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## Personal Name Rights and Professional Fairness: The Italian Supreme Court on the Fiorucci Case

Julia Holden ( Trevisan & Cuonzo) · Tuesday, July 26th, 2016



According to a recent decision of the Italian Supreme Court, it is no longer possible for an original name ‘proprietor’ to use his or her personal name as a distinctive sign once it has been validly registered as a word mark and has acquired a reputation if it has been validly transferred to a third party, although there are some limited exceptions relating to principles of professional fairness. (Supreme Court decision, May 25, 2016, Fiorucci case, no. 10826).

According to the judgment, personal name rights would be “*even if not exactly eliminated, surely restricted in an economic and business framework,*” especially when the person whose name is involved previously registered the name as a trademark and then transferred it to a third party once the trademark had acquired a reputation.

In this case, well-known designer ELIO FIORUCCI, who recently passed away, along with his related companies, registered his personal name as trademarks for clothes, accessories and gadgets, and sweeteners through a co-branding agreement with a low-calorie sweetener company. These marks included “Love Therapy by Elio Fiorucci” and “Love Therapy Collection by Elio Fiorucci”.

Prior to this, Elio Fiorucci had transferred the word and figurative trademarks, with his name, to third parties. For this reason, the subsequent trademarks registered by Mr. Fiorucci were considered to infringe the earlier Fiorucci registered trademarks, which were now owned by a third party.

The Court of Appeal of Milan initially found the use of Mr. Fiorucci’s own name in the subsequent trademarks lawful, since the name had a clear descriptive and not distinctive purpose, and simply expressed the personality of Mr. Elio Fiorucci. According to the Milan Court, the wording “by Elio Fiorucci” was nothing other than the creative contribution from Mr. Fiorucci as a designer to the

activities at issue. Any unlawful use of the contested trademarks or infringement of the earlier marks was thereby excluded on the basis that this use was merely a descriptive use and not a distinctive use.

However, the Supreme Court found that the Court of Appeal of Milan “*simplified, not to say trivialised*” the matter concerning personal name use as it failed to consider all the very different company activities of Mr Elio Fiorucci and his many employees, which had no creative contribution by Mr. Fiorucci. As such, the Supreme Court overturned the decision and remanded the proceedings back to the Court of Appeal.

The Supreme Court held that a personal name registered as a trademark (which has been sold to a third party) can’t be used as a distinctive sign by the personal name owner except in very limited circumstance such as where there is a descriptive use which is strictly necessary for the activities being carried out.

This is not the first time the courts have faced a personal name issue in Italy. Recently, following a dispute in Rome, the personal name mark “Alfredo” came into contention before the General Court and the EUIPO when Mr. Alfredo Di Lelio, the alleged creator of the original recipe for “fettuccine Alfredo” and the owner of the prior mark “L’ORIGINALE ALFREDO”, filed for the cancellation of Mr. Mario Mozzetti’s EU TM application for “ALFREDO ALLA SCROFA”. Mr. Mario Mozzetti had originally purchased this restaurant from Alfredo Di Lelio before Alfredo set up a second restaurant in Rome under the name Alfredo II. See the full story and cases [here](#).

In the case of Mr. Fiorucci, the Milan Court of Appeal will now have to reach a decision following the principles set out by the Supreme Court. The Supreme Court provided only a very limited exception for descriptive use. It will have to be seen whether “Love Therapy by Elio Fiorucci” and “Love Therapy Collection by Elio Fiorucci” fall within this rule. If on the other hand the use of the personal name is considered an exploitation of the “selling power” acquired by this personal name, this could result in a finding of ‘parasitic’ conduct as well as possibly causing a likelihood of confusion. A decision can be expected in the coming months.

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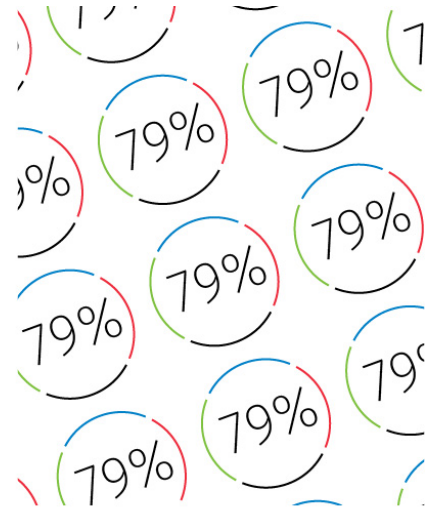
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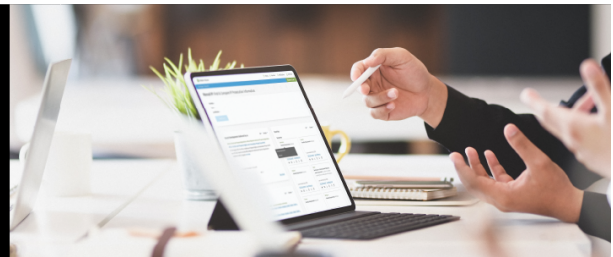
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