

Court of Milan: the 3D mark covering the form of the “Le Pliage” bag is a reputed trademark, and any imitation thereof is banned not only in Italy, but throughout Europe

With a decision issued on January 5th, 2024, the Court of Milan has granted a pan-European injunction against a UK company, prohibiting it from marketing an imitation of the “Le Pliage” bag, that was found to infringe the European Union three dimensional registered and non-registered trademark, owned by Jean Cassegrain / Longchamp.

In doing so, the Court observed that the Longchamp “Le Pliage” bag is characterized by an original combination of a series of elements, described as follows: *“the trapezoidal shape of the body of the bag, the flap with a slightly rounded shape located between the two handles of the bag and covering part of the zip fastener; the stitching on the front of the bag, in the extension of the flap and emphasizing the contour of its inside pocket; the two tubular-section handles, which end in rounded tips attached to each side of the bag's opening; the two small rounded leather tabs, positioned at each end of the zip fastener and highlighting the upper corners of the bag, turned inwards; the contrast of colours and materials between the elements (handles, flap, tabs) of leather and the canvas of the nylon bag body”*.

The UK company had offered for sale a product, imitating the shape of the “Le Pliage” on its website, which was accessible throughout Europe, including an Italian version of the site, where an Italian consumer could purchase and have products delivered directly to the Italian territory.

After the examination of the case, the Court of Milan declared the respondent liable for infringement of both the unregistered and registered three dimensional trademarks, protecting the shape of “Le Pliage” bag, since the bag marketed by the UK company reproduced all the distinctive arbitrary characteristics, claimed by Longchamp’s shape trademark.

As such, the Court held that the marketing, offering for sale and sale of the challenged products, in imitation of the famous “Le Pliage” bag protected by the above mentioned titles, constitutes infringement of a trademark with reputation, according to art. 20 of Italian Code of Industrial Property, letter c) and art. 9, paragraph (2), letter c) of EU Regulation No 2017/1001.

In so holding, the Court also determined that it had jurisdiction to decide the action, which was brought by Longchamps against the UK company, before the Court of Milan.

Confirming that the Italian Courts have jurisdiction over the matter, the Court of Milan observed that, to ground jurisdiction, it is sufficient that there is a threat that acts of infringement may be committed in the Italian territory, within the meaning of Article 126 (a) of EU Regulation No 1001/27 and, in any event, that there is a possibility that the petitioner’s IP rights may be infringed in the Italian territory, within the meaning of art. 7(2) of EU Regulation No 1215/12. Here, the petitioners

were able to purchase the contested products from the Italian version of the UK company's website, products which have been delivered to Italy by the UK company, thus confirming that the sale of these products is directed to the Italian market and to Italian consumers, and not solely to the European public.

Moreover, according to the applicable rules on jurisdiction (paragraph 2 of art. 125 EU Reg. 1001/17, to be read in combination with paragraph 2 of art. 120 of the Italian Intellectual Property Code), the Court of Milan was the correct venue to hear the action, considering that (i) the respondent UK company did not have a registered place of business, or domicile, in one of the Member States of the European Union, (ii) the products were delivered in Milan, and (iii) one of the petitioners, Longchamp Italia, has its registered place of business in Milan.

Having established jurisdiction in Italy and the competence of the Court of Milan, the presiding judge recognized, in accordance with the extensive case-law on "Le Pliage" bag, that both the unregistered and registered 3D trademarks, owned by the French company enjoy a substantial degree of reputation.

Namely, the Milanese judge held that a comparison between the 3D trademarks covering "Le Pliage" bag and the defendant's imitating bag confirms - **without any doubt** - a clear case of infringement, under art. 20(c) of the Italian Code of Industrial Property and art. 9(2)(c) of EU Regulation 1001/17, with the result that the respondent gained an unfair advantage from the almost complete exploitation of Longchamp's 3D trademarks, with the sole purpose of misappropriating the reputation associated with the registered and unregistered trademarks of the petitioner, which have been widely used by Longchamp.

Finally, the Court of Milan concluded that, given the identity of the original and the contested products, the possible continuation of the marketing and offer on sale of the bag in question by the respondent would undoubtedly cause a serious prejudice to the reputation of Longchamp's enforced trademarks, taking into account that the products marketed by the defendant are not subject to a quality control, and, as such, there is a real danger of tarnishing the public's appreciation of Longchamp's shape trademark, further causing confusion, to the detriment of Longchamp, on the entrepreneurial origin of the sign in question.

For this reason, the Court of Milan granted a pan-European injunction, enjoining the UK company from any further marketing of the challenged bags in Italy and throughout the EU, according to art. 126(1) and art. 131(2) of EU Reg. 1001/17. The judge also issued a penalty of € 1,000 for each day of delay in the execution of any of the urgent measures granted, as well as for each single product that is subject to the injunction and marketed in Italy and in Europe, after the fifth day from the service of the order.

This decision shows that, when products infringing a reputed trademark, not only are sold online in Europe, but are also specifically directed to the Italian market, the trademark proprietor can act against such infringing activities before Italian Courts and obtain a pan-European injunction against the infringer, although this latter does not have a registered place of business in Italy.

Therefore, under such circumstances, IP owners may select Italy as proper jurisdiction and the competent Italian Court, as right venue, for the request of a pan European injunction and the associated measures.

