DECISION
of the Grand Board of Appeal
of 19 December 2025

In case R 2248/2019-G

The Estate of the Late Sonia Brownell Orwell
A.M. Heath Literary Agents,
6 Warwick Court, Holborn
London, WC1R 5DJ
United Kingdom Applicant / Appellant

represented by Sipara Sweden AB, Nannavägen 22, SE-18773 Täby, Stockholm, Sweden

APPEAL relating to European Union trade mark application No 17 869 417

THE GRAND BOARD OF APPEAL

composed of S. Stürmann (Chairperson), V. Melgar (Rapporteur), G. Humphreys Bacon, N. Korjus, C. Negro, S. Martin, L. Marijnissen, C. Bartos, Ph. von Kapff (Members)

Acting Registrar: K. Zajfert

gives the following

Language of proceedings: English

Decision

Summary of the facts

1 By an application filed on 6 March 2018, the Estate of the Late Sonia Brownell Orwell ('the applicant') sought to register the word mark

GEORGE ORWELL

('the contested sign') as a European Union trade mark ('EUTM'), inter alia, for the following goods and services, as amended on 22 June 2018:

Class 9: *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, information, signals or software; webcasts; podcasts; vodcasts; podscrolls; electronically recorded data; electronic files; databases; teaching apparatus and instruments; audio and visual teaching apparatus; downloadable digital media and recordings containing teaching apparatus and instruments; computer games; educational computer games; downloadable computer games; computer software; computer programs; downloadable software and applications; software applications delivered online through a web-browser or as a downloadable application or application delivered to any computing device including desktop, laptop and tablet computers as well as mobile devices; data processing equipment; animated cartoons and other imagery; downloadable ring tones, music, screensavers, video, games, graphics and information; compact disc players; DVD players and recorders; tape recorders and tape cassette players; record players; MP3 players; MP4 players; ogg players; flac players; apparatus and instruments all for the recording, reproduction or transmission of sound, images, video and data; cinematographic films; animated cartoons; film strips; movies; magnetic recordings; optical recordings; magneto-optical recordings; solid-state recordings; amusement apparatus adapted for use with television receivers; apparatus for receiving, downloading and transmission of sound and images; digital electronic devices for the storage and transmission of information, data, messages, games, music and entertainment and access to the Internet; interactive games adapted for use with television receivers; multimedia discs and publications; multimedia recordings and publications; laser-readable discs; sound recordings; pre-recorded disks; recording disks; magnetic badges; gramophone records; compact discs-interactive CD-roms; communications apparatus and instruments; telephones; mobile phones; chargers; chargers for mobile phones; hands-free apparatus for mobile phones; mobile phone games; mobile phone covers and cases; karaoke machines; cameras; 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; glasses; sunglasses; parts and fittings for all of the above goods.*

Class 16: *Paper; cardboard and goods made from these materials; postcards, calendars, diaries, cardboard cut-outs and/or works of art; printed matter; photographs; stationery; artists' materials; paint brushes; typewriters and office requisites (except furniture); book ends; books; annuals; note books; publications; comic books; paper badges; cardsong books; magazines; newsletters; newspapers; albums; periodicals; journals; catalogues; manuals; maps; pamphlets; leaflets; posters; labels; office requisites; drawing and painting materials, apparatus and instruments; writing instruments; instructional and teaching materials; instructional and teaching materials for education and information; book binding materials; book covers; book marks; printing sets; printers' type; drawings; paintings; prints; pictures; calendars; pens; pencils; pencil top ornaments; paintbrushes; paint kits; tags; gift wrap; gift wrap cards; gift wrap tissue; gift boxes; wrapping paper; note pads; decalcomanias; paper napkins and other decorative paper items; paper party goods and paper party decorations; paper tablecloths and table covers; paper mats; paper party streamers; embroidery patterns; decorative transfers; temporary tattoos; rulers; erasers; greetings cards; stickers; paper signs; banners; charts; packaging materials; parts and fittings for all of the above goods.*

Class 28: *Games, toys and playthings; decorations for Christmas trees; electronic games; board games; costume masks; 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; gymnastic and sporting articles not included in other classes; parts and fittings for all of the above goods.*

Class 41: *Entertainment; cultural activities; publishing services; educational services; electronic publishing; providing non-downloadable electronic publications; 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); news and news programme services; film, video, sound and visual production, presentation and /or distribution services; video tape and DVD film production; production, presentation and/or distribution of video recordings, sound recordings, video cassettes, CDs, DVDs and/or digital recordings; organisation of events, festivals, seminars, conferences, congresses, workshops, exhibitions, cultural activities, webinars, competitions and / or stage shows; production, presentation, rental and distribution of films, television and /or radio programmes; interactive entertainment services in relation to films, sound and /or video recordings; publication and/or distribution of entertainment, educational and/or instructional materials; online entertainment and digital publishing services; providing television programmes and films online; advisory, consultancy and information services for all of the above services.*

Notice of grounds for refusal of the contested sign

2 On 28 March 2018, the examiner raised an objection against the contested sign for part of the goods and services listed in paragraph 1 above based on Article 7(1)(b) and (c), and Article 7(2) EUTMR. The reasoning of this objection was the following:

– The goods and services to which this objection applies are the following:

  Class 9: *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, information; webcasts; podcasts; vodcasts; electronically recorded data; downloadable digital media and recordings containing teaching apparatus and instruments; downloadable screensavers, video, information; cinematographic films; 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; prerecorded audio and video compact discs, DVDs, motion picture films, television programmes and other digital recording media; parts and fittings for all of the above goods.*

  Class 16: *Printed matter; photographs; books; publications; magazines; newsletters; newspapers; albums; periodicals; journals; catalogues; pamphlets; leaflets; posters; instructional and teaching materials; instructional and teaching materials for education and information; book covers; drawings; paintings; prints; pictures.*

  Class 41: *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.*

– The relevant average European consumer, and in particular those speaking English, would understand the sign as meaning the famous writer George Orwell. George Orwell, pseudonym of Eric Arthur Blair (born 25 June 1903,

Motihari, Bengal, India – died 21 January 1950, London, England), was an English novelist, essayist, and critic famous for his novels *Animal Farm* (1945) and *1984* (1949). The words composing the trade mark can be supported by the following dictionary references: https://www.oxfordreference.com/ and https://www.britannica.com/ and the following websites: https://www.telegraph.co.uk/culture/books/5453633/The-genius-of-George-Orwell.html; https://www.famousauthors.org/george-orwell; https://www.theguardian.com/books/2001/may/05/artsandhumanities.highereducation).

– The denomination 'George Orwell' will immediately create a link to the famous and widely known writer George Orwell. The relevant consumers would perceive the sign primarily as providing information that certain goods and services are about this famous writer. While Class 16 (e.g. printed matter, books, (electronic) publications) is a prime example of a category of goods which contains subject matter or content, an objection made under this section occurs also with respect to other goods and services, such as recorded media, films, plays, seminars and education. With regard to these categories, the terms 'subject matter' and 'content' are used interchangeably. The sign 'GEORGE ORWELL' does not only describe the writer himself but is also descriptive of books/publications/films/events etc. about the writer 'George Orwell'. The sign describes characteristics such as the subject matter/content of the goods and services in question.

– Given that the sign has a clear descriptive meaning in connection with the goods and services, it is also devoid of any distinctive character and therefore objectionable under Article 7(1)(b) EUTMR for those goods and services.

– A mark may be devoid of (any) distinctive character in relation to goods or services for reasons other than the fact that it may be descriptive.

– Names of individual persons are distinctive, irrespective of the frequency of the name and even in the case of the most common surnames (such as Jones or García, judgment of 16/09/2004, C-404/02, Nichols, EU:C:2004:538, § 26, 30) and prominent persons (including heads of states). However, an objection will be raised if the name can also be perceived as a non-distinctive term in relation to the goods and services (e.g. 'Baker' for pastry products). Names of famous persons (in particular artists, writers, musicians or composers) can indicate the category of goods, if due to widespread use, the time lapse, the date of death, or the popularisation, recognition, etc., the public can understand them as generic. This is the case with respect to 'George Orwell', whose books, in particular *1984* and *Animal Farm*, are known and read by people all over the world and, consequently, the sign 'George Orwell' will not be understood as an indicator of origin for publications, information, cultural activities, film, television, events, festivals, exhibitions, etc. For example, 'Shakespeare', 'Hitchcock' and 'Animal Farm' are perfectly capable of being distinctive trade marks for paint, clothing, or pencils. However, they are incapable of performing a distinctive role in relation to books or films, for example, because consumers will simply think that these goods refer to the story of Animal Farm,

Shakespeare or Hitchcock, this being the only meaning of the terms concerned.

– The fame of the sign ‘George Orwell’ constitutes a barrier to its registration. The sign does not contain any distinguishing features.

Applicant’s observations

3 On 26 July 2018, the applicant filed its observations on the objections raised by the examiner, stating in essence the following:

– The applicant is the Estate of the Late Sonia Brownell Orwell, who was the second and final wife of George Orwell and was responsible for administering his literary estate after his death (see for example https://en.wikípedia.orelwiki/Sonia Orwell). As such, it has full capacity and an obvious right to file this application in order to protect the ‘GEORGE ORWELL’ sign.

– Reference to the decision of 31/08/2015, R 2401/2014-4, Le journal d’Anne Frank, was made. Although that decision relates to a book title, the title includes the name of a famous historical figure, Anne Frank, and it is applicable in relation to the contested sign. On the basis of this decision, the sign ‘GEORGE ORWELL’ is not devoid of distinctive character in relation to goods and services in Classes 9, 16, and 41. The repute of a name should not constitute a barrier to registrability (31/08/2015, R 2401/2014-4, Le journal d’Anne Frank, § 32). An author’s name is by its very nature distinctive, in that it is used to distinguish the works of one author from the works of others. Applying that principle here, it is clear that just because ‘GEORGE ORWELL’ is arguably a famous name this does not mean that the name is devoid of distinctive character.

– The refusal on the grounds of descriptive character should be waived in relation to all goods and services. The contested sign is clearly distinguishable from the sign in the judgment of 12/06/2007, T-339/05, LOKTHREAD, EU:T:2007:172, in that ‘GEORGE ORWELL’ is a person’s name rather than a made up word, so any third party publishing a book or producing a film about George Orwell would have a defence under Article 14(1)(b) EUTMR, where ‘GEORGE ORWELL’ formed part of the title of such book or film, as such use would clearly concern characteristics of the goods or services.

– The sign ‘GEORGE ORWELL’ would not immediately create a link to the writer, and it would not be seen as providing information about him. Even if this were the case, in relation to the refused goods and services in Classes 9, 16 and 41, the Board found in Anne Frank that the consumer would be able to distinguish the goods and services of the owner from those of third parties. The Board also found in Anne Frank that her name was not descriptive.

– The examples of SHAKESPEARE, HITCHCOCK and ANIMAL FARM are irrelevant. William Shakespeare died in 1616, and his works are long out of

copyright, with no single party having control of his literary estate. The trade mark 'ALFRED HITCHCOCK' is actually registered in the EU (No 2 187 904) for goods in Class 16, including books, magazines, periodicals, pictures, posters, photographs. There are many prior names of writers that have been accepted as trade marks for the refused goods and services.

The contested decision

4 On 2 August 2019, the examiner took a decision ('the contested decision') refusing the contested sign, under Article 7(1)(b) and (c), in conjunction with Article 7(2), EUTMR, with regard to the following goods and services:

Class 9: *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, information; webcasts; podcasts; vodcasts; electronically recorded data; downloadable digital media and recordings containing teaching apparatus and instruments; downloadable screensavers, video, information; cinematographic films; 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; prerecorded audio and video compact discs, DVDs, motion picture films, television programmes and other digital recording media; parts and fittings for all of the above goods.*

Class 16: *Printed matter; photographs; books; publications; magazines; newsletters; newspapers; albums; periodicals; journals; catalogues; pamphlets; leaflets; posters; instructional and teaching materials for education and information; book covers; drawings; paintings; prints; pictures.*

Class 41: *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.

5 The decision was based on the following main findings:

- Although names of authors are not per se unregistrable for goods such as books and films, George Orwell is a very famous author who died in 1950.
- In the decision of 15/05/2018, R 2382/2017-2, SIBELIUS, it was found that with the passage of time, and with the factors of ongoing widespread use and universal recognition, certain very well-known names (such as SIBELIUS) may cease to have a trade mark impact due to their coming to be viewed as mere generic indications. The existence of copyright was not, in itself, a sufficient justification for granting trade mark rights in perpetuity to the composer's name.
- The case concerning the sign 'Le journal d'Anne Frank' (31/08/2015, R 2401/2014-4, Le journal d'Anne Frank) cannot be compared as it refers not simply to a name but rather to an autobiographical work, this being the only work for which Anne Frank is famous. Autobiographical works are inescapably linked to the person whose life is written about, it being central to the reader's understanding of such works that they are either written by, or at least authorised by, the subject of the work.
- In contrast, George Orwell is the writer of a large body of work including two novels which are universally regarded as classics (*1984* and *Animal Farm*), several other novels, literary criticism, social and political commentary, an account of colonialism (*Burmese Days*) and a classic account of the Spanish Civil War (*Homage to Catalonia*). Unlike Anne Frank (who is known as the writer of one book), George Orwell is recognised, with his wide-ranging and richly varied canon, as one of the key literary figures of the first part of the twentieth century. Given this context the name 'George Orwell' will not convey a distinctive trade mark significance for the relevant consumer of the refused goods and services but will rather be seen as a descriptive indication of subject matter: being by or about George Orwell.
- As regards the applicant's reference to Article 14(1)(b) EUTMR, the mere existence of a defence for honest descriptive use has no bearing on the exclusion from registration; there is therefore no relevant interplay between the scope of that exclusion and the limitation of liability for infringement of a validly registered mark.
- Concerning the fact that the applicant is the owner of the George Orwell name, the average relevant consumer may well be unaware whether the works of George Orwell are still in copyright or not, indeed as a purchaser they may neither know nor care; however they will certainly be aware that George Orwell is a giant of English literature whose works and enduring reputation are ensured in what may be considered 'the universal cultural heritage'.

– The practice of the Office concerning marks of famous persons has been in evolution, particularly since the decision of 15/052018, R 2382/2017-2, SIBELIUS. All the registrations mentioned by the applicant in fact predate that decision, the exact considerations leading to some of those acceptances may have represented a somewhat more lenient approach than that now taken.

Appeal R 2248/2019-5: Notice of appeal and statement of grounds

6 On 2 October 2019, the applicant filed an appeal against the contested decision, requesting that the decision be set aside. The statement of grounds was received on 2 December 2019. The arguments raised in the statement of grounds may be summarised as follows:

– The sign 'GEORGE ORWELL' has been used and controlled by the applicant to ensure that consumers can readily identify the original works of the deceased author. As a result, the relevant public perceives the 'GEORGE ORWELL' sign as indicating that the contested goods and services originate from either the applicant or economically linked undertakings. For the purpose of showing its control on the trade mark 'GEORGE ORWELL', the applicant encloses (Enclosure A) examples of news articles demonstrating some of the applicant's commercial activities in managing the original works of George Orwell, (Enclosure B) materials demonstrating the activities and reach of the Orwell Foundation and the Orwell Prizes, (Enclosure C) examples of agreements with theatre, film and television companies giving them authorisation to make use of the applicant's rights (marked as confidential), (Enclosure D) a printout from the Anne Frank Fonds website listing adaptations and printouts from Amazon demonstrating the adaptations for sale to the public, (Enclosure E) examples demonstrating that a large body of literature about Anne Frank and her work exists, and (Enclosure F) examples of remixes of original works by the Finnish composer Sibelius.

– Where little or no control has been exercised over a work, as for example 'The Jungle Book', it ceases to have a trade mark impact as it comes to be viewed as a mere generic indication.

– 'GEORGE ORWELL' is similar to the mark 'Le journal de Anne Frank' whereas the 'SIBELIUS' case was different because it applies to a composer and the services are also different (*live performances*).

– It has not been shown that 'GEORGE ORWELL' will be perceived by the public as generic or descriptive.

– Other more famous writers have been registered as marks for example: F. SCOTT FITZGERALD (EUTM No 15 433 519), IAN FLEMING (EUTM No 2 475 234) or ALBERT CAMUS (EUTM No 11 832 458).

Fifth Board's communication to the applicant

7 On 6 April 2020, the Fifth Board sent a communication to the applicant with the following observations:

– The contested sign 'GEORGE ORWELL' is the name of a very famous person who left an important legacy in world literature by his work.

– Following the evidence enclosed in the communication, George Orwell was known for his journalism, both in the British press and in books of reportage such as *Homage to Catalonia* (describing his experiences during the Spanish Civil War). As a novelist, his masterpieces are the enormously successful titles *Animal Farm* and *1984*. The former is considered an allegory of the corruption of the socialist ideals of the Russian Revolution by Stalinism, and the latter is Orwell's prophetic vision of the results of totalitarianism; a number of words and phrases that Orwell coined in his work *1984* have entered the standard vocabulary, such as 'memory hole', 'Big Brother', 'Room 101', 'doublethink', 'thought police', and 'newspeak'.

– He is also known for his insights about the political implications of the use of language, as for example in the essay *Politics and the English Language*.

– Consequently, an important and relevant part of the general public, well aware of the well-known character of 'George Orwell' as an important and outstanding writer in worldwide literature, will with respect to the contested goods and services establish immediately a relation as to their topic or content, in the sense that they deal with or include some aspect of the person or biography of George Orwell or of his work.

– The Board submits evidence found on the internet that shows the universal knowledge of George Orwell and his reputation which has as direct consequence that there are many publications, references, open discussions or events and seminars about 'George Orwell' and /or his work. This confirms and supports the descriptive character and lack of distinctiveness of the sign as indicated in the contested decision.

– Annex A of the communication contains internet references from 6 April 2020, Annex B contains further references to the exceptional reputation of George Orwell in secondary literature. The use identified in Annexes A and B of the communication is wholly descriptive use with a reference to the workings of the author George Orwell. This use is the kind of descriptive use permitted by Article 14 EUTMR; the sign 'GEORGE ORWELL' is the name of a very famous person who left an important legacy in world literature by his work.

– Therefore, the sign is not eligible for registration pursuant to Article 7(1)(c) and (b) EUTMR for the contested goods and services.

Observations by the applicant

8 On 8 June 2020, the applicant submitted the following observations in reply to the communication of the Fifth Board of Appeal:

– By the very nature of fame, the name of the person concerned will be used in the titles of articles or books about them or their work.

– The use of a trade mark recognises the ability of a person's name, especially an unusual name such as Orwell, to designate origin. The Office has recognised this right of a performer in accepting a range of personal names as trade marks.

Referral to the Grand Board

9 By an interim decision dated 2 July 2020, the Fifth Board referred the case to the Grand Board. The main reasons were the following:

– The Office and the Boards of Appeal have issued diverging decisions with respect to the registrability of names of famous persons for goods and services such as *videos; CD's; movies* (Class 9), *printed matter; photographs; books; paintings* (Class 16), or *entertainment; cultural activities; educational services* (Class 41).

– The consequence is that some applications consisting of such names are registered as EU trade 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 name of a famous person will be seen as information regarding the content or the subject matter of the goods and services and being considered as non-distinctive and descriptive in the meaning of Article 7(1)(b) and (c) EUTMR.

INTA's written observations

10 On 3 March 2021, after the publication in the Official Journal of the Office of the referral to the Grand Board, the International Trademark Association ('INTA') sent its written observations pursuant to Article 37(6) EUTMDR. INTA takes the view that 'the underlying issue of this case 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", which has given rise to contradictory decisions'. The main arguments are as follows:

– The outcome of this case could disrupt any sector involving famous names, from art and literature to sport, history, science and fashion. Numerous trade marks consisting of personal names, including famous ones, are registered in various registries, including that of the Office. The validity and enforceability of those marks, as well as of future applications, could therefore be adversely affected.

– The right to protect a name and in particular a famous name, as a trade mark, should be safeguarded. Names of famous persons should not be subject to

special treatment which is more severe than that applied to other signs of which a trade mark may consist.

– The adoption of a priori rules on the assessment of the distinctive character of signs of which a trade mark may consist, including names of famous persons, should be discouraged. Names of famous persons are not per se descriptive or non-distinctive in connection with specific categories of goods and/or services. Like any other sign of which a trade mark may consist, names of famous persons may serve as indicators of the origin of any goods or services, unless there are additional factors pointing to a different conclusion. It is a case-by-case assessment, taking into consideration all the circumstances of the case to determine whether a specific famous name would be perceived as a distinctive sign in connection with the concerned goods or services.

– The Grand Board should clarify that famous persons' names 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 colours). This is important to avoid famous persons' names being subject to a higher threshold to establish distinctive character.

– Once registered, the scope of protection of famous persons' names as trade marks would not affect the right of third parties to use such names in a descriptive, non-trade mark, manner.

– If a name has developed a meaning that denotes a kind of goods, then it will be ineligible for registration on the basis of descriptiveness.

– Names are not excluded from registration a priori, and for the same reasons, names of famous persons are not excluded from registration a priori. On the contrary, they are expressly mentioned as signs that may be registered as trade marks under Article 4 EUTMR.

– If one were to accept that famous names denote content (namely per the examiner 'by or about' a person) and are for this reason descriptive and therefore non-distinctive and exclude them from registration, the same should be accepted for non-famous names.

– Finding that famous names are ineligible for registration because of that, would lead to a finding that (a) all names are ineligible for registration as they all denote content, namely a *contra legem* finding and (b) content is denoted for all goods and services, which would be a finding contrary to consistent EU trade mark case-law. This would lead to the exclusion of all names from registration not only for books but for any goods or services, something that would go against the express wording of the EUTMR and EUTMDR as well as established CJEU case-law. Consequently, not only names, but also any meaningful word could be seen as potentially denoting content of any book, rendering all meaningful word marks unregistrable for books.

– Therefore, a) reputation is not a criterion as such and b) the criterion of ‘denoting content’ as ‘by or about’ is not a criterion as such, since the actual function of any name is to denote ‘by or about’ and should be interpreted restrictively as covering only words that directly describe the goods or services at issue.

– It would be counter-intuitive to state that names of famous persons/authors are per se non-distinctive because of their fame. Even assuming that said names are not inherently distinctive, they may have acquired distinctiveness through use under Article 7(3) EUTMR.

– On the one hand, possible descriptive uses of the names at issue, made in accordance with Article 14 EUTMR, would not amount to trade mark infringement and therefore cannot be legitimately barred by the owner of the relevant mark; on the other hand, if the owner of the mark at issue makes only descriptive use or non-trade mark use of the said mark it would be exposed to a revocation for non-use of the same.

– Names of authors as well as famous authors are not per se excluded from trade mark protection with respect to goods such as books and films. In particular, names of authors may very well serve as an indicator of the origin of the relevant goods/services and be consequently registered as a trade mark. It must be assessed, on a case-by-case basis, whether a specific famous name would be perceived as a distinctive sign in connection with the concerned goods/services, by applying the standard threshold, applicable to all the other signs.

– Regarding Article 7(1)(d) EUTMR, the mere fact that the contested sign is a famous person’s name does not, of itself, establish genericness. Whether it denotes a genus of goods must be assessed in light of all relevant circumstances affecting public perception. None of these circumstances apply in the present case.

– With regard to the case-law mentioned in the interim decision, the following is submitted.

i) The Sibelius ruling

– The decision in Sibelius is, in turn, based on the General Court’s judgment of 30/06/2009, T-435/05, DR. NO / DR.NO, EU:T:2009:226. However, that judgment cannot serve as a basis for finding that the sign ‘GEORGE ORWELL’ is descriptive or devoid of distinctive character in relation to goods and services in Classes 9, 16 and 41, because it concerned a specific factual situation. In that case, the applicant claimed de facto trade mark protection for the sign ‘Dr. No’ as a well-known mark/use-based right. The Court was required to determine whether the sign could benefit from the protection claimed and whether ‘Dr. No’ had been used by the applicant as a trade mark. Therefore, the Court examined the documents submitted by the applicant and found that it showed only descriptive use of the sign. The factual finding made by the Court in the Dr. No case cannot lead to a general principle whereby famous persons’ names and/or titles would be perceived

as an indicator of the content or subject matter of books, films, or entertainment, cultural or educational services in Classes 9, 16 or 41. Even more so when the Court in the Dr. No case explicitly confirmed in paragraph 24 that: 'Dr. No is the title of the first film in the "James Bond" series and 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'.

ii) The Janis Joplin ruling

– In the decision of 24/03/2015, R 2292/2014-4, JANIS JOPLIN, the Board rightly found that the name of the artist 'JANIS JOPLIN' does not indicate the 'content or subject matter' of goods such as 'CDs, DVDs' or 'downloadable musical sound recordings' (Class 9) or the services 'providing websites featuring information in the field of music and entertainment' (Class 41), but instead it functions as a trade mark, with the result that Article 7(1)(b) or (c) EUTMR are not applicable.

iii) The journal d'Anne Frank ruling

– INTA agrees with the Board of Appeal findings in the decision of 31/08/2015, R 2401/2014-4, Le journal d'Anne Frank, in that when a sign is linked to a single source it shall prima facie considered to be distinctive.

iv) The Van Gogh Museum and Museo Gaudi rulings

– INTA agrees with the rationale in the decisions 14/07/2016, R 1969/2015-2, Van Gogh Museum Amsterdam (fig.), 14/07/2017, R 2197/2016-2, MUSEU ANTONI GAUDI, and 14/07/2017, R 2196/2016-2, MUSEU GAUDI that, at the very least, famous persons' names may have acquired distinctiveness through their use and the applicant is entitled to claim it.

Applicant's observations on INTA's written observations

11 The applicant's observations in relation to INTA's written observations can be summarised as follows:

– The applicant agrees in general terms, in particular that authors' names are inherently registrable as trade marks. The contested sign has not been used in such a way as to lose its trade mark significance.

– The name George Orwell is not descriptive of a type of story, it is merely that the author is well known for writing examples of a genre such as dystopian novels. The use in everyday language is illustrative rather than generic. Otherwise, an author would be in the unenviable position of trying to 'suppress' the success or recognition of their work to avoid a challenge to the validity of the trade mark.

– Trade marks are very fact specific and it is possible in extreme cases for an author's name to 'enter into the language' in such a way that trade mark

significance can be lost. The EUTMR allows for this possibility by permitting descriptive use under Article 14 EUTMR and attacks on the validity of any registration under Article 59(1)(a) EUTMR.

– In the case of George Orwell, the name has become well known as opposed to generic and has been carefully policed and licensed.

Division of the EUTM application

12 On 2 May 2023, the applicant filed a request in accordance with Article 50 EUTMR to divide the EUTM applied for, No 17 869 417, GEORGE ORWELL. The Office assigned all goods and services in Classes 18, 21, 25, 28, and 45 with new application number No 18 903 873; this application was registered on 20 March 2024.

Grand Board's questions to the Executive Director of the Office and his comments

13 On 22 July 2024, the Grand Board invited the Executive Director to submit comments, in accordance with Article 29 EUTMDR, on questions of general interest pursuant to Article 29 EUTMDR which arose during the above proceedings. The comments were submitted on 19 February 2025. For ease of reference and to avoid repetitions only the comments are summarised here and not the questions.

(i) Comments in relation to Article 7(1)(c) EUTMR

– The term 'characteristic' within the meaning of Article 7(1)(c) EUTMR designates a property, easily recognisable by the relevant public for the goods or the services in respect of which registration is sought, which, consequently, must be 'objective' and 'inherent to the nature of that product' or service (06/09/2018, C-488/16 P, NEUSCHWANSTEIN, EU:C:2018:673, § 44), and 'intrinsic and permanent' with regard to that product or service (07/05/2019, T-423/18, Vita, EU:T:2019:291, § 44).

– Authors' names can only be a characteristic of books in the sense of Article 7(1)(c) EUTMR if they can be perceived as describing the 'content' (subject matter) of the book (e.g. biographies or commentaries on the author) rather than identifying who the author of the book is. This must be assessed on a case-by-case basis, taking into account that the perception of the relevant name of an author as the subject matter of a book is only likely to be possible if the author is famous and has gained a degree of gravitas in the broader social or cultural sense.

– The public, when confronted with a book, will perceive: (a) its title, (b) the name of the author of the literary work and (c) the name of the publisher. The title identifies a specific literary work, the author identifies the artistic origin of the literary work, and the publisher identifies the commercial origin of the book. The presumed expectation (08/04/2003, C-53/01, Linde, EU:C:2003:206, § 41) of the average consumer of books, who is reasonably

well informed and reasonably observant and circumspect, is to find this information on the book cover.

– The indication of authorship, therefore, identifies the artistic origin (30/06/2009, T-435/05, DR. NO / DR.NO, EU:T:2009:226, § 25) of the literary work contained in a book. Although the name of the author is very important to the relevant consumer's decision to purchase a book, this is not the indication that a trade mark for books protects. The function of a trade mark for books is not to indicate the artistic/cultural origin of the literary work but rather to indicate the commercial origin (18/06/2002, C-299/99, Remington, EU:C:2002:377, § 30) of the book – namely, the publisher.

– The authorship of a literary work is protected by copyright law via the moral right of attribution, meaning that the creator of a work is attributed and recognised as its author. This, however, is an aspect of a book that the consumer will perceive as quite distinct and separate from the indicator that relates to the book's commercial provenance.

– The name of the author of a book is not 'serving in trade to designate' a 'characteristic' of a book under Article 7(1)(c) EUTMR when it is merely identifying the book's author.

– The examination of whether an EUTM consisting of the name of an author can indicate the commercial origin for books under Article 7 is not subject to any a priori rules merely because the sign consists of the name of an author.

– If, however, the examination determines that the public will identify/recognise the name of an author in the sign and will perceive the name as describing the content (subject matter) of the book, the sign is descriptive.

– It is only after examining all the relevant factors, however, that the Office could reach such a conclusion. In essence, the question is whether, in the consumer's perception, it is likely that there would be publications about the author. If the answer is yes, the author's name is objectionable as it would indicate that particular subject matter. The factors should be considered in a global assessment and include:

  - fame and recognition of the author: this may be a well-known fact or an *ex officio* investigation may reveal that an author's fame and recognition is in a particular area such as mathematics;

  - widespread use of the work of the author: the work has been widely distributed, possibly with different adaptations and formats; it is part of school or university curricula; it has been converted into film or graphic work;

  - social and cultural integration: there are prizes that bear the name (e.g. Premio Miguel de Cervantes), statues erected in their honour, parks or

schools that bear their name (e.g. parc Jean Rousseau, lycée Balzac), museums (e.g. musée Victor Hugo);

- period for which the author has been known: if the author has been known for a long period including, for a deceased author, whether fame, recognition, social and cultural integration remain long after death;

- nouns or adjectives that have been created from the name of the author: these can be an indication of the impact of an author's works on society, for example, Kafkaesque, Dantesque or Dickensian (these terms usually reflect a special style or atmosphere present in their works);

- market reality: is there a section of a library or bookshop dedicated to books about this person or their work.

– This is a combination of interrelated factors that reflect, in some way, the gravitas of an author which would provide a rationale for them being perceived by the relevant consumer as the subject matter of a publication.

– Books may be written about a famous author, in which case, there could be an objection based on descriptiveness under Article 7(1)(c) EUTMR. It is possible that the expiration of copyright of the author's works may be relevant in the analysis of descriptiveness to the extent that it might affect the consumer's perception. In this way, the expiration of copyright could indirectly affect the examination of descriptiveness under Article 7(1)(c) EUTMR.

– When examining descriptiveness, the expiration of copyright protection of the author's works can be a factor when assessing the perception of the sign by the relevant consumer because, once copyright in a work expires and it enters the public domain, there can be an impact in the marketplace, such as:

  - the use of the works of an author might become more widespread, with more adaptations and versions;

  - as the works become freely available, it may result in their inclusion in more cultural and educational material and to higher visibility and recognition of the work in popular culture;

  - the name of the author or of the book might re-enter the public lexicon or see significantly increased usage.

– An increased exploitation of the works on expiration of copyright would, in general, go hand in hand with increased use of the author's name. As a result, the consumer's perception of the author could be affected by the expiry of copyright in the author's works. Nevertheless, the examination of descriptiveness will always be an overall assessment, taking into account all the relevant factors in relation to the perception of the relevant mark.

– Finally, copyright protects original expressions in works of authorship but not the name of the author of a copyrighted work. The expiration of copyright referred to, therefore, must relate to the works of the author not the name of the author. The name of the author of a work is protected by 'moral rights' that ensure the name of the author is associated faithfully with their works (e.g. George Orwell must always be referred to as the author of his books, such as *Animal Farm* or *1984*). This moral right of attribution is intended to protect an author's non-economic and non-proprietary interests.

(ii) Comments in relation to Article 7(1)(b) EUTMR

– Names of authors can be distinctive for books pursuant to Article 7(1)(b) EUTMR provided that they are capable of identifying the commercial origin of those goods. EUTM applications consisting of names of authors are not subject to any 'special treatment' during their examination and will be rejected only if they fall within a ground for refusal under Article 7 EUTMR. The distinctiveness of a mark consisting of the name of a famous author is examined according to the relevant consumer's perception of the mark on its own merits.

– In this regard, the existence (or expiration) of copyright protection in the works of a famous author does not determine the distinctiveness of a mark consisting of an author's name for books. The status of the copyright protection of such works per se is irrelevant in the assessment under Article 7(1)(b) EUTMR, whether that status is a well-known fact or not.

– The Office's examination of a sign for books does not evaluate the mark's ability to indicate the name of the author of the specific literary work but only its ability to indicate the commercial origin of books (i.e. the publisher). The fact that the public is aware that the name of an author is independent from the publisher (commercial source) is immaterial for this examination.

(iii) Comments in relation to Article 7(1)(d) EUTMR

– It cannot be ruled out that, in exceptional cases, the conditions might be met for the name of a famous author to become customary in relation to books. For this to happen, the author's name would have to have been used to a significant extent as a common term to designate books themselves or books with certain characteristics (and not just to designate the author of a book).

– Some neologisms have been created based on names of authors. These normally describe a kind of atmosphere or genre linked to the work of the writers or a type of behaviour, such as, Kafkaesque, Dantesque, Orwellian or Machiavellian (*Ces adjectifs qui viennent de la littérature*, *Le blog de Plume !*; Plume (2022). These terms might be/have been considered generic. However, they do not consist of the name of the author per se but of an adjective derived from the name.

– The status of the copyright of the author's books is per se, irrelevant in the assessment of the customary nature of the author's name under

Article 7(1)(d) EUTMR. It is only the possible impact that copyright protection may have on the market and the consequent perception of the relevant consumer that could be relevant in an indirect manner.

(iv) Public interest v private interest

– The identity of the applicant does not impact the substantive assessment of a sign under any of the grounds relevant to this referral under Article 7 EUTMR.

– The irrelevance of the identity of the applicant is supported by Recital 26 EUTMR, which indicates that the identity of the owner of the mark is not relevant to the assessment of absolute grounds for trade marks. It states that an EUTM is to be regarded as an object of property which exists separately from the undertakings whose goods or services are designated by it and that, accordingly, the trade mark should be capable of being transferred, being charged as security in favour of a third party and being the subject matter of licences. If the identity of the trade mark owner were relevant to the assessment of a sign under Article 7 EUTMR, it would follow that a new examination of the mark following transfers would be necessary, but there is no basis for this under the EUTMR.

– The principle that the identity of the applicant plays no role in assessments under Article 7 EUTMR has been endorsed by the General Court and by the Boards of Appeal (13/11/2024, T-82/24, RUSSIAN WARSHIP, GO F**K YOURSELF (fig.), EU:T:2024:821, § 42, 43).

– The applicant's argument that the mark applied for is directly and unambiguously associated with the applicant, who is the author, cannot be taken into account when assessing inherent distinctiveness of that mark.

– In decision 25/02/2015, R 1856/2013-2, PINOCCHIO, § 38, the Board of Appeal stated: 'with regard to the fact that the cancellation applicant is the owner of the CTM application No 9 740 457, […] and details of the assignment of ownership rights by Oscar Tirelli, [the] artist who created the so called "Aquatic Pinocchio", to the cancellation applicant, are irrelevant in the present proceedings. The case beforehand only deals with the assessment of the distinctiveness of the CTM proprietor's contested mark, and not the alleged contractual rights of the parties or the assessment of likelihood of confusion between the said marks.'

– In decision 15/05/2018, R 2382/2017-2, SIBELIUS, § 39, the Board of Appeal stated: 'the fact that the applicant represents the heirs of Jean Sibelius does not support the conclusion that the trade mark application has distinctive character. In examining the absolute grounds for refusal, no account was taken of copyright, raised by the applicant, nor even rights pertaining to the name. A trade mark application may be transferred freely to a third party at any time.'

– The irrelevance of the applicant when assessing absolute grounds is congruent with Article 7 EUTMR's primary purpose of protecting the public (04/05/1999, C-108/97 & C-109/97, Chiemsee, EU:C:1999:230, § 25; 06/05/2003, C-104/01 Libertel EU:C:2003:244, § 50), rather than private interests.

– Private interests, on the other hand, are protected in relative grounds proceedings (opposition under Article 8 EUTMR and cancellation under Article 60 EUTMR). There, the entitlement to enforce an earlier right must be claimed and proven (Article 46(1) and Article 63(1) EUTMR) since the identity of the applicant of the cancellation action or opposition is essential.

(v) Comments on cultural heritage

– The concepts of 'famous' and of 'cultural heritage' are not defined in the EUTMR nor in Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks (the 'TM Directive').

– The term 'famous', from a literal point of view, means someone or something that is 'well-known' (Collins online dictionary definition of 'famous': 'Someone or something that is famous is very well known').

– EU case-law has defined 'well-known facts' as referring to something that is a matter of common knowledge. In particular, 'well-known facts' are those that are likely to be known by anyone or that may be learnt from generally accessible sources (17/09/2020, C-449/18 P & C-474/18 P, MESSI (fig.) / MASSI et al., EU:C:2020:722, § 74).

– The General Court has found that the fact that the relevant public is aware that a sign consists of the name of a person that is 'famous' in the field of art, music, politics or sport, can be a matter of common knowledge (22/06/2004, T-185/02, PICASSO / PICARO, EU:T:2004:189, § 55; 26/04/2018, T-554/14, MESSI (fig.) / MASSI et al., EU:T:2018:230, § 61). This approach was adopted in the context of relative grounds proceedings but can also serve in the *ex officio* analysis carried out in absolute grounds examination (15/03/2006, T-129/04, Plastikflaschenform, EU:T:2006:84, § 16-19).

– In the context of absolute grounds for refusal, the assessment of whether the name of a person is considered 'famous' can be the result of facts of common knowledge that can be learnt from generally accessible sources (e.g. dictionaries: 23/05/2019, T-439/18, ProAssist, EU:T:2019:359, § 17-18 or encyclopaedias or websites: 19/01/2022, T-483/20, Shoes (3D), EU:T:2022:11, § 67-68) and/or it can be the result of an *ex officio* investigation related to the specific circumstances of the case when it pertains to a specific audience or area (e.g. mathematics).

– Relevant information concerns, for instance (by analogy, 26/04/2018, T-554/14, MESSI (fig.) / MASSI et al., EU:T:2018:230, § 56, 58, 61;

16/06/2021, T-368/20, Miley Cyrus / Cyrus et al., EU:T:2021:372, § 51), the person's popularity, their public exposure in the media (e.g. press, television, radio), awards, prizes and other achievements, their legacy and influence in a relevant field (art, literature, music, politics or sport) as well as in society generally.

– It is impossible to determine a priori an exhaustive list of criteria to be applied in the assessment of whether the name of a person is 'famous' as it boils down to a question of fact that must be carried out on a case-by-case basis (by analogy, 18/09/2024, T-1099/23, LEMOON / LENNON, EU:T:2024:630, § 62) to establish the degree of recognition amongst the relevant consumers.

– There is no officially agreed interpretation of the expression 'cultural heritage' (for instance, UNESCO, Convention Concerning the Protection of the World Cultural and Natural Heritage, Article 1 (16 November 1972)); UNESCO Glossary from the Institute for Statistics, 2009; EU Policy for cultural heritage from DG EAC (the Commission's Directorate-General of Education, Youth, Sport and Culture) but it can be inferred from various definitions and usage to be a broad term that covers tangible and intangible aspects of a society or community such as values, traditions, art (literature, music, painting, etc.).

– Being part of the UNESCO World Heritage List or of any other official register of a similar kind can be an objective indication that something is part of 'cultural heritage'. However, this kind of official recognition is not necessary, as a community can still perceive a work, place or tradition as part of its cultural heritage.

– The Office's Guidelines for Examination (Guidelines, Part B, Examination, Section 4, Absolute grounds for refusal, Chapter 4, Descriptive trade marks, paragraph 2.7.2, Titles of books) suggest that the fact that a book, or its story, is included in a high-profile encyclopaedia, that it frequently forms part of school/university curricula and that it is subject to ample scientific research and abstract analysis of its main themes, might be an indicator that it is considered a 'classic', that is to say, a work that has reached a universal importance that stretches beyond its actual content and that actively forms part of the cultural DNA of the general public (e.g. 'The Odyssey', 'The Divine Comedy', 'Don Quixote'). The same is applicable to authors.

– The foregoing are examples of factual circumstances that can be of relevance in the context of the examination of the registrability of a trade mark. Nonetheless, there is no fixed criteria to be adopted for defining whether a work, or the name of its author, is part of cultural heritage. For this reason, the Office is not able to establish, in the abstract, comprehensive criteria under which the name of a person or other signs form part of the 'cultural heritage'.

– It is not the role of the Office to take a position on whether there is a public interest in preserving universal cultural heritage. Article 7 EUTMR sets out the basis on which the Office must refuse a trade mark. These provisions are

exhaustive and mainly aim to ensure that the sign for which registration is sought can function as a badge of commercial origin.

– Cultural heritage is not a factor that is enumerated under the exhaustive absolute grounds for refusal set out under Article 7 EUTMR. In this regard, even if cultural heritage was to be considered of high symbolic value, the EUTMR does not contain an equivalent provision to Article 4(3)(b) of the TM Directive, which sets out that Member States may provide that a trade mark is not to be registered where and to the extent that the trade mark includes a sign of high symbolic value.

– As to the interests of the applicant, the identity or interest of the applicant is not relevant in the trade mark examination of EUTM applications under Article 7 EUTMR.

(vi) Comments on the impact of an author's fame, or of their status as part of a Member State's cultural heritage, on the assessment under Article 7(1)(b) and (c) EUTMR

– The fame of an author, as well as the fact that they or their works might form part of the cultural heritage of a Member State or of universal cultural heritage, are among the many factual elements that can have an impact on consumer perception of the sign. Therefore, they can be relevant when a sign is examined under Articles 7(1)(b) and (c) EUTMR regarding subject matter, but they are not a basis for objection per se.

(vii) Comments on the impact of an author's fame, or of their status as part of a Member State's cultural heritage, on the assessment under Article 7(1)(d) EUTMR

– The fame of an author or whether they might form part of the cultural heritage of a community is not in itself enough to alter the conclusions reached above. What matters is how these factors might affect the perception of the relevant consumer.

(viii) Comments on the impact of an author's fame, or of their status as part of a Member State's cultural heritage, on the assessment under Article 7(1)(e)(iii) EUTMR

– The fame of an author or the fact that they might form part of the cultural heritage is not enough to alter the outcome of the Office's analysis of that provision.

(ix) Comments on the impact of an author's fame, or of their status as part of a Member State's cultural heritage, on the assessment under Article 7(1)(f) EUTMR

– The Office does not regard the registration of the name of a famous author as a trade mark per se as going against those fundamental EU norms

protected through Article 7(1)(f) EUTMR, even if the author could be said to form part of the cultural heritage of a community.

- The concept of accepted principles of morality refers to the fundamental moral values and standards to which a society adheres at a given time. Here again, the Office considers that, in principle, the registration of the name of a famous author as a trade mark does not go against fundamental moral values and standards protected through Article 7(1)(f) EUTMR, even if the author could be said to form part of the cultural heritage of a community.

- However, it cannot be excluded that an application consisting of the name of a famous author (including one considered part of a nation's cultural heritage) may be considered contrary to accepted principles of morality. Where, according to the particular context and circumstances, there is a very particular strength of feeling and reverence or hostility towards an author amongst the relevant public, the registration of the name as a trade mark (with the implied commercial exploitation) could be perceived as offensive. This would be quite an exceptional occurrence and would require evidence of a very particular set of circumstances as the threshold for an objection on this basis would be high (the trade mark must be assessed by reference to the standards and values of ordinary citizens, not those who are exceptionally puritanical or are at the other end of the spectrum (06/07/2006, R 495/2005-G, SCREW YOU, § 21)).

(x) Comments in relation to Article 7(1)(e) EUTMR

- Word marks do not fall within Article 7(1)(e) EUTMR and consequently word marks consisting of authors' names do not fall within Article 7(1)(e) EUTMR.

- Marks consisting of the name of a reputed author of a book should not be considered a characteristic that gives substantial value to these books within Article 7(1)(e) EUTMR.

- A teleological reading of Article 7(1)(e)(iii) EUTMR does not support treating the name of an author as a characteristic that gives substantial value to books.

- The stated objective of Article 7(1)(e)(iii) EUTMR is to prevent the exclusive and permanent rights that a trade mark confers from serving to extend the life of other IP rights indefinitely (18/09/2014, C-205/13, Tripp Trapp, EU:C:2014:2233, § 19-20; 14/09/2010, C-48/09 P, SHAPE OF A LEGO BRICK (3D), EU:C:2010:516, § 43-45; 06/10/2011, T-508/08, Loudspeaker (3D), EU:T:2011:575, § 65), which the EU legislature has sought to make subject to limited periods. Obtaining a trade mark for the name of an author for books, however, would not extend the life of other IP rights. This is because the author is merely the initial owner of the copyright in the books they have written. It is the literary work itself (not the name of the author), which is protected by copyright and which, once in the public domain, can be freely used, reproduced and adapted (subject to possible restrictions regarding the moral rights of the author).

– Obtaining a trade mark for the name of the author would not allow the trade mark owner to exploit functions that are meant to return to the public domain upon the expiry of copyright protection (Article 7(1)(e)(iii) EUTMR could, however, be relevant in preventing attempts to extend copyright protection via the trade mark system where the trade mark depicts the protected work (e.g. an object such as a statue or a painting), which is the basis of the questions raised in the preliminary ruling of the EFTA Court (E-5/16)).

– The Office supports the position set out by the Advocate General in Louboutin (12/06/2018, C-163/16, Louboutin and Christian Louboutin, EU:C:2018:423, Opinion of the Advocate General) that 'substantial value' should be exclusively based on the value added to the goods by the shape (or another characteristic) and not by other factors such as the reputation of the designer (16/01/2013, R 2520/2011-5, Shape of Guitar Body (3D), § 19), (a principle that has also been applied by the Board of Appeal (14/12/2010, R 486/2010-2, Shape of a Chair (3D), § 20-21)). The name of a famous author is considered equivalent for this purpose to that of a designer and cannot give substantial value to any good within the meaning of this provision.

– The Office's practice (Guidelines, Part B, Examination, Section 4, Absolute grounds for refusal, Chapter 6, paragraph 1: 'The wording of this provision implies, in principle, that it does not apply to signs for which registration is sought in respect of services') and dicta of the Court of Justice (10/07/2014, C-421/13, Apple Store, EU:C:2014:2070, § 24) are aligned on the point that services are excluded from Article 7(1)(e) EUTMR. This provision's three subsections only refer to goods. It is the only provision under Article 7(1) EUTMR with an explicit reference to goods only whereas the other provisions are either silent about goods and services or expressly mention goods and services.

(xi) Comments in relation to Article 7(1)(g) EUTMR

– It is irrelevant for the examination of Article 7(1)(g) EUTMR whether the applicant is/was (a) the author themself, (b) the author's heir or (c) the holder of any copyright or title right. Copyright ownership can only be relevant in some specific opposition and cancellation actions that protect earlier rights.

Observations of the applicant on the Executive Director's comments

14 On 26 March 2025, the applicant submitted the following observations in relation to the questions sent to the Executive Director and the comments provided.

– The Executive Director is correct in his view that author's names and book titles can, in principle, meet the requirements under Article 7(1) of the EUTMR.

– The main point is the distinction drawn by the Executive Director between signs that specify the artistic origin of a literary or other work (such as a novel) and marks that specify the commercial origin of such works.

– The Executive Director's view is too rigid and lacks flexibility. The same sign may provide an indication of both the commercial and artistic origin of a creative work. If such a sign is capable in principle of indicating commercial origin, it should be registrable as a trade mark.

– This point on trade mark use engages a number of different areas of trade mark law including:

(i) The functions of a trade mark and book titles and author names

– Article 4 EUTMR provides that any sign, including personal names, may be registered as a trade mark, provided that it is capable of distinguishing the goods of one undertaking from those of others. Trade marks are recognised to have the function of guaranteeing both origin and quality of goods sold under them. They also have the function of protecting investment made in developing a reputation associated with the mark. Trade marks are recognised to have an advertising function preventing use of signs identical or similar to the trade mark where this use interferes or adversely affects the proprietor's ability to use the trade mark in sales promotion or as part of its commercial or marketing strategy. Trade mark functions in the case-law are open-ended and have evolved incrementally. Accordingly, whether book titles and author names can serve as trade marks should be assessed flexibly, with regard to existing and emerging functions as the jurisprudence develops.

(ii) Signs that denote artistic origin and the distinction (if any) with commercial origin

– The existence of copyright in a literary, artistic or other work does not preclude trade mark protection for the same sign (07/06/2023, T-735/21, DEVICE OF A STYLISED DEPICTION OF A BLACK BAT INSIDE A WHITE OVAL FRAME (fig.), EU:T:2023:304, § 44).

– Any weight placed by the Executive Director on parallel copyright or moral rights cannot justify curtailing trade mark protection; such parallel rights are without prejudice to registrability and enforcement of trade marks.

– Names of bands and musical groups, artists, films and directors often accompany copyright works, yet the General Court has upheld trade mark rights in such signs, including the following cases: 04/10/2018, T-345/16, DEEP PURPLE / DEEP PURPLE, EU:T:2018:652; 06/12/2018, T-459/17, THE COMMODORES / Commodores et al., EU:T:2018:886. There is no suggestion in any of these cases that these marks are incapable of operating as trade marks that indicate commercial origin.

– In each of these cases, it is recognised that author names and book titles serve as markers of commercial origin just as much as they serve as markers for artistic origin.

– A consumer will rely on an author’s name as an indication of both the trade origin and the quality of a work. For example, the name Gabriel García Márquez on a novel enables a purchaser to distinguish its origin and qualities from those of novels by other Spanish-language authors. The same applies to book titles, which can distinguish works by origin and by qualities. In this sense, author names and book titles are capable of fulfilling the essential function of a trade mark.

– The other functions of a trade mark are also relevant to book titles and author names. Through the advertising function, the title or author name informs and persuades consumers to buy a book when they are browsing. Likewise, through the communication function of the trade mark, the title or author name informs consumers of the provenance of the book – it comes from the same stable as [book title] or from an author which produces books of a certain quality.

– The Executive Director’s response mentions the possibility of the publisher’s name having the role of a trade mark on a product like a book. Similar arguments could be advanced with albums and recordings: it could be argued that the record label name serves a role as a trade mark.

– The applicant agrees that in principle, a publisher name on a book product (or equally a record label name on a sound recording product) might be viewed to have trade mark significance by the average consumer of such products. However, whereas publisher names likely do serve as trade marks, that should be without prejudice to other signs on a book like author names or book titles also serving a trade mark function.

– In fact, the critical product qualities or characteristics, which are important to the average consumer of books or other published material, relate to the authorship of the novel. The author of the novel will be responsible for the quality of the work published, its interest for the reader, its narrative features and genre and all the other product qualities that potentially incentivise a purchase of the product.

– In contrast, the publisher or manufacturer of the book will be responsible for the grade of paper of the book and other features of the work: these features may play some role in attracting a purchase of the work but fundamentally this role will be subsidiary to the qualities or characteristics of the work for which the author is responsible. For this reason, the undertaking which is accountable for the quality of the goods, and who is able to guarantee to consumers the origin of the goods, is primarily the author.

– The identity of a publisher may be important to authors who may need to distinguish between different publishers in terms of the services they provide, or to commercial book retailers and/or distributors who purchase work from the publisher, but it is of little relevance to the consumer in

making the purchasing decision. The name of the publisher does not indicate the most important feature(s) of the book for the consumer, which are its ability to inform or entertain (the two main reasons for buying the book).

– When deciding whether to purchase another book, the consumer will recall the experience they had from reading previous books and choose based on either the author or book title and a recommendation to buy a particular book, identified by either the author or book title.

– Indeed, consumers will focus much more heavily on the title or author of a book than the publisher.

– This is supported by the consideration that an author may publish works with different publishers over time. This is a circumstance that is very unlikely to affect the average consumer's perception of a body of work authored by the same person as sharing a common trade origin. Notwithstanding changes in publisher, an author's name is likely to serve as a consistent guarantee of quality in the eyes of an average consumer.

– A sharp distinction between signs denoting trade origin and signs denoting artistic origin is unwarranted. In many cases, the artistic and commercial origin of a work is in substance one and the same thing and there should be trade mark rights to protect signs that fulfil the functions of a trade mark.

– The analysis is always fact specific and depends on how the works are marketed, the types of parties involved in creating and marketing them and the way in which marks and signs associated with the work are presented to the consumer at every relevant step (including to end users). The analysis will in principle have different results for different types of work. To an extent, the analysis will vary even from book to book, film to film and/or music product to music product, as each specific work will be presented and/or marketed in different ways.

– It appears to be the Executive Director's view that these points will typically affect a trade mark after registration and do not affect the initial registrability of a mark from the perspective of distinctiveness or otherwise. The applicant agrees with the Executive Director on the issue of registrability but also wants to make it clear that these sorts of points should not subsequently affect the issue of genuine use of the trade mark.

(iii) The context of the infringement of book title and/or author name trade marks

– Trade marks in the author's name and/or title of the work would provide additional protection, preventing unauthorised use of identical or similar signs to these marks on such unauthorised copies of the work where the requirements under any one of Article 9(2)(a) and (c) EUTMR are otherwise met.

– The contested sign is plainly performing its normal functions of guaranteeing origin and quality and preventing uses of signs that are adverse to these functions.

– Once copyright expires, third parties may lawfully publish copies of the work without the consent of the rights holder. In principle, trade mark rights in the author's name and/or titles of their works would not obstruct third party entry into the market for such public domain works. To make use of signs corresponding to the author's name or the title of their work in order to market such products, third parties could claim the benefit of the defence under Article 14(1)(c) EUTMR permits use of an EUTM 'for the purpose of identifying or referring to goods or services as those of the proprietor of that trade mark'. That is because they are producing a good incorporating the author's work. In order to market such public domain works, these third-party publishers need to be able to refer to the author's name and/or the title of the work. Such use is generally necessary to identify the work as a work of the author's and is generally in keeping with honest and commercial practices under Article 14(2) EUTMR.

– Nevertheless, even after a work falls into the public domain, there is a role for trade mark protection in signs corresponding to the author's name and/or the titles of their creative works. By way of example:

  • A publisher of public domain works may choose to publish altered or edited versions of an author's work following its entry into the public domain. Examples might include censoring particular sections of the work, conversely adding offensive material into the work that was not previously present or attempting to condense or abridge the work by excising large passages of the work.

  • Such altered works might be presented as works of the author although they do not reflect either the author's opinions or views and/or although they adversely affect the average consumer's impression of the quality of the author's works. Clearly, such uses would adversely affect the origin, quality and investment functions of any trade marks corresponding to the author's name. Claims could be brought under Article 9(2)(a) and (b) EUTMR and (assuming the trade marks have a reputation) Article 9(2)(c) EUTMR. A defence under Article 14 EUTMR would not arise in this context as such uses (apart from anything else) would not be in keeping with honest commercial practices.

  • It would remain possible in this scenario for third parties to publish bowdlerised or altered versions of public domain works. The role of trade mark protection would be to prevent such works being wrongly attributed to the original author. In this sense, trade mark protection would be consistent with the interests of consumer protection, enabling genuine copies of an author's work to be distinguished from non-genuine and/or altered versions.

– Each of these points would raise fact specific issues in any scenario in which they arise. Nevertheless, they identify an important reason why an author or an author's estate has an interest in continuing trade mark protection following the author's works falling into the public domain. That is so not least in relation to authors like George Orwell, whose works are commonly

used in education and/or other contexts where it is important that consumers can guarantee the authenticity of the copy or version from which they are working.

(iv) Relevance of parallel rights in copyright and/or moral rights

– Copyright itself does not prevent unauthorised use of either the title of a work or the author's name but instead the work itself. Indeed, words or short phrases will typically not attract copyright protection. In judgment of 16/07/2009, C-5/08, Infopaq, EU:C:2009:465, § 51, it was ruled that in principle a short extract of work in the form of a sentence or phrase of 11 words could enjoy copyright protection, but only if it expressed the author's own intellectual creation.

– Book titles are generally short and are therefore unlikely to be copyright works. Author's names will not be copyright works in that they are not creative works in the first place.

– It follows that the subject matter of a trade mark covering an author's name or a book title is completely different from the subject matter of copyright. Author's names and book titles cannot generally be protected through copyright.

– As for moral rights, it appears to be the Executive Director's view that these may provide similar protection to the sort of protection that arises from a trade mark in an author's name. The applicant argues that moral rights are not the subject of any harmonisation measures across the Member States through EU Directives or otherwise. Each Member State's laws will differ on this topic and that the scope of such protection will vary from Member State to Member State. In these circumstances, it is not possible to generalise as to the scope or effectiveness of moral rights protection across the EU or as to the extent to which such rights will protect creative works and/or the author's names associated with them from detrimental third-party use.

– At the international level, certain treaties do touch on the issue of moral rights but the focus in these treaties is just to set certain minimum requirements for the protection afforded by the laws of each signatory state. Article 6bis of the Berne Convention is permissive in this regard, permitting states in some cases to restrict such rights to the period of an author's life (or in other words for a shorter term than the corresponding copyright that arises in the work). That reinforces the considerations outlined above.

– The Executive Director's response touches on the right of attribution. This is defined in the Berne Convention as a 'right to claim authorship of' a work under Article 6 *bis* (1). This right arises in effectively the opposite of the normal situation in which there is trade mark infringement. The attribution right is contravened where an author's work is published under a name other than the author's name (i.e. where the author's name is omitted). A trade mark infringement arises by contrast where unauthorised use of the author's name is made. This is therefore not an instance of properly parallel protection. The subject matter of moral rights and the scenarios in which

they might be contravened are generally different from the subject matter and protection afforded by trade mark rights that might arise in an author's name.

– Moral rights do not provide any protection at all in relation to work titles or names. They are a fundamentally different kind of right that do not provide protection for author's names or work titles as indicators of the trade origin or the quality of a good or service.

– Many books become popular long after their initial publication. There is no evidence, of which the applicant is aware, that shows that, in general, the expiry of copyright in a book results in a loss of distinctiveness of either the author's name or the book title as a trade mark.

– It is difficult to address these points in the abstract without detailed evidence on consumer perception or behaviour and the general features of the relevant market.

– In summary, the issue of parallel protection arising from different types of intellectual property rights in this area is not a factor which should curtail the availability of trade mark rights. Trade marks protect different kinds of interests to rights like copyright and moral rights. This is not therefore a situation of completely parallel protection where there is a good foundation for the position that authors or creators should be restricted to copyright or moral rights.

Reasons

15 All references made in this decision to the EUTMR should be seen as references to Regulation (EU) 2017/1001 (OJ 2017 L 154, p. 1), codifying Regulation (EC) No 207/2009 as amended, unless specifically stated otherwise.

16 The appeal complies with Articles 66, 67 and Article 68(1) EUTMR. It is admissible.

17 The Grand Board is competent on the basis of Article 165(3) EUTMR and Article 37(6) EUTMDR following the referral by the Fifth Board.

I. Scope of appeal

18 The applicant contested the decision of the examiner in its entirety.

19 However, the examiner only partially rejected the contested sign. Therefore, the scope of the appeal brought by the applicant is limited to the refused goods and services as listed in paragraph 4 ('the contested goods and services').

20 The examiner refused the contested sign on grounds of Article 7(1)(c) EUTMR and also independently under Article 7(1)(b) EUTMR. The Grand Board will first examine whether the examiner correctly rejected the sign under Article 7(1)(c) EUTMR, after which it will assess Article 7(1)(b) EUTMR.

II. Evidence submitted before the Board of Appeal and confidentiality

21 According to Article 95(2) EUTMR, the Office may disregard facts or evidence which are not submitted in due time by the parties concerned.

22 In accordance with settled case-law (13/03/2007, C-29/05 P, Arcol, EU:C:2007:162, § 43-44; 11/12/2014, T-235/12, Grass in bottle, EU:T:2014:1058, § 62), which is now enshrined in Article 27(4) EUTMDR, the Grand Board may accept facts or evidence submitted for the first time before it only where those facts or evidence are on the face of it, likely to be relevant for the outcome of the case and they have not been produced in due time for valid reasons, in particular where they are merely supplementing relevant facts and evidence which had already been submitted in due time, or are submitted to contest findings made or examined by the first instance of its own motion in the decision subject to appeal (09/02/2022, T-520/19, Heitec, EU:T:2022:66, § 36).

23 The applicant provided on appeal additional evidence (Enclosures A-F) in response to the findings of the contested decision on the descriptive character and lack of distinctiveness of the mark. The Grand Board, in the exercise of its discretion, accepts the additional evidence on appeal, which supplements the evidence presented before the examiner, and is relevant for the outcome of the present case.

24 Article 114(4) EUTMR provides that files may contain certain documents which are withheld from inspection, in particular, if the party concerned shows a special interest in keeping them confidential.

25 In the event that a special interest in keeping a document confidential is invoked in accordance with Article 114(4) EUTMR, the Office must check whether a special interest is sufficiently shown. Such a special interest must exist because of the confidential nature of the document or its status as a trade or business secret.

26 The applicant marked as confidential the evidence submitted as Enclosure C, which includes examples of agreements with theatre, film and television companies giving them authorisation to make use of the applicant’s rights.

27 The Grand Board considers that the confidentiality request should be granted, as the information contained in Enclosure C relates to business contracts containing sensitive information which should be kept confidential.

III. Article 7(1)(c) EUTMR

28 Under Article 7(1)(c) EUTMR, 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 services, or other characteristics of the goods or services, shall not be registered. Pursuant to Article 7(2) EUTMR, it is sufficient that an absolute ground for refusal exists in only part of the European Union (EU).

29 According to settled case-law, the signs and indications covered by Article 7(1)(c) EUTMR are those which may serve in normal usage from the point of view of the

relevant public to designate, either directly or by reference to one of their characteristics, the goods or services in respect of which registration is sought or contested (20/09/2001, C-383/99 P, BABY-DRY, EU:C:2001:461, § 39; 10/09/2015, T-610/14, BIO organic, EU:T:2015:613, § 14; 25/10/2018, T-122/17, DEVIN, EU:T:2018:719, § 18; 15/02/2023, R 1083/2018-G, EL TOFIO El sabor de CANARIAS (fig.), § 28).

30 By using the terms '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' in Article 7(1)(c) EUTMR, the EU legislature made it clear, first, that those terms must all be regarded as corresponding to characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account (07/05/2019, T-423/18, vita, EU:T:2019:291, § 42).

31 The fact that the EU legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in Article 7(1)(c) EUTMR are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. Consequently, a sign can be refused registration on the basis of that provision only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics. 'Characteristic' highlights the fact that the signs to which the exclusion from registration applies are those which merely serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. It must be reasonable to believe in the mind of the relevant class of persons that the sign will actually be recognised as a description of one of the characteristics of the goods and services at issue (10/03/2011, C-51/10 P, 1000, EU:C:2011:139, § 50).

32 Furthermore, although it is irrelevant whether such a characteristic is commercially essential or ancillary, a characteristic, within the meaning of Article 7(1)(c) EUTMR, must nevertheless be objective and inherent to the nature of that product or service and intrinsic and permanent with regard to it (21/12/2022, T-554/21, Cash4life, EU:T:2022:841, § 41).

33 As regards marks composed of several words, it must be borne in mind that, in order to assess the descriptive character of a compound mark, not only must the various elements of which it is composed be examined but also the mark as a whole, so that such an assessment must be based on the overall perception of that trade mark by the relevant public (14/07/2017, T-194/16, Classic Fine Foods (fig.), EU:T:2017:498, § 23).

34 In order to refuse registration of a trade mark on the basis of Article 7(1)(c) EUTMR, it is not necessary that the signs and indications composing the mark that are referred to in that article actually be in use at the time of the application for registration in a way that is descriptive of goods or services such as those in relation to which the application is filed, or of characteristics of those goods or services. It is sufficient, as the wording of that provision itself indicates, that such signs and indications may be used for such purposes. A sign must therefore be refused registration under that provision if at least one of its possible meanings

designates a characteristic of the goods or services concerned (23/10/2003, C-191/01 P, DOUBLEMINT, EU:C:2003:579, § 32).

35 Article 7(1)(c) EUTMR pursues an aim in the public interest, namely that descriptive signs or indications relating to the characteristics of the goods or services in respect of which registration is sought may be freely used by all. That provision, therefore, prevents such signs or indications from being reserved to one undertaking alone because they have been registered as trade marks (04/05/1999, C-108/97 & C-109/97, Chiemsee, EU:C:1999:230, § 25).

36 That public interest requires that all signs or indications which may serve to designate characteristics of the goods or services in respect of which registration is sought remain freely available to all undertakings in order that they may use them when describing the same characteristics of their own goods. However, the application of that provision does not depend on the existence of a real, current or serious need to leave a sign free (07/10/2015, T-292/14, ΧΑΛΛΟΥΜΙ, EU:T:2015:752, § 55 and the case-law cited).

37 Marks consisting exclusively of such signs or indications are not eligible for registration unless Article 7(3) EUTMR applies (12/02/2004, C-265/00, Biomild, EU:C:2004:87, § 35-36).

38 For a sign to be caught by the prohibition set out in Article 7(1)(c) EUTMR, there must be a sufficiently direct and specific relationship between the sign and the goods or services at issue to enable the public concerned immediately to perceive, without further thought, a description of the goods or services or one of their characteristics (27/06/2017, ANTICO CASALE, T-327/16, EU:T:2017:439, § 18 and the case-law cited).

39 Accordingly, the descriptiveness of a mark must be assessed, first, by reference to the goods or services in respect of which registration is sought and, second, by reference to the perception of the relevant public (12/01/2005, T-367/02 – T-369/02, SnTEM, SnPUR & SnMIX, EU:T:2005:3, § 17 and the case-law cited; 09/03/2017, T-400/16, MAXPLAY, EU:T:2017:152, § 20).

40 In the light of those considerations, it is necessary to examine whether the examiner was right to find that the sign 'GEORGE ORWELL' is descriptive with regard to the goods and services concerned.

A) The relevant public and the level of attention

41 The goods and services that were challenged are in Classes 9, 16 and 41. They cover audio, video, magnetic and digital carriers, printed matter, education and entertainment-related services.

42 The case-law establishes that these goods and services are aimed both at the general public who might be looking for media products with pre-recorded content as well professionals in the education or entertainment sectors (for goods in Class 9: 03/12/2015, T-105/14, IDRIVE, EU:T:2015:924, § 36; for goods in Class 16: 09/03/2012, T-32/10, ELLA VALLEY VINEYARDS / ELLE, EU:T:2012:118, § 24; for services in Class 41: 18/01/2023, T-443/21, YOGA

ALLIANCE INDIA INTERNATIONAL (fig.) / yoga ALLIANCE (fig.), EU:T:2023:7, § 41, 45, 47).

43 Therefore, the relevant public's degree of attention will be that of the average consumer who is reasonably well informed and reasonably observant and circumspect. According to the case-law, the question of whether the consumer belonging to the relevant public displays a low, average or high level of attention is irrelevant to the application of Article 7(1)(c) EUTMR (23/02/2022, T-806/19, Andorra (fig.), EU:T:2022:87, § 28).

44 Given that the word sign corresponds to the name of a British author, the relevant public is composed, in particular, of the Irish and Maltese public, since, for historical, linguistic and cultural reasons, that part of the European Union has the closest connections with the United Kingdom. In addition, Ireland shares a land border with the United Kingdom and has long-standing and significant trade links with that country.

45 Article 7(2) EUTMR states that paragraph 1 of that article is to apply notwithstanding that the grounds of non-registrability concern only part of the European Union. An obstacle pertaining to the English-speaking European Union public is sufficient to refuse an EUTM application (07/04/2025, T-206/24, Hoodless hoodies, § 23).

B) Meaning of the sign: A reference to the author George Orwell

46 As established by the examiner, George Orwell is the pseudonym of Eric Arthur Blair (born 25 June 1903 in British India, died in London on 21 January 1950). He was an English novelist, essayist, journalist and critic. As a writer, Orwell produced literary criticism and poetry, fiction and polemical journalism; and is best known for the allegorical novella *Animal Farm* (published in 1945) and the dystopian novel *1984* (published in 1949).

47 As shown in the excerpts from the Orwell Foundation website (https://www.orwellfoundation.com/) submitted by the applicant, other non-fiction works include *The Road to Wigan Pier* (published in 1937), documenting his experience of working-class life in the north of England, and *Homage to Catalonia* (published in 1938), an account of his experiences soldiering for the Republican fraction of the Spanish Civil War (1936-1939).

48 The fame and recognition of George Orwell by the relevant public is an undisputed fact and can also be considered a well-known fact. This is stated by the applicant itself and is supported by the evidence submitted by the applicant, in particular the article from *The Guardian* (a newspaper that is also widely read in Ireland), submitted on 2 December 2019, referring to him as 'the famous author George Orwell'.

49 Orwell's work remains influential in popular and in political culture, and the adjective 'Orwellian' – describing totalitarian and authoritarian social practices – is part of the English language. A number of words and phrases that Orwell coined in *1984* have entered the standard vocabulary, such as 'memory hole', 'Big Brother', 'Room 101', 'doublethink', 'thought police', and 'newspeak'.

50 George Orwell was known for his journalism, both in the British press and in books of reportage, such as *Homage to Catalonia* mentioned above. As a novelist, his masterpieces are the enormously successful titles *Animal Farm* and *1984*. The former is considered an allegory of the corruption of the socialist ideals of the Russian Revolution by Stalinism, and the latter is Orwell's prophetic vision of the results of totalitarianism.

51 He is also known for his insights about the political implications of the use of language, as for example the essay *Politics and the English Language,* as noted in the Fifth Board's communication.

52 The Grand Board therefore concludes that the mark applied for will be perceived by the relevant public as the name of the British author George Orwell.

C) Preliminary remark: descriptive character of the sign and copyright protection

53 The Grand Board notes that the works by George Orwell were in copyright at the time of the application. George Orwell died in January 1950, so under the provisions of Directive 2006/116/EC of the European Parliament and of the Council of 12 December 2006 on the term of protection of copyright and certain related rights, copyright expired in the European Union in January 2020.

54 Copyright resides in literary works (the works of George Orwell) rather than in an author's name, even if the name of the author is a necessary form of reference to a body of literary output.

55 Nevertheless, the author of a literary work enjoys moral rights.

56 Moral rights are a category of non-patrimonial personal rights, belonging to authors of literary, artistic or scientific works, performers and authors of industrial creations; they are not harmonised under EU legislation.

57 This special type of rights can be found at an international level, in Article 6 *bis* paragraph (1) of the Berne Convention, introduced by the Rome Act of 1928: 'Independently of the author's economic rights, and even after the transfer of the said rights, the author shall have the right to claim authorship of the work and to object to any distortion, mutilation or other modification of, or other derogatory action in relation to, the said work, which would be prejudicial to his honour or reputation.' Therefore, the Berne Convention introduces two moral rights: the right to authorship of the work (right of attribution) and the right of the author to oppose any change which would harm his honour or reputation (right of integrity).

58 Moral rights are found in two sources: international conventions and national regulations. The Grand Board notes that what is missing is the regulation of moral rights at EU level. EU law makes certain references to moral rights, but they are sporadic at most and do not represent proper regulations in this area.

59 The issue of the moral rights of George Orwell was not raised as such; the applicant claims that the fact that there is copyright at the time of application is not an

obstacle to the registrability of the name of the author as a mark. The Grand Board agrees with this statement.

60 However, it should be noted that the existence of copyright is not, in itself, a sufficient justification for granting trade mark rights in perpetuity to the author's name.

61 The same arguments were developed in the proceedings concerning the 'SIBELIUS' trade mark application and dismissed by the Board in its decision (15/05/2018, R 2382/2017-2, SIBELIUS). It was considered that the existence of copyright was not, in itself, a sufficient justification for granting trade mark rights in perpetuity to the composer's name.

62 As the examiner correctly pointed out, for examination under Article 7 EUTMR, the existence of copyright protection is a factor which should be considered in combination with other factors. A finding of descriptiveness will be more likely when multiple adaptations of an author's works have reached a wide audience, in particular when copyright in an author's works has expired. Nevertheless, the existence of copyright protection is not, in itself, a decisive factor when it comes to considering whether an author's name is capable of performing a trade mark function.

63 As correctly expressed by the Executive Director, copyright and trade marks concern 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; 30/06/2009, T-435/05, DR. NO / DR.NO, EU:T:2009:226, § 26). It is the relevant consumer's perception of the mark which is of paramount importance when considering whether it serves to distinguish commercial origin.

64 As pointed out by the Executive Director, copyright can be relevant, not directly but indirectly. If a product is copyright protected, it may create certain patterns of trade and hence generate a connection between the mark and a commercial operator.

65 The Grand Board agrees with the Board in the Sibelius decision (15/05/2018, R 2382/2017-2, SIBELIUS), where the refusal of the sign 'SIBELIUS' was upheld in relation to, inter alia, musical recordings, printed matter and entertainment services. The Board reached this view notwithstanding the applicant's arguments that, as the representative of the heirs of Jean Sibelius (who died in 1957), they owned full rights to all the composer's work. The existence of copyright protection was therefore not regarded as a decisive factor by the Board in its determination of the actual perception (a descriptive one) which the public would have of the mark.

66 There is no evidence on file to show, through trade patterns or otherwise, that a connection between the mark applied for and a commercial operator exists. Equally, there is no evidence on file to suggest that the possible existence of moral rights or copyright have, in and of themselves, determined the relevant public's perception of the sign.

D) Descriptive character of names of authors with respect to subject matter

67 As noted in paragraph 28 above, by using the terms ‘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 services’ in Article 7(1)(c) EUTMR, the EU legislature made it clear, first, that those terms must all be regarded as corresponding to characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account (07/05/2019, T-423/18, vita, EU:T:2019:291, § 42).

68 The reference to ‘other characteristics’ in Article 7(1)(c) EUTMR can be understood to include, inter alia, the subject matter/content of the goods or services in question. However, no clear definition exists as to which goods and services can be considered as having ‘subject matter’, or how the descriptiveness of such subject matter can be assessed.

69 The Grand Board notes that ‘subject matter’ is not defined by the EUTMR or the TM Directive; however, it is an expression frequently employed, in the context of the analysis of absolute grounds of refusal based on Article 7(1)(c) EUTMR, in connection with trade marks consisting exclusively of terms describing the thematic or intellectual content of the goods or services for which protection is sought. As such, it is a subcategory of the absolute grounds of refusal based on descriptiveness. It refers to the description of a characteristic of the goods or services (their subject matter or content) which is not expressly mentioned in the non-exhaustive list of Article 7(1)(c) EUTMR but is considered to be included within the reference this provision makes to ‘other characteristics’.

70 An objection based on the description of the subject matter can in principle only be applied to those goods or services which contain information about other matters or refer to them, such as for instance books, magazines or training services.

71 This was confirmed by the Court of Justice in Memory (14/03/2011, C-369/10 P, Memory, EU:C:2011:148), where it held that the use of the word ‘characteristics’ in Article 7(1)(c) EUTMR referred, in general, to terms which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought (§ 53).

72 The Grand Board notes that one of the earliest judgments to deal with the subject matter of the goods or services as a characteristic within the meaning of Article 7(1)(c) EUTMR is Electronica (05/12/2000, T-32/00, Electronica, EU:T:2000:283). In that case, the General Court held that, since the sign referred to the basic subject area or context to which the goods and services applied for related (such as, catalogues for electronic trade fairs, organisation of electronic trade fairs and conferences, publishing and distributing of catalogues for electronic trade fairs) and because those goods and services were identifiable by their relationship to that subject, the mark was considered descriptive of an essential characteristic of the goods and services in question and could not serve to indicate their link with the undertaking which makes or provides them (§ 43-44).

73 The criteria used to arrive to this conclusion are well illustrated in Transcendental Meditation (06/02/2013, T-412/11, Transcendental Meditation, EU:T:2013:62; see also 06/02/2013, T-426/11, Méditation Transcendantale, EU:T:2013:63, concerning a parallel case). This judgment concerned an application for a word mark for, inter alia, *instructional and teaching material (except apparatus)* in Class 16 and *education; providing of training; entertainment* in Class 41. It was, therefore, concluded that there was a sufficiently direct and specific relationship between the meaning of the signs and the goods and services concerned to consider the respective marks descriptive in the sense of Article 7(1)(c) EUTMR (§ 91).

74 Another judgment regarding an objection based on the subject matter, where one can see that the same criteria are being applied to the analysis, is billiger-mietwagen.de (25/01/2018, T-866/16, billiger-mietwagen.de, EU:T:2018:32). This case concerned an application for a word mark for, inter alia, services in Classes 35, 38 and 39. It was held that there was a direct or immediate link between the mark and the services in question, since the relevant public, when faced with such a mark in respect of these services, would immediately understand that they relate to the hire of cars on preferential terms and that they were provided via an internet portal (§ 40-41). This in turn led to the conclusion that the trade mark application was descriptive of the subject matter of the provision of the services, namely services linked to the leasing of vehicles on advantageous terms, as well as to the method of providing these services, namely via a website (§ 42). Consequently, the trade mark application was found to infringe both Article 7(1)(c) and (b) EUTMR.

75 In order for the objection to apply, however, the reference to the subject matter of the goods and/or services has to be sufficiently clear and specific. In BI-Bot (22/03/2018, R 1753/2017-4, BI-Bot), for instance, which was an application for a word mark for goods in Class 9 (*software*) and services in Classes 38, 41 and 42, the Board annulled the examiner's decision which had found the trade mark descriptive of the subject matter of the services in question. It held that it had not been proven that 'BI' would be understood by the relevant public as an acronym for 'business intelligence' and that, even if that was the case, it remained a term which was vague, to say the least, and this vagueness was not reduced by the additional word 'Bot', so that the sign as a whole did not bear a sufficiently direct and concrete relation with the goods and services for which registration was sought.

76 In summary, and as formulated by the General Court in Brauwelt (18/10/2016, T-56/15, Brauwelt, EU:T:2016:618, § 58), a mark will fall under Article 7(1)(c) EUTMR if it is liable to convey an indication about the thematic subject matter of a good or service.

77 In view of the foregoing, the Grand Board shares the view of the Executive Director that marks consisting of names of famous persons may be perceived by the relevant public as describing the content (subject matter) of the goods and services of the applied for trade mark and are therefore descriptive. A sign can simultaneously be famous for denoting someone or something and depending on the nature of the product or service at issue, be descriptive of the content or character of the goods or services with reference to which it is used.

78 Following the case-law of the General Court establishing the criteria for objections based on descriptive subject matter, the Grand Board considers the standards suggested by the Executive Director to be a non-exhaustive list of parameters suitable for taking into account in such cases. The non-exhaustive and non-cumulative criteria that have been identified are the following:

- **Fame and recognition of the author**: an *ex officio* examination may show that the name of the author is famous and recognised in a particular territory, evidence can comprise books sold, prices, how the author is studied today or how their works are represented, discussed or adapted.

- **Widespread use of the work of the author**: this criterion looks at how widely the work has been distributed, possibly with different adaptations and formats; if it is part of school or university curricula; if it has been converted into a film or graphic work, etc.

- **Social and cultural integration**: this criterion looks at present signs of recognition of the author, for example if there are prizes, sculptures or other forms of recognition.

- **Period for which the author has been known**: if the author has been known for a long period of time, even if they are dead at the time of filing the EUTM, an analysis will be made to determine whether that name still enjoys fame, recognition, and social and cultural integration.

- **Nouns or adjectives that have been created from the name of the author**: this can be an indication of the impact of an author's work, demonstrating the incorporation of their work into common language; for example, nouns like Kafkaesque, Dantesque or Dickensian have entered the language as references to an author's literary work.

- **Market reality**: the last factor to examine is whether the relevant public's perception of the goods and services as an indication of a particular subject matter, corresponds to market reality. Market reality is the assessment of whether a section of a library or bookshop is associated to the author or their work.

Fame and recognition of the author

79 The Grand Board notes that with respect to George Orwell, whose books, in particular *1984* and *Animal Farm*, are known and read by people all over the world, the contested sign 'GEORGE ORWELL' will be understood as a reference to the author.

80 The applicant itself stated in its submissions that George Orwell is famous. Moreover, the evidence submitted by the applicant, in particular the article from *The Guardian*, submitted on 2 December 2019, referred to him as 'the famous author George Orwell'. Also, in 2003, *The Economist* magazine (which is widely read throughout the EU) published an article referring to George Orwell as 'the master' (reference is made to the Fifth Board's communication of 6 April 2020).

81 In relation with INTA's argument on Dr No, the Grand Board notes that Dr No is a fictional character. He's not as famous as George Orwell and no adjectives have entered ordinary language as a result of Dr No.

82 The work of George Orwell dates from the 1930s, 1940s, during World War II and its immediate aftermath. In the more than 70 years since, throughout the relevant territory, the literary work of George Orwell has been taught, his books studied, theatrical productions based on his work performed, and numerous adaptations produced. The extensive list of books and articles on Orwell's life, legacy, values, and literary criticism demonstrates his universal reputation and exceptional influence as a cultural figure and as an author.

83 George Orwell died in January 1950, approximately 75 years ago. The *Encyclopaedia Britannica* states: 'George Orwell became famous and prosperous after the publication of *Animal Farm* in 1945, a political fable based on the Russian Revolution. This book made him well-known, but his novel, *1984*, released in 1949, has since overshadowed it.' (https://www.britannica.com consulted on 5 December 2025).

Widespread use of the work of the author

84 As regards the criterion of widespread use of the author's work, the applicant itself notes that Orwell's works have been adapted and performed in theatres. He is the author of two novels which are universally regarded as classics (*1984* and *Animal Farm*), as well as several other novels, literary criticism, social and political commentary, an account of colonialism (*Burmese Days*) and a classic account of the Spanish Civil War (*Homage to Catalonia*). George Orwell is among the most popular writers of the twentieth century in the English language (in particular, an article submitted by the applicant, dated 25 October 2018 and published on *The Bookseller*, states that George Orwell is best known for the two novels that define the 20th century, *Animal Farm* and *1984*). This is further confirmed by the information in the applicant's website; https://www.orwellfoundation.com/the-orwell-foundation/about/about-george-orwell/, last accessed on 5 December 2025).

85 George Orwell is one of the English-speaking world's most influential writers. By the time of his death in 1950, he was a world-renowned author (see https://www.orwellfoundation.com/the-orwell-foundation/about/about-george-orwell/ consulted on 5 December 2025).

86 Unlike Anne Frank (who is known as the writer of one book), George Orwell is recognised, with his wide-ranging and richly varied canon, as one of the key literary figures of the first part of the twentieth century. His reputation is such that, beyond his own works, a large body of literature about the writer and his work also exists, as demonstrated to the applicant in the Fifth Board's communication.

87 As confirmed by the applicant itself in its submissions, the Orwell Foundation is a charity registered in England and Wales. The applicant's website explains that the Foundation's objective is to perpetuate the achievements of the British writer George Orwell (1903-1950) (see Enclosure B of the statement of grounds).

88 The Foundation runs the Orwell Prize, which according to the applicant and its evidence, is among the most prestigious prizes in the UK and beyond for political writing. By way of example, the evidence submitted shows that the *Irish Times* columnist Fintan O'Toole won the Orwell Prize for Journalism in 2017. This refers clearly to the relevant public. The Orwell Youth Prize works with young people aged 12-18. The Orwell Youth Prize organises writing workshops for young people and runs a writing prize, culminating in an annual Celebration Day.

89 The evidence provided by the applicant shows that, in addition to the Prize, the Orwell Foundation also runs free public events, debates and lectures and provides free online resources and/or about Orwell and his literary work.

Social and cultural integration

90 As regards social and cultural integration, the Grand Board notes that George Orwell's literary works are still taught today in EU academic institutions, including Irish schools.

91 Orwell's legacy is reflected in public commemorations across Europe, including the following examples from Ireland and Spain. A street in Dublin, Ireland, is named 'Orwell Road'. Barcelona has a square named after George Orwell. Plaça de George Orwell, also known as Plaça Tripi, is a square in the Gothic Quarter named in his honour. This square was officially named in 1996. Additionally, there is a 'George Orwell Route' in the Alcubierre mountains of Aragon, commemorating his experiences during the Spanish Civil War.

92 As noted above, there are various prizes in the author's honour, including the Orwell Prize for Political Writing, which aims to encourage good writing and thinking about politics and is regarded as prestigious in the UK and beyond, the Orwell Prize for Political Fiction, the Orwell Prize for Journalism, and the Orwell Prize for Exposing Britain's Social Evils, as reported in a 2018 *Financial Times* article.

93 As shown in the applicant's evidence, the Orwell Foundation organises free public lectures and debates.

Period for which the author has been known

94 The criterion concerning the period for which the author has been known serves to verify whether the other elements mentioned above (i.e. fame, widespread use of the work of the author, social and media recognition), continue to persist notwithstanding the long period since the author's death. This well-known fact is in particular supported by numerous examples included in the annexes of the Fifth Board's communication of 6 April 2020.

95 In 2003, a celebration of the 100 years anniversary since the birth of the British author gave rise to a number of publications confirming his fame, among which the following can be noted:

- 'A witness to revolution and counterrevolution: The legacy of George Orwell - LEE WENGRAF looks at the life and writing of George Orwell on

the 100th anniversary of his birth' published on 4 July 2003 (http://socialistworker.org/2003-2/459/459_08_Orwell.php):

'BIG BROTHER, double-think, thought police: almost everyone is familiar with the bleak portrait of a futuristic, totalitarian society portrayed in George Orwell's *1984.* Orwell's writing has come to epitomise lessons taught in schools everywhere: resistance is impossible, and the tyranny of Orwell's Big Brother -the Soviet Union under Stalin- is the unavoidable result of fighting for a socialist society'.

- *The Economist*, 'George Orwell: The master's voice' (published on 12 June 2003).

- *The Economist*, 'Orwell centenary: Blair-mania' (published on 26 June 2003).

- Hitchens, Christopher, 'Why Orwell Matters' (published in 2003).

- Hitchens, Christopher and Conan, Neal, 'George Orwell Turns 100' (published in 2003).

96 George Orwell's name has been featured in the titles of many newspaper and magazine articles, as well as books. Some examples, which were presented to the applicant in the Fifth Board's communication, are the following:

- 'Why George Orwell is as relevant today as ever' (article published in *The Guardian* on 24 August 2012 https://www.theguardian.com/commentisfree/2012/aug/24/george-orwell-relevant-today-ever):

  'Geoffrey Wheatcroft: Why Orwell Matters is the title of a book published some years ago by my much-lamented if misguided friend Christopher Hitchens. Whether Orwell matters, he clearly still fascinates, stimulates and enrages. How is it that a writer who died in 1950, at only 46, should be one of the most controversial figures of our own time?'.

- Gourevitch, Phillip and Self, Will, Phillip Gourevitch and Will Self on George Orwell (2007).

- McCrum, Robert, 'Why it's hard to conjure the spirit of Orwell' (*The Observer*) (2009).

- McCrum, Robert, 'George Orwell and the eternal truths of good journalism' (*The Observer*) (2003).

- Seaton, Jean, 'George Orwell at the BBC' (2017).

- Spender, Stephen, 'The Truth about Orwell', *NYRB* (1972).

- The School of Life, 'George Orwell' (2016).

- Paxman, Jeremy, ‘Introduction to Shooting an Elephant: The genius of George Orwell’ published in *The Daily Telegraph* (2015).

- Aaronovitch, David, ‘1984: George Orwell’s road to dystopia’, *BBC News Magazine*.

- Harris, Robert, Robert Harris Discusses George Orwell’s 1984 – Faulks on Fiction, BBC (2011).

- McCrum, Robert, 1984: The masterpiece that killed George Orwell, *The Observer* (2009).

- Taylor, David, The Best George Orwell Books, interview with Five Books (2019).

- Cowley, Jason, George Orwell’s luminous truths, *Financial Times* (2014).

- Hastings, Rob, There’s more to George Orwell than politics, *The Guardian* (2010).

- Davison, Peter, Orwell – Religion and Ethical Values (2008).

- Goodman, Giora, George Orwell and the question of Palestine (2010).

- Gray, Robert, Orwell vs God, *The Spectator* (2011).

- Naftali, Timothy, George Orwell’s List, *New York Times* (1998).

- Packman, Carl, Orwell the Rorschach Test (Though Cowards Flinch) (2011).

- Richards, Paul, From Tory Anarchist to Democratic Socialist (LabourList) (2009).

- Jeffries, Stuart, What would George Orwell have made of the world in 2013? *The Guardian* (2013).

- Mackenzie, Sophie, George Orwell’s hot and cold British menu, *The Guardian* (2011).

Nouns and/or adjectives that have been created from the name of the author

97 It must be recalled that although it is in principle for the Office to establish in its decisions the accuracy of the facts on which a decision is based, that is not the case where the alleged facts are well-known (21/02/2013, T-427/11, BIODERMA, EU:T:2013:92).

98 In particular, information included in dictionaries has been considered as being in the nature of well-known facts because the source is accessible by the general public. In relation to nouns and/or adjectives derived from literary work, the Grand Board notes that it is a well-known fact that the Oxford English Dictionary, the most authoritative dictionary in English-speaking countries such as Ireland and

Malta, defines the term 'Orwellian' (https://www.oed.com/dictionary/orwellian_adj?tl=true consulted on 16 December 2025) as:

- **Adjective:** Characteristic or suggestive of the writings of George Orwell, esp. of the totalitarian state depicted in his dystopian account of the future, *1984* (1949).

1950	A leap into the Orwellian future. M. McCarthy, *On Contrary* (1961) ii. 187
1959	Virtually perfect Orwellian ambivalences—(War is Peace, Love is Hate, Ignorance is Knowledge). N. Mailer, *Advertisements for Myself* (1961) 309
1974	One sees a future Robin Day as an Orwellian Official Moderator of the Ministry of Received Truth. *Daily Telegraph* 20 September (Colour Supplement) 27/4
1993	The debate about reforms by..the BBC's Director General, was reopened yesterday with a devastating criticism accusing him of creating an Orwellian regime of fear and sycophancy. *Guardian* 14 July 1/1

- **Noun:** An admirer of the works and ideas of Orwell.

1971	McLuhanites and Orwellians are likely to block our view of their masters' arguments. *Guardian* 14 January 7/1
1991	The book..did not satisfy the needs of the ever-growing band of Orwellians who required the story of their hero's life told as a coherent narrative. *Financial Times* 12 October (Weekend section) p. xvi

99 For the sake of completeness, the applicant has also submitted an article published in *The Guardian* that includes the adjective 'Orwellian' in its title.

Market reality

100 The criterion of market reality concerns whether, in practice, sections of libraries or bookshops are associated with a given author or their works. The Grand Board considers that George Orwell's work will occupy a prominent place in all the bookstore sections devoted to political fiction.

Conclusion regarding the criteria for objections based on descriptive subject matter

101 In light of the foregoing criteria, the Grand Board concludes that, for the relevant public, the sign 'GEORGE ORWELL' will be immediately and unequivocally understood as referring to that well-known British writer. The contested sign is therefore inherently apt to indicate, without further mental effort, that the goods and services in question concern the author George Orwell, his writings or the ideas and themes deriving from them as their subject matter as will be analysed below.

E) Connection between the contested sign and the goods and services

102 The examination of absolute grounds for refusal must be carried out in relation to each of the goods or services for which trade mark registration is sought and the decision by which the competent authority refuses registration of a mark must, in principle, state reasons in respect of each of those goods or services (18/03/2010, C-282/09 P, P@yweb card / Payweb card, EU:C:2010:153, § 37; 17/05/2017, C-437/15 P, deluxe, EU:C:2017:380, § 29; 22/11/2011, T-275/10, Mpay24, EU:T:2011:683, § 52; 23/09/2015, T-633/13, Infosecurity, EU:T:2015:674, § 45).

103 However, in respect of that latter requirement, the General Court has held that the competent authority may confine itself to general reasoning for all of the goods or services concerned in the case where the same ground of refusal is given for a category or group of goods or services (22/11/2011, T-275/10, Mpay24, EU:T:2011:683, § 53 and the case-law cited; 23/09/2015, T-633/13, Infosecurity, EU:T:2015:674, § 46 and the case-law cited).

104 According to the cited case-law, an option of this nature can extend only to goods or services which have a sufficiently direct and specific link to each other to the extent that they form such a sufficiently homogenous category or group of goods or services that it allows general reasoning to be applied (17/05/2017, C-437/15 P, deluxe, EU:C:2017:380, § 30-31; 03/03/2015, T-492/13 & T-493/13, Darstellung eines Spielbretts, EU:T:2015:128, § 40). Moreover, for that purpose the mere fact that the goods or services in question are in the same class under the Nice Agreement is not sufficient since those classes often contain a wide variety of goods or services which do not necessarily have a sufficiently direct and specific link to each other (03/09/2014, T-686/13, Deux lignes et quatre étoiles, EU:T:2014:737, § 15 and the case-law cited).

105 Therefore, the Grand Board will assess the objection of the absolute ground in relation to all the objected goods and services concerned, and will thereby consider whether the same reasoning can be applied to all the goods and services, pursuant to the requirements of Article 94(1) EUTMR and case-law which requires decisions of the Office to state a complete and precise statement of the reasons of the decision (21/10/2004, C-447/02 P, Orange, EU:C:2004:649, § 63-65).

a) Goods in Class 9

106 In a number of decisions, the Boards of Appeal and the General Court have examined the descriptive character of a mark applied for as referring to the subject matter of the goods in Class 9. In KAATSU (07/11/2014, T-567/12, KAATSU, EU:T:2014:937), the General Court established for *pre-recorded videotapes, compact disks (CDs), laser disks (LDs), digital versatile disks (DVDs) and computer software*, that the mark would be understood as containing direct information as to the nature and subject matter of the goods and services referred to (§ 38), namely, the Kaatsu system of restricted blood flow weight-training.

107 In Brauwelt (18/10/2016, T-56/15, Brauwelt, EU:T:2016:618, § 58), the mark was applied for *computer programs and software and data carriers (recorded or not)*. The General Court established that the mark means ‘the world of brewing’, and, as such, it was considered directly descriptive of the subject matter of ‘computer

programs' and 'data carriers' in Class 9. In particular, and contrary to the applicant's assertions in that case, when the mark sought is affixed to 'data carriers', by its nature it informs the relevant public immediately of an essential characteristic of those goods, namely their thematic subject matter (§ 61-62).

108 In ST ANDREWS (24/04/2020, R 2485/2019-1, ST ANDREWS), the mark applied for concerned *media content*. The Board established that the town of St Andrews is famous for well-known golf tournaments and golf has been associated with it for hundreds of years (§ 33). The mark applied for conveyed a clear and unambiguous message about 'media content' in Class 9 to the extent that it was reasonable to assume that 'ST ANDREWS' was the subject matter of those goods, as they provided information about the town and the world-famous golf facilities. By way of example, the mark was found to indicate that the media content related to a town in eastern Scotland that is known worldwide for its historic golf courses (§ 42).

109 In NATURE (12/06/2020, R 2755/2019-1, NATURE), the mark was applied for *content carriers, including e.g. electronic (downloadable) publications and software*. The Board established that the 'content carriers' to which the objection applied could all be considered repositories of information of some sort or another. In this sense, none of them excluded the possibility of storing, presenting or otherwise containing material that could relate to 'nature'. In other words, the mark 'NATURE' was found to describe the information about these items and not their commercial provider (§ 33). 'Computer software' on content carriers did not exclude the possibility of containing objectionable content, or of being used in a manner that fell under the objection in Article 7(1)(c) EUTMR. For example, computer applications that help to identify flora and fauna such as plants, birds, butterflies – even the constellations in the night sky – could all rightly have been referred to as 'nature apps' (§ 34).

110 For those reasons, if the sign 'George Orwell' is used for the goods in Class 9, *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, information; webcasts; podcasts; vodcasts; electronically recorded data; downloadable digital media and recordings containing teaching apparatus and instruments; downloadable screensavers, video, information; cinematographic films; 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; prerecorded audio and video compact discs, DVDs, motion picture films, television programmes and other digital recording media; parts and fittings for all of the above goods*, it will be perceived to indicate the content, the subject matter of those goods. In other words, the content of these goods is about George Orwell. The goods provide information about the famous British author George Orwell.

111 As the indications '*DVDs*' and '*data carriers*' are general terms which may also encompass recorded data carriers, they must be refused independently of the fact

that the specification could also include empty DVDs and data carriers. In addition, the Grand Board notes that there has been no restriction or delimitation of those goods in that sense.

b) Goods in Class 16

112 In relation to Class 16 goods, such as *printed matter, instructional and teaching material*, the General Court and the Boards of Appeal have applied the concept of subject matter to declare marks descriptive.

113 In Electronica (05/12/2000, T-32/00, Electronica, EU:T:2000:283), the goods in question were *catalogues for electronic component and assembly trade fairs*. The General Court established that the goods and services applied for all related to electronic components or assemblies. Electronics is the basic subject area or context to which those goods and services were related. They were identifiable by their relationship to that subject (§ 43).

114 In Brauwelt (18/10/2016, T-56/15, Brauwelt, EU:T:2016:618), the goods were *brochures, magazines catalogues and books*. The General Court established that 'the subject matter of the goods in Class 16 may be brewing activity. Frequently the title of a book, catalogue or brochure and the name of magazines refer to the thematic content of those publications, and both consumers and professionals will choose to consult publications mainly on the basis of their content or subject-matter' (§ 62).

115 In Beaches Jamaica Bloody Bay (30/06/2020, R 1688/2019-2, Beaches Jamaica Bloody Bay), the goods were *printed matter, souvenir catalogues, travel and vacation magazines, photographs and posters*. The Board established that 'in relation to the claimed goods in Class 16, which may be intended to convey a particular conceptual content, the sign applied for may serve as an indication of the subject matter and thus indicate the substantive nature of such goods within the meaning of Article 7(1)(c) EUTMR. In view of its history and the ongoing significance as a tourist destination, Bloody Bay/Negril is a suitable subject or motif for travel information or guides and visual recordings, and a sufficient part of the target public will understand that connection. The sign applied for could therefore easily identify the subject matter of the relevant goods' (§ 28).

116 For those reasons, if the sign 'GEORGE ORWELL' is used in connection with the contested goods in Class 16, namely *printed matter; photographs; books; publications; magazines; newsletters; newspapers; albums; periodicals; journals; catalogues; pamphlets; leaflets; posters; instructional and teaching materials for education and information; book covers; drawings; paintings; prints; pictures* it will also indicate the subject matter of those goods. In other words that the goods are about the work, life or person of George Orwell or that they contain his works (by analogy, 30/06/2009, T-435/05, DR. NO / DR.NO, EU:T:2009:226, § 27).

c) Services in Class 41

117 As regards services in Class 41, such as *education, training or entertainment*, the General Court and the Boards have held that marks may be refused as descriptive of the subject matter of these services.

118 In Infosecurity (23/09/2015, T-633/13, Infosecurity, EU:T:2015:674), the services in question were *organisation, arranging and conducting of exhibitions, conferences, conventions, seminars, workshops, expositions and events, publishing of magazines and news magazines by electronic means, publication, in electronic or non-electronic format, of texts, books, reviews and magazines*. The General Court held that 'the Board of Appeal did not make an error of assessment in deciding that the sign INFOSECURITY described the subject matter of all the goods and services concerned, namely the provision of information orally and in writing in relation to information security. As the Board of Appeal correctly held in […] the contested decision, the expression "infosecurity" will immediately inform the relevant public that the goods and services concerned "are aimed at the area of protecting information from safety threats'" and, therefore, directly describes their subject matter. That conclusion cannot be called into question by the applicant's argument that some of the goods and services concerned, namely 'printed information relating to trade shows, exhibitions, expositions, fairs, conferences, seminars and business and educational events' (Class 16), 'information relating to business introductory services' (Class 35) or 'publishing of online electronic publications' (Class 41), do not have any direct links with the mark applied for. It is clear that, in connection with those goods and services, the mark applied for immediately indicates to the relevant public the content or subject matter of that information and those publications, namely information security (§ 51, 52 and 53).

119 In Trading.com (26/08/2019, R 853/2019-2, Trading.com), the services were *educational and training services* and *news and information services*. The Board established that 'both educational and training services and news and information services can have as their subject the topic trading'. Therefore, the first element 'TRADING' was found to be descriptive of these services. It describes their subject matter. The second element '.COM' describes the form in which the services are offered, namely over the internet (§ 27-28).

120 For those reasons, if the sign 'GEORGE ORWELL' is seen in relation with the contested services in Class 41, *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, it will indicate the subject matter, that is to say the content of these services, or in other words that they deal with, refer or are about the work, life or person of George Orwell. This conclusion is supported by the numerous lectures, prizes and other events referred to above which are specifically devoted to his life, works and literary style and thus use his name descriptively in order to designate their content. Even if those examples largely originate in the United Kingdom, there is no reason to assume that similar events could not be organised or offered in Ireland or Malta.

d) Conclusion in relation to the contested goods and services

121 The relevant public will perceive the above goods and services and directly and immediately establish a relation with their topic or content or subject matter, in the sense of understanding that they deal with or include some aspect of the person or biography of 'George Orwell' or of his work.

122 In summary, the Grand Board notes with approval the decision of the Board in Sibelius (15/05/2018, R 2382/2017-2, SIBELIUS), where the refusal of the sign 'SIBELIUS' was upheld in relation to, inter alia, musical recordings, printed matter and entertainment services. The Board took the view that the public's perception of the sign 'SIBELIUS', when used in relation to these goods and services, would be that it merely indicates a descriptive link with their subject matter, namely the music, life or person of Jean Sibelius. The Grand Board does not concur with the applicant that the Sibelius case is not analogous to the present case merely because the artist at issue in that appeal was a composer, whereas the present proceedings concern a famous author. Moreover, the SIBELIUS mark was refused registration not only for music-related services but also for the broader category of *entertainment* services.

123 Therefore, the Grand Board concludes, as did the contested decision, that the sign applied for is descriptive for all the goods and services mentioned in paragraph 4 above.

IV. Article 7(1)(b) EUTMR

124 It is sufficient for one of the absolute grounds of refusal to apply for the sign not to be registered as a European Union trade mark.

125 Moreover, a mark which is descriptive of characteristics of the goods and services for the purposes of Article 7(1)(c) EUTMR is necessarily devoid of any distinctive character in relation to those goods and services within the meaning of Article 7(1)(b) EUTMR (12/02/2004, C-363/99, Postkantoor, EU:C:2004:86, § 86; 14/06/2007, T-207/06, Europig, EU:T:2007:179, § 47 and the case-law cited; 17/12/2015, T-79/15, 3D, EU:T:2015:999, § 35).

126 Nevertheless, the Grand Board considers that the sign applied for also lacks distinctiveness with respect to the goods and services listed in paragraph 4 above for the purpose of Article 7(1)(b) EUTMR independently of its descriptiveness.

127 Distinctive character within the meaning of Article 7(1)(b) EUTMR means that the mark applied for must serve to identify the goods or services in respect of which registration is applied for as originating from a particular undertaking. It thus serves the purpose of distinguishing the trade marked goods or services from those of other undertakings (21/10/2004, C-64/02 P, Das Prinzip der Bequemlichkeit, EU:C:2004:645, § 33).

128 The distinctiveness of a trade mark must be assessed both by reference to the goods or services in the application and to the perception of them by the relevant public (12/02/2004, C-363/99, Postkantoor, EU:C:2004:86, § 34-35).

129 The general interest underlying Article 7(1)(b) EUTMR is, manifestly, indissociable from the essential function of a trade mark, which is to guarantee the identity of origin of the marked product or service to the relevant public by enabling the relevant public, without the possibility of confusion, to distinguish the product or service from other goods or services which have a different origin (15/09/2005, C-37/03 P, BioID, EU:C:2005:547, § 60; 08/05/2008, C-304/06 P, Eurohypo, EU:C:2008:261, § 56).

130 INTA is correct, as is the Executive Director, in claiming that names of authors can be distinctive for books pursuant to Article 7(1)(b) EUTMR provided that they are capable of identifying the commercial origin of those goods. As mentioned above in the assessment of the descriptive character of the mark, EUTM applications, consisting of names of authors, therefore, are not subject to any ‘special treatment’ during their examination and will be rejected only if they fall within a ground for refusal under Article 7 EUTMR.

131 Under Article 7(1)(b) EUTMR, therefore, the distinctiveness of a mark consisting of the name of a famous author is examined according to the relevant consumer’s perception of the mark on its own merits in relation to the goods or services it covers and its ability to indicate commercial origin.

132 Again, like for the assessment of the descriptive character, the existence (or expiration) of copyright protection in the works of a famous author does not determine the distinctiveness of a mark consisting of an author’s name for books. The status of the copyright protection or moral rights of such works per se is irrelevant in the assessment under Article 7(1)(b) EUTMR, whether that status is a well-known fact or not.

133 A mark, which, as in the case at issue, would simply be seen as descriptive, cannot guarantee the identity of the origin of the marked goods and services to the consumer by enabling the consumer, without any possibility of confusion, to distinguish the said product or service from other goods or services which have a different origin. As such, it is incapable of performing the essential function of a trade mark, namely that of identifying the origin of the goods and services, thus enabling the consumer who acquired them to repeat the experience, if it proves to be positive, or to avoid it, if it proves to be negative, on the occasion of a subsequent acquisition (03/07/2003, T-122/01, Best Buy, EU:T:2003:183, § 20).

134 In the present case, the mark is non-distinctive not only because of being descriptive, but also because it consists of the name of the famous British author

George Orwell. It therefore merely indicates to the relevant public that the goods and services concerned comprise, concern, or are otherwise linked to the work, life, or personality of George Orwell.

135 The relevant public confronted with the goods in Classes 9 and 16 and the services in Class 41 will perceive the mark as merely referring to the author and not as an indicator of origin.

136 The examiner was right to state that 'it is a well-known fact that George Orwell is a very famous author […]' and to find the mark non-distinctive based on the following: 'Given this context the name "George Orwell" will not convey a distinctive trade mark significance for the relevant consumer of the rejected goods and services but will rather be seen as an indication of subject matter: being by or about George Orwell', the latter making reference to the 'content' in terms of authorship or that the goods and services refer to George Orwell.

137 The sign 'George Orwell' will therefore be perceived as the name of a famous author of the twentieth century. The sign does not contain any distinguishing features.

138 The Grand Board concludes that the examiner correctly refused the mark applied for, for the goods and services listed in paragraph 4 also under Article 7(1)(b) EUTMR.

V. On the applicant's other arguments

A) Similar registrations

139 The applicant makes reference to signs that are allegedly comparable with the present sign and that have been registered as European Union trade marks in respect of goods and services in Classes 9, 16 and 41.

140 Accordingly, while the Boards strive for decision-making consistency, the legality of the decisions of the Boards must be assessed on the basis of the EUTMR, as interpreted by the European Union judicature, and not on the basis of a previous decision-making practice of the Office or the Boards (15/09/2005, C-37/03 P, BioID, EU:C:2005:547, § 47; 05/12/2000, T-32/00, Electronica, EU:T:2000:283, § 47; 05/12/2002, T-130/01, Real People, Real Solutions, EU:T:2002:301, § 31; 03/07/2003, T-129/01, Budmen, EU:T:2003:184, § 61; 11/05/2005, T-390/03, CM, EU:T:2005:170).

141 Furthermore, the principle of equal treatment only applies at the level of the same decision-making body, and the Board is therefore not bound by the decisions of the examiners who decided to register the signs referred to by the applicant (22/05/2014, T-228/13, EXACT, EU:T:2014:272, § 48). The Grand Board cannot be bound by decisions of first-instance departments of the Office (for example the Examination or Cancellation Divisions) which have not been appealed (see, with respect to Opposition Division decisions, 27/03/2014, T-554/12, Aava Mobile, EU:T:2014:158, § 65, second sentence).

142 The examination decisions concerning these earlier EUTM registrations have not been appealed or assessed by the Boards of Appeal. The Boards of Appeal have had no opportunity to state their opinion on the registrability of the signs referred to. Moreover, although the registrations mentioned by the applicant are currently entered in the European Union trade mark register this does not automatically mean that those trade marks have in fact also been used as trade marks, that is to say as an indication of the commercial origin of the goods and services identified thereby, or are capable of being used in such a way in the first place.

143 Finally, as stated in the Fifth Board's Referral of 2 July 2020, this case was referred to the Grand Board precisely because the Office has issued diverging decisions with respect to the registrability of names of well-known persons for goods and services such as *videos; CD's; movies* (Class 9), *printed matter; photographs; books; paintings* (Class 16), or *entertainment; cultural activities; educational services* (Class 41). Consequently, the fact that the EUTMs on which the applicant relies have been registered cannot justify the registration of the sign in the current proceedings.

B) Article 14 EUTMR

144 The applicant has claimed 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-trade mark use of the same, would not amount to trade mark infringement.

145 As the examiner correctly pointed out, the fact that a defence to infringement is available for descriptive use of a sign in accordance with honest practices in industrial or commercial matters has no decisive bearing or intrinsic role to play in relation to the exclusion from registration; there is accordingly no interplay to be considered between the scope of the exclusion from registration and the scope of the exclusion from liability for infringement of the rights conferred by a valid registration (10/03/2011, C-51/10 P, 1000, EU:C:2011:139, § 38, 39; 16/07/2025, T-105/23, Iceland, EU:T:2025:729, § 80-81).

VI. Final obiter dictum remarks

146 INTA observations explored other possible grounds of refusal and the Grand Board raised these further grounds in the questions to the Executive Director.

A) Article 7(1)(f) EUTMR

147 Article 7(1)(f) EUTMR stipulates that trade marks must be refused if they are contrary to public policy or accepted principles of morality. However, it is accepted that not every norm of national law qualifies as being one of public policy or accepted principles of morality.

148 In its judgment of 6 April 2017 in case E-5/16, Municipality of Oslo, considering a series of 3D marks filed by the municipality and reproducing the sculptures of Gustav Vigeland, the EFTA Court, when interpreting Article 3(1)(f) of the

Trade mark Directive (Directive 2008/95/EC, 'TMD') in force at that time, which is identical to Article 7(1)(f) EUTMR, held that 'certain pieces of art may enjoy a particular status as prominent parts of a nation's cultural heritage, an emblem of sovereignty or of the nation's foundations and values' and that a 'trade mark registration may even be considered a misappropriation or a desecration of the artist's work' (§ 92). The EFTA Court concluded that the notion of 'public policy' referred to principles and standards regarded to be of a fundamental concern to the State and the whole of society (§ 94) and registration of a sign may only be refused on the basis of the public policy exception provided for in Article 3(1)(f) TMD, if the sign consists exclusively of a work pertaining to the public domain and registration of this sign would constitute a genuine and sufficiently serious threat to a fundamental interest of society (§ 95).

149 The Grand Board already held that George Orwell is the name of a very famous person who left an important legacy in world literature by his work. It is a well-known fact to Irish consumers that his work is still part of the prescribed texts in the English curriculum for junior cycle students in Ireland. More generally, Orwell's work can be described as an integral and long-established part of Western Europe's cultural heritage.

150 There is no officially agreed interpretation of the expression 'cultural heritage' but it can be inferred from various definitions and usage to be a broad term that covers tangible and intangible aspects of a society or community such as values, traditions or art (literature, music, painting, etc.).

151 As mentioned by the Executive Director, being part of the UNESCO World Heritage List (see UNESCO, Convention Concerning the Protection of the World Cultural and Natural Heritage, Article 1 (16 November 1972); UNESCO Glossary from the Institute for Statistics, 2009; EU Policy for cultural heritage, European Commission, Directorate-General of Education, Youth, Sport and Culture) or of any other official register of a similar kind can be an objective indication that something is part of 'cultural heritage'. However, this kind of official recognition is not a condition, as a community can still perceive a work, place or tradition as part of its cultural heritage.

152 Although there is no universally accepted definition of cultural heritage in EU trade mark law, applying the criteria of the Vigeland judgment or the ones described above in the guidelines to the present case, the Grand Board considers that the condition for declaring the sign unregistrable because it is contrary to public order on the grounds of misappropriation of cultural heritage are not fulfilled. According to the Vigeland judgment, cultural heritage is morally violated by trade mark registration if the public would find the registration offensive in two main ways: first, that it represents an offensive misappropriation or desecration of an artist's work or, second, that the public perceives it as a misappropriation of a prominent part of the nation's cultural heritage, an emblem of its sovereignty, or foundational values. The Vigeland judgment even went so far as to state that trade mark registration for culturally significant works should be excluded on grounds of public policy and morality, even if the work is not inherently shocking, because the act of commercialising it is what violates public morality.

153 In the present case, the trade mark applied for corresponds to the name of a famous author and the biography of that person. Applying to register the name of that person in relation to the goods and services at issue in no way desecrates his prestige or renown – quite the contrary. While Orwell is greatly admired as a writer, his biography (which was not written by him) is not so famous as to represent a prominent part of any Member State's cultural heritage within the EU and nor is it an emblem of their sovereignty or foundational values. Even if the political and sociological values he espoused through his allegorical criticisms are central to democracy, his name has – through adjectival use (namely, the term 'Orwellian') – become associated with dystopian, anti-democratic ideas of totalitarianism. In any event, the commercialisation of that author's name, and the eponymous bibliography, through a trade mark registration for the goods and services sought, would not be contrary to the public policy or morality of any Member State.

154 It would not violate any set of fundamental norms, principles and values of societies in the European Union at the time of filing of the trade mark application. In particular, the Board fails to see how it could breach the universal values of the EU, such as human dignity, freedom, equality and solidarity, and the principles of democracy and the rule of law, as proclaimed in the Charter of Fundamental Rights of the European Union. Nor, from the perspective of a person of normal levels of sensitivity or tolerance, would it be contrary to the accepted principles of morality, that is, the fundamental moral values and standards accepted by a society in the European Union. It is not shocking, offensive or otherwise morally reprehensible.

B) Article 7(1)(d) EUTMR

155 The Grand Board notes that the Executive Director in its answers that 'signs covered by Article 7(1)(d) EUTMR are excluded from registration not because they are directly descriptive of a characteristic of the goods or services (which would be covered by Article 7(1)(c) EUTMR) but because their current usage designates those goods and services (e.g. a red and white pole indicates a barber shop though it does not describe them)'.

156 The Grand Board does not follow the view of the Executive Director, who does not exclude that, in some cases, the name of a famous author may qualify to be refused under this provision if it has become customary in relation to books. For this to occur, the author's name would need to be used to a significant extent as a common term to designate books themselves or books with certain characteristics, rather than merely to identify the author or the subject matter of a book.

157 As mentioned above under Article 7(1)(c) EUTMR, the adjective and noun 'Orwellian' exist, and a mark applied for that term in relation to books, printed matter or entertainment may be considered generic. However, this is not the case here. Nevertheless, the fact that an adjective exists which is derived from the name of the author being considered in the present case, means that no quantum leap of cognitive thought is needed on the part of the relevant public to perceive George Orwell as being the subject matter of the books, printed matter or entertainment sought to be protected by the sign applied for. That perception is immediate and direct.

C) Article 7(1)(e)(iii) EUTMR

158 In accordance with Article 7(1)(e)(iii) EUTMR, signs, which consist of the shape, or another characteristic, which gives substantial value to the goods, are excluded from registration.

159 In case 23/04/2020, C-237/19, Gömböc, EU:C:2020:296, the Court of Justice held that Article 7(1)(e) EUTMR serves to delimit property rights that are limited in time, such as patent, design, copyright on the one hand, and trade mark law, on the other hand. By the last legislative reform, the legislature has extended protection to signs which consist exclusively of the shape, or another characteristic, which gives substantial value to the goods (§ 50, 60).

160 In this respect it is also important to note that the Court of Justice in its judgment of 16/07/2009, C-202/08 P, RW (fig.), EU:C:2009:477 held that ‘the body of relevant [Union] law provisions do not distinguish, in principle, between trade marks for goods and service marks’ (§ 75).

161 The question is whether the name of a reputed author of a book is a characteristic of ‘books’ in Class 16, that gives substantial value to the books, if that description includes the books that they have written.

162 It is clear that the stated objective of Article 7(1)(e) EUTMR is to prevent the exclusive and permanent rights that a trade mark confers from serving to extend the life of other IP rights indefinitely, which the EU legislature has sought to make subject to limited periods. Registering a trade mark for the name of an author for books, would not extend the life of other IP rights as this provision does not cover moral rights of an author. This is because the author is merely the initial owner of the copyright in the books they have written. It is the literary work itself (not the name of the author), which is protected by copyright and which, once in the public domain, can be freely used, reproduced and adapted (subject to possible restrictions regarding the moral rights of the author).

163 The Grand Board considers that obtaining a trade mark for the name of the author would not allow the trade mark owner to exploit functions that are meant to return to the public domain upon the expiry of copyright protection.

D) Article 7(1)(g) EUTMR

164 The Grand Board raised with the Executive Director the question whether the mark may be considered misleading if the applicant was neither the author themself; nor the heir of the author; nor the holder of any copyright or title right.

165 The identity of the applicant has no impact in the *ex officio* examination of trade mark applications regarding the absolute grounds for refusal of Article 7 EUTMR that are relevant to this referral (05/10/2011, T-526/09, PAKI, EU:T:2011:564, § 17; 16/05/2024, R 260/2021-G, COVIDIOT (fig.), § 38). Therefore, none of the scenarios presented will change the assessment of Article 7(1)(g) EUTMR on deceptiveness which is evaluated independently of who the applicant is. Article 7(1)(g) EUTMR cannot extend to anything other than

the goods or services in question, on the one hand, and the perception of the mark by the relevant public, on the other.

166 The Grand Board considers that the examination of the deceptive character of a trade mark is restricted to the interaction between how the consumer will perceive the sign in relation to the goods and services as worded in the specification and, whether, taking account of the market reality of how the consumer purchases such goods and services, there is a sufficiently serious risk that the consumer will be deceived as to the nature, quality or geographical origin of the goods or services (04/03/1999, C-87/97, Cambozola, EU:C:1999:115, § 41-42; 30/03/2006, C-259/04, Elizabeth Emanuel, EU:C:2006:215, § 47, 48-49; 29/06/2022, La Irlandesa 1943, T-306/20, EU:T:2022:404, § 55).

167 Therefore, it could be concluded that it is irrelevant for the examination of Article 7(1)(g) EUTMR whether the applicant is/was or not (a) the author themself, (b) the author’s heir or (c) the holder of any copyright, moral right or title right.

VII. Conclusion

168 The Grand Board concludes that the examiner correctly rejected the contested sign for all the goods and services listed in paragraph 4 above, on the basis of Article 7(1)(c) and 7(1)(b), in conjunction with Article 7(2), EUTMR for being descriptive and non-distinctive, at least for Irish consumers.

169 The appeal is dismissed.

Order

On those grounds,

THE GRAND BOARD

hereby:

Dismisses the appeal.

Signed	Signed	Signed
S. Stürmann	V. Melgar	G. Humphreys Bacon
Signed	Signed	Signed
N. Korjus	C. Negro	S. Martin
Signed	Signed	Signed
L. Marijnissen	C. Bartos	Ph. von Kapff

Acting Registrar:

Signed

K. Zajfert