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Cordillera IP

Building a holistic IP strategy

Using trademarks, copyright and designs to achieve corporate objectives

Pharmaceutical Trademarks Group Conference

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**Can you imagine what I would
do if I could do all I can?
- Sun Tzu**

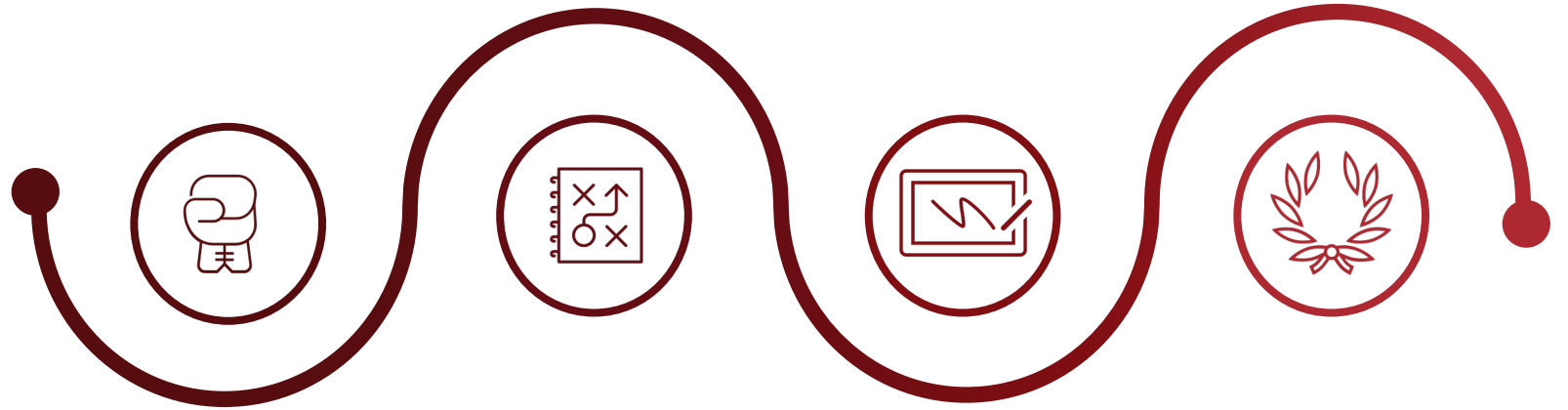


ROADMAP

- The rationale
- The foundation
- The framework
- The takeaway



THE RATIONALE



**Equip
teams to
deliver
against
objectives**

**Risk
management
and
opportunity
capture**

**Enable
effective
business
counselling**

**Optimal
deployment
of IP assets
with defined
rationale**

**Flexibility, agility – IP strategy pivots and evolves
in alignment with the business**



THE FOUNDATION

DEFENSIVE RISK MANAGEMENT

Trademark clearance
Design clearance
Defensive disputes

IP PORTFOLIO BUILDING & MAINTENANCE

Trademark filing and prosecution
Design identification, filing and prosecution
Registered and unregistered copyright strategy

PROACTIVE ENFORCEMENT

Watch strategy
Digital monitoring and enforcement
Proactive disputes (registry and litigation)

COMMERCIAL & ADVISORY SUPPORT

Business guidelines
Business tools and templates
IP fluency and compliance



THE FOUNDATION

DEFENSIVE
RISK MANAGEMENT

PORTFOLIO
MAINTENANCE

Risk Assessment Framework:
Risk definition, corporate approach,
potential impact, approval structure

PROACTIVE

AL &
SUPPORT

Outcomes

Protect innovation

Coherent and
functional excellence
practices

Business disruption
minimised

Budget optimisation

Maximise leverage



THE FRAMEWORK

DEFENSIVE RISK MANAGEMENT

TRADEMARK CLEARANCE CONSIDERATIONS

Existing rights | Nature of the asset | Previous clearance
Distinctiveness of the asset | Proposed use of the asset | Timeframe of use
Goods and services | Geographic scope | Regulatory considerations

DESIGN CLEARANCE CONSIDERATIONS

Image search limitations | Unpublished designs
Geographic footprint | Known prior rights

DEFENSIVE DISPUTE CONSIDERATIONS (REGISTRY & LITIGATION)

Clearance position | Importance of the asset
Importance of the market | Global/national footprint of the asset
Merits | Current use of the asset | Corporate position and exposure



DESIGN CLEARANCE CONSIDERATIONS

SEARCH SCOPE

- Full search – core designs?
- Online/inhouse desktop searches – non-core designs?
- Which markets?
- Known prior art? Existing design corpus?

DESIGN SEARCH CHALLENGES

- Registered and unregistered corpus
- Image search limitations
- Unpublished designs

BUSINESS EXPECTATION MANAGEMENT

- Limitations and scope



THE FRAMEWORK

IP PORTFOLIO BUILDING & MAINTENANCE

TRADEMARK FILING CONSIDERATIONS

Asset type (main brand, variant name, packaging, slogan) | Geographic footprint
Regulatory considerations | Stealth considerations | Cost considerations
Goods and services (broad protection vs. minimal objections) | Enforcement objectives

DESIGN FILING CONSIDERATIONS

Type of asset (product, packaging, brand element, design feature)
Whether to file (novelty, individual character, value) | What to file (3D/2D, country requirements)
When to file (disclosure risks) | Geographic footprint

REGISTERED AND UNREGISTERED COPYRIGHT CONSIDERATIONS

Type of asset (product, brand element, packaging, written materials)
Enforcement optionality | Damages recovery
Securing copyright (employees, consultants, contractors)



DESIGN FILING STRATEGY

- Novelty
- Individual Character
- Asset value

WHETHER TO FILE

- 3D or 2D design
- Whole or part
- Local requirements

WHAT TO FILE

- Design locked
- Disclosure risks
- Need to maintain secrecy

WHEN TO FILE

- Asset value
- Commercial footprint

WHERE TO FILE

Considerations

- Design enforceability under local law
- Company commercialization priorities
- Manufacturing locations (company and competitor)
- Cost effectiveness and synergies with other IP rights



DESIGN FILING STRATEGY

IDENTIFY

Design is close to lock-down or disclosure imminent:
File Registered Community Design (priority claim; deferred publication)



BUILD

Prior to 6-month priority date:
1) Roll out further filings (disclosure likely in 6+m) **or** 2) Withdraw RCD (secrecy maintained)



PROSECUTE AND REGISTER

Pursue prosecution of key designs in enforcement priority markets

The design filing tension

Establish an early filing date – protect against inadvertent disclosures

Avoid destroying individual character by filing before design is finalized

Ensure soonest post-launch protection in key enforcement markets



THE FRAMEWORK

PROACTIVE ENFORCEMENT

WATCH STRATEGY

Nature of asset (global, regional, local asset) | Goods/services
Geographic breadth | Particular competitor focus
Review and revision

DIGITAL MONITORING & ENFORCEMENT

Social media | Marketplaces | Apps
Websites and domains

PROACTIVE DISPUTES (REGISTRY & LITIGATION)

Importance and footprint of the asset | Importance of the market
Merits | Current use of the asset | Broader freedom to use risk
Scale of impact | Notorious/repeat infringement | Reputational harm | Consumer harm
Parallel patent infringement | Speed and types of remedies



PROACTIVE DISPUTE STRATEGY

PROACTIVE DISPUTES (REGISTRY & LITIGATION)

Importance and footprint of the asset |
Importance of the market
Merits | Current use of the asset | Broader freedom to use risk
Scale of impact |
Notorious/repeat infringement |
Reputational harm |
Consumer harm
Parallel patent infringement | Speed and types of remedies

Infringing product using key features (main brand, core design)

Significant scale or impact

Enforcement criteria

ENFORCEMENT OBJECTIVES / CORPORATE OBJECTIVES

Block

Disrupt

License

Cross- license

Definition of 'success'



THE FRAMEWORK

COMMERCIAL & ADVISORY SUPPORT

BUSINESS GUIDELINES

Use of company trademarks | Use of ©, ® and ™ symbols
Legal lines | Use of third-party trademarks and copyright
Asset clearance guidelines

BUSINESS TOOLS AND TEMPLATES

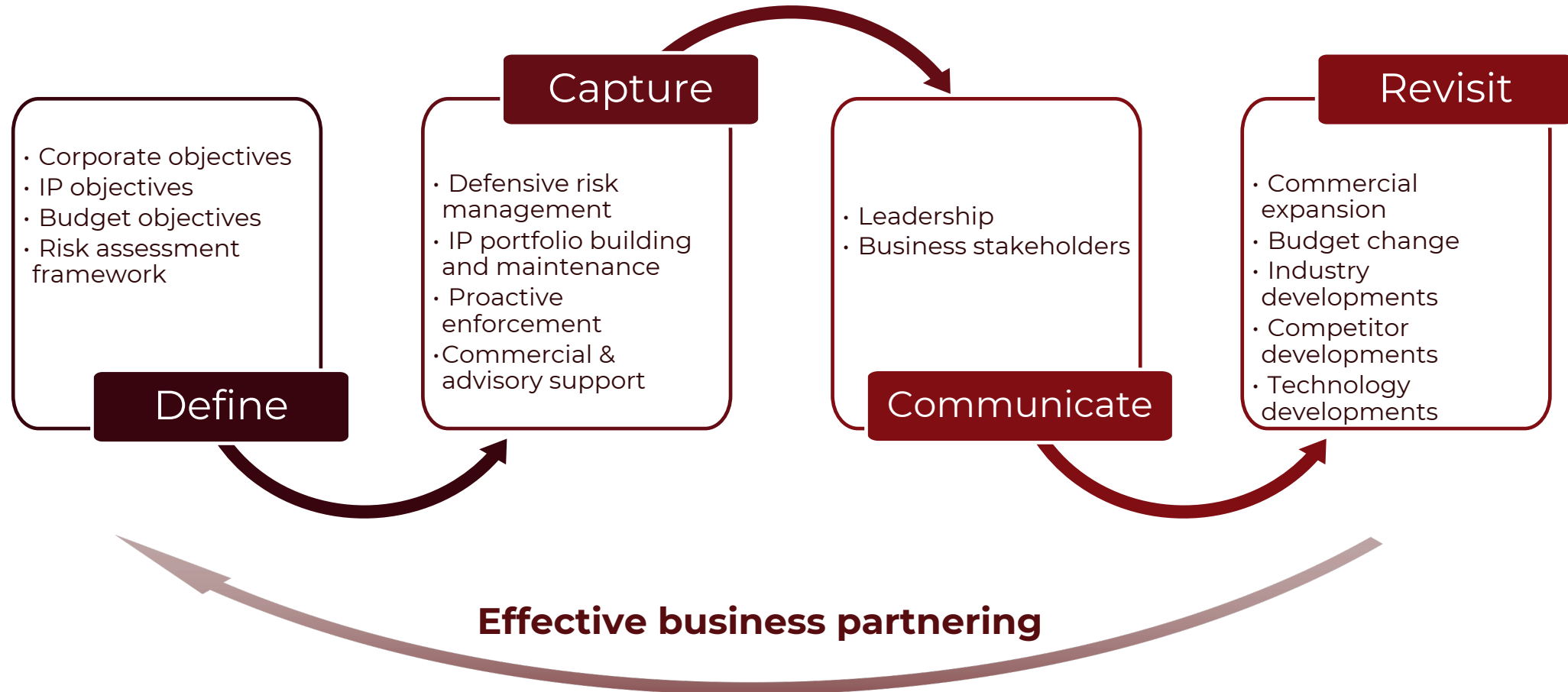
Template IP assignment/work-for-hire clauses
Template license clauses | Template waivers

IP FLUENCY AND COMPLIANCE

Onboarding training | Compliance tools
Internal communication (intranet)



THE TAKEAWAYS





www.cordillera.ch