ARBITRATION AND MEDIATION CENTER

WIPO
WORLD INTELLECTUAL PROPERTY ORGANIZATION

WIPO LIST OF NEUTRALS

BIOGRAPHICAL DATA

Edoardo FANO
Milan
Italy



Nationality: Italian

EDUCATIONAL AND PROFESSIONAL QUALIFICATIONS

EC Law, European Studies Certificate, University of Social Sciences of Grenoble - European and International Research University Center, Grenoble, 1991;
(*Certificat d'Etudes Européennes, Université de Sciences Sociales de Grenoble, Centre Universitaire de Recherches Européennes et Internationales*).

Diploma, Comparative Law, University of Strasbourg, International Comparative Law Faculty, Strasbourg, 1989-91: (*Diplòme de Droit Comparé, Université de Strasbourg, Faculté Internationale de Droit Comparé*).

Law Degree, University of Milan, (*Università degli Studi di Milano*), Milan, 1991, homologated in Spain, University Abat Oliba, Barcelona, 2010.

LANGUAGES

Italian, English, French and Spanish

PRESENT POSITION

Director of the Masters "Intellectual and Industrial Property" and "International Business Law" at OBS Online Business School (Barcelona, Spain), since 2016;

Law Lecturer in the Masters "Intellectual and Industrial Property" (Trademark Law and Fashion Law) and "International Business Law" (Intellectual and Industrial Law) at OBS Online Business School (Barcelona, Spain), since 2015;

IP Consultant, Consorzio Camerale per il Credito e la Finanza, Milan, since 2011;

March 30, 2020

Law Lecturer; Consorzio Camerale per il Credito e la Finanza, MIP Politecnico di Milano, Domus Academy, Milan; ESADE, Colegio de Abogados, Universidad Abat Oliba, Universidad Pompeu Fabra, Elisava, Universitat Politecnica de Cataluña – Centro de la Imagen y la Tecnología Multimedia, BAU Centro Universitario de diseño, Instituto Italiano de Cultura, Barcelona; Istituto Europeo di Design, Barcelona, Milan, Rome, Florence, Cagliari, since 2003:

"*I.P. Law*"
"*Law and Internet*"
"*Seminars on Italian Law*"

Independent EU Senior Expert in Intellectual Property Rights, since 2004:

Kazakhstan, advising and lecturing the Lower House of the Parliament of Kazakhstan (Majilis) in trademarks, patents, industrial design, geographical indications of origin protection and on the amendments to the Kazakh trademark, patent, design and geographical indications laws for the Lower House of the Parliament of Kazakhstan (Majilis), within the project "Support for Partnership and Co-operation Agreement (PCA) Implementation by the Republic of Kazakhstan", 2004;

Chile, advising Chilean SME in European patents strategies and programs, 2006;

India, advising and lecturing the Confederation of Indian Industry (CII) and the local Patent and Trademark Offices in trademarks, patents, industrial design, geographical indications of origin, internet domain names protection and exploitation within the EU – India trade and Investment Development Program (TIDP) Intellectual Property Rights, 2006;

Croatia, advising and lecturing the Croatian Ministry of Science, Education and Sports in trademarks, patents, industrial design, geographical indications of origin protection and exploitation within the CARDS IPR Project, 2006, 2007;

Republic of Moldavia, advising and lecturing the AGEPI (Intellectual and Industrial Property Office of the Republic of Moldavia) in trademarks, patents, industrial design, geographical indications of origin protection and exploitation within the Law Approximation to EU standards in the Republic of Moldova within the EU project: Support to the implementation of agreements between the Republic of Moldova and the European Union, 2010.

PROFESSIONAL EXPERIENCE BEFORE PRESENT POSITION

IP Consultant, Consorzio Camerale per il Credito e la Finanza, Milan, advising and lecturing the Chamber of Commerce of Matera (Italy) in trademarks, patents, industrial design, geographical indications of origin, internet domain names protection and exploitation, September-October 2013;

Spanish representative of the U.S. Company Intellectual Ventures Management, LLC for Technology Transfer, 2005-2010;

Law Lecturer in the I.P. Master Magister, Lucentinus of the University of Alicante (Spain), 2005-2009;

Of Counsel:Soares & Avila Pereira Abogados Asociados, Barcelona; Jausas, Barcelona: Intellectual Property, Trademark and Internet-related issues, 2003-2010;

Counsel: Notarbartolo & Gervasi S.p.A., Milan: Intellectual Property, Trademark and Internet-related issues, Head of Trademark Department, 2001-2003;

Counsel; Ing. Barzanò & Zanardo Milano S.p.A., Milan: Trademark and Internet-related issues; 1997-2001;

Of Counsel; Soares & Avila Pereira Abogados Asociados, Barcelona: I.P. Trademark and Internet-related issues, 1995-96;

Law Lecturer; Universidad de Barcelona, Instituto Italiano de Cultura, E.S.I. Escola de Sistemes Informàtics, Barcelona, 1995-96:

"*Public Law and Information Technology*"
"*I.P. Law and Information Technology*"
"*Law and Internet*"
"*Seminars on Italian Law*"

Law Lecturer; University College of London (Faculty of Laws);
Italian Institute of Culture, several Law Firms (among which Lovell White Durrant, Nabarro Nathanson, Lee & Pemberton, Freshfields), London, 1992-95:

"*Seminars on Italian Law*"
"*Comparative Law*".

AREAS OF SPECIALIZATION

Intellectual property: trademarks; domain names; unfair competition; licensing; Internet-related I.P. issues; copyright; industrial design; brand strategy; advertising law; trademark valuation. data protection.

MEMBERSHIP IN PROFESSIONAL BODIES

Lawyer (*abogado*), registered with the Barcelona Bar (*Colegio de Abogados*);

Panelist: Arbitration Chamber (*Camera Arbitrale*) Milan Chamber of Commerce, in order to solve domain name disputes involving .IT Country Code top level domains by means of Mandatory Administrative Procedure (M.A.P.);

Panelist: C.R.D.D. Centro Risoluzione Dispute Domini (Center for the Domain Disputes Resolution), the first Italian Body appointed by the Italian Naming Authority in order to solve domain name disputes involving .IT Country Code top level domains by means of Mandatory Administrative Procedure (M.A.P.);

Registered Italian Trademark Attorney, Trademark Section;

Registered European Trademark Attorney; O.H.I.M. Office for the Harmonisation of the Internal Market of Alicante.

EXPERIENCE IN INTELLECTUAL PROPERTY

Dealing with I.P. out-of-court disputes;
Carrying out trademark availability searches;
Filing and prosecuting trademark applications and trademark oppositions;
Giving legal advice related to trademarks, domain names, copyright, Internet-related I.P. issues;
Negotiating and drafting trademarks assignment, licensing and coexistence agreements.

Lectures given:

“What is IP and what is it possible to protect with IP?” for the Sardegna Ricerche IP Help Desk:
21.03.2019 - Manifattura Tabacchi di Cagliari (Italy)
Speaker in two short videos on “Certification Trademark” and “The state of the art in Design protection” organized by Consorzio Camerale per il Credito e la Finanza, Ufficio Italiano Brevetti e Marchi (UIBM), European Union Intellectual Property Office (EUIPO):
31.08.2018 - www.marchiedisegni.eu/pillole-video
“How to protect packaging design” for the Sardegna Ricerche IP Help Desk:
18.06.2018 - Manifattura Tabacchi di Cagliari (Italy)
"Italian day: trademarks, design and fight against counterfeiting” organized by Consorzio Camerale per il Credito e la Finanza, Ufficio Italiano Brevetti e Marchi (UIBM), European Union Intellectual Property Office (EUIPO):
5.12.2017 - AC Hotel, Firenze (Italy)

“Trademark opposition proceeding in Italy and at EUIPO” at the Congress "The reform of the European Trademark Law – second part” organized by Consorzio Camerale per il Credito e la Finanza, Ufficio Italiano Brevetti e Marchi (UIBM), European Union Intellectual Property Office (EUIPO):
13.11.2017 - Camera di Commercio di Viterbo (Italy)
Speaker in two short videos on “Who is the informed user” and “The relationship between design and copyright” organized by Consorzio Camerale per il Credito e la Finanza, Ufficio Italiano Brevetti e Marchi (UIBM), European Union Intellectual Property Office (EUIPO):
14.09.2017 - www.marchiedisegni.eu/pillole-video
“Intellectual Property in the creative industry” at the Congress "Design and counterfeiting: protect your creativity from the others and from yourself!” organized by Consorzio Camerale per il Credito e la Finanza, Ufficio Italiano Brevetti e Marchi (UIBM), European Union Intellectual Property Office (EUIPO):
15.12.2016 - Istituto Superiore per le Industrie Artistiche di Roma ISIA, Pordenone (Italy)
Speaker in two short videos on “Design licensing” and “The priority claim” organized by Consorzio Camerale per il Credito e la Finanza, Ufficio Italiano Brevetti e Marchi (UIBM), European Union Intellectual Property Office (EUIPO):
21.09.2016 - www.marchiedisegni.eu/pillole-video
“Intellectual Property in the creative industry” at the Congress "Design and counterfeiting: protect your creativity from the others and from yourself!” organized by Consorzio Camerale per il Credito e la Finanza, Ufficio Italiano Brevetti e Marchi (UIBM), European Union Intellectual Property Office (EUIPO):
16.12.2015 - Istituto Superiore per le Industrie Artistiche di Roma ISIA, Pescara (Italy)
“*Intellectual Property for the creative industry*” at the Seminar "Design and counterfeiting: protect your creativity from the others and from yourself!", organized by Consorzio Camerale per il Credito e la Finanza, Ufficio Italiano Brevetti e Marchi (UIBM), Office for the Harmonization of the Internal Market (OHIM):
05.10.2015- Istituto Europeo di Design, Cagliari (Italy);
“*The juridical tools for the fight against counterfeiting ",* at the Seminar "Trademarks, designs and model: tools against counterfeiting”, organized by Consorzio Camerale per il Credito e la Finanza, Ufficio Italiano Brevetti e Marchi (UIBM), Office for the Harmonization of the Internal Market (OHIM):
24.09.2015- Camera di Commercio di Bolzano (Italy)
Speaker in two short videos on “What is counterfeiting?” and “The choice of the trademark to protect”, organized by Consorzio Camerale per il Credito e la Finanza, Ufficio Italiano Brevetti e Marchi (UIBM), Ufficio per l’Armonizzazione del Mercato Interno (UAMI):
09.09.2015 - www.marchiedisegni.eu/pillole-video
“*Trademark, design and copyright: alternative or complementary?*” at the Seminar "Trademarks and other IP protection tools: alternative and cumulative use”, organized by Consorzio Camerale per il Credito e la Finanza, Ufficio Italiano Brevetti e Marchi (UIBM), Office for the Harmonization of the Internal Market (OHIM):
24.11.2014- Camera di Commercio di Chieti (Italy)
Speaker in two short videos on “WIPO Global Brand Database” and “UAMI TM View Database” organized by Consorzio Camerale per il Credito e la Finanza, Ufficio Italiano Brevetti e Marchi (UIBM), Ufficio per l’Armonizzazione del Mercato Interno (UAMI):
25.09.2014 - www.marchiedisegni.eu/pillole-video
“New perspectives for design protection in the fashion field between Europe and United States: registration v. copyright” at the Optime Congress "The new managing strategies of IP rights in the luxory, fashion and design field”:
24.09.2014 - Palazzo Parigi, Milano (Italy)
“*Design protection in the fashion field, between trademark registration, design and copyright: comparing the situation in E.U and U.S. and relevant case law*”, at the Congress “International Fashion Code event":
29.01.2014- Museo del Disseny de Barcelona (Spain)
Speaker in two short videos on “Community Trademark” and “Community Design” organized by Consorzio Camerale per il Credito e la Finanza, Ufficio Italiano Brevetti e Marchi (UIBM), Ufficio per l’Armonizzazione del Mercato Interno (UAMI):
30.09.2013 - www.marchiedisegni.eu/pillole-video
“*Design protection in the fashion field, between trademark registration, design and copyright: comparing the situation in E.U and U.S. and relevant case law*”, at the Congress “Fashion Law event":
23.02.2013- Museo del Traje de Madrid (Spain)
“*Design protection in the fashion field, between trademark registration, design and copyright: comparing the situation in E.U and U.S.*”, at the Congress on "Fashion &b IP Law”:
19.10.2012 - Università degli Studio di Parma (Italy)

"*Brand and real life: how to protect it*" at the Seminar "Brand 2.0", organized by Consorzio Camerale per il Credito e la Finanza, Ufficio Italiano Brevetti e Marchi (UIBM), Office for the Harmonization of the Internal Market (OHIM):
06.07.2012 - Istituto Europeo di Design, Cagliari (Italy)
"*Community trademark and design: registration proceeding and case law at OHIM*"at the Seminar "Trademarks and design as company asset", organized by Consorzio Camerale per il Credito e la Finanza, Ufficio Italiano Brevetti e Marchi (UIBM), Office for the Harmonization of the Internal Market (OHIM):
08.09.2011 - Camera di Commercio di Como (Italy)
"*Opposition to trademark registration in Italy and for the Community trademark*" at the Seminar "The administrative protection of trademarks and design in Italy and the European Union: opposition and cancellation proceedings ", organized by Consorzio Camerale per il Credito e la Finanza, Ufficio Italiano Brevetti e Marchi (UIBM), Office for the Harmonization of the Internal Market (OHIM):
08.07.2011 - Camera di Commercio di Cuneo, Cuneo (Italy)
"*Community trademark and design: registration proceeding and case law at OHIM"at the Seminar* "Trademark and Design: how to protect them ", organized by Consorzio Camerale per il Credito e la Finanza, Ufficio Italiano Brevetti e Marchi (UIBM), Office for the Harmonization of the Internal Market (OHIM):
24.06.2011- Unioncamere Calabria, Lamezia Terme (Italy)
"*Brand creation and strategic protection of trademarks*" at: Convey – Chamber of Commerce of Milan, Milan – Master "IP and Anti-Counterfeiting", November 2007;
"*Introduction to I.P. Law", "Spanish, Community and International Design"*; Istituto Europeo di Design, course on "Automotive Design", Barcelona, since 2004;
"*Introduction to I.P. Law", "Trademarks in general", "Trademarks: Spanish, International and Community registrations and Internet related issues*", *"Trademark and Brand", "Trademark Valuation", "Trademarks and Internet", "Spanish, Community and International Design"*; Istituto Europeo di Design, course on "Fashion Marketing Communication", Barcelona, since 2004;
"*Introduction to I.P. Law", "Trademarks in general", "Trademarks: Spanish, International and Community registrations and Internet related issues*", *"The Spanish Trademark Law", "Trademark and Brand"*; ESADE, Master "International Busines Law", Barcelona, since 2004;
"*Trademarks in general", "Trademarks: Spanish, International and Community registrations and Internet related issues*", *"The Spanish Trademark Law"*; Universidad Abat Oliba, Master "Masterbrand", Barcelona, since 2003;
"*Trademarks in general", "Trademarks: Italian, International and Community registrations and Internet related issues*", *"Trademark and Brand", "Trademark Valuation", "Trademarks and Internet", "Community Design", "Agricultural Products Protection"*; Università Federico II, Master ARPA on "Industrial Property Expert", Naples, October 2003;
"*Trademarks in general", "Trademarks: Italian, International and Community registrations and Internet related issues*", *"Trademark and Brand", "Trademark Valuation", "Trademarks and Internet", "Community Design"*; Fòrema, conference on "Patent, Trademark and design", Padua, June 2003;
"*Trademarks: Italian, International and Community registrations and Internet related issues*"; S.M.I. (Sistema Moda Italia), one-day seminar on "Trademark and Design protection", Milan, April 2003;
"*Trademarks: Italian, International and Community registrations and Internet related issues*"; Regione Valle d'Aosta, conference on "Patent and Trademark protection", Aosta, January 2003;
"*Trademarks: Italian, International and Community registrations and Internet related issues*", "*Trademark and Brand", "Trademarks and Internet*", "*Community Design*"; "Fashion Marketing Manager" Master of Istituto Europeo di Design di Milano, November 2002;
"*Trademarks: Italian, International and Community registrations and Internet related issues*"; Chamber of Commerce of Chieti, one-day seminar on "Trademark protection", June 2002;
"*Trademark and Brand*" and "*Trademarks and Internet*"; "Intellectual Property Liaison Officer" Master SEIDO, Milan, January-June 2002;
"Right of Privacy, I.P. Law and Multimedia", "Law and Internet"; "Multimedia communication" Master of Istituto Superiore di Comunicazione, Milan, July 1997 and May 1998;
"Right of Privacy and Multimedia", " I.P. Law and Multimedia", "Law and Internet"; I.U.L.M. (Istituto Universitario di Lingue Moderne), Milan, September 1997.

EXPERIENCE WITH RESPECT TO DOMAIN NAMES

Dealing with domain names grabbing / misappropriation and other Internet-related out-of-court disputes;
Carrying out domain names availability searches;

Filing and prosecuting domain names applications;
Filing U.D.R.P. complaints before W.I.P.O.;
Giving legal advice regarding to domain names and other Internet-related I.P. issues;
Drafting domain names assignment agreements;
Handling as panelist disputes concerning .IT CCtld in accordance with the Italian Mandatory Administrative Procedure (M.A.P.).

Lectures given:

"*Fashion and Internet*"; Course on "Fashion Law", Università degli Studi di Milano, December 2014;
"Fashion trademarks in Internet", Agrupación Española de Genero de Punto (AEGP) Barcelona (Spain), June 2013
"*Intellectual Property and Internet*"; Seminars for the Barcelona Bar (*Colegio de Abogados*), since 2010;
"*Intellectual Property and Internet*"; "Industrial Property Management" Master MIP of the Politecnico di Milano, April 2004;
"*Intellectual Property: Trademarks and Internet*"; International Week of E.A.D.A (Escuela de Alta Dirección y Administración), Barcelona, April 2003;
"*Intellectual Property and Internet*"; "Industrial Property Management" Master MIP of the Politecnico di Milano, March 2003;
"*Protection and exploitation of domain names and e-mail as Intellectual Property assets*"; Istituto di Ricerca Internazionale, conference on "E-mail & permission marketing", Milan, October 2001;
"*Trademarks and Domain Names*" and "*Intellectual Property Protection on Internet (contentious and non-contentious)*"; ITASOI conference on "The Web Site as communication instrument: Domain Names, On-Line Branding and Trademarks", Milan, June 2001;
"*The Uniform Domain Name Dispute Resolution Policy applied before W.I.P.O.*"; Information Technology Chamber "Training Course for Mediators and Arbitrators for Information Technology-related issues", The Milan Law Courts, May 2001;
"*Intellectual Property protection on Internet*"; ITASOI conference on "E-Commerce", Milan, September 2000.

MAJOR PUBLICATIONS

"*TIC TAC packaging: distinctive YES; functional and/or ornamental NO",* article for the Blog of Innexta Consorzio Camerale per il Credito e la Finanza, Ufficio italiano Brevetti e Marchi (UIBM), European Union Intellectual Property Office (EUIPO), 2020 (author)

"*Trademark and Design in the No Profit sector",* vademecum prepared for Innexta Consorzio Camerale per il Credito e la Finanza, Ufficio italiano Brevetti e Marchi (UIBM), European Union Intellectual Property Office (EUIPO), 2019 (author)

"*On the wings of (trademark) victory",* article for the Blog of Innexta Consorzio Camerale per il Credito e la Finanza, Ufficio italiano Brevetti e Marchi (UIBM), European Union Intellectual Property Office (EUIPO), 2019 (author)

"*Millennials and Intellectual Property",* vademecum prepared for Consorzio Camerale per il Credito e la Finanza, Ufficio italiano Brevetti e Marchi (UIBM), European Union Intellectual Property Office (EUIPO), 2018 (author)

"*What is the Sacher-Torte?! OK, let's go on like that, let's get hurt",* article for the Newsletter of Consorzio Camerale per il Credito e la Finanza, Ufficio italiano Brevetti e Marchi (UIBM), European Union Intellectual Property Office (EUIPO), 2017 (author)

"*ABC of Design legal protection",* vademecum prepared for Consorzio Camerale per il Credito e la Finanza, Ufficio italiano Brevetti e Marchi (UIBM), European Union Intellectual Property Office (EUIPO), 2016 (author)

"*Barça-UAMI 0-2",* article for the Newsletter of Consorzio Camerale per il Credito e la Finanza, Ufficio italiano Brevetti e Marchi (UIBM), European Union Intellectual Property Office (EUIPO), 2016 (author)

"*Breakfast at Costco",* article for the Newsletter of Consorzio Camerale per il Credito e la Finanza, Ufficio italiano Brevetti e Marchi (UIBM), European Union Intellectual Property Office (EUIPO), 2015 (author)

"*Trademarks an Design in the fashion field",* article for the Newsletter of Consorzio Camerale per il Credito e la Finanza, Ufficio italiano Brevetti e Marchi (UIBM), European Union Intellectual Property Office (EUIPO), 2015 (author)

"*Brand and Celebrities",* article for the Newsletter of Consorzio Camerale per il Credito e la Finanza, Ufficio italiano Brevetti e Marchi (UIBM), European Union Intellectual Property Office (EUIPO), 2015 (author)

"*Design protection in the fashion field between registration and copyright: comparative analysis between Europe and United States",* article for the magazine "Il Diritto Industriale", 2013 (author)

"*Intellectual Property Law and Policy",* prepared for the AGEPI (Intellectual and Industrial Property Office of the Republic of Moldova), within the frame of the « Law Approximation to EU Standards in the Republic of Moldova Project, 2010 (co-author)

"*Intellectual Property Rights Infrastructure for the R&D Sector in Croatia",* prepared for the Croatian Ministry of Science, Education and Sports in trademarks, within the frame of the CARDS IPR Project, 2007 (co-author)

"*Mecanismos, incentivos y fidelización de usuarios utilizados en países socios UE y modelos exitosos de difusión de patentamiento en los países socios UE*" (EU policies for promoting the patent system), prepared within the frame of the EU project "*Proyecto Apoyo a la Creación y Desarrollo de Empreses Innovadoras*" ("Project for the Creation and Development of Innovative SMEs") in Chili, 2006 (author)

"*Intellectual Property Handbook*", prepared for Lower House of the Parliament of Kazakhstan (Majilis), within the frame of the EU project "*Support for Partnership and Co-operation Agreement (PCA) Implementation by the Republic of Kazakhstan*" (2004), co-author on the following topics:

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- Patents
- Trademarks
- Design
- Geographical Indications of Origin
- Intellectual Property and Internet

"*Dispense di Diritto dell'Informatica*" (Outline of Information Technology Law), prepared for I.U.L.M. (University Institute of Modern Languages, Milan, 1997) on:

"*Right of Privacy and Information Technology"*
"Copyright, Intellectual Property Law and Information Technology"
"Law and Internet"

"*Dispense di Diritto italiano*" (Outline of Italian Law and Legal Practice), prepared for B.I.L.A. (British Italian Law Association, London, 1994) on:

"*Diritto processuale civile"* (Civil Procedure)
"*Contratti in generale"* (Contract Law)
"*Contratti di agenzia"* (Agency Contracts)
"*Diritto commerciale"* (Commercial/Company Law)

EXPERIENCE IN MEDIATION

Acted as counsel in several domestic and international mediation regarding intellectual property rights, i.e. trademarks, domain names and other Internet-related issues

PROFESSIONAL TRAINING IN ARBITRATION

"Workshop for Arbitrators", W.I.P.O., Geneva, November 2000.

EXPERIENCE IN ARBITRATION

Acted as panelist in several Italian Mandatory Administrative Procedures (M.A.P.)
Acted as counsel in several U.D.R.P. proceedings before W.I.P.O.

ARBITRATION EXPERIENCE

SUMMARY TABLE

Type		Administering Institution		Role			
		Name	Number of Arbitrations	Presiding Arbitrator	Sole Arbitrator	Co-arbitrator	Counsel
International Arbitrations		AAA					
		ICC					
		WIPO	16		11		5
		Ad Hoc					
Number of cases: sub-total			16		11		5
Domestic Arbitrations	AAA						
	Ad Hoc						
	CRDD		3		2	1	
Number of cases: sub-total			3		2	1	
TOTAL			**19**		13	1	5

MEDIATION EXPERIENCE

SUMMARY TABLE

Type		Administering Institution		Role	
		Name	Number of Mediations	Mediator	Counsel
International Mediations					
		Ad hoc	14		14
Number of cases: sub-total			14		14
Domestic Mediations		AAA			
		Court-annexed			
		Ad Hoc	15		15
Number of cases: sub-total			15		15
TOTAL			**29**		