Distinctive sounds like the MGM lion's roar protected by law

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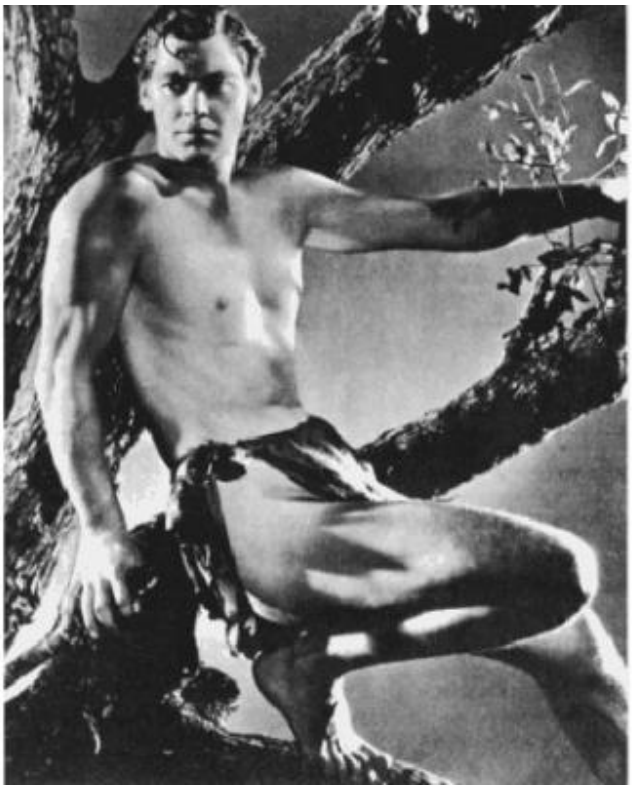

Johnny Weissmuller, the silver screen's most well-known Tarzan, did not do the famous Tarzan yell himself. The yell was a fabrication done in the studio by mixing two singers' voices. And that yell's been trademarked.

Photograph by: Handout, File photo

"There's no such thing as silence. Something is always happening that makes a sound."

—John Cage, influential American composer known for his 1952 4'33'', which is performed in the absence of deliberate sound.

The idea that sounds in the public domain may be owned by someone appears, at first, as a dubious proposal. However, it is common for companies to try to protect the sounds associated with their product branding and overall marketing strategy.

Distinctive sound marks have been registered in a number of countries. In the United States, a substantial range of sound marks have been registered, such as the Yahoo! yodel, the "ringing cash register sound" owned by EasyTel Corp. and the well-known Tarzan Yell owned by Edgar Rice Burroughs.

In Germany, a number of jingles by AT&T, Deutsche Telekom and Nokia have also been registered. In the United Kingdom, the “sound of a speaking clock” has been registered by British Telecom. In Australia, McCain Foods registered a “ping” sound in the context of the slogan “Ah! McCain (PING) You’ve done it again.”

After a lengthy dispute involving Metro-Goldwyn-Mayer’s iconic lion’s roar (heard at the outset of most MGM movies) and its attempt to register the mark in Canada, the Federal Court of Canada has finally accepted the possibility of the registration and use of sounds as trademarks.

The trademark application for MGM’s Lion’s Roar was filed on Oct. 6, 1992, and was subsequently refused by the Canadian Trademarks Office (CIPO) on the basis that the mark did not meet: the definition of the Trademarks Act; the requirements to provide a drawing of the trademark; the test for distinctiveness of the trademark; and the test laid down in relevant case law which, in the opinion of CIPO, required that a trademark be represented visually. MGM appealed the rejection to the Federal Court, and the court’s decision to allow the appeal marks a reversal of the CIPO’s long-standing position to deny the registration of sound marks, clearing the way for the filing of such marks in Canada. Unfortunately, the court did not provide any discussion of the law.

On March 28, CIPO published a Practice Notice indicating that, effective immediately, it will accept applications for sound marks. In this practice notice, CIPO states that an application for the registration of a sound mark must include: an indication that the application is for the registration of a sound mark; a drawing that graphically represents the sound; a description of the sound; and an electronic recording of the sound.

There were approximately nine more sound trademark applications submitted to CIPO ever since, including the Intel Corp. sound and the Toys “R” Us jingle “I don’t wanna grow up, I’m a Toys “R” us kid.” It is expected that more and more companies will apply to register sound marks in Canada.

The recent change in policy brings Canada in line with the position of other countries that recognize registration of sound marks, such as the United States, some countries within the European Union and Australia. Applicants should be aware that it still may be difficult to obtain registration of a sound mark in Canada even though this recent change in practice represents an important step in recognizing the registrability of such marks in Canada.

Indeed, the sound mark must be distinctive and evidence of acquired distinctiveness will be required to demonstrate that the public associates the sound with the underlying goods or services. Such evidence is normally filed through a sworn declaration or affidavit. Moreover, it will be challenging for trademark owners to provide an adequate description of the sound when filing the trademark application.

The following description, which appears in reference to a sound mark registered in the United States, is an excellent example, and it is far from being the most complex description of record:

“The mark is a sound mark consisting of three musical notes - Treble notes B-Flat one octave above middle C, followed by an F, and then to an E-Flat note above middle C. The tones are synthesized portamento feature slightly sliding the notes into and towards each other, with a slight addition of delay and reverb throughout.”

Stretching the Boundaries: Registrability of other Forms of "Non-traditional" Marks

Canadian law is evolving toward granting protection to non-traditional marks. A few months ago, the red colour was registered as a trademark in association with Christian Louboutin's famous red sole.

Last spring, CIPO published proposed amendments to the Trademarks Regulations pertaining to the registrability of sound, motion and holographic marks in Canada and asked for public considerations and comments – a change that would bring Canada closer to the United States, some countries within the European Union, New Zealand and Australia. At present, there are no regulation dealing with these forms of non-traditional marks.

It should be noted that the proposed amendments do not cover the more common forms of "non-traditional" marks, specifically taste, texture and smell marks. These marks are contemplated in other trademark registration systems, such as some countries within the European Union, Australia and the United States and are generally supported by the international trademark community. With a little guidance from CIPO on how to graphically depict or describe the scope of these other types of marks, they too could and should be covered under the proposed amendments. Only time will tell us what the future holds in terms of the registrability of other forms of non-traditional marks.

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