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"Sound Trademark" on the Fire

(From China IP)

On September 2nd, 2011, the Legislative Affairs Office of the State Council of China issued the Trademark Law of the People's Republic of China (Amendments Exposure Draft) to solicit opinions from all circles of the society. It is known that, compared with the current Trademark Law, the Exposure Draft has added "sound" to the category of trademark registration.

The Exposure Draft stipulates that any mark that can distinguish the commodity of a natural person, a legal entity or other organizations from other entities" commodities, including characters, pictures, letters, numbers, three-dimensional marks, colors and sounds as well as the combination of the above elements, can be registered as a trademark.

Though the sounds of some brands, such as the five second sound of "Yang Yang Yang" of the Heng yuan xiang Group in 1992 were familiar to all, they hadn't been registered until the Exposure Draft added sound trademark registration. The international representative "sound trademarks" include Intel's "Intel Inside," Motorola's "Hello Moto," Yahoo's three second advertisement "jingle," MGM's lion roaring at the beginning of its movies, MSN's special sounds of getting online and receiving a message, along with other familiar sounds or services already protected by the law.

Actually, for legislation, it's not difficult to define sound trademark. The real difficulties are the problems encountered in the process of implementation. In the inter view with Mr. Bu Xiaojun, lawyer of Unitalen Attorneys at Law, he told China IP his opinion, "I think the registration of a sound trademark should pay attention to several things. First, the registration requirement for a sound trademark, especially the requirement on conspicuousness, should be raised to a higher standard at the beginning of legislation. The legislative department may even consider setting a minimum time of usage in order to distinguish a trademark from others. The stipulations on how to apply for sound trademark registration should be explicit and specific as well. Second, the examination criteria for sound trademarks should be clear. The judgment of similarity between sound trademarks is more subjective than word trademarks. Whether to judge according to the tone, the sound spectrum or the note is a question. The free discretion upon sound trademarks of judges should be more restricted than word trademarks. Third, the similarity judgment standards for judicial review should be clear. The traditional comprehensive examination and comparison of key elements are not suitable for sound trademarks at all. The stipulations on how to file an infringement case should be clear."

The situation in Hong Kong and Taiwan Hong Kong and Taiwan introduced sound trademark earlier than the Chinese mainland. Hong Kong introduced the concept of sound trademark in April, 2003.

On July 27th, 2007, Hong Kong Trade Marks Registry added a chapter to the interior work manual for trademark examination, providing detailed stipulations on the registration procedure of sound trademarks. According to the

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stipulations, when applying for sound trademark registration, the materials describing the sound trademark should be explicit, definite, independent and objective and can last for a period of time as defined by the law. The materials should also be easy to identify and understand. Only a piece of specific music or a few notes does not meet the requirement of a sound trademark. Using music bars consisting of notes and clefs to represent the tune and pauses of a piece of music is an acceptable description of a sound trademark. If a sound trademark is described by words, music notation must be added to the description.

The arguments for raising an objection to a sound trademark, include lacking in conspicuousness and descriptiveness, which means that a sound trademark describes a certain linguistic or commercial habit. However, it should be noted that the lack of conspicuousness of an associated trademark cannot be judged only from the lack of conspicuousness of the music part. Other components of the associated trademark should also be considered so as to comprehensively judge the conspicuousness of the whole trademark.

The Trademark Law of Taiwan started sound trademark registration on November 28th, 2003. The other two non-traditional trademarks that have been newly included in the new Trademark Law of Taiwan this year are hologram trademark and dynamic trademark.

It is known that the total number of applications for a sound trademark registration is not very large presently in Taiwan because the distinctiveness examination for sound trademark is difficult to pass. According to the statistics, there have been about 77 applications for sound trademark registration by January 18th, 2010; however, only 33 of them have been successfully registered.

When interviewing Mr. Wang Huangxuan, Director of Production Translation and Industry Collaboration Committee of Taiwan Innovation and Incubation Society, he introduced the situation of sound trademark registration in Taiwan. "According to the examination criteria for sound trademark in Taiwan, sound trademark means a sound that can make the relevant consumers distinguish a product or service from others. For example, short advertisement songs, melodies, human voices, bell tolls, ringing sounds of bells, crying of animals, etc. that can be identified. In practical application, the auditory sense is added to the traditional visual performance in order to deepen consumers' impression upon the brands so that the representation of advertisements becomes more diversified. Actually, these applications have been happening around us for a long time. However, the new Trademark Law has provided them with legal protection for their properties. Though TRIPs under the WTO framework does not require its members to include sound trademark into their range of protection, many countries in the world, among which the U.S. was the first one, have put sound on their list of trademark registration. Other countries include France, Australia, Turkey, India, Russia, etc.," Wang told China IP.

A sample case It is well-known that the sound trademark of "Enrich your life" of Cathay Financial Holdings of Taiwan has been used in the advertisement of the 9th category of bank commodity. It has been successfully registered because it has postnatal distinctiveness. However, when the company was using the same content to apply for the 35th category of services of "advertising and delivery of publicity materials, computer network online advertisements, delivery of publicity materials in the layout design, production, agent for publicity of advertisements, intermediary for enterprise purchase and related consultations, etc.," its application was rejected by Taiwan Intellectual Property Office (TIPO) due to its lack of trademark distinctiveness. TIPO's reason for the judgment was that for the 35th category of services, the trademark did not have actual proof for its usage to

support its postnatal distinctiveness as the 9th category. The Petition Reviewing Commission rejected its application due to the same reason. The opinions of the Supreme Administrative Court were: though sound trademark was a new type of trademark, the criteria for its distinctiveness was the same with other types of trademarks such as word trademark and figure trademark; therefore, there should not be such a statement that "it is more difficult to judge the innate distinctiveness of a new type of trademark than the traditional trademarks;" the case should be heard in the Intellectual Property Court. The opinions of the Intellectual Property Court were: the melody of the disputed sound trademark seemed ordinary because it was too simple; the representation of its sound was common because of its low recognizable level; the voice in the trademark was also normal wording; therefore, consumers would not regard the melody as the trademark of the product or service; the disputed sound trademark was lacking in innate distinctiveness; the plaintiff had never emphasized that the disputed trademark ought to be used on the 35th category of services, so it was difficult to judge its postnatal distinctiveness due to its usage.

In practice, most sound trademark registrations are the advertisement sounds of famous brands because it is easier to obtain distinctive elements with postnatal distinctiveness. For example, Intel (Registration No. 01158019), Mr. Brown Cafe (Registration No. 01152021), New I-Ten-Rin B12 (Registration No. 01150436), Green Oil (Registration No. 01135554), etc.. Their melodies are often heard in their advertisements. Other examples include: in Rejection No. 0289036, the company applied for sound trademark registration for the crying of "robbery" in both Mandarin and Taiwanese, which was specifically used on a kind of non-vehicle anti-theft system, and the application was rejected due to its lack of distinctiveness; some people tried to register a sound trademark with a whole song, which was also rejected by TIPO due to the same reason (e.g. Rejection No. 0289602).

In our interview with Mr. Zhang Malin, Professor at the School of Law of Southeast University, he concluded, "The inclusion of sound into trademark registration is an innovation, which breaks through the boundary of traditional trademarks consisting of visual pictures, words, etc.. It is necessary to develop from visual images to the range of audibility because visual images are not the only method to distinguish commodities. So do some sounds."