



# ENVIRONMENTAL AND INTELLECTUAL PROPERTY RIGHTS

University of Ferrara  
ACADEMIC YEAR 2019/2020

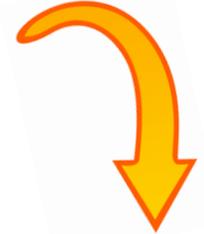
Mr. Alessandro Bura

# IS THIS A TRADEMARK?



# IS THIS A TRADEMARK?

**EL OLOR A LIMON** no.  
001254861 filed on 1999



the mark consists of the smell of  
lemon applied to the goods  
covered by the application  
(clothing)

**No!**



# EUIPO REFUSAL

Pikolino's Intercontinental S.A. sought to register 'THE SCENT OF A LEMON' as a Community **olfactory** mark for 'soles for shoes; footwear' in class 25

the olfactory sign applied for was not eligible for registration as a trade mark as it came under the absolute grounds for refusal

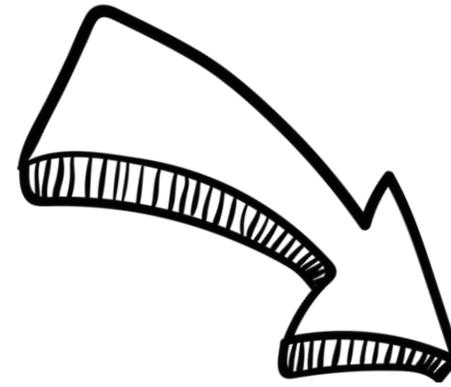


**not capable of being represented graphically**

suffice to perform a simple mental experiment consisting in, on seeing the sign, trying to perceive the scent of a lemon: it cannot be done, all you do is imagine or reproduce mentally the scent of a lemon (which you have experienced at some stage) but you **do not perceive the scent per se.**



# IS THIS A TRADEMARK?



**YEAH!**

# IS THIS A TRADEMARK?

The mark consists of the **smell of vanilla** in connection with soap, jewelry clothing, patches for application to the skin, etc.

Perfume that smells like...



**THE SMELL OF VANILLA** no.  
001807353 filed on 2000



**No!**

# EUIPO REFUSAL



Aromacology Patch Co. Ltd. sought to register **THE SMELL OF VANILLA**’ as a Community olfactory mark for different products (soap, patches, clothing, jewelry, etc.)



protecting “THE SMELL OF VANILLA” on vanilla patches as a trade mark **is not possible** since a smell is a characteristic applied to a product (such as a patent applied to a product to obtain a technical result) and it does not fulfill the function of guarantee of the origin of the marked product

# ECJ RULING IN RALF SIECKMANN LEADING CASE

*Case C-273/00 Ralf Sieckmann v Deutsches Patent- und Markenamt ('Methylcinnamat')*

a trade mark may consist of a sign which is not in itself capable of being perceived visually, provided that it can be represented graphically, particularly by means of images, lines or characters, and that the **representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective**

in respect of an olfactory sign, the requirements of graphic representability are not satisfied by a chemical formula, by a description in written words, by the deposit of an odour sample or by a combination of those elements.



# EU TRADEMARK REGULATION (2017)

## Article 4 - Signs of which an EU trade mark may consist

an EU trade mark may consist of any signs, in particular words, including personal names, or designs, letters, numerals, colours, the shape of goods or of the packaging of goods, or sounds, provided that such signs are capable of:

- a) distinguishing the goods or services of one undertaking from those of other undertakings; and;
- b) being represented on the Register of European Union trade marks ('the Register'), in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor



# TRADEMARK ACTUAL PROTECTION



## International level

Union Paris  
Convention of  
1883

Madrid Agreement  
(1891) and its  
Protocol (1989)

TRIPS Agreement  
(Marrakech 1994)



## European Level

European  
Directive n.  
2015/2436  
(2015)

EU Regulation  
1001/2017  
(2017)



## National

Civil Code  
(Articles 2569-  
2574)

Industrial  
Property Code  
(Articles 7-31)

# LIST OF PROTECTABLE SIGNS

A non-exhaustive list of examples identified under this rule includes:

- words, including persons' names
- drawings
- letters, numbers
- the form of the product or of the product's packaging
- musical and non-musical sounds

# MAIN DISTINCTION

## Regulated by law ("tipici")

trade marks  
company names,  
on-premises signs and  
domain names

VS.

## Not regulated by law ("atipici")

different source-identifiers  
acknowledged as  
distinctive by Italian courts,  
such as

emblems and slogan

# REGISTERED TRADEMARKS

Article 4 EUTMR and 7 IPC a basic definition of a trade mark as

a trade mark may consist of any signs, in particular words, including personal names, or designs, letters, numerals, colors, the shape of goods or of the packaging of goods, or sounds, **provided that** such signs are capable of:

a) **distinguishing** the goods or services of one company from those of other company; and

(b) **being represented** on the Register of trade marks, in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor



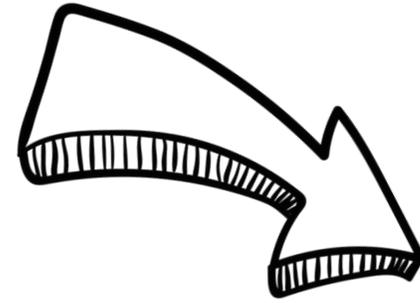
# REGISTRABILITY NECESSARY REQUIREMENTS

Articles 3 and 4 of the Trademark Directive 2008/95, implemented into Italian law provide:

- Article 12 IPC (**novelty**)
- Article 13 IPC (**distinctive character**)
- Article 14 IPC (**lawfulness**)



# AND HOW ABOUT UNREGISTERED SIGNS?



rights in unregistered signs  
arise **on the basis of their  
use in the market** as source-  
identifiers, provided that  
such use results in the  
distinctiveness and  
reputation of those signs

# WORD AND FIGURATIVE MARKS

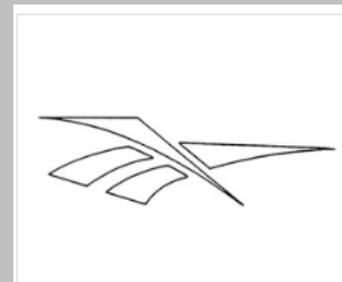
## word marks

Trade marks can consist in one or more words, both existing and made up;

if the word at issue is a person's name, the mark is called patronymic

## *figurative marks*

they can consist of drawings and designs



EUTM 000000456



EUTM 000106948



EUTM 005271598

# SIMPLE / COMBINED MARKS



EUTM 009687336



EUTM 002009298



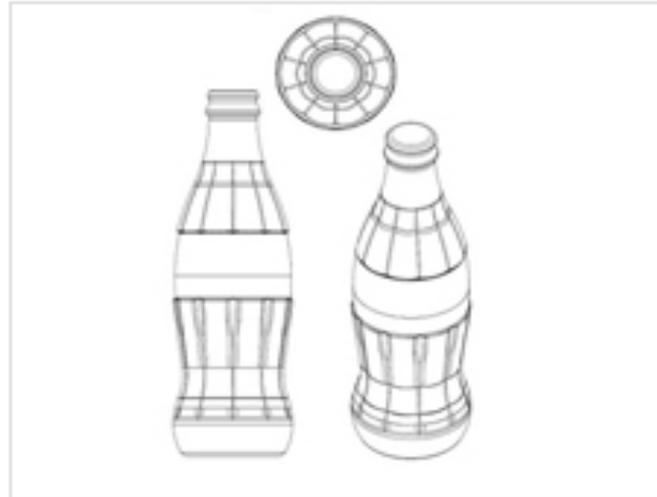
EUTM 011029477

Trademarks can consist, namely, of one element (word or drawing) or a combination of word and figurative elements

# TWO DIMENSIONAL MARKS



EUTM 000146704



EUTM 010532653



EUTM 012492393

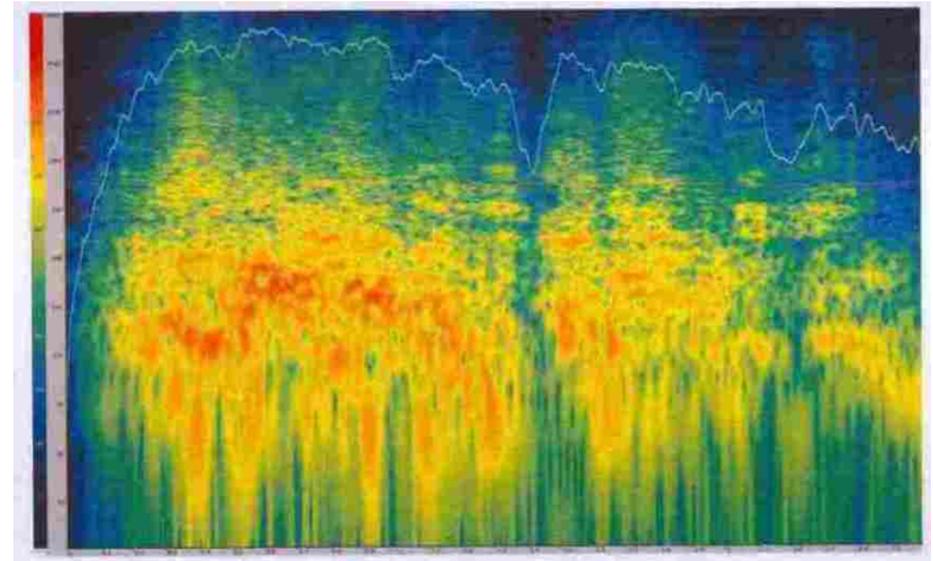
trademarks can consist in the shape or the packaging of the product. However, shapes that are necessary for the nature or function of the product or that are ornamental cannot be registered as trademarks, but may be protected as patents or designs if the related conditions are met

# NON CONVENTIONAL MARKS



METRO GOLDEN MAYER  
EUTM No. 005170113  
(2006)

In case of sound marks – especially if non-musical – they cannot be represented graphically, and hence case law has not deemed them admissible





# AND HOW ABOUT COLORS?

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colors, including basic colors, could be deemed registrable, provided that they have acquired distinctive character



unless a **general interest** arise



# LIBERTEL – ORANGE TRADEMARK



**CJEU 6 May 2003, case C-104/01, Libertel/BMB**

A color *per se* can be a mark, but this usually **requires acquired distinctiveness**.

Regard must be had to the ‘*general interest*’ in not unduly restricting the availability of colors. For registration of a color mark reproduction on paper and/or description of the color is not sufficient, an internationally recognized color code is required (Pantone code)

# HAVE A BREAK

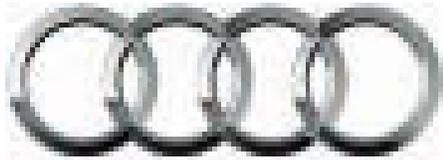
## CJEU 7 JULY 2005, CASE C-353/03

the distinctive character of a mark **may be acquired in consequence of the use of that mark** as part of or in conjunction with a registered trade mark.

it could be as a result both of the use, as part of a registered trade mark, of a component thereof and of the use of a separate mark in conjunction with a registered trade mark. In both cases it is sufficient that, in consequence of such use, the relevant class of persons actually perceive the product or service, designated exclusively by the mark applied for, as originating from a given undertaking.’ (Para. 30)



# CJEU 21 JANUARY 2010, CASE C-398/08



**Audi**

Vorsprung durch Technik

All marks made up of signs or indications that are also used as **advertising slogans**, indications of quality or incitements to purchase the goods or services covered by those marks convey by definition, to a greater or lesser extent, an objective message

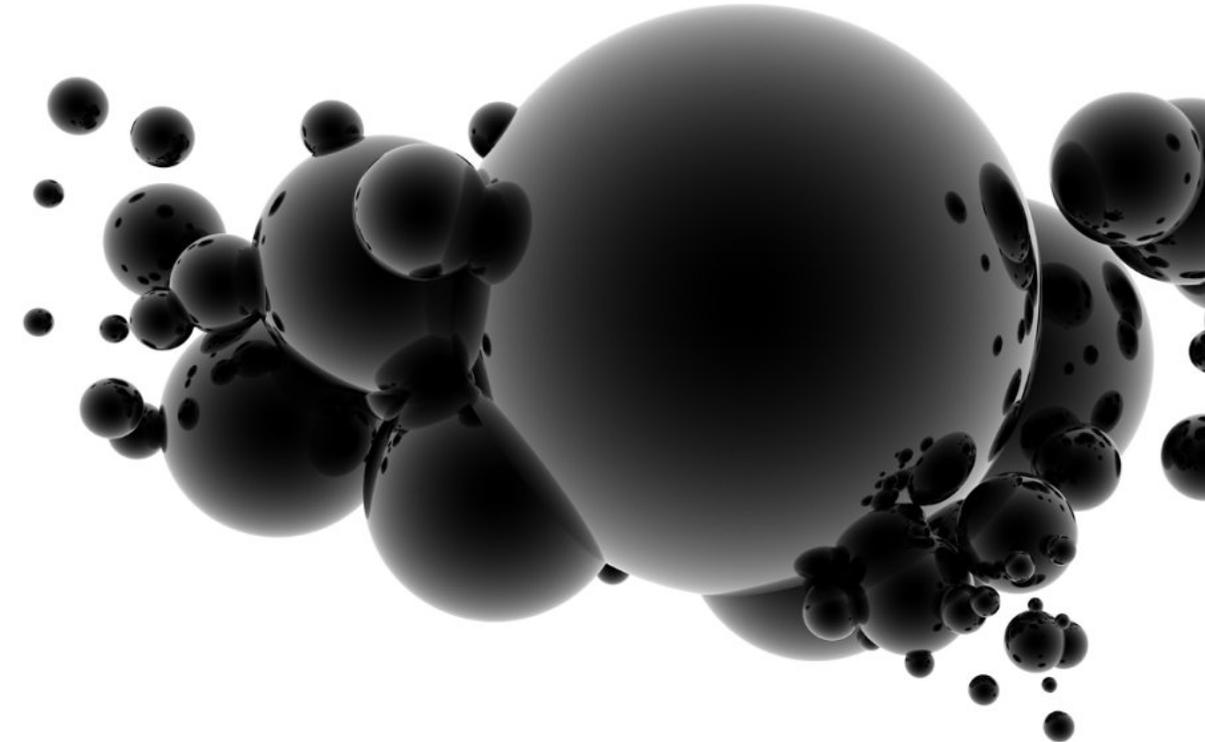
In so far as those marks are not descriptive for the purposes of Article 7(1)(c) of Regulation No 40/94, they can express an objective message, even a simple one, and still be capable of indicating to the consumer the commercial origin of the goods or services in question. That can be the position, in particular, where those marks are not merely an ordinary advertising message, but possess a certain originality or resonance, requiring at least some interpretation by the relevant public, or setting off a cognitive process in the minds of that public. (Para. 56-57)

# DISTINCTIVE CHARACTER

The sign should be distinctive, that is, capable of distinguishing products and services of a specific company

Pursuant to Article 9 of the IPC, a sign cannot be registered as a trade mark if

- a) it is constituted exclusively by the product's form, which is necessary to obtain a technical result,
- b) or which is crucial for the product's value,
- c) or which is imposed by the very nature of the product



# STRONG V. WEAK MARKS

## Strong trademarks

mark that will most easily allow you to prevent third-party use of your mark (fanciful or arbitrary, suggestive)

VS.

## Weak trademarks

describe goods or services for which they are used, making it difficult and costly to try to police and protect (descriptive, or generic)



FRED PERRY



# EXAMPLES

## Strong trademarks

- fanciful: ALLIANZ for “insurance services”
- arbitrary: BANANA for “tires”
- Patronymic: GUCCI for “clothes”

VS.

## Weak trademarks

descriptive:

- PIZZERIA for “pizzas”;
- WORLD’S BEST Pizzeria for “pizzas”

# DYSON

## ABSOLUTE GROUNDS FOR REFUSAL



**CJEU 25 January 2007, case C-321/03, Dyson**

the trademark application which relates, **in a general and abstract manner, to an object with a variety of different appearances** is no more than a characteristic of the product concerned and is not a sign in the meaning of a trademark. Given the exclusivity inherent in trade mark right, the holder of a trademark relating to such a nonspecific subject-matter would obtain an unfair competitive advantage since it would be entitled to prevent its competitors from marketing vacuum cleaners having any kind of transparent collecting bin on their external surface, irrespective of its shape

# PHILIPS ABSOLUTE GROUNDS FOR REFUSAL



CJEU 18 June 2002, case C-299/99, Philips/Remington

a shape is unregistrable as a trade mark if its **essential functional** features are attributable only to a **technical result**. Such a shape can never acquire distinctive character by the use made of it

because...

The rationale of the grounds for refusal of registration laid down in Article 3(1)(e) of the Directive is to prevent trade mark protection from granting its proprietor a monopoly on technical solutions or functional characteristics of a product which a user is likely to seek in the products of competitors

# CORONA ABSOLUTE GROUNDS FOR REFUSAL

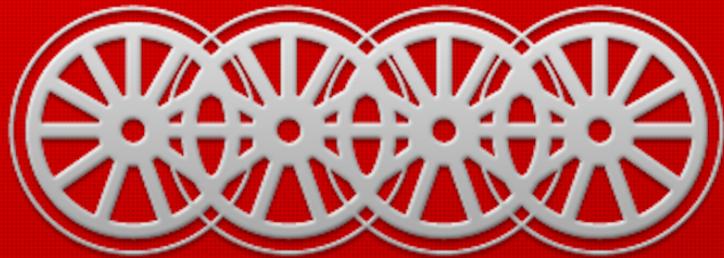


CJEU 30 June 2005, C-286/04 P,  
Eurocermex/OHIM

seen as a whole, the mark applied for **fails to differentiate itself** materially from the ordinary shapes of the containers for the products concerned, which are commonly used in trade and it is not capable of differentiating the products referred to in the application for registration and of distinguishing them from those of a different commercial origin

# SECONDARY MEANING THROUGH USE

QUATTORRUOTE



DIVANI & DIVANI by natuzzi

# LACKS OF DISTINCTIVE CHARACTER

generally speaking, descriptive or generic trademarks are not registrable

## EXEPTION

trademarks might **acquire distinctiveness** on account of the use considering the specific turnover of trademarked goods, efforts in promotion and advertising, degree of intrinsic distinctiveness



# THE USE IN COMMERCE

the Italian system does not require an actual use of the trade mark as of the date of filing of the application. Indeed, similar to the EU trade mark registration process, Italy has a registration-based protection system and **the use of the trade mark in the course of trade is not requested to be a ground for refusal of the application**



in a case where a trade mark has not been an object of genuine use for a period of **five years**, in connection with products and services claimed in the registration, any third party could raise the non-use exception in court proceedings



evidence of the **actual and continued use of the trade mark in the past five years**

# NOVELTY REQUIREMENT

the trademark must be **new**, that is, it must not be anticipated by other **identical or similar trademarks** already valid in the countries where registration is requested

novelty is evaluated with reference to the **classes of products and services** shown in the specific international classification

it is also evaluated according to the **likeness of the products and the services** and the type of customer for which they are intended



# PRIOR RIGHTS TO BE CONSIDERED

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1. prior **identical** registered (or unregistered) trademark filed in connection with **identical** goods or services
2. prior similar registered (or unregistered) trademark filed in connection with **similar** goods or services so as to create a **risk of confusion** with this prior trademark
3. prior identical or similar **well-known** trademark so as to cause a risk of confusion, including a risk of association with, or cause **prejudice** or take **unfair advantage** of the reputation of the well-known prior registered trademark



# REVOCAATION – CASE NO. C 409/12, BACKALDRIN - KORNSPITZ

Backaldrin produces in Austria a baking mix which it supplies primarily to bakers, who turn it **into a bread roll** which is oblong in shape and pointed at both ends, namely **‘KORNSPITZ’**

a trade mark registration may be held invalid if, **in the consumers' eyes, it has become a common name in the trade**, regardless of the perception of those in trade



# OTHER SOURCE-IDENTIFIER SIGNS

## Company names

Article 2563 of the Italian Civil Code provides that the entrepreneur is vested with the **exclusive right to use the company name** used in the course of trade

## Domain names

The exclusive rights of a domain name derive from the registration of the domain name on a first-come, first-served basis



# TERMS OF PROTECTION

the exclusive rights granted last

**TEN YEARS**

starting from the application date, and it can be renewed with respect to the same sign and the same products and services for ten-year periods, for an indefinite number of times



# RIGHTS GRANTED ARTICLE 20 IPC

the proprietor shall be entitled to **prevent all third parties not having his consent** from using in the course of trade



- (a) any sign which is **identical** with the trade mark in relation to goods or services which are identical with those for which the trade mark is registered
- (b) any sign where, because of its identity with, or **similarity** to, the trade mark and the identity or similarity of the goods or services covered by the trade mark and the sign, there exists a **likelihood of confusion** on the part of the public, which includes the likelihood of association between the sign and the trade mark

# WELL-KNOWN TRADEMARKS

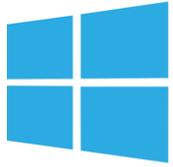


the proprietor shall be entitled to prevent all third parties not having his consent from using in the course of trade any sign which is identical with, or similar to, the trade mark in relation to goods or services which are not similar to those for which the trade mark is registered, **where the latter has a reputation** and where the use of that sign without due cause takes **unfair advantage** of, or is **detrimental** to, the distinctive character or the repute of the trade mark

*Coca-Cola*



Walmart 



amazon.com



FedEx®



# EXHAUSTION OF RIGHTS

exclusive rights of the trademark owner are exhausted when the product bearing the trade mark has been **put on the market by the owner or with their consent in the EU and/or within the EEA** (article 5 IPC )

**BUT**

in the case of “legitimate reasons”, such as modification and/or the alteration of the products’ status after having been put on the market, **trademark rights are not exhausted**



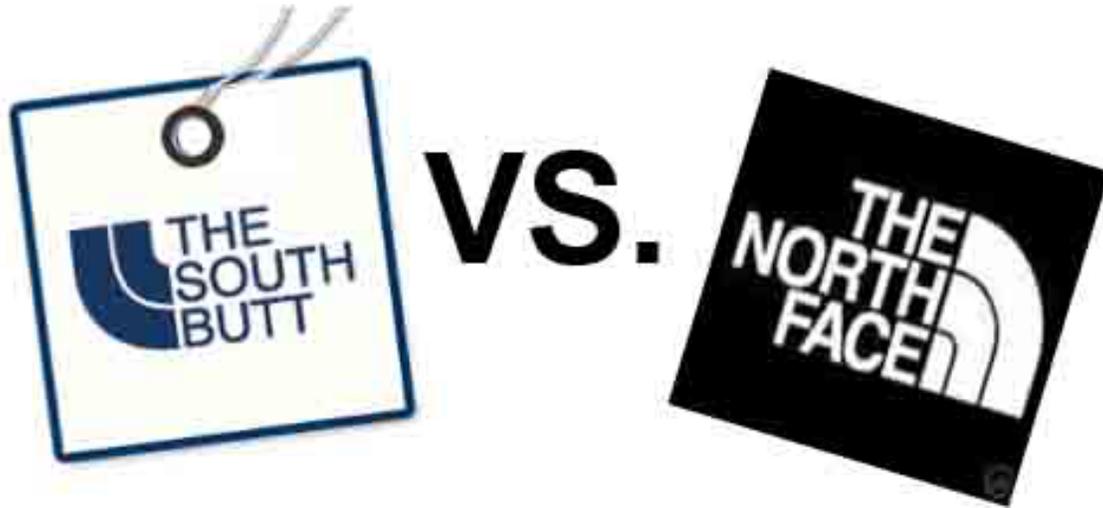
# THE ECJ RULING ON EXHAUSTION

the consent of the trade mark owner is also given by the placing of the goods on the market by the authorized licensee

however, should the licensee place luxury goods in the market in disregard of the license agreement's provisions (e.g. where a selective distribution network is in place), the aura of luxury of such goods could be undermined and **exhaustion did not apply**



# INFRIGEMENT ASSESSMENT CRITERIA



degree of **similarity** between **goods** and **services** concerned

degree of **similarity** of the **signs**, in particular under a phonetic, visual and conceptual profile

**predominant elements** of the compared signs

degree of **acquired distinctiveness** on account of the use considering the specific turnover of trademarked goods, efforts in promotion and advertising, degree of intrinsic distinctiveness

determination of the **relevant consumer** and the degree of awareness

**global assessment** of all factors

# ECJ RULING - LACOSTE INFRINGEMENT

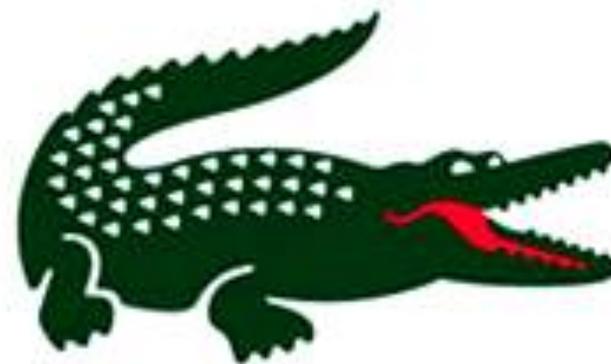
*Case T-364/13 Lacoste SA v Eugenia Mocek, Jadwiga Wenta KAJMAN Firma Handlowo-Uslugowo-Produkcyjna*

the trademark applied for must not be registered if because of **its identity with, or similarity** to, an earlier trade mark and the identity or similarity of the goods or services covered by the trade marks, there exists a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected (para 18)

It is not impossible that the representation of a caiman in the mark applied for may be perceived as a **variant of the representation of a crocodile** in the earlier mark, the latter being **widely known among the relevant public**, as is clear from paragraphs 36 to 43 of the contested decision, a fact which, moreover, is not disputed by the applicant (para 71)



VS.



# ECJ RULING - PUMA INFRINGEMENT

## Case C-251/95, Puma v. Sabel



the criterion of likelihood of confusion which includes the likelihood of association with the earlier mark is to be interpreted as meaning that the **mere association** which the public might make between two trade marks as a result of their analogous semantic content **is not in itself a sufficient ground for concluding that there is a likelihood of confusion** but a global appreciation of the sign must be carried out

# ECJ RULING - ADIDAS/FITNESSWORLD

CJEU 23 October 2003, case C-408/01 Adidas v. Fitnessworld

Adidas is the proprietor of a figurative trade mark registered at the Benelux Trade Mark Office for a number of types of clothing. That mark is formed by a motif consisting of **three very striking vertical stripes** of equal width, running parallel, which appear on the side and down the whole length of the article of clothing

Fitnessworld, a UK company, markets fitness clothing under the name Perfetto. A number of those articles of clothing **bear a motif of two parallel stripes** of equal width which contrast with the main color and are applied to the side seams of the clothing



# ADIDAS CLAIMS

Adidas claimed that that marketing of clothing with two stripes creates a likelihood of confusion on the part of the public, since the public might associate that clothing with Adidas' sports and leisure clothing which bears three stripes, and Fitnessworld thus takes advantage of the repute of the Adidas mark. The exclusivity of that mark could thereby be impaired

**UNFAIR**  
**ADVANTAGE**

# COURT'S FINDINGS

the infringements referred to in Article 5(2) of the Directive, where they occur, are the consequence of a **certain degree of similarity between the mark and the sign**, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, **establishes a link** between them even though it does not confuse them

the existence of such a link must, just like a likelihood of confusion in the context of Article 5(1)(b) of the Directive, be appreciated globally, **taking into account all factors relevant to the circumstances of the case**



# ECJ RULING - ARSENAL CASE

CJEU 12 November 2002, case C-206/01

having regard to the **presentation of the word Arsenal** on the goods at issue in the main proceedings and the other secondary markings on them, the **use of that sign is such as to create the impression that there is a material link** in the course of trade between the goods concerned and the trade mark proprietor (Para. 56)



# INFRINGEMENT AS A CRIMINAL OFFENCE



## articles 473 and 474 of the Italian Criminal Code

the infringement of a registered IP right so as to create the risk of confusion among the public is a criminal offence. The ascertain of the criminal offence could be requested independently from party's request by public prosecutors

## article 517ter of the Criminal Code

applies where the infringement does not involve an actual risk of confusion among the public. In this case, the rights holder must file a criminal complaint

# COMPENSATION FOR DAMAGES

**criteria** set for its quantification are:

- lost profits (lucrum cessans);
- actual damages, meaning the expenses borne as a consequence of the infringement (damnum emergens).

Italian law does not recognize punitive damages

- moral damages (for example, damages if the behavior is a crime) may be available.

in order to quantify the damages the court considers both the profit of the infringer, usually as a minimum value, and the lost profit of the right holder

in any case, the damages will amount as a **minimum to the value of a hypothetical licence**





# OTHER REMEDIES FOR THE RIGHT HOLDER

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removal of the goods from commerce

destruction of the infringing signs

injunction addressed to the infringer

publication in a newspaper of the judgment ascertaining the infringement

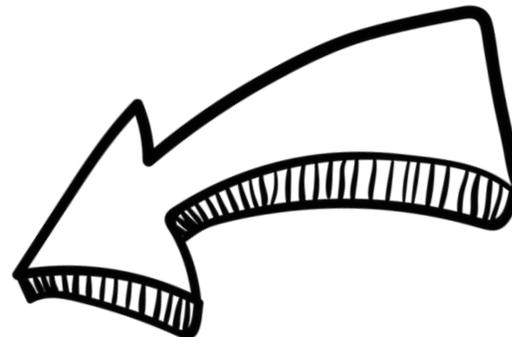
# ASSIGNEMENT

assignments should be done **in writing** (albeit no particular formalities are requested)



a substantive requirement is imposed by the combined effect of Article 2573 of the Civil Code and Article 23 of the IPC: the assignment must **not lead to confusion with respect to characteristics of products or services** considered essential by consumers, i.e. those that may influence the purchasing decision

in order to avoid any likelihood of confusion the assignee may inform the public of any changes in the products or services



# LICENSING



no particular form requested (as discussed about assignments)

***exclusive or non-exclusive*** and/or provide for different rights of the parties.

must not result in deception with regard to characteristics of the products and/or services that are widely considered to be essential;

non-exclusive licensee must expressly agree to use the licensed trade mark only for products or services that are the same as those marketed by the licensor or by other non-exclusive licensees in the relevant territory (Article 23 IPC)

# TRADEMARKS AND INFLUENCERS

Influencers in social media are people who have built a reputation for their knowledge and expertise on a specific topic

they make regular posts about that topic on their preferred social media channels and generate large followings of enthusiastic, engaged people who pay close attention to their views

trademark owners exploit influencers in light of creating purchasing's trends through social media marketing (providing influencers of products bearing a trademark to be shown during posts or stories in social media)



# SOCIAL NETWORK ADVERTISING

influencers generally publish advertising and banners within social networks (e.g. Instagram, Facebook, Twitter, Youtube, Snapchat, etc.)

followers might be exposed to a form of accreditation of a brand or a product, which takes place by celebrities or by influencers, bloggers or vloggers

brand endorsement



# WHEN SOCIAL #ADV IS LICIT



 chiara ferragni  • Segui già  
L'Albereta Relais & Châteaux

 chiara ferragni  Sunday January 26th  
❤️ #supplied

11 sett.



 paolteodori10 Maglietta super!  
Bellissima! 👍 Ma forse solo  
addosso a te... 🤔 🤔

10 sett. Rispondi

 muhammadayyan98 Very nice

10 sett. Rispondi

 angelo\_damiani9 lo mi vesto dal  
cinese e tu puhblichì sta foto che



 Piace a trt.nna e altri 291.518

26 GENNAIO

Aggiungi un commento...

Pubblica

# WHEN SOCIAL #ADV IS LICIT (or NOT)



 fedez • Segui

 fedez lo sono sporco all'esterno ma giudicare le apparenze è l'atteggiamento tipico di chi è sporco dentro

37 sett.



 rosa.leccese.3 Grande..tutta la famiglia di Fedez

33 sett. Mi piace: 1 Rispondi

 rosa.leccese.3

33 sett. Rispondi

 cate\_ghezzi @rxezarte non dici che dovrebbe tagliare le unghie dei piedi

 Piace a trt.nna e altri 512.971

28 LUGLIO 2019

Aggiungi un commento... [Pubblica](#)

# WHEN SOCIAL #ADV IS LICIT



giuliavalentina • Segui

Milan, Italy



giuliavalentina "Un bel libro, Marcus, non si valuta solo per le sue ultime parole, bensì sull'effetto cumulativo di tutte le parole che le hanno precedute. All'incirca mezzo secondo dopo aver finito il tuo libro, dopo averne letto l'ultima parola, il lettore deve sentirsi pervaso da un'emozione potente; per un istante, deve pensare soltanto a tutte le cose che ha appena letto, riguardare la copertina e sorridere con una punta di tristezza, perché sente che quei personaggi gli mancheranno. Un bel libro, Marcus, è un libro che dispiace aver finito." La Verità sul Caso Harry Quebert di Joël Dicker. Nelle storie trovate i miei commenti sul libro che ho ascoltato su @storytel.it ! Fatemi sapere le vostre impressioni nei commenti #Storytel #audiobookclub #GVbooks #adv



Piace a michelacoppaofficial e altri 41.142

28 MARZO

Aggiungi un commento...

Pubblica

# PERCEPTION OF CONSUMERS

social network endorsement is licit provided that the rules for the protection of the consumer and competition are respected, both by the brand owners and by the influencers

whatever form of commercial communication is used by the influencer, the consumer/follower **should clearly perceive the commercial intent of the message** advertising and banners within social networks

the Italy's Advertising Self-Regulatory Institute requests that in the first part of the influencer's post are included the following hashtags

#supplied #adv #advertising #[name of the brand]



**Thank you for your attention!**  
**Next discussion will be on Patents**

**Alessandro Bura**