

Legal Battle over Gucci name. Guccio Gucci successful in Italy as Florence Court stops use of Elisabetta Gucci mark.

On July 16, 2010, the luxury goods brand Gucci obtained a preliminary injunction from the specialized IP Court of Florence, preventing the unauthorized use of the name ELISABETTA GUCCI in commerce and in advertising throughout the European Union.

The case is of particular significance as, in its ruling, the Court, referring to the principles established in another Italian landmark decision on the use of a well-known patronymic mark by a homonymous third party (the ELIO FIORUCCI case, Milan Court 2008), delineates further the scope of the concept of “honest practices in trade” and of the own name defence, provided by Article 6(1)(a) of the CTM Directive and concurrent Article 21(1)(a) of the Italian IP Code, as well as by Article 12(a) CTMR.

BACKGROUND

The case relates to the **famous GUCCI mark**, owned by the claimant, the well known Italian fashion house Guccio Gucci S.p.A. (owned by PPR) which was established in Florence almost a century ago by its homonymous founder. The fashion company owns several Italian GUCCI trademark registrations, dating back as far as 1977, covering classes 1 up to 42, in addition to two CTM registrations in all classes.

Ms. Elisabetta Gucci, a great-granddaughter of the fashion empire's founder, in her capacity of artistic director of an Italian interiors and accessories company, authorized the same and other related companies (the defendants) to use and register her name as trademark and domain name.

The interiors and accessories company further owns the **Italian trademark registration ELISABETTA GUCCI** – filed in November last year – for building construction, repair and installation services in class 37. In addition, it registered the **domain name <elisabettagucci.com>**.

This website announced the imminent launch of a hotel chain branded as ELISABETTA GUCCI Hotels & Resorts, the first opening of which was scheduled in Dubai at the end of 2010.

In addition, the website informed that Ms. Gucci also markets food and beverages services under the names “EG and Elisabetta Gucci Boutique Caffè”, “Elisabetta Gucci Caffè”, etc.

The website clearly indicated that Ms. Guccio has no connection with the famous GUCCI brand; however, it also stated that Ms. Gucci “is a fourth generation descendant of the famous Florentine dynasty” and that she previously had “gained experience within the family company”. The name and surname in question was further mentioned on every page and along with every activity advertised on the website.

DECISION

➤ Guccio Gucci claimed infringement of its national and community trademarks and requested that the Court enjoin the defendants’ use of the ELISABETTA GUCCI sign in trade throughout the EU territory.

➤ The defendants argued that the contested use of the Elisabetta Gucci name was in accordance with honest practices in trade, i.e. in compliance with the provisions on the limitation of the effects of trademarks — the use of one’s own name —, so as to not infringe the exclusive rights of the claimant.

➤ The Florence Court agreed with the claimant that the use of the Elisabetta Gucci name was not in accordance with honest practices, as it was exclusively aimed at boosting the homonymous brand. Likewise, the Court found that the domain name and the content of the website had the sole purpose of promoting the Elisabetta Gucci mark, alone or with additional non distinctive matter. The fact that the website specified that there was no link with the Gucci group, was not sufficient to fall within the scope of the own name defence, as several other elements revealed the intention of the website administrators to take unfair advantage of the reputation of the claimant’s well-known trademarks.

In conclusion, the defendants were ordered to immediately cease the use, throughout the EU, for business or advertising purposes of the ELISABETTA GUCCI sign as well as of the homonymous domain name. In addition, the Court imposed a penalty of Euro 2,000 for each future violation and for each day of delay in implementing the decision. The Court also ordered the publication of its interim decision at the expense of the defendants in the mainstream Italian daily newspapers “Il Corriere della Sera” and “La Repubblica” as well as in “Vanity Fair” magazine. Finally, the defendants were ordered to pay two thirds of the costs of the proceedings.