

Managing Intellectual Property



Patents, trade secrets, know-how, copyrights, and trademarks can be crucial to your business. Managing this intellectual property can make the difference between fortune and failure. Leech Tishman offers ten recommendations for protecting what belongs to you.

General

Recommendation #1

Obtain written assignments of all inventions and copyrights from employees and third-party vendors including consultants, advertising agencies, and photographers, and have these assignments reviewed by your attorney.

Recommendation #2

When adopting anything new, such as technology, a trademark, or software, contact your attorney about conducting a right-to-use study to avoid infringement.

Inventions & Trade Secrets

Recommendation #3

Assume that any disclosure to a third party, including a customer, a vendor, a consultant, or a competitor, will not remain confidential. Confidentiality agreements offer some degree of protection, but they are not guaranteed against improper disclosure.

Recommendation #4

Discussing an idea in the presence of others, such as actual/prospective customers, vendors, or consultants, can result in a claim of co-ownership of your idea. Avoid this situation by listening to the challenge presented, and then by conducting your problem-solving in private.

Recommendation #5

When negotiating an agreement, avoid terms that may limit your ability to compete. Terms that require careful scrutiny include:

- An agreement stating that ownership of an invention does not belong to you.
- A software or website development agreement that does not explicitly provide for your ownership of the software.
- Prohibitions against engineering by you.

- Confidentiality clauses.
- Unreasonable restrictions on the use of deliverables.
- Continuing obligations to use the vendor, e.g., for software modifications or hosting.
- Limitations on the other party's indemnification obligations, e.g., no indemnifications for infringement of patents, copyrights, or trade secrets.

Recommendation #6

Protect your inventions by documenting all improvements and promptly disclosing potentially patentable inventions to your patent attorney. Do not offer to sell the improvements and do not publicly disclose them until your attorney has considered the feasibility of patent and trade secret protection.

Copyrights & Trademarks

Recommendation #7

Protect your copyrights by using the proper notice on all copyrightable works, including software, advertisement, brochures, and artwork. Check with your attorney to determine if the copyrights should be registered.

Recommendation #8

Before adopting a trademark or service mark, have a search conducted to make certain that the mark, and the corresponding domain name, is available. If the mark is available, register the mark and use it properly. Do not allow third parties to use your mark without a written license agreement.

Litigation

Recommendation #9

If you have a claim against another party, proceed promptly. If you delay, you could lose your rights.

Recommendation #10

Contact your attorney if you receive a cease and desist letter. Your attorney may lessen the possibility of a lawsuit being filed against you, and failure to consult with your attorney may expose you to increased damages for willful infringement. If actually sued, contact your attorney promptly. Failure to timely respond to a lawsuit can have serious, and costly, ramifications.

About Leech Tishman

Where Innovation Finds Protection[®]

At Leech Tishman, we recognize that innovation is our clients' competitive edge, and this innovation needs protection. As intellectual property attorneys, we specialize in offering powerful protection for unique ideas.

Areas of Expertise

We are an experienced, full-service intellectual property firm that provides the following services:

- Patent, trademark, copyright, and antitrust litigation in all areas of the country
- Patent, trademark, and copyright prosecution
- Opinion and expert testimony work
- IP licensing and portfolio management
- Foreign patent and trademark prosecution management
- IP due diligence
- IP alternative dispute resolution
- Confidentiality agreements

Creating Wealth for Our Clients

As intellectual property law attorneys, we can accomplish what most attorneys cannot; we can help create wealth for our clients. Patents, trademarks, copyrights, and trade secrets are assets that can be worth many times their costs. By using our skills and experience to protect innovation, we help optimize returns for our clients.

Our intellectual property attorneys stay current with the changes in the law regarding patents, trademarks, and copyrights internationally and use various systems including the Madrid Protocol, Paris Convention Treaty, and the European Community Trademark System.

Leech Tishman's international service reaches individuals and corporations in foreign countries seeking protection of their intellectual property in the United States. Several of our clients are based in Asia, as we can communicate fluently both in Mandarin and Cantonese.

Leech Tishman Fuscaldo & Lampl is a full-service law firm dedicated to assisting individuals, businesses, and institutions. Leech Tishman offers legal services in alternative dispute resolution, bankruptcy & creditors' rights, construction, corporate, employee benefits, employment, energy, environmental, health & safety, estates & trusts, family law, government relations, immigration, insurance coverage & corporate risk mitigation, intellectual property, internal investigations, international legal matters, litigation, real estate, and taxation. Headquartered in Pittsburgh, PA, Leech Tishman also has offices in Chicago, Los Angeles, New York and Wilmington, DE. For more information call 412.261.1600 or visit us at www.leechtishman.com.