

Settlement in a potential trademark infringement case

by Giulia Didone' - Italian and European Trademark and Design Attorney

A client, an Italian company specialized in the urban mobility sector, launched a 100% Italian zero-emission brand of e-scooter. The trademark was duly registered in European Union in class 12 before the product was placed on the market. During the soft launch of the e-scooter, the client found that one of the largest Italian chains of electronic products retailers was selling an electric kick scooter as well as a folding bicycle under a very similar mark.

We arranged an investigation in different shops to understand how such products were sold, how many products were displayed, marketed, how the contested mark was applied on them and to also collect information on the manufacturer of the products bearing the contested sign. Then, we sent a C&D letter to the retailer as well as to the manufacturer claiming the existence of a likelihood of confusion between our client's trademark and the sign used on the electric kick scooters and folding bicycles and thus the infringement of our client's registered mark. We asked to immediately stop selling any products under the contested sign, immediately cease to use the contested sign in any advertisement, promotional material online and offline, not to manufacture, import and export, distribute or offer for sale online or offline products with the contested sign not only for goods falling in class 12 of the Nice classification (the relevant class), but even in other classes for which the trademark was registered.

After an intense negotiation, we achieved the result and settled the case. Counterparts not only agreed to the above conditions but also paid to our client's a damage compensation. Our client agreed to give them a sell-off period, within which counterpart was entitled to sell off the stock. THINX has skills and expertise in negotiations in conflict resolution process, achieving successful results in a fast and cost-effective way.