INDEX

Abuse Decree (1962) 8.23, 8.25
acquisitions see mergers and acquisitions (M&As)
ADR see alternative dispute resolution (ADR)
Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS)
see TRIPS (Agreement on Trade-Related Aspects of Intellectual Property Rights)
agreements
asset purchase 7.39
coexistence 5.03, 15.03
and consent agreements 11.11, 11.22, 11.23, 11.24
definitions 11.11, 17.09
consent see consent agreements, trademarks
delimitation 11.23
distribution 11.05
domain name transactions, agreements on use
general principles 4.26–4.29
situations of joint use 4.30
licensing see licensing agreements, trademarks
prior-rights 11.23
purchase (Germany) 16.33–16.35
trademark portfolio splitting transactions 5.39–5.56
trade-mark delimitation and allocation 5.42–5.45
alternative dispute resolution (ADR) 13.01
see also trademark dispute resolution mechanisms
methods for solving trademark disputes 13.02–13.26
mediation 13.03–13.05
UDRP 13.06–13.11
American Law Institute (ALI) Principles
choice-of-court clauses 12.10, 12.14, 12.16, 12.24
choice-of-law clauses 12.36
animation characters and commercial value 3.02, 3.17, 3.19
copyright-expired characters, adopting 3.19, 3.21, 3.22, 3.23
temporary examples
Buster Brown 3.22, 3.23
Mickey Mouse/Steamboat Willie 3.02, 3.10–3.15, 3.17
Superman 3.26–3.29
Yellow Kid 3.19, 3.21, 3.22
reversion of copyright in a trademarked character 3.26–3.29
trade-mark and copyright, whether inseparable 3.10–3.15
anti-abuse rules, double tax treaties 8.22–8.26
antitrust law
German trademark agreements
coeexistence agreements 16.51–16.52
license agreements 16.40–16.45
intellectual property and trademarks 6.24, 6.26
tying arrangements 6.72
United States 6.11
INDEX

Apple Corps (UK), action against Apple Inc. (US) 10.01, 10.02
Apple trademark 7.46, 10.01
applicable law
coexistence agreements, Germany 16.53–16.57
trademark portfolio splitting transactions 5.05–5.08
arbitration of international intellectual property disputes 13.27–13.68
arbitration clauses
and choice-of-court clauses 12.07
covering contractual and non-contractual claims 13.35–13.46
intellectual property carve-out clauses 13.47–13.60
scope 13.34–13.60
clauses covering contractual and non-contractual claims 13.35–13.46
conditions and features 13.29–13.60
consent of parties to submit to arbitration 13.34–13.60
decisions erga omnes 13.33
emergency arbitrators 13.68
governing law 13.61–13.65
intellectual property carve-out clauses 13.47–13.60
New York Convention 13.58
objective arbitrability of intellectual property disputes 13.30–13.33
provisional measures 13.66–13.68
arm’s length price, related party transactions 8.47–8.53
arm’s length principle, related party transactions 8.43–8.46
ASEAN (Association of Southeast Asian Nations)
assignment of registered trademarks 22.12–22.26
application for registration 22.21
formalities 22.22
with or without goodwill/business 22.14–22.20
unregistered trademarks 22.23–22.26
in writing 22.22
licensing of registered trademarks 22.27–22.56
registration of transactions
Brunei 22.68
Cambodia 22.65–22.66
Indonesia 22.73
Laos 22.72
Malaysia 22.69–22.71
Myanmar (Burma) 22.67
Philippines 22.64
Singapore 22.58–22.59
Thailand 22.62–22.63
Vietnam 22.60–22.61
trademarks as property in 22.05–22.11
Asia, trademark transactions in see ASEAN (Association of Southeast Asian Nations); Brunei; Cambodia; China, trademark transactions in; India; Indonesia; Japan, trademark transactions in; Laos; Malaysia; Myanmar (Burma); Philippines; Singapore; Thailand; Vietnam
Assembly of the Paris Union 2.08, 2.31, 2.39
assets
asset purchase agreements containing trademarks 7.39
intangible 7.01, 7.02, 8.68
sale of, and trademark use within acquired division (Chair v. Tropodyne) 10.21–10.23, 10.32, 10.73
restricted to field of use and geographical territory (Seattle Brewing & Malting Co v. Commission) 10.24–10.32, 10.76
substance of and capital gains/royalties distinction 8.28
trademark license as 17.52–17.53
assignment of licenses, United Kingdom 15.77–15.80
assignment of trademarks
in ASEAN
application for registration 22.21
formalities 22.22
with or without goodwill/business 22.14–22.20
unregistered trademarks 22.12–22.26
registered trademarks 22.12–22.26

588
Irene Calboli and Jacques de Werra - 9781783472123
Downloaded from Elgar Online at 11/30/2018 01:42:10PM via free access
INDEX

unregistered trademarks 22.23–22.26
in writing 22.22
in Brazil 19.46–19.62
in China
  concept and formalities 20.26–20.33
  procedures and regulations 20.34–20.36
confirmatory assignments, in United Kingdom 15.37–15.39
and consent agreements 11.03, 11.06
defined 11.03
equitable, in United Kingdom requirements 15.35–15.36
and trusts 15.32–15.34
in France 17.08–17.12
free assignability as international standard 5.10–5.11
in gross 18.10, 18.12, 18.19, 18.20
in India 23.55–23.70
assignment of certification and associated trademarks at discretion of Registrar 23.70
and assignment of goodwill 23.59
assignment of unregistered trademark 23.69
by licensee 23.31
registration of assignee of a registered trademark 23.63–23.68
restrictions on assignment 23.60–23.61
resulting in splitting of trademark on territorial basis 23.62
in Japan
  general principles 21.53–21.55
  non-assignability of regional collective trademarks 21.61–21.62
  trademarks representing collective goodwill of multiple suppliers 21.58–21.60
  trademarks simultaneously representing the goodwill of diversified suppliers 21.56–21.57
language 15.21
and license-back 18.39–18.41
partial 5.12–5.22
actual, under Swiss law 5.19, 5.20
effect 5.14–5.15
license grant compared 5.31–5.38
limitations 5.16–5.18
overview 5.12–5.13
restrictions on 5.36
Swiss law, technicalities under 5.19–5.22
in United Kingdom 15.16–15.18
regional collective trademarks, non-assignability (Japan) 21.61–21.62
restrictions on, in India 23.60–23.61
resulting in splitting of trademark on territorial basis, in India 23.62
right to sue prior infringers, in United Kingdom 15.24
strategic, in United States 18.39–18.41
taxation 8.27–8.37
capital gains, tax treatment 8.33–8.35
double tax treaties, impact in international context 8.36–8.37
royalties/capital gains distinction 8.27–8.32
trademark rights in different fields of use (concurrent use) 10.79–10.94
co-existence separately 10.91–10.93
doctrine of concurrent use 10.80–10.90
imperfect co-existence (with license untouched) 10.94
and TRIPS Agreement (Article 21) 2.13
in United Kingdom 15.11–15.39
assignment of right to sue prior infringers 15.24
confirmatory assignments 15.37–15.39
consideration 15.23
identification of IPRs being assigned 15.22
language 15.21
part assignment 15.16–15.18
registration 15.30–15.31
requirements for equitable assignment 15.35–15.36
title, implied covenants as to 15.25–15.29
trusts and equitable assignments 15.32–15.34
unregistered trademarks 15.19
valid assignment requirements 15.20

Irene Calboli and Jacques de Werra - 9781783472123
Downloaded from Elgar Online at 11/30/2018 01:42:10PM via free access
INDEX

in United States (current rule) 18.06–18.20
origin of rule 18.12–18.15
rationale for rule 18.10–18.11
shifting towards assignment ‘in gross’ 18.19–18.20
validity 15.20
Association of Southeast Asian Nations see ASEAN (Association of Southeast Asian Nations)
auctions, private 4.07
Australia
Personal Property Securities Register (PPS Register) 9.01, 9.15, 9.18, 9.24
PPSA (Personal Property Securities Act, Cth), 2009
introduction of 9.01
PPSA systems and trademarks 9.14–9.31
pre-PPSA position 9.03–9.07
reforms 9.08–9.13
reforms
options 9.32–9.37
PPSA (Personal Property Securities Act, Cth), 2009 9.08–9.13
Register of Company Charges 9.06, 9.07, 9.36
Registrar of Trade Marks 9.04, 9.05, 9.23, 9.24, 9.27, 9.28
registration of security interests over trademarks in new PPS Register 9.10, 9.11
PPSA reforms 9.08–9.13
PPSA systems and trademarks 9.14–9.31
pre-PPSA position 9.03–9.07
reform options 9.32–9.37
Securities and Investments Commission 9.04
Trade Marks Act 1995 (Cth), (TMA) 9.03, 9.05, 9.06, 9.19, 9.24, 9.28, 9.29
Trade Marks Office 9.23, 9.25, 9.33, 9.36
Trade Marks Office Manual of Practice and Procedure 9.34, 9.35
Trade Marks Register advantages of registration 9.01
discretion to record security interests in 9.04
ongoing role of recording claims in 9.23–9.24
PPSA reforms 9.12
pre-PPSA position 9.04, 9.07
reform options 9.33, 9.34
trademarks and PPSA systems 9.14–9.31
imperfect information and transition costs 9.16–9.22
problems caused when title in property passes to secured party 9.25–9.31
Trade Marks Register, ongoing role of recording claims in 9.23–9.24
authorship works and Dastar Corp case copyright-expired characters, adopting 3.06
works distinguished from trademark goodwill 3.07–3.10
auxiliary tax status, intellectual property companies 8.70–8.75
bankruptcy and trademark licenses, law intersecting in United States concurrent use (assignment of trademark rights in different fields of use) 10.79–10.94
co-existence separately 10.91–10.93
doctrine of concurrent use 10.80–10.90
imperfect co-existence (with license untouched) 10.94
corporate transactions, trademarks in (case law) 10.18–10.67
Exide Technologies decision (corporate division sale of assets and trademark use) 10.09, 10.33–10.67, 10.71, 10.79, 10.93, 10.94
sale of assets and trademark use restricted to field of use/geographical territory (Seattle Brewing & Malting Co. v Commission) 10.24–10.32, 10.76

590
Irene Calboli and Jacques de Werra - 9781783472123
Downloaded from Elgar Online at 11/30/2018 01:42:10PM via free access
sale of assets and trademark use within acquired division (*Chain v. Tropodyne*) 10.21–10.23, 10.32, 10.73
ending of uncertainties 10.68–10.94
concurrent use (assignment of trademark rights in different fields of use) 10.79–10.94
looking beyond the form/facing the substance 10.68–10.74
sales, vs. licenses 10.75–10.78
hypothetical case 10.05–10.07
uncertainties 10.02, 10.03
adding 10.57–10.67
cauising 10.44–10.67
ending 10.68–10.94
*Exide Technologies* decision 10.44–10.67
*Interstate Bakeries* decision 10.58, 10.67
*Lakewood* decision 10.61–10.67
Belgium, licence box regime 8.76
BEPS (*Base Erosion and Profit Shifting*) report and Action Plan (2013), OECD 8.02, 8.05–8.09, 8.84
Action Plan reports 8.07, 8.08
member country preferential schemes 8.07
transparency goals 8.07, 8.09
brands
asset purchase agreements containing trademarks 7.39
brand management principles 7.06–7.08
brand strength score (BSS) 7.07
distressed vs. going concern (brand-only vs. business enterprise with brand) scenarios 7.23–7.36
distressed business enterprise (liquidation/brand only) 7.24, 7.25–7.30
going concern business enterprise 7.31, 7.32–7.36
dual nature of competition, over branded goods 6.23
historical transactions involving 7.22–7.39
asset purchase agreements containing trademarks 7.39
distressed vs. going concern scenarios 7.23–7.36
underlying circumstances 7.38
valuation of brands transacted 7.37–7.38
Income Approach to valuing 7.09, 7.10–7.19
Excess Earnings methodology 7.18–7.19
Relief from Royalty methodology 7.13–7.17, 7.45
industry, importance of 7.41–7.44
key transactions
distressed enterprise 7.25–7.30
going concern business enterprise 7.32–7.36
Market Approach to valuing 7.09, 7.20–7.21
most valuable 7.46
public goods 6.22
Purchase Price Allocation 7.40, 7.41, 7.44
rebranding 5.61
switching 6.60
SWOT analysis of brand positioning 7.06
trademarks and products 6.07
valuation of additional methods 7.45
common approaches 7.09–7.21
Comparative Transaction method 7.20, 7.21
Income Approach 7.10–7.19
Market Approach 7.20–7.21
strategic vs. financial target 7.37
transacted brands 7.37–7.38
Brazil
assignment of application and/or registration 19.46–19.62
Consulate 19.19, 19.21, 19.34
Federal Constitution 19.08
franchising and trademarks in 19.22–19.34
legal nature of trademarks 19.06–19.12
licensing 19.13–19.21
master licenses 19.14
non-exclusive licenses 19.14
INDEX

sole licenses 19.14
Theory of Property Rights, Civil Code 19.08
trademark as collateral and security interest 19.35–19.45
Brunei
assignment of trademarks 22.15, 22.21, 22.22, 22.25
governing law on trademarks 22.10
licensing of registered trademarks 22.48–22.49
registration of trademark transactions 22.68
Trade Mark Act 22.68
trademarks as property in 22.08, 22.10
Cambodia
assignment of trademarks 22.22
licensing of registered trademarks 22.46
registration of trademark transactions 22.65–22.66
and trademarks as property 22.11
capacity, transfers of domain names transactions 4.20–4.21
capital gains
royalties/capital gains distinction 8.27–8.32
tax treatment 8.33–8.35
cash flow streams, brand valuation 7.11, 7.12
characters
see also copyright
cartoon 3.02, 3.17, 3.19
copyright-expired characters, adopting 3.21, 3.22, 3.23
reversion of copyright in a trademarked character 3.26–3.29
trademark and copyright, whether inseparable 3.10–3.15
copyright-expired 3.06, 3.19–3.24
derivative works 3.39
exploiting when trademark claimant not copyright owner 3.19–3.29
keeping out of copyright public domain, impact on trademarks 3.16–3.18
legally-privileged copying 3.35
merchandising of and trademark licensing, in India 23.46–23.47
reversion of copyright in a trademarked character 3.25–3.29
trademark symbols as 3.03
visual, overlapping of copyright and trademarks 3.01, 3.39
China
access to WTO 20.08, 20.67
Anti-Unfair Competition Law 20.25
application for registration 20.13–20.15
examination of 20.16–20.19
assignment of trademarks
concept and formalities 20.26–20.33
procedures and regulations 20.34–20.36
Classification of Goods and Services 20.15
Contract Law of PRC 20.48
distinctiveness of trademark 20.17
establishment of rights 20.12–20.25
evolution of trademark law 20.03–20.11
founding of PRC (1949) 20.05
General Principles of the Civil Law 20.51
goodwill, ownership 20.50
Guaranty Law of the PRC 20.54, 20.55, 20.60, 20.65
licensing of trademarks 20.37–20.52
exclusive licenses 20.40
legal responsibilities following termination of a trademark license contract 20.51–20.52
maintenance of trademark rights 20.48–20.49
non-exclusive licenses 20.40
obligations of owners and licensees 20.42–20.49
sole licenses 20.40
supervision of quality of marked goods 20.43–20.47
types of licenses 20.40–20.41
National People's Congress, Standing Committee 20.06
and Paris Convention 20.21, 20.31
pledge of trademarks
definition and legal basis 20.53–20.59
effects of pledge contract of rights
20.65–20.66
procedural requirements 20.60–20.64
Product Quality Law of PRC 20.44
Property Law of the PRC 20.54, 20.55,
20.60, 20.65
Qing government 20.04
registered trademarks 20.13–20.19
signs, detrimental to public order, social
morals or customs 20.18
Trademark Law of PRC
assignment of trademarks 20.30, 20.34
establishment of rights 20.12, 20.15,
20.18, 20.19, 20.20, 20.21, 20.22,
20.24
evolution of trademark law 20.06,
20.07, 20.08, 20.09, 20.10, 20.11
trademark licensing 20.39, 20.43, 20.45,
20.52
Trademark Office of State Administration
for Industry and Commerce 20.33,
20.39, 20.47, 20.62
establishment of rights 20.13, 20.15,
20.16, 20.19
and TRIPS Agreement 20.08, 20.31
unregistered trademarks 20.20–20.25
choice-of-court clauses 12.01, 12.04–12.30
and arbitration clauses 12.07
country court chosen 12.05
exclusivity considerations 12.06
foreseeability, assuring 12.09
Hague Convention 12.10, 12.13, 12.16,
12.19, 12.21, 12.24, 12.28
how country court chosen 12.05
legal certainty, assuring 12.09
legal issues 12.09–12.28
issues difficult and easy to harmonize
12.28
limitation 12.20–12.24
special treatment of international
trademark licensing agreements
12.26–12.27
validity 12.13–12.19
practice 12.05–12.08
choice-of-law clauses 12.01, 12.31–12.40
legal issues 12.34–12.40
practice 12.32–12.33
scope 12.39–12.40
validity 12.35–12.38
civil law systems
see also common law systems
and common law systems, in TRIPS
Agreement 1.03–1.07
ex ante approach in role of government
1.12
function of trademarks 1.19
and geographical indications 1.06
CLIP (European Max-Planck Group on
Conflict of Laws in Intellectual
Property)
Principles for Conflict of Laws in
Intellectual Property
choice-of-court clauses 12.10, 12.13,
12.16, 12.19, 12.21
choice-of-law clauses 12.37, 12.38,
12.40
and validity 12.36
coexistence
and absence of likelihood of confusion
11.31
agreements 5.03, 15.03, 17.09
and consent agreements 11.11, 11.22,
11.23, 11.24
in Germany 16.50, 16.51–16.52,
16.53–16.57
and concurrent use 10.94
imperfect, with license untouched 10.94
sales and not licences 10.91–10.93
trademark portfolio splitting transactions
5.03, 5.51
commercial value, licensing
characters, exploiting when trademark
claimant not copyright owner
adopting copyright-expired characters
3.19–3.24
reversion of copyright in a trademarked
character 3.25–3.29
overlapping of copyright and trademarks
3.01, 3.39
trademark owner no longer a copyright
owner
INDEX

characters, keeping out of copyright public domain 3.16–3.18

*Dastar Corp* (US) case and trademark licensing 3.05–3.18
trademark and copyright, whether inseparable 3.11–3.15
trademark goodwill distinguished from authorship works 3.07–3.10
trademarks as copyrighted works 3.30–3.38

common law systems

*see also* civil law systems
adaptation of TRIPS Agreement 1.27
and civil law systems, in TRIPS Agreement 1.03–1.07
*ex post* approach in role of government 1.12
function of trademarks 1.19
unregistered trademarks protected at 1.09
Common Regulations under the Madrid Agreement and Protocol
disposal right, restrictions of 2.48, 2.49, 2.50, 2.51, 2.52
licensing of trademarks 2.44, 2.46
and WIPO, normative framework 2.05, 2.09
Community Trade Mark Regulation (CTMR)
*see also* European Union (EU)
and consent agreements 11.09
Draft CTMR 14.11
and German law 16.03, 16.14, 16.29, 16.47, 16.49
overview of harmonized rules 14.04, 14.05, 14.06, 14.09, 14.10, 14.12
relevant Articles 14.01
trademark portfolio splitting transactions 5.08
Community Trade Marks (CTMs) 5.10, 14.01

*see also* European Union (EU)
CTM Register 14.09
and French law 17.36
and German law 16.14, 16.15, 16.18
overview of harmonized rules 14.03, 14.04, 14.05, 14.06, 14.08, 14.09

Comparable Transaction method, brand valuation 7.20, 7.21
comparative advertising 6.62
competition
arenas outside a market 6.29
as basis for institutional and social change 6.33
concepts, models and trademark law 6.38–6.70
trade secrets 6.56, 6.57, 6.58
*see also* exit, voice and loyalty framework
dual nature of, over branded goods 6.23
EU law 11.37, 11.38, 15.92
forms 6.41
and GATT Panels 1.67
images 6.15
and innovation 6.06
intellectual property and competition law 6.39, 6.40
intellectual property and trademarks 6.15–6.37
analysis of Lemley and McKenna 6.23–6.27, 6.36, 6.37
antitrust law 6.24, 6.26
market definition 6.25–6.28
public goods 6.16, 6.18, 6.19, 6.22
monopolies 6.05, 6.09, 11.38
non-price *see* non-price competition norms 6.30
perfect competition 6.32
and product differentiation 6.42
and trademark law 6.11, 6.12, 6.13
TRIPS Agreement and trademark transactions 1.62–1.69
unfair competition
complete harmonization 14.48–14.51
function theory 14.48, 14.52–14.56
national 14.43–14.58
Paris Convention 1.16
United Kingdom law 15.91–15.92
Competition and Markets Authority (CMA), United Kingdom 15.91
concurrent use (assignment of trademark rights in different fields of use) 10.79–10.94

594
Irene Calboli and Jacques de Werra - 9781783472123
Downloaded from Elgar Online at 11/30/2018 01:42:10PM via free access
INDEX

see also bankruptcy and trademark licenses, law intersecting in United States 10.91–10.93
docctrine of concurrent use 10.80–10.90
imperfect co-existence (with license untouched) 10.94
confirmatory assignments, United Kingdom 15.37–15.39
conflict of laws rules, Germany 16.54, 16.56
conflict resolution 5.56
consent agreements, trademarks and assignment of trademarks 11.03, 11.06
circumstances in which may arise 11.13–11.19
confusion, likelihood of 11.31–11.34
and cross-license agreements 11.07
definitions 11.11, 11.26
and Israel Trademarks Ordinance 11.10
legal foundation 11.02–11.12
and licensing 11.04–11.05, 11.06
provisions 11.20, 11.21, 11.22
public and private considerations 11.35–11.41
and TRIPS Agreement 11.08
types 11.20–11.24
undertakings in, impact on the parties 11.25–11.30
consideration, assignment (United Kingdom) 15.23
consumer sovereignty 6.08
contract law
arbitration claims 13.35–13.46
China
legal responsibilities following termination of a trademark license contract 20.51–20.52
maintenance of trademark rights 20.48
pledge contract of rights, effects 20.65–20.66
contractual rights, vs. ownership 5.31–5.32
executory contracts 10.43
France
assignment 17.08–17.12
contractual freedom in 17.06–17.31
general principles of contract law 17.07–17.22
licensing of trademarks 17.13–17.22
and national laws 17.03
specific dispositions 17.23–17.31
trademark portfolio splitting transactions 5.31–5.32
and UDRP 13.10
copyright
authorship works, distinguished from trademark goodwill 3.07–3.10
in cartoon characters 3.02, 3.17, 3.19
copyright-expired characters, adopting 3.21, 3.22, 3.23
reversion of copyright in a trademarked character 3.26–3.29
trademark and copyright, whether inseparable 3.10–3.15
characters, exploiting when trademark claimant not copyright owner adopting copyright-expired characters 3.19–3.24
reversion of copyright in a trademarked character 3.25–3.29
copyright-expired characters, adopting 3.19–3.24
fair use doctrine 3.35, 6.63
infringement of 3.32, 3.36
owner of trademark owner becoming 3.30–3.38
trademark owner no longer a copyright owner 3.07–3.18
reversion of, in a trademarked character 3.25–3.29
as right 'in gross' 3.01, 3.32, 3.34
trademark owner no longer a copyright owner characters, keeping out of copyright public domain 3.16–3.18
trademark and copyright, whether inseparable 3.11–3.15
trademark goodwill distinguished from authorship works 3.07–3.18
and trademarks 3.30–3.38, 6.63
whether inseparable 3.11–3.15
corporate transactions, trademarks in 10.18–10.32

595
Irene Calboli and Jacques de Werra - 9781783472123
Downloaded from Elgar Online at 11/30/2018 01:42:10PM via free access
INDEX

*Exide Technologies* decision (corporate division sale of assets and trademark use) 10.09, 10.33–10.67, 10.71, 10.93, 10.94
causing uncertainties 10.44–10.56
details of case 10.34–10.43, 10.59, 10.67, 10.79
procedures 10.18–10.19
sale of assets and trademark use
within acquired division (*Chain v. Tropodyne*) 10.21–10.23, 10.32, 10.73
restricted to field of use and geographical territory (*Seattle Brewing & Malting Co v. Commission*) 10.24–10.32, 10.76
Court of Cassation, France 17.10, 17.44
Court of Justice of the European Union (CJEU) 14.02, 14.06, 14.16, 14.17, 14.59–14.62
*see also* European Union (EU) and French law 17.01, 17.15
and German law 16.16, 16.17
unfair competition 14.47, 14.48, 14.52, 14.55
covenants not to sue 6.75
cross-license agreements 11.07
CTMR *see* Community Trade Mark Regulation (CTMR)
CTMs *see* Community Trade Marks (CTMs)
damages, infringement of trademarks 3.37, 3.38
deception 3.34
delimitation agreements 11.23
developing countries, failures of market-driven policies in 6.69
dilution notion
‘blurring’ 3.23, 3.37
overlapping of copyright and trademarks 3.01
trademarks as copyrighted works 3.36, 3.37
in United States 1.11
Diplomatic Conference, Singapore (2006) 2.24
disposal of registration of marks, restrictions on right of 2.47–2.52
dispute resolution mechanisms *see* trademark dispute resolution mechanisms
distinguishing function of trademarks 1.20, 1.23, 1.50
distressed business enterprise
(liquidity/brand only scenario) 7.23, 7.24
*see also* brands
key transactions
Borders 7.28
Circuit City 7.29
Hostess Brands 7.25
Linens ‘n Things 7.30
Polaroid 7.26
Sharper Image 7.27
distribution agreements 11.05
distribution networks, selective (EU law)
exhaustion of rights, impact on 14.19–14.22
licensee, rights against 14.29–14.36
more nuanced approach, adopting 14.40–14.42
open questions 14.23–14.28
outside traders, rights against 14.37–14.39
product quality concept, expansion 14.17–14.18
domain name transactions
economic life of domain name following registration 4.04
geographical restrictions 4.15
holders or users of name 4.18–4.30
agreements on use, case of 4.26–4.30
eligibility 4.19
transfer, case of 4.26–4.30
license of domain name 4.32
location of use of name 4.14–4.17
management 4.03
nature of 4.31–4.32
resales 4.01
sale of domain name 4.08, 4.31
second level domain 4.13
secondary markets 4.01, 4.33
specification of object for the transaction 4.06–4.13
third level domain 4.10–4.12
top level domain
blocking of 4.16
country code (ccTLDs) 4.09, 4.22, 4.23, 13.12
generic (tTLDs) 13.06
lease of 4.09
private auctions 4.07
sale of 4.08
and second level domain 4.13
UDRP (Uniform Domain Name Dispute Resolution Policy) 13.06–13.11
as model for other ADR systems for trademark-related domain name disputes 13.12–13.26
WordPress platform 4.02
domestic restructuring, related party transactions 8.54–8.56
double tax treaties, impact in international context
anti-abuse rules 8.22–8.26
assignment 8.36–8.37
licensing 8.18–8.26
enforcement of trademarks 1.54–1.61, 1.69
equitable assignments, United Kingdom requirements 15.35–15.36
and trusts 15.32–15.34
EU law see European Union (EU)
European Max-Planck Group on Conflict of Laws in Intellectual Property see CLIP (European Max-Planck Group on Conflict of Laws in Intellectual Property)
European Union (EU)
see also specific European countries
acquis (best practice) 13.22
competition law 11.37, 11.38, 15.92
and consent agreements 11.09
Court of Justice of the European Union (CJEU) see Court of Justice of the European Union (CJEU)
geographical indications, protection 1.07
and German law 16.09, 16.11–16.18
harmonization 17.02
complete 14.48–14.51
overview of harmonized rules 14.03–14.13
see also Office for Harmonization in the Internal Market (OHIM)
national doctrines, no pre-emption of 14.57–14.58
overview of harmonized rules 14.03–14.13
Community Trade Mark Regulation 14.03–14.09
reform plans 14.11–14.13
Trade Mark Directive 14.10
Savings Agreement with 8.20, 8.21
selective distribution networks
exhaustion of rights, impact on 14.19–14.22
licensee, rights against 14.29–14.36
more nuanced approach, adopting 14.40–14.42
open questions 14.23–14.28
outside traders, rights against 14.37–14.39
product quality concept, expansion 14.17–14.18
unfair competition law, national complete harmonization 14.48–14.51
function theory 14.48, 14.52–14.56
Excess Earnings methodology, Income Approach (brand valuation) 7.18–7.19
exclusivity considerations
choice-of-court clauses 12.06
exclusive jurisdiction 12.20–12.21
license grants, United Kingdom 15.50–15.51
scope of exclusive right 6.10
trademark and copyright, whether inseparable 3.15
trademark portfolio splitting transactions 5.24, 5.27
executory contracts 10.43
exhaustion of rights, EU 14.19–14.22
Exide Technologies decision (corporate
division sale of assets and trademark
use) see bankruptcy and trademark
licenses, law intersecting in United
States; sale of assets and trademark use
exit, voice and loyalty framework
(Hirschman) 6.39, 6.43, 6.45, 6.59
see also competition
comparative advertising and voice 6.62
competition, intellectual property and
trademarks 6.33, 6.34, 6.35, 6.36
concept of exit 6.46, 6.47, 6.50
concept of loyalty 6.36, 6.51, 6.52, 6.53,
6.60, 6.64, 6.73, 6.74
concept of voice 6.48, 6.49, 6.50, 6.61,
6.62, 6.65
and covenants not to sue 6.75
criticisms 6.68
developed and developing countries 6.69,
6.70
non-price competition 6.43, 6.53, 6.56,
6.60, 6.65
shifts in emphasis 6.57, 6.58
and trade secrets 6.56
and trademark law/transactions 6.59, 6.75,
6.76
expenses, tax treatment 8.38–8.40
fair use doctrine, copyright 3.35, 6.63
fair value, intangible assets 7.01
fonds de commerce see France, trademark as
element of the fonds de commerce
France
Civil Code 17.12, 17.13, 17.18, 17.20,
17.35
contractual freedom 17.06–17.31
assignment 17.08–17.12
general principles of contract law
17.07–17.22
licensing 17.13–17.22
specific dispositions 17.23–17.31
Council of State (Conseil d’Etat) 17.52,
17.53
Court of Cassation 17.10, 17.44
domain name transactions 4.11
intuitus personae (personal obligations)
17.18
Monetary and Financial Code 17.40
National Industrial Property Institute
(INPI) 17.25, 17.28, 17.30, 17.31,
17.35
tax considerations
apport partiel d’actifs (tax qualification)
17.54, 17.55
influence on a merger and acquisition
qualification 17.54–17.56
qualification of a trademark license as
an asset 17.52–17.53
trademark operations for free
17.49–17.51
trademark as element of the fonds de
commerce 17.04, 17.32–17.45, 17.57
trademarks and securities 17.33–17.41
transfers of trademarks 17.42–17.45
warranties, licence agreement 17.17
franchising, in Brazil 19.22–19.34
Brazilian Franchise Law 19.25
Business Format Franchising 19.24
Franchise Agreement 19.32, 19.33
Franchise Disclosure Document (FDD)
19.31, 19.32
function theory, unfair competition 14.48,
14.57–14.58
General Agreement on Tariffs and Trade
(GATT) Panels 1.67
Generally Accepted Accounting Principles
(GAAP), US 7.40
geographical indications 1.06, 1.07, 1.52
Germany
Civil Code (BGB) 16.05, 16.06, 16.07,
16.22, 16.34, 16.47
coeexistence agreements
antitrust law, restrictions imposed by
16.51–16.52
applicable law 16.53–16.57
in general 16.50
Commercial Law Code 16.04
contact of laws rules 16.54, 16.56
existing rules
and EU law 16.09, 16.11–16.18
legal framework, overview 16.02–16.10
MarkenG (German Trademark Act),
sections 27–31 16.19–16.25
legal framework 16.03
license agreements 16.36–16.49
antitrust law, restrictions imposed by
16.40–16.45
in general 16.36–16.39
infringement of trademarks
16.47–16.48
and insolvency proceedings 16.46
registration of license 16.49
MarkenG (German Trademark Act)
legal framework 16.03
license agreements 16.36, 16.37, 16.38
securities, trademarks as 16.61, 16.63
sections 27–31 16.19–16.25
mergers and acquisitions 16.58–16.60
Patent and Trademark Office 16.49
practical considerations 16.33–16.63
purchase agreements 16.33–16.35
registered trademarks, company symbols
and titles of works 16.26–16.32
representations and warranties 16.59
and Rome I Regulation 16.54, 16.57
securities, trademarks as 16.61–16.63
Stock Corporation Act 16.04
territoriality principle and trademark law
16.11
Trademark Register 16.62
and TTBER (Technology Transfer Block
Exemption Regulation) 16.41, 16.43,
16.44
 going concern business enterprise 7.23, 7.31
see also brands
key transactions
American Airlines merger with US
Airways 7.33
Jarden Corporation, acquisition of
Yankee Candle Company 7.32
Liberty Global acquisition of Virgin
Media 7.34
Swatch Group acquisition of HW
Holdings Inc 7.36
T-Mobile acquisition of MetroPCS
7.35
goods and services
see also public goods
branded goods, dual nature of competition
over 6.23
detachment of mark from particular goods
or services 3.33
partial assignment vs. license grant
5.33–5.34
private or public 6.16, 6.17, 6.18, 6.22
products and trademarks 6.07
supervision of quality of marked goods,
China 20.43–20.47
goodwill, trademark
assignment of
in India 23.59
in United Kingdom 15.12
in United States 18.06–18.15
collective, of multiple suppliers (Japan)
21.58–21.60
distinguishing from authorship works
3.07–3.10
in India 23.37, 23.59
intangible 18.15
in Japan 21.56–21.60
overlapping of copyright and trademarks
3.01
ownership, in China 20.50
registered trademarks, assignment in
ASEAN 22.14–22.20
rights over, in India 23.37
trademark portfolio splitting transactions
5.11
trademarks simultaneously representing
the goodwill of diversified suppliers
(Japan) 21.56–21.57
and TRIPS Agreement 1.60, 1.61
in United Kingdom 15.12
governing law
arbitration of international intellectual
property disputes 13.61–13.65
in Brunei 22.10
licensing agreements, Japan 21.38
trademark portfolio splitting transaction
agreements 5.56
ICANN see Internet Corporation for
Assigned Names and Numbers
(ICANN)
illegality, tying arrangements 6.73

599

Irene Calboli and Jacques de Werra - 9781783472123
Downloaded from Elgar Online at 11/30/2018 01:42:10PM
via free access
INDEX

impleaded, right to be (in India) 23.26, 23.35
Income Approach, brand valuation 7.09, 7.10–7.19
Excess Earnings methodology 7.18–7.19
Relief from Royalty methodology 7.13–7.17, 7.45
indemnities, UK licensing 15.62–15.64
India
assignment of trademarks 23.55–23.70
and assignment of goodwill 23.59
of certification and associated trademarks at discretion of Registrar 23.70
by licensee 23.31
registration of assignee of a registered trademark 23.63–23.68
restrictions on 23.60–23.61
resulting in splitting of trademark on territorial basis 23.62
of unregistered trademarks 23.69
impleaded, right to be 23.26, 23.35
licensing of trademarks
assignment and sublicensing by licensee 23.31
Basic Agreement 23.15
breach of license and consequences 23.51–23.54
character merchandising and trademark licensing 23.46–23.47
conditions for and extent of use of mark by licensee 23.13–23.17
by licensee 23.31
licensing and hybridization of trademarks 23.48
obligation to furnish information to the Registrar 23.28
procedure for registration, variation and cancellation of registration 23.18–23.22
proprietorship over the mark 23.38
quality control over use of licensed mark 23.40–23.42
right over goodwill generated 23.37
right to be impleaded 23.35
right to be notified in case of new license or cancellation 23.36
right to challenge the mark 23.39
right to initiate infringement proceedings 23.32–23.34
right to keep licensing details secret 23.27
rights and obligations of licensee 23.29–23.39
rights and obligations of licensor 23.23–23.28
scope of trademark licensing 23.05–23.10
Technology Transfer Agreement 23.15
term and territorial scope of license 23.11–23.12
Trade Mark Act (1999), under 23.04–23.48
trafficking under Trade and Merchandise Marks Act 1958 23.43–23.45
unregistered trademarks 23.49–23.50
use of mark under accompanying legend 23.30
Registrar of Trade Marks 23.11, 23.13, 23.17, 23.19, 23.20, 23.27, 23.28, 23.61, 23.62, 23.63, 23.70
regulation of trademark transactions 23.02
rights and obligations of licensor 23.23–23.28
liability for acts of licensee 23.25
right to sue infringers/right to be impleaded 23.26
royalties, tax treatment 23.71–23.72
and TRIPS Agreement 23.05
WTO membership 23.05
Indonesia
assignment of trademarks 22.15, 22.22
General Register of Marks 22.55, 22.56, 22.73
licensing of registered trademarks 22.55–22.56
registration of trademark transactions 22.73
industry
importance of 7.41–7.44
industrial applicability, patentability criteria 1.05

600
Irene Calboli and Jacques de Werra - 9781783472123
Downloaded from Elgar Online at 11/30/2018 01:42:10PM via free access
INDEX

infringement of trademarks 3.32
and copyright 3.32
Germany 16.47–16.48
India 23.26, 23.32–23.34
remedies 3.36, 3.37, 3.38
right to initiate infringement proceedings 23.32–23.34
United Kingdom assignment of right to sue prior infringers 15.24
rights of licensees to bring infringement proceedings 15.65–15.70
injunctions, trademark infringement 3.36
innovation and competition law 6.06
insolvency proceedings see also bankruptcy and trademark licenses, law intersecting in United States
brand valuation 7.24–7.30
and license agreements, in Germany 16.46
intangible assets 7.01, 7.02, 8.68
intellectual property (IP) see also competition; copyright; patents; trademark transactions; trademarks carve-out clauses 13.47–13.60
and competition law 6.39, 6.40, 6.55
objective arbitrability of intellectual property disputes 13.30–13.33
and trademarks 6.15–6.37
analysis of Lemley and McKenna 6.23–6.27, 6.36, 6.37
antitrust law 6.24, 6.26
market definition 6.25–6.28
public goods 6.16, 6.18, 6.19, 6.22
trademark law 6.01, 6.02
Intellectual Property Office, Myanmar (Burma) 22.47
Intellectual Property Office, United Kingdom 13.04, 15.31, 15.90
intellectual property rights (IPRs), assignment 15.22
intent-to-use (ITU) trademark applications, United States 18.07
International Bar Association Guidelines for Drafting International Arbitration Clauses 13.57
International Centre for Dispute Resolution (ICDR) 13.53
International Law Association (ILA) 12.10, 12.29
International Trademark Association (INTA) 11.11, 11.26
international trademark transactions see also trademark transactions
choice-of-court clauses 12.01, 12.04–12.30
and arbitration clauses 12.07
exclusivity considerations 12.06
how country court chosen 12.05
legal issues 12.09–12.28
practice 12.05–12.08
choice-of-law clauses 12.01, 12.31–12.40
legal issues 12.34–12.40
practice 12.32–12.33
scope 12.39–12.40
validity 12.35–12.38
legal issues choice-of-court clauses 12.09–12.28
choice-of-law clauses 12.34–12.40
issues difficult and easy to harmonize 12.28
limitation 12.20–12.24
special treatment of international trademark licensing agreements 12.26–12.27
validity 12.13–12.19
limitation exclusive jurisdiction 12.20–12.21
public policy 12.24
weak party 12.22–12.23
validity capacity 12.18–12.19
choice-of-court clauses 12.13–12.28
choice-of-law clauses 12.35–12.38
formal 12.13–12.14, 12.37
substantive 12.15–12.17
Internet Corporation for Assigned Names and Numbers (ICANN)
see also alternative dispute resolution (ADR); domain name transactions; trademark dispute resolution
Application Guidelines 4.07
location of use of domain name 4.16
and Top Level Domains 4.07, 4.08
and UDRP 13.06, 13.10, 13.14
inventive step, patentability criteria 1.05
IP see intellectual property (IP)
IPRs see intellectual property rights (IPRs), assignment

Japan
assignment of trademarks
general principles 21.53–21.55
non-assignability of regional collective trademarks 21.61–21.62
trademarks representing collective goodwill of multiple suppliers 21.58–21.60
trademarks simultaneously representing the goodwill of diversified suppliers 21.56–21.62
choice-of-court clauses 12.10
Civil Code 21.09, 21.12, 21.32
concept of trademark under Japanese law changes in legal definition of trademarks 21.07–21.10
laws to consider when negotiating trademark transactions 21.11
scope of 'trademarks' in context of trademark transactions 21.03–21.04, 21.07
Trademark Act 21.05–21.06
licenses
Anti-Monopoly Act, application 21.51–21.52
definitions 21.12
governing laws of licensing agreements 21.38
licensing agreements for marks not registered under the Trademark Act 21.29–21.37
non-exclusive right to use 21.17–21.23
proprietary right to use 21.24–21.28
‘right to use’ trademarks provided under Trademark Act 21.13–21.16
royalties, Japanese taxes imposed on 21.39–21.47
termination of licensing agreements 21.48–21.50
right to use trademarks
non-exclusive 21.17–21.23
proprietary 21.24–21.28
Trademark Act 21.13–21.16, 21.18
security interests 21.63–21.66
Trademark Act
Amendment of 2014 21.37
concept of trademark 21.05–21.06
marks not registered under, licensing agreements 21.29–21.37
‘right to use’ trademarks 21.13–21.16, 21.18
and TRIPS Agreement 21.10
Joint Recommendation Concerning Trademark Licenses (2000)
function of trademarks 1.31
and Singapore Treaty 2.30–2.43
as soft law instrument 2.08
and WIPO, normative framework 2.08
joint registration, domain names transactions 4.25
joint ventures 5.60
jurisdictions
exclusive, choice-of-court clauses 12.20–12.21
licensing of trademarks 11.04
trademark portfolio splitting transaction agreements 5.56
ktMINE database service 7.16, 7.17, 7.39
Laos
licensing of registered trademarks 22.53–22.54
registration of trademark transactions 22.72
leases, domain name transactions 4.09
lex contractus principle 12.40
lex loci protectionis principle 5.06, 12.37, 12.39, 12.40
licence box regime, taxation 8.76–8.86
INDEX

licensee estoppel 6.65
licensing agreements, trademarks
and consent agreements 11.06
cross-license agreements 11.07
defined 8.12
in Germany 16.36–16.49
agreements and insolvency proceedings
16.46
antitrust law, restrictions imposed by
16.40–16.45
in general 16.36–16.39
infringements of trademarks
16.47–16.48
registration 16.49
international, special treatment
12.26–12.27
in Japan
governing laws 21.38
marks not registered under the
Trademark Act 21.29–21.37
termination of agreements 21.48–21.50
oral 10.13
in writing 10.13
licensing of trademarks 5.23–5.30
agreements see licensing agreements,
trademarks
in ASEAN 22.27–22.56
Brunei 22.48–22.49
Cambodia 22.46
Indonesia 22.55–22.56
Laos 22.53–22.54
Malaysia 22.50–22.52
Myanmar (Burma) 22.47
Philippines 22.45
Singapore 22.30–22.34
Thailand 22.38–22.44
Vietnam 22.35–22.37
asset, trademark license as 17.52–17.53
assignment of licenses, United Kingdom
15.77–15.80
and bankruptcy see bankruptcy and
trademark licenses, law intersecting in
United States
in Brazil 19.13–19.21
breach of license and consequences, India
23.51–23.54
character merchandising and trademark
licensing, India 23.46–23.47
in China 20.37–20.52
exclusive licenses 20.40
legal responsibilities following
termination of a trademark license
contract 20.51–20.52
maintenance of trademark rights
20.48–20.49
non-exclusive licenses 20.40
obligations of owners and licensees
20.42–20.49
sole licenses 20.40
supervision of quality of marked goods
20.43–20.47
types of licenses 20.40–20.41
commercial value, licensing see
commercial value, licensing
compulsory, under TRIPS Agreement
1.49–1.53
conditions for and extent of use of mark
by licensee
in India 23.13–23.17
conditions on transfers and licenses, and
enforcement of marks 1.54–1.61,
1.69
and consent agreements 11.04–11.05,
11.06
and copyright licensing 3.01
definitions 21.12
domain name transactions 4.32
flexibility of license grants 5.36
in France 17.13–17.22
in Germany see licensing agreements,
trademarks
governing laws 21.38
in India
assignment and sublicensing by licensee
23.31
Basic Agreement 23.15
breach of license and consequences
23.51–23.54
character merchandising and trademark
licensing 23.46–23.47
conditions for and extent of use of mark
by licensee 23.13–23.17
hybridization 23.48

Irene Calboli and Jacques de Werra - 9781783472123
Downloaded from Elgar Online at 11/30/2018 01:42:10PM
via free access
licensing and hybridization of trademarks 23.48
obligation to furnish information to the Registrar 23.28
procedure for registration, variation and cancellation of registration 23.18–23.22
proprietorship over the mark 23.38
quality control over use of licensed mark 23.40–23.42
right over goodwill generated 23.37
right to be impleaded 23.35
right to be notified in case of new license or cancellation 23.36
right to challenge the mark 23.39
right to initiate infringement proceedings 23.32–23.34
right to keep licensing details secret 23.27
rights and obligations of licensee 23.29–23.39
rights and obligations of licensor 23.23–23.28
scope of trademark licensing 23.05–23.10
Technology Transfer Agreement 23.15
term and territorial scope of license 23.11–23.12
under Trade Mark Act (1999) 23.04–23.48
trafficking under Trade and Merchandise Marks Act 1958 23.43–23.45
unregistered trademarks 23.49–23.50
use of mark under accompanying legend 23.30
in Japan
Anti-Monopoly Act, application 21.51–21.52
definitions 21.12
governing laws of licensing agreements 21.38
licensing agreements for marks not registered under the Trademark Act 21.29–21.37
non-exclusive right to use 21.17–21.23
proprietary right to use 21.24–21.28
right to use trademarks 21.13–21.28
royalties, Japanese taxes imposed on termination of licensing agreements 21.48–21.50
Joint Recommendation Concerning Trademark Licenses 1.31, 2.08, 2.30–2.43
license grant compared to partial assignment
affected goods and services 5.33–5.34
flexibility of license grants vs. restrictions on partial assignments 5.36
license to register new trademarks 5.37–5.38
ownership v. contractual rights 5.31–5.32
post-transactional arrangement, duration 5.35
licensee estoppel 6.49, 6.65, 18.37
and loyalty 6.35
Madrid System 2.44–2.46
'naked licenses' 1.22
obligation to furnish information to the Registrar in India 23.28
ordinary licenses 10.12–10.17
quality control in India 23.40–23.42
licenses without 1.22
purpose 10.13
in United Kingdom 15.54–15.61
recordal of licenses under Article 19.2 of TRIPS 1.02, 1.29–1.34, 1.54, 2.41
right to be notified in case of new license or cancellation, in India 23.36
right to keep secret, in India 23.27
right to use, in Japan non-exclusive 21.17–21.23
proprietary 21.24–21.28
Trademark Act 21.13–21.16
rights against licensee 14.29–14.36
rights and obligations of licensee, in India 23.29–23.39
INDEX

rights of licensees to bring infringement proceedings 15.65–15.70
sales vs. licenses 10.75–10.78
scope, in India 23.05–23.10
Singapore Treaty 2.30–2.43
sublicensing, United Kingdom 15.52–15.53
Swiss law, technicalities under 5.28–5.30
term and territorial scope of license, in India 23.11–23.12
termination of licensing agreement, in Japan 21.48–21.50
trademark portfolio splitting transactions
license grant compared to partial assignment 5.31–5.38
limitations 5.26–5.27
overview 5.23–5.25
trademark transactions between third parties 8.12–8.26
double tax treaties, impact in international context 8.18–8.26
royalties, tax treatment 8.14–8.17
tying arrangements 6.73
United Kingdom 15.40–15.85
assignment of licenses 15.77–15.80
Contracts (Rights of Third Parties) Act (COTPA), 1999 15.81–15.82
formalities 15.44–15.46
grant and exclusivity 15.50–15.51
key terms 15.47–15.49
liabilities and indemnity 15.62–15.64
nature of a license 15.42–15.43
quality control 15.54–15.61
registration 15.83–15.84
rights of licensees to bring infringement proceedings 15.65–15.70
sublicensing 15.52–15.53
term and termination 15.72–15.76
unregistered trademarks 15.85
warranties 15.71
in United States (current rule) 18.21–18.37
origin of rule 18.29–18.31
rationale for rule 18.27–18.28
unregistered trademarks in India 23.49–23.50
in United Kingdom 15.85
use of mark under accompanying legend, in India 23.30
limitation, international trademark transactions 12.20–12.24
exclusive jurisdiction 12.20–12.21
public policy 12.24
weak party 12.22–12.23
Lisbon Agreement on the Protection of Appellations of Origins 1.06
Lisbon Conference (International Patent and Trademark Conference), 1958 1.30
Lisbon Revision Conference (1958) 1.30, 2.10
loyalty see exit, voice and loyalty framework (Hirschman)
Luxembourg, licence box regime 8.76, 8.77, 8.81
Madrid Agreement Concerning the International Registration of Marks (1891)
ownership, change in 2.25
trademark portfolio splitting transactions 5.08
and WIPO, normative framework 2.05, 2.09
Madrid Protocol (Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks), 1989
ownership, change in 2.25
trademark portfolio splitting transactions 5.08
and WIPO, normative framework 2.09
Madrid System Concerning the International Registration of Marks licenses 2.44–2.46
and Madrid Protocol 2.09
ownership, change in 2.25–2.29
rules 2.56
Malaysia
assignment of trademarks 22.15, 22.18, 22.22, 22.26
licensing of registered trademarks 22.50–22.52

605
Irene Calboli and Jacques de Werra - 9781783472123
Downloaded from Elgar Online at 11/30/2018 01:42:10PM via free access
INDEX

registered users 22.51, 22.52
registration of trademark transactions 22.69–22.71
Trademark Act 22.70
and trademarks as property 22.11
Market Approach, brand valuation 7.09, 7.20–7.21
markets
developing countries, failures of market-driven policies in 6.69
market definition 6.25–6.28
models 6.42
public goods 6.19, 6.20
structure 6.31
Max-Planck-Institute, Germany 16.17
mediation 13.03–13.05
mergers and acquisitions (M&As) 5.01
see also brands
bankruptcy filings 7.24
distressed business enterprise
(liquidation/brand only scenario) 7.23, 7.24
key transactions 7.25–7.30
France 17.54–17.56
Germany 16.58–16.60
going concern business enterprise 7.23, 7.31
key transactions 7.32–7.36
ownership, change in 2.18
sale of assets and trademark use within acquired division 10.21–10.23
trademark portfolio splitting transactions 5.01, 5.40, 5.55
transfers of trademarks and brand valuation 7.22–7.39
monopolies
competition 6.05, 6.09, 11.38
and property 6.09
trademarks as 6.03, 6.05, 6.09
Myanmar (Burma)
Intellectual Property Office 22.47
licensing of registered trademarks 22.47
registration of trademark transactions 22.67
naked licensing (licensing without quality control) 1.22
National Industrial Property Institute (INPI), France 17.25, 17.28, 17.30, 17.31, 17.35
National People's Congress, Standing Committee (PRC)
Trademark Law of PRC 20.06, 20.07
Netherlands, the 8.76, 8.77
new trademarks, license to register 5.37–5.38
non-obviousness, TRIPS Agreement 1.05
non-price competition 6.09
concepts, models and trademark law 6.42, 6.54, 6.55, 6.66
exit, voice and loyalty framework (Hirschman) 6.43, 6.53, 6.56, 6.60, 6.65
and intellectual property 6.55, 6.67
invention/innovation 6.54
Stigler on 6.32, 6.33
numerus clausus doctrine 17.10
OECD (Organization for Economic Cooperation and Development)
BEPS report and Action Plan (2013) 8.02, 8.05–8.09, 8.84
Commentary 8.61
Model Tax Convention 8.04, 8.18, 8.19, 8.21, 8.29, 8.44, 8.61
Transfer Pricing Guidelines for Multinational Enterprises and Tax Administrations 8.07, 8.42
Office for Harmonization in the Internal Market (OHIM) 13.03, 14.01, 14.05
see also European Union (EU)
open questions, selective distribution networks 14.23–14.28
Organization for Economic Cooperation and Development (OECD) see OECD (Organization for Economic Cooperation and Development)
ownership of trademarks see also assignment of trademarks; transfers of trademarks
changes in 'blacklisting' of documents or information 2.16, 2.20
'capping' of inventory of allowed requirements 2.16, 2.20

606
Irene Calboli and Jacques de Werra - 9781783472123
Downloaded from Elgar Online at 11/30/2018 01:42:10PM via free access
INDEX

dependence of international registration 2.10

documentary evidence 2.16, 2.18, 2.19, 2.22

under Madrid System 2.25–2.29
mergers 2.18
notarization or certification of legal documents 2.23
under Paris Convention 2.10–2.13
under Trademark Law Treaty and Singapore Treaty 2.14–2.24
and TRIPS Agreement 2.13
vs. contractual rights 5.31–5.32
goodwill, China 20.50
intellectual property owner as price-setter 6.41

international tax strategies 8.64–8.68
obligations of Chinese owners 20.42–20.49
maintenance of trademark rights 20.48–20.49
supervision of quality of marked goods 20.43–20.47
shared 5.57–5.59
six-month priority period for trademark owners (Paris Convention) 1.15
trademark owner becoming a copyright owner 3.30–3.38
trademark owner no longer a copyright owner
trademark goodwill distinguished from authorship works 3.07–3.10
trademarks and copyright 3.11–3.15
and UDRP 13.19

Paris Convention for the Protection of Industrial Property of 1883, as revised and amended
and China 20.21, 20.31
and European Union 14.05
ownership, change in 2.10–2.13
and Paris Union 2.10, 2.11, 2.12
registrability of trademarks 1.25
six-month priority period for trademark owners 1.15
and TRIPS Agreement 1.14–1.16, 1.25, 1.26, 1.40, 1.59, 1.61, 2.06

unfair competition, protection against 1.16
and WIPO 2.06
Paris Union
Assembly 2.08, 2.31, 2.39
and Paris Convention 2.10, 2.11, 2.12
partial assignment
actual, under Swiss law 5.19, 5.20
effect 5.14–5.15
license grant compared (portfolio splitting transactions)
affected goods and services 5.33–5.34
flexibility of license grants vs.
restrictions on partial assignments 5.36
license to register new trademarks 5.37–5.38
ownership v. contractual rights 5.31–5.32
post-transactional arrangement,
duration 5.35
limitations 5.16–5.18
Swiss law focus, technicalities under 5.19–5.22
trademark portfolio splitting transactions 5.12–5.22, 5.14–5.15
limitations 5.16–5.18
overview 5.12–5.13
restrictions on partial assignment 5.36
in United Kingdom 15.16–15.18
passing off tort
reverse passing off, in United States 3.05
and TRIPS Agreement 1.09, 1.10, 1.27
in United Kingdom 15.08, 15.19, 15.85
patents
and loyalty 6.64, 6.65
and trademarks 6.63
and TRIPS Agreement 1.05
People’s Republic of China (PRC) see China
perfect competition 6.32
Personal Property Securities Register (PPS Register), Australia 9.01, 9.15, 9.18, 9.24
Philippines
assignment of trademarks 22.15, 22.19, 22.21, 22.22
licensing of registered trademarks 22.45
INDEX

registration of trademark transactions 22.64
and trademarks as property 22.11
portfolio splitting transactions, trademarks
see trademark portfolio splitting transactions
PRC (People’s Republic of China) see China
pre-right (coexistence) agreements see coexistence
price discrimination 6.20
prior-rights agreements 11.23
private goods
see also public goods
allocation 6.17
definitions 6.16
markets 6.21
Private International Law Association of Japan and Korea
Joint Proposal (Principles of Private International Law on Intellectual Property Rights)
choice-of-court clauses 12.10, 12.13, 12.21
choice-of-law clauses 12.36
product quality concept, expansion 14.17–14.18
property
see also intellectual property (IP); intellectual property rights (IPRs)
labelling of 6.10
legal definition of property rights 6.18
rights ‘in gross’ 3.34
title in passing to secured party in Australia 9.25–9.31
trademarks as 15.07, 22.05–22.11
competition law 6.03, 6.05, 6.09
public goods
see also goods and services
as brands 6.22
categorisation as 6.16
markets 6.19, 6.20
problem of 6.18
third party effects 6.17
purchase agreements, Germany 16.33–16.35
Purchase Price Allocation (PPA) 7.40, 7.41, 7.44
quality control, licensing
India 23.40–23.42
licenses without 1.22
purpose 10.13
United Kingdom 15.54–15.61
rebranding 5.61
Register of Company Charges, Australia
9.06, 9.07, 9.36
Registrar of Trade Marks, Australia 9.04, 9.05, 9.23, 9.24, 9.27, 9.28
Registrar of Trade Marks, India 23.11, 23.13, 23.17, 23.19, 23.20, 23.27, 23.28, 23.61, 23.62, 23.63, 23.70
Registrar of Trade Marks, Thailand 22.40
registration of trademarks and licenses
see also Madrid System Concerning the International Registration of Marks; Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (1989); unregistered trademarks
ASEAN countries, application for registration 22.21
Brazil, assignment of registration 19.46–19.62
Brunei 22.68
Cambodia 22.65–22.66
China 20.13–20.19
examination of application, in China 20.16–20.19
new trademarks, license to register 5.37–5.38
filing of application for 1.25
France, Droit d’enregistrement 17.44
Germany 16.49
India 23.18–23.22
Indonesia 22.73
joint registration 4.25
Laos 22.72
Malaysia 22.69–22.71
Myanmar (Burma) 22.67
Philippines 22.64
registrability dependent on use 1.25
Singapore 22.58–22.59
Thailand 22.62–22.63

608
Irene Calboli and Jacques de Werra - 9781783472123
Downloaded from Elgar Online at 11/30/2018 01:42:10PM
via free access
United Kingdom 15.30–15.31, 15.83–15.84
Vietnam 22.60–22.61
related parties, trademark transactions between 8.41–8.56
arm's length price 8.47–8.53
arm's length principle 8.43–8.46
domestic restructuring 8.54–8.56
Relief from Royalty methodology, Income Approach (brand valuation) 7.13–7.17, 7.45
residence of companies, international tax strategies 8.59–8.63
royalties failure to pay as breach of license agreement 10.16
licensing 8.13
Relief from Royalty methodology 7.13–7.17, 7.45
royalty base 7.14
royalty rate 7.15, 7.16, 7.17
sale of assets and trademark use within acquired division (Chain v. Tropodyne) 10.21–10.23, 10.32, 10.73
Exide Technologies decision (corporate division sale of assets and trademark use) 10.09, 10.33–10.67, 10.71, 10.93, 10.94
causing uncertainties 10.44–10.56 details of case 10.34–10.43, 10.59, 10.67, 10.79
restricted to field of use and geographical territory (Seattle Brewing & Malting Co v. Commission) 10.24–10.32, 10.76
second level domain 4.13
securities/security interests
Australia, registration of security interests over trademarks
PPSA reforms 9.08–9.13
PPSA systems and trademarks 9.14–9.31
pre-PPSA position 9.03–9.07
reform options 9.32–9.37
in Brazil (trademark as collateral) 19.35–19.45
in France 17.33–17.41
in Germany 16.61–16.63
in Japan 21.63–21.66
in United Kingdom 15.86–15.90
in United States 18.42–18.44
Security and Exchange Commission (SEC) filings, United States 7.15
shared ownership 5.57–5.59
Singapore assignment of trademarks 22.13, 22.14, 22.17, 22.21
licensing of registered trademarks 22.30–22.34
registration of trademark transactions 22.58–22.59
Trade Marks Act 22.06
trademarks as property in 22.08
Singapore Diplomatic Conference (2006), Records 2.24
Singapore Treaty on the Law of Trademarks (STLT), 2006 licenses 2.30–2.43
ownership, change in 2.14–2.24
and Trademark Law Treaty 2.07, 2.14–2.24
trademark portfolio splitting transactions 5.08, 5.10
and WIPO, normative framework 2.05, 2.07
Spain, licence box regime 8.76
Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) 2.01
STLT see Singapore Treaty on the Law of Trademarks (STLT), 2006 sublicensing 15.52–15.53, 23.31
Switzerland arbitration of international intellectual property disputes 13.39–13.41, 13.43
INDEX

Federal Trademark Protection Act (TPA) 5.08, 5.10, 5.28, 5.58
Free Exchange Agreement (1972) with EU 8.73
legal technicalities licensing 5.28–5.30
partial assignment 5.19–5.22
Swiss Institute of Intellectual Property (IIP) 5.22
taxation issues
arm’s length price 8.48
arm’s length principle 8.45
company residence 8.59, 8.60, 8.62
Controlled Foreign Company rules (CFC rules) 8.85
Corporate Tax Reform III 8.74, 8.85
domestic restructuring 8.55
exemptions 8.33
expenses 8.39
licence box regime 8.79
royalties 8.14
tax status 8.69, 8.70
taxation and trademark transactions see also trademark transactions
anti-abuse rules, double tax treaties 8.22–8.26
assignment 8.27–8.37
capital gains, tax treatment 8.33–8.35
double tax treaties, impact in international context 8.36–8.37
royalties/capital gains distinction 8.27–8.32
BEPS report and Action Plan (2013) 8.02, 8.05–8.09, 8.84
capital gains
royalties/capital gains distinction 8.27–8.32
tax treatment 8.33–8.35
double tax treaties, impact in international context 8.18–8.26
assignment 8.36–8.37
expenses 8.38–8.40
in France 17.46–17.56
apport partiel d’actifs (tax qualification) 17.54, 17.55
qualification of a trademark license as an asset 17.52–17.53
tax influence on merger and acquisition qualification 17.54–17.56
trademark operations for free 17.49–17.51
international tax strategies 8.57–8.86
ownership 8.64–8.68
residence of companies 8.59–8.63
tax status 8.69–8.86
licensing 8.12–8.26
double tax treaties, impact in international context 8.18–8.26
royalties, tax treatment 8.14–8.17
Model Tax Convention (OECD) 8.04, 8.18, 8.19, 8.21, 8.29, 8.44, 8.61
related parties, trademark transactions between 8.41–8.56
arm’s length price 8.47–8.53
arm’s length principle 8.43–8.46
domestic restructuring 8.54–8.56
royalties, tax treatment assignment 8.27–8.32
Japan 21.39–21.47
from point of view of beneficiary 8.14–8.15
from point of view of debtor 8.16–8.17
tax status 8.69–8.86
auxiliary status 8.70–8.75
licence box regime 8.76–8.86
third parties, trademark transactions between 8.10–8.40
assignment 8.27–8.37
expenses, tax treatment 8.38–8.40
licensing 8.12–8.26
TD see Trade Marks Directive (TMD)
territoriality principle, German trademark law 16.11
Thailand
assignment of trademarks 22.15, 22.21
licensing of registered trademarks 22.38–22.44
Registrar of Trade Marks 22.40
registration of trademark transactions 22.62–22.63
Trade Mark Act 22.38, 22.62

610
Irene Calboli and Jacques de Werra - 9781783472123
Downloaded from Elgar Online at 11/30/2018 01:42:10PM
via free access
INDEX

Trade Mark Board 22.41, 22.43
and trademarks as property 22.11
Theory of Property Rights, Brazilian Civil
Code 19.08
third level domain 4.10–4.12
third parties
and consent agreements 11.36
third party effects 6.17
trademark transactions between 8.10–8.40
assignment 8.27–8.37
capital gains 8.27–8.35
double tax treaties, impact in
   international context 8.18–8.26,
   8.36–8.37
expenses, tax treatment 8.38–8.40
licensing 8.12–8.26
royalties, tax treatment 8.14–8.17,
   8.27–8.32
title
full title guarantee, United Kingdom
   15.25, 15.26, 15.27
   implied covenants as to (United Kingdom)
   15.25–15.29
limited title guarantee, United Kingdom
   15.25, 15.26, 15.27
   passing to secured party (Australia)
   9.25–9.31
TLDs see Top Level Domains (TLDs)
TMD see Trade Marks Directive (TMD)
Top Level Domains (TLDs)
   blocking of 4.16
country code (ccTLDs) 4.09, 4.22, 4.23,
   13.12
generic (tTLDs) 13.06
   lease of 4.09
private auctions 4.07
sale of 4.08
   and second level domain 4.13
Trade Marks Directive (TMD)
   and consent agreements 11.09
   Draft TMD 14.11, 14.13
   and German law 16.15, 16.20
   and licensing of UK trademarks 15.41
   overview of harmonized rules 14.02, 14.10
   relevant Articles 14.01
   selective distribution networks
trademark portfolio splitting transactions
   5.08
unfair competition 14.47–14.53
Trade Marks Office, Australia 9.23, 9.25,
   9.33, 9.36
Trade Marks Register, Australia
   advantages of registration 9.01
   discretion to record security interests in
   9.04
   ongoing role of recording claims in
   9.23–9.24
   PPSA reforms 9.12
   PPSA systems and trademarks 9.14, 9.15,
   9.17, 9.22–9.31, 9.33
   pre-PPSA position 9.04, 9.07
   reform options 9.33, 9.34
Trade Marks Registry, United Kingdom
   15.01, 15.06, 15.32, 15.37, 15.65
trade secrets 6.30
   concepts, models and trademark law 6.56,
   6.57, 6.58
   and trademarks 6.02, 6.03
trademark dispute resolution mechanisms
   13.02–13.26
   ADR methods for solving trademark
   disputes 13.01, 13.02–13.26
   and EU law 13.03, 13.14, 13.16, 13.19
   EU Policy 13.03, 13.14, 13.21–13.25
   mediation 13.03–13.05
   asymmetrical 13.11
   and EU law 13.64, 13.65
   UDRP (Uniform Domain Name Dispute
   Resolution Policy) 13.06–13.11
   as model for other ADR systems
   13.12–13.26
   World Trade Organization dispute
   settlement system 1.01
   WTO Dispute–Settlement Panel 1.37,
   1.39, 1.42
trademark enforcement 1.54–1.61, 1.69
   trademark law
   and competition law 6.11, 6.12, 6.13
   and concepts/models 6.38–6.70
   exit, voice and loyalty framework
   (Hirschman) 6.59
   and intellectual property 6.01, 6.02
   and policy 6.08

Irene Calboli and Jacques de Werra - 9781783472123
Downloaded from Elgar Online at 11/30/2018 01:42:10PM
via free access
Trademark Law Treaty (TLT), 1994
conditions on transfers and licenses, and enforcement of marks 1.61
ownership, change in 2.14–2.24
and Singapore Treaty 2.07, 2.14–2.24
trademark portfolio splitting transactions 5.08, 5.10
and United States 18.13
Trademark Manual of Examining Procedure (TMEP), US 11.40, 11.41, 18.08
trademark portfolio splitting transactions agreements 5.39–5.56
co-existence, non-compete and mutual support provisions 5.03, 5.51
conflict resolution, governing law and jurisdiction 5.56
duration and termination 5.55
implementation of the allocation 5.46–5.50
maintenance of trademark 5.53–5.54
scope 5.52
trademark delimitation and allocation 5.42–5.45
allocation and delimitation 5.42–5.45
implementation of 5.46–5.50
applicable law 5.05–5.08
assignability free, as international standard 5.10–5.11
partial 5.12–5.22, 5.31–5.35
building blocks 5.03, 5.09–5.38
cross-border trademark portfolio splits 5.06, 5.07
exclusivity considerations 5.24, 5.27
joint ventures 5.60
key issues 5.62
lex loci protectionis principle 5.06
license 5.23–5.30
limitations 5.26–5.27
overview 5.23–5.25
Swiss law focus, technicalities under 5.28–5.30
maintenance of trademark 5.53–5.54
mergers and acquisitions (M&As) 5.01, 5.40, 5.55
partial assignment 5.12–5.22
actual, under Swiss law 5.19, 5.20
effect 5.14–5.15
license grant compared to 5.31–5.38
limitations 5.16–5.18
overview 5.12–5.13
Swiss law, technicalities under 5.19–5.22
rebranding 5.61
shared ownership 5.57–5.59
and Singapore Treaty 5.08, 5.10
and Trademark Law Treaty 5.08, 5.10
and TRIPS Agreement 5.08, 5.10
typical provisions 5.42–5.56
trademark transactions 6.71–6.76
see also assignment, trademark transactions; domain name transactions; licensing of trademarks;
OECD (Organization for Economic Cooperation and Development) and competition 6.63
copyright and patent compared 6.63
corporate 10.18–10.32
Exide Technologies decision (corporate division sale of assets and trademark use) 10.09, 10.33–10.67,
10.71, 10.79, 10.93, 10.94
sale of assets and trademark use restricted to field of use/geographical territory (Seattle Brewing & Malting Co. v Commission) 10.24–10.32, 10.76
sale of assets and trademark use within acquired division (Chain v. Tropodyne) 10.21–10.23, 10.32,
10.73
covenants not to sue 6.75, 6.76
disposal, restrictions on right of 2.47–2.52
domain name transactions see domain name transactions
in EU law see European Union (EU)
in France see France
in Germany see Germany
importance of 2.03
international see international trademark transactions
normative framework of WIPO 2.04–2.09
Joint Recommendation Concerning Trademark Licenses 2.08

Irene Calboli and Jacques de Werra - 9781783472123
Downloaded from Elgar Online at 11/30/2018 01:42:10PM via free access
INDEX

and Madrid Protocol 2.09
Paris Convention 2.06
and Singapore Treaty 2.05, 2.07
ownership, change in 2.10–2.29
‘blacklisting’ of documents or information 2.16, 2.20
‘capping’ of inventory of allowed requirements 2.16, 2.20
dependence of international registration 2.10
documentary evidence 2.16, 2.18, 2.19, 2.22
under Madrid System 2.25–2.29
mergers 2.18
notarization or certification of legal documents 2.23
under Paris Convention 2.10–2.13
under Trademark Law Treaty and Singapore Treaty 2.14–2.24
and TRIPS Agreement 2.13
portfolio splitting transactions see trademark portfolio splitting transactions
related parties, between 8.41–8.56
arm’s length price 8.47–8.53
arm’s length principle 8.43–8.46
domestic restructuring 8.54–8.56
Singapore Treaty and Joint Recommendations 2.30–2.43
taxation strategies see taxation and trademark transactions
third parties, between 8.10–8.40
assignment of transactions 8.27–8.37
double tax treaties, impact in international context 8.18–8.26, 8.36–8.37
expenses, tax treatment 8.38–8.40
licensing 8.12–8.26
royalties, tax treatment 8.14–8.17, 8.27–8.32
transfer of trademarks see transfer of trademarks
transfers in gross 6.74
and TRIPS Agreement (Article 21) 1.02, 1.43–1.69, 2.13
tying arrangements 6.72, 6.73
in United Kingdom see United Kingdom

in United States see United States trademarks
asset purchase agreements containing 7.39
in Australia see Australia
and bankruptcy see bankruptcy and trademark licenses, law intersecting in United States
as copyrighted works 3.30–3.38
definition of signs constituting (TRIPS Agreement) 1.16
detachment from particular goods or services 3.33
foreign, controlling use of 1.33
functions of distinguishing function 1.20, 1.23, 1.50
information transmission 3.33
origin-indicating 1.52
and TRIPS Agreement 1.19, 1.20–1.28, 1.52
trust function 1.23
in gross commercial value, licensing 3.24, 3.30, 3.34

competition 6.71, 6.74
rule against, in United States 18.01, 18.03, 18.10
shifting towards, in United States 18.19–18.20
United States 18.01, 18.03, 18.10, 18.12, 18.19, 18.20
impact on of keeping characters out of copyright public domain 3.16–3.18
infringement see infringement of trademarks
legal nature (Brazil) 19.06–19.12
maintenance 5.53–5.54
in major legal systems, and TRIPS Agreement 1.08–1.13
as monopolies 6.03, 6.05, 6.09
new see new trademarks
and patents 6.63
pledge of, in China
definition and legal basis 20.53–20.59
effects of pledge contract of rights 20.65–20.66
procedural requirements 20.60–20.64
and products 6.07

613
Irene Calboli and Jacques de Werra - 9781783472123
Downloaded from Elgar Online at 11/30/2018 01:42:10PM
via free access
as property 15.07, 22.05–22.11
competition law 6.03, 6.05, 6.09
quality control over use of licensed mark 23.40–23.42
regional collective, non-assignability (Japan) 21.61–21.62
right to challenge, in India 23.39
‘right to use’ in Japan, licensing of non-exclusive 21.17–21.23
proprietary 21.24–21.28
under Trademark Act 21.13–21.16
as securities, in Germany 16.61–16.63
symbols as characters or artistic works 3.03
and trade secrets 6.02, 6.03
transactions see trademark transactions
transfers see transfers of trademarks
use of under accompanying legend, in India 23.30
Trademarks Directive see Trade Marks Directive (TMD)
Transfer Pricing Guidelines for Multinational Enterprises and Tax Administrations, OECD 8.07, 8.42
transfers of trademarks
see also assignment of trademarks;
ownership of trademarks
brand valuation 7.22–7.39
domain names, holders or users 4.19–4.25
capacity 4.20–4.21
contact information 4.24
eligibility 4.19
establishment conditions 4.22–4.23
joint registration 4.25
in France 17.42–17.45
multiple jurisdictions 2.23
transfers in gross 6.74
TRIPS Agreement
conditions on transfers, and enforcement of marks 1.54–1.61
recordal under Article 19.2 1.02, 1.29–1.34, 1.54, 2.41
Transparency Proposal, Transparency of Japanese Law Project 12.10, 12.13, 12.21
TRIPS (Agreement on Trade-Related Aspects of Intellectual property Rights)
adaptation in common law systems 1.27
battle between common and civil law 1.03–1.07
and China 20.08, 20.31
and consent agreements 11.08
consultations 1.67
and dispute resolution 13.61
drafting history of Article 21 1.44–1.48
flexibility of 1.69
foreign trademarks, controlling use of 1.33
and goodwill 1.60, 1.61
and India 23.05
and Japan 21.10
and Lisbon Conference (1958) 1.30
origin of trademark provisions in 1.03–1.16
and Paris Convention 1.14–1.16, 1.25, 1.26, 1.40, 1.59, 1.61, 2.06
and passing off tort 1.09, 1.10, 1.27
patent section 1.05
signature at Marrakesh (1994) 1.04
trademark portfolio splitting transactions 5.08, 5.10
trademark provisions in 1.17–1.42
Article 15 1.02, 1.18–1.19
Article 20 1.36–1.42
function of trademarks 1.19, 1.20–1.28
recordal of transfers and licenses under Article 19.2 1.02, 1.29–1.34, 1.54, 2.41
trademark transactions provisions (Article 21) 1.02, 1.43–1.69
assignment of trademarks 2.13
compulsory licenses of trademarks 1.49–1.53
conditions on transfers and licenses, and enforcement of marks 1.54–1.61, 1.69
drafting history 1.44–1.48
role for competition law 1.62–1.69
and trademarks in major legal systems 1.08–1.13
and United States 18.15
use requirement 1.25, 1.27, 1.28
and Vienna Convention on the Law of Treaties (VCLT) 1.13, 1.64

614
Irene Calboli and Jacques de Werra - 9781783472123
Downloaded from Elgar Online at 11/30/2018 01:42:10PM
via free access
INDEX

trusts and equitable assignments, in United Kingdom 15.32–15.34
trust function of trademarks 1.23
tying arrangements, trademark transactions 6.72, 6.73

UDRP (Uniform Domain Name Dispute Resolution Policy) 13.06–13.11
see also domain name transactions
adoption (1999) 13.06
domain name transactions 4.12
and ICANN 13.06, 13.10, 13.14
as model for other ADR systems for trademark-related domain name disputes 13.12–13.26
undertakings, consent agreements 11.25–11.30
unfair competition
complete harmonization 14.48–14.51
function theory 14.48, 14.52–14.56
national 14.43–14.58
Paris Convention 1.16
Uniform Commercial Code (UCC) 18.42
Uniform Domain Name Dispute Resolution Policy see UDRP (Uniform Domain Name Dispute Resolution Policy)
Uniform Resource Identifier (URL) 4.02

United Kingdom
assignment of trademarks 15.11–15.39
confirmatory assignments 15.37–15.39
consideration 15.23
identification of IPRs being assigned 15.22
language 15.21
part assignment 15.16–15.18
registration 15.30–15.31
requirements for equitable assignment 15.35–15.36
right to sue prior infringers 15.24
title, implied covenants as to 15.25–15.29
trusts and equitable assignments 15.32–15.34
unregistered trademarks 15.19
valid assignment requirements 15.20

Companies House, charges over trademarks registered at 15.90
Competition and Markets Authority 15.91
competition law 15.91–15.92
Intellectual Property Office 13.04, 15.31, 15.90
law and trademarks 15.05–15.10
licence box regime 8.76
licensing of trademarks 15.40–15.85
assignment of licenses 15.77–15.80
Contracts (Rights of Third Parties) Act (COTPA), 1999 15.81–15.82
formalities 15.44–15.46
grant and exclusivity 15.50–15.51
key terms 15.47–15.49
liabilities and indemnity 15.62–15.64
nature of a license 15.42–15.43
quality control 15.54–15.61
registration 15.83–15.84
rights of licensees to bring infringement proceedings 15.65–15.70
sublicensing 15.52–15.53
term and termination 15.72–15.76
unregistered trademarks 15.85
warranties 15.71
passing off tort 15.08, 15.19, 15.85
reasonable notice, termination of trademark licence arrangement on 15.73
security interests 15.86–15.90
Trade Marks Registry 15.01, 15.06, 15.16, 15.32, 15.37, 15.65

United States
see also American Law Institute (ALI)
antitrust law 6.11
assignment, current rule (‘with goodwill’) 18.06–18.15
origin of rule 18.12–18.15
rationale for rule 18.10–18.11
shifting towards assignment ‘in gross’ 18.19–18.20
unregistered trademarks 15.19
valid assignment requirements 15.20

Companies House, charges over trademarks registered at 15.90
Competition and Markets Authority 15.91
competition law 15.91–15.92
Intellectual Property Office 13.04, 15.31, 15.90
law and trademarks 15.05–15.10
licence box regime 8.76
licensing of trademarks 15.40–15.85
assignment of licenses 15.77–15.80
Contracts (Rights of Third Parties) Act (COTPA), 1999 15.81–15.82
formalities 15.44–15.46
grant and exclusivity 15.50–15.51
key terms 15.47–15.49
liabilities and indemnity 15.62–15.64
nature of a license 15.42–15.43
quality control 15.54–15.61
registration 15.83–15.84
rights of licensees to bring infringement proceedings 15.65–15.70
sublicensing 15.52–15.53
term and termination 15.72–15.76
unregistered trademarks 15.85
warranties 15.71
passing off tort 15.08, 15.19, 15.85
reasonable notice, termination of trademark licence arrangement on 15.73
security interests 15.86–15.90
Trade Marks Registry 15.01, 15.06, 15.16, 15.32, 15.37, 15.65

United States
see also American Law Institute (ALI)
antitrust law 6.11
assignment, current rule (‘with goodwill’) 18.06–18.15
origin of rule 18.12–18.15
rationale for rule 18.10–18.11
shifting towards assignment ‘in gross’ 18.19–18.20
INDEX

assignment and license-back 11.03, 18.39–18.41
Copyright Office, registration with 3.38, 3.39
_Dastar Corp_ case and trademark licensing 3.05–3.18
dilution notion 1.11
domain name transactions 4.12
function of trademarks 1.21
Generally Accepted Accounting Principles 7.40
_Hy-Cross_ principle 18.18
intent-to-use (ITU) trademark applications 18.07
intersection of trademark and bankruptcy laws see bankruptcy and trademark licenses, law intersecting in United States
judicial developments 18.16–18.20, 18.32–18.37
assignment ‘in gross’ 18.19–18.20
early (conservative) decisions 18.17–18.18
evolution of the standard 18.32–18.35
recent developments 18.36–18.37
_Lanham_ (Trademark) Act 1.21, 1.22, 3.05, 18.04, 18.05, 18.45
trademark assignment 18.12, 18.15, 18.17
trademark licensing 18.21, 18.22, 18.25, 18.29, 18.30, 18.32, 18.33
licensing of trademarks, current rule (‘with control’) 18.21–18.37
origin of rule 18.29–18.31
rationale for rule 18.27–18.28
Patent and Trademark Office see USPTO (United States Patent and Trademark Office)
reverse passing off 3.05
and Security and Exchange Commission (SEC) filings 7.15
security interests 18.42–18.44
strategic transactions 18.38–18.44
assignment and license-back 11.03, 18.39–18.41
security interests in trademarks 18.42–18.44
Supplemental Register, use of 1.15
trademark law 18.03–18.05
_Trademark Manual of Examining Procedure (TMEP)_ 11.40, 11.41, 18.08
_Uniform Commercial Code_ 18.42
unregistered trademarks see also registration of trademarks and licenses in ASEAN 22.23–22.26
India 23.49–23.50, 23.69
licensing in India 23.49–23.50
in United Kingdom 15.85
protected at common law 1.09
in United Kingdom 15.19, 15.85
_USPTO_ (United States Patent and Trademark Office) 11.40, 18.08, 18.26, 18.42, 18.43
_Assignment Recordation Branch_ 18.09
validity of assignment, UK 15.20
validity of international trademark transactions capacity 12.18–12.19
choice-of-law clauses 12.35–12.38
formal 12.13–12.14, 12.37
substantive 12.15–12.17, 12.38
_Vienna Convention on the Law of Treaties (VCLT)_ double taxation 8.26
and TRIPS Agreement 1.13, 1.64
_Vietnam_
assignment of trademarks 22.20, 22.21, 22.22
_Law on Intellectual Property_ 22.35, 22.37
licensing of registered trademarks 22.35–22.37
registration of trademark transactions 22.60–22.61
trademarks as property in 22.08, 22.09
voice see exit, voice and loyalty framework (Hirschman)

warranties
France 17.17
Germany 16.59
United Kingdom 15.71
<table>
<thead>
<tr>
<th>Topic</th>
<th>Page(s)</th>
</tr>
</thead>
<tbody>
<tr>
<td>weak party, choice-of-court clauses</td>
<td>12.22–12.23</td>
</tr>
<tr>
<td>weighted average cost of capital (WACC)</td>
<td>7.08</td>
</tr>
<tr>
<td>Whois database, domain name transactions</td>
<td>4.24, 4.29</td>
</tr>
<tr>
<td>WIPO (World Intellectual Property Organization) see World Intellectual Property Organization (WIPO)</td>
<td>13.06, 13.14</td>
</tr>
<tr>
<td>WordPress platform, domain name transactions</td>
<td>4.02</td>
</tr>
<tr>
<td>World Intellectual Property Organization (WIPO)</td>
<td></td>
</tr>
<tr>
<td>dispute resolution mechanisms</td>
<td>13.06, 13.14</td>
</tr>
<tr>
<td>General Assembly</td>
<td>2.08</td>
</tr>
<tr>
<td>global function</td>
<td>2.01</td>
</tr>
<tr>
<td>International Bureau</td>
<td>2.27, 2.29, 2.44, 2.50</td>
</tr>
<tr>
<td>Lisbon Agreement</td>
<td>1.06</td>
</tr>
<tr>
<td>normative framework</td>
<td>2.04–2.09</td>
</tr>
<tr>
<td>Common Regulations</td>
<td>2.05, 2.09</td>
</tr>
<tr>
<td>Joint Recommendation Concerning</td>
<td></td>
</tr>
<tr>
<td>Trademark Licenses</td>
<td>2.08</td>
</tr>
<tr>
<td>Madrid Protocol</td>
<td>2.09</td>
</tr>
<tr>
<td>Paris Convention</td>
<td>2.06</td>
</tr>
<tr>
<td>Singapore Treaty</td>
<td>2.05, 2.07</td>
</tr>
<tr>
<td>Report of 2013 (Brands – Reputation and Image in the Global Marketplace)</td>
<td>2.03, 2.53</td>
</tr>
<tr>
<td>technical Committees</td>
<td>2.55</td>
</tr>
<tr>
<td>World Trade Organization (WTO)</td>
<td></td>
</tr>
<tr>
<td>Chinese accession</td>
<td>20.08, 20.67</td>
</tr>
<tr>
<td>dispute settlement system</td>
<td>1.01</td>
</tr>
<tr>
<td>WTO Dispute–Settlement Panel</td>
<td>1.37, 1.39, 1.42</td>
</tr>
<tr>
<td>Indian membership</td>
<td>23.05</td>
</tr>
<tr>
<td>naked licensing</td>
<td>1.22</td>
</tr>
<tr>
<td>TRIPS Agreement</td>
<td></td>
</tr>
<tr>
<td>see TRIPS (Agreement on Trade-Related Aspects of Intellectual property Rights)</td>
<td></td>
</tr>
</tbody>
</table>