

At your service

WTR's exclusive survey asked trademark counsel around the world to identify those companies to which they outsource their trademark and domain management, and how they rate them. Here are the results

A decade ago, two significant developments in trademark law and practice transformed the way in which brand owners manage their rights. First, the Uniform Domain Name Dispute Resolution Policy armed trademark owners with a speedy, cost-effective weapon against cybersquatters. Second, the threats presented by the Internet exploded: suddenly brand owners had to get to grips not only with cybersquatters, but with all manner of trademark abuses, from typosquatting to keywords and the online sale of fake goods.

Brand owners and law firms have gradually outsourced more and more of their work to service providers that specialize in the non-legal aspects of online trademark protection. *WTR* readers use a broad range of firms for domain name-related services, the most prominent of which are Melbourne IT, Thomson CompuMark and Corporation Service Company (CSC) (see table to the right). The latter firm, which counts nearly half of the Fortune 500 among its clients, received the highest rating in *WTR*'s approval ranking for domain services. More than 100 years old, CSC has set the pace for service providers in the IP services field and has recently built an impressive practice around domain names. CSC will surely feel reassured to receive the highest approval rating for domain-related services; the ranking shows that it can compete on quality as well as quantity of services. With that in mind, closely following CSC were Scandinavian set-up Patrafee (founded and run by a coalition of lawyers, like the CSC of yore) and London-based boutique Com Laude, whose high-profile managing director Nick Wood is well known in trademark circles for his lobbying on behalf of rights owners in the generic top-level domain debate.

CSC not only scores highest on the domain side, but also attains an impressive 8.3 rating from those that use its trademark services. The firm publishes *Trademark Insider*, an annual index of the top trademark firms, which is a useful tool for those that take an active interest in the trademark landscape. The report is further proof of CSC's sophisticated understanding of the market. This year's edition highlights the fact that those firms that changed their fee structures subsequently experienced a increase in filing work this year. Dennis Prah, partner at Ladas & Parry, which saw a workload increase of 37%

in 2009/10, told *WTR* earlier this year: "We have helped clients control costs by offering many of them an alternative flat-fee structure." CSC's reputation as the provider of such insight can only help to cement its position near the top of the table for trademark services.

Brian Banner, who practised trademark and unfair competition at two multinationals for many years and is now in private practice, while also teaching at George Mason University School of Law, explains why it is cost effective to outsource trademark searching: "If you miss something or base a recommendation or the risk level on an in-house search that is later proven defective, you are open to a professional

Most used trademark service providers

Domain name/online services

- 1 Melbourne IT
- 2 Thomson CompuMark
- 3 Corporation Service Company (CSC)
- 4 MarkMonitor
- 5 Com Laude
- 6 Patrafee
- 7 CPA Global
- 8 Ladas Domains
- 9 Patrix
- 10 IP Twins

Trademark services providers

- 1 Thomson CompuMark
- 2 CT Corsearch
- 3 CPA Global
- 4 Onscope
- 5 Patrix
- 6 Computer Packages Inc
- 7 Corporation Service Company (CSC)
- 8 Avantiq
- 9 Edital
- 10 SMD markeur

Methodology: Respondents were asked to name the company(s) they outsourced domain name/online activities to and who they used for general trademark services. The listings above represent the top 10 most cited companies.

liability claim. External commercial search firms provide their own disclaimers in their reports, so you always base your opinion letter on the four corners of the document that were prepared by a professional search firm. There's nothing worse than having a big client relying on information that's inaccurate or out of date. In the worst case, the client will have to rebrand the new product and you may lose the client."

It is natural for private practitioners to feel cautious. But Jef Vandekerckhove, Philips's vice president for intellectual property and standards (IP&S) in Europe, advises that in-house counsel should not be too quick to make the decision to outsource. "I'm convinced it makes more sense to do it in-house," he told *WTR*. "You need someone who is acquainted with the company to select and prioritize targets. I have ample examples where an outside service provider that does not have the insight over the whole of the business made mistakes in searching." Another in-house counsel interviewed for *WTR*'s survey found that outsourcing renewals was not cost effective.

Of course, efficiencies and requirements vary from one industry sector to another, and the top companies listed in the tables here have all built their business models on adapting to the needs of different clients. The market is likely to become more competitive over the coming years. Smaller outfits will necessarily be acquired by larger players; and attorneys will find themselves asking tougher questions of their service providers. Jane Collins, IP counsel at Syngenta, inherited CPA Global on the formation of Syngenta. "It made sense to go where the majority of the records were," she told *WTR*. As the sector

grows, though, counsel will look more analytically at service providers. CPA Global is undoubtedly one of the sector's most established players. Since its foundation in 1969 to handle patent renewals, the company has expanded its operations to a number of legal services. Its trademark offering opened in 1985 and CPA was one of the earliest companies to offer domain name services for trademark owners. Earlier this year the firm completed a management buy-out in a transaction reportedly valued at £440 million. "Our growth prospects in the years ahead are the strongest we've ever seen as we continue to develop our IP services and software businesses with an expanded range of products and services, while aggressively pursuing our diversification into the wider legal services sector," proclaimed Peter Sewell, CPA's chief executive.

The deal can be seen as confirmation that mark owners will rely more and more on IP service companies. However, as in-house challenges grow along with the IP services market, mark owners will become increasingly sophisticated consumers of such offerings. For some, the decision of whether to hire a company can come down to how its proposition fits in with the client's business. "Some of the companies are founded by and for attorneys, so the in-house trademark manager's ability to repackage the offering to win funding from management is difficult," explains Justin Pierce, Sony Ericsson's head of trademarks and brand protection. Pierce uses MarkMonitor and Melbourne IT, citing the flexibility of their digital solutions packages. "In-house counsel can use the reports they produce to get marketing executives more involved in brand protection," Pierce adds. "It makes it easier to convey the importance of this function to non-legal people." [WTR](#)

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Customer approval ratings

Trademark services providers

1	Edital	8.5
2	Onscope	8.38
3	Corporation Service Company (CSC)	8.33
4	CT Corsearch	8.06
5	Computer Packages inc	7.90
6	Thomson CompuMark	7.87
7	CPA Global	7.47
8	Avantiq	6.6
9	SMD markeur	6.6
10	Patrix	6.43

Domain name/online services

1	Corporation Service Company (CSC)	8.68
2	Patrafee	8.5
3	Com Laude	8.3
4	IP Twins	8.3
5	Ladas Domains	8.1
6	Patrix	8.0
7	MarkMonitor	7.95
8	Thomson CompuMark	7.71
9	CPA global	7.2
10	Melbourne IT	6.88

Methodology: Respondents who used the companies featured in the "Most used service providers" graph were asked, on a scale of one to 10, to rate the service received in terms of quality of service and value for money. The average score is presented above as a customer approval rating.