

INTELLECTUAL PROPERTY GUIDELINES

INTERNATIONAL IP PROTECTION

Intellectual property (“IP”) is an increasingly important aspect of international transactions. **You should contact the Law Department whenever you are dealing with an intellectual property matter.** The fact that the protections afforded to IP in various jurisdictions differ widely increases the importance of ensuring its protection in those jurisdictions in which both your company and its customers and partners will operate. Furthermore, although some jurisdictions have legislated IP protective measures, cultural, political and economic factors sometimes dictate that these measures are not enforced. For instance, in Asia, although many jurisdictions provide for a system of IP protection, the imperative of obtaining cheap modern technology discourages enforcement of these measures.

Protection of IP rights could require registration in foreign jurisdictions (or in an international registry), creative drafting of licensing agreements, the inclusion of specific representations and warranties in agreements, or other steps.

IP CHECKLIST

1. **In General.** With few exceptions, the legal protections afforded to IP operate on a country-specific basis. You should not assume that the legal protections provided to [COMPANY] IP assets within the US will apply in other countries. Nor should you assume that the processes for obtaining legal protections for [COMPANY] IP within the US are the same as those used in other countries. Instead, prudence dictates that steps are taken to assure that the IP rights of [COMPANY] are adequately protected in each country in which business is conducted involving [COMPANY] IP assets. What follows below is a general checklist of IP-related issues to address when doing business outside of the US.
2. **Employment-related IP Issues.**
 - (a) Require employees and consultants to execute [COMPANY]-approved proprietary information and invention assignment agreements for the nation in which they are working. If no such approved agreement exists, or if the approved agreement is not being used, contact the Law Department to obtain approval before entering into the agreement.

- (b) Confirm that an agreement governing the use and ownership of IP rights exists between [COMPANY] and any foreign subsidiary of [COMPANY] before the subsidiary develops or uses IP rights of [COMPANY].
- (c) Advise employees and consultants that the information they acquire or create is confidential and proprietary to [COMPANY] and is to be treated as such.
- (d) Conduct termination interviews (subject to applicable [COMPANY] HR policies) with departing employees concerning inventions and trade secrets that they may have developed while working for [COMPANY].

3. **Trade Secrets.**

- (a) Require that [COMPANY]-approved non-disclosure agreements (NDAs) for the country in which you are conducting business are in place before disclosing [COMPANY] trade secrets or confidential information to contractors, potential business partners and customers, or other third-parties.
- (b) Clearly mark all documents and files containing information that is not generally known to people outside of [COMPANY] as “CONFIDENTIAL” or “TRADE SECRET.”
- (c) Maintain all information received from third-parties in business discussions in confidence unless you receive written permission to do otherwise.
- (d) Require that a submission agreement approved by the Law Department and specifically governing confidentiality, be signed before accepting any invention disclosure from any outsider.
- (e) Restrict access to areas containing confidential documents or items and, as required, keep sign-in sheets for all entrants to these areas.
- (f) Remember: In general, the law will not give any greater protection to your trade secrets than you do.

4. **Patents.**

- (a) Maintain records of all inventions, and consult the Law Department to evaluate the desirability of seeking U.S. and/or foreign patent protection on those inventions.
- (b) Make no public disclosures or attempts to commercialize any invention before determining whether patent protection will be sought for that invention.
- (c) Seek an opinion of non-infringement or invalidity from the Law Department before you manufacture, use or sell a potentially infringing product.

- (d) Mark all products (and literature regarding products) that are subject to a patent application with proper markings indicating that a patent is “pending” on those goods.

5. **Trademarks.**

- (a) Contact the Law Department to determine whether [COMPANY] has sought registration for its trademarks in any country in which you are asked to conduct business on behalf of [COMPANY] *before* beginning to conduct business in that country.
- (b) Mark all unregistered [COMPANY] trademarks with a “™” and service marks with an “SM.” Mark all registered trademarks with the “®” symbol. Follow all other applicable [COMPANY] trademark usage guidelines for the country in which you are doing business.
- (c) Use [COMPANY] trademarks and service marks as adjectives, and not as nouns, in advertising and brochures.
- (d) Consider recordation of registered trademarks with the U.S. Customs Service in order to prevent unauthorized importation of counterfeit or gray market goods into the United States.
- (e) Inquire as to whether the country-specific domain name for “[COMPANY]” has been registered by [COMPANY] before doing business in any country on behalf of [COMPANY].

6. **Copyrights.**

- (a) Mark all software, advertisements, brochures and other material with the proper copyright notice: “© [year of first publication/creation] [COMPANY]” or “Copyright [year of first publication/creation] [COMPANY]”
- (b) Display the statutory copyright notice with any user interface display that is generated by [COMPANY] software.
- (c) Remember that the copyright in software written by a consultant probably belongs to the consultant unless you have obtained a specific written assignment from the consultant.
- (d) Contact the Law Department to determine whether [COMPANY] has registered its material copyrights in any country in which you are asked to conduct business on behalf of [COMPANY] before beginning to conduct business in that country.

7. **Electronic Privacy.**

- (a) Confirm that you are in compliance with applicable local laws regarding collecting and maintaining personal information

- (b) In particular, if you collect data on European customers, or employees, follow applicable European Union privacy regulations.

8. **Confidential Information.**

[COMPANY]'s CP-1, [COMPANY] Code of Business Conduct and Ethics, Effective Date: 11-10-04 provides:

Others must be able to interact with us in the knowledge that the content of their communications and records will be kept confidential and private when appropriate. We must ensure that the confidential and proprietary information is protected and that information which [COMPANY] discloses is accurate. You must maintain the confidentiality of information entrusted to you by [COMPANY] and its customers, except where disclosure is authorized or legally mandated.

You may not use confidential information in violation of the terms under which it was disclosed for any reason and you may not allow any third-party to obtain such information in violation of such terms. Improper acquisition, possession and use of confidential information of a third party is also improper and can under certain circumstances be illegal. If you know or have reason to know that confidential information was wrongfully obtained from the owner of the information or was obtained from a third party who was under a confidentiality obligation to the owner you cannot use such information.