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# Setting Up IP in Small Legal Departments

A Presentation by:



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## Supplemental Materials

### Table Of Contents:

Sample IP Policy .....	2
International Chamber of Commerce Guidelines for IP Policies .....	9
Sample Patent Assignment .....	10
Example Corporate Assignment of Inventions Policy .....	13
Trademark Resources .....	19
Intel’s TM Usage Policy .....	19
Dropbox’s Branding Guidance .....	19
International Trademark Association’s “A guide to proper trademark use” .....	19
Subcontractor IP Agreement .....	20
Invention Disclosure Form .....	23

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## Sample IP Policy

### 1. Basic Policy Statement

Some of ABC-Corp's most important assets are not tangible things, like buildings, equipment, and inventory. They are the intangible products of the creative human intellect. These intangibles include inventions, works of authorship, product name recognition, information, and other intangible assets known collectively as "intellectual property." ABC-Corp values its intellectual property, because it contributes to the success of ABC-Corp. ABC-Corp also recognizes that others value their own intellectual property as well. ABC-Corp has the following general policies regarding intellectual property.

- (1) **ABC-Corp will seek and preserve exclusive rights over valuable intellectual property by taking advantage of laws protecting patents, copyrights, trademarks, and trade secrets.**
- (2) **ABC-Corp will not knowingly infringe, misappropriate, or otherwise improperly use or misuse valid intellectual property of others.**

What follows below are policies relating to different types of intellectual property and the forms available for their protection. More than one type of protection may apply in a given situation. For example, a patent might both be available for new product. The name of that product may be protected as a trademark. During product development, confidential ABC-Corp plans and financial information about the product may be trade secrets. These guidelines are not exhaustive. Any employee who has any question about the identification, protection, and/or use of intellectual property should contact his/her supervisor, or the Vice President of Manufacturing.

Failure to comply with these policies and guidelines could irreparably damage ABC-Corp's competitiveness and expose ABC-Corp to injunctions, statutory damages, sanctions and fines. For example, disclosure to a competitor of proprietary technical information could give that competitor an unfair "free ride" on ABC-Corp's research. Unauthorized use of another of ABC-Corp's patented technology could trigger a lawsuit.

Employees at all levels have an obligation to apply and comply with these policies in good faith in the performance of their employment duties.

Any employee who has reason to believe that these policies are or may be violated must disclose the information to a supervisor or to the Vice President of Manufacturing, especially where the intellectual property rights of third parties are involved. Intentional violation or negligent disregard of these policies and guidelines will result in discipline, up to and including discharge. If a violation results from inadvertence or excusable lack of information, less severe action may be taken. In some cases, employees may be personally liable for damage they cause.



## 2. PATENT POLICY

### 2.1. DEFINITION OF A PATENT

A patent is an exclusive right to make, use, offer to sell, sell and import a patented invention. For each patented invention, the Federal Government publishes a document that describes the patented invention in technical terms.

Patentable inventions may be any new and useful machine, article of manufacture, composition of matter, or process. To be patentable, an invention must be novel and more than a merely obvious variation on what is already known in the field at the time of the invention.

Patents may only be obtained by filing an application with the U.S. Patent and Trademark Office, or with a patent office of foreign country or region.

### 2.2. ABC-CORP-DEVELOPED INVENTIONS

#### 2.2.1. Identification of Potentially Patentable Inventions

Employees have obligations to notify their supervisors of any potentially patentable inventions relating to ABC-Corp's products, services, markets, or customers. The most important inventions are those that give ABC-Corp a competitive advantage, such as a product capability that might induce customers to select ABC-Corp's products over competitors, or a technique that might reduce ABC-Corp's costs. Each employee is encouraged to record all of his/her innovations and ideas in a notebook, to sign and date each such entry, and to have it witnessed as evidence of the date of invention.

#### 2.2.2. Time Limits

The patent application process has strict time limits.

Employees must notify ABC-Corp of potentially patentable inventions *before* disclosing them to anyone outside ABC-Corp. Patent rights can be lost by making public disclosure before filing a patent application. The most important (but not only) types of disclosures that may either destroy patentability or initiate the statutorily mandated period during which an application must be filed are:

- (a) sales or offers for sale (even secret ones, or discussions with intent to garner commercial interest);
- (b) descriptions in printed publications; and
- (c) public uses or demonstrations.



If a compelling reason exists to disclose an invention before evaluating it for patentability, contact the Vice President of Manufacturing to discuss ways to preserve patent rights.

If an invention has already been disclosed, employees should still notify their supervisors, because some countries allow a patent application to be filed for a limited time period after disclosure.

After filing a patent application, inventions should not be disclosed outside ABC-Corp without a compelling business reason. ABC-Corp treats information contained in a patent application as a trade secret until the patent application process advances to a point where the invention becomes public.

Violation of patent policies, whether intentional or accidental, can result in a loss of valuable rights. ABC-Corp reserves the right to take disciplinary action against any employee who causes a loss in potential patent rights.

### **2.2.3. Confidentiality and Trade Secrets**

Various ABC-Corp technology and inventions may be in various states of development, including anywhere from oral concept discussions, schematics, test beds, prototypes, etc. Such technology and inventions may be in the products themselves, the methods used to make such products, and/or the methods of use of such products. ABC-Corp considers all such technology and information to be trade secret, and thus Confidential Information. Failure to maintain the confidential status of Confidential Information before filing a patent application may cause a loss of rights in patent protection for the Confidential Information.

Accordingly, employees may not discuss, disclose, distribute, or disseminate to any third party the Confidential Information, and will not use the Confidential Information for any purpose other than for further research and development of the same. This shall remain the case for any particular Confidential Information until such time as ABC-Corp may authorize its release to the public (*e.g.*, a pending product is Confidential Information up until the day ABC-Corp shows it to the public, but the method of making that product remains Confidential Information at all times unless revealed by ABC-Corp to the public.) These obligations shall survive any employees' departure from ABC-Corp and shall persist for a period of one (1) year after such termination.

At sites that contain Confidential Information, visitors who are not authorized to have access to Confidential Information should be prevented from having physical access to areas containing physical embodiments of Confidential Information. Where visitors must enter premises, their movements should be limited to locations that have been cleared of Confidential Information (such as conference rooms, rest rooms, *etc.*), and they should be escorted so as to prevent them from having access to other areas. Those who have a legitimate reason for gaining access (*e.g.*, customers with a need to know) may be granted access to Confidential Information only subject to execution of the Non-Disclosure Agreement obtained from the Vice President of Manufacturing.

Contact the Vice President of Manufacturing if you are unsure whether something constitutes Confidential Information, what can be done with Confidential Information,



whether a Non-Disclosure Agreement is needed, and/or if there is an accidental disclosure of Confidential Information.

#### **2.2.4. Compensation**

The act of creation of technology and inventions on behalf of ABC-Corp is part of an employee's job responsibilities. Employee's existing compensation package, including salary, benefits and the like, shall serve as consideration and compensation for all obligations under this Intellectual Property Policy, and ABC-Corp is under no obligation to provide further reward or compensation. ABC-Corp may, at its sole discretion, provide additional compensation to any inventor of subject matter that proves patentable or otherwise brings value to ABC-Corp.

#### **2.2.5. The Patent Application Process**

The process for obtaining a patent may take several years. This process is known as "prosecution." All employees are required to fully cooperate as necessary in this process, including executing any necessary documentation and providing technical assistance. All employees are further required to cooperate in any litigation involving the invention or any resulting patent. These obligations shall survive any employees' departure from ABC-Corp, and shall be exercised without further compensation to the employee.

#### **2.2.6. Ownership of Inventions and Patents**

Unless otherwise required by specific written contracts or written agreements, all technology and/or inventions (hereinafter "Developments"), whether patentable or unpatentable, developed on ABC-Corp property, with ABC-Corp funds, at the behest of ABC-Corp personnel, on behalf of ABC-Corp, using ABC-Corp equipment and/or that relate to ABC-Corp's business shall be the property of ABC-Corp, including any and all patent rights that may arise from such technology and/or inventions. Any inventor of such Developments hereby irrevocably assigns and agrees to assign any and all rights, title and interest to such Developments to ABC-Corp, and shall execute any necessary documents to formally assign the rights in such Developments or resulting patents to ABC-Corp. These obligations shall survive any employees' departure from ABC-Corp. Also, the employee hereby assigns, and agrees to assign, to ABC-Corp all Developments conceived or reduced to practice by the employee within one year following termination of employment with ABC-Corp (whether voluntary or otherwise), if the Developments are a result of ABC-Corp information obtained by the employee during and as a consequence of employment with ABC-Corp.

With respect to specifically and only to activity governed by the laws of North Carolina, and notwithstanding the foregoing, pursuant to North Carolina Statute § 66-57.1, nothing herein shall be interpreted to "apply to an invention that the employee developed entirely on his own time without using the employer's equipment, supplies, facility or trade secret information except for those



inventions that (i) relate to the employer's business or actual or demonstrably anticipated research or development, or (ii) result from any work performed by the employee for the employer.” Within 30 days of conception of such invention, employee must report to ABC-Corp any inventions developed in whole or in part by employee which employee believes is non-assignable to ABC-Corp under this provision; failure to so report may serve as the basis for disciplinary action.

#### **2.2.7. Marking**

To the extent practicable, all physical embodiments of a patented invention should be marked to give notice that it is patented. Appropriate notice is the word “Patent” followed by the patent number. This notice should appear on the product as sold. If the character of the product does not allow for marking (such as a liquid), then the product package should be marked. Contact the Vice President of Manufacturing if there is uncertainty as to how to mark a product.

#### **2.2.8. Infringement By Third Parties**

Any unauthorized person or entity that makes, uses, imports, sells, or offers for sale an invention covered by a patent owned by ABC-Corp may be infringing that patent. All employees are required to report to the Vice President of Manufacturing any suspected infringement.

#### **2.2.9. Inventions Made In Connection With the Government**

Certain inventions may result from a combination of the efforts of ABC-Corp with the Federal Government, either through a contribution of funds, equipment, or personnel. ABC-Corp may be entitled to retain ownership of patents on such invention. Inventions arising during the course of a Government contract with Government funds should be reported for evaluation.

ABC-Corp may lose patent rights if the first prototype of a patentable invention is made under a Government contract. If practicable, the first prototype should be made and tested using funding other than direct funding from a Government contract. Contact the Vice President of Manufacturing for guidance if needed.

### **2.3. INVENTIONS OF THIRD PARTIES**

ABC-Corp may, from time to time, cooperate with outside individuals or entities to develop or distribute technology. All such cooperative efforts must be cleared through the Vice President of Manufacturing to resolve ownership of resulting intellectual property.

### 3. COPYRIGHT POLICY

#### 3.1. Definition of Copyright

Copyright is a right of an author to control the reproduction, distribution, and other aspects of his/her original works of authorship fixed in a tangible mode of expression. Copyright protects that mode of expression but does not reach the ideas embodied in that expression. Works of authorship include: literary works; musical works; dramatic works, pantomimes and choreographic works; pictorial, graphic and sculptural works; movies and other audiovisual works; sound recordings; and architectural works. These categories include most books, journal articles, other scientific articles and writings, technical drawings, conference papers, software, videos, artwork, graphics, and multimedia works. However, some works do not meet the definition of a “work of authorship” and are not copyrightable, such as: (i) impromptu speeches which are not fixed in a tangible medium; (ii) titles and other short phrases; (iii) intangible ideas, methods and concepts; and (iv) facts, dates, or measurements. Only a small amount of creativity is needed to render a work “original” and subject to copyright protection. A compilation of facts or a database may be copyrighted only to the extent that its structure, selection, and arrangement of facts or data contain the required originality to be copyrightable expression.

#### 3.2. Copyright Policy

Unless otherwise required by specific contracts or agreements, all work product of ABC-Corp employees that satisfies the legal requirements for copyright belongs to ABC-Corp as a “work for hire”. Such work product includes, but is not limited to, drafts or finished products of any computer software, operating manuals, sales materials, graphics or multimedia presentations, white papers, *etc.*

No one in ABC-Corp may make an unauthorized copy of any copyrighted work or engage in any other act of infringement, such as unauthorized distribution of a copyrighted work or unauthorized creation of a derivative work. If you have any question or doubts about your right to make, modify and/or distribute copies of materials, you should contact the Vice President of manufacturing before making or requesting that any copies be made or before making any modifications or engaging in any distribution.

### 4. TRADEMARK POLICY

#### 4.1 Definition of Trademark and Service Mark

A trademark or service mark is a word, logo, slogan, phrase, design or other symbol that operates as an indicator of the source of particular goods or services. A “trademark” is adopted by a company to identify its *goods* and to distinguish them from those of others. Examples of trademarks include XEROX for photocopy machines and the “Flying Horse” design for gasoline. A service mark is similar to a trademark, except it identifies and distinguishes the company’s *services* from those of others. Examples of service marks are FIRST UNION for banking services and the slogan “Have It Your Way” for restaurant services. Even *product* shapes and packaging that are distinctive or have acquired an association with their source may qualify for “trade dress” protection.

Trademarks and service marks function to represent the quality standards of a company and the products and services it distributes. They are also advertising and promotional tools that help sell products and services and advertise the business. The terms “trademark” and “mark” will be used here to refer to both trademarks and service marks.



The owner of a valid trademark has an exclusive right to use the mark in commerce to identify particular goods or services. Third parties may not use the mark or a similar mark in a way that might confuse the public into thinking that the third party's goods or services originate from the same source as those of the trademark owner, or are sponsored or endorsed by the trademark owner.

## 4.2. Trademark Policy

All employees are required to fully cooperate as necessary in obtaining and maintaining trademark rights for ABC-Corp. All employees are further required to cooperate in any litigation involving any registered or unregistered trademark of ABC-Corp. These litigation obligations shall survive any employee's departure from ABC-Corp.

Any unauthorized person that uses a trademark in commerce that is the same as or similar to a trademark of ABC-Corp may be infringing that trademark. All employees are required to report to the Vice President of Manufacturing any suspected trademark infringement of ABC-Corp trademarks. Vigilance or "policing" the use of ABC-Corp trademarks by ABC-Corp and by third parties is essential to maintaining their value as ABC-Corp assets.

Unauthorized use of the trademark of another in a manner that is likely to cause confusion as to the source or sponsorship of the associated goods or services is trademark infringement. Penalties for trademark infringement may include an injunction against future infringement and payment of damages. It is the general policy of ABC-Corp to avoid knowingly infringing the trademarks of third parties.

Before using any new ABC-Corp mark in commerce, submit the mark to the Vice President of Manufacturing to confirm that the mark is appropriate for use. All employees are required to report to the Vice President of Manufacturing any suspected infringement of marks owned by third parties by ABC-Corp operations, personnel or products.



## **International Chamber of Commerce Guidelines for IP Policies**

[https://www.uscib.org/docs/BASCAP\\_IP\\_Guidelines.pdf](https://www.uscib.org/docs/BASCAP_IP_Guidelines.pdf)



## Sample Patent Assignment

### ASSIGNMENT BY INVENTORS

**THIS ASSIGNMENT**, made this \_\_\_\_\_ day of \_\_\_\_\_, \_\_\_\_\_, by \_\_\_\_\_ (hereinafter referred to as Assignors), residing at \_\_\_\_\_, respectively;

**WHEREAS**, Assignors have invented certain new and useful improvements in \_\_\_\_\_, set forth in a \_\_\_\_\_ application for Letters Patent of the United States, filed on \_\_\_\_\_ as U.S. Application No. \_\_\_\_\_; and

**WHEREAS**, \_\_\_\_\_, having its principal place of business at \_\_\_\_\_ (hereinafter referred to as Assignee), is desirous of acquiring the entire right, title and interest in and to said inventions and said Application for Letters Patent of the United States, and in and to any Letters Patent of the United States to be obtained therefore and thereon.

**NOW, THEREFORE**, in consideration of One Dollar (\$1.00) and other good and sufficient consideration, the receipt of which is hereby acknowledged, Assignors have sold, assigned, transferred and set over, and by these presents do sell, assign, transfer and set over, unto Assignee, its successors, legal representatives and assigns, the entire right, title and interest in and to the above-mentioned inventions and application for Letters Patent, and in and to any and all direct and indirect divisions, continuations and continuations-in-part of said application, and any and all Letters Patent in the United States and all foreign countries which may be granted therefore and thereon, and reissues, reexaminations and extensions of said Letters Patent, and all rights under the International Convention for the Protection of Industrial Property, the same to be held and enjoyed by Assignee, including the right to sue and collect damages for all past, present and future infringement of the foregoing, for its own use and benefit and the use and benefit of its successors, legal representatives and assigns, to the full end of the term or terms for which Letters Patent may be granted and/or extended, as fully and entirely as the same would have been held and enjoyed by Assignors, had this sale and assignment not been made.

**AND** for the same consideration, Assignors hereby represent and warrant to Assignee, its successors, legal representatives and assigns, that, at the time of execution and delivery of these presents, except for any rights, titles and/or interests that have arisen to Assignee under law or that have already been transferred to Assignee, Assignors are the sole and lawful owners of the entire right, title



and interest in and to the said inventions and application for Letters Patent above-mentioned, and that the same are unencumbered and that Assignors have good and full right and lawful authority to sell and convey the same in the manner herein set forth.

**AND** for the same consideration, Assignors hereby covenant and agree to and with Assignee, its successors, legal representatives and assigns, that Assignors will sign all papers and documents, take all lawful oaths and do all acts necessary or required to be done for the procurement, maintenance, enforcement and defense of any Letters Patent and applications for Letters Patent for said inventions, without charge to Assignee, its successors, legal representatives and assigns, whenever counsel of Assignee, or counsel of its successors, legal representatives and assigns, shall advise: that any proceeding in connection with said inventions, or said Design application for Letters Patent, or any proceeding in connection with any Letters Patent or applications for Letters Patent for said inventions in any country, including but not limited to interference proceedings, is lawful and desirable; or, that any division, continuation or continuation-in-part of any application for Letters Patent, or any reissue, reexamination or extension of any Letters Patent, to be obtained thereon, is lawful and desirable.

**AND** Assignors hereby request the Commissioner for Patents and Trademarks to issue said Letters Patent of the United States to Assignee, as Assignee of said inventions and the Letters Patent to be issued thereon, for the sole use and benefit of Assignee, its successors, legal representatives and assigns.

**AND** Assignors hereby grant the following individuals the power to insert on this Assignment any further identification which may be necessary or desirable in order to comply with the rules of the United States Patent and Trademark Office for recordation of this document:

FIRM

All practitioners at Customer Number XXXXX

**AND** Assignors acknowledge an obligation of assignment of this invention to Assignee at the time the invention was made.

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Date



## Example Corporate Assignment of Inventions Policy

### NONDISCLOSURE, ASSIGNMENT OF INVENTIONS, AND RESTRICTIVE COVENANT AGREEMENT

This NONDISCLOSURE, ASSIGNMENT OF INVENTIONS, AND RESTRICTIVE COVENANT AGREEMENT (“Agreement”) is made and entered into as of the date last below written (“Effective Date”) by and between **ABC-Corp** (“Company”) and \_\_\_\_\_ (“Employee”).

WHEREAS, Company desires to employ or continue to employ Employee and Employee desires to be employed by Company; and

WHEREAS, Company has, through its research, creativity, and experience, developed and acquired valuable Confidential Information; and

WHEREAS, as a result of Employee’s position with Company, Employee will have access to, contribute to, receive, or possess such Confidential Information; and

WHEREAS, Company will suffer irreparable harm if Employee makes any unauthorized disclosure or communication thereof to any third party or makes any use of such Confidential Information wrongfully or in competition with Company; and

WHEREAS, Employee will have contact with Company’s employees, customers, and contractors and may develop relationships with them that could be used against the interests of Company but for the limitations set forth herein; and

WHEREAS, the execution of this Agreement is an express condition of Employee’s employment or continued employment with Company.

NOW, THEREFORE, in consideration of Employee’s employment or continued employment with Company, training, access to Confidential Information, Company’s goodwill, and other valuable consideration, the receipt and adequacy of which is hereby acknowledged, Company and Employee hereby agree as follows:

#### **1. Confidential Information.**

(a) Employee shall, during the course of Employee’s employment and at all times subsequent to Employee’s employment, hold in strictest and total confidence all Confidential Information. Employee will at no time, without prior written authorization by Company, disclose, assign, transfer, convey, communicate, or use for the benefit of any person or entity other than Company any Confidential Information, nor shall Employee permit any other person or entity to use Confidential Information in competition with Company.

(b) “Confidential Information” shall mean any information proprietary to Company and not generally known, including without limitation trade secrets (as interpreted by the Virginia Trade Secrets Act, VA. CODE ANN. § 59.1-336 et seq.); Inventions; technology, whether now known or hereafter discovered; information pertaining to research, development, techniques, engineering, purchasing, marketing, selling, accounting, licensing, know how, processes, products, equipment, devices, models, prototypes, computer hardware, computer programs and flow charts, program code, software libraries, databases, formulae, compositions,



discoveries, cost systems, and pending business transactions; the identity of customers and potential customers and the particular needs and requirements of customers; customer lists; customer histories and records; personnel information; financial information; and confidential and proprietary information of customers and other third parties received by Company. [expand as appropriate]

(c) “Invention” shall mean all ideas, discoveries, developments, inventions, improvements, innovations, technology, computer programs, software, products, methods, systems or plans, whether or not shown or described in writing or reduced to practice or use, and whether or not entitled to the protection of applicable patent, trademark, copyright, or similar laws, relating in any manner to any of Company’s present or future products, services, manufacturing or research. The foregoing notwithstanding, the term Invention shall not include an invention for which no equipment, supplies, facilities, or trade secret information of Company was used and which was developed entirely on Employee’s own time, unless: (i) the invention relates to the business of Company or to Company’s actual or demonstrably anticipated research or development; or (ii) the invention results from any work performed by Employee for Company.

(d) The term Confidential Information shall not apply to the following: (i) information that is or becomes public knowledge other than through the fault of Employee; (ii) information that is received by Employee from a third party who is under no obligation to keep the information confidential; (iii) information that Employee can show by written records was in Employee’s possession prior to the date of disclosure by Company to Employee of the Confidential Information in question; or (iv) information that is individually developed by Employee, and that Employee can show by written or other tangible evidence was so independently developed.

(e) Upon termination of Employee’s employment with Company or at any other time upon Company’s request, Employee shall deliver promptly to Company all originals and all copies (including photocopies, facsimiles, and computer or other means of electronic storage whether now known or hereafter discovered) of all documents and other materials relating in any way to Confidential Information or the business of Company. Employee will not make or retain any copies of the foregoing and will so represent to Company upon Employee’s termination of employment.

**2. Immunity From Liability for Confidential Disclosure of a Trade Secret to the Government or in a Court Filing.** Employee shall not be held criminally or civilly liable under any U.S. Federal or State trade secret law for the disclosure of a trade secret that is made (a)(i) in confidence to a U.S. Federal, State or local government official, either directly or indirectly, or to an attorney; and (ii) solely for the purpose of reporting or investigating a suspected violation of law; or (b) is made in a complaint or other document filed in a lawsuit or other proceeding, if such filing is made under seal.

**3. Use of Trade Secret Information in Anti-Retaliation Lawsuit.** If Employee files a lawsuit against the Company for retaliation by the Company for reporting by Employee of a suspected violation of law, Employee may disclose the trade secret to Employee’s attorney and use the trade secret information in the court proceeding, if Employee (a) files any document containing the trade secret under seal; and (b) does not disclose the trade secret, except pursuant to court order. Nothing in this Agreement is intended to conflict with 18 U.S.C. §1833(b) or create liability for disclosures of trade secrets that are expressly allowed by 18 U.S.C. §1833(b).



**4. Ownership of Intellectual Property; Assignment of Inventions.** Any Invention that Employee, either alone or with others makes, discovers, devises, conceives, reduces to practice, or otherwise possesses while employed by Company or for a period of six (6) months following such employment shall be “works made for hire” as that term is defined in the United States Copyright Laws and the sole property of Company. Employee further agrees to assign, and does hereby irrevocably assign, to Company or Company’s designee, Employee’s entire right, title and interest in: (a) all Inventions, (b) all trademarks and copyrights in any of the Inventions, and any applications with respect thereto, and all of the goodwill appurtenant thereto, and (c) all patent applications and patents with respect to any of the Inventions, including those in foreign countries, which Employee conceives or makes (whether alone or with others) while employed by Company or within six (6) months of the end of Employee’s employment with Company.

Additionally, both while employed by Company and afterwards, Employee agrees to execute and deliver at Company’s expense any documents that Company may reasonably consider necessary or helpful to assure the originality of all Inventions, obtain or maintain patents, trademarks, copyrights or any other registrations, whether during the prosecution of applications therefor or during the conduct of an interference, opposition, litigation or other matter (all related expenses to be borne by Company), and to vest ownership in, transfer and convey, by assignment or otherwise, all right, title and interest in and to such items to Company. If Company is unable because of Employee’s mental or physical incapacity or for any other reason to secure Employee’s signature to apply for or to pursue any application for any United States or foreign patent letters or copyright registrations covering inventions or original works of authorship assigned to Company as above, then Employee hereby irrevocably designates and appoints Company and its duly authorized officers and agents as Employee’s agent and attorney in fact, to act for and on Employee’s behalf and stead to complete, execute and file any such applications and to do all other lawfully permitted acts to further the prosecution and issuance of patent letters or copyright registrations thereon with the same legal force and effect as if executed by Employee. Employee hereby waives and quitclaims to Company any and all claims, of any nature whatsoever, which Employee now has or may hereafter have for infringement of any patents or copyrights, resulting from any such application for patent letters or copyright registrations assigned hereunder to Company.

**5. Restrictive Covenants.**

(a) **Noncompetition.** During Employee’s employment and for a period of one (1) year following the termination of Employee’s employment for any reason (“Restricted Period”), Employee shall not, within the United States, directly or indirectly, own, manage, operate, control, advise, be employed by, or materially participate in, or be materially involved in any manner with the ownership, management, operation, or control of any business or entity that competes with the business then conducted by Company.

(b) **Non-Solicitation of Customers.** During the Restricted Period, Employee shall not, individually or collectively, as a participant in a partnership, sole proprietorship, corporation, limited liability company, or other entity, or as an operator, investor, shareholder, partner, director, employee, consultant, manager, sales representative, independent contractor or advisor of any such entity, or in any other capacity whatsoever, either directly or indirectly (i) solicit or accept any business from any Customer or assist any other entity in soliciting or accepting any business from any Customer; or (ii) request or advise any Customer to withdraw, curtail, or cancel any of such Customer’s business or other relationships with Company. As used in this section, “Customer” shall mean any person or entity with whom Employee had contact by



reason of Employee's employment with Company, and that Company rendered any services or sold anything of value to.

(c) **Non-Solicitation of Employees.** During the Restricted Period, Employee shall not (i) participate in, directly or indirectly, or be materially involved in any manner in the solicitation, hiring, or any attempt to hire as an employee, officer, director, consultant, advisor, or contractor any person who is at the time of such hiring or attempted hiring, or was within six (6) months of such hiring or attempted hiring, an employee of Company; or (ii) otherwise, directly or indirectly, induce or attempt to induce any employee of Company to leave the employ of Company.

(d) **Employee Acknowledgement of Reasonableness.** Employee acknowledges that the restrictions set forth herein are necessary to protect the legitimate business interests of Company, and that irreparable harm and damage will be done to Company in the event that Employee competes unfairly with Company. Employee has carefully read and considered the provisions of this Section entitled "*Restrictive Covenants*," and, having done so, agrees that the restrictions set forth herein are fair and reasonable and are reasonably required for the protection of the legitimate business interests of Company. Employee further agrees and acknowledges that the geographic and durational limitations set forth therein are reasonable under the circumstances considering Employee's position with Company, the location of Company's operations, Employee's access to Company's Confidential Information and relationships, and other relevant factors, and agrees that Company's need for the protection afforded herein is greater than any hardship Employee might experience by complying with the terms set forth therein.

(e) **Tolling.** In the event of a breach by Executive of this Section entitled "*Restrictive Covenants*," then the restrictive periods referenced herein shall be tolled and shall begin to run or recommence running only at such time as the breach is alleviated or remedied.

**6. Remedies.** Employee acknowledges that Employee's threatened or actual breach of any of the terms hereof will result in immediate, irreparable harm and injury to Company, not adequately compensable by monetary relief. As a result, Company shall have the right to enforce the provisions hereof by injunction, specific performance or other equitable relief, as well as through all other equitable and/or legal remedies to which Company may be entitled, including, but not limited to, monetary relief.

**7. Not an Employment Agreement.** This Agreement is not an employment agreement between Employee and Company. This Agreement does not change Employee's status as an at-will employee of Company. This Agreement does not create any right to employment or continued employment of Employee with Company.

**8. Notification of Subsequent Employers.** Employee shall notify each subsequent employer or person or entity using the services of Employee following the termination of Employee's employment with Company of the existence and provisions of this Agreement. Company is hereby authorized to notify any person or entity employing or otherwise using the services of Employee or evidencing an interest or intention to arrange for the employment of or to employ or otherwise use the services of Employee as to the existence and provisions of this Agreement, including providing a copy of this Agreement and shall be free to advise any third party of its intention to enforce such Agreement.



**9. Employee Representations.** Employee represents and warrants to Company that Employee is not bound by any covenant not to compete or similar agreement that would prohibit Employee from performing, or would restrict or limit Employee in Employee's performance of, Employee's duties and obligations under this Agreement. Employee further represents and warrants that Employee has not retained and will not use during Employee's employment with Company any confidential, proprietary or trade secret information obtained by Employee while employed with any other company that has not become generally available to the public.

**10. Notices.** All notices provided for in this Agreement shall be in writing and shall be given either (a) by actual delivery of the notice to the party entitled thereto or (b) by depositing the same with the United States Postal Service, first class mail, postage prepaid, to the address of the party entitled thereto. The notice shall be deemed to have been received in case (a) on the date of its actual receipt by the party entitled thereto or in case (b) one (1) day after the date of its deposit with the United States Postal Service.

**11. Waiver.** Waiver by Company of any breach or violation of any provision of this Agreement shall not operate as or be construed to be a waiver of any subsequent breach thereof.

**12. Severability.** Should any one or more sections of this Agreement be found to be invalid, illegal, or unenforceable in any respect, the validity, legality, and enforceability of the remaining sections contained herein shall not in any way be affected or impaired thereby. In addition, if any section hereof is found to be partially enforceable, then it shall be enforced to that extent.

**13. Entire Agreement; Amendments.** The provisions hereof constitute the entire and only Agreement between the parties with respect to the subject matter hereof and supersede all prior agreements, commitments, representations, understandings, or negotiations, oral or written, and all other communications relating to the subject matter hereof, and may be modified only by written agreement signed by Employee and Company.

**14. Successors and Assigns.** This Agreement shall inure to the benefit of and may be enforced by Company, its successors or assigns.

**15. Assignment.** Employee may not assign any rights hereunder. Any such purported assignment by Employee shall be void. Company may assign all of its rights and obligations under this Agreement. In the event of an assignment by Company, each reference in this Agreement to Company shall include the assignee from and after the date of such assignment.

**16. Governing Law.** This Agreement shall be governed by and construed in accordance with the internal laws of the Commonwealth of Virginia without giving effect to any choice of law or conflict of law provision or rule (whether of the Commonwealth of Virginia or any other jurisdiction) that would cause the application of the laws of any jurisdiction other than the Commonwealth of Virginia.

**17. Venue and Jurisdiction.** The exclusive venue and jurisdiction for any litigation concerning this Agreement shall be in the Circuit Court located in Richmond, Virginia or in the United States District Court for the Eastern District of Virginia. Any of the foregoing courts shall have personal jurisdiction over Employee and jurisdiction over matters arising out



of this Agreement, and Employee hereby irrevocably waives any and all objections to personal jurisdiction, venue, or convenience in the aforementioned courts.

**18. Costs and Expenses.** In any action, litigation or proceeding between the parties arising out of or in relation to this Agreement in which Company shall prevail, Company will be awarded, in addition to any damages, injunctions or other relief, and without regard to whether such action is prosecuted to final appeal, Company's costs and expenses, including reasonable attorneys' fees.

**19. Headings.** The sections and other headings contained in this Agreement are for reference purposes only and shall not affect the meaning or interpretation of this Agreement.

**IN WITNESS WHEREOF,** Employee has executed this Agreement and Company has caused this Agreement to be executed by its duly authorized representative, as of the last date indicated below.

**ABC-Corp**

By: \_\_\_\_\_

Title: \_\_\_\_\_

Date: \_\_\_\_\_

**EMPLOYEE:**

Printed Name: \_\_\_\_\_

Signature: \_\_\_\_\_

Date: \_\_\_\_\_



## **Trademark Resources**

### **Intel's TM Usage Policy**

<https://www.intel.com/content/www/us/en/trademarks/trademarks.html>

### **Dropbox's Branding Guidance**

<https://www.dropbox.com/branding>

### **International Trademark Association's "A guide to proper trademark use"**

[https://www.inta.org/Media/Documents/2012\\_TMUseMediaInternetPublishing.pdf](https://www.inta.org/Media/Documents/2012_TMUseMediaInternetPublishing.pdf)



## Subcontractor IP Agreement

### 9. Confidentiality and Invention Rights.

- (a) As used in Section 9 of this Master Subcontractor Agreement, the following terms will have the meaning set forth below:
- (i) “***Invention***” shall mean any and all inventions, discoveries, developments or improvements, whether or not patentable, and works of authorship, whether or not copyrightable, which are conceived, developed or reduced to practice, or caused to be conceived, developed, or reduced to practice, by Subcontractor, solely or jointly, or in whole or in part, during the term of and as a direct result of serving as a subcontractor under this Master Subcontractor Agreement.
  - (ii) “***Proprietary Information***” shall mean any and all secret, confidential or other information, and all tangible manifestations thereof, reasonably considered as proprietary including but not limited to that of a technical nature such as patent applications, methods, know-how, formulas, compositions, processes, discoveries, designs, inventions, potential product applications and uses, computer programs and research efforts relating thereto, and to that of a business nature such as costs, purchasing sources and arrangements, financial analyses, contractual terms, customer and potential customer identities, prospective business plans, and research and development of future marketing plans and shall further include all such information and materials disclosed by SUBCONTRACTOR in the course of the SUBCONTRACTOR’s services under this Master Subcontractor Agreement.
  - (iii) “***ABC-CORP Proprietary Information***” means Proprietary Information of ABC-CORP.
  - (iv) “***Third Party Proprietary Information***” shall mean Proprietary Information received by ABC-CORP from a third party.
- (b) It is understood that SUBCONTRACTOR’s service as a subcontractor under this Master Subcontractor Agreement expected to involve access to ABC-CORP Proprietary Information and Third Party Proprietary Information. SUBCONTRACTOR recognizes and acknowledges that such ABC-CORP Proprietary Information and Third Party Proprietary Information are valuable, special and unique assets of ABC-CORP and third parties, respectively. Except with the express written authorization of the CEO of ABC-CORP, SUBCONTRACTOR agrees that during the term of this Master Subcontractor Agreement, and for a period of ten years thereafter, SUBCONTRACTOR shall not disclose or transfer any ABC-CORP Proprietary Information or Third Party Proprietary Information to any person, firm, corporation or other entity, and will not use such ABC-CORP Proprietary Information or Third Party Proprietary Information for any purpose not directly related to SUBCONTRACTOR’s service as a subcontractor under this



Master Subcontractor Agreement. The confidentiality and non-use obligations of Section 9 will not apply to ABC-CORP Proprietary Information or Third Party Proprietary Information, which SUBCONTRACTOR is able to demonstrate with tangible written evidence (i) is or becomes within the public domain prior to any unauthorized use or disclosure thereof by SUBCONTRACTOR; (ii) was in SUBCONTRACTOR's possession or within SUBCONTRACTOR's knowledge prior to commencement of service as a subcontractor under this Master Subcontractor Agreement; or (iii) is lawfully received by SUBCONTRACTOR with no restrictions upon use from a third party having a right to disclose it to SUBCONTRACTOR. If SUBCONTRACTOR is requested or required (by oral questions, interrogatories, requests for information or documents, subpoena, civil investigative demand or similar process) to disclose any ABC-CORP Proprietary Information or Third Party Proprietary Information, it is agreed that SUBCONTRACTOR will provide ABC-CORP with prompt notice of such request(s) so that ABC-CORP may seek an appropriate protective order or other appropriate remedy or waive compliance with the confidentiality provisions of this Section 9. If such protective order or other remedy is not obtained, or ABC-CORP grants a waiver hereunder, SUBCONTRACTOR may furnish that portion of ABC-CORP Proprietary Information or Third Party Proprietary Information which SUBCONTRACTOR is legally compelled to disclose and will exercise commercially reasonable efforts to obtain reliable assurance that confidential treatment will be accorded any ABC-CORP Proprietary Information or Third Party Proprietary Information so furnished.

- (c) All tangible manifestations of ABC-CORP Proprietary Information and Third Party Proprietary Information which shall at any time come into the possession of SUBCONTRACTOR shall be the sole and exclusive property of ABC-CORP or the third party to whom such information relates, and shall be surrendered to ABC-CORP upon termination of SUBCONTRACTOR's service as a subcontractor under this Master Subcontractor Agreement or upon ABC-CORP's request at any other time. To the extent that SUBCONTRACTOR acquires any ownership in or to ABC-CORP Proprietary Information, SUBCONTRACTOR agrees to assign and does hereby assign to ABC-CORP all right, title and interest in and to such ABC-CORP Proprietary Information. SUBCONTRACTOR agrees to comply with procedures established by ABC-CORP to preserve the confidentiality of ABC-CORP Proprietary Information and Third Party Proprietary Information, including physical security procedures and policies.
- (d) SUBCONTRACTOR assigns to ABC-CORP any right, title, and interest SUBCONTRACTOR may have in any Inventions. Upon the request of the ABC-CORP and at the ABC-CORP's expense, SUBCONTRACTOR shall execute such further assignments, documents, and other instruments as may be necessary to assign such Inventions to ABC-CORP and to assist ABC-CORP in applying for, obtaining and enforcing patents or other rights in the United States and in any foreign country with respect thereto. ABC-CORP will bear the cost of preparation of all patent or other applications and assignments, and the cost of obtaining and enforcing all patents and other rights thereto. SUBCONTRACTOR will cooperate and take all other reasonable action required or requested by ABC-CORP in connection therewith.
- (e) SUBCONTRACTOR agrees that a breach of SUBCONTRACTOR's obligations under Section 9 of this Master Subcontractor Agreement would result in irreparable injury to ABC-CORP for which monetary damages would not be an adequate remedy. SUBCONTRACTOR agrees that ABC-CORP may in the event of any actual or threatened breach of SUBCONTRACTOR's obligations under this Section 9, in addition



to all other available legal remedies to which it may be entitled, seek and obtain injunctive and equitable relief and remedies, including temporary restraining orders, preliminary injunctions, and specific performance in such form as may be appropriate under the circumstances.



## Invention Disclosure Form

### INVENTION DISCLOSURE DATA SHEET

Upon completion, submit form to the [insert contact information]

(Please type or print in ink; attach additional sheets, if needed)

Date: \_\_\_\_\_

INVENTOR INFORMATION	FOR INTELLECTUAL PROPERTY COMMITTEE USE ONLY	
Name: _____ Position: _____ Address: _____ _____ Phone: _____ Email: _____	Name (1) Received: _____ Examined & Understood: _____	Date _____ _____
Name: _____ Position: _____ Address: _____ _____ Phone: _____ Email: _____	Name (2) Received: _____ Examined & Understood: _____	Date _____ _____
The herein-described invention is submitted pursuant to my Intellectual Property agreement.		
1. DESCRIPTIVE TITLE: _____		
CATEGORY: <input type="checkbox"/> (a) method or process <input type="checkbox"/> (b) composition or chemical compound <input type="checkbox"/> (c) machine, article, or device		
2. BRIEF SUMMARY OF INVENTION:   		
3. COMPLETE ATTACHED "DETAILED DISCLOSURE RECORD" FOR THE INVENTION.		



4. INVENTION CONCEIVED (DATE): _____
5. INVENTION REDUCED TO PRACTICE (i.e.), CONSTRUCTION, MANUFACTURE, FORMULATION, PRACTICE, ETC. COMPLETED SUCCESSFULLY) (DATE): _____
6. INVENTION DISCLOSED TO: _____ (DATE): _____
7. AND/OR SKETCHES MADE BY (attach copies if possible): (DATE): _____ (DATE): _____ (DATE): _____
8. MADE BY: _____ (DATE): _____
9. DRAWING NUMBER(S): _____
10. FIRST SOFTWARE MODEL (IF ANY) MADE BY: _____ (DATE): _____
12. INVENTION DISCLOSED IN NOTEBOOK NO.: _____ PAGES: _____
13. INVENTION FIRST TESTED (DATE): _____
14. IF THERE HAS BEEN ANY EXPERIMENTAL USE, GIVE DATE(S) AND EXPLAIN BRIEFLY: _____
15. LIST POTENTIAL BUSINESS OPPORTUNITIES THAT MAY BE APPLIED TO THIS INVENTION. EXPLAIN BRIEFLY: _____
16. HAS ANY OFFER FOR SALE OR SALE OF THE INVENTION OCCURRED? IF SO, WHEN AND TO WHOM? _____ _____
17. IF YOU HAVE DISCLOSED THIS INVENTION TO PERSONS OUTSIDE THE COMPANY (INCLUDING CUSTOMERS), INDICATE WHEN, UNDER WHAT CIRCUMSTANCES, AND TO WHOM: (IF NO DISCLOSURE, INDICATE "NONE")  a. ORAL: _____ b. WRITTEN: _____ c. ACTUAL USE, DEMONSTRATION, OR DISPLAY: _____
18. WAS THIS INVENTION CONCEIVED OR DEVELOPED DURING PERFORMANCE OF A GOVERNMENT CONTRACT OR SUBCONTRACT? Yes _____ No _____  IF THE ANSWER IS "YES" PROVIDE THE GOVERNMENT CONTRACT NUMBER AND NAME OF THE PROGRAM :  IF THE ANSWER IS "NO" – PROVIDE THE FUNDING SOURCE (IR&D, OVERHEAD, ETC.) WITH CHARGING CODE. _____



19. PLEASE PROVIDE TWO QUALIFIED PEERS TO REVIEW THE DISCLOSED INVENTION:

NAME: \_\_\_\_\_  
TELEPHONE: \_\_\_\_\_

NAME: \_\_\_\_\_  
TELEPHONE: \_\_\_\_\_

20 INVENTOR(S):

Full Name: \_\_\_\_\_ Citizen of: \_\_\_\_\_  
\_\_\_\_\_  
City: \_\_\_\_\_ County: \_\_\_\_\_  
\_\_\_\_\_  
Country: \_\_\_\_\_  
\_\_\_\_\_  
Plant Location: \_\_\_\_\_

Full Name: \_\_\_\_\_ Citizen of: \_\_\_\_\_  
\_\_\_\_\_  
City: \_\_\_\_\_ County: \_\_\_\_\_  
\_\_\_\_\_  
Country: \_\_\_\_\_  
\_\_\_\_\_  
Plant Location: \_\_\_\_\_

21. SIGN FULL NAME(S):

(a) \_\_\_\_\_  
First name Middle name (not initial) Last name

DATE: \_\_\_\_\_

(b) \_\_\_\_\_  
First name Middle name (not initial) Last name

DATE: \_\_\_\_\_

(An effort should be made to obtain the signature of the person(s) to whom the inventor(s) first disclosed the invention)

22. THE INVENTION HAS BEEN EXPLAINED TO ME AND THIS DATA SHEET AS WELL AS THE ATTACHED DETAILED DISCLOSURE HAVE BEEN EXAMINED AND UNDERSTOOD BY ME:

(a) Name of Witness: \_\_\_\_\_  
Signature: \_\_\_\_\_

DATE: \_\_\_\_\_

(b) Name of Witness: \_\_\_\_\_  
Signature: \_\_\_\_\_

DATE: \_\_\_\_\_

## DETAILED DISCLOSURE RECORD

1. Objects or results to be achieved by the practice of this development:  
*[insert answer]*
  
2. How these objects or results may be attained:  
*[insert answer]*
  
3. Variations known (or reasonably predictable) to be permissible without losing the primary benefits:  
*[insert answer]*
  
4. New features inherent in attainment of our objectives:  
*[insert answer]*
  
5. Features embodied in this development that probably would not have been clearly obvious to, or readily foreseeable by, the typical skilled worker in this field:  
*[insert answer]*

6. Detailed description (attach additional sheets, drawings, sketches, etc. if needed--each additional sheet must be dated, signed and witnessed):

*[insert answer]*

7. Background of published information and commercial practice in this field, as now known to those participating in the development:

*[insert answer]*

8. Names of those (a) contributing to the initial concept, and (b) to the further investigation, development and testing of the process, or composition, or machine, etc.:

*[insert answer]*

9. Chronology of principal events in this conception and development:

A. Date of conception (designate any written data you have to support this):

*[insert answer]*

B. Invention first disclosed to (designate what written evidence you have to support this):

*[insert answer]*

C. Date disclosed (designate what written evidence you have to support this):

*[insert answer]*

D. Date of first written description (designate what written evidence you have to support this):

*[insert answer]*

E. Date of first sketch or drawing (designate location of sketch or give drawing number):

*[insert answer]*

F. Date first device made:

*[insert answer]*

G. Date first tested:

*[insert answer]*

H. If described in any publication, advertising or report, identify:

*[insert answer]*

10. Names of other persons in the company with whom this development and Invention Disclosure Record have been discussed (essential when another division or department is directly or indirectly concerned) with a view towards including pertinent facts from any related work or background which these other groups may have:

11. Commercial and Strategic Advantages that Justify Patent Costs

A. Will this patent give company a strategic competitive advantage in a market?

*[insert answer]*

B. Why patent invention and not treat as trade secret?

*[insert answer]*

C: Is the technology feasible?

*[insert answer]*

D: Other information:

*[insert answer]*

E. Describe the market/user need and value to user of using invention relative to alternatives:

*[insert answer]*

F. Estimate number of buyers/users and a dollar size of the potential markets:

*[insert answer]*

G. Identify competing and substitute technologies, products, or services:

*[insert answer]*

H. Estimate potential investment needed to develop patent into a marketable product or service (including marketing and promotions):

*[insert answer]*

I. Estimate unit cost to produce Estimate unit revenue or price:

*[insert answer]*

Name of compiler of this  
Invention Disclosure Record: \_\_\_\_\_

Signature: \_\_\_\_\_ Date: \_\_\_\_\_