

55.03

How to Describe a Sound Trademark in an Application (by use of words)

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

In the case where words are used to describe a sound trademark consisting of sounds that are impossible or difficult to express in the form of a staff such as the sounds in nature, sounds made by animals, and electronic sounds, the applicant is required to state in an application, more specifically, in the section to present the trademark for which trademark registration is sought (the "trademark representation section"), the type and duration (time) of the sounds. If such information is not provided in the trademark representation section, the trademark would not be recognized as a sound trademark. Thus, the requirement specified in the main paragraph of Article 3(1) of the Trademark Act would not be satisfied.

(1) Cases where the type of sounds is not stated

The applicant is required to define the type of sounds by using onomatopoeia or a combination of onomatopoeia and imitative words (Part I "Article 3(1)," Chapter 2 "Main paragraph of Article 3(1)," 10 (2) (B) [i] of the Trademark Examination Guidelines). If the applicant states only onomatopoeia or imitative words and fails to state the type of the sounds, the trademark cannot be recognized as a sound trademark. Thus, the requirement specified in the main paragraph of Article 3(1) of the Trademark Act would not be satisfied.

For example, if an application states that the trademark "consists of the sounds "kiin," which takes about two seconds as a whole," the application would be considered to fail to state the type of the sounds "kiin," In this case, it is impossible to understand exactly what kind of sounds they are (e.g., the sounds of a machine in operation, the voice of a human being, an electronic sound). Thus, the requirement specified in the main paragraph of Article 3(1) of the Trademark Act would not be satisfied.

(2) Case where the musical elements are described in the trademark representation section by use of words

In the case where a trademark described in the trademark representation section by use of words clearly exhibits musical elements, if the applicant fails to clearly describe the characteristics of the sounds (pitch, rhythm, tempo, etc.), the information provided by

the applicant would be insufficient to define the sounds. In this case, the sound trademark would not satisfy the requirement specified in the main paragraph of Article 3(1) of the Trademark Act.

For example, in the case where a trademark is presented in the application with the description "A male voice reading out XXX, followed by two-second piano sounds," the phrase "piano sounds" clearly indicates the existence of musical elements. However, since the applicant fails to provide sufficient information to define the sounds, the requirement specified in the main paragraph of Article 3(1) of the Trademark Act would not be satisfied. Even if the applicant submits an item (an "audio file") specified in an ordinance issued by the Ministry of Economy, Trade and Industry and describes the details of the "piano sounds" in the section "Detailed explanation of the trademark" ("detailed explanation"), the requirement specified in the main paragraph of Article 3(1) of the Trademark Act would not be satisfied. The presentation of an audio file and a detailed explanation would merely 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 in a situation where the applicant can be considered to have provided all the information necessary to reproduce the sounds for which trademark registration is sought in the trademark representation section. This can be described as a situation where sufficient information is provided to define the trademark for which trademark registration is sought. It should be noted that the presentation of an audio file and a detailed explanation would not define the sounds (the details of the "piano sounds") for which trademark registration is sought.

On the other hand, in the case where the details of the musical elements are described in the trademark representation section by use of words, if the description is sufficient to define the sounds for which trademark registration is sought (e.g., tempo XX, X-X time, XX key, the sound X is played on the first beat in the first measure...), the requirement specified in the main paragraph of Article 3(1) of the Trademark Act would be satisfied.

(3) Case where the trademark presented in the application contains anything that is not a component of the sound trademark

The Trademark Examination Guidelines specifies that, if the applicant states, in the trademark representation section, the title of the tune, the name of the composer, or any other things that is not a component of the sound trademark, the trademark presented in the application cannot be considered to be a sound trademark.¹ Thus, the requirement

¹ Part I, Chapter 2 "Main paragraph of Article 3(1)," 10 (1) (A) of the Trademark Examination Guidelines

specified in the main paragraph of Article 3(1) of the Trademark Act would not be satisfied.

In addition to the title of the tune and the name of the composer, there are other things that cannot be considered to be components of a sound trademark. For example, if a trademark is described in an application as "the Trademark consists of the mewing of the cat named XX, which is famous nationwide. The mewing lasts three seconds as a whole," the phrases "famous nationwide" and "cat named XX" cannot be considered to describe the sounds of the sound trademark themselves and cannot be considered to be components of the sound trademark. Such sound trademark would not satisfy the requirement specified in the main paragraph of Article 3(1) of the Trademark Act.

However, the deletion of these phrases would not be considered to be a change in the substance of the trademark.

2. Article 5(5) of the Trademark Act

(1) Case where the sounds recorded in the audio file are not identical with the sounds presented in the trademark representation section

If the characteristics of the sounds presented in this trademark representation section (the pitch and duration (time), etc. of each sound) are not identical with those of the sounds 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 trademark application would not satisfy the requirement specified in Article 5(5) of the Trademark Act. The same applies to the case where the linguistic elements presented in the trademark representation section are not identical with those of the sounds recorded in the audio file.

In the case where a sound trademark is presented in the trademark representation section 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 (please refer to Section 2 (Note) of 55.02 of the Trademark Examination Manual).

(2) Case where anything that is not a component of the sound trademark is included in the detailed explanation of the trademark by use of words

If anything that is not a component of the sound trademark is stated in the detailed

explanation, the detailed explanation would not be considered to define the sound trademark. Thus, the trademark application would not satisfy the requirement specified in Article 5(5) of the Trademark Act.