

DECISION
of the Fourth Board of Appeal
of 19 May 2021

In Case R 378/2021-4

Rozanne Verduin Holding B.V.

Rue de Vrolijkstraat 273-1

1091 VB Amsterdam

Netherlands

Applicant /Appellant

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

Appeal concerning EU trade mark application No 17 358 458

THE FOURTH BOARD OF APPEAL

Composed of D. en (Chair), L. Marijnissen (Rapporteur), E. Fink (Member)

Registrar: H. Dijkema

gives the following

decision

Summary of the facts

- 1 By application lodged on 16 October 2017, Rozanne Verduin Holding B.V. (‘the applicant’) applied for registration of the image of the trade mark.



as an EU trade mark (EUTM) for the following services:

Class 35 — Mannequin services and photomodels for publicity or sales promotion;

Class 41 — Models and mannequins for recreational or recreational purposes.

- 2 On 1 March 2018, the examiner informed the applicant that, on the basis of Article 7(1) (b) of the EU trade mark Regulation (‘EUTMR’), the mark applied for was devoid of any distinctive character in relation to the services for which protection was sought. The applicant maintained its application for registration despite the objections raised by the examiner.
- 3 On 11 January 2021, the examiner took a decision (‘the contested decision’) to refuse the trade mark applied for in its entirety pursuant to Article 7(1) (b) EUTMR. This decision was based mainly on the following findings:
 - The services covered by the mark applied for are aimed both at the general public and at a specialised public. The image at issue in the present case consists only of a natural faithful representation of the head/face of a (young) woman. Bearing in mind the attentiveness of the relevant public, the mark applied for does not enable that public to distinguish the services applied for immediately and smoothly from similar performances with a different commercial origin.
 - For the services applied for in Classes 35 and 41, the mark applied for represents only the mannequin or the photomodel providing the service; the mark applied for consists of no more than a representation capable of being used in the presentation of those services.
 - Although a (pass) photograph of a person’s face is a unique representation, there is no characteristic, nor any imaginable or striking element, which gives the sign a minimum degree of distinctiveness in order to enable consumers to perceive it, unlike mere appearance. Uniqueness and distinctiveness are two

different concepts. Each face is unique, but this does not mean that it is immediately perceived as an indication of the commercial origin of the services applied for.

- The present picture has no particular feature capable of influencing the consumer’s memory to such an extent that he can distinguish the services sought from others. The form of presentation does not differ substantially from other faithful representations of a woman’s head/face. European consumers who are not known to Rozanne Verduin see only a “face in the crowd”, a face in the population of around 450 million people, thus losing the possible origin function of a face.
 - For the services requested, it is not unusual for them to be offered with the image of the person providing those services, such as a mannequin or photomodel. Countless photographs of women’s heads/faces exist in a wide range of fields, including in the design world.
 - The link between the mark applied for and the services applied for is sufficiently close to refuse the sign on the basis of Article 7(1) (b) EUTMR.
 - The applicant has not shown that the mark applied for is distinctive in the European Union through the use which has been made of it, within the meaning of Article 7(3) EUTMR, for the services in question.
- 4 On 19 February 2021, the applicant brought an action against the contested decision and requested that it be set aside in its entirety. The statement setting out the grounds of appeal was received on the same day.
- 5 The applicant asks the Board of Appeal to cancel the refusal in respect of the mark applied for and to register it for all the services applied for. The arguments put forward may be summarised as follows:
- The ground for refusal under Article 7(1) (b) EUTMR does not apply to the present case.
 - Distinctive and original characteristics are criteria for distinctive character. The face of an adult is precisely the element of the human body which enables people to distinguish one human being from another. The Boards of Appeal have previously decided, on a number of occasions, that the public will perceive a photographic representation of a person as an identifier of the origin of goods and services.
 - The fact that images of individuals are generally used more frequently in the sale or supply of goods and services does not alter the distinctive character of the present application. As long as the representation which is the subject matter of the mark applied for is recognisable and unique in itself, it may serve as a sign of origin.
 - Whether a trade mark is distinctive does not depend on the number of people likely to be confronted with the trade mark; a trade mark is distinctive or not distinctive.

- In addition to the fact that the human face of an adult is a distinguishing sign, Rozanne Verduin whose face is depicted in the mark applied for is a well-known person in the fashion world for design services; it is known as an international retreading, catwalk and commercial model. Its face is its mark and, with its success, it has built up a beautiful popularity and reputation which gives sufficient grounds for registration of its portrait as a trade mark.

Justification

- 6 The action is admissible and well founded. The applicant's application for registration of the sign applied for will be understood as a request for publication for opposition purposes pursuant to Article 44 EUTMR.
- 7 Under Article 7(1) (b) EUTMR, trade marks which are devoid of any distinctive character are not to be registered.
- 8 The idea underlying Article 7(1) (b) EUTMR coincides with the essential function of the trade mark, which is to guarantee the identity of origin to the consumer in relation to the goods and services covered by the trade mark (08/05/2008, C-304/06 P, Eurohypo, EU:C:2008:261, §56; 15/09/2005, C-37/03 P, BioID, EU:C:2005:547, § 60).
- 9 That absolute ground for refusal is thus intended to ensure that the consumer is able, without any possibility of confusion, to distinguish the product or service in question from goods or services of different origin. A trade mark which makes it possible to identify the product or service in respect of which registration is sought as originating from a particular undertaking and thus to distinguish that product or service from those of other undertakings has distinctive character within the meaning of that provision (05/12/2002, T-130/01, Real People, Real Solutions, EU:T:2002:301, § 20; 12/05/2016, T-32/15, MARK1 (fig.), EU:T:2016:287, § 25-26).
- 10 It is not necessary for the trade mark to convey exact information about the identity of the manufacturer of the goods or the supplier of the services. It is sufficient that the mark enables the relevant public to distinguish the product or service designated by it from goods or services having a different commercial origin (21/01/2011, T-310/08, executive edition, EU:T:2011:16, § 22).
- 11 On the other hand, signs which are not capable of fulfilling the essential function of the trade mark, namely to indicate the origin of the product or service, are devoid of any distinctive character within the meaning of that provision, so that the consumer who acquired the product covered by that mark or to whom the service designated by that mark has been provided may repeat that choice or, in the event of a negative experience, make a different choice in the event of a subsequent purchase or assignment, if the experience has been positive (12/05/2016, T-32/15, MARK1, EU:T:2016:287, § 28; 04/07/2017, T-81/16, a pair of curved strips on the side of a tire, EU:T:2017:463, § 46).
- 12 The Court of Justice has observed that, although the criteria for assessing the distinctive character of the different categories of trade marks are identical, the

application of those criteria may show that the perception of the relevant public is not necessarily the same for each of those categories of trade marks and that it may be more difficult for certain categories to establish distinctive character (08/04/2003, C-53/01 to C-55/01, Linde, EU:C:2003:206, § 48); 12/02/2004, C-218/01, Henkel, EU:C:2004:88, § 52; 06/05/2003, C-104/01, Libertel, EU:C:2003:244, § 65).

- 13 First of all, it is not clear why it would be more difficult for the figurative mark applied for to establish distinctive character. This is not motivated, for example, by the fact that the figurative mark is a faithful representation. In any event, even if it were indeed more difficult to establish the distinctive character of a photograph representing a person (*quod non*), that does not mean that the registration of marks consisting of the representation of persons would be excluded if they could immediately be perceived as an indication of the commercial origin of the goods or services in question, so that the relevant public is able, without any possibility of confusion, to distinguish the goods or services of the proprietor of the trade mark from those of another commercial origin.
- 14 It is true that, although special or original characteristics are not criteria for the distinctive character of a trade mark, the mark in question must enable the public to distinguish the goods and services concerned from those of other undertakings or persons (04/07/2017, T-81/16, a pair of curved strips on the side of a tire, EU:T:2017:463, § 49).
- 15 The Board of Appeal considers that this is the case with the sign applied for. The image at issue in the main proceedings, as also indicated by the examiner, consists, taken as a whole, of the natural faithful representation of a woman's head/face, in common colours and on a common background. Contrary to the view taken by the examiner, that representation does indeed enable the relevant public, consisting of the general public and a specialist public, to distinguish the services in question from those of a different commercial origin and, in particular, as originating from the specific person depicted.
- 16 The mere fact that a photograph is a faithful representation of what is depicted by nature does not mean that it cannot be perceived as a trade mark, all the more so since the representation itself does not say anything about the services applied for. The sign applied for relates, without doubt, to the representation of the face of a particular person, with its unique face, that is to say, its specific external features, in the form of a passport photograph. In addition to (inter alia) the surname and first name, the representation of the face in the form of a passport photograph applies to the identification of a person and therefore to his or her honesty of other persons. Whether the person can actually be named by name when viewing the image because it is known to the relevant public does not alter this.
- 17 The representation at issue in the main proceedings may therefore, in the view of the Board of Appeal, fulfil the essential function of a trade mark, in order to distinguish the services applied for from a different origin (16/11/2017, R 2063/2016-4, device (PHOTO) OF THE HEAD OF A Woman, § 37; 23/10/2019, R 2574/2018-1, FOTOGRAFÍA AND COLOR DEL ROSTRO DE UNA PERSONA, § 14-15).

- 18 This is not affected by the fact that many other faithful images of faces are conceivable from women and men. Each of these will be a unique representation of that specific person, with his or her own specific appearance. The existence of double keepers and identical multiple births can be disregarded in this context as exceptional and exceptional. Moreover, that argument could also, wrongly, be raised against any other type of trade mark; how many words, patterns, images of animals, etc. do not exist?
- 19 On the contrary, the examiner's argument that, in respect of the services applied for in Classes 35 and 41 of mannequins and photomodels, the image represents only the person providing those services indicates that the image may be perceived as a means of distinguishing the commercial origin of those services. The relevant public will perceive the sign as an identifier of the origin of the services in question, namely that they originate from the person depicted, thereby fulfilling the essential function of a trade mark (16/11/2017, R 2063/2016-4, device (PHOTO) OF THE HEAD OF A Woman, § 24-25).
- 20 Similarly, the finding of the examiner that it is not unusual for the services applied for in Classes 35 and 41 to be offered with the representation of the person providing the services does not call into question the conclusion that the mark applied for has distinctive character. Apart from the fact that such a finding, which is not, moreover, substantiated, is part of the ground for refusal laid down in Article 7(1) (d) EUTMR, which is not at issue here, the representation is reproduced in the mark applied for only of its kind. Nor is the fact that the use of the mark applied for is common for the services in question.
- 21 Since, contrary to the examiner's view, the trade mark applied for does not infringe the absolute grounds for refusal set out in Article 7(1) (b) EUTMR, it is not necessary to examine whether it has acquired distinctive character as a result of its use in respect of the services in respect of which registration is sought under Article 7(3)EUTMR.
- 22 In the light of the foregoing considerations, the appeal is held to be well founded and the contested decision annulled.

Judgment

On those grounds, THE BOARD, hereby:

- 1. Annuls the contested decision;**
- 2. Allows, pursuant to Article 44 EUTMR, publication of EU trade mark application No 17 358 458 in respect of all the services for which the mark is applied for.**

Signed

D. Schennen

Signed

L. Marijnissen

Signed

E. Fink

Registrar:

Signed

H. Dijkema

