

Newsletter

IP, TMT e Data Protection Department
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SUMMARY

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I. WIPO PROOF

On May 27, 2020, the World Intellectual Property Organization ("WIPO") introduced "WIPO PROOF", a new digital service aiming to provide an unforgeable digital time stamp that allows to certify the existence of a certain file at a given time. This service acquires a relevant utility, for example, in disputes about the authorship of a work or invention, providing an important support for creators to safeguard their intellectual assets and to prevent misuse and misappropriation at every stage of development.

WIPO Director General Francis Gurry, in a press release, said that "in a highly dynamic global economy where value is increasingly based on human activity enabled by digital and big data technologies, it becomes crucial to be able to prove that you were in possession of your digital intellectual property." Innovative and creative activities, as we know, are largely carried out through the use of digital tools, and the production of content is increasing exponentially. The data thus produced are vulnerable to abuse or unauthorized use. The list of contents potentially subject to the WIPO PROOF, *inter alia*, includes (i) trade secrets and know-how; (ii) audiovisual or literary creative works; (iii) technical schemes, plans, projects; (iv) software codes; (v) research results (reports, laboratory notes); (vi) algorithms and genetic sequences.

From a practical standpoint, upon uploading a digital file in any format to the <https://www.wipo.int/wipoproof/en/> website, the user will receive the WIPO PROOF TOKEN ("WPT"), which is a system-generated, globally recognized fingerprint that is valid indefinitely. WIPO does not read the content of the uploaded file or store a copy of it; the one-way algorithm



interacts only with the requester's browser. In addition, WIPO PROOF securely stores WPTs for 5 years (renewable upon request), keeping them compliant with evolving encryption technologies. The technology used is known as Public Key Infrastructure ("PKI"), this is a cryptographic technology that, through the robust eIDAS standards (EU Regulation No. 910/2014), provides a high level of certainty regarding the date and time on the WPT.

WPT complements, but in no way replaces, traditional intellectual property registrations, which remain the primary form of protection. The use of the WPT is intended for those works that cannot enjoy the protection afforded to industrial property titles but are protected by copyright law or other non-registered rights. However, the WPT assumes particular relevance, also for the purpose of protecting the stages of work of the creator/inventor by providing the basis for a possible subsequent registration of an intellectual property right. For instance, the protection of the design, in fact, enjoys a "grace period", which consists in not considering disclosed the design or model that has been made available to the public in the twelve months preceding the date of submission of the application for registration or, if priority is claimed, in the twelve months preceding the date of the latter. In this case, for the purposes of proof, the WPT may play an important role.

Also, with regard to the new ways of protecting intellectual property assets, the *Società Italiana degli Autori ed Editori* (SIAE) and Algorand, a platform based on blockchain technology, have been conducting a collaboration since 2019 aimed at innovating the management of copyrights. On March 24, 2021, the two companies, announced the first important stage of the project aimed at creating an open platform based on blockchain that allows transparent and efficient management "by design" of authors' rights. As part of this collaboration, more than 4,000,000 NFTs (Non Fungible Tokens) have been created, digitally representing the rights of more than 95,000 authors associated with SIAE.

An NFT is a unique and indivisible cryptographic token that is inextricably linked to a typical digital object: a work of art, a piece of music, a collectible. For the most part, NFTs are created and managed via Ethereum's blockchain, via the ERC-721 standard (different from ERC-20 fungible tokens), and there are various online marketplaces, such as OpenSea, on which NFTs are sold, traded, and purchased. Recently NFTs are enjoying wide success, for example, an NFT published by digital artist Beeple was recently auctioned at Christie's for \$69 million, Jack Dorsey, Founder and CEO of Twitter, auctioned his first tweet, which sold for \$2.9 million, and major auction houses (e.g. Sotheby's, Phillips) are showing considerable interest in operating in this market by promoting, *inter alia*, larger scale NFT auctions.

In conclusion, it will be interesting for industry players to follow the technological and regulatory developments and business opportunities related to such new intellectual asset protection tools.

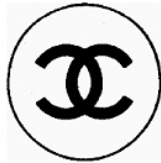
II. CHANEL V. HUAWEI – EGC DECISION

On April 21, 2021, the General Court of the European Union ("EGC") ruled on the issue of likelihood of confusion of trademarks pursuant to Article 8(1)(b) of Regulation 2017/1001.

The case was between the well-known fashion *maison* Chanel and Huawei Technologies. The latter, on September 26, 2017, filed a trademark application with the European Union Intellectual Property Office ("EUIPO"), namely for computer equipment, for the following figurative sign:



On December 28, 2017, Chanel filed an opposition to said registration on the grounds of alleged similarity with its own prior French trademarks registered for perfumes, cosmetic products, costume jewelry, leather goods and garments:



In a decision dated November 28, 2019, the EUIPO rejected Chanel's opposition, deeming the sign filed by Huawei to be different from the two trademarks owned by Chanel and that there is no likelihood of confusion by the public. The EGC, with the judgment in question, has rejected the appeal brought by Chanel and aimed at the annulment of the above EUIPO decision.

The EGC recalled that in order for an earlier trademark to benefit from the broader protection under Article 8(5) of Regulation No. 207/2009 it must meet three conditions: (i) the conflicting trademarks must be identical or similar; (ii) the earlier trademark upheld in opposition must be well-known; and (iii) there must be a likelihood that the use without due cause of the trademark applied for will take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier trademark. Failure to comply with even one of the above conditions is sufficient to render this provision inapplicable.

The EGC, in its reasoning, recognizes that, although "the conflicting signs have certain similarities", "their visual differences are significant. As regards Chanel's trademarks marks, in particular, the curves are more rounded, their contours are thicker and their arrangement is horizontal, whereas that of Huawei's sign is vertical." The EGC has, therefore, noted that "in assessing their identity or similarity, the conflicting trademarks must be compared in the form in which they are registered and applied for, regardless of any rotation in their use in the marketplace."

For the reasons described above, the EGC found that the trademarks in dispute are different and, accordingly, dismissed the action brought by Chanel against Huawei.

Here is the [link](#) of the decision.

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