



June 20, 2003

Ms. Cathy A. Catterson
Clerk
United States Court of Appeals
for the Ninth Circuit
95 Seventh Street
San Francisco, CA 94119-3939

Re: *JSL Corp. v. Visa International Services Ass'n* (Docket Nos. 02-17353 and 03-15420)

Dear Ms. Catterson:

Pursuant to Rule 29 of the Federal Rules of Appellate Procedure and the Circuit Advisory Committee Note to Rule 29-1 of the Rules of this Court, the International Trademark Association (“INTA”) requests leave to appear as an Amicus Curiae and to file this letter in lieu of a brief as amicus curiae.

INTA is an association of trademark owners and professionals with expertise and an interest in trademarks and in their role in fostering informed decisions by consumers in the marketplace. INTA is composed of over 4,300 members that cross all industry lines and include manufacturers, retailers, law firms, and professional and trade associations.¹ To further the interests of trademark owners and consumers, INTA has testified before Congress on various trademark issues and otherwise worked with legislators, submitted position papers to various bodies, and filed briefs as an amicus curiae before various courts, including the United States Supreme Court and this Court. INTA also played an active role in the passage of the Federal Trademark Dilution Act of 1995 (“FTDA”) that is at issue in this action.

INTA has reviewed the brief that we understand was filed by appellee Visa with this Court on June 18, 2003. INTA is submitting this letter in support of Visa’s legal arguments made at pp. 30-34 to the extent that they assert that JSL’s “eVisa” mark is identical to Visa’s famous “VISA” mark for the purpose of analyzing whether JSL’s use of “eVisa” causes actual dilution of the “VISA” mark under the recent decision of the United States Supreme Court in *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418, 123 S. Ct. 1115 (2003) (“*Moseley*”). INTA takes no position on any of the other issues presented in this appeal. Its decision not to take a position should not be deemed to be agreement or disagreement with any other legal or factual assertions made by the parties to the appeal.

In *Moseley*, the Supreme Court held that while a showing of “actual dilution” is always required under the FTDA, it is not always necessary to introduce direct evidence to make the required showing. The Supreme Court held that actual dilution may sometimes be established circumstantially, citing as “the

¹ Appellee Visa International Services Association (“Visa”) is a member of INTA but has not participated in the decision by INTA to seek leave to participate as an amicus curiae, or in the preparation of this letter. Appellant JSL Corporation (“JSL”) is not a member of INTA.

Ms. Cathy A. Catterson
June 20, 2003
Page 2

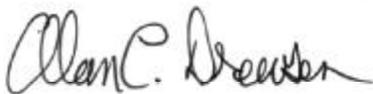
obvious case” “where the junior and senior marks are identical.”² Accordingly, the issue of whether a junior mark is “identical” to a famous senior mark will take on great significance in post-*Moseley* dilution cases.³

INTA agrees with Visa that the addition of the prefix “e-” to the “VISA” mark results in a mark that is “identical” to that mark for purposes of the application of the rule in *Moseley* that actual dilution can be proven circumstantially where marks are “identical.” As explained by Visa at pp. 32-34 of its brief, the “e-” prefix has no source-identifying significance because it is a generic term for “electronic,” and, as such, is commonly attached to marks to identify the electronic commerce or online version of the markowners’ businesses, as it appears to be so used and positioned in JSL’s mark. The remainder of JSL’s mark, the source-identifying portion, is Visa’s mark “VISA” in its entirety. As Visa’s brief points out at pp. 33-34, numerous cases have held that the addition of a non-source-identifying element such as the “e-” prefix to another’s mark results in a mark that is legally, if not literally, identical. INTA accordingly submits that for purpose of deciding whether Visa established actual dilution circumstantially, the “VISA” and “eVISA” marks should be viewed to be identical as a matter of law.

INTA believes that in properly applying *Moseley*, it will be critical for courts to recognize that a junior mark can actually dilute a famous senior mark where the only difference between the marks is an entirely non-distinctive element like the “e-” prefix. Requiring the owner of a famous senior mark to prove actual dilution by direct, not circumstantial, evidence, unless the junior mark is *literally* identical, is inconsistent with the policy rationale behind the FTDA. The addition of wholly minor and non-source-identifying elements (such as “e-”) to a famous mark (“VISA”) does not detract from the ability of the mark as a whole (“eVISA”) to actually dilute the famous mark. The source-identifying portion of that mark, “VISA,” is identical to the famous senior mark and the use of junior mark, as a whole, will lessen the capacity of the famous senior mark to identify and distinguish one and only one company and business.

INTA respectfully requests that the Court accept this submission. INTA would be pleased to make any additional comments or submissions as the Court may request.

Respectfully submitted,



cc: Michael McCue, Esq., Counsel for Visa International Service Association
Thomas E. Moore III, Esq., Counsel for JSL Corporation

²123 S. Ct. at 1124. To put the Supreme Court’s analysis in its proper context, it is important to note that in *Moseley*, the marks were “VICTORIA’S SECRET” and “VICTOR’S LITTLE SECRET.”

³The Court’s mention of this “obvious case” makes it clear that there may be cases other than those involving “identical” marks in which actual dilution can be established circumstantially.