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Sound marks in the European Union: General Court rules for the first time on registration of sound mark submitted in audio format

European Union - [BARDEHLE PAGENBERG Partnerschaft mbB](#)

- **An audio file containing the sound made by the opening of a drinks can, followed by silence and a fizzing sound, cannot be registered as a trademark**
- **A sound mark must have a certain resonance which enables consumers to perceive it as a trademark and not as a functional element or as an indicator without any inherent characteristics**
- **The sound produced by the opening of a can will be considered, having regard to the type of goods, to be a purely technical and functional element**

Introduction

We identify things and persons by the way they look, sound, feel, smell or taste. We also identify goods or services using our five senses, and when such identification refers to the commercial origin of the goods or services, trademarks come into play. Traditionally, trademarks were limited to word marks and device marks, but colours and the shape of goods - although at times listed as “non-traditional” trademarks - were broadly included among the signs that could be protected as trademarks, provided that they were distinctive and not subject to refusal or invalidation based on other grounds of invalidity. In the European Union, it was not possible to trademark a “smell” - irrespective of whether that smell was distinctive or not - due to the absence of any technical means of recording and reproducing smells. Taste marks and touch marks were never tested, but here again the representation requirement seems to present an unsurmountable obstacle, especially for taste marks. As regards touch marks (eg, signs in Braille), their acceptance should not present a major difficulty. As for sounds, the Council of the European Union and the European Commission added the following to the Joint Statements in the minutes of the Council session during which the First Trademark Directive was adopted (on 21 December 1988):

(a) The Council and the Commission consider that Article 2 does not rule out the possibility:

- of registering as a trademark a combination of colours or a single colour;
- of registering sounds as trademarks in the future, provided that they are capable of distinguishing the goods or services of one undertaking from those of other undertakings.

Aside from the curious use of “in the future”, referring perhaps to the actual entry into force of the directive and eventually the Community Trademark Regulation (adopted in December 1993), it was recognised in 1988 that “sounds”, if distinctive, may be registered as trademarks. This is entirely logical when considering that consumers are used to identifying goods and services by sound, as exemplified by the many musical notes and jingles that come to mind, such as those identifying TV stations and programmes.

For the trademark offices in the European Union, the question was not whether sounds could be trademarked, but whether they could be “graphically represented”, as this was a legal requirement until 2016. The Court of Justice of the European Union (CJEU), in the leading case of [Shield Mark v Kist](#) (Case C-283/01), held that musical notations are acceptable, whereas mere descriptions of sounds in words do not satisfy the graphic representation requirement. Thus, the EU trademark office, then called Office for Harmonisation in the Internal Market, now the European Union Intellectual Property Office (EUIPO), did accept quite a number of sound marks represented by standard musical notations, but other means of representation, such as showing a sonogram, were rejected.

In 2015, with the new directive and the amended Trademark Regulation, the requirement of “graphic representation” was replaced by the requirement that the authorities and the public must be able to identify the subject matter of the mark. For sounds, the EUIPO allows musical notations, but also provides for the submission of sound samples. A link to the sound is published on the EUIPO’s website and is thus accessible to all having a device with a sound card. Almost 18 years after *Shield Mark*, the EUIPO database now shows that a total of 415 sound marks have been filed. Many have been refused, but a significant number (262) has been registered.

The *Ardagh* case

Until recently, no sound mark case involving sounds not represented by musical notation had gone beyond the Boards of Appeal of the EUIPO (an example of a musical notation case was the judgment of 13 September 2016 in [Globo Comunicação e Participações S/A](#) (Case T-408/15)). That changed in 2019, when the EUIPO and its Board of Appeal rejected the application for a sound mark (No 17912475) described as “the sound made by a drinks can being opened, followed by a silence of approximately one second and a fizzing sound lasting approximately nine seconds”, applied for various drinks and metal containers for storage or transport.

The applicant, German company Ardagh Metal Beverage Holdings, brought an action for annulment against the EUIPO's decision. That action was dismissed by the General Court in a [judgment dated 7 July 2021](#), and the court, sitting in an enlarged chamber of five judges, chose this first sound mark case as an opportunity to lay down relevant criteria and standards.

Decision

The General Court first reiterated the principles established by the CJEU, namely that all trademarks are examined under the same criteria for distinctiveness - that is, whether they have the capacity to identify the commercial origin of the goods or services. This also applies to sound marks. According to the court, these marks:

must have a certain resonance which enables the target consumer to perceive it as a trademark and not as a functional element or as an indicator without any inherent characteristics. Thus, the consumer of the goods or services in question must, by the simple perception of the sound mark, without its being combined with other elements such as, inter alia, word or figurative elements, or even another mark, be able to associate it with their commercial origin.

The court rejected two of the arguments relied upon by the Board of Appeals to justify the refusal:

- As regards sounds, the case law of the CJEU regarding shape marks consisting of the shape of goods or of their packaging should apply. Therefore, in order to be distinctive, the mark must differ significantly from the norm or custom in the relevant sector.
- Goods have no sound as such, and the sound would only be heard upon the consumption of the goods.

As regards the first argument, the court concluded that there was no basis for applying the case law relating to shapes. As regards the second argument, the court held that most goods are silent in themselves and produce a sound only when they are consumed. Thus, the mere fact that a sound is made only on consumption does not mean that the use of sounds to indicate the commercial origin of a product on a specific market would still be unusual.

The court however confirmed the contested decision by concluding that the sound was not inherently distinctive of the goods. The court first observed that:

the sound produced by the opening of a can will in fact be considered, having regard to the type of goods, to be a purely technical and functional element. The opening of a can or bottle is inherent to a technical solution connected to the handling of drinks in order to consume them and such a sound will therefore not be perceived as an indication of the commercial origin of those goods.

Second, the court concluded that "the relevant public immediately associates the sound of fizzing bubbles with drinks". In addition, according to the court:

the sound elements and the silence of approximately one second, taken as a whole, do not have any inherent characteristic that would make it possible for them to be perceived by that public as being an indication of the commercial origin of the goods. Those elements are not resonant enough to distinguish themselves from comparable sounds in the field of drinks.

Therefore, the court confirmed the EUIPO's findings relating to the lack of distinctive character of the mark applied for.

Comment

The *Ardagh* judgment fits well into the case law of the CJEU and the General Court on distinctiveness, and the finding that the criteria applied to sound marks do not differ from those applied to other types of mark should be welcomed. It is also good news that the General Court rejected the analogy with shape marks whose distinctiveness depends on being significantly different from the norms or customs in the sector. There is also no mention - and correctly so - of the "depletion" theory applied to colour trademarks. Sounds are not "depletable". The "resonance" theory, however, taken from the earlier 2016 judgment involving a simple sound represented by musical notation, seems somewhat of an aberration. What appears to be correct is that the sound itself - whether individualised notes (eg, the NBC chimes) or a coherent (non-musical) whole (eg, the famous roar of the MGM lion) are, as such and without more, capable of identifying the source of goods or services. The fact that most goods (and services) are themselves "silent" is totally irrelevant, as long as the sound for which trademark protection is sought is capable of identifying the undertaking responsible for their production or marketing.

Arguably, it seems obvious that the sound made by the opening of a can of carbonised drinks is not a trademark - in any event, not for beverages or their containers. However, the fact that Ardagh brought the issue before the General Court should be welcomed.

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