

OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET
(TRADE MARKS AND DESIGNS)

The Boards of Appeal

In Case R 781/1999-4

**DECISION
of the Fourth Board of Appeal
of 25 August 2003**

Head Notes

- (1) Sound marks not involving music in the traditional sense of the word are registrable as Community Trade Marks.
- (2) A sonogram is a valid and practical graphic representation of a sound mark in the sense of Article 4 CTMR.
- (3) The diagram submitted in the Roaring Lion case cannot be considered a valid graphic representation in the sense of Article 4 CTMR due to its lack of scales.

**DECISION
of the Fourth Board of Appeal
of 25 August 2003**

In Case R 781/1999-4

Metro-Goldwyn-Mayer Lion Corporation

2500 Broadway Street
90404-3061 Santa Monica, California
United States of America

Applicant / Appellant

represented by Bureau Gevers, Brussels Airport Business Park, Holidaystraat 5, B-1831
Diegem, Belgium

APPEAL relating to Community trade mark application No 143 891

THE FOURTH BOARD OF APPEAL

composed of C. Hoffrichter-Daunicht (Chairwoman and Rapporteur) F. López de Rego
(Member) and W. Peeters (Member)

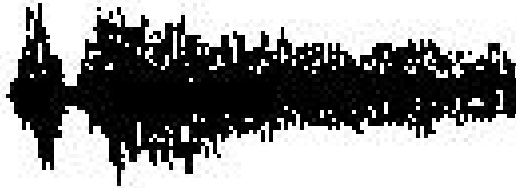
Registrar: E. Gastinel

gives the following

Decision

Summary of the facts and grounds of appeal

- 1 By an application which was accorded a filing date of 1 April 1996, the appellant sought to register the trade mark represented hereunder



for various goods and services in classes 9, 38, 41 and 42 .

In the application form, the trade mark was named as ‘geluidsmerk’ and described as “Het merk bestaat uit de klank voortgebracht door het gebrul van een leeuw en voorgesteld op bijgevoegd spectrogram” (‘The trade mark is constituted by the sound produced by the roar of a lion and is represented by the spectrogram abovementioned’).

- 2 The examiner informed the appellant that the trade mark application (a) did not comply with the formal requirements pursuant to Rule 3(3) CTMIR and (b) did not appear to be eligible for registration pursuant to Article 7(1)(a) CTMR. He argued that there was no correlation between the reproduction of the mark and its description, that the public was not able to perceive the sound from the representation supplied, even with the description, and that consequently the application did not contain the graphic representation of a mark as required by Rule 3 CTMIR and Article 4 CTMR, and should be refused in accordance with Article 7(1)(a) CTMR too.
- 3 The appellant disputed the examiner’s view, arguing essentially that the graphic representation requirement of Article 4 CTMR is fulfilled because the sign is capable of being represented graphically by the provided spectrogram. The description very clearly explains what the graphic representation is. Rule 3(3) CTMIR was inserted because it was envisaged that for certain marks, albeit graphically represented, a verbal clarification might be needed. The public can clearly understand what the mark is from its mere description without any need to hear the sound. In the case of “the smell of freshly cut grass” the Second Board of Appeal decided that this description complied with the graphic representation requirement of Article 4 CTMR.

As regards Article 7(1) a CTMR, the mark is capable of distinguishing the goods and services of one undertaking from those of other undertakings *per se* and as a result of its use. The public does recognise this sign as a trade mark because since 1928 it has been hearing the lion’s roar together with the appellant’s goods and services so that

they are inevitably associated (copy of print-outs of the appellant's Internet site were enclosed).

- 4 In the contested decision, the examiner refused the application. He reiterated that the trade mark was not eligible for registration for the reasons given below. The objection of the Office is composed of two steps: the formal deficiency and the lack of the function of a trade mark.

As to the formal deficiency, the Office does not contest that the application for a CTM consists of a graphic representation, but that the graphic reproduction of the mark associated with the description is not of such a nature as to be able to describe correctly the mark as depicted. The description does not allow to reproduce clearly, precisely and unequivocally the sound as depicted.

As to Articles 4 and 7(1) a CTMR, the mark does not fulfil the requirements of the function of a trade mark. It is not capable of distinguishing the goods or services of the appellant from those of other undertakings. The public will not determine the origin of these goods upon sight of this mark. The sign applied for is not precise, clear and unequivocal enough to be perceived *per se* by the public as being a specific 'roar of a lion'.

Additionally, the evidence of use provided in order to prove that the mark has acquired distinctiveness through use (Article 7(3) CTMR) is insufficient. It only confirms that the 'roaring lion' is identified by the public only when linked to the appellant's name.

- 5 The appellant filed a notice of appeal, followed by the statement of grounds, both in due time (November 1999 and January 2000, respectively). In April 2000 the Registry of the Board of Appeal sent the appeal for interlocutory revision. This was not granted. In December 2000, the appeal was re-allocated to the newly established Fourth Board of Appeal.
- 6 The appellant requests the decision of the examiner to be annulled and the application to be registered. The statement of grounds are summarised below.
- 7 Prior to the filing of this application, the representative had specifically contacted the examiner who confirmed that sound marks were registrable. The examiner had 'agreed' that the same 'spectrum representation' as in France could be used for the application for a CTM. The examiner has totally reversed his decision and this lack of consistency is detrimental to the repute of the Office.
- 8 Sound marks are admissible as CTMs because even if they are not specifically mentioned in the CTM Regulations, they are mentioned in the ED guidelines, and even if these guidelines are not binding, according to Article 79 CTMR, procedural law generally recognised in the Member States shall apply as to their principle, and their related practice. In principle, all the national laws of the Member States provide that sound marks are registrable (a report of a survey made in all Member States is enclosed as well as copies of the identical sound mark accepted by the Italian and French national offices). Sound marks are also registered outside the Community, in the

United States of America the lion roaring was accepted (a copy of the corresponding US registration is enclosed).

With respect to the fact that the Office already accepted sound marks No 1040955 and No 907 527, CTM applicants may legitimately expect 'a certain coherence in the application of the criteria adopted by the Office for the examination of trade marks'.

- 9 There is no formal deficiency because the filed spectrogram is a very accurate record of a sound and the most appropriate (where musical notation is not possible as in the present case).

By representing the mark as has been done, the mark is unequivocally defined, and by adding a short but unequivocal description 'The trade mark is constituted by the sound produced by the roar of a lion and is represented by the spectrogram', the mark is clear and the claim is clear. The appellant does not understand why the examiner considers that there is no correlation between the graphic representation and the description of the mark. Just as the average consumer is unable to read musical notation, he is also unable to read spectrograms. But Rule 3(3) CTMIR was inserted for these specific cases where a clarification is needed: the trade mark has to be read together with the description.

However, the applicant is prepared to amend the verbal description of the application as follows: 'The sound mark is composed of a roaring lion having a 7,5 second duration with a frequency response from 25 Hz to 12,5 Hz with measurable harmonies <sic> to 20 Kz <sic>. It has peak modulation at 0,5 second and 4 seconds from the start of the lion's roars and attendant growls.'

Later on, the appellant proposes to amend the description as follows: 'The sound mark is composed of the sound of a roaring lion having a 7.5 second duration (**abscissa**) with a frequency response from 25 Hz to 12.5 Hz with measurable harmonies <sic> to 20 Kz <sic> (**y-axis**). It has peak modulation at 0.5 second and 4 seconds from the start of the lion's roars and attendant growls'.

- 10 The CTM application functions as a mark because it is distinctive *per se* and as a result of use. It is inherently distinctive because it is not descriptive of the goods or services. As it is unusual to use an animal cry to designate goods and services, the public will necessarily associate them with the sound. The sound is therefore recognised as a trade mark. As a practical test, the appellant encloses an audio tape on which the tunes of the Columbia Tristar, Paramount, Walt Disney, Gaumont, MGM, Universal, Twentieth Century Fox and Warner Bros movies company are recorded. The applicant repeats that the association between the lion's roar and its goods and services dates back to 1928.
- 11 Finally, as to the distinctiveness acquired through use, the appellant encloses five declarations by third parties in order to convince the Board that the trade mark has acquired a secondary meaning through genuine use in the territory of the European Union.

- 12 By letter of 12 February 2002, the Chairwoman of the Fourth Board of Appeal, who had taken over as Rapporteur the month before, informed the appellant of the potential objections against the representation provided. The note read, *inter alia*, as follows:

‘(...)

The pattern provided lacks any co-ordinate system; therefore, the diagram itself does not indicate the scaling, orientation (rotation) and translation of the axes, which is expected in case of a spectrogram to read time (horizontal axis) and a frequency (vertical axis). The lack of the axes, consequently, does not allow to determine duration and time course of frequencies of the sound (and, if necessary, to compare this sound with other sounds graphically represented by a spectrogram).

Furthermore, the pattern provided by the appellant shows black marks distributed mainly along a straight - apparently horizontal - line, accompanied by fewer marks distributed approximately symmetrical to this line.

(...)

These features and the observation that the dots of the pattern are grouped orthogonal and symmetrically to the straight (horizontal) line, indicate that the pattern provided by the appellant might in fact be an oscillogram rather than a spectrogram of the sound at hand. However, an oscillogram might not be deemed a sufficient graphic representation of a sound.

(...)

- 13 The time limit for filing comments having been extended, the appellant answered in due time.

- 14 The letter is introduced by reference to ‘extensive discussions’ the in-house lawyer of the appellant had held with the Vice President of the Office, then still responsible for the Boards of Appeal, during which the registrability of sound marks was addressed.

The appellant then addresses the

- distinctive character of the mark applied for,
- representation of a mark in the case of a word mark,
- representation of a mark in the case of a mere sound mark.

- 15 With respect to the graphic representation, there are two options. First, admitting the representation already filed either with the original description or with the amended description as suggested by the appellant in the statement of grounds. That amended description contains all the information on time and frequency needed according to the note dated 12 February 2002. Not including axes on frequency and time in the representation itself, it would be advantageous for the CTM to be granted for exactly the same representation as the one used in France and Italy, which would also ensure harmony with the national marks that were granted.

The second option would be to admit the new representation of the mark with a horizontal axis on ‘time’ and a vertical axis on ‘volume’ as represented on page 6 of the letter (page 109 of the file). This new representation has been made in order to explain further the distinctive sound.

- 16 Finally the appellant discusses oscillograms, spectrograms and sonograms and claims that there is no difference between the three and that the three systems are equally acceptable.
- 17 By letter of April 2003, the appellant refers to the conclusions of the General Advocate Colomer in the Shield Mark vs. George Kit proceedings of the Court of First Instance and to an article on 'La Marque Sonore' published by French lawyers on the internet. The representative of the appellant repeatedly points out that he hopes the extremely well known sound mark in question can be registered as a CTM.
- 18 At the request of the Board of Appeal, the appellant waived its right to have the decision written in Dutch.

Reasons

- 19 The appeal complies with Articles 57, 58 and 59 CTMR and Rule 48 CTMIR. It is therefore admissible. However, the appeal is not well founded as the application for a CTM lacks a proper graphic representation (Article 4 CTMR).
- 20 The fundamental registrability of sound marks as Community trade marks is not disputed, as a trade mark may consist of a sign which is not in itself capable of being perceived visually, provided it can be represented graphically, particularly by means of images, lines or characters (see judgement of the Court of Justice of 12 December 2002, in Case C-273/00, Sieckmann). The question of the graphic representation of such marks is still being debated. In this context, particular account should be taken of the high standards developed by the Court of Justice for the quality of the graphic representation of every mark, which must be clear, precise, self-contained, easily accessible, intelligible, durable and objective (*cf.* CJEC Sieckmann and Libertel judgments).
- 21 If the sound mark involves music in the traditional sense of the word, there is an obvious way to represent it graphically, namely by representing the theme or composition to be registered as a sound mark by standard musical notation, i.e. on or between the lines of a stave, giving the clef, bars, key and, if applicable, the tempo. To date, OHIM appears to have registered sound marks exclusively as 'acoustic marks', which could be represented graphically in this way.
- 22 On the other hand, the situation is different when it is not music, in the traditional sense of the word, that is to be registered as a sound mark, but animal noises such as the roar of a lion or even completely different noises such as rolling thunder in a storm. Here, representation by musical notation regularly fails to work. Attempts have been made to describe sound marks, in particular using verbal description (*cf.* Decision R 1/1998-2 Déclic of the Second Board of Appeal of 7 October 1998) and onomatopoeic description (*cf.* judgment of the Court of Justice C-283/01 Shield Mark v. Kist) of the relevant sounds, but owing to a lack of precision and objectivity, these attempts have rightly been regarded as inadequate.

- 23 In contrast, the approach involving the use of *graphic* aids to represent sound marks graphically is a promising one. However, there appears to be a degree of confusion regarding both the possible diagrams (oscillogram, spectrum, spectrogram, sonogram), and the way in which these diagrams are depicted (*cf.* paragraphs 7 and 16 above).
- 24 An oscillogram is a two-dimensional depiction of the amplitude of the actual signal (vertical axis) versus time (horizontal axis). This definition implies that no processing of the signal depicted has been undertaken; accordingly, an oscillogram would be suitable to represent a sound mark graphically only if it were exclusively a question of the strength (volume) of the signal, which is clearly not the case with sounds. Therefore oscillograms are not normally suitable as graphic representations of sound marks.
- 25 A spectrum is also only a two-dimensional depiction of the distribution of a signal's frequency content (vertical axis) versus frequency (horizontal axis). Therefore such a depiction would be suitable only if changes in frequency content over time were irrelevant, as is obviously not the case with sounds and noises. Thus a spectrum is also unsuitable for representing sound marks graphically.
- 26 Finally, a spectrogram is a three-dimensional depiction of the distribution of a signal's frequency content (blackening) versus frequency (vertical axis) and time (horizontal axis). This broad definition shows that spectrograms can record not only sounds and noises, *i.e.* sound occurrences, but also any signals whatsoever, such as light, for example. On the other hand, if sound occurrences are depicted in this way, the spectrogram is a sound spectrogram, usually known as a sonogram.

Graphic representation of a noise – such as a lion's roar or a roll of thunder – by means of a sonogram results from analysis of the pitch (frequency), relative volume (frequency content) and progression over time of the sound occurrences. Accordingly, representation by means of a sonogram is comparable with representation using musical notation, since the latter also reproduces pitch, volume and progression of the theme or composition over time, even though it involves symbols that differ from those in a sonogram, symbols to which Europeans with an average level of education are more accustomed. In a sonogram, the pitch corresponds to the vertical axis and time to the horizontal axis, and the degree of blackening indicates the volume. The use of form in sonograms is actually superior to that of musical notation, since more nuances and, in particular, sound characteristics are depicted (*cf.* H.-H. Bergmann et al., *Der Falke* 2003, pp. 138, 139).

- 27 The possible objection that sonograms cannot be read by examiners (or the Boards) is not convincing. Naturally, one needs a certain amount of training and practice before one can read sonograms in such a way as to be able to conceive the noise or sound depicted, *i.e.* the relevant sound occurrence. However, the same applies to musical notation; it cannot be assumed that everybody would immediately be capable of hearing the opening bars of 'Für Elise', for example, with his or her inner ear on the basis of musical notation. Nevertheless, nobody seriously disputes the fact that musical notation is a suitable way of representing sound marks graphically. On the other hand, a sonogram without any timescale (horizontal) or frequency scale (vertical) cannot be read. This situation would be comparable with one in which musical notation has no

lines, key, or designation of the notes as, for example, crotchets or semi-breves. In any opposition or infringement proceedings, it would be out of the question to compare representations of sound marks that lacked these dimensions with one another.

- 28 To sum up, it has been established that although the ‘roaring lion’ trade mark applied for does not involve music in the traditional sense of the word, it is registrable in principle as a Community trade mark, since a form of graphic representation that fulfils all requirements is available in the shape of the sonogram. Nevertheless, the appeal against the examiner’s decision to reject it is unsuccessful because the (alleged) sonogram (as depicted in paragraph 1 above) is incomplete – it contains no representation of scale on the time axis and the (alleged) frequency axis.
- 29 There are serious doubts as to whether the pattern provided together with the application is in fact a sonogram (*cf.* paragraph 12 above). However, this can be left undecided as the graphic representation, even if it were a sonogram, would be incomplete and therefore unreadable due to the lack of scales. A pattern that cannot be read, and therefore not understood, cannot be considered as a valid graphic representation of a mark. No musical notation lacking *e.g.* staff lines, could and would be accepted as a graphic representation since the meaning of the different notes is incomprehensible without staff lines. The same applies, *mutatis mutandis*, to the two scales of a sonogram (time and frequency) that are necessary to understand the represented sound with respect to course, tone and volume.
- 30 As regards the print provided by the appellant during the appeal proceedings (*cf.* page 109 of the file), that new print submitted for the first time during the appeal proceedings, cannot be taken into account as a graphic representation pursuant to Article 44(2) CTMR.
- 31 The lack of scales in the reproduction of the (alleged) sonogram cannot be substituted by the different descriptions the appellant provided throughout the proceedings (*cf.* paragraph 9 above). The systematics of Rule 3 CTMIR shows that in cases other than word marks (Rule 3(1)) the mark has to be ‘reproduced’ on a sheet separate from the application text (Rule 3(2)). That application may contain a description of the mark as well (Rule 3(3)), but that description is additional *e.g.* to facilitate understanding in certain cases. The reproduction of the mark itself, as reproduced separately, has to be sufficiently clear and understandable in order to be considered a valid graphic representation of the mark applied for. If substantial parts of that graphic representation are omitted, they cannot be substituted by a verbal description. It would not be acceptable to give a musical notation without staff lines but in their place, a verbal description that there are five staff lines which have to be added to the pure picture of the notes provided.
- 32 Under these circumstances it can be left undecided as to whether the appellant could change the description of the mark during the appeal proceedings (Article 44(2) CTMR). For the sake of completeness only, the Board notes that the two new descriptions suggested in the appeal proceedings cannot substitute a scaling of the (alleged) sonogram itself, as the verbal description does not provide a precise

connection between scales and patterns. This applies in particular to the vertical scale and/or to the angle of the pattern in the diagram (rotation).

33 In conclusion, the appeal is to be dismissed.

Order

On those grounds,

THE BOARD

hereby:

Dismisses the appeal.

C.Hoffrichter-Daunicht

F. López de Rego

W. Peeters

Registrar:

E.Gastinel

R

[Key words using official list] ([Key words using official list])

CTMR Article or provisions of other legislation.

[Key words using official list]

[Main issues of the cases]

For instance:

The word/figurative/three-dimensional/ [redacted] mark for the following goods/services is descriptive/devoid of any distinctive character/ [redacted].

Decision of the [First/Second/Third/Fourth] Board of Appeal of .