

CONVENTIONALISING NON-CONVENTIONAL TRADEMARKS OF SOUNDS AND SCENTS: A CROSS-JURISDICTIONAL STUDY

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ABSTRACT

This article is a comparative study of the reception given to three specific non-conventional trademarks – sound, scent and shapes – in India, the European Union and the United States of America. It is concluded that whilst America has adopted a liberal approach towards the registration of these marks, the EU has been more cautious in its reception of these marks. India, as can be gauged from the Draft Manual for Trademark Practice & Procedure, a guide to the Trade Marks Act, has simply imported the EU approach. In the context of these different approaches, it is argued that provided non-conventional marks satisfy the basic tests required of any mark for securing registration there is no reason why these marks should not get registration. The argument that they represent an unreasonable restriction on the availability of intellectual property resources is not tenable as only those properties which have exhausted all avenues of intellectual property rights protection can be said to be free. Moreover, visual perceptibility should not be and is not a sine qua non for building brand association in the minds of the consumers. Non-conventional trademarks, being multi-sensory in nature, also cater to consumers who are visually impaired and illiterate.

INTRODUCTION

Trademark law continues to be one of the most interesting branches of law, not just in the realm of intellectual property law but in terms of general legal developments as well. The rationale behind trademarks is multi-layered. A trademark is economically efficient because it allows the consumer to identify the service or good that he prefers and to buy that to the exclusion of others in the future.¹ Consequently, the maker of the preferred good is encouraged to maintain the production of quality goods.² Moreover, since good quality is associated with that particular trademark, infringement claims exist when another undertaking uses a similar mark. This prevents the latter from unjustly enriching from the labour and reputation of the holder of the original mark, and protects consumer interests.³

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1. I J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION 2-3 (4th ed. 2000).
2. *Zippo Mfg. Co. v. Rogers Imports, Inc.*, 216 F. Supp. 670, 137 U.S.P.Q. 413 (S.D.N.Y. 1963).
3. *B.V.D. Co. v. Kaufmann & Baer Co.*, 272 Pa. 240, 116 A. 508 (1922); *Palmer v. Harris*, 60 Pa. 156 (1869).

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A Cross-jurisdictional Study*

Traditionally, firms have registered words or certain logos/designs as trademarks.⁴ However, increasingly all over the world, recognizing the potential contained therein, different combinations have been sought to be trademarked.⁵ This includes a variety of things ranging from the Intel jingle to the shape of the Coca Cola bottle. The common feature of all these marks is that none of them are visually perceptible, and hence the label of ‘non-conventional’ has been conferred on them. Trademark law has traditionally stressed on visual perceptibility,⁶ as it enables trademark authorities, competitors and consumers to have clarity on *what* has secured trademark protection. Nonetheless, statutes have been amended,⁷ making place for non visual trademarks. Such inclusion has brought with it a requirement in most jurisdictions that the mark be capable of “graphical representation”. Hence, for instance, a smell would only be registered if, *inter alia*, it was capable of being graphically represented. Such a requirement has been brought in for enabling competitors and others to know what has been trademarked. This requirement is in addition to the standard requirements that the mark be unique and not be an inherent part of the product itself.⁸ Such an amendment has necessitated the inclusion of a graphical representation requirement.

The inclusion of non-conventional trademarks raises various questions: Is their inclusion leading to an undesirable depletion of available intellectual property resources? Are these marks capable of fulfilling the purpose of the trademarks? Finally, does the fact that these marks are not visually perceptible create any confusion on *what* has been registered?

This article seeks to present an informed analysis of these issues with the help of a cross-jurisdictional analysis between India, the European Union and the United States of America. It is argued that the registration of non-conventional trademarks is a desirable phenomenon because it serves a vital commercial, economic and legal purpose. Part I and II of the article examine the treatment of non-conventional trademarks in the European Union and the United States respectively. Part III discusses the existing legal regime concerning non-conventional trademarks in India. Part IV examines the possibilities of registering non-conventional trademarks and its desirability.

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4. For example, the swoosh and the phrase “Just Do It” are trademarks of the sports company Nike.
 5. David Vaver, *Intellectual Property: The State of the Art*, 116 L.Q. REV. 621, 625 (2000).
 6. For instance, in the Indian context, the Trade and Merchandise Marks Act, 1958 did not contain any references to non-conventional trademarks.
 7. For example, § 2(1)(zb) of the Indian Trade Marks Act, 1999 deviates from the 1958 Act by putting a wide criterion for registration – it should be capable of being represented graphically and it should be distinctive. A combination of colours has been expressly introduced.
 8. That is, the mark should be distinctive and non-functional, respectively.

I. NON-CONVENTIONAL TRADEMARKS: *THE EUROPEAN UNION*

European trademark law comprises the national laws of countries in line with European Directives, along with the decisions of the European Court of Justice (ECJ); the Madrid Protocol acting as another significant source of norm-setting. Trademarks can either be registered at a national level or achieve the status of a Community Trademark (throughout EU) by registration at the Office for Harmonisation in the Internal Market (OHIM). In this part, I delve upon the treatment that scent and sound trademarks have received in the EU. The issues discussed in these judgments are the ones truly essential to any discussion on non-visual trademarks. They relate to the distinctiveness of such trademarks. Further, they question whether it is necessary that the mark must be capable of being graphically represented and if yes, whether certain marks are capable of it. It is to be noted that the cases are mostly in the context of Article 2 of the First Council Directive of 21st December 1988 (Article 2),⁹ which provides for the graphical representation requirement.

A. Scent Trademarks

The early relevant cases relating to scent were decided by the English judiciary under the United Kingdom Trade Marks Act, 1994, enacted to implement the European Community Directive 89/ 104/EEC (Directive).

The first undertaking which sought to register a scent under the 1994 Act was Chanel for the scent of its fragrance Chanel No. 5. The application was rejected on the grounds of being functional; the fragrance was the product itself.¹⁰ On the same day, Sumitomo Rubber Co. sought the registration of “a floral fragrance/smell reminiscent of roses as applied to tyres”¹¹ and Unicorn Products sought to register “the strong smell of bitter beer applied to flight darts”.¹² Both these applications were successful.¹³

9. It states that the “[s]igns of which a trade mark may consist: A trade mark may consist of any sign capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.”

10. Chanel’s Application, 31 October 1994, *cited from* Nathan K G Lau, *Registration of Olfactory Marks as Trademarks: Insurmountable Problems?*, 16 SINGAPORE ACADEMY L. J. 264, 265 (2004).

11. Sumitomo Rubber Co’s Application No. 2001416, 31 October 1994.

12. Unicorn Products’ Application No 2000234, 31 October 1994.

13. Another relevant case which came before the OHIM is the case of ‘Freshly Cut Grass’, Second Board of Appeal, European Court of Justice, Case R 156/1998. An application was sought to register the “smell of freshly cut grass” for tennis balls, in the European Community. The OHIM held that the smell was distinctive, and the description was in compliance with Article 4 of the Community Trade Mark Regulations.

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A landmark case determined by the ECJ is the case of *Ralf Sieckmann v. Deutsches Patent und Markenamt*.¹⁴ In this case, Mr. Sieckmann sought trademark protection in respect of his conglomeration of businesses. He represented the mark by denoting its chemical composition, giving the chemical formula, and specifying that samples could be found in local laboratories listed in the Dutch Yellow Pages. He also submitted a sample, stating that the scent was usually described as “balsamically fruity with a slight hint of cinnamon”.

The application was rejected at various levels on the ground that it did not fulfil the requirement of Article 2. The preliminary ruling was essentially on whether smells were registerable and whether the stated methods of graphical representation were adequate.

Noting that the signs mentioned in Article 2 did not constitute an exhaustive list, the Court ruled that a scent could receive trademark protection provided it is graphically represented. Such representation “must enable the sign to be represented visually, particularly by means of images, lines or characters...”¹⁵; it should be clear, intelligible and self-contained. The purpose of the graphic representation was to enable the competent authorities, tradesman/ competitors and the general public to ascertain the precise sign for which protection was being sought for, by checking the public registry.

Regarding the method of graphical representation, the Court noted that few people could ascertain the scent by reading a chemical formula; further, the formula actually denoted the substance and not the scent. A mere written description, though graphical, was not precise or clear. An odour sample was not graphical, nor stable or durable. Therefore, the Court ruled that none of these methods, individually, or in combination, constituted valid representation. Thus, the application was rejected.¹⁶

It is interesting to note that the Court did not lay down what constituted a *valid* graphical representation for the purposes of Article 2. In not doing so, and in striking down the aforementioned methods, the ECJ has severely restricted the scope of registration of scents. In fact, various academics have commented that registration of scent is now impossible.¹⁷

14. *Ralf Sieckmann v. Deutsches Patent und Markenamt*, Case C-273/00, 12 December 2002, European Court of Justice [hereinafter *Sieckmann*].

15. *Id.* at ¶ 46.

16. *See Sieckmann*, *supra* note 14, at ¶¶ 56-73.

17. *See* Paul Leo Carl Torremans, *Trademark Law: Is Europe Moving Towards an Unduly Wide Approach for Anyone to Follow?*, 10 J. INTEL. PROP. RIGHTS 127, 131 (2005); David Vaver, *Unconventional and Well-Known Trademarks*, SING. J. LEGAL STUD. 1, 7 (2005); Susanna HS Leong, *Conditions for Registration and Scope of Protection of Non-Conventional Trademarks in Singapore*, 16 SING. ACAD. L. J. 423, 441(2004).

B. Sound Trademarks

The most relevant case, landmark in its consequence, is the case of *Shield Mark BV v. Kist*.¹⁸ The ECJ decided on whether sounds could be trademarked, and if yes, could they be graphically represented, as per the provision in Article 2.¹⁹

The Court ruled that as per Article 2 a sign needed to possess two features: the capability of graphical representation and the characteristic of distinctiveness in that the sign will enable consumers to distinguish between the goods and services of two or more firms. Sound, the ECJ opined, could be graphically represented. If a sound was distinctive, the Court stated that there was no reason why it could not receive trademark protection.²⁰ On the need for the requirement of graphical representation, the same was required especially as these signs were not capable of visual representation.²¹

In this light, the Court analysed the various trademarks. Regarding the description of a sound by virtue of a written description, the ECJ ruled that this lacked precision and clarity and hence did not constitute a graphical representation. Regarding onomatopoeia, the ECJ noted that there was a difference between the sound sought to be trademarked and the onomatopoeia, once pronounced. Therefore, there was no precision and clarity; hence it did not constitute graphical representation.²²

However the ECJ ruled that a stave divided into bars and showing a clef, musical notes and the rest showing the relative value helped determine the pitch and duration. Apart from being precise and self-contained, the ECJ was of the opinion

18. *Shield Mark BV v. Kist*, Case C-283/01, The European Court of Justice [hereinafter *Shield Mark*].

19. The facts of the case are as follows: *Shield Mark* was a Dutch firm which had registered a collection of trademarks comprising: 1. Four trademarks denoted by representation of the melody formed by the first nine notes of the musical composition *Für Elise* described on the stave; 2. Four trademarks of the first nine notes of *Für Elise*. These contained a description of the melody and one which was played on the piano; 3. Some marks denoted by the sequence: E, D#, E, D#, E, B, D, C, A; 4. Two represented by the reproduction of the melody; 5. Two of them represented by the denomination *Kukelekuuuuu* (an onomatopoeia which in Dutch denoted a cockcrow). The written description too was given. The ECJ had to decide on the registerability of scents, and if yes, whether the above 5 constituted valid graphical representation.

20. In an apparent endorsement of the potential of sound trademarks, the Court also noted that sounds and noises were perceptible by human beings, and similar to visual representations they too could be remembered and recalled.

21. The ECJ also reiterated the rationale behind graphical representation as stated in *Sieckmann*. A clear, precise, self-contained representation was required in order that third parties could ascertain over what the holder had a trademark over.

22. Musical notes, such as E, D#, E, D#, E, B, D, C, A did not make it possible to ascertain the pitch and the duration of the sounds. Lack of precision and clarity thus prevented it from being sufficient. See generally ¶¶ 51-64, *Shield Mark*.

that this representation was durable, intelligible and easily accessible. Significantly, noting that the description may not be immediately intelligible, the ECJ observed that “it may be easily intelligible”, thereby allowing the public, especially the traders to determine the precise sign whose trademark was being sought for. The judgment thus in effect greatly restricts the scope of registration of sound marks.²³

II. NON-CONVENTIONAL TRADEMARKS: *UNITED STATES OF AMERICA*

In the United States of America, the Lanham Act²⁴ provides for the protection and registration of trademarks at the federal level. The U.S. Patent and Trademark Office (U.S.P.T.O.) administers the registration.

Section 1052 of the Lanham Act is the relevant provision enabling determination of *what* can be trademarked. The provision is negatively worded: it lays down what cannot qualify for a trademark. The only positive requirement is that apart from being non-functional, the mark should be distinctive, or have acquired distinctiveness, enabling consumers to distinguish the goods of the holder from that of others.²⁵

Trademark itself is defined in 15 U.S.C. § 1127.²⁶ It is an inclusive definition, and includes ‘symbols’ and ‘devices’ as well. In 1988, Congress deliberately retained these two words so as to not preclude registration of sounds, scents and shapes as trademarks.²⁷ Therefore, registration of sounds and scents is not precluded by the statute.²⁸ The registration of non-conventional marks is further helped by the decision of the U.S. Supreme Court in *Qualitex Co v. Jacobson Products Co.*²⁹, wherein it held that a trademark can be “almost anything at all that is capable of carrying meaning.”³⁰

23. See David Vaver, *Recent Trends in European Trademark Law: Of Shapes, Senses and Sensation*, 95 THE TRADEMARK REPORTER, 895, 900 (2005); Jerome Gilson et al., *Cinnamon Buns, Marching Ducks and Cherry-Scented Racecar Exhaust: Protecting Nontraditional Trademarks*, 95 THE TRADEMARK REPORTER 773, 777 (2005).

24. 15 U.S.C. § 1051 – 1127.

25. See U.S. Lanham Act, 15 U.S.C. § 1052.

26. 15 U.S.C. § 1127: The term “trademark” includes any word, name, symbol, or device, or any combination thereof— (1) used by a person, or (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter, to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.

27. S Rep 515, 100th Cong 2nd Session 44 (1988).

28. See Lyndra Zadra-Symes, *Sounds, Smells, Shapes and Colours: Protection of Nontraditional Trademarks in the U.S.*, available at http://www.kmob.com/pdf/Sounds_Smells_Shapes_and_Colors.pdf (last visited on 29 August 2010).

29. *Qualitex Co v. Jacobson Products Co.*, 514 US 159 (1995).

30. See Brinks Hofer Gilson & Liono, *The Sound of Unconventional Marks in the United States*, WORLD TRADEMARK REV. 94 (July / August 2007).

A. Scent Trademarks

The first scent to receive trademark protection was the scent described as a “high impact, fresh, floral fragrance reminiscent of Plumeria blossoms.”³¹ The normal restrictions for determining what can be trademarked were laid down. The scent had to be distinctive of the product and it could not be utilitarian or functional. Therefore the fragrance of a perfume could not be registered. Moreover, in terms of graphical representation, the court stated that while drawings were not required, description of the scent was required.³²

B. Sound Trademarks

Given the liberal approach in U.S.A. towards registration of trademarks, many sounds have received trademark protection in the U.S.A.

In *Oliveira v. Frito Lay*³³, the Court held that musical works could receive trademark protection. Further, it noted that musical works could not be deprived of trademark protection merely because it was already protected by copyright. In the instant case, the Court dismissed the plaintiff’s claim only on the ground that the song did not possess the feature of distinctiveness.³⁴

In *Kawasaki Motors Corp USA v. Harley-Davidson Michigan Inc*³⁵, the plaintiff argued that the sound of the motor bike could not be registered on the ground of the doctrine of functionality. The sound sought to be trademarked was a sound common to all motorcycles of the aforementioned type, irrespective of which company it was. Unfortunately, Harley-Davidson abandoned the application before a decision could be arrived at.

31. In re Clarke, 17 USPQ2d 1238 (TTAB 1990). The goods for which this scent was required was sewing thread and yarn required for embroidery.

32. Perhaps there has been only one other scent that has received trademark protection in the USA. This is that of office supplies such files and folders manufactured by Smead Manufacturing Company. The scent was described as that consisting of a Vanilla scent or fragrance. The registration number is No. 3143735. See Jacey McGrath, *The New Breed of Trade Marks: Sounds, Smells and Tastes*, 32 VICTORIA UNI. WELLINGTON L. REV. 277, 278 (2001).

33. *Oliveira v. Frito-Lay Inc* (251 F3d 56 (2d Cir 2001)). In this case a singer claimed that a song sung by her had become her signature performance and thus her trademark, and thus Frito Lay had infringed her trademark by using it in an advertisement.

34. The decision of the Trademark Trial and Appeal Board (“TTAB”) in *In re General Electric Broadcasting Co Inc* is also relevant in the context of distinctiveness. Here, the applicant sought to register the sound of a bell tolling for its radio services. It was held that held that a sound could have acquired distinctiveness, having, from the consumer’s perspective, acquired association with the particular good or service in time. In the instant case however it was held the sound had not acquired distinctiveness. See *In re General Electric Broadcasting Co Inc*, 199 USPQ 560 (TTAB 1978).

35. *Kawasaki Motors Corp USA v. Harley-Davidson Michigan Inc*, 1997 TTAB LEXIS 11 (TTAB 1997). In this case, the plaintiff had opposed Harley-Davidson’s registration of the exhaust sound their motorcycles, produced by V-Twin, common crankpin motorcycle engines when the goods are in use. Aficionados of the motorbike refer to the sound as ‘potayto-potahto’.

Therefore it can be seen that the American Trademark Board and Courts have not shied away from granting sounds trademark protection as long as they fulfil requirements sought for conventional marks. Significantly, US courts, unlike the EU, have accepted representations through sonograms or sound recordings.³⁶ When MGM sought trademark protection for the lion roar, the sound was represented through a sonogram.³⁷

III. NON-CONVENTIONAL TRADEMARKS: INDIA

Unlike the case in US and EU, very few unconventional marks have received registration in India. Nonetheless, unlike the Trade and Merchandise Marks Act of 1958, the Trade Marks Act of 1999 (the Act) and the Trade Marks Rules of 2002 do refer to non-conventional trademarks.³⁸ Another interesting document which needs to be referred to is the Draft Manual for Trademark Practice & Procedure (Draft Manual).³⁹ This part deals with the relevant provisions of the Act in the context of non-conventional marks, followed by an analysis of the elaboration given on the relevant provision in the Draft Manual.⁴⁰

A. Law on Non-Conventional Trademarks

A reading of Sections 2(1)(zb)⁴¹ and 2(1)(m)⁴² of the Act shows that the definition of “trade mark” has been widened to include shapes, packaging and

36. David Vaver, *Unconventional and well-known trademarks*, *supra* note 17.

37. Nick Pisarsky, *Potayto-Potabto-Let's Call the Whole Thing Off: Trademark Protection of Product Sounds*, 40(3) CONNECTICUT L. REV. 797, 812 (2008).

38. See Taj Kunwar Paul et al., *Reincarnation of Trade Mark Law in India*, 86 J. PATENT AND TRADE MARK OFFICE SOCIETY 237, 240 (2004).

39. The Draft Manual serves the purpose of a guide to the trade mark examiners, traders and the general public, in order to achieve uniformity and precision in practice. Nonetheless, as stated, if anything in the Manual is at variance with the Act and the Rules, the latter will prevail. See Preface and Section 5, *The Draft Manual (Revised) for Trademark Practice & Procedure*, available at http://ipindia.nic.in/tmr_new/TMR_Manual/DraftManual_TMR_23January2009.pdf (last visited on 29 August 2010).

40. See Dev Gangjee, *Non-Conventional Trade Marks in India*, 22(1) NAT'L L. SCHOOL INDIA REV. 67 (2010) for another view on The Draft Manual's approach to non-conventional trademarks.

41. “Trade mark” is defined as a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others and may include shape of goods, their packaging and combination of colours, and in relation to Chapter XII (other than section 107), a registered trade mark or mark used in relation to goods or services for the purpose of indicating or so as to indicate a connection in the course of trade between the goods or services, as the case may be, and some person having the right as proprietor to use the mark, and in relation to other provisions of this Act, a mark used or proposed to be used in relation to goods or services for the purpose of indicating or so to indicate to a connection in the course of trade between the goods or services, as the case may be, and some person having the right, either as proprietor or by way of permitted user, to use the mark whether with or without any indication of the identity of that person, and includes a certification trade mark or collective mark.

42. “Mark” includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination thereof.

combination of colours. As specified in the Manual,⁴³ this is an inclusive definition including *any* mark as long as the mark is capable of being represented graphically and capable of distinguishing the goods or services of one person from that of the others. Nonetheless, it has been stated that colours, shapes, sounds and smells will require “special consideration” during registration.

With respect to the graphical representation of sound marks, India has simply imported the *Shield Mark* doctrine.⁴⁴ The Trade Mark Registry has not sought to probe into whether representation through musical notes is intelligible to everyone, and whether it is all-encompassing. Nonetheless, with regard to distinctiveness, the Manual specifically lists sounds which are not distinctive and thus will not be registered.⁴⁵

In the context of scent marks, the Registry has again directly applied the *Sieckmann* test, stating that though smells are registrable, the fulfilment of the graphical representation criteria becomes difficult post the *Sieckmann* holding.⁴⁶ It is disappointing to note that the Registry has not suggested any alternative method of graphical representation in spite of stating that smells are registrable.

B. Instances of Registration

Three non-conventional trademarks have received registration in India so far. Yahoo!’s yodel is the first non-conventional mark to be registered. The yodel was represented through musical notes.⁴⁷ The shape of the Zippo lighter was also granted registration, which was later confirmed in a trademark infringement suit in the Delhi High Court, on the ground that it was distinctive.⁴⁸ The latest non-conventional trademark to be registered is a sound mark, held by a German company Allianz Aktiengesellschaft.⁴⁹

43. See Section 3, Draft Manual.

44. See Section. 5.2.2.1, Draft Manual.

45. These include, *inter alia*, nursery rhymes and simple pieces of music of only 1 or 2 notes. See Section 5.2.2.2, Draft Manual.

46. See Section 5.2.3, Draft Manual.

47. Peter Ollier, *Yahoo Yodels into India’s TM Registry*, 183 MANAGING INTELLECTUAL PROPERTY 14 (2008); Shamnad Basheer, *India’s first “Sound Mark” Registered*, SPICYIP, 19 August, 2008, available at <http://spicyipindia.blogspot.com/2008/08/breaking-news-indias-first-sound-mark.html> (last visited on 15 August 2010).

48. *Zippo v. Anil Manchandani* (unreported, CS (OS). 1355/2006). See also Shwetaree Majumdar, “Zippo shape mark protected by Indian Court”, *SpicyIP* blog, August 18th, 2006, available at <http://spicyipindia.blogspot.com/2006/08/zippo-shape-mark-protected-by-indian.html> (Last visited on 15 August 2010).

49. Santosh Singh, *Yet Another Sound Mark Granted*, SPICYIP, 30 July 2009, available at <http://spicyipindia.blogspot.com/2009/07/yet-another-sound-mark-granted.html> (Last visited on 15 August 2010).

IV. A DEFENCE OF NON-CONVENTIONAL TRADEMARKS

In this part, I argue that the inclusion of non-conventional trademarks in the trademark regime is a positive phenomenon. Subsequently, the nuances of registration of these marks are discussed.

A. The “Desirability” of Non-Conventional Trademarks

One of the common arguments against non-conventional trademarks is that they are leading to an undesirable restriction in free intellectual property resources.⁵⁰ A manufacturer would have to think twice before he uses the colour orange for the label covers of his jam bottles, an advertising company would tread with caution when coming up with jingles for an advertising campaign.

It is significant to reckon that such an argument can actually be made when *any* mark, visual or non-visual, is sought to be trademarked. Curiously, the only rationale that is stated for this distinction is that non-visual marks are not capable of graphical representation. Such a ground, even assuming is valid, cannot be a reason for suggesting that non-conventional marks lead to an *undesirable* restriction. It is a ground for arguing why non-conventional marks are *incapable* of registration. The argument here however is of first principle: assuming non-conventional marks are capable of registration, is it desirable that they be registered?

Assuming that a particular non-conventional mark is distinctive and is not functional, it is argued that a non-conventional mark like sound or scent should be given trade mark protection. Non-conventional trademarks become significantly important for a section of society like the visually impaired and the illiterate.⁵¹ Non-conventional marks encourage undertakings to develop new and innovative ways of branding. Companies reach out to newer markets, increasing benefits for themselves and a new segment of purchasers. Marks such as shape, smell and sound, embodying multi-sensory perception, enable a wider cross-section of consumers to make more beneficial purchasing decisions. Their identification of what they prefer incentivizes quality production for the holders of these marks.

Another argument against non-conventional trademarks is that they are making inaccessible free intellectual resources, for instance classical music over which no one has a copyright. However, such an argument is untenable. It must be noted that patent, copyright and trademark law are three different branches of intellectual

50. See for instance, Paul Leo Carl Torremans, *Trademark Law: Is Europe Moving Towards an Unduly Wide Approach for Anyone to Follow?* 10 J. INTEL. PROP. RIGHTS 127 (March, 2005); David Vaver, *supra* note 17.

51. See David Vaver, *supra* note 17, at 18.

property law, performing different functions.⁵² As McCarthy has remarked, “one cannot come to the bottom-line conclusion that any item is ‘in the public domain’ until one has exhausted *all* of the possible areas of exclusive intellectual property rights.”⁵³ Consequently, only because no author has a copyright over a certain work does not mean that it cannot be trademarked. Hypothetically, Stone Cold Steve Austin, the famous wrestler, can get the sound of glass shattering, which is played every time he makes an entry, trademarked, even if another musician has a copyright over it.

Another contention against non-conventional trademarks that protection of such marks lead to a slippery slope by exposing a vista of intellectual property to potential registration, is not a valid contention for arguing in favour of non-registration. Provided the mark is not functional and is distinctive, there is no reason to prevent *anything* from receiving protection. Visual perceptibility should not be and is not a *sine qua non* for building brand association in the minds of consumers. As observed above, not only do non-conventional trademarks fulfill the traditional purpose attached to trademark protection, but they also provide additional benefits. Thus, they should receive trademark protection.

B. Non-Conventional Trademarks and Nuances of Registration

After concluding that it is untenable to *not* include smells and sounds as marks, the next question to be asked is: are these marks *capable* of registration? The two requirements which are relevant for this discussion are: distinctiveness and graphical representation.

a. Are Non-Conventional Trademarks Distinctive?

It is arguable that smells and sounds are often a feature of the product, possibly even essential (and therefore functional), and hence are not distinctive.⁵⁴ For instance, a consumer may instantly recognise the presence of paint through its smell. However the smell cannot be trademarked by, for instance, Asian Paints because it is a smell

52. II MELVILLE B. NIMMER ET AL., NIMMER ON COPYRIGHT §2.08[G] (2000). Patents seek to protect original and useful work / inventions. Copyright seeks to protect original literary, musical, artistic and other creative work. Trademarks protect the use of marks as commercial brands. With respect to trademarks, the owner of a trademark may not have been the inventor of the mark. Yet he / she has the trademark for the innovative use of that mark as an indicator of his/her goods.

53. II J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION 6-9 (4th ed., 2000). It must also be noted that an existing copyright over something will not prevent it from getting trademarked. As has been noted by an American court in the context of the character of E.T, in the eponymous film: “A character is deemed an artistic creation deserving copyright protection and may also serve to identify the creator, thus meriting protection under theories of trade mark”. See *Universal City Studios, Inc. v J.A.R. Sales, Inc.*, 216 U.S.P.Q. 679 (C.D. Cal. 1982).

54. See James C. Chao, *Recent Trends in Asian Trademark Law*, 95 THE TRADEMARK REPORTER 883, 894 (2005).

common to all paints and is the consequence of its composition. However, it can be simultaneously argued that consumers associate a certain smell with a product, the best example being the rose fragrance and the Sumitomo tyres, and hence trademark protection should be granted to such marks. Thus, this dilemma can only be solved on a case to case basis and it is *not* possible to make a general proposition that non-conventional trademarks should not receive trademark protection on account of lack of distinctiveness.

b. Are Non-Conventional Trademarks Capable of Being Graphically Represented?

This question begets a careful analysis of existing judgments on methods of graphical representation of non-conventional marks.

1. Sound and the Shield Mark criterion

In the *Shield Mark* case, the ECJ held that musical notes comprising a stave and cleft is an intelligible, precise and stable method of representing sound and hence is a satisfactory form of graphical representation.

However, this criterion is not completely satisfactory. It raises the issue whether graphical representation consisting of a stave and cleft comprise intelligible representation. Such a representation caters only to a music-literate audience and thus, is *not* intelligible representation.⁵⁵

Significantly, the Court seems to have pre-empted this. The Court did note that even if not “immediately intelligible”, the representation was still “easily intelligible”. While this is true, there can be simpler, equally precise, and more intelligible representation. It is noteworthy to observe that before the *Shield Mark* case, Metro-Goldwyn Mayer (MGM) had applied for a trademark for its lion roar.⁵⁶ The graphical representation of the roar was in the form of a sonogram. The Board of Appeal ruled that sonograms in principle constituted valid graphical representation; however, in that particular case, since time or frequency could not be made out from the sonogram, there was no precision. The *Shield Mark* case, in not considering sonograms and stressing only on musical notes, is at divergence with the decision in MGM.

Moreover, representation comprising musical notes can only be extended to musical works. The *Shield Mark* decision thus, in not envisioning non-musical sounds, had, perhaps inadvertently, restricted the number of potential sound trademarks.⁵⁷

55. David Vaver, *supra* note 17, at 8.

56. *Metro-Goldwyn Mayer Lion Corporation's Appeal relating to Community Trade Mark Application No. 143 891, Case R 781 / 1999-4*, Decision of OHIM Fourth Board of Appeal of 25 August 2003, as corrected on 29 September 2003. See David Vaver, *supra* note 23, at 902.

57. David Vaver, *supra* note 17, at 8.

It is arguable that the decision did not contemplate non-musical sounds because the dispute before it pertained to a musical work; nonetheless, the authoritative tenor of the judgment seems to imply that the recommendations made are exhaustive ones, applicable to all sounds.

It is however heartening to note that in 2005, the OHIM, in the context of non-musical notes, has taken the American way and has accepted representation by means of an oscillogram or sonogram accompanied by the sound file.⁵⁸ To make the representation more clear, it is suggested that a written description of the sound too should be given.⁵⁹ However this description should not be a crucial criterion in that even if it is not wholly precise, if the sonogram is so, the mark should be registered.

Unfortunately, India has not upgraded its law and continues to endorse the *Shield Mark* criterion.⁶⁰

2. Scent and the *Sieckmann* Criterion

The ironical aspect of the *Sieckmann* case is that there is *no* Sieckmann criterion. The ECJ in ruling that smells are registrable, but in rejecting the exhaustive list of methods of representation suggested and *not* suggesting any new method, has cast great uncertainty over the registerability of smells.⁶¹ It is submitted that if musical notes, in spite of not being “immediately intelligible”, could be deemed to be valid representation by the ECJ⁶² then the same standard should be applied to chemical formulae and they too should be considered to be valid in the context of scents. Formulae are clear and precise in their representation. Admittedly, formulae only represent the origin of the smell, that is, the substances. Possibly, *along* with the chemical formulae, the method of preparing the substance with temperature and other conditions being specified,⁶³ and a written description of the smell, is a suitable alternative.⁶⁴ Hence, even if it is argued that chemical formulae are not commonly intelligible, the additional description will make it so.

58. See Section 7.6.1, *The Manual Concerning Proceedings before the Office for Harmonization in the Internal Market (Trade Marks and Designs)*, Part B, Examination, available at http://oami.europa.eu/ows/rw/resource/documents/CTM/legalReferences/partb_examination.pdf (last visited on 1 September 2010).

59. This has also been suggested by David Vaver. See David Vaver, *supra* note 17, at 9.

60. See Section 5.2.2.1, Draft Manual.

61. Alex Butler, *The Smell of Ripe Strawberries: Representing Non-Visual Trademarks*, INTELLECTUAL ASSET MANAGEMENT 7 (April / May, 2008).

62. See *Shield Mark*, *supra* note 18.

63. As unlike musical notes which one can play on a piano to obtain the tune, the chemical formula may not enable one to get the substance which has the smell; the same elements can react differently under different atmospheric conditions and in different quantities to give different substances.

64. In this regard, the method used in chemistry to describe how students can get a particular flame colour is a suitable analogy. The exact method of preparing the substance which gives the flame, with quantities and atmospheric conditions being specified, is stated in chemistry books when the flame colour is being discussed.

CONCLUSION

In this article, I have first attempted to charter the development of acceptance of non-conventional trademarks in trademark regimes across America, the European Union and India. It is apparent that while America's approach towards these trademarks is liberal, the EU's approach has been mixed. India unfortunately has simply imported EU guidelines with regard to these marks, without any modifications.

Secondly, I have argued in defence of these trademarks. We continually use *all* our five senses when we recognise someone by the sound of their voice, or identify what is being cooked by the smell of the food, or favour spaghetti or any other dish because of its taste. Non-conventional trademarks recognise this use and are a welcome development. Although not *visually*, these marks are perceptible as well. In addition to fulfilling the ordinary function of trademarks, they bring in an additional benefit of catering to a new segment of consumers and consequently encourage innovation among advertisers. Fundamentally, there is no difference between "non-conventional" and "conventional" trademarks and so there is no rationale for arguing that only the former represents an undesirable restriction of free intellectual property resources.

Regarding registration requirements, while it is imperative that these marks, apart from being distinctive and non-functional, be capable of being graphically represented since that ensures clarity for all interested parties, it is stressed that neither smell nor sound can be labelled to be incapable of graphical representation. In the context of sounds, Europe has finally followed the American way and accepted sonograms and sound recordings as valid graphical representations. Furthermore, a written description of the sound should also be mandated as a requirement. With regard to scents, the following method of representation seems apposite: the chemical formulae of the substance which forms the origin of the smell, the method of making that substance with all specific conditions outlined, and a written description. It is disappointing to note, however, that India has not validated any of these methods yet. It is hoped that in the time to come, it will.