



Trademark registration of sound marks- Registrability criteria

1.Preamble

According to article 4 of EUTMR an EU trademark may consist of any sign provided that such signs are capable of being represented on the Register of European Union trademarks ('the Register'), in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor. Also, article 3(3)g of EUTMIR defines a sound mark as a trademark consisting exclusively of a sound or a combination of sounds. Combination of sounds with movement of images are not sound marks but multimedia marks as per article 3(3) (i) of EUTMIR.

Like in other types of marks, the sound mark will be accepted depending on whether the sound is distinctive per se, that is the average consumer will perceive the sound as memorable one that serves to indicate that the goods or services are exclusively associated with one undertaking (under Article 7(1)(b) CTMR and 29.4.2004, C-456/01 P & C-457/01 P, 'Tabs', EU:C:2004:258, § 34; 21.10.2004, C-64/02 P, 'Das Prinzip der Bequemlichkeit', EU:C:2004:645, § 33).



Furthermore, it must be recalled that, in its case-law, the EUIPO has held that, although the criteria for assessing distinctive character are the same for the different categories of mark, it may be apparent, in the context of the application of those criteria, that the perception of the relevant public is not necessarily the same for each of those categories and that, therefore, it may prove more difficult to establish the distinctive character of the marks in certain categories than those of other categories (see order of 28 June 2004, Glaverbel v OHIM, 445/02 P, EU: C: 2004: 393-, paragraph 23 and the case-law cited).

In that regard, it should be noted that, while the public is accustomed to perceiving word or figurative marks as signs identifying the commercial origin of goods or services, the same is not necessarily true where the sign consists solely of a sound element.

However, as regards certain goods or services, it may not be unusual for the consumer to identify them by means of a sound element. In certain economic sectors such as television broadcasting, it is not only unusual, but also and even every day, that the consumer will be led to identify a product or service in that sector as a result of a sound element enabling it to be distinguished as originating from a particular undertaking.

2. The resonance criterion/recognition effect and marks of purely functional character

According to Article 4(1)(c) TMD, trademarks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, or the time of production of the goods or of rendering of the service, or other characteristics of the goods or services, shall not be registered, or, if registered, shall be liable to be declared invalid.

In Case T- 408/15 (*Judgment of the General Court (Second Chamber) 13 September 2016*), the mark applied for consisted of a graphical representation of a sound mark as below:



Such mark was denied protection on the basis of Article 7(1) (b) of Regulation No 207/2009, and the reasoning was re-affirmed by the Board of Appeal and the General Court.

The General Court stated that the mark consisted of a simple and banal sonance and that it could not be perceived as an indicator of the commercial origin of the goods. The applicant had argued that its mark was not simple and as a short melody it would be perceived as a reference indicator to its own goods and services. The reason was that it consisted of floor scope on a tempo of 147 black notes per minute with the repetition of two floor arese, that is to say, a heightened



black, followed by a second soil (pointed out) (three time), which was extended to the white round (four times).

However, as the Board of Appeal had stated, in order to be capable of indicating to the consumer the commercial origin of the goods or services in question, the mark applied for must have features which enabled it to be easily remembered and perceived by the consumer (par.18-19, par.23).

Moreover, the General Court reasoned that it was necessary that the sound sign for which registration was sought has a certain resonance ((*Application No: 018318562/ 1/05/2022*, 13/09/2016, T-408/15, SON D'UN JINGLE SONORE PLIM PLIM (sound mark), EU:T:2016:468, § 45)) enabling the targeted consumer to perceive it and consider it to be a trade mark and not as a functional element or as an indicator without any inherent intrinsic characteristic. That consumer must thus regard the sound sign as having the ability to identify, in the sense that it will be identifiable as a trade mark.

As the EUIPO correctly stated at the hearing, should the mark represent only a functional element of the product or service, then it is reduced to a mere 'mirror effect' (it refers only to itself and nothing else) and would not enable the targeted consumer to perceive it in its function of identifying the goods and services at issue.

In Case T-668/19 (Judgement of the General Court of 7 July 2021), the trade mark in respect of which registration was sought was the sound sign which recalls the sound made by a drinks can being opened, followed by a silence of approximately one second and a fizzing sound lasting approximately nine seconds.

The Board of Appeal had argued that the trade mark applied for consisted of a sound inherent to the use of the goods at issue, so that the relevant public would perceive that trade mark as a functional element and an indication of the qualities of the goods at issue and not as an indication of their commercial origin. It concluded that the trade mark applied for was devoid of distinctive character.

According to the applicant, the sound reproduced by the trade mark applied for was unusual for the goods in Classes 29, 30, 32 and 33 which are not carbonated, so that the already existing distinctive character of that trade mark was reinforced. The same was true of the goods in Classes 29, 30, 32 and 33 which are carbonated, since the various sound elements making up the trade mark applied for are different from the sound produced when the fizzy drinks usually on the market are opened, so that the relevant public would perceive them as an indication of the commercial origin of those goods.

The Board of Appeal, stated that, where the sound applied for reproduces a sound which is inherent to the goods or their use, that trade mark must, in order to display the required distinctive character, depart significantly from the norm or customs of the sector, in the same way as a three-dimensional trade mark reproducing the external appearance of the product or of its packaging. (judgment of 7 October 2004, *Mag Instrument v OHIM*, C-136/02 P, EU:C:2004:592, paragraph 31).





According to the General Court that case-law does not establish new criteria for assessing the distinctive character of a trade mark but merely states that, in the context of the application of those criteria, the perception of the relevant public is likely to be influenced by the nature of the sign for which registration is sought. The perception of the average consumer is not necessarily the same in relation to a three-dimensional mark consisting of the appearance of the product itself or of its packaging, as it is in relation to a word, figurative or sound mark consisting of a sign which is independent of the external appearance or shape of the products it designates (see, to that effect, judgment of 12 December 2019, *EUIPO v Wajos*, C-783/18 P, not published, EU:C:2019:1073, paragraph 24 and the case-law cited).

In the case at hand the Court held that, as the trade mark sought reproduces neither the shape of the goods at issue nor that of their packaging, the Board of Appeal was wrong to consider that the case-law referred to was applicable by analogy, and to apply the criterion consisting of determining whether the trade mark sought departed 'significantly' from the norm or customs of the sector.

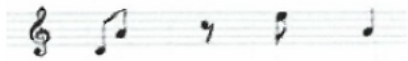
The General Court though agreed with the Board of Appeal's reasoning that a sound must have a certain resonance or a certain recognition value which enables the targeted consumers to regard it 'as an indication of origin and not merely as a functional element or as an indication without any statement'. It re-affirmed that the sound constituting the trade mark applied for had an immediate relationship to the claimed goods and was inherent to the use of those goods. It concluded that the trade mark applied for would be perceived by the relevant public as a functional element of the goods at issue, since the fizzing sound was an indication of the qualities of those goods and not an indication of their commercial origin, so the mark was devoid of any distinctive character.

The sound emitted when a can is opened will be considered, having regard to the type of goods concerned, to be a purely technical and functional element, since the opening of a can or bottle is inherent to a certain technical solution connected to the handling of drinks in order to consume them, irrespective of whether or not those goods contain carbon dioxide. Since an element is perceived by the relevant public as fulfilling above all a technical and functional role, it will not be perceived as an indication of the commercial origin of the goods concerned (see, by analogy, judgment of 18 January 2013, *FunFactory v OHIM (Vibrateur)*, T-137/12, EU:T:2013:26, paragraph 27 and the case-law cited). Second, the relevant public will immediately perceive the sound of fizzing bubbles as referring to drinks. only as a variant of the sounds usually emitted by drinks when their contents are opened, and do not therefore give the sound mark applied for the capacity to identify in such a way that it will be identifiable as a trade mark.





In Case R 2821/2019-1 (*Decision of the First Board of Appeal of 23 July of 2020*) the applied for mark consisted of the following sound sequence.



The examiner denied protection on the basis that the mark was simple, commonplace and did not have any recognition value. The first two sounds were leveraging than the last two sounds and were separated from one another by a break. The first two sounds were therefore barely noticed, but merely the last two sounds. Because of the break or such an interruption in the sound sequence, the overall sound sequence would not be perceived as a jingle or as a memorable identification report.

The OD also noted that because of the high number of different signals detected in electronic devices makes it difficult to attract consumers' particular attention. The focused and echo-effects were not enough to create a perceptible or conceivable musical statement. The sound sequence in question therefore did not differ from other sound sequences or sounds that are usually to be heard on the market through many different electrical and electronic devices nowadays.

The Board of Appeal did not agree with such findings. The sound was analyzed as four points at the heart of the sound: D3, A3, followed by a eight-break, for E6 and A5, the sound of which is changed by perushioning and echo to echo. As the applicant emphasized, this clay sequence has a certain dynamism thanks to the somewhat vague beginning with perceptible and as a result of the subsequent increasing volume and height of clay. Accordingly, it was certainly a musical statement that allows a certain melody and structure. The sound sequence is short and memorable (a so -called 'Jingle').

Contrary to the examiner's assertion, it was not a sound sequence that is customarily used when operating electronic devices, and this has also not been proven by the examiner either. The present jingle had a somewhat more complex sound sequence than the normal operating signals for electronic apparatus that are merely perceived as simple signalling beams (such as the banal 'Plim-Plim' Ton of the judgment cited by the examiner, T-408/15, SON D'UN JINGLE SONORE PLIM, EU:T:2016:468, § 41, or the functional 'ping' -Ton a Christmas tree stand in the final decision of the Board of Appeal of the 31/10/2014, R 2444/2013-1 -4, HÖRMARKE, which had a functional significance). The present sound mark could therefore also trigger a reminder effect.

It was highlighted that even if the sequence of words applied for were to show the functionality of a device, this did not mean that it could not also be perceived as an indication of origin. The very fact that sound sequences often sail when the various electronically operated devices are launched means that consumers, at least in relation to those goods, are accustomed to them and perceive them as an indication of origin provided that they are memorable (e.g. sound sequences used by mobile telephones to identify producers).

The examiner had also failed to prove that the sound sequence applied for was connected with the goods in question. Nor had the examiner explained that the tone was customary in the field



of the goods that were the subject of these proceedings, primarily in the area of information technology, health and medical and sanitary preparations at the time of application.

It was therefore concluded that the trade mark applied for was a jingle with a rhythm of four sounds, which was likely to 'go into the ear' among relevant consumers who were relevant.

The appeal was therefore upheld and the contested decision was annulled to the extent that it refused the trade mark application in respect of the goods that were the subject of the proceedings.

3. A melody/harmony of a recognizable structure

In Case R 2059/2016-4 (*Decision of the 4th Board of Appeal of 12 December 2017*) the mark applied for consisted of an electronically generated sound sequence lasting a little over four seconds. It started with several short, hollow sounds, which changed noise-like into a lighter sound, which is longer and louder.

The examiner of the OD had argued that the sound applied for was a typical electronic sound, such as was frequently used in advertising for a whole variety of different goods, for example motorcycle goggles, ear defenders, clothing or protective supports, to draw attention to their modernity. It was neither a memorable melody nor a sound sequence in the form of a jingle, which had a recognition effect. The sound sequence of the trade mark was very simple, and was characterized primarily by its volume. The consumer would not infer from that sound any indication of the commercial origin of the goods applied for.

On the other hand the applicant claimed that the sound mark was a two-bar fanfare of over four seconds, which began with an eight-note staccato and, following a crescendo, ended with a fortissimo chord. The fact that the parallel notations in the treble and bass clefs differed by a semi-tone would generate an unusual and striking sound, which the consumer would not perceive as a 'standard sound'. When used with those goods, for example in the form of a sound chip, which the trade mark played when the packaging of the goods was opened, the consumer would easily recognize the sound as an indication of commercial origin.

However as the Court stated, those arguments in relation to the frequency, dynamic and harmony, which are evident from the notation, are only relevant if they are obvious when the trade mark applied for is heard. In the case at hand the sound sequence was not a fanfare and contained no melody, no recognizable structure and no memorable harmony (*Application No: 018318562/ 1/05/2022 ,13/09/2016, T-408/15, SON D'UN JINGLE SONORE PLIM PLIM* (sound mark), EU:T:2016:468, § 45). On the contrary, it ended precisely at the point at which it was perceived. The special features as regards dynamic, note values and harmony that were claimed by the applicant became apparent after hearing it repeatedly, and required an analytical approach that the consumer does not normally take.

Finally, the Court noted that the consumer is accustomed to many electronically operated devices, such as smartphones, computers and kitchen appliances, and also other equipment, such as cash and ticket machines, lifts, escalators, safety barriers, door-openers and the like, which produce a whole variety of different electronically generated sounds during their



operation. There are no indications that the consumer perceives such noises and sounds as an indication of commercial origin.

4. The consumer's perception

In Case R 157/2018-2 (*Decision of the 2nd Board of Appeal of 20th September 2018*) the mark applied for consisted of a continuation of sounds issued by a motor (i.e., a vehicle engine), without any characterizing element capable of effectively leaving a lasting impression in the mind of the consumer. The trade mark forming the subject of the application was therefore held as devoid of any distinctive character.

As the Court re-affirmed, the assessment of distinctive character is more complex for such marks than for other 'normal' categories of distinctive signs. Therefore they are subject to more complex checks, which are not limited to the arbitrary character of the sign in relation to the product. In addition, it is necessary to assess how the public will normally perceive, and mostly, a sound in a context such as that of the sale of goods.

The case-law does not exclude the registrability of a 'jingle' as a sound mark (see cases 11/06/2014, R 87/2014-5 -1, KLANG EINER NOTENSEQUENZ (HÖRMARKE); 16/12/2013, R 2056/2013-4 -1, KLANG DER SSP -BANK MUSIK (KLANGMARKE)), however. it is necessary that the sound sign for which registration is sought owns a certain length of use, enabling the consumer to perceive it and consider it as a trade mark, not because they have a functional nature or because they are devoid of intrinsic characteristics (13/09/2016, 408/15-, son of UN J/Jingle sound PLIM), EU: T: 2016: 468, § 45).

In Case R 2721/2019-4 (*Decision of the 4th Board of Appeal of 21st of May 2020*), the claimed sign consisted of a sequence of sounds generated electronically (synthetic) that lasted only between 2 and 3 seconds, although the mp3 sent was 7 seconds. It was a sequence of different shades that merged among themselves within the line. It started with several short shades, which didn't change to a more glossy tone, which is longer and stronger.

The examiner of the OD objected to the application on the basis of Article 7(1)(b) EUTMR, arguing that the sound is too short (*see in contrast applications number 011893054, 017672932, 018008406, 018029296, 018158593, 018470008 which are longer and more complex compositions*) and nothing special to act as a trade mark, and with no remarkable or memorable sound, and with no extra, distinctive, sound which needs it to be recognized as a distinctive sound, including other similar sounds that are formed on the market in which the applicant moves. It was a nice, unmemorable sound, which would be perceived more as a sound decoration.

The duration of the mark was a factor to be taken into account, although not the decisive one, since the trade mark subject to refusal had a duration of less than three seconds. As the appellant furnished a technical report arguing that the mark in question 'has achieved the attention' of the participants, the examiner concluded that the ability of any sound 'to attract the attention' does not lead the conclusion that, by this simple fact, the sound already can function as a trade mark without further requirements.





Accordingly, it was emphasized that the only decisive factor is whether the sequence of sounds applied for is capable of identifying the goods and services specifically applied for as coming from a particular undertaking, and thus to distinguish them from the goods and services of other undertakings.

However, when the above criteria are applied, account should be taken of the fact that the perception of the relevant public is not necessarily the same in relation to each of these different categories of trade marks and, therefore, it may be difficult to establish the distinctive character of the trade marks in certain categories (28/06/2004, C445/02 P, Glass Pattern, EU:C:2004:393, § 23; 13/09/2016, T408/15-, SON OF A JINGLE SONORE PLIM PLIM, EU:T:2016:468, § 41). The assessment of the distinctive character of the application must be based on the alleged perception of the public at which the goods or services claimed are targeted (12/7/2012, C-311/11 P, Wir machen das Besondere einfach, EU:C:2012:460, § 24).

In order to fulfil the function of the trade mark (identification of the origin), it is not necessary for a consumer to memorise the sign in their accuracy and in the most minimal detail. It is, rather, sufficient to trigger a memory effect. The particular characteristics of the dynamics, the values of the shades and harmony, which the appellant claimed, were obvious after repeated escutcheon and required an analytical approach which is not usually adopted by consumers.

5. The duration of the sound and the noiseness effect

In *application number 018689652 (EUIPO 28/03/2023)*, the contested mark consisted of a two-second electronic apparatus sound. Both the applicant and the examiner argued about whether the mark was simple, memorable or not and which are the registrability requirements. The applicant argued that the threshold for distinctiveness is very low (T-34/00) and that only a minimum degree of distinctiveness was required. A trade mark is not subject to a finding of a specific level of linguistic or artistic creativity or imaginativeness on the part of the proprietor. He further referred to other case law admitting marks of a four-second duration.

On the other side of the spectrum, the examiner although agreed that the threshold for distinctiveness is not high, he/she highlighted that in contrast a blank piece of paper or a single musical note or very simple notes might not be distinctive. In the present case the sound at issue was a very short one. It lasted at most 2 seconds and it was therefore too short and banal to qualify as a business identifier. Especially in the context of devices which are switched on and off one might expect a sound as the present one. The sign was found to be a not melodic with no structure, which would help to recognize it after some days or even weeks (normal situation of purchase of goods/services).

As concerns previous case-law that could be of assistance in assessing the distinctive character, the Court has repeatedly confirmed the lack of any distinctive character of word or figurative marks which were excessively simple (29.9.2009, T-139/08, 'Smiley', EU:T:2009:364, § 26; 13.4.2011, T-159/10, 'Parallélogramme', EU:T:2011:176, § 30) and this reasoning may be transposed to sound marks. Sound marks that were found acceptable are for example the roaring



of a lion (CTM No 5 170 113 registered on the basis of being accompanied by a sound file; and a musical tune (R 2056/2013-4).

In antithesis, in **Case R 620/2019-4** (*Decision of the Fourth Board of Appeal of 19 September 2019*) the Court highlighted that the fact that a sound sequence is memorable, is not sufficient to consider the sign to be distinctive. The most important factor for the distinctive character would be that the sign is directly perceived as an indication of the commercial origin of the goods and services, so that the relevant public could distinguish, without any possibility of confusion, the applicant's goods and services from those of a different commercial origin.

The Board of Appeal found that although the mark was short, it consisted of an electronically produced (synthetic) sound sequence of just over 3 seconds. There were dynamic sequences of different shades which merged into one another within a cordless cords. Sounds produced by a marimba or a similar instrument could be identified, as well as basstades. The sound sequence was classified as belonging to the e-music sector. The sound sequence was found to have a resonance since it contained a certain melody and a recognisable structure. It was short and memorable ('Jingle').

As far as memorability is concerned the smallest detail is not necessary instead, it is sufficient for the consumer to be able to remember it.

Sound sequences, for instance in the length of the sound sequence applied for in the case at hand, certainly enable recognition of a wide variety of goods and services, or be perceived in the (radio) advertising as memorable. In such sound sequences, the completely striking sound sequence applied for in the case at hand can easily be classed as a sound sequence. Account must instead be taken of the specific sound sequence.

The question of whether the sound sequence is an 'inspirational or motivational noise', as stated by the examiner in the contested decision, can remain open. However, the Board emphasised that such an 'inspiring or motivating noise' is more likely to substantiate its eligibility for trade mark, as such a 'noisiness' will be consciously perceived and the relevant consumers will also be able to remember the trade mark at a later point.

6. Conclusion

As sounds are increasingly being used in trade as part of a branding strategy, consumers are also more likely to perceive them as indications of commercial origin.

The registration of any type of trade mark depends upon whether they are considered distinctive per se. The general criteria for assessing distinctiveness of traditional types of trade mark must also apply when assessing the required degree of distinctiveness of new types of trade mark.

However, such distinctiveness can be assessed only by reference, firstly, to the goods or services for which registration is sought and, secondly, to the relevant public's perception of that sign. In addition, the way in which the relevant public perceives a trade mark is influenced by its level of attention, which is likely to vary according to the category of goods or services in question.





The above case-law signifies that the consumer will be more likely to see the mark as an indication of commercial origin if no link can be established between the mark and the goods and services. Other criteria are also important like the duration of the sound, the resonance of the mark and the reminder effect, the inherent characteristics of the sound and whether there is a melody, a jingle and a particular structure. These are to be assessed by way of an a priori examination.

Accordingly, not only distinctive character but also suitability to perform the function of indicating origin are necessary (see recital 8 in the preamble to the EUTMR; 29/09/1998, C-39/97, Canon, EU:C:1998:442, § 21, 28).

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