



International Trademark Association
Representing Trademark Owners Since 1878

12 June 2007

Gregor Vos
Klos Morel Vos & Schaap
Albert Hahnplantsoen 23
1077 BM Amsterdam, P.O. Box 75988
1070 AZ Amsterdam
The Netherlands

Re: *Adidas AG and Adidas Benelux BV* (“adidas”) v *Marca Mode, C&A Nederlanden, H&M Hennes & Mauritz Nederlands BV and Vendex KBB Nederlanden BV* (Case C-102/07)

Dear Sir

The International Trademark Association (“INTA”), through its Europe Amicus Subcommittee, has prepared this Submission in relation to the case *Adidas AG and another v Marca Mode and others* (Case C-102/07).

In the first part of this Submission INTA explains the basis on which it seeks to put forward its views. In the remainder of this Submission, INTA sets out the comments it wishes to make in relation to the case and summarises INTA’s position on each of the questions referred to the European Court of Justice (“ECJ”).

INTA’S SUBMISSION

1. INTA’s interest in the case

INTA wishes to put forward submissions in this case on behalf of its members. INTA does not seek to participate any further than this in the case.

2. What is INTA?

2.1 INTA is a 128-year-old not-for-profit organisation of trade mark owners and practitioners from more than 190 countries throughout the world with offices in Brussels, Shanghai and New York. INTA is dedicated to the support and advancement of trade marks and related intellectual property concepts as essential elements of commerce. Its current membership of over 5000 companies and firms crosses all industry lines, including manufacturers and retailers in industries ranging from aerospace to consumer goods and service providers. INTA’s membership includes over 1000 companies, law firms and trade mark attorneys in all 27 Member States of the European Union (“EU”).

- 2.2 An important objective of INTA is to protect the interests of the public by the proper use of trade marks. In this regard, INTA strives to advance the development of trade mark 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 Organization (“WIPO”) since 1979 and actively participates in all trade mark related WIPO proposals. INTA has influenced WIPO trade mark 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 Southeast Asia Nations (“ASEAN”), the EU and the World Trade Organization (“WTO”).
- 2.3 Since 1916, INTA has acted in the capacity of advisor and has appeared as *amicus curiae* (“friend of the court”) in the US and in other jurisdictions. (More information on the *amicus curiae* briefs and similar interventions or comments the association has filed in cases around the world is given in Annex 1 to this Submission.)
- 2.4 A member of the adidas group is a member of INTA though the other parties to the proceedings are not. This brief was drafted by INTA independently of adidas.

3. Basis of INTA’s interest in the case.

- 3.1 INTA respectfully seeks to submit its views on issues which concern trade mark proprietors generally and which also can affect the rights of other parties. Such proprietors and other parties may include a large number of INTA members.
- 3.2 The questions referred by the Hoge Raad to the ECJ are as follows:
1. **In the determination of the extent to which protection should be given to a trade mark formed by a sign which does not in itself have any distinctive character or by a designation which corresponds to the description in Article 3(1)(c) of Directive 89/104/EEC (the “Directive”), but which has become a trade mark through the process of becoming customary and has been registered, should account be taken of the general interest in ensuring that the availability of given signs is not unduly restricted for other traders offering the goods or services concerned (the requirement of availability)?**
 2. **If the answer to Question 1 is in the affirmative: does it make any difference whether the signs which are referred to therein and which are to be held available are seen by the relevant public as being signs used to distinguish goods or merely to embellish them?**

3. If the answer to Question 1 is in the affirmative: does it, further, make any difference whether the sign contested by the holder of a trade mark is devoid of distinctive character, within the terms of Article 3(1)(b) of the Directive, or contains a designation, within the terms of Article 3(1)(c) of the Directive?

4. INTA's view on the issue

- 4.1 It is important that the scope of the first, and principal, question, should be clearly understood. It is concerned with the scope of protection to be afforded to a trade mark which has been registered, and not with issues of registrability. Once a sign is shown to be a trade mark and has been registered, there is a presumption, albeit rebuttable, that the registration is valid.
- 4.2 A mark must be refused registration, under Article 3(1)(b) of the Directive, if it is devoid of any distinctive character, or under Article 3(1)(c) if it consists exclusively of one of the designations (such as geographical origin) referred to in that provision or Article 3(1)(d) if it consists exclusively of a sign which has become customary in the trade. However, in accordance with Article 3(3), any such ground for refusal of registration may be overcome by demonstrating that the mark has acquired distinctive character through the use which has been made of it. INTA notes that the reference in the question to a sign having “become a trade mark through *the process of becoming customary*” appears to be out of place. The italicised words do not appear in Article 3(3) but are assumed to be a reference to distinctiveness acquired through use (as the Dutch version of the questions indicates).
- 4.3 The ECJ has already given a ruling on the matter of the “requirement of availability” in the *Chiemsee* case (C-108 & 109/97). The ECJ ruled that the grounds for refusal specified in Article 3(1)(c) pursue an aim in the public interest, in that it must be possible for anyone to use the indications referred to in that provision (the ‘requirement of availability’). However, the ECJ went on to rule that a mark that is considered to be inherently non-distinctive may, under Article 3(3) become registrable, if it has acquired distinctive character through use (i.e. has come to be perceived by the public as identifying products bearing the mark as originating from the trade mark owner).
- 4.4 The ECJ in the *Libertel* case (C-104/01) following *Chiemsee* also recognised the underlying public interest in the use of descriptive indications including colours – in that case orange. In *Libertel* the ECJ noted that regard must be had to the general interest in not unduly restricting the availability of colours for use by traders, but made it clear that this is achieved by the test of distinctiveness. The ECJ noted that a colour is *per se* not normally inherently capable of distinguishing goods but distinctive character may be acquired through use and an overall assessment must be made of the evidence that the mark has become distinctive (i.e. indicates the source of the goods).

In accordance with both judgments, Article 3(3) provides for an exception to Article 3(1)(b), (c) and (d), and its application does not depend upon the

requirement of availability, the question being simply one of sufficient distinctive character.

- 4.5 Once a mark is registered, and in the absence of an attack on the validity of the original registration, the so-called ‘requirement of availability’ can only possibly be brought into possible consideration in two ways. One is through the application of Article 6 of the Directive, under which the use of certain indications of characteristics of goods or services may be protected, if in accordance with honest practices in industrial or commercial matters. The other is as a part of the established ‘global appreciation’ test, in determining whether in particular circumstances there is a likelihood of confusion on the part of the public. Thus, the use of descriptive or non-distinctive matter may be less likely to cause confusion, particularly where there is less similarity between the goods or services for which the mark is registered, and the goods or services of the alleged infringer. But of course, where the defendant uses a mark which is identical to the registered mark, for goods or services which are identical with goods or services covered by the registration, such considerations would be irrelevant.
- 4.6 If a mark is the sort of mark in relation to which there might be said to be a general interest in not unduly restricting its use, such as a mark with a descriptive meaning, in practice, it will (without use) have low or no inherent distinctiveness as a trade mark. However, if a party has invested in it to such an extent that it has become distinctive, that distinctiveness entitles it to trade mark protection, subject to the usual requirements as to validity and the global appreciation test for assessment of confusion. It is inappropriate, and not contemplated by the Directive, that there be an explicit assessment of that “general public interest” in the assessment of the registrability or scope of protection of trade marks.

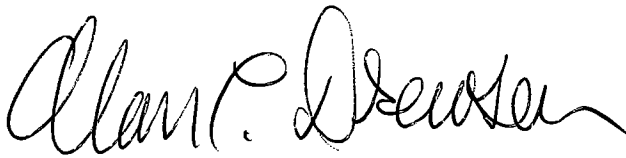
5. INTA’s view on the questions

The questions referred to the ECJ should therefore be answered as follows:

Question 1 The so-called ‘requirement of availability’ should have no part in determining the scope of protection to be given to a registered trade mark. The underlying policy of not unduly restricting the availability of the mark is adequately given effect through the absolute grounds for refusal/invalidity of registration, the global appreciation test on infringement and the availability of defences under Article 6 of the Directive.

Question 2 In the light of the observations in the previous paragraph it is not necessary to consider the second question. The view of INTA, however, is that, in the absence of a counterclaim for a declaration of invalidity, it makes no difference that the sign referred to in question 1 (i.e. the mark of the claimant who asserts infringement, which, prior to acquiring distinctiveness (through use), is lacking in distinctive character or is no more than a designation of characteristics of the goods) is seen by the relevant public as embellishing the goods rather than as distinguishing the goods.

Question 3 In the third question it is understood that the reference to “*the sign contested by the holder of a trade mark*” is a reference to the allegedly infringing sign used by a defendant. INTA observes that if the defendant’s sign is used in a manner which impacts on the function of the claimant’s trade mark as a guarantee of origin of goods or services, so as to fall within the definition of infringement in Article 5 of the Directive, it matters not whether the defendant’s sign is itself registrable. Accordingly, whether or not the answer to the first question is in the affirmative, it can make no difference if that sign is devoid of distinctive character within Article 3(1)(b) of the Directive or contains a description falling within Article 3(1)(c).

A handwritten signature in black ink, reading "Alan C. Drewsen". The signature is written in a cursive, flowing style with a long horizontal tail stroke.

Alan C. Drewsen
Executive Director

ANNEX

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. Dowellhurst 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 Clicquot 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.*

International Trademark Association

*DAX Properties CC and JoBurgers Drive Inn Restaurants (PTY) Limited (1997 1 SA
1 (A)).*