

Mentor Guide

Session 4: **Developing a Draft IP Plan**

 1 HOUR



INNOVATION COUNCIL

Session Objective

The objective of this session is to develop a draft IP Plan for potential execution during the coming 6-12 months, specific to your mentee's invention, business, and commercialization plans. During this session, you should answer any remaining questions your mentee may have.

Developing an IP Plan with your Mentee

Patents

Determine a preliminary patent filing strategy, based upon the key markets for sales of products that might include your mentee's invention and the likely manufacturing locations of such products.

Determine potential patent attorney/agent resources to contact to pursue the patent protection process. Consider both fee-based and pro bono services, whichever is preferred by the mentee. Decide upon a date for your mentee to select and contact the preferred candidate(s).

Your mentee should be informed to:

- Discuss the preliminary filing strategy with the selected patent attorney or agent to determine where the first patent application should be filed (domestic, regional, PCT).
- Discuss commencing a patentability search for her invention prior to filing a patent application and obtain a commitment date from the attorney/agent to complete search and render a patentability opinion.
- Discuss the estimated fee, if any, for preparation of the patent application and associated filing, prosecution and issue costs/fees.
- Discuss the patent prosecution process, so your mentee will understand time frames for, and issues that may arise during, the entire process.

Trademarks

Determine a preliminary trademark filing strategy to discuss with a trademark attorney, based on the key markets for sales of your mentee's products.

Determine potential trademark attorney/agent resources to contact to pursue the trademark protection process. Decide upon a date for the mentee to select and contact the preferred candidate(s).

Your mentee should be informed to:

- Discuss the preliminary filing strategy with the selected trademark attorney to determine where the first trademark application should be filed (domestic, regional, Madrid Treaty).
- Discuss commencing a trademark search for her preferred trademark prior to filing a trademark application and obtain a commitment date from the attorney/agent to complete search and render a trademark opinion.
- Discuss the estimated fee, if any, for preparation of the trademark application and associated filing, prosecution and issue costs/fees.
- Discuss the trademark prosecution process, so the mentee will understand time frames and issues that may arise during the entire process.

Copyrights

Determine which documents your mentee has created, or will create, that are candidates to be marked with copyright notice.

Establish a date for your mentee to complete adding copyright notice to the identified documents and seek copyright registration, if required.

Trade Secrets

Identify documents that contain information that your mentee desires to have maintained as a trade secret.

Establish a date for your mentee to complete adding the term “Confidential” or “Confidential and Proprietary” to the identified documents.

If your mentee intends to disclose the trade secret to others, she should obtain a nondisclosure or confidentiality agreement from a qualified attorney to be signed by intended recipients of the trade secret information before such information is disclosed to them.

If your mentee has employees, the employees should be required to sign confidentiality agreements, also before receiving any trade secret information.

Final Questions

Ask your mentee if she has any other questions before closing the session. Consider discussing monitoring and IP enforcement in relation to any IP rights your mentee chooses to utilize.