



AG examination of trade marks that refer to the content of the goods and services

Talking about what things are about

Richard Thewlis
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PROGRAMME

30'
Presentation

- What is meant by “subject matter”?
- What considerations are relevant for AG Examination?
- Case Law and interesting issues.
- How may objections be overcome?

10'
Questions and answers

Food for thought...

Do you think..

...“PENGUIN” books are about penguins?

...“CAR” magazines are about cars?

...“CHURCHILL” books are about (or by) Winston Churchill?

...“SIBELIUS” musical recordings are of the music of Jean Sibelius?

Where do the differences lie? How should the AG Examiner react?

Legal provisions

Article 7(1)c EUTMR

The following shall not be registered:

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 the rendering of the service, or **other characteristics** of the goods or service.

“Other Characteristics” may be thematic content. Will the public, without further thought, understand the mark refers to thematic content?

The Examination Guidelines

Examination Guidelines: Section 4: 2.7.1

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.

The principal areas to be considered are: Classes: 9, 16, 28, 35, 41

The Examination Practice - Perceptions

Trade marks for Books in Class 16. What does the consumer think ?

“PENGUIN”/”BIRD”

“THE PENGUIN DICTIONARY”/”THE BIRD DICTIONARY”

“THE CHILDREN’S BOOK OF PENGUINS”

Realities of the market/Realities of the consumer’s perception

The Examination Practice

What does the consumer think?

“PENGUIN” for books and magazines

AG OK



“THE PENGUIN DICTIONARY”

AG OK



“THE CHILDREN’S BOOK OF PENGUINS ”

AG not OK



“THE BIRD DICTIONARY”/”BIRD”

AG not OK



The Examination Practice - Perceptions

How arbitrary is the mark in overall structure/content?

“BUSINESS JOURNAL”

“JOURNAL OF BUSINESS ACCOUNTING AND FINANCIAL
PERSPECTIVES”

Realities of the market/Realities of the consumer’s perception

The Examination Practice - Perceptions

How arbitrary is the mark in overall structure/content?

“BUSINESS JOURNAL” AG not OK 

“JOURNAL OF BUSINESS ACCOUNTING AND FINANCIAL PERSPECTIVES” AG OK 

Realities of the market/Realities of the consumer's perception

Relevant Considerations for the Examiner – getting the right balance.

Possibly refusible?

- The mark refers directly to a category heading or genre (Business/Crime/Law/Dogs/Love)
- The overall structure of the mark leads towards a descriptive understanding.
- Mark concerns a plural term.

Possibly acceptable?

- The mark refers to a rarefied sub-category, without a wide readership/market-presence.
- The mark is somewhat arbitrary as an overall combination.
- Mark concerns a singular term.

Cases from the Boards

R 2755/2019-1

“NATURE” (word mark) applied for in Classes 9, 16, 41 (*inter alia*: computer software, downloadable publications, printed matter, educational services, holiday camp services).

R 2339/2017-4



SportBusiness

Applied for in Classes 9,16,35,41 (*inter alia*: software, publications books and magazines, market studies, education, magazine publishing).

Cases from the Boards

R 1709/2010-4

“EcoWellness” (word mark) applied for, *inter alia*, in Class 16: Printed matter.

- Merely bringing two descriptive terms together does not prevent them from remaining essentially descriptive
- ‘EcoWellness’ is a mere subject indication, and therefore describes that the content of these goods deals with ecological wellness (ecologically orientated wellness).

Case Law of the Court

Case T-412/11 “TRANSCENDENTAL MEDITATION”

- *In relation to books or other publications, the relevant public will perceive, without further thought, the thematic content of the goods in question, namely the application of a method of meditation.*
- *This applies irrespective of the public’s actual knowledge about how transcendental meditation is practiced.*

See also “HEARTFULNESS” T-48/20 (Decision of 3 March 2021)

Can Names be Subject Matter?

Case R 2382/2017-2 “SIBELIUS”

If the mark ‘SIBELIUS’ is used with goods in Class 9, namely “magnetic data carriers, recording discs; Compact discs, DVDs and other digital recording media; Electronic publications, downloadable;...” the mark will be perceived as indicating their content.. they contain the music of Jean Sibelius, or photos/videos of Jean Sibelius.

Compare: Janis Joplin, Amy Winehouse, Mick Jagger (all accepted)



Can Titles be Subject Matter?

- Registered “Title” marks: “Harry Potter”; “James Bond”; “Pocahontas”
- What about: “Snow White and the Seven Dwarves”?
- R 1856/2013-2 “Pinocchio”
- R 0118/2014-1 “The Jungle Book”
- “George Orwell”/”Animal Farm”/”1984” all currently before Grand Board

How may Subject Matter objections be overcome? Exclusions/limitations

Trade Mark: “CATS” for books

Objection: Descriptive of books about cats

Proposal to overcome objection “Books; but not including books about cats.”

How may Subject Matter objections be overcome? Exclusions/limitations

Trade Mark: “CATS” for books

Objection: Descriptive of books about cats

Proposal: “Books; but not including books about cats.” 

Where registration is applied for in respect of particular goods or services, it **cannot be permitted** that the competent authority registers the mark only in so far as the goods or services concerned do not possess a particular characteristic. Case C -363/99.

How may Subject Matter objections be overcome? Exclusions/limitations

Trade Mark: “CATS” for books

Objection: Descriptive of books about cats

Proposal to overcome objection “Books; all relating to business statistics.”

How may Subject Matter objections be overcome? Exclusions/limitations

Trade Mark: “CATS” for books

Objection: Descriptive of books about cats

Proposal: “Books; all relating to business statistics.”



The positive limitation is acceptable, mark is neither descriptive nor deceptive for the goods.

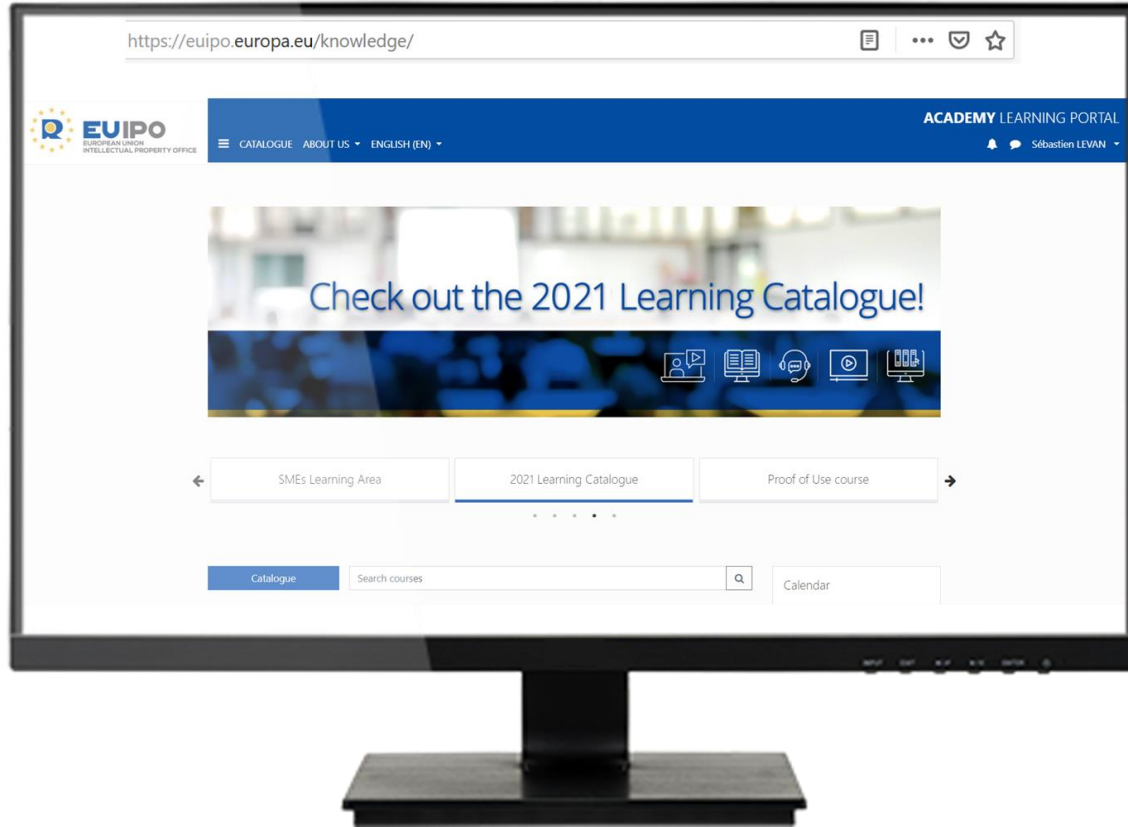
Summary

To summarize, we have considered:

- How “subject matter” is to be understood as a characteristic of goods and services.
- The relevant considerations in Absolute Grounds examination.
- Case law from the Boards and the Court.
- Questions arising with famous names and titles.
- How to overcome an objection through positive limitation.



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