

BUZZI, NOTARO & ANTONIELLI d'OULX

Unauthorized use of trade-marks on the Internet:

*How can Trademark law Help?
An Italian perspective*

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Legal framework

Legal framework

Strategies for enforcing IP rights on-line

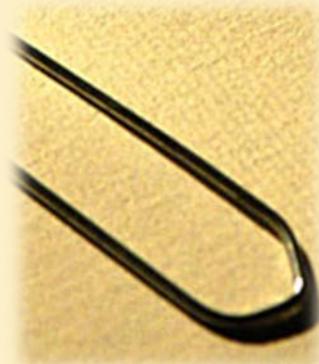
Practical Cases

Iwatch

Flos

Mediaset

Conclusions



- ❖ **21 Specialised IP divisions**
(D.Lgs. 27th june 2003, No. 168 - art. 1)
- ❖ **Code of Industrial Property**
(D. Lgs. 10th february 2005, No. 30)
- ❖ **Copyright law**
(L. 22nd april 1941, No. 633)
- ❖ **Criminal code**
- ❖ **Relevant EU regulations**

Strategies for enforcing IP rights on-line

Legal
framework

**Strategies for
enforcing IP
rights on-line**

Practical Cases

Iwatch

Flos

Mediaset

Conclusions



- ❖ Legal action before the Court
- ❖ Arbitration proceedings under the Uniform Domain Name Dispute Resolution Policy for gTLDs.
- ❖ Uniform Rapid Suspension System (URS) for new gTLDs (from 2013).
Domain Name Administrative Proceedings for ccTLD.it.
- ❖ In case of alleged unreasonable enforcement requests, a party can apply actions for a declaration of non-infringement

Practical cases

Legal
framework

Strategies for
enforcing IP
rights on-line

Practical Cases

Iwatch

Flos

Mediaset

Conclusions

Critical review on three recent actions before the Italian Courts

Examples of lawful and unlawful use of keyword advertising and domain name



Practical cases - Iwatch

Legal
framework

Strategies for
enforcing IP
rights on-line

Practical Cases
Iwatch

Flos
Mediaset

Conclusions



Probendi Ltd / Apple Inc., Apple Italia s.r.l

(Court of Milan - Order 14/12/2015 No. 40551)

Facts

- ❖ Probendi Ltd is the owner of an EU registration for the trademark IWATCH;
- ❖ The sign IWATCH was used by Apple and Apple Italia as a keyword in connection with goods which were definitely different from those of Probendi;
- ❖ The sign IWATCH was not mentioned/used either in the sponsored link or on Apple's webpage;
- ❖ Probendi asked the court to inhibit Apple and Apple Italia any use of the trademark IWATCH.

Practical cases - Iwatch

Legal
framework

Strategies for
enforcing IP
rights on-line

Practical Cases

Iwatch

Flos

Mediaset

Conclusions



Probendi Ltd / Apple Inc., Apple Italia s.r.l

(Court of Milan - Order 14/12/2015 No. 40551)

Lawful use of keyword advertising

The protection of the exclusive right must be reserved to cases in which a third party's use of the sign adversely affects or is liable to affect the functions of the trade mark (Interflora).

Use of a third party's trademark as Google keyword for advertising purposes is not an a priori infringing practice.

As usual, risk of confusion for the users must be the first issue to be assessed.

Practical cases - Flos

Legal
framework

Strategies for
enforcing IP
rights on-line

Practical Cases

Iwatch

Flos

Mediaset

Conclusions



Flos S.p.A. / Lightsten s.r.l

(Court of Milan - Order 23/11/2012)

Facts

- ❖ The well-known company Flos S.p.A. is the owner of a registration for the trademark FLOS, for lamps and lighting equipment;
- ❖ The sign FLOS was used by Lightsten s.r.l. as metatag and keyword for selling FLOS products on his website;
- ❖ Flos S.p.A. asked the court to inhibit Lightsten s.r.l. any use of the trademark FLOS.

Practical cases - Flos

Legal
framework

Strategies for
enforcing IP
rights on-line

Practical Cases

Iwatch
Flos
Mediaset

Conclusions



Flos S.p.A. / Lightsten s.r.l

(Court of Milan – Order 23/11/2012)

Unlawful use of keyword advertising

It is of course possible using a third party's trademark in order to identify the origin of the goods on sale on the website.

Any kind of communication on the net shall not generate the conviction that the user belongs to the commercial branch of the owner of the trademark, nor to aim at the appropriation of his values.

Practical cases – Mediaset

Legal
framework

Strategies for
enforcing IP
rights on-line

Practical Cases

Iwatch
Flos

Mediaset

Conclusions



Mediaset S.p.A. / Didier Madiba, Fenicius LLC WIPO Case No. D2011-1954

Facts

- ❖ Mediaset S.p.A. is the biggest Italian TV group, owner of several trademark registrations and domain names for MEDIASET;
- ❖ Fenicius LLC acquired the domain name www.mediaset.com after winning an auction;
- ❖ The domain name was inactive, showing a sign “Coming soon...”;
- ❖ Mediaset filed an administrative before WIPO and a court action before the Court of Rome regarding the same domain name, and they reached opposite conclusions.

Practical cases – Mediaset 1

Legal
framework

Strategies for
enforcing IP
rights on-line

Practical Cases

Iwatch
Flos

Mediaset

Conclusions



Mediaset S.p.A. / Didier Madiba, Fenicius LLC

(WIPO Case No. D2011-1954)

Lawful use of domain name

Focus of decision: the bad faith

Lack of an active use of a disputed domain name does not as such prevent a finding of bad faith particularly if there are various possibilities to use the disputed domain name in good faith in connection with its generic meaning.

Practical cases – Mediaset 2

Legal
framework

Strategies for
enforcing IP
rights on-line

Practical Cases

Iwatch
Flos

Mediaset

Conclusions



Mediaset S.p.A. / Didier Madiba, Fenicius LLC

(Court of Rome – Order 15/06/2012)

Unlawful use of domain name

Focus of decision: the risk of confusion

The use of a domain name who is identical to the Plaintiff's trademark creates a risk of confusion on the market, enhanced by the trademark's reputation.

It is not significant that the business activity of Fenicius LLC is not referred to Italian market, since the website may be easily reached by both European and Italian consumers.

Conclusions

Legal
framework

Strategies for
enforcing IP
rights on-line

Practical Cases
Iwatch
Flos
Mediaset

Conclusions



What can be done?

Surveillance systems on:

- Use of the trademark by third parties on the Internet;
- Registration of domain names;
- Registration of Apps;
- Creating Facebook pages/profiles;

Legal
framework

Strategies for
enforcing IP
rights on-line

Practical Cases
Iwatch
Flos
Mediaset
Conclusions



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Corinthia Hotel, St. Petersburg

Thank You for your kind attention

Dr. Livia PASQUALIGO

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