



COURT OF ROME  
IP CHAMBER

The Court,

having read the motion for PI filed by Juventus Football Club s.p.a., owner of the rights relating to the word marks JUVE and JUVENTUS and to the figurative mark consisting of the black and white striped shirt with two stars on the chest (indicating that the club won more than twenty championships);

having read the defense brief of the defendant Blockeras s.r.l.;

considering that the motion by the applicant requests the Court:

- to enjoin the further production, marketing, promotion and offer for sale, directly and/or indirectly, in any manner or form whatsoever, of the NFTs (non-fungible tokens) and digital contents referred to in the motion for PI, as well as of any other NFTs (non-fungible tokens), digital contents or products in general bearing the image referred to in the motion for PI, even if modified, and/or the Juventus trademarks referred to in the motion for PI, as well as the use of said trademarks in any form and manner whatsoever;
- to order the defendant to withdraw from the market and remove and/or obscure from every website and/or from every page of a website directly and/or indirectly controlled by the defendant on which such products are offered for sale and/or advertised, the NFTs (non-fungible tokens) and the digital contents associated thereto or products in general subject to the injunction, and in any event to take action with the other online platforms on which such products are offered for sale and/or advertised so that the relevant pages are removed and/or obscured;
- to order the defendant to provide any useful information to identify the persons involved in the various stages of the production and marketing of the Blockeras cards at issue, as well as the quantities and price of the Blockeras cards created and/or sold by the defendant;
- to set a penalty to be payed by the defendant to the applicant for each day of delay in the implementation of the above measures and for each subsequent breach or non-compliance (on a daily basis), in the amount of EUR 25,000.00 (twenty-five thousand/00) for both cases, without prejudice to higher damages that the applicant may suffer as a result of the defendant's conduct;
- to publish the order to be issued, by the applicant and at the expense of the defendant, twice, in double the normal font and with the heading and names of the parties in bold, in the daily newspapers "Corriere della Sera" and "La Gazzetta dello Sport", as well as for one month on the home page of the websites blockeras.com and coinofchampions.com, and on the Facebook, Instagram and Twitter profiles of Blockeras and Coin of Champions, without the use of links, or tabs or pop-ups, in Italian and English, in legible characters and without the need to scroll the page, or with the different modalities as the Court shall deem appropriate.

considering that the defendant Blockeras sought the dismissal of the motion for PI on the grounds set out in its defensive brief, pointing out, in particular, the lack of urgency, its right to use and/or market the cards in

question, and, in the alternative, claiming that the protected trademarks were not registered in the category of downloadable virtual products,

notes as follows.

The dispute concerns trademark infringement and unfair competition practices consisting in the unauthorized use of the abovementioned word or figurative marks through the production, marketing and online promotion of digital playing cards NFTs (“*non-fungible tokens*”), reproducing the distinctive signs in question insofar as they show the image of former player Christian (Bobo) Vieri wearing the Juventus shirt and the name of the team.

On the merits of the case, regarding the *prima facie* case requirement, the exhibits on file demonstrate the applicants’ ownership of the trademarks in question (which in any case is not contested), and that these are well-known.

In this regard, it is known that these trademarks concern the most successful Italian football team with the largest number of fans in Italy and abroad.

In addition, the evidence on file shows the existence of widespread merchandising activities in various sectors (clothing, accessories, games) carried out both online and through dedicated stores located in various parts of Italy, with the use of the brands in question; the company’s presence on the main social networks; the support to several fan clubs.

With regard to the conduct attributed to the defendant, it is documented and undisputed that Blockeras launched, in 2021, the project called Coin Of Champion, a token whose marketing and/or dissemination was supported by past and present athletes, as well as the fact that the cards in question were offered for sale via the BINANCE NFT platform between 7 April 2022 and 4 May 2022.

A secondary market exists where the cards are resold by the first purchasers, and the creators of the cards are entitled to a fee on such transaction (as shows by the applicant in the motion for PI).

With regard to the sales, the defendant claimed and proved that a total of 529 cards showing Bobo Vieri (not wearing only the Juventus shirt) had been sold and that from the sale of those Vieri cards (precisely 68 cards sold) it had obtained revenues for a total of USD 35,796.87.

Having said that, it must first of all be considered that in cases where there is confusion in the use of a trademark, there is the risk that the public might believe that the goods or services at issue come from the same undertaking or from economically-related undertakings; the possibility of a likelihood of confusion must be assessed globally, taking into account the perception that the relevant public has of the signs and the goods or services under assessment. The analysis shall also take into account all the relevant circumstances of the case, paying particular attention to the similarity of the signs and of the designated goods or services.

In the present case, regardless of the digital nature of the cards in question, with the creation of said cards and their marketing, the defendant did use the image of the player Bobo Vieri within the limits of the license agreement entered into with the company that manages his image rights, but at the same time also exploited the trademarks owned by Juventus without authorization.

In the present case, the use of the marks in question cannot be justified (pursuant to Article 97 Italian Copyright Law) by the interest to the publication of the image of Bobo Vieri in view of the notoriety of the person, since such publications are not aimed at scientific or educational purposes, nor are they justified by a public’s right to know.

Indeed, as clearly results from the exhibits on file and from the very presentation of the defendant’s project, the creation and sale of said cards was carried out exclusively for commercial purposes.

The circumstance that Bobo Vieri actually played for Juventus and that he granted permission to the use of his image through the creation of cards reproducing the player with the different shirts of the teams in which he played does not, therefore, exclude the need to request authorization for using the registered trademarks owned by the teams whose shirts and names are reproduced. The goods reproducing such trademarks are indeed

intended for sale and the reputation of the various teams in which the player played also contributes to the value of the digital image offered for sale.

It should also be noted that the trademark registration (in particular for class 9) also covers goods not included in the Nice Classification and that are inherent to downloadable electronic publications.

In addition, the applicant proved that it has become active in the field of crypto games, or blockchain games, i.e., online games that are based on blockchain technologies and on the use of cryptocurrencies and/or non-fungible tokens (NFTs) through agreements with Sorare s.a.s.

Accordingly, we hereby conclude that the creation and marketing of the cards in suit constitutes an infringement of the trademarks enforced, giving rise to a likelihood of confusion due to the identity of the signs, used in a way misleading the public as to the existence of a commercial or group relationship between the defendant and Juventus, which owns the trademarks.

Since Juventus also operates in the sector at issue and the trademarks in suit are registered for classes including such type of activity, the conduct of the defendant also constitutes unfair competition resulting from the unauthorized use of a third party's trademarks (distinctive function of the trade mark) and misappropriation of the merits associated with the trade marks used (attractive function of the trade mark).

Additionally, such conduct also risks causing a dilution of the trademarks and the loss of the right to exploit such trademarks, causing damages to their owner that are objectively difficult to quantify.

In this respect, the defendant claims that the marketing of the cards in question has ceased, but this does not remove the aforementioned need for urgent measures, since the applicant maintains an interest in avoiding that the challenged conduct is repeated in the future, also considering that the contract for the use of Bobo Vieri's image expires in March 2024, as well as considering the possibility of resale on the secondary market of the cards already purchased by users.

In this respect it is worth noting that, in IP matters, the requirement of irreparable harm to issue urgent measures is met whenever there is a risk of damages, even if merely monetary, that are susceptible of further aggravation or are not easily quantifiable, and that this irreparable harm does not depend on the number of products marketed or on whether the sale thereof has ceased, since such marketing activity may resume and increase.

In light of the above, taking into account the manners in which the challenged conduct was carried out, we hereby uphold the applicant's requests to the following extent:

- to order the defendant to cease within ten days as of communication of the order any further production, marketing, promotion and offering for sale, directly and/or indirectly, in any manner or form whatsoever, of the NFTs (non-fungible tokens) and digital content referred to in the motion for PI, as well as of any other NFTs (non-fungible tokens), digital content or product in general bearing the image referred to in the motion for PI, even if modified, and/or the Juventus trademarks in suit, as well as the use of such trademarks in any manner or form whatsoever;
- to order the defendant to withdraw from the market and remove from every website and/or from every page of a website directly and/or indirectly controlled by it on which such products are offered for sale and/or advertised, the NFTs (non-fungible tokens) and the digital content associated therewith or products in general covered by the injunction;
- to set a penalty, in case of any delay in complying with this order or any breach of the injunction, of EUR 500.00 for each day of delay or for each breach.

We do not consider it necessary to order the defendant to provide information to identify the persons involved in the various stages of the production and marketing of the Blockeras cards at issue, and on the quantities and price of the Blockeras cards created and/or sold, in view of the information already provided in this regard by the defendant.

The request for publication of the order is also dismissed, given its predominant function as a sanction and in view of the current limited sales of the cards in question.

The losing party shall bear the costs of the proceedings in accordance with the criteria and rates set out in Ministerial Decree No. 55 of 10 March 2014.

**For the reasons set out above**

the Court

- enjoins Blockeras s.r.l., starting in ten days as of the communication of the order, from any further production, marketing, promotion and offer for sale, directly and/or indirectly, in any way and form, of the NFTs (non-fungible tokens) and digital contents referred to in the motion for PI, as well as of any other NFTs (non-fungible token), digital contents or products in general bearing the image referred to in the motion for PI, even if modified, and/or the Juventus trademarks in suit, as well as from the use of such trademarks in any form and manner;
- orders the defendant to withdraw from the market and remove from every website and/or from every page of a website directly and/or indirectly controlled by the same on which such products are offered for sale and/or advertised, the NFTs (non-fungible tokens) and the digital contents associated therewith or products in general covered by the injunction;
- sets a penalty, in the event of any delay in complying with this injunction or breach thereof, of EUR 500.00 for each day of delay or for each breach;
- dismisses the remaining requests put forward by the applicant;
- orders Blockeras s.r.l. to reimburse to Juventus Football Club s.p.a. the costs of the proceedings, which are awarded in the total amount of Euro 5,518.00, which include Euro 5,000.00 for fees and Euro 518.00 for expenses, plus reimbursement of general expenses, VAT and lawyers' bar contribution as required by law.

To be communicated to the parties.

Rome, 19 July 2022

The Judge  
Alfredo Landi