

# Dunner Law Dicta

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## Dunner Law

Small IP Practice specializing in trademark and copyright law; IP counseling, domestic and international protection of IP portfolios; internet-issues; IP audits and strategies relating to IP portfolios; drafting and negotiating IP and IT-related agreements

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## A Little IP Recordkeeping Can Go a Long Way

One crucial aspect of running a successful business or organization is effective recordkeeping. While there are many types of records that one must be able to identify, organize, and access on short notice (e.g., corporate records, accounting information, insurance documents, deeds/leases), this issue focuses on an often overlooked area: intellectual property recordkeeping, specifically pertaining to trademarks and copyrights.

### 1. Types of Records to Keep

There are different types of intellectual property records that should be organized and kept in a safe location. The following list is representative of the types of important documents and records pertaining to your intellectual property that should be kept safely:

#### *Trademark Records*

Original sealed certificates of registration issued by the U.S. Patent and Trademark Office (“PTO”); certificates issued by state governments; dates when a trademark was adopted, first placed on a product or the product’s tags or packaging, or first incorporated into advertising materials or a web site to advertise the services; a list of which products or services are offered or sold using the

trademark; dates when those products or services were first offered or sold across state lines using that trademark; samples of product packaging, product tags, or advertising material showing the trademark; dates when a trademark ceased being used in connection with a particular product or service; information regarding intent to resume use of a trademark.

#### *Copyright Records*

Original certificates of registration issued by the U.S. Copyright Office; copies of completed works; copies of derivative works; dates of creation of each work; date that each work (and any subsequent modified work) was first published, if applicable.

#### *Agreements & Licenses*

All executed agreements including addendums, exhibits and modifications. Examples of agreements could include: work-for-hire agreements, joint authorship agreements, author release forms, trademark and/or copyright licenses, nondisclosure agreements, confidentiality agreements, employment agreements, trademark and/or copyright assignments.

***“Organized and accessible recordkeeping of your intellectual property documents and information is important to your business...”***

## 2. Importance of Keeping These Records

Organized and accessible recordkeeping of your intellectual property documents and information is important to your business for many reasons:

### *Securing Your Rights*

Filing applications with the PTO and the Copyright Office helps to solidify rights and confer important federal benefits. However, before you can file you must know the details of the rights you wish to secure. Without proper and accurate details of use and changes to your intellectual property assets, you may weaken the rights of these assets and you may also open yourself up to claims of fraud on the PTO or Copyright Office if you knowingly attest to information that is inaccurate.

### *Litigation*

#### Enforcement

When you need to assert intellectual property rights over an infringer or find it necessary to defend your rights when approached by another entity, you will need to assess the strength of your rights and how best to proceed. Effective recordkeeping will help you determine whether or not your company is the senior user and valid owner of the intellectual property in question.

#### Discovery

In any trademark lawsuit or adversarial proceeding before the PTO, during the discovery period you will be asked to produce information regarding length of trademark use, geographic scope of use, marketing collateral in which the trademark appears, channels of trade, whether the trademark has been altered

or modified in any way, whether there have been any periods of sporadic or nonuse, as well as other information. Organized and accessible recordkeeping will enable you to produce the requested information more efficiently and accurately.

### *Intellectual Property Valuation*

If you contemplate selling your business, or a particular division, or some of your intellectual property assets, then you must be able to accurately assess the value of your intellectual property portfolio. Oftentimes an outside consultant will be brought in to make a value determination. Maintaining comprehensive and accurate records will be paramount to this process.

## 3. Establish a Plan

We recommend following these guidelines to help with your intellectual property recordkeeping:

- Identify what is important.
- Identify where your intellectual property records are currently located and move them to a central, secure location.
- Create a system for storing and retrieving. Many companies scan old records for easy storage on a computer. A spreadsheet and/or database also can be helpful tools.
- Establish an official recordkeeper to minimize loss or confusion of records.