

**Non-conventional trademarks: two recent European rulings of great interest**  
**(Guerlain and Ardagh Metall Beverage Holdings)**

In the legitimate attempt by companies to distinguish their products from those of their competitors, for some time now companies have been investing in new branding techniques that go far beyond word trademarks. As a result, trademark law has seen an expansion of the types of signs that can constitute a trademark on their own: colours, shapes, textures, smells, etc.

However, the protection of such less conventional signs has always been controversial, and it has been questioned whether they can perform the most basic and essential function of a trademark: identifying goods or services<sup>1</sup>. For this reason, case law has been mostly reluctant to recognise the distinctive character of this type of signs.

In this briefing note we will proceed to analyse two recent judgments of the General Court in relation to this controversial issue and its implications for the future of trademark law.

**Guerlain Rouge G Lipstick**

Can the shape of a lipstick alone indicate the business origin of the product? Yes, according to the recent decision of the General Court of the European Union (Case **T-488/20** of 14 July).




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<sup>1</sup> Ghidini, Gustavo. The protection (three-dimensional) shape trademarks and its implications for the protection of competition. En I. CALBOLI y M. SENFTLEBEN (Ed.), *The Protection of Non-Traditional Marks, Critical Perspective*. Nueva York: Oxford University Press.

## Background

In 2018, Guerlain, part of the LVMH group, applied to the European Union Intellectual Property Office (EUIPO) for registration of the three-dimensional sign for goods in class 3 of the International Classification of Goods and Services "Lipstick":



Both the EUIPO and its Board of Appeal rejected the registration of the shape of the lipstick on the grounds that the three-dimensional shape in question does not deviate significantly from the usual shapes on the market and is therefore devoid of distinctive character within the meaning of Article 7(3) of Regulation 2017/1001. According to the First Board of Appeal, all the sticks are cylindrical in shape and consumers are used to oval-shaped packaging. In that regard, the Board of Appeal reproduced the following images:



Guerlain filed an appeal in September 2020 against the EUIPO's refusal to protect the shape of the beauty product on the grounds that the lipstick's 'boat hull' appearance does have a differential value compared to the rest, deserving to be registered as a trademark.

### Decision

The General Court notes that the concept of 'distinctiveness' (understood as an indicator of the commercial origin of goods within the meaning of Article 7(1)(b) of Regulation 2017/1001) differs from 'novelty' and 'originality'. The fact that the applicant's shape was described by the press and industry experts as 'revolutionary' is irrelevant for the purposes of assessing its distinctiveness. The relevant criterion taken into account by case law is that the shape of the product differs significantly from the usual customs and norms of the sector (in this case, cosmetics), so that it fulfils the function of distinctiveness.

In relation to the aesthetic appearance or achieved beauty of the packaging, an argument that was upheld by Guerlain, the Board clarifies that the aesthetic appearance may have an impact on the distinctiveness of a product compared to that of other companies, if aesthetic appearance is understood as referring to the objective and unusual visual effect produced by the specific design in the eyes of the relevant public. The fact that goods are well designed does not necessarily imply that a mark consisting of a three-dimensional shape has such a distinctive character or function.

Finally, the Court reviews the part of the EUIPO decision relating to the "norms and customs of the sector", taking the view that the norms and customs of the sector cannot be reduced to the single most statistically widespread shape, i.e. in the case of lipsticks, the cylindrical shape, but must include all shapes that the consumer is used to seeing on the market. With this criterion in hand, it concludes that the shape of Guerlain's Rouge G is unusual for a lipstick and differs from any other shape on the market, recalling the shape of a boat hull or a baby carriage, so that the relevant public will be surprised by an easily remembered and significantly divergent shape, which leads them to associate the shape with a Guerlain product.

### Commentary

In the difficult balance between not granting an exorbitant □ monopoly on a shape indefinitely to a company (since industrial designs would normally cover this need to stimulate the aesthetic innovation of business products) and recognising the distinctiveness of the shape, as an indicator of the origin of the product (Guerlain), we think that in this case the General Court's decision seems to be accurate and opens the door to new sensible applications for three-dimensional trademarks. Let us remember that industrial designs themselves are not accepted if the shape meets a functional need, so this principle must be considered even more in the case of three-dimensional trademarks: the shape cannot meet the need for the presentation of the product, for example. This principle was certainly implicitly taken into account by the EUIPO when it initially rejected the application.

In addition, as the General Court reminds us, the applicant for a three-dimensional trademark must always bear in mind that the average consumer is not used to associating the origin of goods by their shape or the shape of their packaging, in the absence of graphic or textual elements, and will therefore find it more difficult to prove the distinctive character of the sign. According to European case law, the closer the shape applied for as a trademark is to the shape of the product in question, the more likely it is that this shape will be devoid of distinctive character.

We will see if EUIPO appeals the decision to the Court of Justice of the EU.

The decision, currently only available in French, is available [here](#).

### **Registration of a sound mark presented in audio format**

In case **T-668/19** of 7 July, the General Court ruled for the first time on the distinctiveness of a sound and found that the noise of a can being opened cannot be registered as a sound mark for different beverages.

#### **Background**

On 6 July 2018, Ardagh Metal Beverage Holdings filed an application with the EUIPO for a trademark registration for a sound sign reminiscent of the sound produced when a beverage can is opened, followed by a silence of about one second and a fizzing sound of about nine seconds. The company, which manufactures lightweight metal containers and packaging, applied to register the mark for various beverages and metal transport and storage containers.

In January 2019, the examiner refused the application for registration on the grounds that the mark applied for was devoid of distinctive character - it could not be perceived as an indicator of the commercial origin of the goods - in accordance with the distinctiveness requirement of Article 7(1)(b) of Regulation 2017/1001.

This decision was upheld by the Second Board of Appeal of EUIPO, which stated that the general public is not necessarily used to consider a sound as an indication of the commercial origin of beverage containers and that, furthermore, the mark applied for consists of a sound that is inherent in the use of the goods in question, so that it would be perceived as a functional element and not as an indicator of business origin.

#### **Decision of the General Court of the EU**

In the decision, the GC provides criteria for assessing the distinctive character of sound marks. First, it recalls that the criteria for assessing the distinctive character of a sound mark is no different from that applicable to other categories of trademarks. Therefore, a sound sign requires a certain degree of distinctiveness to enable the consumer to perceive it as a trademark and not merely as an element of a functional or indicative nature with no intrinsic characteristics of its own.

In relation to the case-law applied by the EUIPO by analogy, according to which for a trademark to have distinctive character it must differ significantly from the customs of the sector, the GC points out that such case-law has developed in relation to three-dimensional trademarks (shapes of goods or packaging) for cases where there are standards or customs of the sector regarding those shapes. A consumer who is used to seeing one or more shapes corresponding to the norm or customs of the sector will not perceive the trademark applied for as an indication of the commercial origin of the goods if the shape constituting that trademark is identical or similar to the usual shape.

The Court continues that this case law can in no way be understood as establishing new criteria for assessing the distinctive character of a trademark, and concludes that the perception of an average consumer will not necessarily be the same in the case of a three-dimensional trademark consisting of the appearance of the product or its packaging as in the case of another type of trademark (word, figurative or sound) consisting of a sign independent of the shape or external appearance of the product.

On the other hand, the General Court analyses the perception of the trademark applied for by the relevant public, in order to determine whether the argument put forward by EUIPO that the relevant public would perceive the trademark as a functional element which would justify the lack of distinctive character of the trademark, is well founded.

In this sense, it concludes that the opening of a can or bottle is intrinsic to a technical solution which is linked to the necessary handling of the beverages to consume them, such a sound being considered imperceptible as an indication of commercial origin. Likewise, the slight nuances of the sound elements in relation to the classic sounds made by beverages when they are opened is not perceived by the relevant public as anything other than an indication of functionality, or as a variant of the sounds usually made by beverages when the container is opened.

Finally, the Board disputes EUIPO's assertion that it is unusual to indicate the trade origin of beverage and packaging goods solely by sounds because the goods are silent until they are consumed. In that regard, it points out that most goods only produce a sound when consumed, and this does not imply that the use of sounds to indicate a product's commercial origin in a particular type of market is unusual. However, that debatable assessment by EUIPO does not lead to the contested decision being annulled, since it does not have a decisive influence on the reasoning of the decision.

### Commentary

The obstacles that sound marks traditionally faced to comply with the requirements of trademark legislation and, in particular, the requirement of graphic representation, have been solved over the years. The initial solution was to represent them graphically by means of pentagrams, which were then extended to holograms or graphic representation of sound.

Nowadays, this representation can be completed by providing a sound file in which the sound or melody to be registered as a trademark is reproduced<sup>2</sup>.

However, it is still difficult for non-conventional marks, and in particular for sound signs, to obtain registration: the threshold of distinctiveness requirement is not met, especially when the sound is linked to a product from which some kind of sound is expected, as in the case of beverages.

We can also conclude, at least provisionally, a trend in non-conventional trademarks, which is that they are generally accepted when their use has been consolidated over time, but it seems much more complex to apply for registration *ex novo*. The example of these very recent judgments we have just reviewed seems to confirm this.

The decision can be accessed [here](#).

**Isabel Freijo**  
**AUGUSTA ABOGADOS**

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<sup>2</sup> Corrales Rodríguez, Juan (2014), “El registro de las marcas sonoras”, Sección El Rincón Legal, en MK Marketing+Ventas, Nº 296, Editorial Wolters Kluwer España.