

# Copyright: The sound of copyright

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*India registry accords intellectual property protection to sound marks for the first time*

The Indian Trademark Registry recently registered Yahoo's 'yodel' sound as a trademark, the first time statutory protection had been accorded to a sound mark in India. The development in this area is being welcomed by brand owners. Sounds, music, jingles and melodies have for a long time proven to be an effective marketing tool: it is well accepted that sounds often have a greater impact than purely visual advertising because they are easier to remember. The importance of sound marks to brand owners is, therefore, unquestionable.

It is, however, interesting to note that the Indian Trademarks Act does not specifically mention or define unconventional trademarks such as smell, colour, taste and sound marks. Further, the Act does not lay down any special procedures or criteria to be followed when applying to register unconventional marks. In the absence of clear provisions, one must rely on the definition of 'trademark' being sufficiently broad to cover such marks.

## **Definition of 'trademark'**

To comply with its obligations as a World Trade Organisation (WTO) member, and in accordance with the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS), India introduced significant changes to its trademark legislation in 2003. The changes included granting wider protection to well-known marks and increasing the scope of trademark infringement provisions. Further, the definition of 'trademark' was broadened to accommodate non-conventional marks including sound marks.

The Act defines a trademark 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 Yahoo's 'yodel' sound was granted statutory protection under the Act. As per the definition of 'trademark' 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 in the form of musical notes is clear, precise, self-contained and objective.

In the absence of any guidelines from the Indian Trademarks Registry, it appears that representations in the form of musical notes would facilitate registration of a sound such as Yahoo's 'yodel'. However, it remains to be seen whether the Registry would also allow onomatopoeic descriptions, such as a lion's roar or rooster's crow, or if it would adopt a more restrictive approach when assessing applications for registration of these marks.

## **Guidelines for filing**

The Trademarks Registry's position on the filing and the criteria for acceptance of sound mark applications has not been made clear: no guideline on how such applications should be submitted, or what the examination procedure will be, has been laid out.

It is understood from the Trademarks 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 criteria of distinction 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 of law, which will be clarified over time.

Although no guidelines have been formulated, applicants are being advised to file both a graphical representation and a CD of the relevant sound. Further, the application should clearly indicate that registration is being sought in relation to a sound mark.

### **The future**

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 registration applications. Further, the lack of clarity in procedures and examination criteria may prompt the Trademark Registry to include some guidelines in the new trademark manual (it is currently open for comment from brand owners, practitioners and members of the public). With the expected increase in applications for sound marks in the future, there is a need for a precise database to accurately record representations of sound marks at the Registry. This way a proper assessment of applications and registrations will be possible.

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