

Bugnion SpA

Keeping with tradition

Non-traditional marks are afforded protection in Italy, but there are challenges to registration

Trademarks traditionally consist of distinctive signs such as words, images or symbols. However, a trademark can fulfil its distinguishing function through alternative elements, such as sounds, colours, scents, brand positioning, motion, touch or taste.

This article briefly analyses the primary critical issues faced by each type of non-traditional trademark in terms of Italian case law and doctrine. It goes on to focus on colour marks in light of recent judgments handed down by the Italian courts.

In terms of non-traditional trademarks, the contribution made by Italian case law has tended to be less significant than that played by the European Court of Justice (ECJ), to which the Italian courts usually defer.

Legal framework

Pursuant to Article 7 of the Intellectual Property Code, and in line with Article 4 of the EU Community Trademark Regulation (207/2009), the Italian legislature has clarified that the following can be registered as a trademark: "all the signs which may be represented graphically, particularly words, including personal names, designs, letters, numerals, the sounds, the shape of the product or packaging of it, combinations or shades of colours, provided they are capable of distinguishing the goods or services of one undertaking from those of other undertakings". This list is by no means exhaustive, but serves as a mere example.

In any case, from the wording of the above article (which establishes the general principles that apply to any type of mark, be it conventional or non-traditional), it is clear that in order to be registered in Italy, a trademark must comply with three basic requirements:

- It must be a sign of "business communication";
- It must be capable of being represented graphically; and

- It must fulfil the essential function of distinguishing and connecting products or services to a particular commercial source.

These requirements significantly hinder the registration of non-traditional trademarks. These difficulties are heightened in particular for sound marks and scent marks.

The main problems lie in the objective graphical representation of trademarks, which must be intelligible and accessible to the target consumers.

Shape marks

A shape mark constitutes the actual shape of a product that is sufficiently distinctive or unusual to function as a trademark. A particular shape can give a product a unique appearance.

However, Article 9 of the Industrial Property Code states that "signs consisting exclusively of the shape which results from the nature itself of the product, or consisting of the shape of the product which is necessary to obtain a technical result or of the shape which gives substantial value to the product may not be registered as trademarks".

For three-dimensional trademarks, meeting the requirements set forth by this article is extremely difficult and registration is granted in only a few cases. On March 3 2008 the Court of Turin ruled on a shape mark application, holding that the shape of a smart car could be validly registered as a Community trademark because this shape was not a requirement of the intrinsic nature of the product, was not needed to achieve a technical result and did not give substantial value to the product.

However, the difficulty in registering shape marks seems to have been confirmed

by a 2012 ruling of the Court of Venice, which held that "the trademark which relates on the form of a product is invalid if it does not fulfil the function of identifying the commercial source of the product itself...being irrelevant... that the shape of the product has been accredited to the consumers due of the advertising investments made" (February 15 2012, 1297/12).

Sound marks

As per sounds which can be reproduced on a stave, the Court of Naples has stated that a musical jingle that is used for advertising purposes may be considered as a sound mark (Case 3753/2006, March 16 2006). However, Italian case law on the matter is scarce.

Scent marks

Scents are the most controversial type of non-traditional mark, due to the difficulty in representing them graphically. Although no cases involving scent marks have come before the Italian courts to date, the courts would have to apply the strict ECJ case law in this regard.

Colour marks

Registering colour marks with the Italian Patent and Trademark Office does not seem to be particularly difficult. Nevertheless, the primary critical issue relates to the registration of single colours, as opposed to colour combinations.

While no doubts have ever arisen about the possibility of registering colour combinations, case law suggests that courts are reluctant to grant trademark protection to single colours. For example, in a Court of Milan case, it was argued that primary colours such as blue and red cannot be registered as a trademark (June 7 2007).

For a long time, it was thought that

single colours could not be registered as trademarks because they lacked distinctiveness and could not indicate the trade origin of a product.

Moreover, the registration of colours as trademarks was considered contrary to the public interest, which aims to protect the free disposal of colours. In view of their limited number, granting registrations for single colours would lead to monopolies. Consequently, for many years, unfair competition law was largely invoked in order to protect unique colours.

However, this approach began to be challenged in legal literature in the 1990s. It was argued that lack of distinctiveness could not be regarded as an objective characteristic of colour used as a trademark, but rather that such lack of distinctive character should be assessed on a case-by-case basis, including assessment of secondary meaning acquired by the colour.

This impasse was resolved by the ECJ's well-known *Libertel* judgment (May 6 2003), in which the ECJ ruled that it is possible to register single colours as trademarks, provided that the colour itself is defined in a sufficiently clear manner (eg, identified by an internationally recognised identification code, such as a Pantone number).

The (few) judgments of the Italian courts in relation to colour marks have mainly invalidated colour mark registrations due to regular and recurrent use of the colours in certain business sectors, thus rendering them incapable of distinguishing the activities of one enterprise from those of competitors (App Milan, May 7 2002, GADI, 2002, 857).

Similarly, if a colour used as a trademark is natural to the product for which it is used, it does not have distinctive character and therefore cannot be validly registered (eg, it has been argued that "the use of silver and aluminium in food packaging is also generalised to the technical requirements and functional and cannot be protected by a trade mark" (Court of Milan, November 15 1994)).

Moreover, the Court of Cassation (Italy's Supreme Court) has specified that only those colours with particular or unusual chromatic tonality can be registered as trademarks. In the case at hand (7254/2008), the Supreme Court, upholding a Milan Court of Appeal decision, ruled that several trademarks owned by Louis Vuitton in relation to leather goods, which consisted of the colours black, brown, beige, green, red and blue, were invalid because they



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lacked distinctiveness, as these colours are commonly used in the leather industry.

In its reasoning, the Supreme Court referred to the principle set out in *Libertel*, which aimed to prevent undue restriction of the availability of colours for other business entities operating in the same sector. However, the issue of the possible acquisition of distinctive character through use of such colour marks was not dealt with in this case.

In *Guccio Gucci SpA v Guess Inc* (6095/2013, January 10 2013, published on May 2 2013), the Court of Milan held that a Gucci trademark consisting of coloured stripes (green-red-green) was validly registered, despite the absence of Pantone numbers.

The court ruled that the trademark as held "may be assigned undoubted distinctive strength and it is considered suitable to accurately identify the origin of the products". However, it confirmed that if the trademark at issue had been a single colour, the relevant application would have required a Pantone number.

Therefore, Pantone numbers are not required when the colour combination is such as to give the sign sufficient distinctive strength. This condition was deemed to have been fulfilled by Gucci's green-red-green stripe mark. The court stated that "the alternation of colours is such as to indicate that the mark is described with the required accuracy and can be identified in an objective manner".

Moreover, in the same decision, the court ruled that the use of brown-red-brown stripes by Guess for shoes did not constitute infringement of Gucci's above-mentioned green-red-green trademark. The court held that "it is certainly not protectable the simple idea of using in clothing accessories a tape characterised by the alternation of colours", and that "in the fashion industry, inserted strips in various ways are widespread, especially in the accessories bearing the alternation of colours". [WTR](#)