

Amicus Curiae—INTA’s role as Friend of the Court

The International Trademark Association provides expertise concerning trademark and other IP-related laws to courts and trademark offices around the world through the submission of *amicus curiae* ("friend of the court") briefs or similar filings. Through these kinds of filings, INTA takes advantage of procedures that allow an independent third party to a proceeding to voluntarily offer an opinion on a legal matter—such as the proper interpretation or application of the law, or an explanation for why certain policies are superior—and to educate the courts on a specific legal issue.

The purpose of INTA's intervention in such cases is to ensure that the court or tribunal is fully informed about the relevant issues that may impact the law in a given jurisdiction. Unlike the parties in litigations, who typically focus on the specific facts of a case and argue for a particular outcome, INTA plays a neutral role, addressing only the legal issues. The *amicus curiae* mechanism can offer courts, trademark offices, and other tribunals the benefit of INTA's independent perspective and its deep knowledge and experience about trademark and other IP-related laws. INTA's involvement in these cases can strengthen legal discussions on intellectual property matters and improve decision-making in complex matters of public interest. INTA's intervention may be carried out through a brief, testimony, expert report, legal memorandum or other submission, depending on the procedural rules in force in the respective country and in the tribunal at issue. Usually, the submission is presented during the appeal stage, but INTA has participated at other stages as well, when the circumstances warrant.

The kinds of matters for which intervention by INTA may be appropriate include: matters that involve, relate to or potentially affect the law of trademarks, trade names and trade dress; the law of unfair competition; and other IP-related laws (e.g., right of publicity, false advertising, designs, domain names); or procedural issues related to such matters (e.g., standing, jurisdiction, evidentiary presumptions, use of surveys, remedies) (together, "Trademark, Unfair Competition and IP-Related Laws").

INTA's submissions in such cases are prepared by the Association's International Amicus Committee (the "Committee"), under the direct supervision of INTA's Executive Committee of the Board of Directors (the "Executive Committee") with support from INTA staff (the "Staff Liaison").

PROCEDURE FOR REQUESTING INTA’S INTERVENTION

INTA depends upon individuals around the world to alert INTA of cases involving Trademark, Unfair Competition and IP-Related Laws in which INTA's intervention may be appropriate. If you are aware of a case in which input from INTA could be of value to the court, please let us know! You do not need to work for an INTA Member to submit a case for consideration.

To alert the Committee of such a case or request that INTA file a brief or other submission, please follow the policy and procedure outlined below.

INTA *AMICUS* BRIEF POLICY AND PROCEDURE

A. Policy Statement

1. *Amicus curiae* and other interventions are generally appropriate only in litigated matters: Generally, *amicus curiae* or other “friend of the court” submissions are appropriate in litigated matters, where a court, tribunal or trademark office will be making a decision about the law. These actions may include court actions, opposition proceedings and cancellation proceedings, among others. The *amicus curiae* process is not appropriate for legislative matters, such as arguments about the passage of new statutes, rules or regulations. Matters that are more appropriately considered legislative in nature should be brought to the attention of the Staff Liaison for reference to the relevant INTA committee (such as a substantive law committee or a committee that considers and proposes legislative revisions in the relevant jurisdiction).
2. Criteria for *amicus curiae* submission: The matter must meet at least one of the following criteria:
 - a. The views of INTA have been specifically requested by the tribunal; or
 - b. The question to be addressed directly affects INTA’s activities, or
 - c. The matter involves, relates to or potentially affects Trademark, Unfair Competition and IP-Related Laws, and a filing by INTA would be reasonably likely to advance the strategic goals and objectives of INTA, including supporting trademarks and related intellectual property rights in order to protect consumers and to promote fair and effective commerce (see [INTA’s Strategic Plan](#)).

The Committee will consider all requests by third parties that comport with the Procedures outlined below. The Committee also regularly monitors leading cases involving Trademark, Unfair Competition and IP-Related Laws and may recommend to the Executive Committee that INTA, on its own initiative, seek to file an *amicus* brief or similar type of intervention. At the Committee’s discretion, it may (but is not required to) reach out to parties in a case it is monitoring to ask whether an *amicus* brief or other submission by INTA would be advisable, and whether the parties would like to make a formal request pursuant to this Policy. Other INTA committees also routinely monitor developments in Trademark, Unfair Competition and IP-Related Laws, and they may recommend that the Committee consider an *amicus* or similar filing in an appropriate case. The Committee, in its discretion, may recommend an *amicus* brief or similar filing even if the parties oppose INTA’s intervention and/or even if a party subsequently withdraws a request that it previously submitted to the Committee.

3. **Conflict of Interest Policy:** To ensure the independence and objectivity of INTA’s *amicus* process, Committee members (including invited experts or members of the Executive

Committee) will not participate in the discussion or vote on any request that relates to a case in which they have a conflict of interest. Such a conflict of interest would arise (a) when the participant or the participant's company or firm: (i) is a party to the case; (ii) is related to a party to the case (e.g., a parent, subsidiary or affiliate for a corporate party, or a spouse, child, parent or other close relative for an individual party); (iii) has a direct financial interest in the outcome of the case; or (iv) represents an entity that is a party, is related to a party, or has such a direct financial interest; or (b) when a conflict would arise under any ethical rule otherwise applicable to the participant, such as rules of professional conduct imposed by a bar in the member's jurisdiction or the jurisdiction in which the case is pending. As long as there is no conflict of interest pursuant to the preceding principles, Committee members are not precluded from participating in the consideration of a case merely because the participant's company, firm, or related entity, or a client of the participant's firm, has an interest in, or has taken a position regarding, an issue relevant to the case, or is a member of the same industry as one or more of the parties to the case.

4. **Factors Supporting an *Amicus* Brief:** In deciding whether to recommend that INTA submit an *amicus* brief, the Committee will generally take the following non-exclusive factors into account:
- i. Whether the matter raises an issue of Trademark, Unfair Competition and IP-Related Laws of potential interest to INTA.
 - ii. The significance to trademark owners of the legal issues involved in the case, both in the jurisdiction in which the case is pending and in other jurisdictions.
 - iii. Whether the case involves primarily legal, as opposed to factual, disputes.
 - iv. Whether the legal issue involved in the case is settled law or is the subject of a conflict between courts within the country and/or between countries.
 - v. Whether the proposed filing would be consistent with resolutions adopted by the INTA Board of Directors or other promulgated INTA's policies.
 - vi. The seniority or level of the tribunal before which the case is pending (e.g., whether it is the highest court of the country, an intermediate appellate court, or a trademark office or appeals board), and, where relevant, the potential precedential value of the ruling for which *amicus* participation is sought.
 - vii. Whether other entities seek intervention as *amicus curiae*, or are or may be involved in the case, and, if so, their identity (e.g., those representing a particular industry sector or public interest group).
 - viii. The quality of and positions taken in other briefs submitted in the case by the parties and any other amici, including in prior stages of the litigation.
 - ix. The public interest, if any, in the legal issues involved in the case.

- x. Whether any request was made in accordance with INTA's procedures and in sufficient time to permit the preparation of a quality brief.

Parties making requests should, to the extent appropriate, explain why their request is appropriate with reference to these factors and any other factors the requesting party believes are relevant. Parties are also asked to indicate whether the issues in the case are likely to have broader impact on Trademark, Unfair Competition and IP-Related Laws, other areas of the law, or within the relevant industries, and to explain those issues fully so that INTA can make an informed judgment.

In deciding whether to recommend that INTA submit an *amicus* brief or other submission, the Committee generally will NOT take the following factors into account:

- i. Whether any of the parties to the case, or counsel to the parties, is an INTA member;
- ii. The absence of any established INTA's policy or position;
- iii. Whether the tribunal in question typically receives *amicus* filings (unless the Committee determines that there would be no mechanism whatsoever through which to submit INTA's position to the forum);
- iv. The possibility that the tribunal in question may reject the position advocated by INTA.

It is important to emphasize that the Committee generally will recommend taking the position that it believes best advances INTA's mission and strategic objectives, which includes the goals of supporting the development of Trademark, Unfair Competition and IP-Related Laws, protecting consumers, and promoting fair commerce. Moreover, the Committee expressly reserves the right to recommend positions that are different from those requested by the parties, including a party who is a member of INTA.

- 5. **Appropriate Tribunals for *Amicus* Filings:** INTA generally prefers to make *amicus* or similar filings at an appellate stage in the case, after a factual record has been established and an initial ruling has been made. Accordingly, a filing generally will not be made if the case is at the trial stage in the tribunal of first instance. However, in appropriate cases (such as a matter of significant importance, or where the principal issue in dispute at the court of first instance is primarily a legal issue), and in jurisdictions that permit *amicus* filings only in the tribunal of first instance, the Committee will consider filing in the tribunal of first instance.

B. Procedure for Requesting a Filing by INTA

- 1. **Timing of Requests:** INTA takes the filing of *amicus* briefs very seriously and can only make submissions when the process has been timely initiated to allow careful consideration and drafting as well as full adherence to this Policy. Assessment of issues and preparation of *amicus* filings require substantial effort and time in the Committee, the Executive Committee and INTA staff. This process requires significant commitments by member volunteers, who contribute their time and expertise on a pro bono basis. These commitments make it extremely difficult for requests to be considered and acted upon in

less than 30 days, and even simple requests often demand up to 60 days to handle properly. Complex cases, such as those before the highest court of a jurisdiction involving novel issues of law, multi-jurisdictional proceedings, or the necessity of obtaining translations, demand even more time to review. Accordingly, requests should be made as early as possible, **preferably at least 30 days in advance of any filing deadlines**. INTA strongly suggests that requesters contact the appropriate Staff Liaison listed below as early as possible in the history of a case—even if a ruling has not yet been issued—if they believe that INTA’s involvement may be appropriate.

2. **How to Make a Request:** A requester may solicit consideration by INTA of a possible filing by submitting an electronic request to the Amicus Committee to the attention of the appropriate Staff Liaison member below:

Asia-Pacific: Seth Hays at shays@inta.org

Canada: Tiffany Pho at tpho@inta.org

Europe: Carolina Oliveira at coliveira@inta.org

Latin America: José Luis Londoño at jlondono@inta.org

Middle East/Africa: Tat-Tienne Louembe at tlouembe@inta.org

United States: Maysa Razavi at mrazavi@inta.org

For cases conducted in a language other than English, materials must be submitted in both their original language and English translation.

The request should take the form of a letter that fully explains the basis for the request. Although there is no page limit, parties are encouraged to make their requests as succinctly as possible—a few pages is often all that is required—to facilitate the Committee’s prompt review of the request. The request should include:

- The case name, caption, number, and identity of the tribunal;
- A list of all litigants, counsel and other interested parties involved in the case, to facilitate conflict of interest clearance by Committee members;
- A brief summary of the procedural and decisional history of the case;
- A description of the issue(s) the requester would like INTA to address in its filing, and the requester’s recommendation on the position INTA should take (along with references to supporting case law);
- A discussion of whether the case is likely to have an impact beyond the parties, including any impact on other parties, on the development of Trademark, Unfair Competition and IP-Related Laws, or more generally within the relevant industries;
- A discussion as to why the issues are of significance to INTA and its membership, and how INTA’s participation in the case is likely to make a material contribution to a decision;

- Identification of any risks to INTA in seeking to participate as *amicus* (such as a risk of an award of costs against INTA should its motion to intervene be denied); and
- The full briefing schedule, including the deadline for making the requested filing, or if the briefing schedule has not yet been set or finalized, the anticipated briefing schedule.

In addition, the request should include:

- Electronic copies of the opinion(s) of the lower tribunal(s);
- Electronic copies of both parties' briefs and supporting evidence related to the issue on which the requester seeks INTA's intervention, including in prior stages of the litigation, if available;
- Electronic copies of any other material that the requester believes would be helpful to the Committee's consideration; and
- An electronic copy of a complete description of the *amicus* or other procedure(s) permitted by the tribunal in question, and any rules applicable to such filings. (If there are no formal rules for *amicus* filings in the tribunal in question, but the tribunal would nevertheless accept an informal filing, such as an expert affidavit or letter, please provide as complete a description as possible of the procedures for such an informal filing in the tribunal at issue).

Finally, along with any request for an *amicus* brief, **the requesting party must provide INTA with a separate letter, in a form suitable for filing with the tribunal if necessary, confirming its consent to INTA's filing of an *amicus* brief in the matter**, regardless of the position that INTA ultimately decides to take and regardless of whether INTA files an *amicus* brief in support of one of the parties or in support of neither party. Also, by making a request, the requesting party(ies) acknowledge that INTA can make it a condition of its seeking intervention that the requesting party(ies) has(ve) agreed that there be no (claim for a) costs order from its/their side in respect of INTA's intervention.

3. **Waiver of Electronic Submission Rule:** The Committee expects that most requesters will have access to the technology that allows them to submit their request and supporting materials electronically. If a party is unable to submit its request or some or all supporting documents in electronic form, the requester may contact the appropriate Staff Liaison to explain the reasons for the inability to adhere to the electronic submission requirement and arrange for alternative means of submission (such as providing a sufficient number of hard copies of non-electronic materials for circulation to the Amicus Committee).
4. **Copy to the Parties and Responses:** The request shall show that a copy of the request was sent by the requester to counsel for the other party (or both parties) to the case by electronic means (*e.g.*, email). **The other parties generally shall have five (5) business days** from their receipt of the request to submit to the Committee any response, which may include a request that INTA file an *amicus* brief or other submission in support of a different

position, or may explain why the party believes an *amicus* brief or other submission from INTA would be unwarranted. In special circumstances, the Chair of the Committee (or, in the event of a conflict of interest, the Vice Chair or the Subcommittee Chair) may shorten or lengthen the time for response.

Absent exceptional circumstances, the parties should not provide the Committee with any further substantive submissions unless specifically requested by the Committee. The parties should, however, keep the Committee apprised through the Staff Liaison of any material developments in the case that might impact the Committee's consideration of the request, including both as to the merits and as to the timing.

5. **Confidentiality:** Once a request is made, in order to maintain INTA's independence, the *amicus* process will proceed confidentially. INTA will not disclose its deliberations to the parties, will not consult with the parties on the issues in the case and, if it decides to recommend the filing of an *amicus* or other submission, will not inform the parties of the positions that INTA is likely to take. The parties generally will not be informed of INTA's position until the day of the filing of the brief or other submission. The one exception to this rule is that, if INTA is not able to file an *amicus* brief or other submission on its own in a particular jurisdiction, and if its filing can more appropriately be considered by the tribunal if it is submitted by a party (either with its evidence or its arguments), then INTA may consult with that party to coordinate the filing of the *amicus* brief or other submission. In these circumstances, the party may need to be informed of INTA's position and may need to be given an advance copy of INTA's proposed filing, but any consultation with the party should address only the form of INTA's submission and not its content.