

# D YOUNG & CO TRADE MARK NEWSLETTER *no.115*

March 2021

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WTR 1000 has once again ranked our firm as “gold” in the UK. Such positive feedback means a great deal to our entire team and we are extremely grateful to all clients for their valued comments. As we go to press, for the first time UK trade mark applications filed up till 14 March (35,068) surpassed their EUTM counterparts (31,845), showing the ongoing importance of the UK to brand owners as a thriving marketplace. Our UK and German offices continue to offer a full range of European IP services and we look forward to hopefully being able to meet up in person some time soon – but in the meantime at various online IP industry events.

Matthew Dick  
Partner, Solicitor

## Events



23 March 2021

### IP Inclusive's 2021 Annual Meeting

Partner Rachel Bateman will be attending IP Inclusive's annual meeting which will take place as a virtual round table event this year, and will include IP Inclusive community updates, regional networks and discussion about IP Inclusive's future development.

12-14 May 2021

### AIPLA 2021 Spring Meeting

Partner Jana Bogatz will be speaking at AIPLA's spring meeting.

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## Distinctiveness of slogans

# “It’s like milk but made for humans” Oatly capitalises on controversy in GC distinctiveness decision

**T**he General Court (GC) has overturned the European Union Intellectual Property Office (EUIPO) refusal to register the mark “IT’S LIKE MILK BUT MADE FOR HUMANS”. The General Court was persuaded that Oatly’s slogan met the minimum requirement for distinctive character.

This surprise decision from the General Court signals a break from the EUIPO’s typical reluctance to register slogans consisting of ordinary words. The decision was influenced by the “controversial” sentiment of the mark, evidenced by a substantial backlash in Sweden, the UK and the Netherlands.

### Background

Oatly AB, known as “the original Swedish oat drink company”, is a giant in the expanding market for plant-based dairy alternatives, or “alt-milks”. The company are famed with pioneering oat based food and drinks products, but its startling growth has undoubtedly been fuelled by its quirky, even controversial, marketing campaigns.

On 14 March 2019, Oatly applied to register the word mark “IT’S LIKE MILK BUT MADE FOR HUMANS”, which was partially refused by the EUIPO for goods in classes 29, 30 and 32, including dairy substitutes and various oat based food and drink products. The EUIPO’s refusal on the basis of Article 7(1)(b) was upheld by the Board of Appeal and then overturned in this General Court decision.

### Relevant public

The Board of Appeal assessed the relevant public to be the English-speaking territories of the EU: Ireland and Malta. This enabled the Board of Appeal to disregard some of the applicant’s evidence relating to additional territories, where English is not an official language.

In the GC appeal Oatly argued that the Board of Appeal should have taken into account English speaking consumers in Denmark, the Netherlands, Finland and Sweden. The General Court agreed that the EUIPO had erred on this point. The additional evidence included a Swedish court case

and media backlash in the Netherlands and the UK which became pivotal, as the evidence demonstrated the controversy ignited by the launch of the slogan.

Both the Board of Appeal and General Court agreed that the relevant consumer circle was the general public which, critically, includes a non-negligible group of consumers who avoid milk for health or ethical reasons. This group was crucial to the question of how the mark “IT’S LIKE MILK BUT MADE FOR HUMANS” would be perceived.

### Oatly’s controversial campaigns

You may recognise “IT’S LIKE MILK BUT MADE FOR HUMANS” as a lyric sung by Oatly’s CEO Toni Petersson in the now infamous 2021 Oatly Super Bowl advert. The “Wow, No Cow” song and advert was particularly strange and surprising for its low-budget feel, which juxtaposed with the expensive, star studded Super Bowl commercials viewers have come to expect.

The advert and song containing the lyric were first launched in Sweden in 2014 and allegedly took just one or two takes. However, the provocative tag line “IT’S LIKE MILK BUT MADE FOR HUMANS” presumably made up for this in legal fees, when the company was promptly sued by the Swedish dairy lobby LRF Mjöl, for being misleading and “scaring [consumers] into thinking cow’s milk is dangerous”. The Swedish Court ruled against Oatly, banning use of the provocative slogan in Sweden in 2015.

Undeterred, or even spurred on, by the Swedish ban, Oatly has re-launched its “controversial” campaign and slogan in various countries since. Repeatedly fuelling the debate over whether the tag line “IT’S LIKE MILK, BUT MADE FOR HUMANS” is an irrefutable fact, or misleading provocation of the dairy industry.



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### This case concerns Oatly's slogan "IT'S LIKE MILK BUT MADE FOR HUMANS"



Undoubtedly, Oatly's legal team had a difficult task on its hands considering Oatly has been arguing that it is a simple fact that milk is not made for humans for years, both during and since the Swedish case. However, clearly the slogan cannot be misleading and unfairly disparaging to the milk industry, as well as being simply factual and non-distinctive.

#### Fact v perception

Through a literal reading of the slogan, "IT'S LIKE MILK BUT MADE FOR HUMANS", one might reasonably conclude that the mark is non-distinctive, on the basis that it is a technically true statement of fact. Milk is not "made for humans" it is made for baby cows. After all, this is exactly the type of simple, fact-based messaging Oatly has built its brand on.

Indeed, the Board of Appeal decided that the relevant consumers would immediately recognise the phrase as promoting a factual, laudatory principle. The Board of Appeal found that the mark would be perceived as indicating that the goods applied for were similar to milk but "more apt for human consumption than real milk."

As a result, the mark would simply be perceived as a promotional laudatory slogan, highlighting the positive aspects of the goods concerned. The Board of Appeal stressed that the mark was promotional because a relevant part of the public are vegan or don't drink milk for health reasons.

In the GC appeal, Oatly argued that this was an error as the Board of Appeal

had focused on the perception of a small sub-section of the general public, that is vegan or lactose intolerant, as opposed to the broader general public.

Oatly argued that the immediate perception of the broader general public is that milk is "a healthy and nutritious staple food", produced for human consumption. Therefore the phrase evokes the controversial notion that milk is not appropriate in a human diet. As a result, the mark should be considered "paradoxical, surprising, thought provoking and unexpected". This was evidenced by the Swedish Court case, discussed earlier, and the media backlash in the Netherlands and the UK.

In contrast, the EUIPO contended that the general public is aware of the continuing debate regarding the human consumption of milk from another animal and that the average consumer knows the primary function of milk is to feed baby animals.

#### General Court decision

In assessing all of these arguments, the General Court decided that the slogan "calls into question the commonly accepted idea that milk is a key element of the human diet" as evidenced by the backlash in the Netherlands, Sweden and the UK, where launch of the slogan triggered considerable controversy.

As a result, the mark was considered capable of triggering a cognitive process in the minds of relevant consumers, making it a memorable indicator of origin, which meets the threshold for distinctive character.

The General Court concluded that although a non-negligible part of the relevant public avoids consuming dairy products, this group of consumers are also highly aware of the commonly held belief that milk is essential to a human diet. Therefore, the mark is still capable of setting off a cognitive process for that specific part of the relevant public, as well as the broader general public.

#### Conclusion

This decision hinged on whether the relevant public immediately recognises that milk is produced for baby cows and, crucially, whether consumers perceive that as an uncontroversial fact.

Oatly avoided undermining its ethical principles, by harnessing the criticisms of its own detractors, in order to prove that the phrase is still controversial and that consumer perception has not yet matched Oatly's own ideals.

**Author:**  
**Abigail Macklin**



#### In short

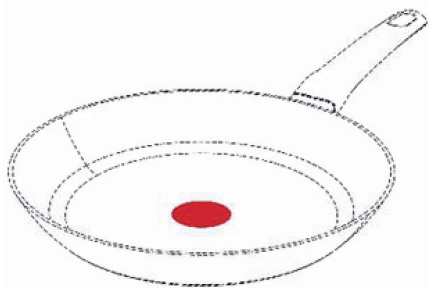
While the EUIPO remains generally sceptical of slogans consisting of ordinary words, consumer perception is vital. If a slogan sparks sufficient debate or provokes backlash, this may be used as evidence that the mark meets the minimum threshold for distinctiveness in the EU. In the battle of fact v perception, perception will win.



# Tefal's pan with the "famous red spot"

## Proving an indicator of commercial origin

**T**efal applied to register the mark (shown below) in the UK for frying pans and related goods in class 21. The application was rejected as being devoid of distinctive character. Tefal submitted evidence of acquired distinctiveness, including a survey.



Tefal had sold over 42 million units since 2000 and net sales were over EUR 340 million. It had spent over £20 million in UK promotion over the last ten years, including displaying the famous red spot in major publications such as *Good Housekeeping* and *The Times*. Products bearing the mark had featured in commercials aired during popular shows such as *MasterChef* (4 million viewers in 2013). A witness statement from the COO of the British Home Enhancement Trading Association confirmed that a round, red spot at the centre of a frying pan was known in the industry and understood as an indication that the product originates from Tefal.

Despite such substantial sales over a significant period of time, the issue essentially came down to whether the red dot, on its own, would be seen as an indicator of brand origin by consumers.

Of 400 people interviewed across the UK in May 2019, the survey had shown that 32.5% mentioned "TEFAL" unprompted when asked what came to mind when they saw the mark. A further 27.75% mentioned "TEFAL" when prompted to name a company. Ultimately the survey showed that 60.25% of respondents mentioned Tefal in their

Was the round red dot seen as an indicator of brand origin by consumers?



responses, a statistically significant proportion, especially in the context of a crowded market.

However, simple exposure and recognition of a sign does not make out the case for acquired distinctiveness. The hearing officer believed a perfectly legitimate question to pose was what measure, if any, of trust or confidence the applicant had placed in its sign, such as to educate the public that it was a guarantee of origin? The hearing officer struggled to see exactly how Tefal had shown such confidence in the mark. The sort of confidence in question is not necessarily independent use of the sign but, for example, a referencing of the red spot in some way (such as, "The pan with the red spot"), other than as a simple feature.

The Kit-Kat case (*Societe Des Produits Nestlé SA v Cadbury UK Ltd* [2017] EWCA Civ 358) was of particular relevance, since it introduced the question of reliance as opposed to association. The hearing officer was not convinced that the evidence demonstrated that the red spot alone would be seen as an indicator of brand origin as opposed to associating the mark with Tefal. Nothing in the evidence specifically drew attention to the red spot as being a badge of origin in itself. The survey also seemed to show simply recognition of and association with a major player in the cookware sector, rather than the kind of material perception as a trade mark, which the case law required (see, for example, *Jaguar Land Rover Ltd v Ineos Holdings Ltd* [2020] EWHC 2130 (Ch)).

The hearing officer also had grave concerns that the applicant's sign was an indicator of heat rather than an arbitrary or random

red spot operating as a guarantee of origin. Some of Tefal's own evidence noted this THERMO-SPOT innovation, a heat indicator that changed appearance depending on the temperature of the pan. The evidence also disclosed references to that technology in the Grattan, Tesco and Argos catalogues; as well as no fewer than 65 of the 400 survey respondents who indicated that the sign showed a heat spot. These figures critically undermined Tefal's claim that the mark was a "famous red spot". The hearing officer held that the mark, in the eyes of many, could not be divorced from its technical function. Indeed, the hearing officer was of the opinion that Tefal's evidence had been carefully curated to seek to draw his attention away from the mark's technical function.

Author:  
Matthew Dick



### In short

Proving acquired distinctiveness can be a challenging task, even for well-known marks that are recognized by consumers. Brand owners should ensure that any evidence of acquired distinctiveness focuses on how such consumers rely on their mark as an indicator of commercial origin, rather than simply associating it with them.

# Pippi Longstocking

## Can song lyrics infringe the copyright to a fictional character?

**C**an song lyrics infringe the copyright to a fictional character? The Regional Court of Hamburg answered this question in the affirmative.

This case before the Regional Court of Hamburg concerned the German version of the theme song to the children's movies "Pippi Longstocking" called "Hey, Pippi Langstrumpf" and was brought by the heirs of Astrid Lindgren against the song writer ("defendant") and publisher ("defendant publisher").

The central question of the case was whether the song text (not the song as a whole) constituted free use or an adaptation of the fictional character "Pippi Longstocking"; the latter requiring consent of Astrid Lindgren or her legal successors. The Regional Court of Hamburg found the use to be an adaption. Since there was no consent, the song text was found to be infringing the copyright to the fictional character "Pippi Longstocking".

### Background

This case dates back to 1969 when the defendant was approached to write the lyrics to the theme song for the German-Swedish movies "Pippi Longstocking", namely to the movie "Pippi Longstocking on the run". The ensuing song text written by the defendant showed similarities to the Swedish theme song written by Astrid Lindgren herself, but wasn't a direct translation. In a letter dated September 1969 the defendant sent the lyrics to Astrid Lindgren asking for her consent. Astrid Lindgren replied stating that no such consent could be given at that time.

A month later, an initial version of the German song called "Hei, Pippi Langstrumpf" was registered with GEMA, the German society for musical performing and mechanical reproduction rights. The defendant and

Astrid Lindgren were named as joint authors of the lyrics. In 1970 the defendant signed a publishing agreement with the defendant publisher. The publishing agreement specified that the defendant was to be named as sole author of the lyrics.

As German readers may be aware, the song "Hei/y, Pippi Langstrumpf" then went on to be used as part of the theme song in the various "Pippi Longstocking" films.

Fast forward to 1987, the defendants (song writer and publisher) registered the same work with GEMA under a slightly amended name "Hey, Pippi Langstrumpf". The defendant was indicated as the sole author and the defendant publisher as the original publisher.

Almost 20 years later (in 2006), the plaintiff became aware of the fact that the registration of 1987 named the defendant as sole author of the song "Hey, Pippi Langstrumpf". After apparently very lengthy correspondence, the case was then brought before the Regional Court of Hamburg in December 2017.

### The decision

In its decision of December 2020, the Regional Court of Hamburg found that the song text to "Hey, Pippi Langstrumpf" was not only a translation of the Swedish song, but constituted an adaption. Since there was no consent with regard to the adaption, the court granted the action for information, injunctive relief and damages.

To arrive at this conclusion, the court answered the following questions in the affirmative:

- Is the reference to the fictional character connected to the adoption of essential external and characteristic features of said character?

- If yes, does this lead to the reader/listener/viewer thinking that the already known fictional character is actually to be depicted or described by the song text?

The Regional Court of Hamburg opined that the song text showed a direct link to Astrid Lindgren's "Pippi Longstocking".

Firstly, the song title included the name "Pippi Langstrumpf". Moreover, the song text referenced various characteristic features, such as Pippi Longstocking's living conditions and her financial circumstances, which considering that she has a house, a monkey and a horse (as explicitly mentioned in the song) are quite comfortable.

Aside from that, Pippi Longstocking's "fearlessness and irreverence coupled with imagination and wordplay, which is also reflected in her unconventional but at the same time cheerful way of life and her idiosyncratic way of dealing with supposedly universally valid rules, e.g. mathematics" were also depicted in the song text.

### What to take away from this?

At this stage, we do not know if the decision has been appealed.

That said, the decision shows that copyright can extend past the original type of work, in this case from a book solely to the fictional character depicted therein.

### Author:

Yvonne Stone



The defendant was asked to write the lyrics to the movie "Pippi Longstocking on the run"



### In short

A fictional character may enjoy copyright protection on its own and may be infringed if essential external and characteristic features of that character are adopted, resulting in the public thinking that the work in fact depicts/describes that fictional character.

# Getting to the point of registered designs

## IPEC finds Rothy's registered Community design valid and infringed

In what has been dubbed the “last Community design” ruling before the UK courts, the Intellectual Property Enterprise Court (IPEC) found that Rothy's registered Community design (RCD) for its “Pointed Loafer” ballerina shoes (depicted below left) was valid and had been infringed by Giesswein's “Pointed Flat” shoes (depicted below right). The court however found that there had been no infringement of Rothy's unregistered Community design (UCD) since the Pointy Flat arose from independent design rather than from copying the Pointed Loafer.



Rothy's  
Pointed Loafer



Giesswein's  
Pointed Flat

### Background

Rothy's first launched its Pointed Loafer (a type of ballerina shoe made of knitted yarn made from recycled plastic) in November 2017. The shoe had been preceded to market by two of Rothy's other shoes known as “The Flat” and “The Point” (also made of knitted yarn made from recycled plastic). It was common ground between the parties that The Flat and The Point were the first ballerina shoes to be made of knitted yarn made from recycled plastic.

In April 2019, Giesswein began marketing through its website the Pointy Flat ballerina shoes (the upper parts of which were also in a knitted meshwork fabric made from recycled plastic). This resulted in:

1. Rothy's issuing design infringement proceedings against Giesswein based on its RCD and UCD in the Pointed Loafer; and
2. Giesswein counterclaiming for invalidity for lack of individual character over

two prior art shoe designs identified as the “Bonnibel” and the “Allegra K” (the prior designs), depicted below.



Prior design - Bonnibel



Prior design - Allegra K

The question to the court was whether the RCD and UCD produced a different overall impression on the informed user when compared to the prior designs.

### Invalidity

Both side's experts agreed that, whilst fabrics knitted from heavy thread were known for shoe uppers for gym shoes and sneakers, the informed user would not be aware that they had been applied to ballerina shoes.

This meant that the use in the RCD and UCD of an upper knitted from heavy thread (as shown in the image of Rothy's Pointed Loafer above and the black and white RCD images below) would stand out to the informed user as a significant difference to what had come before.

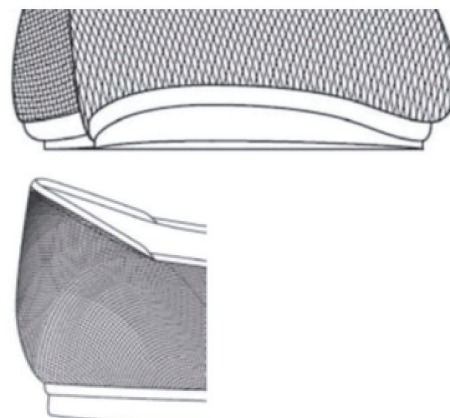
As a result, the court had no hesitation in concluding that the RCD and the UCD produced a different overall impression on the informed user than the prior designs and were therefore valid.

### Infringement - interpreting the RCD

When turning to the question of infringement,

so far as the RCD was concerned, an issue arose between the parties as to what the images in the RCD were showing and therefore what was being claimed as part of the protected registered design.

The first issue concerning the interpretation of the RCD related to the black lines shown on the surface of the shoe upper and, in particular, what those lines meant (see black and white images below).



Rothy's argued that the lines “make very clear that the upper is meshwork/ knitted” whilst Giesswein submitted that the cross-hatching either shows:

1. that the product is a three-dimensional shape; or
2. some material texture but in a more general way than depicting a knitted meshwork fabric (for example, such as knitted, woven, meshwork or animal hide textures but excluding smooth leather or plastic textures).

Although the court ultimately sided with Rothy's, finding that it was “clear” that the lines indicated a knitted fabric (rather than any alternative textures as contended by Giesswein), this required a very close review of the images filed with the RCD (including zooming in on the high resolution images maintained by the EUIPO on its website).

In reaching its conclusion, the court observed that (amongst other things) the



### This case serves as a reminder of the importance of registering designs



lines are not consistently applied across the design. For example, at the heel of the shoes, the lines radiate in a circular fashion following the counterline and this was also true when viewing the shoe from the front where the lines radiate out from the toe. These patterns were inconsistent with a woven fabric or unprinted animal hide such as nubuck or suede, which would not radiate as shown at the heel of the RCD.

The second issue concerned the meaning of the two parallel lines running around the topline of the shoe (where the foot enters the shoe). Rothy's claimed that this indicates "a small contrasting collar which runs around the perimeter of the topline" (the contrast was not said to be one of colour) whilst Giesswein argued that these lines show "a narrow uniform binding around the whole topline" and that this is "a distinct part of the upper (not just a continuation of it to an edge)".

Again, the court sided with Rothy's, concluding that these lines indicate the contrasting edge created in the knitting of the shoes (such as in the neckline of a crew-neck knitted woollen sweater).

#### Infringement - comparing the RCD and UCD with the Pointy Flat

Having resolved the issues concerning the interpretation of the RCD, the court turned to the question of infringement, comparing the RCD and UCD against the accused item (that is, the Pointy Flat). Whilst the court found that there were

undoubtedly differences between Rothy's RCD and UCD and Giesswein's Pointy Flat, it concluded that the Pointy Flat did not ultimately create a different overall impression bearing in mind that:

- it was common ground that there were no relevant constraints on design freedom; and
- most importantly, what would strike the informed user the most in this case is that Rothy's RCD and UCD and Giesswein's Pointy Flat have uppers knitted from a heavy thread which was a departure for ballerina shoes.

The court therefore found that the Pointy Flat had infringed the RCD.

Turning to the UCD, the court went on to consider whether Giesswein had copied the UCD when designing the Pointy Flat (copying being one of the elements that must be established in order for there to be infringement of an UCD). If copying could be established then Rothy's UCD would have been infringed.

Giesswein acknowledged that it took inspiration from The Flat, The Point and The Loafer (another shoe launched at the same time as the Pointed Loafer) throughout the process of designing the Pointy Flat but that it had never come across the Pointed Loafer (which Giesswein conceded was a limited edition product that had been shown on

its website for a short period of time only).

In fact, no image or reference to the Pointed Loafer was present in any of the disclosed documents and there was no evidence that the individuals responsible for the design of the Pointy Flat had seen, been aware of, or copied the Pointed Loafer when designing the Pointy Flat.

The court therefore ruled that the Pointy Flat had not been copied from the Pointed Loafer so Rothy's case for infringement of the UCD failed.

Author:  
**Alban Radivojevic**



#### In short

In handing down its decision, the IPEC made important observations regarding the use of expert evidence and, in particular, the importance of avoiding having experts comment on matters that are for the court to decide, such as infringement and validity.

The case also serves as a useful reminder of the importance of (1) registering one's designs and not solely relying on unregistered rights, which require proof of copying which can be difficult to establish in practice and (2) the central role played by the images used when registering one's design. Right holders are therefore always advised to register their design and seek legal advice if they intend to file the design applications themselves.

# Are all book titles equal?

## Animal Farm and EUIPO doublespeak

➤ **Case details at a glance**  
*Jurisdiction: European Union*  
*Decision level: Board of Appeal*  
*Parties: The Estate of the Late Sonia Brownell Orwell*  
*Date: 29 June 2020*  
*Citation: R 1719/2019-5*

**C**ase R 1719/2019-5 concerning an attempt to register ANIMAL FARM at the EUIPO points out inconsistencies in the EUIPO's decisions regarding the registrability of titles of famous literary works as trade marks.

### The contested decision

The Estate of the Late Sonia Brownell Orwell, George Orwell's second wife and a fierce protector of his literary legacy, sought to register the mark ANIMAL FARM for various goods and services in classes 9, 16, 28 and 41, including movies, books, toys, entertainment, cultural activities and educational services.

Initially, the examiner at the EUIPO partially refused the application pursuant to Articles 7(1)(b), 7(1)(c) and 7(2) of the EU Trade Mark Regulation, arguing that the mark refers to the title of a renowned artistic work and would be perceived by the public as such. Consequently, the mark would not serve as an indication of the commercial origin of the goods and services at issue.

The applicant appealed, seeking an annulment of the contested decision and pointing to the Anne Frank decision (case R 2401/2014-4, *Le Journal d'Anne Frank*). In that case, the trade mark had proceeded to registration; the applicant argued that it was analogous to the ANIMAL FARM mark since it also referred to a well-known literary work.

### The EUIPO's track record

The Board of Appeal noted that the EUIPO has issued several diverging decisions regarding the registrability of book titles and names of characters of artistic works, particularly in relation to the above-mentioned goods and services in classes 9, 16, 28 and 41. The Board of Appeal discussed how in some of those cases a title could be seen as an indicator of source, whereas in others it could render a mark descriptive and non-distinctive. The following cases were listed to highlight the issue:

- **The Jungle Book** (R 118/2014-1) and **Pinocchio** (R 1856/2013-2): the EUIPO

### Should the EUIPO's guidelines be more specific regarding the registrability of book titles?



ruled that trade marks which consist solely of titles of books that have undergone many film and theatre adaptations reaching large audiences are usually not distinctive, particularly in the context of goods and services which could have that story as their subject matter.

- **Frühlingsfest der Volksmusik** (R 670/2005-1): a title of an event without further distinctive elements was considered devoid of distinctive character.
- **Winnetou** (R 1297/2016-2): the sign was descriptive and non-distinctive because, apart from signifying a famous invented figure, it acquired an additional abstract meaning as a reference to an honourable Native American.
- **Le Journal d'Anne Frank**: although the story of Anne Frank is widely known and popular among the public, it was not considered descriptive of goods and services in classes 9, 16 and 41. The mark identified the producer of the goods and services, and the Board of Appeal stated that the repute of a title does not in itself constitute a barrier to registrability.
- **Der Kleine Hey** (R 881/2014-5): the EUIPO ruled that the title of a book does not *prima facie* inform of the subject matter of a publication except if it has developed in the understanding of the public into a general indication in addition to being the title of a book.

The Board of Appeal referred the ANIMAL

FARM case along with the applicant's related 1984 trade mark application (R 1922/2019-5) to the Grand Board of Appeal, stating that the EUIPO's guidelines ought to be more specific in connection with the registrability of book titles. On the one hand, a title might be indicative of content; on the other, the application of Article 7(1)(b) may depend on whether the title in question has "entered into the language".

The interim decision makes no attempt to reconcile the differences between the above cases nor does it mention additional factors included in the EUIPO's guidelines, such as the passage of time and cultural heritage considerations (such as inclusion in school curricula or widely disseminated dictionaries), which can create an independent thematic significance for well-known titles, thus hindering their registration prospects.

### Comment

Hopefully, the Grand Board of Appeal will provide rights holders and practitioners with much needed clarification. The outcome is an important one, with a potentially disruptive effect for the publishing industry. To that end, it would be helpful for an outright barrier to trade mark protection for titles of famous works to be definitively ruled out and for the Grand Board of Appeal to set out a more detailed list of parameters to be adopted for cases relating to high profile literary works.

**Author:**  
**Agnieszka Stephenson**





# MULTIBUS overtakes VW's MULTIVAN

## Appointed person rejects likely confusion

**T**his case is the first decision from the appointed person in 2021 and resulted in a rare success for an appellant.

The applicant, Mr O'Halloran from Lincoln, filing his first trade mark application was seeking to register MULTIBUS for vehicles in class 12. His application was opposed by Volkswagen based on an international registration designating the EU for MULTIVAN.

Before the UKIPO Volkswagen was successful:

- The hearing officer found that MULTIVAN was distinctive to an average degree.
- The hearing officer also concluded that there would be indirect confusion because consumers would see MULTIBUS as a sub brand of MULTIVAN.
- Finally, the hearing officer found that consumers would take great care and be very attentive when buying such goods.

All this was notwithstanding the fact that Volkswagen had not used its mark in the United Kingdom. Nor did Volkswagen own a family of MULTI- prefixed marks in use.

Having found in favour of Volkswagen Mr O'Halloran appealed the decision to the appointed person.

The appointed person disagreed with the analysis by the hearing officer. He said:

“Whilst MULTIVAN is an invented word, the highly descriptive nature of its component parts... put it at the lowest end of the spectrum of distinctiveness within which valid trade marks may exist.”

The appointed person also concluded that with an attentive consumer “it would be

fully for a consumer to conclude...that the marks indicate a common trade origin”.

Perhaps the most interesting point about this short decision is what is not mentioned. There is no specific reference to the grounds of appeal by Mr O'Halloran. Whilst Volkswagen was not represented at the appointed person hearing, from the decision, it appears that the appointed person may well have taken the decision himself that the hearing officer was wrong and the decision should be overturned (leaving aside whether there were any valid grounds for appeal).

The appointed person concluded his decision by saying:

“The decision was well outside the bounds of what a reasonable tribunal acting reasonably could have decided on the facts of this case.”

Whilst MULTIVAN may be well known in many countries in Europe the lack of its use in the UK probably went some way towards Volkswagen's failure to persuade the tribunal that the marks were sufficiently close that confusion would arise.

**Author:**

**Jeremy Pennant**



### In short

This case once again illustrates that marks with a below average level of distinctiveness will not be afforded broad rights over and beyond the mark as registered.

VW opposed Mr O'Halloran's MULTIBUS application based on its MULTIVAN registration



# D YOUNG & CO INTELLECTUAL PROPERTY

And finally...

*D Young & Co news*

## “The UK trademark elite” Gold ranking for WTR 1000



**W**TR 1000 has again ranked D Young & Co as a top tier (gold) firm for UK trade mark attorney services, commenting that “Whatever way you measure it, it’s clear that D Young [ & Co] ranks among the UK trademark elite. It has eight practitioners featured in the WTR 1000 this year; a glittering roster of blue-chip clients; and all the legal and technical know-how needed for effective one-stop shopping”.

WTR clarifies that “firms and individuals in the gold band are those that attract the most positive comments from sources. We have identified them as the crème de la crème; their success often hinges on reputations established over lengthy periods of time, something which enables them to secure the most high-profile, big-ticket work from the most prestigious of clients.” In addition to the team’s top-tier ranking, all individual partners in the team also

feature as “recommended experts” in the 2021 survey. Notably, Partners Jeremy Pennant and Tamsin Holman are highlighted as “gold” experts for trade mark enforcement and litigation services and Jeremy Pennant and Matthew Dick are reported to be “gold” experts for trade mark prosecution and strategy work.

More details can be found on our website report at <http://dycip.com/wtr2021>.

We are also delighted to report that D Young & Co has been shortlisted for two UK trade mark awards in the Managing IP Global Awards 2021. We are shortlisted for the trade mark contentious and trademark prosecution (patent and trade mark attorney firms) awards. Now in their 16th year the awards recognise the top IP practitioners, firms and in-house counsel from around the world. Winners will be announced at an online awards ceremony on 30 March 2021.

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