

European Union Intellectual Property Office

Grand Board of Appeal

Alicante, Spain

RE: Cases R 1719/2019-5 and R 1922/2019-5, *The Estate of the Late Sonia Brownell Orwell* ./ EUIPO.

DATE: March 3, 2021

AMICUS BRIEF (THIRD PARTY OBSERVATIONS) – INTERNATIONAL TRADEMARK ASSOCIATION

The International Trademark Association (“**INTA**”) has prepared this brief in relation to cases R 1719/2019-5 and R 1922/2019-5, *The Estate of the Late Sonia Brownell Orwell* ./ EUIPO, pending before the Grand Board of Appeal of the European Union Intellectual Property Office (“**GBoA**”).

Article 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 (“**EUTM**”) and repealing Delegated Regulation (EU) 2017/1430 (“**EUTMDR**”) allows for intervention of interested groups or bodies in EUIPO appeal proceedings referred to the GBoA.

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 CASES

INTA is not a party but believes that these cases are 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.

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CASES' BACKGROUND

In the cases at issue, The Estate of the Late Sonia Brownell Orwell (also referred to as the "**Applicant**") applied to obtain the registration as EUTMs of the following signs:

- a. "**Animal Farm**" (word), in connection with, *inter alia*, "video tapes; audio tapes; compact discs; video discs; laser discs; DVDs; CD-ROMs; electronic publications; digital media and recordings; pre-recorded digital media and recordings; downloadable electronic publications; downloadable digital media and recordings; downloadable digital media and recordings containing sound, images, text or information; webcasts; podcasts; vodcasts; electronically recorded data; downloadable digital media and recordings containing teaching apparatus and instruments; computer games; educational computer games; downloadable computer games; animated cartoons and other imagery; downloadable screensavers, video, games and information; cinematographic films; animated cartoons; movies; magnetic recordings; optical recordings; magneto-optical recordings; solid-state recordings; multimedia discs and publications; multimedia recordings and publications; laser-readable discs; sound recordings; pre-recorded disks; recording disks; gramophone records; compact discs-interactive CD-ROMs; mobile phone games; digital games, mobile phone games; DVD games; pre-recorded audio and video compact discs, DVDs, motion picture films, television programmes and other digital recording media; musical sound recordings; parts and fittings for all of the above goods" in **class 9**; "printed matter; photographs; books; publications; comic books; magazines; newsletters; newspapers; albums;

periodicals; journals; leaflets; posters; instructional and teaching materials; instructional and teaching materials for education and information; book covers; drawings; paintings; prints; pictures in **class 16**; *“games, toys and playthings; electronic games; board games; playing cards; action figures; figurines; electrical and video amusement apparatus and instruments; peripheral devices for use with home video game machines; amusement apparatus for use with a television monitor or some other form of display apparatus; jigsaws; card games; interactive games adapted for use with television receivers; parts and fittings for all of the above goods”* in **class 28**; and *“entertainment; cultural activities; educational services; theme park services; amusement park services; provision of educational services via electronic media, multimedia content, videos, movies, television programmes, pictures, images, text, photos, user-generated content, audio content, and related information via the Internet and other communications networks; providing online entertainment and cultural information by way of multimedia content, podcasts, vodcasts, viral videos, interviews, audio visual programmes, videos, video recordings, photos, images, text, data, games, music, sound recordings and/or films; provision of films, games and audio or visual information online (not downloadable); organisation of events, festivals, seminars, conferences, congresses, workshops, exhibitions, cultural activities, webinars, competitions and / or stage shows; interactive entertainment services in relation to films, sound and /or video recordings; online entertainment services; providing television programme”* in **class 41** (subject matter of case R 1719/2019-5; hereafter also referred to as the “**Animal Farm Case**”); and

- b. “**1984**” (word) in connection with, *inter alia*, *“Video tapes; audio tapes; compact discs; video discs; laser discs; DVDs; CD-ROMs; electronic publications; digital media and recordings; pre-recorded digital media and recordings; downloadable electronic publications; downloadable digital media and recordings; downloadable digital media and recordings containing sound, images, text or information; webcasts; podcasts; vodcasts; electronically recorded data; downloadable digital media and recordings containing teaching apparatus and instruments; computer games; educational computer games; downloadable computer games; animated cartoons and other imagery; downloadable screensavers, video, games and information; cinematographic films; animated cartoons; movies; magnetic recordings; optical recordings; magneto-optical recordings; solid-state recordings; multimedia discs and publications; multimedia recordings and publications; laser-readable discs; sound recordings; pre-recorded disks; recording disks; gramophone records; compact discs-interactive CD-ROMs; mobile phone games; digital games, mobile phone games; DVD games; pre-recorded audio and video compact discs, DVDs, motion picture films, television programmes and other digital recording media; musical sound recordings; parts and fittings for all of the above goods”* in **class 9**; *“printed matter; photographs; books; publications; comic books; magazines; newsletters; newspapers; albums; periodicals; journals; leaflets; posters; instructional and teaching materials; instructional and teaching materials for education and information; book covers; drawings; paintings; prints; pictures”* in **class 16**; *“Entertainment; cultural activities; educational services; theme park services; amusement park services; provision of educational services via electronic media, multimedia content, videos, movies, television programmes, pictures,*

images, text, photos, user-generated content, audio content, and related information via the Internet and other communications networks; providing online entertainment and cultural information by way of multimedia content, podcasts, vodcasts, viral videos, interviews, audio visual programmes, videos, video recordings, photos, images, text, data, games, music, sound recordings and/or films; provision of films, games and audio or visual information online (not downloadable); organisation of events, festivals, seminars, conferences, congresses, workshops, exhibitions, cultural activities, webinars, competitions and / or stage shows; interactive entertainment services in relation to films, sound and /or video recordings; online entertainment services; providing television programmes and films online; advisory, consultancy and information services for all of the above services” in class 41 (subject matter of case R 1922/2019-5; hereafter also referred to as the “1984 Case”),

By decisions of June 5, 2019 (in the Animal Farm Case) and July 4, 2019 (in the 1984 Case), the Examiner refused both EUTM applications (“EUTMAs”) under **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 (“EUTMR”) for all the goods/services above, mainly on the basis that the signs “Animal Farm” and “1984” are famous titles of artistic works and, as such, they would not be perceived by the public as marks indicating the origin of the goods and services applied for.

The Applicant appealed both decisions before the EUIPO Board of Appeals (“BoA”) on August 5, 2019 (in the Animal Farm Case) and August 28, 2019 (in the 1984 Case).

On February 18, 2020 (in the Animal Farm Case) and March 23, 2020 (in the 1984 Case), the BoA sent communications to the Applicant, stressing additional issues related to the marks applied for, apart from them being the famous titles of literary and artistic works. In particular, in the Animal Farm Case, the BoA pointed out that “*animals in farms are a popular and well-known topic in publications related to instructional or entertainment purposes*” (see, to that effect, paragraph 5 of the relevant decision); and, in the 1984 Case that “*consumers within the whole EU will perceive the indication of a year in connection with the concerned goods and services as an information concerning the content or subject matter of those goods and services*” (see, to that effect, paragraph 8 of the relevant decision);

By decisions of June 29, 2020 (in the Animal Farm Case) and July 2, 2020 (in the 1984 Case) the Fifth BoA referred the case to the GBoA (“Interim Decisions”).

In particular, the BoA pointed out that “*the Office and also the Boards of Appeal have issued **diverging decisions** with respect the registrability of titles of books and names of well-known characters of artistic works for goods and services such as ‘videos; CD`s; movies’ (Class 9), ‘printed matter; photographs; books; paintings’ (Class 16), ‘games, toys, figurines (Class 28) or ‘entertainment; cultural activities; educational services’ (Class 41). The consequence is that **some applications consisting of a title of a book or of a well-known character are registered as marks** because they may even, if they are well-known, still be perceived by the public also as an indicator of source for printed matter or education services. In other cases **it has been held that a famous title will be seen as an information of the content or are the subject matter of the goods and services being considered as non-distinctive and descriptive** in the meaning of Article 7(1)(b) and (c) EUTMR” (see, to that effect, paragraphs*

10-11 of the decision in the Animal Farm Case; similarly, paragraphs 13 and 14 of 1984 Case; emphasis added).

Consequently, the Interim Decisions requested that the GBoA establish “***whether the title of a famous and well-known book - as such - will merely be perceived as an indicator of the content or subject matter of books, films, games or entertainment services in Classes 9, 16, 28 or 41, thus being descriptive and devoid of distinctive character pursuant to Article 7(1)(b) and (c) EUTMR or to the contrary there must be present additional factors in order to reach the aforesaid conclusion***” (see, to that effect, paragraph 20 of the decision in the Animal Farm Case; similarly, paragraphs 23 of the 1984 Case; emphasis added).

* * *

REASONS FOR INTA TO SUBMIT THIS BRIEF

The underlying issue in both these cases 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 MÜHLEND AHL, *Concise European Trademark Law*, 2018 page 73), which has given rise to contradictory decisions (some of which are also mentioned in the Interim Decisions).

In particular, these cases concern the possibility of protecting titles of famous and well-known literary and artistic works – such as books, movies, songs and so on – as a trademark: the question posed to the GBoA might lead to the conclusion that signs consisting of titles of famous literary and artistic works, as such, are inherently descriptive/non-distinctive in connection with certain categories of goods/services.

Therefore, the outcomes of these cases might have a disruptive effect especially on undertakings operating in the publishing and entertainment industry. Many registered trademarks consisting of signs which happen to also be titles of artistic works exist in various registries, including that of the EUIPO. The registrability/validity of all those marks and their enforcement *vis-à-vis* third parties might therefore be adversely affected.

INTA submits that it should be avoided adopting *a priori* rules, capable of barring trademark protection to any title of famous artistic works.

It should be noted that this intervention is exclusively related to the specific issue that the Interim Decisions posed to the GBoA, *i.e.*, protectability of titles as trademarks. No position will be taken with respect to the other issues addressed by the BoA.

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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 EUTMR

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.

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II. INTA’s Position

INTA submits that signs corresponding to titles of famous artistic works should not be subject to a special treatment which is more severe than that applied to the other signs which a trademark may consist of. 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 titles of artistic works, should be discouraged.

Consequently, the answer to the question posed to the GBoA should be that signs consisting of titles – including those of famous and well-known literary and artistic works – 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, titles of literary and artistic works may serve as an indicator 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 title of an artistic work – including a famous one – would be perceived as a distinctive sign in connection with the concerned goods/services.

In this last regard, INTA recommends that the GBoA clarifies that titles of artistic works 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).

Lastly, INTA takes the view that the GBoA should give due deference to the fact that, once registered, the scope of protection as trademarks of the signs at issue would not affect the right of third parties to use the relevant titles in a descriptive, non-trademark, manner, in accordance with Article 14 EUTMR.

The reasons supporting INTA's position are detailed below.

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A. Preliminary remarks

Before addressing the specific issue posed to the GBoA, it is worth setting forth some undisputed points, which are useful to consider the matter from the right perspective.

i) Signs Capable of Being a Trademark – 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).

There is no doubt that titles of artistic works – including famous ones – are signs, which can be represented on the Register, capable, at the very least *in abstracto*, of distinguishing the goods of services of one undertaking from those of other undertakings. This is confirmed by the Interim Decisions, the diverging decisions mentioned therein and the current EUIPO Guidelines for Examination in the Office, Part B Examination, 2.7.2 (also referred to as the “**EUIPO Guidelines**”). All these sources support the conclusion that the fact that a sign is a title of an artistic work is not *per se* an obstacle to obtain trademark protection.

Indeed, the Interim Decisions and Examiner's refusals confirm that titles can be registered and function as trademarks and consequently their use be considered as trademark use.

This is compatible with EU Member States' laws that, for instance, expressly provide for titles of magazines and newspapers being eligible for trademark protection (e.g. Article 1 paragraph

2 of pre-existing Greek trademark law No. 2239/1994, *cf* also Article 5 paragraph 1 of German trademark act “*titles of works shall enjoy protection as commercial designations*”) and the relevant case law, which confirmed the same (e.g. Benelux case law *Suske and Wiske*, Court of Amsterdam of 28 July 2004 regarding the “*Suske and Wiske*” comic books stating that *SUSKE EN WISKE*, in general, could serve as an indication of origin for goods from the trademark owner, even for comic books as long as *Suske and Wiske* are not part of such books).

As we will note in detail below, the contradictory BoA decisions and the objections of some of those to the registrability of titles as trademarks concern only cases of famous titles – not the titles as such – and are based on the assumption that the relevant fame results in the mark denoting “*a whole genre or type of story*” in accordance with the current EUIPO Guidelines. The ambiguity of these Guidelines is one of the reasons for the referral to the GBoA (paragraph 22, Interim Decision in the 1984 Case).

It follows that the signs “*Animal Farm*” and “*1984*” should be considered as signs eligible for registration pursuant to Articles 4 and 7(1)(a) and EUTMR, irrespective of the fact that they are the titles of famous books.

ii) Possible cumulation of copyright and trademark protection

Titles of artistic works may enjoy copyright protection in many EU Member States, including Italy, Benelux, Germany, and Greece. However, this circumstance in and of itself has no bearing on the possibilities of securing trademark protection over the same.

It is a settled principle that a sign that consists of copyrighted works/works for which the copyright protection has expired, may be registered as a trademark and there is no ban to cumulate both copyright and trademark protection (this principle was recently confirmed by the EFTA Court, April 6, 2017, E-5/16, *Municipality of Oslo*).

Consequently, the fact that a title of a famous artistic work is/was also protected under copyright in and of itself has no in principle bearing in assessing the possibility of protecting that title as a trademark. This is further confirmed by the precedents mentioned in the Interim Decisions, whereby “*the sole fact that the sign indicated a story protected by copyright does not exclude the possibility of the same sign to function as an indicator of commercial origin by trademark*” (see, to that effect, Second BoA, February 25, 2015, R 1856/2013-2, *Pinocchio*).

It follows that the signs “*Animal Farm*” and “*1984*” should be considered as signs eligible for trademark protection.

iii) Misleading Character - Public Order - Symbols - Bad Faith

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

When the mark has passed the absolute grounds test under Articles 7(1)(a), (b), (c) and (d) EUTMR it may still be barred protection if it is misleading or against public order or if it constitutes symbols which are prohibited from registration on the basis of Article 6*ter* of the Paris Convention, or if it is made in bad faith.

None of the above grounds applies to the present case, as confirmed by the fact that the Interim Decisions do not even mention them.

iv) Scope of Protection / Defenses

It is worth stressing that the scope of protection of an EUTM 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 of the same, would not amount to trademark infringement.

In this regard, see for instance the decision of the General Court of the European Union (GCEU), of May 10, 2006, T-279/03, *Galileo International v. Commission*, EU:T:2006:121, whereby the General Court pointed out that “[b]y choosing the name ‘Galileo’ to designate their trade marks, products and services, the applicants could not deny that they were inspired by the first name of the renowned Italian mathematician, physicist and astronomer, born in Pisa in 1564, who is one of the great names in European culture and scientific history. Thus, the applicants voluntarily exposed themselves to the risk that someone else (in this case, the Commission) could legally – that is to say, without infringing their trade mark rights – give the same famous name to their satellite radio navigation research programme. Furthermore, in 1989, the National Aeronautics and Space Administration (NASA) had already chosen the word ‘Galileo’ to designate a space mission, namely the launch of an observation satellite to the planet Jupiter” (see, to that effect, paragraph 150).

Consequently, it should be taken into consideration that granting trademark protection to the signs “Animal Farm” and “1984” shall not bar possible descriptive uses of said titles, which are meant to remain in the public domain.

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B. Assessment of distinctive character

The GBoA is called to establish whether/to what extent the fact that a sign consists of a title of a famous artistic work may impair its distinctive character as a trademark. More specifically, the GBoA should establish whether a title of a famous artistic work should be considered inherently non-distinctive, without the need to evaluate other factors.

Although the Interim Decisions make 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.

i) Inherent Distinctive Character - Article 7(1)(b) EUTMR

It is settled case-law that the distinctive character of a trademark within the meaning of Article 7(1)(b) EUTMR refers to the sign’s ability 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 [Court of Justice of the European Union (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 the distinctive character 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 (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. In general, a mark is deemed to fulfil its essential function of indicating origin if it departs significantly from the norm and customs of the sector.

In light of the above, in the assessment under Article 7(1)(b) EUTMR it is important to compare the sign applied for with the **norms of the relevant sector at the filing date**.

It follows that, establishing whether a sign 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, 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 title of an artistic work – 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 mark applied for may identify the concerned goods/services as emanating from a single source and, therefore, functions as trademark.

In order to make this assessment, all the circumstances of the case which may have an impact on the public's perception must be taken into consideration. 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 title;
- to look at the kind of uses that the right holder itself has made of the relevant title; and
- to look at possible uses of the title at issue by third parties, with and without the right holder's authorization.

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.

ii) *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, 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 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 General Court ruled in its judgment of June 17, 2009, in 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, 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).

A recurring argument in the decisions refusing trademark protection to signs consisting of titles of famous literary and artistic works on the ground of descriptiveness is that said titles would be perceived as providing information “*on the content or the subject matter*” of the concerned goods and services. This argument is usually based on the EUIPO Guidelines whereby “*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*” (GCEU, June 12, 2007, T-339/05, *Lokthread*, EU:T:2007:172, paragraph 27). Therefore, according to the same Guidelines, “*the essential question is whether the relevant sign consisting of a title of a famous artwork 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 the concerned goods or services”.

We will analyze in more detail the EUIPO Guidelines in paragraph C below to which, therefore, we make reference herein. At any rate, we can already point out that INTA does not find the arguments set forth in the EUIPO Guidelines convincing, also because any meaningful word may indicate something that may possibly be the subject matter of a book. 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).

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's 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 title of an artistic work – 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 (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 [see paragraph II.B.i)].

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

iii) Customary Signs – 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).

Like the assessment of the other two 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’s 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 is a title of an artistic work – including a famous one – 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’s perception [see paragraph II.B.i)].

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

iv) 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 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), (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 Decisions, 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.

* * *

C. The EUIPO Guidelines

In the Interim Decision of the 1984 Case the BoA stresses that “[t]he 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’” (see, to that effect, paragraph 22 of the relevant decision). This ambiguity is one of the reasons which has led to the contradictory decisions related to the protectability of titles.

Therefore, we deem it necessary to analyze in detail what is established, in this regard, in the EUIPO Guidelines.

In particular, the EUIPO Guidelines address this issue in Part B Examination, Section 4 Absolute grounds for refusal, Chapter 4 Descriptive trade marks under Article 7(1)(c) EUTMR, page 383, stating that 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 these Guidelines include the “*kind*”, “*purpose*” and “*other characteristics*”.

i) Kind of Goods or Services

Per the Guidelines (page 385), 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 (GCUE, February 1, 013, T-104/11, *Perle*, EU:T:2013:51,) or ‘Universaltelefonbuch’ for a universal telephone directory (GCUE, June 14, 2001, T-357/99 & T-358/99, *Universaltelefonbuch*, EU:T:2001:162).

The title of a book by its nature does not necessarily describe any kind of goods or services. If the title of a book about 200 flower varieties is “200 flower varieties”, then the title is descriptive of the kind of goods, i.e. a book about flower varieties. However, in most cases the title will not describe the nature of the goods/services claimed under the mark. A book title as a trademark is therefore not *a priori* descriptive of the kind of goods/services claimed under it.

ii) Other Characteristics: Subject Matter/Content

As mentioned above a recurring argument in the decisions refusing trademark protection to signs consisting of titles of famous literary and artistic works on the ground of descriptiveness, is that said titles would be perceived as providing information “*on the content or the subject*” matter of the concerned goods and services [see paragraph II.B, ii)].

The “subject matter/content” is not as such included in the list of elements amounting to descriptiveness, per the wording of Article 7(1)(c) 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 Article 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 EUIPO Guidelines (page 382) considered as “**other characteristic**”. The EUIPO Guidelines expressly clarify that the notion of “*content*” is used interchangeably with “*subject matter*” (page 388), it applies to certain goods and services only (provides books, CDs, films as a typical example, page 403) and it concerns all kinds of marks. One example mentioned in the Guidelines is ROCK MUSIC for CDs (page 388). INTA agrees that such a mark should be ineligible for registration as descriptive of a kind of music.

According to the Guidelines (paragraph 2.7.1, pages 387-388): “*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” (emphasis added).

However, it is doubtful that the average consumer may understand VIVALDI as being a generic term for “music” or any kind of “music”. Likewise, it is doubtful that the average consumer may understand a famous book title as being a generic term for “books” or any kind of “books”.

What the EUIPO Guidelines state (as cited above) 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 EUIPO Guidelines, page 387).

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 EUIPO Guidelines state (page 381): “*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 cannot be employed in the context of titles. The natural meaning of the former relates to a geographical area, which will have a multitude of sources, while the latter to a book title, being one single source (even if it is a series of books). In other words, while a geographical name would *a priori* from its nature signify a region and not a single source, titles 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 GCEU's ruling T-339/05 makes no reference to "content". Neither does the rest of the ruling. Instead, it only refers 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").

With regard specifically to (famous) titles of books, the EUIPO Guidelines state in paragraph 2.7.2 (page 390) that book titles can function as trademarks, unless they describe the subject matter of the goods and services and thus cannot identify the commercial origin of the goods or services.

According to the EUIPO Guidelines, that would be the case if "*the book title may be descriptive under Article 7(1)(c) EUTMR in relation to goods and services that could be perceived as containing or dealing with the well-known story, a new version of it or a theme linked to the story. The reason for this is that certain stories (or their titles) have been established for so long and become so well known that they have 'entered into the language'. 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*".

For example, 'The Jungle Book' or 'Robinson Crusoe' are book titles originally attributable to a particular literary work and a particular author (Rudyard Kipling; Daniel Defoe). Due to the enormous popularity of the books, and facilitated by the passing of time, their titles have, in the public's perception, gradually gained a thematic significance, which extends beyond the actual content of the books concerned. They have entered into everyday language as synonyms for a particular type of story or genre (e.g. young humans succeeding on their own in the wilderness; struggle against nature, hardship, privation, loneliness)"

INTA shall not in the present brief express any opinion as to whether these words do have the "semantic significance" and generic content mentioned above, as this is a factual issue.

Furthermore, the EUIPO Guidelines state that "(...) *The assessment of whether a book title has reached a sufficient degree of recognition depends on a thorough case-by-case analysis, taking account of the particularities of the individual case*".

The EUIPO Guidelines (page 390) give certain (non-exhaustive) considerations to assist in evaluating whether a specific title can function as a trademark, those being adaptations, cultural heritage and time.

a. Adaptations

We understand that, per the EUIPO Guidelines, the more adaptations have been made of a story the less distinctive the title will be. As argued further on, INTA believes this to be a

criterion which leaves ample room for subjective interpretation and thus diverging decisions [see also the references to adaptations contained in paragraph II.C.iv) below].

b. Cultural Heritage

In this respect, it is noted that books that have become ‘classics’ or have a certain educational value, may, as a result, have become part of the “cultural DNA” of the general public, possibly rendering them unsuitable to function as trademarks. INTA submits that this would render any famous mark unsuitable as a trademark (see the example of COCA COLA further on).

c. Time

The EUIPO Guidelines establish that the more time has passed since the first publication, the more likely it is that the title has reached an autonomous status and is no longer connected to a specific author or story. INTA does not share this view, as this would mean that any title which *a priori* could serve (and may have served) as a trademark can no longer do so, just because of the mere passing of time, even though the trademark has been properly used and perhaps has even gained repute.

iii) Defining Content

Per the EUIPO Guidelines, the “content/subject” matter is denoted because the mark will be “*linked*” to a specific “*thing, product or activity*” (page 387).

Under a different paragraph in the EUIPO Guidelines (*ibid*, page 388), a name shall signify the content/subject matter because the mark will “*indicate the category*” in which the said goods belong (Guidelines, *ibid*: “*They have entered into everyday language as synonyms for a particular type of story or genre*”, page 390), 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. Per the EUIPO Guidelines a famous composer’s name will “*immediately create a link to the famous composer, just as the term ‘skis’ will immediately create a link to the sport of skiing. [...]*”.

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: the titles ‘The Jungle Book’ or ‘Robinson Crusoe’ are not the name of any goods or services and do not “immediately” create a link to any goods or services, whereas “skis” is the name of certain goods and do denote such goods.

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

As already mentioned, the Interim Decision of the BoA in the 1984 Case stated in paragraph 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 book title*”.

INTA submits that this uncertainty stems from the fact that famous titles 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 and certainty 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*, page 389), 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 EUIPO Guidelines (p. 389), for example COMEDY filed for television broadcasting, "except for comedy programming" will still raise objections.

iv) Link

As aforementioned, it is not clear whether the "link" in the content/subject matter test according to the EUIPO Guidelines means the link to the "*thing, product or activity*" or the link to the book category 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 any kind of "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 title as basis of the subject matter test, it is noted that it is not clear from the EUIPO Guidelines whether this link establishes descriptiveness or excludes it. Namely:

- In the Guidelines it is mentioned (paragraph 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 paragraph 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 the work of both the above cited paragraphs it follows a *contrario* that for as long as a title is connected to a particular book, the mark is not descriptive of the subject matter.

The reasoning of the Examiner in the 1984 Case (mentioned in paragraph 5 of the relevant Interim Decision) is that the ANNE FRANK case is not analogous to the present case, since ANNE FRANK is an autobiographic story which does not lend itself to significant re-imaginings, whereas ‘1984’ according to the Examiner would fall in the category of THE JUNGLE BOOK and PINOCCHIO, which have gained the status of fables with multiple adaptations weakening the link with the underlying original work.

In fact, there have been a few adaptations of Anne Frank, such as a picture book and a novel for (younger) children with the Anne Frank story. It appears that the Examiner finds that the threshold is whether a work “*lends itself to significant re-imaginings*”. INTA submits that this seems to be a rather arbitrary criterion, as it is unclear what qualifies as ‘significant’. Furthermore, it seems that the threshold would already be met if the story would be suitable for re-imaginings, regardless of whether actual adaptations have been made.

In such cases it would follow that the title could not function as a trademark for the original book. INTA believes this reasoning is arbitrary, as three adaptations may not be significant but six would? And how is it decided which story is capable of being adapted? In theory, any story is capable of being adapted, even if it is an autobiographical story.

Therefore, the adaptations’ criterion as such could not provide a safe framework. If what is aimed at is establishing whether the title has become “generic” so as to denote a specific genre, then all relevant circumstances and evidence of the case should be taken into account. Adaptations as such, given that they relate to copyright exploitation, would be irrelevant in the trademark context.

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.

v) Genre/Category

In the case at hand, the titles 1984 and ANIMAL FARM have not been found by the Examiner or the Interim Decisions as denoting a certain genre or category.

vi) Reputation

The argument that the possible fame renders the title 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 the absurd conclusion that any famous mark would be ineligible for registration after acquiring reputation. COCA COLA marks are linked in the mind of consumers worldwide to soft drinks. This link and reputation alone do 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, paragraph 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 titles), 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 title or any other kind of mark, would be refused registration.

vii) Source Indicator

The fact that a famous title, just as any other title, 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’**”.*

viii) Other criteria

INTA submits that criteria such as whether the book written by the person is autobiographical (paragraph 4 of the Interim Decision in the GEORGE ORWELL case “*refers not simply to a name but rather to an autobiographical work*”) or whether the person published one or several books (paragraph 4 of the Interim Decision in the GEORGE ORWELL case “*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.

Paragraph 20 of the Interim Decision in the 1984 Case refers to the decision of 02/02/2015, R 881/2014-5, Der kleine Hey, paragraph 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.

* * *

INTA submits that the criteria above 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 EUIPO Guidelines under which “[o]bjections 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)” (see, to that effect, page 403; emphasis added)

In light of the above, INTA takes the view that the mere fact that a sign for which a trademark application has been filed is a title of an artistic work – 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, as confirmed in the decision of the Fourth BoA, August 31, 2015, R 2401/104-4, *Anne Frank* under which “[t]he expression ‘Anne Frank’ **is in no way descriptive and strictly speaking does not mean anything**” (see, to that effect, paragraph 26 of the relevant decision).

* * *

D. The BoA Case law

With regard to the case-law mentioned in the Interim Decisions, INTA submits the following (the rulings are mentioned in chronological order starting from the earlier ones):

i. The Pinocchio Ruling

In the decision of February 25, 2015, R 1856/2013-2, *Pinocchio*, the BoA found that: “*the cancellation applicant **has not proved that the term ‘PINOCCHIO’ is generic or usual with regard to these goods and services covered by the CTM, for the purpose of identifying or distinguishing those goods and services**” and that “[...] the contested mark **does not give the CTM proprietor a monopoly over a term which is common in the commercial field to which these contested goods and services belong, or deprive other traders of an essential and***

widely used term to describe their goods and services. The continuance of the registration of the contested CTM represents no restraint of trade” (see, to that effect, paragraphs 36-37 of the decision; emphasis added). It nevertheless annulled the mark finding that “it has entered into the language” because it has been used for a long time.

INTA submits that this (earlier) ruling in *Pinocchio* appears to go beyond the test on descriptiveness and distinctiveness when it finds that: “it has been found that if a title is famous enough to be truly well known to the relevant public where the mark can be perceived in the context of the goods/services as primarily signifying a famous story or book title, a mark may be perceived as nondistinctive. A finding of non-distinctiveness in this regard will be more likely where it can be shown that a large number of published versions of the story have appeared and/or where there have been numerous television, theatre and film adaptations reaching a wide audience. ‘PINOCCHIO’ belongs to the category of titles described above. It is indeed a title of a story that is long established and well known as a reference to a children story” (see, to that effect, paragraph 26 of the relevant decision). The above merely states that the title of this book is a famous title and is well known among the public without providing a reasoning why this constitutes the mark non distinctive. Furthermore there is no reasoning explaining why simply the time of use renders a mark generic, if this is what is meant by “entering into the language” (paragraph 26: “PINOCCHIO has been established for so long that it has ‘entered into the language’”).

ii. The Jungle Book Ruling

In the decision of March 18, 2015, R 118/2014-1, *The Jungle Book*, the BoA stated, in paragraph 24, that where the public perceives a sign purely as a reference to the author’s work or type of story without any additional element which could impart distinctive character to the sign indicating the business origin, it is to be considered as descriptive and non-distinctive in the context of goods and services such as indicated above. The BoA based its ruling by analogy to the decision of March 14, 2008, R 670/2005-1, *Frühlingsfest der Volksmusik*, paragraphs 38-40, which however merely stated that the words “Frühlingsfest der Volksmusik” which in English mean “Spring Festival of Folk Music” were found, under the general descriptiveness and non distinctiveness tests, unregistrable.

The decision of March 14, 2008, R 670/2005-1, *Frühlingsfest der Volksmusik*, paragraphs 38-40 stated, in particular, that titles are registrable: “Moreover, a juxtaposition of the two property rights on the basis of the different objectives of trade mark protection and title protection (indication of origin on the one hand, description of the intellectual performance in the form of a name, with greater reference to the content, on the other) fundamentally appears meaningful **provided the sign applied for has an indication of origin function**, i.e. it has distinctive character. **Therefore, the sole relevant factor here is whether the sign applied for is also understood at least as an indication of origin**, i.e. as a sign which ensures the identity of origin of the goods or services characterised” (emphasis added). INTA submits that the above reasoning is clear and in accordance with the CJEU’s interpretation of the descriptiveness and distinctiveness tests. Words that directly denote the subject matter should be refused registration.

INTA agrees with the BoA holding in paragraph 23 of the *Jungle Book* ruling that “The title of an (artistic) work may benefit from trade mark protection and, where appropriate, title protection (indication of origin on the one hand, description of the author’s intellectual performance in the form of a name, with greater reference to the content, on the other)

provided that, as far as trade mark protection is concerned the sign applied for has an indication of origin function, i.e. it has distinctive character”.

INTA however disagrees with the holding in paragraph 24 which states: *“However, this would not be the case when the sign applied for is purely understood as a reference to the author’s work or type of story without any additional element which could impart distinctive character to the sign indicating the business origin”.*

INTA submits that due to the nature of the title of any book it is always understood (at least) as the name of the literary work at issue (namely as a title). To the extent however that titles are registrable under EUTMR this perception would not be enough to preclude titles of books from registration: the very fact that, as we have seen above [see *supra* paragraph II.A.i)], titles should be considered as signs eligible for registration pursuant to Articles 4 and 7(1)(a) EUTMR means that they necessarily may function as trademarks *a priori*. The, posterior to this ruling, case law mentioned below clarifies the issue in stating that only when the mark has become generic (or is otherwise unregistrable) registration shall be refused.

Furthermore, INTA does not find the argument that Jungle Book denotes a genre of books consisting of *“life stories of young humans succeeding on their own in the wilderness”*, as stated in paragraph 29 of the ruling, persuasive. This argument led to the finding that the mark is unregistrable (paragraph 29: *“The sign applied for, therefore, lacks inherent distinctive character since the relevant public will instantly understand it as providing some kind of information relating to the goods or services designated, i.e. exclusively as a claim indicating the relationship with ‘THE JUNGLE BOOK’ story, a genre which always relates or adapt the life stories of young humans succeeding on their own in the wilderness, and not as indicating the commercial origin of those goods and services (see, by analogy, 08.05.2008, C-304/06 P, Eurohypo, EU:C:2008:261, § 69)”*.

Lastly, it is noted that another ruling on which the *Jungle Book* decision was based was the *Dr No* decision (GCEU’s decision of June 30, 2009, T-435/05, *Dr. No*). INTA reiterates that this ruling cannot be taken as a basis for a finding of descriptive character/lack of distinctiveness because this decision addressed a different issue, i.e., 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.

iii. *The Journal D’ Anne Frank Ruling*

The BoA in R 2401/2014-4 of August 31, 2015, *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 MERLIN'S KinderWelt Ruling

In T-566/15, *Excalibur City s.r.o. v. EUIPO*, of September 20, 2016, paragraphs 33 and 34, the GCEU stated:

*"In the first place, as regards the distinctive elements of the mark applied for, it must be noted that, **although the relevant public may understand that the element 'merlin's' refers to an emblematic character of Arthurian legend ('Merlino' in Italian), that element will nevertheless not be perceived by the relevant public as being capable of designating the services covered by the mark applied for or a characteristic of those services. Thus, as the applicant claims, the fact that the element 'merlin's' has a meaning for the relevant public does not necessarily lead to the conclusion that that term is descriptive of the services at issue. According to settled case-law, a term with a clear meaning is considered to be descriptive only if there is a sufficiently direct and specific relationship between that term and the goods and services in question to enable the public concerned immediately to perceive, without further thought, a description of the goods and services in question or one of their characteristics (see judgment of 22 June 2005, *Metso Paper Automation v OHIM (PAPERLAB)*, T-19/04, EU:T:2005:247, paragraphs 24 and 25 and the case-law cited). In the present case, however, there is not a sufficiently direct and specific relationship between the meaning of the term 'merlin's' and the services covered by the mark to enable the relevant public immediately to perceive, without further thought, a description of those services or, as EUIPO and the intervener claim, one of their characteristics. The term 'merlin's' cannot be regarded as being descriptive of the services covered by the mark applied for, that is to say, services intended to entertain, referred to in paragraph 3 above, where it has not been established that it is used in business to designate a characteristic of those services. The fact that a term such as 'merlin's' may be evocative, in some circumstances, of the specific theme of Arthurian legend does not mean that it is descriptive of the services covered by the mark applied for or of one of their characteristics. [...] The Court therefore finds, contrary to the assessment made by the Board of Appeal in that regard, that the word element 'merlin's' in the mark applied for has an average degree of distinctiveness"***.

INTA agrees that the fact that the name of a fictional character may be well-known, does not automatically mean that such name is descriptive or devoid of distinctive character.

Such a name will only be descriptive where **"it is used in business to designate a characteristic of those services"**.

v. The Winnetou Ruling

The BoA in R1297/2016-2 of March 22, 2018, *Winnetou*, paragraph 38, stated: **"By way of a preliminary point, it should be stated that a fictional literary character is regarded as a fanciful term and is therefore eligible for protection as a trade mark, at least in principle, irrespective**

of whether or not that term has entered the public domain under copyright law (02/02/2015, R 881/2014-5, DER KLEINE HEY, § 20). **The reputation of the character is not sufficient in itself to deny that term the capability of being perceived as an indication of commercial origin, as even if the relevant public recognises the name of the literary character as such, that name may nevertheless be understood as a trade mark** (20/09/2016, T-566/15, MERLIN'S KinderWelt / KINDER et al., EU:T:2016:517, § 33)" (emphasis added).

INTA agrees with the above finding of the BoA that the fact that the name of a fictional character may be well-known does not mean that such name is descriptive or devoid of distinctive character and that it may not be understood as a trademark.

It is noted that the BoA further in that ruling found that the mark WINETTOU (paragraphs 39 – 41, emphasis added) "*gradually began to become independent as a concept of the character invented by Karl May. A Winnetou cult following emerged, and Winnetou transformed into some kind of symbol for the good, fair Native American, the topos of the 'noble savage', within the Wild West genre in literature and film" and "This development and gradual independence of the term 'Winnetou' also moved in a different, less elevated direction, in the sense that the mention of Winnetou, originally a specific reference to the novel character or the works of Karl May, increasingly became **a general reference to the fictional world of Native Americans** within the Wild West genre already defined above [...] the term 'Winnetou' had therefore acquired up to two secondary meanings that the Board believes to be descriptive [...]"*.

Here the BoA confirmed that **it was not** reputation that led to its conclusion that the mark was descriptive, on the contrary, such reputation and specific reference to the fictional character confirmed the mark's distinctiveness and non-descriptiveness. According to the BoA, under the evidence presented, it was a secondary meaning that had developed, independent of the fictional character, which led to the mark's unregistrability. Irrespective of whether such "symbol" (and not a concrete finding that the term is a generic term for the goods/services each time at hand) is enough to confirm descriptiveness, which shall not be analyzed in the present brief, there is no allegation by the Examiner that any of the titles at issue in the present cases has developed any particular secondary meaning whatsoever and has become the symbol of anything. Neither is there any allegation that the marks at issue have become generic of any kind of goods/services and, in particular, the goods/services at issue.

It is noted that this WINETTOU BoA ruling was issued following an appeal before the GCEU which cancelled the first WINETTOU ruling of the BoA (R 125/2012-1 of 9 July 2013) due, *inter alia*, to inadequacy of reasoning (T-501/2013, paragraph 62). This annulled first WINETTOU ruling was also mentioned as basis of reference in the *Jungle Book* ruling R 118/2014-1 of the BoA, issued on March 18, 2015 (in paragraph 33), namely before its annulment by the GCEU. The ruling R 118/2014-1 had found that "Jungle Book" was descriptive as denoting a characteristic of the goods. In the *Jungle Book* case, the BoA considered as evidence the UKIPO Guidelines where they state that "**Where other traders have become accustomed to using the name in trade without the applicant's consent prior to the date of application, the mark may have become generic in trade (cf. Article 7(1)(d) CTMR)**" (paragraph 4, emphasis added). It is clear that the UKIPO Guidelines refer to use "in trade" and to unauthorized use by third parties in trade, which may lead to a genericification of the mark. They do not infer descriptiveness from reputation.

No evidence that other traders have become “accustomed to using” the titles of the books at issue without the applicant’s consent has been submitted per the Examiner’s decision. On the contrary, per the same decision, evidence has been submitted that the applicant of the marks controls such uses.

The above mentioned (second) BoA *WINETTOU* ruling refers to the previous GCEU ruling on *MERLIN*.

* * *

E. Overall Evaluation

As seen above, titles of artistic works – including famous ones – are signs, which can be represented clearly and precisely, capable, *in abstracto*, of distinguishing the goods of services of one undertaking from those of other undertakings. Therefore, the signs “Animal Farm” and “1984” should be considered as signs eligible for registration pursuant to Articles 4 and 7(1)(a) EUTMR, despite the fact that they are also the titles of famous books.

Likewise, the signs “Animal Farm” and “1984” should be considered as signs eligible for trademark protection, despite the fact that they are the titles of famous books which have enjoyed copyright protection (or other kinds of exclusive rights in the Member States).

Turning to the issue posed to the GBoA, it follows from the above that the fact that a sign is a title of a famous artistic work is not *per se* sufficient to establish that the same falls within the absolute grounds of refusal set forth in Article 7(1)(b), (c) and (d) EUTMR (see also Fourth BoA, August 31, 2015, R 2401/104-4, *Anne Frank*, *ibid*, paragraph 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?’*”).

Indeed, establishing whether a sign falls within any of the absolute grounds of refusal set forth in Article 7(1)(b), (c) and (d) EUTMR, is a complex assessment which must be carried out by considering various factors and all the circumstances of the case, taking into account that the public’s perception may vary over time. What is essential is whether the mark may identify the goods as emanating from one single commercial source. The possible fame as such is not a separate criterion. To make this assessment it is instead necessary to take into consideration all the circumstances of the case, which may have an impact on the public’s perception [see paragraph B, i)]. At any rate, it must be taken into account that, even assuming that the signs at issue are not inherently distinctive, they may have acquired distinctiveness through use under Article 7(3) EUTMR.

It must be stressed that neither the EUIPO Guidelines nor the BoA case law may call the above conclusions into question for the reasons outlined above (see *supra* paragraphs II.C and D).

Based on the Examiner’s reasonings reported in Interim Decisions, as well as on the EUIPO Guidelines and the BoA case law, it seems that one of the concerns with respect to protectability of titles of famous artistic works as trademarks is to avoid granting exclusive rights to the titles of famous literary and artistic works that could end up barring possible descriptive uses of said titles, which should remain in the public domain. In this regard, we must stress, on the one hand, that possible descriptive uses of the signs 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 marks at issue makes only a descriptive use of said marks, it would be exposed to a revocation for non-use of the same. For example, assuming that a sign such as the “Divine Comedy” were to be granted trademark registration, on the one hand, said registration could not be used to bar a third party from using the relevant title to reprint and publish the public domain work the “Divine Comedy” by Dante Alighieri, or even make a television series or comic book series based on the “Divine Comedy”; and, on the other hand, the use of the sign “Divine Comedy” in connection with the work in the public domain the “Divine Comedy”, by Dante Alighieri, would not amount to genuine use of the relevant mark. In other words, barring the registration as a trademark of names of titles of famous artistic works 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

In light of the above, INTA supports the following conclusion:

Signs consisting of titles of literary and artistic works, including famous ones, are not *per se* excluded from trademark protection.

The fact that a sign is a title of a famous artistic work is not *per se* sufficient to establish that the same falls within the absolute grounds of refusal set forth in Article 7(1)(b), (c) and (d) EUTMR. Indeed, establishing whether a sign falls within any of the absolute grounds of refusal set forth in Article 7(1)(b), (c) and (d) EUTMR is a complex assessment which must be carried out by considering various factors and all the circumstances of the case, taking into account that that the perception of the public may vary over time.

Lastly, even if the GBoA 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 marks have 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).