

**DECISION
of the First Board of Appeal
of 23 April 2014**

In Case R 1553/2013-1

Lionel Messi

Spain

Applicant / Appellant

represented by J.M. TORO, S.L., Viriato, 56 - 1º izda, ES-28010 Madrid, Spain

v

J.M.-E.V. E HIJOS, S.R.L.

(Barcelona)

Spain

Opponent / Respondent

represented by CURELL SUÑOL S.L.P., Via Augusta 21, ES-08006 Barcelona, Spain

APPEAL relating to Opposition Proceedings No B 1 938 458 (Community trade mark application No 10 181 154)

THE FIRST BOARD OF APPEAL

composed of Th. M. Margellos (Chairperson), C. Rusconi (Rapporteur) and
M. Bra (Member)

Registrar: P. López Fernández de Corres

gives the following

Decision

Summary of the facts

- 1 By an application filed on 8 August 2011, Lionel Messi ('the applicant') sought to register the figurative mark 'MESSI' as reproduced hereunder



for, amongst others, the following list of goods ('the contested goods'):

Class 9 – Life-saving apparatus and instruments;

Class 25 – Clothing, footwear, headgear;

Class 28 – Gymnastic and sporting articles not included in other classes.

- 2 The application was published in the Community Trade Marks Bulletin No 158/2011 of 23 August 2011.
- 3 On 23 November 2011 Jaime Masferrer Coma filed a notice of opposition against the contested goods of the application (see paragraph 1) on the basis of a likelihood of confusion (Article 8(1)(b) CTMR) with the earlier word mark

MASSI

protected as:

- a) Community trade mark registration No 3 436 607, which was filed on 31 October 2003, registered on 3 September 2007 and duly renewed for, amongst others, the following goods:

Class 25 – Clothing, footwear, headgear.

- b) Community trade mark registration No 414 086, which was filed on 27 November 1996, registered on 20 July 1998 and duly renewed for, amongst others, the following goods:

Class 9 – Helmets for cyclists; protective clothing against accidents; protection devices for personal use against accidents;

Class 28 – Gloves, accident protective shoulder, elbow and knee guards.

- 4 On 18 May 2012, these earlier marks were transferred to J.M.-E.V. E Hijos, S.r.l. ('the opponent'). The transfer was recorded in the CTM register.
- 5 By decision dated 12 June 2013 ('the contested decision') the Opposition Division upheld the opposition for all the contested goods. The applicant was ordered to bear the costs. The Opposition Division's arguments can be summarized as follows:
 - Further to applicant's request, the opponent proved genuine use of earlier CTM registration No 414 086 only in relation to 'helmets for cyclists' in Class 9. Therefore, only these goods will be considered as basis of the opposition in relation to this earlier right;
 - As the contested goods 'life-saving apparatus and instruments' in Class 9 include, as a broader category, the opponent's goods 'helmets for cyclists', they are considered identical;
 - As regards the contested 'clothing, footwear, headgear' in Class 25, both the contested mark and earlier Community trade mark No 3 436 607 cover the entire class heading. They are considered identical;
 - As the contested goods 'gymnastic and sporting articles not included in other classes' in Class 28 and the opponent's 'helmets for cyclists' have the same purpose, nature, end users and distribution channels, they are considered similar;
 - The European Union is the relevant territory and the goods found to be identical and similar are directed both at the public at large and at business customers with specific professional knowledge or expertise. Thus, the level of attention is considered to vary from average to above average;
 - The signs are visually and aurally similar insofar as they coincide in four out of their five letters, 'M*SSI'. The only differences between the marks lie in their second letters, 'A' and 'E', respectively, and in the figurative elements of the contested sign (fanciful device in a V-shape);
 - Conceptually, depending on the language spoken, the earlier marks 'MASSI' will be associated with the following:
 - the plural of '*masa*', meaning 'table', by the Bulgarian-speaking part of the public in the relevant territory;
 - the plural of '*masso*', meaning 'boulder' or 'rock', or a common nickname for 'Massimo' or 'Massimiliano', by the Italian-speaking part of the public;

- a slang expression for money or a colloquial expression for a small purse or wallet by the Finnish-speaking part of the public;
- a form of 'mass' (denoting 'quantity, mass'), by the Estonian-speaking part of the public.

The verbal element 'MESSI' of the contested mark will be perceived as:

- the third person singular form of the verb '*mesia*', meaning 'to knead', by the Bulgarian-speaking part of the public;
- the plural form of the past participle of the verb '*mettere*', meaning, amongst others, 'to place', 'to wear', 'to put on', by the Italian-speaking part of the public;
- the kitchen/canteen of a ship by the Finnish-speaking part of the public;
- 'trade fairs', as '*messi*' is a form of the noun '*mess*', meaning 'trade fair', by the Estonian-speaking part of the public.

Independent of the language spoken, a part of the public in the relevant territory will associate 'MESSI' with the surname of the famous football player 'Lionel Messi' (the applicant). For the part of the public that associates the marks with different meanings, or for which one of the marks does not have a meaning, the marks are not conceptually similar. For the remaining part of the public, to which neither of the signs conveys a meaning, the signs have no concept in common.

- The distinctiveness of the earlier mark must be seen as normal;
- The verbal element of a trade mark has a stronger impact than the figurative element, because the average consumer will more readily refer to a mark by quoting its name rather than by describing the figurative elements of it;
- The differences found between the mark in question are not sufficient to outweigh the similarities between the marks, because consumers can rarely compare marks at the time of purchase but must rely on their imperfect recollection of them and tend to remember similarities rather than dissimilarities;
- Therefore, taking into account all the relevant factors in the present case, including the principle that a lesser degree of similarity between the signs may be offset by a greater degree of similarity between the goods, which applies in the present case, even if consumers display an increased level of attention in relation to some of the goods, they might believe that the conflicting goods come from the same or economically-linked undertakings;
- Consequently, likelihood of confusion on the part of the public exists.

- 6 On 9 August 2013 the applicant filed a notice of appeal and on 14 October 2013 the corresponding statement of grounds was received.
- 7 The decision was forwarded to the Opposition Division for consideration pursuant to Article 62 CTMR and was remitted to the Board on 22 November 2013.
- 8 The opponent submitted its observations on 23 January 2014.

Submissions and arguments of the parties

- 9 The applicant requests the Board to annul the contested decision and, as a consequence, to allow the application for the refused goods. The applicant states that there is no likelihood of confusion and makes the following submissions:
 - The opposition has been filed by a person who did not own the earlier marks at that time and should have been dismissed for that reason under Rule 20(1) CTMIR;
 - The proof of use for CTM No 414 086 does not originate from the owner but from another party (Casa Masferrer, S.A.) and does not show how significant use has been; the opposition based on that mark must accordingly be dismissed;
 - There is no likelihood of confusion in view of the visual and aural differences between the marks.
- 10 The opponent requests in its observations in reply that the rejection of the CTM application for the contested goods in Classes 9, 25 and 28 be confirmed and submits the following:
 - At the time of opposition, the earlier marks stood in the name of Mr Masferrer, who filed the opposition; the transfer to the listed company was recorded by OHIM in 2012; at that moment, the listed company became the opponent;
 - The evidence submitted, particularly the invoices, prove genuine use of the mark;
 - The marks are visually similar because the word element of the later mark (MESSI), which is the dominant element, is almost identical to the earlier mark (MASSI); they are aurally almost identical;
 - The Spanish Trade Mark Office has found confusing similarity between the parties' marks; these findings are not binding on OHIM but deserve consideration.

Reasons

- 11 The appeal complies with Articles 58, 59 and 60 CTMR and Rule 48 CTMIR. It is, therefore, admissible. However, it is unfounded because the contested decision is correct on all accounts and must be confirmed. The reasons are explained hereafter.

On the opponent's entitlement

- 12 At the time the opposition was filed – on 23 November 2011 – the earlier CTMs stood in the name of Jaime Masferrer. Mr Masferrer was, therefore, entitled to file the opposition in his name.
- 13 In 2012, at a time when the opposition proceedings were still ongoing, the CTMs were transferred to J.M.- E.V. e Hijos, S.R.L. and the transfer was recorded in the CTM register. The company thus succeeded Mr Masferrer in the trade mark ownership and, logically, in the opposition proceedings.
- 14 The applicant's objections concerning the entitlement of the opponent are therefore unfounded.

On the proof of use of CTM No 414 086

- 15 The applicant's objections as regards the proof of use are manifestly unfounded.
- 16 The applicant observes, firstly, that the evidence shows use of the mark by Casa Masferrer, S.A., who is not the owner of the mark. The fact that the owner of the CTMs is in possession of documents, such as catalogues and invoices, which have been issued by Casa Masferrer, S.A., is an indication, according to the case-law (see judgment of 8 July 2004, T-203/02, 'Vitafruit'), that Casa Masferrer, S.A. issues the catalogues and the invoices under the authority of the trade mark owner. As a result, use made by Casa Masferrer, S.A. must be considered, in the absence of any indication to the contrary, as legitimate and, therefore, inures to the benefit of the owner, i.e. the opponent.
- 17 The applicant notes, secondly, that the evidence does not show how economically significant use has been. The objection is unfounded. The opponent has submitted more than 200 invoices over the relevant five-year period. These invoices show that the 'MASSI' mark is used on all kinds of accessories for cyclists, namely helmets, protective clothing and protective devices to prevent injuries to cyclists. These invoices show that the requirement of Rule 22 CTMIR as regards extent of use has been satisfied. The mark has been used publicly, consistently with its distinctive function and on a scale, quantitatively and geographically, that can be regarded as not merely intended to artificially safeguard the registration.
- 18 The applicant also notes that the evidence is not in English (the language of opposition proceedings). The objection is unfounded. The brochures and the catalogues are multilingual and include English. It is true that most invoices are in Spanish – the language of the country where the opponent is based – but their content is not so obscure that the applicant, who claims in the CTM application

form to have 'Spanish nationality' and is moreover represented by a Madrid-based firm of lawyers, could not understand it.

- 19 The Board has reviewed the evidence and is of the opinion that it proves use of the mark not only for cyclist's helmets, as acknowledged in the contested decision, for the reasons stated in the section 'Proof of Use' of the contested decision, to which the Board refers to avoid repetitions but also for 'gloves' covered in Class 28. These gloves, specially made for cyclists, are represented in the catalogues, the price lists and appear in many of the invoices submitted.

On the likelihood of confusion

- 20 The public against whom likelihood of confusion must be assessed is composed of ordinary consumers in the European Union who buy clothing, sport goods and devices for protective purposes. They are reasonably informed, observant and circumspect.
- 21 As regards the comparison of the contested goods with those covered by the earlier registrations, the Board notes that the applicant did not consider it 'necessary' to submit any arguments since the dissimilarity of the marks was substantial enough, in its opinion, to prevent confusion.
- 22 The Board endorses the findings made in the contested decision, namely that the goods are identical as regards Classes 9 and 25 and similar, even highly, as regards Class 28, for the reasons stated in the decision, to which the Board refers to avoid repetition.
- 23 As regards the comparison of the applicant's mark with the opponent's sign, the Board notes the following.
- 24 Visually, the applicant's mark may be regarded as similar to the earlier mark because its dominant element – the name 'MESSI' – is extremely similar to the name covered by the earlier mark (MASSI). 'MESSI' is the dominant element of the contested mark because it is the only clearly legible element and, therefore, the element that consumers will refer to in trade in order to designate the applicant's mark and distinguish it from other marks. The device on top of the mark will in all likelihood be perceived by reasonably observant consumers as a stylised 'M', which relates to 'MESSI', and will thus be considered as the emblem of the 'MESSI' mark. Consumers are familiar with the practice of branding products with a word element and an emblem that abbreviates and symbolises in some way that word mark, for example by stylising its initial letter. The word, rather than the logo, will be the element whereby consumers will identify the industrial origin of the product. The fact that this element, in spite of the stylisation of the 'E', is almost identical to the earlier name ('MESSI' instead of 'MASSI') has a strong visual impact. Moreover, both names have a double consonant and finish with an 'I'. The visual appearance of both names is typically that of an Italian name. It is a further factor of visual similarity.
- 25 The aural similarity of the marks is very high, and even borders on identity in some languages of the European Union – English, French, Italian, etc. – since the

only difference is the sound of the 'A' and 'E'. It is unlikely that the 'M' device will be pronounced because consumers will see it is a logo, i.e. a sign to be perceived visually rather than aurally.

- 26 As regards the conceptual content of the conflicting marks, the opponent made no submissions in support of the opposition. The applicant submitted that the marks were conceptually dissimilar because 'MESSI' would be perceived as a surname and, specifically, the surname of a football player of the Barcelona FC, whereas 'MASSI' would be understood as 'big stones' in Italian.
- 27 In the Board's assessment, based on the parties' arguments (see Article 75 and 76 CTMR), no clear conceptual content will be attributed to the marks by reasonably observant consumers except, perhaps, that they would be associated to Italian-sounding and looking words or names. In fact, 'MESSI' and 'MASSI' are meaningless words for most consumers and the conceptual dissimilarity based on the fame that Lionel Messi enjoys among football fans only concerns part of the public, who is interested in football and sport in general. In the Board's opinion, there are no elements in the file suggesting that the mark 'MESSI' will be conceptually associated to the football player by all the relevant consumers. It must be assumed, therefore, that this conceptual association will not be made, contrary to what the applicant argues, by the whole of the relevant public. For the public who does not associate 'MESSI' with the football player, the alleged conceptual dissimilarity will obviously not be perceived.
- 28 The overall conclusion as regards the marks is that they are similar because their dominant elements, i.e. the names 'MESSI' and 'MASSI', are nearly identical visually and aurally, whereas a possible conceptual differentiation will only be made, if at all, by a part of the public.

Overall assessment of likelihood of confusion

- 29 The applicant's goods have been found to be mostly identical and in part highly similar to the goods covered by the earlier registrations.
- 30 The applicant's mark has been found to be similar to the opponent's mark. Moreover, the earlier mark has an average degree of distinctiveness.
- 31 Bearing in mind the principle of imperfect recollection of marks by the consumers and the principle of interdependence of the factors of confusion (whereby a lesser degree of similarity of the marks may be offset by a higher degree of similarity of the goods), the Board considers that use of the applicant's mark for the contested goods may cause, on the consumers' part, confusion with the earlier mark.

Costs

- 32 The applicant is ordered to bear the opponent's costs in the appeal proceedings in accordance with Article 85 CTMR, namely EUR 550 for the costs of professional representation.

Order

On those grounds,

THE BOARD

hereby:

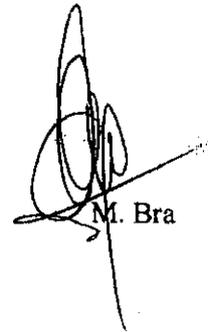
- 1. Dismisses the appeal;**
- 2. Orders the applicant to reimburse EUR 550 to the opponent.**



Th. M. Margellos

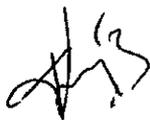


C. Rusconi



M. Bra

Registrar:



P. López Fernández de Corres

