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Sound marks: A new perspective

Dheeraj Kapoor, associate at LexOrbis, examines the repercussions of India's new rules for sound trademarks, and whether they have hit the right note

A musical composition, jingle or sound can play a vital role in brand recollection and enrich the brand value of a business. The concept of sound marks explored, exploited and protected in India definitely opens up its own world of branding. Now, especially with the explicit recognition given to sound as a trademark under the new Trade Marks Rules 2017 as issued on 6 March 2017, businesses can receive more exclusivity for their musical or cacophonous branding and marketing methods to allure, attract and appeal to consumers in today's highly disruptive market.

If sound marks are distinctive and can play the role of trademarks, which is to exclusively identify and associate the goods and/or services as emanating from a particular undertaking (in other words, a 'source identifier'), they are registrable and deserve full protection under the Trade Marks Law. In India, sound marks such as the Yahoo yodel and the corporate jingle of ICICI Bank have already been registered. The former was the first sound mark to be granted registration in India and the latter was the first sound mark to be registered in the name of an Indian entity. Other sound marks that are registered in India include the sound of 'Hisamitsu' sung over certain musical notations and applied on a 'proposed to be used' basis by Hisamitsu Pharmaceutical Co of Japan; certain sound marks of Allianz of Germany in respect of insurance and financial services; and the popular musical sequence of Raymond: The Complete Man.

Coming back to the new Trade Marks Rules 2017, applications for sound marks must now be submitted in an MP3 format, not exceeding 30 seconds in length and recorded on a medium allowing easy and clear audible replay. This has to be accompanied with a graphical representation of the notations constituting the sound mark, according to Rule 26(5). Although the term "notations" has not been defined under the new rules and there is no explanation given as to what may be acceptable to fulfil the requirement of "a graphical representation of its notations", generally, modern staff notations are acceptable for musical compositions.

However, the fact that the scope of these terms has not been defined or restricted to mean only a particular manner of rendering the notations graphically, the legislative intent appears to be inclusive and thus progressive in nature. As a result, in so far as the graphical notations in the sound mark application are unambiguous and clearly define the mark, the notations would be acceptable. This is particularly useful in the case of a sound that is not musical and rather arbitrary noise but is still capable of being registered as a sound mark on account of its distinctiveness.

Previously, some applicants submitted transcriptions of the notations whereas others gave detailed descriptions along with conditions to explain their sound mark application while submitting the graphical representation of the notations, which was always a necessary requirement. This made the submission process non-uniform. Now, the requirement of submitting applications for sound marks in MP3 format will make a positive change in the uniformity and accessibility of records for users as well as the trademark office. In any case, describing one's sound mark application is not barred and this brings only further clarity on the scope of rights asserted in the application.

The uniform process under the new rules, coupled with digitisation of records, would also positively affect conducting sound mark searches

via the online database to ascertain conflicts and for due diligence activities. The MP3 format, which can be easily accessed and heard by users including the laymen, as opposed to reading sound notations, which is a difficult proposition for those who are not well versed in them, would, in the near future, enable better examinations and dealings in contentious matters (such as oppositions and cancellations) concerning sound marks.

An interesting and important feature from a procedural and rights perspective that cannot be ignored by the concerned executive and legislative bodies is the overlap in trademark and copyright law with respect to compositions constituting sound marks. Such an overlap also exists in the case of artistic works and there is a process of obtaining clearance from the trademark office before an artistic work can be applied for and registered as a copyright with the copyright office. It is likely that an application for registration of a sound recording or musical work with the copyright office would first have to be cleared by the trademark office through the issuance of a search clearance certificate.

Though ignored until now, this requirement is imminent given the rising popularity of sound marks in branding, trade and commerce. Another aspect would be issues concerning the preservation of the moral rights of authors/composers in the musical work of which only a segment may be used and applied for as a trademark by another party having been assigned the exclusive rights of exploitation, commercial or otherwise, in the work.

An obvious yet important point of law in respect of composite sound marks, such as melody sequences expressed or articulated in a particular manner such as by the use of words, would be the role of Section 17 of the Trade Marks Act of 1999.

It is settled law that trademarks are to be considered in their entirety and not artificially broken down into component parts for analysing the mark's registrability and the resultant rights, and even for the purpose of a comparison of marks. Thus, while the registration of a composite sound mark would provide statutory rights of exclusivity to its proprietor over the sound perceived as a whole or the unitary combination, it may not provide such rights over the words or the melody separately.

While filing sound mark applications, proprietors need to make sure that they are able to justify that the sound they are seeking exclusivity over in respect of their goods and/or services is worthy of such protection. In other words, the sound mark should be distinctive and issues regarding its functional role (if any), or the sound being common to trade, descriptive or just non-distinctive for any rational reason, would have to be dealt with. However, an original tune constituting a sound mark may entail trademark protection across classes on account of its inventiveness and inherent distinctive value.

All in all, with the advent of the new rules giving express recognition to and clarity on sound trademarks, several issues will emerge, be dealt with and settled in the near future. This would certainly lead to the development and progress of the legal framework concerning such non-conventional trademarks in tandem with the momentous impetus for brand creation in this area. [IPPro](#)