



Inside Track: Language lessons – the Xerox experience

Fighting off the risk of genericide is just one challenge that faces successful brands. Margaret Williams Walker, associate general IP counsel at Xerox Corporation, explains the company's approach to IP enforcement and how it has strived to ensure proper use of the XEROX mark

No matter what the industry, the primary goal of any brand owner is to become the market leader and have its products become the first point of call for consumers. However, if that dominance is pushed too far, the brand owner may quickly find its trademark rights in jeopardy.

The need to strike the right balance between success and potential genericide is at the forefront of Xerox Corporation's IP decision making, as associate general IP counsel Margaret Williams Walker explains: "We do have the concern of the XEROX mark being misused as a verb and/or noun. This particular problem is one that

varies from jurisdiction to jurisdiction, and requires specific creative measures to address in each."

However, there are practical strategies that can be adopted to counter this risk, and Walker suggests that others can take some practical pointers from her company's experience: "My hope is that Xerox really serves as an example of what an owner of a mature brand must do to protect against genericism. I hope also that we can be an example for new brands of the steps that must be taken, from the outset, to protect against genericism."

From real estate to intellectual property

Before joining Xerox, Walker was an associate at Nixon Peabody (formerly Nixon Hargrave, Devans & Doyle), where she specialised in real estate and municipal finance. It was in a related capacity that, after approximately three years, she joined Xerox Corporation – coming on board as a real estate attorney.

Having made the transition in-house, she found the deeper involvement it afforded particularly welcome: "While I enjoyed my



Xerox at a glance

- Founded: As the Haloid Company in 1906. The organisation was then named Haloid Xerox in 1958 and became Xerox Corporation in 1961.
- Revenue in 2010: \$22 billion
- Employees in 2011: 136,000
- Geographic scope: 160 countries

experience at Nixon, I found the in-house life more rewarding, as it gave me the ability to focus wholly on one client and contribute directly to the success of a great company.”

After making the move, she spent several years travelling the United States negotiating commercial leases for the company, before an opening in the legal department led to her transition to what she describes as the “dark side of IP”, in the licensing and litigation group.

Although this was a distinct change of direction in some respects, her real estate experience nonetheless proved a useful asset: “In the IP group I worked specifically on patent litigation and patent licences, and my experience with real estate property actually helped in my transition to intellectual property - certainly the contracting skills I developed in negotiating and drafting lease agreements proved useful.”

In terms of patents, Xerox is continuing to expand its heavyweight portfolio. In 2011 it obtained 1,030 US patents and, including patents obtained by Japanese joint venture Fuji Xerox Co, it was ranked eighth on the IFI Patent Intelligence list worldwide.

Yet patents are not the only IP right viewed as critical to the company’s success, and while initially Walker’s role was mostly patent focused, as a sub-assignment to her licensing and litigation work she collaborated closely with the company’s trademark counsel: “I found the trademark work really interesting, particularly given the fact that we have a world-famous brand. As luck would have it, our leading trademark counsel then left the company and I was promoted into his role - and I have never looked back.”

From patents to trademarks

Structurally, the trademark group is part of the larger trademarks, copyrights and designs group, which Walker manages. In turn, “this is a part of the larger IP department and I report directly to our general patent counsel, who in turn reports to our general counsel.

“In total there are two attorneys, including myself, who focus on trademarks and one attorney who devotes a portion of his time to designs. In addition, we have a wonderful trademark paralegal who is an invaluable part of our team, as well as docketing support that we share with our patent attorneys”.

The group, which is based in the United States, is responsible for a global trademark portfolio boasting over 3,000 marks. The XEROX trademark is itself registered in more than 100 countries and is considered world famous.

As would be expected when overseeing a global portfolio, the tasks facing the trademark team change from day to day: “I am greeted in the morning with emails from our agents based all over the world. The great thing is, I have developed a strong relationship with each outside counsel, so it is nice to exchange pleasantries as well as tackling the legal issues at hand. Soon thereafter, I am hearing from my internal clients with issues ranging from counterfeiting in China to trademark licensing in the United States and Europe to trademark prosecution in Mexico to trademark litigation in India. My work involves matters as simple as providing rudimentary counsel on when to use the ® symbol with XEROX (ie, when referring to our products and services as opposed to our corporate name), to something as complex as providing comments on proposed IP legislation and its impact on the company.”

This variety is a consequence of the company’s business and the way its product offerings and structure have evolved. At present, Xerox Corporation is active in 160 countries, with its global reach extended through wholly owned subsidiaries of regional office technology dealers, as well as more than 6,500 authorised sales agents and concessionaires and approximately 10,000 technology resellers.

This sprawling network demands close interaction with the respective business units: “Most people know of us as a technology company – and that is our legacy, and we take great pride in that. Today, however, we are also a services company, albeit one that is still driven by our technology. We like to say ‘we are technology driven and services led’. That being the case, intellectual property continues to play a large role in all we do. Our brand is always evolving, and as trademark counsel there is never a dull moment keeping up with all the changes.”

To ensure that all jurisdictions receive the attention they require, the team effectively divides the globe into two areas of responsibility: “As an in-house team, we split the world in half. Seana Watts is responsible for one half of the world and I am responsible

60-second interview

What aspects of your job do you find the most challenging?

All of them. The volume, breadth and pace of the work are both challenging and exhilarating.

What aspects do you find the most rewarding?

Again, I find it all rewarding. I enjoy the interaction I have with agents from all over the world and I learn so much from each of them. I also like the interaction I have with my internal clients. Of all the legal disciplines here at Xerox, I believe that working on such an iconic brand as a trademark attorney is the best job that anyone can have. Everyone cares about the brand. Everyone is a brand steward. Everyone has an opinion. It is rewarding to play such a crucial role in this arena.

If you could make one change to the industry, what would it be?

To limit the power of the Internet Corporation for Assigned Names and Numbers. Also, to pass more IP protection laws. Nothing onerous – rather, laws that truly draw a distinction between first amendment protection and criminal behaviour.

What career do you think you would have followed if not law?

That is a good question. I had always imagined being a civil rights lawyer, while friends tell me I could have gone into politics. Today, I would go into the ministry.

What is your greatest inspiration or motivation?

My husband, John, and our four girls (Nala, Faith, Grace and Jasmine)

Who has been the greatest influence on your career?

At the risk of sounding corny I'd have to say my mother. It has always been important to me to succeed because she worked so hard to give me the opportunities she did not have. In every career move I make I ask myself if this is something she would be proud of.

for the other. We then share one trademark administrator extraordinaire, Janet Bailey. Through partnering with our outside agents, we somehow are able to manage our worldwide portfolio."

Preventing genericide

As mentioned earlier, one of the issues that the Xerox trademark team faces in certain jurisdictions is the potential for genericide. In countering this, Walker acknowledges that "sometimes legal avenues are not the best course of action".

Instead, the team adopts a more expansive approach, with an emphasis on public outreach. "Oftentimes we work closely with our marketing and advertising departments to tailor trademark education advertisements, to educate the public on the proper use of the XEROX trademark. We also will run cautionary notices in local periodicals alerting the public to the fact that XEROX® is a registered trademark of Xerox Corporation. Where available, we pursue famous name/well known name protection."

As well as appealing directly to the general public, in the past the company has targeted industry-specific journals, particularly those read by the creative industries. One advertisement, placed in the *Hollywood Reporter*, asked film industry readers to "use Xerox only as an adjective to identify our products and services, such as Xerox copiers, not a verb, 'to Xerox' or a noun, 'Xeroxes'". Through such targeted advertisements, the company is working to effectively head



off misuse in the media. While unseen by the wider public, these ads help to ensure that influential film and television content does not then contribute to wider misuse of the XEROX mark.

While the company utilises watch services to monitor online trademark misuse, to help mitigate the risk of genericide wider education is still viewed as key, and this message is ingrained in all of the company's stakeholders: "We educate our workforce to be trademark ambassadors and enforcers – and we have over 140,000 employees to help spread the word, not to mention our various partners."

The desire to seek alternative routes to dispute resolution is reflected in Walker's statement that "fortunately, we do not have a great deal of litigation". However, this should not be taken to indicate an absence of infringement, and the online world is proving a particular concern: "As for every major brand, the Internet presents many challenges - from innocent misuse of the XEROX trademark to wayward dealers to typosquatters to cybersquatters to outright infringers."

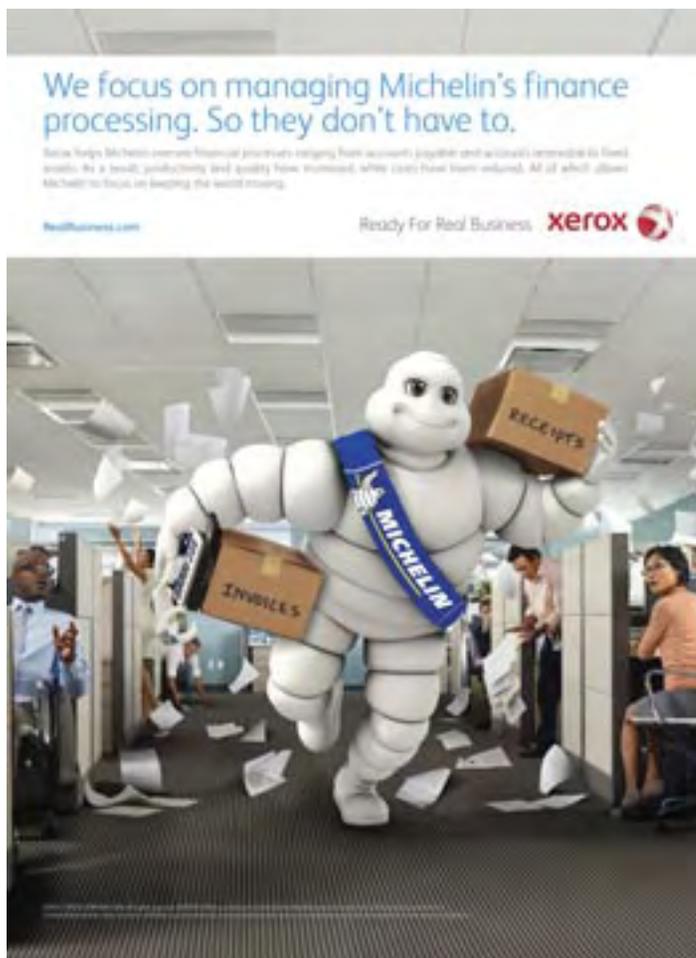
As is the case for many brand owners, the sheer scale of online infringement necessitates a pragmatic approach. Walker observes: "Because we cannot address them all, we spend time prioritising the most egregious offenders and then strategising the best approach to pursue them, which sometimes involve business solutions as opposed to legal remedies".

Focusing on the brand

In addition to dealing with infringement, the trademark team is actively involved in business transactions undertaken by the company, with a number of high-profile acquisitions demanding particular attention.

One such was the acquisition of Affiliated Computer Services (ACS), the world's largest diversified business process outsourcing firm, in a transaction valued at \$6.4 billion. The deal was completed in February 2010 and the branding initially adopted was 'ACS, A Xerox Company'.

Xerox currently runs a number of advertising campaigns centred on the services it offers other companies, creating a need to work with external advertising and trademark partners



Walker explains: "We acquired ACS to broaden our business so, in addition to our traditional or legacy Xerox trademark portfolio, we also assumed responsibility for managing ACS's global portfolio of trademarks. We therefore played an active role in the ACS acquisition. The first thing we had to do was to expand the scope of our XEROX registrations to include the traditional ACS services. We then worked on transitioning the ACS logo into a hybrid logo that included both elements of the ACS name and the Xerox name. This, of course, helped in transitioning ACS into the Xerox family."

This year the team has additionally had to prepare for the full transition of ACS into the Xerox brand, with Xerox announcing that it was effectively retiring the ACS handle on January 25 2012.

Managing the brand

The Xerox brand itself underwent a significant revamp in 2008, with current chief executive Ursula Burns explaining at the time: "Our brand is one of our most prized assets and the value it brings to our business is immeasurable. Our customers, our employees and our shareholders connect the most with what the brand stands for - quality, innovation, customer focus and a values-rich culture. Today, we're strengthening all our attributes and giving our brand a contemporary look that is more relevant for business today - a bit less formal, a lot more lively with links to our heritage and a nod to the future."

While the rebrand "seems like ages ago at this point", Walker and her colleagues were again intrinsically involved in the project: "The

trademark team engaged early on with our brand client. We understood what was important to them and what message they were seeking to deliver, and this early engagement helped us to hone in on what was most important. However, it was a challenge clearing our design mark across 100 jurisdictions."

As well as working with internal clients, the team benefits from insights into the way that other corporates approach IP protection. Xerox currently runs a number of advertising campaigns centred on the services it offers other companies, with names such as Virgin Atlantic and Michelin featured prominently in the artwork.

The team must therefore be mindful of how it is using trademarks belonging to others. In the same way that Xerox aims to offer guidance to others on fighting genericide, these advertising partnerships enable the team to learn from trademark peers.

Walker concludes: "We work closely with our advertising group as well as our external advertising agent to ensure that the companies' properties are not compromised in any way - and this has been a great opportunity to learn how hard these companies work to preserve the strength of their properties." ^{WTR}

Trevor Little, *World Trademark Review*