

# A refresh of certain trademark rules thanks to AC Milan

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## ***What happened?***

In February 2017, the well-known football club Associazione Calcio Milan SpA (“AC Milan”) filed an application to register its emblem as an international trademark designating the EU for many goods including goods in Class 16 (paper, cardboard, stationery items, writing materials, etc.).

Defending its German word trademark “Milan” registered in 1988 for goods such as “paper”, “cardboards”, “stationery” in Class 16, the German office supply store InterES <sup>1</sup> introduced an opposition before the European Union Intellectual Property Office (EUIPO) to prevent the registration of AC Milan’s trademark application with respect to the goods mentioned above. InterES was claiming the existence of a risk of confusion between its prior trademark and AC Milan’s trademark application for these goods.

The signs at issue were the following:

	<b>Milan</b>
Trademark application	Earlier trademark

Both the EUIPO’s Opposition Division and the Board of Appeal upheld the opposition, which led AC Milan to request the annulment of the Board of Appeal’s decision before the General Court of the European Union (the “General Court”). On 10 November 2021, the General Court dismissed AC Milan’s action in its entirety <sup>2</sup>.

## ***What is the key takeaway?***

Quite classical, this judgment is an opportunity to refresh some key rules of trademark law.

- **Clarifications regarding the genuine use of the earlier trademark**

Facing a common challenge when filing an opposition, InterES was asked to prove the genuine use of its earlier trademark.

The General Court restates that the purpose of this rule is to ensure that the earlier trademark is used in accordance with its prime function of guaranteeing the identity of the origin of the goods or services for which it is registered. The symbolic use of a trademark only to maintain artificially the rights over a trademark is not acceptable.

The evidence brought by the opponent regarding the genuine use of its trademark must be assessed as a whole and not independently from each other. Consequently, information present in certain documents (such as invoices, catalogues) can corroborate information included in other evidence (such as an affidavit regarding sales figures) even if some documents do not refer to the relevant period to be taken into consideration to assess the genuine nature of the use.

Moreover, although the earlier sign registered was a word trademark, InterES also provided proof of use in connection with the sign reproduced below:



The evidence provided was not rejected and this was the occasion for the General Court to reaffirm that the use of a sign that is not identical to the one registered is admitted. Modifications to adapt to the constraints or evolutions of one's business are allowed to the extent that these modifications do not alter the distinctive character of the registered trademark.

In the case at hand, the General Court considered that the differences between the earlier registered trademark and the sign also used in the market by InterES (addition of a figurative element, slight styling of the word element and sign represented in blue), although not negligible, do not have an impact on the distinctive character of the earlier trademark Milan.

- **Importance of the principle of interdependence in the assessment of the risk of confusion**

When the signs or the goods or services at stake are not identical but only similar, an opposition will be considered as well-founded if there exists a risk of confusion on the part of the public in the territory in which the earlier trademark is protected, i.e. Germany in the case at hand. A risk of

confusion exists if the relevant public might believe that the goods or services marketed under the earlier trademark and the sign for which a trademark application has been filed come from the same company (or related ones). It is settled case law that the risk of confusion must be assessed globally, taking into consideration all the relevant factors in the case.

In this respect, the principle of interdependence of the relevant factors entails considering that a low degree of similarity between the designated goods or services may be compensated by a high degree of similarity between the earlier trademark and the sign for which registration is sought, and *vice versa* <sup>3</sup>.

In light of this principle, the risk of confusion was confirmed in the case at hand. The General Court considered that the element “AC MILAN” constituted the dominant element of the sign reproduced in the trademark application and that the visual differences existing between the signs at stake were offset by the high degree of similarity of the concerned goods i.e. stationery items and writing materials.

***Further points of attention: the role of the respective reputation of the conflicting signs when assessing the risk of confusion***

The Milanese football club was arguing that the Board of Appeal should have taken into account, in the context of the assessment of the risk of confusion, the high reputation of the sign applied for and of the club AC Milan.

The General Court dismissed the argument in a terse way and reaffirmed that only the reputation of the earlier trademark shall be taken into account in order to assess whether the similarity of the goods designated by the conflicting signs is sufficient to lead to a risk of confusion. This rule tends to protect the owners of existing trademarks against subsequent trademark applications for signs already known to the general public.

In the past, however, the position of the Court of Justice of the European Union (the “Court”) has not always been as clear-cut. In a recent decision concerning opposition proceedings involving another player in the world of football, the Argentine footballer Lionel Messi who, in 2011, had filed the trademark application



(in particular for clothing and sporting goods), the Court did take into account the reputation of the owner of the trademark application.

In its decision of 17 September 2020 <sup>4</sup>, the Court considered it was necessary to take into account all the relevant factors in the overall assessment of the risk of confusion and in particular the reputation of the person requesting one's name to be registered as a trademark, since this reputation may have an influence on the perception of the trademark by the relevant public.

In application of this principle, the Court confirmed that Mr. Messi's reputation was leading to a difference from a conceptual point of view between the word elements "Messi" and "Massi" (the earlier European Union trademark on which the opposition was based) thus preventing any risk of confusion between the conflicting signs. One may wonder whether the decision would have been the same if Mr. Messi had not filed the above-mentioned trademark application directly, but through a company, for instance.

Given the importance of the reputation criterion in the assessment of the risk of confusion, a clarification on the role of this criterion would be welcome to increase legal certainty for trademark applicants in their trademark filing strategy and for opponents in their defence strategy.

- 1** The full company name is InterES Handels- und Dienstleistungs Gesellschaft mbH & Co. KG.
- 2** Judgment of the General Court (Sixth Chamber) of 10 November 2021, Associazione Calcio Milan SpA (AC Milan) v European Union Intellectual Property Office, T-353/20.
- 3** See for instance Judgment of the Court of Justice of 29 September 1998, Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc. (C-39/97), §17.
- 4** Judgment of the Court of Justice of 17 September 2020, EUIPO v Lionel Andrés Messi Cuccittini and J.M.-E.V. e hijos SRL, C-449/18 and C-474/18.

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