

I AM A TRADEMARK, HEAR ME ROAR! — AN APPEAL FOR SOUND MARKS IN CANADA

Chantal Bertoša and Andrea Pasztor
Shapiro Cohen



If a sound is able to serve the function of a trademark, why shouldn't the owner of the sound mark be permitted to register it?

Many jurisdictions have accepted the premise that sounds are able to function as trademarks and have allowed for the registration of sound marks. These countries have either interpreted their existing trademark law in such a way as to allow for the registration of sound marks or have amended their legislation to make it possible. Unfortunately, the registration of sound marks is currently not an option in Canada.

However, the question of whether and how sound marks can be registered in Canada has finally been put to the Federal Court in Canada by Metro-Goldwyn-Mayer Studios Inc. (MGM).

MGM, the producer and distributor of major motion pictures, applied to register the famous and distinctive roar of the lion that appears at the start of its movies. The application was filed in October 1992 and was in prosecution for 18 years until finally the Canadian Intellectual Property Office (CIPO) rejected the application based on a technicality, which is now the subject of an appeal before the court.

For 18 years, we filed several rounds of submissions on behalf of MGM in an ongoing debate with CIPO about whether sound marks can be trademarks; ultimately, however, MGM's application was refused on the basis of Paragraph 30(h) of the Canadian Trademarks Act, which requires "a drawing of the trademarks and such number of accurate representations of the trademarks as may be prescribed" unless the application is only for a word or words not depicted in a special form.

When applying to register the sound mark, MGM included a spectrogram of the lion's roar in the application. Subsequently, MGM filed an audio tape of the lion's roar, and a video of a movie, which demonstrated the roaring lion at the start of the movie.

CIPO opined that the spectrogram, a visual representation of the sound, was not the trademark since MGM had clearly applied for a sound mark and not a design mark; therefore, the spectrogram was not considered to be an accurate representation of the trademark applied for.

This technical objection and restrictive interpretation of Paragraph 30(h) puts Canada behind other countries when it comes to the evolution of trademark law and compliance with international obligations, and is very difficult to reconcile with CIPO's acceptance of and proposed adoption of other types of non-traditional trademarks, which are also difficult to represent visually in an application.

"IF CIPO ACCEPTS 2D DRAWINGS OF 3D MARKS AND DISTINGUISHING GUISES, AND IS PROPOSING TO ACCEPT A SERIES OF FREEZE FRAMES OF HOLOGRAM MARKS AND VIDEOS OF MOTION MARKS, THEN HOW CAN IT NOT ACCEPT THE SPECTROGRAM OF THE SOUND MARK?"

Canada already allows for the registration of 3D marks and distinguishing guises, and has recently closed a consultation with the profession about motion marks and hologram marks. The consultation specifically dealt with a Draft Practice Notice wherein CIPO outlined the filing requirements for motion marks and hologram marks, including for motion marks or hologram marks: an application should contain "one or more freeze frames to show the various points in movement, depending upon how many freeze frames would best depict the commercial impression of the mark" and "a detailed written description stating specifically which elements of the mark as in motion and describing the motion itself"; and for motion marks, an application should contain a video of the motion mark.

The ability to apply for motion marks and hologram marks may not be finalised until well into 2011.

If CIPO accepts 2D drawings of 3D marks and distinguishing guises, and is proposing to accept a series of freeze frames of hologram marks and videos of motion marks, then how can it not accept the spectrogram of the sound mark? Neither the 2D drawing nor the freeze frames nor the video are the trademarks applied for, they are simply accurate, meaningful representations of them.

Hopefully, the Federal Court will see this inconsistency in the registrability of non-traditional trademarks in Canada and find that the technical objection against sound marks put forth by CIPO is not founded in law.

Those interested in applying for sound marks in Canada are encouraged to monitor MGM's case in the Federal Court.

Chantal Bertoša is a partner and a patent and trademark manager at Shapiro Cohen. She can be contacted at: cbertosa@shapirocohen.com

Andrea Pasztor is an associate at Shapiro Cohen. She can be contacted at: apasztor@shapirocohen.com