

## ARGENTINA: Conflicts with Surnames. Who Has the Right of Use?

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Division III of the Federal Court of Appeals in Civil and Commercial Matters of the city of Buenos Aires confirmed the lower court's decision in *re: Zito, Graciela Haydee v. Zito, Francisco* on December 27, 2016. The first instance decision said that the plaintiff's right to request that FRANCISCO ZITO cease using his name as a tradename had expired, but ordered the defendant to cease using ZITO as a trademark to distinguish clothing on the grounds of confusing similarity.

The plaintiff, Graciela Zito, is a well-known Argentine fashion designer who registered her name GRACIELA ZITO as a mark in Class 25 in 1984. In 2007, she registered her surname, ZITO, as a mark in such class. Ms. Zito filed a complaint requesting that the owner of the name FRANCISCO ZITO stop using the name as a mark as well as a tradename. The defendant, Francisco Zito, is a fashion designer who has used his name as a "de facto" mark and tradename since 1997. The defendant argued that GRACIELA ZITO and FRANCISCO ZITO were not confusingly similar.

The Court of First Instance admitted the complaint by ordering the defendant to cease using any mark containing the surname ZITO. However, the court rejected the plaintiff's request that the defendant cease using FRANCISCO ZITO as a trade name. The Court held that FRANCISCO ZITO had been used since 1997 and the complaint was filed in 2008. Therefore, the right to such claim was considered to have expired under statutory limitations. Graciela Zito withdrew the appeal on the issue of use of FRANCISCO ZITO as a tradename, which became final, but the defendant appealed the order that he cease using the name as a trademark.

On appeal, the Federal Court of Appeals confirmed the ruling that the defendant cease use of ZITO as a trademark for clothing. The court held that the first name was less important than the surname, which was the most distinctive element of the marks. Moreover, it mentioned that the previous coexistence of the marks was not relevant since the defendant had not registered his name as a trademark, while the plaintiff had done so.

The decision cited a previous relevant case (*Paloma Herrera v. Carolina Herrera S.A.* (Docket No. 455/97, Sept. 12, 2003)) where the court held that the "coincidence in the surname was not enough to find the marks confusingly similar since all the circumstances should be analyzed." The court pointed out the different facts of both cases: while in regards to *Paloma Herrera*, the parties were well-known in different fields, Paloma Herrera as a ballet dancer and Carolina Herrera as a fashion designer, in regards to *Graciela Zito*, both parties were fashion designers.

The case shows the most current guidelines followed by the Argentine court in order to decide conflicts with marks containing surnames. Surnames are considered to be the most distinctive elements; however, marks containing identical surnames are not always considered to be confusingly similar. All the facts of each case should be analyzed in order to decide whether or not to allow the possible coexistence.

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