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Revenge of the Pink Panther: stuffed animal toys can infringe 2D trademark

On March 4 2015 the Criminal Division of the Court of Cassation issued its decision in *Metro-Goldwin-Mayer v Iervolino*. The court held that a three-dimensional (3D) reproduction of a two-dimensional (2D) trademark constituted trademark infringement. The ruling is expected to harmonize earlier conflicting decisions on this issue.

Facts

An action was brought against Carmine Iervolino for trademark infringement and unauthorized placement on the Italian market of 21,822 stuffed animal toys depicting the Pink Panther character, which was protected by 2D trademark registrations held by Metro-Goldwyn-Mayer (MGM).

The Naples Court of Appeal agreed that trademark infringement existed, although it also found that an order for the defendant to pay a fine was time barred under Articles 473 to 474 of the Criminal Code, which require a criminal action to be concluded within a certain period.

Iervolino disagreed with the finding of trademark infringement and appealed the decision to the Court of Cassation, Criminal Division II, on the grounds that the lower courts had misapplied Articles 473 to 474 and 507 of the Criminal Code. Iervolino argued that the criminal offences cited in Articles 473 (counterfeiting, alteration or use of trademarks or distinctive signs) and 474 (introduction into the country and sale of goods bearing counterfeit signs) were not applicable. In particular, he asserted that even though the toys depicted the Pink Panther character, these provisions did not apply because the stuffed toys were 3D and did not include the words 'Pink Panther' or any other element of MGM's 2D trademarks.

Iervolino argued that 2D trademarks and 3D trademarks are inherently different. In fact, Iervolino pointed out that MGM could have applied for 3D trademarks, which would have been of questionable validity, since shapes corresponding to the nature of a product are not registrable under Italian law. In any event, Iervolino concluded that his Pink Panther 3D toys, sold without a label referencing the words 'Pink Panther', did not constitute infringement.

At a hearing on November 4 2014 the Court of Cassation, Criminal Division II, referred the matter to the Criminal Division of the Court of Cassation in joint sessions in order to resolve the conflict in previous case law.

Decision

The decision of the Court of Cassation in joint sessions considered whether infringement exists when goods representing fantasy characters are marketed without reference to a word mark or symbol of the rights holder.

The court held that the reproduction of a fantasy character protected by a registered trademark constitutes infringement that is punishable under Article 474 of the Criminal Code when the illegal conduct creates an objective and unequivocal likelihood of confusion between images that could mislead consumers as to the origin of the goods.

The court's decision confirms that criminal law can be used to expand the coverage of 2D trademarks to 3D reproductions having the same character or shape.

Previous case law

As mentioned above, previous decisions from different divisions of the Court of Cassation conflicted on this issue.

For example, in Judgment 26754/2001 the Court of Cassation, Division III held that Article 474 of the Criminal Code was not violated when puppets depicting well-known cartoon characters that were protected by a 2D trademark were sold without a label indicating the name of the characters. This case concerned the sale of puppets reproducing Winnie the Pooh and Pokémon.

In contrast, Court of Cassation Decision 27032/2004 issued by Criminal Division V held that pursuant to Article 474 of the Criminal Code, inflatable toys depicting the fantasy character Calimero, which was protected by a 2D trademark, constituted infringement, even though the toys did not bear any word elements with the name 'Calimero'.

Finally, Court of Cassation Decisions 25147/2005, 20040/2011, 13235/2014 and 34703/2009 left the door open for findings of copyright infringement, but excluded criminal infringement in cases similar to Calimero.

Comment

The *MGM* decision provides uniform criteria for determining when the reproduction of a well-known character in 3D form (eg, a toy or puppet) constitutes criminal infringement under Italian law.

Even without a 3D trademark registration, and in the absence of any indication of the name of the character on the puppet or toy or the labels, infringement exists when there is an objective and unequivocal likelihood of confusion that could mislead consumers as to the origin of the goods.

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