



501:Managing a Domestic & Global IP Portfolio-Strategies Beyond the Basics

Katrina Burchell


General Trade Mark Counsel—Home & Personal Care
Unilever PLC

Alexandre A. Montagu

General Counsel
Lipper, Inc.

Bret I. Parker

Chief Trademark & Assistant General Counsel
Wyeth




**Managing a Domestic and Global
IP Portfolio – Strategies Beyond
the Basics (Session 501)**

**Katrina Burchell
Alexandre Montagu
Bret I. Parker**

ACC's 2004 Annual Meeting: The New Face of In-house Counsel October 25-27, Sheraton Chicago

The in-house bar association.™



Agenda

- Introductions and Definition of IP
- Managing the Portfolio
- Payment, Budgets, Strategies
- Docketing Systems and Processes
- Transactions and Portfolio Integration
- Personnel
- Questions and Discussion

ACC's 2004 Annual Meeting: The New Face of In-house Counsel October 25-27, Sheraton Chicago



Introductions

- Katrina Burchell, General Trade Mark Counsel – Home & Personal Care, Unilever
- Alexandre Montagu, General Counsel, Lipper, Inc.
- Bret I. Parker, Chief Trademark Counsel and Assistant General Counsel, Wyeth

ACC's 2004 Annual Meeting: The New Face of In-house Counsel

October 25-27, Sheraton Chicago



Definition of IP

- Trademark, Copyright, Patents, Domain Names and any other intellectual property that can be managed as a portfolio of rights
- Won't be discussing know-how and other rights which are part of broader category of IP and may not require day-to-day management

ACC's 2004 Annual Meeting: The New Face of In-house Counsel

October 25-27, Sheraton Chicago



Managing an IP Portfolio

- In-house or external?
- Global or Local?
- By Brand/Product or by Region?
- Separate specialists?

ACC's 2004 Annual Meeting: The New Face of In-house Counsel

October 25-27, Sheraton Chicago



Managing an IP Portfolio

- What is geographical spread of portfolio?
 - national
 - regional
 - global

ACC's 2004 Annual Meeting: The New Face of In-house Counsel

October 25-27, Sheraton Chicago



Managing an IP Portfolio

- Where is resource located?
 - one central team/person
 - various in-house sites
 - various external resources
 - combination of above
 - split specialists between areas of IP

ACC's 2004 Annual Meeting: The New Face of In-house Counsel

October 25-27, Sheraton Chicago



Managing an IP Portfolio

- Managing by product/brand or by region
 - how is company set up?
 - what are reporting lines?
 - global brand management benefits from one overall picture
 - by category e.g., hair or brand eg DOVE bar, body, skin, hair, deo etc
 - Regional management benefits from specialist lawyers for a territory/region
 - less relevant in today's harmonised world

ACC's 2004 Annual Meeting: The New Face of In-house Counsel

October 25-27, Sheraton Chicago



Unilever as an Example

- business divided into 2 categories
 - HPC
 - Foods
 - + Corporate name and logo managed separately
- one global IP department (7 locations)
 - divided by function then by product group per attorney
 - PATENTS/DESIGNS/KNOW HOW
 - TRADEMARKS/DOMAIN NAMES/©*
 - » * in conjunction with general legal

ACC's 2004 Annual Meeting: The New Face of In-house Counsel

October 25-27, Sheraton Chicago

Organisation Structure Unilever Intellectual Property Group



ACC Association of Corporate Counsel

INTELLECTUAL PROPERTY GROUP

Unilever

Welcome to our site.
The IP Group is responsible for Intellectual Property (Designs, Patents, Trade Marks, Domain Names, Copyright, etc) for Unilever, around the world.

IP FRONT PAGE
SITE MAP
INTRODUCTION FROM LOU VIRELLI
THE UNILEVER LOGO
CORPORATE POLICY ON IP
IP EXECUTIVE COMMITTEE
PATENTS HOME
TRADEMARKS HOME

PATENTS TRADEMARKS

Home * Home
Overview * Domain Names
Designs * Counterfeits
Trade Secrets / Know How * Copyright
Who's Who * Who's Who
Publications * Publications
Web Links * Web Links
FAQs * FAQs
Contact * Contact

IP News
UNILEVER: THE NEW FACE OF IN-HOUSE COUNSEL

Outstanding anti-counterfeiting work in China recognised again
Unilever wins 'Best Company'

ACC's 2004 Annual Meeting: The New Face of In-house Counsel

October 25-27, Sheraton Chicago

ACC Association of Corporate Counsel

How other companies manage

- Gillette - all now in US but retained one person in UK
- Glaxo - US and UK based teams
- Coty - all by 1 attorney/1 assistant from NY with external resource in individual countries
- P&G by region in four locations
 - moving towards global product management still in four locations
- Henkel - USA and Germany (for ROW)
- BAT/FORD - shared admin resources
- LIPPER/REUTERS – all managed by GC
- Colgate/Wyeth – all managed centrally at U.S. parent co.
- Unilever – managed by parent co.

ACC's 2004 Annual Meeting: The New Face of In-house Counsel

October 25-27, Sheraton Chicago



Practical Tips

- align management of IP function to set up of company
- facilitate easy communication across multiple sites (emails, websites, shared drives; meetings etc)
- be prepared to be flexible as product ranges develop, companies are acquired or disposed of and geographical territories extend

ACC's 2004 Annual Meeting: The New Face of In-house Counsel

October 25-27, Sheraton Chicago



Payment, Budgets, Strategies

Who pays:

- Is there a single cost center or individual cost centers
- Billing back fees to individual cost centers may encourage product managers not to change marks
- Tax considerations
- Who holds the IP (is there a separate entity)?

ACC's 2004 Annual Meeting: The New Face of In-house Counsel

October 25-27, Sheraton Chicago

Payment, Budgets, Strategies

Who devises strategy:

- Product managers
- Marketing (is there a naming architecture?)
- Get marketing approval
- Timing an issue
- Importance of having a process in place

This form is required for use by all Product Business Owners and/or Product Managers to request assignment and approval of a name to any new product, solution, feature and/or component. All of the information requested on this form is required to facilitate the assignment of a new name and initiate any trademark search/registration activity as required prior to approval of the use of the name. While assignment of a name can happen quite quickly, the standard lead-time for trademark search, Brand/Legal approval and subsequent registration (if required) is 4 - 6 months, **plus accordingly**. Note: the costs for trademark search and registration (if required) are the responsibility of the Product Business Owner. Please complete this form, answering all of the questions, then click Submit. Be concise and use plain language.

1. Product name to be searched:

2. This is a request for:

- A name for a new product family
- A name for a product upgrade or migration of an existing product
- A name for a new package/offering within an existing product family
- A name for a new feature or component
- A name for a feature or component upgrade or migration of an existing feature or component

3. This is a product for the "X" customer segment:

- Sales & Trading
- Asset Management
- Enterprise Data
- Media

OR

This is a feature or component for:

- News
- Information

Close Full Screen

ACC Association of Corporate Counsel

Wyeth

Trademark Search & Application Request Form
Privileged and Confidential Document

Complete and return this form to the attorney in the Trademark Department who is responsible for the product category concerned.

Request: Clearance only Application only Search & Filing after Search Results
 Search & Simultaneous Filing

Product category:
 Consumer Healthcare Pharmaceutical Animal Health Nutritional Other

Particular Product (e.g., lip balms, vaccines for pneumococcal diseases, etc.):

Geographic areas covered (list countries):

Uses/other products in line/possible line extensions:

Generic Name (if applicable):

Date Search Results Required (prefer able to submit more than a year in advance, but at least three month lead time required outside the U.S.):

Names or Design (with back-ups in order of preference):

Projected Product launch date(s) (by country if not global)

Requested by: _____ Date: _____
Phone: _____

Close Full Screen

ACC's 2004 Annual Meeting: The New Face of In-house Counsel October 25-27, Sheraton Chicago

ACC Association of Corporate Counsel

Payment, Budgets, Strategies

Increasing demands for budget costs and calls to be profitable:

- In-house or law firm management of portfolio
- Consolidate portfolios in one location/one database
- Match up product names with trademark registrations
- Do not renew trademarks for obsolete products
- Examine your naming architecture
- Use your name brand name with a descriptive stem to save lots of money

ACC's 2004 Annual Meeting: The New Face of In-house Counsel October 25-27, Sheraton Chicago



Payment, Budgets, Strategies

Searching:

- Use online screening tool to run preliminary searches to eliminate conflicts; local searches are expensive and take a long time (up to one month).
- This is the single area where you can save a lot of time and money; do screening searches yourself even if you're working with an outside law firm

ACC's 2004 Annual Meeting: The New Face of In-house Counsel

October 25-27, Sheraton Chicago



Payment, Budgets, Strategies

Filing:

Don't file applications:

1. For marks that will be used short term – (< 2 years);
2. For marks that consist of your main brand (already registered) and a descriptive stem;
3. On an ITU basis if there is a chance that the name will change by the time use begins.

Do file applications:

1. For new marks/brand names/ taglines
2. Where use by a competitor is a concern

ACC's 2004 Annual Meeting: The New Face of In-house Counsel

October 25-27, Sheraton Chicago



Payment, Budgets, Strategies

Renewal:

- Avoid automatic renewal or standing instructions to foreign counsel except with respect to your main marks
- Check with product managers to avoid renewals of obsolete marks.
- Reconsider filing new applications for new versions of a product i.e. Xiling 2000, Xiling 3000: one of these registrations may offer sufficient protection.

ACC's 2004 Annual Meeting: The New Face of In-house Counsel

October 25-27, Sheraton Chicago



Docketing Systems and Processes

- Must meet needs (portfolio size, price, number/location of users, IT and network issues, customized or simple)
- Sarbanes-Oxley?
- What do you want to track? What kind of reports to run?
- Division of docketing responsibilities by task, business or other?
- Garbage in, garbage out; supervision of data entry and paper flow
- Integrate with intranet & access for business people?
- Consistent procedures (documented in a manual)

ACC's 2004 Annual Meeting: The New Face of In-house Counsel

October 25-27, Sheraton Chicago



Transactions and Portfolio Integration

- Quality of record keeping is vital
 - registered rights are easier than unregistered
 - information about IP rights may be in different places within the company
 - eg domain names may be with IT
 - copyright may be with commercial lawyers or marketing
- speed of providing information may be a factor

ACC's 2004 Annual Meeting: The New Face of In-house Counsel

October 25-27, Sheraton Chicago



Transactions and Portfolio Integration

(cont.)

- Clarity of what you are buying or selling
- specialist expertise in negotiation and contracts
 - develop or buy in
- highly detailed and thorough administrative back up required long term
 - retention of staff or of corporate memory is important
- transitional provisions for pending cases/renewals may have staffing issues

ACC's 2004 Annual Meeting: The New Face of In-house Counsel

October 25-27, Sheraton Chicago



Practical Points

- Chain of title - work closely with corporate secretaries to make sure everything updated
- prepare as best as possible for loss of knowledge/expertise on acquired marks
 - retirements, redundancies etc mean that knowledge of old pending files can disappear

ACC's 2004 Annual Meeting: The New Face of In-house Counsel

October 25-27, Sheraton Chicago



Practical Points (cont.)

- transitional arrangements - especially who pays the bills
- amalgamation of records into database - do they have same system?
- storage space for files and certificates
- ensure good working relationship if possible with seller as you will need to get more information!

ACC's 2004 Annual Meeting: The New Face of In-house Counsel

October 25-27, Sheraton Chicago



Personnel

- The right people doing the right jobs?
- If competitive market for staff, how do you keep high-quality people?
- Effect of new people on a department
- Interns = free help
- Stretch assignments
- Honest and regular feedback