

April 17, 2012

Listen to that Trade-Mark: Protecting Sounds as Trade-marks in Canada

By Paul W. Donovan

Sound marks are a sub-category of trade-marks that involve the use of a particular distinctive sound in order to distinguish one's goods and services from the goods and services of others. For many years, the Canadian Intellectual Property Office took the position that such marks could not be registered, largely due to technical difficulties in how these marks were to be graphically represented.

On March 28, 2012, the Office issued a new Practice Notice governing sound marks. Effective immediately the Office will accept trade-mark applications for sound marks. The Practice Notice was made as a result of the decision in a recent Federal Court motion, in which the Court ordered the Office to approve a sound mark application for advertisement in the Canadian Trade-marks Journal.

The application in question is the "ROARING LION" sound featured at the beginning of movie films since 1928 by Metro-Goldwyn-Mayer Lion Corp. ("MGM"). The trade-mark application was actually filed in 1992. After many years of back and forth correspondence between the Applicant and the Office (I note from the online records that twenty-three extensions of time were filed!), the Office formally issued a letter of refusal in 2010. MGM appealed to the Federal Court and on March 1, 2012 the Court overturned the Office's refusal of the application, paving the way for MGM to proceed to advertisement in the Canadian Trade-marks Journal.

As a result, the Office has now decided to accept sound mark applications and it managed to issue its Practice Notice within a month of the MGM decision. It appears that the legal community wasted no time in moving forward on this issue, as another sound mark application was filed on March 30, 2012 (just two days after the Practice Notice) – a catchy little riff apparently to be used by Mars Canada Inc. in association with chocolate confectionary. The Office has in fact created a sound mark database where you can listen to these marks:

<http://www.cipo.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/wr03433.html>

The Office has set out some initial criteria for the filing of a sound mark:

1. The application must contain a statement that the application is for a sound mark.
2. The application must contain a drawing that graphically represents the sound.
3. The application must contain a description of the sound.
4. The application must contain an electronic recording of the sound.

The Office will only accept hard copy applications for sound marks – they cannot be filed online – and the recording of the sound must be in MP3 or WAVE format and no larger than 5 megabytes in size.



PERLEY-ROBERTSON,
HILL & MCDUGALL LLP/s.r.l.

Only time will tell if Applicants will continue to take advantage of the possibility of sound mark applications. If you are interested in protection for a distinctive sound in order to distinguish your goods and services from those of others, please contact the writer for more information.

Paul W. Donovan is a lawyer in our Intellectual Property Law Group. He can be reached at pdonovan@perlaw.ca or 613.566.2834.