

# Canada's Current Position with Respect to Sound Marks Registration: A Need for Change?

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## INTRODUCTION

With the exception of Canada, sound marks have become increasingly recognized and registrable throughout the world.<sup>1</sup> The use of sounds as a trade-mark is particularly interesting and innovative as sounds disregard all language barriers. With the globalization of market and trade and the rapid evolution of technologies, an increase in applications for sound marks registration in future years seems predictable.<sup>2</sup> Therefore, the analysis of the legal and practical aspects in this matter is of great interest as it will further the understanding of the reasons for which Canada is not a pioneer in this field.

Canada was amongst the first countries to enact trade-mark legislation. Prior to Confederation, in 1860, the Legislative Council and Assembly of Canada

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<sup>1</sup> For instance, the United States, European Union and Australia allow sound marks registration; David Vaver "Unconventional and Well-Known Trade Marks" (2005) *Sing. J.L.S.* 1, at 2 [Vaver, "Unconventional"]; Canadian Intellectual Property Office, correspondence dated May 15<sup>th</sup>, 2009: « L'Office de la propriété intellectuelle du Canada est fier de répondre aux besoins de sa clientèle. En réponse à votre demande, les marques sonores ne sont pas enregistrables au Canada ».

<sup>2</sup> Marcus Höpferger, "Non-Traditional Marks — Singapore Treaty Enters into Force" (2009) *WIPO Magazine*, online: <[http://www.wipo.int/wipo\\_magazine/en/2009/01/article\\_0002.html](http://www.wipo.int/wipo_magazine/en/2009/01/article_0002.html)> (It is interesting to note that efforts have been made in order to defined areas of convergence related to the reproduction and description of non-traditional marks: The Singapore Treaty on the Law of Trademarks "sets out a multilateral framework for the definition of criteria concerning the reproduction of hologram, motion, color and position marks and of marks consisting of non-visible signs on trademark applications and in trademark registers." The Singapore Treaty entered into force on March 16, 2009. Moreover, the WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) has defined "a number of areas of convergence concerning the representation and description of non-traditional marks, such as 3D marks, hologram marks, position marks, multimedia marks or sound marks. Those areas of convergence reflect a common approach by all WIPO Members to the representation and description of non-traditional marks and provide the first international reference in that area)."

adopted *An Act respecting Trade-Marks*.<sup>3</sup> However, the most recent major revision to Canadian trade-marks legislation was in 1953 with the passing of the *Trade-marks Act*.<sup>4</sup> Since then, the *TMA* has remained relatively unchanged as only a few amendments have been made.<sup>5</sup> Nevertheless, in 2005, the Canadian Intellectual Property Office (CIPO) published proposals to modernize the *TMA* in order to maintain an efficient trade-mark regime, to respond to new trends and to enhance Canadian's competitiveness in the market place. CIPO invited comments regarding a number of trade-mark improvements, including issues surrounding the registration of non-traditional trade-marks, such as sound marks.<sup>6</sup> While applications for the registration of sound marks continue to be rejected in Canada, these proposals indicate that CIPO might be considering extending statutory protection to some forms of non-traditional trade-marks.

Historically, the conventional way of distinguishing products or services of one person from those of another was through the use of traditional trade-marks, which usually consisted of words or specific designs.<sup>7</sup> For instance, Nike, Coca-Cola and the McDonald's Golden Arches logos are famous, legally established, conventional trade-marks.<sup>8</sup> However, the expansion of the Internet, the growing use of new technologies, and the globalization of markets have led to the development of a wide variety of new methods and strategies to distinguish products and services.<sup>9</sup> Companies now feel the need to distinguish themselves in new ways in order to attract consumers and stay in the market.

As a result, conventional trade-marks, which are essentially limited to the use of words and designs, are joined by innovative, non-traditional trade-marks.<sup>10</sup>

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<sup>3</sup> Kelly Gill & R. Scott Jolliffe, *Fox on Canadian Law of Trade-marks and Unfair Competition*, 4th ed. (Toronto: Carswell, 2002) at 1-3.

<sup>4</sup> *Trade-marks Act*, R.S.C. 1985, c. T-13 [*TMA*].

<sup>5</sup> The most significant amendment occurred in 1993 with the abolition of the Registered User regime in favour of section 50 (as it is known today).

<sup>6</sup> Canadian Intellectual Property Office, *Proposals for Comment Relating to Modernization of the Trade-marks Act* (Industry Canada, 2005), online: <<http://www.cipo.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/wr00676.html>> (CIPO invited comments concerning the adherence of Canada to the Trademark Law Treaty and the Madrid Protocol and on a number of trade-mark improvements).

<sup>7</sup> Bob H. Sotiriadis & Laurent Carrière, "The Statutory Protection of Non-Traditional Trade-Marks in Canada — A Few Reflections on Their Registrability and Distinctiveness" (2000) Leger Robic Richard, online: <<http://www.robic.ca/publications/Pdf/235E-BHS.pdf>> ("We generally conceive a trade-mark as constituted of one or many letters, one or many words — invented or not — a sentence, armorial bearings, seal, hallmark, label, numbers, drawing, or even a combination of these" at 2). See also Guillermo Bosch Canto, *Analysis of Non-Traditional Trademarks in North American Countries* (LL.M. Thesis, Graduate Department of Law of the University of Toronto, 2007) [unpublished], at 24.

<sup>8</sup> Vaver, "Unconventional," *supra* note 1 at 1-2.

<sup>9</sup> John S. Macera & Adele J. Finlayson, "Eccentric Trade-Marks, Smells and Bells Grooves and Moves" (2003) at 1-2, online: Moffat & Co., Macera & Jarzyna LLP <<http://www.moffatco.com/pages/publications/SmellsBells.pdf>>.

<sup>10</sup> *Ibid.*

These may include sound marks, scent marks, taste marks, shape marks, texture marks, colour marks and motion marks.<sup>11</sup> The use of these novel marks goes beyond conventional methods because it reaches consumers through their five senses.<sup>12</sup> These types of marks were thought to be essentially unregistrable as trade-marks until recent years, where the possibility of registering non-traditional marks, particularly sound marks, has been growing internationally.<sup>13</sup> For instance, in Australia, trade marks law has been amended to broaden the definition of a trade-mark in order to include non-traditional trade-marks, such as sound marks. In Canada, however, sound marks remain unregistrable as trade-marks.

This paper analyses and criticizes Canada's position on sound marks registration in order to recommend the ways in which Canadian policy-makers could further act in order to advance this area of law. The first part of this paper exposes the fundamental concepts of trade-marks as they are necessary to the comprehension of the problems surrounding the registration of sound marks. In the second part, legal considerations associated with the registration of sound marks are discussed. More specifically, the visual requirement, the issue of "use," the concept of distinctiveness and the question of overlap with copyright are assessed. In the third part, practical concerns related to the representation of sound marks are addressed and recommendations are made.

## I. BRIEF OVERVIEW OF FUNDAMENTAL CONCEPTS

### (a) What is a Trade-Mark?

Trade-marks are commonly classified as intellectual property, along with patents and copyright. The owner of a trade-mark, however, is not required to provide the public with some novel benefit, as with patents or copyrights,<sup>14</sup> in exchange for a monopoly. The purpose of trade-mark law is to distinguish the wares or services of one person or organization from those of others in the marketplace and, conse-

<sup>11</sup> Vaver, "Unconventional," *supra* note 1 at 2.

<sup>12</sup> Jerome Gilson & Anne Gilson Lalonde, "Cinnamon Buns, Marching Ducks and Cherry-Scented Racecar Exhaust: Protecting Nontraditional Trademarks" (2005) 95 TMR 773 ("An emotional connection to a brand makes the brand more compelling and engenders consumer loyalty, Lindstrom says" at 775); Martin Lindstrom, *BRAND sense: Build Powerful Brands Through Touch, Taste, Smell, Sight and Sound* (New York: Free Press, a division of Simon & Schuster, 2005) ("The research demonstrates that taste, touch and smell are intimately involved in creating a great brand experience and continued loyalty. The role of sound to create an emotional response is well documented. Sight may convey information well, but even at best it creates a less deeply felt emotional response" at 161).

<sup>13</sup> Vaver, "Unconventional," *supra* note 1 at 2; see also Appendix 1: Sound Marks Registrability by Jurisdiction in 2006, below.

<sup>14</sup> *Mattel U.S.A. Inc. v. 3894207 Canada Inc.*, [2006] 1 S.C.R. 772, ¶21 (S.C.C.) (Unlike patent law, which grants a time-limited monopoly to the patentee in return of the disclosure of his invention, and copyright law, which grants right of exploitation to the author of an original work and has the original purpose of encouraging culture and the distribution of expressive work in the human repertoire).

quently, guarantee the source of the goods.<sup>15</sup> In addition, trade-marks represent the reputation of the producer and help consumers identify and purchase a certain quality associated with this particular mark.<sup>16</sup> The goodwill, as it is embodied in a trade-mark, is therefore considered as valuable for the producer.<sup>17</sup>

The definition of a trade-mark provided by section 2 of the *TMA* reads as follows:

“trade-mark” means

- (a) a mark that is used by a person for the purpose of distinguishing or so as to distinguish wares or services manufactured, sold, leased, hired or performed by him from those manufactured, sold, leased, hired or performed by others,
- (b) a certification mark,
- (c) a distinguishing guise, or
- (d) a proposed trade-mark;

Subsection (a) of the above definition provides the fundamental components of a trade-mark.<sup>18</sup> First, a trade-mark must be “a mark” and second, it must be used for the purpose of distinguishing or so to distinguish wares or services of one person from those of another. In the sections that follow, these principal attributes and the different categories of trade-marks will be discussed in turn. This brief overview of fundamental elements will subsequently be useful in assessing the registrability of sound marks in Canada.

### (i) *Principal Attributes*

#### (A) A Mark

The word “mark” is unfortunately not defined by the *TMA*. Some consider the definition of the word to be presumably as broad as the term “symbol,” used in the *Unfair Competition Act*.<sup>19</sup> Others believe it could be co-extensive in meaning with

<sup>15</sup> David Vaver, *Intellectual Property Law* (Toronto: Irwin Law, 1997) at 176 [Vaver, *Intellectual*]; *United Artists Pictures Inc. v. Pink Panther Beauty Corp.*, [1998] 3 F.C. 534, 225 N.R. 82, 80 C.P.R. (3d) 247, ¶15 (Fed. C.A.); leave to appeal allowed (1998), 1998 CarswellNat 3295 (S.C.C.) [*Pink Panther*]; *Mishawaka Rubber & Woolen Manufacturing Co. v. S.S. Kresge Co.*, 316 U.S. 203 (1942) (the law’s recognition of the psychological function of symbols); *Perry v. Truefitt* (1842), 6 Beav. 66, 49 E.R. 749 (Eng. Rolls Ct.) (a man is not to sell his own goods under the pretence that they are the goods of another man).

<sup>16</sup> Canadian Intellectual Property Office, *A Guide to Trade-Marks* (Industry Canada, 2005) at 2 [CIPO, *Guide to Trade-Marks*]; World Intellectual Property Organisation, “What is a Trademark?” online: WIPO Resources <<http://www.wipo.int/trademarks/en/trademarks.html>>.

<sup>17</sup> *Kirkbi AG v. Ritvik Holdings Inc.*, 2005 SCC 65, [2005] 3 S.C.R. 302, ¶39 (S.C.C.).

<sup>18</sup> Gill & Jolliffe, *supra* note 3 at 3–6.

<sup>19</sup> *Unfair Competition Act*, S.C. 1932, c. 38, at para. 2(m); Gill & Jolliffe, *supra* note 3 at 3–12; Harold G. Fox, *The Canadian Law of Trade Marks and Unfair Competition*, 3d ed. (Toronto: Carswell, 1972) at 20; Sotiriadis & Carrière, *supra* note 7 at 25.

the old definition appearing in the *Trade Mark and Design Act*<sup>20</sup> or with the one in the *North American Free Trade Agreement*.<sup>21</sup> On the basis of the ordinary meaning of the word “mark,” however, the Federal Court of Canada decided in the 1987 *Playboy Enterprises Inc. v. Germain*<sup>22</sup> decision that a “mark” must be something that can be represented visually.<sup>23</sup> This position constitutes one of the main obstacles for the registration of sound marks in Canada and will be discussed in detail in the second part of this paper.

### (B) The Concept of Distinctiveness

“Distinctive,” in relation to trade-marks, means: “a trade-mark that actually distinguishes the wares or services in association with which it is used by its owner from the wares or services of others or is adapted so to distinguish them.”<sup>24</sup> Distinctiveness is the essence of a trade-mark because only a distinctive trade-mark will assure consumers of the origin and identity of the source of the goods from all others.<sup>25</sup> However, a mark does not need to be nationally distinctive in order to be registered, for example, it is possible for a mark to only be distinctive in Montreal and still be registered for all of Canada.<sup>26</sup>

A mark can be distinctive in one of two major ways. First, a mark can be inherently distinctive. For example, invented words like Kodak, Rolex and Lululemon fit into this category. These fanciful words are “adapted to distinguish” because they have the capacity without use to be accepted as trade-marks.<sup>27</sup> On the other hand, a generic sign may lack distinctiveness. For example, the term “drink” for alcoholic beverage would not normally be inherently distinctive because it is commonly used to describe the good itself.<sup>28</sup> Second, a mark can acquire distinctiveness, commonly called “secondary meaning.”<sup>29</sup> Acquiring secondary meaning implies that a word’s initial meaning evolves over time to include a second meaning, which becomes an indicator of source for products or services.<sup>30</sup> For instance,

<sup>20</sup> *Trade Mark and Design Act*, 31 Vict., c.55, at s. 5 — “all marks, names, labels, brands, packages or other business devices”; Gill & Jolliffe, *supra* note 3 at 3–12.

<sup>21</sup> *North American Free Trade Agreement*, 12 December 1992 (Ottawa: Supply & Services, 1993), art. 1708(1) (“any sign, or any combination of signs [. . .] including personal names, designs, letters, numerals, colors, figurative elements”); Vaver, *Intellectual*, *supra* note 15 at 188.

<sup>22</sup> *Playboy Enterprises Inc. v. Germain* (1987), 16 C.P.R. (3d) 517 (Fed. T.D.) [*Playboy*]  
<sup>23</sup> *Ibid.*, at 522.

<sup>24</sup> *TMA*, *supra* note 4 at s. 2.

<sup>25</sup> *Kirkbi*, *supra* note 17, at para. 39; Vaver, *Intellectual*, *supra* note 15 at 189-190.

<sup>26</sup> *TMA*, *supra* note 4 at ss. 18(1)(b), 38(2)(d); Vaver, *Ibid.* at 190.

<sup>27</sup> Vaver, *Ibid.* at 189.

<sup>28</sup> WIPO, Standing Committee on the law of trademarks, industrial designs and geographical indications, *Trademarks and Their Relation with Literary and Artistic Works*, WIPO doc. SCT/16/5 (2006), 16<sup>th</sup> Sess., at 6. [SCT/16/5]

<sup>29</sup> Vaver, *Intellectual*, *supra* note 15 at 189.

<sup>30</sup> *Ibid.* at 189; Daniel Gervais et Elizabeth F. Judge, *Le droit de la propriété intellectuelle* (Cowansville, Qc.: Yvon Blais, 2006) at 220-221.

words that are clearly descriptive or deceptively misdescriptive and nominal marks are not registrable<sup>31</sup> unless proof of distinctiveness is provided.<sup>32</sup> Marks like Allbran or Shredded Wheat may be examples of marks that can be seen as merely descriptive because they designate certain characteristics of the wares in question and, thus, are not initially “adapted” to distinguish products of one producer from others. However, through use and advertising, over time, these primarily clearly descriptive marks can acquire distinctiveness and then be registrable. Distinguishing guises,<sup>33</sup> for example, must become distinctive through use in order to be registrable.<sup>34</sup>

### (C) The Concept of “Use”

Use is a fundamental concept in trade-mark law. It is through use that trade-mark rights are acquired,<sup>35</sup> maintained and violated.<sup>36</sup> Without use, or proposed use, a trade-mark cannot be registered and, if it is registered, it can be expunged for non-use.<sup>37</sup> The definition of “use” differs whether the trade-mark is used in relation to wares or whether it is used in relation to services.<sup>38</sup> Though, in both situations, when determining if a trade-mark is used within the meaning of section 4 of the *TMA*, it is necessary to read this section together with the definition of a trade-mark in section 2 of the *TMA*.<sup>39</sup> Thus, a mere use is not enough. The use of a trade-mark needs to be made for the purpose of distinguishing products or services of one producer from others.<sup>40</sup> Therefore, the “use” within the meaning of the *TMA* does not always coincide with “use” in ordinary language.

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<sup>31</sup> *TMA*, *supra* note 4 at s. 12(1) (“Subject to section 13, a trade-mark is registrable if it is not (a) a word that is primarily merely the name or the surname of an individual who is living or has died within the preceding thirty years; (b) whether depicted, written or sounded, either clearly descriptive or deceptively misdescriptive in the English or French language of the character or quality of the wares or services in association with which it is used or proposed to be used or of the conditions of or the persons employed in their production or of their place of origin”).

<sup>32</sup> *TMA*, *ibid.* at s. 12(2) (“a trade-mark that is not registrable by reason of paragraph (1)(a) or (b) is registrable if it has been so used in Canada by the applicant or his predecessor in title as to have become distinctive at the date of filing an application for its registration”).

<sup>33</sup> For a definition, see section I.(a)(ii)(A), below.

<sup>34</sup> Vaver, *Intellectual*, *supra* note 15 at 187.

<sup>35</sup> Daniel R. Bereskin, “Trade-Mark “Use” in Canada” (1997) 87 TMR 301 at 301; *TMA supra* note 4 at s. 16.

<sup>36</sup> Sheldon Burshtein, “Trade-Mark “Use” in Canada: The Who, What, Where, When, Why and How — Part I” (1997) 11 I.P.J. 229 at 231.

<sup>37</sup> Vaver, *Intellectual*, *supra* note 15 at 193; *TMA*, *supra* note 4 at ss. 30(a), 45 and 57.

<sup>38</sup> Burshtein, *supra* note 36 at 235.

<sup>39</sup> *Cie générale des établissements Michelin — Michelin & Cie v. CAW-Canada* (1996), [1997] 2 F.C. 306 (Fed. T.D.); Bereskin, *supra* note 35 at 303-304.

<sup>40</sup> *Clairol International Corp. v. Thomas Supply & Equipment Co.* (1968), 55 C.P.R. 176 (Can. Ex. Ct.) [*Clairol*]; Burshtein, *supra* note 36 at 235; Bereskin, *ibid.*, at 303.

With respect to wares, a trade-mark is deemed to be used if “at the time of the transfer of the property in or possession of the wares, in the normal course of trade, it is marked on the wares themselves or on the packages in which they are distributed or it is in any other manner so associated with the wares that notice of the association is then given to the person to whom the property or possession is transferred.<sup>41</sup>” The trade-mark must appear on the wares themselves or on their packages, or must be otherwise associated with the wares when the property or the possession changes hands.

In the case of services, a mark is used when “it is used or displayed in the performance or advertising of those services.<sup>42</sup>” To constitute use of a trade-mark in Canada, it is important that the advertising of services be associated with the performance of the services in Canada.<sup>43</sup> The words “services” and “performance” are not defined in the *TMA*. The meaning of each of them is a question of fact to be determined in the circumstances of each case.<sup>44</sup>

## *(ii) Categories of Trade-Mark*

### *(A) Traditional Trade-Marks*

It is possible to separate trade-marks into five main categories: “classic” trade-marks, service marks, distinguishing guises, certification marks and proposed trade-marks.<sup>45</sup> The classic trade-mark, the most common type, is one that distinguishes one person’s product from another’s. Pepsi and Coca-Cola are famous examples of “classic” trade-marks. Service mark, like its name suggests, is a mark that distinguishes services performed by one person from those of another. In Canada, service marks only became registrable in 1954.<sup>46</sup> McDonald’s restaurant services is a common illustration of a service mark. When appearance is used for the purpose of distinguishing a product or service of one person from another, the way wares or their containers are shaped, wrapped or packaged<sup>47</sup> may also constitute a trade-mark known as distinguishing guises. For instance, the curved shape of the Coca-Cola original glass bottle is sufficient to distinguish it from other drinks. Certification marks are marks that distinguish products or services of a defined standard from others. An example of a typical certification mark could be the use of appellations of origin for foods and wines.<sup>48</sup> The last category includes “proposed trade-marks,” which, in fact, is not really a separate category. It is possible for an applicant under the *TMA* to apply to register a trade-mark before using it unless the

<sup>41</sup> *TMA*, *supra* note 4 at s. 4(1).

<sup>42</sup> *TMA*, *ibid.*, at s. 4(2).

<sup>43</sup> *Porter v. Don the Beachcomber* (1966), 48 C.P.R. 280 (Can. Ex. Ct.); *Sotiriadis & Carrière*, *supra* note 7 at 13; *Bereskin*, *supra* note 35 at 308; *Burshtein*, *supra* note 36 at 248.

<sup>44</sup> *Burshtein*, *Ibid.* at 249.

<sup>45</sup> *TMA*, *supra* note 4 at s. 2; *Vaver*, *Intellectual*, *supra* note 15 at 184.

<sup>46</sup> *Vaver*, *Ibid.*, at 185.

<sup>47</sup> *Ibid.*, at 187; *TMA*, *supra* note 4 at s. 2.

<sup>48</sup> *Vaver*, *Ibid.* at 188.

application is for a distinguishing guise or a certification mark.<sup>49</sup> The applicant needs, however, to intend to use it as a trade-mark in Canada.

### (B) Non-Traditional Trade-Marks: What is a Sound Mark?

Non-traditional marks comprise trade-marks that are not perceived as conventional. They are usually grouped into two major categories. The first category includes visible marks such as colour, shape, hologram and moving image. The second comprises non-visible marks like sounds, scents and tastes.<sup>50</sup> Sound marks constitute our particular concern in this essay. According to the World Intellectual Property Organization, sound marks may consist of:

musical sounds, 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>51</sup>

Similarly, the International Trademark Association defines sound marks as:

This type of mark may be a jingle or any piece of music or other sound. It may be a short extract from a composition or an entire musical piece. In some cases, it may be a reproduction of an everyday sound, perhaps in an unusual circumstance.<sup>52</sup>

A sound mark may be a jingle, a piece of music, an extract from a composition, an animal sound or any kind of sound as long as the sound mark distinguishes a person's wares or services from the wares or services of another.<sup>53</sup> For instance, the famous lion roar of MGM and the YaHOO Yodel have been registered in the United States.<sup>54</sup>

### (b) Registration in Canada: Common Law / Statutory Protection

Trade-marks can be protected in Canada through trade-mark registration (statutory protection) and through common law protection, mainly by the common law action of passing-off. While trade-marks are reasonably well protected by common

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<sup>49</sup> *Ibid.* at 186.

<sup>50</sup> JF. Bretonnière & Sophie Rodari, "Global Protecting and Eenforcing Non-Traditional Trademarks" (2009) Building and enforcing intellectual property value (IP Value 2009) 50 at 50.

<sup>51</sup> WIPO, Standing Committee on the law of trademarks, industrial designs and geographical indications, *Representation and Description of Non-Traditional Mmarks Possible Areas of Convergence* WIPO doc. SCT/19/2 (2008) 19th Sess. at 9 [SCT/19/2], online: WIPO <[http://www.wipo.int/edocs/mdocs/sct/en/sct\\_19/sct\\_19\\_2.pdf](http://www.wipo.int/edocs/mdocs/sct/en/sct_19/sct_19_2.pdf)>.

<sup>52</sup> International Trademark Association, "Nontraditional Trademarks," online: ITA <[http://www.inta.org/index.php?option=com\\_content&task=view&id=178&Itemid=59&getcontent=1](http://www.inta.org/index.php?option=com_content&task=view&id=178&Itemid=59&getcontent=1)>.

<sup>53</sup> Bretonnière & Rodari, *supra* note 50 at 51.

<sup>54</sup> Reg. Number: 1395550 and 2442140.



law, trade-mark registration is, nevertheless, frequently recommended as it provides important additional benefits.<sup>55</sup>

The registration of a trade-mark is valid across Canada, providing the owner of the trade-mark with an exclusive right to use the mark throughout the country.<sup>56</sup> The registration of a trade-mark in Canada may also be used as the basis for applications for similar protection in other countries.<sup>57</sup> By contrast, the passing-off action protects the trade-mark only in the area where it developed its reputation.<sup>58</sup> Furthermore, to succeed in a passing-off action, three elements need to be proved by the claimant: the existence of goodwill or reputation of the mark, the deception of the public due to a misrepresentation, and actual or potential damage to the plaintiff.<sup>59</sup> However, the goodwill of the mark and the defendant's misrepresentation can be very difficult and expensive to prove.<sup>60</sup> On the other hand, registration protects the trade-mark for goods and services for which it is registered without needing to prove damages or an attempt to deceive the public.<sup>61</sup>

Moreover, if an action is brought, the registration of a trade-mark is presumed to be valid for the goods and for the services for which it is registered.<sup>62</sup> Registration also provides protection against the depreciation of the goodwill associated with a trade-mark, even without any misrepresentation.<sup>63</sup>

Therefore, taking into account the various benefits and inconveniences, trade-mark registration provides undeniable advantages and, nevertheless, seems desirable in most cases to adequately protect a trade-mark.<sup>64</sup> Understanding why sound marks are not registrable in Canada and determining whether or not this position should be maintained becomes a matter of great interest.

<sup>55</sup> Vaver, *Intellectual*, *supra* note 15 at 175-176.

<sup>56</sup> CIPO, *A Guide to Trade-Marks*, *supra* note 16 at 3; *Pink Panther*, *supra* note 15 at para. 14.

<sup>57</sup> Vaver, *Intellectual*, *supra* note 15 at 178.

<sup>58</sup> *Ibid.*

<sup>59</sup> *Ciba-Geigy Canada Ltd. v. Apotex Inc.*, [1992] 3 S.C.R. 120 (S.C.C.), at 132 [S.C.R.]; *Kirkbi*, *supra* note 17 at 66.

<sup>60</sup> Vaver, "Unconventional," *supra* note 1 at 3.

<sup>61</sup> *Pink Panther*, *supra* note 15 at para. 14.

<sup>62</sup> *TMA*, *supra* note 4 at s. 19; CIPO, *A Guide to Trade-Marks*, *supra* note 16 at 3; Vaver, *Intellectual*, *supra* note 15 at 178.

<sup>63</sup> *TMA*, *ibid.*, at s. 22; CIPO, *A Guide to Trade-Marks*, *Ibid.*; Vaver, "Unconventional," *supra* note 1 at 5.

<sup>64</sup> Chris Bennett & Jeannine Tse, "Why Sound Marks Law Needs to Catch Up in Canada" (2009) Davis Publications at 14, online: <<http://www.davis.ca/en/publications>>.

## II. LEGAL CONSIDERATIONS SURROUNDING THE REGISTRATION OF SOUND MARKS

### (a) The Visual Requirement

#### (i) *Current Doctrine Set by the Jurisprudence*

In Canada, only one sound mark has successfully been registered as a trade-mark. In 1989, Capitol Records registered a rapid burst of 11 musical notes for audio tapes and quality services.<sup>65</sup> However, the mark was expunged in 2005 because it was not renewed.<sup>66</sup> Since 1989, applications to register sounds as trade-marks have been systematically refused by CIPOs.<sup>67</sup> This position relies on the Federal Court of Canada's *Playboy* decision.<sup>68</sup>

This case was an appeal from the decision of the Chairman of the opposition board refusing to expunge the trade-mark *Playboy* in favour of the respondent Michel Germain. The sole issue in the appeal before the Federal Court of Canada was whether the respondent had satisfied the requirements of section 44 of the *TMA* and had shown use of the trade-mark *Playboy* in association with hair pieces within the meaning of the definition of "trade-mark" in section 2 and of "use" in section 4 of the *TMA*.<sup>69</sup> Therefore, the issue was not the registrability or the definition of a trade-mark, but rather whether the trade-mark constituted use in association with wares.<sup>70</sup>

The Chairman of the Opposition Board's position was based on paragraph 10 of the respondent's affidavit, which states as follows:

From 1983 to the present no "Playboy" label has been affixed to a hair piece but rather the hair piece is verbally described to a customer and a purchaser as a "Playboy" hair piece.<sup>71</sup>

The Chairman was of the view that the word "mark" in the definition of trade-mark was "such a general term that it could potentially include within its scope most any indication which can be perceived by the senses."<sup>72</sup>

On judicial review, Pinard J. was of the opinion that the Chairman of the Opposition Board erred in law when he made those conclusions. Pinard J. held that: "the use of a verbal description is not use of a trade-mark within the meaning of the

<sup>65</sup> Reg. number: TMA359318, online: <<http://www.ic.gc.ca/app/opiccipo/trdmrks/srch/vwTrdmrk.do;jsessionid=00006XfvOoOzy0rJ6H0mEO95jbg:1247nfca5?lang=eng&fileNumber=0553825&extension=0&startingDocumentIndexOnPage=1>>; Sotiriadis & Carrière, *supra* note 7 at 24.

<sup>66</sup> *Ibid.*; Bennett & Tse, *supra* note 64 at 14.

<sup>67</sup> Canadian Intellectual Property Office, correspondence dated May 15<sup>th</sup>, 2009, *supra* note 1.

<sup>68</sup> *Playboy*, *supra* note 22.

<sup>69</sup> *Ibid.* at 520; *Aerosol Fillers Inc. v. Plough (Canada) Ltd.*, [1981] 1 F.C. 679 (Fed. C.A.), at 684 [F.C.].

<sup>70</sup> Macera & Finlayson, *supra* note 9 at 9.

<sup>71</sup> *Playboy*, *supra* note 22 at 521.

<sup>72</sup> *Ibid.*

*Trade Marks Act*. A “mark” must be something that can be represented visually.<sup>73</sup> Under this doctrine, trade-mark must be capable of being seen and, therefore, a sound mark would not be a mark.

### (ii) *An Outdated Approach*

Pinard J.’s interpretation of “mark” in the 1987 *Playboy* decision has major consequences on registrability of sound marks in Canada. Even if the main issue in this case was not the registrability of the mark but rather whether the mark constituted use in association with wares,<sup>74</sup> CIPO’s position of refusing to register sound marks is mainly based on Pinard J.’s interpretation of “mark.” This section will discuss the reasons for which this interpretation seems to be quite restrictive with today’s market place realities and should no longer be the standard for defining a “mark.”

As the word “mark” is undefined in the legislation, interpretation of its meaning becomes inevitable. In fact, according to the Canadian Report of the Trade-marks Committee of 1953,<sup>75</sup> there has intentionally been no definition of a “mark” included in the *TMA* in order to avoid a potentially restrictive interpretation.<sup>76</sup> It can, therefore, be argued that this open-ended definition suggests that the word “mark” should evolve with the constant development of society.<sup>77</sup> This position would be consistent with other types of intellectual property. For instance, in patent law,<sup>78</sup> an invention is broadly defined as: “any new and useful art, process, machine, manufacture or composition of matter, or any new and useful improvement in any art, process, machine, manufacture or composition of matter.”<sup>79</sup> Therefore, the definition of what constitutes an invention is broad because the law does not precisely define what technology is patentable as it is not possible for the legislator to anticipate what kinds of technologies will be developed in the future.<sup>80</sup>

In the *Playboy* decision, Pinard J. based his interpretation of what constitutes a “mark” on the “ordinary meaning” of the word “mark” that was adopted in two older cases of 1931 and 1979.<sup>81</sup> With the globalization of markets, the advent of

<sup>73</sup> *Ibid.*, at 522.

<sup>74</sup> Macera & Finlayson, *supra* note 9 at 12.

<sup>75</sup> Harold G. Fox, *The Canadian Law of Trade Marks and Unfair Competition*, 2d ed., v.2, (Toronto: Carswell, 1956) at 1142; *C.A.P.A.C. v. Maple Leaf Broadcasting Co.*, 18 C.P.R. 1, 1953 CarswellNat 1, [1953] Ex. C.R. 130, 13 Fox Pat. C. 101 (S.C.C.).

<sup>76</sup> Katharine McGinnis, “Whether Sound Marks Can and/or Should Be Registered as Trade-Marks in Canada” (2005) 19 Intellectual Property Journal 117 at 121.

<sup>77</sup> Vanessa Mackie, “Scent Marks The Future of Canadian Trade-Mark Law” (2004/2005) 18 Intellectual Property Journal 417 at 421.

<sup>78</sup> *Patent Act*, R.S.C. 1985, c. P-4 [*Patent Act*].

<sup>79</sup> *Ibid.*, at s. 2.

<sup>80</sup> *Ibid.*

<sup>81</sup> *Wright & Ropes Ltd. v. Broderick & Bascom Rope Co.*, [1931] Ex. C.R. 143; *Insurance Corporation of British Columbia v. Registrar of Trade Marks* (1979), 44 C.P.R. (2d) 1 (Fed. T.D.); *Playboy*, *supra* note 22 at 522; Justine Wiebe, “Recent Canadian IP Office Proposals Recognize Non-Traditional Trade-Marks” (2005) 25 The Lawyers Weekly 2 at para. 4.

the Internet and the increasing use of new technologies and of modern branding strategies, the adoption of a definition of the word “mark” (relying on a definition dating back to 1931), which imposes a visual requirement, seems to have become an outdated approach that is inconsistent with today’s realities.<sup>82</sup> The definition of the word “mark” should evolve with the development of society and not be limited to something that can be represented visually. This position is consistent with intellectual property law in general, for example, in the *Kirkbi AG v. Ritvik Holdings Inc.*<sup>83</sup> decision, Lebel J. states that “[t]he vast and expanding domain of the law of intellectual property is going through a period of major and rapid changes. The pressures of globalization and technological change challenge its institutions, its classifications and sometimes settled doctrines.<sup>84</sup>” Therefore, the ordinary meaning of the word “mark” is likely to have changed since 1931 to follow modern developments and, thus, is not necessarily the same.

Moreover, the requirement of being visually represented is certainly not in the *TMA*. “Trade-mark” is defined in section 2 of the *TMA* as a mark capable of being distinguished.<sup>85</sup> Nothing in the *TMA* appears to restrict a trade-mark only to what is visible, and section 2 of the *TMA* does not explicitly preclude a sound from being registrable as a mark.<sup>86</sup> Notably, there is no enumeration or exclusion of what can be a trade-mark.<sup>87</sup> Furthermore, the definition of “trade-mark” seems to be broad enough to encompass a sound mark because it is defined as a “mark.” Protecting marks that are capable of distinguishing the source of the wares or services is one of the primary goals of the *TMA*. The concept of trade-mark should, therefore, be interpreted broadly in view of this purpose. Emphasis should be put on whether the sound is distinctive enough to distinguish the wares and services of one source from those of another.<sup>88</sup> The nature of the mark alone should not prevent its registration.<sup>89</sup>

On the other hand, from a general perspective, a substantive policy matter related to the privatization of cultural assets in the public domain still remains.<sup>90</sup> After the expiry of copyright, a work falls into the public domain. In principle, it may be freely used, reproduced or communicated. The intention behind this principle is

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<sup>82</sup> Burshtein, *supra* note 36 at 234 (“The validity of the restriction to visual marks is based on a historical, and I submit, outdated interpretation of the word ‘mark.’ However, a non-visual use of a registered mark could constitute a infringement under section 20 because the activities constituting infringement are not limited to visual uses”); McGinnis, *supra* note 76 at 121; Canto, *supra* note 7 at 53.

<sup>83</sup> *Kirkbi*, *supra* note 17.

<sup>84</sup> *Kirkbi*, *ibid.*, at para. 37.

<sup>85</sup> *TMA*, *supra* note 4 at s. 2 (“a mark that is used by a person for the purpose of distinguishing or so as to distinguish wares or services manufactured, sold, leased, hired or performed by him from those manufactured, sold, leased, hired or performed by others”).

<sup>86</sup> Sotiriadis & Carrière, *supra* note 7 at 25.

<sup>87</sup> *Ibid.*

<sup>88</sup> Canto, *supra* note 7 at 55-56.

<sup>89</sup> McGinnis, *supra* note 76 at 122.

<sup>90</sup> Vaver, “Unconventional,” *supra* note 1 at 10.

to enhance the availability of works to the public and, thus, it may have a positive effect on creativity and on the development of new works.<sup>91</sup> Therefore, the acquisition by companies of trade-mark rights, for instance, of musical songs fallen into the public domain, raises several issues. If a company acquires such rights, it can prevent a third party, in the course of trade, from using the same mark or a similar one with regard to identical or similar goods or services.<sup>92</sup> However, the use of such a trade-mark, for private studies or teaching,<sup>93</sup> for example, will not fall within the scope of the trade-mark owner's exclusive right. The company will, thus, "partially" privatize a work that was previously part of the public domain. Such works may be important musical creations that have become part of our cultural heritage, and some concerns may be raised about the legitimacy of an individual's appropriation of such works for trade purposes.<sup>94</sup> For some, it is "an unnecessary encouragement for the whole public domain music repertoire to be privately re-appropriated for commercial ends."<sup>95</sup>

While these concerns must be seriously taken into account, it is important to keep in mind that such appropriation is partial and will not prevent the use of the registered musical mark for purposes not related to trade. Furthermore, trade-mark rights of public domain works would only constitute a part of what could be registered as sound marks, since sound marks may also be invented and non-musical. It has also been mentioned that the free use of musical works in the public domain by all traders may possibly confuse consumers.<sup>96</sup> For instance, if a company has used a musical work in such a way that consumers associate this distinctive musical work with its products or services, then the use of the same musical work by other companies could create confusion in the minds of consumers. Furthermore, such associations are often the result of substantial investment in marketing by the company. The use of the same musical work as trade-mark by other companies may be seen as unfair free-riding on the trade-mark's reputation.<sup>97</sup>

### **(iii) An International Perspective**

While Canada is reluctant to register sound marks, other jurisdictions have decided otherwise on this issue. The United States, the European Union and Australia allow sound marks to be registered.

<sup>91</sup> WIPO, Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications, *Relation of Established Trademark Principles to New Types of Marks*, WIPO doc. SCT/17/3 (2007) 17th Sess. at 10 [SCT/17/3].

<sup>92</sup> SCT/16/5, *supra* note 28 at 21; Article 16(1) of the *TRIPS Agreement*, online: WTO <[http://www.wto.org/english/tratop\\_e/trips\\_e/t\\_agm0\\_e.htm](http://www.wto.org/english/tratop_e/trips_e/t_agm0_e.htm)>; *TMA*, *supra* note 4 at s. 19.

<sup>93</sup> i.e., for purposes which are not trade-related.

<sup>94</sup> SCT/16/5, *supra* note 28 at 21.

<sup>95</sup> Vaver, "Unconventional," *supra* note 1 at 10.

<sup>96</sup> SCT/16/5, *supra* note 28 at 21.

<sup>97</sup> *Ibid.*

In the United States, the federal courts have expressly accepted the validity of sound marks. Their registration is commonplace today.<sup>98</sup> For example, the National Broadcasting Company (NBC) was the first to register the sound mark NBC chimes in 1950 for its radio broadcast services<sup>99</sup> and the famous lion roar of MGM was registered in 1986.<sup>100</sup> The *Lanham Act* codifies United States trademark law and defines a trade-mark as “any word, name, symbol, or device, or any combination thereof”<sup>101</sup> that identifies and distinguishes a person’s goods and services. Jurisprudence in the United States has a broad enough interpretation of the definition to include sounds.<sup>102</sup> In *Re General Electric Broadcasting Co.* decision, the Trademark Trial and Appeals Board (T.T.A.B.) stated that the nature of a mark was not a basis for refusing to register a trade-mark, if it acts as an indication of source; sounds may function as source indicators.<sup>103</sup> Likewise, in *Paramount Pictures Corp.*, the T.T.A.B. held that “. . . our trademark law is very liberal . . . as to what is registrable subject matter and that sounds may be registered as trademarks.”<sup>104</sup> Therefore, the registration of sound marks is well accepted in the United States.

In the European Union, sound marks are registrable. The *EU First Trademark Directive (89/104/EEC)* includes this definition of trademark: “A trademark may consist of any sign capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods and services of one undertaking from those of other undertakings.”<sup>105</sup> This definition contains examples of trademarks, and in the *Shield Mark* decision,<sup>106</sup> the European Court of Justice held that the list was not exhaustive.<sup>107</sup> Therefore, the focus in trade-mark registration is on whether the mark in question is capable of distinguishing the source of the goods or services and is capable of being represented graphically. If the two requirements are met, the registration cannot be refused on the basis of the intangible nature of the mark.<sup>108</sup> However, as we will discuss below, these conditions are quite restrictive.

<sup>98</sup> *Oliveira v. Frito-Lay*, 251 F.3d 56 (2d Cir. 2001), approving *Re General Electric Broadcasting Co.*, 199 U.S.P.Q. 560 (T.T.A.B., 1978) [*General Electric*]; Vaver, “Unconventional,” *supra* note 1 at 8.

<sup>99</sup> Reg. Number: 0523616; Méliisa E. Roth, “Something Old, Something New, Something Borrowed, Something Blue: A New Tradition in Nontraditional Trademark Registrations” (2005) 27 *Cardozo L. Rev.* 457 at 485.

<sup>100</sup> Reg. Number: 1395550; Bretonnière & Rodari, *supra* note 50 at 50.

<sup>101</sup> *Lanham Act*, s. 45, 15 U.S.C. 1127.

<sup>102</sup> McGinnis, *supra* note 76 at 122.

<sup>103</sup> *General Electric*, *supra* note 98 at 562-563.

<sup>104</sup> *Paramount Pictures Corp.*, 213 U.S.P.Q. 1111 at 1113 (T.T.A.B., 1982).

<sup>105</sup> Bretonnière & Rodari, *supra* note 50 at 52.

<sup>106</sup> *Shield Mark BV v. Joost Kist*, C-283/01, [2003] E.T.M.R. 64 [*Shield Mark*].

<sup>107</sup> Sarah Playle & Sarah Hodson, “Registering Sounds as Trade Marks” (2004) 11 *Journal of Brand Management* 331 at 332.

<sup>108</sup> *Shield Mark*, *supra* note 106.

In Australia, trade marks law has been amended to expressly include sounds within the definition of a sign.<sup>109</sup> The *Trade Marks Act 1995* defines a trade mark as “a sign used, or intended to be used, to distinguish goods or services dealt with or provided in the course of trade by a person from goods or services so dealt with or provided by any other person.”<sup>110</sup> Then, at section 6, a “sign” includes the following or any combination of the following, namely, any letter, word, name, signature, numeral, device, brand, heading, label, ticket, aspect of packaging, shape, colour, sound or scent.<sup>111</sup> Since these modifications, many applications for sound marks’ registration have been filed. To date, thirty-eight sound marks are registered and three are pending in Australia.<sup>112</sup>

The position of United States, Europe and Australia in relation to the registrability of sound marks reveals the changing realities of branding norms and the evolution of business over the past years. Canada should take into account the position of these jurisdictions in order to ensure its presence in a modern marketplace framework.

### (b) The Issue of “Use”

It is very important that a trade-mark fulfills the requirement of “use” in the sense of section 4 of the *TMA*,<sup>113</sup> as failing to do so may result in expungement of its registration.<sup>114</sup> On the basis that a “mark” must be something that can be represented visually,<sup>115</sup> Pinard J. ruled in the *Playboy* decision that:

in order to be deemed to be used in association with wares, at the time of the transfer of the property in or possession of such wares, *the trade mark must be something that can be seen*, whether it is marked on the wares them-

<sup>109</sup> One of the purposes of the introduction of the *Australian Trade Marks Act 1995* (Cth) was to broaden the definition of a trade mark. The *Australian Trade Marks Act 1995* (Cth), other than Part 1, commences on 1 January 1996 and The *Australian Trade Marks Act 1994* is repealed.

<sup>110</sup> *Australian Trade Marks Act 1995* (Cth) at s. 17

<sup>111</sup> *Australian Trade Marks Act 1995* (Cth) at s. 6

<sup>112</sup> As of April 20, 2010.

<sup>113</sup> *TMA*, *supra* note 4 at s.4.

(1) A trade-mark is deemed to be used in association with wares if, at the time of the transfer of the property in or possession of the wares, in the normal course of trade, it is marked on the wares themselves or on the packages in which they are distributed or it is in any other manner so associated with the wares that notice of the association is then given to the person to whom the property or possession is transferred.

(2) A trade-mark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

(3) A trade-mark that is marked in Canada on wares or on the packages in which they are contained is, when the wares are exported from Canada, deemed to be used in Canada in association with those wares.

<sup>114</sup> *TMA*, *supra* note 4 at ss. 45, 57, 18(1), 38(2)(a), 30(b); Sotiriadis & Carrière, *supra* note 7 at 15.

<sup>115</sup> *Playboy*, *supra* note 22 at 522.

selves or on the packages in which they are distributed or whether it is in any other manner so associated with the wares that notice of the association is then given to the person to whom the property or possession is transferred.<sup>116</sup>

If a trade-mark must be something that can be seen in order to be deemed to be used in association with wares, then, it eliminates the possibility of showing use of non-visual marks such as sound marks. However, as discussed above, such an interpretation of what may constitute a “mark” seems to be outdated. The nature of the mark should not be a barrier to its registration if this mark is used to distinguish one person’s wares or services from those of another.<sup>117</sup>

Moreover, there appears to be no persuasive reason why a mark that can be visually depicted when used, for example, when the mark is marked on the wares, should be distinguished from a mark that cannot. Judge Pinard understood the words “in any other manner” in s. 4(1) of the *TMA* as simply meaning that the mark can be associated with the wares by another manner than by being marked on the wares themselves or on the packages and *still be visible*.<sup>118</sup> This seems to be an unduly restrictive interpretation of section 4 of the *TMA*. For some, the words “in any other manner” and generally, the issue of use, should be interpreted with more flexibility; “[t]he issue of use, like all other factual issues must be regarded flexibly and creatively and should not be used as a device to limit registrability.”<sup>119</sup> Even if a sound mark cannot be marked on the wares themselves or on the packages, a sound mark could still be considered to be in another way associated with the goods.<sup>120</sup> The wording “in any other manner so associated with wares” of section 4 of the *TMA* could be interpreted as encompassing non-visual marks that cannot logically be fixed to the wares themselves or on the packages, but can be associated by other manners. Many countries have already accommodated the registration of non-visual marks, like sound marks, and it is still an open possibility for Canada. As discussed, the fundamental consideration for registration should be whether or not a sound mark is used or could be used to distinguish the goods or services of one party from another.<sup>121</sup>

However, even if we were to establish that the interpretation of the definition of “mark” and “use” are outdated and that they should include visual and non-visual marks, additional complexities remain. The substantial differences of the definition of “use” and whether it is used in relation to goods or services, as discussed earlier in this article remains problematic.<sup>122</sup> These differences could gener-

<sup>116</sup> *Playboy*, *supra* note 22 at 523 [emphasis added].

<sup>117</sup> Philip Lapin, “Smart & Biggar Response to CIPO Request for Comments — Re: Proposed Modernization of Trade-Mark Act” (2005) Smart & Biggar at 11, online: <<http://www.smart-biggar.ca/assets/CIPOResponse.pdf>>.

<sup>118</sup> *Playboy*, *supra* note 22 at 523.

<sup>119</sup> Macera & Finlayson, *supra* note 9 at 13.

<sup>120</sup> *Ibid.*

<sup>121</sup> International Trademark Association, Non-Traditional Trademarks Taskforce Issues and Policy Group, “A report on the Protection of Sound Trademarks” (1997) at 14, online: ITA <[http://www.inta.org/downloads/tap\\_sound1997.pdf](http://www.inta.org/downloads/tap_sound1997.pdf)>.

<sup>122</sup> For more details, see section I.(a)(i)(C), above.



ate difficulties in relation to the use of sound marks with wares. Actually, it would be common that sound marks be used through advertising, like in the case of jingles, or performance. However, a mark for services can be "used" in a television commercial or generally in non-point of sale advertising, whereas a mark for wares cannot.<sup>123</sup> Moreover, with respect to use in relation to wares, section 4 of the *TMA* requires that the association between the trade-mark and the wares be made "at the time of the transfer of the property in or possession of the wares." This requirement may raise some difficulties because the consumer may only listen to the sound mark after the time of purchase, when he will have bought and used the product.<sup>124</sup> For example, if a consumer purchases a videotape produced by MGM, he will hear the "lion's roar" only when he plays it, not at the cash register.<sup>125</sup> At the moment of purchase, the sound mark is not visible and is inaudible because the consumer will only listen to the videotape at home. Therefore, the sound mark may only become apparent to the consumer after the time of the transfer of the property in or possession of the wares.

To meet this requirement, some have proposed that the sound mark could be identified on the wares via written descriptions or graphical representations. However, this proposition may be difficult to implement. Would a merchant really affix to wares a graphic representation of the sound mark such as a musical notation on a staff? This solution does not seem to be feasible. Another possibility is to rely on jurisprudence dealing with the use of computer software marks. It was held that the display of a trade-mark on a computer screen, when the software was installed (thus after purchase), qualified as use within the meaning of section 4 of the *TMA*, even if the trade-mark had not been physically applied to a diskette or a package containing the software.<sup>126</sup> Therefore, it is arguable that the same logic could be extended to sound marks, which are only available to consumers after purchasing.<sup>127</sup> Using marketing techniques, such as putting in place interactive displays and advertising involving the sound mark at the point of sale could reinforce this position.<sup>128</sup>

<sup>123</sup> *Clairol*, *supra* note 40; *Vaver*, *Intellectual*, *supra* note 15 at 193; *McGinnis*, *supra* note 76 at 125.

<sup>124</sup> *Wiebe*, *supra* note 81 at 1; *Sotiriadis & Carrière*, *supra* note 7 at 27.

<sup>125</sup> *Macera & Finlayson*, *supra* note 9 at 12.

<sup>126</sup> Justine Weibe, "A Sense-ible Approach to Non-Traditional Trade-Marks" (2001) Bereskin & Parr publication at 7, online: Bereskin & Parr <<http://www.bereskinparr.com/FRE/News/IntellectualPropertyArticles/pdf/TM%20Sense-ible%20Wiebe.pdf>>; *McGinnis*, *supra* note 76 at 126; *BMB Compuscience Canada Ltd. v. Bramalea Ltd.* (1988), [1989] 1 F.C. 362 (Fed. T.D.); *R. c. Locquet* (1985), 5 C.P.R. (3d) 173 (Que. C.S.P.) (Similarly, use may comprise the appearance of a trade-mark on a video screen when produced by a computer program); *Riches, McKenzie & Herbert v. Source Telecomputing Corp.* (1992), 46 C.P.R. (3d) 563 (T.M. Bd.) (It has been held that the display of a trade-mark on the screen is use of the trade-mark in association with computer telephone access services).

<sup>127</sup> *Mackie*, *supra* note 77 at 423.

<sup>128</sup> *Ibid*; *McGinnis*, *supra* note 76 at 125-126.

### (c) Sound Marks' Distinctiveness

#### (i) *Inherently Distinctive or Acquired?*

Like traditional trade-marks, a sound mark must be distinctive in order to register goods or services to which it is applied. As discussed above, distinctiveness can be inherent or can be acquired through use, i.e., secondary meaning.<sup>129</sup> Some have suggested that non-traditional marks are unlikely to be regarded as inherently distinctive. It is argued that consumers do not typically view these marks as indicators of distinctive sources and, therefore, non-traditional marks would always need secondary meaning.<sup>130</sup> While this argument may be right for some types of non-traditional marks, such as shape or color marks, sounds have been used for a long time in the marketplace to distinguish companies and their products in order to reach consumers; jingles in advertisements are commonly used for this purpose.<sup>131</sup> Therefore, it is reasonable to say that, in some cases, a consumer who hears a unique sound may in fact associate it as an indicator of source of specific goods or services.<sup>132</sup>

In the United States, for instance, sound marks can be inherently distinctive, whereas color marks can never be and may only be registered on a showing of secondary meaning.<sup>133</sup> Indeed, in *Qualitex Co. v. Jacobson Products Co.* decision,<sup>134</sup> the Supreme Court of the United States held that no color mark can ever be inherently distinctive because: "a product's color is unlike "fanciful," "arbitrary," or "suggestive" words or designs, which almost automatically tell a customer that they refer to a brand."<sup>135</sup> However, a color mark may develop secondary meaning over time. Therefore, a color mark could be protected as a trademark, but only upon a showing of secondary meaning. The Supreme Court of the United States has reiterated this position in *Wal-Mart Stores Inc. v. Samara Bros. Inc.* decision in 2000.<sup>136</sup> Furthermore, it is interesting to note that in *Re General Electric Broadcasting Co.*<sup>137</sup> the Trademark Trial and Appeals Board mentioned that, like traditional trade-marks, sound marks may vary in terms of distinctiveness. A distinction must be made between sound marks that are "unique, different, or distinctive" and those that "resemble or imitate commonplace sounds or those to which listeners have been exposed under different circumstances."<sup>138</sup> In the situation

<sup>129</sup> Roth, *supra* note 99 at 468.

<sup>130</sup> Kevin K. McCormick, "Ding You Are Now Free to Register that Sound" (2006) 96 TMR 1101 at 1119.

<sup>131</sup> *Ibid*; McGinnis, *supra* note 76 at 131-132.

<sup>132</sup> *Ibid*.

<sup>133</sup> *General Electric*, *supra* note 98; *Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159, 34 U.S.P.Q. 2d 1161 (U.S. Sup. Ct., 1995) [*Qualitex*]; *Wal-Mart Stores Inc. v. Samara Bros. Inc.*, 529 U.S. 205 (U.S. Sup. Ct., 2000) [*Wal-Mart*]; Roth, *supra* note 99 at 472; McGinnis, *supra* note 76 at 131.

<sup>134</sup> *Qualitex*, *ibid*.

<sup>135</sup> *Ibid*. at 163; *Wal-Mart*, *supra* note 133.

<sup>136</sup> *Ibid*.

<sup>137</sup> *General Electric*, *supra* note 98.

<sup>138</sup> *Ibid*. at 563.

where the mark is formed by commonplace sounds, the applicant must provide evidence that the mark has acquired secondary meaning.<sup>139</sup> These distinctions are made in accordance with the standard traditional trade-mark's spectrum of distinctiveness in Canada, i.e., from fanciful marks to generic ones. Indeed, an invented and fanciful word like "Kodak" would generally possess more inherent distinctiveness than a suggestive mark such as "mini-wheat" when used in relation to cereals.<sup>140</sup> Considering that a unique invented sound mark is more likely to be inherently distinctive than a commonplace one, seems to be in compliance with current practices surrounding traditional trade-marks in Canada. CIPO should make a distinction between unique or fanciful sounds and commonplace sounds in terms of distinctiveness, similar to what has been done in the United States.

### *(ii) Proof of Secondary Meaning*

Proof of acquired distinctiveness or secondary meaning of a sound mark, based on section 12(2) of the *TMA*, could be conducted like it is usually done with traditional trade-marks. The evidence of acquired secondary meaning must be strong and convincing in order to prove that a mark is distinctive. Thus, the onus on an applicant who contends that a mark has come to acquire distinctiveness could be a heavy one.<sup>141</sup> Moreover, some have mentioned that consumers are not necessarily used to making a correlation between products or services and non-traditional marks, such as sound marks, as much as they are for traditional ones. It could, therefore, be even more difficult to establish the acquired distinctiveness of a sound mark than of a word mark.<sup>142</sup> However, proving that a mark has acquired a secondary meaning must be presented in a factual manner. Therefore, depending on the case, establishing a secondary meaning for a sound mark could be more or less difficult. For instance, it could be easier to establish a secondary meaning for a well-known sound mark, such as the Pillsbury Giggle.

Proof that a mark has come to acquired distinctiveness may be filed by way of affidavit or statutory declaration meeting the requirements of section 32(1) of the *TMA*.<sup>143</sup> The application must first contain a master affidavit submitted by some-

<sup>139</sup> John Gabrielides & Thomas Williams, "The Sound of Unconventional Marks in the United States" (2007) *World Trademark Review* (July 10) at 95.

<sup>140</sup> Canadian Intellectual Property Office, *Trade-Marks Examination Manual* (1996) at 73, online: <http://www.cipo.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/wr01644.html> [TMEM].

<sup>141</sup> *Ibid.* at 196; *Standard Coil Products (Canada) Ltd. v. Standard Radio Corp.* (1971), 1 C.P.R. (2d) 155 (Fed. T.D.), at 172 [C.P.R.], affirmed (1976), 1976 CarswellNat 529 (Fed. C.A.); *Carling Breweries Ltd. v. Molson Cos.* (1984), 1 C.P.R. (3d) 191 (Fed. T.D.); affirmed (1988), 1988 CarswellNat 539 (Fed. C.A.).

<sup>142</sup> SCT/17/3, *supra* note 91 at 4.

<sup>143</sup> *TMA*, *supra* note 4 at s. 32(1) ("An applicant who claims that his trade-mark is registrable under subsection 12(2) or section 13 shall furnish the Registrar with evidence by way of affidavit or statutory declaration establishing the extent to which and the time during which the trade-mark has been used in Canada and with any other evidence that the Registrar may require in support of the claim").

one having first-hand knowledge of the current situation.<sup>144</sup> The affidavit should contain certain information, such as: a statement of the nature of use of the mark in association with the wares or services, the length of time and the extent of this use,<sup>145</sup> an explanation related to the association of the mark at the time of the transfer of property or possession of the wares, etc.<sup>146</sup> As discussed earlier,<sup>147</sup> this last element may be problematic in some cases in which sound marks are used in relation with wares. Indeed, sound marks may only be heard after the transfer of property or possession of the goods. Additional affidavits from distributors, advertising agencies, retailers and users of the goods, who can attest to the secondary meaning of the mark, may also be submitted, although they are not usually required.<sup>148</sup>

Finally, surveys may also be used as evidence that the mark has acquired distinctiveness.<sup>149</sup> Indeed, surveys and their results are currently commonly used by companies for many of their business decisions. However, to be accepted as evidence, an expert in designing and interpreting survey results must carry it out. Moreover, the strategy and the statistical basis of the survey needs to be established, and the form and type of questions asked have to be explained.<sup>150</sup> Therefore, a properly conducted survey can normally be accepted as evidence. For instance, surveys have been admissible as evidence of secondary meaning in *Aluminium Goods Ltd. v. Registrar of Trade Marks*<sup>151</sup> and in *Canadian Schenley Distilleries Ltd. v. Canada's Manitoba Distillery Ltd.*<sup>152</sup> In the case of sound marks, surveys could be done by phone or by the Internet; respondents would, thus, be able to listen to the sound mark in issue in order to answer the survey's questions.

### (iii) *The Doctrine of Functionality*

In Canada, the registration of a mark should not interfere with the use of any utilitarian feature embodied in this mark.<sup>153</sup> If the mark is mainly functional, namely when the feature is “solely, primarily or essentially” functional, the mark

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<sup>144</sup> TMEM, *supra* note 140 at 190-191.

<sup>145</sup> *Ibid.*, at 191-192 (“The extent of use may be stated in terms of units, dollar volume of sales, or percentage of the market for the wares or services performed, sold, leased or hired in association with the mark. The evidence may refer to the mode of distribution, the number of distributors, and the number of outlets in which the product or services associated with the mark is offered for sale”).

<sup>146</sup> See TMEM, *ibid.*, at 191.

<sup>147</sup> See section II.(b), above.

<sup>148</sup> TMEM, *supra* note 140 at 192.

<sup>149</sup> *Ibid.*, at 192-193.

<sup>150</sup> *Ibid.*, at 193.

<sup>151</sup> *Aluminium Goods Ltd. v. Registrar of Trade Marks* (1954), 19 C.P.R. 93 (Can. Ex. Ct.).

<sup>152</sup> *Canadian Schenley Distilleries Ltd. v. Canada's Manitoba Distillery Ltd.* (1975), 25 C.P.R. (2d) 1 (Fed. T.D.).

<sup>153</sup> *TMA*, *supra* note 4 at s. 13(2).

cannot be distinctive and thus, is unregistrable.<sup>154</sup> For example, in a case involving the well-known LEGO construction sets for children, the trial judge found that the “LEGO indicia”<sup>155</sup> was purely functional and, therefore, could not be the basis of a trade-mark, whether registered or unregistered.<sup>156</sup> This doctrine of functionality reflects the essence of the purpose of trade-marks. It recognized that trade-marks are intended to protect the distinctiveness of a product, not to create and to protect a monopoly on the product that could ultimately prevent fair competition within the industry.<sup>157</sup> This logical principle of trade-mark law has also been incorporated into the *Lanham Act* in the United States<sup>158</sup> and is applied in Europe by a directive of the European Commission.<sup>159</sup>

The functionality doctrine is not an absolute obstacle to the registration of sound marks in Canada. As for a traditional mark, if a sound mark is distinctive and is not primarily functional, then the registration should not be barred. However, commonplace sounds may face particular challenges related to the doctrine of functionality.<sup>160</sup> For example, the sound of a lawn mower motor would not be registrable in relation to lawn mowers without evidence of factual distinctiveness. Indeed, such registration could block legitimate competition from other traders, who need to use the sound of lawn mower motors for their similar goods. Similarly, the application of registration for a Harley Davidson muffler sound<sup>161</sup> caused a lot of discussion in the United States. Nine motorcycle competitors raised objections to its registration invoking that the exhaust sound was purely functional. On the other hand, Harley Davidson argued that while the mark was utilitarian in origin, there were modifications to the engine resulting in a unique sound. The issue of whether the Harley Davidson muffler sound was functional was never decided because Har-

<sup>154</sup> *Vaver, Intellectual*, *supra* note 15 at 192; *Remington Rand Corp. v. Philips Electronics N.V.* (1995), 64 C.P.R. (3d) 467 (Fed. C.A.), at 475 [C.P.R.], leave to appeal refused (1996), 1996 CarswellNat 3160 (S.C.C.); McGinnis, *supra* note 76 at 132.

<sup>155</sup> *Kirkbi*, *supra* note 17 at para. 2 (“the upper surface of the block with eight studs distributed in a regular geometric pattern”).

<sup>156</sup> *Ibid.*, at 40–61.

<sup>157</sup> *Ibid.*, at 42–43 (“It reflects the purpose of a trade-mark, which is the protection of the distinctiveness of the product, not of a monopoly on the product”).

<sup>158</sup> *Lanham Act*, *supra* note 101 at s. 1052(e)(5); *TrafFix Devices Inc. v. Marketing Displays Inc.*, 532 U.S. 23 at 34 (U.S. Sup. Ct., 2001); *Wal-Mart*, *supra* note 133 at 211 (The Supreme Court of the United States has held that purely functional features may not become the basis of trade-marks); *Kirkbi*, *supra* note 17 at 48.

<sup>159</sup> First Council Directive 89/104, *Encyclopedia of European Community Law* (EEC), art. 3(1)(e); see also L. Bently & B. Sherman, *Intellectual Property Law* (2nd ed. 2004) at 794–96; *Kirkbi, Ibid.*, at 49 (“EU does not allow the registration of purely functional trade-marks. It prohibits the registration as marks of signs which consist exclusively of a shape which is necessary to obtain a technical result”).

<sup>160</sup> SCT/17/3, *supra* note 91 at 8.

<sup>161</sup> *Kawasaki Motors Corp., U.S.A. v. H-D Michigan, Inc.*, 43 U.S.P.Q. 2d 1521 (T.T.A.B., 1997) [*Kawasaki Motors Corp.*] (“the exhaust sound of the applicant’s motorcycles produced by V-Twin, common crankpin motorcycle engines when the goods are in use”); Sotiriadis & Carrière, *supra* note 7 at 31.

ley Davidson abandoned its application in 2000.<sup>162</sup> Therefore, applicants should be aware that if the sound mark has a primarily functional use, the application could be refused.<sup>163</sup>

#### (d) The Possibility of Overlapping with Copyright Protection

In the case of a sound mark consisting of musical sounds, it could be possible that a single sound mark may also be protected as a “musical work” under the *Copyright Act*.<sup>164</sup> Indeed, a musical sound mark can be protected by copyright assuming that it fulfills the criteria required under the *Copyright Act*, such as the criteria of originality and of fixation.<sup>165</sup> The fact that a sound mark can also be protected by copyright should not be a major obstacle to its registration as a trade-mark as the coexistence of copyright and trade-mark has “already been recognized, especially with respect to artistic works.”<sup>166</sup>

The possibility of overlap between trade-mark and copyright law was discussed in the recent *Euro-Excellence* decision,<sup>167</sup> in which the Supreme Court of Canada established whether or not “a work of art appearing on a label and receiving trade-mark protection could also be the subject of copyright protection.”<sup>168</sup> The Court concluded that section 64 of the *Copyright Act* was adopted by the Parliament having in mind that works could receive concurrent copyright and trade-mark protection.<sup>169</sup> By enacting section 64, the Parliament authorized the possibility of such overlap.

This interpretation was made in the case of artistic work, in which the object of protection was a logo on a chocolate bar wrapper. The question, whether the same logic could be extended to sound marks and musical work, may be asked. Nothing seems to prevent us from extending the same logic to sound marks and musical work. In fact, the Court stated in a general way that, “[i]n contrast, s. 64(3)(b) of the *Copyright Act* permits a single work to be the subject of both copyright and trade-mark protection. In other words, Parliament has authorized an overlap between copyright and trade-mark.”<sup>170</sup> This interpretation seems broad enough to encompass many different kinds of work.

<sup>162</sup> McCormick, *supra* note 130 at 1120.

<sup>163</sup> TMEM, *supra* note 140 at 99.

<sup>164</sup> *Copyright Act*, R.S.C. 1985, c. C-42, s. 2.

<sup>165</sup> *Copyright Act*, *supra* note 164 at s. 5(1) (“Subject to this Act, copyright shall subsist in Canada, for the term hereinafter mentioned, in every original literary, dramatic, musical and artistic work . . .”); *CCH Canadian Ltd. v. Law Society of Upper Canada*, [2004] 1 S.C.R. 339 (S.C.C.); Vaver, *Intellectual*, *supra* note 15 at 41.

<sup>166</sup> Sotiriadis & Carrière, *supra* note 7 at 25; Hugues G. Richard (dir.) et al., *Canadian Copyright Act Annotated* (Toronto: Carswell, 1993) at S5.9.2–S7.1.5.

<sup>167</sup> *Kraft Canada Inc. c. Euro Excellence Inc.*, 2007 CarswellNat 2087, (sub nom. *Euro Excellence Inc. v. Kraft Canada Inc.*) [2007] 3 S.C.R. 20 (S.C.C.).

<sup>168</sup> *Ibid.*, at para. 9.

<sup>169</sup> *Copyright Act*, *supra* note 164 at s. 64(3)(b) (“(3) Subsection (2) does not apply in respect of the copyright or the moral rights in an artistic work in so far as the work is used as or for: (b) a trade-mark or a representation thereof or a label”)

<sup>170</sup> *Euro-Excellence*, *supra* note 167 at para.13.

Furthermore, while it is important to keep in mind the distinctions between different forms of intellectual property and their legal and economic functions,<sup>171</sup> the Court specified that this guiding principle should be completed “by the proviso: except where Parliament provides otherwise.”<sup>172</sup> Therefore, because Parliament has authorized the duality of protection provided by trade-mark and copyright, the Court is bound to conclude that such concurrence is possible. This logic is also in accordance with the reasoning in the *Kirkbi* decision where the Court relied on the functionality doctrine, incorporated in s. 13(2) of the *TMA*, in order to rule that there could be no overlap between patent and trade-mark. Indeed, while the Court mentioned that trade-mark law should not be interpreted in a way that undermines patent law, the decision was based on the actual functionality doctrine and its correlative provision in the *TMA*, which “precluded the granting of trade-mark protection to functional works, which are the subjects of patent law.”<sup>173</sup> Following this reasoning, and until the Parliament provides otherwise, the overlap between copyright and trade-mark protection is possible and should not be a barrier to the registration of sound marks.

With these points in mind, a more fundamental issue remains. While copyright protection is limited in time, the trade-mark owner may enjoy exclusive rights indefinitely, if the trade-mark is used and renewed every 15 years.<sup>174</sup> Therefore, one may wonder if copyright protection could be extended beyond its natural term through trade-mark protection, similar to what LEGO was trying to do in the *Kirkbi* decision when its patent expired. In this decision, it was mentioned that trade-mark law should not be used in a way to perpetuate monopoly rights enjoyed under a patent's protection when it expires.<sup>175</sup> In terms of copyright law, the question is whether the objectives underlying the temporally limited protection of copyright in a work can be reconciled with the maintenance of trade-mark protection in the same work after copyright has expired. For some, the work should fall into the public domain completely. For others, it could be acceptable if it became free for uses that are not covered by the scope of trade-mark rights. For instance, uses that are not trade-related or uses in trade that do not concern the same or similar products or services.<sup>176</sup>

Lastly, when a company is using sounds as trade-marks, it should be aware that these sounds may already be protected under copyright. Therefore, without the authorization of the copyright owner, the use of the musical work in question or a substantial part of it as a trade-mark could constitute an unauthorized reproduction according to section 3 of the *Copyright Act* and, thus, an infringement in the sense of section 27 of the same Act. This possibility should always be carefully considered when applying for the registration of trade-marks in order to avoid copyright infringement.

<sup>171</sup> *Kirkbi*, *supra* note 17 at para. 37; *Euro-Excellence*, *supra* note 167 at para. 13.

<sup>172</sup> *Euro-Excellence*, *ibid.* at para. 13.

<sup>173</sup> *Ibid.* at para. 12.

<sup>174</sup> *TMA*, *supra* note 4 at s. 46; *Copyright Act*, *supra* note 164 at s. 6; SCT/16/5, *supra* note 28 at 20.

<sup>175</sup> *Kirkbi*, *supra* note 17 at paras. 40–61.

<sup>176</sup> SCT/16/5, *supra* note 28 at 20.

### III. PRACTICAL CONSIDERATIONS ASSOCIATED WITH THE DESCRIPTION OF SOUND MARKS

#### (a) The Difficulty of Describing Sounds

In many jurisdictions, such as the United States, Australia and the European Union, there is a requirement for some form of graphical representation within trade-mark legislation. This graphic representation requirement constitutes one of the most problematic issues related to the registration of sound marks. In Canada, unless the application for a mark only consists of a word, or words, not depicted in a special form, an applicant needs to file a drawing of the trade-mark in order to register it.<sup>177</sup> Translating a non-visual mark, such as a sound mark, into a visual representation, a drawing, can be a challenge. Indeed, the sound mark needs to be clearly translated into a graphic representation in order to keep the essence of the registration.<sup>178</sup> The form of graphic representation should also allow the public to consult and understand the nature of the mark and the scope of protection.<sup>179</sup> Consequently, a very technical description or a non-accessible or unusual mode of representation would be considered inappropriate.<sup>180</sup>

Therefore, it is essential to evaluate if the drawing representation system is the appropriate method for indexing sound marks in Canada. Other jurisdictions in which these difficulties have not prevented the registration of sound marks may offer guidance for Canada in order to establish how sounds can be adequately described and depicted for indexing and searching purposes. In turn, three representation systems will be discussed: the United States' descriptive representation system, the European Union's graphic representation system and Australia's hybrid representation system.<sup>181</sup>

#### (b) Existent Graphical Representation Systems

##### (i) *United States' Descriptive Representation System*

Various sound marks are currently registered in the United States. Some well-known examples of these sound marks are the MGM Lion Roar, the YaHOO Yodel and the Pillsbury Giggle.<sup>182</sup> In fact, the United States has adopted the most liberal

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<sup>177</sup> *TMA*, *supra* note 4 at s. 30(h) ("An applicant for the registration of a trade-mark shall file with the Registrar an application containing: (h) unless the application is for the registration only of a word or words not depicted in a special form, a drawing of the trade-mark and such number of accurate representations of the trade-mark as may be prescribed").

<sup>178</sup> McGinnis, *supra* note 76 at 134.

<sup>179</sup> SCT/19/2, *supra* note 51 at 3 ("Most importantly, in relation to non-traditional marks, the representation should demonstrate the nature of the mark and show its features clearly enough to permit proper examination and at a later stage, adequate determination of the nature and scope of the protection granted to a particular sign").

<sup>180</sup> *Ibid.*

<sup>181</sup> McCormick, *supra* note 130 at 1105.

<sup>182</sup> Macera & Finlayson, *supra* note 9 at 3; Reg. number: 1395550, 2442140 and 2692077.



approach of any jurisdiction to the registration of sound marks.<sup>183</sup> As long as the mark is used as an indicator of source and meets statutory requirements, it should be registrable.<sup>184</sup> The way that a sound mark is filed in the United States is described in sections 807.09, 1202.13 and 1202.15 of the *Trademark Manual of Examination Procedure* (TMEP). A sound mark is defined in the TMEP as a mark that “identifies and distinguishes a product or service through audio rather than visual means.”<sup>185</sup> Following this definition, a detailed description of the sound mark is required, whereas no drawing needs to be submitted. The detailed description of the sound mark is recognized “as the accepted scope of the mark being sought.”<sup>186</sup> The applicant can also submit an audio or video reproduction of the sound mark to supplement the description.<sup>187</sup>

As a result, sound marks have been registered with descriptions using onomatopoeia, listed musical notes and declaratory phrases. This method waives the drawing requirement and, thus, has the advantage of relieving some of the difficulties related to the visual representation of the mark, as in the case of non-musical sound marks. However, the issue of clearly and accurately representing sound marks through a written description still remains. In fact, some sound marks are very detailed, like the famous Tarzan yell:<sup>188</sup>

The mark consists of the sound of the famous Tarzan yell. The mark is a yell consisting of a series of approximately ten sounds, alternating between the chest and falsetto registers of the voice, as follow — 1) a semi-long sound in the chest register, 2) a short sound up an interval of one octave plus a fifth from the preceding sound, 3) a short sound down a Major 3rd from the preceding sound, 4) a short sound up a Major 3rd from the preceding sound, 5) a long sound down one octave plus a Major 3rd from the preceding sound, 6) a short sound up one octave from the preceding sound, 7) a short sound up a Major 3rd from the preceding sound, 8) a short sound down a Major 3rd from the preceding sound, 9) a short sound up a Major 3rd from the preceding sound, 10) a long sound down an octave plus a fifth from the preceding sound.

While a detailed description could represent the sound more precisely, it could, on the other hand, lack concision. Shorter descriptions are sometimes ambiguous. For example, “the [Pillsbury Giggle] mark consists of the sound of a childlike

<sup>183</sup> McCormick, *supra* note 130 at 1105.

<sup>184</sup> *General Electric*, *supra* note 98 at 562-563.

<sup>185</sup> United States Patent and Trademark Office, *Trademark Manual of Examination Procedure* (2007) at s.1202.15, online: <<http://tess2.uspto.gov/tmdb/tmep/>> [TMEP].

<sup>186</sup> *Kawasaki Motors Corp.*, *supra* note 161; McCormick, *supra* note 130, at 1106.

<sup>187</sup> TMEP, *supra* note 185 at s. 807.09 and 1202.15 (“The reproduction should contain only the mark itself; it is not meant to be a specimen. The specimen is used to show that the sound mark actually identifies and distinguishes the goods/services and indicates their source. The specimen should contain a sufficient portion of the audio or video content to show how the mark is used on or in connection with the goods/services”).

<sup>188</sup> Reg. Number: 2210506.

human giggle which represents the Pillsbury Doughboy giggle,”<sup>189</sup> or the mark of the AWS Convergence Technologies “consists of a series of five chirps similar to the chirping sound of a cricket.”<sup>190</sup> Therefore, in many cases, it is difficult to transfer the written description into an aural impression and to determine the scope of the mark.<sup>191</sup>

### (ii) *European Union’s Graphic Representation System*

In the European Union, sound marks are registrable under certain conditions. A sound mark must be represented graphically. This requirement of graphic representation has been interpreted by the European Court of Justice (E.C.J.) in a case of olfactory marks. The E.C.J. states that the representation needs to be “clear, precise, self-contained, easily accessible, intelligible, durable and objective.”<sup>192</sup> The same criteria were applied in 2004 in the *Shield Mark* decision which dealt with sound marks and their graphic representation.<sup>193</sup> In addition, the E.C.J. states that a trade-mark must not deprive the trade or the public of signs that should be free to all.<sup>194</sup>

In relation to the requirement of graphic representation, the E.C.J. held that a detailed musical notation on a stave divided into bars and showing clefs, musical notes, rests, pitch and duration or a sonogram, with a timescale and a frequency scale,<sup>195</sup> in principle satisfies this requirement for sound marks<sup>196</sup>. With this quite restrictive interpretation of graphic representations, the E.C.J. discredited the use of some other possibilities. For instance, a mere written description such as “the first nine notes of *Für Elise*” or “the sound of a cockcrow” would often lack clarity and precision.<sup>197</sup> Therefore, according to the E.C.J., it would be difficult to determine the scope of the protection of the mark. However, not all written descriptions are necessarily automatically precluded.<sup>198</sup> The use of onomatopoeia<sup>199</sup> is another ex-

<sup>189</sup> Reg. Number: 2692077.

<sup>190</sup> Reg. Number: 2827972.

<sup>191</sup> McCormick, *supra* note 130 at 1111; Roth, *supra* note 99 at 486.

<sup>192</sup> *Sieckmann v. Deutsches Patent und Markenamt*, C-273/00, [2003] E.T.M.R. 37, ¶55.

<sup>193</sup> Bretonnière & Rodari, *supra* note 50 at 52; *Shield Mark*, *supra* note 106.

<sup>194</sup> *Windsurfing Chiemsee v. Boots*, [1999] E.T.M.R. 585 (E.C.J.); Vaver, “Unconventional,” *supra* note 1 at 4.

<sup>195</sup> McCormick, *supra* note 130 at 1110; *Shield Mark*, *supra* note 106; *Metro Goldwyn-Mayer Lion Corp’s Application No. 143891*, R-781/1999-4, [2004] E.T.M.R. 34 [*MGM Application*].

<sup>196</sup> *Shield Mark*, *supra* note 106; Roth, *supra* note 99 at 483.

<sup>197</sup> McCormick, *supra* note 130 at 1111; *Shield Mark*, *supra* note 106 (the opening bars of Beethoven’s “*Für Elise*” and another set of a cockcrow crowing were the main trade-marks that were at issue in the case).

<sup>198</sup> Roth, *supra* note 99 at 483.

<sup>199</sup> Onomatopoeia is defined as: “the creation and use of words which include sounds that are similar to the noises that the words refer to.” “Pop”, “boom” and “squelch” are examples of onomatopoeic words. Cambridge Dictionaries, *s.v.* “onomatopoeia,” online: <<http://dictionary.cambridge.org/>>

ample of a graphic representation discredited by the E.C.J. Indeed, the use of onomatopoeia does not meet the requirement because there could be a lack of consistency between the onomatopoeia and the actual sound.<sup>200</sup> Finally, a third approach discredited by the E.C.J. is the use of musical notation in sequential order to represent the sound. For instance, “the first nine notes of *Für Elise*” could be described as: E, D#, E, D#, E, B, D, C, A. According to the E.C.J., this kind of sequence of musical notes alone will ignore important information such as pitch and duration of the melody<sup>201</sup> and, thus, will not meet the requirement of graphic representation.

While the European position presents some advantages in terms of clarification and precision of the sound mark compared to the use of a written description, some argue that it still poses some difficulties. Not everyone can read and understand a detailed musical notation on a staff and even fewer, a sonogram.<sup>202</sup> However, on this last point, the Board of Appeals in *Metro-Goldwyn-Mayer Lion Corp's Application* rejected the argument that a sonogram is unintelligible because consumers cannot read it. It is true that some knowledge is needed to fully understand a sonogram, however, according to the Board of Appeals, the same is true for a musical notation and nobody seriously contests the fact that it is an adequate way of representing sound marks graphically.<sup>203</sup> In fact, a sonogram would, in principle, satisfy the graphic representation requirement because it indicates volume, pitch and progression over time. Moreover, it could be argued that, in some cases, using a sonogram may be a better way to describe sounds than with musical notations since more sound characteristics may be depicted.<sup>204</sup>

### (iii) Australia's Hybrid Representation System

In Australia, the application for registration must include both a graphical representation and a clear and concise description of the trade-mark<sup>205</sup> to ensure that it is adequately represented.<sup>206</sup> Eight separate recordings of the sound (e.g. compact disc) are required to support an application.<sup>207</sup> The applicant should also state that the trade-mark is a sound trade-mark to be indexed in such a category.

<sup>200</sup> McCormick, *supra* note 130 at 1111.

<sup>201</sup> Playle & Hodson, *supra* note 107 at 332-333 (“The ECJ decision was based only on the graphic representation in issue. Therefore, it did not rule on all kind of registration, such as a sound recording annexed to the registration form or a digital recording accessible through the Internet”).

<sup>202</sup> McGinnis, *supra* note 76 at 135.

<sup>203</sup> Roth, *supra* note 99 at 484; *MGM Application*, *supra* note 195.

<sup>204</sup> *Ibid.*

<sup>205</sup> IP Australia, *Trade Marks Manual Practice and Procedure-IP Australia [TMMPPA]*, part 10 at 3.3.3; part 21 at 2, 6; s. 4.3(7) Subregulation, online: <[http://www.ipaustralia.gov.au/resources/manuals\\_trademarks.shtml](http://www.ipaustralia.gov.au/resources/manuals_trademarks.shtml)>.

<sup>206</sup> *Trade Marks Act 1995*, s. 40 requires that all trade-marks be capable of being represented graphically.

<sup>207</sup> Subregulation, *supra* note 205 at s. 4.3(8).

An accurate trade-mark description is important as it facilitates searching the database for any conflicting trade marks on the register.<sup>208</sup> The relationship between the description and the graphical representation should be clearly noted in order to avoid any confusion between them. For example, a cross reference to the graphical representation can be included in the description.<sup>209</sup> However, the description and the graphical representation may sometimes be the same; the words “represented graphically” have been broadly interpreted to include symbols in the form of diagrams and writing.<sup>210</sup> For example, a trade-mark has been registered with the following description: “[t]he trade mark consists of the sound of the spoken word BIMBO. The sound of the word is represented graphically by the following: BIM BO as rendered on the cassette tapes forming part of the application.”<sup>211</sup> On the other hand, a mark consisting of a musical sound will be, in general, represented graphically via musical stave. In such a case, the musical notation is consultable online.<sup>212</sup>

### (c) Canadian Representation System Proposal

It is apparent, from the previous discussion, that each method of graphically representing a sound mark, taken alone, offers advantages and inconveniences. Although the use of written descriptions eliminates problems related to the visual representation of sound marks that are not musical, there are issues with clarity and accuracy. Alternatively, graphically representing a sound mark through musical notation or a sonogram can ensure a more accurate and precise representation of the sound. However, this method raises concerns regarding intelligibility, particularly in the case of sonograms. CIPO could resolve these difficulties by requiring a combination of these methods.

In the context of sound marks consisting of musical sounds, the representation could be a musical notation on a stave joined with a concise written description of the mark that provides information about the instrument used, the length of the notes, or any other characteristics of the sound. To ensure clarity and precision, a written description or a musical notation alone should not be accepted.<sup>213</sup> Representing a sound mark consisting of non-musical sounds, such as an animal sound, is more problematic. In order to meet the drawing requirement of section 30(h) of the *TMA*, the representation could consist of a written description of the sound combined with a sonogram of the sound. While some believe that sonograms may be

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<sup>208</sup> *TMMPPA*, *supra* note 205 Part 21(2).

<sup>209</sup> *Ibid.*

<sup>210</sup> *TMMPPA*, *supra* note 205 Part 21(5.1) (“As the words “represented graphically” have not been judicially defined, it is appropriate to take as their meaning the common, ordinary meaning they would be given by an ordinary person reading them — the so-called “golden rule” of statutory interpretation. The Macquarie Dictionary gives graphical as the equivalent of graphic, and defines “graphic” as follows: 2. pertaining to the use of diagrams, graphs, mathematical curves, or the like; diagrammatic. 3. pertaining to writing: graphic symbols”).

<sup>211</sup> Reg. Number: 850175.

<sup>212</sup> See e.g. Reg. Number: 844282.

<sup>213</sup> See possible area of convergence: SCT/19/2, *supra* note 51 at 10.

useful in assessing the similarity between two sounds, there are a lot of questions related to its being accessible to the general public, as few people are able to read and understand a sonogram.<sup>214</sup> Therefore, a possibility could be to create an exception to the drawing requirements in cases where sound marks consist of non-musical sounds, like it has been done for color marks pursuant to section 28 of the Canadian Trade-marks Regulations.<sup>215</sup> For reasons discussed herein, one may wonder, however, if a written description alone is enough to graphically represent a sound mark. This kind of representation is well accepted in the United States, but often lacks clarity and precision in Europe. Moreover, creating an exception for non-musical sound marks could lead to ambiguous situations. For instance, should a bird song or a cat meowing a song be considered as a musical or a non-musical sound mark? The distinction between musical and non-musical sound marks can sometimes be blurred.

Irrespective of the Canadian position on the matter, these combinations (written descriptions/musical notations or written descriptions/ with or without sonograms) should be accompanied by a sample of the sound mark. Indeed, the best way to truly understand a traditional trade-mark is obviously through visual means such as a drawing. The same logic should be applied to sound marks. Even if an applicant provides the most elaborate description of a sound mark, it cannot be truly experienced unless it is heard through some other means. Therefore, Canada should require that a sample of the sound mark be submitted with every sound mark's application.<sup>216</sup> It is of interest to note that sample based systems are not foreign to intellectual property law in Canada. In patent law, for instance, samples can be deposited for biological materials following section 38.1 of the *Patent Act* and sections 103 to 110 of the Patent Rules.<sup>217</sup> A deposit may be made whether or not it is necessary to enable the invention. However, it is a mandatory element when biological materials cannot otherwise be adequately described to comply with section 27(3) of the *Patent Act*.<sup>218</sup>

In terms of practical considerations, sound mark samples could be in the form of an MP3 or WAV<sup>219</sup> and should be available to the public through the Canadian trade-marks database site by, for instance, providing an icon or hyperlink where the sound can be heard. Written descriptions should refer to the sample for better coherence. Canada could also use the example of jurisdictions where registration sys-

<sup>214</sup> *Ibid.* at 9 and 10.

<sup>215</sup> Trade-marks Regulations, SOR/96-195 (TMR), s. 28(1) ("Where the applicant claims a colour as a feature of the trade-mark, the colour shall be described"); McGinnis, *supra* note 76 at 138.

<sup>216</sup> McGinnis, *supra* note 76 at 140.

<sup>217</sup> Patent Rules, SOR/96-423.

<sup>218</sup> Canadian Intellectual Property Office, *Manual of Patent Office Practice (MOPOP)* (Industry Canada, 1998) at 20 ("[...] a deposit may be made whether or not it is necessary to enable the invention. Where the invention cannot be enabled [see 17.04] in the absence of access to a biological material, however, the deposit is a necessary element to make the description sufficient unless the required material is publicly known and reliably available to the person skilled in the art").

<sup>219</sup> SCT/19/2, *supra* note 51 at 10.

tems allowing or requiring samples of sound marks already exist, such as New Zealand, Australia and United States.<sup>220</sup> Finally, the term “sound mark” should be clearly mentioned by applicants as a type of registered trade-mark. Therefore, CIPO could create a separate section for sound marks and possibly subsections, for example, for instrument music or animal noises, in order to facilitate a search of database information.

## CONCLUSION

In recent years, the possibility of registering non-traditional marks, including sound marks, has been growing internationally. In Canada, however, applications to register sounds as trade-marks have been systematically refused by CIPO since 1989. CIPO’s position relies on a restrictive interpretation of the word “mark” that imposed a visual requirement in the 1987 Federal Court of Canada’s *Playboy* decision. It has been argued in this article that this interpretation seems to be outdated and should no longer be the standard for assessing the registrability of sound marks in Canada. Indeed, with the globalization of markets and the increasing use of new technologies and marketing methods, the current Canadian approach to the registration of sound marks is inconsistent with the evolution of business over the past years. The favorable position of the United States, Europe and Australia in relation to the registrability of sound marks reveals the changing realities of branding norms and Canada should consider the position of these jurisdictions in order to ensure its presence in a modern marketplace framework.

In order to register a sound mark, the emphasis should be on whether the sound is distinctive enough to distinguish the wares and services of one source from those of another. The nature of the mark should not preclude its registration. In terms of degree of distinctiveness, a distinction between unique fanciful sounds, which are more likely to be inherently distinctive, and commonplace ones should be observed present. Commonplace sound marks may face particular challenges in relation to the doctrine of functionality, even if this doctrine is not an absolute barrier to their registration. In relation to the definition of “use,” particularly with respect to wares, the requirement that “use” must be made at the time of transfer of the property may raise some difficulties because the consumer may only listen to the sound mark after the time of purchase, when he will have bought and used the product. On this matter, a solution has been proposed relying on jurisprudence dealing with the use of computer software marks that could be considered by CIPO.

In terms of policy issues related to cumulative protection, an overlap between copyright and trade-mark protection does not appear to be a major obstacle to the registration of sound marks. However, some concerns may be raised about the legitimacy of a “partial” individual appropriation of a musical work that was previously part of the public domain. For some, works in the public domain are part of our cultural heritage and should be completely free to everyone. For others, the maintenance of trade-mark protection in some musical works can be reconciled with the objectives underlying the temporally limited protection of copyright.

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<sup>220</sup> However, in Australia and United States, the scope of protection of the mark is determined by the written description; see also Appendix 2: Information Furnished by Applicants to Register Sound Marks in Different Jurisdictions, below.

Finally, the graphic representation requirement is an important problematic issue regarding the registration of sound mark. On this matter, combinations of different methods (written descriptions/musical notations or written descriptions with or without sonograms) were proposed in order to clearly and accurately translate a sound mark through a visual representation. More importantly, it was noted that these combinations should be accompanied by a sample of the sound mark in the form of an MP3 or WAV. A sample is necessary to truly understand what constitutes the sound mark. Moreover, Canada should take advantage of new technologies by including in the Canadian trade-marks database digital versions (e.g. MP3 or WAV) of sound marks and make them accessible to the public and the legal practitioners through the internet, as it could facilitate searching the database for any conflicting trade marks on the register.

**Appendix 1: — Sound Marks Registrability by Jurisdiction  
in 2006<sup>221</sup>**

Can sound marks be registered as marks under the applicable legislation or under IP office practices?		
Responding countries/Regional IP offices	Sound marks	
	Musical sounds	Other sounds
ALGERIA	NO	NO
ARMENIA	YES	YES
AUSTRALIA	YES	YES
AUSTRIA	YES	YES
BANGLADESH	NO	NO
BELARUS	NO	NO
BRAZIL	NO	NO
BULGARIA	YES	NO
CANADA	NO	NO
CHILE	NO	NO
CHINA	YES	
CHINA: HONG KONG (SAR)	YES	YES
COLOMBIA	YES	YES
COSTA RICA	YES	YES
CROATIA	NO	NO
CZECH REPUBLIC	NO	NO
DENMARK	YES	YES
ECUADOR	YES	YES
EL SALVADOR	NO	NO
ESTONIA	NO	NO
FINLAND	YES	
FRANCE	YES	YES
GEORGIA	YES	YES
GERMANY	YES	YES
HUNGARY	YES	N/A
IRAN	NO	NO
IRELAND	YES	YES
ISRAEL	YES	N/A
ITALY	YES	YES
JAMAICA	YES	YES
JAPAN	NO	NO
KYRGYZSTAN	NO	NO
LITHUANIA	YES	YES
MADAGASCAR	NO	NO
MALTA	NO	NO

<sup>221</sup> Data taken from: WIPO, Standing Committee on the law of trademarks, industrial designs and geographical indications, *Summary of replies to the questionnaire on trademark law and practice*, WIPO doc. SCT/11/6 (2006), at 25–27.



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<b>Can sound marks be registered as marks under the applicable legislation or under IP office practices?</b>		
<b>Responding countries/Regional IP offices</b>	<b>Sound marks</b>	
	<b>Musical sounds</b>	<b>Other sounds</b>
MAURITIUS	YES	NO
MEXICO	NO	NO
MONACO	NO	NO
MOROCCO	NO	NO
NEW ZEALAND	YES	YES
NORWAY	YES	YES
OMAN	NO	NO
PAKISTAN	YES	YES
PANAMA	NO	NO
PERU	YES	YES
PHILIPPINES	NO	NO
PORTUGAL	YES	NO
REP. OF KOREA	NO	NO
REP. OF MOLDOVA	NO	NO
ROMANIA	YES	
RUSSIAN FEDERATION	YES	YES
SAINT LUCIA	NO	NO
ST. VINCENT & THE GRENADINES	YES	N/A
SINGAPORE	YES**	YES**
SLOVAKIA	NO	NO
SLOVENIA	N/A	N/A
SPAIN	YES	
SRI LANKA	NO	NO
SUDAN	N/A	N/A
SWAZILAND	N/A	N/A
SWEDEN	YES	YES
SWITZERLAND	YES	YES
SYRIAN ARAB. REP.	NO	NO
THAILAND	NO	NO
THE FORMER YUGOSLAV REP. OF MACEDONIA	NO	NO
TRINIDAD & TOBAGO	NO	NO
TUNISIA	YES	NO
TURKEY	NO	NO
UKRAINE	YES	YES
UNITED KINGDOM	YES	YES
UNITED STATES	YES	YES
URUGUAY	YES	YES
ZAMBIA	NO	NO
OAPI	NO	NO
EC	YES	YES

\*\* Sound marks are now registrable in Singapore. For more information see: <http://www.ipos.gov.sg/topNav/hom/>.

**Appendix 2: — Information Furnished by Applicants to Register Sound Marks in Different Jurisdictions<sup>222</sup>**

<b>Jurisdictions</b>	<b>Information furnished to register sound marks</b>
<i>Australia</i>	<ul style="list-style-type: none"> <li>— A graphical representation of the mark (musical notation or written description)</li> <li>— Description of the mark</li> <li>— Recording of the mark (audio tapes, compact discs or other media which are easily accessible)</li> </ul>
<i>China (Hong Kong)</i>	<ul style="list-style-type: none"> <li>— A graphical representation of the mark (detailed musical notation)</li> <li>— A description of the mark</li> </ul>
<i>New Zealand</i>	<ul style="list-style-type: none"> <li>— A graphical representation of the mark (where possible, include a musical score)</li> <li>— A written description</li> <li>— A sound file containing the sound in mp3 format (not exceeding 1 MB and not allowing loops or streaming)</li> <li>— If the musical instrument used to produce the sound forms part of the mark, this should be stated</li> </ul>
<i>Peru</i>	<ul style="list-style-type: none"> <li>— A graphic representation of the mark</li> <li>— A description of the mark</li> <li>— Audiocassettes and compact disk</li> </ul>
<i>Singapore</i>	<ul style="list-style-type: none"> <li>— A representation of the mark (detailed musical notation)</li> <li>— A description of the mark</li> <li>— 2 copies of CD recording of the mark</li> </ul>
<i>Chinese Taipei</i>	<ul style="list-style-type: none"> <li>— A representation of the mark (musical score, numerical musical score or a written description; If the musical score or numerical score is provided, a written description shall also be enclosed)</li> <li>— A CD recording of the sound</li> </ul>
<i>United States</i>	<ul style="list-style-type: none"> <li>— A written description of the mark</li> <li>— Audio cassettes and compact disks may be accepted as specimens</li> </ul>

<sup>222</sup> Data taken from: Asia-Pacific Economic Cooperation (APEC), APEC Intellectual Property Experts Group and APEC Committee on Trade and Investment, *Report for APEC survey on non-traditional trade marks* (2008), online: <<http://www.apec.org/>>.