

ARBITRATION AND MEDIATION CENTER

# WIPO LIST OF NEUTRALS BIOGRAPHICAL DATA

Tommaso LA SCALA Studio Legale Withers Milan Italy



Nationality: Italian

#### **EDUCATIONAL AND PROFESSIONAL QUALIFICATIONS**

Master's Degree, Law, Bocconi University, Milan, Italy, 2009; Postgraduate course, Intellectual Property Law, Maastricht University, Maastricht, The Netherlands, 2008; LL.B., Law, Bocconi University, Milan, Italy, 2006.

Italian and European Trademark & Design Attorney; Admitted to practice before the European Union Intellectual Property Office (EUIPO).

#### **LANGUAGES**

Italian, English

## PRESENT POSITION

Head of Trademark & Filing Prosecution, Studio Legale Withers, Milan, Italy

### PROFESSIONAL EXPERIENCE BEFORE PRESENT POSITION

Head of Domain Name Department, Perani & Partners S.p.A., Milan, Italy; Trademark Attorney, Perani & Partners S.p.A., Milan, Italy; Intern, Bayer S.p.A., Milan, Italy.

## **MEMBERSHIP IN PROFESSIONAL BODIES**

Italian Trademark and Patent Attorneys Association; AIPPI (International Association for the Protection of Intellectual Property); INTA (International Trademark Association).

#### AREAS OF SPECIALIZATION

Trademarks, domain names, designs, unfair competition, licensing and technology transfer agreements, Internet, antitrust.

#### **EXPERIENCE IN INTELLECTUAL PROPERTY**

Professional representative before the Italian Trademark Office and the EUIPO since 2009.

Consultant specialized in pre-filing advices, similarity searches, trademark filing strategies, prosecution and maintenance of trademarks, management of trademark portfolios, opposition procedures before the Italian Trademark Office, the EUIPO, and the USPTO.

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

Representative in several domain name disputes before WIPO Arbitration and Mediation Center, Milan Chamber of Commerce, Hong Kong International Arbitration Centre, Resolution Canada Inc., etc.

#### **MAJOR PUBLICATIONS**

Author, "Passive holding of a domain name: which grounds are required in order to obtain the transfer of the disputed domain?", Journal of the Italian Trademark and Patent Attorneys Association, No. 01/17;

Author, "The unauthorized use of a trademark as a domain name by the distributor/reseller", Journal of the Italian Trademark and Patent Attorneys Association, no. 02/17.

## **EXPERIENCE IN COURT LITIGATION**

Acted as counsel in several court cases involving intellectual property rights – especially trademarks and domain names – in Italy and other jurisdictions.

## PROFESSIONAL TRAINING IN ARBITRATION

WIPO Advanced Workshop on Domain Name Dispute Resolution, Geneva, Switzerland, 2017;

#### **EXPERIENCE IN ARBITRATION/MEDIATION**

Member, ADR Committee of the Italian Trademark and Patent Attorneys Association.

## ARBITRATION EXPERIENCE SUMMARY TABLE

	Administering Institution		Role			
Туре	Name	Number of Arbitrations	Presiding Arbitrator	Sole Arbitrator	Co- Arbitrator	Counsel
	WIPO	approx. 160				160
International Arbitrations						
	Others					
Number of Cases Sub-Total		approx. 160				
	Milan Chamber of Arbitration	approx. 20				20
	Nominet UK	4				4
Domestic Arbitrations	Hong Kong International Arbitration Centre	1				1
Number of Cases Sub-total		approx. 25				
TOTAL		approx. 185				