

IP DUE DILIGENCE

Asset? Stock? Merger? Licensing?
Recordation necessary?

IP ASSET	DILIGENCE CHECK	RATIONALE	POST-CLOSING HORROR STORY
PATENTS (Federal law)	<i>Issued or Pending</i>	Are you acquiring a <i>patent</i> or a patent <i>application</i> still under examination?	It's not a patent; no exclusivity; no chance application will be granted.
	<i>The Claims</i>	READ CLAIM 1! – do the patent <i>claims</i> cover “the IP” being purchased?	Patent is irrelevant.
	<i>Assignment</i>	Who actually owns the IP? – Who might have a security interest?	Not the Target; the Bank.
	<i>Inventors</i>	Has each co-inventor assigned?	Rogue co-inventor assigns 100% patent rights to competitor.
	<i>Expiration Date</i>	When does the patent die? (20 years from first U.S. non-provisional filing date); PTA?	A lot of money for short period of exclusivity.
	<i>Fees</i>	Have all maintenance fees been paid, or need to be paid after closing? (Fees due Yrs. 4, 8, 12)	Target didn't timely pay (patent's dead); or Acquiring company didn't docket due date and missed it.
	<i>Continuity Data</i>	Are there related patents in the family that need to be acquired?	Didn't acquire all the patents. Target sells the others to your competitor.
	<i>Worldwide Patent</i>	There is no such thing.	Mistaken belief no-one else can make the patented product.
	<i>Freedom-to-Operate</i>	Will you still infringe a third party's patent?	Yes. Bad day.
TRADE SECRETS (State law)	<i>What are they?</i>	Identify Target's trade secrets with specificity . Kept secret???	There aren't any. Not secret.
	<i>Statute</i>	Almost every state adopted the uniform trade secret act but check for definitions, damages.	Target state's trade secret laws.
	<i>Court's Factors</i>	Evaluate trade secret classification using court criteria	Realize court likely won't uphold trade secret status.
	<i>Need to Know</i>	Who knows about the trade secret?	Too many. Not bound by confidentiality.
TRADEMARKS	<i>What are they?</i>	Common Law "TM" or federal ®?	Jurisdiction enforcement power.
	<i>Goodwill</i>	Remember to convey goodwill	Assignment invalid.
COPYRIGHTED MATERIALS	<i>Software</i>	Are you acquiring open source or mixed software?	Someone else owns or can use copyright-protected software.
DOMAIN NAMES	<i>Websites</i>	Are you acquiring websites? Convey all domain names.	Cyber-squatter charges \$XM.
LICENSES	<i>Out-licenses</i>	Has "the IP" been licensed to anyone? Assumed?	Yes and did not know about it.
	<i>Improvements</i>	If "the IP" has been licensed, who owns improvements and developments?	The licensee. Grantback obligations?
	<i>In-licenses</i>	Did the Target license-in IP necessary to operate? Consents?	Yes, they did. Freedom-to-operate problem.
	<i>Antitrust</i>	Tying or patent misuse issues?	Lost leverage.
EMPLOYEE AGREEMENTS	<i>Assignments</i>	"Hereby assign" or future promise to assign?	Target employee assigns patent to competitor.
AMERICA INVENTS ACT	<i>NEW LAW: FIRST-TO-FILE</i>	Identify all new Target inventions as soon as possible and consider filing patent applications after closing.	Lose race to Patent Office.

HELPFUL RESOURCES

**USPTO Website
for searching
patents**

<http://patft.uspto.gov/>

**USPTO website
for searching
trademarks**

<http://www.uspto.gov/trademarks/index.jsp>

**USPTO Public
PAIR**

<http://portal.uspto.gov/pair/PublicPair>

**Patent Term
Expiration
Calculator**

<http://www.maxval.com/patenttool/PatentTermCalculator.aspx>

**Download PDFs
of Patents**

<http://www.pat2pdf.org/>

**WIPO website
for non-U.S.
Patent filings**

<http://patentscope.wipo.int/search/en/structuredSearch.jsf>

**USPTO Manual
of Patent
Examining
Procedure
(MPEP)**

<http://mpep.uspto.gov/RDMS/detail/manual/MPEP/e8r9/d0e18.xml>

MPEP § 313 Recording of Licenses, Security Interests ...

Copyright Office <http://www.copyright.gov/>

**Idaho Trade
Secret Statute
(Title 48, Chapter
8)**

<http://law.justia.com/codes/idaho/2011/title48/chapter8>

**Taxable Income -
IRS Definition of
Intangible
Property**

<http://www.law.cornell.edu/cfr/text/26/1.482-4>

uspto.GOV
The United States Patent and Trademark Office
an agency of the Department of Commerce

Home Patents Trademarks Other

Patent eBusiness

- Electronic Filing
- Patent Application Information
- Patent Ownership
- Fees
- Supplemental Resources & Support

Patent Information

- Patent Guidance and General Info
- Codes, Rules & Manuals
- Employee & Office Directories
- Resources & Public Notices

Patent Searches

- Patent Official Gazette
- Search Patents & Applications
- Search Biological Sequences
- Copies, Products & Services

Other

- Copyrights
- Trademarks
- Policy & Law
- Reports

Patent Application Information Retrieval

Order Certified Application As Filed Order Certified File Wrapper View Order List

11/770,130 FRENCH FRY PRODUCTION METHOD WITH REDUCED CRUMB GENERATION SIMPLOT-49331

Select New Case Application Data Transaction History Image File Wrapper Patent Term Adjustments Continuity Data Fees Published Documents Address & Attorney/Agent Supplemental Content Display References

Bibliographic Data

Application Number:	11/770,130	Customer Number:	-
Filing or 371 (c) Date:	06-28-2007	Status:	Patented Case
Application Type:	Utility	Status Date:	04-17-2013
Examiner Name:	GEORGE, PATRICIA ANN	Location:	ELECTRONIC
Group Art Unit:	1793	Location Date:	-
Confirmation Number:	5916	Earliest Publication No:	US 2008-0008797 A1
Attorney Docket Number:	SIMPLOT-49331	Earliest Publication Date:	01-10-2008
Class / Subclass:	426/438	Patent Number:	8,435,583
First Named Inventor:	Michael L. Hamann , Caldwell, ID (US) all Inventors	Issue Date of Patent:	05-07-2013
First Named Applicant:	-	AIA (First Inventor to File):	No
Entity Status:	Undiscounted		

Title of Invention: FRENCH FRY PRODUCTION METHOD WITH REDUCED CRUMB GENERATION

Vid Mohan-Ram
J.R. Simplot Company
vid.mohan-ram@simplot.com
208 389 7638