

Court of Justice EU, 27 November 2003, Shield Mark – sound mark



TRADEMARK LAW

Soundmarks

• The answer to the first question must therefore be that Article 2 of the Directive is to be interpreted as meaning that sound signs must be capable of being re-garded as trade marks provided that they are capable of distinguishing the goods or services of one undertaking from those of other undertakings and are capable of being represented graphically.

Graphical representation soundmark

• Article 2 of the Directive must be interpreted as meaning that a trade mark may consist of a sign which is not in itself capable of being perceived visually, provided that it can be represented graphically, particularly by means of images, lines or characters, and that its representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective;

in the case of a sound sign, those requirements are not satisfied when the sign is represented graphically by means of a description using the written language, such as an indication that the sign consists of the notes going to make up a musical work, or the indication that it is the cry of an animal, or by means of a simple onomatopoeia, without more, or by means of a sequence of musical notes, without more. On the other hand, those requirements are satisfied where the sign is represented by a staff divided into measures and showing, in particular, a clef, musical notes and rests whose form indicates the relative value and, where necessary, accidentals

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Court of Justice EU, 27 November 2003

(V. Skouris, J.N. Cunha Rodrigues, J.-P. Puissechet, R. Schintgen and F. Macken)

JUDGMENT OF THE COURT (Sixth Chamber)

27 November 2003 (1)

(Trade marks - Approximation of laws - Directive 89/104/EEC - Article 2 - Signs of which a trade mark may consist - Signs capable of being represented graphically - Sound signs - Musical notation - Written description - Onomatopoeia)

In Case C-283/01,

REFERENCE to the Court under Article 234 EC by the Hoge Raad der Nederlanden (Netherlands) for a pre-

liminary ruling in the proceedings pending before that court between

Shield Mark BV

and

Joost Kist h.o.d.n. Memex,

on the interpretation of Article 2 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1),

THE COURT (Sixth Chamber),

composed of: V. Skouris, acting for the President of the Sixth Chamber, J.N. Cunha Rodrigues, J.-P. Puissechet, R. Schintgen and F. Macken (Rapporteur), Judges,

Advocate General: D. Ruiz-Jarabo Colomer,

Registrar: M.-F. Contet, Principal Administrator,

after considering the written observations submitted on behalf of:

- Shield Mark BV, by T. Cohen Jehoram and E.J. Morée, advocaten,

- the Netherlands Government, by H.G. Sevenster, acting as Agent,

- the French Government, by G. de Bergues and A. Maitrepierre, acting as Agents,

- the Italian Government, by U. Leanza, acting as Agent, assisted by O. Fiumara, avvocato dello Stato,

- the Austrian Government, by C. Pesendorfer, acting as Agent,

- the United Kingdom Government, by J.E. Collins, acting as Agent, and D. Alexander, Barrister,

- the Commission of the European Communities, by N.B. Rasmussen and H.M.H. Speyart, acting as Agents, having regard to the Report for the Hearing,

after hearing the oral observations of Shield Mark BV, represented by T. Cohen Jehoram, of the Netherlands Government, represented by N.A.J. Bel, acting as Agent, and also of the Commission, represented by N.B. Rasmussen and H. van Vliet, acting as Agent, at the hearing on 27 February 2003,

after hearing the [Opinion of the Advocate General](#) at the sitting on 3 April 2003,

gives the following

Judgment

1. By judgment of 13 July 2001, received at the Court on 18 July 2001, the Hoge Raad der Nederlanden (Netherlands) referred to the Court under Article 234 EC two questions for a preliminary ruling on the interpretation of Article 2 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1; ‘the Directive’).

2. Those question were raised in proceedings between Shield Mark BV (‘Shield Mark’) and Mr Kist, trading as Memex, concerning the latter's use in the course of his trade of signature tunes (jingles) previously registered by Shield Mark at the Benelux Trade Marks Office (‘BBM’) as sound marks.

Legal framework

Community legislation

3. According to the first recital in the preamble to the Directive, the purpose of the Directive is to approxi-

mate the laws of Member States on trade marks in order to remove the disparities capable of impeding the free movement of goods and freedom to provide services and distorting competition within the common market. However, as indicated in the third recital, the Directive does not seek to achieve full-scale approximation of those laws.

4. The seventh recital to the Directive states that ‘attainment of the objectives at which this approximation of laws is aiming requires that the conditions for obtaining and continuing to hold a registered trade mark are, in general, identical in all Member States’ and that, ‘to this end, it is necessary to list examples of 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’.

5. Article 2 of the Directive, entitled ‘Signs of which a trade mark may consist’, contains the list of examples referred to in the seventh recital. It provides:

‘A trade mark may consist of any sign 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.’

6. Article 3 of the Directive, entitled ‘Grounds for refusal or invalidity’, provides in paragraph 1(a) and (b): ‘The following shall not be registered or if registered shall be liable to be declared invalid:

- (a) signs which cannot constitute a trade mark;
- (b) trade marks which are devoid of any distinctive character’.

Legislation applicable to Benelux

7. The Kingdom of Belgium, the Grand Duchy of Luxembourg and the Kingdom of the Netherlands laid down their trade marks law in a common law, the uniform Benelux law on trade marks (Trb. 1962, 58, and Trb. 1983, 187; ‘the LBM’), and responsibility for its implementation was entrusted to a common institution, the BBM.

8. The LBM was amended, with effect from 1 January 1996, by the Protocol of 2 December 1992 amending that law (Trb. 1993, 12, ‘the Protocol’), in order to transpose the Directive into the legal order of those three Member States.

9. However, it was not deemed necessary to amend the LBM for the purpose of expressly transposing Articles 2 and 3 of the Directive. In that regard, the sixth and seventh subparagraphs of point I.2 of the grounds of the Protocol provide:

‘Article 2 of the Directive, concerning signs which may be protected, does not require amendment of the LBM. The wording of that article corresponds almost wholly with Article 1 of the LBM. While it is true that, unlike Article 2 of the Directive, Article 1 of the LBM does not require that the signs be capable of being represented graphically, in practice signs are none the less required to satisfy that requirement in order to benefit from protection as a trade mark.

Nor did Article 3 of the Directive entail an amendment of the LBM. The absolute grounds for refusal or invalidity set out in the first paragraph of that article may be found in Articles 1 and 4(1) and (2), taken together with Article 14(A)(1) of the LBM. ...’

10. Article 1 of the LBM, which was not thus amended by the Protocol, provides in the first paragraph:

‘Denominations, designs, prints, seals, letters, numbers, shapes of products or of packaging and all other signs serving to distinguish an undertaking’s products shall be regarded as individual trade marks.’

11. Article 1(b) of the regulation implementing the LBM provides that ‘[t]he Benelux deposit of a trade mark shall be done in French or Dutch by production of a document bearing ... a reproduction of the trade mark’.

12. Although, before the entry into force of the Protocol on 1 January 1996, the BBM did not carry out a substantive check of the registration of a trade mark, such a check, where necessary, being made ex post facto, on the occasion of an invalidity action or in a counterclaim action in a case involving breach of the rights of the holder of the trade mark, it now examines applications on the basis of the absolute grounds for refusal laid down in the LBM.

13. As regards sound marks, the BBM initially considered that they could be registered. However, following the judgment of the *Gerechthof te's Gravenhage* (Regional Court of Appeal) (Netherlands) of 27 May 1999, delivered in proceedings between the parties to the main proceedings, the BBM has generally refused to register sound marks.

Main proceedings and questions referred to the Court

14. Shield Mark is the holder of 14 trade marks registered at the BBM, the first on 5 June 1992 and the most recent on 2 February 1999, for various products and services in Classes 9 (computer software (recorded), etc.), 16 (magazines, newspapers, etc.), 35 (publicity, business management, etc.), 41 (education, training, organisation of seminars on publicity, marketing, intellectual property and communications in the business sector, etc.) and 42 (legal services) of the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as amended and modified.

15. Four of those trade marks consist of a musical stave with the first nine notes of the musical composition ‘Für Elise’, by Ludwig van Beethoven. Two of them also state: ‘Sound mark. The trade mark consists of the representation of the melody formed by the notes (graphically) transcribed on the stave’, plus, in one case, ‘played on a piano’.

16. Four other trade marks consist of the first nine notes of ‘Für Elise’. Two of them also state: ‘Sound mark. The trade mark consists of the melody described’, plus, in one case, ‘played on a piano’.

17. Three further marks consist of the sequence of musical notes ‘E, D#, E, D#, E, B, D, C, A’. Two of them also state: ‘Sound mark. The trade mark consists of the reproduction of the melody formed by the sequence of

notes as described', plus, in one case, 'played on a piano'.

18. Two of the trade marks registered by Shield Mark consist of the denomination 'Kukelekuuuuu' (an onomatopoeia suggesting, in Dutch, a cockcrow). One of them states: 'Sound mark, the trade mark consists of an onomatopoeia imitating a cockcrow'.

19. Last, one mark consists of a 'cockcrow' and also states: 'Sound mark, the trade mark consists of the cockcrow as described'.

20. In October 1992, Shield Mark launched a radio advertising campaign, each of its commercials beginning with a signature tune employing the first nine notes of 'Für Elise'. Furthermore, from February 1993 Shield Mark has issued a news sheet describing the services which it offers on the market. Its news sheets are displayed on stands in bookshops and newspaper kiosks and the signature tune is heard each time a news sheet is removed from the stand. Last, Shield Mark publishes software for lawyers and marketing specialists and each time the disk containing the software starts up a cockcrow is heard.

21. Mr Kist, who operates as a communications consultant, in particular in advertising law and trade marks law, organises seminars on intellectual property and marketing and publishes a review dealing with those matters.

22. During an advertising campaign which began on 1 January 1995, Mr Kist used a melody consisting of the first nine notes of 'Für Elise' and also sold a computer program which, when starting up, emits a cockcrow.

23. Shield Mark brought an action against Mr Kist for infringement of its trade mark and unfair competition.

24. By judgment of 27 May 1999, the *Gerechtshof te's Gravenhage* granted Shield Mark's application in so far as it was based on the law of civil responsibility, but dismissed it in so far as it was based on trade marks law, on the ground that it was the intention of the Governments of the Member States of Benelux to refuse to register sounds as trade marks.

25. Shield Mark appealed to the *Hoge Raad der Nederlanden*, which decided to stay proceedings and to refer the following questions to the Court for a preliminary ruling:

'1. (a) Must Article 2 of the Directive be interpreted as precluding sounds or noises from being regarded as trade marks?

(b) If the answer to question 1(a) is in the negative, does the system established by the Directive require that sounds or noises must be capable of being regarded as trade marks?

2. (a) If the answer to question 1(a) is in the negative, what requirements does the Directive lay down for sound marks as regards the reference in Article 2 to the need for the sign to be capable of being represented graphically and, in conjunction therewith, as regards the way in which the registration of such a trade mark must take place?

(b) In particular, are the requirements referred to in (a) satisfied if the sound or the noise is registered in one of the following forms:

- musical notes;
- a written description in the form of an onomatopoeia;
- a written description in some other form;
- a graphical representation such as a sonogram;
- a sound recording annexed to the registration form;
- a digital recording accessible via the internet;
- a combination of those methods;
- some other form and, if so, which?'

First question

26. By part (a) of its first question, the national court is asking whether Article 2 of the Directive must be interpreted as precluding sound signs from being regarded as trade marks. In the event that the answer is in the negative, it asks, by part (b) of its first question, whether that article implies that sound signs must be capable of being regarded as trade marks.

Observations submitted to the Court

27. According to Shield Mark, it follows from the seventh recital to the Directive that Article 2 thereof does not contain an exhaustive list of signs of which a trade mark may consist. Accordingly, all signs capable of serving to distinguish an undertaking's products or services from those of other undertakings may, in principle, serve as trade marks. It follows, in its submission, that since sound signs are clearly capable of doing so they may fulfil the role of a trade mark.

28. That interpretation is supported, in particular, by the Opinion of Advocate General Ruiz-Jarabo Colomer in Case C-273/00 *Sieckmann* [2002] ECR I-11737, by the preliminary work on the Directive and the Council documents available to the public concerning the adoption of both the Directive and Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p. 1), and also by the Examination Guidelines of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM).

29. The Netherlands, French, Italian, Austrian and United Kingdom Governments maintain that sounds are capable of distinguishing products or services of one undertaking from those of other undertakings. As the list of signs of which a trade mark may consist in Article 2 of the Directive is merely indicative, sounds may constitute trade marks.

30. The French and Austrian Governments further state that, owing to the objective of the Directive, which is to approximate the laws of the Member States relating to trade marks, sounds must be capable of being regarded as trade marks provided that they are capable of being represented graphically.

31. The Commission observes that Article 2 of the Directive requires that, in order to be registered as a trade mark, a sign must be capable of being represented graphically and capable of distinguishing the goods or services of one undertaking from those of other undertakings. In its view, it follows from the system established by Articles 2 and 3 of the Directive that distinctive character for the purposes of Article 2, unlike Article 3, does not relate to whether a sign may actually assume a distinctive character for the goods or services for which its registration as a trade mark is sought, but

rather to the possession, by the sign in question, of a distinctive character in general terms, irrespective of the various categories of products or services.

32. Sounds and noises are perceptible by human beings, who are able to remember them, and they allow the goods or services of one undertaking to be distinguished from those of other undertakings. Furthermore, they are capable of being represented graphically.

33. Since the list of signs of which a trade mark may consist in Article 2 of the Directive is not limitative, the Commission infers that signs consisting of sounds or noises are in principle capable of being registered as trade marks, on condition that they are capable of distinguishing goods or services without any risk of confusion and that they are capable of being represented graphically in a clear, precise and stable manner which allows third parties to understand without difficulty what trade mark is being protected.

The Court's response

34. As regards the first question, the purpose of Article 2(a) of the Directive is to define the types of signs of which a trade mark may consist. That provision states that a trade mark may consist of 'particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging ...'. Admittedly, that provision mentions only signs which are capable of being perceived visually, are two-dimensional or three-dimensional and can thus be represented by means of letters or written characters or by a picture (Sieckmann, cited above, paragraph 43).

35. However, as is clear from the language of both Article 2 of the Directive and the seventh recital in the preamble thereto, which refers to a 'list [of] examples' of signs of which a trade mark may consist, that list is not exhaustive. Consequently, that provision, although it does not mention signs which are not in themselves capable of being perceived visually, such as sounds, does not, however, expressly exclude them (see, to that effect, regarding olfactory signs, Sieckmann, paragraph 44).

36. Furthermore, as Shield Mark, the intervening Governments and the Commission have stated, sound signs are not by nature incapable of distinguishing the goods or services of one undertaking from those of other undertakings.

37. In those circumstances, Article 2 of the Directive must be interpreted as meaning that sounds may constitute a trade mark, on condition that they may also be represented graphically, a question to be dealt with when the Court considers the second question.

38. As regards part (b) of the first question, Article 2 of the Directive does not preclude the registration of sounds as trade marks. Consequently, the Member States cannot preclude such registration as a matter of principle.

39. Although the Directive does not seek to achieve full-scale approximation of the laws of the Member States relating to trade marks, it is clear from the seventh recital to the Directive that the conditions for obtaining and continuing to hold a trade mark are to be the same in all the Member States.

40. In that regard, as the French Government has observed, the nature of the signs of which a trade mark may consist cannot differ from one Member State to another.

41. The answer to the first question must therefore be that Article 2 of the Directive is to be interpreted as meaning that sound signs must be capable of being regarded as trade marks provided that they are capable of distinguishing the goods or services of one undertaking from those of other undertakings and are capable of being represented graphically.

Second question

42. By its second question, the national court is asking the Court to state the conditions on which a sound sign is capable of being represented graphically within the meaning of Article 2 of the Directive and, in particular, whether musical notes, a written description in the form of an onomatopoeia, a written description in some other form, a graphical representation such as a sonogram, a sound recording annexed to the registration form, a digital recording accessible via the internet, a combination of those methods, or any other form meet the requirements of graphical representation.

Observations submitted to the Court

43. First of all, Shield Mark, the intervening Governments and the Commission agree that any graphical representation of a sound sign must satisfy various requirements in order for the sign to be capable of being a trade mark.

44. Thus, in Shield Mark's submission, the graphical representation must be clear, precise and comprehensible, without undue effort, to third parties. According to the Netherlands Government, it must be complete, clear and precise, so that it is possible to know to what the exclusivity of the holder of the trade mark relates, and intelligible to those with an interest in consulting the trade mark register. The French Government claims that the graphical representation must be clear and precise, although it is not essential that the perception of the sign be immediate for the public; furthermore, the protected sign must be intelligible. The Italian Government submits that the representation must be suitable for expressing the sound, for rendering it comprehensible and for distinguishing it. The Austrian Government maintains that the sound of a sound sign must be clear from a graphical representation or must be capable of being inferred with sufficient clarity, so that the scope of such protection as the trade mark may afford is recognisable with sufficient precision. According to the United Kingdom Government, the graphical representation must be sufficiently complete in itself, clear, precise and understood, without undue effort, by persons consulting the trade mark register. Last, the Commission claims that the representation must be clear, precise and stable and must allow third parties to understand without difficulty what the protected trade mark is.

45. As regards, second, the acceptable forms of graphical representation of sound signs, Shield Mark, the French, Austrian and United Kingdom Governments and the Commission maintain that a musical stave con-

stitutes a graphical representation for the purposes of Article 2 of the Directive.

46. Shield Mark and the French Government, unlike the United Kingdom Government and the Commission, take the view that a reference to a well-known work, such as ‘the first nine notes of “Für Elise”’, constitutes a graphical representation.

47. Unlike the French and United Kingdom Governments, Shield Mark and the Commission maintain that the description of a tune by the transcription of the notes of which it is composed, such as ‘E, D#, E, D#, E, B, D, C, A’ must be regarded as a graphical representation of the melody concerned.

48. Shield Mark and the French and Austrian Governments accept, in essence, that a sonogram constitutes a graphical representation, while the Austrian Government further states that such a sign may be registered provided that it is accompanied by an acoustic reproduction on a data carrier, and the French Government states that this mode of representation might be accompanied by a sound recording or a digital recording. The United Kingdom Government, on the other hand, maintains that, generally, this form of graphical representation cannot be accepted and the Commission rejects the contention that, at the current stage of technology, a sonogram may be an acceptable form of graphical representation when filing a sign for registration as a trade mark.

49. Unlike the French and Austrian Governments, Shield Mark and, in certain circumstances (where the description is clear and unambiguous), the United Kingdom Government and the Commission take the view that an onomatopoeia is also capable of being registered.

50. As regards a sound recording annexed to the registration form, the French Government submits that it might accompany a sonogram or a spectrogram and the Austrian Government maintains that it must be annexed to a sonogram. On the other hand, this purported mode of ‘graphical representation’ is disputed as a means of filing an application for a sign as a trade mark by Shield Mark, the United Kingdom Government and the Commission.

The Court's response

51. As a preliminary observation, it is to be remembered that, in the context of the cooperation between the Court of Justice and the national courts provided for by Article 234 EC, it is solely for the national court before which the dispute has been brought, and which must assume responsibility for the subsequent judicial decision, to determine in the light of the particular circumstances of the case both the need for a preliminary ruling in order to enable it to deliver judgment and the relevance of the questions which it submits to the Court. Consequently, where the questions submitted by the national court concern the interpretation of Community law, the Court of Justice is, in principle, bound to give a ruling (see, *inter alia*, Case C-415/93 *Bosman* [1995] ECR I-4921, paragraph 59).

52. Nevertheless, the Court has taken the view that, in order to determine whether it has jurisdiction, it should

examine the conditions in which the case was referred to it by the national court. The spirit of cooperation which must prevail in the preliminary-ruling procedure requires the national court, for its part, to have regard to the function entrusted to the Court of Justice, which is to assist in the administration of justice in the Member States and not to deliver advisory opinions on general or hypothetical questions (see, *inter alia*, *Bosman*, cited above, paragraph 60).

53. The Court may therefore decline to rule on a question referred by a national court for a preliminary ruling where, *inter alia*, the problem is hypothetical (see, *inter alia*, Case C-111/01 *Gantner Electronic* [2003] ECR I-4207, paragraph 36).

54. In the present case, Shield Mark did not file an application for registration in the form of a sonogram, a sound recording, a digital recording or a combination of those methods, so that, in the absence of relevance, an answer cannot be provided to the question in so far as it relates to those modes of representation.

55. As regards, in the first place, the requirements to be satisfied by any graphical representation, the Court held in *Sieckmann*, cited above, which concerned olfactory signs, that Article 2 of the Directive must be interpreted as meaning that a trade mark may consist of a sign which is not in itself capable of being perceived visually, provided that it can be represented graphically, particularly by means of images, lines or characters, and that its representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective.

56. Those conditions are also binding on sound signs, which, like olfactory signs, are not in themselves capable of visual perception.

57. As regards, in the second place, acceptable forms of graphical representation, although it is for the national court to determine, in each specific case before it, whether the sign was capable of constituting a trade mark and could therefore be validly registered, the Court is none the less competent to provide guidance as to whether a representation by means of musical notes or a representation using the written language constitutes a graphical representation of a sound sign for the purposes of Article 2 of the Directive.

58. It must be emphasised at the outset that a sign cannot be registered as a sound mark where the applicant has failed to state in the application for registration that the sign in question must be understood as being a sound sign. In such a case, the competent trade mark registration authority, and the public, in particular traders, are entitled to consider that it is a word mark or a figurative mark as represented graphically in the application for registration.

59. As regards, first, the representation of a sound sign by a description using the written language, it cannot be precluded a priori that such a mode of graphical representation satisfies the requirements defined at paragraph 55 of this judgment. However, in the case of signs such as those at issue in the main proceedings, a graphical representation such as ‘the first nine notes of “Für Elise”’ or ‘a cockcrow’ at the very least lacks pre-

cision and clarity and therefore does not make it possible to determine the scope of the protection sought. Accordingly, it cannot constitute a graphical representation of that sign for the purposes of Article 2 of the Directive.

60. As regards, next, an onomatopoeia, it must be held that there is a lack of consistency between the onomatopoeia itself, as pronounced, and the actual sound or noise, or the sequence of actual sounds or noises, which it purports to imitate phonetically. Thus, where a sound sign is represented graphically by a simple onomatopoeia, it is not possible for the competent authorities and the public, in particular traders, to determine whether the protected sign is the onomatopoeia itself, as pronounced, or the actual sound or noise. Furthermore, an onomatopoeia may be perceived differently, depending on the individual, or from one Member State to another. That is so in the case of the Dutch onomatopoeia ‘Kukelekuuuu’, which seeks to transcribe a cockcrow, and which is very different from the corresponding onomatopoeia in the other languages used in the Benelux Member States. Consequently, a simple onomatopoeia cannot without more constitute a graphical representation of the sound or noise of which it purports to be the phonetic description.

61. As regards, last, musical notes, which are a common method of representing sounds, a sequence of notes without more, such as ‘E, D#, E, D#, E, B, D, C, A’, does not constitute a graphical representation for the purposes of Article 2 of the Directive either. Such a description, which is neither clear, nor precise nor self-contained, does not make it possible, in particular, to determine the pitch and the duration of the sounds forming the melody in respect of which registration is sought and which constitute essential parameters for the purposes of knowing the melody and, accordingly, of defining the trade mark itself.

62. On the other hand, a stave divided into bars and showing, in particular, a clef (a treble clef, bass clef or alto or tenor clef), musical notes and rests whose form (for the notes: semibreve, minim, crotchet, quaver, semiquaver, etc.; for the rests: semibreve rest, minim rest, crotchet rest, quaver rest, etc.) indicates the relative value and, where appropriate, accidentals (sharp, flat, natural) - all of this notation determining the pitch and duration of the sounds - may constitute a faithful representation of the sequence of sounds forming the melody in respect of which registration is sought. This mode of graphical representation of the sounds meets the requirements of the case-law of the Court that such representation must be clear, precise, self-contained, easily accessible, intelligible, durable and objective.

63. Even if such a representation is not immediately intelligible, the fact remains that it may be easily intelligible, thus allowing the competent authorities and the public, in particular traders, to know precisely the sign whose registration as a trade mark is sought.

64. The answer to the second question must be that:

- Article 2 of the Directive must be interpreted as meaning that a trade mark may consist of a sign which is not in itself capable of being perceived visually, pro-

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

- in the case of a sound sign, those requirements are not satisfied when the sign is represented graphically by means of a description using the written language, such as an indication that the sign consists of the notes going to make up a musical work, or the indication that it is the cry of an animal, or by means of a simple onomatopoeia, without more, or by means of a sequence of musical notes, without more. On the other hand, those requirements are satisfied where the 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.

Costs

65. The costs incurred by the Netherlands, French, Italian, Austrian and United Kingdom Governments and by the Commission, which have submitted observations to the Court, are not recoverable. Since these proceedings are, for the parties to the main proceedings, a step in the action pending before the national court, the decision on costs is a matter for that court.

On those grounds,

THE COURT (Sixth Chamber),

in answer to the questions referred to it by the Hoge Raad der Nederlanden by judgment of 13 July 2001, hereby rules:

1. Article 2 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks is to be interpreted as meaning that sound signs must be capable of being regarded as trade marks provided that they are capable of distinguishing the goods or services of one undertaking from those of other undertakings and are capable of being represented graphically.

2. Article 2 of Directive 89/104 must be interpreted as meaning that a trade mark may consist of a sign which is not in itself capable of being perceived visually, provided that it can be represented graphically, particularly by means of images, lines or characters, and that its representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective.

In the case of a sound sign, those requirements are not satisfied when the sign is represented graphically by means of a description using the written language, such as an indication that the sign consists of the notes going to make up a musical work, or the indication that it is the cry of an animal, or by means of a simple onomatopoeia, without more, or by means of a sequence of musical notes, without more. On the other hand, those requirements are satisfied where the 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.

OPINION OF ADVOCATE GENERAL
RUIZ-JARABO COLOMER

delivered on 3 April 2003 (1)

Case C-283/01

Shield Mark BV

v

Joost Kist

(Reference for a preliminary ruling from the Hoge Raad der Nederlanden (Netherlands))

(Trade marks - Approximation of laws - Directive 89/104/EEC - Article 2 - Signs of which a trade mark may consist - Sounds - Signs capable of being represented graphically)

1. The interpretation of Article 2 of the Trade Mark Directive (2) and the determination of the signs of which this form of industrial property may consist are no longer behind the scenes but have taken their place on the proscenium of the judicial stage.

2. The Court of Justice has recently ruled on the capacity of odours to be trade marks (3) and it will shortly have done so in respect of colours as such, with neither form nor shape. (4) The object of the present case is to dispel the mystery surrounding sounds.

3. The Hoge Raad der Nederlanden raises the question whether sensations induced by sound satisfy the requirements of the abovementioned provision which a sign must fulfil in order to be regarded as a trade mark and, if so, asks about the form which its registration must take.

I - Facts and main proceedings

4. Shield Mark BV ('Shield Mark') own 14 trade marks, registered at the Benelux office (Benelux-Merkenbureau). Eleven of these have as their theme the first, elegiac notes of the étude for piano 'Für Elise', (5) composed by Ludwig van Beethoven, (6) and three a cockcrow.

5. In the first group, the representation of four trade marks (7) represents a musical stave with the first nine notes of the piece in question. The third and fourth are accompanied by the following description: 'Sound mark. The mark is formed by the musical reproduction of the notes (graphically) represented on the stave'. In the first of the latter two marks it is stated that the music should be played 'on a piano'.

6. Two further trade marks (8) are word marks and their registration is described as follows: 'consists of the first nine notes of "Für Elise"'. Joined to these last trade marks are two more (9) which present the same description, but which were filed as sound marks; 'the mark consists of the musical reproduction of the notes described', plus, in the case of the first, to be 'played on a piano'.

7. There is a third group of three marks (10) with the description 'E, D#, E, D#, E, B, D, C, A'. However, the first is a word mark, while the last two are sound marks, consisting in the reproduction of the sequence of notes, on the piano, as stated in the second.

8. As regards the three remaining indications, two (11) are based on the denomination 'kukelekuuuuu', (12) and one of them has the following mention: 'sound mark consisting of an onomatopoeia representing a

cockcrow'. The last, (13) which is also explained as 'the crowing of a cock', is an acoustic mark 'formed by the sound described'.

9. In October 1992, Shield Mark launched a radio advertising campaign, based on messages beginning with a jingle consisting of the first nine notes of 'Für Elise'. From February of the following year, it began to publish a news sheet devoted to its activities, on sale on stands located at the cash desks of book shops and kiosks. Each time a copy is taken out, the melody is heard.

10. Shield Mark also developed a computer program for lawyers and marketing specialists, which provided them with information on choosing and protecting a trade mark. When the program is run, a strident cockcrow is heard.

11. Mr Kist, who trades under the name 'Memex', provides a legal consultancy specialising in advertising law, trade mark law, copyright and, generally, the law on commercial communications. He also organises seminars and publishes a review dealing with those matters. On 1 January 1995 he launched an advertising campaign, using the same sound signs and the same marketing techniques as Shield Mark. (14)

12. Shield Mark brought proceedings against Mr Kist before the Gerechtshof te's-Gravenhage (Trade Marks Court, The Hague), seeking an injunction, under pain of coercive fines, on the use by him in Benelux of the trade marks of which it was the owner, in connection with the goods and services in respect of which they were registered. In a judgment of 27 May 1999, the Gerechtshof te's-Gravenhage dismissed the claim in so far as it was based on trade mark law and upheld the claims based on the defendant's unfair conduct.

II - The questions referred to the Court

13. Shield Mark appealed on a point of law to the Hoge Raad, which decided to stay the proceedings and to refer to the Court for a preliminary ruling the following questions on the interpretation of Article 2 of the Trade Mark Directive:

'1(a) Must Article 2 of the Directive be interpreted as precluding sounds or noises from being regarded as trade marks?

1(b) If the answer to question 1(a) is in the negative, does the system established by the Directive require that sounds or noises must be capable of being regarded as trade marks?

2(a) If the answer to question 1(a) is in the negative, what requirements does the Directive lay down for sound marks as regards the reference in Article 2 to the need for the sign to be capable of being represented graphically and, in conjunction therewith, as regards the way in which the registration of such a trade mark must take place?

2(b) In particular, are the requirements referred to in (a) satisfied if the sound or the noise is registered in one of the following forms:

- musical notes;
- a written description in the form of an onomatopoeia;
- a written description in some other form;
- a graphical representation such as a sonogram;

- a sound recording annexed to the registration form;
- a digital recording accessible via the internet;
- a combination of those methods;
- some other form and, if so, which?’

III - Examination of the questions

A. Sounds as trade marks

14. ‘May’ sounds be trade marks? Or, indeed, ‘should’ they be trade marks? Those are the questions which the Hoge Raad raises in the two parts of its first question, which refers to Article 2 of the Directive, which provides that ‘any sign capable of being represented graphically’ 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’.

15. The legal concept of a trade mark therefore consists of two elements: ability to distinguish and capacity to be represented graphically. In order to be capable of being used as a trade mark, a sign must combine both qualities.

16. In my Opinion in Sieckmann, cited above, I stated that human beings perceive and recognise messages, i.e. communicate by means of senses other than sight, (15) so that they can be used in a trade mark, (16) because they are capable of having ‘some distinctive character’. (17)

17. Although it is true that that case concerned olfactory trade marks, the considerations which I set out concerning odours are applicable to messages received by hearing. The Court of Justice itself so stated in its judgment of 12 December 2002, when it ruled that Article 2 of the Directive allows signs not capable of being perceived visually to constitute a trade mark. (18) The ability of sounds and, in particular, music to identify derives from its evocative intensity, which converts sounds into a specific language. Marcel Proust was able to capture it in a decisive passage in *In search of lost time*, where the narrator asks ‘whether music is not the only example of what - had language, the formation of words, the analysis of ideas not been invented - might have been the communication between souls. It is a possibility which was not subsequently developed; humanity followed other routes, the way of spoken and written expression’. (19) This idea is based on the philosophy of Schopenhauer, expressed in his work *The world as will and representation*, in which he assigns to music the same revelatory and transcendent function as that subsequently attributed to it by Proust’s work, avoiding the poetic explanations and with the same attention to time. (20)

In short, Proust literally paraphrased Schopenhauer’s text, in particular, in relation to the capacity of music to interpret the intimate essence of things, (21) since the novel relies on a metaphysical aesthetic from which it translates the abstract and theoretical content into the attitudes experienced, into the actions, into the sentiments which constitute the substance of an artistic work, (22) taking into account above all that music imitates life and prefigures the work on which the novelist must embark in order to combine the strands in a single and organised whole, since he functions as the involun-

tary memory: the reappearance of a melody already heard brings to mind the first hearing, as the flagstones of the pavement, in Proust’s work, bring to the narrator’s mind the episode of the madeleine. (23)

18. Thus, because they have the capacity to distinguish, auditory messages may, in principle, be trade marks. (24) However, the doubts expressed by the Hoge Raad go much further and, once it is accepted that that provision envisages, without expressly referring to them, (25) other signs distinct from visual signs, asks whether the Member States are free to preclude sounds as indications capable of constituting that class of property.

19. The answer must be in the negative. The Trade Marks Directive is a harmonisation measure and its purpose is to approximate the trade mark laws of the Member States in order to remove disparities which may impede on trade marks, with the aim of abolishing the disparities which hinder the free movement of goods and freedom to provide services or distort competition within the common market. (26) It is true that it is not intended to achieve full-scale approximation, since it only concerns certain aspects relating to trade marks acquired by registration, (27) but the matters on which harmonisation must be reached include the list of signs of which a trade mark may consist. (28)

20. The single market, without barriers to the free movement of goods and freedom to provide services, requires that the protection given to a trade mark in one Member State be equal to that afforded in another Member State, and for that reason it is essential that throughout the entire territory of the European Union the same trade mark be regarded and protected as such. In short, as the French Government states in its written observations, there are no differences from one Member State to another on the nature of the indications capable of distinguishing the goods of some undertakings from those of other undertakings.

21. In so far as the Directive has not precluded sounds, no Member State can prevent a message of that type from being registered as a trade mark, on the clear understanding that it satisfies the mandatory requirements: capacity to distinguish and capability of being represented graphically.

22. The legal orders of many Member States expressly state that sounds are signs capable of constituting or forming part of a trade mark. That is so in Germany, (29) Austria, (30) Spain, (31) France, (32) Greece, (33) Italy (34) and Portugal. (35) Other systems, like the Directive, make no reference to sounds: these are the three States forming the Benelux Economic Union, (36) Denmark, (37) Finland, (38) Ireland, (39) the United Kingdom (40) and Sweden. (41) However, none of them expressly precludes sounds; furthermore, all the relevant provisions, like Article 2 of the Trade Marks Directive, expressly state that the list which they include is open and incomplete.

23. In some of the legal systems in which sounds are not mentioned by name, administrative practice, by accepting them, has undertaken to dispel the claims of those who maintain that acoustic signs cannot constitute that form of industrial property. (42)

24. By reason of the foregoing reflections, I propose that the Court of Justice should rule, in answer to the first question referred by the Hoge Raad, that Article 2 of the Directive not only does not preclude sound signs from being trade marks but prevents the national legal orders from precluding them from that condition a priori.

B. The graphical representation of the sound messages

25. As I have stated, the capacity of sound signs to distinguish is an essential but not a sufficient condition of acceptance as trade marks. They must, in addition, be capable of being represented graphically, in the words of Article 2 of the Directive, a requirement which is also present in most of the legal orders of the Member States. (43)

1. The purpose of the requirement and the qualities of the representation

26. This requirement is not unimportant and has its *raison d'être* in the system of registration central to the Directive, (44) in which the exclusive rights conferred by ownership of a trade mark are acquired by means of its entry on the register. (45) 'If an undertaking reserves certain signs and references for itself in order to distinguish its goods and services from those of other undertakings, the symbols so claimed must be known very precisely.' (46)

27. The principle of legal certainty thus makes the requirement necessary. (47) The authorities responsible for the registration institution, other traders and consumers in general must be able to know precisely the object on which protection is conferred: the first group, in order to carry out their responsibilities properly; the second, in order to exercise their rights without encroaching on those of the owner of the trademarks; and the third, in order to select the products and services on the basis of their provenance in a system of open competition. (48)

28. Consequently, '[s]igns comprising a trade mark are represented graphically in order to protect and publicise their appropriation by an undertaking, which has reserved the signs for itself with the aim of individualising the goods or services it offers'. (49)

29. That objective is not attained by every figure perceptible by sight, since the representation must be 'clear, precise, self-contained, easily accessible, intelligible, durable and objective'. (50) It must be easily accessible and intelligible so that virtually all those interested in consulting the register, consisting of other producers and consumers, are able to understand it. It must be clear, precise and complete so that the indication which is used may be known beyond doubt. It must be durable and objective so that neither the passing of time nor the change in the addressee will affect the identification or the perception of the sign.

30. Since, as I have stated, the indications of which a trade mark consists need not necessarily be visual, those qualities of the representation must be adapted to the particular nature of those indications, in such a way that they are identified accurately.

2. The different forms of graphical representation of the sounds

31. As regards the signs which are perceived by hearing, I must therefore ask myself the same questions as in my Opinion in *Sieckmann* concerning olfactory messages: Can a sound be 'drawn'? Can an auditory signal be graphically represented in a way which is precise and clear for everyone?

32. The answer must be more nuanced than in the case of smells, where I said that such a class of signs is not capable of being represented in the manner required by Article 2 of the Directive. (51)

33. Where sounds are concerned, the solution does not have to be so categorical. First of all, as I have already stated, (52) oral language is merely communication by sound and writing is its graphical representation. In the abstract, the capacity of sounds to be reproduced in writing is undeniable.

34. It is for the courts of the Member States to determine, in each case, whether the 'drawing' of a specific acoustic sign satisfies the objectives which the Community legislature pursues by means of the requirement for representation. That view is shared by *Shield Mark*, the Netherlands and Italian Governments and the Commission. The Hoge Raad's request that, irrespective of the facts of the case (53) and in the abstract, the Court of Justice should rule on different forms of representation of a sound ignores the nature of the judicial process, the purpose of which is to provide an answer which will be useful to the determination of the dispute. Furthermore, the very nature of that procedure and the absence of expert evidence would make it difficult to rule on questions of a highly technical content.

35. The Court of Justice must therefore remain silent on the capacity to satisfy that requirement of sonograms and spectrograms, and also certain sound and digital recordings, which have no connection with the distinctive signs on which *Shield Mark* relies as against Mr *Kist* in the main proceedings.

36. As the Commission observes, there is nothing to prevent the Court of Justice, without interfering in the facts of the case and for the purposes of the interpretation sought, from providing some general rules about the forms of graphical expression which, proposed by the Hoge Raad in its second question, concern the trade marks relied on in the dispute which it is hearing and the resolution of which prompted the question referred to the Court: the representation by musical notes and the descriptions using written language.

37. Concerning the capacity to be represented graphically, in the universe of messages which are perceived by hearing it is necessary to distinguish two categories, one consisting of sounds capable of being expressed by musical notes and the other consisting of all other sounds.

(a) Musical notation

38. Musical notes are the signs whereby sounds are represented. However, a sequence of such notes, without more, does not identify a melody and distinguish it from others. The repetition in writing of the names of the first nine notes of 'Für Elise' says nothing. It does

not identify the sound with the clarity and precision demanded by the requirement for graphical representation.

39. In order to attain that objective, it is essential to reflect the sounds by means of their musical notation, so that they are perfectly recognisable and leave no room for doubt. And there is only one way of doing that: by setting them out on a musical stave. With that universal language, the diffused drawing consisting of the sequence of notes, called by name, seems to be clear, with its precise contours to identify it, differentiating it from others. The notes written on the stave, together with the key, which determines the tonality, the time signature, which determines the rhythm, and the relative value of each note, and also an indication of the instruments which are to interpret them, are a faithful ‘photograph’ of the sequence of sounds which are represented; if I may say so, they are their ‘fingerprint’.

40. That form of representation of sounds fulfils the requirements indicated by the Court of Justice in Sieckmann. It is clear, precise, self-contained, durable, objective and easily accessible. It is true that it is not intelligible to everyone, but there is no reason to require that perception be immediate. Account being taken of the *raison d’être* of the requirement, it is sufficient that, by means of objective and reliable instruments of interpretation, of execution or reproduction, anyone seeing the entry on the register acquire precise knowledge of the distinctive sign which the owner monopolises.

41. Most persons seeing the sign are not familiar with musical notation, which is the technique intended to enable musical texts to be sung correctly, but when the score is read by an expert the uninformed are able to understand the sound sign without risk of confusion as to its identity. (54)

(b) The descriptions of the sounds

42. In order to be registered as a trade mark, a sign must therefore be capable of being represented graphically; ‘describe’ is not the same as ‘represent’, which evokes the idea of ‘reproduction’.

43. Any description of a sound suffers from vagueness and lacks clarity and precision. (55) I have already stated that, as regards musical notes, to state that the trade mark consists of a specific sequence (for example: ‘E, D#, E, D#, E, B, D, C, A’) is meaningless.

44. The position is even less certain if the description constitutes an onomatopoeia. That is illustrated by the case before the national court. In the official languages of the European Union, the written reproduction of the sounds which imitate a cockcrow is in reality varied and diverse. (56) It would be difficult for the average British, Spanish, Portuguese or Italian citizen to realise that kukeleku represents a cockcrow. However, there may be circumstances in which that form of graphical representation would be sufficiently expressive and satisfy the purpose of the provision. That is a matter to be determined by the national courts in each case. (57)

45. A description by written language of a sound, like that of a smell, and in general of non-figurative signs, is

burdened with subjectivity and relativity, which is inimical to precision and clarity. (58)

46. I can see no other way of describing with words a sound sign or a sequence of signs, unless, in the case of a musical composition, there is a reference to its title, to the composer or to any other factor allowing it to be identified. However, this ‘drawing’ implies, as the United Kingdom Government observes in its written observations, a certain familiarity, a prior knowledge of the sign, a situation which is not admissible in a system such as that of the Directive, where ownership of a trade mark is acquired by registration and not by use. (59)

47. On the basis of the foregoing reasoning, I propose that the answer to the second question referred by the Hoge Raad be:

- the graphical representation of sound marks must be clear, precise, self-contained, easily accessible, intelligible, durable and objective;
- it is for the competent national court to determine in each case, on the basis of the relevant facts, whether such requirements are satisfied;
- generally, such conditions are satisfied by representation on a musical stave;
- on the other hand, descriptions using the written language, including onomatopoeia and a word sequence of musical notes, are generally insufficient.

C. A final brief digression

48. In preliminary ruling proceedings, the Court of Justice must provide the court of referral with the appropriate answer according to the parameters imposed by the law. The facts of the main proceedings place the question in its context and make its impact easier to understand, so that the solution, given in general terms owing to its role in arriving at a uniform interpretation, may prove most useful to the resolution of the dispute before the national court.

49. In a case such as the present, in order to carry out its interpretative task, the Court of Justice only needs to know that some of the trade marks at issue before the Hoge Raad are distinctive acoustic sounds. However, it must not be overlooked that the sound signs which Shield Mark claims as being in its exclusive ownership are a cockcrow and the first notes of what is perhaps the best-known piece for piano in the history of music, a work by one of the great composers, whose genius was quickly recognised by the other composers of his day, (60) although Beethoven himself always regarded Handel as the greatest. (61)

50. Registration of a trade mark confers a monopoly on its owner, so that, in principle and as a general rule, he is able to prevent its use by others. In my Opinion in Arsenal, (62) I stated that any extension of the catalogue of signs capable of constituting this form of industrial property must be accompanied by a precise delimitation of the rights which registration confers on the owner. (63) The time seems to have come to add that particular care must also be exercised when a person is granted the exclusive use on the market of a sign, whatever sense it is perceived by.

51. Two points must be made. First, there are considerations of public interest that militate in favour of limiting the registrability of certain signs to enable them to be freely used by all traders. The theory of the need to keep certain signs available has been evaluated by the Court of Justice in its judgments in *Windsurfing Chiemsee* (64) and *Philips*. (65) I find it difficult to accept that individuals may, by means of a trade mark, perpetuate exclusive rights in natural indications and signs or those that are a direct manifestation of nature. (66)

52. I find it more difficult to accept, and this is the second refinement, that a creation of the mind, which forms part of the universal cultural heritage, should be appropriated indefinitely by a person to be used on the market in order to distinguish the goods he produces or the services he provides with an exclusivity which not even its author's estate enjoys. (67)

Conclusion

53. In the light of the foregoing reasoning, I propose that the Court of Justice, in answer to the questions referred by the Hoge Raad der Nederlanden, should rule as follows:

(1) Article 2 of Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks not only does not preclude sound signs from being trade marks but also precludes the legal orders of the Member States from precluding that condition a priori.

(2) In order for a sound to be capable of being a trade mark, in addition to being distinctive, must be capable of being represented graphically in a way that is clear, precise, self-contained, easily accessible, intelligible, durable and objective.

(3) It is for the competent national court to determine in each case, on the basis of the relevant facts, whether such requirements are satisfied.

(4) However, those requirements are generally satisfied where the representation takes the form of a musical stave.

(5) On the other hand, descriptions using written language, including onomatopoeia and the word sequence of musical notes, are normally insufficient.

1: - Original language: Spanish.

2: - First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1; 'the trade mark directive' or 'the directive').

3: - Case C-273/00 *Sieckmann* [2002] ECR I-11737, in which I delivered my Opinion on 6 November 2001.

4: - Case C-104/01 *Libertel Groep*, in which Advocate General Léger delivered his Opinion on 12 November 2002.

5: - *Bagatelle in A minor* (WoO 59).

6: - The composer himself gave the piece the subtitle 'Memories of 27 April 1808', the date on which he was invited to a gathering at which he met various children of different ages. His attention was much drawn to a beautiful girl, called Elise, who, upon being informed

who the visitor was, approached him and said that she, too, was an artist, since she could play the piano. Before leaving, Beethoven asked her to demonstrate her abilities and Elise interpreted works by various composers, but, when he suggested that she play one of his sonatas, the girl replied, in some distress, that she could not, because they were very difficult to play. The maestro promised that he would compose a simpler piece so that she would be able to play it on the piano (commentary by K. Groenewolf, cited in the review 'Ángulos', June 1994, p. 29). Other critics, such as A. Reverter (Beethoven, Ed. Península, Barcelona, 1996, 2nd Edition, p. 115), believe that the bagatelle was composed in 1810, as part of a quartet of various pieces under the name not of Elise but of Teresa Malfatti, one of the impossible loves of the musician from Bonn. The change in title was due to an unexplained error by the editor Noht, who published it in 1867. See, to the same effect, W. Kinderman, *Beethoven*, Oxford University Press, Oxford-New York, 1995, p. 146.

7: - Those identified by numbers 517166, 835113, 931683 and 931688, the purpose of which is to distinguish goods and services in classes 35 and 41 (the first trade mark), 9 and 16 (the second) and 16, 41 and 42 (the third and fourth) of the International Trade Mark Nomenclature.

8: - Numbers 535083 and 835115. The first represents services in classes 35 and 41, while the second distinguishes goods in classes 9 and 16.

9: - Trade marks numbers 931687 and 931689, both for classes 16, 41 and 42.

10: - With numbers 839419 (classes 9, 16, 35 and 41), 931684 (classes 16, 41 and 42) and 931686 (classes 16, 41 and 42).

11: - Those registered with numbers 835114 (classes 9, 16, 35 and 41) and 931685 (classes 9, 41 and 42).

12: - The onomatopoeia of a cockcrow in the various official languages of the European Union is as follows: kikiriki, in German; kikeli-ki in Danish; quiquiriquí, in Spanish; kukkokiekuu, in Finnish; cocorico, in French; kokoriko, in Greek; cock-a-doodle-doo, in English; chichirichi, in Italian; kukeleku, in Dutch; cocorocócó, in Portuguese; and kukeliku, in Swedish.

13: - Number 931682, for products in class 9 and services in classes 41 and 42.

14: - The first nine notes of 'Für Elise' are heard when its telephone rings and when news sheets are taken from the stands in bookshops and kiosks. It also offers a computer program which, when activated, reproduces the sound of a cockcrow.

15: - W. Benzov, *Beethoven's Anvil, Music in Mind and Culture*, Ed. Basic books, New York, 2001, p. XI et seq., contains a fascinating study of the idea that music connects the human being with the social world.

16: - See point 21 et seq.

17: - Point 28 of my Opinion of 24 October 2002 in Joined Cases C-53/01 to C-55/01 *Linde and Others*, in which judgment has not yet been delivered.

18: - See paragraph 42 and the first paragraph of the operative part.

- 19: - M. Proust, *À la recherche du temps perdu*, La prisonnière, Ed. Gallimard, La Pléiade, Paris, 1988, Vol. III, pp. 762 and 763.
- 20: - A. Schopenhauer, *Le monde comme volonté et comme représentation*, Ed. P.U.F., translated by A. Burdeau (1888), revised and corrected by R. Roos, Paris, 1966, p. 340.
- 21: - A. Henry, Marcel Proust, *Théories pour une esthétique*, Ed. Klincksieck, Paris, 1981, p. 303.
- 22: - J.J. Nattiez, *Proust musicien*, Ed. Christian Bourgois, Paris, 1975, p. 162.
- 23: - J.J. Nattiez, *ibid.*, p. 121.
- 24: - The French and Netherlands Governments, and also Shield Mark, stated in their written observations that in the joint statements made by the Council and the Commission on the occasion of the adoption of the Directive on trade marks (Declaration 9142/88) and the Regulation on the Community trade mark (Council Regulation (EC) No 40/94 of 20 December 1993 (OJ 1994 L 11, p. 1) (Declaration 5865/88), acknowledged that sounds are signs capable of constituting that form of intangible property. The claimant in the main proceedings also states that, in the debates of the European Parliament corresponding to the Sitting of 24 October 1988, it was confirmed that that Regulation would not prevent acoustic messages from constituting trade marks.
- 25: - In reality, it does mention sound messages. When it refers to ‘words’, it is referring to a sound capable of being represented graphically. The ‘word’ is, above all, oral communication. Not insignificantly, the first meaning of that signifier in Spanish is ‘sonido o conjunto de sonidos articulados que expresan una idea’ (Diccionario de la Real Academia de la Lengua). In French, *mot* means, primarily, *chacun des sons ou groupe de sons correspondant à un sens, entre lesquels se distribue le langage* (Le Petit Robert). The same meaning applies in English, where *word* means ‘a sound or combination of sounds forming a meaningful element of speech’ (The Concise Oxford Dictionary). In German, *wort* is ‘kleinste selbständige sprachliche Einheit von Lautung und Inhalt beziehungsweise Bedeutung’ (Duden, Deutsches Universal Wörterbuch).
- 26: - See the first and third recitals.
- 27: - See the fourth and fifth recitals.
- 28: - ‘... attainment of the objectives at which this approximation of laws is aiming requires that the conditions for obtaining and continuing to hold a registered trade mark are, in general, identical in all Member States; ... to this end, it is necessary to list examples of 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; ...’ (seventh recital).
- 29: - Article 3(1) of the Gesetz über den Schutz von Marken und sonstigen Kennzeichnungen (German Law on the protection of trade marks and other signs) of 25 October 1994 (BGBl. 1994, I, p. 3082).
- 30: - Article 16(2) of the Markenschutzgesetz (Law on the protection of trade marks) of 1970 (BGBl. 260), as amended by Laws BGBl. I 111/1999 and BGBl. I 191/1999.
- 31: - Article 4(2)(b) of Ley 17/2001 de Marcas (Law on Trade Marks), 7 December 2001 (BOE, 8 December 2001, p. 45579).
- 32: - Article 711-1(b) of the Code de la Propriété Intellectuelle, as amended by the Law of 4 January 1991.
- 33: - Article 1(2) of Law 2239/1994 (ÖEK A' 152).
- 34: - Article 16 of the Testo delle disposizioni legislative in materia di marchi registrati (Law on trade marks), approved by Royal Decree 929 of 21 June 1942 (GURI 203, 29 August 1942), as subsequently amended.
- 35: - Article 165 of the Código da Propriedade Industrial.
- 36: - Article 1 of the Benelux Uniform Law on trade marks (Nederlands Traktatenblad 1962, No 58, pp. 11 to 39), as amended, with effect from 1 January 1996, by the Protocol of 2 December 1992 (Nederlands Traktatenblad 1993, No 12, pp. 1 to 12).
- 37: - Article 2(1) of the Varemaerkeloven (Law 162 of 21 February 1997 on trade marks).
- 38: - Article 1(2) of the Tavaramerkkilaki 7/1964 (Law on trade marks).
- 39: - Section 6(2) of the Trade Marks Act 1996.
- 40: - Section 1(1) of the Trade Marks Act 1994.
- 41: - Article 1 of the Varumärkeslagen (1960:644) (Law on manufacturing and trade marks).
- 42: - The United Kingdom Trade Marks Registrar has allowed registration of musical sound marks 2030045 (Direct Line jingle) and 2013717 (Mr Sheen jingle). At the end of 2002, the Office for Harmonisation in the Internal Market had registered nine sound marks.
- 43: - See footnote 50 of my Opinion in Sieckmann. The Spanish Trade Marks Bill, to which that footnote refers, is now Law 17/2000, cited above.
- 44: - See the fourth recital and Article 1.
- 45: - See Article 5 of the Directive. The sixth recital of the Regulation on the Community trade mark clearly expresses that idea: ‘the rights in a Community trade mark may not be obtained otherwise than by registration’. Advocate General Léger, in his Opinion in Libertel Groep, cited above, states that ‘it is the graphical representation of the sign set out in the application for registration that allows an assessment to be carried out of whether all the conditions relating to the acquisition of rights to the trade mark are complied with and that determines the rights and obligations conferred by its registration’ (point 60).
- 46: - Point 36 of my Opinion in Sieckmann, cited above.
- 47: - See point 36 of my Opinion in Sieckmann and paragraph 37 of the judgment in that case.
- 48: - See paragraph 48 et seq. of the judgment in Sieckmann.
- 49: - Point 38, in fine, of my Opinion in Sieckmann.
- 50: - Paragraph 55 of the judgment in Sieckmann.
- 51: - Concerning the difficulties in graphically representing olfactory trade marks, see point 39 et seq. of my Opinion in Sieckmann.

52: - See footnote 25.

53: - It will be recalled that the trade marks in the main proceedings - only some - are sound signs represented by musical notation or a description, or by a sequence of notes, or by an onomatopoeia.

54: - Shield Mark states that the fact that a score cannot be interpreted by someone with no knowledge of music does not prevent that form of graphical representation of sounds from being accepted. It states that word trade marks can be relied on as against the illiterate and that trade marks composed of colours are valid as against the colour blind (see paragraph 39 of its written observations).

55: - In e-filing, which is the system of on-line application for Community trade marks, the Office for Harmonisation in the Internal Market states that it does not accept the graphical representation of a sound mark by a description.

56: - See footnote 12.

57: - The Office for Harmonisation in the Internal Market, by resolution of 7 October 1998 (Case R-1/1998-2), rejected the registration of a sound mark consisting of the sound of a click (*déclic*).

58: - See point 41 of my Opinion in *Sieckmann*.

59: - That is the case of Time Warner, who, in July 2001, registered as a sound mark the ‘Merry Melodies’ jingle, which for 50 years has accompanied the animated cartoons of Hanna & Barbera. Another example is Tarzan's cry, registered as a trade mark, also in the United States of America, by Edgar Rice Burroughs.

60: - A. Orga, *Beethoven*, Ed. Robinbook, translated by Imma Guardia, Barcelona, 2001, p. 24, refers to the admiration of Mendelssohn, Schumann, Liszt and Bizet for Beethoven, and also to that of Wagner, Bruckner, Mahler and Debussy. W. Kinderman, *op. cit.*, p. 1, recognises that no composer occupies such a central position in musical life as Beethoven.

61: - M. Steinitzer, *Beethoven*, Ed. Fondo de Cultura Económico, México, 1953, p. 51, describes how on various occasions Beethoven called Handel the greatest of all the masters of music. See also F. Kerst, *Beethoven, The Man and the Artist as Revealed in his Own Words*, Dover Publications Inc., English translation by Henry Edward Krehbiel, New York, 1964, p. 54.

62: - Case C-206/01 *Arsenal* [2002] ECR I-10273.

63: - See point 61.

64: - Joined Cases C-108/97 and C-109/97 [1999] ECR I-2779.

65: - Case C-299/99 [2002] ECR I-5475.

66: - See point 19 et seq. of my Opinion in *Linde*, cited above.

67: - It will be recalled that, under Article 1(1) of Council Directive 93/98/EEC of 29 October 1993 harmonising the term of protection of copyright and certain related rights, the rights of an author of an artistic work, such as Beethoven's ‘Für Elise’, are to run for the life of the author and for 70 years after his death.

the work itself. Trade marks, on the other hand, do not claim to protect original creations: their purpose is to allow the goods or services offered by undertakings to be distinguished on the market. It may happen, how-

ever, that a sign is an original work protected by copyright at the same time, in which case it is necessary to regulate their reciprocal interrelations. A. Bercovitz has analysed them in his work ‘*Marcas y derecho de autor*’, published in *Revista de Derecho Mercantil*, No 240 (2001), pp. 405-419.
