

## Animation video eligible to be registered as multimedia mark

Mathijs Peijnenburg and Moira Truijens  
Hoogenraad & Haak, Advertising + IP Advocaten  
05 June 2023



### EUROPEAN UNION

Legal updates: case law analysis and intelligence

- The EUIPO examiner refused an application for an animation video on the ground that it was devoid of any distinctive character
- The Board of Appeal disagreed, finding that the video was not too complex and allowed the relevant public to remember the 'Super Simon' character
- The mere fact that the application was a video did not mean that it should be compared to a TV commercial

In [Case R 1490/2022-5](#), the Fifth Board of Appeal of the European Union Intellectual Property Office (EUIPO) has overturned a decision of the EUIPO refusing a trademark application for an [animation video](#) on the ground that it was devoid of any distinctive character in relation to the goods and services applied for.



The Board of Appeal held - most importantly - that:

- the animation video did satisfy the requirement of distinctiveness;
- there were no stricter requirements for the registration of multimedia marks; and

- multimedia marks should not be compared to TV commercials.

## Background

On 7 May 2019 Chiever BV submitted an application for registration of an animation video depicting 'Super Simon' saying goodbye to his colleagues and flying off to a sunny holiday destination, where he sits by the pool and enjoys a drink. The goods and services applied for were:

- "books, including thick books and biographies" in Class 16;
- "wine, including self-imported Luxembourgish wines, Elzasser Pinot Noir and chilled red wines" in Class 33; and
- "relaxation; cultural activities; traditional music performances" in Class 41.

On 13 June 2022 the examiner refused the trademark application in its entirety on the grounds that it was devoid of any distinctive character. The EUIPO held that:

- the animation video would be perceived only as a funny animation video, but not as an indication of origin; this was partly because the video would be too complex;
- the animation video did not refer to a particular commercial source as an indication of origin; and
- the animation video did not refer to the goods and services for which the trademark application was submitted.

This led Chiever to file an appeal before the Fifth Board of Appeal.

## Board of Appeal decision

The Board of Appeal annulled the decision of the EUIPO and ruled that the trademark application should be accepted for publication.

Contrary to the examiner, the Board of Appeal judged that the animation video was not too complex and allowed the relevant public to remember the main character 'Super Simon' and the narrative of him flying off to a holiday destination. This alone would be distinctive enough for the relevant public, which did not have to remember all details from the animation video.

Additionally, there are no stricter requirements for a multimedia trademark when it comes to referring to the commercial source. The Board of Appeal judged that it is not required that the trademark provides precise information on the identity of the manufacturer of the product or of the service provider, like a TV commercial would. It suffices that the multimedia mark allows the relevant public to distinguish the goods and services for which it is registered from those of a different commercial origin. Further, the mere fact that the trademark application was a video did not mean that it should be compared to a TV commercial.

Lastly, the Board of Appeal found, contrary to the examiner's position, that a trademark should *not* refer to the goods and services for which it is applied. This is because, from the moment a trademark refers directly and exclusively to certain goods and services, it becomes descriptive or non-distinctive. Therefore, the absence of the goods in Classes 16 and 33 and the services in Class 41 in the animation video did not hinder the distinctive character of the mark.

## Comment

This decision will pave the way for more animation videos to be registered as trademarks. Nevertheless, only time will tell whether more will follow and how these trademarks will be used in practice.

---

### Mathijs Peijnenburg

Author | Associate

[mp@hoogenhaak.nl](mailto:mp@hoogenhaak.nl)

Hoogenraad & Haak

---

### Moira Truijens

Author | Partner

[mt@hoogenhaak.nl](mailto:mt@hoogenhaak.nl)

Hoogenraad & Haak