

The CJEU agrees with Messi and allows him to register his surname as a trademark

On 17 September 2020, the Court of Justice of the European Union ("CJEU") ruled in favour of Lionel Messi Cuccittini in an action brought by a Spanish company against the "MESSI" trademark, as in lower instances it was held that the latter gave rise to confusion with its "MASSI" trademark¹.

Background

In August 2011, Messi Cuccittini filed the application for the figurative trademark "MESSI" with the EUIPO. That trademark fell within Classes 9, 25 and 28 of the Nice Classification, which corresponded, in general, to clothing, footwear, life-saving and sporting goods.

In November of the same year, Jaume Masferrer Coma filed a notice of opposition with the EUIPO on the ground of likelihood of confusion with the trademark "MASSI", registered in 2003, which also covered sporting goods, in particular cycling clothing and accessories.

The rights to the trademark "MASSI" were transferred to the company J.M.-E.V. e hijos in May 2012.

In June 2013 the EUIPO upheld the opposition filed by the owners of the "MASSI" trademark. As a result, in August 2013 Messi Cuccittini lodged an appeal with the EUIPO against the decision of the Opposition Division. That appeal was dismissed by the First Board of Appeal of EUIPO on the ground that the objections raised by Messi Cuccittini were "*manifestly unfounded*" since, having defined the relevant public as the average consumer in the European Union, who is reasonably well informed, it took the view that the goods covered by the two trademarks were identical and that the terms "MESSI" and "MASSI" were also very similar from a phonetic and visual point of view.

Following that decision, Messi Cuccittini decided to file an action for annulment before the General Court on 25 July 2014, based on a single ground of appeal, because he considers that there was no likelihood of confusion on the part of the public.

The action was upheld by the General Court on the ground that, because of the reputation of Messi's character, there was no likelihood of confusion on the part of the public and the contested decision was therefore annulled².

The procedure before the ECJ

The EUIPO and the commercial company J.M. - E.V. e hijos filed an appeal in cassation with the CJEU against the General Court's ruling.

¹ Judgment of the Court of Justice of the European Union of 17 September 2020, *Messi Cuccittini v E.M.-E.V. e hijos*, Joined Cases C-449/18 P and C-474/18 P.

² Judgment of the General Court of 26 April 2018, *Messi Cuccitini/EUIPO - J.M. - E.V. e hijos (MESSI)* (T-554/14).

As regards the EUIPO, it brought the appeal on a single ground of appeal, namely the existence of a likelihood of confusion between the two trademarks. According to EUIPO, the likelihood of confusion does not require that the likelihood of confusion covers the whole of the public but may be considered if it concerns a part of that public.

In view of this, the CJEU states that while it is true that some consumers may never have heard of Messi, this is not the average consumer who is *"informed and reasonably attentive people who read newspapers, watch television, go to the cinema or listen to the radio"*. His action was therefore dismissed.

The appeal brought by J.M. - E.V. e hijos was based on four grounds of appeal:

- The first ground of appeal is again based on the likelihood of confusion. It was argued that, conceptually, the term “Messi” is no different from the term “Massi”. J.M. - E.V. e hijos considers that the reputation of Messi Cuccittini is irrelevant, since only the fact that there is an earlier trademark similar to “Messi”, sufficient to give rise to a likelihood of confusion, must be taken into account. The CJEU dismisses the argument, holding that *“the reputation of Mr Messi Cuccittini was a relevant factor in establishing a conceptual difference between the word “Messi” and the word “Massi””*³.
- The second plea raised by J.M. - E.V. e hijos was that the General Court was wrong to consider that the degree of knowledge of Messi Cuccittini throughout Europe was a well-known fact. According to J.M. - E.V. e hijos, the degree of knowledge of Messi Cuccittini has varied over the years, so that it is difficult to establish the degree of knowledge of the Messi’s name in 2013, which is when the opposition was upheld. The appellant added that in some European countries football is not followed, for example in Lithuania, so its citizens may not associate the brand “Messi” with the footballer. The CJEU dismisses the action and states that *“the Court has held that there is no requirement to prove the accuracy of facts which are well known and that, moreover, a finding by the General Court as to whether or not the facts in question are well known constitutes a finding of fact” (see, to that effect, the order of 3 June 2015 in Case C 142/14 P The Sunrider Corporation v OHIM, not published, EU:C:2015:371, paragraph 65)”*.
- By the third ground of appeal, J.M. - E.V. e hijos reasoned that the General Court relied on evidence which was submitted for the first time before it and that it was not possible to alter the facts established before the Board of Appeal or to introduce new arguments. The CJEU rejects that third plea as unfounded because, although it is true that new facts cannot be introduced before the General Court, in the present case the ECJ had already said on another occasion that *“arguments put forward at the appeal stage before the General Court for the sole purpose of establishing well-known facts cannot be regarded as new arguments (see, to that effect, judgment of 10 November 2011 in Case C 88/11 LG Electronics v OHIM, not published, EU:C:2011:727, paragraph 30 and the case-law cited)”*. Therefore, *“given that the reputation of the word Messi, as the surname of the world-famous football player and as a public figure, was a well-known fact, that is to say, a fact which could be known by anyone or ascertained from generally accessible sources, those sources were elements which were available to the Board of Appeal when*

³ Judgment of the Court of Justice of the European Union of 24 June 2010, *Becker v Harman International Industries* (C-51/09 P, paragraph 37).

it adopted the contested decision and which it should have taken into account when assessing the conceptual similarity between the signs at issue”.

- The fourth and final ground of appeal is based on the argument of J.M. - E.V. e hijos that the General Court misapplied the judgment in Ruiz-Picasso and Others v OHIM⁴, since, according to the appellant, the General Court held that *“in certain circumstances conceptual differences may counteract the visual and phonetic similarities between the signs in question”*. The Court of First Instance dismisses the fourth ground and points out that, in order to assess whether a sign has a clear and specific meaning from the point of view of the relevant public, both the sign relating to the earlier trademark (MASSI) and the sign corresponding to the trademark applied for (in this case, MESSI) may therefore be taken into account. Therefore, since the General Court had indicated that the relevant public would perceive the signs MASSI and MESSI as conceptually different, it was entitled to apply that case-law⁵.

The ECJ finally allowed Messi Cuccittini to register a trademark with its surname, on the understanding that there is no risk of confusion with the trademark "MASSI" which, despite protecting practically identical goods, because of the footballer's reputation, it is understood that anyone will associate the trademark "MESSI" with the Argentine football player, but not the trademark "MASSI", as it is a different term and easily identifiable by the general public.

Finally, it is important to bear in mind that, since the entry into force of the Royal Decree-Law 23/2018 of 21 December, which transposes the directives on trademarks, rail transport and package travel and related travel services⁶, Spanish legislation no longer distinguishes between the well-known⁷ and the renowned⁸ trademark, and only Article 8 of the Trademark Act still contains the concept of "renowned". In this case, the TJUE continues to use the term "well-known" because the Single Transitional Provision of that law indicates that *"trademark proceedings initiated before the entry into force of this Royal Decree-Law shall be processed and resolved in accordance with the previous legislation"*.

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[This information is not intended to constitute legal advice and is only for information purposes].

⁴ Judgment of the Court of Justice of the European Union of 12 January 2006, *Ruiz-Picasso and Others v OHIM* (C-361/04 P).

⁵ *"The Court of Justice dismisses the actions brought by EUIPO and a Spanish company against the judgment of the General Court authorising the football player Lionel Messi to register the mark 'MESSI' for sports articles and clothing"*, CURIA, Press and Information, 17 September 2020.

⁶ The Royal Decree-Law entered into force on 28 December 2020.

⁷ *"A well-known trademark or trade name shall be understood to be those which, by virtue of their volume of sales, duration, intensity or geographical scope of their use, value or prestige achieved in the market or for any other reason, are generally known by the relevant sector of the public to which the products, services or activities that distinguish said trademark or trade name are addressed"* (definition of former article 8 of the Trademark Act).

⁸ Renowned trademarks are those that *"are known by the general public shall be considered to be well-known and the scope of protection shall extend to any type of product, service or activity"* (definition of former article 8 of the Trademark Act).