

Judgment of the EU General Court in Case T-353/20 (AC Milan v EUIPO)

ABSTRACT: Trademark, image rights and intellectual property rights are indispensable marketing tools that sports brands use to build their reputation and commercial value. In protecting their trademark rights for specific goods or services, clubs, event organizers and sports personalities can build their brand and stand apart from their competitors. However, under some circumstances, sports brands are not protectable for all the categories of goods and services. In fact, already existing trademarks may be potentially conflicting and have grounds to oppose the registration for a specific category in a specific market. This would lead to costly consequences such as infringement disputes, product redesign, and rebranding. To get ahead of obstacles and avoid potential legal issues, a trademark clearance search is absolutely needed. The case of “AC MILAN vs. MILAN” shows how important is to verify the existence of an earlier registered trademark. In the case at hand, the General Court of the European Union dismissed the action brought by the football club and confirmed that it cannot seek protection for stationery and office supplies due to the likelihood of confusion with the earlier German trademark “MILAN”. In short, the European Court noted that (i) the earlier mark was genuinely used on the German market; (ii) the word element “MILAN” was dominant and constitutes the distinctive character of both marks, which have a high degree of aural similarity; (iii) only the reputation of the earlier mark (and not that of the mark applied for) must be taken into account to assess whether the similarity of goods designated is sufficient to affirm that there is a likelihood of confusion. As a consequence, the Italian football club lost this “trademark” game.

Keywords: *Trademark registration – Earlier trademark – International Classification of goods and services (Nice Classification) – Clearance search – Trademark coexistence agreements.
Registrazione del marchio – Marchio anteriore – Classificazione internazionale dei prodotti e dei servizi (Classificazione di Nizza) – Ricerca di anteriorità – Accordi di coesistenza tra marchi.*

**TUTELA DI MARCHI SPORTIVI:
CHI TARDI ARRIVA, PUÒ PERDERE LA PARTITA
IL CASO “AC MILAN VS. MILAN”**

di *Mario Vigna**

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Sommario: 1. Premessa – 2. La decisione della EGC e il rischio confusorio (c.d. likelihood of confusion) – 3. L’analisi dell’effettivo utilizzo del marchio anteriore – 4. La notorietà del marchio “AC Milan” – 5. Alcuni precedenti – 6. Conclusioni