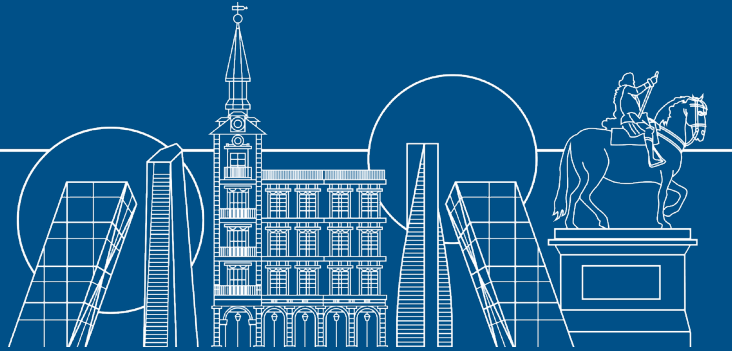




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# Introduction

Eleni Kokkini  
PPT Legal, Greece



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**Eleni  
Kokkini**  
Greece



**Ramon Vives**  
Spain



**Andy King**  
United Kingdom



**Anna King**  
USA



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## THE BUSINESS (AND THE POWER!) OF SOUND MARKS

Ramon Vives  
Independent Consultant, Spain



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## THE BUSINESS (AND THE POWER!) OF SOUND MARKS FICPI

RAMON VIVES XIOL

September 2024

THE SONIC YOU  
YOUR BRAND IN SOUND



Ramon Vives

**NICE TO MEET YOU!**  
rvives@thesonicyou.com

**STUDIES**

**LANGUAGES**

**EXPERIENCE**

**CLIENTS**

**PRIZES**

**MUSIC**

DEGREE IN ECONOMICS

MASTERS IN COMMUNICATIONS

POSTGRADUATE IN MUSIC MANAGEMENT

SPANISH

CATALAN

ENGLISH

FRENCH

GERMAN

ITALIAN

+ **MUSIC !!!**

PRESS MANAGER:  
*BRUCE SPRINGSTEEN,  
BACKSTREET BOYS....*

EU INTERNATIONAL COOPERATION

SIXIÈME SON SPAIN  
FOUNDER AND MD  
(2013-2024)

THE SONIC YOU (2024)



IF DESIGN FOR THE SONIC SYSTEM OF MAPFRE (2023)

CLEMENTNES

PLOU

SUPERMON

MORE THAN BARÇA



## SOME CLIENTS\*

From Spain to the world



“WE ARE INNATELY MUSICAL CREATURES FROM THE  
DEPTHS OF OUR NATURE”

STEFAN KOELSCH  
PHD IN NEUROSCIENCE, PSYCHOLOGIST,  
NEUROBIOLOGIST, SOCIOLOGIST  
& MUSICIAN

MUSIC AND SOUND BRING US TOGETHER; THEY  
CONNECT AND INSPIRE US. THEY ARE A UNIVERSAL  
LANGUAGE THAT TRANSCEND PEOPLE, CULTURES AND  
GEOGRAPHIES ACROSS PLANET EARTH.

What does sound mean for brands?

IT ALLOWS BRANDS TO CONNECT PEOPLE WITH A BRAND ON AN EMOTIONAL LEVEL, CONVEY MEANING, PROMPT RECALL, SOLIDIFY BRAND ASSOCIATIONS, TRANSCEND BARRIERS OF LANGUAGE AND CULTURE AND **SIGNIFICANTLY IMPACT BUSINESS RESULTS**

What is sonic branding about?

DESIGN DISTINCTIVE AND ENGAGING SONIC ECOSYSTEMS THROUGH  
MUSIC, SOUND, AND VOICE.

Sonic Branding is infused in our daily life

IN THE THINGS WE EAT



IN THE WAY WE WORK



IN THE THINGS WE WATCH



IN THE WAY WE COMMUNICATE



IN THE THINGS WE PLAY WITH



IN THE WAY WE DATE



And **much much** more..

## 6 key ELEMENTS for a successful SONIC branding

1. GRAB **ATTENTION**
2. CREATE **ENGAGEMENT**
3. TRIGGER **RECALL**
4. CONVEY **MEANING**
5. ENSURE **FLEXIBILITY**
6. ASSURE **CONSISTENCY**

# SONIC TEST

- 1  NESPRESSO
- 2  NOKIA
- 3 
- 4  Coca-Cola
- 5  



THE POWER OF **SOUND**  
TODAY MORE THAN **EVER**

1

MUSIC CHANGES  
**PERCEPTION OF VISUAL ASSETS**

# WHY IS SONIC BRANDING CRITICAL FOR BRANDS?

- **EXERCISE**

- We will watch the same TVC, four times: without audio and then with three different music tracks. For each video, ask yourself:
  - How does your understanding change from one version to the next?
  - Is it coherent with what you understood without audio?
  - Which is the most coherent version?

# 2

## MUSIC CAN ENHANCE THE EMOTIONAL CONNECTION

SIXIÈME SON

# 3

**SOUND DOESN'T REQUIRE EYES  
TO GRAB ATTENTION**

SONIC BRAND ASSETS SURPASS VISUAL CUES  
IN **GRABBING ATTENTION**

A person is holding a smartphone in their left hand and a tablet in their right hand. In the background, a television screen displays a soccer game. The scene is dimly lit, suggesting an indoor setting like a living room.

**70%**

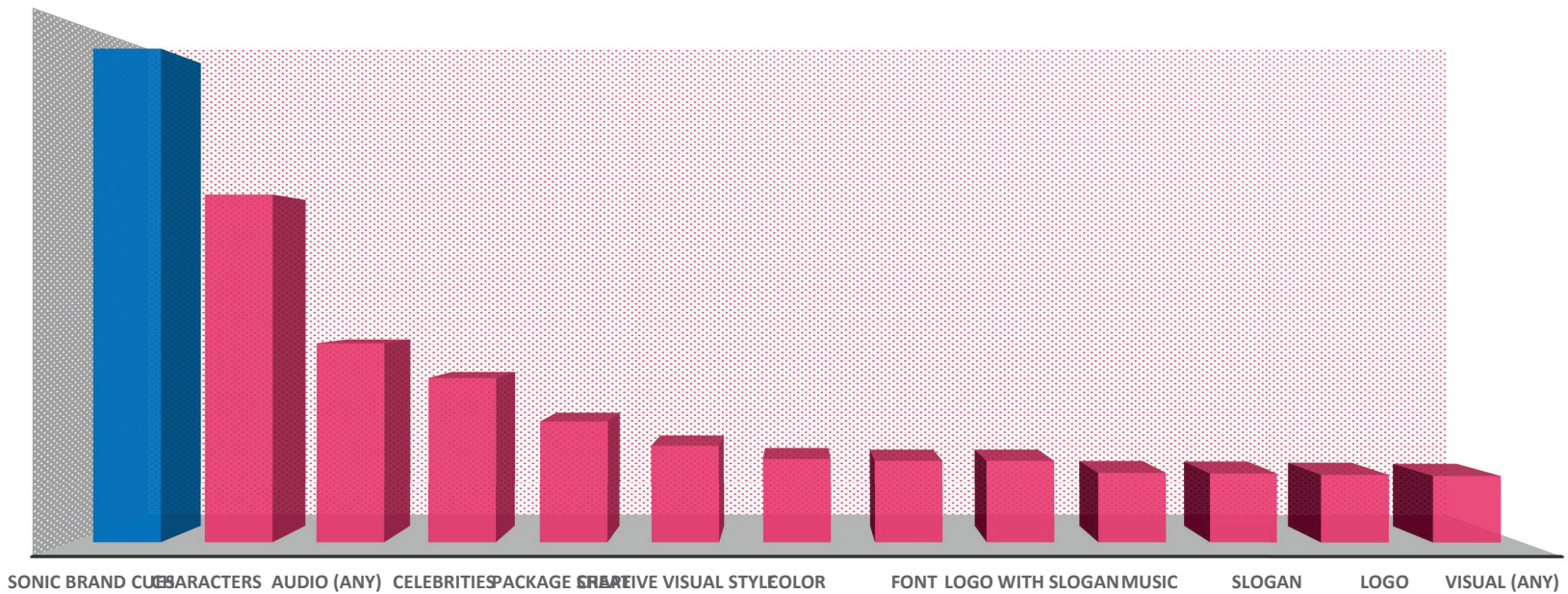
OF AUDIENCES USE OTHER DEVICES AS THEY  
“WATCH TV”, REDUCING ATTENTION SPANS

Engine Insight 2021

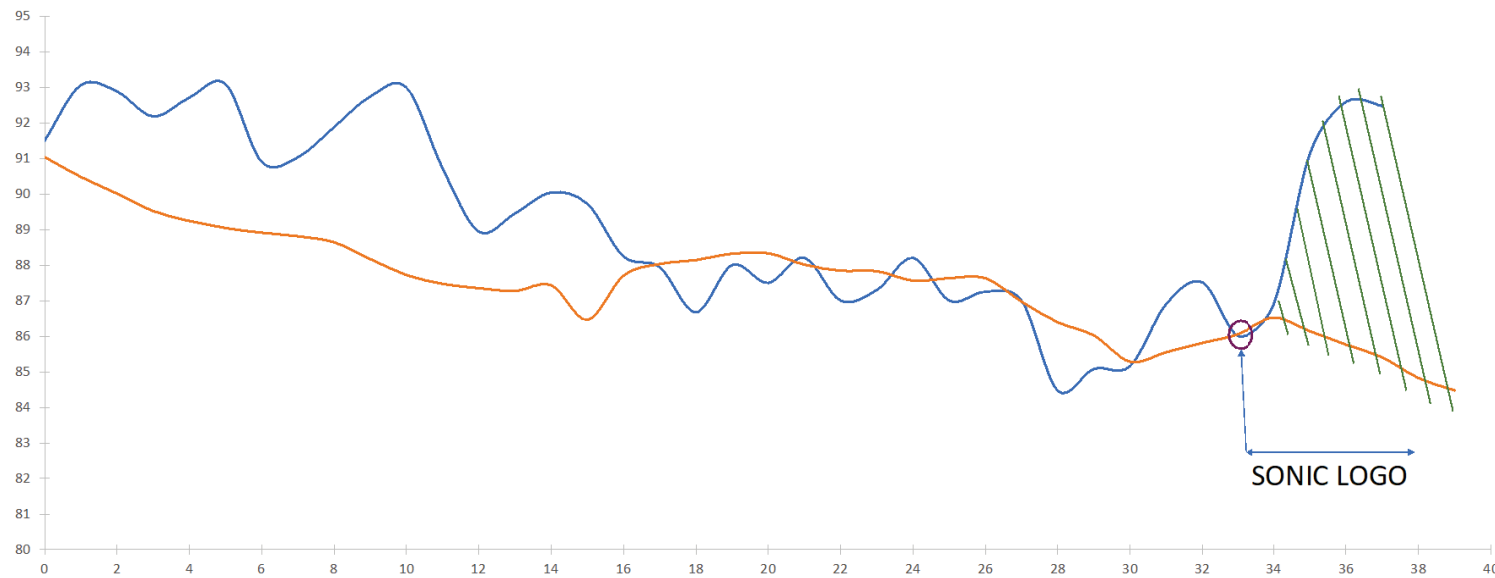


# IMPACT OF BRAND ASSETS ON BRAND ATTENTION

OVER 2000 TV ADS TESTED



## WITH A PROPRIETARY SONIC LOGO AT THE END, ATTENTION INCREASES EXPONENTIALLY



**4**

**SONIC CONVEYS MEANING IN  
LESS THAN 3 SECONDS**



Bold  
Clear  
Consistent



People first  
Friendly and inviting  
Fun



Innovative  
Intelligent  
Reliable

# 5

SOUND BRINGS **CONSISTENCE** TO A BRAND



SIXIÈME SON

# 6

MUSIC IS A LANGUAGE **UNIVERSALLY**  
UNDERSTOOD

# PERCEPTIONS ARE MORE AND MORE **UNIVERSALS**

Geographical or generational gaps are decreasing slowly, but surely.





THERE ARE MANY WAYS TO **MEASURE SUCCESS**

Many studies reflect the effect that music/sound has on the performance of the brands that are using sonic logos and evaluate how they impact:

Attention

Association.

Appreciation

Engagement

96% OF CONSUMERS ARE MORE LIKELY TO REMEMBER A  
BRAND THAT USES **MUSIC ALIGNED WITH THEIR BRAND  
IDENTITY**

Leicester University Research (2008)

41% OF CONSUMERS SAY THAT SOUND IS A KEY ELEMENT OF  
BRAND COMMUNICATION

Oxford University (2009)

74% OF YOUNG ADULTS BELIEVE THAT THEY DEVELOP A  
BETTER UNDERSTANDING OF A COMPANY'S PERSONALITY  
THROUGH MUSIC

PHMG

Veritonic audio logo index (2021)

75% OF PEOPLE LIKE RECOGNIZING A BRAND'S COMMUNICATION  
BASED SOLELY ON MUSIC

Harris Interactive Barometer 2019

# THE SONIC ASPECT MUST BE TREATED AS A **KEY BRAND ASSET**

More than 1 out of 2 people remember a brand's music or jingle more than its logo

Harris Interactive Barometer 2019



1 OUT OF 2 PEOPLE USE BRANDS' MUSIC OR JINGLES  
IN THEIR CONVERSATIONS WITH THEIR ENTOURAGE

Harris Interactive Barometer 2019

1 OUT OF 2 PEOPLE ARE CAPABLE OF IDENTIFYING  
A BRAND THEY'RE INTERESTED IN  
BASED ON ITS MUSIC OR JINGLE

Harris Interactive Barometer 2019

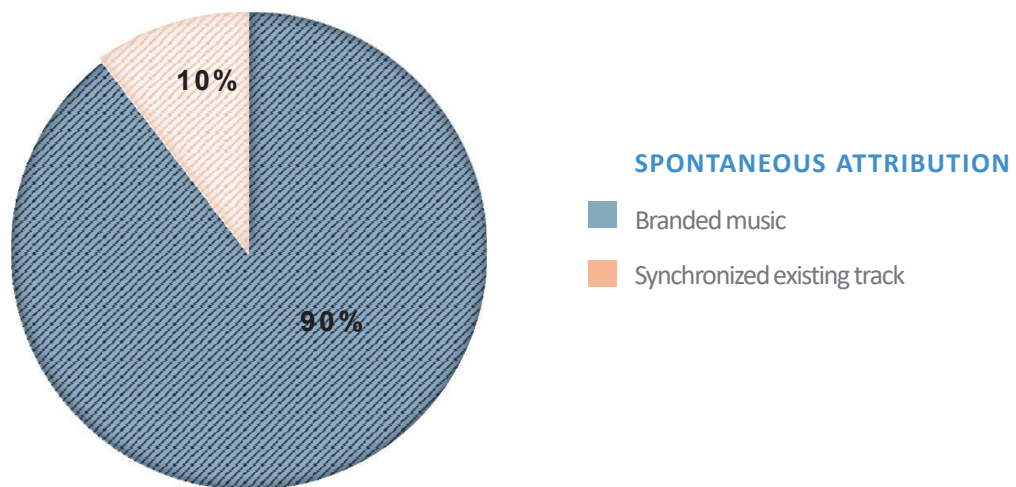
# EXPOSITION & LONGEVITY PROVES KEY TO A SONIC BRAND'S SUCCESS

75% of the best performing sonic identities have been in use for more than 5 years

Harris Interactive Barometer 2019

## TAILOR-MADE MUSIC PERFORMS BETTER FOR BRANDS

9 OUT OF 10 MUSICAL SELECTIONS THAT BRANDS CHOSE PERFORM BEST WHEN THEY ARE COMPOSED SPECIFICALLY FOR THE BRAND.

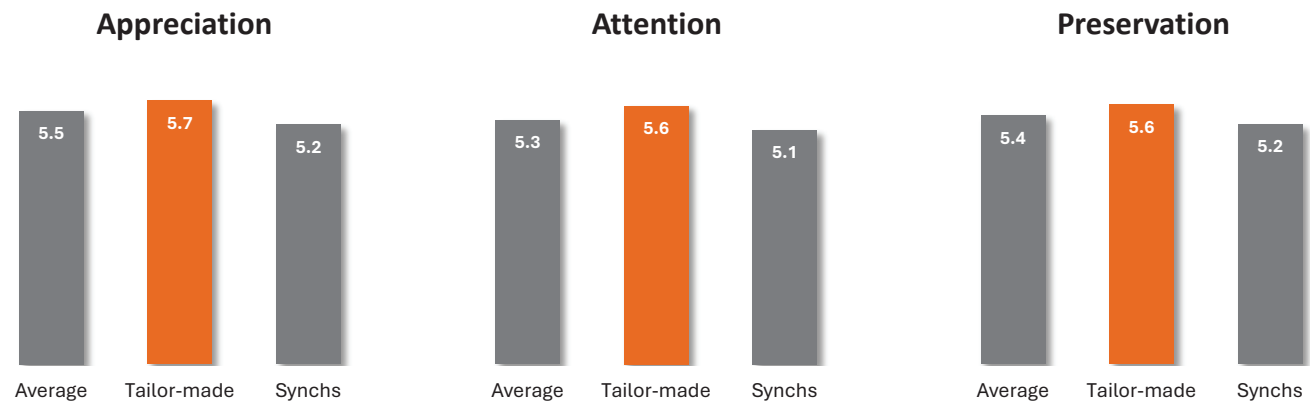


Harris Interactive Barometer 2019

## KEY TAKEAWAYS

What we learn

### TAILOR-MADE CREATIONS PERFORM BETTER THAN SYNCHS



Harris Interactive Barometer 2019

## RESEARCH AND STUDIES

Learnings

### UNIQUENESS

The feeling that there is a personality weighs heavily on the ability of a piece of music to make a difference, have stamina, and capture interest. There must be an element of surprise and an aspect different from the competition.

### ATTENTION

The ability of a piece of music to attract attention in the context of a situation. This is where we give our sense of hearing priority and allow it to activate the brain.

### ENGAGEMENT

The ability of a piece of music to provoke a reaction is indispensable to leave an impression and create a link to the brand. The engagement must also evolve appropriately to each situation and as the brand context evolves through time.

### ATTACHMENT

The attachment that the audience has to the music, their desire that it remains the same and that it remains exclusively used by the brand. A highly revealing factor, providing clarity and understanding brand compatibility.

THANK YOU!

THE SONIC YOU  
YOUR BRAND IN SOUND

Ramon Vives  
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## **The challenge of registering a sound mark in the UK - A recent case study: Sandvik**

Andy King  
Mewburn Ellis, United Kingdom



# The challenge of registering a sound mark in the UK

A recent case study: Sandvik

Andy King  
FICPI Open Forum  
25 September 2024

# A quick introduction to Sandvik

- Sandvik is a Swedish multinational engineering group that specialises in products and services for:
  - Mining
  - Rock excavation
  - Rock processing
  - Metal cutting
- Founded in 1862
- Over 40,000 employees

The screenshot shows the Sandvik website homepage. At the top, there is a navigation menu with the Sandvik logo on the left and links for 'About us', 'Products & Services', 'Investors', 'Careers', 'News & Media', and 'Stories'. On the far right of the navigation bar are links for 'Contact', 'Our websites', and 'Change language', along with a search icon. Below the navigation is a large hero image of a mining operation with a white text box containing the text: 'WELCOME TO THE SANDVIK GROUP', 'We apply our expert minds and collaborative ways of working with customers to build more resilient and stronger businesses.', and a link 'VIEW OUR AREAS OF EXPERTISE'. Below the hero image are three icons with text: 'Financial reports' (with a bar chart icon), 'Sustainability' (with a globe icon), and 'Vacancies' (with a person icon). At the bottom, there is a 'NEWS' section with two entries: 'FEBRUARY 21, 2023 — PRESS RELEASE Sandvik announces changes to the Group Executive Management' and 'FEBRUARY 15, 2023 — PRESS RELEASE Sandvik selected to supply record SEK 370 million worth of BEV equipment to'. To the right of the news section is a 'FEATURED STORIES' section with two images: one showing children in a classroom and another showing a key with the word 'FREEDOM' written on it.

# Sandvik launched a new corporate brand identity in September 2023



SANDVIK

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[Home](#) > [News & Media](#) > [News and press releases](#) > [2023](#) > [September](#) > [Sandvik introduces new logotype and visual identity](#)

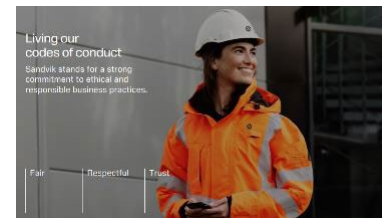
## Sandvik introduces new logotype and visual identity

**Published**  
Sep 21, 2023 8:00 AM CET

**Categories**  
General

Today, Sandvik presents a new visual identity. It highlights the company's commitment to lead the shift towards digitally driven and automated industries, and it is developed to suit the current position of the company as a technology leader enabling improved productivity, efficiency and sustainability for its customers.

Over the past few years, Sandvik has implemented a new strategy and defined a

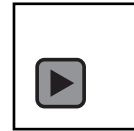


# A sonic logo was an important part of the new identity

- Created by Sonic Director Tomas Nordmark:



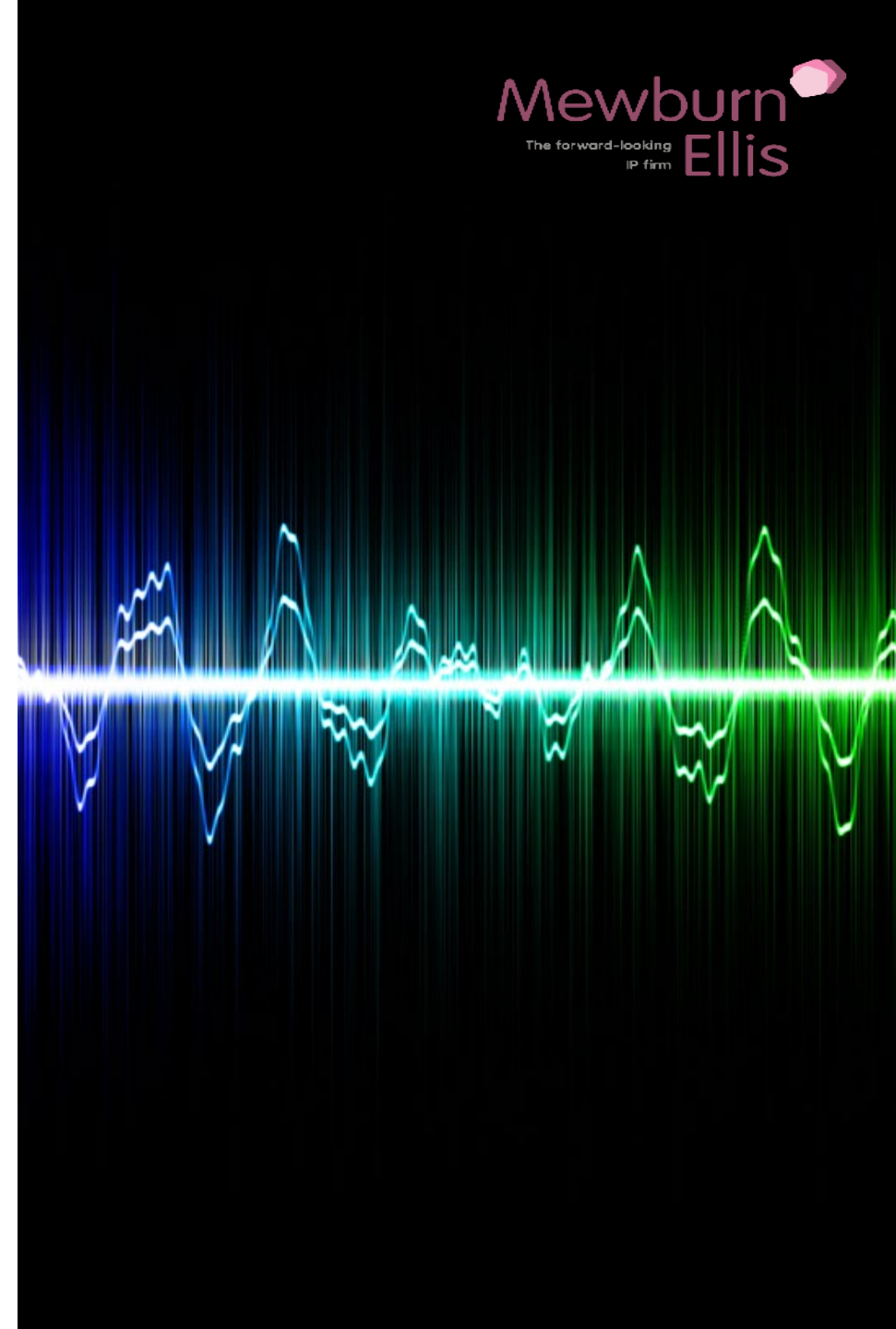
**Sandvik Sonic Logo**



**Stripped Back Version**

- We advised on protection of the sound mark well ahead of the brand launch, back in September 2022

**Can Sandvik register its sonic logo  
in the UK?**



- We advised that a non-distinctiveness objection was highly likely

**Section 3(1)(b) of the Trade Marks Act 1994**

3 (1) The following shall not be registered...

(b) trade marks which are devoid of any distinctive character...

provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.

- As sound marks are part of new corporate branding, evidence of acquired distinctiveness was never an option
- Considered contingencies of a multi-media mark or alternative sound mark featuring ‘SANDVIK’

- General guidance from the Trade Marks Act 1994 and distinctiveness authorities

## **Section 1(1) of the Trade Marks Act 1994**

A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals, colours, **sounds** or the shape of goods or their packaging

## **August Storck KG v OHIM, Case C-24/05 P**

“the distinctive character of a trade mark must also be assessed by reference to the perception of the consumers of the relevant goods and services”

## **OHIM v Erpo Möbelwerk, Case C-64/02**

“the criteria for assessing distinctive character of all types of marks are the same”

- But a lack of case law on the distinctiveness of sound marks, particularly in the UK



# The UK IPO Practice Manual's guidance on sound marks is quite light

## UK IPO Practice Manual


There is no question that sound marks can function as trade marks to designate origin...[but] the origin of goods or services is not generally designated by reference to sound only...even if the consumer may be unfamiliar with a piece of music or sound, like other unconventional marks, **the assumption that it functions also as a trade mark is unlikely to be the case, absent education.**

The following are intended only as examples of sound marks that would be unlikely to be accepted without evidence of factual distinctiveness:

- Very simple musical sequences (for example, those consisting of only one or two notes);
- Entire melodies and/or songs (for example, the well-known 'Greensleeves' melody, which may be used as a chime by ice cream van in the context of providing ice cream and confectionery);...

- Sounds marks are still very rare in practice
  - Despite changes to the EU Trade Marks Directive a few years back
  - Just 27 sound mark applications filed at the EUIPO in prior year
- Only around 250 sound marks registered in the UK
  - But 210 are Brexit 'clones' not substantively examined by the UK IPO
  - Only 10 of the remaining 40 post-date Brexit so give an insight into current examination
  - Some include spoken distinctive verbal elements
  - Others are very different sound marks

## Six generally comparable sound marks, but timelines suggest acquired distinctiveness

Regn. No.	Owner	Filing Date	Grant Date	Sign
UK00003604547	B.Braun Melsungen AG	4 March 2021	29 October 2021	
UK00003658921	Intel Corporation	22 June 2021	3 June 2022	
UK00003689393	Clear Score Technology Limited	2 September 2021	27 May 2022	
UK00003708855	Legal & General Group plc	11 October 2021	8 July 2022	
UK00003773979	Ocado Retail Limited	5 April 2022	7 April 2023	
UK00003809185	Hewlett Packard Enterprise Development LP	13 July 2022	31 March 2023	

# What about sound marks at the EUIPO?



# The EUIPO's Trade Mark Guidelines contains a little greater depth

## EUIPO's Trade Mark Guidelines

The acceptability of a sound mark must, like words or other types of trade marks, depend on whether the sound is distinctive per se

Whether the average consumer will **perceive the sound as a memorable one** that serves to indicate that the goods or services are exclusively associated with one undertaking




A sound must have '**a certain resonance**'...enabling the target consumer to perceive and consider it a mark...

... However, marketing habits in an economic sector are not fixed and **can evolve** in a very dynamic way, including as regards the use of sound marks....

The kinds of sound marks that are unlikely to be accepted without evidence of factual distinctiveness include:

- Very simple pieces of music consisting of only one or two notes (see examples below)
- Sounds that are in the common domain (e.g. La Marseillaise, Für Elise)
- Sounds that are too long to be considered as an indication of origin
- Sounds typically linked to specific goods and services

## The EUIPO's Guidelines even have some examples of acceptable sound marks

Regn. No.	Filing Date	Sign	Reasoning
017396102	26/10/2017		The sign is short but it is not too simple and is capable of being memorised by the relevant consumer.
011530326	30/01/2013		Jingle-like sound sequences are capable of identifying goods and services.
011893054	12/06/2013		According to general life experience, jingle-like sound sequences enable goods and services to be distinguished.

# Some recent EU case law is more encouraging

## **Globo Comunicação e Participações S/A v EUIPO**

**(Case T-408/15, 7 October 2016)**




Introduced a framework for considering the issue of inherent distinctiveness in the context of sound marks, with there being two main criteria for consideration: **consumer habits and trade practice**, and the characteristics of the mark itself

## **Ardagh Metal Beverage Holdings GmbH & Co. KG v EUIPO**

**(Case T-668/19, 7 July 2021)**

Provided a series of considerations regarding the criteria for assessing the distinctiveness of sound marks and the general perception of this type of mark among consumers

# Comparable sound marks at the EUIPO: timelines suggest no issues

Regn. No.	Filing Date	Publication Date	Grant Date	Sign
018800487	24/11/2022	12/01/2023	21/04/2023	
018825877	25/01/2023	31/01/2023	10/05/2023	
018735576	21/07/2022	27/09/2022	06/01/2023	
018722396	26/06/2022	17/08/2022	24/11/2022	
018717394	14/06/2022	07/07/2022	14/10/2022	
018698949	06/05/2022	13/06/2022	20/09/2022	
018657963	18/02/2022	12/05/2022	19/08/2022	



## An application was filed...and the refusal soon issued

There is an objection...as the mark is **devoid of any distinctive character**. This is because the marks consist of a musical tune that would not be instantly recognisable as a trade mark by the average consumer. It is considered that without education, the public would **not attribute any trade mark significance** to the sign and would instead perceive the marks merely as a non-distinctive musical tune

- A cautious approach because of the lack of sound mark precedents
- The reference to “without education” alludes to the possibility of relying on evidence of acquired distinctiveness/secondary meaning

# The response to the objection focused on four main arguments

- The sonic logo was in the ‘sweet spot’ for a sound mark
  - An easily-recallable jingle
- Marketplace evidence on the rise of sonic branding
  - Changing consumer habits
  - Case law and practice outdated
- EUIPO precedents
- Minimum level of inherent distinctiveness is reached
  - The pause or rest before the fourth note in particular creates an air of suspension, tension or perhaps intrigue amongst listeners
  - Consumers can recall the sound mark(s) and repeat a purchase based on it

# Examples of the marketplace evidence

28/04/2023, 16:10

What is sonic branding, and how can you make the most of it?  
power of sound in your brand-building, you're losing out.

Previously, we've looked at the ways you can [use sound to increase sales in your retail store](#). But sonic branding isn't limited to one location. It's a wider use of sound that spreads your message throughout society and culture. And that means it can seriously enhance your profitability.

Whether you're a retailer, online seller, cultural institution or public service, you've got a big opportunity for growth by using sonic branding.

We'll take a look at what it is and the different ways you can use it. We'll also take a deeper look at the ideal home for sonic branding – the retail store.

### What is sonic branding?

English **Sonic branding, also known as audio branding, is the expression of your brand through sound.**

It most commonly appears through a 'jingle' – a short, instantly recognisable piece of music or sound that customers link to your brand. Popular global examples of this are McDonald's ('I'm Lovin' It'), Apple (the startup sound their computers make), Amazon (the voice of Alexa, the interactive assistant), and Microsoft (the Windows startup sound). You might think of these as 'audio logos'.


But it has a much wider scope. Just like a brand's visual assets consist of their logo, visual style, typeface, animations, product, product packaging and more, their sonic branding exists through lots of different channels.

Made in

<https://www.akoustico-arts.com/blog/what-is-sonic-branding-and-how-can-you-make-the-most-of-it?text=sonic%20branding%2C%20also%20know>

28/04/2023, 16:21  
Sonic Branding: What Is It and How It Can Speak Volumes for Your Brand  
May 10, 2022 11 min read

## Sonic Branding: What Is It and How It Can Speak Volumes for Your Brand



Any '90s kid knows the original Nokia ringtone, AOL's "You got mail" sound or the Disney intro theme. Sound is powerful and can trigger memory, instantly transporting you (even for a millisecond) to the memory and feeling of every time you've heard it. According to Spotify's annual 2021 Culture Next Report: "63% of millennials feel that audio is the most immersive form of media and 65% of Gen Z agrees that audio helps them experience a situation more deeply."

And as experienced from the Apple iPhone ringtone or even the pleasant song your dishwasher makes when it's finished a cycle, it's also a surefire way to grab your attention. As brands fight for our eyeballs on every screen available, they're shifting towards asking audiences to listen rather than look. And audiences are increasingly receptive: Edison Research's findings in The Infinite Dial show that 73% of the U.S. 12+ population (an estimated 209 million people) have listened to online audio in the last month, up from 68% in 2021. With the wireless headphones market trajectory believed to reach \$45.7 billion by 2026 and more brands using artificial intelligence to generate realistic sounding voices for ads and content, it's no wonder 2022 is shaping up to be the year of the "sonic boom."

As the industry evolves, brands need to keep up and reach their audiences in the spaces where they are, in the way they want to be reached. Everything from social sonic entities to multimedia experiences in the metaverse presents audio opportunities for brands: "Audio is essential to navigation and communication

<https://www.wix.com/blog/2022/05/sonic-branding/>

28/06/2023, 16:16

Your Guide to Sonic Branding: A Sound Strategy For Business Growth

START HERE

BRANDING MARKETING 10 MIN READ | by Robert Hodgson

## Your guide to sonic branding: A sound strategy for business growth

f w @ in

1 a crowded marketplace packed full of new ideas, innovative products, and exciting companies, branding is more important than ever.

most marketers and business owners, the easiest way to imagine a brand is by visualising logos, specific colours, and popular marketing materials. However, there's more to a company than how it looks. Sonic branding is about making that your organisation is 'heard', as well as seen.

[Your guide to sonic branding](#)

4/23

## But the UK IPO Examiner was not persuaded

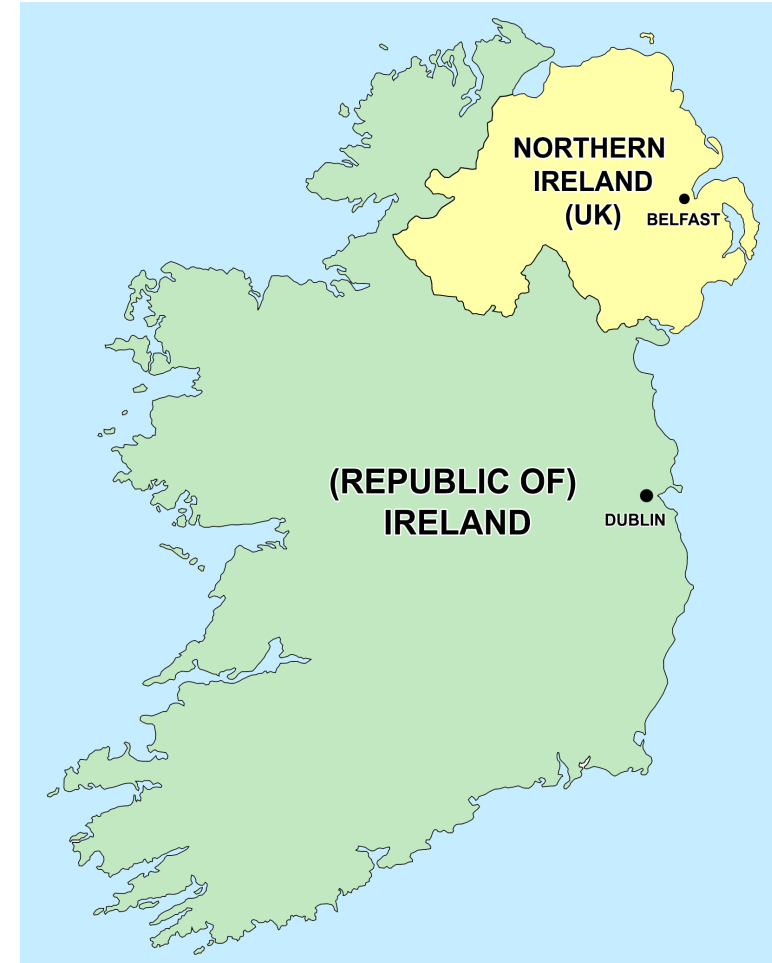
- In a thorough response to our submissions, the Examiner maintained the refusal

...while the sonic logos could be capable of performing a trade mark function and therefore being distinctive, this is not going to happen ab initio – a period of time for **consumers to be educated** to the sounds functioning as marks will be required.

- A Hearing was requested

# Additional arguments and evidence were filed before the Hearing

- What other function the sound mark is performing, if not a trade mark function?
  - It is too short to be a regular song
- Common use of sound marks in the market
  - Both general market and Sandvik's specific industrial/manufacturing sector
  - UK marketplace evidence from other companies that use sound marks
  - The relevant professional consumers are used to hearing and accepting sonic logos functioning as indicators of trade origin and knowing them to be 'brand stamps'
- EUIPO precedents should be highly influential
  - Dublin versus Belfast consumers (100 miles away)



# The extra evidence filed before the Hearing

Example of Sonic Logos in Use

Company / Owner	Sonic Logo	Registered (if known)?	Comments / Notes
<b>Industrial and/or manufacturing B2B market sectors</b>			
1. Thales	<a href="#">Video 1</a> , <a href="#">Video 2</a>		
2. Honeywell	<a href="#">Video 3</a> (last few seconds)		
3. Delphi Automotive	<a href="#">Video 4</a> (last few seconds)		
4. Salzgitter AG	<a href="#">Video 6</a> (last few seconds)		
5. Hydro	<a href="#">Video 7</a>		
6. Vestas	<a href="#">Audio 1</a>		
7. ABB	<a href="#">Audio 2</a>		
8. Siemens	<a href="#">Video 8</a> (first few seconds)		
9. Enel	<a href="#">Audio 3</a>		
10. Schneider Electric	<a href="#">Video 9</a>		
11. Linde	<a href="#">Audio 4</a>		
<b>Other B2B market sectors (not B2C)</b>			
12. Beryllium	<a href="#">Audio 5</a>		
13. Biamp	<a href="#">Audio 6</a>		
14. European Society of Cardiology (ESC)	<a href="#">Audio 7</a>		

A Selection of Various Sonic Logos in Use in Industrial Sectors

1. <https://www.youtube.com/watch?v=3LWVUJWBrk> – YouTube GB - Careers with Thales UK (sonic logo/sound mark in the last few seconds).

4. <https://www.youtube.com/watch?v=odOPK-CWNC0> – YouTube GB - The Future Is Podcast - Sustainable Innovation (sonic logo/sound mark in the opening seconds).

# The Hearing Officer's decision issued shortly after the Hearing


“...I would agree that the use of sonic branding is [now] prevalent in the manufacturing and industry sectors. I would also contend that in light of [the] submissions it is clear that consumer perception of sounds as trade marks has evolved and what might have been considered non-distinctive some decades ago may now be considered distinctive.

I have also taken into consideration [the] compelling submissions and I agree that the marks have a certain resonance that will enable the target consumer to perceive and regard them as trade marks.

The objection is waived”.

- A landmark decision and a change in practice...?
  - Acknowledges a change in marketplace recognition of sound marks
  - May have some precedential value going forwards

# Success!

 Intellectual Property Office

[New search](#)

Trade mark number

**UK00003893778**

**Status**

Registered

[View historic details](#)

**Trade mark type**

Sound mark

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**Dates**

**Filing date**

27 March 2023

**Date of entry in register**

08 December 2023

**Renewal date**

27 March 2033



[https://trademarks.ipo.gov.uk/ipo-  
tmcase/page/Results/1/UK00003893778](https://trademarks.ipo.gov.uk/ipo-tmcase/page/Results/1/UK00003893778)





## Any questions?

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## **SOUND MARKS in the U.S.**

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***SOUND MARKS in the U.S.***

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## ***What is a registrable sound mark?***

- A mark that identifies and distinguishes a product or service through audio means
- Must be arbitrary, unique, or distinctive to be registrable on Principal Register
- Commonplace sounds (sound marks for goods that make the sound in their normal course of operation) can be registered with a showing of acquired distinctiveness

# ***Drawing & Specimen Requirement***

- Drawing
  - Select “sound mark” in application and submission of audio reproduction (.wav, .wmv, .wma, .mp3, etc.)
- Specimen
  - Submit a specimen that contains a sufficient portion of the audio or video content to show how the mark is used in connection with the goods/services
  - For products, consider displays associated with the goods (e.g., DURACELL – played sound in stores where batteries sold)



## ***Is distinctiveness required?***

- No – only if the product makes the sound in its normal operation (e.g. alarm clocks, appliances with audible alerts, mobile phones rings, etc.)
- Motorola/Nextel: electronic chirping sound made by phone could not be registered because its was not inherently distinctive and had not acquired secondary meaning
  - Chirp applied to two-way radios lacked distinctiveness
  - Chirp applied to cell phones was not inherently distinctive and had not acquired distinctiveness (Motorola failed to provide sufficient evidence that the chirp was recognized as a source identifier and Nextel's contemporaneous use rebutted claims of substantially exclusive use)

## ***How do you prove distinctiveness?***

- Show acquired distinctiveness via substantially and exclusive continuous use
- Show acquired distinctiveness via evidence of recognition: surveys, promotional efforts, sales, length of use, awards, press, etc.

## Case Example – Zippo (RN 5527388)

- Mark description: sounds of a windproof lighter opening, igniting, and closing
- Goods: lighters for smokers
- Office Action:
  - Failure to function (not source indicator)
  - Information request:
    - Submit evidence/explanation of how mark is used on/with goods in order to determine whether or not the sound is emitted in normal course of operation of goods
      - If sound is emitted in normal course:
        - Claim acquired distinctiveness; or
        - Amend to the Supplemental Register





# Zippo

- Admitted the goods make the sounds in the normal course of operation and claimed acquired distinctiveness with evidence and supporting declaration
  - Long term use (since 1933)
  - Advertising (“You can even tell a genuine ZIPPO in the pitch dark!”)
  - Media articles (discussing, e.g., some people just like the “click”)
  - Entertainment industry (Eric Clapton using sound in song “It’s Probably Me,” literary works, numerous television and movie works), Broadway musical “Stomp”
  - Professional and consumer statements

# Zippo

- USPTO refusal
  - Not convinced sound is a source indicator
  - No sales or advertising expenditures
  - Advertising does not refer to all three sounds claimed
- Zippo response
  - Provided sales and advertising expenditures
  - Reinforced in simple statement that “magnitude of evidence” clearly demonstrates that consumers have come to identify the mark, including portions thereof, as a source indicator of products

## ***Functionality hurdle***

- A sound is not a trademark if it is functional
  - Loud, pulsing sound denied registration as a mark for personal emergency alarms
  - Allegedly distinctive sound of Harley-Davidson motorcycle engines (SN 74485223)



# Examples of Registered Sound Marks





**Thank you!**

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