



MAKE SOME NOISE: CANADIAN INTELLECTUAL PROPERTY OFFICE TO ACCEPT SOUND MARKS

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This order will indeed give rise to a significant change in practice by which the Canadian Intellectual Property Office (CIPO) will now accept sounds as trade-marks.

Although sounds have already been recognized as registrable trade-marks within several jurisdictions, including in the United States and the European Union, Canada rather acted as a discordant voice by refusing to accept them as such.

Through the issuance of a Practice Notice dated March 28th, 2012, CIPO remedied the situation while clarifying the requirements for registration applications concerning sounds as trade-marks. Said Practice Notice reverses CIPO's longstanding policy to not accept sound marks.

An application for the registration for a sound mark should therefore include the following information:

- a statement indicating that the application is for a sound mark;
- a drawing that graphically represents the sound mark;
- a description of the sound; and
- an electronic recording of the sound.

The Practice Notice further indicates that the only electronic recordings that will be accepted must be either in MP3 or WAVE format, have to be limited to 5 megabytes in size and be recorded on a CD or DVD.

Any submitted electronic recording should not include any looping or repetition of the sound mark which is the object of the application.

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^{*} From ROBIC, LLP, multidisciplinary firm of Lawyers, and Patent and Trade-mark Agents. Published in the Spring 2012 (Vol. 16, no. 1) Newsletter of the firm. Publication 068.147E.

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For the time being, any application for a sound mark shall be submitted on paper and not through CIPO's online filing system. Applicants shall submit the recording of the sound upon production of their application.

As with any other trade-marks, the sound mark will have to meet the other requirements for registration, including being used for the purpose of distinguishing the wares or services associated with it from those of others.

Although it is not possible to search the Canadian trade-marks database for sound marks at this moment, it is nevertheless possible to listen to them when accessing to the sound marks section now available on CIPO's website.

Since the publication of the Practice Notice and except for MGM's mark, less than 10 sound marks have been applied for. In comparison, it is worth noting that there are currently less than 1 000 sound marks on the American register, which approximately includes 4 millions trade-marks.

Beyond the initial enthusiasm that sound marks may create in Canada, it remains to be seen whether, as time passes, we will say that they made much noise for nothing, or else if they will be considered a resounding

success. **ROBIC** + LAW
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