

## 55.02

### **How to Describe a Sound Trademark in an Application (in the form of a staff)**

#### 1. Main paragraph of Article 3(1) of the Trademark Act

In the case of a trademark expressed in the form of a staff, the applicant is required to specify in an application, more specifically, in the section "Trademark for which trademark registration is sought" (the "trademark representation section"), notes, clefs, time signature, and tempo and also specify, if necessary, the linguistic elements (if lyrics are included) and rests. If such information is not provided in the trademark representation section, the trademark would not be recognized as a sound trademark and would not satisfy the requirements specified in the main paragraph of Article 3(1) of the Trademark Act.

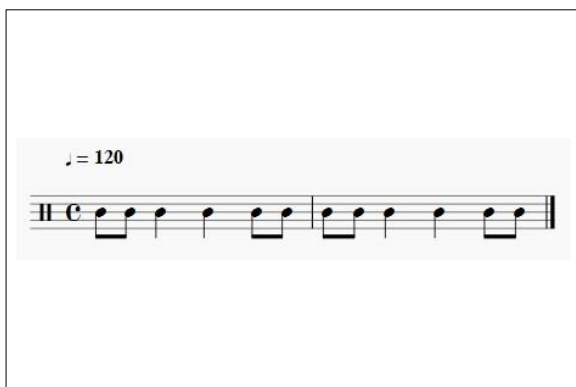
#### (1) Cases where only percussion instruments are used

If a single percussion instrument is used to create the sounds of a sound trademark, the trademark can be presented in the form of notes placed on a single line or in a space between two lines. If multiple percussion instruments are used (such as a drum set), the sounds created by each instrument can be presented in the form of notes placed on a single line or in a space between two lines.

In this case, the applicant is required to specify, in the section "Detailed explanation of the trademark" ("detailed explanation"), on which single line or in which space between two lines, the sounds of each percussion instrument are presented in the form of notes.

## (Example 1) Trademark played by a Percussion Instrument

[Trademark for which trademark registration is sought]



[Sound trademark]

[Detailed explanation of the trademark]

The trademark for which trademark registration is sought (the "Trademark") is a sound trademark played by a tambourine.

The Trademark is expressed by use of the third line of the staff.

## (2) Tempo

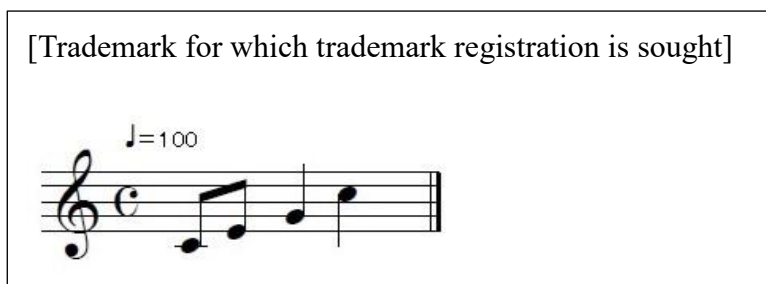
In the case of a trademark expressed in the form of a staff, the applicant is required to specify in an application, more specifically, in the section "Trademark for Which Trademark Registration is Sought" (the "trademark representation section"), notes, clefs, time signature, and tempo and also specify, if necessary, the linguistic elements (if lyrics are included) and rests. As an exception, it is not mandatory to specify the tempo in the trademark representation section. As long as the tempo is specified in the detailed explanation, the requirement specified in the main paragraph of Article 3(1) of the Trademark Act would be satisfied. The applicant is permitted to make an amendment of additionally specifying the tempo in the detailed explanation because such amendment is not considered to be a change in the substance of the trademark.

## (3) Imperfect staff

Even if notes, clefs, time signature, and tempo are presented in the trademark representation section, if the staff is considered to be imperfect, the trademark cannot be considered to be a sound trademark. In this case, the requirement specified in the main paragraph of Article 3(1) of the Trademark Act would not be satisfied.

For example, a staff would be considered imperfect if a staff consists of a single imperfect measure that lacks a rest.

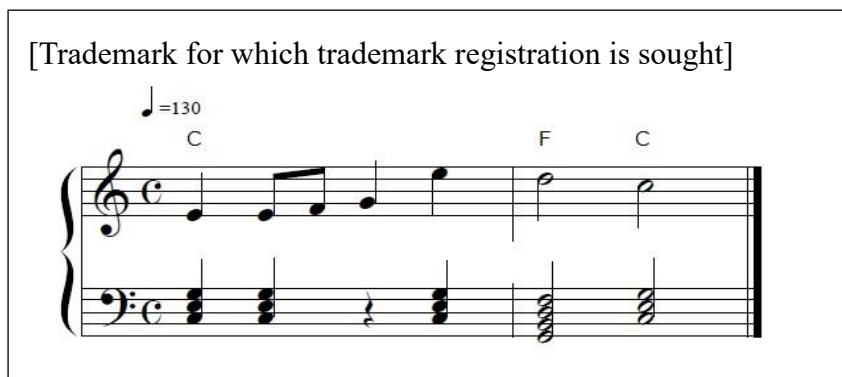
(Example 2) Staff consisting of a single imperfect measure



#### (4) Chord name

In the case of a trademark presented in the form of a staff, if the applicant presents any sounds other than the main theme (the "accompaniment sounds"), the applicant may use chord names (signs to indicate the chord compositions) instead of notes to present those sounds in the trademark representation section. Chord names are allowed to be used on the presumption that the sounds composing the chord indicated by a chord name are played as long as the effect of a chord name extends (or during the time span starting from the beat on which a chord name takes effect and ending on the beat preceding the beat on which the next chord name takes effect). If the trademark representation section presents accompaniment sounds not only in the form of chord names but also in the form of notes, those notes should be included in the sounds composing the chords indicated by the chord names. Thus, in the case where the main theme is presented in the form of notes, while the accompaniment sounds are presented in the form of notes as well as chord names, if any sound other than the sounds composing the chords indicated by the chord names is presented in the staff in the form of a note (excluding the notes of the main theme) to which the effect of the chord names extends, the requirement specified in the main paragraph of Article 3(1) of the Trademark Act would not be satisfied.

(Example 3) On the first and second beats in the second measure, the chord name (F: a sign indicating the "fa, la, do" composition) is inconsistent with the note (a chord consisting of "so, ti, re, fa")



## 2. Article 5(5) of the Trademark Act

Even in the case where the applicant presents an item (an "audio file") specified in an ordinance issued by the Ministry of Economy, Trade and Industry and a detailed explanation in a trademark application, if the audio file and the detailed explanation fail to define the sound trademark, the application would not satisfy the requirement specified in Article 5(5) of the Trademark Act. A determination as to whether the audio file and the detailed explanation define the sound trademark must be made based on whether the composition and style of the trademark presented in the application are identical with the audio file and also with the composition and style described in the detailed explanation.

### (1) Cases where any sound not presented in the staff is recorded in the audio file

For example, in Example Case (1) where the staff shows only the notes of the main theme, while the audio file contains both the main theme and the accompaniment sounds, Example Case (2) where the staff does not present a percussion part, while the audio file contains the sounds of a percussion instrument, or Example Case (3) where the staff does not contain any linguistic elements, while the audio file contains the voice of a human being containing linguistic elements, the composition and style of the trademark presented in the application cannot be considered to be identical with the composition and style of the sounds recorded in the audio file. Thus the trademark application cannot be considered to satisfy the requirement specified in Article 5(5) of the Trademark Act.

### (2) Cases where a sound presented in the staff is not recorded in the audio file

For example, in Example Case (1) where the staff presents multiple notes, while the audio file contains the sounds of only some of those notes, Example Case (2) where the

staff (including the case where the staff is presented in the form of a full score) presents multiple parts to be performed, while the audio file contains only some of those parts, or Example Case (3) where the staff contains linguistic elements, the audio file does not contain the voice of a human being containing linguistic elements, the composition and style of the trademark presented in the application cannot be considered to be identical with the composition and style of the sounds recorded in the audio file. Thus, the trademark application cannot be considered to satisfy the requirement specified in Article 5(5) of the Trademark Act.

The applicant is required to present and submit an audio file and a detailed explanation in order to define such 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 would not be satisfied (please refer to Section 2 of 55.01 of the Trademark Examination Manual).

(3) Case where the sounds presented in the staff are not identical with the sounds recorded in the audio file

If the musical elements (pitch, rhythm, tempo, tone color, etc.) presented in the staff are not identical with those recorded in the audio file, the composition and style of the trademark presented in the application would be considered to be different from the composition and style of the sounds recorded in the audio file. Thus, the requirement specified in Article 5(5) of the Trademark Act would not be satisfied. The same would apply to the case where the linguistic elements presented in the staff are not identical with those of the sounds recorded in the audio file.

In the case where the staff presents notes while the audio file contains any sound different from the sounds of any musical instrument or the singing voice of human beings, in other words, any sound that is not required to hit a certain note (e.g., sounds in nature, human voice, sounds made by animals, electronic sounds), the composition and style of the trademark presented in the application would be considered to be identical with the composition and style of the sounds recorded in the audio file. Thus, the requirement specified in Article 5(5) of the Trademark Act would not be satisfied.

(Example 4) Case where the audio file contains any sound that is not required to hit a certain note

[Trademark for which trademark registration is sought]

♪ = 200

とつ きよ ちょう

The image shows a musical staff with a treble clef and a 2/4 time signature. Above the staff, it says '♪ = 200'. The staff contains four notes: a quarter note on G4, a quarter rest, a quarter note on B4, and a quarter note on G4. Below the staff, the Japanese characters 'とつ', 'きよ', and 'ちょう' are written under the first, third, and fourth notes respectively.

[Explanation]

The audio file would be considered to be sufficient to define the sound trademark only if the audio file contains the singing voice singing "To, kkyo, cho" in a manner that each of these linguistic elements hits "do, so, mi" respectively in accordance with the aforementioned staff. However, the audio file contains a voice expresses the linguistic elements by simply reading out the word "Tokkyocho" ([MP3](#)).

(Note) In the case where a sound trademark is presented in the trademark representation section, not in the form of a staff, but by use of words in a manner that does not indicate the existence of any musical elements, if the audio file contains sounds that can be considered to hit certain notes and exhibit musical elements, the composition and style of the trademark presented in the application would be considered to be different from the composition and style of the sounds recorded in the audio file. Thus, the requirement specified in Article 5(5) of the Trademark Act would not be satisfied.

(Example 5) Case where the audio file contains sounds that change in pitch and exhibit musical elements

[Trademark for which trademark registration is sought]

The trademark consists of a human voice saying "Tokkyocho," which lasts about two seconds as a whole.

The image shows a rectangular box containing the text: "The trademark consists of a human voice saying 'Tokkyocho,' which lasts about two seconds as a whole."

[Explanation]

The audio file would be considered to be sufficient to define the sound trademark only

if the audio file contains a human voice that expresses the linguistic elements by simply reading out the word "Tokkyocho." However, the audio file contains sounds that change in pitch and exhibit musical elements ([MP3](#)).