

# Daily

Archive

Channel

**SCARPA not necessarily descriptive**

Examination/opposition

**Slovenia - ITEM doo**

National procedures

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The Slovenian Supreme Court has overturned a decision of the Slovenian Intellectual Property Office (SIPO), in which SIPO had refused an opposition against the registration of the trademark LA SCARPA on the grounds that the word '*scarpa*', meaning 'shoe' in Italian, was descriptive (Case I Up 974/2004-3 (U 1584/2002), September 26 2006).

Slovenian company PAMI doo applied to register the trademark LA SCARPA for goods in Class 18 of the **Nice Classification**, namely "trunks, umbrellas, rucksacks, purses and wallets, bags, belts", and Class 25, namely "footwear for men, women and children; all kinds of clothing for men, women and children". The words '*La Scarpa*' are written in yellow, slightly inclined letters with black shadowing.

CALZATURIFICO SCARPA SpA (CALZATURIFICO), an Italian company, filed an opposition against the LA SCARPA application based on its earlier international trademark SCARPA covering goods in Class 3 ("preparations for cleaning shoes"), Class 18 ("leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides, trunks and travelling bags, umbrellas, parasols and walking sticks, whips, harness and saddlery") and Class 25 ("boots, shoes and slippers"). The earlier trademark comprised of the word '*scarpa*' and a circular graphical element above the word.

SIPO refused the opposition for the reason that although the word SCARPA appears in both trademarks, it is not a dominant distinctive element because this word, in Italian, means 'shoe', so this word is descriptive or generic. Since the holder of the earlier trademark could not hold a monopoly over the word '*scarpa*', the visual comparison between the trademarks overrode the conceptual one. It concluded that the graphical elements in the trademarks were sufficiently different to prevent confusion between the marks.

CALZATURIFICO contested SIPO's refusal before the Administrative Court, which held that SIPO's decision should be set aside and the case remitted back to SIPO for further consideration.

PAMI appealed to the Supreme Court, which confirmed the Administrative Court's judgment and set out instructions for SIPO as to how to resolve this opposition case. The Supreme Court stated that SIPO should first establish whether the word '*scarpa*' is understood by an

average Slovenian consumer and whether this word has some generic or descriptive meaning for each particular product in the list of goods. Based on these findings, SIPO should evaluate once again whether the trademarks are confusingly similar.

This decision is interesting because the Italian language is one of the three official languages in Slovenia. Thus, in some parts of Slovenia, Italian is understood by the Italian minority living in those areas and yet the Supreme Court found it necessary for SIPO to establish whether Italian is understood in Slovenia. In the light of this, it will be interesting to see how SIPO will define 'an average Slovenian consumer' in terms of the relationship between the majority of Slovenian-speaking consumers and consumers who are members of the Italian minority in Slovenia.

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