

30 Sep 2020

## MESSI v MASSI: CJEU confirms that reputation of EUTM applicant can affect likelihood of confusion

European Union - [NJORD](#)

- The CJEU has confirmed that football player Lionel Messi could register the mark MESSI for sports clothing and equipment
- It was appropriate for the General Court to consider the notoriety of the applicant
- The applicant's reputation constituted a relevant factor for the purposes of establishing a conceptual difference between MESSI and MASSI

In [European Union Intellectual Property Office v Messi](#) (Joined Cases C-449/18 P and C-474/18 P), the Court of Justice of the European Union (CJEU) has affirmed two decisions of the General Court finding that the marks MESSI and MASSI were not confusingly similar.

### Background

The case is based on the premise that Lionel Messi is a very famous football player, who has been the star of FC Barcelona for many years, is the captain of the Argentina national team, and has been voted the best football player in the world several times.

A dispute arose following Mr Messi's application for the registration of the device mark MESSI (depicted below) as an EU trademark for goods in Classes 9, 25 and 28:



The application was opposed by the owner of the word mark MASSI. The Opposition Division of EUIPO upheld the opposition and rejected Mr Messi's application; the Board of Appeal of the EUIPO affirmed.

### General Court decision

[On appeal to the General Court, Mr Messi was successful.](#) The court agreed that, although the marks were visually and phonetically similar, they were conceptually different because of the notoriety of the name Messi. Specifically, the court held that the Board of Appeal had erred in believing that a possible conceptual difference would not be perceived only by part of the relevant public. On the contrary, it considered that a significant part of the relevant public would associate the term 'messi' with the name of the famous football player and would therefore perceive the term 'massi' as being conceptually different. Such conceptual difference neutralised the visual and phonetic similarities between the marks.

Both the EUIPO and the opponent appealed to the CJEU.

### CJEU decision

#### *EUIPO's claim*

The EUIPO claimed that the General Court's holding that a significant part of the relevant public would differentiate between the marks at issue conceptually was incorrect. According to the EUIPO, the court should have assessed whether the other part of this public was also significant, and take into consideration the possible existence of a likelihood of confusion with regard to that part. The CJEU pointed out that the General Court had also held that:

*[w]hile it was possible that a few consumers had never heard of Mr Messi... this would not be the case for the normally attentive, informed and savvy average consumer who purchases clothing or sportswear.*

The General Court had thus held that only a negligible part of the relevant public would not directly associate MESSI with the name of the famous football player. Accordingly, the EUIPO's claim failed.

### **Opponent's claims**

The opponent claimed, firstly, that the notoriety of the applicant was irrelevant. However, the CJEU pointed out that there has been other case law, in particular [Ruiz-Picasso v OHIM \(PICASSO v PICARO\)](#) (Case C-361/04 P, 12 January 2006), holding that it can be relevant, so the opponent lost on this point.

Next, the opponent claimed that no evidence whatsoever had been filed concerning the degree of knowledge of Mr Messi's surname throughout Europe. The CJEU ruled that this claim was inadmissible because it concerned the facts, and the CJEU is limited to reviewing the application of the law.

Thirdly, the opponent argued that the notoriety of Mr Messi was a new claim which had been brought for the first time before the General Court. However, the CJEU held that the Board of Appeal had considered Mr Messi's notoriety, so it was not a new claim.

Finally, the opponent claimed that the General Court has misapplied *PICASSO v PICARO* because, in that case, Picasso was the opponent and the notoriety of the opponent was relevant. It is different where it is the applicant who claims to be famous. The CJEU held that the determination of the likelihood of confusion is an overall assessment, and it was appropriate for the General Court to consider the notoriety of the applicant.

Accordingly, the CJEU affirmed the General Court's decision.

### **Comment**

This case is interesting for several reasons, both from a procedural and substantive point of view. Procedurally, this was one of the rare cases in which the EUIPO appealed to the CJEU, which the EUIPO does only when it feels that a decision was incorrect. Nevertheless, there was no opinion from the attorney general, the CJEU stating simply that, after hearing the advocate general, it would judge the case without conclusions. Substantively, this decision shows that conceptual differences, even for only a portion of the relevant public, can neutralise otherwise strong visual and phonetic similarities between two trademarks.

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