

GIOVANNI VISINTINI

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A **Solicitor and Trade Mark Attorney with 19 years PQE**, also qualified as an **Italian Avvocato**. Adaptable, pragmatic and commercially focused, I help clients plan, manage, protect and enforce their domestic and global brands and wider IP rights.

With a broad spectrum of experience across a range of business sectors, both in private practice and in-house, including breaking new ground with protection and registration of colour trademarks, I am comfortable working independently or as part of a leadership team. I also have experience of speaking at both UK and international conferences to promote client brands and enhance their reputation.

EMPLOYMENT HISTORY

January 2006 to 30 April 2020– Counsel, Brands - BP plc

- Providing strategic advice to senior business leaders in relation to the management, protection, exploitation and enforcement of complex IP assets.
- Lead negotiations and provide advice on BP IP rights in JV, M&A, distribution, licence, procurement and other agreements across multiple jurisdictions.
- Managing trade mark budget (approx. \$360K) for my clients within Castrol and BP.
- Sole responsibility for trade mark licensing for Castrol Industrial, Marine and Energy (IME) and Own Engine Manufacturer (OEM) businesses.
- High level analysis of business environment and client plans to identify, address, and mitigate trade mark and copyright risks, and direct client's IP legal strategies and policies appropriately.
- Building, developing, maintaining and instructing a worldwide network of both internal and external lawyers and brand managers to acquire up-to-date information on product usage and support enforcement actions.
- Representing BP IP group interests in developing IP legislation, developing and fostering external network to further BP's IP interests and profile.
- Sole responsibility within BP Legal (Brands) for sponsorship agreements, including international sporting events
- Lead legal adviser on cultural sponsorship agreements (Royal Academy, British Museum, National Portrait Gallery, Royal Opera House etc.) and the exploitation of sponsorship rights in marketing campaigns.
- Providing support and training to both the wider business and within the Brands team on new developments in IP law and emerging IP policies.

Key Achievements

- Leading the project to **successfully enforce Colour Green trademarks in ground breaking cases** in various jurisdictions, in particular UK, Poland and Russia.
- **Lead IP adviser for Genome project** - strategic initiative for the Castrol IME business to reduce the number of brands from 200 to 60:
 - establishing and implementing strategies for rationalisation of client's trade mark portfolio
 - ensuring protection in place across all relevant jurisdictions for remaining brands
 - leading and setting priorities for the formalities team in relation to the project
 - managing costs of acquisitions

- liaising with global senior management
- **Chair of the Transaction Team** - responsible for setting priorities and leading the team in reviewing, maintaining and creating new model agreements and related policies across the wider BP IP Group.
- Lead adviser on **protecting the launch and marketing campaign for new product (Active Technology) in Turkey** - filing actions against local competitor and co-ordinating activities between local and international business.
- **Lead adviser** on IP matters in relation to **marketing campaigns, sponsorship activities, product launches and media-buy.**
- **Lead legal adviser to BP Video Library** in relation **to the outsourced production of BP films.**
- **Invited speaker at various national and international IP conferences**, seminars and training sessions, representing BP and promoting BP IP Group's profile and reputation.
- **Mentor for year 5 pupils at Cubitt Town Primary School** through Mosaic (part of the Princes Trust) - inspiring primary school children from disadvantaged backgrounds to raise their educational and career aspirations.

January 2005 to December 2005 – Legal Counsel, IBML

(International Brand Management Limited) part of the Sports Direct group

- Management of IP Portfolio – including Dunlop, Donnay, Slazenger, Lonsdale.
- Advising on IP issues in brand acquisition.
- Drafting commercial agreements - licences, sponsorship agreements, distribution agreements etc.
- Establishing anti-counterfeiting strategies for brand protection.
- Obtaining EU-Wide customs registrations.
- Instructing and co-ordinating external lawyers on contentious matters.

October 2001 to December 2004 - Assistant Solicitor, Field Fisher Waterhouse - Trade Mark and Brand Protection Group

- Providing clients with strategic, commercial, advice on a wide range of IP matters – contentious and non-contentious.
- Portfolio management of a variety of global disputes, including a counterfeit action.
- Trade mark cancellation and opposition actions in the UK and CTM Registries, including attendance at hearings.
- Advising in relation to domain name disputes.
- Drafting license, assignment, settlement and co-existence agreements.
- Trade mark portfolio analysis and management, due diligence, risk analysis and assessment of registrability, filing and prosecution of trade mark and design applications in the UK, CTM and international registers.
- Watching services and assessment of conflicting rights.
- Advising on Italian law across the wider FFW business.

July 2000 to October 2001 - Assistant Solicitor, Bristows - Commercial IP Department

Seconded to **Diageo** as **Trade Mark Manager**

- Global protection and management of key Diageo brands, including Gordon's Gin, Gilbey's, Tanqueray, Tanqueray No.10 and Malibu.
- Management & protection of ASPAC brand portfolio.
- Prosecution of new applications, oppositions and international contentious matters.
- Drafting contracts and marketing documentation.
- Liaising with international trade mark agents etc.

CONFERENCE SPEAKING

Recent speaking invitations include:

- **Brand Protection Online Europe, London 2019** - *Developing a state-of-the-art online brand protection strategy.*
- **IP World Summit, Amsterdam 2018** – *Expanding your finished product offering.*
- **Oil & Gas IP Summit 2018, London** - *Expanding your finished product offering.*
- **Managing the Trademark Asset Lifecycle 2017, Munich** - *brand evaluation round table.*
- **Oil & Gas IP Summit 2017, London** – *The role of trade marks and copyright for an IOC (first ever speaker on trade mark issues).*
- **ITMA Autumn Seminar, Birmingham** - *protection of non-traditional trade marks.*
- **Trade Mark Conference, London** - *protection of non-traditional trade marks.*

EDUCATION & QUALIFICATIONS

- UK Trade Mark Attorney Exams, Institute of Trade Mark Attorneys
Admission date as a Trade Mark Attorney: 14 June 2013
- Qualified Lawyer Transfer Test, College of Law, London
Admission date as a Solicitor of England & Wales: 17 July 2000
- Italian Bar Exam, Scuola Forense De André, Genova, Italy
Admission date as an Italian Avvocato: October 1998
- **Law Degree**, Università degli Studi di Parma, Italy
104/110 – equivalent to a 2:1
Thesis: Revocation of Trade Marks

PROFESSIONAL TRAINING & OTHER INFORMATION

Recent courses include:

- Intellectual Property in R & D Collaborations
- A to Z of Negotiating & Drafting IT Contracts
- Drafting Sport Sponsorship Agreements
- Drafting Commercial Contracts
- Negotiation Skills for Lawyers
- Financial Foundation Course
- Ethical & Inclusive Leadership

Languages:

- Italian – native speaker
- English – fluent spoken & written

Key Interests:

- Triathlon
- Running
- Cooking
- Volunteering
 - mentoring school children with Mosaic charity (part of the Prince Trust)
 - assisting with son's cub pack activities