

Licensing & Tech. Transfer

- Module 6
- Trademark Licenses and Franchises

Oreck Corp. v. Thomson (SD Indiana 1992)

- Oreck marks and registrations
 - XL {1970, vacuums; 1975, other}
 - X-TENDED LIFE {1979}
- RCA 1971 letter and 1972 use of XL-100
 - Fed. TM App. {1975; “incontestable” in 1981}
- RCA attempts for XtendedLife
 - Settlement discussions – 1982 letter “XL Marks”
- 1988 – Thomson sues Oreck after terminating it as a dealer
 - 6 counts by Oreck
 - 2 S/J motions, and motion to dismiss, by Thomson

Word Mark	XL 1988
Goods and Services	JOHN DEERE CO. 200. US 201. 0 & 5. TELEVISION RECEIVERS; FIRST USE: 1970/01. FIRST USE IN COMMERCE: 1972/01/01
Mark Drawing Code	10. THREE CHARACTERS
Serial Number	7390208
Filing Date	August 15, 1975
Current Filing State	IA
Original Filing State	IA
Registration Number	1037120
Registration Date	April 15, 1976
Owner	(REGISTRANT) RCA CORPORATION CORPORATION DELAWARE 30 ROCKEFELLER PLAZA NEW YORK NEW YORK 10020
Assignment	ASSIGNMENT RECORDED
Trademark	FRANCHISE
Type of Mark	FRANCHISE
Attorney	PROCTER & KENNEDY
Attorney Mail	REG. 02. 1027. P. 04/16/76
Live/Dead Indicator	DEAD

Villanova Univ. v. Villanova Alumni Ed. Found., Inc. (E.D. Penn 2000)

- Which party is arguing that there was an implied license from 1972 to 1992, and why? What about the remainder of the timeline?
- Can a disclaimer cure?
- Insufficient control to constitute abandonment?

Form with corporate and trade name

1972 1981 1987 1992 1995 1996 1999

Ratify Expire

Dear Friends of Villanova University,

I am writing to keep you abreast of the latest developments which have occurred concerning the Athletic Department's fund raising operations which benefit Villanova's student-athletes.

Our affiliation agreement with the Wildcat Club expired in September, 1996, and since that time we have worked tirelessly with Club representatives in an attempt to reach a new agreement that would be in the best interest of our student-athletes and athletic programs. In November, 1998, the University took the extraordinary step of appointing a special committee of the Board of Trustees to work out an agreement between the University and the Club. An agreement in principle was reached in June, 1999, between the negotiating teams, but regrettably, the Club voted not to approve the proposal at their annual meeting held in October, 1999. As a result, Villanova University is disassociating itself from the Wildcat Club for the reasons contained in the following statement.

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John Anthony, Inc. v. Fashions by John Anthony, Inc. (TTAB 1980)

- Applicant and opposer
- Relationship of Mr. John Anthony Iorio to applicant and opposer
- Why does opposer think it should be successful?
- Result?



Birthright v. Birthright, Inc. (D. NJ 1993)

- Organization origins in Canada
- Mode of international growth
- Dispute and marks at issue
- Status of defendant US charters
- Result



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Pneutek, Inc. v. Scherr (TTAB 1981)

- Applicant
 - Agreement of September 1976
 - First journal publication in October 1977 with possible use then
- Opposer
 - February 1976 for first use
- Grounds for opposition
 - Use can't be established solely by licensee
 - Insufficient control by licensor

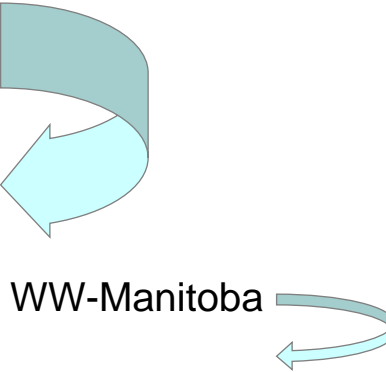


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Weight Watchers of Quebec Ltd. v. Weight Watchers International, Inc. (ED NY 1975)



- WW-Intl
 - WW-Quebec
 - WW-Manitoba
 - WW-Ontario
 - then
 - WW-Quebec & WW-Manitoba
 - WW-Intl
- 

- (1) defendant's deliberate refusal to exercise its contractual controls over WW Ontario;
- (2) defendant's failure to diligently pursue injunctive relief against WW Ontario; and
- (3) defendant's consent to an order allowing WW Ontario to use the 'Weight Watchers' trademark in plaintiffs' territories from October 23, 1973 until August 1, 1974.

In re Vylene Enterprises, Inc.; Vylene Enterprises, Inc. v. Naugles, Inc. (9th 1996)

- Naugles, Inc. as Franchisor (F'OR)
- Vylene as Franchisee (F'EE)
- Agreement scope, term, and renewal provisions
- October 1985 "negotiation" to extend term 8 more years
- Dispute in bankruptcy court and result
 - Core or not?
 - Was expiration of agreement effective?
- Dist. Ct. result
 - Renewal term is too indefinite
- 9th circuit result
 - Renewal provision did require F'OR to negotiate in good faith to renew, even if F'EE did not have a guaranteed right to renew
 - F'OR can't rely on nonexclusive status of F'EE in locating new restaurant so close

Exxon Corporation v. Oxxford Clothes, Inc. (5th 1997) **EXXON**

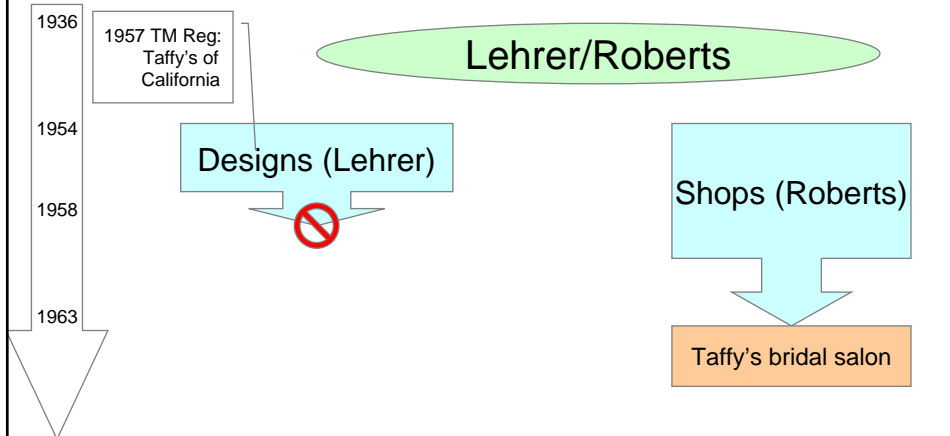
- 14 phase out agreements after the 1970s, one with a 3 year period
- Oxxford mark in use since 1949, but started using interlocking XX in 1993
- Exxon suit, with Oxxford affirmative defenses
 - Phase out agreements alleged to be naked licenses, leading to abandonment
 - Ultimately, Exxon goes forward in the suit with a single Texas state law dilution claim
- Issue(s) and Dist Ct. result?
- 5th circuit result?

Stanfield v. Osborne Industries, Inc. (D. Kan. 1993)

- Stanfield's role
- Osborne's role
- 1973 contract
- 1975 license
- Issues in present case
 - Did Stanfield "in fact" exercise control toward quality?
 - Can he rely on licensee's QC?
 - Or, did licensee just resist his QC efforts?
 - Time of suit?

The screenshot shows a web browser window displaying the Osborne Industries website. The page is titled "Stanfield® Heat Pads" and features the Osborne Industries logo and navigation menu. The main content area includes a description of the heat pads, stating they are an energy-saving heat source for healthier, faster-gaining pigs in farrowing crates and nurseries. It also mentions that the pads have earned UL, CE, and CSA certification and that stress-free, vigorous pigs gain faster. A small image of the heat pads is visible in the bottom right corner of the page content.

Taffy Original Designs, Inc. v. Taffy's, Inc. (ND Ill. 1966)



- Issue for Shops to enforce the mark TAFFY'S OF CALIFORNIA against the bridal shop
- Result?

Joseph Bancroft & Sons Co. v. Shelley Knitting Mills, Inc. (ED Penn. 1962)

- Bancroft uses the BAN-LON mark in its licensing program under strict QC in order to create consumer demand in hopes of driving more royalties for its process manufacturing licensing
- Shelly became a licensee in 1955 as a garment manufacturer and distributor
- Bancroft QC standards, heightening, and stitch count increases to combat "pilling"
- TM infringement?
- Injunction?

Westowne Shoes, Inc. v. Brown Group, Inc. (7th 1997)

- Purity program
 - When start?
 - Purpose?
 - How did it change the parties' relationship?
- Basis of Westowne's suit against Brown
 - Licensing K / sales transactions?
 - Dealership law?
 - Contract?
- Dist Ct. result
- Appellate result



MWS Wire Industries, Inc. v. California Fine Wire Co., Inc. (9th 1986)



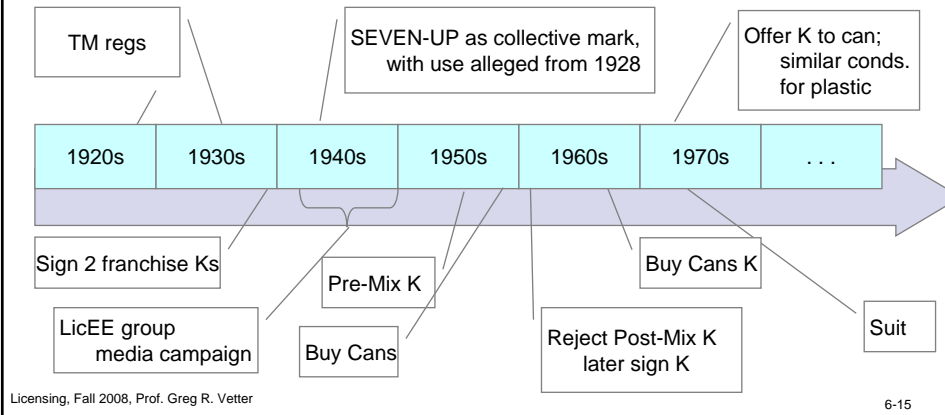
- 1983 dispute about MWS's MULTIFILAR mark
- 1984 use by CFW & dispute therefrom



Seven-Up Bottling Company v. Seven-Up Company (8th 1977)



- Bottler's claim to challenge mark(s)
 - Alleged effect of collective mark
- Company defense
- Effect of 1939 agreements



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Burger King Corporation C.R. v. Weaver; M-W-M, Inc. (11th 1999)



- Weaver franchises
 - #1666 (1976)
 - #6158 (1988)
- Geographic scope provisions in the franchise agreements?
- Malmstrom Air Force Base restaurant
 - 1989 opening
 - Weaver's reaction and resulting action?
- Dist Ct. result?
- Appellate result?

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MJ & Partners Restaurant v. Zadikoff (ED III. 1998)

- Jordan/Jump intervene as 23Food brings TM suit against Zadikoff
 - Why?
- 1990 agreements
 - Restaurant
 - Store
 - “side agreement”
- Issue in whether to grant Jordan/Jump relief under a declaratory judgment



Torres v. Goodyear Tire & Rubber Company, Inc (Arizona 1990)

- Nature of suit by Torres
- Procedural posture of issue before Arizona Supreme Court
- Tires as goods that carry the tort regime of strict liability
- Who made the tire involved in Torres' accident?
- How was the tire branded?
- Does status as trademark licensor carry strict liability?
- Reasons for/against; effect of level of QC
 - Other points of control by Goodyear over its subsidiaries/licensees



Kosters v. Seven-Up Company (6th 1979)

- Nature of Kosters' accident with the bottles?
- Which product(s) are potentially defective?
 - Source of supply for these
- 6th circuit predicting Michigan state law
 - Implied warranty for franchisor – 4 factors
 - Bottles in the strict liability class of inherently dangerous activities?
 - Opportunity to change design
 - TP beneficiary claim
- Dist. Ct. result
- Appellate result

