

Innovation Talks

5 litigation cases in Italy on licensing contracts

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RTI v. Poltronissima

(Milan IP Court, decision no. 3925/2016)

1. the trademark licence agreement is not required to be in writing and it can be concluded verbally as well as by conduct;
2. in the absence of a specific agreement between the parties to the contrary, it must generally be ruled out that the licence is free of charge.

Alviero Martini v. Time Vogue
(Milan IP Court, docket No. 13254/2015,
order of 30/04/2015)

A third party that purchased the licensed goods from the licensee during the sell-off period, and sold them on the market after the end of such period, infringes the licensor's rights (which are not exhausted).

Samsung v. Apple

(Milan IP Court, docket no. 59734/2011,
orders of 5/01/2012)

1. Samsung's refusal to license its SEPs after a long negotiation, due to the absence of an agreement on royalties, does not constitute an abuse of dominant position;
2. by balancing the interests of the two companies, Samsung's motion for PI shall be dismissed: Samsung's feared damages are economic and can easily be restored at the end of merits proceedings, whilst the delay or interruption of the production and marketing of the allegedly infringing Apple products would cause Apple irreparable damages.

Nuova Informatica Consulting v. Sigest - Agas (Supreme Court decision no. 10641/2011)

Where a licence agreement expressly excludes the licensee's ability to transfer the same to any third party in the absence of the licensor's authorization, that agreement cannot be transferred even in the framework of the sale of the company branch to which it relates.

Integrated Food Franchising v. Spuntinoteka Breakfast s.r.l.

(Supreme Court order no. 10420/2019)

We are dealing with a licence agreement, and not a franchise agreement, where it only regulates the use of the licensor's know-how and trademark, whilst it does not regulate aspects such as:

- the inclusion of the franchisee in the franchisor's distribution chain;
- the payment of an initial franchising fee;
- the obligation to purchase products intended for sale;
- training and controls

Thank you

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