

Newsletter

IP, TMT and Data Protection Department

The General Court rules on the registration of a sound mark in the food sector

On June 6, 2018, Ardagh Metal Beverage Holdings GmbH & Co. KG ("**Ardagh Beverage**"), a German company that manufactures sustainable and recyclable packaging made of metal and glass, filed a European trademark application before the European Union Intellectual Property Office ("**EUIPO**") to register a sound sign for classes, *inter alia*, 32 and 33 of the Nice Classification, comprising various alcoholic and non-alcoholic beverages, as well as metal containers. To this end, it submitted an audio file reproducing the sound of the opening of a drink can followed by a silence of about one second and a fizzing sound of about nine seconds.

EUIPO rejected the trademark's application as it considered that the trademark could not be deemed as an indicator of the commercial origin of the goods to which it referred and therefore lacked distinctive character.

The second Board of Appeal of the EUIPO had ruled in the same sense. Applying the criteria provided for by law for assessing distinctiveness, the Board of Appeal held that consumers were not "*accustomed to considering a sound as an indication of the commercial origin of unopened packages of beverages and packaged beverages*" and reiterated that, in order to be registered as a trademark, a sound must be capable of being recognized by consumers in such a way as to indicate the commercial origin of the goods or services to which it relates. It added that in this case, the sound of the can opening referred to the use of the goods in question and, therefore, consisted in a functional element of the goods and not an indication of their commercial origin.

Ardagh Beverage appealed to the General Court of the European Union (the "**General Court**") requesting the annulment of the decision of the Board of Appeal of the EUIPO, claiming, *inter alia*, that the assessment of the distinctive character of the trademark was erroneous.

In its judgment of July 7, 2021, the General Court, first of all, noted how the criteria for assessing distinctiveness are the same for all categories of trademarks, since Article 7(1)(b) of EU Regulation 2017/1001 on the European Union trademark does not distinguish between

different categories of trademarks and therefore, the same general criteria apply in relation to a sound mark which reproduces a sound inherent in the goods or their use.

According to the General Court case-law, the sound mark - to be registered - must have a certain resonance that allows the consumer to consider it as a trademark and not as an element of a functional nature, a characteristic that usually occurs for sound trademarks when combined with other verbal or figurative elements.

The criterion used by the Board of Appeal to assess the distinctiveness of the sound mark was erroneous in that the criterion developed by case law in relation to three-dimensional marks, consisting of the appearance of the product itself or its packaging, was used as a reference. According to that case law, for three-dimensional marks consumers will not perceive the three-dimensional mark as an indication of the commercial origin of the goods if its shape is identical or similar to the usual shapes of that product. This interpretation therefore gives importance to the similarity/diversity between the shape of the product claimed as a trademark and the "norm or uses of the sector", that is, the usual shapes of the same categories of products on the market. The perception of consumers can however be influenced by the nature of the sign for which registration has been filed and is not necessarily the same in the case of a three-dimensional trademark, consisting of the appearance of the product itself or of its packaging, as opposed to other trademarks (word, figurative, or - as in the case at stake - sound), which consist of a sign that is independent and separate from the external appearance or the shape of the products on which it is affixed. For these latter marks, therefore, in the opinion of the General Court, the criterion of comparison with the norm and the practices of the sector loses importance, and therefore the comparison between the mark applied for and the external characteristics of the products on the market.

According to the General Court, nevertheless, the sound produced by the opening of a can will be considered, having regard to the type of goods in question, as a purely technical and functional element, given that the opening of a can or bottle is inherent to a specific technical solution in the context of the handling of beverages for the purposes of their consumption, irrespective of whether such products contain carbonic gas or not and therefore, where an element is perceived by the relevant public as fulfilling primarily a functional role, it will not be perceived as an indication of commercial origin and the sound emitted by the can will be considered as a purely technical element (para. 36-40). Nor are the prolonged silence for one second and the sound of bubbling for nine seconds decisive, as they are not sufficiently meaningful to distinguish themselves from comparable sounds in the beverage sector. Such a combination, according to the General Court, therefore, does not allow the relevant public to identify these goods as originating from a particular producer and to distinguish them from those of another company.

The Board of Appeal also erred, according to the General Court, in applying its arguments on the lack of distinctiveness to non-carbonated beverages, also included in the classes of the application for registration.

The errors made by the Board of Appeal, according to the Court, however, were not such as to render its decision erroneous since it was clear from the Board's overall reasoning that it had not relied exclusively on the case law relating to three-dimensional marks and had correctly found that the sound mark was not distinctive. The General Court, therefore, dismissed the action brought by the German company.

The judgment in question has provided an opportunity to define the criteria for evaluating the distinctive character of sound trademarks. In fact, companies nowadays are careful to make

their products identifiable – especially in crowded market sectors - in order to attract the attention of consumers, including through “unusual” trademarks and marketing efforts, as also noted by the General Court in the judgment analysed herewith.

Here the full text of the ruling in Case T-668/19 in Italian.

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