

ANNEX A

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

- Filed a brief in *Richemont International SA v. Russian Patent and Trademark Office* on December 22, 2011, which was included in Richemont's submission before the Arbitrazh Court of Moscow.
- Participation as intervener in *Nokia Corporation v. Her Majesty's Commissioners of Revenue and Customs* (ECJ -Joined Cases C 446/09) both in the form of written submission in March 2010 and at the oral hearing of the matter in Luxembourg on November 18, 2010.
- Submission as intervener to the English Court of Appeals on November 9, 2009 in the case *Nokia Corporation v. Her Majesty's Commissioners of Revenue and Customs (HMRC)* (HC 09 CO 1457 Court of Appeal A3/2009/1726).
- Brief in *Intel Corporation Inc. v. CPM United Kingdom Ltd.* included in submission before the European Court of Justice, November 2007.
- 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:

- *Christian Louboutin S.A. et al. v. Yves Saint Laurent America Holding, Inc. et al.* No. 11-3303-CV (2nd Cir., 2011).

- *Fleischer Studios, Inc. v. A.V.E.L.A., Inc.* No. 09-56317 (9th Cir., 2011).
- *Penguin Group Inc. v. American Buddha.* No. 609 F.2d 30 (2nd Cir., 2010).
- *Rosetta Stone Ltd. v. Google, Inc.* No. 10-2007 (4th Cir., 2010).
- *Tiffany (NJ) Inc. v. eBay, Inc.* No. 10-300 (2nd Cir., 2010).
- *Levi Strauss & Co. v. Abercrombie & Fitch Trading Co.* No. 09-16322 (2nd Cir., 2009).
- *Chloe v. Queen Bee of Beverly Hills,* No. 09-3361-CV (2nd Cir., 2009).
- *Starbucks Corp. v. Wolfe's Borough Coffee, Inc.,* No. 08-3331-CV (2nd Cir., 2008).
- *ITC Limited v. Punchgini,* 482 F.3d 135 (2d Cir., 2007).
- *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 filed in *Unilever N.V. v. Administrative Resolutions No. 537 of August 2010 and No. 241 of October 2010* before the The Honorable Exchequer Court, First Chamber of Paraguay in December 2011.
- Brief filed in *PT Bintang Pesona Jagat v PT Karya Tajinan Prima*, case No. 03/HKI.MERREK/2011/PN.NIAGA.JKT.PST in the Supreme Court of the Republic of Indonesia (2011).
- Brief filed in *International Hair Cosmetics Ltd & ORS v. International Hair Cosmetics Group Pty LTD* (ACN 057 921 945) before the Full Court of the Federal Court of Australia (2011).
- Brief filed in *Masterpiece Inc. v. Alavida Lifestyles Inc* (Court Filed No. 33459) in the Supreme Court of Canada (on appeal from the Federal Court of Appeal). (2010).
- Brief filed in *Grupo Anderson's S.A. de C.V. v. Mexican Institute of Industrial Property*, before the Mexican Federal Court of Tax and Administrative Affairs and the Mexican Institute of the Industrial Property (2009).
- Brief filed in *Austin, Nichols & Co. Inc. v Stichting Lodestar (SC 21/2007)* in the Supreme Court of New Zealand (2007).
- 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/MERREK/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 B

INTA Amicus Brief Policies and Procedures

A. Policy Statement

Matters appropriate for the filing of an amicus brief or other similar "amicus" type filing are limited to matters that are adjudicatory in nature, e.g., court actions and opposition and cancellation proceedings. Legislative and nonadjudicatory executive branch matters are not appropriate for amicus filings and should be brought to the attention of Bruce MacPherson, INTA Director of External Relations, for reference to the correct committee.

The matter must meet the following criteria:

1. The matter must involve a general principle of the law of trademarks, trade names, or trade dress, or the law of unfair competition, and must be considered sufficiently significant to warrant a filing, and filing by INTA must be reasonably likely to make a material contribution to the arguments by the parties or to the tribunal's consideration of the matter; or
2. The views of the Association have been specifically requested by the tribunal; or
3. The question to be addressed directly affects the activities of the Association.

A request from the tribunal or from a party to the matter is not required for INTA to make an amicus filing. INTA may choose to make such a filing without request from the tribunal or any party.

B. Procedure for Requesting a Filing by INTA

1. Review this Policy and Procedure: In the event that a person or entity wishes to make a request for INTA to file, the requester is urged to review and comply with this entire Policy and Procedure.

2. Timing of Requests: Requests should be made as early as possible. It should be understood by requesters that consideration and preparation of an amicus filing requires a very substantial and timeconsuming effort by the Subcommittee, the Executive Committee, and the INTA Staff. Accordingly, as a general rule, the Subcommittee will not even consider a request unless there are at least 30 days available before the filing is due. Even in a relatively simple case, at least 60 days is highly recommended. In complex cases, such as Supreme Court cases, cases involving novel questions of law, cases where document translation is required, cases in countries where the Association has not previously filed, and the like, more than 60 days will likely be required. Accordingly, if a Requester believes that an amicus filing by INTA may be appropriate in a case, even though a ruling has not yet been made in the case, contacting the Subcommittee is strongly encouraged. In appropriate cases, the Subcommittee may choose to come up to speed on the case in preparation for a possible filing, even though it may not be clear that a filing will be needed or appropriate.

3. How to Make a Request: A requester may solicit consideration by INTA of a possible filing by submitting an electronic request to the INTA International Amicus Committee (the "Committee") in care of International Trademark Association, 655 Third Ave., New York, NY 10017 USA

Asia Pacific: Seth Hays at shays@inta.org

Latin America: Laura Cruz at lcruz@inta.org

Europe: Carla Schwartz at cschwartz@inta.org

Canada: Seth Hays at shays@inta.org

United States: Michelle King at mking@inta.org

With respect to cases originating from non-English speaking countries, materials should be submitted in both their original language and English translation.

The request should take the form of a statement of no more than three pages. The Committee kindly asks that requesters strictly adhere to this rule. Again, this statement should be sent electronically using a generally accepted word processing program and include:

- The case name, caption, number, and tribunal;
- A brief summary of the procedural and decisional history of the case;
- A discussion as to why the issue(s) is/are of significance to the Association and its membership, and how the Association's participation in the case is likely to make a material contribution to a decision;
- The issue(s) the requester would like the Association to address in its filing;
- The deadline for making the filing; and
- The identity of counsel for both parties.

In addition, the request should include:

- Electronic copies of the opinion(s) of the lower tribunals(s);
- Electronic copies of the briefs of the parties, if available;
- Electronic copies of any other material that the requester believes would be helpful to the Subcommittee's consideration; and
- An electronic copy of a complete description of the "amicus" 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, then provide as complete a description as possible of the informal filing that would be acceptable to the tribunal.)

Waiver of electronic submission rule: The Committee expects that most requesters or their counsel will have access to means that would permit an electronic submission, including scanning devices that would allow for the sending of unreported opinions, briefs, and other material via electronic mail. Notwithstanding, the Committee also anticipates that there will be exceptions to this rule. In these cases, the requester or his counsel is asked to contact the appropriate staff liaison, as noted above, and explain

the reasons for the inability to adhere to the electronic submission requirement. The staff liaison will then work with the requester or his counsel to secure the necessary material for consideration.

4. **Copy to the Parties:** The request shall show that a copy of the request was sent by the requester to other party (or both parties) to the case.

5. **Appropriate Point for Consideration of a Filing:** INTA 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, and particularly in jurisdictions that permit amicus filings only in the tribunal of first instance, the Subcommittee will consider filing in the tribunal of first instance.