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### **Patronymic trademarks: Cassation outlines the borders**

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The decision comes at the end of a never-ending lawsuit that sees the stylist Elio Fiorucci (and other) against Edwin co. Ltd (the company who has purchased the trademark “Fiorucci” from the company Fiorucci S.p.A.) and others. The famous fashion designer, throughout various companies, had included his name, Elio Fiorucci, inside different trademarks (i.e. “Love Therapy by Elio Fiorucci”, “Tout doucer by Elio Fiorucci” etc.).

The Tribunal of Milan in its first instance judgment, had established that the use of the mark “Fiorucci” together with other words (i.e. “love therapy”, “tout doucer”) constituted an infringement of the registered trademark “Fiorucci” which had been formerly transferred by Elio Fiorucci to Edwin co. Ltd and that the conduct of Mr. Fiorucci was against the principles of fair competition. Lately, the Court of Appeal of Milan had overturned the Tribunal’s decision by concluding that the use of the patronymic made by Mr. Fiorucci was legitimate and not against professional fairness. Edwin co. Ltd challenged the appeal judgment before the Court of Cassation, which has recently reversed once again the judgment. Specifically, in its landmark decision of 25 May 2016 (case No. 10826/2016) the Cassation ordered the Court of Appeal to reconsider its judgment in the light of the two following principles.

First of all, a trademark consisting of a personal name and/or surname that has been validly registered represents a limit to the personal right to the name, so that the person which has the same name as the one included in the trademark has the right to use its name within the limit of correct professional behavior. Secondly, the use of a trademark – which includes the patronymic of a person who has already included his name in another trademark and has sold it to a third party – is not legitimate if it is not justified by real descriptive reason.

The Court of Cassation, in order to establish the mentioned principles has referred the precedent of its jurisprudence. Specifically, it recalled the case No. 29879/2011 through which the Court has affirmed the principle that the use of a patronymic – when a valid trademark includes the same words – must be done with professional fairness and only in a descriptive function (the patronymic cannot be used with a distinctive function). The Court refers also to its precedent case No. 6021/2014 in which it has been specified that the mentioned interpretation apply also to the new Art. 21 of the Industrial Property Code (rule applicable to the case). The Court of Cassation continues its reasoning by stating that patronymic trademarks are usually strong trademarks and consequently the use of the same patronymic in a subsequent trademark is legitimate only if there is a real descriptive need.

The Supreme Court applied the above mentioned reasoning to the Fiorucci case and it points out that the use of the patronymic made by the fashion designer was not limited to the activities that were ascribable to Elio Fiorucci stylist creation. Moreover, the patronymic was used in other activities that were not pertaining to the work of Elio Fiorucci (i.e. co-branding, co-marketing and merchandising), consequently these uses of the patronymic were against professional fairness and against the interpretation of Art. 21 of the Industrial Property Code.

Through this judgment, the Court of Cassation demarcated more specifically the limit to the use of a patronymic when a trademark including the patronymic has already been registered.