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## **Title**

Miley Cyrus ‘came in like a wrecking ball’: the American popstar succeeds in registering her name as an EU trade mark.

## **Relevant case and legislation**

Case T-368/20, *Smiley Miley, Inc. v European Union Intellectual Property Office (EUIPO)* and Article 8(1)(b) of Regulation (EC) No 207/2009

## **Single sentence summary**

The article analyses the decision in *Smiley Miley v EUIPO*, in which the General Court held that the American singer-songwriter and actress Miley Cyrus was entitled to use her name as a trade mark. It considers the importance of this ruling in relation to the protection afforded to public figures of international recognition through trade marks in the EU.

## **Legal context**

Article 8(1)(b) of Regulation No. 207/2009 on the EU Trade Mark (now Article 8(1)(b) of Regulation (EU) 2017/1001), provides that, upon opposition by the owner of an earlier trade mark, a finding of a likelihood of confusion presupposes that the marks at issue are identical or similar and that the goods or services covered are identical or similar. These requirements are cumulative. In assessing the likelihood of confusion, a global assessment of the overall impression produced by the signs needs to be made with reference to their visual, phonetic and conceptual similarities. Under certain circumstances, the conceptual differences between the signs can be so strong to effectively counteract their visual and phonetic similarities, ruling out any finding of likelihood of confusion.

In September 2020, the CJEU ruled that the world-famous footballer Lionel Messi was entitled to register his name ‘Messi’ as a trade mark following a nine-year legal battle (joined Cases C-449/18 P *EUIPO v Messi Cuccittini* and C-474/18 P *J.M.-E.V. e hijos v Messi Cuccittini*). The CJEU agreed with the General Court (GC) in ruling that the conceptual difference between the two signs in question (‘Messi’ referred to the professional sport-star and ‘Massi’ was devoid of a specific meaning) offset any visual and phonetic similarities, so that the signs were different overall. As such, the EUIPO had erred in concluding that use of the ‘Messi’ mark for the goods at issue could give rise to a likelihood of confusion with the ‘Massi’ mark on the part of the relevant public (see Stefan Martin, ‘Lionel Messi v EUIPO: 2-0. Court of Justice blows final whistle on opposition proceedings involving Leo Messi’ 16(1) *JiPLP* 9-11). A similar line of reasoning was followed by the GC in the case of the artist Miley Cyrus.

## **Facts**

In 2014, Smiley Miley Inc., the Tennessee-based company of the popular artist Miley Cyrus, filed an application with the EUIPO for the registration of the word mark ‘MILEY CYRUS’ against several goods in Classes 9, 16, 28 and 41 of the Nice Agreement, including audiovisual and information technology equipment, merchandising and entertainment services. The mark was opposed by Cyrus Trademarks Ltd on the basis that the applicant’s mark was confusingly similar to its earlier figurative mark ‘CYRUS’ that was registered in 2010, indicating music and audio-related good in classes 9 and 20.

In 2018, the Opposition Division of the EUIPO agreed in part with the opponent, holding that there was a likelihood of confusion within the meaning of Article 8(1)(b) between the earlier mark ‘CYRUS’ and the mark applied for in respect of the majority of the goods and services for which registration was sought. Smiley Miley failed to convince the Fourth Board of Appeal of the EUIPO that there was no likelihood of confusion and the Board confirmed the Opposition

Division's ruling in 2020. The Board held, in particular, 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 (Case T-368/20, *Smiley Miley, Inc. v EUIPO*, henceforth 'Smiley Miley', para. 10). Smiley Miley Inc. successfully appealed to the GC.

### Analysis

The GC considered whether the Board of Appeal was wrong in its assessment that 'MILEY CYRUS' could cause a likelihood of confusion with the 'CYRUS' mark. The Board had determined that there was an average visual and phonetic similarity between the signs, given that the earlier mark's single and distinctive component 'CYRUS' was wholly present in Smiley Miley's mark and that the marks coincided in the sound of two syllables resulting from the shared word element. Moreover, the Board had acknowledged that the applied for mark corresponded to the name of a reputed singer, but this was not sufficient to attribute a 'meaning' for the purposes of the conceptual comparison of the marks: 'there is no such thing as a "Miley", a "Cyrus" or even a "Miley Cyrus",' the Board had observed (*Smiley Miley*, para. 48). In the Board's opinion, 'Miley' was more common than the more distinctive element 'Cyrus' and the relevant public would understand that the mark applied for was the full name of 'CYRUS' or that 'CYRUS' is the mark belonging to the singer as the short version of the full name. In each of these cases, the respective marks would be taken to identify the same commercial origin. Coupled with the finding about the average degree of visual and phonetic similarities, the signs should be regarded as similar overall, and a likelihood of confusion was present.

The GC disagreed. Its analysis centred on two main issues. The first concerned the conceptual comparison of the signs. The Board had erred in holding that the conceptual comparison between the marks was neutral. A conceptual comparison is still 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 surname has a clear and immediately recognisable semantic content' (*Smiley Miley*, para. 54). The GC rejected the EUIPO's view that the singer's name lacked any meaning with which the first name and surname could be associated. The Court underlined that the word-sign 'MILEY CYRUS' has 'a 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 [...] whereas the earlier mark has no particular semantic meaning' (*Smiley Miley*, para. 61). In other words, 'MILEY CYRUS' has a specific meaning, because the relevant public associates it with the well-known pop star. As such, it was conceptually distinct from the earlier 'Cyrus' trade mark.

The second issue related to the effect of the reputation of the person whose name was to be the subject of the trade mark, since that factor may influence the relevant public's perception of the mark (Case C-51/09, *Becker v Harman International Industries*, paras. 36-37). The GC recognised that surnames generally enjoy in part of the EU greater distinctiveness than first names, but each case needs to be evaluated on its own merits. The Court challenged the EUIPO's finding that 'Miley' in the mark applied for would be perceived as a less dominant element compared to 'Cyrus'. The mark applied for in this case referred to the first name and surname of a world-renowned performer, who is known by the first name and surname *taken together*. Those two components were 'equally distinctive' (*Smiley Miley*, para. 38). It was wrong to assume that one was more dominant in relation to the other and thus the public would not perceive 'Cyrus' as a reference to 'Miley Cyrus'.

The GC concluded that the conceptual differences in the present case counteracted the visual and phonetic similarities between the mark applied for and the earlier mark. Given this finding, one of the cumulative conditions for the application of Article 8(1)(b) was not fulfilled;

hence, the GC did not need to consider the similarity between the goods or services and eventually annulled the EUIPO's decision.

### **Practical significance**

Coming like 'a wrecking ball' (as the lyrics of one of her biggest hits suggest), the American pop star succeeded in proceeding with the registration of an EU trade mark. The judgment confirms that a name and surname, taken as a whole, can have a conceptual meaning and that the fame and popularity attached to them may result in a finding of conceptual dissimilarity with an earlier registration. Specifically, where a clear and specific meaning is assigned to a name by the relevant public, so that it is capable of grasping it immediately, this is a factor that can neutralise any visual and phonetic similarities between the senior and the junior mark.

Although the decision does not depart from the previous line of case law (see also Case T-185/02, *Claude Ruiz-Picasso and Ors v EUIPO*), it reinforces the significance of the strong protection available to public figures with widespread recognition through the registration of trade marks featuring their names in the EU. Public personas are likely to be able to secure a trade mark for their name - even where visually and phonetically similar trade marks already exist on the register - on the basis that the applicant's reputation may affect the relevant public's perception of the mark. Even though it is implicit in the GC's decision that the specific features of each case need to be examined, neither the *Messi* nor the *Smiley Miley* decision help clarify how exactly the assessment of the likelihood of confusion is to be approached when registration is sought by an applicant who is not a A-list celebrity. Whilst the outcome in the case at hand is favourable to famous personalities as 'human brands' (Renaud Lunardo, Olivier Gergaud and Florine Livat, 'Celebrities as Human Brands: An Investigation of the Effects of Personality and Time on Celebrities' Appeal' (2015) 31(5-6) *Journal of Marketing Management* 685), it will be interesting to see whether corporate brands can rely on a similar argument where their incomparable global reputation (e.g., in the ICT sector) is a well-known fact.