

Italy

TRADE MARKS

Existence of the risk of confusion

Court of Milan

August 27, 2007

FACTS: In August 2007 Pin – Up Stars S.r.l. applied to the Court of Milan for an ‘interim judgement’, claiming unfair competition and infringement of its own trademark ‘PIN-UP STARS’ for swim-suits. The complaint regarded products from Fashion Work and Starlab Fashion’s. The contested products were promoted with the trademark ‘UPSTAR’ for jeans and casual wear on a fashion dealer’s web site, registered in the name of Denim House.

HELD: The Court of Milan rejected the preliminary plea of lack of jurisdiction raised by the Defendants, these alleging that Denim House was not the retailer of the products. The Court stated that, despite being only a company belonging to the dealer’s group, in the other Defendants’ web site ‘www.upstar.it’ Denim House appeared to be mentioned as official dealer and also appeared to be directly involved in the retailing activity.

Furthermore, the Judge acknowledged the likelihood of a risk of confusion between the trademarks, stating that, although the Applicant had not proved the reputation of its sign during the period of the Defendants’ trademark registration, the similarity of a significant part of the trademarks suggested a hooking.

The Court held that even the term ‘star’ was not distinctive *per se*, the trademark enforced is distinctive when ‘star’ is used in combination with the other element of the trademark. The Court held that in the past the OHIM was supposed to have shared the same view when it granted the registration of the trademark ‘PIN-UP STARS’ by considering it different from an earlier trademark ‘PIN-UP’ for the same goods. According to the Court, the lack of any conceptual meaning of the word ‘UPSTAR’ seemed to confirm the real intent of the Defendants to take unfair advantage of the association between marks. In the light of the fact that there is a partial overlapping of the products sold by the Parties and that beachwear can be combined with casual wear, the Court

deemed the risk of association between the marks as existing and granted most of the interim measures sought.

Comments: In the present case what is relevant is the Judge's assessment of the risk of confusion between the signs.

When assessing the risk of confusion, the Judge took little account of the conceptual difference between the marks and considered the prominence of the sole visual and phonetic aspects, in particular relating to the dominant part of the enforced trademark. A recent decision of the European Court of First Instance (Case – SUNPLUS ; Dec. 15.11.2007) focuses the attention on the importance to ascertain which is the dominant part of the sign.

Indeed, the first part of the mark and the conceptual one are usually considered to catch the consumer's attention and to be remembered more clearly than the rest of the sight.

Due to the misleading approach to the case, the Judge went on considering the signs very similar in the last part, this being deemed to be very distinctive in the Applicant's mark if in combination with other elements. This view led the Judge even to find the Defendants' meaningless trademark as an attempt to hook the other sign's reputation.

Despite the lack of evidence of the Applicant's trademark reputation at the time of the Defendants' registration, the strong distinctive power of the Plaintiff's mark and its advertising on some newspapers were deemed sufficient for it to enjoy a wide protection over similar goods.

Indeed, it must be borne in mind that the Applicant's sign was applied only to beachwear, whereas the Defendants' mark concerned casual wear. In this regard, the Italian case law, amongst others, stated that a wide protection is to be recognized only to products that meet the same needs. This is not the case here. Furthermore, when the use of a trademark, even a famous one, relates only to a single-product market, the risk of confusion for the consumer is quite reduced.

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Therefore, the contradiction of the Judge's statement apparently lies in the fact that he denied any reputation to the Applicant's trademark on the basis of evidence provided, and yet, he held the existence of a risk of confusion, (better of association), between the marks, on the basis of the criteria used for well-known trademarks.