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Using a Surname in a Trademark: Has the Messi Case Changed Case-Law?³

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Abstract

Using a surname as a trademark or part of a trademark has been the subject of numerous case-laws and has been widely discussed in the literature. However, it seems that after the Messi case (cases C-449/18 P and C-474/18 P), the Court of Justice of the European Union (CJEU) seems to have departed from their previous approach where it was held that surnames in trademarks should be treated as normal signs. In the Messi case, the CJEU, however, ruled that the reputation of Messi – an internationally famous football player – is so well known that an average consumer, seeing the ‘MESSI’ mark placed on clothing, gymnastic or sporting articles and protective equipment, will establish a link between the mark and the sports personality, despite the similarity between the ‘MESSI’ mark to the ‘MASSI’ brand name, a previously registered trademark.

However, this ruling gives rise to the following questions, which this article seeks to address:

- How can one prove that someone’s surname is globally recognised?
- Why did the CJEU decide that Messi is better known than, for instance, Picasso who was the subject of the previous case? Who else can be as famous as Messi if Picasso was held not to be?
- Has Messi changed the CJEU’s approach and opened the floodgates to expand trademark protection for an unlimited number of trademarks?
- This article attempts to answer these questions.

Keywords: trademark, surname, reputation.

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Użycie nazwiska jako znaku towarowego – czy sprawa *Messi* zmieni praktykę orzeczniczą?⁴

Streszczenie

Posługiwanie się nazwiskiem jako znakiem towarowym lub jego częścią było już przedmiotem licznych wypowiedzi przedstawicieli doktryny oraz judykatury. Wydaje się jednak, że po sprawie *Messi* (sprawy C-449/18 P i C-474/18 P) Trybunał Sprawiedliwości Unii Europejskiej (TSUE) odszedł od swojej wcześniejszej linii orzeczniczej, zgodnie z którą uznawano, że nazwiska zawarte lub będące znakiem towarowym należy traktować tak jak inne oznaczenia (znaki towarowe). W sprawie *Messi* Trybunał przyjął, że renowa *Messiego* – piłkarza o międzynarodowej sławie – jest tak duża, że przeciętny konsument, widząc znak „MESSI” umieszczony na odzieży, artykułach gimnastycznych lub sportowych oraz sprzęcie ochronnym, nie skojarzy go ze znakiem „MASSI”, który został wcześniej zarejestrowanym znakiem towarowym.

Orzeczenie to rodzi następujące pytania, na które postarano się odpowiedzieć w niniejszym artykule:

- jak udowodnić, że czyjeś nazwisko jest globalnie rozpoznawalne?
- dlaczego TSUE uznał, że *Messi* jest bardziej znany niż np. *Picasso*, którego dotyczyło wcześniejsze orzecznictwo?
- kto jeszcze mógłby być „tak sławny” jak *Messi*, aby w inny sposób traktować taki znak towarowy (renomowany)?
- czy sprawa *Messi* zmieni podejście TSUE i rozszerzy ochronę znaków towarowych na nieograniczoną liczbę znaków towarowych?

Słowa kluczowe: znak towarowy, nazwisko, reputacja.

⁴ Badania wykorzystane w artykule nie zostały sfinansowane przez żadną instytucję.

Introduction

Using a surname as a trademark or part of a brand has been subject to numerous CJEU cases where surnames have been held to be treated as normal signs.⁵ However, after the Messi case (cases C-449/18 P and C-474/18 P), the Court seems to have changed its previous approach. It held that the reputation of Messi – an internationally well-known football player, is so famous that an average consumer, seeing the ‘MESSI’ mark, cannot ignore the link between the sign and the sports personality, despite its similarity to ‘MASSI’, a previously registered trademark.

However, this ruling gives rise to the following questions, which this article seeks to address:

1. How to prove that someone’s surname is globally recognised?
2. Why did the Court decide that Messi is better known than, e.g. Picasso, the subject of the previous case?
3. Has the Messi case changed the Court’s interpretation and opened the floodgates to expand their trademark protection for an unlimited number of trademarks? Who else can be as famous as Messi if Picasso was held not to be?

The Significance of Surnames

A surname accompanies a person from birth to death and sometimes ‘lives’ for centuries, occupying a permanent place in a nation’s history, e.g. Napoleon, Picasso, Chopin. The surname remains the crucial element of identification of a person and it is credited with stability and immutability.⁶ The surname is an element of legal identification, created in the long-term development process, in the course of which the aim was initially only a temporary, current identification, based on

⁵ Judgment of the Court (Second Chamber) of 16 September 2004, *Nichols plc v. Registrar of Trade Marks*, Case C-404/02, Judgment of the General Court (Second Chamber) of 1 March 2005, *Vincenzo Fusco v. European Union Intellectual Property Office*, Case T-185/03, Judgment of the General Court (Fourth Chamber) of 13 July 2005, *Julián Murúa Entrena v. European Union Intellectual Property Office*, Case T-40/03.

⁶ J. Buchalska, *Nazwisko jako przedmiot ochrony w prawie polskim*, Warszawa 2016, pp. 15 ff.

various variable markings.⁷ It is a source of knowledge about the social and political history of a nation, about the development of its culture and realities of life, and sometimes about certain values. A person's surname is part of his or her personality because in the public space, one is defined precisely by his or her surname and at the same time, it can – and it often should – carry a specific image of the person who uses it.⁸ However, many characteristics are ascribed to the surname. For instance, it individualises natural persons, which is the basis for assigning them specific rights and obligations. The surname also shapes the principle of separating individual natural persons in the civil law sphere.

One can distinguish three basic functions of the surname – identification (ordinal function), the role of a personality symbol (personal right) and the function of family belonging.⁹ The additional functions of the surname are to define the nationality or ethnic ties; the shape of the surname also allows, in some languages, to determine the gender of the person holding it. The surname also creates a kind of portrait of the person holding it, which allows one to recognise the person and their characteristics.¹⁰ For instance, this 'metaphysical' portrait¹¹ can frequently be equated with protecting personal rights. This is because many celebrities have associated their brands bearing their surname.¹²

Naturally, we feel the differences between the surname as part of a personal trademark and the surname as such. The differences between those two rights were limited by creating the right of publicity, which can be transferable as an economic right. However, the right of publicity has a dichotomous aspect – audience perception and a physical human individual (natural person). Moreover, it does not allow the person to control the use of the name and reputation. In those cases, after transferring the name as part of the right of publicity, it is no longer under the control of the surname bearer. It can also be split into two – on the one hand,

⁷ Ibidem, p. 24.

⁸ R. Freitag, *Subjektive Anknüpfung: Vorstellung des Vorschlags*, [in:] A. Dutta, T. Helms, W. Printens (eds.), *Ein Name in ganz Europa, Vorschläge für ein Internationales Namensrecht der Europäischen Union*, Frankfurt am Main 2016, p. 51.

⁹ P. Lagarde, *L'oeuvre de la Commission Internationale de l'Etat Civil en matière de nom des personnes*, [in:] H.-P. Mansel, T. Pfeiffer, H. Kronke, Ch. Köhler, R. Hausmann (eds.), *Festschrift für Erik Jayme, Band II*, Munich 2004, p. 1291; K. Funken, *Das Anerkennungsprinzip im internationalen Privatrecht. Perspektiven eines europäischen Anerkennungskollisionsrechts für Statusfragen*, München 2009, p. 293; P. Meier, E. de Luze, *Droit des personnes. Articles 11–89a CC*, Schulthess 2014, pp. 120 ff.

¹⁰ S. Nautré, *Le nom en droit compare*, Frankfurt am Main 1977, pp. 9 ff.; R. Freitag, *Subjektive Anknüpfung...*, p. 51.

¹¹ S. Nautré, *Le nom...*, p. 29.

¹² Compare: <https://www.vogue.com/article/catherine-malandrino-new-see-now-buy-now-hsn-collection>; <http://www.southflorida.com/video/sf-boca-fashion-kate-spade-20160412-story.html> (access: 12.11.2021); <https://www.wsj.com/articles/when-is-kate-spade-not-kate-spade-when-shes-frances-valentine-1471971817> (access: 12.11.2021).

representing a product of their actual identity and creativity. On the other hand, a public person is controlled by the assignee using their identity.

Many brands also engage celebrities to increase the popularity of products or services they sell.¹³ Usually, this results in registering their surname as a trademark. However, along with financial problems, a surname – as a trademark – becomes the property of another entity, which uses it.¹⁴ On the other hand, according to Article 14(1) of Regulation (EU) 2017/1001,¹⁵ an EU trademark (EUTM) owner cannot prohibit the third party from using the name or the address of the third party, where that third party is a natural person.¹⁶

Summary of the Messi Case

In August 2011, Lionel Andrés Messi Cuccittini, the famous football player (the Applicant), applied for the registration of a figurative mark 'MESSI' with the European Union Intellectual Property Office (EUIPO), in Nice Classes 9, 25 and 28 as follows:



In November 2011, the owner of Massi – a Spanish company dealing in cycling equipment and clothing – the products registered in Classes 9, 25 and 28 – filed an opposition to Messi's registration on the ground of the likelihood of confusion. As an aside, the term *massi* means 'large rocks' in Italian.

¹³ Compare: [2013] EWHC 3459 (Ch) <http://www.vogue.co.uk/article/jane-birkin-asks-remove-name-hermes-bag-peta-investigation>; <http://www.vogue.co.uk/article/tommy-hilfiger-defends-gigi-hadid> (access: 12.11.2021).

¹⁴ Compare: <https://www.vogue.com/article/catherine-malandrino-new-see-now-buy-now-hsn-collection>; <http://www.southflorida.com/video/sf-boca-fashion-kate-spade-20160412-story.html> (access: 12.11.2021); <https://www.wsj.com/articles/when-is-kate-spade-not-kate-spade-when-shes-frances-valentine-1471971817> (access: 12.11.2021).

¹⁵ Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trademark.

¹⁶ ECJ: Judgment in Céline SARL v. Céline SA C-17/06, EU:C:2007:497.

In June 2013, the EUIPO Division of Opposition sided with the opponent. Dissatisfied with this decision, Messi appealed to the Board of Appeal, which rejected his request, confirming the conclusion of the Division of Opposition. The Board of Appeal held that their dominant components comprised of the terms 'MASSI' and 'MESSI' were virtually identical visually and phonetically. Although there is a possible conceptual differentiation, if at all, by a part of the public, such a difference cannot outweigh the phonetic and visual similarities. Moreover, Messi's goods are almost identical to the goods covered by the earlier registration of 'Massi'.

In July 2014, Lionel Messi filed an appeal before the EU General Court, claiming that the Board of Appeal had erred by holding the risk of confusion between the conflicting trademarks. The EU General Court agreed with Lionel Messi.

The EUIPO and Massi were displeased with the General Court's ruling, so they took the case to the CJEU. Firstly, the CJEU found that visually the marks are only similar because consumers are accustomed to graphic elements being promoted by trademarks. These are stylised differently in both marks.¹⁷ Secondly, although the Court endorsed the position of the Board of Appeal, claiming that the marks are phonetically similar, it took a different view regarding the conceptual layer of marks. According to the Court, the Board of Appeal wrongly claimed that Messi's reputation was recognised only by a part of the public interested in football and sports.¹⁸ In the Court's view, Messi is a public figure known recognised by informed, attentive and competent customers who read the press, watch the news on TV, go to the cinema or listen to the radio. It is possible to see him and where he is mentioned.¹⁹

The reputation of Messi as the surname of a world-famous football player and public figure is a well-known fact. Therefore, an average consumer of sporting articles and clothing in many cases would likely associate the term 'MESSI' directly with this famous player and distinguish him from another Italian-sounding brand. According to the CJEU, the Board of Appeal had such information and it should have considered the conceptual similarity.²⁰ In the General Court's view, the concept of the mark stemming from the reputation of Messi neutralises the similarity in the phonetic and visual sphere. In the light of all those elements, the degree of similarity between the marks at issue is not sufficiently high to be concluded that the relevant public may believe that the goods in question come from the same undertaking or, as may be the case, from economically related performances.

¹⁷ Paragraph 43 et seq. of the justification.

¹⁸ Paragraph 50 et seq. of the justification of the judgment.

¹⁹ Paragraph 52 of the justification.

²⁰ Paragraph 61 of the judgment.

Jurisprudence in Matters Concerning Surnames Placed in Trademarks

It is worth comparing the considerations with the position of EU bodies assessing the registration of surnames as trademarks²¹. Based on the jurisprudence of the General Court (EU Court) and the Court of Justice, the following cases considering the registration of a surname as a trademark can be identified:

- 1) Nichols plc v. Registrar of Trade Marks²²
- 2) Vincenzo Fusco v. OHIM²³
- 3) Julián Murúa Entrena v. OHIM²⁴
- 4) Elio Fiorucci v. OHIM,²⁵ and later Edwin Co. Ltd v. OHIM (trademark 'ELIO FIORUCCI')²⁶
- 5) I Marchi Italiani Srl and Antonio Basile v. OHIM (trademark 'B. Antonio Basile 1952')²⁷
- 6) Jackson International Trading Co. Kurt D. Brühl GmbH & Co. KG v. OHIM (trademark 'ROYAL SHAKESPEARE')²⁸

²¹ J. Buchalska, *op. cit.*, pp. 219 ff.

²² Judgment of the Court (Second Chamber) of 16 September 2004, Nichols plc v. Registrar of Trade Marks, Case C-404/02, <https://curia.europa.eu/juris/document/document.jsf?text=&docid=49511&pageIndex=0&doclang=EN&mode=lst&dir=&occ=first&part=1&cid=4821259> (access: 12.11.2021).

²³ Judgment of the General Court (Second Chamber) of 1 March 2005, Vincenzo Fusco v. European Union Intellectual Property Office, Case T-185/03, <https://curia.europa.eu/juris/document/document.jsf?text=&docid=55026&pageIndex=0&doclang=EN&mode=lst&dir=&occ=first&part=1&cid=4821259> (access: 12.11.2021).

²⁴ Judgment of the General Court (Fourth Chamber) of 13 July 2005, Julián Murúa Entrena v. European Union Intellectual Property Office, Case T-40/03, <https://curia.europa.eu/juris/document/document.jsf?text=&docid=60415&pageIndex=0&doclang=EN&mode=lst&dir=&occ=first&part=1&cid=4821259> (access: 12.11.2021).

²⁵ Judgment of the Court of First Instance (Fifth Chamber) of 14 May 2009, Elio Fiorucci v. Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), Case T-165/06, <https://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62006TJ0165&qid=1633421485195&from=EN> (access: 12.11.2021).

²⁶ Judgment of the Court (Grand Chamber) of 5 July 2011, Edwin Co. Ltd v. Office for Harmonisation in the Internal Market (Trade Marks and Designs), Case C-263/09 P, <https://curia.europa.eu/juris/document/document.jsf?text=&docid=106861&pageIndex=0&doclang=EN&mode=lst&dir=&occ=first&part=1&cid=7563152> (access: 12.11.2021).

²⁷ Judgment of the General Court (Sixth Chamber) of 28 June 2012, I Marchi Italiani Srl and Antonio Basile v. Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), Case T-133/09, <https://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:62009TJ0133&qid=1633421686435&from=EN> (access: 12.11.2021).

²⁸ Judgment of the General Court (First Chamber) of 6 July 2012, Jackson International Trading Co. Kurt D. Brühl GmbH & Co. KG v. Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), Case T-60/10, <https://curia.europa.eu/juris/document/document.jsf?text=&do>

- 7) *El Corte Inglés, SA v. OHIM* (trademark 'PUCCI')²⁹
- 8) *Claude Ruiz-Picasso, Paloma Ruiz-Picasso, Maya Widmaier-Picasso, Marina Ruiz-Picasso, Bernard Ruiz-Picasso v. OHIM* (trademark 'Picasso')³⁰
- 9) *Harman International Industries, Inc. v. OHIM* (trademark 'Barbara Becker').³¹

Ad 1) This case is the prototype of issues relating to assessing the registration of a surname as a trademark. It was based on the refusal to register an application for registration by Nichols plc, a company established in the United Kingdom, against the Registrar of Trade Marks (head of the trademark registration office). It concerned the refusal to register a popular surname as a trademark for vending machines and food products, including beverages, typically dispensed through such machines.

The Registrar of Trade Marks stated, given the number of entries in the London telephone directory, that the surname 'Nichols', including its phonetic equivalent 'Nicholls' and its singular form 'Nichol', is common in the United Kingdom. Therefore, such a surname cannot communicate as a badge of origin. The High Court took a similar view that common surnames should be considered carefully to ensure that an unfair advantage is not given to those names. A question was submitted to the CJEU for a preliminary ruling in those circumstances.

The CJEU stated that the criteria to assess the distinctiveness of a surname mark are the same as those applied to other marks. Those criteria are, for instance, a predetermined number of persons with the same surname, above which that name may be regarded as devoid of distinctive character – the number of undertakings providing products or services of the type covered by the application for registration – or the prevalence, or the use of surnames in the relevant trade, cannot be applied

cid=124801&pageIndex=0&doclang=EN&mode=lst&dir=&occ=first&part=1&cid=416758 (access: 12.11.2021).

²⁹ Judgment of the General Court (Sixth Chamber) of 27 September 2012, *El Corte Inglés, SA v. Office for Harmonisation in the Internal Market (Trade Marks and Designs)*, Case T-39/10, <https://curia.europa.eu/juris/document/document.jsf?text=&docid=127624&pageIndex=0&doclang=EN&mode=lst&dir=&occ=first&part=1&cid=4821259> (access: 12.11.2021).

³⁰ Judgment of the Court (First Chamber) of 12 January 2006, *Claude Ruiz-Picasso and Others v. European Union Intellectual Property Office*, Case C-361/04 P, <https://curia.europa.eu/juris/document/document.jsf?text=&docid=57309&pageIndex=0&doclang=EN&mode=lst&dir=&occ=first&part=1&cid=4821259> (access: 12.11.2021).

³¹ Judgment of the Court of First Instance (First Chamber) of 2 December 2008, *Harman International Industries, Inc. v. Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-212/07, <https://curia.europa.eu/juris/document/document.jsf?text=&docid=72680&pageIndex=0&doclang=EN&mode=lst&dir=&occ=first&part=1&cid=4821259>; Judgment of the Court (Fourth Chamber) of 24 June 2010, *Barbara Becker v. Harman International Industries Inc.*, <https://curia.europa.eu/juris/document/document.jsf?text=&docid=81387&pageIndex=0&doclang=EN&mode=lst&dir=&occ=first&part=1&cid=4821259> (access: 12.11.2021).

to such trademarks. According to the CJEU, a surname, even a popular one, may be registered as a trademark if it is distinctive.

Advocate General Dámas Ruiz-Jarabo Colomer expressed a slightly different opinion.³² The potential distinctiveness of a surname depends on the goods or services covered by the marks, the relevant consumers who consider that the mark identifies those of one undertaking rather than those of another. The commonness of the surname is one of the factors but not the decisive one.

Ad 2) This dispute involved the refusal to register the word mark – ‘ENZO FUSCO’ by the OHIM, against the registration of which the owner of the trademark ‘ANTONIO FUSCO’ filed an opposition. The Board of Appeal of OHIM upheld the initial decision, stating that the surname ‘Fusco’, which appears in both signs, was neither rare nor particularly common in Italy. The individual character of these signs was given by the names ‘Antonio’ and ‘Enzo’, which are familiar names. Therefore, the presence of the word ‘Fusco’ in both signs was to give rise to a reasonable likelihood of confusion in the mind of the reference public. One of the grounds for refusal was that the marks were applied to identical goods.

In this case, the court of first instance adopted an interesting position, conditioning the assessment of a surname trademark through the prism of differentiation about individual states of the community. According to the court, the perception of signs made up of personal names may vary from country to country within the European Community. In determining whether, in a particular country, the relevant public generally attributes greater distinctiveness to the surname than the forename, the case-law of that country, although not binding on the Community courts, may provide valuable guidelines. In this case, the court of first instance referred to Italian case-law, which generally considers that the surname constitutes the heart of a sign made up of a forename and a surname. Moreover, both parties agreed that ‘Fusco’ is not one of the most common surnames in Italy. Therefore, the court of first instance decided that the indicated signs are characterised by a certain similarity resulting from their most characteristic feature being the same.

Ad 3) This case concerned the figurative mark ‘Julian Murúa Entrena’, in Nice Class 33 dedicated to wines.

The Opposition Division of OHIM refused to register the mark because an earlier trademark, ‘MURÚA’, was registered in the same class and for the same goods. This position was supported by the Board of Appeal, pointing out that the conflicting trademarks designated identical goods. Moreover, the dominant verbal element

³² <https://curia.europa.eu/juris/document/document.jsf?text=&docid=48847&pageIndex=0&doclang=EN&mode=lst&dir=&occ=first&part=1&cid=414747> (access: 12.11.2021).

in both marks is the word 'Murúa', the first surname in the sign at issue. Such registration would be misleading.

In this case, the applicant's position about using a name in trademarks is interesting. The applicant stated that the first name 'Julián', whose mark was composed, is relatively common. However, the combination of 'Murúa' and 'Entrena', which is rare, has a unique and distinctive character that is aurally easy to distinguish. According to the applicant, when confronted with a verbal element composed of a first name, in this case, 'Julián', and two surnames, in this case, 'Murúa' and 'Entrena', Spanish consumers tend to disregard the first name and the second surname. On the contrary, in a legal system such as the one existing in Spain, where a person's civil status is based on two surnames, according to the applicant, the critical factor is the distinctiveness of each of the components of the verbal element in question. Moreover, the applicant pointed out that the refusal to register that surname would prevent him from using his patronymic in the trade mark.

The court of first instance pointed out that the Directive 89/104/EEC³³ indicates that the trademark does not entitle the proprietor to prohibit a third party from using, in the course of trade: his name or address; indications concerning the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or rendering of the service, or other characteristics of goods or services; the trade mark where it is necessary to indicate the intended purpose of a product or service, in particular as accessories or spare parts, provided he uses them by honest practices in industrial or commercial matters. The court of first instance also stated that based on Council Regulation (EC) No 40/94,³⁴ there are no specific regulations regarding the registration of a surname as a trademark. The criteria for assessing the distinctive character constituted by a personal name are the same as those applicable to the other categories of the trademark. The same must hold for criteria for assessing the likelihood of confusion between a Community trade mark whose registration has been sought and an earlier trademark unless otherwise provided by that regulation.

In this case, the court of first instance agreed with the position of the Board of Appeal, pointing to the impossibility of registering the mark in question. The surname 'Murúa', shared by the conflicting signs, has the same origin, namely the applicant's father, who transferred the earlier trademark, registered in Spain, to the proprietor of the 'Murúa' mark could potentially mislead consumers.

³³ OJ L 040, 11/02/1989 P. 0001–0007, hereinafter referred to as 'Directive 89/104', no longer in force; currently Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks, OJ L 299, 8 November 2008, pp. 25–33.

³⁴ OJ L 011, 14/01/1994 P. 0001–0036, hereinafter referred to as 'Regulation 40/94'.

Ad 4) The facts of the case were as follows: Fiorucci SpA, a company incorporated under Italian law set up by E. Fiorucci, a fashion designer who gained some popularity in Italy in the 1970s, transferred on 21 December 1990 to Edwin Co. Ltd all of its 'creative assets', including all trademarks it owned, many of which contained the element 'FIORUCCI'. On 6 April 1999, upon the request of Edwin Co. Ltd, OHIM registered the word mark 'ELIO FIORUCCI' in respect of a series of goods falling within Classes 3, 18 and 25. Four years after the registration, E. Fiorucci applied for revocation and a declaration of the invalidity of that mark. The basis of the request was the premise that as a result of the use by the proprietor of the trade mark or with his consent in respect of the goods or services for which it is registered, the trade mark is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services. The other premise was also Article 52(2) of Regulation 40/94 determining the relative grounds for invalidity, according to which a Community trade mark will also be declared invalid on application to OHIM or based on a counterclaim in infringement proceedings where the use of such trademark may be prohibited under the national law governing the protection of any other earlier right and in particular: a right to a name; a right of personal portrayal; copyright; an industrial property right. By the decision of 23 December 2004, the Cancellation Division of OHIM allowed the application for a declaration of invalidity because it was necessary to receive permission to register his name as a Community trademark. Such permission has never been given.

However, the Board of Appeal annulled the decision of the Cancellation Division, referring to the provisions of national law which prevented the registration of a commonly known surname by a person other than the person bearing this surname. The Board of Appeal held that E. Fiorucci's case did not fall within the scope of that regulation. Its purpose is to prevent third parties from exploiting for commercial purposes the name of a person famous in sectors other than strictly commercial. Consequently, E. Fiorucci cannot rely on the right to a surname under that provision.

In its judgment, the court of first instance upheld the position of the Board of Appeal, according to which, the fact that a mark and a patronymic were identical does not mean that the public concerned will think that the person whose surname constitutes the mark designed the goods bearing that mark. According to the Board of Appeal, the use of patronymic marks is a widespread practice in all sectors of commerce and the public concerned is well aware that, behind every patronymic mark, there is not necessarily a fashion designer of that name. However, the court of first instance pointed out that the renown of a surname does not exclude the possibility

of its protection as a trademark. This protection may be dualistic under national laws concerning the protection of a surname EU and national law about trademarks.

Subsequently, the subject of the proceedings was the application of Edwin Co. Ltd to set aside the judgment of the Court of First Instance of 14 May 2009 in Case T-165/06 Fiorucci v. OHIM – Edwin (ELIO FIORUCCI), by which that Court upheld in part the action brought by E. Fiorucci against the decision of the First Board of Appeal of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) of 6 April 2006 (Case R 238/2005-1) concerning invalidity and revocation proceedings between E. Fiorucci and Edwin, which was submitted to the Court of Justice for consideration.

In the opinion of the Court, the content of national law made it possible to prevent the registration of a trademark containing the surname of a well-known person without that person's consent. However, it is essential to present circumstances that confirm the renown of the surname in question.³⁵

Ad 5) The mark contested in this case was the figurative mark B. Antonio Basile 1952, registered by OHIM assigned to a sole trader under the name B. Antonio Basile 1952. Given the registration of this mark, the company Osra SA applied for a declaration of invalidity referring to its Italian and international trademark BASILE. Both marks were registered for the same goods – clothing. What is significant is that the surname Basile was the subject of many registrations made in Italy. Additionally, the mark B. Antonio Basile 1952 is widely known and has a particular reputation.

In this case, the EU Court, as in the case of 'ENZO FUSCO', stated that the Italian consumer would generally attribute greater distinctiveness to the surname than to the forename in trademarks. In that regard, in particular, the account must be taken that the surname concerned is unusual or, on the contrary, very common, which is likely to affect that distinctive character. Account must also be taken of whether the person who requests that his forename and surname, taken together, be registered as a trademark is well known.³⁶ Because the surname Basile is widely known and even one of the most popular in Italy, despite the combination with the name Antonio, it is an element that makes the trademark more distinctive. In the judgment, the Court compared the marks in question on three levels – visual, phone-

³⁵ Advocate General Kokott argued against this position in an opinion delivered on 27 January 2011, <https://curia.europa.eu/juris/document/document.jsf?text=&docid=79193&pageIndex=0&doclang=EN&mode=lst&dir=&occ=first&part=1&cid=7563152> (access: 12.11.2021).

³⁶ Cf. Judgment of the Court (Fourth Chamber) of 24 June 2010, Barbara Becker v. Harman International Industries Inc., Case C-51/09 P, Court Reports I-5805, paragraphs 36 and 37.

tical, and conceptual, stressing, in line with the previous case-law, that trademarks with an element of surname should be assessed according to the same method.³⁷

Ad 6) The subject of the proceedings, in this case, was the application for the word mark 'ROYAL SHAKESPEARE' for beverages, including alcohols. The Royal Shakespeare Company applied for a declaration of invalidity of this registration, indicating that the use of the indicated mark may bring unfair advantage to the applicant, may be detrimental to the distinctive character and reputation of the unregistered, reputable trademark RSC, where the abbreviation was described below as 'The Royal Shakespeare Company' and was used by The Royal Shakespeare Company.

The Court found that the surname of William Shakespeare is well known and, as such, in and of itself, is not highly distinctive for theatre productions. It is also not distinguished by the words 'royal' or 'Shakespeare'. However, combining these two words gives rise to a distinctive mark. It is the expression 'Royal Shakespeare', which is at the same time dominant, which was repeated in the mark at issue. In the opinion of the Court, it is also significant that the mark was used in a way that targeted the public at large, not only a specialised group of consumers. Consequently, consumers could be misled by the existence of these two marks simultaneously on the market.

Ad 7) The subject of the dispute was the registration of the word mark 'PUCCI' El Corte Inglés, SA, filed a notice of opposition regarding this registration. The opposition was based on the earlier registration of the marks 'E. TUCCI' and 'EMIDO TUCCI' both as figurative and word marks. The Cancellation Division upheld the registration of the PUCCI mark registered for clothing and footwear, as did the Board of Appeal, arguing that the marks were not similar. The lack of similarity consists of a different surname used in the marks – PUCCI – TUCCI. It is proceeded by an additional element – E. TUCCI or EMIDO TUCCI.

The EU Court, in this case, referred to the previous practice of using the criteria of the average consumers about the national law. As in previous cases, the Court argued that a Spanish consumer, like an Italian one, will primarily pay attention to the surname appearing in the mark. Therefore, the surname PUCCI and TUCCI may mislead the average consumer since they only differ by one letter. However, the name EMIDO is not popular in Spain. Thus, the average consumer will consider the trademark as a whole, disregarding the dominant nature of the word TUCCI. Moreover, this form of the trademark will suggest the Italian origin of the goods

³⁷ Cf. Judgment of the General Court (Sixth Chamber) of 28 June 2012, Antonio Basile and I Marchi Italiani Srl v. Office for Harmonisation in the Internal Market (Trade Marks and Designs), Case T-134/09, <https://curia.europa.eu/juris/document/document.jsf?text=&docid=124470&pageIndex=0&doclang=-FR&mode=lst&dir=&occ=first&part=1&cid=419456> (access: 12.11.2021).

covered by it. In the opinion of the EU Court, in the case of trademarks containing a surname, the assessment of misleading an average consumer in this respect should be performed each time, in the same way as in the case of other trademarks.

Ad 8) The issue of registering a historical surname was also the subject of the Court's considerations. In this case, the painter's heirs opposed using the artist's name by a car brand. While this judgment does not refer to the issue, particular attention should be paid to the opinion of Advocate General Colomer.³⁸ In this case, the Court had no doubts that the famous artist's name could be used as the designation of cars. The Advocate General pointed out that attention should be paid to two aspects concerning protecting a historical surname. Firstly, when such a surname is allowed to be used in a different context to that in which its reputation was earned, the greater protection which must be given to marks with a highly distinctive character cannot automatically be claimed because it is not certain if the name provides any information about the commercial origin of the goods or services. Secondly, to safeguard their work from trivialisation, there is a general interest in protecting great artists' surnames, which represents a universal cultural heritage from insatiable commercial greed. It is sad to think that an averagely informed, reasonably aware, and perceptive consumer, who no longer links names such as Opel, Renault, Ford or Porsche with the outstanding engineers whose products were named after them, will, in the not-too-distant future, be subjected to the same process as the surname Picasso.³⁹

Ad 9) The Board of Appeal held that the mark Barbara Becker would be perceived by the relevant public as a person's name consisting of a first name and a surname, identical to the surname that comprises the earlier mark. It follows that the surname Becker is likely to have attributed to it a stronger distinctive character than the first name Barbara in the mark Barbara Becker. However, the court of first instance stated that the fact that Barbara Becker enjoys celebrity status in Germany as the former wife of Boris Becker does not mean that, conceptually, the marks at issue are not similar. The earlier trademark BECKER and the mark Barbara Becker refer to the same surname Becker. In the present case, it is clear that the component 'becker' will be perceived as a surname, which is commonly used to describe a person. It must be held that that component retains a distinctive independent role in the mark Barbara Becker. However, in the view of Advocate General Villalón, such grounds may lead to the misconception that any surname, similar to an earlier trademark, may constitute an obstacle to the registration of a complex trademark

³⁸ <https://curia.europa.eu/juris/document/document.jsf?jsessionid=9ea7d2dc30d60bb9aefc02af49c38984b-566f8c205ef.e34KaxiLc3qMb40Rch0SaxuOb3r0?text=&dclid=59707&pageIndex=0&dclang=EN&mode=lst&dir=&occ=first&part=1&cid=539996#Footref36> (access: 12.11.2021).

³⁹ Cf. Paragraph 69 of the opinion.

composed of the first and last name in question, due to the existence of a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94.⁴⁰

However, this case was brought to the Court, which pointed to an essential element in using a surname in trade marks. According to the Court, when assessing the similarity of the marks, account must also be taken of whether the person who requests that his first name and surname, taken together, be registered as a trademark is well known, since that factor may influence the perception of the mark by the relevant public.

Comments

Following the previous analysis, we can observe some remarks. First of all, according to the EUIPO Guidelines, 'there are no specific criteria to be taken into account when the likelihood of confusion between names is assessed. However, because of the very nature of names and surnames, certain aspects come into play that have to be carefully considered and balanced, such as whether a given name and surname is common or not in the relevant territory.'⁴¹ Trademarks consisting of names can be perceived differently in different EU countries.⁴² For instance, the special role of the average consumer – initially Italian and later Spanish. This was the first obvious step, which showed that trademarks could not be limited to trademark rights because of their functions.

Based on case-law, trademarks consisting of common surnames are also assessed in certain ways. Renown is of particular importance in assessing the similarity of trademarks. However, renown should be evaluated in relation to the reputation of trademarks but their bearers. A celebrity may also have an impact on the possibility of registering a trademark containing one's surname. Turning to trademarks containing historical surnames, it is possible to distinguish the different positions of the Advocate General, who recognised the historical name as an object of particular respect. Therefore, it is emphasised in recent judgments that these surnames have characteristic renown identified with the persons who bear them.

However, in the Messi case, the CJEU sheds essential light on the likelihood of confusion on test interpretation when assessing the conceptual differences in

⁴⁰ Opinion of Advocate General Cruz Villalón delivered on 25 March 2010, Case C-51/09 P, Barbara Becker, <https://curia.europa.eu/juris/document/document.jsf?text=&docid=79651&pageIndex=0&doclang=EN&mode=lst&dir=&occ=first&part=1&cid=540605> (access: 12.11.2021).

⁴¹ 7.2. point to the Guidelines EUIPO, <https://guidelines.euipo.europa.eu/1922895/1788130/trade-mark-guidelines/7-2-1-names> (access: 12.11.2021).

⁴² Com point 7.2.1.

determining similar marks. The Court confirmed that even if a sign has a high degree of visual and phonetic similarity, a substantial dissimilarity in concept may be sufficient to prevent confusion. It is indisputable that Messi is a globally famous figure. However, would it be fair to grant Messi broader protection against the previously registered trademark because of his extraordinary publicity? Would the Court have arrived at a different conclusion if the 'MESSI' mark owner had been someone else, for instance, a company or a family member? Messi won because he is too famous for being confused with anyone else. However, we should think about human rights (or civil ones), allowing us to identify a person by their name. According to the CJEU's decision, only one person bearing the name 'Messi' is well known, but what about someone else named Messi?

The decision also highlights another significant legal issue. The CJEU held that Messi's legal team did not need to submit any evidence of his reputation because his world-renowned reputation was already apparent. It poses challenges for practitioners to garner proof to prove the reputation of a celebrity figure. How famous must someone be so that the evidence of their notoriety can be waived? Especially when we consider the previous judgments. The EUIPO's decision concerned an earlier EU trademark LADY GAGA and a later EU trademark GAGA.⁴³ The EUIPO concluded that the opponent (Lady Gaga – the singer) failed to prove that her trademark LADY GAGA has a reputation. The evidence did not provide information on using the LADY GAGA trademark. Moreover, the evidence did not indicate the degree of recognition of the trademark by the relevant public.

Additionally, the evidence proving someone's reputation must be clear and convincing.⁴⁴ In MESSI, contrary to the previous one, the courts did not judge the reputation based on legal facts. As the doctrine points out, the ECJ clarified that ascertaining a person's notoriety is a question of fact and therefore is inadmissible in court. Thus, the ECJ accepted a priori the recognition of Messi, which affects the distinctiveness of the goods and eliminates the risk of confusion. This point of view is objectionable, and General Court should also consider the lack of evidence of personal fame.⁴⁵ Lack of evidence requirements to judge the reputation of the trademark, which is (or includes) famous surnames, can be too unclear and cause the subjective feeling of the judge becomes the basis of the decision.⁴⁶

⁴³ Decision of the Opposition Division of EUIPO No B 2 166 034.

⁴⁴ E.g. 16/12/2010, T-345/08 & T-357/08, Botolist / Botocyl, confirmed 10/05/2012, C-100/11 P, 10/01/2011, R 43/2010-4, FFR (fig.) / CONSORZIO VINO CHIANTI CLASSICO (fig.).

⁴⁵ Com. A. Sztoldman, *The Lionel Messi Case: Trade Mark's Reputation Blurred with Personal Notoriety*, "European Intellectual Property Review", 2021, 43(6), pp. 408–411.

⁴⁶ Com. M. Mancinella, *The Visual, the Phonetic and the Famous: Trade Mark Similarity in the Wake of Messi v EUIPO*, "European Intellectual Property Review" 2018, 40(10), pp. 665–668.

Although the CJEU quickly confirmed that such instances would only arise in unique circumstances, there is a lack of clarity arising from the decision. Although the celebrity of a football star certainly seems obvious in Messi, personal notoriety cannot be supposed. Lionel Messi's fame among football fans only concerns the public interest in football and sport. This is also hard to agree implausible that average consumers have never heard of Lionel Messi and be incapable of associating the MESSI mark to him.⁴⁷ If personal fame is superior to other factors, where is the limit and what are the criteria for assessing the fame of celebrities in trademark matters?

Moreover, it is hard to agree that Messi is better known in public than Lady Gaga, who is active in many areas, e.g. as a singer, actress and performer. Additionally, she is one of the most notable performers. Somehow, it brings to a very sad conclusion, pointed out by S. Martine that in trademark cases, when marks consist of surnames or trademarks, it is not necessary to compare trademarks taking into account the relevant public, the identity of the goods or services or the visual and phonetic similarity of the signs. What is essential in those cases is the reputation of the person bearing the name, which, unfortunately, based on this judgment, cannot be evaluated on a transparent basis.⁴⁸

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⁴⁷ M. Giannino, *Messi Like Picasso? General Court Rejects Opposition Against Registration as an EUTM Featuring the Name of Lionel Messi*, "Journal of Intellectual Property Law & Practice" 2018, 13(9), p. 686.

⁴⁸ 'From a trade mark perspective, the ruling implies that opposition against an application consisting of the name of a celebrity is doomed to fail regardless of the level of attention paid by the relevant public, the identity of the goods or services or the visual and phonetic similarity of the signs. This judgment merely confirms the truth of the well-known adage that it is "better to be rich and healthy than poor and sick"' – S. Martin, *Lionel Messi v EUIPO: 2-0. Court of Justice Blows Final Whistle on Opposition Proceedings Involving Leo Messi*, "Journal of Intellectual Property Law & Practice" 2021, 16(1), p. 11.

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