

No. 21-1043

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In The  
**Supreme Court of the United States**

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ABITRON AUSTRIA GMBH; ABITRON GERMANY  
GMBH; HETRONIC GERMANY GMBH;  
HYDRONICSTEUERSYSTEME GMBH; ABI  
HOLDING GMBH; ALBERT FUCHS,  
*Petitioners,*

v.

HETRONIC INTERNATIONAL, INC.,  
*Respondent.*

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*On Writ of Certiorari to the  
United States Court of Appeals for the Tenth Circuit*

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**BRIEF OF *AMICUS CURIAE* EUROPEAN  
COMMISSION ON BEHALF OF THE  
EUROPEAN UNION IN SUPPORT OF  
NEITHER PARTY**

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## TABLE OF CONTENTS

	<b>Page</b>
INTEREST OF <i>AMICUS CURIAE</i> .....	1
SUMMARY OF ARGUMENT .....	4
ARGUMENT.....	7
I.    There Exists A Robust International System To Protect United States Holders of Trademark Rights Abroad.....	7
II.   European Union And German Law Implement The International System And Provide Relief For United States Rightsholders For Infringement That Occurs in Germany .....	15
III.  The International Trademark System Works, And It Has Worked Specifically In This Case .....	23
IV.  Extraterritorial Application Of The Lanham Act Risks Disrupting The International Trademark Regime, And Violating The United States’ Obligations Under International Law .....	28
CONCLUSION .....	33

**TABLE OF AUTHORITIES**

	Page(s)
<u>United States Cases</u>	
<i>Barcelona.com, Inc. v. Excelentísimo Ayuntamiento de Barcelona</i> 330 F.3d 617 (4th Cir. 2003) .....	10, 30
<i>Brennan’s, Inc. v. Brennan’s Restaurant</i> 360 F.3d 125 (2d Cir. 2004).....	23
<i>In re Compagnie Generale Maritime</i> 993 F.2d 841 (Fed. Cir. 1993) .....	30
<i>Dam Things From Denmark v. Russ Berrie Co.</i> 290 F.3d 548 (3d Cir. 2002).....	11
<i>EEOC v. Arabian American Oil Co.</i> 499 U.S. 244 (1991) .....	32
<i>Frehling Enterprises v. Int’l Select Group</i> 192 F.3d 1330 (11th Cir. 1999).....	23
<i>Garcia v. Texas</i> 564 U.S. 940 (2011) .....	29
<i>Hilton v. Guyot</i> 159 U.S. 113 (1894) .....	28
<i>Int’l Cafe v. Hard Rock Cafe Int’l</i> 252 F.3d 1274 (11th Cir. 2001) .....	9, 30
<i>Kiobel v. Royal Dutch Petroleum Co.</i> 569 U.S. 108 (2013) .....	32, 31

<i>La Quinta Worldwide LLC v. Q.R.T.M., S.A. de C.V.</i> 762 F.3d 867 (9th Cir. 2014) .....	23
<i>Lodestar Anstalt v. Bacardi &amp; Co.</i> 31 F.4th 1228 (9th Cir. 2022) .....	10
<i>Mattel, Inc. v. MCA Records, Inc.</i> 296 F.3d 894 (9th Cir. 2002) .....	9
<i>Medellin v. Texas</i> 552 U.S. 491 (2008) .....	29
<i>Microsoft Corp. v. AT&amp;T Corp.</i> 550 U.S. 437 (2007) .....	31
<i>Murray v. Schooner Charming Betsy</i> 6 U.S. 64, 2 Cranch 64, 2 L.Ed. 208 (1804) .....	28
<i>In re Rath</i> 402 F.3d 1207 (Fed. Cir. 2005) .....	30
<i>Sterling Drug, Inc. v. Bayer AG</i> 14 F.3d 733 (2d Cir. 1994) .....	28
<i>Vanity Fair Mills v. T. Eaton Co.</i> 234 F.2d 633 (2d Cir. 1956).....	9, 14, 31
<i>Weil Ceramics &amp; Glass, Inc. v. Dash</i> 878 F.2d 659 (3d Cir. 1989).....	29, 30
<u>European Union and German Cases</u>	
Bundesgerichtshof [BGH] [Federal Court of Justice], June 28, 2007 I ZR 49/04, Cambridge Institute (Ger.) .....	19

Bundesgerichtshof [BGH] [Federal Court of Justice], Nov. 7, 2019, I ZR 222/17, Club Hotel Robinson (Ger.).....	20
Case C-375/97, <i>General Motors Corporation v. Yplon SA</i> , ECLI:EU:C:1999:408.....	25
Case C-175/21, <i>Harman International Industries, Inc. v. AB SA</i> , ECLI:EU:C:2022:895.....	25
<i>Hewlett Packard v. Senetic</i> Case C-367/21 (EU).....	25
Bundesgerichtshof [BGH] [Federal Court of Justice], Oct. 13, 2004, I ZR 163/02, HOTEL MARITIME (Ger.) .....	19, 20
Case C-617/15, <i>Hummel Holding A/S v. Nike Inc. and Nike Retail B.V.</i> , ECLI:EU:C:2017:390.....	25, 32
Case C-324/09, <i>L'Oréal SA and Others v. eBay International AG and Others</i> , ECLI:EU:C:2011:474.....	22
Bundesgerichtshof [BGH] [Federal Court of Justice], Mar. 3, 2012, I ZR 75/10, OSCAR (Ger.).....	19
Case C-265/19, <i>Recorded Artists, Performers, Actors and others v. Ireland</i> , ECLI:EU:C:2020:677.....	32

Bundesgerichtshof [BGH] [Federal Court of Justice], Nov. 9, 2017, I ZR 134/16, Resistograph (Ger.) .....	20
Case C-251/95, <i>SABEL BV v. Puma AG, Rudolf Dassler Sport</i> , ECLI:EU:C:1997:528.....	22
<u>United States Statutes And Rules</u>	
15 U.S.C. § 1116 .....	21
15 U.S.C. § 1117 .....	21
15 U.S.C. § 1126 .....	7, 9, 30
15 U.S.C. § 1152 .....	18
U.S. Supreme Court Rule 37.2 .....	1
U.S. Supreme Court Rule 37.6 .....	1
<u>United States Constitutional Provisions</u>	
Article VI.....	29, 30
<u>International Treaties</u>	
Agreement on Trade-Related Aspects of Intellectual Property Rights, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, 1869 U.N.T.S. 299, 33 I.L.M. 1197 (1994).....	8
Article 2 .....	11
Article 3 .....	11

Article 15 .....	11
Article 16 .....	12, 13
Article 42 .....	12
Article 44 .....	12
Article 45 .....	12
Consolidated Version of the Treaty on European Union & Consolidated Version of the Treaty on the Functioning of the European Union, Mar. 30, 2010, 2010 OFFICIAL J. OF THE EUR. UNION (C 83) 13, 47 (EU) .....	1, 2
Paris Convention for the Protection of Industrial Property, <i>done</i> July 14, 1967, 21 U.S.T. 1583, 828 U.N.T.S. 305.....	7, 13
Article 6(1) .....	9
Article 6(3) .....	9
Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, <i>adopted</i> June 27, 1989, S. Treaty Doc. No. 41, 106th Cong., 2d Sess. (2000), T.I.A.S. 03-112 .....	3, 7, 8, 13
<u>European Union and German Legislative Materials</u>	
Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 .....	16, 19

Article 9 .....	20
Article 11 .....	20
Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 .....	3, 15
<b>German Trade Mark Act</b>	
Section 4 .....	17
Section 14 .....	20
Section 18 .....	20
Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark .....	3
Article 9 .....	21
Article 10 .....	21
Article 124 .....	17, 18
Article 125 .....	18
Article 126 .....	19
Article 131 .....	19, 20
<b><u>United States Legislative History Materials</u></b>	
H.R. REP. No. 374, 104th Cong., 1st Sess. 2 (1995).....	30



Office of the United States Trade Representative, The Uruguay Round Agreements Act Statement of Administrative Action: Agreement on Trade-Related Aspects of Intellectual Property Rights (1994).....	11
S. Rep. No. 87-1019 (1961), U.S.C.C.A.N. 3044 .....	15
<u>Secondary Sources</u>	
EUIPO Statistics For Union Trade Marks, 1996-01 to 2022-11 Evolution .....	24
European Commission, Directorate-General for Internal Market, Industry, Entrepreneurship and SMEs, Peter, V., Radauer, A., Markianidou, P., et al., <i>Support study for the ex-post evaluation and ex-ante impact analysis of the IPR enforcement Directive (IPRED) : final report (2017)</i> .....	24
Gustavo Bravo, From Paris Convention to TRIPs: A Brief History, 12 J. CONTEMP. LEGAL ISSUES 445 (2001) .....	11, 12
Paul J. Heald, Trademarks and Geographical Indications: Exploring the Contours of the TRIPs Agreement, 29 Vand. J. Transnat'l L. 635 (1996) .....	11
J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, § 29 (4th ed. 2002) .....	10

Wolfgang Kellenter, Andrea Schlaffge and  
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Mark Litigation in Germany: Overview,  
Practical Law Country Q&A w-010-4972  
(2022)* ..... 18, 19

**INTERESTS OF *AMICUS CURIAE***<sup>1</sup>

The European Commission is the executive body of the European Union, successor to the European Community as of December 1, 2009. The European Union includes twenty-seven member countries.<sup>2</sup> The Union is a treaty-based international organization with the authority to develop and enforce Union-wide legislation in the form of directives, regulations, and decisions in specified areas of policy. Such authority is conferred upon the Union by its member countries.<sup>3</sup>

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<sup>1</sup> Pursuant to Supreme Court Rule 37.2(a), counsel for the European Union notified all parties more than 10 days prior to the due date of European Union's intent to file an amicus brief, and all parties consented. Pursuant to Supreme Court Rule 37.6, the European Union states that no counsel for any party authored this brief in whole or in part and that no entity or person, aside from the European Union and its counsel, made any monetary contribution toward the preparation or submission of this brief.

<sup>2</sup> The member countries are Austria, Belgium, Bulgaria, Croatia, Cyprus, the Czech Republic, Denmark, Estonia, Finland, France, Germany, Greece, Hungary, Ireland, Italy, Latvia, Lithuania, Luxembourg, Malta, the Netherlands, Poland, Portugal, Romania, Slovakia, Slovenia, Spain and Sweden.

<sup>3</sup> The European Union is currently based on two treaties setting out its primary law: the Treaty on the European Union (TEU) and the Treaty on the Functioning of the European Union (TFEU). Consolidated versions of the TEU and TFEU are published in the *Official Journal of the European Union*, which was called the Official Journal of the European Communities until February 1, 2003. See *Consolidated Version of the Treaty on European Union & Consolidated Version of the Treaty on the Functioning of the*

The European Union and its member countries have adopted legislation on intellectual property rights in the following areas: trademarks, copyright, industrial designs, geographic indications, and patents. In common with other nations throughout the world, Union intellectual property legislation is based on the principle of territoriality. i.e., intellectual property rights are limited to the territorial boundaries of the granting authority.

The effect of the principle of territoriality in member countries of the Union, as in all other nations, is that the very existence and exercise of an intellectual property right is closely related to the sovereignty of the State or regional authority granting recognition and protection of that right. Trademark rights end at the border of a national territory, so that, by definition, the infringement of a trademark right can only take place in the state that grants the right, and not beyond its boundaries. In addition, some trademark rights take effect only after procedural or administrative formalities, such as application and registration, which involve local public authorities—namely regional or national trademark offices.

The European Union has established a legal framework whereby national and regional (Union-wide) systems coexist, and infringements are dealt with by the national courts of Union member countries. At the national level, a trademark can be applied for, registered, and exercised only in the

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*European Union*, Mar. 30, 2010, 2010 OFFICIAL J. OF THE EUR. UNION [hereinafter O.J.] (C 83) 13, 47 (EU).

member country in which protection is sought (a national trademark). Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 (the Trade Marks Directive) harmonizes the national trademark rules and aligns them with the Union-wide system of Union trademarks, which can be applied for and registered with unitary effect throughout the European Union. Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (the EUTM Regulation) establishes rules and conditions for granting, protecting and enforcing Union trademarks.

In common with all other European Union intellectual property rights, the Union trademark system is based on the principle of territoriality either for national marks in individual member countries or at the regional level for EUTM trademarks. The principle of territoriality also provides the foundation for international treaties in the field of intellectual property rights, including the Paris Convention, the Madrid Protocol, and TRIPs, all of which include the European Union and all of its member countries as parties. The United States also is a party to all three of these treaties. The Paris Convention and TRIPs require national treatment, i.e., that member countries treat foreign trademark holders the same way they treat domestic trademark holders, including with respect to the availability of remedies in the event of infringement. The Madrid Protocol sets forth an international trademark registration system.

The decision of the Tenth Circuit in this case threatens to upset the carefully balanced

international trademark system. The Paris Convention and TRIPs would be undermined and the international trademark registration system codified in the Madrid Protocol would be rendered futile if national courts could adjudicate alleged infringement outside their territorial boundaries, and inside the territorial boundaries of other sovereign States.

The European Union therefore has a concrete interest, for itself and its member countries, in protecting the functioning of the trademark system, irrespective of the nationality of rightsholders, and consistent with national, Union, and international law. Extraterritorial application of United States law to trademark use that occurs within the European Union threatens to interfere with the legal authority of the European Union and its member countries, in contravention of international law and principles of comity.

### SUMMARY OF ARGUMENT

The European Commission submits this brief on behalf of the European Union as *amicus curiae* in support of neither party.

The Court should decline to interpret the Lanham Act to apply extraterritorially to acts of infringement occurring in in the European Union. There exists via three international treaties—the Paris Convention, the Madrid Protocol, and TRIPs—a robust international system to protect the rights of United States trademark holders abroad based on the principle of territoriality. The Paris Convention requires that foreign nationals be given the same

treatment in each member country as that country provides to its own citizens. The Madrid Protocol likewise ensures compatible cross-border treatment of trademarks at the registration stage, by establishing an international trademark registration system, which enables foreign nationals both to obtain protection for and enforce their trademark rights abroad under local law. Finally, TRIPs reinforces national treatment and provides additional protection against infringement, and it gives enforcement teeth to the Paris Convention. These three treaties collectively provide an effective system for the registration and protection of trademarks across the United States, the European Union, and individual Union countries. Union law fully reflects the European Union's obligations under the international system, protecting the intellectual property rights of Union nationals and United States nationals alike.

As implemented in Union law, the international system provides full protection for United States rightsholders with trademark interests in any member country in the European Union. Like United States law, Union law as applied in the Union member countries protects registered and unregistered trademarks, and provides for effective remedies such as injunctive relief, damages, and the seizure and destruction of goods in the event of infringement.

This case concerns, among other things, alleged infringement in the territory of the European Union, and in particular, Germany. Union law as applied in Germany provides the United States holder of a trademark in the Union, and/or in a member country such as Germany, with guarantees of national

treatment and effective and robust remedies for acts of infringement that occur anywhere in the territory of a member country of the Union. The test for infringement in the European Union, including in Germany, like the United States, assesses whether there is a likelihood of consumer confusion, and both jurisdictions use similar factors to make that determination. Thus, for putative United States plaintiffs, like Respondents in this case, Union law and the corresponding German law provide ample tools to address trademark infringement in Germany without allowing United States courts to intervene or apply United States law. And, in this case, both parties actually invoked the European and German systems and courts.

Under this international system, which was set up expressly to account for the territorial limits of nationally granted trademarks, the courts of the United States may not adjudicate an alleged infringement outside the territory of the United States. Like any nationally granted trademark, a United States trademark applies and has effect only in the territory of the United States. Indeed, it is not within the jurisdictional authority of *any* national court *anywhere* in the world to extend a trademark beyond the boundaries of the state that granted the trademark at issue. In addition, other considerations such as the nationality of the plaintiff and the defendant are addressed by the national treatment obligations that require states to provide equal treatment for all foreign nationals. These principles apply because of comity, and also because of the United States' obligations under international law. The Paris Convention and TRIPs, both of which



Congress implemented through the Lanham Act, and particularly through 15 U.S.C. § 1126, are the supreme law of the United States. Congress's affirmative implementation through the Lanham Act of treaties effecting a national, territorial, trademark regime means that far from rebutting the presumption against extraterritorial application of United States law, Congress enshrined it. To hold otherwise and allow extraterritorial application of the Lanham Act would disrupt the territorial, international system to which the United States, the European Union and Germany have subscribed via the Paris Convention and TRIPs by incorporating their international legal obligations into their respective national laws and, in the case of the European Union, regional law.

## ARGUMENT

### **I. There Exists A Robust International System To Protect United States Holders of Trademark Rights Abroad**

The international trademark regime comprises three main treaty systems:

- (1) Paris Convention for the Protection of Industrial Property, *done* July 14, 1967, 21 U.S.T. 1583, 828 U.N.T.S. 305 (Paris Convention), *available at* [bit.ly/3BRRvzO](http://bit.ly/3BRRvzO);
- (2) Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, *adopted* June 27, 1989, S. Treaty Doc. No. 41, 106th Cong., 2d Sess. (2000),

T.I.A.S. 03-112 (Madrid Protocol), *available at* [bit.ly/3hDB7w9](http://bit.ly/3hDB7w9); and

- (3) Agreement on Trade-Related Aspects of Intellectual Property Rights, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, 1869 U.N.T.S. 299, 33 I.L.M. 1197 (1994), *available at* [bit.ly/3hN1cZx](http://bit.ly/3hN1cZx).

These three treaty regimes govern the treatment of United States nationals who hold trademarks in the European Union, and the treatment of Union nationals who hold trademarks in the United States.

The Paris Convention, originally adopted in 1883, and acceded to by the United States in 1887,<sup>4</sup> has been described as:

essentially a compact between the various member countries to accord in their own countries to citizens of the other contracting parties trade-mark and other rights comparable to those accorded their own citizens by their domestic law. The underlying principle is that foreign nationals should be given the same treatment in each of the member

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<sup>4</sup> The United States has also ratified amendments to the Paris Convention as revised at Brussels in 1900, at Washington in 1911, at The Hague in 1925, at London in 1934, at Lisbon in 31, 1958, and at Stockholm in 1967. Contracting Parties, Paris Convention, United States of America, *available at* [bit.ly/3FMfsK6](http://bit.ly/3FMfsK6).

countries as that country makes available to its own citizens. In addition, the Convention sought to create uniformity in certain respects by obligating each member nation to assure to nationals of countries of the Union<sup>[5]</sup> an *effective protection against unfair competition*.

*Vanity Fair Mills v. T. Eaton Co.*, 234 F.2d 633, 640 (2d Cir. 1956) (emphasis added; internal quotations omitted); *see also Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894 (9th Cir. 2002) (affirming that the Paris Convention is intended to ensure “national treatment”); *Int’l Cafe v. Hard Rock Cafe Int’l*, 252 F.3d 1274, 1277 (11th Cir. 2001) (same); 15 U.S.C. § 1126(b) (incorporating the Paris Convention and other treaties into United States law by entitling nationals of member countries “to the benefits of this section under the conditions expressed herein to the extent necessary to give effect to any provision of” those treaties); Paris Convention, art. 6(1) (“The conditions for the filing and registration of trademarks shall be determined in each country of the Union [of the Paris Convention] by its domestic legislation.”); *id.*, art. 6(3) (“A mark duly registered in a country of the Union shall be regarded as independent of marks

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<sup>5</sup> For avoidance of confusion, the use of “Union” in this quote and other references to the Paris Convention means the Union created by that treaty. *See* Paris Convention, Art. 1 (“The countries to which this Convention applies constitute a Union for the protection of industrial property.”).

registered in the other countries of the Union, including the country of origin.”).

As the Fourth Circuit explained, quoting the “distinguished commentary” *McCarthy on Trademarks and Unfair Competition*, the Paris Convention “recognizes the principle of the territoriality of trademarks [in the sense that] a mark exists only under the laws of each sovereign nation.” *Barcelona.com, Inc. v. Excelentísimo Ayuntamiento de Barcelona*, 330 F.3d 617, 628 (4th Cir. 2003) (quoting J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 29 (4th ed. 2002) ; alterations in original).

The Madrid Protocol likewise ensures compatible cross-border treatment of trademarks at the registration stage. “The Protocol establishes an international trademark registration system, and the United States’ participation in that system became operative upon the effective date [November 2, 2003] of a new Title XII of the Lanham Act, which added §§ 60-74 to the” Lanham Act, originally enacted in 1946. *Lodestar Anstalt v. Bacardi & Co.*, 31 F.4th 1228, 1237 (9th Cir. 2022). Under the Protocol, “holders of trademark rights in their respective countries” may “‘secure protection’ for their marks in other contracting parties by obtaining, through their home country’s trademark office, an ‘international registration’ in the ‘register of the International Bureau of the World Intellectual Property Organization.’” *Id.* at 1237-38 (quoting Madrid Protocol, art. 2).

Finally, as described by the United States Trade Representative, TRIPs “establish[es] comprehensive standards for the protection of intellectual property and the enforcement of intellectual property rights in WTO [World Trade Organization] member countries. It requires each WTO member country to apply the substantive obligations of the world’s most important intellectual property conventions, supplement those conventions with substantial additional protection, and ensures that critical enforcement procedures will be available in each member country to safeguard intellectual property rights.” *Dam Things From Denmark v. Russ Berrie Co.*, 290 F.3d 548, 555, n. 5 (3d Cir. 2002) (quoting Office of the United States Trade Representative, *The Uruguay Round Agreements Act Statement of Administrative Action: Agreement on Trade-Related Aspects of Intellectual Property Rights* (1994)); *see also* TRIPs, art. 15(1) (defining the “protectable subject matter” of trademarks).

TRIPs thus gave additional teeth to international trademark law, and made available additional tools for trademark holders that the Paris Convention did not provide. *See, e.g.*, TRIPs, Arts. 2, 3 (incorporating portions of the Paris Convention); Paul J. Heald, Trademarks and Geographical Indications: Exploring the Contours of the TRIPs Agreement, 29 VAND. J. TRANS. LAW 635 at 649-50 (1996) (noting that “[s]everal commentators have noted that the enforcement provisions of the TRIPs Agreement are the most promising sections in the Agreement” because TRIPs contains enforcement provisions that the Paris Convention does not); Gustavo Bravo, From Paris Convention to TRIPs: A Brief History, 12 J.

CONTEMP. LEGAL ISSUES 445, 448 (2001) (“Dissatisfied with the progress being made by WIPO on substantive and enforcement issues for international intellectual property, the United States and other nations turned to the 1994 negotiations regarding the General Agreement on Tariffs and Trade (GATT) for the purpose. The result was the Trade Related Aspects of Intellectual Property Rights (TRIPs).”).

TRIPs provides: “The owner of a registered trademark shall have the exclusive right to prevent all third parties not having the owner’s consent from using in the course of trade identical or similar signs for goods or services which are identical or similar to those in respect of which the trademark is registered where such use would result in a likelihood of confusion.” TRIPs, art. 16(1). It then mandates: “Members shall make available to right holders civil judicial procedures concerning the enforcement of any intellectual property right covered by this Agreement.” TRIPs, art. 42. TRIPs further provides for injunctive relief and “damages adequate to compensate for the injury the right holder has suffered because of an infringement of that person’s intellectual property right” plus “expenses, which may include appropriate attorney’s fees.” TRIPs, art. 44, art. 45. It also promises “Fair and Equitable Procedures,” i.e., due process. *Id.*, art. 42 (“Defendants shall have the right to written notice which is timely and contains sufficient detail, including the basis of the claims. Parties shall be allowed to be represented by independent legal counsel, and procedures shall not impose overly burdensome requirements concerning mandatory personal appearances....”).

Read together, the TRIPS Agreement and the Paris Convention, whilst affirming the territorial nature of trademark rights, also harmonize the main substantive trademark norms of national laws by laying down minimum standards and granting equal treatment to trademark owners whether they are nationals or non-nationals. The Madrid Protocol works with the TRIPs Agreement and the Paris Convention to enable foreign nationals to easily obtain the “registered trademark” required for enforcement under TRIPs Article 16(1). These three treaties provide a robust system for registering and enforcing the rights of foreign nationals with respect to their trademarks both in the United States and abroad in World Trade Organization member countries, which include the United States, the European Union, and individual Union member countries. TRIPs membership, *available at* [bit.ly/3BQJ0oQ](http://bit.ly/3BQJ0oQ); Madrid Protocol Membership, *available at* [bit.ly/3WD1pgy](http://bit.ly/3WD1pgy); Paris Convention Membership, *available at* [bit.ly/3YGpRj7](http://bit.ly/3YGpRj7).

The United States has long embraced the international trademark treaty system. As the Second Circuit noted in 1956:

“The [Paris] Convention is not premised upon the idea that the trademark and related laws of each member nation shall be given extraterritorial application, but on exactly the converse principle that each nation’s law shall have only territorial application. Thus a foreign national of a member nation using his trademark in commerce in the United

States is accorded extensive protection here against infringement and other types of unfair competition by virtue of United States membership in the Convention. But that protection has its source in, and is subject to the limitations of, American law, not the law of the foreign national's own country. Likewise, the International Convention provides protection to a United States trade-mark owner such as plaintiff against unfair competition and trade-mark infringement in

a foreign country under the laws of that country. *Vanity Fair, supra*, 234 F.2d at 640-41. The State Department, in a statement submitted to the Senate, echoed those sentiments in 1961, recognizing the importance of the treaty system for purposes of international relations:

The [State] Department also considers [the Paris] convention the most effective mechanism for insuring continuing and sound cooperative relations with other countries in the industrial property rights field. The convention is based on two important principles; namely, 'national treatment' and the extension of special rights or advantages. Under the 'national treatment' principle each member country is required to extend to nationals of other member countries the same protection and rights which it grants to its own nationals in this field."



S. Rep. No. 87-1019 (1961), reprinted in 1961 U.S.C.C.A .N. 3044, 3048.

There is no need to apply the Lanham Act extraterritorially where, as explained below, the international system in which the United States and the European Union and its member countries participate, is working.

## **II. European Union And German Law Implement The International System And Provide Relief For United States Rightsholders For Infringement That Occurs in Germany**

As noted above, the European Union and Germany, where the alleged infringement in this case occurred, are bound by the Paris Convention, the Madrid Protocol, and TRIPs.

Like the United States, the European Union and Germany have implemented the Paris Convention, the Madrid Protocol, and TRIPs. In the European Union, the Trade Marks Directive provides a legal framework whereby national trademarks can be applied for, registered, and exercised only in the member country where protection is sought. Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015, *available at* [bit.ly/3hJk4Zv](http://bit.ly/3hJk4Zv). The EUTM Regulation provides for Union-wide trademarks subject to Union-wide uniform rules and conditions. The Trade Marks Directive ensures that national trademarks are harmonized among member countries and aligned with the Union-wide EUTM Regulation, which

governs Union-wide trademarks. EUTM Regulation, available at [bit.ly/3GbUE03](http://bit.ly/3GbUE03). The Union trademark is a unitary right valid throughout the entire Union. Union trademarks are registered at the European Union Intellectual Property Office (the EUIPO), which is an agency of the European Union.<sup>6</sup>

Furthermore, the Enforcement Directive (Directive 2004/48) specifically implements the minimum remedies that TRIPs requires for all rightsholders, regardless of nationality. Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004, available at [bit.ly/3WFDbT7](http://bit.ly/3WFDbT7). This Directive requires all Union member countries to apply effective, dissuasive, and proportionate remedies and penalties against infringers, and it aims to create a level playing field for rightsholders in the Union. The Directive applies without prejudice to the particular provisions for the enforcement of rights, such as the Trademark Directive and the EUTM Regulation. This legal framework collectively ensures common standards, and thus equivalent protection, for rightsholders—foreign and national—in all member countries of the European Union. *Id.*

The courts of the individual countries of the European Union are competent to apply Union trademark law for infringements that occur in their

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<sup>6</sup> Union law relating to trademarks does not replace the trademark laws of the member countries. National trademarks continue to be necessary for undertakings that do not seek Union-wide protection, or which are unable to obtain Union-wide protection, but are protectable at the national level.

territories. As the alleged infringement at issue in this case occurred in Germany, the courts of Germany must accord United States rightsholders like Respondent the same protection that they afford their own citizens in respect of an alleged infringement in Germany. German courts and remedies for trademark infringement must be equally available to United States nationals who hold German trademarks as they are for German nationals who hold German trademarks.

The enforcement of rights conferred by a Union trademark lies with Union trademark courts designated by the member countries. Those courts have exclusive jurisdiction in all disputes concerning the infringement and validity of Union trademarks. EUTM Regulation. Art. 124, *available at [bit.ly/3GbUE03](http://bit.ly/3GbUE03)*.

United States rightsholders and other foreign trademark holders can also obtain protection in the European Union for enforcement of rights conferred under national trademarks, by national courts. The courts of the member countries in which the trademark at issue is registered are best placed to assess whether an act has taken place in their territory that infringes the protected national mark. Member countries' national trademark law (substantive and procedural), in this case the law of Germany, must also conform to the Union's Trade Marks Directive.

The German Trade Mark Act provides for trademark protection of registered and unregistered marks. *Compare* German Trade Mark Act § 4

(protecting registered marks, “the use of a sign in trade in so far as the sign has acquired public recognition as a trade mark within the affected trade circles,” and “a trade mark constituting a well-known mark within the meaning of Article 6bis of the Paris Convention”),<sup>7</sup> *with* 15 U.S.C. §§ 1152 (defining marks that may be registered) & 1125 (defining protections available for unregistered marks). In cases involving a registered Union trademark, competent German courts must directly apply the Union Trademark Regulation.

Where a party alleges infringement of a registered or unregistered German mark or a registered Union mark, it may file an action for infringement. Union countries must designate Union trademark courts. These courts have exclusive jurisdiction in all disputes concerning the infringement and validity of Union trademarks. EUTM Regulation, Art. 124, *available at* [bit.ly/3GbUE03](http://bit.ly/3GbUE03). Article 125 of the Union Trademark Regulation provides for competent courts in the Union for litigation involving parties who are not Union nationals, including United States nationals. EUTM Regulation, Art. 125(2), *available at* [bit.ly/3GbUE03](http://bit.ly/3GbUE03). In Germany, each German federal state has district and appellate courts that specialize in trademark law. *See* Wolfgang Kellenter, Andrea Schlaffge and Astrid Harmsen, Hengeler Mueller, *Trade Mark Litigation in*

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<sup>7</sup> A translation of the German Trade Mark Act by the German Patent and Trade Mark Office is available at [bit.ly/3HWSBmu](http://bit.ly/3HWSBmu). All references to the German Trade Mark Act reference this particular translation.

*Germany: Overview*, PRACTICAL LAW COUNTRY Q&A W-010-4972 (2022). The jurisdiction of these courts is limited to trademarks protected in and infringed in Germany. Bundesgerichtshof [BGH] [Federal Court of Justice], Mar. 3, 2012, I ZR 75/10, OSCAR (Ger.) § 34 ; Bundesgerichtshof [BGH] [Federal Court of Justice], Oct. 13, 2004, I ZR 163/02, HOTEL MARITIME (Ger.), § 21 ; Bundesgerichtshof [BGH] [Federal Court of Justice], June 28, 2007 I ZR 49/04, Cambridge Institute (Ger.), § 26 .

The trademark courts in all Union member countries adhere to the territoriality principle, as required under Union law. Pursuant to Article 126 of the EUTM Regulation, *available at* [bit.ly/3GbUE03](http://bit.ly/3GbUE03), Union trademark courts have jurisdiction only over acts of infringement committed or threatened within the territory of any of the member countries. They do not have jurisdiction over infringement occurring outside the European Union. Remedies for infringement are likewise limited to the European Union's territorial boundaries. *See* EUTM Regulation, Art. 131 (authorizing injunctions for infringement occurring or threatened “in the territory of any Member State”), *available at* [bit.ly/3GbUE03](http://bit.ly/3GbUE03). Such limitations are compelled by the principle of territoriality.

Union member countries, including Germany, are also required to maintain a robust system of remedies pursuant to the EUTM Regulation and the Enforcement Directive (Directive 2004/48, *available at* [bit.ly/3WFDbT7](http://bit.ly/3WFDbT7)) for holders of national or EUTM trademarks. This system is also guided by the territoriality principle. Claims for injunctive relief are

only justified if the infringement is taking place within the territorial scope of the trademark in question or, in the case of preventive injunctions, where infringement is seriously threatened. Under Article 131 of the EUTM Regulation, *available at [bit.ly/3GbUE03](http://bit.ly/3GbUE03)*, a Union trademark court with international jurisdiction can grant provisional and protective measures within the European Union, “in the territory of any Member State.”

The Enforcement Directive provides for provisional and permanent injunctive relief. Enforcement Directive, Arts. 9 & 11, *available at [bit.ly/3WFDbT7](http://bit.ly/3WFDbT7)*. In Germany, provisional relief may be obtained via preliminary injunction for infringement occurring or threatened in Germany. German Trade Mark Act § 14(5) (providing for injunctive relief). A plaintiff also has the option to seek destruction or confiscation of infringing goods, an accounting, and compensatory damages, including for lost profits based on infringement occurring in Germany. *Id.* § 14(6) (damages and profits); § 18 (destruction of infringing goods); *see also* BGH, I ZR 163/02, HOTEL MARITIME (Ger.), § 21 ; Bundesgerichtshof [BGH] [Federal Court of Justice], Nov. 9, 2017, I ZR 134/16, Resistograph (Ger.), § 37 ; Bundesgerichtshof [BGH] [Federal Court of Justice], Nov. 7, 2019, I ZR 222/17, Club Hotel Robinson (Ger.), § 25 . Relief is regularly given if counterfeit goods are sold domestically or services are offered under another’s trademark in Germany. BGH, I ZR 222/17, Club Hotel Robinson (Ger.); BGH, I ZR 163/02, HOTEL MARITIME (Ger.), with further references.

The remedies available under Union and German law are similar to remedies available under United States law. *See* 15 U.S.C. § 1116 (injunctive relief); § 1117 (profits and damages); § 1118 (delivery and destruction of infringing goods). Union and German law, however, do not provide for punitive damages or treble damages, which might be available under United States law. *Compare Trade Mark Litigation in Germany: Overview, supra* (enhanced damages not available under German trademark law), *with* 15 U.S.C. § 1117(b) (authorizing treble damages).

Substantively, the Union law test for infringement is similar to the United States likelihood of confusion test. A court in any member country (including Germany) that is competent to rule on trademark infringement would assess “whether there exists a likelihood of confusion on the part of the public.” EUTM Regulation, Art. 9 . *available at* [bit.ly/3GbUE03](http://bit.ly/3GbUE03), Art. 10 Trademark Directive § 2(b) , *available at* [bit.ly/3hJk4Zy](http://bit.ly/3hJk4Zy). The test for what constitutes likelihood of confusion has been explicated by the European Court of Justice in its case law on both the Trade Marks Directive and the EUTM Regulation. The test for consumer confusion concerns use that occurs in the Union or in individual member countries. Consumer confusion includes acts of targeting consumers in the territory of the Union, and it excludes the mere accessibility of a website from the territory covered by the trademark which, consistent

with the principle of territoriality, does not constitute targeting consumers.<sup>8</sup>

German courts are required to apply the Union law standard when they decide whether there exists a likelihood of confusion in a particular case. The criteria that all courts in member countries of the Union, including Germany, must apply include:

- Degree of distinctiveness of the earlier trademark.
- Identity or degree of similarity of the goods and services.
- Identity or degree of similarity of the conflicting signs.
- Nature of the goods or services

Case C-251/95, *SABEL BV v. Puma AG, Rudolf Dassler Sport*, ECLI:EU:C:1997:528, available at [bit.ly/3hIaAh0](https://bit.ly/3hIaAh0).

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<sup>8</sup> Thus, in a case involving a United States defendant, the European Court of Justice held in the context of an online marketplace accessible from within the Union that if it were sufficient for advertisements displayed on websites merely accessible to consumers to be within the scope of Union trademark law, then websites and advertisements which, although obviously targeted solely at consumers in third States, which are nevertheless technically accessible from Union territory, would wrongly be subject to Union law. Case C-324/09, *L'Oréal SA and Others v. eBay International AG and Others*, ECLI:EU:C:2011:474, available at [bit.ly/3YMBhSj](https://bit.ly/3YMBhSj).



The substantive standards that apply in the European Union, including Germany, are comparable to United States law. *See, e.g., Brennan's, Inc. v. Brennan's Restaurant*, 360 F.3d 125, 130 (2d Cir. 2004) (setting forth likelihood of confusion factors similar to those applicable in the Union and Germany); *La Quinta Worldwide LLC v. Q.R.T.M., S.A. de C.V.*, 762 F.3d 867 (9th Cir. 2014) (same); *Frehling Enterprises v. Int'l Select Group*, 192 F.3d 1330, 1335 (11th Cir. 1999) (same).

In sum, Union trademark law, including its application by the competent national courts of member countries, on the one hand, and United States trademark law, on the other hand, are substantively similar. That there are small differences, such as the availability of treble or punitive damages, is inherent in and contemplated by the national treatment system established by the Paris Convention and TRIPs, where instead of a global trademark system, each country complies with its international law obligations by implementing and applying its own laws to nationals and foreigners without discrimination. Union law as applied in Germany provides sufficient remedies, consistent with international law, for infringement within the Union and Germany.

### **III. The International Trademark System Works, And It Has Worked Specifically In This Case**

The efficacy of the international trademark system, and the ability of United States rightsholders to obtain trademark protection in the European Union is not merely hypothetical. United States rights

holders submitted 17,529 applications for EUTM trademarks in 2020; 20,205 in 2021; and 18,088 in 2022. This represents 33.23% of all applications for EUTM trademarks, and United States rightsholders also hold 32% of registered EUTM trademarks during the last three years. EUIPO Statistics For Union Trade Marks, 1996-01 to 2022-11 Evolution at 2.4, 5.3, available at [bit.ly/3BTsvbg](https://bit.ly/3BTsvbg). The United States ranks third among all countries worldwide in Union Trade Mark applications, and first in priority claims.<sup>9</sup> *Id.* at 2.5, 2.11. Moreover, in 2016, the European Commission conducted an evaluation of the Enforcement Directive to improve further the application and enforcement of those rights, and the Commission expressly took into account the views of United States companies. European Commission, Directorate-General for Internal Market, Industry, Entrepreneurship and SMEs, Peter, V., Radauer, A., Markianidou, P., et al., *Support study for the ex-post evaluation and ex-ante impact analysis of the IPR enforcement Directive (IPRED) : final report (2017)*, available at [bit.ly/3FMfYI2](https://bit.ly/3FMfYI2) at 34.

United States rightsholders are active in pursuing and protecting their rights before Union courts. Indeed, there are numerous examples of significant judgments by the European Court of Justice involving questions of interpretation of the Trade Marks Directive and the Union Trademark

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<sup>9</sup> This means that an applicant who files a trademark application in one country may, within six months, apply for trademark protection in other nations with reciprocal agreements like the Madrid Protocol.

Regulation in disputes involving U.S. rightsholders. Examples include Case C-375/97, *General Motors Corporation v. Yplon SA*, ECLI:EU:C:1999:408, available at [bit.ly/3Wh6cV7](https://bit.ly/3Wh6cV7); Judgment of September 29, 1998, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc., formerly Pathe Communications Corporation*, Case C-39/97, ECLI:EU:C:1998:442, available at [bit.ly/3WFxvZ1](https://bit.ly/3WFxvZ1); Case C-175/21, *Harman International Industries, Inc. v. AB SA*, ECLI:EU:C:2022:895, available at [bit.ly/3WBdjYh](https://bit.ly/3WBdjYh); Case C-617/15, *Hummel Holding A/S v. Nike Inc. and Nike Retail B.V.*, ECLI:EU:C:2017:390, available at [bit.ly/3jgQFWR](https://bit.ly/3jgQFWR); *Hewlett Packard v. Senetic*, Case C-367/21 (EU), available at [bit.ly/3VjoQue](https://bit.ly/3VjoQue) (pending).

Not only do the international trademark protection mechanisms work for United States rightsholders generally, they have worked in this case. Both Petitioner Abitron Germany GmbH and Respondent Hetronic International, Inc. invoked Union and German law to protect their interests in Germany. They have *thirty-eight* registered trademarks between them, and they collectively have filed at least *fourteen* different trademark-related proceedings in the European Union and German courts and trademark offices. These cases involve disputes in the context of administrative proceedings before national trademark offices or EUIPO and separate actions based on infringement. This type of trademark litigation scenario is not unusual where, as here, the parties have a historical commercial relationship. Representative cases include, for example, *ABITRON Germany GmbH v. Hetronic International, Inc., Methode Electronics International*

*GmbH*, Regional Court of Munich Case No. 33 O 14670/19, which involves two of the trademarks at issue in the case at bar (“GL” and “GR”). In that case, the Regional Court of Munich ruled in favor of Hetric International, and Abitron Germany appealed.

Similarly, in *Method Electronics International GmbH v. ABITRON Germany GmbH*, which was pending in the Regional Court of Nuremberg, Case No. 19 O 3574/20, Methode Electronics International GmbH sought to litigate its rights in the “NOVA” trademark, also at issue in this litigation, and sought injunctive relief, a declaration regarding monetary relief, and destruction of infringing goods. That case had been suspended pending resolution of a related case before the European Court of Justice, *ABITRON Germany GmbH vs. EUIPO*, in which ABITRON Germany GmbH filed an unsuccessful application for annulment of the EUIPO’s decision to declare Hetric International, Inc.’s registration of the European “NOVA” trademark invalid. The European Court of Justice dismissed that application and refused ABITRON Germany GmbH leave to appeal. Order of December 13, 2021, *Abitron Germany vs. EUIPO*, Case C-589/21 P, ECLI:EU:C:2021:1012, available at [bit.ly/3BUDLUW](https://bit.ly/3BUDLUW). The “NOVA” trademark proceedings represent only a fraction of the many proceedings in the German and European

trademark offices addressing the parties' trademark rights in Germany and Europe more broadly.<sup>10</sup>

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<sup>10</sup> See, e.g., *ABITRON Germany GmbH v. Hetronic International, Inc.*, German Patent and Trademark Office Case No. 30 2020 010 728.8/36 (opposition by ABITRON Germany GmbH to Hetronic International, Inc.'s application for registration of the "GL" trademark in Germany); *ABITRON Germany GmbH v. Hetronic International, Inc.*, German Patent and Trademark Office Case No. 30 2020 010 726.1/36 (same for trademark "GR"); *Hetronic International, Inc. v. ABITRON Germany GmbH*, German Federal Patent Court Case No. 30 W (pat) 50/21 (appeal of unsuccessful request by Hetronic, Inc. to cancel ABITRON Germany GmbH's registration of the "GL" trademark); *Hetronic International, Inc. v. ABITRON Germany GmbH*, German Federal Patent Court Case No. 30 W (pat) 68/21 (appeal of unsuccessful request by Hetronic, Inc. to cancel ABITRON Germany GmbH's registration of the "GR" trademark); *ABITRON Germany GmbH v. Hetronic International, Inc.*, EUIPO Case No. 000050472 C (application by ABITRON Germany GmbH to declare Hetronic International, Inc.'s registration of the European "NOVA" trademark invalid); *Hetronic International, Inc. v. ABITRON Germany GmbH*, EUIPO Case No. 000041986 C (application by Hetronic International, Inc. to declare ABITRON Germany GmbH's registration of the Union "GL" trademark invalid); *Hetronic International, Inc. v. ABITRON Germany GmbH*, EUIPO Case No. 000042022 C (same for Union "GR" trademark); *ABITRON Germany GmbH v. Hetronic International, Inc.*, EUIPO Case No. B 003127943 (opposition by ABITRON Germany GmbH to Hetronic International, Inc.'s registration of the Union trademark "GL"); *ABITRON Germany GmbH v. Hetronic International, Inc.*, EUIPO Case No. B 003127967 (same for Union trademark "GR").

**IV. Extraterritorial Application Of The Lanham Act Risks Disrupting The International Trademark Regime, And Violating The United States' Obligations Under International Law**

It would be unseemly at best for U.S. courts to police allegations of infringement occurring in Germany, thereby ignoring or disregarding decisions made in a foreign judicial system according to the laws that apply in that system, especially when those laws implement international treaty obligations that equally bind the United States. For more than two hundred years, this Court has, in the name of comity, avoided meddling in extraterritorial affairs. *See, e.g., Murray v. Schooner Charming Betsy*, 6 U.S. 64, 118, 2 Cranch 64, 2 L.Ed. 208 (1804) (“an act of Congress ought never to be construed to violate the law of nations if any other possible construction remains”); *Hilton v. Guyot*, 159 U.S. 113, 163 (1894) (international comity is “[t]he extent to which the law of one nation, as put in force within its territory, whether by executive order, by legislative act, or by judicial decree, shall be allowed to operate within the dominion of another nation.”); *Sterling Drug, Inc. v. Bayer AG*, 14 F.3d 733, 746-47 (2d Cir. 1994) (“It is one thing ... to be barred under United States law from boycotting activity that they might be free to engage in without violating British law. But it is quite a different thing for the holder of rights in a mark under German law to be ordered by a United States court to refrain from uses of that mark protected by German law.”).

The instant matter presents an even more compelling case to respect sovereign boundaries. Both parties hold United States trademarks, and with its order, the Tenth Circuit purports to extend the effect of the United States trademark held by the United States plaintiff beyond the territory of the United States. The international trademark system, which includes the United States, the European Union, and Germany, does not allow for the courts of one country to reach across international borders to protect its nationals from trademark infringement overseas. Quite the contrary, the international system requires each participating country to make its own national courts available for such infringement, and it requires each participating country to treat foreign nationals the same as its own nationals. The system only works if all participating states respect their obligations, including the limits on their power.

Article VI, Clause 2 of the Constitution provides: “all Treaties made, or which shall be made, under the Authority of the United States, shall be the supreme Law of the Land.” While “treaties may comprise international commitments ... they are not domestic law unless Congress has either enacted implementing statutes or the treaty itself conveys an intention that it be ‘self-executing’ and is ratified on these terms.” *Medellin v. Texas*, 552 U.S. 491 (2008); *see also Garcia v. Texas*, 564 U.S. 940, 945 (2011) (“This Court subsequently held that, *because Congress had not embodied our international legal obligations* [under the Vienna Convention on Consular Relations] *in a statute*, the Court lacked the power to enforce those obligations as a matter of domestic law.”); *Weil Ceramics & Glass, Inc. v. Dash*, 878 F.2d

659, 679 (3d Cir. 1989) (“The Paris Convention is the law in the United States by virtue of Article VI of the Constitution and is explicitly implemented by the Lanham Act in section 44(b)”).

Here, Congress has consciously enacted implementing legislation for the Paris Convention, which on its face also applies to TRIPs: “Any person whose country of origin is a party to any convention or treaty relating to trademarks ... to which the United States is also a party, or extends reciprocal rights to nationals of the United States by law, shall be entitled to the benefits of this section under the conditions expressed herein to the extent necessary to give effect to any provision of such convention, treaty or reciprocal law.” 15 U.S.C. § 1126. *See, also e.g., In re Rath*, 402 F.3d 1207, 1216 (Fed. Cir. 2005) (“Congress has repeatedly reaffirmed that the Lanham Act implemented the United States’ obligations under the Paris Convention.”); *In re Compagnie Generale Maritime*, 993 F.2d 841, 850 (Fed. Cir. 1993) (“Since 1887, the United States has adhered to the ‘Paris Convention.’”); *International Café, S.A.L.*, 252 F.3d at 1278 (Lanham Act incorporates the Paris Convention); *Barcelona.com*, 330 F.3d at 628 (“Section 44 of the Lanham Act, 15 U.S.C. § 1126, incorporates the Paris Convention into United States law, but only to provide foreign nationals with rights under United States law which are coextensive with the substantive provisions of the treaty involved.” (quotations omitted)); H.R. REP. No. 374, 104th Cong., 1st Sess. 2 (1995) at 4 (noting with respect to the Federal Trademark Dilution Act of 1995 that “the recently concluded Agreement on Trade-Related Aspects of Intellectual Property Rights,



including Trade in Counterfeit Goods (“TRIPS”).... Thus, enactment of this bill will be consistent with the terms of the agreement, as well as the Paris Convention, of which the U.S. also is a member.”<sup>11</sup>

These implementing statutes make it even more dubious that Congress intended to rebut the presumption against extraterritorial application of the Lanham Act. *See, e.g., Kiobel v. Royal Dutch Petroleum Co.*, 569 U.S. 108, 115 (2013) (“the presumption against extraterritorial application” of United States law “provides that ‘[w]hen a statute gives no clear indication of an extraterritorial application, it has none.’” (quoting *Morrison v. Nat’l Austl. Bank Ltd.*, 561 U.S. 247, 255 (2010))). This is not a case where there is “no clear indication of an extraterritorial application.” *Id.* Rather, there is a clear indication of the *opposite* intent. In implementing the Paris Convention and then TRIPs, Congress said plainly “that United States law governs domestically but does not rule the world.” *See Microsoft Corp. v. AT&T Corp.*, 550 U.S. 437, 454 (2007).

To hold otherwise would risk disrupting the territorial, international system to which the United States has subscribed via the Paris Convention and

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<sup>11</sup> The Second Circuit in *Vanity Fair Mills* noted, “Plaintiff would appear to be correct in arguing that no special legislation in the United States was necessary to make the International Convention effective here.” 234 F.2d at 640. This point, however, is academic because even if the Second Circuit were wrong, Congress has clearly transposed the Paris Convention into United States law.

TRIPs, both as a treaty party and by implementing those treaties through the Lanham Act. *See, e.g., EEOC v. Arabian American Oil Co.*, 499 U.S. 244, 248 (1991) (presumption against extraterritoriality “serves to protect against unintended clashes between our laws and those of other nations which could result in international discord.”).

The European Union has upheld its commitments under of these treaties. The European Court of Justice has forcefully confirmed the Union’s international obligations in the area of intellectual property rights, especially in the treatment of foreign nationals who benefit fully from national treatment for acts of use that take place in the Union in relation to their rights. Case C-265/19, *Recorded Artists, Performers, Actors and others v. Ireland*, ECLI:EU:C:2020:677; *see also* non-binding Opinion of the Advocate General in Case C-617/15, *Hummel Holding A/S v. Nike Inc. and Nike Retail BV* (Advocate General explains that the concept underlying intellectual property law is traditionally the rule of the country of protection or *lex loci protectionis*).<sup>12</sup>

The United States should do the same. There is no need to countenance such disruption to the international system, where that very system provides adequate tools for United States rights holders to

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<sup>12</sup> An Advocate General is a magistrate who assists the Court of Justice of the European Union (CJEU) by preparing an independent and impartial opinion on cases assigned to the CJEU. *See* website of the European Court of Justice, *Composition* section, available at [bit.ly/3BTkeV8](https://bit.ly/3BTkeV8).

protect their rights and interests, and where applying United States law extraterritorially could violate United States treaty obligations. It would also create the risk of inconsistent judgments addressing the same conduct, and create incentives for potentially damaging forum shopping. In the interest of international comity and compliance with international law, these ills should be avoided. The United States should respect the substantive and procedural limits imposed by international law on the authority of any individual state to apply its laws beyond its own territory, and decline to apply the Lanham Act extraterritorially.

### CONCLUSION

In recognition of the United States' obligations under the Paris Convention and TRIPs, the Court should decline to hold that the Lanham Act applies extraterritorially.

Respectfully submitted.

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