



Arbitrating and Mediating IP licensing disputes in the entertainment and fashion industries: What can Barbie teach us?

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Conference Reference Materials

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California International Arbitration Week

March 11-14, 2024

LITIGATION

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CA California
Arbitration

**Arbitrating and mediating IP licensing disputes in
the entertainment and fashion industries:
What can Barbie can teach us?**

Ghada Qaisi Audi, Ghada Qaisi Audi ADR
Emily Borich, Foster Garvey
Adam Rattray, WIPO Arbitration and Mediation Center

Welcome to the session, all!

Ghada Qaisi Audi, Ghada Qaisi Audi ADR

Emily Borich, Foster Garvey

Adam Rattray, WIPO Arbitration and Mediation Center

Intro to today's session

- Why ADR for Entertainment and Fashion Disputes?
- Routes to Mediation and Arbitration
- WIPO Arbitration and Mediation Center
- Entertainment: contracts, parties, and cases
- Fashion: contracts, parties, and cases
- Don't forget domain names
- Final thoughts

Why ADR for Entertainment and Fashion Disputes?

- Cost of IP court litigation
- Internationalization of creation and use of IP
- Technical and specialized nature of IP
- Short product and market cycles in IP
- Confidential nature of IP
- Collaborative nature of IP creation and commercialization
- Enforcement

Fashion and entertainment disputes and parties

Areas of dispute

- licensing agreements
- franchising agreements
- distribution agreements
- manufacturing agreements
- co-branding agreements
- sponsorship agreements
- advertisement
- internet retail and e-commerce
- IP infringements

Parties

- multinational corporations
- SMEs
- startups
- designers
- inventors
- distributors
- manufacturers
- fashion houses
- service providers

Routes to ADR

- **ADR contract clause** electing [WIPO] Rules
 - Mediation or Arbitration or Expedited Arbitration; or
 - Multi-tier/escalation clause
 - Model clauses
- **ADR submission agreement** electing [WIPO] Rules, e.g., in existing non-contractual disputes
- **Unilateral request** for WIPO Mediation by one party (Art. 4)
- **Court referrals**

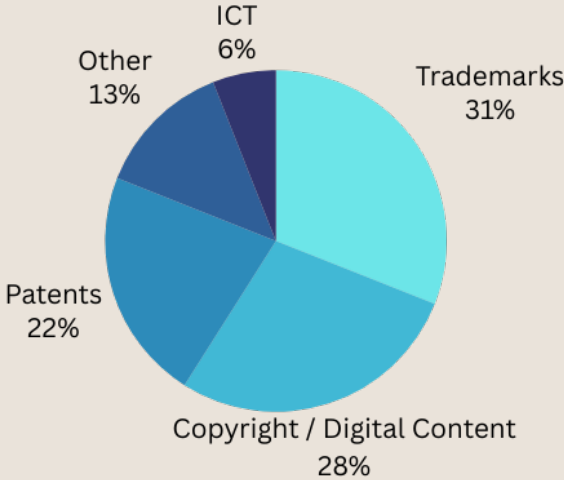
WIPO Arbitration and Mediation Center

- Facilitates the resolution of commercial disputes between private parties involving IP and technology, through ADR
 - Offices in Geneva and Singapore
 - International neutrality
 - Users around the world
- ADR of IP disputes benefits from a **specialized** ADR provider
- Competitive WIPO fees
- Services include mediation, (expedited) arbitration, expert determination, and domain name dispute resolution

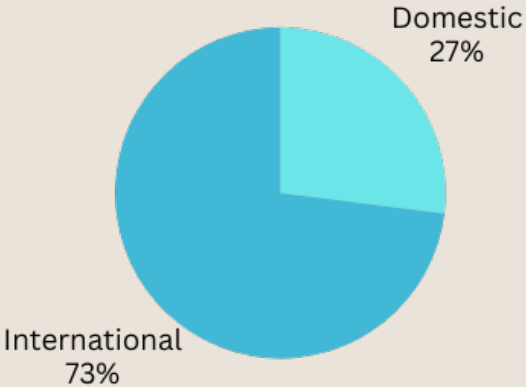
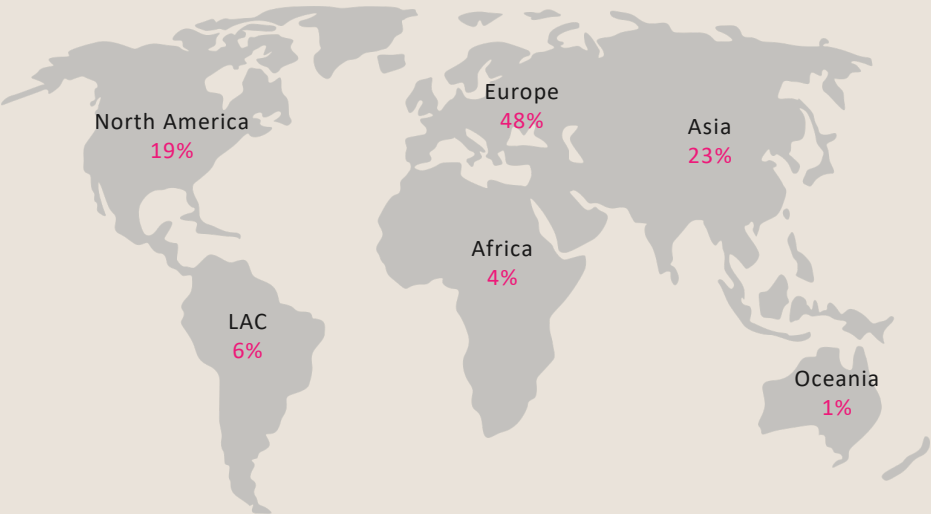


Disputes Under WIPO ADR Rules

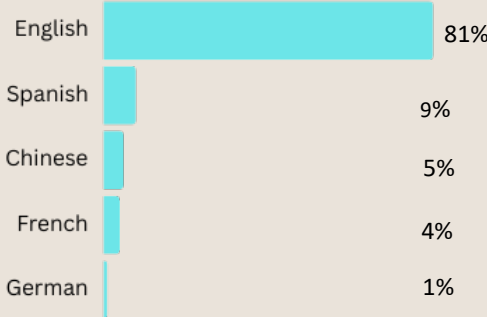
Legal Areas



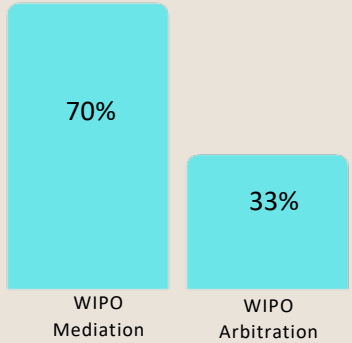
Party Location



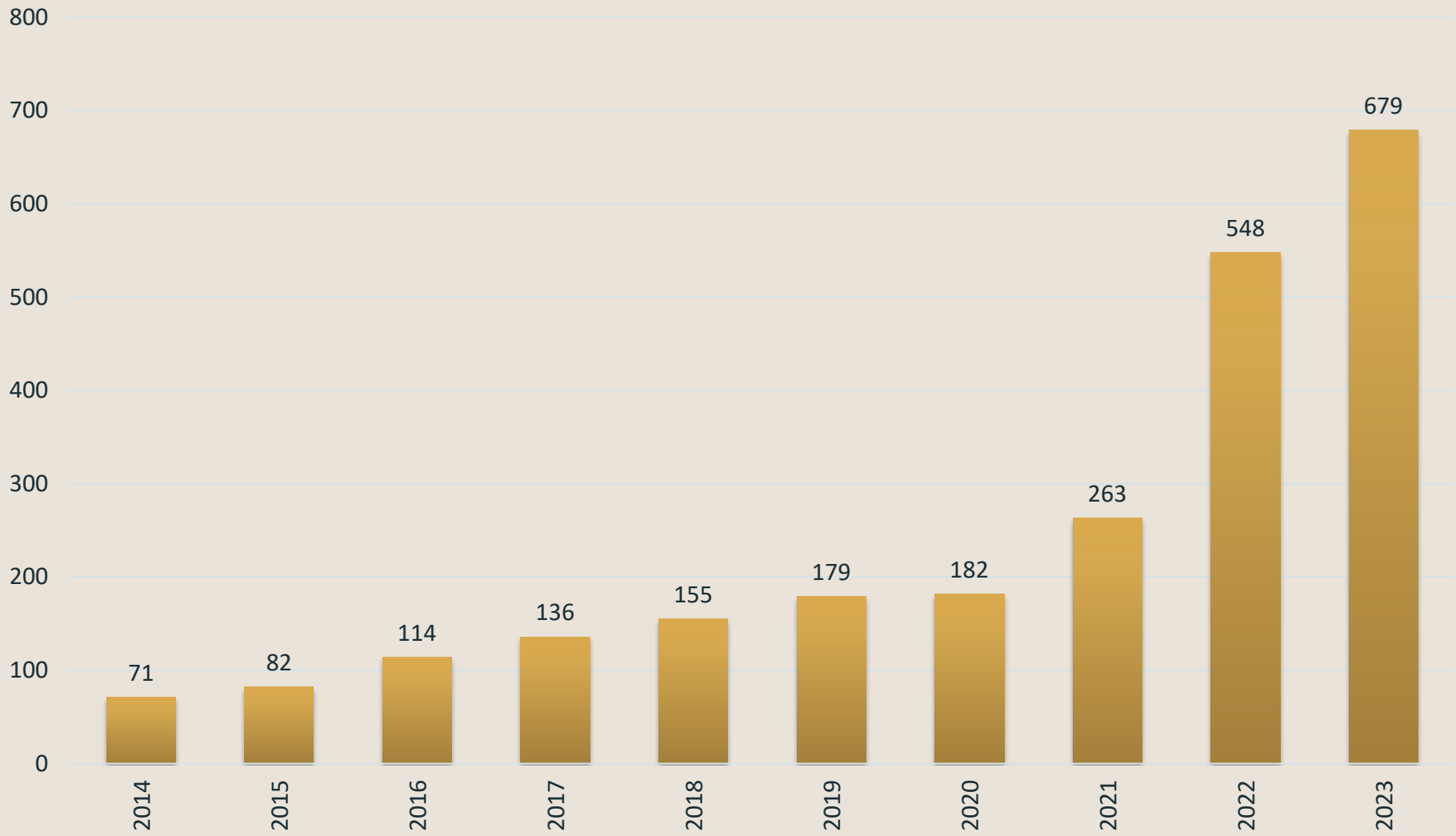
Language



Settlement rate



Disputes Referred to WIPO ADR



WIPO Center Case Role

- Procedural assistance (Good Offices)
 - Information and guidance on ADR
 - Drafting ADR clauses and submission agreements
- Administering cases
 - Containing time and costs
 - WIPO eADR (online case management system)
- Assisting selection and appointment of mediators, arbitrators, experts; negotiating fees
 - 2,500+ WIPO neutrals from all regions
 - Specialized in IP and technology

Clause example for contract

"**Any dispute**, controversy or claim arising under, out of or relating to this contract and any subsequent amendments of this contract, including, without limitation, its formation, validity, binding effect, interpretation, performance, breach or termination, as well as non-contractual claims, **shall be submitted to mediation in accordance with the WIPO Mediation Rules**. The place of mediation shall be **[specify place]**. The language to be used in the mediation shall be **[specify language]**"

If, and to the extent that, **any such dispute**, controversy or claim **has not been settled pursuant to the mediation within [60][90] days of the commencement of the mediation**, it shall, **upon the filing of a Request for Arbitration by either party, be referred to and finally determined by arbitration in accordance with the WIPO Expedited Arbitration Rules**. Alternatively, if, before the expiration of the said period of [60][90] days, either party fails to participate or to continue to participate in the mediation, the dispute, controversy or claim shall, upon the filing of a Request for Arbitration by the other party, be referred to and finally determined by arbitration in accordance with the WIPO Expedited Arbitration Rules. The place of arbitration shall be **[specify place]**. The language to be used in the arbitral proceedings shall be **[specify language]**. The dispute, controversy or claim referred to arbitration shall be decided in accordance with **[specify jurisdiction]** law."

WIPO Mediation example of a trademark infringement dispute

<i>Parties</i>	Chinese and US companies in the fashion industry
<i>Dispute</i>	Trademark infringement and unfair competition claims, litigation pending before Pudong District Court (Shanghai)
<i>Basis</i>	Submission agreement to WIPO Mediation and court proceedings suspended for 30 days
<i>Process</i>	Mediator with experience in Chinese trademark law One-day mediation meeting in Shanghai
<i>Result</i>	Settlement confirmed by the court and withdrawal of litigation

WIPO Expedited Arbitration of a trademark licensing dispute

Parties Dutch and Swiss companies

Contract Trademark License Agreement for the commercialization of luxury products

Dispute Unjustified termination of the license and related damages

Process Sole arbitrator experienced in trademarks

Interim measures relating to provisional restriction on the use of the trademark, as well as measures for the conservation of the stock

Several one-day hearings including witness examination

Result **Final award rendered within ten months of the commencement of the arbitration**

ADR procedures adaptable to suit business areas

- Art and Cultural Heritage
- Artificial Intelligence (AI)
- B2B Data Disputes
- **Digital Copyright and Content**
- Energy
- **Fashion**
- **Film and Media and Entertainment**
- Franchising
- Green Technology and Sustainability
- Information and Communication Technology
- Intellectual Property Offices and Courts
- Life Sciences
- Patents in Standards
- Research and Development/Technology Transfer
- SMEs
- Sports
- Trade Fairs
- Video Games and eSports

WIPO ADR cases: Copyright

Areas of disputes / Agreements

- Contractual
 - Ownership of rights
 - Royalties payment
 - IP/ IT licensing agreements (e.g., software licenses)
 - Film co-production agreements
 - Broadcasting agreements
 - Distribution agreements
 - Reciprocity agreements

- Non-contractual
 - IP Infringement (copyright, TV format, patents)

Parties

- Authors
- Performers
- Publishers
- Producers
- CMOs
- Start-ups
- IT companies
- Marketplaces
- Software developers and programmers

WIPO ADR for Digital Copyright and Content Disputes

The WIPO AMC provides ADR procedures to help parties resolve disputes related to copyright and content in the digital environment. These procedures include [WIPO Mediation](#), [\(Expedited\) Arbitration](#), [Expert Determination](#) and tailored procedures, such as [WIPO Expert Determination for Digital Copyright and Trademark Infringement \(WIPO DCTI\)](#).

Parties can use WIPO ADR to resolve different types of disputes in the digital environment:

- negotiation of licensing agreements for content distribution;
- adjustment of existing licensing terms on the remuneration owed from online platforms to right holders;
- breach of licensing terms;
- determination of tariffs, in particular between collective management organizations (CMOs) and right holders, and/or reasonable remuneration terms;
- establishing ownership of unpaid/unclaimed royalties;
- establishing ownership of software improvements or updates;
- delivery and quality of works and/or content in film co-production or advertising agreements; and
- if copyright exceptions or limitations are applicable when uploading and making available content.

For more information, you can contact us by [email](#) or [book an online appointment with WIPO AMC's staff](#).

[File a case online](#)

- [Why WIPO ADR for Digital Copyright and Content Disputes?](#)
- [WIPO Mediation](#)
- [WIPO Arbitration](#)
- [WIPO Expedited Arbitration](#)
- [WIPO Expert Determination, including for Digital Copyright and Trademark Infringement \(WIPO DCTI\)](#)
- [WIPO ADR Case Examples related to Digital Copyright and Content Disputes](#)
- [Support and Guidance by the WIPO AMC and Tailored ADR Procedures](#)
- [Collaboration with Concerned Stakeholders and Entities](#)

Alternative Dispute Resolution Mechanisms for Business-to-Business Digital Copyright- and Content-Related Disputes

A report on the results of the WIPO-MCST survey

With the financial support of the Ministry of Culture, Sports and Tourism of the Republic of Korea (MCST)



Unilateral Request for WIPO Mediation

This electronic filing form allows you to complete and submit a Unilateral Request under [Article 4](#) of the WIPO Mediation Rules to the WIPO Arbitration and Mediation Center. Upon submission, a copy of this Request will be sent to the Responding Party.

The filing of a Unilateral Request for Mediation is not subject to an administration fee. If the parties agree to continue with the mediation process, the administration fee required by [Article 22](#) of the WIPO Mediation Rules and the [Schedule of Fees and Costs](#) will be applicable. Should you prefer to file a Unilateral Request for WIPO Mediation without using this electronic form, please see the WIPO AMC's [Case Filing Guidelines](#) and [additional online resources](#) for WIPO Unilateral Mediation.

Information about the processing of personal data by the WIPO AMC is [available here](#).

Mandatory fields are marked as (*).

Name [Requesting Party] *	Name [Responding Party]
Address *	Address
Telephone	Telephone
E-mail *	E-mail
Represented By	Represented By
Address	Address

Fashion disputes

Disputes in the fashion industry relate to a wide variety of contracts, including retail, licensing, distribution, franchising, advertising and exploitation of image rights, among others.

Such disputes can involve complex legal, commercial or management issues, and often relate to highly valuable trademarks, industrial designs, copyright and related rights and patented technologies.

The Barbie trademark

First [registered in 1959](#), Barbie's original logo featured a simple, handwritten bright pink sans serif font. Since then, the logo changed five times before Mattel reverted to the original in 2009, which is still in use today.

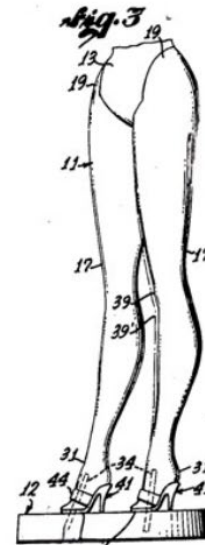
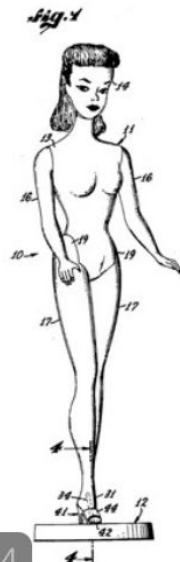
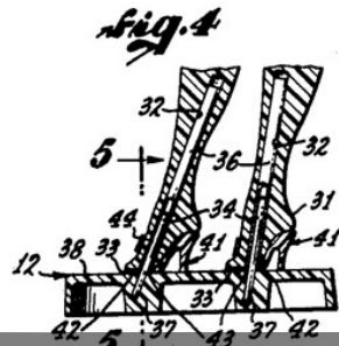


When Mattel applied to register the Barbie trademark, they had to precisely identify the goods for which they intended to use “Barbie”. When they were first granted trademark protection for “Barbie”, it was specifically for “dolls”, giving them the right to exclusively use and prevent others from using “Barbie” on dolls.

Mattel has since applied for the Barbie trademark in other categories of goods such as clothing, jewelry, vehicles, drawing materials, and others. To avoid rejection, brand owners need to be careful to only select relevant product types for which they seek trademark protection – otherwise trademark offices are unlikely to accept their application.

In addition to trademark rights, Barbie products have also received [patent](#) and [industrial design](#). For example, the [first Barbie patent from 1961](#) related to a “doll construction”. Back then, on a tiptoe, Barbie was unable to stand upright without support. Only later were Barbie’s feet flattened.

J. W. RYAN
DOLL CONSTRUCTION
Patented November 21, 1961
No. 3,009,284



DRAWINGS FROM U.S. PATENT 3,009,284

From Barbie to the world: licensing and merchandising deals

For the Barbie movie and through other [licensing](#) deals, Mattel (“the licensor”) grants others (“licensees”) the right to produce and sell products and services leveraging the Barbie brand.

It’s thanks to these deals that we are seeing a plethora of products featuring Barbie on the market: Mattel’s licensing deals with over 100 brands include an O.P.I. Barbie nail polish, Gap’s Barbie apparel, NYX cosmetics, a Burger King pink sauce, pink Xbox controllers, Crocs, UNO cards, and much more.

The defining feature across all these products is the presence of the Barbie logo, which serves as a connection to the original Barbie brand.

BARBIE® Licensing





10% OFF

Almost Gone

Made in the USA



Sale

SHIRT
\$8.00



Sale

HIBARBIE PINK SWEATSHIRT
~~\$69.99~~ \$34.00 Save \$35.99



Sale



Sale

Protect your domain names

Tackling cybersquatting: Uniform Domain Name Dispute Resolution Policy (UDRP)

- 1999: WIPO-created international ADR procedure
- Allows trademark owners to resolve “clear-cut” cases of abusive domain name registration and use (“cybersquatting”)
- Operates outside the courts, but preserves court option
- Applies via mandatory domain name registration conditions
- Applies to all international domains “old” (.com, etc.) and “new”
- Also available for some country-code domains (.eu, .cn, .nl., .ch....)

Why do brand owners choose the UDRP?

- Significantly quicker and cheaper than court litigation
 - Two-month average; fixed fees (USD 1,500)
- Predictable criteria and results
- Decision (transfer) implemented directly by registrar

Protect your domain names

How is a UDRP case decided?

- Trademark identical or confusingly similar to the domain name; and
- Domain name registrant has no rights or legitimate interests in the domain name; and
- Domain name registered and used in bad faith.



Burberry, Cartier, Chanel, Christian Dior, Fabergé, Lacoste, Lancôme, L'OREAL, Louis Vuitton, Ralph Lauren, The Gap, Tiffany Adidas, Birkenstock, Calvin Klein, Converse, Crocs, Dr. Martens, Elite Model Management, Estee Lauder, Feiyue, Fitflop, John Galliano, Karen Millen, L'Oréal, Luxotica, Missoni, Moncler, Paul Frank, Swarovski, Vibram Burberry, Davidoff, Dolce & Gabbana, Etro, Fendi, Gassan Diamonds, Gucci, Hèrmes, J. Choo Limited, Omega, Pierre Balmain, Prada, Richemont, Tiffany Aldo, Belstaff, Bikkembergs, Cerruti, Dr. Martens, Eric Bompard, Karen Millen, Lacoste, Lush, Missoni, Monsoon, Paul Frank, Pepe Jeans, Peuterey, Vans Armani, Bottega Veneta, Burberry, Chanel, Christian Dior Couture, Davidoff, DKNY, Dolce & Gabbana, Etro, Fendi, Frey Wille, Goyard, Gucci, Hermès, Hugo Boss, J. Choo, Marc Orian, Moncler, Prada, Richemont, Rolex, Salvatore Ferragamo, Swarovski, Zegna Armani, Balenciaga, Bottega Veneta, Cartier, Christian Dior Couture, Davidoff, Dolce & Gabbana, Etro, Fendi, Frey Wille, Goyard St-Honoré, Gucci, Hermès, Hugo Boss, J. Choo, Moncler, Montblanc-Simplo, Prada, Richemont, Salvatore Ferragamo, Swarovski, Van Cleef & Arpels, Yves Saint Laurent, Zegna Swarovski Aktiengesellschaft, Valentino S.p.A., Richemont International SA., Chloé S.A.S. Columbia Sportswear, Hugo Boss, Jeanne Lanvin Company, Marimekko, Moncler, Peak Performance, Victoria Beckham

Berlitz, CANAL+, CBS Broadcasting, HarperCollins, Indian Express, MTV, Wikipedia Avid Life, Atlas Productions, Bwin, Delia Ephron, EMI, iTunes, Opera National de Paris, Plácido Domingo Opera Foundation, Twentieth Century Fox, Viacom, Virgin Entertainment Ana Rosa, Avid Life, Columbia Pictures, Deezer, DreamWorks Animation, iTunes, Marlon Brando, MTV, Ubisoft, Viacom, Virgin Entertainment Columbia Pictures, DreamWorks Animation, Showtime Networks, Take-Two Interactive, Ticket Software, Warner Bros. Entertainment, World Wrestling Entertainment Sony Computer Entertainment, Playboy Enterprises International, Inc., Midasplayer.com Ltd., Dreamworks Animation LLC, King.com Limited, YouTube, Google, Meta, Yahoo! Twitter Lady Gaga, Paris Mutuel Urbain (PMU), Star Stable Entertainment, Universal City Studios, Veikkaus, Warner Bros.

Related resources I

WIPO Mediation and Arbitration Rules

<https://www.wipo.int/edocs/pubdocs/en/wipo-pub-446-2022-en-wipo-mediation-arbitration-expedited-arbitration-and-expert-determination-rules-and-clauses.pdf>

WIPO Model Clauses and Submission Agreements

<https://www.wipo.int/amc/en/clauses/index.html>

WIPO Guide to Mediation

https://www.wipo.int/edocs/pubdocs/en/wipo_pub_449_2018.pdf

WIPO Guide to Arbitration

https://www.wipo.int/edocs/pubdocs/en/wipo_pub_919_2020.pdf

Related resources II

Fashion ADR

WIPO Arbitration and Mediation for Fashion

<https://www.wipo.int/amc/en/center/specific-sectors/fashion/>

WIPO Magazine: Managing Risks and Disputes in the Fashion Industry

https://www.wipo.int/wipo_magazine/en/2021/01/article_0008.html

WIPOD podcast Episode 4 – WIPO ADR for Fashion and Luxury Disputes

<https://www.wipo.int/podcasts/en/amc/>

Entertainment

WIPO ADR for Film, Media, and Entertainment

<https://www.wipo.int/amc/en/film/>

Alternative Dispute Resolution Mechanisms for Business-to-Business Digital Copyright and Content-Related Disputes

<https://www.wipo.int/publications/en/details.jsp?id=4558>

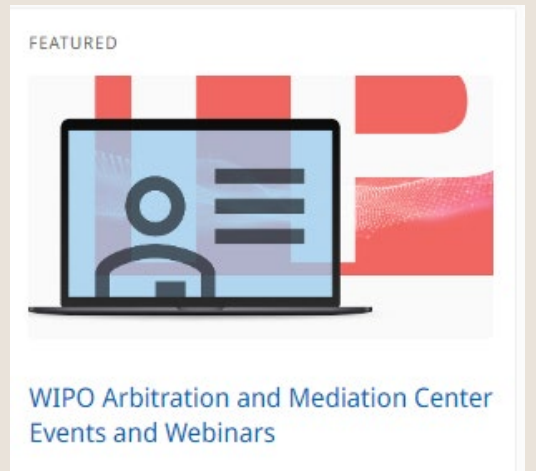
WIPO ADR for Video Games and esports Disputes

<https://www.wipo.int/amc/en/center/specific-sectors/videogames>

Final thoughts

Training

- WIPO Mediation and Arbitration Workshop (June and October)
 - Refreshing the list!



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