**15.15 Trademark Ownership—Assignee
(15 U.S.C. § 1060)**

The owner of a trademark may [transfer] [sell] [give] to another the owner’s interest in the trademark, that is, the right to exclude others from using the mark. This [transfer] [sale] [gift] is called an assignment, and the person to whom this right is assigned is called an assignee and becomes the owner of the trademark.

 [The assignment must be in writing and signed.] To be enforceable, the assignment must include the goodwill of the business connected with the mark.

 An assignee may enforce this right to exclude others from using the trademark in an action for [infringement] [or] [*insert applicable form of unfair competition from 15 U.S.C. § 1125(a)*].

 [The plaintiff is an assignee, who has received an enforceable ownership interest.]

**Comment**

 “The purpose behind requiring that goodwill accompany the assigned mark is to maintain the continuity of the product or service symbolized by the mark and thereby avoid deceiving or confusing customers.” *E. & J. Gallo Winery v. Gallo Cattle Co.*, 967 F.2d 1280, 1289 (9th Cir. 1992). Whether goodwill is transferred is a factual issue. *Id.*

 A trademark assigned without the underlying goodwill (including a transfer of underlying assets or rights) is sometimes referred to as a trademark “assigned in gross,” which fails to transfer enforceable trademark rights. “The law is well settled that there are no rights in a trademark alone and that no rights can be transferred apart from the business with which the mark has been associated.” *Mister Donut of Am., Inc. v. Mr. Donut, Inc.*, 418 F.2d 838, 842 (9th Cir. 1969). For a discussion of the goodwill requirement, *see* 3 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 18:2 (5th ed. 2019).

 In a case brought under the Lanham Act, a signed writing is necessary for an assignment to be valid. 15 U.S.C. § 1060. A signed writing is not required to prove an assignment in a common law trademark infringement claim. McCarthy, *supra*, § 18:11.

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