



**International Trademark Association**  
*Representing the Trademark Community since 1878*

**Alan C. Drewsen**  
*Executive Director*

June 17, 2005

Bovemij Verzekeringen N.V.  
Mr. E. Matser  
Hoge van den Broek (advocaten)  
Postbus 1126  
6501 BC Nijmegen

Re: Bovemij Verzekeringen N.V. v. Benelux Merkenbureau (EUROPOLIS case);  
reference by the Court of Appeal at The Hague to the European Court of Justice,  
case number C-108/05, decision of January 27.

Dear Mr. Matser:

The International Trademark Association (INTA) has prepared this letter to assist the European Court of Justice (ECJ) in giving a preliminary ruling under article 234 of the EC Treaty in the EUROPOLIS case referred by the Court of Appeal in The Hague in its decision of January 27, 2005. INTA is commenting below only on the second and third questions that have been referred by this court, i.e.:

- (a) whether article 3(3) of the First Council Directive of December 21, 1988 to Approximate the Laws of the Member States Relating to Trademarks (“the Directive”) must be interpreted as meaning that in order to acquire distinctive character (in the present case through a Benelux trademark) as a result of use, as referred to in that provision it is necessary that the sign be regarded as a trademark, before the date of application, by the relevant public throughout the Benelux territory and, therefore, in Belgium, The Netherlands and Luxemburg;
- (b) and, if the answer to this question is in the negative, whether the condition for registration laid down in article 3(3) of the Directive is satisfied, for the purposes of that provision, if the sign, as result of the use made of it is regarded as a trademark by the relevant section of the public in a substantial part of the Benelux territory and whether this substantial part can be, for example The Netherlands alone?

#### The International Trademark Association

The International Trademark Association (INTA) is a 127-year-old not-for-profit organization of trademark owners and practitioners from more than 180 countries throughout the world. INTA is dedicated to the support and advancement of trademarks and related intellectual property concepts as essential elements of commerce. Its current membership of over 4600 companies and firms crosses all industry lines, including manufacturers and retailers, in industries ranging from aerospace to consumer goods. INTA’s membership includes over 1000 trademark owners and practitioners in all 25 Member States of the European Union (EU).

An important objective of the International Trademark Association 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 Organization (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 Southeast Asia Nations (ASEAN), the European Union and the World Trade Organization (WTO).

INTA's membership is varied and extensive and, therefore, offers a balanced and reliable body of trademark experts. INTA's international character brings a global approach to the issues at stake in this case.

Since 1916, INTA has acted in the capacity of advisor and has appeared as *amicus curiae* ("friend of the court") in the US<sup>1</sup> and in other jurisdictions.<sup>2</sup> INTA also had the opportunity to appear in cases before the European Court of Justice.<sup>3</sup> Although INTA realizes that the European system does not recognize a true *amicus curiae* intervention, INTA presents itself as a "friend of the court" in this matter by having its opinion annexed to the brief submitted

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1 INTA has filed the following *amicus* briefs before the United States Supreme Court and other Federal Courts: *Test Masters Educational Services, Inc. v. Singh and Singh v. Test Masters Educational Services* (no reported opinion); *KP Permanent Make-Up, Inc. v. Lasting Impression Inc. and MCN International I Inc.*, 125 S. Ct. 542 (2004); *JSL Corp. v. Visa International Services Ass'n; Dastar Corporation v. Twentieth Century Fox Film Corporation, SFM Entertainment LLC and New Line Home Video, Inc.*, 539 U.S. 23 (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); *K Mart 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); and *Conopco, Inc. v. May Dep't Stores Co.*, 46 F.3d 1556 (Fed. Cir. 1994).

2 INTA has filed the following briefs and affidavits in jurisdictions outside the United States: Brief of *amicus curiae* in the Supreme Court of the Republic of Indonesia on November 30, 2004 in the trademark case *French Connection Ltd v. DB Mirchandani* (No.26/Trademark/2004/PN.NIAGA.JKT.PST); Letter of submission to the Supreme Court of Justice of Paraguay on March 26, 2003, in the trademark case *Tabacalera Boquerón S.A. 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/II.95 Doc. 7 rev. at 225 (1997)); brief of *amicus curiae* in the Supreme Court of the Republic of Indonesia on April 11, 2004, in the trademark case *Davidoff & Cie S.A. v. N.V. Sumatra Tobacco Trading Company* (53/MERREK/2002/PN.NIAGA.JKT.PST); brief of *amicus curiae* in the Supreme Court of the Republic of Indonesia, on December 23, 2002 in the trademark case *Intel v. Hanitio Luwi* (3535K/PDT/2001); brief of *amicus curiae* in the Supreme Court of the Republic of Indonesia on October 10, 2002 in the trademark case *Intel v. PT Panggung Electronics Industries* (590PK/PDT/2001); 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 Supreme Court of South Africa (Durban and Coast Local Division) on November 8, 2005 in the trademark case *McDonald's Corporation v. DAX Properties CC and JoBurgers Drive Inn Restaurants (PTY) Limited* (1997 1 SA 1 (A)); 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).

3 INTA has filed the following letters in Europe: 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* (C-) (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).

by the trademark owner in this case. INTA is not a party in the instant case, but believes this case is significant to the development of trademark law.

INTA respectfully submits this letter in the hope that it may assist the Court in reaching a decision that is in the public interest.

### The EUROPOLIS Case

Trademark owners, including members of INTA, will be directly affected by the judgment of the ECJ on the questions referred to it by the Court of Appeal in The Hague on January 27, 2005 under article 234 of the EC Treaty and in particular by the answer to the questions regarding the territorial scope of “secondary meaning.”

For the purposes of trademark law, the Benelux Economic Union forms one undividable territory. Under the Benelux Trademarks Act, it is not possible to acquire any national trademark right. Since the Act entered into force on January 1, 1971, trademark rights in the Benelux can only be acquired through an application with the Benelux Trademarks Office (BTO) which application needs subsequently to be registered to vest as trademark right. These rights are uniform rights covering the whole of the Benelux territory. Article 12 of the Benelux Trademarks Act provides that trademark rights can only be acquired through registration.

The concept of “secondary meaning” is recognized in the Benelux Trademarks Act. Article 14ter of the Act provides that the Court can rule that a registered mark acquires distinctiveness through use.

The Benelux Trademarks Office takes the position that in order to acquire “secondary meaning” the trademark needs to be recognized as a trademark by the public in the whole of the Benelux territory. This position is outlined in the Office 2004 guidelines with respect to the criteria for the refusal of trademarks on absolute grounds. The BTO also expressed this position in the EUROPOLIS case.

INTA believes that the BTO position is extremely unfair towards trademark owners who are using a trademark in a substantial part of the Benelux territory and where as a result of that use the trademark has acquired “secondary meaning,” i.e., a distinctive character among a substantial portion of the public in the Benelux territory. This position is unfair because a company active only in one or two of the three Benelux States would be unable to get any protection for its mark despite consumer recognition of such a trademark through use. For example, under current practice of the BTO, a chain of shops operating in all major cities in The Netherlands and/or Belgium and selling, on a large scale, products carrying a mark is not able to register its mark with the BTO. The impossibility of getting such protection results from the fact that separate national registrations (e.g., for Belgium) are not available in the Benelux. In addition, no protection under general rules of torts, unfair competition or other law is available without the acquisition of a regional Benelux trademark registration.

Furthermore, it is important to note that the BTO position differs from that of other Member States. For example, in the United Kingdom (UK), a mark may acquire a distinctive character as a result of use in only parts of the UK, provided it is a substantial part. There is no requirement for a mark to be known in England, Scotland and Wales for the trademark right to vest, although where the use is particularly limited, the registration may be narrowed in

scope but not lost. This position is set out in the UK Patent Office Guidelines for Examination. Under German law, although it is required that a non-distinctive mark be recognized over the entire German territory for it to gain “secondary meaning,” it is not required that the same degree of recognition exist in all German states.

It is also important to note that the ECJ decided in *General Motors v. Yplon* on September 14, 1999 that it is sufficient for a Benelux trademark to have a reputation within the meaning of Article 5 (2) of the Trademark Harmonization Directive in a substantial part of the Benelux territory, which part may consist of a part of one of the Benelux countries. INTA believes, based on a similar reasoning, that it should be sufficient for a Benelux trademark to have acquired “secondary meaning,” if such “secondary meaning” was acquired in a substantial part of the Benelux territory which part may consist of one of the countries of the Benelux territory.

Conclusion

INTA respectfully urges the European Court of Justice to answer question 2 of the Court of Appeal in The Hague in the negative and question 3 in the positive.

Sincerely,

A handwritten signature in black ink, appearing to read "Alan C. Dawson". The signature is fluid and cursive, with a long horizontal flourish extending to the right.