



# Intellectual Property (IP) Checklist

## Management systems

- 1) Appoint an Intellectual Property Manager.
- 2) Budget for obtaining and defending your IP rights and avoiding infringement of third-party rights.
- 3) Establish an IP awareness program for your management and staff.
- 4) Conduct regular IP portfolio reviews, and assess business value of each IP asset in terms of:
  - > providing competitive business advantage
  - > generating revenue
  - > necessity to attracting investment.
- 5) Review all current projects for emerging innovations, brands and other intellectual property.
- 6) Establish and maintain an IP register.
- 7) Incorporate IP tollgates into your product development process.

## Copyright

- 1) Retain records relating to creation of any work that may be entitled to copyright protection, such as:
  - > textual material
  - > computer programs
  - > artistic works
  - > musical works
  - > published works
  - > dramatic works
  - > film and sound recordings.
- 2) Where work is created by a third party, obtain an assignment of copyright.
- 3) Ensure that all copies of the work are marked with a copyright notice: © year of first publication/copyright owner's name.

## Confidential information

- 1) Identify what is confidential and keep an original copy secure.
- 2) Implement measures to ensure information is kept confidential within your organisation, including:
  - > establishing physical security
  - > limiting access and copies
  - > ensuring employees are aware of and agree to keep information confidential.
- 3) Have third parties sign a confidentiality agreement before giving access.
- 4) Mark all documents and other material containing confidential information **CONFIDENTIAL**.

## Ownership and licensing

- 1) If ownership of IP is to be joint between two or more parties, agree on rights of each party to:
  - > licence
  - > assign
  - > litigate.
- 2) Document any licence arrangement to include provisions relating to:
  - > parties to arrangement
  - > property being licensed
  - > scope – exclusive, sole, non-exclusive
  - > geographic coverage
  - > warranties and exclusions
  - > infringement responsibilities
  - > payments
  - > duration.

## Employees/consultants

- 1) Have employees/consultants enter into an agreement to:
  - > keep information confidential
  - > assign to your organisation any IP that they may create or develop for the organisation.
- 2) Conduct exit interview with departing employees and ensure retention or return of all documents to organisation.



## Patents

- 1) Check that your product or service does not infringe any third-party patents, including conducting patent infringement search(es).
- 2) Remain alert to unauthorised exploitation of your invention by third-parties and consider preventative action, by monitoring activities of competitors; identifying breaches; assessing impact on business.
- 3) Thoroughly document a potentially inventive idea, and have the document read, signed and dated by a witness (who has entered into a non-disclosure agreement with you).
- 4) Document the progress of any developmental work.
- 5) Delay offers to sell or publicly disclose the invention until the patent application is filed.
- 6) Conduct a search to form a preliminary view on patentability of the invention.
- 7) File Australian and foreign patent applications, as appropriate.
- 8) Routinely assess business value of patent and patent application portfolio.

## Designs

- 1) Check that your product does not infringe any third-party design registrations, including conducting design infringement search(es).
- 2) Remain alert to unauthorised manufacture, sale or use of your design by third-parties and consider preventative action, by monitoring activities of competitors; identifying breaches; assessing impact on business.
- 3) Thoroughly document a potentially new or original design, and have the document read, signed and dated by a witness (who has entered into a non-disclosure agreement with you).
- 4) Document the progress of any developmental work.
- 5) Delay offers to sell or publicly disclose the design until the design application is filed.
- 6) Conduct a search to form a preliminary view on registrability of the design.
- 7) File Australian and foreign design applications, as appropriate.
- 8) Routinely assess business value of design application and registration portfolio.

## Trade marks

- 1) Choose a trade mark that is distinctive, not descriptive.
- 2) Before adopting a mark, conduct a search to determine if it is available, and the rights of other parties are not infringed.
- 3) Register the mark in Australia and in foreign countries to obtain more easily enforceable protection.
- 4) Remain alert to unauthorised use of the trade mark by third-parties and consider preventative action by  
> monitoring activities of competitors; identifying breaches; assessing impact on business.
- 5) Use marks as adjectives, not as nouns or verbs in advertising and marketing materials.
- 6) Do not copy or imitate in any way another company's names, trade marks, logos or get up.
- 7) Use the trade mark regularly and in a consistent format and rendition.
- 8) Distinguish the trade mark from surrounding words and images.
- 9) Always use <sup>™</sup> or ® (if registered) adjacent the trade mark to indicate propriety rights are claimed in the mark.

**If you require any further details, please contact Phillips Ormonde Fitzpatrick  
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