

**DECISION
of the Fourth Board of Appeal
of 19 November 2019**

In Case R 588/2019-4

Newbury Healthcap Limited

22 Stassikratous Street

Office 104

1685 Nicosia

Cyprus

Applicant / Appellant

represented by GROTH & CO. KB, Birger Jarlsgatan 57 B, 113 56 Stockholm,
Sweden

APPEAL relating to European Union trade mark application No 17 925 491

THE FOURTH BOARD OF APPEAL

composed of D. Schennen (Chairman and Rapporteur), C. Bartos (Member) and
L. Marijnissen (Member)

Registrar: H. Dijkema

gives the following

Decision

Summary of the facts

- 1 On 2/07/2018; the applicant filed European Union European Union trade mark application No 17 925 491 for the word mark

MYSTAR GLOBAL STAR REGISTRY

for goods and services in Classes 14, 16 and 35.

- 2 On 15/01/2019, the examiner took a decision to reject the EUTM application partially, on the grounds of Article 7(1)(b) and (c) EUTMR, lack of any distinctive character and descriptive character, for the goods and services in Classes 16 and 35 (all), namely for:

Class 16 – Printed matter: printed publications; repertories, Books, Publications, Pamphlets, Brochures, Diagrams, Directories, Certificates and sheets for identification of celestial bodies, the names and positions of stars, printed certificates and charts with the names of positions of stars.

Class 35 – Mail order, telephone and internet ordering relating to publications, booklets, brochures, Diagrams, Lists, certificates and sheets for identification of celestial bodies and their positions, cataloguing of records relating to named stars; Novelty gift services, namely, designating celestial stars with names selected by customers and providing certificates to customers by means of the global computer network; Naming, namely naming of stars.

- 3 The examiner reasoned that notwithstanding the slight, and non-distinctive, graphic presentation, where the ‘star’ device only reinforced the verbal element ‘star’, the relevant consumer would perceive the sign simply as an indication about characteristics of the goods and services, in the sense that they relate to a worldwide star register, to which the refused goods and services pertain. A registry means a collection of official records, according to www.collinsdictionary.com. A ‘star registry’ means an official register of stars, available worldwide (‘global’). It is in particular descriptive for certificates for the identification of celestial bodies, because they may certify that a star is featured in a global registry. Consumers would see the applied-for sign as an informative message, but not as an indication of commercial origin. The examiner referred to the website www.globalstarregistry.com, which she believed was run by the applicant. The application was allowed to proceed for the goods in Class 14.
- 4 With the agreement of the applicant the decision was taken in the second language of the EUTM application, English.
- 5 On 14/03/2019, the applicant filed a notice of appeal against the contested decision.
- 6 The statement of grounds was submitted on 03/05/2019, in English. It contests the decision to the extent the application was refused. The applicant argued:

- The applied-for sign is actually a slogan and as such it is distinctive. The sign is evocative.
 - The test under Article 7(1)(b) EUTMR would lead to the result that the sign will be linked to one given business entity, and not be seen as a generic expression.
 - The applicant seeks protection not for the words ‘global star registry’ as such, but for a precise word combination, which renders the sign distinctive.
- 7 On 30/08/2019, the Board issued a communication to the applicant, in which it was pointed out that after a preliminary first examination of the case, the Board raises objections against the registrability of the mark under Article 7(1)(g) EUTMR. The reasons were given as follows: Article 7(1)(g) EUTMR excludes from registration signs which are of such a nature as to deceive the public. The sign contains a promise to the client that the applicant holds a ‘global star registry’. All goods and services relate to such a star registry. It appears that the promise to give names to stars upon petition of private customers and against payment of a consideration is deceptive. The applicant certainly has no authority to give official names to stars. Giving unofficial names to stars is of zero economic value and purely token. It appears that any star registry run by a private entity is nothing more than a private register for anything or nothing. Reference was made to the website https://www.iau.org/public/themes/buying_star_names/, on which the International Astronomical Union makes clear that it is not connected to any private activity in this field and that private star registries are devoid of any relevance for scientific names given to stars or any other celestial objects. The Board also specifically drew the attention to the following paragraph of that website: ‘Thus, like true love and many other of the best things in human life, the beauty of the night sky is not for sale, but is free for all to enjoy. True, the “gift” of a star may open someone’s eyes to the beauty of the night sky. This is indeed a worthy goal, but it does not justify deceiving people into believing that real star names can be bought like any other commodity’. Indeed, a romantic proposition to tell a beloved person ‘I name that star after you’ but of no binding effect to third persons (see also the successful pop song by DJ Ötzi ‘Ein Stern, der deinen Namen trägt’).
- 8 The Board added that in the decision of 4/4/2001, R 468/1999-1, INTERNATIONAL STAR REGISTRY, the First Board of Appeal found the mark in breach of Article 7(1)(g) EUTMR. The Board expressly referred to the reasoning in that decision. The EUIPO is particularly concerned about private entities who pretend to maintain private trade mark registers. These must be considered fraud, for several reasons, one of them being that such offers do not inform the prospective client that the entry in a private register is as useless as if one wrote s.th. in one’s personal diary. The Board referred to the following links: <https://euipo.europa.eu/ohimportal/en/misleading-invoices>; <https://www.wipo.int/madrid/en/fees/warning.html>. The Board could not find any evidence on the Internet about any use by the applicant for the activities covered by the list of goods and services, so the Board would assess the case on the basis of a prognosis.

- 9 The applicant was given two months to file its observations on this communication.
- 10 The applicant replied on 22/10/2019 and disputed the application of Article 7(1)(g) EUTMR. It stated:

However, after the limitation filed by this party, the list of goods and services consists of the following goods and services:

Class 14. Precious metal and their alloys and goods in precious metals or plated or coated therewith, Namely metal badges for clothing, Medals; Ornamental pins, trophies; Medallions, Key rings; Key rings, Statues or figurines (statuettes); Jewelry.

Class 16 Printed matter: printed publications; repertories, Books, Publications, Pamphlets, Brochures, Diagrams, Directories, Certificates and sheets printed certificates and charts

The Board decision R 468/1999-1 had accepted that mark for ‘advertising’. There was no reason to assume an actual deceit or sufficiently serious risk for such a deceit. An objection should be raised only when the list of goods and services is worded in such a way that a non-deceptive use is not guaranteed. The applicant took issue with the statement of the Board that no evidence of actual use had yet been found by the Board. The principle should be first-to-file and no actual use was necessary. There was no proof that the applicant actually used the sign in a misleading way. The applicant attached a list of registered EUTMs which contain the word ‘REGISTRY’. The applicant maintained its request to annul the contested decision and to allow the EUTM application to proceed.

Reasons

Admissibility

- 11 The appeal is admissible. Pursuant to Article 21(3) EUTMDR the applicant was entitled to file the notice of appeal and the statement of grounds of appeal in the language in which the contested decision was taken. The appeal is limited to the refusal of the application, in part, under Article 7(1) EUTMR and the use of the second language as the language of the decision under appeal is not among the grounds for appeal.

Article 7(1)(g) EUTMR

- 12 The appeal is not well founded.
- 13 The contested decision relied on definitions which are correct. The definitions of ‘registry’ coupled with the indication of the year in which this entity is founded lead the applicant to argue that the sign designates one specific registry set up by just one entity and is thereby distinctive in terms of Article 7(1)(b) EUTMR. But exactly these are the reasons why the sign must be refused under Article 7(1)(g) EUTMR. The Board has heard the applicant on the reasons for a refusal under

that provision, and the Board is entitled to object the application under any other ground under Article 7(1) EUTMR than the one(s) invoked by the examiner, see Article 27(1) EUTMDR.

- 14 Article 7(1)(g) EUTMR excludes from registration as an EUTM trade marks which are of such a nature as to deceive the public, for instance (but not limited to) as to the nature, quality or geographical origin of the goods and services. As the reference to goods and services in that provision makes clear, this must be assessed vis-a-vis the goods and services as filed. Moreover, the wording of the provision refers to the public, the perception of which is decisive (05/05/2011, T41/10, *esf école du ski français*, EU:T:2011:200, § 51), and not the – good or bad – intentions of the applicant.
- 15 It suffices under Article 7(1)(g) EUTMR that the applied-for sign contains word elements which are deceptive, notwithstanding the presence of other elements in the sign, be them distinctive or not. The ground for refusal under Article 7(1)(g) EUTMR applies on account of the presence of the expression ‘GLOBAL STAR REGISTRY’.
- 16 The refused goods in Class 16 are expressly indicated as being certificates and like printed matter for the identification of celestial bodies and the names of stars. The general term ‘printed matter; printed publications’ is a broad term covering the subsequently-listed certificates etc and share their destiny (28/06/2011, T487/09, *ReValue*, EU:T:2011:317, § 74; 7/06/2001, T-359/99, *EuroHealth*, EU:T:2001:151, § 33).
- 17 The refused services in Class 35 concern the possibility of a customer to choose a name for a star.
- 18 The meaning of the word elements ‘GLOBAL STAR REGISTRY’ is clear and the applicant, on appeal, has not challenged the definitions provided by the examiner.
- 19 As the examiner indicated with respect to the definition of ‘registry’, this implies an official or quasi-official activity. ‘STAR’ refers to the fact that this registry concerns stars, i.e. the names of stars. The word ‘GLOBAL’, in conjunction with the word ‘REGISTRY’, suggests that this registry is global and worldwide which means that it covers all countries of the world. It suggests that there is just one global registry for stars. The word ‘certificate’ in the list of goods and services refers to something authoritative and official.
- 20 Taken together with the goods and services the applicant, through the sign, promises individual customers that they can choose a name for a star and that that name will then be entered in a registry. The further wording ‘MYSTAR’ only reinforces the suggestion that a private person can become the ‘owner’ of a star or its name.

- 21 Such an international, global or otherwise relevant ‘register’ of star names does not exist. The applicant promises not to register stars as such (this can only be done after a scientist has found a new star in the sky) but to register given names, chosen by the customer, to an already discovered star.
- 22 As already pointed out in the communication of the Board, the promise to give names to stars upon petition of private customers and against payment of a consideration is deceptive. The applicant certainly has no authority to give official names to stars. Giving unofficial names to stars is of zero economic value and purely token. It appears that any star registry run by a private entity is nothing more than a private register for anything or nothing. Reference is made to the website https://www.iau.org/public/themes/buying_star_names/, on which the International Astronomical Union makes clear that it is not connected to any private activity in this field and that private star registries are devoid of any relevance for scientific names given to stars or any other celestial objects. The following paragraph on that website is highly relevant: ‘Thus, like true love and many other of the best things in human life, the beauty of the night sky is not for sale, but is free for all to enjoy. True, the “gift” of a star may open someone’s eyes to the beauty of the night sky. This is indeed a worthy goal, but it does not justify deceiving people into believing that real star names can be bought like any other commodity’. Nota bene that the word ‘deceiving’ is employed.
- 23 In sum, the applicant on the one hand promises s.th. that is of a particular value for the customer (to have a personal name, be it his own name, be it of a beloved person, attributed to a star) with a ‘certificate’ value and with the value of being ‘globally’ applicable, for which on the other hand the applicant has no authority and no means of obtaining the authority. The activity is limited to printing or allowing for download of a nice-looking certificate. The fact that there is no such thing as an official star name register at all also implies that any third party could make the same pretension, so that there may be as many ‘star registers’ as there may be entities setting them up. It is plainly obvious that this amounts to selling s.th. that has zero commercial or other value.
- 24 The applicant cannot reasonably argue that the customer will perceive this plainly unofficial, if not purely symbolic character of the offer.
- 25 The average consumer, including for goods and services as the ones under refusal here, is deemed to be reasonably well informed and reasonably observant and circumspect (12/09/2019, C-541/18, Hashtag, EU:C:2019:725, § 20; 07/10/2004, C-136/02, Torches, EU:C:2004:592, § 19; 26/03/2015, T-72/14, Bateaux mouches, EU:C:2015:194, § 34). This means that the consumer may be expected to employ some degree of scepticism towards commercial offers and some self-discipline in spending his/her money but this does not allow traders to rely on such degree of observance contrary to the plain statement made by themselves. Any such degree of scepticism must ultimately still be able to rely on the plain meaning of the words read. If, for example, a geographical term is objected under that provision, it only matters whether the goods have (or can have) the indicated origin and the trader may not hide himself behind further explanations that would

contradict the indicated characteristics (e.g. ‘French red wine made in Algeria’). Rather, a trader using such indications must be taken by his own words.

- 26 In the present sign the word ‘REGISTRY’ denotes an official or quasi-official status the applicant does not have, and cannot obtain, as seen on the webpage https://www.iau.org/public/themes/buying_star_names/. A reasonably observant consumer will understand this word inside the applied-for sign as meaning that such a star registry, or register, of whatever type and run by whomsoever, nevertheless exists, and that there is some activity on this globe at some stage that englobes the possibility to influence the naming of stars in a permanent way. Such does not exist, and the promise that the consumer may obtain such a ‘star name’, purely chosen by him/her, and purely because he pays a sum of money to the EUTM applicant, is simply wrong and misleading.
- 27 By analogy, somebody might promise to give names to the trees in the forest or to the pebbles on the beach, which in itself would not be illegal, but of no other value than as a party joke. The sign might recall the recent pop song ‘Ein Stern, der deinen Namen trägt’ (a star that carries your name) so the sign might be perceived as a platform to impress one’s girlfriend with a romantic story. However, such an interpretation is precluded by the quasi-official impression given by the applied-for sign.
- 28 There is a parallelism with private ‘trade mark registers’, not because the applicant’s activities might involve fraud, but in that there is the possibility of a plethora of like registers which have the zero value in common, and which pretend an official nature. I can register on a private basis as many marks on my computer as it pleases me but when offering services against consideration in which an entry in a register (registry) is offered that is no longer a private matter. Rather, it is a matter of public policy to reserve public registers to public authorities.
- 29 The refused goods and services are addressed to the average consumer. So the applicant could not validly argue that experts in astronomy would be aware of the fact that there is no such official entity naming stars after names chosen by individuals.
- 30 The reply of the applicant to the Board’s communication of 30/08/2019 is not sufficient to overcome this ground for refusal and does not proffer any arguments that would challenge the above findings.
- 31 First of all, there is nothing in that reply that would challenge the basic reasoning that there is no official registry keeping or attributing names to stars and no possibility for the applicant to influence the naming of stars by accepted scientific authorities or public bodies.
- 32 Rather, the applicant relies on the fact that in Case R 468/1999-1 ‘advertisement’ services had been accepted by the Office. The applicant seems to take advantage

of that fact by now reformulating the refused goods and services into more abstract-worded terms. This bears no merit.

- 33 First of all, the Board is not aware of any communication from the applicant in which it would have actually declared a limitation of the list of goods and services in accordance with Article 49(1), 1st sentence, EUTMR. The wording of the applicant's communication of 22/10/2019 'after the limitation filed by this party the list ... consists of' is unclear, the Board finds no trace of such a 'filing', and taken on its own it is not a valid express and unconditional limitation.
- 34 Next, the wording set out in the communication of 22/10/2019 is not a limitation but would rather broaden the scope of the list, and this is in breach of Article 49(2), 1st sentence, EUTMR. The difference to the applied-for version (as accepted after classification discussions by Office communication of 25/09/2018, which only concerns Class 14, which is not in issue in this appeal) is that now all references to 'the identification of celestial bodies' and 'names of stars' would be dropped. That actually broadens and now would include 'directories, certificates' for any other purpose or matter (sadly, this would also include certificates for trade marks). The same would happen in Class 35, by broadening the scope in removing any reference to 'the identification of celestial bodies' and 'designating celestial stars with names'.
- 35 Thirdly, it suffices to say, as has already been observed in respect of the original list and the general terms 'printed matter; printed publications', that the claimed goods and services comprise certificates and services around the issuing of certificates for names of stars so that any removal of express references to names of celestial bodies would not alter the fact that this would still comprise goods and services for which the mark must be refused.
- 36 Next, the applicant makes reference to the principle that if two manners of use of the sign, a legal and an illegal one, are conceivable, the presumption should be that the use would be made in the legal way. That principle is in essence correct but it does not assist the applicant in the present case. Firstly, it covers the situation where no use has yet taken place so that the analysis must be by way of prognosis (see in that regard 12/09/2019, C-541/18, Hashtag, EU:C:2019:725; also in 04/04/2001, R 468/1999-1, INTERNATIONAL STAR REGISTRY, the Board took into account the actual use the applicant had demonstrated). Secondly, it is not about a use being legal or not, but being deceptive. It is not illegal to give names to stars but it is deceptive if the impression is created that a consumer may validly obtain a registration in a registry for such a name. Thirdly, what this principle addresses is a situation where the goods and services are worded in a broad generic way and the meaning of the sign would be deceptive only for part of the goods, in particular when having specific properties. If, for example, the mark is applied for 'shoes' and the mark contains the words 'genuine leather' then it must be presumed, for the benefit of doubt, that the applicant will use the mark for leather shoes and not for shoes for which that indication would be deceptive. This was also the basic scenario in the case 'TITAN' (13/09/2000, R 422/1999-1, TITAN) mentioned by the applicant, regarding the possibility that

the claimed goods were or were not made of that material. In such a case the mark would still remain descriptive anyhow unless it contains a genuinely distinctive term, and only in that latter case Article 7(1)(g) EUTMR would alter the result. This is not the type of case here, as all the goods and services are related to the naming of stars and there is no non-deceptive use readily conceivable. Rather, the sign is deceptive in itself in that it gives an incorrect impression of an official status.

- 37 This is also the reason why the applicant has no reason to complain about the statement in our communication that the analysis is to be made by way of prognosis. The examiner indicated that www.globalstarregistry.com was the website of the applicant; this was not confirmed by the applicant, and the Board did not investigate this point any further. What matters is that the applicant has not been able to show an actual use in a way that would not deceive.
- 38 The Board has made reference to the numerous activities to seek money from trade mark proprietors for purported entries in purported private trade mark registers. We want to make clear at this stage that the charge against the applicant in the present case is not that its 'star register' is the same, and has the same fraudulent nature, as a 'private trade mark register'. Indeed, the latter activities are fraud already because they are addressed to owners of a valid EUTM or national trade mark and because they intend to confuse the customer about the origin of the advertisement, and also for the simple reason that in most cases the advertised private register simply does not exist. What still remains is the parallel in the sense that in both cases the entry in that sort of register has no legal value but that register is held out to have a certain type of official status.
- 39 As regards previous decisions or registrations, the communication of the Board already referred to a very early decision of the First Board of Appeal (04/04/2001, R 468/1999-1, INTERNATIONAL STAR REGISTRY), which this Board still finds perfectly convincing in its reasoning and perfectly on a par with the present case. In that sense the reference to registrations accepted by examiners of this Office which occurred after that decision are ineffective and cannot prevent this Board from aligning itself to the decision of the First Board. Next the cited registrations merely have in common that they contain the word 'REGISTRY' or 'REGISTER' but there may be many different types of registers, and here we discuss specifically registers for stars. For example, the Board fails to see a parallel to the term 'tennis registry'; there are many private organisations who organise the tennis sport at a professional level and who issue player's licenses to those who wish to compete in those professional championships or tournaments (see also 05/05/2011, T-41/10, esf école du ski français, EU:T:2011:200, § 59, concerning the sport of skiing).
- 40 Only one of the cited registrations, No 822 528, concerns a sign which makes references to registers for stars, and this is exactly the application which was refused by virtue of the decision R 468/1999-1 except for 'advertising', so this is of no avail to the applicant. The present EUTM application does not include 'advertising' services.

- 41 The EUTM application must be refused for the goods and services under appeal, as it is in breach of Article 7(1)(g) EUTMR.
- 42 The goods in Class 14 were not refused by the examiner and are not within the scope of the appeal.
- 43 With this result it is unnecessary to examine the grounds for refusal on which the contested decision was based, namely breach of Article 7(1)(b) and (c) EUTMR.
- 44 The appeal is dismissed in its entirety.

Order

On those grounds,

THE BOARD

hereby:

Dismisses the appeal.

Signed

D. Schennen

Signed

C. Bartos

Signed

L. Marijnissen

Registrar:

Signed

H. Dijkema

