



OCTOBER 2025

MADRID SYSTEM DEVELOPMENTS: INSIGHTS FROM THE 23RD SESSION OF THE WIPO WORKING GROUP IN GENEVA



Manuela Bruscolini of our Firm, Member of the **MARQUES International Trade Mark Law and Practice Team**, participated as representative of **MARQUES**, the famous international association representing the brand owner interests, in the **23rd Session of the WIPO Working Group on the Legal Development of the Madrid System for the International Registration of Marks**, which took place in Geneva from 22 to 26 September.

The session brought together representatives of contracting parties, observers and associations of right holders, like **MARQUES**, to discuss how to modernize and simplify the **Madrid System** - the cornerstone of international trademark registration.

Key topics discussed in Geneva

The Working Group addressed several themes of direct relevance to trademark practitioners:

- **Procedural modernization** - proposals to improve communication flows, digital tools, and transparency within the Madrid System.
- **New language options** - discussions on the “international registration language option,” which could make filings and correspondence under the System more accessible to a wider user base.
- **Review of the dependency principle and “central attack”** - examining potential reforms to mitigate the risk of international registrations being cancelled due to the invalidation of their basic marks.
- **Clarification of terms and harmonization of goods and services** - the use of unified databases to improve consistency and legal certainty across jurisdictions.
- **User-centric improvements** - simplification of fees, procedures, and post-registration operations to make the System more efficient and predictable.

In short, the Madrid System is evolving to become more accessible, transparent, and business-oriented - a development that benefits both users and their IP advisors worldwide.

Why this is the right moment to promote international filings

The ongoing reform discussions provide a compelling argument for advising clients to expand their trademark portfolios internationally:

1. Streamlined coverage and cost efficiency

The Madrid System remains the most cost-effective way to secure protection across multiple jurisdictions with a single application and centralized management.

2. Strategic anticipation

By filing now, clients can benefit from the current system while positioning themselves ahead of forthcoming procedural enhancements.

3. Enhanced enforcement value

A registered international mark significantly increases a brand’s credibility and enforceability across jurisdictions, serving as a powerful deterrent to infringement.

4. Key designations: the EU

The European Union, including Italy, continues to be an economically strategic market with strong, harmonized IP frameworks. Including these designations strengthens a brand’s position in Europe and demonstrates global reach.

The critical role of local representatives for Italy and the EU

While the Madrid System centralizes the filing and management of international registrations, **local expertise remains essential** both before proceeding (in case for instance of **trademark availability searches**) and after filing once a designation enters the examination phase at national or regional offices. In particular, **provisional refusals** issued by the **Italian Patent and Trademark Office (UIBM)** or the **EUIPO** must be handled promptly and precisely.

Applying to a local representative offers multiple advantages:

- **Trademark clearance searches**, i.e. effectively evaluating whether the proposed brand is a) available and b) protectable.
- **Reviewing class specifications**, ensuring alignment with Italian and EUIPO practice.
- **Timely management of deadlines** - local attorneys are familiar with procedural time limits and administrative practices, ensuring swift and compliant responses.
- **Effective response to provisional refusals** - local counsel can draft reasoned arguments in line with national practice, improving the likelihood of overcoming objections.
- **Representation in opposition or appeal procedures** - when conflicts arise, local representation is mandatory and strategically invaluable.
- **Tailored strategic advice** - experienced local

practitioners provide guidance on prior-rights conflicts, coexistence agreements, and enforcement strategies.

- **Integrated portfolio management** - coordinating local and international rights ensures consistency between national, EU, and Madrid registrations, minimizing dependency-related risks.

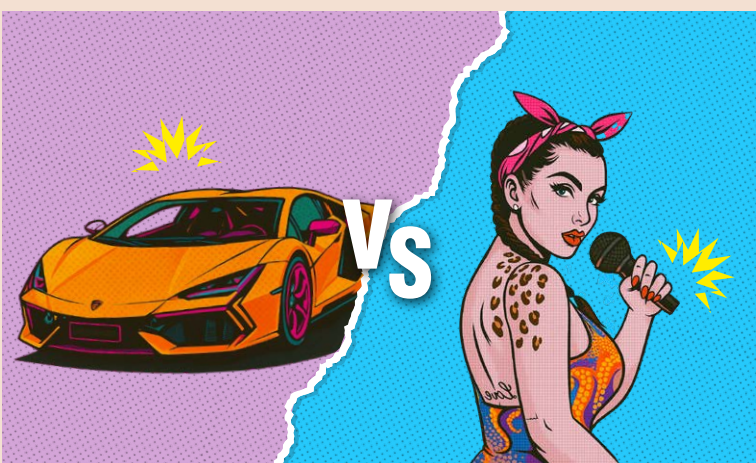
Conclusion

The 23rd Session of WIPO's Working Group has reaffirmed the Madrid System's ongoing modernization and its central role in global

brand protection. For international IP firms, this is the perfect time to **promote the use of the Madrid System** and to **establish partnerships with trusted local representatives** for the management of provisional refusals and oppositions or for preliminary trademark clearance searches.

Please do not hesitate to contact us for any need in the Eu and in Italy, we will be happy to be of help to ensure that clients' brands receive in our jurisdictions the best comprehensive protection they deserve.

LAMBORGHINI VS. LAMBORGHINI: WHEN A FAMOUS SURNAME BECOMES AN OBSTACLE



The surname "Lamborghini" is known to the Italian public mainly for its association with the family of Ferruccio Lamborghini, the Italian entrepreneur who founded, in 1963, the famous car manufacturer company Automobili Lamborghini SpA.

The Lamborghini family no longer controls the brand, which has been in the hands of third-party companies for fifty years and – currently – under the control of the German company Audi.

One of Ferruccio Lamborghini's granddaughters, Elettra, has taken a career path that differs from the family tradition, becoming a famous influencer, singer and showgirl.

Given her international success, on May 2nd, 2019, Elettra filed the trademark application "ELETTRA LAMBORGHINI" with the Italian Patent and Trademark Office (UIBM) to protect her name and exploit it commercially. The trademark has been registered in classes 03 (including creams, perfumes, and cosmetics), 09 (including music CDs, scales, calculators, helmets), 18 (including bags, beauty cases, backpacks), 25 (including clothing, footwear), and 41 (including education services, event and concert organization).

On December 5th of the same year, however, Automobili Lamborghini Spa filed an opposition against the trademark application, contesting its registration for all the claimed products and services.

The opposition was based on the earlier trademarks of the well-known car manufacturer, including the word mark "LAMBORGHINI" and the figurative mark "AUTOMOBILI LAMBORGHINI",



registered – *inter alia* – for goods in classes 03, 08, 09, 12, 14, 16, 18, 21, 24, 25, 28, 34.

In contesting the registration, Automobili Lamborghini highlighted the **renown of the Lamborghini brand** that distinguishes one of the most important car manufacturers in the world, filing specific documentation to this end, and underlined the similarity between the opposing trademarks given that the core of the same is constituted by the surname LAMBORGHINI.

Italian law (**Article 12, paragraph 1, letter e) of the Italian Industrial Property Code**) grants, in fact, a broader protection to **trademarks that enjoy reputation**, providing that a subsequent trademark may not be registered when the latter is identical or similar to the well-known trademark, for identical, similar or **non-similar good /services**, when the earlier trademark enjoys reputation and **when the use without due cause of the trademark applied for would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier mark**.

A trademark enjoying reputation is, therefore, a trademark that has achieved such a high level of reputation and fame that it benefits from enhanced legal protection, extending beyond the goods or services for which it was registered. This type of trademark enjoys a "status of renown" that grants it extensive protection even in product sectors other than the original ones and even in the absence of a risk of confusion among the public, with the aim of preventing unauthorized use that could unduly exploit its reputation or damage its image. However, there must be no "due cause" for the use by the third party and said use must necessarily benefit from or cause harm to the reputation of the renowned trademark.

On the other hand, the showgirl argued that the presence of the name ELETTRA was a sufficient element to avoid the risk of confusion *"considering that the trademark applied for ELETTRA LAMBORGHINI leads the consumer to think of the pop star, while the trademark AUTOMOBILI LAMBORGHINI leads the consumer to think of the automotive industry"*.

The Opposition Division, however, upheld the

opposition of Automobili Lamborghini Spa.

According to the Division, there is a risk of confusion, given the visual, phonetic and conceptual similarity between the signs, which can be traced back to the common element "LAMBORGHINI." This element, being a surname – and, hence, a **patronymic trademark** – represents, in the Office's opinion, the distinctive element of the signs. The term "automobiles," in fact, should be considered weak because it evokes the products and the name "Elettra" plays a minor role in comparing the signs, since the surname is generally considered more distinctive than the given name.

In fact, case law dictates that when a trademark consists of a first name and last name, the surname is given greater consideration when assessing the likelihood of confusion with a similar sign. Consequently, even if the surname alone is identical, a patronymic trademark that differs only in the first name will still be considered susceptible to confusion.

A patronymic trademark is a distinctive sign consisting of the first and last name, or even just the last name, of a natural person. It is considered a **strong trademark** because a first and/or last name usually have no relation with the goods and/or services claimed by the trademark itself.

In Italy, this type of trademark is governed by Article 8 of the Industrial Property Code, which establishes specific conditions for the registration of a trademark containing a personal name. It can be registered, first and foremost, by the owner of the name itself, but also by third parties under certain conditions, provided that its use does not harm the name owner's reputation, credit or dignity.

Based on the above, the Office rejected the trademark application filed by Elettra Lamborghini in its entirety.

The latter, however, appealed the decision, claiming that in this case the conditions required for the application of Article 12, paragraph 1, letter e), of the Industrial Property Code, were lacking. The Board of Appeal upheld the appeal, thus overturning the first-instance decision.

The Board found that the two conditions for the aforementioned Article 12, paragraph 1, letter e) to apply were not met.

As mentioned, in order to enjoy the broader legal protection, the use of the subsequent trademark must occur without due cause and the unauthorized use of the trademark identical or similar to the renowned one must allow the former to take unfair advantage of the distinctive character or reputation of the earlier sign.

As to the first condition, Elettra Lamborghini argues – and the Commission agrees – that the opposing sign coincides with her surname and that the possibility of registering her name as a trademark is recognized by Article 8 of the IP Code.

The same article 8, in the third paragraph, recognizes strengthened protection **to the owner of a name that has become well-known outside of business activity**, that is "in the artistic, literary, scientific, political or sporting fields", **allowing only the latter to register its name as a trademark**.

In her appeal, Elettra Lamborghini submitted extensive documentation demonstrating the reputation her name has acquired in the artistic and musical fields. Therefore, there would be "due cause."

Regarding the second condition, the decision states: *"The fact that Elettra Lamborghini is the granddaughter of the founder of the car manufacturer of the same name (Ferruccio Lamborghini) would not, from this perspective, have had much of an impact on the fame she has achieved in the artistic field and on social media, if it is true that one of her music videos recorded 154 million views in 2018 alone".*

The Board, while acknowledging that the earlier trademarks of Automobili Lamborghini enjoyed reputation and that the signs being compared were similar, upheld Elettra Lamborghini's appeal, deeming that there was a just cause for the registration of the opposed trademark and – at the same time – that there was no unfair advantage that could be derived from the

distinctive character or the reputation of the earlier trademark, taking into account the renown acquired by Elettra was *"outside and (at least in part) independent of that of the earlier trademark"*.

However, the story is not yet definitively concluded...

Automobili Lamborghini has – in turn – appealed the decision of the Board of Appeal before the Court of Cassation.

Deviating from the reasoning of the Board of Appeal, the Court held that the registration of the trademark "Elettra Lamborghini" could take unfair advantage of the reputation of the appellant's trademarks.

The Court argued that the Board, in assessing this risk, did not examine decisive factors such as the intensity of the reputation and the degree of distinctiveness of the Automobili Lamborghini trademarks, the similarity between the signs and the nature and proximity of the products or services, but only the degree of reputation achieved by the name Elettra Lamborghini.

The Court also ruled out that Elettra Lamborghini had a "due cause" to have its trademark registered: *"the mere circumstance that the later trademark corresponds to the applicant's name is irrelevant to the question whether the use of that term constitutes a just cause since the examination of the balance of interests at stake cannot undermine the essential function of the earlier trademark, which is to guarantee the origin of the product"*.

For these reasons, the Court of Cassation upheld Automobili Lamborghini's appeal and referred the matter back to the Board of Appeal (with a different composition) for re-examination.

The outcome of this dispute is therefore still uncertain. We will be sure to update you as soon as the Board issues its decision. Stay tuned!

SME FUND 2025 VOUCHERS 2 AND 3 REOPENED

As announced by the European Union Intellectual Property Office (EUIPO), the **SME Fund 2025** - a programme designed to support European and Ukrainian small and medium-sized enterprises (SMEs) - has reopened access to Vouchers 2 and 3. The Fund provides partial reimbursement of expenses incurred in protecting intellectual property (IP) rights, offering valuable financial support to SMEs seeking to safeguard their innovations and brands.

Specifically, **Voucher 2** covers activities related to trademarks and designs, including fees for trademark and design applications within the EU and before WIPO. **Voucher 3**, on the other hand, supports patent-related activities, such as legal and consultancy costs for drafting and filing a new European patent application.

Both vouchers, which had previously been closed due to high demand and the resulting depletion of available funds, officially reopened on **20 October 2025**.



The aim of this newsletter is to keep our Clients and Associates updated about developments in the sector of Intellectual Property in general and our firm in particular. In this way, we wish to provide a broader view of the tools that the field of trade marks, domain names, patents, designs and related rights offers to entrepreneurs to enhance and protect their efforts in researching and developing new solutions and ideas.



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