
Protection of a Famous Person's Surname in the Light of the European Union Trade Mark Regulation

Submitted 15/04/21, 1st revision 10/05/21, 2nd revision 28/05/21, accepted 12/06/21

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Abstract:

Purpose: The main goal of the paper is to analyse the possibilities and rules of management of the protection of a famous person's surname based on the provisions of the Regulation 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (EUTMR). Moreover, the author aims at exploring whether the general principles of European Union trade marks protection are modified in view of the relation between a trade mark and a famous person in the case of the conflict between a trade mark containing a famous person's surname and a similar trade mark of another person.

Design/Methodology/Approach: The author analyses and interprets legal provisions of EUTMR and a variety of cases concerning the problem of a famous person's surname protection based on the EUTMR provisions.

Findings: A specific theory of a trade mark neutralization is applied in the case of a conflict between a trade mark containing a famous person's surname and a similar trade mark of another person. Furthermore, in such a conflict the general rule formulated by the Court of Justice of the European Union (CJEU) in the SABEL case ("the more distinctive the earlier mark, the greater will be the likelihood of confusion") tends to be modified by CJEU.

Practical Implications: The paper is addressed to both lawyers dealing with the protection of intangible assets (particularly personal names and trade marks) and managers of famous persons.

Originality/Value: The article contains a comprehensive analysis of the subject matter. The possibilities and principles of protection of a famous person's surname on the ground of the EUTMR are discussed in the context of specific cases, including the latest ones, to enable the author to detect the specific approach to the matter that tends to be applied by the courts.

Keywords: European Union trade mark, surname, personal rights, trade mark neutralization theory, bad fight, Regulation 2017/1001, EUTMR, Messi, Neymar, Picasso.

JEL codes: K29.

Paper Type: Research Paper.

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1. Introduction

Each person's surname is a designation that allows us to identify a given person and distinguish the same from others. Surnames of famous people are carriers of their popularity and ideas associated with them. Celebrities as well as their surnames *per se* are commonly recognised. Besides carrying specific notions and ideas relating to a given person, when used for business purposes, surnames become good of substantial economic value. Therefore, protecting thereof comes to the fore.

Most legal systems provide for the protection of surnames (also pseudonyms and personal images) as personal rights irrespective of social status, popularity or other characteristics of a given person. The analysis of the issues indicated goes beyond the scope of this article whose aim is to elaborate on the possibilities to protect surnames of famous persons afforded by the Regulation 2017/1001 of 14 June 2017 on the European Union trade mark (EUTMR) (Official Journal of EU, L 154, 2017). Consequently, the issues discussed will be limited to matters relating to the analysis of options to counteract situations where an unauthorised person registers a European Union trade mark (EU trade mark or EUTM) which contains the surname of a famous person without the consent of the same. The provisions of the regulation may apply to protecting the surname of a famous person where it has been registered as a trade mark and where no such registration has been made. Naturally, the range of measures available in both cases is different. It is, therefore, crucial in respect of the management of the protection of a famous person surname to decide whether register the surname of a natural person as a trade mark or not.

The aim of the article is to analyse the possibilities of management of the protecting famous persons' surnames where such persons have the right to a trade mark containing their surnames and where no such rights are afforded thereto. Moreover, the author wishes to examine whether in the case of registration of a famous surname as a trade mark and the occurrence of a conflict between such a trade mark and a similar or identical trade mark of a third party, the general rules of settling the conflicts between trade marks in the trade mark law undergo any modification in view of the link between the trade mark and the famous person.

2. Protection of a Famous Person's Surname under Regulation 2017/1001 where the Famous Person Has no Right to the Trade Mark which Contains his/her Surname

It may happen that an unauthorised person registers a trade mark in his/her name which bears a surname of another famous person. In most cases, such acts aim at capitalising on the reputation a given person enjoys and at transferring positive associations onto the goods or services offered by the breaching party. Where a famous person does not have a previously afforded right to his/her own EUTM or a national trade mark (granted on the basis of the legislation of some EU Member

State) containing his/her own surname, there are two available courses of action. First, such a person may apply to the European Union Intellectual Property Office (EUIPO) for invalidation of the EU trade mark of the breaching party under the provisions of Article 60 (2) (a) of the EUTMR, on the grounds of his/her right to the surname. Second, a famous person may request invalidation of an EU trade mark containing their surname and registered to the benefit of a third party by referring to the application filed by a third person acting in bad faith. If this be the case, the grounds for invalidity are provided in Article 59 (1) (b) of the EUTMR.

A. Invalidation of the EU trade mark on the grounds of Article 60 (2) (a) of the EUTMR – infringement of the earlier right to the surname of a famous person.

In the first case mentioned, the following provision of Article 60 (2) (a) of the EUTMR applies, i.e., “An EU trade mark shall also be declared invalid on application to the Office or on the basis of a counterclaim in infringement proceedings where the use of such trade mark may be prohibited pursuant to another earlier right under the Union legislation or national law governing its protection, and in particular: (a) a right to a name”. However, the provision cited does not contain circumstances to help determine what breaching the right to a surname consists of in. The provision is limited to a legal norm providing for relative grounds for invalidity of a registration of a trade mark where there exists an earlier right of a third party to a surname. Detailed provisions relating to specific evidence of breach of the right to a surname should be sought in the national law relevant to the persons who seek legal protection of their surnames. In the *Elio Fiorucci* case, the European Union Court of Justice (CJEU) rightly notices that where an application for EU trade mark to be declared invalid is based on an earlier right protected by a rule of national law, the EUIPO must first assess the authority and scope of the particulars submitted by the applicant in order to establish the content of that rule (CJEU C-263/09 P, 2011, para. 51).

In the Italian legal system, the right to a surname is protected against its use in a trade mark by a third person under the provisions of Article 8 (3) of the Intellectual Property Code (Codice della Proprietà Industriale, hereinafter referred to as CPI). In the *Elio Fiorucci* case mentioned above, the Cancellation Division of the EUIPO considered the application for EUTM to be declared invalid arguing that (1) pursuant to the provisions of Article 8.3 of the CPI, the consent of E. Fiorucci was required to register his surname as EUTM, and (2) no such consent was granted (CJEU C-263/09 P, 2011, para. 36). It is worth bearing in mind that *Elio Fiorucci* was a famous Italian fashion designer.

In the Polish law, the provisions of Article 24 in connection with Article 23 of the Civil Code should be applied (Tylec, 2013; Buchalska, 2015). It is assumed in the doctrine that in light of these provisions a breach of the right to a surname occurs where the use of a trade mark similar to a person's surname threatens or infringes upon the objectively justified interest of the person entitled to the surname and

where such activity is unlawful (Skubisz, 2012). Such an infringement of the person entitled to the surname could occur where the buyer of goods offered under the trade mark of the breaching party erroneously assumes that the goods come from the person entitled to the surname who commenced his/her business activity or where the goods come from a person associated with the person entitled to the surname under, say, a licence agreement (Skubisz, 2012). Invalidating the right to the DODA ENERGY DRINK trade mark is a case in point (decision of 22 June 2011 made by the Polish Patent Office, 2011). The Polish Patent Office (PPO) refused to grant protection of the word mark DODA ENERGY DRINK to the Polish entrepreneur. The Office considered that the registration of the trade mark in question infringes the personal and economic rights of the well-known Polish singer Dorota Rabczewska, who acts under the nickname DODA. Although this matter referred to an unlawful use of a nickname, and not the surname, of a famous person in a trade mark, it nevertheless may serve as an illustration on the application of the provisions of Article 60, since this provision also applies to pseudonyms (nicknames, stage names and pen names) used in trade marks of unauthorised persons. The inclusion of the “in particular” phrase in Article 60 indicates an open set of inventories of goods protected under the national law which may constitute a conflict with a later EUTM.

B. Invalidation of the EU trade mark on the grounds of Article 59 (1) (b) of the EUTMR – an application of a trade mark containing the famous person’s surname filed in bad faith

The other option to counteract the use of a famous person’s surname in a trade mark of an unauthorised person is to raise the issue of filing an application in bad faith, as stipulated in Article 59 (1) (b) of the EUTMR. Pursuant to this provision, “an EU trade mark shall be declared invalid on application to the Office or based on a counterclaim in infringement proceedings (...) where the applicant was acting in bad faith when he filed the application for the trade mark.”

The mark contained the surname of a famous footballer NEYMAR is a well-known example concerning the application for EU trade mark filed in bad faith. The NEYMAR trade mark was registered by Carlos Moreira. On application filed by Neymar Da Silva Santos, the EUIPO invalidated the registration of the Moreira’s trade mark. The General Court of EU (GCEU) upheld the decision of the EUIPO arguing that the NEYMAR trade mark was applied for registration in bad faith, solely with a view to capitalising on the reputation of a famous Brazilian football player (CJEU T-795/17, 2014). Unfortunately, there is no statutory definition of bad faith, and, therefore, one should refer to the judicial decisions of the CJEU. Pursuant to what the Court of Justice determined in its preliminary ruling in the matter of *Chocoladefabrics Lind* while assessing the trade mark application filed in bad faith, the court must, in the first place, take into consideration the knowledge of the applicant on the existence of a counterclaim of the third party (objective factor) and the applicant’s intention to prevent that third party from continuing to use such a

sign (subjective factor), (CJEU C-529/07, 2009, para. 53). The General Court of EU held that both prerequisites were fulfilled in the matter relating to the NEYMAR trade mark.

Arguably, the judgment in the matter of the NEYMAR trade mark indicates that the claim concerning the application for registration filed in bad faith can prove an effective trial strategy for famous persons who seek to protect their surnames against unlawful use in a trade mark by a third party (Giannino, 2019).

3. Protection of a Famous Person's Surname Afforded under Regulation 2017/1001 where a Famous Person Holds a Right to the Trade Mark that Contains his/her Surname

Famous people who have registered their names as trade marks acquire additional possibilities of management of protecting their surnames. This pertains to those who have registered their surnames as EU trade marks and to the national trade marks under protection in a Member State. Besides the legal grounds described above, a famous person entitled to any of the mentioned rights to the trade mark may, under the provisions of the EUTMR, oppose their right to the trade mark against a later registration of a trade mark effected to the benefit of a third party. Thus, a famous person may protect their surname not only as a personal interest but also as a trade mark. As a holder of the right to the earlier trade mark, a famous person has two courses of action to consider. A famous person may file an application for a declaration of invalidity of a later trade mark already registered in favour of a third party or undertake action early on, i.e., at the notice of opposition stage, prior to the registration of the trade mark by the breaching party. Pursuant to the provisions of Article 46 (1) of the EUTMR, the person entitled to an earlier EUTM (or a national trade mark) may file a notice of opposition to registration of a later EU trade mark on the grounds that it may not be registered within a period of three months following the publication of an EUTM trade mark application.

It should be indicated that where a given person decides to register his/her surname as a trade mark, he/she should bear in mind that such a trade mark must be used with respect to specific goods and services. Article 58 (1) (a) of the EUTMR provides that "*The rights of the proprietor of the EU trade mark shall be declared to be revoked on application to the Office or on the basis of a counterclaim in infringement proceedings (...) if, within a continuous period of five years, the trade mark has not been put to genuine use in the Union in connection with the goods or services in respect of which it is registered, and there are no proper reasons for non-use.*"

A famous person entitled to a trade mark containing his/her surname may exercise the right to protection relevant to ordinary trade marks by referring to the provisions that protect the public against confusion as to the origin of goods and/or services. Moreover, a famous person may take advantage of extended protection

relevant solely to trade marks with a reputation and acquire protection irrespective of that associated with the risk of confusion as long as all prerequisites to protect trade marks with a reputation are fulfilled. The paragraphs below elaborate on these two cases.

A. Protection of a famous person's surname registered as a trade mark based on provisions specific to ordinary trade marks.

In the first situation, a famous person may refer to the provisions that protect ordinary trade marks against the risk of confusion. These provisions include Article 8 (1) (a) and Article 8 (1) (b) of the EUTMR. Article 8 (1) (a) applies where the trade mark applied for is identical with the earlier trade mark and the goods and services for which the registration is applied for are identical with those for which the earlier trade mark is protected. If this be the case, there is no need to prove the risk of confusion since the circumstances of the case are self-evident. However, in the other situation, subject to the provisions of Article 8 (1) (b) of the EUTMR, one should demonstrate that there exists a likelihood of confusion on the part of the public which may lead the public to falsely assume that the goods that bear the trade mark of the breaching party originate from a famous person or that there is an economic or organisational link between the breaching party and the famous person. That approach results from the case-law of the Court of Justice of EU which stated that the risk that the public might believe that the goods or services in question come from the same undertaking or from economically linked undertakings, constitutes a likelihood of confusion (CJEU C-342/97, 1999, para. 17; Skubisz, 1988; Phillips, 2003). Article 8 (1) (b) of the EUTMR pertains to such conflicts where there is no complete symmetry relative to disputed markings and goods.

According to this provision, “*upon opposition by the proprietor of an earlier trade mark, the trade mark applied for shall not be registered if, because of its identity with, or similarity to, the earlier trade mark and the identity or similarity of the goods or services covered by the trade marks there exists a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected; the likelihood of confusion includes the likelihood of association with the earlier trade mark.*” The same prerequisites as those specified in Article 8 (1) (a) and (b) of the EUTMR apply to filing an application to declare the already registered trade mark invalid under the provisions of Article 60 (1) (a) of the EUTMR.

There are some general principles that results from the CJEU judgments and should be applied to evaluate the likelihood of confusion. First, a global assessment of the likelihood of confusion implies some interdependence between the relevant factors, and in particular a similarity between the trade marks and between these goods or services. Accordingly, less similarity between these goods or services may be offset by a greater degree of similarity between the marks, and vice versa (CJEU

C-39/97, 1998, para. 17; CJEU C-234/06, 2007, para. 48). Moreover, a global appreciation of the visual, aural, or conceptual similarity of the conflicting marks, must be based on the overall impression given by the marks, bearing in mind their distinctive and dominant components (CJEU C-251/95, 1997, para. 23). Finally, the global appreciation must be undertaken from the perspective of the average consumer of the category of products concerned, who is deemed to be reasonably well – informed end reasonably circumspect (CJEU C-342/97, 1999, para. 26).

However according to the doctrine, assessing the likelihood of confusion account must also be taken of whether the person whose name is incorporated in a trade mark is a well-known person (Jaeger-Lenz, 2016). This assumption can be observed i.e., based on PICASSO case, concerning the conflict between earlier PICASSO trade mark (containing the surname of a famous painter) and later PICARO trade mark owned by third party (CJEU T-185/02, 2004, para. 55-57; CJEU C-361/04 P, 2005, para. 27). In the case the General Court of UE applied “theory of a trade mark neutralization”. This theory means that aural and visual similarity of trade marks may be neutralized by obvious conceptual differences provided that at least one of the conflicting trade marks has, from the point of view of the relevant public, a clear and specific meaning that the public can grasp immediately (CJEU T-185/02, 2004, para. 56). When the theory is applied, a finding of non-confusing similarity of marks arises. The General Court of EU stated that the word sign PICASSO has a clear and specific semantic content for the relevant public.

According to the Court reputation of the painter Pablo Picasso is such that it is not plausible to consider that the sign PICASSO as a mark for motor vehicles may, in the perception of the average consumer, override the surname of the painter so that that consumer, confronted with the sign PICASSO in the context of the goods concerned, will henceforth disregard the meaning of the sign as the surname of the painter and perceive it principally as a mark of motor vehicles (CJEU T-185/02, 2004, para. 57). This point of view was confirmed by the CJEU (CJEU C-361/04 P, 2005, para. 27). The GCEU applied the same neutralisation theory in the SIR/ZIRH case (GCEU T-355/02, 2004). It seems that this idea first appeared in the matter involving a conflict between PASH and BASS trade marks (GCEU T-292/01, 2003, para. 47).

Furthermore, while determining whether there is a likelihood of confusion in the case of conflicting signs, the degree of distinctiveness of the previous mark should be taken into consideration. In the SABEL case, the CJEU stated that “*the more distinctive the earlier mark, the greater will be the likelihood of confusion*” (CJEU C-251/95, 1997, para. 23–24). Moreover, marks with a highly distinctive character, either *per se* or because of the reputation they possess on the market, enjoy broader protection than marks with a less distinctive character (CJEU C-39/97, 1998, para 18). R. Skubisz observes that Court of Justice of EU uses the notion “distinctive” in the sense of “recognition” of a trade mark (Skubisz, 2009).

However, on the background of general the rules which should be applied to assess the likelihood of confusion between trade marks, there seem to be some specific principles adopted with respect to trade marks containing surnames of globally recognised persons. In the matter of conflict between PICASSO and PICARO trade marks, the GCEU departed clearly from the afore mentioned rule that applied to the SABEL case.

The court held that in the PICASSO matter the applicants are wrong to rely on the case law which states that trade marks which have a high distinctive character, either *per se* or because of the reputation they possess on the market, enjoy broader protection than marks with a less distinctive character. The General Court of EU stated as follows: “*That the word sign PICASSO is well known as corresponding to the name of the famous painter Pablo Picasso is not capable of heightening the likelihood of confusion between the two marks for the goods concerned.*” (CJEU T-185/02, 2004, para. 61) It can, therefore, be concluded that in the opinion of the CJEU, a strong association of the mark with a famous person may not be perceived as a factor that increases the likelihood of confusion.

On the contrary, it should be treated as a circumstance that excludes the risk of confusion regarding the origin of goods or services. This judgment is a departure from the general principle established in the judgment in the SABEL case, i.e., the principle under which the more distinctive its character, the greater the risk of confusion, that the use by an unauthorised person of a similar sign will give the public a wrong impression that the goods marked with disputed signs come from the same enterprise or from affiliated enterprises. Confirmation of such a view is easy to find.

According to A. Kur, marks that are widely recognized on the market are usually remembered very clearly and are, therefore, less easily confused with similar marks than those which are only vaguely familiar to the relevant public (Kur, 2017). A similar view is presented by K. Szczepanowska-Kozłowska who aptly notes that logical contradiction makes it impossible to accept a view under which more distinctive marks should enjoy broader protection in view of their greater likelihood of confusion (Szczepanowska-Kozłowska, 2007). A mark which acquires its distinctive character through use is, after all, better known to and better remembered by the public. It follows that the public who are well acquainted with a specific mark find it easier to see the differences between this mark and that of a potential breaching party (Szczepanowska-Kozłowska, 2007).

This specific approach to the assessment of risk of confusion with respect to trade marks containing the surname of a famous person (applied in the judgment in the PICASSO case) was confirmed at the end of 2020 by the CJEU in its judgment concerning the conflict between the MASSI and MESSI trade marks (GCEU T-554/14, 2018; CJEU C-449/18 P and C-474/18 P, 2020). The Court of Justice of the EU upheld the decision of the General Court of the UE that the popularity of

Mr Lionel Andrés Messi Cuccittini is a significant factor that affects the assessment of similarities between MESSI and MASSI marks analysed in terms of their meaning. Then the CJEU, following the assertions of the GCEU, admitted that the semantic difference between the two marks may neutralise the visual and phonetic similarities. The court considered the unquestionable popularity of Messi's name, even among those who are not football fans, which led eventually to ruling out any likelihood of confusion in this instant matter. It was therefore determined that both trade marks may coexist on the market without causing any risk of confusion among the public. Commentators of the doctrine are right to note that this matter should be a warning for the owners of earlier trade marks who wish to oppose the registration of a famous person's trade mark featuring his/her surname on the grounds of their earlier rights to a similar or identical trade mark (Giannino, 2018).

The matter discussed ended well for the Brazilian footballer, since the opposition against the registration of the MESSI trade mark filed by the owner of the previous trade mark MASSI proved ineffective. In a reverse situation, i.e., if Messi Cuccittini's MESSI trade mark had priority and the footballer wished to oppose the registration of MASSI, a later trade mark, the principle of neutralisation of a trade mark should act against the footballer, i.e., it should exclude the risk of confusion and, thus, make the claim of breach of the MESSI trade mark groundless. It would be interesting to see such a hypothetical situation to find out whether courts would be ready to use the principle of neutralisation of the trade mark in rulings against famous persons. Irrespective of the possibility of protecting trade marks against the risk of confusing the public, it seems that Messi Cuccittini could protect his trade mark on the grounds of legal provisions that provide extended protection to trade marks with a reputation. For such trade marks, the risk of confusion does not serve as evidence, as shown in the dispute described above.

B. Protection of a famous person's surname registered as a trade mark on the basis of provisions specific to trade mark with a reputation.

The other option at the disposal of a famous person who has the right to a registered trade mark that bears his/her surname is to refer to the provisions on the protection of trade marks with a reputation. According to Article 8 (5) EUTMR „Upon opposition by the proprietor of a registered earlier trade mark within the meaning of paragraph 2, the trade mark applied for shall not be registered where it is identical with, or similar to, an earlier trade mark, irrespective of whether the goods or services for which it is applied are identical with, similar to or not similar to those for which the earlier trade mark is registered, where, in the case of an earlier EU trade mark, the trade mark has a reputation in the Union or, in the case of an earlier national trade mark, the trade mark has a reputation in the Member State concerned, and where the use without due cause of the trade mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.” While there is no legal definition of a trade

mark with a reputation, such a definition was formulated in the preliminary ruling of the CJEU concerning the use of the trade mark CHEVY. In its judgment, the Court of Justice of EU stated that a trade mark with a reputation must be known by a significant part of the public concerned by the products or services covered by that trade mark, and this knowledge must refer to a significant part of the territory on which this trade mark is subject to protection (C-375/97, 1999, thesis).

All the requirements that determine acquisition of the status of a trade mark with a reputation are discussed extensively in the doctrine (i.a., Simon-Fhima, 2011; Sitko, 2019). It seems that, in principle, a trade mark which contains the surname of a famous person may be recognised as a trade mark with a reputation, since the reputation of a given person becomes part and parcel of the trade mark and makes it widely recognisable. Claiming protection of a trade mark with a reputation, the applicant must demonstrate its reputation or knowledge amongst the public, as referred to in the cited judgment, and that the trade mark in question is associated with specific goods or services, since reputation must be ascertained with respect to a specific group of the public who acquire given goods or services.

Thus, it is not popularity *per se* that matters but rather the knowledge of the trade mark in each market offer. This thesis was confirmed i.a., by the decision of EUIPO held in case concerning conflict between earlier EU trade mark LADY GAGA and later EU trade mark GAGA (decision of the Opposition Division of EUIPO No B 2 166 034). In the case the Opposition Division of EUIPO concluded that the opponent (Lady Gaga – the singer) failed to prove that her trade mark LADY GAGA has a reputation as the evidence did not provide information on the extent of use of LADY GAGA trade mark. Moreover, the evidence did not provide any indication of the degree of recognition of the trade mark by the relevant public.

In keeping with the provisions of Article 8 (5) of the EUTMR, protection of trade marks with a reputation is far more attractive than that the EUTMR affords to ordinary trade marks. There is no need to demonstrate the risk of confusion where such trade marks are concerned. According to the CJEU the infringement of a trade mark with a reputation “*are the consequence of a certain degree of similarity between the mark and the sign, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them*” (CJEU C-408/01, 2003, para. 29). Thus, it is sufficient to demonstrate the likelihood of associating the mark of the breaching party with the trade mark with a reputation, which, in turn, carries the risk of unfair advantage taken from the distinctive character or reputation of the trade mark or the risk of acting to the detriment of such distinctive character or reputation. Naturally, it is essential to assess the degree of similarity of signs and to compare the categories of products for which the contentious trade marks are used (Sitko, 2017). The latter condition, albeit with certain modifications relating to the similarity of goods, is also present in relation to ordinary trade marks. An ordinary trade mark is protected solely for goods identical and similar to those for which it

is registered, while the trade mark with a reputation is protected irrespectively of the type of goods to which it refers.

4. Conclusions

In summary, it should be stated that the EUTMR may be the grounds for protecting the surname of a famous person where a third party applies for EU trade mark registration that bears the surname of a famous person. Such protection is afforded where a famous person has or does not have the right to a trade mark featuring his/her surname. In the former case, the scope of protection seems broader. Where a famous person registers his/her surname as EU trade mark, (or a national trade mark in a Member State), additional protection is afforded with respect to the surname as a trade mark by resorting to all conditions relating to the protection of trade marks. In result, a sign which is a surname acquires additional protection which all trade marks enjoy.

It is worth bearing in mind that if a famous person registers a trade mark bearing his/her surname, he/she will have an opportunity to oppose the registration applied for by third parties of trade marks whose signs are similar or identical to his/her surname. Such a person may give notice of opposition to registration of the trade mark already at the stage of the registration procedure and prevent any further action. Where a famous person does not have a trade mark that bears his/her surname, no such legal instruments are available. Such a person may seek remedies under the provisions of the EUTMR only after registration of the trade mark in favour of the breaching party. Such a person may only apply for an EU trade mark to be declared invalid under the provisions of Article 59 (1) (b) or Article 60 (2) (a) of the EUTMR. Thus, during management of the protection of the famous person's surname, one should consider the advantages of registering such a surname as a trade mark.

Referring to the question posed at the beginning of this article, it should be stated that the fame of a person whose surname is included in a trade mark has a significant influence on the assessment of the conflict between the trade mark that contains his/her surname and a similar (identical) trade mark of a third party. Where a famous person registers his/her surname as a trade mark and a conflict occurs between such a trade mark and a similar one of a third party, the rules for settling such conflicts as laid down in the trade mark law undergo some modification to account for the link of the designation with a famous person. Such a statement rests on the conclusions drawn from the analysis of the judicial decisions presented in this article.

Firstly, judicial decisions of EU courts and EUIPO point to implementing, in recent years, the theory of neutralisation of the trade mark in matters of conflicts between trade marks that contain surnames of famous persons and similar trade marks of third parties. Given the reputation of such a person, it is assumed that the

popularity of the person whose surname is included in the trade mark leads to unequivocal associations of the trade mark with that person, and despite visual and phonetic similarities between conflicting marks, such a major distinction in terms of meaning may exclude (neutralise) the likelihood of confusion of the public as to the origin of specific goods or services. This leads to the exclusion of a conflict between the trade mark containing the surname of a famous person and a similar mark of a third party and to the possibility of peaceful coexistence of these trade marks on the market.

Secondly, in settling the matter of conflict between a trade mark which contains the surname of a famous person and a similar trade mark of another person, a departure from the general principle developed by the CJEU in the SABEL case can be observed, according to which “*the more distinctive the earlier mark, the greater will be the likelihood of confusion.*” The fame of the person whose surname is included in the trade mark may give rise to unequivocal associations of the trade mark with a given person excluding the likelihood of confusion of the public as regards the origin of the goods in question where a similar trade mark is used by a third party.

Thirdly, the fame of the person whose surname is included in a trade mark may have a bearing on the assessment of evidence of a breach of the right to a trade mark with a reputation. To determine a breach of the right to a trade mark with a reputation, it is essential to demonstrate the occurrence of similarity between conflicting signs which carries the risk of associating the mark of the breaching party with the trade mark with a reputation, which can be detrimental to the repute of the trade mark or lead to taking unfair advantage of the same. The reputation of a person whose surname is included in a trade mark implies, in principle, a greater likelihood of association of the public at the sight of a similar sign used by the breaching party. The popularity of a given person may be carried onto the trade mark and may help evidence a breach of the right to a trade mark with a reputation. Nonetheless, it should be borne in mind that the person who wants to prove the reputation of his/her trade mark must demonstrate the evidence of awareness of the trade mark among the public and not the knowledge of the famous person *per se*. In consequence, broader protection specific to trade marks with a reputation can be acquired by trade mark containing the surname of a famous person provided that such a trade mark is used on the market in relation to goods or services.

As a result of the implementation of the trade mark neutralisation theory and a departure from the principle formulated in the SABEL case (the more distinctive the earlier mark, the greater will be the likelihood of confusion), protection of an earlier trade mark featuring the surname of a famous person under Article 8 (1) (b) of the EUTMR is somewhat weaker. Although the fame of a person whose surname is included in a trade mark may exclude the risk of confusion and, therefore, make it impossible to evidence a breach of the right to the trade mark under Article 8 (1) (b) of the EUTMR, it can, quite paradoxically, increase the risk

of associating conflicting signs and, by extension, facilitate protection of a trade mark with a reputation under the provisions of Article 8 (5) of the EUTMR.

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