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## Weak marks grown stronger: DIVANI & DIVANI trumps DIVINI & DIVANI

On February 2 2015 the Supreme Court ruled on the issue of secondary meaning, pursuant to Article 13(1) of the Industrial Property Code (D Lgs 30/2005), and its effect when applied to an originally weak trademark

### Background

Natuzzi spa manufactured sofas and armchairs under the DIVANI & DIVANI brand name, which was registered as a trademark in Italy and in the European Union. Natuzzi filed a complaint alleging trademark infringement and unfair competition against Divini & Divani, which used the mark DIVINI & DIVANI in social media and for identical products.

In its complaint Natuzzi asked the Court of Bari to enjoin Divini & Divani from using this mark because it was confusingly similar to and constituted infringement of its prior and well-known mark. Natuzzi also asserted that its trademark should be recognised as having acquired enhanced distinctive character due to its longstanding presence in the sofa and armchair market.

The Court of Bari agreed with Natuzzi concerning the counterfeit nature of Divini & Divani's mark with respect to the DIVANI & DIVANI trademark. However, it rejected the unfair competition claim.

The defendant appealed, denying any similarity between the marks on the grounds that the plaintiff's prior marks were weak.

In April 2008 the Court of Appeal reversed the decision of the Court of Bari and rejected all of Natuzzi's claims, stating that:

- the DIVANI & DIVANI trademarks owned by Natuzzi were weak, consisting merely of the repetition of the common word 'divani' with the addition of an ampersand in the middle;
- weak marks may be protected only in regard to marks that are strictly identical; and the longstanding diffusion and promotion of Natuzzi's marks in the relevant market were irrelevant in determining whether a trademark is weak or strong.

### Decision

Natuzzi appealed to the Supreme Court, which reversed the Court of Appeal concluding that:

- the protection of weak marks is not limited to cases of strict identity between the marks; and
- the principle of secondary meaning must be applied when evaluating marks that were originally weak, but have subsequently acquired distinctiveness and strength through widespread use and promotion.

In so concluding, the Supreme Court confirmed that even a weak trademark can be protected against counterfeit marks if the later mark simply includes variations that cannot, *per se*, exclude likelihood of confusion with the central elements of the prior trademark. Further, the Supreme Court stated that failure to apply this principle would lead to the conclusion that weak marks can be enforced only against identical and totally overlapping marks. The Supreme Court also noted that the appeal court had erred by carrying out an analytical examination of each element of the marks and by failing to compare them in their entirety, as required by established case law.

The Supreme Court determined that the issue of the rehabilitative power of use (ie, the principle of secondary meaning) was not correctly applied by the Court of Appeal insofar as it excluded the possibility that use of the DIVANI & DIVANI trademark could strengthen a mark that was weak to start with. The principle of secondary meaning should be applied in order to assess the evolution and reinforcement of the distinctive character of marks that are weak, provided that they are not completely devoid of distinctive character.

In accordance with this principle, the appeal court should have evaluated whether the DIVANI & DIVANI trademark had acquired enhanced distinctive character through use and promotion so as to become recognisable as a well-known sign.

For these reasons the case was remanded to the Court of Appeal for further consideration.

### **Comment**

The Supreme Court's judgment may lead to further developments regarding two issues that have been discussed for some time: the extent of the protection of weak signs and the application of secondary meaning as a remedy to strengthen the distinctive character of such signs.

The Supreme Court restated – and thus reaffirmed – certain principles.

One such principle is that a weak trademark is not solely protected against identical signs.

Such limited protection would be inconsistent with the protection of weak signs. Indeed, a weak trademark must be protected against later signs that are different in minor ways which are unrelated to the distinctive and dominant elements of the prior mark.

A condition for the application of this principle is that the weak sign must have at least a minimum degree of distinctiveness *per se*. The appeal court recognised that DIVANI & DIVANI did have such a minimum degree of distinctiveness, and this point was

confirmed by the Supreme Court even where the minimum degree of originality requirement was satisfied by the simple repetition of the product's name.

The second principle set down by the Supreme Court relates to the concept of secondary meaning. The court provided an interpretation of this principle which is of relevance for both:

- the acquisition of distinctive character for marks that are totally invalid from the start;

and

- the strengthening of originally weak signs with distinctiveness which evolves and increases through widespread use and promotion.

Thus, the Supreme Court's decision provides that such rehabilitation allows an originally weak mark eventually to acquire the same protection as is afforded to originally strong marks.

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