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# ECTA BULLETIN

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INSIGHTS OF THE EUROPEAN COMMUNITIES TRADE MARK ASSOCIATION

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*Edinburgh Castle is a historic fortress which dominates the skyline of the city of Edinburgh, Scotland, from its position on the Castle Rock. Archaeologists have established human occupation of the rock since at least the Iron Age.*

# 8. ECTA Case Law Reports



for the trade mark TRAMARI before the Italian Patent and Trademark Office (UIBM), on the ground that TRAMARI is potentially confusing with its trade mark registration TRAIMARI and that both trade marks are for wine products.

At this point, Cantine sued Pellegrino before the Italian Enterprise Tribunal of Palermo asking for some provisional measures: 1) a preliminary injunction to force Pellegrino to respect its obligations under the coexistence agreement and consequently to withdraw its opposition before the UIBM and 2) a penalty for each day of delay in fulfilling the order of the judge according to article 614 bis of the Italian code of civil procedure. Pellegrino pleaded the invalidity of the coexistence agreement because it had been unable to avoid the conflicts that the parties would have prevented through the agreement.

## DECISION

In the case of 7 February 2018 (R.G. n. 19632/2017, *Tramari*<sup>2</sup>) the Tribunal held, first of all, with regard to *fumus boni iuris* (likelihood of success on the merits), that the coexistence agreement which the parties had signed should have covered the obligation for Cantine to not sell in Sicily through the internet in order to guarantee to consumers and to both parties the same coexistence discipline both online and in the traditional market. On this point, the Italian Tribunal referred to a previous case law *Merck*, which was decided by the High English Court in January 2016.

Secondly, the Tribunal established that Pellegrino defaulted on the coexistence agreement for two reasons: a) Pellegrino did not collaborate in identifying third parties selling TRAMARI wine in the Sicily region and b) Pellegrino opposed the trade mark application for TRAMARI before the UIBM.

According to the Judge, Pellegrino should have complained to Cantine about its online sales in Sicily and should have waited for Cantine to stop its online sales in Sicily.

In relation to *periculum in mora* (risk of imminent and irreparable damage), the Tribunal held that this was satisfied because, in the absence of the preliminary injunction, Cantine would have suffered the negative consequence and irreparable prejudice of not being granted a registered trade mark.

In light of the above, the Tribunal ordered Pellegrino to withdraw its opposition before the UIBM within seven days from the communication of the injunction and set 500 Euro as a penalty for each day of delay in withdrawing the administrative opposition.

## CONCLUDING REMARKS

The decision has clarified that a coexistence agreement is a private contract through which the parties agree respective rights to the confusing trade marks and decide the way to use potentially confusing trade marks to regulate coexistence in the market.

In addition, the Tribunal established that coexistence agreements which provide for a splitting of geographical sales areas should be considered to extend to Internet sales, even when this is not explicitly stated. «



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<sup>2</sup> The name of the case *Tramari* is not an official reference