



**International Trademark Association**

1133 Avenue of the Americas, New York, NY 10036-6710 USA

Telephone: 212-768-9887 Fax: 212-768-7796

November 1, 2001

SHIELD MARK B.V.  
AMSTERDAM

To the attention of Mr. T. Cohen Jehoram  
De Brauw, Linklaters & Alliance  
The Hague

Re: Shield Mark B.V. v. J. Kist; reference by the Dutch Supreme Court to the  
European Court of Justice; decision of 13 July 2001

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Dear Sir or Madam:

The International Trademark Association (INTA) has prepared this letter for the purpose of assisting the European Court of Justice (ECJ) in reviewing Article 234 referenced by the Dutch Supreme Court in the proceedings of the Shield Mark B.V. v. J. Kist case. INTA is commenting below on the first question put by the Supreme Court of the Netherlands: Does article 2 of the Trademarks Harmonization Directive ("the Directive") oppose the registration of sound marks as such and if not, does in article 2 exist the possibility of considering a sound as a trademark.

INTA did not attempt to intervene directly before the ECJ because of the procedural difficulties associated with joinder to the national proceedings. Therefore, INTA would be grateful if Shield Mark would file this letter before the ECJ.

## The International Trademark Association

The International Trademark Association is a 123 year-old not-for-profit organization of trademark owners and practitioners from 145 nations throughout the world. INTA is dedicated to the support and advancement of trademarks and related intellectual property concepts as essential elements of commerce. Its current membership of over 4000 trademark owners and practitioners crosses all industry lines, including manufacturers and retailers, in industries ranging from aerospace to consumer goods. INTA's membership includes close to 700 trademark owners and practitioners from European Union countries.

An important objective of the International Trademark Association is to protect the interests of the public in the proper use of trademarks. In this regard, INTA strives to advance the development of trademark and unfair competition laws and treaties throughout the world, based on the universal public interest in avoiding deception and confusion. INTA has been an official non-governmental observer to the World Intellectual Property Organization ("WIPO") since 1979, and actively participates in all trademark related WIPO proposals. INTA has influenced WIPO trademark initiatives such as the Madrid Protocol and is active in other international arenas including the Asia Pacific Economic Cooperation Forum (APEC), the Association of Southeast Asia Nations (ASEAN), the European Union and the World Trade Organization (WTO). INTA's membership is varied and extensive: it is a balanced and reliable representative body. INTA's international character brings a global approach to the issues at stake in this case.

Since 1916, INTA has acted in the capacity of advisor and has appeared as *amicus curiae* ("friend of the court") in the US<sup>1</sup> and in other jurisdictions<sup>2</sup>. INTA presents

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<sup>1</sup> INTA has filed the following amicus briefs before the United States Supreme Court and other Federal Courts: *Playboy Enterprises Inc. v. Netscape Communications Corporation* S.Ct. Case No 00-56648 and *Playboy Enterprises Inc. v. Excite Inc.* S.Ct. Case No 00-56662; *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, S.Ct. Case No. 99-1571 ; *Major League Baseball Players Association v. Cartoons, L.C.*, S.Ct. Case No. 00-39; *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, S.Ct. Case No. 99-150 (March 22, 2000); *College Sav. Bank v. Florida*

itself as a “friend of the court” in this matter. It is not a party in the instant case, but believes this case is significant to the international development of trademark law.

INTA respectfully submits this letter in the hope that it may assist the Court in reaching a decision that is in the public interest.

### The Shield Mark Case

INTA’s purpose in filing this letter is to suggest that a sound, under appropriate circumstances, can have the capacity to function as a trademark. Whether or not a sound has this capacity is a question of fact in each case, but it is inconsistent with fundamental principles of trademark law to deny protection to a sound trademark merely because it is such.

It is evident that trademark owners, including members of INTA, will be directly affected by the judgment of the ECJ on the questions referred to it under Article 234 of the EC Treaty. The INTA Board of Directors adopted on February 25, 1997 the following resolution with respect to the protection of sounds as trademarks:

*" WHEREAS, the recognition of, and the protection afforded to sound trademarks varies from country to country; and*

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*Prepaid Postsecondary Educ. Expense Bd.*, 119 S. Ct. 2219 (1999); *Dickinson v. Zurko*, 119 S. Ct. 1816 (1999); *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159 (1995); *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992); *K Mart Corp. v. Cartier, Inc.*, 486 U.S. 281 (1988); *WarnerVision Entertainment Inc. v. Empire of Carolina, Inc.*, 101 F.3d 259 (2d Cir. 1996); *Conopco, Inc. v. May Dep’t Stores Co.*, 46 F.3d 1556 (Fed. Cir. 1994); *Ralston Purina Co. v. On-Cor Frozen Foods, Inc.*, 746 F.2d 801 (Fed. Cir. 1984); *Anti-Monopoly, Inc. v. General Mills Fun Group, Inc.*, 684 F.2d 1316 (9<sup>th</sup> Cir. 1982); *Redd v. Shell Oil Co.*, 524 F.2d 1054 (10<sup>th</sup> Cir. 1975); *Century 21 Real Estate Corp. v. Nevada Real Estate Advisory Comm’n*, 448 F. Supp. 1237 (D. Nev. 1978), *aff’d*, 440 U.S. 941 (1979).

<sup>2</sup> Cases outside of the US in which INTA has filed affidavits include: *McDonald’s Corporation v. DAX Properties CC and JoBurgers Drive Inn Restaurants (PTY) Limited, Supreme Court of South Africa (Durban and Coast Local Division)*; and *Heublein Inc. v. Appeals Chamber of Rospatent, Moscow City Court, Russia*; and *Glaxo Welcome Limited v. Dowelhurst Limited and Swingward Limited, European Court of Justice*; and *Ikea Inter-Systems Inc. v. Beijing Cinet co Ltd., Beijing High Court*; and *Libertel v. Benelux Merkenbureau, European Court of Justice*; *Prefel SA v. Fahmi Babra, Indonesian Supreme Court.*

***WHEREAS**, such variation makes protection uncertain while sounds are being more frequently used to distinguish the goods and services of one business from another;*

***BE IT RESOLVED**, that it is the position of the International Trademark Association that sound that is connected with a product or service may serve as a trademark and therefore, in appropriate circumstances, should be entitled to trademark recognition, protection and registration in the same way and subject to the same standards as any other trademark."*

For many years sounds have been registered and protected as trademarks in many jurisdictions (see below). Sounds can be an important element in branding and corporate identification. There is no doubt that sound is used and relied upon by the public. Sounds can help consumers distinguishing a particular service or product from another, for example: jingles that are used in television and radio commercials or in the context of film announcements (like the "roar" of the MGM lion) or television programs (like the chimes of NBC).

Whether a specific sound has the ability to function as a trademark, is a question of fact in each case. This case raises the question of whether or not sounds are protectable as trademarks under article 2 of the Directive, which provides the following:

*A trademark 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.*

Community legislators choose to broadly define the signs that can function as trademarks. Therefore, it is clear that sounds are not excluded from this broad definition.

In many jurisdictions within and outside the European Union it has been decided that a sound can be protected as a trademark. Some national trademark laws, for instance in Germany, France and Italy explicitly use sounds as examples of

trademarks. In Germany, more than 120 sound trademarks are published, mostly in the form of musical notations (jingles by AT & T, by Deutsche Telekom and Nokia).

Other countries such as the United Kingdom where a number of sounds are registered do not mention sound trademarks explicitly in their legislation but accept registration mostly in the form of a musical notation. Examples of British registrations of musical notations are the sound of a barking dog for paints and varnishes used by ICI, a notation for British Telecom's speaking clock and an advertising jingle by Reckitt & Colman.

In Sweden three cases of sound trademark registration are known. The first sound trademark belongs to a Danish company, Hjem-Is Europa A/S, and consists of the melody played by vans selling ice cream. The second trademark is a whistle sound used in the Swedish radio channel P3 and belongs to Sveriges Radio AB and the third mark is an advertising jingle which belongs to the Axfood Sverige AB company.

The Community Trademark Regulation (CTMR) contains in article 4 a definition of trademarks that is identical to the definition in article 2 of the Directive. Until now the Office for Harmonization in the Internal Market (OHIM) accepted sounds as trademarks in a number of cases and therefore as capable of being represented graphically. The Community Trademark (CTM) nr. 143891 consisting of a sonogram of a lion roar, the CTM nr. 1040955 in the name of Nokia consisting of a musical notation and CTM nr. 1772086 in the name of Yahoo also consisting of a musical notation are good examples of Community sound trademarks.

We can conclude from the above that sounds are regarded as trademarks worth of protection and that they are accepted as signs that can be represented graphically.

Also in the United States sound trademarks are accepted under Section 45 of the Lanham Act according to which a mark includes "*any word, name, symbol, or device, or any combination thereof.*" This broad definition can include many forms of symbols including non-traditional trademarks such as colors, smells or sounds as long as they convey a commercial message to the consumer.

The U.S. has long registered audible trademarks, including, the chimes of NBC Network, the sounds of a creaking door for a radio program of the ringing Liberty Bell (of Independence Hall, Philadelphia) (Registration No. 548458) or another series of notes (Eb, Bb, G, C, and F) (Registration No. 928479).

The way in which a sound trademark application is filed in the US is described in the Trademark Manual of Examination Procedure (TMEP) section 1301.02(d), which states that

*“A sound mark identifies and distinguishes services through audio rather than visual means. Examples of sound marks include: (1) a series of tones or musical notes, with or without words, and (2) a word or words accompanied by music.<sup>3</sup> The requirement for a drawing does not apply to sound marks. Trademark Rule 2.51(c), 37 C.F.R. §2.51(c), provides that “The drawing of a mark may be dispensed with in the case of a mark not capable of representation by a drawing, but in any such case the application must contain an adequate description of the mark.”*

It is customary to write on the drawing sheet, *“No drawing; the mark consists of... (describing precisely what the sound is).”<sup>4</sup>*

If the mark comprises music or words set to music, the applicant may also submit the musical score. Audiocassettes may be accepted as specimens for sound trademarks.<sup>5</sup> To demonstrate that the sound mark actually identifies and distinguishes the services and indicates their source, the cassette should contain a sufficient portion of the audio content to indicate the nature of the services.

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<sup>3</sup> For a discussion of the criteria for registration of sound marks, see *In re General Electric Broadcasting Co., Inc.*, 199 USPQ 560 (TTAB 1978).

<sup>4</sup> see: TMEP §807.03(b)

<sup>5</sup> see: 37 C.F.R. §2.58(b).

Accordingly, sound marks are well recognized in the U.S. as long as the sound functions as a trademark.

### Conclusion

The International Trademark Association believes that the requirements for distinctiveness of sounds should be the same as those for other signs. The text of both article 2 of the Trademarks Harmonization Directive and article 4 of the Community Trademark Regulation give a very broad definition of signs that are inherently capable of being protected as a trademark. Nowhere is there any indication that a sign that is not specifically excluded under the definition of article 2 of the Directive should be treated differently than the signs mentioned in this article and INTA urges the court to decide that sounds may be protected as trademarks.

Very truly yours,

Nils Victor Montan  
President