

Lionel Messi scores his surname trade mark - the CJEU's own goal?

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On 17 September the CJEU handed down a long-awaited judgment on a matter that thrilled sports fans and the IP community ([C-449/18P](#), [C-474/18P](#), available in French and Spanish). Footballer Lionel Messi Cuccittini is allowed to register his surname as a trademark for a sportswear brand after a nine-year legal battle. The trade mark is a figurative sign in particular for clothing, footwear and gymnastics and sports articles:



(Classes 9, 25 and 28)

A Spanish cycling company, which started its business under the name MASSI before “Messi” was launched onto the market, opposed the application for identical goods. While the EUIPO considered that there was a likelihood of confusion, the General Court thought otherwise. Both the EUIPO and the opponent appealed to the CJEU but failed. The CJEU confirmed that there was no likelihood of confusion.

The key rationale was that the football player's fame neutralized the visual and phonetic similarities between two signs. The CJEU pointed out that, like the reputation of the earlier trade mark (para. 46), the reputation of the person applying for registration of his name as a trade mark was one of the relevant factors for the assessment of likelihood of confusion, as the reputation of the person applying for registration of his surname may influence the perception of the trade mark by the relevant public (para. 47).

This is in line with the 2010 judgment regarding BARBARA BECKER (see C 51/09P, para. 37). In that case, the German actress and model Barbara Becker, former wife of the tennis player Boris Becker, succeeded in defeating the opposition of the proprietor of the earlier trade mark BECKER to the registration of her trade mark "BARBARA BECKER".

When speaking about "reputation" or "notoriety", the CJEU did not mean the concept referred to in the Art. 8(5) EUTMR. The appreciation of the likelihood of confusion depends on numerous elements, and in particular, on the recognition of the trade mark on the market the association which can be made with the used or registered sign, and the degree of similarity between the trade mark and the sign and between the goods or services identified. The likelihood of confusion (LOC) test does not include factors that depend on the applicant itself (C-171/06 P, para. 31). Notoriety of a super-famous person may indeed change over time and it is inherently associated with the applicant's personal status. In Messi's trade mark attempts, the EUIPO had said that the likelihood of confusion could not be neutralized by the fact that Lionel Messi was a reputed football player (applications nos. 2765183 and further).

Furthermore, the CJEU confirmed that even if signs have a high degree of visual and aural similarity, strong conceptual dissimilarity may suffice to prevent a finding of likelihood of confusion - such as between the terms "messi" and "massi". Taking into account the type of consumers of the respective goods and their level of attention, this difference is sufficient for average consumers. The notoriety relies on the perception of the mass public, and not of the relevant public of the given goods, which by the way is similar to the assessment of notoriety of trade marks.

The CJEU noted *a priori* that the fame of the name Messi, as the surname of a world-famous soccer player and as a public figure, constituted a matter of common knowledge, that is to say, a fact known by any person or which may be known

through generally accessible sources (para. 74). But a personal notoriety that influences the public perception cannot be presumed! The fame that Lionel Messi enjoys among football fans only concerns part of the public, who is interested in football and sport in general. And since we assess personal notoriety with respect to the general public, for the public who does not associate 'MESSI' with the football player, the alleged conceptual dissimilarity will obviously not be perceived. The CJEU test for LOC confuses. If in some cases personal fame is superior than other factors, where is the limit and what are the criteria for assessing the fame of celebrities in trade mark matters?