



**DECISION
of the Second Board of Appeal
of 25 February 2015**

In Case R 1856/2013-2

Yves Fostier

22, Avenue Notre Dame de Bon Voyage
FR-06190 Roquebrune-Cap-Martin
France

Cancellation Applicant / Appellant

represented by Dott. Prof. Franco Cicogna & C.SRL, Via Visconti di Modrone, 14/A,
IT-20122 Milan, Italy

v

Disney Enterprises, Inc.

500 South Buena Vista Street
Burbank, California 91521
United States of America

CTM Proprietor / Respondent

represented by Mitscherlich, Patent- und Rechtsanwälte, PartmbB, Sonnenstraße 33,
DE-80331 Munich, Germany

APPEAL relating to Cancellation Proceedings No 6 358 C (Community trade mark
registration No 5 239 223)

THE SECOND BOARD OF APPEAL

composed of T. de las Heras (Chairperson and Rapporteur), C. Govers (Member) and
H. Salmi (Member)

Registrar: H. Dijkema

gives the following

Decision

Summary of the facts

- 1 By an application filed on 3 August 2006, Disney Enterprises, Inc. ('the CTM proprietor') sought to register the word mark

PINOCCHIO

for the following list of goods and services (after an amendment confirmed by the Office on 11 October 2006):

Class 3 – Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices; after-shave lotions; antiperspirants; aromatherapy oils; artificial eyelashes and fingernails; baby oil; baby wipes; bath gels; bath powder; beauty masks; blush; body creams, lotions, and powders; breath freshener; bubble bath; cologne; deodorants; dusting powder; essential oils for personal use; eye liner; eye shadows; eyebrow pencils; face powder; facial creams; facial lotion; facial masks; facial scrubs; fragrance emitting wicks for room fragrance; fragrances for personal use; hair gel; hair conditioners; hair shampoo; hair mousse; hair creams; hair spray; hand cream; hand lotions; hand soaps; lip balm; lipstick; lipstick holders; lip gloss; liquid soaps; makeup; mascara; mouthwash; nail care preparations; nail glitter; nail hardeners; nail polish; perfume; potpourri; room fragrances; shaving cream; skin soap; talcum powders; toilet water; skin creams; skin moisturizer; sun block; sun screen; decorative glitter;

Class 9 – Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus; computer hardware and computer software, peripherals; operating and user instructions stored in digital form for computers and computer software, in particular on floppy disks or CD-ROM; eyeglasses and sunglasses; protective helmets; swimming jackets, life jackets; cinematographic films, exposed films; audio cassette recorders; audio cassette players; audio cassettes; audio discs; audio Speakers; binoculars; calculators; camcorders; cameras; CD-ROMs; CD-ROM drives (as part of the computer); CD-ROM writers (as part of the computer); cellular telephones; cellular telephone accessories; cellular telephone cases; face plates for cellular telephones; compact disc players; compact disc recorders; compact discs; computer game programs; computer game cartridges and discs; computer keyboards; computer monitors; computer mouse; computer disc drives; cordless telephones; decorative magnets; digital cameras; DVDs; DVD players; DVD recorders; digital versatile discs; digital video discs; electronic personal organizers; eyeglass cases; headphones; karaoke machines; microphones; MP3 players; modems (as part of a computer); mouse pads; motion picture films; pagers; personal Stereos; personal digital assistants; printers; radios; telephones; television sets; video cameras; video cassette recorders; video cassette players; video game cartridges; video game discs; video cassettes; videophones; walkie-talkies; wrist and arm rests for use with computers;

Class 14 – Precious metals and their alloys and goods in precious metals or coated therewith (included in Class 14); jewellery, precious stones; horological and chronometric instruments; alarm clocks; belt buckles of precious metal (for clothing); bolo ties with precious metal tips; bracelets; busts of precious metal; candle snuffers of precious metal; candlesticks of precious metal; charms; clocks; earrings; jewellery cases of precious metal; jewellery chains; key rings of precious metal; lapel pins; letter openers of precious metal; neck chains; necklaces; necktie fasteners; non-monetary coins; ornamental pins; pendants; rings; slides for bolo ties; stop watches; tie clips; tie fasteners; tie tacks; wall clocks; watch bands; watch cases; watch chains; watch straps; watches; wedding bands; wristwatches;

Class 16 – Paper, cardboard and goods made from these materials (included in Class 16); printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (included in class 16); printers' type; printing blocks; address books; almanacs; appliquéés in the form of decals; appointment books; art prints; arts and craft paint kits; autograph books; baby books; ball point pens; baseball cards; binders; bookends; bookmarks; books; bumper stickers; calendars; cartoon strips; Christmas cards; chalk; children's activity books; coasters made of paper; coin albums; colouring books; colour pencils; comic books; comic strips; coupon books; decals; decorative paper centre-pieces; diaries; disposable diapers for babies; drawing rulers; envelopes; erasers; felt pens; flash cards; gift cards; gift wrapping paper; globes; greeting cards; guest books; magazines; maps; memo pads; modelling clay; newsletters; newspapers; note paper; notebooks; notebook paper; paintings; paper flags; paper party favours; paper cake decorations; paper party decorations; paper napkins; paper party bags; paperweights; paper gift wrap bows; paper pennants; paper place mats; paper table cloths; pen or pencil holders; pencils; pencil sharpeners; pen and pencil cases and boxes; pens; periodicals; photograph albums; photo-engravings; pictorial prints; picture books; portraits; postcards; posters; printed awards; printed certificates; printed invitations; printed menus; recipe books; rubber stamps; score cards; stamp albums; staplers; stickers; trading cards; ungraduated rulers; writing paper; writing implements;

Class 18 – Leather and imitations of leather and goods made of these materials (included in Class 18); animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery; all-purpose sport bags; athletic bags; baby backpacks; backpacks; beach bags; book bags; calling card cases; change purses; coin purses; diaper bags; duffel bags; fanny packs; gym bags; handbags; knapsacks; key cases; leather key chains; lipstick holders; luggage; luggage tags; overnight bags; purses; satchels; shopping bags; tote bags; waist packs; wallets;

Class 20 – Furniture, mirrors, picture frames; goods (included in Class 20) of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics; air mattresses for use when camping; bassinets; beds; benches; bookcases; cabinets; chairs; coat racks; computer furniture; computer keyboard trays; cots; couches; decorative mobiles; desks; drinking straws; engraved and cut stone plaques; figurines and statuettes made of bone, plaster, plastic, wax, or wood; flagpoles; foot stools; gift package decorations made of plastic; hand fans; hand-held mirrors; jewellery boxes not of metal; key fobs not of metal; lawn furniture; love seats; magazine racks; mattresses; non-Christmas ornaments made of bone, plaster, plastic, wax or wood; ottomans; party ornaments of plastic; pedestals; pillows; plant stands made of wire and metal; decorative wall plaques; plastic flags; plastic name badges; plastic novelty license plates; plastic pennants; plastic cake decorations; sea shells; sleeping bags; tables; toy chests; umbrella stands; venetian blinds; wind chimes;

Class 21 – Household or kitchen utensils and containers (not of precious metal or coated therewith); combs and sponges; brushes (except paint brushes); brush-making materials; articles for cleaning purposes; steelwool; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware (included in Class 21); beverage ware; beverage glassware; bird houses; bowls; brooms; cake pans; cake moulds; cake servers; candle holders not of precious metal; candle snuffers; canteens; ceramic figurines; coasters not of paper and not being table linen; cookie jars; cookie cutters; cork screws; cups; decorating bags for confectioners; decorative crystal prisms; decorative glass; decorative plates; dishes; figurines made of china, crystal, earthenware, glass, or porcelain; flowerpots; hair brushes; heat-insulated vessels; insulating sleeve holders for beverage containers; lunch boxes; mugs; napkin holders; napkin rings not of precious metals; paper cups; paper plates; pie pans; pie servers; plastic cups; plates; soap dishes; tea kettles; tea sets; thermal insulated containers for food or beverage; toothbrushes; trays; trivets; vacuum bottles; waste baskets;

Class 24 – Textiles and textile goods (included in Class 24); bed and table covers; afghans; barbecue mitts; bath linen; bath towels; bed blankets; bed canopies; bed linen; bed sheets; bed skirts; bed spreads; blanket throws; calico; children's blankets; cloth coasters; cloth doilies; cloth flags; cloth pennants; comforters; crib bumpers; curtains; fabric flags; felt pennants; golf towels; hand towels; handkerchiefs; hooded towels; household linen; kitchen towels; oven mitts; pillow cases; pillow covers; pot holders; quilts; receiving blankets; silk blankets; table linen; textile napkins; textile place mats; textile tablecloths; throws; towels; washcloths; woollen blankets;

Class 25 – Clothing, footwear, headgear; belts; athletic shoes; bandanas; baseball caps; beach cover-ups; beachwear; bibs; bikinis; blazers; boots; bow ties; bras; caps; chaps; cloth bibs; coats; dresses; ear muffs; gloves; golf shirts; Halloween costumes; hats; head bands; hosiery; infant-wear; jackets; jeans; jerseys; kerchiefs; leotards; leg warmers; mittens; neckties; night shirts; night gowns; pyjamas; pants; panty hose; polo shirts; ponchos; rainwear; robes; sandals; scarves; shirts; shoes; skirts; shorts; slacks; slippers; sleepwear; socks; stockings; sweaters; sweat pants; sweat shirts; swimsuits; tank tops; tights; t-shirts; underwear; vests; wrist bands;

Class 28 – Games and playthings; gymnastic and sporting articles (included in Class 28); decorations for Christmas trees (except illumination articles and confectionery); playing cards; action skill games; action figures and accessories therefore; board games; card games; children's multiple activity toys; badminton sets; balloons; basketballs; bath toys; baseballs; beach balls; bean bags; bean bag dolls; board games; building blocks; bowling balls; bubble making wands and solution sets; chess sets; children's play cosmetics; Christmas stockings; collectable toy figures; crib mobiles; crib toys; disc toss toys; dolls; doll clothing; doll accessories; doll playsets; electric action toys; equipment sold as a unit for playing card games; fishing tackle; golf balls; golf gloves; golf ball markers; hand held unit for playing electronic games; hockey pucks; inflatable toys; jigsaw puzzles; jump ropes; kites; magic tricks; marbles; manipulative games; mechanical toys; music box toys; musical toys; parlour games; party favours in the nature of small toys; party games; plush toys; puppets; roller skates; rubber balls; skateboards; soccer balls; spinning tops; squeeze toys; stuffed toys; table tennis tables; target games; teddy bears; tennis balls; toy action figures; toy bucket and shovel sets; toy mobiles; toy vehicles; toy scooters; toy cars; toy model hobby craft kits; toy figures; toy banks; toy trucks; toy watches; wind-up toys; yo-yos; paper party hats;

Class 30 – Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals; bread; pastry and confectionery, chocolate and chocolate articles, ices; honey, treacle; yeast, baking powder; salt, mustard; vinegar, sauces (condiments); spices; ice; bagels; bases for making milkshakes; biscuits; breakfast cereal; bubble gum; cakes; cake mixes; candies; cake decorations made of candy; ketchup; cereal-based snack bars; chewing gum; chocolate-based beverages; cocoa-based beverages; cones for ice cream; cookies; corn-based snack foods; crackers; deli sandwiches; flavoured, sweetened gelatin desserts; frozen confections; frozen meals consisting primarily of pasta or rice; frozen yogurt; ice milk; liquorice; marshmallows; mayonnaise; muffins; noodles; oatmeal; pancakes; pancake mixes; pasta; pastries; pancake syrup; pies; pizza; popcorn; pretzels; puddings; rolls; salad dressings; sherbets; tea; tortillas; waffles;

Class 41 – Education and entertainment services; providing of training; sporting and cultural activities; production, presentation, distribution, and rental of motion picture films; production, presentation, distribution, and rental of television and radio programs; production, presentation, distribution (publication), and rental of sound and video recordings; entertainment information; production of entertainment shows and interactive programs for distribution via television, cable, satellite, audio and video media, cartridges, laser discs, computer discs and electronic means; production and provision of entertainment, news, and entertainment information via communication and computer networks; amusement park and theme park services; educational and entertainment services rendered in or relating to theme parks; live stage shows; presentation of live performances; theatre productions; entertainer services.

- 2 The application was published in the Community Trade Marks Bulletin No 4/2007 of 29 January 2007 and the mark was registered on 8 January 2009.

- 3 On 6 March 2012, Yves Fostier ('the cancellation applicant') filed a request for a declaration of invalidity on the basis of absolute grounds pursuant to Article 52(1)(a) CTMR, namely that the CTM was registered in breach of Article 7(1)(b) CTMR.
- 4 The cancellation applicant's arguments in support of his application were, in essence, the following:
 - Trade marks which have become popularised or which have fallen into the public domain lack distinctive character (see Article 26 of the Industrial Property Code of Italy). Furthermore, the insertion of a word in dictionaries creates a sort of presumption of generality.
 - The term 'PINOCCHIO' is the name of the famous wooden puppet created by the Tuscan writer Carlo Collodi in a story that was published for the first time in 1883 in a children's comic. The puppet was very successful and has frequently featured in productions of different kinds based on the original story.
 - The cancellation applicant also draws attention to the first cinematographic version of this story, called 'The Adventures of Pinocchio', as well as to the book 'I, Comencini's Pinocchio' published by Sassoscritto Editore in 2008. In the latter, a so-called Aquatic Pinocchio was created, ownership rights to which were assigned by Oscar Tirelli, the artist who created it, to the cancellation applicant.
 - On the basis of the legitimately acquired rights, as shown above, the cancellation applicant filed CTM application No 9 740 457. In this respect, the cancellation applicant stresses that, although he is the owner of the abovementioned Community trade mark application, he does not seek to have a monopoly on the word 'PINOCCHIO', as this Community trade mark also contains an image. However, the CTM proprietor, being the owner of the CTM, which is a word trade mark, does have a monopoly on the word 'PINOCCHIO'. In the cancellation applicant's view, such a monopoly damages the interests of justice, the free market and the sacred popular traditions as world values.
 - The Berne Convention for the Protection of Literary and Artistic Works of 9 September 1886 provides that folklore is a right which has to be protected, a position also supported by WIPO and UNESCO. Popular literature represents a fundamental component of folklore. As seen in WIPO guidelines, traditions, customs, stories and legends which are no longer covered by author's rights and fall into public use cannot be the object of monopolies. In this regard, the decision of the Intellectual Property Office of the United Kingdom, of 24 March 1999, regarding trade mark No 1 589 463, should also be mentioned where it was stated that, for example, 'SHERLOCK HOLMES' is a name that has been used by many traders over the years in order to describe a story and a character. As no one these days would expect all material bearing this name to originate from Conan Doyle or his estate the name is devoid of any distinctive character and is descriptive for books, films, etc. Additionally, it is noted by the cancellation applicant that the word 'PINOCCHIO', representing a child

who was punished for his lies, as well as an expression ‘your nose has grown just like Pinocchio’, is used in Italy to indicate someone who is lying.

- The cancellation applicant stresses that the decisions of the German Federal Court of Justice presented by the CTM proprietor regarding the trade mark and copyright protection have no binding effect on the OHIM.
- According to the cancellation applicant, the CTM, therefore, should be declared invalid and, in support of these arguments, he filed the following documents:
 - Printout from the website www.wuz.it, dated 20 January 2012; printout from the website www.letteraturadimenticata.it, undated; printout from the website www.cgi.ebay.it, undated; printout from the website www.bergogliolibri.it, undated – all containing information about the story of ‘PINOCCHIO’;
 - Printout from the book ‘Io, il Pinocchio di Comencini’, undated;
 - Printout, containing information about Oscar Tirelli, an artist from Rome;
 - The assignment agreement regarding the ownership rights to the so-called Aquatic Pinocchio, dated 29 January 2011.

5 In its defence the CTM proprietor has, in essence, submitted the following:

- The cancellation applicant has overlooked the difference between a title for an artistic work on one hand and a trade mark on the other hand. The difference has been emphasised in a judgment of 30.06.2009, T-435/05, Dr. No, EU:T:2009:226, § 24, which stated that the existence of a title for an artistic work cannot prevent the use of this title (sign) as a trade mark as well.
- Section 5 of the German Trade Mark Act explicitly acknowledges the protectability of titles for artistic works (in contrast to trade marks as an indicator of trade origin). Therefore, German law exemplifies very well the relationship of trade marks as an indicator of trade origin, on one hand, and titles for an artistic work, on the other hand, in the European Union.
- It is especially emphasised in the jurisdiction of the German Federal Supreme Court that the title of an artistic work, in general, only indicates the content of an (artistic) work, but not its commercial origin. Accordingly, the use of a sign as a title for an artistic work generally does not violate third parties’ rights, since the title only specifies the content of an artistic work, but not its commercial origin. Furthermore, in the present case, according to the jurisdiction of the German Federal Supreme Court, anybody is allowed to reprint the content of the book ‘Le avventure di Pinocchio’ written by C. Collodi, and use its title, as it is no longer subject to copyright, i.e. it is in the public domain.
- The CTM proprietor states that the CTM is not devoid of any distinctive character and is not descriptive, i.e. it does not consist exclusively of a sign or

indication which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or time of production of the goods or of rendering of the service, or other characteristics of the goods or services.

- The CTM proprietor requests that the invalidity action be rejected. In support of these arguments, the CTM proprietor filed the following documents:
 - Decision of the German Federal Supreme court of 29 April 1999, I ZR 152/96, ‘SZENE’;
 - Decision of the German Federal Supreme court of 26 May 1994, I ZR 33/92, ‘Wir im Südwesten’;
 - Decision of the German Federal Supreme court of 7 December 1979, I ZR 157/77, ‘MonumentaGermaniae Historica’;
 - Decision of the German Federal Supreme court of 24 November 2011, I ZR 175/09, ‘Medusa’.
- 6 By decision of 22 July 2013 (‘the contested decision’), the Cancellation Division rejected the request for a declaration of invalidity and ordered the cancellation applicant to bear the costs. The reasons underlying this result were, in essence, the following:
- Due consideration was given to the documents related to the story of ‘PINOCCHIO’ submitted by the cancellation applicant. However, the sole fact that the sign indicates a story protected by copyright does not exclude the possibility of the same sign to function as an indicator of commercial origin by trade mark law. It is, therefore, a matter of 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 and 30.06.2009, T-435/05, Dr. No, EU:T:2009:226, § 26).
 - In the present case, there is no data, information or evidence provided by the cancellation applicant that could lead to a conclusion that the CTM does not function as an indicator of commercial origin in relation to the goods and services in question. Furthermore, it is noted by the Cancellation Division that the CTM is considered to be distinctive even in relation to ‘printed matter’, ‘recorded data storage equipment’ or ‘toys and playthings’, as well as ‘entertainment services’ applied for, when it could identify the content of these products and services, because the content in this case would be identified with a distinctive term, i.e. ‘PINOCCHIO’ (see ‘OHIM Manual on Current Trade Mark Practice’, Part B: Examination, Section 4: Absolute Grounds for Refusal and Community Collective Marks, paragraph 1.3).
 - There is no information provided by the cancellation applicant to show that the term ‘PINOCCHIO’ has become customary in any language of the European Union and, therefore, that it is incapable of distinguishing the goods and

services for which registration is sought within the meaning of Article 7(1)(b) CTMR.

- Moreover, it may be true that the inclusion of a word in dictionaries creates a sort of presumption of generality, as noted by the cancellation applicant. However, in this case, no relevant evidence has been provided by the cancellation applicant to confirm that the CTM was included in any dictionary of any language spoken in the European Union at the time of the application for the CTM.
 - It should be noted that the fact that the cancellation applicant is the owner of Community trade mark application No 9 740 457 and, in particular, the details related to the assignment of the ownership rights by Oscar Tirelli to the cancellation applicant have no relevant bearing on the assessment of the CTM under Article 7(1)(b) CTMR.
- 7 On 20 September 2013 the cancellation applicant filed a notice of appeal against the contested decision. The statement of grounds followed on 19 November 2013.
 - 8 On 20 November 2013, the Office requested the cancellation applicant to supply a translation of the statements of grounds in the correct language of the proceedings i.e. English, since the cancellation applicant had submitted those documents in Italian.
 - 9 On 18 December 2013, the cancellation applicant submitted the translation of the abovementioned statement of grounds.
 - 10 The CTM proprietor filed its observations on 26 May 2014.

Submissions and arguments of the parties

- 11 The cancellation applicant requests that the contested decision be set aside and that the Community trade mark be cancelled. The cancellation applicant's reasoning may be summarised as follows:
 - The cancellation applicant claims that popular traditions cannot be monopolised, he refers to evidence already provided during the cancellation proceedings such as jurisprudential references from several Member States of the European Union, as well as the *vademecum* reference of intellectual property given by international treaties on the subject and WIPO guidelines.
 - It is surprising that the Office, which remarks that it is not bound by national jurisprudence, then follows the direction of a single court, the German court, whose decision is cited by the CTM proprietor.
 - The cancellation applicant fails to understand why the decisions of the Italian and English courts have no value, and instead the Office adheres to a German court case, a third party country with respect to both parties. It would have been more logical to cite an Italian or French court case given the cancellation applicant's nationality.

- The cancellation applicant points out that for the Office only German legislation exists when referring to using the title of a story as a trade mark, ignoring what is provided in the same sense in the legislation of Italy or other countries of the European Union.
 - The fact that a title of a story can be used as a trade mark does not stand when the title is also the name of a very famous personality in Italian tradition.
 - The CTM proprietor could have proved use of its trade mark on goods which did not concern either toys, amusement parks or entertainment games for which the trade mark is directly descriptive and not able to be monopolised. However, it has not done this.
 - Descriptiveness exists with regards to Classes 16, 28 and 41 as, naturally, the puppet calls to mind toys, books and children's entertainment.
 - The CTM proprietor claims an absolute monopoly that it cannot have. The Fondazione Nazionale Carlo Collodi is the legitimate heir to the world of Pinocchio, which continued and promoted children's literature from Pinocchio's inventor, from whom Disney took inspiration for the successive children's film (see Doc.1).
 - The Office needs to take into consideration all the legal interests deriving from the evaluation of whether a trade mark can be registered and not only the financial aspect of the person who sponsors it.
 - In case the Office considers this action groundless, the cancellation applicant claims coherence with its deliberation in opposition No B 1 870 354 filed by the CTM proprietor against the cancellation applicant's CTM No 9 740 457 limiting itself to evaluate the noted similarity.
- 12 In its reply the CTM proprietor requests that the Board dismiss the appeal and confirm the Cancellation Division's decision, imposing the costs of the proceedings on the cancellation applicant. The CTM proprietor refers to its submissions during the cancellation proceedings and adds the following:
- The cancellation applicant mixes up the difference between titles of artistic works and trade marks. The differences of a title for an artistic work on the one hand and a trade mark on the other hand, has been emphasized in a decision of the General Court in the case 30.06.2009, T-435/05, Dr. No, EU:T:2009:226. 'Dr. No' is the title of the first film in the 'James Bond' series and also the name of one of the main characters in the film. 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.
 - German Law (sections 5 and 15 of the German Trademark Act) exemplifies the relationship of trade marks as an indicator of trade origin on the one hand and titles for an artistic work on the other hand in the European Union, although it is acknowledged that the Office is not bound by national registration/jurisdiction.

- Since German law acknowledges the protection of titles for artistic works, German jurisdiction on several occasions has been concerned with the specifics and differences between titles, on the one hand, and trade marks on the other hand. The German Federal Supreme Court has emphasised that the title of an artistic work in general only individualises the content of an artistic work, but not its commercial origin. As such, under German law, a title is generally only protected against a likelihood of confusion regarding the signs used as a title as well, and not signs used as trade marks (e.g. General Federal Supreme Court in case I ZR 181/02- *Das Telefon Sparbuch*, or case I ZR 152/96, ‘SZENE’, enclosed as Exhibit 1 during the cancellation proceedings, among others).
- According to the jurisdiction of the German Federal Supreme Court, the use of a sign as a title for an artistic work generally does not violate third parties’ trade marks, since the title only individualizes the content of the work (see case I ZR 33/92, ‘*Wir im Südwesten*’ enclosed as Exhibit 2 during the cancellation proceedings).
- The ‘*Jungle Book*’ written by Rudyard Kipling is no longer subject to copyrights, as it is in the public domain. Therefore, anyone is allowed to reprint the content of this work and can use the title of the book to identify this publication (see Exhibits 3 and 4 enclosed during the cancellation proceedings, which refers to the case I ZR 157/77, ‘*Monumenta Historica*’ and case I ZR 175/09, ‘*Medusa*’, respectively).
- It is evident that the CTM application ‘PINOCCHIO’ at issue shows distinctiveness and is also non-descriptive regarding the goods and services applied for. The trade mark ‘PINOCCHIO’ is fanciful with no direct and immediate connection regarding the registered goods and services.

Reasons

- 13 The appeal complies with Articles 58, 59 and 60 CTMR and Rule 48 CTMIR as amended. It is, therefore, admissible.
- 14 Article 52 CTMR, under the heading ‘Absolute Grounds for Invalidity’, states, in relevant part, the following:
 - ‘1. A Community trade mark shall be declared invalid on application to the Office or on the basis of a counterclaim in infringement proceedings: (a) where the Community trade mark has been registered contrary to the provisions of Article 7;
 2. Where the Community trade mark has been registered in breach of the provisions of Article 7(1)(b), (c) or (d), it may nevertheless not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which is registered.’
- 15 The signs devoid of any distinctive character referred to in Article 7(1)(b) CTMR are incapable of performing the essential function of a trade mark, namely that of

identifying the commercial origin of the goods or services, thus enabling the consumer who purchased 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.

- 16 It must also be borne in mind that the distinctive character of a mark must be assessed in relation to the goods or services in respect of which registration is applied for (or, as it is the case here, in respect of which the invalidity request is directed) and in the light of the presumed perception of an average consumer of the category of goods or services in question, who is reasonably well informed and reasonably observant and circumspect (26.11.2008, T-435/07, *New Look*, EU:T:2008:534, § 17).
- 17 The Court of Justice has held that, although the criteria for assessing distinctiveness are the same for the various categories of marks, it may become apparent, in applying those criteria, that the relevant public's perception is not necessarily the same for each of those categories and that, therefore, it may prove more difficult to establish distinctiveness for some categories of mark than for others (29.04.2004, C-456/01 P & C-457/01 P, *Tabs*, EU:C:2004:258, § 38).
- 18 Moreover, it is also settled case-law that the way in which the relevant public, perceives a trade mark is influenced by that person's level of attention, which is likely to vary according to the category of goods or services in question (05.03.2003, T-194/01, *Soap device*, EU:T:2003:53, § 42 and 03.12.2003, T-305/02, *Bottle*, EU:T:2003:328, § 34).
- 19 In that regard, it must be stated, firstly, that the goods and services referred to, which fall within Classes 3, 9, 14, 16, 18, 20, 21, 24, 25, 28, 30 and 41 may all indeed be targeted at the general public in the whole European Union.
- 20 Furthermore, it is apparent from the case-law that the Office may of its own motion take into consideration facts which are well known, that is, which are likely to be known by anyone or which may be learned from generally accessible sources (22.06.2004, T-185/02, *Picaro*, EU:T:2004:189, § 29 to 32).
- 21 Under Article 76(1) of Regulation No 207/2009, when considering absolute grounds for refusal, OHIM examiners and, on appeal, the Boards of Appeal of OHIM are required to examine the facts of their own motion in order to determine whether the mark registration of which is sought comes within one of the grounds for refusal of registration laid down in Article 7 of that Regulation.
- 22 It follows that the competent bodies of OHIM may be led to base their decisions on facts which have not been put forward by the cancellation applicant for the mark. OHIM is required to examine of its own motion the relevant facts which may lead it to apply an absolute ground for refusal (15.05.2014, C-97/12P, *Clasp lock*, EU:C:2014:324, § 71 and cited case-law therein).
- 23 It is true that in invalidity proceedings, the Boards of Appeal cannot be required to carry out afresh the examination which the examiner conducted, of his/her own motion, of the relevant facts which could have led him/her to apply the absolute grounds for refusal. It follows from the provisions of Articles 52 and 55 of

Regulation No 207/2009 that the Community trade mark is regarded as valid until it has been declared invalid by OHIM following invalidity proceedings. It, therefore, enjoys a presumption of validity, which is the logical consequence of the check carried out by OHIM in the examination of an application for registration.

- 24 It is, therefore, for the cancellation applicant for revocation or for a declaration of invalidity to adduce evidence in support of its application for revocation or for a declaration of invalidity (25.11.2014, T-450/09, Cube with surfaces having a grid structure, EU:T:2014:983, § 103 ; 13.09.2013, T-320/10, Castel, EU:T:2013:424, § 25 and §§ 27 - 28; see also Rule 37(b)(iv) of Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Regulation No 40/94 (OJ 1995 L 303, p. 1)).
- 25 Accordingly, in the present case, although it is for the cancellation applicant to produce evidence to show the alleged absence of distinctive character of the contested mark and, in particular, to demonstrate that the contested mark is not capable of distinguishing the goods and services for which registration is sought for the purposes of the relevant case-law, the Board considers that a common sense approach is necessary. While a strict absolute examination is desirable and appropriate, it should not be taken to extremes, especially considering the extremely high recognition of the mark in question.
- 26 In this respect, if a title in question is famous enough to be truly well known to the relevant public where the mark can be perceived in the context of the goods/services as primarily signifying a famous story or book title, a mark may be perceived as non-distinctive. A finding of non-distinctiveness in this regard will be more likely where it can be shown that a large number of published versions of the story have appeared and/or where there have been numerous television, theatre and film adaptations reaching a wide audience. ‘PINOCCHIO’ belongs to the category of titles described above. It is indeed a title of a story that is long established and well known as a reference to a children story about a wooden boy whose nose grows when he lies. ‘PINOCCHIO’ has been established for so long that it has ‘entered into the language’ as the cancellation applicant notes, and that it is incapable of being ascribed any meaning other than just a particular story.
- 27 Although as correctly stated by the CTM proprietor, titles or fictional character names may be trade marks and assumed to function as *prima facie* indicators of trade origin, the question however arises whether the mark as such is capable of being distinctive in relation to the goods and services in question covered by the CTM. There is nothing to say that ‘PINOCCHIO’ is not capable of being distinctive for paint, clothing or pencils. Indeed, the relationship between ‘PINOCCHIO’ and such goods is, if anything, an indirect one.
- 28 However, and in line with the Office’s practice (Part B: Examination Section 4: Absolute grounds for refusal Article 7(1)(a) till 7(1)(e) CTMR, paragraph 2.2.3 Titles of books), it is incapable of performing a distinctive role in relation to:

Class 9 – Recording discs; cinematographic films, exposed films; audio discs; CD-ROMS; compact discs; computer game programs; computer game discs; DVDs; DVD recorders; digital

versatile discs; digital video discs; motion picture films; video cassette recorders; video game discs; video cassettes;

Class 16 – Printer matter; baby books; books; cartoon strips; children’s activity books; comic books; comic strips; magazines; picture books;

Class 28 – Action figures; bath toys; collectable toy figures; crib toys; dolls; electric action toys; inflatable toys; mechanical toys; plush toys; puppets; squeeze toys; stuffed toys; toy figures;

Class 41 – Entertainment services; amusement park and themed park services; educational and entertainment services rendered in or relating to theme parks; live stage shows; presentation of live performances; theatre productions; entertainer services.

since consumers will simply think that these goods and services refer to the story of ‘PINOCCHIO’, this being the only meaning of the term concerned. The subject-matter of these goods and services is clearly the title and also the fictional character from a well-known children book.

- 29 As for the German practice claimed by the CTM proprietor, the registrability of a sign as a Community trade mark must be assessed solely on the basis of the CTMR, as interpreted by the EU judicature, and not on the basis of laws of other Member States.
- 30 As to the cited ‘Dr. No’ case of the General Court (30.06.2009, T-435/05, Dr. No, EU:T:2009:226), this case concerned an opposition which was based on earlier claimed well-known marks under Article 8(2)(c) CTMR and non-registered marks under Article 8(4) CTMR whereas in the present case a request for the invalidity of a mark in relation to Article 7 CTMR is being dealt with. Furthermore, ‘Dr. No’ is only a particular story in the James Bond series with a single film adaptation which falls short of a universally known tale.
- 31 On the other hand, the Board cannot find any reason for assuming that the contested CTM would not be memorized and would not be recognized as an indication of commercial origin for the remaining goods and services it covers. Moreover, there is no reason why the denomination contained in the sign should be left free for competitors.
- 32 As per settled case-law, the fact that a sign is made up of components which may allude to certain features of some of the registered goods and services is not sufficient to justify the application of the absolute ground for refusal laid down by Article 7(1)(b) CTMR, unless it amounts to proof that such a sign, looked at as a whole, would not enable the section of the public targeted to distinguish the applicant's goods and services from those of its competitors (27.02.2002, T-34/00, Eurocool, EU:T:2002:41, § 43).
- 33 With regard to the capability of a sign to function as a trade mark, as long as the use of the sign takes place in the context of sales to consumers, the Court of Justice has stated that it is immaterial whether, in the context of that use, the sign is perceived as a badge of support for or loyalty or affiliation to the trade mark proprietor (12.11.2002, C-206/01, Arsenal, EU:C:2002:651, §§ 50-21, 55).
- 34 The cancellation applicant has failed to show the connection between the contested mark and the remaining goods and services covered by the contested

CTM. None of the evidence filed by the cancellation applicant is related to these goods and services.

- 35 In conclusion, there is insufficient evidence to show that the term ‘PINOCCHIO’ will be understood by relevant customers as an indication of the kind of the remaining goods or services offered by the CTM proprietor and there is also nothing that suggests that it is devoid of any distinctive character for any other reason.
- 36 The cancellation applicant has not proved that the term ‘PINOCCHIO’ is generic or usual with regard to these goods and services covered by the CTM, for the purpose of identifying or distinguishing those goods and services (29.09.2010, T-200/08, ‘FOODLUBE’, EU:T:2010:414, §§ 63-64).
- 37 Furthermore, the contested mark does not give the CTM proprietor a monopoly over a term which is common in the commercial field to which these contested goods and services belong, or deprive other traders of an essential and widely used term to describe their goods and services. The continuance of the registration of the contested CTM represents no restraint of trade.
- 38 With regards to the fact that the cancellation applicant is the owner of the CTM application No 9 740 457, which is currently being opposed by the CTM proprietor, and details of the assignment of ownership rights by Oscar Tirelli, 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.
- 39 Finally, for the sake of completeness, as regards the cancellation applicant’s argument related to the alleged non-registrability of the mark in question according to Italian case-law, it suffices to observe, apart from referring to the relevant considerations expressed in the contested decision, that this argument was not supported by any evidence.
- 40 As to any possible bad faith allegation, since the cancellation applicant has failed to make such a plea, this ground will not be assessed. In any event, no evidence has been presented by the applicant to prove bad faith on the part of the CTM proprietor by filing its application to register the contested CTM.
- 41 In conclusion, the contested decision must be partially annulled and the appeal must, consequently, be partially allowed.

Costs

- 42 Since the appeal is partially successful and the contested Community trade mark registration will be allowed to remain registered for a part of the goods and services against which the declaration of invalidity was directed, each party has succeeded in part. Pursuant to Article 85(2) CTMR, each party shall be ordered to bear its own fees and costs incurred in the cancellation and appeal proceedings

Order

On those grounds,

THE BOARD

hereby:

1. Allows the appeal and declares the CTM invalid in respect of:

Class 9 - Recording discs; cinematographic films, exposed films; audio discs; CD-ROMS; compact discs; computer game programs; computer game discs; DVDs; DVD recorders; digital versatile discs; digital video discs; motion picture films; video cassette recorders; video game discs; video cassettes;

Class 16 – Printer matter; baby books; books; cartoon strips; children’s activity books; comic books; comic strips; magazines; picture books;

Class 28 - Action figures; bath toys; collectable toy figures; crib toys; dolls; electric action toys; inflatable toys; mechanical toys; plush toys; puppets; squeeze toys; stuffed toys; toy figures;

Class 41 – Entertainment services; amusement park and themed park services; educational and entertainment services rendered in or relating to theme parks; live stage shows; presentation of live performances; theatre productions; entertainer services.

2. Dismisses the appeal and declares the CTM valid in respect of the remaining goods and services covered by the CTM.

3. Orders that each party bears its own costs in the cancellation and the appeal proceedings.

According to Article 6 of
Commission Regulation
(EC) No 216/96

Signed

H. Salmi

Signed

C. Govers

Signed

H. Salmi

Registrar:

Signed

H.Dijkema

