

Bereskin & Parr LLP

Sound arguments – time to allow other non-traditional marks?

Proposed practice rules, if implemented, could pave the way for the registrability of sound and colour marks

The Canadian Intellectual Property Office (CIPO) published a draft practice notice for comment on October 8 2010, proposing the registrability of moving images and holograms as trademarks. The consultation period closed in November 2010 and it is not known when – or whether – the proposed draft notice will come into effect. IP practitioners have been left wondering whether a more flexible approach to moving images and holograms will affect other types of non-traditional mark that have been denied registration in Canada.

Formal submissions by the Intellectual Property Institute of Canada questioned why holograms and motion marks were the only two types of non-traditional mark to be addressed in the draft notice, since “other non-traditional marks, such as colour, sound, smell marks and three-dimensional marks are of at least equal, if not greater, interest and relevance to trade-mark owners”.

Although specific to motion marks and holograms, the introductory passage of the draft notice hints at a broader applicability. It states: “The requirements for registrability of a non-traditional mark are dependent upon whether the mark falls within the definition of a trade-mark in Section 2 of the Trade-marks Act and accordingly upon whether the mark 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.”

These remarks, and in particular the focus on the criterion of distinctiveness, appear tacitly to pave the way for the recognition in Canada of other types of non-traditional mark, such as sound and colour marks, which have been held to different standards.

Sound as a trademark

The CIPO does not consider sounds to be registrable as trademarks. Although they can be registered in various countries and regions, including the European Union, Australia and the United States, the biggest hurdle in Canada remains the antiquated interpretation of the word ‘mark’ in *Playboy Enterprises Inc v Germain* ([1987] FCJ 616). *Playboy* involved an alleged trademark for hairpieces that was not physically marked on the goods; instead, the goods were described to potential purchasers as being PLAYBOY hairpieces. Noting that the word ‘mark’ is not defined in the act, the judge relied on the “ordinary sense” of the word and held that a trademark must be visible. This case is often cited in support of the principle that sounds cannot be registered as marks in Canada because they cannot be seen.

There has been one registration for a sound in Canada. In 1989 Capitol Records registered a series of 11 notes for audiotapes and sound duplication services. This registration was subsequently expunged in 2005 for failure to renew. Since 1989 no applications for sound have obtained registration – and not for lack of trying. Various applications to register sounds as trademarks have been filed and rejected. Several of the applications were for sounds that are unmistakably distinctive to Canadian consumers, such as MGM’s roaring lion (Refused Application 0714314 – CIPO’s refusal is being appealed) and the opening and closing version of “The Hockey Theme” by CTV Inc (abandoned Applications 1435197 and 1435199).

Companies often use sound, such as advertising jingles, to great effect to distinguish their products and services and to appeal to consumers’ other senses. Successful examples of sound being used in

commerce to signify source include the Pillsbury doughboy’s giggle (which is subject to trademark registration in the United States – 2692077), Intel’s five-chord sequence (US Registration 2315261) or McDonald’s five-note tune (US Registration 2939936).

Colour as a trademark

The current published view of the Canadian Trademarks Office is that colour alone is not registrable as a trademark (Trademark Examination Manual IV.2.1, page 98). However, it will accept marks that consist of a specific colour applied to a particular shape and size of product.

In *Parke, Davis & Co Ltd v Empire Laboratories Ltd* ((1963) 41 CPR 121 (Ex)) the court found that a colour is not registrable in itself. However, if applied to a specific product, shape or design, it may acquire distinctiveness through use in Canada. The degree of distinctiveness acquired is a question of fact that places a heavy onus on the applicant.

The Federal Court has confirmed that colour applied to the entire exterior of an article is a valid trademark. In *Smith Kline & French Canada Ltd v Canada Registrar of Trademarks* ([1987] 2 FC 633 (FCTD)) the court reversed the registrar’s finding and found that the colour green applied to the exterior of a pharmaceutical tablet of a particular size and shape was a valid trademark. The judge stated that “while distinctiveness, an issue which is not before me here, will always be an important hurdle for an applicant to overcome in obtaining registration of a trade-mark which relies heavily on colour, I would find it difficult to hold that such a trade-mark could never be registrable”.

The Supreme Court has recognised that colour can distinguish a particular

manufacturer. In *Ciba-Geigy Canada Ltd v Apotex* ([1992] 2 SCR 120, 44 CPR (3d) 289 (SCC)) the court stated that “the product’s appearance or its packaging – shape, size or colour – may be characteristic of a particular manufacturer and have the effect of marking out the product or making it recognizable as his own”.

Distinctiveness and non-traditional marks

By emphasizing the criterion of distinctiveness in the draft notice, CIPO has properly couched the question of registrability as whether a non-traditional mark is capable of distinguishing the source of the goods and services in association with which it is used.

Formal submissions by the International Trademark Association (INTA) in response to the draft notice suggest support for a broader application of this more flexible approach to other types of non-traditional mark. INTA has stated that it “supports the registration of trademarks that are visually perceptible, or capable of being depicted or described by written notation, diagrams or other sufficiently certain visual means, as long as they are sufficiently distinctive and function as an indicator of source... As with words and symbols, the required distinctiveness can be inherent or acquired through use”.

The emphasis on distinctiveness in the draft notice and in INTA’s submissions contrasts with the limiting definition of a ‘trademark’ adopted in *Playboy*, which has since plagued applicants of sound marks with its visual depiction requirement. The technical problem of how to represent a sound mark visually can be overcome, as indicated by the draft notice’s detailed guidelines for depicting holograms and motion picture marks, which are also difficult to depict in a conventional sense. The logical implication of the draft notice’s guidelines for filing may be that sound marks could also be visually depicted, although filing a digital audio file as part of the application would be equally suitable, if not preferable. Provided that such marks are capable of distinguishing goods or services, they should be registrable.

There also appears to be a persuasive argument that colours alone should be registrable, provided that they have acquired distinctiveness. This view is supported by the draft notice’s mandate that the registrability of a non-traditional mark depends on whether it is used to distinguish associated goods or services, and by the recognition by Canada’s highest court nearly two decades ago that colour can distinguish a particular manufacturer.

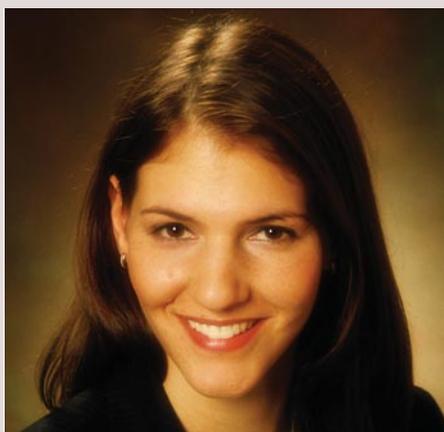


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Alternative protection: copyright

IP practitioners and brand stakeholders will

continue to await the possible implementation of the draft notice and a potential determination by the CIPO on the extent to which the loosening of Canada’s rather particular restrictions on the registration of non-traditional marks can be applied to all types of non-conventional mark. In the meantime, owners of musical sound marks should consider seeking copyright protection. Although sounds cannot yet be registered as trademarks in Canada, they may constitute a ‘musical work’ under the Copyright Act. If Canada finally catches up and grants registered trademark protection to sound marks, IP practitioners should include a search of the copyright database when clearing proposed sounds for clients. For decades, owners of sound marks that were rejected by the Trademarks Office may have been relying instead on Canada’s friendlier copyright laws. [WTR](#)