

Reputation and Likelihood of Confusion – It’s All a Bit of A Messi...

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CJEU determines no likelihood of confusion between footballer’s “Messi” figurative mark and earlier MASSI mark.

Whilst debate will continue to rage as to whether Messi or Ronaldo is the world’s best male football player, the Court of Justice of the European Union (the “**CJEU**”) has [ruled](#) that Argentine superstar can register his name as a trade mark after an almost decade long legal battle.

In an interesting decision for trade mark fanatics, irrespective of their interest in football, the CJEU stated that Lionel Messi’s reputation could be taken into account, without any evidence of said reputation being provided, when weighing up whether the public would be able to determine the uniqueness of Messi’s mark.

Background

The Barcelona and Argentina captain filed an application for EU trade mark registration back in 2011 for classes 9, 25 and 28 which sought registration for various goods including sportswear, footwear and equipment brands. The holder of the EU word trade mark MASSI, the Spanish cycling brand, previously registered for the same classes and filed an opposition to Messi’s application, based on the likelihood of confusion with the earlier word mark. Initially the EUIPO Opposition Division upheld the opposition in 2013, but the EU’s General Court overturned this decision in 2018.

The General Court held that there was no likelihood of confusion due to Mr Messi’s reputation, which outweighed the signs’ visual and phonetic similarities. Reputation is a well recognised concept in EU trade mark law, as per Articles 8(5) and 9(2)(c) of the EU Trade Mark Regulations. This legislation often ensures that trade marks reflecting a strong reputation will enjoy more protection. To benefit from such protection an EU trade mark must have a reputation in a “substantial part of the territory of the EU”.

The General Court outlined that Lionel Messi is not only known amongst football fans and sports followers alike but that he would be known by a majority of people who are “informed and reasonably

attentive” “who read newspapers, watch television, go to the cinema or listen to the radio”. In addition, the General Court remarked that given that the relevant goods were sports clothes the relevant public was even more likely to know Messi and associate his mark directly with him.

However, as Messi appealed the General Court’s decision, Mr Messi (or more likely his legal team) headed to the platform of the European Court of Justice, rather than the Barcelona board room where he appears to have taken up residency of late, as the two sides headed into injury time.

CJEU’s Decision

The CJEU’s decision sheds important light on the interpretation of the likelihood of confusion test when assessing marks, specifically the status of conceptual comparison in the assessment. The Court confirmed that even if a sign has a high degree of visual and phonetic similarity a strong intangible dissimilarity may be sufficient to prevent a finding of likelihood of confusion.

However, the decision highlights an additional significant legal issue in that 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 so apparent. The CJEU asserted there was a flaw in the earlier EUIPO decision, where it submitted that even if Messi is renowned he had not presented any evidence of his opposition in proceedings before them and could therefore not rely on his reputation in the proceedings.

The decision presents an interesting update in the EU’s decision on trade marks particularly when just a few months ago the CJEU determined that such a finding would only be determined in “exceptional” instances (*Claude Ruiz-Picasso and Others v OHIM*). The Messi decision appears to be such a unique case.

The CJEU’s decision was upheld on three key points:

- The reputation of Messi (as one of the world’s best football players) was one of the relevant factors in determining the likelihood of confusion test, as it could influence the public’s perception of the trade mark. The CJEU agreed with the General Court in its assessment of the likelihood of confusion.
- The reputation of Messi, as the surname of a famous football player and celebrity, was a well-known fact that could be determined from generally accessible sources and was therefore relevant in assessing the public’s perception of the mark.
- The CJEU determined the General Court had correctly applied the case law flowing from the CJEU’s judgment in the *Claude Ruiz-Picasso* case and others. The application of reputation in the determination of likelihood of confusion is applicable not only where the earlier mark has a reputation but also where the mark applied for has a reputation.

Comment

Although a clear win for Mr Messi, the decision does highlight the difficulties for practitioners surrounding the necessity to adduce evidence with respect to the reputation of a celebrity figure when defending the uniqueness of a mark. Is the figure so well-known that their notoriety is known without evidence?

Although the CJEU appears to have been quick to confirm such instances of reputation establishment will only arise in unique circumstances, there is a lack of clarity arising from the decision. The CJEU's contradiction of the EUIPO's initial decision appears to have been based in pragmatism rather than the formalities of evidentiary process. Although in this instance the celebrated status of a football star certainly appears pragmatic the process going forward of both the Court and EUIPO considering the reputation associated with a mark when establishing the likelihood of confusion is a space to follow.

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