



International Distribution Institute

Workshop 1: The Enforcement of IP Rights in Different Jurisdictions

International Distribution Institute

Annual Conference

Bologna June 10, 2022

DISCUSSION PANEL: The enforcement of IP rights in different jurisdictions

Departing from well drafted contractual clauses as well as the registration of IP rights to protect the “trade dress” of the shop layout, how can such legal instruments be effectively implemented, in order to obtain interim measures and other effective court interventions?

The panel of speakers will review and answer possible questions from the perspective of their own jurisdictions from different perspectives.



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DISCUSSION PANEL: The enforcement of IP rights in different jurisdictions

Session Chair:

Marco Hero, Schiedermaier Rechtsanwälte, Frankfurt am Main; IDI franchising country expert for Germany

Speaker Panel:

- **Deborah S. Coldwell**, Haynes and Boone, LLP, Dallas
- **Nathalie de Quatrebarbes**, Quatrebarbes, Paris
- **Roberta Obinu**, Golden Goose, Treviso
- **Bernard Vanbrabant**, Prof. Université de Liège and Of Counsel Liedekerke, Bruxelles

DISCUSSION PANEL: The enforcement of IP rights in different jurisdictions

Judicial measures and enforcement in Italy

Premises:

1) Trademark (e.g. Apple), registered or unregistered; 2) Design, registered or unregistered 3) art. 2 n. 5 l.a.: designs and works of architecture 4) if there is unfair competition. E.g. parasitism (Kiko case).

Judicial measures:

A) Interim proceeding, followed by the proceeding in the merit

Remedies: Most effective: **injunction with penalty** (art. 156 l.a. and/or 131 c.p.i.) + **order of publication of the interim decision**. Both, injunction with penalty and order of publication are stable → No need to file the proceeding in the merit.

B) Proceeding in the merit: in addition to the remedies of the interim proceeding, reimbursement of damages (art. 125 c.p.i. and/or 158 l.a.)→ loss of profit of the IP owner or disgorgement of profits of the infringer or royalty criteria.



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Judicial actions, probatory measures and remedies for trade dress infringement in France

- The proof of the litigious act
- The judicial proceedings
- The available remedies
- Graphical User Interface (GUI)



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The Common Law approach from the U.S. Perspective:

- **Bases for protection**
 - **The Lanham Act**
- **Remedies and enforcement**
- **Examples of protected/unprotected trade dress**

DISCUSSION PANEL: The enforcement of IP rights in different jurisdictions

- Liège, 6 December 2016, Kiko v. BVMW and Wycon



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- Liège, 6 December 2016, Kiko v. BVMW and Wycon



DISCUSSION PANEL: The enforcement of IP rights in different jurisdictions

- Den Haag, 7 August 2019

A green, distressed-style stamp with the word 'GRANTED' in all caps, slanted slightly upwards to the right. The stamp has a white background and is framed by two parallel green lines.

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Thank you for your attention!

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