

# Portraits as Trademarks: A Doctrinal and Practical Analysis of EUIPO Case Law on Facial Image Signs

by Barna Arnold Keserű \*

**Abstract:** This article examines the increasingly relevant and doctrinally complex question of whether photorealistic human faces can serve as valid and protectable trademarks under European Union law. Drawing on updated empirical data, evolving EUIPO case law, and critical third-party interventions—including the amicus curiae brief submitted by INTA in the Smit case—the study interrogates the normative and institutional limits of trademark distinctiveness when applied to facial images. The research applies to doctrinal legal methodology supported by empirical observations and comparative references, with a focus on European legal sources and procedural developments. It evaluates the registrability, scope of protection, and practical enforceability of facial image trademarks in light of estab-

lished principles of trademark law, including the requirement of distinctiveness, genuine use, and the limitations arising from personality rights and public interest. Particular emphasis is placed on the conceptual distinction between personal identity and commercial origin, the merger of service and sign in the context of modeling services, and the doctrinal thresholds for enhanced protection based on reputation. The findings indicate that while facial trademarks are gradually gaining acceptance, their registration raises unresolved theoretical and practical challenges that requires careful legal scrutiny and, potentially, legislative clarification to ensure coherence with the foundational objectives of trademark protection.

**Keywords:** Trademark, Right to Image, Portrait Marks, EUIPO

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## A. Introduction

1 The question of whether photorealistic facial images can be protected under trademark law remains a subject of continuing legal and practical relevance. Although human faces are among the most distinctive features of personal identity, their transformation into legally protectable commercial signs raises profound doctrinal, normative, and institutional questions. The core issue is whether the legal framework governing trademarks – originally developed to serve the interests of commercial source identification – can or should be extended to accommodate images of human faces in the absence of textual or graphic embellishments. This trajectory forms part of a broader turn towards non-traditional signs and multisensory branding, driven by intensified competition and affect-based consumer

decision-making; brand communication increasingly seeks to engage multiple senses rather than relying on a single visual cue.<sup>1</sup> The importance of non-traditional signs has grown with the advent of fourth industrial revolution, high level of digitalization and artificial intelligence, which gradually transforming our lives.<sup>2</sup>

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1 Lilla Fanni Szakács, 'Új típusú védjegyek - középpontban a színvédjegyek' (2013) 8 Iparjogvédelmi és Szerzői Jogi Szemle 40, 48.

2 Máté Frank, 'Contractual Dilemmas of Smart Contracts: Information Society Versus Contract Law' (2023) 15 Jog Állam Politika: Jog- És Politikatudományi Folyóirat 63, 63.

- 2 This article builds upon prior research that explored whether the right to one's facial image, as traditionally protected under private law, can provide sufficient legal safeguards against unauthorized commercial use, thereby potentially obviating the need for trademark protection. That earlier study provided a systematic comparison between personality rights and European trademark law across twelve legal dimensions, concluding that while trademark law may offer advantages in terms of transferability, enforcement, and temporal continuity, it also risks unsettling normative assumptions about personal autonomy and human dignity.<sup>3</sup> That article was based on an empirical review of European Union trademark applications submitted up to 26 November 2023, focusing exclusively on those consisting of photorealistic human faces without any additional elements such as names, logos, or ornamental designs. The findings suggested a rising number of such registrations, particularly following 2021, with a notable concentration in fashion-related and model-portrait applications. Since the time of that original data collection, only a modest number of new applications have been submitted that fit this narrow definitional category - i.e., trademarks consisting solely of photorealistic facial images without any clearly distinctive or dominant secondary elements. Specifically, only two new applications featuring female faces<sup>4</sup> and five with male faces<sup>5</sup> have been filed until 28.07.2025. There have been no new applications involving children's faces that meet the same criteria.
- 3 Despite the relative novelty of this phenomenon, the trademark protection of faces is no longer an abstract legal possibility but a steadily expanding reality. Empirical data shows a moderate increase in applications for such signs within the European Union Intellectual Property Office (hereinafter EUIPO), particularly since 2021, with dozens of registered trademarks consisting exclusively of facial images - many of them representing models, athletes, or AI-generated personas. This trend is doctrinally relevant, as it tests the limits of what

constitutes a distinctive sign under Article 4 of Regulation (EU) 2017/1001 (hereinafter EUTMR) and challenges the applicability of the absolute grounds for refusal set out in Article 7(1) of EUTMR.

- 4 The ongoing relevance of this issue is underscored by several legal proceedings, including the pending *Johannes Hendricus Maria Smit v EUIPO* case before the Grand Board of Appeal.<sup>6</sup> In that matter, the registrability of a portrait photo as an EU trademark has become a point of legal contention, generating extensive analysis and commentary. Notably, the International Trademark Association (hereinafter INTA) submitted a third-party amicus curiae brief in the appeal proceedings, emphasizing the broader implications of facial image trademarks for trademark law, personality rights, and public policy. INTA's intervention specifically addresses the conceptual tensions between a face as a personal identifier and as a commercial signifier, and it seeks to influence the development of coherent, consistent adjudicatory standards. An additional level of the problems - which remains outside of the scope of the article - when facial images are used in virtual spaces like video games or metaverse.<sup>7</sup>
- 5 This study aims to extend the existing analytical framework by integrating recent case law, policy statements, and stakeholder interventions into a deeper normative and doctrinal evaluation. Particular attention will be devoted to the *Smit* case and the INTA brief, which offer valuable insights into the evolving jurisprudence and institutional perspectives concerning face-based trademarks. The central question remains whether the legal recognition of human faces as trademarks represents a permissible evolution of intellectual property norms or a conceptual overreach with far-reaching consequences for the balance between commercial and personal rights.

## B. Methods

- 6 This study applies a doctrinal legal research methodology, supported by case law analysis. Its primary aim is to assess the evolving legal framework governing the registrability of photorealistic human faces as trademarks within the European Union. Applications where the image is accompanied by text, stylized distinctive background, graphical enhancement, or any design elements that may independently carry distinctive force are excluded from the scope of this study. The reason for this

3 Barna Arnold Keserű, 'Trademark Protection for Faces? A Comprehensive Analysis on the Benefits and Drawbacks of Trademarks and the Right to Facial Image' (2024). A similar investigation was carried out from an American perspective by Jennifer E Rothman, 'Navigating the Identity Thicket: Trademark's Lost Theory of Personality, the Right of Publicity, and Preemption' (2021) 135 Harvard Law Review 1271.

4 The female face applications: 019208620 is already published, 019116918 is under examination at the time of writing this article.

5 The male face applications: 019088469 application is withdrawn, 019094091 and 019146115 applications are already registered, 019120537 and 019138872 applications are currently under examination.

6 EUIPO Grand Board of Appeal, Case R 50/2024-2.

7 Péter Szalai, 'A képmásvédelem egyes kérdései a virtuális térben' in Gergely G. Karácsony (ed), *A videojátékok jogi kérdései* (Széchenyi István Egyetem 2021).

methodological decision is simple: once such additional elements are introduced, the legal evaluation of distinctiveness becomes multifactorial, and it is no longer clear whether the facial image itself plays a decisive role in the overall perception of the sign.

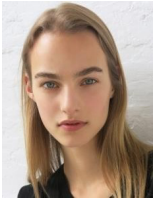


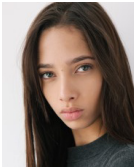
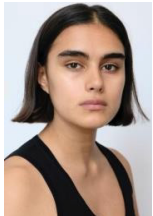
- 7 The article builds upon earlier research, while integrating newly emerging legal materials and procedural developments. The method is threefold: (i) normative analysis of relevant EU legal sources and jurisprudence; (ii) qualitative assessment of selected administrative and judicial decisions; and (iii) contextual interpretation *amicus curiae* brief submitted by the INTA in the *Smit v EUIPO* case. The trademark case law of the EU is not only relevant for EU countries but also for other European or overseas countries as in recent years the European regulatory power has enhanced and exported by the extraterritorial scope of GDPR, DMA and AI Act, which places a higher global awareness on the EU legislation and case law.<sup>8</sup>
- 8 This brief provides a unique perspective on the institutional concerns of trademark professionals, brand owners, and IP scholars. Its arguments are examined not merely as advocacy positions, but as indicators of evolving interpretative frameworks and policy orientations within the trademark community.
- 9 The INTA brief is assessed using both legal-normative and policy-analytical tools. The study critically evaluates INTA's reasoning concerning the distinctiveness of facial images, their eligibility as signs, and the interaction between trademark rights and personality rights. Particular focus is given to the extent to which INTA's intervention aligns with or challenges the prevailing doctrines of EU trademark law.
- 10 The study further examines selected case decisions of the EUIPO Boards of Appeal that reflect pivotal developments in the interpretation of portrait marks, including decisions concerning Dutch models (Maartje Verhoef, Rozanne Verduin, Yasmin Wijnaldum, Jill Kortleve, and Puck Schrover) as well as the *Smit* case, currently pending before the Grand Board of Appeal. These decisions are analyzed in terms of the legal reasoning adopted, internal consistency, and doctrinal coherence.
- 11 It must be acknowledged that the study is limited to the European Union legal and institutional context. Nonetheless, the core doctrinal questions concerning

distinctiveness, subject matter, and the interplay between IP and dignity are broadly relevant across legal systems.

## C. Recent EUIPO Case Law

- 12 Although the number of trademark applications consisting solely of photorealistic human faces remains limited, the legal significance of these applications has increased considerably in recent years. The decisions rendered by the Boards of Appeal of the EUIPO demonstrate a clear trend towards the acceptance of such portrait marks, even in cases where the signs lack any textual, figurative, or design-based elements that could otherwise enhance their distinctive character.
- 13 The table below presents a selection of recent cases that illustrate this trend. In each of these instances, the application concerned a photorealistic depiction of a human face, typically styled as a passport-style portrait, and devoid of names, logos, stylized backgrounds, or additional graphic components. At the first instance, the EUIPO Examiners uniformly rejected these applications based on the alleged lack of inherent distinctiveness, often citing the general assumption that photographs of faces are commonly used in advertising and thus do not serve a trademark function.
- 14 However, upon appeal, the respective Boards of Appeal systematically overturned these refusals. In each case, the Boards concluded that the facial image in question did possess sufficient distinctiveness to be eligible for registration as a European Union trademark.

<sup>8</sup> Gábor Hulkó, János Kálmán and András Lapsánkszy, 'The Politics of Digital Sovereignty and the European Union's Legislation: Navigating Crises' (2025) 7 *Frontiers in Political Science* 1, 1.

The Sign	Examiner's Decision	Board of Appeal Decision
 EUTM 14679351	Refused according to EUTMR Article 7 (1)(b)(c) due to lack of distinctiveness and exclusively descriptive signs.	Nullified the decision on 16/11/2017, the trademark is registered. <sup>9</sup>
 EUTM 17916623	Refused according to EUTMR Article 7 (1)(b) due to lack of distinctiveness.	Nullified the decision on 23/10/2019, the trademark is registered. <sup>10</sup>
 EUTM 17358458	Refused according to EUTMR Article 7 (1)(b) due to lack of distinctiveness.	Nullified the decision on 19/05/2021, the trademark is registered. <sup>11</sup>
 EUTM 17953534	Refused according to EUTMR Article 7 (1)(b) due to lack of distinctiveness.	Nullified the decision on 19/05/2021, the trademark is registered. <sup>12</sup>
 EUTM 18640603	Refused according to EUTMR Article 7 (1)(b) due to lack of distinctiveness.	Nullified the decision on 04/12/2023, the trademark is registered. <sup>13</sup>

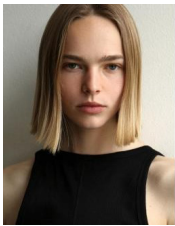

<sup>9</sup> EUIPO, Decision of the Fourth Board of Appeal of 16 November 2017, in the case R 2063/2016-4 (EUTM 014679351)

<sup>10</sup> EUIPO, Decision of the First Board of Appeal of 23 October 2019, in the case R 2574/2018-1 (EUTM 17916623).

<sup>11</sup> EUIPO, Decision of the Fourth Board of Appeal of 19 May 2021, in the case R 378/2021-4 (EUTM 018864324).

<sup>12</sup> EUIPO, Decision of the Fourth Board of Appeal, 19 May 2021, in the case R 468/2021-4 (EUTM 017953534).

<sup>13</sup> EUIPO, Decision of the Fourth Board of Appeal of 4 December 2023, in the case R 1704/2023-4 (EUTM 018640603).

 EUTM 18864324	Refused according to EUTMR Article 7 (1)(b) due to lack of distinctiveness.	Nulled the decision on 30/01/2024, the trademark is registered. <sup>14</sup>
 EUTM application 014711907	Refused according to EUTMR Article 7 (1)(b)(c) due to lack of distinctiveness and exclusively descriptive signs.	Currently pending before the Grand Board of Appeals.

1. Table The EUIPO case law on portrait trademarks filed before 2024. Compiled by the author.

- 15 This consistent nullification of first-instance decisions suggests an evolving institutional approach within the EUIPO, one that is increasingly open to the registration of portrait marks, provided that the face depicted is sufficiently specific and does not merely reproduce a generic or symbolic human figure. It also underscores a growing divergence between the conservative stance of examiners – who tend to rely on established refusal criteria – and the liberal analysis applied by the Boards of Appeal. For this reason, the appeal in the *Smit v. EUIPO* case – the last row in the table above – was referred from the Second Board of Appeal to the Grand Board of Appeals, which body has the jurisdiction in the legally difficult or important cases.<sup>15</sup> The divergent case law requires some guidance and uniformization.
- 16 These decisions have not remained without systemic effect. In the wake of the consistent rulings of the Boards of Appeal, the EUIPO's examination practice appears to be undergoing a gradual but noticeable transformation. While initial rejections of facial image trademarks were previously the norm, recent applications that similarly consist solely of photorealistic portraits – free from additional distinctive elements – have increasingly proceeded through the registration process without significant objection or delay.

- 17 Against this backdrop, the pending decision in the *Smit* case – one of the last unresolved applications filed under the earlier framework – acquires particular significance. As the case has been referred to the Grand Board of Appeal, its outcome is expected to carry precedential weight well beyond the individual application. The decision may serve as a capstone to the evolving jurisprudence on facial trademarks, either confirming the doctrinal shift initiated by the Boards of Appeal or redefining its contours. In this sense, the *Smit* case has the potential to mark the closure of a transitional period in EUIPO practice, providing legal clarity and guidance for future assessments of whether and when a human face can function as a protectable trademark sign.

## D. The Boards of Appeal on the Absolute Grounds of Refusals

- 18 The Boards of Appeal, in their recent rulings mentioned above rendered in the course of appeals concerning facial image trademark applications, have consistently taken the following position regarding the applicability of absolute grounds for refusal. The wording of the decisions is almost identical.
- 19 The signs examined in the given cases are clearly and unmistakably the image of

14 EUIPO, Decision of the Fourth Board of Appeal of 30 January 2024, in the case R 2173/2023-4 (EUTM 018864324).

15 EUIPO Second Board of Appeal, Interim Decision in the case R 50/2024-2 (EUTM 14711907) (26 September 2024).



specific individuals, featuring their unique facial features, presented in the format of passport-style photographs. As such, it cannot be presumed that the relevant public would perceive these images as descriptive of the goods or services within the meaning of Article 7(1)(c) of EUTMR.<sup>16</sup> This is in line with the theory that allowing appropriation of nondistinctive elements would effectively confer exclusivity over the information that lowers search costs for rivals and consumers, so the social result would be higher prices and lower output.<sup>17</sup> However, according to the Boards, it is not evident that the relevant public, upon seeing the face of these women, would immediately associate the image with the target audience of the goods or services. In fact, all possible goods and services – by their nature – are directed either at a male or female audience, and the depiction of a particular woman does not automatically lead to the conclusion that the products are intended for women. Numerous female fashion designers, for instance, release men's collections under their own name.<sup>18</sup>

- 20 Contrary to the examiners' opinion, according to the Boards, it is reasonable to assume that the relevant public would perceive the sign as an indication of the commercial origin of the goods and services in question – that is, as referring to the person depicted. In doing so, the sign would be capable of performing the essential function of a trademark. It is not necessary for a trademark to provide exact information about the identity of the manufacturer of the goods or the provider of the services. It is sufficient that the trademark enables the relevant public to distinguish the goods or services bearing the mark from those of a different commercial origin.<sup>19</sup>
- 21 The Boards acknowledged that assessing the distinctiveness of photographs depicting individuals may be more complex.<sup>20</sup> However, this does not imply that trademarks consisting of such images are automatically excluded from registration, provided that the image can be readily interpreted

as indicating the commercial origin of the relevant goods or services, and that the public is able to distinguish them without a risk of confusion from those offered by other undertakings. In addition to a person's first and last name, the depiction of their face – especially in the format of a passport-style photograph – may serve to identify that individual and distinguish them from others. As such, it is capable of fulfilling the core function of a trademark, namely that of guaranteeing origin.

## E. Theoretical and Practical Concerns of Portrait Trademarks

### I. Can a Human Face Perceived as a Sign?

- 22 Trademark law, in its most essential function, serves the purpose of distinguishing the goods or services of one undertaking from those of another.<sup>21</sup> The mark actually sells the goods. And, self-evidently, the more distinctive the mark, the more effective is its selling power.<sup>22</sup> Trademarks serve as essential tools of communication between producers and consumers by conveying concise, symbolic information about the characteristics and origin of goods, thereby influencing purchasing decisions across various sectors of economic and social life.<sup>23</sup> This distinguishing and informative function – frequently referred to as the *source-identifying function* – is not only doctrinally fundamental but also serves as the ontological justification for trademark protection as a branch of intellectual property law.<sup>24</sup> Both the EUTMR and the Trademark Directive (EU) 2015/2436 (hereinafter EUTMD) emphasize this principle: only those signs are eligible for registration which are capable of distinguishing goods or services in the course of trade.<sup>25</sup> Within this conceptual framework, the question arises whether a human face, particularly in the form of a photorealistic portrait, is capable of fulfilling this basic legal function. Is the human face, in itself, or as a photo, a sign in the legal

16 EUIPO Fourth Board of Appeal, Case 2063/2016-4, paras 19–20.; Case R 468/2021-4, para 16.; Case R 378/2021-4, para 16.; Case R 1704/2023-4, para 21.; Case R 2173/2023-4, para 21.

17 William M Landes and Richard A Posner, 'Trademark Law: An Economic Perspective' (1987) 30 *Journal of Law & Economics* 265, 289.

18 EUIPO Fourth Appeal Board, Case 2063/2016-4, para 21.

19 EUIPO Fourth Board of Appeal, Case 2063/2016-4, para 30; Case R 378/2021-4, para 10; Case R 468/2021-4, para 10; Case R 2173/2023-4, para 13; Case R 1704/2023-4, para 13.

20 For the CJEU case law on the assessment of distinctiveness see Péter Szalai, *A megkülönböztető képesség jelentése a védjegyjogban* (Universitas-Győr Nonprofit Kft 2015) 101–131.

21 Case C-39/97, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* ECLI:EU:C:1998:442, para 28.

22 Frank Isaac Schechter, 'The Rational Basis of Trademark Protection' (1927) 40 *Harvard Law Review* 813, 819.

23 Case C-236/08 *Google France SARL and Google Inc. v Louis Vuitton Malletier SA* ECLI:EU:C:2010:159, para 77; Péter Szalai, 'The Possibilities of Trademark Law in the Service of Sustainable Development, with an Outlook on the Possibilities of State Involvement' (2024) *Rechtskultur: Zeitschrift für Europäische Rechtsgeschichte* 565, 569.

24 Anette Kur and Thomas Dreier, *European Intellectual Property Law* (Edward Elgar 2013) 157.

25 EUTMR Art. 4(a), EUTMD Art. 3(a).

sense? Can it reliably and unequivocally indicate the commercial origin of goods or services?

- 23 This issue is particularly complex in the context of the European Union, a jurisdiction comprising 27 Member States and a population of approximately 450 million individuals. In such a vast and culturally diverse market, the threshold for what counts as inherently distinctive is correspondingly high. The average consumer is presumed to possess an ordinary level of attention, but not necessarily the capacity to recall or differentiate subtle visual elements with high precision.<sup>26</sup> It is particularly true when the sign in question lacks textual or stylised features.
- 24 Although Court of Justice of the European Union (hereinafter CJEU) has not yet ruled directly on the registrability of facial images, its jurisprudence on distinctiveness provides general principles that apply to all categories of signs. In landmark cases such as *Canon* (C-39/97),<sup>27</sup> *Linde* (C-53/01-55/01),<sup>28</sup> *Libertel* (C-104/01),<sup>29</sup> *Heidelberger Bauchemie* (C-49/02)<sup>30</sup> and *Storck* (C-25/05 P)<sup>31</sup>, the Court draw the boundaries of concept of sign, and consistently underlined that a sign must be capable of indicating the commercial origin of goods or services, and that the assessment of distinctiveness must be carried out in relation to the perception of the relevant public.
- 25 The CJEU dealt with the notion of sign in the *Sieckmann* case (C-273/00). In his opinion Advocate General Colomer indicated that any message capable of sensory perception could function as a trademark.<sup>32</sup> In the *Libertel* case it was pointed out that colors per se cannot be presumed to constitute a sign but per se are capable to be a sign depending on the context in which they are used. So, one of the prerequisites of the trademark protection – to be a sign – can be fulfilled if the context supports it.<sup>33</sup> In the *Heidelberger Bauchemie* case Advocate General Léger argued in the ordinary sense of the term, a sign is a thing perceived which demonstrates

the existence or truth of another thing, to which it is linked. A sign is therefore something which is perceived and which can be identified as such.<sup>34</sup> In the same case the court held that the requirement of being a sign aims to prevent the abuse of trademark law in order to obtain an unfair competitive advantage.<sup>35</sup>

- 26 In the *Dyson* case (C-321/03) Advocate General Léger and the Court discussed the concept of sign extensively, but the decision is somewhat disappointing as it did not give a positive definition but negative description of what does not constitute a sign in the case.<sup>36</sup>
- 27 Regarding to portrait trademarks, INTA notes that the EUIPO Fifth Board of Appeal found in 2015 that representations of human beings are not precluded from being perceived as distinctive signs.<sup>37</sup> This conclusion was repeated in the above cases by the Boards of Appeal.
- 28 The author contests this approach. Figurative signs are one of the most common types of trademarks, those per se can be seen by the consumers as signs. However, if they consist only of a human face (as most of the portrait trademarks are filed as figurative signs), the question may arise whether they can be seen as figurative signs or not. The author argues that in these cases the average consumers do not perceive faces as commercial signs. An instructive analogy may be drawn from the *Libertel* case, in which the CJEU held that colors per se cannot automatically be regarded as signs, yet may acquire the capacity to function as such depending on the manner and context of their use in trade. A similar reasoning could apply to facial images: although a human face, taken in isolation, may not inherently be perceived as a sign, the context in which it is used may render it capable of functioning as an indication of commercial origin. This suggests that the registrability of facial image marks should not be assessed in absolute terms, but rather in relation to the market practices, consumer perception, and the specific use of the image in question.

## II. The Distinctiveness of Faces

- 29 If faces can be perceived as signs, the next important question is whether they are capable of distinguishing goods and services or not. In the above EUIPO cases the assessment of being a sign and being distinctive

26 Sándor Vida, 'Az "átlagos fogyasztó" az európai és a német védjegyjogban' (2004) 109 Iparjogvédelmi és Szerzői Jogi Szemle.

27 Case C-39/97, paras 27-28.

28 Case C-53/01-55/01 *Linde AG, Winward Industries Inc. v Rado Uhren AG* ECLI:EU:C:2003:206, para 40.

29 Case C-104/01 *Libertel Groep BV. v Benelux Merkenbureau* ECLI:EU:C:2003:244, para 62.

30 Case C-49/02 *Heidelberger Bauchemie GmbH* ECLI:EU:C:2004:384, para 16.

31 Case C-25/05 P *August Storck KG v Office for Harmonisation in the Internal Market (Trade marks and designs)(OHIM)*, ECLI:EU:C:2006:422, para 26.

32 Alexander von Mülhendahl and others, *Trade Mark Law in Europe* (Oxford University Press 2016) 53.

33 Case C-104/01, para 41.

34 Opinion of Advocate General Léger, C-49/02, para 63.

35 Case C-49/02, para 24.

36 von Mülhendahl and others (n 32) 60.

37 INTA: Amicus Brief (Third Party Observations), Case R 50/2024-2, para 10.

merge together under the scope of Article 7 of EUTMR, but theoretically they are separate problems as it is outlined in the case law. The third criterion of a trademark is the clear and precise representation (previously graphical representation) of the mark, but this one is not relevant from the scope of this paper as it obviously fulfills in the case of portrait trademarks.<sup>38</sup>

- 30 Theoretically, a distinction can be drawn between objective and subjective distinctiveness. Objective distinctiveness corresponds to the requirement enshrined in Article 4 EUTMR, namely that a sign must, by virtue of its inherent characteristics and irrespective of place or time, be capable of distinguishing goods or services from one another. This assessment is based exclusively on the features of the sign itself, independent of external factors. Subjective distinctiveness, by contrast, reflects the approach of Article 7(1)(b) of EUTMR, which requires an evaluation of whether the sign is actually capable of fulfilling its origin-indicating function in the light of the market conditions, the linguistic environment, and the commercial practices existing on the filing date of the application. In this sense, while objective distinctiveness establishes a theoretical capacity of the mark, subjective distinctiveness grounds the assessment in empirical and contextual realities.<sup>39</sup> However the CJEU applied a different approach in the *Phillips* case (C-299/99) where the court held that “there is no category of marks which is not excluded from registration by Article 3(1)(b), (c) and (d) and Article 3(3) of the Directive which is none the less excluded from registration by Article 3(1)(a) thereof on the ground that such marks are incapable of distinguishing the goods of the proprietor of the mark from those of other undertakings.”<sup>40</sup> (The articles refer to the First Council Directive 89/104/EEC). This way the CJEU tied together the provisions of distinctiveness as a positive requirement and non-distinctiveness as a ground for refusal. However, later in the *Henkel* case (C-456/01 P. & C-457/01 P-) – interpreting the trademark regulation in force – provided a different conclusion stressing that a sign, in general, capable of constituting a trademark within the meaning of Article 4. does not mean that the sign necessarily has distinctive character for the purposes of absolute grounds for refusal in relation to a specific product or service.<sup>41</sup>
- 31 The concept of distinctiveness is complex and has been considered by the CJEU in many cases in relation to

different categories of signs. In the *Phillips* case the CJEU emphasized that the criterion of distinctiveness must be applied consistently across all categories of trademarks, and that three-dimensional signs are, in this respect, subject to the same standards as any other type of mark.<sup>42</sup> Although Article 7(1)(b) of EUTMR does not distinguish between different categories of trade marks in determining whether a trade mark is capable of distinguishing the goods or services of one undertaking from those of other undertakings, a distinction must be made depending on consumer perception and market conditions.<sup>43</sup>

- 32 For the purpose of this study, the theoretical foundations of distinctiveness of colors are worth an insight. In the *Libertel* case it was pointed out that colors per se cannot, as a matter of principle, be considered to be capable of distinguishing the goods or services of one undertaking from those of other undertakings, but in some circumstances they can acquire that capability.<sup>44</sup> This is the same line of reasoning as that applied in relation to whether colors may constitute signs or not. In the Heidelberg *Bauchemie* case this approach was reaffirmed and connected to acquired distinctiveness when the court held that “save in exceptional cases, colours do not initially have a distinctive character, but may be capable of acquiring such character as the result of the use made of them in relation to the goods or services claimed.”<sup>45</sup>
- 33 While INTA notes<sup>46</sup> that the EUIPO Fifth Board of Appeal found in 2015 that representations of human beings are not precluded from being perceived as distinctive signs, and this conclusion was repeated in the above cases by the Boards of Appeal, it may be justified to adopt a more cautious approach, namely the one applied by the CJEU in assessing the distinctiveness of color marks.
- 34 A photographic image of a human face, even if technically unique, may not automatically evoke in the mind of the average EU consumer a specific commercial origin. Unlike a logo or an arbitrary word, which can be constructed with deliberate distinctiveness, human faces are naturally occurring and structurally similar across the population. Besides, as it was stated in the earlier study, human faces are not intellectual creations, thus their trademark protection is quite far from the original

38 Case C-421/13 *Apple Inc. v Deutsches Patent- und Markenamt* ECLI:EU:C:2014:2070, para 17.

39 Gábor Faludi and Péter Lukácsi (eds), *A Védjegy-törvény Magyarázata* (HVG ORAC 2015) 39.

40 Case C-299/99 *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd.* ECLI:EU:C:2002:377, para 40.

41 Case C-456/01 P & C-457/01 P *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* ECLI:EU:C:2004:258, para 32.

42 Case C-299/99, para 48.

43 T-194/01 *Unilever NV. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* ECLI:EU:T:2003:53, paras 44-45.

44 Case C-104/01, paras 27, 41.

45 Case C-49/02, para 39.

46 INTA: Amicus Brief (Third Party Observations), Case R 50/2024-2, para 10.



philosophy of intellectual property law.<sup>47</sup>

35 Generally accepting the distinctiveness of face could broaden the scope of trademark protection to an uncertain territory. In this context, it is instructive to recall the reasoning adopted by the Court of Justice of the CJEU in the *Dr. No case* (T-435/05),<sup>48</sup> where the Court emphasized the distinction between artistic origin and commercial origin. The ruling acknowledged that while certain signs – such as the title or imagery of a well-known artistic work – may convey information about the author or the cultural source, this is not equivalent to identifying the commercial origin of goods or services. Irene Calboli considers such copyrighted characters as “content signs” which are not source indicators, therefore they should be excluded from trademark protection.<sup>49</sup> Applying this analogy to facial trademarks, it becomes apparent that the presence of a recognizable face, even one linked to artistic or public notoriety, does not automatically enable consumers to infer the business undertaking responsible for the goods or services. It is particularly true when the celebrities or influencers give their face for advertising purposes for one or more brand. The mere recognizability of a face may indicate personal identity or artistic association, but not necessarily fulfill the legal function of a trademark as defined by EU law. Although cognitive science has shown that the human brain is highly adept at recognizing faces,<sup>50</sup> it is also well-established that recognition is not synonymous with identification of origin. This stance was represented by the examiners at first instance in the above cases.

36 According to the INTA, the human face – whether in the form of a photograph or a drawing – can potentially qualify for trademark protection if it meets the fundamental requirement set out in Article 4 of the EUTMR: the capacity to distinguish the goods or services of one undertaking from those of others. INTA explicitly rejects the argument, often found in EUIPO first-instance decisions, that portraits are generally incapable of serving a distinctive function. It refers to the *Verhoef* case, where the Board of Appeal had already ruled that a specific portrait may indeed fulfil the essential function of a trademark,

namely indicating commercial origin.<sup>51</sup>

37 INTA emphasizes that the human face is capable of expressing individuality, and although consumers may initially perceive a face merely as an identifier of a person (rather than a trademark), through consistent use and market context, they can learn to perceive it as a source identifier. The organization outlines four conditions under which a portrait may be capable of serving the trademark function: (i) use in the course of trade, (ii) consistent format and appearance, (iii) placement in a position commonly associated with trademarks (e.g., on packaging), and (iv) either an established market practice of using portraits as trademarks in the given sector or the existence of special features that set the image apart from a “normal” portrait.<sup>52</sup> The application of the above test can in fact be aligned with the reasoning set out in the *Libertel* judgment, since INTA likewise requires the fulfilment of certain parameters under which a face may become capable of indicating commercial origin. Accordingly, the principle established in *Libertel* may also be applied here: portrait photographs depicting human faces do not, in themselves, possess inherent distinctiveness, yet the circumstances of their use may demonstrate the acquisition of such capacity in relation to the specific goods and services.

38 INTA stresses that the object of protection is not the general likeness or identity of a person, but a specific, concrete photograph, which therefore also satisfies the requirement of “clear and precise representation” under Article 4(b) of EUTMR. It draws a direct analogy to personal names<sup>53</sup> as trademarks: just as names cannot be categorically excluded from trademark protection, the same principle applies to portraits. The same logic extends to other “non-traditional” marks, such as colors or store layouts, where the CJEU has held that distinctiveness is context-dependent and can be established through use that departs from industry norms.

39 In summary, INTA takes the position that faces cannot be categorically excluded from trademark protection. The eligibility of such signs for registration should not depend on whether their form is conventional, but on whether the sign, in its specific commercial context, is capable of functioning as an indicator of trade origin.

40 The analytical framework developed by INTA – harmonizing with CJEU case law on color trademarks

<sup>47</sup> Keserű (n 3) 91.

<sup>48</sup> Case T-435/05 *Danjaq, LLC v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM) ECLI:EU:T:2009:226.

<sup>49</sup> Irene Calboli, ‘Overlapping Trademark and Copyright Protection: A Call for Concern and Action’ (2014) 2014 University of Illinois Law Review Online 25, 33.

<sup>50</sup> Martha J Farah, ‘Is Face Recognition “Special”? Evidence from Neuropsychology’ (1996) 76 Behavioural Brain Research 181. “plainCitation”: “Martha J Farah, ‘Is Face Recognition “Special”? Evidence from Neuropsychology’ (1996

<sup>51</sup> Case R 2063/2016-4, para 37.

<sup>52</sup> INTA: Amicus Brief (Third Party Observations), Case R 50/2024-2, para 11.

<sup>53</sup> This refers to the currently ongoing appellation case on the name of George Orwell, see R2248/2019-5 case, EUTM 017869417.

– provides a well-founded basis for assessing the registrability of human faces as trademarks, particularly in its focus on contextual and functional considerations. The four criteria identified in its submission offer a structured and coherent method for evaluating whether a portrait image can fulfil the essential function of a trademark.

- 41 Nevertheless, doubts remain as to whether these conditions are sufficiently met in the case of passport-style photorealistic portraits. Such images are typically neutral in expression, devoid of stylization, and lack any commercial context or symbolic enhancement. As a result, they often fail to meet the practical threshold of distinctiveness in the perception of the average consumer.
- 42 However, this does not require a categorical exclusion of facial images from trademark protection. Rather, the determination of registrability should be carried out on a case-by-case basis, with attention to the specific characteristics of the image and its manner of use. A nuanced, fact-sensitive assessment is necessary to ensure that only those facial signs which are genuinely capable of indicating commercial origin are granted protection, without undermining the openness of trademark law to evolving forms of non-traditional marks.

### III. The Relevance of Goods and Service

- 43 EUIPO's first-instance examiners have repeatedly raised objections concerning the nature and context of facial images used on product packaging. According to their arguments such depictions often represent generic or banal portrayals of people, which may lead the relevant public to interpret them not as indicators of commercial origin, but rather as symbolic references to the target audience of the goods or services.<sup>54</sup> In other words, when a face is used in a way that reflects a generalized human image, it is presumed to function merely as a decorative or suggestive element, rather than as a trademark.
- 44 However, a different situation arises when the person depicted is a professional model, and the specification of goods and services includes modelling services. This is precisely the case in several of the disputed applications under consideration, where the images represent identifiable models, and the goods and services explicitly cover modelling-related activities.
- 45 This raises a nuanced but significant legal question: Can the face of a model function as a distinctive

sign in relation to modelling services, which include participating on photoshoots or fashion shows? It could be argued that particular difficulties arise in such cases, since the image – specifically, the face of the model – comes very close to constituting the very subject matter of the service. Unlike situations where a trademark functions as an external identifier attached to goods or services provided by an undertaking, here the visual appearance of the person is inseparable from the service being offered. In this respect, the boundary between the sign and the service may appear blurred, which challenges the basic premise that a trademark should operate as a sign of origin distinct from the goods or services themselves. Although it would be too categorical to assert that the model and the service are fully identical, it is reasonable to highlight that the overlap is far stronger than in most conventional trademark scenarios.

- 46 By way of illustration rather than strict analogy, reference may be made to the so-called “merger doctrine” in U.S. copyright law. This doctrine describes situations where an expression and the underlying idea effectively merge because the idea can be expressed in only one or a very limited number of ways.<sup>55</sup> Similarly, one might cautiously suggest that in trademark law, if the sign coincides too closely with the essence of the service offered, its ability to function as an indicator of origin is weakened. The present discussion does not suggest a direct transposition of this doctrine into EU trademark law; rather, the analogy is meant to illustrate the conceptual challenge that arises when the subject matter of protection and the object of the service converge. In the context of modelling services, the portrait of the model arguably embodies the core value of what is offered on the market. From this perspective, one might cautiously suggest that if the sign coincides too closely with the essence of the service, its capacity to function as an external indicator of origin is undermined.
- 47 In respect of goods, there is an exact rule for such a situation in Article 7(1)(e)(iii) of EUTMR, which excludes from registration those signs that consist exclusively of a shape or other characteristic which gives substantial value to the goods. This occurs when the sign represents the product itself.<sup>56</sup> This provision is typically applied to three-dimensional forms or aesthetic attributes that enhance the market appeal of a product. It is acknowledged that this exclusion is grounded in considerations of public

<sup>54</sup> Case R 2063/2016-4, para18.

<sup>55</sup> Pamela Samuelson, ‘Reconceptualizing Copyright’s Merger Doctrine’ (2016) 63 *Journal of the Copyright Society of the USA* 417, 417.

<sup>56</sup> Milica Z Petrovic, ‘Legal Conditions for the Protection of Three Dimensional Signs in Trademark Law Review Article’ (2021) 38 *LAW - Theory and Practice* 54, 56.

interest, namely, to prevent undertakings from monopolizing features that substantially increase the attractiveness or value of goods. Nevertheless, the underlying rationale – that a trademark should not be identical with the product itself – may provide a useful analytical parallel. While the wording of the provision as it currently stands applies only to goods, it signals the structural limitation that a sign cannot simultaneously embody the product's essential value and serve as an indicator of its commercial origin, even if it has distinctive character. Transposed to services, this suggests that caution is required whenever a sign (e.g. a model's face presumed as a distinctive sign) is so closely tied to the essence of the service that it risks ceasing to operate as an external badge of origin. Although EU law does not extend Article 7(1)(e)(iii) to services, acknowledging this conceptual problem helps to delineate the possible boundaries of protectable portrait marks.

- 48 EUTMR does not define the category of mark that is considered a shape within the meaning of that provision. It makes no distinction between 2D and 3D shapes, and 2D representations of 3D shapes. Therefore, Article 7(1)(e) of EUTMR is applicable not only to 3D shapes but also to other categories of marks, such as figurative signs representing shapes.<sup>57</sup> Such products could be posters with the face, toys and figurines embodying the given person, keyholders with face etc. In these cases, the trademarks are not brands, they are not responsible for indicating commercial origins, but they are the valuable products themselves. At the same time, it must be noted that one facial image trademark has been registered as a three-dimensional mark,<sup>58</sup> rather than as figurative or photographic sign. In such cases, the sign is not limited to a two-dimensional representation but it explicitly claims protection for the shape and spatial configuration of the human face as it appears on the product or packaging. In these circumstances, the absolute ground for refusal under Article 7(1)(e)(iii) of EUTMR may become applicable, since such signs consist of a shape or other characteristic that may add substantial value to the goods. Where the representation of a face, whether in two or three dimensions, is not merely decorative but substantially influences the product's aesthetic or emotional appeal – or even constitutes its very essence – the rationale of this exclusion becomes particularly relevant. The implication is not that every portrait mark falls within the exclusion, but that certain uses of facial images approach a threshold where the trademark ceases to serve its essential source-indicating function.

57 Joined Cases C-337/12 P – C-340/12 P ECLI:EU:C:2014:129, para 55.

58 EUTM 018594683, a young man in black T-shirt and black baseball hat.

#### IV. The Relative Grounds for Refusal. The Assessment of Likelihood of Confusion in Facial Image Trademarks

- 49 Once the registration of human faces as trademarks is permitted on absolute grounds, a new and complex layer of legal analysis becomes inevitable: the question of likelihood of confusion under relative grounds for refusal. In order to ensure that trademarks serve their essential function of indicating the commercial origin of goods or services, proprietors are entitled to prohibit the use of identical or similar signs by unauthorized third parties whenever such use is likely to cause confusion among the relevant public.<sup>59</sup> This issue is not only relevant in opposition proceedings, but also in invalidation actions and infringement cases, where the same legal standards must be applied.
- 50 Accordingly, the acceptance of portrait marks into the trademark system will necessarily require EUIPO opposition and cancellation divisions and national courts alike to assess the comparability of different facial images in the context of potential conflicts between earlier and later rights.
- 51 This shift introduces a number of substantial challenges. Within the European Union, the criteria for evaluating likelihood of confusion are well established and originate from the CJEU's landmark judgment in the *Canon* and *SABEL* cases.<sup>60</sup> The *Canon* case provides guidance for comparing the goods and services, which is not relevant from the scope of the study in the absence of any specialties regarding facial image trademarks. The CJEU created the basic formula for the comparison of the signs in the *SABEL* case. According to the test laid down by the CJEU, marks must be compared as a whole, considering the visual, phonetic, and conceptual impressions they leave on consumers. This aligns with human perception, which processes sensory input (primarily sight and hearing) holistically rather than analytically.<sup>61</sup> For composite marks, the distinctive and dominant elements shall have

59 Martin Senftleben and Femke van Horen, 'The Siren Song of the Subtle Copycat - Revisiting Trademark Law with Insights from Consumer Research' (2021) 111 *The Trademark Reporter* 739, 743.

60 Case C-251/95 *SABEL v Puma, Rudolf Dassler Sport* ECLI:EU:1997:528.

61 Ilanah Fhima and Dev S Gangjee, *The Confusion Test in European Trade Mark Law* (Oxford University Press 2019) 173. likelihood of confusion has been the core infringement test for trade mark law, and it remains the most frequently applied test in infringement actions by far. However, there are noticeable differences in how it is applied by the Court of Justice of the European Union (CJEU)

special emphasis. Consumers do not typically see or hear the marks side by side – they rely on memory. Thus, similarity is assessed based on whether the marks could be confused in recollection.<sup>62</sup> The risk of confusion must be assessed globally, according to the perception of the relevant public, taking into account all factors relevant to the circumstances of the case, in particular the recognition of the trade mark on the market, the association which may be made with the used or registered sign, the degree of similarity between the marks and between the goods or services designated. The global assessment also implies some interdependence between the factors taken into account and in particular between the similarity of the trade marks and that of the goods or services designated.<sup>63</sup>

- 52 The joined *Messi* cases (C-449/18 P; C-474/18 P) reaffirm that the likelihood-of-confusion inquiry under Article 8(1)(b) EUTMR is a global assessment in which conceptual factors may neutralise visual and phonetic similarities. The court accepted that the reputation of the sign “MESSI”—as a matter of common knowledge—objectively shapes consumer perception and, in that case, counterbalanced the optical and aural proximity to “MASSI”, thereby excluding confusion. The judgment thus confirms that what ultimately matters is not the abstract category of the sign but how the relevant public perceives it in context, and that fame – where truly famous – may be taken into account without formal proof.<sup>64</sup> The CJEU’s case law on conceptual “neutralization” provides a useful template for assessing conflicts involving facial image trademarks. The *Messi* case relies on the *Picasso* case (C-361/04 P),<sup>65</sup> where the Court already accepted that a sign bearing a name with an immediate and specific conceptual meaning to the relevant public may, in certain circumstances, neutralize visual and phonetic similarities and thus exclude a likelihood of confusion. The *Messi* case adds to this approach that the world-fame of the person can be considered ex officio, without further proof. Neutralization remains exceptional and strictly applied: it presupposes that (virtually) the whole relevant public will grasp an immediate and clear conceptual difference,

otherwise visual and phonetic similarities prevail.<sup>66</sup> Scholarly commentary has also voiced reservations about the reach and clarity of the Court’s approach in *Messi*—while the judgment recognizes that conceptual dissimilarity (grounded in common-knowledge notoriety) may neutralize pronounced visual and phonetic proximity, it leaves only sketchy guidance on when such notoriety suffices and how it should be evidenced.<sup>67</sup> Sztoldman argues that the Court blurred trade mark reputation with personal notoriety, effectively treating Messi’s fame as an a priori conceptual anchor that neutralized visual and phonetic similarity. If in some cases personal fame is superior to other factors, where is the limit and what are the criteria for assessing the fame of celebrities in trademark matters?<sup>68</sup>

- 53 However, the critical question arises: How can these doctrinal standards be meaningfully applied to facial image trademarks? Unlike traditional word or figurative marks, where graphical stylization or verbal elements can be analyzed more easily, human faces possess inherent and biologically determined features that limit the extent of visual variation. Most faces include two eyes, a nose, a mouth, and ears in similar relative positions. While individuality exists in proportions, expressions, and minor distinguishing traits, the overall structural similarity of human faces poses difficulties in applying conventional visual comparison methods used in trademark law. In the global assessment required by Article 8(1)(b) EUTMR, and consistently articulated in *SABEL*, *Canon*, and *Lloyd Schuhfabrik* cases, this baseline similarity interacts with two well-established features of the test, the interdependence of factors and the imperfect recollection of the average consumer. Because consumers typically do not compare signs side-by-side and rely on an imprecise memory, minor variations in pose, lighting, expression or cropping will often fail to notice differences, so facial marks with broadly comparable morphology may be perceived as similar to a degree that supports a risk of confusion. This is especially true where the faces are not independently recognizable to the relevant public and where the purchasing act involves a lower degree of attention or occurs in visual environments (small formats, grayscale uses, fast-moving online contexts) that diminish the salience of fine facial details.

62 Barna Arnold Keserű, ‘A védjegyek összetéveszthetőségének joggyakorlata az USA, az Európai Unió és Magyarország védjegyjogában’ (2012) 7 (117) Iparjogvédelmi és Szerzői Jogi Szemle 68, 81–84.

63 Case C-342/97 *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* ECLI:EU:C:1999:323, para 19.

64 Case C-449/18 P & C-474/18 P *European Union Intellectual Property Office v Lionel Andrés Messi Cuccittini* ECLI:EU:C:2020:722, paras 44–47.

65 Case C-361/04 P *Claude Ruiz-Picasso and Others v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* ECLI:EU:C:2006:25.


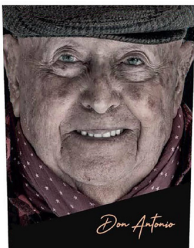
66 Angel Garcia Vidal, ‘Trademarks Composed by Names of Celebrities: Legal Implications of the Fame of the Person’ (2022) 14 Cuadernos de Derecho Transnacional 255, 269–270.

67 Van Anh Le and Joanna Buchalska, ‘Using a Surname in a Trademark: Has the Messi Case Changed Case-Law?’ (2022) 14 Krytyka Prawa. Niezależne Studia i Prawem 67, 83.

68 Agnieszka Sztoldman, ‘The Lionel Messi Case: Trade Mark’s Reputation Blurred with Personal Notoriety’ (2021) 43 European Intellectual Property Review 408, 409–410.



- 54 This biological similarity means that adjudicators must grapple with the fine margins of distinctiveness among faces, particularly in the absence of additional identifiers such as stylization, context, or accompanying verbal elements.
- 55 Transposing the findings of the *Picasso* and *Messi* cases to portrait marks, this approach provides a workable method for addressing the biologically determined baseline of facial similarity in certain cases. Where a facial image is recognizable to the relevant public (e.g., the portrait of a widely known figure), that conceptual anchor can neutralize structural likeness to another portrait, reducing the risk of confusion notwithstanding visual proximity. Conversely, where both faces are unknown (and thus lack any salient conceptual content), no such neutralization occurs and visual similarity will assume greater weight in the overall appraisal. In short, the *Messi* framework directs adjudicators to integrate identity, fame and use-context into the analysis rather than allowing a purely optical comparison to dominate.
- 56 It must be emphasized, however, that the *Messi* case concerns relative grounds and offers no shortcut on absolute grounds. The fact that personal fame can dispel confusion in opposition proceedings neither establishes inherent distinctiveness under Article 7(1)(b) EUTMR nor proves reputation within the meaning of Article 8(5). Those remain separate inquiries, to be satisfied—if at all—by evidence of trademark-functioning use in relation to the goods and services claimed.
- 57 It must also be taken into account that our biologically determined perception of human faces – that is, our innate ability to recognize identical faces and to distinguish between different ones – is not equivalent to the legal concept of likelihood of confusion as developed in trademark law. While the human brain is highly trained to process facial features and detect subtle distinctions between individuals, this cognitive capacity operates on a different level than the structured legal assessment used to evaluate the similarity of signs and the risk of confusion among consumers. Consequently, the mere fact that two faces may appear different to the human eye does not necessarily mean that no likelihood of confusion exists under trademark law, and vice versa. This distinction highlights the need for a nuanced and legally consistent framework when applying traditional trademark criteria to signs consisting of human faces. This raises the risk of inconsistent or overly subjective decisions, especially when the analysis hinges on nuanced visual assessments that may be influenced by subconscious perceptions or cultural biases. In trademark law, where decisions regarding similarity and likelihood of confusion must meet objective standards, such uncertainties present significant challenges when human faces are used as signs. This problem does not preclude the registrability of such signs, but opens the gate for jurisdictional challenges.
- 58 INTA notes that in the *Don Antonio* case<sup>69</sup> the Fifth Board of Appeal has already given an example for such comparison in opposition proceedings.

Earlier Trademark EUTM 14908677 Filed on 14 December 2015, Registered on 12 May 2016	Contested Trademark Application EUTM 18362780 Filed on 25 January 2021
	

2. Table The compared signs in case R 0010/2023-5. Compiled by the author.

<sup>69</sup> EUIPO, Decision of the Fifth Board of Appeal of 15 March 2024, in the case R 0010/2023-5 (EUTM 18362780).



- 59 Both trademark applications were filed for wines (Nice class 33), and the list of goods and services of the earlier trademark also encompassed other services related to wines in class 35 and 39. As regards the comparison of the signs, the Board of Appeal has taken into account the eyes, the position of lips, the wrinkles on the faces, the facial expression, the skin tone, the style of the caps, the collars of the shirts. This case does not entirely fit to the above arguments of the paper as the contested sign is not merely a photo, but it also contains verbal elements. As the decision highlights, the verbal elements and their slight stylization, while having a secondary visual impact on the overall impression of the contested mark, will not go unnoticed, as the space reserved for them corresponds to approximately one third of the sign and is clearly differentiated from the portrait by a diagonal cut and the black background. The expressions ‘DON ANTONIO’ and ‘TENUTA ULISSE’ were found also distinctive overall. According to case law, in the wine-growing world, names carry great weight, whether surnames or names of vineyards, since they are used to reference and designate wines.
- 60 This way the overall assessment was influenced by the verbal elements, but as regards the portraits, the Board found that the first image is somber and somewhat stark. The man’s serious expression, combined with the earthy tones and deep-set features, gives the portrait a solemn and contemplative feel. The attire is simple and unadorned, contributing to an overall austere aesthetic. The second image is vibrant and lively. The man’s face is alight with a broad smile, and his eyes are crinkled in amusement. The image is colorful, with the subject wearing a patterned scarf. In terms of color and lighting, the first image is characterized by muted, natural tones and soft lighting, while the second is brighter and more colorful with a clear and radiant presentation.<sup>70</sup> In conclusion, the visual similarity was held in a low degree.
- 61 The conceptual comparison was derived from the visual comparison, while phonetic assessment was unnecessary. The different artistic choices – alongside with the other factors which are irrelevant for the topic of this article – led to the refusal of the opposition and the contested application was granted.

## V. The Challenge of Genuine Use for Portrait Trademarks

- 62 A critical issue arises in connection with the registration of human faces as EU trademarks

concerns the requirement of genuine use, as set out in Article 18(1) of EUTMR. According to this provision: if, within a period of five years following registration, the proprietor has not put the EU trademark to genuine use in the Union in connection with the goods or services in respect of which it is registered, or if such use has been suspended during an uninterrupted period of five years, the EU trademark shall be subject to the sanctions provided for in the EUTMR. In trademark systems based on registration, the obligation to demonstrate actual use of a mark – at least at some stage – is a fundamental mechanism for addressing the problem of register clutter. This holds particular significance in systems like the EUTM, where neither prior use nor an intention to use is required for obtaining registration. Consequently, monitoring and enforcing the use requirement becomes especially critical for preserving trademark rights over time.<sup>71</sup> In the pure registry systems the banking of trademarks makes more costly to enter markets, so the requirement of use keeps the level of investments at optimal rate.<sup>72</sup>

- 63 The use of a trademark means use as a badge of origin, by the proprietor or with its consent, for the registered goods or services, and in forms that preserve the distinctive character of the registered sign. It was consistently articulated by the CJEU in the cases *Ansul* (C-40/01),<sup>73</sup> *La Mer* (C-259/02),<sup>74</sup> *Rintisch* (C-553/11),<sup>75</sup> *Colloseum* (C-12/12),<sup>76</sup> *Specsavers* (C-252/12).<sup>77</sup> These also reflect the role of the register, where the representation recorded brings clarity and legal certainty as to what is protected.
- 64 This requirement becomes more complex where the registered sign consists of a photorealistic representation of a living individual’s face, and the sign is not used as a static visual sign (what does not raise specific questions compared with other figurative trademarks), but instead in the course of trade through the appearance of the actual person – for instance, in the context of modelling services as “living trademarks”. Although there could be different approaches whether the use of

71 Graeme B Dinwoodie, ‘Territorial Overlaps in Trademark Law: The Evolving European Model Symposium: Negotiating IP’s Boundaries in an Evolving World’ (2016) 92 *Notre Dame Law Review* 1669, 1694.

72 Landes and Posner (n 17) 281.

73 Case C-40/01 *Ansul BV kontra Ajax Brandbeveiliging BV*. ECLI:EU:C:2003:145.

74 Case C-259/02 *La Mer Technology Inc. v Laboratoires Goemar SA*. ECLI:EU:C:2004:50.

75 Case C-553/11 *Bernhard Rintisch v Klaus Eder*. ECLI:EU:C:2012:671.

76 Case C-12/12 *Colloseum Holding AG v Levi Strauss & Co*. ECLI:EU:C:2013:253.

77 Case C-252/12 *Specsavers International Healthcare Ltd v Asda Stores Ltd* ECLI:EU:C:2013:497.

70 Case R 10/2023-5, 43-44.

own face constitutes use of trademark or not, the author argues that as the persons are the natural and inseparable three-dimensional bearers of the registered signs, their commercial activity related to the list of goods and services may be relevant, and that tension emerges more frequently with portrait marks than with stylized logos or word marks. In such cases, the question occurs whether the dynamic and naturally changing appearance of a person can still satisfy the condition of consistent and genuine trademark use. This question is simply theoretically, if the trademarks are used in the orthodox static way as well (e.g. on posters, websites etc.) which can fulfill the requirement of genuine use anyway but becomes more important in the absence of such common use and the owners rely only to the use of their natural face.

65 Indeed, human faces are subject to inevitable changes over time. Hairstyles, make-up, facial expressions, and even the natural aging process may alter the appearance of the person depicted in the registered sign. This leads to the legal dilemma of determining whether use of a slightly modified version of the face still constitutes use of the registered trademark. It shall be noted that the author disagrees with INTA in this aspect as they held that the changes of the face have no impact on the trademark, as the subject of the trademark is merely the concrete photograph and not the actual face of the person. It is true that trademarks do not protect the face in general but in that static format which was registered, it is clear consequence of the requirement of representational clarity laid down on Article 4 of EUTMR. However, the person's head is the three-dimensional representation of that picture. If it is captured on photo or video, it becomes again two-dimensional. This way regarding to modeling services, posing and showing the given face in a photoshoot or in the catwalk could be relevant from the perspective of genuine use.

66 Under established EUIPO<sup>78</sup> and CJEU case law, use of a sign that differs from the registered form only in elements which do not alter the distinctive character of the sign is still considered genuine trademark use.<sup>79</sup> However, this assessment can become particularly challenging in the context of portrait marks. For instance, if the registered mark shows a person wearing a hat that visually dominates one-quarter of the image, omitting the hat in actual use may significantly impact the sign's overall impression and its distinctiveness. The same might apply in

cases of substantial changes to hairstyle, extreme make-up, or other prominent visual alterations. The determination of whether such changes remain within the scope of permissible variation or whether they affect the distinctive character of the sign is far from straightforward.

67 Another practical consideration concerning the utility of such trademarks relates to the duration of use of the registered image by the individuals concerned. It is reasonable to assume that, as these individuals change over time – whether in appearance, style, or age – the facial photographs they use in commerce are also likely to evolve. This raises the question of how long the exact photograph registered as a trademark will remain in active use. Given that trademark protection operates on the premise of a static and consistent sign, which must be used in the precise or near-identical form in which it was registered, this legal rigidity may not be fully compatible with the dynamic nature of personal image use, particularly in industries like fashion, media, or entertainment. As a result, the requirement of genuine use, when applied to photorealistic facial trademarks, may render the protection less practical over time. The mark's inflexibility may eventually conflict with the individual's evolving branding strategies or visual identity, thereby limiting the long-term usefulness of trademark protection for such portrait-based signs. Of course, it is not the theoretical problem of trademark law, but a practical problem of the applicants who have to choose the adequate form of legal protection for their interests.

68 The above thoughts illustrate not only the doctrinal difficulty of assessing the genuine use of photorealistic portrait marks, but also points to the practical limitations of these so-called “living trademarks.” When the registered image is not merely a stylized logo but the real, evolving face of an individual, the utility and enforceability of the trademark may become fragile over time.

## VI. Limitation on Trademark Protection: The Use of “own face”

69 A fundamental aspect of EU trademark law is the balance it seeks to maintain between exclusive rights and the freedoms of third parties. This balance is enshrined in Article 14(1)(a) of EUTMR, which provides that the proprietor of an EU trademark shall not be entitled to prohibit a third party from using, in the course of trade, his own name or address, provided he uses them in accordance with honest practices in industrial or commercial matters. The study does not aim to introduce the concept of honesty under Article 14, but it makes clear that it is a misconception that one has an absolute right to use

78 See in more detail ‘CP8 – Common Communication. Use of a Trade Mark in a Form Differing from the One Registered’ (EUIPO, 2020).

79 Case T-194/03 *Il Ponte Finanziaria SpA v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) ECLI:EU:T:2006:65, para 50.

one's own name as a trademark, there are additional requirements.<sup>80</sup> Article 14. includes other types of limitations as well, but they do not raise specific questions regarding faces, so those are out of the scope of the investigation.

- 70 While this provision currently applies only to the use of personal names, the increasing number of trademark registrations consisting of photorealistic human faces raises the question of whether this limitation should be extended to facial image – what would provide the right of an individual to use their own image in economic activities.
- 71 In the absence of such an extension, a significant tension emerges between trademark law and personality rights. Under Articles 8(1)(b) and 9(2)(b) of EUTMR, EU trademark protection and enforcement extend to identical or similar signs where similarity gives rise to a likelihood of confusion. If a person's facial image is registered as a trademark, it could theoretically allow the proprietor to prohibit other individuals from commercially using their confusingly similar own face, even in contexts where that use is essential to their profession. With the scope of protection this is not only a problem for twins or look-alikes, but also very similar looking peoples. This tension becomes particularly acute in the modelling industry. If a model's facial image is registered as a trademark for modelling services, and a different model has a confusingly similar or even nearly identical appearance (not to mention the special case of twins), the mere commercial use of their face (eg. walking along the runway on a fashion show) might constitute trademark infringement.
- 72 Such outcomes would run counter to the foundational objectives of trademark law, which are not intended to exclude individuals from pursuing legitimate economic activities based on their physical appearance. As Rothman notes, "each person had a right to control how others used their identity in trade."<sup>81</sup> Rather, trademark law is designed to prevent consumer confusion and to protect business goodwill – not to monopolize personal identity through trademark and restrict the use of similar identities.
- 73 This concern was briefly acknowledged in certain Board of Appeal decisions involving portrait trademarks, where the panels recognized the issue but regarded it as exceptional and peripheral, thereby concluding their analysis without broader legal reflection.<sup>82</sup> However, given the increasing

registration of portrait marks and the expansion of their commercial implications, the current framework may no longer be sufficient.

- 74 It is therefore arguable that legislative development is needed to ensure that the limitations on trademark protection under Article 14 of EUTMR are interpreted more broadly, potentially encompassing the right to one's own image under the same principles that currently apply to the use of one's own name. This would help to safeguard basic personality rights and to prevent disproportionate restrictions arising from the expansion of "living trademarks."

## VII. Reputation and Portrait Marks: Does Personal Fame Transfer to Trademark Reputation?

- 75 A critical issue in the context of portrait trademarks concerns whether the reputation of the individual depicted can automatically elevate the trademark itself to the status of a well-known or reputed mark, thus granting it enhanced legal protection. This question bears relevance under both Article 8(2)(c) and Article 8(5) of EUTMR and can have significant implications for the registrability and enforcement of such marks.
- 76 Under Article 8(2)(c) of EUTMR, a trademark application may be refused if it conflicts with a prior, unregistered trademark or sign that is well-known in a Member State, in the sense of Article 6bis of the Paris Convention. In the context of portrait marks, this raises the question of whether a well-known face – such as that of a celebrity or public figure – can itself function as a prior sign that blocks subsequent applications. Furthermore, under Article 8(5) of EUTMR, trademarks with reputation enjoy extended protection, even in cases where the goods or services are dissimilar, provided that the later use would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier mark.
- 77 Well-known and reputed trademarks are similar in nature,<sup>83</sup> both categories involve quantitative assessments of the degree of recognition enjoyed by the sign among the relevant public. The World Intellectual Property Organization in its recommendation defined the criteria for well-known trademarks.<sup>84</sup> The document makes clear that the

80 Floyd A Mandell, 'Personal Name Trademarks - Your Name May Not Be Your Own' (1980) 70 The Trademark Reporter 326, 326–327.

81 Rothman (n 3) 1306.

82 EUIPO Fourth Board of Appeal Case R 468/2021-4, para 18;

Case R 1704/2023-4, para 23; Case R 2173/2023-4, para 23.

83 István Gödölle, 'A jó hírű védjegy mint kizáró ok a védjegyjogban' (2013) 8 Iparjogvédelmi és Szerzői Jogi Szemle 153.

84 'Joint Recommendation Concerning Provisions on

conditions shall be assessed in accordance with the list of goods and services.<sup>85</sup>

- 78 The CJEU has addressed in the *Chevy* case the concept of trademark with reputation in the context of Community law.<sup>86</sup> The Court held that in order to enjoy protection extending to non-similar products or services, a registered trademark must be known by a significant part of the public concerned by the products or services which it covers. The TDK case has also confirmed this interpretation.<sup>87</sup>
- 79 The settled case law makes clear that a trademark does not acquire reputation simply because it refers to a famous person or event. Reputation must be based on the actual use of the mark in connection with the designated goods or services, and not merely on the renown of the individual depicted. The mark must become known in the market as a sign of origin, and this association must be the result of commercial use and consumer perception. For instance, in a case concerning Fernando Alonso, the famous Formula 1 world champion, the evidence of his personal fame was deemed insufficient to establish reputation for the purposes of the goods listed in the trademark's specification. The mere fact that a celebrity is universally known does not necessarily mean that a trademark consisting of their image or name qualifies as "reputed" under Article 8(5) of EUTMR.<sup>88</sup>
- 80 Therefore, while the public recognition of the depicted person may contribute to the distinctiveness of a portrait mark, it does not automatically confer reputation in the legal sense. Reputation must be proven in relation to the use of the sign as a trademark, and in connection with the specific goods and services for which the sign is registered. Without this commercial use and consumer association, personal fame remains insufficient as a basis for enhanced protection under EU trademark law.
- 81 This logic also underpins the position taken by the INTA with regard to acquired distinctiveness. In its amicus curiae brief, INTA explicitly emphasized that the fame or public recognition of a particular face, standing alone, is not sufficient to establish

acquired distinctiveness in connection with the goods or services at issue. Instead, it must be shown that the relevant public perceives the image as a source identifier, due to consistent and targeted use in commerce. The underlying rationale here mirrors that which applies in the context of reputed marks: a famous image or name must function as a trademark in the market, rather than merely symbolizing personal identity or fame.<sup>89</sup>

- 82 Thus, both acquired distinctiveness and reputation-based enhanced protection share a common doctrinal foundation: consumer perception shaped by market use, not mere celebrity status or renown. This reinforces the principle that personality traits – even when widely recognized – must be evaluated within the structured legal framework of trademark function, which is ultimately rooted in the mark's capacity to distinguish goods or services in trade.

## F. Conclusion

- 83 The registration of facial images as trademarks presents a unique intersection of traditional trademark doctrine, emerging non-traditional marks, and fundamental personality rights. As this study has demonstrated, the recent shift in EUIPO case law – particularly the reversal of first-instance refusals by the Boards of Appeal – has opened the door to a broader acceptance of facial image marks, provided they satisfy the essential requirement of distinctiveness under Article 7(1)(b) of EUTMR. At the same time, this trend raises a series of conceptual and practical challenges.
- 84 The analysis has shown that while the capacity of facial images to serve as source indicators cannot be ruled out in principle, their registrability must be assessed with great caution. Passport-style, photorealistic portraits that lack stylization, symbolic elements, or contextual use in trade are unlikely to meet the threshold of distinctiveness. In this regard, the study supports a case-by-case assessment of such signs rather than a categorical exclusion or acceptance.
- 85 Several normative and de lege ferenda suggestions have emerged from this analysis. First, the study proposes a clearer application and legislative expansion of Article 7(1)(e)(iii) of EUTMR to cases where the portrait itself constitutes the core commercial value of the service – particularly in modelling-related trademarks – thus blurring the line between the sign and the goods/services. Second, the study raises the issue of genuine use

the Protection of Well-Known Marks' SCT/3/8, World Intellectual Property Organization, 2000.

- 85 István Gödölle, 'A korábbi védjegy mint lajstromozást gátló és törlési ok - 1. Rész' (2014) 9 Iparjogvédelmi és Szerzői Jogi Szemle, 32–33.
- 86 Case C-375/97 *General Motors Corporation v Yplon SA* ECLI:EU:C:1999:408.
- 87 Case T-477/04 *Aktieselskabet af 21. november 2001 v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* ECLI:EU:T:2007:35, para 48.
- 88 EUIPO, Decision of the Fourth Board of Appeal of 22 July 2010, in the case R 11/2008-4 (EUTM 3972973), paras 44–45.

- 89 INTA: Amicus Brief (Third Party Observations), Case R 50/2024-2, para 18.

under Article 18(1) of EUTMR in the context of evolving appearances (e.g. hairstyle, makeup), suggesting that that criteria of genuine use may undermine the practical usefulness of portrait trademarks in many cases.

- 86 Third, in light of potential conflicts between trademark rights and personality rights, the study argues that the exception enshrined in Article 14(1) (a) of EUTMR – currently applicable to personal names – might justifiably be extended to facial likenesses. This would prevent scenarios where an individual could be prohibited from using their own face in commerce due to a previously registered facial image trademark in cases involving highly similar appearances or identical twins.
- 87 Fourth, with respect to reputation and acquired distinctiveness, the study affirms that the mere public recognition of a person is insufficient to establish the reputation or secondary meaning of a portrait mark. This view is aligned with INTA's position, which emphasizes that fame alone does not transform a portrait into a distinctive mark for the relevant goods or services.
- 88 Finally, the study calls attention to the practical implications for trademark proprietors. The static nature of facial image trademarks may not correspond to the dynamic visual identity of the individuals they depict. As a result, the legal protections afforded by trademark registration may not fully meet the evolving needs of rights holders, who may, in some cases, be better served by relying on personality rights for image protection as it was investigated in the previous study.<sup>90</sup>

90 Keserű (n 3).