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IP Health
Checklist



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Intellectual property ('IP') ownership and protection is key to providing a market advantage for businesses.

Whether through an innovative product or process, a novel design or distinctive brand, differentiating it from competitors and providing a sustainable edge in a competitive environment means it is important that exclusive rights are obtained and maintained.

1. Have you identified all of the IP of importance to you that provides a commercial advantage?

- ☐ Business name
- ☐ Innovative products, processes or services (including product designs and important functional features)
- ☐ Trade marks including logos and graphics used in association with the product, process or service
- ☐ Domain names
- ☐ Trade secrets
- ☐ Databases including customer and client lists
- ☐ Internal business processes
- ☐ Artwork
- ☐ Distinctive packaging designs
- ☐ Exclusive agreements with suppliers and/or distributors
- ☐ Customised software, macros and electronic forms and systems
- ☐ Website and social media accounts

2. Do you own all of your IP?

- ☐ Has all IP created externally been assigned to you upon its creation/completion?
- ☐ Have the exclusive agreements been reduced to writing with your business entity as a party?
- ☐ Are the employees' creations covered by IP clauses in employment contracts?
- ☐ Have you granted rights to others including distributors that might impact on IP ownership?
- ☐ In whose name are the social media accounts, domains, hosting agreements etc?

3. Have you considered registering the following?

- ☐ Novel functional features of products/processes as patents
- ☐ Novel shape or design of products as registered designs
- ☐ Business names and product names as word trade marks
- ☐ Distinctive, non-functional shapes of products as shape trade marks
- ☐ Distinctive logos, graphical artworks and product get up as device trade marks
- ☐ Scents, sounds and colours that have become synonymous with the offering of your goods/services in the marketplace

4. If there is a group of companies or entities, is your IP owned by the right entity?

- ☐ Has the IP remained in the name of an older entity (potentially now deregistered) after business moved to a new structure?
- ☐ Is the IP in the right entity for asset protection or is it in the name of a trading entity?
- ☐ If IP is co-owned between parties and entities – have the implications been considered?

5. Are you prepared to/have you enforced your IP?

- ☐ Have you marked your goods/processes/services with your registered IP rights – e.g. Patent Pending, Aust. Patent No, TM, ®, Registered Design?
- ☐ Do you monitor the marketplace for infringement?
- ☐ Have you identified infringers in the marketplace and taken no action?
- ☐ Do you send letters of demand to all infringers?

6. Do you monitor IP registrations of others?

- ☐ Do you monitor the patent, designs and trade mark databases for conflicting IP applications made by competitors or others in the market and oppose them where possible?
- ☐ Do you conduct searches of IP registers to identify state of the art technology and trends in the provision of goods and services?
- ☐ Do you conduct searches of patents and design databases to identify technology that could be implemented by you royalty-free in Australia?
- ☐ Do you identify gaps in the IP landscape that you can seek to fill through your own R&D?

7. Do your new products and/or processes infringe the IP of third parties? Have you conducted a freedom to operate search?

- ☐ Have you checked whether a new business name infringes a third party TM before commencing use?
- ☐ Have you checked whether the importation or sale of a new product or service would infringe on the registered designs or patents of third parties before commencing use?
- ☐ Have you checked whether the trade marks to be used in association with the new product or service don't infringe the TMs of others before commencing use?

8. Are you planning to export your product, process or service?

- ☐ Have you conducted a check or search with respect to the IP applicable in the export destinations for your product/service?
- ☐ Have you registered your TM and patents/registered designs in the export markets including any foreign language equivalent TM?
- ☐ Have you checked you don't need to register copyright or take any steps that you would not need to take in Australia with respect to any export markets?

9. Have you checked over existing agreements to see where your company stands with regard to IP?

- ☐ Do contractor agreements provide that IP developed by them is owned by you in exchange for remuneration?
- ☐ Do distributor agreements that provide for the authorised use of a TM as a business name have the goodwill generated in the TM accrued to you as TM owner?
- ☐ Do licence agreements (including licence grants in distributor or manufacturer agreements) ensure that any improvements made by licensees to your products/services are owned by you?
- ☐ Does every employee have an IP clause in their contract agreeing that IP created during and for work is owned by you?
- ☐ Do you warrant that your product/process/service does not infringe third party IP in the absence of having obtained freedom to operate advice to minimise your exposure?
- ☐ If a third party infringes a licenced IP right, who will pay the legal costs in pursuing the infringer; you or the Licensee?
- ☐ If your licensed trade mark or product/process/service infringes an IP right of a third party, who will pay the legal defence costs; you or the Licensee?

For more information

If you have questions about any of the areas or items above, and would like assistance with your IP, reach out to us with your details and area of interest via the office emails on the back page, and one of our specialists will be in touch.

To explore our services further, please go to spruson.com

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