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Title

Let's take a new sip: the sound of a fizzy drink cannot be trade marked, the EU General Court rules

Abstract

This case comment examines the first ruling of the EU General Court on the registration of a sound mark submitted in audio format, in which it was held that the sound of opening a can, followed by a short pause and a fizzing sound, cannot be registered as a trade mark for beverages and their containers. The analysis examines the Court's reasoning and discusses the decision's practical significance.

Legal context

Following the 2015 reform package, EU trade marks no longer need to be graphically represented. Under Article 4 of the Amending Regulation (EU) 2015/2424 an EU trade mark may consist of any signs, in particular words, including personal names, or designs, letters, numerals, colours, the shape of goods or of the packaging of goods, or sounds, provided that such signs are capable of (a) distinguishing the goods or services of one undertaking from those of other undertakings; and (b) being represented on the Register of EU trade marks in a manner that enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor.¹ Recital 9 of the Regulation clarifies that signs must still meet the "Sieckmann" criteria and must thus be represented in clear, precise, self-contained, easily accessible, intelligible, durable and objective manner.² Article 4 of the Regulation implements what the EUIPO calls a "what you see is what get"³ system which aspires to make trade mark entries clearer and enhance legal certainty. It was also hoped that the rate of formality objections, especially in relation to unconventional trade marks such as olfactory, colour and sound marks, would be reduced.

Article 3 of the Trade Mark Implementing Regulation (EU) 2018/626 outlines specific requirements for the representation of some of the most popular types of trade mark in accordance with the specific nature and attributes of the trade mark in question. Its first paragraph specifies that:

"The trade mark shall be represented in any appropriate form using generally available technology, as long as it can be reproduced on the Register in a clear, precise, self-contained, easily accessible, intelligible, durable and objective manner so as to enable the competent authorities and the public to determine with clarity and precision the subject matter of the protection afforded to its proprietor."

¹ Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015 amending Council Regulation (EC) No 207/2009 on the Community trade mark and Commission Regulation (EC) No 2868/95 implementing Council Regulation (EC) No 40/94 on the Community trade mark, and repealing Commission Regulation (EC) No 2869/95 on the fees payable to the Office for Harmonization in the Internal Market (Trade Marks and Designs).

² *Ralf Sieckmann v Deutsches Patent- und Markenamt* (Case C-273/00) ECLI:EU:C:2002:748.

³ EUIPO, Graphical representation: types of mark <<https://euipo.europa.eu/ohimportal/en/elimination-of-graphical-representation-requirement>> accessed 3 September 2021.

A sound mark, in particular, i.e., a trade mark that consists exclusively of a sound or a combination of sounds, can be represented either by an audio file (e.g., MP3) reproducing the sound for which protection is sought or an accurate representation of the same using musical notation.⁴ The abolition of the graphical representation requirement favours sound marks that do not easily lend themselves to being represented in more conventional methods, which are still being accepted, for example representations including a stave divided into bars with a clef, musical notes, rests and accidentals etc. In its first ruling on the registration of a sound mark submitted in audio format, the EU General Court (GC) offered some guidance on the criteria for assessing its distinctiveness and how such a mark is perceived by consumers generally.⁵

Background to the case

In June 2018, the company Ardagh Metal Beverage Holdings GmbH & Co. KG applied for an EUTM at the EUIPO under Regulation (EU) 2017/1001⁶ for the sound produced at the opening of a can of a soft drink. The application was in the form of an audio file and covered a wide variety of beverages (including fizzy and non-carbonated drinks) in Classes 29, 30, 32 and 33 as well as metal containers for storage or transport in Class 6 of the Nice Classification Agreement 1957. The EUIPO rejected the application for registration in January 2019 due to lack of distinctiveness within the meaning of Article 7(1)(b) of the Regulation. In July 2019, the Board of Appeal dismissed the appeal against the EUIPO's decision. Ardagh subsequently appealed to the GC which reached, however, the same conclusion in July 2021.

Analysis

The GC confirmed that the criteria for assessing the distinctiveness of sound marks within the meaning of Article 7(1)(b) are not different from those applying to other types of marks. The consumer of the goods in question must, by mere perception of the sound mark on its own, be able to align it with its commercial origin. The Court recalled its previous judgment in *Globo Comunicação e Participações v EUIPO*,⁷ where it considered the inherent distinctiveness of a sound mark which was graphically represented with musical notation and consisted of the repetition of a sound resembling a ringtone.⁸ The Court recognised that in some sectors, like telecommunications, it was common for the consumer to identify a product or service by an audio element (e.g., a jingle). However, it emphasised that a sound sign characterised by 'excessive simplicity'⁹ (such as, in the *Globo* case, a 'banal combination'¹⁰ of two identical notes) would be incapable of engendering in the addressed consumer "a certain form of attention"¹¹ to enable them to perceive the identifying function of that audio sign. Similarly, the GC stated in *Ardagh* that a sound mark should possess a certain resonance which enables the target consumer to perceive it as a trade mark and not as a functional element or as an indicator without any inherent characteristics.¹²

⁴ Art. 3(3)(g), Commission Implementing Regulation (EU) 2018/626 of 5 March 2018 laying down detailed rules for implementing certain provisions of Regulation (EU) 2017/1001 of the European Parliament and of the Council on the European Union trade mark, and repealing Implementing Regulation (EU) 2017/1431.

⁵ *Ardagh Metal Beverage Holdings GmbH & Co. KG v EUIPO* (Case T-668/19) ECLI:EU:T:2021:420.

⁶ Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark.

⁷ *Globo Comunicação e Participações v EUIPO* (Case T-408/15) ECLI:EU:T:2016:468 at paras. 41 and 45.

⁸ Registration of this mark was sought in a range of classes, including digital recording media (Class 9), television broadcasting services (Class 38) and entertainment services (Class 41).

⁹ *Globo* (Case T-408/15) ECLI:EU:T:2016:468 at para. 51.

¹⁰ *Globo* (Case T-408/15) ECLI:EU:T:2016:468 at para. 46.

¹¹ *Globo* (Case T-408/15) ECLI:EU:T:2016:468 at para. 46.

¹² *Ardagh* (Case T-668/19) ECLI:EU:T:2021:420 at para. 24.

The GC agreed with the EUIPO's assessment that the sound of the applied for mark in *Ardagh* was directly associated with the claimed goods and was inherently connected to their use. The sound of opening a can of drinks and the subsequent pouring is a direct consequence of the act needed to handle cans for their purpose, i.e., to consume a drink. As such, it would not be considered as an indication of commercial origin but would rather be perceived by the relevant public as a purely technical and functional element. Moreover, the sound elements of the mark applied for, taken in its entirety, were not sufficiently prominent to distinguish it from comparable sounds in the drinks sector. The sound of fizzing bubbles is often associated by the relevant public with beverages generally and, in the absence of any other inherent characteristics in the mark applied for, the public would not perceive it as an indication of commercial origin of the goods in question (unless this sound acquires distinctiveness over time through prolonged and intensive use). The two other traits highlighted by the applicant, i.e., a second of silence and nine seconds of a fizzing sound (which the applicant suggested lasted longer than normal), were not unusual, but merely nuances¹³ in relation to the typical sounds that beverages produce when opened. The Court agreed, therefore, with the EUIPO's ruling that the sound mark in this case lacked the distinctiveness required for registration to be achieved.

It is notable that the GC disagreed with some of the EUIPO's application of previous authority, according to which only a mark that departs 'significantly' from the norm or customs of the sector concerned is not devoid of distinctive character.¹⁴ This case law was, however, developed in relation to three-dimensional marks consisting in the shape of the product itself or its packaging where there are norms or customs relating to that shape. The Court rejected the analogy with shape marks because that case law did not introduce any new criteria for assessing the distinctiveness of the mark but only emphasised that the average consumer will not regard the shape of a product that corresponds to the product itself or its packaging as an origin indicator if there are norms or customs for the shape concerned. A sound mark – unlike a three-dimensional mark – is independent of the product's exterior appearance or shape of the goods it designates.¹⁵ This finding arguably leaves some space for the development of a different approach to the registration of sound marks that considers their particularities as advertising instruments.

The Court also refuted the EUIPO's finding that it was unusual in the drinks market to indicate the commercial origin of a product using sounds alone because those goods are generally silent at least until they are consumed.¹⁶ This was, however, immaterial, as most goods are in fact soundless in themselves and only produce a sound when they are consumed.¹⁷ Simply because a sound is heard only on consumption, it does not necessarily follow that the use of sounds to indicate origin would still be uncommon in a specific market. The sound is itself capable of identifying the source responsible for the relevant goods and services.

There errors in the Office's reasoning were not deemed, however, to have a decisive impact on its approach and did not mean its decision should be annulled. The GC concluded that the application had been rightfully rejected and dismissed the appeal.

Practical significance

This was the first time the GC delivered a ruling on a sound mark submitted in audio format (as opposed to a graphical description of the sound using musical notation) since the 2015

¹³ *Ardagh* (Case T-668/19) ECLI:EU:T:2021:420 at para. 45.

¹⁴ *Mag Instrument Inc. v OHIM* (Case C-136/02 P) ECLI:EU:C:2004:592 at para. 31.

¹⁵ *Ardagh* (Case T-668/19) ECLI:EU:T:2021:420 at paras. 30-32.

¹⁶ *Ardagh* (Case T-668/19) ECLI:EU:T:2021:420 at para. 55.

¹⁷ *Ardagh* (Case T-668/19) ECLI:EU:T:2021:420 at para. 56.

reforms. While the ruling is not surprising, the Court provided some helpful guidance on the criteria for assessing the distinctiveness of sound marks and their perception by the general public. Overall, the GC held in *Ardagh* that the sound of a can of beer or soda being opened, and its content being subsequently poured into a glass, might have a certain recognition value, but it is not distinctive enough to point the average consumer to the commercial origin of the goods in question.

The elimination of the graphical representation requirement opened new possibilities for trade mark applicants who are keen to benefit from technological advancements and secure protection for more layered and rhythmically intricate sounds as badges of origin. Brands are also increasingly looking to strengthen their advertising campaigns and cement themselves in consumers' minds through the use of more creative soundbites and other ultramodern audible elements. The liberalisation of the rules regarding non-traditional marks, including sound marks, did not arrive without its challenges. The type of industry as well as the nature of the goods or services involved will continue to play a role when considering the eligibility of sounds as trade marks.

Whilst the outcome in *Ardagh* must have been disappointing for the manufacturer of light metal packaging, applicants in other industries have recently been successful. For instance, the world-leading luxury automobile and motorcycle manufacturer BMW secured EU trade mark registrations by depositing .MP3 files for sounds that presumably represent an electric car starting up (see e.g., EU trade mark filing numbers 018424119 and 018424124 with registration dates of 30 June 2021). Applications of sound marks in audio formats in this sector will arguably fair better because the sound of an all-electric car switching on does not have to sound like a common combustion engine and is unlikely to correspond to foreseeable and typical elements in this market. However, this might not necessarily be the case where the applied for sound mark resembles an electric car accelerating or pulling up: although protection through trade mark registrations might help from a marketing perspective match such sounds with the brand image, it remains to be seen whether marketers' desire for individualisation survives contact with the need for standardisation of some types of sounds to ensure that all electric vehicles (which tend to be quieter than their internal combustion engine-having counterparts) can be readily identified from a safety point of view.

The food and beverages industry, specifically, should however note that where a sound mark is applied for, care should be taken to avoid seeking registration for sounds that could be considered as a purely technical and functional element of the claimed products (e.g., the "pop" of a cork in relation to champagne). The outcome in *Ardagh* suggests that the EUIPO and GC are unlikely to find such an application refreshing.