

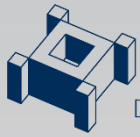
Metroconsult

DEFENDING CREATIVITY WITH TAILORED PROTECTION

How to protect IP in fashion Trademark protection

Carmela Rotundo Zocco

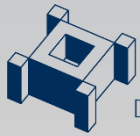
EU and Italian Trademark Attorney
Community and Italian Design Attorney



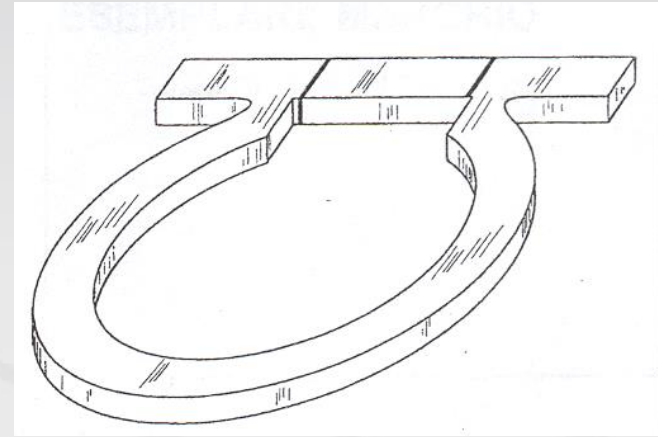
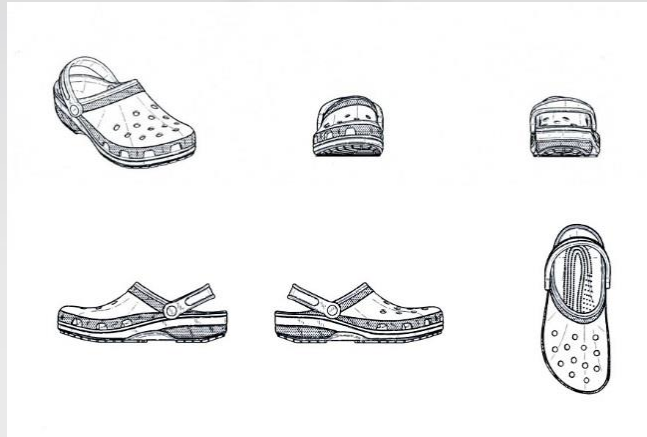
What can be registered as a trademark before Italian Patent and Trademark Office

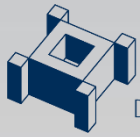
Art. 7 Italian IP Code:

1. A trademark may consist of signs capable of being represented graphically, and in particular words including personal names, designs, letters, numerals, sounds, the shape of goods or of their packaging, the color combinations or tones, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.



What can be registered as trademarks before the Italian Patent and Trademark Office





What can be registered as a trademark before EUIPO



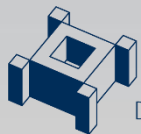
LEVI'S

- Word marks
- Figurative marks
- Figurative marks with letters
- 3-D marks
- Colors per se
- Sound marks
- Holograms
- Other marks i.e.
 - Animated marks (movement)
 - Position marks
 - Tracer marks (colored lines or threads applied to certain products)

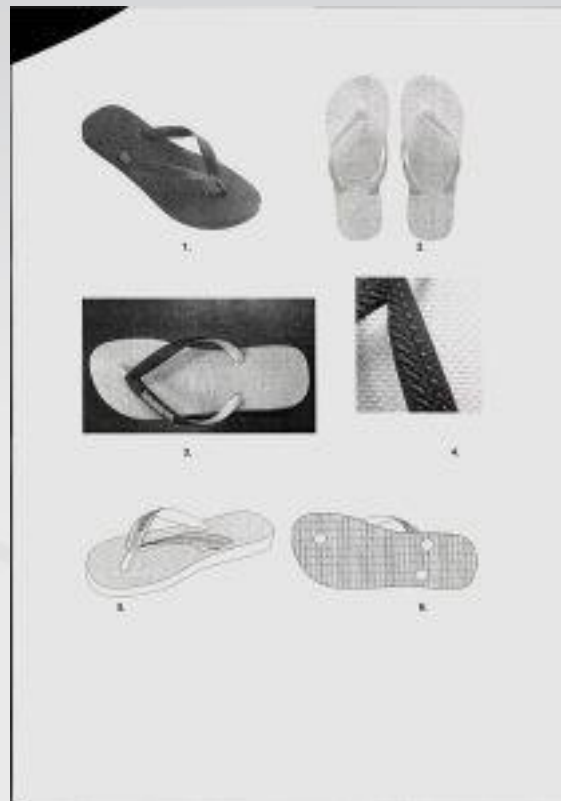
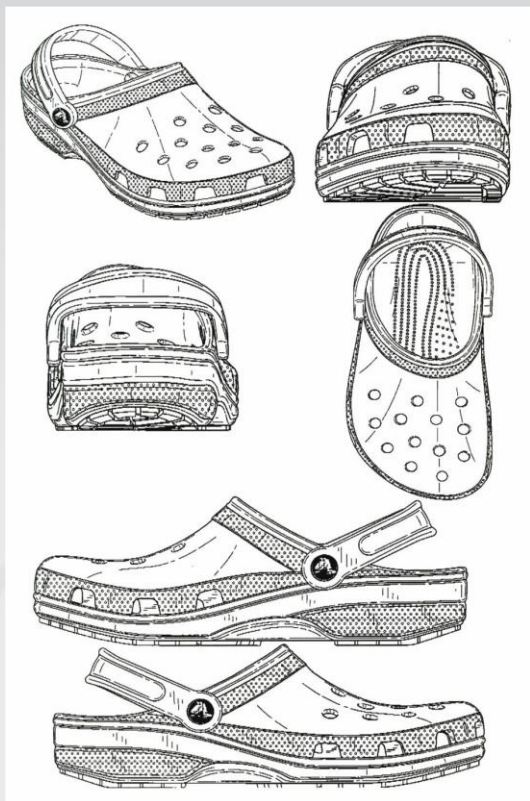


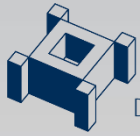
adidas





What can be registered as a trademark before EUIPO

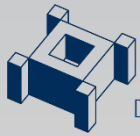




Filing in b/w or in color?

In Italy

Through the filing in b/w, the protection is obtained for the TM in all colors



Filing in b/w or in color?

In the EU

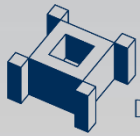
Common Communication on the Common Practice of the Scope of Protection of Black & White ("B&W") Marks

Is the use of a colour version of a trade mark registered in B&W/greyscale (or vice-versa) acceptable for the purpose of establishing genuine use?

A change only in colour does not alter the distinctive character of the trade mark, as long as the following requirements are met:

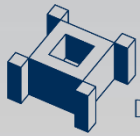
- a) the word/figurative elements coincide and are the main distinctive elements;
- b) the contrast of shades is respected;
- c) colour or combination of colours does not possess distinctive character in itself and;
- d) colour is not one of the main contributors to the overall distinctiveness of the mark.

Please also refer to Guidelines for examination of EU trade marks, Part C Opposition Section 6, Proof of use





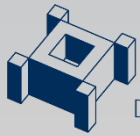
EUIPO: Cases where use in a modified form was considered use of the mark as registered

		<p>Registered form Actual use Case No R 1479/2010-2 The word element was considered to be the dominant feature of the figurative mark, since it was in a central position and in large letters. It was considered that the distinctive character was not changed</p>
<p>Registered form</p>	<p>Actual use</p>	<p>Case</p>



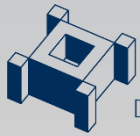
EUIPO: Cases where use in a modified form was considered use of the mark as registered

		<p>Registered form Actual use Case No R 0877/2009-1</p> <p>The orange background is the colour of packaging of the products. The mark is used in black on a white background, outlined in silver similar to the earlier registered mark. The typeface has been slightly modernised and the small hyphen between “Bi” and “Fi” has been deleted. Nevertheless, these may be considered as minor changes that do not alter the distinctive character of the mark in the form in which it is registered in the sense of Article 15(1)(a) EUTMR. The typeface has been modernised but the letters keep their rounded shape and the deletion of the hyphen may pass unnoticed. The distinctive character of the earlier mark is still based on the large black letters “Bi Fi”, the “B” and “F” being in capital letters and the two “i” letters in lower case, on a white background and outlined in silver’</p>
		
Registered form	Actual use	Case



EUIPO: Cases where use in a modified form was not considered use of the mark as registered

		<p>Registered form Actual use Case No R 2066/2010-4</p> <p>The 'NOVEDADES' catalogues dated 2004-2009 consistently show the mark and only this version. This does not constitute use of the mark [as registered] (with or without colour) as admissible under Article 15(1)(a) EUTMR. The mere fact that both marks include a word element LLOYD'S is not enough for that purpose, also the figurative elements of the earlier mark must appear in the form as used. The form as used is in a different font, lacks the single letter L at the end and surrounded by an orbital device, and lacks the circular or orbital device around the word 'LLOYD'S'. In other words, all its figurative elements are missing in the form as used. On top, the form as used contains the conspicuous device of a flying bird with a long beak. The omission of all the figurative elements of the mark as registered and the addition of another figurative element does alter, in the form as used, the distinctive character of the mark and is much more than a mere variation or modernization</p>
Registered form	Actual use	Case

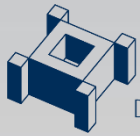


Opposition proceedings in Italy

Art. 8 Italian IP Code: Persons' portraits, names and signs with reputation

Art. 12.1 c) and d) Italian IP Code

- c) absolute (i.e. double) identity both between goods and/or services and between signs, where likelihood of confusion is presumed, and need not be proved)
- d) where there must be a likelihood of confusion (Identical or similar signs; identical or similar products and services).



Decisions of the Italian Patent and Trademark Office which admitted likelihood of confusion

MIU MIU



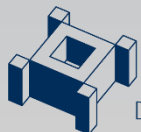
Products in classes 18 and 25

Earlier trademarks



Products in classes 18 and 25

Contested trademark



Decisions of the Italian Patent and Trademark Office which admitted likelihood of confusion

AZZARO

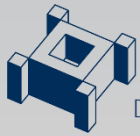


Products in class 25

Earlier trademark

Products in classes 18 and 25

Contested trademark



Decisions of the Italian Patent and Trademark Office which admitted likelihood of confusion

KOKKA

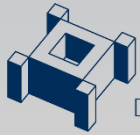


Products in classes 14 and 25

Earlier trademark

Products in classes 14 and 25

Contested trademark



Opposition proceedings before EUIPO can be based on

Art. 8 (1)(a) EUTMR

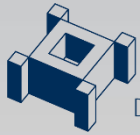
absolute (i.e. double) identity both between goods and/or services and between marks, where likelihood of confusion is presumed, and need not be proved

Article 8(1)(b) EUTMR

where there must be a likelihood of confusion (Identical or similar signs; identical or similar products and services).

Article 8(3) EUTMR prevents unauthorised filing of mark by proprietor's agent or representative

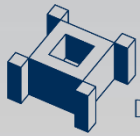
Article 8(4) EUTMR non-registered trade marks or other signs used in the course of trade of more than mere local significance



Opposition proceedings before EUIPO

Article 8(4a) EUTMR designations of origin and geographical indications

Article 8(5) EUTMR based on earlier mark which enjoys a reputation and the use without due cause of the trade mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier mark.

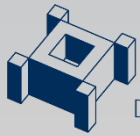


Opposition proceedings before EUIPO

POLO POLO DENIM & SUPPLY	HPC POLO
Products & services in classes 18, 25, 35	Products and services in classes 18, 25, 35
Earlier trademarks	Contested trademark

Opposition upheld for products in classes 18 and 25 based on 8 (1) (b) EUTMR

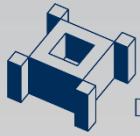
Opposition was not considered well founded either under Article 8(5) or Article 8(4) EUTMR



Successful opposition proceedings before EUIPO based on Art. 8.5 EUTMR

STEFANO RICCI	ROBERTO RICCI
Products in classes 9, 18 and 25	Products in classes 9, 18, 25, 28
Earlier trademark	Contested trademark

EUIPO decided that earlier mark is reputed for clothing and that the use without due cause of the trademark applied for would take unfair advantage of the repute of the earlier mark



Metroconsult

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INTELLECTUAL PROPERTY CONSULTANTS

**Thank you
for your attention**

For additional information, please contact:

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