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Point of View

A Quarterly Newsletter

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INTELLECTUAL PROPERTY CHECKLIST

It is increasingly important to develop a plan of action to protect the valuable intellectual property rights of your company. Are the intellectual assets of your company protected? Is the company leveraging its brand? Are the intellectual assets being captured and exploited so as to increase the value of the company?

The following **Intellectual Property Checklist** may be used as a tool to review the areas within the company where intellectual property rights typically arise. You may recognize the need to take steps to minimize the loss of such rights. You may discover rights which can be protected and enforced and give rise to revenue.

TRADEMARKS

Do you:

- Conduct a trademark availability search before adopting a new mark or trade name?
- Use the mark consistently and properly in advertising materials?
- Register your marks with the United States Patent and Trademark Office or your state?
- Preserve the right to any potential marks by filing an intent-to-use trademark application?
- Use your marks in foreign countries and obtain rights in such countries?
- Use the proper notice (™ or ®) with your marks?
- Know when your registration maintenance fees are due?
- Have a list of all agreements that contain trademark licenses (including distributor, dealer, franchising, co-branding and web site linking agreements)?
- Monitor your dealers, distributors and licensees for proper use of your marks?
- Hire a watch service to monitor the marketplace and detect unauthorized use of your marks by others?

- Conduct Internet searches for use of your marks by competitors, including unauthorized use of your marks in search engine caches, metatags, keyword triggered advertising and watermarkings?

DOMAIN NAMES

Have you:

- Performed a clearance search prior to obtaining your domain name?
- Kept track of renewal dates?
- Registered all possible top level domains (.com, .net, .org, .us, etc.) and country codes?
- Registered common misspellings of your domain name?
- Found a third party using your identical registered mark as a domain name?

WEB SITES

Do you:

- Use clips of artwork, photographs, text, video or music on your site?
 - Have a written agreement with your web site developer giving you ownership to the content, the artwork and the layout?
 - Obtain permission for third party trademarks or service marks used on your site?
 - Have terms and conditions that limit your liability from errors or unavailability of the site?
 - Have linking or framing agreements with other web site owners?
 - Have a blog? Is it protected by copyright?
 - Use images or likenesses of individuals with permission?
 - Collect data or use “cookies”? If so, have you complied with privacy regulations?
 - Have a chat room? Does it have a posting policy?
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- Use metatags of competitors in your hidden text, on internet search engine caches or with keyword based advertising or use watermarkings?

TRADE SECRETS

Do you have:

- A written employee policy and manual for handling confidential information?
- Locks on your private file cabinets? Limited access to corporate plants?
- All employees sign non-disclosure agreements?
- Agreements with consultants or programmers who have access to information?
- A practice of requiring agreements prior to providing a product, service or program or prior to taking meetings with those offering a product, service or program?
- Markings of “Confidential” on highly sensitive documents?

SOFTWARE

Have you:

- Obtained written agreements with developers assuring your ownership of the code?
- Registered all versions of created software with the Copyright Office?

- Acquired written permission from all licensors to use their software in your program?
- Conducted an audit to assure the number of users does not exceed your software license limitations?
- Monitored end users to assure compliance with licensing provisions?

PATENTS:

Do you:

- Identify new technology and conduct novelty searches to determine patentability?
- Protect new designs of products with design patents?
- Use provisional patents to protect developing and emerging ideas for one year before filing utility or design patents?
- Check for critical due dates for maintenance fees to avoid the unintentional lapsing of patents?

COPYRIGHTS

Do you:

- Register your manuals, advertising materials, literature, web pages and software with the Copyright Office?
- Use the proper notice (©) and know where to put it?
- Have written assignments with employees, independent contractors, developers and vendors assuring your ownership of works created?
- Copy trade journals, newspapers, newsletters or technical journals and circulate throughout the office?

CORPORATE TRANSACTIONS (IP CONSIDERATIONS)

Have you:

- Assured ownership and any expiration date of intellectual property assets?
- Recorded ownership of newly acquired assets with appropriate federal agency?
- Obtained assignments of IP rights from all employees and consultants?
- Considered co-branding opportunities including digital co-branding partnerships?
- Verified term and transferability of license agreements?
- Taken a security interest in intellectual property assets? Perfected such interest?
- Recorded with the federal government, if appropriate?

ADVERTISEMENTS

Do your advertisements:

- Use the name of a competitor?
- Use client testimonials?
- Make statements that are not true?
- Use defamatory or obscene material?
- Contain the proper copyright or trademark notices?

- Use your trademarks consistently and properly?

WORKPLACE ISSUES

Do you have:

- An employee policy for use of e-mail, employee computers and the Internet?
- An e-mail disclaimer protecting confidentiality of content?
- Assignment Agreements with present (not future) assignment language?
- Agreements with current and terminated employees assuring confidentiality?
- An acknowledgement from every employee that no intellectual property of his/her prior employer will be used in your business?
- Copyright warning notices on copiers, and in company library and reference centers?

Deborah A. Basile, a shareholder with the firm, is primarily involved in the firm's intellectual property and business practice. Deborah is registered to practice before the United States Patent and Trademark Office and works in all areas of general business and commercial transactions, with a specialty in intellectual property, including trademark and patent prosecution, copyright and licensing.

*This publication may be considered advertising under the rules
of the Supreme Judicial Court.*
