



Trademark fluidity

Alberto Pelosi
page 1

An approach to the doctrine of equivalents

Marco Conti
page 3

Welcome on board Claude Nassif

page 4



the bugnion journal

#thebugnionjournal

n° 5. May 2019

Published in Milan (IT)
By Bugnion S.p.A.

Director:
Vincenzo Melilli

What's news with Bugnion

Renata Righetti

One year ago, in Seattle, we introduced our new image and logo on an international level. Over the course of 2018, until the very end of the year, we staged a huge number of events to celebrate our 50th Anniversary, the highlight being a three-day convention in Venice with our people. Our great team certainly deserved it! At the end of 2018 we also published a book to share our principles, ideas and attitudes. Some of our readers have already got it, but we'll be more than happy to forward a copy to those of you who are interested in getting to know us better.

But a celebration is mainly a perfect opportunity for us to focus on the future we want to build for ourselves and our stakeholders. This is especially true nowadays, when things are changing at such an incredible pace. Artificial intelligence and blockchain are always mentioned in almost every possible context, evoking intertwined hopes and concerns. It is difficult to foresee what impacts the new technologies will have on our lives. The entire IP world must certainly stay tuned.

As IP attorneys and specialists we have the privilege of constantly dealing with innovation, in the widest sense of the term, and are obliged to modernize ourselves and the way in which we handle cases, keep in contact, respond, suggest new solutions, walk new paths and occasionally change direction.

Among the many tasks we have, I would like to mention just a couple of ongoing projects.

Internally, we still have a lot to do in order to further develop smart working practices in all our offices and among professionals with different roles. To this end, we can exploit the additional opportunities that will come from the rebuilding of our proprietary professional and management software, a project which is already underway and will probably take about two years to complete.

A new project, IP-UP, was recently launched on the Italian market with the aim of better supporting innovative startups in identifying, protecting and exploiting their IP assets and gaining access to the financial market. It is the fruit of the long experience acquired on the ground by several of our colleagues and is featured in a dedicated area of our website. Again with an eye to supporting business, a specialized team was recently set up to help companies to recognize and better manage their know-how and trade secrets.

To summarize, a lot of projects as always, and our usual mantra: think, propose, imagine, plan, share and dare for a better tomorrow.

Renata Righetti



Born in Milan, Renata attended the history faculty at Università Statale di Milano. After joining Bugnion in 1982, she has acquired a wide-ranging expertise above all vis-à-vis trademarks as head of the Foreign Department of Bugnion. From 1995 until 2012 she was General Manager of the company. Renata is partner of Bugnion and has been President of Bugnion S.p.A. since 2004. President of Italian Section of AIPPI from 2014-2016 Vice-President of AIPPI International since 2016. President of Aippi International since 2018.

Trade dress in the European Union

Dealing with shapes and appearance



Vincenzo Melilli

"Trade dress" refers to the visual appearance of a product and/or its packaging as well as their ornamental features. In particular, protecting "trade dress" in the EU mainly consists of a combination of three tools: 3D trademarks, Designs and Copyright.

The most effective protection is provided by EU three-dimensional trademarks because, among other things, they are renewable for an unlimited period of time (every ten years), they protect a broader subject matter (the (legal) standards for likelihood of confusion, a typical issue in the trademark realm, apply). The subjective point of view to take into account when assessing similarity/invalidity is the "average consumer" rather than the "informed user" in the particular field

of expertise concerned and there is no matter of "disclosure"/ "pre-publication" to be considered. Some of the most significant decisions on trademarks and designs shaping some basics in the EU of "trade dress" are summarized below. Apple Inc. v. DPMA (C-421/13) - TRADE-MARKS

The matter addressed at the European Court of Justice level involved a sophisticated issue, namely, the "the presentation of the establishment" or the layout of Apple's flagship store.

Apple Inc. was already the owner of a three-dimensional trademark granted by the USPTO. When the company sought an extension of protection in Europe, the DPMA (the German PTO) found that the trademark did not qualify as a source identifier, defining the sign no more and no less than a representation

of the essentials of a store.

The ECJ ruled that "[...] a representation, such as that at issue in the main proceedings, which depicts the layout of a retail store by means of an integral collection of lines, curves and shapes, may constitute a trade mark provided that it is capable of distinguishing the products or services of one undertaking from those of other undertakings."

Hauck v. Stokke (C-205/2013) In Hauck GmbH & Co. KG v Stokke A/S and Others, the European Court of Justice provided crucial guidance for interpreting Art. 3(1)(e)(i) of Directive 2008/95/EC. In fact, this provision prohibits the registration, as a trademark, of signs consisting exclusively of shapes resulting from the nature of the goods. In summary, despite the potential registrability of product shapes as trade-

marks, three-dimensional trademarks should be rejected also if the shape is not indispensable to the function of the goods. As a result, the decision has drastically increased the difficulties in overcoming the thresholds.

Christian Louboutin -I v. van Haren Schoenen BV C-163/16

In spite of the strict interpretation, as seen particularly in the Stokke case, the newest developments in respect of three-dimensional trademarks are promising. In fact, in the "Louboutin" decision, the Court courageously went even beyond the uncompromising opinion of the CJEU Advocate General. In fact, the Court stated: [...] while it is true that the shape of the product or of a part of the product plays a role in creating an outline for the colour, it cannot, however, be held that a sign consists of that shape in the case where the registration of the mark did not seek to protect that shape but sought solely to protect the application of a colour to a specific part of that product."

DOCERAM GmbH v CeramTec GmbH C-395/16 - DESIGNS

Despite the broader and more comprehensive trademark protection for "trade dress" in the EU, Designs offer a residual means for "trade dress" owners to protect the external appearance of their products in the European Union.

It is rare for the Court of Justice of the European Union to be entrusted with design cases. In fact, the percentage of trademark cases brought before the European Court of Justice drastically exceeds the amount of design cases it has decided. Therefore, unlike the above-mentioned decisions, which only focused on three-dimensional trademarks, a recent Court ruling has brought enormous attention to design practice in the European Union as a whole and in individual Member States.

Despite their limits in terms of narrow protection, design registrations in the EU are more accessible than three-dimensional trademark registrations. The main threshold applied is intended to prevent monopolies over technological innovation. In other words, obstacles to registration are raised when the need to fulfil a technical function is the sole factor determining the designers' choice. There is no clear statutory law explaining the terms "solely dictated by its technical function". One issue is whether alternative options for achieving the same technical function might suffice to overcome the threshold. In C-395/16, Doceram v

page 2

Trademark fluidity

A concept applied to distinctive signs

Alberto Pelosi

In the Internet age, a new approach to distinguishing products and services is replacing the traditional concept of trademarks. This new perspective regarding distinctive signs has brought us fluid trademarks (Google doodle). There are no known decisions or rules of law that expressly provide for fluid trademarks in the EU. As a result, the only way this matter can be addressed is to identify the essence of the fluid mark and apply current court decisions and the rule of law. Analysis should focus on fluid trademarks as distinctive signs, signs with a decorative purpose and signs used in trade that are different from the form in which they were registered. There is a straightforward

strategy already in place that enables companies to file for protection of fluid trademarks. It is always crucial to start with a strong trademark. Before considering the fluidity of a mark, it is best to begin with the basics: namely, selecting, enforcing and strengthening a secure and robust distinctive sign – there would be no Google doodle without a strong Google sign. When the basic trademark is fully and easily recognised by consumers, a focus can be placed on adopting a style leading to fluidity. Such a style – which maintains the personality of the main mark – is the signature of a fluid trademark protection strategy. Based on a cost-benefit analysis, when there are so many variations in a fluid mark that it would be unreasonable to file for protection for each version, mul-

iple designs enable ornamental rights to be claimed on these variations. The scope of mixing and matching trademark and design tools can secure comprehensive protection for many aspects of the same sign – in particular, pairing trademark protection for the main sign with alternative variations. In In re Galletas Gullon SA v EU Intellectual Property Office (Case T-404/16), the EU General Court highlighted the main issues relating to the alteration of trademarks that would apply to fluid marks. In essence, The General Court found that where the form of the sign used in trade differs from the form in which the sign was registered only in negligible elements, with the result that the two signs can be regarded as broadly equivalent, the obligation to use the registered trademark may be fulfilled by furnishing proof of use of the sign which constitutes the form in which it is used in trade. This will allow its owner to make variations which, without altering its distinctive character, enable it to be better adapt-

ed to the marketing and promotional requirements of the goods or services concerned. Branding companies and professionals have fully embraced the concept of fluid trademarks. Dealing with the fluidity of distinctive signs in terms of protection and enforcement is like the labyrinth of the Minotaur – the deeper we delve into the maze, the more difficult it is to escape.

Alberto Pelosi

Graduated in Marketing, Corporate Communication and International Markets from the Economics and Business faculty of University degli Studi Milan-Bicocca. He joined the Milan office of Bugnion, trademark sector, in September 2013. In 2017 he became a partner and since 2018 has been in charge of international relations of Bugnion, liaised with foreign correspondents and clients.



From the first page - Vincenzo Melilli
Trade dress in the European Union

CeramTec, the Court gave a comprehensive explanation of what "solely dictated by its technical function," means. In the decision for invalidation at issue, the Court held that: "Article 8(1) of Regulation No 6/2002 excludes protection under the law on Community designs for features of appearance of a product where considerations other than the need for that product to fulfil its technical function, in particular those related to the visual aspect, have not played any role in the choice of those features, even if other designs fulfilling the same function exist." In other words, "it must be established that the technical function is the only factor which determined those features, the existence of



alternative designs not being decisive in that regard."

Conclusion

In view of the foregoing, although it is extremely rewarding, it is also very challenging to protect, inter alia, shapes and three-dimensional features as EU trademarks. However, those seeking protection for signs whose appearance differs from the "typical" shape

in a particular sector may yet find a basis for claiming distinctive character. In addition to distinctiveness, having at least one "non strictly functional" element would enhance the likelihood of avoiding the "technical" objection, namely, "the shape, or another characteristic, of goods which is necessary to obtain a technical result". Finally, three-dimensional signs for which registration is sought should not include a major "ornamental element" providing the goods with substantial value.

Vincenzo Melilli

Vincenzo Melilli is a European trademark and design attorney. Graduated from the Catholic Law School of Milan and obtained his LLM from Fordham University School of Law in New York. Head of design law department. Before joining Bugnion SpA, Mr Melilli worked at a New York IP law firm where he specialised in trademark prosecution, infringement, counterfeiting and dilution. A member of the American Bar Association (ABA), the ABA Design Committee and the International Trademark Association's EU.



Protecting fashion shape marks

An obstacle course?

Chiara Domeniconi

Shape is an important factor behind purchasing decisions by consumers, especially in the fashion sector, where the aesthetic appearance of products plays a key role. Fashion designer Pierre Cardin once remarked: "What comes first is the shape. Then the material, which expresses volumes, fluidity, languor. Colour is merely the last feature". In terms of the various options offered for protecting shapes, trademarks are certainly preferable thanks to their potentially permanent protection.

needs to be met in all EU countries! Once over the hurdle of distinctive character, a shape trademark may be registered only if there are no further legislative impediments. With regard to fashion products, the most common impediment is certainly that of "substantial value", which relates to shapes that, on their own, thanks to their power of attraction and aesthetic-ornamental value, can determine consumer choices. It's clear that such a situation is rather frequent in the fashion sector, where product aesthetics play a key role. The impediment cannot be remedied



GDPR and WHOIS: from bad to worse

Providing access to data

Andrea Cappai

Anyone who was involved in online trademark protection before May 25, 2018 knows only too well that the WHOIS system, albeit flawed by technical and legal inconsistency among the different TLDs, was a vital tool for pursuing the difficult goal of protecting IP rights. The "WHOIS", a contraction of the English words "Who is", enables (or, enabled) anyone to identify the owner of a domain, worldwide and 24/7; it granted access to data on millions of domain names to corporate IT departments and law firms (but also to spammers and other "web" bandits).

The effectiveness of the WHOIS system had already been affected by the introduction of WHOIS privacy, a premium service that allows the holder of a domain to mask the contact details and disguise the e-mail address. Yet, the cost of the service and the carelessness of many owners limited its impact somewhat. In May 2018 the already ailing WHOIS system received the coup de grace with the implementation of the EU General Data Protection Policy; the "GDPR" is the legal framework for personal data protection and privacy for all individuals within the European Union, and applies to any company involved in the movement, processing or storage

of personal data of EU citizens, regardless where the company is located. Indeed, this huge database crammed with the personal data of domain name holders, many of them being EU citizens, was utterly GDPR not-compliant. In view of the high sanctions and the technical difficulty of establishing whether domain data belongs to an EU citizen or not, many registries have decided to be on the safe side by simply not providing data to WHOIS. What was originally intended to protect the privacy of EU citizens has turned into a terrific gift for cybersquatters and scammers in the rest of the world. The main stakeholders are now working on a new system of access with accreditation to the data that are today obscured. However, for now brand protection experts must send complaints to the registrar abuse contact or file court actions to get access to WHOIS data, with an increase in the costs of online brand protection. Relevant developments are expected by the end of 2019.

Andrea Cappai

Graduated in law from Luiss University in Rome with a dissertation on "The Legal Protection of Fashion Design". At the Management School of the Italian Trade Agency, he elaborated on the topic of the protection of intellectual property, focusing on the Chinese market. After an internship at a leading Italian IP office, and work experience in Beijing at the Dragon IP office, he joined Bugnion, where he is a consultant in intellectual property who assists Italian and foreign clients with trademarks, domain names and designs. He is a member of the China desk and assists the Head of the Internet Department in the management of services providing online protection of intellectual property. He holds seminars in Italy and China and regularly writes articles in the main journals specializing in intellectual property.



European Union law does not contain any definition of "shape", a fact which recently resulted in the EU Court of Justice understanding this concept as "a series of lines or boundaries that delimit the product in space" (C-163/18). In other words, everything that is not delimited in space (through boundaries, dimensions and volumes) will be excluded by the concept of "shape". Alongside this limit, deriving from the notion of "shape", there are other legislative requirements that contribute to making the obtaining of shape trademarks a genuine obstacle course. The first one is "distinctive character". Although EU case law has reiterated that the distinctive character of a product's shape must be examined in the same way as for other types of marks, it's undeniable that a lack of distinctiveness is more frequently found for shape trademarks (than for other types of marks), since average consumers are not in the habit of making assumptions about the origin of products on the basis of their shape or the shape of their packaging in the absence of any graphic or word element. EUIPO recently rejected a three-dimensional trademark application (No. 15679426), consisting in the shape of a shoe by the fashion designer Manolo Blahnik, filed for "footwear", considered to be devoid of distinctive capacity. To overcome this obstacle, in the event of intense use in the market, the "secondary meaning" requirement is often invoked. However, the difficulty of proving a sign's acquired distinctiveness in relation to shape should not be underestimated, especially if this requirement

by the fact that the shape which lends a product its substantial value has also acquired the function of identifying its entrepreneurial origin, since the "secondary meaning" does not apply to get around the "substantial value" obstacle (C-371/06). This is clearly to prevent permanent monopolies on aesthetic solutions even in the event of a commercial success of such magnitude that shapes can be deemed to have acquired, along with an aesthetic value, a distinctive function. But fashion protagonists should remember that a trademark is just one of the tools of shape protection. The easiest mistake to make is to rely only on the protection offered by trademarks, thus waiving the opportunity to protect the shape of a product or its packaging first as a design, provided that all legal requirements are met.

Chiara Domeniconi

After graduation, she attended a course in intellectual property and infringement in Turin. She qualified as a lawyer in 2016. After working for years with a leading law firm in Milan, where she mainly dealt with trademarks, design, patents, domain names, copyrights and labelling of products, she worked for three years in the legal department of a well-known industrial group in Bologna. In October 2017 she joined Bugnion, where she currently works as an intellectual property consultant.



Implementing EU directives.

A country approach to EU authoritative directions

Simone Verducci Galletti

The development of the project to harmonize the national regulations of European Union countries governing trademarks continues to be a main driver of change in the trademark sector in Europe. Italy's trademark sector, like that of all EU Member States, is facing a new (r)evolution: the implementation of Directive (EU) 2015/2436 on the approximation of the laws of the Member States relating to trade marks and the adaptation of national legislations to the provisions of Regulation (EU) 2015/2424, which amended the Regulation on the European Union trade mark. On the 20th of November 2018, the Italian Council of Ministers met to approve the legislative decree prepared by the Ministry of Economic Development, with which Italy fulfils its obligations to amend trademark law as provided for by Directive 2015/2436. As is well known, the Directive brings in mainly the following changes: - over the next seven years, Member States will have to introduce new administrative procedures as an alternative to legal proceedings for the revocation or

declaration of invalidity of trademarks; - the extension of existing cases of trademark rights and the extension of protection to new types of trademarks, with the abolition of the requirement of mere graphic representability; - the introduction of absolute grounds for refusal to register trademarks in the case of conflict with designations of origin and geographical indications (PDOs/PGIs), regardless of the sector to which they pertain (wines, spirits, agricultural products, etc.), as well as the provision of special grounds for refusal of registration in the event of conflicts with protected traditional terms relating to wines (TTs) and traditional specialities guaranteed (TSGs) protected by Union legislation. Regrettably, the issue related to alternative administrative procedures for revocation and cancellation has not yet been addressed; it may be assumed that the Italian Government intends to use all the time made available by Directive 2015/2436 (until 2023) in an attempt to identify an operational platform that would allow the Italian Patent and Trademark Office to tackle the huge increase in activity that will result from these new procedures. All

remaining aspects have been implemented, including the issues related to the fight against counterfeiting: the Legislative Decree prepared by the Italian Ministry of Economic Development in fact extends the possibility of applying border seizure measures against counterfeit goods even in cases of mere transit. Such measures were previously provided for only in the presence of evidence that the suspect goods would have been marketed in Europe.

Simone Verducci Galletti

Graduated in Law with top marks and, after qualifying as a lawyer, specialized in the law and economics of the European Union. After a short period at Legimark in Rome and in the Alicante office of a well-known English firm, he joined Bugnion's Milan office in 2005. Assists leading Italian and international clients in creating, managing and defending trademark and design portfolios and with the relative enforcement, especially in the customs field. He is a partner and since 2018 has sat on the Board of Directors at Bugnion. He is on the WTR 1000 list of recommended individuals for Italy and was nominated as an IP STAR by Managing IP. Simone has been nominated one of the Leaders 2018 by WIPR.



Twisting and spinning

A reputation twister for the well-known SPINNING brand

Alessandro Mannini

In its judgment of November 8, 2018 in Case T-718/16 concerning the revocation of a European Trademark for the word SPINNING, the General Court confirmed the principle that a EUTM may be revoked if the trademark mark has become a common name for the relevant goods or services even in a limited part of the EU, or in a single Member State. In this case, however, the Court annulled EUIPO's decision to revoke the EUTM, as its assessment failed to consider evidence from professionals in the relevant field, whose influence in the circumstances was considered greater than that of the end user.

In 2012 partial revocation proceedings were brought before EUIPO against Mad Dogg Athletics, Inc.'s EUTM No. 000175117 for the word mark SPINNING in respect of exercise equipment and exercise training. The basis for revocation was that the mark had become a common name to describe those goods and services in the Czech Republic (Article 51(b) CTMR - now Article 58(1)(b) EUTMR).

In July 2016 EUIPO revoked the EUTM, finding that the substantial evidence submitted "proved that the term 'spinning' had become, in the Czech Republic, the common name for a type of 'exercise training' and for the 'exercise equipment' used for that training" by end users and that the trademark owner, the US company Mad Dogg Athletics, Inc., had not taken sufficient initiatives to prevent this occurrence. As a result, the trademark had lost its distinctive character.

Mad Dogg Athletics brought an action for annulment of this decision before the General Court, alleging flaws in EUIPO's reasoning, inter alia, its evaluation of the relevant territory and relevant public to be considered for assessing the grounds for revocation. With regard to the relevant territory, the trademark owner held that an assessment limited to one Member State alone was insufficient to determine revocation of an EUTM that enjoyed a reputation throughout the EU. With respect to the relevant public, Mad Dogg Athletics held that EUIPO's assessment was flawed in that it considered only the perception of end users of the goods and services, while disregarding that of the professionals concerned, which played a greater role.

In its decision, the General Court addressed these issues as follows. It reiterated that the "unitary character of the EU trademark is the basic legal principle underpinning the entirety of [the EUTMR]". That principle implies that the distinctiveness required to be present in a trademark, throughout the EU, at the time of its registration must

From the second page - Alessandro Mannini
Twisting and spinning

be retained during the life of the registration and should not become, even in a limited part of the EU or a single Member State, a common name to identify the goods or services for which it is registered. Therefore, the EUIPO was entitled to revoke the EU trademark SPINNING based on evidence from a single Member State.

On the matter of the relevant public, however, the General Court held that EUIPO was wrong to limit its assessment only to the perception of the end users of the contested goods and services. During the proceedings it clearly emerged that in most cases the exercise equipment (indoor cycles) sold by Mad Dogg Athletics is purchased by commercial operators and fitness centres, hardly ever by end users. Those professional operators for the most part also provide the "exercise training" services that in-

volve use of the goods in question and arrange for the group sporting activities to be conducted at their facilities. It was held that such commercial operators are key figures in the exercise equipment market and influence the end user's selection of equipment and training sessions. Therefore, since the EUIPO failed to consider the perception of Mad Dogg Athletics' professional customers in the Czech Republic when assessing whether the trademark SPINNING had become a common name for the goods and ser-

vices in question, the decision to revoke EUTM No. 000175117 was annulled.

Alessandro Mannini

Master's Course in Environmental Sciences at the University of London; Industrial Property course at the WIPO of Geneva. Head of Bugnion's Florence office since 2005 after many years



working with another firm in the same sector in Rome and Florence. Mainly provides written opinions and solutions to issues relating to trademarks and designs inside and outside Italy. Member and then Chair of the INTA (International Trademark Association) Committee for dealings with National European trademark offices (2010-2015), the Committee for Trademark Legislation in European Countries and Central Asia (2016-) and of the TM5 Group (2018-). He also publishes articles on IP in professional journals. Partner at Bugnion.

An approach to the doctrine of equivalents:

Amending claims of patent applications

Marco Conti

The impact that amendments applied to the claims of a patent application during prosecution may have in a subsequent infringement litigation has been largely debated in the last few years. In the following paragraphs, the recent developments that have occurred in Europe are compared to the practice that appears to be established in the USA.

In Decision N. 54470/2016 (10 September 2017), the Milan Court ruled that if a patent undergoes substantive amendments – that is, amendments introducing new features which are based on the description – the doctrine of equivalents should not apply to those features. This decision appears to be consistent with the practice of the Courts in the USA.

Similar decisions were taken in Germany and UK, but they were later reversed by the respective supreme courts, with decisions X ZR 29/15 (14 June 2016) and

the other factors that deeply impact the legal certainty for third parties: (i) the prohibition against broadening the scope of protection with a post-grant amendment, established for example by Art 76(1)(c) CPI and Art 123(3) EPC, and (ii) the prohibition against adding fresh subject matter in any amendment, with respect to the content of the application as filed, established for example by Art 76(1)(c) CPI and Art 123(2) EPC. Regarding the first factor, the prohibition against broadening the scope of protection with a post-grant amendment determines that, once a patent is granted, competitors will have the possibility of studying the claims and may rest assured that, if their technical solution falls outside the scope of the independent claims of the patent, they cannot be later be found to have infringed the patent.

Regarding the second factor, the harshness of the criterion for establishing

lity action brought against the patent, often as a counterclaim. Under these circumstances, the patent is ordinarily challenged on the ground of prior art that the Examiner did not consider, as a result of which the patentee did not have a chance to amend his patent during the Examination phase (in the absence of a prohibition against broadening the scope of the patent) in order to address such references.

Therefore, the need to resort to the description to limit claims is often a reaction to a situation the patentee has not faced before (sometimes also because of the limits of the patent offices concerned), rather than abusive behavior.

Also, the stricter the criterion for assessing new subject matter in an amendment, the more probable it is that additional features will have to be introduced into the claim, in addition to those strictly needed to actually meet the requirements of novelty and inventive step with respect to a (new) reference.

For the above reasons, it appears that the application of the doctrine of equivalents also to features that are possibly added in the course of description-based amendments is important to preserve a fair right for an inventor to protect his invention.

Conversely, should the doctrine of equivalents be excluded from all post-grant limitations added based on the description, a risk appears to arise of an excessive advantage for third parties, who could oppose a patent by resorting to a tactical use of prior art which was unknown to the applicant during the prosecution of the patent application, thus unbalancing the patent system against the patentee. In other words, a risk of an unbalanced and weakened patent system would arise, with all of the consequences that this could bring about.

Marco Conti

Marco took a Master Degree in electrical Engineering and a PhD in Electrical Technologies. He is employed in Bugnion since 2004 dealing with Patent, Copyright, Industrial design and model. As an authorized European Patent Attorney Marco prosecuted over 100 patent applications and assisted clients in many post grant proceedings. Marco is Partner of Bugnion and he is a member of the company's board of directors since 2015.



[2017] UKSC 48 (12 July 2017), respectively.

A patent system must ensure a fair balance between the right of the inventor to enforce his patent rights and the need to guarantee legal certainty for third parties. This concept is established in Art 52 of the Italian patent law (CPI - Industrial Property Code) and has corresponding provisions in the patent law of other countries.

In this context, the application of the doctrine of equivalents is an important advantage for the patentee. When assessing whether this advantage is unfair or inappropriate in the case of substantial amendments, one should consider

whether or not an amendment has enough basis in the description may vary greatly from one country to the other. Typically, in Europe the freedom for a patentee to amend claims based on the description is severely limited with the aim of ensuring legal certainty for third parties. However, the situation is quite different in the USA, where applicants have plenty of freedom to fine tune their claims in order to overcome prior art cited against the patent.

Let us also consider the situation where the need arises for a patentee to amend claims in the post-grant stage. Typically, such a need is generated by opposition proceedings before the EPO or by a nul-



Find the way to shape your future.

A successful story that begins in 1968, built on our expertise and innovative approach in protecting and handling intellectual property assets worldwide.

We turn your ideas into value.

Find your way on www.bugnion.eu

ANCONA | BOLOGNA | BRESCIA | FIRENZE
MILANO | MODENA | PARMA | PERUGIA
REGGIO CALABRIA | REGGIO EMILIA | RIMINI
ROMA | UDINE | VERONA | ALICANTE (ES)
LOS ANGELES (US) | MÜNCHEN (DE)

Testing the waters

EPO: Postponement of the examination for patent applications

Simona Inchingalo

The EPO recently launched an online survey about the postponement of examination of pending patent applications.

Postponement of examination is available in some countries, like the USA, Japan, Korea, China, Australia and Russia.

In CN, JP, KR and RU, substantive examination must be requested by the applicant, or by any third party, with payment of an examination fee, at any time within 3 years from filing.

In the USA it is different: after being filed, a patent application joins a queue awaiting examination. The USPTO has established an optional deferral procedure whereby the applicant pays a fee and chooses the number of months of deferral, 36 at the most.

In Australia the examination of an application is carried out only when a request for examination is filed and an examination fee is paid, within 5 years from the filing date. The long period for requesting examination is balanced by the short duration of substantial examination (12 months from the date of the first examiner's report).

In Europe, Germany has a similar system. Applicants have 7 years from the filing date to request examination and pay the associated fee. Applicants can take advantage of this by filing a German and a Euro-PCT patent application in parallel. Based on the outcome of the latter, the former can be used as a fallback position: the applicant can abandon the Euro-PCT and use the provisional protection granted by the German application. The German case is peculiar, since it fits into a system that doesn't envisage the postponement of examination. If the EPO introduces deferred examination, the German system's advantages will disappear.

The purpose of the EPO is to reduce the existing backlog at the EPO by avoiding the examination of applications in which applicants have lost interest or in cases where applicants have decided not to invest further resources in a technology that has become obsolete.

There are also disadvantages tied to deferred examination, since it would stretch the duration of prosecution of a patent application which, in the view of many applicants, is already too long.



The introduction of this system would harm third parties, since the period of legal uncertainty would be extended. Many years could pass between the filing date and the date of grant and third parties wouldn't know the exact scope of protection of a competitor's right and would be left in doubt as to whether their new products might infringe a patent granted after a deferred examination. This could potentially freeze the marketplace.

Some applicants, mainly large companies, might take advantage of this system strategically by choosing to defer examination, monitor the market, and tailor their patent around competitors' successful products. They can file a high number of applications, even weak ones, keeping them pending for years without much financial effort, thereby blocking or increasing the uncertainty of the marketplace. Many patents will remain submerged for years, only to surface and surprise competitors at the right time, harming small and medium-sized enterprises.

Furthermore, some European States allow court infringement proceedings to be initiated on the basis of a national or European patent application, where the State concerned is designated. However, a decision can be issued only after the patent is granted. A postponement of the examination might unacceptably delay the issuance of a decision by the court.

If postponement becomes a reality in Europe, some precautions can be adopted to mitigate the drawbacks: delaying examination only after the publication of a European search report, and giving third parties means to assess the patentability of the application. The request for postponement should be subject to payment of a high fee, in order to ensure that deferral will be sought only if there is a real interest and not just to put a strain on competitors. Third parties should be allowed to trigger an examination even if postponement was requested. Moreover, as in Australia, the examination should be ended quickly, for example within 12 months from the first official action.

Countries having a deferred examination system possess homogeneous legislation and a single economy. Adopting this system should be a matter of national law, considering the national economic environment. Europe, by contrast, is the union of a number of states, each having its own legislation, marketplace and economy. What works for realities totally different from Europe's could not be applied with equal success in such a heterogeneous bundle of nations. The deferred system could make sense at a national level but not at the European level.

Simona Inchingalo

She graduated in Aerospace Engineering with top marks and worked with the Aerospace Propulsion Laboratory of the Polytechnic University of Milan to develop solid propellers for space vehicles. In Bugnion since 2004, after gaining experience and great technical expertise, she was the head of Bugnion's Back Office until 2013. She is in charge of managing the patent and design portfolios of Italian and international clients and since 2015 she has been the head of the Validation Department. Partner since 2016.



International developments

Bugnion worldwide

Alberto Pelosi

Before talking about Bugnion's international developments, it is important to mention internal changes. Simone Ver-

been appointed member of the Board of Directors at Bugnion and, since the second half of 2018, I have been acting as the new International Affairs manager (referred to internally as the "Foreign



ducci Galletti, manager of International Relations for more than 5 years, has

Minister"). I'm excited about this new role and about having a chance to work

even more closely with foreign correspondents and clients. Several international projects have been launched in the last few years and there is a lot of stuff going on. We are very active in the Japanese market and, via the close cooperation with our partner in Osaka, we have acquired considerable experience on the Japanese system. The establishment of a Japanese desk, with a Japanese attorney joining the staff of our office in Bologna 3 years ago, has allowed us to reach a high level of knowledge about the Japanese context. The benefits of this cooperation are enjoyed by both our domestic clients, as support in their overseas activity, and Japanese corporations seeking assistance in European IP-related procedures. Remaining in Asia, just two years since the establishment of a China team, we are glad to have achieved the objectives we set ourselves. We have acquired internal knowledge of the Chinese system and are now seen as point of reference in Europe for Chinese clients. However, this is just the beginning of a much longer journey. On the other side of the world, in the US, Mr. Claude Nassif, a former US patent attorney who has been active in the IP field for over 18 years, has joined Bugnion and the liaison office in Los Angeles, becoming a member of our U.S. team. With the arrival of Claude, Bugnion's footprint in the USA is getting bigger and bigger. Japan, China and the USA are projects we are working hard on and investing resources in, but Bugnion's horizons are limitless. Increasing our promotional activities in other parts of the world as well (India, Israel, South Korea, etc.) must be one of our goals for the near future.

An overview of Comparative Advertising

The most significant case law

Elena Carpani

Comparative advertising (comp. adv.) is the direct or indirect use by one company of another company's brand/product in order to compare that company's brand/product with its own.

Comp. adv. is differently regulated in every country. Generally speaking, comp. adv. is allowed to a much greater degree in common law systems than in civil law ones.

For example, concerning US law, the Federal Trade Commission specifically encourages comp. adv., when truthful and non-deceptive, since it is a source of important information to consumers and assists them in making rational purchase decisions and because it encourages product improvement and innovation and can lead to lower prices in the marketplace.

In a famous US decision, a Court held that comp. adv. naming a competitor is beneficial to consumers ("25% LOWER IN CALORIES THAN WERTHER'S® ORIGINAL CANDY") because "they learn at a glance what kind of product is for sale and how it differs from a known benchmark".

In all European countries there is a very similar situation due to Directive 2006/114/EC concerning misleading and comp. adv., which is directly enforceable in every EU country.

However, comp. adv. is still very marginal in EU countries. An essential requirement for comp. adv. is that a company has to be able to substantiate the superiority of a product/service compared to a product / service of a competitor / all competitors on the market.

According to German case law, comp. adv. must avoid the express use of the terms

"imitation," "replication," and "replica" in order to not be characterized as non-permissible. It is, however, permissible to claim mere product "equivalence."

In France there was a case in which a manufacturer of a coffee press had presented in its catalogue an advertisement showing, next to its coffee press, a pile of used, deformed capsules with the slogan "make taste not waste". A coffee capsules manufacturer and competitor argued that such advertising constituted an act of denigration and parasitism, even though the competitor's name was not mentioned. The French Cour de Cassation held that the advertising depicted only a negative characteristic of a competitor's product, presented in conditions likely to discredit that product.

As far as Italian case law is concerned, the Italian Advertising Self-regulatory Jury held that the picture of a podium with different cosmetic products on different steps and the sentence "Have you ever wondered how effective your anti-wrinkle cream is?" represented an unlawful comparison if a robust claim substantiation test was missing.

Elena Carpani

She graduated in 1990 from the University of Milan and wrote her thesis on cultural sponsorship contracts. In the academic field, she also works with the Institute of Commercial and Industrial Law of the University of Verona. Co-operator of counsel, she is member of Bugnion Legal Department.



Disclosure of Community Designs

One out of the various angles

Fabio Angelini

Art. 6 of Directive 98/91 states that "a design shall be deemed to have been made available to the public if it has been published following registration or otherwise, or exhibited, used in trade or otherwise disclosed". What constitutes valid disclosure in today's world is still quite uncertain, which is also why EUIPO launched its CP10 to establish a common approach to examining evidence of prior art disclosed on the Internet. However, as the project is expected to last until the second quarter of 2020, in the meanwhile companies that file designs (and those that seek to invalidate designs) need to increase their attention to Internet disclosure. Indeed, the Court of Justice (CJEU) held in joined cases C-361/15 and C-405/15 that, as far as both novelty and individual character are concerned, the

type of product is irrelevant, because if an earlier product was disclosed to public, irrespective of the sector, it must be assumed that it is known. It follows



that the scope of prior art searches has been greatly enlarged and failure to pay proper attention to the Internet may be a fatal mistake.

Fabio Angelini

After a first experience in the late 80's as Chief of the Legal Secretary of the Central Inspectorate for Fraud Repression and subsequent Master of Laws (LLM) at the University of California at Berkeley, as well as admission to the New York Bar, he started in the mid 90's his IP-related activity with SIB, soon becoming a Partner thereof. In the second half of the 2000s he was in Silicon Valley with Intel Corporation, where, as Senior Attorney, he managed, among other things, some of Intel's most important brands worldwide, such as INTEL INSIDE and PENTIUM. He joined, as of Counsel, Bugnion in May 2018. He is also at WIPO Panelist and is frequently invited to speak at conferences and congresses of major IP organizations such as INTA, ECTA, Marques and AIPPI.



PEOPLE Profile

We are pleased to welcome Claude Nassif as the newest member of our patent team. Claude has been active in the IP field for over 18 years. His doctoral work was conducted at the University of California, Los Angeles (UCLA), where his studies focused on brain mapping of the fruit fly *Drosophila melanogaster* and cell-adhesion molecule dynamics during embryonic neurogenesis. After graduation, he joined prominent international law firms where he honed his patent prosecution skills by drafting and prosecuting varied patents for local universities, start-up companies as well as mid- and large national and international corporations.



Tasty, but not enough to be a work of art

What about copyrighted spices?

Alessandro Balduzzi

The Court of Justice of the EU recently ruled on a case concerning the possibility of claiming a copyright on the taste of a food product. The subject of the dispute was "Heksenkaas", a Dutch spreadable dip containing cream cheese and fresh herbs, whose IP rights had been transferred to Levola Hengelo BV. Claiming that a product called "Witte Wievenkaas" infringed its copyright in the taste of Heksenkaas, Levola brought proceedings against the manufacturer of the former before the Gelderland District Court, Netherlands.

specified which elements of the taste of Heksenkaas gave it its unique, original character and personal stamp.

This decision was appealed before the Regional Court of Appeal, Arnhem-Leeuwarden, Netherlands, which decided to stay the proceedings and refer a series of questions to the Court of Justice for a preliminary ruling concerning whether EU law precludes the taste of a food product being granted copyright protection.

In requesting the preliminary ruling, the referring court cited a divergence in the case-law of national supreme courts of the EU when it came to the question -

judgment of the Supreme Court of the Netherlands that accepted, in principle, the possibility of recognizing copyright in the scent of a perfume and a decision of the French Court of Cassation that categorically rejected the possibility of granting copyright protection to a scent. In examining the matter, the CJEU first took into consideration Directive 2001/29, noting that the directive does not leave it up to the laws of Member States to determine the meaning and scope of the concept of a "work", which must therefore have an autonomous and uniform interpretation throughout the EU.

The CJEU stated that the taste of a food product can be protected by copyright under Directive 2001/29 only if the two cumulative conditions for a certain subject matter to be classified as a "work" (set out by the directive itself and the relevant case-law on the matter) are satisfied. More precisely, the subject matter must (i) be original in the sense that it is the author's own intellectual creation; and (ii) be the expression of the author's own intellectual creation.

In addition to the above, the CJEU noted that, in light of the Berne Convention, copyright protection may be granted to expressions, but not to ideas.

On the basis of such considerations, the CJEU clarified that for there to be a "work", the subject matter protected by copyright must be expressed in a manner which makes it identifiable with sufficient precision and objectivity. According to the CJEU, identifying the subject matter of protection clearly and precisely is essential not only for the au-

thorities that must ensure the copyright protection, but also for economic operators, who must be able to discern the scope of the rights that third parties, especially competitors, enjoy.

However, the taste of a food product is identified essentially on the basis of taste sensations and experiences, which, unlike those determined by other types of work of art that possess a precise and objective form of expression, are subjective and variable since they depend, inter alia, on factors peculiar to the person tasting the product concerned.

Furthermore, the current state of scientific development does not allow a precise and objective identification of the taste of a food product by technical means, such as to enable it to be distinguished from the taste of other products of the same kind.

The CJEU hence concluded that the taste of a food product cannot be classified as a "work" within the meaning of Directive 2001/29. In consideration of the need for a uniform interpretation of the concept of a "work" throughout the EU, the CJEU also clarified that the directive prevents national legislation from being interpreted in such a way that it grants copyright protection to the taste of a food product.

Alessandro Balduzzi

After obtaining an honors degree in Law cum laude from the University of Bologna (Italy) and a Master of Laws (LLM) in "Intellectual Property" at King's College London (UK), Alessandro joined Costa-Creta Law Firm and Bugnion Legal in 2012, dealing mainly with Intellectual Property, Competition, Privacy and IT Law.



The court of first instance held that it was not necessary to rule on whether the taste of Heksenkaas was protectable under copyright law, given that Levola's claims had to be rejected since it had not

similar to the one concerning the possibility of copyrighting tastes - as to whether a scent may be protected by copyright. In particular, the referring court cited a