

Goal or yellow card – Inter Miami vs Inter Milan

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At the time of writing, events worldwide are being cancelled or postponed in an effort to reduce the Covid-19 pandemic. A new major league soccer (“MLS”) professional team based in Miami, USA, called Inter Miami, was scheduled to play its first game on 14 March 2020 and was yet another event postponed. The formation of team Inter Miami is driven by David Beckham, the former captain of football teams Manchester United and England who is also a minority shareholder in MLS.

Inter Miami is also currently involved in a trade mark dispute with Italian Football team, Inter Milan.

We know that sport and sporting events, sponsorships, merchandise and events emanating there from exemplify the value of IP, written about in previous editions of our Legal Werks newsletters ([Roger Federer trade mark](#) and [trade marks in sports](#)).

With the availability and continued promotion of the Inter Miami team, apparel and merchandise the outcome of the current trade mark dispute before the United States Patent and Trade Mark Office (“USPTO”) may require a change of tack.

Background

The trade mark dispute concerns MLS and the Italian football team Inter Milan and their respective word marks Inter Miami CF (“Inter Miami”) and Inter Milano (“Inter Milan”).

In September 2018, a US trade mark application for the mark Inter Miami in a range of classes was filed on behalf of MLS. Although the Inter Milan application belonging to Internazionale Milano S.p.A. predates the Inter Miami application by four years, MLS chose to oppose Inter Milan and filed formal trade mark opposition proceedings with the USPTO in March 2019.

The trade mark dispute concerns exclusivity to the word “Inter” with MLS claiming that “Inter” refers to “international” and is a common term, particularly in soccer, and therefore not exclusive to one soccer team. MLS avers both a likelihood of confusion and descriptiveness claiming that if Inter Milan were to exclusively retain the mark, it would unfairly prevent use or registration of further marks incorporating the word “Inter”.

The USPTO has since dismissed MLS’ likelihood of confusion claim as a result of insufficient evidence. Interestingly the USPTO has not accepted MLS arguments on behalf of other clubs that have, or may have “Inter” in their names and according to the USPTO record, although there is a disclaimer on “Milano”, there is no disclaimer on “Inter”. It remains to be seen whether MLS can adduce enough evidence to support its claim of descriptiveness which may prove difficult given that the USPTO hasn’t considered arguments on behalf of third parties as relevant.

The USPTO’s decision is being watched with interest as are the fixtures!



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