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Italian Sounding

Navigating IP Enforcement Challenges in the USA and Europe

The American perspective presented by:

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Relevant U.S. IP Law

- Big “buckets” of IP protection in the U.S. are patent, trademark, copyright, and trade secret
- The Italian Sounding problem—and others like it—has not been as directly addressed in the U.S. as it has in Italy and throughout Europe
- Trademark law is most relevant IP right
 - Suits for false designation of origin
 - Geographic indications
 - Certification marks
 - Collective marks



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False Designation of Origin

“Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which . . . in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person’s goods, services, or commercial activities,

Challenges Applying Trademark Law to the Italian Sounding Problem

- “Genericide”
- “Merely descriptive”
- Trademarks must be diligently enforced or rights can be lost



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Enforcing IP in the U.S.

- U.S. litigation is very expensive
- Venue is a critical consideration
- Injunctions are less available
 - Trademark law can be an exception to that
- Cases ultimately decided by non-expert juries

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Thank You! Questions?

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