

Intellectual Property Best Practice Checklist.

Are you being strategic with your intellectual property? Find out with Stratford Intellectual Property's Best Practice Checklist.

Acknowledging the complexity of intellectual property with a holistic strategy is key to maximizing your portfolio. Innovation is a very rewarding and empowering process for employees when managed cost effectively. Your company can truly harvest the power of intellectual property to significantly increase company valuation.

Optimize your IP strategy by following our comprehensive checklist of best practices for companies at all stages, from inception to maturity. Consistently implementing these practices are critical to the success of any innovative or innovation-based company.

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"Due diligence done correctly is intended to either facilitate an effective negotiation that results in a secure investment or safe-guard the buyer from a dangerous gamble."

—PAUL MONTGOMERY
PROJECT MANAGER



The First 6 Months...to Angel Funding

Intellectual property protection should be proactive – policies and protections should be in place before the first idea is logged or patent is filed.

Day 0–30

- Set up employment agreements between all founders, employees, contractors that include IP assignment clauses and NDA's.
- Treat everything being developed as a trade secret and protect accordingly.
- Set up an ongoing process for signing and keeping track of all NDA's signed by the Company with their expiration date. Limit the number of people who are authorized to sign NDA's.
- Set up an ongoing process to document and maintain an up-to-date log of innovative concepts and who has been creating them using a structured trade secret disclosure form.
- Enforce a clean desk and clean whiteboard policy.
- Minimize disclosure of innovative technical details to an absolutely as needed basis. Only disclose information under an NDA.
- Budget for one (1) provisional filing within the first 6 months.
- Perform a trademark search on USPTO and CIPO site before adopting a visible identity. Use ™ on any identity terms (e.g. company and product names) to show intent to own a trademark.
- Secure any relevant domain names.
- Instruct employees to refrain from writing patentability/infringement/validity opinions on Company's innovations or 3rd party IP.

Day 31-180

- Find a good IP advisor willing to work on a fixed-price basis for drafting and office actions and providing strategic advice without a money clock running. Take into account foreign associate fees and PTO fees.
- Establish company as micro or small entity depending on the situation of the inventors (** requirements for size determination vary by jurisdiction).
- For each innovation, determine if it is to be kept secret, published, or patented.
- Perform a high-level prior art search on key inventions to assess patentability.
- File an umbrella provisional application covering all the innovative concepts to be patented in as much detail as possible, including one claim per innovative concept.
- Periodically assess the need to file other provisional applications based on the updated log of innovative concepts and file accordingly.
- Perform competitive landscape and identify the areas of IP protection opportunities.
- Never discuss any technical details not disclosed in the provisional application(s) to anyone that has not signed an NDA and only on an as needed basis.

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“It's not always just the IP itself that drives the value of a transaction. It is also the quality of the intellectual property's management and organization.”

- JORDAN PYNN
VICE PRESIDENT,
STRATFORD INTELLECTUAL
PROPERTY



To Series A or Commercialization

If not already done, implement the best practices from the “first 6 months” as outlined previously. The activities in this section should be ongoing.

Grow the Assets

- Set portfolio growth objectives and review quarterly.
- Perform quarterly brainstorming sessions with different groups of employees. Ensure that relevant ideas held by employees are disclosed and captured (even those which may not be immediately relevant to operations or product development) using a well-defined invention disclosure process.
- Explicitly value and promote innovative thinking (i.e. bonuses, IP incentive plan, etc.).
- Stay informed of developments in relevant IP landscapes (including competitor activity).
- Strategically target innovation to fill gaps.
- Document all inventions in either Trade Secret Disclosure (TSDf), Record of Invention (ROI) or Invention Disclosure (IDF) forms, depending on stage and strategy.
- Form a patent committee including different functional areas in the company and involve Subject Matter Experts to review TSDfS and ROIs.
- Hold regular patent committee meetings to review the inventions. Catalogue trade secrets and plan patent filings.
- Formalize all provisional applications as soon as possible.

IP Protection

- Consistently use a sign-in book for all visitors.
- Enforce a clean whiteboard policy.
- Ensure systematic shredding of all classified documents.
- Implement detailed IP policy approved by management team.
- IP policy shared with all employees and signed when joining the company. Enforce consistent and careful use of lab books (with page #s).
- Archive lab books of employees leaving the company.
- Assign a single point of contact for IP related issues/questions.
- Implement process to mark “patent pending” and Patent No. marking on all public documents and/or set up and maintain a IP marking web page.
- Employ mechanisms to identify, log, and protect trade secrets.
- Implement a policy on inclusion and tracking of shareware/freeware in products.
- Include copyright statements on all public documents.
- Implement a trade secret protection strategy.

Freedom to Operate

- Maintain IP landscape of competitors' IP.
- Monitor innovation announcements from competitors.
- Sign purchasing contracts with proper indemnification clauses.
- Review key design elements against competitors' IP, plan contingency designs or design round (*Optional – depends on company policies).
- Register key trademarks, mark them with the symbol ® and use them on websites in association with goods and services.

Strategic Portfolio Operations

- Establish and update quarterly importance rating of patent families.
- Establish filing location strategy per patent family + update quarterly based on importance ranking.
- Establish prosecution time strategy per application + update quarterly based on importance ranking.
- Update strategies when business plan is updated.
- File continuation patent application when a US application is allowed.
- Maintain 4Q rolling short- and long-term budget portfolio to include in funding requirement.
- Monthly review of legal bills and track expenses per application/ correlate with budget.
- Maintain IP due diligence package ready to showcase to investors or possible acquirers.
- Review entity status (micro, small, large) depending on growth and contracts.
- Maintain a secure log of trade secrets.
- Include copyright statements on all public documents.
- Implement a trade secret protection strategy.



Post Series A or Preparing for Exit

If not already done, implement the best practices from the “First 6 months” and “To Series A” as outlined previously.

IP Acquisition

- Proactive monthly search for patents available to acquire.
- Proactive monthly search for innovation that can improve products.
- Proactive monthly search for expired patents of interest.

IP Enforcement

- Proactive monthly search for infringers.
- Proactive monthly search for possible licensing opportunities.
- Trademark monitoring: Proactive monthly search for trademark infringement and for trademark applications for the same or a confusingly similar mark.

Portfolio Valuation

- Track portfolio value evolution quarterly.
- Proactively strengthen claims based on known competitors' products.
- Review portfolio quarterly and identify families to divest or allow to lapse.
- Build an inventory of litigation-ready claim charts.



Implement a Better IP Strategy

ABOUT STRATFORD INTELLECTUAL PROPERTY

Stratford Intellectual Property, a division of Stratford Group, is a full-service patent and trademark agency that offers end-to-end IP services covering all types of IP. Our virtual IP department service is offered on a monthly subscription basis where our cross-functional team of IP experts collaborate to proactively and pragmatically develop and implement your IP strategy.

We work with you to ensure it stays in sync with your business objectives to maximize value and reduce risks. Equipping your team with hands-on support, Stratford Intellectual Property delivers you peace of mind as it relates to your intellectual property.

Offering a unique combination of strategic and operational experience to ensure a better implementation of your IP strategy.

Ask us how today.

How Can We Help?

- Looking for help beyond a checklist?
- Seeking a tailor made IP strategy that aligns with your business objectives?
- Looking for peace of mind when it comes to your IP portfolio?
- Need actionable insights and daily operations support?

At Stratford, we believe better is possible, and it's our mission to help clients get there with better strategies, better processes, better technology, better intellectual property protection and better leadership. Our teams have years of practical business experience and deliver customized solutions that help clients realize value, achieve results and build enduring capabilities. Capabilities that leave our clients in better positions to thrive and contribute to the prosperity and vibrancy of their organizations, their teams and their communities.

Contact us: info@stratford.group | Stratford.Group

