

# Checklist—Intellectual Property Due Diligence

Mark Penner and Sarah Goodwin, Fasken Martineau DuMoulin LLP

The following is a non-exhaustive list of information to be requested/obtained when conducting an intellectual property (IP) due diligence review of a company (the “Company”) for a commercial transaction. Documents and/or information should be requested for both the Company and its subsidiaries, if any.

NO.	ITEM DESCRIPTION	DATE PROVIDED	NOT APPLICABLE
1.	<b>INTELLECTUAL PROPERTY</b>		
1.1	Names of all law firms that handle intellectual property matters for the Company, and contact names and numbers.		
1.2	Schedule and copies of all intellectual property registrations and pending applications therefor, including: issued patents, patent applications, design patents, design patent applications, industrial designs, industrial design applications, copyright registrations, trade-mark registrations, trade-mark applications and integrated circuit topography (mask works) registrations, (including any other applicable related foreign IP, such as petty patents, etc.). Schedules should include jurisdiction in which each item of IP is registered or applied for. Schedules should include status of all pending cases.		
1.3	Identify those patents, patent applications and patent families, as well as trade-marks, that relate to technologies which are currently commercialized/licensed and technologies for which regulatory approval is being or will be sought for commercialization or license.		
1.4	With respect to the items listed in 1.3, please identify the most relevant competing technology, if any, and the most relevant prior art.		
1.5	With respect to all pending patent applications in Canada or U.S. (or such other key foreign jurisdictions), provide a copy of the most recent office action or Examiner’s report.		
1.6	Schedule of all trade-marks, copyrights or proprietary information of the Company not protected by registration, including without limitation, common-law trade-marks, trade secrets, know-how, processes, programs and confidential information relating to operations of the Company.		
1.7	All agreements and documents relating to ownership and rights of use and publication of advertising copy, trade-marks, logos and slogans used in connection with the Company’s business, products or services, including licences, assignments, waivers and releases, and agency agreements.		
1.8	All agreements and documents relating to ownership and rights of use for all issued patents, patent applications, design patents, design patent applications, industrial designs and industrial design applications used in connection with the Company’s business, products or services, including licences, assignments, waivers and releases, and agency agreements.		
1.9	All agreements and documents relating to assignment or license of copyright in any copyrightable material used by the Company, including releases of any moral rights of the authors.		

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NO.	ITEM DESCRIPTION	DATE PROVIDED	NOT APPLICABLE
1.10	All research and development agreements, including without limitation, joint development agreements and development agreements with contractors.		
1.11	All agreements concerning assignment, purchase, sale or license of proprietary rights, including patents, copyrights, trade secrets, know-how and trade-marks. Such agreements should include assignment or licences granted or received and a description of any royalty payments or ongoing obligations.		
1.12	Schedule of exclusive rights granted by the Company with regard to its products or intellectual property rights.		
1.13	Copies of all patent or trade-mark searches conducted by or on behalf of the Company with respect to trade-marks or patents listed in 1.2 or 1.6 noted above.		
1.14	Policies of the Company addressing the protection of proprietary information.		
1.15	Copies of the Company's employment agreements (including standard agreements and those of key personnel/employees), including any terms directed to intellectual property ownership.		
1.16	Schedule of all material software, databases or proprietary processes used by the Company and copies of all agreements granting the Company the right to use such software, databases or proprietary processes.		
1.17	All confidentiality, nondisclosure and/or proprietary rights assignment agreements with contractors, visitors or other non-employee parties.		
1.18	Copies of all proprietary rights notices used by the Company, dates such notices were first used and, if changed, date or dates of changes.		
1.19	Schedules of all domain names owned or registered by the Company and registrations or assignment documentation relating thereto.		
1.20	All documents and correspondence relating to current, past or potential claims or disputes concerning infringement, validity, conflict, re-examination, interference or any other disputes involving proprietary or intellectual property rights owned or used by the Company.		
1.21	All documents and correspondence relating to current, past or potential claims or disputes concerning infringement, validity, conflict, re-examination, interference or other disputes involving proprietary or intellectual property rights owned or used by third parties directly or indirectly involving the Company.		
1.22	All other documents or descriptions of all other facts or information that may be important to an understanding of the Company and its subsidiaries and their business.		

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