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Changing practices in a changing world

Donatella Prandin

When I started at Bugnion (too many years ago to mention), the world was really a different place and apart from what was imagined and depicted by futurist and sci-fi novelists, I do not think we really were conscious of the fact that the future was just round the corner.

Thanks to the Internet, our world has become exceedingly small and this has huge implications in our profession, as we are forced to deal with a different reality.

In the trademark world for instance, over the years, the strategy to protect a coffee shop was, after the searches had been completed, to enter the selected trademark in Class 35 of Nice Classification. The same coffee shop is now operated by an application for mobile phones identified by a fancy icon (protected in Class 9). Also, customers access to the services by a coffeeshop.com domain name which is now the best spot in the world for managing a coffee shop. Not to mention that each webpage – corresponding to an operating commercial web platform enabling customers to buy the product – has been recently subject to Design Protection (Locarno Class 32-00).

Counterfeiters are no longer in a physical market location but increasingly in the virtual (but so real) one.

The social networks' environment helps people to connect easily and allows IP rights owner to show who they are and what they do with a simple "click".

This easy communication system gives us a chance to rapidly show how smart we are, which great products or services we sell and enables us to have immediate positive feedback in terms of reputation, turnover, etc. globally. But how many hidden pitfalls and hazards lie behind this simple window. Many businesses still do not really realise how careful one must be when approaching the web. The world of laws is becoming ever larger, so it is becoming increasingly difficult not to get lost in the net of laws. Nowadays our expertise must be focused to new challenges and we have to direct our advice to strategies to defend our clients' rights and their image in a world of "Internet of Things", "Artificial Intelligence", "Blockchain", "Big Data", "Web influencer" and digital advertising. What's coming next?

Donatella Prandin

Graduated in Law from the University of Milan. Donatella joined Bugnion in 1991 where she started her career in the field of Intellectual Property. She assists Italian and International clients in all the aspects related to trademark management portfolio, including searches, contracts, opposition and legal opinions. Currently head the company's Foreign Department and the Milan office and partner of the firm. Donatella is a FICPI, INTA, PTMG, ECTA and AIPPI member.



50 Years of Us

Our firm throughout fifty years of outstanding challenges



Renata Righetti

Why are we all so fascinated by anniversaries? There is no special reason after all to celebrate one year in particular instead of the previous or the next one. But still, when the calendar shows that a certain date is approaching, a sort of automatic reaction is triggered and everyone perceives it as an opportunity to take stock, to remember, to celebrate, to adjust, to renovate and, obviously, to look ahead and to predict – imagine? – the future. It happens at a personal level, but it is quite common for almost all entities: enterprises, associations, teams, businesses, etc. Then... here I am, doing exactly what

everyone expects me to do. The first task, of course, is to celebrate: 'half a century' sounds very impressive and important in our part of the world and, certainly, it is the first reason to focus on such an "anniversary". In October 1968, my father opened an office in Milan, with just one secretary, a couple of desks and not a single client; the launch of Bugnion's adventure into the IP world in Italy. Nowadays, we are one of the largest and most respected IP firms in Europe, with more than 250 staff, fifteen offices and an impressive number of different size clients. This is something we can be proud of and a good reason to celebrate. But we are even more proud to have always been innovators, I would even say precursors.

We were the first, in our Country, to organise seminars and workshops, to publish newsletters and booklets, that attempted – using any means – to develop IP knowledge and understanding among SMEs, shifting the IP profession from its outdated, traditional attitude of a guild to a modern, interactive, business-oriented activity, that internally organises up-dating programs, uses a proprietary management software consolidating all professional and administrative needs of the firm and clients and constantly focuses on helping businesses build a consistent IP strategy. In short, Bugnion, from the very beginning, wished to be a real advisory consulting firm and business partner and not just an operational support. Even today, when apparently any

software-based provider presents itself as the best option for managing IP rights, we are convinced that the value of IP consultants lies in their intertwined strategic long-term support to businesses.

This brings me to thinking about the future. Every IP professional these days has difficulties in predicting what the profession will look like in the next – few! – years. Bugnion does not have a crystal ball but devotes a lot of time and effort to increasing efficiency, on the one hand, and to extending and expanding competencies also to neighbouring and related areas, like advertising, digital communication, labelling, IP evaluation, systematic innovation, and so forth, on the other. For the time being, this approach seems to be working, considering that our success has greatly exceeded our expectations.

We are very pleased to note that we are beginning to be recognised as good players and reliable partners internationally, too. Even if almost 90% of our activity is still on behalf of our domestic clients, the number of cases we receive from clients and colleagues in jurisdictions other than the EU, Italy and San Marino is significantly on the increase.

As I already mentioned, an anniversary is also an occasion for renewal. It was actually time to give our image a make-over, considering that our current logo dates back to our 30th Anniversary, which is to say, 20 years ago!

We decided to officially present our new logo, as well as our new website, in Seattle, at the INTA, by far the largest gathering of IP professionals and where we will be attending with twelve representatives.

What's in a logo? Anything anyone can detect, of course but, in our view, the new one should provide a more dynamic perception of our mission and of our relations with others.

Our initial, our "B", is no longer a plain capital letter extending out of a square. Now the "B" is lowercase and almost contained within a square but hardly detectable as a "B" and much more recognisable as a path, a road, a route and a journey we are ready and willingly to take with our own partners and colleagues, our clients, our associates, our shareholders. Once again, the idea of "together" that has always been our peculiar trait is foremost. And the new pay off? "The way to". It's in line with the idea of a journey to be undertaken and the final destination has not been mentioned because "Chacun son chemin", (Each his own path). Ambitious? Yes! As we've always been.

Last but – definitely – not least, an Anniversary is an opportu- ➔ **page 2**

One step after another

Seasons of worldwide achievements

Ezio Bianciardi

It was around springtime in 1988 and I was about to take my Italian patent attorney finals; I was really green, definitely inexperienced, and my older colleagues did their very best to help me prepare for the exams, for successfully drafting an Italian patent application in the best possible way in order to pass the exam that was rapidly approaching. Looking back, they were great times, especially because – as Ing. Righetti always said – I was starting to understand the difference, with relative ease, between a patent and an elephant, although I was increasingly drawn towards a certain organisation of European States, created just a few years earlier. It had the task of making a uniform procedure available to citizens and enterprises of the European

nations which had adopted its convention, allowing patent applications to be admitted and examined and patents to be granted. Back then, thirteen countries had acceded to the convention, today, they are 40 and still others will be joining. I was so fascinated and almost nearly seduced by this organisation that, at the start of 2000, specifically in November 2005, I set off for Munich with the support and endorsement of Bugnion which, like dutiful parents, encouraged their children to exploit their inclinations to the best of their ability. This time I was not leaving to attend meetings with examiners but to search for a German partner, for setting out on that wonderful adventure which saw us engaged in opening an office in that city, where the organisation was headquartered. Since then, much water has flowed under the bridge and,

in October 2016, we celebrated our 10 years of operations in Munich, moving into a new, bigger and fantastic location! Today, two German and European patent attorneys, two German and Italian lawyers and two secretaries work at the Munich office.

The numbers explain the project's success: over 200 Notices of Opposition filed, more than 60 Appeals lodged, and we have been part of around 150 Oral Proceedings, with a great number of our clients using this service. The results: approximately 40% of the European patents attacked was revoked, 46% was restricted and rendered inoffensive! In 2014, riding the crest of this success, we expanded our horizons looking Eastwards, specifically, towards China and Japan, seeking to offer our services there. In 2017, we formed a NewCo with an important Japanese firm, with which we are already working, servicing new clients deploying our experience accrued over the years at the European Patent Office.

Myself and a few of the closest colleagues and co-workers spend at least one or two weeks a month at the Munich office. We had the goal of creating one of the many outstanding areas of superiority of which Bugnion may be proud. Well, then! Today we can say that we really did well, and it's not over yet

Ezio Bianciardi

Has worked in the Bologna-based Bugnion office since 1986 where he has acquired wide-ranging expertise in patents, first and foremost applied to the following categories: machine automation, packing and packaging equipment, metallic alloy moulding, electric and electronic power equipment for industrial applications, besides computer-aided search. Head of the Bologna-based office since 2014. He had sat on the company's board of directors since 2006 to 2015.



The Italian PTO: a year in review

The Office's last developments. Building a consistent practice

Simone Verducci Galletti

UIBM has taken significant steps towards introducing improvements over the past 10 years. Over the last year UIBM has been engaged in implementing a new, more complete database for Trademarks: the traditional database, active for the past decade, has now been twinned with a modern database, which is still being implemented. The adoption of a new e-filing system (some years ago) generated a different numbering system for all the trademarks. Italian trademarks have now a 15-digit number: the UIBM has provided a conversion table that allows rights holders to amend and add prior registration numbers in the present system. This number allocated to applications will no longer change upon registration as in the past (when registered application received a different registration number). Over the last two years,

increased possibilities for online activities have been implemented and this has led to significant streamlining in the time taken to register recordal applications. Obtaining confirmation of a registered change of ownership or name record now takes only a few weeks. The dematerialisation of registration certificates, now an electronically signed PDF document, reduces the grant time for renewals (a few months) and the registration time for non-opposed marks (12 to 15 months from filing). With regard to the examination procedure, the UIBM has finally implemented protection for sales services in Class 35. In 2017, a dispute arose between rights holders and the UIBM on the protection of sales services. UIBM, in fact, in early 2017, suddenly began to issue refusals relating to the protection of these services in Class 35, with doubts related not only to the formulation of the specification but also to the real protectability of sales

services in the class. In December 2017, the UIBM stated that it “will proceed with the registration of the trademark applications intending to protect the sales services, to be understood as services related to wholesale or retail selling, with the clear specification of the types of products related to said services...”. The announcement targets an issue that was already resolved in much of the European Union and in a way (a simple notification) that emphasises that the aim to minimise bureaucracy is among the UIBM’s priority guidelines.

Simone Verducci Galletti

Graduated in Law from the University of Perugia he qualified as Trade Mark Attorney in 2008 and since 2012 is International Affairs Manager of Bugnion. As Trade Mark Attorney Simone has substantive experience in the field of Italian and Community trade mark filing and prosecution. He enjoys advising clients in the management and filing strategy of trade mark portfolios. Simone is Partner of the firm. He takes care of the network of Bugnion associates supervising associate selection. Simone also leads the International business development group.



Last findings of the General Court

‘Apparatus for reproduction of sound and images’ not sufficiently precise and narrow



Vincenzo Melilli

In Case T-879/16, Sony Interactive Entertainment Europe v EUIPO, the General Court has considered whether the term ‘apparatus for the reproduction of sound and images’ was sufficiently precise and narrow, and whether proof of use had been adduced for such goods. The Cancellation Division dismissed the application for revocation for the following goods: “loudspeakers, loudspeaker systems, sound amplifiers” and “computers, video screens, apparatus for the reproduction of sound and images, television sets, record players”. The Second Board of Appeal of the EUIPO upheld the decision, finding that the mark had been put to genuine use in connection with the abovementioned goods in Class 9. However, in its judgment of 10 December 2015, Sony Computer Entertainment Europe v OHIM (Case T-690/14), the General Court found that, contrary to what was stated by the Board of Appeal, it could not be held that the term ‘apparatus for the reproduction of sound and images’ had been defined

sufficiently “precisely and narrowly”. The action was referred back to the Fourth Board of Appeal (Case R-1010/2016-4). In summary, Sony applied to the General Court to annul the decision of the Board of Appeal, while the EUIPO contended that the court should dismiss the action and uphold the Board of Appeal’s findings. The General Court found at Paragraph 33 that: “as regards ‘apparatus for the reproduction of sound and images’, it is apparent from Paragraphs 63 to 68 of [the judgment of 10 December 2015] that [such a] term did not designate a precise and narrowly-defined category of goods, as stated by the Board of Appeal in Paragraph 46 of the first decision, but a large category of audiovisual and electronic equipment. Therefore, [...] the proof of genuine use of the contested mark had not been adduced for that equipment.” Although the decision is based on Article 65(6) of Regulation 207/2009 and the Board of Appeal failed to comply with the “operative” part of the judg-

ment or the reasoning of the General Court which led to it, the main issue highlighted in this decision concerns the requirement for clarity in the description of goods.



Vincenzo Melilli

Vincenzo Melilli is an European trademark and design attorney. Graduated from the Catholic Law School of Milan and obtained his LL.M. 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 Intellectual Property Office sub-committee, he focuses on trademark and design matters. Mr Melilli also lectures on trademark and design law – as well as comparative IP strategies – at universities.

Amazon and Facebook Monitoring Tools. For free

How new platforms help our strategies

Paolo Di Mella

As is well known, all Internet Service Providers (hereinafter “ISPs”) including social media (such as Twitter or Facebook), search engines (Google first and foremost) and e-commerce sites (from eBay to Amazon) have adopted procedures enabling owners of intellectual property rights (in particular trademarks and copyrights) to report abuses or infringements of their exclusive rights committed by online users. On receiving such notices, the providers can take down the infringing content, or else reject the request if they judge it to be unfounded. In this manner, ISPs protect themselves against the risk of being involved in legal actions together with their customers and secure themselves a “safe harbour”, i.e. exemption from liability, under certain conditions, guaranteed to ISPs under U.S. and European law. Some ISPs, among which AMAZON and FACEBOOK, have implemented tools that allow owners of IP rights to monitor their websites, in addition to notifying them of infringements. In particular, AMAZON has launched a tool called “Brand Registry”, via which trademark owners may monitor the Amazon marketplace through a search for text and images and thereby detect counterfeit goods and infringements of their copyrights, or unauthorised uses of their trademark. Through this tool, it is also possible to check how the original products are featured on the website, in particular, by verifying the product name, descriptions and images so as to become aware of acts of unfair competition. A similar monitoring system called “Commerce & Ads IP Tool” has been created by FACEBOOK. This tool provides registered users – trademark owners – with a platform featuring filters and search modes that allow them to narrow the scope of the search to the content they intend to analyse. Once they have identified fraudulent use of a trademark or copyright abuse committed by Facebook users in their ads, they can directly notify Facebook of the unlawful content. Both monitoring platforms are accessible only to users in possession of registered marks. Therefore, it is not enough to be holders of a simple “de facto” or “common law” right. The Amazon platform accepts only marks registered in certain jurisdictions, including Italy and the European Union, whereas no territorial limit seems to be provided for the tool offered by Facebook. Until very recently, in order to be eligible for the Amazon “Brand Registry”, the trademarks had to be registered in the form of word marks, while figurative ones were not taken into consideration. This limit seems to still exist in the case of the Facebook “Commerce & Ads IP Tool”. In any case, beyond this “entry barrier” established for these monitoring tools, ISPs that receive notices of infringements of a figurative mark appear to be more reluctant and slower to accept complaints compared to notices regarding the infringement of word marks. For this reason, it is recommended that owners also protect the word version of their marks (provided of course that the word elements have distinctive character). Another limit of Facebook’s tool is the fact that only the brand owners, and not



their representatives, can access the platform in question, a limit that appears to exist also for the Amazon “Brand Registry”.

In conclusion, we feel that for companies truly concerned about defending their IP rights on the Internet but not ready to launch more structured and systematic watch services, these monitoring tools offered free of charge by ISPs may undoubtedly turn out to be very useful for taking down the most significant cases of infringement.

Paolo Di Mella

Graduated in Law. After doing his national service as officer in the Army, he has spent three years with a medium-sized business first and, subsequently, with a multi-national corporation. He joined Bugnion in 2000 and works in the trademark division of the Bologna-based office. He is also the person in charge of Internet Department of the Firm.



Slogans in the EU

Basics on how to approach the matter

Alberto Pelosi

The Oxford Dictionary of English defines a slogan as: “a short and striking or memorable phrase used in advertising”. Slogans mainly have an advertising function. However, like any other types of sign, slogans can also have the capacity to function as an indication of the commercial origin of goods and/or services. Specifically, they are deemed to be distinctive whenever the relevant public perceives them as more than a mere promotional/laudatory message which exalts the characteristic of the goods or services. In fact, as stated in the decision of the General Court (Case T-216/14) advertising slogans shall be considered as having distinctive character if, apart from their promotional function, the public perceives them as an indication of the commercial origin of the goods or services. According to European practice, this is the case when a slogan possesses a certain originality and conceptual intrigue that

triggers in the minds of the relevant public a cognitive process or requires an interpretative effort. In line with the above, the guidelines for examination of EUTMs stated that: “a slogan whose meaning is vague or impenetrable or whose interpretation requires considerable mental effort on the part of the relevant consumers is also likely to be distinctive since consumers would not be able to establish a clear and direct link with the goods and services for which the trademark is protected”.

NOW YOU KNOW (rejected for services in class 41 since the consumer will understand that by using the services or watching the seminars they will soon acquire knowledge of) something more on the European criteria for assessing the distinctive character of slogans so DON’T CRACK UNDER PRESSURE (accepted for software).

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.



From the first page - Renata Righetti 50 Years of Us

nity to say thank you. First of all, a big, huge, grateful thankyou to our team of people, to all the women and men that for over 50 years have devoted their intelligence, their competence, their time, their efforts, their creativity to Bugnion and allowed it to become the great firm it is today. Many thanks obviously to our clients:

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.



to those who trusted us when we were very young and small and who were often so pleased with our services that they passed our name on to their acquaintances and to those who have joined us over the years. Thank you especially to those who have requested additional services or suggested improvements we were very happy to implement. Again, when a relationship is strong and gratifying, all parties can improve together and attain greater goals. And thank you to all our international associates with whom we have been working together.

To those we have known and have worked with for many years – sometimes over two or three generations – and to those we have met more recently and with whom we have established very good relations and started working on interesting common projects. Finally, as this article will be published in our International journal, on a personal note, I wish to share my strong belief that we, IP professionals, are very privileged to interact and work with colleagues from all over the world and have respect for each other despite our differences.

The era of ICOs and DAICOs

Developments on blockchain and cryptocurrencies



Simone Milli

We are witnessing a new phenomenon, unprecedented and revolutionary, which creates a direct bridge between a new company being formed and the investors, without any intermediary, for the development of new IT-based businesses. We are talking about ICOs (initial coin offering), i.e. the mechanism that involves IT enterprises – generally blockchain-based companies – which issue “tokens”, or “cryptocurrency”, used in their business and which offer tokens to their investors. A “token” is simply a “digital coin” that is generally linked to the enterprise’s business in some way or is actively used in the business with a precise technical operating purpose. Therefore, tokens are “digital coins”, held in electronic form in special digital wallets and whose transfer among owners is simultaneously registered and authorised by a blockchain-based IT system (i.e. a publicly verifiable system guaranteed by cryptographic algorithms or “consent” of the majority), for ensuring certainty of ownership vis-à-vis third parties. In ICOs, tokens are initially offered at a pre-selling stage to potential, interested investors at prices serving as an incentive to purchase (a bonus is usually granted to “early investors”). Then, subsequently, the tokens enter the market and they are traded amongst investors. An example of a successful start-up may certainly be identified in ETHEREUM (ETC and ETH), which aims to make a BLOCKCHAIN-based technology available, for implementing the creation of tokens in it and/or the launch of ICOs. Certainly, it is true that, for the time being, the ETHEREUM platform is the mother of most outstanding tokens, but there are also other blockchain-based platforms, on which it is possible to launch ICOs, i.e. create tokens, which may be sold to potential, interested

investors. And, indeed, it is quite amazing the amount of capital which is raised (sometimes in just a few hours) by these start-ups through issuing tokens. In synthesis, the ICO system allows a start-up to access a form of capital without any intermediation, coming directly into contact with the end investors purchasing the tokens. And the financing for the enterprise may indeed be long-term. In fact, the enterprise does not generally sell all tokens initially but retains a certain percentage in its portfolio, for reselling them and financing itself later. It goes without saying that, if the project “takes off”, the token acquires value and the enterprise may thus resell its retained tokens at a higher value, financing itself with ready cash over time. In the Intellectual Property sector, through the ICO mechanism, for example, PO.ET was created, a blockchain-based platform for registering digital creative content created by an author (proving its dating and paternity) on the blockchain, and which will also allow, among other things, automation of all licensing steps, including paying royalties. As you can imagine, the ICO era has just commenced and the projects which will use this development method will be increasingly more numerous. It also goes without saying that the vigilant eye of the legislator will need to guarantee and create the necessary legislative mechanisms for ensuring the correct quality of start-ups launched via the ICO model, primarily preventing frauds affecting investors. And it will not just be the legislator that will be ensuring correct quality of the start-ups launched through the ICO mechanism: if the era of the ICOs has just begun, the DAICO technological era has yet to commence. A DAICO is nothing other than an ICO, but in which the investor has greater decision-making power and, above all, the power to withdraw funds paid into

the enterprise in the event of the start-up misusing the funds. The recent concept of DAICOs is the brainchild of Vitalik Buterin, founder of the famous “DAO”, which aims to supersede the ICO model, in which the investor is not directly involved in decision-making. Vitalik Buterin has reformulated the idea of ICOs on the basis of the decentralized autonomous organization (“DAO”) model. Needless to say, the heart of a DAICO could only be a smart contract which guarantees, through the basic blockchain, the necessary features for voting, withdrawing funds and making fund contributions to projects under development by token holders. All this enabling direct “digital” decisions to be taken by token holders. Are DAICOs going to be the next advanced investment and “digital” decision-making model? Probably, yes; it will certainly be interesting to watch this technology business management model in use.

Simone Milli

Graduated in Business Engineering from the Università degli Studi of Pisa in 2005. Research thesis at the Department of Mechanic Engineering of Pisa (monitoring the status of tools in milling operations). Between 2005 and 2008 researcher at Marposh SpA where he dealt with measurement sensors experimentation and optical design of measuring devices. Between May 2008 through November 2009 he has worked for an industrial property consulting firm of Bologna where he was in charge of drafting patent applications and consultancy. He joined the Bologna-based office of Bugnion in November 2009. He is member of Internet Department of the Firm.



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Expansion of Early Certainty

EPO seeking speeding up the patent-granting process

Cristina Biggi

“Early Certainty” is the title being given to a number of initiatives undertaken by the European Patent Office for speeding up the patent-granting process and for meeting the needs of users for greater certainty and timeliness in their patent applications. Notably, EPO pre- and post-grant proceedings can be slow and, frequently, cases may lie dormant at the EPO for several years. This can be an issue when the application concerns a rapidly changing technical field with short product cycles. The first measure to be implemented was the “Early Certainty from Search (ECfS)” which was introduced in July 2014, with the aim of accelerating the search phase and providing a high-quality search report with a preliminary written opinion on

Goal	Actual*	Progress
6 months search period within months	4.9 months	Goal accomplished!
12 months average examination months	22.6 months	Gradual improvement – volumes are a challenge
15 months standard opposition months	23.7 months	Rapid improvement due to streamlined procedure

* September 2017
European Patent Office

patentability within six months of filing. This objective was accomplished in 2016 and, following this success, the EPO has undertaken the expansion of Early Certainty by extending it to the examination and opposition stages. This response to users’ call for greater efficiency and timeliness for the overall procedure should result in significant improvements to these services. The procedure for requesting examination of a European patent application provides that applicants can file a request up to 6 months after the European Patent Bulletin mentions publication of the search report. Currently, this examination phase lasts 22.6 months on average, which is generally considered too long a period. For this reason, by 2020, the EPO aims to reduce the aforementioned timescale to 12 months after the

and complicated cases. The principal features of the new procedure aim at reducing time to the first instance decision. Previously, patent proprietors had 4 months to reply to an opposition notice, with a two-month extension available upon request and additional further extensions. With the new Early Certainty initiative, extensions will be available only in “exceptional cases”. Moreover, the patent proprietors will now have 4 months to arrange their response with evidence to the opposition. In conclusion, accelerating the patent-granting procedure with the Early Certainty initiatives seems to be the right solution for applicants who want their patents granted quickly and want to exploit their inventions before the technology becomes outdated. The same also applies to patentees and opponents who may be waiting for the outcome of opposition proceedings for deciding on a business strategy. Unquestionably, faster decisions will increase the legal certainty not only for proceedings before the EPO but also for infringement proceedings in domestic jurisdictions. On the other hand, not all users have the same interest in accelerating the patent-granting process. For example, they may wish to delay moving the process forward until they know the outcome of examination in another country or they may be waiting for agreement on a funding or licensing matter. Furthermore, the meaning of “straightforward” opposition and “exceptional circumstances” is not clear, and it seems that the EPO will judge each request for a time-extension on its individual merits. Another questionable point is whether this policy is fair for patentees, since opponents have 9 months to prepare and file an opposition, while patentees now only have 4 months to respond. Moreover, these changes only deal with the first instance part of the opposition process leaving the appeal procedures intact, which have significant potential for creating delay.



start of the examination procedure. The opposition procedure is a post-grant, inter partes (proprietor vs one or more opponents) procedure which comprises a first instance before a panel of three examiners and, if necessary, a second instance (appeal) before a technical board of appeal. The term for filing an opposition is nine months from publication of the mention of grant of the European patent. All adverse decisions taken by the opposition division may be appealed within 2 months from the date of notification of the opposition decision. For simplifying and reducing the length of “straightforward” opposition proceedings, the EPO introduced the “Early Certainty from Opposition”, with the aim of reducing the average time for a decision for a standard case to within 15 months. The EPO also guaranteed that it would maintain a certain flexibility in allowing longer timelines if necessary, for taking into account the post-filing of data

Cristina Biggi

PhD of chemistry from University of Milan. Qualified as European and Italian Patent and Design Attorney.

In 13+ years of practice, she has filed and prosecuted hundreds of cases before the EPO, WIPO and the Italian PTO, including opposition and appeal procedures at the EPO. Cristina’s technical expertise is polymers, novel pharmaceutical compounds and their use, novel cosmetic and pharmaceutical compositions and formulations, biomaterials for medical use, diagnostic and therapeutic methods, textiles, electrochemical cells, nanotechnology, chemical processes, food chemistry, microorganisms and their use and biotechnology. She heads the Chemistry and Life Science Patent Group of Bugnion since 2011 and has become partner of the firm in 2017.



Congratulations Japanese desk, you're two years old!

Again, on expansion from the Asian side

Simone Verducci Galletti

When, less than 3 years ago, as part of Bugnion's international development plans, we set out to start a small Japanese project, we could not have imagined that we would be where we are today. We had no partners, no Japanese Patent Attorneys working with us and no staff with Japanese language skills. The venture was perhaps crazy and yet, in our own way, with a lot of commitment and a generous dose of enthusiasm, we managed to build one of the most interesting success stories of our recent history: the Bugnion Japanese Desk. The initial idea was to offer our domestic clients a valid support in the difficult Japanese scenario, but opportunity to be involved with Japan so closely has allowed us to convert the project into a useful opening for cultural exchange and

mutual enrichment, both professional and human. In these two, we have found a reliable partner in Osaka who has believed in our capabilities not only from the technical and legal standpoint, but also as business developers. We have made 8 trips to Japan, bringing three partners and various associates to meet colleagues, clients and experience Japanese culture, holding numerous seminars at the offices of Japanese clients and institutions on IP matters. Today, our office in Bologna is staffed by a Japanese Attorney (Takeharu Miyagaki) seconded from our partners in Osaka, who offers assistance to Italian clients and, above all, a safe harbour for our Japanese clients. Today, we assist several Japanese corporations both directly from Japan and their subsidiaries in Italy and Europe and we are dependable partners for Japanese clients,



Takeharu Miyagaki

ts, especially those having R&D centres in Europe. The activity of Takeharu (now an adoptive Italian and connoisseur of wine and Bolognese cuisine) has been almost permanently supported by the activities of Alessandro Cossu, former EPO examiner with substantial experience in patents of Japanese origin, and other professionals from the Milan and Bologna offices (including Lucia Vittorangeli, Simone Milli and Marco Conti) for ensuring full coverage of the technical fields of interest.

Trademarks and mozzarella cheese containers

A question of shape. Views on functionality for packaging

Nicoletta Colombo

Can a shape of a mozzarella cheese container be considered a distinctive trademark? The Court of Milan has been requested to evaluate if a certain packaging of a dairy product – mozzarella – could be considered as a de facto shape mark and, consequently, condemn the producer and the retailer, which was distributing such product, for trademark infringement as well as for unfair competition. The Court, in the decision delivered in December 2017, admitting the arguments of the defendants, dismissed the plaintiff's claims, holding that the container shape could not be considered a valid trade mark because its shape was:

- functional to containing a mozzarella cheese, which has a spherical shape like the container, with its liquid



- not distinctive because its spherical shape is standard for such products. In this decision, the Court upheld that a pu-

rely functional packaging, that duly fulfils its technical purpose, is not sufficient for being considered a shape trade mark which instead requires some distinctive identifying element.



Nicoletta Colombo

Nicoletta started to practice in 1990 and became partner of Caneva e Associati in 2009. Besides dealing with general legal advice assisting clients in judicial, extra-judicial and arbitral cases in Italy and abroad, Nicoletta has considerable experience in intellectual property matters, in particular those dedicated to internet related issues, including the protection of domain names, onli-

Influencers and bloggers for trademark advertising

Better than the Star Wars lightsaber!

Valentina Gazzarri - Elisabetta Guolo

In a market full of qualitatively homogeneous products, the role of marks and the values they embody (i.e. brand identity) is essential. The tendency is to transmit the brand identity also through influencers or bloggers who have positive image and reputation (e.g. trendsetters). The influencer 'Army' is indeed a powerful mean through which new market shares may be conquered. The product placement makes influencers collect 'likes' on social networks and web pages. This kind of advertising is a weapon as efficient as the Star Wars lightsaber, capable of cutting through any obstacle to communication. However, like any weapon...even the lightsaber is a double-edged sword! Indeed, it is common for third-party rights to be infringed through influencer marketing. According to the Italian Copyright Law, the portrait of a person may be reproduced only with the consent of the latter. Moreover, pursuant to this Law, the photographer is the owner of moral and economical copyrights on the picture he took. Furthermore, the image could constitute personal data, which, as such, is protected by Italian Data Protection Law.



However, it often happens that trademark owners disseminate images showing the influencer, without permission either from the latter or the photographer. Frequently, influencers include third-party brands other than those officially sponsored (e.g. accessories under third-party trademark/design, perfectly recognisable). This unauthorised use infringes third parties' exclusive rights and may give rise to a risk of confusion for the consumer, who could wrongly consider

all the goods displayed as sold by the owner of the main trademark or by a company economically linked to it. This risk is often increased by the comments left by the Internet users about the image, out of the brand owner's control. Finally, this unapproved use may constitute unfair competition, sanctioned by the Italian Civil Code, when it consents the brand owner to illegitimately exploit third parties' trademark/design reputation. It is also important that the trademark owner carefully chooses the influencer from the point of view of his marketing strategy. It is equally important to verify the correctness of the influencer's conduct from a legal standpoint, in relation not only to other traders but also to consumers, who are the recipients of this communication. In fact, any commercial communication made by an influencer through an endorsement of a brand needs to take into account the rules on unfair commercial practices. Therefore, the advice to trademark owners is to regulate this aspect contractually, forcing the testimonial to respect the law, in regard to both advertising and unfair commercial practices. The promotional purpose of all content distributed through social media should be clearly recognisable by

Proof rests solely on the Opponent

Licensees and evidence of their entitlement.

Alessandro Mannini

Case T-235/16 (GP Joule PV GmbH & Co KG v EU Intellectual Property Office (EUIPO)) In its judgment of 21 June 2017, in Case T-235/16, the EU General Court distinguished clearly between the licensee's obligation to file timely evidence of its entitlement to oppose a EUTM Application under Rule 19(2) of Regulation 2868/95 and the separate determination of admissibility of the opposition by the EUIPO under Rule 15(2)(h)(iii) of the same Regulation. Opposition No. 002353616 (GP JOULE/GP-Tech) was dismissed as "unfounded" under Rule 20(1), given that the licensee had not submitted proof of its entitlement to file a notice of opposition against the EUTM. The decision was upheld on appeal and the case brought before the EU General Court. The Opponent's main claim was that the EUIPO misapplied Rule 17(4) of the Regulation having failed to invite it to prove its entitlement at the outset of the proceedings, but incorrectly misleading it on the matter by sending correspondence to the parties suggesting the opposition was "admissible" under Rule 15(2)(h)(iii). The Court notes that the opposition was dismissed on the ground of being "unfounded", and not "inadmissible" and that examination of these two principles is independent. It remarks that the Opposition Division allows the opponent to file evidence of its entitlement also at a later stage, after the inter partes stage of the proceedings has commenced, not only be-

fore admissibility is assessed. Also, Rule 20(6) states that: "in no case shall [the EUIPO] be required to inform the parties which facts or evidence could be or have not been submitted". Accordingly, the plea alleging misapplication of Rule 17(4) cannot lead to the annulment of the contested decision, since the opposition was dismissed as unfounded and not as inadmissible, for lack of evidence concerning the applicant's entitlement to file the notice of opposition.



Alessandro Mannini

Master's Course in Environmental Sciences at the University of London; Industrial Property course at the WIPO of Geneva. Alessandro joined Bugnion in 2005 after a 15-year collaboration with a patent and trademark consultancy company. Alessandro is head of the Firenze-based office, where he enjoys advising clients in the management and filing strategy of trademark portfolios. Chair of INTA's Subcommittee for European National Trademark Offices Practices (2013-2015). INTA Legislation and Regulation Committee – Europe and Central Asia Subcommittee (2016 -).

ne counterfeiting, the protection of industrial property rights on the web and e-commerce. She also gives advice on patents, designs, trademarks, strengthening the rights of industrial property, commercial contracts, acts of counterfeiting and labelling in general. In January 2015 Studio Caneva Associati merges with CRW and MRA founding CREA Avvocati Associati. Co-operator of counsel of Bugnion.

inserting specific warning tags, such as, for example, #sponsored, #advertising, or, in the case of supply of the goods, even if free of charge, #productgivenby. It may also happen that the chosen influencer communicates the features of the promoted product in an incorrect manner with respect to the rules of the Consumer Code, through misleading communication. However, although it is difficult for the legal system to keep up with new forms of advertising communication, and the Authorities' capability for monitoring is not sufficient, this phenomenon is targeted not only by the AGCM (Italian Competition Authority) but also by the IAP (Italy's Advertising Standards Authority) and CODACONS (Italian Consumers Association). The question is: what are the consequences for brands? Our opinion is that the Authorities could involve the owners of the trademarks being advertised in the first instance, who might have to demonstrate that they have asked the influencing party to commit to complying with all the rules mentioned above. What better proof than an agreement signed by the parties? Otherwise, monetary fines of up to €5 million by the AGCM could also be imposed on trademark owners. All that remains to be done, is to contact a qualified firm for advice and explanation about influencer marketing.



Valentina Gazzarri

She has worked as trainee in the Intellectual Property Department of a Milan-based international firm and in 2014 she became

lawyer.

Before joining Bugnion in 2015, she has worked as intern in the brand protection department of an important Italian luxury fashion brand, in Shanghai, China.



Elisabetta Guolo

She worked as a trainee for leading law firms in Ferrara and afterwards in the legal department of top-ranking Italian Mass Market

Retailers, Discount Retailers and HoReCa suppliers. She is specialized in Food and Agribusiness Law as well as IP law and she is currently a member of Bugnion's Agri-food Team.

PEOPLE profile

We are very pleased to announce that Fabio Angelini has joined us. Who is Fabio Angelini is easy to tell. Ip lawyer and consultant for almost three decades, in house counsel for Intel Corporation handling a variety of trademark portfolios. He is involved in a vast range IP international organizations and known as one of the best IP attorneys in the EU also mentioned by Who's Who Legal, The World's Leading Trademark Professionals and Global IP Stars. Welcome Fabio!



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19/24 May 2018

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9 June 2018

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