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# General Court rules on registrability of sound mark submitted as audio file for first time

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On 7 July 2021 the General Court upheld the decision of the Second Board of Appeal (BoA) of the European Union Intellectual Property Office (EUIPO), declaring that the sound of a drinks can that is opened, followed by a short silence and a fizzing sound, cannot be registered as an EU trademark (EUTM) because of lack of distinctiveness.<sup>(1)</sup>

## Facts

On 6 June 2018 a manufacturer of glass and metal packaging sought to register a sound trademark submitted in an audio format for metal containers for storage and transport, as well as for various carbonated and non-carbonated beverages. The sound sequence applied for consisted of the sound that occurs when a drinks can tab is pressed in, followed by about one second of silence and a fizzing sound that lasted for approximately nine seconds.

## EUIPO

Both the examiner of the EUIPO and the BoA dismissed the application for lack of distinctiveness. The applicant filed an action against the decision of the BoA in respect to carbonated and non-carbonated beverages.

## General Court

The General Court confirmed the BoA's decision that the sound mark at issue lacked distinctiveness. Referencing its *Sound mark* decision,<sup>(2)</sup> the General Court confirmed that sound marks must have a certain resonance, enabling the addressed consumer to perceive it as a trademark and not as a functional component or an indicator of intrinsic characteristics. According to the General Court, the average consumer must be able to deduce the commercial origin of a product through the mere perception of the sound, without it being combined with other elements such as words, images or even another trademark.

The General Court confirmed that the submitted sound did not meet these criteria. It found that the sound of a drinks can being opened would be perceived by the average consumer as a purely technical and functional element that is inherent to the technical solution for the purpose of its use. Similarly, the fizzing sound of bubbles is also directly linked to drinks. The fact that the fizzing sound lasted longer than normal and did not start immediately after the opening of the can did not confer any distinctive character on the sound mark as the average consumer would be unable to associate the sound with the commercial origin of the product at issue.

The General Court rejected, however, the BoA's view that the criteria for the assessment of distinctiveness for sound marks is the same as for 3D marks. Based on the case law relating to 3D marks, the BoA had held that a sound mark has distinctive character only if it differs "significantly" from the norm or custom in the industry concerned. The General Court pointed out that this case law is based on the consideration that the average consumer will not regard a shape of a product that corresponds to the product itself or its packaging as an indication of origin if there are norms or customs for the shape concerned. Thus, the closer the shape of the mark corresponds to the shape of the product itself or the packaging in which it normally appears, the more likely it is that the mark will lack distinctive character. A sound mark – unlike a 3D mark – is independent of the shape of the product concerned or its packaging. Therefore, the criteria developed for 3D marks do not apply to sound marks.

According to the General Court, the fact that the sound submitted for trademark protection could be heard by the consumer only after the purchase of the drinks can – namely, when the drinks can was opened – was not relevant (the EUIPO took the opposite view). The General Court observed that most products are silent until they are consumed.

Despite the fact that the General Court refuted the view of the EUIPO regarding the criteria applicable for the assessment of distinctiveness relating to a sound mark, its decision was upheld because the General Court shared the EUIPO's view that the submitted sound mark lacked distinctiveness.

## Comment

This first decision of the General Court on sound marks submitted in an audio format gives helpful guidelines for assessing the requirements regarding distinctiveness that sound marks have to meet in order to be registrable. The key element is the perception of the sound by the relevant consumers. In view of the fact that, according to the GC, a sound mark must be able to convey the commercial origin of the goods on its own without the support of word elements, images or other trademarks, it seems rather difficult to overcome the hurdle of distinctiveness.

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## Endnotes

(1) T-668/19.

