

January 2021

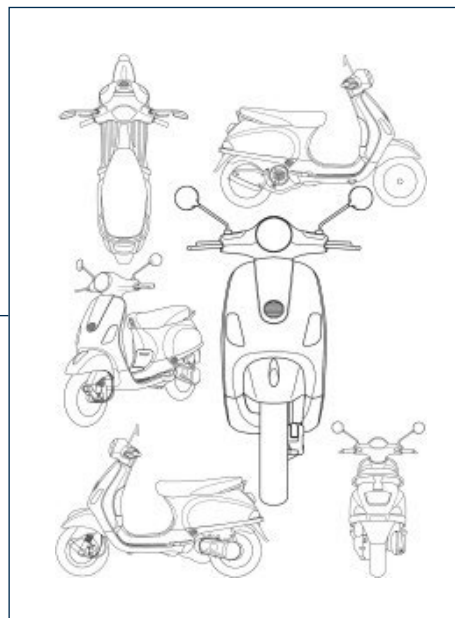
Never copy a Vespa

The European Union Intellectual Property Office (EUIPO) confirms the validity of the three-dimensional trade mark for the shape of the Vespa, also affirming the cumulability of trade mark and design protections. Represented before the EUIPO by Elena Monte of Jacobacci & Partners, Piaggio repeated the historic victory already achieved in Italy: the shape of the Vespa is a valid European three-dimensional trade mark.

Three-dimensional trade mark registration and trade fair seizure of Znen scooters

In 2013, represented by Elena Monte of Jacobacci & Partners, Piaggio obtained protection for the shape of the Vespa as a three-dimensional trade mark in Italy and in the European Union, proving that it had acquired distinctiveness.

3D VESPA TRADEMARK



That year, on the basis of the Italian three-dimensional registration, Piaggio obtained the seizure of some scooter models exhibited at the EICMA trade fair by the Chinese companies Zhejiang Zhongneng Industry Group and Taizhou Zhongneng Import and Export Co. (hereinafter jointly referred to as Znen), called Cityzen, Revival and Ves, the first two of which were protected as registered Community designs.



Citizen



Revival



Vespa

Proceedings before the Court of Turin

Following the seizure, Znen brought an action before the Court of Turin, petitioning the the Court to declare that the three scooter models were not counterfeits of the Vespa, and the invalidity of the Italian three-dimensional trade mark. Piaggio, defended by lawyers Fabrizio Jacobacci, Barbara La Tella and Maddalena Deagostino of Studio Legale Jacobacci e Associati, requested the Court not only to reject Znen's claims, but also to confirm the validity of its three-dimensional Italian trade mark and to establish that the shape of the Vespa, as a work of "industrial design", enjoyed protection pursuant to Article 2.10 of the Italian copyright law.

The Court of Turin - by decision 1900 of 6 April 2017, confirmed on appeal by decision 677 of 16 April 2019 (currently challenged by ZNEN before the Italian Court of Cassation) - rejected Znen's claims and confirmed both the validity of the **Italian trade mark** for the shape of the Vespa and the **protection of the shape under Italian copyright law** as a work of industrial design, since it is in itself of creative character and artistic value.

Action for invalidity before the EUIPO

In parallel, Znen brought an action for invalidity of the European three-dimensional trade mark before the EUIPO on the grounds of (i) infringement of Article 60(2)(d) of the European Union Trade Mark Regulation 2017/1001 (EU Regulation 2017/1001), for being pre-dated by Znen's Revival design; for (ii) infringement of Article 7(1)(b) and (e)(ii) and (iii) of the EU Regulation, for being devoid of any distinctive character and consisting merely of the shape of the product, solely dictated by its technical function, with the shape giving substantial value to the goods; and (iii) for the infringement of Article 59(1)(b) of EU Regulation 2017/1001 on the grounds of acting in bad faith at the time of filing the application.

To neutralise the relative ground for invalidity based on Znen's Revival earlier registered Community design, Piaggio, represented by Elena Monte and Pierluigi Carangelo of Jacobacci & Partners, brought an action for invalidity against Znen's registration, claiming lack of individual character in comparison with the Vespa model protected by the trade mark, which had been on the market since 2005. In fact, the reasoning was that if the earlier design were to be declared invalid, the relative ground for invalidity would cease



EARLIER MODEL BY ZNEN

to exist; if, instead, it were to be found valid, as conveying to informed users an overall impression differing from that conveyed by the Vespa scooter, then the same conclusions could be expected in the context of the trade mark action.

The parallel action led to the suspension of the trade mark proceedings until the **final decision on the earlier design** was taken by the Court of Justice of the European Union in case T-219/18. The Court upheld the decision of the Board of Appeal of the EUIPO overturning the decision of the Invalidity Division, which had initially ordered the invalidity of the earlier Znen's Revival design for being pre-dated by the Vespa.

In its **decision on the trade mark**, the EUIPO referred to the decision of the Court, stating - by reason of the principles of equal treatment and good administration - that it could not ignore

the findings of the Court and, since the signs compared in the two proceedings coincided, its conclusions were that Piaggio's trade mark produced an overall impression that clearly differed from that of the earlier Community design.

In relation to the invoked absolute grounds for invalidity, the Cancellation Division found that the applicant for invalidity failed to prove their existence, pointing to the presumption of validity of the trade mark which had already undergone the assessment of registrability prior to granting its registration.

Znen argued that the contested trade mark was devoid of distinctiveness because it consisted of a representation of the shape of the product, which did not differ significantly from the shape of other similar products on the market, without adducing any supporting evidence. Instead, the Cancellation Division ruled that it is up to the party requesting the declaration of invalidity to present arguments, facts or factual evidence in order to challenge the validity of the contested trade mark, and rejected the ground of invalidity for lack of distinctiveness.

As regards the prohibition of registration of signs consisting exclusively of the shape of the product required for its technical function, the Division observed that "*the applicant merely referred to a single feature defined as 'essential' which, according to the applicant, consisted of the arrow-shaped front shield, which 'suggests the idea of speed'. That argument, however,*

is insufficient for the purposes of applying the grounds relied on. In fact, the argument that a certain shape feature evokes an "idea" in the consumer does not show how such feature would fulfil the alleged technical function".

The Division therefore concluded that the applicant had neither identified the essential sign features nor indicated the technical function performed by those features, reiterating that, by reason of the presumption of validity of the trade mark, it was for Znen to prove the existence of the ground relied on.

In relation to the ground for refusal of signs consisting exclusively of the shape giving substantial value to the product, according to the Cancellation Division the fact that the shape or other feature may be pleasing or attractive is not sufficient to exclude the trade mark from registration. *"If that were the case, it would be practically impossible to imagine any trade mark for a shape or other characteristic, since in modern business practice there is no product of industrial interest not undergoing study, research and industrial design before being launched on the market".*

In confirming the cumulability of trade mark and design protection, the Division concluded that *"In the absence of evidence to support the applicant's arguments, it is not possible to conclude that the aesthetic value of the shape under consideration can, in itself, determine the commercial value of the relevant goods or the choice of the consumer".*

This is an important step: considering that the Vespa has been acknowledged by the Court of Turin and, even earlier, by the Tribunal de Grande Instance of Paris, as a work of industrial design protected by copyright, the cumulability of protection is confirmed for the same shape both as a trade mark and as an industrial design, in this case protected under copyright law but also protectable, in abstract terms, as a registered industrial design.

Finally, with regard to Piaggio's alleged bad faith at the time of filing the trade mark, Znen merely argued that the trade mark proprietor had not acted in good faith since, in order to corroborate the acquisition of distinctive character, alongside evidence pertaining to the shape represented in the trade mark application, it had filed evidence of the Vespa shape that referred to earlier scooter models. However, the EUIPO stated that "in the assessment of bad faith, what matters are the subjective intentions of the proprietor at the time of filing the contested EUM, which translate into actions that can be put in relation to a «conduct that departs from accepted principles of ethical behaviour or commercial and professional practices of fairness». In fact, Znen merely challenged the possible relevance of the evidence, which had already been the subject of the Examiner's assessment during the registration phase and, had it been found unsuitable to support the proprietor's claims, such evidence would have been deemed irrelevant at most.

The Cancellation Division of the EUIPO therefore rejected Znen's application in its entirety, confirming the validity of Piaggio's three-dimensional trade mark for the shape of the Vespa.

Effects of the triple protection of a shape as an industrial design protected by copyright, as a registered industrial design and as a three-dimensional trade mark

The Vespa case is particularly interesting in the context of the debate on the protection of shapes by means of different sets of rights, as it undoubtedly clarifies that the typical protection enjoyed by an industrial design, protected by copyright or by a registered design, can be flanked by trade mark protection.

In a still diverse European copyright landscape with regard to protectable industrial design works – with not all creative works protected in Italy but just those having an intrinsic creative character and artistic value – the combination of rights is an important solution for companies manufacturing objects the shape of which increasingly has a necessary aesthetic value. This is now evident in many sectors, from furniture and automotive to the food, fashion and medical sectors.

Obtaining protection as a three-dimensional trade mark for a timeless shape such as the Vespa means having a potentially perpetual right, in addition to the protection for up to twenty-five years given by a registered design or by copyright, elapsing after a maximum of seventy years from the author's death.

The target audience is also important. The prerequisite for obtaining design protection is the existence of individual character, i.e. the different overall impression produced by the shape in an informed user compared to any other design that has been disclosed to the public before. In this case, it is a person who has a thorough knowledge of the field. The protection conferred by the trade mark, which is subject to the existence of distinctiveness, with the shape in itself capable of providing an indication of the origin of the product, extends to all similar shapes for the consumers of that product, who need not be informed connoisseurs of the sector, as in the case of the design, but just "average" consumers.

It is therefore evident, in comparison with competitors' shapes, that the scope of protection afforded by the three-dimensional trade mark is broader when compared with the exclusivity conferred by industrial design; moreover, the latter does not depend on the category of goods and in certain circumstances is preferable to trade mark protection.

Piaggio has had the merit of obtaining registration of the three-dimensional trade mark for the shape of the Vespa and also the courage to successfully bring its own action against counterfeiters, who are increasingly placing on the market models that are not so similar as to violate a design and are normally distinguished by a different name so as not to violate the word sign, but are sufficiently imitative to recall the Vespa and thus attract consumers who consciously purchase a different product, fascinated by the memory of the iconic scooter. In a European scenario in which three-dimensional trade marks are rarely granted and even more rarely pass a validity test following a nullity action by third parties, Vespa can now count on a trade mark registration that not only passed

an assessment of registrability but even withstood an action for its annulment, proving to be an effective tool against counterfeiting, in particular in those contexts where an authorial protection can only be asserted through its recognition in a decision in the merit, as happened during the Eicma fair and as it could happen at any public exhibition. The three different protections – registered design, trade mark and copyright – are a very comprehensive arsenal in the fight against counterfeiting.

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