

Trade-marks Rock.

By Chris Bennett and Jeannine Tse

When you think of some of the most valuable trade-marks in the world, you probably think of marks like COCA-COLA, MICROSOFT and IBM. You might also think of some logos, such as McDonalds' *Golden Arches* or Nike's *Swoosh* design. But what about the *Intel Inside* tune, or the Harlem Globetrotters' *Sweet Georgia Brown* theme, or Nokia's distinctive ring tone? Are these protected under trade-mark law?

Unregistered Protection

The short answer is that sound marks are protected by the common law if their owners can prove: (a) there is goodwill in the marks (i.e., the marks have developed a reputation), (b) a third party's use of a similar mark is deceiving the public, and (c) the third party's use of the marks is causing damage to the owner.

Common law trade-mark protection is great, but it's a lot of work and it can be very expensive. Also, the protection only applies to the geographic area where the mark has developed a reputation. That's why registering trade-marks is a much better solution: the owner of a registered mark doesn't need to have or prove any reputation in the mark in order to protect it.

Registered Protection

Unfortunately, it's extremely difficult to register sound marks in Canada. There appears to have been only one sound mark registration in Canada. The mark was owned by Capitol Records, but was expunged in 2005 because it was not renewed.

One of the difficulties in getting sound marks registered in Canada is a 1986 Federal Court of Canada case where the court ruled that a trade-mark must be something that can be represented visually. This requirement certainly isn't in the Canadian *Trade-marks Act*, which defines a trade-mark as "a mark that is used by a person for the purpose of distinguishing or so as to distinguish..." This definition does not explicitly exclude a sound from being registrable as a mark, and in fact appears to be broad enough to encompass a sound as long as that sound is used to distinguish the wares and services of one source from those of another.

Another difficulty is describing the sound. Unlike traditional trade-marks which can be represented visually, even the most elaborate description of a sound can't be truly understood and experienced unless it is played through some other means, such as on a musical instrument. And some sound marks (such as MGM's roaring lion) are even harder to describe because they can't be easily translated into musical notes.

MEMO

Page 2 of 3

These difficulties haven't prevented other countries from registering sound marks. The Intel, Globetrotters and Nokia marks listed above have all been registered in other trade-marks offices. Dozens of sound marks have been registered in the US alone.

The fact is that many of these marks are highly distinctive and recognizable trade-marks. They should be registrable in Canada.

The National Anthem

How about CBC's *Hockey Night in Canada* theme? It's been played as part of CBC's coverage of hockey games in Canada for 40 years. CBC doesn't own the copyright in the theme, and recently lost its licence to use the theme as part of its hockey coverage. However, the fact that CBC did not own the copyright in the theme wouldn't have prevented CBC from registering the theme as a trade-mark.

As it turns out, CBC didn't register the theme as a trade-mark. Even if it had, the registration would have been vulnerable to attack now that the CBC has lost its copyright licence and its right to use the song in its hockey coverage.

The Other National Anthem

There has recently been controversy regarding Canada's official national anthem. The Vancouver Organizing Committee for the 2010 Olympic and Paralympic Winter Games (VANOC) recently applied to register "WITH GLOWING HEARTS" and "DES PLUS BRILLIANTS EXPLOITS" as trade-marks. These phrases were derived from the English and French versions of Canada's national anthem.

When these applications became public, there was a bit of an uproar. Some people were concerned about VANOC commercializing and monopolizing an important part of Canadian culture. Others were concerned that they would be infringing VANOC's trade-mark rights by simply singing the national anthem (although this is not a valid concern: singing the national anthem is not the same as using phrases from the national anthem in connection with products or services).

From a trade-marks law perspective, VANOC's marks should be registrable as trade-marks, as long as they're not confusing with any third parties' trade-marks, and not being used in a descriptive manner. VANOC could also protect the marks as "official marks" which is a special form of protection available to public authorities.

VANOC has aggressively protected its trade-marks in advance of the upcoming Vancouver Olympics, and has even been successful in having new legislation created to specifically protect its



MEMO

Page 3 of 3

trade-marks. Is VANOC up to the challenge of protecting the Olympic theme music as a sound mark in Canada?

-=-

Chris Bennett is the head of Davis LLP's Trade-marks and Technology Groups. Jeannine Tse is an articulated student at Davis LLP.