



**QORTI CIVILI
PRIM' AWLA**

**ONOR. IMHALLEF
MARK CHETCUTI**

Seduta ta' l-14 ta' Frar, 2012

Rikors Numru. 799/2011

**Avukat Dottor James Muscat Azzopardi bhala
mandatarju
specjali tas-socjeta Watches & Style Group Limited,
socjeta inkorporata u registrata fil-British Virgin
Islands,
FM Holdings Limited u Classic Group Limited**

VS

Vincent Desira, Joseph Desira u Gold Line Limited

Il-Qorti,

Rat ir-rikors tas-socjetajiet rikorrenti tat-18 ta' Awwissu 2011 li jghid hekk:

Illi s-socjetajiet rikorrenti Watches & Style Group Limited u FM Holdings Limited dahlu fi ftehim ta' distribuzzjoni esklussiva u ta' uzu esklussiv tat-trademark ICE-WATCH mas-socjeta TKS s.a. tal-Belgju li hija s-socjeta propjetarja

tad-trademark maghrufa sew madwar id-dinja ICE-WATCH liema trademark tintuza fil-bejgh u spaccar ta' arloggi;

Illi l-imsemmija trademark ICE-WATCH hija registrata fil-pajjizi kollha tal-Ewropa in virtu ta' registrazzjoni Ewropeja li kopja taghha qieghda tigi hawn unita u mmarkata bhala Dokument IW1 u *inter alia* tkopri il-prodott konsistenti f'arloggi;

Illi l-istess socjetajiet Watches & Style Group Limited u FM Holdings Limited ikkoncedew id-drittijiet taghhom ta' distribuzzjoni esklussiva u uzu esklussiv tat-trademark ICE-WATCH f'Malta lis-socjeta l-ohra rikorrenti Classic Group Limited u dan in virtu u bis-sahha ta' ftehim iffirmit. Dan jinsab ikkonfermat f'dikjarazzjoni li l-imsemmija socjetajiet Watches & Style Group Limited u FM Holdings ghamlu u iffirmaw u li kopja ta' liema dikjarazzjoni tinsab hawn unita u mmarkata Dokument IW2;

Illi skond, bis-sahha u in virtu ta' ftehim bejn TKS s.a. u Watches & Style Group Limited u FM Holdings Limited u ta' ftehim iehor bejn FM Holdings Limited u Classic Group Limited, din tal-ahhar tgawdi d-dritt ta' distribuzzjoni esklussiva u dritt ta' uzu esklussiv tat-trademark tas-socjeta TKS s.a. ICE-WATCH f'Malta. Dan l-istat ta' fatt huwa sopportat u ikkonfermat minn dikjarazzjoni maghmula w iffirmata minn TKS s.a. u li kopja ta' liema dikjarazzjoni tinsab hawn unita u mmarkata Dokument IW3;

Illi b'hila u b'invenzzjoni kif ukoll b'hafna investiment finanzjarju u promozzjoni reklamativa mad-dinja kollha s-socjeta TKS s.a. u allura s-socjetajiet selezjonati minnha cjoe Watches & Style Group Limited u FM Holdings Limited kwantu socjetajiet li jgawdu drittijiet ta' distribuzzjoni esklussiva u ta' uzu eskklusiv tat-trademark ICE-WATCH u Classic Group Limited bhala l-koncessjonarja f'Malta tad-distribuzzjoni esklussiva tal-prodotti konsistenti f'arloggi bil-marka ICE-WATCH u tal-uzu eskklusiv tal-istess imsemmija tradenmark ICE-

WATCH, kisbet reputazzjoni u avvjament enormi (inkluz f'Malta) in konnessjoni mat-trademark taghha;

Illi l-istess socjeta TKS s.a. meta tisselezjona d-distributori esklussivi taghha u dawk li juzaw b'mod esklussiv it-trademark taghha ICE-WATCH hija tezigi numru ta' rekviziti b'mod partikolari dawk marbuta mat-tahrig ta' nies inkarigati mill-bejgh tal-prodott bil-marka ICE-WATCH, ir-rispett lejn struttura ta' prezzijiet u s-servizz wara l-bejgh in funzjoni tal-garanzija tal-manifattur;

Illi huwa proprju ghal dawn ir-ragunijiet li s-socjeta TKS s.a. tikkoncedi u tippermetti li jigu konnessi dritt ta' distribuzzjoni esklussiva u ta' uzu esklussiv tat-trademark ICE-WATCH lil persuni u kumpanniji li jkunu gew selezzjonati ghax jiggarrantixxu r-rispett ta' dawn il-kundizzjonijiet li l-istess socjeta TKS s.a. stabbiliet ghall-ahjar funzjonament tal-operat u negozju taghha u sabiex thares l-imagini internazzjonali taghha li fiha investiet flejjes kbar kif gja fuq spjegat;

Illi ricentement l-intimati xtaraw u qeghdin jispaccaw bi ksur tal-kunsens tas-socjeta TKS s.a. u tas-socjetajiet rikorrenti li huma konnessjonarji esklussivi taghha, kif fuq spejgat f'Malta arloggi bit-trademark ICE-WATCH tas-socjeta TKS s.a.;

Illi dan l-agir min-naha tal-intimati u cjoe t-tqeghid fis-suq u bejgh ta' arloggi li fihom trademark tas-socjeta TKS s.a. u ghalhekk l-uzu tat-trademark ICE-WATCH, l-uzu esklussiv ta' liema trademark gie koncess lis-socjeta rikorrenti Classic Group Limited, sar minghajr il-kunsens legali tal-istess socjeta TKS s.a. u tas-socjetajiet rikorrenti Watches & Style Group Limited u FM Holdings Limited – kif jidher mid-dikjarazzjoni suriferiti u uniti ma' dan ir-rikors - u ghalhekk tali agir jikkostitwixxi kontravvenzjoni u ksur ta' drittijiet ta' proprjeta intelletwali kwantu t-trademark ICE-WATCH u jilledi ghalhekk id-drittijiet tas-socjetajiet rikorrenti bhala konnessjonarji esklussivi tad-drittijiet marbuta mal-uzu tal-imsemmija trademark ICE-WATCH u ghalhekk tali agir u abbuz tal-ligi konsistenti fi gwadan mir-reputazzjoni, fama u apparranza tat-trademark ICE-

WATCH qieghed jikkawza dannu lis-socjetajiet rikorrenti bhala koncessjonarji esklussivi tad-distribuzzjoni tal-arloggi u l-uzu tat-trademark assocjata mal-istess arloggi konsistenti fil-kelma ICE-WATCH;

Illi huwa car u manifest li d-dritt ta' proprjeta intelletwali tas-socjetajiet rikorrenti bhala koncessjonarji esklussivi tad-dritt ta' uzu tat-trademark ICE-WATCH kif rikonoxxut u protett in virtu, bis-sahha u skond paragrafu (b) tal-artikolu 3 tal-Kapitolu 488 tal-Ligijiet ta' Malta qieghed jigi lez mill-intimati, u kwindi s-socjetajiet rikorrenti ghandhom dritt li jircievu l-protezzjoni akkordata lilhom mill-Kap. 488 tal-Ligijiet ta' Malta;

Illi l-agir tal-intimati qed jarreka danni lis-socjetajiet rikorrenti;

Illi minkejja li s-socjeta intimata giet avzata li hija kienet qieghda tagixxi bi ksur tad-drittijiet tar-rikorrenti baqghet inadempjenti;

Ghaldqasant u ai termini tal-artikoli 8, 6 u 14 tal-Kapitolu 488 tal-ligijiet ta' Malta s-socjetajiet rikorrenti jitolbu bir-rispett lil din l-Onorabbli Qorti joghghobha:

1. Tohrog kontra l-intimati digriet li jkun intiz sabiex jipprevjeni kull ksur ta' dritt ta' proprjeta intelletwali vestit fis-socjetajiet rikorrenti fuq il-marka ICE-WATCH;
2. Tipprojbixxi lill-intimati milli jkompli jaghmlu uzu mill-kelma ICE-WATCH fl-ezercizzju minnha tal-bejgh u spaccar ta' arloggi kontenti l-istess kelma ICE-WATCH;
3. Tipprojbixxi lill-intimat milli jaghmlu uzu minn disinni u sinjali distintivi kontenenti fost ohrajn u partikolarment il-kliem ICE-WATCH;
4. Tordna l-qbid tal-prodotti li huma suspettati li qeghdin jiksru d-dritt ta' proprjeta intelletwali tar-rikorrenti kwantu t-trademark ICE-WATCH;

5. Tordna lill-intimati li jipprezentaw fil-Qorti, rendikont dettaljat tal-prodotti konsistenti f'arloggi li gew mixtrija u spaccati minnhom f'Malta bit-trademark ICE-WATCH;

6. Tordna li jittiehdu mizuri adatti ghat-tixrid tal-informazzjoni li tirrigwarda d-decizzjoni taghha, inkluz il-wiri tad-decizzjoni u l-pubblikazzjoni taghha kollha kemm hi jew parti minnha u jekk ikun il-kaz tipprovdi wkoll ghal mizuri ta' pubblicita addizzjonali a spejjez tas-socjeta intimata;

Is-socjetajiet rikorrenti jitolbu li din l-Onorabbli Qorti sabiex, abbazi tal-pregudizzju rrimedjabbli li qed isofru s-socjetajiet rikorrenti, l-ewwel tlett talbiet jigu milqugha provizorjament u dan ai termini tal-artikolu 8 (4) tal-Kapitolu 488 tal-Ligijiet ta' Malta;

Bl-ispejjez kontra l-istess intimati;

Rat ir-risposta tal-intimati li tghid hekk:

1. Fl-ewwel lok u in linea preliminari, in-nuqqas ta' kompetenza ta' dawn il-Qrati, stante li l-esponenti jikontendu li kawza bhal dik proposta fl-ismijiet premissi kellha tigi intavolata fil-pajjiz fejn effettivament giet irregistrata t-trademark 'ICE-WATCH' kif jallegaw li sar ir-rikorrenti;

2. Illi fit-tieni lok u bla pregudizzju, l-esponenti Vincent Desira u Joseph Desira ghandhom jigu liberati minn l-osservanza tal-gudizzju stante li hija s-socjeta intimata esponenti Gold Line Limited li tiggestixxi n-negozju imsemmi mir-rikorrenti fir-rikors taghhom;

3. Illi r-rikorrenti lanqas ma setghu jipproponu rikors bhal dak odjern, stante li huma ma humiex il-proprietarji tat-trademark ICE-WATCH, u ghalhekk il-Qorti ghandha tissindika jekk rikors bhal dan kellux isir kif sar mir-rikorrenti;

4. Illi t-talbiet ghandhom ukoll jigu michuda stante li l-esponenti ma ghamlu ebda ksur tal-Kapitolu 488 tal-Ligijiet ta' Malta;

5. Illi t-talbiet ghandhom ukoll jigu michuda stante li fil-kawza taghhom, ir-rikorrenti jaghmlu garbuljata legali shiha, fis-sens li sabiex jittantaw jiddefendu l-indefendibbli, ossia l-ftehim li huma - u mhux terzi ohra - ghandhom ta' distribuzzjoni, qed jittantaw jinqdew bid-disposizzjonijiet tal-Kap. 488 tal-Ligijiet ta' Malta, u dana meta huma jafu li dak li qed jaghmlu l-esponenti huwa perfettament lecit u b'ebda mod ma jikser xi disposizzjoni ta' kif wiehed jista' jimporta u jbiegh prodott genwin f'Malta u jew f'pajjizi ohra membri tal-U.E;

6. Salv eccezzjonijiet ulterjuri;

Bl-ispejjez;

Rat il-verbal tas-seduta tad-29 ta' Settembru 2011 tal-kawza 797/2011MCH fejn il-partijiet qablu illi l-verbali, il-provi u d-dokumenti kollha maghmulin f'din il-kawza japplikaw u ghandhom jiffurmaw parti mill-atti tal-kawzi bin-numri 798/2011MCH, 799/2011MCH, 800/2011MCH, 801/2011MCH;

Rat l-atti kollha tal-kawza inkluz ix-xiehda u dokumenti esebiti kif ukoll hadet konjizzjoni tan-nota ta' osservazzjonijiet tas-socjetajiet attrici;

Rat li l-kawza thalliet ghas-sentenza ghall-14 ta' Frar 2012.

Ikkunsidrat

Din hi kawza mibdija taht il-provvedimenti tal-Kapitolu 488 tal-Ligijiet ta' Malta dwar l-Enforzar tad-Drittijiet Intellettuali w inter alia s-socjetajiet attrici qed jitolbu lil din il-Qorti sabiex tipprojbixxi lill-intimati milli jkomplu jaghmlu uzu mill-kelma ICE-WATCH fil-bejgh u spaccar ta' arloggi maghrufa bl-istess isem kif ukoll milli jkomplu jaghmlu uzu minn disinji u sinjali distintivi partikolarment il-kliem ICE-

WATCH. Korrollari ghal dawn l-ordnijiet is-socjetajiet attrici qed jitolbu li l-prodotti kollha suspettati li qed jiksru dan id-dritt ta' proprjeta intellettwali kwantu ghat-trademark ICE-WATCH jigu maqbuda mill-Qorti.

Wagt it-trattazzjoni tal-kawza s-socjetajiet attrici ipprecizaw illi d-dritt intellettwali li qed jinvokaw li qed jigu miksuri hu d-dritt konferit skond l-artikolu 9 tal-Kapitolu 416 li jghid hekk:

9. (1) Il-proprjetarju ta' trademark registrata ghandu drittijiet esklużivi dwar dik it-trademark. Dawk id-drittijiet jigu kontravvenuti meta t-trademark hekk tintuza f'Malta bil-mod specifikat fl-artikolu 10, minghajr il-kunsens tal-proprjetarju.

Huma jzidu illi huma qed jinvokaw ukoll l-artikolu 12(2) tal-istess Kapitolu biex isostnu l-pozizzjoni taghhom. Dan l-artikolu jghid hekk:

12. (1) Trademark ma taghti ebda jedd lill-proprjetarju li jipprojbixxi l-uzu ghar-rigward ta' oggetti li jkun fihom dik it-trademark li jkunu tqeghdu fis-suq mill-proprjetarju jew bil-kunsens tieghu.

(2) Id-disposizzjonijiet tas-subartikolu (1) ma ghandhomx japplikaw meta jkun hemm ragunijiet legittimi ghaliex il-proprjetarju ghandu jopponi iktar kummercjalizzazzjoni ta' l-oggetti partikolarment meta l-kondizzjoni ta' l-oggetti tinbidel jewg tittiefes wara li dawn ikunu tqeghdu fis-suq.

(3) Ghall-finijiet ta' dan l-artikolu "suq" tfisser is-suq f'Malta u mill-1 ta' Mejju 2004, is-suq f'kull Stat Membru.

F'dan l-istadju l-Qorti tqis li hi relevanti li jigi riprodott ukoll it-test tad-Direttiva tal-Unjoni Ewropea fuq it-trademarks liema direttiva hi riprodotta kwazi ezatt fil-ligi Maltija. L-artikoli relevanti huma l-artikolu 5 u artikolu 7 tad-Direttiva 2008/95/EC li ssostitwiet dak precedenti 89/104. Dawn l-artikoli jghidu kif gej:

Article 5

Rights conferred by a trade mark

1. The registered trade mark shall confer on the proprietor exclusive rights therein. The proprietor shall be entitled to prevent all third parties not having his consent from using in the course of trade:

(a) any sign which is identical with the trade mark in relation to goods or services which are identical with those for which the trade mark is registered;

(b) any sign where, because of its identity with, or similarity to, the trade mark and the identity or similarity of the goods or services covered by the trade mark and the sign, there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association between the sign and the trade mark.

2. Any Member State may also provide that the proprietor shall be entitled to prevent all third parties not having his consent from using in the course of trade any sign which is identical with, or similar to, the trade mark in relation to goods or services which are not similar to those for which the trade mark is registered, where the latter has a reputation in the Member State and where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark.

3. The following, inter alia, may be prohibited under paragraphs 1 and 2:

(a) affixing the sign to the goods or to the packaging thereof;

(b) offering the goods, or putting them on the market or stocking them for these purposes under that sign, or offering or supplying services thereunder;

(c) importing or exporting the goods under the sign;

(d) using the sign on business papers and in advertising.

4. Where, under the law of the Member State, the use of a sign under the conditions referred to in paragraph 1 (b) or paragraph 2 could not be prohibited before the date of entry into force of the provisions necessary to comply with Directive 89/104/EEC in the Member State concerned, the rights conferred by the trade mark may not be relied on to prevent the continued use of the sign.

5. Paragraphs 1 to 4 shall not affect provisions in any Member State relating to the protection against the use of a sign other than for the purposes of distinguishing goods or services, where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark.

Article 7

Exhaustion of the rights conferred by a trade mark

1. The trade mark shall not entitle the proprietor to prohibit its use in relation to goods which have been put on the market in the Community under that trade mark by the proprietor or with his consent.

2. Paragraph 1 shall not apply where there exist legitimate reasons for the proprietor to oppose further commercialisation of the goods, especially where the condition of the goods is changed or impaired after they have been put on the market.

Fatti

Il-fatti li waslu ghal vertenza huma s-segwenti:

Jirrizulta mill-affidavit ta' Fadwa Mohanna direttrici ta' Watches and Style Group Limited u FM Holding Limited, illi huma dahlu fi ftehim mal-proprietarji tat-trademark ICE-WATCH cioe TKS s.a. tal-Belgium sabiex huma jkollhom drittijiet esklussivi ta' uzu u distribuzzjoni tal-imsemmija trademark uzata fil-bejgh ta' arloggi. Dan jirrizulta mid-dokument IW2 esebit mill-atturi fejn fis-17 ta' Awwissu

2011. Watches and Style Group Limited inghataw 'exclusive subdistribution rights' għall-arlogg u trademark 'ICE-WATCH' u 'exclusive sublicense rights' għall-uzu tal-istess trademark u bejgh ta' arloggi b'din il-marka. L-imsemmija trademark hi registrata bhala community trademark kif jidher mid-dokument 1W1 anness. Jidher mid-dokument IW3 esebit mill-atturi cioe dikjarazzjoni tas-CEO tal-kumpanija Jean Pierre Lutgen TKS illi Watches and Style Group Limited huma d-distributuri tal-istess trademark f'Malta u illi FM Holding Limited huma s-subdistributors f'Malta. Fl-istess dikjarazzjoni hemm innizzel illi TKS ma tat permess lil hadd izjed f'Malta li juza t-trademark jew jispaccja arloggi bl-istess marka. Il-Qorti tirrileva illi din id-dikjarazzjoni ma jirrizultax hix wahda originali w imkien ma giet konfermata bil-gurament. Madankollu l-konvenuti ma oggezzjonawx għaliha.

Mill-provi quddiem il-Qorti u x-xiehda in kontroezami li sar lil Fadwa Mohanna, ma hemmx prova illi l-arlogg bl-isem ICE-WATCH fil-pussess tal-konvenuti huma kontrafatti. Fadwa Mohanna ma seghetx tikkonferma dan anzi mix-xiehda tagħha irrizulta illi l-arlogg li nxtara minghand il-konvenuti irrizulta li kien originali. Dak li qed tikkontendi invece f'dan l-istadju Fadwa Mohanna u konsegwentement is-socjetajiet attrici hu illi l-garanzija li tigi mal-arlogg hi wahda li tista' tigi ffirmata biss bhala valida w awtentika mid-distributuri ufficjali tal-markju w illi l-garanzija mogħtija minn persuna mhix awtorizzata hi meqjusa bhala falza.

Inoltre gie sottomess mill-atturi illi l-markju hu wiehed ta' certu livell fejn gew investiti finanzjamenti kbar inkluz fil-promozzjoni tat-trademark sabiex is-socjeta proprjetarja tikseb reputazzjoni u għalhekk hu importanti li l-ghazla tad-distributuri trid issir sabiex jigi garantit l-ahjar funzjonament tal-operat u negozju konsistenti f'tahrig ta' nies inkarigati mill-bejgh tal-prodott, ir-rispett lejn struttura ta' prezzijiet u after sales in adempiment tal-funzjoni tal-garanzija tal-manifattur. B'dawn il-kriterji ntghazlet is-socjeta attrici Classic Group Limited biex tidistribwixxi dawn l-arloggi ftehim li skond Fadwa Mohanna dahal fis-sehh fl-2010.

Il-konvenuti qed jilqghu ghal dan kollu billi jsostnu illi l-prodott li qed jinbiegh hu l-prodott genwin u mhux kontrafatt jew kopja u illi l-importazzjoni tieghu hi legali minn distributuri awtorizzati gewwa l-Italja u bl-adoperazzjoni tal-principju tal-'exhaustion of rights', is-socjetajiet attrici ma jista' jkollhom ebda dirttijiet fil-konfront taghhom.

Bhala provi mill-konvenuti irrizulta s-segwenti:

Joseph Desira direttur tas-socjeta Gold Line Limited xehed illi hu u huh f'isem is-socjeta konvenuta xtara l-arloggi minghand 'Time-Off' Limited li maghha ilu jinnegoza xi tlett snin. Xtara xi 139 arlogg ICE-WATCH. Hu nghata garanzija li l-arloggi kienu genwini u xtara skond invoice u ricevuta bil-hlas tal-VAT. Jaf li x-xoghol iddahhal f'Malta legalment. Qatt hadd ma kellmu fuq dawn l-arloggi. Hu jittimbra u jiddata l-garanzija. Jekk ikun hemm hsara hu miftiehem ma' 'Time-Off' Limited li l-arlogg jigi sostitwit. Hadd ma qallu li hawn exclusive distributor. Id-displaying tal-arloggi sar mid-ditta tieghu u ma sar ebda training ghal bejgh taghhom. Id-ditta tieghu ebda xi ghaxar snin tbiegh arloggi ta' diversi tipi.

Salvatore Panebianco li jiggestixxi s-socjeta Maltija 'Time-Off' xehed illi hu xtara l-arloggi minghand socjeta Franciza 'Time International' li kienet taf li l-arloggi kienu destinati ghas-suq Malti. Ma staqsiex lis-socjeta Franciza kellhiex xi limitazzjoni fuq bejgh lil terzi pero la darba s-socjeta Franciza beighet dan il-prodott, hu pprezuma li tali socjeta kellha dan id-dritt. Fil-fatt hu jbiegh l-istess prodott fl-Italja mixtri wkoll minghand is-socjeta Franciza. Zied li 'Time-Off' ghandha konnessjoni diretta ma' socjeta l-Italja bl-isem 'PS Time' li tiehu hsieb tiswijiet ta' arloggi pero zied illi fil-kaz ta' ICE-WATCH, jekk ikun hemm hsara, kien jaqbad u jissostitwih ma' iehor gdid.

Eccezzjoni ta' legittimu kontradittur

Qabel ma din il-Qorti tidhol fil-mertu tal-azzjoni tajjeb li qabel xejn jigi deciz punt preliminari mqajma mill-konvenut

Joseph u Vincent Desira personalment. Jidher mill-atti illi l-importazzjoni u bejgh tal-arloggi in kontestazzjoni saret mis-socjeta Gold Line Limited. L-uniku konessjoni ta' l-ahwa Desira hi li huma direttur tal-istess socjeta. L-atturi ma ssostanzjawx ir-raguni ghalix kellu jitharrek Joseph u Vincent Desira personalment billi l-involviment tieghu jidher biss bhala dirigent tal-kumpanija konvenuta. Ghalhekk in mankanza ta' xi prova l-Qorti ma jidhrilhiex li ghandha tidhol f'ipotesi legali kif Joseph u Vincent Desira f'ismhom proprju jista' jkollhom xi konnessjoni jew responsabilita personali mal-ezitu tal-vertenza u kwindi qed tilliberahom mill-osservanza tal-gudizzju.

Eccezzjoni ta' nuqqas ta' gursidizzjoni ta' din il-Qorti u ta' proponibilita tal-azzjoni

Dawn l-eccezzjonijiet ma sar ebda accenn ghalihom mill-konvenuti waqt il-kawza u stante li l-prova tispetta lilhom u ma giebet ebda prova biex tissostanzja dawn l-eccezzjonijiet din il-Qorti qed tichadhom.

Mertu

Il-mertu tal-kwistjoni hu wiehed baziku cioe jekk sid trademark ghandux id-dritt li jopponi ghall-uzu ta' tali trademark darba li l-prodott bl-imsemmi trademark gie mqiegghed fuq is-suq bil-permess tieghu. Bil-kelma 'suq' il-ligi taghna ibbazata fuq dik Ewropeja tinkludi s-suq tal-Unjoni Ewropeja. Din il-kwistjoni giet trattata in principju fil-kawza **Av. Philip Manduca nomine vs Frans Bezzina Wettinger** (PA 16.12.2004TM):

“Dan il-principju huwa rikonoxxut fid-duttrina u hu meqjus bhala *“The Principle of Exhaustion of Rights”*. Dan il-principju itenni li darba prodott jitpogga fis-suq, il-proprietarju jkun ezawrixxa d-drittijiet tieghu fuq dak il-prodott; x'jigri mill-prodott wara li dan jitqiegghed fis-suq ma jinteressax lill-proprietarju. Dan il-principju gie stabbilit fil-kuntest ta' *trademarks* anke mill-Qorti Ewropea tal-Gustizzja fil-kawza *“Centraform vs Winthrop”* (kaz numru 16/74), deciz fil-31 ta' Ottubru, 1974. Dan il-principju gie accettat anke hawn Malta fil-kuntest ta' konkorenza sleali.

L-Onorabbli Qorti ta' l-Appell fil-kawza “La Rosa vs Borg”, deciza fil-5 ta' Marzu, 1956, kienet irrimarkat li dak li *“jintroduci f'suq, għall-bejgħ fl-istess suq, merkanzija tal-istess ditta li tagħha, f'dak is-suq, hadd iehor ikun l-agent jew rappreżentat”*, ma jikkometti ebda konkorenza illecita skond il-ligi kummerċjali. Ricentement, din il-Qorti, kawza “Gauci Maistre noe vs Mizzi noe”, deciza fil-31 ta' Jannar, 2003, ribadit dan il-principju u qalet li *“parallel trading, malgrado li jista' johloq tassew tahwid fil-mohh tal-konsumatur riferibbilment għal min ikun jippretendi u jivvanta sole agency, pero', madankollu jidher li hija Prattika tollerata fil-limiti tal-legalita”*

Fil-kuntest ta' *trademarks* dan il-principju gie enuncjat ukoll mill-Onorabbli Qorti tal-Appell fil-kawza “Stefan Ltd vs Save-On Discount Stores Ltd”, deciza fit-28 ta' April, 1998. F'dik il-kawza, is-socjeta' attrici, bhala proprjetarju tal-marka “*Stefanel*”, oggezzjonat għal-fatt li d-ditta konvenuta, mhux agenti tagħha, kienet qed tispacca fis-suq lokali prodotti bil-marka “*Stefanel*”. Kemm din il-Qorti, kif ukoll l-Onorabbli Qorti tal-Appell cahdu din it-talba, wara li gie osservat li għalkemm proprjetarju ta' marka għandu dritt għal-*“exclusive use”* tal-istess marka, dan ma jfissirx li l-proprjetarju jista' jinibixxi lil xi hadd iehor milli jbiegħ jew jinnegozja fi prodotti originali u genwini tad-ditta “*Stefanel*”. Il-kliem *“exclusive use”* jirreferu għal-uzu bhala ndikazzjoni tal-origini tal-prodotti, izda darba jirrizulta li l-prodott huwa genwien, il-proprjetarju ta' dik il-marka ma jistax izomm lil xi terz milli jinnegozja dawk il-prodotti b'dik il-marka. Darba li negozjant ma jkunx qed jagħmel uzu minn marka ta' hadd iehor fuq prodotti tiegħu, izda jkun qed ibiegħ prodotti genwini, dak l-*“uzu”* li jkun qed jagħmel tat-*trademark*, ikun uzu legittimu.”

Din il-Qorti pero tagħmel is-segweni caveat għal dawn il-principji kif ighidu l-awturi **Bently and Sherman** fil-ktieb **Intellectual Property** (Oxford) fol. 882

On the other hand, in order to ensure that trademarks continue to function as indicators of origin and as

guarantors of quality to the consumer¹, the European Court of Justice also said that the rights were not exhausted where the trademark owner had a legitimate reason for opposing further circulation with the goods².

Kif jispjegaw tajjeb l-istess awturi

The principle of exhaustion represents a compromise between a respect for national rights and an attempt to ensure that those rights are not used to restrict trade across borders. To reach this compromise, the jurisprudence relies on the notion of the 'specific subject matter' of a trade mark. In the Community's view, the essential purpose of a trade mark is to guarantee that the owner has the exclusive right to use that mark for the product for the first time. The trade mark owner can therefore prevent competitors from taking unfair advantage of the status and reputation of the trade mark by selling products illegally bearing the mark. However, once the goods are placed on the market with the proprietor's consent, the trade mark has done its job. As such, the 'specific subject matter' of the trade mark is exhausted.

Exhaustion means that trade mark rights cannot be used to prevent further trade in the goods. This is subject to the proviso that the owner of the mark may be able to control further use of the mark where that use implicates some other aspect of the specific subject matter protected by the trade mark right.

Dawn il-principji insibuhom rifless fil-ligi taghna fl-artikolu 12(2), li ghalkemm jirreferi partikolarment fejn il-kondizzjoni tal-oggett jigi mibdul jew pregudikat, pero dan l-artikolu ma hux ezawrjenti fis-sens illi mhumix l-unici ragunijiet li sid it-trademark jista' jinvoka biex jopponi l-kummercjalizzazzjoni tal-prodott minn persuni mhux esplicitament awtorizzati minnu tant hu hekk li dan l-

¹ See e.g. Case 102/77, *Hoffmann-La Roche v. Centrafarm* [1978] ECR 1139 (para. 7); Case 1/81, *Pfizer v. Eurim-Pharm* [1981] ECR 2913, 2925-6 (para. 7); *Hag II* [1990] ECR I-3711, I-3758 (para. 14); and *IHT Internationale Heiztechnik*, Case C-9/93 [1994] ECR I-2789, I-2847 (para. 33).

² See *Hoffmann-La Roche v. Centrafarm*, Case 102/77 [1978] ECR 1139; *Centrafarm v. American Home Products Corporation*, Case 3/78 [1978] ECR 1823.

artikolu juza l-kelma 'partikolarment' u ghalhekk mhux 'b'mod esklussiv'.

Hu minnu illi l-Qorti Ewropej, billi din il-Qorti sabet diffikulta tistrieħ fuq guriprudenza nostrana, l-aktar li uzat dan is-subartikolu rifless fl-artikolu 7(2) tad-Direttiva 2008/95/EC f'kaz ta' alterazzjoni fizika tal-oggetti fl-istadju ta' resale tal-istess oggett u f'kaz fejn l-impakkettar tal-prodott originali jigi mibdul, għalkemm il-prodott jibqa' l-istess. L-aktar li intuza dan l-artikolu hu f'kaz ta' prodott farmacewtici. F'kaz ricentissimu li kien jitratta repackaging il-Qorti Ewropeja fil-kawza C-400/09 u C-207/10 fl-ismijiet Orifarm A/S et u Paranova Danmark A/S et vs Merck Sharp & Dorsma Corp. et fit-28 ta' Lulju 2011 li rriferiet għal guriprudenza anterjuri pero li din il-Qorti tipprecizaha b'enfasi, b'referenza għal prodotti farmacewtici, qalet hekk:

27 It thus follows from settled case-law, in particular the judgment which the referring court asks the Court to interpret, that the proprietor of a trade mark may not legitimately oppose the further marketing of a pharmaceutical product bearing his trade mark which has been re packaged by an importer who has reattached the mark if

- it is shown that such opposition would contribute to artificial partitioning of the markets between Member States, in particular because the repackaging is necessary for marketing the product in the Member State of import;
- it is shown that the repackaging cannot affect the original condition of the product inside the packaging;
- the new packaging clearly indicates the repackager of the product and the name of the manufacturer;
- the presentation of the repackaged product is not liable to damage the reputation of the trade mark and its proprietor, which implies in particular that the

packaging must not be defective, of poor quality, or untidy; and

- the importer gives notice to the proprietor of the trade mark before putting the repackaged product on sale, and supplies him, on request, with a specimen of the repackaged product (see, inter alia, *Hoffmann-La Roche*, paragraph 14; *Bristol-Myers Squibb and Others*, paragraph 79; *MPA Pharma*, paragraph 50; *Boehringer Ingelheim and Others*, paragraph 21; and Case C-276/05 *The Wellcome Foundation* [2008] ECR I-10479, paragraph 23).

28 As regards the condition at issue in the main proceedings that the new packaging must indicate clearly the repackager of the product, that requirement is justified by the trade mark proprietor's interest in the consumer or end user not being led to believe that the proprietor is responsible for the repackaging (see *Bristol-Myers Squibb and Others*, paragraph 70, and *MPA Pharma*, paragraph 42).

Il-Qorti taghmilha cara li din is-sentenza mhix direttament konnessa mal-fattispecie tal-kawza subjudice izda hi indikattiva illi l-artikolu 7(2) jipprova jsib ekwilibriju, kultant diffiċli, bejn id-drittijiet tal-proprietarju tat-trademark, daww ta' min jimporta l-prodott originali bit-trademark għal bejgħ, għalkemm mhux distributur awtorizzat tal-istess proprietarju, u d-drittijiet tal-end user cioè l-konsumatur li għandu d-dritt ikun konsapevoli ta' dak li qed jixtri.

Il-kontestazzjoni f'dan il-kaz hi għal kollox differenti fil-fattispecie peress li l-vertenza hi centrata fuq allegazzjoni tas-socjetajiet attrici illi l-prodott bil-markju ICE-WATCH hu ta' reputazzjoni u kwalita, cioè 'luxury goods' u qed jinbiegħ minn terzi mhux awtorizzati. L-attrici qed jallegaw ukoll illi l-mod kif qed jinbiegħ il-prodott mhux qed jagħti l-importanza għall-kwalita w esklussivita tal-prodott f'sens ta' pubblicità, sales expertise tal-prodott u after sales service u illi min qed ibiegħ il-prodott, apparti d-distributur awtorizzat, ma għandux il-jedd li jagħti garanzija kif jesigi l-produttur u kwindi l-ghoti minn dawn id-distributori mhux

awtorizzati ta' garanzija fuq il-prodott hi falza għax mhix qed tinhareg bil-premess esplicitu tal-proprjetarju tal-marka u kwindi mhux obligat jirrispettaha. Dan hu ta' pregudizzju għal konsumatur u finalment għal proprjetarju tal-marka. Kwindi l-atturi jilmentaw mill-pubblicità, sales u after sales, u għoti tal-garanziji minn terzi mhux awtorizzati.

Fil-kaz fl-ismijiet **Christian Dior v. Evora** ECR I-6013 (1997) l-imsemmija awturi **Bently and Sherman** precitati jghidu hekk dwar l-element tal-pubblicità:

The ECJ said that the proprietor is able to object to such advertising if there are 'legitimate reasons' for doing so. The ECJ held that the damage done to the reputation of a trade mark through subsequent advertising may in principle be a legitimate reason within Article 7(2) to allow the proprietor to oppose further commercialization of goods which have been put on the market in the Community by him or with his consent.³ After referring to the case law concerning the repackaging of trade-marked goods, the ECJ said that:

[A] balance must be struck between the legitimate interest of the trade mark owner in being protected against resellers using his trade mark for advertising in a manner which could damage the reputation of the trade mark and the reseller's legitimate interest in being able to resell the goods in question by using advertising methods which are customary in his sector of trade.⁴

In the case of prestigious luxury goods, resellers must endeavour to prevent their advertising from affecting the value of the trade mark by detracting from the allure and prestigious image of the goods in question, and from their aura of luxury.⁵ However, if the reseller is merely employing techniques that are customarily used for goods of the kind but not necessarily of the same quality in issue, then an objection to such advertising is only

³ *Dior SA v. Evora BV* [1997] ECR I-6013, I-6048 (para. 43).

⁴ *Ibid.*, I-6049 (para.44).

⁵ *Ibid.* (para.45).

legitimate if it '*seriously damages* the reputation of the trade mark'.⁶ The Court suggested that this would occur if in advertising goods bearing the mark, the trade mark was placed in a context which seriously detracted from the image which the trade mark owner had succeeded in creating around his or her trade mark.⁷

Sentenza aktar recenti dejjem b'referenza ghal 'luxury goods' inghatat fil-kawza **Copad SA vs Christian Dior Couture SA** fil-23 ta' April 2009 fejn il-Qorti Ewropeja tat aktar kjarazza ghal protezzjoni ta' sid trademark fuq prodotti 'branded' u 'ta' lussu'. Fl-ewwel lok dik il-Qorti qalet illi jekk distributur jikser kondizzjoni kontrattwali destinata biex tipprotegi l-'brand image', allura dan il-ksur jaghti lok ghal azzjonijiet ta' kontravvenzjoni ta' trademark kemm kontra d-distributur u anki terzi li d-distributur ikun ittrasferixxa l-prodott ghal resale. Jinkombi fuq il-konvenut sabiex jipprova li kien hemm il-kunsens ta' sid it-trademark għall-ispaccar ta' prodott 'branded' fuq is-suq, liema kunsens jista' jigi prezunt meta jkun hemm rabta kontrattwali bejn sid it-trademark u d-distributur, sakemm ma jirrizultax mill-kuntratt illi dan id-dritt gie limitat fil-ftehim stess. It-termini tal-ftehim jillimitaw l-iskop tal-awtorizzazzjoni mogħtija lid-distributur għall-uzu tat-trademark li a sua volta tiddetermina l-kontroll ezercitat min sid it-trademark fuq l-uzu tat-trademark u l-kwalita tal-prodott. In-nuqqas ta' osservanza tat-termini tal-ftehim ta' distribuzzjoni mhux biss jiffa' r-responsabilita fuq il-parti li kisret il-ftehim imma jimpingi direttament fuq id-drittijiet tal-proprietarju fuq it-trademark ghax tiddanneggja l-garanzija ta' sid it-trademark fuq il-kontroll tal-kwalita tal-prodott, u l-kummercjalizzazzjoni tal-prodott in vjolazzjoni tal-ftehim ta' distribuzzjoni. Distributur li jispaccja fuq is-suq prodotti in vjolazzjoni ta' kundizzjoni kontrattwali intiza biex tipprotegi r-reputazzjoni tal-markju jagħmel hekk mingħajr il-kunsens ta' sid it-trademark u ma tagħtix lok għal 'exhaustion of rights' ta' sid it-trademark u b'hekk jista' jopponi b'mod legittimu l-bejgh mill-gdid tal-prodott minn terzi.

⁶ Ibid.

⁷ Ibid., I-6050 (para. 47). In *BMW v. Deenik*, Case C-63/97 [1999] 1 CMLR 1099, 1127 (para. 64) the ECJ added that if there is no risk that the public will be led to believe that there is a commercial connection between the trader and the trade mark proprietor, the mere fact that the trader derived an advantage from using the mark (for example because the advertisements lend an aura of quality to their business) would not of itself mean that the use was dishonest.

Mhux hekk biss izda fl-imsemmi gudikat intqal illi anki fejn il-kummercjalizzazzjoni tal-prodott isir bil-kunsens ta' sid it-trademark, xorta jista' jigi oppost il-bejgh tal-prodott minn terzi fejn 'it can be established that, taking into account the particular circumstances of the case, such resale damages the reputation of the trademark'.

Il-Qorti sostniet illi hi funzjoni essenzjali ta' trademark li tiggarrantixxi l-identita u l-kwalita tal-prodott u dan biex l-end user jew il-konsumatur ikun f'pozizzjoni li jikkonsidra dawn l-elementi qabel jixtri. Din is-sentenza tmur oltre l-protezzjoni tal-immagini u r-reputazzjoni lussuza tal-prodott li ghalih gie estiz l-iskop tat-trademark fis-sentenza precitata tal-1997. Billi 'luxury goods' huma 'high class goods' ix-xehta ta' lussu li tohrog mill-prassi kummercjali Prattikati min sid it-trademark ighinu biex jiprotegu l-kwalita esklussiva tal-prodott kif irid sid it-trademark, frott tal-investment u sforz tieghu u b'limitazzjoni predeterminata tat-tip ta' 'outlets' li minnhom il-prodott jista' u ghandu jinbiegh, cioe 'selective distribution networks', li jghinu biex 'to preserve the quality and ensure the proper use of such goods.'

Applikati dawn il-principji ghal kaz in ezami ghax wara kollox il-ligi u l-gurisprudenza issib l-applikazzjoni vera taghha fuq fatti accertati f'vertenza irid l-ewwel nett jigi stabbilit u ppruvat min min qed jaghmel il-kawza illi jipprova li l-markju hu wiehed 'prestiggju' fit-termini fuq spjegati. Tali prova ma saritx. Intqal mis-socjetajiet attrici li din hi marka prestiggjuza pero ma ngabet ebda prova ghalfejn ghandha titqis prestiggjuza fis-sens li jisthoqqilha l-protezzjoni mitluba. Ma ngiebet ebda prova fejn dan il-prodott jinbiegh internazzjonalment, liema u x'tip huma l-outlets mnejn jinbiegh, x'percezzjoni ghandu l-pubbliku ta' dan il-prodott cioe jekk hux wiehed esklussiv u mhux biss semplicement rinomat jew maghruf. Tali nuqqas ta' prova jwaqqa' qabel kull konsiderazzjoni ohra dak li qed jintalab mis-socjetajiet attrici, u cioe jekk l-ispaccar tal-prodott minn terzi hux jikkontravvjoni xi kundizzjoni kontrattwali bejn sid it-trademark u d-distributur awtorizzat u fin-nuqqas ta' tali kondizzjoni, tali spaccar, anki jekk qed isir

bil-kunsens tas-sid it-trademark hux qed jiddanneggja r-reputazzjoni tat-trademark. Harsa lejn il-website tal-markju, kif ghamlet din il-Qorti ma hallietx l-impressjoni li dan hu xi markju esklussiv kemm ghal mod kif jinbiegh il-prodott cioe anki mill-internet stess, l-outlets imsemmija fil-website u l-prezzijiet tal-prodott li hu accessibbli ghas-suq in generali. Il-Qorti wkoll hadet in konsiderazzjoni l-ilment tal-lok mnejn qed jinbiegh il-prodott f'Malta u l-mod kif qed jinbiegh fejn is-socjetajiet attrici wkoll naqsu li jgibu xi prova li turi illi l-mod u l-lok mnejn qed jinbieghu l-arloggi bil-markju 'ICE-WATCH' hu ta' detriment serju ghal-markju nnifsu. Il-Qorti fehmet illi dawn l-arloggi huma tal-moda immirati lejn sezzjoni ta' klijentela l-aktar giovanili mill-mod kif inhi d-dehra taghhom, u ghalkemm igawdu popolarita pero jitqies primarjament bhala 'prete a porter' milli 'designer' jew 'haute couture'.

In kwantu ghal garanzija, ingiebet il-prova mis-socjeta' konvenuta illi hi xtrat il-prodott minn socjeta' Maltija cioe Time-Off fejn xehed id-direttur taghha cioe Salvatore Panebianco li qal li hu kien xtara l-prodott minn socjetajiet Francizi u bieghhom lil diversi distributuri Maltin. Il-garanzija hi wahda 'lokali' kif tidher mill-garanzija nfisha li tigi mal-arlogg u d-ditta tieghu ghandha socjeta' assocjata maghha fi Sqallija li taghmel tiswijiet ta' arloggi pero l-istess socjeta' tiggarantixxi lid-distributur li jkun ibiegh l-imsemmija arloggi illi f'kaz ta' hsara li ma tisewwiewx l-arlogg jinbidel ma' iehor gdid u b'hekk tigi sodisfatta l-garanzija w effettivamente il-konsumatur.

Jidher ghalhekk ghal din il-Qorti illi l-kwistjoni tal-garanzija li hi wahda 'lokali' u mhux wahda 'internazzjonali' ma jinnessita ebda awtorizzazzjoni specifika jew specjali tas-socjeta' li ghandha 'exclusive distributorship' biex isiru tiswijiet jew tibdil tal-prodott. Tali garanzija timponi fuq il-bejjiegh partikolari l-obbligu li juri li hu f'pozizzjoni jaghmel tajjeb ghal hsarat li jistghu jigu fit-termini tal-garanzija. Dan jidher li qed jigi sodisfatt mill-provi mressqa mis-socjeta' konvenuta fuq dan il-punt u s-socjetajiet attrici ma gabu ebda prova li dan mhux minnu.

Din il-Qorti tirreferi ghal dak li jghid il-Kapitolu 378 tal-Ligijiet ta' Malta fuq l-affarijiet tal-konsumatur. Uhud mill-artikoli f'Parti IX 'Sale of goods to consumers' huma trasportati kelma b'kelma mid-Direttiva tal-Unjoni Ewropeja 1999/44/EC. L-artikolu 72 tal-Kap. 378 ighid illi 'garanzija kummercjali' hi wahda fejn kummercjant jaghti obbligu li jirrifondi l-prezz, ibiddel jew jirringa prodott mhux konformi mal-garanzija jew ir-rikamar. L-artikolu 77 imbaghad jaghti d-dritt tal-kummercjant bhala l-ahhar bejjiegħ direttament responsabbli lejn il-konsumatur, li jkollu dritt ta' rivalsa kontra l-persuni li minn ghandhom ikun gie trasferit il-prodott minhabba nuqqas fil-prodott li ghalih ikun responsabbli l-produttur.

Hu minnu illi hemm opinjonijiet divergenti jekk hawn Malta din il-katina ta' responsabilita tistax tigi ezercitata dirrettament mill-ahhar bejjiegħ kontra l-produttur minhabba l-ambigwita ta' kif inku redatt l-artikolu 77 pero f'din l-istanza mhux l-iskop ta' din il-Qorti li tidhol fil-mertu ta' kwistjoni simili. Dak li hu importanti hu illi l-konsumatur mhux qed jigi ppregudikat mill-bejgħ ta' prodott b'garanzija li fuqha ma jkollhux dritt Prattiku ta' rivalsa. Il-ligi hi cara u l-garanzija mogħtija mis-socjeta' konvenuta tobbligaha skond il-ligi għal konsegwenzi ta' hsara jew nuqqas fil-prodott koperti b'dik il-garanzija. Drittijiet bejn il-kummercjant u bejjiegħa antecedenti li jaslu sal-manifattur u drittijiet bejn distributur esklussiv u l-produttur huma re inter alios acta l-mertu f'dan il-kaz.

Ma hemmx dubju illi s-socjetajiet attrici mhux qed jargumentaw illi l-prodott mibjugħ mill-konvenuti hu wieħed kontrafatt fejn allura japplikaw principji ohra legali. Anzi l-provi juru illi l-prodott mibjugħ hu genwin, akkwistat minghand distributur iehor minn pajjiz fl-Unjoni Ewropeja, fejn allura japplika d-dettam tal-artikolu 12(1) tal-Kap. 416 u l-artikolu 7(1) tad-Direttiva 2008/95/EC.

Decide

Għalhekk għal ragunijiet kollha msemija aktar 'l fuq filwaqt li tichad l-eccezzjonijiet tal-konvenuti dwar in-nuqqas ta' guriisdizzjoni u l-proponibilita tal-azzjoni, tilqa' l-

Kopja Informali ta' Sentenza

eccezzjonijiet tal-konvenuti u filwaqt li tillibera lil Vincent Desira u Joseph Desira mill-osservanza tal-gudizzju, tichad it-talbiet attrici fil-konfront tas-socjeta konvenuta billi ma jsibu ebda fundament fattwali jew legali.

Bl-ispejjez kontra l-atturi.

< Sentenza Finali >

-----TMIEM-----