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Verne, B. Michael

From: [REDACTED]
Sent: Monday, December 22, 2008 4:58 PM
To: Verne, B. Michael
Cc: [REDACTED]
Subject: HSR question

Mike:

I have been looking at some of the recent (last couple of years) informal interpretations on the issue of when a license for a field of use constitutes a potentially reportable asset acquisition, and I'm having trouble discerning a reasonably clear dividing line. In 0712007, dated 12/14/07, you say that an exclusive distribution agreement coupled with an exclusive license to use the trademark in connection with distributing is not the acquisition of an asset, which makes sense to me if the distributor is simply selling a product actually made by the trademark owner, as appears to be the case in that hypothetical (candy or whiskey). But in the earlier email included in that string, dated 11/28/07, you say somewhat more broadly that "an exclusive license for a trademark to be used for marketing a particular product or products is not an acquisition of an asset," citing the example of an exclusive license to use the trademark on stadium seats, where the licensor is also granting exclusive licenses to use the trademark on other products (cups, etc.). In that scenario, I assume the licensee would actually be making the pillows (or cups, bobble-heads, etc.), not just selling someone else's brand-name product, so I gather the question of who is doing the manufacturing is not the determining factor. You contrast that to an exclusive license to a patent in a particular field of use, such as a license for a drug for veterinary use. While I agree that the trademark arrangement "can be differentiated" from the patent license, I'm not sure which basis of differentiation you're following. Is it simply that an exclusive field of use license for a trademark, unlike a patent, isn't enough to constitute an asset; rather, it has to be an exclusive license for "all rights to use of the trademark," as in the example in your final sentence? See also No. 0809004, dated 9/10/08 in response to a 9/9/08 email, agreeing that a contribution of exclusive trademark licenses to a joint venture is not a contribution of assets.

Where does a combined license for a copyright and a trademark fit into this? More specifically, I'm looking at an "exclusive" license to use certain movie characters to make and distribute certain types of toys, e.g., action figures and board games, but not other types of toys, such as dolls, plush toys, etc. Based on the trademark license advice described above, it would seem that this limited exclusive license isn't an asset for HSR purposes, but does it make a difference that it's coupled with a comparable license for certain copyrights?

As always, thanks for your help.

[REDACTED]

12/23/2008

Our position is that an exclusive license for all rights to use a patent for a particular field of use is a potentially reportable acquisition of an asset. Conversely, an exclusive right to use a trademark to market and distribute a specific product(s) is not. This is true whether the product is being manufactured either by the licensor or the licensee.

In your scenario, I agree that the license is not an acquisition of an asset. Being coupled with copyright licenses does not change the analysis. In order for a trademark license to be an acquisition of an asset, it must transfer all rights associated with the trademark to the licensee, even against the licensor, as if the actual trademark is being acquired.


12/23/08