

# NOVEMBER 2008 A guide to pitch perfect sound marks

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*India's trade mark registry granted its first sound mark in August this year. Ranjan Narula and Rachna Bakhru look at the implications for brand owners in the region*

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## One-minute read

Sound marks provide a very effective way for companies to distinguish their brands, but have yet to take off in Asia. The Indian Trade Mark Act defines a trade mark as "a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others". Although this definition is sufficiently broad to include sound marks, none had been registered until recently when Yahoo's yodel sound was granted statutory protection in August this year. Filed in 2004, the registration of the mark has caused a lot of interest in the region. The registration has also drawn attention to how unclear the application procedures are in India and to how slow other countries in Asia have been to accept sound marks.

Sounds, music, jingles and melodies have for a long time proved to be an effective marketing tool for publicising brands. It is well accepted that, because they are easier to remember, they have a greater penetration than visual advertising among a broad section of society. Consumers tend to associate and recall brands quickly with the help of a jingle, music or melody that is used with the brand. The importance of sound marks to brand owners is unquestionable. In that context, the registration granted to Yahoo's yodel sound as the first sound mark in India has been widely welcomed by brand owners.

The foundation for India accepting non-traditional marks was laid down in 2003 when India introduced important changes to its trade mark legislation in line with its obligation as a member of the World Trade Organisation. The changes included granting broader protection to well-known marks and widening the scope of trade mark infringement provisions. Further, the definition of a trade mark was broadened to accommodate non-conventional marks, including sound marks.

## The problem of representation

It is, however, interesting to note that the Indian Trade Marks Act does not specifically mention or define unconventional marks such as smell, colour, taste and sound marks. Further, the Act does not lay down any special procedures or criterion to be followed when applying to register unconventional marks. In the absence of clear provisions, it is possible to rely on the definition of trade mark being sufficiently broad to cover such marks. However, the Trade Marks Registry position on the filing and acceptance of sound mark applications has not been made clear. No guideline on how the application needs to be submitted, or on the examination procedure, has been laid out by the Registry.

As with the definition of trade mark in most jurisdictions, an essential registration criterion is that the mark in question should be capable of being represented graphically. Taking a cue from other jurisdictions in which sound marks have been registered, such graphic representation may be in the form of musical notes. In some jurisdictions, it has been held that, compared to a mere description of a sound, a representation of a sound in the form of musical notes is clear, precise, self contained and objective.

The practice in the US when seeking sound mark registration is to provide a description of the mark and not a drawing or musical notation. Further it should be accompanied by an audio or video reproduction of the mark.

In the UK, where mere description is not sufficient, the practice being followed is quite different. The mark should be graphically represented in the form of musical notes. The UK Trade Mark Manual provides that simple sequential musical notation, without indications as to timing and pitch, will also not meet the necessary requirements to qualify for registration as a sound mark.

Hong Kong appears to follow the UK practice. According to the Hong Kong Trademark Ordinance:

A description in words alone unaccompanied by a graphical representation of the mark is insufficient. The requirements of graphical representation are not met by a written description of the sound such as the sign composes a particular piece of music, or a list of the notes of which it is comprised, or the sound an animal makes. Simple sequential

musical notation, without indications as to timing and pitch, will not meet the necessary requirements.

In the absence of any guidelines from the Indian Trade Marks Registry, it appears that representations in the form of musical notes would facilitate registration of a sound as a trade mark such as Yahoo's yodel sound. In other words, as the definition of trade mark in the Indian Trade Mark Act has been adopted from the UK Act, the Trade Mark Registry is likely to follow the UK practice. Both the US and UK positions have their pros and cons: the UK position ensures that the sound mark being registered is clear and precise while the description of mark according to the US position ensures that the mark can be clearly understood by a common man, as not everyone can read musical notes.

However, it remains to be seen whether in the absence of clear guidelines in the Indian Trade Marks Act, the Registry would also allow onomatopoeic descriptions such as a lion's roar or rooster's crow, or whether it would adopt a more restrictive approach when assessing such applications. In this context it may be important to mention that OHIM had refused registration for the Tarzan yell as it was not represented in the form of musical notation. The brand owners would argue that ruling makes it difficult to register sound marks that are not music and thus cannot be expressed in the form of musical notation. The rejection has led to clarification being issued by OHIM accept that sound marks such as Tarzan's "yell" can be accepted if accompanied by an MP3 sound file.

What to avoid when registering a sound mark

- Very simple pieces of music consisting of only one or two notes;
- Songs such as Greensleeves that are commonly used as chimes by, for example, ice cream vans;
- Jingles commonly associated with amusement arcade machines (for such machines and entertainment services);
- Well-known popular music in respect of entertainment services, including
- amusement park services;
- Children's nursery rhymes, for goods or services aimed at children; and
- Music strongly associated with particular regions or countries for the type of goods or services originating from or provided in that area.

*Source: Trade marks Manual, UKIPO*

## Yahoo yodels into India's registry

Apparently, the yodel sound was represented graphically, although its publication in the Official Gazette does not seem to confirm this. The publication of Yahoo's sound mark in the Indian Trade Mark Journal no 1370 dated June 16 2007 for the purpose of any third party to file opposition appeared as: "The mark consists of the sound of a human voice yodelling the word Yahoo."

In other words, from the publication it would appear that the sound mark was not represented in the form of musical notes and/or a musical stave as it may have been applied for. This has been the subject of debate amongst IP practitioners. In the absence of an exact representation of the sound mark in the Trade Marks Journal, the trade and public cannot possibly determine the exact mark or sound that is being registered as a trade mark. Further, on a plain reading of the above description, one could argue that the sound being described is not precise and clear and therefore not sufficiently distinctive to be granted statutory protection as a trade mark.

The requirement of graphical representation is different from the requirement of visual perception. A mark needs to be visible to the eye to satisfy the requirement of visual perception. However, a sign can be represented graphically by providing a pictorial representation, a written description or a combination of both. A sound mark or scent/smell mark may be capable of being graphically represented but not capable of visual perception.

As a result, in countries such as the Philippines, where the mark has been defined as "a visible sign capable of distinguishing goods or services", sound or smell marks cannot be covered by the definition of trade mark.

## Asia's sound mark silence

Given that sounds are an important



element in branding and corporate

identification, the International Trademark Association (INTA) in 1997 adopted the following resolution with respect to protection of sounds as trade marks:

Whereas, the recognition of, and the protection afforded to sound trademarks varies from country to country; and whereas, such variation makes protection uncertain while sounds are being more frequently used to distinguish the goods and services of one business from another; be it resolved, that it is the position of the International Trademark Association that sound that is connected with a product or service may serve as a trademark and therefore, in appropriate circumstances, should be entitled to trademark recognition, protection and registration in the same way and subject to the same standards as any other trademark.

However, looking at the protection granted to sound marks in Asian countries one could say there is still a long way to go and the INTA resolution had little impact on acceptance of non-traditional marks in Asia. A majority of the trade mark offices in Asia do not provide for sound mark registration. These include the Asian economic powerhouse of China and the growing economies of Indonesia, Philippines, Vietnam, Thailand and South Korea. The only exceptions at the moment are Hong Kong and Singapore

It may be important to mention that all of the countries above are WTO members and hence signatories to the TRIPs Agreement. Article 15 of TRIPs states: "Any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trade mark." On that basis non-traditional marks such as sound marks should have been granted protection.

## Promising sounds

After the registration of Yahoo's yodel sound in India, the future seems promising. There is growing interest among WTO member states in granting protection to non-traditional marks. Perhaps the acceptance of sound marks by the Indian Trade Marks Registry will provide impetus to other Asian countries to accord statutory protection to sound marks. With new technologies such as mobile phones providing increased opportunities for trade mark owners to use sound marks these are bound to catch the attention of policy makers. It will be interesting to watch this area of intellectual property shape up in the coming years.

It is understood from the Indian Trade Marks Office that, despite acceptance of the Yahoo mark, procedures for the registration of sound marks are by no means fixed. It is not clear, at this stage, what distinctiveness criteria will be applied at the time of examination or how any conflicts with prior registrations will be determined. The registration of sound marks is still considered a grey area which will be clarified over time. At the moment, no guidelines have been formulated for sound mark applications. Applicants are, however, being advised to file both a graphical representation and a CD of the sound recording.

Although there is a lack of clarity as to the procedures and criteria for the registration of sound marks, these are expected to evolve with time as the Registry examines more of these applications. Further, the current debate may prompt the trade mark registry to include this in the new trade mark manual that is open for comment from brand owners, practitioners and members of the public. With the expected increase in applications and registrations for sound marks in the future, there is a need for a precise database (soundex) to accurately record data of sound marks at the Registry so that a proper assessment of applications can be made.

How to register a sound mark in India

- Mark clearly on the application that it is meant for the registration of a sound mark;
- Make sure the mark is graphically represented in, for example, the form of musical notes;
- Submit a compact disk with a recording of the sound mark to accompany the application; and
- Enclose any copies of corresponding registrations in other commonwealth countries.



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