



# ENVIRONMENTAL AND INTELLECTUAL PROPERTY RIGHTS

University of Ferrara  
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Mr. Alessandro Bura

# 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

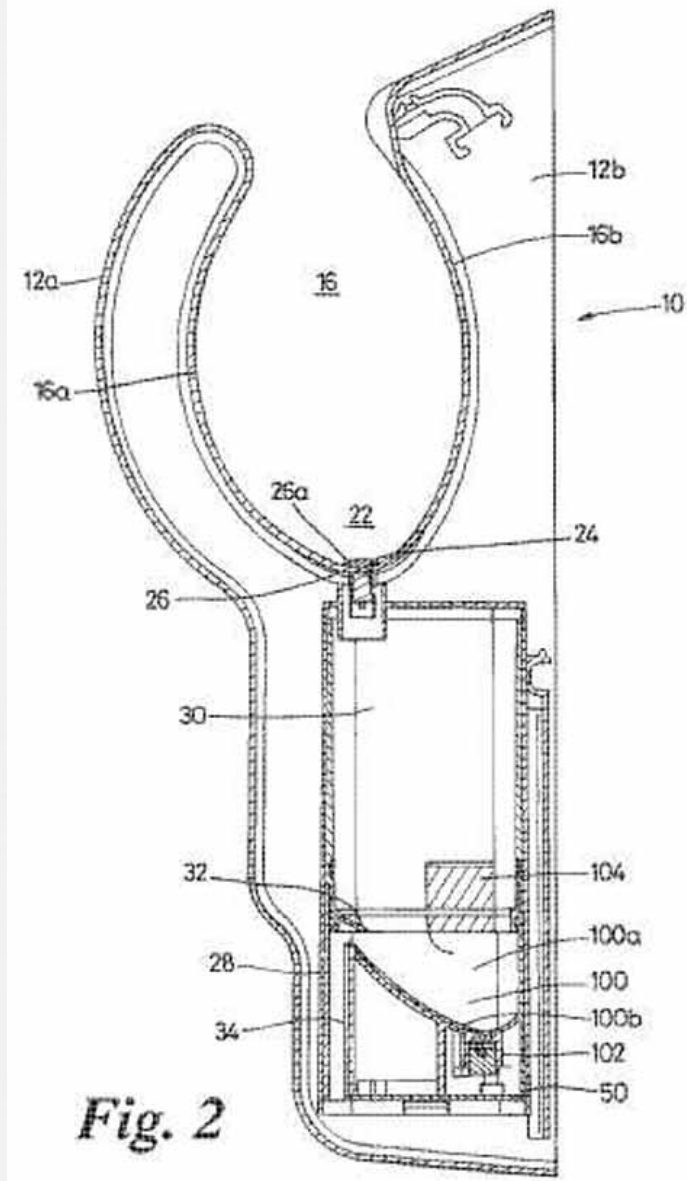
Christian  
Liquor











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

*Coca-Cola*





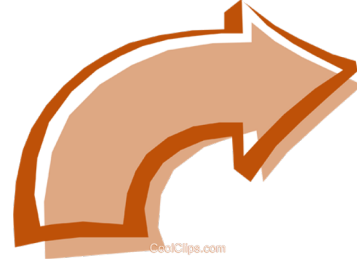


# COMBINED PROTECTION

Trademark  
Patent  
Design  
Copyright



# INDUSTRIAL AND INTELLECTUAL PROPERTY RIGHTS

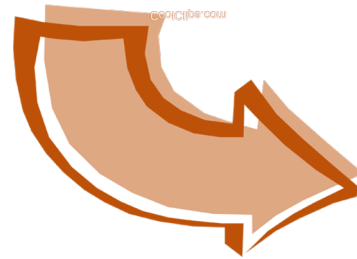


## Industrial property rights (hard IP rights):

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

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# ACQUISITION OF IP RIGHTS

being the  
inventor/creator  
of the IPR

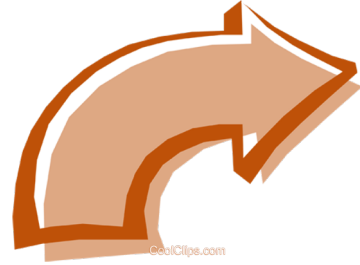
registration/  
protection of the  
IPR

being part of  
a team of  
inventors/creators

co-ownership  
registration/  
protection

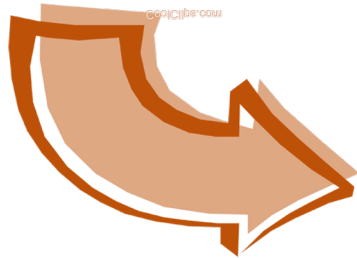
work made  
for hire

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

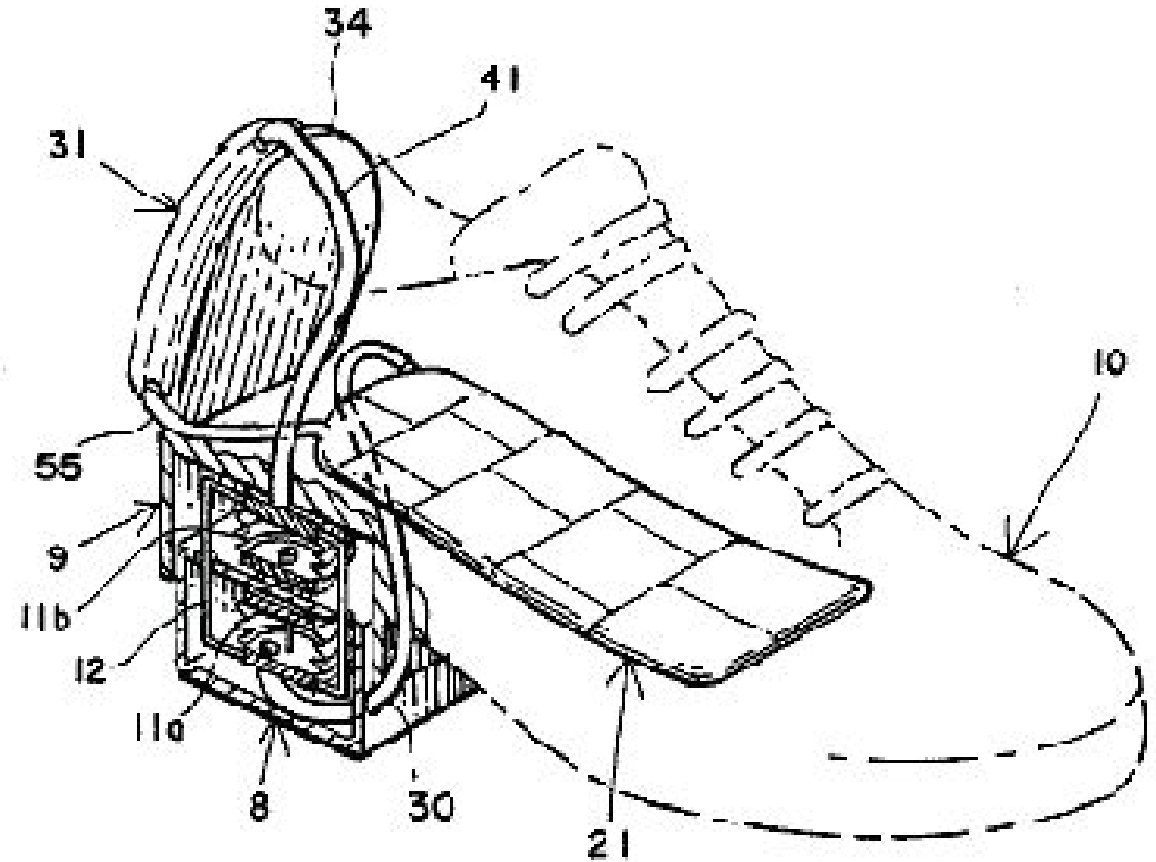
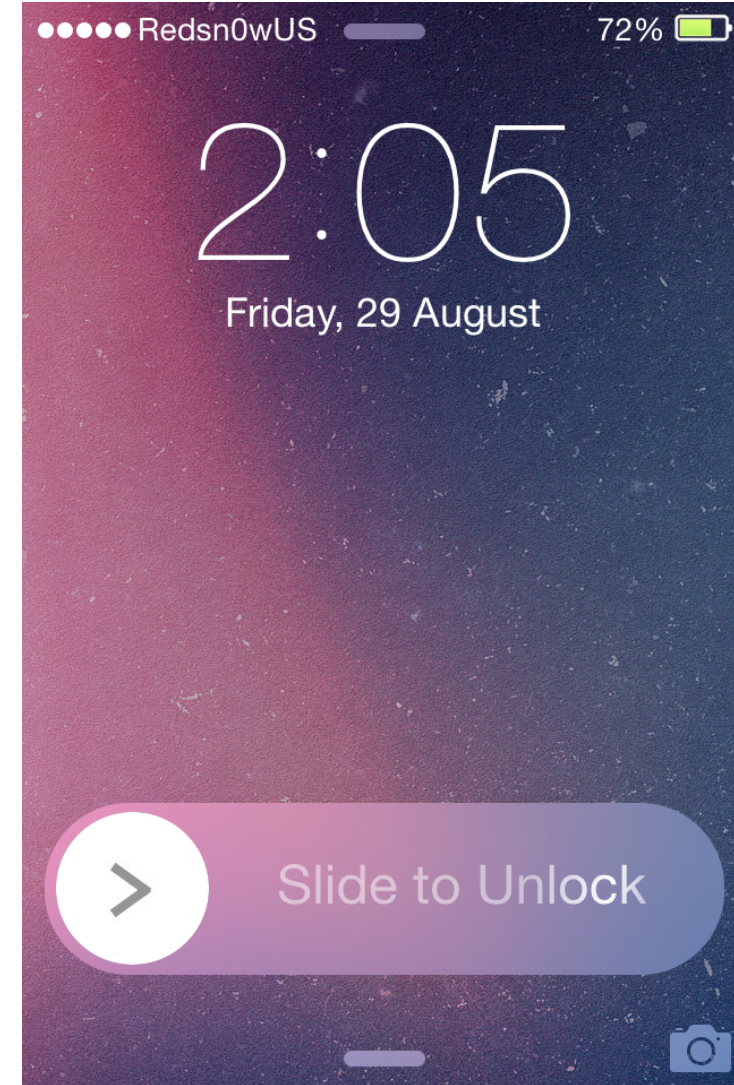


FIG. 2

# 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

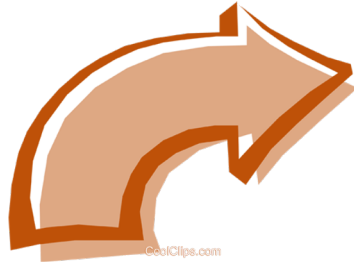
right given to creators for their literary and artistic works (including computer software)

**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)

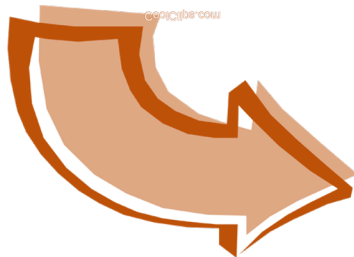
# Rights granted under copyright



## **Economic rights**

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

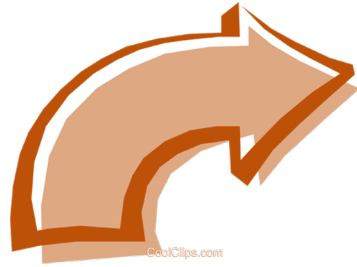
The rights owner may prohibit or authorize against money the reproduction, distribution, rental of copies, the translation into languages and the adaptation of the work (such as a novel into a screenplay)



## **Moral rights**

preserve the personal link between the author and the work

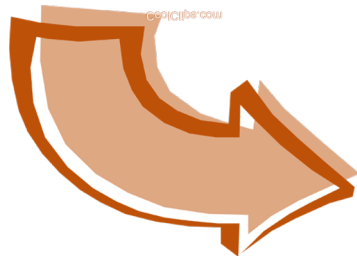
# Duration of copyright



## 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

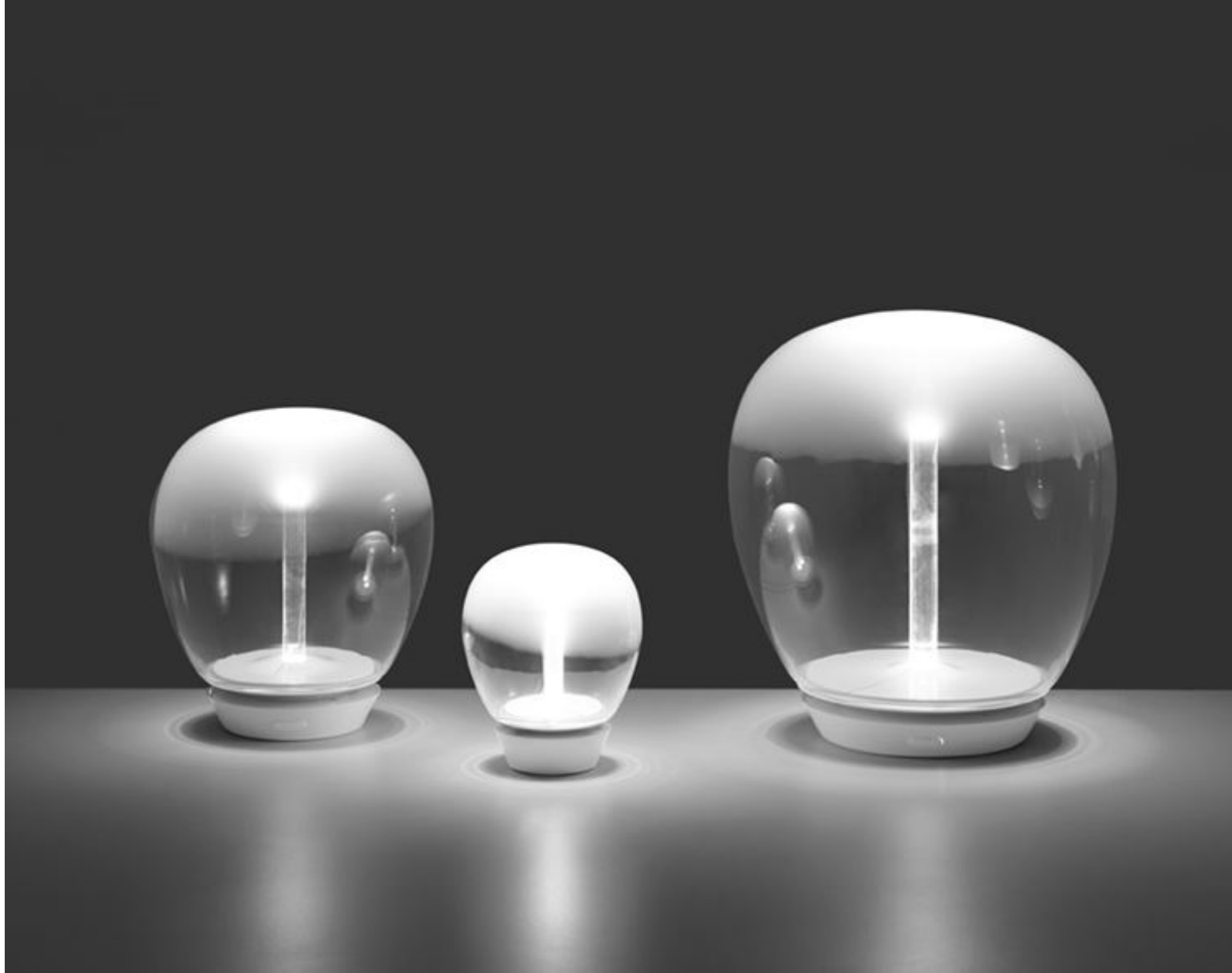
- **FACTS**

- 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





## CONTACT DETAILS

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