KILPATRICK TOWNSEND

Barry M. Benjamin

PARTNER

The Grace Building, 1114 Avenue of the Americas
New York, NY, 10036-7703
USA
t +1 212.775.8783
f +1 212.775.8817

Bbenjamin@kilpatricktownsend.com

Services

Advertising; Copyright; Trademark; Litigation; Intellectual Property Litigation; Green Economy; Advertising Litigation; Internet; Big Data, Privacy and Information Security

Industries

Advertising & Publishing; Fashion & Luxury Goods; Consumer Products; Entertainment, Media & Sports; Food, Beverage & Agriculture; Hospitality & Gaming; Technology & Software; Telecommunications; Retail

Barry M. Benjamin focuses his practice on advertising, intellectual property, technology, and media law in the areas of advice and counseling, regulatory defense, and litigation. He represents clients of all size, from multinational corporate advertisers and agencies to start-up ventures.

Mr. Benjamin's understanding and breadth of knowledge of the broad areas under the umbrella of "advertising law" informs his ability to provide reasoned, experienced judgment and legal/risk analysis, including areas such as claim substantiation, fair use, social media, marketing and trade practices, trademarks, copyright, the First Amendment, the rights of privacy and publicity, licensing, and consumer privacy and data security. Mr. Benjamin also drafts and negotiates contracts ranging from traditional agency-client, co-promotion, talent, endorsement and sponsorship agreements to Internet advertising, content licensing, and copyright and trademark licensing deals. He advises on the structure of and reviews advertising and marketing campaigns, and drafts terms and conditions for all forms of advertising and promotion initiatives, including sweepstakes, contests, social media, online and app gaming, direct mail, telemarketing, and charitable marketing programs.

His practice includes advising in the areas where traditional and digital media converge, where new distribution platforms and data gathering tools push the boundaries of technology, privacy, copyright, and content. This includes areas such as the development of data collection and interest based advertising policies, privacy policies, website terms of use, data collection, data security, and breach notification policies. He also drafts and negotiates technology contracts such as web site content and development agreements, affiliate agreements, and software licensing deals.

As an experienced litigator, Mr. Benjamin handles false advertising and trademark claims under the Lanham Act, trade dress violations, copyright claims, misappropriation, and fraud claims.

Mr. Benjamin also has extensive experience representing advertisers and marketers in regulatory investigations before government agencies, in competitor challenges through the self-regulatory process, and in dealing with consumer complaints and class actions.

Mr. Benjamin is a frequent public speaker on advertising, marketing, privacy, and emerging media issues, and has written articles in many different publications. He was recognized as a New York "Super Lawyer" in the area of First Amendment/Media /Advertising Law by *SuperLawyers* magazine and was listed in *The Best Lawyers in America*® for Advertising Law.

Experience Highlights

Advertising agreement for advertising agency *
Represented advertising agency in negotiations with international mobile phone carrier.

Trademark litigation for Internet auction website *
Represented Internet auction website in defense of claims for fraudulent sales of branded merchandise by brand advertisers.

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Social media policies for an international financial services company
Developed social media and privacy policies for international financial holding company and its banking and non-banking subsidiaries.

Promotional contract negotiations for JA Apparel Corp.
Drafted the "Welcome Home Joe" licensing and promotional contract among our client JA Apparel Corp. and with Iraq and Afghanistan Veterans of America (IAVA), and JCPenney. This promotion provides Iraq and Afghanistan veterans with $1 million in certificates to purchase professional attire as they transition to the civilian workforce. Representation of JA Apparel Corp. in this contract also included providing clearing advertising copy, negotiating terms and conditions for the promotion, and advising on trademark clearance issues.

Successful defense of Computer Fraud and Abuse Act, Stored Communications Act, and trade secrets claims
Defended online database services provider against CFAA, SCA and trade secrets claims in the EDNY, obtaining successful settlement.

NASCAR sponsorship negotiation for drug manufacturer *
Represented over the counter drug manufacturer in negotiation of NASCAR sponsorship agreement.

Copyright infringement and theft of trade secrets for corporate education and training company *
Represented corporate education and training company asserting theft of trade secrets and copyright infringement claims for copying website against former employee.

Raffles and casino night compliance with state regulations *
Advised medical device manufacturer on state regulations around corporate fund raising efforts, including raffles and a casino night.

Event marketing promotion advice for client *
Advised agency on appropriate processes and procedures for event marketing promotion.

Right of Publicity/Copyright/Parody advice for Source Marketing Group *
Advised Source Marketing Group on intellectual property issues related to proposed advertising campaign using parodies of current and old movie and television show titles and actors' names.

Copyright infringement defense for media publisher *
Represented media publisher defending claims of copyright infringement and hot news misappropriation.

Advertising claims against Suncore Products LLC
Successfully represented Suncore Products LLC ("Suncore") against an investigation by the National Advertising Division of the Council of Better Business Bureau ("NAD") seeking substantiation for Suncore's explicit nutritional content claims for its WhoNu? Cookies and inquiring whether Suncore's advertising included an unsubstantiated implied overall equivalency claim concerning the benchmark foods used to illustrate the nutritional content of WhoNu? Cookies. The NAD issued a ten-page decision finding that Suncore's advertising was, without qualification, fully substantiated and did not contain any unsubstantiated implied claims.

Copyright infringement for Gerson & Gerson Inc. *
Successfully represented Gerson & Gerson, Inc., a children’s clothing designer, in a copyright infringement case relating to the defendant making knockoffs of its toddler dress designs. The firm negotiated a favorable monetary settlement for the client and obtained a final judgment on consent with permanent injunction.

Generated content contest aligned with Super Bowl for well-known job search and career management Internet site *
Advised well-known job search and career management Internet site on all sweepstakes, contest, and copyright/user generated content law aspects of "Department of Fandemonium" Super Bowl advertising campaign.

Right of publicity litigation for footwear maker *
Represented footwear maker in defense of right of privacy/publicity claims by models whose images were used on packaging.

Negotiation of on-air talent clothing outfitting for apparel designer *
Represented men's apparel designer in negotiation of Olympics on-air talent clothing outfitting agreement.

Compliance work for international apparel brand owner *
Represented international apparel brand owner in charitable commercial co-venture, coordinating compliance with state law registration and filing obligations.

Acquisition of ownership interest in social media website for individual *
Represented individual shareholder's withdrawal and buy out of ownership interest in Internet social media website.

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Privacy and personal data transfer issues for international cruise line *
Advised international cruise line on privacy and cross-border consumer personal data transfer issues.

Unfair and deceptive trade practice defense for Internet marketer *
Defended Internet marketer and Web hosting company from fraudulent advertising practices and unfair and deceptive trade practice allegations by state attorney general.

Litigation for international franchise fitness center
Represented an international fitness center against false advertising allegations that a television commercial wrongfully utilized the trademarks of competitor.

Compliance with state gambling laws for network broadcaster *
Advised television network broadcaster on state gambling laws in connection with proposed televised charity poker tournament.

Privacy issues related to internet social media providers *
Represented in an advisory capacity an Internet network advertising agency specializing in social media, specifically advised company on privacy issues including their privacy policy.

Survey for AT&T AdWorks
Prepared for media platform a 50 states survey on the laws and regulations governing the acceptance of political advertisements, from candidates, PACs, and Super PACs.

Development of e-mail marketing policy for corporate printing company *
Represented corporate printing company in development of e-mail marketing policy and Can-Spam compliance.

False advertising litigation for vitamin manufacturer
Represented a nutritional supplement and pre-natal vitamin manufacturer against a manufacturer of generic supplements of false advertising and related claims, based on use by defendant of client's patented and trademarked compound on labels and marketing materials. Case pending.

Advisory counsel for national retail food company *
Advised national quick service retail food company on engaging in user generated content and social media marketing efforts.

Defended treated wood manufacturer against false advertising claims
Represented treated wood product manufacturer against false advertising claims by a competitor based on allegations of superiority, passing off, and false qualifications for meeting standards set by model code.

Negotiation of software license for national real estate property owner *
Advised national real estate property owner and manager on negotiating software license for residential property management.

State gambling law compliance for web site operator *
Represented web site operator in advisory capacity regarding compliance with state lottery and gambling laws concerning internet sales of lottery and gambling devices.

Compliance with state telemarketing laws *
Advised financial institution on compliance with 50 state telemarketing laws.

Litigation for home improvement & hardware retail company
Represented an international specialty tool manufacturer of false advertising and related claims against former blade supplier and new purchaser of blade supplier's products, based on former blade supplier's falsely taking credit for awards and honors earned by client's products. Case pending.

*Experience gained by attorney prior to joining Kilpatrick Townsend

Publications, Articles and Speaking Engagements

A Brand Owner's Guide to Social Media
Kilpatrick Townsend & Stockton LLP, May 01, 2013

Diamonds Are Forever — Are False Advertising Claims?
Law360, February 01, 2013

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Mobile application developers: a target of regulators
E-Commerce Law & Policy, Vol. 15, Issue 1, January 01, 2013

How to Navigate the Tangled Social Media Legal Web
2012 Blue National Summit, September 12, 2012

ADVERTISING LAW: Keeping it Legal — The Law of Claim Substantiation, Clearing Trademark and Copyrights, Social Media Endorsements
2012 Blue National Summit, September 11, 2012

The New, Nongovernmental Face of Food Regulators
Law 360, August 17, 2012

Facebook Resolves User Right of Publicity Claims Concerning Sponsored Stories
Cyberspace Lawyer, August 01, 2012

Challenging Competitors' Comparative Advertising
Stafford Live Phone/Web Seminar, January 12, 2012

Sweepstakes, Promotions & Marketing Laws: Comprehension & Compliance
New York City Bar Center for CLE, February 11, 2011

The Latest Litigation Front: Behavioral Advertising
Law 360, February 10, 2011

Developing Clear Policies for Compliant Use of Mobile Marketing
National Advanced Forum on Advertising Law, January 24, 2011

Challenging Competitors Comparative Advertising
Webinar, January 11, 2011

Advertising and the Environment: The New FTC Green Guides
New York State Bar Association IP Section Bright Ideas, January 01, 2011

Anatomy of the 2010 Integrated Marketing Ad Agency Agreement: A Play for Advanced Studies with Three Main Characters
Promotion Marketing Association Law Conference, November 18, 2010

Social Media Game Plan: IP and Marketing Law Playbook
Association of Corporate Counsel Docket, September 01, 2010

New York City Bar Association Presentation: Hot Topics in Online Behavioral Advertising
New York City Bar Association , June 21, 2010

'Not On My Watch' -- De Niro and Pacino Settle Right of Publicity and False Advertising Claims Against Watch Maker and Film Distributor
Entertainment Law Review, June 02, 2010

Becoming Social: Issues in Creating Networking Sites
New York Law Journal, March 11, 2010

Marketing to Kids In the Online Age
New York Law Journal, January 14, 2010

Immediate Engagement: the New New Things
Promotion Marketing Association Law Conference, November 05, 2009

IP Innovations Class: Is Your News 'Hot': The Hot News Exception, Copyright Law, and Protecting Content in the Digital Age (Speaker)
Teleconference, July 16, 2009

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Virtual Worlds Social Networks User Generated Content
International Trademark Association, February 09, 2009

Information Security and Data Privacy Law
Law Seminars International New Technologies and New Media in Advertising Law, January 30, 2009

Understanding and Complying with Sweepstakes and Promotions Drafting Official Rules and Preparing for the Worst
New York City Bar Association, December 12, 2008

The Message Is the Medium: Consumer Marketing in the Age of Ubiguity
PMA Promotion Marketing Law Conference, November 20, 2008

Marketing and Advertising Law Update
2008 Gaming Law Conference, November 07, 2008

Sweepstakes Contents Promotions Marketing to Children
American Conference Institute, October 20, 2008

Current Issues in Trademark and Copyright Licensing Transactions
Law Seminars International, September 11, 2008

Protecting Against Pranksters When Running User-Generated Contests
Online Media Daily, June 18, 2008

Regulatory Summit for Advertisers and Marketers
American Conference Institute, June 17, 2008

Regulatory Kid Watch Ensuring Privacy and Safety When Manufacturing and Marketing Products
American Conference Institute, April 01, 2008

Negotiating Promotion Contracts Key Issues in Negotiating Promotion Contracts
19th Annual Promotion Marketing Law Conference, November 15, 2007

Sweepstakes Contests and Promotions
American Conference Institute's Conference, October 10, 2007

Our Trademark Copyright and ECommerce Related Licensing Transactions
Law Seminars International, June 22, 2007

A Blurry Distinction: Commercial vs. Non-Commercial Speech
The Connecticut Law Tribune, June 02, 2007

Colliding Worlds in Copyright
Mediaweek, April 20, 2007

Email Marketing and CAN-SPAM: Practical Consideration
Subscription Marketing, January 01, 2007

Better Discloser-How to Make Product Integration More Transparent for Viewers
Mediaweek, December 19, 2006

Case Study of the Issues Facing Entertainment, Media and Advertising Industries in Setting Up Promotional Blogs
Law Seminars International Blog Law Conference: Legal issues, Liabilities and New Opportunities, November 16, 2006

The Intellectual Property Think Tank: A Case Study About Good Ideas and Their Consequences
New York State Bar Association, IP Law Section, October 12, 2006

Hot Topics In Advertising and Marketing Law 2006: The Law of Sweepstakes and Contests
New York City Bar Association, September 27, 2006

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Information Security - More than Just Consumer Notification, and Already Here
The Metropolitan Corporate Counsel, September 01, 2006

Consumer Promotion Law Essentials You Need to Know
The Incentive Show, May 04, 2006

Direct Marketing Laws
Advertising Law and Business Affairs Conference, January 26, 2006

A Fine Line Between Placement and Payola
BRANDWEEK, January 01, 2006

Advertising Disclaimers: Disclaimers in Small Print Must Be Clear and Conspicuous
New Jersey Lawyer, August 15, 2005

Internet Advertising Law Essentials You Need to Know
Marketing Expo & Executive Conference, June 14, 2005

Trademark Copyright and E-Commerce Licensing Transactions
"Complex Intellectual Property Licensing" Conference, May 19, 2005

Reality Check From Promotion Apprentice to Master of the Game
The 26th Annual PMA Law Conference, December 03, 2004

Regulatory Enforcement Actions Serve as Warnings
Subscription Marketing, July 01, 2004

Direct Marketing Law: The New Essentials You Need To Know
New York Conference & Expo, May 25, 2004

Understanding and Complying with Sweepstakes and Promotions Law
The Association of the Bar of the City of New York, March 29, 2004

The Legal Side of Internet Marketing: Comply, Survive and Thrive
The DMA/AIM Net.marketing Conference, February 25, 2004

Marketing to Children
Metropolitan Corporate Counsel, December 01, 2003

Plan Ahead to Limit Potential Disasters
Marketing News, November 01, 2003

The Tangled DM Legal Web - How to Weave Your Way Out
The Incentive Show, May 01, 2003

Consumer Promotions Law: Essentials You Need to Know
The Incentive Show, April 07, 2003

The Legal Side of Promotional Premiums: Know Your Rights and Avoid Disasters
The Incentive Show, April 07, 2003

Understanding and Complying with Sweepstakes and Promotions Law
The Association of the Bar of the City of New York, March 31, 2003

Hot Topics In Advertising Law
The Association of the Bar of the City of New York, October 30, 2002

Consumer Promotions Law: Essentials You Need to Know
The Motivation Show, September 01, 2002

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Professional & Community Activities

New York City Bar Association, Information Technology Committee

New York City Bar Association, Consumer Affairs Committee, Former Member

Promotion Marketing Association, Government and Legal Affairs Committee

Education

Fordham University School of Law, J.D. (1993)

University of Michigan, B.A. (1990)

Bar Admissions

New York (1994)

New Jersey (1993)

Admissions

U.S. District Court for the District of New Jersey (1994)

U.S. District Court for the Eastern District of New York (1994)

U.S. District Court for the Northern District of New York (1994)

U.S. District Court for the Southern District of New York (1994)

U.S. District Court for the Western District of New York (2005)

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