







## **ACC San Francisco Bay Area IP Symposium 2025**

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This presentation is provided for informational purposes and does not constitute legal advice.

# **Poll 1: Contracting Experience**

How regularly do you deal with commercial contracts in your role?

- Never
- Rarely
- Monthly
- Often
- Every day



#### **Poll 2: Trademark Experience**

How much experience do you have working with trademarks (filings, enforcement, opinions, or disputes)?

- None
- Limited (a few matters)
- Moderate (regular but not primary focus)
- Extensive (a core part of my role)



# **Poll 3: Trademark Licensing Experience**

How many trademark license agreements have you handled directly?

- None
- 1–5
- 6–20
- More than 20



#### **Poll 4: Biggest Challenge**

When working with trademark licenses, what do you see as the biggest risk area?

- Exercising quality control without overreaching
- Setting and collecting royalties
- Enforcement and infringement disputes
- None of the above/Not applicable



#### **Poll 5: Current Practices**

In your current practice, how often do you see explicit provisions covering digital rights (domains, social media, app stores, NFTs, virtual goods) in trademark license agreements?

- Rarely or never
- Sometimes
- Frequently
- Almost always
- N/A



## Agenda



- Structuring the License Agreement
- Avoiding Naked Licensing
- Franchise vs. License
- Enforcement Rights and Obligations
- Marketplace and Influencer Use



#### 1. Structuring the License Agreement

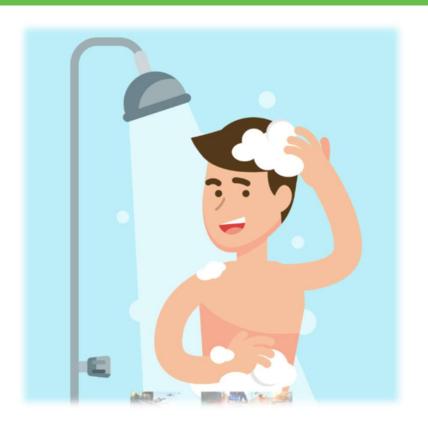
- Define licensed mark, field of use, territory, exclusivity, term
- Key financial terms: royalties, milestones, sublicensing rights
- Infringement enforcement and termination triggers
- Common pitfalls: unclear scope, missing digital rights, weak termination provisions





#### 2. Avoiding Naked Licensing

- What is naked licensing and why it risks loss of rights
- Quality control provisions: product standards, approval rights, samples
- Inspection/audit rights and reporting obligations
- Documentation: compliance records and enforcement history





#### 3. Franchise vs. License

- Franchise = trademark license + business control/assistance + fee
- Where licensing ends and franchising begins
- Red flags: operational manuals, mandatory suppliers, extensive training
- Safe harbor: focus control on brand quality, not operations





### 4. Enforcement Rights and Obligations

- Licensor must monitor misuse to preserve rights
- Licensee enforcement: typically tied to exclusivity
- Agreement terms: who enforces, who pays, who controls litigation, allocation of damages
- Practical monitoring tools: online marketplace sweeps, reporting obligations





#### 5. Third-Party Marketplace & Influencer Use



- Risks with influencers, affiliates, resellers
- Need for clear trademark use permissions or licenses
- Best practices: brand guidelines, written agreements, ownership clauses
- Monitoring social media and marketplaces for misuse



# Key Takeaways

- Precise drafting reduces risk
- Active quality control protects rights
- Distinguish licenses from franchises
- Define enforcement clearly
- Manage marketplace and influencer use





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