

Table of Contents

CHAPTER 1. INTRODUCTION TO MERCHANDISING

- § 1:1 What is merchandising?
- § 1:2 History of licensing—The beginning
- § 1:3 —The 1940s
- § 1:4 —The 1950s
- § 1:5 —The 1960s
- § 1:6 —The 1970s
- § 1:7 —The 1980s
- § 1:8 —The 1990s
- § 1:9 —The 21st century
- § 1:10 Current status of merchandising
- § 1:11 Reasons for the popularity of merchandising
- § 1:12 Future trends

CHAPTER 1A. INTERNATIONAL LICENSING MARKETS

- § 1A:1 Introduction
- § 1A:2 International scope of the industry
- § 1A:3 Europe
- § 1A:4 Asia
- § 1A:5 Australia & New Zealand
- § 1A:6 Latin America
- § 1A:7 Africa

CHAPTER 2. SELECTION AND EVALUATION OF A MERCHANDISING PROPERTY

- § 2:1 Introduction

I. WHAT TYPES OF PROPERTIES ARE MERCHANDISABLE?

- § 2:2 Generally
- § 2:3 Popularity properties

- § 2:4 Status and Fashion Properties
- § 2:5 Personification properties
- § 2:6 Distinctive ornamentation properties

II. SOURCES OF MERCHANDISING PROPERTIES

- § 2:7 Generally
- § 2:8 Motion pictures
- § 2:9 Television and radio
- § 2:10 Comic strips and publications
- § 2:11 Greeting cards and stationery products
- § 2:12 Entertainers & Influencers
- § 2:13 Designer names
- § 2:14 National brands and corporate logos
- § 2:15 Advertising campaigns
- § 2:16 Colleges, universities, and college athletes
- § 2:17 Professional sports
- § 2:18 Nonprofit organizations & Governmental bodies
- § 2:19 Computer, video and handheld games
- § 2:20 Classic v. Entertainment Properties
- § 2:21 Private label brands
- § 2:22 Art
- § 2:23 Food & Beverages
- § 2:24 Music

III. WHAT TYPES OF PRODUCTS LEND THEMSELVES TO MERCHANDISING?

- § 2:25 Generally

IV. SELECTING A MERCHANDISING PROPERTY

- § 2:26 Generally

V. SPECIAL CONSIDERATIONS IN EVALUATING MERCHANDISING POTENTIAL

- § 2:27 Generally

VI. MARKET STUDIES

- § 2:28 Generally

TABLE OF CONTENTS

CHAPTER 3. CLEARING POTENTIAL PROPERTIES

§ 3:1 Introduction

I. TRADEMARK SEARCHING

§ 3:2 Preliminary review—Narrowing the list

§ 3:3 Formal searching by trademark search firm

§ 3:4 Considerations in framing the search request

§ 3:5 Search analysis

§ 3:6 —Questions to be addressed

§ 3:7 —Likelihood of confusion

§ 3:8 —Investigation of use of potentially conflicting properties

§ 3:9 —Purchase of potentially conflicting properties

§ 3:10 —Searching fallibilities

II. COPYRIGHT AND PATENT SEARCHING

§ 3:11 Generally

CHAPTER 4. OWNERSHIP CONSIDERATIONS

§ 4:1 Introduction

I. REVIEW OF CONTRACTS AND AGREEMENTS

§ 4:2 Generally

§ 4:3 Employee and employment agreements

§ 4:4 Designer agreements

§ 4:5 Joint venture agreements

§ 4:6 Professional athletes—Individual, team, and league agreements

§ 4:7 Motion picture and television agreements

II. SPECIAL SITUATIONS

§ 4:8 The Many Faces of Dwayne Johnson, aka “The Rock”

§ 4:9 Public domain subject matter

§ 4:10 —Deceased celebrities

§ 4:11 —Expired copyrights

- § 4:12 —Functional use of college and university names
- § 4:13 —Developing proprietary rights in public domain
subject matter

CHAPTER 5. LICENSING CONSIDERATIONS

- § 5:1 Introduction

I. PRE-LICENSING CONSIDERATIONS

- § 5:2 Identification of licensing plan and goals
- § 5:3 —Fragmentation considerations
- § 5:4 —Carefully planned program
- § 5:5 Identification of responsible personnel
- § 5:6 Worldwide coordination
- § 5:7 The Non-Disclosure Agreement (“NDA”)
- § 5:8 The option agreement

II. DEAL MEMO OR TERM SHEET

- § 5:9 Advantages
- § 5:10 Glossary of licensing terminology
- § 5:11 Suggested terms and conditions

III. THE MERCHANDISING LICENSE AGREEMENT

- § 5:12 Overview
- § 5:13 Preamble
- § 5:14 Body of the agreement—License grant
- § 5:15 —Term and options
- § 5:16 —Royalty provisions
- § 5:17 Establishing a royalty rate
- § 5:18 Types of royalty rates
- § 5:19 Royalty rates on domestic sales
- § 5:20 FOB royalty rates
- § 5:21 Royalty rates on direct sales
- § 5:22 Royalty rates for services
- § 5:23 Sublicensing royalties
- § 5:24 Split royalty rates
- § 5:25 Body of the agreement—Definition of “Net Sales”
- § 5:26 —Marketing Contributions
- § 5:27 —Statements and payments

TABLE OF CONTENTS

§ 5:28	—Audit
§ 5:29	—Quality control, notices, approvals, and samples
§ 5:30	—Obligations/Representations and warranties
§ 5:31	—Data Privacy
§ 5:32	—Artwork
§ 5:33	—Ownership of rights
§ 5:34	—Goodwill and promotional value
§ 5:35	—Intellectual property ownership, protection, marking & challenge
§ 5:36	—Infringements
§ 5:37	—Representations, warranties & indemnification
§ 5:38	—Insurance
§ 5:39	—Exploitation by the licensee and marketing and sales reports
§ 5:40	—Premiums and promotions
§ 5:41	—Assignability and sublicensing
§ 5:42	—Termination
§ 5:43	Body of the agreement: Post-Termination rights and notices
§ 5:44	Notices
§ 5:45	Relationship of the parties
§ 5:46	Governing law & disputes
§ 5:47	International Provisions
§ 5:48	Waiver
§ 5:49	Consistent rights
§ 5:50	Severability
§ 5:51	Survival of rights
§ 5:52	Force majeure
§ 5:53	Execution & Integration

IV. LITIGATION INVOLVING LICENSE AGREEMENTS

§ 5:54	Actions for Breach of License Agreement
§ 5:55	Actions for wrongful termination of license agreement

V. THE SECURITY AGREEMENT

§ 5:56	In general
§ 5:57	<i>[Reserved]</i>
§ 5:58	<i>[Reserved]</i>
§ 5:59	<i>[Reserved]</i>
§ 5:60	<i>[Reserved]</i>

§ 5:61 *[Reserved]*

§ 5:62 *[Reserved]*

§ 5:63 *[Reserved]*

CHAPTER 5A. LICENSING ADMINISTRATION AND MANAGEMENT

- § 5A:1 Introduction
- § 5A:2 The licensing team
- § 5A:3 Product development
- § 5A:4 Style Guide
- § 5A:5 Manufacturing Agreement
- § 5A:6 Social Compliance
- § 5A:7 Product approvals
- § 5A:8 Marketing & sales
- § 5A:9 Administration of the licensing program
- § 5A:10 Legal administration
- § 5A:11 Licensee Application Form
- § 5A:12 Deal Memo
- § 5A:13 License agreement
- § 5A:14 Approval Forms
- § 5A:15 Royalty Report Form
- § 5A:16 Financial administration
- § 5A:17 Prospecting for the right property
- § 5A:18 Using technology to better manage a licensing
program
- § 5A:19 The Internet
- § 5A:20 Licensing directories & trade publications
- § 5A:21 Trade shows
- § 5A:22 International Licensing Trade Shows
- § 5A:23 Terminating a Licensee
- § 5A:24 Actions for wrongful termination of a licensee

CHAPTER 5B. MARKETING, ADVERTISING AND PROMOTING LICENSED PRODUCTS

- § 5B:1 Introduction
- § 5B:2 The role of marketing, advertising & promotion
in licensing
- § 5B:3 Advertising programs
- § 5B:4 Effective use of public relations
- § 5B:5 Innovative promotions
- § 5B:6 Premium promotions

TABLE OF CONTENTS

- § 5B:7 Social Media
- § 5B:8 Direct marketing
- § 5B:9 Marketing funds
- § 5B:10 Legal considerations
- § 5B:11 Approvals

CHAPTER 6. SPECIAL CONSIDERATIONS IN DRAFTING OTHER TYPES OF MERCHANDISING- RELATED AGREEMENTS

- § 6:1 Introduction

I. DESIGNER AGREEMENTS

- § 6:2 Generally
- § 6:3 Structuring the relationship
- § 6:4 Designer compensation
- § 6:5 Drafting the designer agreement
- § 6:6 —Term of the agreement
- § 6:7 —Required minimums to maintain rights
- § 6:8 —Ownership and indemnification
- § 6:9 —Additional design work
- § 6:10 —Sublicensing rights and provisions
- § 6:11 —Use of designer's name and likeness

II. AGREEMENTS WITH LICENSING AGENTS OR REPRESENTATIVES

- § 6:12 Generally
- § 6:13 Drafting the agreement
- § 6:14 —Limits on agency grant
- § 6:15 Drafting the Agreement—Term of the agreement
- § 6:16 Drafting the agreement—Responsibilities of the agent
- § 6:17 —Agent compensation and payment
- § 6:18 —Post-termination rights
- § 6:19 —Property owner warranties and indemnification
- § 6:20 Terminating an agent
- § 6:21 Introducer agreements

III. MISCELLANEOUS AGREEMENTS

- § 6:22 Promotional & sponsorship agreements

THE LAW OF MERCHANDISE AND CHARACTER LICENSING

- § 6:23 Manufacturer's representatives
- § 6:24 Role of the manufacturer's representative
- § 6:25 Compensating the manufacturer's representative
- § 6:26 *[Reserved]*
- § 6:27 Manufacturer's Representative Agreement
 - § 6:28 —Scope
 - § 6:29 —Exclusivity
 - § 6:30 —Term
 - § 6:31 —Termination
 - § 6:32 —Duties and responsibilities
 - § 6:33 —Payment
 - § 6:34 —Post-termination compensation
 - § 6:35 —Indemnification
- § 6:36 Licensing consultants
 - § 6:37 —Role
 - § 6:38 —Compensation
- § 6:39 Making the relationship work

IV. CELEBRITY AND ATHLETE PROMOTIONAL OR ENDORSEMENT AGREEMENTS

- § 6:40 Generally
- § 6:41 *[Reserved]*
- § 6:42 *[Reserved]*

V. JOINT VENTURE AGREEMENTS

- § 6:43 Generally

CHAPTER 6A. ETHICS AND SOCIAL COMPLIANCE

- § 6A:1 Ethics in licensing
- § 6A:2 Ensuring social compliance
- § 6A:3 The BSR report

CHAPTER 6B. ACCOUNTING, AUDITING & TAX CONSIDERATIONS

- § 6B:1 Introduction
- § 6B:2 Audit Provisions in the License Agreement
 - § 6B:3 —Right to Perform a Royalty Audit
 - § 6B:4 —Record Keeping

TABLE OF CONTENTS

§ 6B:5	—Interest on findings
§ 6B:6	—Extrapolation
§ 6B:7	—Recovery of Audit Fees
§ 6B:8	Interest on Late Payments
§ 6B:9	Audit conducted remotely
§ 6B:10	Non-Disclosure Agreement
§ 6B:11	When Should a Royalty Audit be performed?
§ 6B:12	Selecting the Royalty Auditor
§ 6B:13	Preparing for the Royalty Audit
§ 6B:14	Information Required from the Licensee
§ 6B:15	—Sales Journals, Invoices, Cash Receipts, and Banking Records
§ 6B:16	Information required from the Licensee— Manufacturing and purchasing records
§ 6B:17	—Inventory records
§ 6B:18	—Credit memo journals
§ 6B:19	—General ledgers, tax returns and financial statements
§ 6B:20	—Product catalogs/item masters
§ 6B:21	—Price lists, BOM's and Cost-Plus Calculations
§ 6B:22	Royalty Audit procedures
§ 6B:23	The Royalty Audit Report
§ 6B:24	—Common monetary findings
§ 6B:25	The Royalty Audit report—Common non- monetary findings
§ 6B:26	Accounting provisions in License Agreements
§ 6B:27	—Definition of terms
§ 6B:28	Auditing a Direct to Retail license agreement

CHAPTER 7. PROTECTION OF MERCHANDISING PROPERTIES

§ 7:1 Introduction

I. INTERRELATIONSHIP OF VARIOUS LEGAL THEORIES

A. AVAILABLE THEORIES OF PROTECTION

§ 7:2 Generally

B. SIMULTANEOUS RELIANCE ON SEVERAL THEORIES

§ 7:3 Generally

- § 7:4 Copyrights and trademarks
- § 7:5 Design patents and trademarks
- § 7:6 Design patents and copyrights
- § 7:7 Patent/Copyright and unfair competition overlap

II. THE BILLBOARD APPROACH

- § 7:8 Generally

III. CONSIDERATIONS AFFECTING PROTECTION SOUGHT

- § 7:9 Generally

IV. ESTABLISHING A FOUNDATION FOR PROTECTION

- § 7:10 Generally

CHAPTER 8. PROTECTING MERCHANDISING PROPERTIES UNDER TRADEMARK LAW

- § 8:1 Introduction

I. PROTECTABLE PROPERTIES

- § 8:2 Generally

A. ARBITRARY AND SUGGESTIVE MARKS

- § 8:3 Generally

B. DESCRIPTIVE MARKS WITH SECONDARY MEANING

- § 8:4 Generally

C. SPECIAL SITUATIONS

- § 8:5 Literary titles of single works
- § 8:6 Characters' names, physical attributes, and personality traits
- § 8:7 Properties used solely as ornamentation
- § 8:8 Are NFTs Protectable?

D. FUNCTIONAL SUBJECT MATTER

- § 8:9 Utilitarian functionality

TABLE OF CONTENTS

§ 8:10 Aesthetic functionality

**E. PROPERTIES LICENSED WITHOUT
QUALITY CONTROL**

§ 8:11 Generally

F. GENERICNESS

§ 8:12 Generally

**II. ESTABLISHING AND MAINTAINING
RIGHTS**

A. ADOPTION AND INITIAL USE

§ 8:13 In general

§ 8:14 Developing a use program for merchandising
properties

**B. POTENTIAL PROBLEMS ARISING FROM
FIRST USE BY LICENSEES**

§ 8:15 Generally

**C. IDENTIFYING AND DISTINGUISHING
FUNCTION**

§ 8:16 Generally

D. ONGOING USE

§ 8:17 Generally

E. TRADEMARK NOTICES

§ 8:18 Generally

**F. MONITORING USE, MISUSE, AND
UNLICENSED USE**

§ 8:19 Generally

**III. FEDERAL TRADEMARK REGISTRATION
PROTECTION**

§ 8:20 Generally

A. THE MERCHANDISING TRADEMARK APPLICATION

§ 8:21 Generally

B. OVERCOMING ORNAMENTATION REJECTIONS

§ 8:22 Generally

§ 8:23 Commercial impression created by the property

§ 8:24 Prior registrations

§ 8:25 Promotion of the property

§ 8:26 Practice of the trade

C. POST-REGISTRATION CONSIDERATIONS

§ 8:27 Generally

IV. STATE TRADEMARK REGISTRATION PROTECTION

§ 8:28 In general

§ 8:29 Advantages and disadvantages

§ 8:30 State Trademark Offices

V. STATE ANTIDILUTION PROTECTION

§ 8:31 In general

§ 8:32 Advantages and disadvantages

VI. FOREIGN TRADEMARK REGISTRATION PROTECTION

A. IN GENERAL—SURVEY OF EXPERTS

§ 8:33 Method

§ 8:34 National law

§ 8:35 International conventions

§ 8:36 Procedural recommendations

1. Bases for Protection

§ 8:37 Fanciful words with no meaning, such as XEROX

§ 8:38 Names of living persons, such as JESSICA
SIMPSON

§ 8:39 Names of dead persons, such as MARILYN
MONROE

TABLE OF CONTENTS

- § 8:40 Names of companies, such as HSBC
- § 8:41 Trademarks, such as COCA-COLA
- § 8:42 Designs, such as a Picasso Sketch
- § 8:43 Images or likenesses of living persons, such as images of JERRY LEWIS
- § 8:44 Images or likenesses of dead persons such as images of JIMI HENDRIX
- § 8:45 Images or likenesses of characters, such as images of MICKEY MOUSE

B. VARYING USE REQUIREMENT

- § 8:46 Generally

C. U.S. GOVERNMENT ATTEMPTS TO FOSTER PROTECTION

- § 8:47 Generally

D. SPECIAL MERCHANDISING CONSIDERATIONS

- § 8:48 United Kingdom—Risks of inadequate quality control

E. CANADA

- § 8:49 Controlled licensing
- § 8:50 Canada's Copyright Act and Industrial Design Act
- § 8:51 Functional Articles
- § 8:52 Developments in merchandising protection
- § 8:53 Reputation needed to enforce unregistered trademark rights
- § 8:54 Registration of merchandising marks as trademarks
- § 8:55 Famous marks

F. KOREA—DEVELOPMENTS IN INTELLECTUAL PROPERTY PROTECTION

- § 8:56 Copyright protection
- § 8:57 Unfair competition and trademark protection
- § 8:58 Treaties—Madrid protocol
- § 8:59 Recent court decisions

G. ARGENTINA

§ 8:60 Protection of foreign marks

H. INDONESIA

§ 8:61 Protection of U.S. copyright

I. NEW ZEALAND

§ 8:62 Recent developments in merchandising protection

J. TAIWAN

§ 8:63 Copyright to a work is granted upon completion

§ 8:64 Recordation of registered user is required

K. FRANCE

§ 8:65 New Trademark Act is adopted

L. BRAZIL

§ 8:66 Copyright

§ 8:67 Trademark license agreements

§ 8:68 Case law

M. ITALY

§ 8:69 Revisions to the Italian Trademark Act

N. SPAIN

§ 8:70 Recent legislative developments

O. AUSTRALIA

§ 8:71 Recent developments in merchandising protection

P. UNITED KINGDOM

§ 8:72 Recent developments in merchandising protection

§ 8:73 —Common law passing off protection for
merchandising

§ 8:74 —Registered trademarks protection for
merchandising

§ 8:75 —Copyright protection for merchandising

§ 8:76 —Confidential information as publicity and
privacy rights

TABLE OF CONTENTS

- § 8:77 —Designs protection for merchandising
- § 8:78 Design protection and trademark registrations compared
- § 8:79 Community unregistered design right
- § 8:80 Community or National Registration?

Q. HONG KONG

- § 8:81 Recent developments in merchandising protection

R. SWEDEN AND FINLAND

- § 8:82 Revisions to the Swedish trademark Act
- § 8:83 Finland—Revisions to the Finnish trademarks Act

S. SOUTH AFRICA

- § 8:84 New trademarks Act
- § 8:85 —Recent developments in merchandising protection
- § 8:86 Recent case law

T. VENEZUELA

- § 8:87 Recent judicial and legislative developments

U. URUGUAY

- § 8:88 Trademark and copyright protection
- § 8:89 Trademark protection—Act No. 17.011 of September 25, 1998
- § 8:90 —Regulatory Decree No. 34/99 for the enforcement of Act No. 17.011
- § 8:91 —Procedure for recordal of license agreements
- § 8:92 —Publication
- § 8:93 —Cancellation of the registration

V. JAPAN

- § 8:94 Recent developments in intellectual property law
- § 8:95 Recent case law

W. PHILIPPINES

- § 8:96 Recent court decisions on copyright infringement and well-known marks

CHAPTER 9. PROTECTING MERCHANDISING PROPERTIES UNDER COPYRIGHT LAW

§ 9:1 Introduction

I. APPLICABILITY OF COPYRIGHT PROTECTION

§ 9:2 Generally

II. OBTAINING COPYRIGHT PROTECTION— STATUTORY FORMALITIES

§ 9:3 Statutory subject matter

§ 9:4 The copyright notice

§ 9:5 Effect of copyright registration

III. LIMITATIONS ON COPYRIGHT PROTECTION

§ 9:6 Generally

§ 9:7 The fair use doctrine

§ 9:8 Public domain material

§ 9:9 Independent creation

IV. DERIVATIVE WORKS

§ 9:10 Generally

V. ARTIFICIAL INTELLIGENCE

§ 9:11 Generally

CHAPTER 10. PROTECTING MERCHANDISING PROPERTIES UNDER PATENT LAW

§ 10:1 Introduction

I. DESIGN PATENTS

A. SCOPE OF PROTECTION

§ 10:2 Protection for new, original, and ornamental
designs

TABLE OF CONTENTS

§ 10:3 Applicability in merchandising—Three-dimensional characters

B. ADVANTAGES AND DISADVANTAGES

§ 10:4 Generally

II. UTILITY PATENTS

§ 10:5 Generally

§ 10:6 Impact of artificial intelligence on patents

III. PATENT LICENSING ISSUES

§ 10:7 Generally

CHAPTER 11. ENFORCEMENT OF RIGHTS

§ 11:1 Introduction

I. POLICY CONSIDERATIONS

§ 11:2 Dangers of selective enforcement

II. DETECTION OF INFRINGING PRODUCTS

§ 11:3 Generally

III. INVESTIGATION OF SOURCES OF INFRINGEMENT

§ 11:4 Generally

§ 11:5 Private investigators

§ 11:6 Sting operations

IV. PREVENTION OF INFRINGEMENT

§ 11:7 Generally

§ 11:8 Technological approaches

§ 11:9 U.S. and foreign customs registrations

§ 11:10 Public awareness campaigns

§ 11:11 Artificial intelligence

V. ENFORCEMENT ACTIONS AGAINST INFRINGEMENT

§ 11:12 Generally

§ 11:13 The cease and desist letter

§ 11:14 Litigation

CHAPTER 12. CAUSES OF ACTION IN MERCHANDISING CASES

§ 12:1 Introduction

I. LANHAM ACT VIOLATIONS

§ 12:2 In general

§ 12:3 Jurisdictional considerations

A. FEDERAL TRADEMARK INFRINGEMENT (SECTION 32 OF THE LANHAM ACT)

1. Elements of a Section 32 Action

§ 12:4 Statutorily required elements

§ 12:5 Registration test

2. Likelihood of Confusion Tests

§ 12:6 Generally

§ 12:7 Strength of mark

§ 12:8 Degree of similarity

§ 12:9 Proximity of products

§ 12:10 Evidence of actual confusion

§ 12:11 Defendant's intent

§ 12:12 Quality of defendant's products

§ 12:13 Sophistication of the buyer

3. Remedies Available in a Section 32 Action

§ 12:14 Generally

4. Analysis of Merchandising Cases

§ 12:15 Generally

B. THE FEDERAL TRADEMARK DILUTION ACT OF 1995

§ 12:16 Historical background

§ 12:17 Federal Dilution Act of 1995

§ 12:18 Analysis of cases under the Federal Trademark
Dilution Act

§ 12:19 The Trademark Dilution Revision Act of 2006

TABLE OF CONTENTS

§ 12:20 *[Reserved]*

§ 12:21 *[Reserved]*

§ 12:22 *[Reserved]*

§ 12:23 Merchandising Cases Involving Dilution Claims

C. SECTION 43(A) OF THE LANHAM ACT

§ 12:24 Historical development

1. Elements of Cause of Action

§ 12:25 Generally

§ 12:26 Plaintiff's standing

§ 12:27 Use by defendant

2. Analysis of Merchandising Cases

§ 12:28 In general

§ 12:29 Infringement of unregistered trademark

§ 12:30 Trade dress and product configuration

§ 12:31 False advertising and unfair competition

II. COPYRIGHT INFRINGEMENT

§ 12:32 Jurisdiction

§ 12:33 Elements of cause of action

§ 12:34 Artificial intelligence and its impact on
copyright actions

§ 12:35 Analysis of cases

III. SPECIAL LEGISLATION PROTECTING SPECIFIC PROPERTIES

A. THE AMATEUR SPORTS ACT OF 1978

§ 12:36 Historical development

§ 12:37 Elements of cause of action

§ 12:38 Analysis of cases

B. OTHER LEGISLATION

§ 12:39 Generally

IV. TRADEMARK COUNTERFEITING ACT

§ 12:40 Generally

§ 12:41 Stop Counterfeiting in Manufactured Goods Act

§ 12:42 Shop Safe Act of 2020

V. PATENT INFRINGEMENT

§ 12:43 Generally

VI. CAUSES OF ACTION BASED ON STATE AND COMMON LAW

A. STATE TRADEMARK INFRINGEMENT

§ 12:44 Generally

B. STATE ANTIDILUTION LAWS

§ 12:45 Generally

C. UNFAIR COMPETITION

§ 12:46 Generally

D. MISAPPROPRIATION OF A MERCHANDISING PROPERTY

§ 12:47 Generally

E. THE RIGHT OF PUBLICITY

§ 12:48 In general

§ 12:49 Historical development

§ 12:50 Statutory protection

§ 12:51 Elements of cause of action

§ 12:52 First amendment defenses

§ 12:53 Survivability

§ 12:54 Transfer of celebrity rights

§ 12:55 General comment

§ 12:56 Impact of artificial intelligence on publicity
rights

VII. CYBERSPACE LITIGATION

§ 12:57 In general

§ 12:58 Jurisdictional considerations

VIII. ANALYSIS OF CASES

§ 12:59 Linking

§ 12:60 Metatags

IX. CYBERSQUATTING

§ 12:61 Generally

TABLE OF CONTENTS

- § 12:62 Anti-cybersquatting legislation
- § 12:63 Cases involving cybersquatting

A. DISPUTE PROCEDURES

- § 12:64 Network solutions
- § 12:65 ICANN
- § 12:66 WIPO
- § 12:67 eBay VeRO Program

CHAPTER 13. LITIGATING A MERCHANDISING CASE

I. DRAFTING THE COMPLAINT—CHECKLIST

- § 13:1 Generally
- § 13:2 Checklist

II. EX PARTE RELIEF

- § 13:3 In general

A. MOTION FOR EX PARTE TEMPORARY RESTRAINING ORDER

1. Requisite Showing

- § 13:4 Generally
- § 13:5 Likelihood of success on the merits
- § 13:6 Irreparable harm
- § 13:7 Balance of hardships
- § 13:8 Public interest

2. Posting of Bond

- § 13:9 Generally

3. Merchandising Situations Involved

- § 13:10 Generally

III. PRETRIAL PROCEEDINGS

A. MOTION FOR PRELIMINARY INJUNCTION

- § 13:11 Generally

**B. DEFENSES TO A MOTION FOR
PRELIMINARY INJUNCTION**

- § 13:12 Generally
- § 13:13 First amendment rights
- § 13:14 Fair use
- § 13:15 Equitable defenses

C. MOTION FOR SUMMARY JUDGMENT

- § 13:16 Generally

IV. THE TRIAL

- § 13:17 In general

A. EVIDENTIARY SHOWINGS REQUIRED

- § 13:18 Trademark surveys
- § 13:19 Expert witnesses

V. RELIEF AVAILABLE

- § 13:20 Injunctive relief
- § 13:21 Damages
- § 13:22 Attorneys' fees

VI. POST-TRIAL COMPLIANCE

- § 13:23 Generally

**CHAPTER 14. PROTECTION AGAINST
INFRINGEMENT IMPORTS**

- § 14:1 Introduction

I. U.S. CUSTOMS SERVICE

- § 14:2 Applicable statutes
- § 14:3 Prerequisites for obtaining protection—
Recordation
- § 14:4 Ensuring continued protection—Assignment and
renewal
- § 14:5 Excluding infringing and counterfeit goods
- § 14:6 Excluding gray market goods

TABLE OF CONTENTS

II. INTERNATIONAL TRADE COMMISSION

§ 14:7 Statutory basis

**A. ADVANTAGES OF LITIGATION BEFORE
THE ITC**

§ 14:8 Speed

§ 14:9 In rem jurisdiction

B. PREPARING THE COMPLAINT

§ 14:10 Procedural requirements

1. Elements of Cause of Action

§ 14:11 Unfair methods of competition

§ 14:12 Importation of articles or sale of imported
articles

§ 14:13 Existence of efficiently run domestic industry

§ 14:14 Destroy or substantially injure

C. PREHEARING PROCEDURES

§ 14:15 Generally

D. HEARINGS

§ 14:16 Generally

E. RELIEF AVAILABLE

§ 14:17 Generally

**CHAPTER 15. ENFORCEMENT
ACTIONS WORLDWIDE**

§ 15:1 Introduction

I. SURVEY OF JURISDICTIONS WORLDWIDE

§ 15:2 Generally

§ 15:3 Argentina

§ 15:4 Australia

§ 15:5 Benelux (Belgium; The Netherlands;
Luxembourg)

§ 15:6 Brazil

§ 15:7 Canada

THE LAW OF MERCHANDISE AND CHARACTER LICENSING

- § 15:8 Finland
- § 15:9 France
- § 15:10 Germany
- § 15:11 Hong Kong
- § 15:12 Ireland
- § 15:13 Italy
- § 15:14 Japan
- § 15:15 Republic of Korea
- § 15:16 Mexico
- § 15:17 New Zealand
- § 15:18 Norway
- § 15:19 Philippines
- § 15:20 Portugal
- § 15:21 Saudi Arabia
- § 15:22 South Africa
- § 15:23 Spain
- § 15:24 Sweden
- § 15:25 Taiwan
- § 15:26 Thailand
- § 15:27 United Kingdom
- § 15:28 Uruguay
- § 15:29 Venezuela
- § 15:30 Greece

CHAPTER 16. SPECIAL PROBLEMS FOR PROPERTY OWNERS: GRAY MARKET GOODS AND PRODUCT LIABILITY, AND ANTITRUST

- § 16:1 Gray market goods
- § 16:2 Product liability
- § 16:3 Antitrust

APPENDICES

- Appendix A. Breakdown of Registered Merchandising
Marks by International Class
- Appendix B. Trademark and Copyright Prosecution
- Appendix C. License Agreements
- Appendix D. Licensee—Manufacturer Forms
- Appendix E. Licensor Forms
- Appendix F. Litigation Forms

TABLE OF CONTENTS

Appendix G.	Summary of and Selected State Right of Publicity Statutes
Appendix H.	Copyright Office Guidance for AI
Appendix I.	International Legislation and Statutes