

METAVERSO AGGIORNAMENTI E PROSPETTIVE

Raffaella BARBUTO
Milano, 11 maggio 2023



Casistica

Dinanzi all'EUIPO:

- decisioni esame d'ufficio
- decisioni opposizioni

Controversie tra parti

- Hermès v. Mason Rothschild (METABIRKIN) 14/2/2023
- Yuga Labs v. Ryder Ripps and Jeremy Cahen : RRBAYC contro BAYC (BORED APE YACHT CLUB) 21/04/2023
- Juventus v. Blockareas S.r.l. (NFT con immagine Vieri) Tribunale di Roma 20/7/2022

Collegio Italiano dei Consulenti in Proprietà Industriale

Casistica dinanzi all' EUIPO



FÉDÉRATION INTERNATIONALE DES CONSEILS
EN PROPRIÉTÉ INTELLECTUELLE


INTERNATIONAL FEDERATION OF
INTELLECTUAL PROPERTY ATTORNEYS

INTERNATIONALE FEDERATION
VON PATENTANWÄLTEN

Caso Burberry

018647205

[+ info](#)



Trade mark information

Trade mark number

018647205

Type

Figurative

Filing date

02/02/2022

Registration date

Nice Classification

9, 35, 41

Trade mark status

Application under examination

Basis

EUTM

Reference

BUR138.UEU82

Owner information

Owner ID number

18441

Owner name

BURBERRY LIMITED

Representative information

Representative ID num...

90166

Representative name

TAYLOR WESSING N.V.

- 9**Non-fungible tokens (NFTs) or other digital tokens based on blockchain technology; downloadable digital graphics; downloadable digital collectibles; downloadable clothing and accessories; downloadable interactive characters, avatars and skins; downloadable virtual goods; virtual bags, textile goods, clothing, headgear, footwear, eyewear all displayed or used online and/or in virtual environments; video games and downloadable video game software; downloadable digital materials, namely, audio-visual content, videos, films, multimedia files, and animation, all delivered via global computer networks and wireless networks.
- 35**Retail and wholesale services for clothing, footwear, headgear, bags, purses, wallets, umbrellas, watches, jewellery, eyewear and sunglasses, cases and covers holders for portable electronic devices, printed matter, homeware, toys, perfume, toiletries and cosmetics, textile goods, pet accessories; online retail services related to fashion, clothing and related accessories; Retail store services and/or online retail store services in relation to virtual merchandise namely clothing, footwear, headgear, bags, purses, wallets, umbrellas, watches, jewellery, eyewear and sunglasses, cases and covers holders for portable electronic devices, printed matter, homeware, toys, perfume, toiletries and cosmetics, textile goods, pet accessories; presentation of goods on communication media, for retail purposes.
- 41**Providing online non-downloadable digital collectibles namely art, photographs, clothing and accessories, images, animation, and videos; providing on-line information about fashion shows, digital games and sustainability; entertainment services, namely providing on-line, non-downloadable virtual content featuring clothing, footwear, headgear, bags, purses, wallets, umbrellas, jewellery, eyewear and sunglasses, cases and covers holders for portable electronic devices, printed matter, homeware, toys, perfume, toiletries and cosmetics, textile goods, pet accessories, for use online and/or in virtual environments; providing online video games; provision of online information in the field of computer games entertainment; entertainment services, namely, providing online electronic games, providing a website with non-downloadable computer games and video games, computer interface themes, enhancements, audio-visual content in the nature of music, films, videos, and other multimedia materials.

Caso Burberry

decisione rifiuto parziale 8/2/2023 – non appellata

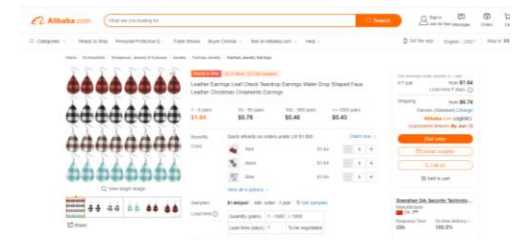
.....«The Office states that a combination of elements forming a check pattern is obvious and typical for the goods and not essentially different from other check patterns commonly found in the trade. The Office notes that the consumer's perceptions for real-world goods can be applied to equivalent virtual goods as a key aspect of virtual goods is to emulate core concepts of real-world goods.

The pattern depicted by the mark is not markedly different from various basic patterns commonly used in the trade for the goods and services for which an objection has been raised. This fact is supported by the following internet searches:

<https://www.boohoo.com/check-back-print-raw-hem-shirt/5ZZ32599.html>



https://www.alibaba.com/product-detail/Leather-Earrings-Leaf-Check-Teardrop-Earrings_1600100059240.html



e altri Citati nella decisione

Caso Burberry

decisione rifiuto parziale 8/2/2023 – non appellata

The application 018647205











may proceed for the remaining goods and services, namely:

Class 9 Downloadable interactive characters, avatars and skins; Video games and downloadable video game software.

Class 41 Providing on-line information about digital games; Providing online video games; Provision of online information in the field of computer gamesentertainment; Entertainment services, namely, providing online electronic games, providing a website with non-downloadable computer games and video games.

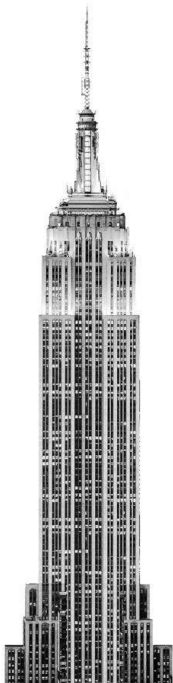
Burberry Comunque il famoso pattern è tutelato

Search for Trade marks with Owner name contains "BURBERRY LIMITED" and Trade mark type like Figurative, sorted by Trade mark number, Descending. Bulletin created 10-5-2023-15:55:6												
Filing number	Graphic representation	Basis	Type	Filing date/ Designation date	Registration date	Expiry date	Nice classes	Status	Owner name	Owner country	Acquired distinctiveness	
018295696		EUTM	Figurative	19/7/2004	27/9/2005	19/7/2024	25	Registered	BURBERRY LIMITED	GB	false	
018295228		EUTM	Figurative	19/7/2004	27/9/2005	19/7/2024	24	Registered	BURBERRY LIMITED	GB	false	
018293135		EUTM	Figurative	19/7/2004	27/9/2005	19/7/2024	18	Registered	BURBERRY LIMITED	GB	false	
008981508		EUTM on which IA is based	Figurative	25/3/2010	20/9/2010	25/3/2030	9	Registered	BURBERRY LIMITED	GB	false	
003940442		EUTM	Figurative	19/7/2004	27/9/2005	19/7/2024	4, 8, 9, 16, 20, 21, 23, 26, 27, 28	Registered	BURBERRY LIMITED	GB	false	
2701498		EUTM	Figurative	14/5/2002	12/1/2004	14/5/2032	9, 14, 16 Sunglasses, combined sunglasses and goggles, goggles, spectacles, optical glasses, fitted frames and lenses for the aforesaid goods; cases and holders for the aforesaid goods; parts and fittings for all the aforesaid goods; cases and holders for portable computers and mobile telephones. 14Watches, clocks and parts and fittings for all the aforesaid goods, wrist watches and straps and bracelets therefor and pocket watches, jewellery, imitation jewellery, tie-pins and cuff links; articles included in class 14 made of precious metals or coated therewith. 16Paper, paper articles, cardboard articles; wrapping and packaging materials; printed matter, books, stationery, pencils, labels, cards, diaries, agendas, note books, folders, ring binders and ribbon.	Registered	BURBERRY LIMITED	GB	false	
1591601		EUTM	Figurative	27/3/2000	15/2/2002	27/3/2030	3, 9, 35 35 Retail services for clothing, bags, shoes and accessories, perfumes and toiletries, food and drink, watches, optical frames, luxury items and accessories.	Registered	BURBERRY LIMITED	GB	false	
000377580		EUTM	Figurative	8/10/1996	21/6/1999	8/10/2026	18, 24, 25	Registered	BURBERRY LIMITED	GB	false	

EUIPO – rifiuti per carenza capacità distintiva

EUTM 018652011
10/2/2022

Titolare: ESRT
Empire State
Building, L.L.C.



9: Downloadable computer software in the nature of non-fungible tokens (NFTs); non-fungible tokens (NFTs); digital materials, namely, non-fungible tokens (NFTs); non-fungible tokens used with blockchain technology; non-fungible tokens featuring collectible items; digital tokens used with blockchain technology; digital assets authenticated by non-fungible tokens (NFTs); downloadable virtual goods, namely, non-fungible tokens; downloadable image files containing artwork authenticated by non-fungible tokens (NFTs); downloadable multimedia files containing video authenticated by non-fungible tokens (NFTs); downloadable multimedia files containing audio authenticated by non-fungible tokens (NFTs); downloadable multimedia files containing text authenticated by non-fungible tokens (NFTs); downloadable multimedia files containing artwork authenticated by non-fungible tokens (NFTs); downloadable multimedia files containing artwork, text, audio, and video authenticated by non-fungible tokens (NFTs).

EUIPO - decisione del 22/9/2022 non appellata

“The relevant public would simply perceive the figurative sign as a non-distinctive image of the empire state building, a world-famous skyscraper, conveying that non-fungible token in class 9 are intended to authenticate a downloadable image of the empire state building, and that downloadable multimedia files authenticated by non-fungible tokens have for subject matter the empire state building. Therefore, the relevant public will not tend to see in the sign any indication of commercial origin, but merely information about the subject matter or the intend purpose of the goods”

EUIPO – rifiuti per carenza capacità distintiva

Depositi classi 9 (software per prodotti virtuali) e
servizi 35, 36 41, 42

- Esame capacità distintiva severo
- Molti rifiuti, soprattutto marchi denominativi con componente descrittiva
- Spesso titolari non replicano

EUIPO – opposizioni

Similitudine tra prodotti reali e software per visualizzare prodotti virtuali e NFT

- Al momento non ho trovato pronunce specifiche

Servizi

- **B 3167431 decisione 24/4/2023 : marchi identici LORD TOKEN:** The contested *financial exchange of virtual currency; financial exchange of crypto assets* are included in the opponent's broad category of *financial management*. Therefore, they are identical

*Collegio Italiano dei
Consulenti in Proprietà Industriale*

Controversie (giudiziarie) tra le parti



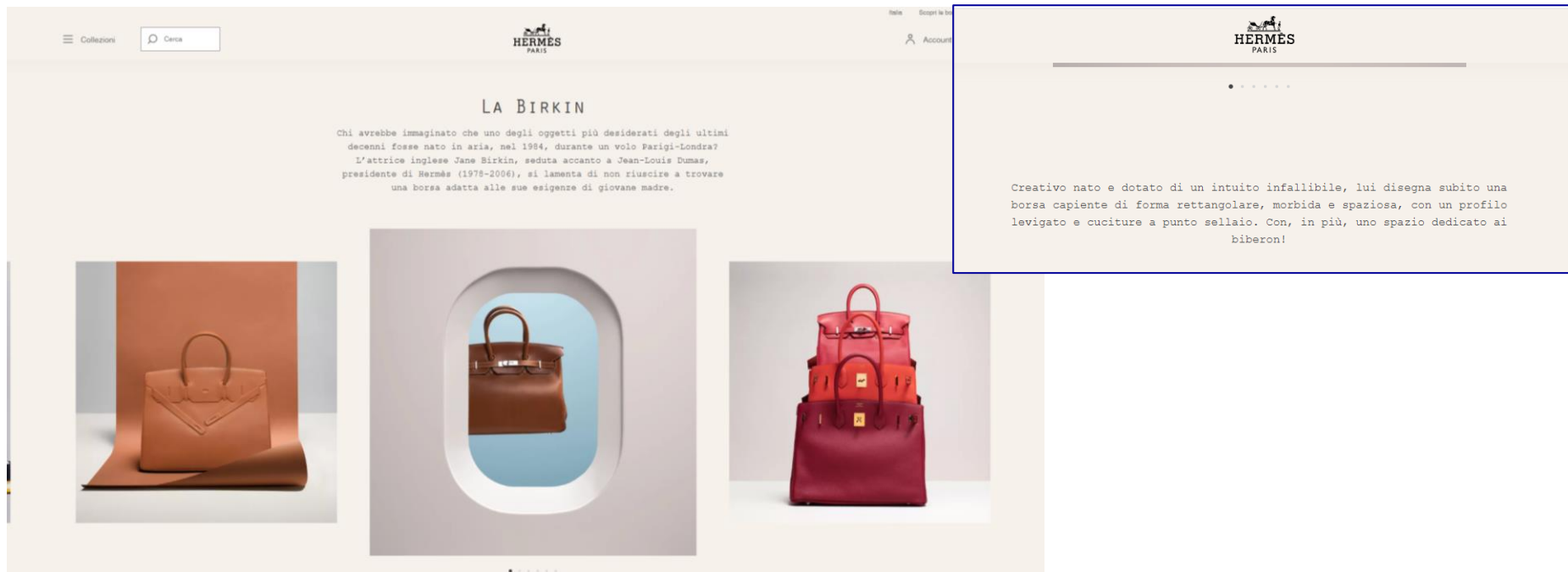
FÉDÉRATION INTERNATIONALE DES CONSEILS
EN PROPRIÉTÉ INTELLECTUELLE

INTERNATIONAL FEDERATION OF
INTELLECTUAL PROPERTY ATTORNEYS

INTERNATIONALE FEDERATION
VON PATENTANWÄLTEN

Hermès v. Mason Rothschild

LA BIRKIN



<https://www.hermes.com/it/it/story/297713-birkin/>

Chi è Mason Rothschild

È un artista americano che ha creato e venduto (42.000 \$) il primo NFT METARBIRKIN ad inizio dicembre 2021, come un «tributo a Hermès»

Progetto ironico e provocatorio alla asserita politica «fur free e cruelty free» di Hermes



Il giudizio avviato da HERMES dinanzi Corte New York nel gennaio 2022

- Hermes, previa diffida, avvia quindi causa per contraffazione marchio, concorrenza sleale (sfruttamento parassitario, appropriazione di pregi e ingannevolezza sull'origine del prodotto) e cybersquatting per www.metabirkins.com e account nei social
- Hermes ha prodotto esito di ricerche di mercato attestanti la confusione ingenerata tra i consumatori

La difesa di Mason Rothschild

- METABIRKIN è un progetto artistico che usa il marchio altrui, ma non lo viola
- Espressione artistica tutelata dalla libertà di espressione prevista dal Primo Emendamento della Costituzione USA
- Progetto artistico al pari delle immagini di Andy Warhol che ha usato marchi di altri (es. zuppe Campbell)

L'opinione del Giudice Rakoff

Test valutativo su principi decisione «Rogers» sulla liceità dell'espressione artistica

Il Giudice non si è sostanzialmente pronunciato ed ha lasciato l'interpretazione al giudizio della Giuria

“Because reasonable individuals could reach different conclusions on the “artistic relevance” factor, the Court denies both parties’ summary judgment motions on it”

Hermès International v. Rothschild (1:22- cv-00384), Order of February 2, 2023, p. 22



L'opinione del Giudice Rakoff

Principi del caso «Polaroid» in merito al reale rischio di confusione per i consumatori

Rakoff drew eight relevant considerations:

- “(1) the strength of Hermès’ mark, with a stronger mark being entitled to more protection;*
- (2) the similarity between Hermès’ “Birkin” mark and the “MetaBirkins” mark;*
- (3) whether the public exhibited actual confusion about Hermès’ affiliation with Rothschild’s MetaBirkins collection;*
- (4) the likelihood that Hermès will “bridge the gap” by moving into the NFT space;*
- (5) the competitive proximity of the products in the marketplace;*
- (6) whether Rothschild exhibited bad faith in using Hermès’ mark;*
- (7) the respective quality of the MetaBirkin and Birkin marks; and, finally,*
- (8) the sophistication of the relevant consumers.”*

Hermès International v. Rothschild (1:22-cv-00384), Order of February 2, 2023, p. 23

Il verdetto della GIURIA dell'8/2/2023 condanna Mason Rothschild

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

HERMÈS INTERNATIONAL and
HERMÈS OF PARIS, INC.,

Plaintiffs,

-v-

MASON ROTHSCHILD,

Defendant.

1:22-cv-384-JSR

VERDICT

1. On Hermès' claim for trademark infringement, we the jury find the defendant Mason Rothschild:

Liable ☒

Not Liable ☐

2. On Hermès' claim for trademark dilution, we the jury find the defendant Mason Rothschild:

Liable ☒

Not Liable ☐

3. On Hermès' claim for cybersquatting, we the jury find the defendant Mason Rothschild:

Liable ☒

Not Liable ☐

[If you find "Not-Liable" on all of the above claims, leave the remaining three questions blank. If you find "Liable" on one or more of the above claims, proceed to Question 4.]

4. Having found the defendant liable for trademark infringement and/or trademark dilution and/or cybersquatting, we the jury find that the First Amendment protection nonetheless:

Bars Liability ☐

Does Not Bar Liability ☒

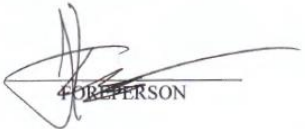
[If you find "Bars Liability" on the above question, leave Questions 5 and 6 blank. If you find "Does Not Bar Liability," proceed to Questions 5 and 6.]

5. Having found the defendant liable for trademark infringement and/or trademark dilution and having further found that the First Amendment protection does not bar liability, we the jury award Hermès the following net profits earned by Mason Rothschild:

\$ 110,000

6. Having found the defendant liable for cybersquatting and having further found that the First Amendment protection does not bar liability, we the jury award Hermès the following statutory damages for cybersquatting:

\$ 23,000


FOREPERSON

Date: 2/08/2023

Yuga Labs v. Ryder Ripps and Jeremy Cahen **caso BORED APE YACHT CLUB (BAYC)**

21/04/2023 Central District of California



Yuga Labs Inc. & BORED APE YACHT CLUB (BAYC)



WELCOME TO THE BORED APE YACHT CLUB

BAYC is a collection of 10,000 Bored Ape NFTs—unique digital collectibles living on the Ethereum blockchain. Your Bored Ape doubles as your Yacht Club membership card, and grants access to members-only benefits, the first of which is access to THE BATHROOM, a collaborative graffiti board. Future areas and perks can be unlocked by the community through roadmap activation.



THE BATHROOM

The BAYC Bathroom will become operational once the presale period is over. It contains a canvas accessible only to wallets containing at least one ape. Like any good dive bar bathroom, this is the place to draw, scrawl, or write expletives.

Each ape-holder will be able to paint a pixel on the bathroom wall every fifteen minutes. Think of it as a collaborative art experiment for the cryptosphere. A members-only canvas for the discerning minds of crypto twitter.

We're pretty sure it's going to be full of dicks.



<https://boredapeyachtclub.com/#/home>



FÉDÉRATION INTERNATIONALE DES CONSEILS
EN PROPRIÉTÉ INTELLECTUELLE
INTERNATIONAL FEDERATION OF
INTELLECTUAL PROPERTY ATTORNEYS
INTERNATIONALE FEDERATION
VON PATENTANWÄLTEN

Raffaella Barbuto ©

Ryder Ripps ed il sito <https://gordongoner.com/> le accuse di razzismo contro BORED APE YACHT CLUB (BAYC)

For information on Yuga Labs cultural fraud please see the following page. For information concerning

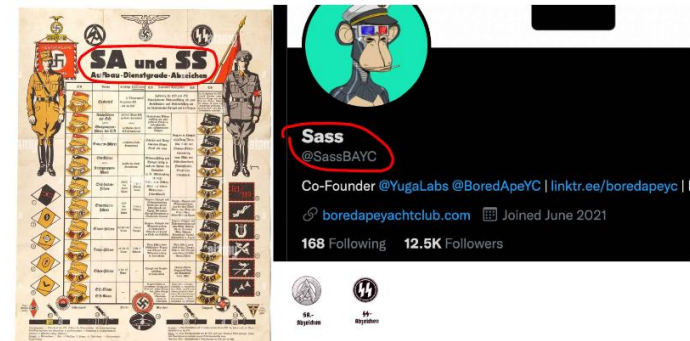
Bored Ape Yacht Club is Racist and Contains Nazi Dog Whistles



[Bored Ape Yacht Club](#) (BAYC) is a series of 10,000 anthropomorphized ape cartoons sold as NFTs. Since the project's launch in April 2021 the value has amassed to over \$5B USD and spawned many similar projects. The apes have various clothing and other traits, most traits are racially oriented or involve some type of military history. The act of disparaging someone by comparing them to an ape/monkey goes back hundreds of years. There is a word for it, "[simianization](#)." There are many examples throughout history, its purpose is to justify violence and racism against another group by dehumanizing them, comparing them to apes. Simianization has occurred with various ethnic groups such as Jewish, Irish and Asian people, but it is most predominantly used as a tactic against Black people. You might think simianization is something of a past era, but racists are still comparing Black



5. Another co-founder goes by [Gordon Goner](#), says he picked the name because it sounds like "Joey Ramone".. being that the group [uses anagrams](#) and that it doesn't at all sound like Joey Ramone, maybe this is an anagram. Sure enough its a whole word anagram for, Drongo (Gordon) Negro (Goner), Drongo is common 4chan and Australian [slang for stupid](#), its in the dictionary as such, [second definition](#).. So, his name means "Stupid Negro." Writers [often](#) use anagrams for character names and they are also often incorporated within [videogames](#), some of which Yuga Labs have [stated](#) they play. Gordon Goner's real name, Wylie Aronow, was disclosed early February, there is barely anything online about him. The one person I could find who knows him says "[I have no doubt that they're cryptofascists](#)".



Ryder Ripps e la creazione dei suoi NFT chiamandoli RR/BAYC



On June 14th, 2021 I re-minted CryptoPunk #3100 on the Ethereum Blockchain, an image whose original token sold for a record \$7.58M USD on March 11th, 2021.

The #3100 mint tested the boundaries and meaning of digital images within a new paradigm of IP law, copyright, computer generated images and Non-Fungible Tokens. The work was delisted from the platform Foundation after I received a **Digital Millennium Copyright Act (DMCA)** notice from Larva Labs. I successfully countered the DMCA and #3100 was subsequently re-listed, sending a strong message that you can't copy an NFT.

My recent NFT work has been centered around provocations and inquiries regarding the nature of NFT, provenance and digital ownership. Provenance has always been the definitive aspect in establishing an artwork's meaning and value. The technology of NFTs is widely misunderstood, but in its greatest form, it enables an immutable trace of origin in time to the publisher/creator of a digital work.

Since December of 2021, I have been investigating the most prominent NFT project, Bored Ape Yacht Club and its creators, Yuga Labs. Through months of intensive research, myself and other community members have discovered extensive connections between BAYC and subversive internet nazi troll culture. You can read the findings at <http://GordonGoner.com>, warning this website contains sensitive content not suitable for children.

On Wednesday, May 13th 2022, I began creating new work in the form of NFTs, based on the BAYC images. Through the process of "re-minting", the original BAYC images are recontextualized – illuminating truths about their origins and meanings as well as the nature of Web3 – the power of NFTs to change meaning, establish provenance and evade censorship.

RR/BAYC uses satire and appropriation to protest and educate people regarding The Bored Ape Yacht Club and the framework of NFTs. The work is an extension of and in the spirit of other artists who have worked within the field of **appropriation art**.

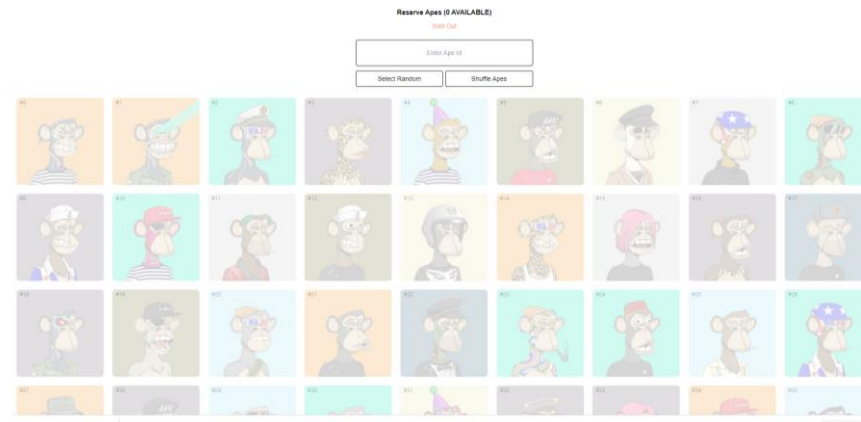
This collection was delisted from the Foundation marketplace on May 17th, 2022 when Yuga Labs sent a DMCA takedown request. Two hours later Yuga Labs **formally capitulated, withdrawing their DMCA request**. The current terms of ownership set forth by Yuga Labs to BAYC token holders are unclear and do not meet current copyright standards. Clearly defining what we are buying when we purchase an NFT is one of the primary goals of this work.

Please have a look at the works available and reserve what you like.

If you have any questions feel free to contact me at rrbayc@protonmail.com.

- Ryder Ripps

■ <https://rrbayc.com/>



La causa

- Fine luglio 2022 Yuga Labs cita Ryder Ripps per contraffazione marchio BAYC (usato, non registrato), concorrenza sleale, arricchimento indebito, pubblicità falsa ed ingannevole etc.
- Ryder Ripps si difende sostenendo di essere un «conceptual artist»

La decisione

- L'uso dei marchi BAYC (BORED APA YATCH CLUB) non è a fini meramente artistici, ma ha una finalità commerciale.
- Non si applicano i principi del caso «Rogers»
- C'è un rischio di confusione ed un indebito uso del marchio altrui

Case 2:22-cv-04355-JFW-JEM Document 225 Filed 04/21/23



La decisione

Case 2:22-cv-04355-JFW-JEM Document 225 Filed 04/21/23 Page 22 of 22 Page ID
#:17476

IV. Conclusion

For all the foregoing reasons, Yuga's Motion is **GRANTED in part and DENIED in part**. Yuga is **GRANTED** summary judgment as to its first cause of action for false designation of origin under 15 U.S.C. § 1125(a) and as to its third cause of action for cybersquatting under 15 U.S.C. § 1125(d). Yuga is also **GRANTED** summary judgment on Defendants' second affirmative defense alleged under the First Amendment/*Rogers*, Defendants' third affirmative defense alleging fair use, Defendants' seventh affirmative defense alleging unclean hands, and Defendants' first counterclaim alleging a knowing misrepresentation of infringing activity. Yuga's Motion is **DENIED** with respect to a determination of Yuga's damages on its first cause of action for false designation of origin under 15 U.S.C. § 1125(a) and third cause of action for cybersquatting under 15 U.S.C. § 1125(d).

IT IS SO ORDERED.



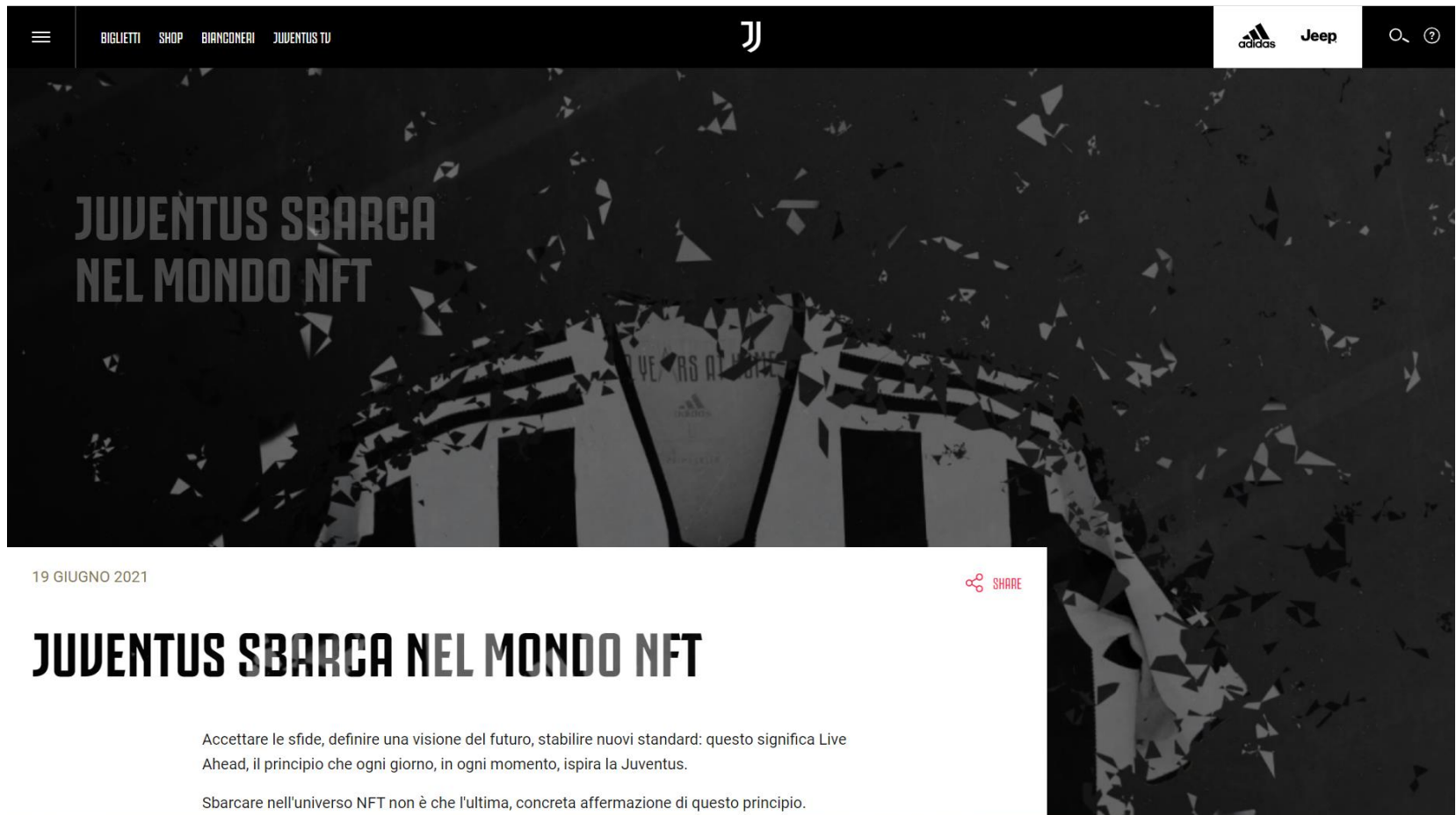
Juventus v. Blockareas S.r.l.

TRIBUNALE DI ROMA 20/7/2022

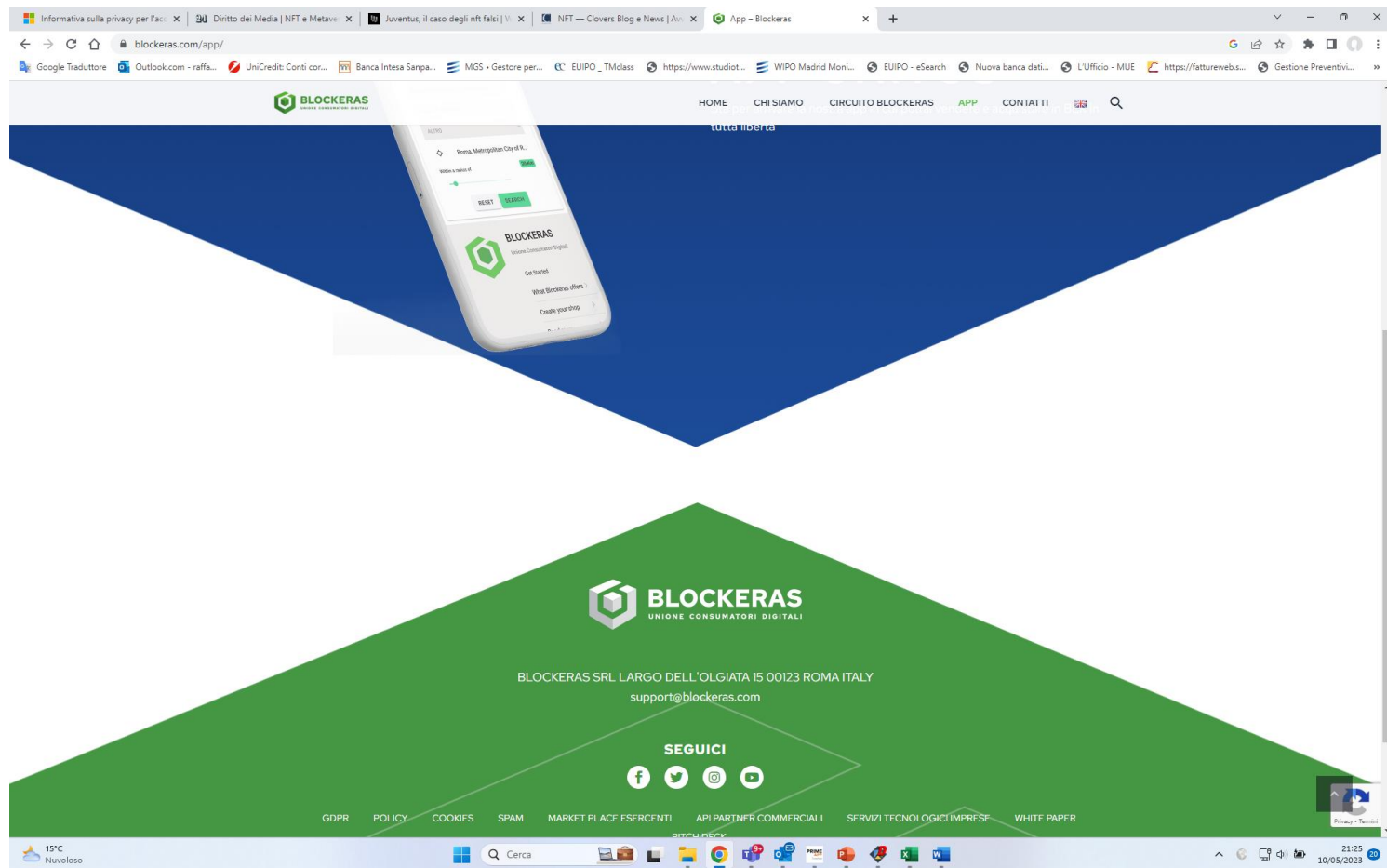
ORDINANZA NON OGGETTO DI RECLAMO



Juventus



Blockareas S.r.l.



Juventus v. Blockareas S.r.l.

- Blockareas Srl produce e commercializza «*carte da gioco digitali NFT*» con immagine di Vieri, **anche con la maglia della Juventus** e l'indicazione del nome della squadra
- Juventus FC SpA avvia procedimento cautelare presso Tribunale di Roma, con richiesta inibitoria alla vendita in qualunque forma degli NFT con i marchi Juventus e ritiro dal commercio, rimozione da siti etc.
- **Caso di concorrenza sleale e contraffazione di marchio**

Juventus v. Blockareas S.r.l.

Ordinanza 20/7/2022

Juventus è titolare di marchi registrati in classe 9 inerenti anche a pubblicazioni elettroniche scaricabili

Secondo il Giudice è «dato notorio che i marchi riguardano la squadra di calcio italiana più titolata e con maggiori tifosi in Italia e all'estero»

Ne risulta la notorietà dei marchi

Juventus v. Blockareas S.r.l.

Ordinanza 20/7/2022

«A prescindere dalle caratteristiche telematiche della card in questione , la società resistente, oltre a utilizzare l'immagine del giocatore Vieri nei limiti del contratto di utilizzazione dell'immagine stipulato con la società che ne gestisce i diritti all'immagine, ha utilizzato senza autorizzazione anche i marchi della società Juventus».

«l'utilizzazione dei marchi in oggetto non può essere giustificata dall'interesse alla pubblicazione dell'immagine del personaggio notorio (Vieri) né sono giustificate da un'esigenza pubblica di informazione»

Juventus v. Blockareas S.r.l.

Ordinanza 20/7/2022

«si ritiene che la creazione e commercializzazione della CARDS comporti una **contraffazione dei marchi** in oggetto concretizzando il rischio di confusione, determinato dalla identità dei segni utilizzati tale da potere indurre in errore il pubblico circa la sussistenza di un legame commerciale»

«Si ritiene , altresì, che operando la Juventus anche nel settore commerciale in parola ed essendo i marchi registrati per categorie comprendenti anche detto tipo di attività, la condotta della resistente integri anche un'ipotesi di **concorrenza sleale** in conseguenza dell'uso non autorizzato di marchi altrui (funzione distintiva del marchio) e dell'appropriazione di pregi (funzione attrattiva del marchio)»

Juventus v. Blockareas S.r.l.

Ordinanza 20/7/2022

Accoglimento totale del 20/07/2022

RG n. [REDACTED]

Repert. n. [REDACTED] del 20/07/2022

-inibisce alla [REDACTED], entro dieci giorni dalla comunicazione dell'ordinanza, l'ulteriore produzione, commercializzazione, promozione e offerta in vendita, diretta e/o indiretta, in qualsivoglia modo e forma, degli NFT (non-fungible token) e dei contenuti digitali di cui in narrativa, nonché di ogni altro NFT (non-fungible token), contenuto digitale o prodotto in genere recante la fotografia di cui in narrativa, anche modificata, e/o i marchi Juventus di cui in narrativa, nonché l'uso di detti marchi in qualsiasi forma e modalità;

-ordine alla predetta società resistente di ritirare dal commercio e rimuovere da ogni sito internet e/o da ogni pagina di sito internet direttamente e/o indirettamente controllati dalla stessa su cui tali prodotti sono offerti in vendita e/o pubblicizzati, gli NFT (non-fungible token) ed i contenuti digitali ad essi associati o prodotti in genere oggetto di inibitoria;

fissa la penale, in caso di eventuale ritardo nell'esecuzione del presente provvedimento ovvero di violazione dell'inibitoria, di euro 500,00 per ogni girono di ritardo o violazione;

rigetta la residua richiesta cautelare;

-condanna la [REDACTED] alla rifusione, in favore della Juventus Football Club s.p.a., delle spese di fase che si liquidano complessivamente in euro 5.518,00, di cui euro 5.000,00 per compensi ed euro 518,00 per spese, oltre il rimborso delle spese generali, I.V.A. e C.P.A. come per legge.

Si comunichi.

Roma, 19 luglio 2022.

Il Giudice

Alfredo Landi

Juventus v. Blockareas S.r.l.

Ordinanza 20/7/2022

Note interessanti:

- I marchi (di rinomanza e notorietà) della Juventus erano registrati in classe 9, anche se non espressamente per gli NFT ed è stato sufficiente per ottenere tutela
- Autorizzazione all'uso dell'immagine del calciatore e diritto d'autore ininfluenti: affermata contraffazione per il sol fatto di aver usato i marchi della Juventus
- Problemi pratici esecuzione della decisione: ritirare dal commercio gli NFT già venduti: **problema pratico di adempimento dell'inibitoria in quanto tali beni digitali sono fuori dalla disponibilità della medesima**

Conclusioni

Si aprono scenari interessanti per la tutela dei diritti dei Titolari di marchi ed è necessaria cautela

Enforcement e dimostrazione del rischio di confusione

Marchi di rinomanza e notorietà ottengono / hanno ottenuto tutela

Marchi «normali» necessarie registrazioni adeguate e tutela anche contrattuale (simile ad ipotesi di merchandising)

Collegio Italiano dei Consulenti in Proprietà Industriale

GRAZIE

Raffaella BARBUTO

barbuto@studiotorta.it



FÉDÉRATION INTERNATIONALE DES CONSEILS
EN PROPRIÉTÉ INTELLECTUELLE

INTERNATIONAL FEDERATION OF
INTELLECTUAL PROPERTY ATTORNEYS

INTERNATIONALE FEDERATION
VON PATENTANWÄLTEN