

**TOPIC**

Strong and weak trademark. Misleading use of trademark and legitimate use of third-party trademark. Counterfeiting, confusion, vulgarization, decadence and legal protection of the trademark

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Executive summary

In a funny and creative way and with a sustainable approach, the SustainaBeelity team has focused its activity on the slippery world of the trademarks. Why have we thought of this name: SustainaBeelity? Because **we love Bees**. Because they are fascinating little insects, part of ecosystem, vital to a healthy environment and economy and, more than ever, we have to recognize the importance of Bees to our lives!

Aiming at giving an overview, we've focused the analysis on the different functions, even the new ones, of the trademark, analyzing all the possible signs that are registrable as trademarks.

We started from the principle of unitarity of distinctive signs, giving the due importance to the role of business company name and domain name.

Considering trademarks as leaders in the sustainable revolution, we concentrated on the difference between strong and weak trademarks, considering the different protection that can be granted to the trademark falling into each one of the two categories.

We've also analyzed the risk of vulgarization of generic marks and pointed out the great importance of the priority search in choosing a new trademark in order to avoid possible infringement of third parties' IPRs.

An important part of the work has been dedicated to all the potential trademark infringements and the misleading use of the trademark that can represent a serious risk for customers.

An overview of the registration procedures at National, European and International level has been given, together with some pills of legal strategy and protection of the trademark.

Because the purpose of this paper is more than theoretical, we interviewed a lot of specialized people and we concluded our work with **three innovative proposals**, namely:

- the **first one**, directed to any energy production company, is the realization of a **Pollinator-Friendly Solar plan**, possibly in Romania, aiming to increasing the amount of habitable land for pollinators
- the **second proposal** is the **creation of a symbolic trademark (SustainaBeelity)**, in both word and figurative version, that can lead the ongoing activities on biodiversity side (care of bees included) to be registered and shared with all the companies participating to this e-legal game willing to realize common projects to pursue the SDGs goals together with Enel
- not least, a **SustainaBeelity Global Union** is our **third proposal**, that can also be created between all the companies participating to this e-legal game, to face and solve common issues related to energy transition.

In the part below, we'll try to refer about the main topics of our research in a short summary, inviting you to read our work in details and support bees as well as our SustainaBeelity team.

In coherence with the function and role that the trademark plays in the market, the World Intellectual Property Organization (WIPO) defined the **trademark** as follows: *"A trademark is any sign that individualize the goods of a given enterprise and distinguishes them from the goods of its competitors"*.

A common misconception is that having a trademark means the owner legally owns a particular word or phrase and can prevent others from using it. From the very beginning it has to be clarified that owning a trademark does not give any exclusive rights over the word, symbol, or phrase in general, but only gives the owner protection on the way that word or phrase is used in connection with specific goods or services.

Traditionally, the following are the three main functions of the trademark:

1. **the origin function** – to denote origin
2. **the quality function** – to denote quality
3. **the "advertising" function** – to denote connection between the trademark owner and the advertiser.

A trademark could be a distinctive word, phrase, logo, graphic, letter, numerals, symbols, or a combination of all these, or other device that is used to identify the source of a product or service and to distinguish it from any competitors. Trademarks may also consist of drawings, symbols, three-dimensional features such as the shape and packaging of goods, non-visible signs such as sounds or fragrances, or color shades used as distinguishing features – the possibilities are almost limitless.

Have a look at our work should you be interested in knowing better about the several types and categories of signs that can be recognized as registrable trademarks (such as word or figurative marks, shape or 3D marks, position mark, slogan marks, sound marks, hologram marks, motion and multimedia marks, gesture marks, olfactory marks, taste marks and so on).

The law also offers some protection to distinctive shapes (such as Coca-Cola bottle) or packaging (the choice of blue on Tiffany box) or distinctive decor of services (such as Old Navy clothing stores). Collectively, these types of identifying features especially in US jurisdiction are commonly named “**trade dress**”. Functional aspects of trade dress cannot be protected by the law.

In this sense, a trademark can be more than just a brand name or logo, it can include other nonfunctional but distinctive aspects of a product or service that tend to promote and distinguish it in the marketplace. The trademark is the most known industrial property right being the distinctive sign that shows the entrepreneurial origin of a product or a service, able to distinguish the products of a company from the ones of another one.

In a nutshell, a trademark:

- (i) identifies the source of goods or services
- (ii) provides legal protection for the brand and
- (iii) helps guarding against counterfeiting and fraud.

You can become a trademark owner by using a trademark in relation with the goods or services you provide, but in such a case your rights are limited, and they only apply to the geographic area in which the goods and services are provided. So, it is not required to register a trademark to have the right to use it. However, a registered trademark provides broader rights and protections than an unregistered one.

The protection is granted on specific classes. Please note that the Nice Classification is a system of classifying goods and services for European Union (EU) trademark applications. If you want to know more about this classification, please read our work.

Not only trademarks serve to identify the origin of products and services, but they can also be used to communicate a particular message to the public. For examples, there are trademarks that identify eco-friendly characteristics of products and services and can help consumers, aware of environmental issues, in choosing ecofriendly products and services.

Trademarks can have an important role in it because they can ensure that the product complies with certain standards.

Do you know “famous” sparkling wine BROSECCO from UK? Does it remind you something? Read more about it, and the relevant case in our research.

Moreover, **trademarks can be qualified as “strong” or “weak”**, or somewhere in between. In our work we provide some recommendation to the business to develop strong marks from the earliest stages of the enterprise’s development. In fact, the nature of a mark, its strength or

weakness, could have a direct effect on performance in the market as well as scope of legal protection. A “strong” mark is a mark that is highly distinctive, thus immediately identifying the owner as the source of the covered products or services. When a mark is scarcely distinctive, it is considered “weak.”

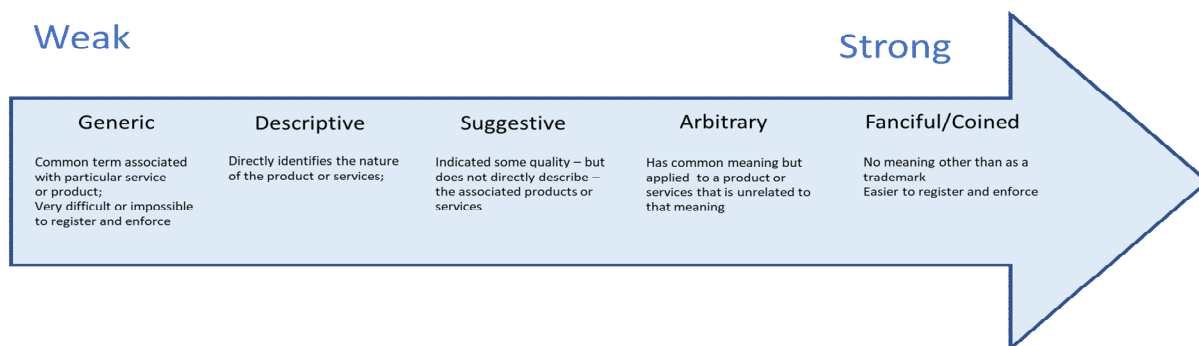
So, the stronger a mark is, the easier it is for the mark to be eligible for registration and to obtain protection from unauthorized use and registration by others.

Adopting a strong trademark highly reduces the possibility for the consumers to be misled in the market too.

Trademarks are evaluated on a continuum ranging from weak to strong:

- ✓ **Generic** - never entitled to trademark protection. No one claims the word “windmill” as a trademark for a renewable wind turbine. The policy is simple: granting a trademark for a generic term would remove that term from the public lexicon—thereby excluding the public from its use.
- ✓ **Descriptive** - slightly stronger than generic marks but are only entitled to trademark protection under special circumstances, such as acquired “secondary meaning” - distinctiveness that marks earn through strong consumer association. Read in the full version of our research if “booking.com” could protect the trademark, considering that both “booking” and “.com,” in the aggregate, are generic and descriptive.
- ✓ **Suggestive** - hints at or suggests the nature of a product or service without describing the product or service.
- ✓ **Arbitrary** - use a familiar word in an unfamiliar way, highly distinctive in identifying and distinguishing products or services, the scope of protection obtained is very broad. Are you curious to know how Apple Corps, the record label founded by the Beatles, and Apple Computer are co-existing? Is there any problem? See the full version of our research.
- ✓ **Fanciful or Coined** – a trademark which has been made up or invented by its owner: previously unknown words, which are invented solely for its use as a trademark. Once goodwill has been established, fanciful marks provide trademark owners with the broadest scope of protection against third-party use of the same or a similar mark.

In synthesis:



The **first step** for every business is a creating a protectable and attractive brand.

The **next critical** – but likewise fundamental – **step** is to complete the **trademark clearance search**, aimed at determining whether the proposed brand is available for trademark registration.

In the process of inventing and adopting a trademark there can be the risk that a competitor has already registered an identical or very similar mark for the same product or service category (or related category): a clearance search is the only measure to find out and avoid that risk in advance. Therefore, if you are thinking about registering your own new trademark (which has become a quite common practice in this start-up world!), you should carefully read the part of our work giving details about the possible trademark clearance searches. Would you buy a car which is “no va”, read about *Chevrolet NOVA*.

A part of the work has also been focused on **trademark infringement**, that verifies when a party uses a trademark which is identical or alike a trademark already registered for identical or similar goods and/or services, thus causing in the customers (also potential) confusion, deception, or mistake about the source of the goods and/or the services.

If this case verifies, there are several legal instruments that could be activated in order to protect the legitimate trademark’s owner. Among these instruments, it could be mentioned:

- the request for preliminary injunction relief
- the starting of a legal dispute: the first choice is to decide whether to start a legal proceeding or an arbitration, although for trademarks related disputes, arbitration is not always an easy way to choose; you may find more details in our work
- before starting the legal dispute in court, the traditional approach is to send a cease and desist letter, although this approach could have negative effects (also towards the customers): if you want to read more about this side effect, read the *Frappuccino* case.

In our work we also referred about the following unauthorized uses of the trademark or unlawful behaviors by third parties that can cause damages to the legitimate owner:

- **trademark dilution**: it refers to the unauthorized use of and/or application for a trademark that is likely to weaken the distinctive quality of or harm a famous mark: the dilution rule permits the owner of a famous mark to take actions because the famous trademark can lose its distinctive character and strength in case of diluting use of the mark
- **misleading use of a trademark**: it creates customer confusion, where a misleading mark causes the customer to believe - wrongly - that a product or service is somehow connected with a business that the customer already knows
- **counterfeiting**: unauthorized imitation of a branded good
- **confusion** (or likelihood of confusion): it exists between trademarks when the marks are so similar and the goods and/or services for which they are used are so related that consumers would mistakenly believe they come from the same source. In order to see applications of this concept, read the “*ène light*” case (does *ène light* sounds familiar to you?).

Another concept that has been examined is the **genuine use of the trademark**, whose lack could lead to trademark revocation or refusal to register a trademark. In order to prove genuine use of the trademark, the trademark holder may be required to demonstrate the real use of the trademark for the goods and services covered by the registration. The proof of genuine use of the trademark could be quite demanding, since the assessment of whether the use of the trademark is genuine cannot be limited by establishing that the trademark has been used in the course of trade; instead, such use should be associated with goods and services which are placed on the market.

The final part of the work is focused on the trademark registration. There are several procedures for registration that can be followed, depending on the countries where the trademark has to be protected. The procedures that have been examined are:

- Italian procedure
- EU procedure
- International procedure (there is no trademark with international validity, worldwide, but it is possible to proceed with an international extension of the national mark through the WIPO).

At the end a main question has been asked and answered: why should a trademark be protected? If you are asking yourself the same question or you just want to go in-depth on this topic, then you should read this analysis. Among the main reasons, it could be mentioned that protection of the trademark would enhance your freedom to operate in the market and would let you save money, since the registered trademark establishes the legal ownership of your brand and informs everyone about the rights that you have been granted; additionally, registered trademarks may increase the value of your brand.

On the other side, once the registration of the trademark is completed, any third party can request its revocation or invalidity. For EU trademarks, the revocation may be pronounced if the owner of the mark fails to demonstrate its effective use within five years of its registration by providing evidence such as packaging, labels, price lists, catalogs, invoices, photographs, advertisements in newspapers, and written statements.

There is also a procedure for revocation in Italian law, which could be requested when one of the three following cases verifies:

- 1) vulgarization, when a trademark loses its distinctive capacity and becomes a generic name
- 2) subsequent illegality (if it was illegal from the moment of registration, the trademark would be invalid)
- 3) non-use for 5 consecutive years.

Once your trademark is registered and you are the legitimate owner of the brand, what should you do?

We have included some tips in order to help you in providing an effective and sustainable protection of your brand from abusive use by monitoring the market and defending your rights where appropriate.

According to [Our Common Future](#) – Brundtland Report, sustainable development is defined as development that *“meets the needs of the present without compromising the ability of future generations to meet their own needs.”*

In our view, the appropriate creation and use of trademarks can represent a tool for the protection of innovative solutions serving sustainable development for great causes.

In a circular vision the protection of the environment is at the center, no longer being a cost but as the very driver of sustainable development. There is only one planet, Earth!

Choose our work and help us to realize our three proposals!



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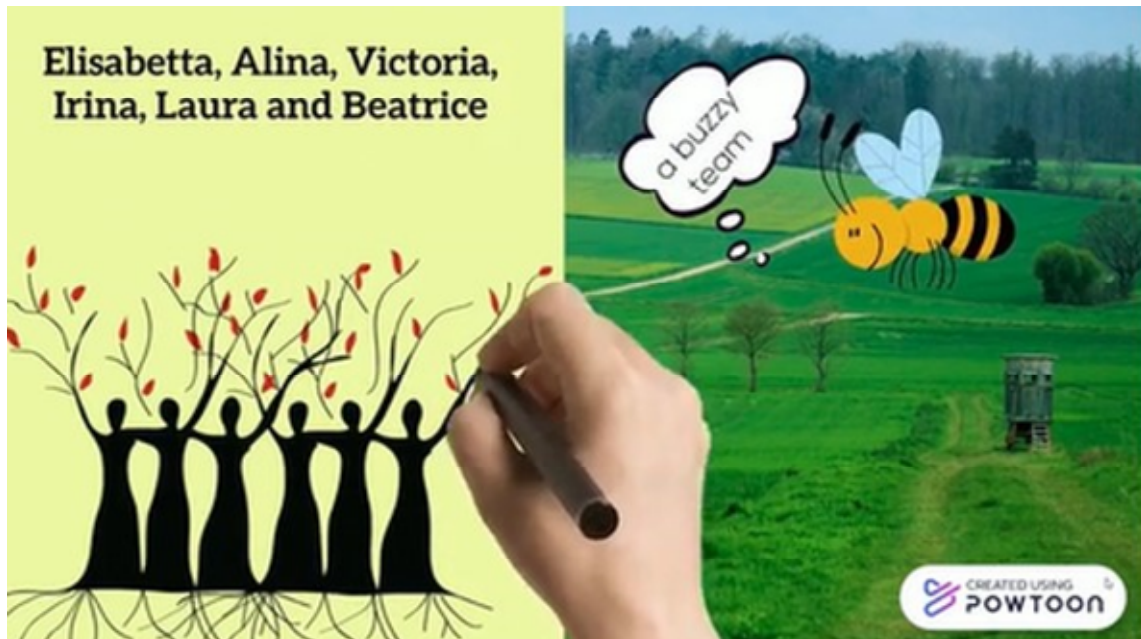
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Who are we? We are The SustainaBeelity Team



Why **SustainaBeelity**?

Because we love Bees. But Bees are in trouble! 🐝

Because we believe in Sustainability. But not all projects in the world are sustainable yet! 🐝

Bees are beautiful and fascinating little insects but something else makes them special.

Bees are part of ecosystems; they are vital to a healthy environment and healthy economy.

Honeybees are the world's most important single species of pollinator in natural ecosystems and a key contributor to natural ecosystem functions, helping plants grow, breed and produce

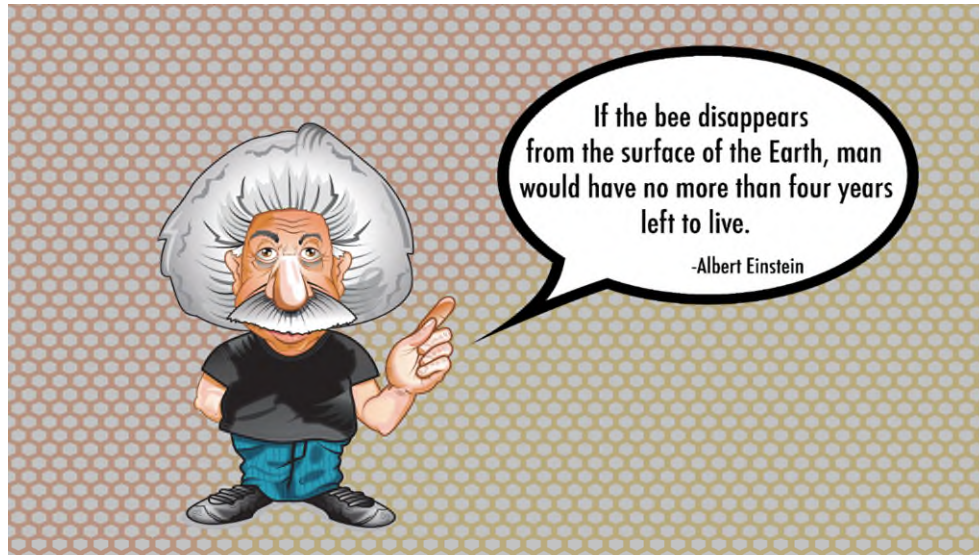
food. They do so by transferring pollen between flowering plants and therefore keeping the cycle of life turning.

Bees strongly influence ecological relationships, ecosystem conservation and stability, genetic variation in the plant community, floral diversity, specialization and evolution.

But bees are in trouble! There is a growing concern at bee decline across the world.

This decline is caused by a combination of stress – from loss of habitat and food sources to exposure to pesticides and the effects of climate breakdown.

More than ever, we have to recognize the importance of Bees to nature and to our lives! 🐝



Because we want something more than a trademark.
... and Bees are little insects but also a **strong symbol for millennia.**

🐝 Since ancient times, bees have been seen to bring messages from the Divine, to set an example, to be associated with the soul, healing, power, abundance, blessing, fertility, afterlife and rebirth.

🐝 Bees figures prominently in the mythology of nearly every culture, including those of the Mayans, Hindus, Egyptians, Romans and ancient Greeks.

🐝 Bees along with honey, are mentioned not only in the Bible, but in other holy books too, including the Koran and in the Hindu Vedas.

🐝 The Celts and Saxons believed bees were winged messengers between worlds.

✿ Egyptians thought the bee represented the soul - *ka*. According to Egyptian mythology, when the god Re cried, his tears turned into bees upon touching the ground, to deliver messages to man.

✿ In European folklore, it was believed that bees and eagles were the only members of the animal kingdom with access to heaven.

✿ The Greeks consecrated bees to the moon. The Greek philosopher Pythagoras believed that the souls of the wise and ingenious passed into the bodies of bees.

✿ Jupiter for the ancient Romans was the equivalent of the god Zeus for the Greeks. The Romans believed Jupiter was nourished by bees in infancy.

✿ In 1623, a swarm of bees flew into the Vatican just as the conclave of cardinals were choosing a new pope. The bees alighted on the chamber where Maffeo Barberini awaited the outcome of the election. The Barberini family crest features three bees. Maffeo was appointed pope. The election was afterwards said by Romans to have been foretold by the swarm of bees entering the conclave. The three bees were subsequently incorporated into Rome's architecture and monuments.

✿ The apogee of the bee, however, would come in the 19th century under the reign of Napoleon Bonaparte, who made them one of his imperial symbols.

✿ Today, the bee still signals regal aspirations.



What is Sustainability?

According to *Our Common Future* – Brundtland Report, sustainable development is defined as development that “meets the needs of the present without compromising the ability of future generations to meet their own needs.”

The Sustainable Development Goals (SDGs) are the United Nations General Assembly’s current harmonized set of seventeen future international development targets. The Official Agenda for Sustainable Development adopted on 25 September 2015 outlining the 17 Sustainable Development Goals¹ (SDGs) and their associated targets to be achieved by the year 2030.

The seventeen goals include:



It may sometimes feel like the legislator is playing catch-up with the technology commonly used every day, but IP already offers the existing tools to allow for the protection of innovative solutions serving sustainable development for great causes.

Sustainable development is the conceptual tool of the circular economy, a guiding principle based on three pillars: economic, social and environmental, that is making its way into the legal framework at every level.

In a circular vision the protection of the environment is at the center, no longer being a cost but as the very driver of sustainable development. There is only one planet Earth!²

¹ <https://sdgs.un.org/>

² https://ec.europa.eu/environment/pdf/circular-economy/new_circular_economy_action_plan.pdf

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INTRODUCTION

People have been trademarking stuff since before there was even a word for it. In the ancient times people couldn't read or write, so the symbols were the only method of communication, of expressing feelings and emotions.

In the history of trademarks, the wall paintings in ancient Egypt, cave drawings in different parts of Europe, Madagascar and Stonehenge are the first symbols ever discovered.

Two thousand years ago, Roman³ craftspeople left their distinctive marks on almost everything they made. Even the very foundations of ancient Rome were labeled.



This Monday, June 13, 2016 photo shows a bronze slave collar of the 5th century displayed at "Made in Roma" exhibition at the Trajan's Markets site in Rome. In an ancient twist to today's Made-in-Italy labeling, Romans of some 2,000 years ago took to branding with zeal, putting names, trademarks and other identifying details with meticulous care on items including tableware, plumbing pipes and lead ammunition for slingshots. (AP Photo/Fabio Frustaci) (The Associated Press)

Not only the Romans were doing this, but also Egyptians and Chinese people left traces of human hands and painted large wild animals.

The ancient Greeks marked almost all their artworks with the name of the sculptor or decorator. There is also evidence of device marks such as figures of bees, lions' heads, and others. The Etruscans and Romans used marks in a similar way, an example being the Roman oil lamps, which were traded by Romans throughout Europe showing the mark of the most famous maker, "*Fortis*".



³ <https://www.sandiegouniontribune.com/sdut-exhibit-explores-ancient-roman-designer-labels-2016jun16-story.html>

⁴ <https://www.catawiki.com/en/l/25039011-ancient-roman-terracotta-ollamp-with-makers-mark-fortis-3-5x7-5x9-5-cm-1>

Another way to understand the history of trademarks is to look at the definition of the word “*hieroglyphs*” – the earliest known writing system, using symbols called “*hieroglyphs*” which comes from a Greek word meaning “*sacred carving*”.



Also, in ancient China, people made pottery showing the mark of the emperor of that times, the place where the pottery was created and the name of the manufacturer. During 2020, an extremely rare golden seal dated 1600s has been discovered by archeologist, being engraved with the symbols of Chinese emperor.



In the 12th century, King Edward I enacted a law prohibiting jewelers from selling their artworks unless including a stamp from the Goldsmith’s Hall, the royal office in London. It’s believed to be the earliest form of modern trademark, serving as a guarantee of quality for the purchased goods⁷.

To be also remarked that many Greek or Latin words function as modern trademarks. *Nike*, for example, was the ancient Greek personification of Victory, *Nivea*, deriving from Latin *niveus* – meaning snow white, *Kouros*, the typical male figure in Greek sculpture, *Mars* is used for chocolate bars, only that this time, and it derives from the Mars family rather than the god of war.

⁵ <https://www.bbc.co.uk/bitesize/topics/zg87xnb/articles/zvw3mfr>

⁶ <https://www.dailymail.co.uk/news/article-8277819/Spectacular-pictures-reveal-centuries-old-royal-family-golden-seal.html>

⁷ <https://respectfortrademarks.org/tricks-of-the-trademark/history-of-trademarks/>

Maybe you are asking yourself, why the origins are important. The answer is simple, because the origins are deeply rooted in traditions and here it is an interesting example:

Some “honey” from the Bee:

Vin Santo or Vinsanto?

The name of Vinsanto, is established in Greece, as the name of the wine originating from the Greek island of Santorini (Santo-Erini), being an abbreviation of vin[o] santo[rini]. But, in Tuscany, Italy, it is produced a wine variety known as Vino Santo⁸, produced under the same process, using semi-dried grapes.

In deciding who has the right to the name as an appellation of origin the parties had to go back to the fifteenth century and establish that the Vinsanto was already known then throughout the ports of Levante (south-eastern Mediterranean) as a wine from Santorini. Santorini wineries were somewhat overconfident that Greek history would prevail. Grapes have been grown continuously on Santorini through a unique method – the basket system – for more than 3000 years.

According to a Florentine tale the Tuscany wine was known as Vin Pretto, until 1439, when the Greek Patriarch had lunch with the Pope and tasting the divine wine said “... ma questo è vino di Xanto”, referring to a wine from another Greek region. The others thought that he claimed that this was a Vino Santo (“holy”, in Italian) and so the wine was baptized.⁹

In 2002, the EU determined that there was enough information to name Santorini, Greece as Vinsanto’s place of origin thus granting the island exclusive rights to the use of the name Vinsanto on its sweet wines while Italy may still use Vin Santo del Chianti Classico – an ancient dessert wine that can be found in different regions of Tuscany.¹⁰

⁸ <https://www.lagazzettaitaliana.com/food-and-wine/7671-the-vin-santo>

⁹ See: The Vinsanto of Santorini (Athens, Boutari (Fani) Foundation, 1995); O. TACHIS, *Il Libro del Vin Santo* (in Italian) (Firenze, 1988); and S. KOURAKOU, *VinSanto Tales and History of a Wine Variety* (in Greek), Kathimerini, 1996.

¹⁰ [https://en.wikipedia.org/wiki/Santorini_\(wine\)#cite_note-11](https://en.wikipedia.org/wiki/Santorini_(wine)#cite_note-11)

TRADEMARKS – Definitions and functions

Trademarks and Distinctive signs.

From the deliberations on the function and role that the trademark plays in the market, World Intellectual Property Organization (WIPO) defined the **trademark** as follows: *“A trademark is any sign that individualize the goods of a given enterprise and distinguishes them from the goods of its competitors”*.

Trademarks, copyrights and patents protect different types of intellectual property.

Trademarks are protected by intellectual property rights, and they are signs capable of distinguishing the goods or services owned by different persons. A trademark is used for goods, while a service mark is used for services.

According to art. 1 of the Italian Code of Industrial Property (CPI), the industrial property includes trademarks and other distinctive signs.

All the distinctive signs are under legal protection against acts of unfair competition that can take place within a free market. Trademarks help consumers to be able to make more informed choices and, on the other hand, entrepreneurs to keep their customers better.

A copyright protects an original artistic or literary work. A patent protects an invention.

A trademark could be a distinctive word, phrase, logo, graphic, letter, numerals, symbols, or a combination of all these, or other device that is used to identify the source of a product or service and to distinguish it from any competitors. Trademarks may also consist of drawings, symbols, three-dimensional features such as the shape and packaging of goods, non-visible signs such as sounds or fragrances, or color shades used as distinguishing features – the possibilities are almost limitless.

A trademark can be more than just a brand name or logo, it can include other nonfunctional but distinctive aspects of a product or service that tend to promote and distinguish it in the marketplace. The trademark is the most known industrial property being the distinctive sign that shows the entrepreneurial origin of a product or a service, able to distinguish the products of a company from the ones of another one.

The distinctive signs of the company are those signs that allow the company to be uniquely identified, to recognize the entrepreneur (company name), the place where the company operates (sign) and the goods or products offered (trademark). The domain name is also a distinctive sign.

Titles, character names, or other distinctive features of movies, television and radio programs can also serve as trademarks when used to promote a product or service.

The law also offers some protection to distinctive shapes (such as Coca-Cola bottle) or packaging (the choice of blue on Tiffany box) or distinctive decor of services (such as Old Navy clothing stores). Collectively, these types of identifying features especially in US jurisdiction are commonly named “**trade dress**”. Functional aspects of trade dress cannot be protected by the law.

“Trade dress” refers to the visual appearance of a product and/or its packaging as well as their ornamental features. In the European Union, unlike other jurisdictions, there is no single way to protect product and packaging shape, product color and shop fronts. In fact, protecting “trade dress” in the EU mainly consists of a combination of three tools: 3D trademarks, Designs and Copyright. However, combining the more significant IP protection tools (e.g., mainly trademark and design) can be a useful way to protect trade dress.

In a nutshell, a trademark: (i) identifies the source of goods or services; (ii) provides legal protection for the brand, and (iii) helps guarding against counterfeiting and fraud.

A common misconception is that having a trademark means the owner legally owns a particular word or phrase and can prevent others from using it. It has to be clarified from the very beginning that a trademark does not give the rights over the word, symbol, or phrase in general, but only give protection on the way that word or phrase is used in connection with your specific goods or services.

A person becomes a trademark owner starting with using the trademark in relation with the goods or services provided but the rights are limited, and they only apply to the geographic area in which the goods and services are provided. It is not required to register a trademark. However, a registered trademark provides broader rights and protections than an unregistered one.

So, a trademark can be protected on the basis of either use or registration. Both approaches have developed historically, but today trademark protection systems generally combine both elements. These aspects will be dealt with in detail below.

The protection is granted on specific classes. In particular, the Nice Classification is a system of classifying goods and services for European Union (EU) trademark applications. It consists of 45 classes for goods and services¹¹.

Each class contains a set of terms within that class to better define the goods or services to be protected by the EU trademark application. When indicating the goods and services in an EU trademark application, applicants are strongly advised to use the Nice Classification terms in order to avoid delays in the registration procedure caused otherwise by the need to translate the

¹¹ The Nice Classification assigns goods to Classes 1 to 34, and services to Classes 35 to 45. Each class is represented by a class heading, which gives general information about the type of goods or services covered. For example, the Class 25 heading reads ‘Clothing; footwear; headgear’ and the Class 15 heading ‘Musical instruments’.

terms submitted. Use of these generic terms will also improve the search capabilities of the EU trademark databases and thus ultimately result in greater transparency¹².

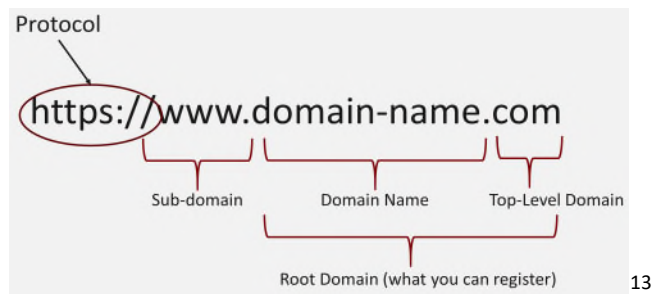
Domain names, business name registrations and trademarks: differences

A **domain name** is part of a web address that links to the internet protocol address (IP address) of a particular website, using an accredited domain name registrar. A domain name and a trademark differ. A trademark identifies goods or services as being from a particular source. The use of a domain name only as part of a web address does not qualify as source-indicating trademark use, though other prominent use apart from the web address may qualify as trademark use. Registration of a domain name with a domain name registrar does not give any trademark rights.

The domain name is a technical device to indicate in a comprehensible manner the address of a website in the worldwide web, which corresponds to a single sequence of numbers. The possibility to use letters combined with numbers allows to create domain names with a strong commercial impact. From this derives the need to create a system of protection against abuse of domain names similar and confusing with the legitimate owners' ones.

This is the reason why if someone registers as domain name the trademark of someone else, the owner of the trademark can oppose the request of registration and ask for re-assignment of such domain name. In the following six months the re-assignment procedure can be implemented and is aimed at the formal transfer of the domain name to the opponent if it is proved that:

- a) the domain name is identical or can create confusion with the trademark belonging to the opponent or to his name or surname
- b) the resistant doesn't prove to have any rights or title in relation to the challenged domain name
- c) the domain has been registered and is used in bad faith.



Similarly, use of a business name does not necessarily qualify as trademark use, though other use of a business name as the source of goods or services may qualify it as both a business name and a trademark.

¹² <https://euipo.europa.eu/ohimportal/en/nice-classification>

¹³ <https://love2dev.com/blog/domain-names/>

A company name identifies a legal entity. By incorporating a company, the owner of the company will only be preventing other businesses from registering an identical or very closely similar company name. Crucially, incorporation of a company does not prevent other people from selling goods or providing services under an identical or a similar name. A business name may or may not be trademarked.

Some "honey" from the Bee:

A company's business name is among one of its most powerful branding assets and as with other business assets, it's wise to protect it. If a business owner fails to do so, there is the risk of another company using the name, that can potentially confuse customers and create legal issues.

There is a protection for **company name**.

Under Italian Civil Code and pursuant to 22 CPI it is a distinctive sign that has juridical protection on Italian territory like the other distinctive signs. As far as legal protection is concerned the unitarity of distinctive signs applies.

It is worth mentioning that **cybersquatting** is registering, selling, or using a domain name with the intent of profiting from the goodwill of someone else's trademark. It generally refers to the practice of buying up domain names that use the names of existing businesses with the intent to sell the names for a profit to those businesses. Another example of cybersquatting is using another brand's likeness in a confusing or misleading way. Some examples of this instance might include "drinkcoke.org". While it's not necessarily a misspelling of the brand name, it is misleading.



Some cases from the Bee:

CASE 1

The X company has registered its company name in 2014 and this name is identical to the trademark X that has been registered by another company later. The two companies are competitors sharing the same business activity. In this case the company owning the registered trademark cannot prevail on the company named X in the country where this name has been registered. This is in line with the principle of unitarity of the distinctive signs.

¹⁴ <https://snapshotinteractive.com/why-cybersquatting-is-actually-illegal/>

CASE 2

Mr. X held for a short period of time the quality of sales agent within the Company X. During his activity he had the opportunity to know how to carry out the bidding and contracting activities carried out through contractual partner of Company KKK.

At the same time, for the period in which Mr. X acted as a sales agent within Company X, he received a service card, which ceased to be valid at the time of termination of relationship between Mr. X and Company X.

Although the service card was withdrawn, Mr. X continued to use it illegally, falsely claiming, by misleading the persons with whom he interacted, that he acted for Company YYY, in the sole attempt to create a false appearance of its quality and to associate without any factual or legal basis the activity of the companies, with its criminal activity carried out in personal name. In fact, during the same illicit conduct, Mr. X initiated a series of blackmails. Harassment meant to obtain illegal benefits, aspects for which, however, Company YYY had already invested the criminal investigation bodies with a criminal complaint in the sense of the above in order to attract his criminal responsibility for the deeds committed.

In parallel, Mr. X registered in bad faith and for obvious fraudulent purposes two internet domains including in their name the trademark "Company YYY", thus flagrantly violating the industrial property rights of the owner, rights that benefit from protection, both at national and international level.

So, Company YYY notified him of his obligation to cease any violation of the trademark right, as well as of good commercial practices by requesting him in this regard the following:

(a) the cessation of using the Company YYY card and its return to Company YYY

(b) the cessation of using whichever element that is in connection with the Company YYY trademarks in his communications

(c) the cessation of using the domains and the related e-mail, by cancelling/closing them or transferring them to Company YYY and

(d) the deletion of any element from the materials used by him that has a direct or indirect connection with the Company YYY trademarks.

Company YYY has also asked for the re-assignment of the domain names and has obtained it.

What are the functions of a trademark?

A trademark's essential function is to be a badge of origin. It distinguishes the goods and services of one undertaking from those of other undertakings.

It cannot be defined better than as it was in the *Memorandum on the creation of an EEC trademark (Bulletin of the European Communities, Supplement 8/76, adopted by the Commission on 6 July 1976)*:

" Both, economically and legally the function of the trademark as an indication of origin is paramount. It follows directly from the concept of a trademark as a distinctive sign, that it serves to distinguish trademarked products originating from a particular firm or group of firms from the products of other firms. From this basic function of the trademark are derived all the other functions which the trademark

fulfils in economic life. If the trademark guarantees that the commercial origin is the same, the consumer can count on a similarity of composition and quality of goods bearing the trademark; and the advertising value of the trademark requires that between the trademarked goods and the owner of the trademark there is a definite legal relationship. Although the quality function predominates in the mind of the consumer and the publicity function predominates in the mind of the producer, so far as the legal aspect is concerned the decisive criterion is the function of the mark as an indication of origin. Only if the proper purpose of the trademark is maintained, namely, to distinguish the trademarked goods from goods of different origin, can it fulfil its further role as an instrument of sales promotion and consumer information; and only then does the trademark right perform its function of protecting the proprietor against injury to the reputation of his trademark”¹⁵.

Traditionally, three main trademark functions have been recognized:

4. **The origin function** – To denote origin.
5. **The quality function** – To denote quality.
6. **The advertising function** – To denote connection between the trademark owner and the advertiser.

Of course, aside from the traditional functions, we must admit that, by its acquired reputation, the trademark acquiring an economic value, has also an economic **function**. As intangible assets, trademarks may be sold, licensed, or be the subject of various commercial transactions, franchising, sponsorship or merchandising agreements. Licensing is not only for big multinational companies. It appears that there are a lot of startups¹⁶ whose business model includes licensing both their technology and brand.

➤ Referring to the **original function**, the trademark identifies the product and its **origin**. The traditional view is that the main purpose of a trademark – its “*essential function*” – is that of being a **source indicator**.

In a 1970 article, K. Breier¹⁷ noted that “a trademark serves to distinguish the goods of one manufacturer from the goods of another. The trademark should identify the origin of the goods with a particular company. The exclusive right of use granted to the trademark owner by statute serves to protect only this function and is limited by the basic purpose of trademark protection: the trademark owner is protected by his statutory right only against unfair use of his trademark on the goods of others. This right shall prevent others from causing confusion as to the origin of the goods and thereby taking unfair advantage of

¹⁵ *Morcom, Roughton and St Quintin: The Modern Law of Trademarks (Part I General introduction, Chapter 1 Subject matter and history of the law).*

¹⁶ www.eu-startups.com “Ten reasons to register your trademark”

¹⁷ See F. K. Beier «Territoriality of Trademark Law and International Trade», 1 IIC (1970).

the goodwill embodied in the trademark. Such protection is also in the interest of the general public that should be protected against misrepresentation”.

The notion of the “essential function” was explicitly acknowledged by the Court of Justice of the European Union (CJEU) in the seventies, long time before the Trademark Directive. The Court held the following in *Hoffmann-La Roche vs. Centrafarm*¹⁸ case:

“The essential function of the trade-mark . . . is to guarantee the identity of the origin of the trade-marked product to the consumer or ultimate user, by enabling him without any possibility of confusion to distinguish that product from products which have another origin. This guarantee of origin means that the consumer or ultimate user can be certain that a trademarked product which is sold to him has not been subject at a previous stage of marketing to interference by a third person, without the authorization of the proprietor of the trademark, such as to affect the original condition of the product. The right attributed to the proprietor of preventing any use of the trademark which is likely to impair the guarantee of origin so understood is therefore part of the specific subject-matter of the trademark right.”

Subsequently, the existence of functions was mentioned in the First Recital to the Preamble of the EU Trademarks Directive (89/104/EEC), which held that *“the protection afforded by the registered trademark, the function of which is in particular to guarantee the trademark as an indicator of origin, is absolute in the case of identity between the mark and the sign and goods or services”*.

➤ Referring to the **quality function**, the trademark proposes to **guarantee the quality** of the products. This function assumes that consumers will use trademarks to identify goods which they know from experience to be satisfactory, matching a trademark with what they like and dislike.

Trademarks can be said to “guarantee” product quality by providing credible assurance about the likely quality of the products sold under them¹⁹. They are an “essential element” of a system of undistorted competition because firms have to use them to gain an advantage in the various ways that depend on having this capacity²⁰.

Underlying this behavior is the expectation that all goods sold under the mark will be of the same quality. However, the quality guarantee function is controversial. While there is an expectation of consistency, there is no legal mechanism to guarantee that the proprietor of the mark will only use his mark on goods of uniform quality.

¹⁸ ECJ 23 May 1978, Case 102/77, *Hoffmann-La Roche/Centrafarm*.

¹⁹ The CJEU has referred to the functions of a trademark as including that of “guaranteeing the quality of the goods or services in question.” See, e.g., *L’Oréal SA v. Bellure NV*, (Case C-487/07).

²⁰ On how competition through quality and competition through innovation may conflict with each other, see Robert E. Cole & Tsuyoshi Matsumiya, *Too Much of a Good Thing? Quality as an Impediment to Innovation* (2007).

Nowadays, most trademarks are associated more with the level of quality of the underlying product than with the source of the product. Harry D. Nims succinctly states that “*trademarks may serve as indications not only of source but also of quality or of uniformity of quality*”²¹ and Rudolf Callmann notes that a trademark “*assures the public that goods bearing the same mark are similar in nature, quality or characteristics*”.²²

An example from the Bee:

In the 1920, US Supreme Court case of Coca-Cola Co. vs. Koke Co. of America, Justice Holmes noted that the famous trademark COCA-COLA perhaps had become more associated in the public’s mind with the product quality than with the producer origin.

➤ The **advertising function** is the least understood of the trademark functions and there is no consensus on what the advertising function is, being criticized by the doctrine as being “illusory”.

However, when marks are used in advertising, an image can be built up around them, different from the physical nature of the goods themselves. In this way, this image will be evoked whenever consumers are subsequently exposed to a specific mark.

Aside from the theoretical debates, this function was recognized in the case law – *Dior vs. Evora*.²³ “*The questions have been raised in proceedings between (i) Parfums Christian Dior SA, a company incorporated under French law established in Paris (hereinafter ‘Dior France’) and Parfums Christian Dior BV, a company incorporated under Netherlands law established in Rotterdam (hereinafter ‘Dior Netherlands’) and (ii) Evora BV, a company incorporated under Netherlands law established at Renswoude (hereinafter ‘Evora’), concerning advertising carried out by Evora for Dior products which it has put on sale*”²⁴. Briefly, perfumes bearing the DIOR mark were imported into the Netherlands from another EU Member State and were sold and advertised by a cut-price retailer. Evora - a chain of fragrances shops in Holland which was not part of Christian Dior's official distribution network - had obtained Dior product from parallel importers which it advertised in promotional leaflets. Dior objected on the grounds that the type of advertising was inconsistent with the prestigious image of its brand and infringed its trademarks.

Although this was *prima facie* legal permissible parallel importation, the proprietor argued that it had legitimate reasons to oppose the further commercialization of the goods in which way because the reputation of the DIOR mark would be damaged by this mode of sale and advertising. The court that referred this issue to the Court of Justice of the European Union spoke of such

²¹ H. Nims, Unfair Competition and Trademarks.

²² R. Callmann, Unfair Competition, Trademarks and Monopolies.

²³ Parfums Christian Dior SA & Parfums Christian Dior BV v. Evora BV C-337/95 [1998] ETMR 26 <https://curia.europa.eu/juris/liste.jsf?num=C-337/95>.

²⁴ <https://curia.europa.eu/juris/document/document.jsf?docid=43440&doclang=EN>.

reasoning as protecting the mark's "advertising function". The CJEU agreed in principle that damage to a mark's reputation can constitute legitimate reason to oppose resale.

In this way, for the first time, the CJEU may be considered to have provided significant protection to its advertising and investment function in the case of the well-known trademark *L'Oréal*. This case opened the way for brand owners, particularly those in the luxury goods market, to seek to prevent the resale or promotion of their goods in undesirable circumstances.

Are the trademarks' functions expanding?

Some have identified trademarks as having a **cultural function**, forming social icons which are used in wider discourse to identify ideas and strengthen arguments because of the degree of recognition that they have in the eyes of consumers.

Over the last years, the CJEU has remarkably expanded the potential scope/function of trademark rights.

Under the EU Trademark Directive (TMD), a trademark owner may only prevent third-party uses of the mark if such uses are made (i) in the course of trade, (ii) in relation to goods or services, and (iii) *for the purpose of distinguishing the goods or services*, that is, as a trademark.

Nonetheless, the CJEU case law has evolved to accept a very broad view of the use as a mark requirement so as to include referential, comparative and decorative uses when such uses may somehow affect the origin function.

The following types and categories of signs can be imagined as registrable trademarks.

Word mark

This category includes company names, surnames, forenames, letters, numerals, geographical names and any other words or sets of words, whether invented or not, and slogans. Example:

LEVI'S

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enel

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²⁵ <https://www.gerbenlaw.com/trademarks/apparel/levis/#73210408>

https://en.wikipedia.org/wiki/Levi_Strauss_%26_Co

²⁶ <https://trademarks.justia.com/791/97/enel-79197631.html>

<http://www.museodelmarchioitaliano.com/route1/enel.php>

Figurative mark

It is a trademark where non-standard characters, stylization or layout, or a graphic feature or a color are used, including marks that consist exclusively of figurative elements. Example:



An example from the Bee:



Some cases from the Bee:

In 2019, Adidas has been unsuccessful in an attempt to expand its trademark three-stripe design in the EU after the court ruled it was not “distinctive” enough.²⁹

Figurative mark containing elements

A figurative mark consisting of a combination of verbal and figurative elements. Example:



²⁷ <https://en.wikipedia.org/wiki/Adidas>; <https://www.gerbenlaw.com/trademarks/footwear/adidas/>

²⁸ <https://en.wikipedia.org/wiki/Adidas>

²⁹ <https://curia.europa.eu/jcms/upload/docs/application/pdf/2019-06/cp190076en.pdf>;

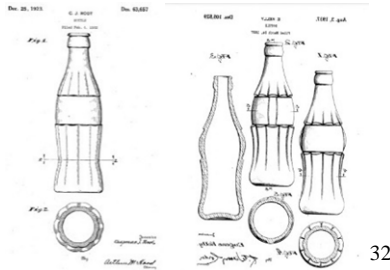
<https://www.theguardian.com/law/2019/jun/19/adidas-loses-three-stripe-trademark-battle-in-european-court>

³⁰ <https://www.fujitsu.com/global/about/businesspolicy/tech/intellectualproperty/brand/#anc-01>

³¹ <https://www.eni.com/en-IT/about-us/history-of-logo.html>

Shape or 3D mark

A shape mark consists of, or extends to, a three-dimensional shape. It can include containers, packaging, the product itself or its appearance. Example – contour bottle granted to Coca-Cola:



Shape or 3D mark with elements

A shape mark that contains verbal elements. Example - The Swiss chocolate, whose shape is based on the triangular shape of the Matterhorn peak, is protected by a 3-D trademark in the area of confectionery and is known for its shape being a long bar with a series of joined triangles (peaks):



Some cases from the Bee: **Poundland vs. Toblerone**

Poundland filed a challenge to the trademark of Mondelez-owned Toblerone in 2017 when it was set to release a similarly shaped chocolate bar called Twin Peaks, claiming that the shape was inspired by Wrekin Hill in Shropshire, unlike Toblerone which has a pyramidal shape said to be a version of the Alps' iconic Matterhorn. The case was closed based on negotiations and Poundland released a modified bar with asymmetrically arranged sloped hills instead of peak mountains.³⁴

Position mark

A position mark identifies the exact positioning of a mark with respect to its surrounding elements. For instance, logos appearing on shoes are placed using the same proportions across the line of footwear. The positioning itself must be considered unique to the company. Position marks are very often used to have protection in the fashion sector, for example to have protection. Example:

³² <https://www.uspto.gov/sites/default/files/about/offices/ous/121110.pdf>

³³ <https://www.roedl.com/insights/life-sciences-law/3-d-trademarks-protection-shape-registered-design-ritter-sport-toblerone>

³⁴ <https://www.dezeen.com/2020/08/01/chocolate-trademark-battles-kit-kat-toblerone-cadbury/>

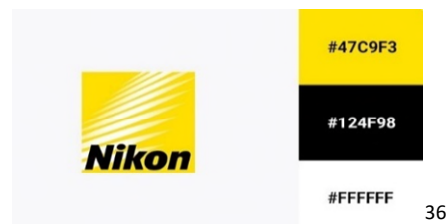


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Color single mark and color combination mark

A color single mark is just that – a trademark which consists exclusively of a single color (without contours) and a color combination mark consists exclusively of a combination of colors (without contours). Concerning the representation of color, one court held that “graphic” representation of color must be “clear, precise, self-contained, easily accessible, durable and objective”. Therefore, a mere sample of a color is insufficient, as a sample could deteriorate with time.

However, a description in words of the color or a designation of the color using an internationally recognized identification code may be acceptable. In a later decision, the same court said that combinations of colors in the abstract, without contours must also include “a systematic arrangement associating the colors in a predetermined and uniform way”. Example - The Nikon logo uses yellow as the primary color, paired with a strong contrast of white and black. The logo is friendly and bright, putting the customer at the center of their interest.



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Slogan mark

In most systems, slogans may be registrable as trademarks if they have the capacity to individualize the goods or services. Slogans may also acquire distinctiveness through use, whether they are used with or without another trademark, or as part of it. If a proposed trademark consists of a phrase that is entirely generic, descriptive, informational, or is otherwise not being used as a trademark vis-a-vis the goods sold by the trademark holder, the phrase will not be considered a “trademark”. Example of slogans that have been trademarked:

10 Famous Phrases/Slogan that Have Been Trademarked

1. "JUST DO IT" - Nike
2. "IMPOSSIBLE IS NOTHING" - Addidas
3. "WE HAVE THE MEATS" - Arbys
4. "I'M LOVIN' IT" - McDonalds
5. "IT'S FINGER LICKIN' GOOD" - KFC
6. "THINK DIFFERENT" - Apple
7. "A DIAMOND IS FOREVER" - Da Beers
8. "BECAUSE YOU'RE WORTH IT" - L'Oreal
9. "OBEY YOUR THIRST" - Sprite
10. "CAN YOU HEAR ME NOW" - Verizon

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³⁵ <https://www.plass.com/en/articles/position-mark>

³⁶ <https://www.creatopy.com/blog/logo-color-combinations/>

³⁷ <https://www.cohnlg.com/best-trademark-lawyers/how-to-trademark-a-phrase/>

Titles of books and films

It is generally admitted that serial titles and periodical or newspaper titles may fulfill a trademark function by identifying and distinguishing the successive issues of one publisher from those of other publishers or printers. In this case, the successive issues would be considered products emanating from a single commercial origin. Example:

Switzerland (Reg. No. 486 730), classes 9 and 41: "HARRY POTTER"

Sound mark

Known as a "jingle", as a unique sound, a combination of sounds or a melody that has proven recognition for the brand, are capable of distinguishing the goods or services and are capable of being represented graphically are registrable as trademarks. A description in words alone unaccompanied by a graphical representation of the mark is insufficient.

Simple sequential musical notation, without indications as to timing and pitch, will not meet the necessary requirements. Example:

*"The mark consists of the spoken words HI SA MI TSU superimposed over musical sounds in the key of D major, namely, the melody notes, e, a, e and 2 f sharp notes."*³⁸



Pattern mark

It is a trademark where non-standard characters, stylization or layout, or a graphic feature or a color are used, including marks that consist exclusively of figurative elements. This type of mark, commonly found in the fashion industry, protects the specific way design is tiled into a canvass. Example Louis Vuitton famous patterns. *"The mark consists of repeating, textured pattern as well as repeating checkerboard pattern on leather that covers the entire surface of the goods. The textured pattern is displayed in contrasting shades of black and grey in a weft and warp fashion which appear within alternating black and grey squares in a checkerboard pattern with the wording "LOUIS VUITTON PARIS" in grey written on one of the black squares."*

³⁸ The following are examples of sound marks that would not be accepted without evidence of acquired distinctiveness:

- a. very simple pieces of music consisting of only 1 or 2 notes.
- b. music commonly used as chimes by ice cream vans.
- c. children's giggling for childcare services or goods and services aimed at children.
- d. jingles commonly associated with amusement arcade machines.
- e. well-known popular music in respect of entertainment services.

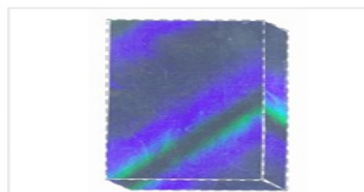


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Hologram mark

This is somehow a new category of trademark (as and from 1 October 2017). Since holograms may optically store and retrieve an image in three-dimensions, it may be difficult to capture the image in paper form, since depending on the angle that one looks at the image, the picture will change, and a paper print will not show the movement of the images.

Hologram marks consist of elements with holographic characteristics, covering the three-dimensional picture shown in a holographic device. Example:



EUTM 002559144

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Description The mark as shown in the attachment consists of holographic paper that reflects the spectrum of colour in a pattern of oblique, parallel lines applied to the surface of a package; the dotted lines shown in the drawing form no part of the mark, and are for 3-d illustrative purposes only.

Colour The whole spectrum of colour (hologram).

Motion and Multimedia mark

Moving trademarks are typically small animations, as seen in banners, but they can also be proper film sequences such as commercials. In this way, moving trademark consist in a long series of frames, which, put together, creates a movement. Example⁴¹:

European Community (Reg. No. 3429909), Classes 9, 28, 38, 41:



³⁹ <https://uspto.report/TM/88445688>

⁴⁰ <https://euipo.europa.eu/eSearch/#details/trademarks/002559144>

⁴¹ <https://euipo.europa.eu/ohimportal/en/trade-marks-examples>.



Gesture mark

Even though the registration of this type of sign remains exceptional, it would seem that graphic representation could be achieved through a drawing or picture and a description.

It may be more difficult to prove that the gesture is distinctive for the type of goods and/or services that it is intended to cover.

Example:

Mars BV has a registration in the Benelux Trademark Register for a gesture of two cutting fingers for its TWIX chocolate (BX No. 520574).

Olfactory mark

Regarding graphic representation of smell marks, the European Court of Justice, in the *Sieckmann case* (12 December 2002, C-273/00), gave an interpretation that corresponds to that on sound marks. In addition, the Court stated that *“In respect of an olfactory sign, the requirements of graphic representability are not satisfied by a chemical formula, by a description in written words, by the deposit of an odor sample or by a combination of those elements.”*

The first case was the well-known perfume manufacturer Chanel, that sought to register the fragrance of ‘Chanel No 5’ as an olfactory trademark in 1994. It described its perfume as a *“scent of aldehydic-floral fragrance product, with an aldehydic top note from aldehydes, bergamot, lemon and neroli; an elegant floral middle note, from jasmine, rose, lily of the valley, orris and ylang-ylang; and a sensual feminine note from sandal, cedar, vanilla, amber, civet and musk. The scent is also being known by the written brand name No 5”*. Its application failed because the shape of the product shall not result from the nature of the good itself. However, the smell of a perfume is the good itself and can therefore never be successfully registered as an olfactory trademark.

Taste mark

Some jurisdictions have accepted taste marks for registration but European Union Intellectual Property Office rejected the pharmaceutical company Eli Lilly’s attempt to register the taste of artificial strawberries noting in its decision in case R 120/2001-2 that *“Any manufacturer is entitled to add the flavor of artificial strawberries to those products for the purpose of disguising any unpleasant taste that they might otherwise have or simply for the purpose of making them*

pleasant to taste. Moreover, the taste is unlikely to be perceived by consumers as a trademark; they are far more likely to assume that it is intended to disguise the unpleasant taste of the product.”

Texture or feel marks

The surface of a product might lead to recognition due to a specific recognizable structure or texture. The graphic representation of the sign was achieved in embossed printing (Braille).

There is at least one instance of an issued trademark for the texture of product packaging described as *“a velvet textured covering on the surface of a bottle of wine”*.

Purpose mark

The purpose of a company can also be registered as a trademark. This is the case of Enel’s “OPEN POWER FOR A BRIGHTER FUTURE”.

TRADEMARKS are leading the sustainable revolution

Branding and sustainability

Trademarks serve to identify the origin of products and services, but they can also communicate a message to the public, for example, about the environmentally (eco) friendly characteristics of the product and services. Consumers tend to trust more labels issued from a third-party verified scheme, such as certification trademarks, e.g., Fair Trade, Vegan or Organic.

Finally, trademarks can help establish a brand value and equity for something that is intangible, so that it is seen as *“doing something good for the planet”* and allow companies to sell that message.

Preservation of biodiversity and resources

The recent events made us reflect on the connection between human conduct and planetary health. From Geographical Indications (GIS) to Plant Variety Rights (PVRs), trademarks can help to certify the origin of products including the quality of certain raw ingredients, such as *“organic”* food or *“natural”* cosmetics.

Authentic products

Brands are under increasing pressure to be more transparent about their supply chains, including treatment of workers or how they source raw materials. Blockchain technology is being used to fight counterfeits and parallel imports and can also help track the products' journey in the supply chain, guarantee authenticity and help address the consumers' demands to guarantee more transparency.

Circular economy

The European Commission adopted a **Circular Economy Action Plan**⁴² in March 2020 — one of the main building blocks of the European Green Deal. Any innovation can be covered by IPR protection from designing products for a longer duration, patents for renewable energy, and tech transfer, to technologies for recycling, upcycling and all the other economic opportunities of this fourth industrial revolution.

Having in mind the interaction of IP and sustainability in our community, WIPO's annual conference for World Intellectual Property Day, held on April 26, 2021, was on *“Innovate for a Green Future.”*⁴³ WIPO also issued its Green Strategic Plan (2019-2023) to help accelerate the transition to a greener global economy.

How trademark legislation can promote sustainable business practices⁴⁴

⁴² https://ec.europa.eu/environment/topics/circular-economy/first-circular-economy-action-plan_en

⁴³ <https://www.wipo.int/ip-outreach/en/ipday/>

⁴⁴ World Intellectual Property Day 2020 – Innovate for a Green Future, How trademarks can promote sustainability, web site of WIPO, https://www.wipo.int/ip-outreach/en/ipday/2020/articles/sustainable_trademark.html

Regarding trademarks and sustainability, more and more consumers today are conscious of environmental issues, and many wish to buy and consume products that are environmentally friendly.

Trademarks can have an important part in it. Trademarks can ensure that the product complies with certain standards. Consequently, more often you can see logos indicating that a product is certified by a particular organization.

Trademarks are therefore great means to communicate that a product is “green”, sustainable or otherwise environmentally friendly understandable terms such as “green”, “eco”, or “re” (for recycling).

Some “honey” from the Bee:

Being a sustainable bee, the main character of our research has decided to change her colors and use green and yellow instead of black and yellow, which are used for usual bee.

Do we underline the sustainability of the project in our logo by this action?

Most legal systems around the world provide specific types of trademarks for this purpose, known as certification marks, collective marks or guarantee marks.

As a rule, four options for protection should be considered by companies that want to announce and sell a green innovation on the market:

- i. individual trademarks
- ii. certification marks
- iii. collective marks, and
- iv. protected designations of origin (PDOs) or geographical indications (GIS).

Although in our research we are focusing on the individual trademark, in the light of the sustainability, we have to mention that each differs in terms of function and effect, they can all contribute to the successful marketing and the protection of environmentally friendly and/or sustainable innovations.

- i. **Individual marks** are the most frequently applied for and probably the best-known type of protection which guarantee a specific commercial origin. In the area of green innovations, a wide variety of individual trademarks can be applied to technologies or products.

Terms such as ‘green’, ‘eco’, ‘climate’, ‘re’ or ‘fair’ are extremely popular choices and green logos and signs are currently in vogue, they seldom meet the criteria for registration as all too often they are purely descriptive. If there is a lack of distinctiveness, components of the sign that clearly point to the sustainability of the product or service will be less important than distinctive components during the assessment of overall impression.

- ii. **Certification marks** are used for signs that are intended to certify that goods or services have certain characteristics and can guarantee, for example, that strict environmental regulations have been observed during a production process or that a product or technology is sustainable.

The main function of a certification mark is therefore to provide a guarantee, rather than to signify origin.

The GREEN BRAND sign is an example of an EU certification mark. Licensees of the mark can obtain certification for the ecologically sustainable quality of their products. To qualify companies must make various ecological and sustainable business decisions. These include reducing and avoiding waste, saving natural resources and training employees about environmental awareness.

In Italy, the GREEN BRAND will start with the first process presumably in summer 2021⁴⁵.

- iii. **Collective marks:** unlike individual marks, collective marks indicate that a product originates from a particular association, with the mark being owned by that association and can be used by any trader that is a member of that association. Like other trademarks, collective marks can be words or logos. Collective marks are also used as a tool for promoting sustainable development goals.

For example, German collective figurative mark DER GRÜNE PUNKT (the green dot), the sign indicates that the packaging concerned can be collected and recycled through a specific waste disposal system. Companies can therefore use DER GRÜNE PUNKT to indicate that their packaging will be dealt with in a sustainable manner. The Court of Justice for the European Union has recently confirmed that such indications can influence consumer purchasing decisions.



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- iv. **protected designations of origin (PDOs) or geographical indications (Gis):** such protection may be of particular interest to manufacturers and producers of food and agricultural products, including fruit and vegetables, fish, meat and meat products, cheese, baked goods or beer.

⁴⁵ <https://green-brands.org/en/countries/italy/>

⁴⁶ <https://www.gruener-punkt.de/>



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An important pre-requisite in this respect is the link between the characteristics of the product and its manufacture in the region of origin. Designations of origin require a particularly close link; all production steps must take place in the region in question.

Occasionally the sustainability of products labelled in this way can even be inferred from the indication itself, for example, the element ‘*bio*’ (meaning ‘*organic*’).

The potential of green trademarks in developing and marketing sustainable products and technologies is enormous. Trademark law offers many incentives for investments in sustainable ideas and concepts and can serve as a means for protecting these investments.

Some “honey” from the Bee:

The Consortium for the Protection of the Controlled Designation of Origin Prosecco has successfully filed an opposition against the UK registration BROSECCO in stylized form for wines, British sparkling wines and sparkling wines in Class 33.

The consortium is the institution officially recognized under EU law as coordinating and managing the PDO Prosecco, which has been in effect since August 2009 and concerns wines that meet certain conditions with regard to production and composition, including grapes of a particular variety grown in a defined area. Although the United Kingdom has left the European Union, Section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The decision therefore continues to refer to EU trademark law.

Decision

The hearing officer found that BROSECCO evoked Prosecco. The applicant’s explanation that the opposed mark was for a UK sparkling wine, originally conceived of to celebrate Brexit, did not assist him. The hearing officer considered the opposed mark to be highly similar in terms of both sign and products. She considered that evocation was all the more likely as UK consumers would know Prosecco very well and would think of it when encountering BROSECCO. For evocation to be established, it is only necessary that the opposed mark trigger the image of Prosecco; no confusion between the two signs is required. That UK consumers would associate the opposed mark with the prestigious PDO conferred an unfair marketing advantage on the applicant and enabled the opposed mark to ride on the coat tails of the established reputation of the PDO.

The hearing officer also found that BROSECCO would take an unfair advantage regarding marketing and benefit from the reputed PDO.

The courts have shown great willingness to defend these protected indications against misuse, even where there is no confusion, provided that the later sign brings the PDO to the mind of the consumer.⁴⁸

⁴⁷ <https://www.italianmade.com/usa/pdo-pgi/>

⁴⁸ Italian consortium successfully opposes BROSECCO wine mark on the grounds of Prosecco PDO, Burges Salmon LLP – UK, <https://www.worldtrademarkreview.com>

Alongside the need to set legislative objectives and frameworks, further huge investments in environmentally friendly technologies and concepts are required to establish an economic system that is focused on sustainability while still being efficient.

WIPO GREEN is a project launched in 2013 in a bid to catalyze and accelerate green technology innovation and its transfer to expand the uptake and use of environmentally friendly technologies in support of the transition to a low-carbon future.⁴⁹

A public-private partnership, WIPO GREEN unites green tech innovators and those seeking green solutions, public and private entities supporting climate-friendly tech, as well as experts in green innovation and other relevant fields. Through WIPOGREEN, WIPO and its partners offer practical solutions that support the development, adoption and deployment of green technology solutions.

As an online marketplace for sustainable technology, WIPO GREEN helps to connect green technology providers with technology seekers, such as sustainable access to water or climate-friendly sanitation management. It does this primarily through the WIPO GREEN database, which currently features more than 3,000 technologies and needs.

The WIPO GREEN database is the backbone of the WIPO GREEN platform. It covers technologies that help to both adapt to and mitigate the impacts of climate change and includes prototypes as well as marketable products. The database also includes the expressed needs of entities who are seeking technologies and solutions to help combat climate-related challenges. All featured technologies are available for license, collaboration, joint ventures and/or sale

At present, the database includes seven technology categories, like building and construction, energy, water, transport, etc. and

each category includes a series of related subcategories. For example, subcategories for Pollution and Waste include recycling, waste management, air pollution, etc.

Green technology growth outlook
(in billion euro)



Source: WIPO GREEN Strategic Plan 2019 – 2023

Registering trademarks enables companies to protect investments in sustainable, environmentally friendly technologies, products or services and to amortize financial expenses.

⁴⁹ <https://www3.wipo.int/wipogreen/en/aboutus/>

Strategically building up attractive IP portfolios in turn makes it easier to attract high-performing partners and investors for future projects.

 **Some “honey” from the Bee:**

Do make careful use of trademarks and branding to promote your “green” credentials!

Do not make exaggerated claims about how “green” your product or service is!

Do consider the use of certification marks to demonstrate compliance with sustainable practices but ensure that you can continually meet the requirements that go with it!

Don’t use complex or jargon-heavy language which might confuse or mislead consumers!

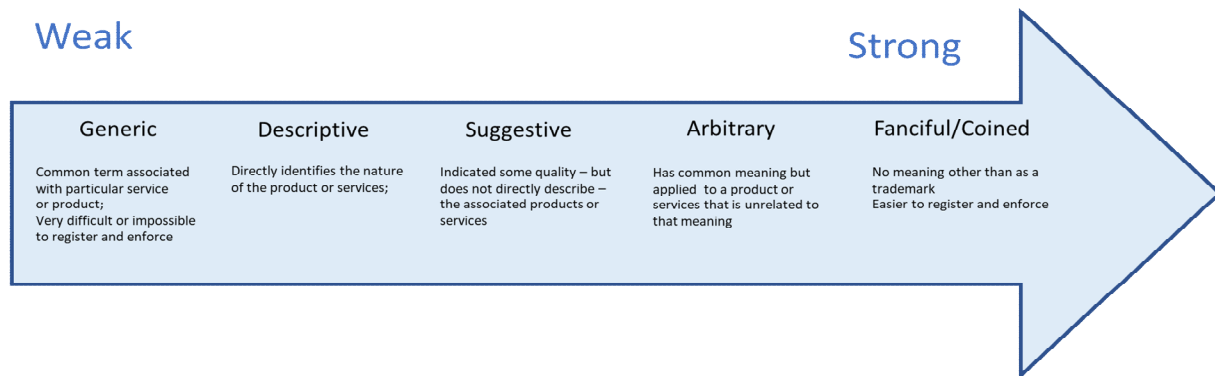
Strong and weak TRADEMARKS

Strong, memorable trademarks that's what business needs. Great trademarks inspire confidence in customers, before they even know who you are.

Trademarks can be qualified as “*strong*” or “*weak*”, or somewhere in between. It is really recommended to every business to develop strong marks from the earliest stages of his enterprise's development.

The nature of a mark, its strength or weakness, could have a direct effect on performance in the market as well as scope of legal protection. A “*strong*” mark is a mark that is highly distinctive, thus immediately identifying the owner as the source of the covered products or services. When a mark is scarcely distinctive, then the mark is considered “*weak*.” In general, the stronger a mark is, the easier it is for the mark to be eligible for registration and to obtain protection from unauthorized use and registration by others⁵⁰.

Trademarks are evaluated on a continuum ranging from generic, to descriptive, to suggestive, and finally, to arbitrary or fanciful. Recall that a trademark distinguishes the goods of one from all others.



Generic marks

Generic marks are trademarks that denote the product itself, rather than the source of the mark. Generic trademarks are never entitled to trademark protection. One cannot claim the word “*windmill*” as a trademark for a renewable wind turbine. The policy is simple: granting a trademark for a generic term would remove that term from the public lexicon—thereby excluding the public from its use.

Famous trademarks lose their trademark status because the public begins to associate the trademark name with the underlying product. By way of '*vulgarization*', a trademark may lose

⁵⁰ <https://www.inta.org/fact-sheets/trademark-strength/>

its distinctive character when it becomes the common name for the products or services which it is intended to identify⁵¹. This phenomenon is also called “*generification*” or “*genericide*”, and creates a conflict between the interests of the rightsholder of a trademark, that is the interest in maintaining the right of exclusive use upon the sign, and the social interest of using this same sign unrestrictedly as the name of the product or service that, originally, the trademark used to distinguish⁵².

This happened to Aspirin, Thermos, and Escalator; these dominant trademarks became such popular names that the marks became no more than generic identifiers of their underlying products.

Genericide is avoidable; the common strategy for companies facing a potential genericide is to try to advise the media and the public that the mark should not be used as a noun or a verb⁵³. Anyway, most companies don’t have to worry about this issue, since few products or services are successful enough to produce a generic mark (it tends to arise with revolutionary new products that the public comes to associate with the name their first manufacturer gives them)⁵⁴.

Descriptive marks

Descriptive marks are slightly stronger than generic marks but are only entitled to trademark protection under special circumstances. Descriptive trademarks are marks that describe or identify a significant one or more characteristic of the underlying product or service.

It can be said that “*a descriptive mark is a mark that directly describes, rather than suggests, a characteristic or quality of the underlying product (e.g. its color, odor, function, dimensions, or ingredients). For example, “Holiday Inn”, “All Bran,” and “Vision Center” all describe some aspect of the underlying product or service (respectively, hotel rooms, breakfast cereal, optical services). They tell us something about the product.*”⁵⁵.

In addition to registrability issues, descriptive marks are also difficult to protect from third-party use because competitive third parties need to use the same or similar descriptive words to describe their goods⁵⁶.

⁵¹ <https://www.internationallawoffice.com/Newsletters/Intellectual-Property/Spain/Grau-Baylos-Angulo/Vulgarization-of-Trademarks>

⁵² TRADEMARK GENERIFICATION: A CROSSCOUNTRY COMPARISON OF LEGAL REGIMES REGARDING THE LOSS OF THE EXCLUSIVE RIGHT Andreza Cristina Baroni Mónica Piedad Palma

⁵³ Patent, Copyright and Trademark.

⁵⁴ Stephen Elias Attorney, Richard Stim Attorney - Trademark_ Legal Care for Your Business & Product Name (2007, NOLO) - libgen.lc

⁵⁵ <https://cyber.harvard.edu/metaschool/fisher/domain/tm.htm>

⁵⁶ As example of quite descriptive trademark in English speaking territories can be used “Juice” which shall compete at least with JuiceBar and Juice Word. All the business which use such trademarks are providing service for the electric vehicles charging. In English speaking countries the word “juice” has a meaning “energy”, so Juice can be considered as a descriptive trademark.

Descriptive marks can attain trademark status, however, if they can attain “secondary meaning”. **Secondary meaning** is acquired distinctiveness that marks earn through strong consumer association. Trademarks may only earn secondary meaning status by presenting strong evidence of consumer recognition, length of use, and exclusivity of use. It can be argued that “*secondary meaning is a demonstration that the consuming public associates a mark with a single source, usually proved by advertising, promotion and sales. Consumer familiarity with an ordinary mark can make the mark distinctive and therefore legally protectible*”⁵⁷. The public need not be able to identify the specific producer; only that the product or service comes from a single producer⁵⁸.

As a concept, secondary meaning acknowledges that words with a regular and distinctive meaning of their own could become synonymous with a specific product. The general public then specifically identifies a product by this secondary meaning. The business is also required to show that the main significance of the secondary meaning is related to the producer rather than a product.

Coca-Cola® (ingredients come from coca leaves); American Airlines® (an American company that provides flight services); Western Digital® (sells tech products with headquarters in California); International Business Machines® (international seller of computers).

The business has the burden of proof in a secondary meaning case. It is possible by using both circumstantial and direct evidence. Direct evidence may include consumer testimony and consumer surveys.

Circumstantial evidence is any evidence that relates to the:

- advertising expenses
- number of customers and amount of sales, or
- manner, length, and exclusivity of the trademark’s use.

It usually depends on four factors when determining whether a trademark has acquired secondary meaning:

- length of time and how the mark has been utilized
- how much advertising and promotional work has been done for the owner’s business
- what efforts the mark’s owners have made to create a conscious connection between the mark and its owner in the mind of a consumer, and
- the extent that the public identifies the name with the mark’s services or goods.

Some “honey” from a bee:

The US Supreme Court issued a decision on June 2020, regarding marks incorporating generic top-level domains such as “.com.” The Court ruled that the addition of “.com” to a generic term can

⁵⁷ Stephen Elias Attorney, Richard Stim Attorney - Trademark_ Legal Care for Your Business & Product Name (2007, NOLO) - libgen.lc

⁵⁸ <https://cyber.harvard.edu/metaschool/fisher/domain/tm.htm>

*create a protectable trademark if the applicant provides evidence that consumers perceive the mark as distinguishable from a class of goods or services. An applicant company must submit evidence to the Authority to prove that consumers associate the primary significance of the mark with that particular company. Applicants may rely on carefully crafted surveys, dictionaries, and common usage by consumers and competitors. The Court reasoned that the primary significance of the registered mark to the public adequately turns a generic term into a descriptive term, which can be registered after acquiring **secondary meaning**.*

Booking.com was initially denied trademark protection by the US authorities. The authorities concluded that the terms, “booking” and “.com,” in the aggregate were generic. It argued that “booking” refers only to making travel reservations and “.com” signifies only a commercial website. Booking.com then sought review in the U.S. District Court and presented evidence of consumer perception that the mark had acquired secondary meaning, as required for trademark protection of a descriptive mark. The Supreme Court concluded that the exclusivity of a domain name allows a consumer to associate the mark with a particular website, which in turn makes trademark protection appropriate.

Suggestive trademarks

A suggestive mark hints at or suggests the nature of a product or service without describing the product or service. Such marks require the imagination, thought and perception of a consumer in order to determine the nature of the goods. Suggestive marks hint at the relevant product or service without really describing it. For this reason, generally, suggestive marks are entitled to meaningful but less extensive protection. In this category a mark is considered as inherently distinctive and worthy of protection immediately. Such marks do not need the requirement of secondary meaning.

KitchenAid® (suggests aid in the kitchen); Citibank® (suggests financial services); Netflix® (suggestive of movies on the internet); Microsoft® (suggestive of software); Airbus® (suggests air travel).

Arbitrary trademarks

Arbitrary marks are the next on the range of trademark strength. Arbitrary marks are those marks that use a familiar word in an unfamiliar way. Arbitrary marks are considered highly distinctive in identifying and distinguishing products or services and the scope of protection obtained is very broad.

Dove® (cosmetic products); Shell® (gasoline); Coach® (luxury handbags); Camel® (tobacco); Apple® (computers).

Some “honey” from a bee:

The case of Apple Corps, the record label founded by the Beatles, and Apple Computer illustrates the difficulties. The two companies entered into a trademark coexistence agreement in 1991. This provided that Apple Computer would have the exclusive right to use its Apple marks “on or in connection with electronic goods, computer software, data processing and data transmission services”; while Apple Corps would have the exclusive right to use its own Apple trademarks “on or in connection with any current or future creative work whose principle content was music and/or musical performances, regardless of the means by which those works were recorded, or communicated, whether tangible or intangible.” Thus, although the two companies had confusingly similar trademarks, they identified an area in which they were distinct – i.e. fields of use – and this became the basis of their coexistence agreement. The agreement permitted the two companies to continue to do business and build on their reputations without infringing on each other’s rights.

But neither company foresaw that the future development of digital music technologies was to bring the two fields much closer together. When Apple Computers launched the iPod and the iTunes software and music store, Apple Corps sued, claiming that Apple Computers had trespassed into the area exclusively reserved for Apple Corps, thus contravening the trademark coexistence agreement. The court looked at the issue from the point of view of the consumer and held that there had been no breach of the agreement as the Apple Computers logo had been used in connection with the software and not with the music provided by the service. No consumer downloading music using the iTunes software would think they were interacting with Apple Corps.

Despite the coexistence agreement, expensive litigation was not avoided in this case. As in all agreements, therefore, it is advisable to include a clause on dispute settlement for when problems arise in the future⁵⁹.

Fanciful or Coined Marks

The strongest marks are those that are considered fanciful or coined. A fanciful mark is one that has been made up or invented by its owner. Fanciful marks are either previously unknown words, which are invented solely for its use as a trademark. It is a word or words that have a common meaning in the language of the relevant jurisdiction; however, that meaning is unrelated to the goods or services for which the mark is used. No-word marks (letters, numbers, designs and pictures) may also be considered fanciful. Since a fanciful or coined mark has no inherent meaning, in the beginning a bigger effort in terms of advertising is necessary in order to educate the public as to the relationship between the invented word and the owner’s product or service. However, such marks, give trademark owners the best chance of creating a strong and positive brand association between a mark and its associated goods or services. Once goodwill has been

⁵⁹ IP and Business: Trademark Coexistence By Tamara Nanayakkara, WIPO SMEs Division, https://www.wipo.int/wipo_magazine/en/2006/06

established, fanciful marks provide trademark owners with the broadest scope of protection against third-party use of the same or a similar mark.

ENEL (electricity), KODAK® (photographic products/services); Exxon® (oil and gasoline); Pepsi® (soft drinks); Clorox® (bleach and cleaning supplies), GOOGLE® (online services), ROLEX® (watches).

Thus, from a trademark perspective, the strongest marks are those that are fanciful or arbitrary, and suggestive; the weakest are those that are merely descriptive. Generic terms cannot be trademarks. From a business perspective, sometimes a fanciful or arbitrary mark may not be appropriate for a particular product. Nevertheless, whenever possible, trademark owners should take care to choose a strong mark that helps to position their products in the marketplace, and to avoid choosing one that is considered merely descriptive or generic.

Some “honey” from a bee:

Did you know that commencing use of your mark is especially important in jurisdictions such as the United States and Canada, which follow a “first to use” policy (i.e., priority rights in the trademark are based on first use)? Other jurisdictions, such as European or Chinese jurisdictions, follow a “first to file” policy, meaning that priority rights in a mark are assigned to the party that first files an application for registration of the mark. In “first to file” jurisdictions, timely filing of your application is especially key.

Search for existing trademarks

The first step for every business is creating a protectable and attractive brand. Next critical step, which is also very important, is the trademark clearance search. It is necessary to determine whether the proposed brand is available for trademark registration. When inventing and adopting a new trademark, there is the risk that a competitor may have registered an identical or very similar mark in your product or service category (or related category) and a clearance search is the only measure to find out that risk.

A business that invests in a new trademark without knowing whether the mark is legally available is putting that investment at risk. This is owing to the possibility of having to change the mark, sometimes after the mark is already well established and known by consumers, at the request of a registered trademark owner previously unknown. As a part of sustainable development business should avoid confusion with others consider it as a form of respect towards clients and third parties.

It is necessary to ensure that the proposed mark does not infringe on the mark of another already in use, to search for existing marks and to analyze the results found.

Trademark searches will typically fall into one of the following categories:

- **identical trademark search** to identify marks or devices that are visually or phonetically identical
- **similar trademark search** to identify identical and confusingly similar marks
- **trademark search with opinion ('Search with advice')** to include an advisor's recommendation on the results of the identical or similar trademark search based on their consideration of the prior marks identified
- **index search** to identify companies with identical/similar names to the search terms
- **in-use verification search** to examine whether a third party with prior rights is using its trademark rights correctly, which may provide grounds to challenge a registration and
- **trade name search** to identify trade name rights that may conflict with your desired trademark, by identifying companies with identical/similar names to the search terms.

In order to ensure that your search effectively locates all potential conflicts, it is recommended:

- to search for phonetic variants of the proposed name, because phonetically similar marks can cause a trademark conflict. For example, if the company's name is (1) quick; search for (2) quik; (3) quic; (4) kwick; (5) kwik; (6) kwic and so on
- to search for both the plural and singular versions of your proposed name
- if the name uses more than one word, to search for each word individually
- to follow the instructions in the use of wildcard search terms.

In addition, it is recommended to examine a chosen trademark for unintended meanings or associations. It is of particular importance should a company be launching its product or brand in certain overseas countries where you could be caught out by linguistic and cultural differences, how the trademark may be perceived in the real world (e.g., whether a mark has an undesirable meaning; would create confusion as to the nature of the product or service; or would be difficult to read, spell, or pronounce in that country).

Some "honey" from a bee:

Chevrolet NOVA car did not sell well in many Spanish-speaking countries because "no va" in Spanish means "does not go." Local guidance can be invaluable and will help you avoid such costly mistakes⁶⁰.

⁶⁰ Considerations in Selecting a Trademark, web site of International Trademark Organization, <https://www.inta.org/fact-sheets/considerations-in-selecting-a-trademark/>

TRADEMARK infringement

What is **trademark infringement**?

Trademark infringement *“exists when any person, without the consent of the trademark registrant/owner, uses the same or a confusingly similar mark, on the same or closely related goods or services, in the same geographical area or, in some cases, within a natural area of expansion”*⁶¹.

Trademark infringement verifies when a party uses a trademark which is identical or like a trademark already registered for identical or similar goods and/or services. Therefore, the effect of trademark infringement is to cause (also in a potential way) confusion, deception, or mistake about the source of the goods and/or the services. It is not necessary to prove actual confusion of customers to prove trademark infringement⁶². Proving likelihood of confusion in the market satisfies the requirement so that similar marks in physical design could constitute cases of infringement⁶³.

For the aim of determining whether there has been a trademark infringement, a court should thus proceed through two steps.

First, the court should determine whether the plaintiff’s trademark is distinctive of source and thus eligible for trademark protection⁶⁴: *“Underlying this inquiry is the assumption that if the plaintiff’s signifier-referent combination is not itself distinctive of the plaintiff’s signified, then no similar signifier-referent combination will also be distinctive of, and thus trespass upon, that signified. Having determined that the plaintiff’s signifier referent combination is itself distinctive of the plaintiff’s signified, the court should then determine whether the defendant’s signifier-referent combination is sufficiently similar to the plaintiff’s as also to be distinctive of the plaintiff’s signified. Here, the court should consider not the source distinctiveness of the plaintiff’s mark, but its differential distinctiveness, the distance between it and the nearest, most similar marks, other than the defendant’s, in trademark features space”*⁶⁵.

Some “honey” from a bee:

The Worldwide Fund for Nature (WWF) (now WWE) sued the wrestling company Titan Sports when the latter changed its name to the “World Wrestling Federation” or “WWF”. The legal action lasted for almost 13 years.

⁶¹ P.R. Paradise, *Trademark counterfeiting, product piracy and the billion dollars threat to the U.S. economy*, Greenwood Publishing Group, 1999, p. 32.

⁶² M. Cosgrove, D. Marsh, J.F. Chester, S. Cosgrove, *Case Study: Trademark Infringement Issues*, in *Journal of Business Case Studies*, March/April 2011, vol. 7, n. 2.

⁶³ M. Cosgrove, D. Marsh, J.F. Chester, S. Cosgrove, *Case Study: Trademark Infringement Issues*, in *Journal of Business Case Studies*, March/April 2011, vol. 7, n. 2.

⁶⁴ Research Handbooks in Intellectual Property] Graeme B. Dinwoodie, Mark D. Janis - *Trademark Law and Theory_ A Handbook of Contemporary Research* (2008, Edward Elgar Publishing) - libgen.lc, p. 57.

⁶⁵ M. Cosgrove, D. Marsh, J.F. Chester, S. Cosgrove, *Case Study: Trademark Infringement Issues*, in *Journal of Business Case Studies*, March/April 2011, vol. 7, n. 2.

In 2001, a London High Court ruled in the favor of the Worldwide Fund: according to the ruling, the wrestling federation had broken a 1994 agreement according to which the federation has promised to restrict its use of the initials in its business activities. After the issuing of the decision, the federation decided to re-brand its name “World Wrestling Entertainment” (WWE), with all the consequential costs.

Lesson learnt: a priority research could have saved a lot of money and also of time for the wrestling federation.

A victory in favor of protection of environment!

Monster Energy v. Thirsty Beasts

In 2018, a “healthy” drinks company called Thirst Beasts was launched. Its slogan was “Rehab the beast”. Shortly afterwards, Monster Energy, another drinks company, sued Thirsty Beasts for trademark infringement, claiming the slogan of the latter one would have been confused by customers with its own slogan “Unleash the beast”.

The dispute was brought before the UK Trademark Office, which ruled in favor of Thirsty Beasts. The decision was challenged by Monster Energy, but the second-degree ruling confirmed the first-degree one. However, the legal costs sustained by the founder of Thirsty Beasts have been quantified in £75,000.

Therefore, defending even a real strong trademark could be very expensive.

Lesson learnt? Defending its own legitimate trademark can cost a company a lot of money. Therefore, when choosing a trademark, a company may also evaluate to undertake a more “defensive” and careful approach which means that it should evaluate in advance if the trademark to be adopted could cause a company an expensive legal defense.

The cease and desist letter

The cease-and-desist letter is a somehow classical approach aimed at opposing the illegitimate use of a trademark. This instrument is greatly diffused in North - American system.

The letter should contain the following requests: 1) the notice to immediately stop all commercial operations related to the alleged violation with its regulatory reference; 2) the immediate destruction of the articles/products resulting from the infringement and of the machinery used to produce such articles and/or products; 3) disclosure of the total number of items and/or products and the identity of all purchasers; 4) the release of information of the earnings obtained from the sale of each item and/or product⁶⁶. According to the literature on the matter, the

⁶⁶ http://www.uibm.gov.it/attachments/article/2006088/lettera_cease_desistrev_handout_color.pdf.

request for immediate payment of fees characterize the letter as abusive⁶⁷. The letter could be followed by negotiations between the parties, or by the starting of a legal dispute before a Court.

It is not advisable for the alleged violator to ignore the content of a cease-and-desist letter, because, in case the dispute is brought before a Court and the defendant is found responsible, not paying attention to it and not rectifying the situation can be seen by the judge as proof of the deliberation of the unlawful acts and exacerbate the procedural position of the defendant, exponentially increasing the compensation for damages⁶⁸.

Nowadays a less formal way of opposing the illegitimate use of a trademark is also diffused: some companies have turned their cease and desist communications into marketing campaigns, social media promotions, or even just initial gentle words that only escalate if necessary⁶⁹. An aggressive approach may have a negative impact on consumers.

Some "honey" from a bee:

In 2013, Missouri brewer Jeff Britton was told in a letter sent by Starbucks that the name "frapuccino" used to describe a beer served in his pub too much resembled the name of the Starbucks' "Frappuccino", and he was given 14 days to respond to the company's request to remove any sources of potential confusion with the Starbucks brand. The owner of the pub responded to Starbucks, stating that they never thought their beer drinking customers would confuse the beer coming out of their taps with coffee from the Starbucks and, enclosing with the letter a check for six dollars "for the full amount of profit gained from the sale of those three beers"⁷⁰. The issue went viral, and many consumers saw the Starbucks' approach as too aggressive. Lesson learnt? A less formal approach may have better preserved the reputation of Starbucks.

Preliminary injunction relief

In case of trademark infringement, the infringed party may want to seek an immediate remedy in order to obtain the other party's the cessation of the illegitimate use of the trademark.

According to the Italian Code of Intellectual Property the following remedies are allowed:

- the **description** intended to acquire evidence of the infringement of the trademark. However, these elements can sometimes be more simply acquired in other ways, for example by procuring the counterfeit product or catalogs or promotional or advertising material from which the counterfeit appears, and so on;

⁶⁷ L.C. Grinvald, *Policing the Cease-and-Desist Letter*, *University of San Francisco Law Review*, Vol. 49, p. 409, 2015.

⁶⁸ http://www.uibm.gov.it/attachments/article/2006088/lettera_cease_desistrev_handout_color.pdf.

⁶⁹ <https://www.jdsalaw.com/law-talk-archives/2018/7/17/trademark-infringement-creative-approaches-to-cease-and-desist-communications>.

⁷⁰ <https://www.jdsalaw.com/law-talk-archives/2018/7/17/trademark-infringement-creative-approaches-to-cease-and-desist-communications>.

- the **seizure**, which has the main purpose of removing from the availability of the counterfeiter the objects that constitute a violation of the trademark, as well as probative purposes.
- the **injunction** and the **order to withdraw** from the market are intended to prevent the production, use and marketing of what constitutes a violation of the law. The other precautionary measures can also be requested jointly or subject to the description.

These remedies are different in every country. For example, in Spain article 134 of the Intellectual Property Code sets out the specific injunctions to be requested by the claimant in relation to a trademark. These injunctions are as follows:

- cease the infringing acts
- seizure and deposit of the manufactured or imported objects infringing the trademark owner's rights and seizure and deposit of the means exclusively aimed at the manufacturing of the infringing products
- warranty bond to ensure the payment of damages
- annotations in the Spanish Patents and Trademarks Office's Registry and other public registries⁷¹.

Requirements are generally the same in every country:

- ***periculum in mora***: the existence of a danger in the delay of issuing the preliminary relief requested. The claimant has to prove that the activity of the alleged infringer is already causing significant damage to the claimant's rights, and that the long delays that usually occur in civil proceedings before a final decision is issued at First Instance, may result in the final judgment lacking effect
- ***fumus boni iuris***: the claimant has to prove that he is entitled to enforce his alleged rights and that there are good reasons to believe that these rights are indeed being infringed by the defendant. When assessing this second requirement, the Court will not thoroughly analyse whether the claimant's rights are being infringed, but will merely state whether, in light of the evidence filed, it seems that his rights are being infringed. Accordingly, the decision issued by the Court in this regard shall not prejudice the decision of the main trademark infringement proceedings.

And in arbitration?

Parties may provide for preliminary injunctive or interim reliefs in the ADR provision of their contract or in the arbitration rules they adopt in that provision. In order to obtain interim relief before an arbitration panel is constituted, most rules of the leading arbitration institutions have introduced the possibility of appointing an Emergency Arbitrator who will decide on the issuance of interim measures. These rules are being increasingly used by parties to request interim measures. Parties who anticipate the need for arbitral interim relief or who want to leave the

⁷¹ <https://www.twobirds.com/en/news/articles/2007/trade-marks-preliminary-injunction-claims>.

possibility open should provide for it in their ADR provision or make certain it is available in the arbitration rules they adopt. Otherwise, the parties may end up addressing the issue of preliminary injunctive relief before a Court⁷².

Dilution

Trademark dilution refers to the unauthorized use of and/or application for a trademark that is likely to weaken the distinctive quality of or harm a famous mark⁷³. In particular, *“dilution occurs when someone uses a famous mark in a manner that blurs or tarnishes the mark. In other words, dilution diminishes the capacity of a famous mark to identify and distinguish goods or services, regardless of the presence or absence of:*

- *competition between the owner of the famous mark and other parties, or*
- *likelihood of confusion, mistake, or deception (15 U.S. Code § 1527).*

*Dilution is therefore different from trademark infringement because trademark infringement always involves a probability of customer confusion, whereas dilution can occur even if customers wouldn't be misled”*⁷⁴.

The dilution rule permits the owner of a famous mark to take actions because the famous trademark will lose its distinctive character and strength in case of diluting use of the mark. Additionally, according to some courts, the public would be in any case confused by the use of a famous mark because they would anyway associate to some extent the famous mark with the second user⁷⁵.

Trademark dilution is recognized in many countries, but the concept and associated requirements change by jurisdiction. For instance, trademark dilution is expressly recognized in the United States, the European Union, South Africa, India, and Japan, as well as several Central and South American countries. Others, such as Canada and Australia, have no explicit dilution law but provide similar protection under other trademark laws⁷⁶.

It should be noted that EU legislation does not provide the concept of dilution but mentions the notion of **detriment to repute and distinctive character**, which constitute dilution. In particular EU legislation provides for *“the proprietor of the earlier mark to oppose a registration or to*

⁷² L. Kaster, H. Samaras, *Arbitrating Trademark, Copyright, and Trade Secret Cases*, College of Commercial Arbitrators, <https://www.ccarbitrators.org/wp-content/uploads/Arbitrating-Trademark-Copyright-and-Trade-Secret-Cases.pdf>.

⁷³ International Trademark association, *Fact Sheet: Protecting a Trademark Trademark Dilution (Intended for a Non-Legal Audience)* updated November 9, 2020 available at <https://www.inta.org/fact-sheets/trademark-dilution-intended-for-a-non-legal-audience/>

⁷⁴ Richard Stim, Patent, copyright & trademark - An Intellectual Property Desk Reference (2020, NOLO), p. 402

⁷⁵ Stephen Elias, Richard Stim Trademark- Legal Care for Your Business & Product Name (2007, NOLO) p. 241

⁷⁶ International Trademark association, *Fact Sheet: Protecting a Trademark Trademark Dilution (Intended for a Non-Legal Audience)* updated November 9, 2020 <https://www.inta.org/fact-sheets/trademark-dilution-intended-for-a-non-legal-audience/>

prevent use of similar or identical mark, if dilution of his mark occurs in the form of taking unfair advantage of, or detriment to the distinctive character or the repute of the mark”⁷⁷.

Misleading use of TRADEMARK

The misleading use of a trademark creates customer confusion where a misleading mark causes the customer to believe - wrongly - that a product or service is somehow connected with a business that the customer already knows. In other words, the misleading use of a trademark creates confusion in the customer about the source of the product or service⁷⁸.

An example of misleading use of a trademark can be found in the following case law: a company that maintains and repairs cars combines its own brand with the brand of a well-known car manufacturer (BMW). Even if specialized in the repair and maintenance of BMW cars, it had no formal connection with BMW, other than as user of BMW's spare parts. BMW sued the maintenance company for trademark infringement. In this case it was necessary to distinguish between uses that conveyed the true message "*my business provides a service which repairs BMWs or uses genuine BMW spare parts*" (informative use) and those that conveyed the false message "*my repairing service is commercially connected with BMW*" (misleading use). According to the Court, which of these messages was conveyed should be assessed based on a close consideration of the details and context of the use⁷⁹. In this case, no steps had been taken to make it clear that the BMW mark was used only for information purposes, so the court decided that the use of the mark was unlawful⁸⁰.

Legitimate use of third party's TRADEMARK

There are certain cases in which it is legitimate to use another party's registered trademark. As regards European Union legislation, these cases are regulated by article 14 of the EU Directive 2015/2436 which provides that:

“1. A trademark shall not entitle the proprietor to prohibit a third party from using, in the course of trade:

- a) the name or address of the third party, where that third party is a natural person*

⁷⁷ Alina Shchetinina, The Dilution of a Trademark: A Comparative Study on EU and U.S. Law, TTLF Working paper n. 35, available at https://law.stanford.edu/wp-content/uploads/2018/05/shchetinina_wp35.pdf, p.10

⁷⁸ Stephen Elias, Richard Stim, Trademark- Legal Care for Your Business & Product Name (2007, NOLO), p. 117

⁷⁹ <https://www.twobirds.com/en/news/articles/2017/uk/it-and-ip-law-bytes-aug-17/trade-marks-infringement-informative-or-misleading-use>

⁸⁰K. Oliver, Defining a line, between informative use and misleading use of a trade mark, available at <https://www.albright-ip.co.uk/2017/07/defining-line-informative-use-misleading-use-trade-mark/>

- b) *signs or indications which are not distinctive, or which concern the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of the service, or other characteristics of goods or services*
- c) *the trademark for the purpose of identifying or referring to goods or services as those of the proprietor of that trademark, in particular, where the use of the trademark is necessary to indicate the intended purpose of a product or service, in particular as accessories or spare parts.*

2. Paragraph 1 shall only apply where the use made by the third party is in accordance with honest practices in industrial or commercial matters.

3. A trademark shall not entitle the proprietor to prohibit a third party from using, in the course of trade, an earlier right which only applies in a particular locality, if that right is recognized by the law of the Member State in question and the use of that right is within the limits of the territory in which it is recognized.”

This first hypothesis states that the right conferred by the registered trademark does not allow the proprietor to prevent a natural person from using his name or address carrying out an economic activity. However, once a sign consisting of a certain personal name has been validly registered as a trademark, even the person legitimately bearing that name may no longer adopt it as a trademark (in conflicting fields of trade). Likewise, a person or company can continue to use its address.

As regards the address, the principle of freedom to use one's own address in economic activity (on letterheads, business cards and even on the goods themselves) is justified by the consideration that an economic operator cannot be required to make disproportionate sacrifices only in respect of an earlier registered trademark.

As regards the use of non-distinctive or exclusively descriptive signs or indications, it is clear that the prohibition to use a third party's trademark cannot apply to signs which are non-distinctive or consist “*exclusively*” of descriptive indications referring to the goods marked.

The third hypothesis is the referential use of another person's trademark and to indicate the destination of one's own product. Some goods do not perform an autonomous function but serve only as complements to other goods. A spare part for a car has no independent use value unless it is used to replace the original part that has worn out or broken down. If the manufacturer of these types of complementary goods could not accurately recall the complex good to which they relate, it would not be able to be present on the market. The manufacturer of the main good would thus achieve a monopolistic position on the accessories or spare parts of that good. For this reason, for example, a car spare parts company may place its trademark on the packaging of the product “*wheel rim*” and the words “*compatible for Ford cars*” using the trademark of that car manufacturer. The use of another person's trademark is, however, permitted subject to compliance with the conditions of fairness set out in the regulation, so that the spare parts firm

in question must ensure that the consumer is not confused as to the origin of the spare part and that it is clear to him that it comes from the firm of the spare parts producer and not from the firm Ford⁸¹.

There are also atypical hypotheses of legitimate use of third-party trademarks which, for reasons of synthesis, are not examined here.

Below are listed some of the hypothesis of use of third party's trademark often discussed in the jurisprudence:

- sale of used products
- information about an element that makes up your product (e.g.: component, ingredient, raw material....)
- illustration of content of product/service (case of publication specialized publication, or on a sports theme)
- sales technique of concordance tables in the field of perfumery
- use of terms "*type*", "*similar*", "*model*"
- use of trademark as word keyword within of a service of Internet positioning (keyword advertising)
- reproduction of the trademark for decorative - ornamental purposes (toy models, scarves, jerseys and team flags)
- extension by analogy or by extension to different hypotheses, without a descriptive purpose
- extension by analogy or extension to different hypotheses, without a descriptive purpose in the communication to the consumer
- use of accessories or spare parts
- compatibility between two goods
- parody
- comparative advertising⁸².

Counterfeiting of TRADEMARKS

EU Regulation 608/2013, in which the European Union laid down the rules for the protection of intellectual property rights and regulated the intervention of Customs authorities in case of goods suspected of counterfeiting, defines '*counterfeit goods*' as "*goods which are the subject of an act infringing a trademark in the Member State where they are found and bear without authorization a sign which is identical to the trademark validly registered in respect of the same*

⁸¹L. Zanatta, *La tutela del marchio*, available at

<http://www.confartigianatoasolomontebelluna.it/it/associazione/in-evidenza/la-tutela-del-marchio#:~:text=Dunque%2C%20si%20pu%C3%B2%20dire%20che,quella%20che%20l'utilizzo%20del>

⁸² Umberto Luigi Scotti, *Gli usi non distintivi del marchio altrui: la pubblicità comparativa, la nuova casistica e i principi generali che se ne possono desumere*, available at <https://www.filodiritto.com/sites/default/files/articles/documents/0000002101.pdf>

type of goods, or which cannot be distinguished in its essential aspects from such a trademark” (art. 2)⁸³.

In other words, a counterfeit good is an unauthorized imitation of a branded good. A definition can be found also in the enforcement section of an agreement on intellectual property rights negotiated in the World Trade Organization, known as the TRIPS Agreement:

"Counterfeit trademark goods shall mean any goods, including packaging, bearing without authorization a trademark which is identical to the trademark validly registered in respect of such goods, or which cannot be distinguished in its essential aspects from such a trademark and which thereby infringes the rights of the owner of the trademark in question under the law of the country of importation."⁸⁴

Confusion

Trademarks’ original function is to allow consumers to navigate between products using trademarks as product identifier; the concept of confusion - or, more precisely, of - likelihood of confusion connects to this essential function⁸⁵.

Likelihood of confusion is a standard relevant both with reference to registration of a trademark and to infringement.

As regards EU legislation, Article 8(1)(b) EUTMR states that, upon opposition, a EUTM application shall not be registered: *“...if because of its identity with or similarity to the earlier trademark and the identity or similarity of the goods or services covered by the trademarks there exists a likelihood of confusion on the part of the public in the territory in which the earlier trademark is protected; the likelihood of confusion includes the likelihood of association with the earlier trademark (emphasis added).”*

In matters of infringement, art. 9 (1)(b) of the EUTMR provides that that *“[t]he registration of a trademark shall confer on the proprietor exclusive rights therein (. . .) [T]he proprietor of that registered trademark shall be entitled to prevent all third parties not having his consent from using in the course of trade, in relation to goods or services, any sign where (. . .) the sign is identical with, or similar to, the trademark and is used in relation to goods or services which are identical with, or similar to, the goods or services for which the trademark is registered, if there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association between the sign and the trademark.”*

⁸³ Agenzia delle Dogane e dei Monopoli, Counterfeiting and protected rights, available at <https://www.adm.gov.it/portale/en/ee/trader/the-fight-against-counterfeiting/what-is-counterfeiting>

⁸⁴ European Commission, Counterfeiting and Piracy - frequently asked questions, MEMO/10/272 available at https://ec.europa.eu/commission/presscorner/detail/en/MEMO_10_272

⁸⁵ Rasmus Dalgaard Laustsen, The Average Consumer In Confusion-based Disputes In European Trademark Law And Similar Fictions (2020, Springer), p. 262.

Likelihood of confusion should be assessed globally, considering all relevant factors and the overall impression given by the marks (visual, phonetic, conceptual...) from the perspective of the relevant public. Also, the distinctiveness of the earlier mark should be taken into account, where relevant. The assessment should be from the point of view of the average consumer of the category of goods concerned, who is well informed and reasonably observant and circumspect. The average consumer level of attention may vary according to the category of goods or services in question.⁸⁶

As regards US legislation, likelihood of confusion is considered a reason for refusing registration. According to the US Patent and Trademark office *“Likelihood of confusion exists between trademarks when the marks are so similar and the goods and/or services for which they are used are so related that consumers would mistakenly believe they come from the same source”*. To determine whether a likelihood of confusion exists, the marks are first examined for their similarities and differences (likelihood of confusion can be found also if the marks are not identical). Even if two marks are found to be confusingly similar, a likelihood of confusion will exist only if the goods and/or services upon which the marks are used are, in fact, related. Also, in this case, to find relatedness between goods and/or services, the goods and/or services do not have to be identical⁸⁷.

Likelihood of confusion is also taken into consideration by US Courts in determining infringement cases. In determining likelihood of confusion, courts use several factors derived from a 1961 case⁸⁸. These factors, sometimes known as the *“Polaroid factors,”* can vary slightly as federal courts apply them throughout the country and are intended as a guide (not all of them may be relevant)⁸⁹.

Some “honey” from a bee:

Try to read: “ène light”, don’t you think that it sounds familiar and reminds you something?

⁸⁶ Gordon Humphreys Chairperson of the EUIPO First Board of Appeal Virtual Event, ‘Perfecting Pharmaceutical Trade Mark Protection: Pinnacles and Pitfalls’, 10 February 2021, presentation available at https://www.ucl.ac.uk/laws/sites/laws/files/4_ucl-ibil_10feb21_humphreys.pdf

⁸⁷ <https://www.uspto.gov/trademarks/search/likelihood-confusion>

⁸⁸ Polaroid Corp. v. Polarad Elecs. Corp., 287 F.2d 492 - 2d Cir. 1961.

⁸⁹ Richard Stim, Patent, copyright & trademark - An Intellectual Property Desk Reference (2020, NOLO), p. 451

- Strength of the senior user’s mark. The stronger or more distinctive the senior user’s mark, the more likely the confusion.
- Similarity of the marks. The more similarity between the two marks, the more likely the confusion.
- Similarity of the products or services. The more that the senior and junior user’s goods or services are related, the more likely the confusion.
- Likelihood that the senior user will bridge the gap. If it is probable that the senior user will expand into the junior user’s product area, it’s more likely there will be confusion.
- The junior user’s intent in adopting the mark. If the junior user adopted the mark in bad faith, confusion is more likely.
- Evidence of actual confusion. Proof of consumer confusion is not required, but when the trademark owner can show that the average reasonably prudent consumer is confused, it is powerful evidence of infringement.
- Sophistication of the buyers. The less sophisticated the purchaser, the more likely the confusion.
- Quality of the junior user’s products or services. In some cases, the lesser the quality of the junior user’s goods, the more harm is likely from consumer confusion.

Ène light srl was registered in 2017 in Milan. The purpose of the company has been stated as trade in electricity, natural gas, petroleum products, coal, others energy products and carrying out the necessary, appropriate and related activities to the purchase of electricity and natural gas nationally and internationally.

Shall Enel just “fly by” that fact?



The court agreed that is indisputable evidence that ène light have put in place a studied confusion strategy, aimed at inducing the impression on the market that ène light are attributable to companies of the Enel Group.

Already the company name ène light easily to be confused with the names of the companies and brands of Enel. The separation between the two parts of the name is in fact in no way sufficient to avoid confusion. As if that were not enough, ène light, operated in the market, which, both for the name and for the characters chosen, constitutes illicit imitation of trademarks and typefaces registered by Enel. The assonance with the name “Enel”, the similarity between the graphics and the combination of colors in fact used by the ène light are obvious. The slight differences are irrelevant, such as the accent on the initial “e”, as well as adding the generic term “light”. The combination of “ene (l)” and “light” is therefore easily perceived as a confusion between the well-known brand of the first group Italian energy and a commonly used term (moreover, used by Enel for its “E-Light”). Trademarks are confusing when the others can believe (due to its similarity) that the marked goods or services come from same company or there is a link between these companies.

 ***Some “justice” from a bee (and the Civil Court of Milan, August 2020):***

Inhibit any use (such as company name, brand, sign or other) in any location (such as, for example, social networks and YouTube) and with any modality of the “ène light” trademark and distinctive signs that can be confused with the distinctive signs legitimately held and used by Enel.

Genuine use and its requirements

Under the current EU laws, genuine use is one of the prerequisites for trademark holders to maintain the validity of trademarks and their ability to enforce their trademark rights against third parties. Lack of genuine use could thus lead to trademark revocation or refusal to register a trademark.⁹⁰ According to article 18 EUTMR, *“If, within a period of five years following registration, the proprietor has not put the EU trademark to genuine use in the Union in connection with the goods or services in respect of which it is registered, or if such use has been*

⁹⁰ Genuine use and its requirements: study of recent EU case law. Vinge - Richard Wessman, Sofia Ljungblad and Yelyzaveta Semenovykh <https://www.lexology.com/library/detail.aspx?g=52664b36-a3be-45bb-9374-7b88af54ce61>

suspended during an uninterrupted period of five years, the EU trademark shall be subject to the sanctions provided for in this Regulation, unless there are proper reasons for non-use”.

Article 42 EUTMR requires proof of genuine use of the earlier mark. Genuine use of a trademark cannot be proved by means of probabilities or suppositions but must be demonstrated by solid and objective evidence of effective and sufficient use of the trademark on the market concerned.

The notion of “genuine use” and its criteria

After the grace period of five years following the registration of the trademark, the trademark holder may be required to demonstrate the use of the trademark for the goods and services covered by the registration. Upon request from the trademark applicant in opposition proceedings or the intervener in invalidation proceedings, the owner of the (earlier) trademark is obliged to prove genuine use or the existence of proper reasons for non-use, failing which the opposition or the application for a declaration of invalidity is to be rejected. Consequently, genuine use constitutes public use of the trademark in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered in order to create or preserve an outlet for those goods or services.

The assessment of whether the use of the trademark is genuine cannot be limited by establishing that the trademark has been used in the course of trade; instead, such use should be associated with goods and services which are placed on the market.

As regards the criteria for assessing whether the use of the trademark is genuine, all the facts and circumstances relevant to establishing whether the commercial use of the trademark is real should be determined, particularly the practices regarded as warranted in the relevant economic sector as means of maintaining or creating market shares for the goods or services protected by the trademark, the nature of those goods or services, the characteristics of the market as well as the extent and frequency of the use of the trademark. The specified factors are interdependent, which means that the low volume of goods under the trademark may be offset, for instance, by peculiarities of the relevant goods and services and/or frequency of trademark use and vice versa.

The extent of genuine use: does quantity mean everything?

It is a general rule that the volume of sales of the goods and services marketed under the trademark must be analyzed together with other relevant factors, such as the volume of business, economic sector, marketing capacity and characteristics of goods and services on the relevant market. Therefore, genuine use of the trademark does not require it to be significant in quantitative terms: even minimal use can suffice if it is regarded as warranted in the relevant economic sector.

In the recent *Polfarmex SA v EUIPO* case, the EU trademark SYRENA was registered for, *inter alia*, goods in Class 12 (motor vehicles for locomotion by land and parts therefor). In the cancellation proceedings, the European General Court tried to draw a border line in the assessment of

genuine use of the SYRENA trademark in relation to racing cars and electric cars comprising Class 12. According to the General Court, such a category as racing cars had certain technical specifications, which made racing cars less suitable for normal, everyday road use and more expensive in comparison to most private use cars. Therefore, racing cars were often characterized by relatively low demand, production to an individual specific order, and sale of a limited number of vehicles. The General Court concluded that, given the specifics of the economic sector, the provision of accounting documents presenting sales figures and invoices was not mandatory for the purposes of establishing genuine use.

The existence of various preparatory tasks and advertising efforts were recognized to be sufficient to prove genuine use of the trademark in relation to racing cars, even though no cars had been sold. In contrast, electric cars were not intended for a market as specific as racing cars and thus the criteria relating to the racing cars could not apply to electric cars. Therefore, the General Court found that the evidence adduced was not sufficient to confirm the use of the SYRENA trademark for electric cars. Consequently, it is impossible to determine in the abstract, without taking into consideration all the relevant facts of the case, what quantitative threshold should be established to determine whether the trademark has been put to genuine use. Notwithstanding that even minimal use of the trademark could be sufficient to establish genuine use, what exactly constitutes the “minimal use” depends on the specific circumstances of the case.

The nature of goods and services: is it necessary to prove genuine use for every product or service covered by the trademark?

It is an established rule that when a trademark has been registered for goods and services for which it is not possible to make clear subdivision within the relevant class, the evidence of genuine use for those goods and services covers the whole class.

The purpose and/or intended use of the goods or service are of fundamental importance to determine whether the goods or services form a coherent subcategory that can be viewed independently.

In the *Polfarmex SA v EUIPO* case, the applicant raised the question of whether the evidence confirming the use of the SYRENA trademark for racing cars was sufficient to prove genuine use in relation to a broad category of “cars”. The General Court held that the purpose and use of racing cars (the goods in relation to which genuine use was established) was different from the purpose and use applicable to vehicles intended to carry a driver and passengers. Those cars were not suitable to be driven on public roads - such use was even prohibited, given the specific characteristics of racing cars. Therefore, the purpose of the use was clearly different from that of other cars. The General Court concluded that the fact that genuine use of the trademark was established in relation to racing cars only which, due to their difference in purpose, formed an independent subcategory within Class 12, was not sufficient to show the use in respect of the whole category of “cars”.

According to EU trademark law, proof of genuine use of the trademark also includes proof of its use in a form differing in elements which do not alter the distinctive character of that trademark.

Evidence sufficient to prove genuine use

Establishing genuine use leads to a determination as to whether the trademark can be deemed to be registered in respect of the goods or services in question. Genuine use means “actual” use of the trademark: the principles accorded to this definition were provided for in the famous the ‘Minimax’ 2003⁹¹. Genuine use cannot be demonstrated by means of probabilities or suppositions. It should be proved by solid and objective evidence supporting the effective and sufficient use of the trademark on the market. Moreover, *inter alia*, genuine use,

- (i) must be consistent with the essential function of a trademark, which is to guarantee the identity of the origin of goods or services to the consumer or end user by enabling the latter, without any possibility of confusion, to distinguish the product or service from others that have another origin⁹², and
- (ii) must relate to goods or services already marketed or about to be marketed and for which preparations by the undertaking to secure customers are under way, particularly in the form of advertising campaigns⁹³

According to the settled case law, grouping items of evidence may allow the necessary facts to be established, even if each of those items, individually, would be insufficient to prove the accuracy of those facts. According to the case law, printouts from websites on which the goods have been offered for sale under the trademark, the brochures and advertising materials, pages from social media, financial documentation are equally relevant to establish genuine use of the trademark. It is also worth noting that although the presence of the trademark on the website can demonstrate the nature of its use and/or the fact that products or services bearing the trademark have been offered to the public, such evidence is not sufficient to prove genuine use unless the website shows the place, time and extent of use.

However, the value of the internet extracts as potential evidence can be strengthened by “presenting that the specific website has been visited and, in particular, that orders for the relevant goods and services have been made through the website” by a certain number of customers in the relevant period and in the relevant territory. As regards affidavits which are commonly used to demonstrate genuine use of the trademark, such evidence cannot constitute sufficient proof of the use if the affidavit has been produced by the interested parties themselves or any person who has close links with them since the perceptions of a party involved in a dispute may be more or less affected by its personal interest in the matter.

The proof of genuine use must be furnished by the holder of the trademark in accordance with the established procedural time limits. In this regard, the case law confers a certain amount of flexibility to the trademark holder to guarantee the balance between the observance of

⁹¹ judgment of 11/03/2003, C-40/01, Minimax, EU:C:2003:145.

⁹² Minimax Case, par. 36.

⁹³ Minimax Case, par. 36.

procedural time limits and principles of justice. Therefore, the documents from only just outside the five-year timeframe, if they are relevant for the assessment, can be considered and evaluated together with the rest of evidence, since they may offer proof of real and genuine commercial exploitation of the trademark.

Such an approach enables the scope of the use of the registered trademark and actual intentions of the holder during the latter period to be borne out and assessed more accurately.

Italian point of view: according to article 24 of the Intellectual Property Code, “*Under penalty of forfeiture, the trademark must be effectively used by the owner or with his consent, for products or services for which it was registered, within five years of registration, and such use it must not be suspended for an uninterrupted period of five years, except that he non-use is not justified by a legitimate reason*”. Who can propose this legal action? This legal action is up to all the economic operators in the sector to which the trademark refers or who are close to entering it, constituting the expired trademark an obstacle, even potential, to the exercise of their business⁹⁴.

** Some “honey” from a bee:*

The question of what constitutes genuine use of the trademark is frequently posed at both national and EU level. A significant number of uncertainties arise in relation to the scope and extent of such use, its nature, and the effective evidence to be demonstrated. The legislative provisions governing genuine use require trademark holders to ensure whether their current trademark registrations meet the criteria of such use.

The importance of the relevant evidence of the trademark use cannot be overemphasized. Therefore, it is recommended that trademark holders exercise diligence when collecting materials and documents supporting genuine use.

The evidence should provide a sufficient indication as to the factors of time, place, extent and nature of use and point to the real commercial presence of the trademark on the market for the relevant goods and services. Such factors must be assessed with due regard to the economic sector in which the trademark holder operates, category of goods and services that the trademark is registered for, and distinctive elements of the trademark. By doing so, trademark holders would be able to withstand legal challenges of a request to demonstrate genuine use of the trademark.

Arbitration

Is arbitration always an appropriate way to solve disputes related to IP rights – and, specifically, to trademarks? The answer is not that simple.

⁹⁴ Tribunale di Milano, 4007/2019, 19th Aprile 2019.

Disputes concerning IP issues are generally allowed to be submitted to arbitration in most jurisdictions (although with different limits and procedures). Therefore, parties, when drafting an arbitration clause referred to IP disputes, should be careful in ensuring:

- that IP rights can be subject to arbitration according to the governing law of the contract
- that also the law of the Country where the parties would eventually seek the enforceability of the arbitral awards allows IP disputes to be submitted to the knowledge of arbitration (otherwise, the arbitral award could conflict with the internal public order, and the arbitral award could be refused recognition and enforcement).

To give an example of a few countries:

- UK - disputes concerning trademarks and IP rights can be fully submitted to the jurisdiction of arbitrators
- United States – according to the federal law applicable in the U.S., parties are allowed to submit disputes concerning patents and trademarks
- Singapore – every dispute concerning IP rights may be subject to arbitration
- Switzerland – every dispute concerning IP rights may be subject to arbitration Three tendencies.

According to the WIPO statistics, 21% of the disputes that are brought before WIPO concern trademarks: disputes on trademarks generally regard brand assignments, licenses, franchising and distribution agreements. Trademark infringements are excluded since these disputes generally arise between third parties, that of course have not drafted an arbitral agreement.

Criminal Law

The Italian approach: art. 473 Italian Criminal Code – *“Counterfeiting, alteration or use of trademarks or distinctive signs or patents or models and designs”*: *“Anyone who, being able to know of the existence of the industrial property title, counterfeits or alters trademarks or distinctive signs, national or foreign, of industrial products, or anyone, without being concurrence in counterfeiting or alteration, makes use of such counterfeit or altered trademarks or signs, is punished with imprisonment from six months to three years and with a fine from € 2,500 to € 25,000.*

Subject to imprisonment from one to four years and a fine of € 3,500 to € 35,000 anyone who counterfeits or alters patents, industrial designs or models, national or foreign, or, without being involved in counterfeiting or alteration, makes use of such patents, counterfeit or altered designs or models.

*The offences provided for in the first and second paragraphs are punishable provided that the rules of national laws, EU regulations and international conventions on the protection of intellectual or industrial property have been complied with”.*⁹⁵

⁹⁵ Art. 473 Italian Criminal Code *“Contraffazione, alterazione o uso di marchi o segni distintivi ovvero di brevetti, modelli e disegni - Chiunque, potendo conoscere dell'esistenza del titolo di proprietà industriale, contraffà o altera marchi o segni distintivi, nazionali o esteri, di prodotti industriali, ovvero chiunque, senza essere concorso nella*

This provision is aimed at protecting the public faith, to be deemed as the citizens' reliance in the trademarks and in the distinctive signs that identifies intellectual works or industrial products, and not the reliance of only one citizen; therefore, in order for such crime to be carried out, it is not needed to realize a situation in which a specific customer is deceived about the genuineness of a product (Cassazione Penale, 27th January 2016, n. 18289).

It is worth interesting to note that, according to some decisions, this provision also applied to NON-REGISTERED trademarks.

Of course, criminal law aims at protecting public interest; therefore, the offended party may seek monetary relief becoming a civil party in the criminal proceeding and introducing a civil dispute.

However, counterfeiting has also a direct economic impact on companies since infringements of intellectual property rights reduce the revenues of the affected businesses. According to Europol, the impact of counterfeiting is particularly high in the European Union, where counterfeit and pirated products make up to 5 % of imports, or as much as EUR 85 billion.

contraffazione o alterazione, fa uso di tali marchi o segni contraffatti o alterati, è punito con la reclusione da sei mesi a tre anni e con la multa da euro 2.500 a euro 25.000.

Soggiace alla pena della reclusione da uno a quattro anni e della multa da euro 3.500 a euro 35.000 chiunque contraffà o altera brevetti, disegni o modelli industriali, nazionali o esteri, ovvero, senza essere concorso nella contraffazione o alterazione, fa uso di tali brevetti, disegni o modelli contraffatti o alterati.

I delitti previsti dai commi primo e secondo sono punibili a condizione che siano state osservate le norme delle leggi interne, dei regolamenti comunitari e delle convenzioni internazionali sulla tutela della proprietà intellettuale o industriale”.

TRADEMARKS REGISTRATION

ITALIAN PROCEDURE⁹⁶

A trademark application may be filled by anyone: natural persons, legal persons, associations, organizations, etc., including minors, even foreigners, provided they are domiciled in one of the EU countries. More than one person can be the owner of a trademark.

The application may be submitted in the following ways:

- i) Telematic mode (with the possibility to use a fast-track)⁹⁷
- ii) On paper at the Chamber of Commerce (CCIAA)
- iii) Postal mode.

The filing procedure is completed upon payment of the registration fee; the date of the payment will be considered as the filling date.

The trademark can be registered in one or more classes of the Nice Classification; the costs of the registration vary depending on the number of classes indicated. Protection is limited to the classes applied for and it is not possible to extend protection after the application is filed.

The filing of an Italian trademark application is only valid on the Italian territory.

Applications are assigned for examination in chronological order of filing and include a check for admissibility and an examination of the merits. The admissibility check serves to ascertain that the application has been completed in its essential elements and that the fees have been paid.

The substantive examination verifies:

- that the trademark meets the legal requirements
- that the goods and services for which protection is sought are correctly indicated and belong to the class applied for.

If there are any criticalities, the office sends official communications to applicant, giving time to reply. If there is no reply, or if the reply does not resolve the criticality, the office rejects the application.

Registrable applications are published, and any person entitled may oppose the registration by filing an Opposition Procedure within three months of publication. Applications that are not opposed are registered.

⁹⁶ Information about the Italian application and procedure is taken from the UIBM official website <https://uibm.mise.gov.it/index.php/it/marchi>

⁹⁷ The Fast Track procedure allows to reduce the time required for examination on the merits as it is not necessary to check the correspondence between the class number and the goods and services indicated, which is done automatically by the system when the application is filed.

The trademark is valid for 10 years and can be renewed indefinitely every 10 years. The renewal of a trademark must be made before the expiry of the 10th year, which is the last day of the month of filing.

The registration can also be renewed with a delay of up to 6 months by paying late fees. After this date, the trademark is no longer renewable, and a new application must be filed.

The trademark must be identical to the trademark being renewed. In the renewing procedure no changes can be made; the trademark must be identical to the one originally registered. The only possible modification when renewing is the reduction of classes.

EU PROCEDURE⁹⁸

EU trademark applications can only be filed at the EUIPO (European Union Intellectual Property Office). Filing is possible on-line (e-filing, in the EUIPO website) or by post or special courier service:

- e-filing — online applications via User Area
- by post
- by special courier service.

The EU trademark application can be filed in any of the languages of the European Union as the ‘first language’; in addition, a second language must be selected from the following five Office languages: English, French, German, Italian or Spanish.

The application must contain a list of goods and services as which must be classified in accordance with the already mentioned Nice Agreement. The basic application fee covers only one class; more classes of goods or services may be added paying an additional fee.

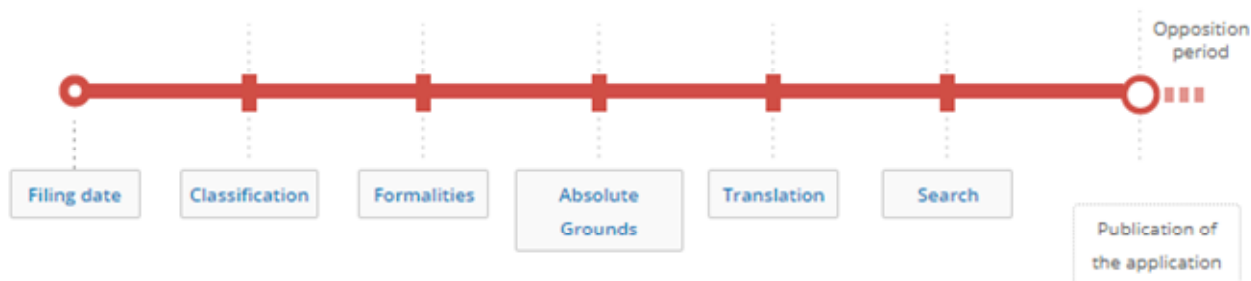
The procedure for the registration of an EUTM is composed of three main parts:

1. examination of the application
2. opposition (only if the application for EU trademark has been subject to an opposition)
3. registration.

A EUTM is valid for 10 years. It can be renewed indefinitely, for 10 years at a time.

Here is a scheme of the registration procedure and a brief explanation of the different steps:

⁹⁸Information about the EU application and procedure is taken from the EUIPO official website
<https://euipo.europa.eu/ohimportal/en/application-procedure>;
<https://euipo.europa.eu/ohimportal/en/registration-process>.



Filing date: the office check that the application contains the mandatory information required: a request for application, a correctly identified owner, a clear representation of the mark and a list of goods and services.⁹⁹

Classification: the goods and services are reviewed to check if they have been correctly classified; if the Harmonised Database for classification has been used, the list of goods and/or services will be accepted automatically.

Formalities: all the details of the application are reviewed (signature, languages, owner and/or representative data, priority and/or seniority claims...). If an error is detected, the office will send an official communication and the applicant has two months to remedy and reply. It is possible to ask for an extension of time to prepare the response.

Absolute Grounds: The trademark is analysed to see whether it is distinctive but not descriptive.

Translation: The trademark application is translated so that details of it can be published in all the official languages of the European Union.

Search: If it has been requested in the application, the office will carry out a search in the EU trademark database for identical and/or similar marks. The results are sent to the applicant before the publication of the trademark application. Owners of previously registered trademarks or trademark applications quoted in the report are informed — by letter — about the trademark application. This is called a *'surveillance letter'*. The results of both search reports and surveillance letters are only for information.

Publication of the application: the application procedure ends with the publication of the application

Opposition: Third parties may oppose the registration within three months from the publication date. There are usually two motives for objecting:

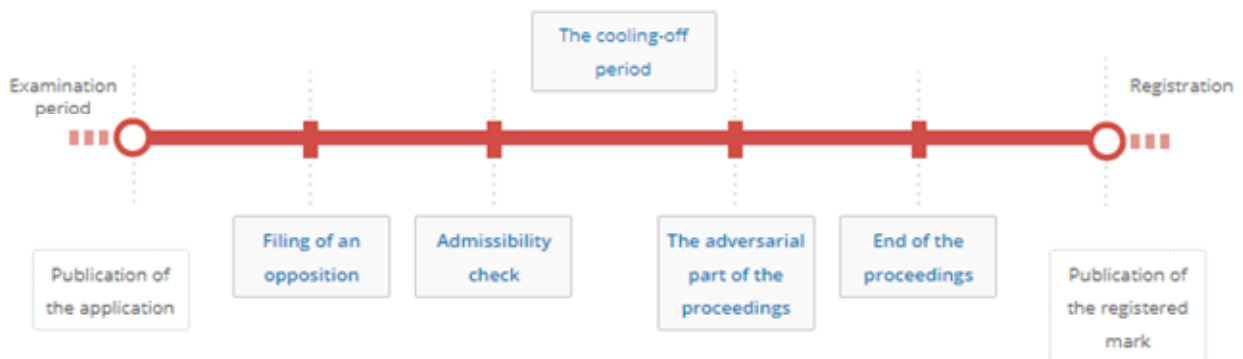
- i) earlier right, when the third party has an earlier right (or more than one) and believes that the new trademark will, if registered, conflict with it

⁹⁹ Payment of the basic fee must also be made within one month of the filing date.

- ii) absolute ground, when the third party believes that the trademark does not meet some requirements it should have had.

If nobody files an opposition or third-party observations, the trademark is registered, and the registration is published. The publication of the registration is free of charge and a certificate of registration is issued.

The opposition procedure is structured as follows:



Filing of an opposition, through the appropriate online form.

Admissibility check: it is checked if the Notice of Opposition meets the formal requirements

The 'cooling-off' period: if the notice of opposition is accepted, the office sends a notification to both parties setting time limits for the proceedings. The proceedings start with a two months period during which parties can negotiate an agreement (so-called 'cooling-off' period). During this period the parties are given the option to terminate the proceedings. The cooling-off can be extended for 22 months (for a total of 24 months maximum). Each party can opt-out of the extension at any time. Once the cooling-off period has expired, the adversarial part of the proceedings begins.

The adversarial part of the proceedings: the parties involved are invited to send additional information and evidence to support their positions: first, the opponent is given two months to complete their file, including any information that they consider necessary to support the opposition. Then the applicant has two months to reply. Finally, the opponent is given the opportunity to comment on the observations submitted by the applicant. These are the three stages of the process, but EUIPO may agree to or request further 'rounds'.

End of the proceedings: when EUIPO informs the parties that no more observations will be allowed the proceedings comes to an end. The file is ready for the Opposition Division to take a decision.

When EUIPO issue a decision there are various **possible outcomes**:

- The EU trademark application does not conflict with the earlier right(s); the opponent then pays costs to the other party (EUR 320) and the application proceeds to registration.
- The EU trademark application conflicts with the earlier right(s); the application then fails, and the EU trademark applicant pays the opposition costs to the other party (EUR 650).
- The EU trademark application partially conflicts with the earlier right(s); the goods or services in conflict are then removed from the list and the application proceeds to registration (costs are generally shared between the two parties).

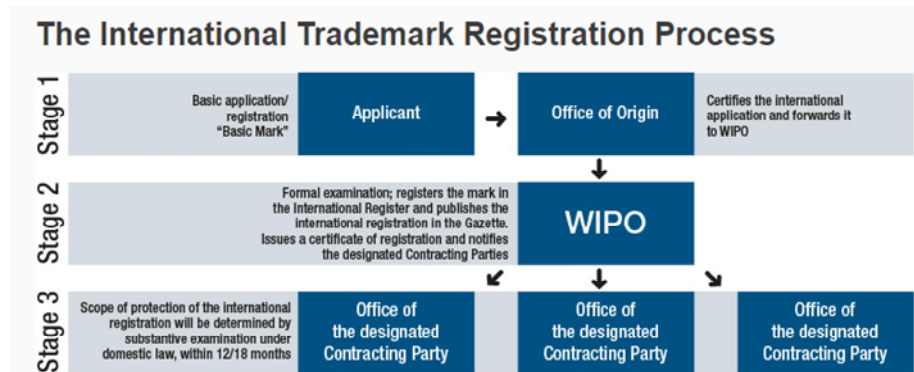
INTERNATIONAL PROCEDURE¹⁰⁰

There is no trademark with international validity, worldwide, but it is possible to proceed with an international extension of the national mark through the WIPO. Both the Italian trademark and the EU trademark can be extended.

The extension procedure is done through the office where the first filing was made. For instance, if someone wants to extend a trademark filed in Italy, the extension request must be filed with the Chamber of Commerce. If one wants to extend an EU trademark, it is necessary to apply through the EUIPO.

The extension can be made at any time. If the extension is made within 6 months of the national filing, the date of the international mark coincides with that of the national filing.

Here is a graphic and brief description of how the Madrid System works taken from the WIPO website:



Stage 1 – Application through your National or Regional IP Office (Office of origin)

¹⁰⁰ Information about the international application and procedure is taken from the WIPO official website <https://www.wipo.int/trademarks/en/>

After having filled an application (or registered a trademark) in his “home” IP office, the applicant submits the international application through this same IP Office, which will certify and forward it to WIPO.

Stage 2 – Formal examination by WIPO

WIPO only conducts a formal examination of the international application. Once approved, the mark is recorded in the International Register, published in the WIPO Gazette of International Marks. and notified to all the IP Offices where the applicant asked to have the mark protected.

Stage 3 – Substantive examination by National or Regional IP Offices

The IP Offices of the territories where the applicant wants to protect the mark will analyse the application and take a decision in accordance with their legislation. WIPO will record the decisions of the IP Offices and then notify the applicant.

THE DIFFERENT CHOICE BETWEEN DE FACTO TRADEMARK AND DE JURE TRADEMARK

In the Italian legal system, a certain protection of unregistered trademarks can be inferred indirectly from the combination of article 2571 of the Italian Civil Code and article 12(1) of the Industrial Property Code. In particular, the two funding elements of protection of unregistered marks are effective use and reputation¹⁰¹.

Indeed, Article 2571 of Italian Civil Code establishes that *“A person who has used an unregistered trademark may continue to use it, notwithstanding the registration obtained by others, to the extent to which he has previously used it”*. Article 12 IPC maintains that: *“Signs may not be registered as a trademark if at the date of filing of the application: are identical or similar to a sign which is already known as a trademark or a sign which is distinctive for goods or services manufactured, marketed or provided by others for identical or similar goods or services, if because of the identity or similarity of the signs and the identity or similarity of the goods or services there exists a likelihood of confusion on the part of the public, which may also consist in a likelihood of association between the two signs. [...]. The previous use of the sign, when it does not imply renown, or implies purely local renown, does not take away the novelty, but the third party pre-user has the right to continue using the mark, even for advertising purposes, within the limits of local diffusion, notwithstanding the registration of the mark itself. Previous use of the sign by the applicant or its predecessor is not an obstacle to registration;”*

It should also be noted that unregistered trademarks benefit from different level of protection depending on their level of reputation (local or general reputation). The local pre-use gives the unregistered trademark owner only the possibility to continue using its trademark for the same kind of product or service and within the same geographical area, that is to say in the framework

¹⁰¹ Barzanò&Zanardo, Unregistered trademarks, available at <https://www.barzano-zanardo.com/en/approfondimenti/unregistered-trademarks/>

of the use already made, without possibly forbidding the subject filing the same trademark afterwards to use it in the local territory as well. Therefore, in this case the coexistence – only locally – of the pre-used trademark with the newly registered one is allowed¹⁰².

As concerns the European legislation, it does not provide uniform provisions concerning unregistered marks, but it recognizes the existence of such rights in the Member States and grants the proprietors of non-registered marks the possibility of preventing the registration of an EUTM application where they would succeed in preventing use of that EUTM application under the relevant national law (see art. 8(4) EUTMR)¹⁰³.

Some “honey” from a bee:

Who: Twitter

When: 2009

What trademark it wanted to register: "Tweet"

Status: Denied by the United States Patent and Trademark Office.

The micro-blogging service may be worth billions, but it still can't claim ownership over the word “tweet”.

The trademarks office rejected Twitter's application because of an earlier claim by a third-party developer. Twittad, a Twitter-based advertising service, trademarked the phrase “Let Your Ad Meet Tweets” in 2008.

Luckily for Twitter, during the court case of the trademark infringement, the judge agreed with the arguments that “tweet” was a word that Twitter had made famous before Twittad registered the trademark.

The parties reached an agreement.

¹⁰²Barzanò&Zanardo PCT System and Patent Protection abroad, <https://www.barzano-zanardo.com/en/appfondimenti/pct-system-and-patent-protection-abroad/>

¹⁰³ Guidelines for examination in the European union intellectual property office on European union trademarks, Part c opposition section 4 rights under articles 8(4) and 8(4a) EUTMR, paragraph 3.2.2, available at https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/trade_marks/Draft_Guidelines_Legal_Reform/Part-C/04-part_c_opposition_section_4_rights_under_article_8_4_eutmr/part_c_opposition_section_4_rights_under_article_8_4_eutmr_en.pdf

LEGAL STRATEGY AND PROTECTION

WHY SHOULD THE TRADEMARK BE PROTECTED?

According to www.eu-startups.com “*Ten reasons to register your trademark*”, the protection of your trademark is significant. It would enhance your freedom to operate and would let you save money, since the registered trademark establishes the legal ownership of your brand and informs everyone about your rights limiting in a certain way that someone put himself in a position to infringe your rights being in good faith. According to the same source, you are supposed to conclude better partnerships. In many countries, particularly in many Asian countries, local partners require that your trademark is protected. Also registered trademarks increase the value of your brand. According to ISO standard (10668:2010), registered trademarks are one of three components attributing value to your brand.

With a protected trademark you would be able to attract more investors that value companies higher that have protected its intellectual property since such approach in particular decreases the operational risks.

It is important to highlight that the ® symbol increases consumer trust and the company trademark registration means also serious business.¹⁰⁴

HOW CAN THE TRADEMARK BE SUSTAINABLY PROTECTED?

Like any other intellectual property rights, each country has the natural authority to establish its own rules for obtention of the protection and for consideration of the trademark rights.

Even if we often refer to the concept “*international trademark rights*” which supposes the existence of common rules across various jurisdictions, the existence and enforceability of those rights are exclusive to each jurisdiction without being sometimes even reliant.

Should your company pursuing the goal to sustainably protect trademark, then you should first identify in which countries you are offering your products and services and, in addition, where you intend to develop the business in the future. We can also advise to consider the countries where your goods might be counterfeited.

Please not that several international agreements make possible to file a single application to register a mark in more than one jurisdiction. For example, a registration with the Benelux Office for Intellectual Property offers trademark protection in the Benelux territory (Belgium, Luxembourg, and the Netherlands) as it is published by International Trademark Association on their website. A European Union Trademark (EUTM) (formerly Community Trademark) registration protects a trademark in all the member states of the European Union (EU). The Madrid Agreement and the Madrid Protocol make it possible to file an application for an

¹⁰⁴ www.eu-startups.com “*Ten reasons to register your trademark*”.

International Registration, which will provide trademark protection in any of the jurisdictions the applicant designates that are party to either or both of those treaties. Filing with the African Regional Intellectual Property Organization or the African Intellectual Property Organization protects a trademark in all the member states of that organization. If you register the trademark in Italy, your trademark will be protected in San Marino as well and *vice versa*.¹⁰⁵

Entering into more detailed analysis of a European Union Trademark, as provided by the same International Trademark Association on their internet site¹⁰⁶ the EUTM system offers trademark owners a unified system of protection throughout the EU with the filing of a single application. They state that this one application results in an EUTM registration, which is recognized in all the EU member states.

The European Union trademark system is designed to complement the different national trademark systems of the Member States as well as the international system. A European Union trademark could serve as the basis for an international trademark.

The registration of EUTM presents several advantages in particular: it is fast and cost optimizing, efficient in terms of administrative management insofar as it would be necessary to manage only one registration. Furthermore, genuine use in an EU Member State may be sufficient to protect an EUTM in all Member States against cancellation for non-use.

There is, however, a risk that if a ground for rejection exists in only one of the Member States, the trademark may not be registered as an EUTM, although conversion into national applications is possible in some cases.

Also note that the same sign can be protected for the same goods and services both by a European Union trademark as well as by one or more national trademarks in different EU member states, the owner of one or several national trademarks may wish to obtain a European Union trademark for the same sign.¹⁰⁷

Following the end of the Brexit transition period on December 31st, 2020, effective January 1st, 2021, the UK Intellectual Property Office (UKIPO) will automatically and free of charge convert the UK portion of a registered EUTM into a separate and independent UK trademark registration with the same filing date as the EUTM. For EUTM applications that are still pending as of January 1st, 2021, the trademark applicant will have nine months from December 31st, 2020, to file a new

¹⁰⁵Ratification of 23 December 2014 of the exchange of notes between Italy and the Republic of San Marino regarding the interpretation of art. 43 of the 1939 Friendship and Good Neighborhood Convention on trademarks and patents.

¹⁰⁶<https://www.inta.org/fact-sheets/international-trademark-rights/>.

¹⁰⁷<https://www.inta.org/fact-sheets/international-trademark-rights/>.

and separate UK trademark application that will take the same filing date as the EUTM. The EUTM will no longer extend trademark protection to the UK after December 31st, 2020.

Also, an important instrument for protection of your trademark rights is the Paris Convention, an international treaty for protection of intellectual property, adopted by 177 countries which constitute the Paris Union. The main principle of the Convention is that nationals of any country of the Union are afforded the same advantages with respect to intellectual property protection and enforcement that the national law of any country of the Union grants its citizens. The right of priority under the Paris Convention provides that, on the basis of a trademark application filed in one of the countries in the Paris Union, the applicant may, within six months of that filing, apply for protection in any of the other countries in the Union. These subsequent applications will be regarded as if they had been filed on the same day as the first application; that is, they have priority over applications for the same mark filed by others during that six-month period.¹⁰⁸

An important concern for a company is to understand whether different parties in different countries may own the same trademark.

Considering that the trademark rights have generally geographic dimension, it is quite conceivable for a trademark to be registered in different countries by different owners. Therefore, in order to be able to efficiently protect their trademark, it is strongly recommended that trademark owners obtain protection for their trademarks in all jurisdictions or regions of interest in order to sustainably guarantee their trademark rights and prevent others to get them.

Filing an international registration application may also have advantages over filing individual national applications if an applicant wishes to protect its mark in more than one jurisdiction. This registration is possible through a single uniform application filed through a unified filing system directed by the International Bureau of WIPO.¹⁰⁹ The latter checks the formal requirements, including the correctness of the specification of the goods and services and the payment of the relevant fees, and transfers the international registration to the requested jurisdictions.

The IP office of each requested country has between twelve and eighteen months to decide whether the protection under the international registration is approved notifying the applicant accordingly. Check periods thus determined in advance make the whole process of applications foreseeable and, in some cases, briefer than examination by national trademark offices.

International registration may subsequently be extended to the countries not initially selected and can also be renewed in all chosen countries with a one electronic filing. Still the filing of an international registration can have significant disadvantages, such as the reliance of the

¹⁰⁸<https://www.inta.org/fact-sheets/international-trademark-rights/>.

¹⁰⁹<https://www.inta.org/fact-sheets/international-trademark-rights/>.

international registration on the status of the basic national application or the registration for a limited period, which should be cautiously evaluated by the brand owners.

Once the registration of the EU trademark is completed, any third party can request its revocation or invalidity with EUIPO Invalidity Division of, or in the context of an infringement claim brought before the courts.

The revocation may be pronounced if the owner of the mark fails to demonstrate its effective use within five years of its registration by providing evidence such as packaging, labels, price lists, catalogs, invoices, photographs, advertisements in newspapers. and written statements. That said, the revocation will be pronounced only for the products or services for which it is not used, and it will be maintained for the outstanding products and services. The same would apply to the trademark if it becomes a common name in the trade of a product or a service for which it has been registered, or it is likely to mislead the public in particular on the nature, the quality or geographical origin of these products or services. As to the invalidity claim, it may be based on one of the absolute grounds for refusal such as the lack of distinctive character for example.

Some “honey” from a bee:

With its decision of 16 June 2019 ([Case T-307/17](#)), the EU General Court ruled on the appeal filed by Adidas AG (“Adidas”) against the decision of the Second Board of Appeal of EUIPO, relating to invalidity proceedings between Shoe Branding Europe BVBA (“SBE”) and Adidas.

In December 2013, the well-known sportswear manufacturer filed an application with EUIPO and obtained the registration of the EU trademark here below for clothing, footwear and headgear.



“The mark consists of three parallel equidistant stripes of identical width, applied on the product in any direction”

In December 2014, SBE filed an application for declaration of invalidity of the mark at issue based on lack of distinctive character, which was granted by EUIPO. Against this decision, Adidas filed an appeal, claiming that the mark had acquired distinctive character through use. In 2017, EUIPO dismissed the appeal and declared the mark invalid, on the grounds that the applicant had failed to establish that the mark had acquired distinctive character through its use throughout the European Union.

Adidas filed an appeal before the EU General Court against the EUIPO decision, claiming that EUIPO had wrongly dismissed numerous items of evidence and had made a wrong assessment in holding that the acquisition of distinctive character had not been established.

The General Court pointed out that the requirement of graphic representation, together with the description of the mark, is intended to define the mark itself, and it is for the trademark applicant to file a graphic representation of the mark corresponding precisely to the subject matter of the protection he wishes to secure. Once a trademark is registered, the proprietor is not entitled to a broader protection than that afforded by the graphic representation.

In the case at issue, the General Court rejected the applicant's claim that the object of the protection conferred by the mark consisted of the use of three parallel equidistant stripes, irrespective of their length or the way in which they are cut (an argument instrumental to the plea that EUIPO had wrongly dismissed numerous items of evidence). In the General Court's opinion, this argument was not supported by any concrete evidence: not by the graphic representation of the mark at issue, which shows a sign characterized by a ratio of around 5 to 1 between the total height and width and its rectangular shape, the three stripes being cut at a right angle; nor by the description of the mark, which does not refer to stripes of variable length or stripes cut at a slanted angle.

With regard to the documents submitted by the applicant as alleged evidence of the use of the mark (in particular, images from catalogues or other promotional material), the General Court confirmed that the concept of the "use of a trademark", within the meaning of Article 7(3) and Article 52(2) of Regulation no. 207/2009, must be interpreted as "referring not only to use of the mark in the form in which it was submitted for registration and, where relevant, registered, but also to the use of the trademark in forms which differ from that form solely by insignificant variations and that are able, therefore, to be regarded as broadly equivalent to that form". At the same time, upholding the observations of EUIPO, the Court pointed out that, given the extremely simple character of the mark at issue, even minor alterations may affect one of its essential characteristics and the perception of it by the relevant public.

In particular, the General Court observed that the mark at issue is a figurative mark containing no word elements and presenting very few characteristics, except the use of three black stripes against a white background. Therefore, the General Court stated that "the act of reversing the colour scheme, even if a sharp contrast between the three stripes and the background is preserved, cannot be described as an insignificant variation as compared to the registered form of the mark at issue".

In the General Court's opinion, the proof of use submitted by Adidas, consisting of images bearing a sign that consists of three parallel stripes in a light colour, thick, short and cut at a slanted angle, must be rejected. With regard to the images as a whole, the General Court stated that, although some of the images correspond to the mark at issue and are thus capable of proving use of that mark, they don't provide any indication regarding the scale and duration of that use or the impact

of that use on the perception of the mark by the relevant public. Consequently, the General Court continued, those images “do not show that the use was sufficient in order for a significant proportion of the relevant public to identify, based on the mark at issue, a product as originating from a particular undertaking”.

Finally, regarding the affidavit produced by the applicant containing figures concerning the turnover of the undertaking, the amount of marketing and advertising costs incurred, as well as information regarding the market shares of the “Adidas brand” in some Member States and the sponsorship activities in connection with sporting events and competitions, the General Court observed that the figures concern the entire business of the undertaking, all of the goods and all of the marks taken together, and therefore do not establish that the specific mark at issue has been used and has acquired distinctive character following that use.

Based on the above, the General Court concluded that the various items of evidence produced by the applicant, even taken as a whole, did not prove the use of the mark throughout the territory of the European Union and were not sufficient, in any event, to demonstrate that by virtue of that use the mark has come, in the whole of that territory, to identify the goods for which it was registered and thus to distinguish those goods from those of other undertakings.

The General Court, therefore, dismissed the appeal and ordered Adidas to pay the costs¹¹⁰.

REVOCAZIONE IN ITALIANO

In Italiano, ci sono tre casi di revocazione:

- 1) vulgarizzazione, quando un marchio perde la sua capacità distintiva e diventa un nome generico (vedi “Vulgarizzazione” sopra)
- 2) illegittimità successiva (se fosse illegittimo dal momento della registrazione, il marchio sarebbe invalido)
- 3) non-uso per 5 anni consecutivi. Deve essere specificato che l'uso deve essere effettivo: pertanto, un uso meramente simbolico o sporadico o l'uso per quantità insignificanti di prodotti è una perdita; inoltre, l'uso del marchio deve conformarsi alla registrazione (i.e. per la classe rilevante di beni) poiché un uso diverso darebbe origine a un marchio di fatto, ma causerebbe la morte del marchio registrato¹¹¹. La revocazione non si applica se il non-uso è dovuto a una legittima ragione. La legittima ragione può dipendere dalla volontà del titolare del marchio o no; per

¹¹⁰ [https://martinimanna.com/the-eu-general-court-confirms-the-invalidity-of-the-adidas-eu-three-](https://martinimanna.com/the-eu-general-court-confirms-the-invalidity-of-the-adidas-eu-three-strippedtrademark/)

[strippedtrademark/](#) by Gaia Gusmini

¹¹¹ <https://uibm.mise.gov.it/index.php/it/marchi/esame-della-domanda-e-procedura-di-opposizione/modifica-del-marchio/estinzione>

example, it has been suggested that the COVID-19 outbreak may be considered a legitimate reason for non-use of the trademark¹¹².

Now that your trademark is registered and you are the brand-new brand owner, you should organize an effective and sustainable protection of your brand from abusive use by monitoring the market and defending your rights where appropriate. Even if it is certainly easier to outsource such service, you can also proceed on your own by scanning potential counterfeiters through online research on your regular search engines. Pay attention to anything that looks unreasonably similar your brand and may be confusing. You can also include other spellings for your brand for a broader check.

Some "honey" from a bee:

SET UP A GOOGLE ALERT FOR YOUR TRADEMARK

Create a search alert for your brand, which will make it easier to monitor. It is in fact accessible to generate your alert on Google Alerts. After you arranged it, you will start receiving email notification reports in accordance with the chosen frequency whenever a new search result uses your brand.

Review all sources and media for publications including the official trademark gazette for any potential infringement of registered trademarks that have been published.

Check the official trademark gazette reviewing the names of the trademarks that are about to be registered and have been published for opposition in accordance with the applicable rules.

QUICKSAND OF THE SOCIAL MEDIA

Over these last years we have experienced a huge expansion and increasing role with a strong social impact of social media in people's daily lives as a large number of people already has social media accounts and this number is increasing.

Social media provides businesses with great communication platforms, which also increases the risk of brand misuse. At the same time, the same platforms have put in place relatively quick and inexpensive ways to deal with or report abuse. But you can only benefit from such protection if you have a registered trademark.

However, a registered trademark alone is not sufficient to claim the account or username.

Facebook has a "first come, first served" username policy which includes the ability to have a third-party Facebook page or profile that includes your brand in their username. You can obviously report this type of use claiming the infringement, but the outcome will depend on the

¹¹² <https://www.ipsoa.it/documents/impresa/marchi-e-brevetti/quotidiano/2020/05/11/covid-19-decadenza-marchio-giustificabile-mancato-uso>

context of its use because each use of your mark in a username is not necessarily a trademark infringement.

YouTube's policy, for example, is very similar and having a registered trademark is not enough to be protected.

Advertising being an important source of revenue for platforms, could also imply brand abuse. A characteristic situation is that a business uses its competitor's brand as a keyword for advertising. Each country sets its own rules, but in most countries what matters is the content of the advertisement.

Google or YouTube do not restrict the use of other companies' trademarks as keywords. The important thing is that the advertisement itself does not create a chance of confusion by indication the brand name of another company in the text of your ad or creating the impression that there is a connection between your companies.

Please note that the only reference to trademarks is not a trademark violation. It is true that writing an article about a product is difficult without naming that product. Consequently, the use of the brand name for informational purposes does not constitute trademark infringement.

Considering all above, it is worth to say that social media platform are not the final arbiters on trademark infringements. And even if a social media platform refuses your claim with regards to the misuse of your brand or considers that the reported facts are in line with their rules does not imply that there is no trademark violation.¹¹³

Some "honey" from a bee:

Instagram states on their website that:

Instagram can't adjudicate disputes between third parties, and so we wouldn't be in a position to act on trademark reports that require an in-depth trademark analysis or a real-world dispute outside of Instagram.

In the event of a problem that cannot be resolved rapidly, the prudent and sustainable approach would be to refer your concern to a lawyer specializing in trademark law to define possible steps and identify next actions if necessary.

The best strategy for the brand owner with respect to usernames and account names would be to act as quickly as possible as they are assigned on a first come, first served basis and remember that the registration of the account with the name of your trademark does not constitute per se an abuse.

¹¹³ <https://www.eu-startups.com/2018/08/trademarks-and-social-media-what-startups-should-know>

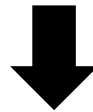
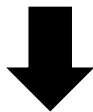
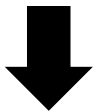


PROJECTS' PROPOSALS

by SustainaBeelity Team

e-LEGAL Game 2021

3 Buzzing Questions:



Why don't we create Solar Plans that can also help the Bees?

Why don't we create a new symbolic trademark dedicated to all projects referred to Bees and biodiversity?

Why don't we create a multi-stakeholder Union as integrated solution to deal with issues related to energy transition, bees, soil?

3 Buzzing Answers from the Bees



3 Fantastic Bee Proposals

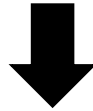
Bees need us!

Yes!
Let's do a Pollinator-Friendly Solar Plan

Yes!
Let's register SustainaBeelity as a trademark to cover all projects referring to the bees and biodiversity for all the companies participating to this e-legal game to pursue the SDGs goals together

Yes!
Let's create a global Union of responsible partners linked by SustainaBeelity trademark to face legal and business issues related to energy transition

Details:

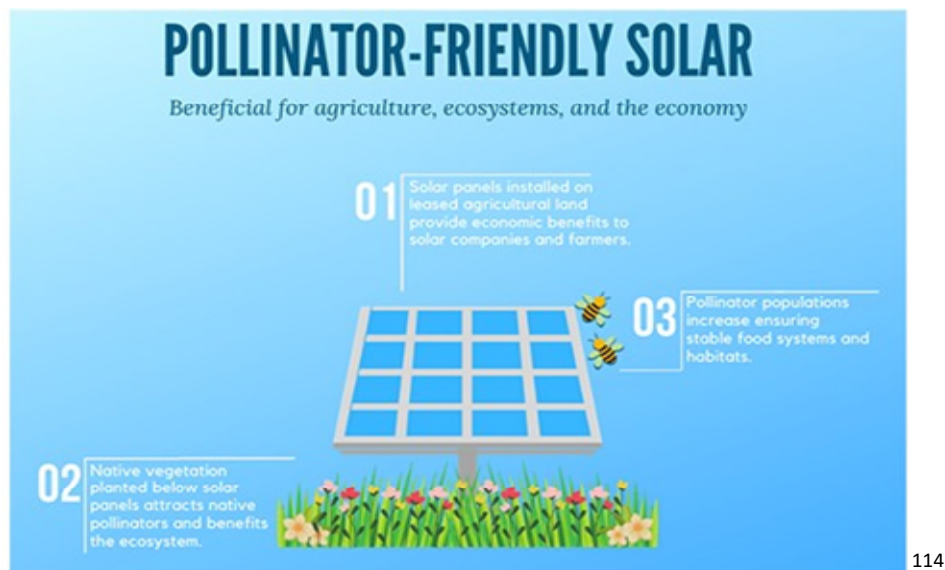


1st proposal: Constructing Pollinator-Friendly Solar Plan

As the global energy mix continues to move toward clean and renewable sources, energy generators need to consider the overall environmental impact of their installations. In the case of solar energy, simple actions to promote pollinator health alongside PV panels make solar not only carbon-free, but also beneficial to native ecosystems and the surrounding area's agricultural economy.

One way to enhance the ecosystem around solar panels is to plant native vegetation on solar farms to encourage local and migratory pollinator health.

Using solar installations as an opportunity to plant native vegetation would increase the amount of habitable land for pollinators such as bees.



Using native plants as ground cover can help recharge groundwater, reduce erosion, and improve soil carbon sequestration.

¹¹⁴ <https://www.eesi.org/articles/view/pollinator-friendly-solar-installations-benefit-wildlife-farmers-climate>

Planting vegetation underneath solar panels may provide benefits for the solar industry as well. Plant cover creates a cooler microclimate around the solar panels, and this cooling effect increases the panels' efficiency.

- **We suggest any energy production company should construct a (even) small Pollinator friendly solar project, in Europe, for example, in Romania or another European country.**

2nd proposal – a new Trademark Registration ®

We suggest the following “SustainaBeelity” to be registered, as a denominative and figurative trademark, at least at national level, in Italy. Our idea is to create a Symbolic trademark.



All projects¹¹⁵ referring to the bees and biodiversity, including those that will be illustrated in this e-legal game, can be covered by the same symbolic trademark.

This trademark can be a collective trademark to be shared also with other companies not participating to this e-lega game in order to reach common sustainable goals, on biodiversity care.

3rd Sustainabeelity global union – important role of Legals

¹¹⁵ Enel has several projects on different stages of its implementation, for example

Enel X organized some beehives on the roofs of offices in Rome:

<https://www.enelx.com/en/news-and-media/press/2021/05/apicolturaurbanait-and-enel-x-together-for-the-environment-three-beehives-find-a-home-on-the-roofs-of-offices-in-rome>

Enel Green Power – invented some agri-voltaic project on the solar plants around the world:

<https://www.enelgreenpower.com/stories/articles/2021/06/photovoltaic-beehive>

<https://www.enelgreenpower.com/stories/articles/2021/07/helping-bees>

<https://www.enelgreenpower.com/stories/articles/2021/07/fabio-rustico>

<https://www.enelgreenpower.com/our-projects/under-construction/azure-sky-solar-storage-project>

<https://www.linkedin.com/feed/update/urn:li:activity:6816322330814488576/>

<https://www.rinnovabili.it/energia/fotovoltaico/agrivoltaico-rinnovabili-bio-crea-enel/>

<https://www.enelgreenpower.com/stories/articles/2021/05/energy-transition-spain>

In our new development era with 17 intertwined Sustainable Development Goals and 169 associated targets as a blueprint for achieving the sustainable Future We Want, cross sectorial and innovative multi-stakeholder partnerships play a crucial role for reaching the goals.

Sustainable Development Goal 17, which reads “Strengthen the means of implementation and revitalize the Global Partnership for Sustainable Development”, recognizes multi-stakeholder partnerships as important vehicles for mobilizing and sharing knowledge, expertise, technologies and financial resources to support the achievement of the sustainable development goals in all countries, particularly developing countries. Goal 17 further seek to encourage and promote effective public, public-private and civil society partnerships, building on the experience and resourcing strategies of partnerships.

In this view, we also propose to create a multi-stakeholder Union in order to work all together with people of other companies, no matter if not involved in energy sector, on specific sustainable projects in an integrated manner. This means sharing ideas, knowledge and expertise, pooling financial resources with the scope to promote energy transition and, at the same time, to protect bees, improve soil quality, mitigate the effects of the climate crises on agriculture, sustaining biodiversity of flora and fauna.

Huge importance, in such a Union, can be the role of Legals since the legislative framework and intrinsic barriers are sometimes the main problems to be solved when looking towards the future having in mind an innovative solution.

Why don't we start from this e-legal game and let the seed grow in this direction? We propose all the entities participating to this e-legal game to give their support to this common initiative.





ANNEXES



INTERVIEW

by SustainaBeelity Team

e-LEGAL Game 2021

Trademark questions from the Bees

Guest: ANDREI GEORGESCU – Partner, SuciPopa Attorneys - Romania
Lawyer & Counselor of the Romanian Chamber of Industrial Property

1. I am an unusual bee, colored in yellow and green because I am focused on sustainability. Can I register my colors? Is there any advantage that I am not a usual one?

You sure can. Many corporations have registered their iconic color as trademark, such as red soles for women's high-heel shoes (Louboutin), light blue for jewelry boxes (Tiffany), brown for delivery trucks and uniforms (UPS), magenta for telecommunications (T-Mobile), or orange for tools handles (Fiskars).

However, little bee, I sense you are asking about registering a color combination. Here things get trickier, because, as the CJEU pointed out in *Heidelberger Bauchemie* (C 49/02), the graphic representation of two or more colors, designated in the abstract and without contours, must be systematically arranged by associating the colors concerned in a predetermined and uniform way. The court also pointed out that putting together two or more colors, without shape or contours, "in every conceivable form", does not exhibit the qualities of precision and uniformity required by Article 4 of the EU Trademark Regulation (EUTMR). Therefore, I would suggest that you register your lovely color pattern, meaning the repetitive succession of your green and yellow lines.

There sure is an advantage in being unique, not only in general, but also when it comes to trademarks. A lot of colors have been rejected as trademarks because they were

considered merely descriptive of a product or inherent to a product's functioning, such as color-coded automobile replacement parts, because the colors assist in installation, purple sandpaper, because the color signified the grit size of the abrasive, or yellow and orange telephone booths, because they increase visibility.

Therefore, if you were an ordinary black and yellow bee, you may have encountered some trouble with your trademark, if you were trying to register it for bee-related products and services. Being unique saves you this trouble and works as a great advantage.

2. Bees make honey from the nectar they obtain from flowers.

Can I register the smell of my honey? If yes, how can I describe it?

It can be done, but it is pretty difficult. The hard part comes from Art. 4 EUTMR, which requires that the trademark is capable of being represented in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor.

Perhaps the most interesting debate on this was stemmed by the case of *Vennootschap onder Firma Senta Aromatic Marketing*. They applied to register the "smell of fresh cut grass" upheld the application, saying that "The smell of freshly cut grass is a distinct smell which everyone immediately recognizes from experience. For many, the scent or fragrance of freshly cut grass reminds them of spring, or summer, manicured lawns or playing fields, or other such pleasant experiences". The decision was well criticized, as some scholars pointed out that the appearance of a smell to a person is always a subjective matter – the smell of fresh cut grass could appear differently to townspeople than to a farmer during harvest (Benson, Christopher, „Can a smell be registered as a trademark?", I.H.L. 2001). This is surely something that you as a bee can relate to, as you may have a different representation of how spring smells than us humans.

Subsequently, the European Court of Justice made the registration of smells merely impossible by deciding in *Ralf Sieckmann v. Deutsches Patent- und Markenamt* (Case C-273/00) that in respect of an olfactory sign, the requirements of graphic representability are not satisfied by a chemical formula, by a description in written words, by the deposit of an odor sample or by a combination of those elements. However, the new form of the EUTMR, adopted in 2007, does not require *graphic* representability any longer, but only a precise representation. Therefore, it has become relatively accepted that an optimal solution for describing the trademark would be a combination of the 'gas chromatography', a description of the olfactory mark in words and a reference to the manufacturing process (Essl, Marcus, „Die Registrierbarkeit von Geruchsmarken", ÖBl. 2001).

Nevertheless, more and more olfactory trademarks are being registered, throughout the world. You may be familiar with the scent of Play-Doh, described as “a scent of a sweet, slightly musky, vanilla fragrance, with slight overtones of cherry, combined with the smell of a salted, wheat-based dough”, which was registered in the US.

Finally, there are also jurisdictions where copyright was recognized for a particular smell (although copyright is not registrable and more related to an original work of creation), like the Dutch Supreme Court recognizing copyright protection to a perfume (Trésor of Lancôme) in 2006.

3. Can I register the taste of my honey? If yes, how can I describe it?

Taste is a whole other cup of honey sweetened tea.

The CJEU delivered a decision in *Levola* (C-310/17) on copyright which is considered to be similarly applicable to any other form of intellectual property (including trademarks).

Levola, which manufactured a cream cheese with fresh herbs, called *Heksenkaas*, sued a competitor over a different cheese alleging that such product infringed its copyright “in the taste” of *Heksenkaas*. The CJEU held that current EU law does not allow the taste of a food product from being protected by copyright.

To reach this conclusion, the CJEU held, *inter alia*, that for a “work” to be copyrightable, its subject matter must be represented in a manner that makes it identifiable with sufficient precision and objectivity. Taste would fail this test, because unlike literary, photographic, cinematographic or musical work, which are objective forms of expressions, taste is subjective and variable since it depends, *inter alia*, on factors particular to the person tasting the product concerned, such as age, food preferences and consumption habits, as well as on the environment or context in which the product is consumed.

So, there you have it, at least according to the CJEU, taste is more subjective than smell.

4. If I register my honey, can someone else produce honey?

That’s a tough one, because you cannot register honey *per se*.

What you could do is try to register the plant you use to make your honey. A plant variety right is an intellectual property right for the exclusive exploitation of a named plant variety. As with other IP rights, plant variety rights are intended to protect creativity and investment into research – in this case innovation in producing plant varieties for the development of agriculture. However, in order to do this your plant needs to be novel, so your plant would have to be as unique as you are. This would not protect the honey *per se* but would allow you to be the only one cultivating your plant which generates your particular honey.

Another way to do it would be to obtain a geographical indication for your honey. A geographical indication is a sign used on products that have a specific geographical origin and possess qualities or a reputation that are due to that origin. In addition, the qualities, characteristics or reputation of the product should be essentially due to the place of origin. Since the qualities depend on the geographical place of production, there is a clear link between the product and its original place of production.

If you obtain a narrow enough geographical indication (*i.e.* covering the area where only you and your bee friends harvest your honey), then no one else could claim that they produce honey which is identical to yours.

5. Honey is a supersaturated sugar solution, a solution that also contains acids, minerals, vitamins, and amino acids in varying quantities. Honey is composed of the sugars, fructose, and glucose. Can I register the recipe of the honey?

A mere listing of ingredients is not protected under copyright law; therefore, a recipe cannot be registered *per se* either. This is an element of your honey making know-how which you can protect by secrecy only. Therefore, sign confidentiality agreements with all those who you disclose your honey recipe to.

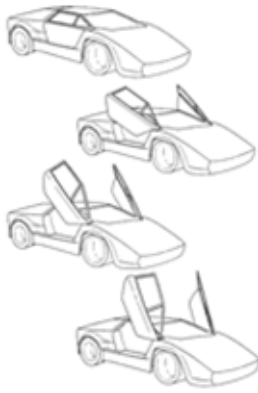
6. What about my buzz? Can I register this sound? If yes, how can I describe it?

Yes, sounds can be trademarked, as well, subject to the same rule of precise representation. Historically, the WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications indicated that “Offices may require that the representation of sound marks consist of a musical notation on a staff, a description of the sound constituting the mark, or an analog or digital recording of that sound – or of any combination thereof. Where electronic filing is available, an electronic file may be attached to the application. However, for some jurisdictions, only a musical notation on a staff may be considered to adequately represent the mark”.

The European Union Intellectual Property Office (EUIPO) now accepts that applicants attach a sound file to electronic or online trademark application forms. The attachment must be in MP3 format, must not exceed one megabyte and must not allow loops or streaming.

So, the easiest way to do it is to record your buzz and attach the file to the application.

7. Did you know that bees communicate with dance moves? Is it possible to register the wagging motion? If yes, how?



Motion marks are also permitted for registration. Their registration usually requires the use of a sequence of pictures or drawings to show the movement (much like animated cartoons). A popular example is the EU trademark belonging to Lamborghini, for their famous car doors. I think this looks a lot like your wagging motion, actually.

8. Can I register the design/pattern of the honeycomb? Can I also register the tridimensional aspect of the honeycomb?

Designs, defined as the appearance of the whole or a part of a product resulting from the features of, in particular, the lines, contours, colors, shape, texture and/or materials of the product itself and/or its ornamentation can be registered in both 2D and 3D.

However, the design needs to be new and the must not subsist in features of appearance which are solely dictated by its technical function.

Since there is proof that the hexagonal geometry of the honeycomb shape is designed to use the least amount of material to hold the most weight, the registration office may argue that the design is determined by functionality, rather than mere imagination.

9. If I register a mark, do I have to provide a notice to the public?

Part of the registration process is the publication of the trademark by the registering office. That is the moment when the applicant obtains the provisional protection over the trademark, which is consolidated at the end of the registration process. Therefore, it is the office that will provide the notice to the public on your behalf.

10. How can you tell if a mark proposed by me is already being used by another bee?

Actually, you can only research if the mark proposed by you is registered by another bee. The best tool for this is the TMVIEW engine which is coordinated and maintained by EUIPO.

However, if you do know that a mark is being used by another bee, even if not registered, you should not try to register it as such registration would be in bad faith, especially if you would be free-riding on the other bee's efforts to promote its mark.

11. Is it possible to lose my trademark?

Yes, first of all a trademark registration needs to be renewed every 10 years. Other ways to lose your trademark would be if you do not put it to genuine use in the course of five years, if the trademark has become the common name in the trade for a product or service in respect of which it is registered or if in consequence of the use made by you, the trademark is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.

Therefore, you should definitely use the trademark, and make sure that people know the trademark is yours and it does not become synonymous with a product or service. Sometimes, however, if your product is innovative and popular, it is difficult to stop the genericization of your trademark. This is what happened to Linoleum, Videotape, or Zipper, which originally used to be registered trademarks and not common product names.

Not least, you may lose your trademark as a result of annulment if it is proven that it did not meet the registration conditions in the first place or if it infringes an earlier intellectual property right.

12. Shall I register the logo of my SustainaBeelity team? But the SustainaBeelity name of the team?

Clearly you should. Nonetheless, all registrations must refer to products and services for which you actually intend to use the trademark. Therefore, decide first what is it that you are going to use your trademark for and only then proceed with the registration.

Thank you!

SustainaBeelity Team





Interview

by SustainaBeelity Team

e-LEGAL Game 2021

Leadership Lessons from Bees

Guest: CARLO ALBINI - Head of Innovability People & Organization in Enel Group

1. While one might think that Bees only focus on the most productive flower, they are wrong about this. There are unique Bees that do not rush into the most productive flower patches for short-term benefits. Instead, they follow a rule which focuses on the idea of sustainability with the nectar of that region. They prepare themselves for any unforeseen decline in the nectar of the currently productive location by relocating resources to other sites as well.

Do today's leaders have the same Sustainable Thoughts as Bees?

If you consider the responsibility leaders have toward the people belonging to their teams, I would definitely confirm they should think and act as bees do. When dealing with individual aspirations and talents within their teams, they have to ensure every person will be able to express their own potential and talents in the best way, by creating the proper environment and setting the most favorable conditions to allow each and every talent to bloom.

2. It seems that Bees have feelings and personality. Many bees exhibit unique personality traits, says Gene Robinson, the director of the University of Illinois Institute for Genomic Biology. His team of scientists found that certain bees exhibit behaviors that are not unlike the thrill-seeking behaviors seen in humans. The study also revealed the fact that some bees seem to seek novelty and adventure.

How important is to find the same novelty and adventure traits as Bees in a leader?

We have to look at current and future leaders in their essence first: they are all human beings... that implies they have the natural inclination to behave according to their unique personal traits, to their experiences (and the elaboration of “DOs and DON’Ts” they made out of them), to their comfort zones, and many other factors.

For sure we can find different archetypes (the so-called Explorer and Innovator are two of them) among the leaders we meet in the Company, but the crucial factor is the ability to successfully mix all these different attitudes in order to get the best from all of them.

What is (and must be) differentiating bees and leaders, in my view, is the set of reference Company values that always allow leaders to orient their behaviors despite their own archetype and to act accordingly.

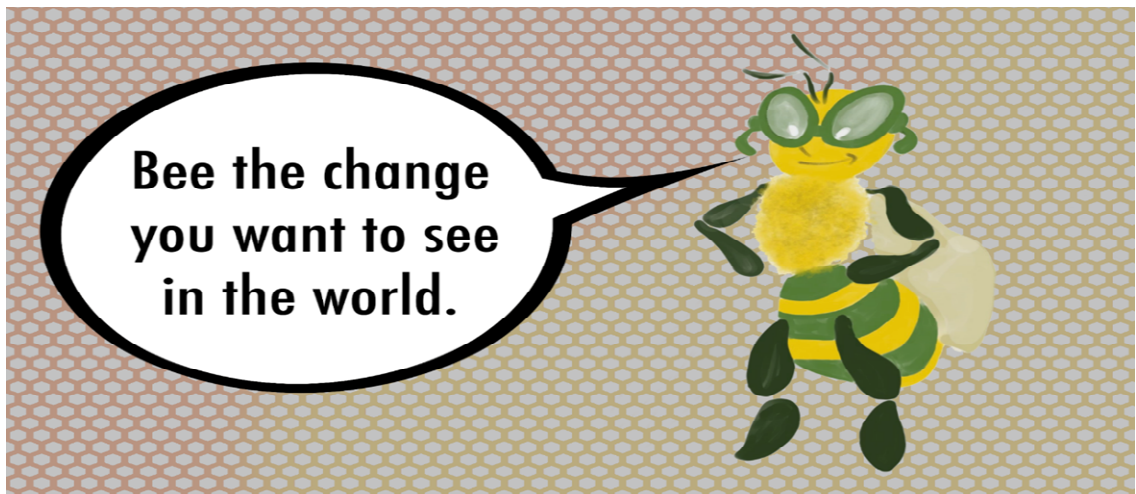
- 3. The Queen Bee performs her tasks and trusts her colony to get on with their individual duties. In essence, she doesn’t micro-manage. Each member of the colony is left to work autonomously and with purpose. A Harvard Business Review survey revealed 58% of people say they trust strangers more than their own boss because they don’t feel inspired, empowered and trusted.**

How important is the leader to perform like a Queen Bee?

Actually, I am not sure we can describe the Queen Bee as an example of voluntary leadership for what concerns “sense making” and inspiring the colony towards a common purpose. In this case we can think Nature is actually supplementing her leadership skills through an inherent adherence to the colony’s purpose and values of all the other bees.

Explicitly moving our attention to humans, when describing an ideal leadership profile, I see first the need for sense making to be able to inspire people and make them “activate” to reach common goals. Then trust, empowerment, open feedback and genuine listening will contribute to inject and sustain motivation and sense of belonging in all the people in the long run, completing the profile of the leader without competing with the Queen Bee.

Thank you!





Our Bee-friendly US trademark example – GUCCI BEE¹¹⁶

SustainaBeeLity Team

e-LEGAL Game 2021

Image Trademark with Serial Number 87120005

Status: 700 - Registered



Serial Number	87120005
Registration Number	5279452
Status	700 - Registered
Status Date	2017-09-05
Filing Date	2016-07-28
Registration Number	5279452
Registration Date	2017-09-05

¹¹⁶ <https://trademarks.justia.com/871/20/n-87120005.html>

Mark Drawing	2000 - Illustration: Drawing or design without any word(s)/letter(s)/ number(s) Typeset
Design Searches	032306, 032324, 261701, 261704 - Bees, wasps, hornets. Stylized insects, spiders and micro-organisms. Straight line(s), band(s) or bar(s). Vertical line(s), band(s) or bar(s).
Published for Opposition Date	2017-06-20

Statements

Indication of Colors claimed	The color(s) GREEN RED and GOLD is/are claimed as a feature of the mark.
Description of Mark	The mark consists of THE DESIGN OF A GOLD COLORED BEE ON A STRIPE CONTAINING THREE DISTINCT BANDS OF COLORS, THE COLORS BEING GREEN, RED THEN GREEN.
Goods and Services	Watches
Goods and Services	Handbags, shoulder bags, tote bag and wallets
Goods and Services	Clothing, namely, scarves, neckties and footwear

Classification Information

International Class	014 - Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments. - Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments.
US Class Codes	002, 027, 028, 050
Class Status Code	6 - Active
Class Status Date	2016-08-02
Primary Code	014
First Use Anywhere Date	2016-01-00
First Use In Commerce Date	2016-01-00

International Class	018 - Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery. - Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.
US Class Codes	001, 002, 003, 022, 041
Class Status Code	6 - Active
Class Status Date	2016-08-02
Primary Code	018
First Use Anywhere Date	2015-10-00
First Use In Commerce Date	2015-10-00
International Class	025 - Clothing, footwear, headgear. - Clothing, footwear, headgear.

Current Trademark Owners

Party Name	Gucci America, Inc.
Party Type	30 - Original Registrant
Legal Entity Type	03 - Corporation
Address	<i>Please log in with your Justia account to see this address.</i>

Trademark Owner History

Party Name	Gucci America, Inc.
Party Type	30 - Original Registrant
Legal Entity Type	03 - Corporation
Address	<i>Please log in with your Justia account to see this address.</i>
Party Name	Gucci America, Inc.
Party Type	20 - Owner at Publication
Legal Entity Type	03 - Corporation
Address	<i>Please log in with your Justia account to see this address.</i>
Party Name	Gucci America, Inc.
Party Type	10 - Original Applicant
Legal Entity Type	03 - Corporation

BEE PART OF THE SOLUTION!
HELP THE BEES!
#sustainbeelity



Sustainability Team **ACT NOW**



TO BEE CONTINUED...