



Hold the Bellini

Magdalena Borucka explains why a Cipriani scion failed to secure a name-based mark



GIUSEPPE CIPRIANI founded Harry's Bar, home of the Bellini, in Venice in 1931, and opened Hotel Cipriani in 1958. In 1966, all shares in the hotel were transferred to a third party, and Hotel Cipriani SpA (now Hotel Cipriani Srl) was authorised to use the name Cipriani. In 2014, the hotel was renamed Belmond Hotel Cipriani. It has earned a reputation as one of the world's most luxurious hotels.

Giuseppe Cipriani and, subsequently, his son, Arrigo Cipriani, carried on running Harry's Bar and opening new venues under the Cipriani family name, becoming known for serving traditional Italian food in an opulent setting.

In 1969, Hotel Cipriani SpA applied to register the Italian word mark CIPRIANI and, in 1996, applied for an EU trade mark (EUTM), which was transferred to Hotel Cipriani Srl in 2006. On 31st July 2009, Arrigo filed an application for a declaration of invalidity of this EUTM in respect of all goods and services on the grounds of Article 52(1)(b) of Council Regulation (EC) No 207/2009 (EUTMR) (bad faith), and Article 53(2)(a) EUTMR, read together with Article 8(3) of the Italian Industrial Property Code (infringement of the right of a well-known person to his name). The Cancellation Division rejected the application, and EUIPO's Fourth Board of Appeal (BoA) dismissed Arrigo's appeal. Arrigo appealed to the General Court (GC).

The GC affirmed the test for bad faith and confirmed that all relevant factors at the time of filing of a trade mark application must be taken into account. Since the Italian registration had never been challenged, seeking registration for an EU mark for business activities lawfully exercised for many years could never constitute

an act of bad faith. Extending the protection of a national mark to the EU can only be seen as a normal commercial strategy. In the GC's opinion, Arrigo had not produced evidence to support his allegations that the sole intention of the EUTM registrant was to hinder Arrigo's activity in the independent restaurant sector.



The GC further confirmed that EUIPO may take the judgment of national authorities into consideration, and found that the BoA was right in referring to the judgment of 9th December 2008 of the English High Court and applying the principle of *res judicata*.

Regarding the alleged infringement of Italian law, the GC held that Arrigo failed to produce the national provisions or elements of doctrine that applied. The evidence aiming to show that the surname Cipriani is commonly linked per se to Arrigo was insufficient, especially as most of it referred to him by his first name and surname. Therefore, at the relevant date, Arrigo could not have relied on the renown of the Cipriani surname alone, and the relevant Italian provision could not apply. The application was dismissed as unfounded.

The factual matrix surrounding the Cipriani name is complicated and has now been the subject of a number of proceedings. That said, there is little new law in this decision, which simply restates the position on bad faith.

KEY POINTS

- ▶ The established test for bad faith was confirmed
- ▶ EUIPO may take into consideration decisions given by national authorities
- ▶ No satisfactory evidence for an own-name defence was produced



MAGDALENA BORUCKA

is a Trade Mark & Design Formalities Lead at Allen & Overy LLP, and a Polish trainee attorney at law
magdalena.borucka@allenoverly.com