

Registration of Sound Marks in India- The dilemma of Graphical Representation

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When someone mentions trademarks, sound marks are not the first thing that comes to our mind. However, to our surprise, we would have come across sounds that are protected as “sound marks”. When a sound performs the function of a trademark, it can be categorised as a sound mark. Sounds can function as source indicators when they “assume a definitive shape or arrangement” and “create in the hearer’s mind an association of the sound” with goods or services.¹

The Trade Marks Act, 1999 (Act) does not provide a separate category of protection for sound marks. However, according to the definition of “trademark” under Section 2(1)(zb) of the Act, a “trade mark” should be capable of being represented graphically. Consequently, ***as sound marks can be represented graphically, they are capable of being registered under the Act.***

While Rule 26 (5) of the Trade Marks Rules, 2017 provides that ‘*Where an application for the registration of a trademark consists of a sound as a trademark, the reproduction of the same shall be submitted in the MP3 format not exceeding thirty seconds’ length recorded on a medium which allows for easy and clearly audible replaying accompanied with a graphical representation of its notations’.*

Further, the draft Manual of Trade Marks also provides that ‘*A trademark may consist of a sound and represented graphically by a series of musical notes with or without words’ and ‘graphic representation requirements are met by representation of the sign by a musical staff divided into measures and showing, in particular, a clef, musical notes and rests, indicating relative value, and sharps, flats and naturals (accidentals)’.*

Consequently, it can be inferred from the above, that a sound mark should be represented by a series of musical notes(graphically), with or without words, and should be submitted along with an audio file in MP3 format.

However, certain sound marks, e.g. roar of a lion, cannot be represented in conventional staff notation. To allow these unconventional sound mark applications, a sonogram or a spectrogram wave may be admissible. In India, even though the rules require graphical representation through staff notation, by practice the Trade Marks Registry has admitted even spectrogram and sonogram waves under certain circumstances. The dichotomy in rules and practise can be decluttered by looking at the European Union Intellectual Property Office (EUIPO).

Graphical representation of a sound mark *vis-a-vis* EUIPO

The Court of Justice of the European Union (CJEU) in the seminal *Sieckmann*² case, concerning an olfactory mark, held that “*a trade mark may consist of a sign which is not in*

¹ USPTO Trademark Manual of Examining Procedure (Oct 2018), at 1202.15.

² *Sieckmann v. Deutsches Patent - und Markenamt*, (C-273/00) [2003] E.T.M.R. 37, 43- 45 (European Court of Justice)

itself capable of being perceived visually, provided that it can be represented graphically, particularly by means of images, lines or characters, and that the representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective” (Sieckmann criteria).

Further, the CJEU in *Shield Mark BV vs Joost Kist*³ considered the requirement of graphical representation of a sound mark and referred to the *Sieckmann criteria* and decided that graphical requirements are satisfied when ‘*the sign is represented by a staff divided into measures and showing, in particular, a clef, musical notes and rests whose form indicates the relative value and, where necessary, accidentals*’.

The case of Tarzan’s yell and MGM Lion’s roar in Europe

The requirement for graphical representation in staff notes led to the rejection of Edgar Rice Burroughs Inc.'s application for Tarzan’s ululating yell and Metro-Goldwyn-Mayer Lion Corp’s application for lion’s roar as it was unable to meet the *Sieckmann* criteria. The applications were filed as spectrograms with written descriptions. A spectrogram did not permit third parties to reproduce the sound without technical means; nobody could “read” a spectrogram as such, and therefore it was neither clear, intelligible nor easily accessible.

Considering the furore caused by this, the relevant regulation⁴ was amended and a sound file was allowed with electronic filings for Community Trademarks (CTM). Accordingly, for CTM applications, an electronic sound file, together with a graphical representation of the sound will be an acceptable graphical representation for purposes of trademark registration.

The EUIPO has taken the initiative to change their practice on sound mark registration by allowing the submission of spectrogram or sonogram if accompanied with an audio file. After years of trying, Tarzan’s yell and MGM Lion’s roar were finally registered as CTMs through sonogram/spectrogram accompanied with a sound file.

The road forward for India

Even though the draft Trademarks manual calls for graphical representation in staff notes, the Indian Trademarks Registry in practice allows sonograms and spectrograms. The Indian Registry has followed the EUIPO’s footsteps and allowed sonograms and spectrograms as it is accompanied with audio files. There are multiple marks, including the famous Tarzan’s yell⁵, which have been registered on the basis of sonograms and spectrograms along with the electronic music file (even though the Registry called for staff notations).

The Indian Trade Mark Registry has also allowed the sound mark containing the click of Zippo lighter⁶ to be registered on the basis of a spectrogram. ***Recently, a sound mark containing the Urdu couplet⁷, "Muddai lakh bura chahe to kya hota hai, Wahi hota hai jo manzoor-e-khuda***

³ *Shield Mark BV v. Joost Kist*, (C-283/01) [2004] R.P.C. 315 (European Court of Justice)

⁴ *See*, Decision No Ex-05-3 of the President of OHIM of 10 October 2005 concerning electronic filing of sound marks.

⁵ Indian Registration No. 1748778

⁶ Indian Registration No. 3995841

⁷ Indian Registration No. 3027897

hota hai", was registered on the basis of a spectrogram with descriptions. While the 'thump' sound of the bullet motorcycle⁸ was registered on the basis of staff notations.

The Indian Trade Mark has allowed registration of sound marks in tune with the times, however, without a way to listen to the sound mark application, a third party, a competitor, or an IP enthusiast are kept in the darkness regarding the nature of such a registration. A sound mark with staff notation is understood by at least a certain part of the population but a sound mark with a spectrogram\sonogram is unlikely to be understood or reproduced. When IP owners are obligated to be vigilant about similar/identical marks such a representation will prove to be an additional burden on them. The issue of graphical representation can be easily solved by enabling the public to listen to such sound marks at the Registry's online portal and amending the draft manual to include sonogram and spectrogram as graphical representation.

⁸ Indian Registration No. 3044833