

## *Intellectual Property Practice*

Today, both small and large corporate clients benefit from adequate management of intellectual property. Intellectual property plays four major roles. Patents, copyrights, and trademarks provide a company with a right to assert a marketplace position. Intellectual property positions may also be used to defend against accused infringement. Compliance, such as software and copyright compliance is a part of good corporate governance. Business dealings often carry a significant intellectual property component that must be properly handled, such as non-disclosure agreements, licenses, and employee invention agreements.

Affordable access to intellectual property counsel for large and small corporate clients provides a dedicated and tailored approach to an individual company's specific intellectual property needs.

### **Basic Intellectual Property Protection**

#### *Patents - Trademarks - Copyrights*

Most businesses offer products or services using logos, names, or slogans. Unfortunately, many do not seek protection until they wish to sell their business or when they discover their logo, name, or slogan used by someone else. Timely, cost-effective trademark protection is generally available within Texas, the United States, or internationally. Advanced trademark protection may even include colors, jingles, or smells. Federal protection is offered for the service of certification of products or services.

Many businesses innovate new designs or inventions. Designs and inventions may be protected with patents. Artistic designs, such as jewelry and patterns, may be protected by copyright registration. Manuals, audio programs, or training videos may also be protected by copyright registration.

Software development may be protected by a combination of copyright, trademark, and patent protection.

### **Compliance**

#### *Software License Audit - Web Site Audit - Product Audit - Marketing Audit*

Intellectual property compliance takes many forms, which may be addressed with a compliance audit. An Intellectual Property compliance audit is a systematic review of all or part of a company's intellectual property. The goal of a compliance audit is to provide valuable information regarding possible infringement or breach on the part of the company or third parties.

Most common are questions about the use of software in a company. Software license violations create liability exposure. Other compliance issues include misuse of copyrighted material, proper web site Terms-of-Use and Privacy Agreements, employee invention agreements, web site style, web site art and text, domain name ownership, license agreements, insurance coverage, and potential infringement of patents, trademarks, or marketing materials of others.

### **Assessment**

#### *General Intellectual Property Audit*

Sometimes it is not clear to corporate management what basic intellectual property protection is needed. The goal of a general intellectual property audit is to look at the current products, services, licenses, and intellectual property held to identify the rights owned or used by a company and consider appropriate ways to protect them from infringement. From the managers' perspective, a general intellectual property audit helps identify and focus on a company's core assets, assisting in the growth strategy while optimizing output from existing intellectual property rights.

Employees may be making designs or improvements, which are not being seen as inventions. Trademarks may be under protected in their markets. Domain names may be exposed or held by others. A general intellectual property audit may be used to assess gaps in basic intellectual property protection as well as educate managers and key employees in identifying intellectual property opportunities.

## **Accused Infringement**

*Cease and Desist Letter - Copyright Violation - Trademark - Patent - Internet Violations*

Both large and small corporate clients are exposed to potential claims of infringement. Claims of infringement may come in the form of a letter or actual legal action. Such a claim can instantly expose a client to astounding potential liability. The early steps taken can set the course for ultimate cost. Responding to an infringement letter is no exception.

For matters not easily resolved, a combination of legal intervention and approach may be used to manage risk exposure. For example, in some cases it is possible to focus on avoiding litigation through defensive negotiation that is concurrently maintaining preparation for litigation.

## **Assertion**

*Copying Your Product - Design - Web Site - Brand Name - Software - Advertising - Business*

Potential competitors may knowingly or unknowingly copy some aspect of a client's business. This may include outright infringement of a patented product or service, copying written material or designs, using a business' slogan, logo, or brand name, lifting quality web site style or art or text, or improperly acquiring trade secrets.

Accusing a business of infringement is a serious matter, which could lead to legal complications if the accusation is false or threatening. Typically, any alleged infringement should reviewed prior to writing any letter or making any claim of infringement.

## **Business Dealings**

*Non-Disclosure Agreements - Non-Compete Agreements - Licensing - Purchases  
Mergers, Divestitures, Acquisitions - Due Diligence*

Business dealings may involve buying, selling or licensing of intellectual property. Some of the most important agreement terms involve licensing a product from a supplier, which may propose significant intellectual property obligations.

Just a few of the potential agreement situations include:

- Software license agreements, whether shrink-wrap or requiring written signature
- Non-disclosure Agreements with potential business venturers, contractors
- Non-compete Agreements with employees, contractors, contracting companies
- Invention Agreements with employees, contractors, contracting companies
- License Agreements with suppliers for new product lines
- Remarketing Agreements with suppliers or national Internet companies
- Advertising Agreements, including Internet-based advertising and search engine promotion
- Web development Agreements, ownership of the domain, web site and web content
- Sale of product or service
- Sale of product or service to resellers
- Due Diligence on purchase of a portfolio, including patents, licenses, brand names, software
- Sale of portfolio or asset, including license assignments, brand names, patents