

When to use:

- Prior to beginning development
- During final design approval

CHECKLIST

- All employees working on product development should be required by agreement to assign all inventions to the company. Where required by applicable state statute, assignment agreements should provide an exception for inventions made outside the scope of employment and without using company confidential information or resources.
- If employees are located outside the U.S., outside IP counsel should be consulted for terms required for the subject jurisdiction. Beware that in certain countries, it is critical to obtain a waiver of certain statutory rights because employees may have to receive royalties on their inventions (e.g. China, Germany, Japan, and others).
- All independent contractors or outside development entities should be required by contract to assign all inventions made for the company or made using company confidential information.
- All independent contractors or development entities should be required by contract to assign all copyrightable works (software in particular) authored for the company or authored using company confidential information. Such agreements should ideally include a “work made for hire” clause.
- All employees and contractors should be required to represent that any IP they create for the company is original, or in other words not copied from IP owned by a third party. This also includes information based on or derived from the confidential information of a third party, or knowingly infringing the patent of a third party.
- Employees and contractors should be required to schedule any IP included in a company product or development that is not original/outside sourced (e.g. open source software or other software).
- Meeting minutes should be taken during discussions with outside parties to assist in proper identification of the source of inventive ideas.
- If the product development is related to a government contract, this should be noted and identified when seeking to protect inventions that arise from that development.