

Corporate Counsel's Guide To

# IP IN ADVERTISING & MARKETING

Understanding Fair Use, Enforcing Your Rights,  
and Leveraging Opportunities

February 27-28, 2006  
Marriott East Side, New York

**KEYNOTE ADDRESS ON:**

RECENT KEYWORD  
ADVERTISING CASES

*Michael Kwun*  
Litigation Counsel  
Google Inc.

Leading in-house counsel from a variety of industries, and the expert attorneys who represent them, will tell you how to:

- **UTILIZE** copyrighted material in your advertising efforts without fear
- **TACKLE** complicated new case law involving fair use
- **EVALUATE** the threats to adware and spyware
- **NEGOTIATE** successful joint marketing transactions
- **ACCOUNT** for the Internet in your contracts' definitions of "territory"
- **IMPLEMENT** new safeguards in light of recent case law
- **DETERMINE** how insurance coverage can affect litigation strategy
- **MAXIMIZE** your benefits from targeted marketing while minimizing risk
- **AVOID** "right of publicity" problems when using celebrities

Hear from leading  
counsel on both sides  
of the 1-800 Contacts  
pop-up advertising case

OK

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## Are recent developments in “fair use” threatening your marketing, licensing, and enforcement activities?

With a plethora of new case law defining and redefining fair use of copyrights and trademarks, your company must carefully evaluate its use of others' intellectual property and adopt new measures to protect its own IP. To minimize the risk of infringement suits, effectively and properly use other people's intellectual property, and protect your own vital assets, you need to be equipped with all the latest information on the most recent and relevant case law, regulatory developments, and popular marketing and advertising trends.

Counsel and marketing executives must identify practices that put the company at risk, and spot behavior that can leave your property wide open to certain types of legally permissible “infringements.” Armed with the proper information to conduct an analysis of your advertising and marketing policies, you can ensure proper use of trademarks and copyrights, while allowing your marketing department to flourish and move into new realms.

*American Conference Institute's* national conference on *Corporate Counsel's Guide To IP in Advertising & Marketing* will provide you with the need-to-know legal and business developments that affect the way advertising and marketing departments operate. You will hear about the latest case law, legal strategies, negotiation tactics, and marketing trends from leading in-house counsel and expert attorneys who face intellectual property issues for their companies and clients on a daily basis. They will provide you with first hand, practical, and comprehensive information on:

- Effectively using the intellectual property of others without infringing it
- Integrating recent fair use case law into your marketing and advertising decisions
- Determining the significance of international case law in your advertising and marketing decisions
- Assessing your keyword and pop-up advertising efforts
- Using celebrities in your advertising and marketing

Take this opportunity to get the information you need from experts in intellectual property, advertising and marketing as you network with your colleagues. Delegates will also benefit from the extensive written materials prepared by the speakers especially for this conference. Register now by calling **888-224-2480**, faxing your registration form to **877-927-1563** or registering online at [www.americanconference.com/IPAD](http://www.americanconference.com/IPAD)

### Who Should Attend

- In-house counsel in any company involved in advertising or marketing its products or services
- In-house counsel at advertising agencies and marketing firms
- Marketing and advertising directors
- Attorneys who specialize in the following practice areas:
  - Advertising
  - Marketing
  - E-commerce/Internet
  - Copyrights
  - Trademarks
  - Intellectual Property
  - Licensing

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Monday, February 27, 2006

7:30 Registration and Continental Breakfast 

## 8:15 Co-Chairs' Opening Remarks

*Mary Innis*

Partner, Loeb & Loeb LLP (Chicago, IL)

*Joshua Paul*

Partner, Sedgwick, Detert, Moran & Arnold, LLP  
(New York, NY)

## 8:30 What is left of the fair use defense under trademark law?

*Sally Abel*

Partner, Fenwick & West LLP  
(Mountain View, CA)

*Bruce Keller*

Partner, Debevoise & Plimpton LLC  
(New York, NY)

- Integrating the Supreme Court decision in *K.P. Permanent Make-Up, Inc.* into your fair use analysis
  - the likelihood of confusion test
  - nominative fair use
- Assessing the way different venues deal with the nominative fair use defense
  - California
  - New York
  - Ohio
- Advising your company in light of the differing views on nominative fair use
- Pursuing trademark infringement cases against gripe sites
  - how bad does a gripe site have to be for you to face the negative PR associated with suing its owner?
  - how effective is the dilution argument in overcoming a fair use defense?
  - utilizing the ACPA

## 9:30 Navigating the Evolving Definition of "Use in Commerce"

*Stephen Feingold*

Partner, Pitney Hardin LLP  
(New York, NY)

- What is "use" as defined in Lanham Act?
  - different definitions for goods and services
- How is "use in commerce" defined in the Lanham Act?
  - navigating the USPTO's new and broadened definition of "use in commerce"
- How are international trademarks approached in the Lanham Act?
  - what are the ramifications of *Casino De Monte Carlo* case?
  - can the *Casino De Monte Carlo* case apply to goods as well as services?
- Navigating recent case law defining "use in commerce"
  - "tacking cases"
  - product placement cases

10:30 Refreshment Break

## 10:45 Metatags, Keywords, and Related Forms of Targeted Internet Advertising

*Joshua Paul*

Partner, Sedgwick, Detert, Moran & Arnold, LLP  
(New York, NY)

*Allison McDade*

Counsel, Trademark & Copyrights, Dell Inc.  
(Round Rock, TX)

- What are "metatags" and how do they function as a search engine optimization technique?
- Making sense of the early metatag decisions
  - Reconciling the 9th Circuit's decisions in *Brookfield Communications* and *Playboy Enterprises v. Welles*
  - Understanding how these and other metatag cases have established a footprint in the evolving law of trademarks on the Internet
- Advising clients about using trademarks as keywords in targeted Internet advertising
  - Making sense of the Lanham Act cases – *Playboy Enterprises v. Netscape*, *American Blind v. Google*, *GEICO*, and more
  - The international dimension – *Estee Lauder v. Excite* and other decisions in France, Germany and Austria
- Understanding the FTC's approach to keywords and "paid placement" advertising
- Non-litigation alternatives available to trademark owners whose marks have been purchased as keywords
- What should a company consider when making decisions regarding keyword advertising?

## 11:30 Using Insurance in Managing Infringement Liability Based on Advertising and Marketing

*Chad E. Milton*

Senior Vice President and National Practice Leader  
Marsh USA, Inc. (Kansas City, MO)

*Jay M. Levin*

Counsel, Reed Smith LLP  
(Philadelphia, PA)

- What insurance coverage is potentially applicable to trademark and copyright litigation under standard and specialty forms?
- How does the typical general liability policy respond to various types of claims?
  - nature of the claims
  - nature of offending activity
- How specialty policies work to cover these claims
  - professional liability policies
  - media liability policies
  - new insurance products.
- How does the availability of insurance coverage affect litigation strategy for both plaintiffs and defendants?

## 12:15 Networking Luncheon for Speakers and Delegates

### Keynote Address on Recent Keyword Advertising Cases

*Michael Kwun*

Litigation Counsel, Google Inc. (Mountain View, CA)

## 1:30 Mapping the Legal Future of Targeted Internet Advertising: How Real are the Threats to Adware and Spyware?

*Terence Ross*

Partner, Gibson, Dunn & Crutcher LLP  
(Washington, DC)

*Michael Clayton*

Partner, Morgan, Lewis & Brockius LLP  
(Washington, DC)

*Celia Barenholtz*

Partner, Kronish Lieb Weiner & Hellman LLP  
(New York, NY)

- Determining the extent to which the behavior of contextual marketing companies constitutes “use” in commerce?
  - the *1-800 Contacts* case
  - *U-Haul Inc. v. WhenU.com*
  - *Wells Fargo & Co. v. WhenU.com*
- Evaluating the arguments that pop-up ads violate the IP rights of website owners
  - copyright infringement
  - trademark infringement
  - trademark dilution
  - initial interest confusion
- Applying the fair use defense to pop-up claims
- Legislative efforts to regulate adware and spyware
  - differentiating between adware and spyware
  - state prohibition of adware (Utah, California)
  - possible federal preemption of state laws
- FTC’s view on regulating adware and spyware
  - is industry self-regulation sufficient?
  - would further regulation limit the development of new technologies?

## 3:00 Refreshment Break

## 3:15 Securing All Necessary Rights When Using Celebrities in Your Marketing and Advertising

Right of publicity and false association claims

*Rick Kurnit*

Partner, Frankfurt Kurnit Klein & Selz PC  
(New York, NY)

- The expansion of rights of publicity and commercial speech, and the exposure beyond advertising use
- What constitutes name, picture, likeness, voice, signature, “persona,” and context — and California’s peculiar protections for celebrities
- The differing standards for determining whether a use is protected by the First Amendment
- Claims based on titles, packaging, marketing, websites, and editorial content
- Parallel marketing, ambush marketing, and parasitic marketing — where are the lines?

Contracting with celebrities in your advertising and marketing efforts

*William Coats*

Partner, White & Case LLP  
(Palo Alto, CA)

*Heather Rafter*

Counsel, DigiDesign  
(Daly City, CA)

*William Jelinek*

Vice President and Legal Counsel  
The Estee Lauder Companies Inc.  
(New York, NY)

- Incorporating the lessons of recent “right of publicity” case law into your contracts
- Ensuring national campaigns comply with all state right of publicity and privacy laws
- Negotiating contracts with celebrities
  - Factoring recent excessive damage awards into your negotiation strategies
- Strategies for creating effective release documentation
- Obtaining the necessary rights and clearances in your marketing efforts
- Utilizing publicity of a celebrity who is no longer under contract with your company
- Special considerations on using celebrities in your Internet marketing

## 5:00 Conference Adjourns to Day Two

**Tuesday, February 28, 2006**

## 8:15 Continental Breakfast ☞

## 8:45 Co-Chairs’ Opening Remarks

## 9:00 Defining Appropriate Uses of Competitors’ Trademarks in Advertising

*Ronald Urbach*

Partner, Davis & Gilbert  
(New York, NY)

- What types of uses of a competitor’s trademark and logos have been proven to cross the line into infringement?
- Reducing the risk of legal claims related to your comparative advertising campaigns
  - infringement claims
  - dilution claims
  - fair use claims
- Making clear at the outset of the agency relationship who is responsible for obtaining trademark clearance
- Communicating to copywriters methods for creating effective and compliant comparative advertising campaigns

## 9:45 Using Others’ Copyrighted Material in Advertising and Marketing Campaigns

*Barbara Kolsun*

Senior Vice President and General Counsel  
7 For All Mankind  
(New York, NY)

*Mary Donovan*

Partner, Donovan & Yee LLP  
(New York, NY)



*Brian Murphy*

Partner, Frankfurt Kurnit Klein & Selz PC  
(New York, NY)

- Distinguishing between the taking of ideas and the taking of expression
  - using dialogue from other commercials
  - using settings from other commercials
  - case studies
- How much use is fair?
  - using quotations from other materials
  - using excerpts from periodicals and other types of media
  - showing someone else's copyrighted work in its entirety
- Parody update

## 11:15 Coffee Break ☕

## 11:30 Effective Use of Licensing — and the Public Domain — in Your Marketing Efforts

*Amy Benjamin*

Partner, Darby & Darby PC  
(New York, NY)

*David Sternbach*

Director, Legal & Business Affairs, A&E Television Networks  
(New York, NY)

- Determining precisely which rights you're trying to secure
- Identifying who you need to obtain rights from
- Confronting issues unique to music clearance
- When is one responsible for inducing others to infringe copyrights under *Grokster*?
- What is the future of the Digital Millennium Copyright Act after *Grokster*?
- Understanding the long-term effects of the Sonny Bono Copyright Extension Act

## 12:30 Networking Luncheon for Speakers and Delegates

## 1:45 Structuring, Negotiating, and Drafting Sponsorship and Joint Marketing Transactions

*David Ervin*

Of Counsel, Collier Shannon Scott  
(Washington DC)

- Understanding the business concerns behind various forms of cross-marketing opportunities
  - straight sponsorship
  - cross promotions
  - cross licensing
- Covering all the legal bases in joint promotion and sponsorship contracts
  - standard provisions
  - licensing issues
  - trademarks and logos
  - necessary indemnifications

- Defining each party's rights - and the limits of those rights — with respect to the licensed property
- Balancing the concerns of multiple parties in sublicense negotiations
  - clearly delineating each party's obligations
- Unique contractual issues with associational rights
  - competitor issues
- Incorporating new commission and revenue formulas into your contracts

## 2:45 Refreshment Break

## 3:00 Incorporating Internet Concerns into Territorial Restriction Clauses

*Steven Weinberg*

Partner, Greenberg Traurig LLP  
(Santa Monica, CA)

- Working the borderless world of the Internet into your definition of "territory"
- Case studies on "exclusivity" clauses
- Solutions to the extra cost for worldwide rights on the Internet

## 3:45 Key IP And Related Issues In Cross-Border and Spillover Advertising

*Sheldon Burshtein*

Partner, Blake, Cassels & Graydon LLP  
(Toronto, ON)

- Integrated North American media, packaging, and labeling
- Trademarks, including rights, differentiated ownership, licensing, and comparative advertising issues
- Copyright, including works made for hire, fair dealing, music rights, and moral rights issues
- Personality rights, including national and provincial issues
- Personal information, including national and provincial issues
- Advertising law, including Internet issues
- Jurisdiction, including Internet issues
- Domain name disputes
- Internet activities, including linking, framing, keying, metatagging, pop-up advertising, cybergripping, phishing and pharming issues

## 4:45 Conference Adjourns

### Sponsorship Opportunities

ACI works closely with each sponsor to create a distinctive package tailored to individual marketing and business development objectives. Our objective with every sponsor is to foster a rewarding and long-term partnership through the delivery of a wide variety of sponsorship benefits and thought leadership opportunities. For more information, please contact:

*Benjamin Greenzweig,*

Director of Business Development, U.S., (212) 352-3220 ext. 238  
or [B.Greenzweig@AmericanConference.com](mailto:B.Greenzweig@AmericanConference.com)

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# IP<sub>IN</sub> ADVERTISING & MARKETING

Understanding Fair Use, Enforcing Your  
Rights, and Leveraging Opportunities

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