

IP_LAW_GALLI *Newsletter*

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RECENT DEVELOPMENTS IN ITALIAN IP LAW

- ✓ ***The «anti-infringement package» examined by Parliament. Renewal of the delegation for revision of the CIP also under appraisal***

In Commission X of the Senate of the Italian Republic, before which Bill AS 1644 (better known as the «Bersani-ter Law») was examined, a series of **amendments and sub-amendments** were submitted. These are truly cross-party, having been signed both by the Government and by

individual senators belonging to the majority and to the opposition, often in the same text. They are aimed at **updating (substantive and procedural) criminal rules in infringement matters and at renewing the delegation for CIP revision.**

Senator Polledri dedicates a specific sub-amendment to this revision. It provides that the Government be «*delegated to adopt, by 30 December 2008 and subject to the opinion of the competent parliamentary commissions and the High Commissioner for the Fight against Infringement, regulations which correct or make additions to Legislative Decree no. 30/2005 (CIP), according to the following criteria: 1) correct material errors and coordination faults in the Code; 2) strengthen and improve the effectiveness of the protection of IP rights, in particular against parasitism, including at procedural level, also inserting an express rule relating to the pre-requisites for protection of non-registered trade marks and to the discipline regulating such marks; 3) harmonize the regulations with EU and international legislation on the protection of biotech inventions; 4) introduce instruments which simplify and reduce administrative red tape; 5) provide that in cases of inventions realized by researchers at universities or other public research bodies, the university or administration shall implement the patenting procedure, acquiring the relative right on the inventions*». These criteria would allow retrieval of the work already carried out by the Commission of Experts, one of whose members was Professor Cesare Galli, at the Ministry of Productive Activities in the previous legislature. This work did not simply correct material errors to be found in the Code but was a revision proper, aimed at bringing together the various regulations to form a coherent system. These regulations protected IP rights against **parasitical exploitation** by non-authorized parties in such a way as to make protection against parasitism – not by chance expressly referred to in the new delegation – one of the mainstays of the Code.

The **new criminal rules** in the amendments (and, above all, in a number of sub-amendments) would, in turn, place at the disposition of the competent authorities instruments which are often indispensable in effectively combating infringement. **Undercover operations** could be carried out without the need for associated crimes (as is the case today) and telephone interception used (made possible by an **increase in the maximum prison sentence for infringement to six years**, which would also mean that the time-bar on prosecuting such crimes would kick in later). An express and cogent criminal rule would be introduced in cases of agricultural **denominations of origin** and trade marks, where health protection issues are also considered, and the **administrative sanction for end-users of counterfeit goods who know them to be counterfeit** would be determined in an amount socially acceptable, thus facilitating application and transforming a hitherto theoretical regulation into an efficacious instrument for tackling infringement at the final stage of the market. One of the sub-amendments is also dedicated to the **structure of the High Commissioner's offices**, aiming to make it more streamlined and hard-hitting in dealing with new infringement phenomena.

These regulations, a real «**anti-infringement package**», are essentially the result of work carried out by Giovanni Kessler, the High Commissioner for the Fight against Infringement, assisted by a group of experts, including in particular Professor Cesare Galli and Riccardo Castiglioni, who **presented the rules of the package** during an **international conference** in Rome at the beginning of December organized by the High Commissioner.

These amendments and sub-amendments were due to be discussed in February 2008. However, the fall of the government and the early end of the legislature caused that yet once more we shall have to wait for the new rules to be introduced.

✓ ***EPC 2000 ratified in Italy : new rules for European patents***

A few days before the final deadline for ratification, the Italian parliament passed Law 29 November 2007, no. 224 (Official Gazette of 3 December 2007) **ratifying EPC 2000**. This convention significantly updates the European Patent Convention. Ratification was a real race against time, complicated by a difficult political period and some failure to comprehend the real importance of the convention which was overcome basically thanks to awareness raising work conducted by representatives of the Intellectual Property Order, of the Board of Advisors, of A.I.C.I.P.I. (Italian Association of IP Consultants and Experts) and *Confindustria*. They also met the

Italian Foreign Affairs Minister in order to explain to him the serious consequences for businesses and Italian consultants should EPC 2000 not be ratified in time. Giovanni Kessler, the High Commissioner for the Fight against infringement, pressed by Professor Cesare Galli, also intervened on this matter with the competent bodies.

✓ *Implementation in Italy of EC Directive 2005/29 on unfair commercial practices*

Italy, too, has implemented EC Directive 2005/29 on unfair commercial practices. The Directive was implemented by means of **two legislative decrees**, in itself a questionable legislative technique, issued on the same day, 2 August 2007. One of these (no. 146/07) replaced articles 18 to 27 of the Consumers' Code (Legislative Decree 6 September 2005, no. 206), whilst the other (no. 145/07) laid down corresponding rules for relations between professionals. This was entirely superfluous since, even prior to this reform, there was no doubt that laws on misleading and comparative advertising also applied to relations between professionals, even though these laws, originally provided in Legislative Decree no. 74/92 and subsequent modifications, were incorporated in the Consumers' Code.

Compared to the earlier text, the new rules **list a series of proscribed practices**. However, there was never any question before that such practices were unlawful, at least for what concerns unfair competition. The main novelty of the new law seems, therefore, to be the possibility now offered of **tackling such practices also using administrative measures**, submitting them to the Competition and Market Authority.

✓ *Ministerial Decree 3 October 2007 introduces prior art searches for Italian patents, making the EPO the competent authority for conducting such searches, but also contains a questionable rule on lapse*

On 3 October 2007, the Minister for Economic Development issued a Ministerial Decree on patent law. Alongside rules of a procedural nature – and, in particular, those concerning a number of formalities which Italian and foreign universities and public research institutes have to carry out in order to benefit from the exemption on paying fees (art. 2) and that which allows the Italian Patent and Trade Mark Office to enter into agreements with *Poste Italiane s.p.a.* to allow large scale online payment of the fees by the holders of registrations and patents (art. 4) –, there is a provision that makes the **EPO** the competent authority for conducting **prior art searches** concerning Italian patents (previously Italian patents were granted without prior examination of novelty), the declared aim being to strengthen same (art. 1, which, moreover, postpones implementation of the rule to a subsequent agreement to be entered into between the Italian Patent and Trade Mark Office and the EPO).

However, another rule of a more substantive nature has also been inserted (art. 3). It provides for «**lapse of an IP right**» should there be a «**delay in the fifth yearly payment for industrial invention patents (and) of the second five year period for utility model patents and for the registration of designs or models**» and «*non or late presentation of a petition for extension under art. 238 of Legislative Decree no. 30/2005, relating to the second five year period of designs and models*», stipulating that in such cases revocation begins «*from the date on which the relative application is filed*». There is actually **nothing really new** in these situations being a cause for revocation. The first (non-payment of the annual fees for maintaining the patent, or rather a delay of over six months in making said payment – it is clear that, despite the decree's imprecision in this regard, it is inconceivable to think of sanctioning now with revocation any delay, even one of less than six months) was already expressly provided as a cause of revocation by art. 75 C.I.P., also applicable to models (with regard to the five year fee relating to the second five year period of same) by virtue of the recall contained in art. 86 C.I.P. **Strictly speaking there is not even any need to speak of lapse for designs and models**, given that the mechanism provided for same is that of a basic duration of five years, extendable every five years up to a total twenty five years at the request of the applicant (and of fifteen years extendable for another two five year

periods again up to a total of twenty five years for models prior to the 2001 reform, to which art. 238 C.I.P. refers). However, what is completely new – and in fact **subversive** of the present system – is the stipulation that in these cases «lapse» comes into effect **«from the date of filing the relative application»**.

It is, in fact, a **general principle** in matters of lapse of IP rights – and serves to distinguish this institute from that of nullity – that **lapse comes into effect from the moment in which the situation giving rise to lapse takes place**. The same (exceptional) regulation which provides for the original loss of the invalidating capacity for revoked trade marks and for those which have expired by more than five years is considered by Italian legal theorists to be a cure of the original nullity due to lack of novelty of the subsequent trade marks. In particular, in matters of patent lapse (and of utility models lapse, due to the already cited recall) for non-payment of the annual maintenance fees (five-yearly for models), art. 75.4 C.I.P., expressly states that *«a patent is understood to have been lapsed with regard to anyone from the end of the final year for which fees were paid»*. The secondary regulation nature of ministerial decrees obviously means that they cannot prevail over primary regulations. The regulation now introduced, therefore, seems clearly **unlawful and without effect**, and as such shall not be **applied** by the Courts without the need for further intervention on the part of the legislator. It still remains as an example of the errors which may be committed if experts are not consulted when new regulations are being drafted.

✓ ***The Senate approves a Bill to reintroduce the Company Procedure for IP cases***

On 16 January last the Senate approved a Parliamentary Bill (A.S. 1609, now being examined by the Lower House), signed by Senators of both political wings, which **would reintroduce** the so-called Company Procedure **for IP cases**. This is regulated by Legislative Decree 5/2003 and had ceased to be applied to the IP sector following a decision of the Constitutional Court (no. 170 of 17 May 2007, published in the Official Gazette of 23 May 2007) which ruled that application of the procedure to this field was unlawful, deeming that the article of the C.I.P. (Legislative Decree 30/2005) which provided for it had gone beyond the delegation granted to the Government to re-organize IP legislation, on the basis of which the Code had been introduced.

It is, however, common knowledge that the so-called Company Procedure has not given a good account of itself either in the IP field or more generally in the cases to which it has been applied. In fact, the special procedural discipline provided by Legislative Decree 17 January 2003, no. 5, better known as the «Company Procedure», gives rise to **notable complications in cases involving a number of parties** (anything but uncommon in the IP field) and, in any case, the need to **exchange often superfluous briefs**. Under the procedure the parties, after service of the Writ of Summons and submission of the defendant's entry of appearance, containing any counterclaims, may exchange further briefs which run the risk of being costly and pointless. Each party may bring an end to this exchange simply by not replying to its opponent's brief and asking the Court (which until this moment has not examined the case papers and, therefore, cannot discover, for example, procedural errors undermining the case) to schedule a hearing. At this hearing, preceded by an exchange of final briefs, the necessary evidence may be gathered or an Expertise ordered (as usually happens in patent matters: this **therefore often also makes these final briefs superfluous**), after which the Court may decide on the merits of the case. However, for that purpose, if evidence has been gathered or an Expertise conducted, new final briefs must naturally be drawn up. A further drawback to this system is that neither party knows in advance for how long it will be allowed to submit documents and present evidence gathering motions, since this activity is stopped as soon as the other party submits its request that a hearing be scheduled and thus depends on that party. In cases involving a number of parties the exchange of briefs is even more complex, with varying deadlines for replying to the various parties and with each party only being able to reply to some of its opponents, to such an extent that proceedings are almost **ungovernable** in some cases.

These disadvantages are not counterbalanced by what could be the advantage of cases lasting

a shorter time. It was thought, at least initially, that this would be a natural consequence of following the procedure. However, the length of proceedings still hovers around the 2-3 years mark. In fact, proceedings can last as long as with the ordinary civil procedure which, following the **2006 reform**, concentrates all the preliminary activity of the proceedings, from confirmation that the evidence gathering stage of the proceedings had been duly started to any additions made to claims, into one single hearing, providing only for a threefold exchange of briefs between the parties, for the presentation of claims and pleas, submission of motions for evidence gathering and any reply to same, before the Court decides, at a second hearing, on admission of these motions. The ordinary civil procedure, moreover, **offers greater protection to foreign defendants**, who are given more time to prepare their case (150 days rather than the 90 days given to Italian defendants), while the Company Procedure gives 60 days to all defendants.

It must also be added that the Bill approved by the Senate lays down an interim system which would further complicate the situation, providing for a return to the Company Procedure for some cases begun on that basis, but converted (or destined to be converted) following the decision of the Constitutional Court. So it is certainly to be hoped that the Bill does not receive final approval. Mr. Kessler, the High Commissioner, has already taken action in this regard on the suggestion of Professor Cesare Galli.

THE CASE

✓ *Trade Mark protection extends to all forms of linkage: the decisive importance of consumer perception (Court of Milan, order 27 August 2007)*
– The text of the order and of the petition

In a decision of 27 August 2007 the Court of Milan ruled on the question of **infringement of trade marks by marks which are only partially similar** in a case in which the owner of one of the most famous Italian **swimming costumes and beachwear** marks, «**Pin Up Star**» (defended by our firm), reported infringement of the trade mark by a casual clothing producer using a similar mark. However, it was similar only to one part of the trade mark, a part which did not comprise all the «heart» of the trade mark, i.e. the characterizing part. Nevertheless the Court **granted the requested protection**, enjoining use of the mark and ordering **seizure** of the goods bearing the mark and the infringer's accounting books so that compensation and profit restoration could be assessed.

What is interesting about this decision is, firstly, that **more «formal» methods were discarded** in ascertaining likelihood of confusion. These are based on abstract and general characteristics (identification of the «heart» of the mark, identity or difference at a conceptual level, the extent to which the goods bearing the marks have a close product affinity). The decision, on the contrary, concentrated directly on the **consumer perception of the mark**, according to the settled case law of the ECJ, which has been proposing this criterion for years in order to resolve interpretative problems raised by EU legislation on trade mark matters (EC Directive 89/104 and the European Community Trade Mark Regulation). In this case, what was of particular importance was the fact that the two marks were used in the **fashion field**, in which it is common practice to launch «**second lines**» of famous trade marks, bearing marks which only reproduce one part of the characterizing features of the principal mark.

Equally noteworthy is that the decision ruled that **the likelihood of confusion also included the «linkage»**, i.e. use of a mark which is not sufficiently different to a famous trade mark brings to mind the latter. Protection against linkage is, in fact, the typical protection enjoyed by trade marks having a reputation, i.e. the most famous marks. This was unquestionably the case for the mark in suit (Pin UP Star) in its field. In the case in point, however, the Court disregarded the repute of the trade mark but still held that linkage was important as a form of confusion or association.

This confirms that, in reality, **the «traditional» likelihood of confusion is increasingly a past**

scenario, or at any rate a scenario which concerns less famous trade marks. The «new frontiers» of infringement, and thus also those of the protection of more famous marks (the «brands», as experts in economics and marketing prefer to call them), relate more to the forms of **parasitic exploitation of the «communication value»** of these marks by non-authorized third parties.

There follows the text of our petition and of the decision admitting said petition.

COURT OF MILAN

Specialized IP Division

Petition for injunction and seizure order

pursuant to articles 129 and 131 Legislative Decree 10 February 2005, no. 30

and 700 Code of Civil Procedure

On behalf of

Pin Up Stars s.r.l., with registered offices in Bologna, Via Porta Nova no. 3 (Tax Code 02366391205), in the person of its CEO and legal representative Mr. Jerry Tommolini, represented, by virtue of the power of attorney at the margins of this petition, by the attorneys-at-law Professor Cesare Galli and Mariangela Bogni and with elected domicile at their offices in Milan, Via Lamarmora no. 40

- petitioner -

against

Mr. Tiziano Sironi, owner of the sole proprietor business **Fashion Work**, with registered offices in Cesena (FC), Via Luciano Lama no. 62 (doc. 1);

Starlab Fashion s.r.l., with registered offices in Cesena (FC), Via Luciano Lama no. 62, in the person of its legal representative *pro tempore* (doc. 2);

and **Denim House s.r.l.**, with registered offices in Milan, Via Tartaglia 11 and showroom in Milan, Via Cevedale 7, in the person of its legal representative *pro tempore* (doc. 3).

- petitionees -

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The petitioner and the sector in which it operates

1.- The petitioner, Pin Up Stars s.r.l., is a firm operating in the **clothing** sector and, in particular, that of so-called women's **beachwear** (swimming costumes, wraps and cover-ups and other items of beach apparel and accessories), in which it is today one of the recognized leading firms on the Italian and international market, with an annual turnover, only looking at 2006, of over **8 million Euro**.

At the basis of this success is the creative genius of the designer Jerry Tommolini, who in 1995 (through **MI.TO. s.a.s. di Tommolini Jerry Joseph Junior & C.**) launched his first range of swimming costumes under the trade mark **Pin Up**, which later became **Pin Up Stars**. In particular, **Pin Up Stars** is well-known amongst the general public for the creation, production and sale of womens' top quality swimming costumes.

This extremely high quality, together with a continuous search for originality, which has allowed **Pin Up Stars** to frequently be ahead of its competitors and to dictate rather than follow fashion, has allowed the petitioner to achieve great success both with consumers – who include the leading names in the Italian and US entertainment world, amongst whom **Pin Up Stars** costumes enjoy the reputation of status symbol proper – and with buyers in the sector. In a 2004 survey carried out by the specialized review “Fashion”, buyers considered that the Pin-Up Stars collection of that year was

one of the most creative in the sector (doc. 4).

2.- The third ingredient in the success of **Pin Up Stars** and its mark has naturally been its determined branding policy into which the petitioner has invested significant resources, laying out **considerable sums for advertising**, not only in Italy but throughout the world. Its aim has been to make its trade mark known and create around it a **strong mark image**, symbolizing luxury and exclusivity. **Pin Up Stars** invested sums of 148.979 Euro in 2005 and 167.318 Euro in 2006 (doc. 5) only for advertising in the leading national and international **fashion magazines** (“Vogue”; “Elle”; “Vanity Fair”; “Marie Claire”; “Grazia” to name the most important).

Furthermore, over the years, **Pin Up Stars** has participated in all the main beachwear fashion shows, having its products endorsed by such **exceptional personalities** as **Natasha Stefanenko, Vanessa Kelly, Elisabetta Gregoraci, Nina Moric, Federica Fontana**, etc..

The principal national **television networks** (Raiuno, Raidue, Canale 5, Italia 1, Rete 4, La 7), have also given full coverage to **Pin Up Stars** products, with long broadcasts dedicated to **Pin Up Stars** fashion shows organized by leading Italian newspapers and fashion programs (doc. 6).

The result of all this entrepreneurial effort is the **extremely strong reputation of the Pin Up Stars mark on** both the Italian and international market (above all in the US where **Pin Up Stars** products are distributed by the huge “**Victoria’s Secrets**”) This has led to the label coming to be considered a **cult name** in the beachwear sector, being recognized by fashion critics as a “**top brand**” for Made in Italy products (doc. 7), and thus a **trade mark having a reputation par excellence**.

Pin Up Stars, well aware of the immense importance of fashion being backed up by brand, image and design, is holder of numerous IP rights including various Italian, EU and international trade marks. For the purposes of this petition the **EU denominative Trade Mark no. 2 057 750** (hereinafter, in brief, ‘750), filed on 26 January 2001 and registered on 4 February 2002 for class 25, relating to the expression “**PIN UP STARS**” (doc. 8) is focused on in particular.

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The unlawful conduct carried out to the detriment of the petitioner

3.- The rapid and constant rise of the “**PIN UP STARS**” mark, above amongst young women who pay a lot of lot of attention to their appearance, choosing items of clothing which are attractive and trendy, has however become, as unfortunately often happens with the most famous marks and innovative and successful design goods, an irresistible magnet for **imitators**.

Towards the end of last May, the petitioner observed in a shop in the Province of Forlì-Cesena (“**Abbigliamento Moda Giovane**” owned by Mr. Fabbri Paolo, in S. Egidio (FC) Via Cervese 1332), a number of “**casual**” **items of clothing** intended for the **younger market** (a vest and a pair of blue-jeans, both of **poor quality**, were bought by way of example: doc. 9), bearing the “**UPSTAR**” **trade mark**, evidently very similar to that of the petitioner.

In addition to being affixed to the goods, the trade mark was also clearly placed on the **labels** hanging from same and even on the plastic **bag** used to carry the purchased goods and on the **receipt** issued by the shopkeeper (see again doc. 9).

The petitioner also learnt from the label (which carried the website address of the opponent), that the producer of these articles of clothing was **Fashion Work**, a small **sole proprietor business**, also located in the Province of Forlì-Cesena. The petitioner had, until then, been completely unaware of this producer and it is perfectly clear why, given that it is an extremely small business and has made **virtually no advertising**.

The only “external” presence of **Fashion Work** is, in fact, the above “**amateurly put-together**” **website**, opened only a few months ago with the domain name **www.upstar.it**, again very similar to

the petitioner's mark. The site is composed of **one single page** which **does not even show the opponent's products**, simply giving the names of those who are the apparent **retailers** ("dealers" to use the opponent's expression) of these products, accompanied by the image of a young, beautiful girl (doc. 10), an image which strengthens the link in the consumer's mind with the much more well-known mark **Pin Up Stars**.

4.- The petitioner has learnt that **Fashion Work has been stepping up its activity in these past few months**. In particular, although the most important of these "dealers", **Gruppo FV Massa**, indicated as a retailer for Lombardy, is not yet selling the "UPSTAR" articles, it intends to do so starting from the Autumn-Winter 2007 season, with goods being delivered in the next few weeks. A Pin Up Stars employee contacted the showroom of the Lombardy retailer indicated on the site, describing herself as a shopkeeper interested in "UPSTAR" articles. She was told that the articles in question were not yet on sale in Lombardy but would be from next September (on this point see the statement given by Gianna Maria Fantinelli, doc. 11, who, if it is considered necessary, may also be heard by the Judge).

This is confirmed by the fact that Gruppo FV Massa has in the meantime **already begun to use this trade mark in advertising on the website www.gruppofvmasse.com** (doc. 12; there is a link between the "UPSTAR" logo shown on this site and the **Fashion Work site**), a site which is controlled by one of the companies of the group (**Denim House S.r.l.**, with registered offices in Milano Via Tartaglia 11: doc. 3), the owner of the Milan showroom, Via Cevedale n. 7 and, according to the information on the website, the principal agent of the group's agency and representation agreements.

Instead, a Sicilian "dealer" (the only other player whose activity it has been possible to monitor, as all checks on the others have so far proved fruitless), again indicated on the **Fashion Work** website, does not even show the opponent's mark on its website **www.studioar.info** (doc. 13).

5.- The facts as recounted so far make for easy interpretation of the "business decisions" made by **Fashion Work** (to the detriment of **Pin Up Stars**).

This company, entering the market and being faced by the huge launch costs which are a feature of all start-ups, in particular those in the fashion world (a sector which, as is well-known, requires enormous and continuous **effort and investment to be made with regard to advertising and image**) evidently decided to "contain" these costs by choosing as its trade mark (from among the thousands of new marks which it could have chosen) an expression which is very similar to and liable to be confused with the expression covered by mark '750. The chosen expression "Upstar", undeniably markedly calling to mind the "PIN UP STARS" mark owned by the petitioner, allowed Fashion Work to become recognized on the market (in a sector closely related to that of the petitioner's products), becoming mingled up with this famous trade mark and, in any case, exploiting its backwash of fame. It thus gained an enormous, undeserved advantage in terms of the two heaviest costs in the fashion field, publicity and image.

Evidently not satisfied with the illicit use of a trade mark so similar to mark '750, Fashion Work also **registered its "own" trade marks** (the inverted commas really are necessary!), in addition to the previously mentioned domain name **www.upstar.it**. These trade marks are, at least in the denominative versions, obviously **deprived of novelty** by that of the petitioner. A search on the main national, EU and international data banks has, in fact, shown up the existence of the following marks held by **Fashion Work**:

- EU denominative trade mark no. 4 828 638, registered on 5 February 2007 for class 25, relating to the expression "**UPSTAR**" (doc. 14);
- EU complex trade mark no. 5 155 271, registered on 22 June 2006 for class 25, relating to the word "UP" accompanied by a star design (doc. 15)
- EU complex trade mark no. 5 155 395, again registered on 22 June 2006 for class 25, relating to

a star design with the word “UP” in the centre (doc. 16)

- Application for Italian denominative trade mark no. MC2003C000253, filed on 27 October 2003 for class 25 and not yet granted, again relating to the expression “UPSTAR” (doc. 17).

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The reaction of the petitioner and the immediate precedents to these proceedings

6.- This being the situation, on 8 May 2007 Pin Up Stars’ attorney, Daniela Giampieri, sent Fashion Work a letter, essentially warning the petitionee not to persist in the unlawfully infringing the trade marks held by Pin Up Stars and asking it to immediately withdraw from the market all products bearing the mark “UPSTAR” (doc. 18).

Fashion Work replied to this cease and desist letter, through its attorney (doc. 19), denying all possible confusion between the signs/marks involved in these proceedings and stressing, *inter alia*, that the “Upstar” mark had been in use since 2004, “in particular” in the area of **Emilia Romagna** (*and, in all likelihood, in fact, only in the Province of Forli-Cesena*).

This exchange of letters was followed by events laying bare the real intentions of the petitionees.

The umpteenth check conducted, out of scrupulousness, on the website www.upstar.it revealed that it had been substantially modified (doc. 20). The sole proprietor Fashion Work was no longer indicated under “Manufacturer” and “Official Dealer” for Emilia Romagna but had been replaced by **Starlab Fashion s.r.l., a company set up extremely recently (only entered in the Register of Companies on 13 June 2007** – doc. 2 –, therefore **subsequent to the cease and desist letter** sent by Pin Up Stars) in which Tiziano Sironi, its legal representative, **merged** his sole proprietor business: a business, moreover, which according to the Register of Companies at the Chamber of Commerce of Forli-Cesena is **a going concern and still the owner of the website www.upstar.it**.

The way in which these events have unfolded – like a badly concealed game of Chinese boxes – leads, at least, to the suspicion that Fashion Work and its owner are perfectly well aware of the offence committed to the detriment of Pin Up Stars and its marks. Alarmed by the cease and desist letter they tried to divert their opponents and, at any rate, limit their liability, ascribing their activity to other parties (moreover, with limited liability and capital stock reduced to the bare bones).

What is more, the arrival on the scene of this new party firmly establishes that the infringement of **Fashion Work/Starlab Fashion** is about to make a “leap in quality”, moving from a mainly local activity to an organization capable of classily diffusing products bearing the infringing trade mark over the entire Italian market, causing irreparable damage to the image and value of the “PIN UP STARS” mark.

Therefore, as Fashion Work has not demonstrated any willingness to spontaneously cease sale of the products which violate the rights of Pin Up Stars, the latter is obliged to turn to this Court, in order to obtain, *inter alia*, an interim order to block the above illicit activity.

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The illicitness of the petitionees’ conduct: a) trade mark infringement

7.- It cannot be disputed that the petitionees have acted illicitly, both from the perspective of **trade mark infringement** and of **unfair competition**.

As regards the former, the similarity, and the consequent likelihood of confusion, between the petitioner’s mark relating to the words “PIN UP STARS” (valid in any type, size and color) and the mark “UPSTAR” used by the opponent is crystal clear, since the latter presents itself as a **simple**

abbreviated variant of the former, which may actually elude the less observant consumer and thus be mistaken, purely and simply, for the original.

At product level the superimposition is perfect, given that the petitioner's mark is registered in **class 25 for articles of clothing**, and the petitionees' mark is used on articles of clothing. Thus in this case there is **absolute identity**. The products on which the "PIN UP STARS" mark is actually used are also, moreover, **extremely similar** to those for which the opponent has adopted its imitation, given that the petitioner produces beachwear and Fashion Work/Starlab Fashion produce casual wear, a category which also includes beach wear and which in any case has extremely labile borderlines with respect to the first category.

The fact that the "UPSTAR" products belong to product types which are very similar but not exactly identical to those for which the "PIN UP STARS" mark is used **accentuates the likelihood of confusion**, even leading those consumers who are aware of the difference between the two marks to think that this is a "**second line**" of original products, **distinguished by a mark formed by using only some of the elements of the original mark, as often happens today in the fashion field**. For example we can find the mark "Versus" being used to distinguish the second casual line of Versace, or "Ice-B" for the second casual line of Iceberg.

Moreover, there is still a likelihood of confusion even for consumers who are aware of the fact that "UPSTAR" products come from a business other than Pin Up Stars. As has been stated clearly in legal theory and case law, likelihood of confusion also exists when an idea may arise in the mind of the public that there is a **group or collaborative relationship** between the proprietor of the mark and the mark's infringer, for example because the consumer may believe that the illicit products are made by a **licensee** of the proprietor of the infringed mark. This is a case of so-called **likelihood of confusion in a broad sense or likelihood of association** (see VANZETTI-DI CATALDO, *Manuale di diritto industriale*⁵, Milan, 2005, p. 215 and, in case law, Court of Appeal of Milan, 18 May 2001, in *Giur. ann. dir. ind.*, 2001, 871 ff., which ruled that the adoption of a mark which is similar to the original is illicit when it "**creates an objective likelihood of confusion from the perspective of likelihood of association ... creating amongst the public the possibility of error with regard to the connection between the product and the company itself, i.e. with regard to the existence of contractual or group relations between the producers or, at any rate, between the sources of origin**").

In the case in question, therefore, likelihood of confusion by association at least appears completely **inevitable**. Since the "PIN UP STARS" mark is famous for swimming costumes and beachwear, a consumer coming across an item of "UPSTAR" casual clothing cannot but think that Pin Up Stars has recently decided to venture into the creation of casual wear too, launching a second line with respect to the company's core business products, using a mark for it which, albeit different, strongly recalls the original mark (thus creating a recognizable connection between the two), directly or by means of a company coming within the orbit of Pin Up Stars or of one of its licensees.

The same protection against likelihood of confusion also appertains to the other distinctive signs of the petitioner, and in particular to its **business name**, which as an **unregistered distinctive sign** is protected pursuant to articles 1 and 2 C.I.P.: on this point see two texts, VANZETTI-DI CATALDO, *Manuale di diritto industriale*⁵, *cit.*, p. 279 ff. and AUTERI-FLORIDIA-MANGINI-OLIVIERI-RICOLFI-SPADA, *Diritto industriale*², Milan, 2005, p. 150 ff., which state that an unregistered trade mark is protected by the Code provided that "**(generalized or local) repute consequent to use**" has been achieved. In the case in point, this pre-requisite holds.

8.- Moreover, even should it be deemed that there is no likelihood of confusion between the marks in suit, the **Pin Up Stars** mark has still been infringed. The great repute and prestige enjoyed by this mark amongst the public means that it most definitely qualifies for the protection offered by art. 20.1.c) to marks having a reputation, such marks being understood as those "**known by a significant part of the public concerned by the products or services which it covers**" (ECJ, 14 September 1999, C-375/97, "General Motors", in *Giur. ann. dir. ind.*, 1999, 1569 ff.; see also ECJ, 9

January 2003, C-292/00, “Davidoff”, *ibid*, 2003, 1398 ff.).

Such protection also applies when the mark of the infringer, which although identical or similar to the original cannot be mistaken for it, gives rise to “**parasitic linkage of the goods or services of the imitator to the image connected to the imitated trade mark and to the repute of same**”, or when “**the mark of the imitator covers faulty or cheap goods (or) ... at any rate is used in ways which are not consistent with the image connected to the imitated mark**” (VANZETTI-GALLI, *La nuova legge marchi*², Milan, 2001, p. 39).

In case law, see for example Court of Milan, interim order 24 July 2003, in *Giur. ann. dir. ind.*, 2003, 1133 ff., which stated that “**The unfair advantage which the imitator may gain, claimed as an alternative to detriment to the proprietor of the mark in order to obtain protection of a mark having a reputation, may be represented by the parasitic linkage of the goods or services of the imitator to the image of the imitated mark, which allows them to be placed on the market exploiting all the evocative value of the renowned mark, thus acquiring a specific space (also as low price ‘clones’ or imitations) which they would otherwise not have occupied**”; and Court of Turin, 7 March 2002, *ibid*, 2002, 723 ff., which stressed how non-authorized third party use of a trade mark having a reputation “**may cause detriment at least because of the dilution of the evocative power and symbolic value (of the imitated mark) and, in parallel, give the non-authorized third party a particular advantage, permitting it to reap the fruits** on the market (of) that same evocative power and symbolic value which pertain to the proprietor”.

Both these situations exist in the case in point, as the infringement by Fashion Work/Starlab Fashion of mark ‘750 is clearly aimed at attaching the goods they sell to the **pulling force of the reputation** of the extremely famous marks/products of Pin Up Stars, saving on the relative advertising costs. Furthermore, this infringement can at the same time cause detriment to the image and prestige of these marks, given the **poor quality** and **creative poverty** of the goods marketed by Fashion Work/Starlab Fashion.

So there are two scenarios: either the consumer **simply mistakes** the Fashion Work/Starlab Fashion products for those of Pin Up Stars, at least in the sense of also ascribing to the latter the goods of the former, or at any rate of believing that the company selling them has been authorized to do so by Pin Up Stars; or, even if the consumer is able to ascribe these marks to different and unconnected businesses (but we do not really see how), likewise he/she cannot but recognize in the mark used on the Fashion Work/Starlab Fashion product at least an **association with the “PIN UP STARS” trade mark** and to the connected message: an association which is even more evident and complete if we think that on the **single page** of the opponent’s website, *per se* lacking all relevant information and images, the image of a young, beautiful girl in blue jeans dominates – the casual version of a pin-up – thus creating a further connection from which the imitator gains an advantage in terms of linkage, whilst the proprietor of the mark is harmed.

In both cases, therefore, it is patently clear that mark ‘750 has been infringed.

*** **

**The illicitness of the
petitionees’ conduct:
b) unfair competition**

9.- It is also absolutely beyond dispute that the conduct of Fashion Work/Starlab Fashion constitutes unfair competition.

The effect of creating confusion, and/or at any rate the parasitic linkage, with the petitioner’s mark also has a bearing for the purposes of unfair competition pursuant to art. 2598, nos. 1 and 2 Civil Code, i.e. from the perspective of use of “*names or distinctive signs which can give rise to confusion with the distinctive signs legitimately used by others*” and of the “*appropriation of the qualities of the products or of the*

business of a competitor”.

It is **indisputable** that a sign which is similar to another’s prior distinctive sign (registered or non-registered trade mark, or business name) in relation to goods or services of the same kind or of similar kinds to those for which the latter is used gives rise to **unfair competition for reasons of confusion**, illicit pursuant to art. 2598, no. 1 Civil Code: just as it is **indisputable** that “**acts of competition characterized by the intention to link up with another’s repute**” constitute a case of **appropriation of qualities**, proscribed by art. 2598, no. 2 Civil Code, (again VANZETTI-DI CATALDO, *Manuale di diritto industriale*⁵, cit., p. 90), even when this does not involve a likelihood of confusion— although this is not the case here.

We shall cite on the first point, from among the many, Court of Monza, Desio section, 13 January 2000, in *Giur. ann. dir. ind.*, 2000, 628 ff.; Court of Naples, 21 June 1995 (interim order), in *Il dir. ind.*, 1996, 453 ff.; Court of Rome, 20 February 1988, in *Giur. ann. dir. ind.*, 1988, 498 ff.; and in legal theory, for all, VANZETTI-DI CATALDO, *Manuale di diritto industriale*⁶, cit., pp. 47-48. On the second point see Supreme Court, 21 October 1998, no. 10416, in *Giur. ann. dir. ind.*, 1998, 155 ff., especially p. 162; Court of Milan, 1 February 1999, *ibid*, 2000, 209 ff.; and, still more expressly, Court of Milan, interim order 1 July 2005, *ibid*, 2005, which ruled that even imitation which did not lead to confusion with the distinctive features of another’s product was “**undue linkage pursuant to art. 2598 no. 2 Civil Code, committed by the defendant with respect to the plaintiff’s activity and the product, intended to exploit the repute and the success of the competitor by reproducing the external forms of presentation of the product in order to gain unfair advantage from the positive recognition gained by it among consumers in such a way as to transfer to the product**” of the imitator “**the effect of the repute of the competitor’s product**”; and likewise the Court of Milan ruling, order 17 January 2006 (soon to be published in *Il dir. ind.*, and which we submit as doc. 21); and also here in legal theory, for all, VANZETTI-DI CATALDO, *Manuale di diritto industriale*⁷, cit., pp. 90-92.

The activity conducted by Fashion Work is, in any case, contrary to the principles of fair trade practice and thus illicit pursuant to art. 2598, no. 3 Civil Code, as **unlawful exploitation of another’s business efforts**. Adoption of the “UPSTAR” mark places the goods for which it is used in the wake of those of Pin Up Stars and of the famous mark held by the petitioner, thus unfairly appropriating the goodwill of the latter and the advertising investment made to gain recognition for it on the market, allowing Fashion Work/Starlab Fashion (and its retailers or would-be retailers, such as Denim House) to significantly reduce – or rather, as we have seen, **to save completely on – the advertising costs** required in order to become recognized amongst consumers, giving them a notable, and above all unfair, advantage with respect to the competition. We may cite here, for example, the Court of Naples, interim order 20 October 1995, in *Il dir. ind.*, 1996, 473 ff, which precisely pointed out that “**There is parasitism each time a clothing company follows in the tracks of the company of a well-known designer in a systematic and continuous fashion, profiting from the studies, preparation and market penetration costs borne by the competitor, even without creating confusion between the activities**”. This is exactly what has happened in the case in point.

It needs to be stressed once again that the parasitic activity of Fashion Work also causes serious detriment to the image of Pin Up Stars and its products, since, as has been frequently stated, the quality of Fashion Work/Starlab Fashion products is poorer than that of the petitioner’s products. The latter can justly be placed in the **luxury goods** category, if we consider that they are on average sold to the public at a price of **250 Euro**, with prices going up to **12.000 dollars** (for the top quality pieces) (see our doc. 6). Thus, also from the perspective of being able to cause detriment to another’s assets, the opponents conduct is particularly to be feared and must be blocked as soon as possible.

*** **

The action into the merits which the petitioner intends to bring

10.- Therefore, on the basis of the above, Pin Up Stars intends to bring an action for **infringement of its trade mark and unfair competition**, seeking such a ruling against **Fashion Work, Starlab Fashion** and **Denim House** and a declaration of nullity (at least) with regard to the application for an Italian mark held by **Fashion Work/Starlab Fashion** on the grounds that it lacks novelty.

In particular, the petitioner intends to seek ascertainment that all the above illicit acts were carried out and also a final injunction on the continuation or repetition of such acts, including the production and sale of goods bearing the above mark and, in general, signs which are similar to that of Pin Up Stars, a final order to withdraw such goods from the market and establishment of a fine for each violation subsequently noted.

The petitioner also intends to seek an order against the petitionees for compensation for damage caused to the former by the illicit acts of same and for restoration of profits earned by same, as provided by art. 125 C.I.P., plus all consequent orders, in particular assignment of the products bearing the infringing marks and publication of the ruling.

*** **

The interim petitions of these proceedings and their premises

11.- It is absolutely indispensable, for the purposes of ensuring the effects of this action, that there be **interim intervention** which stops the petitionees both continuing with the above illicit activity (still taking place and even, as has been seen, now **expanding** throughout Italy), and “eliminating” key evidence in relation to the illicit activity which has been carried out so far and, in particular, evidence for assessing the amount of damage suffered by the petitioner and of profits earned by the infringers, relevant for the previously mentioned restoration of profits pursuant to art. 125 C.I.P.

Both pre-requisites for grant of the requested interim orders (*fumus boni iuris* and *periculum in mora*) are, from what has been seen, completely indisputable.

The existence of *fumus boni iuris* can immediately be seen, given the plaintiff’s perfectly valid proprietorship of mark ‘750 and infringement of same by the petitionees for the above reasons.

As for *periculum in mora*, it needs to be observed that the illicit activity is certainly capable of causing **serious damage** to Pin Up Stars (and in fact is already doing so) in terms both of **lost profits**, and – even before this – of **damage to its image**, of the loss of value of an extremely prestigious mark in which enormous amounts of capital have been invested: **neither**, by definition, **can be compensated in financial terms**.

As to this last point, the **particular urgency** of interim intervention needs to be stressed in relation to the previously mentioned **expansion** in use of the infringing mark.

As we saw at the beginning of this petition, although the presence of the opponent’s products on the market is limited (presumably to the Province of Cesena and/or Emilia Romagna), a **launch of “UPSTAR” products on a national scale** is at an advanced stage of preparation (as can be deduced from the opponent’s website which gives information on dealers in the principal Italian regions), and in particular in **Lombardy**, through the activity of **Denim House** of the **Gruppo FVMassa**, which uses the “UPSTAR” mark on its website and is preparing to put the relative products on the market for the **Autumn-Winter 2007-2008 season**.

Since **delivery of clothes for the Autumn season is taking place in these very weeks**, it is imperative that Pin Up Stars block the opponent’s illegal activity at this stage, before distribution of the new clothes to retailers, at an undetermined number of outlets, makes it essentially **impossible** to block them all.

12.- We also stress that it must also be possible to conduct the requested seizures at the premises of **third parties not identified in the petition**, should it emerge that they are involved in the illegal activity, pursuant to art. 130 C.I.P..

Finally, **publication of the ruling** must be ordered pursuant to art. 126 C.I.P., whereby “*the judicial authority may order that the interim order ... be published in full or as a summary or in its operative part, bearing in mind the seriousness of the circumstances, in one or more newspapers indicated by it, at the expense of the losing party*”.

In this regard, we ask that the ruling **also be published on the petitionees’ website www.upstar.it**. As stated previously, we ask that use of the site be blocked by means of blacking it out and replacing it with the text of the interim ruling.

*** **

The need for the requested orders to be issued *ex partes*

13.- Likewise the above orders must be issued ***ex partes***.

This is indispensable, above all, for the requested **injunction** on the production, import, advertising and sale of the products unlawfully bearing the infringing mark and the **order to seize** same issued against Fashion Work and Starlab Fashion. These are, as we have seen, **preparing to distribute to retailers (in particular Denim House) the new products bearing the infringing mark of the Autumn-Winter 2007/2008 season** (see, in particular doc. 11), with the imaginable consequences not only in terms of worsening the situation of clients being led astray and **disrepute** suffered by Pin Up Stars, but – above all – **of the infringing goods** – articles of clothing– **being distributed** to the individual outlets, and thus of the virtual **impossibility** of fruitfully executing the seizure and, at any rate, of impeding sale of the goods. The fact that there is very little time at our disposal (delivery of clothes from the Autumn-Winter 2007/2008 collection is taking place in these very weeks) renders **prior appearance of the parties impracticable**.

Furthermore, appearance of the parties would compromise execution of the vital **seizure of the petitionees’ accounting books**. If the opponents were informed of the order they would have no difficulty getting rid of all “compromising” documents, above all if we consider the fact that retention of many of these documents is not obligatory.

Therefore, there are the prerequisites for grant of the requested interim orders without prior appearance of the parties, it being understood that appearance shall follow immediately after, any defense arguments of the petitionees being assessed at that point.

*** **

In relation to the above submissions, Pin Up Stars s.r.l., represented as indicated at the beginning of this petition

asks

this Court, pursuant to art. 700 CCP and articles 121, 126, 129, 131 and 133 C.I.P., upon designation by the President of the Court of the Judge who shall hear these proceedings, to issue orders for temporarily ensuring the effects of the decision into the merits; and in particular

asks

that this Court:

1) Issue against the petitionees:

a) an injunction on the production, import, sale and advertising in any form of products illicitly bearing the above “UPSTAR” sign/mark and, in general, of signs similar to the marks held by Pin Up Stars, accompanied by the simultaneous order to withdraw said goods from sale;

b) an order to seize the products, labels, tags, stickers, catalogues and in general all advertising

material relating to the goods bearing the “UPSTAR” mark, and, more generally, signs similar to the marks held by Pin Up Stars, plus the specific means used in production of same;

c) an order to seize the accounting books of Fashion Work/Starlab Fashion and Denim House, including VAT registers, warehouse loading and unloading registers and client/supplier invoices, showing, on the one hand, the exact (also quantitative) extent of the infringement (for the purposes of assessing damages) and, on the other, the names of any other parties involved, at all levels, in this illicit activity;

d) an injunction on the use of the domain name **www.upstar.it** and elimination of the relative link from the www.gruppofvmasa.com site;

e) and conduct a formal interrogation of the legal representatives of the petitionees on the following questions: “*What is the origin of the distribution network of the goods infringing mark ‘750 and how it is composed?’*”, “*Indicate the names and addresses of the producers, manufacturers, distributors, wholesalers, retailers and other previous holders of the goods infringing mark ‘750’*”, “*Indicate the quantities produced, manufactured, delivered, received or ordered plus the price of the goods infringing mark ‘750’*”;

2) Authorize a representative of the petitioner, a technical expert of its choice and its legal counsel to attend the seizure;

3) Determine a sum to be paid by the petitionees for each violation of and/or non-compliance with the injunction and the other orders under point (1) observed subsequent to the ruling being filed, and in particular for each further infringing product produced, imported or sold by them and for each day’s delay in executing the orders;

4) Order publication of the ruling, at the expense of the petitionees and arranged by the petitioner, twice in double size characters with the names of the parties in bold, in the newspapers “*Corriere della Sera*”, “*La Repubblica*” and “*Il Resto del Carlino*” and twice, on a full page with the names of the parties in bold, in the magazines “*Grazia*” and “*Marie Claire*”, or in any other way which the Court thinks fit, and also on the website **www.upstar.it**, which will be accessible only with this content;

5) Order the petitionees to reimburse the petitioner for the costs, duties and fees of these proceedings, including the lump sum provided by art. 14 Ministerial Decree no. 127/04.

*** **

For the purposes of determining the unified contribution, we declare that the value of this case is indeterminable.

*** **

The following documents are submitted:

(...)

*** **

Milan, 17 July 2007.

R.G. no. 48999/07

COURT OF MILAN

Vacation Division

The Designated Judge, Dr Claudio Marangoni

(...)

observes as follows

First of all, the petitionees’ pleas of territorial non-competence are dismissed.

The registered offices of the petitionee Denim House s.r.l. in Milan appear to fulfill the prerequisite for determining, pursuant to art 33 CCP, a case of plurality of parties which renders the Court under art. 19 CCP of one of the defendants also competent for the same claims brought against the other defendants.

What is more, the alleged speciousness of the involvement of Denim House s.r.l. in these proceedings – that it is being used as a reason for determining the competence of this Court – is not so evident and indisputable, bearing in mind that this party is indicated as the official dealer for Lombardy on the Fashion Work website www.upstar.it, which can be arrived at from the website of Denim House s.r.l. www.gruppofvmassa.com by clicking on the *Upstar* mark in the list of collections.

Therefore, it must be stated – bearing in mind the information at the disposition of the petitioner prior to submitting the petition – that Denim House s.r.l. presents itself to the general clientele as a party which is officially involved in the distribution network of the disputed goods and that therefore its invocation in these proceedings cannot be considered groundless or simply an instrument with the sole aim of unduly determining the competent Court.

As to the merits of the dispute, the petitioner is acting in defense of its mark *Pin-Up Stars*, covered in particular by EU registration 2.057.750 filed on 26.1.2001 (doc. 8 plaintiff's file), a mark which according to the plaintiff has now acquired widespread repute in the beachwear sector (swimming costumes, sundresses, pareu, etc.), and is damaged by the petitionees' use of the mark *Upstar* for casual wear.

This mark is covered by Italian registration no. MC2003C000253 dating back to 27.10.2003 and Community Trade Mark no. 4.828.638 filed on 11.1.2006 (see documents 14 and 17 petitioner's file) for class 25.

I hold that the petition possesses the requisite of *fumus boni iuris* (prima facie evidence) required for grant of the requested interim orders.

In addition to proof of the actual repute now obtained by the petitioner's mark – which in actual fact should be proven in relation to the period in which the *Upstar* mark was registered (October 2003) for application of the specific protection – the pre-requisites do in fact hold for ruling that the rights of the petitioner in relation to the situation under art. 20. b) C.I.P. have been violated.

The undue similarity of the petitioner's mark must be confirmed by a concise and comprehensive comparative assessment of the two marks, given that the petitionees' mark copies in a servile manner part of the mark of the petitioner in such a way as to create indisputable linkage.

Although it is true that the term *star* may not per se be a determining and characterizing element of a trade mark due to its common use, its limited distinctive character must be considered differently if this term is associated with other graphic or denominative elements.

In the case in point, due to an assessment which may not be effected in a purely analytical way on individual terms contained in the petitioner's denominative mark, the word *stars* must also be considered capable of discharging – assessed together with the other denominative elements of the mark – one of its positive functions at a distinctive level with respect to a mark which taken as a whole certainly appears to possess a marked characterization from which follows the need for adequate differentiation by third parties.

What is more, this assessment is likewise confirmed by the Community trade mark registration body, which in turn deemed eligible for registration the mark of the petitioner which had added the word *stars* in order to differentiate its previous application for registration of the *Pin-Up*, which had already be covered by a prior registration by third parties.

From this perspective, the *Up-Star* sign unduly infringes the *Pin-Up Stars* mark, reproducing a relevant part from a phonetic and visual point of view and creating an objective confusing effect.

The conceptual difference between the two marks – used by the petitionees' as foundation for their argument that the two marks are independent – does not appear decisive in excluding the lack of novelty of the petitionees' mark, since if the term *pin-up* gives rise to a certain image of a model of

the '40s-'50s and thus appears capable of having an evocative effect on the consumer, the fact that the *Up Star* mark is, however, per se without any intelligible significance highlights to an even greater extent the alleged intention of linkage by reproducing a significant and relevant part of the first mark, bearing in mind that when the petitionees' mark was filed (October 2003) there was already considerable acknowledgement in the press and sectoral exhibitions of an expansion in diffusion of the *Pin-Up Stars* mark (see press review which in July 2003 defined this sign as an "up and coming mark", in doc. 6 petitioner's file).

It must likewise be confirmed that there is a likelihood of confusion deriving from registration and use of the disputed mark, although principally identifiable from the perspective of likelihood of association between the two marks and between the activities of the respective owners.

In fact, I believe that there is also a partial overlapping between the products respectively bearing the opposing marks if we consider – bearing in mind at any rate the registration of both for the class of clothing in general – that the petitioner places its mark not only on swimming costumes but also on other articles (pareu, sundresses, etc.) which even if they are intended for beach use could well be included in a casual clothing range, which is essentially characterized by its informal nature.

Fumus boni iuris is accompanied by the presumption of *periculum in mora* (urgency), bearing in mind the damage to appreciation of the petitioner's mark which continuation of the undue linkage by the petitionees' mark is capable of causing, damage which cannot completely be compensated in financial terms at the end of the proceedings into the merits.

Thus, the measures sought must be granted pursuant to articles 129, 131 and 133 C.I.P., as there is no need either to proceed with cross examination pursuant to art. 121-*bis* C.I.P. of the legal representatives of the petitionees on the circumstances indicated by the petitioner, as they can be ascertained on the basis of the accounting books, or publication of the interim ruling, given the still initial stage in national distribution of the petitionees' goods.

No order is issued as to payment of costs of these proceedings as there are no pre-requisites for believing that said proceedings can anticipate all the effects of the decision into the merits.

For these reasons

Pursuant to articles 669 *octies* Code of Civil Procedure and 129, 131 and 133 C.I.P.:

1) In admitting the petition submitted by PIN UP STARS s.r.l. enjoins TIZIANO SIRONI – as owner of the sole proprietor business FASHION WORK –, STARLAB FASHION s.r.l. and DENIM HOUSE s.r.l. to discontinue production, advertising and sale of the clothing bearing the *UP STAR* mark, ordering withdrawal from sale of same;

2) Authorizes the petitioner to proceed with the order against the petitionees at their premises – or at their warehouses, secondary offices and buildings – to seize goods bearing the *UP STAR* mark and the relative advertising material, plus the accounting books and documentation relating to the production and sale of same – to be executed by photocopying the VAT registers, warehouse loading/unloading registers, client/supplier invoices, transportation documents with the originals being subsequently returned to their respective owners – authorizing the petitioner to attend the seizure through its own representatives and the Court Bailiff to use any technical means deemed necessary;

3) Enjoin TIZIANO SIRONI – as owner of the sole proprietor business FASHION WORK – not to use the term *Up-Star* as a domain name;

4) Fix a sum to be paid by the petitionees of Euro 100,00 for each product sold in violation of the injunction and of Euro 250,00 for each day's delay in executing the order;

Milan, 27 August 2007

The Designated Judge
Dr G. Marangoni

THE ARTICLE

✓ *Trade Marks, models, newspaper titles and domain names: a year of case law* – Summary of an article by Professor Cesare Galli soon to be published in *AIDA*

As is the case each year, the *AIDA* review has invited Professor Cesare Galli to examine and comment briefly on the principal Italian and EU decisions on distinctive signs, in relation to their impact on the cultural industry.

His article was published in the 2007 volume of the review, just issued, under the title *Segni distintivi e industria culturale*. In the meantime, we give a full summary hereunder.

CESARE GALLI

TRADE MARKS, MODELS, NEWSPAPER TITLES AND DOMAIN NAMES: A YEAR OF CASE LAW (SEPTEMBER 2006-SEPTEMBER 2007)

SUMMARY: 1. The protection of trade marks and names with a reputation and the relations between a trade mark and a name. – 2. The «justification» of art. 21 C.I.P. and the «just cause» of art. 20.1.d). Applications in matters of sports distinctive signs. – 3. Problems of proprietorship of distinctive signs used in common by different parties: the case of music groups. – 4. Distinctive signs and parody: the importance of perception and the public. – 5. Industrial design and distinctive signs. – 6. EU case law and its impact on the IP sector: a) Shape trade marks and trade marks «without a shape». The change over time in the public's attitude towards a shape. – 7. (continued) b) identical marks for identical goods and infringement of the legally protected functions of a trade mark; non-use and «proper reasons». – 8. Marks, titles of intellectual works and newspaper titles. – 9. Problems raised by the Internet.

1. The Court of Milan, in an *ex partes* order of 9 March 2007 subsequently upheld by a ruling of 27 April 2007, protected an extremely famous trade mark in the luxury goods sector against use of a similar sign on an erotic calendar as a pseudonym for a pornographic actress. The decision follows in the steps of previous rulings of the same Court ⁽¹⁾. These held that any use in trade of a sign that is identical or similar to another's trade mark with a reputation, which is capable of giving rise to a likelihood of confusion or profiting from the repute of the mark (or damage to this repute) constitutes infringement, even should such use not have a distinctive function. In the case in question, it must be pointed out that the Court ruled all the parties involved in the publication and distribution of the infringing calendar guilty of infringement, including its printer and the sponsors.

Again on this argument, at international level, there is the *Limitations of Trademark Rights* document approved by the AIPPI Executive Committee which met in Singapore in October 2007. The document, drawn up by the International Working Group on *Question Q 195* chaired by Professor Cesare Galli, and preceded by a full-scale debate between the National Groups (with 41 National Reports being submitted including, naturally, that of the Italian Group ⁽²⁾), recommends that use in trade of a personal name be permitted even when this name is identical or similar to another's registered mark, provided that it is a real name and not a pseudonym and that it is not used as a company name, and as long as such use does not give rise to confusion/association with the mark, does not unduly benefit from the mark's reputation or cause damage to same, even in the form of dilution: thus making clear that it is now universally accepted that a mark acts as a fundamental instrument of business communication, valorized and protected not only against the likelihood of confusion, but also against any other form of parasitic linkage, and that it is in this context (and no

⁽¹⁾ Court of Milan, order 28 October 2005 and Court of Milan, interim order 14 November 2005, which were recounted in full in the previous edition of GALLI, *Segni distintivi e industria culturale*, published in *AIDA*, 2006.

⁽²⁾ The Resolution and the Reports of the national groups can be found on the AIPPI website www.aippi.org and will be published in the Association's yearbook. On the approved Resolution, also see the article by GALLI in *AIPPI News* (Newsletter of the Italian Group of the Association), November 2007, pp. 11-12.

longer only in the context of its traditional origin function) that a point of balance must be sought between the interests of the proprietor and those of the market⁽³⁾.

The Court of Turin dealt with a case of non-authorized use of the (famous) name of an athlete and other signs unequivocally related to him on clothing (and on the relative labels, which also claimed that the goods were produced in collaboration with the athlete). The Court issued an interim order forbidding use of the name, ruling that it contravened art.7 Civil Code ⁽⁴⁾. Albeit only in an *obiter dictum* (since in the case in question the Court dismissed the defense arguments which claimed that the athlete had, in fact, authorized use of his name), the ruling also stated that any consent to the use of the name by its owner could always be revoked. The Court of Bari, in a similar case (but relating to the commercial use of an image), ruled likewise on this point ⁽⁵⁾. This conclusion, however, seems open to question since such consent, precisely because it does not transfer a (unobtainable) right to the name but pertains only to exercise of same – as the ruling stresses –, certainly appears negotiable. Art. 8.3 C.I.P. (and prior to this Trade Mark Law art. 21.3) expressly provides for the possibility that the proprietor of a famous name may consent to third parties registering that name as a mark: such registration, once effected, has potentially perpetual duration being indefinitely renewable ⁽⁶⁾. It is, on the other hand, worth noting that both the rulings in question stressed, from the perspective of irreparability of damage, «*damage deriving from dilution and inflation of the ... images*», or «*dilution of the image and loss of the commercial value of same*», deriving from non-authorized use of the name and image. This seems consistent with the logic that also governs recognition of the right *sui generis* of the proprietor of famous marks to proscribe their unauthorized registration (and use) as a trade mark, provided by art. 8.3 C.I.P., an article which could possibly also have been invoked in the cases in question, or at least in the first ⁽⁷⁾.

The Supreme Court ruled on a case concerning authorization by an entertainer to register her name as a trade mark. Moreover, the Court, for those aspects which concern us here, confined itself to stating that the factual ascertainment arrived at by the Court of Appeal in relation to the contents of the agreement was to be considered final at Supreme Court stage, in particular that part of the Court of Appeal's decision which stressed the fact that the mark was composed only of the forename in order to conclude that the right to redress was «*contractually due only in relation to the*

⁽³⁾ A problem of balancing interests in this field has been tackled, but from a completely different perspective, by the European Court of Human Rights, which held that the right to an image protected by national copyright law is one of those rights of others which may legitimate restriction of freedom of information pursuant to art. 10.2 European Convention for the Protection of Human Rights, when this restriction is required for its protection (ECHR, 14 December 2006, in *AIDA*, 2007), likewise stating that the national courts must [...] balance public interest in information with the private interest of the holder of the right on the image; and art. 10 of the European Convention for the Protection of Human Rights is breached when an absolute ban on publishing an image in a news report is not proportionate to the legitimate objective of protecting the right of the private individual to the image (ECHR, 14 December 2006, in *AIDA*, 2007).

⁽⁴⁾ Court of Turin, interim order 26 January 2006, in *Riv. dir. ind.*, 2006, II, 356 ff.. The athlete in question was David Trezeguet, a French footballer playing for Juventus, and the disputed clothing carried his name together with the French flag and the number of the shirt (17) in which he played in the French national team.

⁽⁵⁾ Court of Bari, interim order 13 June 2006, in *AIDA*, 2007. On this argument see also Court of Milan, interim order 25 February 2006, again in *AIDA*, 2007, which also stated that, as is obvious, «The burden of proving the consent required for using another's image for advertising purposes rests with the party invoking its existence».

⁽⁶⁾ PERON, *Il diritto al nome, il consenso al suo sfruttamento ed i danni risarcibili*, in *Riv. dir. ind.*, 2006, II, 360 ff., in a note to the decision in question takes a critical stance on this aspect of the ruling, also citing other authors who have more generally criticized the idea of absolute revocability of consent for the commercial use of a person's name or image.

⁽⁷⁾ In this sense, respectively, Court of Turin, interim order 26 January 2006 and Court of Bari, interim order 13 June 2006, both *cit.*. Again in this perspective, a ruling of the Court of Appeal of Rome has also referred to the «media and promotional function assigned by the music producer to the image of the artist». The Court described as an act of unfair competition «the activity of a publisher which receives images of an artist from a music producer which are intended to illustrate a new album on the understanding that they are to be used only to inform the public as to its release, and then uses them for its own rival album of poorer quality»: Court of Appeal of Rome, 30 January 2006, in *AIDA*, 2007.

performances of the entertainer 'in any form of show' which could make clear that the entertainer preferred the shoes of her licensee»⁽⁸⁾): a conclusion which, beyond the case in question, appears in turn to be consistent with the idea that only the recognizability of the connection between a famous personality and the mark renders applicable the regulation which reserves to the famous personality, or makes it conditional upon his/her consent, registration of his/her name (or of another famous sign).

Another ruling of the Supreme Court is interesting essentially at a historical level. The Court, applying the Trade Mark Law of the pre-1992 reform text to a case going back many years, confirmed its more «liberal» interpretation, whereby use of a surname covered by another's trade mark within a business name was possible, provided however that it did not give rise to a real likelihood of confusion on the market⁽⁹⁾. Compared to the law now in force, this limit is both broader and narrower: broader, since not only likelihood of confusion but also linkage is important (and thus unfair advantage derived from the distinctive character or repute of the mark or detriment caused to same), and narrower since this rule may allow not only use of the surname as a distinctive sign different from the mark, but also the same use within a mark, due to the disappearance (following the introduction of the C.I.P., which incorporated from this perspective the express indication coming from EU case law⁽¹⁰⁾), of the provision which made the lawfulness of use in trade of one's own name which conflicted with another's mark (and the other lawful uses of another's mark already provided by art. 1-*bis*, paragraph 1 Trade Mark Law and now by art. 21.1 C.I.P.) conditional not only upon compliance of that use with fair business practice but also upon the fact that use occurred «*not as a mark, but only with a descriptive function*».

3. In the field of sports distinctive signs, there has been an important decision from the Court of Venice⁽¹¹⁾. The Court ruled that the IOC mark composed of the word «Olympic» was valid and infringed by the use of this sign on articles of sports clothing. The decision has given rise to a full analysis of legislation applicable to the Olympic distinctive signs. The analysis is concluded with the hope for an extensive interpretation of art. 21 C.I.P. on the lawful uses of another's mark, «which could define preceptive scope in appropriate terms – above all in similar cases»⁽¹²⁾. However, this last point seems off target. Application of the article in question is conditional upon the compliance of third party conduct «*with customary fair practice in the commercial and industrial fields*», compliance which – according to its interpretation by the Supreme Court⁽¹³⁾, subsequently upheld by the ECJ⁽¹⁴⁾, in interpreting art. 6 of EC Directive 89/104 – permits application of this justification only when use

⁽⁸⁾ Supreme Court, 13 June 2006, no. 13674, in *AIDA*, 2007.

⁽⁹⁾ Supreme Court, 26 August 2004, no. 17004, in *Riv. dir. ind.*, 2007, II, 20 ff., with note by ESPOSITO, *Brevi osservazioni in tema di adozione quale ditta, ragione o denominazione sociale di un patronimico già incluso in un antecedente marchio altrui*.

⁽¹⁰⁾ See ECJ, 7 January 2004, C-100/02, also cited in the 2004 edition of GALLI, *Segni distintivi e industria culturale*, in *AIDA*, 2004, p. 494.

⁽¹¹⁾ Court of Venice, 23 January 2006, in *Foro it.*, 2006, I, 1572 ff. and now also in *AIDA*, 2007 and *Riv. dir. ind.*, 2006, II, 267 ff. (where it appears with the date 16 December 2005), fully commented in the 2006 edition of GALLI, *Segni distintivi e industria culturale*, in *AIDA*, 2006, pp. 345-346. This decision also cited the special law passed in view of the Turin 2006 Winter Olympics (Law 167/2005), which strengthened the protection in Italy of the Olympic symbols until 31 December 2006 against parasitic operations by non-authorized third parties, also leaving unchanged their ordinary protection; and the 1981 Convention of Nairobi, ratified by Italy by Law 434/85, which protects the Olympic symbol of five circles against commercial use not authorized by the IOC (which was likewise breached in the case decided by the Court of Venice).

⁽¹²⁾ BANDERA, «*Marchi olimpici: tra diritti esclusivi e ragioni di Stato (ovvero di Olimpiadi)*», in *Riv. dir. ind.*, 2006, II, 275 ff..

⁽¹³⁾ Supreme Court, 22 November 1996, no. 10351 and likewise Court of Biella (interim order), 21 June 1996 and Court of Milan, 28 October 1996, all in *Giur. ann. dir. ind.*, 1996, nos. 3392, 3497 and 3518 (the Supreme Court ruling can also be read in *Riv. dir. ind.*, 1997, II, 80 ff., with note by CALISSE and in *IDI*, 1997, 569 ff., with note by LAMANDINI) and Court of Livorno, 27 January 1997, in *Giust. civ.*, 1997, 1963 ff., with note by ALBERTINI, *Conflitto tra segni distintivi patronimici*. In legal theory see in particular GALLI, *Attuazione della Direttiva n. 89/104/C.E.E. Commentario*, in *Nuove leggi civ. comm.*, 1995, 1151 (whose arguments are repeated almost word for word in the grounds of the Court of Livorno decision).

⁽¹⁴⁾ ECJ., 17 March 2005, C-228/03.

does not create any kind of parasitic exploitation of another's sign; and this exploitation usually occurs each time the sign which is claimed to be descriptive is such precisely in relation to the meaning for which the legislator has accorded protection to the mark ⁽¹⁵⁾. This is also what happened in the case heard before the Court of Venice. The Court held that the word «Olympic», used on sports clothing whose infringing nature was being examined, continued to evoke the Olympic spirit and values safeguarded by the IOC, and thus a «message» which the IOC is entitled to exploit even in the commercial field.

Rather, a margin of lawfulness for uses of signs which are identical or similar to another's mark which also involve linkage to that mark may be recovered in relation to art. 5.2 of the Directive, which requires that the advantage gained by the third party from this linkage be «*undue*» and that the use which is either advantageous (for the third party) or detrimental (to the distinctive character or repute of the mark), be effected «*without due cause*»: the «open» wording of this article seems to suggest that a Court must balance the interests of the proprietor of the mark and the needs of the market, at least in situations (which does not seem to be the case here) in which «*effective competition on the relevant market is conditional upon a reference to those marks*», according to the interpretation given by the ECJ in relation to a different case (interpretation of the Comparative Advertising Directive) ⁽¹⁶⁾, but in relation to a similar problem (assessment of the nature, be it unfair or not, of the advantage that the author of the advertising derives from the reputation of a trade mark, trade name or other distinguishing marks of a competitor or of the designations of origin of competing products, which is one of the prerequisites for the legitimate use of such signs in comparative advertising).

Again in relation to the need to make protection of the mark commensurate to its real market value, making it conditional upon actual appropriation by a third party of advantage which the legislator intended to reserve to the owner, recent research has aimed at expanding the characteristics of the «*mark as a sign of communication*», and stresses the rules of «*bi-directionality, equal interaction, conversational participation, consensual sharing, symbolic and conventional systems, coding and decoding, cultural contextualization*» according to which this particular form of communication develops, suggesting therefore that judicial assessment of the case must integrate with the results arrived at by marketing and communication experts ⁽¹⁷⁾: a context in which marks themselves are increasingly one of the fundamental products of the cultural industry.

The Court of Milan has also examined a case involving problems of parasitism, in relation to distinctive signs connected to sport, more precisely to a number of marks corresponding to the titles of TV sports programs. The Court denied protection to the marks in question, ruling that they related to «descriptive or, at any rate, vulgarized signs», while it awarded protection to the corresponding titles on the basis of both art. 100 Copyright Law and unfair competition legislation, and, in particular, the final article which proscribes commission of acts which are contrary to fair practice and can damage another's assets, in that imitation of the corresponding titles was part of general conduct, held to be improper, which consisted of «*availing oneself of past contractual relations to acquire the idea for a television format, albeit not eligible for copyright protection, and also taking its title, albeit not*

⁽¹⁵⁾ see GALLI, *Estensione e limiti dell'esclusiva sui segni distintivi dello sport, tra merchandising e free-riders*, in this *Review* 2003, 231 ff..

⁽¹⁶⁾ ECJ., 23 February 2006, C-59/05, cited in the 2006 edition of GALLI, *Segni distintivi e industria culturale*, p. 357.

⁽¹⁷⁾ SANDRI, *Ricezione percettiva del mark e ricettore molecolare*, in *IDI*, 2007, 357 ff., and then more fully *ID.*, *Percepire il marchio: dall'identità del segno alla confondibilità*, Forlì, 2007; see also, by the same author, *Marchi non-convenzionali*, in *IDI*, 2007, 341 ff., who draws up this category (putting together, without playing down differences, smell, color, sound, mood and music, positioning, movement, touch and taste marks) on the basis of the «peculiarity with which the mark transmits the message and with which this is perceived by consumers». The annual National Conference on IP Law organized by the University of Parma and held on 26 October 2007, entitled «Trade Marks, Marketing, Advertising» took a multidisciplinary approach to the mark, which adds the law of distinctive signs and advertising to a new law of business communication; see also GALLI, *I marchi nella prospettiva del diritto comunitario: dal diritto dei segni distintivi al diritto della comunicazione d'impresa*, in *AIDA*, 2007.

eligible for trade mark protection» ⁽¹⁸⁾. However, at least the first conclusion appears debatable. The protection of the title of an intellectual work provided by art. 100 Copyright Law is, in fact, a typical protection of a competition nature, which presupposes that the title can distinguish the work from others of the same kind and therefore that it has an actual distinctive character, a character which may naturally emerge with use. When this character exists there is no reason for the title to be denied protection as a mark, for corresponding goods or services. As for the conduct criticized for being professionally improper, it seems rather that it can be ascribable to a form of parasitic linkage which is sanctioned by a ban on appropriating qualities pursuant to art. 2598.2 Civil Code, on the premise that, although the relevant public was not confused, the title of the imitator's program brought the imitated program to their mind.

4. The Court of Turin issued – in record time, considering that the Writ of Summons was served on 1 December 2005 and the ruling filed on 9 March 2007 – a first instance decision into the merits on a case relating to the proprietorship of the name of a pop group. The name was «disputed» between various members and former members of the group. The case had already given rise to an *ante causam* interim order and the relative confirmation at appeal ⁽¹⁹⁾.

However, this decision too, just like the preceding orders, gives rise to some ambiguity. The action was brought by one of the group members (the only one who had been a continuous member) and another member, who had rejoined the group after many years' absence, on their own behalf, against use of the name in the denomination of a new group promoted by another former member of the original group. The decision accorded protection of the name of the group to the two plaintiffs on the basis of their «*right to the name or pseudonym*» and of the corresponding non-registered mark used uninterruptedly «*by the homonymous group and its members*». The decision ruled that the conduct of the defendants was an act of unfair competition by way of confusion, given that it «*created confusion between the two groups*», who were recognized as business entrepreneurs proper. However, the fact that the two group members acted on their own behalf, and not on behalf of the group, makes their (substantive) entitlement to act uncertain, as it was the group and not its individual members which should have considered itself the autonomous proprietor of the rights on the business name and non-registered trade mark, and also proprietor of the business activity in the music sector. As was mentioned in commenting on the interim orders, however, the possibility of protecting the name of a group as the pseudonym of one or more of its members presupposes that it has been ascertained that in the eyes of the public these members, and only they, identify the group. This could also have happened in the case in question but it failed to be considered adequately in the decision just as in the *ante causam* orders.

A decision on a dispute going back in time is that of the Court of Appeal of Naples, issued in a case involving two music groups with the same name. The second had been set up by a member of the first who had been excluded from the *de facto* company which had been the original proprietor of the name (later given to a cultural association made up of the remaining members of the original company). In this case, the Court of Appeal confirmed the unlawfulness of the conduct of the «*member excluded from a de facto company between artists who, unbeknown to the company, used the name for an artistic show*», by way of infringement of the right accorded to the company (and then to the cultural association which replaced it) on its own name ⁽²⁰⁾.

⁽¹⁸⁾ Court of Milan, 15 November 2006, in *AIDA*, 2007. See also Court of Milan, 2 August 2006, again in *AIDA*, 2007, which likewise held that the final clause of art. 2598, no. 3 Civil Code was applicable in a case in which an entrepreneur had «taken from a competitor's program all its fixed images (but not those relating to animation), by means of a systematic undue exploitation of the competitor's work and an unfair advantage at a competitive level, in terms of both costs and time saved», even though the images could not be protected on the basis of copyright.

⁽¹⁹⁾ Court of Turin, 9 March 2007, in *Foro it.*, 2007, I, 1756 ff.. The interim orders were those of the Court of Turin, interim order 31 October 2005 and interim order 20 December 2005. They were also covered in the previous edition of GALLI, *Segni distintivi e industria culturale*, in *AIDA*, 2006, p. 347; the name of the first group was «I nuovi angeli», while the disputed name was «I nuovi angeli by Valerio Liboni».

⁽²⁰⁾ Court of Appeal of Naples, 19 May 2006, in *AIDA*, 2007. The decision of the Court of Naples, 2

5. The Court of Naples decided a case between two clubs which had both adopted as their sign – the first, time-wise, also registering it as a mark, for restaurant and musical entertainment services – the title of a famous Neapolitan song. The Court dismissed the imitator's arguments which refuted the distinctive character of that sign on the basis of diffusion, also in common parlance, of the expression which constituted the name of the song. The Court observed that said diffusion did not concern adoption of the expression in relation to the goods or services for which the mark had been registered. It added that the distinctive character of the latter was confirmed also by the «*fact that the defendants had requested – note the coincidence – a name and applied to register a mark which was essentially the same as that registered by the plaintiff*»⁽²¹⁾.

The Court of Turin has reasoned in a somewhat similar manner. In interim proceedings, relating to the reproduction on T-shirts of an expression which, according to the plaintiff, was a parody of its (denominative) registered mark, fully replicated on the T-shirts accompanied by a vulgar epithet. However, according to the defendant, this was an «*extremely common expression in young people's slang, also because it was linked to the famous song of a band ... which had been singing it in public for many years*». The Court of Turin deemed this circumstance irrelevant, on the basis of the mere temporal importance of the priority of the registration as a mark for clothing of the plaintiff's sign, ruling that its repute in that sector could still lead a potential buyer to believe that that the proprietor of the mark had «*authorized or, at any rate, consented to the sale of goods bearing writing which contained its registered mark*»⁽²²⁾. In actual fact, the openly (and vulgarly) parodying nature in which the mark was alleged to have been used in this case seems to make likelihood of confusion quite improbable⁽²³⁾, while the fact that the epithet added to the mark was of a one with it appears to rule out the possibility of claiming the protection of identical marks for identical goods. The dispute in point must therefore be seen as a case of infringement not leading to confusion disciplined by art. 20.1.c) C.I.P. and art. 5.2 EC Directive 89/104.

In both the cases examined, however, the decisive element has to be the perception of the relevant public. As was highlighted by the ECJ in relation to the decorative use of another's mark⁽²⁴⁾ – but whose considerations had a more general bearing –, if the potential clients of the music clubs or the potential buyers of the T-shirts perceive, respectively, the club sign and the writing on the T-shirts as a mere reference to the songs, without making any connection with the prior marks, the use of the sign or of the writing must be considered legitimate. If, however, a connection may be established (even if it is only from the perspective of psychological recall, and thus not necessarily supposing a common origin, and even if the public is aware that the sign refers to the song), and due to this recall the distinctive character and repute of the imitated mark are affected or, at any rate, the user of the sign derives an advantage from them, then the pre-requisites for protection of the mark hold, at least from the perspective of art. 20.1.c) C.I.P. This perspective prescind (at least in the Italian legal system) from use of the mark with a distinctive function, but it evidently may not prescind from the fact that the imitated element is perceived as a sign, i.e. as the bearer of a message, and in particular of a message which repeats at least in part the message which is linked to the mark

December 1996, examined in the 1997 edition of GALLI, *Segni distintivi e industria culturale*, in AIDA, 1997, pp. 336-337, dealt with the same affair (relating to the name «Nuova Compagnia di Canto Popolare»).

⁽²¹⁾ Court of Naples, 25 July 2006, in *Foro it.*, 2006, I, 3517 ff.. The disputed sign was «Anema e core», and this decision too was particularly quick, being reached after little more than a year and a half from service of the Writ of Summons on 3 December 2004.

⁽²²⁾ Court of Turin, interim order 9 March 2006, in *IDI*, 2007, 149 ff., with note by VENTURELLO, *Uso del mark in funzione parodistica e come espressione di uso comune nel linguaggio corrente*. The expression on the T-shirts was «Porco Diesel», while the protected mark was «Diesel».

⁽²³⁾ On the parodic use of another's mark see in particular GALLI, *La protezione del marchio oltre il limite del pericolo di confusione*, in Various Authors, *Segni e forme distintive. La nuova protezione*, Milan, 2001, p. 19 ff. and *ID.*, *L'allargamento della tutela del marchio e i problemi di Internet*, in Various Authors, *Il futuro dei marchi e le sfide della globalizzazione* edited by GALLI, Padova, 2002, p. 17 ff. and in *Riv. dir. ind.*, 2002, I, 103 ff..

⁽²⁴⁾ ECJ, 23 October 2003, C-408/01, «Adidas/Fitnessworld», also commented in the 2004 edition of GALLI, *Segni distintivi e industria culturale*, in AIDA, 2004, on which, for further study, see GALLI, *I limiti di protezione dei marchi rinomati nella giurisprudenza della Corte di Giustizia C.E.*, in *Riv. dir. ind.*, 2004, II.

to be protected.

In the second case examined, it could also be asked whether the particular vulgarity of the expression on the T-shirt – which openly alluded to a swear word, and as such is criminally sanctioned by art. 723 Criminal Code – could render the sign itself null, if it had ever been registered as a mark ⁽²⁵⁾.

6. A decision of the Court of Milan offered the occasion for notable theoretical study in the form of an essay on the protection of shapes as works of design and as distinctive signs.

The Court ruled that the shape of a product, registered neither as a mark nor as a design, could be protected, essentially due to its repute which led the consumers concerned to perceive it as a symbol of the producer. The Court held that an identical copy of that product was unlawful by way of both infringement of a non-registered distinctive sign and unfair competition on the grounds of servile imitation and appropriation of qualities ⁽²⁶⁾. Taking this decision as a starting point, the essay examines the *«problem of establishing when the shape of the product, in addition to meeting functional or aesthetic needs, counts also as a discriminative criterion between the product of one company and those of its competitors»*, and in particular the relationship between distinctive character and individual character, concluding – also on the basis of EU case law on shape marks – that *«distinctive character and individual character may be placed on a par since they are both based on the perception of the public, but they protect two different functions of the product shape: individual character concerns the shape ‘per se’, while distinctive character ‘the other from self’ of a shape i.e. the other possible messages and suggestions which are communicated by the shape»*, usually as a result of use. The essay denies that on this basis it is *«possible... to make individual character coincide with distinctive character, by distinguishing the two concepts essentially on the basis of the parties to whose judgment reference is made, the average consumer for distinctive character and the informed user for individual character»*, observing instead that *«in this regard, a further step could be taken by saying that the relationship between individual character and the use and success of the shape which a product attains on the market also differs from that between individual character and distinctive character or rather that there is a sort of cause-effect relationship between the two, in the sense that individual character may be a vehicle for the success of a shape on the market, while distinctive character is a possible consequence of such success in the sense that individual character may be a vehicle for success»* ⁽²⁷⁾. This is an assertion that can be subscribed to, with the warning however that often perception of a shape as aesthetically significant is linked to the communication and advertising activity actually carried out in its regard, not, however, as the bearer of a message (i.e. as a sign), but as a shape *per se*.

The central importance of the perception of the relevant public also in determining the protection which shapes can enjoy is also beginning to make inroads in case law. Two decisions of the Court of Milan are particularly significant from this viewpoint. They were issued in relation to different cases but contain corresponding pronouncements of principle. In examining whether a certain shape may be protected by copyright for works of design under art. 2, no. 10 Copyright Law, the Courts held that *«in assessing the artistic value of the work its consolidated perception in society and, in particular, in the cultural environment in general needs to be highlighted as objectively as possible»*, and in this perspective they highlighted, as confirmation of the artistic value of the work, *«its inclusion in many leading museums of contemporary art»* ⁽²⁸⁾. From this viewpoint it might appear surprising that, due to the decision of the Italian legislator to add a supplementary prerequisite to that of creative character which is provided for all other works protected by copyright, in the case of a design recognition of

⁽²⁵⁾ For two very recent decisions on marks considered illicit – the first because it contravened criminal law – see Court of Milan, 14 February 2005 and Court of Milan, interim order 17 December 2005, which we covered in the previous edition of GALLI, *Segni distintivi e industria culturale*, in *AIDA*, 2006, p. 349.

⁽²⁶⁾ Court of Milan, order 17 January 2006, in *IPLawGalli Newsletter*, April 2006, later upheld by the Court of Milan, interim order 1 February 2006, unpublished.

⁽²⁷⁾ BRAMBILLA, *Carattere individuale e capacità distintiva nella tutela delle forme registrate e non registrate*, in *IDI*, 2007.

⁽²⁸⁾ Court of Milan, interim order 28 November 2006, later upheld at appeal by the Court of Milan, interim order 22 January 2007, both in *AIDA*, 2007, and Court of Milan, interim order 29 December 2006, again in *AIDA*, 2007. The drafter of the two orders cited in the text is Marangoni.

the product as a work of art is elevated in some way to a constitutive element of protection or, at any rate, a condition of protection. However, this all depends on the particularity of this form of art which is inseparably connected to the context in which it is enjoyed as a object of utility. Thus this context (and the public's perception of it) cannot be prescindend from even in order to determine its value as a possible beneficiary of copyright.

There has been another interesting essay ⁽²⁹⁾ which concerns more specifically non-registered shapes. It reviews the different forms of protection for the shape of products now provided under Italian law, above all due to EU legislation, stressing *«the evolution of legislation on forms of protection disengaged from registration»* and highlighting in particular the phenomenon of the *«look alike, which involves imitating the external appearance of another's famous product ... in order to 'shower the effect of the competing product's repute on the lower priced product'»*. The essay opines that the protection accorded to signs with a reputation may also be invoked against this phenomenon, provided the prerequisites hold, even if there has been no registration, since *«this extension of protection is founded not on registration but on a factual element i.e. the actual presence of the sign on the market»*. As for the protection of the non-registered Community model, the essay likewise stresses that it is *«conditional upon the fact that proof is provided that the requisites for access to protection hold»*, thus placing a particularly heavy burden of proof on the party seeking protection as is the case, from this perspective, with the protection of a non-registered mark.

7. This year too EU case law has made significant pronouncements in the whole area of distinctive signs.

Of particular interest, also from the conceptual perspective, is a ruling relating to an unusual case of a shape mark which could maybe be better termed *«a mark without a shape»*. In fact, the sign for which protection was sought concerned *«all imaginable shapes of a transparent bin or collection chamber forming part of the external surface of a vacuum cleaner»*, i.e, the idea of making this chamber transparent. The ECJ, however, denied the possibility of registering a simple idea such as this as a mark, stating that *«the subject-matter of the application at issue in the main proceedings is, in actual fact, a mere property of the product concerned and does not therefore constitute a 'sign' within the meaning of Article 2 of the Directive»* ⁽³⁰⁾. The strict interpretation given by the Court so far of the notion of capacity for graphical representation ⁽³¹⁾ probably made this decision inevitable. However, it may be asked whether the outcome would have been different if the proprietor had applied for registration of the transparence as a color mark, but had then actually applied it only to one part of its product or, even better, if it had applied for registration of a specific (non-functional) shape for the collection chamber of its vacuum cleaner, indicating in the application that the chamber had to be transparent (and possibly claiming possible acquisition of secondary meaning), only to then also claim protection against different shapes, but likewise transparent, on the grounds that they too could be perceived by the public as a reference to its sign.

Again on shape marks, the ECJ confirmed – citing its previous decision in the Philips/Remington case⁽³²⁾ – that acquisition of distinctive character cannot qualify for protection a mark composed of a shape which gives substantial value to a product, and this even if, as proposed by the remitting Court (the Hoge Raad of the Netherlands), *«prior to the application for registration, it acquired attractiveness as a result of recognition of it as a distinctive sign»* ⁽³³⁾. In this case too the question

⁽²⁹⁾ BOGNI, *La tutela della forma tra design non registrato, marks di fatto, concorrenza sleale*, in *Riv. Ord. Consulenti*, March 2007.

⁽³⁰⁾ ECJ, 25 January 2007, C-321/03, points 39 and 40 of the grounds.

⁽³¹⁾ See in particular, on the question of smell marks, ECJ, 12 December 2002, C-273/00, points 50 and 51 of the decision.

⁽³²⁾ ECJ, 18 June 2002, C-299/99.

⁽³³⁾ ECJ, 20 September 2007, C-371/06. Again on the question of shape marks the rulings of 4 October 2007, C/144/06 P, and 25 October 2007, C-238/06 P, are at least worth mentioning. They stress (but always at the stage of examining the novelty of new marks, thus not baptized by the market) that usually – and regardless, obviously, of the possible acquisition of secondary meaning following use – only shapes that are significantly different from the usual ones in the sector may be perceived as marks by consumers.

received the obligatory reply. However, we possibly have to ask whether it may be that a shape *per se* is initially appreciated by the public (and as such confers substantial value on the product) and then loses this value, and is appreciated by the public only as a sign, so that for the public the attraction of the shape is determined, not only «*principally*», as proposed by the Dutch court, but entirely «*as a result of recognition of it as a distinctive sign*». This is not beyond the realm of possibility given that, as has already been noted, the public's perception of the shape of products is, to a large extent, influenced by communications.

8. The two most important decisions on trade mark protection are most certainly those issued in the «Opel» and «Celine» cases. The first concerned the possibility of seeking protection for a motor vehicle mark (which was also registered for toys) against its use on scale models of the original cars. The second concerned the protection of a mark against its use in the business name of a non-authorized party.

The two decisions first of all gave a restrictive interpretation of art. 5.1.a) of EC Directive 89/104 (to which art. 20.1.a) C.I.P. corresponds), stating that the protection of a mark against the use of a identical sign for identical goods may be sought only if the use by the third party «*affects or is liable to affect the functions of that mark*»⁽³⁴⁾. This is debatable, given the wording of the article, which only requires identity of signs and of goods or services bearing the signs. However, it is most certainly in line with the general trend in EU case law in trade mark matters, which has so far given an interpretation of the Directive and the Community Trade Mark Regulation which stresses all the elements of the actual case which may affect the real perception of the marks of the relevant public, discarding all the «abstract» criteria which were followed in individual national court rulings and thus stressing what the mark actually represents, or rather, communicates on the market⁽³⁵⁾. It seems that

⁽³⁴⁾ ECJ, 25 January 2007, C-48/05 (Opel), point 22 of the grounds and ECJ, 11 September 2007, C-17/06 (Celine), points 16 and 26 of the grounds. In actual fact, this aspect emerges less clearly in the Opel decision, in which – as was stressed in one of the first comments on this decision – reference to the detriment to the functions of the mark «seems to allude to the need for the national Court to ascertain if reproduction of another's mark on the model is perceived by the public as the affixing of a distinctive sign on same, and not as the reproduction of a 'substantial' element which is needed to make the scale model car perfect», as is confirmed by the fact that in another passage from the grounds the Court observes that, if the national Court held that «the relevant public does not perceive the sign identical to the Opel logo appearing on the scale models as an indication of origin [...], it would have to conclude that the use at issue does not affect the essential function of the Opel logo as a trade mark registered for toys» (BOGNI, *Il marchio dei modellini di automobili*, in IDI, 2007).

⁽³⁵⁾ For further study of these aspects from a systematic perspective see GALLI, *I marchi nella prospettiva del diritto comunitario: dal diritto dei segni distintivi al diritto della comunicazione d'impresa*, cit. and ID., *The Scope of Trade Mark Protection and the «New» Trade Mark Infringement*, in *ECTA Gazette*, 2006. This year the ECJ, in relation to ascertainment of the likelihood of confusion – and essentially to Community trade marks examined by the OHIM Opposition Board and then at the stage of appeal against its decisions – has issued a number of rulings which stress that for these purposes a «global assessment of the likelihood of confusion» has to be carried out which «must be based on the overall impression created by the signs at issue, bearing in mind, in particular, their distinctive or dominant components». Particularly significant rulings in this perspective are ECJ 13 September 2007, C-234/06 P (which cited, with approval, in point 36 of the grounds, the arguments put forward by the Court in denying importance to the aural similarity between the two marks in suit, and based on «the manner in which the goods in question are marketed, so that, when making a purchase, the relevant public usually perceives visually the mark designating those goods»; and still more significantly, in point 64, it excluded the possibility that mere registration, not followed by use, of a series of marks which possessed a common element, may affect the assessment of the likelihood of confusion with them of a later mark on the basis of the «series marks» theory, in that, as the Advocate General stressed in his conclusions, «no consumer can be expected, in the absence of use of a sufficient number of trade marks capable of constituting a family or a series, to detect a common element in such family or series and/or to associate with that family or series another trade mark containing the same common element. Accordingly, in order for there to be a likelihood that the public may be mistaken as to whether the trade mark applied for belongs to a 'family' or 'series', the earlier trade marks which are part of that 'family' or 'series' must be present on the market»); of 12 June 2007, C-334/05 P (which overturned the decision of the Court of First Instance because it limited itself to «taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark

the other assertion of principle contained in the «Celine» ruling must also be read in this way. In remitting to the national court ascertainment of the fact that use of a mark within the business name of a non-authorized third party (operating in the same sector as that for which the imitated mark was registered) constitutes use of an identical sign for identical goods or services, the Court stated that *«even where the sign is not affixed, there is use 'in relation to goods or services' within the meaning of that provision where the third party uses that sign in such a way that a link is established between the sign which constitutes the company, trade or shop name of the third party and the goods marketed or the services provided by the third party»* ⁽³⁶⁾.

From the same perspective, it is significant that in the «Opel» decision the ECJ went beyond the requests of the remitting Court and tackled, so as to say, *ex officio* the question of the possible application of art. 5.2 of the Directive to the model cars case, i.e. the provision which admits protection of a mark with a reputation beyond the likelihood of confusion, observing that *«first, the Opel logo is also registered for motor vehicles; secondly, subject to verification by the referring court, it is a trade mark well known in Germany for that kind of product, and, finally, a motor vehicle and a scale model of that vehicle are not similar products»*; and that *«Therefore, the use at issue in the main proceedings (i.e. the use for scale models: writer's note) is also capable of being prohibited, in accordance with Article 5(2) of the Directive, if such use without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of that trade mark, registered for motor vehicles»* ⁽³⁷⁾: thus confirming that it is precisely to the protection of the repute of the mark that courts must refer in all cases in which there is no actual likelihood of confusion on the market, instead of resorting to abstract and fictitious constructions.

Again on the subject of revocation of a mark due to non-use, the ECJ has, in some way, brought to a conclusion a discourse which was begun in the last few years, in which it had always stressed that uses which can avoid revocation are those *«viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark»* ⁽³⁸⁾. This year the ECJ examined the question of «proper reasons» for non-use of the mark, observing first of all that this notion needs to be given the same meaning in all Member States, and interpreting it restrictively, also in the light of the eighth «recital» of EC Directive 89/104 (which states that, *«in order to reduce the total number of trade marks registered ... in the Community ... , it is essential to require that registered trade marks must actually be used or, if not used, be subject to revocations»*). *«It appears in the light of that recital – the ECJ observed – that it would be contrary to the scheme of Article 12(1) of the Directive to confer too broad a scope on the concept of proper reasons for non-use of a mark. Achievement of the objective set out in that recital would be jeopardized if any obstacle, however minimal yet none the less arising independently of the will of the owner of the trade mark, were sufficient to justify its non-use»*. The Court went on to state that not all obstacles blocking use

may not, in certain circumstances, be dominated by one or more of its components», and «it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element»: points 40-42 of the grounds); and 26 April 2007, in C-412/05 P (which in relation to pharmaceutical products sold by doctor's prescription, held that it was still necessary to assess likelihood of confusion also for end users since «even though the choice of those products is influenced or determined by intermediaries, such a likelihood of confusion also exists for those consumers since they are likely to be faced with those product, even if that takes place during separate purchasing transactions for each of those individual products, at various times»: point 58 of the grounds).

⁽³⁶⁾ ECJ, 11 September 2007, C-17/06, *cit.*, point 23 of the grounds.

⁽³⁷⁾ ECJ, 25 January 2007, C-48/05, *cit.*, point 37 of the grounds. BOGNI again writes in this regard in *Il marchio dei modellini di automobili*, *cit.* that «The 'counter-position' between art. 5.1 of the Directive and art. 5.2 outlined by the Court seems therefore to suggest the idea that there are two possibilities i.e. either the mark is a sign pure and simple, perceived as such but still without significance and an ulterior message (and so it is protected by the legal system only as a sign, and only against use of another sign which affects – like the use of the same name for different people – the function of identifying the goods bearing the imitated mark); or the mark has acquired repute on the market and its potential as a real, complete and synthetic instrument of communication has therefore become active: and so this acquired function must be completely protected against any action which could affect it, by infringing same, and in particular against all forms of parasitic linkage which allows a third party to appropriate the value the mark has been given by the proprietor».

⁽³⁸⁾ ECJ, 11 May 2006, C-416/04 P, cited in the previous edition of GALLI, *Segni distintivi e industria culturale*, in AIDA, 2006.

could constitute proper reasons for non-use of a mark, even if these obstacles «arose independently of the will of the proprietor of the mark», but only those which render use of the mark «impossible» or at least «unreasonable», in the sense that «if an obstacle is such as to jeopardize seriously the appropriate use of the mark, its proprietor cannot reasonably be required to use it none the less»; to then conclude, in general terms, that «only obstacles having a sufficiently direct relationship with a trade mark making its use impossible or unreasonable, and which arise independently of the will of the proprietor of that mark, may be described as ‘proper reasons for non-use’. It must be assessed on a case-by-case basis whether a change in the strategy of the undertaking to circumvent the obstacle under consideration would make the use of that mark unreasonable. It is the task of the national court or tribunal, before which the dispute in the main proceedings is brought and which alone is in a position to establish the relevant facts, to apply that assessment in the context of the present action»⁽³⁹⁾.

9. In a previous edition of this review, in commenting on a number of court decisions which had stressed how the title of the work was not an intellectual work but was of the nature of an accessory with the function of distinguishing the intellectual work itself, it was observed that even if this assertion is most certainly correct in general terms it cannot be excluded that in particular cases the title too participates in the creative character of the work distinguished by the title and is thus eligible for protection together with the work (also) as the subject of copyright⁽⁴⁰⁾. This theme has now been examined more deeply in an essay which stresses how, firstly, «a case in which the title of the work performs the typical function of a ‘name’, i.e. an instrument identifying the work itself aimed at marking it and distinguishing it from all the others, (must be differentiated) from a case – infrequent, but theoretically possible – in which the title possesses the necessary requisites, of novelty and expressive completeness, to be defined per se an intellectual work»⁽⁴¹⁾, stating that a further case which cannot be overlooked is that in which the title does not simply identify the work but is an integral and necessary part of it, fully participating in its creative character as in certain poetic compositions for which «to conceive of the title as something external to the work which it identifies would prevent ... the fullness of the artistic creation from being captured and its due protection from being assured»⁽⁴²⁾: and on this basis it criticizes, due to the fact that it is worded in too absolutist terms, the recurrent assertion made in case law whereby the title should never be considered an integral part of the work.

Another essay published this year, again regarding titles, calls attention to the fact that the scope of protection given to the titles of intellectual works by art. 100 Copyright Law is that of «not giving rise to confusion as to the work, thus its origin, its author, its provenance and its contents», from a perspective which is not yet that of competition and the market but rather that of the protection of the work per se; when, however, «the work is inserted within a business organization so that it becomes a publishing product, necessitating protection of the work not only per se but against works of the same kind which are to be found on the market», as typically happens with periodical publications, the title becomes «able ... to identify the source as the publisher-entrepreneur», and in this case compounding protection of the title and that of the registered and non-registered mark is most certainly admissible, since «definition of a name as a mark depends upon the function it performs: if the name attributed to an intellectual work also actually performs the typical function of marks, it is (also) a mark», so, for example, «the well-known title of a famous film» could also be

⁽³⁹⁾ ECJ, 14 June 2007, C-246/05 («Häupl/Lidl»), points 51-54 of the grounds.

⁽⁴⁰⁾ 2005 edition of GALLI, *Segni distintivi e industria culturale*, in *AIDA*, 2005, p. 240, in relation to a number of rulings (Court of Milan, 22 September 2004, Court of Milan, 10 March 2005 e Court of Rome, 16 June 2004), which on this basis had denied that a «moral right (of paternity) of the author» existed in relation to the title.

⁽⁴¹⁾ MARI, *Possibile tutela dei titoli delle opere dell'ingegno*, in *Dir. aut.*, 2007, 422 ff., pp. 422-423, who cites, as examples of this second and rarer situation, the elaborate titles of a number of films directed by Lina Wertmüller. The author also states (pp. 434-435) that in the Italian film world «a Titles Office» has been set up at «ANICA in order to ensure a sort of ‘conventional IP right’ on the use of a certain title even before release of the film to which the title refers», while in the music field the new SIAE Regulation will expressly provide for the possibility of refusing to administrate «titles of works which may create confusion, for the purposes of administration on the part of the Society, with pre-existing titles of musical works».

⁽⁴²⁾ MARI, *op. cit.*, 424-425, who cites the famous short lyric poem of Giuseppe Ungaretti entitled «Mattina» («M'illumino / d'immenso»), observing that «this marvelous combination of words would not have the same meaning and would not get the same emotional reactions if it was deprived of its title which helps to reveal its sense and greatness».

protected against uses not leading to a likelihood of confusion which give rise to unfair advantage or detriment as provided by art. 20.1.e) and art. 12.1.f) (and g) C.I.P. ⁽⁴³⁾. In actual fact, the protection of the famous title of an intellectual work also beyond a likelihood of confusion may be inferred from art. 8.3 C.I.P., which proscribes registration (and also, according to authoritative case law and legal theory, use) as marks of signs which are well-known in an extra-commercial field, without the consent of the entitled party ⁽⁴⁴⁾. However, it is precisely this fact which confirms that protection against parasitic exploitation of the distinctive character and repute of trade marks under Italian law is not of an exceptional nature, but responds to the need – which becomes a general principle of the system of protection for distinctive signs – to make their protection commensurate with the function actually and legitimately performed by them on the market.

The Supreme Court has handled two cases involving titles of publications and their rulings have been commented and published in Italian legal reviews. Both rulings upheld the appealed decisions, which had emphasized the actual circumstances in which the opposing signs (in one case also registered as marks) were used, in order to rule out likelihood of confusion. From this viewpoint, it should not be emphasized the circumstance that the former asserted, that in this context what was important was *«the possibility that the public, misled by the similarity between the titles, would mistake one work for another»*, i.e. what in trade mark matters is called likelihood of confusion between goods, since also the possibility that *«the erroneous conviction»* that the second publication is *«a sort of editio minor of the published periodicals»* from the publishing house which issues the first, and thus a likelihood of confusion as to origin is engendered in the public mind, is properly considered (and ruled out in the case in point) ⁽⁴⁵⁾. Likewise, the second decision examined the notion of product affinity, observing that what counts in this regard is that *«the goods or products in question be sought and bought by the public for identical reasons or, at least, reasons which are closely linked: so the functional affinity between those goods or products (and between the relative product sectors) leads the consumer to naturally assume that they come from the same producer, even irrespective of the merely extrinsic fact constituted by any identity in marketing channels»* ⁽⁴⁶⁾.

However, in singular contrast to these assertions, and to those of legal theorists, the Court of Rome confirmed its stance aimed at distinguishing the protection offered by art.100 and art.102 Copyright Law, as if the former only proscribed the adoption of identical titles and the latter also that of newspaper titles which may be confused ⁽⁴⁷⁾. It has, however, already been observed ⁽⁴⁸⁾ that it seems more precise to understand both articles as specifications, in the publishing sector, of art. 2598.1 Civil Code, in the sense that the former (art. 100 Copyright Law) protects the title per se whilst the latter (art. 102 Copyright Law) protects the newspaper title, i.e. its graphic form, and more generally the external appearance of the intellectual work: both therefore aimed at repressing not only the complete imitation of the sign but also adoption of a similar sign, in that it may create confusion between the works or as to their origin.

⁽⁴³⁾ AMODEO, *I criteri per la tutela del titolo dell'opera dell'ingegno*, in *Dir. aut.*, 2007, 155 ff.

⁽⁴⁴⁾ For a full study of the question and the appropriate case law and theoretical references see GALLI, *La tutela contro il parassitismo nel «nuovo» Codice della Proprietà Industriale*, in Various Authors, *Il progetto di novella del CPI – Le biotecnologie*, edited by UBERTAZZI, Milan, 2007, p. 105 ff.

⁽⁴⁵⁾ Supreme Court, 26 January 2006, no. 1636, in *Riv. dir. ind.*, 2006, II, 331 ff. (with note by CALLEGARI, *Tutela del titolo, della testata editoriale, delle rubriche e limiti di applicazione dell'art. 2598, n. 3 c.c. alle vendite sottocosto di giornali panino*), which upheld the ruling of the Court of Appeal of Milan, 18 May 2001, discussed and commented in the 2002 edition of GALLI, *Segni distintivi e industria culturale*, in *AIDA*, 2002, pp. 330-331.

⁽⁴⁶⁾ Supreme Court, 27 September 2006, no. 21013, in *Foro it.*, 2007, I, 815 ff., which upheld the ruling of the Court of Appeal of Milan, 8 May 2001, also discussed and commented in the 2002 edition of GALLI, *Segni distintivi e industria culturale*, in *AIDA*, 2002, p. 331.

⁽⁴⁷⁾ Court of Rome, 14 February 2006, in *Dir. inf.*, 2007, 301 ff., with note by CLEMENTE, *Confondibilità delle testate e concorrenza sleale*. In the case in question, the titles of the publications of the plaintiff (held ineligible for protection since they lacked distinctive character) were «Giochi Puzzle», «Giochi Enigmistici» and «Quiz Puzzle», while those of the defendant were «Collana Giochi Puzzle», «Collana Giochi Enigmistici» and «Puzzle e Quiz».

⁽⁴⁸⁾ In the 2003 and 2005 editions of GALLI, *Segni distintivi e industria culturale*, in *AIDA*, 2003 and 2005, commenting on the rulings of the Court of Rome of 5 February 2003 and 28 November 2004, which had expressed the same distinction as that expressed here by the Court of Rome.

10. The consolidation of case law in domain name matters is also confirmed by a waning of attention on the part of legal publications, which now normally consider domain names used in economic activity («*aziendali*», to adopt the awkward term used in the C.I.P. to refer to them) in the same way as other business distinctive signs.

Remarkably, maybe the most interesting decision comes from the Regional Administrative Court of Tuscany, which ordered the *Consiglio Nazionale delle Ricerche – Istituto di Informatica e Telematica – Registro dei ccTLD «.it»* to make the Register held by the body accessible to a well-known bank, notifying it of all the domain names which differ only in one or two letters from its own, in order to allow it to «*prepare action to defend its interests, given that domain names constituting typo-squatting activities may well harm its image*»⁽⁴⁹⁾. *Typo-squatting* is the adoption of domain names which differ only in one or a few alpha-numerical elements from pre-existing ones, used for distinguishing well-known sites and individuals. Their aim is to re-route surfers, who have made a simple keying mistake while trying to type the domain name of the original, to the sites bearing these names. This is therefore a clear attempt to profit from the repute of another's distinctive sign (in this case the domain name, normally – but not necessarily – corresponding to a registered mark), which may also cause detriment to the proprietor of the mark (especially when the typo-squatter sites are used not only as advertising vehicles but also to carry out scams⁽⁵⁰⁾) and legal theorists had already stated that it was unlawful from this perspective⁽⁵¹⁾.

A French ruling relating to an issue still much discussed – provider liability – has given rise to an analysis of the basis of this liability under Italian law⁽⁵²⁾. The conclusions are essentially in line with those already expounded in previous editions of this Review, also in the light of the legislation introduced by Legislative Decree 9 April 2003, no. 70, in implementation of EC Directive 2000/31, and quote with approval the assertions contained in a decision of the Court of Catania, whereby the Internet Service Provider should have «*subjective liability: negligent if the provider, aware of the presence of suspect material on the site, fails to ascertain unlawfulness and remove it; willful if the provider is also aware of the unlawfulness of the agent's conduct and fails to intervene*»⁽⁵³⁾.

CESARE GALLI

ABOUT US

✓ *Professor Cesare Galli called onto the Committee for Revision of the Copyright Law*

Last October Professor Cesare Galli was appointed member of the **Committee for Revision of Copyright Regulations and Legislation**, set up at the permanent Commission on Copyright Law chaired by Professor Alberto Gambino. The Committee is a group of experts which assists the Commission in its work.

⁽⁴⁹⁾ Regional Administrative Court of Tuscany, 24 January 2007, in *Dir. Internet*, 2007, 381 ff., with note by TACK, *Il T.A.R. Toscana riconosce la capacità lesiva dell'attività nota come typosquatting*.

⁽⁵⁰⁾ In the note by TACK, *cit.* full consideration is given to these possibilities, including in particular that of «*creating email boxes with addresses similar to those of large companies with the possibility therefore of being able to intercept a good number of the emails sent to the address of the targeted company, permitting typo-squatters to create, without great effort, an ample database of email addresses which can be used for aggressive spamming campaigns*»; and underlines «*the developments that have affected the right to privacy*», also in relation to threats posed by new technology, and thus understood today as including the right to personal identity.

⁽⁵¹⁾ Expressly in this sense see GALLI, *I domain names nella giurisprudenza*, Milan, 2001, pp. 50-51, who cites in US legal theory SOMA, *Computer Technology and the Law*, 1999 Supplement, St. Paul, 1999, p. 30. In case law, Court of Parma, interim order 22 January 2001, in GALLI, *I domain names nella giurisprudenza, cit.*, no. 70 referred to the methods followed by surfers in digitation, in order to work out the substantial identity of a mark or domain name.

⁽⁵²⁾ BERLIRI-LA GUMINA, *La (non) responsabilità di eBay per gli illeciti commessi dai propri utenti*, in *Dir. Internet*, 2007, 342 ff. (note to the Court of *Gr. Inst. Grenoble*, 1 February 2007, *ibidem*, 339 ff.).

⁽⁵³⁾ Court of Catania, 29 June 2004, cited in the 2004 edition of GALLI, *Segni distintivi e industria culturale in AIDA*, 2004.

✓ *The work of Professor Cesare Galli in the High Commission for the Fight against Infringement*

In the work carried out by the High Commission for the Fight against Infringement, aimed at coordinating the tasks of the various bodies dealing with this matter, Professor Cesare Galli – who has, since its inception, been a member of the **Technical Committee at the High Commission for the Fight against Infringement**, i.e. the small group of experts who assist the Commissioner in his work – has mainly handled the **adaptation of legislation** to the needs created by «new» infringement, namely the forms of parasitical exploitation of another's IP rights and the updating of criminal substantive and procedural rules in infringement matters.

In this regard, Professor Galli has dealt, *inter alia*, with the **destruction of goods which have been subject to criminal and administrative seizure** and has assisted in drafting the rules of the «**anti-infringement package**», now being discussed in the Senate, including in particular the rule which provides for renewal of the delegation for **revision of the CIP**, laying down its criteria in such a way as to incorporate the proposals already made by the Commission set up in the previous legislature. At the same time, Professor Galli has been involved in ratification of **EPC 2000** (which was then carried out in time, as stated in the first part of this Newsletter) and cancellation of the unlawful rules in matters of **patent revocation** which had been contained in Ministerial Decree 3 October 2007.

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✓ *The Chambers «The World's Leading Lawyers for Business» Guide once more includes our firm amongst the leading IP law firms, declaring Professor Cesare Galli to be one of the «number 1» lawyers in this field and again indicating Ms Bogni as a leading Italian IP lawyer*

A year ago the Chambers Guide **ranked Professor Cesare Galli among the six «Number 1» IP lawyers** in Band 1 of the indicated lawyers. This judgment was **very recently confirmed by the Chambers Global Guide 2008**, which has just been published and can also be found at www.chambersandpartners.com. The firm as a whole was also indicated by the Guide as being among the top sixteen IP law firms, and of these it is one of the few to have two leading individuals listed.

There follows the comment of «*Chambers Globals*» on our firm: «**This six-lawyer boutique is highly regarded on the market due to the academic reputation and commercial nous of lead partner Cesare Galli. Clients are pleased to work with a firm that is 'neither small nor too big' and has lawyers whose approach is 'clear, direct and decisive'. The personal involvement of the name partner is also highly appreciated by interviewees.**

«**Cesare Galli** is held in high esteem by the Italian IP scene for what one interviewee called the '*rare quality of combining a high level of knowledge of his subject with a practical and dynamic approach*'. He recently assisted the Italian authorities in preparing a reform of the national IP laws and has acted as chairman of a working committee on trade marks and geographical indications at the AIPPI Congress. **Mariangela Bogni** is described as a '*very determined, well-prepared*' IP lawyer.

«**Recent trade mark cases include acting for an Italian manufacturer in the protection of a non-registered trade mark and a luxury goods producer in the protection of trade marks with a reputation against denigration. Copyright work has included the revision of contracts for a leading international scientific publisher from the point of view of Italian law. Other clients include Bulgari; Pharmaland; Enoitalia; Gestweb and IMA.**

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✓ *Caterina Paschi joins the team of the Milan offices of our firm*

The legal team of highly specialized IP lawyers at the Milan head office of our firm continues to grow. Following the arrival of Alberto Contini in April, the team was further strengthened by the entry of **Caterina Paschi** in September. She joins our firm after accumulating wide experience in Italian and foreign firms involved in the **fight against infringement**, in particular in **software** and **copyright** matters. She was most recently in Studio Jacobacci & Partners of Milan, where she principally handled **IP litigation**.

Caterina Paschi directly assists Professor Galli, dealing in particular with trade mark, competition and copyright litigation.

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✓ *Another Associate of our firm comes first in the IP and Competition Research Doctorate*

Alberto Contini, who since last April has been an Associate with our Milan office, came **first in the public examination for admission to the XXIII series of the IP and Competition Law Research Doctorate** announced by the Associated Universities of Parma and Florence. This is the only Italian research doctorate exclusively dedicated to furthering IP studies.

Mr. Contini's written dissertation on **non-distinctive uses of another's trade mark** received particular high praise.

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✓ *The Review Top Legal interviews Professor Cesare Galli on the new EU rules on nutritional and health information labeling on products*

The September 2007 issue of *Top Legal* featured a long interview with Professor Cesare Galli in the context of an article on the **new EU legislation on nutritional and health information labeling on products**. In the interview, Professor Galli stressed in particular that *«in addition to the interest in protecting consumers' health against misleading advertising, this legislation has another important propelling force: to ensure that the **product can always use the same claims, even abroad**. Prior to these new rules, if, for example, a number of strongly redolent slogans were not admitted in France, an Italian producer would have had to replace the packet labeling with another which complied with French legislation. If it failed to do so it could face sanctions. The new legislation means that the messages on the labeling will, at the most, be translated into different languages»*.

Professor Galli also highlighted the need not only for multinationals, but also small and mid-sized firms, to equip themselves to avoid litigation, observing that *«such an articulated directive providing for an **extremely lengthy series of deadlines and interim provisions** of necessity requires the reading of a lawyer and the advice of food technicians may not suffice»*.

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✓ *Recent IP decisions obtained by our firm*

Trade Marks: Protection against linkage

The Court of Milan, in its decision of 27 August 2007 drawn up by Dr Marangoni of the Specialized IP Division, issued a **seizure order** and **injunction** and ordered that the entire Autumn-Winter 2007-2008 «Upstar» clothing collection be withdrawn from the market, ruling that the trade mark infringed the well-known beachwear trade mark «Pin Up Star», whose proprietor was assisted by our firm, on the grounds of the *«indisputable **linkage**»* which use of the contested trade mark made of the prior trade mark and the consequent *«objective confusing effect ... principally to be found in the perspective of **likelihood of association** between the two trade marks and between the activities of the respective*

proprietors»: all on the basis of a **solid examination** of the **perception of the two trade marks by the relevant public**.

The decision and our petition are published in full in the «The Case» section of this Newsletter.

The specialized press also covered the case. A long commentary was published in the financial daily *Italia Oggi* and on www.panorama.it.

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Trade Marks: Infringement by a disloyal licensee

The Specialized IP Division of the Court of Florence, in a decision of 5 September/12 October 2007 ruled that two registered trade marks, a registered trade mark and business name belonging to a well-known firm operating in the field of construction site security, assisted by our firm, were infringed by way of the **use of the denominative component of these trade marks by a disloyal licensee**. Protection was recognized by the Court regardless of the question concerning the continuing validity of the license agreement, in application of art. 22.3 C.I.P. which **permits the proprietor of the trade mark to bring an action also against the licensee who is in breach** of the contractual terms relating to duration, method of using the trade mark, nature and quality of the goods or services bearing the trade mark and the territory covered by the license.

On these grounds the Court of Florence issued an **injunction** against further use of the trade marks in question, **seizure** of the materials on which the trade marks were affixed and the **accounting books** showing the extent of such use, also for purposes of assessing compensation.

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Trade Marks: Injunctive protection against breach of delimitation agreements

The Court of Brescia, in its decision of 6 November 2007, not contested, **awarded interim protection** to trade marks based on the name «Franciacorta» belonging to the most important Italian grappa producer, assisted by our firm, against the use of trade marks comprising the same name by another grappa producer, in **breach of an agreement** whereby the latter undertook to cease use of these trade marks and to use the expression «Franciacorta» only in the context of **descriptive expressions which are clearly distinct from the trade mark**. In particular, the Court stated that use of the expression «Distillatori dal 1978 in Franciacorta» *«in a completely adjacent position»* to the imitator's complex trade mark so as to appear to the public as *«part of it»* could not be considered such a use. The Court also ruled that **injunctive protection of the delimitation agreement was admissible** observing, *inter alia*, that *«the breaches directly attack the specific obligations undertaken by the defendant and their assumed inability to cause damage is refuted by the circumstance that on the question of the use of the word 'Franciacorta' the parties drew up an agreement and in doing so they clearly demonstrated that they attributed financial importance to it»*.

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Trade Marks: Revocation through non-use

The Specialized IP Division of the Court of Milan, in a final ruling of 20/28 December 2007, settled a dispute relating to the **«Isotta Fraschini» trade marks in the luxury goods sector**, finding in favor of the only business actually using them in a commercial activity (Isotta Fraschini Milano s.r.l., assisted by our firm). The Court had already issued a ruling on the affair in 2006, which had in the meantime become final, which declared that a series of prior corresponding trade marks, again registered for luxury goods by another business, had **been revoked through non-use**.

The new ruling relates to a further trade mark concerning the same mark, again unused, which the proprietor claimed had not been revoked, stating that non-use was «justified» by the fact that the case was pending. However, the Court rejected this argument, maintaining that **«the dispute comes within the normal risks of business»** and therefore does not justify the inactivity of the **entrepreneur**. Therefore, the ruling appears to be in line with the position of the ECJ which stated

«only obstacles having a direct relationship with a trade mark which makes its use impossible or unreasonable and which are independent of the will of the proprietor of that mark constitute 'proper reasons for non-use of the mark'» (ECJ., 14 June 2007, C-246/05, «Häupl/Lidl»).

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Patents: Repeating a technical expertise

In its ruling of 25 October 2007, the Specialized IP Division of the Court of Milan **admitted our petition for another technical expertise** in a case concerning the validity and infringement of a patent belonging to a US company, assisted by our firm, specializing in the production of plastic products for biomedical use. The first technical expertise held the patent null. An **Objective Technical Report** drawn up on the basis of the *AIPPI Italia* Code was also submitted in support of the petition.

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Patents: Connection of cases

In its ruling of 4/11 October 2007, the Specialized IP Division of the Court of Milan, in admitting a plea from the defendants, one of whom was assisted by our firm, declared its **lack of jurisdiction on the grounds of connection** in a patent case of infringement and nullity, brought after another case was already pending before another specialized division (that of Bologna). In this latter case, the same plaintiff had summonsed other alleged infringers producing the same products as those summonsed before the Court of Milan, with whom they had commercial relations and who had, in turn, sought in counterclaim a finding that the patent was null. The Court admitted our argument that in this situation there was an **«objective connection which prescind the non-identity of the parties»**, ordering the plaintiff to **refund costs**, on the basis *«that it was the losing party and was responsible for bringing the case, to be assessed (also) with regard to the repeated duplication of procedural activity»*.

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Designs and models: Non-protectability of a «combination» model against a product which does not copy the dominant feature of the protected combination

The Court of Milan, in its ruling of 30 August 2007, issued by Dr Marangoni of the Specialized Division, later upheld at appeal with another ruling of 25/27 October 2007, dismissed requests for an interim injunction and seizure order against a well-known Brescian tap manufacturer, assisted by our firm. The Court admitted our argument, stating that **infringement of a model is ruled out when the allegedly infringing product does not copy the features with which the general impression given by the protected model is principally associated**, which represents *«the prevailing characterizing visual feature»*.

The ruling issued at appeal also ruled out the possibility of re-examining the case from the perspective of unfair competition, confirming, as we argued, that **protection against unfair competition given to shapes presupposes that they are distinctive and non-functional**.

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Competition: Use of images from the catalogue of a licensor on the website of a disloyal licensee

The Specialized IP Division of the Court of Florence, in its previously mentioned decision of 5 September/12 October 2007, also admitted our arguments that the use of photographs and materials taken from the catalogues of a competitor constituted unfair competition, on the grounds of **appropriation of qualities**, and at any rate that such behavior ran contrary to fair business practice. The case was particular in that the tort was committed by a licensee whose agreement had not yet been terminated. The Court ruled its conduct unlawful on the grounds that, in breach of the agreement, it sold goods which did not come from the licensor and thus unduly associated its goods with the qualities of the licensor's goods and activity.

Competition: non-authorized use of photographs of a competitor's products and breach of settlement

The Court of Milan, in a ruling of 20/25 September 2007, ruled that a manufacturer of rotating oleodynamic distributors was guilty of unfair competition to the detriment of a competitor, a leading firm in the sector at international level and assisted by our firm, in relation to the **use of photographs of the latter's products modified in such a way as to pass them off as products of the former**. In admitting our case, the Court ruled that this behavior constituted «*undue accreditation with respect to the production of a type and variety of goods which do not (yet) correspond to actual planning and manufacturing carried out so far*» and thus an act of unfair competition pursuant to art. 2598, 2 and 3 Civil Code, regardless of the fact that the goods were neither patented nor covered by trade secret.

The Court also ruled that this conduct (and the delay in publishing the correction) **breached a settlement** between the parties, relating to a similar case, and ordered the defendant to pay the **fine** provided in the settlement for repeating the tort.

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International IP work of the firm

Our firm has been instructed to **coordinate and supervise a number of important international IP litigations**, achieving significant success. In particular, on behalf of a leading firm in the production and sale of baby products, injunctions were awarded in Germany, Poland and Greece on the sale of **servile imitations** of a number of these products, made in China. Again in Germany, a **patent claiming** action brought against another important client of the firm, a leader in the production of capsules for coffee machines, was dismissed.

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✓ **Our latest publications and conferences**

The legal Encyclopedia *Il Diritto*, edited by Professor Salvatore Patti and published by *Il Sole-24 Ore*, invited Professor Cesare Galli to draw up the **Trade Mark** entry of the Encyclopedia, which appeared in volume IX.

The review *AIDA* has published two essays by Professor Cesare Galli: the first is composed of the annual review ***Segni distintivi e industria culturale***, which Professor Galli has published here since 1996, and of which we give a full summary in the «The Article» section of this Newsletter; the second is dedicated to ***I marchi nella prospettiva del diritto comunitario: dal diritto dei segni distintivi al diritto della comunicazione di impresa*** (*Trade Marks from the point of view of EC rules. From the law of distinctive signs to a new law of business communication*).

An essay by Professor Cesare Galli appeared in *Rivista di Diritto d'Autore* entitled ***Paternità e «non paternità» delle opere dell'arte figurativa tra diritti morali e interessi patrimoniali*** (*The Right of Assessing and Denying to Be Author of an Art Work. Moral and Economic Interests*).

The IPSOA review *Il diritto industriale* has this year published two essays by members of our firm, both currently following IP and Competition research doctorates: that of Mariangela Boggi, a full note ***Il marchio dei modellini di automobili*** (*Trade marks of car toys*), commenting on the decision of the ECJ in the «Opel» case; and that of Debora Brambilla, an article entitled ***Carattere individuale e capacità distintiva nella tutela delle forme registrate e non registrate*** (*Individual Character and Distinctiveness: the Protection of Registered and Unregistered Product Shapes*).

Professor Galli has also continued to publish his reflections on matters of **design** in his regular column in the specialized review *Luce e Design*.

On the suggestion of the Reporter General of **A.I.P.P.I.**, Professor Cesare Galli was appointed **Chairman of the International Working Group on Question Q 195** dedicated to the

Limitations of Trade Mark Protection, and in this capacity led the drafting of the Resolution which he then explained and successfully had passed during the meeting of the international Executive Committee (**EXCO**) held in Singapore in October.

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On 4 September 2007 Professor Galli presented a paper on **La proprietà industriale nel diritto comunitario** (*IP in the EC Law*) at the international conference *Settimana del Diritto Civile Comunitario* held at the University of Camerino.

On 28 September 2007 Professor Galli presented a paper on **Diritto comunitario dei marchi** (*EC Laws on Trade Marks*) at the conference *L'IP a 50 anni dal trattato di Roma: bilancio e prospettive* organized by the University of Pavia.

On 26 October 2007 Professor Cesare Galli chaired the annual IP law conference organized by the University of Parma, on **Trade Marks, Marketing, Advertising: law and communication strategies for businesses in the global market**, opened this year with a formal address given by Giovanni Kessler, the High Commissioner for the Fight against infringement. Professor Galli, in turn, presented a paper entitled **La tutela dell'immagine di marca contro free-riders, look-alike e parassitismo** (*Protecting Brand Equity against Free-Riders, Look-Alike and Parasitical Exploitation*).

On 13 December 2007 Professor Cesare Galli spoke at an international conference in Rome organized by the High Commissioner for the Fight against infringement on **La «nuova» contraffazione di marchio tra tutela civile, penale e amministrativa** (*The «New» Trade Mark Infringement. Civil, Criminal and Administrative Rules for Protecting Trade Marks in Italy*).

On 31 January 2007 il Professor Cesare Galli was invited to speak at the national conference of the A.I.C.I.P.I., the association of IP business consultants. He gave a paper on **Novità buone e cattive del diritto industriale nello scorcio del 2007: dal D.M. 3 ottobre 2007 al Pacchetto Anticontraffazione (passando per la possibile reintroduzione del rito societario)** (*What's New In Italian IP Law. From the Ministerial Decree of 3 October 2007 to the «Anti-Infringement Package», Passing through the Possible Reintroduction of the Company Procedure for IP Cases*).

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The Abstracts of the papers presented at the National IP Law Conference **Trade Marks, Marketing, Advertising**, held in Parma on 26 October 2007 and chaired by Professor Cesare Galli, are still available.

If you wish to receive these Abstracts or would like further information on this or the other conferences mentioned, email us at GALLI.PR@IPLAWGALLI.IT.

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CONCORRENZA SLEALE, ANTITRUST,
DIRITTO D'AUTORE), CONTRATTI
E DIRITTO COMMERCIALE GENERALE

IP LAW

(PATENTS, TRADEMARKS AND DOMAIN NAMES,
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