

# + Protecting and Profiting from Your Intellectual Property

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# Agenda



- Taking stock of your intellectual property
- How might your intellectual property be at risk when dealing with third parties, including friends, employees, vendors and customers?
- How can inventors and entrepreneurs protect against infringement or other IP-related claims by third parties?

*Note: The information provided is for educational purposes only and is not intended as legal advice as to a particular situation.*



# IP Issues in Collaborative Contexts



- Friends and Relatives
- Employees
- Consultants and Vendors
- Customers



# Joint Authors or Co-Inventors

- Can each use or license out patent or copyright, subject to obligation to account to the other for profits
- Rights can be assigned or limited by agreement





# IP and Friends or Relatives



- Friends and relatives
  - Inspire, initiate or contribute to creative ideas
  - Make key introductions
  - Provide financial support
  - Provide collateral services, such as designing logos or illustrations, building websites, editing, bookkeeping, sales assistance



# IP and Friends and Relatives



- Clarify ownership of IP
- Clarify status of legal relationship
- Protect confidentiality
- Clarify expectations regarding compensation



# IP in the Employment Context



- Employer owns rights to work product created in the scope of employment due to “work for hire doctrine”
- Issues arise due to:
  - Existing agreements with prior employers or other third parties
  - Prior or independent developments by employees
  - Employee failure to respect employer IP rights



# IP and the Vendor or Consultant Relationship



- Default rule is that consultant or vendor owns IP rights and licenses to customer
- “Work for hire” doctrine applies if there is written agreement and work falls within eligible categories
- Otherwise, consultants can assign their rights





# IP and the Vendor or Consultant Relationship



- Warranty of originality
- Have consultant or vendor represent that it has necessary rights to convey
- Obtain IP rights indemnity
- Use non-disclosure agreement to protect trade secrets
- Consider use of exclusivity provisions
- Don't exceed limitations in license



# IP and the Customer Relationship

- Clarify whether commissioned, suggested or requested inventions or products are “works for hire” or whether IP rights to be “assigned”
- If so, can author or inventor make portfolio or advertising use of work
- Allocate rights in collaborative work product
- Use product evaluation and testing agreements
  - Protect confidentiality of disclosures and results
  - Assign rights in resulting IP





# Conclusion



- Intellectual property laws allocate rights in work product of creative and collaborative endeavors
- IP creates risks and opportunities
- Identify and protect your IP
- Avoid infringing others