

The **i**NTERPATENT newsletter



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'KNOWLEDGE SHARE': A POWERFUL TOOL AVAILABLE FOR SCOUTING TECHNOLOGIES PATENTED IN ITALY

Created in 2019, '**Knowledge Share**' (<https://www.knowledge-share.eu/>), a project funded by the Italian Recovery and Resilience Plan, is a portal run and managed by the Italian Patent and Trademark Office, the University of Politecnico di Torino and NETVAL, a network putting together a large number of Italian universities and Italian spin-off companies as well as important public research bodies, scientific hospitalisation and care institutes, foundations and agencies.

The aim of 'Knowledge Share', which has been recognised as best practices by the European Union in 2021, is to **facilitate and enhance technology transfer and be a touchpoint between universities, companies and financial sponsors** by providing clear and comprehensive information related to patented technologies from public research in Italy.

With a coverage spanning the paramount technological and industrial fields in our country and a rate of 30-50 new patents added each month, today 'Knowledge Share' provides the most exhaustive overview of public research and of technological and scientific know-how in Italy.

The new version of this portal, '**Knowledge Share**

2.0' (KS 2.0), was launched in January 2024 and in addition to the patents section now features a new section reserved for Italian start-up and spin-off companies.

KS 2.0 also **employs AI to improve matching** between searched keywords and projects available on the portal, and searching is facilitated by an easy and intuitive interface available in both English and Italian.

KS 2.0 has a **semantic search engine**, which, unlike conventional search engines, is capable of creating a representation of the meaning of the words searched and comparing it with the representations of the concepts of the patents available on the portal.

The contents of the portal are curated and reviewed by a dedicated team to ensure that they comply with the portal's 'total quality' communication standards, and all the technology information is presented in a clear and simple language that can be easily understood also by those users who are not acquainted with patent-specific language.

KS 2.0 also features, for each patent, a 'Marketing

annex' that highlights the advantages and prospective applications of the patented technology, making it possible for users to better evaluate the potential of the patent and its suitability for their needs.

User access to KS 2.0 is allowed by **registration**, which **is free and open to all big companies, small and medium entities, investment funds, accelerators and incubators from all over the world**, and gives users the possibility of:

- **Interacting** with the project team
- **Accessing contents** relating to published projects,
- **Sending requests** of contact with the Research Teams
- **Retrieving the newest contents** about the innovation ecosystem and,
- **Being contacted** by the other users with proposals

for cooperation.

The project also aspires to scale up at an international level by setting up similar portals in any country that may join the initiative, thus further expanding the possibilities of valorisation of new technologies.

It is clear from the above that 'Knowledge Share' might prove extremely **useful for companies in pinpointing technologies of their interest** to be exploited by means of licence contracts or similar agreements.

As is known, however, **such agreements always require extremely careful drafting** and our in-house attorneys-at-law with long-standing, extensive experience in this area can certainly provide effective consultancy in this respect.



SLOGANS AS TRADEMARKS: A BRIEF REVIEW OF THE ISSUE

It has been scientifically proven that **synthetic, incisive, catchy phrases or sentences** availing themselves of rhythms, rhymes, assonances, alliterations, word plays and other language gimmicks, **can capture consumers' attention** and are easily remembered.

Therefore, **slogans** or **pay-offs** are an **excellent help for companies in making them recognizable** to the public and they are certainly worth considering for registration as trademarks.

However, careful evaluation of the **criteria for a**

slogan to be validly registered is required both at European and Italian level.

The European Position

In line with the provisions of Art. 7 of the EU Trade-mark Regulation (EUTMR), **a trademark** in order to be registered as such **must not be merely descriptive of the goods and/or services** distinguished by them nor be without distinctive character.

On one hand, slogans were initially considered to be laudatory and/or descriptive and therefore void of any distinctive character, but EU case-law subsequently stated that slogans should not be subjected

to more rigid, restrictive evaluation criteria than other forms of trademarks when assessing their distinctive character.

On the other hand, the EU Court of Justice has acknowledged that slogans when compared with other types of trademarks are perceived by the reference public in a different manner and this may make it more difficult to assess or prove their distinctive character.

Consumers' level of attention to promotional indications is indeed usually quite low, i.e., slogans are primarily perceived as laudatory advertising messages rather than as trademarks and this would therefore exclude slogans from being allowed registration.

If, however, the reference public when reading or hearing a slogan, comes to perceive it as an indication of the commercial origin of a good or service, then the slogan can be regarded as being distinctive even if it has also a clearly promotional nature.

As summarized by the European Union Intellectual Property Office (EUIPO) "What has to be established for a refusal is that it will be perceived merely as a promotional slogan and, therefore, incapable of performing the function of distinguishing goods and services, because this 'second' trade mark meaning will not be perceived by the public at all."¹

In particular, **a slogan has distinctive character when it meets the following non-exhaustive criteria laid down by the EUIPO:**

1. it has a **number of meanings**;
2. it constitutes a **play on words**;
3. it introduces elements **of conceptual intrigue or surprise**, so that it may be perceived as imaginative, surprising or unexpected;
4. it has some particular **originality or resonance**, and/or triggers in the minds of the relevant public a cognitive process or requires an interpretative effort;
5. it has **unusual syntactic structures and/or linguistic and stylistic devices** such as alliterations, metaphors, rhymes.

In this respect, it should be noted that the criteria listed above are not applicable in an absolute manner, i.e., independently of one another. In other words, **it is not enough that a slogan has one of the above features for it to be distinctive.**

To mention only one example of unsuccessful registration of a slogan as a trademark, the EU General Court considered the slogan "Create delightful human environments" (13/05/2020, T-49/19, EU:T:2020:197) for distinguishing goods in

Classes 9, 19 and services in Class 37 in relation to glass window units as non-distinctive, because it has a clear meaning and respects the rules of English syntax and grammar, and also because its semantic content, indicating the intended purpose of the designated goods and services, aimed to promote them and not to indicate their origin.

On the other side, the EU General Court considered the slogan "LOVE TO LOUNGE" (15/07/2017, T-305/16, EU:T:2017:607) for distinguishing goods in Class 25, as sufficiently distinctive, because, although it is a syntactically correct combination of English words, the relevant public will have to put some intellectual effort in relating it to the context of clothing, footwear and headgear, and also because the clever use of alliteration and euphony in the phrase.

The Italian Position

The approach of Italy to the issue of the registration of slogans is essentially the **same as the one of the EUIPO.**

Particularly important in this connection is Decision No. 37697/2022 of the Italian Court of Cassation, which denied any distinctive character of the slogan specifically concerned "*La tua pelle merita di essere trattata bene*" ("*Your skin deserves to be treated well*") for goods in Classes 03 and 05 and services in Class 35 pertaining to the cosmetic and pharmaceutical field, because of lack of any linguistic arbitrariness, allusive translation or metaphorical transposition that could differentiate this slogan from a merely promotional formula.

In the very same decision, however, the Italian Court of Cassation, referring also to the case law of the EU Court of Justice, stated that **slogans can be registered as trademarks, provided that in addition to their advertising nature, they also have a distinctive character** indicating the origin of the goods or services protected by them.

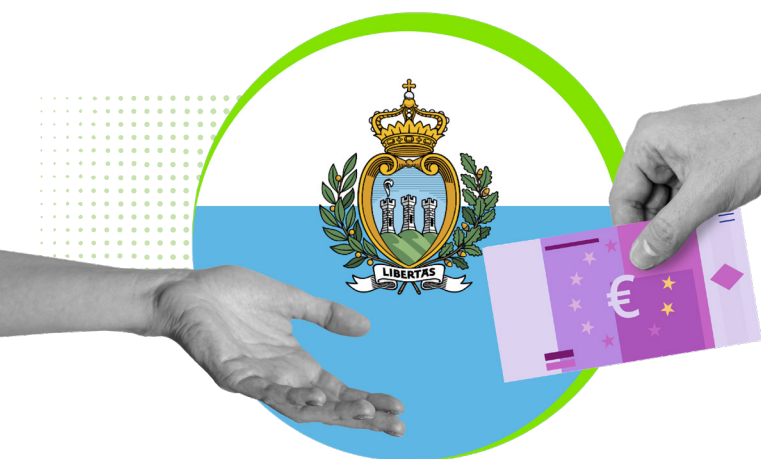
In other words, slogans urging consumers to buy goods and services cannot be excluded from registration as trademarks just because of how the applicant uses or intends to use them.

In the above scenario, it is clear how **important** it is **for companies to carefully choose their slogans not only from a commercial standpoint but also** – if they are going to register said slogans as trademarks – **from the intellectual property viewpoint.**

Seeking **expert guidance from a trademark attorney is therefore crucial** in order to minimize risks of rejection of a slogan as a trademark.

¹ EUIPO 'Case-law Research Report - The distinctive character of slogans effectively' - October 2021

SAN MARINO'S RECENT INCREASE IN TRADEMARK FEES



Now, **filing and renewal fees in the amount of EUR 150.00** (EUR 250.00 for collective marks) **are provided for one class and a fee of EUR 50.00 is applicable to each additional class from the second one on.**

In practice, the increase in the filing and renewal fees only concerns trademarks in three classes, whereas trademarks in one class benefit from a slight reduction and for trademarks in two classes and trademarks over three classes the fee remains unchanged.

Effective **11 March 2024**, the **official fees** applicable to **trademarks in the Republic of San Marino** have been **increased**.

The main difference lies in that before said date the filing and renewal fees for trademarks up to three classes were the same, i.e. EUR 200.00 (EUR 300.00 for collective marks) irrespective of whether the trademark covered one, two or three classes, and a fee of EUR 50.00 was provided for each class from the fourth one on.

Some of our trademark attorneys at Interpatent are also admitted to practice before the Patent and Trademark Office of San Marino and would be happy to advise you as to the best strategy for protecting your trademarks in this country.

The aim of this newsletter is to keep our Clients and Associates updated about developments in the sector of Intellectual Property in general and our firm in particular. In this way, we wish to provide a broader view of the tools that the field of trade marks, domain names, patents, designs and related rights offers to entrepreneurs to enhance and protect their efforts in researching and developing new solutions and ideas.



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