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ACCA
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501 How to Build an In-house IP Shop

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Tropicana Products, Inc.

Joseph F. Murphy
Former Vice President of Intellectual Property and Corporate Counsel
PSC, Inc.

Catherine H. Rundle
Legal Director, Marketing and Brands
Sun Microsystems, Inc.

Faculty Biographies

Natalie Butto

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

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/seminars. She serves on the Board of Directors for the United Way of Manatee County, The Manatee Players community theater (Executive Committee), and the NYU West Coast of Florida Alumni Association.

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

Joseph F. Murphy

Joseph F. Murphy is a registered patent attorney with broad in-house legal and business experience. He currently is a corporate consultant on intellectual property strategy, with an emphasis on patents.

Mr. Murphy's in-house experience includes five years as vice president of intellectual property and corporate counsel for PSC Inc. where he founded the in-house legal department. In this position, he developed in-house IP procedures, advised management on patent strategy, wrote and supervised the filing of patent applications.

Mr. Murphy is a member of ACCA, the American Intellectual Property Law Association, the ABA, and the New York State Bar Association. As a volunteer legal educator, he has spoken on numerous panel discussions and on television to discuss the topics of patents and intellectual property.

He holds a BS from Marquette University, and is a graduate of Franklin Pierce Law Center, where he received a JD with an emphasis on intellectual property.

Catherine H. Rundle

Ms. Rundle joined Sun Microsystems, Inc. five years ago and is the legal director for marketing & brands. She currently manages all legal aspects of Sun's worldwide trademark work. In addition, her department provides legal support for Sun's corporate marketing and branding efforts including advertising, sponsorships, PR, ad communications, and eMarketing.

Previously, Ms. Rundle worked at the law firm of Wilson, Sonsini, Goodrich and Rosati for 12 years, specializing in both technology licensing and trademark law. She then joined The 3DO Company as its intellectual property counsel.

Ms. Rundle is a member of the California Bar Association, the Intellectual Property Owners Association, the Intellectual Trademark Association, and the AIPLA. She is also a frequent lecturer with the International Trademark Association and the Practicing Law Institute.

Ms. Rundle graduated from the University of California at Berkeley, magna cum laude, and from Hastings College of Law.

BUILDING AN IP SHOP – CHECKLIST

IP TEAM

- Inside Counsel
- Inside Paralegal
- Outside Counsel

TRADEMARKS

- Selection
- Search
- Opinions
- Registration
- Maintenance
- Notice
- Line
- Usage in advertising
- Usage by OTHER Parties
- Usage "in the family": Licenses between subsidiaries/affiliates of your own companies

PATENTS

- Inventors' Notebooks, use of
- Invention Disclosure Process
- Establishing an Invention/Patent docketing process
- Constituting a Patent Committee
- Dealing with patents of others: Patent Clearance Searches and Opinions of Non-infringement

CONTRACTS

- Managing IP issues, not only as main issues (e.g. in NDAs), but as ancillary issues in all contracts

COPYRIGHT

- Preventing company liability for copyright infringement
- Protecting Company works with registered copyrights

MISCELLANEOUS

- Intellectual Property Audits
- Some real-life examples

Prepared for ACCA Annual Meeting 2002 by Panelists: Natalie Butto, Joseph Francis Murphy, and Catherine H. Rundle