

EUIPO refuses to register mark representing Charlie Chaplin character

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- Roy Export SAS filed an EUTM application for a figurative mark representing Charlie Chaplin's Tramp character in Classes 9, 35, 38, 41 and 42
- The EUIPO found that the sign would be not perceived by the relevant consumers as an indicator of origin
- The sign served as a mere promotional message due to the positive values associated with the Tramp character

On 3 January 2023 the European Union Intellectual Property Office (EUIPO) [refused](#) EUTM application No 018141170 (depicted below) for goods and services in Classes 9, 35, 38, 41 and 42 pursuant to Articles 7(1)(b) and (c) of Regulation 2017/1001.



Background

On 22 October 2019 Roy Export SAS filed an EUTM application for the above figurative mark for goods and services in Classes 9, 35, 38, 41 and 42.

The EUIPO refused the application on the basis of a lack of distinctiveness and descriptiveness pursuant to Articles 7(1)(b) and (c), as well as Article 7(2) of the regulation.

Lack of distinctive character

The EUIPO first considered that, given the exceptional reputation of the character portrayed, the relevant public - namely, the general public, as well as businesses, professionals and specialists - would recognise the sign as representing 'the Tramp' (known as 'Charlot' in several countries), the famous comic and iconic character interpreted by Charlie Chaplin.

Further, the EUIPO considered that this character embodied and conveyed positive modern, liberal and humanist values throughout the world.

In light of the above, it concluded that the sign in question would be not perceived by the relevant consumers as an indicator of origin; rather, due to the positive values associated with the character, it would be perceived simply as a promotional advertising message, whose sole purpose is to induce or provoke the purchase of the products or the subscription to the services in question.

In this respect, the EUIPO further noted that the use of the image of famous film characters associated to trademarks exclusively for advertising purposes is relatively common in many sectors. In particular, it noted that the Tramp character had been associated for several years with the promotion of IBM products.

Therefore, it concluded that the mark did not fulfil its function as an indicator of commercial origin of the goods and services, but instead served as a mere promotional message due to the positive values associated with the character of the Tramp that simply reinforced the attractiveness of the goods and services in question.

Descriptiveness

The EUIPO also concluded that the sign was descriptive of the characteristics of certain services in Class 41 (educational, recreational and cultural services, as well as related information services), since it provided information on the thematic content of such services, namely the character of Charlie Chaplin and/or the films in which that character was portrayed.

Comment

This decision is somewhat surprising as the EUIPO relied on the values associated with the character portrayed by Charlie Chaplin as being such as to render the mark non-distinctive and thus non-registrable, due to the positive advertising message conveyed by such values.

Arguably, this creates a new factor that must be taken into consideration in the assessment of the registrability of a mark - namely, the values that a sign conveys to the relevant public.

Indeed, over the past few years, the EUIPO has examined a number of applications for figurative marks depicting a famous person or character, notably the Mona Lisa (see the EUIPO decision dated 13 February 2023 refusing protection to International Registration No 1694418; in this case, the application was also rejected on the basis of a lack of distinctive character under Article 7(1)(b), although with a different reasoning - namely, that it would simply be seen as a decorative embellishment of the goods claimed in Class 11).

Therefore, it appears that, when it comes to these types of signs, the fame and repute of a character may not be interpreted as increasing its distinctive character but, rather, as having the effect of rendering the sign unlikely to be perceived by consumers as an indicator of commercial origin.

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