JUDGMENT OF THE COURT OF FIRST INSTANCE (Fifth Chamber)

14 May 2009 *

In Case T-165/06,

Elio Fiorucci, residing in Milan (Italy), represented by A. Vanzetti, G. Sironi and F. Rossi, lawyers,

applicant,

v

Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM), represented by O. Montalto and L. Rampini, acting as Agents,

defendant,

the other party to the proceedings before the Board of Appeal of OHIM, intervener before the Court of First Instance, being

* Language of the case: Italian.

Edwin Co. Ltd, established in Tokyo (Japan), represented by D. Rigatti, M. Bertani, S. Verea, K. Muraro and M. Balestriero, lawyers,

ACTION brought against the decision of the First Board of Appeal of OHIM of 6 April 2006 (Case R 238/2005-1), concerning invalidity and revocation proceedings between Mr Elio Fiorucci and Edwin Co. Ltd,

THE COURT OF FIRST INSTANCE
OF THE EUROPEAN COMMUNITIES (Fifth Chamber),

composed of M. Vilaras, President, M. Prek and V.M. Ciucă (Rapporteur), Judges,

Registrar: J. Palacio González, Principal Administrator,

having regard to the application lodged at the Registry of the Court of First Instance on 19 June 2006,

having regard to the response of OHIM lodged at the Registry on 1 December 2006,

having regard to the response of the intervener lodged at the Registry on 6 December 2006,

further to the hearing on 5 November 2008,

gives the following

Judgment

Background to the case

1 The applicant, the fashion designer Elio Fiorucci, achieved certain renown in the 1970s in Italy. Following financial difficulties in the 1980s, an administrator was appointed in respect of his company, Fiorucci SpA.

2 On 21 December 1990, Fiorucci sold to the intervener, Edwin Co. Ltd, a Japanese multinational, the entirety of its 'creative assets'. Article 1 of the contract stipulates:

'The company Fiorucci assigns, sells and transfers to the company Edwin … which, for its part, acquires:

— (i) trade marks wherever registered, or trade marks for which registration has been sought in any part of the world whatsoever, and all patents, ornamental and utility models and all other distinctive signs belonging to the company Fiorucci, as listed in the annex to this contract under letter A, A1-A2 and A3 (the trade marks registered in Italy are listed under A; the trademarks registered abroad under A1; the Italian patents under A2; and the foreign patents under A3);

— (ii) all the existing contracts concerning trade marks and any other distinctive signs, including licensing agreements allowing use of those trade marks;

— (iii) all the Fiorucci archives of models on paper, coloured posters, collections, fabric samples, posters for window display, advertising aids, samples of clothes collections created by the Fiorucci company, photographs (the "know-how");

— (iv) all the rights exclusively to use the designation "FIORUCCI" and exclusively to manufacture and sell the clothes and other goods bearing the name "FIORUCCI".'

3 For several years, the applicant collaborated with the intervener.

4 On 23 December 1997, the intervener filed an application with the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) for registration of the word mark ELIO FIORUCCI as a Community trade mark in respect of a series of goods falling within Classes 3, 18 and 25 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

5 On 6 April 1999, the word mark ELIO FIORUCCI was registered by OHIM and published in the *Bulletin of Community Trade Marks* No 39/1999 of 17 May 1999.

6 On 3 February 2003, the applicant filed an application for revocation and for a declaration of the invalidity of that mark, pursuant to Article 50(1)(c) and Article 52(2)(a) of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), as amended.

7 By decision of 23 December 2004, the Cancellation Division of OHIM allowed the application for a declaration of invalidity of the mark ELIO FIORUCCI on the ground of infringement of Article 52(2) of Regulation No 40/94, without finding it necessary to rule on the application for revocation of that mark.

8 The Cancellation Division found that Article 21(3) of the Legge Marchi (Italian Law on trade marks) (now Article 8(3) of the Codice della Proprietà Industriale (Italian Industrial Property Code)) was applicable and annulled the registration of the mark at issue because it was established that the name Elio Fiorucci was well known and because there was no evidence of explicit, clear and unequivocal consent to registration of that name as a Community trade mark. Taking the view that that ground alone led to the invalidity of the mark, the Cancellation Division found that it was not necessary to examine the grounds for revocation put forward by the applicant.

9 The intervener then brought an appeal against that decision before the Board of Appeal of OHIM seeking the rejection of the application for a declaration of invalidity of the mark at issue and maintenance of the registration.

10 By decision of 6 April 2006 ('the contested decision'), the First Board of Appeal of OHIM allowed the intervener's appeal and annulled the decision of the Cancellation Division, holding that the ground of invalidity referred to in Article 52(2) of Regulation No 40/94 did not apply in the present case, which did not fall within the cases provided for under national law (Article 8(3) of the Codice della Proprietà Industriale). The application brought by the applicant for revocation of the mark at issue, alleging infringement of Article 50(1)(c) of Regulation No 40/94, was also rejected by the Board of Appeal.

11 In particular, the Board of Appeal stated that the raison d'être of Article 8(3) of the Codice della Proprietà Industriale was to prevent third parties from exploiting for commercial purposes the name of a famous person. According to the Board of Appeal, that provision was introduced in order to protect the commercial potential of a name which has become famous in sectors other than the strictly commercial sector (for example, in the artistic, political or sporting fields). The Board of Appeal stated that there was not, to its knowledge, case-law on that point but that 'the most authoritative Italian academic writings' seemed to confirm that the raison d'être of the provision cited ceases where that commercial potential is already fully exploited. The Board of Appeal stated that, in the present case, the renown of the name Elio Fiorucci with the Italian public could certainly not be regarded as arising from its first use in the non-commercial sector. On the contrary, according to it, in the light of the pleadings and of the applicant's own arguments, the renown of Elio Fiorucci as a cultural figure was the direct result of the renown of Elio Fiorucci as a fashion designer and therefore of his commercial activity. For the abovementioned reasons, the Board of Appeal found that the registration of the name Elio Fiorucci as a Community trade mark by the proprietor did not fall within the cases set out in the national provision referred to, and, therefore, that the condition for invalidity laid down in Article 52(2) of Regulation No 40/94 was not satisfied.

12 With regard to the application for revocation brought under Article 50(1)(c) of Regulation No 40/94, the Board of Appeal stated that the raison d'être of that provision was to protect public confidence in the conformity of the goods with the message contained in the mark following its registration. Consequently, according to the Board of Appeal, two conditions must be satisfied for that provision to apply:

— the first is that the mark contains a message as to the nature, quality, geographic origin, or, in the present case, the stylistic origin of the goods;

— the second is that, in the use of the mark, a divergence must be detected between that message and the characteristics of the goods covered by the mark presented to the public.

13 In the present case, the Board of Appeal considered that the first of the two conditions was not satisfied, meaning that it was impossible to establish whether the second was. It found that the mark in question was devoid of any message as to the geographic origin, nature, quality or even the stylistic origin of the goods concerned. The Board of Appeal stated that the public did not necessarily link the goods covered by a mark consisting of a patronymic to the corresponding physical person. It explained that the public is aware that patronymics are commonly used as commercial marks, but that does not imply that those patronymics correspond to an actual person. In addition, the Board of Appeal held that, by the sale of 1990, the applicant had waived all rights of use pertaining both to the mark FIORUCCI and to the mark ELIO FIORUCCI. It found that the distinction between those two marks was artificial and that the mark FIORUCCI and the patronymic, a de facto distinctive sign, were completely identical.

14 With regard to the second ground for revocation put forward by the applicant, namely the deterioration in quality of the goods covered by the mark ELIO FIORUCCI, the Board of Appeal held that the ground for revocation referred to in Article 50(1)(c) of Regulation No 40/94 did not apply. It noted that the interest protected by that article was not the quality of the goods in an abstract sense but public confidence in the specific characteristics of the goods promised by the mark. In the present case, the Board of Appeal found that the mark ELIO FIORUCCI, representing only the name of a person, did not give any indication of a specific quality and that therefore there could not be any question of the public being misled.

Forms of order sought by the parties

15 The applicant claims that the Court should:

— annul the contested decision and declare invalid the Community trade mark ELIO FIORUCCI;

— in the alternative, declare the Community trade mark ELIO FIORUCCI to be revoked;

— order OHIM and the intervener to pay the costs.

16 OHIM contends that the Court should:

— dismiss the action;

— order the applicant to pay the costs.

17 The intervener contends that the Court should:

— declare inadmissible:

(a) the applicant's application for annulment of the contested decision, in so far as it rejects the application for a declaration of the revocation of the Community trade mark ELIO FIORUCCI;

(b) the applicant's application for a declaration of revocation for misleading use of the trade mark at issue,

(c) the applicant's application for a declaration of invalidity of the mark at issue on account of its deceptive nature within the meaning of Article 7(1)(g) of Regulation No 40/94,

— dismiss all the applications brought by the application as legally and factually unfounded;

— order the applicant to pay the costs.

Law

Admissibility

18 The intervener contends that, in challenging the part of the contested decision which concerns the revocation application, the applicant has failed to explain the nature of the alleged infringement of Article 50(1)(c) of Regulation No 40/94 by the Board of Appeal. The intervener notes that the applicant has not pleaded error in the interpretation or application of that provision, but has complained rather about the result of its application in the contested decision. According to the intervener, the only objective of the applicant's action is to obtain a re-examination of the facts of the case by the Court, replacing that of OHIM's Board of Appeal. However, the action is raised before a court which, according to Article 63(1) of Regulation No 40/94, may review only the legality

of the contested decision. That is sufficient to conclude that the applicant's application for revocation of the mark at issue must be rejected as inadmissible.

19 The intervener, in addition, contends that the pleas in law relating to the alleged invalidity of the mark at issue based on its lack of novelty and its deceptive nature, within the meaning of Article 7(1)(g) of Regulation No 40/94, and on bad faith in the filing of the mark, within the meaning of Article 51(1) of Regulation No 40/94, constitute new pleas in law which were not the subject of the proceedings before OHIM and must therefore be declared inadmissible.

20 The intervener contends, finally, that numerous documents lodged by the applicant along with its application of 19 June 2006 appear to be new, since they were never submitted in the course of the proceedings before OHIM, in particular annexes A36, A37, A39 to A59, A74 to A94, A103 to A106, A116 and A117. The intervener notes that, according to settled case-law, the parties may not submit new documents to the Court; they are inadmissible as such.

21 It must be borne in mind that the purpose of actions before the Court is to obtain a review of the legality of decisions of the Boards of Appeal of OHIM within the meaning of Article 63 of Regulation No 40/94 (Case T-128/01 *DaimlerChrysler* v *OHIM (Grille)* [2003] ECR II-701, paragraph 18; Case T-129/01 *Alejandro* v *OHIM — Anheuser Busch (BUDMEN)* [2003] ECR II-2251, paragraph 67; and Case T-311/01 *Éditions Albert René* v *OHIM — Trucco (Starix)* [2003] ECR II-4625, paragraph 70). While the Court, under Article 63(3) of Regulation No 40/94,'has jurisdiction to annul or to alter the contested decision', that paragraph must be construed in the light of Article 63(2), which provides that an 'action may be brought on grounds of lack of competence, infringement of an essential procedural requirement, infringement of the Treaty, of this Regulation or of any rule of law relating to their application or misuse of power', and in the context of Articles 229 EC and 230 EC. The Court's review of the legality of a decision by a Board of Appeal must therefore be carried out with regard to the issues of law raised before the Board of Appeal (see Case T-373/03 *Solo Italia* v *OHIM - Nuova Sala (PARMITALIA)* [2005] ECR II-1881, paragraph 25).

22 Therefore, it is not the Court's function to examine new pleas introduced before it or to review the facts in the light of documents adduced for the first time before it. To allow the examination of those new pleas or such evidence would be contrary to Article 135(4) of the Rules of Procedure of the Court, according to which the parties' submissions may not alter the subject-matter of the proceedings before the Board of Appeal. Accordingly, the pleas introduced and the evidence submitted for the first time before the Court must be declared inadmissible and there is no need to examine them (Case C-29/05 P *OHIM* v *Kaul* [2007] ECR I-2213, paragraph 54, and Case T-342/05 *Henkel* v *OHIM — SERCA (COR)* of 23 May 2007, not published in the ECR, paragraph 31).

23 In the present case, concerning the first inadmissibility plea raised by the intervener, it must be pointed out that the applicant clearly invokes an infringement by the Board of Appeal of Article 50(1)(c) of Regulation No 40/94 and therefore one of the grounds provided for under Article 63(2) of Regulation No 40/94. Consequently, the intervener's application concerning the inadmissibility of the second plea in law must be rejected.

24 With regard to the other grounds of inadmissibility raised by the intervener, the case-file indicates that, as correctly argued by the intervener, the pleas in law relating to the alleged invalidity of the mark at issue based on its lack of novelty and on its deceptive nature, within the meaning of Article 7(1)(g) of Regulation No 40/94, and on bad faith in the filing of the mark, within the meaning of Article 51(1) of Regulation No 40/94, constitute new pleas in law which were not the subject of the proceedings before the Board of Appeal of OHIM and must, accordingly, be declared inadmissible.

25 Consequently, the only pleas in law which were properly raised before the Court are those alleging the infringement of Article 52(2)(a) and Article 50(1)(c) of Regulation No 40/94, that is to say invalidity on the ground of infringement of the 'right to a name' and revocation for misleading use, respectively.

26 Moreover, it must be pointed out that some of the documents annexed by the applicant to his application, that is annexes A36, A37, A39 to A59, A74 to A94, A103 to A106, A116 and A117, were not submitted in the course of the proceedings before OHIM and are therefore, under the case-law cited in paragraph 22 above, also inadmissible.

Substance

27 In support of its action, the applicant relies in essence on two pleas in law, alleging infringement of Article 52(2)(a) and Article 50(1)(c) of Regulation No 40/94, respectively. The Court considers it appropriate to begin by examining the second plea in law.

The second plea in law, alleging infringement of Article 50(1)(c) of Regulation No 40/94

28 The applicant claims, in essence, that the Board of Appeal wrongly found that the conditions for the application of Article 50(1)(c) of Regulation No 40/94 were not satisfied in the present case. According to the applicant, the mark ELIO FIORUCCI is, in itself, liable to mislead the public as to the stylistic origin of the goods covered by that mark. The use of that mark by the defendant is also liable to mislead the public.

29 OHIM and the intervener support the position of the Board of Appeal and contend, first, that the mark at issue is not misleading in itself, because consumers are aware that a separation between the designer and the mark bearing his name is common and an

average consumer cannot be misled by the change of ownership of a mark; second, the applicant has never proved any misleading use of the mark whose revocation is sought.

30 With regard, in the first place, to the applicant's argument alleging that the mark ELIO FIORUCCI is, in itself, liable to mislead the public, to the extent that the goods it covers were not designed by the applicant, it should be noted that that argument was rejected in paragraphs 53 and 54 of the contested decision, the Board of Appeal having found that it could not be inferred from the sole fact that a mark and a patronymic were identical that the public concerned will think that the person whose patronymic constitutes the mark designed the goods bearing that mark. According to the Board of Appeal, the use of patronymic marks is a widespread practice in all sectors of commerce and the public concerned is well aware that, behind every patronymic mark, there is not necessarily a fashion designer of that name.

31 Those findings must be upheld.

32 In that regard, the Court of Justice has held that the essential function of a trade mark is to guarantee the identity of origin of the marked goods or services to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin. For the trade mark to be able to fulfil its essential role in the system of undistorted competition which the Treaty seeks to establish and maintain, it must offer a guarantee that all the goods or services bearing it have been manufactured or supplied under the control of a single undertaking which is responsible for their quality (Case C-206/01 *Arsenal Football Club* [2002] ECR I-10273, paragraph 48).

33 Furthermore, with regard to the conditions for revocation laid down by Article 12(2)(b) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), whose normative content is, in essence, the same as that of Article 50(1)(c) of Regulation No 40/94, the Court of Justice has held that a trade mark corresponding to the name of the designer and first manufacturer of the goods bearing that mark is not, by reason of that particular feature alone, liable to revocation on the ground that that mark would mislead the public, in particular where the goodwill associated with that mark has been assigned together with the business making the goods to which the mark relates (Case C-259/04 *Emanuel* [2006] ECR I-3089, paragraph 53). That conclusion is based on the absence of actual deceit or of a sufficiently serious risk that the average consumer will be deceived. Even if the average consumer might be influenced in his act of purchasing the product concerned by imagining that the person to whose name the mark corresponds was involved in its design, the characteristics and the qualities of that product remain guaranteed by the undertaking which owns the trade mark (see, to that effect, *Emanuel*, paragraphs 47 and 48).

34 Equally it must also be held that a trade mark corresponding to the first name and to the family name of the designer and first manufacturer of the goods bearing that mark is not, by reason of that particular feature alone, liable to revocation on the ground that that mark would mislead the public, where the proprietor of that mark has lawfully acquired, by assignment, a mark consisting of just the family name of the designer and all the creative assets of the business making the goods to which the mark relates.

35 As that is indeed the case in the present proceedings, the Court rejects the argument that the mark ELIO FIORUCCI is, in itself, liable to mislead the public as to the origin of the goods for which it is registered within the meaning of Article 50(1)(c) of Regulation No 40/94.

36 In the second place, in relation to the argument based on the alleged deceptive use of the mark ELIO FIORUCCI, said to have misled the public as to the stylistic origin of the

goods and therefore to have constituted deception necessitating the revocation of the mark ELIO FIORUCCI under Article 50(1)(c) of Regulation No 40/94, it must be pointed out that the applicability of that article is conditional on the misleading use of the mark after its registration. Such misleading use must be duly proved by the applicant.

37 However, as correctly contended by OHIM and the intervener, no evidence has been submitted showing any use whatsoever by the intervener of the mark ELIO FIORUCCI after its registration. In the absence of such evidence, there can be no question of use liable to mislead the public within the meaning of Article 50(1)(c) of Regulation No 40/94. In those circumstances, since the present plea in law is not well founded, it must be rejected.

The first plea in law, alleging infringement of Article 52(2)(a) of Regulation No 40/94

38 The applicant claims, first, that the Board of Appeal confused and superimposed the question of the rights relating to the mark FIORUCCI, which was the subject of an assignment, and those relating to the mark constituted by the name Elio Fiorucci, which was never the subject of an assignment, and, second, contests the assertion by the Board of Appeal that Article 8(3) of the Codice della Proprietà Industriale — which provides that only the holder of a well-known name may register it as a trade mark — is applicable only where that name first became well known in the non-commercial sector. He claims that there is no basis for that assertion in the Italian legislation and that, in any case, the applicant is also very well known in the non-commercial sector.

39 OHIM and the intervener consider that that plea must be rejected. They contend in particular that the application of Article 8(3) of the Codice della Proprietà Industriale must be excluded because the raison d'être of that provision is to protect the

commercial potential of a famous name as a distinctive sign and not one already commercially exploited which is already protected under Italian law. The renown of Elio Fiorucci originated in the commercial sector. In the alternative, OHIM and the intervener take the view that, even if the present dispute must be resolved by applying Article 8(3) of the Codice della Proprietà Industriale, it is not possible to infer from that the invalidity of the Community mark ELIO FIORUCCI. They maintain in that regard that, according to the contract of assignment, the latter applied to all the trade marks and all the distinctive signs and that it therefore appears logical to consider that it also concerned the de facto mark ELIO FIORUCCI.

40 The Court recalls that according to Article 52(2) of Regulation No 40/94:

'A Community trade mark shall also be declared invalid on application to the Office or on the basis of a counterclaim in infringement proceedings where the use of such trade mark may be prohibited pursuant to another earlier right, and in particular:

(a) a right to a name;

…

under the Community legislation or national law governing the protection.'

41 Under that provision, OHIM may therefore declare a Community trade mark to be invalid, on application by an interested party, if its use can be prohibited pursuant to, in particular, a right to a name protected by a national law.

42 Article 8(3) of the Codice della Proprietà Industriale provides:

'If they are well known, the following may be registered as a trade mark by the proprietor, or with the consent of the latter or of the persons referred to in paragraph 1: personal names, signs used in the artistic, literary, scientific, political or sporting fields, the designations and acronyms of events and those of non-profit making bodies and associations, including their characteristic emblems.'

43 The Board of Appeal ruled out the application of Article 8(3) of the Codice della Proprietà Industriale in the present case, on the ground, in essence, that that provision applies only where the renown attached to a person's name results from a 'first use outside the market', which was not the case with regard to the applicant's name (paragraph 44 of the contested decision).

44 The Board of Appeal found that such an interpretation of the abovementioned provision was justified by its objective, which is to prevent the exploitation of a famous person's name by third parties for commercial ends (paragraph 31 of the contested decision). According to the Board of Appeal, that provision allows a controlled — that is, subject to the consent of the person concerned — 'migration' of a patronymic 'from the field (of politics, sport, etc.) in which he was hitherto famous to the purely commercial sector' (paragraph 32 of the contested decision).

45 The Board of Appeal added that, if, although famous, the person concerned is already known to the general public as a commercial mark or de facto distinctive mark, that 'migration' has already occurred and, consequently, Article 8(3) of the Codice della Proprietà Industriale does not apply (paragraph 33 of the contested decision).

46 Although it found that there was absolutely no case-law on the interpretation of Article 8(3) of the Codice della Proprietà Industriale, the Board of Appeal considered that its interpretation of that provision was supported in the academic writings of some Italian authors, extracts of which it cited in paragraphs 41 to 43 of the contested decision.

47 In that regard, it must be pointed out that personal names can, both under Community law and Italian law, constitute trade marks (see, with regard to Community trade marks, Article 4 of Regulation No 40/94 and Article 2 of Directive 89/104 and, with regard to Italian marks, Article 7 and Article 8(2) of the Codice della Proprietà Industriale).

48 However, as an indication of the commercial origin of the goods or services covered by it, a mark consisting of a personal name has a different function than a personal name as such, which identifies a specific person.

49 Therefore, the Board of Appeal's finding that the name of a person who has achieved renown on account of his commercial activity can be protected only as a well-known mark and not on the basis of a right to a name under Article 8(3) of the Codice della Proprietà Industriale must be rejected.

50 First, it must be held that the interpretation of Article 8(3) of the Codice della Proprietà Industriale adopted by the Board of Appeal is not confirmed by the wording of that provision, which refers to the names of well-known persons, without making a distinction according to the sector in which that renown was acquired.

51 Moreover, given the lack of a definition in the Codice della Proprietà Industriale of the sectors which can be regarded as 'outside the market', to make the application of the provision in question depend on that concept which is not clearly defined would create ambiguity or even confusion, and could lead to very divergent applications in practice.

52 While certain sectors, such as politics or religion, may, indisputably, be considered to be 'outside the market', whether other sectors do or do not fall within the market is far less clear. It suffices to note in that regard that, as a general rule, a 'famous film director' and a 'popular footballer', mentioned as examples in paragraph 32 of the contested decision, make a considerable financial profit from their respective fields of activities. It could therefore reasonably be maintained that those persons acquired their renown in a field which was not 'outside the market' and that, consequently, and contrary to the position taken by the Board of Appeal, they too were not covered by the Italian provision in question.

53 Second, contrary to what is suggested by the Board of Appeal in paragraph 33 of the contested decision, even on the assumption that the name of a well-known person has already been registered or used as a de facto trade mark, the protection given by Article 8(3) of the Codice della Proprietà Industriale is not in any way superfluous or irrelevant.

54 It should be borne in mind that trade marks are registered and protected in respect of specific goods or services. While it is true that there are provisions such as Article 8(5) of Regulation No 40/94 and Article 4(3) of Directive 89/104 permitting the proprietor of an earlier mark to prevent the registration of another identical or similar mark, even for goods or services which are not identical or in any way similar to the goods or services covered by that earlier mark, the application of those provisions is subject to a series of conditions. It cannot be assumed that those conditions are always satisfied.

55 Consequently, it is not ruled out that the name of a well known person, registered or used as a mark for certain goods or services, can be the subject of a new registration for different goods or services which are not in any way similar to those covered by the earlier registration. The Board of Appeal was therefore wrong to consider that, once the name of a well-known person has been registered or used as a mark, its 'migration' to the trade mark sector has already been 'implemented'.

56 It must be held, furthermore, that Article 8(3) of the Codice della Proprietà Industriale does not lay down, for its application, any condition other than that relating to the well-known character of the personal name concerned. Since that provision grants to persons whose name has acquired renown more extensive protection under less onerous conditions, there is no justification for excluding its application where the name of a well-known person has been registered or used as a mark.

57 Third, the extracts from some of the academic writings cited in paragraphs 41 to 43 of the contested decision also do not allow the conclusion to be drawn that the interpretation of Article 8(3) of the Codice della Proprietà Industriale adopted by the Board of Appeal in the contested decision is correct.

58 Thus, Mr Vanzetti, author with Mr Di Cataldo of the work cited in paragraph 41 of the contested decision, took part in the hearing as lawyer for the applicant and stated that the thesis adopted by the Board of Appeal did not follow at all from what he had written in the work in question, a fact which was minuted at the hearing.

59 Mr Ricolfi, cited in paragraph 42 of the contested decision, refers, according to the Board of Appeal, to the 'renown [of a personal name] resulting from a first use which is frequently not entrepreneurial in character', which does not at all exclude renown resulting from an 'entrepreneurial' use, even if that is less frequent.

60 Only Mr Ammendola, cited in paragraph 43 of the contested decision, refers to a use in a 'sector outside the market', without thereby expressly concluding that Article 8(3) of the Codice della Proprietà Industriale cannot be invoked to protect the name of a person whose renown was not acquired in such a field. In any case, having regard to all of the foregoing considerations, the Court cannot, only on the basis of the opinion of that one author, make the application of the provision in question subject to a condition which does not follow from its wording.

61 It follows that the Board of Appeal committed an error of law in its interpretation of Article 8(3) of the Codice della Proprietà Industriale. As a result of that error it ruled out, incorrectly, the application of that provision to the case of the applicant's name, even though it is not disputed that that is the name of a well-known person.

62 Moreover, even if the interpretation of the provision in question adopted by the Board of Appeal is correct, it is also not disputed that the applicant enjoys renown in a field 'outside the market' too, owing to his activities in the artistic and cultural fields and with regard to the environment and child protection.

63 Even if the renown of the name Elio Fiorucci in the non-commercial sector is regarded as having come later than or as derived from his renown in the commercial sector, that fact alone cannot preclude the protection of that non-commercial renown under Article 8(3) of the Codice della Proprietà Industriale.

64 With regard to the alternative argument presented by OHIM and the intervener that, in essence, the mark ELIO FIORUCCI was included in the assignment, by the applicant to the intervener, of all the marks and all the distinctive signs, it suffices to point out that the Board of Appeal did not reject the application for a declaration of invalidity on that ground.

65 As stated in paragraph 21 above, the Court of First Instance carries out a review of the legality of the decisions of OHIM bodies and may not, in any event, substitute its own reasoning for that of the OHIM body which adopted the contested act (see, to that effect, Case C-164/98 P *DIR International Film and Others* v *Commission* [2000] ECR I-447, paragraph 38). Consequently, the alternative argument submitted by OHIM and the intervener must be dismissed as irrelevant.

66 It follows from all of the foregoing that the first plea in law must be accepted and, consequently, the contested decision annulled.

67 Finally, with regard to the applicant's application for a declaration of the invalidity of the mark ELIO FIORUCCI, it must be pointed out that the applicant is, in essence, asking the Court to adopt the decision which OHIM should have taken, that is a decision declaring the mark in question to be invalid. It must therefore be concluded that, by that part of its first head of claim, the applicant is requesting alteration of the contested decision (see, to that effect, Case T-188/04 *Freixenet* v *OHIM (Form of a matt black frosted-glass bottle)* of 4 October 2006, not published in the ECR, paragraphs 16 and 17). However, since OHIM and the intervener have relied, in answer to the applicant's application for a declaration of the invalidity of the mark at issue, on an argument which was not examined by the Board of Appeal (see paragraph 64 above), the applicant's application to alter the contested decision cannot be granted, since that would imply, in substance, the exercise of administrative and investigatory functions specific to OHIM and would therefore upset the institutional balance on which the division of jurisdiction between OHIM and the Court is based (see, to that effect, *Form of a matt black frosted-glass bottle*, paragraph 47).

Costs

68 Under Article 87(2) of the Rules of Procedure, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings. Moreover, under the same article, where there are several unsuccessful parties, the Court of First Instance shall decide how the costs are to be shared.

69 In the present case, since OHIM and the intervener have been unsuccessful, they must be ordered to pay the applicant's costs, as applied for by him.

70 In those circumstances, OHIM must be ordered to pay, apart from its own costs, two thirds of the applicant's costs and the intervener must be ordered to pay, apart from its own costs, one third of the applicant's costs.

On those grounds,

THE COURT OF FIRST INSTANCE (Fifth Chamber)

hereby:

1. **Annuls the decision of the First Board of Appeal of the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) of 6 April 2006 (Case R 238/2005-1) in so far as it contains an error of law in the interpretation of Article 8(3) of the Codice della Proprietà Industriale (Italian Industrial Property Code);**

2. **Dismisses the action as to the remainder;**

3. **Orders OHIM to bear its own costs and two thirds of the costs incurred by Mr Elio Fiorucci;**

4. Orders Edwin Co. Ltd to pay its own costs and one third of those incurred by Mr Elio Fiorucci.

Vilaras Prek Ciucă

Delivered in open court in Luxembourg on 14 May 2009.

[Signatures]