

# The Italian Supreme Court Case on the Vespa Appearance

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OVERLAPPING  
INTELLECTUAL  
PROPERTY RIGHTS

SECOND EDITION

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OXFORD

The Cambridge Handbook of  
**INTERNATIONAL  
AND COMPARATIVE  
TRADEMARK LAW**

EDITED BY

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**The Italian Supreme Court Case on the Vespa Appearance**

**Or**

**“Has the Italian Supreme Court Torpedo the Entire Italian Design Industry Against the CJEU Interpretation of EU Law?”**

**Or**

**“The Italian Vespa Saga ... To Be Continued with a Very Likely New Question and Decision by the CJEU?”**



Source: <https://ipkitten.blogspot.com/2023/12/the-vespa-appearance-italian-supreme.html>

## ZZIG Scooters



Piaggio's Italian 3D trade mark  
and EU



Vespa LX, released in 2005

Source: <https://www.lexology.com/library/detail.aspx?g=8ea57e56-9785-4a4a-ac16-ee0ec1874b8b>

		
<p><b><u>Cityzen</u> (2007)</b></p>	<p><b><u>Revival</u> (2010)</b></p>	<p><b><u>Ves</u> (2012)</b></p>

Source: <https://iplens.org/2017/06/26/the-shape-of-the-worldwide-famous-vespa-obtains-protection-in-italy-under-copyright-law/>

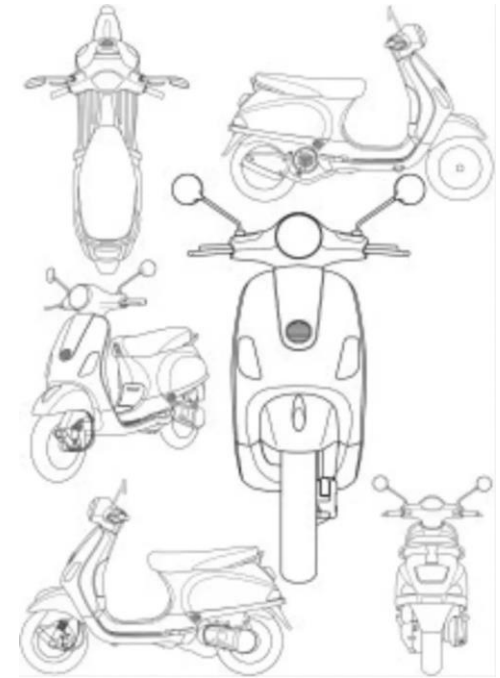


ZZIG Community Design (2010)

Source: EU General Court Case T-219/18

## At Stake

- Italian and EU trademark by Vespa
- EU designs by ZIGG
- Concurrent EU and Italian legal actions on the Piaggio mark
  - 29 November 2023 General Court T-19/22 (holding EUIPO erred in finding the Piaggio 3D mark invalid and did not consider the submitted evidence proving the distinctive character of the mark across the EU)
  - 28 November 2023 Italian Supreme Court (finding that aesthetic appearance of a product may constitute substantial value, thus absolute ground for refusal of TM registration)
- Copyright protection (in Italy, but really across the EU and in general)



TM ®

Product Identifiers

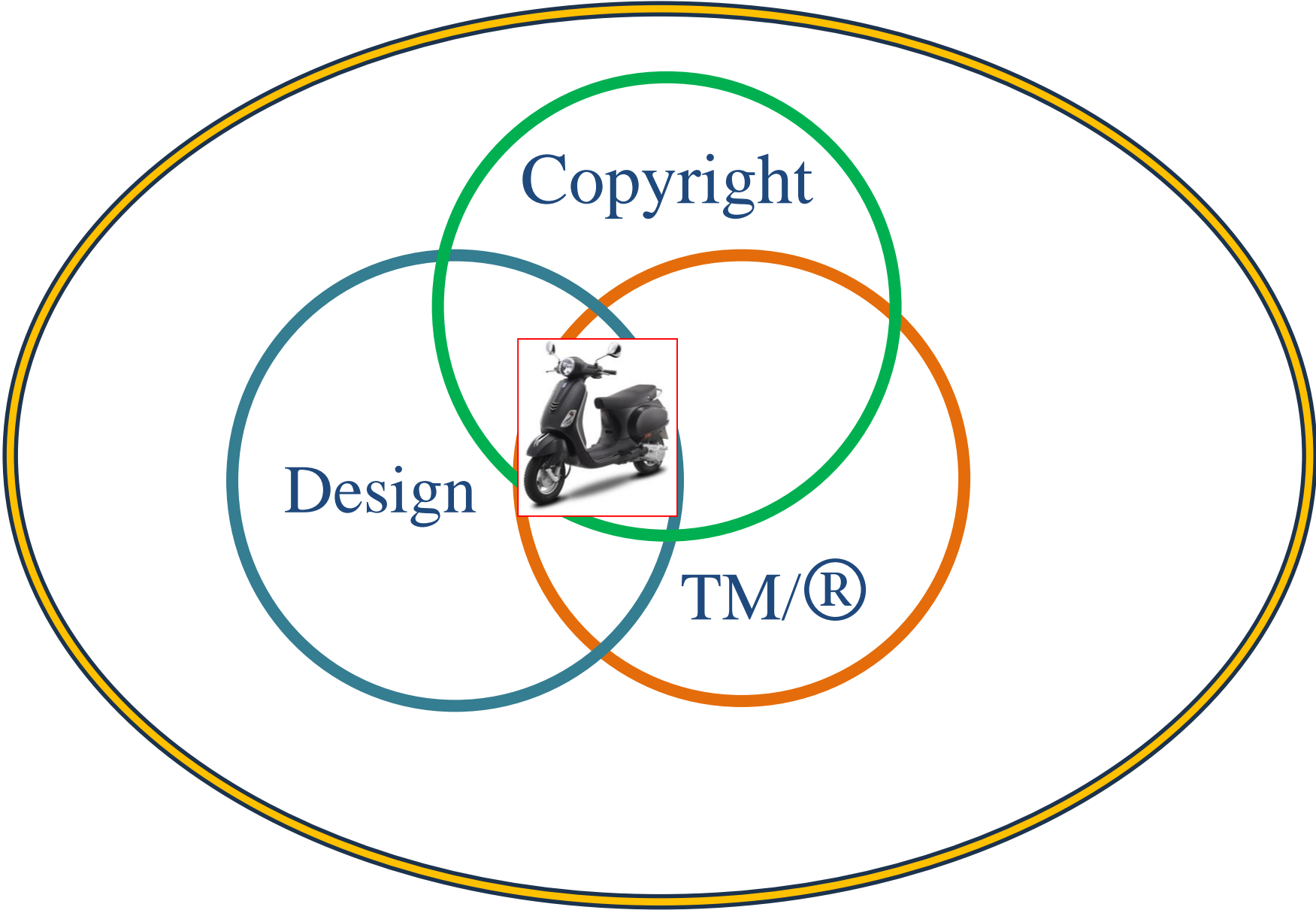
Design

Aesthetic Works

Copyright

Artistic works





Copyright

Design

TM/®



TM ®

Product Identifier

Design

Aesthetic Work

Copyright

Has Artistic Value



Article 4

**Absolute grounds for refusal or invalidity**

1. The following shall not be registered or, if registered, shall be liable to be declared invalid:

- (a) signs which cannot constitute a trade mark;
- (b) trade marks which are devoid of any distinctive character;
- (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, or the time of production of the goods or of rendering of the service, or other characteristics of the goods or services;
- (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade;
- (e) signs which consist exclusively of:
  - (i) the shape, or another characteristic, which results from the nature of the goods themselves;
  - (ii) the shape, or another characteristic, of goods which is necessary to obtain a technical result;
  - (iii) the shape, or another characteristic, which gives substantial value to the goods;
- (f) trade marks which are contrary to public policy or to accepted principles of morality;
- (g) trade marks which are of such a nature as to deceive the public, for instance, as to the nature, quality or geographical origin of the goods or service;



- *Cofemel*



- *Brompton*



**Substantial Value vs. Artistic Value:  
Can they be “Compatible” or Are they “Mutually Exclusive”?**

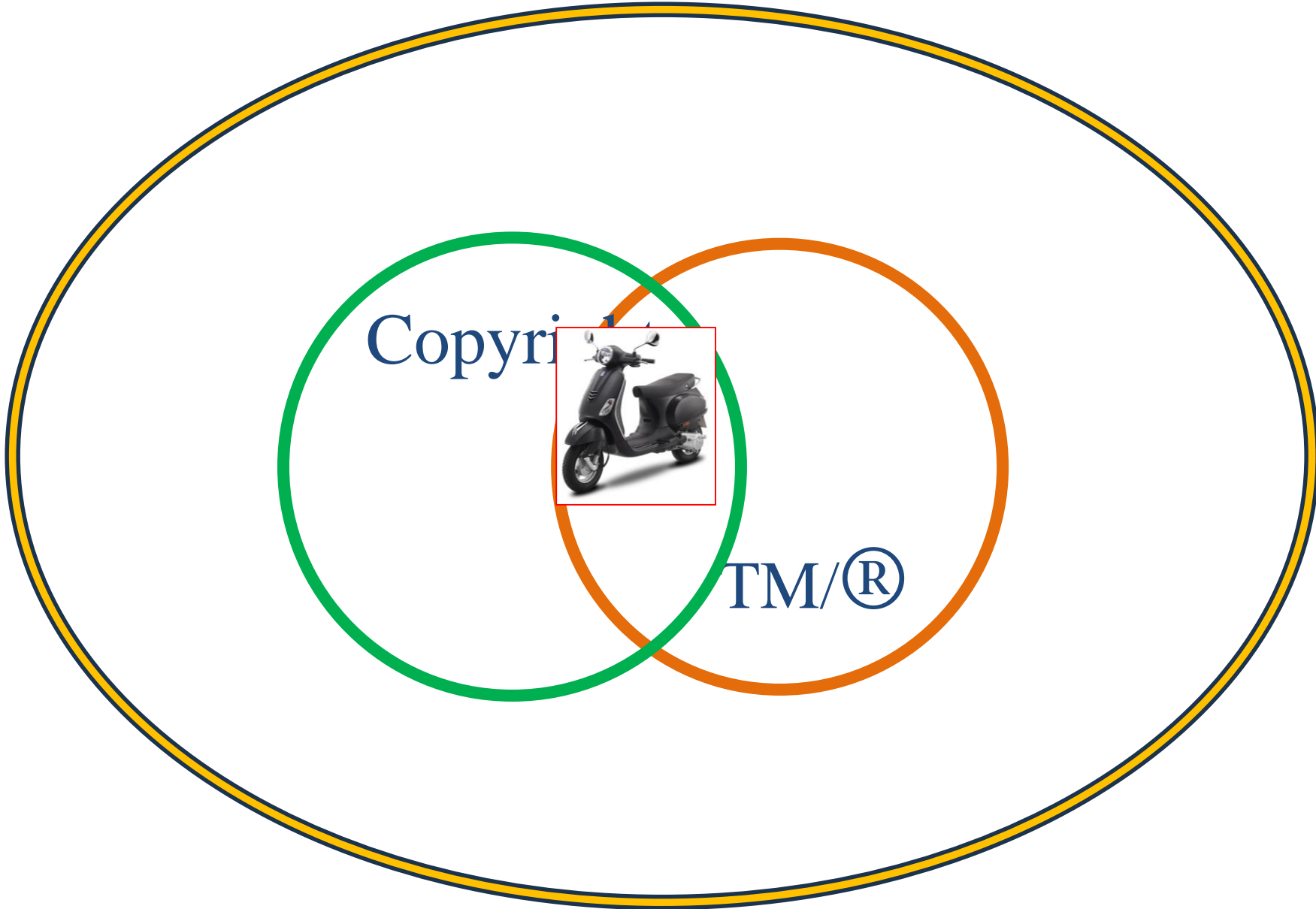


**2017:** Turin Court of First Instance dismissed the request to invalidate the Vespa Italian 3D mark (appearance of the 2005 Vespa LX model) and found that ZIGG's Ves model infringed Piaggio's Vespa trademark and copyright. The court also found Vespa possesses an artistic value beyond its technical and functional character.

**2019:** Turin Court of Appeal of Turin upheld the decision.

One of the issues on appeal to the Italian Supreme Court (not on the merit) was:

- Can a 3D mark be registered for the shape of a product that is also protected by copyright, or instead, the "substantial value" absolute ground prohibit such registration?



Copyri



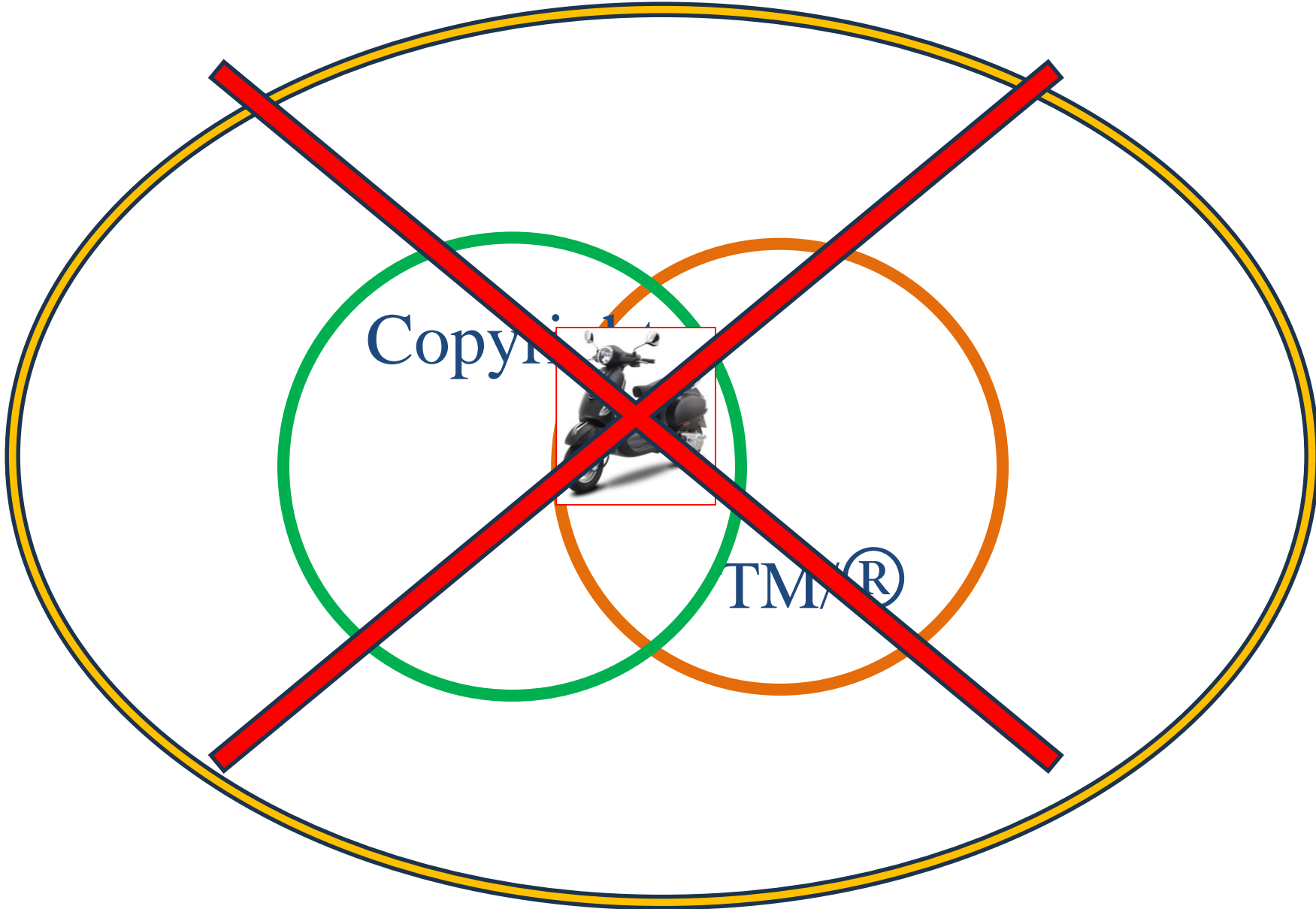
TM/®



- Substantial value' means a 'non-trivial aesthetic value'
  - Meaning the "external appearance of the product" makes the product a symbol or social icon, which makes the product particularly appealing and gives the owner a competitive advantage by influencing purchasing decisions
- Substantial value is when the shape of the product plays a very important role in consumers' choice.'
- Factors to consider include:
  - consumers' perception
  - the nature of the product
  - artistic value of the shape
  - higher price thereof
  - promotional strategy highlighting the product's aesthetic features
- Substantial value is not limited to aesthetic features but also includes elements that combine aesthetic with functional/technical value.

Essentially, the Supreme Court stated that the subsistence of an artistic value is a crucial element for a finding of a substantial value, which in turn precludes the registration of such a shape as a 3D mark

The case is back at the Court of Appeal to determine whether the Vespa's shape confers substantial value to the goods to which it is applied.



Copyri



TM/R



Is the shape that gives substantial value to the goods, or is the reputation that has been acquired by the sign that confers such value? (AG Szpunar Louboutin C-163-16)



Is the Vespa shape that gives substantial value to the scooter, or is the reputation that the Vespa Shape has acquired in many years that confers such value?



Is the Vespa shape that gives substantial value to the scooter, or is the reputation that the Vespa Shape has acquired in many years that confers such value?

This is the question that the Turin Court of Appeal needs to resolve now: How to reconcile the SC decision and definition of artistic value and its impact on the registrability of 3D “artistically valuable” marks with EU law



**The Italian Vespa Saga ...**

**To Be Continued with a Very Likely New Question and Decision by the CJEU?**



Thank you



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