

Monograms: Just letters or powerful trademarks?

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Some *maisons* have built their empire on motifs made by combining the initials of the founder's name or, more generally, alphabetic letters. However, although the commercial value of monograms is not questioned, they are still made of letters of the alphabet.

Sometimes such letters are graphically elaborated in a way that distinguishes them from the conventional version used in language, but sometimes not. Hence, a question may arise: can monograms be registered as trademarks?

First of all, the chance to register alphabetic letters as trademarks was formally introduced into the Italian legal system only with the enactment of Legislative Decree no. 480/1992 (in implementation of Directive 89/104/ EEC). Despite this result, some courts kept arguing that trademarks consisting of letters are weak, so that even slight changes are sufficient to exclude infringement. However, after the CJEU stated that alphabetic letters can be registered as trademarks as long as they are distinctive (C-265/09), some courts began stating that the validity of a mark consisting of letters must be entirely grounded in the distinctiveness test, if the letters have a particular graphic (see, among others, Court of Naples, March 16 2012 in *Giur. Ann. Dir. Ind.*, 13, 396).

Moreover, in a decision concerning the omega letter used by Ferragamo as the shape of the closing ring of a bag, the Supreme Court ruled that, although the letters of the alphabet are normally language tools, they can be used (regardless of any graphic characterization) as identification signs, and it is precisely for this reason that they can gain distinctiveness (see Court of Cass., March 16 – June 25, 2007, n. 14684, in *Foro it.*, 2008, I, 177).

Still, even well-known monograms are not easily protected in courts. For example, in the Gucci/Guess case, the Court of Appeal of Milan confirmed that the trademark covering two of the Gucci's monograms "letter G with dots" and "the letter G with dots serially repeated" were devoid of any distinctive character (see Court of Appeal of Milan, July 10, 2014, available on *Darts IP*).

Thus, it is important to bear in mind that success and legal protection don't always overlap and that, to enhance the distinctive character of a monogram, particular attention shall be given to the graphic representation, the positioning of the mark (especially if the monogram is a 3D mark) and the description attached to the trademark application.

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