

## IP Due Diligence Checklist

### Patents

- Obtain technical description of key products and processes.
- Assess procedures for identifying patentable inventions and for ensuring applications are timely filed.
- Obtain a complete list of patents and applications in all countries.
- Confirm that assignments have been recorded for all patents and applications.
- Identify any security interests granted against any patents and applications.
- Obtain patent maintenance and annuity fee records.
- For patents of special interest, require all prior art in company's files and determine whether there are any validity issues.
- Obtain any correspondence by or from the company accusing others of infringing patents and/or offering licenses under patents.
- Identify and review all licence agreements, covenants not to sue, indemnification agreements, settlement agreements and releases.
- Review the results of patentability and right-to-use searches.
- Review all records of audits conducted by or against the company pursuant to any type of IP agreement.
- Search for patents and patent applications in the names of key personnel, consultants, and principal investigators.
- For patents of special interest, obtain prosecution histories from the Patent Office.
- Departures of key personnel.
- Check employee and consultant agreements and confirm obligations to assign rights, including the right of priority.
- Conduct freedom-to-operate searches for key products and processes.
- Check abandoned applications in same or related fields.

### Trade Marks

- Review all products, marketing, promotional, websites and packaging materials of the company to determine trade mark usage.

- Obtain copies of all domestic and foreign trade mark registrations and registration applications.
- Identify all assertions of trade mark infringement, trade dress infringement passing off, dilution, or unfair competition by or against the company.
- Obtain records of any opposition or cancellation proceedings.
- Review all material trade mark renewal records.
- Obtain results of trade mark searches.
- Confirm ownership and clear title to trade marks, trade names, company names and domain names. Conduct title searches in national and local records.
- Review assignments, licences, covenants not to sue, and security documents, where appropriate.
- Identify any marks that may have been abandoned.
- Identify procedures employed by the company for quality control and monitoring of licensee use of trade marks.
- Conduct independent searches for key trade marks.

### **Copyrights and Designs**

- Identify all key copyright works and any design registrations.
- Review work-for-hire agreements and consultant contracts.
- Evaluate the company's policy for identifying and protecting copyrights and designs.
- Evaluate the company's policy for obtaining copyright clearance to protect against infringement claims.
- Identify all assertions of copyright design infringement by or against the company.
- Review all copyright design assignments, licences, and other transfers. Review records at relevant registries Copyright Office for key copyrights.
- For all transfers of material copyrights designs, determine which individual aspects of the copyright/designs were transferred.
- Check employee and consultant agreements for acknowledgement of status for copyright purposes, and wavers moral rights.
- Identify all relevant recordations of copyrights design by Customs Services.
- Assess adequacy of licences for all software loaded on the company's computers.

### **Trade Secrets**

- Obtain list of material trade secrets.
- Determine whether appropriate confidentiality and non-complete agreements are in place.
- Evaluate adequacy of hiring and exit interviews procedures. Review records for key personnel.
- Evaluate secrecy policies, including physical security, employed by the company.
- Evaluate security policies for computer software and electronic data.
- Consider the impact of recent arrivals or departures of key personnel.
- Review of key know-how licences, technical assistance agreements, and confidentiality agreements.

### **Miscellaneous**

- Consider any potential improper anticompetitive effect or antitrust scrutiny.
- Determine whether any governmental agency has rights to key IP.
- Assess adequacy of insurance coverage against potential intellectual property infringement claims.