



Press and Information

Court of Justice of the European Union

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Judgment in Case C-263/09 P  
Edwin Co. Ltd v OHIM

## **The holder of a name is entitled to prevent its use as a Community trade mark where national law so permits**

*The economic aspects of a right to a name may also be protected*

The Community trade mark regulation<sup>1</sup> provides that a trade mark may be declared invalid where its use may be prohibited pursuant to an earlier right, in particular a right to a name, as defined by European Union law or national law.

Fiorucci SpA is an Italian company which was set up by the fashion designer Elio Fiorucci in the 1970s. In 1990 it sold the entirety of its 'creative assets', including all the trade marks which it owned, to the Japanese company Edwin Co Ltd.

In 1999, on application by Edwin, OHIM registered the word mark 'ELIO FIORUCCI' for a series of goods, namely perfumery, leather goods, articles of luggage and clothing. Mr Fiorucci, relying on the trade mark regulation in conjunction with Italian law<sup>2</sup>, challenged that registration, claiming that in Italy his name enjoyed special protection, under which a well-known personal name can be registered as a trade mark only by, or with the consent of, that person, and that no such consent had been given in this case.

OHIM, however, decided that the Italian law did not apply in this case because the name Elio Fiorucci had acquired renown in the context of the latter's commercial activity. OHIM therefore allowed the application for registration.

Following the action brought by Mr Fiorucci, the General Court of the European Union annulled<sup>3</sup> that decision in 2009 in so far as it contained an error of law in the interpretation of the national law. The General Court confirmed that OHIM may declare a Community trade mark to be invalid, on application by an interested party, if its use can be prohibited pursuant to, in particular, an earlier right to a name protected by national law. It held, however, that OHIM had ruled out, incorrectly, the application of national law in the case of Mr Fiorucci.

Edwin subsequently lodged an appeal before the Court of Justice. The Japanese company claimed that the trade mark regulation refers to the 'right to a name' solely as an attribute of personality. On that ground the General Court had not, it argued, applied the trade mark regulation correctly.

In today's judgment, the Court of Justice interprets the concept of the 'right to a name', which may be relied on in an application for a declaration that a trade mark is invalid, within the meaning of the trade mark regulation. It is required to clarify whether that concept refers solely to an attribute of personality or concerns in addition its commercial exploitation.

The Court of Justice finds first of all that **the wording and structure of the trade mark regulation do not permit the concept of the 'right to a name' to be restricted to an aspect of an**

<sup>1</sup> Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), Article 52(2)(a).

<sup>2</sup> The Italian Industrial Property Code (Codice della Proprietà Industriale, 'the CPI') provides that, if it is well known, a personal name may be registered as a trade mark by, or with the consent of, the proprietor.

<sup>3</sup> Case [T-165/06 Fiorucci v OHMI – Edwin \(Elio Fiorucci\)](#)

**attribute of personality. On the contrary, the concept may also cover the commercial exploitation of the name.**

The regulation provides for a Community trade mark to be declared invalid where an interested person claims *another earlier right*, and gives a non-exhaustive list of four examples: besides the right to a name, it cites the right of personal portrayal, copyright and industrial property rights. The economic aspects of some of those rights are protected, both under national laws and under European Union law. There is no reason, therefore, not to afford the same protection to the 'right to a name'.

**The General Court was thus fully entitled not to restrict the protection provided by the trade mark regulation merely to situations where the registration of a Community trade mark conflicts with a right intended to protect a name exclusively as an attribute of the personality of the person concerned.** In other words, the right to a name may be relied on not only in order to protect a name as an attribute of personality but also to protect its economic aspects.

The Court of Justice also confirms the jurisdiction of the General Court to review the legality of OHIM's assessment of the national law relied on. It states that, in the context of an appeal, the Court of Justice has jurisdiction itself to determine whether the General Court, on the basis of the documents and other evidence submitted to it, distorted the wording of the national provisions or of national case-law, or of the academic writings concerning them, and whether the General Court made findings that were manifestly inconsistent with their content or significance.

Consequently, the Court of Justice finds that the General Court was fully entitled, without distorting the national law<sup>4</sup>, to infer from it that, irrespective of the sector in which that renown was acquired and even where the name of the well-known person has already been registered or used as a trade mark, **the proprietor of a well-known name is entitled to prevent the use of that name as a trade mark where he has not given his consent to its registration as a trade mark.**

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The [full text](#) of the judgment is published on the CURIA website on the day of delivery.

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<sup>4</sup> CPI, see footnote 2.