

## PHILIPPE THERIAS

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### SUMMARY

**Senior IP Law Counsel** with expertise advising clients in relation to obtaining, enforcing, litigating and licensing patents, trademarks, copyright and related IP rights. Develops strong technical and/or business relationships at all corporate levels, through credibility of combined technical and law education, and personal passion for his clients' success. Recognized team leader, bringing empathy and listening skills toward successful negotiations. Creative problem solver. Balances timely decisions and developing consensus between divergent corporate interests. Maintains hands-on approach to practice when in people management positions. Competencies and experience include:

- ✓ Strategic corporate IP policy development
- ✓ External advocacy of IP interests
- ✓ Acquisition/divestiture due diligence
- ✓ Numerous contract drafting and negotiations
- ✓ Bilingual English/French with basic competence German
- ✓ Practice in 3 Jurisdictions (France, USA, Canada)

### EXPERIENCE

**Attorney at law – Paris Bar**

**Since July 2017**

**ALE International (a former business of Alcatel-Lucent divested October 1, 2014)**

**2014-2017**

**Senior Assistant General Counsel - IP (Paris, France)**

Reporting to the General Counsel, current responsibilities cover broadly patents, trademarks, copyright and open source software, confidential information, IP clauses in contracts and IP litigation, to:

- set up the new company IP processes, including internal policies and their compliance, and external network of outside counsels; and
- advise Business and Legal on all IP issues, including as a result of the divestiture agreement.

**Alcatel-Lucent**

**2012-2014**

**Senior IP Corporate Counsel (Paris, France)**

Reporting to VPs of Patent Creation and IP Law Services, managed a local department (7 IP Professionals, 9 administrative Staff) in charge of filing and prosecuting patent applications worldwide on inventions originating in France, led an international team (4 IP Professionals) in charge of handling globally a segment (mainly software-related) of the overall patent portfolio, and supported Business and Legal on IP transactions, IP clauses in contracts in Europe (sales, procurement, collaborative research, etc.), and open source compliance process globally.

**IBM**

**2004-2012**

**Senior Counsel (Markham, ON, Canada, 2008-2012)**

Reporting to Senior Counsel Software Group IP Law, set up and led global IP Law support to Business Analytics segment, focusing on patents, copyright and open source software related issues, IP clauses in procurement or customer agreements, and handling of IP in acquisition operations.

- Completed successful integration of IP operations and IP assets (125 patent families, 200 trademarks, acquired software) for the acquisition of company Cognos (\$5B), realizing savings of 50% over legacy \$2M IP Law support budget, and reviewing/cleansing 100's of imbedded open source components off the acquired software.
- Conducted IP due diligence on newer acquisitions SPSS, Clarity Systems, OpenPages, Algorithmics.
- Aligned all these acquisitions with IBM IP standards and processes going forward:
  - led education to stimulate a yearly flow of 100 invention disclosures yielding 25 patent filings;
  - analyzed 100 third party patents for freedom of action, took 1 license, supported 1 litigation;
  - subjected 50+ yearly product releases to clearance and open source review processes;
  - established worldwide IP Law support budget and controlled spending.
- Assisted Legal with IP clauses in contracts in French language with Québec customers.

- Supported Bromont, Québec packaging site, with invention protection, contracts with suppliers.
- Headed strategic projects:
  - 18-month 8-Attorney worldwide task force to identify/create patents around Cloud Computing;
  - preparation of communications by IBM over its patent portfolio relevant to “Business Analytics”;
  - sizing legal risk of contractual and copyright issues for IBM products consuming web data;
  - sizing legal risk of technical alternatives toward displacing competitor SAS from customers’.

### ***Managing Counsel (La Gaude, France, 2004-2008)***

Reporting to Corporate Chief IP, managed a department in charge of South/West Europe/Middle-East/Africa on all IP Law matters including patents, trademarks, copyright, IP issues in private and public customer agreements or in standards. Externally advocated IBM's IP positions.

- Re-organized the department (9 IP Professionals, 7 administrative Staff) and processes:
  - recruited 4 IP Professionals, mentored 2 toward passing the European Qualifying Examination;
  - improved and documented IP department internal processes (targeting ISO 9001 certification).
- Prepared and managed a budget of around 4MEuro.
- Oversaw yearly, and personally handled a part of 120+ patent filings, 400+ name clearances, 100+ trademark filings/renewals, and 100+ IP clause negotiations with local customers.
- Resolved customer indemnity claims particularly relative to MPEG 2 patent cluster.
- Advocated employer's IP positions in professional affiliations, standards and meetings with Officials, for example in relation to the projects of Community Patent, or EU Directive around the patentability of computer-implemented inventions.

### **Airbus**

**2003-2004**

#### ***Chief IP (Toulouse, France)***

Reporting to Head of Legal and Head of Development, assumed a newly created position to define patent strategies for the group, led existing IP operations, and supported strategic patent license negotiations.

- Co-led patent cross-license negotiations with main competitor, resulting in a positive outcome for Airbus despite negative imbalance in respective patent portfolios.
- Initiated patent policies to correct imbalance going forward, with spectacular growth in patent filings (ie: from 110 to 300 annually), and systematic opposition to competitor's patents at EPO.
- Managed 20 IP Professionals and Administrative Staff scattered over France, Germany, UK, Spain.

### **IBM**

**1989-2003**

#### ***Counsel (La Gaude, France, 2002-2003)***

Reporting to Corporate Counsel Global Services IP Law, provided general IP Law advice and counsel to the Global Services operations in Europe/Middle-East/Africa. Focus was on inventions and patents for services, copyright and open source software related issues, IP provisions in customer agreements, and due diligence activities for acquisitions/divestitures.

- Led acquisition IP due diligence of the European operations of PricewaterhouseCoopers Consulting, then proceeded with integration into IBM IP processes.
- Co-developed and deployed material to entice Consulting Business to submit invention disclosures.
- Co-developed patent application templates and claims for services inventions, so as to circumvent difficulties of patenting business methods.
- Negotiated numerous IP clauses with European customers.
- Cleared presence of open source in all non-product software delivered to customers.

#### ***Staff Counsel (Somers, NY, USA, on temporary assignment, 2000-2002)***

Reporting to Corporate Counsel Global Services IP Law, provided general IP Law advice and counsel for the USA to the Learning Services segment. Focus was on patents, copyright and open source software related issues, and IP clauses in contracts.

- Analyzed several third party patents for freedom of action, particularly owned by Ronald Katz.
- Cleared presence of 3rd party content in educational material delivered to customers.
- Drafted and negotiated numerous agreements with suppliers or customers, including Universities, for the purpose of licensing in/out training material.
- Developed contract template for licensing out Global Services Method (documentation, know-how).

### ***Managing Attorney (La Gaude, France, 1997-2000)***

Reporting to Corporate Trademark Counsel, managed a department in charge of South/West Europe/Middle-East/Africa on trademarks, and their filing, prosecution, litigation and licensing. Externally advocated IBM's IP positions.

- Re-organized the department (2 Lawyers, 2 Administrative Staff) and processes:
  - recruited 1 General Lawyer for the 1st time, mentored 1 Staff toward passing Master in Law;
  - improved the name clearance process to a format that has remained the same to date;
  - expanded trademark support Europe-wide by collaboratively involving 3 other IP Professionals in UK, Germany and Switzerland.
- Oversaw yearly 600-1200 name clearances, 100+ trademark filings/renewals, personally handling a part of it.
- Ensured seamless adoption by IBM of the new Community Trademark system.
- Defended trademark litigation initiated by several third parties in France, UK, Germany, Austria, Italy and Sweden as a result of IBM establishing a new brand on the market (a red e in a @ shape):
  - devised, centralized and coordinated defense arguments between cases and outside counsels;
  - settled all cases through licenses or assignments for total \$2.5M, an excellent deal relative to the marketing campaign budgets.
- Assisted in the negotiation of licenses of the IBM logo to manufacturers of printer paper.
- Advocated employer's IP positions in professional affiliations particularly re London Agreement on translation of European patents and the reform of the IP Profession in France.

#### ***Senior Attorney (Paris, France, on temporary assignment, 1996-1997)***

Reporting to Head of Licensing Europe, provided legal and technical support to European negotiators on patent license agreements. Personally assisted in many negotiations.

- Drafted numerous license agreements and handled all patent discussions.
- Prepared enforcement letters to recover license fees.

#### ***Staff Attorney (Thornwood, NY, USA, on temporary assignment, 1995-1996)***

Reporting to Corporate Assistant Counsel IP Law. Focus was on getting exposure to global IP Law management and practices, as well as education in trademarks and licensing of IP rights.

- Involved on an ad-hoc basis in Corporate licensing and trademark situations.
- Assisted in bringing to resolution an allegation of trade secret violation against IBM.
- Developed and deployed in-house education re new Community Trademark system.

#### ***Attorney (La Gaude, France, 1989-1995)***

Reporting to Managing Counsel of IP department for South/West of Europe/Middle-East/Africa, supported a networking product development group, focusing on patent application drafting and prosecution (drafted over 50 European patent applications, handled 100 EPO office actions, defended oppositions at EPO).

### **E D U C A T I O N   A N D   C R E D E N T I A L S**

Diploma, Patent Litigation in Europe EPI/CEIPI, Strasbourg (Diplôme Univ. Contentieux des Brevets en Europe)

Master in General Law from University of Nice (Maitrise droit privé, mention "Carrières Judiciaires")

Diploma, IP Law CEIPI, Strasbourg (Diplôme du CEIPI, brevets et marques)

Engineering Degree ESIEE Paris (Diplôme d'Ingénieur, spécialités micro-électronique)

- ➔ Attorney at law Paris Bar
- ➔ European Patent Attorney before the European Patent Office (EPO)
- ➔ Authorized representative before the European Union Intellectual Property Office (EUIPO)
- ➔ Authorized representative before the Institut National de la Propriété Industrielle (INPI) (brevets, marques, dessins et modèles: liste des personnes qualifiées L.422-1)

### **P R O F E S S I O N A L   A F F I L I A T I O N S**

Currently: APEB, LES, AIPPI, I3PM

Formerly: Member of EPI Council | Member of AFJE | Vice-President and President of ASPI | Member of the Board of FEMIFI | French industry associations AFEP-groupe PI and MEDEF-Comité de Propriété Industrielle