

# 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

## THE LAW OF MERCHANDISE AND CHARACTER LICENSING

- § 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

## THE LAW OF MERCHANDISE AND CHARACTER LICENSING

- § 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 *[Reserved]*
- § 5:58 *[Reserved]*
- § 5:59 *[Reserved]*
- § 5:60 *[Reserved]*

## THE LAW OF MERCHANDISE AND CHARACTER LICENSING

- § 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

## THE LAW OF MERCHANDISE AND CHARACTER LICENSING

- § 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

## THE LAW OF MERCHANDISE AND CHARACTER LICENSING

### 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

THE LAW OF MERCHANDISE AND CHARACTER LICENSING

**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

THE LAW OF MERCHANDISE AND CHARACTER LICENSING

- § 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

THE LAW OF MERCHANDISE AND CHARACTER LICENSING

**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

## THE LAW OF MERCHANDISE AND CHARACTER LICENSING

### 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 INFRINGING 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