ENTREPRENEUR'S INTELLECTUAL PROPERTY NOTEBOOK

THIS IS A BOOKLET, NOT A LAWYER (YOU CAN TELL BECAUSE IT IS MUCH SMALLER AND LESS EXPENSIVE). THIS ENTREPRENEUR'S INTELLECTUAL PROPERTY NOTEBOOK IS MEANT TO PROVIDE AN OVERVIEW ON AREAS RELATING TO INTELLECTUAL PROPERTY PROTECTION THAT MIGHT ARISE IN YOUR BUSINESS. THE CONTENT OF THIS BOOKLET **IS NOT** LEGAL ADVICE, BUT SIMPLY HELPFUL INFORMATION, ACCURATE AT THE TIME OF PUBLICATION, WHICH WILL HOPEFULLY MAKE YOUR INTERACTIONS WITH YOUR LAWYER MORE EFFECTIVE AND LESS EXPENSIVE. DO NOT RELY UPON THIS, OR ANY BOOKLET OR WEBSITE, WHEN YOU ARE MAKING DECISIONS ABOUT YOUR VALUABLE INTELLECTUAL PROPERTY RIGHTS. THE DISSEMINATION AND USE OF THIS BOOKLET DOES NOT CREATE AN ATTORNEY-CLIENT RELATIONSHIP BETWEEN YOU OR YOUR COMPANY AND HARNESS IP. IF YOU HAVE ANY QUESTIONS RELATING TO THE CONTENT OF THIS BOOKLET, OR ANY INTELLECTUAL PROPERTY ISSUES, YOU SHOULD CONTACT A LAWYER.

HARNESS IP
INTELLECTUAL PROPERTY LAW SINCE 1921

TABLE OF CONTENTS

Protecting Your Confidential Information

Implement basic security measures. Protect every disclosure of valuable, confidential information with a confidentiality agreement.

Guidelines

1. Sufficient: Be sure that a confidentiality agreement is sufficient and that you don't need some other agreement, such as a development agreement.

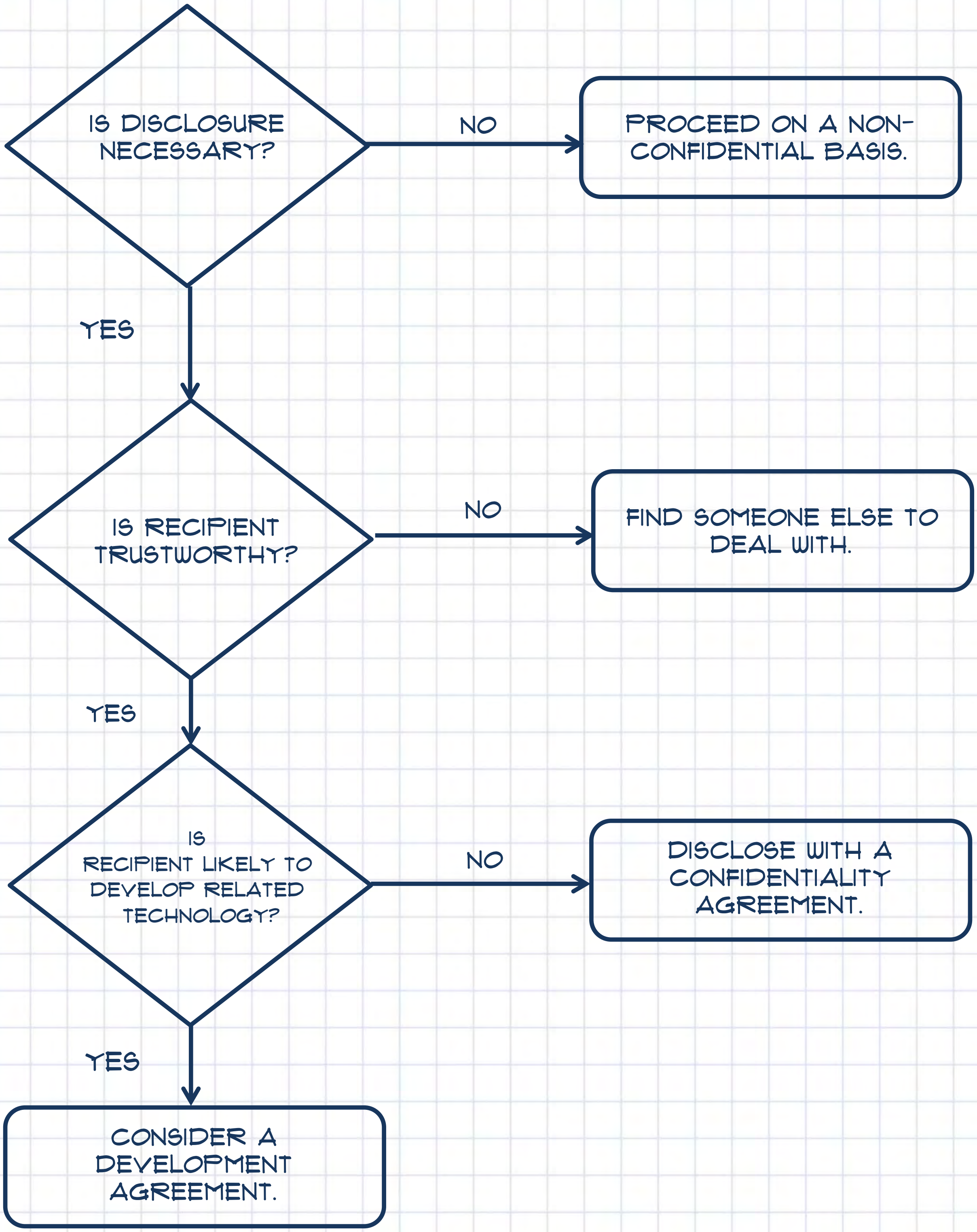
2. Essential: Only disclose information that you have to – agreement or not, every person who has access to your information is an additional risk.

3. Trust: Only disclose information to people you trust – a confidentiality agreement doesn't make someone trustworthy, it just lets you sue them.

4. Public: Assume that anything you disclose without a confidentiality agreement will become public domain, and if you haven't yet filed a patent application, expect that the non-confidential disclosure may limit your ability to do so.

5. Timing: Only disclose information after you have a signed agreement and keep your copy in a safe place.

CONFIDENTIALITY FLOW-CHART



CHECKLIST

ESSENTIALS:

- ☐ DOES THE AGREEMENT BIND EVERYONE WHO MIGHT RECEIVE THE INFORMATION?
- ☐ IS THE SUBJECT MATTER PROTECTED BY THE AGREEMENT CLEAR?
- ☐ DO YOU UNDERSTAND THE TIME FRAME DURING WHICH YOUR DISCLOSURES ARE COVERED BY THE AGREEMENT?
- ☐ DOES THE AGREEMENT RESTRICT THE RECIPIENT'S DISCLOSURE AND USE OF YOUR INFORMATION?
- ☐ IS THE RECIPIENT'S PERMITTED USE SUFFICIENTLY DEFINED?
- ☐ DO YOU UNDERSTAND HOW LONG THE RECIPIENT'S OBLIGATIONS LAST?

OPTIONS:

- ☐ DISCLAIMER OF WARRANTIES?
- ☐ RETURN OF DISCLOSED INFORMATION?
- ☐ DISCLAIMER OF OBLIGATION TO ENTER INTO FURTHER AGREEMENTS?
- ☐ DISCLAIMER OF RECIPROCAL OBLIGATIONS?
- ☐ EXPORT RESTRICTIONS?
- ☐ INDEMNITY?
- ☐ CHOICE OF LAW?
- ☐ CHOICE OF FORUM?

TIPS

- <u>INDEX & IMAGE</u>: KEEP AN INDEX OF THE AGREEMENTS YOU ENTER INTO AND KEEP AN IMAGE OF THE AGREEMENTS IN A SECURE LOCATION.

- <u>MARK</u>: MARK ALL DOCUMENTS IN WHICH YOU DISCLOSE YOUR CONFIDENTIAL INFORMATION "CONFIDENTIAL" OR, EVEN BETTER, "SUBJECT TO CONFIDENTIALITY AGREEMENT OF "{<u>DATE</u>}."

- <u>DOCUMENT</u>: DOCUMENT THE INFORMATION YOU HAVE DISCLOSED PURSUANT TO THE AGREEMENT IN A FOLLOW UP LETTER OR EMAIL.

- <u>DEADLINES</u>: MARK THE DATE THAT DISCLOSURES ARE NO LONGER PROTECTED ON YOUR CALENDAR, SO YOU KNOW WHEN TO STOP MAKING DISCLOSURES. (CONSIDER SENDING YOURSELF A POST-DATED EMAIL.)

- <u>EXPIRATION</u>: MARK THE DATE THAT THE RECIPIENT'S CONFIDENTIALITY OBLIGATIONS EXPIRE. (CONSIDER SENDING YOURSELF A POST-DATED EMAIL.)

CONFIDENTIAL INFORMATION OF OTHERS

AVOID RECEIVING CONFIDENTIAL INFORMATION THAT YOU DO NOT NEED — AND MAKE SURE YOU PROTECT THE CONFIDENTIAL INFORMATION THAT YOU DO RECEIVE — TO AVOID BREACHING YOUR DUTY TO THE DISCLOSER.

GUIDELINES

1. SCOPE: MAKE SURE THAT THE SCOPE OF THE DISCLOSED INFORMATION AND THE DURATION OF YOUR OBLIGATIONS ARE AS LIMITED AS POSSIBLE.

2. NECESSARY: ONLY ACCEPT CONFIDENTIAL INFORMATION THAT IS NECESSARY TO YOUR BUSINESS.

3. AGREEMENTS: HAVE CONFIDENTIALITY AGREEMENTS IN PLACE WITH YOUR EMPLOYEES AND CONTRACTORS THAT ALLOW YOU TO MEET YOUR OBLIGATIONS. CONSIDER USING A NON-CONFIDENTIAL AGREEMENT WITH THIRD PARTIES TO PREVENT ANY IMPLIED OBLIGATIONS OF CONFIDENTIALITY.

4. PRIOR INFORMATION: MAKE SURE THAT YOUR CONFIDENTIALITY OBLIGATIONS EXCLUDE INFORMATION THAT YOU HAD PRIOR TO THE AGREEMENT OR THAT YOU INDEPENDENTLY DEVELOP AFTER THE AGREEMENT PERIOD ENDS.

CHECKLIST

- ☐ IS THE SUBJECT MATTER OF YOUR CONFIDENTIALITY OBLIGATIONS CLEAR?
- ☐ ARE THERE EXCEPTIONS FOR INFORMATION THAT YOU ALREADY HAVE IN YOUR POSSESSION, THAT YOU SUBSEQUENTLY ACQUIRE FROM AN UNRESTRICTED SOURCE, OR THAT YOU INDEPENDENTLY DEVELOP?
- ☐ IS THE PERIOD DURING WHICH THE DISCLOSER CAN MAKE CONFIDENTIAL DISCLOSURES CLEAR?
- ☐ IS THE DURATION OF YOUR CONFIDENTIALITY OBLIGATIONS CLEAR?

TIPS

- INDEX & IMAGE: KEEP AN INDEX OF THE AGREEMENTS YOU ENTER INTO AND KEEP AN IMAGE OF THE AGREEMENTS IN A SECURE LOCATION.

- NOTIFY: IF YOU RECEIVE ANY INFORMATION THAT WAS ALREADY IN YOUR POSSESSION, OR THAT YOU KNOW NOT TO BE CONFIDENTIAL, ALERT THE DISCLOSER RIGHT AWAY.

- SECURE: SECURE ALL DOCUMENTS AND THINGS THAT CONTAIN THE DISCLOSER'S CONFIDENTIAL INFORMATION.

- MARK: MARK ALL DOCUMENTS AND THINGS THAT CONTAIN THE DISCLOSER'S CONFIDENTIAL INFORMATION AS "CONFIDENTIAL" TO AVOID MISTAKES.

- DATE: MARK THE DATE THAT DISCLOSURES ARE NO LONGER PROTECTED ON YOUR CALENDAR, SO YOU KNOW WHEN THE DISCLOSURES YOU RECEIVE ARE NO LONGER PROTECTED. (CONSIDER SENDING YOURSELF A POST-DATED EMAIL.)

- EXPIRATION: MARK THE DATE THAT YOUR CONFIDENTIALITY OBLIGATIONS EXPIRE. (CONSIDER SENDING YOURSELF A POST-DATED EMAIL.)

NOTES:

EMPLOYEES

YOU CANNOT DO IT ALL YOURSELF. TO GROW A SUCCESSFUL BUSINESS, YOU WILL HAVE TO ENLIST THE HELP OF EMPLOYEES. EMPLOYEES DO NOT HAVE THE SAME DUTIES AND OBLIGATIONS TO THE BUSINESS AS AN OWNER, AND YOU NEED TO ADDRESS THIS WITH AN APPROPRIATE EMPLOYEE (NOT NECESSARILY EMPLOYMENT) AGREEMENT.

GUIDELINES

1. SHOPRIGHT: IN THE ABSENCE OF AN AGREEMENT, A BUSINESS DOES NOT AUTOMATICALLY OWN THE INVENTIONS OF ITS EMPLOYEES UNLESS THOSE EMPLOYEES WERE HIRED TO INVENT OR ARE SPECIFICALLY ASSIGNED TO THAT TASK. INSTEAD, THE BUSINESS GETS A SHOPRIGHT — A NONEXCLUSIVE LICENSE TO USE THE INVENTION.

2. EMPLOYEE WORKS: IN THE ABSENCE OF AN AGREEMENT, A BUSINESS OWNS THE COPYRIGHT IN WORKS MADE BY EMPLOYEES IN THE SCOPE OF THEIR EMPLOYMENT, BUT NOT OTHER WORKS CREATED BY EMPLOYEES.

3. CONFIDENTIALITY: EMPLOYEES HAVE A COMMON LAW DUTY OF LOYALTY TO THEIR EMPLOYER NOT TO DISCLOSE CONFIDENTIAL INFORMATION, BUT THE FAILURE TO HAVE AN EXPRESS CONFIDENTIALITY AGREEMENT MAY CAUSE A COURT TO CONCLUDE THE EMPLOYER HAS NO TRADE SECRETS.

4. AGREEMENT: AN EMPLOYEE AGREEMENT ALLOWS AN EMPLOYER TO IMPOSE OTHER RESTRICTIONS, INCLUDING PROTECTION OF COMPUTER DATA AND

COMPUTER SYSTEMS, AS WELL AS RESTRICTIONS ON WORKING FOR COMPETITORS.

CHECKLIST

ESSENTIALS:

- ☐ IS THERE AN AGREEMENT TO ASSIGN AND A CURRENT ASSIGNMENT OF INVENTIONS?
- ☐ IS THERE AN AGREEMENT TO ASSIGN AND A CURRENT ASSIGNMENT OF COPYRIGHTS?
- ☐ IS THERE A CONFIDENTIALITY AGREEMENT?

OPTIONS:

- ☐ IS THERE AN AGREEMENT REGARDING ACCESS TO THE COMPANY'S COMPUTER SYSTEM(S), NETWORK(S) AND DATA?
- ☐ IS THERE A NON-COMPETE AGREEMENT?
- ☐ IS THERE A NON-SOLICITATION AGREEMENT?
- ☐ DOES THE EMPLOYEE DISCLOSE PRIOR INVENTIONS?
- ☐ DOES THE EMPLOYEE DISCLOSE PRIOR OBLIGATIONS AND AGREEMENTS?
- ☐ IS THERE A CHOICE OF LAW PROVISION?
- ☐ IS THERE A CHOICE OF FORUM PROVISION?

TIPS

- <u>LIMITS</u>: SOME STATES LIMIT WHAT CAN BE ASSIGNED AND HOW LONG A NON-COMPETE AGREEMENT WILL BE VALID, SO BE SURE TO UNDERSTAND WHAT LAWS APPLY TO YOUR AGREEMENTS.

- <u>AGREEMENTS</u>: GET AGREEMENTS FROM ALL EMPLOYEES WHO HANDLE CONFIDENTIAL INFORMATION (YOURS AND THIRD PARTY'S) OR WHO COULD POSSIBLY CREATE SOMETHING VALUABLE.

- <u>SECURE</u>: KEEP COPIES OF ALL EMPLOYEE AGREEMENTS IN A SECURE LOCATION.

- <u>TIMING</u>: ADEQUATE LEGAL CONSIDERATION CAN BE AN ISSUE WITH EMPLOYEE AGREEMENTS, SO PRESENT THE AGREEMENT AT THE START OF EMPLOYMENT, OR AT THE SAME TIME AS A PROMOTION, SALARY INCREASE OR BONUS.

NOTES:

CONTRACTORS AND CONSULTANTS

TO GROW A SUCCESSFUL BUSINESS, YOU WILL NEED TO ENLIST THE HELP OF CONTRACTORS AND CONSULTANTS. CONTRACTORS AND CONSULTANTS DO NOT HAVE ANY OBLIGATIONS TO THE COMPANY BEYOND THOSE CREATED BY CONTRACT.

GUIDELINES

1. INVENTIONS: A BUSINESS DOES NOT OWN THE INVENTIONS OF ITS CONTRACTORS AND CONSULTANTS, EXCEPT AS PROVIDED IN A CONTRACT BETWEEN THE PARTIES.

2. COPYRIGHT: A BUSINESS USUALLY DOES NOT OWN THE COPYRIGHTS IN WORKS MADE BY CONTRACTORS AND CONSULTANTS, EXCEPT AS PROVIDED IN A CONTRACT BETWEEN THE PARTIES.

3. CONFIDENTIALITY: CONTRACTORS AND CONSULTANTS HAVE NO OBLIGATIONS TO PROTECT A COMPANY'S CONFIDENTIAL INFORMATION EXCEPT AS CREATED BY A CONTRACT BETWEEN THE PARTIES.

4. RESTRICTIONS: AN AGREEMENT ALLOWS A BUSINESS TO IMPOSE OTHER RESTRICTIONS ON CONTRACTORS AND CONSULTANTS, INCLUDING PROTECTION OF COMPUTER DATA AND COMPUTER SYSTEMS, PLUS RESTRICTIONS ON WORKING FOR COMPETITORS.

CHECKLIST

ESSENTIALS:

- ☐ IS THERE AN AGREEMENT TO ASSIGN AND A CURRENT ASSIGNMENT OF INVENTIONS?
- ☐ IS THERE AN AGREEMENT TO ASSIGN AND A CURRENT ASSIGNMENT OF COPYRIGHTS?
- ☐ IS THERE A CONFIDENTIALITY AGREEMENT?

OPTIONS:

- ☐ IS THERE AN AGREEMENT REGARDING ACCESS TO THE COMPANY'S COMPUTER SYSTEM(S), NETWORK(S) AND DATA?
- ☐ DOES THE AGREEMENT ADDRESS THE EMPLOYEES OF THE CONTRACTOR OR CONSULTANT?
- ☐ IS THERE A NON-COMPETE AGREEMENT?
- ☐ IS THERE A NON-SOLICITATION AGREEMENT?
- ☐ IS THERE A REPRESENTATION AND WARRANTY THAT THE CONTRACTOR OR CONSULTANT IS FREE TO WORK FOR THE COMPANY?
- ☐ IS THERE A CHOICE OF LAW PROVISION?
- ☐ IS THERE A CHOICE OF FORUM PROVISION?

TIPS

- GET AGREEMENTS FROM ALL CONSULTANTS.

- MAINTAIN A DATABASE OF CONTRACTOR AND CONSULTANT AGREEMENTS AND KEEP COPIES OF ALL AGREEMENTS IN A SECURE LOCATION.

PATENTS

THE UNITED STATES HAS JOINED MOST OF THE WORLD IN AWARDING PATENTS ON A FIRST-TO-FILE BASIS. TO PROTECT AN INVENTION, AN INVENTOR SHOULD TRY TO GET THE *EARLIEST POSSIBLE FILING DATE*, PREFERABLY BEFORE ANY PUBLIC DISCLOSURE OF THE INVENTION.

GUIDELINES

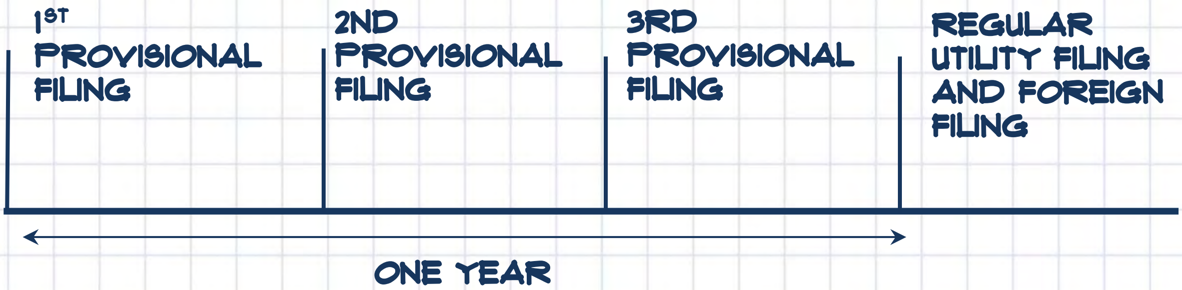
1. PATENT TYPES: THERE ARE THREE TYPES OF U.S. PATENTS: 1) UTILITY PATENTS THAT PROTECT THE WAY SOMETHING IS CONSTRUCTED OR HOW IT WORKS; 2) DESIGN PATENTS THAT PROTECT THE APPEARANCE OF A PRODUCT; AND 3) PLANT PATENTS THAT PROTECT ASEXUALLY REPRODUCED PLANTS.

2. REQUIREMENTS: AN INVENTION MUST BE USEFUL, NOVEL (NEW) AND NON-OBVIOUS (NOT AN OBVIOUS VARIATION OF THE PRIOR ART) TO BE PATENTABLE.

3. FILING DATE: GET THE EARLIEST POSSIBLE FILING DATE BY FILING A PROVISIONAL PATENT APPLICATION AS SOON AS POSSIBLE, AND FILING A NEW PROVISIONAL EACH TIME A SIGNIFICANT DEVELOPMENT IS MADE.

4. TIMING: ALTHOUGH DISCLOSURES MADE BY THE INVENTOR WITHIN THE YEAR BEFORE FILING GENERALLY DO NOT BAR PATENTING IN THE U.S., PRE-FILING DISCLOSURES CAN BAR FOREIGN PATENT FILINGS AND CAN PROMPT THIRD PARTY PUBLICATIONS THAT NARROW THE SCOPE OF PROTECTION AVAILABLE IN THE U.S., SO FILE BEFORE MAKING ANY PUBLIC DISCLOSURES.

PATENT FILING TIMELINE



NOTES:

PUBLICATION

- UTILITY PATENT APPLICATIONS ARE USUALLY PUBLISHED 18 MONTHS FROM THEIR EARLIEST EFFECTIVE FILING DATE.

- YOU CAN PREVENT PUBLICATION OF YOUR APPLICATION UNTIL ISSUANCE IF YOU REQUEST NON-PUBLICATION AT FILING AND AGREE NOT TO FILE ANY FOREIGN PATENT APPLICATIONS ON THE SUBJECT MATTER.

TIPS

- NON-PUBLICATION MAKES SENSE IF YOU WANT TO TREAT YOUR INVENTION AS A TRADE SECRET IF YOU DO NOT OBTAIN A PATENT, OR IF YOU ARE STILL DEVELOPING YOUR INVENTION AND DO NOT WANT YOUR OWN PUBLISHED APPLICATION TO BE PRIOR ART TO YOUR FUTURE DEVELOPMENTS.

- A NON-PUBLICATION REQUEST GENERALLY PREVENTS FOREIGN PATENT PROTECTION, BUT START-UP BUSINESSES SHOULD NOT OBSESS OVER FOREIGN PROTECTION —WHICH CAN BE DIFFICULT AND EXPENSIVE TO OBTAIN —AT THE EXPENSE OF SOLID DOMESTIC PROTECTION.

PROVISIONAL PATENT RIGHTS

THERE IS NO LIABILITY FOR PATENT INFRINGEMENT UNTIL A PATENT ACTUALLY ISSUES, BUT ONCE THE PATENT ISSUES YOU MAY BE ABLE TO COLLECT DAMAGES FOR INFRINGEMENT OCCURRING AFTER PUBLICATION BUT BEFORE ISSUANCE, PROVIDED THAT:

1. YOU GIVE THE INFRINGER NOTICE OF YOUR PUBLISHED APPLICATION; AND

2. THE INFRINGED CLAIM IN YOUR ISSUED PATENT IS "SUBSTANTIALLY THE SAME" AS A CLAIM IN YOUR PUBLISHED APPLICATION.

RECORD KEEPING

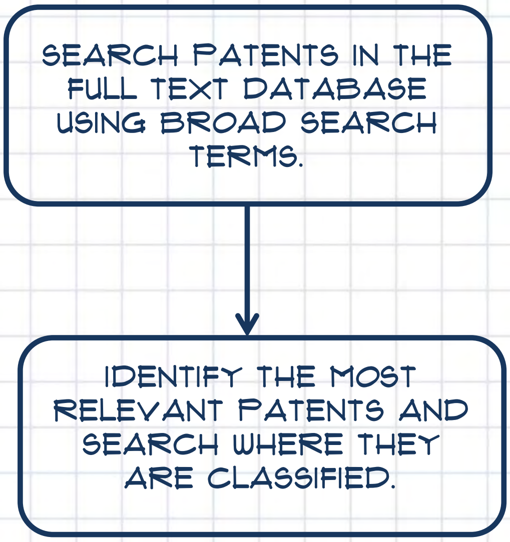
THE ADOPTION OF A FIRST-TO-FILE SYSTEM DID NOT ELIMINATE THE NEED TO KEEP INVENTOR NOTEBOOKS. THE TIME MAY COME WHEN YOU WILL NEED TO USE THOSE RECORDS TO PROVE THAT THIRD PARTY DISCLOSURES ARE NOT PRIOR ART. THEREFORE:

1. PRESERVE RECORDS SHOWING INDEPENDENT DEVELOPMENT OF YOUR INVENTION.

2. PRESERVE RECORDS OF THE CONTENT OF ALL PRE-FILING DISCLOSURES AND THE IDENTITIES OF TO WHOM THEY WERE MADE.

PATENT SEARCHING

YOU DO NOT HAVE TO CONDUCT A PATENT SEARCH, BUT ANY MATERIAL PRIOR ART YOU DO FIND MUST BE DISCLOSED TO THE PATENT OFFICE. SEARCHING, HOWEVER, WILL HELP YOU UNDERSTAND THE PRIOR ART AND AVOID FILING AN APPLICATION THAT HAS NO CHANCE FOR SUCCESS. IT CAN ALSO GIVE YOU HELPFUL INFORMATION ABOUT YOUR FREEDOM TO PRACTICE THE INVENTION.



TIPS

- SCOPE: DON'T FORGET TO SEARCH PUBLISHED APPLICATIONS AS WELL AS PATENTS.

- LIMITATIONS: KNOW THE LIMITATIONS OF YOUR SEARCH. FULL TEXT SEARCHING AT THE USPTO ONLY INCLUDES PATENTS FROM 1976. FULL TEXT SEARCHING ON GOOGLE PATENTS INCLUDES ALL PATENTS, BUT CONTAINS SCANNING ERRORS.

PATENT MARKING

1. YOU CAN AND SHOULD MARK PRODUCTS COVERED BY A PENDING APPLICATION "PATENT PENDING" OR "PAT. PEND.," BUT THERE IS NO LEGAL OBLIGATION TO DO SO.

2. YOU SHOULD MARK PRODUCTS COVERED BY AN ISSUED PATENT WITH THE PATENT NUMBER TO PRESERVE YOUR ABILITY TO COLLECT DAMAGES FROM INFRINGERS.

TIPS

YOU CAN KEEP YOUR PATENT MARKING CURRENT BY:

- <u>ACTUAL MARKING</u>: MARKING THE PRODUCT WITH THE WORD "PATENT" AND THE NUMBER; OR

- <u>VIRTUAL MARKING</u>: MARKING THE PRODUCT WITH THE ABBREVIATION "PAT." AND AN ADDRESS OF A WEBSITE THAT HAS CURRENT INFORMATION ABOUT THE PATENT COVERAGE.

YOUR BUSINESS NAME

THE NAME YOU ADOPT FOR YOUR BUSINESS — YOUR TRADE NAME – MUST NOT BE CONFUSINGLY SIMILAR TO A NAME ALREADY IN USE.

GUIDELINES

1. UNIQUE: IF YOU ARE FORMING A BUSINESS ENTITY (A CORPORATION, LLC, OR PARTNERSHIP), YOUR NAME MUST BE DIFFERENT FROM ANY PREVIOUSLY ACTIVE AND REGISTERED BUSINESS NAME.

2. TRADEMARK SEARCH: IF YOU ARE GOING TO USE YOUR BUSINESS NAME ON YOUR PRODUCT OR SERVICE, YOU SHOULD ALSO CONDUCT A TRADEMARK SEARCH TO REDUCE THE RISK OF AN INFRINGEMENT OR UNFAIR COMPETITION CLAIM.

3. FICTITIOUS NAME: IF THE BUSINESS NAME THAT YOU ARE GOING TO USE PUBLICLY IS DIFFERENT FROM YOUR ACTUAL LEGAL NAME, YOU MAY NEED TO REGISTER THIS "FICTITIOUS" NAME (ALSO CALLED "DOING BUSINESS AS," FREQUENTLY ABBREVIATED AS "D/B/A") WITH THE STATE OR LOCAL AUTHORITIES WHERE YOU DO BUSINESS.

BRANDING

THE TRADEMARK OR SERVICE MARK THAT YOU SELECT MUST NOT BE CONFUSINGLY SIMILAR TO OR DILUTE A PRIOR MARK.

GUIDELINES

1. SEARCH: SEARCH YOUR MARK.

2. CLEARANCE: DO NOT FALL IN LOVE WITH YOUR MARK UNTIL IT HAS BEEN CLEARED.

3. SIMILARITY: DO NOT SELECT A MARK THAT IS SIMILAR TO A MARK USED ON THE SAME OR RELATED PRODUCTS OR SERVICES, OR WHICH IS SIMILAR TO A FAMOUS MARK.

4. CONNECTION: AVOID MARKS THAT FALSELY SUGGEST A CONNECTION WITH SOMEONE OR SOMETHING.

5. DESCRIPTIVE: AVOID MARKS THAT MERELY DESCRIBE YOUR PRODUCT OR SERVICE.

6. DECEPTION: AVOID MARKS THAT ARE DECEPTIVE IN THEIR DESCRIPTIONS OF YOUR PRODUCT OR SERVICE.

7. NAMES: AVOID MARKS THAT ARE MERELY SURNAMES.

TIPS

- <u>OBJECTIVITY</u>: EVALUATE YOUR SEARCH RESULTS HONESTLY.

- <u>OBJECTIONS</u>: DON'T ASSUME THAT ANOTHER TRADEMARK OWNER IS ANY LESS ATTACHED TO THEIR MARK THAN YOU ARE TO YOURS. IF YOU WERE THE SENIOR USER, WOULD YOU CONSIDER OBJECTING TO THEIR MARK? IF SO, THEN THEY WILL PROBABLY CONSIDER OBJECTING TO YOURS.

FLOWCHART

SEARCH A TRADEMARK DATABASE FOR THE EXACT MARK ON ANY GOODS AND SERVICES.

↓

SEARCH A TRADEMARK DATABASE FOR THE VARIATIONS OF THE MARK ON RELATED GOODS AND SERVICES.

↓

CONDUCT A BROAD WEB SEARCH FOR POTENTIALLY CONFLICTING AND POTENTIALLY UNFLATTERING USES.

EXAMPLE

SEARCH: CARDICHEK	
SEARCH SINGULAR AND PLURAL VERSIONS OF THE MARK.	E.G., CARDICHEKS
SEARCH THE FIRST PORTION OR PREFIX OF THE MARK.	E.G., CARDICARD, CARDIAC. CARDICAD, ETC.
SEARCH THE SECOND PORTION OR SUFFIX OF THE MARK.	E.G., CASECHEK, CLEARCHEK, CORECHEK
SEARCH SUBSTITUTED VOWELS FOR THE MARK.	E.G., CARDOCHEK, CORDICHEK, ETC.
SEARCH SUBSTITUTED CONSONANTS.	E.G., KARDICHEK, CARDICHEX, CARDICHECK, ETC.

TRADEMARK PROTECTION

YOU DEVELOP PROTECTABLE RIGHTS IN YOUR MARK SIMPLY BY USING IT. THESE RIGHTS, HOWEVER, ONLY EXTEND TO THE AREAS WHERE YOU ACTUALLY USE THE MARK. TO PROTECT YOUR MARK THROUGHOUT THE COUNTRY, EVEN IN AREAS WHERE YOU HAVE NOT YET USED IT, YOU SHOULD GET A FEDERAL REGISTRATION ON YOUR MARK.

THERE ARE THREE DECISIONS TO MAKE IN APPLYING FOR A FEDERAL REGISTRATION:

1. BASIS: THE BASIS FOR THE APPLICATION;

2. FORM: THE FORM OF THE MARK TO REGISTER; AND

3. PRODUCTS/SERVICES: THE PRODUCTS AND SERVICES FOR WHICH TO REGISTER THE MARK.

THE BASIS FOR THE APPLICATION

AN APPLICATION CAN BE FILED BASED ON YOUR ACTUAL USE OF THE MARK ON ALL OF THE LISTED PRODUCTS AND SERVICES OR BASED ON YOUR INTENT TO USE THE MARK ON ALL OF THE LISTED PRODUCTS AND SERVICES.

A USE-BASED APPLICATION IS GENERALLY FASTER AND LESS EXPENSIVE AND IS THE OBVIOUS CHOICE WHERE THE MARK IS ALREADY IN ACTUAL COMMERCIAL USE.

AN INTENT TO USE-BASED APPLICATION IS SLIGHTLY MORE EXPENSIVE AND USUALLY TAKES LONGER TO PROCESS, BUT IT ALLOWS THE OWNER TO GET THE REGISTRATION PROCESS STARTED LONG BEFORE COMMERCIAL USE OF THE MARK BEGINS. UNLESS THE MARK IS IN USE ON ALL OF THE LISTED GOODS, AN INTENT-TO-USE APPLICATION SHOULD BE FILED.

THE FORM OF THE MARK

A WORD MARK CAN BE REGISTERED IN THE PARTICULAR FORM IT IS USED (E.G., A SPECIAL FONT, ARRANGEMENT AND/OR LOGO).

BLOCK LETTER FORMAT: A WORD MARK CAN BE REGISTERED IN BLOCK LETTER FORMAT, WHICH PROTECTS THE MARK IN ANY FORM OR STYLE. THIS REGISTRATION OFFERS THE ADVANTAGE OF PROTECTING YOUR MARK AS IT EVOLVES OVER TIME, WHEREAS A STYLIZED FORMAT MAY CAUSE PROTECTION TO LAPSE IF YOU MAKE CHANGES TO THE MARK.

STYLIZED FORMAT: A REGISTRATION ON THE STYLIZED FORMAT IS ADVANTAGEOUS BECAUSE THE STYLIZED PRESENTATION MAY MAKE THE MARK EASIER TO REGISTER. FURTHERMORE, YOU COULD BRING LEGAL ACTION AGAINST AN INFRINGER WHO COPIES THE PRESENTATION OF THE MARK WHILE USING DIFFERENT WORDS.

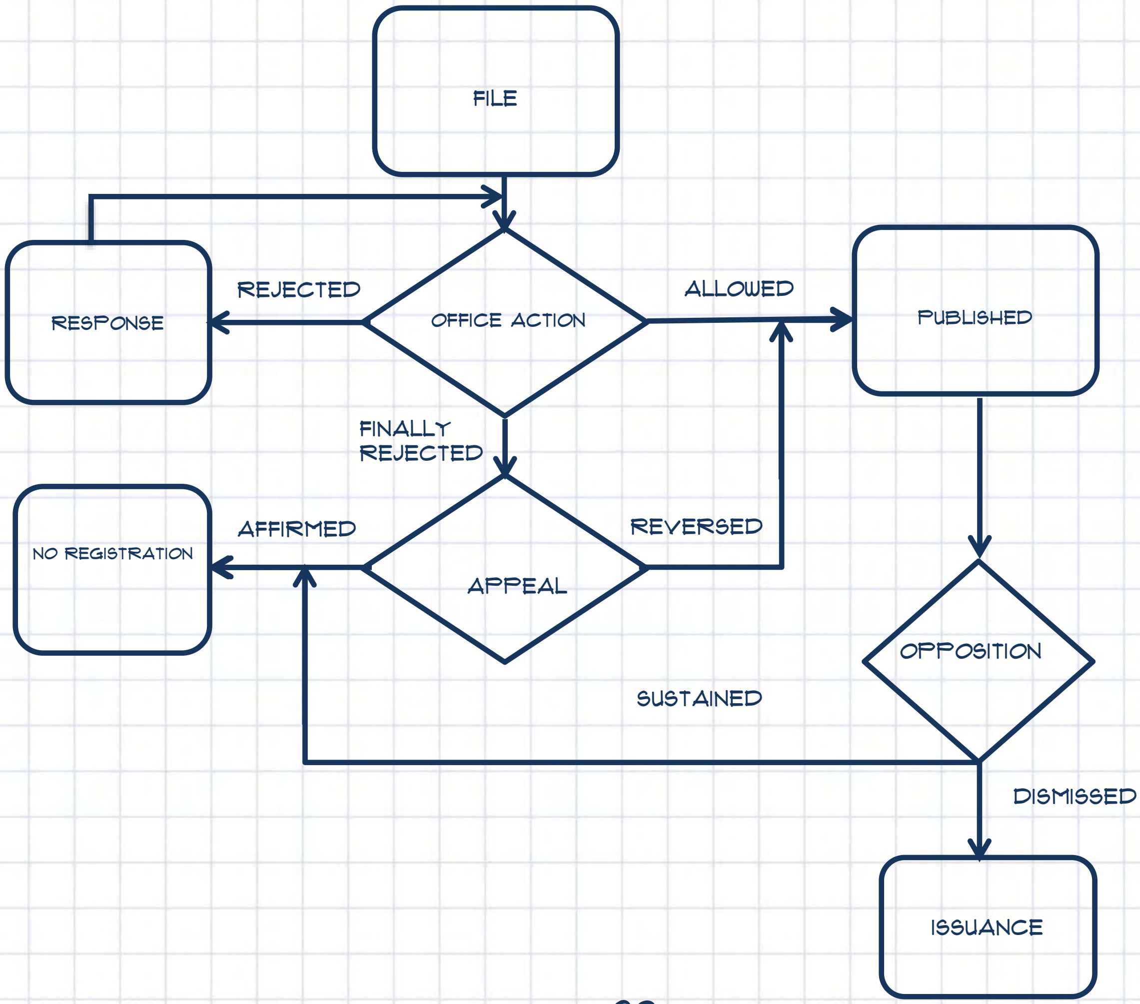
THE PRODUCTS AND SERVICES

A FEDERAL REGISTRATION CREATES A PRESUMPTION OF OWNERSHIP AND GRANTS EXCLUSIVE RIGHT TO USE THE MARK IN CONNECTION WITH THE PRODUCTS AND SERVICES LISTED IN THE REGISTRATION. THE SCOPE OF PROTECTION THEREFORE DEPENDS UPON THE PRODUCTS AND SERVICES LISTED. THIS LIST CANNOT BE EXPANDED ONCE THE APPLICATION IS FILED, SO IT IS IMPORTANT TO HAVE AN ACCURATE AND COMPLETE LIST OF THE PRODUCTS AND SERVICES WHEN THE APPLICATION IS FILED.

THE USPTO HAS A MANUAL OF ACCEPTABLE GOODS AND SERVICES. THIS MANUAL SHOULD BE USED, WHERE POSSIBLE, TO AVOID DELAYS AND EXTRA EXPENSES.

TRADEMARK REGISTRATION PROCESS

ONCE FILED, THE USPTO EXAMINER DETERMINES WHETHER THE APPLIED-FOR-MARK FITS THE CATEGORIES OF TERMS THAT CAN BE TRADEMARKED AND WHETHER THE MARK IS "CONFUSINGLY SIMILAR" TO ANOTHER PERSON'S MARK. IF THE EXAMINER OBJECTS TO THE MARK, THE APPLICANT MAY RESPOND TO THE REJECTION AND/OR APPEAL THE EXAMINER'S DECISION. IF APPROVED, THE MARK IS "PUBLISHED" IN THE FEDERAL REGISTER. THIS ALLOWS THE PUBLIC TO DETERMINE WHETHER THEY HAVE ANY OBJECTIONS TO THE APPLIED-FOR-MARK. IF SO, THE MARK ENTERS AN ADMINISTRATIVE PROCEEDING KNOWN AS AN "OPPOSITION." IF NO OPPOSITION IS FILED, OR IF THE APPLICANT RAISES A SUCCESSFUL DEFENSE, THE MARK IS PLACED ON THE FEDERAL REGISTER.



PROPER TRADEMARK USE

YOU MUST USE YOUR TRADEMARKS PROPERLY OR YOU RISK LOSING THEM.

GUIDELINES ("THE ACID TEST")

1. ADJECTIVE: A TRADEMARK IDENTIFIES A PARTICULAR KIND (BRAND) OF PRODUCT, SO A TRADEMARK SHOULD ONLY BE USED AS AN ADJECTIVE. THIS MEANS THAT A MARK GENERALLY SHOULD BE USED WITH A GENERIC TERM. THE WORD "BRAND" CAN HELP, BUT USUALLY IS NOT NECESSARY. ONLY USE YOUR MARK AS AN ADJECTIVE.

2. CONSISTENT: TRADEMARKS ARE MORE RECOGNIZABLE, AND THUS STRONGER, WHEN THEY ARE USED CONSISTENTLY. A TRADEMARK SHOULD THEREFORE ALWAYS BE USED IN THE SAME FORM WITH A CONSISTENT FONT, CASE, COLOR AND PUNCTUATION.

3. IDENTIFIED: IDENTIFY THE MARK AS A MARK. WHEN A MARK IS REGISTERED FOR THE PARTICULAR PRODUCT(S) AND/OR SERVICE(S) WITH WHICH IT IS BEING USED, USE A ® SYMBOL; IN ALL OTHER CASES USE A ™ SYMBOL. IF YOU CANNOT MARK EVERY USE, AT LEAST MARK THE MOST PROMINENT USE ON EACH FACE OF THE PACKAGE OR PAGE OF TEXT.

4. DISTINCTIVE: A TRADEMARK SHOULD BE USED DISTINCTIVELY SO THAT IT IS RECOGNIZED AS A BRAND AND NOT PERCEIVED AS A DESCRIPTION OR PRODUCT DESIGNATION. USE A DISTINCTIVE SIZE, COLOR OR FONT SO YOUR MARK STANDS OUT FROM NORMAL TEXT.

COPYRIGHT PROTECTION

COPYRIGHTS PROTECT EIGHT BROAD CATEGORIES OF WORKS:

1. LITERARY WORKS;
2. MUSICAL WORKS;
3. DRAMATIC WORKS;
4. PANTOMIMES AND CHOREOGRAPHIC WORKS;
5. PICTORIAL, GRAPHIC AND SCULPTURAL WORKS;
6. MOTION PICTURES AND AUDIOVISUAL WORKS;
7. SOUND RECORDINGS; AND
8. ARCHITECTURAL WORKS.

OF THESE, LITERARY WORKS AND GRAPHIC WORKS ARE USUALLY THE MOST IMPORTANT TO A BUSINESS. THEY CAN INCLUDE: SOFTWARE; WHITE PAPERS; TECHNICAL DRAWINGS AND ILLUSTRATIONS; PRESENTATIONS; WEBSITES; ADVERTISING AND PROMOTIONAL MATERIALS; AND PACKAGING.

COPYRIGHT RIGHTS

COPYRIGHT RIGHTS GIVE THE OWNER THE EXCLUSIVE RIGHTS TO DO OR AUTHORIZE THE FOLLOWING:

1. REPRODUCE THE COPYRIGHTED WORK;
2. PREPARE DERIVATIVE WORKS BASED UPON THE COPYRIGHTED WORK;
3. DISTRIBUTE COPIES OR PHONORECORDS (PHYSICAL OBJECTS CARRYING A RECORDING, SUCH AS A CD) OF THE COPYRIGHTED WORK TO THE PUBLIC;
4. PUBLICLY PERFORM THE WORK;
5. PUBLICLY DISPLAY THE WORK; AND
6. PERFORM THE COPYRIGHTED WORK PUBLICLY BY MEANS OF DIGITAL AUDIO TRANSMISSION (FOR SOUND RECORDINGS).

COPYRIGHT PROTECTION

YOUR WORKS ARE AUTOMATICALLY PROTECTED BY COPYRIGHT WHEN THEY ARE "FIXED IN TANGIBLE FORM." THERE ARE TWO STEPS, HOWEVER, THAT WILL GIVE YOU THE BROADEST POSSIBLE COPYRIGHT RIGHTS:

1. THE FIRST STEP IS TO APPLY COPYRIGHT NOTICE TO EACH COPY OF THE WORK. COPYRIGHT NOTICE CONSISTS OF THE © SYMBOL, THE NAME OF THE COPYRIGHT OWNER, AND THE YEAR THAT THE WORK WAS FIRST PUBLISHED. FOR A WORK THAT WAS FIRST PUBLISHED BY THE ACME COMPANY IN 2016, THE NOTICE WOULD BE:

   © ACME COMPANY 2016

2. THE SECOND STEP IS TO REGISTER THE COPYRIGHT WITH THE COPYRIGHT OFFICE. IT TAKES ABOUT 30 MINUTES AND CURRENTLY COSTS $35 TO ELECTRONICALLY FILE A COPYRIGHT APPLICATION AT HTTP://WWW.COPYRIGHT.GOV/.

COPYRIGHT REGISTRATION

REGISTERING THE COPYRIGHT GIVES THE OWNER AT LEAST THREE IMPORTANT ADVANTAGES:

1. A REGISTRATION IS A PREREQUISITE TO BRINGING AN INFRINGEMENT LAWSUIT.

2. IF THE COPYRIGHT IS REGISTERED BEFORE THE INFRINGEMENT BEGINS, THE COPYRIGHT OWNER IS ENTITLED TO STATUTORY DAMAGES —$750 TO $30,000 PER INFRINGEMENT, WHICH CAN BE INCREASED TO $150,000 FOR WILLFUL INFRINGEMENT.

3. IF THE COPYRIGHT IS REGISTERED BEFORE THE INFRINGEMENT BEGINS, THE COPYRIGHT OWNER IS ENTITLED TO RECOVER ITS ATTORNEYS' FEES IN SUCCESSFULLY ENFORCING THE COPYRIGHT.

COPYRIGHT TERM

A COPYRIGHT LASTS FOR THE LIFE OF THE AUTHOR(S) PLUS SEVENTY YEARS. FOR ANONYMOUS WORKS, OR WORKS MADE FOR HIRE, THE COPYRIGHT LASTS FOR THE SHORTER OF 95 YEARS FROM PUBLICATION OR 120 YEARS FROM CREATION.

BECAUSE OF THE LONG DURATION, AND THE FACT THAT APPLYING COPYRIGHT NOTICE IS NOW OPTIONAL, IT CAN BE DIFFICULT TO DETERMINE WHETHER OR NOT A WORK IS STILL PROTECTED BY COPYRIGHT. GENERALLY SPEAKING, WORKS PUBLISHED BEFORE 1924 OR WORKS PUBLISHED WITHOUT COPYRIGHT NOTICE BEFORE 1978 ARE NOT PROTECTED BY COPYRIGHT.

SECURING OWNERSHIP

EMPLOYEES: WORKS PREPARED BY EMPLOYEES IN THE SCOPE OF THEIR EMPLOYMENT ARE "WORKS-MADE-FOR-HIRE" AND BELONG TO THE EMPLOYER.

NON-EMPLOYEES: WORKS PREPARED BY NON-EMPLOYEES, OR WORKS PREPARED BY EMPLOYEES OUTSIDE THE SCOPE OF THEIR EMPLOYMENT, GENERALLY DO NOT BELONG TO THE EMPLOYER. MERELY PAYING FOR A WORK IS NOT ENOUGH TO ENSURE THAT YOU ARE ACQUIRING THE INTELLECTUAL PROPERTY RIGHTS IN THE WORK. WHENEVER YOU ENGAGE A CONSULTANT OR FREELANCER TO CREATE A WORK FOR YOU, YOU SHOULD HAVE A WRITTEN AGREEMENT THAT SPECIFICALLY TRANSFERS ALL RIGHTS IN THE WORK TO YOU:

> *CONTRACTOR AGREES THAT ALL RIGHTS, TITLE, AND INTEREST IN ANY WORKS CREATED IN THE COURSE OF THE PROJECT, INCLUDING ALL COPYRIGHT RIGHTS THEREIN, BELONG TO COMPANY, AND CONTRACTOR AGREES TO ASSIGN, AND HEREBY DOES ASSIGN, TO COMPANY, THE WORK, ALL INTELLECTUAL PROPERTY RIGHTS (INCLUDING COPYRIGHT RIGHTS) IN THE WORK, AND THE RIGHT TO SUE AND RECOVER FOR ANY PAST INFRINGEMENTS THEREOF.*

THE AGREEMENT SHOULD CONTAIN ADDITIONAL PROVISIONS TO ENSURE THAT YOU CAN SECURE AND ENFORCE YOUR RIGHTS IN ANY SUCH WORKS AND MAINTAIN OWNERSHIP RIGHTS POST ENGAGEMENT.

INFRINGEMENT ISSUES

PATENT INFRINGEMENT

UTILITY PATENT: INFRINGEMENT OF A UTILITY PATENT IS DETERMINED BY COMPARING THE PRODUCT OR METHOD WITH THE CLAIMS OF THE PATENT. IF THE PRODUCT OR METHOD MEETS EACH AND EVERY LIMITATION OF AT LEAST ONE CLAIM, IT LITERALLY INFRINGES THE PATENT. EVEN IF THE PRODUCT OR METHOD DOES NOT LITERALLY MEET ALL THE CLAIM LIMITATIONS, IT MAY STILL INFRINGE UNDER THE DOCTRINE OF EQUIVALENTS IF IT IS INSUBSTANTIALLY DIFFERENT FROM AT LEAST ONE OF THE CLAIMS.

DESIGN PATENT: INFRINGEMENT OF A DESIGN PATENT IS DETERMINED BY COMPARING THE PRODUCT WITH THE DRAWINGS IN THE DESIGN PATENT. IF THE RESEMBLANCE IS SUCH THAT IN THE EYE OF AN ORDINARY OBSERVER, GIVING SUCH ATTENTION AS A PURCHASER USUALLY GIVES, TWO DESIGNS ARE SUBSTANTIALLY THE SAME, THE DESIGN PATENT IS INFRINGED.

GUIDELINES

1. DETERMINING INFRINGEMENT REQUIRES READING THE CLAIMS, THE SPECIFICATION OF THE PATENT, AND THE PROSECUTION HISTORY (THE PATENT OFFICE'S FILE FOR THE APPLICATION)—USUALLY AVAILABLE ON THE PATENT OFFICE WEBSITE.

2. ALWAYS CHECK THE PAIR SYSTEM TO MAKE SURE THAT THE PATENT IS STILL IN FORCE AND HAS NOT EXPIRED FOR FAILURE TO PAY MAINTENANCE FEES.

TRADEMARK INFRINGEMENT

INFRINGEMENT OF A TRADEMARK IS DETERMINED BY EVALUATING WHETHER THE MARK IS "CONFUSINGLY SIMILAR" TO A PRIOR MARK. A NUMBER OF FACTORS GO INTO THE DETERMINATION OF CONFUSING SIMILARITY, INCLUDING:

1. SIMILARITY OF THE MARKS;
2. SIMILARITY OF THE GOODS AND SERVICES ON WHICH THE MARKS ARE USED;
3. CHANNELS OF TRADE IN WHICH THE MARKS ARE USED, INCLUDING HOW THE PRODUCT OR SERVICES ARE ADVERTISED;
4. TYPES OF OUTLETS WHERE THE PRODUCTS OR SERVICES ARE SOLD; AND
5. OVERLAP OF CUSTOMERS OR POTENTIAL CUSTOMERS, AND THE TYPE AND SOPHISTICATION OF THE CUSTOMERS.

EVEN IF THERE IS NO LIKELIHOOD OF CONFUSION, THE NEW MARK MAY DILUTE THE DISTINCTIVENESS OF A MARK EITHER BY BLURRING ITS DISTINCTIVENESS OR TARNISHING ITS REPUTATION, CREATING LIABILITY FOR ITS ADOPTER.

COPYRIGHT INFRINGEMENT

COPYRIGHT INFRINGEMENT IS DETERMINED BY WHETHER PROTECTABLE EXPRESSION HAS BEEN COPIED. BECAUSE COPYING IS HARD TO PROVE DIRECTLY, THE COPYRIGHT OWNER USUALLY ONLY HAS TO PROVE THAT THE ALLEGED INFRINGER HAD ACCESS TO THE COPYRIGHTED WORK AND THAT THE ACCUSED WORK IS SUBSTANTIALLY SIMILAR TO THE COPYRIGHTED WORK. THE ACCUSED INFRINGER HAS TO PROVE THAT THERE WAS NO COPYING.

NOT ALL USES OF A COPYRIGHT WORK ARE INFRINGEMENTS, AND THE LAW RECOGNIZES AND EXCUSES CERTAIN "FAIR" USES OF A COPYRIGHTED WORK. FAIR USE CONSIDERS:

1. THE PURPOSE AND CHARACTER OF THE USE, INCLUDING WHETHER SUCH USE IS OF COMMERCIAL NATURE OR IS FOR NONPROFIT EDUCATIONAL PURPOSES;

2. THE NATURE OF THE COPYRIGHTED WORK;

3. THE AMOUNT AND SUBSTANTIALITY OF THE PORTION USED IN RELATION TO THE COPYRIGHTED WORK AS A WHOLE; AND

4. THE EFFECT OF THE USE UPON THE POTENTIAL MARKET FOR, OR VALUE OF, THE COPYRIGHTED WORK.

TRADE SECRET MISAPPROPRIATION

There is no "infringement" of a trade secret. Rather, federal and state trade secret law protects against the use of "misappropriation" — using improper means to acquire the trade secret, such as breaching a confidentiality agreement, bribery or theft.

Independently discovering the trade secret or reverse engineering the trade secret from publicly available information, however, is not misappropriation.

ENFORCEMENT

THE DECISION TO ENFORCE YOUR INTELLECTUAL PROPERTY RIGHTS SHOULD NOT BE MADE LIGHTLY.

THERE IS, OF COURSE, THE MATTER OF COST, BOTH IN TERMS OF LEGAL FEES AND IN EMPLOYEE DISTRACTION. THE MERE REFERENCE TO INTELLECTUAL PROPERTY RIGHTS MAY PROMPT AN INFRINGER TO SUE YOU FOR A DECLARATION THAT YOUR RIGHTS ARE INVALID OR NOT INFRINGED. YOU MAY ALSO PROVOKE COUNTERCLAIMS FOR OTHER, UNRELATED DISPUTES BETWEEN THE PARTIES.

ASSERTING INTELLECTUAL PROPERTY RIGHTS ALSO OBLIGATES THE OWNER TO FOLLOW UP OR RISK LOSING THOSE RIGHTS THROUGH THE DOCTRINES OF *LACHES* (AN UNREASONABLE DELAY IN ASSERTING RIGHTS) OR *ESTOPPEL* (A FAILURE TO FOLLOW UP THAT THE ACCUSED INFRINGER RELIES UPON).

FINALLY, YOU SHOULD EXPECT THAT YOUR ASSERTION OF RIGHTS WILL BE PUBLICIZED AND JUDGED IN THE COURT OF PUBLIC OPINION.

THE CEASE AND DESIST LETTER

THE KNEE-JERK REACTION UPON DISCOVERY OF A SUSPECTED INFRINGEMENT IS TO SEND A CEASE AND DESIST LETTER. WHILE THIS ULTIMATELY MAY BE THE CORRECT STRATEGY, THERE ARE A NUMBER OF THINGS THAT MUST BE CONSIDERED BEFORE THE LETTER IS SENT.

SENDING A CEASE AND DESIST LETTER

PROS	CONS
OFTEN EFFECTIVE.	YOU MUST BE PREPARED TO FOLLOW UP.
RELATIVELY INEXPENSIVE.	THE RECIPIENT MAY SUE YOU.
LETTER MAY GENERATE DESIRED PUBLICITY.	THE LETTER MAY GENERATE UNWANTED PUBLICITY.
RECIPIENT MAY STOP INFRINGING ACTIVITY.	THE RECIPIENT MAY RAISE OTHER UNRELATED MATTERS.
LETTER MAY SERVE AS BASIS FOR ASSERTING CONTINUED INFRINGEMENT IS WILLFUL.	STATE LAWS RESTRICT CEASE AND DESIST LETTERS.

RECEIPT OF A CEASE AND DESIST LETTER

CEASE AND DESIST LETTERS WORK BOTH WAYS. CONSIDER THE FOLLOWING ACTIONS IF YOU SHOULD RECEIVE A CEASE AND DESIST LETTER:

- <u>INVESTIGATE</u>: IF YOU RECEIVE SUCH A LETTER, YOU SHOULD IMMEDIATELY INVESTIGATE THE CLAIM.

- <u>RESPONSE</u>: YOU SHOULD NOT RESPOND TO A LETTER UNTIL YOU HAVE AN UNDERSTANDING OF THE VALIDITY OF THE ASSERTED RIGHTS AND THE LEGITIMACY OF THE INFRINGEMENT CLAIM.

- <u>CONTINUED INFRINGEMENT</u>: CONTINUED INFRINGEMENT WITHOUT JUSTIFICATION AFTER RECEIPT OF NOTICE OF INFRINGEMENT MAY BE REGARDED AS WILLFUL INFRINGEMENT, POSSIBLY SUBJECTING YOU TO INCREASED DAMAGES AND ATTORNEYS' FEES. YOU SHOULD PROMPTLY SATISFY YOURSELF THAT THE ASSERTED RIGHTS ARE NOT VALID OR ARE NOT INFRINGED BEFORE CONTINUING.

- <u>OPINION OF COUNSEL</u>: AN OPINION OF COUNSEL IS NOT ABSOLUTELY ESSENTIAL, BUT IT CAN BE VERY VALUABLE IN DEFENDING AN ALLEGATION OF WILLFUL INFRINGEMENT.

CORRESPONDENCE AND RECORDS

WHILE YOU SHOULD ALWAYS BE CAREFUL IN YOUR CORRESPONDENCE AND RECORD KEEPING, WHEN IT APPEARS LIKELY THAT THERE WILL BE LITIGATION, YOU MUST BE DOUBLY CAREFUL.

GUIDELINES

1. RESTRICT EMAIL COMMUNICATION AS MUCH AS POSSIBLE.

2. TELEPHONE COMMUNICATION IS PREFERRED BECAUSE ALL WRITTEN CORRESPONDENCE, SOMETIMES EVEN WITH COUNSEL, MAY BE DISCOVERABLE.

3. YOUR COUNSEL WILL LIKELY ADVISE YOU TO PUT A "LITIGATION HOLD" ON YOUR PHYSICAL AND ELECTRONIC FILES. ANY LOSS OR DESTRUCTION OF RECORDS FROM THIS POINT ON, CALLED "SPOLIATION," CAN RESULT IN SEVERE SANCTIONS BY A COURT, INCLUDING FINES AND/OR DISMISSAL OF THE CASE.

YOUR COMPUTERS AND DATA

FEDERAL AND STATE LAWS, SUCH AS THE COMPUTER FRAUD AND ABUSE ACT (18 U.S.C. § 1030), PROTECT YOUR COMPUTER SYSTEM AND DATA FROM TAMPERING. THE KEY TO LIABILITY UNDER THESE STATUTES IS WHETHER THERE WAS UNAUTHORIZED ACCESS TO THE SYSTEM. YOU MUST THEREFORE MAKE THE LIMITS OF ACCESS CLEAR.

GUIDELINES

1. LIMIT ACCESS: MAKE SURE YOU LIMIT ACCESS TO YOUR COMPUTER SYSTEMS BY EMPLOYEES AND CONTRACTORS. ADD A MESSAGE, SUCH AS THE FOLLOWING:

   YOU ARE ONLY AUTHORIZED TO ACCESS THE COMPUTERS AND COMPUTER DATA OF THE COMPANY DURING NORMAL BUSINESS HOURS, FOR THE SOLE AND EXCLUSIVE BENEFIT OF THE COMPANY, AND ANY OTHER ACCESS OF USE OF THE COMPANY'S COMPUTERS AND COMPUTER DATA IS UNAUTHORIZED AND EXPRESSLY PROHIBITED.

2. REMIND: REMIND EMPLOYEES OF THIS POLICY, FOR EXAMPLE ON YOUR LOG-ON SCREENS.

3. ENFORCE: ENFORCE YOUR POLICY.

YOUR WEBSITE

YOU SHOULD CREATE TERMS OF USE FOR YOUR WEBSITE, PARTICULARLY IF YOU PROVIDE DATA OR OTHER INFORMATION TO CUSTOMERS VIA YOUR SITE OR IF MEMBERS OF THE PUBLIC CAN UPLOAD OR POST INFORMATION TO THE SITE. YOU SHOULD ALSO PROTECT THE INTELLECTUAL PROPERTY SURROUNDING THE SITE.

GUIDELINES

1. TERMS OF USE: IMPLEMENT WELL-THOUGHT OUT TERMS OF USE.

2. RIGHTS: ACQUIRE THE RIGHTS IN YOUR WEBSITE FROM THE DEVELOPER, AUTHORS AND PHOTOGRAPHERS VIA A WRITTEN ASSIGNMENT AGREEMENT.

3. COPYRIGHT: PUT COPYRIGHT NOTICE ON THE WEBSITE. OBTAIN COPYRIGHT REGISTRATION ON PHOTOS, MULTIMEDIA AND TEXT THAT APPEAR ON YOUR WEBSITE.

4. TRADEMARK: REGISTER DISTINCTIVE ELEMENTS OF YOUR WEBSITE AS TRADEMARKS.

5. PATENT: OBTAIN DESIGN PATENTS ON THE BACKGROUNDS, ICONS AND ANIMATIONS OF YOUR WEBSITE.

YOUR ADVERTISING AND PACKAGING

YOU SHOULD MAKE SURE THAT YOU EITHER OWN, OR HAVE PERMISSION TO USE, ALL OF THE TEXT, IMAGES AND GRAPHICS THAT YOU USE IN YOUR ADVERTISING, PACKAGING AND PROMOTIONAL MATERIALS. IF YOU HIRED OUTSIDE COPYWRITERS, PHOTOGRAPHERS AND ARTISTS, YOU CAN AND SHOULD OBTAIN AN ASSIGNMENT OF THE COPYRIGHT IN SUCH WORKS.

GUIDELINES

1. PROTECTION: PROTECT THE INTELLECTUAL PROPERTY IN THE ADVERTISING AND PACKAGING, PAYING PARTICULAR ATTENTION TO COPYRIGHTS AND TRADEMARKS.

2. ACQUIRE RIGHTS: ACQUIRE ALL RIGHTS IN THE ADVERTISING AND PACKAGING FROM ALL PERSONS AND FIRMS WHO PARTICIPATE IN THEIR CREATION.

3. COPYRIGHT NOTICE: USE COPYRIGHT NOTICE ON ALL ADVERTISING AND PACKAGING.

4. TRADEMARK USE: MAKE SURE THAT YOUR TRADEMARKS ARE PROPERLY USED AND IDENTIFIED. ALSO MAKE SURE THAT ANY REFERENCES TO THIRD PARTY TRADEMARKS ARE ACCURATE, TRUTHFUL AND REFLECT THE OWNERSHIP AND STATUS OF THE MARK.

CHECKLIST

You should carefully review your advertising, promotional materials and packaging before you publish them. Consider the following:

- ☐ Does it contain any unsearched marks, taglines or slogans?
- ☐ Are all marks properly identified?
- ☐ Are all marks properly used?
- ☐ Are third party marks properly used and are appropriate disclaimers made?
- ☐ Have the appropriate consents and permissions been obtained?
- ☐ Have all claims for product function and performance been vetted?
- ☐ Are all patent markings correct?
- ☐ Are all warranties and guarantees intentional?

YOUR EMAIL

EMAIL OFTEN PLAYS A PROMINENT ROLE IN LAWSUITS WHERE YOU ARE SEEKING TO ENFORCE YOUR INTELLECTUAL PROPERTY OR DEFENDING AN ALLEGATION OF INFRINGEMENT. YOU SHOULD ASSUME THAT EVERY EMAIL YOU SEND OR RECEIVE WILL BE TURNED OVER TO AN OPPONENT IN LITIGATION, AND YOU WILL THEREFORE WANT TO ACT ACCORDINGLY.

GUIDELINES

1. PROFESSIONAL: KEEP BUSINESS EMAIL PROFESSIONAL. (WRITE AS IF YOUR MOTHER WERE READING OVER YOUR SHOULDER.)

2. PURPOSE: CONSIDER THE PURPOSE OF THE COMMUNICATION.

3. AUDIENCE: CONSIDER THE AUDIENCE/RECIPIENTS.

4. FACTUAL: BE FACTUAL. WHERE OPINION IS CALLED FOR, IDENTIFY IT AS OPINION, AND MAKE SURE THAT IT IS GERMANE TO THE ISSUES. DON'T GIVE AN OPINION YOU ARE NOT QUALIFIED TO GIVE.

5. EMPHASIS: MAKE YOUR POINT, BUT AVOID EXTREME EMPHASIS!!!

6. SEPARATE: KEEP BUSINESS AND PERSONAL MESSAGES SEPARATE.

7. CHARACTERIZATION: CONSIDER HOW YOUR CHARACTERIZATION OF THE COMPANY AND ITS ACTIVITIES WOULD BE PERCEIVED BY AN OUTSIDER. DO NOT MAKE MEAN OR DEMEANING REFERENCES TO OTHERS.

8. EVIDENCE: CONSIDER HOW THE EMAIL WOULD LOOK AS AN EXHIBIT AT A DEPOSITION OR TRIAL, BECAUSE THAT IS WHERE YOU'LL SEE IT AGAIN.

CONTACT US

DETROIT METRO
5445 CORPORATE DR.
SUITE 200
TROY, MI 48098
PHONE: 248.641.1600
FAX: 248.641.0270

ST. LOUIS METRO
7700 BONHOMME AVE.
SUITE 400
CLAYTON, MO 63105
PHONE: 314.726.7500
FAX: 314.726.7501

WASHINGTON, DC METRO
11730 PLAZA AMERICA DR.
SUITE 600
RESTON, VA 20190
PHONE: 703.668.8000
FAX: 704.668.8200

DALLAS METRO
2801 NETWORK BLVD.
SUITE 600
FRISCO, TX 75034
PHONE: 469.777.5400
FAX: 469.777.5401

HARNESS IP
INTELLECTUAL PROPERTY LAW SINCE 1921

WWW.HARNESSIP.COM

HARNESS IP
INTELLECTUAL PROPERTY LAW SINCE 1921