International Trademark Association

INTA News

International Amicus Committee Offers Expertise on IP-Focused Cases Worldwide

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The International Amicus Committee (IAC) provides expertise concerning trademark and other intellectual property (IP) laws to courts and trademark offices around the world through the submission of amicus curiae ("friend of the court") briefs or similar filings. IAC members evaluate requests to file, monitor leading cases, and draft amicus curiae submissions. Through independent amicus curiae filings, the Association can advocate on policy matters and educate the courts on a specific legal issue while ensuring that the court is informed about the relevant issues that may impact the law in a given jurisdiction.

In 2024, the IAC continued its steady pace of filing briefs as a "friend of the court" in important cases worldwide:

INTA filed its first brief of the year on May 7, before the High Court of Delhi in the matter of *Hero Motocorp Limited v. Shree Amba Industries*, [CS (Comm) 1078/2018], a designs case pertaining to the interpretation of the term "article" under the India Designs Act, 2000. In its amicus curiae brief, INTA argued that the phrase "any part of an article capable of being made and sold separately" in Section 2(a) of the Designs Act does not only include parts of articles that can be sold as articles that have an independent life as articles of commerce, but also those substitutes/accessories that may have no such independent life and which however do fall within the meaning of "articles" under Section 2(a) of Designs Act, 2000 and are registrable.

Given that design registrations in India for spare/replacement parts of articles, including automotive spare parts, such as motorcycle fenders, etc., may or may not qualify as having an "independent life as an article of commerce," those that would be found not to qualify would become vulnerable to

cancellation, with significant negative impact on the rightsholders.

On June 1, INTA filed an amicus curiae brief before the Grand Board of Appeal of the European Union Intellectual Property Office (EUIPO) in relation to a referral by the EUIPO's executive director regarding a September 26, 2022, decision of the Fourth Board of Appeal in the *Nightwatch* case (R 1241/2020-4). The case concerned the conversion of EU Trade Marks (EUTMs) into one or more EU national or Benelux applications under Article 139(2)(b) of Regulation 2017/1001. Conversion provides a means to overcome issues of registrability/validity while preserving the priority date of the initial EUTM application. The practice of EUIPO since 2006 has been that the decision of the EUIPO objecting to the registration of an EUTM is sufficient to exclude conversion in member states where the relevant ground of refusal applies, even when such decision has not become "final" due to a withdrawal, unless an appeal is filed (and then withdrawn).

In response to questions raised by the EUIPO's executive director, INTA argued that it should be possible to convert a previously refused EUTM into national marks, even in the member states where grounds of refusal apply, without first needing to appeal the refusal decision (and pay the appeal fee). The Association also maintained that the above conclusion should likewise apply to all preregistration and post registration actions. Finally, INTA maintained that there is no reason the approach should be different where the relevant decision is rendered in ex parte or inter partes proceedings.

INTA filed an amicus curiae brief on June 5 with the U.S. Court of Appeals for the Ninth Circuit in *Yuga Labs, Inc. v. Ryder Ripps, Jeremy Cahen*, No. 24-879, a case considering whether nonfungible tokens (NFTs) are "goods" for purposes of Section 1125(a), the unfair competition provision of the Lanham Act. INTA's position is that NFTs and intangible goods in general constitute "goods" under the Lanham Act and cautioned against overextension of the narrow holding in the Supreme Court's decision in *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23 (2003), which would improperly foreclose any and all manner of NFTs from constituting "goods" under the Lanham Act.

Most recently, the Association filed a statement in intervention before the General Court of the European Union on July 24, in case T-38/24, *OMV AG v. EUIPO*, an appeal case against a ruling of the EUIPO Boards of Appeal concerning a color mark combination and the criteria to be taken into account for assessing distinctiveness. INTA's position was that combinations of colors should be assessed in the same way as any other trademarks, without applying a particularly strict test as may be proper for single color marks. Furthermore, the systematic arrangement of a color mark should be considered on the basis of the trademark as filed and be part of the assessment of a trademark's distinctiveness.

INTA argued that the market practice in a given industry is a relevant factor in the assessment of inherent distinctiveness, as it might have an impact on how the public perceives the relevant sign. Such market practice might serve to demonstrate that the relevant public is accustomed to perceiving a specific sign—different from a word or a figurative mark—as a trademark and satisfy the distinctiveness threshold, overcoming any general and out of the specific market context presumption that such signs are not perceived as trademarks.

Heavily relying on INTA members to alert the Committee to possible cases of interest, the IAC encourages INTA members to send an email when they see a case with possible implications for the wider trademark/IP community.

For more information on amicus curiae briefs and on how to submit a request for filing an amicus curiae brief, please see the Amicus Brief Submission Guidelines.

Although every effort has been made to verify the accuracy of this article, readers are urged to check independently on matters of specific concern or interest.

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