

**SOUND AS NON-CONVENTIONAL TRADEMARK: AN EMERGING TREND IN INDIA****\*KIRAN SHARMA<sup>1</sup>****Introduction**

A mark consisting of lacquered red sole on women footwear, the sound of an oscillating humming buzz created by combining feedback from a microphone with a projector motor sound, peppermint scent or fragrance for office supplies, namely, file folders, hanging folders, paper expanding files are some recently registered trademarks. Isn't this trademark appearing to be a little different from the marks which we usually get to hear? The representation might seem a little different but the purpose remains the same. The object of trademark law is to deal with the precise nature of the rights which a person can acquire in respect of trademarks. This branch of commercial law has undergone changes from time to time in tune with the changing pattern of business methods and practices. Even the very concept of a trademark and its functions has changed<sup>2</sup>. Trademarks usually performs the function of communicating to the public that the mark on the goods serve as a 'source identifier'. The visual representation of the mark acts as the connector or 'source identifier' that links the goods bearing the mark to the public<sup>3</sup>. A device, brand, heading, label, ticket, name, signature, word, letter, numeral are called as mark<sup>4</sup> used by traders on their goods and services for distinguishing it from other traders' goods and services. These marks are known as traditional or conventional trademark. So, what are basically non-conventional or non-traditional trademark?

**Non-conventional Trademark: An overview**

In the day and age of aggressive marketing, numerous techniques are adopted to capture the attention of the consumers. This is where the non-conventional trademarks come into play<sup>5</sup>. A **non-conventional** or **nontraditional trademark** is a type of trademark which does not belong to any pre-existing or conventional trademark category, but does fulfill the essential trademark function of uniquely identifying the products or service<sup>6</sup>. Non-conventional trademarks

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<sup>2</sup> P. Narayan, *Intellectual Property Law* 148-149 (3<sup>rd</sup> ed. Eastern Book Company, 2002).

<sup>3</sup> Dev Gangjee, *Non-Conventional Trade Marks in India*, 22 NLSIR, 67 (2010).

<sup>4</sup> Trade Marks Act Sec 2(m) (1999).

<sup>5</sup> Shristi Bansal, *India: Non-Conventional Trademarks in India* (March 9, 2016) <http://www.mondaq.com/india/x/472602/Trademark/NonConventional+Trademarks+in+India>.

<sup>6</sup> *Non-conventional Trademarks* <http://www.svw.co.za/non-conventional-trademarks>.

may therefore be *visible signs* (e.g. colors, shapes, moving images, holograms, positions), or *non-visible signs* (e.g. sounds, scents, tastes, textures)<sup>7</sup>. These new marks go beyond the traditional trademarks in nature, characteristics, scope and economic potentials. With the passage of time different methods of identification and distinction developed<sup>8</sup>. The digital and social media revolution brought paradigm shift in the branding strategies. Non-traditional trademarks are the most striking branding strategy of the 21st century<sup>9</sup>. With the advancement in technology and the increasing competition day by day, the competitors has left with no other option but to come up with inventive and creative ideas which could make an impact on the minds of the potential consumers in regard with their goods and services.

### **Sound Mark: A Non-conventional trademark**

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<sup>10</sup>. A sound mark may consist of songs, strings of notes-with or without words, jingles either pre-existing or specially commissioned for the purposes of trademark registration. They may also consist of non-musical sounds, either existing in nature (e.g., animal sounds or sounds produced by meteorological or geographical features) or produced by machines and other man-made devices<sup>11</sup>. Other name for 'Sound' marks can be 'aural' or 'audio' marks. A sound trademark is a non-conventional trademark where the trademark function of uniquely identifying the commercial origin of products or services is achieved by means of an audio clip. Under most conventions and statutory provisions the definition of trademark either encompasses sound as a trademark, or at the very least, does not exclude such marks. Only a handful of countries have a standard or a set of requirements to be met for sound trademarks.<sup>12</sup>

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<sup>7</sup> As also categorized under WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications.

<sup>8</sup> Lionel Bentley & Jennifer Davis, *Trademarks and Brands: An Interdisciplinary Critique* (et.al. eds., Cambridge University Press, 2008).

<sup>9</sup> Lindstorm Martin, *Brand Sense: Build Powerful Brands through Touch, Taste, Smell, Sight and Sound*, Kogan Page Publisher (2005).

<sup>10</sup> Dheeraj Kapoor, *India: Sound Marks: A New Perspective* (May 31, 2017) <http://www.mondaq.com/india/x/598438/Trademark/Others>.

<sup>11</sup> Nineteenth Session of WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications, Representation and Description of Non-Traditional Marks Possible Areas of Convergence (Geneva, July 21 to 25, 2008).

<sup>12</sup> *Non-Conventional Trademarks- Analysis of the Indian Structure*, 4 RLR (2017).

## India

India is one of the few Asian countries to have opened its doors to the statutory protection of sound marks. The Trademarks Registry granted India's first sound mark registration for Yahoo!'s three-note yodel in 2008. The application was filed in 2004 with the following description: "the mark consists of the sound of a human voice yodeling the word Yahoo!". This encouraged other applicants to seek registration of their musical notations. ICICI Bank has secured trademark registration for its corporate jingle "*Dhin Chik Dhin Chik*", making it the first Indian entity to obtain a sound mark registration<sup>13</sup>. Other sound marks registered in India include the sound of 'Hisamitsu' sung over certain musical notations on a 'proposed to be used' basis and the popular musical sequence of "Raymond: The Complete Man".<sup>14</sup>

For registration under Trade Marks Act, 1999 dual criteria need to be satisfied. As defined under the Act "*trademark*"<sup>15</sup>, means a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others. The definition of trademark is exclusive in nature; it states that anything which can be represented graphically and can show the distinctiveness can secure trademark registration. The Trademark Act 1999 does not specifically use the word "sound" as a trademark but the Trademark Manual<sup>16</sup> have mentioned about the sound mark as a non-conventional trademark. This states that law does not explicitly exclude "sound marks" from registration. Sound marks, in a trade mark sense, are extremely rare. Accordingly, a trade mark may consist of a sound and represented by a series of musical notes with or without words. To explain this, the applications for sound marks must clearly state that they are sound marks. Otherwise the application will be considered as if it were a word and/or device mark (e.g. in the case of musical notation) 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)<sup>17</sup>. This means that musical notes that can be represented in the form of musical notations are acceptable whereas noises like a dog barking which cannot be represented

<sup>13</sup>Ranjan Narula & Rachna Bakhru, India: A shift in protection of non-traditional trademarks (April 26, 2016), <https://www.worldtrademarkreview.com/trademark-law/india-shift-protection-non-traditional-trademarks>.

<sup>14</sup>Dheeraj Kapoor & Shilpi Jain, Unconventional trademarks: An Indian perspective, CTC Legal Media 51, 51 (2017).

<sup>15</sup> Trade Marks Act Sec 2(zb) (1999).

<sup>16</sup> A Draft Manual on Trademark (Practice & procedure), 2015.

<sup>17</sup>Regarding unconventional trademark, A Draft Manual on Trademark (Practice & procedure), 2015.

by a musical notation but has to be described onomatopoeically or through a sonogram cannot be eligible for a trademark<sup>18</sup>. About the second criteria i.e. whether the mark is distinctive *per se* or can distinguish the goods or services of the owner from those of others. Generally speaking, a successful registration of a non-traditional mark must be supported by robust evidence of factual distinctiveness.<sup>19</sup> The acceptability of a sound mark depends upon whether the sound is or has become a distinctive sign; that is whether the average consumer will perceive the sound as a trademark showing an exclusive association with a product.<sup>20</sup> In particular, the following sounds may not be accepted for registration as trademarks since these are incapable of distinguishing goods or services of one person from those of others<sup>21</sup>:-

- very simple pieces of music consisting only of only 1 or 2 notes;
- songs commonly used as chimes;
- well known popular music in respect of entertainment services, park services;
- children's nursery rhymes, for goods or services aimed at children;
- Music strongly associated with particular regions or countries for the type of goods/services originating from or provided in that area.

The criteria of distinctiveness can be easily identified as association of the product with the consumer can be shown through the "use" over a time. The problem lies with the showing of graphical representation. The criteria of graphical representation for sound marks are in conventional notation or described in words by being graphically represented. As a practical matter, however not everyone can read written music. Moreover written musical notes while indicating pitch, normally will not indicate tone<sup>22</sup>. India has found the apparent solution of it which is mentioned in the recently amended Trademarks Rules<sup>23</sup>. It states that any application for registration of the trademark consisting of sound trademark, the reproduction of the same

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<sup>18</sup>Shristi Bansal, Graphical representation of the marks. India: Non-Conventional Trademarks in India (March 9, 2016) <http://www.mondaq.com/india/x/472602/Trademark/NonConventional+Trademarks+in+India>.

<sup>19</sup>Supra note 12.

<sup>20</sup>Lisa P. Lukose, Non-Traditional Trademarks: A Critique, 57 JILI 197, 197.

<sup>21</sup>A Draft Manual on Trademark (Practice & procedure), 2015.

<sup>22</sup>Arka Majumdra, Subhojit Sandhu and Sunandan Majumdra, The Requirement of Graphical Representability for Non-Conventional trademarks, 11 JIPR, 313-317 (2006).

<sup>23</sup>Trade Mark Rules, 2017.

shall be submitted in the MP3<sup>24</sup> format not exceeding 30 sec length recorded on a medium which allows for easy and clearly audible replaying accompanied with a graphical representation of its notations<sup>25</sup>. The WIPO<sup>26</sup> has recommended the new standard on the electronic management of sound marks. It states that the applicant should submit a graphical representation of the sound constituting the mark, for example, the musical notation on a stave or image of the corresponding sound wave, in electronic format. For sounds which are not a musical-type, the IPO may accept that the graphical representation of such sound consists of a textual<sup>27</sup> description. India amended its definition of graphical representation<sup>28</sup> provided under Trade mark rules, 2017 and states that representation of trademark for goods or services now includes representation in digitized form also apart from paper form.

### European Union

The take on sound mark registration as a trademark is not only emerging in India but some other countries are also amending their legislations with the growing trend. Such as, European Union of Intellectual Property Office (EUIPO) states regarding registrability of sound marks; with the abolition of the graphical representation requirement, as and from 1 October 2017, applications for sound marks can only be an audio file reproducing the sound or an accurate representation of the sound in musical notation. The Office accepts the file formats in JPEG, MP3 form and must not exceed 2 Mb. Currently there are no examples of sound marks represented exclusively by an audio file. Some earlier examples of sound mark registered by EUIPO are Metro-Goldwyn-Mayer<sup>29</sup>, Mast-Jägermeister SE<sup>30</sup>, Edgar Rice Burroughs, Inc<sup>31</sup>. Before the abolition of graphical representation requirement there was this famous case Shield Mark BV v Joost Kist h.o.d.n. Memex<sup>32</sup> in which ECJ held that:

*those requirements are not satisfied when the sign is represented graphically by means of a description using the written language, such as*

<sup>24</sup> "MP3" (or "MPEG-1/2 Layer 3") is the coded representation and the method of decoding of audio signals as defined by the International Standards ISO/IEC 11172-3:1993 as mentioned under New WIPO Standard on the Electronic Management of Sound Marks.

<sup>25</sup> Trade Marks Rules Rule 26(5)(2017).

<sup>26</sup> Committee on WIPO Standards (Feb 22, 2016).

<sup>27</sup> Textual description may contain the description of the sound in words, indication of the instruments used, the notes played, the length, as well as any other characteristics of the sound which the applicant wishes to specify.

<sup>28</sup> Trade Marks Rules Section 2(k) (2017).

<sup>29</sup> EUTM 005170113.

<sup>30</sup> EUTM 004928371.

<sup>31</sup> EUTM 005090055.

<sup>32</sup> Case C-283/01.

*an indication that the sign consists of the notes going to make up a musical work, or the indication that it is the cry of an animal, or by means of a simple onomatopoeia, without more, or by means of a sequence of musical notes, without more. On the other hand, those requirements are satisfied where 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<sup>33</sup>*

As discussed earlier these kinds of notational graphical representation is quite difficult to understand. Hence, it's always convenient to grow with the emerging technology and amend the rules accordingly. This growth and change can be seen in the amending laws of the various countries which are emerging with the growing trend and accepting the audio clips in a digital form. Websites of various trademark registry of different countries have this option available. 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<sup>34</sup>. Apart from providing sound in digital form, graphic representation can also be submitted. Below is an example of it:

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<sup>33</sup>Shield Mark BV v Joost Kist h.o.d.n.

[Memexhttp://curia.europa.eu/juris/showPdf.jsf?jsessionid=9ea7d2dc30db7f4993f0bf1745e58a24ac9c7690bfa3.e34KaxiLc3qMb40Rch0SaxuMa3b0?text=&docid=71437&pageIndex=0&doclang=EN&mode=req&dir=&occ=first&part=1&cid=53481](http://curia.europa.eu/juris/showPdf.jsf?jsessionid=9ea7d2dc30db7f4993f0bf1745e58a24ac9c7690bfa3.e34KaxiLc3qMb40Rch0SaxuMa3b0?text=&docid=71437&pageIndex=0&doclang=EN&mode=req&dir=&occ=first&part=1&cid=53481).

<sup>34</sup>Supra note 9.

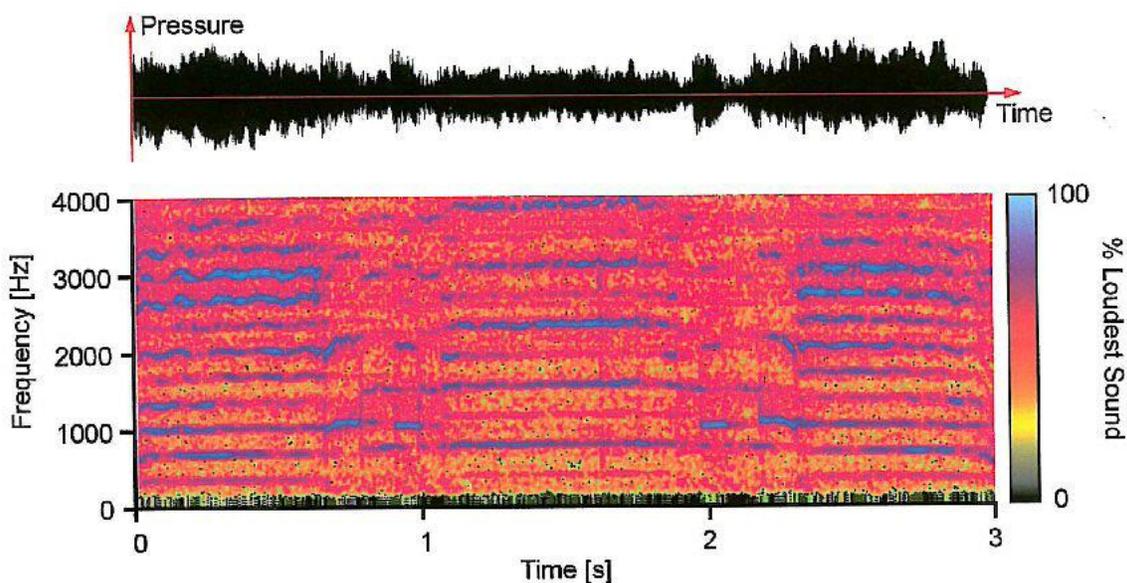


Figure 1 UTM 005090055 Yell of the fictional character TARZAN

## United States

The Lanham Act, which established the main chunk of the U.S.'s modern trademark law, allows for "any word, name, symbol, or device" to be registered by that mark's owner as long as they have a bona fide right to its use and intend to use it in commerce. So there really isn't anything in the Lanham Act that precludes the registration of a sound mark.<sup>35</sup> In the United States, whether a sound can serve as a trade mark "depends on the aural perception of the listener which may be as fleeting as the sound itself unless, of course, the sound is so inherently different or distinctive that it attaches to the subliminal mind of the listener to be awakened when heard and to be associated with the source or event with which it struck"<sup>36</sup>. Quite simply this means that if a sound lingers in the mind of the listener and the listener subsequently associates the source or event with that sound then the sound may be eligible for trademark registration<sup>37</sup>. The United States Patent and Trademark Office (USPTO) will not register "commonplace" sound marks (such as alarm clock chirps and audible electronic signals), but rather only marks that are

<sup>35</sup> Russell H. Falconer, *Big Future for Nontraditional Marks*, NAT'L L. 28 (2012).

<sup>36</sup> *Re Gen. Electric Broad. Co.*, 199 USPQ 560, 563 (TTAB 1978).

<sup>37</sup> *Supra* note 4.

"arbitrary, unique or distinctive." Further, a sound mark that is "functional"<sup>38</sup> cannot be registered<sup>39</sup>. The USPTO encourages online filing via TEAS (Trademark Electronic Application System) on its website. For sound mark, the applicant must submit an audio file in electronic format (.wav, .wmv, .wma, .mp3, .mpg, or .avi format) that should not exceed 5 MB in size. The applicant must provide a detailed description of the sound, including any words or lyrics<sup>40</sup>.

In US there have been many attempts to register sound marks and have been successful also. The first successful application for a sound mark which was a three key sequential notes was registered in 1978 and was filed by National Broadcasting Company (NBC)<sup>41</sup>, one of the country's largest media conglomerates<sup>42</sup>. Despite the successful registration of trademarks in sounds, the USPTO reports that only 23 of more than 7, 29,000 trademarks in force in the United States are sounds and since 1946, there have only been 71 applications to register sounds as trademarks or service marks. Harley Davidson's attempt to register the mark consisting of the exhaust sound of the applicant's motorcycles, produced by V-Twin common crankpin motorcycle engines was very much debated. The sound produced by Harley Davidson's motorcycles seems to be peculiar, but many other manufacturers objected to the registration of this sound mark, arguing that cruiser-style motorcycles of various brands use a single-crank pin V-twin engine which produce a similar sound. This application opened the Pandora box of doubts in the registrability of sound marks<sup>43</sup>. Some other recognizable sound trademarks registered by USPTO are Beneficial - Insurance - "At Beneficial TOOT TOOT You're Good for More..."<sup>44</sup>, Del's Lemonade & Refreshments - Carryout Food Mobile Truck - Horn<sup>45</sup>, Al Ham Productions - Entertainment - The Dreams We Share, We'll Always Remember, Remember With The Music Of Your Life "<sup>46</sup> and many more.

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<sup>38</sup> As described in *In re Vertex Gp. LLC*, 89 USPQ2d 1694, 1702-03 (TTAB 2009), a sound mark is functional if: (1) it is essential to the use or purpose of the goods or services; or (2) if it affects the cost or quality of the goods or services, such that the exclusive right to use the sound would put competitors at a disadvantage.

<sup>39</sup> Jeffrey Cadwell, *What's That Sound? It Might Just Be a Trademark* (April 19, 2016) <https://thetmca.com/whats-that-sound-it-might-just-be-a-trademark/>.

<sup>40</sup> Filing a Trademark Application in the United States (September, 2016) <http://www.inta.org/trademarkbasics/factsheets/pages/filinginusfactsheet.aspx>.

<sup>41</sup> USPTO Reg. no. 72349496.

<sup>42</sup> *Supra* note 34.

<sup>43</sup> Michael Sapperstein, *the Trademark Registrability of the Harley-Davidson Roar: A Multimedia Analysis*, B C LIPT Forum & Journal, 101 (1998).

<sup>44</sup> USPTO Reg. no. 73270308.

<sup>45</sup> USPTO Reg. no. 73391897.

<sup>46</sup> USPTO Reg. no. 73432170.

## Conclusion

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<sup>47</sup> and this process lacked practicality<sup>48</sup>. 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 digitization of records, would also positively affect conducting sound mark searches via the online database to ascertain conflicts and for due diligence activities<sup>49</sup>. With the passage of time different methods of identification and distinction developed. The whole purpose of trade marking a product is to show the distinctiveness and being identified as a source indicator and to protect the product from the commercial use by the other proprietors, which could deceive the public and lead to disparagement of business goodwill. Many organizations register brands and logos as trademarks. However, the scope of "trademark" is much beyond mere brands and logos. Until recently, such things were thought to be unregistrable and largely unprotected at common law. Now, this position is changing internationally. Sound, images, color combinations, 3D images, and so on now appear on so many trade mark registries and in trade mark legislations and treaties<sup>50</sup>. This change in the Trade Mark rules is expected to generate the lost interest in people for registering sound marks<sup>51</sup>. Such unconventional trademarks can also create great value for organizations. Corporate India should now open up to the possibilities of unconventional trademarks, and explore their full potential<sup>52</sup>.

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<sup>47</sup>Supra note 9.

<sup>48</sup>Surbhi Pandey, Registering Sound Marks in India- Trade Mark Rules 2017 (April 1, 2017) <https://www.intepat.com/blog/trademark/registering-sound-marks-india/>.

<sup>49</sup>Supra note 9.

<sup>50</sup>David Vaver, Unconventional and Well-known trademarks, 2 SJLS, (2005).

<sup>51</sup>Supra note 47.

<sup>52</sup>Rajendra Misra, Taj Mahal Palace Gets Trademarked! <http://www.tajhotels.com/en-in/about-taj-group/press-and-media/leader-speak/leader-speak/2017-2018/taj-mahal-palace-gets-trademarked/>.