

**European Union Intellectual Property Office  
Grand Board of Appeal  
Alicante, Spain**

**RE:** Case R 50/2024-2, Johannes Hendricus Maria Smit / *EUIPO*

**DATE:** January 7, 2025

**Amicus Brief (Third Party Observations) – International Trademark Association**

The International Trademark Association (“**INTA**”) has prepared this brief in relation to Case *R 50/2024-2, Johannes Hendricus Maria Smit / EUIPO* pending before the Grand Board of Appeal of the European Union Intellectual Property Office (“**GBoA EUIPO**”).

Art 37(6) of Commission Delegated Regulation (EU) 2018/625 of 5 March 2018 supplementing Regulation (EU) 2017/1001 of the European Parliament and of the Council on the European Union Trade Mark and repealing Delegated Regulation (EU) 2017/1430 (“**EUTMDR**”) allows for intervention of interested groups or bodies in EUIPO appeal proceedings referred to the EUIPO Grand Board of Appeal.

**ABOUT INTA**

INTA is a global association of brand owners and professionals dedicated to supporting trademarks and related intellectual property (IP) to foster consumer trust, economic growth, and innovation. Members include nearly 6,500 organizations, representing more than 34,350 individuals (trademark owners, professionals, and academics) from 185 countries, who benefit from the Association’s global trademark resources, policy development, education and training, and international network. Founded in 1878, INTA is headquartered in New York City, with offices in Brussels, Santiago, Beijing, Singapore, and Washington, D.C. Metro Area, and a representative in New Delhi. An important objective of INTA is to protect the interests of the public by the proper use of trademarks.

In this regard, INTA strives to advance the development of trademark and related IP and unfair competition laws and treaties throughout the world, based on the global public interest in avoiding deception and confusion. INTA has been an official non-governmental observer to the World Intellectual Property Organization (WIPO) since 1979 and actively participates in all trademarks related WIPO proposals. INTA has influenced WIPO trademark initiatives such as the Trademark Law Treaty, and also is active in other international arenas, including the Asia Pacific.

The present brief was drafted by INTA independently of the parties in the case at issue.

## INTA'S INTEREST IN THE CASE

INTA is not a party in the case but believes that the case is significant to the development of trademark law and presents itself as an *amicus curiae* ("friend of the court") in the matters raised therein, as it has done in the past (see **Annex A** listing previous amicus interventions by INTA before the EUIPO, the General Court of the European Union and the Court of Justice of the European Union).

Through its International Amicus Committee, INTA provides expertise concerning trademark and other IP-related laws to courts and trademark offices around the world by way of the submission of *amicus curiae* briefs or similar filings. Through these kinds of filings, INTA takes advantage of procedures that allow an independent third party to a proceeding to voluntarily offer an opinion on a legal matter, such as the proper interpretation or application of the law, or an explanation for why certain policies are superior.

The purpose of INTA's intervention in such cases is to ensure that the court or tribunal is fully informed about the relevant issues that may impact the law in a given jurisdiction. Unlike the parties in litigations, who typically focus on the specific facts of a case and argue for a particular outcome, INTA plays a neutral role, addressing only the legal issues. INTA hereby acts in the interest of the represented manufacturers, producers, suppliers of services, traders, or consumers, who are affected by the various issues of concern in this case regarding registrability of marks.

INTA hopes that this submission may be of assistance to the GBoA.

In particular, INTA considers it worth intervening in these proceedings, given the importance for the trademark world of the case at issue, which deals with the registrability of people's faces – including famous people's faces – as trademarks.

INTA believes that the referral to the GBoA deals with limitations of trademark law: it is not only about the registrability of a certain type of image, but also about what makes a "sign" in the sense of trademark law and about the impact of personality rights on trademark law. In a broader sense, it calls for determining the function and scope of trademark rights alongside proprietary and moral rights of a different kind.

## PROCEDURE FOR INTERVENTION

Article 37(6) EUTMDR provides for intervention in cases referred to the EUIPO Grand Board of Appeal as follows:

***Groups or bodies representing manufacturers, producers, suppliers of services, traders or consumers which can establish an interest in the result of a case on appeal or a request for a reasoned opinion brought before the Grand Board, may submit written observations within two months following the publication in the Official Journal of the Office of the decision of referral or, as the case may be, the request for a reasoned opinion. They shall not be parties to the proceedings before the Grand Board and shall bear their own costs.***

The referral decision was published in the EUIPO Official Journal on November 4, 2024, so the two months deadline to submit written observation ends on January 6, 2025; being a day in which the Office is closed, the deadline is automatically postponed to **January 7, 2025**.

## **ANALYSIS**

### **I. The relevant legal provisions**

Due to the date of the initial filing in 2015, Community Trade Mark Regulation (CTMR) 207/09 is applicable. The Second Board of Appeal however would rather apply Trade Mark Regulation (EU) 2017/1001 of the European Parliament and of the Council on the European Union Trade Mark (“**EUTMR**”) as the relevant provisions are not materially different from the earlier law.

#### Article 4 EUTMR:

*Signs of which an EU trade mark may consist*

*An EU trade mark may consist of any signs, in particular words, including personal names, or designs, letters, numerals, colours, the shape of goods or of the packaging of goods, or sounds, provided that such signs are capable of:*

*(a) distinguishing the goods or services of one undertaking from those of other undertakings; and (b) being represented on the Register of European Union trade marks (‘the Register’), in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor.*

#### Article 7(1) EUTMR:

*Absolute grounds for refusal*

*1. The following shall not be registered:*

*(a) signs which do not conform to the requirements of Article 4;*

*(b) trade marks which are devoid of any distinctive character;*

*(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service;*

#### Article 7(2) EUTMR:

*2. Paragraph 1 shall apply notwithstanding that the grounds of non-registrability obtain in only part of the Union.*

#### Article 7(3) EUTMR:

3.Paragraph 1(b), (c) and (d) shall not apply if the trade mark has become distinctive in relation to the goods or services for which registration is requested as a consequence of the use which has been made of it.

## II. The Case Background and the Contrasting Positions Within the EUIPO

### A. The Contested Mark

The case at issue concerns the registrability of the image of a human face as an EU trademark. By EUTM application No. 014711907, filed on October 23, 2015, the applicant is seeking to register an image of his face which appears to be a “natural” depiction of the real appearance of his face in the manner of a photograph, as shown below:



The applicant is a singer, actor and TV presenter who is well known in The Netherlands and who has gained a certain reputation also in Germany, Belgium, Switzerland and Austria. He is not really known in the other EU Member States. In 2021, he presented the European Song Contest in Rotterdam, which was broadcast throughout the whole of the EU. For some years, the applicant sought to market an eponymous fashion-label which however failed to become a commercial success.

### B. The Refusal

By decision of December 19, 2023, the Examiner had refused to register the above photograph as a figurative mark for a number of goods in classes 9, 16, 24 and 25 and for services in classes 35 and 41 (the “**Refusal**”). The Refusal was based on: (1) lack of distinctiveness for all of the applied-for goods and services and (2) descriptiveness for some of the applied-for goods and services.

The Examiner found that (photographic) representations of persons are commonplace in the advertising of products and services, that “*there is no feature, nor any memorable or striking element, which confers a minimum degree of distinctiveness on the sign to enable consumers to perceive it other than mere appearance*” and that portrait photos “*generally imply nothing more than a banal representation of people in general, so it can be expected that such images will be understood as common to the goods and services in question*”.<sup>1</sup> The Examiner found that

---

<sup>1</sup> Examiner decision of December 19, 2023, pages 10 and 11.

distinctiveness lies on whether the face has any particular features: “[...] *there may be heads/faces with dominant or distinctive features, such as Barbra Streisand's nose, a cap (R 2574/2028-1, EU trademark No 017916623) or Donald Trump's hair, for example. Such features could obviously be taken into account for determining the distinctiveness of a face. Usually, people pay most attention to a person's eyes, nose, mouth, ears and hair*”<sup>2</sup>.

The Examiner took the view that for a portrait photo mark to be distinctive the representation must show special features “*as regards eyes, nose, mouth, ears or hair*” or it has to “*concern a well-known personality, in most EU Member States*”.

It is already worth stressing that in INTA's view both criteria above are too arbitrary.

As regards “special features”, this arbitrariness is evident from the fact that the Examiner agrees



that the following mark is distinctive (EUIPO First Board of Appeal, October 23, 2019, No. R 2574/2028-1; EUTM No. 017916623) for goods and services in classes 29, 33, 35 even though no special characteristics exist on the face: the man simply wears a hat<sup>3</sup>.

As regards the reputation of the person depicted in the photo, the Examiner on the one hand stated that it is required for the image to serve as a trademark<sup>4</sup>. On the other hand, the Examiner found that “*recognizing is not the same as differentiating according to commercial origin*”<sup>5</sup> thereby acknowledging that reputation is not necessary or able, as such, to affirm a commercial origin function. Moreover, the Examiner also found that the reputation of the person depicted in the photo is a factor that contributes to the mark being unregistrable for the goods/services for which the person is known: “[i]f the person depicted in question is a famous or well-known person - a film star, singer or historical figure - such a sign in connection with, say, a book, poster or cultural activity, **would not be inherently distinctive** because the relevant consumer would understand it as referring to its subject matter, namely the artist, musician, painter or philosopher in question, and not as an indicator of commercial origin”<sup>6</sup> (emphasis added).

Therefore, per the Examiner, the same factor (reputation) is, on the one hand, necessary to justify registrability as a mark and, on the other hand, a bar to registrability on the basis of descriptiveness.

The Examiner found that “[t]aken as a whole, the mark applied for consists of no more than an image (a photograph) which can be used for the presentation of the goods and services in question. This form of presentation does not differ substantially from other faithful representations of the head/face of a (young) man. The representation in question does not show any special

---

<sup>2</sup> *Ibid*, page 11.

<sup>3</sup> *Ibid*.

<sup>4</sup> “This is also immediately the crucial point. Such a ‘portrait’ must have acquired a reputation precisely in order to be seen as a trade mark. In other words, the European consumer sees in it prima facie only the image of the head/face of a (young) man, but not necessarily that of Jan Smit. People (average users) who are not familiar with Jan Smit only see the image of the head/face of a (young) man”, page 8.

<sup>5</sup>See, *Ibid*, page 11.

<sup>6</sup> *Ibid*, page 12.

*features as regards eyes, nose, mouth, ears or hair nor does it concern a well-known personality, in most EU Member States”<sup>7</sup>.*

According to the Examiner, it is therefore questionable how the face of a person can represent any goods or services whatsoever, since per common experience and according to some previous Offices’ decisions, a face image has nothing to do with the appearance of goods, is not an image of goods<sup>8</sup> and “*does not say anything about the services*”<sup>9</sup>.

In relation to the specific goods and services, the Examiner found that for goods in class 25 the mark was descriptive as denoting the category of consumers to which the **goods were intended**, namely men. In respect of magnetic data carriers, DVDs, photographs, audio recordings, printed publications etc. in class 16, the mark was deemed to provide information about the **subject of the goods/services**, namely the person on the photograph, the musician of the audio recordings etc. For class 35 and 41 services, it was deemed that **it is not unusual for** them to be offered with the image of the person providing the services, for example an artist or composer. In particular, for retail and wholesale services, the image was deemed to represent only the relevant person, category (men), singer etc. Given that there are countless photos of men’s faces in all manner of fields, the photo at issue was deemed as not capable of distinguishing the goods from those of others.

Lastly, the Examiner dismissed the claim of acquired distinctiveness, on the basis that the applicant had failed to meet the relevant burden of proof. In its reasoning the Examiner also seems to imply – and INTA agrees with this approach, as we set out below – that reputation of the person is not enough for acquired distinctiveness to be established for the mark, since what is required is systematic use of the sign as trademark not of the face of the person in non-trademark uses (e.g., catwalks by the model depicted on the mark for modelling services). In fact, any use of the person’s face by the person and any condition of such face through time (e.g. changes related to age) has no impact on the trademark, as the subject of the trademark is merely the concrete photograph and not the actual face of the person.

### C. The Appeal

The applicant appealed the Examiner’s decision before the EUIPO Board of Appeals on January 8, 2024, and written observations were subsequently filed.

By his appeal, the applicant opposed the Refusal from the Examiner mostly by legal arguments. He refers to a number of earlier rulings in which the Boards of Appeal of the EUIPO overruled the refusal of similar so called “portrait marks”, which also had been filed by the bearers of the respective faces/images.

---

<sup>7</sup> *Ibid.* p. 11.

<sup>8</sup> See, EUIPO Fourth Board of Appeal, November 16, 2017, No. R 2063/2016-4, *DEVICE (PHOTO) OF THE HEAD OF A WOMAN (fig)*, par. 36.

<sup>9</sup> See, EUIPO Fourth Board of Appeal, May 19, 2021, No. R 378/2021-4, *WEERGAVE VAN HET GEZICHT VAN EEN PERSOON (fig.)*, par. 16, concerning the portrait photo of yet another model Rozanne Verduin.

#### D. The Referral

By decision of September 26, 2024 (the “**Referral**”) the Second Board of Appeal referred the case to the GBoA on the basis of Article 162 (3) EUTMR, which provides jurisdiction for the Grand Board of Appeals in cases of (1) legal difficulty or (2) a particular importance of the case or (3) special circumstances. In particular, the BoA pointed out that “[i]t is apparent from a preliminary examination that, at first instance, the Office appears to systematically refuse registration of trade marks containing the face of a person pursuant to Article 7(1)(b) and/or Article 7(1)(c) EUTMR. In the most recent years, the Board of Appeal has ruled, by various decisions, that EU trade mark applications containing a person’s face are not inherently devoid of distinctive character. In the light of the foregoing, and with the aim of ensuring consistency and coherence within the Office with regard to the examination of EU trade mark applications for ‘personal faces’, the referral of the present case to the Grand Board is justified” (at paragraphs 25 and 26 of the Referral).

#### E. The Board of Appeals Decisions on Earlier Similar Cases<sup>10</sup>

As stressed in the Referral, the Examiner’s findings are not in line with the BoA’s earlier case-law on the matter.

In particular, in many BoA precedents – reversing previous decisions which were in line with the Refusal – the relevant marks were deemed registrable, on the basis that “*the sign in question is, however, clearly and without any doubt the image of a specific individual, with her unique facial features, and takes the form of a passport photo*”<sup>10</sup>, pointing out that “*it cannot be assumed that, from the point of view of the relevant public, there would be a direct and specific relationship between the sign and the goods and services in question in accordance with Article 7(1)(c) EUTMR*”<sup>11</sup>.

As regards the description of the intended consumers of the goods, the Board has previously established – again by reversing previous decisions in line with the Refusal – that seeing an image of a woman will not necessarily lead one to conclude that the goods in classes 3, 14, 18 and 25 are intended for women. Furthermore, although it is common for famous people to advertise these kinds of goods, the public does not believe that the goods emanate from these people.

As regards goods in class 16 (e.g. concerning the person on the customer card or ID) the Board has previously held that such goods are not sold with a photo of a person already on them.

---

<sup>10</sup> This decision was preceded by a number of BoA decisions on the matter, in which the examiners took similar views to those of the Examiner in the case at hand: EUIPO Fourth Board of Appeal, November 16, 2017, No. R 2063/2016-4, *DEVICE (PHOTO) OF THE HEAD OF A WOMAN (fig)*; EUIPO Fourth Board of Appeal, May 19, 2021, No. R 378/2021-4, *WEERGAVE VAN HET GEZICHT VAN EEN PERSOON (fig.)*; EUIPO Fourth Board of Appeal, May 19, 2021, No. R 468/2021-4, *WEERGAVE VAN HET GEZICHT VAN EEN PERSOON (fig.)*; EUIPO First Board of Appeal, October 23, 2019, No. R 2574/2018-1, *FOTOGRAFÍA EN COLOR DEL ROSTRO DE UNA PERSONA (fig.)*; EUIPO Fourth Board of Appeal, October 30, 2023, No. R 1255/2023-4, *WEERGAVE VAN HET GEZICHT VAN EEN PERSOON (fig.)*; EUIPO Fourth Board of Appeal, October 30, 2023, No. R 1266/2023-4, *WEERGAVE VAN HET GEZICHT VAN EEN PERSOON (fig.)*; EUIPO Fourth Board of Appeal, January 30, 2024, No. R 2173/2023-4, *WEERGAVE VAN HET GEZICHT VAN EEN PERSOON (fig.)*.

<sup>11</sup> EUIPO Fourth Board of Appeal, November 16, 2017, No. R 2063/2016-4, *DEVICE (PHOTO) OF THE HEAD OF A WOMAN (fig)*, paragraphs 19 and 16.

Contrary to the Examiners' finding in this case that the image would represent the person providing services in classes 41 and 42 (e.g. the photo of a model filed for modeling services), the Board has previously established that this would indicate precisely that the image can be perceived as a way of distinguishing those goods and services based on their commercial origin, namely that they originate from the person depicted, thereby fulfilling the essential function of a trademark<sup>12</sup>.

Furthermore, contrary to the Examiners' finding in this case that images of faces would be commonplace and, as such, non-distinctive, the BoA has previously established that the ability of a portrait image to act as a commercial source identifier "[...] is not affected by the fact that many other faithful images of faces are conceivable from women and men. Each of these will be a unique representation of that specific person, with his or her own specific appearance. The existence of double keepers and identical multiple births can be disregarded in this context as extraordinary and exceptional. Moreover, that argument could also, wrongly, be raised against any other type of trade mark; how many words, patterns, images of animals, etc. do not exist?"<sup>13</sup>.

Lastly, as regards the Examiner's finding whereby it is not unusual for the services applied for in classes 35 and 41 to be offered with the representation of the person providing the services, in its previous decisions the BoA has pointed out that these circumstances would not call into question the conclusion that the mark applied for has distinctive character, while this issue in reality concerns genericness of the mark under Article 7(1)(d) EUTMR, namely a different ground, whereas the mark at hand concerns a concrete and specific image of the person<sup>14</sup>.

It is already worth stressing that INTA agrees with the lines of reasoning followed by the BoA in its previous decisions involving the protection of marks depicting people's faces.

### III. INTA's Position

#### A. Preliminary Remarks

An article from a Hungarian Scholar just recently published on the subject matter of portrait marks notes a rising number of successful applications for the registration of portrait marks in recent years which are mostly of Dutch origin. It lists a total number of 57 male portrait marks and 23 female portrait marks currently under protection as EUTMs.<sup>15</sup>

The article quotes a judgment from the 6<sup>th</sup> Circuit of the Court of Appeals of the United States of America concerning unregistered rights protected under Section 43(a) of the Lanham Act<sup>16</sup>, where the Court found that the plaintiff claims against the unauthorized use of the likeness of Tiger Woods in a painting were made in relation to all images of a person and not to a particular photograph,

---

<sup>12</sup> For all the above see *Ibid*, paragraphs 20-25.

<sup>13</sup> EUIPO Fourth Board of Appeal, May 19, 2021, No. R 378/2021-4, *WEERGAVE VAN HET GEZICHT VAN EEN PERSOON (fig.)*, paragraph 18.

<sup>14</sup> *Ibid*, paragraph 20.

<sup>15</sup> See BARNÁRNOLD KESERŐ, *Trademark protection for Faces? – A comprehensive analysis on the benefits and drawbacks of trademarks and the right to facial images*, Journal of Intellectual Property, Information Technology and Electronic Commerce Law (jipitec), 2024, page 88 *et seq.*

<sup>16</sup> Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a), provides "a right of action to persons engaged in interstate and foreign commerce, against deceptive and misleading use of words, names, symbols, or devices, or any combination thereof, which have been adopted by a . merchant to identify his goods and distinguish them from those manufactured by others[.]".



and, therefore, stated that such general claims on a person's image cannot be accepted as this would lead to a person being regarded as a "walking talking trademark".<sup>17</sup>

In Germany the face of the famous late actress Marlene Dietrich is registered as a trademark under No. DE3915127386, while the German Federal Supreme Court had discussed and in principle accepted the registrability of a portrait photograph in general, which was later confirmed by the German Federal Patent Court.<sup>18</sup>



The German Federal Supreme Court confirmed that the sign applied for is capable of being a trademark in the abstract, *i.e.* without reference to the goods and services applied for, similarly as a name can function as a trademark, as expressly mentioned in the law<sup>19</sup>.

Also, the Court confirmed that, as regards signs that are excluded from registration because they consist exclusively of shapes or other characteristics which result from the nature of the goods themselves [Article 3(2)(1) of German Trademark Law], the mark at hand did not consist of such a sign even for goods like photographs, posters, placards, picture cards: the mark did not show any of the named goods in a form determined by their nature. This did not change from the fact that the image at hand could be used (also) in a way, for example, of a poster, placard or picture card which consists, on one side only, of the portrait of Marlene Dietrich<sup>20</sup>.

The Court also found that in examining inherent distinctiveness, the existing trade practices in the relevant sector and – if the sign applied for or a similar sign is already in use – the labeling habits and the actual perception of the targeted public must be taken into account<sup>21</sup>. The perception of the public as to whether a sign is understood in an individual case as an indication of the commercial origin of the goods or services concerned may also be influenced by the fact that marks are usually affixed to the goods or services concerned in certain positions<sup>22</sup> where there are usually (also) means of identification, or the use on tags, patches and the like, as well as on the packaging<sup>23</sup>.

---

<sup>17</sup> ETW Corp. v. Jireh Publ'g., Inc. 332F.3d 915 (6th Cir. 2003).

<sup>18</sup> See Bundesgerichtshof, ruling of April 24, 2008 (I ZB 21/06), *Marlene Dietrich Bildnis I*; Bundespatentgericht, decision of October 6, 2010 (29 W (pat) 147/03) and Bundesgerichtshof, ruling of March 31, 2010 (I ZB 62/09), *Marlene Dietrich Bildnis II*.

<sup>19</sup> Bundesgerichtshof, ruling of April 24, 2008 (I ZB 21/06), *Marlene Dietrich Bildnis I*, paragraph 10.

<sup>20</sup> *Ibid*, paragraph 11.

<sup>21</sup> Bundesgerichtshof, ruling of March 31, 2010 (I ZB 62/09), *Marlene Dietrich Bildnis II*, paragraph (b).

<sup>22</sup> *Ibid*.

<sup>23</sup> *Ibid*, paragraph 25.

## B. The Issues Before the GBoA

In essence, the question before the Grand Board of Appeal is whether photorealistic facial images (i) qualify as “signs” in the sense of Article 4 EUTMR (although the Referral does not specifically mention this provision, we believe that this is the necessary starting point of our analysis); (ii) if this question is answered in the affirmative, whether/to what extent the fact that a sign consists of a photorealistic facial image of a person may impair its distinctive character under Article 7(1)(b) EUTMR and/or Article 7(1)(c) EUTMR, as well as under Article 7(3) EUTMR.

The first clarification to be made is whether photographic images and drawings are to be treated differently. The EUIPO BoA and the General Court have confirmed that both these manners of depiction are to be treated **in the same way**: “*even a (full or at least largely) true-to-life, **graphic or photographic** reproduction, [...] may in principle be capable of individualizing the product in terms of its origin*” (EUIPO Third Board of Appeal, November 25, 1999, No. R 75/1999-3, *red-white squared washing tablet (fig.)*, paragraph 20, emphasis added). Similarly, the General Court has further confirmed that “*it cannot be immediately denied that a **graphic or photographic** representation, even one faithful to reality, has distinctive character for the purposes of Article 7(1)(b) EUTMR*”, even if this representation is of the product itself [see, for example, GCEU, September 19, 2001, T-30/00, *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, EU:T:2001:223, paragraph 45].

With the above in mind let’s move to the main issues arising from the case at stake.

### **a) Quality of a “sign” – Article 4 EUTMR**

The first issue to address is whether faces (either in the form of photo or drawing) may be considered as a sign of which an EUTM may consist of.

According to Article 4 EUTMR, an EUTM may consist of “any signs” to the extent they are able to distinguish the goods or services of one undertaking from those of other undertakings.

INTA notes that since 2015 the EUIPO BoA has held that representations of human beings are not precluded from being perceived as distinctive signs<sup>24</sup>.

The argument of the Examiner, that the image of the face of the applicant is not capable of distinguishing goods and services in general, has been brought forward also in earlier Board of Appeal case No. R 2063/2016-4 concerning the image of the face of the Dutch model Maartje Robin Elke Verhoef<sup>25</sup>. In this decision, the Fourth Board of Appeal concluded that the following

---

<sup>24</sup> EUIPO Fifth Board of Appeal, September 1, 2015, No. R 2993/2014-5, *Device of a Square with Four Pictures (Fig. Mark)*, par. 15.

<sup>25</sup> This decision was followed by a number of similar decisions [EUIPO Fourth Board of Appeal, May 19, 2021, No. R 378/2021-4, *WEERGAVE VAN HET GEZICHT VAN EEN PERSOON (fig.)*; EUIPO Fourth Board of Appeal, May 19, 2021, No. R 468/2021-4, *WEERGAVE VAN HET GEZICHT VAN EEN PERSOON (fig.)*; EUIPO First Board of Appeal, October 23, 2019, No. R 2574/2018-1, *FOTOGRAFÍA EN COLOR DEL ROSTRO DE UNA PERSONA (fig.)*; EUIPO Fourth Board of Appeal, October 30, 2023, No. R 1255/2023-4, *WEERGAVE VAN HET GEZICHT VAN EEN PERSOON (fig.)*; EUIPO Fourth Board of Appeal, October 30, 2023, No. R 1266/2023-4, *WEERGAVE VAN HET GEZICHT VAN EEN PERSOON (fig.)*; EUIPO Fourth Board of Appeal, January 30, 2024, No. R 2173/2023-4, *WEERGAVE VAN HET GEZICHT VAN EEN PERSOON (fig.)*].

portrait is capable of fulfilling the essential function of a trademark, namely distinguishing the goods and services in respect of which registration is sought from those of a different origin:



For what it is worth, it appears that this argument has also been relevant for the conclusions of the 6th Circuit in the Tiger Woods case quoted above, which however was not about the registration of a portrait mark, but rather an issue of a violation of the rights of a well-known person on the basis of alleged unregistered rights on the general likeness and not a particular image.

INTA takes the view that this approach, in the legal framework of EUMTR, though quoted in relation to Article 7(1)(b), would instead apply to Article 7(1)(a) in relation to Article 4(a) EUTMR. Images of the faces of human beings are capable of distinguishing individuals. Therefore, the question to answer here is whether this quality is so dominant that any addressed public will always take the image of a face as an identifier of a human being and not of the trade origin of goods and services.

With a slightly different connotation, there are also doubts if the image of a face can ever be attributed to a commercial undertaking and thus serve as a “sign” in the course of trade.<sup>26</sup>

In that regard, INTA takes the view that **the image of a face of a human being may well serve as a means to distinguish goods and services** if (i) it is used in the course of trade in relation to goods or services, (ii) it is used in a consistent format and appearance; (iii) it is used in a manner (e.g. on a specific position of the goods) which the addressed public already knows and perceives as typical for trademarks, and (iv) either the public is **accustomed** in the specific market to such portraits being used as trademarks or the portrait has **special characteristics** which make it different from a “normal” portrait. “Capability” in Article 4(a) EUTMR addresses **a potential** and not a given capacity.

There are at least the following points to be considered in relation to whether the portrait of a person can be a trademark:

- any face somewhat differs from other faces (except in the case of identical twins);

---

<sup>26</sup> See Opinion of Judge Graham in the Tiger Woods case: “Here, ETW claims protection under the Lanham Act for any and all images of Tiger Woods.<sup>5</sup> This is an untenable claim. ETW asks us, in effect, to constitute Woods himself as a walking, talking trademark. Images and likenesses of Woods are not protectable as a trademark because they do not perform the trademark function of designation. They do not distinguish and identify the source of goods. They cannot function as a trademark because there are undoubtedly thousands of images and likenesses of Woods taken by countless photographers, and drawn, sketched, or painted by numerous artists, which have been published in many forms of media, and sold and distributed throughout the world. No reasonable person could believe that merely because these photographs or paintings contain Woods’s likeness or image, they all originated with Woods. [...] Here, ETW does not claim that a particular photograph of Woods has been consistently used on specific goods.<sup>6</sup> Instead, ETW’s claim is [...] a sweeping claim to trademark rights in every photograph and image of Woods”.

- human beings are well trained to take faces as identifiers of individuals;
- although average consumers may normally perceive the portrait of a person as the portrait of a person and not as a trademark, they may nonetheless become trained to and actually do perceive faces as source identifiers for goods and services like in the following examples:<sup>27</sup>



From the above it follows that at least in the food/restaurant sector, as an example, consumers are accustomed to perceiving faces as an indication of trade origin. Furthermore, in the context of assessing the habits of the relevant consumers which might have an impact on the way they perceive a relevant sign, the usual modes of sale of the goods/services in question must also be taken into account [GCEU, March 5, 2003, T-194/01, *Unilever v OHIM (Tablette ovoïde)*, EU:T:2003:53];

- the subject matter of trademark protection would be not the face of a person or his/her likeness in general but a particular photograph of the same. In other words, we are talking of a sign consisting of an image, which might happen to be a portrait of a living person, but whose protection would be unrelated to the characteristics/fame of the relevant human being;
- in particular, human beings are experienced at seeing faces which display different expressions at different times and on different occasions. The image of a face, however, once taken and then reproduced, is stable and steady. As a consequence, the public experience with the encounter of real faces of living individuals and images is always different as fixed images lack the characteristic of constant changes. In that regard, images

<sup>27</sup> This is proven for stylized faces like that of Colonel Sanders for fast food (EUTM No. 012510376) or that of Paul Newman for salsa (USTM No. 3145005), Wendy's for fast food restaurant (registered along with the word Wendy's USTM No. 85789070), Uncle Ben's rice (EUTMs No. 000002337 and No. 010849032) and Quaker Oats (EUTM No. 016704835).

of faces at least are aligned to trademarks which – because of the use requirement – are also reproduced and fixed in a single specific reproduction.

- trademark law requires trademark holders to make use of their marks as signs in the course of trade.<sup>28</sup> As a consequence, any examiner, having to assess the capability of the image of a face to fulfil the function of a trade mark, should examine whether the concrete trademark applied for in the context of the market of the goods and services applied for and the consumer habits as well as the manner in which trademarks are used in the respective market, is capable of being regarded as a trademark by the average consumer or, alternatively, whether special characteristics which make it different from a “normal” portrait make it likely that the applied for mark will function as a trademark. The legal issues at stake here are, therefore, similar to those posed by the protection of person names as trademarks, as they both in their natural function identify individuals. In that regard, INTA, in its brief in the George Orwell case<sup>29</sup> has taken the clear position that names are not a category of signs which are distinct from others:

*The criteria for assessing the distinctive character of signs consisting of names or famous names, such as the one at issue, shall be no different from those to be applied to other categories of trademarks (CJEU, September 16, 2004, C-404/02, Nichols plc v. Registrar of Trade Marks, EU:C:2004:538, paragraph 24, Joined Cases C-53/01 to C-55/01 Linde and Others par. 42 and by analogy CJEU Case C-299/99, Koninklijke Philips Electronics NV v. Remington Consumer Products Ltd, par. 48).*

There are also conclusions to be drawn from the case-law on colors and other non-traditional marks. Difficulties in establishing distinctiveness which may be associated with certain categories of trademarks because of their very nature, e.g. when the average consumers are not in the habit of making assumptions about the origin of products on the basis of such marks, do not justify laying down specific criteria supplementing or derogating from the standard criteria of distinctiveness (see CJEU, October 21, 2004, C-64/02 P, *OHIM v. Erpo Möbelwerk GmbH*, EU:C:2004:645).

The capacity of a photograph of a human face to constitute a sign capable of distinguishing goods or services in the sense of Article 4(a) EUTMR has support in CJEU's case-law on items that are not primarily perceived as signs. In CJEU, May 6, 2003, C-104/01, *Libertel Groep BV v Benelux-Merkenbureau*, EU:C:2003:244, the Court of Justice held that, although a color *per se* cannot be presumed to constitute a sign as it is a simple property of things, yet it may constitute a sign depending on the context in which the color is used (paragraph 27 of the judgment). At paragraphs 39-42 of the same judgment, the Court further elaborates on the topic and concludes that the possibility that a color *per se* may in some circumstances serve as a badge of origin of the goods or services of an undertaking cannot be ruled out.

Again, in CJEU, June 24, 2004, C-49/02, *Heidelberger Bauchemie GmbH*, EU:C:2004:384, the Court of Justice reaffirms that colors or combinations of colors may be capable, when used in relation to a product or a service, of being a sign, which depends on the context in which they are used (see paragraphs 22-24 and paragraphs 37-40). Case CJEU, July 10, 2014, C-421/13, *Apple*

---

<sup>28</sup> See CJEU, September 13, 2007, C-234/06 P, *Il Ponte Finanziaria*, EU:C:2007:514, paragraph 72.

<sup>29</sup> EUIPO Fifth Board of Appeal, July 2, 2020, No. R 2248/2019-5, *George Orwell*.

*Inc. v Deutsches Patent- und Markenamt*, EU:C:2014:2070, also bears similarities with the question at issue; in paragraph 20 of this judgment the Court observes that it cannot be ruled out that the layout of a retail outlet depicted by such a sign may allow the products or the services for which registration is sought to be identified as originating from a particular undertaking. This could be the case when the depicted layout departs significantly from the norm or customs of the economic sector concerned.

The standards set by the cited case-law may apply to the question at issue. Similarly, likeness is a human property referring to the unique visual appearance or characteristics of a person. As such, it is not a sign. Yet, it may constitute a sign serving as a badge of trade origin of the goods and services of an undertaking depending on the context in which it is used.

Considering that the subject of EUTM No. 014711907 is a particular image of a person, not his likeness in any possible form (as in the Tiger Woods case), the application also meets the requirement of Article 4(b) EUTMR for clarity and precision of the representation.

### **b) Inherent Distinctiveness – Article 7(1)(b) EUTMR**

With regard to Article (7)(1)(b) EUTMR, the mark in question must enable the public to distinguish the goods and services concerned from those of other undertakings or persons, while “*the finding that a mark has distinctive character within the meaning of Article 7(1)(b) of Regulation No 207/2009 is not subject to a finding of a specific level of linguistic or artistic creativity or imaginativeness on the part of the proprietor of the trade mark*”.<sup>30</sup> It follows from the reasons discussed above with respect to Article 4(a) EUTMR, that the image of a human face has, at least, the potential to distinguish goods and services.

INTA shares the approach of the Fourth Board of Appeal in the earlier case of the registration of the image of Maartje Robin Elke Verhoef whereby:

*“After all, a photo is always a ‘realistic representation’ of what is depicted, although that does not mean that that representation cannot be perceived as a trade mark, especially if **it has nothing to do with the appearance of the goods in question and is therefore not an image of the goods**, or, in other words, does not consist of a sign that depends on the appearance of the designated goods (emphasis added).*

*A photo of a person’s face, in the form of a passport photo, is a unique representation of that person, including his/her specific external features. Besides elements including a person’s first name and last name, a depiction of a person’s face in the form of a passport photo serves to identify that person and therefore to distinguish him/her from others. In the Board’s opinion, the image at issue is therefore capable of fulfilling the essential function of a trade mark, namely distinguishing the goods and services in respect of which registration is sought from those with a different origin”.*<sup>31</sup>

---

<sup>30</sup> See, GCEU, July 4, 2017, T-81/16, *Pirelli Tyre v EUIPO*, EU:T:2017:463, paragraph 49.

<sup>31</sup> See, EUIPO Fourth Board of Appeal, November 16, 2017, No. R 2063/2016-4, *DEVICE (PHOTO) OF THE HEAD OF A WOMAN (fig)*, paragraphs 36 and 37.

In that regard, INTA also takes the view that the above approach is not called into question by the fact that individuals or the faces of individuals are commonplace in advertising to identify the addressed public or to illustrate goods or services in use. This argument of the Examiner concerns advertisements in which individuals or the faces of individuals stand for the targeted public and are depicted in a neutral manner *i.e.* as exchangeable individuals. This method of communication can easily be distinguished from depicting a certain individual, even if the individual is unknown.



Indeed, as per CJEU case-law, if the public (also) perceives the sign as an indication of origin for the goods or services in question, distinctive character cannot be denied because it is simultaneously or even primarily perceived as *e.g.* an advertising medium (see CJEU, April 29, 2004, joined cases C-473/01 P and C-474/01 P, *Procter & Gamble v OHIM*, EU:C:2004:260, paragraph 36) or a portrait photograph. Furthermore, evidence based on the actual perception of the mark by consumers may, in certain cases, provide guidance, if the sign applied for or similar signs are already used in trade (see CJEU, October 7, 2004, C-136/02 P, *Mag Instrument Inc. v. EUIPO*, EU:C:2004:592, paragraph 49).

However, even if such practice cannot be established, this alone is not sufficient to deny the suitability of the sign applied for to be understood by the public as an indication of origin. Rather, an assessment based on general principles of experience and the established facts on the same or similar marks is required as to how the sign applied for will presumably be perceived by the relevant public when it is put to use to identify the goods or services concerned<sup>32</sup>. The assumption of distinctiveness does not require that every conceivable use of the sign must be trademark use<sup>33</sup>.

It follows that, establishing whether a portrait of a person, in the form of either a photo or drawing, is distinctive under Article 7(1)(b) EUTMR requires a **complex assessment**, which must be carried out by considering various factors and all the peculiarities of the case, always taking into consideration that the public perception may vary over time.

In light of the above, in INTA's view the mere fact that a sign for which a portrait trademark application has been filed consists of a photorealistic facial image of a person – including a famous one – is certainly not sufficient to conclude that said sign lacks distinctive character. What is important is to assess, on a case-by-case basis, whether the specific portrait applied for, which

<sup>32</sup> See Bundesgerichtshof, ruling of March 31, 2010 (I ZB 62/09), *Marlene Dietrich Bildnis II*, paragraph 19.

<sup>33</sup> *Ibid*, paragraph 21.

has its **own peculiarities and is independent of the person portrayed**, may identify the concerned goods/services as emanating from a single source and therefore function as trademark.

### **c) Descriptiveness – Article 7(1)(c) EUTMR**

The signs and indications to be refused under Article 7(1)(c) EUTMR are only those which may serve to designate the goods or services applied for or their characteristics, such as, kind, quality, quantity, intended purposes, value, geographical origin or time of production of the goods or rendering of the service.

It is settled case-law that descriptiveness of a sign must be assessed by reference, first, to the goods or services in respect of which the registration is sought and, second, to the relevant public's perception of that sign (see CJEU, April 29, 2004, joined cases C-468/01 P and C-472/01 P, *Procter & Gamble*, EU:C:2004:259, paragraph 33; CJEU May 08, 2008, C-304/06 P, *Eurohypo*, EU:C:2008:261, paragraph 67; and CJEU, January 21, 2010, C-398/08 P, *Audi*, EU:C:2010:29, paragraph 34). The relevant point in time to make this assessment is the date of filing of the trademark application (see GCEU, June 17, 2009, T-189/07, *Frosch Touristik GmbH v OHIM*, EU:T:2009:172).

For a sign to fall within the scope of the prohibition in that provision, it must suggest a sufficiently direct and concrete link to the goods or services in question to enable the public concerned immediately, and without further thought, to perceive a description of the goods and services in question or of one of their characteristics (GCEU, February 27, 2002, T-106/00, *Streamserve v OHIM*, EU:T:2002:43, paragraph 40, upheld on appeal by CJEU's order of 5 February 2004, C-150/02 P, *Streamserve v OHIM*, EU:C:2004:75).

According to the Examiner, the mark at issue would be descriptive either because it would represent the category for whom the goods/services are intended (namely men), or because it would be perceived as providing information on the content or the subject matter of the concerned goods and services because of the fame of the applicant (the applicant here is known as a singer and the addressed public may well take the image of his face as an indication for records of his songs or performances).

On the one hand, with respect to the category argument, as mentioned above, INTA agrees with the BoA's position set forth in case No. R 2063/2016-4 – concerning the image of the face of the Dutch model Maartje Robin Elke Verhoef – whereby it is not obvious that, on seeing the photo of the depicted woman, the relevant public would make a direct connection with the target customers of the goods and services, pointing out that “[a]fter all, it is a fact that 100 % of all possible goods and services are intended for either a female or a male public, and seeing an image of a specific woman will not necessarily lead one to conclude immediately that” the relevant goods/services are intended for women, “[a] huge number of female fashion designers release men's collections under their names (e.g. Carolina Herrera or Purificación García) and the public will naturally not assume that a mark consisting of a woman's name necessarily protects goods intended for women. The same can be said of male fashion designers who also bring out collections for both target groups (e.g. Giorgio Armani and Ralph Lauren)” (see, to that effect, paragraph 21).

On the other hand, INTA takes the view that the Examiner's argument that the mark applied for would be inherently descriptive for certain goods/services because it depicts the face of a famous individual and, as such, would automatically provide information on the content or the subject



matter is not convincing. Indeed, in most cases, signs providing information on the content or the subject matter of the concerned goods and services are, at the very most, merely evocative; and, as known, a “*sign is not caught by the prohibition set out in [Article 7(1)(c) EUTMR] if it is purely allusive, suggestive, or evocative of specific characteristics*” (see VON BOMHARD – VON MÜHLENDAHL, *Concise European Trademark Law*, 2018, page 65). In this regard it is worth mentioning that it is not unlikely that the mark at issue might be used in connection with content unrelated to the applicant (for instance, in the case at issue, the applicant may use the mark applied for in connection with a collection of movies by young European directors or the like) and, in any case, the applicant would not be able to maintain his registration by using the mark in connection with his own content, as this use would be descriptive and, as such, would not amount to “genuine use”.

To support his conclusion based on the subject matter criterion, the Examiner relies on the German Federal Court in the Marlene Dietrich case, which found that books, data carriers, photographs, entertainment and cultural activities can relate thematically to the work and life of the person Marlene Dietrich<sup>34</sup>. In this regard, INTA notes that the finding of the German Court was based on the assumption that the mark would be used on all such items (e.g. entertainment) that would relate to Marlene Dietrich and had dismissed the argument that – under the specific circumstances of the case – these goods under this mark could also relate to other persons, e.g. other actors, as being contrary to experience and practice.

However, it is important to take into consideration that different circumstances may determine different outcomes. It is therefore important to always carry out a case-by-case assessment valuing all the circumstances of the case. For instance, regardless of the fame of the person depicted, the placement of the sign at hand in the usual labelling position of trademarks on the respective goods, e.g. in small size at the bottom of a CD cover, while the rest of the cover depicts the same or another performer, suggests that the consumers will make the distinction and understand that the sign at hand denotes the trade origin and not the performer. Similarly, the positioning of the drawing of the penguin drawing logo at the bottom of a book cover of Penguin Editions, for example, would not lead consumers to believe that the book is about penguins.

Any person and any object, any meaningful word, may constitute the subject matter of a book/film and so on, and therefore a book could be “about” any possible subject matter described by the meaningful word, thereby potentially excluding anything and everything as descriptive. Famous persons’ faces are not, because of their fame, directly descriptive of any goods or services. Similarly, non-famous persons’ faces are not *per se* descriptive of any goods or services. Furthermore, if reputation was a factor considered as excluding trademark protection, it should be excluding it for all categories of marks. This would lead to the paradox of having any famous mark being ineligible for trademark protection because of their fame: COCA COLA marks are linked in the mind of consumers worldwide to soft drinks. This link and reputation alone does not prohibit registration of new COCA COLA trademarks. As the EUIPO Guidelines confirm “*Article 7(1)(c) EUTMR does not apply to those terms that are only suggestive or allusive as regards certain characteristics of the goods and/or services [...] (31/01/2001, T 135/99, Cine Action, EU:T:2001:30, § 29)*”, the consumers must be able to discern immediately and without further reflection the description of one of their characteristics, in order for the sign to be descriptive.

---

<sup>34</sup> Bundesgerichtshof, ruling of April 24, 2008 (I ZB 21/06), *Marlene Dietrich Bildnis I*.

It follows that, establishing whether a sign is descriptive under Article 7(1)(c) EUTMR requires a **complex assessment**, which must be carried out by assessing various factors and all circumstances of the case, always taking into consideration that the public perception may vary over time, also in light of the market practice of the relevant sector.

Considering the above, in INTA's view the mere fact that a sign for which a portrait trademark application has been filed consists of a photorealistic facial image of a person – including a famous one – is certainly not sufficient to conclude that said sign will undoubtedly be perceived by the relevant public as descriptive of the concerned goods/services. To make this assessment it is necessary to take into consideration all the circumstances of the case, which may affect public perception.

#### **d) Acquired distinctiveness through use – Article 7(3) EUTMR**

According to Article 7(3) EUTMR a trademark may still be registered despite the fact that it does not comply with Article 7(1)(b) and (c) EUTMR, provided that it “*has become distinctive in relation to the goods or services for which registration is requested in consequence of the use which has been made of it*”.

Article 7(3) EUTMR constitutes an exception to the rule laid down in Article 7(1)(b), (c) or (d) EUTMR whereby registration must be refused for trademarks that are *per se* devoid of any distinctive character, for descriptive marks, and for marks that consist exclusively of indications that have become customary in the current language or in the *bona fide* and established practices of the trade.

Distinctive character acquired through use means that, although the sign lacks inherent distinctiveness *ab initio* with regard to the goods and services claimed, at least a significant proportion of the relevant public has, owing to the use made of it on the market, come to see it as identifying the goods and services claimed in the EUTM application as originating from a particular undertaking. Thus, the sign has become capable of distinguishing those goods and services from those of other undertakings because they are perceived as originating from a particular undertaking. In this way, a sign originally unable to be registered under Article 7(1)(b) and (c) EUTMR can acquire new significance, and its connotation, no longer purely descriptive or non-distinctive, allows it to overcome those absolute grounds for refusal of registration as a trademark.

Based on the Referral, INTA understands that the applicant mainly relies on the fame of the depicted person to try and substantiate his claim of acquired distinctiveness. In this regard, INTA submits that reputation of the person is not enough to establish acquired distinctiveness, since what is required is a systematic use of the sign as a trademark and not of the face of the person in non-trademark uses (e.g. catwalks by the model depicted on the mark for modelling services). In fact, any use of the person's face by the person and any condition of such face through time (e.g. changes related to age) has no impact on the trademark. This is because, as mentioned above, the subject matter of trademark protection here would not be the face/likeness of a person in general but the **concrete photograph** of the same.

### **e) Moral Concerns**

The acceptance of portrait marks raises philosophic and moral concerns as they may collide with personality rights.<sup>35</sup> First of all, one may have doubts as to the level of protection in a technical sense because EUTMs are protected at an EU-wide level while personality rights are protected at a local level as they are not harmonized in the EU. Personality rights, however, appear to be protected in almost all Member States in the EU under national laws. Further, personality rights are an emanation of the right to Integrity and Life, protected under Article 3 of the Charter of Human Rights in the EU.<sup>36</sup> It follows from Article 51 of that Charter and from the jurisprudence of the CJEU that all member states and all their governmental or administrative bodies have to respect and apply the EU Charter of Human Rights in their application of national laws.<sup>37</sup> Against this background there is little fear that in the case of a conflict, any individual would be able to invoke his or her personality rights in the case of an abuse in the field of trademark law, e.g. against unauthorized trademark applications of that individual's image.

Further, there is also the general rule stipulated in Article 4 of the Universal Declaration of Human Rights, that no person should be regarded as the property of others. INTA, however, does not believe that the mere possibility of registering portrait trademarks opens a door to modern economic slavery. Although there is a risk of abuse, one may note firstly, that such risk is not captured under the list of absolute grounds in Article 7(1) EUTMR. Secondly, one may well assume that in the case of an abuse, local protection of personality rights would come into play and would be enforced effectively in each member state of the EU. Finally, the EUIPO might also be able to invoke Article 7(1)(f) EUTMR, which provides that trademarks which are contrary to public policy or to accepted principles of morality, shall not be registered, in the case of an applicant seeking to register the image of a face of a third person without being able to demonstrate his or her consent. Furthermore, in case of an application by a third unauthorized party, Article 7(1)(g) EUTMR could come into play, which forbids the registration of trademarks which are of such a nature as to deceive the public. This scenario, however, is not the case here, as the applicant and the person in the photo are the same.

However, INTA considers it worth noting that in other jurisdictions, e.g. the U.S.A. and Canada, trademark law does not allow the registration of images of faces of living individuals without a declaration of consent of the respective individual. Such a practice could be adopted by the EUIPO as well.

### **f) Assessment of Similarity**

To the extent a photo portrait is a sign capable of trademark registration, distinctive and non-descriptive, it shall be registered and enforced against future applications/uses in the course of

---

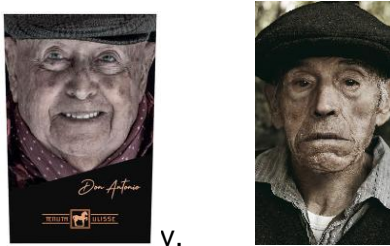
<sup>35</sup> See *Keserű*, *ibid* under C I.

<sup>36</sup> OJ, C 202 of June 7, 2016, p. 389–405J.

<sup>37</sup> CJEU, February 26, 2013, C-617/10, *Åklagaren v Hans Åkerberg Fransson*, EU:C:2013:105, paragraphs 24-27, 31.

trade that are infringing, namely of similar signs by third parties filed as a trademark or used for similar goods/services (or in case of reputation of the prior mark, also dissimilar goods/services).

The Fifth BoA has already given an example of such assessment, comparing two photograph faces of unknown old men, for wines, in case R 10/2023-5, *Don Antonio TENUTA ULISSE (fig.) / A photographic portrait of an old man (fig.)*:



*“29 The earlier mark shows a close-up portrait of an elderly man with prominent facial features. He has deep-set eyes with heavy, slightly drooping eyelids, and his gaze is direct and intense. The man's skin bears deep wrinkles and lines. His lips are closed, set in a serious expression, as correctly observed in the contested decision. He is wearing a dark-coloured flat cap on his head, which adds to the rustic character of his appearance. The collar of a white shirt peeks out from under a worn, unbuttoned jacket with a coarse texture, indicating a casual or work-related outfit. The background is indistinct, providing a neutral backdrop that focuses on the man's face. The overall tone of the image is dominated by sepia or earthy colours.*

*30 The contested mark shows an elderly gentleman with a joyous expression on his face. He has an open, genuine smile that reveals his teeth, and his eyes are crinkled with deep laugh lines. His skin bears wrinkles, which characterise advanced age. He is wearing a dark-coloured beret-style cap, and a scarf around his neck with a visible pattern on a pinkish background. Below the portrait, there's a signature-like text in light yellow that reads 'Don Antonio'. At the bottom of the sign, the words 'TENUTA ULISSE' are written in regular upper-case gold letters, which are spaced out with a gold horse silhouette in between, all framed by thin gold lines”.*

This example shows that even in the case of photorealistic portraits the comparison of the signs is possible and not all portrait photos are the same.

## CONCLUSION

In view of the above, INTA recommends that the Grand Board of Appeal confirms that the application for registration of the image of a face does not *per se* raise concerns with regard to the capability of distinguishing goods and services in general or distinctiveness or descriptiveness, or to conflicts with personality rights.

Indeed, signs consisting of photorealistic facial images of people, including famous ones, are **not *per se* excluded from trademark protection**.

The fact that a sign is a portrait of a person – even a famous one – is not *per se* sufficient to establish that the same falls within the absolute grounds of refusal set forth in Article 7(1)(b) and (c) EUTMR. Indeed, establishing whether a sign falls within any of the absolute grounds of refusal

set forth in Article 7(1)(b) and (c) EUTMR is a **complex assessment**, which must be carried out by considering various factors and all the circumstances of the case, taking into consideration that the **perception of the public may vary over time also in light of the market practices** of the relevant sector.

In particular, in the assessment of the inherent distinctiveness/descriptiveness of signs consisting of photorealistic facial images of people, it is important to keep in mind that the **subject matter of trademark protection** would not be the face of a person or his/her likeness in general, but only a particular photograph of that person. Basically, **a mark consisting of the photorealistic facial image of a person would have a life independent of the person depicted**, no different from what happens to marks consisting of the drawing of faces. In this last regard, let us think for instance of the famous Kentucky Fried Chicken's logo, depicting the face of Colonel Harland David Sanders who is the founder of the fast-food chain:



It follows that physical features – such as, for instance, possible changes in the person's face over his/her life – and/or other characteristics – such as his/her fame – would not necessarily have an impact on the relevant mark. However, it might also be that the reputation of the applicant/face in the photo helps the relevant public to better perceive his face in the context of a commercial communication as a source identifier for the origin of the respective goods and services. This has to be assessed thoroughly in the process of examination and cannot be taken as an a-priori-guidance.

INTA may concur with the idea – seemingly underlying the Examiner's decision – that, especially in some sectors, consumers may not be in the habit of perceiving photorealistic facial images as trademarks, and that it might be more difficult to establish inherent distinctiveness of these signs under the current market practices.

It might therefore often be necessary to establish acquired distinctiveness through use to obtain protection for the relevant sign. In this regard, INTA submits that reputation of the person would not *per se* be sufficient to establish acquired distinctiveness, since what is required is a systematic use of the sign as trademark and not of the face of the person in non-trademark uses (e.g. catwalks by the model depicted on the mark for modelling services).

## ANNEX A

### INTA's *amicus*-type submissions in cases before European courts/bodies:

- Third Party Observations on June 1, 2024, in case R 497/2024-G, *Nightwatch*
- Statement in Interventions of September 11, 2023, in cases T-105/23 and T-106/23, *Iceland Foods Ltd. v EUIPO*
- Statement in Intervention of June 7, 2023, in case C-337/22P, *EUIPO v. Nowhere*
- Letter of Submission of September 29, 2022, in case C-361/22, *Industria de Diseno Textil, S.A. (Inditex) v. Buongiorno Myalert, S.A.*,
- Letter of Submission of September 1, 2022, in case C-334/22, *Audi AG v. GQ*
- Third Party Observations on June 3, 2022, in case R-260/2021-1, *Matthias Zirnsack v. EUIPO*
- Letter of submission of January 10, 2022, in case C-175/21, *Harman International Industries*
- Letter of submission of December 2, 2021 in case C-472/21, *Monz Handelsgesellschaft International mbH & Co. KG vs. Büchel GmbH & Co. Fahrzeugtechnik KG*
- Letter of submission of August 16, 2021, in case C-112/21, *X BV v Classic Coach Company and Others*
- Third Party Observations on July 2, 2021 in cases R 1613/2019-G, *Iceland Foods Limited v. Icelandic Trademark Holding ehf* and R 1238/2019-G *Iceland Foods Limited v. Islandsstofa (Promote Iceland), The Icelandic Ministry for Foreign Affairs and SA - Business Iceland*
- Letter of submission of June 28, 2021, in case C-62/21, *Leinfelder Uhren München*
- Third Party Observations on April 1, 2021 in case R 964/2020-G, *EUROMADI IBERICA, S.A./ Zorka Gerdzhikova*
- Third Party Observations on March 3, 2021 in cases R 1719/2019-G and R 1922/2019-G, *The Estate of the Late Sonia Brownell Orwell ./ EUIPO*
- Third Party Observations on February 24, 2021, in case R 2248/2019-G, *The Estate of the Late Sonia Brownell Orwell ./ EUIPO*
- Letter of submission of December 23, 2020, in case C-421/20, *Acacia*
- Third Party Observations on December 1, 2020, in case R 1304/2020-G, *Der Grüne Punkt Duales System Deutschland GmbH ./ Halston Properties, s.r.o. GmbH*
- Letter of submission of September 28, 2020, in joined Cases C-253/20 and C-254/20, *Novartis AG v. Impexco NV and Novartis AG v. PI Pharma NV*
- Letter of submission of August 27, 2020, in joined cases C-147/20 and C-224/20, *Novartis Pharma GmbH v. Abacus Medicine A/S and Merck Sharp & Dohme B.V. et al. v. Abacus Medicine A/S et al.*
- Statement in Intervention of January 6, 2016, in case T-142/15, *DHL Express (France) v EUIPO*
- Statement in Intervention of April 25, 2014, in case C-445/13P, *Voss of Norway v OHIM24*
- Written Observations of March 16, 2010, in case C-495/09, *Nokia*
- Letter of submission of August 23, 2012, in case C-252/12, *Specsavers International Healthcare Limited & others vs Asda*
- Letter of submission of September 5, 2007, in case C-252/07, *Intel Corporation*
- Letter of submission of June 12, 2007, in case C-102/07, *Adidas and adidas Benelux*

- Letter of submission of April 25, 2006, in case C-17/06, *Céline*
- Submission as intervener to the English Court of Appeals on October 16, 2006, in case *Special Effects v L'Oreal SA* (HC 05C012224, Court of Appeal 2006 0744)
- Letter of submission of June 17, 2005, in case C-108/05, *Bovemij Verzekeringen*
- Letter of submission to of December 5, 2003, in case T-133/03, *Schering-Plough v Commission and EMEA*
- Letter of submission of April 4, 2003, in case EFTA Court E-3/02, *Paranova A/S v. Merck & Co., Inc, Merck, Sharp & Dohme B. V. and MSD (Norge) A/S*
- Letter of submission of March 20, 2003, in case C-418/02, *Prakiker Bau- und Heimwerkermärkte*
- Letter of submission of November 1, 2001, in case C-283/01, *Shield Mark*
- Letter of submission of July 6, 2001, in case C-104/01, *Libertel*
- Letter of submission of October 10, 2000, in case C-143/00, *Boehringer Ingelheim and Others*