



VENABLE<sup>®</sup>LLP

**BRAND IP SEMINAR**  
San Francisco, CA

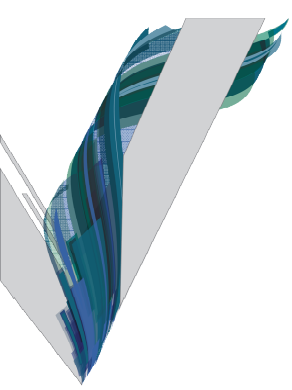
October 1, 2015

Justin Pierce

Partner, Venable LLP

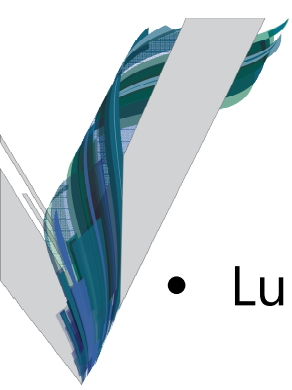
[JPierce@Venable.com](mailto:JPierce@Venable.com)

202.344.4442



# Today's Panelists

- D'Lonra Ellis, Gap
- Meredith Levins, SanDisk
- Kimberly Culp, Venable
- Marcella Ballard, Venable
- Justin Pierce, Venable



# AGENDA

- Lunch & Networking (11:30 am)
- Discussion & Webinar (12:00 – 2:00 pm)
  - Improving Coordination Between Legal and Marketing (M. Levins)
  - Key Things to Consider Before Entering Litigation Involving Your Brand (D. Ellis, K. Culp)
  - Protecting Design Elements in Marketing, Packaging and User Interface (J. Pierce)
  - Best Practices in Brand Protection (M. Ballard)
- Question & Answer



# Improving Coordination Between Legal & Marketing

## Make a PACT with your Marketing Team

- **P**rocess
- **A**ccessible/Approachable
- **C**ommunication
- **T**rust



## Situation 1

It's Friday at 5pm and you receive an email, a call and a text in the span of ~3 minutes. The marketing team want to run something by you prior to launching a new marketing campaign. . . scheduled to launch next week. . . globally. They say it shouldn't take more than a few minutes to review.



## Situation 2

You are copied in on an email thread and see that there are the following statements in the earlier emails:

“I can’t get an answer from Legal and they are delaying the product launch.”

“Legal is taking forever to get back to me.”

“I haven’t sent it to Legal because if I do there is no way we will launch on time.”



## Situation 3

Your inbox/voicemail/calendar is full and you can't get to your car/lunch/bathroom without being cornered by a client with a "quick" question.

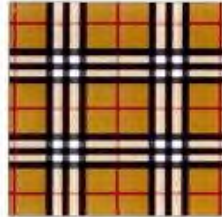


# Key Things to Consider Before Entering Litigation Involving Your Brand

- Your Brand - What do you want to say about Your Brand?
- Your business plan – Where are you going?
- Cost / Benefit – What will it cost (or risk) and what will you get?
- Timing – What events, marketing campaigns, etc. might litigation impact?
- Exposure – Do you have areas of exposure to consider?
- Counsel – Who is the right fit for the matter?



# Protecting Brand Elements in Marketing, Product Design, Packaging and User Interface (UI)



# Protecting Design Elements in Marketing, Packaging and User Interface (UI)

## Trade Dress

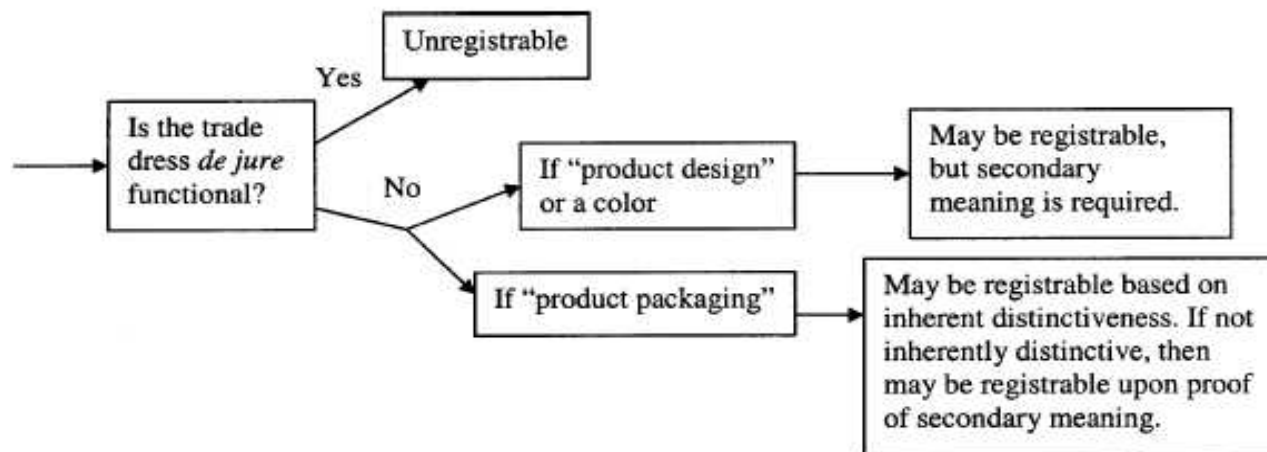
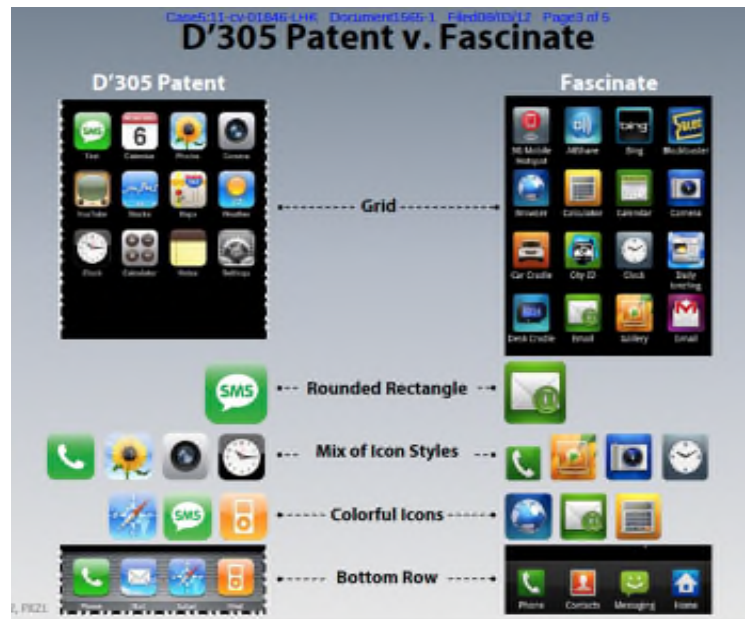
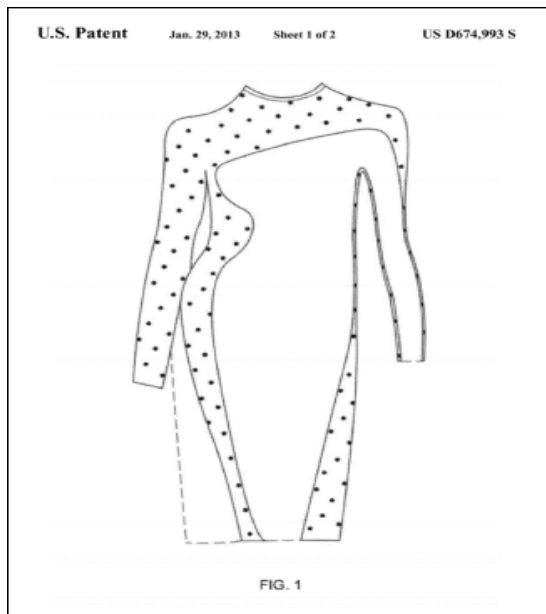


Fig. 1: The Functionality and Distinctiveness Hurdles To Registrability

Image from [http://ip-updates.blogspot.com/2004\\_10\\_01\\_archive.html](http://ip-updates.blogspot.com/2004_10_01_archive.html)

# Protecting Design Elements in Marketing, Packaging and User Interface (UI)

## Design Patents





# Best Practices in Brand Protection

## Top Tier Brand & Content Protection Groups:

- Coordinate on regular basis within their companies between IP, corporate security, and business units.
- Systematically secure IP rights and record with these rights with Customs (where possible) in all places where they manufacture, distribute, and/or have plans to expand.
- Constantly change and improve tactics in order to keep up with sophisticated competitors, counterfeiters, infringers and pirates; this includes keeping pace with current in trends e-commerce, technology and media (e.g. social media, emergence of dark web, 3D printing, new online marketplaces).



## Questions?

Justin Pierce, Venable

[jpierce@venable.com](mailto:jpierce@venable.com)

202-344-4442

Kimberly Culp, Venable

[kculp@Venable.com](mailto:kculp@Venable.com)

415-653-3704

Marcella Ballard, Venable

[mballard@Venable.com](mailto:mballard@Venable.com)

212-370-6289