

IP_LAW_GALLI Newsletter

AVV. PROF. CESARE GALLI STUDIO LEGALE MILANO-BRESCIA-PARMA

MILANO – MARCH 2005

SUMMARY

RECENT DEVELOPMENTS IN ITALIAN IP LAW

- ✓ *The Industrial Property Code has been approved: it will come into force in two stages with possible revisions within a year – the principal new points*
- ✓ *Using trade marks which may be linked to smoking products for non-smoking products is ruled unlawful by the Court of Cassation*
- ✓ *The Court of Cassation further clarifies the details of agreements of co-existence between trade marks*

THE CASE

- ✓ *It is lawful to advertise as “patented” a good for which a patent application has not yet resulted in grant of a patent (Court of Varese, 12 October 2004) – The text of the decision*

THE ARTICLE

- ✓ *Trade marks, designs, newspaper titles, domain names: a year of case law (September 2003-September 2004) – An article by Professor Cesare Galli soon to be published in *Annali Italiani del Diritto d'Autore**

ABOUT US

- ✓ *The Commission of Production Activities of the Chamber of Deputies calls Professor Cesare Galli as one of the experts invited to give their opinions on the new IP Code*
 - ✓ *Recent IP decisions obtained by our firm*
 - ✓ *Our latest publications and conventions*
-

RECENT DEVELOPMENTS IN ITALIAN IP LAW

- ✓ ***The Industrial Property Code has been approved: it will come into force in two stages with possible revisions within a year - the principal new points***

On 23 December 2004 the Council of Ministers approved a Legislative Decree, containing the **Industrial Property Rights Code**. The Decree was issued on the basis of the delegation in Art. 15 of Law 12 December 2002, no. 273 (the so-called «Mercati Annexe» to the 2003 Financial Law). It regulates all IP matters save copyright. The Code was published as **Legislative Decree 10 February 2005 no. 30** in the *Gazzetta Ufficiale* (Official Gazette) of **4 March 2005** coming into force two weeks later on **19 March 2005**. However, an express transitory article (Art. 245, not in the previous drafts of the Code) has delayed by **another six months** the application of one of the Code's principal new points, i.e. submitting IP disputes to the **procedural discipline** provided by Legislative Decree 17 January 2003, no. 5, better known as the «**company procedure**». Furthermore, Parliament, by Law 27 December 2004 no. 306 of Conversion of Legislative Decree 9 November 2004, no. 266, has provided (in Art. 2) that «*within a year of the entry into force of the legislative decrees*» issued on the basis of the delegation «*the Government may adopt, subject to the opinion of the competent parliamentary commissions, provisions which correct or add to these legislative decrees*». Thus the Code will be **road-tested** for a year during which time its provisions may still be adjusted.

In fact the Code – albeit also (but not only) a «**single text**» gathering together and coordinating current IP laws in Italy (a good many of which emanate from the EU and are therefore binding) –

contains a certain number of **innovative provisions** which have been fully debated both by scholars and practitioners in the field and representatives of interested bodies and associations. An early legislative decree proposal, fruit of the work of the Commission set up for this task, underwent significant changes in order to take into consideration the numerous critical observations made in its regard (see this Newsletter, October 2004). A subsequent version, approved by the Council of Ministers on 10 September 2004, was then examined, in order to obtain the requisite opinions, by the competent **Parliamentary Commissions**. After hearing the experts and representatives of the financial and business world, the Commissions asked for a series of **Corrections** to be introduced. In particular the Commission for Production Activities of the Chamber of Deputies took on board most of the observations made in the above hearings by Professor Cesare Galli and representatives of INDICAM, *Istituto di Centromarca per la Lotta alla Contraffazione* (Trade Marks Association Institute for the Fight against Counterfeiting), later accepted and supported by Massimo Polledri, a member of the Commission. Many of these corrections have, in fact, been **included in the adopted text**. In particular:

a) the rules on **co-ownership** (Art. 6) have been extended to all IP rights and is not limited to those arising from registration or patenting («titles», according to the terminology of the Code)

b) the definition of **signs which may be registered as trade marks** (Art. 7) has been changed, eliminating all reference to novelty, so as to avoid legislative overlap, and the provision concerning novelty (Art. 12) has been redrafted using more correct syntax

c) in the provision concerning **the distinctive character of trade marks** (Art. 13), the situation whereby a trade mark constitutes a general name or a descriptive indication has been indicated as a **particular case** of lack of distinctive character, thus eliminating ambiguity in the article

d) the article concerning **limitation of trade mark rights** (Art. 21) has been adapted to the interpretation given to the corresponding article of EC Directive no. 89/104 (Art. 6.1) by the ECJ on 7 January 2004, in C-100/02. Thus, the listed uses of another's trade marks **are no longer unlawful due to the sole fact that they are effected as trade marks**, but only when they are not in accordance with principles of honest business practice

e) as regards **employees' inventions** (Art. 64), the **right of option** on inventions realised by employees when off-duty has been expressly given to **all employers**, in that the inventions themselves come within their field of activity, and not only to "companies", thereby stating clearly that the article also applies to non-entrepreneurial employers (as was uncertain: in favour of the accepted interpretation see, in particular, GALLI, *Le invenzioni dei dipendenti nel progetto di Codice della Proprietà Industriale*, in AA.VV., *Il Codice della Proprietà Industriale* edited by UBERTAZZI, Milano, 2004, pp. 43-44; *contra* LIBERTINI, *Appunti sulla nuova disciplina delle invenzioni universitarie*, in *Foro it.*, 2002, I, 2174)

f) again with regard to employees' inventions, a specific article has been added (Art. 64, paragraph 5, first proposal) which regulates **relations between proceedings before the ordinary courts** which aim to establish whether or not an employee-inventor is entitled to fair recompense for the invention and **arbitration proceedings** introduced by the Code in order to **establish the amount of recompense**, stating that «*The arbitration panel may be applied to also when a judgement is pending as to whether a right to fair recompense, royalty or price exists. In this case, however, its decision will only come into effect once it has been ruled that such a right exists*»

g) on the delicate question of **compensation** (Art. 125), it has been established – in line with EC Directive no. 2004/48 – that compensation for loss of anticipated profits is to be assessed by Courts «also taking into account the **profits made in violating the right** and the **sums the violator would have to have paid if he had obtained a licence from the owner of the right**» (the added part is in italics). This article should therefore help the holder of the violated right to discharge his burden of proof, thereby consolidating the current development of the most recent Italian case-law, in granting **greater compensation** than in the past in cases of violation of IP rights.

h) the **competence of the Specialised IP Divisions** (Art. 134) has also been expressly extended to cases which have *«reasons of connection, even improper»* with those explicitly attributed to the Specialised Divisions (IP rights, including copyright, and Antitrust cases concerning IP rights, now all expressly within the remit of the Specialised Divisions and subject to the so-called company procedure)

Following the suggestion of Professor Ricolfi, the article regarding the limitation of patent rights (Art. 68) was reworded, with the aim of harmonising Italian law with Art. 10.6 of EC Directive 2004/27 of the European Parliament and Council. Under the new article, patent owners are not entitled to forbid experimentation aimed at *«obtaining, also in foreign states, authorisation to put a medicine on the market and the consequent practical formalities including preparation and use of strictly necessary pharmacologically active raw materials»*. In practice, the solution which had already been accepted in case law by the Court of Milan, Order 12 giugno 1995, in *Giur. ann. dir. ind.*, 1995, when the old article was in force, has thus been codified.

With the exception of these modifications (and a few others which are mainly formal, the most important of the substantial modifications is perhaps the elimination of the so-called internal priority in patent matters), the text of the Code mirrors that of 10 September 2004, and similarly – as was stated at the beginning – it is essentially a single text gathering together all law in matters of trade marks, design, patents (invention and model), plant varieties, chips and trade secrets on the basis of a system which is substantially that of the TRIPs Agreement (it being understood that copyright is excluded).

However codification has offered the legislator the chance to **clarify some much debated questions** in legal theory and case law. These include:

a) the **scope of trade mark protection**, with regard to which articles 20 and 21 provide that the owner is entitled to forbid, if the premises corresponding to those under Art. 5.1-2 of EC Directive 89/104 held, the use *«in economic activity»* of marks which are the same as or similar to the registered trade mark. This expression seems to be much broader than the corresponding expression of the Directive (*«in trade»*) and to encompass uses of the trade mark effected **not with a distinctive function**, but, for example, an ornamental function. i.e. uses which, under Art. 5.5 of the Directive, each individual Member State is free to consider as infringing or non-infringing but which some Italian case law and legal theory has, for some time now, considered unlawful (see, in particular, Court of Milan, 4 March 1999, in *Giur. ann. dir. ind.*, 1999, no. 3987 and Court of Turin, 5 November 1999, in *AIDA*, Rep. 2000; and in legal theory GALLI, *I limiti di protezione dei marchi rinomati nella giurisprudenza della Corte di Giustizia C.E.*, in *Riv. dir. ind.*, 2004, and in *IP_LAW_GALLI Newsletter*, October 2004; and GALLI, *Estensione e limiti dell'esclusiva sui nomi e sui segni distintivi dello sport, tra merchandising e free-riders*, in *AIDA*, 2003)

b) the meaning of the rule whereby **only the holders of prior rights are entitled to claim nullity for design registration**, which has been clarified by stating (Art. 43) that this limitation only concerns the situations cited in Art. 11.4 of EC Directive 98/71 (i.e. when the design constitutes *«non-authorized use of a work protected by copyright»*; when *«a distinctive sign is used in a successive design»* which another party may forbid the use of; and when the design is in conflict with another design which has been protected in the State since a date prior to that of the registration or priority of the model or design in question, but which has not yet been divulged at that date), and not all those cases in which the design lacks novelty or distinctive character (as the previous text stated), thus admitting the interpretation of the article given in legal theory by GALLI, *L'attuazione della Direttiva comunitaria sulla protezione di disegni e modelli*, in *Nuove leggi civ. comm.*, 2001, 883 ff., pp. 897-898; the opposite view was, however, expressed by FLORIDIA, in AUTERI-FLORIDIA-MANGINI-OLIVERI-RICOLFI-SPADA, *Diritto industriale. Proprietà intellettuale e concorrenza*, Torino, 2001, pp. 282-283)

c) again in the field of **designs**, the scope of application of the **transitory system** introduced on implementation of EC Directive 98/71 – which allows those who exploit a work of design now protected by copyright that earlier was in the public domain to continue said exploitation for ten

years starting from 19 April 2001 –, Art. 239 states that this concerns all «*designs which were in or which entered the public domain*» prior to implementation of the Directive, thus clarifying the fact that this applies **not only to works of design which, prior to introduction of the new law, were covered by a design patent which had expired but also to those which had never been patented**. This corresponds to what has been expressed in legal theory by GALLI, *L'attuazione della Direttiva comunitaria sulla protezione di disegni e modelli*, cit., p. 901, but runs contrary to other legal theory (see, in particular, BONELLI, *Industrial design e tutela di diritto d'autore*, in *Dir. aut.*, 2003, 497 ff., p. 521) and some case law (Court of Monza, interim order 23 April 2002; Court of Monza, interim order 16 July 2002; and Court of Florence, 6 August 2003, which are discussed in the «The Article» section of this Newsletter)

d) the applicability of the so-called «**galenic exception**» (whereby medicines covered by a patent may be made up on the spot and in units in chemist shops on presentation of a doctor's prescription), which Art. 68 of the Code has made conditional upon the fact that «**industrially prepared active principles are not used**»

e) again in the field of patents, the possibility of granting a **compulsory licence in favour of the infringer**, which is now expressly **excluded** both for the licence for failure to implement the patent and for the licence in favour of the owner of a dependent patent (as already held in legal theory and case law), excepting, however, in both cases, situations in which the infringer «**demonstrates his good faith**» (Art. 72). This may be particularly important for IT and computer implemented inventions patents.

f) the much disputed regulation giving **researchers belonging to universities and other public research institutions** the right to patent their inventions, derogating from the general regulation which gives this right to the employer. This regulation is unchanged, but it **cannot** be applied when the research leading to the invention has been **financed completely or in part by private parties or by other public bodies** (Art. 65, paragraph 5)

The main innovations of the Code also concern **procedural law**.

One of the first new points in this regard lies in extending to **non-registered trade marks** and **trade secrets** the possibility of using typical **interim measures** and **sanctions**. These had previously only been applied in favour of trade marks, patents and copyright, and have shown themselves to be particularly effective in their practical application.

Among these measures, the «**descrizione**», i.e. the interim measure which permits infringement proving information to be gathered at the premises of all parties involved in the unlawful activity, has been expressly extended (Art. 128) to the acquisition of **proof as to the extent of the infringement**, important above all in assessing compensation, thus codifying a solution which had already been used in some court decisions (see the orders obtained by our firm cited in the Newsletter of October 2004).

It is most certainly opportune that **compulsory intervention of the Public Prosecutor has been cancelled** (although it is doubtful whether it comes within the limits of the delegation) in cases of nullity and lapse of an IP right (Art. 122). This intervention had often caused problems.

As regards domain names registered in violation of another's trade mark right, it has further been expressly provided that **transfer in favour of the entitled party** may be ordered, both with the final decision (Art. 118, paragraph 6) and with the interim decision (Art. 133, which also provides for the possibility that the beneficiary of the order may be required to pay a suitable deposit).

The most important procedural innovation is, however, the application, to all disputes under the remit of the IP Specialised Divisions (and therefore, as stated previously, to all cases concerning trade marks, patents, copyright, Antitrust Law in matters concerning IP rights and connected matters), of the **special procedural regulations**, so far only seen in **company law** cases. These regulations should **speed up proceedings**, as they involve a **pre-investigative stage** carried out

without the judge. This stage, what is more, requires particular attention on the part of the defence team and, therefore, increases the need to call on experts in the field who are able to **coordinate effectively** with the party and its IP consultants. It must also be pointed out that the company procedure provides that **decisions issued after interim proceedings** become **final**, if the relative proceedings into the merits are not brought by one of the parties within a certain period of time. This seems to run contrary to Art. 50, paragraph 6 of the TRIPs Agreement. Anyone obtaining an interim measure on the basis of the new system would be well advised to bring a case into the merits all the same, at least until the issue is clarified at case law level.

On the whole, these legislative changes have been positive although there are reasons for regret and some uncertainty. The regret concerns some **innovations which failed to be taken up**, such as streamlining administrative measures against piracy and extending them to all violations of IP rights (or to those effected through copies which are substantially identical to the original products); or harmonising with the articles of EC Directive no. 93/98 (which provides for a time period of seventy years for all works covered by copyright) the length of copyright protection for creative works of design (currently only twenty five years in Italy): INDICAM insisted particularly on these two issues. The **uncertainty**, on the other hand, concerns the innovations for which there is some doubt as to their connection to the «formal and substantial coordination of the provisions in force» for the purposes of «juridical, logical and systematic consistency», which marked the limits (also for what concerns **constitutional legitimacy**) of the delegation granted by the Parliament to the Government to issue the Code. Adoption of the company procedure appeared particularly problematic from this point of view, even if the latest amendments, which extend application to all cases under the remit of the Specialised Divisions, have most certainly weakened (and maybe cancelled) the doubts which could be felt in this regard.

There is therefore a well-founded hope that this reform may further **consolidate the relaunch of Italy as an IP jurisdiction**. This relaunch had already begun positively with the various reforms of IP interim measures – which have made Italy, contrary to what continues to be thought – **one of the countries in which interim measures to protect IP rights can be obtained most rapidly and easily**– and then continued with the setting up of the IP Specialised Divisions.

✓ *Using trade marks which may be linked to smoking products for non-smoking products is ruled unlawful by the Court of Cassation*

The **indirect advertising of smoking products** through the use of their trade marks or trade marks which may be linked to them as trade marks for products of a different nature was recently examined by the Court of Cassation (Court of Cassation, 14 September 2004, no. 18431). The case concerned the advertising for a watch bearing as a trade mark the name of a car rally containing a well-known trade mark for cigarettes, whose owner had sponsored the event. The Court of Cassation held this advertising to be unlawful, as «*in the case in question, although it concerned a non-smoking product, it directly recalled prohibited sponsorship*».

The Court reasoned that the criterion for deciding on the lawfulness of the use of trade marks for smoking products for products of a different nature would be to check whether or not **the «message» they evoke in the business setting in which they are used recalls (even indirectly) smoking products**. Thus the Court seems to have changed its position with regard to previous declarations whereby «*when it has been soundly ascertained that the trade mark characterising a certain non-smoking product has become autonomous, each evocative effect of the original product must be excluded for it*» (Court of Cassation, 27 February 2001, no. 2822). In fact, in the reasoning following this decision it is only the concrete exclusion of every evocative effect of the smoking product which may allow **the «sound» ascertainment of the autonomy of a trade mark** used for non-smoking products with respect to the same or a similar trade mark distinguishing the latter, and not vice versa.

It remains indisputable, however, that, as the Court of Cassation has stated in general terms on a number of occasions (starting from its decision issued in 1995 in Joined Sitting of the Divisions), a

trade mark is lawful and may be advertised, even if identical to that used for smoking products, if it has acquired *«the ability to immediately identify a product which differs from the one originally recalled, having lost the possibility of evoking, inasmuch as it is used in a different sector, the original product»* (Court of Cassation, Joined Sitting of the Divisions, 6 October 1995, no. 10508; likewise see, among the other decisions, Court of Cassation, 23 March 2001, no. 4183).

✓ ***The Court of Cassation further clarifies the details on agreements of co-existence between trade marks***

The Court of Cassation returned again this year to the issue of **agreements of co-existence between trade marks**, i.e. agreements whereby the owners of two potentially conflicting trade marks recognise as legitimate, and thus mutually consent the use of, their respective trade marks, laying down procedure and limits, thus contractually defining the respective spheres of exclusive rights.

The **legitimacy** of delimitation agreements between trade marks was recognised, in general terms, by the Court of Cassation, 19 April 1991, no. 4225, in *Giur. ann. dir. ind.*, 1991, no. 2599. The Court of Cassation tackled this issue again, little more than a year ago, issuing a key decision which stated that if these agreements *«can be entered into for a length of time which is shorter than that of one or more of the exclusive rights at play, they may well, exactly because they are such, be drawn up to last as long as the co-existence itself»* (Court of Cassation, 22 April 2003, no. 6424, in *Giur. ann. dir. ind.*, 2003 – Professor Galli was a member of the defence team of the winning party), and, therefore, **potentially perpetual**, as is the potential life of the trade marks and the other distinctive signs.

In its recent decision no. 20472 of 19 October 2004, the Court of Cassation **further clarified** the subject, establishing that these principles apply even when the agreement **regulates use of the same trade mark by independent parties**, that is when a *«single production complex»* is broken up into *«a plurality of distinct and independent businesses»*.

A **limit** on the legitimacy of delimitation agreements comes with the bar on using the trade mark in such a way as to **mislead the public**. This deception, what is more, may not be considered *in re ipsa* when goods and services of the same kind or closely linked kinds coming from different producers (and in the correlative risk of confusion on the market, which alone does not give rise to problems of public order) circulate under the same trade mark, but must concern **the characteristics of the goods or services themselves which are important in evaluation by the public**.

THE CASE

✓ ***It is lawful to advertise as “patented” a product for which a patent application has not yet resulted in a patent being granted (Court of Varese, 12 October 2004) – The text of the decision translated into English***

On 12 October 2004 the Court of Varese issued a key decision in the area of advertising. The case involved two well-known Varese mechanical companies, represented by our firm, which had been accused of unfair competition due to the fact that in one of their catalogues they had defined a new lock for isothermic trucks, created by them, as *«patented»*, even if a patent application had been submitted for the lock but the patent had not yet been granted.

The Court rejected the opponent's claim, asserting the principle whereby *«The dispute in question does not correspond to a case of advertising which is unfair and consequently detrimental to the interests of the competitor since a patent application had been duly filed prior to distribution of the advertising material»*.

This decision is important, first of all, since it clarifies the lawfulness of behaviour which for many years has no longer been examined by the Magistrature and which, vice versa, the Italian Antitrust Authority (called on to assess the deception of advertising with respect to violation of Legislative Decree 74/92) has many times found to be unlawful, even if some of its more recent rulings hint at a change in its stance.

In practice, the Court took into account the fact that other businesses in the sector perceive an invention for which a patent application has been filed and an invention for which a patent has been granted as essentially one and the same thing and could thus not be misled. Under Italian law, the owner of a patent application may take legal action to protect the application, seeking interim measures, just as he would do if a patent had been granted. On the other hand, grant of a patent (which, in the case in question, happened just a few days before the decision was issued and thus the court decided not to take it into consideration) has retroactive effect to the moment of the application. Grant of the patent, on the other hand, does not preclude a court decision on its validity.

The decision comes into force immediately, pending the deadline for bringing an appeal.

The translated text of the decision follows.

COURT OF VARESE

First Civil Division in the person of Doctor Marco Lualdi, Sole Judge

has issued the following

DECISION

In the civil case registered under *Ruolo Generale* (General Register) no. 409/2003

between

Pastore & Lombardi s.r.l. (previously FHF s.r.l., incorporating the original Pastore & Lombardi s.r.l.), represented by the attorneys-at-law (...) - PLAINTIFF

and

De Molli Giancarlo Industrie s.p.a. (or De Molli Industrie s.p.a.) and **De Molli Romeo & C. s.n.c.**, both represented by the attorneys-at-law Professor Cesare Galli and Piero Cesare Iametti, and domiciled at the offices of the latter - DEFENDANTS

(*omissis*)

GROUNDINGS OF THE DECISION

The facts of the case may be considered indisputable and uncontested by the parties.

The defendants De Molli drew up, arranged, realised and distributed to the public, at least and most certainly on the occasion of the trade fair “*IJA di Hannover*” in September 2002, brochures and advertising material regarding their products in the “Locks for Isothermic Trucks Division”.

The prepared and distributed advertising material, as is clearly shown in the submitted documents, defines a number of De Molli products here described and illustrated as “**patented**”.

It is likewise indisputable that no patent had been granted to De Molli for the above products, at least at the date on which the advertising was distributed.

Having ascertained these “factual” premises, Pastore’s legal team argues that such conduct constitutes unfair competition under articles 2598 ff of the Civil Code as the defendants attributed non-existent qualities to their products and in particular boasted of the existence of a patent, and

that such conduct could mislead the customer/client with the inevitable consequent detriment to competing businesses.

The first question which merits being tackled is the pivot of De Molli's defence argument.

In fact, it affirms that there is nothing misleading about the word "patented" in the advertising material submitted by the opponent as the products referred to by the contested word were **the subject of a national patent application** MI002A001428, duly filed by the companies on 28.6.2002 (an indisputable and documented fact) and thus before the realisation and distribution of the advertising material in suit.

According to the arguments of the defendants the nature of the patent grant procedure under articles 27 ff. of Royal Decree no. 1127/1939, which does not make granting the patent conditional on a prior examination of the requisites of novelty and inventive step of the invention, reduces the grant to a natural and virtually unfailing consequence of the mere examination of the application, with the result that the simple filing of the application characterises the product with the same qualification of "patented".

These conclusions deserve to be admitted.

The premises for conviction under Art. 2598 no. 3 Civil Code are, in fact, that the agent is guilty of misrepresentation or negligence and that it has been ascertained that damage has occurred.

The above negligence must, in the opinion of the Court, go hand in hand with the conscious and voluntary performance of an act provided by Art. 2598 Civil Code by a party which is unaware of, due to its failure to ascertain, some basic facts of the unlawful conduct.

In the case in question the patent grant procedure under this article **excludes** the grounds for the conduct in suit being deemed as a "tort", i.e. the alleged *misrepresentation*, and thus the existence itself of the agent's guilt.

Patent grant procedure under articles 27 ff Royal Decree 1127/1939 does not make patent grant conditional upon prior examination of the requisites of the invention's novelty and inventive step. It thus becomes an administrative procedure regulated by mere formal scanning and ending with grant of the patent.

From this standpoint, there are a number of decisions which have actually stated that the inventor has a real subjective right to be granted a patent given that the state body to which this request is made has no discretionary power to grant or refuse it (*Court of Appeal of Milan 11.3.1975*).

The importance to be attributed to the due filing of the patent application, an importance which is not merely "*formal*" as an introductory document in the administrative proceedings but also "*substantial*", can be seen from the forms and instruments of protection which this article confers upon the interested party simply for having filed the application (we need only consider Art. 83 *bis* and Art. 4 of the same law).

That having been stated, the Court considers that it has not been established that the advertisement might have misled the consumers of the product advertised by the competitor as attribution of the term "patented" whilst a patent application is pending does not endow that product with any particular quality nor does it lead one to believe that the product has undergone a technical examination or that it possesses the essential requisites of novelty and inventive step.

The fact that the advertising message is not misleading thus precludes any further investigation into real or potential detriment to the competitor (*Court of Rome, interim order 2.2.1999*).

The case law cited by the defendants supports this interpretation. These decisions have in essence confirmed the principle whereby "*...qualifying one's product as patented, after filing the patent application but prior to the patent being granted, does not constitute unfair competition ...*" (*Court of Appeal of*

Milan 13.3.1975) and again “... *the simple fact that at the time the patent application had only been filed and the patent not yet granted does not constitute misrepresentation and therefore unfair competition, given that under Italian Law patent registration does not involve prior examination of the requisites of validity ...*” (Court of Milan 12.7.1976).

In the light of the above, it is difficult to find any “fault” in the conduct of De Molli corresponding to the situation provided by Art. 2598 Civil Code.

De Molli, knowing that it had duly filed the patent application and trusting in the subsequent patent grant at the end of the administrative procedure, essentially “moved forward” patent grant in qualifying its advertised goods as patented.

In fact, no factor “negligently overlooked” by De Molli could lead one to believe that the patent would not be granted as there was a “reasonable prediction” regarding the validity of the patent, a patent which the defendants in their final brief stated had been duly granted for those goods referred to in the disputed advertising (the defendants’ request to submit documentation attesting to the patent grant was rejected by the Court as it had been made too late, after the hearing for final pleadings).

The case in question does not correspond to a case of advertising which is “unfair” and consequently detrimental to the interests of the competitor since a patent application had been duly filed prior to distribution of the advertising material.

The above considerations must be considered likewise admitted also taking into account the fact that the advertising material in suit was distributed in another EU Member State.

In fact, the Court considers that the advertising material was not misleading since there was no reference in this material to the existence of a European Patent, the only patent which would have allowed its owner to exercise the same rights abroad as those given by a national patent.

Thus, the fact that there was no reference to a European Patent means that the consumers/clients could not have been misled, being led to believe that there was only a national patent issued in the country of origin of the business, with all the above consequences.

The plaintiff’s claims deserve therefore to be disregarded.

Likewise, De Molli’s counterclaims must also be disregarded .

According to the defendants, that conduct of Pastore could disturb the business activity of the competitor, with the consequent obligation to compensate for the damage caused pursuant to Art. 2598 Civil Code, is that of “... *undertaking legal action ...*” for the sole purpose of hindering the competitor in its business initiatives.

However, in this case De Molli has suffered no damage because of the plaintiff’s legal action.

In fact, none of Pastore’s legal actions has been admitted and thus no order has been issued causing serious competitive detriment to the defendants.

The order requested by Pastore and adopted on 6.2.2003 by the Italian Antitrust Authority enjoining De Molli from further distribution of the advertising material, does not constitute unfair competition.

It is even more difficult to state that there is a **causal link** between this episode and any specific damage caused to De Molli. De Molli, as can be seen in the documents of these proceedings, withdrew all incriminating advertising material and replaced the word “patented” with “patent pending” prior to the order being issued by the Authority and in reaction to Pastore’s simple objections. Consequently the order in essence had no “cogent” or potentially detrimental concrete effects on De Molli’s activity.

Any damage caused by the “vexatious action” with reference to this single and specific order would also be hypothetically and autonomously sanctioned in the compensation claim presented by the defendants under Art. 96 of the Code of Civil Procedure as a subordinate request.

The defendants’ compensation claim pursuant to Art. 96 of the Code of Civil Procedure must thus be rejected.

An examination of the papers of the proceedings shows that there was nothing at all in Pastore’s procedural conduct on which to base a ruling of aggravated liability against the losing party.

In particular, Pastore’s right to take legal action did not assume the nature of abuse, as having been exercised outside its typical pattern or beyond the limits determined by its function.

The vexatious nature of a suit, the prerequisite for a compensation order, may be seen in the awareness that the claim and arguments are unfounded, or rather, in the lack of normal diligence to acquire said awareness, not in the mere opinionability of the claimed right (*Court of Cassation 21.7.2000 no. 9579*).

Furthermore, the defendants did not give any concrete and objectively relevant evidence that there was any damage to be compensated and such evidence may not even be found in the papers of the proceedings. Thus the Court is precluded from awarding damages, even equitably (*for all Court of Cassation 1.12.1995 no.12422*).

In accordance with Italian Law, the plaintiff is ordered to pay ½ of the costs of the proceedings. This amounts to € 8.505,00 of which € 35,00 for advanced sums, € 770,00 for general costs, € 700,00 for taxes and € 7.000,00 for legal fees, plus CP (Lawyers’ Provident Fund) as per the law.

Rejection of the plaintiff’s claim and rejection of De Molli’s counterclaim result in setting off suit costs between the parties of the other ½.

FOR THESE REASONS

THE COURT

In its final ruling, disregarding all contrary petitions, objections or inferences, on the claim submitted in the Writ of Summons served on 25.2.2003 by Pastore & Lombardi S.r.l.

REJECTS as unfounded the claim submitted pursuant to Art. 2598 Civil Code by Pastore & Lombardi S.r.l.

REJECTS the compensation counterclaim submitted by De Molli Giancarlo Industrie S.p.a., De Molli Romeo & C. S.n.c..

DECLARES that ½ of the costs of the proceedings will be set off between the parties.

ORDERS Pastore & Lombardi S.r.l., in the person of its legal representatives, to pay a further ½ of the costs of the proceedings, which amounts to € 8.505,00, of which € 35,00 for advanced sums, € 770,00 for general costs, € 700,00 for taxes and € 7.000,00 for legal fees, plus CP (Lawyers’ Provident Fund) as per the law.

So decided in Varese, 23 September 2004. Filed in the Court Clerk’s Office on 12 October 2004.

THE ARTICLE

- ✓ *Trade Marks, designs, newspaper titles, domain names: a year of case law - An article by Professor Cesare Galli soon to be published in **Annali Italiani del Diritto d’Autore***

As happens each year, the review *Annali Italiani del Diritto d'Autore* has given Professor Cesare Galli the task of examining and commenting on the main Italian and EU decisions in trade mark matters, in relation to their impact on the culture industry.

Professor Galli's article is soon to be published in the 2004 volume of the review under the title *Segni distintivi e industria culturale* (Distinctive Signs and the Culture Industry). A full summary of the article follows.

CESARE GALLI

**TRADE MARKS, DESIGNS, NEWSPAPER TITLES, DOMAIN NAMES:
A YEAR OF CASE LAW (SEPTEMBER 2003 - SEPTEMBER 2004)**

SUMMARY: 1. Trade marks and names with a reputation: interference and limits of protection. – 2. (continued) The parasitical exploitation of the reputation of a trade mark. – 3. Industrial design and trade marks. Protection of the external features of a work protected by copyright. – 4. EU Case Law: a) scope of protection of the trade mark and descriptive use of another's trade mark. – 5. (continued) b) Name, shape, colour and sound trade marks. – 6. Trade marks and newspaper titles. – 7. Distinctive signs on the Internet.

1. The **protection of the reputation of names and trade marks** has, this year too, been one of the most hotly debated issues in Italian case law.

The Court of Turin confirmed, at the end of proceedings into the merits, the interim injunction issued at the preliminary stage of proceedings on the **use as a domain name of the name of a well-known actress** by a publishing firm. The peculiarity of this case lies in the fact that the legal foundation for the decision is to be found not in the law regulating the rights of the name nor in that of trade marks, but in the **law on privacy** (Law 31 December 1996, no. 675), in that said use was qualified as «*unlawful handling of personal data*»¹. The law on privacy and its relationship with Trade Mark law regarding the use as a trade mark of another's name has also been examined by the Court of Naples. The Court stated that this law **did not apply** when the adopted name was not well-known, or, at any rate, when its insertion in the trade mark did not lead to the person bearing that name being recognised. The Court observed that in these cases the name «*in fact, loses its semantic meaning of name (and) takes on ... that of a trade mark*», thus «*there is no personal data to protect*»².

The Court of Verbania, Domodossola Division, examined a case of conflict regarding the use as a trade mark of the name «Orfei», which brought together two members of the well-known Italian family of circus artistes. The Court found for the owner of the earlier registration, stating – in line with prevailing case law and legal theory – that «*the problem of the relationship between the right on a name and a trade mark right is fully regulated by trade mark law, which provides that Art. 7 of the Civil Code has no direct relevance to the matter*» (i.e. the article concerning protection of the name of a person), and

¹ Court of Turin, 9 February 2004, in *AIDA*, 2004. The actress was Alessia Merz, and the interim injunction was issued by the Court of Turin, interim order 23 December 2000. Again, with regard to famous people in the worlds of sport and entertainment, three decisions (all published in *AIDA*, 2004) have ruled unlawful the non-authorised use in advertising of the images of, respectively, an actor (Court of Rome, interim order 23 July 2003), a footballer (Court of Tortona, 24 November 2003) and the winner of a beauty contest (Court of Appeal of Milan, 18 November 2003), stating that the public interest which justifies use of the image without the consent of the person portrayed does not, by definition, hold in the case of use of an image for advertising purposes.

² Court of Naples, 13 March 2003, in *Foro it.*, 2003. The case concerned the registration as a domain name of the name «Rapolla», corresponding to the name of a person who is not well-known and a place name. The Court ruled the registration invalid on the basis of the latter, in that it was generic, since the site which was to be thus designated was dedicated to the Municipality of the same name. This decision seems disputable, to say the least, given that generic domain names are not null, but rather not protectable as distinctive signs (on this point see GALLI, *I domain names nella giurisprudenza* (Domain Names in Italian Case Law), Milan, 2001, p. 22).

that under trade mark law such use «*in the undertaking of an identical business activity*»³ is always unlawful. This decision seems to stem directly from the wording of Art. 1-*bis*, paragraph 1 Trade Mark Law (which implemented **Art. 6.1 of EC Directive 89/104**), whereby the descriptive uses of another's trade mark considered in the article, including one's name and address, in order to be lawful must not be effected «*with the function of a trade mark*». It will, however, be reviewed, on the basis of the recent ECJ decision which held that Art. 6.1 of EC Directive 89/104 is to be interpreted as meaning that the lawfulness of the uses of another's trade mark which it lists is not excluded by the sole fact that they are effected with the function of a trade mark, but only when they are not in accordance with honest business practices⁴: it being understood that it would be difficult to consider use with the function of a trade mark (or, at any rate, of a business distinctive sign) of another's trade mark which does not give rise to the likelihood of confusion or at least to **parasitical exploitation** and which may therefore comply with honest business practices.

The Court of Cassation examined Art. 7 Civil Code in a case in which this article was invoked by a private individual whose surname had been adopted as **the name of a company**. This company intended to carry on the work of a previous company which had gone bankrupt. The bankrupt company had been set up by the father of the plaintiff and its company name had not been transferred to the new company. The Court of Cassation overturned the decision of the Court of Appeal on the grounds that **detriment, at least potential**, deriving from adoption of the name, had not been proved in concrete terms⁵.

The Court of Salerno also examined Art. 7 Civil Code in a case of **non-authorized use of the name of a bank as a domain name**. The Court ruled that this article may be «*applied in the same way also to private or public bodies, in relation to the interest of same in avoiding being mistaken for other parties, and to their right on the name, recognised by law, also in the light of the constitutional principle laid down in Art. 2 of the Constitution*», and to the right of a body «*to its own personal identity*». The Court ruled that in this case «*the potential harmfulness of the defendant's conduct (was) in re ipsa*» and lay in the bar on using the same sign as a domain name⁶. The Court of Salerno was also of the opinion that Art. 7 applies only when «*special legislation is not applicable*», but ruled out – debatably – the possibility that in the case in question this special legislation could be invoked, since it was not a question of «*adoption of a business name or trade mark*», neglecting the nature of a business distinctive sign which, in the case at issue should, undoubtedly, have been given to the contested domain name. That would in all likelihood have allowed reference (also) to be made to the special legislation for protecting business names.

2. The Court of Turin likewise examined the right of a profit-making company to «**personal identity**», and to the right on its trade mark and business name in a case between a well-known car manufacturer and an **association** which used the same trade mark in its name and in the **title of a**

³ Court of Verbania, Domodossola Division, interim order 14 May 2003, in *Giur. ann. dir. ind.*, 2003. The order deemed irrelevant also the fact that the disputed trade mark also contained the first name of the owner (Armando Orfei). For the most recent decision which has found that a difference in the first name does not usually have any bearing on excluding likelihood of confusion and therefore interference between two trade marks hinged on the same surname, see a ruling from the Court of Catania, interim order 14 November 2003, in *Giur. ann. dir. ind.*, 2003; also see, again very recently, Court of Forlì 27 June 2003, *ibidem*, which reached the opposite conclusion, holding that in the case of name trade marks constituted by a widespread surname (in the case in question, Rossi, which is very common in Italy) the distinctive nature was to be found «in the first name (in the case in question, Sergio) or, rather, in the combination of this with the surname». It may be asked if similar considerations may also hold in the case in question, in consideration of the well-known co-existence on the market of different circuses headed by various members of the Orfei family, distinguished from each other by the first names of the specific artistes.

⁴ E.C.J., 7 January 2004, C-100/02, discussed more fully in paragraph 4. In fact, Art. 21 of the Italian Industrial Property Code – i.e. the article which replaced Art. 1-*bis* of the Trade Mark Law – does not provide for this limitation, only requiring that this use of the third party «comply with principles of good professional conduct».

⁵ Court of Cassation, 16 July 2003, no. 11129, in *Corr. giur.*, 2003.

⁶ Court of Salerno, 25 February 2003, in *Dir. inf.*, 2003.

magazine which it published⁷. This ruling confirms the prevailing stance – albeit not unanimous – of Italian case law which holds that **descriptive uses of famous trade marks are also unlawful, when said uses profit from the reputation of the trade marks.**

The Court of Bolzano handled the question of the non-authorized use in a domain name of the name of the public body administering a particular area, which had registered it as a **collective trade mark** for quality products typical of that area. The Court held that this use was lawful, as on the one hand «*the geographical name of the area administered by a public body is not perceived by the public as identifying the administering body*», and, on the other, «*the law regarding extended protection of the trade mark with a reputation does not apply to collective trade marks, which therefore do not extend their scope of protection to non-similar products*», as were those to which the disputed domain name referred⁸. This conclusion indeed appears debatable, given that **there is no reason to exclude collective trade marks with a reputation from the extended protection under Art. 1, paragraph 1, letter c of the Trade Mark Law (corresponding to Art. 5.2 of EC Directive 89/104)**, so much so that protection against commercial parasitical exploitation seems to be no longer an exception but the rule; and that protected denominations of origin and geographical indications are also protected against **undue exploitation of the reputation** which they enjoy⁹.

Non-authorized use of famous trade marks in the worlds of culture and entertainment has been ruled unlawful by two decisions regarding trade marks which used respectively the **title of a film** and a TV series inspired by the film¹⁰, and that of a **TV programme**¹¹. In the first case a claim that the trade mark was null due to violation of Art. 21, paragraph 3 Trade Mark Law was admitted (in Italy this article protects names which have a reputation outside the business sphere). In the second case the use of the trade mark was held to constitute unfair competition and violation of the right on the title of a creative work. As regards the latter stance, we may wonder whether violation of Art. 21, paragraph 3 of the Trade Mark Law could also have been invoked in the second case. This article seems to involve **not only the nullity of the trade mark which unlawfully uses a famous name but also a bar on using it**, parasitically exploiting the reputation of the trade mark¹².

Again as regards the protection of trade marks with a reputation, an interim injunction issued by the Court of Bari must be mentioned. The Court awarded protection to the well-known trade mark of a publishing firm, relative to information services, against its use as a **domain name for an Internet radio**. In this case it is significant that the Court held it unnecessary to assess the affinity between the services designated by the conflicting trade marks, in consideration of the «*peculiar way of accessing the available services on the Internet, based on the domain name as a fundamental element for service recognition*»¹³.

⁷ Court of Turin, 9 January 2003, in *Giur. ann. dir. ind.*, 2003. The car manufacturer in question was Fiat, and the Association was called «Associazione Registro FIAT Italiano» and published a magazine entitled «Registro FIAT», in which the logo of the car manufacturer also appeared.

⁸ Court of Bolzano/Bozen, Brunico/Bruneck Division, 30 August 2003, in *AIDA*, 2004. In the sense that the use of a geographical name as a trade mark does not violate the right of the homonymous body administering the relevant area on its name had already been expressed, for the same reasons as those given by the Court of Bolzano, see Court of Cassation, 20 December 2000, no. 16022, in *Giur. ann. dir. ind.*, 2001, no. 4203.

⁹ This extended protection for P.D.O. and P.G.I. is expressly provided by Art. 13 of EEC Regulation 92/2081. In general, on this argument, see GALLI, *Globalizzazione dell'economia e tutela delle denominazioni di origine dei prodotti agro-alimentari*, in *Riv. dir. ind.*, 2004.

¹⁰ Court of Modena, interim order 19 August 2002, in *Giur. ann. dir. ind.*, 2003. The title of the film and the TV series was «Saranno famosi» («Fame»).

¹¹ Court of Bologna, interim order 19 August 2003, in *Giur. ann. dir. ind.*, 2003. The disputed trade mark was «Veline».

¹² In this sense see Court of Modena, interim order 26 June 1994, in *Giur. ann. dir. ind.*, 1994 and in *Nuova giur. civ. comm.*, 1995. In legal theory in the same sense see VANZETTI-GALLI, *La nuova legge marchi*², Milano, 2001, p. 157.

¹³ Court of Bari, interim order 1 July 2002, in *Giur. ann. dir. ind.*, 2003. The imitated trade mark was «radiocor», filed by Il Sole-24Ore, and the infringing domain name was «radiocor.it». In the sense that the initial error made by a surfer due to the fact that a domain name is the same as or resembles another's trade mark may be

The EU Court of First Instance handled the issue of a EU trade mark constituted by the name of a famous **cartoon character**, for the purposes of deciding on novelty, and on this occasion had the chance to confirm the principle already pronounced by the ECJ¹⁴ (and in line with what some Italian legal theory had already argued¹⁵), whereby «*The likelihood of confusion on the part of the public must be assessed globally, taking into account all factors relevant to the circumstances of the case ... This global assessment implies some interdependence between the relevant factors, and in particular a similarity between the trade marks and between the goods or services concerned. Accordingly, a lesser degree of similarity between those goods or services may be offset by a greater degree of similarity between the marks, and vice versa*»¹⁶.

The EU Court issued an important ruling on another famous name in the world of culture – the surname of the painter **Pablo Picasso**, registered and used, with the consent of his heirs, as the trade mark for a car. The Court **ruled out** the possibility that the trade mark in question could deprive a similar trade mark, again registered for cars, of novelty, by virtue of the **great reputation outside the business sphere** enjoyed by that name, which, according to the EU Court, does not mislead the public when the trade marks are not identical¹⁷. The ruling is important because it **destroys a real myth**, whereby the great reputation of a trade mark necessarily increases the likelihood of confusion¹⁸: and thus confirms that the path to be followed in extending the scope of protection of famous trade marks **is not so much that of the likelihood of confusion as that of exploitation/detriment** depending on the recall to the famous trade mark which the second trade mark makes.

The Court of Catania examined a dispute between a **musical group** and an ex member who had continued to use the name. The Court found that the ex member of the group had infringed the registered trade mark of the company constituted by the original members of the group and its business name¹⁹. The Court ruled as unlawful the use of the group's name by the ex-member also because said ex-member, having formed a new band, had advertised the group with a poster «*in which the name of the group of which he was part (was) in such a **position and used such characters as to be highlighted** with respect to the name of the new group*», thus **parasitically exploiting the reputation** of the old group. It can be understood from the ruling that the solution might have been different if the name of the old band had been used merely with a descriptive function and in a completely secondary position.

3. With regard to works of design, of particular bearing is the problem of interference between different forms of protection which arises with the application of the new provisions introduced in this field by Legislative Decree 95/2001, which implemented EC Directive 98/71.

In particular, the relationship between copyright protection and protection against unfair competition due to likelihood of confusion has been tackled in a ruling issued by the Court of Florence. The Court held that a work of design which has creative character and artistic value and

important not as regards likelihood of confusion but as regards exploitation/detriment under Art. 1, paragraph 1, letter c Trade Mark Law (corresponding to Art. 5.2 of EEC Directive 89/104) see my *L'allargamento della tutela del marchio e i problemi di Internet*, in AA.VV., *Il futuro dei marchi e le sfide della globalizzazione* edited by GALLI, Padova, 2002, p. 17 ff., pp. 31-33 (also published in *Riv. dir. ind.*, 2002, I, 103 ff., pp. 119-121).

¹⁴ ECJ, 29 September 1998, in C-39/97, «Canon».

¹⁵ See, in particular, GALLI, *Problemi attuali in materia di marchi farmaceutici*, in *Riv. dir. ind.*, 1992, I, 14 ff., pp. 46-47 and, more generally, *Funzione del marchio e ampiezza della tutela*, Milano, 1996, pp. 105-107.

¹⁶ EU Court of First Instance, 22 October 2003, in T-311/01. The trade mark was constituted by the name «Asterix».

¹⁷ EU Court of First Instance, 22 June 2004 in T-185/02. The trade mark whose likelihood of giving rise to confusion with «Picasso» was discussed was «Picaro».

¹⁸ On this point see RICOLFI, *La tutela dei marchi che godono di rinomanza nei confronti della registrazione ed utilizzazione per beni affini nella giurisprudenza della Corte di Giustizia*, in *Giur. it.*, 2004, 283 ff., which is in line with the opinion expressed by the Attorney General Ruiz-Jarabo Colomer in his conclusions of 13 June 2002 in the «Arsenal» case (C-206/01).

¹⁹ Court of Catania, 14 April 2003, in *Giur. ann. dir. ind.*, 2003.

can therefore (also) be covered by copyright, may **combine** this protection with that against unfair competition due to likelihood of confusion²⁰. However, this conclusion seems, to say the very least, debatable, given that **a work of design possessing artistic value can, by definition, confer substantial value on the product in question**, and as such cannot be protected as a trade mark and thus not even against unfair competition due to likelihood of confusion; in this case, rather, as there is a competitive relationship between the active and passive subjects of the tort, violation of copyright would seem to lead to a situation of **so-called “dependent” unfair competition**, pursuant to Art. 2598, no. 3 Civil Code.

The decision also ruled out *«any relevance of the question regarding separating the artistic value from the industrial nature of the products»*, stating (correctly) that the 2001 reform had cancelled this requisite to benefit from copyright protection²¹. The Court of Florence thus denied that the transitory system under Art. 25-*bis* of Legislative Decree 95/2001 (which allows those exploiting a work of design now protected by copyright that in the past was in the public domain to continue this exploitation for ten years starting from 19 April 2001) could apply to the work in question. It held that this system only concerned works of design which, prior to introduction of the new law, had been covered by a **design patent which had now expired**, and not those which had never been patented. This conclusion seems debatable, given that the need underlying the transitory provision in question (to protect someone who had made investments to reproduce a work in the public domain) is the same in both situations²².

Case law published this year has also been able to examine in more depth the issue of **protection of the external characteristics of the works protected by copyright**. The question was the subject of an order issued by the Court of Rome in a case in which *«the essential and characterising features of a communicative idea»* expressed in the form of a TV cartoon work were imitated also by means of *«writing and characters which are similar to ... the original ones»*. The Court held that this conduct constituted both **«infringement of the film copyright»**, and **unfair competition due to likelihood of confusion and non-compliance with honest business practices**²³.

Similarly, the Court of Udine stated that the infringement of a piece of software constituted **infringement of the trade marks of the copied software**, which appeared *«in the images visualised on the computer screen whilst the program was in use»*²⁴.

4. In **EU case law** there have been more and more decisions from the ECJ on trade marks, issued in preliminary ruling about EC Directive 89/104 or in appeals against the corresponding decisions of the EU Court in EU trade mark matters. The most significant rulings include those regarding the scope of trade mark protection and protectable trade marks.

Among the former certainly the most important is that issued at the end of 2003 regarding trade marks with a reputation in the *«Adidas»* case²⁵. In fact, in this decision the ECJ stated that the detriment that Art. 5.2 of the Directive refers to, as an alternative to undue advantage, as a specific

²⁰ Court of Florence, 6 August 2003, in *AIDA*, 2004. The case concerned a lamp which, according to the decision, *«due to the peculiarity of its shape and structure, the harmony and balance of the lines, constitute the artistic expression of creative and aesthetic research which has matured in the environment of a well-known cultural movement (in the case in question, Bauhaus)»*.

²¹ See, for an opposing point of view, the two orders of the Court of Monza, interim order 23 April 2002 and Court of Monza, interim order 16 July 2002 (issued at the appeal stage of the same proceedings), cited – and criticised – by GALLI, *Segni distintivi e industria culturale*, in *AIDA*, 2003.

²² This interpretation (criticised in legal theory by GALLI, *L'attuazione della Direttiva comunitaria sulla protezione di disegni e modelli*, in *Nuove leggi civ. comm.*, 2001, 883 ff., p. 901) seems today to have been overtaken by the new wording of Art. 239 of the Industrial Property Code (which replaces Art. 25-*bis*), in which the transitory system is expressly made applicable to *«designs which were in or which entered the public domain»*.

²³ Court of Rome, interim order 14 January 2004, in *AIDA*, 2004.

²⁴ Court of Udine, 29 April 2004, in *AIDA*, 2004.

²⁵ ECJ, 23 October 2003, in C-408/01, on which we may read, for further examination, GALLI, *I limiti di protezione dei marchi rinomati nella giurisprudenza della Corte di Giustizia C.E.*, in *Riv. dir. ind.*, 2004, and in *IP_LAW_GALLI Newsletter*, October 2004.

requisite for protection of renowned trade marks is 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*» (point 29 of the decision); and **denied** that the mere fact that the sign of the imitator is (also) perceived by the public as **decorative** could rule out the application of Art. 5.2 of the Directive to this use, each time the public made a connection between the sign and the trade mark. It is exactly this connection, or rather, the **simple psychological recall to the other's well-known trade mark** which thus seems to emerge as the common denominator of the two situations of undue advantage and detriment under Art. 5.2 of the Directive, resembling «**dikelihood of association**», as it was described – prior to implementation of the Directive – in Benelux case law.

The ruling did not, however, take into account another question which could have some bearing on the case in question i.e. establishing whether the uses of the same or a similar trade mark which, albeit able to lead the public to make a connection between the sign and the trade mark, **are not effected to distinguish** the goods designated by the mark also come within the scope of protection. The ECJ had dealt with the question less than a year before, issuing a decision stating that Art. 5.4 of the Directive had excluded this specific matter from harmonisation, leaving each individual Member State free to decide on this matter as they saw best²⁶. The fact that neither this ruling nor the «Arsenal» decision²⁷ examined this aspect, although both cases involved use of the disputed trade mark in all likelihood not effected with the function of indicating the origin of the goods designated, is, what is more, a clear indication of the difficulty of distinguishing between the two situations, when it is ruled (as the ECJ did) that **the trade mark is protected not only against the likelihood of confusion but also against parasitical exploitation** of its reputation and distinctive character, or rather against the detriment caused to same. In fact, at least under Italian Law, it becomes extremely difficult – and, at least in Italy, possibly constitutionally unlawful due to violation of the principle of equality – to discriminate between parasitical uses of the trade mark effected with or without a distinctive function²⁸.

Equally important – especially for Italy – is another decision in which, as was briefly mentioned, the ECJ tackled the issue of the **lawful uses of another's trade mark under Art. 6.1 of EEC Directive 89/104** (and Art. 1-*bis*, paragraph 1 Trade Mark Law), denying that the fact that the sign is used «*not as a trade mark*» (as the Italian article states) comes within the requisites of lawfulness sanctioned by the article and concluding that the only criterion to be followed in assessing the lawfulness of the sign, in the situation considered by the article in question, is to verify whether or not it is used «*in accordance with honest practices in industrial or commercial matters*» (point 24 of the decision), without this compliance being per se excluded by the «*mere fact that there exists a likelihood of aural confusions*» (point 25) between the trade mark and the sign²⁹. The decision was issued in relation to a mark consisting in a geographical name in conflict with another (similar) mark of a geographical nature, and this seems to have influenced the solution adopted. It is, however, clear that on the basis of this interpretation **the presumption of unfairness in the use of the sign as a trade mark has been ruled out**, and it must be established on a **case by case** basis whether or not the use corresponding to one of the situations listed in the article is, in concrete terms, to be regarded as honest³⁰. This, at least under Italian law, must, in all likelihood, be rejected each time

²⁶ ECJ, 21 November 2002, in C-23/01.

²⁷ ECJ, 12 November 2002, in C-206/01.

²⁸ For a fuller handling of the issue see GALLI, *Nomi e segni distintivi dello sport tra merchandising e free riders*, in *AIDA*, 2003.

²⁹ ECJ, 7 January 2004, in C-100/02. The conflicting signs were the trade mark «Gerrri», for a German mineral water of Gerolsteiner Brunnen, and the name «Kerry Spring», again for a mineral water from the spring of the same name in the County of Kerry (Ireland).

³⁰ In this regard the ECJ stresses that national courts must «carry out an overall assessment of all the relevant circumstances», including the context in which the trade mark is used (point 26 of the decision, which in relation to the specific case examined includes among these elements in particular «the shape and labelling of the bottle»).

said use gives rise to a *«likelihood of confusion for the public, which may also consist in a likelihood of association»* with the earlier trade mark, or rather, if this trade mark has a reputation – as is usually the case with trade marks in the sporting and cultural fields (with respect to which the claim of descriptive use is frequently invoked) –, to one of the two situations of «linkage» under Art. 5.2 of the Directive.

5. The ECJ has also dealt with the **relationship between the trade mark and a personal name**, in a case regarding the UK Trade Mark Office's refusal to grant a name trade mark, on the simple grounds that the surname in question was quite widespread. The ECJ stated that *«The distinctive character of a trade mark, in whatever category, must be the subject of a specific assessment»* (point 27 of the decision), and that the particular difficulty of assessing certain categories of trade marks *«cannot justify the assumption that such marks are a priori devoid of distinctive character or cannot acquire such character through use, pursuant to Article 3(3) of Directive 89/104 »* (point 29)³¹.

This ruling is also important because the ECJ confirmed – with regard to a trade mark consisting in a name – its position on **also checking whether or not the requisite of distinctive character does exist**, rather than only whether it *does not* exist, in relation to bars on the registration of signs in common use and those constituted exclusively by the generic name of the goods or services for which the trade mark has been registered or by a descriptive indication relating to them, as was usual in Italian case law and legal theory.

When, however, the Court has gone from pronouncing the principles to applying them (also within the limits of cognisance of pure law which it has, or should have, even when examining appeals against decisions of the Court of First Instance), the results have not always been consistent. Thus, in one case (regarding a telecommunications mark) the decision of the EU Court of First Instance was overturned on the grounds that the fact that the individual components of the trade mark were devoid of distinctive character did not necessarily mean that the resulting syntagma also lacked distinctive character. This lack of distinctive character should thus have been specifically analysed³². In another two rulings, however, the Court – after confirming the **anti-monopolistic rationale of the bar on registration for signs constituted exclusively of descriptive indications** relative to goods or services for which they were registered, observing that *«this article pursues an aim that is in the public interest, which requires that signs and indications descriptive of the characteristics of goods or services in respect of which registration is sought may be freely used by all»*³³ –, stated that the bar also usually applies to new trade marks that are composed by the mere juxtaposition of two descriptive elements unless *«because of the unusual nature of the combination in relation to the goods or services, the word creates an impression which is sufficiently far removed from that produced by the mere combination of meanings lent by the elements of which it is composed, with the result that the word is more than the sum of its parts»*³⁴.

With regard to **colour and shape marks**, the ECJ has substantially confirmed – with some significant further examination – its previous decisions. In particular, as regards the distinctive nature of these kinds of marks, the ECJ has stressed that *«The criteria for assessing the distinctive character of three-dimensional marks consisting of the shape of the product itself are no different from those applicable to other*

³¹ ECJ, 16 September 2004, in C-404/02. The trade mark was «Nichols».

³² ECJ, 16 September 2004, in C-329/02 P. The trade mark was «SAT.2», and in the grounds to its decision the Court stressed that «The frequent use of trade marks consisting of a word and a number in the telecommunications sector indicates that that type of combination cannot be considered to be devoid, in principle, of distinctive character » (point 44 of the decision).

³³ ECJ, 12 February 2004, in C-363/99 and ECJ, 12 February 2004, in C-265/00, respectively points 55 and 35.

³⁴ ECJ, 12 February 2004, in C-363/99, *cit.* and ECJ, 12 February 2004, in C-265/00, *cit.*, respectively points 98 and 41. The two decisions also stated that «whether or not there are synonyms permitting the same characteristics of the goods or services to be designated» (respectively points 101 and 42) has no bearing on establishing whether or not the bar applies. The first also stated that it is not possible to limit registration regarding certain goods or services, excluding those which possess determinate characteristics described by the trade mark, since this could result in uncertainty as to the scope of protection of the trade mark (points 111-117).

categories of trade marks», «Nonetheless, for the purpose of applying those criteria, the **relevant public's perception** is not necessarily the same in the case of a three-dimensional trade mark consisting of the shape of the product itself as it is in the case of word of figurative mark (...). **Average consumers are not in the habit of making assumptions about the origin of products on the basis of their shape or the shape of their packagings**: to conclude that «the more closely the shape for which registration is sought resembles the shape most likely to be taken by the product in question, the greater the likelihood of the shape being devoid of any distinctive characters», and that, therefore, «only a mark which departs significantly from the norm or customs of this sector and thereby fulfills its essential function of indicating origin is not devoid of any distinctive characters». This character may, what is more, «be acquired, inter alia, after the normal process of familiarising the relevant public has taken place»³⁵, i.e. in practice, through the **rehabilitation** process regulated by Art. 3.2 of the Directive and in Italy by articles 19 and 47-bis Trade Mark Law.

The Court also examined the problem of establishing whether or not a valid shape trade mark could have **other functions**, apart from a distinctive function and therefore of establishing whether the limited technical or ornamental character of a shape is compatible with its protection as a trade mark. However, the problem, raised by the party appealing against a decision of the EU Court, was held to be irrelevant in the case in question and thus remained unexamined, given that the trade mark in question was held to be devoid of distinctive character and this fact overrode the claim in justifying refusal to award protection³⁶.

At the end of 2003, the ECJ also examined **sound trademarks**, in relation to the question of whether or not they could be reproduced graphically. The trade marks examined were constituted by the first notes of the «Für Elise» sonata by Ludwig van Beethoven and a cock crow, both registered (and used) to designate consultancy services in the communications field. However, of the fourteen trade marks filed (ten for the former, four for the latter, which differed from each other only in the various ways in which the two sounds, which the trade marks aimed to protect, were represented graphically) the Court held that only one – constituted by transcription onto a stave of the first notes of the sonata, including indications as to key and pauses – could provide a «**clear, precise, self-contained, easily accessible, intelligible, durable and objective**» reproduction of the sound (point 62 of the decision) and was thus consistent with Art. 2 of EEC Directive 89/104.³⁷ The Court gave an extremely **rigorous** interpretation of this article, in line with the stance which had emerged a year before with regard to olfactory trade marks³⁸.

This interpretation seems, however, to be open to criticism since it ends up excluding from registration signs which are undoubtedly distinctive (the cock crow for consultancy services in the communications field is no less able to identify the provider of services than the notes of «Für Elise») and is equally undoubtedly able to be recognised and identified with precision even on the basis of a simple description. No-one, for example, hearing the roar of a lion at the beginning of a film is in any doubt that Metro Goldwin Mayer is being referred to. At least in Italy, there does not seem to remain any doubt that imitation leading to the likelihood of confusion of a sound trade mark of this kind may be qualified as an **act of unfair competition** at least on the basis of the final clause of Art. 2598, no. 1 Civil Code (which sanctions the conduct of whoever «*carries out with any other means acts which create confusion with the goods and with the activity of the competitor*») and to the analogous conclusion it seems likely to add also in the presence of an imitation which only links itself to the trade mark of the competitor, on the basis of Art. 2598, no. 2 Civil Code. In this situation it seems that a **revision**

³⁵ Thus, with particular clarity, ECJ, 7 October 2004, in C-136/02 P («Mag»), points 30, 31 and 47. The last point had already been made, with specific reference to colour trade marks, by the ECJ, 6 May 2003, in C-104/01 («Libertel»), and has been confirmed this year, again with reference to colour trade marks, by the ECJ, 24 June 2004, in C-49/02; the former are to be found, what is more, in ECJ, 12 February 2004, in C-218/01, in ECJ, 29 April 2004, in the joined proceedings C-456/01 P and C-457/01 P and in ECJ, 29 April 2004, in the joined proceedings C-473/01 P and C-474/01 P.

³⁶ ECJ, 23 September 2004, in C-107/03 P.

³⁷ ECJ, 27 November 2003, in C-283/01.

³⁸ ECJ, 12 December 2002, in C-273/00, cited (and criticised) in GALLI, *Segni distintivi e industria culturale*, in *AIDA*, 2003.

of the above EU case law is to be hoped for, in a way which is more consistent with the basic rationale of the Directive.

6. The Court of Milan decided not to issue **an injunction against the publication and distribution of a periodical bearing a title which could lead to it being confused** with another periodical registered earlier, giving an extensive interpretation, which seems unjustified, of Art. 21 of the Constitution. This article does not admit the seizure of periodical publications, except *«in the case of crimes for which the law on the press expressly authorises it, or in the case of violation of the articles which the law itself provides for identification of the culprits»*³⁹.

The Court of Milan, however, dealt with a **delimitation agreement between the owners of potentially conflicting publication titles**. It held that the agreement was lawful on the basis of the exact consideration *«(of) the available nature of the exclusive right on a trade mark and (of) the compatibility with the legal system of the co-existence of trade marks belonging to different business persons»*⁴⁰.

7. With regard to **domain names**, a Court of Naples order must first of all be mentioned. It accepted and developed the idea expressed in legal theory whereby, if it is true that these marks are not exclusively telematic addresses but may have a distinctive function⁴¹, it is, however, equally true that they **are not always and necessarily trade marks**, and at any rate not always and necessarily business trade marks. In particular, the Court observed that if the applicability of distinctive signs laws (and in particular Trade Mark Law) to domain names is certain in relation *«to domain names used – directly or indirectly – in the business and advertising sector»*, there are also, however, *«numerous sites (which) belong to public or private non-commercial institutions (bodies, associations ...), or to persons or groups, and which lack commercial value, so that same «may not be considered subject purely and simply to the law on distinctive signs and therefore to Trade Mark Law»*⁴².

The same point was stressed by the Court of Bergamo (in a decision to which we shall return), which observed that *«the domain name may not be considered as having a single qualification, and instead the **concrete situation must be analysed**, in that – according to the circumstances of the case and taking into account the content and placing of the site – the domain name may rightly be equated with a (business) trade mark, if the site is of a commercial nature; if ... it is used not to access a commercial site and therefore not with the function of identifying an economic activity, but rather of **transmitting opinions and ideas**, the rationale underlying the equating of domain names and business trade marks in no way holds»*⁴³.

The Court of Naples, in the above ruling, went further in observing that these **«civil» or non-commercial domain names** may conflict with other business trade marks, in that all domain names have *«an advertising function, so they potentially have a detrimental effect on the other's business and economic interest»*⁴⁴. This last point is debatable. In fact, it is, on the other hand, true that advertising normally comes under Art. 41 of the Italian Constitution regarding freedom to undertake an economic activity (which may run into limits), and not Art. 21, regarding freedom of expression

³⁹ Court of Milan, interim order 3 June 2004, in *AIDA*, 2004. In the case in question, however, the Court also ruled out the likelihood of confusion of two conflicting titles («Pavia Pavia Eco & Co. Notizie» and «Pavia Vigevano Voghera»). As regards the admissibility of the injunction on the use of the title held to lead to confusion (and instead of the non-admissibility of seizure of the publication, the latter precluded by virtue of Art. 21 of the Italian Constitution) see the Court of Rome, interim order 5 February 2003, in *Dir. inf.*, 2003.

⁴⁰ Court of Milan, interim order 26 March 2003, in *Giur. ann. dir. ind.*, 2003.

⁴¹ This point may now be considered indisputable: among the most recent decisions in this sense see Court of Bari, interim order 1 July 2002, in *Giur., ann. dir. ind.*, 2003, interesting also because the Court of Bari had stated the contrary in the first Italian order published on domain names (Court of Bari, interim order 24 July 1996, which can be read in GALLI, *I domain names nella giurisprudenza*, cit., no. 1). See also Court of Naples, 20 December 2002, in *Giur. ann. dir. ind.*, 2003.

⁴² Court of Naples, 13 March 2003, *cit.*...

⁴³ Court of Bergamo, 6 March 2003, in *Dir. inf.*, 2003; and in *Corr. giur.*, 2004.

⁴⁴ Court of Naples, 13 March 2003, *cit.*. In the sense that «registration as a domain name of another's original business name to designate a site used not for commercial purposes, but for generally humanitarian purposes is unlawful» see Court of Rome, interim order 24 November 2003, in *AIDA*, 2004.

(which is much more extensive), and thus may well come within the scope of protection of trade marks. It does not seem, however, that the mere advertising potential of the message on Internet suffices for this qualification.

The Court of Bergamo decision mentioned a little earlier involved a dispute relating to the **very famous surname of a fashion designer** (also one of the most famous trade marks in Italy), registered and used as a domain name by **a party having the same name**, for a site presenting the services of the one-man business of the latter, who worked in a completely different economic sector. This abyss between the two sectors convinced the Court that there **was no likelihood of confusion**, and that there was thus no possibility of the «traditional» type of infringement, such as unfair competition due to the likelihood of confusion. However, the domain name was found to be infringing under Art. 1(1) (c) Trade Mark Law, since it could enable the user to gain an **undue advantage** – causing him to «*become extremely famous*» –, and cause **detriment** to the company owning the mark – «*stopping same using its mark as a domain name followed by ‘it’*». The fact that the domain name was the same as the surname of the entrepreneur was not held to make this use lawful under Art. 1-*bis* Trade Mark Law (corresponding to Art. 6.1 of EEC Directive 89/104), as the Court stated that in the case in question, involving a business web site, «*the use of the mark in question as a domain name constitutes a form of use of that mark with the function of a trade mark*»⁴⁵.

In relation to this decision it is worth stating – obviously regardless of any assessment of the case – that, if the legal considerations concerning undue advantage and detriment correspond substantially to the positions taken in legal theory⁴⁶ and if there is some specific precedent in case law⁴⁷, we must ask ourselves whether there is not a **justified motive** for this use, in relation to the fact that the parties in conflict were already owners on the market of valid similar trade marks⁴⁸; and to observe, again, that excluding application of Art. 1-*bis*, paragraph 1 Trade Mark Law may no longer today be justified on the basis of the simple fact that the name was used as a trade mark, after the ECJ decision on this point, already discussed many times⁴⁹.

The Courts of Bari and Trento have ruled on conflicts between domain names and marks. The courts, after stating that **the presence of the geographical top level «.it» was completely irrelevant**, held that the imitated mark and the domain name, which differed from the former only in this feature, were **identical**, for the purposes of Art. 1(1) (a) and (b) Trade Mark Law⁵⁰.

The Court of Bari, in the above ruling, and the Court of Naples have ruled **the mere registration as a domain name of a mark which is the same as another's mark unlawful**. The first, as was stated previously⁵¹, took this decision in consideration of the peculiar way of accessing the Internet⁵² whereas the second ruled on the basis of the «**bad faith**» of the registrant who had

⁴⁵ Court of Bergamo, 6 March 2003, *cit.*. The sylest was Giorgio Armani (his company bearing the same name is the owner, amongst other marks, of the mark «Armani») and the disputed domain name was «armani.it», registered by the one-man business Timbrificio Luca Armani.

⁴⁶ In this regard, see again GALLI, *I domain names nella giurisprudenza, cit.*, pp. 49-50 and 52-55.

⁴⁷ For detriment consisting in stopping registration of the famous mark as a domain name see, in particular, Court of Genova, interim order 17 July 1999, Court of Rome, interim order 22 December 1999 and Court of Parma, interim order 22 January 2001, all published in GALLI, *I domain names nella giurisprudenza, cit.*, nos. 26, 29 and 70; for advantage consisting in the greater visibility of the site bearing the domain name corresponding to another's famous trade mark, see Court of Naples, interim order 8 January 2002 and (at the appeal stage of the same dispute) Court of Naples, interim order 19 February 2002, in *Dir. inf.*, 2002.

⁴⁸ The Court of Vicenza, interim order 9 November 2000, in *Giur. ann. dir. ind.*, 2001 and (at the appeal stage) Court of Vicenza, interim order 8 February 2001, have stressed this aspect. Again both can be read in GALLI, *I domain names nella giurisprudenza, cit.*, no. 74.

⁴⁹ ECJ, 7 January 2004, in C-100/02, *cit.*

⁵⁰ Court of Bari, interim order 1 July 2002, *cit.*, and Court of Trento, 15 January 2003, in *Giur. ann. dir. ind.*, 2003. In the same sense see also Court of Pistoia, interim order 15 October 2001, in *Giur. ann. dir. ind.*, 2002.

⁵¹ above, paragraph 1.

⁵² Court of Bari, interim order 1 July 2002, *cit.*

adopted as a domain name the name of a theatrical show organised by other parties⁵³ (in this case too it might have been possible to use the bar on exploitation as a mark famous names in a non-commercial field, provided under Art. 21 (3) Trade Mark Law).

The use of another's mark as a *metatag* has also been deemed illicit by the Court of Naples *«in that one enjoys the reputation of the mark capturing public attention in a parasitic fashion»*⁵⁴. With regard to measures which may be taken at the interim stage of proceedings against infringement of a trade mark through the Internet, see Court of Bari, which ruled that it could enjoin the allegedly unlawful use but could not order the cancellation of the infringing domain name, as this is *«a measure which involves in some way definitive effects, as such exclusively within the remit of proceedings into the merits»*⁵⁵. Again on the procedural plane, see Court of Bolzano which ruled that **not only the party which registered the disputed domain name but also the party using it could be sued** in trade mark infringement proceedings⁵⁶.

Finally, on the **liability of the provider** the Court of Catania has applied the new regulation introduced by Legislative Decree 9 April 2003, no. 70, in implementation of EC Directive no. 31/2000 regarding some aspects of the services of information companies in the domestic market, with particular reference to e-commerce. The Court of Catania interpreted these articles as meaning that they make of the *Internet Service Provider* *«a subjective liability: culpable if the supplier of the service, aware of the presence on the site of suspect material, fails to ascertain whether or not it is unlawful and remove it; fraudulent when he is also aware of the unlawfulness of the agent's conduct and fails to intervene»*⁵⁷.

CESARE GALLI

ABOUT US

✓ *The Commission of Production Activities of the Chamber of Deputies calls Professor Cesare Galli as one of the experts giving their opinion on the new IP Code*

Professor Cesare Galli was called by the Parliamentary Commission of Production Activities of the Chamber of Deputies as one of the experts giving their opinions on the new IP Code. Professor Galli was heard in the course of a session held on 22 November 2004, and on that occasion, in addition to giving some general considerations, he illustrated a series of proposals for revision of the

⁵³ Court of Naples, interim order 26 March 2004, in *Foro it.*, 2004. The name of the show (which was protected as an unregistered trade mark) was «Veliateatro».

⁵⁴ Court of Naples, 20 December 2002, *cit.*.

⁵⁵ Court of Bari, interim order 1 July 2002, *cit.*. The Industrial Property Code is also destined to affect this point too. Art 133 now provides that the «provisional transfer» of the unlawfully registered domain name may be ordered at the injunction stage of the proceedings, «making it conditional, if believed necessary, upon the payment of an adequate deposit by the beneficiary of the order». See for more details the first section of this Newsletter.

⁵⁶ Court of Bolzano/Bozen, Brunico/Bruneck Division, 30 August 2003, *cit.*...

⁵⁷ Court of Catania, 29 June 2004, in *AIDA*, 2004.

provisional text of the Code.

Many of these proposals were **accepted by the Commission**, which included them in its Official Opinion on the Code, and were then partially **accepted by the Government** in the final draft of the Code, as is described in more detail in the first section of this Newsletter.

*** **

✓ *Recent IP decisions obtained by our firm*

Misleading advertising

The Court of Varese, in its decision of 12 October 2004, acquitted two well-known mechanical companies of Varese, represented by our firm, of the charge of unfair competition due to misleading advertising in relation to their using the expression «patented» in an advertisement for goods for which a patent application had been filed but as yet no patent granted. The Court – which had already rejected the plaintiff's request for an interim injunction on the grounds that the requisites for an emergency measure did not hold – ruled that this advertisement did not mislead its target (other businesses in the field). The full text of the decision may be read in the “*The Case*” section of this Newsletter.

The specialised press also covered the Court of Varese decision. A long commentary article was published in the financial newspaper *Italia Oggi*.

*** **

Patents for computer implemented inventions

Our firm recently represented a leading Italian software company in arbitration proceedings brought against it with regard to a **licence agreement for a patent for a computer implemented invention and the software required for its implementation**. The Arbitration Panel first of all rejected the opponent's objections regarding the validity of the patent and then disregarded the claim for damages of € 1.000.000 against our client for an alleged non-performance of the agreement.

This award (filed on 6 December 2004) is the first Italian judicial order to recognise – albeit without any particular deep analysis of the subject – the **validity** of a patent for this kind of invention which is still relatively new in Italy.

*** **

Interim injunctions against the retailer of counterfeit goods

The Court of Milan, applied to for an interim injunction for **patent infringement**, accepted, in its order of 16 December 2004, the plaintiff's petition only against the producer of the goods alleged to be counterfeit, rejecting its petition against the firm selling the goods (a leading Milanese lighting firm, represented by our firm).

The Court accepted our defence which refuted the existence of the *periculum in mora* required for granting an interim injunction, laying stress on the fact that the retailer no longer had the disputed goods and had unilaterally undertaken to no longer buy or sell them. The Court held that, with respect to the firm selling the goods these facts «**lead one to deem that the unlawful act attributed to it no longer has any effect and that there is no risk that the act will be repeated and therefore the petition is rejected**».

*** **

✓ *Our latest publications and conventions*

This year too an essay by Professor Cesare Galli will appear in the review *Annali Italiani del Diritto d'Autore*, volume 2004 soon to be published, entitled *Segni distintivi e industria culturale* (Distinctive signs and the culture industry) and dedicated to the examination and brief commentary of the principal Italian and EU trade mark decisions issued during the year in relation to their effect on the

culture industry (a full summary of this essay may be read in the “*The Article*” section of this Newsletter).

Another essay by Professor Cesare Galli on *I domain names in Italia: le novità* (What’s new on domain names in Italy) is currently being printed among the publications of the Master’s Degree in Law, Economics and Information Technology of the University of Camerino.

A new edition of the essay by Professor Galli *Le invenzioni biotecnologiche e gli organismi geneticamente modificati* (Patents on Biotech Inventions and GMOs) has appeared in the *Occasional Papers* of the Istituto Bruno Leoni.

A full comment by Professor Galli to the IP Law Code has been published in the financial newspaper “*Italia Oggi*”.

An interview with Professor Galli on the evolution of law firms in the IP field in Italy has appeared in the Italian legal magazine “*Top Legal*”, issue no. 2.

*** **

As Coordinator of the Trade Marks Group of the Italian section of **A.I.P.P.I.** Professor Cesare Galli has also drawn up, together with other members of the group, the Italian Report on **Question Q 188** dedicated to ***Conflicts between Trademark Protection and Free Speech***.

*** **

On 26 January 2005 Prof. Galli was one of the two speakers at the study day on the **Nuovo processo di Diritto industriale (Innovations in Italian Procedural Law in the IP field)** organised in Milan by AICIPI (Associazione Italiana dei Consulenti in Proprietà Industriale – Italian Association of IP Consultants)

On 11 February 2005 Professor Galli spoke on the *Patentability of Software and Computer Implemented Inventions in Europe: Problems and Perspectives* at the International Convention on ***Interoperability in the Digital World: Open Standards, Open Source, Property Rights and Markets*** organised in Milan by The Progress & Freedom Foundation and the Istituto Bruno Leoni (the slides of Professor Galli’s paper – in English only – may be requested at the email address indicated below)

On 15 February 2005 Professor Galli presented a paper on *L’impatto del TRIPs Agreement sulla liberalizzazione del commercio internazionale* (The effects of the TRIPs Agreement upon international free trade) at the Italian presentation of **The 2005 Index of Economic Freedom** edited by The Heritage Foundation and The Wall Street Journal

On 28 February 2005 Professor Galli spoke on *La «nuova» contraffazione tra diritto civile e diritto penale* (The “new” trade mark infringement, between criminal and civil protection) at the Convention on **Tutela penale della Proprietà Intellettuale (Criminal Protection of Intellectual Property)** organised in Milan by INDICAM

On 7 March 2005 Professor Cesare Galli will spoke at the Convention on **the new Italian Code of the Industrial Property Rights** organised in Milan again by INDICAM

*** **

The Abstracts of the Papers presented at the National IP Law Convention ***L’invasione dei falsi: la difesa dei prodotti originali nel mercato globale contro le contraffazioni e la pirateria*** (The invasion of copy products. Protection of original products against piracy and infringement in the global market), held on 8 October 2004 at the University of Parma in collaboration with SISPI and chaired by Professor Cesare Galli are still available. At this Convention he gave two papers, dedicated respectively to *Marchi, forme, denominazioni di origine: la tutela contro il parassitismo commerciale* (Trade marks, product shapes and appellations of origin: protection against parasitical exploitation) and to *Strategie per reagire alle contraffazioni che interessano più Paesi europei* (Strategies to tackle cross-border infringements in Europe).

IP_LAW_GALLI Newsletter

If you would like to receive these Abstracts (in Italian only), or further information on this and other Conventions mentioned, please send a message to GALLI.PR@IPLAWGALLI.IT.

© 2005 BY AVV. PROF. CESARE GALLI STUDIO LEGALE MILANO-BRESCIA-PARMA

AVV. PROF. CESARE GALLI

PROFESSORE ORDINARIO DI DIRITTO INDUSTRIALE NELL'UNIVERSITÀ DI PARMA

STUDIO LEGALE

MILANO-BRESCIA-PARMA

DIRITTO INDUSTRIALE

(BREVETTI, MARCHI E DOMAIN NAMES,
CONCORRENZA SLEALE, ANTITRUST,
DIRITTO D'AUTORE), CONTRATTI
E DIRITTO COMMERCIALE GENERALE

IP LAW

(PATENTS, TRADEMARKS AND DOMAIN NAMES,
UNFAIR COMPETITION, ANTITRUST LAW,
COPYRIGHT), CONTRACTS AND
GENERAL COMMERCIAL LAW

BRESCIA

VIALE VENEZIA, 44
I-25123 - BRESCIA -
ITALY
TEL. +39.030.3756773
FAX +39.030.3756773
E-MAIL:
GALLI.BS@IPLAWGALLI.IT

MILANO

VIA LAMARMORA, 44
I-20122 - MILANO - ITALY
TEL. +39.02.54123094-
54124344
FAX +39.02.54124344
E-MAIL:
GALLI.MI@IPLAWGALLI.IT

PARMA

VIA FARINI, 37
I-43100 - PARMA - ITALY
TEL. +39.0521.282210
FAX +39.0521.208515
E-MAIL:
GALLI.PR@IPLAWGALLI.IT

WWW.IPLAWGALLI.COM

For further information or to contact us write to the above addresses or visit our website:

WWW.IPLAWGALLI.COM
