

The Trademark Lawyer

Issue 5 2017

GLOBAL REACH, LOCAL KNOWLEDGE

www.trademarklawyermagazine.com

Pharmaceutical products in the US & the EU: The challenges of protecting your trademark globally

by Benjamin Goldenberg
from Galderma



CTC Legal Media

PLUS

Brexit Update: Stephen Hodsdon from Mewburn Ellis comments on the recent European Commission's position paper on IP rights



- Non-conventional trademarks
- Indian trademark applications
- The ARIPO challenges
- Trademark strategies
- Italian IP courts
- Polish design rights
- The Asia Pacific region



Francesco Bonini

Latest update on Italian IP courts

Francesco Bonini, of Studio Bonini Srl, reports on the recent developments, timeliness, and performances of IP courts in Italy and effectiveness of IP enforcement.

Contrary to a commonplace, the rule of law against IP infringement is effective: in fact, IP enforcement, especially civil enforcement, has an important level of efficiency due to specialized divisions in a limited number of existing courts.

It is noteworthy that on April 2014, Italy was removed from the US Trade Representative “Special 301 Watch List”, which includes those countries whose rule of law in protecting and ensuring IP rights enforcement is not sufficient or, in the case of the “Priority 301 Watch List”, seriously unsatisfactory.

The USTR notice said: *“Italy’s removal... reflects the significant steps the Government of Italy has taken to address the problem of online piracy... The United States encourages Italy to continue this positive momentum”*¹

The progresses of Italian specialized IP civil courts before and after 2014, until today, has given floor to this acknowledgement by such an authoritative government agency of the United States: on the contrary, other developed and well-reputed² countries, namely Canada and Switzerland, still remain in the “301 Watch List” of USTR in 2017.

IP courts and their development

Since 2003, IP civil enforcement has been highly effective in Italy. From that date, Italy established 12 court sections that specialize in IP matters and who’s numbers increased to 21 in September 2012.

These courts have exclusive entitlement to issue judgments in trials for infringement of patents, trademarks, designs, copyrights, know-how, trade secrets, plant varieties,

geographic indications, and domain names, as well as in trials for unfair competition or infringement of antitrust law.

However, since 2014 the cases involving foreign companies have been concentrated to only 9 entitled venues: Turin, Milan, Venice, Genoa, Rome, Naples, Bari, Catania, and Cagliari.

All these courts, to the exception of Cagliari, belong to the original group of 12 courts established in 2003, which have been experiencing at least 14 years of case-law: consequently, they can ensure more consistency and more reliability in their judgements.

Given that, and considering that the larger cities attract also the highest number of IP civil cases, at present the most applied venues are those of Milan, Rome, Naples, Venice, Bari, and Turin.

The good timeliness of the civil court is enhanced by their entitlement to:

- Order official investigations on evidence (i.e. judicial description);
- Grant precautionary measures (i.e. seizures, inhibitory, injunctions).

Urgent measures are usually examined and granted in a short amount of time – within a few days as far as trademarks and designs are concerned, within a few months as regards patents (for which a court expert is appointed).

An injunction or an inhibitory order is usually joined by a provision for a fine for each violation thereof to be paid to the rights’ holder. Violation of an injunction entails a crime, according to article 388 of the Criminal Code (which foresees imprisonment up to three years).

Another important issue to take into consideration is the complete digitization of the civil trials: starting from 2014 the Italian Government has obliged all civil courts to shift from paper acts to digital acts.

Starting from courts of First Instance, the lawyers of each party have been obliged to file documents and arguments by certified e-mail and no longer on paper; the same have been applied to any communication by the Judge to the parties and to the judgement on the case.

¹ See full notice at <https://ustr.gov/about-us/policy-offices/press-office/press-releases/2014/April/USTR-Removes-Italy-From-The-Special-301-Watch-List>

² See Country RepTrack® 2017 report at <https://www.reputationinstitute.com>

Résumé

Francesco Bonini, EU Trademark Attorney, Studio Bonini

Mr. Francesco has 20 years of experience in Italian and EU trademark and design prosecution. He had successful cases in oppositions, appeals and cancellations both before the EUIPO and the Italian PTO.

Studio Bonini, established in 1980, has its head office in Vicenza, in the North-East of Italy. It has helped several companies in the Venetian area to protect their IP rights, dealing with IP prosecution.

IP litigation assistance is also provided by a 20-year cooperation with Studio Alberti & Fontana, a specialized law firm (IP and company right) with successful cases before the Italian IP courts.



stoyanh / Shutterstock.com

Subsequently, digitization has also been made compulsory for civil appeal courts and for the Supreme Civil Court. This made a relevant contribution to a reduction in costs (67 million euro/year, according to the Ministry of Justice²), as well as the time for a judgement to be issued.

Finally, recruitment for some thousands clerks in the court has helped a lot to reduce the timeliness of the proceedings, especially the chancellors whose role is essential in printing and issuing the judgements' texts.

Statistics, trends, timeliness, and reliability

The Italian civil courts in general and especially the specialized IP courts have seen a relevant reduction of the backlog. The overall backlog decreased dramatically from over 5 million civil litigations pending in 2009 to 3,155,000 at the second quarter of 2017.

This is due either to the economic crisis, which acted as a deflator

of the number of litigations, and to the increase of efficiency and of the clearance ratio of the courts due (as mentioned above) to digitization and increase of the staff.

Within the civil courts, the IP courts gained the top of excellence both for timeliness and quality of decisions. Going into more detail, at the end of 2016 Milan was the most required venue (1394 filed cases), followed by Rome (1369), Naples (831), Venice (734), Bari (378), Turin (310), Catania (181) and Genoa (124). Despite the large number of IP cases, Milan has a high level of efficiency. For example, Claudio Marangoni³, Judge of Milan IP court, reported that urgent measures are granted within an average (between trademark and patent cases) of 107 days and their number reaches the 40% of all the filed cases.

In addition, he adds that the plaintiff often does not proceed to issue a decision on the merit of the claimed counterfeiting. Indeed,

| Main Italian IP courts: Numbers of cases and average timelines. Years 2015-2016 (source: Database of Ministry of Justice) | | | | |
|---|------------|--------------------|------------|--------------------|
| Venue | 2015 filed | 2015 final pending | 2016 filed | 2016 final pending |
| Milan | 1468 | 1849 | 1394 | 1952 |
| Rome | 1046 | 1531 | 1169 | 1853 |
| Naples | 731 | 943 | 831 | 1061 |
| Venice | 558 | 850 | 734 | 997 |
| Bari | 254 | 448 | 378 | 572 |
| Turin | 327 | 376 | 310 | 378 |
| Catania | 143 | 129 | 181 | 290 |
| Genoa | 100 | 110 | 124 | 155 |
| Cases ended without issuance of decisions | | 285 days | | 333 days |

an injunction, usually with a fine for each violation, is a striking damage for the counterfeiter because he is stopped from going on with his illicit action and a judgement of conviction has been issued even without an award of damages.

In regards to IP cases prosecuting until a judgement on the merit is issued, at present nearly 57% are concluded within one year; for the remaining cases, the average time is 866 days (that is, 1 year and 4 months) in Milan and of 970 days (2 years 8 months) on a national average.⁴ Moreover, in Milan IP court only 20% of first instance judgements are challenged in appeal; in addition, the second stage confirms 70-80% of first instance decisions.⁵ This is very important because it demonstrates the good quality and consistency of the decisions: predictability acts as a deflator of litigations going on until decision.

Indeed, for those cases that are concluded without a judgement (i.e. with a settlement agreement between the parties) the average time to settle them is 333 days, which is less than 1 year.⁶

The IP court of Milan is divided into two sections: section A, which deals with Intellectual Property cases and section B, which deals with violation of company law (an added entitlement to the IP courts, which could slow their timeliness).

“ *Urgent measures are usually examined and granted in a short amount of time.* ”



The same complete division and specialization is in the IP court of Naples; while in Rome and Venice IP judges also deal with other kinds of civil cases related to finance law or other civil violations.

In conclusion, we all can see a positive and improving scenario for IP civil courts in Italy, which keep on showing their quickness and consistency, and hence, reliability: a positive piece of news for Foreign Direct Investments, especially those that are connected with the development and enforcement of tech innovation and brand or design innovation.

Francesco Bonini, www.ipbonini.com

² See PDF document at https://pst.giustizia.it/PST/resources/cms/.../PCT_Stato_arte_sintetico_31_10_2016.pdf

³ Abstract from *IlSole24ore*, the most reputed Italian economic daily newspaper, May 19th 2017.

⁴ Ibidem as note 3.

⁵ Ibidem as note 3.

⁶ Ibidem as note 3

industrial property
patents, trademarks, design, copyright

licensing
valuation and exploitation of intangible assets

training and innovating
training services for Innovation Managers

legal and technical assistance in
litigation
protection against patent, TM, design and
copyright infringement

Looking to the future together with
our customers since 1980



studio Bonini
over 35
years

Studio Bonini S.r.l.
Corso Fogazzaro, 8 - 36100 - Vicenza - Italy
T. +39 (0)444.324570 - F. +39 (0)444.230574 - info@ipbonini.com
www.ipbonini.com