



# IP HEALTH CHECKLIST

### 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 – eg. 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?

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