
TRADEMARKS: LEGAL AND BUSINESS ASPECTS

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TRADEMARKS: LEGAL AND BUSINESS ASPECTS

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The papers published herein are based on reports made in the Spring 1993 conference at Waidring, Austria, and chaired by Hubert J. Harmeling and Eric P.A. Keyzer, Loeff Claey's Verbeke, Amsterdam, The Netherlands

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Preface

Authors from several different countries have contributed to this book, all of them scholars and practitioners in this field in their jurisdictions. Every contribution is written on the basis of the expertise of the writer and the input obtained from their exchange of knowledge and opinions during the 7th Annual Waidring Spring Conference.

The topics were chosen to address a wide range of issues which should be of interest to all those practicing in the field of trade mark law, whether litigators, agents or attorneys, but also to tax lawyers and accountants. We thought it would be a highly interesting experiment to discuss both the legal and the business aspects of trade marks in a gathering of professionals from such different disciplines. The result of these individual and joint efforts is laid down in this book covering a variety of topics on:

- (1) International registration and protection of trade marks;
- (2) Trade mark related developments in the EU including unified Germany;
- (3) Counterfeiting of branded goods;
- (4) Trade marks as business assets; and
- (5) Various issues of both commercial and legal interest such as merchandising, house marks, collective marks and trade mark dispute resolution.

Several contributions deal with the international registration and protection of trade marks as confirmed in the Paris Convention and the Madrid system which resulted from it. The extensive report on the Madrid Protocol together with the practical analysis of how this Protocol will work alongside the agreement is instructive and of particular interest, considering that President Clinton's administration is likely to submit appropriate legislation for United States accession to the Madrid Protocol shortly. Considerable attention is given to specific developments in the European Union (EU). A separate contribution regarding recent developments in EU legislation and case law regarding free movement of goods conflicting with and terms affecting trade mark protection is also included.

The impact of the EU trade mark and its filing and registration are the subject of two reports. In addition, this book deals with the consequences (especially regarding the scope of protection) of approximation of the national trade mark laws of the EU-Member States in particular.

When reading the two reports on comparative advertising and the use of a competitor's trade mark, the reader will discover the enormous contrast between the European Draft Directive and the US approach: what is normal in the United States turns out to be impossible in European countries.

A special contribution is included on the effects of the German unification on the trade marks in Germany. The report shows the impact of unification on trade mark owners.

Counterfeiting of branded goods is extensively dealt with in a number of contributions. Readers will find an excellent overview and update on the efforts through GATT, on the one hand, and through WIPO, on the other; different approaches with different appeal to *haves* and *have nots*. The commercial importance of counterfeiting, together with instructive examples, are discussed in a separate report. Different contributions on anti-counterfeiting measures and (anticipated) legislation in territories such as Australia, Canada, eastern Europe, Japan and South America are included.

The various reports dealing with trade marks as business assets cover subjects such as trade marks as collateral (especially in common law countries) and tax aspects of trade marks as well as portfolio management. Possible routing of royalties is dealt with showing how the profits of trade mark-owning companies may be increased through timely and careful tax planning. The reader's attention is also drawn to the pro's and con's of trade marks being valued on the sheet balance. These reports show once again the importance of tax law, accountancy and banking law when dealing with trade marks, as with most other forms of valuable business assets.

Furthermore, readers will find two elaborate contributions on the effects of insolvency (from a United Kingdom and partly from a United States perspective) and trade mark invalidity on license agreements.

This book further deals with subjects such as house marks, the commercial use of collective trade marks and merchandising where the relationship between product liability and merchandising has been analyzed in depth.

While collective trade marks find their basis in the Paris Convention (Article 7), house marks and merchandising are terms which are not easy to identify. House marks have been described as "the Sphinx of intellectual property". By reading the contribution on house marks, readers will get a better picture of the *lacunae* found in most jurisdictions with respect to this subject.

An interesting contribution is included regarding the attractiveness of trade mark arbitration, enforceability of arbitral awards and exempt of arbitration clauses.

As chairmen of the 7th Annual Waidring Conferences and as co-editors of this book we trust that its content will be useful to its readers and reflect the good spirit in which it was written by the respective authors.

Hub. J. Harmeling & Eric P.A. Keyzer
Chairmen
Waidring Conference
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