

# EIP



You may take my  
company and my  
trademarks, but you  
cannot take my name

A recent judgement from the Court of Justice of the European Union (CJEU) in case C-263/09P highlights the interplay between Community Trade Marks (CTM) and national rights.

Case C-263/09P centred on a dispute between Edwin Co. Ltd. (Edwin) of Japan, and Elio Fiorucci<sup>[i]</sup>, an Italian fashion designer of renown in the 1970s. In 1989, Fiorucci's company, Fiorucci SpA, went into administration and its creative assets, including trademarks comprising the element "FIORUCCI", were later sold to Edwin in 1990.

In 1999, the Office of Harmonization for the Internal Market (OHIM) registered "ELIO FIORUCCI" as a Community Trade Mark (CTM) for Edwin. Subsequently, in 2003, Fiorucci filed an application with OHIM for a declaration of invalidity based, amongst other things, on Article 52(2)(a) of European Regulation No. 40/94.

Article 52 of European Regulation No. 40/94 provides grounds on which a CTM can be declared invalid. Article 52(2)(a) essentially states that a CTM shall be declared invalid where use of the CTM may be prohibited pursuant to an earlier right to a name under Community legislation or national law. Fiorucci asserted that he possessed a right to the personal name ELIO FIORUCCI by virtue of Article 8(3) of the Italian Industrial Property Code (CPI), which specifies that personal names of well known people may only be registered by, or with the consent of, the proprietor.

The CTM was initially cancelled by the Cancellation Division at OHIM. However, after numerous appeals, and annulments of previous decisions, this CJEU judgment brings a

final ruling by which Edwin's trademark for ELIO FIORUCCI is held invalid.

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Edwin had argued that Fiorucci was not entitled to rights under Article 8(3) of the CPI because its purpose was to prevent third parties from exploiting for commercial purposes the name of a person who had become famous in a non-commercial sector. However, it was found that the structure of Article 52(2) of Regulation No. 40/94 was inconsistent with this narrow interpretation. In particular, even if the name had been used commercially or registered as a trade mark, Article 8(3) could still apply, particularly because the name could be the subject of an additional registration in a different class of goods or services.

Whilst Article 8(3) CPI, being Italian national law, is of limited relevance to most CTM proprietors, this decision highlights the importance of national rights in relation to the validity of CTM registrations. In particular, the decision demonstrates the power of unregistered national rights when seeking to invalidate a CTM.

Interestingly, the courts declined to consider Edwin's plea that the rights to the name ELIO FIORUCCI were included in the original transfer of assets from Fiorucci to Edwin. This serves to remind intellectual property practitioners of the importance of considering unregistered rights when arranging transfers of intellectual property.

[i]In 1979, along with Halston and Gucci, Fiorucci was memorably name-checked in the Sister Sledge disco song, He's The Greatest Dancer.