

Bugnion SpA

Power to the people

Italian law provides strong protection for the personal names and portraits as trademarks

The relationship between image protection and trademarks is defined by the few articles in the Industrial Property Code that deal specifically with images and personal names in relation to trademarks.

Article 8 of the code deals with portraits of people, names and well-known marks used as trademarks. The strongest protection is reserved for a person's portrait. Article 8.1 provides that: "portraits shall not be registered as trademarks without the person's consent and, after their deaths, without the spouse's and sons' consent; failing the latter or, after their death, of the parents' or other ancestors' consent, and, failing also the latter or after their death, of other relatives until the fourth degree included."

This article is not limited to famous people, but applies to portraits of any individual.

The severity of this law corresponds to Article 10 of the Civil Code and Articles 96 and 97 of the Copyright Law, which prohibit the public use of another person's image when this is not justified by specific reasons (eg, the right to information or the right to public function). In substance, such laws exclude any commercial use of another person's image without his or her consent.

Article 8 of the Industrial Property Code goes on to clarify that the use of another person's image in connection with a trademark is, by definition, a commercial use.

Article 8.2 of the code deals with the names of non-famous people and provides that: "names other than those of the person who applies for registration may be registered as trademarks, provided that the use of such names is not such as to harm the fame, credit or decorum of the person who is entitled to use such names. The Italian Patents and Trademarks Office may, however, condition the registration to

obtaining the consent as set forth in paragraph 1. In any case, the registration shall not prevent the legitimate holder of the right to the name from using it in the corporate name chosen by the same."

Unlike in other jurisdictions (eg, the United States), in Italy it is legal to register the name of a living person without his or her consent, provided that the person is not famous. This protects the good faith of trademark applicants that happen to use a name that they believe to be fictitious. However, despite this presumption of good faith, proof to the contrary may be presented by the person whose name is used.

It follows that a trademark registration containing a name of a living person and obtained by a third party in good faith prevents that person from obtaining a trademark containing his or her name, since it would clearly infringe the prior mark (without this provision, the clause stating that "In any case, the registration shall not prevent the legitimate holder of the right to the name from using it in the corporate name chosen by the same" cannot be explained). However, such person may use his or her own name for commercial purposes (eg, as the name of a company), but may not register it as a trademark.

The only limit set out in the code with regard to the use of names as trademarks is that such use must not "harm the fame, credit or decorum of the person who is entitled to use such names". There is not a great deal of case law to help to determine the extent of these limits, but in a ruling from the Milan Court of Appeals dated July 30 1996 (*Teatro alla Scala*) the judges stated that "it should be excluded that merely using another person's name as a distinctive mark of products and services constitutes detriment per se to credit and decorum" (and moreover, if this were not the case

then this article would have no meaning). Such damage, the court stated, "is verified when the other person's name serves to designate a product of lowly nature, with little decorum, on its own or when the name is inserted within a complex trademark with elements not suitable for the decorum of the owner of the used name".

The Industrial Property Code also gives the Patent and Trademark Office the authority to summon the owner of the name in question. A possible application of this provision could be related to trademarks that the office deems contrary to public decency (eg, for erotic objects); nevertheless, as can be imagined, there is little case law on the subject.

The final part of Article 8 deals with names and well-known marks, and provides that: "The following, if renowned, may be registered as trademarks by the person holding the right, or with his consent or by the persons set forth in paragraph 1 (i.e. spouse, son, relatives): names of persons, signs used in the fields of art, literature, science, politics and sports, the names or abbreviations of events and of entities and associations not having economic purposes as well as the characteristic badges or emblems."

Unlike the Civil Code and the Copyright Law, this article appears to protect not only individuals, but also the names and well-known marks belonging to associations, organisations and political parties, even extending to sporting and cultural events.

On December 4 2001 the Court of Palermo deemed in *Varenne* that this law applied to the name of a racehorse that was famous throughout Italy for its athletic prowess; the court deemed the horse's owner to be the holder of the right to register his name as a trademark.

This ruling suggests that the exclusive right to enhance and commercialise a

famous name is reserved for the legitimate holder of that name, as well as the registration of its own trademark. Corresponding to this, there is a general prohibition on use by other non-authorised persons (Court of Modena, June 26 1994).

However, the law fails to clarify the range of this protection. Regulations, doctrine and the majority of case law are silent on the matter, suggesting that there is a tendency towards absolute protection. However, it is more reasonable to expect greater protection in sectors where merchandising is most common.

Another problem is where coincidences of names occur. Under the regulations, a coincidence of names does not justify the exploitation of a well-known name.

The law does not expressly deal with the bad-faith aspects of trademarks containing famous names filed by third parties. However, it would appear that any trademark containing the name of a well-known person (or organisation) can be considered to have been filed in bad faith almost automatically. Of course, the trademark must be filed after the person has become famous. On July 21 1998 the Court of Venice stated, with reference to the trademark *MORO DI VENEZIA* – dealing with the name of a boat registered in the America's Cup – that “no unlawful act has occurred if the name appropriated by the registering party lacked notoriety at the time of registration”.

Further, in general, it can be held that the presumption of bad faith must be considered in all cases where someone can claim a legitimate expectation of protection and the trademark filer was aware of this at the time of filing.

If a trademark filing containing a famous name is deemed to have been made in bad faith, this has an important consequence for validation. Regardless of the fact that the relative regulation pertaining to trademark validation in the code expressly refers to Article 8, the same regulation states that the validation does not occur when the subsequent trademark was applied for in bad faith.

Therefore, if the trademark containing the famous name is applied for in bad faith, as it seems easy to sustain, the person may become active in protecting his or her image at any time (this also applies when the famous person notices the filing of a trademark containing his or her name after an extended period or tolerates the use of such mark for an extended period (ie, over five years).

The code essentially provides two penalties for bad-faith registration of a



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trademark: the holder of the famous name can request annulment of the subsequent trademark (Article 25 of the Industrial Property Code), or can use a claim action (Article 118 of the code), whereby the famous name holder requests the judge for a ruling to obtain the pending application or already granted registration. As occurs in the Community system, the prior famous name is not a valid base of opposition to the trademark in Italy (when the opposition system is definitively established in Italy).

From a substantive point of view (ie, when the trademark containing a famous name is not only registered, but actively used), a wide range of remedies are offered. These range from the possibility of precautionary measures to compensation for damages.

A recent case, decided by the Court of Turin with various rulings and decrees and concluded in January 2010, involved the use and registration of the first name of a famous Italian rock star (Vasco Rossi) registered and used for non-official merchandising items. This case is invaluable for understanding the extent of protection given by Italian trademark legislation to the images of famous people.

The Court of Turin sustained that:

- precautionary provisions of seizure and injunction must be granted (with a tour imminent) *ex parte* against subjects who have filed trademarks on their own behalf containing unequivocal references to the famous singer;
- the first name of a famous person cannot be registered as a trademark by third parties without the consent of that famous person; and
- the first name of a famous person cannot be used without the consent of the famous person as a trademark by third parties, regardless of whether they own a registration in such a mark.

The Court of Turin commented on the extent of such protection, stating that the phenomenon of merchandising agreements to sell clothing articles and stationery bearing the name of the artist is widespread. Since the five-year period had not lapsed for validation of the subsequent trademark, the court was unable to rule on the indefeasibility of the action reserved to the holder of the famous name; nevertheless, authoritative commentators have affirmed that the validation must not be applied.

The legal resources protecting famous names, as provided by Italian law, are useful to protect acclaimed international rock stars and other famous people (eg, actors, artists, athletes) from the exploitation of their own names where they have not registered these as trademarks in Italy in a timely manner. It also prevents their merchandising from being subject to mass infringement, a phenomenon that is unfortunately all too common in Italy. [WTR](#)