

**Italian Supreme Court rules that mere reproduction of
Vespa image may amount to counterfeiting**

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Review

Italian Supreme Court rules that mere reproduction of Vespa image may amount to counterfeiting

Cassazione penale, 5th Section, 17 March 2017, No 13078

In its decision of 17 March 2017 a criminal section of the Italian Supreme Court (Corte di Cassazione) ruled that the crime of counterfeiting within Article 474 of the Italian Criminal Code (codice penale, ICC) can also subsist in the case of mere reproduction of the image of a Vespa without also the reproduction of the registered word mark 'Vespa'.

Legal context

Under Italian law counterfeiting is not just a matter of trade mark infringement but also – under certain conditions – a conduct that may be subject to criminal sanctions. The ICC contains a number of provisions for the protection of intellectual and industrial property. In particular, Article 474 ICC states that (translation by the author):

1. Except in cases of joint liability covered by Article 473 [ie counterfeiting, alteration or use of distinctive signs of creative works or industrial products], anyone who introduces into the territory of the State, in order to make a profit, industrial products bearing trade marks or other distinctive signs, whether national or foreign, that are counterfeited or altered, is punished with imprisonment between one and four years, and a fine between EUR 3,500 and 35,000.
2. Except in cases of joint liability in the counterfeiting, alteration, introduction into the territory of the State, anyone who is in possession for the sale, starts selling or otherwise circulates, in order to make a profit, the products mentioned above sub paragraph 1 is punished with imprisonment up to two years and a fine up to EUR 20,000.
3. The delicts sub paragraphs 1 and 2 are punishable upon condition that internal laws, EU regulations and international conventions on the protection of intellectual and industrial property are observed."

Facts

In 2016 the Rome Court of First Instance (Tribunale di Roma) found against the defendant (Davide Ke) in criminal proceedings that had been brought against him within Article 474 ICC for reproducing the image of a Vespa on gadgets (eg key rings) and T-shirts. The goods marketed by the defendant did not also carry a reproduction of the word 'Vespa' (a registered trade mark owned by Piaggio).

Ke appealed the decision before the Supreme Court. He argued that his conduct would not fall within the scope of Article 474 of the Italian Criminal Code, in that such provision distinguishes between the concepts of, on the one hand, trade marks and distinctive signs and, on the other hand, products or objects. There would be no crime when one merely reproduces images of industrial products (like a Vespa) without also reproducing any trade marks or distinctive signs. In such case, there could be confusion among products, but not also trade marks or distinctive signs.

Analysis

The Supreme Court dismissed the appeal. Recalling an earlier Supreme Court decision (Cassazione penale, 2nd Section, 13 February 2015, No 9362), the court noted that even the mere reproduction of an image can fall within the scope of Article 474 as long as:

- (1) such image is a trade mark or a distinctive sign of the product; and

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3 (2) the reproduction has the potential to create in some way confusion among consumers as regards
4 the origin of the good in question.
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6 It follows that the material reproduction of a trade mark as such is not required for Article 474 ICC to apply.
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8 **Practical significance**

9 This decision is consistent with earlier Italian case law on Article 474 ICC.
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12 Even if the Supreme Court did not refer to decisions other than Italian ones and in contexts other than
13 criminal, the ruling also appears consistent with relevant trade mark case law, including the seminal decision
14 of the Court of Justice of the European Union (CJEU) in *Adidas-Salomon AG and Adidas Benelux BV v*
15 *Fitnessworld Trading Ltd*, C-408/01, EU:C:2003:582 (*Adidas-Salomon*). In that case the CJEU considered
16 use of a sign as embellishment (this appears to have been to some extent the defensive line used in the case
17 decided by the Supreme Court), and held that the fact that a sign is viewed as an embellishment by the
18 relevant section of the public is not, in itself, an obstacle to trade mark protection where the degree of
19 similarity is none the less such that the relevant section of the public establishes a link between the sign and
20 the mark. A relatively recent application of – among other things – the *Adidas-Salomon* principles has been
21 in the decision of the High Court of England and Wales in *Hearst Holdings Inc & Another v A.V.E.L.A. Inc*
22 *& Others* [2014] EWHC 439 (Ch), in which Birss J held that the claimants' efforts to imbue a certain 'brand'
23 (in that case, the image of Betty Boop) with trade mark significance should be acknowledged and receive
24 appropriate protection against unauthorized third-party uses (J Blum – N Round, 'Boop oop a doop –
25 protection for cartoon image of Betty Boop (2014) 9(7) JIPLP 546; but cf the different outcome in the
26 relevant (non-criminal) Italian proceedings: S Lavagnini, 'Italian court holds that a trade mark cannot serve
27 to extend IP protection in public domain characters' (2016) 11(12) JIPLP 888).
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