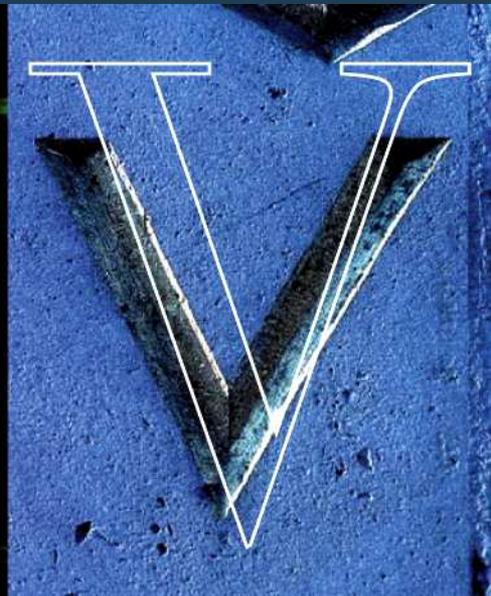
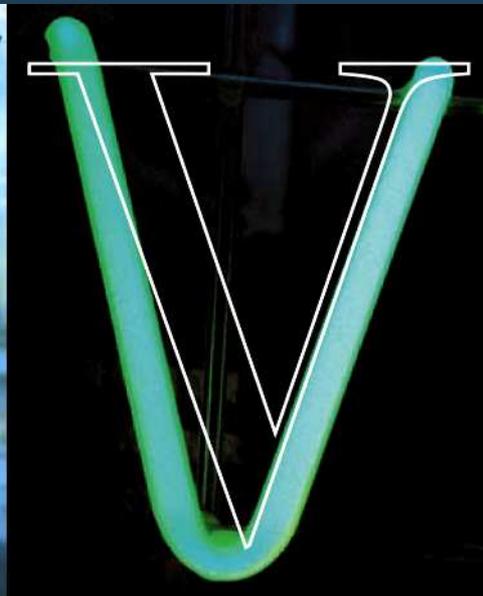
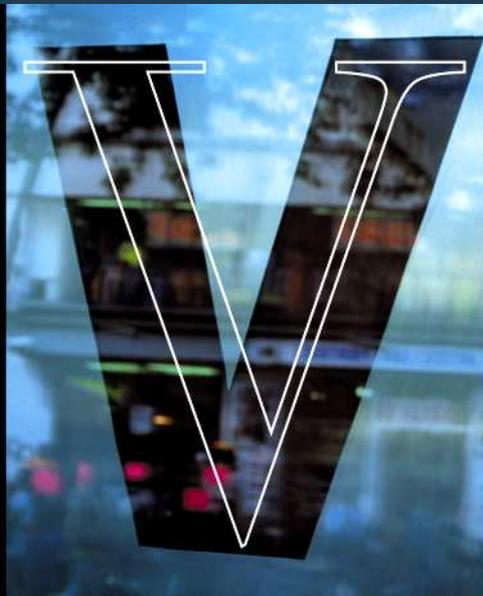
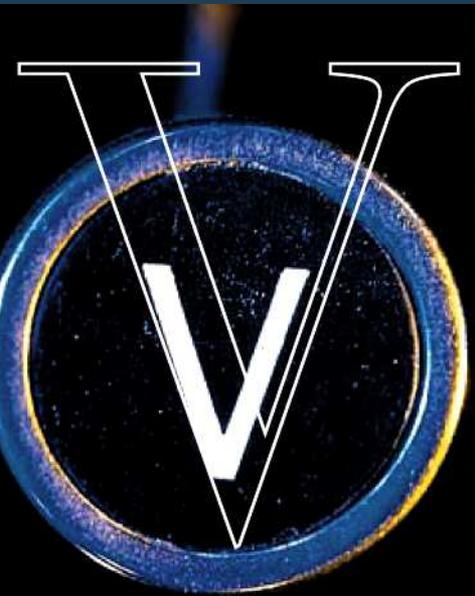


The Venable Brand IP Seminar (Los Angeles)

B. James Gladstone
Linda Menzel
John R. Sommer

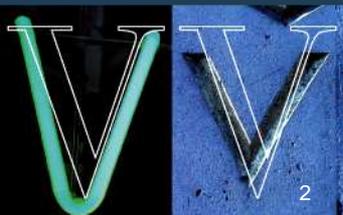
Tamany Vinson Bentz
Marcella Ballard
Justin Pierce

September 24, 2014



Agenda

- Opening Remarks and CLE Instruction (Justin Pierce)
- Brand & Content Protection in the Movie Industry (Jim Gladstone, Tamany Vinson Bentz)
- Global Brand Licensing (Linda Menzel, Marcella Ballard)
- Idiosyncratic View of Brand Management (John Sommer, Justin Pierce)
- Questions
- Closing Remarks and CLE Reminder (Justin Pierce)



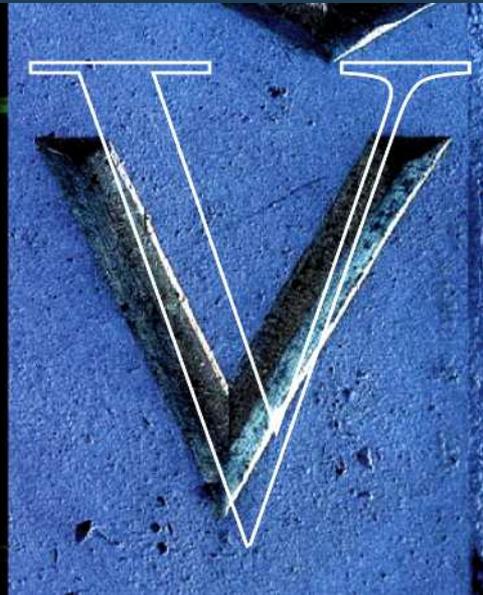
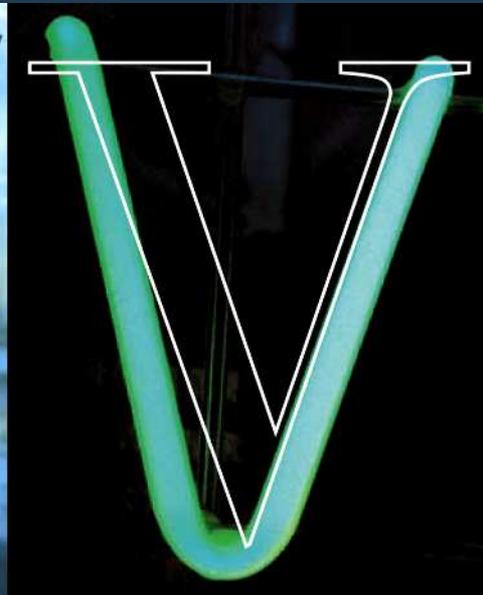
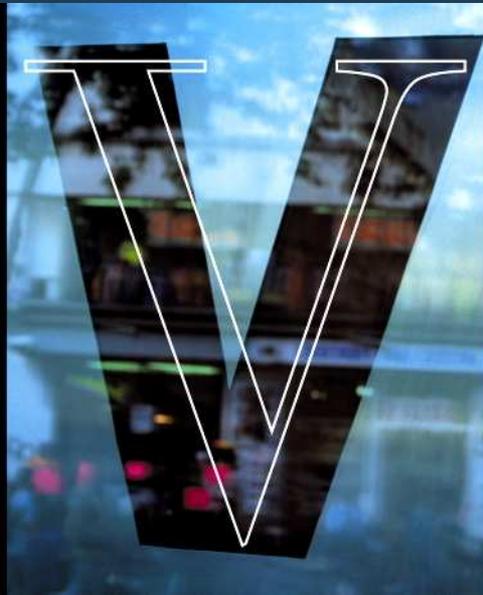
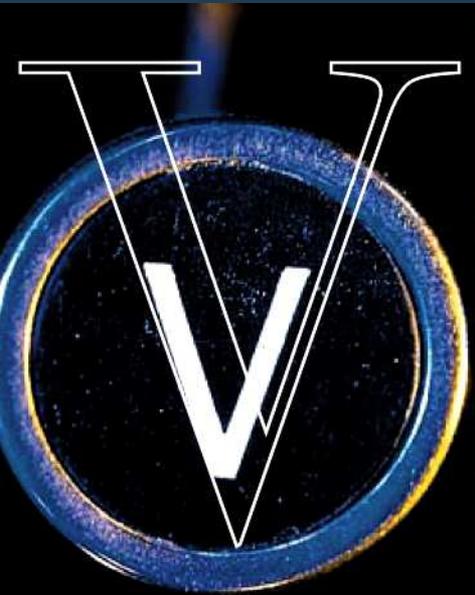
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Protectable Brands in the Motion Picture Industry

B. James Gladstone, Lionsgate Entertainment

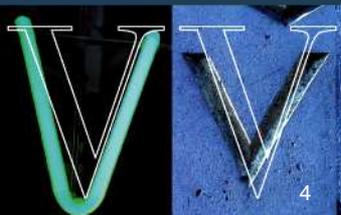
Tamany Vinson Bentz, Venable LLP

September 24, 2014



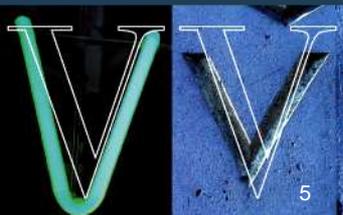
Topics for Discussion

- Trademark Basics
- Movie Titles Subject to Trademark Protection
- Movie Titles Not Subject to Trademark Protection
- Brands Throughout History
- Lionsgate Entertainment & Summit Entertainment Brands
- Creative Designs
- Policing Unauthorized and Counterfeit Goods



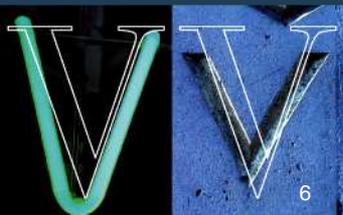
Trademark Basics

- What is a trademark?
 - A trademark is generally a word, phrase, symbol, or design, or a combination thereof, that identifies and distinguishes the source of goods of one party from those of others.
- What does trademark protect?
 - A trademark typically protects brand names and logos used on goods and services.
- When do you have a protectable trademark?
 - Common law trademark rights arise in the U.S. from the actual use of the mark. Federal registration is not required.



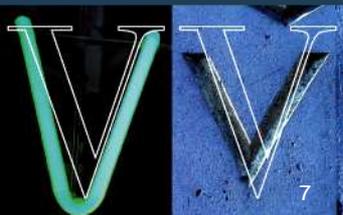
Types of Trademarks

- Trademarks fall into one of four categories:
 - **Fanciful or Arbitrary**
 - Ex: “BELMICO” for insurance services
 - **Suggestive**
 - Ex: “GLANCE-A-DAY” for calendars
 - **Descriptive**: words or designs that describe the goods and/or services.
 - Ex: “WORLD’S BEST BAGELS” for bagels
 - Descriptive marks must acquire secondary meaning / distinctiveness, meaning the mark must come to identify not only the goods but the source of those goods.
 - **Generic** (not protectable)
 - Ex: “BICYCLE” for bicycle



First Use in Commerce

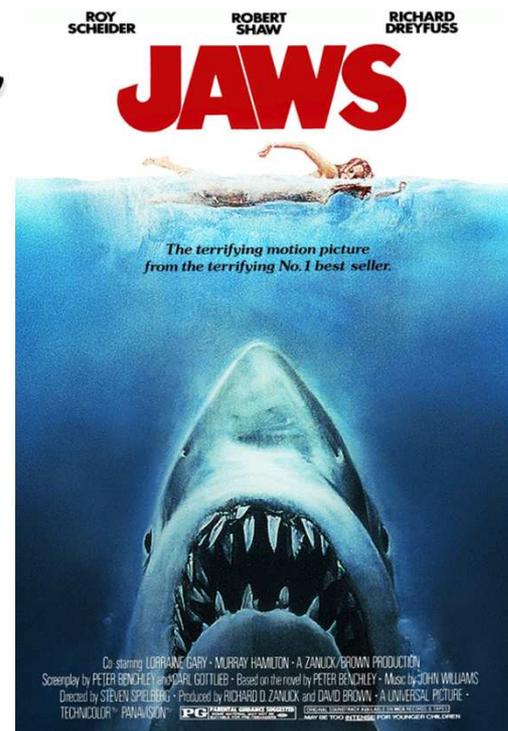
- Rights to a trademark can be acquired in one of two ways: (1) by being the first to use the mark in commerce; or (2) by being the first to register the mark with the U.S. Patent and Trademark Office.
- **First use in commerce:** for a federal registration, you must be using the mark in the sale or transport of goods or the rendering of services in “interstate” commerce between more than one state or U.S. territory, or in commerce between the U.S. and another country.



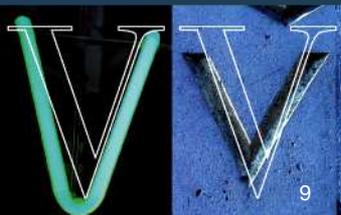
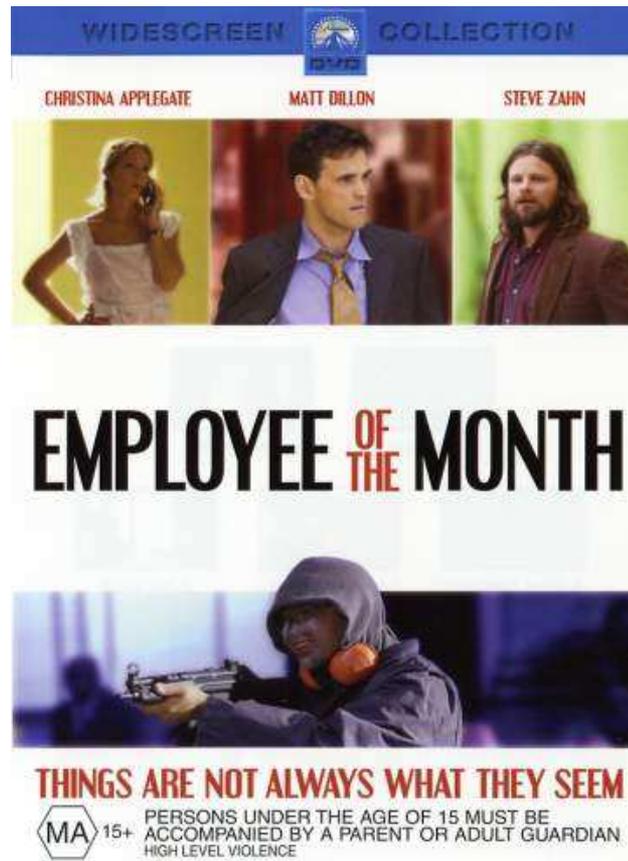
Movie Titles Subject to Trademark Protection



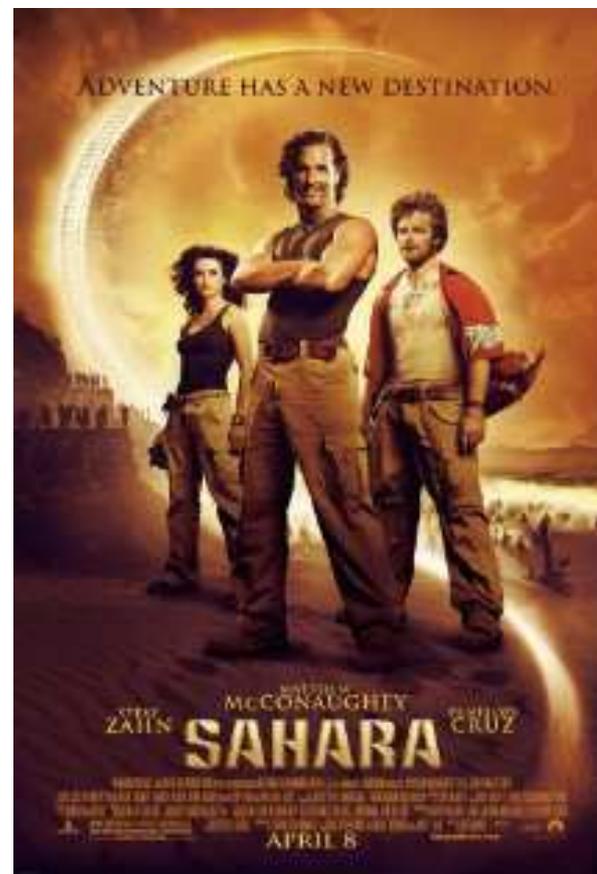
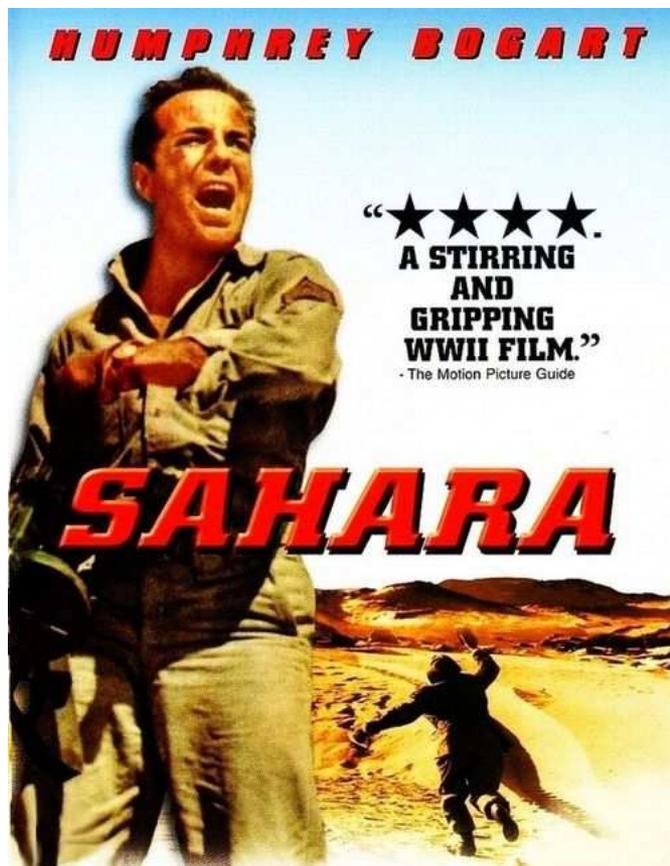
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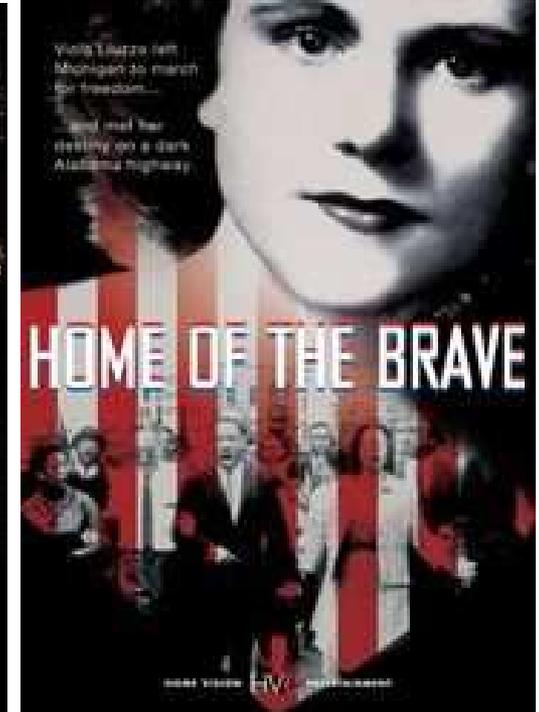
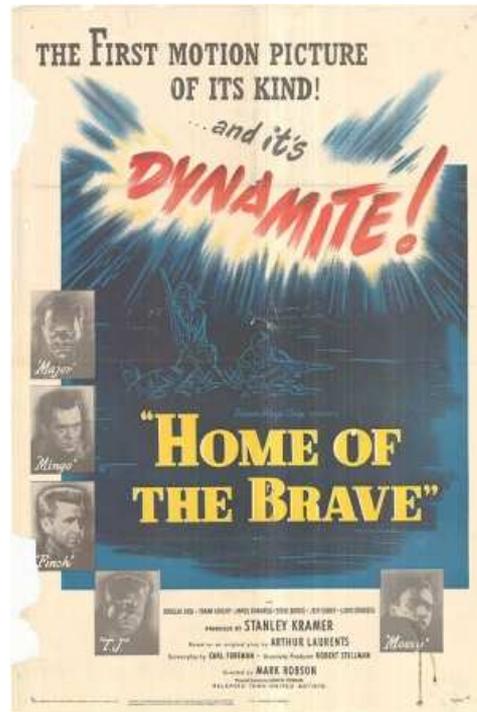
Movie Titles Not Subject to Trademark Protection



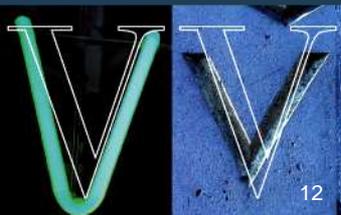
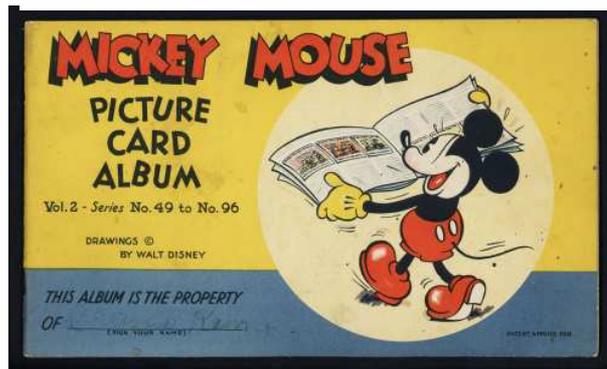
Movie Titles Not Subject to Trademark Protection



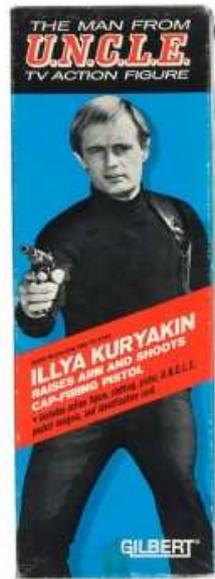
Movie Titles Not Subject to Trademark Protection



Brands Throughout History

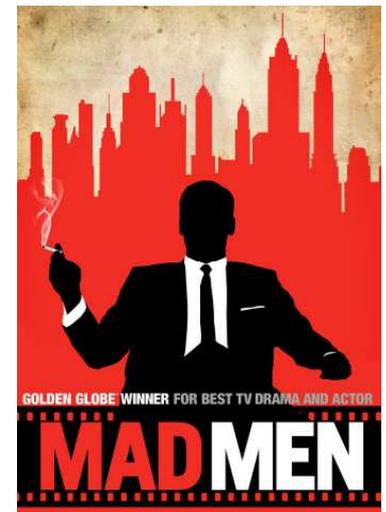
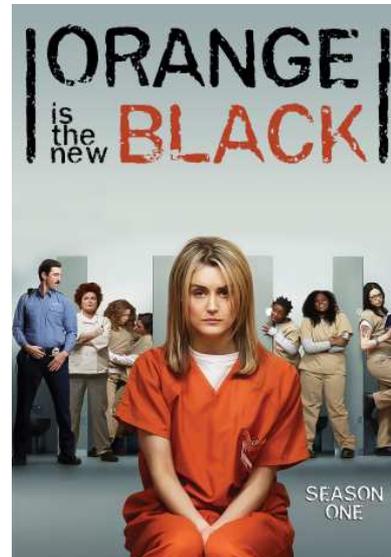
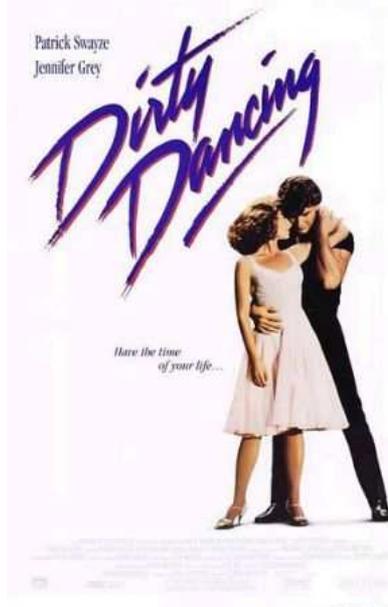
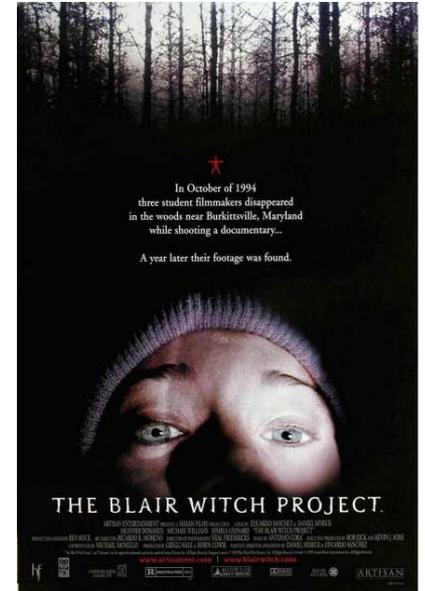


Brands Throughout History



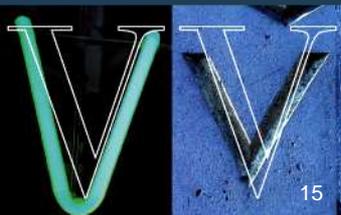
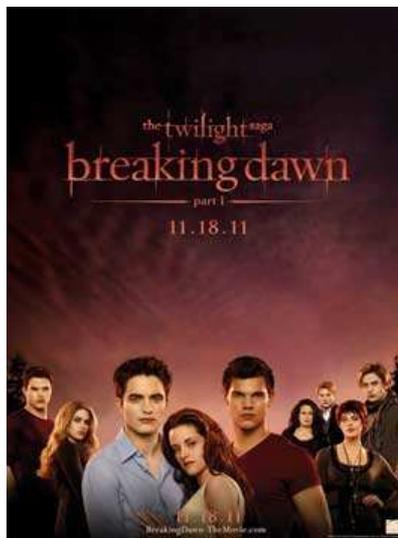
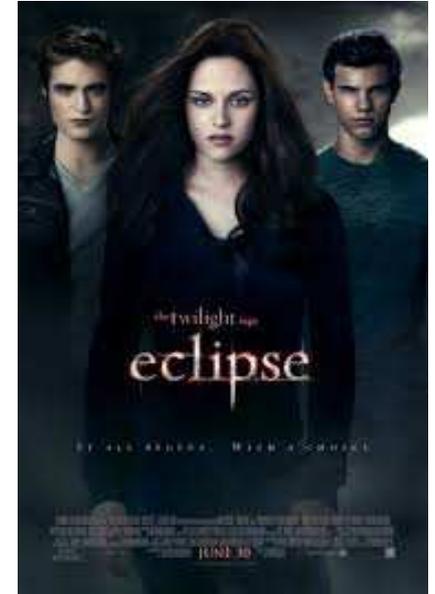
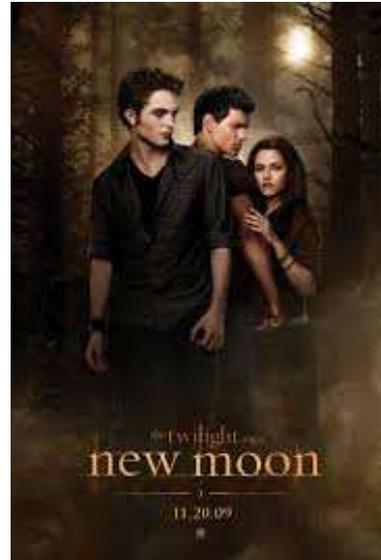
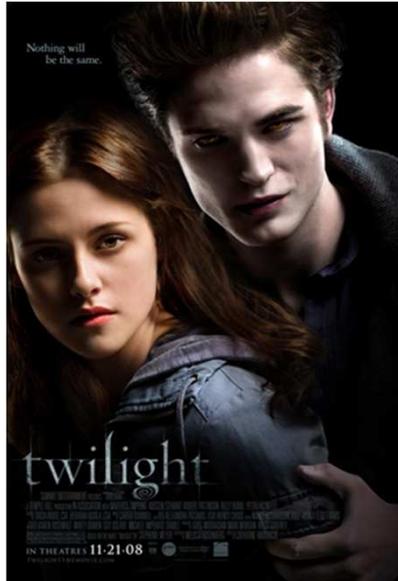
Lionsgate Entertainment & Summit Entertainment Brands

(Sometimes in association with authors' rights)



Lionsgate Entertainment & Summit Entertainment Brands

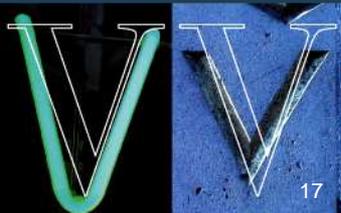
(Sometimes in association with authors' rights)



Creative Designs



Creative Designs



Policing Unauthorized and Counterfeit Goods



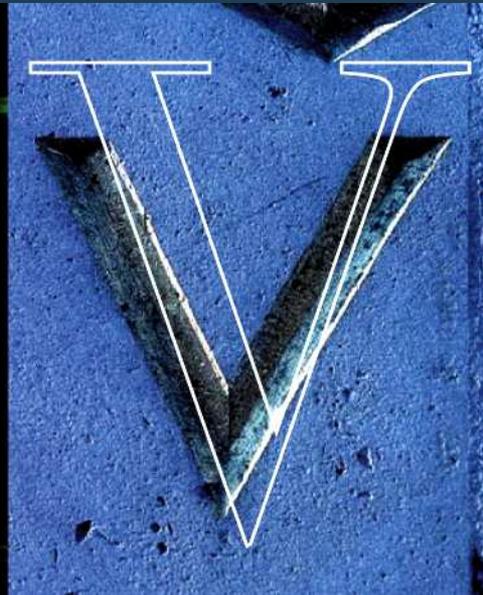
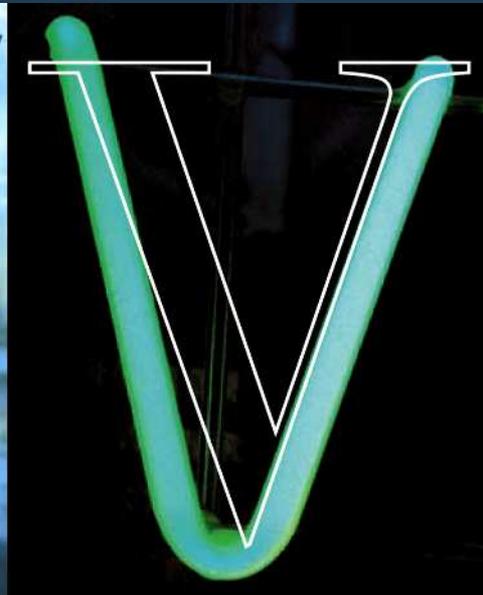
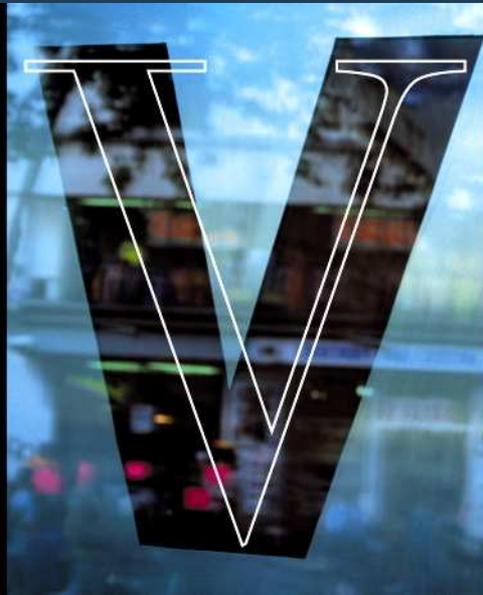
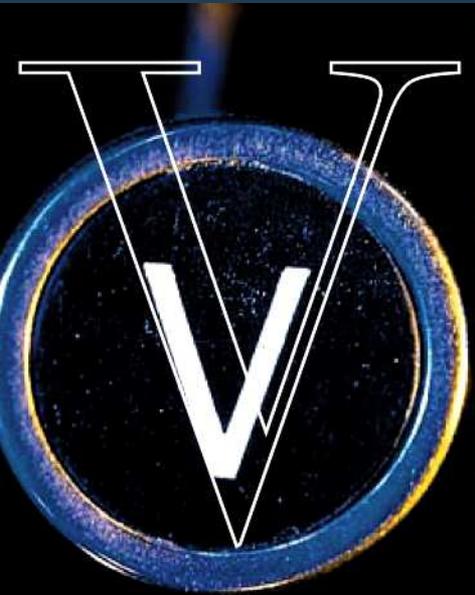
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Brand Protection Issues in a Global Licensing Program

Linda Menzel, Playboy Enterprises International, Inc.

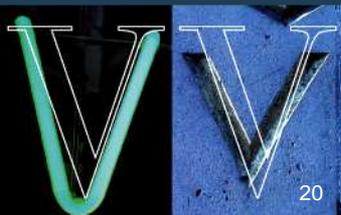
Marcella Ballard, Venable LLP

September 24, 2014



Topics for Discussion

- Playboy Brief History
- Playboy World Famous Trademarks
- Playboy Global Licensing
- Licensing Requirements/Issues



Playboy History

❑ Playboy is one of the most recognized, celebrated, and popular consumer brands in the world. Its enduring appeal derives from its fabulous history and unique status in global pop culture.

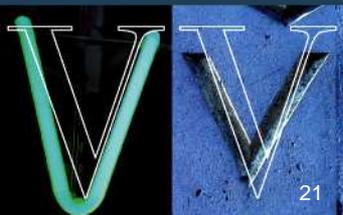


❑ Playboy was founded by Hugh M. Hefner in 1953. The first issue features Marilyn Monroe on the cover and sold more than 50,000 copies.

❑ In 1972, Playboy launched its first foreign edition in Germany. Today, there are 29 editions of Playboy published in more than 50 countries.

❑ In 1972, Playboy formalized its international product licensing business, signing an agreement to distribute Playboy products throughout Japan.

❑ In 1999, Playboy Fashion made its global debut spreading its fun-loving style across the world.



❑ In 2002, Playboy Fashion debuts in Asia with its first free-standing boutique. The boutique's success prompts Playboy to continue opening stores throughout the world.

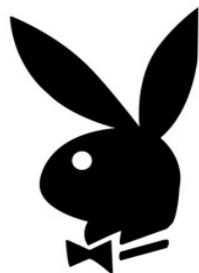


❑ In 2014, Playboy celebrates its 60th Anniversary.



Playboy's World Famous Trademarks

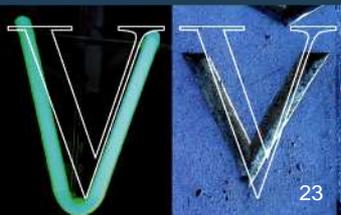
PLAYBOY



❑ **Trademark:** A trademark is a word, name, symbol, device, or other designation, or a combination of such designations, that is distinctive of a person's goods or services and that is used in a manner that identifies those goods or services and distinguishes them from the goods or services of others.

PLAYMATE

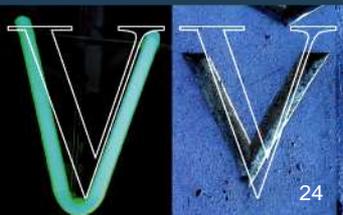
❑ The Rabbit Head Logo, one of the top 20 brands in the world and continues to fuel the future of Playboy and our global expansion.



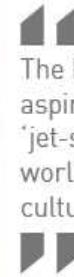
Playboy Global Licensing

Trademark License: A license is an agreement between a trademark owner [the “licensor”] and another person/entity [the “licensee”] in which the licensor authorizes the licensee to use its trademark in commerce. Unlike an assignment, a license does not transfer ownership of the designation. The use of the designation by the licensee thus accrues to the benefit of the trademark owner.

- ❑ Playboy is one of the most recognized, celebrated and popular consumer brands in the world.
- ❑ Through licensing agreements, Playboy has successfully monetized its iconic brand equity.
- ❑ Playboy's licensed products business, including location-based entertainment venues and Playboy-branded retail stores, generates more than \$1 billion in global retail sales in more than 150 countries.



❑ Playboy's trademarks appear on a wide range of consumer products including apparel, accessories, footwear, lingerie, jewelry, fragrances and home fashions.



The Playboy brand conjures the aspirational lifestyle of the proverbial 'jet-set' - the elite who travel the world and live an exciting and culturally rich lifestyle.



❑ Capitalizing on the company's powerful brand name and its iconic Rabbit Head logo - one of the most recognized symbols in the world - Playboy is a truly global brand, relevant to male and female consumers alike, and respected internationally.

Playboy Licensed Products Worldwide

☐ Clothing & Accessories



Playboy Licensed Products Worldwide

☐ Clothing & Accessories



Playboy Licensed Products Worldwide

☐ Clothing & Accessories



Playboy Licensed Products Worldwide

☐ Clothing & Accessories



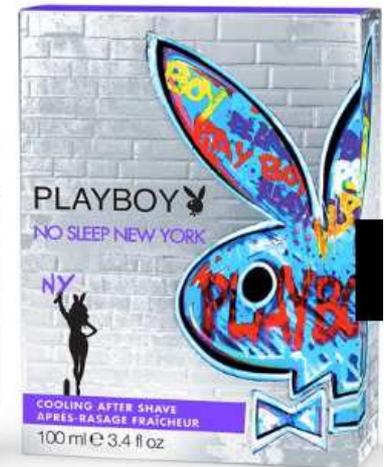
Playboy Licensed Products Worldwide

❑ Fragrances



Playboy Licensed Products Worldwide

❑ Fragrances, Lotions & Deodorants



Playboy Licensed Products Worldwide

☐ E-cigarettes



Playboy Licensed Products Worldwide

☐ Lighters



Playboy Licensed Products Worldwide

□ Condoms



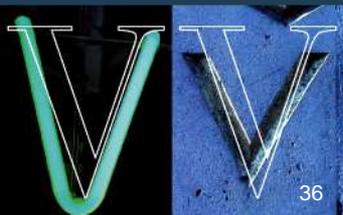
Playboy Licensed Products Worldwide

☐ Barware



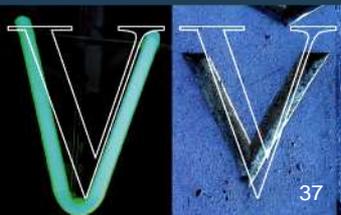
What Provisions are Essential to a Trademark License

- The trademark(s);
- The licensor and the licensee;
- The trademark rights to be licensed (including the territory in which the marks are being licensed);
- The nature and quality of the goods and services that the licensee may offer under the license;
- License Term - A trademark license usually sets a fixed term for the license and the conditions under which the license may be (a) renewed for an additional period of time or (b) terminated for breach of the license conditions.



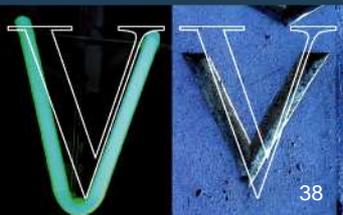
Practical Suggestions

- ❑ Clearly define the license terms for a clear understanding and to avoid disputes in the future.
- ❑ Consider completing a term sheet for key business terms before drafting a license.
- ❑ Failure to properly define (products, territory, distribution channels) could lead to problems and a breach.
- ❑ Clarify at the time of the agreement which party will be primarily responsible for policing and enforcing trademark rights as they impact on the licensed products and on filing for trademark applications in the appropriate jurisdictions.



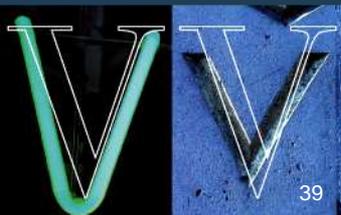
What Other Issues are Commonly Addressed in a Trademark License

- ❑ Royalty - When a licensor grants a trademark license in return for royalty payments from its licensee, a royalty amount is usually stated explicitly in the license.
- ❑ Exclusivity - A trademark may be licensed exclusively to a single licensee or licensed non-exclusively to more than one licensee. In a non-exclusive licensing arrangement, the licensor retains rights to use the trademark itself, to license it to others, or both. A license may also be "sole," meaning that only the licensee may use the trademark.



Should a Trademark License be Recorded with the Trademark Office

- ❑ In some countries, for example, the United States, there is no legal requirement that trademark licenses be recorded with the national trademark office. Such recording will simply provide notice to the public of the existence of the license agreement. In other countries, however, a license must be recorded to be effective against third parties.

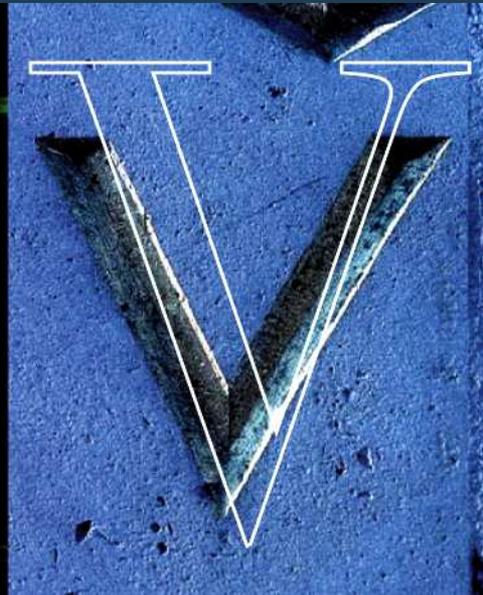
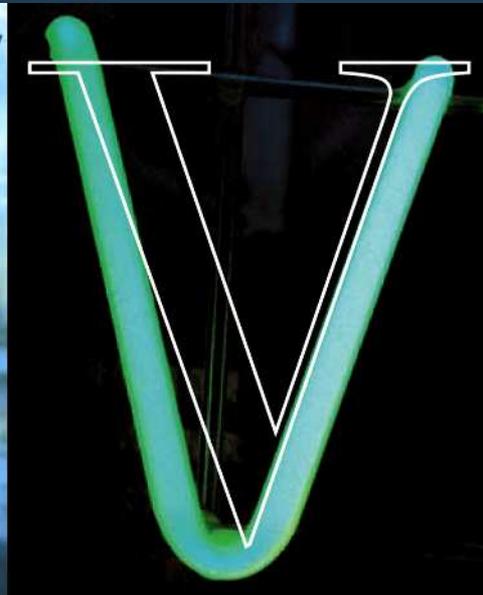
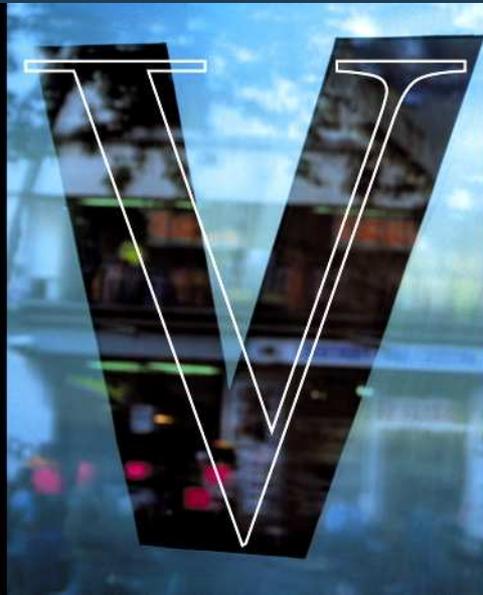
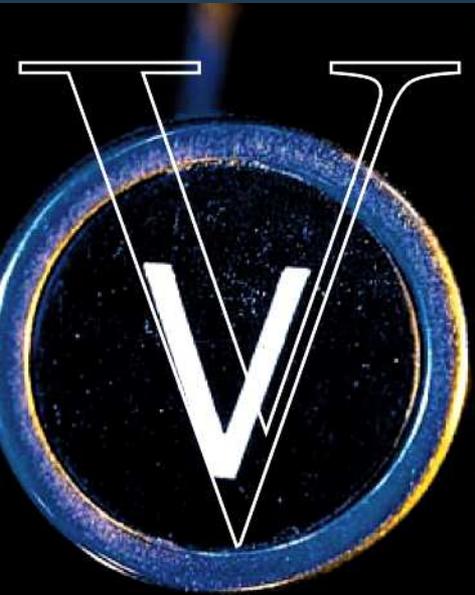


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An Idiosyncratic View of Brand Management (Not Quite Legal, Not Quite Business)

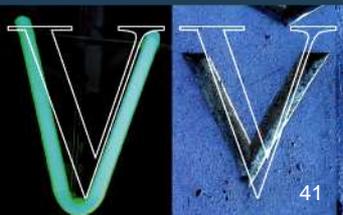
John R. Sommer, Stussy, Inc.
September 24, 2014



Why a Brand?



- Why try?
- What makes a brand worth something?
- The [Stussy](#) story



What is the life of a brand?

- Trendiness (limited time)
- Popularity (long term)
- Recognition

What are the priorities when “Protecting a Brand”?

- Brand image
- Profit margin
- Sales



Specific Issues:

- Collaborations/Co-Branded
- Stores
- Joint Ventures
- e-Commerce

Trademark Registrations

- Approach: Conservative or Broad

Trademark Registrations

- Madrid Issues
 - Strategic
 - Multiple registrations
 - Identification of goods and services
 - Substitution
 - Accession date

Other Intellectual Property Issues

- Copyright
- Clearance
- Customs recordals

Other Brand Issues

- Counterfeiting and Knockoffs
- Internet

Examples



Lama



stupid



Tussy
Porn Star
magnet



Tussy

Examples



Examples

Examples

The image shows the word "SCRATCH" written in a highly stylized, cursive script. The letters are thick and black, with a grainy, stippled texture. The 'S' is a large, sweeping curve. The 'C' is a smaller curve. The 'R' has a tall, thin vertical stem. The 'A' is a simple, rounded shape. The 'T' has a horizontal crossbar and a vertical stem. The 'C' is a simple, rounded shape. The 'H' has two vertical stems and a horizontal crossbar. The overall style is reminiscent of a hand-drawn or chalk-drawn word.

Other Brand Issues

- Labelling
- CSPIA
- Testing/Certification

contact information

YOUR VENABLE TEAM

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