

RE: WEERGAVE VAN HET GEZICHT VAN EEN PERSOON (fig.), R 50/2024-G

ECTA has prepared this brief in relation to case WEERGAVE VAN HET GEZICHT VAN EEN PERSOON (fig.), R 50/2024-G, pending before the Grand Board of Appeal of the European Union Intellectual Property Office (“GBoA EUIPO”).

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, and repealing Delegated Regulation (EU) 2017/1430 (“EUTMDR”) allows for intervention of interested groups or bodies in EUIPO appeal proceedings referred to the EUIPO Grand Board of Appeal.

A. ABOUT ECTA

ECTA, which was formed in 1980, is an organization concerned primarily with trade marks and designs. ECTA has approximately 1,500 members, coming from all the Member States of the EU, with associate Members from more than 50 other countries throughout the world.

ECTA brings together those practicing in the field of IP, in particular, trade marks, designs, geographical indications, copyright, patents and related matters. These professionals are lawyers, trade mark and patent attorneys, in-house lawyers concerned with IP matters, and other specialists in these fields. ECTA does not have any direct or indirect links to, and is not funded by, any section of the tobacco industry.

The extensive work carried out by the Association, following the above guidelines, combined with the high degree of professionalism and recognized technical capabilities of its members, has established ECTA at the highest level and has allowed the Association to achieve the status of a recognized expert spokesman on all questions related to the protection and use of trade marks, designs and domain names in and throughout the European Union, and for example, in the following areas:

- Harmonization of the national laws of the EU member countries;
- European Union Trade Mark Regulation and Directive;
- Community Design Regulation and Directive;

- Organisation and practice of the EUIPO.

In addition to having close links with the European Commission and the European Union Intellectual Property Office (EUIPO), ECTA is recognized by WIPO as a non-Government Organization (NGO).

ECTA does also take into consideration all questions arising from the new framework affecting trade marks and other IP-related rights, including the globalization of markets, the explosion of the Internet and the changes in the world economy.

The present brief was drafted by ECTA independently of the parties in the case at issue.

B. ECTA'S INTEREST IN THE CASE

ECTA is not a party in the case but believes that the case is significant to the development of IP law and presents itself as an amicus curiae ("friend of the court") in the matters raised therein.

Through its Amicus Curiae Task Force (ACTF) and ECTA members contributing to the ACTF projects, ECTA provides expertise concerning trade mark and other IP-related matters through the submission of amicus curiae briefs.

The fact that ECTA decides to file an amicus curiae brief does not mean that ECTA believes there has been an incorrect decision. The purpose of the present brief is to ensure that the GBoA is fully informed about the relevant issues that may impact the law and practice within the European Union.

ECTA plays a neutral role, addressing only the legal issues. ECTA hereby acts in the interest of the represented manufacturers, producers, suppliers of services, traders or consumers, who may be affected by the issues of concern in this case as described below, and thus by the result of this case as required by Article 37 (6) EUTMDR.

ECTA hopes that this submission may be of assistance to the GBoA.

C. SUMMARY OF THE PROCEDURAL HISTORY OF THE CASE

The matter concerns an appeal by **Johannes Hendricus Maria Smit (the “Applicant” and/or “Jan Smit”)** regarding the rejection of his application for the registration of a figurative EU trade mark depicting a person's face (also the “Portrait”):



The EUTM application, filed on **October 23, 2015, with n. 014711907**, designates various goods and services across the International Nice classes 9, 16, 24, 25, 35, 41.

The EUTM application was rejected repeatedly from 2016 to 2023 under Articles 7(1)(c), (b), and 7(2) EUTMR for all goods and services. The applicant invoked Article 7(3) EUTMR, sought deferrals, and requested registration or a final refusal to appeal, but the examiner consistently upheld the objections. Despite opportunities to provide further evidence or observations, the applicant did not respond. Finally, on December 19, 2023, the examiner issued a final decision refusing the EUTM application for all goods and services designated.

The examiner refused the application under **Article 7(1)(b)** and **Article 7(1)(c)** of the EU Trade Mark Regulation (EUTMR) for the following reasons.

The figurative mark, representing the face of a person, was found to lack inherent distinctiveness under Article 7(1)(b) EUTMR. As per the examiner's assessment, the goods and services are aimed at both the general and a specialised public within the EU, and the relevant public is considered to have a high level of attention. However, the Portrait is seen as a generic depiction of a man's face, commonly used to present goods and services, rather than a distinctive identifier of commercial origin. It does not stand out from other realistic representations of human faces and is therefore insufficient to distinguish the applicant's goods and services from those of others.

For specific goods like clothing in class 25, the Portrait is deemed descriptive, as it represents the intended audience (namely men). Similarly, for items like

media, photographs, and posters (classes 9 and 16), the Portrait conveys information about the subject, such as the person depicted on the products. For services like entertainment, performances, and education covered in class 41 and retail services in class 35, it is not uncommon for such services to be associated with images of the individuals providing them (such as performers, artists, or instructors). Accordingly, the mark is descriptive and lacks distinctive character for these goods and services under Article 7(1)(c) EUTMR.

Even for goods and services where the mark has no direct descriptive meaning, it fails to establish distinctiveness because it does not explicitly identify the commercial origin. The mark is seen as one of many generic portraits of a man's face, which are commonly used in advertising and packaging.

The Applicant argued that the mark had acquired distinctiveness through use, based on Jan Smit's reputation as a singer, actor, and presenter. However, this claim was not substantiated with sufficient evidence. While Jan Smit is a well-known figure in the Netherlands and neighbouring countries such as Belgium and Germany, this local recognition is insufficient as to the community-wide requirement for acquired distinctiveness within all 28 (NB: At that time) EU Member States.

The argument that Jan Smit's Portrait is widely recognized by fans in specific regions was insufficient for the examiner, as recognition is not the same as differentiating according to commercial origin. The average consumer would see the Portrait as informative or representative of the individual depicted, rather than as a symbol of commercial origin. This applies even to entertainment-related services in class 41, where the public would likely associate the mark with Jan Smit's life or work.

Following the appeal of the Applicant, the appeal was deemed admissible, and the case was referred to the **Grand Board**, to ensure consistent application of rules regarding trade marks featuring personal faces.

D. REASONS WHY ECTA IS SUBMITTING THIS BRIEF

The case presents the following issues, which are of high importance for the IP community and currently need clarification:

- Whether a photographic image of a person's face can serve as a distinctive and non-descriptive trade mark under EU law.

- There is a perceived contrast between the Office's approach and that of the Board of Appeals'. It is apparent from a preliminary examination that, at first instance, the Office appears to systematically refuse registration of trade marks containing the face of a person pursuant to Article 7(1)(b) and/or Article 7(1)(c) EUTMR, while in recent years, the Board of Appeal has ruled, by various decisions, that EU trade mark applications containing or consisting in a person's face are not inherently devoid of distinctive character.

E. ECTA'S ANALYSIS

ECTA does not take a position on the specific case. Instead, ECTA aims to highlight considerations and implications that may guide the assessment of whether or not portraits can be registered as trade marks.

First and foremost, whether a representation of a person's face is distinctive for certain goods and services should be assessed **on a case-by-case basis** taking into account especially the nature and the intended purpose of the goods and services covered by the application. In this respect, ECTA raises the below considerations.

Distinctiveness

Irrespective of the object of the mark (whether a word, sign, picture or other form of expression that is able to create a perception) the test of distinctiveness of the mark and the possibility of identifying the origin of the goods and/or services through the mark, must always be passed.

Portraits of individuals can, objectively, be inherently distinctive or less so. There is no doubt that human faces are unique. The uniqueness of a human face can be attributed to several factors, such as genetics, developmental factors, ageing, facial expressions, etc.¹ These factors combine to create a wide

¹ 1. Genetics: Each person's facial features are determined by a combination of genes inherited from their parents. This genetic variation leads to distinctive traits such as the shape of the nose, eyes, and jawline.

2. Developmental Factors: Individual differences in development during fetal stages and childhood can influence facial structure. Environmental factors, nutrition, and health during development can also play a role.

3. Ageing: As people age, their faces change due to factors like skin elasticity, bone density, and fat distribution, further contributing to unique facial features over a lifetime.

4. Cultural Influences: Different cultures have varying standards of beauty and facial aesthetics, which can lead to variations in grooming, cosmetic practices, and expressions that add to the uniqueness of appearances.

5. Facial Expressions: Humans have a vast range of facial expressions that can convey emotions. The way people express themselves can be so distinctive that it contributes to their perceived uniqueness.

6. Biometric Identification: Research has shown that no two faces are exactly alike; even identical twins have subtle differences in their facial features, which is why facial recognition technology can be effective.

array of facial characteristics, making each person's face unique in its appearance and expression.

Accordingly, the face of a person has inherently many distinctive elements that serve to differentiate one person from the other. Therefore, it is not pertinent to state as a general rule, as the final decision of the examiner states, that a portrait is necessarily seen as a generic depiction of a man's face, as if all faces looked alike. It would be like arguing that words cannot be distinguished from other words.

In addition, the distinctiveness of portrait would also depend on whether the face has striking features (this could include prominent features - such as tattoos, piercings, distinctive hairstyles, eye patches - expression or style) or is stylized in a distinctive way that immediately sets it apart from other faces / profiles.

A different issue is when the portrait belongs to a well-known person, since in this case it should be assumed that the general public will be able to immediately recognize and distinguish her/his face from that of other persons, although it would not automatically imply inherent distinctiveness. However, whether or not the portrait of a "well known" person is inherently distinctive or not is not at issue here, so we will only marginally address it when necessary.

The focus given to the assessment of the uniqueness, or distinctive character of a face, should not be different to that given to any other mark. The principles laid out in various judgments of the General Court dealing, e.g., with the lack of distinctiveness of shape marks (cf. case C-136/02 para 30) or geometric figures without instantly memorable characteristics (see for instance T 426/23, Chiquita Brands, para. 29 and 32) could apply by analogy to images of faces.

Although it goes without saying that a face is not a mere "shape" or a "simple geometric figure" the elements of distinctiveness required by geometric figures can well apply to "common" (i.e. non-famous or non-striking) faces. The question to ask when examining such portrait trade marks should therefore always be whether, despite every face being potentially different, ordinary facial features could suffice to create, in the mind of the relevant public, an instant perception of distinctiveness that leads such public to identify the origin of the goods being promoted through the use of that image.

Consequently, when deciding whether a profile / face (or any other body part for that matter) should be registered as a trade mark, the distinctiveness of the particular image would need to be considered in view of Article 7(1)(b) of the EUTMR, which clearly states that trade marks that are devoid of any distinctive character shall not be registered. To this end, see especially the reasoning from

the Unofficial Document – “DECISION of the Fourth Board of Appeal of 16 November 2017 in Case R 2063/2016-4; Giraffen houden van Wodka B.V., paragraph 33-34, which ECTA endorses

Descriptiveness

Article 7(1)(c) EUTMR adds an additional layer of complexity to images of faces that could be perceived merely as an indication of some characteristics of the goods/services to which they relate (purpose, subject-matter). For instance, the image of a bearded man for goods relating to beard grooming could be deemed descriptive of the goods associated with the mark. This could apply in the cases of faces of individuals that have distinguishing features related to the goods or services claimed by the application. In addition, one should also take into account that there are specific sectors (for instance for cosmetics) where it is almost necessary to show “faces” as examples of the alleged effectiveness of the product.

On the other hand, could the image of a bearded well-known person be considered sufficiently distinctive as to perform its essential function as a brand where, had the face not been well known, such function would not have been performed?

For instance, may the image of a bearded Lionel Messi or Cristiano Ronaldo’s hairstyles create sufficient distinctiveness to pass the test of both Article 7(1)(b) and 7(1)(c), even where the image is used to promote beard-grooming or shampoo products? Possibly, but the fact remains that the image of a bearded Messi or Ronaldo’s hairstyles will not immediately draw the attention of the consumer to the beard or the hairstyle, but rather to the personality itself.

Hence, the test to be applied would require an analysis of whether a face/portrait that could be deemed a distinctive mark under Article 7(1)(b) would be deemed to be a mere description of the goods or services with which such mark is associated.

This could lead to a different result if, for instance, the image of Lionel Messi was being registered as a mark for football (soccer)-related items, where Messi is known as a prominent figure of that game. Similar examples could be made for images of pop stars used on goods or services within the music industry or top models whose images are used for the branding of goods or services relating to fashion, such as makeup.

In these examples, it may well be the case that, given the identity of a famous person and the obvious connection with the industry in which he/she operates and is well known for, some additional question might arise: would the use of the portrait of Messi for furniture be more acceptable and would not require, for instance acquired distinctiveness, while the same portrait of Messi over a pair of soccer shoes could be considered as descriptive (of a quality) and may require evidence of acquired distinctiveness?

The principles laid out in the General Court decisions 08/07/2010, T-385/08, Hund, EU:T:2010:295, and 08/07/2010, T-386/08, Pferd, EU:T:2010:296 (cited in the EUIPO Trade mark guidelines, Chapter 4) whereby the Court held that an image of a dog (in the first case) and a horse (in the second case) were descriptive of the goods, meaning that the goods concerned (foodstuffs and accessories) were meant for dogs and horses (respectively), can be lifted and applied to the images of personalities whereby the public will associate the goods and services to the industries within which these personalities operate, see also the reasoning of Unofficial Document – “DECISION of the Fourth Board of Appeal of 16 November 2017 in Case R 2063/2016-4; Giraffen houden van Wodka B.V., paragraph 11 and 16.

Conclusion on the question raised before the Grand Board

There is no easy answer to the issue of whether the representation of a person’s face is both distinctive and not descriptive.

In view of the above considerations, coupled with the need to identify the relevant public in each and every case, as well as the relevant goods and services and the habits of each sector, we are of the view that each application for the registration of a trade mark consisting in the representation of a person would need to be considered on its own merits and on the conclusions based on the application of the above-mentioned considerations with respect to Articles 7(1)(b) and 7(1)(c) EUTMR.

In other words, ECTA’s view on the case referred to the GBoA is that, when assessing the subject matter, it may be prudent for the GBoA to formulate answers to the following questions:

- Can a portrait mark be inherently distinctive in the case of a mere plain portrait of a ‘face in the crowd’?
- Can a portrait mark be inherently distinctive in the case of a portrait of someone with distinctive features (weird hair, unusual beard, tattoos)?

- Can a portrait mark be inherently distinctive in case of a portrait with the addition of other features (position of portrayed, accessories (like the Lindt trade mark)?
- Can a portrait mark be inherently distinctive in case of a highly stylized portrait, or a portrait placed against a background containing other figurative elements?
- Can a portrait mark be inherently distinctive in the case of a portrait of a famous person?
- Do the answers to these questions have different outcome depending on the applied for goods or services?
- If not inherently distinctive, can a portrait trade mark acquire distinctiveness?
- Is this distinctiveness acquired when a person can show its fame in the EU (notwithstanding the product and /or the portrait itself)? Or, is distinctiveness only acquired if it is shown that the portrait is known by the relevant public, as being a source indicator for the goods/services applied for?
- Can portraits of famous persons be considered descriptive, if they are applied for goods and services related to what they are famous for? For example, the same test does not appear to be applied to names of famous persons. For instance, TAYLOR SWIFT has many registrations for TAYLOR SWIFT for entertainment services.

In addition to these considerations, the Grand Board will find as Single Annex a table with a quick pros/cons analysis, which may also be useful as a checklist.

ECTA is also aware that trade marks consisting in the representation of a person raise important questions in addition to their ability to overcome absolute grounds for refusal: for example those of their genuine use, of their relationship with personality rights, and of their enforcement. For the sake of completeness, ECTA wishes to share a few remarks with the Grand Board regarding some of these issues (personality rights and likelihood of confusion):

Portrait marks and personality rights

There is probably, on the side of the applicants, a significant misunderstanding in the nature and purpose of a trade mark right, and a confusion with the protection of personality rights.

Personality rights do not have a clear definition in EU law. Even though personality rights have not been harmonized, the CJEU has pronounced several times its view on what they might be. Case law indicates that at least the following can be classified as personality rights: the right to privacy, the right to one's own image, the prohibition of defamation (all Joined Cases C-509/09 and C-161/10) and the protection of good name and reputation (Case C-164/16

Bolagsupplysningen and Ilsjan; Case C-68/93 Shevill and Others, EU:C:1995:61.)

The European court of Human rights held: “[A] person’s image constitutes one of the chief attributes of his or her personality, as it reveals the person’s unique characteristics and distinguishes the person from his or her peers. The right to the protection of one’s image is thus one of the essential components of personal development. It mainly presupposes the individual’s right to control the use of that image, including the right to refuse publication thereof ...” (von Hannover v. Germany (no. 2), Grand Chamber judgment of 7 February 2012, § 96).”

Various EU legislators have specifically recognized ‘the right to one’s own image’, giving persons the right to act against unauthorized use of one’s portrait/image in case of a reasonable interest gives rise to same. Provisions on this appear to be included mainly in local copyright acts. Examples being Netherlands’ “Portretrecht”, art. 21 Auteurswet (AW) as well as Germany’s “recht am eigenen Bild” §22 en 23 Kunsturhebergesetz (KUG).

The primary purpose of a personality right is not to protect commercial value, but to guarantee human dignity and the free development of personality. Personality rights give the portrayed the right to prohibit the use but only in cases where there is a reasonable interest.

While these provisions initially came in play in cases where the use of one’s portrait infringed privacy and private life, it is now widely recognized that there can also be a commercial interest. Portrait rights have commercial value for persons which are famous or renowned, who do not have to consent that their portraits are used for commercial purposes and as such, can even grant permission for such use in exchange for compensation (as per a license).

Personality rights such as the “right to one’s own image” are non-transferrable and not inheritable and only the portrayed or its next of kin (after death) have the power to act against the unauthorized use. It appears that the reason why legislators did not opt for a transferable right follows from the highly personal nature of the portrait right.

Likelihood of confusion & scope of protection

Although the matter before the Grand Board only pertains to the registrability of Portrait Trade marks, one must also bear in mind their scope of protection once

granted, and how far such would extend in order to be in line with the objectives of EU trade mark law.

When assessing if there exists a likelihood of confusion on part of the public between two signs, their visual, phonetic and conceptual similarity must be assessed by weighing up the coinciding and the differing elements, and by taking into consideration their distinctiveness and dominance as well as whether and to what extent these elements determine the overall impression conveyed by the marks.

It is worth noting that a portrait trade mark is protected only for the image for which it has been filed and registered, and it is not protected for the idea or concept that portrait depicts *per se*, and it is worth considering to which extent protection also spans to the same face, though depicted in profile or in another angle and/or with different attires.

As far as ECTA is aware, likelihood of confusion and similarity of trade marks being photographic portraits was only assessed by the EUIPO in Opposition No B 3 145 098. The signs coincided insofar both featured the photographic portrait of an old man. However, for the Opposition Division the attire, and especially the expression and the perceived mood of each old man was found to be clearly and obviously different. The Opposition Division thus stated that the consumer would immediately perceive that each sign concerns a different person/man.

It is noteworthy that the opponent was unable to provide sufficient evidence of reputation/enhanced distinctiveness. However, had such enhanced distinctiveness been proven, to what extent that would alter the findings of the Opposition Division, given that one cannot be granted protection for the idea or concept that portrait depicts *per se* and it is inevitable that the portraits always will depict different persons.

Finally, another aspect to take into consideration in terms of portrait trade marks is that of how likelihood of confusion should be assessed in terms of series trade marks – would that apply only in terms of it being the same face/person being portrayed in different angles, attires et cetera, or would it apply to different types of faces/persons depicted in the same way, being similar yet different only in minor, non-distinctive characters that do not substantially affect the identity of the trade mark? For example, the Opponent in Opposition No B 3 145 098 used the following marks:



(all portraits registered before the EUIPO). If claiming protection as series trade marks, how would that expand to other portraits? In order to ensure sufficient protection for one's own portrait, would a person need to file multiple separate applications for different expressions, wearing different clothing and having the portraits taken in different lighting etc?

ECTA Amicus Curiae Task Force
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