

# IP Hotline

September 22, 2008

## 'SOUNDS' GOOD FOR TRADEMARK PROTECTION-YAHOO REGISTERS THE FIRST EVER SOUND TRADEMARK IN INDIA

India's Trade mark Registry has 'registered' a new high by extending trademark protection to a sound mark. On August 18, 2008, India's first "sound mark" was granted to Sunnyvale, California-based Internet firm Yahoo Inc.'s three-note Yahoo yodel by the Delhi branch of the Trademark Registry<sup>1</sup>. It was registered in classes 35, 38 and 42 for a series of goods including email, advertising and business services and managing websites. Hot on the heels to this news is that Finnish mobile phone maker Nokia has also applied for a sound mark for its signature musical notation in the Mumbai branch of the Trade Marks Registry and the case is being processed.

### CAN THE SOUND MARK SCAMPER UNDER THE TRADEMARK UMBRELLA?

#### ANALYSIS OF THE CURRENT INDIAN REGIME:

Under the Trademarks Act, 1999 ('Act') the term 'marks' is defined as "mark includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or, combination of colors, or any combination thereof." Thus, the list of instances of marks is inclusive and not exhaustive. Any mark capable of being 'graphically represented' and indicative of a trade connection with the proprietor is entitled to get registered as a trademark under the Act. This interpretation opens the scope of trademark protection to unconventional trademarks like sound marks, provided they satisfy the 'graphical representation' test and are not prohibited under Section 9 and 11 of the Act. The Act or the Rules framed thereunder do not contemplate submission of any record of the sound mark. The only way the mark may be described in the application for trademark is by way of 'graphical representation'.

#### SCOPE OF 'GRAPHICAL REPRESENTATION':

Trademark Rules define "graphical representation" as representation of a trademark for goods or services in paper form<sup>2</sup>. Sound marks can be represented on paper either in descriptive form e.g. kukelekuuuuu (Dutch onomatopoeia which sounds like the call of a cock) or as traditional musical notations e.g. D#, E etc. In the case of Yahoo's Yodel mark, they represented the mark using musical notations<sup>3</sup>.

#### SYNCING THE INDIAN LAW TO TIDE THE HURDLES OF REGISTRATION:

Reducing a sensory mark to a written description on paper may not be always possible. A "graphical description" sound mark should clearly identify the exact sound, else the enforcement of the same, would lead to practical issues. E.g. the search result of the trademark at Trade Mark Registry, would not be accurate if the mark is not appropriately described. Merely musical notes without a listing of the note pattern would not provide enough sensory information to contemplate the scope of protection on the mark. With regard to onomatopoeia, there is lack of consistency between the onomatopoeia itself, as pronounced, and the actual sound or noise which it purports to imitate phonetically.

The European Court of Justice has held that musical notations alone are neither a clear nor precise description of the sound mark and gives no information about the pitch and duration of the sounds forming the melody. Even these form the essential parameters for the purposes of defining the trade mark itself. The graphical representations should be clear, precise, self-contained, easily accessible, intelligible, durable and objective. A stave divided into bars and showing, in particular, a clef, musical notes and rests whose form indicates the relative value and, where appropriate, accidentals (sharp, flat, natural)-all of these determine the pitch and duration of the sounds. This may constitute a faithful representation of the sequence of sounds forming the melody in respect of which registration is sought<sup>4</sup>.

#### DEFINING THE BOUNDARIES OF PROTECTION ACCORDED:

Indian Trademark Registry may have enhanced the scope of protection under the trademark umbrella, but there need to be clear guidelines for description, recording and protection that will help define the boundaries of protection of sound marks. Practical difficulties are bound to arise when trademark searches will be required. For e.g. if the sound mark is a crow's call and is described as kukelekuuuuu, the same may be spelt differently or represented with musical notations. The procedure may be highly complicated as musical notations need to be matched against alphabets. To simplify matters, a sample of the sound may be submitted with the application. A separate database of these sound marks can be created and rules for determination of deceptive similarity between sound marks should be developed.

Sound marks may be commonplace in US where Metro-Goldwyn-Mayer's mark of "a lion roaring" has long been registered for movies. But with Yahoo in the kitty, Nokia in the pipeline, it won't be far before other corporate giants like Britannia and Titan would make a beeline to protect their signature tunes in India.

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1. <http://www.livemint.com/2008/08/22002259/Yahoo-awarded-India8217s-fi.html>
  2. See Rule 2 (k ),The Trademark Rules, 2002.
  3. <http://www.managingip.com/Article/2004253/Yahoo-yodels-into-Indias-trade-mark-registry.html>
  4. Shield Mark BV v. Joost Kist h.o.d.n. Memex, (1999) RPC 392
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