

WHY ARCHIVE COMPANY RECORDS – a personal view from a UK IP practitioner

by John Grant, Trevor Baylis Brands plc

Throughout my working life, initially in the employ of The British United Shoe Machinery Company Limited and latterly Redland PLC, acquired by Lafarge SA of France in 1998, I have had access to extensive Company files relating to research and development that reflected the history of machines, products and processes over a considerable number of years and the Intellectual Property Rights secured in connection therewith.

Therefore, when it has been necessary to advise the executives of the various Companies within the Redland Group of Companies as to whether a new machine, a new product, a new cementitious composition or a new method of manufacture was novel and whether there was a risk of infringement of any third party rights, I had the confidence to access the files available to me and formulate an opinion that could be given to the executives in the full knowledge that the opinion was well founded.

The formulation of opinions in relation to IP matters can only be reached by due diligence and access to appropriate records.

When I joined Redland in 1974, I was fortunate to be taken on an induction tour of the concrete roof tile and clay brick factories. I also met with roof tile laboratory personnel and was made aware of the laboratory log books that were kept in relation to all of the work conducted on the very many projects that had been undertaken by such personnel. In addition, it was the Company policy to maintain a log of all of the Projects and to keep copies of all Project Reports in a safe place for future reference as required.

Thus, when conducting a novelty and an infringement appraisal exercise, it was relatively easy to determine the chronological progress of any new development from conception to commercial adoption and to evaluate the scope of any protection that the development might enjoy by way of patent, registered design or trade mark.

I was retired from Lafarge SA in June 1998; however, I have been kept busy over the intervening years in relation to the ongoing developments of roofing components and the acquisition of patents, registered designs and trade marks relating thereto.

Recently, there has been a requirement to review files dating back to 1984/6 in connection with an alleged infringement matter and a potential misuse of confidential information.

In both instances, not only were my own contemporary files still available for study, the files of many executives, designers and laboratory personnel were also retained and could be readily accessed and reviewed in order to formulate opinions on their relevance to the questions of infringement and misuse of confidential information.

Such activities can only be undertaken where records are kept and archived for future reference. It is appreciated that it takes time and diligence to both keep and maintain records in addition to the requirement for storage of the records. This latter requirement is perhaps of less import now that many records can be stored electronically.

It may also be difficult to maintain company records where there is a change, or changes, of company structure due to take-overs, downsizing or other causes.

Despite the fact that companies may change in stature, it is still of paramount importance, not only for large corporations but for companies of modest size, that some effort is made to preserve the history of company developments in order to ensure that a position in the market place is not prejudiced by third party activity.

DOCUMENTS FOR ARCHIVING

- (i) Project Initiation Forms;
- (ii) Project Development Reports;
- (iii) Laboratory Notebooks;
- (iv) Marketing Evaluation Reports;
- (v) Reports to Company Executives on proposals for Commercial Adoption;
- (vi) Reports of Subsidiary Companies to Parent Company on commercial activities and details of new developments;
- (vii) Original design drawings of products, machines and schemes for implementation of new methodology in manufacturing processes;
- (viii) History of all Intellectual Property Assets (IPAs) identified from an analysis of the developments considered for Intellectual Property Rights (IPRs);
- (ix) Details of all IPRs established following the analysis of the IPAs;
- (x) Details of any Litigation entered as Plaintiff or Defendant in relation to IPRs held by the Company or third parties respectively;
- (xi) Details of Watching Briefs conducted for third party IPAs and IPRs;
- (xii) Records of Trade Shows, Exhibitions and Symposiums where Company developments may have been launched;
- (xiii) Copies of Trade Literature that included details of new product launch by the Company and third parties;
- (xiv) Annual Sales Figure for Products, Machinery and Services provided by the Company;
- (xv) Details, including copies of Licence(s), of any Licensed out IPAs and/or IPRs;
- (xvi) Details, including copies of Licence(s), of any Licensed in IPAs and/or IPRs; and,
- (xvii) Any other documents that may be useful in a situation where the Company's position in the market place may be prejudiced by third party activity.