

EXTENDED TABLE OF CONTENTS

<i>List of figures</i>	xx
<i>List of tables</i>	xxi
<i>Editors and Contributors</i>	xxii
<i>Foreword</i> Sir Robin Jacob	xxviii
<i>Introduction</i> Irene Calboli and Jacques de Werra	xxx
<i>Table of cases</i>	xxxiv
<i>Table of legislation</i>	xlvii

PART I TRADEMARK TRANSACTIONS IN THE GLOBAL MARKETPLACE

Section A International Framework

1. TRIPS, TRADEMARKS, AND TRADEMARK TRANSACTIONS: A FORCED RECONCILIATION? <i>Daniel J. Gervais</i>	
A. INTRODUCTION	1.01
B. THE ORIGIN OF THE TRADEMARK PROVISIONS IN THE TRIPS AGREEMENT	1.03
1. The battle between common and civil law	1.03
2. Trademarks in major legal systems and the TRIPS Agreement	1.08
3. The TRIPS Agreement and the Paris Convention	1.14
C. THE TRADEMARK PROVISIONS IN THE TRIPS AGREEMENT	1.17
1. Article 15 of the TRIPS Agreement	1.18
2. The function(s) of trademarks	1.20
3. Recordal of transfers and licenses under Article 19.2 of the TRIPS Agreement	1.29
4. Article 20 of the TRIPS Agreement	1.36
D. THE TRADEMARK TRANSACTIONS PROVISION: ARTICLE 21 OF THE TRIPS AGREEMENT	1.43
1. Drafting history	1.44
2. Compulsory licenses of trademarks	1.49
3. Conditions on transfers and licenses and the enforcement of marks	1.54
4. A role for competition law?	1.62
E. CONCLUSION	1.70
2. TRADEMARK TRANSACTIONS AND THE NORMATIVE FRAMEWORK OF THE WORLD INTELLECTUAL PROPERTY ORGANIZATION <i>Marcus Höpferger</i>	
A. INTRODUCTION	2.01
B. THE NORMATIVE FRAMEWORK OF WIPO	2.04
1. The Paris Convention	2.06
2. The Singapore Treaty	2.07
3. The Joint Recommendation	2.08
4. The Madrid Protocol	2.09
C. CHANGE IN OWNERSHIP	2.10
1. The Paris Convention	2.10
2. The TLT and Singapore Treaty	2.14
3. The Madrid System	2.25

D. LICENSES	2.30
1. The Singapore Treaty and Joint Recommendation	2.30
2. The Madrid System	2.44
E. RESTRICTIONS OF THE RIGHT OF DISPOSAL	2.47
F. CONCLUSION	2.53

Section B Strategic Considerations

3. LICENSING COMMERCIAL VALUE: FROM COPYRIGHT TO TRADEMARKS AND BACK

Jane C. Ginsburg

A. INTRODUCTION	3.01
B. WHEN THE TRADEMARK OWNER IS NO LONGER A COPYRIGHT OWNER: TRADEMARK LICENSING IN THE SHADOW OF <i>DASTAR</i>	3.05
1. Distinguishing trademark goodwill from works of authorship	3.07
2. Trademark and copyright: in fact inseparable?	3.11
3. Keeping characters out of the copyright public domain: the impact on trademarks	3.16
C. EXPLOITING CHARACTERS WHEN THE TRADEMARK CLAIMANT WAS NOT ORIGINALLY OR IS NO LONGER THE COPYRIGHT OWNER	3.19
1. Adopting copyright-expired characters	3.19
2. Reversion of copyright in a trademarked character	3.25
D. WHEN THE TRADEMARK OWNER BECOMES A COPYRIGHT OWNER: TRADEMARKS AS COPYRIGHTED WORKS	3.30
E. CONCLUSION	3.39

4. THE COMPLEXITIES OF DOMAIN NAMES TRANSACTIONS: CONTRACTS FOR A MARKET WHERE VALUE INCREASES WITH TIME

Cédric Manara

A. INTRODUCTION	4.01
B. 'WHICH' OBJECT FOR THE TRANSACTION?	4.06
1. A top level domain	4.07
(a) Private auctions	4.07
(b) Sale of a top level domain	4.08
(c) Lease of a top level domain	4.09
2. A third level domain	4.10
3. A second level domain	4.13
C. 'WHERE' WILL THE NAME BE USED?	4.14
D. 'WHO' WILL HOLD OR USE THE NAME?	4.18
1. The case of a transfer	4.19
(a) Eligibility	4.19
(b) Contact information	4.24
(c) Joint registration	4.25
2. The case of agreements on use	4.26
(a) General principles	4.26
(b) Situations of joint use	4.30
E. 'WHAT' IS THE NATURE OF THE TRANSACTION?	4.31
1. 'Sale' of a domain name	4.31
2. License of a domain name	4.32
F. CONCLUSION	4.33

5. HOW TO MAKE TWO OUT OF ONE: THE INS AND OUTS OF TRADEMARK PORTFOLIO SPLITTING TRANSACTIONS

Gregor Bühler and Luca Dal Molin

A. INTRODUCTION	5.01
B. PRELIMINARY NOTE ON APPLICABLE LAW	5.05

C. BUILDING BLOCKS OF TRADEMARK PORTFOLIO SPLITTING	5.09
1. Overview	5.09
2. Free assignability as international standard	5.10
3. Partial assignment	5.12
(a) Overview	5.12
(b) Effect of the partial assignment	5.14
(c) Limitations	5.16
(d) Technicalities under a Swiss law focus	5.19
4. Trademark license	5.23
(a) Overview	5.23
(b) Limitations	5.26
(c) Technicalities under Swiss law focus	5.28
5. Partial assignment and license grant compared in practice	5.31
(a) In general: ownership v. contractual rights	5.31
(b) Affected goods and services	5.33
(c) Duration of the post-transactional arrangement	5.35
(d) Flexibility of license grants v. restrictions on partial assignments	5.36
(e) License to register new trademarks	5.37
D. TRADEMARK PORTFOLIO SPLITTING AGREEMENTS	5.39
1. Overview	5.39
2. Typical provisions in trademark portfolio splitting agreements	5.42
(a) Trademark delimitation and allocation	5.42
(b) Implementation of the allocation	5.46
(c) Coexistence, non-compete and mutual support	5.51
(d) Scope	5.52
(e) Trademark maintenance	5.53
(f) Duration and termination	5.55
(g) Conflict resolution, governing law, jurisdiction	5.56
E. OTHER POSSIBLE OPTIONS AND CONSIDERATIONS	5.57
1. Shared ownership	5.57
2. Joint ventures	5.60
3. Rebranding	5.61
F. CONCLUSION	5.62
6. COMPETITION, MARKETS, AND TRADEMARK TRANSACTIONS	
<i>Shubha Ghosh</i>	
A. INTRODUCTION	6.01
B. COMPETITION, INTELLECTUAL PROPERTY, AND TRADEMARKS	6.15
C. CONCEPTS, MODELS, AND TRADEMARK LAW	6.38
D. TRADEMARK TRANSACTIONS: TYING, TRANSFERS IN GROSS AND COVENANTS NOT TO SUE	6.71
E. CONCLUSION	6.77

Section C Valuation, Taxation, Security Interests and Bankruptcy

7. BRAND DIFFERENTIATION AND INDUSTRY SEGMENTATION: DRIVERS FOR TRADEMARK VALUATION IN CORPORATE TRANSACTIONS	
<i>Roy P. D'Souza</i>	
A. INTRODUCTION	7.01
B. BRAND MANAGEMENT PRINCIPLES	7.06
C. COMMON APPROACHES TO VALUE BRANDS	7.09
1. Income approach	7.10
(a) Relief from royalty	7.13
(b) Excess earnings	7.18
2. Market approach	7.20
D. HISTORICAL TRANSACTIONS INVOLVING BRANDS	7.22
1. Distressed vs. going concern (brand-only vs. business enterprise with brand)	7.23

(a)	Distressed business enterprise (liquidation/brand only scenario)	7.24
(b)	Distressed enterprise key transactions	7.25
(c)	Going concern business enterprise	7.31
(d)	Going concern business enterprise key transactions	7.32
2.	Valuation of the brands transacted	7.37
(a)	Strategic vs. Financial Target	7.37
(b)	Summary	7.38
3.	Asset purchase agreements containing trademarks	7.39
E.	PURCHASE PRICE ALLOCATION	7.40
F.	WHY INDUSTRY MATTERS	7.41
G.	ADDITIONAL BRAND VALUATION METHODS	7.45
H.	THE WORLD'S MOST VALUABLE BRANDS	7.46
I.	CONCLUSION	7.47
8.	TRADEMARK TRANSACTIONS AND INTERNATIONAL TAX STRATEGIES	
	<i>Jean-Frédéric Maraia</i>	
A.	INTRODUCTION	8.01
B.	OECD – BEPS: GENERAL PRESENTATION	8.05
C.	TRADEMARK TRANSACTIONS BETWEEN THIRD PARTIES	8.10
1.	Licensing	8.12
(a)	Tax treatment of royalties	8.14
(b)	Impact of double tax treaties in an international context	8.18
2.	Assignment	8.27
(a)	Royalties or capital gains?	8.27
(b)	Tax treatment of capital gains	8.33
(c)	Impact of double tax treaties in an international context	8.36
3.	Tax treatment of expenses	8.38
D.	TRADEMARK TRANSACTIONS BETWEEN RELATED PARTIES	8.41
1.	Arm's length principle	8.43
2.	Arm's length price	8.47
3.	Domestic restructuring	8.54
E.	INTERNATIONAL TAX STRATEGIES	8.57
1.	Residence of companies	8.59
2.	Ownership	8.64
3.	Tax status	8.69
(a)	Auxiliary status (intellectual property companies)	8.70
(b)	Licence box	8.76
F.	CONCLUSION	8.87
9.	REGISTERING SECURITY INTERESTS OVER TRADEMARKS IN AUSTRALIA: THEORY AND PRACTICE	
	<i>Robert Burrell and Michael Handler</i>	
A.	INTRODUCTION	9.01
B.	THE PRE-PPSA POSITION	9.03
C.	THE PPSA REFORMS	9.08
D.	TENSIONS BETWEEN THE TRADEMARK AND PPSA SYSTEMS	9.14
1.	Imperfect information and transition costs	9.16
2.	Ongoing role of recording claims in the Trade Marks Register	9.23
3.	Problems caused when title in property passes to the secured party	9.25
E.	CONCLUSIONS AND OPTIONS FOR REFORM	9.32
10.	THE INTERSECTION OF TRADEMARKS, LICENSES AND BANKRUPTCY: ENDING UNCERTAINTIES IN THE LAW	
	<i>Xuan-Thao Nguyen</i>	
A.	INTRODUCTION	10.01
B.	TRADEMARK IN ORDINARY LICENSES	10.12

C. TRADEMARKS IN CORPORATE TRANSACTIONS	10.18
1. <i>Chain v. Tropodyne</i> : sale of assets and trademark use within the acquired division	10.21
2. <i>Seattle Brewing & Malting Co. v. Commissioner</i> : sale of assets and trademark use restricted to field of use and geographical territory	10.24
D. CORPORATE DIVISION SALE OF ASSETS AND TRADEMARK USE IN IN RE <i>EXIDE TECHNOLOGIES</i>	10.33
1. In re <i>Exide Technologies</i>	10.34
2. Causing uncertainties	10.44
3. Adding uncertainties: In re <i>Interstate Bakeries</i> and In re <i>Lakewood (Sunbeam Prods., Inc. v. Chicago Am. Mfg, LLC)</i>	10.57
E. ENDING THE UNCERTAINTIES	10.68
1. Looking beyond form, facing the substance	10.68
2. Sales, not licenses	10.75
3. Concurrent use – assignment of trademark rights in different fields of use	10.79
(a) Concurrent use doctrine	10.80
(b) Co-existence separately	10.91
(c) Imperfect coexistence, but do not touch the license	10.94
F. CONCLUSION	10.95

Section D Dispute Prevention and Settlement Mechanisms

11. OUT OF THE SHADOWS: THE UNIQUE WORLD OF TRADEMARK CONSENT AGREEMENTS

Neil Wilkof

A. INTRODUCTION	11.01
B. THE LEGAL FOUNDATION	11.02
1. Assignment	11.03
2. License	11.04
3. Consent agreement	11.06
C. THE VARIOUS CIRCUMSTANCES IN WHICH A CONSENT AGREEMENT MAY ARISE	11.13
D. TYPES OF CONSENT AGREEMENT	11.20
E. IMPACT ON THE BEHAVIOUR OF THE PARTIES BY VIRTUE OF THE UNDERTAKINGS IN A CONSENT AGREEMENT	11.25
F. THE ROLE OF LIKELIHOOD OF CONFUSION	11.31
G. PUBLIC AND PRIVATE CONSIDERATIONS	11.35
H. CONCLUSION	11.42
APPENDIX	

12. CHOICE-OF-COURT AND CHOICE-OF-LAW CLAUSES IN INTERNATIONAL TRADEMARK TRANSACTIONS

Dai Yokomizo

A. INTRODUCTION	12.01
B. CHOICE-OF-COURT CLAUSE	12.04
1. Practice	12.05
(a) Which country's court is chosen?	12.05
(b) Is a choice-of-court clause exclusive or not?	12.06
(c) Choice-of-court clause or arbitration clause?	12.07
(d) Summary	12.08
2. Legal issues	12.09
(a) Validity	12.13
(b) Limitation	12.20
(c) Summary	12.25
3. Summary	12.29
C. CHOICE-OF-LAW CLAUSE	12.31
1. Practice	12.32
2. Legal issues	12.34
(a) Validity	12.35
(b) Scope	12.39

3. Summary	12.41
D. CONCLUSION	12.42
13. ALTERNATIVE DISPUTE RESOLUTION MECHANISMS FOR SOLVING TRADEMARK DISPUTES (MEDIATION, UDRP, ARBITRATION)	
<i>Jacques de Werra</i>	
A. INTRODUCTION	13.01
B. ADR METHODS FOR SOLVING TRADEMARK DISPUTES	13.02
1. Mediation	13.03
2. The UDRP	13.06
3. UDRP as a model for other ADR systems for trademark-related domain name disputes	13.12
C. ARBITRATION OF (INTERNATIONAL) TRADEMARK DISPUTES	13.27
1. Introduction	13.27
2. Conditions and features	13.29
(a) Objective arbitrability of intellectual property disputes	13.30
(b) Consent of parties to submit to arbitration: the scope of the arbitration clause	13.34
3. Governing law	13.61
4. Provisional measures	13.66
D. CONCLUSION	13.69
PART II TRADEMARK TRANSACTIONS AT THE REGIONAL AND NATIONAL LEVEL	
Section A Trademark Transactions in Europe	
14. TRADEMARK TRANSACTIONS IN EU LAW: REFINING THE APPROACH TO SELECTIVE DISTRIBUTION NETWORKS AND NATIONAL UNFAIR COMPETITION LAW	
<i>Martin Senftleben</i>	
A. INTRODUCTION	14.01
B. OVERVIEW OF HARMONIZED EU RULES	14.03
1. Community Trade Mark Regulation	14.03
2. Trade Mark Directive	14.10
3. Reform plans	14.11
C. SELECTIVE DISTRIBUTION NETWORKS	14.14
1. The <i>Copad/Dior</i> case	14.14
2. Expansion of the concept of product quality	14.17
3. Impact on exhaustion of rights	14.19
4. Open questions	14.23
5. Rights against the licensee	14.29
6. Rights against outside traders	14.37
7. A more nuanced approach	14.40
D. ROOM FOR NATIONAL UNFAIR COMPETITION LAW	14.43
1. The <i>Martin Y Paz/Depuydt</i> case	14.43
2. Mantra of complete harmonization	14.48
3. Function theory unsatisfactory	14.52
4. No pre-emption of national doctrines	14.57
E. CONCLUSION	14.59
15. UK PERSPECTIVES ON TRADEMARK TRANSACTIONS: A LIBERAL APPROACH	
<i>Laura Anderson</i>	
A. INTRODUCTION	15.01

B. UK LAW AND TRADEMARK TRANSACTIONS	15.05
C. ASSIGNMENTS OF UK TRADEMARKS	15.11
1. Assignment of part	15.16
2. Unregistered trademarks	15.19
3. Requirements for valid assignment	15.20
4. Language	15.21
5. Identification of the intellectual property rights being assigned	15.22
6. Consideration	15.23
7. Assignment of the right to sue prior infringers	15.24
8. Implied covenants as to title	15.25
9. Registration	15.30
10. Trusts and equitable assignments of trademarks	15.32
11. What is required for an equitable assignment?	15.35
12. Confirmatory assignments	15.37
D. LICENSES OF UK TRADEMARKS	15.40
1. The nature of a trademark license	15.42
2. Formalities	15.44
3. Key terms	15.47
4. Grant and exclusivity	15.50
5. Sublicensing	15.52
6. Quality control	15.54
7. Liabilities and indemnity	15.62
8. Rights of licensees to bring infringement proceedings	15.65
9. Warranties	15.71
10. Term and termination	15.72
11. Assignment of licenses	15.77
12. Contracts Rights of Third Parties Act	15.81
13. Registration	15.83
14. Licensing of unregistered trademarks	15.85
E. SECURITY INTERESTS	15.86
F. UK COMPETITION LAW	15.91
G. CONCLUSIONS	15.93
16. TRADEMARK TRANSACTIONS IN GERMANY: A CONTINENTAL EUROPEAN SYSTEM MOVES TOWARDS COMMON UNDERSTANDING WITH THE US	
<i>Axel Nordemann and Christian Czychowski</i>	
A. INTRODUCTION	16.01
B. EXISTING LEGAL RULES ON TRADEMARK TRANSACTIONS IN GERMAN LAW	16.02
1. The legal framework – overview	16.02
2. Relations between European Union law and German trademark law	16.11
3. Sections 27–31 of the MarkenG	16.19
4. The difference between transactions with regard to registered trademarks, company symbols, and titles of works	16.26
C. TRADEMARK TRANSACTIONS IN PRACTICE	16.33
1. Purchase agreements	16.33
2. License agreements	16.36
(a) General	16.36
(b) Restrictions imposed by antitrust law	16.40
(c) License agreements and insolvency proceedings	16.46
(d) Trademark infringements	16.47
(e) Registration of a license	16.49
3. Coexistence agreements	16.50
(a) General	16.50
(b) Restrictions imposed by antitrust law	16.51
(c) Applicable law	16.53
4. Trademarks in mergers and acquisitions transactions	16.58

5. Trademarks as securities	16.61
D. CONCLUSION	16.64

17. FRENCH PERSPECTIVES ON TRADEMARK TRANSACTIONS: FROM THE CIVIL CODE TO THE BUSINESS LAW?

Nicolas Binctin

A. INTRODUCTION	17.01
B. CONTRACTUAL FREEDOM	17.06
1. General principles of contract law	17.07
(a) Trademark assignment	17.08
(b) Trademark licensing	17.13
2. Specific dispositions	17.23
C. THE TRADEMARK AS AN ELEMENT OF THE <i>FONDS DE COMMERCE</i>	17.32
1. Trademark and securities	17.33
2. Transfer of trademark	17.42
D. TAX CONSIDERATIONS AND TRADEMARK TRANSACTIONS	17.46
1. Trademark operations for free	17.49
2. The tax qualification of a trademark license as an asset	17.52
3. Tax influence on merger and acquisition qualification	17.54
E. CONCLUSION	17.57

Section B Trademark Transactions in North and South America

18. TRADEMARK TRANSACTIONS IN THE UNITED STATES: TOWARDS A DE FACTO ACCEPTANCE OF TRADING IN GROSS?

Irene Calboli

A. INTRODUCTION	18.01
B. A BRIEF PRIMER OF TRADEMARK LAW	18.03
C. TRADEMARK ASSIGNMENT	18.06
1. The current rule on trademark assignment 'with goodwill'	18.06
(a) Rationale of the rule	18.10
(b) Origin of the rule	18.12
2. Judicial developments	18.16
(a) Early (conservative) decisions	18.17
(b) Shifting towards trademark assignment 'in gross'?	18.19
D. TRADEMARK LICENSING	18.21
1. The current rule on trademark licensing 'with control'	18.21
(a) Rationale of the rule	18.27
(b) Origin of the rule	18.29
2. Judicial developments	18.32
(a) The evolution of the standard	18.33
(b) Recent developments	18.36
E. STRATEGIC TRADEMARK TRANSACTIONS	18.38
1. Trademark assignment and license-back	18.39
2. Security interests in trademarks	18.42
F. CONCLUSION	18.45

19. NEW DRESS CODE FOR BUSINESS TRANSACTIONS IN BRAZIL: ESSENTIALS AND PECULIARITIES OF TRADEMARKS IN THE SPOTLIGHT

José Carlos Vaz e Dias

A. INTRODUCTION	19.01
B. THE LEGAL NATURE OF TRADEMARKS: OPPORTUNITIES AND LIMITS	19.06
C. TRADEMARKS LICENSING	19.13
D. TRADEMARK AND FRANCHISING IN BRAZIL	19.22
E. TRADEMARK AS COLLATERAL AND SECURITY INTEREST	19.35

F. ASSIGNMENT OF THE TRADEMARK APPLICATION AND/OR REGISTRATION	19.46
G. CONCLUSION	19.63

Section C Trademark Transactions in Asia

20. CHINESE TRADEMARK LAW AND TRADEMARK TRANSACTIONS: A LAW IN TRANSITION IN THE GLOBAL ECONOMY

He Guo

A. INTRODUCTION	20.01
B. EVOLUTION OF THE CHINESE TRADEMARK LAW	20.03
C. ESTABLISHING TRADEMARK RIGHTS	20.12
1. Registered trademarks	20.13
(a) Application for trademark registration	20.13
(b) Examination of the application for trademark registration	20.16
2. Unregistered trademarks	20.20
D. ASSIGNMENT OF TRADEMARKS	20.26
1. Concept and formalities for trademark assignment	20.26
2. Procedures and regulations on trademark assignment	20.34
E. TRADEMARK LICENSING	20.37
1. Type of trademark licenses	20.40
2. Obligations of the trademark owners and licensees	20.42
(a) Supervision of the quality of the marked goods	20.43
(b) Maintenance of trademark rights	20.48
3. Ownership of the goodwill and legal responsibilities after a trademark license contract is terminated	20.50
(a) Ownership of the goodwill	20.50
(b) Legal responsibilities after a trademark license contract is terminated	20.51
F. PLEDGE OF TRADEMARKS	20.53
1. Definition and legal basis of trademark pledge	20.53
2. Procedural requirements for the pledge of the trademark rights	20.60
3. Effects of the pledge contract of trademark rights	20.65
G. CONCLUSION	20.67

21. JAPANESE PERSPECTIVES ON TRADEMARK TRANSACTIONS: IS EXPANSIVE TRADEMARK PRACTICE PREVAILING OVER THE CONSERVATIVE STOICISM?

Shinto Teramoto

A. INTRODUCTION	21.01
B. WHAT IS A 'TRADEMARK'?	21.03
1. Scope of 'trademarks' in the context of trademark transactions	21.03
2. 'Trademarks' under the Trademark Act	21.05
3. What has changed and what has not in the legal definition of trademarks	21.07
4. Laws to be considered when negotiating trademark transactions	21.11
C. LICENSES	21.12
1. Definition of 'license'	21.12
2. 'Right to use' trademarks provided under the Trademark Act	21.13
3. Non-exclusive right to use	21.17
4. Proprietary right to use	21.24
5. Licensing agreements for marks not registered under the Trademark Act	21.29
6. Governing laws of licensing agreements	21.38
7. Japanese taxes imposed on royalties	21.39
8. Termination of licensing agreements	21.48
9. Application of the Anti-Monopoly Act	21.51
D. TRADEMARK ASSIGNMENTS AND SECURITY INTERESTS	21.53
1. General principles	21.53
2. Trademarks that simultaneously represent the goodwill of diversified suppliers	21.56

3. Marks that represent the collective goodwill of multiple suppliers	21.58
4. Non-assignability of regional collective trademark rights	21.61
5. Security interests in trademark rights	21.63
E. CONCLUSION	21.67

22. TRADEMARK TRANSACTIONS IN ASEAN: CONVERGENCES AND DIVERGENCES IN EMERGING MARKETS

Susanna H. S. Leong

A. INTRODUCTION	22.01
B. TRADEMARKS AS PROPERTY	22.05
C. ASSIGNMENT OF REGISTERED TRADEMARKS	22.12
1. Assignment of registered trademarks with or without goodwill/business	22.14
2. Assignment of an application for registration of a trademark	22.21
3. Formalities: assignments must be in writing	22.22
4. Assignment of unregistered trademarks	22.23
D. LICENSING OF REGISTERED TRADEMARKS	22.27
1. Singapore	22.30
2. Vietnam	22.35
3. Thailand	22.38
4. Philippines	22.45
5. Cambodia	22.46
6. Myanmar	22.47
7. Brunei	22.48
8. Malaysia	22.50
9. Laos	22.53
10. Indonesia	22.55
E. REGISTRATION OF TRANSACTIONS	22.57
1. Singapore	22.58
2. Vietnam	22.60
3. Thailand	22.62
4. Philippines	22.64
5. Cambodia	22.65
6. Myanmar	22.67
7. Brunei	22.68
8. Malaysia	22.69
9. Laos	22.72
10. Indonesia	22.73
F. CONCLUSION	22.74

23. TRADEMARK TRANSACTIONS IN INDIA: EXPLORING THE GENRE, SCOPE AND CONSEQUENCE

Raman Mittal

A. INTRODUCTION	23.01
B. LICENSING OF REGISTERED TRADEMARKS UNDER THE TRADE MARKS ACT OF 1999	23.04
1. Scope of trademark licensing	23.05
2. Term and territorial scope of license	23.11
3. Conditions for and extent of use of mark by licensee	23.13
4. Procedure for registration, variation, and cancellation of registration	23.18
5. Rights and obligations of licensor	23.23
(a) Liability for acts of licensee	23.25
(b) Right to sue infringers and right to be impleaded	23.26
(c) Right to keep licensing details secret	23.27
(d) Obligation to furnish information to the Registrar	23.28
6. Rights and obligations of licensee	23.29
(a) Use of mark under accompanying legend	23.30
(b) Assignment and sublicensing by licensee	23.31
(c) Right to initiate infringement proceedings	23.32

(d) Right to be impleaded	23.35
(e) Right to be notified in case of new license or cancellation	23.36
(f) Right over goodwill generated	23.37
(g) Proprietorship over the mark	23.38
(h) Right to challenge the mark	23.39
7. Quality control over the use of the licensed trademark	23.40
8. Trafficking under Trade and Merchandise Marks Act of 1958	23.43
9. Character merchandising and trademark licensing	23.46
10. Licensing and hybridization of trademarks	23.48
C. LICENSING OF UNREGISTERED TRADEMARKS	23.49
D. BREACH OF TRADEMARK LICENSE AND CONSEQUENCES	23.51
E. ASSIGNMENT OF TRADEMARKS	23.55
1. Relation between trademark assignment and assignment of goodwill	23.59
2. Restrictions on assignment	23.60
3. Assignment resulting in splitting of trademark on territorial basis	23.62
4. Registration of the assignee of a registered trademark	23.63
5. Assignment of unregistered trademarks	23.69
6. Assignment of certification and associated trademarks and discretion of registrar	23.70
F. ROYALTY FOR TRADEMARK TRANSACTIONS AND TREATMENT UNDER TAXATION LAWS	23.71
G. CONCLUSION	23.73
<i>Index</i>	587