

31 October 2018 – *IAM Weekly E-mail*



Franca Acuto

Partner, Dr Jur., Attorney-at-Law, Italian Bar. Italian Trademark Agent, Professional Representative before the EUIPO. Member of INTA, MARQUES - Association of European Trade Mark Proprietors. Franca graduated in Law from the University of Turin, specializing in IP law. Franca has extensive experience in brand selection, portfolio management, IP due diligence, enforcement and advisory work for clients. She is particularly experienced in prosecution matters and oppositions filed before the EUIPO. She also has broad experience in coordinating trademark litigation for clients throughout Europe, the US and the Far East.

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Colourful shrimp wars: publishers battle it out over GAMBERO ROSSO and GAMBERO VERDE

Can the publisher of a guide, which has earned wide recognition in Italy for listing the best restaurants and wine bars, claim a monopoly on the trademark GAMBERO (meaning “shrimp”) in the publishing field? This is the question that the Rome Court of First Instance addressed in interim proceedings between publishers Gambero Rosso SpA and Gambero Rosso Digital Srl, on the one hand, and publisher Il Nuovo Manifesto Coop, on the other.

Facts

GAMBERO ROSSO (meaning “red shrimp”) was first used in 1987 as the title of a newspaper supplement and has grown to become a powerful gastronomic empire, which includes cookbooks, a magazine and a professional cooking school, as well as a TV channel – the Gambero Rosso Channel – which scours the Italian peninsula for promising young chefs. The brand also oversees the prestigious Guida dei Ristoranti d’ Italia, which awards the Tre Forchette (“three forks”) award to Italy’s top restaurants. As such, publishers are understandably interested in protecting their IP rights in the GAMBERO ROSSO mark.

Gambero Rosso SpA and Gambero Rosso Digital Srl (the claimants) own several national and EU trademark registrations for or comprising GAMBERO ROSSO, including both word and figurative marks in Italy, the European Union and abroad in classes including Classes 9, 16, 25, 33, 35, 38, 41 and 42.

In 2018 Gambero Rosso applied to the Rome Court of First Instance for interlocutory measures against Il Nuovo Manifesto Coop (the defendant) to prohibit its use of the trademark IL GAMBERO VERDE (meaning “green shrimp”) as the title of a weekly supplement in the newspaper Il Nuovo Manifesto, which covers topics relating to biological organic food and sustainable farming.

The claimants argued that the defendant’s use of the GAMBERO VERDE mark infringed their trademark rights in GAMBERO ROSSO and constituted unfair competition because of:

- the confusing similarity between GAMBERO VERDE and several earlier trademark registrations for GAMBERO ROSSO; and
- its use in connection with magazines and guides for restaurants, food and wine.

The claimants noted that although they had cooperated over a long period with the newspaper Il Manifesto (the predecessor to Il Nuovo Manifesto) and Gambero Rosso had been a monthly supplement of the newspaper, the collaboration had ended by mutual agreement of the parties.

The claimants stated that they had become aware of the fact that Il Nuovo Manifesto intended to launch a new weekly supplement, under the title Gambero Verde, concerning topics relating to the green economy, as well as food, and that this was first published on 23 November 2017. The claimants held that these circumstances increased the risk of confusion between GAMBERO ROSSO and GAMBERO VERDE.

The defendant denied any risk of confusion and explained that the reasoning behind the choice of Gambero Verde as the title of the weekly supplement was because it represented an “ecologist metaphor of ongoing conflicts”, referring to – in its opinion – humankind’s step backwards, triggered by the election of President Trump, who – shortly after he was elected – announced the United States’ withdrawal from the Paris Agreement on climate change. Therefore, the underlying reason for the use of the adjective “green” in connection with shrimp – a marine crustacean that is well known for walking backwards – was to link in the consumer’s mind the environmental and ecology issues, which were the main topics of the weekly supplement.

The defendant also argued that GAMBERO ROSSO was a weak trademark because it was descriptive for a guide on restaurants, food and wine; therefore, it should not be afforded protection under Article 20 of IP Code, given the differences between the disputed marks and their varying scope of protection.

Decision

The court granted the injunction in favour of the claimants, as well as other requested measures, including:

- withdrawal of the Gambero Verde supplement from the market;
- seizure of accounting records, as well as other documents showing the sales turnover of the supplement;
- penalties for any infringement by the defendant; and
- reimbursement of the claimants’ legal costs amounting to €6,500.

The court held that, contrary to the defendant’s argument, GAMBERO ROSSO was a strong trademark. Although shrimp is a type of food (as claimed by the defendant), it is a niche type of food, which is not of common use and certainly was not common when the claimants created the trademark and launched the supplement in 1987.

The court held that the use of the word “gambero” in the title of a newspaper supplement alongside the adjective “rosso” (meaning “red”), which is normally the colour of this crustacean, and which together is a type of niche food, was the result of a creative process and its peculiarity strengthened the mark. The court stressed that the GAMBERO ROSSO mark did not identify a type of food, but rather a magazine or guide, and that no other magazine title in Italy uses the word “gambero”. Accordingly, the court concluded that the GAMBERO ROSSO mark was not only distinctive, but also well reputed.

Indeed, on examining the evidence of the claimants’ economic efforts to promote its mark – not only in the publishing industry, but also online and in the telecoms sector – the court held as follows:

There are therefore also the conditions for qualifying the claimant’s mark as a renowned brand, which has expanded from the original distinctive function of an editorial magazine to embrace the sectors of gastronomy, entertainment and

information, justifying the need for the sign to be protected beyond the originally claimed products.

The court also observed that, even when GAMBERO ROSSO was used as the title of a monthly supplement in Il Manifesto, the publisher had maintained wide editorial independence from the newspaper.

Therefore, the court ruled in favour of the applicability of Article 20(b) and (c) of the IP Code, which prohibits the use or registration of a trademark that is identical or similar to an earlier registered mark for identical or similar products or services and which recognises a broader scope of protection for well-known marks.

In reaching this conclusion, the court found that:

- Gambero Verde was sold in association with a newspaper with which the Gambero Rosso supplement was previously sold;
- the first issue was devoted to pasta; and
- alongside the GAMBERO VERDE mark, the defendant also portrayed a stylised image of a small green shrimp, which was similar to the stylised shrimp device that was protected by one of the claimants' registrations in Class 16.

As such, the defendant's use of the GAMBERO VERDE mark constituted a blatant attempt to establish an undue connection with the GAMBERO ROSSO mark.

These circumstances led the court to dismiss the defendant's defence based on the environmental arguments and to rule in favour of the claimants on the likelihood of confusion between the disputed marks and the existence of unfair competition.

Conclusion

The decision, even at this interlocutory stage, confirms the reputation enjoyed by the GAMBERO ROSSO mark and is in line with a 23 June 2008 decision of the Court of Rome, in which the court granted an interim injunction against the publisher of a food and wine guide entitled Il Gambero Rozzo (meaning "the Rough Shrimp").

The court has affirmed its earlier opinion, acknowledging the significant efforts made by the claimants to increase the reputation, popularity and reliability of the GAMBERO ROSSO mark in the publishing sector among the Italian public.

It remains to be seen whether the court will confirm its decision in the proceedings on the merits and put an end to this dispute.

For further information contact:

Franca Acuto
Jacobacci & Partners
View website
Email: facuto@jacobacci.com
Tel: +39 011 2440311