



Introduction

Progressive Legal® is on a mission to help Australian businesses and their owners with securing their **Intellectual Property (IP)** in a way that will ensure they can protect their brand, enforce their legal rights should they need to, learn more about the various IP they have in their business, and understand how valuable it is for a business.

The problem we identified is that there's no checklist out there for a business to know what they should consider when it comes to their IP. Until now...

We've created this checklist as a practical guide to assist businesses, as IP is increasing in its value for most businesses and it's becoming far more important than ever to take proper and reasonable steps to protect it. This is largely attributable to the advancement of technology and increase in globalisation. Many businesses are not sufficiently aware and are surprised how much valuable IP they have made when we advise them, and which has accumulated over the years.

This checklist will:

1. increase your awareness as to how much IP you have in your business;
2. allow you to consider whether all the major boxes have been ticked;
3. provide guidance on all the forms or IP you should protect and register; and
4. if your business's legal structure has changed, have you considered whether some IP would need to be transferred to the right legal entity for it to be enforceable.

Finally, if you own a business and intend to sell or hand-on to future generations at any stage, have you got your house in order? All of this should be legally neat and tidy, and all steps taken to protect the IP of the business. If not, it can potentially be fatal.

We have seen prospective purchasers balk at buying certain businesses where this has not been done, as they know how dangerous it is for a business and the costly consequences that can result, which they would have seen. Opportunities have been missed as a result!

Step 1: Identifying your Intellectual Property (IP)

In order to consider what IP assets the business owns, you must first identify what types of Intellectual Property you currently have in your business (**IP Inventory**).

You'll be surprised just how much IP exists in your business!

Type of IP

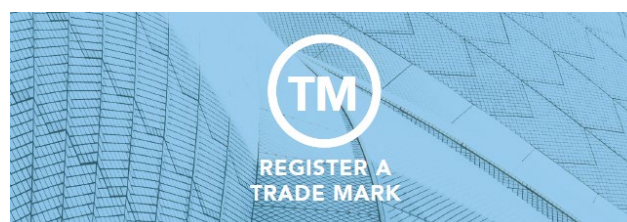
Have you identified any of this IP in your business?

Trade Marks

A trade mark is a badge of origin for your business, it can consist of a logo, letter, word, phrase, sound, movement, shape, scent, or colour.

Examples of trade marks include:

- a business name;
- a logo used by the business with or without the business name;
- advertising or signage;
- slogans, phrases or taglines used by the business;
- unique packaging that you use to sell you products;
- easily recognisable and unique shape of your product;
- unique smell associated with your product;
- unique sound associated with your product (including vocal harmonisations); or
- unique colour that is used by the business



**Domain name
and other social
media accounts**

- All domain name(s) – you might have more than you initially think (.com, .com.au, .au, .net, – are all common)
- Instagram account(s)
- Twitter account(s)
- Facebook account(s)
- TikTok account(s)
- LinkedIn account(s)
- Snapchat account(s)
- Reddit account(s)
- Pinterest account(s)
- YouTube channels(s)
- Spotify channel(s); and
- any other accounts under the name of the business(s)

Copyright

Copyright protects original works and grants the owner the exclusive right to do specific acts for a set period of time.

Examples of copyright works include:

- website content and articles
- presentations (including PowerPoint presentations)
- spreadsheets (including pricing spreadsheets, client information, database lists)
- code written for software programming or applications
- mobile applications
- internal company training manuals and other materials
- policies, procedures and internal documents
- photographs including photographs posted on social media
- videos or movies created, including videos posted on social media
- newsletters and promotional emails
- a privacy policy published on your website
- terms and conditions published on your website
- architectural designs and plans
- business proposals and contracts shared by the business
- annual reports and other internal documents of the business
- advertising or signage
- books and magazines
- paintings
- music notes written on paper
- lyrics of songs
- drawings of artistic work

With all the above content, we suggest you mark any of these documents with: “© Your Company Name – Year – All legal rights reserved”.

Trade Secrets

Trade secrets protect confidential information which may be of value.

Examples of trade secrets include:

- client lists
- inventions and process that are either not patented or not patentable
- R&D information
- formulas
- software algorithms
- recipes, ingredients, or colour blends

Essentially, these are the “secret sauces” for your organisation. You wouldn’t want them to be disclosed (which you would need to do for a patent) and you wouldn’t want your competitors to get their hands on them.

For example, pricing or formulas which you’ve worked hard to develop over time. The recipes for Worcestershire sauce or Coca Cola are good examples. They’ve never been disclosed and are held under lock and 2 separate keys!

Patents

A patent gives the owner the right to stop other people from using or selling an invention, substance, method or process for a limited period of time.

Examples of patents include:

- a new invention or discovery
- new useful processes or ways of doing things
- machines and equipment
- articles of manufacturing

Designs

A design protects the overall visual appearance of a new and distinctive product. Designs protect the appearance of a product, rather than how they function.

This includes:

- Shape or colour
- Configuration or pattern
- Ornamentation

Step 2: Protecting your Intellectual Property

After you've identified the extent of your IP inventory, it's essential that you consider the commercial/ legal risks which exist and any active steps you should be taking to protect it. This includes risks that exist either internally, with 3rd parties you engage, and of course – your competition in the market you operate in.

The protection of your IP is a long process and begins from the moment you expend effort on creating your idea to the actual manifestation of that idea in physical form.

Registration of Intellectual Property

- **Trade Marks:** Have you registered your trade mark(s) with IP Australia?
- **Copyright:** You do not need to register Copyright in Australia. Copyright is automatically recognised under the *Copyright Act 1968* (Cth) (subject to satisfying the requirements of subsistence).
- **Designs:** Have you registered your Design(s) with IP Australia?
- **Patents:** Have you registered your Patent(s) with IP Australia?

Unregistered Trade Mark(s)

- If you have an unregistered trade mark, you still have protection to stop other people from using it (i.e. under the common law of passing off, or pursuant to the Australian Consumer Law for misleading and deceptive conduct).

Trade Mark and Copyright notices

- Do you use the symbol ™ for unregistered trade marks?
- Do you use the symbol ® to show your trade mark is registered?
- Do you use the copyright symbol © and notices on works that the business creates?
- [Here](#) is an article if you want more information.

Ownership of Intellectual Property

- Do you document your right to use IP works?
- Do you document drafts and initial plans of your IP works?
- Is the IP being used wholly owned by you or your company?

- Do you require all employees and contractors to sign agreements which assign all IP rights to you or your company which they have developed while they are working for you?
- Has all IP which has been created externally (i.e. by contractors) been formally assigned to you or your company?
- Do you know under what name your social media accounts and domains are held in?
- Where employment ends, do you conduct exit interviews with employees with respect to any IP issues (such as the return of company property, deletion of confidential information, trade secrets etc)?

Corporate Structure

- If there is a group of companies, is your IP owned by the correct entity?
- If you have a holding company and trading entity, is the IP held in the former, whilst the latter has a license to use it?
- If you have moved to a new business structure, has the IP been moved to the new structure?
- Is the IP co-owned (either between parties or entities)? If so, have you considered the implications of this?

- If you are trading internationally, are the overseas IP rights owned by local entities or is your Australian entity in charge of all IP and licensing?

Enforcement of rights

- Where you are made aware that an infringement of your IP has occurred, do you send cease and desist letters / letters of demand to the infringing party putting them on notice of your rights?
- Do you obtain legal advice regarding suspected infringements of your IP?

Use of confidential information

- Do you have any processes or procedures in place to prevent the unauthorised disclosure of your business's ideas or concepts?
- Do you have Confidentiality Agreements/Deeds, or Non-Disclosure Agreements with your employees, contractors and other third parties?

Licenses

- If another party is found to infringe an IP right that you have licensed, have you considered whether you or the licensee will pay any legal costs associated with dealing with the matter?

Documents

- Have you identified all agreements you or your company may have with a third party? This includes and is not limited to:
 - 1. license agreements;
 - 2. assignment agreements;
 - 3. distribution agreements;
 - 4. non-disclosure agreements; and
 - 5. non-competition agreements.
- Have you identified other documents relating to Intellectual Property rights? This includes and is not limited to:
 - 1. contracts with suppliers; and
 - 2. contracts with customers (including terms and conditions etc).
- After reviewing the documentation, does each agreement identify:
 - 1. the parties to the agreement?
 - 2. the true owner of any IP developed under the agreement?; and
 - 3. the rights being transferred.



Step 3: Avoiding the infringement of others' IP rights

Just as it's important to protect your own Intellectual Property rights, it is also essential that you take active steps to prevent the potential infringement of third parties' Intellectual Property rights, so as to limit your legal liability.

Identification of competitors

- Do you have any processes in place by which you identify potential competitors in the market and the likelihood of infringing their IP rights?
- Before you create your Intellectual Property, do you conduct a thorough review of any registered IP which you may potentially be infringing upon (such as trade mark searches on IP Australia)?
- If you plan on selling your product/ services internationally, have you conducted the same review for the countries you intend to export your products or services to?

Due diligence

- If you are purchasing a business, have you conducted your due diligence to ensure that the IP being used is not infringing a third party's rights?

Licenses with third parties when using third party IP

- Do you have any licenses which allow you to use another party's IP? If so, are you across the terms of that license and how the IP can be used?
- Do your licenses which allow another party to use your IP include indemnities against any tort or liability claims?

Use of hyperlinks

- Are you sure that your online content (such as social media pages or website) does not link to or embed material which infringes copyright?

Seeking advice from legal professionals

- Do you seek advice from any lawyers or Intellectual Property professionals as to your Intellectual Property matters?

If you require legal advice in relation to your Intellectual Property or your business more broadly, the team at Progressive Legal are experts in the field.

Feel free to call our office at [1800 820 083](tel:1800820083) or fill out the online enquiry form located on [this page](#).



Authors: [Ian Aldridge](#) & [Zeinab Farhat](#), Progressive Legal



Disclaimer

The information contained in this document is of a general nature only. It does not constitute legal or financial advice and is based on available information at the time of publication. For steps and costs related to your specific matter, intellectual property and business, you should obtain our specific legal advice, and refer to emails and costs agreement provided by Progressive Legal. All businesses have different needs and requirements, and you should seek formal legal advice in order to understand your specific rights and obligations. We are not liable for your reliance on any of the information contained within this document. If you have any questions whatsoever or require any clarification, please ask us.