SLW INSTITUTE
Building Extraordinary IP Assets

GUIDELINES FOR INTELLECTUAL PROPERTY COMMUNICATION

Open communication often times provides a useful outlet to spur innovation. Nothing in this document is intended to stifle technical communication regarding innovative ideas.

However, when legal issues arise, it is important to understand how to appropriately communicate to avoid potentially harmful statements being used against the company in later litigation.

The following guidelines provide information on proper communication of issues related to IP.

When in doubt, avoid making any patent/legal conclusions regarding your company or non-company patents outside the presence or oversight of your legal counsel. As always, the company or legal counsel should be consulted anytime there is uncertainty in how to properly communicate an IP issue.

WHEN TO BE CAUTIOUS WITH COMMUNICATION

The following are examples of circumstances involving legal issues surrounding technology and IP where proper guidelines should be followed.

- ✓ Outside parties are identified as developing or selling products that look similar to your company technology and/or intellectual property.
- ✓ Patents belonging to another party are being reviewed with regard to your company products or technology. For example, a third-party patent is being reviewed to determine if a company product may be infringing the patent.
- ✓ Any time there is a characterization of a company or other party patent (e.g. what does the patent cover, what is its scope, has the technology of the patent been known before, or any other inquiries relating to the applicability or enforceability of a patent).

HOW TO COMMUNICATE

Written communication to the company legal or outside counsel should include "Attorney Client Privileged and Confidential" language in the subject line and/or at the top of the body of the message. To help ensure that the information is privileged, there must be some type of legal/patent related question directed at the recipient attorney.

The content of communications, especially written messages (email, regular mail, memos, internal notes, etc.) can be damaging. Remember to handle privileged material very carefully and not allow disclosure outside of the company. Inadvertent disclosure outside of the company can serve to waive privilege.

It is also important to avoid certain words or phrases and make certain judgments outside of the presence of your legal counsel. Although in some circumstances use of the following words and phrases may be benign, it is a good practice to avoid using the following in any recordable communication:

- ✓ "Infringe"
- ✓ "Invalid", "invalidity" (especially when referring to company IP)
- ✓ "Prior art" (when referring to company IP)
- ✓ "Not Patentable"
- ✓ Claim Language (avoid using text of any outside party patent claims)

Any time IP violations are being reported or discussed, it is preferred that the communication is done verbally by telephone, video call, video conference, or in person with company legal or outside counsel. Sometimes this is not feasible or efficient, and a written communication (i.e. email) is needed at least to set up a more detailed follow-up call.

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HOW TO COMMUNICATE (*cont.*)

In these cases, email communication is permitted so long as the communication is kept at a high level and details are saved for the subsequent call.

Details to avoid include:

- ✓ Reference to specific patent (by number or title for example);
- ✓ Reference to specific products; and
- ✓ Reference to specific legal conclusions (e.g. infringement, invalidity).

An example of acceptable communication: "Setting up a call to discuss IP concerns with respect to competitor X" or "Discussion of X IP."