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THE ITALIAN SONG FESTIVAL OF SANREMO: A CULTURAL HERITAGE TO BE DEFENDED ALSO THROUGH INTELLECTUAL PROPERTY RIGHTS

The yearly '**Festival della Canzone Italiana**' (Italian Song Festival) held in the charming Ligurian town of Sanremo is one of the most important and long-running music festivals in the world that Italians of all generations have been attending or watching on TV for more than 70 years.

The Ariston theatre in Sanremo has always been the most coveted stage for artists but also for the organisers of the event, which has a national and international renown.

From this point of view, it is **the Italian public television company RAI** that is in charge, having been entrusted with the organisation of all editions. RAI is the author of the proposed TV format and licensee of the trademark 'FESTIVAL DELLA CANZONE ITALIANA' registered by the Municipality of Sanremo, which has protected the sign worldwide, along with other trademarks attached to the event such as 'FESTIVAL DI SANREMO', 'SANREMO YOUNG' and 'SANREMO FESTIVAL ORCHESTRA'.

RAI's monopoly has, however, recently been called into question by the appeal lodged by the company Just Entertainment with the **Regional Administrative Court (TAR) of Liguria**.

Just Entertainment is a music publishing and production company which, in the past, expressed its willingness to acquire the economic and commercial exploitation rights in the Festival of Sanremo and the related trademark from the Municipality of Sanremo, without, however, receiving any feedback from the latter.

The appeal mainly alleges that the awarding of the exclusive use of the trademark and the organisation of the Festival (and related events) took place without a competition procedure, and thus in breach of the principles of transparency and non-discrimination enshrined in European and Italian law.

With decision No. 843/2024 the TAR of Liguria ruled that the awarding, by the Municipality of Sanremo, of the exclusive rights of the 'Festival

della Canzone Italiana' trademark as well as of the organisation of the 2024 and 2025 editions of the Festival to RAI would have required the adoption of public procedures and therefore came to the conclusion that the direct awarding to RAI had been illegitimate, though leaving the organisation of the 2025 edition of the festival still in the hands of RAI.

The use of direct awarding cannot, in fact, be justified by mere considerations of usual practice, because this cannot prevail over the **need to ensure public evidence and competition on an equal footing among all interested parties**.

The most important aspect here is that the **TAR rejected RAI's argument according to which the format of the Festival is inextricably linked to the trademark**.

This thesis was based on the idea that the format itself, as the 'creative structure' of the event, could not be divorced from the title 'Festival della Canzone Italiana', represented by the trademark registered by the Municipality of Sanremo.

Instead, **the ruling emphasised that the Municipality is the legitimate owner of the trademark and may therefore grant use thereof to other parties**. This right implies that the Municipality can freely associate it with formats other than the current one, as long as the distinctive function of the trademark itself is respected.

The TAR stressed the fact that the trademark represents the title of the event and not an inseparable element of the format, which may be subject to modification or replacement without affecting the legitimacy of the use of the trademark.

The concepts of trademark and copyright are, in fact, often confused with each other.

Instead, these are institutions that pertain to two different legal disciplines and with different effects regarding the rights that derive from them. The distinction between trademark and copyright is, therefore, fundamental in the field of intellectual property, as each offers legal protection for different types of creations.

The **trademark**, whose main function is to distinguish the products and services of one company from those of another company, allows its owner the exclusive use of the trademark and the consequent right to prevent third parties from using an identical or similar sign for identical or similar products and/or services. It may consist of

names, logos, slogans or other symbols representing a brand. In other words, the trademark is a communication vehicle that establishes a link between the product and/or service and the company. The legal protection of a trademark is valid for a potentially unlimited period as it can be renewed perpetually.

The **copyright** protects intellectual works that are original and creative, such as texts, music, visual art and films. Copyright gives the creator exclusive rights to reproduce, distribute and modify the work. However, protection may lapse if the work is significantly modified. Copyright expires 70 years after the author's death.



It should also be pointed out that the author acquires all the rights over the work with the mere creation of the work itself, without the fulfilment of any formalities, such as filing, registration, affixing claims to products etc. The issue for the author is therefore only of an evidentiary nature, as they must be able to prove the authorship of the work and the time of its creation, which is not always easy to demonstrate.

To this end, in Italy the author may use the SIAE (Società Italiana Autori ed Editori = Italian Society of Authors and Publishers) by depositing the work there. There are various deposit methods, depending on the nature of the work to be protected. Television formats – i.e., the central idea and general structure of a television programme – are also susceptible to author

protection and the SIAE provides a special deposit system, called '**Format Deposit**', offered by its DOR (Theatre and Radio-Television Works) section.

The deposit procedure is relatively simple: it requires the completion of a special form (Form 91bis) with the applicant's and authors' data, the filing of a copy of the work in the form of a script and the payment of SIAE fees.

The deposit will be valid for three years and may be renewed for the same duration. If the format is rewritten, however, a new deposit must be made. If only the title changes, on the other hand, it will be sufficient to notify the SIAE without a new filing.

Both protection systems therefore aim to safeguard intellectual creations and prevent unauthorised use by third parties. Both trademarks and copyrights offer owners legal tools to defend their works. However, while trademarks focus on commercial identity and distinction in the marketplace, copyright deals with the protection of artistic and literary

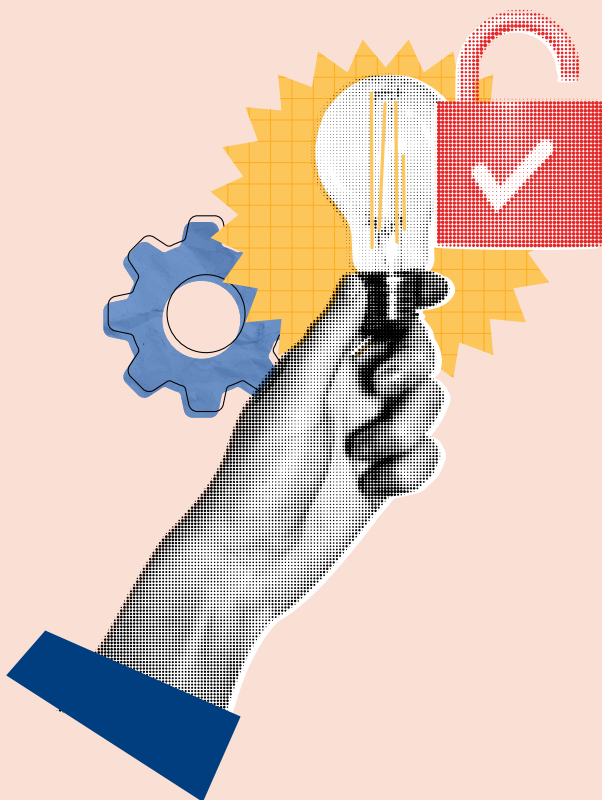
creations. Understanding these differences is crucial for companies and creators who wish to adequately protect their works and brands.

The Italian legal system provides for the so-called possibility of cumulation of protection, making it possible to file a trademark and a copyright simultaneously. Take, for example, labels on wine bottles: these can be protected either by filing a figurative trademark or by filing the image as an unpublished work with the SIAE, or both.

The suggestion is, therefore, to take advantage of both tools, creating significant business assets that can be commercially exploited - for example by licensing them to third parties - increasing the visibility and recognition of one's company in the market.

Do not hesitate to contact our professionals to evaluate with them the best tool to protect and enhance your Clients' corporate assets!

NEW PERSPECTIVES ON DESIGN PROTECTION: THE IMPACT OF THE DESIGN LAW TREATY



After the [EU Design Reform](#), here is another piece of news from the design world: on 22 November 2024 the World Intellectual Property Organization (WIPO) adopted the [Design Law Treaty](#).

The Treaty, which saw the light of day during the Diplomatic Conference held in Riyadh, Saudi Arabia, after almost 20 years of preparatory work, aims at global harmonization and simplification of part of the procedural aspects of design protection, in order enable designers, especially smaller designers as well as microenterprises and SMEs, to protect their creations in an easier and more cost-effective manner.

At present, design protection varies from country to country and therefore country-specific filing procedures must be followed, as design rights are territorial, limited to the country where protection is obtained. The Treaty aims to make these procedures more predictable and less complex. Among the Treaty provisions that stand out for their impact on procedural simplification are the following:

- A **maximum list of indications or elements that design applicants must submit with a design application** is set, with the explicit prohibition of adding further requirements.

Establishing a finite list of elements will help form a predictable framework for design protection procedures and reduce administrative burdens.

- Applicants are allowed to **choose how to represent the design** in an application, i.e. by drawings, photographs, videos (the latter only if allowed by the specific competent IP office) or a combination thereof, in colour or black and white; the use of dotted lines, for portions that are not part of the design to be protected, and shading is also allowed; also, there is no minimum or maximum number of views required.

The simplification introduced is obvious and will allow applicants not to have to worry about having an application rejected due to specific requirements of individual IP offices.

- There are established **sufficient minimum requirements for obtaining a filing date**, i.e. an indication, even implicit, that the submitted elements represent an application, information to identify and contact the applicant or their authorised representative and a sufficiently clear representation of the design.

This ensures that applicants will be able to obtain a filing date without delay, even if certain formalities are dealt with later, without the risk of having the filing date postponed.

- There is a **grace period** of 12 months after the first disclosure of the design, during which such disclosure does not affect the validity of an application for that design.

Thanks to this provision, applicants will be able to 'test the market' for 12 months before applying for a design, without worrying about grace period provisions varying from one jurisdiction to another.

- Applicants are allowed to **keep their designs unpublished** for at least six months after obtaining the filing date.

Deferring publication will allow for greater control over the timing of the initial release of the product covered by the design. Having a

common minimum period for such deferral will ensure that the benefits of deferral are not nullified by publication in a country with a shorter deferral period (or no deferral at all).

- Measures are provided to **remedy failure to meet a deadline** or other omissions and errors (e.g. claiming priority).

Such measures will advantageously prevent applicants from irreparably losing their rights due to such failures.

- The procedure for **requesting renewal** of a design registration is simplified by setting a maximum list of indications that a renewal request must contain in order to obtain renewal, with the explicit prohibition for IP offices to request further indications.

Again, as with first filing, establishing a finite list of indications for design renewal will help to form a more predictable framework and reduce administrative burdens.

- The introduction of **electronic filing systems** for designs and the electronic exchange of priority documents is promoted, with a view to procedural simplification and relief of administrative burdens.

The number of design filings underwent a remarkable increment worldwide in 2023, Italy ranking fourth for the highest number of design applications - after China, USA and Germany - but first for the growth rate of such applications among the top 5 applicant countries.

With the increasing acknowledgement of the importance of designs in global economy, the hope is that the new Treaty will allow designers to achieve even better protection and safeguarding of their creations all over the world.

The Treaty requires ratification by at least 15 WIPO countries to enter into force.

Keep following us on our channels for updates on the entry into force of the Treaty and other important news from the world of Intellectual Property.

FLASH NEWS FROM THE PATENT WORLD



Brazil Extends the PPH Programme with EPO

The Brazilian National Institute of Industrial Property (INPI Brazil) has extended its cooperation with EPO in respect of the Patent Prosecution Highway (PPH) programme until 30 November 2029 and also widened the scope of said programme so that the EPO will benefit from the latest international search report (ISR), international preliminary examination (IPER) or international written opinion (WO) issued by INPI Brazil acting as an International Searching Authority (ISA).

New Zealand Has Joined the PPH

As from 1 December 2024, a Patent Prosecution Highway (PPH) pilot is effective between the Intellectual Property Office of New Zealand and EPO.

Uruguay About to Join the PCT

On 7 January 2025 Uruguay will join the **Patent Cooperation Treaty (PCT)**, thus bringing the number of member countries to 158.

In this connection, it is worth noting that according to a reservation made by Uruguay, the Uruguayan Patent Office shall not be bound by Chapter II of the PCT, i.e. it will not be bound by the outcome of the International Preliminary Examination.

Therefore, there are 17 national IP offices having PPH agreements currently in place with EPO, namely the IP offices of Japan, South Korea, China, USA, Australia, Brazil, Canada, Chile, Colombia, Israel, Malaysia, Mexico, New Zealand, Peru, the Philippines, Singapore and Saudi Arabia.

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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INTERPATENT Studio Tecnico Brevettuale S.R.L. - Registered Office Via Caboto, 35 - 10129 TORINO - Share Capital € 50000
Company Register of Torino 08327040013 - Fiscal Code and VAT Registration Number 08327040013
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email@interpatent.com - www.interpatent.com