



International Trademark Association
Representing Trademark Owners Since 1878

5 September 2007

European Court of Justice
Cour de Justice des Communautés Européennes
L-2925 Luxembourg

Re: *Intel Corporation, Inc. v CPM United Kingdom Ltd, Court of Appeal, Civil Division, 15 May 2007 [2007] All ER (D) 218 (“the Intel case”)*

Dear Sir

The International Trademark Association (“INTA”), through its Europe Amicus Subcommittee, has prepared this submission in relation to the case *Intel Corporation Inc. v. CPM United Kingdom Ltd.*

A. INTA’s interest in the case

1. Although The International Trademark Association (INTA) is not a party in this case and it recognises that the European Court of Justice does not have a procedure for accepting *amicus curiae* intervention, INTA (which represents a wide range of users of trademark systems) believes that this case is significant to the development of trademark law.
2. INTA wishes to put forward submissions in this case on behalf of its members and hopes that its comments (prepared through its European Amicus subcommittee) may be of assistance to the Court.

B. Background to INTA

3. INTA is a 128 year old not-for-profit organisation of trademark owners and practitioners from more than 180 countries throughout the world with offices in Brussels, Shanghai and New York. INTA is dedicated to the support and advancement of trademarks and related intellectual property concepts as essential elements of commerce.
4. INTA’s membership includes over 1000 companies, across all industry lines, including manufacturers and retailers in industries ranging from aerospace to consumer goods and service providers, law firms and trademark attorneys in all 27 member states of the European Union (EU).
5. An important objective of INTA is to protect the interests of the public by the proper use of trademarks. In this regard, INTA strives to advance the development of trademark and unfair competition laws and treaties throughout the world, based on the global public interest in avoiding deception and confusion. INTA has been an official non-

governmental observer to the World Intellectual Property Organisation (WIPO) since 1979 and actively participates in all trademark related WIPO proposals. INTA has influenced WIPO trademark initiatives such as the Trademark Law Treaty and is active in other International arenas including the Asia-Pacific Economic Cooperation Forum (APEC), the Association of South East Asia Nationals (ASEAN), the European Union and the World Trade Organisation (WTO).

6. Since 1916, INTA has acted in the capacity of advisor and has appeared as Amicus Curiae (friend of the Court) in various jurisdictions. A list of some of these briefs is attached as Annex 1.

II. Questions referred to ECJ

7. The questions referred to the European Court of Justice by the English Court of Appeal are as follows :

1. For the purposes of Art. 4(4)(a) of the First Council Directive 89/104 of 21st December 1988, where:

- (a) the earlier mark has a huge reputation for certain specific types of goods or services,

- (b) those goods or services are dissimilar or dissimilar to a substantial degree to the goods or services of the later mark,

- (c) the earlier mark is unique in respect of any goods or services,

- (d) the earlier mark would be brought to mind by the average consumer when he or she encounters the later mark used for the services of the later mark,

are those facts sufficient in themselves to establish (i) “a link” within the meaning of paragraphs [29] & [30] of *Adidas-Salomon AG v Fitnessworld Trading Ltd*, Case C-408/01, [2003] ECR I-2537 and/or (ii) unfair advantage and/or detriment within the meaning of that Article?

2. If no, what factors is the national court to take into account in deciding whether such is sufficient? Specifically, in the global appreciation to determine whether there is a “link”, what significance is to be attached to the goods or services in the specification of the later mark?
3. In the context of Art. 4(4)(a), what is required in order to satisfy the condition of detriment to distinctive character? Specifically, does (i) the earlier mark have to be unique, (ii) is a first conflicting use sufficient to establish detriment to distinctive character and (iii) does the element of detriment to distinctive character of the earlier mark require an effect on the economic behaviour of the consumer?

III. Article 4(4)(a) of First Council Directive (EEC) 89/104

8. Article 4(4)(a) sets out the following :

“Any Member State may furthermore provide that a trade mark shall not be registered or, if registered, shall be liable to be declared invalid where, and to the extent that:

the trade mark is identical with, or similar to, an earlier national trade mark within the meaning of paragraph 2 and is to be, or has been, registered for goods or services which are not similar to those for which the earlier trade mark is registered, where the earlier trade mark has a reputation in the Member State concerned and where the use of the later trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

9. INTA suggests that in looking at what is required to determine whether a sign is validly registered or registerable, it is important to return to and focus on the elements of Article 4 (4)(a).

The elements of Article 4 (4)(a)

10. Article 4(4)(a) applies to circumstances where:

- An earlier trademark and a later sign are identical or similar (which was conceded in the *Intel* case)
- The earlier mark has a reputation (in the *Intel* reference the national court has found on the facts that the reputation of the mark is huge, so this element is satisfied)
- The earlier mark is registered (the Article as drafted requires registration for dissimilar goods and services but as a result of *Adidas and Davidoff & Cie SA, Zino Davidoff SA v Gofkid Ltd*, Case C-292/00, [2003] ECR I-389, this also applies where the goods or services are identical or similar).
- The use of the sign is without due cause (this element is not an issue in this case and is not considered further)
- The use of the sign would
 - take unfair advantage of or
 - cause detriment to

the distinctive character or repute of the trademark.

11. INTA submits that determining if the requirements of unfair advantage or detriment are satisfied requires a consideration by the Court of the following:

- (i) What constitutes a relevant unfair advantage or detriment?
- (ii) Does the required unfair advantage or detriment arise on the facts of the case, assessing all those facts through the global appreciation test?
- (iii) What level of proof is required for unfair advantage/detriment?

12. The questions to the Court in the *Intel* case focus on the issue of whether there is a “link” between the sign and the earlier mark. INTA submits, for reasons explained below, that focussing separately on the link may be less helpful than focussing on the elements of Article 4(4)(a) and determining whether:
- based on a **global appreciation** of all the circumstances,
 - there has been (or is a likelihood of) **unfair advantage or detriment**
 - as a **result** of use of the sign (since Article 4(4)(a) requires that the sign “would take unfair advantage or be detrimental to” the earlier mark).
13. INTA acknowledges that the purpose of Article 4 (4)(a) is not to prevent the registration/use of *any* sign which is identical or similar to an existing mark with a reputation but only those which are likely to be detrimental to the distinctive character or repute of the mark (see *Sigla v Elleni* (Case T-215/03 paragraph 46)) or take unfair advantage of it.

C. Proposed answers to the questions referred

14. INTA’s view on the questions is as follows:

Question (i)

15. It is not possible to say whether the facts set out in Question (i) are sufficient to give rise to a link and/or unfair advantage and/or detriment in the abstract. This is a question that must be decided on all the circumstances of the case, applying the global appreciation test. Further,
16. “A ‘link’ is not of itself sufficient to give rise to liability. It must be shown that use of the sign (through a global assessment of all the circumstances) gives rise to unfair advantage and/or detriment.”
17. It is suggested that if the sign can be shown to be likely to cause detriment and/or take unfair advantage, that should be sufficient within the terms of the Directive, without the need explicitly to identify “a link”.

Question (ii)

18. It is well established that marks are to be considered on a global basis for the purposes of Article 4(1) of the Council Directive 89/104/EEC and the same type of global analysis is appropriate for the interpretation of Article 4(4)(a). The global assessment of the marks will include the usual factors including distinctiveness (inherent or acquired), similarity or otherwise of the goods/services and extent of reputation of the mark as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer, Inc* Case C-39/97 [1998] ECR I-05507. All relevant factors should be taken into account and the significance of any particular factor, such as the goods or services, will depend on the facts of the case. INTA submits however that the global appreciation should be directed at assessing whether unfair advantage or detriment is found and is not a determining factor whether there is a “link” which is merely one of the relevant factors.

Question (iii)

19. The requirement of detriment should not depend on any single factor, such as the unique quality of the mark or whether the sign is the first conflicting use, but should be assessed taking into account all relevant circumstances.
20. The uniqueness or otherwise of the mark and the coexistence of similar marks in the market are similarly factors to be taken into consideration since the inherent distinctiveness per se of a mark will give greater value to a mark and may be offset by a lesser similarity of the goods/services. The risk of detriment will likely be lower if the earlier mark consists of a term which, because of a meaning inherent in it, is very common and frequently used.
21. The proprietor of the earlier mark need not demonstrate actual and present harm to his mark but must adduce prima facie evidence of a future risk, which is not hypothetical, of unfair advantage or detriment. The assessment of detriment should not require an effect on the economic behaviour of the consumer but may take a number of different forms (as discussed in Section E below).
22. Set out below is an analysis of the 3 considerations identified in paragraph 11 above, which INTA suggests are relevant to establish if Article 4(4)(a) is to apply.

D. The Global Appreciation test

23. INTA submits that whether unfair advantage or detriment is likely is a question to be determined through the application of the global appreciation test. It is not appropriate to say that a particular combination of fact will necessarily give rise to detriment. All the other circumstances of the case (which are considered as part of the global appreciation test) will potentially impact upon whether detriment or unfair advantage will result (eg the level of distinctiveness).
24. INTA respectfully submits that it is for each national court to assess in all the circumstances of a particular case whether, based on a global assessment, the use of the sign is likely to cause detriment (*Adidas* paragraphs 29 and 30). The impact of the later mark (ie its ability to cause detriment or unfair advantage) will depend on all the factual circumstances of the case (*Spa Monopole v OHIM* Case T-67/04 [2005] ECR II-01825 paragraph 41).
25. The circumstances to be taken into account in assessing whether there is likely to be detriment or unfair advantage include the degree of similarity of the marks, the presence of similar earlier marks on the register, the reputation of the senior mark, degree of distinctiveness of the marks, the degree of similarity between the goods/services, the market share represented by the marks, extent and intensity of use/reputation, geographical extent and duration of use and the size of the investment made in building and protecting the mark (see e.g. *Antartica Srl v OHIM – The Nasdaq Stock Market Inc.*, Case T-47/06 [2007] ECR 00).
26. As Advocate General Jacobs put it in his opinion in *Adidas* (Opinion delivered on 10 July 2003) paragraph 50:

“National courts will be able to decide, without further analysis of the concept of similarity, whether the similarity is such as to make possible the use complained of, be it in the form of dilution, degradation or free-riding. It is therefore sufficient in my view to note that Article 5(2) requires (i) that the mark and sign be similar and (ii) that the use complained of take unfair advantage of, or be detrimental to, the distinctive character or the repute of the mark.”

27. In the case of *L’Oreal SA v Bellure NV* (High Court Chancery Division - England and Wales 4/10/2006 [2006] EWHC 2355 (Ch)) Lewison LJ referred to the *Mango* case (OHIM First Board of Appeal Case R 308/2003-1 *Mango Sport System Srl Socio Unico Mangone Antonio Vincenzo v Diknah* [2005] E.T.M.R. 5) and stated the following :

“The mischief clearly was that the manufacturer of crash helmets would increase his sales by feeding on the reputation acquired by the manufacturer of clothing. In other words, the one mark supports (or would support) the other. The mere fact that one product has a free ride on another does not necessarily found liability but if the respective marks and signs do not have the necessary degree of similarity, that kind of free riding is legally permissible. Thus it is the similarity between sign and mark, not similarity between products, which is the key”.

Accordingly, the unfair advantage or detriment must be caused by the similarity, but only in part, since other factors are also relevant to whether unfair advantage or detriment results.

28. A lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods/services and vice versa and there is a greater likelihood of unfair advantage and detriment where the earlier trademark has a highly distinctive character either per se or because of the use that has been made of it (as is the case for confusion see *Sabèl B. V. v Puma AG* Case C-251/95 [1997] ECR I-06191). Accordingly, the adoption by another trader of a sign which is similar or identical to a mark with a reputation that has a high degree of distinctive character (whether through use or because it is inherently distinctive) and is particularly well known, is more likely to result in detriment to that mark than it would were the mark descriptive or less well known. Similarly, the greater the degree of similarity between the mark and sign the more likely that detriment will occur (see *General Motors Corporation v Yplon SA* Case C-375/97 [1999] ECR.I-5421 paragraph 30). The strength of some factors may outweigh other weaker factors. For example, even where goods are dissimilar, if a sign is used on goods with undesirable associations (eg. weapons), this may well cause detriment. This underlines the need to consider all relevant facts.
29. INTA suggests that it is helpful to identify relevant factors (as in paragraph 20) which are relevant to the global appreciation test but that those identified should not be taken as an exhaustive list. The group of factors which is relevant and the weight to be given to them may be different in different factual situations.
30. INTA makes no comment on the application of the legal principles to the particular facts in the *Intel* case which is a matter for the national court.

E. What constitutes unfair advantage or detriment?

Unfair advantage

31. Unfair advantage encompasses instances where there is a “clear exploitation and riding on the coat-tails” of the famous mark or an attempt to trade on its reputation (*Sigla* paragraph 40). In other words, the marketing of the goods under the later sign is made easier by the association with the earlier mark (or its image is transferred).

Detriment

32. The detriment may take a number of different forms (as identified by the CFI in *Sigla* and the *Spa Monopole* case paragraphs 43-53):
 1. where the earlier mark is no **longer capable of arousing immediate association** with the goods for which it is registered. In other words, there is a dilution or gradual whittling away of the mark through the dispersion of its identity and hold on the public mind. This was also recognised by the AG in *Adidas* and in *Premier Brands UK Ltd v Typhoon Europe Ltd* [2000] E.T.M.R. 1071 where the court indicated that “blurring” was actionable where there was a likelihood that the use of a sign would diminish the ability of the mark exclusively to call to mind the proprietor’s goods. This detriment caused by “blurring” was also acknowledged in the *NASDAQ* case paragraph 55, where the court was concerned that the use of an identical mark for different services made it likely that *NASDAQ* might cease to be an immediately recognised reference to an electronic stock exchange
 2. where the **power of attraction of the mark is diminished** as a result of the use of the sign, e.g. the characteristics or quality of the goods sold under the sign may have a negative influence on the image of the earlier mark **on account of** the sign being identical or similar to the earlier mark (*Sigla* paragraph 39 and Opinion of AG in *Adidas* point 38).
33. The Court of Appeal in the *Intel* case appears to have suggested that a further element be introduced to the requirements of Article 4(4)(a). Jacob LJ indicated (paragraph 34) that the **detriment** must relate to the mark used for the goods for which it is registered. INTA submits that such a requirement introduces an unnecessary level of uncertainty. The focus should simply be on whether the earlier mark suffers the required taking of unfair advantage or detriment as a result of the use of the later sign. In *Sigla* (paragraph 35), the CFI acknowledged that a mark has an inherent economic value which is independent of the goods and services for which it is registered and that value is significant and deserves protection. In any event, the use of an identical or similar sign for goods for which the mark is not registered may nonetheless affect the distinctive character or repute of the mark in the field in which it is registered because it is no longer capable of arousing immediate attention or its power of attraction is diminished, particularly where it is a mark with a strong reputation. In other words, its distinctiveness for the goods for which it is registered may be diluted or the image adversely affected (as per *Sigla* paragraph 35) by use of a sign for other categories of goods.

F. The Link

The relevance or otherwise of “the link”

34. The ECJ has indicated that (for Article 4(4)(a)) it is not necessary to establish confusion, it is sufficient that a “link” is established between the earlier mark and the later mark or sign.
35. INTA submits that it is possible to apply the global assessment test and identify whether the use of the later mark or sign is likely to lead to (i.e. cause) detriment to the earlier mark without the additional requirement of a link. This approach would avoid some of the confusion that has arisen in the case law over the interpretation of the concept of a link. An alternative way of looking at it is that the existence of some sort of link (whether it be as weak as a mere calling to mind or as strong as confusion as to origin) is a relevant factor to be taken into account in the global appreciation test. It might also be possible to characterise “the link” as the causal connection between the use of the sign and the detriment or unfair advantage to which that use gives rise.
36. To the extent that a link is required, INTA submits that it should be analysed in accordance with the approach of the ECJ in *Sabèl paragraph 16*) and interpreted broadly. The Advocate General in *Adidas paragraph 45*, drew a helpful distinction between direct and indirect confusion and association which result from the degree of similarity between the marks:
- Direct confusion between a sign and mark refers to situations where the public thinks that the goods sold under the sign come from the same source (i.e. from the same or an economically linked undertaking) as those sold under the earlier mark.
 - Indirect confusion refers to the situation where the public makes some other connection between the goods sold under the mark and sign, i.e. that the goods sold under the sign are produced under licence from the proprietor of the mark.
 - Association occurs where the public is not confused but the sign “calls to mind” the mark.
37. In all 3 situations a “link” between the sign and mark is perceived but the link in the first two is strong enough to amount to confusion. It follows that, while confusion may form a basis for the application of Article 4(4)(a), it is not required, i.e. either confusion or a lesser form of link (“pure association”) may be sufficient.
38. Conversely, establishing a link is not of itself sufficient to satisfy the requirements of Article 4(4)(a) (see eg. *Spa Monopole paragraph 44*). The important question is whether the use of the later sign causes detriment or takes unfair advantage. In *Premier Brands*, the court identified a potential impact on the value, force or effect of the mark. Another way of looking at it is that confusion is a form of detriment so, where confusion is not proven, some other form of detriment is required. The existence of a link is in any case to be appreciated globally (see *Adidas paragraphs 29 and 30*).

The Benelux and German approaches

39. Both under Benelux and German case law, there is no need for a likelihood of confusion between the trademarks. With regard to the “link” to be established by the consumer between the trademarks, this is part of or a consequence of the other factors to be taken

into account, i.e. reputation of the mark, similarity of goods and services, similarity of signs.

40. The question asked by German Courts would be: "Is the similarity of the signs and/or similarity of goods and services and/or the reputation of the earlier trademark sufficiently high so that unfair advantage is taken of or detriment is caused to the earlier trademark?". For example, if the trademark is sufficiently known to the public, the public will most likely associate the younger trademark with the earlier trademark; provided however that this leads to an unfair advantage/a detriment.
41. Benelux courts would apply a similar test: "Is the similarity and/or link between the trademarks such that (without due cause) unfair advantage or detriment is caused to the distinctive character of the trademark?"
42. Article 4 (4) of the Trademark Directive is not implemented into Benelux law. Article 5 (2) is implemented into Benelux law by copying the text of the Directive into the Benelux Treaty on Intellectual Property. With regard to German law, both provisions have been implemented in the German Trademark Act.
43. Attached at Annex 2 are details of some of the Benelux and German case law on the issue. Some of these cases relate to infringement actions but the comments made on the approach to global assessment remain relevant to the issues arising on registration.

Economic consequences/connection

44. In some cases the link has been expressed in terms of making a "connection" (*see the AG in Adidas*) but it is submitted that this may be misleading as it suggests a need for a perception of some economic connection e.g. licensing, which would amount to indirect confusion. In INTA's view this is an inappropriate limitation since it is not necessary to show confusion. In addition, INTA considers that nothing is gained by separately analysing whether a link arises. Use of a sign which is sufficiently similar to a mark with a reputation may have an effect on the public which will lead to detriment or a taking of unfair advantage and satisfy the requirements of Article 4(4)(a), despite falling short of conveying a suggestion of an economic connection between the owners of the two marks. This was well expressed by the CFI in *Sigla* (paragraph 42) in the following terms:
"the consumer, without necessarily confusing the commercial origin of the product or service in question, is attracted by the mark applied for itself and will buy the product or service covered by it on the ground that it bears the mark, which is identical or similar to an earlier mark with a reputation"
45. This approach is consistent with the existing cases that note that showing the existence of a link is not sufficient to demonstrate a risk of detriment (*see Spa Monopole*). In practice of course, where a detriment arises **as a result of** the similarity of the marks, it will be possible to identify a link. It is submitted however that it is preferable to simply analyse the position in terms of whether the mark and sign are sufficiently similar to give rise to detriment to the mark. This is consistent with the approach in the TDK case (*Aktieselskabet v OHIM – TDK Kabushiki Kaisha (TDK Corp.) Case T-477/04* where the CFI concluded that the Board of Appeal had been right to conclude that the uses of

the mark could encourage the public to buy the goods by reason of the association between the sign and mark. In *L'Oreal*, the Court similarly concluded that there must be a causal link between the use of the mark and the tarnishment or blurring.

46. In some cases, it has been suggested that the link be one that leads to economic consequences or an effect on the economic behaviour or consumers (see Patten J in *Intel v CPM* [2006] EWHC 1878 (Ch). In *Electrocoin Automatics Ltd v Coinworld Ltd and others* [2004] EWHC 1498 (Ch) it was proposed that a mere “calling to mind” is not sufficient, there must be an effect on economic behaviour. *Hachette Filipacchi Presse SA v Saprotex International (Proprietary) Ltd* [2007] EWHC 63 (Ch). It is submitted that this similarly adds an unnecessary further element to the assessment that should already be encompassed within the assessment of detriment and that seeking to recharacterise detriment as requirement of an economic connection may cause uncertainty. In practice, there is likely to be an economic consequence in that the consumer chooses to buy the goods sold under the sign rather than those sold under the mark. However, the detriment should not be limited to such consequence.

Calling to mind

47. INTA takes the view that a “mere calling to mind” of a mark by a sign is not sufficient to give rise to detriment/unfair advantage. The global assessment must lead to the conclusion that the use of the sign by virtue of its similarity to a mark with a reputation, and the other circumstances of the case is likely to result in detriment to the earlier mark.
48. INTA respectfully submits that the Court of Appeal in the *Intel* case set the bar too high for the requirement of a link. Jacob LJ (see paragraphs 29-35) expressed the view that the mere “calling to mind” of a mark is too tenuous a connection to give rise to liability but goes considerably further in suggesting that what is required is a perception that there is a “trade connection” between the owners of the two marks, or at least that the public wonder whether there is such a connection. With respect, this concept of a trade connection seems dangerously close to the requirement of confusion (which, it is well established, need not be proven for Article 8(5) (see eg. *Sigla* paragraph 41)) and demonstrates the difficulties that arise in analysing the elements of the Article by reference to the need to establish a link, though the existence of a link is likely to be a relevant factor.
49. INTA submits that the Court of Appeal’s suggested formulation goes well beyond the requirement of a link and amounts to a requirement that there be a finding of indirect confusion. In INTA’s submission this is too restrictive, provided there is unfair advantage or detriment, it should not be necessary to establish confusion (nor explicitly a link).

G. Proof of detriment or unfair advantage

50. INTA submits that it is well established that it is not necessary to show actual or present detriment. A probability of a future non hypothetical risk of detriment (or unfair advantage) must however be shown. In other words, as the Court of Appeal put it in the *Intel* case, there must be a real and tangible prospect of damage. (see also *NASDAQ* case) There must however be *prima facie* evidence of this risk, of why and how it might arise (*Sigla* paragraph 46-48 and *Spa Monopole* paragraph 40)).

51. The assessment of the evidence and the risk of detriment is a question for the national court in all the circumstances, applying the global appreciation test. The court is entitled to draw inferences from an analysis of the probabilities (see *NASDAQ* paragraphs 54 and 55). Where the mark has an exceptionally high reputation, it is possible that the probability of a future non hypothetical risk of detriment is so obvious that no other fact need to be proven (*Sigla* (paragraph 48) but this will not always be the case and it cannot be assumed). INTA makes no comment on whether this requirement is satisfied on the facts of this case.

Sincerely,

A handwritten signature in black ink, appearing to read "Alan C. Drewsen". The signature is written in a cursive, flowing style with a long horizontal stroke at the end.

Alan C. Drewsen
Executive Director

ANNEX 1

The International Trademark Association has filed the following *amicus*-type submissions in cases before European courts:

- Submission as intervener to the English Court of Appeals on October 16, 2006 in the case *Special Effects v L'Oreal SA* (HC 05C012224, Court of Appeal 2006 0744).
- Letter of submission to Bovemij Verzekeringen N.V. on June 17, 2005 in the case *Bovemij Verzekeringen N. V. v. Benelux Merkenbureau* (ECJ - C-108/05).
- Letter of submission to Schering-Plough Ltd. on December 5, 2003 in the trademark case *Schering-Plough Ltd v. European Commission and EMEA* (CFI T-133/03).
- Letter of submission to Merck Inc. on April 4, 2003 in the trademark case *Paranova A/S v. Merck & Co., Inc, Merck, Sharp & Dohme B.V. and MSD (Norge) A/S* (EFTA Court E-3/02).
- Letter of submission to Praktiker Bau - und Heimwerkermärkte AG on March 20, 2003 in the trademark case *Praktiker Bau – und Heimwerkermärkte AG* (ECJ C-418/02).
- Letter of submission to Shield Mark on November 1, 2001 in the trademark case *Shield Mark v. J. Kist* (ECJ C-283/01).
- Letter of submission to Libertel Groep B.V. on July 6, 2001 in the trademark case *Libertel Groep B.V. v. Benelux Merkenbureau* (ECJ - C- 104/01)
- Letter of submission to Glaxo Wellcome Limited on October 10, 2000 in the trademark case *Glaxo Wellcome Limited v. Dowelhurst Limited and Swingward Limited* (ECJ - C-143/00).

The International Trademark Association filed the following *amicus curiae* briefs before the United States Supreme Court and other United States Federal Courts:

- *Louis Vuitton Malletier v Haute Diggity Dog LLC*, No. 06-2267 (4th Cir. 2007).
- *Contessa Premium Foods, Inc. v. Berdex Seafood, Inc. et. al.*, 126 S. Ct. 472 (2005) (petition for certiorari).
- *Test Masters Educational Services, Inc. v. Singh and Singh v. Test Masters Educational Services*, 428 F.3d 559 (5th Cir. 2005).
- *KP Permanent Make-Up, Inc. v. Lasting Impression Inc. and MCN International Inc.*, 125 S. Ct. 542 (2004).
- *Dastar Corporation v. Twentieth Century Fox Film Corporation, SFM Entertainment LLC and New Line Home Video, Inc.*, 540 U.S. 806 (2003).
- *Mosely v. V Secret Catalogue, Inc.*, 537 U.S. 418 (2003).

- *TraFFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23 (2001).
- *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205 (2000)
- *College Sav, Bank v. Florida Prepaid Postsecondary Educ. Expense Bd.*, 527 U.S. 666 (1999).
- *Dickinson v. Zurko*, 527 U.S. 150 (1999).
- *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159 (1995).
- *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992).
- *KMart Corp. v. Cartier, Inc.*, 486 U.S. 281 (1988).
- *WarnerVision Entertainment Inc. v. Empire of Carolina, Inc.*, 101 F.3d 259 (2d Cir. 1996).
- *Preferred Risk Mut. Ins. Co. v. United States*, 86 F.3d 789 (8th Cir. 1996).
- *Conopco, Inc. v. May Dep't Stores Co.*, 46 F.3d 1556 (Fed. Cir. 1994).

The International Trademark Association has filed the following *amicus-type* submissions and affidavits in jurisdictions outside Europe and the United States:

- Brief of *amicus curiae* in the Supreme Court of the Republic of Indonesia in April 2007 in the trademark case of *Prestone Products Corporation v Pt. Teguh Mulia Perdana and Drs. Nengrat Kwandou* (Case No. 78/ MEREK/2006/PN.NIAGA.JKT.PST).
- Factum to the Supreme Court of Canada on July 4, 2005 in the case of *Veuve Clicquot Ponsardin, Maison Fondée en 1772 v. Les Boutiques Cliquot Ltee, Mademoiselle Charmante Inc. and 3017320 Canada Inc.*
- Letter of submission to the Supreme Court of Justice of Paraguay on March 26, 2003, in the trademark case *Tabacalera Boquerón SA. vs. Nobleza Piccardo SACI and/or BAT and/or BAT BRANDS Limited* (Report No. 47/97, Inter-Am. C.H.R., OEA/Ser.L.V/II95 Doc. 7 rev. at 225(1997)).
- Brief of *amicus curiae* in the Supreme Court of Korea on September 27, 2003 in the trademark case *Prefel v. Jae Ik Choi* (2001-HU-1358-10 December 2002).
- Letter of submission to the Beijing High Court, Intellectual Property Tribunal on October 11, 2000 in the trademark case *Ikea Inter-Systems Inc. v. Beijing Cinet co Ltd*, (2000) Gao Zhi Zhong Zi No. 76.
- Affidavit to the Moscow City Court (Russia) on April 9, 1998 in the trademark case *Heublein Inc. v. Appeals Chamber of Rospatent* (Civil case No. 3-7/98).
- Affidavit to the Supreme Court of South Africa (Durban and Coast Local Division) on November 8, 1995 in the trademark case *McDonald's Corporation v. DAX Properties CC and JoBurgers Drive Inn Restaurants (PTY) Limited* (1997 1 SA 1 (A)).

ANNEX 2

German case law

The following examples can be found in German case law.

- Federal Court of Justice "Rolls Royce" (NJW 1983, 1431) - The court decided that the "posed" scenic representation of an automobile well-known for its exclusiveness in a whisky advertisement can constitute an exploitation of Rolls Royce's reputation.

Here, no likelihood of confusion was needed; the mere exploitation of the value of the well-known product was sufficient. Please note that this decision was based on unfair competition law, but this is deemed to be still applicable under the provisions of the German trademark law which replaced the old provisions.

- Court of Appeal Berlin "Gute Zeiten, schlechte Zeiten" (GRUR 2000, 906) - "By choosing a term similar to the well-known term "good times, bad times", i.e. "good neighbors, bad neighbours", the positive associations linked to the well-known term are transferred".
- Court of Appeal Hamburg "die tagesschau" (GRUR-RR 2002, 389) - "The use of a well-known trademark (tagesschau, meaning daily news) as a title for a print article exploits the reputation of the earlier trademark as, due to the reputation of the earlier trademark, the consumer automatically associates the title with the well-known trademark".

Benelux case law

The following are examples of Benelux cases.

- District Court of Amsterdam 17 January 2007, "Red Bull / De Vries c.s". In a District Court case in which Red Bull (energy drinks) opposed use of the mark THE BULLDOG for energy drinks, inter alia on the basis of the provision implementing article 5 (2) Trademark Directive, the Court held the following with regard to similarity / "the link".

"Besides reputation of the RED BULL mark, it needs to be established that there is similarity. To establish such similarity, it is sufficient that the reputed mark and the sign are similar in such a way that the relevant public makes a connection between the sign and the mark. The existence of such a connection needs to be based on a global appreciation, taking into account all circumstances of the case. (..)

Furthermore, while confusion between the mark and sign is not required, the scope of protection of the mark does not extend so far that each connection made by the consumer is sufficient to establish similarity. In this context, it is merely relevant that the connection is as such that it leads to unfair advantage or detriment to the distinctive character or reputation of the mark.

In addition, it is of importance that the greater the degree of reputation of the mark and similarity between the goods and services concerned and the higher the distinctive character of the mark, the more likely it is that the relevant public makes a connection between the mark and the sign."

- Court of Appeal The Hague 13 April 2006 "Ipko / Marie Claire" . In a Court of Appeal

case between Marie Claire (well-known magazine) and Ipko (which owned the mark MARIE CLAIRE in class 25, for underwear), Ipko used the word MARIE CLAIRE on a booklet containing such underwear. The Court of Appeal held that, in view of the reputation of the MARIE CLAIRE trademark for magazines, the similarity of groups aimed at, the similarity of trademarks and the fact that Ipko presents itself in a way which seeks alliance with the luxury image of MARIE CLAIRE magazine, Ipko's use of its MARIE CLAIRE trademark causes unfair advantage or detriment to the MARIE CLAIRE trademark.

The Court did not mention the necessity of "a link" as such, but seems to come to the conclusion, that based on an assessment of all the factors mentioned above, the use of Ipko of MARIE CLAIRE infringes Marie Claire 's trademark rights based on (the implementation of) 5 (2) Trademark Directive.