

*Comment on the differences between certain
aspects of US and EU trademark law*

Ms. Simona Lavagnini
Partner at LGV Avvocati

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Trademark law and freedom of expression

Art. 21 of the Italian Constitution

Anyone has the right to freely express their thoughts in speech, writing, or any other form of communication. The press may not be subjected to any authorization or censorship. [...] Publications, performances, and other exhibits offensive to public morality shall be prohibited. Measures of preventive and repressive measure against such violations shall be established by law.

Art. 10 European Convention of Human Rights

1. Everyone has the right to freedom of expression. This right shall include freedom to hold opinions and to receive and impart information and ideas without interference by public authority and regardless of frontiers. This Article shall not prevent States from requiring the licensing of broadcasting, television or cinema enterprises. 2. The exercise of these freedoms, since it carries with it duties and responsibilities, may be subject to such formalities, conditions, restrictions or penalties as are prescribed by law and are necessary in a democratic society, in the interests of national security, territorial integrity or public safety, for the prevention of disorder or crime, for the protection of health or morals, for the protection of the reputation or rights of others, for preventing the disclosure of information received in confidence, or for maintaining the authority and impartiality of the judiciary.

Italian Industrial Property Code (IPC)

1. The following cannot be registered as trademarks:

*a) signs that are contrary to law, public order or morals;
[...]*

*2. A trademark loses its quality to act as such:
[...]*

b) if it has become contrary to law, public order or accepted principles of morality



The same does not apply to copyright and works of art.

Trademark: traditionally an indicator of origin, acquires broad communication functions (attractive functions).

However it remains commercial communication AND represents a potential unlimited monopoly.

EVOLUTION

a) Using the mark as an instrument for criticism:

- criticism and parody of businesses and society at large:
 - (i) «Barbie Girl» (USA);
 - (ii) «Esso» (France).

Compare



Copyright:

- public order and accepted morals have a different relevance and impact;
- works are frequently satirical or parodic («Go follow your clit»);

THEREFORE

- in EU, mark not considered means of expression on the same level as works protected by copyright.

b) The mark itself is «the criticism»:

- the mark is satirical or parodic;
- US hypothesis (baked by a negro, dumb blonde, party with sluts, dykes on bykes).

Convergence between intellectual property rights

Relationship between
trademarks and copyright

Fedez and «POP-
HOOLISTA» Case (Music
album cover)



Trademarks and preclusion

- in the US *B&B Hardware Inc. v. Harris Industries*;
- the reasoning is to avoid wasting the parties' resources, the judge time, the resources of the society (court costs), and provide legal certainty;
- results in prevailing value of first decision, also between opposition and civil court proceedings, when the ordinary elements of issue preclusion are met and the usages adjudicated are materially the same.

Preclusion also exists in the Italian legal system:

- formal preclusion;
- substantive preclusion;
- conflicts between final judgments.

Similar issues are not fully regulated under EU laws

Betty Boop case:

An example of the boundaries between trademarks and
copyright

Starts in US:
4 decisions
conclude there is
no copyright and
US trademark
registration
cannot prevent
decorative use of
the character
(copyright use)



Meanwhile, after 1° US
decision, in Italy:

- case no. 1 and case
no. 2 start in 2010
(relating to
Community TM and
national TM –
identical to US TM);
proceedings last 5/6
years
- In 2015 Italian court
decides against the
TM owner and
considers English
decision not relevant.



Meanwhile, in UK:

- Proceedings start in 2013, *after*
proceedings in Italy;
- Conflict raised by defendant at
a late stage
- High Court takes decision in
favor of TM owner in 2014
notwithstanding pending
Italian proceedings and
qualified as cross border ,
however excluding Italian
jurisdiction

Thank you.



Ms. Simona Lavagnini

LGV Avvocati

Via Privata C.Battisti 2
20122 Milano

tel +39 02 54 06 97 1

fax +39 02 54 06 97 30

www.lgvavvocati.it