

**TALLINN UNIVERSITY OF TECHNOLOGY**

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**Registration of Sound Marks as Community Trade Marks in the  
European Union: Evolution and Challenges**

A Comparative Study with Insights from  
Switzerland and the United States

Master Thesis

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Tallinn 2016

I hereby declare that I am the sole author  
of this Bachelor Thesis and it has  
not been presented to any other  
university of examination.

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“ ..... “ ..... 2016

The Master Thesis meets the established requirements

Supervisor Pawan Kumar Dutt

“ ..... “ ..... 2016

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Board of Examiners of Law Master's Theses

.....

*[..] je me demandais si la musique n'était pas l'exemple unique de ce qu'aurait pu être – s'il n'y avait pas eu l'invention du langage, la formation des mots, l'analyse des idées – la communication des âmes.*

(Marcel Proust – À la recherche du temps perdu, La Prisonnière, 1923)



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## Abbreviations and Acronyms

AG	Advocate General
Ann.	Annex
App.	Appendix
Art.	Article
Az.	Aktenzeichen
BGE	Bundesgerichtssentscheid
BVGE	Bundesverwaltungsgerichtssentscheid
<i>CANJLT</i>	Canadian Journal of Law and Technology
CCPA	Court of Customs and Patent Appeals
Cf.	Compare
CJEU	Court of Justice of the European Union
<i>CommsL</i>	Communications Law
Corp.	Corporation
CTM	Community Trade Mark
CTM Regulation	Council Regulation 207/2009, OJ 2009 L 78/1
Dec.	Decision
ECR	European Court Reports
Ed.	Editor
E. D. Pa.	Eastern District of Pennsylvania
E.g.	For example
<i>EIPR</i>	European Intellectual Property Review
<i>EntLR</i>	Entertainment Law Review
Et al.	Et alii
Et seq.	Et sequentia
EU	European Union
FEDCBJ	Federal Circuit Bar Journal
OHIM Examination Guidelines	Guidelines for Examination in the OHIM on CTMs, Part B, Examination, Section 4, Absolute Grounds for Refusal
FSupp	Federal Supplement
<i>GRUR</i>	Gewerblicher Rechtsschutz und Urheberrecht

HABM	Harmonisierungsamt für den Binnenmarkt
<i>ICLQ</i>	International & Comparative Law Quarterly
IGE	Institut für Geistiges Eigentum
<i>IIC</i>	International Review of Intellectual Property and Competition Law
Id.	Idem
I.e.	Id est
IGE Trade Mark Guidelines	IGE, Richtlinien in Markensachen
In re	in the matter [of]
<i>IPQ</i>	Intellectual Property Quarterly
<i>IPJ</i>	Intellectual Property Journal
IR	International Registration
<i>JIPR</i>	Journal of Intellectual Property Rights
Lanham Act	Code of Laws of the United States of America 15 U.S.C. § 1051 et seq. Trademark Act of 1946 as amended
MA	Madrid Agreement as amended on November 12 2007
MarkenG	Gesetz (Germany) über den Schutz von Marken und sonstigen Kennzeichen (Markengesetz) vom 25. Oktober 1994
MarkenV	Verordnung (Germany) zur Ausführung des Markengesetzes (Markenverordnung) vom 11. Mai 2004
MP	Madrid Protocol, 1989 Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks as amended on November 12 2007
MGM	Metro-Goldwyn-Mayer Corp.
MS	Madrid System for the International Registration of Marks
Middle District	MD
N.	Note

Niece Agreement	1957 Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks as amended on September 28 1979
No.	Number
OHIM	Office for Harmonization in the Internal Market
OS	Organised Sound
Para.	Paragraph
Paris Convention	1883 Paris Convention for the Protection of Industrial Property as amended on September 28 1979
Rec.	Recital
Reg.	Regulation
Res.	Resolution
Sent.	Sentence
<i>sic!</i>	Zeitschrift für Immaterialgüter-, Informations- und Wettbewerbsrecht (Switzerland)
Seq.	Sequence
SR	Systematische Sammlung des Bundesrechts
TM Directive	European Parliament and Council Directive 2008/95/EC, OJ 2008 L 299/25
TMEP	TTAB, Trademark Manual of Examining Procedure
TmPA	Federal Act on the Protection of Trade Marks and Indications of Source, Trade Mark Protection Act (Bundesgesetz (Switzerland) über den Schutz von Marken und Herkunftsangaben vom 28. August 1992 (Markenschutzgesetz, SR 232.11))
TTAB	Trademark Trial and Appeal Board
TRIPS	1994 Trade-Related Aspects of Intellectual Property Rights. Ann. 1 C to the Agreement Establishing the WTO as adopted on April 15 1994

US(A)	United States (of America)
USC	United States Code (Code of Laws of the United States of America)
USPQ	United States Patents Quarterly
V.	Versus
Vol.	Volume
WIPO	World Intellectual Property Organization
<i>WRP</i>	Wettbewerb in Recht und Praxis

## A. Introduction

The Christian church was one of the first organisations to successfully create an audio brand identity in Europe. For almost 1600 years, church bells have called worshippers to attend church services, weddings, funerals or other religious events.<sup>1</sup> Today, for many companies possessing an audio brand, identity has become an important success factor. By creating a lasting and positive impression on consumers, it helps companies to distinguish themselves and their products from those of competitors. Audio branding can be referred to as establishing and maintaining an acoustic identity for a company and its products.<sup>2</sup> In that regard, sound marks, or trade marks that include sound as a sign, play a key role.

Some countries, such as the United States (US), have a long history of sound marks. Other countries have only recently established a proper legal basis for the registration of sound marks. In Canada, it was only made possible to register sound marks in 2012, on the basis of the Canadian Trade-Marks Act.<sup>3</sup> China followed in 2013 with the adoption of the New Trade Mark Law of the People's Republic of China.<sup>4</sup> In Japan, it is only since this year, 2015, that it became possible to register sound marks.<sup>5</sup> In Russia, the earliest registration of sound marks dates back to 2001.<sup>6</sup> However, it is only since 2008 that the Civil Code of the Russian Federation explicitly allowed the registration of non-traditional marks.<sup>7</sup> A similar situation is found in India, where the Indian Trade Mark Registry began to generally register unconventional trademarks in 2008,

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<sup>1</sup> K. Luty & D. Philippart, *Clip Notes for Church Bulletins*, vol. 1, at 76 (1997).

<sup>2</sup> *See infra* at 5.

<sup>3</sup> A. Bella, *Trademark registration: Some Sound Practical Tips for Canadians*, The IPKat, 30 March 2012. <http://ipkitten.blogspot.com/2012/03/trade-mark-registration-some-sound.html> [18.08.2015]

<sup>4</sup> W. Zhang, L. Wei & Y. Li, *The Third Revision of Chinese Trademark Law - Analysis and Comment*, 45 IIC 5, at 556-586, para. 558 (2014).

<sup>5</sup> Act for Partial Amendment to Patent Act, Etc. (Act No. 36 of May 14, 2014) M. Takahashi & R Hashimoto, *Amendment to Trademark Act of Japan - New Marks, Including Color Marks and Sound Marks, Can Be Protected*, Jones Day, September 2014. <http://www.jonesday.com/amendment-to-trademark-act-of-japan---new-marks-including-color-marks-and-sound-marks-can-be-protected-09-04-2014/#> [18.08.2015].

<sup>6</sup> According to the trade mark register of the Russian Federation [30.10.2015].

<sup>7</sup> Art. 1482 of the Civil Code of the Russian Federation (as amended up to 2014), Part IV (The Right to the Trademark and the Right to Service Mark).

despite previous instances of sound marks.<sup>8</sup> Other countries took a more distinctive approach to the registration of sound marks. Until 2009, Switzerland only considered certain sound marks for registration, i.e. only those containing textual elements.<sup>9</sup> Similar rules also applied to those seeking Community Trade Marks (CTMs) for their sound marks in the European Union (EU).

Until ten years ago, musical notation was required for registering a sound mark as a CTM.<sup>10</sup> This practice changed in 2005. As a result, the number of sound marks registered with the Office for Harmonization in the Internal Market (OHIM - the office responsible for granting CTMs) substantially increased. Today, the OHIM counts 178 sound marks registered as CTMs, a number which is steadily growing.<sup>11</sup> However, EU member states still require the sound to be graphically represented as musical notation in order to be registered. Thus, the EU is characterised by the existence of two different approaches towards sound marks on its territory: one at the European level and one at the national level.<sup>12</sup>

## I. Research Questions

The amendment to the Implementing Regulation for Community Trade Marks adopted in 2005 was expected to facilitate the registration for sound marks as CTMs in the EU.<sup>13</sup> This study investigates the protection of sound marks in the form of CTMs, in particular, the registration practice of the OHIM.<sup>14</sup> In that regard, this study addresses the following two main research questions:

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<sup>8</sup> *Intellectual Property Law in India*, Nishith Desai Associates (NDA), December 2013. [http://www.nishithdesai.com/fileadmin/user\\_upload/pdfs/Research%20Papers/Intellectual\\_Property\\_Law\\_in\\_India.pdf](http://www.nishithdesai.com/fileadmin/user_upload/pdfs/Research%20Papers/Intellectual_Property_Law_in_India.pdf) [18.08.2015], at 3.

<sup>9</sup> M. Bundi, *August Storck KG v Swiss Federal Institute of Intellectual Property: Switzerland: Trade Marks – Registration of Acoustic Marks without Textual Elements*, 31 EIPR 12, N84 (2009).

<sup>10</sup> *See infra* at 31.

<sup>11</sup> As of November 24, 2015.

<sup>12</sup> *See infra* at 81.

<sup>13</sup> *See* Commission Reg. 1041/2005, OJ 2006/1 (Community Trade Mark Implementing Reg., CTMI Reg.); *see supra* at 32.

<sup>14</sup> Council Reg. 40/94, OJ 201994 L 11/1 established the CTM. It was later repealed by Council Reg. 207/2009, OJ 2009 L 78/1 (Community Trade Mark Reg., CTM Reg.). Until today, two different trademark systems coexist in parallel: one system at EU level and one at member state level. However, trade mark legislation at member state level is widely harmonised based on Council European Parliament

- *How has the notion of sound mark as a legal concept changed from the past to today?*
- *How do the necessary capabilities of a sign to perform the function of trade mark apply to sound signs and how are they reflected in the OHIM's registration practices? In particular, how does the OHIM conceptualise the notions of descriptiveness and non-distinctiveness as important absolute grounds for refusal and do differences exist with regard to other jurisdictions?*

Of the criteria relating to registrability of trade marks, distinctiveness is the most crucial.<sup>15</sup> This is emphasised in the TRIPS provisions related to trade mark registration. They stipulate that a sign's capability of distinguishing goods or services is the sole essential determinant of its suitability for registration.<sup>16</sup>

A comparison with other jurisdictions allows the exploration of legal rules and their justifications as well as a discussion of the legal history and practical examples to account for patterns of similarity and difference. Such an approach contributes to a deeper understanding of EU trade mark legislation and practice and provides an excellent basis for reflection on a rather young subject, sound marks.

From a practical point of view, this study will not go beyond the legal conceptualisation and registration of sound marks. It will not address the genuine use requirement, nor will it address the protective effect of trade mark registration. Those areas remain open to further research. Moreover, this study will not address trade mark protection at EU member state level. As of today, the registration practice of the OHIM and that of EU member states differ with regard to sound marks. While the OHIM accepts sonograms and sound files as complicit with the legal requirement of graphical representation, national registries in EU member states still require

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and Council Directive 2008/95/EC, OJ 2008 L 299/25 (Trade Mark Directive, TM Directive) and its predecessor, the First Council Directive of 21 December 1988 to approximate the laws of the Member States relating to trade marks 89/104/EEC, OJ 1989 L 40 / 1.

<sup>15</sup> J. Philips, *Trade Mark Law, A Practical Anatomy*, at 86 (2003).

<sup>16</sup> *Id.*; Trade-Related Aspects of Intellectual Property Rights. Ann. 1 C to the Agreement Establishing the WTO as adopted on April 15 1994 (*TRIPS*), *cf. infra* at International Legal Framework15.

musical notation.<sup>17</sup> This issue will be briefly addressed in light of the new Trade Mark Directive (TM Directive 2016) expected to enter into force in the second half of 2016.<sup>18</sup>

## **II. Methodology**

Until today, the OHIM has registered 176 sound marks; of these it declined approximately five percent.<sup>19</sup> At the EU level, however, almost no settled case law has emerged that specifically addresses sound marks. This study therefore takes a comparative approach to gain a deeper understanding of the OHIM's registration practices, and in particular, the absolute grounds for refusal of registration. After investigating the available OHIM and Court of Justice of the European Union (CJEU) settled case law as well as OHIM decisions in which registration of sound marks were declined, this work addresses the registration practices and relevant settled case law in two other jurisdictions: Switzerland and the US.

The idiosyncrasies of both Switzerland and the US provide a particularly interesting comparison. Switzerland is not only the home of the World Intellectual Property Organization (WIPO); it also shares a similar history in regard to the registration of sound marks as the EU. Developments in the field of trade mark legislation and practice at the EU level have not gone unnoticed in Switzerland. Switzerland's practice with regard to sound marks may provide valuable insights, especially in the examination of its deviations from EU practice. Examples from the US will provide additional insights. The US' history of registering sound marks which dates back to the 1950s. Since then, the US has developed a dedicated system with regard to the registration of sound marks.<sup>20</sup> This study will only address the federal system for trade mark registration in the US.

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<sup>17</sup> See, e.g. Website of the Intellectual Property Office (United Kingdom), *Trade Marks Manual*. [https://www.gov.uk/government/uploads/system/uploads/attachment\\_data/file/454221/Manual-of-trade-marks-practice.pdf](https://www.gov.uk/government/uploads/system/uploads/attachment_data/file/454221/Manual-of-trade-marks-practice.pdf) [18.08.2015].

<sup>18</sup> See *supra* at 84.

<sup>19</sup> As of November 20, 2015.

<sup>20</sup> Ianeva, *see infra* note 24, at 153; Ahuja, *see infra* note 24, at 576.



### III. State of the Art

Not many in-depth studies on sound marks exist in Europe; although German scholars have investigated this subject more profoundly.<sup>21</sup> They often address specific aspects related to the registration of sound marks, such as graphical representation.<sup>22</sup> Others investigate sound marks by establishing and assessing a phenomenology of potential sound marks.<sup>23</sup> Reflecting the internationally most common approach to the issue, some studies investigate sound marks in the broader context of non-traditional marks, such as smells, tastes or colours.<sup>24</sup> While not many in-depth studies exist on sound marks, a substantial amount of journal articles discuss non-traditional marks in general.<sup>25</sup> However, by addressing sound marks in the wider context of non-

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<sup>21</sup> See, e.g. R. Landfermann, Handy-Klingeltöne im Urheber- und Markenrecht – Schriften zum deutschen und internationalen Persönlichkeits- und Immaterialgüterrecht, Vol. 017, (2006); S. Bahner, Der Schutz akustischer Marken nach dem deutschen Markengesetz und der europäischen Gemeinschaftsmarkenverordnung (2005); U. Foerstl, Der Schutz akustischer Kennzeichen nach dem MarkenG (2003); C. Kortbein, Markenschutz für Hörzeichen, Probleme der praktischen Verwendung sowie des Eintragungs-, Widerspruchs und Verletzungsverfahrens (2005); R. A. Becker, Kennzeichenschutz einer Hörmarke, WRP, at 56-65 (2000); C-P. Fritz, Gegenwart und Zukunft von Markenformen unter besonderer Berücksichtigung akustischer Zeichen: Registrierbarkeit von Markenformen im deutschen, europäischen und internationalen Recht (1992).

<sup>22</sup> See, e.g. J. Novak, Die Darstellung von besonderen Markenformen, Hörmarke – Geruchsmarke – Bewegungsmarke (2007); C. Hoffrichter-Daunicht, Grafische Darstellbarkeit von Hörmarken: Wo ist das Problem? GRUR, at 935-936 (2007); A. Bender, Die grafische Darstellbarkeit bei den neuen Markenformen, in V. Bomhard et al. (eds.), Harmonisierung des Markenrechts: Festschrift für Alexander von Mühlendahl zum 65. Geburtstag (2005); U. Hildebrandt, *Zum Begriff der grafischen Darstellbarkeit des Artikel 2 Markenrichtlinie, Anmerkungen zu den Schlussanträgen zur Riechmarken-Vorlage des BPatG, 1 MarkenR*, at 1-5, (2002).

<sup>23</sup> See, e.g. I. Suter-Sieber, Die Hörmarke: Schutzvoraussetzungen und Schutzzinhalte nach schweizerischem Recht (2012); L. Meyer, Urheber- und markenrechtliche Überlegungen zum Klingelton, 3 *Medialex: Zeitschrift für Medienrecht / Revue de droit des médias*, at 149-154 (2003).

<sup>24</sup> See, e.g. N. Ianeva, Registration of Non-Conventional Signs Under the Community Trademark Regime (2008); U. Hildebrandt, Marken und andere Kennzeichen (2009); S. Sandri & S. Rizzo, Non-Conventional Trade Marks and Community Law, at 133-149 (2003).

<sup>25</sup> See, e.g. T. Kongolo, *Intellectual Property and Misappropriation of the Public Domain*, 33 EIPR 12, at 780-794 (2011); G. Humphreys, *Non-Conventional Trademarks: An Overview of Some of the Leading Case Law of the Boards of Appeal*, 31 EIPR 9, at 437-448 (2010); V. K. Ahuja, *Non-traditional Trade Marks: new dimension of trade marks law*, 32 EIPR 11, at 575-581 (2010); M. M. S. Karki, *Non-*

traditional marks, those publications discuss sound marks rather superficially. This phenomenon might reflect that, in many countries, registration of sound marks has become possible only recently.<sup>26</sup> Finally, the deeper and more comprehensive studies or journal articles address sound marks generally in the context of national trade mark legislation. Not one of these articles focuses on OHIM practice concerning sound marks. In that regard, this study sheds light on a blind spot in legal research.

#### **IV. Relevance of this Study**

This study investigates the present EU sound mark law as well as the OHIM's registration practices. By addressing sound marks in the meaning of the CTM Regulation and by investigating the trade mark registration practices of the OHIM, this study evaluates how the common principles of trade mark protection apply to sound marks at the EU level. A comparative approach is beneficial as it shows how other jurisdictions, i.e. Switzerland and the US, apply common principles of trade mark protection to sound marks. In addition, this study provides valuable input on how to further develop the registration practice for sound marks in the EU, especially, with regard to CTMs. Finally, the comparative approach might serve as useful guidance for applicants seeking successful sound mark protection in the EU and in other jurisdictions, not least based on the Madrid System.<sup>27</sup>

#### **V. Structure of this Study**

This study is structured along the following lines. Chapter B begins with an introduction to the fundamentals of sound. It forms the basis for defining the notion of sound mark for this study. It is followed by a brief introduction to audio branding illustrated with sound mark examples. Chapter C addresses the protection criteria for trade marks. It discusses the notion of trade mark within the meaning of the EU's TM Directive and CTM Regulation and concludes by elaborating on how the *notion of sound mark as a legal concept has changed from the past to*

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*Traditional Areas of Intellectual Property Protection: Colour, Sound, Taste, Smell, Shape, Slogan and Trade Dress*, 10 JIPR 11, at 499-506 (2005); R. Sieckmann, *Die Eintragungspraxis und –möglichkeiten von nicht-traditionellen Marken innerhalb und ausserhalb der EU*, MarkenR 1, at 236-266 (2001); D. Lyons, *Sounds, Smells and Signs*, 16 EIPR, at 541-543(1994).

<sup>26</sup> See *infra* at 1.

<sup>27</sup> The Madrid System provides an instrument for registering and managing trade marks worldwide, i.e. on the territory of its members.

*today*. This chapter takes a closer look at the notion of sound mark in two other jurisdictions, Switzerland and the US. Chapter D examines the grounds for refusal stipulated in the CTM Regulation and applied by the OHIM with regard to registering sound marks as CTMs. It focuses, in particular, on how the OHIM conceptualises the notions of descriptiveness and non-distinctiveness. This chapter juxtaposes the EU with Switzerland and the US in terms of CTM regulation. The relative grounds for refusal are only briefly addressed as a more detailed discussion would go beyond this study's scope. Chapter E briefly addresses the difference between the registration practice for sound marks at the EU level (CTM) and at the member state level as well as the upcoming changes as a result of the new Trade Mark Directive (TM Directive 2016) expected to enter into force in the second half of 2016. Chapter F concludes this study. It summarises the most important insights concerning sound marks with regard to the research questions guiding this study. It also incorporates the insights from the sound mark registration practice in Switzerland and the US.

Initially, this study tried to treat gender equally. It used the terms she and he simultaneously where the origin of the gender is unknown, such as with regard to the notion of consumer or customer. For easier reading, the final version of this study uses male pronouns for both genders. Nevertheless, the author acknowledges the need for sensitivity for gender issues in science.

This study is based on the available legislation and literature as of November 2015. If not otherwise cited, all trade mark illustrations are derived from online databases, in particular, the OHIM's eSearch plus.<sup>28</sup>

## **B. Fundamentals of Sound**

The rustling of autumn leaves, snippets of a conversation, loud voices, laughing, the whistle of a locomotive, the detonation of a bomb, movement of piano keys or the bang of an exploding balloon are all commonly referred to as sounds. Some of those sounds would be considered music while others simply noise. In some cases it would be even unclear to which category (music or noise) a particular sound should belong to. It is necessary for this study to clarify the

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<sup>28</sup> Website of the OHIM, *eSearch plus*, <http://oami.europa.eu/eSearch/#basic> [18.08.2015].

notions of sound, music and noise. This requires refreshing some basic physics and music knowledge.<sup>29</sup>

### **I. Sound, Music, Noise and Timbre**

Sound is triggered by a mechanical event, for example by clapping hands together. In physics, this is referred to as creating a mechanical vibration or sound wave. The clapping sound promulgates itself to the ears of listeners by inducing movement in the air between the mechanical event, the clapping, and the listeners. The sound wave then reaches our eardrum. It is a thin, cone-shaped membrane which begins moving when reached by the sound wave.<sup>30</sup> Of the physically measurable sound, human beings can only discern parts of it. Those discernible parts are referred to as acoustic impulses or signals. The parameter used to measure sound is frequency, expressed in Hertz (Hz). One Hz means that an event repeats itself once per second. The more an event repeats itself per second, the higher pitched the acoustic impulse seems. The fewer repeats of an event per second there are, the lower the perceived pitch of an acoustic impulse is. Another important parameter used to measure sound is amplitude. It is quoted in Decibels (dB). The higher a dB rate, the louder we sense an acoustic impulse. The lower the dB rate, the quieter we sense an acoustic impulse.

Why do humans sense music and noise differently? When hearing an acoustic signal, humans automatically link an acoustic impulse to a tone pitch. The categorisation is based on the frequency of the sound. Frequency can be graphically described as a wave line over a certain period of time. A sound with a discrete frequency spectrum allows humans to categorising it based on a particular tone's pitch. Sounds with a discrete frequency are sensed as music, such as a pure sound. A pure sound consists of only one sound wave of a particular frequency, for example a sine tone. A sine tone has 440 Hz. This means that an event repeats itself 440 times per second. Such an acoustic signal is generally perceived as being a sterile or empty sound. Often it resembles the whistle of a flute. Contrary to that, sounds that are sensed by humans as noise display an irregular frequency spectrum. In other words, the pattern of the sound is aperiodic. The seemingly regular noise of a running water tap should not be confused with a pure sound. The impression is merely the consequence of overlapping sine waves of different frequencies resulting in a so-called continuous spectrum. In its essence, the acoustic signal

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<sup>29</sup> For this chapter, the author draws from his high school physics and music classes.

<sup>30</sup> Loudspeakers generate sound based on force exerted on a membrane suspended in an electrostatic field.

remains aperiodic and, thus, simply noise. Eventually, the sound associated with a particular pitch can be visualised and represented graphically through the use of musical notation.

An important notion used in relation to music is timbre. To put it simply, timbre is what distinguishes the sound of a music instrument from another instrument, even when they have the same pitch and loudness.<sup>31</sup> Timbre is the result of multiple overlapping partial tones, i.e. sinus waves. A trombone rich in overtones is perceived as producing a bright sound, whereas a transverse flute poor in overtones is perceived as producing a mellow sound.

## **II. Music Genres**

Often, the notion of sound is commonly used to refer to music genres, such as classic, rock, pop, jazz or folk. Music genres should not be confused with the notion of timbre. Genres refer to certain musical traditions. Thus, sound in the meaning of music genres reflects a cultural phenomenon.<sup>32</sup> Obviously, the notion of sound as referring to different music genres is subject to conventions and classifications that can change over time.

## **III. Definition of Sound Mark**

World Trade Organisation (WTO) legislation provides a basic definition of a trade mark.<sup>33</sup> It refers to it as [...] *a sign that is capable of distinguishing the goods or services of one undertaking from those of other undertakings [...]*.<sup>34</sup> For this study, the notion of sound mark refers to: *one or more acoustic signals that together form a sound sign which has gained trade mark protection*. Thus, a sound sign simply refers to tones or noises that can be heard by humans, regardless of their sources of origin or characteristics. The capability of a sound sign to eventually perform the function of a trade mark is subject to a legal assessment prior to its registration as a sound mark, i.e. trade mark. Not every sound sign qualifies as a trade mark. For

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<sup>31</sup> It is worthwhile to note that physicist and musician differ in their understanding and use of the notion of timbre. Physicists relate timber to an acoustic impulse emanated by one instrument, i.e. a sine tone. Musicians relate timber to the acoustic impulse emendated by multiple instruments playing together, i.e. an ensemble.

<sup>32</sup> J. Samson, Genre, Oxford Music Online. <http://www.oxfordmusiconline.com/subscriber/Art./grove/music/40599> [03.11.2015].

<sup>33</sup> Trade-Related Aspects of Intellectual Property Rights. Ann. 1 C to the Agreement Establishing the WTO as adopted on April 15 1994 (*TRIPS*).

<sup>34</sup> Art. 15, para. 1 of TRIPS.

the sake of analytical precision, this study avoids referring to a sound sign as trade mark prior to successful registration or being widely accepted as a trade mark. In that regard, this study differs from other publications which use sign and trade mark interchangeably.

#### IV. Audio Branding

At its core, audio branding can be understood as establishing and maintaining an acoustic brand identity for a company.<sup>35</sup> Unlike the law's relationship with the term trade mark, the word brand takes on another meaning within the business community. By focusing on sound marks in a strictly legal sense, this study applies a much narrower approach to the notion of audio branding than business or marketing professionals would. From a marketing perspective, sound marks can be used in different ways. Because of this, distinctive lexicon has emerged. Sound marks can take the form of *jingles*, *audio logos* or *sound icons*.<sup>36</sup> Other instruments of audio branding are *brand voices*, *brand songs* or *commercial songs*, *sound grounds* and *soundscapes* as well as *sound designs*.<sup>37</sup> In most cases they are unlikely to be beneficial for trade mark protection. However, this does not exclude them from being subject to copyright protection.

##### 1. Jingles, Audio Logos, Sound Icons

Jingles are advertisement slogans that are set to music, such as the famous McDonald's slogan, *I'm lovin' it*.<sup>38</sup> Figure 1 shows the graphical representation of the sound mark as deposited with OHIM for registration as CTM.



Figure 1 I'm lovin' it jingle, McDonald's (CTM no. 003661907)

<sup>35</sup> *What is audio branding?* Audio Branding Academy, <http://audio-branding-academy.org/aba/knowledge/what-is-audio-branding/> [18.08.2015].

<sup>36</sup> *Technical terms audio branding*, Audio Branding Academy, <http://audio-branding-academy.org/aba/knowledge/what-is-audio-branding/> [18.08.2015].

<sup>37</sup> *Id.*

<sup>38</sup> *Id.*

Audio logos are short pieces of music or noise, usually lasting a few seconds.<sup>39</sup> They are used as a signet and have the same effect as textual marks. Among the most famous audio logos are the Nokia tunes (Figure 2), Metro-Goldwyn-Mayer's (MGM) sound of a roaring lion (Figure 3), the Twentieth Century Fox Film Corporation's drums played before its movies (Figure 4), and Hornbach's chanted words *Yippie ja Yippie Yeah* (Figure 5).



Figure 2 Audio logo of Nokia Corporation (CTM no. 001040955)

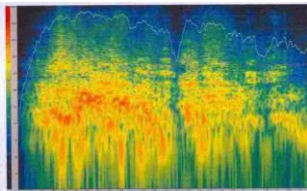


Figure 3 Audio logo of Metro-Goldwyn-Mayer (CTM no. 005170113)

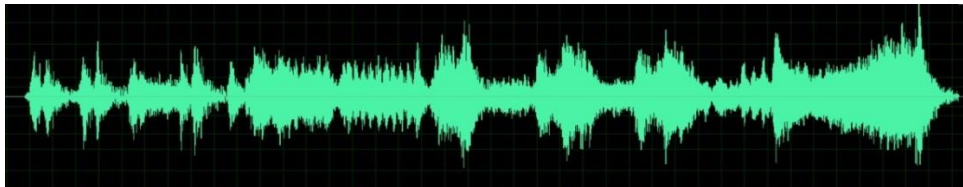


Figure 4 Audio logo of Twentieth Century Fox Film Corp. (CTM no. 012438628)

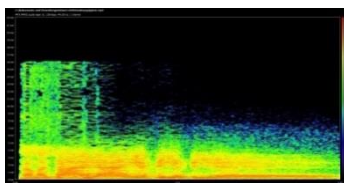


Figure 5 Audio logo of Hornbach-Baumarkt (CTM no. 009274242)

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<sup>39</sup> *Technical terms audio branding*, Audio Branding Academy, <http://audio-branding-academy.org/aba/knowledge/what-is-audio-branding/> [18.08.2015].

The shortest elements in audio branding are sound icons.<sup>40</sup> They provide real or artificial noises for products.<sup>41</sup> Common examples are sounds emanating from computer programs, computers, notebooks, tablets, smart phones or other electronic devices. Some of the most famous sound icons are Intel's (Figure 6) and Samsung's chimes (Figure 7). Samsung's water droplet sound when performing a movement on the surface of the screen of a tablet or smart phone is another well-known sound icon (Figure 8).



Figure 6 Sound icon of Intel (CTM no. 003481744)



Figure 7 Sound icon of Samsung (CTM no. 010137594)

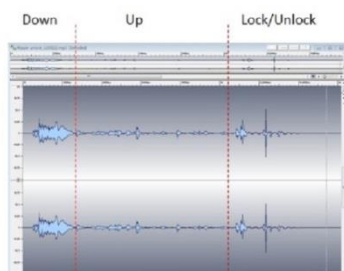


Figure 8 Sound icon of Samsung (CTM no. 011226552)

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<sup>40</sup> *Technical terms audio branding*, Audio Branding Academy, <http://audio-branding-academy.org/aba/knowledge/what-is-audio-branding/> [18.08.2015].

<sup>41</sup> *Id.*



## 2. Brand Voices, Brand Songs, Soundscapes, Sound Design

Some companies use brand voices to provide their products or services with a distinct and recognisable voice.<sup>42</sup> Sometimes voices of actors, singers or other famous persons are used for this purpose. The voice is expected to provide the product with a particular character or feeling to distinguish it from others. HEXAL's trade mark protected slogan *Arzneimittel ihres Vertrauens Hexal* (Figure 9) provides a good but also controversial example of such a sound mark.<sup>43</sup>

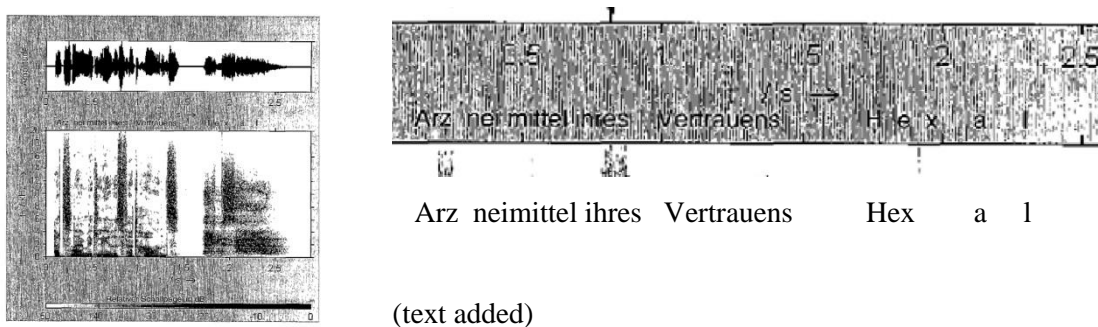


Figure 9 Brand Voice of HEXAL (CTM no. 003699204)

Brand songs or commercial songs are another form of audio branding.<sup>44</sup> They generally are used in advertisements on television and radio or in cinemas. Contrary to jingles, audio logos and sound icons, brand songs are longer in duration. An advertisement may consist fully or partially of a brand song. Among the most famous commercial songs are Bacardi's *Summer Dreaming*, Coca-Cola's *Holidays are Coming!* or Johnnie Walker's *The Skye Boat Song*.

Soundscapes are less pervasive than commercial songs.<sup>45</sup> They are employed by companies at commercial fairs, on websites, in elevators or in the form of hold music for communication devices. Sound grounds try to create an association between a product and a particular company. In that regard, sound grounds can fulfil a similar function as a trade mark. A good example for a

<sup>42</sup> *Technical terms audio branding*, Audio Branding Academy, <http://audio-branding-academy.org/aba/knowledge/what-is-audio-branding/> [18.08.2015].

<sup>43</sup> *See supra* at 21 and 46.

<sup>44</sup> *Technical terms audio branding*, Audio Branding Academy, <http://audio-branding-academy.org/aba/knowledge/what-is-audio-branding/> [18.08.2015].

<sup>45</sup> *Id.*

successful soundscape is the boarding music of the UAE-based airline, Etihad, or Cisco's default hold music for its call manager.<sup>46</sup> Both companies use music to create a unique atmosphere.

Finally, sound design deals with the acoustic features of products. Until recently, it has been mainly relevant for tangible products, such as the noise of crisp packets, vacuum cleaners or car and motorcycle engines.<sup>47</sup> In an increasingly digital world, sound design is getting even more relevant, particularly for inherently silent electronic goods and digital services. Cars are another important area for sound design. As they become more and more computerised and powered by silent electric engines, sound design has been increasingly used to create various car noises reaching from the ticking noise of indicator lights to the roaring noise of engines.<sup>48</sup>

### 3. Conclusions

The examples of audio branding show that sound marks may take various forms. Most obviously, they can take the form of jingles, audio logos or sound icons. Less clear seems the case with regard to brand voices, commercial songs, sound grounds, and sound designs. Longer music pieces in whatever form seem to be a copyright rather than a trade mark protection issue. However, being considered an artistic work does not exclude a sound sign of performing the function of sound mark and, if all legal requirements are met, benefiting from trade mark protection.

As mentioned earlier, some studies on sound marks take a phenomenological approach, discussing various forms of sound signs and their registrability as trade marks.<sup>49</sup> However, the concepts of jingles, audio logos and sound icons simply reflect audio branding or marketing terminology. They denote only the potential use case for a sound sign but are of no legal purpose or value. Subjecting this study's investigation to marketing terminology would unnecessarily

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<sup>46</sup> Etihad Airways, *Etihad Boarding Music*, <https://soundcloud.com/etihad-airways/etihad-boarding-music> or Cisco's *call manager default hold music*, <https://www.youtube.com/watch?v=6g4dkBF5anU> [18.08.2015].

<sup>47</sup> See, e.g. H. Sutcliffe, *Eco crisp packet is too noisy for consumers*, 1 November 2010, The Guardian, <http://www.theguardian.com/sustainable-business/blog/eco-crisp-packet-too-noisy> [18.08.2015].

<sup>48</sup> See, e.g. Audi is working on the so called Audi e-sound to outfit its future e-tron car models powered by electric motors. The noise should ensure that pedestrians will hear those cars in daily traffic. Audi USA, *Acoustic Innovation: e-sound by Audi*, 9 April 2012, YouTube, <https://www.youtube.com/watch?v=HoEDLvQZg5I> [18.08.2015].

<sup>49</sup> See *supra* at 3.

limit the scope of potential sound signs that may perform the function of a trade mark. This study aims at establishing the legal meaning of sound mark and assessing the registration practice in an abstract and general way.

## **C. The Trade Mark: Protection Criteria**

This chapter uses a foundation of international and EU legislation to address the notion of trade mark. It sets the stage for a closer look at the trade mark within the context of the TM Directive and CTM Regulation. Thus, this forms the basis for discussing the term sound mark within the meaning of the CTM Regulation. Although this study examines the notions of sound mark with regard to CTM protection, a substantial part of the research is based on settled CJEU case law and the opinions of the CJEU's Advocate Generals (AG), in particular, related to the interpretation of the TM Directive. While the AG's opinions are not binding, they nevertheless provide valuable legal reasoning and guidance for the interpretation of EU legislation.

### **I. Basic Requirements for Attaining Trademark Status**

#### **1. International Legal Framework**

The Paris Convention for the Protection of Industrial Property (Paris Convention) is the oldest international treaty concerning the protection of intellectual property.<sup>50</sup> However, the Paris Convention does not define trade mark; this is left to the members of the union.<sup>51</sup> Nevertheless, Article 6<sup>quinquies</sup> A para. 1 of the Convention already provides a first step towards harmonisation. It calls for members to accept trade marks registered in another member state for filing and protection. However, Article 6<sup>quinquies</sup> B of the Paris Convention also outlines those cases in which a member of the union may deny trade mark protection. Those circumstances are reflected in the absolute and relative grounds for refusal stated in the domestic trade mark legislation of the members of the Paris Convention.

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<sup>50</sup> Paris Convention as amended on September 28, 1979 (Paris Convention). The first version dates back to March 20, 1883. The convention was amended multiple times. The most recent revision dates back to September 28, 1979.

Article 6<sup>quinquies</sup> is also referred to as the *telle-quelle principle*.<sup>52</sup> According to that principle, a trade mark formally registered in one member country should be registered in the same form in another country of the union. This principle essentially refers to the trade mark's external appearance.<sup>53</sup>

The Paris Convention is complemented by two important international treaties addressing the international registration of trade marks:<sup>54</sup> The Madrid Agreement (MA) and the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, the Madrid Protocol (MP).<sup>55</sup> Both treaties facilitate the international registration of trade marks. Still, neither the MA nor the MP defines the notion of trade mark. The criteria for the international registration of a trade mark is based on the trade mark definition of the country of origin, i.e. where the basic registration took place.<sup>56</sup>

The first international treaty establishing a legal definition of trade mark at an international level was TRIPS in 1994.<sup>57</sup> It referred to trade mark as:<sup>58</sup>

Any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark. Such signs, in particular words including personal names, letters, numerals, figurative elements and combinations of colours as well as any combination of such signs, shall be

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<sup>52</sup> This principle applies also to the members of the Madrid Agreement (MA) and the Madrid Protocol (MP). The World Intellectual Property Organisation (WIPO) applies a much lenient approach to the registration of sound marks than domestic legislations. It explains why sonograms could be found in the ROMARIN database, the international trade mark registry. Suter-Sieber, *supra* note 4, at 159.

<sup>53</sup> In some countries this led in the past to paradox outcomes. While domestic legislation did not allow for registering three-dimensional trade marks in Switzerland, such trade marks could still be registered in Switzerland on the basis of the Madrid Agreement. Suter-Sieber, *supra* note 4, at 16.

<sup>54</sup> Art. 19 of the Paris Convention.

<sup>55</sup> MA and MP as amended on November 12, 2007; For more on their origins see also T. Prime, *supra* note 53, at 80-82 (2000).

<sup>56</sup> Art. 1 para. 2 and art. 5 para. 1 of the Madrid Agreement (MA); Art. 1 para. 1 and art. 5 para. 1 of the Madrid Protocol (MP).

<sup>57</sup> See *supra* at 33. For more on intellectual property and TRIPS see C. M. Correra & A. A. Yusuf, Intellectual Property and International Trade, The TRIPS Agreement (2008); A. Taubman et al., A Handbook on the WTO TRIPS Agreement (2012).

<sup>58</sup> Art. 15 para. 1 of TRIPS.

eligible for registration as trademarks. Where signs are not inherently capable of distinguishing the relevant goods or services, Members may make registrability depend on distinctiveness acquired through use. Members may require, as a condition of registration, that signs be visually perceptible.

According to TRIPS, any sign capable of distinguishing the goods or services of one undertaking from those of another undertaking shall be capable of constituting a trade mark.<sup>59</sup> In addition, as stipulated in the definition, members may require a sign to be visually perceptible as a condition for registration.<sup>60</sup>

The EU is not a member to the Paris Convention. It is, however, a member of the Madrid Protocol as well as of the TRIPS agreement. Those treaties implicitly require EU legislation to be consistent with the Paris Convention.<sup>61</sup> With the EU's 2004 ratification of the Madrid Protocol, the CTM system and the Madrid system have been linked.<sup>62</sup> This connection makes it possible for CTM applicants to simultaneously file an international application with the OHIM. Moreover, it allows an applicant outside of the EU to designate the EU in an international trade mark application.

Interestingly, the *telle-quelle* principle derived from the Paris Convention would have implicitly called upon the EU to register a sound mark for which application came via the Madrid System, i.e. an international trade mark. However, as mentioned previously, while not explicitly excluding sound marks from registration, the TRIPS agreement allowed members, such as the EU, to require visual representation as registration criteria. This was the case for registering sound signs as CTMs until 2005.<sup>63</sup>

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<sup>59</sup> Art. 15 para. 1 sent. 1 of TRIPS. This indicates that a sign's capability of distinguishing goods or services is the sole essential determinant of its suitability for registration and emphasizes the notion of distinctiveness, *see also* Philips, *supra* note 15, at 86 (2003).

<sup>60</sup> Art. 15 para. 1 sent. 4 of TRIPS.

<sup>61</sup> Website of the Office for Harmonisation in the Internal Market (Trade Marks and Designs), 13.2. *What does the link between the Madrid Protocol and the CTM system mean?* <https://oami.europa.eu/ohimportal/en/madrid-protocol#13.2> [18.08.2015].

<sup>62</sup> *Id.*

<sup>63</sup> *See supra* at 31.

## 2. EU Trade Mark Legislation

The TM Directive and the CTM Regulation are the most important EU trade mark legislations.<sup>64</sup> The former is directed at EU member states; it harmonises trade mark protection on the territory of the EU.<sup>65</sup> The latter establishes rules and conditions for granting a CTM. The TM Directive and CTM Regulation share the same trade mark definition:<sup>66</sup>

A [Community] trade mark *may* consist of any signs capable of being *represented graphically*, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings. (emphasis added)

Sound is not explicitly mentioned as a sign, neither in the TM Directive nor in the CTM Regulation. This does not mean that sound signs are excluded from trade mark protection. The EU, however, required any sound sign to be registered as a trade mark in member states or as a CTM to be capable of graphical representation.<sup>67</sup> The word *may* in Article 2 of the TM Directive and Article 4 in the CTM Regulation may not be interpreted that member states or OHIM had discretion on whether or how to implement this provision. Rather, it refers to the concept of sign as an open-ended term stipulating that if the necessary requirements are met a sign could qualify as trade mark.<sup>68</sup>

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<sup>64</sup> European Parliament and Council Directive 2008/95/EC, OJ 2008 L 299/25 (TM Directive) and Council Reg. 207/2009, OJ 2009 L 78/1(CTM Reg.). For more on the origins of EU trade mark law *see also* T. Prime, *European Intellectual Property Law*, at 75-78 (2000).

<sup>65</sup> For more on the harmonization of trade mark law in the EU *see also* A. Michaels & A. Norris, *A Practical Approach to Trade Mark Law*, at 2-4 (2010).

<sup>66</sup> Art. 2 of the TM Directive; Art. 4 of the CTM Reg.

<sup>67</sup> The TM Directive was not intended to define trade mark. EU member states were supposed to determine the signs of which a trade mark may consist themselves. Thereby, Art. 2 of the TM Directive laid down certain requirements for a trade mark. Unsurprisingly, they refer to the function of a trade mark. However, the requirements stipulated in the TM Directive were directed at creating a registration system in which graphical representation would play a key role. Keeling, *supra* note 67, para. 2-028.

<sup>68</sup> Keeling, *supra* note 67, para. 2-029.

### 3. Conclusions

The TRIPS agreement, the TM Directive and the CTM Regulation provide a minimalist trade mark definition - *a sign that is capable to distinguish goods or services from one undertaking from those of another undertaking*.<sup>69</sup> As previously mentioned, the TRIPS agreement left it optional for member countries to require graphical representation of a sign to qualify it as trade mark. In some countries, such as the US, graphical representation was never a legal requirement. The EU, however, opted for a trade mark definition that required graphical representation. This led in the EU to some confusion on how to treat famous sound marks in the EU, such as the Tarzan Yell or MGM's Roar of a Lion, which already had trade mark registration in the US.<sup>70</sup> In that context, a variety of questions arose. What constitutes graphical representation? Do simple onomatopoeias or sonograms (images that show how an acoustic signal varies over time) qualify as graphical representation for sound marks? Would they allow for CTM registration?<sup>71</sup> However, before addressing those questions, it is important to understand the notion of trade mark within the understanding of the TM Directive and CTM Regulation.

## II. Trade Mark within the Meaning of TM Directive/ CTM Regulation

What constitutes a trade mark within the meaning of Article 2 of the TM Directive and Article 4 of the CTM Regulation? This has been addressed by the CJEU in settled case law and by AGs in their opinions.<sup>72</sup> Among the most relevant cases regarding the definition of trade mark are the *Sieckmann* case of 2002 and the *Dyson* case of 2007.<sup>73</sup> In both cases, the CJEU provided guidance on what would allow a sign to qualify as a trade mark according to EU legislation, i.e. Article 2 of the TM Directive.

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<sup>69</sup> Art. 15 Para. 1 of TRIPS; Art. 4 of the CTM Reg.; C. Waelde *et al.*, *Contemporary Intellectual Property, Law and Policy*, at 577 (2011).

<sup>70</sup> *See infra* at 31.

<sup>71</sup> *Id.*

<sup>72</sup> For more on the development of CJEU case law on trade marks *see also* A. Michaels & A. Norris, *A Practical Approach to Trade Mark Law*, at 4-5 (2010).

<sup>73</sup> Judgment of 12 December 2002 in *Case 273/00, Ralf Sieckmann v Deutsches Patent- und Markenamt (Sieckmann)*, [2002] ECR I-11737, at I-11737; Judgment of 25 January 2007 in *Case 321/03, Dyson Ltd v Registrar of Trade Marks (Dyson Ltd.)*, [2007] ECR I-00687, I 712-728.

Still, legal scholars and practitioners have criticised the CJEU's approach in defining the notion of trade mark in settled case law.<sup>74</sup> According to them, the CJEU has identified those functions that provide the basis for a sign to qualify as a trade mark.<sup>75</sup> However, it has so far fallen short of providing a full characterisation of those functions.<sup>76</sup> As a consequence, this study draws especially on the opinions provided by two AGs in order to obtain a deeper understanding of the functions that a trade mark performs according to the TM Directive and the CMT Regulation. Both AG Dámaso Ruiz-Jarabo Colomer and AG Georges Cosmas provide additional insights on the legal concepts that the CJEU established and used in those two landmark cases.

*Sieckmann* provides the starting point for establishing the functions performed by a trade mark. This case concerned the registrability of an olfactory sign (smell). The CJEU referred in its judgment to three necessary capabilities of a sign to be able to perform the function of a trade mark:<sup>77</sup>

- A sign has to be capable to function as indication of origin.<sup>78</sup>
- A sign has to be capable to distinguish between goods and services of one undertaking from those of another undertaking.<sup>79</sup>
- As sign has to be capable to be represented graphically.<sup>80</sup>

In its decision, the CJEU elaborated only very briefly on the first two capabilities. Given the subject matter, the CJEU focused especially on the third capability, justifying the necessity for graphical representation. The following three chapters will elaborate on those three capabilities based on the opinions of the AGs and additional settled case law of the CJEU, such as *Windsurfing Chiemsee*, *Dyson*, *Libertel*, *Canon*, and *Merz & Krell & Co.*<sup>81</sup>

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<sup>74</sup> Keeling, *supra* note 67, para. 2-009.

<sup>75</sup> *Id.*

<sup>76</sup> *Id.*

<sup>77</sup> Advocate General Ruiz-Jarabo Colomer in *Case 273/00, Sieckmann*, [2002] ECR I-11739, at I-11739.

<sup>78</sup> *Case 273/00, Sieckmann*, in particular Rec. 34 and 53 of the judgment.

<sup>79</sup> *Id.*, in particular Rec. 35 and 39 of the judgment.

<sup>80</sup> *Id.*, in particular Rec. 39 of the judgment.

<sup>81</sup> See judgment of the Court of 4 May 1999 in *Joined Cases 108/97 and 109/97 Windsurfing Chiemsee (Windsurfing Chiemsee)* [1999] ECR I-2779, at I-2779, judgment of 25 January 2007 in *Case 321/03, Dyson Ltd v Registrar of Trade Marks (Dyson)*, [2007] ECR I-00687, I 712-728, Judgment of 6 May 2003 in *Case 104/01, Libertel Groep BV v Benelux-Merkenburea (Libertel)*, [2003] ECR I-03793, Judgment of the Court of 29 September 1998 in *Case 39/97, Canon Kabushiki Kaisha v Metro-Goldwyn-*



## 1. Capability of a Sign to Function as an Indication of Origin

The need for a sign to function as an indication of origin can be found in the TM Directive as well as in the CTM Regulation. Both legislations refer to it in their recitals:<sup>82</sup>

The protection afforded by the *registered trade mark* [or CTM], the function of which is in particular to guarantee the *trade mark as an indication of origin*, should be absolute in the case of identity between the mark and the sign and the goods or services. [...] (emphasis added)

According to AG Ruiz-Jarabo Colomer the notion of indication of origin has its roots in the *dialogue* that a trade mark establishes between a manufacturer and a consumer.<sup>83</sup> From an abstract point of view, a trade mark boils down to a means of communication which allows a trade mark owner to raise awareness and provide consumers with information on his products.<sup>84</sup> Communication refers to one person imparting something that he knows to another person.<sup>85</sup> In that sense, every act of communication requires a sender sending a message, a message expressed in a code which can be read by the recipient, a channel for transmission, and a recipient receiving the message.<sup>86</sup> The latter has to be able to decipher or decode the message as well as to comprehend and assimilate the content of message.<sup>87</sup> In that regard, humans as recipients possess a variety of sensors that allow them to receive messages and to decode them.<sup>88</sup> Applied to trade marks this means that a consumer can perceive trade marks as varied as the senses at his disposal.<sup>89</sup>

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*Mayer Inc., formerly Pathe Communications Corporation (Canon)* [1998] ECR I-5507, Judgment of the Court of 4 October 2001 in *Case 517/99, Merz & Krell GmbH & Co., Reference for a preliminary ruling: Bundespatentgericht – Germany (Merz & Krell & Co.)* [2001] ECR I-6959.

<sup>82</sup> See Rec. 11 of the TM Directive and Rec. 8 of the CTM Reg..

<sup>83</sup> Advocate General Ruiz-Jarabo Colomer in *Case 273/00, Sieckmann*, [2002] ECR I-11739, Rec. 19.

<sup>84</sup> Advocate General Ruiz-Jarabo Colomer in *Case 273/00, Sieckmann*, [2002] ECR I-11739, Rec. 19.

<sup>85</sup> See S. Maniatis, *Sent as Trademarks: Propertisation of Scents and Olfactory Property*, Law and The Senses, at 217-235 (1996).

<sup>86</sup> Advocate General Ruiz-Jarabo Colomer in *Case 273/00, Sieckmann*, [2002] ECR I-11739, Rec. 20.

<sup>87</sup> *Id.*

<sup>88</sup> *Id.*

<sup>89</sup> *Id.*, Rec. 21.

Finally, as a means of communication, *a endows a particular product with its reputation*, i.e. the trade mark's reputation.<sup>90</sup> In that context, the trade mark performs two functions for the consumer:<sup>91</sup>

- Identifying the origin of a good or service
- Indicating the quality of a good or service

*a) Identifying the origin of a good or service*

Enabling the consumer to identify the origin of a good or service is considered by AG Ruiz-Jarabo Colomer an essential function of a trade mark.<sup>92</sup> It is a function that has been postulated by the CJEU in multiple cases, in particular, in *Windsurfing Chiemsee*, *Canon* and *Merz & Krell & Co.*<sup>93</sup> AG Cosmas specified in *Windsurfing Chiemsee*, that identifying the origin of a good or service refers to:<sup>94</sup>

- Identifying an undertaking's product and distinguishing that product from other similar products (*distinguishing function of a trade mark*)
- Establishing a link between those products and a particular undertaking (*guarantee of origin*)

With regard to the distinguishing function of a trade mark AG Ruiz-Jarabo Colomer held that this function does not simply rest on linking a certain product with a particular undertaking.<sup>95</sup>

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<sup>90</sup> Advocate General Ruiz-Jarabo Colomer in *Case 273/00, Sieckmann*, [2002] ECR I-11739, Rec. 19.

<sup>91</sup> Keeling, *supra* note 67, para. 2-010.

<sup>92</sup> Advocate General Ruiz-Jarabo Colomer in *Case 273/00, Sieckmann*, [2002] ECR I-11739, Rec. 19; Some legal scholars refer here to a sign's capability of individualizing goods or services. F. Thouvenin *et al.*, *Repetitorium Immaterialgüterrecht*, at 154 (2010).

<sup>93</sup> See Judgment of the Court of 29 September 1998 in *Case 39/97, Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc., formerly Pathe Communications Corporation (Canon)* [1998] ECR I-5507, at I-5507, Judgment of the Court of 4 October 2001 in *Case 517/99, Merz & Krell GmbH & Co., Reference for a preliminary ruling: Bundespatentgericht – Germany (Merz & Krell & Co.)* [2001] ECR I-6959, at I-6959, Judgment of the Court of 4 May 1999 in *Joined Cases 108/97 and 109/97 Windsurfing Chiemsee (Windsurfing Chiemsee)* [1999] ECR I-2779, at I-2779; Keeling, *supra* note 67, para. 2-013.

<sup>94</sup> Advocate General Georges Cosmas in *Joined Cases 108/97 and 109/97 Windsurfing Chiemsee (Windsurfing Chiemsee)* [1999] ECR I-2779, para. 27.

<sup>95</sup> *Id.*

According to him, a consumer should simply be aware that products bearing the same trade mark originate from the same source regardless of knowing the manufacturer's identity.<sup>96</sup>

*b) Indicating the quality of a good or service*

In addition to indicating origin, a trade mark should also indicate quality.<sup>97</sup> According to the CJEU, it is an essential function as undertakings should be in a position to keep their customers by virtue of the quality of their products.<sup>98</sup> The trade mark system should provide an incentive for undertakings to invest in improving their goods and services. This reflects the public policy objectives of the trade mark system. Trade marks are intended to protect consumers from being misled as to the origin or quality of a product or service.<sup>99</sup> The trade mark system is additionally intended to serve as an incentive for businesses or individuals to maintain and improve the quality of their products.<sup>100</sup>

## 2. Capability of a Sign to Distinguish

The requirement for a sign to be able to distinguish between products of one undertaking from those of another undertaking is stipulated in the TM Directive and in the CTM Regulation:<sup>101</sup>

[...] signs which may constitute a trade mark, *provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.* [...] (emphasis added)<sup>102</sup>

[...] *trade marks enabling the products and services of undertakings to be distinguished by identical means* throughout the entire Community, regardless of frontiers, should feature

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<sup>96</sup> Advocate General Georges Cosmas in *Joined Cases 108/97 and 109/97 Windsurfing Chiemsee (Windsurfing Chiemsee)* [1999] ECR I-2779, para. 27.

<sup>97</sup> Advocate General Ruiz-Jarabo Colomer in *Case 273/00, Sieckmann*, [2002] ECR I-11739, Rec. 19; Keeling, *supra* note 67, para. 2-015.

<sup>98</sup> Judgment of the Court of 17 October 1990 in *Case 10/89 SA CNL-SUCAL NV v HAG GF AG, Reference for a preliminary ruling: Bundesgerichtshof - Germany. (HAG GF AG)* [1990] ECR I-3711, para. 13; *Case 517/99, Merz & Krell & Co.*, in particular Rec. 21 of the judgment.

<sup>99</sup> Waelde *et al.*, *see infra* note, at 547.

<sup>100</sup> *Id.*

<sup>101</sup> TM Directive and CTM Reg..

<sup>102</sup> *See* Rec. 8 of the TM Directive.

amongst the legal instruments which undertakings have at their disposal. [...] (emphasis added)<sup>103</sup>

As seen previously, AG Cosmas specified that identification of the origin of a product consists of identifying and distinguishing a product of one undertaking from the products of another undertaking.<sup>104</sup> In other words, trade marks should enable consumers to distinguish goods and services by their origin.<sup>105</sup>

The CJEU has elaborated on the capability to distinguish in *Dyson*.<sup>106</sup> A sign must be specific in order to distinguish products from one undertaking from those of another undertaking.<sup>107</sup> As a consequence, products with signs that are merely descriptive or decorative do not qualify as distinguishing.<sup>108</sup> The capability of a sign to distinguish has to be assessed by reference to the product it is intended designate.<sup>109</sup> A sign that cannot distinguish will be refused registration as a trade mark.<sup>110</sup> However, it is important to remember that a prerequisite to distinguishing is the capability of a sign to establish a dialogue between a manufacturer and a consumer.<sup>111</sup> It follows that only signs humans perceive as exhibiting an indicator of origin can serve as trade marks.<sup>112</sup>

### 3. Capability of a Sign to be Represented Graphically

The TM Directive and the CTM Regulation stipulate that a sign has to be capable of graphical representation to qualify as a trade mark:<sup>113</sup>

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<sup>103</sup> See Rec. 2 of the CTM Reg..

<sup>104</sup> See *supra* note 94.

<sup>105</sup> Keeling, *supra* note 67, para. 2-022.

<sup>106</sup> Judgment of 25 January 2007 in *Case 321/03, Dyson Ltd v Registrar of Trade Marks (Dyson Ltd)*, [2007] ECR I-00687, I 712-728.

<sup>107</sup> *Case 321/03, Dyson Ltd*, in particular Rec. 36 of the judgment; Waelde *et al.*, *supra* note 69, at 580; Keeling, *supra* note 67, para. 2-045.

<sup>108</sup> *Id.*

<sup>109</sup> *Id.*

<sup>110</sup> See *infra*, at 34.

<sup>111</sup> See *supra* notes 83 and 84.

<sup>112</sup> Others refer to this as an instinctive reaction to trade marks, such as Keeling *supra* note 67: [...] *You know a trade mark when you see [experience] one [...]*.

<sup>113</sup> See Art. 2 of the TM Directive and Art. 4 of the CTM Reg..

A [Community] trade mark may consist of any signs capable of being *represented graphically*, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings. (emphasis added)

According to AG Ruiz-Jarabo Colomer, the reason for graphical representation can be found in the public nature of the trade mark register.<sup>114</sup> This registry grants a trade mark owner a monopoly and exclusive right over his trade mark:<sup>115</sup>

[...] it must be possible to know, to the full extent of the public nature of registers, the nature and scope of the signs, references and symbols registered as a trade mark, which is why a graphical representation is required.

For Colomer, graphical representation relates to a trade mark's function as indicator of origin.<sup>116</sup> On the one hand, a trade mark possesses an intrinsic identification capability.<sup>117</sup> On the other hand, a trade mark refers to a sign that can be described by means of symbols that can be drawn on paper.<sup>118</sup> The CJEU followed his approach in *Sieckmann* by stating that a trade mark which is not in itself capable of being perceived visually complies with Article 2 of the TM Directive provided that:<sup>119</sup>

[...] it can be represented graphically, particularly by means of images, lines or characters, and that the representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective.

Those criteria are generally referred to as the *Sieckmann Seven*.<sup>120</sup> Some of the concepts that make up these criteria include self-contained, durable and objective. These properties were

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<sup>114</sup> Advocate General Ruiz-Jarabo Colomer in *Case 273/00, Sieckmann*, [2002] ECR I-11739, Rec. 36; Keeling, *supra* note 67, para. 2-051.

<sup>115</sup> *Id.*

<sup>116</sup> *Id.*; Keeling, *supra* note 67, para. 2-051.

<sup>117</sup> *Id.*

<sup>118</sup> *Id.*

<sup>119</sup> *Case 273/00, Sieckmann*, in particular Rec. 55 of the judgment.

<sup>120</sup> *Id.*, in particular Rec. 35 of the judgment; Waelde *et al.*, *supra* note 69, at 581.

closely related to the olfactory sign for which trade mark protection was sought in *Sieckmann*.<sup>121</sup> Those criteria guarantee that the trade mark on which a right of exclusivity is claimed becomes immediately clear.<sup>122</sup> Moreover, they guarantee that registered trade marks are intelligible; thereby helping interested consumers and undertakings when investigating the trade mark register.<sup>123</sup> Those criteria have been reaffirmed by the CJEU in other cases involving non-traditional trade marks, such as in *Libertel*.<sup>124</sup>

#### 4. Conclusions

To summarise, a trade mark in the meaning of the TM Directive and the CTM Regulation refers to a sign that is:

- Capable of functioning as indication of origin
- Capable of distinguishing products from one undertaking from those of other undertakings
- Capable of being represented graphically

*Capable of functioning as indication of origin:* It is important to note that in order to function as an indication of origin as sign has to be capable, *first*, of identifying an undertaking's product and to distinguish that product from other similar products (distinguishing function of a trade mark) and, *second*, to indicate the quality of that product. Moreover, in order to function as an indication of origin, a sign has to be able to endow a product with its reputation, which requires a sign to work as a means of communication.

*Capable of distinguishing:* The capability to distinguish overlaps with the capability to function as an indication of origin. However, as a capability in its own right, it refers to a trade mark's fundamental purpose, namely, to enable consumers to distinguish products based on their origins. The capability of a sign to distinguish can only be determined in relation to the product it

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<sup>121</sup> In respect of the olfactory sign, the CJEU considered the requirements of graphic representability not satisfied, neither by providing a chemical formula, by a description in written words, by the deposit of an odour sample or by a combination of those elements. *See supra* note 73.

<sup>122</sup> Advocate General Ruiz-Jarabo Colomer in *Case 273/00, Sieckmann*, [2002] ECR I-11739, Rec. 38; Keeling, *supra* note 67, para. 2-054.

<sup>123</sup> Advocate General Ruiz-Jarabo Colomer in *Case 273/00, Sieckmann*, [2002] ECR I-11739, Rec. 38; For more on graphical representability *see also* C. Seville, *supra* note 350, at 226 (2009).

<sup>124</sup> *Case 104/01, Libertel*, in particular Rec. 29 of the judgement.

designates. In order to be capable of distinguishing, a sign has to establish a dialogue between consumers and manufacturers.

*Capability to be represented graphically:* Finally, the capability to be represented graphically requires a sign to be represented according to the *Sieckmann Seven* criteria. This means a sign complies with graphical representation if it can be drawn [...] *by means of images, lines or characters, and that the representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective.*<sup>125</sup>

Those three factors are essential for a sign to perform the function of a trade mark. However, they all rest implicitly on the fundamental capability of a sign to *function as a means of communication* and its capability to *establish a dialogue between manufacturers and consumers*. Given its implicit nature, this quasi fourth factor can be considered the first condition for a sign to qualify as a trade mark.

### **III. The Sound Mark within the Meaning of the CTM Regulation**

What constitutes a sound mark within the meaning of Article 4 of the CTM Regulation? Can a sound sign serve as a CTM at all? What kind of sound signs can serve as CTMs? According to the notion of trade mark in the meaning of Article 2 of the TM Directive and Article 4 of the CTM Regulation, the notion of trade mark is open to any sign that complies with the three essential requirements, outlined in the previous chapter. A sound sign that complies with those requirements is able to perform the function of a trade mark in the EU and, thus, qualifies for registration with OHIM. In fact, clarifying the notion of sound mark within the meaning of the TM Directive and the CTM Regulation took place in basically two steps.

#### **1. The CJEU on Sound Marks**

That sound signs can qualify as trade marks has been upheld by the CJEU and the AGs implicitly in *Sieckmann* and later explicitly in *Shield Mark*.<sup>126</sup> In the latter case, the CJEU had to answer if Article 2 of the TM Directive has to be interpreted as precluding sounds or noises from being regarded as trade marks.<sup>127</sup> The CJEU held that it is clear from Article 2 of the TM

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<sup>125</sup> *Case 273/00, Sieckmann*, in particular Rec. 55 of the judgment.

<sup>126</sup> Judgment of 27 November 2003 in *Case 283/01, Shield Mark BV and Joost Kist h.o.d.n. Memex (Shield Mark)*, [2003] ECR I-14329.

<sup>127</sup> *Case 283/01, Shield Mark*, in particular Rec. 26 of the judgment.

Directive and the seventh recital in the preamble, that the list of signs in Article 2 of the TM Directive does not, expressively exclude sound signs.<sup>128</sup> In that regard the CJEU reaffirmed its statement in *Sieckmann*, in which the court stated that Article 2 of the TM Directive does not exclude signs of qualifying as trade marks that are not visually perceivable.<sup>129</sup> However, such signs fall with Article 2 of the TM Directive only if they comply with the *Sieckmann Seven* criteria, which means they can be [...] *represented graphically, particularly by means of images, lines or characters, and that the representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective.*<sup>130</sup> However, this left many open questions with regard to sound marks. Would the use of simple onomatopoeia qualify as a graphical representation of a sound sign? Would sonograms comply with graphical representation, given that not all sound signs can be represented by musical notation?

The CJEU addressed those issues in *Shield Mark*. Thereby, it further clarified the notion of *sound mark within the meaning of the TM Directive* and, eventually, provided valuable guidance for sound marks in the context of the CTM Regulation. In *Shield Mark*, the CJEU applied the *Sieckmann Seven* on sound signs. It established the conditions that a sound sign in terms of graphical representation must meet in order to qualify potentially as a trade mark.<sup>131</sup> The CJEU reaffirmed the general requirements outlined in *Sieckmann* for graphical representation.<sup>132</sup> According to the CJEU, graphical representation is satisfied where the sound sign is represented by “[...] *a stave divided into measures and showing, in particular, a clef, musical notes and rests, whose form indicates the relative value and, where necessary, accidentals*”.<sup>133</sup> Put in simple terms, a sound sign that can be graphically represented using musical notation qualifies as a sign in the meaning of Article 2 of the TM Directive.

Defining graphical representation for sound signs on the basis of musical notation limited the scope of sound signs to sounds with a discrete frequency spectrum which can be categorised according to a particular tone’s pitch.<sup>134</sup> In other words, this definition limited the scope of sound

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<sup>128</sup> *Shield Mark* Rec. 35 and *cf. supra* at 20.

<sup>129</sup> *Case 273/00, Sieckmann*, in particular Rec. 44 of the judgment

<sup>130</sup> *Id.*, in particular Rec. 55 of the judgment and *cf. supra* at 23.

<sup>131</sup> *See Case 283/01, Shield Mark*, in particular Rec. 64 of the judgment.

<sup>132</sup> *Id.*; Keeling, *supra* note 67, para. 2-060; C. Seville, *EU Intellectual Property Law and Policy*, at 228-230 (2009).

<sup>133</sup> *Case 283/01, Shield Mark*, in particular Rec. 64 of the judgment.

<sup>134</sup> *Cf. supra* at 7.



signs to sounds that humans perceive as music.<sup>135</sup> This left aside sounds with an irregular frequency spectrum, otherwise known as noises.<sup>136</sup> The CJEU opted for musical notation for the sake of providing the [...] *competent authorities and the public, in particular traders, to know precisely the sign whose registration as a trade mark is sought.*<sup>137</sup> However, it is important to acknowledge that musical notation does not account for timbre.<sup>138</sup> While musical notation represents aurally perceived music through the use of written symbols, it fails to provide for an impression of how a piece of music would sound in reality.<sup>139</sup> A piece of music played with a trombone would sound very different from the same piece played with a transverse flute.<sup>140</sup>

## 2. Change in Registration Practice: Sonograms and Sound Files

The fact that noises are considered outside the scope of sound signs in the meaning of the TM Directive has also had repercussions for CTMs. In 1999 Metro-Goldwyn-Mayer (MGM) submitted an application to have their famous *Roar of a Lion* registered as a CTM in the EU.<sup>141</sup> Given that a roar of a lion could not be graphically represented by musical notation, MGM submitted to the OHIM a sonogram, an image that shows how an acoustic signal varies over time, together with a description of the sound.<sup>142</sup> MGM's application was dismissed by the first instance and again in 2003 in the case *Roar of a Lion* by the Fourth Board of Appeal due to insufficient graphical representation of the trademark.<sup>143</sup> The OHIM denied registration a sound marks for which graphical representation was submitted in the form of sonograms.<sup>144</sup> According to the OHIM they would not meet the criterion of being self-contained.<sup>145</sup> This meant that a third party examining the CTM register would neither be able to reproduce such a graphically

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<sup>135</sup> Cf. *supra* at 7.

<sup>136</sup> *Id.*

<sup>137</sup> See *Case 283/01, Shield Mark*, in particular Rec. 64 of the judgment.

<sup>138</sup> Cf. *supra* at 7.

<sup>139</sup> *Id.*

<sup>140</sup> *Id.*

<sup>141</sup> See OHIM Dec. of the Fourth Board of Appeal of 25 August 2003 in *Case R 781/1999-4, Sound Mark (Roar of a Lion)*.

<sup>142</sup> *Id.*

<sup>143</sup> *Case R 781/1999-4, Sound Mark (Roar of a Lion)*, in particular Rec. 20 of the judgement.

<sup>144</sup> *Id.*

<sup>145</sup> *Id.*

represented sound sign nor gain a general idea of it.<sup>146</sup> A surprising exemption to the OHIM's practice in *Roar of a Lion* and later *Tarzan Yell* is the case of *HEXAL*, in 2005.<sup>147</sup> Here, the OHIM's Fourth Board of Appeal decided to grant trade mark protection to a sound sign on the basis of a sonogram. The board of appeal held that the arguments put forward against the permissibility of sonograms were unconvincing and that [...] *it is possible to learn how to understand sonograms, just as one can learn how to understand foreign languages or musical notation.*<sup>148</sup> It seems the board of appeal took the new rules governing the registration practice for CTMs, adopted two months earlier, as reason for broadening the acceptable forms of graphical representation. In July of that year, the CTMI Regulation that stipulated the rules for registration of CTMs was amended. Rule three paragraph six was replaced by the following paragraph:

Where registration of a sound mark is applied for, the representation of the trade mark shall consist of a graphical representation of the sound, in particular a musical notation; where the application is filed through electronic means, it may be accompanied by an electronic file containing the sound. The President of the Office shall determine the formats and maximum size of the electronic file.

However, despite the decision in *HEXAL*, sonograms remained a contested issue.<sup>149</sup> In 2006, Edgar Rice Burroughs, Inc. was denied CTM registration for its famous *Tarzan Yell* on the basis that sonograms do not sufficiently qualify as graphical representation.<sup>150</sup> The Fourth Board of Appeal held that [...] *nobody would be able to hum the Tarzan yell from the spectrogram [sonogram] filed by the applicant in the present case and nobody reads spectrograms*

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<sup>146</sup> *Case R 781/1999-4, Sound Mark (Roar of a Lion)*, in particular Rec. 20 of the judgement; *Case R 708/2006-4, Tarzan Yell*, in particular Rec. 20 of the judgment.

<sup>147</sup> OHIM Dec. of the Fourth Board of Appeal of 27 September 2007 in *Case R 295/2005-4, Sound Mark (HEXAL)*.

<sup>148</sup> *Id.*

<sup>149</sup> See G. Humphreys, *Non-Conventional Trademarks: An Overview of Some of the Leading Case Law of the Boards of Appeal*, 31 EIPR 9, at 437-448 (2010).

<sup>150</sup> OHIM Dec. of the Fourth Board of Appeal of 27 September 2007 in *Case R 708/2006-4, Tarzan Yell, (Tarzan Yell)*, in particular Rec. 47 of the judgment; for more substantial discussion of the case see S. Yavorsky, *Ministry of Sound - OHIM and the Tarzan Yell*, 19 EntLR 3, at 63-65 (2008).

[sonogram] *for entertainment*.<sup>151</sup> However, the board of appeal added that particularly with regard to sounds other than music, the amendment to the CTMI Regulation has provided the basis for filing sound files together with a graphical representation.<sup>152</sup> They continued to postulate that [...] *[s]uch sound files do fulfil the requirements of being easily accessible and self-contained, as the Office publishes the sound file in electronic format and the reader of the CTM Bulletin will then be able to hear the sound*.<sup>153</sup> Nevertheless, the requirement of graphical representation, i.e. the acceptance or rejections of sonograms, seemed to remain an unclear issue for sound mark applicants. In response to the lack of clarity, in 2007 the OHIM published a press release. It expressed that since the amendments to the CTMI Regulation in 2005, the OHIM was therefore [...] *able to accept sonograms provided they are accompanied, at the time of the filing, by an MP3 sound file*.<sup>154</sup> Eventually, this paved the way for the registration of MGM's *Roar of a Lion* in 2008 and cleared the way for the CTM registration of many new sound marks in the EU.<sup>155</sup>

### 3. Conclusions

With regard to the first research question, *how has the notion of sound mark as a legal concept changed from the past to today*, we can conclude that defining graphical representation for sound signs on the basis of sonograms and MP3 sound files substantially increased the breadth of sound marks in the meaning of Article 4 of the CTM Regulation. It made it possible to register melodies as well as noises.<sup>156</sup> Considering the fact that musical notation has its own deficiencies, i.e. its inability to capture timbre, this new OHIM registration practice is thought to have enhanced legal certainty, regardless of the particular sound sign at hand.

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<sup>151</sup> *Case R 708/2006-4, Tarzan Yell*, in particular Rec. 45 of the judgment.

<sup>152</sup> *Id.*

<sup>153</sup> *Id.*

<sup>154</sup> *Tarzan's trade mark yell*, Press Release CP/07/01, Website of the Office for Harmonisation in the Internal Market (Trade Marks and Designs), <http://oami.europa.eu/en/office/press/pdf/051107.pdf> [18.08.2015].

<sup>155</sup> See CTM 005170113 and other sound marks online accessible on the OHIM's databases, *see supra* at 6.

<sup>156</sup> Interestingly, only a couple of years ago some deemed noises anyway unlikely to serve as indicators of origin for goods or services. *See Sandri & Rizzo, supra note 24, at 145 (2003)*.

## IV. The Sound Mark in Other Jurisdictions

### 1. Switzerland

In Switzerland, trade marks are governed by the Federal Act on the Protection of Trade Marks and Indications of Source, (Trade Mark Protection Act, TmPA).<sup>157</sup> Article 1 of the TmPA defines a trade mark as follows:<sup>158</sup>

1 A trade mark is a sign capable of distinguishing the goods or services of one undertaking from those of other undertakings.

2 Trade marks may, in particular, be words, letters, numerals, figurative representations, three-dimensional shapes or combinations of such elements with each other or with colours.

In 2009, the Federal Supreme Court of Switzerland (Bundesgericht, BGER) in *Melodie mit sieben Tönen* paved the way for sound marks absent of textual elements to be registered.<sup>159</sup> Until then, the Swiss Federal Institute of Intellectual Property (Eidgenössisches Institut für Geistiges Eigentum, IGE) employed a rather inconsistent practice with regard to the registration of sound marks. Sound marks were registered with or without textual elements as well as without having acquired secondary meaning.<sup>160</sup> The decision by the Supreme Court led the IGE to revise its registration practice for sound marks.

Unlike with the CTM in the EU, registration of a sound mark in Switzerland still requires graphical representation. However, according to Article 10(1) of the Ordinance on the Protection of Trademarks (OPTm) the IGE can allow other electronic forms of representation.<sup>161</sup> The Supreme Court decision is considered to have given impetus to the registration of sound marks

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<sup>157</sup> Bundesgesetz über den Schutz von Marken und Herkunftsangaben vom 28. August 1992 (Markenschutzgesetz, SR 232.11), Federal Act on the Protection of Trade Marks and Indications of Source, Trade Mark Protection Act (TmPA).

<sup>158</sup> *Id.*

<sup>159</sup> BGE vom 7. April 2009, 4A\_566/2008 X. KG gegen Eidgenössisches Institut (IGE), BGE 135 III 359 E. 3.2, *Melodie mit sieben Tönen*; Bendi, *supra* note 9.

<sup>160</sup> Bendi, *supra* note 9.

<sup>161</sup> Verordnung über den Schutz von Marken und Herkunftsangaben (MSchV, SR 232.111), Ordinance on the Protection of Trademarks (OPTm). Some legal scholars in Switzerland argue that graphical representation should not be considered a protection criterion for trade marks according to TmPA. See Suter-Sieber, *supra* note 23, at 120 and 157.

in Switzerland.<sup>162</sup> Of the currently thirty-four registered sound marks, twenty-two obtained registration in the past six years.<sup>163</sup> It can be concluded that currently the scope of sound signs eligible for registration in Switzerland is similar if not identical to the scope applied for CTMs in the EU. While different melodies have been registered, the registration of noises as sound marks in Switzerland appears to be only a matter of time.<sup>164</sup>

## 2. United States

In the US, trade marks are governed by the Trademark Act of 1946 (Lanham Act).<sup>165</sup> It defines trade mark as follows:<sup>166</sup>

The term “trademark” includes any word, name, symbol, or device, or any combination thereof—

(1) used by a person, or

(2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter, to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.

The US differentiates between trade marks and service marks.<sup>167</sup> The former are signs used to distinguish products of different undertakings.<sup>168</sup> The latter are signs used to distinguish services of different undertakings. The word *McDonald’s*, for example, is registered as a service mark for restaurant services. The word *Nike*, however, is registered as a trademark for footwear and

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<sup>162</sup> Bundi, *supra* note 9.

<sup>163</sup> As of November 24, 2015.

<sup>164</sup> See Suter-Sieber, *supra* note 23, at 157.

<sup>165</sup> Code of Laws of the United States of America 15 USC § 1051 et seq. Trademark Act of 1946 as amended (Lanham Trademark Act); B. W. Pattishall et al., *Trademarks and Unfair Competition*, at 90 (2002); This study relies on a common form of citing statutes in the US, which is by referring to the U.S. code title (15) and the relevant paragraph (*e.g.* § 1127). For an introduction into US intellectual property law see D. Hunter, *The Oxford Introductions to U.S. Law* (2012) or Halpern et al., *Fundamentals of United States Intellectual Property Law, Copyright, Patent, and Trademarks* (2012)

<sup>166</sup> 15 USC § 1127.

<sup>167</sup> *Id.*

<sup>168</sup> Pattishall et al., *supra* note 165, at 100.

clothing products. Depending on the use of a trade mark, it might be necessary for a company to have a word which was originally registered as a service mark to be re-registered as a trade mark. A change of this nature would be caused by its use changing from designating services to designating products.<sup>169</sup> In reality, many companies end up having both marks, for example *Google*. Service marks are registered the same way as trade marks; therefore, for the sake of simplicity, this study will refer to both of them synonymously as trade marks.<sup>170</sup>

The registration process in the US, however, differs significantly from the EU and Switzerland on one point. It has two separate registers for the registration of trade marks.<sup>171</sup> While the *Principal Register* is widely known, the *Supplemental Register* is somewhat more obscure. The former is open to trade marks that are distinctive by virtue of either their unique characteristics or their long and exclusive use.<sup>172</sup> The latter provides the opportunity to register trade marks that are not considered distinctive at the time of registration but are expected to become distinctive.<sup>173</sup> This is generally expected to take place over a period of five years, a process referred to in the US as acquiring *second meaning*. It will be discussed later with regard to non-distinctiveness as an absolute ground of refusal.<sup>174</sup>

The US has as a much longer and broader experience with sound marks than the EU or Switzerland.<sup>175</sup> The case *In re General Electric Broadcasting Company, Inc.* is considered a

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<sup>169</sup> When a trade mark or service mark is federally registered with the USPTO, the owner of the trade mark may use the registered trade mark symbol, often referred to as the registration symbol, ®. Trade mark or service mark that are not federally registered use the trade mark symbols ™ and ™ respectively.

<sup>170</sup> Service marks are subject to the same provisions relating to the registration of trademarks, 15 USC § 1053; Website of the USPTO, <https://www.uspto.gov> [20.10.2015].

<sup>171</sup> 15 USC §§ 1051 to 1072 (Principal Register) and §§ 1091 to 1096 (Supplemental Register); Pattishall et al., *supra* note 165, at 100-104.

<sup>172</sup> 15 USC § 1052(f).

<sup>173</sup> Pattishall et al., *supra* note 165, at 103.

<sup>174</sup> *See infra* at 45.

<sup>175</sup> For examples of US sound marks *see: Trademark "Sound Mark" Examples*, The United States Patent and Trademark Office (USPTO) <http://www.uspto.gov/trademark/soundmarks/trademark-sound-mark-examples> [18.08.2015] and *see* § 807.09 of the Trademark Manual of Examining Procedure (TEMP) concerning the requirements for submitting applications for sound marks in the US and §904.03(f) regarding specimens for sound marks. *See also* R. P. Merges et al, "Intellectual property in the new technological age" Wolters Kluwer Law & Business (2010).

landmark case for sound marks in the US, paving the way for the registration of sound marks.<sup>176</sup> Contrary to the EU and Switzerland, graphical representation of a sound sign was never a requirement for registration. The USPTO accepts written descriptions or specimens, such as audio cassettes and compact disks.<sup>177</sup> Such specimens should contain a sufficient portion of the audio content to indicate the nature of the sound.<sup>178</sup> It is also possible to submit musical notation if the trade mark comprises music or words set to music.<sup>179</sup> Thus, the *Tarzan Yell* or MGM's *Roar of a Lion* were already registered in the US for quite some time before they were registered in the EU. It can be concluded that the scope of sound signs eligible for registration in the US is identical to the scope with regard to the CTM in the EU. However, contrary to the EU, the US has a much longer experience with the registration of sound marks.

#### **D. Grounds for Refusal: The EU in Comparison to Switzerland and the US**

Having established that all kinds of sound signs may qualify as sound marks in the context of the CTM Regulation, it is apt to address the grounds for refusal of a CTM. These are relevant as they relate to the second research question on how the *OHIM* conceptualise the notions of *descriptiveness and non-distinctiveness which are important absolute grounds for refusal*. The CTM Regulation, and trade mark legislation in general, stipulates grounds on which an application for registration of a trade mark can be refused.<sup>180</sup> Two categories of grounds for refusal exist. Absolute grounds for refusal relate to the intrinsic qualities of a sign; those reasons are listed in Article 7 of the CTM Regulation. Relative grounds for refusal address conflicts between already registered trade marks and similar signs for which registration is sought; those grounds are listed in Article 8 of the CTM Regulation.

This study will examine the OHIM's practice of applying grounds for refusal on sound marks. The focus will be on absolute grounds for refusal. Relative grounds for refusal will only be briefly addressed. A full examination would go beyond the scope of this study. With regard to

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<sup>176</sup> Ahuja, *see supra* note 24, at 576; *In re General Electric Broadcasting Company, Inc.*, 199 USPQ 560 (TTAB 1978).

<sup>177</sup> *Id.*

<sup>178</sup> *Id.*

<sup>179</sup> *Id.*

<sup>180</sup> For a concise overview on the application procedure for a CTM *see also* A. Michaels & A. Norris, A Practical Approach to Trade Mark Law, at 93-98 (2010); Seville, *supra* note 350, at 233-269 (2009).

CTMs, no application for a sound mark has yet been opposed by a third party claiming prior right to a trade mark.<sup>181</sup> The examination of the OHIM's practice of applying the absolute grounds for refusal will be complemented by addressing the same practice in two other jurisdictions, Switzerland and the US. The overall aim is to better understand the circumstances under which a sound sign is denied registration as a CTM in the EU and also to gain insights from the practices in the other two jurisdictions.

### **I. Absolute Grounds for Refusal**

Of the grounds for refusal, Article 7(1)(b), (c) and (d) are concerned with aspects of distinctiveness. This is confirmed by the fact that if one of these grounds is established, it can be overcome by showing that a sign has, through use, become distinctive on the basis of Article 7(3).<sup>182</sup> Those three grounds prevent registration of marks which are non-distinctive, descriptive or generic, unless a sign has acquired distinctiveness through use.<sup>183</sup>

The OHIM has guidelines for the examination of absolute grounds for refusal.<sup>184</sup> Those guidelines provide assistance particularly for well-established visual trade marks and some non-traditional trade marks, such as shapes and colours. However, they lack substance when it comes to sound marks.<sup>185</sup> For that reason, this study will examine OHIM's practice with regard to the application of absolute grounds for refusal.<sup>186</sup> It will do so in a descriptive way while focusing on the arguments brought forth by OHIM through its decisions that declined registration of a sound mark. This lays the ground for examining OHIM's practice with regard to the settled case law on grounds for refusal; however, an in depth examination would go beyond the scope of this

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<sup>181</sup> As of October 28, 2015.

<sup>182</sup> Keeling, *supra* note 67, para. 8-010.

<sup>183</sup> *Id.*

<sup>184</sup> *Guidelines for Examination in the Office for Harmonization in the Internal Market (Trade Marks and Designs) on Community Trade Marks, Part B, Examination, Section 4, Absolute Grounds for Refusal* (OHIM Examination Guidelines), Website of the Office for Harmonisation in the Internal Market (Trade Marks and Designs), [https://oami.europa.eu/tunnel-web/secure/webdav/guest/document\\_library/contentPdfs/trade\\_marks/Guidelines/05\\_part\\_b\\_examination\\_section\\_4\\_absolute\\_grounds\\_for\\_refusal\\_en.pdf](https://oami.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/trade_marks/Guidelines/05_part_b_examination_section_4_absolute_grounds_for_refusal_en.pdf) [18.08.2015].

<sup>185</sup> *Id.*

<sup>186</sup> For a general overview and discussion of the absolute grounds for refusal *see* Seville, *supra* note 350, at 233-253 (2009).



study.<sup>187</sup> Consequently, the outcome of the examinations of this study are primarily beneficial for applicants seeking CTM registration for the sound sign.

Among the absolute grounds for refusal, only those considered most closely related to the capabilities of a sign to function as an indication of origin will be addressed by this author, encapsulated by Articles 7(1)(a) to (d). In addition to those Articles, this study will address Article 7(3) which provides the basis to overcome the grounds for refusal stipulated in Article 7(1)(b), (c) and (d) on the basis of demonstrating acquired distinctiveness. This study will address those grounds for refusal partially in a reversed order. It will start with Article 7(1)(a). This will then be followed by Article 7(3), Article 7(1)(d), Article 7(1)(c) and, finally, Article 7(1)(b). The underlying reasoning behind this is that an objection based on Article 7(1)(a) cannot, contrary to the others, be remedied by acquiring distinctiveness. The remaining articles are tackled according to the concreteness with regard to the subject matter they refer to.

Finally, it is important to acknowledge that Article 7(1) CTMR is a European provision. According to the OHIM, it has to be interpreted on the basis of a common European standard.<sup>188</sup> It would be wrong to apply different standards of distinctiveness or different standards on the breach of public order and morality that are based on varying national traditions.<sup>189</sup> According to Article 7(2), CTM registration can be refused if a trade mark is considered descriptive or to lack distinctive character in one of the member states.<sup>190</sup> For sound marks, this means that sound signs which, based on their sematic meaning, would come under one of the grounds for refusal in one or more member states, would be refused registration as CTM.

#### 1. Article 7 (1) (a) CTM Regulation: Non-conforming with Article 4

Article 7(1)(a) of the CTM Regulation is a cross-reference to Article 4. It means that a sign must qualify as a trade mark before it can be registered.<sup>191</sup> The sign must be (i) represented graphically and must be (ii) capable of distinguishing the goods or services it designates from those of other undertakings.<sup>192</sup>

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<sup>187</sup> For an excellent overview on settled case law in the EU, *see* Keeling, *supra* note 67, para.8-001-8-307.

<sup>188</sup> OHIM Examination Guidelines, *supra* note 184, at 5.

<sup>189</sup> *Id.*

<sup>190</sup> *Id.*

<sup>191</sup> Keeling, *supra* note 67, para. 8-010.

<sup>192</sup> OHIM Examination Guidelines, *supra* note 184, at 8.

The OHIM Guidelines stipulate that a trade mark has to consist of a sign that is graphically representable and of distinguishing character.<sup>193</sup> With regard to the notion of sign, the Guidelines acknowledge that, in principle, a trade mark may consist of any sign.<sup>194</sup> However, it also states that Article 4 of the CTM Regulation may not be interpreted to allow any non-specific subject-matter to necessarily qualify as a sign.<sup>195</sup>

In the context of the CTM, sound signs satisfy the requirements of graphical representation when they are either submitted for registration in the form of musical notation, or in the form of sonograms together with a sound file.<sup>196</sup>

In the Guidelines, the OHIM provides one example of a sound mark that was refused application under Article 7(1)(a). It was an early submission of the *Tarzan Yell* for which the applicant provided an incomplete sonogram. However, it has to be acknowledged that the application was submitted at a time when registration of sound signs based on noises such as the *Tarzan Yell* would generally not have been possible with OHIM.<sup>197</sup> Yet another decision, not included in OHIM's Guidelines, is more interesting. It concerned a sound sign submitted in 2006 for trade mark registration. It was described as *a musical jingle in the key of C composed of two notes in the sequence of F, C and any relative equivalent thereof*.<sup>198</sup> OHIM denied its registration.<sup>199</sup> It held that the sound sign failed to comply with the requirement of graphical representation.<sup>200</sup> The written description of the sign did not correspond to the graphical representation.<sup>201</sup> OHIM concluded that based on the description it was impossible of knowing what the sound mark would really sound like.<sup>202</sup>

The requirement of distinguishable character refers to an abstract ability of a sign to serve as an indication of origin.<sup>203</sup> With regard to distinguishable character, no decision on sound marks

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<sup>193</sup> OHIM Examination Guidelines, *supra* note 184, at 9.

<sup>194</sup> *Id.*

<sup>195</sup> *Id.*

<sup>196</sup> *See supra* at 28; OHIM Examination Guidelines, *supra* note 184, at 11.

<sup>197</sup> *Id.*

<sup>198</sup> OHIM Refusal of application for a Community trade mark und Art. 7 of the Reg. and Rule 11(3) of the Implementing Reg. in *Application No. 004010336, Tellme Networks, Inc.*

<sup>199</sup> *Id.*

<sup>200</sup> *Id.*

<sup>201</sup> *Id.*

<sup>202</sup> *Id.*

<sup>203</sup> *Id.*

could be found in which OHIM established a lack of distinguishable character under Article 7(1)(a).<sup>204</sup>

It can be concluded that with regard to sound marks an applicant should make sure to comply with the graphical representability requirement and provide in its application either adequate musical notations or a complete sonogram together with a sound file. Finally, the applicant is well advised to ensure that any description of the sound sign fits with the graphical representation.

*a) Switzerland*

Switzerland distinguishes between formal and material examinations of a trade mark application.<sup>205</sup> The graphical representability belongs to the formal examination. As for the CTM, a sound sign in Switzerland satisfies the requirements of graphical representation when it is submitted for registration in the form of musical notation and, most likely, as well as in the form of a sonogram together with a sound file.<sup>206</sup>

According to the IGE's Trade Mark Guidelines, prior to examining if a sign might be denied registration under Article 2 of the TmPA, the IGE will examine if the sign can be a trade mark at all in the meaning of Article 1(1) of the TmPA.<sup>207</sup> According to the trade mark definition, such a sign has to be able to distinguish and to perform the function of an indication of origin.<sup>208</sup> Similar to the notion of *distinguishability* in Article 4 of the CTM Regulation, the TmPA stipulates that a sign capable of being a trade mark requires abstract distinguishability.<sup>209</sup> According to the IGE, a lack of distinguishability arises only in situations in which a sign would under no circumstance be recognised and understood as a trade mark.<sup>210</sup> Examples for such signs are complex signs, such as barcodes and signs which are not recognised by the relevant public as a consistent sign. This can be the case with long texts or melodies.<sup>211</sup>

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<sup>204</sup> As of November 24, 2015.

<sup>205</sup> *Richtlinien in Markensachen*, 1. Januar 2011 (IGE Trade Mark Guidelines), IGE, <[https://www.ige.ch/file\\_admin/user\\_upload/Juristische\\_Infos/d/rlma/rlma\\_d.pdf](https://www.ige.ch/file_admin/user_upload/Juristische_Infos/d/rlma/rlma_d.pdf)> [18.08.2015].

<sup>206</sup> IGE Trade Mark Guidelines, *supra* note 205 at 22; *See supra* at 31.

<sup>207</sup> IGE Trade Mark Guidelines, *supra* note 205 at 62.

<sup>208</sup> *Id.*

<sup>209</sup> *Id.*

<sup>210</sup> *Id.*

<sup>211</sup> *Id.*

Assuming that a lack of distinguishability in the above meaning will only arise in very rare cases, it can be concluded that, with regard to sound marks, an applicant should make sure to fully comply with the graphical representability requirement and provide in his application adequate musical notations. A complete sonogram together with a sound file would also be likely to be accepted by the IGE in an electronic application.<sup>212</sup> Finally, the applicant is well advised to ensure that any description of the sound sign fits with the graphical representation.

*b) United States*

Given the availability of two registers, a sound mark applicant in the US can circumvent the requirement of distinguishability. He can register a sound mark lacking distinguishability on the Supplemental Register and await registration on the Principal Register until his trade mark has acquired distinctiveness.<sup>213</sup> An applicant will only face the requirement of distinguishability in the event that he seeks registration of a sound mark directly from the Principal Register. Unlike the EU and Switzerland, the US does not stipulate a particular form of graphical representation as a requirement for a sign to qualify as trade mark. However, according to the Trademark Manual of Examining Procedure (TMEP), the USPTO requires the applicant to supplement the description of his sound sign with an electronic audio or video file.<sup>214</sup>

It can be concluded that, with regard to sound marks, an applicant submitting a sound sign for registration on the Supplemental Register should make sure to comply primarily with the requirement of including an electronic audio or video file with the description of the sound sign. However, if an applicant wishes to register a sound sign on the Principal Register or move a sound mark from the Supplemental to the Principal Register, he will be required to demonstrate that the sign or trade mark serves as an indication of origin, is distinctive and non-functional.<sup>215</sup>

## 2. Article 7 (3) CTM Regulation: Acquired Distinctiveness

Article 7(3) provides the basis to overcome the grounds for refusal stipulated in Article 7(1)(b) (non-distinctive signs), Article 7(1)(c) (descriptive signs) and Article 7(d) (customary signs).

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<sup>212</sup> Bundi, *supra* note 9.

<sup>213</sup> Pattishall et al., *supra* note 165, at 100-104.

<sup>214</sup> 807.09 “Drawing” of Sound, Scent, or Non-Visual Mark, Trademark Manual of Examining Procedure (TMEP), <http://tmep.uspto.gov/> [20.08.2015].

<sup>215</sup> *See infra* at 39, 40, 40 and 41.

OHIM examines acquired distinctiveness only on request from the applicant.<sup>216</sup> The applicant must provide the OHIM with evidence that proves that the sign has acquired distinctiveness prior to the filing date of the application for trade mark registration.<sup>217</sup>

There has been only one case in which a sound sign was considered by OHIM to have acquired distinctiveness. In 2009, PHILIPS submitted a short sound sign consisting of two notes.<sup>218</sup> Registration of the sound sign was first declined by OHIM on the ground of non-distinctiveness stated in Article 7(1)(b) of the CTM Regulation. However, the decision was eventually repealed in 2011. After PHILIPS submitted additional information, registration was finally granted by OHIM on the basis that the sound sign had acquired distinctiveness.<sup>219</sup> Unfortunately, the relevant documents leading to OHIM's revised decision are classified as confidential and cannot be accessed.

In 2013, the OHIM objected registration of a sound mark consisting of three musical notes.<sup>220</sup> It held that the three musical notes were too basic and were played in such a rapid way that it would make little or no impact upon the consumer when heard. Interestingly, OHIM provided the applicant with some guidance on the requirements to demonstrate that a sound mark

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<sup>216</sup> OHIM Examination Guidelines, *supra* note 184, at 77.

<sup>217</sup> *Id.*; For more on assessing distinctiveness acquired through use *see also* Philips, *supra* note 15, at 109-114 (2003).

<sup>218</sup> OHIM refusal of application for a community trade mark und Art. 7 of the Reg. and Rule 11(3) of the Implementing Reg. in *Application No. 008293557, Koninklijke Philips N.V.*

<sup>219</sup> Unfortunately, the author could not recall any PHILIPS product that would emanate such a sound mark. The author spent time searching the Internet for PHILIPS products related to the classes for which the company obtained the sound mark. He could not find any PHILIPS product that would display the particular sound mark on websites used for advertisement, such as PHILIPS product websites or YouTube. However, the length sound sign seems to indicate that it might be related to the on/off switching of PHILIPS devices.

<sup>220</sup> It concerned CTM 011377074 and 011377033, *see supra* at 45; *See also Windsurfing Chiemsee* in which the CJEU established what was required in order for a mark to have acquired distinctive character *through use*. In the same case, the CJEU rejected the German Doctrine of *Freihaltungsbedürfnis* a concept that keeps certain signs free, i.e. not registrable as trade marks at all. *Joined Cases 108/97 and 109/97 Windsurfing Chiemsee, in particular Rec. 37* of the judgement.

has acquired distinctiveness *through use*, which would allow the applicant to overcome Article 7(1)(b):<sup>221</sup>

- A Substantial part of the relevant public has to identify the product, based on the sound sign, with a particular undertaking. Distinctiveness has to have been acquired prior to the application for registration.
- The applicant is required to demonstrate that the sound sign has acquired distinctiveness based on its use in the geographical area in which it has not previously had distinctiveness.
- OHIM would assess the sign's distinguishing capability based on all dimensions that can demonstrate that the sign has acquired this capability, such as market share, intensity, geographical reach, duration of use, advertisement expenditures of the undertaking for the sign, the share of the relevant public that identifies products with a particular sign as linked to the correct undertaking, as well as statements of chambers of commerce and other professional associations.
- OHIM would assess distinguishability and acquired distinctiveness of the sign as trade mark and would also examine how the relevant public perceives the relevant category of products.

Some argue that the threshold for acquiring distinctiveness, i.e. recognition by the relevant public, should be lower for sound marks than other types of trade marks.<sup>222</sup> This would account for the fact that sound marks are more difficult to memorise and distinguish amongst other acoustic signals, and that their use for products is more limited.<sup>223</sup> However, it seems unclear how such a treatment could be reconciled with the general approach that signs of different types should not be subject to different requirements with regard to distinctiveness.<sup>224</sup>

In the context of sound marks and the case cited above, acquired distinctiveness could be relevant for sound icons that could initially be deemed by the OHIM too brief to function as an indication of origin and, thus, be denied registration on the basis of Article 7(1)(b).<sup>225</sup>

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<sup>221</sup> OHIM refusal of application for a community trade mark und Art. 7 CTMR and Rule 11(3) of the Implementing Reg. in *Application No. 011377074, CVS Pharmacy, Inc.*, at 2.

<sup>222</sup> Kortbein, *supra* note 21, at 216.

<sup>223</sup> *Id.*

<sup>224</sup> See Ianeva, *supra* note 24.

<sup>225</sup> See *supra* at 45.

a) *Switzerland*

Article 2(a) of the TmPA stipulates that the following are excluded from trade mark protection: [...] signs that are in the public domain, except where they have become established as a trade mark through use for the goods or services for which they are being claimed.” The last part of the sentence refers to acquisition of distinctiveness as seen in Article 7(3) of the CTM Regulation. This Article concerns signs which were earlier considered excluded from protection due to their inability to distinguish.

However, according to Swiss trade mark practice, to become established as a trade mark through use (*Verkehrsdurchsetzung*) requires a very intensive use of that particular sign by an undertaking explicitly in the function of a trade mark in the course its trade.<sup>226</sup> Such a sign becomes registrable only if a majority of the relevant public, i.e. potential consumers, in all of Switzerland associates the sign with a particular undertaking.<sup>227</sup> However, it is not required that the relevant public identifies the particular undertaking by its name. Similar to the OHIM’s assessment of acquired distinctiveness, the IGE examines all possible dimensions that can demonstrate that a sign has in fact acquired distinctiveness.<sup>228</sup> This requires, in particular, a demoscopic market study in which sixty to seventy percent of the panel must recognise the sign as a trade mark.<sup>229</sup>

Finally, Switzerland, unlike the EU, applies the concept of *Freihaltungsbedürfnis*.<sup>230</sup> According to this legal concept the public domain consists of so called absolute signs that cannot acquire distinctiveness.<sup>231</sup> Examples include the natural colour of a product or a colour being prescribed for a particular good, such as red for fire extinguisher.<sup>232</sup>

In light of the subject matter of the decision, acquired distinctiveness might be especially relevant for sound icons that could be initially considered by OHIM too brief to be capable to function as an indication of origin and, thus, be denied registration on the basis of Article 7(1)(b).<sup>233</sup>

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<sup>226</sup> IGE Trade Mark Guidelines, *supra* note 205 at 144-156; Thouvenin *et al.*, *supra* note 92, at 159.

<sup>227</sup> *Id.* Not only one in one or two language regions but in all.

<sup>228</sup> *Id.*; *See supra* at 39.

<sup>229</sup> IGE Trade Mark Guidelines, *supra* note 205 at 144-156; Thouvenin *et al.*, *supra* note 92, at 159.

<sup>230</sup> *See supra* note 220.

<sup>231</sup> *Id.*

<sup>232</sup> *Id.*

<sup>233</sup> *See supra* at 45.

b) *United States*

US trade mark legislation provides for a prima face presumption of acquired distinctiveness after a period of five years of continued use in trade.<sup>234</sup> As already mentioned, the US' dual registers provide the Supplemental Register the possibility of registering trade marks that are, at the day of filing, not distinctive.<sup>235</sup> When moving a trade mark from the Supplemental Register to the Principal Register, the applicant has to provide evidence that the trade mark qualifies as an indicator of origin and has acquired second meaning, i.e. distinctiveness.<sup>236</sup> Eventually, a sign may be considered to have acquired distinctiveness and be registered on the Principal Register. Three factors are used to determine if a sign has achieved secondary meaning derived, in particular, from *American Diabetes Association v. National Diabetes Association*.<sup>237</sup>

- The length and manner of the term's use.<sup>238</sup>
- The nature and extent of advertising and promotion.
- Other efforts at creating a conscious connection in the public's mind between the designation and the service.

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<sup>234</sup> See Hunter, *supra* note 165, at 151-152.

<sup>235</sup> *Id.* and see 1212.03 *Evidence of Distinctiveness under §2(f)*, Trademark Manual of Examining Procedure (TMPEP), <http://tmep.uspto.gov/> [20.08.2015]; See *In re General Electric Broadcasting Company, Inc.*, 199 USPQ 560 (TTAB 1978), para. 3 and *cf. Ride the Ducks LLC v Duck Boat Tours* (2005 US Dist LEXIS 4422 (ED Pa), 2005 US Dist LEXIS 8162 (ED Pa, April 22 2005), 2005 US App LEXIS 13554 (3d Cir, July 6 2005), para. 8-9.

<sup>236</sup> *Id.*

<sup>237</sup> See *Ride the Ducks LLC v Duck Boat Tours* (2005 US Dist LEXIS 4422 (ED Pa), 2005 US Dist LEXIS 8162 (ED Pa, April 22 2005), 2005 US App LEXIS 13554 (3d Cir, July 6 2005), para. 7; *Cf. American Diabetes Association v. National Diabetes Association*, 533 F. Supp. 16 (E.D. Pa. 1981).

<sup>238</sup> The notion of use is fundamental to US trade mark law and registering a trade mark under the federal and states systems. Use is required, however, what amounts to use is slightly varied. With regard to the federal system, i.e. a registration with the USPTO, the notion of use refers to use in *interstate commerce*. For most applicants it is not a huge hurdle to registration. The only substantial requirement is that the products a trade mark designates are used or transported in commerce. Thus, the notion of use “means the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve to reserve a right in a [trade]mark” as stipulated in 15 USC §1127. See Hunter, *supra* note 165, at 158. In cases in which a trade mark is only used in on state, i.e. intrastate commerce, a trade mark applicant might seek registration in that particular state. See Bouchoux, *The Laws of Trademarks, Copyrights, Patents, and Trade Secrets*, at 26. The notion of use is fundamental to Swiss trade mark legislation as well See Thouvenin, *supra* note 92, at 172.



Over the past years, those factors have also been applied to sound signs seeking registration on the Principal Register, such as in *In re Powermat Inc., Nextel Communications, Inc. v Motorola, Inc.* and *Ride the Ducks LLC v Duck Boat Tours*.<sup>239</sup> Both of those cases share that they failed to provide the Patent Office Trademark Trial and Appeal Board (TTAB) with sufficient *evidence* that the relevant sound sign had acquired secondary meaning. As such, they provide little insights on the concept of distinctiveness.<sup>240</sup> More importantly, it must be acknowledged that even if a sound sign meets the requirements, i.e. *acquired second meaning*, if the USPTO considers it to be *functional*, its registration on the Principal Register will not be allowed.<sup>241</sup> In the US, the concept of functionality serves as a limit to acquiring distinctiveness, similar to the concept of *Freihaltungsbedürfnis* in Switzerland.<sup>242</sup>

Functionality, as described in the Lanham Act, cannot be remedied by acquiring distinctiveness.<sup>243</sup> In *Qualitex Co. v. Jacobson Products Co.* the Supreme Court held that a product feature that is functional cannot serve as a trademark.<sup>244</sup> Functionality exists if the feature intended to be registered as a trade mark is essential to the use or purpose of the product or if it affects the cost or quality of the product.<sup>245</sup> In that regard, it is important to note that

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<sup>239</sup> *In re General Electric Broadcasting Company, Inc.*, 199 USPQ 560 (TTAB 1978), *In re Powermat Inc.* 105 UPSQ2d 1789 (TTAB 2013); *Nextel Communications, Inc. v Motorola, Inc.* (TTAB 2008) and *Ride the Ducks LLC v Duck Boat Tours* (2005 US Dist LEXIS 4422 (ED Pa), 2005 US Dist LEXIS 8162 (ED Pa, April 22 2005), 2005 US App LEXIS 13554 (3d Cir, July 6 2005).

<sup>240</sup> *Cf. infra* at 57.

<sup>241</sup> *See In re Vertex Grp. LLC*, 89 USPQ2d 1694, 1700 (TTAB 2009), para. 12.

<sup>242</sup> *See supra* at 42; For more on the doctrine of functionality *see also* J. B. Pegram & T. E. Spath, *Doctrine of Functionality*, at 225-274 (1992).

<sup>243</sup> 15 USC § 1052(f). Put it simple, “*functionality trumps distinctiveness*”. *See Hunter, supra* note 165, at 156.

<sup>244</sup> *Qualitex Co. v. Jacobson Products Co.*, 34 USPQ2d 1 161 (S. Ct. 1995), at 1163-64, quoting *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844, 214 USPQ 1, 4 n. 10 (1982). For more on *Qualitex Co. v. Jacobson Products Co.* *see* Lange et al., *Intellectual Property Cases and Materials, American Casebook Series*, at 72-80 (2007) Functionality is a doctrine in US trade mark legislation that stipulates that trade mark protection is not available for the useful or functional features of a product. Put it simple the *functionality doctrine* states that a trade mark owner cannot forestall competition by gaining a monopoly over a functional feature of a product. *See Hunter, supra* note 165, at 156.

<sup>245</sup> *Id.*

functionality does not equal non-distinctiveness.<sup>246</sup> A sign may be found distinctive but may not be registered due to functionality.

In *In re NV Organon*, the TTAB held that the reason why functionality shall not be protected lies in the purpose of the Lanham Act.<sup>247</sup> Trade mark law is not intended to reward an undertaking for innovation in creating a particular product. This is the purpose of patent law.<sup>248</sup> Trade mark law should not protect trade dress in a functional design simply because of the investments made to encourage the public to associate a functional feature of the product with the owner of the trade dress.<sup>249</sup> In other words, the concept of functionality delimits the scope of the Lanham Act against other areas of intellectual property legislation and thereby helps to maintain a border between trademark law and patent law.<sup>250</sup>

While word or visual trade marks are less likely to be considered functional, non-traditional trade marks, such as colour, smell, flavour or sound marks are more likely. Their close relationship with the product they designate puts those trade marks at risk of being functional. Establishing functionality requires an assessment of the factual basis in two steps:<sup>251</sup>

- An assessment of the Morton-Norwich factors to establish *evidence of utilitarian functionality*.<sup>252</sup>
- An assessment of the competitive need for a sign to establish *de iure* functionality.

*Morton-Norwich Factors*: The Morton-Norwich factors answer the question of whether or not a sign shows evidence of utilitarian functionality. These factors have their legal basis in *In re Morton-Norwich Prods Inc.*<sup>253</sup> Those factors are used to assess a trade mark by answering the following four questions:<sup>254</sup>

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<sup>246</sup> *In re Morton-Norwich Prods Inc.*, 671 F2d 866 (CCPA 1982).

<sup>247</sup> *In re NV Organon*, 79 USPQ2d 1639 (TTAB 2006), para. 7.

<sup>248</sup> *Id.*

<sup>249</sup> *Id.*

<sup>250</sup> *Qualitex Co. v. Jacobson Products Co., Inc.*, 34 USPQ2d, at 1163-64.

<sup>251</sup> *In re NV Organon*, 79 USPQ2d 1639 (TTAB 2006). Some refer here to the *primary functionality test* and the *secondary functionality test*. See Hunter, *supra* note 165, at 157-158.

<sup>252</sup> For more on *Morton-Norwich Factors* see also Pegram & Spath, *supra* note 242, at 235-238 (1992).

<sup>253</sup> In *In re Morton-Norwich Prods Inc.* the applicant, Morton-Norwich Prods Inc., appealed a Dec. of the USPTO which denied the registration of a shape as a trade mark for spray containers. In its Dec. the TTAB reversed the Dec. of the USPTO and provided a catalogue of factors to assess functionality. See P.

1. Does a utility patent exist that discloses the utilitarian advantages of the design?
2. Do the advertising materials for the design tout the design's utilitarian advantages?
3. Are functionally equivalent designs available to competitors?
4. Are there facts indicating that the design results in a comparatively simple or cheap method of manufacturing the product?

It is important to note that not all four factors have to be established to find a sign to be functional.<sup>255</sup> Utilitarian functionality exists even if some assessed factors are found as neutral.<sup>256</sup>

*Competitive need for a sign:* The competitive need for a sign is an additional factor that should be assessed.<sup>257</sup> Factors for assessment include: the registration's potential for substantial competitive disadvantages as well as the competitors' availability of substitutions if competitive disadvantages are present. These questions are directed at establishing *de iure* functionality.<sup>258</sup> It cannot be determined simply by the contribution of a registered sign to the commercial success of an undertaking.<sup>259</sup> It requires assessing whether the registration of a particular sign would hinder competition in the market place.<sup>260</sup>

During the past few years, sound marks have been subject to functionality assessments in the US. This has been the case when applicants have sought registration for a sound sign in the Principal Register. Among the most interesting cases in which the functionality of sound signs were assessed are: *In re Vertex Grp. LLC* and *Kawasaki Motors Corp. U.S.A. v H-D Michigan Inc.* The latter concerned Harley-Davidson's (HD) attempts to obtain trade mark protection for

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Goldstein & R. A. Reese, Copyright, Patent, Trademark and Related States Doctrines, Cases and Materials on the Law of Intellectual Property, at 1137-1141 (2012).

<sup>254</sup> *In re NV Organon*, 79 USPQ2d 1639 (TTAB 2006), para. 7-9; *In re Morton-Norwich Prods Inc.*, 671 F2d 866 (CCPA 1982).

<sup>255</sup> *In re NV Organon*, 79 USPQ2d 1639 (TTAB 2006), para. 7.

<sup>256</sup> *TrafFix Devices Inc. v. Marketing Displays Inc.*, 58 USPQ2d at 1006).

<sup>257</sup> *In re NV Organon*, 79 USPQ2d 1639 (TTAB 2006), para. 9.

<sup>258</sup> *Brunswick Corp. v. British Seagull Ltd.*, 32 USPQ2d 1120 (Fed. Cir. 1994) at 1121; 1122-23; *See also In re Ferris Corp.*, 59 USPQ2d 1587 (TTAB 2000).

<sup>259</sup> *Id.*

<sup>260</sup> *Id.*

the engine sound of its motorcycles. The case gained considerable media attention in the US as well as Europe.

*In re Vertex Grp. LLC*: In 2009, Vertex Group LLC submitted a sound sign for registration on the Principal Register.<sup>261</sup> The examiner rejected registration of the sound sign. Eventually, the applicant appealed the examiner's decision. The TTAB rejected the appeal on the ground that the sound sign was functional.<sup>262</sup> The sound sign consisted of a descending frequency sound pulse from 2.3 kHz to approximately 1.5 kHz following an exponential RC charging curve.<sup>263</sup> The sound sign was supposed to be used as a personal security alarm. This would take the form of a child's bracelet application used to deter and prevent child abductions.<sup>264</sup> With regard to the capability to perform the function of a trademark, the TTAB concluded that the sign was a sound emitted in the normal course of operation of the bracelet and, thus, qualified the sound as non-distinctive. Registration on the Principal Register would only be possible if the sign acquired second meaning and, thus, distinctiveness.<sup>265</sup> In that regard, the TTAB referred to *In re General Electric Broadcasting Company, Inc.* quoting that registration is required to be [...] supported by evidence to show that purchasers, prospective purchasers and listeners do recognise and associate the sound with services offered and/or rendered exclusively with a single, albeit anonymous, source.<sup>266</sup> The TTAB held that even if Vertex Group LLC would have submitted the sign for registration based on acquired second meaning, registration would have been refused on the ground of functionality.

After assessing the *Morton-Norwich Factors*, the TTAB concluded that the sign was functional and therefore not registrable as a trade mark.<sup>267</sup> The TTAB deemed the first factor, the existence of a utility patent, neutral. However, because the applicant advertised the sound as being an implicitly critical feature of the device, a utilitarian advantage, the second factor was confirmed.<sup>268</sup> Regarding the third factor, the TTAB argued that given the description of the sound sign, the applicant would be free to combine sound pulses for a large range (i.e. 1000 Hz

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<sup>261</sup> *In re Vertex Grp. LLC*, 89 USPQ2d 1694, 1700 (TTAB 2009).

<sup>262</sup> *Id.*, para. 9 and 10.

<sup>263</sup> *Id.*, para. 1.

<sup>264</sup> *Id.*

<sup>265</sup> *Id.*, para. 9.

<sup>266</sup> *In re General Electric Broadcasting Company, Inc.*, 199 USPQ 560 (TTAB 1978), para. 3.

<sup>267</sup> *In re Vertex Grp. LLC*, 89 USPQ2d 1694, 1700 (TTAB 2009), para. 12.

<sup>268</sup> *Id.*

to 2000 Hz).<sup>269</sup> Protecting this range would deprive competitors of many sound signs within this optimal range, despite the fact that there are, in principle, innumerable combinations of frequencies available for personal alarms.<sup>270</sup> Consequently, the TTAB also established functionality with regard to the third Morton-Norwich factor. Regarding the fourth and final factor, the TTAB concluded that the sound sign would not provide any relative cost advantages to the applicant, thus, qualifying this factor as neutral.<sup>271</sup> Eventually, the TTAB decided that the sound sign qualified as utilitarian functional, denying it registrability on the Principal Register.<sup>272</sup>

*Kawasaki Motors Corp. U.S.A. v H-D Michigan Inc.*: In 1994, this case drew much attention in the United States and abroad; it concerned Harley-Davidson's (HD) application for a sound mark to be registered in the Principal Register.<sup>273</sup> The company applied for registering the engine sound of its motorcycles.<sup>274</sup> HD held that the sound mark was used locally and in interstate commerce at least since the 1930s.<sup>275</sup> The company sought registration for class twelve of the Niece Classification, for motorcycles in particular.<sup>276</sup> The sound sign was described as the exhaust sound of HD's motorcycles produced by V-Twin, common crankpin motorcycle engines.<sup>277</sup> As its reason for registering this sound, HD argued that competitors have attempted to copy their unique sound and, thus, decided to seek protection for it.<sup>278</sup> Eventually, nine of HD's competitors, including, among others, Kawasaki and Honda from Japan, filed oppositions

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<sup>269</sup> *In re Vertex Grp. LLC*, 89 USPQ2d 1694, 1700 (TTAB 2009), para. 12.

<sup>270</sup> *Id.*

<sup>271</sup> *Id.*

<sup>272</sup> For more on *In re Vertex Grp. LLC* see D. R. Bumpus, *Bing, Bang, Boom: An Analysis of in RE VERTEX Group LLC and the Struggle for Inherent Distinctiveness in Sound Marks Made During a Products Normal Course of Operation*, 21 FEDCBJ 245 (2011).

<sup>273</sup> *Kawasaki Motors Corp. U.S.A. v H-D Michigan Inc.*, 43 USPQ2d 1521 (TTAB 1997) and see *Honda Giken Kogyo Kabushiki Kaisha v H-D Michigan Inc.*, 43 USPQ2d 1526 (TTAB 1997).

<sup>274</sup> *Application by Harley-Davidson, Inc. to have the sound of their motorcycles trademarked*, The 'Lectric Law Library, <http://www.lectlaw.com/files/inp14.htm> [18.08.2015].

<sup>275</sup> *Id.*

<sup>276</sup> *Id.*

<sup>277</sup> *Kawasaki Motors Corp. U.S.A. v H-D Michigan Inc.*, 43 USPQ2d 1521 (TTAB 1997) and see *Honda Giken Kogyo Kabushiki Kaisha v H-D Michigan Inc.*, 43 USPQ2d 1526 (TTAB 1997).

<sup>278</sup> *Application by Harley-Davidson, Inc. to have the sound of their motorcycles trademarked*, The 'Lectric Law Library, <http://www.lectlaw.com/files/inp14.htm> [18.08.2015].

against the registration of HD's sound mark.<sup>279</sup> For almost six years, HD faced opposition to its trade mark applications by competitors.<sup>280</sup> In 2000, HD finally dropped its sound mark application.<sup>281</sup> Among the reasons stated by HD for dropping the application were the substantial legal costs that the fight against the competitors entailed and that the sound of its engine might sooner or later become generic.<sup>282</sup>

The application was abandoned before the USPTO could take a decision on registrability.<sup>283</sup> However, the TTAB noted already in 1997, that if the case would proceed to trial it would have to assess if the submitted sound sign would be descriptive of motorcycle engines and if the trade mark would be considered functional. In light of *In re Vertex Grp. LLC*, the TTAB would have had to assess HD's sound sign based on the evidence provided by HD as well as the arguments of the applicant and the USPTO examiner.<sup>284</sup> It would have therefore needed to assess the sound sign's capability to *perform the function of a trademark* and determine if the *sign showed utilitarian functionality*. HD's evidence might have shown that the relevant public would perceive the sign as an indicator of origin. It might also have shown that, in the words of the TTAB in *In re General Electric Broadcasting Company, Inc.*, [...] *purchasers, prospective purchasers and listeners do recognise and associate the sound with services offered and/or rendered exclusively with a single, albeit anonymous, source*, and, thus, that it had acquired second meaning.<sup>285</sup>

However, it seems likely that HD's sound sign would have been qualified by the TTAB as possessing utilitarian functionality. While not all Morton-Norwich Factors would have been met, HD seems to fulfil at least two of them. This would have been sufficient to qualify the sound sign as functional. First, HD advertised its motorcycles by touting their design as well as their unique sound, an element considered very important by HD (second Morton-Norwich Factor). In addition, HD explained that its motive behind its trade mark application was that competitors were copying the unique sound of its motorcycles. Given the vague description of the sound

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<sup>279</sup> M. B. Sapherstein, *The Trademark Registrability of the Harley-Davidson Roar: A Multimedia Analysis*, B.C. Intell. Prop. & Tech, at 3 (1998).

<sup>280</sup> J. O'Dell, *Harley Davidson Quits Trying to Hog Sound*, The Los Angeles Times, 21 June 2002. <http://articles.latimes.com/2000/jun/21/business/fi%AD431451/2> [18.08.2015].

<sup>281</sup> *Id.*

<sup>282</sup> *Id.*; *See infra* at 48.

<sup>283</sup> *Kawasaki Motors Corp. U.S.A. v H-D Michigan Inc.*, 43 USPQ2d 1521 (TTAB 1997), para. 5

<sup>284</sup> *In re Vertex Grp. LLC*, 89 USPQ2d 1694, 1700 (TTAB 2009), para. 1.

<sup>285</sup> *In re General Electric Broadcasting Company, Inc.*, 199 USPQ 560 (TTAB 1978), para. 3.

sign, HD would have been in a position to claim protection for a large range of sounds derived of the common range of motorcycle sounds of V-twin engines. This would likely have deprived competitors of using similar sounds from the same range of motorcycle sounds (third Morton-Norwich Factor). Finally, with regard to the competitive need for the sign, it seems likely that the sound sign performs a utilitarian function that cannot be monopolised without hindering competition in the relevant market. This has been indicated already with regard to the third Morton-Norwich Factor. Thus, it seems likely that the USPTO would have denied registration of HD's sound mark on the Principal Register.<sup>286</sup>

While the concept of acquired distinctiveness is principally the same in the US as it is in the EU and Switzerland, US settled case law indicates that sound marks may in practice face an additional barrier in the US: functionality. Interestingly, the Morton-Norwich Factor emerged of a case in which trade mark registration was sought for a shape but, as US case law indicates, apply today for sound signs as well. An applicant submitting a sound sign for registration on the Principal Register should ensure that his sound sign would not qualify as functional through an assessment of the Morton-Norwich Factors and an assessment of the competitive need for that particular sound sign.

### 3. Article 7 (1) (d) CTM Regulation: Customary Signs<sup>287</sup>

Article 7(d) (customary signs) refers to signs that have become customary.<sup>288</sup> It overlaps with Article 7(1)(c) (descriptive signs) which prevents the registration of descriptive marks.<sup>289</sup> The CJEU held, in *Merz & Krell GmbH & Co.*, that signs falling under Article 3(1)(d) are not excluded from registration as trade marks on the basis that they are descriptive.<sup>290</sup> This exclusion is based on their *current usage in trade*.<sup>291</sup> Thus the CJEU held in its ruling that Article 3(1)(d) of the TM Directive must be interpreted as:<sup>292</sup>

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<sup>286</sup> See also Sapherstein, *supra* note 279, at 5-6.

<sup>287</sup> Ianeva, *supra* note 24, at 53.

<sup>288</sup> OHIM Examination Guidelines, *supra* note 184, at 66.

<sup>289</sup> Keeling, *supra* note 67, para. 8-010.

<sup>290</sup> *Case 517/99, Merz & Krell GmbH & Co.*, in particular Rec. 35 of the judgement.

<sup>291</sup> *Id.*; For more on customary signs see also Philips, *supra* note 15, at 74-86 (2003).

<sup>292</sup> *Id.*

[...] only precluding registration of a trade mark where the signs or indications of which the mark is exclusively composed have become customary in the *current language* or in the *bona fide* and *established practices of the trade* to designate the goods or services in respect of which registration of that mark is sought. (emphasis added)

Customary signs might once have been capable of distinguishing the goods or services of one undertaking from those of another.<sup>293</sup> However, in the normal language or trade they have become signs identifying those goods and services.<sup>294</sup> In other words, they have become generic and can no longer perform a distinguishing function and are thus excluded from registration.<sup>295</sup>

So far, the OHIM has not declined registration of sound marks on the basis of Article 7(1)(d). Customary signs also cover figurative elements, such as frequently used pictograms or similar indications. Figurative elements that have become standard designations for products are, for example, a knife and fork for restaurant services, or a white P for parking lots. In that context, it is likely that sound signs might be affected as well by Article 7(d). According to the pictogram examples, the classic telephone ring tone is likely to have become a customary sign by now. The circumstances under which sound signs related to new communication devices, such as smart phones, might become customary signs are more difficult to establish. In general, the opinions vary on the issue of customary sound signs.<sup>296</sup>

a) *Switzerland*

Swiss trade mark legislation does not differentiate between non-distinctive, descriptive or customary signs as the CTM Regulation and the TM Directive do. Those concepts are all covered by the notion that signs that are in the public domain in Article 2(a) of the TmPA. However, for some signs in the public domain, Switzerland applies the concept of *Freizeichen*, which is similar to the notion of customary sign in the EU.<sup>297</sup> Such *signs* were once capable of distinguishing; however, over time they became customary and acquired a descriptive character.

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<sup>293</sup> L. Bently & B. Sherman, *Intellectual Property Law*, at 590 (2008).

<sup>294</sup> *Id.*

<sup>295</sup> *Id.*

<sup>296</sup> Bahner, *supra* note 21, at 48 -67.

<sup>297</sup> *Id.*, *supra* note 21, at 85.



Swiss legislation differentiates between registered and not registered customary signs.<sup>298</sup> With registered signs, the transition to customary signs is only completed if the relevant public no longer perceives the sign as a trade mark.<sup>299</sup> With regard to unregistered signs, it is sufficient that a particular group of people use the sign in a descriptive manner.<sup>300</sup> A sound sign considered customary would therefore either lose or not be able to obtain trade mark protection in Switzerland.

*b) United States*

Similar to Swiss trade mark legislation, US legislation does not explicitly stipulate the notion of customary signs in its trade mark legislation. With regard to refusals based on a lack of distinctiveness, however, the US applies the notion of *generic terms* or *generic marks* which is conceptually similar to *customary signs* in the EU or *Freizeichen* in Switzerland.<sup>301</sup> According to the USTP, *[g]eneric terms are terms that the relevant purchasing public understands primarily as the common or class name for the goods or services.[...] These terms are incapable of functioning as registrable trademarks denoting source, and are not registrable or on the Principal Register under [...] the Supplemental Register.*<sup>302</sup> In other words, a generic mark cannot be registered because it would preclude competitors from being able to describe the nature of their products.<sup>303</sup> Some trade marks may be generic from the beginning and others might become generic through use.<sup>304</sup> In that regard, a sound sign considered generic in the US would be unable to obtain trade mark protection. It is important to note that this extends to the Principal as well as the Supplemental Register.

#### 4. Article 7 (1) (c) CTM Regulation: Descriptive Signs

Article 7(1)(c) (descriptive signs) prevents the registration of signs which are descriptive. It prevents the registration of signs which competing undertakings may want to use, for describing

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<sup>298</sup> Bahner, *supra* note 21, at 85.

<sup>299</sup> *Id.*

<sup>300</sup> *Id.*

<sup>301</sup> See Hunter, *supra* note 165, at 149-150.

<sup>302</sup> 1209.01(c) *Generic Terms*, Trademark Manual of Examining Procedure (TMEP), <http://tmep.uspto.gov/> [20.08.2015];

<sup>303</sup> See Hunter, *supra* note 165, at 149-150.

<sup>304</sup> *Id.*

their products, for example.<sup>305</sup> A sign is descriptive if it has a meaning which is perceived by the relevant public as providing information about the products applied for. This is the case when it provides information, among other things, on the quantity, quality, characteristics, purpose, kind or the size of the products.<sup>306</sup> Article 7(1)(c) overlaps with Article 7(d) which refers to signs that have become customary.<sup>307</sup> However, in case a sign is composed of different elements, descriptiveness can be remedied with disclaimers.<sup>308</sup> A disclaimer cannot be used to (negatively) exclaim subject matters of the class to which the trade mark refers to and which it characterises.<sup>309</sup> It can only be used to positively exclaim a subject matters of the class to which the trade mark refers to.<sup>310</sup>

However, assessing descriptiveness with regard to sound signs might be difficult, especially for sound signs which are devoid of textual elements. Can a melody or a particular noise be descriptive in the meaning of Article 7(1) (c) of the CTM Regulation? Under which circumstance would they be qualified as descriptive? The CJEU provides some guidance for assessing distinctiveness for trade marks based on words.<sup>311</sup> In *Procter & Gamble Company v Office for Harmonisation in the Internal Market* it established three conditions which have to be met to qualify a trade mark as descriptive.<sup>312</sup> Those conditions can be summarised as follows:

- There is nothing about the way in which the sign is presented, nor does it possess any additional features to cause it to be anything other than solely descriptive.
- The sign alludes to an essential quality of the goods, and not a secondary quality or one that is not specific to them.
- That allusion is clear to potential consumers of the goods.

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<sup>305</sup> Keeling, *supra* note 67, para. 8-010.

<sup>306</sup> OHIM Examination Guidelines, *supra* note 184, at 36

<sup>307</sup> *Id.*, at 49.

<sup>308</sup> *Id.*

<sup>309</sup> *Id.*

<sup>310</sup> *Id.*

<sup>311</sup> For more on assessing descriptiveness *see also* Philips, *supra* note 15, at 98-109 (2003).

<sup>312</sup> Judgment of 20 September 2001 in *Cases C-383/99 P, Procter & Gamble Company v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (BABY-DRY)*, [2001], in particular Rec. 39 of the judgment.

Moreover, in *Windsurfing Chiemsee*, the CJEU held that it is necessary to consider the application of Article 7(1)(c) on a case by case basis.<sup>313</sup> Therefore, it rejected the German doctrine of *Freihaltungsbedürfnis*, which claims that there should be a differentiation on the importance of keeping certain signs free, i.e. not registrable as trade marks.<sup>314</sup> Rejecting the doctrine of *Freihaltungsbedürfnis* means that descriptive signs may be allowed registration as trade marks as long as the resulting trade marks are not associated with the descriptive meaning the sign incorporates. While settled CJEU case law and the OHIM Guidelines provides guidance for trade marks based on word elements, colours, slogans, pictograms, patterns, they offer little guidance for sound marks.<sup>315</sup>

So far, the OHIM has declined registration of a sound sign only in one decision, in 2014.<sup>316</sup> While it is clear OHIM declined on the basis of Article 7(1)(c), unfortunately, it did not publish the full reasoning of the decision. It can only be speculated that the sound mark submitted by Daimler AG was perceived by OHIM to sound similar to the sound of an engine revving up and, was therefore descriptive with regard to class twelve of the Niece Classification for which registration was sought for, i.e. vehicles (motors and engines for land vehicles).

In 2011, the OHIM referred to descriptiveness in another decision, in which a sound sign was denied registration under Article 7(1)(b). An applicant sought registration for the sound resulting when two Bordeaux wine glasses clink.<sup>317</sup> The OHIM held that the clinking sound of two glasses would semantically indicate the characteristic of the good for which the sound sign was supposed to function as a trade mark. Registration was sought for class twenty-one of the Niece Classification, household or kitchen utensils and containers. The OHIM held that the sound sign would likely describe the noise that results when two glasses, the products for which it was supposed to serve as trade mark, would clink.<sup>318</sup> The OHIM added that the relevant public would, thus, be unlikely to perceive in the sound sign an indicator of origin.<sup>319</sup> Despite this finding, the OHIM finally declined registration on the basis of non-distinctiveness.<sup>320</sup>

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<sup>313</sup> *Joined Cases 108/97 and 109/97 Windsurfing Chiemsee*, in particular *Rec. 37* of the judgement.

<sup>314</sup> *Id.*, in particular *Rec. 37* of the judgement; Bently & Sherman, *supra* 293, at 591.

<sup>315</sup> See, e.g. Novak, *supra* note 21; See OHIM Examination Guidelines, *supra* note 184, at 36-56.

<sup>316</sup> CTM 012074241, as of October 22, 2015.

<sup>317</sup> HABM Zurückweisung der Anmeldung einer Gemeinschaftsmarke gemäss Artikeln 7 der Verordnung und Regel 11(3) der Durchführungsverordnung in *Anmeldenummer No. 009980632, GRUND & MOBIL VERWALTUNGS AG*.

<sup>318</sup> *Id.*

<sup>319</sup> *Id.*

*HEXAL* provides another interesting decision with regard to descriptiveness.<sup>321</sup> *HEXAL* Aktiengesellschaft sought trade mark registration for a sound mark consisting of the spoken words *Arzneimittel Ihres Vertrauens - HEXAL* (translated as: “medicine you can trust: *HEXAL*”). The Fourth Board of Appeal granted registration in 2005. While the appeal case centred on the graphical representation of the sound sign, the Board of Appeal referred in a notice at the end of the case to a special issue which limited the scope of protection offered to the registered sound mark. It held that:<sup>322</sup>

The slogan ‘Arzneimittel Ihres Vertrauens: Hexal’ shall, on the basis of this registration, only be protected as a sequence of sounds as represented by the sonogram. The scope of the protection for such a mark does not extend to the written statement: ‘Arzneimittel Ihres Vertrauens: Hexal’. Applying to register a spoken statement, a slogan, as a sound mark cannot remedy or circumvent a word mark’s ineligibility for registration.

A part of the text of the sound mark, i.e. *Arzneimittel*, is descriptive with regard to the product and, thus, not eligible for protection under Article 7(c). Given the lack of other comparable OHIM decisions, it is not clear if *HEXAL* will remain an exceptional decision. It is unclear if a similar trade mark application would benefit by the same treatment. However, it might indicate that under certain circumstances a sound mark could be only partially protected, i.e. the sonogram but not the spoken statement.

With regard to descriptiveness, an applicant for a sound sign has to consider if the sign semantically gives rise to an association with the product it is supposed to designate. An example for an obvious semantic association could be the use of a famous Christmas melody or parts of it, such as *Jingle Bells*, as a trade mark for Christmas decoration. Descriptiveness can be, in particular, an issue with sound signs based on noises of natural origin as they are well-known to the public.<sup>323</sup> A simple example would be the characteristic noise of a pig for meat products. In all those cases, it seems likely that the OHIM would deny registration on the basis of descriptiveness.

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<sup>320</sup> HABM Zurückweisung der Anmeldung einer Gemeinschaftsmarke gemäss Artikeln 7 der Verordnung und Regel 11(3) der Durchführungsverordnung in *Anmeldenummer No. 009980632, GRUND & MOBIL VERWALTUNGS AG*.

<sup>321</sup> *Case R 295/2005-4, HEXAL*.

<sup>322</sup> *Id.*, at 17 of the judgment.

<sup>323</sup> Kortbein, *supra* note 2121, at 195.

a) *Switzerland*

Article 2(a) of the TmPA stipulates the absolute grounds for refusal in Swiss trade mark legislation by referring to signs that are in the public domain. This incorporates the notion of non-distinctiveness to which the IGE referred to when denying registration to a sound mark in *Melodie mit sieben Tönen*. Still, the same article also incorporates the notion of descriptiveness. In *Melodie mit sieben Tönen* the Federal Supreme Court elaborated on the notion of descriptiveness with regard to sound marks.<sup>324</sup>

According to the BGER, the descriptive character of a sound sign is decisive in determining whether it belongs to the public domain.<sup>325</sup> A descriptive sign also, however, is not capable of functioning as an indicator of origin.<sup>326</sup> Such signs are, for example, terms for products or terms referring to product characteristics. However, such signs are considered descriptive only if the relevant public understands them as *obviously descriptive* and *not merely an allusion*.<sup>327</sup> According to the BGER, the relevant public has to understand the descriptive meaning *directly, effortlessly* and *without using fantasy*.<sup>328</sup>

According to the Federal Supreme Court, a descriptive sound sign belonging to the public domain can be a well-known melody if the vocals can be considered descriptive in relation to the particular product it is supposed to designate.<sup>329</sup> But a melody without vocals can also be considered descriptive if it gives rise to a particular association of ideas that can be considered descriptive with regard to the product it designates.<sup>330</sup>

Moreover, the Federal Supreme Court held that a famous melody is unlikely to be considered distinctive if the relevant public perceives it as a descriptive add-on rather than an indicator of origin. A famous Christmas song as a trade mark for Christmas decoration would be denied trade mark registration as it would be considered by the relevant public a descriptive add-on rather an indication of origin.<sup>331</sup> Eventually, it would be assumed to belong to the public domain. Here, the

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<sup>324</sup> BGE 135 III 359 E. 3.2, *Melodie mit sieben Tönen*, in particular Rec. 2.5 of the judgement.

<sup>325</sup> *Id.*

<sup>326</sup> *Id.*

<sup>327</sup> BGE 135 III 359 E. 3.2, *Melodie mit sieben Tönen*, in particular Rec. 2.5.5 of the judgement.

<sup>328</sup> *Id.*

<sup>329</sup> *Id.*

<sup>330</sup> *Id.*

<sup>331</sup> *Id.*

Federal Supreme Court drew analogy to word marks.<sup>332</sup> It argued that, similar to a descriptive word mark called *Christmas*, the average consumer would associate the sound sign with Christmas.<sup>333</sup> The sound sign would display a direct relationship with the product but not with the origin of the product itself, i.e. the company.<sup>334</sup>

The Federal Supreme Court concluded that the capability to distinguish is likely to be denied when famous melodies are used as sound signs. They generally perform other functions than indicating the origin of a good or a service.<sup>335</sup> Famous melodies are often used for advertising; the relevant public considers them as means to attract attention or as incentives to purchase.<sup>336</sup>

With regard to the sound sign in *Melodie mit sieben Tönen*, the Federal Supreme Court concluded that it could not be considered descriptive for two reasons. First, the melody did not show a direct relationship with the good for which it was supposed to act as an indicator of origin.<sup>337</sup> In other words, the melody would not give rise to a particular association of ideas among the relevant public that could be considered descriptive with regard to the good it designates. Second, the melody has a simple structure and short duration and, thus, does not resemble a mere background sound for advertisement.<sup>338</sup> In other words, the melody could not be considered merely a means to attract attention or purchasing incentives by the relevant public. While the melody in the case at hand was not considered descriptive, the Federal Supreme Court emphasised that in order to be capable of distinguishing between the product of the undertaking involved and those of other undertakings, the sound sign has to be used in a way that the relevant public perceives the sound sign as an indication of origin.<sup>339</sup>

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<sup>332</sup> BGE 135 III 359 E. 3.2, *Melodie mit sieben Tönen*, in particular Rec. 2.5.5 of the judgement.

<sup>333</sup> *Id.*

<sup>334</sup> Bahner, *supra* note 21, at 151.

<sup>335</sup> *Id.*

<sup>336</sup> Bahner, *supra* note 21, at 151.

<sup>337</sup> BGE 135 III 359 E. 3.2, *Melodie mit sieben Tönen*, in particular Rec. 2.5.6 of the judgement.

<sup>338</sup> *Id.*

<sup>339</sup> *Id.*

*b) United States*

Descriptiveness is a less problematic issue in the US than in the EU or Switzerland due to the existence of the Principal and Supplemental Register.<sup>340</sup> It is a ground for refusal particularly with regard to the registration of a trade mark on the Principal Register.<sup>341</sup> A descriptive sign is considered non-distinctive and, thus, not eligible for registration in the Principal Register, except if the applicant provides evidence that the sign is perceived by the relevant public as a trade mark, i.e. has acquired distinctiveness.<sup>342</sup> However, the US system provides for an alternative registration option. A descriptive sign can be registered on the Supplemental Register. This grants a sign time to acquire secondary meaning and, thus, to gain distinctiveness. Usually after a period of five years, the trade mark owner applies for moving his sound mark from the Supplemental Register to the Principal Register. The owner then supplies his application with evidence indicating that his trade mark has acquired secondary meaning. Unlike the EU or Switzerland, the Supplemental Register allows trade marks considered descriptive to benefit from limited legal protection. However, there are limits to the acquisition of second meaning, i.e. if a trade mark is considered functional.<sup>343</sup>

With regard to the Harley Davidson case, it is unlikely that OHIM, based on its registration practice would have granted trade mark protection.<sup>344</sup> The sound sign would most likely have been considered descriptive and would have been refused registration on the basis of descriptiveness.<sup>345</sup>

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<sup>340</sup> As already mentioned, *see supra* at 41, US trade mark legislation provides for a prima face presumption of acquired distinctiveness after a period of five years of continues use in trade. However, secondary meaning is commonly through market surveys providing evidence on consumer perception and recognition of the trade mark combined with details of sales volumes of the products designated by the trade mark and expenditures on advertisement and marketing. *See Hunter, supra* note 165, at 151-152.

<sup>341</sup> 15 USC § 1052 (e) (1)

<sup>342</sup> *See supra* at 39.

<sup>343</sup> *Id.*

<sup>344</sup> *Id.*

<sup>345</sup> *See also Sandri & Rizzo, supra* note 24, at 145 (2003).

## 5. Article 7 (1) (b) CTM Regulation: Non-Distinctive Signs

Article 7(1)(b) (non-distinctive signs) has the broadest scope and is most closely related to the two first criteria determining the capability of a sign to perform the function of a trade mark.<sup>346</sup> According to settled case law, the distinctiveness of a mark within the meaning of Article 7(1)(b) CTMR means that a sign identifies a product for which registration is applied for as originating from a particular undertaking. The sign would therefore distinguish that product from those of other undertakings.<sup>347</sup>

The OHIM provides some guidance on how to assess distinctiveness.<sup>348</sup> It should first be assessed in reference to the goods or services that the sign supposedly designates and second in reference to the relevant public's perception of that sign.<sup>349</sup> As for CTMs, it is important to take into account that in order to be distinctive as a Community trade mark, the sign must be distinctive with regard to the EU as a whole.<sup>350</sup> The OHIM's Guidelines help to assess various types of trade marks, traditional and non-traditional; however, they lack guidance for assessing the distinctiveness of sound marks.<sup>351</sup>

Many signs that obtain trade mark protection are inherently distinctive because they carry no meaning at all.<sup>352</sup> Invented words exemplify such trademarks because of their naturally distinctive character. However, assessing distinctiveness is difficult, as it is impossible to clearly articulate when a trade mark has a strong distinctive character and when not.<sup>353</sup> In some cases, the assessment of the level of distinctiveness rests on the public's recognition of a sign as a trade mark. This is the case, for example, when providing evidence that a particular sign has acquired distinctiveness through use.<sup>354</sup> However, generally, the assessment is based on a sign's *inherent capability* to serve as an indicator of origin and, thus, on its quality as a sign prior to being introduced to the market and to consumers.<sup>355</sup>

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<sup>346</sup> Keeling, *supra* note 67, para. 8-010.

<sup>347</sup> See *supra* at 18.; OHIM Examination Guidelines, *supra* note 184, at 14.

<sup>348</sup> For more on assessing distinctiveness see also Philips, *supra* note 15, at 86-98 (2003).

<sup>349</sup> OHIM Examination Guidelines, *supra* note 184, at 14.

<sup>350</sup> See *supra* at 34; OHIM Examination Guidelines, *supra* note 184, at 14.

<sup>351</sup> See J. Novak, *supra* note 22; See OHIM Examination Guidelines, *supra* note 184, at 15-35.

<sup>352</sup> Ianeva, *supra* note 24, at 46.

<sup>353</sup> Case 342/97, *Lloyd Schuhfabrik Meyer*, in particular Rec. 24 of the judgment.

<sup>354</sup> Ianeva, *supra* note 24, at 69; See *supra* 39.

<sup>355</sup> *Id.*



Legal scholars have come to different conclusions when assessing the distinctiveness of particular sound signs.<sup>356</sup> While some simply highlighted the complexity of the issue, others tackled the problem by establishing and assessing a phenomenology of sound marks.<sup>357</sup> Concerning the latter, as already mentioned, the lexicon of audio branding or marketing has no legal purpose or value.<sup>358</sup>

This study takes a divergent approach and focuses on OHIM decisions with regard to Article 7(1)(b). However, it is important to note that those decisions should not be treated as settled case law or OHIM guidance. They provide guidance for applicants insofar as they shed light on how OHIM decided on certain cases. Investigating those cases in which OHIM declined registration of a sound sign on the basis of Article 7(1)(b), refers, in the words of the CJEU, to sound signs which did not enable the relevant public to [...] *repeat the experience of purchase, if it proves to be positive, or to avoid it, if it proves to be negative, on the occasion of a subsequent acquisition of the goods or services concerned.*<sup>359</sup> Compared to the other absolute grounds for refusals, non-distinctiveness provides the foundation for most OHIM decisions.<sup>360</sup> Interestingly, in one of those cases, OHIM elaborated on how a sound sign should be assessed with regard to its distinctive character, referring to the CJEU decision in *Quick*.<sup>361</sup> A sign should first be assessed *by reference to the goods or services*, and second, *by reference to the perception of the section of the public targeted.*<sup>362</sup> However, an investigation of OHIM decisions reveals an additional dimension through which they assess a sound sign: *by the nature of the sound sign per se*. The following three sections illustrate the OHIM's decisions with regard to those three assessment dimensions:<sup>363</sup>

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<sup>356</sup> See *supra* note 23.

<sup>357</sup> See, e.g. Suter-Sieber, *supra* note 23.

<sup>358</sup> See *supra* at 13.

<sup>359</sup> Judgment of 27 February 2002 in *Case T-79/00, Rewe Zentral AG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (LITE)*, [2002] ECR II-00705, in particular Rec. 26 of the judgment.

<sup>360</sup> As of November 20, 2015.

<sup>361</sup> OHIM refusal of application for a community trade mark under Art. 7 CTMR and Rule 11(3) of the Implementing Reg. in *Application No. 011377074, CVS Pharmacy, Inc.*, at 2; Judgment of 27 November 2003, *Case T- 348/02, Quick restaurants SA / OHIM, (Quick)*, ECR II-5071.

<sup>362</sup> *Case T- 348/02, Quick*, in particular Rec. 29 of the judgement.

<sup>363</sup> The decisions can be accessed on the OHIM Website, <https://oami.europa.eu> [18.08.2015].

*Assessment of the sound sign per se:* In 2006, Tellme Networks, Inc. sought registration for a musical jingle in the key of C composed of two notes in the sequence of F, C and any relative equivalent thereof.<sup>364</sup> The OHIM held first that a musical jingle is [...] *a short slogan, verse or tune designed to be easily remembered, especially as used in advertising.*<sup>365</sup> It opined that a tune based on two notes will have little impact, if any, on consumers. The OHIM concluded that if heard by a consumer, it would most likely be [...] *understood as a very banal sound, much like the “ding dong” of any doorbell or any public address system.* It further asserted that no trade mark character could be assigned to the submitted sound sign. In 2011, the OHIM dealt with a sound sign consisting of a sound resulting when two Bordeaux wine glasses clink.<sup>366</sup> The OHIM held that the sound is common as it happens when other similar wine glasses or ceramic glasses clink. It also held that because the sound consists only of one tonal sound, a similar sound could likely originate from another source. The OHIM concluded that such a sound sign is commonplace and that it is unlikely that the average consumer would perceive such a sound sign as a trade mark. Later, in 2013, the OHIM processed the registration of a sound sign consisting of three musical notes.<sup>367</sup> It held that the three musical notes applied for trade mark protection were so basic and played so rapidly that it would make little or no impact upon the consumer when heard.<sup>368</sup> The relevant public would simply associate it with machine-generated sound alerts which are commonly emitted by computers and other electronic devices.<sup>369</sup> Moreover, it deemed it unlikely that the relevant public would focus on the sound with sufficient attention to memorise it. Consequently, the relevant public would be unable to remember the sound sign as a trade mark capable of distinguishing immediately the applicant’s goods and services from those of other origin. In the same year, the OHIM dealt with a sound sign

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<sup>364</sup> OHIM Refusal of application for a Community trade mark und Art. 7 of the Reg. and Rule 11(3) of the Implementing Reg. in *Application No. 004010336, Tellme Networks, Inc.*

<sup>365</sup> *Id.*

<sup>366</sup> HABM Zurückweisung der Anmeldung einer Gemeinschaftsmarke gemäss Artikeln 7 der Verordnung und Regel 11(3) der Durchführungsverordnung in *Anmeldenummer No. 009980632, GRUND & MOBIL VERWALTUNGS AG.*

<sup>367</sup> OHIM Refusal of application for a Community trade mark und Art. 7 CTMR and Rule 11(3) of the Implementing Reg. in *Application No. 011377074, CVS Pharmacy, Inc.*

<sup>368</sup> *Id.* at 2.

<sup>369</sup> Examples for famous sound icons are Windows start up and shut-down sounds; *See also supra* at 10.

consisting of a ping tone submitted for registration.<sup>370</sup> It concluded that in the case of a *supereinfachen* (sic!) (super-simple) ping tone it seems *undenkbar* (sic!) (unconceivable or impossible) that such a sound sign would be capable of performing the task of an indication of origin for the relevant public.<sup>371</sup> In 2014, the OHIM handled the registration of multiple sound signs submitted by one applicant. OHIM denied registrability in all cases. One of the sound signs consisted of three discreet multi-layered synthesised sounds.<sup>372</sup> OHIM held that the sound sign allowed for two different perceptions. It could be perceived as a basic machine-generated synthesised sound emitted by some sort of electronic apparatus or it could be perceived as a sound made by a motor engine.<sup>373</sup> This would make it impossible for the relevant public to distinguish the sound sign as well as to confidently link the sound sign to the specific undertaking applying for registration. Moreover, the OHIM considered the sound sign to be too brief and lacking elements of distinctive character that would allow the sound sign to be easily recalled by the average consumer. In addition, it found the sound sign to be neither unusual nor remarkable. Finally, OHIM concluded that the sound sign would not be capable of performing the essential function of a trade mark, to distinguish goods or services of one undertaking from those of another. In the same year, the OHIM specified that a tune is by nature hardly suitable to transmit distinctive information to the average consumer.<sup>374</sup> According to the OHIM, a tune sequence may only under extraordinary circumstances acquire distinctiveness.<sup>375</sup> This is only the case if a tune sequence is perceived as extraordinary and remarkable by the relevant public.<sup>376</sup>

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<sup>370</sup> HABM Vollständige Zurückweisung der Anmeldung einer Gemeinschaftsmarke gemäss Artikeln 7 und 37 der Gemeinschaftsmarkenverordnung Nr. 207/2009 (GMV) und Regel 11(3) der Durchführungsverordnung Nr. 2868/1995 (DV) in *Anmeldenummer No. 11747045, Krinner Innovation GmbH*.

<sup>371</sup> *Id.*, at 4.

<sup>372</sup> OHIM Refusal of application for a Community trade mark und Art. 7 CTMR and Rule 11(3) of the Implementing Reg. in *Application No. 01192357, Jaguar Land Rover Limited*.

<sup>373</sup> OHIM Refusal of application for a Community trade mark und Art. 7 CTMR and Rule 11(3) of the Implementing Reg. in *Application No. 01192357, Jaguar Land Rover Limited*, at 4.

<sup>374</sup> HABM Zurückweisung der Anmeldung einer Gemeinschaftsmarke gemäß Artikel 7 GMV und Regel 11 Absatz 3 GMDV in *Anmeldenummer No. 012674958, Bayer Aktiengesellschaft*.

<sup>375</sup> *Id.*, at 2.

<sup>376</sup> *Id.*

*Assessment of the sound sign by reference to the relevant goods or services:* In most cases when the OHIM denied registration of a sound sign, the assessment of the sound sign vis-à-vis the relevant goods and services also served the purpose of identifying the relevant public. In some cases the OHIM focused very narrowly on the relevant goods and services, in particular, on the situation in which a sound sign would be expected to perform its function as a trade mark. In one case when a sound sign consisted of three discreet multi-layered synthesised sounds, the applicant emphasised that in the light of the relevant products, luxury cars and expensive services, potential customers would likely exhibit high attention, especially, with regard to trade marks.<sup>377</sup> Under those circumstances, the applicant concluded that a brief or simple sound sign would be able to perform the function of a trade mark. However, the OHIM had a different assessment of the situation. According to the OHIM, those situations in which consumers usually buy cars and related services are neither often nor generally subject to the use of sound marks. Commonly, car marketing and sales rely on imagery of vehicles, striking words, stylised word elements in banners, commercials, advertisement or combination of those elements with sound effects.<sup>378</sup> Eventually, the OHIM decided that it is unlikely that a consumer in such a situation would perceive a sound sign as an indication of origin for a particular luxury good or service. The OHIM applied a similar focus regarding the use of a sound sign in the case of pharmaceutical products.<sup>379</sup> The sound sign in question consisted of a tune, mentioned in the previous section.<sup>380</sup> Tune sequences are extensively used in advertisement for entertainment but without clear content. In light of this, the OHIM deemed that for a tune to be capable of performing the function of a trade mark, a tune has to qualify as extraordinary and remarkable.<sup>381</sup>

*Assessment of the sound sign by reference to the relevant public:* The assessment of a sound sign with regard to the relevant goods and services forms, in many cases, the starting point for assessing the relevant public's interpretation of the sound sign. The perception of the sound sign by the average consumer or the relevant public is partially considered in *the assessment of the sound sign per se*. The assessment of the sound sign in this section puts the average consumer

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<sup>377</sup> OHIM Refusal of application for a Community trade mark und Art. 7 CTMR and Rule 11(3) of the Implementing Reg. in *Application No. 01192357, Jaguar Land Rover Limited*, at 2.

<sup>378</sup> *Id.*, at 3-4.

<sup>379</sup> HABM Zurückweisung der Anmeldung einer Gemeinschaftsmarke gemäß Artikel 7 GMV und Regel 11 Absatz 3 GMDV in *Anmeldenummer No. 012674958, Bayer Aktiengesellschaft*.

<sup>380</sup> *Id.*

<sup>381</sup> *Id.*, at 2.

centre stage. In the case of the three discreet multi-layered synthesised sounds intended to be used as a trade mark for luxury cars and related services, the OHIM elaborated on the role of the relevant public in assessing the registrability of a sound sign.<sup>382</sup> It held that the public is accustomed to perceiving words or figurative signs instantly as trade marks identifying the origin of a product. In the case of sound signs, the public may not be used to instantly perceiving sound signs as trade marks.<sup>383</sup> According to the OHIM, sound signs are not inherently capable of distinguishing the goods of a particular undertaking.<sup>384</sup> In other words, while the CTM Regulation does not draw a distinction between different types of sign, it is, nevertheless, important to take into account the habits of consumers with regard to particular trade marks. The OHIM held that even if the relevant public would consist mainly or only of experts on luxury cars, as the applicant suggested, a *prima facie* indistinct character of the sound sign could not be overcome by assuming a public exhibiting unusually high attention towards the target products (i.e. luxury cars).<sup>385</sup> Regarding the tune for pharmaceutical products, the OHIM established a high threshold for such a sound sign to function as a sound mark, as mentioned in the previous section.<sup>386</sup> Moreover, the OHIM held that such a tune must be assessed in relation to sounds that the relevant public encounters in everyday life. In other words, the use-situation of the trade mark is an additional and essential factor to be assessed.<sup>387</sup> According to the OHIM, a sound sign likely to be memorised incompletely can cause confusion among the relevant public and, thus, lack the capability to distinguish with certainty the products from one undertaking from those of others.<sup>388</sup>

To sum up the OHIM decisions discussed in the previous three sections, it can be concluded that when attempting to register a sound mark, an applicant should make sure that the sound sign is

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<sup>382</sup> OHIM Refusal of application for a Community trade mark und Art. 7 CTMR and Rule 11(3) of the Implementing Reg. in *Application No. 01192357, Jaguar Land Rover Limited*, at 4.

<sup>383</sup> *Id.*

<sup>384</sup> *Id.*

<sup>385</sup> *Id.*; Cf. Judgment of 12 July 2012 in *Case 311/11 P, Smart Technologies ULC v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (Smart Technologies)*, [2012], in particular Rec. 48 of the judgement.

<sup>386</sup> HABM Zurückweisung der Anmeldung einer Gemeinschaftsmarke gemäß Artikel 7 GMV und Regel 11 Absatz 3 GMDV in *Anmeldenummer No. 012674958, Bayer Aktiengesellschaft*.

<sup>387</sup> *Id.*

<sup>388</sup> *Id.*

not considered to be too brief or banal. Moreover, it seems that the OHIM requires a sound sign to be memorisable to a substantial degree by the average consumer. This means an applicant should ensure that his sound sign is not overly complex. Furthermore, he should evaluate if the relevant public would perceive the sound sign clearly as an indication of origin and not either ignore it or confuse it with other sounds in use-situations, i.e. marketing situations.

Finally, it is important to note that the OHIM provides guidance for slogans that will likely be applied to sound marks, particularly jingles – slogans in the form of sound marks.<sup>389</sup> Slogans are considered non-distinctive when the relevant public perceives them as a mere promotional formula.<sup>390</sup> They are deemed to be distinctive only if, apart from their promotional function, the relevant public perceives them as an indication of origin of the products in question.<sup>391</sup> An applicant submitting a jingle for registration is well advised to make sure that the sound sign complies with the criteria outlined by the OHIM in its guidelines for assessing the distinctive character of slogans.<sup>392</sup>

a) *Switzerland*

Swiss trade mark legislation does not differentiate between non-distinctive, descriptive or customary signs as the CTM Regulation and the TM Directive do. Those concepts are all covered by the notion of signs that are in the public domain in Article 2(a) of the TmPA. Switzerland applies the notion of *fehlende konkrete Unterscheidungskraft* which equals is equal to the concept of non-distinctiveness in the EU.<sup>393</sup> Until 2009, sound signs were considered in Switzerland to be distinctive only if they contained textual elements.<sup>394</sup> The Federal Supreme Court concluded in *Melodie mit sieben Tönen* that the melody applied for registration was distinctive and that the IGE wrongly denied its registration.<sup>395</sup> The court further elaborated on the requirements for a sound sign to perform the function of a trade mark particularly, the capability to distinguish and to act as an indicator of origin. Eventually, the court formulated important guidance for assessing a sound sign's distinctiveness in Switzerland. The court

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<sup>389</sup> See *supra* at 9.

<sup>390</sup> OHIM Examination Guidelines, *supra* note 184, at 21.

<sup>391</sup> *Id.*

<sup>392</sup> *Id.*

<sup>393</sup> For more on examination of distinctiveness, see IGE Trade Mark Guidelines, *supra* note 205 at 85.

<sup>394</sup> Bundi, *supra* note 9.

<sup>395</sup> BGE 135 III 359 E. 3.2, *Melodie mit sieben Tönen*, in particular Rec. 2.5.7 of the judgement.

especially clarified how *the sound sign per se* and *the use-situation* affect and determine distinctiveness.

*The sound sign per se*: The court held that for a sound sign to perform the function of an indicator of origin it is not necessary for it to be exactly reproducible by the relevant public.<sup>396</sup> It is sufficient if a sound sign can simply be recognised by the relevant public.<sup>397</sup> The court acknowledged that sound signs might differ in the way the relevant public recognises them.<sup>398</sup> In that regard, it put recognisability and distinctness into a relationship with each other. The Swiss Federal Supreme Court acknowledged the fact that short, catchy and memorable melodies can, with less effort, be recognised by the relevant public.<sup>399</sup> Sound signs that are melodious for the human ear are easier to memorise and, according to the court, possess thereby generally a higher distinctiveness. On the opposite side are signs that are not perceived as melodious for the human ear. They are not as easy to remember and generally possess lower distinctiveness. The Federal Supreme Court concluded that catchiness and memorability are likelier to occur with sounds that have a simple structure and which are similar to entertainment music.<sup>400</sup> A larger part of average consumers would then be able to understand and memorise them.<sup>401</sup>

While the Federal Supreme Court pointed out that the level of distinctiveness may vary depending on the sound sign, it objected to the IGE's requirement that a sound sign without textual elements display an unusual and distinctive character.<sup>402</sup> The court found IGE's approach unacceptable because the applicant would have to go beyond what is usual and expected to make a clearly distinctive sound sign.<sup>403</sup> In an analogy to word marks, it pointed out that sound signs should not be assessed differently with regard to the combination of tunes than word marks with regard to the combination of letters.<sup>404</sup> A sound sign should be assessed on a case by case basis in relation to the product it designates, in order to establish whether it is distinctive or not.<sup>405</sup>

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<sup>396</sup> BGE 135 III 359 E. 3.2, *Melodie mit sieben Tönen*, in particular Rec. 2.5.3 of the judgement.

<sup>397</sup> *Id.*

<sup>398</sup> *Id.*

<sup>399</sup> *Id.*

<sup>400</sup> *Id.*; Bahner, *supra* note 21, at 238.

<sup>401</sup> *Id.*

<sup>402</sup> BGE 135 III 359 E. 3.2, *Melodie mit sieben Tönen*, in particular Rec. 2.5.2 of the judgement.

<sup>403</sup> *Id.*

<sup>404</sup> *Id.*

<sup>405</sup> *Id.*

*The use-situation:* With regard to the use-situation, the Federal Supreme Court held that for a sound sign to perform the function of an indicator of origin, simply referring to the use of a sound sign in advertisement is not sufficient to deny it the capability of functioning as a trade mark.<sup>406</sup> In that context, the court emphasised that sound signs are increasingly used to identify goods and services in relation to computers, computer software or other electronic devices as well as in TV and radio advertisements or on the Internet.<sup>407</sup>

According to the court, the use of a melody in an advertisement qualifies as trade mark use.<sup>408</sup> Even a very short melody could be understood by the relevant public as an indication of origin and thus, be suitable to distinguish the products from one undertaking from those of another undertaking.<sup>409</sup> However, the Federal Supreme Court stressed that to qualify as a trade mark, it is necessary that [...] *the sound sign [...] is used in the usual course of trade, typically, at the beginning or end of an advertisement.*<sup>410</sup> It made an analogy to textual or visual marks. Those trade marks are not perceived by the relevant public as trade marks when published on the bottom or back of a product, nor in the small print describing a product.<sup>411</sup> While a sound sign may, in principle, be capable of distinguishing, to qualify as a trade mark it also has to be perceived by the relevant public as a clear indication of origin with no additional mental effort.<sup>412</sup> This means that a sound sign has to be used in a way that it establishes a dialogue between a manufacturer and a consumer.<sup>413</sup>

The Federal Supreme Court's decision has some notable implications for potential sound mark applicants. An applicant should ensure that his sound sign is capable of establishing a dialogue between the consumer and the trade mark owner. It might be preferable to rely on a sound sign that is easily memorised by the relevant public. However, there is no requirement that the public must be able to memorise the sound sign, simple recognition suffices. Finally, an applicant is

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<sup>406</sup> BGE 135 III 359 E. 3.2, *Melodie mit sieben Tönen*, in particular Rec. 2.5.2 of the judgement.

<sup>407</sup> *Id.*

<sup>408</sup> *Id.*

<sup>409</sup> *Id.*

<sup>410</sup> *Id.*

<sup>411</sup> *Id.*

<sup>412</sup> *Id.*, in particular Rec. 2.5.1 and 2.56 of the judgement.

<sup>413</sup> The BGER referred here to Art. 11 of the TmPA which stipulates that a trade mark is protected if it is used in relation to the goods or services for which it is claimed.; *Cf. supra* at 25.



well advised to assess if the sound sign would be perceived by the relevant public as a clear indication of origin without additional mental effort.

Finally, an applicant whose sound mark is dubious in terms of distinctiveness might benefit from a more lenient examination by the IGE thanks to the Federal Supreme Court's decision in *Melodie mit sieben Tönen*. The court reminded the IGE that a trade mark can be contested ultimately in a civil proceeding.<sup>414</sup> As a consequence, it held that, in case of doubts, the IGE should register a sound mark and leave the ultimate decision to the courts, rather than declining trade mark protection.<sup>415</sup> Simply put, the Federal Supreme Court encourages a registration approach towards sound marks that can be summarised as *in dubio pro rogatore*.

*b) United States*

Contrary to the CTM Regulation, the Lanham Act does not explicitly refer to distinctiveness. Nevertheless, a sign must be distinctive in order to be registered on the Principal Register.<sup>416</sup> This has been held by the TTAB also with regard to sound signs in *In re General Electric Broadcasting Company, Inc.*<sup>417</sup> In that regard, the USPTO distinguishes two categories of sound signs: sound signs that are *unique, different or distinctive* and sound signs that resemble *or imitate commonplace sounds*.<sup>418</sup> Examples of commonplace sounds include the sounds made by acoustic alarms.<sup>419</sup> While the first category can be directly registered on the Principal Register, the second category needs to acquire a secondary meaning.<sup>420</sup> In the latter case, a registration must be supplemented by evidence.<sup>421</sup>

*In re General Electric Broadcasting Company, Inc.*, is one of the most interesting cases in which a sound sign was assessed for distinctiveness. In fact, it is considered a landmark case for sound marks in the US.<sup>422</sup> The TTAB had to decide if the examining attorney of the USPTO had correctly denied the registration of a ship's bell clock as a trade mark on the Principal Register

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<sup>414</sup> BGE 135 III 359 E. 3.2, *Melodie mit sieben Tönen*, in particular Rec. 2.5.3 of the judgement.

<sup>415</sup> *Id.*

<sup>416</sup> See Hunter, *supra* note 165, at 148-149.

<sup>417</sup> See *In re General Electric Broadcasting Company, Inc.*, 199 USPQ 560 (TTAB 1978), para. 3

<sup>418</sup> *Id.*

<sup>419</sup> See *In re Powermat Inc.* 105 UPSQ2d 1789 (TTAB 2013).

<sup>420</sup> *Id.*; See *supra* at 39.

<sup>421</sup> *Id.*

<sup>422</sup> See *supra* at 32.

on the basis of non-distinctiveness. While the TTAB confirmed the decision, it also elaborated on the requirements for a sound sign to perform the function of a trade mark.<sup>423</sup> Unlike the Federal Supreme Court in Switzerland, the TTAB did not explicitly discuss the use of a sound sign to establish a dialogue between a manufacturer and a consumer. However, the TTAB held that sound signs should be treated with caution when judging their capabilities to act as indicators of origin.<sup>424</sup> Moreover, it stated that the criteria for registration of sound marks must be somewhat different from those applied to the average trade mark.<sup>425</sup> Whether or not the sound sign can function as an indicator of origin concerns the *conditions under which a sound mark is used and the lasting impression that a sound sign should have upon consumers*.<sup>426</sup> According to the TTAB, a sound sign may, under certain conditions, work as an indication of origin.<sup>427</sup>

[...], at least as far as services are concerned where the traditional concept of affixation of a trademark has not been ingrained or, in fact, is not practical or possible, likewise function as source indicators in those *situations where they assume a definitive shape or arrangement* and are used in such a manner so as to create in the hearer's mind an association of the sound with a service. (emphasis added)

The phrase, *in situations where they assume a definitive shape or arrangement*, stipulates that a sound sign should be perceived by consumers as a defined entity. The subsequent phrase, *used in such a manner so as to create in the hearer's mind an association of the sound with a service*, refers to establishing a dialogue between the manufacturer and the consumer. Both are essential criteria for a sign to be capable to function as a trade mark.<sup>428</sup> The TTAB did not specify the conditions when the use of a sound sign could allow the association between the sound and the service in a hearer's ear. It did, however, refer to Trademark Manual of Examining Procedure (TEMP) which stipulates that an applicant has to demonstrate that a trade mark is or will be used in commerce either in the sale or in the advertising of services.<sup>429</sup>

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<sup>423</sup> See *In re General Electric Broadcasting Company, Inc.*, 199 USPQ 560 (TTAB 1978), para. 3.

<sup>424</sup> *Id.*, para. 2.

<sup>425</sup> *In re General Electric Broadcasting Company, Inc.*, 199 USPQ 560 (TTAB 1978), para. 3.

<sup>426</sup> *Id.*

<sup>427</sup> *Id.*

<sup>428</sup> *Cf. supra* at 25.

<sup>429</sup> See § 1301.4(a) and (b) of the TMEP.

The TTAB moreover held that not only visual trade marks may differ in creating [...] a lasting impression upon a purchaser or prospective purchaser encountering those marks in the marketplace.<sup>430</sup> This differentiation also applies to sound marks.<sup>431</sup> Some sound signs can be so inherently different or distinctive that consumers easily remember them. They can be recognised and associated with the product with which they were associated when heard.<sup>432</sup> Other sound signs can be less distinctive or be even devoid of any distinctiveness.<sup>433</sup> Because of this, the TTAB introduced an important conceptual distinction for sound signs which is still valid today: *unique, different, or distinctive* sound signs and *commonplace* sounds or sounds to which listeners have been exposed under different circumstances. The first are directly registrable on the Principal Register.<sup>434</sup> Signs from the second group require supportive evidence to be registered.<sup>435</sup> This was also the case with the sound of a ship's bell in *In re General Electric Broadcasting Company, Inc.* The TTAB held that refusing registration did not mean that such a sound sign would be incapable of functioning as an indicator of origin in the environment of radio broadcasting.<sup>436</sup> However, the evidence provided by the applicant indicating that the sound sign was performing the function of a trade mark was deemed insufficient.<sup>437</sup> In other words, the applicant failed to show that the sound sign had acquired *second meaning* which would allow registration on the Principal Register, a concept that was discussed earlier with regard to *acquiring distinctiveness*.<sup>438</sup>

In summary, *In re General Electric Broadcasting Company, Inc.* established that sound signs in the US can be registered on the Principal Register. It acknowledged that while some sound signs may be distinctive, others might not be. However, even for the latter, registration is possible if they manage to acquire secondary meaning, i.e. acquire distinctiveness. This means an applicant with a non-distinctive sound sign should opt for registration on the Supplemental Register, while expecting the sign to acquire distinctiveness over time. Later, the applicant could submit the sign, backed with sufficient evidence, for registration on the Principal Register.

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<sup>430</sup> *In re General Electric Broadcasting Company, Inc.*, 199 USPQ 560 (TTAB 1978), para. 3.

<sup>431</sup> *Id.*

<sup>432</sup> *Id.*

<sup>433</sup> *Id.*

<sup>434</sup> *Id.*

<sup>435</sup> *Id.*

<sup>436</sup> *Id.*

<sup>437</sup> *Id.*

<sup>438</sup> *See supra* at 39.

Despite this opportunity, US settled case law indicates that direct registration on the Principal Register may also require an assessment of distinctiveness.<sup>439</sup> In that regard, the US system seems to fundamentally differ from the EU or Swiss trade mark system.

## 6. Other Absolute Grounds for Refusal

There are even more absolute grounds for refusal stipulated in Article 7(1). Those grounds cannot be remedied by acquitting distinctiveness based on Article 7(3) of the CTM Regulation. As such, those grounds are addressed only briefly in this study.<sup>440</sup> Article 7(1)(e) is not relevant for sound signs as it concerns shapes and is thus directed at three dimensional marks. Article 7(1)(f) might occasionally apply in case a sound sign is considered to offend generally accepted moral principles.<sup>441</sup> This might be the case when sound marks consist of a combination of sound and text, for example racist songs or where sounds consist of war noises or noises made by persons in agony. In addition, nauseous noises, such as farts or burps or noises with a sexual connotation could be considered to offend moral principles. However, it is important to notice that offences against moral principle arise not of the sound itself but from the relationship between the sound sign and the product it designates.<sup>442</sup> Article 7(1)(g) might occasionally be applied in case a sound sign is considered to be deceptive. This could be the case with a sound sign consisting of a spoken text with an Italian accent for pasta which is *de facto* produced in Germany.<sup>443</sup> Such a sound sign could be considered by the OHIM to be deceptive with regard to the geographical origin of the product. Article 7(1)(h) refers to Article 6ter of the Paris Convention. Article 6ter of the Paris Convention protects the flags and emblems of states that are members of the Paris Convention, as well as the names and emblems of international intergovernmental organisations against unauthorised registration and use as trade marks. As it refers almost entirely to visual signs, it is unclear how Article 7(1)(h) would apply to sound

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<sup>439</sup> See for example: *In re Vertex Grp. LLC*, 89 USPQ2d 1694, 1700 (TTAB 2009); *Kawasaki Motors Corp. U.S.A. v H-D Michigan Inc.*, 43 USPQ2d 1521 (TTAB 1997); *Ride the Ducks LLC v Duck Boat Tours* (2005 US Dist LEXIS 4422 (ED Pa), 2005 US Dist LEXIS 8162 (ED Pa, April 22 2005), 2005 US App LEXIS 13554 (3d Cir, July 6 2005), para. 7.

<sup>440</sup> For more on signs which are not registrable on policy grounds *see also* Philips, *supra* note 15, at 67-73 (2003).

<sup>441</sup> Kortbein, *supra* note 21, at 211; Foerstl, *supra* note 21, at 103; Suter-Sieber, *supra* note 21, at 108.

<sup>442</sup> Suter-Sieber, *supra* note 21, at 108.

<sup>443</sup> *Id.*, at 102.

marks. It might require an OHIM or CJEU decision to expand the application of Article 7(1)(h) to anthems within the EU, for example. However, such cases might also fall under Article 7(1)(f) and be treated materially as contrary to public policy.<sup>444</sup> The Articles 7(1)(i) to (k) can be considered irrelevant for sound marks.

Switzerland refers to those other grounds for refusal in Article 2 of the TmPA. According to Article 2(c), misleading signs and (d) signs contrary to public policy, morality or applicable law are excluded from trade mark protection. US trade mark legislation refers essentially to the same instances in the Lanham Act. However, in comparison, it provides a much more detailed list of examples.<sup>445</sup> Given that Switzerland and the US are both members of the Paris Convention, it can be expected that similar cases to those stipulated in Article 7(1)(e) to (f) of the CTM Regulation would most likely be treated in their jurisdiction in a similar manner as in the EU.

## II. Relative Grounds for Refusal

In addition to absolute grounds for refusal, the CTM Regulation also lists relative grounds for refusal. Those grounds are related to the exclusive right that the CTM confers to its owner.<sup>446</sup> In the past, examiners of the national trade mark registries checked if a trade mark was already on the register to see if a new sign should be refused registration as trade mark.<sup>447</sup> This practice has changed in EU member states as OHIM itself only undertakes examinations of new CTMs on absolute grounds.<sup>448</sup> Under those circumstances, it is a trade mark owner's responsibility to oppose, based on its earlier right, an application for registration of a confusing similar trade mark.<sup>449</sup>

Addressing the subject of relative grounds for refusal would go beyond this study's scope.<sup>450</sup> So far, none of the sound mark applications for CTM have been opposed on relative grounds for refusal.<sup>451</sup> One reason might be that contrary to visual or word marks, the universe of sound marks is still characterised by a high availability of strong sound signs. In addition, audio

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<sup>444</sup> Suter-Sieber, *supra* note 21, at 108.

<sup>445</sup> See 15 U.S.C § 1052(a).

<sup>446</sup> C. Seville, *supra* note 350, at 253-269 (2009).

<sup>447</sup> Waelde *et al.*, *supra* note 69, at 561.

<sup>448</sup> *Id.*

<sup>449</sup> *Id.*

<sup>450</sup> For more on relative grounds for refusal see Philips, *supra* note 15, at 307-359 (2003).

<sup>451</sup> As of October 28, 2015.

branding is a complex and expensive endeavour. Under those circumstances, achieving a high level of distinctiveness in relation to existing sound marks is likely to be an important driver for an undertaking endeavouring to use a sound mark.<sup>452</sup>

### **III. Conclusions**

The second research question guiding this study was: *How do the necessary capabilities of a sign to perform the function of trademark apply to sound signs and how are they reflected in OHIM's registration practices? In particular, how does OHIM conceptualise the notions of descriptiveness and non-distinctiveness as important absolute grounds for refusal and do differences exist with regard to other jurisdictions?*

In regard to this question, we can therefore conclude that, based on the examined OHIM decisions, a certain registration practice for sound marks has evolved since it became possible to submit sound files. This is reflected in the decisions that the OHIM provided in those cases it declined registration. Particularly impactful were those decisions related to Article 7(1)(b) on non-distinctiveness, i.e. the majority of the OHIM decisions. Those decisions have become more structured over time, reflecting the development of a certain assessment practice with regard to sound marks that can be illustrated using a funnel of causality.<sup>453</sup> The OHIM's assessment procedure as illustrated below clearly reflects how the essential capabilities for a sign to perform the function of a trade mark also do apply to sound signs.

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<sup>452</sup> For more on audio branding, *see supra* at 8.

<sup>453</sup> A funnel of causality is a concept used to explain decision making among large groups of people. In the case of the OHIM decisions it is not a large group of people but rather a community of experts drawing on similar arguments that are in the focus. *See* A. Campbell, *A problem to be explained: motivational differences by time of vote Dec.*, in A. Campbell et al. (eds.), *The American Voter* (1980).

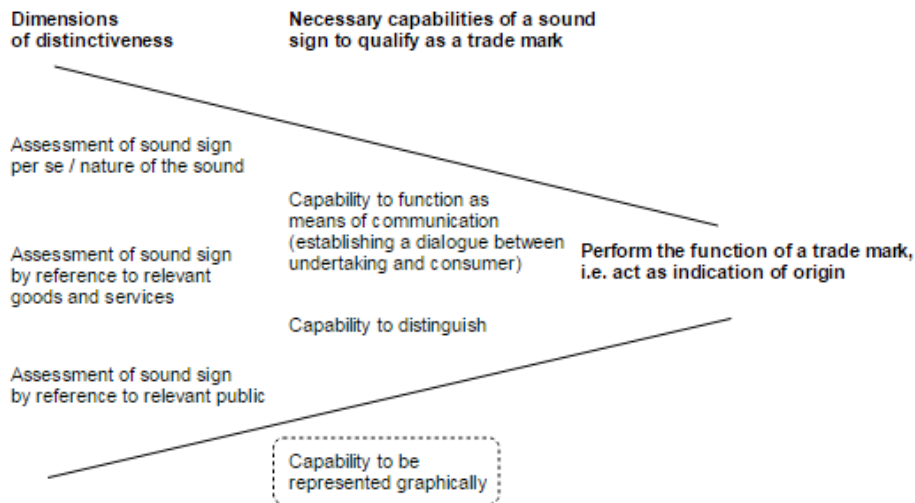


Figure 10 Funnel of causality: Illustrating the OHIM’s assessment practice

The OHIM assesses a sound sign (i) *per se*, (ii) *vis-à-vis relevant goods and services* and (iii) *vis-à-vis the relevant public*. This determines the *capability of a sound sign to communicate* and to *distinguish* and, ultimately, to perform the function of a trade mark which in turn means performing the function of an indication of origin.<sup>454</sup> The capability to be represented graphically is no longer relevant as today sound marks can be registered as CTMs on the basis of sound files.<sup>455</sup>

The OHIM *conceptualises the notions of descriptiveness and non-distinctiveness*, two important absolute grounds for refusal, based on multiple questions. The following table summarises those main questions.<sup>456</sup>

<sup>454</sup> See *supra* at 25.

<sup>455</sup> See *supra* at 31.

<sup>456</sup> An applicant for a sound mark should preferably address them in advance to reduce the risk that his sound sign would be denied registration on the basis of non-distinctiveness.

### **I. Assessment of the sound sign per se**

What is the perception of the sound sign *prima facie*?

- Multiple perceptions?
- Originality (remarkable, unusual)?
- Memorability (recallable)?
- Duration of sign?

### **II. Assessment of the sound sign by reference to the relevant product**

How are the sound signs used in marketing, sales or distribution situation?

- Are those situations characterised by the use of sound signs?
- Do consumers expect a sound sign to be used as a trade mark?
- The use of what kind of signs is characteristic to designate the relevant product?
- Noticeable differences compared to other sound signs in the same situation?
- Would an average consumer perceive the sound sign as an indication of origin in relation to the product?

### **III. Assessment of the sound sign by reference to the relevant public**

How will the perception of the sound sign by the relevant public likely be?

- How does the perception of the sound sign relate to sounds in everyday life?
- Is the relevant public able to perceive the sound sign as an indication of origin?
- Is the sound sign used in the current commercial practice as an indication of origin?

Figure 11 Assessing distinctiveness: The three dimensions based on OHIM practice

Finally, *do differences exist between the OHIM's conceptualisation of descriptiveness as well as non-distinctiveness with regard to other jurisdictions?* The comparison with other jurisdictions shows much similarity concerning the conceptualisation but, nevertheless, also some differences. Compared to Switzerland, the OHIM seems to apply a slightly stricter approach to the concepts of descriptiveness and distinctiveness.

Both apply a similar approach with regard to descriptiveness, in the sense that a sound sign is considered descriptive if it can *semantically rise to a particular association of ideas that can be considered descriptive with regard to the good or service it designates*. However, differences exist with regard to how clear those *association of ideas* have to be to be considered descriptive. The case in which the OHIM denied registration of a sound sign on the ground of descriptiveness might have been treated differently in Switzerland.<sup>457</sup> OHIM likely declined the sound sign on the basis that it resembled the sound of an engine reviving-up. It would, thus, *semantically* have given rise to an association with the class of goods and services for which the sign was supposed

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<sup>457</sup> CTM 012074241.



to be registered, i.e. vehicles. In Switzerland, the same sound sign could probably have obtained registration as, according to the Federal Supreme Court decision in *Melodie mit sieben Tönen*, the relevant public must understand the descriptive meaning of the sound sign *directly, effortlessly and without using fantasy*.<sup>458</sup>

A similar observation applies to the notion of distinctiveness. Again, the OHIM and Switzerland seem to apply a similar conceptual approach. However, based on the examination of OHIM decisions and in light of the decision of the Swiss Federal Supreme Court, one difference seems to exist. In some of the cases, the OHIM decided against registration of sound signs citing, among other reasons, the short duration of the sign. It is possible that in Switzerland the characteristic of those sound signs (here the duration) would have been treated less strictly. According to the Federal Supreme Court decision in *Melodie mit sieben Tönen* it would be enough if a sound sign can *simply be recognised again* by the relevant public.<sup>459</sup> In other words, the benchmark for recognition of a sound signs by the relevant public seems to be lower in Switzerland's when compared to the OHIM's practices. Moreover, Switzerland practices a conceptual approach, with regard to distinctiveness, that can be summarised as *in dubio pro rogatore*.<sup>460</sup>

The US system differs from the OHIM and Swiss system for trademark registration. It provides the Supplemental Register with the basis to register signs that are considered non-distinctive at the point of registration. This offers the owners of such signs limited legal protection of their signs and the possibility to delay until their signs have gained enough distinctiveness to be moved to the Principal Register.

With the *notion of functionality*, the US seems to address an issue that might also arise with sound marks in the EU and Switzerland in the coming years. How to treat a sound sign which could be considered a feature of the product it designates? In the light of technological innovation, it may one day be necessary to exclude certain sound signs from trade mark protection for which monopolisation would go against public interest. An example could be the registration of a particular sound sign for a medical product that both functions as an indication of origin and also carries a particular functional value that should not be denied to other undertakings out of public interest. One might think of a cardiac pacemaker that emanates a sound signal indicating the urgency to apply a defibrillator to the carrier of the pacemaker. One

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<sup>458</sup> BGE 135 III 359 E. 3.2, *Melodie mit sieben Tönen*, in particular Rec. 2.5.3 of the judgement.

<sup>459</sup> *Id.*

<sup>460</sup> *See supra* at 57.

could also think of a sophisticated and distinctive sound sign which elderly people are particularly able to distinguish from ordinary noises in their living environment, such as the sound of various other electronic devices. Such a sound sign might not be considered a customary sign according to Article 7(1)(d) nor would it fall under Article 7(1)(f) and be denied registration on public policy grounds. Two potential approaches could resolve that particular issue, which can be illustrated along a timeline referring to the point of registration.

One approach to resolve the issue could be to introduce a similar clause as Article 7(1)(e) limiting trade mark protection for certain shapes.<sup>461</sup> Akin to the notion of functionality in the US, falling under an article similar to Article 7(1)(e) would not be remedied by acquiring distinctiveness. Such a clause, explicitly limiting trade mark protection for certain sound signs, is likely to contribute to legal certainty for sound marks. An alternative would be to leave the issue open to the CJEU to decide, for example on the basis of anti-competitive behaviour or on the basis of a restriction to the free movement of goods and services.<sup>462</sup> However, it cannot be ruled out that the CJEU would resort to a similar concept of functionality as the US as it would have the advantage to reconcile trade mark legislation with competition law.<sup>463</sup>

Finally, it can be concluded that CTM registration in the EU would substantially benefit from more guidance on how absolute grounds for refusal should be understood with regard to sound signs. This would close a considerable blind spot in the OHIM Examination Guidelines.

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<sup>461</sup> The author is aware that Article 7(1)(e) with regard to shapes is meant to delimiting those subject matters falling under trade mark legislation from those falling under design law. On the overlapping of trade mark and design law *see also* A. S. Nemes & A. Carboni, *Overlapping Rights in Designs, Trademarks and Trade Dress*, in N. Wilkof & S. Basheer (eds.), *Overlapping Intellectual Property Rights*, at 251-275 (2012).

<sup>462</sup> *See* G. Ghidini, *The Bride and the Groom. On the Intersection between Intellectual Property and Antitrust Law*, in G. Caggiano et al. (eds.), *Competition Law and Intellectual Property, A European Perspective* (2012); C. M. Villarejo & T. Kramler, *Intellectual Property Rights and Competition Rules, A Complex but Indispensable Coexistence*, in S. Anderman & A. Ezrachi (eds.), *Intellectual Property and Competition Law* (2011).

<sup>463</sup> *See supra* at 39.

## E. The New TM Directive and Sound Marks

As stated at the beginning, this study briefly touches upon the difference in registration practice between the OHIM and the EU member states. This is done in context of the new Trade Mark Directive (TM Directive 2016) expected to enter into force in the second half of 2016.<sup>464</sup>

So far, the situation in the EU with regard to sound mark registration is rather paradoxical. The CTM protects a broader amount of sound signs than the harmonised trade mark legislation does at EU member state level. This is similar to the situation a couple of years ago in Switzerland concerning three-dimensional trade marks. Applications for trade mark protection submitted on the basis of the Madrid System could obtain protection earlier than those applicants using the national registration process. Until now, sound mark examination in EU member states still relied on the requirements stipulated in *Shield Mark*. For example, a sound mark can only be registered if it can be graphically represented by musical notation.<sup>465</sup> This limits the registration of sound marks to melodies with or without textual content. If an applicant wants to register a noise in the EU he has to apply for a CTM allowing registration of a sound mark on the basis of a sonogram together with a sound file.

This process can be expected to change with the adoption and entering into force of the TM Directive 2016.<sup>466</sup> The definition of signs of which a trade mark may consist of, as stipulated in Article 2 of the TM Directive, is expected to explicitly incorporate the notion of sounds. Moreover, graphical representation is expected to be replaced by the notion of [...] *being represented in a manner which enables the competent authorities and the public to determine the*

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<sup>464</sup> As of November 24, 2015.

<sup>465</sup> See, e.g. Website of the Intellectual Property Office UK, *Manual of Trade Marks Practice*, [https://www.gov.uk/government/uploads/system/uploads/attachment\\_data/file/454221/Manual-of-trade-marks-practice.pdf](https://www.gov.uk/government/uploads/system/uploads/attachment_data/file/454221/Manual-of-trade-marks-practice.pdf) [10.08.2015].

<sup>466</sup> See Proposal for a Directive of the European Parliament and of the council to Approximate the Laws of the Member States Relating to Trade Marks (Recast) (COM(2013) 162 final), (TM Directive 2016), <http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=CELEX:52013PC0162&from=EN> [30.10.2015]. This may be interpreted as a third stage in the construction of Community intellectual property legislation. The entry into force of the Treaty of Lisbon on 1 December 2009 has opened up new perspectives. The Treaty has set up a specific legal basis for the creation of European property rights. In accordance with Article 118, the EU can now provide for a uniform protection of intellectual property rights through the Union. See C. Geiger, *The construction of intellectual property in the European Union: searching for coherence*, in C. Geiger, *Constructing European Intellectual Property, Achievements and New Perspectives*, at 14 (2013).

*precise subject of the protection afforded to its proprietor.*<sup>467</sup> This is likely to broaden the permissible means of representation.<sup>468</sup> The acceptance of a sonogram together with a sound file would extend the notion of sound mark in the meaning of the TM Directive. It would provide the basis to register noises at a member state level. From a technical point of view, replacing graphical representation by sound files would replace an outdated requirement and enhance legal certainty.<sup>469</sup> This is likely to increase the registration of sound marks in the EU.

## F. Conclusions

The amendment to the Implementing Regulation for Community Trade Marks, adopted in 2005, was expected to facilitate the registration for sound marks as CTMs in the EU. This study investigated the protection of sound marks in the form of CTMs.

With regard to the first research question, *how has the notion of sound mark as a legal concept changed from the past to today*, this study concluded that by defining graphical representation for sound signs on the basis of sonograms and MP3 sound files the scope of sound marks, in the meaning of Article 4 of the CTM Regulation, was substantially increased. It made it possible to register melodies as well as noises. Although musical notation has its own deficiencies, such as its inability to capture timbre, this new OHIM registration practice can be considered to have enhanced legal certainty in general, regardless of the particular sound sign at hand. Moreover, in light of the entering into force of the revised TM Directive in 2016, this practice is likely to be soon applied at member state level as well.

The second research question guiding this study was: *How do the necessary capabilities of a sign to perform the function of trademark apply to sound signs and how are they reflected in OHIM's registration practices? In particular, how does OHIM conceptualise the notions of descriptiveness and non-distinctiveness as important absolute grounds for refusal and do differences exist with regard to other jurisdictions?* This study concluded that, based on the

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<sup>467</sup> *The latest on European proposals to modernise trade mark law and procedure*, Taylor Wessing LLP, <http://united-kingdom.taylorwessing.com/fileadmin/files/docs/EU-proposals-to-modernise-TM-law.pdf> [10.08.2015].

<sup>468</sup> Some question whether these new provision will be workable in practice, in particular, with regard to the other non-traditional marks, such as olfactory signs. D. Fields & H. Sheraton, *European Commission Proposes Reform of European Trade Mark System*, 35 EIPR 10, at 564 (2013).

<sup>469</sup> *Id.*

examined OHIM decisions, registration practice and thus, a way to conceptualise particularly the notions of *descriptiveness* and *non-distinctiveness* concerning sound marks has evolved over recent years. This has been especially the case since it became possible to submit sound files in 2005. In comparison with other jurisdictions, in particular Switzerland, it seems that the OHIM applies a slightly stricter conceptual approach with regard to notions of descriptiveness and non-distinctiveness as absolute grounds for refusal. In general, CTM registration in the EU would substantially benefit from more guidance on how absolute grounds for refusal have to be conceptually understood with regard to sound signs. This would address a blind spot in the OHIM Examination Guidelines.

Finally, the US experience in registering sound marks, in particular the case involving Harley Davidson, indicated that sound mark registration in the EU might sooner or later have to address the issue of functional sound signs. In the light of technological innovation, it might one day be necessary to exclude certain sound signs from trade mark protection for which monopolisation would go against the public interest.

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