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**DECISION
of the Fourth Board of Appeal
of 16 November 2017**

In Case R 2063/2016-4

Giraffen houden van Wodka B.V.

Anton Philipslaan 82
5616 TX Eindhoven
Netherlands

Applicant / Appellant

represented by De Merkplaats B.V., Herengracht 227, 1016 BG, Amsterdam,
Netherlands

APPEAL relating to European Union trade mark application No 14 679 351

THE FOURTH BOARD OF APPEAL

composed of D. Schennen (Chairperson), R. Ocquet (Rapporteur) and L. Marijnissen
(Member)

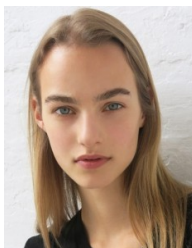
Registrar: H. Dijkema

gives the following

Decision

Summary of the facts

- 1 By an application filed on 14 October 2015, **Maartje Robin Elke Verhoef** ('the original applicant') sought to register the figurative mark:



as a European Union trade mark ('EUTM') in respect of the following goods and services:

Class 3 – Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; make-up preparations; cosmetics; skincare cosmetics; creams (cosmetic -); nail cream; nail polish; make-up removing preparations; disposable wipes impregnated with cleaning substances or compounds for personal hygiene; nail polish remover; cosmetic bath and shower gels and body lotions; cosmetic products for personal care; creams, gels, sprays, mousses and balms for hair styling and hair care; shampoo; perfumery; toilet water; soaps; toiletry preparations; preparations for hair care; deodorant for personal use; essential oils; cosmetic lotions; sun care preparations; sun blocking preparations [cosmetics]; sun-tanning preparations; after-sun products; cosmetic bath salts; potpourris [fragrances]; hair lotion; dentifrices.

Class 9 – Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; compact discs, DVDs and other digital recording media; mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment, computers; computer software; fire-extinguishing apparatus; applications for tablets and mobile telephones; electronic publications; computer databases and data files; sunglasses; sunglass lenses and mounts; cases, chains and cords for sunglasses; protective clothing, helmets and goggles.

Class 14 – Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes, namely amulets, bracelets and anklets, chains, pendants, clocks, beads for making jewellery, works of art, lockets, cuff links, earrings, lapel pins, rings, ornaments, key rings (trinkets or fobs), ornamental pins and tie pins; works of art of precious metal; jewellery, precious stones; horological and chronometric instruments.

Class 16 – Paper, cardboard; printed matter, including books, newsletters, newspapers, magazines, brochures, leaflets and other texts and publications; bookbinding material; photographs; cards; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks; non-encoded information cards, including for identification, credit, saving and payment purposes made of paper, cardboard or plastic; customer cards and discount cards, not equipped with a magnetic strip; gift packaging of cardboard (boxes).

Class 18 – Leather and imitations of leather, and goods made of these materials and not included in other classes, namely luggage labels, purses, pouches, credit card holders and key cases; bags,

handbags, travel bags, toiletry bags, make-up bags and trunks; parasols and umbrellas; pocket wallets and purses; animal skins, hides; whips, harness and saddlery.

Class 25 – Clothing, footwear, headgear; belts; shawls; underwear; lingerie.

Class 35 – Advertising; business management; business administration; office functions; personnel recruitment, including bookings; temporary assignment of employees; the aforesaid services including with regard to models and photo models; services of models and photo models for advertising and sales promotion; merchandising and business consultancy thereon; sales promotion; business management of performing artists; arranging and conducting of promotional events and activities, including openings, demonstrations and product presentations; arranging and conducting publicity and advertising events; commercial management; publication of publicity texts; dissemination of advertising articles and advertising material; publicity; public relations services; organisation of trade fairs, exhibitions and other events for commercial and advertising purposes; demonstration of goods; retailing or wholesaling in connection with bleaching preparations and other substances for laundry use, cleaning, polishing, scouring and abrasive preparations, soaps, perfumery, essential oils, cosmetics, hair lotions, dentifrices, pharmaceutical and veterinary preparations, sanitary preparations for medical purposes, dietetic food and substances adapted for medical or veterinary use, food for babies, dietary supplements for humans and animals, plasters, materials for dressings, materials for stopping teeth, dental wax, disinfectants, preparations for destroying vermin, fungicides and herbicides, scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments, apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity, apparatus for recording, transmission or reproduction of sound or images, magnetic data carriers, recording discs, compact discs, DVDs and other digital recording media, mechanisms for coin-operated apparatus, cash registers, calculating machines, data processing equipment and computers, computer software, fire-extinguishing apparatus, sunglasses, vehicles and parts therefor, apparatus for locomotion by land, air or water, precious metals and their alloys, jewellery, precious stones, horological and chronometric instruments, paper, cardboard, printed matter, bookbinding material, photographs, stationery, adhesives for stationery or household purposes, artists' materials, paint brushes, typewriters and office requisites, instructional and teaching material, plastic materials for packaging, printers' type, printing blocks, leather and imitations of leather, leatherware, animal skins, hides, trunks and travelling bags, bags, umbrellas and parasols, walking sticks, whips, harness and saddlery, clothing, footwear, headgear, belts, furniture, mirrors, picture frames, household or kitchen utensils and containers, combs and sponges, brushes, brush-making materials, articles for cleaning purposes, steel wool, unworked or semi-worked glass, glassware, porcelain and earthenware, textiles and textile goods, bed covers, table covers, games and playthings, gymnastic and sporting articles, decorations for Christmas trees, foodstuffs and beverages, grains and agricultural, horticultural and forestry products, live animals, plants and flowers, foodstuffs for animals; compilation of statistics; market prospecting, research and analysis; opinion polling; compilation of information into computer databases; data file administration; organisation of trade fairs and exhibitions for commercial or advertising purposes; information and consultancy relating to the aforesaid services; all the aforesaid services whether or not provided via electronic channels, including the Internet.

Class 41 – Education; providing of training; entertainment; sporting and cultural activities; modelling; coaching of models and photo models; organisation, production and implementation of festivals, concerts, tours, theatre productions and other events (not for commercial purposes); production and performance of music and entertainment programmes and broadcasting them on television, radio, the Internet and other media; production of television and radio programmes; film production services; entertainment including via radio, television and the Internet; providing electronic publications online; editing, storing and digitising of images and sounds for others; arranging and conducting congresses, seminars, symposiums, lessons and workshops; rental of motion pictures; arranging stage and music shows; producing and conducting music and entertainment programmes; publication, lending and distribution of books, newspapers, magazines, periodicals and other printed matter via electronic channels and otherwise; arranging of trade fairs, exhibitions and events for cultural and educational purposes; electronic library services for the supply of electronic information (including archive information) in the form of text, sound information and/or recorded image material (video); information and consultancy

relating to the aforesaid services; all the aforesaid services, including provided via electronic channels, including the Internet.

Class 42 – Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; design in the field of fashion; fashion design; information and consultancy relating to the aforesaid services; all the aforesaid services, whether or not provided via electronic channels, including the Internet.

Class 44 – Medical services; veterinary services; hygienic and beauty care for human beings or animals; agriculture, horticulture and forestry services; consultancy and services in the field of hygiene, nutrition, fitness, physical and mental health, physiotherapy and beauty care for human beings or animals; applying make-up and cosmetology; running of bathhouses, spas and saunas; consultancy and information relating to the aforesaid services, including via electronic networks such as the internet.

- 2 On 6 November 2015 the examiner informed the applicant that on the basis of Article 7(1)(b) and (c) of the European Union Trade Mark Regulation ('EUTMR') the trade mark applied for was partially descriptive and devoid of any distinctive character in respect of the goods and services for which registration was sought.
- 3 On 16 December 2015 the applicant filed a response defending the application, which can be summarised as follows:
 - The trade mark is not descriptive. Images that provide an indication of the intended purpose of a particular product or the provider of the service are very commonly used and registered.
 - In this case, when assessing the mark's distinctive character, the Office must take the image as a whole (face, colours and background) into account, as well as the familiarity of the person in question (Annex 2).
 - The Office has previously accepted portrait marks (Annex 1).
- 4 On 18 March 2016, in response to the applicant's arguments, the examiner issued notification of a second provisional refusal, which can be summarised as follows:
 - The image does not have any particular characteristic capable of influencing the memory of consumers to such an extent that they are able to distinguish the goods and services in question from others. Considered as a whole, the mark applied for comprises nothing more than an image (a portrait photo) that can be used to present the goods and services concerned. This form of presentation does not differ substantially from other faithful representations of a woman's head/face and is merely a variation.
 - Such a 'portrait' must have acquired some familiarity if it is to be regarded as a trade mark. Prima facie the European consumer will see only an image of the head/face of a (young) woman and not necessarily that of Maartje Verhoef.
 - The descriptive character of the sign (a photo of a woman's head/face) is therefore inseparable from some of the goods and services to which the application for registration relates, in so far as the image (photo) represents

the category for whom the goods are intended, namely women, and, with regard to the services in Classes 35, 41 and 42, in so far as the image merely represents the model or fashion designer concerned in person or, with regard to the services in Class 44, represents the person who provides the services.

- Although the sign has no direct or indirect descriptive meaning in respect of other goods and services, the Office finds (bearing in mind that specific characteristics of the mark applied for, including the colours and background, are meaningful and common) that the image is not capable of distinguishing the applicant's goods and services immediately and with certainty from those of a different commercial origin. There are countless photos of women's heads/faces in all manner of fields.
- The material submitted has not proven anything to the contrary. Without expressly referring to Article 7(3) EUTMR, the applicant seems to be implying that her trade mark has achieved market acceptance. The familiarity of the applicant as a model (Annex 2) in no way justifies the conclusion that the relevant public in the Member States, or in non-Member States, would perceive her image as an indication of origin.
- A figurative mark that prima facie is devoid of distinctive character will not be recognised as a trade mark in any Member State.
- As regards the overview of accepted marks, it is important to stress that every case has to be assessed on its own merits.

5 The applicant did not submit any further comments.

6 In a decision of 13 September 2016 ('the contested decision') the examiner refused the trade mark application for all the goods and services on the grounds already set out in the provisional refusals.

7 On 11 November 2016 the applicant filed a notice of appeal against the contested decision, followed by a statement of grounds of appeal on 13 January 2017. The arguments presented therein can be summarised as follows:

- It is very unlikely that this sign serves, or will serve in the future, to designate a characteristic of the goods and services for which registration is sought. After all, it is a photo of a specific person with specific external features and it is inconceivable that this portrait photo of the applicant will have to remain in the public domain.
- The arguments put forward by the Office do not tie in with the claim that the sign can 'only' serve to designate the characteristics of the products.
- With regard to the services refused in Classes 35, 41, 42 and 44, the fact that this portrait mark can only represent the model or fashion designer concerned in person actually indicates that the mark applied for cannot have any descriptive characteristics.

- During its assessment the Office only took the face of the person in question into account and should also have considered the photo as a whole, including elements such as the colours and background.
 - The Office makes the assumption that the face of the person in question is not sufficiently recognisable to the public. In fact, people recognise faces even when they are not being particularly attentive. A person's face can arouse an extremely negative or positive emotion, which actually implies that a consumer can make a choice on the basis of that emotion. In the case of services in particular, the experience is often linked to a person, namely the person who provides the service.
 - The Office has accepted portraits of various well-known and unknown individuals as trade marks (Annex 1). The mark in question has been registered in the Benelux countries and the United States.
 - Besides the fact that the adult human face is a distinctive sign, the applicant, who is depicted in the image, is a well-known person in the modelling world, not only in the Netherlands and Europe, but also worldwide (evidence: Annexes 6 to 9).
- 8** On 4 September 2017 the original applicant reported that the trade mark application was being transferred to Giraffen houden van Wodka B.V.

Reasons

Article 7(1)(c) EUTMR

- 9** In accordance with Article 7(1)(c) EUTMR, trade marks shall not be registered 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.
- 10** The signs and indications referred to in Article 7(1)(c) EUTMR are those that may serve in normal usage from the point of view of the target public to designate, either directly or by reference to one of their essential characteristics, the goods or services in respect of which registration is sought (29/04/2004, C-468/01 P – C-472/01 P, Three-dimensional tablets, EU:C:2004:259, § 39; 26/11/2003, T-222/02, ROBOTUNITS, EU:T:2003:315, § 34; 22/06/2005, T-19/04, PAPERLAB, EU:T:2005:247, § 24).
- 11** It follows that, for a sign to be caught by the prohibition set out in that provision, there must be a sufficiently direct and specific relationship between the sign 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 (22/06/2005, T-19/04, PAPERLAB, EU:T:2005:247, § 25; 27/02/2002, T-106/00, STREAMSERVE, EU:T:2002:43, § 40).

- 12** It should also be borne in mind that the assessment of the descriptiveness of a sign may only be carried out, first, in relation to the understanding of the sign by the relevant public and, second, in relation to the goods or services concerned (13/11/2008, T-346/07, EASYCOVER, EU:T:2008:496, § 42).
- 13** The examiner correctly found that the goods and services in question target both the general public (e.g. the goods in Classes 3, 9, 14, 16 and 28 and the services in Class 41) and a specialised public (e.g. certain services in Classes 35 and 42), or both (e.g. certain services in Class 44), and that, depending on the nature of the goods and services concerned, or for specific goods and services, the relevant public will have a high level of awareness.
- 14** Furthermore, the examiner was also correct to note that the relevant public throughout the European Union will, in principle, have the same perception as regards the intrinsic distinctiveness, or the descriptiveness or otherwise, of a figurative mark and that, consequently, the relevant public consists of the public of the entire European Union (30/09/2009, T-75/08, (!), EU:T:2009:374, § 26).
- 15** The mark applied for is a photographic image (photo) of the head/face of a woman, as shown in paragraph 1.
- 16** Accordingly, for the purpose of applying Article 7(1)(c) EUTMR it is necessary only to consider, on the basis of the relevant meaning of the sign at issue, whether, from the viewpoint of the relevant public, there is a sufficiently direct and specific relationship between the sign and the goods or services in respect of which registration is sought (20/07/2004, T-311/02, LIMO, EU:T:2004:245, § 30).
- 17** According to the examiner, this was the case for certain goods in Class 3, as the image represents the category for whom the goods are intended, namely women. In the examiner's view, the same also applied to the goods in Classes 14, 18 and 25. Furthermore, with regard to certain goods in Class 16, the sign would contain information relating to the object of the good (e.g. the person on the customer card or ID card). As regards certain services in Classes 35, 41 and 42, the image would only represent the model or fashion designer concerned in person and in the case of certain services in Class 44 it would only represent the person providing those services.
- 18** It is a fact that images or photos of people are commonly used in general and appear on the packaging of all kinds of goods or are used in connection with all manner of services, mainly those connected with personal care, clothing and fashion. Although such images can, of course, depict specific persons or individuals, they generally consist of nothing more than a banal representation of people in general, as a result of which it is likely that these kinds of images will be taken as a reference to the target customers of the goods and services in question (01/09/2015, R 2993/2014-5, DEVICE OF A SQUARE WITH FOUR PICTURES (fig.), § 17).
- 19** The sign in question is, however, clearly and without any doubt the image of a specific individual, with her unique facial features, and takes the form of a passport photo.

- 20** In the Board of Appeal's view, it therefore cannot be assumed that, from the point of view of the relevant public, there would be a direct and specific relationship between the sign and the goods and services in question in accordance with Article 7(1)(c) EUTMR.
- 21** It is not obvious that, on seeing the photo of this woman, the relevant public would make a direct connection with the target customers of the goods and services. After all, it is a fact that 100 % of all possible goods and services are intended for either a female or a male public, and seeing an image of a specific woman will not necessarily lead one to conclude immediately that the goods in Classes 3, 14, 18 and 25 are intended for women. A huge number of female fashion designers release men's collections under their names (e.g. Carolina Herrera or Purificación Garcia) and the public will naturally not assume that a mark consisting of a woman's name necessarily protects goods intended for women. The same can be said of male fashion designers who also bring out collections for both target groups (e.g. Giorgio Armani and Ralph Lauren).
- 22** Moreover, it is not unusual for well-known persons to bring out goods in Class 3 for both men and women under their name or even featuring their image (e.g. Antonio Banderas markets perfumes for both groups) without the public making a direct connection with the target public on seeing the person or his/her name or portrait.
- 23** It is also unclear how the mark applied for would contain information relating to the good in Class 16, e.g. concerning the person on the customer card or ID card, as indicated by the examiner. After all, such goods are not sold with a photo of a person already on them. The photo is added by the user for identification purposes. It is a fact that certain goods (e.g. wallets and purses) are often sold with a specimen ID card inside featuring a photo of a person, but this is merely to show customers where they can store their card inside the product and is not intended to designate the target public of those goods.
- 24** Conversely, the examiner's arguments that, with regard to the services in Classes 35, 41 and 42, the image would only represent the person providing those services indicate precisely that the image can be perceived as a way of distinguishing those goods and services on the basis of their commercial origin.
- 25** It can indeed be assumed that the target public will perceive the sign as a way of identifying the origin of the goods and services in question, namely that they originate from the person depicted, and that the sign therefore fulfils the essential function of a trade mark, as explained below.

Article 7(1)(b) EUTMR

- 26** Pursuant to Article 7(1)(b) EUTMR, 'trade marks which are devoid of any distinctive character' shall not be registered.
- 27** In addition, Article 7(2) EUTMR provides that '[p]aragraph 1 shall apply notwithstanding that the grounds of non-registrability obtain in only part of the [European Union]'.

- 28** The notion underlying Article 7(1)(b) EUTMR is indissociable from the essential function of a trade mark, which is to guarantee the identity of the origin of the marked good or service to the consumer (08/05/2008, C-304/06 P, EUROHYPO, EU:C:2008:261, § 56; 15/09/2005, C-37/03 P, BioID, EU:C:2005:547, § 60).
- 29** This absolute ground for refusal is thus intended to ensure that that consumer or end-user can distinguish, without any possibility of confusion, the good or service concerned from others which have a different origin. A trade mark that serves to identify the good or service in respect of which registration is sought as originating from a particular undertaking and thus distinguishes that good or service from those of other undertakings therefore possesses distinctive character within the meaning of that provision (05/12/2002, T-130/01, REAL PEOPLE, REAL SOLUTIONS, EU:T:2002:301, § 19-20; 12/05/2016, T-32/15, Mark1 (fig.), EU:T:2016:287, § 25-26).
- 30** It is not necessary for the trade mark to convey exact information about the identity of the manufacturer of the goods or the supplier of the services. It is sufficient that the trade mark enables members of the public concerned to distinguish the good or service that it designates from those which have a different commercial origin (21/01/2011, T-310/08, executive edition, EU:T:2011:16, § 22).
- 31** The signs that are devoid of any distinctive character within the meaning of the above-mentioned provision are those that are incapable of performing the essential function of a trade mark, namely that of identifying the origin of the goods or services, thus enabling the consumer who acquired them to make the same choice, if the experience proves to be positive, or to make another choice, if it proves to be negative, when making a subsequent acquisition (12/05/2016, T-32/15, Mark1 (fig.), EU:T:2016:287, § 28; 04/07/2017, T-81/16, a pair of curved strips on the side of a tyre, EU:T:2017:463, § 80).
- 32** The Court of Justice has noted that, although the criteria for assessing the distinctiveness of the various categories of mark are the same, when those criteria are applied it may become apparent that the perception of the relevant public is not necessarily the same for each of the categories and that it may be more difficult to establish distinctiveness in relation to certain categories (08/04/2003, C-53/01-C-55/01, Linde, EU:C:2003:206, § 48; 12/02/2004, C-218/01, Henkel, EU:C:2004:88, § 52; 06/05/2003, C-104/01, Libertel, EU:C:2003:244, § 65).
- 33** It therefore can indeed be more difficult to establish distinctiveness in relation to a photo of a person or persons. That does not mean that marks containing images of persons would be excluded from registration if they can be perceived immediately as a designation of the commercial origin of the goods or services concerned, enabling the relevant public to distinguish, without any possibility of confusion, the goods or services of the holder of the trade mark from those which have a different commercial origin (05/12/2002, T-130/01, REAL PEOPLE, REAL SOLUTIONS, EU:T:2002:301, § 19).
- 34** Although individuality and originality are not criteria that have to be met to establish the distinctiveness of a mark, the mark in question must enable the public to distinguish the goods and services concerned from those of other

undertakings or persons (04/07/2017, T-81/16, a pair of curved strips on the side of a tyre, EU:T:2017:463, § 49).

- 35 In the Board's view, the sign applied for does this. Although, when considered as a whole, the image at issue, as also indicated by the examiner, does indeed consist of a realistic representation of the head/face of a woman, depicted in common colours and against a common background, this image does in fact enable the public to distinguish the goods and services concerned from those with a different commercial origin, and in particular from the specific person depicted.
- 36 After all, a photo is always a 'realistic representation' of what is depicted, although that does not mean that that representation cannot be perceived as a trade mark, especially if it has nothing to do with the appearance of the goods in question and is therefore not an image of the goods, or, in other words, does not consist of a sign that depends on the appearance of the designated goods (*a contrario*, 11/07/2013, T-208/12, EU:T:2013:376, Red shoelace end caps, § 34, confirmed by 11/09/2014, C-521/13 P, Red shoelace end caps, EU:C:2014:2222, § 49).
- 37 A photo of a person's face, in the form of a passport photo, is a unique representation of that person, including his/her specific external features. Besides elements including a person's first name and last name, a depiction of a person's face in the form of a passport photo serves to identify that person and therefore to distinguish him/her from others. In the Board's opinion, the image at issue is therefore capable of fulfilling the essential function of a trade mark, namely distinguishing the goods and services in respect of which registration is sought from those with a different origin.
- 38 As the mark applied for does not contravene the absolute grounds for refusal laid down in Article 7(1)(b) and (c) EUTMR, it is not necessary to examine whether the sign 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, pursuant to Article 7(3) EUTMR.
- 39 In view of the above considerations, the appeal is therefore upheld and the contested decision is annulled.

Order

On those grounds, THE BOARD hereby:

Annuls the contested decision.

Signed

D. Schennen

Signed

R. Ocquet

Signed

L. Marijnissen

Registrar:

Signed

H.Dijkema

