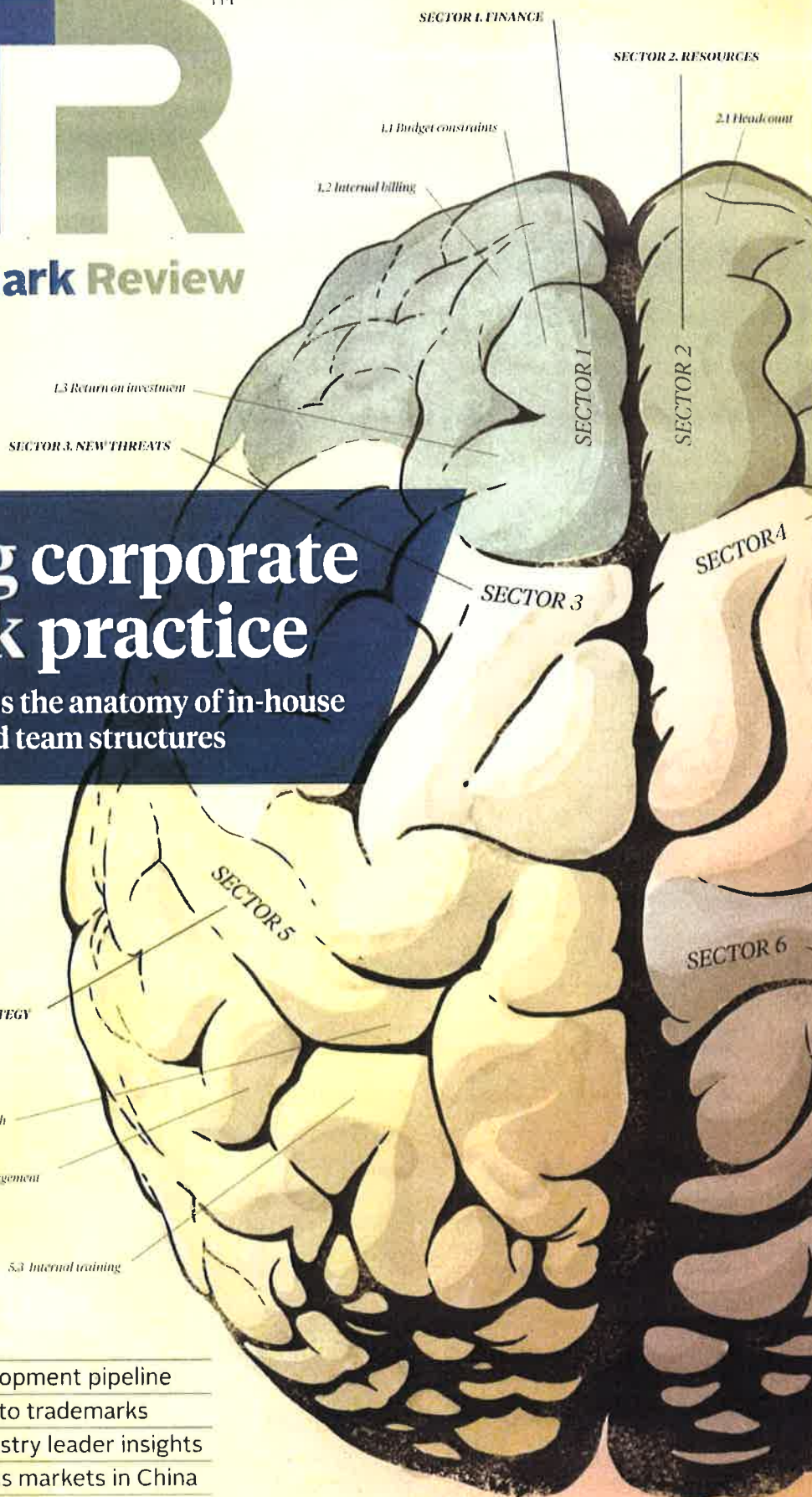


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Dissecting corporate trademark practice

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exclusive interview with Bacardi's Anna Panka

While legal know-how is critical for law firm practitioners, an understanding of the corporate business environment should not be underestimated

A qualified German and Italian attorney, Anna Panka, senior counsel at Bacardi, has spent most of her career working as an IP specialist for law firms, including Jacobacci & Partners and White & Case. In 2011 she entered her first corporate role at the famous alcoholic spirits company, where she is a mainstay of the Geneva-based IP team responsible for managing around 10,000 active trademarks for iconic brands such as Grey Goose, Martini, Bombay Sapphire and Patrón. These marks include the famous Bacardi bat, which has been in use since the 19th century.

Reflecting on the contrasting law firm and corporate environments, she states: "The work of an in-house trademark lawyer is completely different to the work of a lawyer in private practice. You do more of a deep dive into the philosophy of a company, and you get more of an insight into its brands and its business priorities."

Such commercial insights are crucial for corporate brand rights professionals – especially in highly regulated sectors such as the alcohol industry – Panka insists. However, she argues that private practice lawyers would themselves benefit from spending some time in-house: "I believe that every trademark lawyer should work at least half a year within a company. It is good to understand the priorities of your client. In a law firm, you can afford to go deeply into the details of a legal question – which is great. But at a company, you do not have time for that. You need to make quick decisions and take responsibility for them."

The value of working across departments

Panka is not only responsible for handling the full spectrum of brand rights issues, from clearance and prosecution to oppositions, anti-counterfeiting and civil litigation; she also provides legal support to the company's global marketing and innovation teams, and works closely with the technical regulatory team.

"Working with marketing helps you to develop a good knowledge of the industry, as well as the company's vision – its brands and strategies

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– which is crucial for in-house work," she observes. "Marketing is really the communication with the final consumer. By understanding what the company wants to say to the consumer, you learn a lot about what your trademark strategy should be. If I know that there is to be a new global launch, I will make sure that the trademark is very well protected and I will be more aggressive in oppositions."

Bacardi ensures that insights are shared across departments by assembling cross-disciplinary teams to work on major projects. As Panka explains: "We usually work on big projects as a large team, including colleagues from intellectual property, social responsibility, technical regulatory and marketing. That means marketing does pre-clearance work with all of us. We have clearance systems at Bacardi, for example, new packaging needs to go through the approval process involving all stakeholders to guarantee compliance with all laws and regulations."

Working with the marketing department helps Panka to overcome the challenges associated with managing brands which are sold in more than 150 countries. "By knowing in which markets a new product or a marketing campaign will be launched, I can decide where to focus on obtaining rights," she expounds. "If a new slogan will be used across the world and on a long-term basis, it might be worth registering it in key markets. Each brand has different key markets, so if we know that Grey Goose's most important market is the United States, the whole IP and marketing strategy is shaped by this. If a trademark cannot be used in a key market, we would inform the marketing team at an early stage of the project and look for alternatives. We always look closely at the United States and Europe but depending on the product, other key markets must be checked."

Complying with branding restrictions

The difficulties surrounding international trademark management are amplified by the various rules and restrictions that apply to alcohol sales and marketing in countries around the world. "The more markets a company sells into, the more you have to adapt to the different laws and regulations of those countries," Panka highlights. "In a highly regulated sector like ours, internationality is certainly a challenge from a legal point of view. The laws around alcohol are tending to become stricter. Some





L-R: Bacardi and Martini bottle designs

countries are already dark markets, where advertising is highly restricted or completely prohibited. In some markets, you cannot show people in your advertising, in others you cannot include lifestyle elements. In Europe, France and Switzerland are challenging jurisdictions and Spain also has a lot of restrictions. Class 33 registrations are completely banned in other jurisdictions such as in some countries in the Middle East."

Working closely with the technical regulatory team, Panka's group briefs marketing on compliance and social responsibility issues relating to packaging, TV commercials and voiceovers. It also handles all forms of claim substantiation as well as compliance with other labelling and packaging requirements. "We are very strict on these matters, because social responsibility and responsible marketing is very important to the company. We are especially keen to respect the rules. Indeed, the industry imposes a number of restrictions on itself."

Regulations have a direct impact on IP strategy. "For some marketing campaigns we file a slogan globally and different slogans in specific jurisdictions to comply with their restrictions. Also, in some places, a slogan needs to be translated into the local language unless it is filed as a trademark – so we need to be involved in that too."

Tackling counterfeits

Other recent challenges for Bacardi include enforcing its rights against lookalike brands, which often do not use the actual name of the company's brands but imitate other aspects of the products' branding and appearance. The company has faced lookalike issues with the Bacardi, Martini, Grey Goose and Breezer brands, Panka confides. "We are being very vigilant and aggressive against products that are obviously copying our brands or trade dress. We are also filing some of our bottles and labels as trademarks to help us uphold our rights. Word marks are often not enough, because infringers will change the name of the product. We are filing for more and more figurative marks."

She continues: "We always filed our labels, but in the past it was not easy to register the whole trade dress. However, we have recently redesigned some of

our bottles, which we felt were distinctive enough to trademark. We take the bottle in a stripped-down version, without any other branding, and file it as a trademark. We have had a lot of success with this strategy and had a nice victory overturning a refusal by the EUIPO to register our Bacardi bottle. The Board of Appeal found that the overall impression of the particular elements was distinctive enough to register."

However, while Panka tackles wilful infringement aggressively, her approach is softer in other circumstances: "I believe that in the IP world, you have to live and let live. It is important to find ways to coexist; and I would not attack a third party unless I see a real danger for the company or our brands. In some cases, you can find a win-win solution through dialogue and a coexistence agreement of one type or another. Litigation can last for years and cost a lot in legal fees, so it is important to keep dialogue open."

A keen understanding of the business also helps in contentious circumstances, Panka adds. "Working with the technical regulatory and marketing teams helps to get to a better understanding of the products and the industry and therefore also a better understanding of the needs of our competitors. This makes the dialogue easier with our competitors and helps in working out whether a settlement can be reached or not."



By understanding what the company wants to say, you learn what your trademark strategy should be

It therefore helps corporate counsel to fulfil one of their key duties, which is to make important decisions under pressure. "An in-house counsel must be able to pick the right battles," she comments. "Working at a company feels like being a firefighter. You have to have the agility and speed to solve an issue quickly."

However, this broad focus is something that Panka welcomes. When asked what she most enjoys about her current role, she concludes: "The good thing at Bacardi is that our IP legal team is in charge of everything that touches intellectual property – and on a global level. In some companies, especially the largest companies, you get IP teams that do only trademarks or that are in charge of specific regions. But, besides managing our global IP portfolio, we also work with marketing on new branding projects and global advertising and repackaging campaigns. We advise on global brand architecture and identity, and I deal with everything from the first stages of a new project to when the liquid reaches the shelf. This is a challenging and interesting part of our work. It is enjoyable to work with creative people. My mother was an artist and my father was a lawyer, which is why I chose to work in intellectual property; you have both the creative and legal elements." **WTR**



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