



Richmond Saga: Season 4.0

Foreword

Season 4.0 of the Richmond Saga has begun!

In this season, our protagonists will see the outcome of yet another long-awaited case involving the English fashion designer John Richmond and his former business partner, this time concerning the ownership of the RICH trademark.

For those who missed the past seasons, they can be found here on Lexology ([Season 1.0](#), [Season 2.0](#) and [Season 3.0](#)).

Decision of the Court of Milan on the trademark RICH: content and principles of law stated

Season 4.0 opens with the declaration of invalidity of the Italian registration for the RICH trademark registered by John Richmond's former business partner.

The Court of Milan found that the trademark RICH lacked novelty pursuant to Article 12 of the Italian Industrial Property Code (IPC), as the word RICH reproduces the initial part of the patronymic trademark RICHMOND, owned by the assignees of the JOHN RICHMOND portfolio.

In so holding, the Court emphasized that in the case of patronymic word trademarks, the initial part of the trademark has greater distinctiveness than the final part of the mark, as it is the part of the trademark that is first seen by the consumer and therefore remains more strongly impressed in his or her mind.

As a further element supporting the invalidity of RICH trademark, the Court also pointed out that the goods covered by the trademarks in comparison – RICH and RICHMOND – are perfectly overlapping. This aspect, together with the strong degree of similarity between the two signs, amplified the risk of confusion of the public, because of the well-known principle of interdependence between goods/services and signs, as applied by the European Court of Justice on multiple occasions.

With this decision, the Court of Milan also held that John Richmond's request to obtain the transfer of the trademarks and domain names registrations bearing the sign RICH must be filed before the bankruptcy section of the Court. Indeed, because of company owning these registrations and domain names has entered bankruptcy, any request that may affect the assets of the bankrupt company must be proposed jointly, together with all other creditors, within the special procedures provided for in Bankruptcy Law (Article 52 of the Bankruptcy Law).

Finally, the Court of Milan declared that any use of the RICH trademarks and, more generally, of signs bearing that term, constitutes an infringement of RICHMOND trademarks, pursuant to Article 20 of the IPC, as well as unfair competition pursuant to Article 2598 of the Italian Civil Code.

Brief conclusion

The deadline to appeal this decision is fast approaching, so stay tuned on Lexology to discover what Season 5.0 holds.