



201:IP Basics-A Day in the Life of Counsel

Natalie Butto

Counsel & Assistant Secretary

Tropicana Products, Inc. (PepsiCo)

Horace G. Dawson

Senior Associate General Counsel

Darden Restaurants

Francis Toldi

Vice President-Administration, General Counsel

Determined Productions, Inc.

Leslie A. Weise

Of Counsel

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Faculty Biographies

Natalie Butto

Natalie Butto is counsel and assistant secretary with Tropicana Products, Inc. (a subsidiary of PepsiCo) in Bradenton, Florida. She is primarily responsible for legal issues relating to intellectual property, marketing, R&D, contracts, and regulatory matters.

Prior to joining Tropicana, Ms. Butto was an attorney with an intellectual property law firm in New York City.

Ms. Butto is chair of ACCA's Intellectual Property Committee and has spoken at several national conferences. She serves on the board of directors for the United Way of Manatee County, the Manatee Players community theater (executive committee), the NYU Alumni Club of West Coast Florida, and the National Inventors Hall of Fame Foundation.

Ms. Butto earned a BA from Florida International University, a JD from Georgetown University, and an MBA from New York University.

Horace G. Dawson

Horace G. Dawson, III is senior associate general counsel of Darden Restaurants, Inc., the largest casual dining restaurant company. Darden owns and operates over 1,200 Red Lobster®, Olive Garden®, Bahama Breeze®, and Smokey Bones® restaurants in the United States and Canada. His practice areas include intellectual property, advertising, licensing, and real estate development.

Prior to joining Darden, he practiced in the corporate and securities areas in the Orlando office of Akerman Senterfitt and served as vice president of business affairs and general counsel of Hard Rock Cafe International, the restaurant, merchandising, hotel, and live music venue chain. Prior to joining Hard Rock, Mr. Dawson practiced in the entertainment, securities, corporate, and communications areas for Telemundo Network, the Spanish language television broadcaster and for private law firms.

Mr. Dawson received his undergraduate, law, and business administration degrees from Harvard University.

Francis Toldi

Francis Toldi is vice president-administration and general counsel for Determined Productions, Inc., a privately owned international company. Determined Productions represents owners of intellectual property in the character merchandise industry (including the Peanuts Characters and Felix the Cat), and designs and manufactures premium and promotional products (clients include Wendy's International, Macy's, Universal Studios Theme Parks, Whitman's Chocolate, and others). Mr. Toldi has a mix of business and legal responsibilities. Business responsibilities include administrative coordination of Determined's foreign offices and participation with the president in general management of the company. As a solo counsel, Mr. Toldi's legal responsibilities involve a variety of

subjects, including review and preparation of contracts, intellectual property management, international trade, personnel management, and corporate law.

Prior to his position with Determined Productions, Mr. Toldi was an associate at the firm of Graham & James in San Francisco.

Mr. Toldi is presently the chair of ACCA's Council of National Committees. He is a past president of ACCA's San Francisco Bay Chapter, and founded the small law departments committee for that chapter. He currently serves as a chapter director-at-large. Mr. Toldi is also active with a number of local non-profit groups, sitting on the boards of the Insituto Pro Musica de San Francisco (a San Francisco musical arts organization) and Audubon Canyon Ranch (a Marin County nature preserve and educational organization).

Mr. Toldi received his BA from San Francisco State University and his JD from the University of San Francisco.

Leslie A. Weise

Leslie Weise is the former general counsel and associate general counsel at Redback Networks Inc. Her responsibilities at Redback ranged from managing the legal department and staff, as well as securities compliance, litigation, and the company's litigation.

Prior to her employment at Redback, Ms. Weise was assistant general counsel within the electronic materials business unit of Honeywell International (formerly AlliedSignal). And prior to Honeywell, she was intellectual property counsel at Applied Materials. She started her legal career as a patent attorney at Xerox Corporation.

Ms. Weise serves as the legal chairperson for her local chapter of the Sierra Club.

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IP Practice Pointers

Patents and Trade Secrets

- Company employees should sign an **"Agreement to Assign Inventions and Confidentiality Agreement"** prior to beginning employment.
- All employees should document important research developments (e.g. Inventions) in an **Engineering Notebook**.
 - The U.S. awards patents to the First-to-invent (assuming diligence in pursuing patent protection);
 - Whereas foreign countries award patents to the First-to-file for the patent.
- Once an employee believes he/she has invented a novel and useful development, i.e. an Invention, he/she should consult with In-house Counsel.
 - A standard form **"Invention Disclosure"** submission should be completed by the inventor and submitted to the Legal Department.
- Disclosure with outsiders should be limited to only those with a need-to-know; and only after a **Nondisclosure Agreement** has been executed with the Company.
- Employees should be cautious when discussing INVENTION with others.
 - Beware of "ears" in public places, e.g. airplanes, hotel lobbies, restaurants.
- Trade secret information should be kept out of view from visitors within the Company facility.
 - All visitors to sign a **"Visitors NDA"**.
 - Keep drawings and prototypes out of view of visitors.
 - Accompany visitors at all times within the Company facility.
 - No discussion of Invention in front of visitors unless an NDA and Visitors NDA has already been signed.

- **Patent/Technical Committee** should review Invention Disclosure Submission to determine whether resources should be committed to pursue a patent, based on following factors:
 - Relative significance of invention;
 - Value to core development path of Company;
 - Potential value to competitors;
 - Whether unprotected disclosure (i.e. without NDA) was already made;
 - Foreign patent protection would be barred; and in U.S. would be barred if disclosure was made more than one year prior to anticipated patent filing date.
- Inventors should work with **Patent Attorney** to provide thorough description of the Invention, including all different embodiments, and all other known ways in the field of art of obtaining a similar result.
 - Up to point of filing the patent application, and until patent actually issues.

Trademarks

Trademarks should be:

- Cleared before they are used.
- Registered if they will be used on an ongoing basis.
- Marked with the TM or ® (if registered) symbol.
- Credited in the trademark line/notice at the bottom of advertising marketing copy (e.g. noting the registered trademarks and their owner).
- Used consistently on products and in advertising.
- Used properly in advertising
 - Not used as a noun (generic product name)
 - Not truncated, abbreviated, or unnecessarily modified
 - Distinguished (e.g. capitalized, bolded) from other text

Licensing

- Licensors should determine best method of exploiting the property balancing short-term gain with maximizing ability to exploit the property long-term.

- Increasingly, the best method is not a straight sale of a product but an ongoing licensing, franchising, joint venture or other relationship.
- An important initial task for counsel is to help define how the bundle on rights surrounding the item and ancillary products and services will be divided between the parties and otherwise handled. Will rights be given on a geographic or a product/service basis?
- Selecting the right partner is a critical element of a successful strategy. Counsel is often called on to perform due diligence activities.
- Ensuring that the licensee maintains quality is critical for practical as well as legal reasons. Counsel must insure through contract negotiations and drafting that control is maintained, but also that the licensee is appropriately educated and guided after contract execution through manuals, training sessions and the like.
- The relationship must be appropriately policed. The success of this activity can be enhanced by establishing and communicating rights and obligations upfront.
- It is not unusual for licensees to make significant improvements on the product. This eventuality should be provided for in the contract. The licensor should seek to require prior approval before innovations are attempted and assignment of any improvements back to the licensor without consideration. Licensee should have the incentive to innovate through the right to use such improvements on a royalty-free basis.