

havingsrichtlijn in beginsel proportioneel en dus toelaatbaar is, maar dat er wel een wettelijke basis in de zin van art. 15 e-Privacyrichtlijn vereist is (r.o. 127). Ook op dat punt bevat de verwijzingsbeslissing volgens het HvJ te weinig informatie voor nadere duiding (r.o. 128). Maar indien er een wettelijke basis bestaat voor Microms informatieverzoek en dat verzoek voorts gerechtvaardigd, evenredig en niet misbruikbaar is, moet de resulterende verwerking aan de zijde van de ISP als rechtmatig in de zin van de AVG worden beschouwd (r.o. 131).

15. De les lijkt dus te zijn dat de waarborgen uit de AVG zich niet verzetten tegen toewijzing van een informatieverzoek jegens een ISP, mits dat verzoek voldoet aan de voorwaarden van artikel 8 Handhavingsrichtlijn (gelezen in samenhang met artikel 3). Helemaal zeker is dat niet, omdat het arrest tevens de moeilijk te plaatsen r.o. 111-112 bevat, waarin het HvJ juist wel weging van “de betrokken tegengestelde rechten en belangen” lijkt te vergen; en, helemaal raadselachtig, stelt dat de “regelingen die het mogelijk maken om een juist evenwicht te vinden” zijn vervat in de AVG zelf, zonder die regelingen nader te duiden.

16. Zie ik het goed, dan komen de beoordelingskaders onder de Handhavingsrichtlijn en de AVG evenwel op hetzelfde neer. Er dient steeds te worden onderzocht of – kort gezegd – een zwaarwegend belang van het data-subject (de eindgebruiker) zich verzet tegen toewijzing van het informatieverzoek. Het recht op privacy dient immers ook te worden meegenomen in de proportionaliteitstoets onder de Handhavingsrichtlijn. Het is goed voorstelbaar dat dit recht relatief zwaarder zal wegen in gevallen als het onderhavige, waar het om gevoelige informatie gaat en de rechthebbende dat feit mogelijk wil uitbuiten.

L.E. Dijkman

Merkenrecht

IER 2021/31

GERECHT EU

16 juni 2021

(Mrs. A. Kornezov, E. Buttigieg en K. Kowalik-Bańczyk)
m.nt. J.R. Torenbosch en J. Vrieling

Smiley Miley Inc./EUIPO

Beoordeling verwaringsgevaar; toepassing van de fasen-toets uit het arrest Equivalenza. Het Gerecht oordeelt dat het aangevraagde merk ‘Miley Cyrus’ een duidelijke, vaste en onmiddellijk te begrijpen betekenis heeft, waardoor de visuele en auditieve overeenstemming tussen het oudere merk ‘Cyrus’ en het aangevraagde merk ‘Miley Cyrus’ wordt ge-

neutraliseerd. Er is dus geen overeenstemming tussen de conflicterende tekens, de oppositie wordt afgewezen.

Art. 8 lid 1 sub b Uniemerkenverordening 2009

T-368/20

ECLI:EU:T:2021:372

(...)

Smiley Miley, Inc., established in Nashville, Tennessee (United States), represented by J.-B. Devaureix, lawyer, applicant,

v

European Union Intellectual Property Office (EUIPO), represented by V. Ruzek, acting as Agent, defendant,

the other party to the proceedings before the Board of Appeal of EUIPO being

Cyrus Trademarks Ltd, established in Road Town (British Virgin Islands),

ACTION brought against the decision of the Fourth Board of Appeal of EUIPO of 2 April 2020 (Case R 2520/2018-4), relating to opposition proceedings between Cyrus Trademarks and Smiley Miley,

THE GENERAL COURT (Tenth Chamber),

composed of A. Kornezov, President, E. Buttigieg (Rapporteur) and K. Kowalik-Bańczyk, Judges,

Registrar: E. Coulon,

having regard to the application lodged at the Court Registry on 12 June 2020,

having regard to the response lodged at the Court Registry on 7 October 2020,

having regard to the fact that no request for a hearing was submitted by the parties within three weeks after service of notification of the close of the written part of the procedure, and having decided to rule on the action without an oral part of the procedure, pursuant to Article 106(3) of the Rules of Procedure of the General Court,

gives the following

Judgment

Background to the dispute

1 On 21 April 2014, the applicant, Smiley Miley, Inc., filed an application for registration of an EU trade mark with the European Union Intellectual Property Office (EUIPO) pursuant to Council Regulation (EC) No 207/2009 of 26 February 2009 on the European Union trade mark (OJ 2009 L 78, p. 1), as amended (replaced by Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (OJ 2017 L 154, p. 1)).

2 Registration as a mark was sought for the word sign MILEY CYRUS.

3 The goods and services in respect of which registration was sought are in, inter alia, Classes 9, 16, 28 and 41 of the Nice Agreement concerning the International Classification of Goods and Services for the purposes of the Registration of Marks of 15 June 1957, as revised and amended, and correspond, for each of those classes, to the following description:

- Class 9: 'Musical sound recordings; musical video recordings; pre-recorded CDs, DVDs, audio discs, video discs, featuring music, downloadable audio recordings, downloadable video recordings, and downloadable MP3 files featuring music; downloadable multimedia files featuring music; computer carrying cases; downloadable electronic games via the Internet and wireless devices; cases for mobile phones; computer application software for mobile phones; fitted plastic films known as skins for covering and providing a scratch proof barrier or protection for electronic devices, namely, mobile telephones; audio and video recordings featuring music, comedy, action, adventure, drama, romance, dance, concerts, health, lifestyle, preparing foods and beverages; cooking food and beverages, sports, games, animation, family and children's entertainment; phonograph records featuring music; audio tapes, video tapes, audio cartridges, and video cartridges featuring comedy, action, adventure, drama, romance, dance, concerts, health, lifestyle, preparing foods and beverages, cooking food and beverages, sports, games, animation, family and children's entertainment; downloadable audio recordings, downloadable video recordings, and downloadable MP3 files featuring comedy, action, adventure, drama, romance, dance, concerts, health, lifestyle, preparing foods and beverages, cooking food and beverages, sports, games, animation, family and children's entertainment; motion picture films, television shows and radio shows featuring music, comedy, action, adventure, drama and romance, dance, concerts, health, lifestyle, preparing foods and beverages, cooking food and beverages, sports, games, animation, family and children's entertainment; downloadable multimedia files featuring comedy, action, adventure, drama, romance, dance, concerts, health, lifestyle, preparing foods and beverages, cooking food and beverages, sports, games, animation, family and children's entertainment; computers; radios; juke boxes; audio speakers; amplifiers; audio receivers; video receivers; televisions; MP3 players; digital audio players; digital video players; combination digital audio and video players; audio cassette players; video cassette players; global positioning systems; telephones; video disc players; video tape players; audio tape players; video recorders; audio recorders; video cameras; personal stereos; electronic diaries; personal digital assistants; camcorders; loudspeakers; headphones; microphones; CD players; headsets for telephones; headsets for use with computers and video game machines; media players; calculators; digital photo frames for displaying digital pictures, video clips and music, hand-held electronic device for receiving and reading electronically published materials; cases for media players; cases for MP3 players; cases for personal digital assistants; computer hardware; computer joysticks; electronic publications, namely, books, magazines, manuals, journals, catalogues, brochures, newsletters, featuring music, comedy, action, adventure, drama, romance, dance, concerts, health, lifestyle, preparing foods and beverages, cooking food and beverages, sports, games, animation, family and children's entertainment recorded on computer media; CD trading cards; electronic interactive board games for use with external monitor; interactive multimedia computer game programs; magnetic coded gift cards; blank electronic storage media; flash memory cards; memory cards; video display cards; computer software for processing digital music file; music-composition software; software for creating music; software featuring musical sound recordings and musical video recordings; digital trading cards in the nature of multimedia software recorded on magnetic media featuring music, comedy, action, adventure, drama, romance, dance, concerts, health, lifestyle, preparing foods and beverages, cooking food and beverages, sports, games, animation, family and children's entertainment; multimedia software recorded on CD-ROM featuring music, comedy, action, adventure, drama, romance, dance, concerts, health, lifestyle, preparing foods and beverages, cooking food and beverages, sports, games, animation, family and children's entertainment; electronic game software; computer game cartridges, discs, and cassettes; computer game software; video game cartridges, discs, and cassettes; video game software; cameras; digital cameras; camera cases; bags for cameras and photographic equipment; digital camera accessory in the nature of a digital photo viewer; mobile telephones; devices for hands-free use of mobile phones; downloadable ring tones for mobile phones; downloadable graphics for mobile phones; keyboards for mobile phones; mobile telephone batteries; mobile phone straps; fitted plastic films known as skins for covering and providing a scratch proof barrier or protection for electronic devices, namely, laptop computers, media players, MP3 players, smart telephones, digital cameras, global positioning systems and personal digital assistants; karaoke players; mouse pads; decorative refrigerator magnets; men's, women's and children's wearing apparel, namely, sunglasses';
- Class 16: 'Printed material, calendars, souvenir books, show programs, posters, decals, and stickers; printed material, paper goods, writing implements, namely, writing ink, stamping ink and stamps, diaries, planners, greetings cards, autograph books, appointment books, coloring books, albums, namely, sticker albums, scrapbook albums and photograph albums, printed invitations, stationery, newsletters featuring information on musical events, concerts, appearanc-

es, fashion, music and entertainment; paper banners, paper pennants, book covers, wrapping paper, paper emblems, notebooks and non-metal money clips’;

- Class 28: ‘Video game joysticks; game controllers for computer games; guitar skins for electronic guitar game controllers; video game interactive control floor pads or mats; video game interactive remote control units; video game machines for use with external display screens or monitors; hand-held electronic games adapted for use with television receivers only’;
- Class 41: ‘Entertainment services, namely, live dramatic, comedic and musical performances by a professional entertainer and singer; production and distribution of motion pictures, television shows, and radio programs; production of sound and video recordings; production of interactive programs in the nature of entertainment shows for distribution via television, cable, satellite, audio and video media, and by electronic means, namely, via the Internet; amusement park services, theme park services’.

4 On 11 September 2014, the other party to the proceedings before the Board of Appeal of EUIPO, Cyrus Trademarks Ltd, filed a notice of opposition, pursuant to Article 41 of Regulation No 207/2009 (now Article 46 of Regulation 2017/1001), to registration of the mark applied for in respect of the goods and services referred to in paragraph 3 above.

5 The opposition was based on, inter alia, the earlier EU figurative mark reproduced below, filed on 15 June 2010 and registered on 29 November 2010, under number 9176306:



6 The goods covered by the earlier EU figurative mark are in Classes 9 and 20 and correspond, for each of those classes, to the following description:

- Class 9: ‘Apparatus and instruments all for transmitting, receiving, recording and reproducing audio and visual signals; unrecorded magnetic tapes for sound recordings and cartridges for use therewith; loudspeakers, compact disc players and recorders; amplifiers; tuners; remote control units for the programming and operation of the aforesaid goods; apparatus for the wireless transmission of audio and video media; headphones; electrical communication apparatus/instruments; magnetic tapes bearing sound recordings and cartridges for use therewith; pre-recorded compact discs; gramophone records; metronomes; discs and tapes all being magnetic and for use with data processing apparatus; electric wires/cables; electrical connections; electrical distribution or control machines/instruments; rotary converters;

phase modifiers; pre-recorded video discs/tapes; central processor units and hard drive storage discs adapted for the recordal, storage, reproduction and distribution of audio and video signals; digital and analogue receivers of distributed audio and video signals; software for the control of processors and of the distribution of audio and video signals; digital rights management (DRM) apparatus and equipment, and parts and fittings for the aforesaid goods; digital media apparatus and equipment, and parts and fittings for the aforesaid goods; electrical data processing equipment and apparatus; electronic display equipment and apparatus; liquid crystal display units; electronic apparatus and equipment for the reception, storage, transmission and distribution of digital media, and parts and fittings for the aforesaid goods; electronic apparatus and equipment for the processing of digital information, and parts and fittings for the aforesaid goods; cabinets for loudspeakers; credenzas adapted for electrical apparatus; mounting apparatus adapted for use with loudspeakers; cabinets adapted for high fidelity apparatus; cabinets adapted for electrical apparatus; wall brackets for electrical apparatus; furniture adapted for high fidelity apparatus; furniture adapted to hold electrical apparatus’;

- Class 20: ‘Audio racks (furniture) for use with audio, visual and audio-visual equipment; fitted furniture for housing electrical equipment and apparatus’.

7 The ground relied on in support of the opposition was that set out in Article 8(1)(b) of Regulation No 207/2009 (now Article 8(1)(b) of Regulation 2017/1001).

8 On 30 October 2018, the Opposition Division partially upheld the opposition on the ground that there was a likelihood of confusion between the mark applied for and the earlier mark in respect of most of the goods and services covered by the mark applied for, with the exception of ‘magnetic coded gift cards; downloadable ring tones for mobile phones; downloadable graphics for mobile phones; decorative refrigerator magnets; men’s, women’s and children’s wearing apparel, namely, sunglasses’ in Class 9, ‘calendars, souvenir books, show programs, posters, decals, and stickers; paper goods, writing implements, namely, writing ink, stamping ink and stamps, diaries, planners, greetings cards, autograph books, appointment books, coloring books, albums, namely, sticker albums, scrapbook albums and photograph albums, printed invitations, stationery, newsletters featuring information on musical events, concerts, appearances, fashion, music and entertainment; paper banners, paper pennants, book covers, wrapping paper, paper emblems, notebooks and non-metal money clips’ in Class 16, and ‘amusement park services; theme park services’ in Class 41.

9 On 19 December 2018, the applicant filed a notice of appeal with EUIPO, pursuant to Articles 66 to 71 of

Regulation 2017/1001, against the decision of the Opposition Division.

10 By decision of 2 April 2020 ('the contested decision'), the Fourth Board of Appeal of EUIPO dismissed the appeal and found that there was a likelihood of confusion in respect of the goods and services in question, namely those in respect of which the opposition had been upheld. It found, in particular, that the level of attention of the relevant public varied from average to high, that the goods and services in question were identical or similar, that the signs at issue were visually and phonetically similar to an average degree and that the conceptual comparison was neutral. In the light of those considerations, the Board of Appeal concluded that there was a likelihood of confusion.

Forms of order sought

11 The applicant claims, in essence, that the Court should:

- annul the contested decision;
- order EUIPO and, if appropriate, the intervener to bear the costs of the proceedings.

12 EUIPO contends that the Court should:

- dismiss the action;
- order the applicant to pay the costs.

Law

13 As a preliminary point, it should be noted that, in view of the date on which the application for registration of the contested mark was filed, namely 21 April 2014, which is decisive for the purpose of identifying the applicable substantive law, the facts of the case are governed by the substantive provisions of Regulation No 207/2009 (judgment of 16 July 2020, *ACTC v EUIPO*, C-714/18 P, EU:C:2020:573, paragraph 2).

14 Consequently, in the present case, as regards the substantive rules, the references to Article 8(1)(b) of Regulation 2017/1001 made by the applicant in the arguments which it raises and by EUIPO must be understood as referring to Article 8(1)(b) of Regulation No 207/2009, the wording of which is identical.

15 In support of its action, the applicant raises a single plea in law, alleging infringement of Article 8(1)(b) of Regulation No 207/2009. In essence, it submits that the Board of Appeal made several errors in its assessment of the likelihood of confusion.

16 Under Article 8(1)(b) of Regulation No 207/2009, upon opposition by the proprietor of an earlier trade mark, the trade mark applied for is not to 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.

17 According to settled case-law, 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. According to the same line of case-law, the likelihood of confusion must be assessed globally, according to the perception of the signs and goods or services in question in the mind of the relevant public, and taking into account all factors relevant to the circumstances of the case, in particular the interdependence between the similarity of the signs and that of the goods or services covered (see judgment of 9 July 2003, *Laboratorios RTB v OHIM– Giorgio Beverly Hills (GIORGIO BEVERLY HILLS)*, T-162/01, EU:T:2003:199, paragraphs 30 to 33 and the case-law cited).

18 For the purpose of applying Article 8(1)(b) of Regulation No 207/2009, a likelihood of confusion presupposes both that the marks at issue are identical or similar and that the goods or services which they cover are identical or similar. Those conditions are cumulative (see judgment of 22 January 2009, *Commercy v OHIM– easyGroup IP Licensing (easyHotel)*, T-316/07, EU:T:2009:14, paragraph 42 and the case-law cited).

19 It must also be recalled that, in order for registration of an EU trade mark to be refused, it suffices that a relative ground for refusal within the meaning of Article 8(1)(b) of Regulation No 207/2009 exists in part of the European Union (see, to that effect, judgment of 14 December 2006, *Mast-Jägermeister v OHIM– Licorera Zacapaneca (VENADO with frame and others)*, T-81/03, T-82/03 and T-103/03, EU:T:2006:397, paragraph 76 and the case-law cited).

The relevant public

20 According to the case-law, in the global assessment of the likelihood of confusion, account should be taken of the average consumer of the category of goods concerned, who is reasonably well informed and reasonably observant and circumspect. It should also be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question (see judgment of 13 February 2007, *Mundipharma v OHIM– Altana Pharma (RESPICUR)*, T-256/04, EU:T:2007:46, paragraph 42 and the case-law cited).

21 In paragraph 9 of the contested decision, the Board of Appeal found, first, that, since the earlier mark was an EU trade mark, the assessment of the likelihood of confusion was dependent on the perception of the relevant public in the EU Member States and, second, based its assessment on the English-speaking part of that public.

22 The applicant submits, in essence, that the Board of Appeal's approach of basing its assessment on the English-speaking public is erroneous given that the earlier mark is an EU trade mark and that the Board of Appeal should have therefore taken into consideration all the relevant EU publics and not just the English-speaking public.

23 EUIPO disputes the applicant's arguments.

24 In that regard, it should first of all be noted that, in view of the fact that the earlier mark is an EU trade mark, the relevant territory for the purposes of assessing the likelihood of confusion is that of the European Union as a whole, as the Board of Appeal rightly found.

25 Next, it should be noted that it was open to the Board of Appeal to confine itself to taking into account the perception of the English-speaking public in so far as, as is apparent from the case-law referred to in paragraph 19 above, it suffices, in order for registration of an EU trade mark to be refused, that a relative ground for refusal within the meaning of Article 8(1)(b) of Regulation No 207/2009 exists in part of the European Union. Consequently, contrary to what the applicant submits, the Board of Appeal did not err in confining itself to taking into account the perception of the English-speaking part of that public (see, to that effect, judgment of 11 February 2020, *Dalasa v EUIPO- Charité – Universitätsmedizin Berlin (charantea)*, T-732/18, not published, EU:T:2020:43, paragraph 21).

26 Lastly, in paragraph 25 of the contested decision, the Board of Appeal found that, taking into account the nature of the goods and services in question, the relevant public consisted of the public at large and/or business customers with specific expertise or professional knowledge, and that the relevant public's degree of attention could thus vary from average to high, depending on the price, the specialised nature or the terms and conditions of the goods and services purchased. That assessment is not disputed by the parties.

The comparison of the signs

27 The global assessment of the likelihood of confusion, in relation to the visual, phonetic or conceptual similarity of the signs at issue, must be based on the overall impression given by those signs, bearing in mind, in particular, their distinctive and dominant components. The perception of the marks by the average consumer of the goods or services in question plays a decisive role in the global appreciation of that likelihood of confusion. In this regard, the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (see judgment of 12 June 2007, *OHIM v Shaker*, C-334/05 P, EU:C:2007:333, paragraph 35 and the case-law cited).

28 In the present case, the word mark applied for consists of the two elements 'miley' and 'cyrus', written in upper-case letters, whereas the earlier figurative mark consists of the word element 'cyrus'; that word element's letter 'y' is slightly stylised inasmuch as two oblique lines have been added to the letter's right-hand side; the left line of the letter 'r' is missing, and the letters 'u' and 's' are slightly incomplete and intertwined.

The degree of distinctiveness and the relative weight of the elements of the mark applied for

29 In the present case, the Board of Appeal found, in paragraph 21 of the contested decision, that the element 'miley' in the mark applied for will be perceived as a less dominant component in comparison with the element 'cyrus' because of the position and role that that element takes in the composite mark MILEY CYRUS. In that regard, it noted, relying on the case-law, that surnames generally have a 'higher intrinsic value' as indicators of the origin of the goods and services, since referring to a person is more frequently done through that person's family name, rather than first name. Furthermore, it stated that, also according to the case-law, the only exceptions are where the given name is rare and the family name is commonplace or where the public is used to identifying a particular person primarily by his or her given name. In its view, first, neither the given name Miley nor the surname Cyrus is a frequent name in the European Union and, second, none of those exceptions applies to the elements of the mark applied for.

30 The applicant submits that the Board of Appeal's finding that the element 'cyrus' is more distinctive than the element 'miley' is in no way justified. In its view, in acknowledging that the given name and surname in question making up the mark applied for are not common, the Board of Appeal should have concluded that they were equally distinctive. Lastly, the applicant states that, in those circumstances, in accordance with the case-law, the relevant public will pay more attention to the beginning of the mark applied for and therefore to the word element 'miley'.

31 In the first place, it must be noted that the Board of Appeal's assessment, in paragraph 19 of the contested decision, according to which the English-speaking public will perceive the verbal elements of the mark applied for as being the name of a person (first name and surname) is not disputed by the parties.

32 In the second place, it is necessary to recall the case-law according to which the perception of signs composed of a person's first name and surname may vary from country to country within the European Union. Thus, it cannot be excluded that, in certain Member States, consumers will remember the surname rather than first name when they perceive marks composed of a combination of a first name and a surname, since the perception of such signs may vary from country to country. However, that rule, drawn from experience, should not be applied automatically, without taking account of the specific features of each case. It is always necessary to undertake a comparison of the marks in question, considering each as a whole (see judgment of 11 July 2018, *Enoitalia v EUIPO- La Rural Viñedos y Bodegas (ANTONIO RUBINI)*, T-707/16, not published, EU:T:2018:424, paragraph 37 and the case-law cited).

33 Similarly, although it is possible that, in a part of the European Union, surnames have, as a general rule, a more distinctive character than first names, it is necessary,

however, to take account of factors specific to the case and, in particular, of the fact that the surname concerned is unusual or, on the contrary, very common, which is likely to have an effect on that distinctive character (see judgment of 11 July 2018, *ANTONIO RUBINI*, T-707/16, not published, EU:T:2018:424, paragraph 38 and the case-law cited), and to take account of whether the person who requests that his or her first name and surname, taken together, be registered as a trade mark is well known (judgment of 24 June 2010, *Becker v Harman International Industries*, C-51/09 P, EU:C:2010:368, paragraphs 36 and 37).

34 Thus, in a composite mark consisting of several word elements, a surname does not retain an independent distinctive role in every case solely because it will be perceived as a surname. The finding with respect to such a role may be based only on an examination of all the relevant factors of each case (judgment of 24 June 2010, *Becker v Harman International Industries*, C-51/09 P, EU:C:2010:368, paragraph 38).

35 In the present case, it should be noted that, in order to substantiate its finding that the surname Cyrus was the more dominant component in the mark applied for, to the detriment of the given name Miley, the Board of Appeal cited, in paragraph 21 of the contested decision, the judgment of 13 July 2005, *Murúa Entrena v OHIM–Bodegas Murúa (Julián Murúa Entrena)* (T-40/03, EU:T:2005:285), which concerned solely the perception of the Spanish public (paragraphs 40, 64, 65 and 69 of that judgment). However, as is apparent from the case-law cited in paragraph 32 above, consumers' perception of marks consisting of the combination of a first name and a surname may vary from one country to another. First, as has been pointed out in paragraph 24 above, the perception of the relevant public to be taken into account is that of the English-speaking public and, second, the Board of Appeal does not rely on any specific evidence capable of demonstrating that the English-speaking countries of the European Union generally ascribe greater distinctiveness to surnames than to first names. Therefore, it must be held that the Board of Appeal erred in applying automatically, without taking due account of the specific features of the present case, the rule that in certain Member States consumers remember the surname rather than the first name.

36 In the third place, as regards the common nature of the first name Miley and of the surname Cyrus comprising the mark applied for, the parties are in agreement that neither Miley nor Cyrus is a common first name or surname, including for the English-speaking public.

37 Furthermore, it must be observed that the mark applied for, MILEY CYRUS, refers to the first name and surname of the famous singer and actress, and that it is apparent in particular from pages 442 to 451 of EUIPO's file that she is known by that first name and that surname taken together, and not by her first name or surname taken separately.

38 Thus, in so far as, first, for the English-speaking public, it has not been established that a surname has, in

principle, greater distinctiveness than a first name and that that public would not perceive either the first name Miley or the surname Cyrus as common, and, second, the famous singer and actress in question is known by her first name and surname taken together, it must be held that those two elements are equally distinctive and, as the applicant rightly asserts, the view cannot therefore be taken that one is dominant in relation to the other. The Board of Appeal was therefore wrong to find that the element 'miley' in the mark applied for would be perceived as a less dominant element in comparison with the element 'cyrus'.

39 By contrast, concerning the applicant's argument that the public generally pays greater attention to the beginning of a mark than to its end (judgment of 25 March 2009, *L'Oréal v OHIM–Spa Monopole (SPA THERAPY)*, T-109/07, EU:T:2009:81, paragraph 30), it should be observed that an argument of that kind has no impact on the assessment of the distinctive character of the elements of a composite trade mark, as the position of an element within a sign does not in any way influence that element's capacity to identify the origin of a product or service (judgment of 3 June 2015, *Giovanni Cosmetics v OHIM–Vasconcelos & Gonçalves (GIOVANNI GALLI)*, T-559/13, EU:T:2015:353, paragraph 56 (not published)). That argument of the applicant will nevertheless be examined in paragraph 47 below in the context of the examination of the similarity between the marks at issue.

The visual and phonetic comparison

40 In the present case, the Board of Appeal found, in paragraph 20 of the contested decision, that the visual and phonetic similarities between the signs at issue were average, on account of the common element 'cyrus'. In its view, the differences on the basis of the additional verbal element 'miley' and, visually, the additional figurative aspects of the earlier mark are not so great that they could offset the similarity on the basis of the identical and distinctive component 'cyrus'. Furthermore, the Board of Appeal observed that, in accordance with the case-law, where another separate element is added to a distinctive one-word mark in such a way that the common element still retains its independent distinctive function, the marks are similar.

41 The applicant concedes that there is a visual and phonetic similarity between the marks at issue on account of the fact that the earlier mark is included in the mark applied for, but it submits that that similarity is only minimal. Next, the applicant submits that the Board of Appeal erred in paragraph 19 of the contested decision by referring to the conceptual aspect of the marks at issue when comparing them from a phonetic and visual point of view.

42 EUIPO disputes the applicant's arguments.

43 As a preliminary point, it is necessary to reject the applicant's argument that the Board of Appeal referred to the conceptual aspect of the marks at issue when comparing them from a visual and phonetic point of view.

It is true that the Board of Appeal notes, in paragraph 19 of the contested decision, after stating that the mark applied for was made up of the group of elements 'miley cyrus', written in upper-case letters, that those elements will be perceived as a name, possibly that of an American singer. However, it must be noted, as EUIPO observes, that the visual and phonetic comparison of the signs at issue as such is carried out in paragraph 20 of the contested decision, which makes no reference to the conceptual aspect of those signs. As regards the conceptual comparison, this is examined in paragraph 21 of that decision.

44 Next, as regards, in the first place, the visual similarity of the marks at issue, it must be noted, as the Board of Appeal stated, that the single and distinctive word element of the earlier mark is fully contained in the mark applied for. That fact alone is liable to create both a strong visual and phonetic similarity between the signs at issue (see judgment of 12 December 2017, *For Tune v EUIPO–Simplicity trade (opus AETERNATUM)*, T-815/16, not published, EU:T:2017:888, paragraph 53 and the case-law cited). By contrast, as the Board of Appeal correctly pointed out in paragraphs 18 to 20 of the contested decision, the marks at issue differ in the word element 'miley' of the mark applied for and the figurative elements of the earlier mark, which perform a mere decorative function. However, those differences cannot offset the similarity due to the identical and distinctive component 'cyrus'.

45 In the light of the foregoing considerations, the Board of Appeal was right to find, in paragraph 20 of the contested decision, that the visual similarity was average.

46 As regards, in the second place, the phonetic similarity, it must be held that the marks at issue coincide in the sound of two syllables, resulting from the common word element 'cyrus', which the applicant acknowledges, and that they are distinguished by the sound of a further two syllables, resulting from the word element 'miley' of the mark applied for. The Board of Appeal was therefore also right to find that the phonetic similarity of the marks at issue was average.

47 Those findings cannot be invalidated by the applicant's argument that, in accordance with the case-law, consumers generally attach more importance to the beginning of words and that they will therefore pay more attention to the element 'miley', which is in first position. While it is true that it has already previously been held that the consumer normally attaches more importance to the first part of a word mark than to the subsequent parts, it has also been held that that consideration does not hold true in all cases (see judgment of 20 October 2016, *Clover Canyon v EUIPO – Kaipa Sportswear (CLOVER CANYON)*, T-693/15, not published, EU:T:2016:620, paragraph 31 and the case-law cited). In the present case, the component 'miley' includes exactly the same number of letters as the component 'cyrus', which does not allow a finding that the relevant consumer will attach more importance to one of the components than the other (see, to that effect, judgment of 28 April 2016, *Fon Wireless v EUIPO – Henniger*

(*Neofon*), T-777/14, not published, EU:T:2016:253, paragraph 40). The applicant's argument is therefore not capable of demonstrating that the visual and phonetic similarity between the signs at issue is only minimal.

The conceptual comparison

48 In paragraph 21 of the contested decision, the Board of Appeal found that the conceptual comparison of the marks at issue was neutral. In particular, it noted that the well-known character of the name Miley Cyrus does indeed influence the perception of the relevant public. Nevertheless, it stated that the fact that the mark applied for corresponds to the name of a famous singer is not a 'meaning' for the purposes of the conceptual comparison of the marks. Furthermore, in its view, as the goods and services in question target the public at large, it is probable that a significant part of the public will not make that connection when confronted with those goods and services. It states that, in any event, even if a part of the relevant public were to perceive the signs at issue as a name, no meaning can be attributed to them given that there is no such thing as a 'Miley', a 'Cyrus' or even a 'Miley Cyrus'.

49 The applicant submits, in essence, that the Board of Appeal, in recognising that it is possible for the relevant public to perceive the group of words 'miley cyrus' as referring to the famous American singer, should have concluded, in accordance with the case-law, that the mark applied for has a meaning that is clear and distinct from that of the earlier mark and that there is therefore a conceptual difference between them.

50 EUIPO disputes the applicant's arguments and submits that, although it is indeed apparent from settled case-law that a conceptual comparison remains possible where the first name or surname in question has become the symbol of a concept due to, inter alia, the celebrity of the person bearing that first name or surname, it is also apparent from the case-law of the Court of Justice that, in a comparison of marks consisting of first names and surnames, it is appropriate to take account of the factors specific to the case at hand and, in particular, of the fact that the surname concerned is unusual or, on the contrary, very common. EUIPO states that, since neither 'miley' nor 'cyrus' is a common first name or surname, this implies that the relevant public who will identify the mark applied for, MILEY CYRUS, as referring to a famous singer, is also likely to perceive the surname alone as the short version of the full name, thus identifying the same person. In EUIPO's view, that clearly distinguishes the present case from those which gave rise to the judgments of 24 June 2010, *Becker v Harman International Industries* (C-51/09 P, EU:C:2010:368); of 22 June 2004, *Ruiz-Picasso and Others v OHIM– DaimlerChrysler (PICARO)* (T-185/02, EU:T:2004:189); and of 26 April 2018, *Messi Cuccitini v EUIPO – J.-M.-E.V. e hijos (MESSI)* (T-554/14, not published, EU:T:2018:230), referred to by the applicant.

51 In that regard, it must first of all be noted that the fact that Miley Cyrus is well known, as a singer and actress, is recognised, in essence, by the Board of Appeal in

paragraphs 19 and 21 of the contested decision. The fact that she is well known is not called into question by the parties. Furthermore, since Ms Miley Cyrus is a public figure of international reputation known to most well-informed, reasonably observant and circumspect persons who read the press, watch television, go to the cinema or listen to the radio, where they can see her or listen to her sing or where she is regularly spoken of, it follows that the relevant public will understand the mark applied for as designating the name of the famous American singer and actress.

52 Thus, as regards, first of all, the question whether the Board of Appeal was right to find that such a circumstance could not be treated as a 'meaning' for the purposes of a conceptual comparison of the marks, it must be borne in mind that the purpose of a conceptual comparison is to compare the 'concepts' that the signs at issue convey. The term 'concept' means, according to the definition given, for example, by the *Larousse* dictionary, a 'general and abstract idea used to denote a specific or abstract thought which enables a person to associate with that thought the various perceptions which that person has of it and to organise knowledge about it' (judgment of 27 June 2019, *Sandrone v EUIPO – J. García Carrión (Luciano Sandrone)*, T-268/18, EU:T:2019:452, paragraph 83).

53 Similarly, according to the case-law, conceptual similarity means that the signs at issue coincide as to their semantic content (see, to that effect, judgment of 11 November 1997, *SABEL*, C-251/95, EU:C:1997:528, paragraph 24).

54 Thus, a conceptual comparison remains possible where the first name or the surname in question has become the symbol of a concept, due, for example, to the celebrity of the person carrying that first name or surname, or where that first name or that surname has a clear and immediately recognisable semantic content (judgment of 27 June 2019, *Luciano Sandrone*, T-268/18, EU:T:2019:452, paragraph 86).

55 As is apparent from paragraph 51 above, this is the case here. Therefore, the Board of Appeal should have concluded, on the basis of its own findings, that the relevant public was likely to make a conceptual association between the group of words 'miley cyrus' and the name of the famous American singer and actress, as the applicant rightly submits.

56 Moreover, contrary to the Board of Appeal's finding in paragraph 21 of the contested decision, it cannot be concluded that the mark applied for has no meaning given that there is no such thing as a Miley, a Cyrus or a Miley Cyrus. That fact is irrelevant since the name Miley Cyrus has become the symbol of a concept, due to the celebrity of the person carrying that name, as is apparent from paragraphs 51, 54 and 55 above.

57 Accordingly, the Board of Appeal erred in finding that the name of the famous American singer and actress, Miley Cyrus, of which the mark applied for consists, has no conceptual meaning.

58 As regards, next, the earlier mark CYRUS, it must be held that, contrary to what EUIPO claims, the fact that the name Cyrus is not a common surname does not necessarily support the inference, in the present case, that the relevant public will perceive that surname alone as the short version of the full name Miley Cyrus, thus identifying the same person. As has been stated in paragraph 37 above, Miley Cyrus markets her activities and performs on stage using her first name and surname taken together. By contrast, it has been neither suggested nor demonstrated that she has been known as a singer or actress by her surname alone. It is thus apparent that the fact that Miley Cyrus is well known, as a singer and actress, results from her first name and surname taken together, and not from her surname alone. Accordingly, the mere fact that that name is not common does not support the inference that the relevant public will perceive the word 'cyrus', taken alone, as referring to the famous singer and actress Miley Cyrus, who, according to the evidence before the Court, has specifically never used the name Cyrus in isolation in the course of her career. It must therefore be held that the earlier mark has no particular semantic meaning for the relevant public.

59 It thus follows from the foregoing considerations that the applicant is correct in claiming that the marks at issue are conceptually different and that the Board of Appeal erred in finding that the conceptual comparison was neutral.

60 According to the case-law, such conceptual differences may counteract, in certain circumstances, phonetic and visual similarities between the signs in question. In order for there to be such a counteraction, at least one of the signs in question must have, from the point of view of the relevant public, a clear and specific meaning, so that that public is capable of grasping it immediately (see, to that effect, judgments of 12 January 2006, *Ruiz-Picasso and Others v OHIM*, C-361/04 P, EU:C:2006:25, paragraph 20; of 18 December 2008, *Les Éditions Albert René v OHIM*, C-16/06 P, EU:C:2008:739, paragraph 98; and of 17 September 2020, *EUIPO v Messi Cuccittini*, C-449/18 P and C-474/18 P, not published, EU:C:2020:722, paragraph 85).

61 That is the case here. The mark applied for, MILEY CYRUS, has a clear and specific semantic content for the relevant public given that it refers to a public figure of international reputation, known by most well-informed, reasonably observant and circumspect persons, as has been pointed out in paragraph 51 above, whereas the earlier mark has no particular semantic meaning. Furthermore, the reputation of the singer and actress Miley Cyrus is such that it is not plausible to consider that, in the absence of specific evidence to the contrary, the average consumer, confronted with the mark MILEY CYRUS designating the goods and services in question, will disregard the meaning of that sign as referring to the name of the famous singer and actress and perceive it principally as a mark, among other marks, of such goods and services (see, to that effect, judgment of 17 September 2020, *EUIPO v*

Messi Cuccittini, C-449/18 P and C-474/18 P, not published, EU:C:2020:722, paragraph 36).

62 It follows that the conceptual differences existing in the present case between the marks at issue are such as to counteract the visual and phonetic similarities set out in paragraphs 44 to 46 above.

63 It must therefore be concluded, following a global assessment of the overall impression produced by the signs at issue, that they are different (see, to that effect, judgment of 4 March 2020, *EUIPO v Equivalenza Manufactory*, C-328/18 P, EU:C:2020:156, paragraphs 74 and 75).

64 For the purposes of applying Article 8(1)(b) of Regulation No 207/2009, a likelihood of confusion presupposes both that the marks at issue are identical or similar and that the goods or services which they cover are identical or similar. Those conditions are cumulative (see judgment of 19 June 2018, *Damm v EUIPO – Schlossbrauerei Au, Willibald Beck Freiherr von Peccoz (EISKELLER)*, T-859/16, not published, EU:T:2018:352, paragraph 71 and the case-law cited).

65 Thus, given that the mark applied for and the earlier mark are different overall, one of the cumulative conditions for the application of Article 8(1)(b) of Regulation No 207/2009 is not fulfilled. It must therefore be held, without it being necessary to rule on the degree of similarity of the goods and services concerned, that the Board of Appeal erred in finding that there was a likelihood of confusion within the meaning of that provision.

66 It is therefore appropriate to uphold the single plea in law raised by the applicant and to annul the contested decision.

Costs

67 Under Article 134(1) of the Rules of Procedure of the General Court, the unsuccessful party is to be ordered to pay the costs if they have been applied for in the successful party's pleadings. Since EUIPO has been unsuccessful, it must be ordered to pay the costs, in accordance with the form of order sought by the applicant.

On those grounds,

THE GENERAL COURT (Tenth Chamber)

hereby:

1. **Annuls the decision of the Fourth Board of Appeal of the European Union Intellectual Property Office (EUIPO) of 2 April 2020 (Case R 2520/2018-4);**
2. **Orders EUIPO to pay the costs.**

(...)

Noot

1. In de vorige aflevering van *IER* hebben wij een artikel geschreven over de relatief nieuwe fasentoets van het Hof van Justitie, bekeken in het licht van de arresten

Equivalenza en *Messi/Massi*.¹ In dat artikel merken wij op dat de fasentoets de nieuwe gouden standaard is voor de beoordeling van merkinbreuk, maar dat de fasentoets nog wel in zijn kinderschoenen staat. De ontwikkeling van de fasentoets is daarom eentje om nauwgezet te volgen. Het is om deze reden dat wij in deze annotatie willen stilstaan bij de toepassing van de fasentoets door het Gerecht in het arrest *Miley Cyrus*. Het arrest bevat namelijk een aantal aspecten die stof tot nadenken geven over de fasentoets.

2. Voordat wij aan het arrest zelf toekomen, is het nuttig om nog eens kort te herhalen wat de fasentoets precies inhoudt. Het Hof van Justitie heeft de fasentoets uiteengezet in het arrest *Equivalenza*.² De fasentoets is van belang voor de vraag of een ouder merk kan optreden tegen een jonger teken vanwege het bestaan van verwarringsgevaar. Om te kunnen optreden op grond van verwarringsgevaar moet in ieder geval voldaan zijn aan twee constitutieve, cumulatieve voorwaarden: er moet a) sprake zijn van dezelfde of soortgelijke waren of diensten en b) het merk en teken moeten gelijk zijn of overeenstemmen. Is aan deze voorwaarden voldaan, dan moet de rechter beoordelen of sprake is van verwarringsgevaar. Het Hof oordeelt in *Equivalenza* dat de beoordeling van het vereiste 'overeenstemming' is te onderscheiden in twee fasen. In fase 1 moeten de visuele, auditieve en begripsmatige aspecten van merk en teken *sec* worden vergeleken. Deze vergelijking moet worden gemaakt op basis van de totaalindrukken die de tekens achterlaten bij het relevante publiek, mede in aanmerking genomen hun dominerende en onderscheidende bestanddelen. Aangezien fase 1 niets meer is dan het *sec* vergelijken van de tekens, mag de rechter in fase 1 geen acht slaan op andere omstandigheden van het geval. Zo mag de rechter niet meenemen of merk en/of teken bekend zijn of hoe onderscheidend merk en/of teken zijn.³ Als er ook maar iets van overeenstemming is – hoe gering dan ook – dan moet de rechter naar fase 2. In fase 2 speelt de algehele mate van overeenstemming – naast natuurlijk andere relevante omstandigheden van het geval zoals de mate van onderscheidend vermogen, bekendheid etc. – een rol bij de globale beoordeling van het verwarringsgevaar. Er is één uitzondering op de plicht van de rechter om bij een (geringe) mate van overeenstemming van fase 1 naar fase 2 te gaan en dat is wanneer de neutralisatieleer van toepassing is. Dit betreft het geval dat de tekens begripsmatig van elkaar verschillen en ten minste één van beide tekens in de ogen van het relevante publiek een vaste, duidelijke en onmiddellijk te begrijpen betekenis heeft. De neutralisatieleer is onderdeel van fase 1 en de rechter moet vaststel-

1 J.R. Torenbosch & J. Vrieling, 'De fasentoets in het licht van *Equivalenza* en *Messi*', *IER* 2021/20. Zie over de fasentoets ook ons andere artikel dat in diezelfde aflevering is verschenen: J.R. Torenbosch & J. Vrieling, 'Punten van overeenstemming wegen zwaarder dan punten van verschil?', *IER* 2021/19, p. 175-179.

2 HvJ EU 4 maart 2020, C-328/18 P, *BIE* 2020/7, m.nt. M.F.J. Haak (*Equivalenza Manufactory*).

3 HvJ EU 11 juni 2020, C-115/19 P (*China Construction Bank/EUIPO*).

len of deze leer van toepassing is ná het vaststellen van de overeenstemming van de visuele, auditieve en begripsmatige aspecten.⁴

3. Terug naar het arrest *Miley Cyrus*. Feiten van de zaak zijn als volgt. De internationaal bekende zangeres Miley Cyrus schrijft haar eigen naam in als woordmerk. Cyrus Trademarks Ltd stelt oppositie in tegen deze registratie, omdat zij meent dat sprake zou zijn van verwarringsgevaar ten opzichte van het oudere woord-beeldmerk 'Cyrus'. De oppositieafdeling oordeelt dat Cyrus Trademarks Ltd gelijk heeft en dat inderdaad sprake is van verwarringsgevaar. Dit oordeel wordt bevestigd door de Kamer van Beroep.⁵ Miley Cyrus gaat in beroep bij het Gerecht en klaagt dat de Kamer van Beroep op meerdere momenten op onjuiste wijze art. 8 lid 1 sub b Uniemerkenverordening heeft toegepast. Omdat het Gerecht van oordeel is dat Miley Cyrus terecht naar voren brengt dat de neutralisatieleer van toepassing is (waarover straks meer, zie punt 7 e.v.), hoeft het Gerecht niet te beoordelen of sprake is van verwarringsgevaar. Om deze reden staat het gehele arrest in het teken van de beoordeling van overeenstemming in fase 1. Meerdere dingen vallen op aan deze beoordeling van het Gerecht.

4. Allereerst moet het Gerecht oordelen of de Kamer van Beroep terecht als uitgangspunt heeft genomen dat 'Cyrus' het dominante bestanddeel is in het aangevraagde merk 'Miley Cyrus', omdat 'Cyrus' een achternaam is en 'Miley' een voornaam. Het Gerecht overweegt dat over het algemeen geldt dat de achternaam van een persoon een dominanter bestanddeel is dan de voornaam, maar dat het altijd nodig is om in concreto te toetsen of de achternaam inderdaad het dominante bestanddeel is. De Kamer van Beroep heeft ten onrechte niet in concreto getoetst wat het dominante bestanddeel is van het Miley Cyrus-merk. Na de vaststelling dat de Kamer van Beroep het niet goed heeft gedaan, gaat het Gerecht zelf vaststellen wat de dominante bestanddelen zijn. Het Gerecht stelt dat het in dit kader van belang is dat het aangevraagde merk 'Miley Cyrus' verwijst naar de naam van een beroemde zangeres (r.o. 37). Mede omdat Miley Cyrus als zangeres bekend is door de combinatie van haar voor- en achternaam, zijn de bestanddelen 'Miley' en 'Cyrus' even onderscheidend (r.o. 38).

5. Het is de vraag of hetgeen het Gerecht hier doet in overeenstemming is met het afgebakende beoordelingskader van fase 1. Enerzijds is goed te beargumenteren dat wat het Gerecht hier doet precies is wat het Hof van Justitie voorschrijft. In fase 1 moet de rechter immers de tekens met elkaar vergelijken op basis van de totaalindrukken die de tekens achterlaten bij het publiek, mede in aanmerking genomen hun dominerende en onderscheidende bestanddelen. Dit is wat het Gerecht doet: uit het beschikbare bewijs blijkt dat de gemiddeld geïnfor-

meerde, omzichtige en oplettende gewone consument (de Gut Springenheide-consument) bekend is met Miley Cyrus door haar voor- en achternaam tezamen. Begripsmatig gezien verwijst de combinatie van 'Miley' en 'Cyrus' naar de zangeres en een beoordeling van de begripsmatige aspecten binnen de totaalindruk van de tekens is onderdeel van fase 1. Vervolgens destilleert het Gerecht de relevante totaalindruk van het Miley Cyrus-merk, alsook de conclusie dat 'Cyrus' niet dominant is ten opzichte van het woord 'Miley'. Anderzijds geldt volgens het Hof van Justitie dat de bekendheid van het merk of het teken niet mag worden meegenomen bij de beoordeling in fase 1.⁶ De tekens moeten immers *sec* worden vergeleken op basis van hun intrinsieke kwaliteiten. Als de bekendheid van het merk en teken niet mag worden meegenomen in fase 1, zou verdedigd kunnen worden dat de bekendheid van de persoon achter een merk of teken ook niet mag worden meegenomen. De bekendheid van de persoon achter het merk heeft op het eerste gezicht niet heel veel van doen met de intrinsieke kwaliteiten van het merk. Daar valt echter tegenin te brengen dat het teken begripsmatig gezien verwijst naar de zangeres, waardoor – in tegenstelling tot de bekendheid van het merk of teken zelf – kan worden beargumenteerd dat de betekenis van Miley Cyrus wel een intrinsieke (begripsmatige) kwaliteit van het teken is.

6. Het is een voorbeeld van het feit dat de fasentoets nog in de kinderschoenen staat. Wij neigen ernaar dat het Gerecht hier op juiste wijze bepaalt wat de dominante bestanddelen zijn van het Miley Cyrus-merk. Het draait immers in fase 1 om de totaalindruk die het teken achterlaat in het geheugen van het publiek. De begripsmatige betekenis van het teken bepaalt mede de totaalindruk die het teken achterlaat bij het publiek. Zeker weten doen we het echter niet: de rol van de begripsmatige inhoud van een teken in fase 1 is een onderdeel van de fasentoets die het Hof van Justitie zal moeten verduidelijken.

7. Opvallend is verder dat Miley Cyrus zelf een beroep doet op de neutralisatieleer. Miley Cyrus stelt dat er geen overeenstemming is tussen het woordmerk Miley Cyrus en het woord-beeldmerk Cyrus, omdat de bekendheid van de zangeres de visuele en auditieve overeenstemming neutraliseert. Miley Cyrus doet dus precies wat Lionel Messi heeft gedaan in de *Messi/Massi*-zaak.⁷

8. In *Messi/Massi* behandelde het Gerecht de neutralisatieleer ten onrechte pas in fase 2. In het onderhavige arrest behandelt het Gerecht in lijn met *Equivalenza* de neutralisatieleer in fase 1. Net als in *Messi/Massi* vindt het Gerecht dat de neutralisatieleer van toepassing is. Het Miley Cyrus-merk heeft een begripsmatige betekenis die verschilt van de begripsmatige betekenis van het oudere merk Cyrus. Tevens meent het Gerecht dat 'Miley Cyrus' voor het relevante publiek een vaste, duidelijke en onmid-

4 Zie o.a. HvJ EG 12 januari 2006, C-361/04 P (*Picasso/Picaro*), r.o. 20; HvJ EU 4 maart 2020, C-328/18 P, *BIE* 2020/7, m.nt. M.F.J. Haak (*Equivalenza Manufactory*), r.o. 75; HvJ EU 17 september 2020, C-449/18 P, C-474/18 P (*Messi/Massi*), r.o. 35-36.

5 Vierde kamer van beroep van het EUIPO 2 april 2020, R 2520/2018-4.

6 HvJ EU 11 juni 2020, C-115/19 P (*China Construction Bank/EUIPO*).

7 Zie Gerecht EU 26 april 2018, T-554/14 (*Messi/Massi*) en HvJ EU 17 september 2020, C-449/18 P, C-474/18 P (*Messi/Massi*).

dellijk te begrijpen betekenis heeft, namelijk een beroemde zangeres. Omdat de neutralisatieleer van toepassing is, is niet voldaan aan het constitutievereiste 'overeenstemming' en hoeft het Gerecht niet over te gaan naar fase 2.

9. Hoewel het geslaagde beroep op de neutralisatieleer in *Miley Cyrus* sterk lijkt op het geslaagde beroep dat Messi heeft gedaan in *Messi/Massi*, is geen sprake van een volledig gelijke situatie. De constatering dat 'Miley Cyrus' een onmiddellijk te begrijpen betekenis heeft, is door de Kamer van Beroep vastgesteld (r.o. 51). Partijen zijn niet tegen dit oordeel opgekomen, waardoor het Gerecht dit als vaststaand beschouwt. In *Messi/Massi* werd de onmiddellijk te begrijpen betekenis van Messi daarentegen aangenomen op basis van algemeen toegankelijke bronnen. Anders dan in *Messi/Massi*, heeft het Gerecht in *Miley Cyrus* dus niet geoordeeld dat de zangeres dusdanig beroemd is dat op basis van algemeen toegankelijk bronnen kan worden aangenomen dat het publiek haar herkent. Hoewel het beroep op de neutralisatieleer slaagt, is het niet zo dat dit slaagt omdat de zangeres – net als Messi – een vastgestelde 'superreputatie' zou hebben. Wij willen nogmaals pleiten om voorzichtig te zijn met de aanname van een superreputatie. Onzes inziens hebben slechts een heel gering aantal personen zo'n grote bekendheid, dat – zonder concreet bewijs – kan worden aangenomen dat het publiek bij het zien van een teken direct aan deze beroemdheid moet denken.

10. Ten slotte willen wij wijzen op r.o. 61: in deze rechtsoverweging stelt het Gerecht dat de reputatie van Miley Cyrus dusdanig is dat het niet waarschijnlijk is dat, bij gebreke van concreet tegenbewijs, de gemiddelde consument bij het zien van het teken 'Miley Cyrus' de betekenis van het teken als verwijzing naar de naam van de zangeres negeert en in plaats daarvan het teken opvat als herkomstaanduiding. Wat het Gerecht hier stelt heeft onzes inziens een aantal belangrijke implicaties. De implicaties van r.o. 61 zouden wel eens kunnen inhouden dat Miley Cyrus in dit geschil slechts een pyrrusoverwinning behaalt.

11. Allereerst heeft het feit dat Miley Cyrus zelf een geslaagd beroep doet op de neutralisatieleer tot gevolg dat het woordmerk 'Miley Cyrus' vrijwel geen beschermingsomvang overhoudt. Als 'Cyrus' niet overeenstemt met Miley Cyrus vanwege de betekenis van Miley Cyrus als zangeres, dan kan hetzelfde worden gezegd over tekens als 'Mylie' of 'Cairus'. Het beroep op het neutraliserend effect van de bekendheid als zangeres kan Miley Cyrus later gaan tegenwerken als zij zelf wil optreden tegen een conflicterend teken.

12. Een tweede implicatie van r.o. 61 is wat Gielen eerder al heeft gesignaleerd en wat ook wij hebben opgemerkt in ons artikel over het arrest *Messi/Massi*.⁸ Als de gemiddelde consument bij het zien van 'Miley Cyrus' meteen denkt aan de zangeres, dan impliceert dit dat het te-

ken niet als onderscheidingsteken van waren of diensten kan fungeren. Het merk mist dus elk onderscheidend vermogen en staat bloot aan een nietigheidsactie. Het is voor merkhouders en advocaten dus goed om dit te realiseren: gebruik van de neutralisatieleer als verweer in een oppositieprocedure is tijdens een latere nietigheidsprocedure of bij reconventionele vordering tot nietigverklaring van het merk het sterkste argument waarom het merk nietig moet worden verklaard.

13. Dat een geslaagd beroep op neutralisatie impliceert dat het merk geen onderscheidend vermogen heeft, geeft ook verdere stof tot nadenken. Goed verdedigbaar is dat het merk niet alleen bloot staat aan een nietigheidsactie, maar in eerste instantie helemaal niet had mogen worden verleend door het EUIPO. Het EUIPO moet immers ambtshalve toetsen op absolute weigeringsgronden, dus ook of het teken in kwestie wel onderscheidend vermogen heeft.

14. Met de arresten *Messi/Massi* en *Miley Cyrus* zijn nu twee gevallen bekend waar een beroep op de neutralisatieleer volgens ons impliceert dat de naam van een internationale superster onderscheidend vermogen ontbeert. De vraag of de naam van een internationale superster wel onderscheidend vermogen heeft, speelt echter ook zonder dat een beroep op de neutralisatieleer wordt gedaan. Zoals het Gerecht stelt: "the reputation of the singer and actress Miley Cyrus is such that it is not plausible to consider that [...] the average consumer [...] will disregard the meaning of that sign as referring to the name of the famous singer and actress and perceive it principally as a mark [...]" Als het niet 'plausible to consider' is voor het Gerecht dat de naam van een internationaal bekende zangeres kan fungeren als herkomstaanduiding, dan geldt wellicht ook dat het EUIPO terughoudender moet zijn met het verlenen van dergelijke merken.

J.R. Torenbosch en J. Vrieling

IER 2021/32

HOF VAN JUSTITIE VAN DE EUROPESE UNIE

5 september 2019

(E. Regan, C. Lycourgos, E. Juhász, M. Ilešič, I. Jarukaitis; A-G M. Szpunar)

m.nt. F.W.E. Eijsvogels

AMS Neve/Heritage Audio

De uitdrukking "inbreuk" in art. 97 lid 5 Uniemerkenverordening 2009 moet worden opgevat als een verwijzing naar de in art. 9 Uniemerkenverordening 2009 bedoelde handelingen die de merkhouder verwijt aan de vermeende inbreukmaker, zoals in casu de handelingen bedoeld in lid 2, sub b) en d) (advertenties en verkoopaanbiedingen), en deze handelingen moeten worden geacht te hebben "plaatsgevonden" waar de verrichting van deze handelingen zichtbaar werd in de vorm van advertenties en verkoopaanbiedingen,

⁸ Gielen, 'Lijkt het nu allemaal minder op elkaar dan vroeger', *IER* 2005/61; J.R. Torenbosch & J. Vrieling, 'De fasentoets in het licht van Equivalenza en Messi', *IER* 2021/20, p. 192.