

IN THE MATTER OF APPLICATION NUMBER 3662759

BY THE ESTATE OF THE LATE SONIA BROWNELL ORWELL

TO REGISTER THE FOLLOWING MARK IN CLASSES 9, 16, 18, 21, 25, 28, 41 and 45:

1984

Background

1. On 30 June 2021, The Estate of the Late Sonia Brownell Orwell (“the applicant”) applied to register the above mark for the following goods and services:

Class 9

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

pre-recorded audio and video compact discs, DVDs, motion picture films, television programmes and other digital recording media; musical sound recordings; glasses; sunglasses; parts and fittings for all of the above goods.

Class 16

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

Class 18

Leather and imitations of leather; luggage; trunks and travelling bags; tote bags; rucksacks; umbrellas and parasols; backpacks; walking sticks; briefcases; wallets; purses; bags; parts and fittings for all of the above goods.

Class 21

Household and kitchen utensils and containers; Cookware and tableware; small domestic utensils and containers; cosmetic and toilet utensils; combs and sponges; lunch boxes; cups; crockery; bowls; cutlery trays; wash bags; cosmetic bags; oven gloves; oven mitts; travel cups and mugs; mugs; plates; paper plates; paper cups; dishes; saucers; glasses; tankards; money boxes; decorative plates; ornaments, namely, statues, figurines, plaques and works of art, made of materials such as porcelain, terra-cotta or glass; plaques, statues and figurines; articles made of ceramics, glassware, porcelain and earthenware; parts and fittings for all of the above goods.

Class 25

Clothing, footwear, headgear; underwear, outerwear, suits; coats, gloves, shirts, t-shirts, jumpers, belts, tops, pyjamas, gowns, beachwear, socks, hats, scarves, ties, caps; parts and fittings for all the above goods.

Class 28

Games, toys and playthings; decorations for Christmas trees; electronic games; board games; costume masks; playing cards; action figures; figurines; electrical and video amusement apparatus and instruments; peripheral devices for use with home video game machines; amusement apparatus for use with a television monitor or some other form of display apparatus; jigsaws; card

games; gymnastic and sporting articles not included in other classes; amusement apparatus adapted for use with television receivers; interactive games adapted for use with television receivers; parts and fittings for all of the above goods.

Class 41

Entertainment; cultural activities; publishing services; educational services; electronic publishing; providing non-downloadable electronic publications; theme park services; amusement park services; provision of educational services via electronic media, multimedia content, videos, movies, television programmes, pictures, images, text, photos, user-generated content, audio content, and related information via the Internet and other communications networks; providing online entertainment and cultural information by way of multimedia content, podcasts, vodcasts, viral videos, interviews, audio visual programmes, videos, video recordings, photos, images, text, data, games, music, sound recordings and/or films; provision of films, games and audio or visual information online (not downloadable); news and news programme services; film, video, sound and visual production, presentation and /or distribution services; video tape and DVD film production; production, presentation and/or distribution of video recordings, sound recordings, video cassettes, CDs, DVDs and/or digital recordings; organisation of events, festivals, seminars, conferences, congresses, workshops, exhibitions, cultural activities, webinars, competitions and / or stage shows; production, presentation, rental and distribution of films, television and /or radio programmes; interactive entertainment services in relation to films, sound and /or video recordings; publication and/or distribution of entertainment, educational and/or instructional materials; online entertainment and digital publishing services; providing television programmes and films online; advisory, consultancy and information services for all of the above services.

Class 45

Political consultancy services; provision of political and public affairs information; government relation services; research and information services relating to political and public affairs; political and public affairs communications; on-line social networking services; lobbying services; advisory, consultancy and information services for all of the above services.

2. On 17 September 2021 the Intellectual Property Office (“IPO”) issued an examination report in response to the application. In that report, an objection was raised under sections 3(1)(b) and (c) of the Trade Marks Act 1994 (“the Act”) on the grounds that the mark consists exclusively of a sign which may serve in trade to designate the subject matter of the goods and services, e.g. publications, content and image carriers and recordings in respect of the worldwide renowned novel ‘1984’. The objection was raised against Classes 9, 16 and 41 and in respect of the following goods and services only:

Class 9

Video tapes, audio tapes, compact discs, video discs, laser discs, DVDs, CD-roms, electronic publications, digital media and recordings, pre-recorded digital media and recordings, downloadable electronic publications, downloadable

digital media and recordings, downloadable digital media and recordings containing sound, images, text, information, signals or software, webcasts, podcasts, vodcasts, podscrolls, teaching apparatus and instruments, audio and visual teaching apparatus, downloadable digital media and recordings containing teaching apparatus and instruments, computer games, educational computer games, downloadable computer games, animated cartoons and other imagery, cinematographic films, animated cartoons, movies, magnetic recordings, optical recordings, magneto-optical recordings, solid-state recordings, multimedia discs and publications, multimedia recordings and publications, sound recordings, pre-recorded disks, recording disks, magnetic badges, gramophone records, compact discs-interactive CD-roms, communications apparatus and instruments, mobile phone games, digital games, mobile phone games, DVD games, pre-recorded audio and video compact discs, DVDs, motion picture films, television programmes and other digital recording media.

Class 16

Postcards, diaries, cardboard cut-outs and/or works of art, printed matter, photographs, artists materials, book ends, books, annuals, note books, publications, comic books, paper badges, magazines, newsletter, newspaper, albums, periodicals, journals, catalogues, manuals, pamphlets, leaflets, labels, instructional and teaching materials, instructional and teaching materials for education and information, book binding materials, book covers, book marks, drawings, paintings, prints, pictures, calendars, note pads, embroidery patterns, decorative transfers, greetings cards, stickers, paper signs.

Class 41

Entertainment, cultural activities, publishing services, educational services, electronic publishing, providing non-downloadable electronic publications, provision of educational services via electronic media, multimedia content, videos, movies, television programmes, pictures, images, photos, user-generated content, audio content, and related information via the Internet and other communications networks, providing online entertainment and cultural information by way of multimedia content, podcasts, vodcasts, viral videos, interviews, audio visual programmes, videos, video recordings, photos, text, data, games, music, sound recordings and/or films, provision of films, games and audio or visual information online (not downloadable), film, video, sound and visual production, presentation and /or distribution services, video tape and DVD film production, production, presentation and/or distribution of video recordings, sound recordings, video cassettes, CDs, DVDs and/or digital recordings, production, presentation, rental and distribution of films, television and /or radio programmes, interactive entertainment services in relation to films, sound and /or video recordings, publication and/or distribution of entertainment, educational and/or instructional materials, online entertainment and digital publishing services, providing television programmes and films online.

3. The examiner supported the objection by providing examples of the mark '1984' being used by third parties in respect of multiple publications, films and posters. It did not appear from these examples that the applicant had any role in the production or marketing of these goods.

4. In line with standard IPO procedure, a period of two months was allowed for the applicant to respond.

5. On 11 November 2021 Sipara Limited (“the attorney”) acting on behalf of the applicant requested a hearing.

6. At the hearing on 8 December 2021, attended by Mr Robert Furneaux of Sipara, I maintained the objection under section 3(1)(b) & (c) of the Act against the following goods and services:

Class 9

Video tapes; audio tapes; video discs; laser discs; DVDs; CD-roms; electronic publications; digital media and recordings; pre-recorded digital media and recordings; downloadable electronic publications; downloadable digital media and recordings; downloadable digital media and recordings containing sound, images, text, webcasts; podcasts; vodcasts; downloadable video; cinematographic films; animated cartoons; movies; magnetic recordings; optical recordings; magneto-optical recordings; solid-state recordings; multimedia discs and publications; multimedia recordings and publications; sound recordings; pre-recorded disks; pre-recorded audio and video compact discs, DVDs, motion picture films, television programmes and other digital recording media.

Class 16

Printed matter; books; publications; magazines; pamphlets; leaflets; instructional and teaching materials; instructional and teaching materials for education and information; book covers.

Class 41

Entertainment; providing non-downloadable electronic publications; providing online entertainment by way of multimedia content, podcasts, vodcasts, viral videos, audio visual programmes, videos, video recordings, sound recordings and/or films; provision of films, and audio or visual information online (not downloadable); film, video, sound and visual presentation services; presentation of video recordings, sound recordings, and/or digital recordings; organisation of stage shows; presentation of films, television and /or radio programmes; interactive entertainment services in relation to films, sound and /or video recordings; online entertainment services; providing television programmes and films online.

7. As a consequence of maintaining the objection against certain goods and services, the objection was effectively waived against the following:

Class 9

Compact discs; downloadable digital media and recordings containing information, signals or software; podscrolls; teaching apparatus and instruments; audio and visual teaching apparatus; downloadable digital media and recordings containing teaching apparatus and instruments; computer games; educational computer games; downloadable computer games;

animated cartoons and other imagery; recording disks; magnetic badges; gramophone records; compact discs-interactive CD-roms; communications apparatus and instruments; mobile phone games; digital games; mobile phone games; DVD games.

Class 16

Postcards, diaries, cardboard cut-outs and/or works of art, photographs, artists materials, book ends, annuals, note books, comic books, paper badges, newsletter, newspaper, albums, periodicals, journals, catalogues, manuals, labels, book binding materials, book marks, drawings, paintings, prints, pictures, note pads, embroidery patterns, decorative transfers, greetings cards, stickers, paper signs.

Class 41

cultural activities, publishing services, educational services, electronic publishing; provision of educational services via electronic media, multimedia content, videos, movies, television programmes, pictures, images, photos, user-generated content, audio content, and related information via the Internet and other communications networks; providing online entertainment information by way of interviews, photos, text, data, games, and music, providing online cultural information by way of multimedia content, podcasts, vodcasts, viral videos, interviews, audio visual programmes, videos, video recordings, photos, text, data, games, music, sound recordings and/or films; provision of games online (not downloadable); film, video, sound and visual production and /or distribution services; video tape and DVD film production; production and/or distribution of video recordings, sound recordings, video cassettes, CDs, DVDs and/or digital recordings; presentation video cassettes, CDs, and DVDs; production, rental and distribution of films, television and /or radio programmes; publication and/or distribution of entertainment, educational and/or instructional materials; digital publishing services.

8. I issued the hearing report on 15 December 2021 and a period of two months was given to allow Mr Furneaux time to consult with the applicant and to consider the option of filing evidence to demonstrate acquired distinctiveness through use.

9. On 26 January 2022 the attorney submitted Form TM12 (Request to divide an application). The TM12 requested that Classes 9, 16 and 45 be retained on the original application and for Classes 18, 21, 25, 28 and 41 to be divided to create the 'child' application. The attorney contacted the office soon after to highlight an error that had been made on the form TM12 insofar as it should have requested Classes 9, 16 and 41 be retained on the original application and Classes 18, 21, 25, 28 and 45 form the 'child' application. The original application was duly divided as per the attorney's revised instruction. The 'child' application was allocated number UK00003749701 which then proceeded to publication in respect of the accepted Classes 18, 21, 25, 28 and 45. The original (parent) application retained the number UK00003662759 and covered Classes 9, 16 and 41. Confirmation that the application had been divided was issued on 1 February 2022.

10. At the expiry of the response time given in the hearing report, on 15 March 2022 the attorney requested an extension of time to respond to the outstanding objection

raised against the parent application which contained Classes 9, 16 and 41. The request was granted and a new date for response was set at 16 May 2022.

11. On 16 May 2022 the attorney responded with submissions in favour of accepting the mark. At the hearing I had concluded that the mark was not inherently distinctive and invited the attorney to submit evidence to demonstrate acquired distinctiveness through use. Having considered these new submissions it was clear to me that they were supporting a claim as to the inherent distinctiveness of the mark and did not include evidence of the kind that would be expected when demonstrating acquired distinctiveness, nonetheless, I considered the information provided but I was not persuaded to waive the objection.

12. I will briefly summarise the information provided in the attorney's submissions of 16 May 2022:

Enclosure A provided examples of news articles demonstrating some of the applicant's commercial activities in managing the works of George Orwell and specifically ANIMAL FARM and 1984.

Enclosure B provided materials demonstrating the activities carried out by the *Orwell Foundation*, a charity which was set up with the aim of carrying on the achievements of the author George Orwell. The enclosure also provided materials relating to the *Orwell Prize* which aims to encourage writing and includes workshops, seminars and interactive youth forums. The materials in this enclosure were intended to demonstrate the ongoing association between the applicant and the Orwell Trade Marks. An example was a short film released in 2020 by the Orwell Foundation to tell the story of how *Animal Farm* came to be written; and the sponsorship by the Orwell Society in 2015 of series of articles on the origins and genre of the *Animal Farm* book.

Enclosure C included details of agreements between the applicant and third parties *The Actors' Gang*; *Espacio Atomo S.L.*; and the *British Broadcasting Corporation* for them to perform an adaptation of the '1984' play. The enclosure also included the agreement between the applicant and *Hallmark Entertainment Productions Inc* for the film adaptation of 'Animal Farm'.

Enclosure D included a translation of the EUIPO Board of Appeal decision R 2401/2014-4 for the similar trade mark LE JOURNAL D'ANNE FRANK. The contested decision was annulled.

Enclosure E included observations made by the International Trade Mark Association (INTA) to the Grand Board of Appeal of the EUIPO in respect of the decisions of the EUIPO in R 1719/2019 and R 1922/2019-5.

13. Having considered the information provided on 16 May 2022 I remained of the view that the mark was not inherently distinctive, and neither had the information demonstrated that the mark had acquired distinctiveness through use, although as I have mentioned above, I did not believe it was the attorneys intention for the information to be used as a means of demonstrating acquired distinctiveness through use.

14. Having considered these submissions, I had not been persuaded that the mark '1984' would be perceived as a distinctive trade mark and as a designation of single trade origin so the objection was maintained. I had concluded at the hearing that the mark was not inherently distinctive and a period of time had been given to allow the applicant to submit evidence to demonstrate acquired distinctiveness through use. As the submissions received on 16 May 2022 appeared only to address the inherent distinctiveness of the mark, in my response of 31 May 2022 I allowed a further period of two months in which to file evidence to demonstrate acquired distinctiveness through use.

15. On 27 July 2022 the attorney requested a further extension to the response period and gave the reason that more time was needed to prepare the evidence. A further period of one month was agreed and the response date extended to 29 August 2022. At that time it had been over a year since the application had been filed and it appeared to me that the attorney was no further forward in overcoming the objection. I therefore informed them that while I was prepared to allow this final extension of time, any further request would be refused.

16. Before the response date had expired and before the application was formally refused for the goods and services identified above, a form TM5 was received on 26 August 2022. Following the expiry of the response date given in my letter of 29 July 2022, the application was then partially refused and the attorney notified of the refusal in my letter of 30 August 2022.

17. Having received a request for a statement of reasons for the registrar's decision, I am now obliged to set out my reasons for my decision.

The Law

18. Section 3(1) of the Act reads as follows:

3(1) The following shall not be registered –

(a) ...

(b) trade marks which are devoid of distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

(d) ...

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.

19. The objection was raised on the basis that the mark consists exclusively of a sign which may serve in trade to designate a characteristic of the goods and services, the characteristic being their subject matter, for example, tapes, DVDs, movies, books and online entertainment all of which whose subject is that of the famous novel '1984'.

20. As regards what constitutes 'subject matter', during my assessment of the mark I also take into consideration the decision of the Appointed Person in case BL O/287/15, in respect of the marks THE DIARY OF A YOUNG GIRL and THE DIARY OF ANNE FRANK in which Mr Geoffrey Hobbs KC had set out the considerations to be taken when determining what may be regarded as a 'characteristic', and his conclusion that the hearing officer's decision to refuse the marks under section 3(1)(b)&(c) was correct:

20.For the reasons I gave at greater length in NMSI Trading Ltd's Trade Mark Application (FLYING SCOTSMAN Trade Mark) BL O-313-11; [2012] RPC 7; at paragraphs. [15] to [18] I consider that due account must be taken of 'characteristics' that goods or services of the kind specified in an application for registration may optionally possess and that a particular theme or subject may be regarded as an optional 'characteristic' of goods or services which are apt to convey imagery or information. The exclusion of a sign from registration in a case such as the present is liable to depend on: (a) whether the potential for goods or services of the kind specified to provide consumers with imagery or information about someone or something denoted by the sign is sufficiently real and significant to be a material consideration; and (b) whether it is reasonable to believe that the sign will actually be recognised by the relevant class of persons as a description of the content or character of such goods or services. The latter requirement is not satisfied if the sign would be understood to designate content or character that the relevant average consumer would take to have come from a single economic undertaking believed or expected to be linked to the use of that sign.....

21. The Applicant maintained that there can and should be no general proposition of law, hence no standardisation of practice at the national level under the Trade Marks Directive or at the EU level under the Community Trade Mark Regulation to the effect that 'titles of books and films are per se unregistrable for books and films because they indicate the subject matter of the goods'. I agree. There should be a stringent and full examination in each individual case as to the applicability or otherwise of the specific criteria for exclusion in the factual circumstances of that particular case: see paragraph [19(6)] above.

22. The Applicant further maintained that current statements of practice published by the UK Intellectual Property Office and by the Community Trade Marks Office are based on reasoning and case law that is illogical and outmoded: illogical for treating renown as a reason for refusing rather than granting registered trade mark protection; outmoded for not recognising the concept of dual meaning by accepting that a designation can serve to designate the provenance or trade origin of goods or services, whether or not it also has the capacity to communicate information as to their nature or characteristics. It is not necessary to dwell on the published statements of practice. The principles

to be applied are set out in the case law of the CJEU noted in paragraph [19] above. I do not accept that it would be permissible, when assessing a famous name for registrability in accordance with those principles, to assume that the fame of the name prevents it from being descriptive or otherwise non-distinctive as a designation intended for use in relation to goods or services conveying images or information about whatever it is that the name identifies. And if it is reasonable to believe that the name when used as a designation would actually be recognised by the relevant class of persons as a description of the content or character of such goods or services, a claim for protection premised upon dual meaning would then fall to be rejected in the absence of evidence sufficient to establish distinctiveness acquired through use.

23. On reviewing the Hearing Officer's determinations in the light of the principles I have identified, I am satisfied that she was entitled to reach the conclusions she did for the reasons she gave. Her assessment under Section 3(1)(c), see paragraph [10] above, which coincides with that of the Brussels Court of Appeal, see paragraph [15] above, appears to me to be clearly correct and to require exclusion of the designations in question from registration under Section 3(1)(c), hence Section 3(1)(b) of the 1994 Act.

21. In that decision it was concluded that the title of the famous novel would be seen as the subject matter of those particular books and I believe the same conclusion applies here in that the mark '1984' has also enjoyed a considerable level of fame since it was first published in 1949 which gives it the capacity to communicate information as to the characteristic of the goods and services. I consider the objectionable goods and services to be of the kind that would provide consumers with imagery or information about someone or something denoted by the sign, and that the mark will be recognised by the relevant consumer as a description of the content of those goods and services. Moreover, I contend that the relevant consumer would not take the mark as indicating that the goods and services have come from a single economic undertaking believed or expected to be linked to the use of that sign. Consequently, it is my view that each of the requirements (a) and (b) referred to in paragraph 20 of Mr Hobbs decision have indeed been satisfied and that upon seeing the mark '1984' the relevant consumer will take it to designate the subject matter of the goods and services upon which it is used and will not perceive it as designating the goods and services of a single economic undertaking. If someone is looking for this book or DVD, or they wish to go to the theatre or cinema to see the stage show or film adaptation of the George Orwell novel, on seeing the mark '1984' they would take it as being the title of the novel and thus indicating the subject matter of the book, DVD, film or stage show and not as a designation of single trade origin. In this case, I have no doubt that the mark '1984' will be considered as the subject matter of the goods and services and not as an indication of single brand origin.

22. No separate objection had been raised under Section 3(1)(b) and the finding of non-distinctiveness was the automatic consequence of the sign being considered to be descriptive. Therefore, I will give no separate rationale as regards the objection under section 3(1)(b) but will instead treat the two objections as co-extensive and based on the same rationale.

The relevant legal principles – section 3(1)(c)

23. There are a number of judgements of the Court of Justice of the European Union (“CJEU”) which deal with the scope of Article 3(1)(c) of First Council Directive 89/104 (recorded and replaced by Directive 2008/95/EC on 22 October 2008) and Article 7(1)(c) of the Community Trade Mark Regulation (the CTMR), whose provisions correspond to Section 3(1)(c) of the UK Act. I derive the following main guiding principles from the cases noted below:

- Subject to any claim in relation to acquired distinctive character, signs and indications which may serve in trade to designate the characteristics of goods or services are deemed incapable of fulfilling the indication of origin function of a trade mark (*Wm Wrigley Jr & Company v OHIM*, C-191/01P ‘Doublemint’, paragraph 30);
- Article 7(1)(c) (section 3(1)(c)) pursues an aim which is in the public interest, namely that signs or indications relating to the categories of goods or services in respect of which registration is sought may be freely used by all. The provision therefore prevents such signs or indications from being reserved to one undertaking alone because they have been registered as trade marks (see judgment of 4 May 1999 in Joined cases C-108/97 and C-109/97 *Windsurfing Chiemsee Produktions- und Vertriebs GmbH (WSC) v Boots-und Segelzubehör Walter Huber and Franz Attenberger (Chiemsee)* [1999] ECR I-2779, at paragraph 25).
- It is also a well-established principle that the Registrar’s role is to engage in a full and stringent examination of the facts, underlying the Registrar’s frontline role in preventing the granting of undue monopolies, see to that effect CJEU Case C-51/10 P, *Agencja Wydawnicza Technopol sp. z.o.o. v OHIM* [2011] ECR I-1541 (*Technopol*).
- When determining whether a sign is devoid of distinctive character or is descriptive of the goods or services in respect of which registration is sought, it is necessary to take into account the perception of the relevant consumer who is reasonably well-informed and reasonably observant and circumspect (*Matratzen Concord AG v Hukla Germany SA*, C-421/04);
- There must be a sufficiently direct and specific relationship between the sign and the goods in question to enable the relevant consumer immediately to perceive, without further thought, a description of the category of goods and services in question or one of their characteristics (*Ford Motor Co v OHIM*, T-67/07);

24. I have also taken into account the consequences for third parties of granting the applicant a monopoly. In *Linde A.G. v Rado Uhren A.G.* Case C-53/01 the following guidance was given at paragraphs 73 – 74:

“73. According to the Court’s case-law “Article 3(1)(c) of the Directive pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the characteristics of goods or services in respect of

which registration is applied for may be freely used by all, including as collective marks or as part of complex or graphic marks. Article 3(1)(c) therefore prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks (see to that effect, Windsurfing Chiemsee, paragraph 25).

74. The public interest underlying Article 3(1)(c) of the Directive implies that, subject to Article 3(3) any trade mark which consists exclusively of a sign or indication which may serve to designate the characteristics of goods or a service within the meaning of that provision must be freely available to all and not be registrable.

25. It is clear from the aforementioned case law that I must determine whether or not the mark applied for will be perceived by the relevant consumer as a means of directly designating the characteristic of the goods and services being provided. In this case, the characteristic being the 'subject matter' of the goods and services. In order to do this, I must assess who I consider the relevant consumer to be.

26. As mentioned above, the objection has been maintained against the following goods and services:

Class 9

Video tapes; audio tapes; video discs; laser discs; DVDs; CD-roms; electronic publications; digital media and recordings; pre-recorded digital media and recordings; downloadable electronic publications; downloadable digital media and recordings; downloadable digital media and recordings containing sound, images, text, webcasts; podcasts; vodcasts; downloadable video; cinematographic films; animated cartoons; movies; magnetic recordings; optical recordings; magneto-optical recordings; solid-state recordings; multimedia discs and publications; multimedia recordings and publications; sound recordings; pre-recorded disks; pre-recorded audio and video compact discs, DVDs, motion picture films, television programmes and other digital recording media.

Class 16

Printed matter; books; publications; magazines; pamphlets; leaflets; instructional and teaching materials; instructional and teaching materials for education and information; book covers.

Class 41

Entertainment; providing non-downloadable electronic publications; providing online entertainment by way of multimedia content, podcasts, vodcasts, viral videos, audio visual programmes, videos, video recordings, sound recordings and/or films; provision of films, and audio or visual information online (not downloadable); film, video, sound and visual presentation services; presentation of video recordings, sound recordings, and/or digital recordings; organisation of stage shows; presentation of films, television and /or radio programmes; interactive entertainment services in relation to films, sound and /or video recordings; online entertainment services; providing television programmes and films online.

27. The goods for which I have maintained the objection are essentially audio and visual materials, including videos, recordings and DVDs, as well as printed matter including books and publications. The services include entertainment and the non-downloadable versions of the goods in Classes 9 and 16. When considering these goods and services it is my view that the relevant consumer will be the general public but also professionals working in the retail sector and within the field of education. The general public are likely to purchase the goods and services for their own personal use and entertainment, while those working in the retail sector will purchase the goods in order to sell within a retail shopping outlet. Consumers working in the field of education may select the goods and services for use by students as part of their educational curriculum. The level of attention will vary depending on the consumer, however, I consider that it is reasonable to assume that the prospective purchaser of the applicant's goods and services would apply at least a moderate level of attention and circumspection when considering whether or not to purchase.

28. In assessing the mark applied for, it is clear that it consists of the name of the very well-known novel '1984' written by the author George Orwell. It was first published by Secker & Warburg in 1949 and has since been published by various other publishing houses including *Penguin Modern Classics*, *Birlinn General*, *Alma Classics*, and *Scholastic*. I consider the novel to be very well-known having also been performed on stage and screen. The '*Northern Ballet*' put on a production of '1984' and won the dance award at the South Bank Sky Arts Awards in June 2016, and the London's '*Playhouse Theatre*' put on a show based on the novel in 2016. Television and film adaptations based on the novel have also been made. I refer also to the BBC News website which reported in August 2015 that the *Times Educational Supplement* (TES) magazine listed '1984' as number 1 in their top 100 books that you ought to read by the time you finish school. Please see the following link and Annex A at the end of this report:

<https://www.bbc.co.uk/news/newsbeat-33757963>

29. Time magazine also included '1984' on its list of 100 best English language novels, while in 2019, the BBC included '1984' on its list of the 100 most influential novels. I have no doubt that the novel '1984' is very well-known and it would be quite unlikely that many of the general public or those people working in the field of education will not be familiar with it.

30. It is my opinion, that given the high level of fame that the book has, the average consumer will perceive the sign '1984' as the title of a book or work of artistic creation and not as designating the commercial origin of the goods and services but they will instead perceive it as nothing more than the subject matter of the goods and services. As they will be familiar with the book title '1984', upon encountering the sign when used in respect of the goods and services listed in paragraph 26 above, they will not only perceive the sign as indicating the subject matter of the goods and services but they will also expect them to be the '1984' novel or a recorded version of it. In terms of entertainment services, they would expect a stage play or cinematographic film titled '1984' to be based around that novel.

31. In respect of famous works of literature, I refer to the Court of Appeal's decision in respect of *TARZAN* [1970 RPC 450] in which it says:

"In the present case, there is nothing at all in the word 'Tarzan' which would suggest to the public or to the trade that a film or magnetic tape recording has anything to do with the applicant or with anyone else. The word 'Tarzan' when used in connection with a film suggests – and suggests only- that the film has something to do with the well-known fictional person, Tarzan, a man of great strength and agility".

32. With that in mind, I am of the view that there is also nothing at all in the mark '1984' that would suggest to the relevant consumer that the goods and services have anything to do with a specific undertaking, but they would instead see the mark when used in respect of the goods and services as indicating that the subject matter contained within said goods and services as that of the famous novel '1984'. The relevant consumer would not perceive the mark '1984' as designating the goods and services of a single undertaking but will immediately take it to be the subject of the goods and services.

33. In the decision *THE DIARY OF A YOUNG GIRL* and *THE DIARY OF ANNE FRANK*, Mr Geoffrey Hobbs KC referred also to the decision of the Brussels Court of Appeal (9th Chamber) in *Anne Frank-Fonds v. The Benelux Intellectual Property Organisation (OBPI)* (3 October 2013):

15. Anne Frank-Fonds had applied to The Benelux Intellectual Property Organisation (OBPI) on 13 July 2011 for registration of the designation HET DAGBOECK VAN ANNE FRANK as a trade mark for use in relation to goods and services listed in Classes 9, 16, 39 and 41 that were the same as those shown in paragraph [1] above. The OBPI rejected the application on the basis that the designation was descriptive and lacked distinctiveness in relation to such goods and services. The Brussels Court of Appeal upheld the decision of the OBPI. According to the English translation provided by the Registrar, the Court concluded in its Judgment that:

When faced with the sign Het dagboek van Anne Frank affixed to the goods for which registration is sought or designating the services offered, the consumer concerned will immediately perceive it as the title of Anne Frank's work, which is known all over the world, incorporated into a book, a dvd or any other physical medium or the subject of a theatre production or exhibition, but not as indicating the undertaking offering such goods and services.

In this regard it must be noted that even though the OBPI's decision was not based on copyright, the copyrights held by the Anne Frank Fonds will expire in the near future and the work, which is already part of humanity's cultural heritage, will shortly enter the public domain. If registration of the sign were ordered, that would therefore have the consequence of giving the Anne Frank Fonds a de facto perpetual monopoly in that work (subject to renewal), thereby preventing any economic operator from still publishing the work under its original title.

But one of the purposes of refusing registration of a mark may be to prevent the exclusive and permanent right which a trade mark confers from serving to extend the life of other rights which the legislature has sought to make subject to limited periods (Opinion of Advocate General Ruiz-Jarabo Colomer, Philips, C-299/99, point 30). It is in fact unacceptable that a creation of the mind, which forms part of the universal cultural heritage, should be appropriated indefinitely by a person to be used on the market in order to distinguish the goods he produces or the services he provides with an exclusivity which not even its author's estate enjoys (Opinion of Advocate General Ruiz-Jarabo Colomer, Shield Mark C-293/01/point 52). Such appropriation is contrary to the general interest and there is nothing to show that the general interest would be better guaranteed if the work of Anne Frank were distributed by a single undertaking as the Anne Frank Fonds maintains (see its pleadings, point 73). The granting of a trade mark is obviously no guarantee of the authenticity of the work incorporated into the product, contrary to what it claims.

The appeal must be declared unfounded for this reason also.

34. If the mark '1984' was to become registered it would result in the applicant having a continuous monopoly in that work thereby preventing any other party from still publishing the work under its original title. Such appropriation is contrary to the general interest and there is nothing to show that the general interest would be better guaranteed if the works of George Orwell were distributed by a single undertaking. When faced with the mark '1984' affixed to the goods and services applied for, the consumer will immediately perceive it as the title of George Orwell's work incorporated into a book, a dvd or any other physical medium or the subject of a theatre production or film, but not as indicating the undertaking offering those goods and services.

35. As mentioned at paragraph 11, I did not believe it was the attorney's intention for the information submitted on 16 May 2022 to be 'evidence' of the kind to demonstrate acquired distinctiveness, but if I was wrong in that regard, I also considered the information as if it were intended to demonstrate acquired distinctiveness through use.

36. The principles to be considered when assessing evidence to demonstrate acquired distinctiveness are set out in *Windsurfing Chiemsee* (C109/97) and states that the following may be taken into account: the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking. I appreciate that this is not a 'tick box' and that demonstrating acquired distinctive character is not a matter of simply providing this information, and that the evidence must be considered in its totality, but in this present case, having considered all of the information before me it did not include anything that would suggest to me that the relevant class of person, or at least a significant proportion of them, identifies the good and services as originating from a particular undertaking because of the trade mark. Consequently, it did not serve to demonstrate that the mark had acquired distinctive character through use. I set out my reasons below:

37. The news articles provided in Enclosure A may indeed demonstrate the applicant's commercial activities in managing the works of George Orwell and specifically ANIMAL FARM and 1984, but while this provided evidence to show the degree of fame that the author and his works enjoy, it merely supported my view that the mark will not be perceived as a single badge of origin because third parties, such as The Orwell Society, are also producing the works of George Orwell.

38. The information provided in Enclosure B relates primarily to the *Orwell Foundation*, a third party charity set up with the authorisation and support of the applicant, and to the *Orwell Prize*. I have no doubt that the foundation strives to carry on the achievements of the author George Orwell and that their work and the awarding of prizes in his name has clearly kept him in the public eye, but this kind of exposure and recognition merely illustrates his importance within the literary world and does not serve to demonstrate that the mark is a distinctive trade mark.

39. As third parties are producing adaptations of the novel, the agreements at Enclosure C serve only to support my view that the mark will not be seen as a designation of 'single' trade origin, which is of course the primary function of a trade mark. The fact the applicant has given permission for others to create adaptations of the book does not demonstrate that the mark is functioning as a trade mark when used by third parties. The consumer will simply see the mark as indicating the content of the book/film/tv programme.

40. I had noted the translation of the EUIPO Board of Appeal decision R 2401/2014-4 for the similar trade mark LE JOURNAL D'ANNE FRANK at Enclosure D but this did not persuade me that the mark '1984' must also be considered distinctive.

41. As regards the observations made by INTA to the EUIPO Grand Board of Appeal, provided at Enclosure E, I have no doubt the decision of the GBoA will be of great interest, but their observations does not give me grounds for waiving the objection against this application.

Conclusion

42. For the reasons given above, I consider the sign to be descriptive of the subject matter of the goods and services pursuant to section 3(1)(c) and, by inference, also devoid of any distinctive character, and that the submissions provided by the attorney have not served to demonstrate that the mark has acquired distinctiveness through use. The application is therefore partially refused under the terms of section 37(4) of the Act because it fails to qualify under sections 3(1)(b) and 3(1)(c).

Dated this 28th day of October 2022

**Helen Davies
For the Registrar
The Comptroller-General**

Annex A

BBC Sign in Home News Sport Weather iPlayer Sounds Bitesize Search BBC

NEWS Home Cost of Living War in Ukraine Coronavirus Climate UK World Business Politics Tech Science More

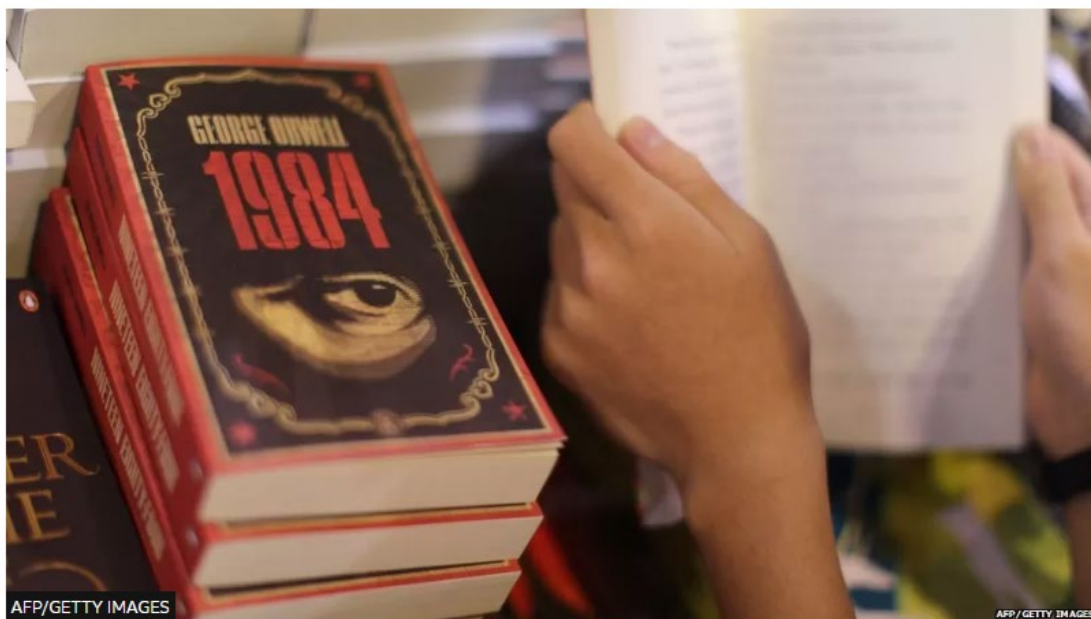
Newsbeat

Are you as well-read as a 16-year-old?

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Top Stories

LIVE New chancellor reverses tax cuts and scales back energy help



By Amelia Butterly

Newsbeat reporter

The top 100 books you ought to have read by the time you finish school have been announced by the Times Educational Supplement (TES) magazine.

Most of the novels in the top 10 have been included on recent GCSE courses.

But others, such as the Harry Potter series and Judy Blume's *Forever*, which is **about teen sex**, are less likely to appear on a syllabus anytime soon.

The list was made using a poll of 500 teachers by the National Association for the Teaching of English and TES.

The top 10 books to read before leaving secondary school

1. **1984 by George Orwell**
2. **To Kill A Mockingbird by Harper Lee**
3. **Animal Farm by George Orwell**
4. **Lord of the Flies by William Golding**
5. **Of Mice and Men by John Steinbeck**
6. **The Harry Potter Series by JK Rowling**
7. **A Christmas Carol by Charles Dickens**
8. **The Catcher in the Rye by JD Salinger**
9. **Great Expectations by Charles Dickens**
10. **Pride and Prejudice by Jane Austen**