

ARBITRATION AND MEDIATION CENTER

# WIPO LIST OF NEUTRALS BIOGRAPHICAL DATA

Andrea CAPPAI Bugnion S.p.A Milan Italy



Nationality: Italian

## **EDUCATIONAL AND PROFESSIONAL QUALIFICATIONS**

Luiss Guido Carli University, Rome, 2011; Postgraduate course in Intellectual Property Rights with a focus on Chinese Law, 2012; Qualified as a European and Italian Trademark and Design Attorney, 2016.

#### **LANGUAGES**

Italian English

## **PRESENT POSITION**

Italian and EU Design and Trademark Attorney, Head, Internet Department, Bugnion S.p.A.

## PROFESSIONAL EXPERIENCE BEFORE PRESENT POSITION

Intern, Bugnion S.p.A., Internet Department, May 2013 – November 2013. Visiting Trainee, Dragon IP Law Firm, November 2012 – December 2012. Trainee Trademark Attorney, Società Italiana Brevetti S.p.A., July 2012 – November 2012.

# **MEMBERSHIP IN PROFESSIONAL BODIES**

Active INTA member – International Trademark Association, Famous and Well-Known Marks Committee, Social Network Subcommittee, and The Trademark Reporter Committee.

January 22, 2024

## AREAS OF SPECIALIZATION

Intellectual Property (EU, Italian and International trademark and design law, copyright, Italian and EU domain name law, applicable rules for UDRP and similar proceedings concerning .eu and .it). IP related matters within Italian civil, corporate, and bankruptcy law, and EU law (where applicable). In-depth knowledge of IP issues in the automotive and fashion sectors.

## **EXPERIENCE IN INTELLECTUAL PROPERTY**

Head of the Internet Department at Bugnion S.p.A. Also an active member of the China Desk, predominantly advising Chinese clients on European Union IP law.

Expertise includes filing and prosecuting trademark and design applications in Italy, the EU, and internationally. Work also involves drafting IP contracts, implementing strategies against online and offline counterfeiting, and managing comprehensive IP portfolios, including global searches, and naming processes. Additionally, carrying out corporate and academic IP education programs, both locally and internationally, with a focus on Italian and EU law.

Practice further includes resolving extrajudicial disputes related to trademarks, designs, and domain names, conducting IP audits for significant business transactions, advising on cross-border trademark portfolio acquisitions and divestments, and developing corporate policies for managing IP assets and risks.

#### **EXPERIENCE WITH RESPECT TO DOMAIN NAMES**

In the realm of domain name management, handling matters relating to registration, maintenance, DNS, email services, and SSL certifications. Dealing with domain name monitoring and UDRP disputes (.it, .eu, and various other national alternative dispute resolution processes). Frequently engaging in the recovery of domain names registered by non-malicious parties and providing guidance to companies on consolidating their domain name portfolios under a single ownership.

Attended the WIPO Advanced Workshop on Domain Name Dispute Resolution, October 9-10, 2022 and November 6-7, 2023.

# **MAJOR PUBLICATIONS**

Thesis on 'Legal Protection of Fashion Creations',

What Are Brands Opportunities and Risks in the Metaverse? - October 25, 2021;

Sky v SkyKick: was the CJEU swayed by Sky's well-known brand? - April 3, 2020;

EU offers increasingly interesting market for pharmaceutical trademarks, World Trade Mark Review – July 18, 2019;

Italy jurisdiction report: Trademarks for retail services, World IP Review – September 9, 2018; Do we need a vaccine against influencers?, Bugnion – March 2018.

## PROFESSIONAL TRAINING IN ARBITRATION

Participated in the Online WIPO Mediation and Arbitration Workshop, and completed courses in arbitration conducted by the Italian Order of Industrial Property Consultants.