

**DECISION
of the Fifth Board of Appeal
of 12 March 2021**

In case R 1996/2020-5

Danjaq LLC

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United States of America

Applicant / Appellant

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APPEAL relating to European Union trade mark application No 18 168 977

THE FIFTH BOARD OF APPEAL

composed of V. Melgar (Chairperson and Rapporteur), C. Govers (Member) and
A. Pohlmann (Member)

Registrar: H. Dijkema

gives the following

Decision

Summary of the facts

- 1 By an application filed on 19 December 2019, Danjaq LLC ('the applicant'), sought to register the sound mark that can be retrieved from the link below

<http://euipo.europa.eu/eSearch/#details/trademarks/018168977>

for the following list of goods, as amended on 22 January 2021:

Class 3 - Non-medicated cosmetics and toiletry preparations; non-medicated dentifrices; perfumery, essential oils; bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; body cleaning and beauty care preparations; soaps; perfumery, cologne, eau de toilette and eau de parfum, and deodorants; essential oils; cosmetic preparations for body care, skin care and lip care; make-up and beauty care products; hair lotions, hair care and hair styling products and preparations; styling grease and gel; dentifrices; shower gel; shaving foams, gels, lotions and creams; body lotions, creams, sprays and oils; sun tanning preparations; depilatory preparations; preparations and products for the care and beautification of the nails;

Class 9 - Scientific, research, navigation, surveying, photographic, cinematographic, audiovisual, optical, weighing, measuring, signalling, detecting, testing, inspecting, life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling the distribution or use of electricity; apparatus and instruments for recording, transmitting, reproducing or processing sound, images or data; recorded and downloadable media, computer software, blank digital or analogue recording and storage media; mechanisms for coin-operated apparatus; cash registers, calculating devices; computers and computer peripheral devices; diving suits, divers' masks, ear plugs for divers, nose clips for divers and swimmers, gloves for divers, breathing apparatus for underwater swimming; fire-extinguishing apparatus; computer programs; floppy disks; CD ROMs; laser disks; electronic books; electronic brochures and magazines, electronic comic books and comic strips; electronic booklets, catalogues, newsletters, pamphlets, periodicals and scrapbooks; audio books; audio tapes and tape cassettes; pre-recorded data carrier with movies, films, music and entertainment content; electronic publications (downloadable); downloadable software; computer games; electronic publications; downloadable publications; cinematographic films; electronic games and applications for mobile devices including mobile phones, tablets, laptop computers, PDA and smart watches, and for computers and game consoles; software and hardware to stream audiovisual and multimedia content via the internet and global communication networks; digital media streaming devices; cases, sleeves and pouches, fitted for mobile phones, tablets, laptop computers, media players and PDA; sunglasses, glasses, spectacles and other eyewear; sunglasses frames, spectacle frames; cases, sleeves and pouches fitted for sunglasses, glasses, spectacles and other eyewear; smart watches; sunshades;

Class 14 - Jewellery, precious and semi-precious stones; horological and chronometric instruments; wrist watches; wall clocks; cuff links; key chains as jewellery; ornamental pins (jewellery); statues, figurines and works of art of precious metal; boxes and cases for the aforementioned products;

Class 16 - Paper and cardboard; printed matter; bookbinding material; photographs; stationery and office requisites, except furniture; Adhesives for stationery or household purposes; drawing materials and materials for artists; paintbrushes; instructional and teaching materials; plastic sheets, films and bags for wrapping and packaging; printers' type, printing blocks; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic

materials for packaging (not included in other classes); printers' type; printing blocks; writing instruments; books, brochures, magazines, comic books, periodicals; calendars; posters; postcards; greeting cards; trading cards; diaries; day planners; albums; stickers; decals; bookmarks; giftwrap; paper party bags; paper party decorations; passport sleeves and covers;

Class 18 - Leather and imitations of leather, animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery; luggage and carrying bags; collars, leashes and clothing for animals; boxes and cases of leather or imitation leather; travel bags, travel sets (leather goods); luggage, bags, wallets and other carriers; luggage tags; trunks and suitcases; garment bags for travel purposes; unfitted vanity cases and pouches; toiletry cases sold empty; sport bags, sling bags, shopping bags; backpacks, hand bags, tote bags, business bags; attaché cases, brief cases, business cases; school bags; wallets, change purses, key cases; card wallets and card holders;

Class 21 - Household or kitchen utensils and containers; cookware and tableware, except forks, knives and spoons; combs and sponges; brushes, except paintbrushes; brush-making materials; articles for cleaning purposes; unworked or semi-worked glass, except building glass; glassware, porcelain and earthenware;

Class 25 - Clothing, footwear, headgear;

Class 28 - Games, toys, puzzles and playthings; video game apparatus; gymnastic and sporting articles; decorations for Christmas trees; apparatus for games and controllers therefor; gaming machines; playing and trading cards; games of chance and games of skill; toy action figures; toy vehicles; toy weapons; table and board games; toy telephones; toy model kits; electronic games machines (other than those adapted for use with television receivers only); coin and/or token operated games and amusement apparatus; paper party favors; paper party hats; lottery tickets and scratch cards;

Class 32 - Beers; mineral and aerated waters and other non-alcoholic beverages; fruit beverages and fruit juices; syrups and other preparations for making beverages;

Class 33 - Alcoholic beverages (except beers); alcoholic preparations for making beverages;

Class 34 - Tobacco and tobacco substitutes; cigarettes and cigars; electronic cigarettes and oral vaporizers for smokers; smokers' articles; matches.

- 2 The applicant maintained its request for registration notwithstanding the objections under Article 7(1)(b) EUTMR raised by the examiner on 9 January 2020:
 - In the present case, the goods covered by the sign applied for are partly for everyday consumption and partly specialized goods.
 - In the present case, the sign applied for consists of a piece of music that lasts 25 seconds. Therefore, it is one of the kinds of sound marks that are unlikely to be accepted, without evidence of factual distinctiveness, since it is considered to be too long for it to be easily and instantly memorized as an indication of origin.
- 3 On 25 September 2020, the examiner took a decision ('the contested decision') entirely refusing the trade mark applied for, under Article 7(1)(b) EUTMR. The decision was based on the following main findings:
 - The length of the sign is one factor to be considered and that applies to the present case since it is composed of three different musical segments, as

asserted by the applicant. While this may make the sound more dramatic, it also makes it less memorable, and consumers will not necessarily perceive it as an indication of commercial origin.

- The Office maintains that the assessment of the sound mark complies with the current practice of the Office. Also, the CP11 discussions referred to by the applicant have not been concluded yet, therefore, those cannot directly be applied to the present case.
- With regard to the numerous case-law cited by the applicant, the Office responds as follows:
 - The decision 11/06/2014, R 87/2014-5, KLANG EINER NOTENSEQUENZ (sound mark) defined the sound mark in question as ‘a catchy rhythm of three notes, a jingle’ and positioned already these mere three notes as falling somewhere between the extremely short and very long categories. This is, at least, a strong indication that the rather complex tune in the present sign falls into the category of longer sounds. Overall, a decision concerning a four-second tune is not really comparable to a 25-second tune composing the present sign.
 - 19/09/2019, R 620/2019-4, KLANG EINER TONFOLGE (sound mark): In this decision, similar conclusions can be drawn as regards the sound mark allowed registration, which actually concerned a three-second tune considered by the Board as ‘not too short’.
 - 13/09/2016, T-408/15, SON D'UN JINGLE SONORE PLIM PLIM (sound mark), EU:T:2016:468: As for this judgment, while it did refer to sounds used in the television and broadcasting sector, it nevertheless merely confirmed the decisions refusing registration of the mark applied for, on grounds of lack of sufficient distinctiveness.
 - In this regard, it is noted that in relation to the goods, the applicant merely asserted that those are either commercialized in the entertainment sectors or are typical movie merchandise articles. However, it has failed to prove that a large number of the goods are indeed commercialized as movie merchandise such as, for example, those claimed in Class 3 (cleaning preparations), in Class 21 (household utensils), in Class 32 (alcoholic beverages), or in Class 34 (tobacco). While the sound might be memorable among film enthusiasts, it does not mean that the sound is automatically able to distinguish the goods of one particular undertaking from those of others. In the present case, the Office states that the sound mark in question will not be perceived as an indication of commercial origin of the goods for which protection is sought.
 - 21/01/2010, C-398/08 P, Vorsprung durch Technik, EU:C:2010:29: This judgment concerned a word mark and the issue was essentially about whether it was merely a promotional slogan or it had sufficient originality to it, and also that slogans are not subject to stricter criteria than those applicable to other types of marks. Furthermore, in any event the Office does not consider this case as analogous to the present one concerning a sound mark as the

perception of the relevant public coming across these two types of marks, namely a slogan and a sound, is rather different. Also, it is the current practice of the Office not to consider acquired distinctiveness of a mark when assessing its inherent distinctiveness.

- As regards the applicant’s argument that several sound marks which it considers relevant or similar were accepted in the past, it is recalled that, according to settled case-law, decisions concerning registration of a sign as a European Union trade mark are adopted in the exercise of circumscribed powers and are not a matter of discretion.
- Accordingly, the registrability of a sign as a European Union trade mark must be assessed solely on the basis of the EUTMR, as interpreted by the Union judicature, and not on the basis of previous Office practice (15/09/2005, C-37/03 P, BioID, EU:C:2005:547, § 47; and 09/10/2002, T-36/01, Glass pattern, EU:T:2002:245, § 35). Furthermore, it is clear from the case-law of the Court of Justice that observance of the principle of equal treatment must be reconciled with observance of the principle of legality according to which no person may rely, in support of his claim, on unlawful acts committed in favour of another (27/02/2002, T-106/00, Streamserve, EU:T:2002:43, § 67).
- In addition, each case must be examined on its own merits. It cannot be denied that the examiner’s decision on distinctiveness is inevitably tainted by a certain degree of subjectivity. However, the observance of the principle of equal treatment must be reconciled with the observance of the principle of legality (08/07/2004, T-289/02, Telepharmacy Solutions, EU:T:2004:227, § 59). The mere fact that in other cases a less restrictive approach may have prevailed does not amount to a violation of the principle of non-discrimination, or to a reason for invalidating a decision which per se appears to be reasonable and to conform to the EUTMR, as interpreted by EU judicature.
- With regard to the applicant’s argument that the sound at issue will be recognized by the public, in particular by movie-goers, or that it is widely known and commercially used, for example in Spotify playlists, the Office notes that these may be relevant arguments, if properly demonstrated with respect to the goods applied for, to prove that the sign has acquired distinctiveness through use.
- However, the present examination solely focuses on inherent distinctiveness of the mark with respect to the goods for which protection is sought.

Conclusion

- Based on all the foregoing, the Office maintains that it has not applied stricter criteria in the assessment of the present sign than those applicable to other types of marks; rather, it took into account that the perception of the relevant

public is not necessarily the same in the case of a sign consisting of a sound per se as it is in the case of a word or figurative mark.

- Furthermore, the Office has examined the case-law cited by the applicant and found that those are not analogous to the present case.
 - Overall, the sign at issue consists of a structure of musical segments which makes it difficult for consumers to immediately perceive it as an indication of commercial origin of the claimed goods. Also, a significant part of the goods have not been shown to have any link with movies or, in general, the entertainment sector.
 - The Office considers, therefore, that consumer would not perceive the mark as a badge of origin and it cannot function as a trade mark.
- 4 On 15 October 2020, the applicant filed an appeal against the contested decision, requesting that the decision be entirely set aside. The statement of grounds of the appeal was received on 19 January 2021.

Grounds of appeal

- 5 The arguments raised in the statement of grounds may be summarised as follows:

Legal assessment

- The trade mark applied for is distinctive for all the goods applied for. The applicant refers to its previous submissions, including Annexes 1-20.
- The Office applied too strict an approach. A minimum degree of distinctiveness is sufficient for registration (21/01/2010, C-398/08 P, *Vorsprung durch Technik*, EU:C:2010:29, § 39).
- The contested decision is wrong because it is (1) based on an inadmissible analogy to the case-law for shape and colour marks, and thus applied a too strict approach, because it (2) lacks argument to support the apodictic conclusion that 25 seconds were ‘too long’ to be distinctive and memorable, and because it (3) does not take into account that the relevant public is familiar with the famous JAMES BOND theme since decades, including related merchandise, licensed products and co-branded products in all classes of concern.

Standards for inherent distinctiveness of sound marks

- The case-law (13/09/2016, T-408/15, *SON D'UN JINGLE SONORE PLIM PLIM* (sound mark), EU:T:2016:468; 11/06/2014, R 87/2014-5, *KLANGMARKE*; and 16/12/2013, R 2056/2013-4, *KLANGMARKE*) deviate from the EUIPO Guidelines and it is the case-law that is binding upon the Boards of Appeal.

- Secondly, as regards the CP11, it is true that the Program is not yet concluded. However, it is already clear that the actual situation on the European Market and the actual perception of sound marks by the European consumer which is decisive when it comes to the distinctiveness of a trade mark, is already reflected in the drafts of CP11.
- The applicant points out that in CP11 in the section of ‘3.2. Sound marks’, the question is raised, how sound marks are actually perceived by the public: ‘At the beginning of this section, the intention is to establish specific criteria regarding the consumer perception of sound marks. In this public consultation, we are looking to receive any input or feedback in this regard: case-law, studies, statistics and/or articles related to the consumer’s perception of sound marks.’
- The further discussion of CP11 will most likely result in the finding that sound marks are perfectly common trade marks like word or device marks since they are in many sectors common designations of origin, be it the typical ‘jingle’ (EUTM No 18 008 406, Citi Group; telecommunication sector, see EUTM No 17 672 932, BRITISH TELECOMMUNICATIONS; IT sector, see EUTM No 11 051 951 Mac Start up Chime etc.) or a memorable melody of a TV add (e.g. in the sector of food and beverages, see EUTM No 15 899 081, Ehrmann, or EUTM No 6 596 258, Dallmayr Prodomo).
- In June 2020, by the way well in advance of the examiner’s final decision on this subject, the EUIPO published the third draft of the CP11, following two drafting workshops for the CP11 and CP12 Convergence Projects during May 2020. Under ‘3.2.1 Consumer Perception – sound marks’ the current CP11 draft states: ‘Consumers are accustomed to perceiving conventional types of trade marks such as word and figurative marks as indications of commercial origin. However, as sounds are increasingly being used in trade as part of a branding strategy, consumers are also more likely to perceive them as indications of commercial origin.’
- For the sake of analysis of consumer perception, the CP11 grouped sound marks in the following three ways: sounds produced by or connected to the goods or services; notes, combination of notes, tunes or melodies; sounds which are the audible equivalent of verbal elements.
- The only sub-category of sound marks, which may not be easily perceived as trade marks is the first group, i.e. ‘sounds produced by or connected to the goods or services’ since they are related to the goods and services applied for.
- This is e.g. the case for sounds which are produced by the goods when being used like warning signals or ring tones etc. The goods at issue do not make a sound and the applied for trade mark is not a simple ‘sound’ but a sequence of notes and thus, a melody or tune. It belongs to the second sub-category. It has no direct relation to the goods and thus, there is no reason which would make it difficult to perceive the sound mark as badge of commercial origin. Rather, a combination of notes like the one at issue is perfectly capable of

being perceived as designation of commercial origin. No higher threshold is justified in the context of Article 7(1)(b) EUTMR.

- The applicant refers to the judgment 13/09/2016, T-408/15, SON D’UN JINGLE SONORE PLIM PLIM (sound mark). The Court stated that for these goods and services (Classes 9, 16, 38 and 41) sound marks are common and the public is already familiar with sounds as a badge of commercial origin. Thus, at least in these sectors sound marks are like any other ‘traditional’ trade mark and in no way is it more difficult to establish the distinctive character as it was held in relation to shape marks or colour marks.
- The familiarization regarding sound marks and in the entertainment sector and in particular movie themes is also shown by an article of the German Patent and Trade Mark Office published in honour of Sean Connery, who was the first ‘James Bond’ and died on 31 October 2020. In this article, the GPTO somehow ‘as a matter of course’ assumed that the movie theme is already a registered trade mark and referred to the subject application EUTM No 18 168 977.
- The applicant provided the Office with comprehensive material which shows that sounds and music themes are very common designations of origin in the market of movie and cinema productions. (Annex 1-8) listing: the famous MGM lion roar (registered as EUTM No 5 170 113, 8 sec.); the STAR WARS theme (‘war drums’); the STAR TREK theme (‘star trek fanfare’); HARRY POTTER (‘Hedwig’s theme’); MISSION IMPOSSIBLE; JASON BOURNE; GAME OF THRONES; LORD OF THE RINGS.
- The applicant further refers to various other film music themes which are directly related to the movie and thus, the commercial origin of the film (Annex 22): ROCKY; JAWS; PSYCHO; A SPACE ODYSSEY; THE LION KING; BACK TO THE FUTURE; TOP GUN; THE HOBBIT.
- Already the first few notes of all these themes suffice to recognize franchise and commercial origin. Accordingly, many ‘guess the movie theme’ games are available at for instance YouTube. (Annexes 10 and 11).
- Further, main scores of famous movies are not only famous in themselves but subject to independent commercial exploitation (see Annex 9 showing a list ‘50 Best of Movie Themes’ of the streaming service Spotify, comprising inter alia the JAMES BOND score (Pos.2), the HARRY POTTER score (Pos.1) and the MISSION IMPOSSIBLE score (Pos.4)).
- Therefore, in the entertainment sector the relevant public is accustomed to sounds as a designation of commercial origin and perceives such sounds as easily as trade marks as within the conventional trade mark categories of word marks or device marks. There is no room for a higher threshold and in particular the sound must not ‘depart significantly from the norm or customs of the sector’ in order to be distinctive.

- This perception does not only concern the entertainment goods/services as such (Class 41 etc.) but also all related classes. In any case this applies for the claimed goods in Class 9 with relation to the entertainment sector like ‘cinematographic films; pre-recorded data carrier with movies, films, music and entertainment content; electronic books; electronic brochures and magazines, electronic comic books and comic strips; audio books; audio tapes and tape cassettes; electronic publications (downloadable)’ and all other goods in this class.
- It applies also to the game and entertainment related goods in Class 28: ‘games, video game apparatus; apparatus for games and controllers therefor; gaming machines; electronic games machines (other than those adapted for use with television receivers only)’.
- And also all other claimed goods in Classes 3, 9, 14, 16, 18, 21, 25, 28, 32, 33, 34 are typical movie and entertainment merchandise goods (jewelry, clothing etc.) and therefore participate in the public’s perception of sound marks regarding the movie or film series they are related to. There is no difference to more traditional trade marks like JAMES BOND or 007 and the goods covered (see, e.g. EUTM Nos 17 010 984 or 17 001 074).

Length of a distinctive sound mark – how long is ‘too long’?

- It is also unclear how and why the Office arrived at the conclusion that 25 seconds were ‘too long’ to be memorized and thus, render the mark non-distinctive. The contested decision merely reiterates this statement without additional explanation. The allegation that the three segments make the sound ‘more dramatic’ but also ‘less memorable’ is not justified. Following the complete lack of any reasoned statement, the decision must be annulled.
- Again, apart from this formal consideration, the position taken is wrong on substance. Neither the EUTMR nor the EUIPO Guidelines state anything on a specific length.
- The Guidelines only say in Part B, Section 4, Chapter 3, No 14 that the kinds of sound marks that are unlikely to be accepted without evidence of factual distinctiveness include inter alia ‘sounds that are too long to be considered as an indication of origin’.
- It is not defined further, however, what is ‘too long’. In the case-law of the Boards of Appeal it can be found that ‘there are only concerns regarding the inherent distinctiveness in case of whole songs or even Symphonies that practically only professional musicians can remember’ (11/06/2014, R 87/2014-5, KLANG EINER NOTENSEQUENZ (KLANGMARKE) § 27). The applied for sound mark lasts only 25 seconds and therefore is neither a whole song nor a symphony. Compared to these extreme constellations, a sound mark of 25 seconds cannot not per se be excluded from registration because of its length.

- The applicant refers to equivalent trade marks which have already been accepted by the Office: EUTM No 10 114 858, 36 seconds; EUTM No 6 596 258, (approx.) 28 seconds; EUTM No 13 823 539, two verses of a song; EUTM No 8 499 055, (approx.) 20 seconds; EUTM No 11 718 632, 18 seconds; EUTM No 15 922 651, 16 seconds; EUTM No 12 158 531, (approx.) 15 seconds.
- The applied for sound mark of the famous JAMES BOND theme is carefully constructed and made of three interacting parts which, altogether, result in a dramatic and inseparable masterpiece of sound. The 25 seconds of the score comprise three musical parts as follows: it begins with the characteristic trumpet fanfare (seconds 1-5) which catches the listeners attention immediately, then a kind of dangerous and lingering ‘creeping up’ sequence follows (seconds 6-11) and leads to the core part, the famous, loud, fast and strong guitar solo (seconds 12-25). This has a certain dramatic dynamic like a good story and is quite memorizable. All three parts form a distinctive entity.

Reasons

- 6 All references made in this decision should be seen as references to the EUTMR (EU) No 2017/1001 (OJ 2017 L 154, p. 1), codifying Regulation (EC) No 207/2009 as amended, unless specifically stated otherwise in this decision.
- 7 The appeal complies with Articles 66, 67 and Article 68(1) EUTMR. It is admissible. It is also well founded.

Article 7(1)(b) EUTMR

- 8 Under Article 7(1)(b) EUTMR, trade marks which are devoid of any distinctive character must not be registered.
- 9 According to the case-law, the criteria for assessing the distinctive character of sound marks are no different from those applicable to other categories of trade mark (13/09/2016, T-408/15, SON D’UN JINGLE SONORE PLIM (sound mark), EU:T:2016:468, § 41).
- 10 However, when those criteria are applied, account must be taken of the fact that it is not necessarily the same in terms of each of the different categories of trade mark that is perceived by the relevant public and it can therefore prove more difficult to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories (28/06/2004, C-445/02 P, Glass Pattern, EU:C:2004:393, § 23; 13/09/2016, T-408/15, SON D’UN JINGLE SONORE PLIM (sound mark), EU:T:2016:468, § 41).
- 11 In that regard, it must be pointed out that, although the public is used to perceiving word or figurative marks as signs which identify the commercial origin of goods and services, the same is not necessarily true when the sign consists solely of a sound element (13/09/2016, T-408/15, SON D’UN JINGLE SONORE PLIM (sound mark), EU:T:2016:468, § 42).

- 12 It must, however, be held that, as regards certain goods or services, it may not be unusual for the consumer to identify them by means of a sound element. Accordingly, it must, in particular, be held that, in certain economic sectors such as that of television broadcasting, it is not only not unusual, but also even common for the consumer to identify a product or service in that sector as a result of a sound element which makes it possible to distinguish that product or service as coming from a particular undertaking (13/09/2016, T-408/15, SON D'UN JINGLE SONORE PLIM (sound mark), EU:T:2016:468, § 43).
- 13 It is in the light of those considerations that the applicant's arguments that the mark applied for has distinctive character must be examined.

The relevant public

- 14 It must be taken into consideration that the relevant public's perception is not necessarily the same in each of the different categories of trade mark, and it can therefore prove more difficult to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories (28/06/2004, C 445/02 P, Glass Pattern, EU:C:2004:393, § 23; 13/09/2016, T-408/15, SON D'UN JINGLE SONORE PLIM, EU:T:2016:468, § 41). When assessing the distinctive character of the application, account has to be taken of the presumed perception by the public targeted by the goods or services claimed (12/07/2012, C-311/11 P, Wir machen das Besondere einfach, EU:C:2012:460, § 24).
- 15 In the present case, the goods covered by the sign applied for are partly for everyday consumption and partly specialised goods. Consequently, the level of attention is average to higher than average.

The mark applied for

- 16 In the present case the sign applied for is a sound mark. As a pure sound sequence without word elements, the trade mark applied for is linguistically neutral, meaning that account must be taken of the consumers in the European Union in assessing the assessment as a whole.
- 17 The sound mark at stake can be described as comprising three musical parts distinctively 'interacting' with each other, i.e. the characteristic trumpet fanfare (seconds 1-5); a kind of a dangerous and lingering 'creeping up' sequence, slow part (seconds 6-11); followed by a guitar solo (seconds 12-25).
- 18 The contested application represents the first 25 seconds of the musical artwork, entitled the 'James Bond theme', composed by David Arnold.
- 19 According to the applicant, the 'James Bond theme' appears with modifications (either not all the three distinctive parts are present, or/and changed sequence of the three distinguishing parts of the theme, different tempo) in all of the twenty four 'James Bond' movies since its first release in 1962.
- 20 It must firstly be noted that the examiner failed to explain in detail why the sound sequence lacks any distinctive character for the various goods applied for. Instead,

it has made a sweeping assumption regarding the behaviour of the relevant consumers, namely that the mark applied for was too long to be easily and instantly memorised as an indication of origin.

- 21 Such global assessment of the facts of the case was not admissible due to the heterogeneous group of goods and services that also target different consumer circles and serve different purposes.
- 22 In this respect, the Board observes the existence of a lack of reasoning within the meaning of Article 94(1) EUTMR, which constitutes a serious procedural error (19/09/2019, R 620/2019-4, *KLANG EINER TONSEQUENCE* (sound mark), § 23). Therefore, it will order the reimbursement of the appeal fee.
- 23 The applicant in the statement of grounds correctly referred to the case-law (by analogy to slogans), according to which the originality and easy memorable nature of a sign may constitute relevant factors in determining whether a sign is capable of designating the commercial origin of the goods and services in question (21/01/2010, C-398/08 P, *Vorsprung durch Technik*, EU:C:2010:29, § 57, 59). In this judgment, the Court concluded, that the slogan in question, on account of the fact that it exhibited a certain originality and resonance, was memorable.
- 24 Indeed, a sign may be identified as originating from a particular undertaking and thus possess distinctive character where it requires a measure of interpretation on the part of the relevant public and exhibits a certain originality and resonance which makes it easy to remember (21/01/2010, *Vorsprung durch Technik*, C-398/08 P, EU:C:2010:29, § 59).
- 25 Furthermore, with respect to sound marks, it is necessary to have a certain resonance which enables the target consumer to perceive and regard it as a trade mark and not as a functional element or as an indicator without any inherent characteristics. That consumer must thus regard the sound sign as having the ability to identify, in the sense that it will be identifiable as a trade mark (13/09/2016, T-408/15, *SON D'UN JINGLE SONORE PLIM* (sound mark), EU:T:2016:468, § 45).
- 26 As mentioned above (paragraphs 17-19), the sound mark applied for consists of a piece of music comprising three parts which are distinctively 'interacting' with each other.
- 27 There is no doubt as regards the originality of the sound at stake, since it forms part, namely the first 25 seconds, of the existing original work of art, entitled 'James Bond theme'.
- 28 The sound in question also has a resonance. In particular, the sound mark at stake contains a certain melody and three parts which form a dramatic entity and consistent work and is thus, contrary to the contested decision – a recognisable sound. The Board cannot see why consumers should not recognise any indication of origin in the sound at stake.

- 29 Insofar the examiner claimed that the sound is too long to be easily memorised, the Board refers to the case-law, according to which there is no test according to which the originality and memorable nature of a sign (here slogan) are sufficient to establish the distinctive character of a trade mark (by analogy 13/05/2020, T 49/19, CREATE DELIGHTFUL HUMAN ENVIRONMENTS, EU:T:2020:197, § 34).
- 30 It follows that there can be no stricter rules applied as regards the length of sound marks, or even traditional marks, that would render them memorable and distinctive as a result. Indeed, as the applicant noted, a number of longer (than 25 seconds) sound marks have been registered by the Office.
- 31 In contrast, there would be reservations about the assumption of an original distinctive character, firstly, in the case of extremely short, simple sounds, and, secondly, for whole songs or even movements in symphonies, which only a professional musician could possibly remember. The sound sequence applied for lies between these extremes, in the middle as it were. In view of the sound sequence applied for or the perception of consumers, there is no cause for there to be different assessments in relation to the various goods of the application (16/12/2013, R 2056/2013-4, SOUND MARK, § 13, 11/16/2014, R 87/2014-5, SOUND OF A SEQUENCE OF NOTES (sound mark), § 27).
- 32 Eligibility for registration does not require that the consumer memorises the sign exactly and down to the smallest detail. Instead, it is sufficient to be able to trigger a memory effect. If one were to follow the first argument, trade marks that consist of foreign-language words and look more like a jumble of letters to the consumer, or complex signs with different word and figurative elements could never be considered distinctive (19/09/2019, R 620/2019-4, KLANG EINER TONSEQUENCE (sound mark), § 25).
- 33 General life experience shows that sound sequences, for instance of the length of the sound sequence applied for in this case, certainly enable recognition of a wide variety of goods, or can be perceived in (radio) advertising as catchy and memorable. The striking sound sequence applied for in this case can easily be classed as such a sound sequence 19/09/2019, R 620/2019-4, KLANG EINER TONSEQUENCE (sound mark), § 26.
- 34 For sake of clarity, even, if the whole sound sign might not be easily memorised, because of the length of the sign, the Board recalls that consumers generally take more note of the beginning of a sign than of its end (16/03/2005, T-112/03, FLEXI AIR, EU:T:2005:102, § 64-65). Therefore, it cannot be excluded that a part of the relevant public may better memorise only the first part of the sign, e.g. the characteristic trumpet fanfare, which in the Board's view, is not devoid of distinctive character.
- 35 It follows that the sound sign at stake is capable of engendering in the target consumer a certain form of attention which would enable him/her to perceive that sign's necessary identifying function (13/09/2016, T-408/15, SON D'UN JINGLE SONORE PLIM (sound mark), EU:T:2016:468, § 46).

- 36 Furthermore, it should also be pointed out that the sound sign at stake, is also capable of indicating the commercial origin of the goods for which registration is sought.
- 37 This is because the ‘James Bond theme’ which according to the applicant appears (although in slightly modified versions) in all the James Bond movies, is, along with the elements ‘007’ and ‘James Bond’ an indicator of a commercial and not only artistic origin, i.e. showing that its commercial origin is the company producing the films in the ‘James Bond’ series (30/06/2009, T-435/05, Dr. NO, EU:T:2009:226, § 25).
- 38 Therefore, in case of the goods of the application in Classes 3, 9, 14, 16, 18, 21, 25, 28, 32, 33 and 34, which, according to the applicant are the typical merchandising items, there is no doubt as to fact that the sound at stake is used as a trade mark.
- 39 It follows that the sign applied for is distinctive in respect of the goods applied for.
- 40 For the above reasons, the contested decision must be annulled and the contested EUTM application No 18 168 977 proceeds to registration for all the goods applied for.
- 41 Considering the substantial procedural error, as indicated in paragraphs 20-22, the Board in accordance with Article 33(d) EUTMDR orders the reimbursement of the appeal fee.

Order

On those grounds,

THE BOARD

hereby:

- 1. Annuls the contested decision**
- 2. Orders the reimbursement of the appeal fee.**

Signed

V. Melgar

Signed

C. Govers

Signed

A. Pohlmann

Registrar:

Signed

H.Dijkema

