

## The sound of harmony

Although brand owners are keen to protect the sounds and jingles associated with their products and services, the system for registering and protecting them on a worldwide scale is far from consistent. As India approves its first sound mark, **Rachna Bakhru** outlines the steps to harmonisation

**Rachna Bakhru** is an IP consultant with **Rouse & Co International**



Most people think of trademarks as simply words and/or logos; however, as both technology and the way we use it become more sophisticated, the importance of non-conventional signs, such as sounds, to promote brands is unquestionable. Consumers find it easy to identify a particular product or service by reference to a particular jingle, melody or music. Sounds are, therefore, capable of satisfying the trademark criteria: they can serve to identify the source, or trade origin, of a product or service.

However, non-conventional signs have not been widely accepted as trademarks across the world. In Asia, for example, only Hong Kong, Singapore, Korea and Taiwan have provisions in their trademark legislation for the registration of sound marks. And even where provision for registration has been made, there is a marked lack of consistency in the criteria and procedures for registration.

According to article 15 of the Agreement on Trade-Related Aspects of IP Rights (TRIPS): '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 trademark...' This definition is sufficiently broad to include non-traditional marks.

However, an essential registration requirement in most jurisdictions is that the mark in question should be capable of being represented graphically. This creates a problem since sounds cannot be visually perceived.

### Defining a sound mark

The procedural requirements of graphical representation for the registration of sound marks vary in different parts of the world: there are, essentially, two approaches. In the UK, the sound mark needs to be graphically represented in the form of musical notes. It is not sufficient

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to merely describe the sound. In the US, however, a description of the mark is required, not a drawing (eg of musical notes). Further, the description needs to be accompanied by an audio or video reproduction of the sound.

Both the US and the UK positions have their pros and cons. While the UK position ensures that the sound mark being registered is clear and precise, the description required in the US ensures

that the mark can be clearly understood by the common man. Not everyone can read musical notes.

Different countries also seem to adopt different approaches when examining sound marks for distinctiveness. For example, the Nokia ringtone was considered sufficiently distinctive to meet the registration requirement in the US and Australia, whereas it was rejected in Hong Kong in 2007, where the examiner concluded that: 'The subject mark fails to perform the essential function of a trademark, which is to guarantee the identity of the origin of the marked products to the consumer by enabling him to distinguish the products from others which have another origin. On hearing the subject mark, the relevant consumers would only perceive it as a sound that signals that the goods are in operation but no more.'

### Protecting Yahoo!'s yodel

The Indian Trade Mark Registry recently registered its first sound mark: Yahoo!'s 'yodel' sound. The development, which has been welcomed by brand owners, has generated a lot of interest in the region.

However, it is interesting to note that the Indian Trade Marks Act does not lay down any special procedures or criteria to be followed for the registration of unconventional marks. In the absence of clear guidelines, the Trade Mark Registry is likely to follow the UK practice since the definition of a 'trademark' in the Indian Trade Marks Act has been adopted from the UK Act. Further, taking into account the registration of Yahoo's 'yodel' sound, it appears that a representation in the form of musical notes is likely to facilitate registration, while a mere description of the sound is unlikely to suffice.

Although the criteria and procedures for the registration of sound marks are, at present, far from clear, this is expected to change as the Registry examines more of these applications. At the moment, applicants are being advised to file a representation of the mark in the form of musical notation, as well as a CD with a recording of the mark.

The acceptance of sound marks by the Indian Registry is a positive step and one that will hopefully encourage other Asian countries to grant statutory protection to sound marks.

In the UK, the sound mark needs to be graphically represented in the form of musical notes, but in the US just a description of the sound is required

## A new battle for Popeye

Although Popeye's copyright expired in January this year, it doesn't mean that the cartoon figure is free for use, as **Steve Kuncewicz** explains

**Steve Kuncewicz** is a media and IP lawyer at **Ralli Solicitors**

When Popeye's UK copyright expired in January 2009, it became one of the first of the famous 20th-century cartoon characters to fall out of copyright protection. The colourful character, his love interest Olive and his nemesis Bluto were created by Illinois artist Elzie Segar nearly a decade before he died in 1938. Since then, the spinach-eating hero has become a pop culture icon, giving birth to an entire industry based on his image, which stretches from foods to computer games, and generates an estimated £1.5bn in licensing each year. But the question of whether any company will now be able to use Popeye's image is still to be tested.

UK (and EU) copyright law provides that protection for Segar's original drawings expires 70 years after the death of their author, which means that the original drawings of Popeye, and to some extent the character himself, has now entered into the public domain in these jurisdictions. That would seem to suggest that anyone may now conceivably use his image without obtaining a licence or paying a royalty.

### New rights come into play

However, even though the original copyright has expired, any business which plans to use an image of a recognisable character should always be aware that copyright has a very long reach – in this case, even beyond the grave. For while Segar's original drawings are now available for use, whether anyone may want to use them is another matter altogether. Like many characters, including Mickey Mouse and Superman, the most iconic versions of the character only became popular after their design had changed following revisions by other artists, which in some cases took place some years after they first appeared.

Any image of Popeye which has been created by other artists after the original drawings will still be protected by copyright until 70 years after the death of whoever drew them.

Not only that, but Popeye's image is also a registered trademark, owned by King Features, a subsidiary of the US conglomerate Hearst Corporation, which is expected to protect the brand fiercely. This is a classic example of how there may be more than one right which can protect the image of a popular cartoon character, and I'm sure Walt Disney will be looking on with great interest when Mickey Mouse's copyright elapses in 2023.



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