



ENVIRONMENTAL AND INTELLECTUAL PROPERTY RIGHTS

University of Ferrara
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LECTURER

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IP LAW COURSE SECTIONS



Mr. Alessandro Bura

IP law general principles
different types of iprs
landmark cases

**Mr. Alberto De
Fransceschi**

focus on patents
how to draft and
understand a patent's
scope of protection

**THE IP LAW
COURSE
AIMS – 24
HRS.**



background on
different **types** of IPRs
how to **manage** IPRs
how to **exploit** IPRs
how to **choose** the
correct protection
amongst IPRs
how to correctly
enforce IPRs'
protection

THE COURSE SCHEDULE

ON LINE SESSIONS



1. general principles IPRS
2. copyright
3. trademarks
4. design and US trade dress
5. general principles patents
6. focus on patents
7. exploitation agreements
8. know how and unfair competition

WHY INTELLECTUAL PROPERTY RIGHTS



WHY FOCUSING ON IPRS

one of the key factors affecting a company's success or failure is the degree to which it effectively exploits intellectual capital and values risk

WHY ARE WE HERE TODAY

provide you with the ability to boost company's assets



Christian
Suburban





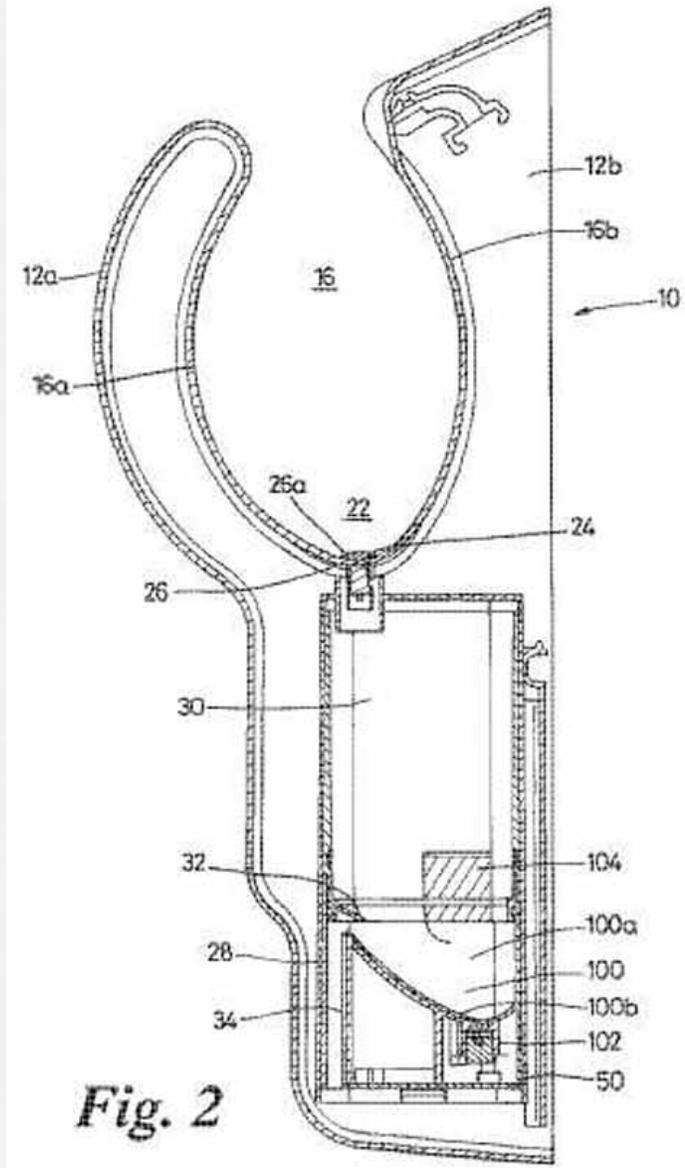


Fig. 2

**ONLY TWO PEOPLE
IN THE WORLD
KNOW THE SECRET RECIPE OF**

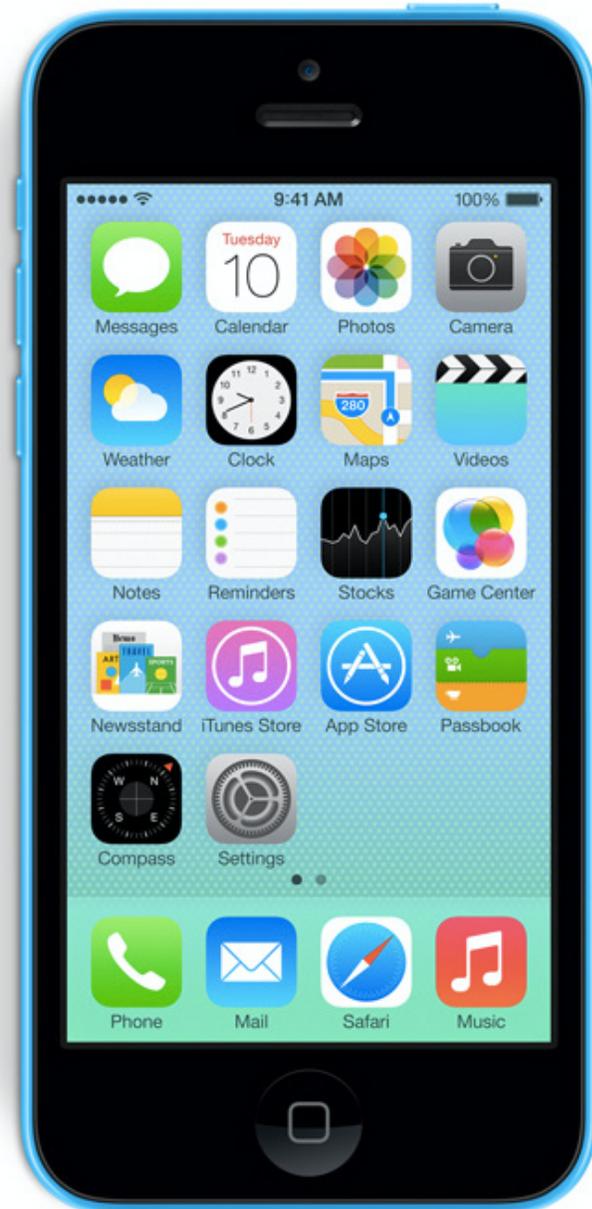
Coca-Cola

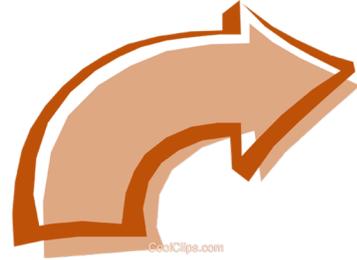




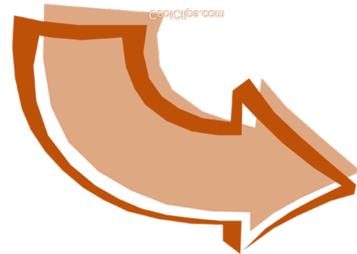
COMBINED PROTECTION

Trademark
Patent
Design
Copyright





INDUSTRIAL AND INTELLECTUAL PROPERTY RIGHTS



Industrial property rights (hard IP rights):

trademarks

patents

designs

Industrial property rights (soft IP rights):

copyright

personality rights (use of name,
image, likeness, or other
unequivocal aspects of one's
identity)

LEGAL PROTECTION OF INTANGIBLES - SECTIONS

- intellectual property rights at an **international level**
- protection of intangibles **not entitled** to protection under intellectual property law
- **exploitation agreements** on IP rights



IP RIGHTS ARE EQUALLY RULED

IP vocabulary/concept is **internationally understood**: i.e. what is a trademark in India is the same in Ukraine and in the US

IP is **international** (even if the rights can be national) because of international treaties, EC regulation, international convention, TRIPS agreement

IP right has a value as a **monopoly right** as long as it is a right

Any and each IP right is **challengeable** and can be declared invalid, cancelled, because of another party, a TM and Patent office, a judge

COMMON PRINCIPLES

exclusivity

exhaustion

registration
(when
applicable)

priority claims

co-ownership

employees and
contractors

WHAT EXCLUSIVITY IS?

exclusivity for a certain period of **time**

the right to **prevent others** from using
the subject of protection

the right to **exclusively exploit** the
IPRs (through license agreements;
assignments; securities)



EXHAUSTION = EXCEPTION TO EXCLUSIVITY

the **trademark** shall not entitle the proprietor to prohibit its use in relation to goods which have been put on the market in the Community under the trademark by the proprietor or with his consent

this principle does not apply where “*there exist legitimate reasons for the proprietor to oppose further commercialization of the goods, especially where the condition of the goods is changed or impaired after they have been put on the market*”



amazon



ebay

EXHAUSTION SECOND HAND SALE ON-LINE SHOPS

ACQUISITION OF IP RIGHTS

being the
inventor/creator
of the IPR

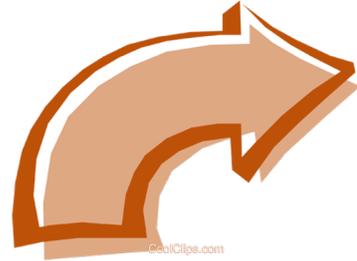
registration/
protection of the
IPR

being part of
a team of
inventors/creators

co-ownership
registration/
protection

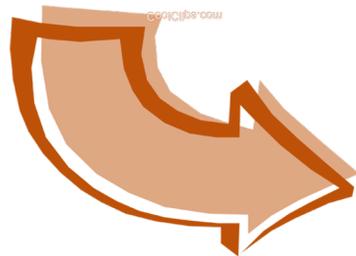
work made
for hire

employer/
principal owns
the IPR



hard IP rights' protection is limited to countries where it is filed or registered

TERRITORIALITY PROTECTION (OR NOT) OF IP RIGHTS



soft IP rights' protection is not territorially limited (since it is not requested to be registered). However it should be enforce in one territory according to its rules (copyright case)

PATENTS (OVERVIEW)

Definition

- exclusive right granted to an **inventor** by a State, or by a regional office acting for several States
- allowing the inventor to exclude anyone else from commercially exploiting its invention for a limited period, generally **20 years**



Conditions of patentability of an invention

- patentable subject matter
- industrial applicability
- novelty
- inventive step

U.S. patent # 5,375,430

'gravity-powered shoe air-conditioner'

This device does not introduce any new concepts, but instead combines two existing concepts in an original way. The shoes, patented in 1994 by Israel Siegel, are powered by the walking motion of the user. Each time you take a step, your heel works to activate the air-conditioner compressor and expander

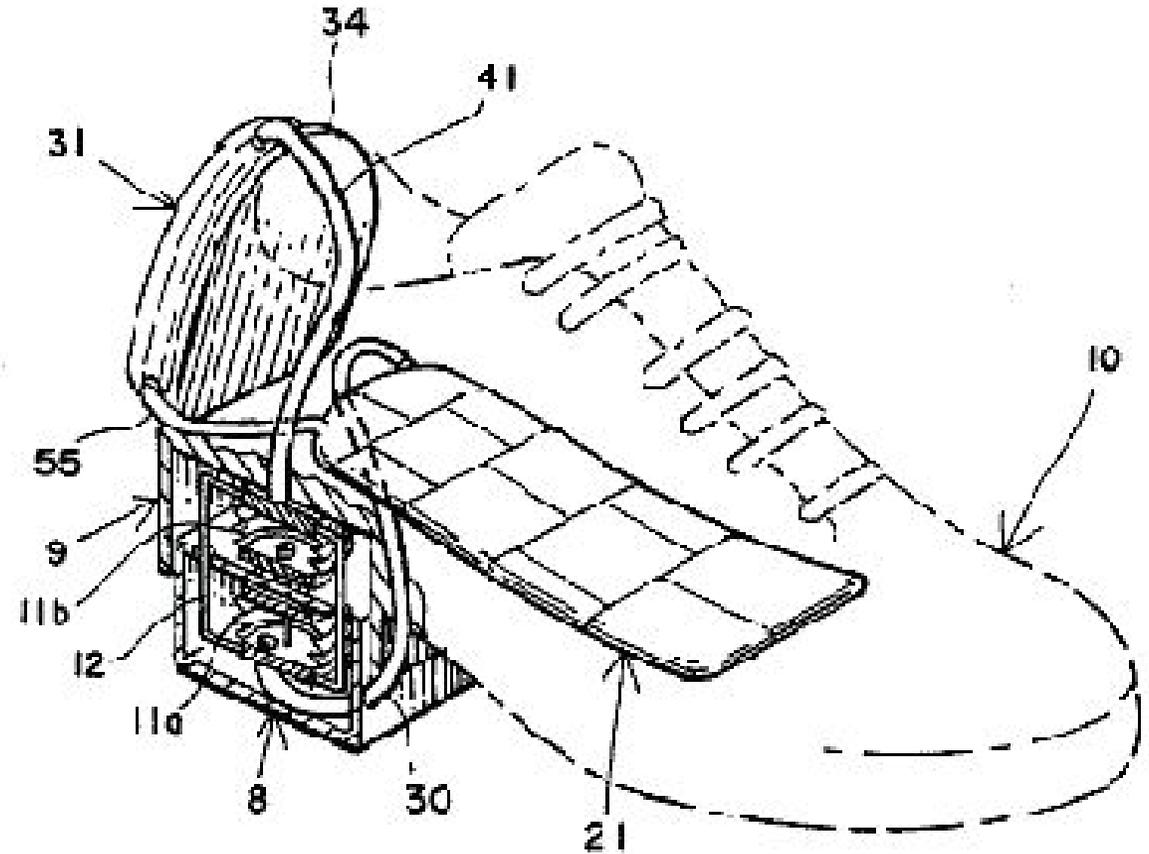
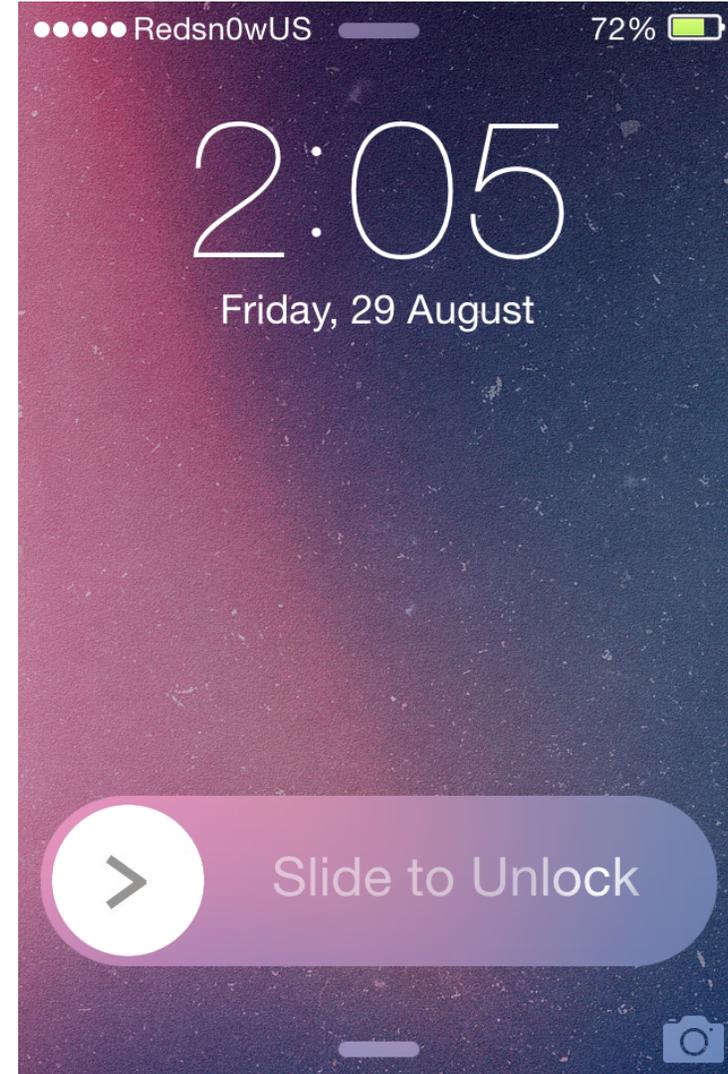


FIG.2

Apple vs. Samsung patents' dispute – USA

the five Apple patents involved at trial and on appeal cover various aspects of the operation of smartphones (from “slide to unlock feature”, till “autocorrect” software from typing errors)



POSSIBLE OUTCOMES OF PATENT LITIGATION



SAMSUNG VS. HUAWEI

High-profile IP litigation is that, sometimes, the most valuable aspect is the **branding benefit**, rather than injunctive or monetary relief

Samsung Electronics Company has sued smartphone rival, Huawei Technologies, for patent infringement in several courts in China. According to a report by Reuters, the action filed in the court in Beijing sought 161 million yuan (approximately \$24.14 million) plus injunctive relief against Huawei regarding the production and sale of alleged infringing products. Huawei had filed suit against Samsung in the U.S. in May, alleging patent infringement with respect to 4G cellular communications technology

The end game is some type of **settlement**, providing for cross-licenses

TRADEMARKS (OVERVIEW)

Definition

registered/used sign, or combination of signs, which distinguishes the goods or services of one enterprise from those of another and guarantees their commercial origin

Exclusive right to use the mark

- right to prevent unauthorized third parties from using the mark, or a confusingly similar mark, so as to prevent consumers and the public in general from being misled
- right to negotiate payment in return for others using the trademark

Period of protection

varies but can be unlimited since the trademark may be renewed indefinitely on payment of corresponding fees

EXAMPLES OF NOTORIOUS TM



TOBBIA VS. PEPPA PIG



are these signs, registered as trade marks for the same goods (clothing, footwear, headgear) in Class 25 of the Nice Classification confusingly similar, so that the one on the right hand side cannot be a valid EU trade mark (EUTM)?

EUIPO First Board of Appeal (R1776/2016-1) overruled the decision of the Cancellation Division, the Board by declaring **invalidity** of EUTM 11775509 '**TOBBIA**' for all its goods.

the figurative elements of the signs are **extremely similar** and, due to their position and size in both signs, consumers will not overlook them



KIT KAT CASE



shape trademark
filed before the
UK Trademark
Office with
reference to
products such as
chocolate



the ECJ ruled that in order to register a trademark consisting in the shape of the product, the applicant has to prove that a **considerable part of the relevant public** "*recognized and associated*" the shape with the applicant

COPYRIGHT (OVERVIEW)

Definition

right given to creators for their literary and artistic works (including computer software)

literary and artistic work: every original work of authorship, irrespective of its literary or artistic merit

”The expression literary and artistic works shall include every production in the literary, scientific and artistic domain, whatever may be the mode or form of its expression”

(Berne Convention for the Protection of Literary and Artistic Works)

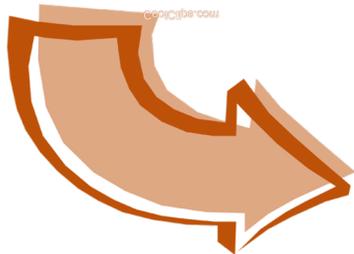
Rights granted under copyright



Economic rights

allow the rights owner to derive financial reward from the use of his work by others, by license or assignment)

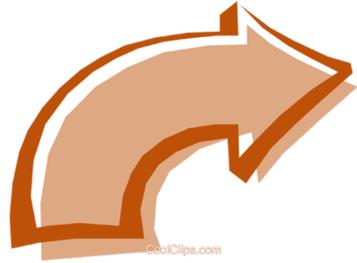
The rights owner may prohibit or authorize against money the reproduction, distribution, rental of copies, the translation into languages and the adaptation of the work (such as a novel into a screenplay)



Moral rights

preserve the personal link between the author and the work

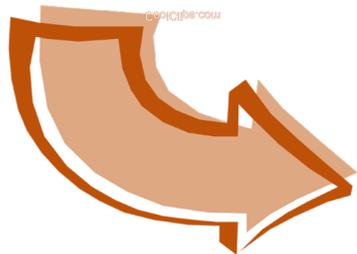
Duration of copyright



Economic rights

Berne Convention : life of the author plus not less than 50 years after his death

European Union, USA: 70 years after the death of the author



Moral rights
perpetual

COMPUTER PROGRAMS

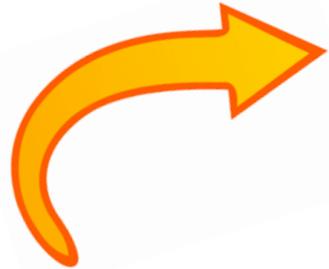
DEFINITION

Set of instructions, which controls the operations of a computer in order to enable it to perform a specific task, such as the storage and retrieval of information

APPLICABLE EU PROVISION

Article 10.1 of TRIPS Agreement: computer programs, whether in source or object code, shall be protected as literary works

MARADONA VS. DOLCE E GABBANA



Pibe de Oro (as Maradona was nicknamed) claimed that fashion designers Domenico Dolce and Stefano Gabbana have unduly exploited his name for commercial reasons



MARADONA CLAIMS

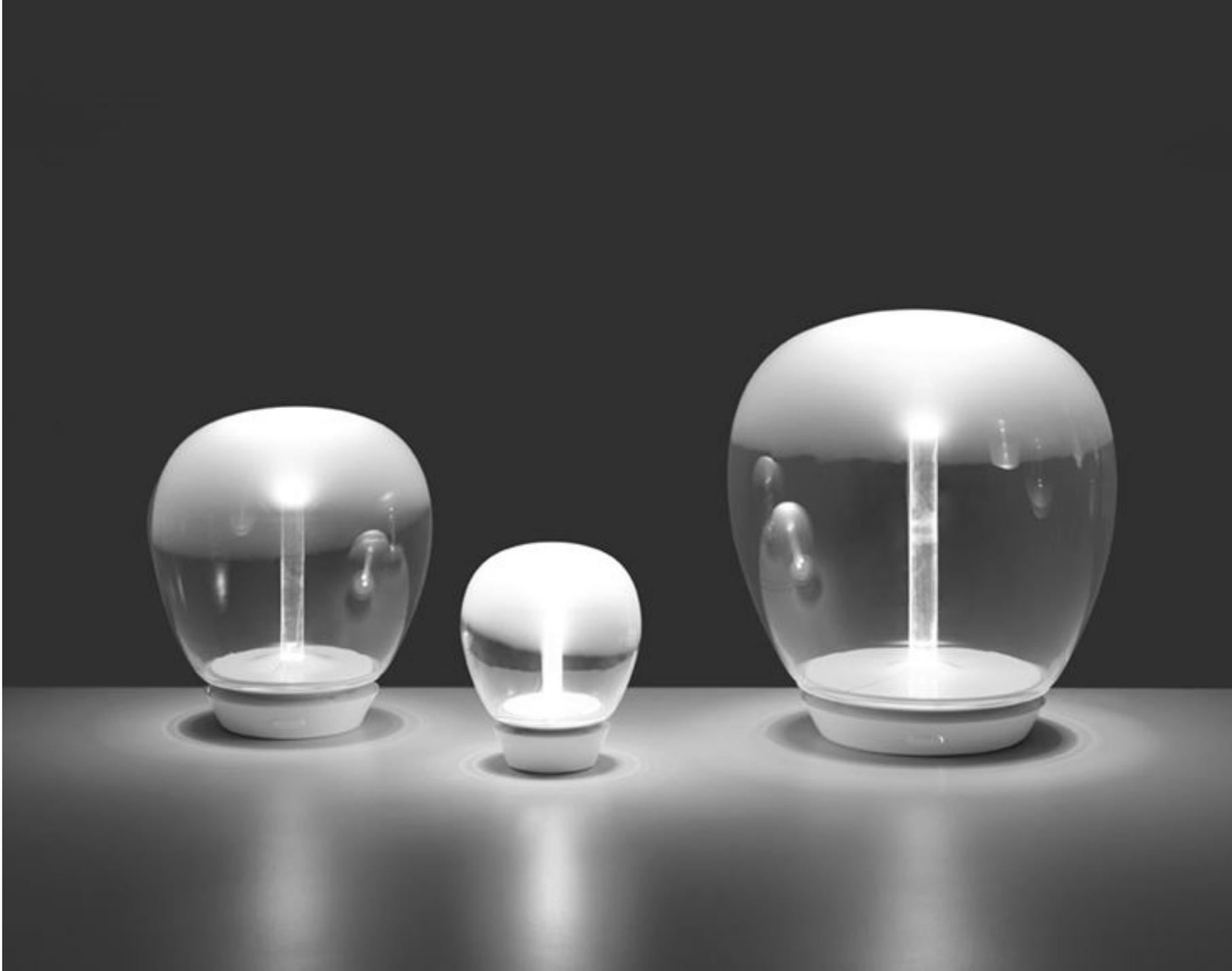
- **FACTS**

- During a fashion show held in the city centre of Naples in 2016, a model wore a jersey bearing the number 10 and the word 'MARADONA'. The jersey itself also had the same colour's combination of Napoli's jerseys, i.e. light blue and white
- Maradona claimed the misappropriation and misuse of his name

APPLICABLE PROVISIONS IN MARADONA CASE

Article 6 and 7 of the Italian Civil Code expressly recognize the **right to one's own name**. In particular, Article 7 states that a person who may suffer a prejudice from the undue use of their name by a third party can request a court order that would put an end to such use, as well as the compensation of any damages.







INDUSTRIAL DESIGNS

DEFINITION

2D or 3 D product : original, ornamental and non-functional features or shape of an industrial product that result from design activity;

REQUIREMENTS OF PROTECTION

novelty and/or originality of the design

TERMS OF PROTECTION

against unauthorized exploitation

DURATION

Usually maximum: 10 to 25 years

PROTECTION OF « OTHERS » INTANGIBLES WHICH ARE NOT LISTED FORMERLY AS TRADITIONAL IP RIGHTS

Any industrial or commercial achievements may not be protected under IP law

BUT

can nevertheless be protected against competitors on the basis that they represent valuable competitive advantages

TRADE SECRET PROTECTION

ADVANTAGES

Trade secret protection protects ideas, not merely the expression of ideas as with copyrights, as long as those ideas are not readily observable or obtainable through reverse engineering. The subject matter protected as a trade secret does not have to rise to the level of a patentable invention. As long as a trade secret remains a secret and provides a competitive advantage, there is no time limit as to the length of protection, unlike patents and copyrights.





DISADVANTAGES

A trade secret remains a trade secret only as long as it is secret. Therefore, trade secrets cannot protect those things which are readily observable or can be reverse engineered. Unlike patent protection, trade secret does not prohibit independent creation by another party



LGV

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