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THE BRANDING OF THE AMERICAN MIND: HOW UNIVERSITIES CAPTURE, MANAGE, AND MONETIZE INTELLECTUAL PROPERTY AND WHY IT MATTERS, by Jacob Rooksby, Johns Hopkins University Press, 2016. 392 pp., Hardcover, $29.95.

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American research universities faced with intensifying economic pressures are being forced to compete with increasing vigor in a variety of different but closely related academic marketplaces. These universities are competing for students and the tuition dollars they bring; "star" faculty and the intellectual and reputational capital they might generate; federal, state and local government support; and industry funds and private philanthropy. For those universities with large medical centers there is additional competition for patients and the revenues they generate. The result of this heightened competition for resources has been an increasing market-like approach to the functions of the university. In a world in which students have a growing number of choices over what, how, and where to study, universities are adopting a service provider mentality that focuses on the student as customer. They are investing heavily in distinguishing their brand and in cultivating the services they believe students will find attractive. As a former comfortable reliance on government support is overshadowed by concerns over how to capture a share of the shrinking pools of government funds, universities are increasingly positioning themselves as drivers of economic development. Robust technology transfer efforts and flexible industry partnerships are used to lure the support of corporations, and a host of carefully tailored and branded university initiatives are designed to appeal to philanthropists.

This changing regime in higher education has been aptly termed "academic capitalism".[1] In their efforts to compete for funds from external resource providers in these various marketplaces, universities are modifying their traditional functions of public knowledge production and dissemination to integrate more commercially-oriented pursuits. As part and parcel of this process of competition for resources, different constituents within the university are forced to find ways of measuring and demonstrating their value – often in quantifiable economic terms. Intellectual property plays diverse and increasingly important roles in all of these pursuits, providing mechanisms for protecting and exploiting university brands, facilitating technology transfer, and extracting commercial value from the content of new and in many cases digitalized educational programs. University administrators now see the cultivation of intellectual assets as an opportunity to both measure value as well as to generate further (economic) value. Administrations are often pressed to utilize different aspects of shared resources, such as the use of university branding to attract students on the one hand and to generate licensing revenue on the other.

Jacob Rooksby's book, THE BRANDING OF THE AMERICAN MIND provides a timely and comprehensive examination of the intersections between different forms of intellectual property and the pursuits, interests, and objectives of different constituencies within the university as it competes in these academic marketplaces. Rooksby demonstrates how the expanded use of intellectual property is both a reflection of, and a contributor to, the changing nature of the university. He warns of the need to recalibrate university policies and strategies in response to these changes to ensure that the accumulation and enforcement of private rights supports rather than subverts the university's public goods mission.

Rooksby's study provides a valuable overview of intellectual property management within higher education, making the issues of intellectual property in this context accessible in ways that allow people unfamiliar with this area of law to grapple with the challenging policy issues that underlie it. He begins the book by providing an interesting and accessible primer on the types of intellectual property that come into play in the modern American research university. He takes the time to separate out the different types of intellectual property – trademark, patent, trade secret, and copyright- and the roles that each plays within the university. Armed with this working knowledge, the reader is then invited to consider the tensions between public and private aspects of knowledge creation, dissemination, and use that are inherent in the ways that universities are choosing to capture, manage and exploit these intellectual assets.

The important role of university branding in the intensifying competition for resources makes trademark law a natural starting point. Rooksby suggests that the university brand "represents a negotiated identity, and colleges and universities in fierce competition with one another sense that they cannot risk being complacent in matters involving self-identification and self-promotion" (p. 5). He highlights the intertwined nature of university brands and trademark law and documents what he terms the phenomenon of "trademark-rights accretion" as well as the proliferation of domain names registered by universities. After investing heavily in their brands, universities naturally turn to the opportunities afforded by commercializing them. Often different groups within the university's central administration are charged with these different aspects of brand, sometimes in communication with each other--though sometimes not--each pursuing commodification of some aspect of the university identity. Rooksby warns that expansive commercialization of the university brand can jeopardize public-interest aspects of higher education.

University patenting activities provide another frontier in which the boundaries between publicly accessible knowledge and private rights are being redrawn. Since the passage of the Bayh-Dole Act in 1980,[2] universities have increasingly engaged in efforts to patent and license their technologies and inventions developed on campus. Indeed, a new profession of technology transfer professionals has arisen, which fuels the growth of this academic industry. More recently government pressure on universities to demonstrate their economic value has intensified pressures to produce measurable economic outcomes, if only in the form of inventions patented, licenses issued, or start-up companies launched. Universities are showing up more and more often in once unfamiliar terrains in their pursuit of patent-generated revenues, such as on the doorsteps of the courthouse to sue for patent infringement or in negotiations with patent assertion entities to monetize unlicensed patents. For example, in the aftermath of a very public patent dispute between two leading research universities over path-breaking CRISPR technology, both parties quickly turned their attention to the business of managing the CRISPR technology through a series of partnerships with private entities that promised millions of dollars in return. In doing so, these universities are testing the boundaries between a non-profit research institution and a for-profit corporation in ways that are becoming increasingly common.

Copyright issues have traditionally dominated debates over public access to publications. However, the new frontier of challenges in this domain lies in the shift towards on-line education, where ownership of the content becomes a more integral part of the business model of the university, and rights formerly left either implicitly or explicitly to professors now become university property. Even students are not immune from the reach of many university intellectual property policies.

The conflicts that Rooksby identifies in the intellectual property sphere both manifest and impact broader trends in American higher education, and his views are an important contribution to this conversation about the future of universities. The concerns that he expresses over what he argues is an over-protection of intellectual property are a natural result of the embrace of a more corporate-like model of the university, one that prioritizes increased efficiency and the ability to generate outcomes that have measureable economic value. This shift towards a business mindset is not limited to intellectual property but rather pervades all domains of intellectual production. However, it is the legal structures put in place to facilitate technology transfer and the commercial potential of the university's intellectual assets that make intellectual property a natural focus of business expansion.

Where universities increasingly behave like private corporations in their use and defense of intellectual property, Rooksby rightly focuses attention on the risks to the public knowledge mission of the university. He argues that risks arise, not from the ability to harness intellectual property, but rather from the operational and policy decisions of higher education institutions operating in an increasingly business-oriented and now financially challenging world. The ability to balance technology commercialization with the public creation and dissemination of knowledge is essential to the healthy university, and yet there are no clear guidelines and little consensus as to what that balance should be or how to achieve it.

The evolution of university intellectual property policies that focus on commercialization of research and education are also reflective of the rise of the administrative-university, with its commodification of the process of knowledge production and dissemination and its focus on efficiency, assessment of measurable outcomes, and attention to the satisfaction of stakeholder interests. One of the dangers of the current trend towards measurement and assessment in economic terms is the disadvantaging of types of knowledge and knowledge production that are of significant public value but nonetheless evade quantification. In pursuit only of the measurable and the measured we jeopardize areas of intellectual production that are essential to the public knowledge mission of the university.

After documenting the tensions between private rights and the public goods nature of the university that arise from what he argues is the over-protection and over-commercialization of university intellectual property, Rooksby goes on to suggest how universities might begin to recalibrate the balance between private rights and the public good. He supports a more limited approach to the accumulation and use of trademarks, advances proposals that would pull universities farther away from competitive patent market practices, and argues for a more circumscribed approach to copyright ownership. Perhaps more importantly, he advocates for a reframing of how universities understand their intellectual property issues, suggesting that intellectual property decisions should not be regarded as routine decisions left to business or legal administrators, but rather deserve full-scale treatment as core academic issues. He concludes that universities must recognize that "intellectual property policies and activities go to the heart of higher education's existence in the public sphere as primarily an academic institution, not a corporate or a bureaucratic entity" (p. 283).

While I agree that some kind of recalibration of university intellectual property policies is needed, I do suggest a note of caution in framing the debate around a rebalancing of private rights and the public good for several reasons. First, this seems to presume that different stakeholders agree that the university has a public goods mission and, furthermore, that they can reach agreement on what the public good is. Universities have always been contested spaces and will continue to be so, as different constituencies bring their own views as to what the mission of the university should be, what the public good consists of, and what processes will best promote this public good. Second, we should also consider the changing structure of the economy within which the university is situated and the changes that might be needed to ensure the sustainability of the university of the future.

The cost of university education has become unsustainable for the majority of students, many of whom find it impossible to get jobs upon graduation that pay enough to cover their growing financial investment in higher education. Universities have adopted research practices that presume a steady flow of government grant funding that can no longer be assured. Academic marketplaces are crowded with a large range of alternative providers of both research and educational programs, all competing for resources that universities once took for granted. We cannot ignore the very real economic and political constraints under which current universities must operate, and thus need to evaluate intellectual property practices with these constraints in mind.

Notwithstanding these caveats, Rooksby's message is an important one. "As the United States moves further towards an information and knowledge-based economy," he tells us, "the impetus to lay claim to intangible outputs is increasing" (p. 255). Universities, as originators of much of this production, face critical decisions about when to amass private rights in knowledge and about how to manage these private rights for the public good. It is essential for them to preserve their "fundamental value and historic orientation towards the public" by putting into place practices that ensure private rights are used for the public good.

ENDNOTES

[1] Sheila Slaughter and Larry L. Leslie, ACADEMIC CAPITALISM: POLITICS, POLICIES, AND THE ENTREPRENEURIAL UNIVERSITY (Johns Hopkins University Press, 1997).

[2] Bay-Dole Act of 1980 (Patent Rights in Inventions Made with Federal Assistance) 35 U.S.C. §§ 200 et seq.

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ARTISTIC LICENSE: THE PHILOSOPHICAL PROBLEMS OF COPYRIGHT AND APPROPRIATION, by Darren Hudson Hick. University of Chicago Press, 2017. 240 pp., soft cover, $30.00.

ILLEGAL LITERATURE: TOWARD A DISRUPTIVE CREATIVITY, by David S. Roh. University of Minnesota Press, 2015, 200 pp., soft cover, $25.00.

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Debates over intellectual property challenge the autonomy of law and attract the perspective of other academic disciplines. Two books by Professors Hick and Roh—ARTISTIC LICENSE and ILLEGAL LITERATURE bring the insights of Philosophy and English, respectively, to bear on the byzantine tangles of copyright law and policy. Separately, each offers needed reinforcement for battles over legal reform. Together, the books are documentary evidence for moving beyond the boundaries of legal thinking, whatever that may mean.

Hick and Roh both are engaging writers, embellishing their arguments with minimal use of disciplinary jargon but with a clear vision for the terms of the debate. Hick's focus is on appropriation practices in the visual arts. His first chapter follows the call of the cover, reproducing, and thereby appropriating, Mick Haggerty's "Mickey Mondrian," a 1976 painting of a just-completed Mondrian, paint dripping onto the floor into a gloppy depiction of Mickey Mouse. Copyright, Hick argues, often appeals to the natural rights of the creator, here Disney, to punish such appropriation. But Hick makes the case, based on a theory of rights, for justified appropriation, a limit on the natural rights of the creator to support the expressive freedom of artists like Haggerty. Roh advocates for appropriation as well but in the literary, textual (as opposed to visual) realm. Fan fiction is among his causes and is one example of what Roh calls a "disruptive textuality" and a "dialogic response to a creative call" (Roh, p. 127). While Hick speaks in terms of theories of rights, Roh speaks for a discursive culture steeped in digital technologies. Rights of appropriators check rights of authors, according to Hick. Appropriation is a multivalent dialogue, according to Roh.

Though the two books are steeped in different disciplines, there is much in common. Both are making the case for openness in copyright, for liberating the creative user from the grip of exclusive rights. Hick builds an argument in support of constrained natural rights for authors, the constraint being the need and rights of creative commentators. Whether this constraint in turn has roots in natural rights theory is a challenging question, but may be beside the point. There is a pragmatic turn to Hicks' book, a shift from grounding authorial rights in the nature of the creative process to limiting those rights based on the practical needs of creators to comment and develop their own works. Appropriators seem to remain second-degree creators; they do not so much have rights but needs and desires to which authorial rights must give way. Admittedly, there is something unsatisfactory about this balance. Why should appropriators be second-degree creators? Why are the rights of appropriators not as grounded in natural reason as those of authors? Roh's approach avoids these quandaries by framing the problem as one of cultural exchange rather than of rights. Creative users are part of the free exchange of texts; they are part of a dialogue that intellectual property law must acknowledge in order to realize its goals of promoting creativity. This dialogue is grounded in the practicalities of digital technology and the distribution networks and feedback dynamics such technology unleashes. Rights talk matters less for Roh than for Hick. Rather, technology facilitates interactions that exclusive rights should not deter. But, as with Hick, Roh reminds us that law must confront reality.

Shared pragmatism leads to the second common feature of the two books: their implications for law as a discipline. Both use the language of law, as is evident from the respective titles. Hick's use of the word "license" is double-edged. He is not referring to a grant from the owner but to the liberty taken by the appropriator in using the owner's work. This license, while transgressive of legal rights, is justified, as Hick demonstrates. Similarly, the "illegal" literature that Roh refers to (fan fiction, parodies, open source software) is against the law while in favor of a digital culture. Law is the target of both books even though the respective authors draw on different disciplinary arsenals. It is the villain in their respective stories of appropriation and disruption. This attitude is particularly clear in Hick's assessment of reforms to fair use proposed by leading legal scholars. "[T]his patchwork approach is insufficient for a problem that requires structural revision" (Hick, p. 173). Law is the structure to be dismantled and reconstructed, presumably using disciplinary tools that transgress and transcend law.

This last point reveals the ultimate lesson of these two books. Law itself is a discipline, a set of practices, a way of thinking, and not an overbearing monolith. Lawyers represent clients who feel violated to pursue cases that seek to establish a particular legal rule. Judges consider these cases in ways that reflect their sense of legal order. Legislators in turn establish their own sense of order counter to or reinforcing what judges have imposed. Add in the work of legal scholars, who seemingly try to make sense of all the pieces. These actors, however, are also disruptive, working against traditions and entrenched interests. They each operate within a certain discipline, which accrete into what a previous generation might have unselfconsciously called legal process. Critics of law like Hick and Roh bring their own discipline into the mix to alter the seemingly placid and unchanging universe of law. As these books demonstrate, they do so at the risk of ignoring law's own discipline.

Martijn Konings' exegesis on Michel Foucault and "disciplinary governance" is relevant here.[1] As Konings describes, Michel Foucault's "work was an argument for displacement of sovereign power by the disciplinary effects of discursive norms and epistemic techniques, and critique of theoretical perspectives that reproduced the illusions of sovereignty."[2] But, as Konings emphasizes, state agency continues on even against the discursive practices of disciplinary governance. Foucault's late lectures at the College of France reintroduce sovereignty "as a configuration of incessant transactions which modify, or move, or drastically change, or insidiously shift sources of finance, modes of investment, decision-making centers, forms and types of control."[3] The discipline of law operates at the intersection of disciplinary governance and sovereignty. Cross-disciplinary takes on law, such as the ones here by Hick and Roh, often ignore law as a discipline, but at a peril to intellectual and political engagement.

What is at stake in ignoring the discipline of law is losing sight of the political and economic interests that drive the practice of law. Both Hick and Roh tacitly understand the play of these interests. Hick recognizes them in the dominance of prominent artists in the art world; Roh, in the dynamics of the publishing industry and the censorious role of copyright. Yet, what is missing is a compelling confrontation with these interests. Instead, the authors seem to find solace in their own disciplinary customs. Their insights reveal cracks and offer a vocabulary and grammar for guiding reform. However, the fear remains that the political and economic interests will nonetheless win. Discipline serves to establish an order with the slim hope of transforming it.

Some may read this argument as a call to develop a different disciplinary approach to law. Perhaps the tools of Economics and Political Science have more to offer than Philosophy and English to the disciplinary debate. The point, however, is not about the right tools. More knowledge does not necessarily lead to better understanding or better practices. Authors like Hick and Roh help in enlivening a debate. They are engaging and stimulating to read; their ideas are seeds for hearty discussion. Real change, however, can spring from scholarship only when discipline ceases to be confining and instead unleashes a flourishing of engagement with reimagining and refashioning the order we take for granted.

Hick and Roh offer disciplinary perspectives, much of which is original and fresh. While I am skeptical of whether their perspectives offer a basis for actual reform, their books do challenge readers to think outside the borders of law's discipline even as those borders may only become further ingrained. And, perhaps, one day we might look up from whatever book we happen to be engrossed in, whatever discipline we may be practicing, and see the world has changed.

ENDNOTES

[1] Martijn Konings, CAPITAL AND TIME: FOR A NEW CRITIQUE OF NEOLIBERAL REASON, at 62 (Stanford University Press, 2018).
[2] Id.
[3] Id. at 65, citing Michel Foucault, THE BIRTH OF BIOPOLITICS, at 72 (Palgrave, 2008) (English translation of 1979 lectures).

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THE LAW AND PRACTICE OF TRADEMARK TRANSACTIONS: A GLOBAL AND LOCAL OUTLOOK, edited by Irene Calboli & Jacques de Werra. Elgar, 2016. 617 pp., Hardcover, $310.00

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Properly calibrating trademark protection requires encouraging the mark owner to use the mark to send consistent signals about source and quality through the medium of the mark. Too little trademark protection can discourage the creation of source signifying meaning and externalize search costs on to consumers. Too much trademark protection can raise barriers to entry against potential competitors. None of this meaning making and source signifying occurs in a vacuum. A well-tuned trademark regime must account for how consumers use trademarks to economize search costs (and how those consumers repurpose the mark). A trademark regime that ignores consumer perception will at best accidentally facilitate consumer welfare on those occasions when a court reaches a result favoring the litigating party whose interests align most closely with the largest proportion of consumers.[1]

When a trademark changes hands, there is a danger that consumers accustomed to the mark will be confused or deceived by the transfer. If one has become accustomed, for example, to the features of the Hostess snack cake, one might be disappointed if a new firm purchases the old Hostess marks but somehow fails to obtain old recipes, machinery, connections with ingredient sources, and the other essential elements that make a Twinkie a TWINKIE®.[2] Indeed, trademark law in the United States once barred assignments of trademark rights in most cases out of concern that an assignment could not help but deceive consumers, unless the assignee obtained the assignor's entire business lock stock and barrel. Licensing relationships were likewise forbidden, due to the harm anticipated if the licensee wasn't using the licensor's physical facilities to produce its mark-bearing goods. Those bars on assignments and licensing have been relaxed, internationally as well as in the U.S. International rules for trademark transactions are the topic of a recent volume edited by Irene Calboli and Jacques de Werra, THE LAW AND PRACTICE OF TRADEMARK TRANSACTIONS.

Overall, this book highlights the ongoing propertization of trademarks, a process that unfortunately is somewhat divorced from what many courts and scholars identify as the *raison d'être* of trademark protection: ensuring the use of the mark to inform consumers about the source and quality of mark-bearing products, and enabling consumers to rely on that mark to economize search costs. This review cannot capture the rich accounts of trademark transactions made by the chapters in this volume. Indeed, unlike the review of a book written by a single author, the multiplicity of voices makes impossible an exhaustive treatment of the various topics covered. But I provide a few highlights, with an eye toward how consumers might respond to trademark transfers and related transactions.

The book is organized into two major parts. The first thirteen chapters of the volume lay out general principles governing trademark transactions, organized into four sections. The first section provides a general international framework for trademark transactions with chapters by Daniel Gervais[3] and Marcus Höpperger.[4] The second section discusses strategic considerations. Chapters include Jane Ginsburg's discussion of how copyrighted works become trademarks and vice versa;[5] Cédric Manara's analysis of transactions for domain names;[6] a chapter from Gregor Bühler and Luca Dal Malin on how trademark portfolios are split between two or more owners;[7] and Shubha Ghosh's insightful discussion of the competition issues implicated by trademark protection in comparison with other intellectual property regimes.[8] A third section considers how trademarks are valued. Roy D'Souza discusses trademarks as a target for acquisition.[9] Jean-Frédéric Maraia explains tax strategies for trademark transfers.[10] Robert Burrell and Michael Handler expound how competing trademark and securities registries complicate secured interests in trademarks in Australia.[11] Xuan-Thao Nguyen describes uncertainties that plague licensing agreements when the licensor declares bankruptcy.[12] A final section discusses alternative dispute resolution and settlement mechanisms. Neil Wilkof examines the benefits and drawbacks of trademark consent agreements, which allow potentially confusing marks to coexist in the market.[13] Dai Yokomizo reviews international choice of law rules.[14] Jacques de Werra considers alternatives to litigation for solving trademark disputes, focusing on mediation, the Uniform Dispute Resolution Procedure for transferring rights in trademark-related domain names, and arbitration.[15]

The second half of the book offers chapters that are regionally or nationally focused. Martin Senftleben describes trademark transactions in the EU.[16] Laura Anderson considers those transactions under the UK's relatively liberal approach.[17] Axel Nordemann and Christian Czychowski describe how the German trademark system has shifted in a pro-transaction direction.[18] Nicholas Binctin discusses how the French concept of *fonds de commerce* – those physical and intangible elements that enable a merchant to engage in commerce – informs trademark transactions.[19] Irene Calboli describes rapidly dwindling U.S. limits on assignment and licensing.[20] José Carlos Vaz e Dias discusses Brazilian permutations.[21] Finally, four chapters consider trademark transactions in Asia. He Guo discusses how the relatively new Chinese trademark regime handles transfers of trademark rights.[22] Shinto Teramoto shares perspectives on a putative Japanese expansion of the right to transfer marks.[23] Susanna Leong compares trademark transaction rules among the member nations of the Association of Southeast Asian Nations (ASEAN).[24] Raman Mittal concludes the volume by discussing trademark transactions in India.[25]

These chapters show how different regimes balance the need for private ordering against consumer protection when determining how much to encourage the transfer of rights in a trademark. My initial reference point for trademark transfers is the United States trademark regime. Historically, assignment or licensing stripped protection from the mark. Free alienation of trademarks is reasonably perceived as somewhat inconsistent with the dominant consumer protection rationale for trademark law (Calboli, Chpt. 18, pp. 440-41). Courts in the early part of the 20th century denied priority to assignees and licensees to avoid "a fraud on the purchasing public who reasonably assumes that the mark signifies the same thing, whether used by one person or another"[26] (Calboli, p. 444, n.26). I pause here to note the peculiar circumstance created when addressing assignment in gross and licensing without control by deeming the mark forfeited. That remedy leaves those same consumers the law sought to protect from the fraud perpetrated by assignment in gross or naked licensing to suffer a similar fate at the hands of an appropriator whose relationship to the former mark owner is even more tenuous, or in fact nonexistent.[27]

While the consequences of making the wrong sort of assignment or carelessly licensing a mark remain grave, the requirements for valid transfers and licenses have been relaxed. Courts no longer expect consistency with regard to physical source. A mark may be assigned without elements of the associated business like the physical plant, machinery used to make the product, connections with suppliers, or employee know-how (Calboli, p. 442). Indeed, the TRIPS agreement forbids member countries like the U.S. from requiring the mark be sold with the underlying business (Calboli, pp. 446-47). U.S. courts now require only that the mark is assigned with its underlying goodwill. Unfortunately, defining goodwill is a challenge (Calboli, p. 446). The modern U.S. rule has thus relaxed requirements for assignments in a way that leads to significant potential uncertainty for assignees and licensees, while simultaneously failing to account for consumer perception and protection.

One might hope that the inquiry into goodwill might consider how consumers respond or are likely to respond to the assignment at issue, to properly balance the needs of consumers with the needs of assignors and assignees and competitors selling similar products. Courts attempt to approximate consumer perception in the assignment context by asking whether the assignee has access to the assignor's physical or intangible resources (inputs) and whether the assignee's goods or services are similar to those previously offered by the assignor under the mark (outputs). A mismatch can forfeit priority in the assigned mark. For example, in PepsiCo, Inc. v. Grapette Co., the assignee's use of the assignor's mark Peppy for a cola-flavor beverage, when the assignor had used the mark only on a pepper-flavored beverage, amounted to a fatal misalignment (*Cf.* Calboli, p. 445).[28] More recent cases embrace a relatively relaxed standard, allowing the assignee to retain priority if the assignee's goods are in the same relative product category, irrespective of differences in quality. For example, in Bambu Sales, Inc. v. Sultana Crackers, Inc., the court declined to hold that the assignee forfeited its priority when it offered cigarette paper of a distinctly lower quality than that of assignor.[29]

Assignment rules in the U.S. provide imperfect measures of consumer perception, but looking at both inputs and outputs is better suited to discover consumer opinion than the licensing rules, which look only at one type of input – the putative existence of a licensor's quality control measures. Courts don't always require actual exercise of control by licensors; the existence of a contractual provision allowing the licensor to exercise control is sometimes treated as sufficient evidence that the licensee's quality will match that of the licensor.[30] What rises to a sufficient amount of quality control is ill defined, and thus cases are inconsistent on this point (Calboli, p. 454). Even more troubling, courts rarely consider actual differences in quality in the absence of quality control measures. For example, in Eva's Bridal Ltd. v. Halanick Enterprises, Inc.,[31] the licensor forfeited its ability to rein in a runaway licensee based on the lack of quality control, even though there was no evidence of confusion or inconsistency as to quality. Indeed, the licensees were relatives of the licensor, and the stores shared the same dress designer.[32]

For firms with international trademark portfolios, or firms looking to purchase or license a mark used internationally, there is a general shift in the direction of freer transfer and licensing of trademarks, but there is as yet no harmonization. Some regimes are quite permissive. For example, the UK regime takes freedom of contract as a foundational principle (Anderson, Chpt. 15, p. 359). Such a focus results in relatively permissive rules about assignment or licensing. For instance, well-known fashion designer Elizabeth Emanuel sold off her company, which kept using her name as the mark. The Court of Justice held that even though consumers might reasonably conclude that Emanuel was still involved in designing the marked product, that mistake on the part of consumers did not rise to a level of deceit sufficient to invalidate the transfer (Anderson, p. 362).[33] Similarly, in a licensing case, Scandecor Development AB v. Scandecor Marketing AB, the House of Lords ruled that licensing without licensor control is not inherently deceptive (Anderson, p. 375-76).[34] Singapore is similarly liberal in its approach to assignment, moreso than other ASEAN members (Leong, Chpt. 22, p. 542).

Other regimes have different mechanisms to police problematic transfers, with at least an eye toward preventing consumer deception or confusion. For example, the Office for Harmonization in the Internal Market, an agency of the European Community, will refuse to register a Community trade mark (CTM) – which would otherwise qualify for protection throughout the European single market – if the CTM is likely to mislead the public with regard to the "nature, quality, or geographical origin of the goods or services for which it is registered" (Senftleben, Chpt. 14, pp. 329). The Philippines also rejects assignments found likely to mislead the public, due to inconsistencies between the products of assignor and assignee, with regard to "nature, source, manufacturing process, characteristics, or suitability for … purpose" (Leong, p. 543).

States also bring different tools to bear to discourage licensing without control. Some states, like India, use multiple mechanisms. The licensee's right to use the mark may be questioned. In addition, the licensor may forfeit the mark due to genericness or misuse. The licensor may even be responsible faulty or injurious products pursuant to a product liability claim (Mittal, Chpt. 23, pp. 571-72).

States also adopt unique solutions to notify consumers of shifting ownership. For example, in Malaysia, another ASEAN member, the assignee must advertise the assignment to notify consumers of the new relationship (Leong, p. 543). Other regimes instead use mandatory recordation with the national trademark or patent office to provide notice to interested third parties. For instance, a license is unenforceable in Japan against non-contracting parties until it is registered with the Japan[ese] Patent Office (Teramoto, Chpt. 21, p. 532). Similarly, a license in China becomes binding on third parties only upon recordation with the Chinese Trademark Office (Guo, Chpt. 20, pp. 502-03).

Mark owners will sometimes split off a portfolio of products sold under a given mark, while retaining a separate portfolio of products also sold under that mark. Splitting the market will frequently require the parties to clearly designate their respective rights. For example, if the priority in each subset of the portfolio stems back to a singular first use in commerce, then the parties may not be able to sort out their legal rights in a market through a standard priority inquiry. In such a case, the parties must necessarily contract around the conflict (Bühler & Dal Malin, Chpt. 5, pp. 103-04). Privately ordering the market in this way through some sort of coexistence deal leaves open the possibility that consumer confusion will follow in its wake (Wilkof, Chpt. 11, pp. 262, 269). Some regimes manage this risk by putting limits on the ability to split a market. For example, splitting markets is not permitted in China or Malaysia (Guo, p. 497; Leong, p. 543). Other states dictate how parties must handle split markets. For example, in Japan, the law recognizes that "simultaneous representations" may potentially confuse consumers, so one mark owner may be required to provide an extra indication or affixation with products sold in order to prevent confusion (Teramoto, pp. 532-33.)

These international regimes provide a slightly different balance between rights to contract and consumer protection. Uncertainty leads to suboptimal guidance for firms with international portfolios. The editors of this volume predict an ongoing shift in the direction of greater harmony between the various national trademark transaction regimes. Harmonization has not yet arrived but the trend line clearly favors low restrictions and freer transactions.

Advocates for more open transfer of trademarks might argue that consumer goodwill often lies fallow in the hands of a current mark owner due to inattentiveness or misuse, and repurposing or reappropriating the mark for which consumers feel nostalgia will certainly benefit those consumers, compared to the status quo. That depends in part on the approach of the firm appropriating a forfeited mark, purchasing a mark, or taking a license. Consumers can certainly be drawn to inactive or underutilized brands, and firms can capitalize by acquiring the mark and taking advantage of that pathway to consumer custom (D'Souza, Chpt. 7, p. 156). Some might wonder whether a failed brand can retain consumer goodwill, but the failure of a firm as an ongoing concern cannot always be attributed to consumer disinterest. For example, Linens ‘n Things was dissolved as a going concern when its corporate operators aggressively leveraged the company. Brands fail in part due to “quantifiable economic factors as well as subjective factors such as public perception” (D’Souza, p. 159).

Appropriations of inactive marks can also raise barriers to entry, compared to a situation where the abandoned mark has not yet been appropriated. For example, when Borders declared bankruptcy, Barnes & Noble bought the trade names and intellectual property of its now defunct competitor. Why purchase those marks? Likely with an eye to preventing a new entrant from rebranding Borders and enjoying an accelerated development of goodwill by capitalizing on consumer interest (D’Souza, pp. 158-59).

As I have argued elsewhere, the U.S. regimes are too focused on the relationship between former and current mark owners, and between incumbents and new entrants, and focused too little on the relationship between the mark and the consumer.[35] A properly aligned transfer regime would not only give lip service to the needs of consumers, but would also develop tools to measure whether consumers would benefit more from liberal transfer or some brakes on trademark alienation and licensing.[36] Perhaps tools used to value intellectual property could be brought more directly to bear on how consumers value and use marks in the hands of assignees, licensees, or post-forfeiture appropriators (*Cf.* D’Souza, pp. 152-56).

Calboli and de Werra take a decidedly agnostic approach to the correct balance between freedom of contract and the consumer protection, instead embracing a “diversity of opinions” with the goal of offering “a unique blend of doctrinal and critical interpretation of the rules related to trademark transactions” (Introduction, *xxxi*). They have reached and surpassed that goal: Those who hope for a streamlined summary of how trademark transactions operate in various national and international jurisdictions will find the volume worthwhile.

I am, however, left with the impression that the volume would have benefitted from a normative capstone. It would admittedly be difficult to provide a unified theory to synchronize the varying approaches described in each chapter. Nonetheless, an attempt to articulate lessons that could be gleaned in light of varying justifications for trademark protection would have been a welcome addition to an otherwise successful endeavor. Perhaps this review will provide the reader with a useful – if slightly critical and altogether too brief – summation of the field of trademark transactions.

ENDNOTES

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[1] Michael Grynberg, Trademark Litigation as Consumer Conflict, 83 N.Y.U. L. Rev. 60 (2008).
[2] Reg. No. 0717273 (June 20, 1961).
[3] Daniel J. Gervais, TRIPS, Trademarks, and Trademark Transactions: A Forced

Reconciliation, in THE LAW AND PRACTICE OF TRADEMARK TRANSACTIONS: A GLOBAL AND LOCAL OUTLOOK, at 5 (Calboli & de Werra, eds., 2016) [hereinafter TRADEMARK TRANSACTIONS].

[4] Marcus Höpperger, Trademark Transactions and the Normative Framework of the World Intellectual Property Organization, in TRADEMARK TRANSACTIONS, at 29.

[5] Jane C. Ginsburg, Licensing Commercial Value: From Copyright to Trademarks and Back, in TRADEMARK TRANSACTIONS, at 53.

[6] Cédric Manara, The Complexities of Domain Name Transactions: Contracts for a Market Where Value Increases with Time, in TRADEMARK TRANSACTIONS, at 82.

[7] Gregor Bühler and Luca Dal Malin, How to Make Two Out of One: The Ins and Outs of Trademark Portfolio Splitting Transactions, in TRADEMARK TRANSACTIONS, at 98.

[8] Shubha Ghosh, Competitions, Markets, and Trademark Transactions, in TRADEMARK TRANSACTIONS, at 121.

[9] Roy P. D'Souza, Brand Differentiation and Industry Segmentation: Drivers for Trademark Valuation in Corporate Transactions, in TRADEMARK TRANSACTIONS, at 149.

[10] Jean-Frédéric Maraia, Trademark Transactions and International Tax Strategies, in TRADEMARK TRANSACTIONS, at 171.

[11] Robert Burrell and Michael Handler, Registering Security Interests Over Trademarks in Australia: Theory and Practice, in TRADEMARK TRANSACTIONS, at 197.

[12] Xuan-Thao Nguyen, The Intersection of Trademarks, Licenses and Bankruptcy: Ending Uncertainties in the Law, in TRADEMARK TRANSACTIONS, at 220.

[13] Neil Wilkof, Out of the Shadows: The Unique World of Trademark Consent Agreements, in TRADEMARK TRANSACTIONS, at 255.

[14] Dai Yokomizo, Choice-of-Court and Choice-of-Law Clauses in International Trademark Transactions, in TRADEMARK TRANSACTIONS, at 276.

[15] Jacques de Werra, Alternative Dispute Resolution Mechanisms for Solving Trademark Disputes (Mediation, UDRP, Arbitration), in TRADEMARK TRANSACTIONS, at 293.

[16] Martin Senftleben, Trademark Transactions in EU Law: Refining the Approach to Selective Distribution Networks and National Unfair Competition Law, in TRADEMARK TRANSACTIONS, at 327.

[17] Laura Anderson, UK Perspectives on Trademark Transactions: A Liberal Approach, in TRADEMARK TRANSACTIONS, at 358.

[18] Axel Nordemann and Christian Czychowski, Trademark Transactions in Germany: A Continental European System Moves Towards Common Understanding with the U.S., in TRADEMARK TRANSACTIONS, at 387.

[19] Nicolas Binctin, French Perspectives on Trademark Transactions: From the Civil Code to the Business Law?, in TRADEMARK TRANSACTIONS, at 410.

[20] Irene Calboli, Trademark Transactions in the United States: Towards a de facto Acceptance of Trading in Gross?, in TRADEMARK TRANSACTIONS, at 439.

[21] José Carlos Vaz e Dias, New Dress Code for Business Transactions in Brazil: Essentials and Peculiarities of Trademarks in the Spotlight, in TRADEMARK TRANSACTIONS, at 462.
[22] He Guo, Chinese Trademark Law and Trademark Transactions: a Law in Transition in the Global Economy, in TRADEMARK TRANSACTIONS, at 485
[23] Shinto Teramoto, Japanese Perspectives on Trademark Transactions: Is Expansive Trademark Practice Prevailing Over the Conservative Stoicism?, in TRADEMARK TRANSACTIONS, at 511.
[24] Susanna H. S. Leong, Trademark Transactions in ASEAN: Convergences and Divergences in Emerging Markets, in TRADEMARK TRANSACTIONS, at 537.
[25] Raman Mittal, Trademark Transactions in India: Exploring the Genre, Scope and Consequence, in TRADEMARK TRANSACTIONS, at 558.
[26] Marshak v. Green, 746 F.2d 927, 930 (2d Cir. 1984). See also Macmahan Pharmacal Co. v. Denver Chem. Mfg. Co., 113 F. 468, 474–75 (8th Cir. 1901) ("A trade-mark cannot be assigned, or its use licensed, except as incidental to a transfer of the business or property in connection with which it has been used.").
[27] Jake Linford, Valuing Residual Goodwill After Trademark Forfeiture, 93 Notre Dame L. Rev., 811, 835 (2017).
[28] PepsiCo, Inc. v. Grapette Co., 416 F.2d 285, 290 (8th Cir. 1969).
[29] Bambu Sales, Inc. v. Sultana Crackers, Inc., 683 F. Supp., 899, 907 (E.D.N.Y. 1988).
[30] See, e.g., Robinson Co. v. Plastics Research & Development Corp., 264 F. Supp., 852, 864 (W.D. Ark. 1967) ("[I]t is the right to control rather than the actual exercise of control which determines whether or not a licenses [sic] is valid ….").
[31] 639 F.3d 788 (7th Cir. 2011).
[32] See also Linford, 93 Notre Dame L. Rev., at 832.
[33] Case C-259/04, Emanuel v. Continental Shelf 128 Ltd. [2006] E.C.R. I-3089.
[34] Scandecor Development AB v. Scandecor Marketing AB and Others and One Other Appeal [2001] UKHL 21, [34], [2001] All E.R. 29 (H.L.) [38] (appeal taken from Eng.).
[35] Linford, 93 Notre Dame L. Rev., at 833.
[36] For the author's attempt to develop such a tool, see Linford, 93 Notre Dame L. Rev., at 851-56.