

**DECISION
of the Fifth Board of Appeal
of 20 June 2024**

In Case R 1900/2023-5

Dr. Ing. h.c. F. Porsche Aktiengesellschaft

Porscheplatz 1
70435 Stuttgart
Germany

Applicant/Appellant

represented by UNIT4 IP Rechtsanwälte, Jägerstraße 40, 70174 Stuttgart, Germany

Appeal relating to European Union trade mark application No 18 795 489

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THE FIFTH BOARD OF APPEAL

composed of V. Melgar (Chairperson and Rapporteur), Ph. von Kapff (Member) and R. Ocquet (Member)

Registrar: H. Dijkema

gives the following

Decision

Established Facts

- 1 By an application filed on 18 November 2022, Dr. Ing. h.c. F. Porsche Aktiengesellschaft ('the applicant') sought to register the sound mark

SOUND OF A MOTORGERÄUSCHES

as a European Union trade mark in respect of the following goods and services ('the goods and services that are relevant to the proceedings'):

Class 9: Downloadable computer graphics; Downloadable multimedia files; Virtual reality models; downloadable digital collectors' items, namely automobiles, automobile parts, model vehicles and toy cars; downloadable digital goods, namely automobiles, motor vehicle parts, model vehicles and toy cars; downloadable virtual goods for use online and in virtual environments, namely automobiles, motor vehicle parts, model vehicles and toy cars.

Class 12: Vehicles and parts therefor.

Class 28: Model vehicles; Toy cars.

Class 41: Providing online non-downloadable digital goods, namely automobiles, motor vehicle parts, model vehicles and toy cars for entertainment purposes; Providing virtual online products, not downloadable, for use in virtual environments, namely of motor vehicles, motor vehicle parts, model vehicles and toy cars for entertainment purposes.

- 2 The application was objected to. The applicant maintained its request for registration. In its observations on the objection decision of 2 May 2023, it submitted the following documents:
 - Annex 1: Extract from the register of German trade mark No 302 022 118 770, which proves the registration of the contested trade mark at the German Patent and Trade Mark Office.
 - Annex 2: Extract from the register of German trade mark No 18 424 124, which proves the registration of a further sound mark of the applicant in respect of *vehicles* in Class 12.
 - Annex 3: Article from the magazine Geo of 17 February 2022, <https://www.geo.de/natur/nachhaltigkeit/elektroautos--sound-designer-erschaffen-klaenge-fuer-die-fahrzeuge-31635364.html>.
- 3 By decision of 25 August 2023 ('the contested decision'), the examiner refused the application pursuant to Article 7(1)(b) EUTMR in respect of all the goods and services claimed. The examiner based her decision on the following reasons in particular:

- The goods and services relevant to the proceedings primarily target the average consumer, who is reasonably well informed and reasonably observant and circumspect.
- The trade mark applied for is the reproduction of a motor sound of a vehicle, which comes to rapid acceleration from the distance, and will be shocked if it achieves the desired speed without further increase. It is a sound which, even if it is not realistic, imitates the sound of an internal combustion engine that accelerates the desired speed until it achieves the desired speed.
- The sound in the electronic file provided is simple and short and will not be perceived as a musical composition. Although complexity is not a requirement for the registrability of a trade mark, it must have a minimum degree of distinctive character.
- The sound creates a certain rhyme, because it could be associated with a racing car, for example, or with the emotion of high speeds and increasing performance, but it is not capable of conveying communications content of a trade mark or of indicating a certain commercial origin. The apparatus in the sign applied for may apply to a large number of vehicles or their replicas, models or virtual products or digital goods created in relation thereto, without the relevant consumer perceiving the precise sequence of sounds. It is an sound which, even if it is not realistic, but rather an electronically synthetic sound which imitates an internal combustion engine which accelerates the desired speed until it achieves the desired speed. However, the fundamental dot is not so great as to whether or not the consumer will perceive the sound of an engine, but rather whether this sound will enable the relevant public to distinguish the applicant's goods and services from those of other providers.
- The sound applied for is so basic that, if it is heard, it will have little or no effect on the consumer. Insofar as this sound is even noticed by the relevant public, it will merely associate it with the nature of the goods which reproduce such a sound, such as vehicles, model vehicles or computer programs, graphics -or files relating to vehicles, as well as digital collectors' items.
- Although the fact that the sound is not produced by the vehicles themselves but is an artificially created sound sequence may be known to the consumer, it is not capable of conferring any distinctive character on the sign. Since it is a sound sequence which is very similar to accelerating an engine, no long or complicated interpretation or intermediate mental steps are required.
- The overall effect of the sign therefore remains that of the sound of a bright engine, which is, however, incapable of conveying communications content of a trade mark.
- Without being accustomed to the sound particularly through intensive use on the market, the relevant public will not concentrate on the sound with sufficient attention or even memorise the sound.
- The Office is not bound by prior national registrations. The registrability of a European Union trade mark must be assessed solely on the basis of the relevant European Union rules.

- 4 The applicant filed a notice of appeal on 6 September 2023, which it filed on 21. Grounds of appeal 5 December 2023. It requests that the contested decision be annulled, the contested sign be allowed to proceed to publication and the appeal fee be reimbursed.

Grounds of appeal

- 5 The applicant's arguments in the grounds of appeal may be summarised as follows:
- The sound sequence applied for is memorable and capable, without any further means, of serving as an indication of commercial origin.
 - The arguments of the contested decision are contradictory in that it firstly states that there is no requirement for sound marks to have a 'significant departure from the norm' and then the sign applied for is described as 'not unusual in connection with the goods and services applied for' or as a typical sound for them, since the unusualness required here is merely another expression for deviating from a standard of any kind whatsoever.
 - The sound sequence applied for is not noises which are naturally produced by the goods applied for or in the rendering of the services, but rather a sound sequence specifically comprised as a trade mark and created artificially, which the Office describes as a sound which, even if it is not realistic, imitates the sound of an internal combustion engine'. However, how can something be 'typical' for a product or service if it is not realistic? And how can something at the same time be 'typical' for vehicles on the one hand and downloadable multimedia files on the other, let alone in respect of all the goods and services claimed?
 - For there to be sufficient distinctive character, it is not necessary for the consumer to remember 'the precise sequence of sounds' of the trade mark applied for. In particular, it is not a requirement for distinctive character for the targeted public to recognise 'the precise sound sequence' upon hearing again.
 - The trade mark applied for is immediately and even particularly capable of triggering such an remembered effect, which is even indirectly confirmed by the contested decision ('The sound creates a certain rhyme, because it could be associated with a racing car, for example, or with the emotion of high speeds and increased performance'). A sound mark which evokes such strong emotions and ideas is particularly memorable for the consumer.
 - The sound sequence applied for has nothing to do with the sound of an internal combustion engine. Moreover, according to the Office's own argument, a 'unrealistic' motorcyclist of motorcyclists spoke precisely in favour of and not against distinctive character.
 - The trade mark applied for is also not the sound of another motor. In particular, it is not the sound of an electric motor, as electric motors do not have any operating noise per se. This is known to the relevant average consumer. Rather, the public is aware that car manufacturers use an appropriate sound design for their electric vehicles which reflects the trade mark character and serves precisely to distinguish themselves from other manufacturers. In the case of electric vehicles in particular, the public is

therefore sensitised about the use of sounds as a trade mark and will therefore perceive the trade mark applied for from the outset, particularly in the case of electric vehicles, as what it is: An artificially created sound for imparting identity between the trade marks and distinguishing them from the vehicles of other manufacturers. In other words: An indication of commercial origin. The following evidence is additionally submitted:

- Annex 4: Article from Volvo Car Austria press centre of 17 October 2011 regarding sound design for Volvo electric vehicles. It was already mentioned there more than ten years ago: ‘This new typical sound will be one of the important unique characteristics that make an electric vehicle particularly and unmistakable’.
- Annex 5: Article entitled ‘So entwickeln den Sound elekter Fahrfreude’ [So develops BMW the sound elektronischer Fahrleude] from the website of the car manufacturer BMW. There, the trade mark function of sound design is summarised as follows: ‘Only twelve notes are available, and we have used three of them that form the BMW Sound’.
- Annex 6: Article ‘ID.Sound: Sound of a new mobility’ from the website of the car manufacturer VW. It states the following in relation to the sound design of VW: ‘The sound experience of our ID.models is elaborate, unpenetant and remarkable’.
- Annex 7: Article entitled ‘Sounddesign for electric cars: How sounds the style?’ from the website of the car manufacturer Renault, which succinctly summarises the objective of sound design: ‘The specific sound should not only warn; it should also promise a message: I am electric, I am innovative, I am a Renault’.

Reasons

6 All references to the EUTMR in this decision relate to Regulation (EU) 2017/1001 (OJ 2017 L 154, p. 1), which codifies the amended text of Regulation (EC) No 207/2009, unless expressly stated otherwise.

7 The appeal complies with Articles 66, 67 and Article 68(1) EUTMR. It is admissible.

Evidence filed at the appeal

8 In the grounds of appeal, the applicant submitted the additional evidence referred to in paragraph 5 for the first time before the Board.

9 Pursuant to Article 95(2) EUTMR, the Office may disregard evidence which is not submitted in due time by the party concerned.

10 According to Article 27(4) EUTMDR, the Board of Appeal may only take into account facts or evidence submitted for the first time before it if those facts or evidence meet the following requirements: (a) they are, on the face of it, genuinely relevant to the outcome of the case; and (b) they were not submitted within the time limit for valid reasons, particularly if they merely supplement important facts and evidence which have already

been submitted in good time or were taken or examined by the first instance of its own motion in the decision subject to appeal.

- 11 Applying the above criteria for exercising the discretion under Article 95(2) EUTMR, the Board of Appeal decides to accept the additional evidence submitted for the first time in appeal proceedings.

Article 7(1)(b) EUTMR

- 12 Pursuant to Article 7(1)(b) EUTMR, trade marks which are devoid of any distinctive character shall not be registered.
- 13 For the trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the product or service in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product or service from those of other undertakings (25/09/2002, 316/00-, Grün/Grau, EU:T:2002:225, § 25; 408/15-, SON D'UN Jeds sonore PLIM (marque sonore), EU:T:2016:468, § 37), thus enabling the consumer who acquired them to repeat the experience if it proves to be positive, or to avoid it if it proves to be negative, on the occasion of a subsequent acquisition (05/12/2002, 130/01-, Real People, Real Solutions, EU:T:2002:301, § 18).
- 14 Although, according to the case-law, the criteria for the assessment of distinctive character are the same for different categories of marks, account must be taken, for the purposes of applying those criteria, of the fact that the relevant public's perception is not necessarily the same in relation to each of those categories and it could 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, 408/15-, SON D'UN Jures sonore PLIM (marque sonore), EU:T:2016:468, § 41).
- 15 It is true that the public is accustomed to perceiving word or figurative marks as signs identifying the commercial origin of the goods or services; however, this is not necessarily the case where the sign consists of a simple sound element (-408/15, SON D'UN Jaling sonore PLIM (marque sonore), EU:T:2016:468, § 42; 07/07/2021, T-668/19, SOUND OF A SOUND WHICH IS HEARD WHEN A BEVERAGE CANE IS OPENED, EU:T:2021:420, § 25).
- 16 In the case of sound signs, it is necessary for them to have a certain resonance, by means of which the targeted consumer can recognise it and interpret it as a trade mark — and not merely as a functional component or as an indicator without any intrinsic characteristics. In order to be registered as a trade mark, the targeted consumer must understand a sound sign as an identification of the commercial-origin (408/15, SON D'UN Jceramsonore PLIM (marque sonore), EU:T:2016:468, § 45; 07/07/2021, T-668/19, SOUND OF A SOUND WHICH IS HEARD WHEN A BEVERAGE CANE IS OPENED, EU:T:2021:420, § 24).
- 17 The applicant's argument must be examined in the light of these considerations.

The relevant public

- 18 The distinctive character of a trade mark must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the relevant public's perception of the mark (21/01/2010, 398/08-P, Vorsprung durch Technik, EU:C:2010:29, § 34; 31/05/2016, 301/15-, Du bist, was du erlebst, EU:T:2016:324, § 18; 408/15-, SON D'UN Jeding sonore PLIM (marque sonore), EU:T:2016:468, § 39).
- 19 The goods and services that are the subject of these proceedings in Classes 9, 12, 28 and 41 target both the more general public and specialists, as a result of which the level of attention will be average to above average.
- 20 It should be pointed out in this connection that even for that public that pays greater attention, the absolute grounds for refusal are therefore not to be applied any differently (11/10/2011, T-87/10, Pipeline, EU:T:2011:582, § 27-28). The level of attention paid by the relevant public cannot have a decisive influence on the legal criteria used to assess whether a sign is descriptive or devoid of distinctive character (02/12/2020, T-26/20, FOREX, EU:T:2020:583, § 39; 07/05/2019, T-423/18, vita, EU:T:2019:291, § 14).
- 21 As the present case concerns a pure sound sequence without text components, specific linguistic knowledge of consumers in the European Union is irrelevant. There are no other indications that the sign applied for will be perceived differently within the European Union. The assessment of distinctive character must therefore be based on all consumers within the European Union.

Lack of distinctive character

- 22 The sign applied for is a sound sign of a total of 16 seconds, even though the first four seconds are phoneless, followed by an electronically generated, intensified barrel-reinforcing sound sequence, with the last three seconds in turn being practically meaningless.
- 23 Accordingly, the statements made in the contested decision must be agreed with in that the sound sign applied for depicts the effect of accelerating or increased performance.
- 24 With regard to the goods and services applied for in Classes 9, 12, 28 and 41, which are all connected with *motor vehicles, motor vehicle parts, model vehicles and toy cars* or explicitly relate thereto, the sound sequence applied for represents a typical feature of these vehicles or cars, namely their acceleration or increased performance until the desired travel speed is reached.
- 25 Overall, the sign applied for is simple and banal and will be perceived by the relevant public as a mere function of the goods and services claimed, specifically with regard to the angular character or ability of the vehicles or cars. Therefore, in the light of the case-law cited in paragraph 16, it has no resonance or recognition value that would enable the targeted consumers to regard it as an indication of origin and not merely as a functional element or as a reference without a statement.
- 26 Accordingly, when confronted with the sign applied for in connection with the goods and services in Classes 9, 12, 28 and 41, the relevant public will at most assume that the sound

refers to the aspect of acceleration or increase in performance of the vehicles and cars, which is why the sign is devoid of distinctive character within the meaning of Article 7(1)(b) EUTMR in respect of all the goods and services applied for.

- 27 The applicant's statements are incapable of calling this finding into question.
- 28 The applicant explains that the sound mark represents a specifically artificially produced composition. The sound design applied for is intended to reflect the trade mark character and serve to distinguish itself from other manufacturers in the sector.
- 29 This must firstly be countered by the fact that the applicant's intentions of using the specifically composed sound sequence as an indication of origin does not mean that it is actually distinctive within the meaning of Article 7(1)(b) EUTMR.
- 30 Secondly, it must be found that the sound sequence applied for does not constitute a memorable sound which is completely independent of the goods and services and is devoid of any connection. It is a progressive intensifying electronic sound which, in connection with vehicles and cars, to which the goods and services applied for expressly refer, will immediately be perceived as a acceleration or increased performance.
- 31 It must therefore be found that, even if — as also argued by the applicant by submitting exhibits 3 to 7 — the public is aware of the use of sounds as a trade mark in the field of electric vehicles, the sound mark that is specifically under discussion is devoid of distinctive character on the basis of the reasons given.
- 32 It should also be noted that Annexes 3 to 7 clearly show that the creation of audio signals in the case of electric vehicles primarily serves for safety in the trade, especially since these electric vehicles are very light.
- 33 The applicant's further argument that the sound sequence was futuristic, melodious and had a certain Tempo and also a dynamism which could be represented as follows: *It is not possible to agree with the beginning — style — ascending sounds and height — decreasing level of sounds and sounds — increasing loudness and sounds — uniform dark sound — end.*
- 34 As already established in paragraph 22 above, this is, in principle, a sound sequence that is increasing from zero, gradually in terms of volume, which practically ends at the height peak. The applicant's sketching and detailed analysis illustrated in the preceding paragraph is barely perceptible and will in any case not be registered or remembered by the targeted consumers in this detailed manner. As has already been stated several times, it is a simple acoustic reproduction in Crescendo of an electronic sound sequence which is associated with the idea of accelerating or increasing performance and not with the manufacturer or provider of the goods and services applied for. It is therefore impossible to concur with the internal effect of the sound sequence applied for that was held by the applicant.
- 35 Finally, the applicant's comments regarding the ungiven reproduction of the noise of an internal combustion engine or the soundness of electric vehicles are also not expedient, as the refusal is not based on an alleged reproduction of the sound of an engine, but rather the idea or character of acceleration or performance potential.

Prior registrations

- 36 The applicant referred before the first instance to European Union trade mark No 18 424 124, which was very similar to the present application, and to the identical German trade mark No 302 022 118 770, which means that it would also have to be decided upon in the assessment case.
- 37 With regard to these prior registrations, the Board finds that they are also unable to alter the above conclusions.
- 38 Previous decisions of the Office cannot justify any legitimate expectations (27/11/2018, T-756/17-, wordLaw Group, EU:T:2018:846, § 52) and examination standards can evolve over time.
- 39 Although the Office must, while respecting the principle of equal treatment and sound administration, take into account the decisions already taken in respect of similar applications and consider with especial care whether it should decide in the same way or not, the way in which those principles are applied must be consistent with respect for legality (21/12/2021, 598/20-, Arch Fit, EU:T:2021:922, § 37; 08/07/2020, 696/19-, moins de migraine pour vivre forgerux, EU:T:2020:329, § 36; 24/06/2015, 552/14-, Extra, U: T: 2015: 462, § 27).
- 40 Consequently, a person who files an application for registration of a sign as a European Union trade mark cannot rely, to his advantage and in order to secure an identical decision, on a possibly unlawful act committed to the benefit of someone else (10/03/2011, C-51/10 P, 1000, EU:C:2011:139, § 75-76).
- 41 Moreover, for reasons of legal certainty and, indeed, of sound administration, the examination of any trade mark application must be stringent and comprehensive, in order to prevent trade marks from being improperly registered or annulled. Accordingly, such an examination must be undertaken in each individual case. The registration of a sign as a mark depends on specific criteria, which are applicable in the factual circumstances of the particular case and the purpose of which is to ascertain whether the sign at issue is caught by a ground for refusal (27/11/2018, T-756/17, Word Law Group, EU:T:2018:846, § 46).
- 42 It is also apparent from the case-law that the considerations set out above apply even if the sign for which registration as a European Union trade mark is sought is identical to a prior registration (22/11/2018, T-9/18, Straightahead Banking, EU:T:2018:827, § 31; 23/04/2018, 354/17-, ONCOTYPE DX Genomic PROSTATE Score, EU:T:2018:212, § 49; 09/11/2018, R 1801/2017-G, Easybank, § 65).
- 43 Even if European Union trade mark No 18 424 124 were comparable, it was accepted by a decision at first instance and the Boards did not have the opportunity to assess their eligibility for registration (27/03/2014, T-554/12, Aava Mobile, EU:T:2014:158, § 65, second sentence). The Boards are not bound by decisions of the Examination Division that were not contested. It would be contrary to the competence of the Boards of Appeal laid down in Article 66 to 71 EUTMR for its jurisdiction to be restricted by the requirement to respect the decisions of the first instance adjudicating bodies of the EUIPO (14/09/2022,-498/21, Black Irish, EU:T:2022:543, § 73; 09/11/2016, 290/15-, SMARTER Travel, EU:T:2016:651, § 73).

- 44 In the present case, the Board of Appeal found that, irrespective of the status of prior registrations, the ground for refusal under Article 7(1)(b) EUTMR is precluded by the ground for refusal under EUTMR with regard to all the contested goods and services, which means that the applicant cannot successfully rely on an earlier decision of the Office to refute this conclusion.
- 45 With regard to the identical German trade mark registration, it must also be added that the European Union trade mark regime is an autonomous system with its own set of rules and pursuing objectives that are reasonable to it, as its application is independent of any national system. Consequently, the possibility of registering a sign as a European Union trade mark must be assessed solely on the basis of the relevant Union rules (06/06/2018, C-32/17 P, PARKWAY (fig.), EU:C:2018:396, § 31; 17/01/2019, T-40/18, SOLIDPOWER, EU:T:2019:18, § 47; 408/15-, SON D'UN Jeds sonore PLIM marque sonore), EU:T:2016:468, § 71). Therefore, the Office and, where appropriate, the Union courts are not bound by a decision of a Member State, and in particular a third country, according to which the same sign may be registered as a national trade mark.
- 46 The Board has taken account of the prior registrations, but comes to the conclusion that, for the reasons stated above, the contested sign cannot be registered as a European Union trade mark in the present case.
- 47 The contested decision is therefore confirmed. The application must be refused in its entirety on the basis of Article 7(1)(b) EUTMR.

Order

On those grounds,

THE BOARD

hereby:

Dismisses the appeal.

Signed

V. Melgar

Signed

Ph. von Kapff

Signed

R. Ocquet

Registrar

Signed

H. Dijkema

