



Reproduction of a trademark in dictionaries under Italian law. A newly codified right, but also a burden, for trademark owners

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📁 INTELLECTUAL PROPERTY, LITIGATION

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Among the several amendments to the Italian Industrial Property Code (“IPC”) introduced by the so-called EU Trademark Package¹, new paragraph 3-*bis* of Article 20 is worth mentioning, which now expressly grants to the owner of a registered trademark, under certain conditions, the specific right to oppose its reproduction with a generic meaning in dictionaries or similar works.

New paragraph 3-*bis*, which mirrors a pre-existing provision applicable to EU trademarks², reads as follows:

“... If the reproduction of a trademark in a dictionary, encyclopaedia or similar reference work, either in paper or electronic form, gives the impression that it constitutes the generic name of the products or services for which the

¹ The EU Trademark Package comprises two main legislative instruments: i) Directive (EU) 2015/2436 of 16 December 2015 to approximate the laws of the Member States relating to trademarks (“*New Directive*”), and ii) Regulation (EU) 2015/2424 of 16 December 2015 (“*Amending Regulation*”), which modified Regulation (EC) 207/2009 on the Community Trademark, finally repealed by Regulation (EU) 2017/1001 of 14 June 2017 on the European Union Trademark (“*New Regulation*” or “*EUTMR*”). In Italy, Legislative Decree no. 15 of 20.02.2019, implementing the New Directive and adapting national legislation to the Amending Regulation, entered into force on March 23, 2019. Article 9, para. 1, letter (d) thereof introduced new paragraph 3-*bis* of Article 20 IPC, corresponding to Article 12 of the New Directive (entitled “*Reproduction of trade marks in dictionaries*”).

² This provision of the IPC, and the corresponding provision of the New Directive, reflect almost literally Article 12 of the New Regulation concerning EU Trademarks and already contained in Article 10 of earlier Regulation (EC) 207/2009. Otherwise than the EUTMR, the IPC and the New Directive specify that the reference work can be either in paper or electronic form: in the latter case, the publisher must take the prescribed measure promptly; in the former case, it must do the same at the latest in the next edition.



trademark is registered, upon request of the trademark owner, the publisher of the work shall ensure that the reproduction of the trademark is, promptly and at the latest in the next edition in case of works in paper form, accompanied by the indication that it is a registered trademark ...”.

The legislative amendment is meaningful, because otherwise it could be argued that such use of the trademark by third parties does not require the owner’s consent, as it is not put in place “*in the course of trade*”³ in relation to the products or services concerned.

The underlying *rationale* is to grant the owner a preventive legal remedy against the loss in distinctive character of its trademark, the so-called vulgarization, and consequent exposure to risk of revocation. In particular, the new provision should be read together with Art. 13, para. 4, IPC, whereby: “... *The trademark is revoked if, in consequence of its owner’s activity or inactivity, it has become the common name of the product or service in the trade, or howsoever has lost its distinctive power ...*”⁴.

The mere fact that a trademark is mentioned in dictionaries as a generic name does not prove *per se* that it has already lost its distinctiveness; however, it may facilitate this process and/or indicate that this is ongoing. Actually, vulgarization is often inherently connected with the linguistic reality, consisting of an “... *objective change occurred in the usual language of the community ...*”⁵.

In order for this phenomenon to take place, “... *it is necessary that the trademark has lost its function of conceptual link between that product or service and a specific entrepreneur, because the word constituting the trademark has become of common use, as mere generic denomination of the product or service: a new term or neologism, a “common name of thing” among others ...*”⁶.

Italian case-law makes it clear that the mention of a word trademark in dictionaries, and the contents of the mention itself, may prove a key-factor in the assessment of vulgarization.

In a case decided by the Court of Modena in 2000⁷, concerning the “MISS ITALIA” registered trademark, which denotes a notorious beauty contest in Italy, the defendant claimed that the sign had lost its distinctive character because it had fallen into common language, to such an extent that it featured in dictionaries. However, the Court held that – while the term “Miss” was actually a generic term (meaning either an unmarried girl or the winner of a beauty contest) – the expression made up of the two joint words “Miss” and “Italia” had not become the denomination of a product/service. Hence, a vulgarization counterclaim might have affected the trademark if it had included only the word “Miss”.

Another example regards the “OSCAR” registered trademark, used with reference to the world-famous eponymous movie contest. In 2016 the

³ See Article 20 IPC and, for EU Trademarks, Article 9 EUTMR.

⁴ For EU Trademarks, an analogous provision is set out in Article 58, para. 1, letter b), EUTMR, whereby: “... *The rights of the proprietor of the EU trade mark shall be declared to be revoked on application to the Office or on the basis of a counterclaim in infringement proceedings: ... b) if, in consequence of acts or inactivity of the proprietor, the trade mark has become the common name in the trade for a product or service in respect of which it is registered ...*”.

⁵ See Cass. Civ., 23.10.1984, no. 5376, quoted in Cass. Civ., Sez. I, 21.07.2016, no. 15027.

⁶ See Cass. Civ., Sez. I, 21.07.2016, no. 15027.

⁷ Court of Modena, 27.07.2000, in *Giur. Mer.*, 2001, p. 329, as reported in GAUDENZ I A.S., *Manuale pratico dei marchi e dei brevetti*, VII ed., Maggioli Editore, 2020, page 171.

Italian Supreme Court⁸ found that such word had undergone a partial vulgarization process. More particularly, it was held that the trademark had retained its distinctive character in the movie industry, but it was revoked in other product/service fields, in which it had assumed the generic meaning of top prize.

According to the challenged decision⁹, vulgarization in Italy occurred during the years immediately subsequent to the national registration, dated 1982, when the word “Oscar” was included also as a common name in some Italian dictionaries¹⁰, together with the mention of its first specific meaning as a trademark. The Court eventually upheld the claimant’s argument whereby the challenged decision had not taken into due consideration the permanence of the primary, distinctive, meaning of the sign.

The new provision in detail

Let us now focus on the main textual elements of the EU/Italian provision, as construed by legal literature¹¹.

- **The concept of “reproduction”**

Although this term seems to point to a situation of identity between the trademark and the sign appearing in dictionaries or similar works, it should be construed as also including denominations that, amounting to mere and obvious variations of the registered trademark, may in reality accelerate the vulgarization process.

- **The concept of “dictionary, encyclopaedia or similar reference work”**

These terms should be broadly construed, so as to encompass whatever work that the public uses in order to learn the meaning of a word and collect information thereon. Also digital databases serving this function should fall within the notion.

- **The condition whereby the reproduction gives “the impression that it constitutes the generic name of the products or services for which the trademark is registered”**

A non-deceptiveness criterion for the perception of the consumer is implied. The provision applies only if the reproduction of the trademark generates in the average reader of the work the erroneous impression that the sign constitutes a generic name, rather than a trademark.

This may happen, in particular, when the trademark is printed in normal font without being accompanied by, typically, the circular symbol embodying a capital “R” (®) or another symbol/indication that points to its distinctive nature; however, this assessment should be contextualized on a case-by-case basis.

The provision typically applies to word trademarks featuring in a dictionary or similar work as a headword, or in a definition or description. However, at least in the abstract, also figurative or atypical trademarks might become the object of vulgarization, if they appear under similar circumstances in an audiovisual or digital environment.

- **The measures to be adopted by the publisher, upon the trademark owner’s request, to indicate that the sign reproduced is a registered trademark**

⁸ Cass. Civ., Sez. I, 21.07.2016, no. 15027.

⁹ Appeal Court of Venice, 23.12.2011.

¹⁰ First, in 1983, the Garzanti dictionary; then the Gabrielli dictionary in 1989, the Zingarelli in 1999 and others.

¹¹ On the corresponding and pre-existing provision for EU trademarks, see UBERTAZZI L.C., *Commentario breve alle leggi su proprietà intellettuale e concorrenza*, CEDAM, 2019, pp. 1246 ff. and GALLI C., GAMBINO A., *Codice commentato della proprietà industriale e intellettuale*, UTET GIURIDICA, 2011, pp. 1777 ff.. Specifically on the new Italian provision, see ALBERTINI L., *Novità in tema di disciplina dei marchi: le disposizioni sostanziali del D. Lgs. 15 del 20.02.2019*, in IL CASO.it, 2019.

The publisher cannot be absolutely prohibited from mentioning the trademark in its work and/or, if he wishes, from deleting all references thereto in following editions. He can only be requested to ensure that the reproduction is accompanied by the indication that the word is a registered trademark.

As regards the measures to be adopted, the insertion of the symbol ® or TM beside the trademark, possibly accompanied by a mention of the trademark owner, is normally deemed sufficient. Conversely, it would arguably not be enough to publish a general warning or notice in the sense that, where trademarks appear in the work, their reproduction is not meant to denote that they became a generic denomination of the product or service in the course of trade.

If the publisher is of the view that the mark has become a generic name, he can say so in addition to the acknowledgement of the existence of the trademark registration. However, this does not affect the legal assessment, which is up to the judicial authority.

- **The timing of the measures to be adopted by the publisher**

The publisher of an on-line work is expected to take the correcting measures promptly (without prejudice to the reasonable time necessary to verify the truthfulness of the trademark owner's allegation).

In case of works in paper form, the same measures must be implemented at the latest in the next edition; by analogy, this should also apply to works issued periodically, even on digital supports (e.g. CDs).

- **Possible judicial action against the publisher**

If the publisher does not fulfill the request to insert the prescribed indication in the work, the trademark owner will be entitled to file a civil action, claiming specific enforcement and compensation of damages. To that end, it will need to prove (as part of the constitutive fact of the alleged right) the impression among the relevant readership conveyed by the reproduction, that the mark constitutes a generic name.

Trademark revocation can be avoided by demonstrating to have duly opposed the generic use of the trademark; for starters, such reaction could be of extra-judicial kind, taking the shape of a warning letter.

Final remarks

New Art. 20, paragraph 3-*bis*, IPC has codified a specific right that beforehand legal literature¹² had already recognized to the owners of Italian trademarks, by analogy to the corresponding provision applicable to EU trademarks.

Actually, in the past companies holding famous trademarks did take legal measures aimed at preventing the risk of vulgarization, in presence of uses of their sign as a generic name identifying a category of products, in particular within reference works.

A leading case dates back to the 90s of the last century, when the publishing house Le Monnier inserted into the celebrated Devoto-Oli dictionary the name "NUTELLA", which is the brand of the famous hazelnut cocoa spreadable cream created and commercialized by the Italian company Ferrero. According to archive sources¹³, Ferrero successfully challenged this unauthorized use of its trademark, and the publisher issued a release in the sense that the definition of the word "Nutella" as a commercial name did not mean to identify a common term and undertook, starting from the subsequent edition of the dictionary, to

¹² See SENA G., *Il diritto dei marchi. Marchio nazionale e marchio comunitario*, IV ed., Milano, 2007, 100.

¹³ See [LINK](#).

add a note specifying that it was a registered trademark.

Le Monnier implemented the same measure also with respect to the words “JACUZZI” (for whirlpool baths) and “DOMOPAK” (for food cooking and preserving foil), upon request of their respective trademark owners. In general, the publisher is likely to fulfill the trademark owner’s request, in order to avoid litigation and in the absence of a true interest to oppose the request¹⁴.

What practical impact could the new provision have?

Considering that, pursuant to Art. 13, para. 4, IPC, the trademark owner’s inactivity (or activity) constitutes a subjective condition for revocation, in light of the newly granted right under Art.

20, para. 3-*bis*, IPC, to some extent the owner of an (Italian) trademark is now expected to be more proactive against the publisher if he wishes to avert revocation. As a matter of fact, refraining from utilizing the remedy may amount to inactivity.

Hence, in the perspective of businesses wishing to preserve the distinctive character of their trademarks of very broad use by the public, it is important to react promptly against the unauthorized use thereof by third parties as a generic name of products or services. With that goal in mind, a regular surveillance service aimed at monitoring the publication of reference works, both tangible and digital, could prove a worthwhile investment.


¹⁴ This opinion is expressed, in particular, by ALBERTINI L., *Novità in tema di disciplina dei marchi: le disposizioni sostanziali del D. Lgs. 15 del 20.02.2019*, in IL CASO.it, 2019.




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