

55.01

How to Describe a Sound Trademark in an Application and the Required Attachment

1. Requirements for registration of a sound trademark

Any applicant who seeks trademark registration of a sound trademark is required to present the trademark in an application: more specifically, in the section to present the trademark (the "trademark representation section"), by using words, a staff, or any combination thereof to provide information necessary to define the composition of the sound trademark such as notes, rests, clefs, tempo, time signature, and lyrics (Article 4-5 and Form 2, Note 7, 'So' (R) of the Ordinance for Enforcement of the Trademark Act). If the applicant [i] fails to provide sufficient information about the composition of the sounds or [ii] provides information not related to the elements of the composition of the sounds in the trademark representation section, the trademark would not be recognized as a sound trademark. In such case, the requirement specified in the main paragraph of Article 3(1) of the Trademark Act cannot be considered to be satisfied (please refer to Section 1 of 55.02 and Section 1 of 55.03 of the Trademark Examination Manual).

2. How to define a sound trademark

Since a sound trademark is perceived in an auditory way, words, a staff, or any combination thereof would not be sufficient to describe some elements of the trademark such as a tone color and intonation. Therefore, in the case of an application for a sound trademark, the applicant is required to provide information necessary to define the composition of the sound trademark and also to attach an item (an "audio file") specified in an ordinance issued by the Ministry of Economy, Trade and Industry. The applicant may present a detailed explanation (a "detailed explanation") of the trademark in an application only if such explanation is necessary to define the sound trademark (Article 5(5) of the Trademark Act).

A trademark application would not be considered to satisfy the requirement specified in Article 5(5) of the Trademark Act unless the audio file and the detailed explanation presented therein are sufficient to define the sound trademark. A determination as to whether the audio file and the detailed explanation are sufficient to define the sound trademark should be made based on whether the composition and style of the sound trademark presented in the trademark representation section are identical with the audio

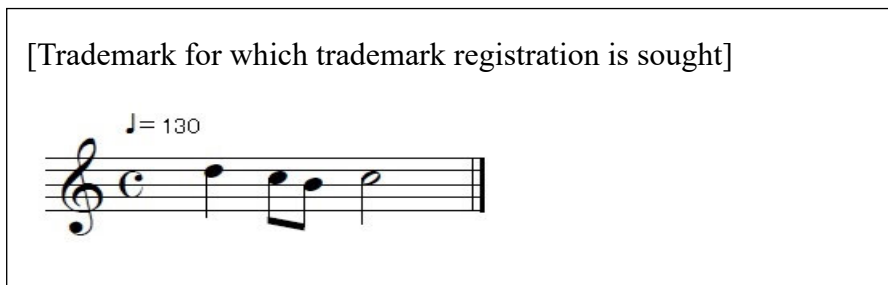
file and also with the composition and style of the trademark described in the detailed explanation. If those composition and style are found to be identical, the sound trademark can be considered to be defined.¹

Part IV, Article 5(4) of the Trademark Examination Guidelines specifies that, even if the trademark presented in the application is not identical with the audio file or the detailed explanation, the sound trademark may be considered to be defined as long as the audio file or the detailed explanation can be considered to fall within the scope of the composition and style of the sound trademark. One of the example cases that falls under this provision would be a case where the trademark is presented in the application without any explanation as to which musical instrument should be used, whereas the audio file contains the sounds of a certain musical instrument. In this case, since the trademark representation section does not provide any information about which musical instrument should be used, any musical instrument could be used. Thus, the sounds of a certain musical instrument recorded in the audio file cannot be considered to be identical with the sounds of the trademark presented in the application. However, since the sounds recorded in the audio file (the sounds of a certain musical instrument) can be considered to fall within the scope of the sounds of the trademark presented in the application (the sounds of any musical instrument), the audio file may be considered to define the trademark for which trademark registration is sought (Part IV, Article 5, 4, (4) of the Trademark Examination Guidelines). On the other hand, the applicant is required to include all of the sounds presented in the trademark representation section in the audio file in order to define the sound trademark. For example, in Example Case (1) where the trademark is presented in an application in the form of a staff showing multiple notes, if the audio file contains the sounds of only some of those notes or in Example Case (2) where the trademark is presented in an application in the form of a full score showing multiple parts to be performed, if the audio file contains the sounds of only some of those multiple parts, the audio file would not be sufficient to define the trademark for which trademark registration is sought.

Each applicant is required to present and submit an audio file and a detailed explanation in order to define the elements of the trademark that cannot be precisely defined in the trademark representation section or to define the matters that are not mandatory for the applicant to describe in the trademark representation section. Thus, even if some of the sounds presented in the trademark representation section are defined, the requirement specified in Article 5(5) of the Trademark Act cannot be considered to be satisfied.

¹ Please refer to "Part IV, Article 5 (4) of the Trademark Examination Guidelines"

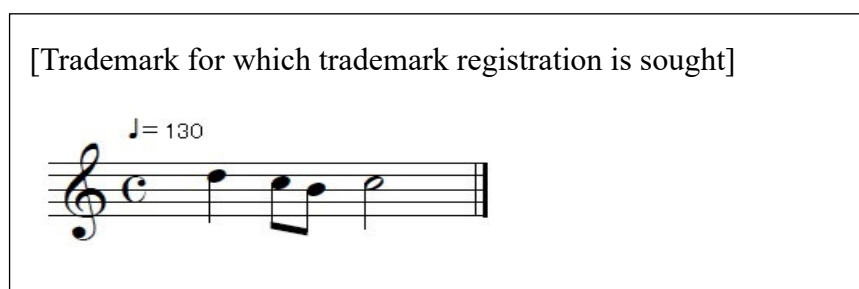
(Example 1) Case where the audio file can be found to define a sound trademark



Audio file: The audio file contains the sounds of piano performed in accordance with the aforementioned staff.

In the case where the trademark presented in an application is accompanied by a statement that designates a piano and a guitar as the musical instruments for the trademark, if the audio file contains only the sounds of a piano, the musical instruments designated for the trademark presented in the application cannot be considered to be identical with the musical instrument used in the audio file. In this case, the audio file would not be sufficient to define the trademark for which trademark registration is sought.

(Example 2) Case where the audio file cannot be found to define a sound trademark



Audio file: The audio file contains only the piano sound of "Re" shown as the first note in the aforementioned staff.

3. Amendment of the audio file

Even in the case where the audio file cannot be considered to define the sound trademark, if the applicant's amends the audio file so that the composition and style of the sound trademark presented in the trademark representation section become identical with the composition and style of the sounds in the audio file, the trademark application

would satisfy Article 5(5) of the Trademark Act because the amended audio file would be sufficient to define the sound trademark.

4. Handling concerning a sound trademark in an international application for trademark registration

(1) A sound trademark in an international application for trademark registration is described as follows in a designation notification.

- (i) Information necessary to define the sound trademark are represented by using words, a staff, or any combination thereof (A single-line staff may be presented in addition to a staff if necessary)
- (ii) Audio file (e.g., MP3 format)

(2) In a case where a trademark pertaining to international application for trademark registration is presented as an audio file, the requirement specified in the main paragraph of Article 3(1) of the Trademark Act is not satisfied since audio files are not recognized as a composition of a sound trademark in Japan (Part I-2, Article 3(1) Main Paragraph 10(1) of the Examination Guidelines for Trademarks, and Article 4-5 of the Ordinance for Enforcement of the Trademark Act).