

## Italian's do it better, but the Germans do it with equal but "not similar" success

Belén Tomás

*For those of you wondering what it's all about, the summer ice cream hasn't frozen our brains (yet), we're talking about electric scooters and designs.*

*EUIPO's Board of Appeal (file no. R 1663/2020-3) has recently –8 August 2022– rendered a Decision by which it has rejected the appeal filed by Piaggio in its entirety. The Office discarded similarity between the contested designs, confusion with Piaggio's earlier TM and protection under copyright law. It weighed the similarities and dissimilarities, between the scooter shape and the bunch of earlier rights, and the latter prevailed.*

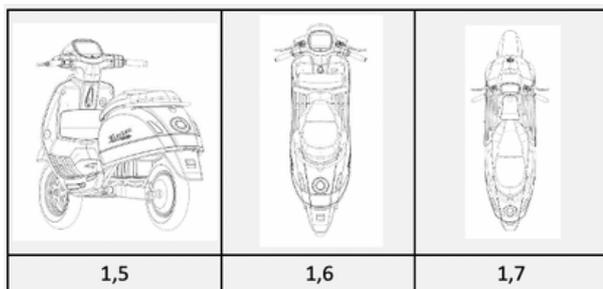
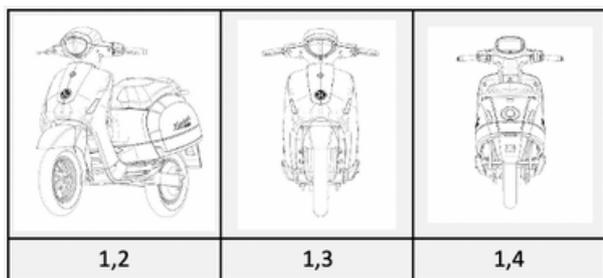
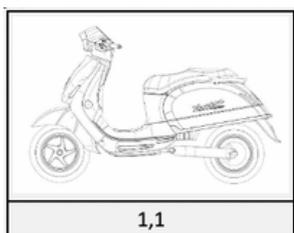
*However, Piaggio has two months to appeal against this decision to the General Court of the European Union – otherwise, the decision will become final.*

There is a long last battle between German electric scooter manufacturer Kumpa Electric (e. Bility GmbH) and the Italian Vespa manufacturer Piaggio, who, unfortunately has many open fronts (as ZNEN's case, where, to the contrary, Piaggio succeeded in getting the EUIPO to declare these these Chinese copy-cats of Vespa invalid by the EUIPO, after being able to remove a set of scooted display at the EICMA 2019 two-wheeler show in Milan).

In connection to the Italo-German conflict, it has hit all the battlefields, civil courts, criminal courts and the EUIPO. In relation to the latter, we have a "second round" recent ruling issued at the peak of Alicante's summer, last August 8th. Just the most recent, because, given the circumstances, we cannot be sure that it will be the last.

*The Italian Vespa manufacturer challenged the community design of the Kumpan's scooter, since he claimed that its design, together with its trademark and copyrights, to the shape design of the hugely famous and iconic Vespa scooters to be infringed by the Kumpan design.*

The Italian Vespa manufacturer challenged the application for registered community design (RCD) of the Kumpan's scooter, since he claimed that its design, together with its trademark and copyrights, to the shape design of the hugely famous and iconic Vespa scooters to be infringed by the Kumpan design, which was as follows:



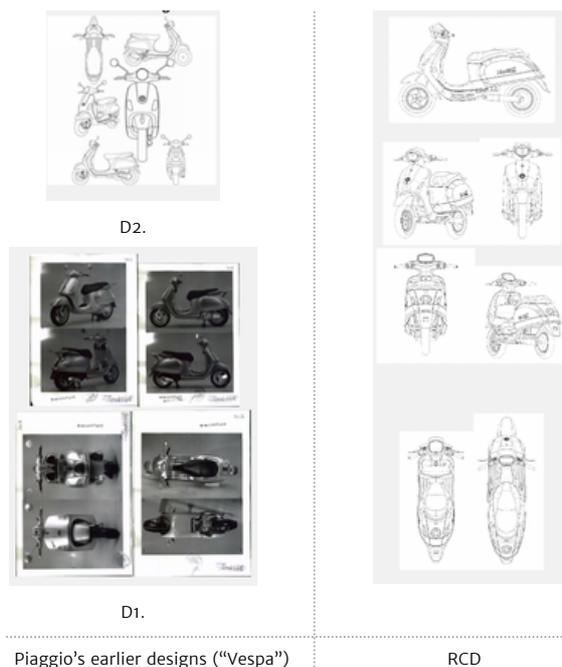
*However, the Cancellation Division dismissed the application for a declaration of invalidity of the RCD because “the design of the components of the motor scooter is sufficiently different to produce a different overall impression”.*

Background facts to put this into context:

i. **e-bility GmbH** is the proprietor of the registered Community design No. 4363588-0001 with the designation "scooter" (Locarno 12-11), filed on 20/09/2017.

ii. **Piaggio & C. S.P.A.** filed an application for annulment on 6 November 2018, claiming that the impugned RCD is **not new and has no individual character**, moreover it infringes a distinctive sign and constitutes an unauthorized use of a copyrighted work[1].

The comparison between the designs was as follows (judge for yourself):



However, back on June 19, 2020, the Cancellation Division dismissed the application for a declaration of invalidity of the RCD.

First, the Cancellation Division stated that there were enough details that distinguish the opposing designs that cannot be regarded as 'insignificant'. Thus, novelty condition breach should be rejected. Then, with regard to its individual character, the Office established that taking into account the range

[1] Article 25(1)(b) CDR in conjunction with Article 4(1), Article 5(1)(b) CDR, Article 6(1)(b) CDR, Article 25(1)(e) CDR and Article 25(1)(f) CDR;

of products, the existing set of shapes, the designer's degree of freedom in developing the design and the informed user awareness of the differences between the opposing designs (which was contested at appeal stage by a survey according to which 81% of the 893 persons questioned agreed with the similarities between designs), the individual character requirement was met by the contested RCD. Specifically, stated that *"The designs under comparison correspond only insofar as they use certain components which a motor scooter has as a two-wheeler, but the design of the components of the motor scooter is sufficiently different to produce a different overall impression"* and that there were differences in their configuration, such as, headlights, side trim and back view. Thus, being those features in which the designer has a degree of freedom and which the informed user will perceive (on account of the asserted high level of attention), the overall impression produced by the designs is clearly different.

*This years-long legal dispute has reached a temporary end, although not successful for Vespa's manufacturer.*



Lastly, and notwithstanding the debate on whether exactly the same design is registered as a three-dimensional mark (obviously, at a later stage) which validity was confirmed by the EUIPO in a parallel proceeding –aforementioned Zhen's Case T-219/18–, the Cancellation Division (CD) also discard likelihood of confusion, and about copyright, according to the Regional Court of Turin there was some cumulative individualizing characteristics present in all Vespa-Scooter that grant exclusive rights to its author. However, the Cancellation's Decision considered that **the RCD does not have all those features and, thus, the Italian law on the basis of the copyright could not be granted.**

Since Piaggio was certainly not happy with this rejection as unfounded overall, it appealed before the Board of Appeal file no. R 1663/2020-3.

Unfortunately for the appellant, the BoA, despite its more detailed argumentation, agrees with the CD through and through. And with regards to the remaining claims, in addition to offering a detailed analysis of each of their differences, however minor, it agrees that there is no likelihood of confusion the Piaggio's 3D Italian trademark as *"Despite the similarity in the essential characteristics of a scooter, the signs have numerous differences which enable the consumer to distinguish them with certainty even if he encounters them on identical goods"* (par. 62 of the Decision) and, lastly, considered that the applicant and appellant failed to provide information identifying the copyrighted work and, for that reason, it cannot be examined whether the contested RCD constitutes an unauthorized use of that work. Indeed, it recalls that copyright does not protect an idea or a concept, but the complete realization in which this idea or concept is expressed, i.e. a very specific work.

This years-long legal dispute has reached a temporary end, although not successful for Vespa's manufacturer. Piaggio has two months to appeal against this decision to the General Court of the European Union – otherwise, the decision will become final.

[1] Article 25(1)(b) CDR in conjunction with Article 4(1), Article 5(1)(b) CDR, Article 6(1)(b) CDR, Article 25(1)(e) CDR and Article 25(1)(f) CDR;