

European Union Intellectual Property Office

Grand Board of Appeal

Alicante, Spain

RE: Case R 2248/2019-5, *The Estate of the Late Sonia Brownell Orwell* ./ EUIPO

February 24, 2021

Amicus Brief (Third Party Observations) – International Trademark Association

The International Trademark Association (“**INTA**”) has prepared this brief in relation to case R 2248/2019-5, *The Estate of the Late Sonia Brownell Orwell* ./ 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 Beijing, Brussels, Santiago, Singapore, and Washington, D.C., and a representative in New Delhi. For more information, visit www.inta.org.

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 trademark 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 Economic Cooperation Forum (“APEC”), the Association of Southeast Asia Nations (“ASEAN”), the European Union (EU), and the World Trade Organization (“WTO”).

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 European courts).

Through its International Amicus Committee, INTA provides expertise concerning trademark and other IP-related laws to courts and trademark offices around the world through 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.

CASE BACKGROUND

The contested trademark is the European Union Trade Mark Application (**EUTMA**) GEORGE ORWELL. It was filed by The Estate of the Late Sonia Brownell Orwell (also referred to as the "**Applicant**") before the EUIPO on March 6, 2018 for goods and services in classes 9, 16, 18, 21, 25, 28, 41, 45. The mark was accepted for registration for classes 18, 21, 25, 28, 45 and rejected for classes 9, 16 and 41.

On August 2, 2019, the Examiner refused the EUTMA for the above classes on the grounds of Article 7(1)(b) and (c), in conjunction with Article 7(2) of Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union Trade Mark Regulation (**EUTMR**).

Per the Examiner (page 3 of the Interim Decision as defined below): "[...] *George Orwell is a very famous author who died in 1950. George Orwell is the writer of a large body of work including two novels which are universally regarded as classics (1984 and Animal Farm), [...] George Orwell is recognized, with his wide-ranging and richly varied canon, as one of the key literary figures of the first part of the twentieth century. Given this context the name 'George Orwell' will not convey a distinctive trademark significance for the relevant consumer of the rejected goods and services but will rather be seen as a descriptive indication of **subject matter: being by or about George Orwell***" (emphasis added).

The Applicant appealed the Examiner's decision before the EUIPO Board of Appeals (**BoA**) on October 3, 2019 and written observations were filed.

The Fifth BoA issued an Interim Decision on July 2, 2020 (**Interim Decision**) referring the case to the Grand Board. It remarked that there are contradictory decisions of the EUIPO in the matter of registrability of names of famous persons: “*The Board points out that the Office and the Boards of Appeal have issued diverging decisions with respect to the registrability of ‘names of famous persons’ for goods and services such as ‘videos; CD’s; movies’ (Class 9), ‘printed matter; photographs; books; paintings’ (Class 16), or ‘entertainment; cultural activities, educational services’ (Class 41)*”; (02/07/2020, R 2248/2019-5, George Orwell).

It stated that in view of that: “[...] *it is for the Grand Board to assess whether the name of a famous person as in the case at hand, GEORGE ORWELL, will be merely perceived as an indicator of the content or subject matter of books, films, or entertainment, cultural or educational services in Classes 9, 16 or 41, being thus descriptive and devoid of distinctive character pursuant to Article 7(1)(b) and (c) EUTMR or to the contrary may still serve as an indicator of the origin of those goods and services and be consequently registered as a trade mark*”.

REASONS FOR INTA TO SUBMIT THIS BRIEF

The underlying issue of this case is the “*dilemma of trade mark protection for names of historical persons, famous authors or of copyright works and their titles, whether or not still subject to copyright protection*” (see von Bomhard – von Mühlendahl ed, *Concise European Trademark Law*, 2018 page 73), which has given rise to contradictory decisions (some of which are also mentioned in the Interim Decision).

In particular, this case concerns the possibilities of protecting names, and in particular famous persons’ names, as a trademark: the question posed to the Grand Board might lead to the conclusion that names of famous persons are inherently descriptive/non-distinctive in connection with certain categories of goods/services.

Therefore, the outcome of this case might have a disruptive effect on any possible sector/industry involving names of famous persons, from art and literature to sports, history, science, fashion and so on. Many registered trademarks consisting of persons’ names – including famous ones – exist in various registries, including that of the EUIPO. The validity of all those marks and their enforcement *vis-à-vis* third parties might therefore be adversely affected, as well as that of future applications. INTA submits that the right to protect a name and in particular a famous name, as a trademark, should be safeguarded.

ANALYSIS

I. The relevant legal provisions

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 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;*
- (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade;*
[...]

2. 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.

Article 14

Limitation of the effects of an EU trade mark

1. An EU trade mark shall not entitle the proprietor to prohibit a third party from using, in the course of trade:

- (a) the name or address of the third party, where that third party is a natural person;*
- (b) signs or indications which are not distinctive or which concern the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of the service, or other characteristics of the goods or services;*
- (c) the EU trade mark for the purpose of identifying or referring to goods or services as those of the proprietor of that trade mark, in particular, where the use of that trade mark is necessary to indicate the intended purpose of a product or service, in particular as accessories or spare parts.*

2. Paragraph 1 shall only apply where the use made by the third party is in accordance with honest practices in industrial or commercial matters.

II. INTA's Position

INTA submits that names of famous persons should not be subject to special treatment which is more severe than that applied to other signs which a trademark may consist of. Like all other

signs, they should be registered if they enable the products or services for which registration is sought to be distinguished from those of others, according to their commercial origin.

More in general, INTA takes the view that the adoption of *a priori* rules on the assessment of the distinctive character of signs which a trademark may consist of, including names of famous persons, should be discouraged.

Consequently, the answer to the question posed to the Grand Board should be that names of famous persons are not per se descriptive/non-distinctive in connection with specific categories of goods/services. Like any other signs which a trademark may consist of, names of famous persons may serve as indicators of the origin of any goods/services, unless there are additional factors pointing to a different conclusion. It is therefore for the judicator bodies to make a case-by-case assessment, taking into consideration all the circumstances of the case to determine whether or not a specific famous name would be perceived as a distinctive sign in connection with the concerned goods/services.

In this last regard, INTA recommends that the Grand Board clarifies that famous persons' names are not among those signs for which, according to the established case-law, it is deemed more difficult to establish distinctive character (such as slogans, shape of goods and colors). This is important to avoid famous persons' names being subject to a higher threshold to establish distinctive character.

Once registered, the scope of protection of famous persons' names as trademarks would not affect the right of third parties to use such names in a descriptive, non trademark, manner.

A. Preliminary remarks and the EUIPO Guidelines

Descriptiveness

According to EUIPO Guidelines for Examination in the Office (**Guidelines**), Part B Examination, Section 4 Absolute grounds for refusal, Chapter 4 Descriptive trade marks (Article 7(1)(c) EUTMR), p. 415, a sign must be refused registration as descriptive if it has a meaning which is immediately perceived by the relevant public as providing information about the goods and services applied for. The examples mentioned in art. 7 (1) (c) EUTMR include the "kind", "purpose" and "other characteristics".

Kind of goods or services

Per the Guidelines (p. 419), the "kind of goods and services" includes the goods or services themselves, that is, their type or nature. For example, 'bank' for financial services, 'Perle' for wines and sparkling wines (01/02/2013, T-104/11, Perle', EU:T:2013:51,) or 'Universaltelefonbuch' for a universal telephone directory (14/06/2001, T-357/99 & T-358/99, Universaltelefonbuch, EU:T:2001:162).

The name of a person may not, by its nature (as it denotes a person and not goods/services), describe any goods / services.

This is confirmed also in the guidelines of the EUIPO in force prior to 2014, where it was stated *that: "Names of individual persons are usually distinctive [...]. The same is true for names*

of **prominent** persons [...]” (https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/law_and_practice/guidelines/ctm/examination_en.pdf).

If a name has developed a meaning of denoting a kind of goods, then indeed it shall be ineligible for registration on the basis of descriptiveness (e.g., MOZART was found to be descriptive of foodstuff in class 30 since in Germany MOZARTKUGEL (Mozart spheres) are a specific kind of candy, Case T-304/06, *Paul Reber GmbH & Co. KG v. EUIPO*).

Subject Matter/Content

The rationale of the Examiner’s decision is based on the “subject matter/content” objection.

The “subject matter/content” is not as such included in the list of elements amounting to descriptiveness, per the wording of art. 7.1. of EUTMR. It has been raised under different prisms by the various judicial bodies/courts, namely under the concept of “other characteristic” or “kind” (see e.g. BoA in SIBELIUS) mentioned in art. 7(1)(c) EUTMR, or as an independent concept (see e.g. BoA in VAN GOGH MUSEUM Amsterdam with respect to “*direct reference to the subject matter*” and SIBELIUS referring to “*content or purpose*”).

Subject matter/content is according to the Guidelines (p. 420) considered as “other characteristic”. The EUIPO Guidelines expressly clarify that the notion of “content” is used interchangeably with “subject matter” (p. 437), it applies to certain goods and services only (provides books, CDs, films as a typical example, p. 437) and it concerns all kinds of marks. One example mentioned in the Guidelines is ROCK MUSIC for CDs (p. 437). INTA agrees that such a mark should be ineligible for registration as descriptive of a kind of music.

According to the Guidelines (par. 2.7.1, p. 436, 437): “*Where a sign consists exclusively of a word that describes what may be the subject matter or content of the goods or services in question, it should be objected to under Article 7(1)(c) EUTMR. Commonly known terms likely to be linked to a particular thing, product or activity by the relevant public are capable of describing subject matter and should therefore be kept free for other traders (12/06/2007, T-339/05, *Lokthread*, EU:T:2007:172, § 27). The essential question is whether the sign applied for may be used in trade in relation to the goods or services applied for in a manner that will be undoubtedly perceived by the relevant public as descriptive of the subject matter of those goods or services for which protection is sought, and should therefore be kept free for other traders. For example, a widely known name such as ‘Vivaldi’ will immediately create a link to the famous composer, just as the term ‘skis’ will immediately create a link to the sport of skiing. [...] .*”

Names of famous persons (in particular musicians or composers) can indicate the category of goods, if due to widespread use, time lapse, date of death, popularisation, recognition, multiple performers or musical training, the public can understand them as generic. This would be the case, for example, with respect to ‘Vivaldi’, whose music is played by orchestras all over the world and the sign ‘Vivaldi’ will not be understood as an indicator of origin for music”.

However, it is doubtful that the average consumer shall understand VIVALDI as being a generic term for “music” or any kind of “music”.

What the EUIPO's guidelines state is that "*commonly known terms likely to be linked to a particular thing, product or activity by the relevant public are capable of describing a subject matter and should therefore be kept free for other traders*" (paragraph 7.2.1. of the Guidelines, p. 436).

INTA takes the view that the argument above is not convincing, because **any meaningful word** could be the subject matter/content of a book, CD or film etc and may indicate characteristics that form the subject matter of such a book.

It is noted that a similar approach is employed as regards geographical names, where the Guidelines state (p. 428): "*The registration of geographical names as trade marks is not possible where such a geographical name is either already famous, or is known for the category of goods concerned, and is therefore associated with those goods or services in the mind of the relevant class of persons, or it is reasonable to assume that the term may, in view of the relevant public, designate the geographical origin of the category of goods and/or services concerned (15/01/2015, T-197/13, MONACO, EU:T:2015:16, § 48; 25/10/2005, T-379/03, Cloppenburg, EU:T:2005:373, § 34)*".

INTA submits that the criteria and rationale employed in relation to geographical names should not be employed in the context of personal names. The natural meaning of the former relates to a geographical area, which will have a multitude of sources, while the latter to a person, being one single source. In other words, while a geographical name would a priori from its nature signify a region and not a single source, names of persons would a priori signify a single source rather than multiple sources.

It is noted that the single case law reference above, namely paragraph 27 of the General Court of the European Union (**GCEU**) ruling T-339/05 makes no mention of "content". Neither does the rest of the ruling. Instead, it only makes reference to the "keep free" concept and concerns a mark filed for goods which do not have any "content" ("[b]olts, bolts of metal, nuts, nuts of metal").

Defining Content

Per the above Guidelines extract, the content/ subject matter is denoted because the mark will be "linked" to a specific "*thing, product or activity*" (p. 436).

Per a different paragraph in the EUIPO Guidelines (*ibid*, p. 437) a name shall signify the content/subject matter because the mark will "*indicate the genre/category*" in which the said goods belong (e.g., VIVALDI will evoke "music"), making the mark "*generic*". Being generic would raise issues under art.7(1)(d).

On another approach in the EUIPO Guidelines (*ibid*), the content/ subject matter shall be denoted because the mark will be linked not to a specific "*thing, product or activity*" but to a specific person (EUIPO Guidelines, *ibid*, emphasis added: "*a widely known name such as 'Vivaldi' will immediately create a link to the famous composer, just as the term 'skis' will immediately create a link to the sport of skiing*", p. 436).

INTA submits that, irrespective of whether the creation of such a link could be enough as a criterion to find descriptiveness, there is a difference: Vivaldi is not the name of any goods or

services and does not “immediately” create a link to any goods or services, whereas “skis” is the name of certain goods and does denote such goods.

On one more aspect, per the EUIPO Guidelines “*the sign ‘Vivaldi’ will not be understood as an indicator of origin for music*” (*ibid*, p. 437), which raises the objection of lack of distinctiveness under 7(1)(b) EUTMR.

All these concerns are included in the chapter of EUIPO Guidelines about descriptiveness, however, as per the above reasons, they may fall under different absolute grounds objections (non-distinctiveness, genericness).

Under yet another aspect, the Interim Decision, as well as other EUIPO BoA and GCEU decisions, have raised the content problematic claiming that the mark signifies the content/subject matter because it denotes that the goods are “by or about” a certain person, George Orwell in the case at hand.

Lastly as the Interim Decision of the BoA in case R 1922/2019-5 (1984) stated in par. 22: “*The guidelines of the Office are not very specific in connection to ‘titles of books’ because on the one hand they say that a title of a book, in particular if it is well known, might be perceived as indicating the subject matter or content of goods such as publications etc. but then on the other hand the guidelines condition the application of Article 7(1)(b) EUTMR to the fact that the title ‘entered into the language’.*”

From the above it follows that there is uncertainty as regards the criteria under which a sign shall denote content/subject matter and in particular a sign that consists of a famous name (or book title).

INTA submits that this uncertainty stems from the fact that famous names are not - because of their fame - *per se* descriptive of any goods or services.

INTA’s view is that the content/subject matter criterion should be restrictively applied, and its actual scope should be clearly determined, so as to safeguard uniformity in the application of the law.

As aforementioned, any given word and its meaning could form the subject matter or content of a book. Should therefore all words be denied registration for books because they are included in the list of possible contents that a book may have?

It should also be noted that under the EUIPO Guidelines (*ibid*, p. 438) if a mark is rejected on the basis of the above, any restriction of the goods/services to exclude the characteristic from the goods would not render it acceptable: “*Where the sign applied for is a descriptive term for a particular characteristic of goods or services, a designation of goods or services which excludes that particular characteristic described by the sign applied for will not avoid an objection based on subject matter. This is because it is unacceptable for an applicant to make a claim of goods or services subject to the condition that they do not possess a particular characteristic (see judgment of 12/02/2004, C-363/99, ‘Postkantoor’, paras 114-116)*”. Therefore, as mentioned in the Guidelines (p. 438), for example COMEDY filed for television broadcasting, “except for comedy programming” will still raise objections.

By or about

INTA submits that the criterion mentioned in the Interim Decision, as falling under the content/subject matter concept, namely “by or about” is arbitrary. If “by” is to indicate “written by”, it is submitted that authorship should be irrelevant in the trademark context. On the other hand, if “by” denotes commercial origin, then the mark is by definition distinctive and non-descriptive. Descriptiveness is judged according to use of indications “in trade”. Therefore, the fact that the name of a person may signify authorship would have no bearing in the context of trademark law and would not render the mark as such descriptive. As regards the “about” criterion similarly, apart from the fact that any person and any thing, any meaningful word, may constitute the subject matter of a book, and therefore a book may be “about” any possible meaningful word, the literary or artistic content shall be irrelevant, as descriptive indications are strictly those that are descriptive “in trade”. Namely what is important is whether the consumers would likely perceive them as badges of commercial origin or not.

Also, the example provided in the Guidelines (p. 438) that “*PENGUINS (in plural) for books, except for books about penguins*” is non registrable, whereas “*PENGUIN for comic books with country western, medieval and ancient Roman themes*” is registrable, clearly illustrates the practical impossibility created by this approach: the goods for which registration would be sought by e.g. a publishing house would normally be “books” without inclusion of each and every possible content the books may have.

Link

As aforementioned it is not clear whether the “link” in the content/subject matter test according to the Guidelines means the link to the “*thing, product or activity*” or the link to the person under that name. Both “links” are mentioned in the Guidelines.

INTA submits that, 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).

Furthermore, if one were to interpret this criterion as rendering ineligible for registration all marks that create “a link” in the mind of consumers to the goods at hand, due to their reputation, no mark could ever be registered after acquiring fame: the mark would always - because consumers know it - create a link in the minds of consumers with the denoted goods.

As regards the link to a specific person as basis of the subject matter test, it is noted that it is not clear from the Guidelines whether this link establishes descriptiveness or excludes it. Namely:

- In the Guidelines it is mentioned (par. 2.7.2. Titles of books, emphasis added) that: “*The following, non-exhaustive considerations might assist in evaluating whether the title of a book would be perceived as descriptive of the subject matter of the goods and services and thus not capable of denoting the commercial origin of subject-related goods and services [...] The more time has passed by since the publication of the original work, the more likely it becomes that a book’s plot, its characters and its title are no longer strictly connected to a particular author or the exact story, but have rather reached a status of autonomy*”.

Similarly, under par. 2.7.1 of the Guidelines, as regards titles of books that are per the Guidelines descriptive, it is stated (emphasis added): “*They are no longer linked exclusively with the original book, but have rather become well known, universal and autonomous commonplace expressions **to denote a certain type of story or an entire genre**”.*

From both the above extracts wording it follows a *contrario* that for as long as a title (or name for that matter) is connected to a particular author / book, the mark is not descriptive of the subject matter.

We refer to the reasoning of the Examiner in the case at hand (mentioned in par. 4 of the Interim Decision) whereby the Anne Frank mark which was deemed eligible for registration and non - descriptive differs from GEORGE ORWELL because inter alia (emphasis added): “*The case R 2401/2014-4, Le Journal D’Anne Frank, cannot be compared to the current application. ‘Le Journal D’Anne Frank’ refers not simply to a name but rather to an autobiographical work, this being the only work for which Anne Frank is famous. Autobiographical works are inescapably **linked to the person** whose life is written about, it being central to the reader’s understanding of such works that they are **either written by, or at least authorised by, the subject of the work**”.*

This means a *contrario* that to the extent books are linked to the person, as being written or authorized by him/her, then the mark is not descriptive of the subject matter.

INTA’s view is that if content/subject matter is to be considered as an eligible criterion under the “other characteristics” wording - it should be applied irrespective of any fame and literally, i. e. not taking into account what the mark might “link” the goods to, but only whether it directly describes them.

Genre/Category

In the case at hand, the words GEORGE ORWELL have not been found by the Examiner or the Interim Decision as denoting a certain genre or category. A case where a name denotes a kind of goods would indeed be rare (see for example the above-mentioned case of MOZARTKUGEL under chapter “*Kind of Goods or Services*”).

Reputation

The argument that fame renders the name descriptive and ineligible for registration appears arbitrary. If reputation was a factor considered as excluding registration, it should be excluding it for all categories of marks. This would lead to any famous mark being ineligible for registration after it has acquired reputation. 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 applications.

INTA submits that the degree of reputation should be irrelevant for the assessment of descriptiveness save as a factor to be assessed in the test of acquired distinctiveness. The EUIPO in MUSEO GAUDI BoA found that reputation constituted the mark registrable (R 2196/2016-2, par. 74 “*in view of the applicant’s claim of **the reputation** of the contested sign and in particular in light of generally known facts, the trade mark claimed is accepted for all the goods and services claimed due to its **acquired distinctiveness**”*).

It is totally different when a mark, any mark (not just famous names), as a result of multiple factors, e.g., systematic inactivity of the trademark holder against unauthorized third party use etc., loses its ability to link the goods to a single undertaking. Such mark, irrespective of whether it is a famous name or any other kind of mark, would be refused registration.

Source indicator

The fact that an author's name, just as any other name, may well function as a source indicator follows indicatively also from the following assertions:

- In *Dr No* the GCEU confirmed (par. 24 Case T-435/05 *Danjaq LLC v. EUIPO*) that:

*“it should be pointed out that Dr. No is the title of the first film in the ‘James Bond’ series and also the name of one of the main characters in the film. Theoretically, **those facts cannot prevent the use of the signs Dr. No and Dr. NO as trade marks in order to identify the commercial origin of the films or DVDs**”*

- In *Sherlock Holmes*, the EUIPO Cancellation Division had found *inter alia* that (par. 6, p. 4, BoA Decision of 07/06/2019, R 189/2018-2):

*“[...] ‘Sherlock Holmes’ is the name of a fictional character, a famous detective in a series of fantasy and science fiction stories written by Sir Arthur Conan Doyle. **In theory, these facts cannot prevent the use of the contested EUTM as a trade mark in order to identify the commercial origin [...] as same sign may be protected as an original creative work by copyright and as an indicator of commercial origin by trade mark law**”*

- In *Pinnocchio* the EUIPO Cancellation Division had found *inter alia* that (par. 6, p. 7 of the BoA Decision of 25.2.2015 – R 1856/2013-2):

*“Due consideration was given to the documents related to the story of ‘PINOCCHIO’ [...]. However, the sole fact that the sign indicates a story protected by copyright **does not exclude the possibility of the same sign to function as an indicator of commercial origin** by trade mark law. It is, therefore, a matter of different exclusive rights based on distinct qualities, that is to say the original nature of a creation, on the one hand, and the ability of a sign to distinguish the commercial origin of the goods and services, on the other (21.10.2008, T-73/06, Sac, EU:T:2008:454, § 32 and 30.06.2009, T-435/05, Dr. No, EU:T:2009:226, § 26). In the present case, there is no data, information or evidence provided by the cancellation applicant that could lead to a conclusion that the CTM **does not function as an indicator of commercial origin in relation to the goods and services in question**. Furthermore, it is noted by the Cancellation Division that the CTM is considered to be distinctive even in relation to ‘printed matter’, ‘recorded data storage equipment’ or ‘toys and playthings’, as well as ‘entertainment services’ applied for, when it could identify the content of these products and services, **because the content in this case would be identified with a distinctive term, i.e., ‘PINOCCHIO’**”.*

- In the Interim Decision of the case at hand it was stated in par. 7 that:

“On the 6 April 2020, the Board sent a communication to the applicant with the following arguments: [...] The trade mark ‘GEORGE ORWELL’ has been used and controlled by the applicant to ensure consumers can readily identify the original works of the deceased author. As a result of their efforts, the relevant public perceives the ‘GEORGE ORWELL’ mark as

indicating that the contested goods and services **originate from either the applicant or economically-linked undertakings**".

Other criteria

INTA submits that criteria such as whether the book written by the person is autobiographical (*cf* par. 4 of the Interim Decision "*refers not simply to a name but rather to an autobiographical work*") or whether the person published one or several books (*cf* par. 4 of the Interim Decision "*unlike Anne Frank who is known as the writer of one book*" and "*cannot be compared to the current application ... this being the only work for which Anne Frank is famous*") are arbitrary and can lead to legal uncertainty.

Par. 20 of the 2.7.2019 Interim Decision of the BoA in case R 1922/2019-5 on "1984" refers to the decision of 02/02/2015, R 881/2014-5, Der kleine Hey, § 16, which considered that the title of a book does, as such, **not inform about the subject matter** of a publication **except if** – apart from being a title of a book – it developed in the perception and understanding of the public as being a **general indication**.

INTA agrees with this position and submits it is also valid for names.

Conclusion

INTA submits that the content/subject matter criterion as part of "other characteristics", should be interpreted restrictively and shall be applicable only in cases where the word directly denotes the content of the specific goods mentioned in the specification, namely where a) it directly and literally describes the exact goods as mentioned in the specification or b) it has become generic for such category of goods. This appears to be the outcome suggested also by the Guidelines (p. 437) stating that "*Objections based on the above will apply only to goods (e.g. books) or services (e.g. education) **that contain** subject matter regarding other things, products and/or activities (e.g. a book about history, or an educational course on history)*".

In light of the above, INTA's view is that the mere fact that a sign applied for trademark protection consists of a personal name – including a famous one – is not sufficient to conclude that said sign will undoubtedly be perceived by the relevant public as descriptive of the concerned goods/services (see also BoA R 2401/104-4 *Anne Frank* par. 26: "*The expression 'Anne Frank' is in no way **descriptive** and strictly speaking **does not mean anything***"). The scope of protection of such right shall not of course prevent third parties from making descriptive non-trademark uses thereof.

B. Assessment of the case at hand

The Grand Board is called to establish whether/to what extent the fact that a sign consists of a name of a famous person may impair its distinctive character. Although the Interim Decision makes express reference to Article 7(1)(b) and (c) EUTMR only, we deem it appropriate to briefly address also the ground of refusal set forth in Article 7(1)(d) EUTMR.

a. Descriptiveness - Article 7(1)(c) EUTMR

The Examiner refused the mark stating that it is non-distinctive, due to its descriptiveness. Other grounds for the lack of distinctiveness have not been argued by the Examiner.

It is settled case-law that each of the grounds for refusal to register listed in Article 7(1) EUTMR is independent and requires separate examination. In addition, according to settled case law, descriptiveness and the distinctive character of a trademark can be assessed only 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 General Court ruled in its judgment of June 17, 2009, in T-189/07, *Frosch Touristik GmbH v OHIM*, EU:T:2009:172).

The signs and indications to be refused under Article 7(1)(c) EUTMR are only those which may serve to designate, either directly or indirectly, 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 established EU case law that descriptiveness shall not be assessed *in abstracto* but *in concreto* on the basis of the goods and services included in the application of the mark (CJEU Case C-363/99, *Postkantoor*, paras. 31-35).

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, as a consequence of which the public concerned will immediately, and without further thought, 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).

The Examiner in the case at issue found that "*in the case at hand, George Orwell is a very famous author [...]*". The finding of descriptiveness was then based on the following: "*Given this context the name 'George Orwell' will not convey a distinctive trade mark significance for the relevant consumer of the rejected goods and services but will rather be seen as a descriptive indication of **subject matter: being by or about George Orwell***" (see, to that effect, page 3 of the Interim Decision). This is a recurring argument in the decisions refusing trademark protection to signs consisting of names of famous persons, which are also mentioned in the Interim Decision.

The above argument is based on what has already been analyzed as the EUIPO's Guidelines on "subject matter/content".

The Examiner's refusal appears to be based in particular on the BoA decision in case R 2382/2017-2, *SIBELIUS*, which, in turn, relied on the GCEU's decision of June 30, 2009, T-435/05, *Dr. No*. However, this ruling cannot be taken as a basis for a finding of descriptive character/lack of distinctiveness of the mark "George Orwell" for the very reason that said decision addressed a different issue: whether the sign "Dr. No" had been used by the applicant as a trademark and such factual finding was based on the documents in the relevant file.

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 considering various factors and all the circumstances of the case, taking always into consideration that the public perception may vary over time.

In light of the above, INTA submits that the mere fact that a sign for which a trademark application has been filed consists of a name of famous person is certainly not sufficient to conclude that said sign will undoubtedly be perceived by the relevant public as descriptive of the concerned goods/services (see also BoA R 2401/104-4 *Anne Frank* par. 26: “*The expression ‘Anne Frank’ is in no way descriptive and strictly speaking does not mean anything*”).

To make this assessment it is necessary to take into consideration all the circumstances of the case, which may have an impact on the public’s perception. For instance, to this end it might be useful:

- to understand whether the right holder has undertaken the available steps (if any) under the relevant laws to control third party uses of the relevant name;
- to look at the kind of uses that the right holder itself has made of the relevant name; and
- to look at possible third party uses – with and without the right holder’s authorization – of the name at issue.

Not having reviewed the case file and, in particular the relevant evidence, INTA cannot take a position on the possible descriptive character of the sign at issue.

In any case, it should be noted that, even if the mark at issue were found to be descriptive, the Applicant would be entitled to attempt to establish acquired distinctiveness through use of said mark according to Article 7.3 EUTMR.

b. Distinctiveness - Article 7(1)(b) EUTMR

i) Inherent Distinctive Character

A trademark has distinctive character if it serves to distinguish, according to their origin, the goods, or services in respect of which registration has been applied for. It is sufficient for the trademark to enable the public concerned to distinguish the product or service from others which have another commercial origin, and to conclude that all the goods or services bearing it have originated under the control of the proprietor of the trademark to whom responsibility for their quality can be attributed (Case C-299/99, *Koninklijke Philips Electronics NV v. Remington Consumer Products Ltd*, par. 47).

It is settled case-law that the distinctive character of a trademark within the meaning of Article 7(1)(b) EUTMR means that the sign serves to identify the product and/or services in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings [CJEU, April 29, 2004, C-468/01 P – C-472/01 P, *Tabs (3D)*, EU:C:2004:259, paragraph 32; CJEU, October 21, 2004, C-64/02 P, *Das Prinzip der Bequemlichkeit*, EU:C:2004:645, paragraph 42; CJEU, May 8, 2008, C-304/06

P, *Eurohypo*, EU:C:2008:261, paragraph 66; CJEU, January 21, 2010, C-398/08 P, *Vorsprung durch Technik*, EU:C:2010:29, paragraph 33].

It is further settled case-law that distinctive character must be assessed by reference, first to the goods or services in respect of which registration is sought and, second, to the relevant public's perception of that sign (CJEU, July 12, 2012, C-311/11 P, *Wir machen das Besondere einfach*, EU:C:2012:460, paragraph 24 and case-law cited). The relevant point in time to make this assessment is the date of filing of the trademark application (see General Court ruled in its judgment of June 17, 2009, T-189/07, *Frosch Touristik GmbH v OHIM*, EU:T:2009:172).

A “**minimum degree of distinctiveness**” is sufficient to meet the threshold set forth in Article 7(1)(b) EUTMR.

ii. Criteria for names

The Examiner himself acknowledged that “*names of authors are not per se unregistrable for goods such as books and films etc.*” but then concluded that the mark at issue lacks distinctive character by being descriptive, on the basis of the settled case law and EUIPO practice, according to which all descriptive marks are necessarily non distinctive (CJEU Case C-363/99 *Postkantoor*, par. 86, CJEU Case C-265/00 *BIOMILD* paras. 18, 19 and case law cited therein).

However, as seen above, the Examiner's finding of descriptiveness of the mark at issue is challenged. It shall therefore be independently examined whether the mark at issue can meet the *minimum distinctive* character threshold set forth in Article 7(1)(b) EUTMR.

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).

As the CJEU has further confirmed in Case C-404/02, *Nichols plc v. Registrar of Trade Marks*, par. 23, the distinctive character of a mark must be assessed in relation to the goods or services in respect of which registration is applied for and in relation to the perception of the relevant consumers (see also Case C-299/99 *Philips*, paras 59 and 63 and Case C-218/01 *Henkel*, par. 50). Any greater difficulty as might be encountered in the specific assessment of the distinctive character of certain trademarks cannot justify the assumption that such marks are *a priori* devoid of distinctive character or can acquire such character only through use (C-404/02 *Nichols* par. 29).

Per the CJEU, in the same way as a term used in everyday language, even a common surname may serve the trademark function of indicating origin and therefore distinguish the products or services concerned, where it is not subject to a ground of refusal of registration, such as, for example, the generic or descriptive character of the mark or the existence of an earlier right (C-404/02 *Nichols* par. 30).

In particular, the Court of Justice, after stressing that any “*greater difficulty as might be encountered in the specific assessment of the distinctive character of certain trademarks cannot justify the assumption that such marks are a priori devoid of distinctive character or can acquire such character only through use*” (see, to that effect, CJEU, September 16, 2004, C-404/02, *Nichols plc v. Registrar of Trade Marks*, EU:C:2004:538, paragraph 29), established that “[i]n the same way as a term used in everyday language, **a common surname may serve the trade mark function** of indicating origin and therefore distinguish the products or services concerned where is it not subject to a ground of refusal of registration other than the one referred to in Article 3(1)(b) of Directive 89/104, such as, for example, the generic or descriptive character of the mark or the existence of an earlier right” (see, to that effect, paragraph 30 of the same judgment; emphasis added).

As the CJEU has ruled, the registration of a trademark constituted by a surname cannot be refused in order to ensure that no advantage is afforded to the first applicant. The EUTMR and the Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the EU Member States relating to trade marks (**EUTMD**) contain no provision to that effect, regardless of the category to which the trademark applied for belongs.

The Court of Justice, in particular, went further to stress that “[t]he registration of a trade mark constituted by a surname cannot be refused in order to ensure that no advantage is afforded to the first applicant since Directive 89/104 [now Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the EU Member States relating to trade marks (ed.)] contains no provision to that effect, regardless, moreover, of the category to which the trade mark whose registration is sought belongs” (see, to that effect, paragraph 31 of the same judgment). Based on these lines of reasoning, the Court of Justice held “*the assessment of the existence or otherwise of the distinctive character of a trade mark constituted by a surname, even a common one, must be carried out specifically, in accordance with the criteria applicable to any sign covered by Article 2 of the said directive, in relation, first, to the products or services in respect of which registration is applied for and, second, to the perception of the relevant consumers. The fact that the effects of registration of the trade mark are limited by virtue of Article 6(1)(a) of that directive has no impact on that assessment*” (see, to that effect, paragraph 34 of the same judgment).

The assessment of the existence or otherwise of the distinctive character of a trademark constituted by a surname, even a common one, must be carried out specifically, in accordance with the criteria applicable to any sign, in relation, first, to the products or services in respect of which registration is applied for and, second, to the perception of the relevant consumers (C-404/02 *Nichols* par. 30, 31, 34).

It follows that the assessment of the distinctive character of names – including those of famous persons – 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, taking always into consideration that the public perception may vary over time.

In light of the above, INTA takes the view that the mere fact that a sign for which a trademark application has been filed consists of a name of a famous person 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 mark applied for may identify the concerned goods/services as emanating from a single source and therefore function as trademark.

To that end, what should be examined is not whether the name is famous and to what degree but rather if the famous name has been used by a single undertaking, and/or under the control of a single undertaking, able to denote commercial origin, understood as implying commercial control, namely that the sale/marketing of the goods and services has been authorized by the person under the famous name and / or entities deriving their rights therefrom. To make this assessment it is necessary to take into consideration all the circumstances of the case, which may have an impact on the public perception. For instance, to this end, the above mentioned criteria might be useful under II.B.a.

Not having reviewed the case file and, in particular the relevant evidence, INTA cannot take a position on whether the signs at issue meet the distinctiveness threshold under Article 7(1)(b) EUTMR.

In any case, it should be noted that, even if the mark at issue were found to be inherently non-distinctive, the Applicant would be entitled to attempt to establish acquired distinctiveness through use of said mark according to Article 7.3 EUTMR.

c. Sign Capable of Being a Trade Mark – Article 4, 7(1)(a) EUTMR

It is settled case-law that to be capable of constituting a mark under Article 4 EUTMR, the subject matter of any application must satisfy three conditions: (i) it must be a sign; (ii) that sign must be capable of being represented on the Register; and (iii) the sign must also be capable *in abstracto* of distinguishing the goods or services of one undertaking from those of other undertakings (see, VON BOMHARD – VON MÜHLENDAHL, *Concise European Trademark Law*, 2018 pages 19-21 and the case law quoted therein).

The question whether names can function as trademarks at all, namely irrespective of specific goods and services, is resolved by the EU legal text themselves. These expressly respond to this question in the affirmative. Under Article 4 EUTMR, names are mentioned among the signs that may be registered as trademarks. They must – at least *in abstracto* – like all other categories of marks, be able to distinguish goods or services of one undertaking from those of other undertakings and they must be able to be represented clearly and precisely. Similar provisions are included in Article 3 EUTMD. Analogous provisions were also included in the previous Regulations and EU Trademark Directives.

INTA points out that in this case the Interim Decision has already confirmed in par. 7 that the Interim Decision itself expressively acknowledges that

*“[t]he trade mark ‘GEORGE ORWELL’ has been used and controlled by the applicant to ensure consumers can readily identify the original works of the deceased author. As a result of their efforts, the relevant public perceives the ‘GEORGE ORWELL’ mark as indicating that the contested goods and services **originate from either the applicant or economically-linked undertakings**”* (see, to that effect, paragraph 7 of the Interim Decision; emphasis added).

It follows that the sign “George Orwell” should be considered as a sign eligible for registration pursuant to Articles 4 and 7(1)(a) and EUTMR, irrespective of the fact that it is a name of a famous writer.

d. Customary Sign – Article 7(1)(d) EUTMR

Under Article 7(1)(d) EUTMR signs shall not be registered if they “*consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade*” for goods and services. Basically, this absolute ground of refusal applies to signs which are or have become **generic**.

“*The relevant criterion is usage in the relevant trade sectors. The evidence must show that the contested designation is not perceived as a trademark but rather as a **common name of a product***” (see VON BOMHARD – VON MÜHLENDAHL, *Concise European Trademark Law*, 2018 page 76; emphasis added).

Therefore, under art. 7(1)(d) EUTMR trademarks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade are to be refused registration. In Case C- 517/99 *Merz & Krell GmbH & Co. (BRAVO)*, the CJEU decided that marks covered by 7(1)(d) EUTMR are excluded from registration not on the basis of descriptiveness but on the basis of current usage in trade sectors, covering trade in the goods and services for which the marks are sought to be registered. It follows from its wording that the above provision must be interpreted as only precluding registration of a trademark, where the signs or indications of which the mark is exclusively composed have become customary in the current language or in the *bona fide* and established practices of the trade to designate the goods or services in respect of which registration is sought (C- 517/99 par. 31). Competent authorities / courts must determine whether the contested sign or indication has become customary in the current language or in the *bona fide* established practices of the trade to designate the specified goods or services. It is immaterial, when that provision is applied, whether the signs or indications in question describe the properties or characteristics of those goods or services (C- 517/99 par. 41). In the case at hand, no issue has been raised by the Examiner of the BoA that the mark has become customary in the current language or in the *bona fide* established practices of the trade to designate the specified goods or services.

Like the assessment of the other grounds of refusal above, establishing whether a sign falls within the grounds of refusal under Article 7(1)(d) EUTMR is a complex assessment, which must be carried out by considering various factors and all the circumstances of the case, taking always into consideration that the public perception may vary over time.

In light of the above, INTA believes that the mere fact that a sign for which a trademark application has been filed is the name of a famous person is certainly not sufficient to conclude that said sign has become generic, namely denoting a whole genre/kind of goods and that, as such, it falls within the ground of refusal set forth in Article 7(1)(d) EUTMR. To make this assessment it is necessary to take into consideration all the circumstances of the case, which may have an impact on the public perception [see paragraph II.B.a)].

Not having reviewed the case file and, in particular the relevant evidence, INTA cannot take a position on whether the sign at issue has become customary in trade.

e. 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), (c) or (d) 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 EUTMA 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), (c) or (d) 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 Interim Decision, we understand that the Applicant has not yet put forward a claim of acquired distinctiveness but would be able to do so if the Office confirms that the signs at issue lack distinctive character with respect to some goods/services.

f. Misleading Character - Public Order – Symbols - Bad Faith

Furthermore, INTA stresses that where misleading character, public order, Paris Convention on the Protection of Industrial Property of 1883 art. 6*ter* or bad faith concerns are raised these shall be examined separately.

When the mark has passed the absolute grounds test of the above-mentioned articles 7(1)(a)-(d) EUTMR it may still be refused registration, if it is misleading (e.g. registration of GEORGE ORWELL by a third party not connected to the George Orwell estate) or against public order or if they constitute symbols which are prohibited from registration on the basis of art. 6*ter* of the Paris Convention, or if they are made in bad faith.

None of these circumstances apply in the present case.

g. Scope of Protection / Defenses

The scope of protection of the relevant marks shall be limited, insofar as any possible descriptive uses made in accordance with Article 14 EUTMR, would be allowed. Therefore, any use made by third parties in the course of trade and in accordance with honest practices, to denote the kind, quality, intended purpose, or other characteristics of the goods or services, namely any non-trademark use, would not amount to trademark infringement.

As the GCEU stated in GCEU, May 10, 2006, T-279/03, *Galileo International v. Commission*, EU:T:2006:121, paragraph 150, confirming that protection of the registered composite EUTM Galileo shall be limited, and its owner should be expected to know that, in the sense that third party non-trademark use shall not be infringing.

C. The BoA Case law

With regard to the case-law mentioned in the Interim Decision, INTA submits the following.

i) The Sibelius Ruling

The Interim Decision mentions that the Examiner largely relied on the BoA SIBELIUS ruling (R 2382/2017-2). This case concerned the filing of the EUTM application SIBELIUS by The estate of Jean Sibelius for goods and services in classes 9, 14, 15, 16, 24, 25, 30, 32, 33, 34, 35 and 41. It was refused for goods and services in classes 9, 16, 35 and 41.

The decision in the *Sibelius* case, in turn, is based on the General Court's decision of June 30, 2009, T-435/05, *Dr. No* case. This is particularly evidenced by paragraph 21 of the *Sibelius* decision, relying on the General Court's decision in the *Dr. No* case to support the conclusion that *"If the mark 'SIBELIUS' is used in the aforementioned goods in Class 16, namely 'Printed matter; Photographs; Books; Song books; Albums; Greeting cards; Musical greeting cards; Periodicals; Posters', the mark will indicate also the content of those goods, in other words that the goods are linked to the work, life or person of Jean Sibelius or that they contain his music (greeting cards and musical greeting cards)"*.

However, the General Court's decision in the *Dr. No* cannot be taken as a basis for a finding of descriptive character/lack of distinctiveness of the mark "George Orwell" in connection with goods/services in classes 9, 16, 41, for the very reason that the said decision addressed a particular factual issue. In the relevant case, the applicant had claimed *de facto* trademark protection for the sign "Dr. No" as well-known mark/use based right, so the General Court was called to establish whether the relevant sign could enjoy the claimed protection and, in particular, whether the sign "Dr. No" had been used by the applicant as a trademark. Therefore, the Court examined the documents submitted by the applicant and found that the same showed a descriptive – rather than a trademark – use of the relevant sign. Therefore, this decision is based on a specific set of evidence.

Clearly, the factual finding made by the General Court in the *Dr. No* case – which was based on the documents in the relevant file – cannot anyhow lead to a general principle whereby famous persons' names and/or titles would be perceived as an indicator of the content or subject matter of books, films, or entertainment, cultural or educational services in classes 9, 16 or 41.

Even more so when the General court in the *Dr. No* case explicitly confirmed in paragraph 24 that: *"it should be pointed out that Dr. No is the title of the first film in the 'James Bond' series and also the name of one of the main characters in the film. Theoretically, those facts cannot prevent the use of the signs Dr. No and Dr. NO as trade marks in order to identify the commercial origin of the films or DVDs"* (emphasis added).

ii) The Janis Joplin Ruling

On the other hand, in the decision of March 24, 2015, R 2292/2014-4, *JANIS JOPLIN*, the BoA stated in paragraph 17 the following:

*“... If the name of an artist or a group of artists is affixed to CD’s, DVD’s etc., displayed on packaging and used for a website, regardless of whether famous or not, it cannot be excluded that the name is used in such a way that it will be perceived by the relevant public as **an indication of trade origin** and not merely indicating the name of the performer whose performance is recorded or stored or about whom information is provided. The name “JANIS JOPLIN” of CD’s, DVD’s or websites featuring information is not capable to describe a particular category which could be seen then as the subject-matter of these goods and services, e.g., a particular style of music, such as rock or blues. Therefore, it is unlikely that the relevant customers will perceive the mark as an indication of the subject matter of the goods and services for which registration is sought...”*

Therefore, the BoA found in the aforementioned decision that the name of the artist “JANIS JOPLIN” does not indicate the “*content or subject matter*” of goods such as ‘CDs, DVDs or “downloadable musical sound recordings” (Class 9) or the services “*providing websites featuring information in the field of music and entertainment*” (Class 41), but instead it functions as trademark, with the result that Article 7(1)(b) or (c) EUTMR are not applicable.

INTA agrees with the rationale of the *JANIS JOPLIN* ruling.

The above is in line also with the recent German Federal Court Case No. 27 W (pat) 519/18. 496 in which “**The Federal Patent Court emphasized that a minimum degree of distinctiveness does not require that every possible use of the sign is use as a trademark. It is sufficient that there are practically significant and obvious possibilities of using the sign in such a way that the public will perceive it as a trademark.** A sign may thus be devoid of distinctive character if, in the most probable form of use, it is not perceived by the public as an indication of origin. The Federal Patent Court concluded that the mark *FRANZISKA VAN ALMSICK* must be assumed to be used in a manner consistent with use as an indication of origin and assessed in that light. Applying such notional use in the context of image, sound, and data carriers (CD, DVD, and CD-ROMs) and printed matter (books and periodicals), the public would be accustomed to the fact that **both the topic or subject** of these products (i.e., the title of the work and the authors, actors, directors, screenwriters, composers, or musicians responsible for it) **and the indication of origin** (i.e., the book publisher, music label production, and distribution company) are indicated next to each other. Since such indications tend to predominantly be found in predetermined locations on the goods, the public is able to deduce whether it is an indication of an author, a title, or a publisher. For example, it is common practice in the sale of books to highlight the author and work title (including graphical elements) and generally place them in the upper two thirds of the book cover. The indication of origin, being the publisher’s indication, is almost always found in a smaller font at the bottom of the book. The same practice applies to image and sound carriers, where the indication of origin is usually smaller than the title and the author’s name on the front or might only be on the back of the data carrier. Following such established practice, a consumer can be expected to assume that the name at the bottom of the book cover will be the name of the person or company responsible for the publication and not the object or theme of the product in question (even where that name is well known for matters other than publishing). Conversely, if that name appears in the middle of the book cover, the

public will only recognize it as the author's name or the subject matter of the book. It was held that similar considerations would apply in respect of the publication services sought in class 41" (Vol. 110 TMR, Annual Review of EU Trademark Law 2019, "Germany - Federal Patent Court - Are celebrity names as trademarks perceived as indicating subject or source?", p. 495, Martin Viefhues-Jonas, ed. by Tom Scourfeld).

iii) The Journal D' Anne Frank Ruling

The BoA in R 2401/104-4 Anne Frank paragraph 30 stated: "The Board in fact stresses that the unique and distinctive title 'Le journal d'Anne Frank' does not mean anything in relation to the designated goods and services" and par. 32 "It cannot be justifiably claimed that the repute of a name may constitute a barrier to the registrability of a sign. **How can it in fact be justified that, simply because 'everyone knows about Anne Frank's life story', the sign 'Le journal d'Anne Frank' is devoid of any distinctive character through its reference to just one single work?** The titles of works serve, by their very nature, to distinguish the name of one book from other works. It should be recalled that the distinctiveness of a mark within the meaning of the article in question means that the mark serves to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (12.07.2012, C-311/11 P, *Wir machen das Besondere einfach*, EU:C:2012:460, § 23)" and par. 33 "When it is associated with the goods and services at issue, this name is not devoid of any distinctive character in so far as it indicates their origin [...] The examiner has failed to explain why a requirement for availability exists [...] In any case, the requirement for availability does not exist in Community trade mark law".

INTA agrees with the rationale of the ANNE FRANK ruling, namely that when a sign is linked to a single source it shall *prima facie* considered to be distinctive.

iv) The Van Gogh Museum and Museo Gaudi Rulings

Both these cases concerned marks which included in their wording the word MUSEUM/MUSEO and were filed for *inter alia* services in class 41 "museums".

INTA notes in particular paragraph 4 of the Examiner decision in the VAN GOGH MUSEUM case regarding the figurative International Registration designating the EU No.1212074 VAN GOGH MUSEUM AMSTERDAM:

"A search in OHIM's database of CTMs reveals 165 registered trade marks in Class 41, many of which are no less descriptive and no more distinctive than the trade mark in question. For example, 'THE NOBEL MUSEUM' (No 0812404, application date 27/04/1998), 'THE COLD WAR MUSEUM' (No 0924214, application date 15/05/2007), 'FRIENDS OF THE NATIONAL MUSEUM' (No 11980638, application date 12/06/2013), 'KENNEDY MUSEUM' (No 5290606, application date 10/08/2006), 'MUSEUM OF ANCIENT FOOTBALL' (No 10244176, application date 06/09/2011), 'THE MUSEUM OF SOVIET ART' (No 11938891, application date 27/06/2013). As recently as 2013, the Office accepted the trade mark 'NATIONAL MUSEUM OF WOMEN IN THE ARTS' (No 11732716, application date 11/04/2013) for museum services in Class 41, and even 'FRIENDS OF THE NATIONAL MUSEUM OF WOMEN IN THE ARTS' (No 11980638, application date 12/06/2013) was accepted for

registration in respect of the same services. Therefore, the holder fails to understand why the trade mark in question is considered not registrable”.

The MUSEO GAUDI ruling found that no evidence had been submitted to show “*the level of awareness of the trademark by the relevant public*” (paragraph 60). It did however take into account its own finding of “*GAUDI being a well known name*” (paragraph 4), that “*GAUDI is known worldwide*” (par. 28), that “*Antoni Gaudí is admired by both professionals and the general public*” (paragraph 66) and given that “*generally known facts will be taken into account in favour of the applicant*” (paragraph 65), that “*Antoni Gaudí is the person about whom there are the most online queries by amateur enthusiasts and professionals in architecture*” (par. 67) and that “*Not only is the knowledge of the Catalan artist/architect ‘ANTONI GAUDI’ or ‘GAUDI’ a generally known fact that can be taken into account by the Board, but also the knowledge of some of his most emblematic works*” (paragraph 67). On the basis of all the above, the decision affirmed that, despite the fact that the applicant did not produce enough evidence (“*The Board insists that it would have been easy enough for the applicant to present more objective information*” (paragraph 67) and “*The Board therefore considers that the applicant could have made an effort to present more extensive and relevant evidence to support her claim that the ‘Museu Gaudí’ is so well-known and the only existing museum in the world, and should not have simply hoped that her only evidence would be supplemented by the Board with the generally well-known facts*” in the same paragraph):

*“[...] in view of the applicant’s claim of the reputation of the contested trade mark under Article 7(3) EUTMR, and in particular in light of generally known facts, the trade mark claimed is accepted for all the goods and services claimed **due to its acquired distinctive character**” (p. 16).*

The BoA found the same in relation to VAN GOGH MUSEUM (par. 127): “*As a consequence, the generally known facts confirm and are corroborated by the rather poor secondary evidence submitted by the IR holder, which leads the Board to conclude that due to the long-standing use of the mark before the date on which the European Union was designated, a significant proportion of the relevant public identify the objected services in Classes 35 and 41 (those typically rendered by a museum or those that can be rendered by a museum) **as originating from one particular undertaking***”.

Even though no claim of acquired distinctiveness as such was put forward, in MUSEO GAUDI the BoA had found on its own initiative that the reference by the applicant to association with one entity was deemed to be a claim of acquired distinctiveness (par. 53): “*The applicant alleges that the mark is associated ‘by the general public with a single entity, which in our case manages the only existing Gaudí Museum in the world (sic.)’ and therefore it can be interpreted that the applicant claims that the trade mark has acquired a distinctive character for the protected goods and services, as a result of the use made of it (Article 7(3) EUTMR)*”. See also (ibid, par. 54): “*The identification, by the relevant class of persons, of the product or service as originating from a given undertaking must be as a result of the use of the mark as a trade mark and thus as a result of the nature and effect of it, which make it capable of distinguishing the product or service concerned from those of other undertakings (18/06/2002, C-299/99, Remington, EU:C:2002:377)*”.

INTA agrees with the rationale that, at the very least, famous persons' names may have acquired distinctiveness through their use and the Applicant is entitled to claim it.

D. Overall Evaluation

As seen above, names are not excluded from registration *a priori*, and for the same reasons, names of famous persons are not excluded from registration *a priori*. On the contrary, they are expressly mentioned as signs that may be registered as trademarks under Article 4 EUTMR.

The Examiner decision stated, "*Given this context the name 'George Orwell' will not convey a distinctive trade mark significance for the relevant consumer of the rejected goods and services but will rather be seen as a descriptive indication of subject matter: being by or about George Orwell*" (see, to that effect, paragraph 3 of the Interim Decision).

INTA submits that if one were to accept that famous names denote content (namely per the Examiner "by or about" a person) and are for this reason descriptive and therefore non distinctive and exclude them from registration, the same should be accepted for non-famous names. In that line of thought relating to content, the general function of any name is to denote such content. Therefore, finding that famous names are ineligible for registration because of that, would lead to a finding that a) all names are ineligible for registration as they all denote content, namely a *contra legem* finding and b) content is denoted for all goods and services, which would be a finding contrary to consistent EU trademark case law. In the same way that GEORGE ORWELL for class 16 "books" could be seen as denoting a book by or about GEORGE ORWELL, JOHN NICHOLS for class 16 "books" could also be seen as denoting a book by or about JOHN NICHOLS. This would therefore lead to the exclusion of all names from registration not only for books but for any goods or services, something that would go against the express wording of the EUTMR and EUTMD as well as established CJEU case law. Consequently then, not only names, but also any meaningful word could be seen as potentially denoting content of any book, rendering all meaningful word marks unregistrable for "books". INTA therefore submits that a) reputation is not a criterion as such and b) the criterion of "denoting content" as "by or about" is not a criterion as such, since the actual function of any name is to denote "by or about" and should be interpreted restrictively as covering only words that directly describe the goods / services at issue.

It would be counter-intuitive to state that names of famous persons/authors are *per se* non-distinctive because of their fame. At any rate, it must be taken into account that, even assuming that said names are not inherently distinctive, they may have acquired distinctiveness through use under art. 7(3) EUTMR.

From the Interim Decision, it appears that there is a concern about granting an exclusive right on a name of a famous person and barring possible descriptive uses of the same by third parties.

In this regard, INTA stresses, on the one hand, that possible descriptive uses of the names at issue, made in accordance with Article 14 EUTMR, would not amount to trademark infringement and therefore cannot be legitimately barred by the owner of the relevant mark; and, on the other hand, that if the owner of the mark at issue makes only a descriptive use or non-trademark use of said mark it would be exposed to a revocation for non-use of the same.

In other words, barring the registration as a trademark of names of famous persons is not the correct tool to preserve possible descriptive uses of names of famous persons, also because the EU trademark system already provides for specific rules to this end.

CONCLUSION

INTA's views on the case referred to the GBoA are as follows:

Names, including famous persons' names are not *per se* excluded from trademark protection;

Names are explicitly mentioned in the law (EUTMR and EUTMD) as indicative examples of what may be registered as trademark;

Names of authors as well as famous authors are not *per se* excluded from trademark protection with respect to goods such as books, films etc.;

In particular, names of authors may very well serve as an indicator of the origin of the relevant goods/services and be consequently registered as a trademark. It is therefore for the judicator bodies to assess, on a case-by-case basis, whether a specific famous name would be perceived as a distinctive sign in connection with the concerned goods/services, by applying the standard threshold, applicable to all the other signs;

Even if the Office were to find that the mark at issue falls within any of the absolute grounds of refusal set forth under Article 7(1)(b)(c) and (d) EUTMR, the Applicant would anyway be entitled to attempt to establish that said mark has acquired distinctiveness through use under Article 7(3) EUTMR.

ANNEX A

INTA has filed the following *amicus*-type submissions in cases before European courts and judicial bodies:

- Letter of submission to BMW Group on December 23, 2020, in case C-421/20 *ACACIA S.R.L v. Bayerische Motoren Werke Aktiengesellschaft* ([C-421/20](#)).
- Third Party Observations on December 1, 2020, in case R 1304/2020-G, *Der Grüne Punkt Duales System Deutschland GmbH v. Halston Properties, s.r.o. GmbH* ([R 1304/2020-G](#)).
- Letter of submission to Novartis Pharma AG on October 2, 2020 in Joint Cases C-147/20, *Novartis Pharma GmbH v. Abacus Medicine A/S* and C-224/20, *Merck Sharp & Dohme B.V., Merck Sharp & Dohme Corp., MSD Danmark ApS, MSD Sharp & Dohme GmbH, Novartis AG, H. Lundbeck A/S, Ferring Lægemedler A/S v. Abacus Medicine A/S, Paranova Danmark A/S, 2CARE4 ApS* ([C-147/20](#) and [C-224/20](#)).
- Letter of submission to Novartis AG on September 28, 2020, in Joint Cases C-253/20 *Novartis AG v. Impexco NV* and C-254/20 *Novartis AG v. PI Pharma NV* ([C-253/20](#) and [C-254/20](#)).
- Statement of Intervention on January 6, 2016, in the case *DHL Express (France) v EUIPO* ([T-142/15](#)).
- Statement of Intervention on April 25, 2014 in the case *Voss of Norway v OHIM* ([C-445/13 P](#)).
- Written Observations on March 16, 2010 in the case *Nokia Corporation v. Her Majesty's Commissioners of Revenue and Customs* (HMRC) ([C-495/09](#)).
- Letter of submission to Specsavers International Healthcare Limited on August 23, 2012 in the trademark case *Specsavers International Healthcare Limited & others vs Asda Stores Limited* ([C-252/12](#)).
- Letter of submission to Intel Corporation on September 5, 2007, in the trademark case *Intel Corporation v. CPM United Kingdom Ltd.* ([C-252/07](#)).
- Letter of submission to Adidas and adidas Benelux on June 12, 2007 in the trademark case *Adidas and adidas Benelux* ([C-102/07](#)).
- Letter of submission to SARL Céline on April 25, 2006 in the trademark case *SARL Céline v. SA Céline* ([C-17/06](#)).
- Submission as intervener to the English Court of Appeals on October 16, 2006 in the case *Special Effects v L'Oréal SA* (HC 05C012224, Court of Appeal 2006 0744).
- Letter of submission to Bovemij Verzekeringen N.V. on June 17, 2005 in the case *Bovemij Verzekeringen N. V. v. Benelux Merkenbureau* (ECJ - C-108/05).
- Letter of submission to Schering-Plough Ltd. on December 5, 2003 in the trademark case *Schering-Plough Ltd v. European Commission and EMEA* (CFI T-133/03).

- Letter of submission to Merck Inc. on April 4, 2003 in the trademark case *Paranova A/S v. Merck & Co., Inc, Merck, Sharp & Dohme B. V. and MSD (Norge) A/S* (EFTA Court E-3/02).
- Letter of submission to Praktiker Bau - und Heimwerkermarkte AG on March 20, 2003 in the trademark case *Praktiker Bau - und Heimwerkermarkte AG* (ECJ C- 418/02).
- Letter of submission to Shield Mark on November 1, 2001 in the trademark case *Shield Mark v. J. Kist* (ECJ C-283/01).
- Letter of submission to Libertel Groep B.V. on July 6, 2001 in the trademark case *Libertel Groep B.V. v. Benelux Merkenbureau* (ECJ - C- 104/01).
- Letter of submission to Glaxo Wellcome Limited on October 10, 2000 in the trademark case *Glaxo Wellcome Limited v. Dowelhurst Limited and Swingward Limited* (ECJ - C-143/00).