



*INTA News*

## INTA Files Amicus Briefs on Famous Names, Book Titles as Trademarks in EU

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**Micheline Don**, Parker Advocaten Amsterdam, Netherlands International Amicus Committee - Europe Amicus Subcommittee

INTA recently filed two amicus briefs before the Grand Board of Appeal (GBoA) of the European Union Intellectual Property Office (EUIPO) in three parallel cases—one in cases R 1719/2019-5 and R 1922/2019-5, and one in case R 2248/2019-5. The parties in the three cases are the Estate of the Late Sonia Brownell Orwell and the EUIPO.

The Association intervened as amicus curiae as permitted under EU trademark law, which allows interested groups or bodies to intervene in EUIPO appeal proceedings referred to the GBoA. Art. 37(6) of Commission Delegated Regulation (EU) 2018/625 of Mar. 5, 2018, supplementing Regulation (EU) 2017/1001 of the European Parliament and of the Council on the EUTM, and repealing Delegated Regulation (EU) 2017/1430 (EUTMDR).

The cases address whether (famous) names and titles (in this case trademark applications for GEORGE ORWELL, ANIMAL FARM, and 1984) can be registered as trademarks for books and films, or entertainment, cultural, or educational services. It also addresses whether such marks should be considered descriptive of the claimed content or subject matter of the goods or services and therefore not able to function as trademarks.

The EUIPO partially rejected the applications for these trademarks, ruling that they were famous titles of books (ANIMAL FARM and 1984) and a famous author name (GEORGE ORWELL) respectively, and would thus be perceived by the public as such and not as a mark indicating the origin of the goods and services at hand.

The applicant appealed all three cases. Pending the appeals, the Fifth Board of Appeal noted that there have been diverging decisions with respect to the registrability of titles of books and names of well-known characters of literary and artistic works for certain goods and services.

In view of this, the Board of Appeal asked the GBoA whether the name of a famous person or title of a famous book would be perceived as merely an indicator of the content or subject matter of books and films, games or entertainment, cultural, or educational services in Classes 9, 16, or 41, being thus descriptive and devoid of distinctive character, or to the contrary could serve as a trademark and whether additional factors must be present to find them descriptive.

## **INTA's Key Arguments**

### ***Acceptable as Trademarks***

In the briefs, INTA noted that names are explicitly mentioned in the relevant law (European Trade Mark Regulation and European Trade Mark Directive) as

indicative examples of what may be registered as trademarks. Furthermore, the EUIPO Guidelines state that book titles in principle can function as trademarks.

### *Case-by-Case Evaluation*

Moreover, INTA argued that signs consisting of names of famous authors and titles of famous literary and artistic works should not *per se* be excluded from trademark protection and should not be subject to special treatment that is more severe than that applied to other potential trademarks. Whether they should be barred from registration is a complex assessment. This must be made on a case-by-case basis considering various factors and all the circumstances of the case, including that the perception of the public may vary over time.

### *Not Inherently Descriptive*

INTA further noted that the name of an author or title of a book by its nature does not necessarily describe any kind of goods or services. The average consumer will not understand the name or title as being a generic term for “books” or any kind of “book”. Unless the title is purely descriptive of the subject matter of the book (for instance, *One Hundred Flower Varieties* for a book about 100 flower varieties), INTA argued that in most cases the title will not describe the nature of the goods or services claimed under the mark. Any meaningful word may indicate something that could be considered the subject matter of a book. That would render all titles ineligible for registration, which is not the case. Famous titles are not because of their fame *per se* descriptive of any goods or services, as that would make all famous marks ineligible for registration after they have acquired reputation.

The authors of the amicus briefs were Micheline Don (Parker Advocaten, the Netherlands), David Parrish (CMS, UK), Noemi Parrotta (Spheriens, Italy), and Marina Perraki (Tsibanoulis & Partners, Greece), all members of the International Amicus Committee—Europe Amicus Subcommittee.

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