Susan G. L. Glovsky, a Principal with the intellectual property law firm of Hamilton, Brook, Smith & Reynolds, P.C., practices in the areas of intellectual property litigation, licensing, trademark, and patent law. She assists clients in the life science, electrical, mechanical, and consumer product industries.

Clients benefit from Ms. Glovsky's expertise in intellectual property litigation. Much of her career has been devoted to litigating complex trademark, trade dress and patent conflicts, patent interferences, and trademark opposition and cancellation proceedings. She has tried cases to juries, judges, and arbitrators and is a member of the American Arbitration Association's National Roster of Neutrals.

Ms. Glovsky has published works in the area of trademark strategy, interferences, and alternative dispute resolution. She has spoken on the acquisition and enforcement of intellectual property rights both regionally and nationally and taught the principles of trademark law as an Adjunct Professor of Law at Suffolk University Law School.

Recognized by the Boston intellectual property law community, Ms. Glovsky was elected to serve as President of the Boston Patent Law Association. She is the founder of the organization's Litigation Committee and is a founding member and current Co-Chair of the group's Committee on Contested Matters.

Ms. Glovsky is admitted to practice in Massachusetts and New York, before the U.S. District Court for the District of Massachusetts, the U.S. Court of Appeals for the Federal Circuit and the United States Supreme Court. She is also registered to practice before the United States Patent and Trademark Office.

TRADEMARK LICENSING

Susan G. L. Glovsky

***Principal*,**

Hamilton Brook Smith & Reynolds, P.C.

July 19, 2006

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What Is A "Trademark"?

A way to distinguish goods and services

Trademarks

Service Marks

Certification Marks

Collective Marks

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Trademark v. Trade Name

Trademarks Distinguish Goods and Services

Trade Names Distinguish Businesses

- Fuji Heavy Industries, Ltd manufactures SUBARU® cars

- Coca-Cola, Co. manufactures COCA-COLA®

Acquisition Of Trademark Rights

First to Use has Ownership and Priority

- For federal registration of distinctive marks there must be commercial use

- Exception: Intent to Use applications

Licenses v. Assignments

Licenses are agreements to use a licensor's trademark

Assignments are absolute grants of all rights to the trademark

Development Of Licensing

Historical View of Trademark Licensing

-Source Theory

Modern Rule of Trademark Licensing

-Quality Theory

First Sale Doctrine

Ingredient – Coty Doctrine

- Case Study: *Enesco Corp. v. Price/Costco Inc.*

Repaired or Used

- Case Study: *Nitro Leisure Products LLC v. Acushnet Co.*

Grey Market Goods

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Formalities And Interpretation

Licenses are Contracts

Licenses can be Oral

Implied Obligations

- Case Study: *Twentieth Century Fox Film Corp. v. Marvel Enterprises, Inc.*

Use Only By Licensees

Ownership Rights can be Acquired and Maintained through use by a Controlled Licensee

- Licensee's use inures to the benefit of the licensor

- Licensee as a Related Company

Merger Rule

Quality Control

Trademarks Convey that the Owner is Controlling the Nature and Quality of the Goods and Services Sold under the Mark

-This imparts a duty on the licensor

- Case Study: *Enesco Corp. v. Price/Costco Inc. con't*

Naked Licensing

Licensing of a Mark Without Adequate Quality Control by the Licensor

- Case Study: *Barcamerica Intl USA Trust v. Tyfield Importers, Inc.*

How Much Quality Control?

Quality must be Equal to what the Consumer Expects

Level of Quality Control Necessary Varies with the Nature of the Product or Service

- Soft Drink v. Pharmaceutical

How Much Quality Control? Cont'd

Actual Control not Contractual Control

Negative Options

Third Party Inspectors

Explicit Disclaimers

- Case Study: *Alpha Tau Omega Fraternity, Inc. v. Pure Country, Inc.*

Too Much Control: Antitrust Laws

Designation of the Source of Supplies

- Tie-Ins
- Shopping Around
- Distributors
- Case Study: *California Glazed Products, Inc. v. Burns and Russell Co. of Baltimore City*

Typical License Provisions

License Grant

Term of Agreement

Quality Control

Fees and Payments

Typical License Provisions

Exemptions From Payments

Reports

Right to Audit

Delinquent Payments

Typical License Provisions

Termination

Sublicensing and Transferring of Rights

Indemnification

Protection of the Licensed Mark

Trademark Litigation

Complaint

Motion for Preliminary Judgment

Memorandum in support for Motion for Preliminary Judgment

Summons

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Trademark Litigation

Notice of Appearance for Defendant

Notice of Motion Hearing

Joint Motion for Briefing Schedule

Allowed Joint Motion for Briefing Schedule

Trademark Litigation

Defendant's Opposition to Plaintiff's Motion for Preliminary Injunction

Defendant's Cross Motion for Preliminary Injunction

Defendant's Memorandum in Support for Cross-Motion for Preliminary Injunction

Answer to Complaint and Verified Counterclaims

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