

Mark of Success

Unilever outsources the management of one of the biggest trademark collections in the world.

By Jill Nawrocki

FROM HELLMAN'S MAYONNAISE IN America to Domestos bleach in France to Rexona deodorant in Russia, Unilever has one of the largest trademark portfolios on the planet, with more than 160,000 names currently in use. So when the consumer products giant decided to outsource the management of this massive collection, it turned to a law firm with a footprint that also spans the globe.

Baker & McKenzie, with 70 offices in 38 countries, won Unilever's work in a unique beauty contest last year. Now the company is in the process of moving thousands of records and documents to the firm. Several Unilever attorneys are also leaving their in-house posts to

technology you offer." But Burchell knew that Unilever wouldn't fund the type of technology she needed, either a global network for trademark tracking or specialized software. "It's hard to get an investment in a company database when it's not core to the business," she explains.

The first step in solving the problem came in September 2005, when Burchell quizzed Unilever's rivals on how they managed their own trademark collections. "We wanted to know what worked for them and what hadn't," Burchell says. "We looked at everything. We asked them how they do things, why they do things. We wanted ideas."

While the companies that she consulted all compete with Unilever on the product level,

solution. It was looking for an overall solution to its challenge."

Unilever sent its RFP to 30 firms in December 2005, and all but three responded with proposals. The company ultimately selected 3,400-lawyer Baker & McKenzie, which had previously done some trademark work for the company in Hong Kong. Burchell says the firm won because it offered the most comprehensive solution. Baker & McKenzie's data management system—which operates as a single global intellectual property library—will enable lawyers both inside and outside Unilever to access the company's portfolio, run reports, and track the progress of trademark applications. It will also simplify the process used to locate vital statistics on any mark, from anywhere in the world.

Paul Rawlinson, a London-based partner who chairs Baker & McKenzie's global IP group, says that the relationship with Unilever involves "outsourcing not just areas of work, but also the underlying database, records management, documents, and some of their people." The firm does trademark work for other companies, but nothing on the scale of what it will do for Unilever.

At press time the outsourcing was scheduled to become complete in January. Burchell wouldn't divulge how much the arrangement will cost Unilever. But she says that it has allowed her to reduce her staff to 28, including nine attorneys.

Burchell believes that the outsourcing initiative will pay off over time. Baker & McKenzie had a "clear ability to know what we needed," she says. "They're simplifying the work, and that's quite a challenge."

Unilever didn't have the kind of technology it needed, but Baker & McKenzie did.

join Baker & McKenzie's payroll as part of the assignment. (Neither the firm nor the company would say exactly how many.)

Outsourcing trademark work isn't new, but for London-based Unilever, turning over the management of its gigantic collection of brand names was an unprecedented step. "It was hard to do, because we had no real example [of another company outsourcing a huge trademark collection] to follow," says Katrina Burchell, Unilever's head of trademarks and global category counsel.

Prior to the outsourcing initiative, Burchell headed a 54-person staff that oversaw the company's portfolio of brand names. The attorneys in her office worked on every aspect of trademark management, from clearing and registering new names to litigating unfair competition issues.

As big as Burchell's staff was, however, it wasn't enough. Successful mark management, she says, "has less to do with the number of people you have, and more to do with the

Burchell says that trademark attorneys are typically more willing to share information because they face similar obstacles regardless of industry. (She declined to name the companies she talked with, due to confidentiality agreements signed with each.)

After months of research, meetings, and interviews, Burchell crafted a unique request for proposals. Instead of simply outlining the job to be done and requesting a breakdown of costs, she defined Unilever's current needs and goals for the future, then asked for a solution. The company wanted a firm that could handle trademark prosecution and administration, license recording, database management, and audits, too. Burchell stresses that the most important factor was how firms would approach the task. Cost, she says, was secondary.

"Theirs was certainly an unusual approach," says Rees Morrison, a consultant at the Somerset, New Jersey-based Hildebrandt International. "Unilever was looking for more than a financial