

**TRADE MARKS ACT 1994.**

**IN THE MATTER OF:**

**APPLICATION No. 2587662 FOR REGISTRATION OF**

**‘THE DIARY OF A YOUNG GIRL’**

**AND APPLICATION No. 2587665 FOR REGISTRATION OF**

**‘THE DIARY OF ANNE FRANK’**

**IN CLASSES 9, 16, 39 AND 41**

**IN THE NAME OF ANNE FRANK-FONDS**

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**DECISION**

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The Trade Mark Applications

1. On 13 July 2011 Anne Frank-Fonds (‘the Applicant’) applied under number 2587662 to register the designation **THE DIARY OF A YOUNG GIRL** and under number 2587665 to register the designation **THE DIARY OF ANNE FRANK** as trade marks for use in relation to goods and services in Classes 9, 16, 39 and 41 listed as follows:

Class 9: Recorded optical, magnetic or electronic data media containing sounds and/or images, particularly compact disks; DVDs; sound recording disks; video cassettes; magnetic audio tapes; exposed films, exposed cinematographic films, electronic publications.

Class 16: Printed matter; periodicals; magazines; newspapers and books.

Class 39: Arranging of guided tours for cultural or educational purposes.

Class 41: Theatre productions; showing of films.

The objections to registration

2. The Registrar objected to both applications under Section 3(1)(c) of the Trade Marks Act 1994 on the basis that the designations consisted '*exclusively of signs or indications which may serve, in trade, to designate the ... characteristics*' of goods and services of the kind specified and also under Section 3(1)(b) of the Act on the basis that they were '*devoid of any distinctive character*' relative to such goods and services.

Evidence of use

3. The Applicant filed evidence with a view to overcoming the objections to registration on the basis of the proviso to Section 3(1) of the Act: '*... 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*'.

4. The evidence consisted of a witness statement with 11 exhibits provided by Mr Kugelmann (a member of the Board of the Applicant). He explained that the Applicant is a charitable foundation established under Swiss law on 24 January 1963, with one of its key roles being to administer the copyright for the literary works of Annelies "Anne" Marie Frank, a victim of the Holocaust who gained posthumous worldwide fame as a result of the publication of the diary she wrote from 12 June 1942 to 1 August 1944 whilst in hiding from German forces in the Netherlands during the Second World War.

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5. Anne Frank intended when the war was over to publish a book based on her diary. In the Spring of 1944 she began re-writing and editing her diary with that aim in mind. She was arrested on 4 August 1944 and imprisoned in Westerbork concentration camp where she subsequently died in late February/early March 1945. Her father Otto H Frank fulfilled his daughter's wish and published her diary 'Het Achterhuis' in 1947. It was subsequently translated into English and published as 'The Diary of a Young Girl' in 1952.

6. The literary works of Anne Frank administered by the Applicant are:

- Het Achterhuis/The Diary of a Young Girl (Otto H Frank and Otto H Frank and Mirjam Pressler Versions respectively)
- Verhaaltjes en Gebeurtenissen uit het Achterhuis/Tales From The Secret Annex
- De Dagboeken Van Anne Frank/The Diaries of Anne Frank (Critical Edition).

In 1996, Waterstones bookshops in association with Channel 4 television launched a search for the greatest books of the twentieth century as voted for by 'the reading public' in the United Kingdom. The Diary of Anne Frank was fourth in the 'Top 10 books Written by Women': Exhibit AFF11. In 2009, the Diaries of Anne Frank were added to the list of items of documentary heritage of exceptional value on UNESCO's Memory of the World Register, along with 34 other records of historically important matters and events from around the world. In its press release relating to the listings, UNESCO identified her diary as '*one of the top 10 most read books worldwide*' (Exhibit AFF1).

7. The responsibilities of the Applicant were summarised in Exhibit AFF2:

**To disseminate the message of ANNE FRANK**

Through her Diary, ANNE FRANK has become a world-wide symbol representing all victims of racism, anti-Semitism and fascism. She stands for victims who lived at the same time as she did just as much as for the victims of today. The foremost message contained in her Diary sets out to combat all forms of racism and anti-Semitism

**Charitable activities of the ANNE FRANK-Fonds**

In accordance with its statutes, the AFF uses the largest part of the revenue from the Foundation's assets for a wide range of concretely described charitable activities. After careful examination, the ANNE FRANK-Fonds finances those projects which comply with the ideas of ANNE FRANK. ...

Causes assisted to date include:

- On the suggestion of, and in co-operation with, Yad Vashem in Jerusalem, the AFF founded the "ANNE FRANK Medical Fund for the Righteous" in Basle in 1987. This provides urgently needed medical supplies to the "Righteous" - non-Jews who risked their lives to help Jews persecuted during the Holocaust. Help with financing is also sought from third parties.
- Initiation of, and financial support for, the ANNE FRANK Shoah Library at the German Library in Leipzig - a special library dedicated to genocide under National Socialism.
- Co-financing of exchange visits and meetings between young Germans, Israelis and Arabs.
- Support for the ANNE FRANK-Stichting (ANNE FRANK-House) in Amsterdam that maintains the house at Prinsengracht 263 as a museum and that performs extensive public activities in the struggle against all forms of discrimination.
- Support is given to Israeli-Palestinian peace organisations.
- Encouragement of projects related to schools and education, e.g. the Sussex University Symbiosis

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Project and the Ethics Project of the  
“Bläsischulhaus”, Basel.

- and many others

8. Mr. Kugelmann’s evidence clearly demonstrated the role of the Applicant as licensor with respect to reproductions and adaptations of ‘The Diary of a Young Girl’ and ‘The Diary of Anne Frank’ marketed in visual, audio and audio-visual form in the United Kingdom and elsewhere around the world. The market for such reproductions and adaptations in the United Kingdom can be seen from his evidence to have been both enduring and substantial. The exhibited materials show that the different entities responsible for producing and marketing licensed reproductions and adaptations of the copyright protected words did so under and by reference to their own trade identifiers and commercial indicia. The Applicant was generally identified by name (Anne Frank-Fonds) as the owner of copyright in or pertaining to the content of the licensed works. It does not appear from the evidence that the Applicant participated in the production or marketing of any of the licensed works or that any authenticating mark, name or designation was used in relation to the licensed works to indicate that they were produced or marketed under the imprimatur of the Applicant.

### Outcome

9. The objections were maintained and the applications for registration were refused for the reasons given in parallel decisions issued by Ms. Linda Smith on behalf of the Registrar of Trade Marks under reference BL O-293-13 (in relation to Application No. 2587662) and under reference BL O-294-13 (in relation to Application No. 2587665) on

24 July 2013. The decisions proceeded upon the basis of identical reasoning in relation to both applications.

10. The Hearing Officer's assessment of the designations under Section 3(1)(c) of the Act was as follows:

19. ... consumers wishing to read ['The Diary of a Young Girl'] ['The Diary of Anne Frank'] are likely to walk into a bookshop and ask "Do you have [the Diary of a Young Girl] [the Diary of Anne Frank]?", or, if they wished to see a stage version of the work, they would approach the ticket office and ask "Do you have any tickets for the show [The Diary of a Young Girl] [The Diary of Anne Frank]?" If purchasing on line, it is probable that they would look for the title of the work, rather than look for the name of the publisher. The same would apply where that consumer sees the phrase printed onto a publication or ticket. In such circumstances, the Registrar considers such use to be in reference to subject matter, rather than commercial origin.

20. Having come to the conclusion that the mark does indicate the subject matter of the goods and services, I have to also consider whether or not the concept of 'subject matter' can – in principle – be deemed to be a 'characteristic' of goods and services as referred to in section 3(1)(c) of the Act. That provision precludes from registration those signs 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' (my emphasis). I do consider the phrase 'other characteristics' to encompass subject matter, as was confirmed by Arnold J in the aforementioned *Linkin Park* decision:

"...a considerable diversity of characteristics is embraced by section 3(1)(c). In my judgment, the purpose of the words 'other characteristics' is to make it clear that section 3(1)(c) extends beyond the specific types of characteristics mentioned. I see no reason why subject matter should not qualify."

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21. Taking into account all of the above, I have concluded that the mark applied for consists exclusively of a sign which may serve, in trade, to designate a characteristic of the goods i.e. subject matter, and is therefore excluded from registration by section 3(1)(c) of the Act.

11. She went on to hold, in accordance with settled case law, that exclusion from registration under Section 3(1)(c) must also result in exclusion from registration under Section 3(1)(b).

12. Her conclusion in relation to the Applicant's claim for registration under the proviso to Section 3(1) of the Act, on the basis of distinctiveness acquired through use, was as follows:

39. In the case of ['The Diary of a Young Girl'] ['The Diary of Anne Frank'], the evidence clearly shows that the mark has been used by a number of different publishers to indicate the title of the work. This is not use in a trade mark sense, but instead use which indicates to a potential reader the subject matter of the book. The title is not being used to distinguish the goods of one publisher from those of another. As a result, taking into account the guidance set out in relevant case law and the documents and exhibits filed, I consider the evidence has failed to show that, at the date of application, the average consumer had been educated into seeing the sign as indicating the trade origin of the goods and services. The mark is therefore excluded from acceptance because it fails to qualify under section 3(1)(b) and (c) of the Act.

### The Appeal

13. The Applicant appealed to an Appointed Person under Section 76 of the 1994 Act contending, in summary, that the Hearing Officer had erred in point of law by misinterpreting and accordingly misapplying the provisions of Section 3(1)(c) and had in

any event erred in point of fact by deciding that, at the date of the applications for registration, the designations in question did not inherently or as a result of the use which had been made of them possess a distinctive character in relation to goods and services of the kind specified. On behalf of the Registrar it was, in summary, maintained that the word '*characteristics*' as used in Section 3(1)(c) can and should be interpreted as including '*subject matter*', with the result that the Hearing Officer's reasoning and findings of fact were correct and ought to be upheld on appeal.

14. Having discerned in the Applicant's position a suggestion that the designations in question should be taken to possess a distinctive character linked to its ownership and exploitation of the literary copyright in 'The Diary of a Young Girl' and 'The Diary of Anne Frank', the Registrar drew attention to the Judgment of the Brussels Court of Appeal (9<sup>th</sup> 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.

16. With reference to protection of the general interest, the Court went on to observe as follows:

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.

17. Both sides developed and refined their submissions in the course of argument at the hearing before me. The Applicant pressed for a reference under Article 267 TFEU for the purpose of obtaining guidance from the CJEU as to the criteria for determining whether famous book titles are caught by the exclusions from registration implemented in Sections 3(1)(b) and (c) of the Act when presented for registration in relation to goods and services such as those listed by the Applicant in the present case. I gave the Applicant an opportunity to expand upon its request for a reference by providing written representations as to any significant disparities of approach within the EU affecting the assessment of book titles for registrability in the light of existing CJEU case law. The Registrar was given an opportunity to respond. For the reasons set out in paragraphs [24] to [29] below, I have decided to determine the Appeal without making an order for reference under Article 267.

### Decision

18. Article 6quinquies (B2) of the Paris Convention for the Protection of Industrial Property of March 20, 1883 (as last revised in 1967 and amended in 1979) provides for the exclusion of trade marks from registration:

when they ... consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, place of origin, of the goods or the time of production ...

The EU legislature has enlarged upon that by providing in Article 3(1)(c) of the Trade Marks Directive (Directive 2008/95/EC) and Article 7(1)(c) of the Community Trade

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Mark Regulation (Regulation 207/2009/EC) for the exclusion of trade marks from registration when they:

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

Section 3(1)(c) of the Act must be interpreted and applied in the same way as Articles 3(1)(c) of the Directive and Article 7(1)(c) of the Regulation.

19. With regard to the meaning and effect of the expression '*may serve, in trade, to designate the ... characteristics of the goods or service*', it is clear from the Judgments of the CJEU in Case C-51/10 P Agencja Wydawnicza Technopol sp. z.o.o. v. OHIM EU:C:2011:139 and Case C-363/99 Koninklijke KPN Nederland NV v. Benelux-Merkenbureau EU:C:2004:86 that:

- (1) The matters specifically itemised in the relevant legislative provisions must all be regarded as '*characteristics*' of goods or services and the list is not exhaustive, since any other '*characteristics*' of goods or services may also be taken into account: Technopol para. [49].
- (2) The use of the word '*characteristic*' highlights the fact that the signs to which the exclusion from registration applies are those which merely serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought: Technopol para. [50]. It is irrelevant whether the characteristics of the goods or services which may be the

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subject of the description are commercially essential or merely ancillary: Koninklijke KPN Nederland para. [102].

- (3) It is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign in question could be used for such purposes. The ground for refusal does not depend on there being a real, current or serious need to leave the sign or indication free. It is of no relevance to know the number of competitors who might have an interest in using the sign in question. It is irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration Technopol paras. [38], [39].
- (4) The fact that a defence to infringement is available for descriptive use of a sign in accordance with honest practices in industrial or commercial matters has no decisive bearing or intrinsic role to play in relation to the exclusion from registration; there is accordingly no interplay to be considered as between the scope of the exclusion from registration and the scope of the exclusion from liability for infringement of the rights conferred by a valid registration: Technopol paras. [59] to [62].
- (5) In order for the exclusion from registration to apply, it must be reasonable to believe that in the mind of the relevant class of persons the sign in question will actually be recognised as a description of one of the '*characteristics*' of the goods

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or services in respect of which registration is sought: Technopol paras. [50], [52] and [56].

- (6) The examination of the application for registration must be stringent and full. It must be undertaken on the basis that the registration of a sign as a mark depends on specific criteria, which are applicable in the particular case and the purpose of which is to ascertain whether the sign at issue is caught by the ground for refusal that is under consideration: Technopol para. [77].

20. The assessment should take account of all the circumstances in which the mark applied for might be used if it were to be registered cf. Case C-533/06 O2 Holdings Ltd v. Hutchison 3G UK Ltd EU:C:2008:339 at para. [66]. 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. Content and character can serve to contextualise a sign as an indication of involvement by a particular person or organisation in the marketing of ‘official’ goods or services. It is relevant to bear in mind that the beliefs and expectations of consumers are liable to be influenced by their awareness of what is typical in relation to the marketing of goods or services such as those to which the application for registration relates.

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. And as she pointed out, see paragraph [12] above, the evidence filed on behalf of the Applicant not only failed to establish that the designations had acquired a distinctive character through use, but also demonstrated the correctness of the determination as to descriptiveness which mandated refusal of registration.

24. The Applicant put forward three points in support of its request for a reference to the CJEU under Article 267 TFEU: (1) there is uncertainty as to whether subsistence and ownership of copyright can or should be factored into the examination of a sign for

distinctiveness in cases concerning the registrability of designations such as those in issue here; (2) there is uncertainty as to whether the concept of descriptiveness can or should be applied so broadly in relation to goods and services conveying images or information as to prevent registration of the name of anyone or anything reasonably and foreseeably likely to be the 'subject matter' of images or information thereby conveyed; (3) there is uncertainty as to whether the concept of descriptiveness can or should operate as a 'penalty for success' when assessing whether famous names are registrable as trade marks for such goods and services. Examples were provided (as symptoms of the existence of uncertainty) of what were said to amount to different approaches being applied by trade mark registration authorities within the EU in relation to the acceptance of titles for registration as trade marks.

25. As to point (1), I think it is clear that a designation may serve, in trade, to identify the content or character of goods or services conveying images or information if it is known and recognised as the name of something, and none the less so because it is known and recognised as the name of something which may never have been, once was, still is or may soon cease to be protected by copyright. The pattern of trade in goods or services conveying images or information about something can, of course, be affected by the existence or absence of related copyright protection. The existence or absence of related copyright protection may in that way come to have a bearing on whether the designation in question is or is not liable to be regarded as descriptive of content or character by the relevant class of persons. The resulting state of affairs would be a factual circumstance which falls to be taken into account as envisaged by Article 6quinquies (C1) of the Paris Convention: 'In determining whether a mark is eligible for protection, all the factual

circumstances must be taken into consideration, particularly the length of time the mark has been in use'. I do not think there is any real room for uncertainty about the way in which ownership and exploitation of copyright may have a factual role to play in the assessment, nor do I think there is any uncertainty as to the role played, inconsequentially from a trade mark point of view, by ownership and exploitation of copyright in the present case.

26. As to point (2), it is correct that the logic of the descriptiveness objection, as applied to the particular designations in issue with respect to the particular goods and services in issue, has the potential – if not moderated – to be expanded into an all-encompassing basis for refusing to register the name of anyone or anything for goods or services conveying images or information about that person or thing. At paragraph [18] of my decision in FLYING SCOTSMAN Trade Mark I identified (with reference to the case law I cited) the moderating factors which appeared to me to prevent excessively broad application of the concept of descriptiveness for the purposes of the exclusion from registration. I have repeated those factors in paragraph [20] above and kept them in mind when considering the correctness of the Hearing Officer's reasoning and determinations. The designations in issue in the present case are quite naturally understood as explanatory with regard to 'subject matter'. I cannot see any reason why the 'subject matter' they serve to describe should not be regarded as 'a property, easily recognisable by the relevant class of persons, of the goods or services in respect of which registration is sought' in accordance with the existing case law of the CJEU (see, in particular, paragraph [19(2)] above) and in accordance with the evidence on file. In my view, the application of the law to the facts of the present case is not affected by uncertainty about

the scope or effect of any moderating factors preventing excessively broad application of the concept of descriptiveness in relation to goods and services conveying images or information.

27. As to point (3), a sign can simultaneously be famous for denoting someone or something and descriptive of the content or character of goods or services with reference to which it is used. If that is, in fact, the case the sign is liable to be excluded from registration in relation to goods of the kind for which it is descriptive. As happened, for example, in BACH and BACH FLOWER REMEDIES Trade Marks [2000] RPC 513. It cannot be said that fame necessarily enables a sign to individualise goods or services of all kinds to a single economic undertaking. I do not think there is any real room for uncertainty about that, nor do I think that there is, with regard to the particular designations in issue in relation to the particular goods and services in issue, any uncertainty about fame coinciding with descriptiveness in the present case.

28. The Applicant provided 'state of the register' information to indicate differences of approach within the EU to the registration of titles (including equivalents in other languages of the designations in issue here) as trade marks. However, there was a general lack of published guidance on official practice in the countries referred to. The comments of practitioners recorded in the Applicant's written representations did not make up for that shortfall in information. Some of the countries referred to had special regimes in place for the protection of titles as rights ancillary to authorship and ownership of copyright. In the instances where particular titles were identified as having been accepted for registration at the national level, it is not apparent that there would necessarily have been a 'stringent and full' assessment of them for registrability as envisaged by the case

law of the CJEU. The English translation provided by the Registrar of the Judgment of the Brussels Court of Appeal (see paragraphs [15] and [16] above) continued to be the only reasoned decision put forward for consideration in relation to the practice of trade mark registration authorities outside the United Kingdom. The practice of the UK Intellectual Property Office was criticised for being inconsistent in itself. The published guidelines of the Community Trade Marks Office were said to envisage, on the basis of unsound reasoning, that a title would be refused registration ‘in essence, because it is a title and nothing more’.

29. This information does not demonstrate that the United Kingdom is interpreting and applying the descriptiveness exclusion from registration in a way that differs from the way in which it is or would be interpreted and applied by courts and tribunals in other Member States acting on the principles established by the case law of the CJEU noted in paragraph [19] above. As to the approach adopted by the Community Trade Marks Office, it appears from paragraphs [26] to [28] of the recent decision of the Second Board of Appeal in Case R 1856/2013-2 Yves Fostier v Disney Enterprises Inc (25 February 2015) that this is basically consistent with the position adopted in the United Kingdom. In paragraph [13] of the formal Recommendations issued following upon the adoption of new rules of procedure in September 2012 (OJ C338/1, 6.11.2012) the CJEU confirmed that ‘... a national court or tribunal may, in particular when it considers that sufficient guidance is given by the case law of the Court of Justice, itself decide on the correct interpretation of European Union law and its application to the factual situation before it. ...’. I consider that to be the position here. The present case does not, in my view, test the

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limits of established principles of EU law. I have therefore proceeded to determine the Appeal without making an order for reference under Article 267 TFEU.

30. The Appeal is dismissed. In accordance with the usual practice of regarding appeals such as the present as a continuation of the Registry proceedings, I make no order for costs either against or in favour of the Applicant or the Registrar.

Geoffrey Hobbs QC

11 June 2015

Simon Malynicz instructed by Kilburn & Strode LLP appeared as counsel for the Applicant.

Dr Bill Trott appeared on behalf of the Registrar.