The Registrability of Unconventional Trademarks in India and Sri Lanka: A Comparative Analysis

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India and Sri Lanka, having embraced the new global economic wave have liberated their international trade policies incubating a supportive atmosphere within for foreign traders to setup business in the local markets. This new trend though beneficial to the economies of both countries, has posed many new legal issues, particularly, in intellectual property law. One important problem relates to the area of unconventional trademarks, which is of great importance to trade. This paper examines current legal provisions relating to trademarks in India and Sri Lanka and determines registrability of unconventional marks, with emphasis on colour, scent and sounds, within the existing legal framework. Legal reforms are also suggested wherever appropriate. A comparative approach has been adopted, as Sri Lanka and India are historically, culturally and geographically closely connected to each other. Further, intellectual property laws of both the countries are TRIPS compliant and thus can be conveniently considered together.

Keywords: Unconventional trademarks, TRIPS compliant, sound marks, scent marks, graphical representation

Trademark has been defined in the Sri Lankan Intellectual Property Act of 20031 as ‘Any visible sign, serving to distinguish the goods of one enterprise from those of another enterprise2’, the Trademarks Act of India3 defines it as ‘…a mark capable of being represented graphically and 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 colours4.

Both definitions encompass requirement for trademarks to be distinctive, but there is a striking difference in the wording of the two definitions in respect of the requirement that the marks must be visibly perceptible. The Sri Lankan IP Act is worded as ‘Any visible sign…’, whereas the Indian TM Act uses the phrase, ‘…a mark capable of being represented graphically…’. Regardless of this disparity, there is no doubt that the principles behind both the regimes are fundamentally same. However, is that equally true, for non-traditional trademarks as well?

It has been observed that:

‘Unconventional marks are today’s more _outré_ elements: smell, sound, colour, shape and even taste and gesture. Until recently, such things were thought to be unregistrable and largely unprotected at common law. This position is changing internationally. Smell, sound, colour and even shape marks now appear in many trademark registries and trademark legislation and treaties5.’

Thus, while there is a global trend to consider unconventional trademarks for registration, the primary question addressed in this paper is whether Indian and Sri Lankan law as it stands today, provides for the registration of unconventional marks. However, before considering the laws of India and Sri Lanka in detail, it is useful to examine how other jurisdictions have dealt with this issue.

Venturing into Foreign Terrain

While there may be minute differences between trademark laws of different countries, but the essence of the law is most likely the same. The reasons for the similarity are twofold. The first is attributed to the essential function of a trademark. It is a sign whose purpose is to distinguish the goods or services of one undertaking from those of another. This is to avoid consumer confusion and deception to the source of the product. Thus, the element of distinctiveness has been incorporated into all trademark laws across the globe. The second reason relates to the objective of registration. Registration is necessary to enable
enterprises using various trademarks to know the exact ambit or extent of a registered trademark, so as to prevent unnecessary infringement litigation. Thus, unless a mark can be clearly represented, it ought not to be registered; otherwise the very purpose of registration would be defeated. Therefore, a common feature in most laws is the requirement of clear representation or ‘graphical representation’ of a trademark. Thus, the aforesaid features are quintessential in any enactment relating to trademark.

When the framers of the UK Trademark Act of 1994 defined trademark as any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings, which is very similar to Article 2 of the First Council Directive of the European Community and when the US legislature defined trademark as “…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”, these features have been sculpted into these statutes.

The TRIPS Agreement which inspired the framers of most trademark legislation around the world, defined ‘trademark’ as ‘…any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark…Members may require, as a condition of registration, that signs be visually perceptible’, as per Article 15 of TRIPS Agreement, which yet again incorporates the two features noted above.

Thus, for any trademark to be registered it must be established that it is (i) a sign, (ii) capable of distinguishing a product from that of the others and (iii) can be represented clearly for the purpose of registration. Keeping these basic features in mind, it is now apposite to delve into the realm of unconventional trademarks per se.

Should Colours be registered as Trademark?

It is submitted that a sign is, any message capable of perception by the senses can be a trademark, provided it is potentially capable of distinguishing. Colour is a sign capable of being perceived by visual senses. Article 15 of the TRIPS Agreement enunciates that ‘…signs, in particular, words including personal names, letters, numerals, figurative elements and combinations of colours as well as any combination of such signs, shall be eligible for registration as trademarks’. Therefore, it is generally accepted that combination of colours may be regarded as trademarks, provided they fulfill the remaining requirements stipulated above.

The question is, can colours constitute a particular sign? If a sign is regarded as a message that radiates a distinct meaning, can it be said that a colour or a combination of colours can be the source of a message? Humans interact both through verbal and non-verbal means. As stated by Hawkes ‘It is…clear that human beings communicate by non-verbal means and in ways which must consequently be said to be either non-linguistic or which must have the effect of ‘stretching’ our concept of language until it includes non-verbal areas’. For instance, as demonstrated by Re Owens-Corning, the colour pink may symbolise roof insulation, by virtue of both its physical resemblance to, and factual connection with pink roof insulation. However, it can be argued that a colour by itself cannot constitute a sign. In Libertel, the European Court of Justice (ECJ) interpreting Article 2 of the Directive, observed as follows:

‘it must be pointed out that a colour per se cannot be presumed to constitute a sign. Normally a colour is a simple property of things. Yet it may constitute a sign. That depends on the context in which the colour is used. Nonetheless, a colour per se is capable, in relation to a product or service, of constituting a sign.’

Therefore, it can be comfortably said that as to whether a colour is a sign or not would depend on the circumstance of each case and is a matter to be decided by the tribunal or court adjudicating the matter.

Provided that colour is accepted as a sign, it has to fulfill the elements of clear or graphical representation and distinctiveness. As for graphics representation, colour inherently can be displayed graphically, thus there cannot be a problem in representing a colour in visual form. For a mark to be graphically represented, it ‘must be clear, precise, self-contained, easily accessible, intelligible, durable and objective’. In Libertel, it has been observed that generally a sample of the colour or colour combination coupled with a verbal description thereof would suffice to fulfill the graphic representation test. However,
‘…where a sample of a colour, together with a description in words, does not satisfy the conditions laid down in Article 2 of the Directive in order for it to constitute a graphic representation because, inter alia, it lacks precision or durability, that deficiency may, depending on the facts, be remedied by adding a colour designation from an internationally recognized identification code’, such as a pantone number. Durability seems an important aspect of registration, for with time, if the colour sample fades to become inconsistent with the written description that was supplied with it, the combination would not fulfill the graphics representation criterion. In fact, it has been observed in Sieckmann that ‘In particular, a sample of a colour may deteriorate with time. There may be certain media on which it is possible to reproduce a colour in permanent form. However, with other media, including paper, the exact shade of the colour cannot be protected from the effects of the passage of time. In those cases, the filing of a sample of a colour does not possess the durability required by Article 2 of the Directive’. Therefore, perhaps in a computerized system of registration, the question of durability may not arise, as all samples can be protected in an electronic database which would not be subject to natural decay.

Assuming that colours can be represented graphically, the question arises whether colours may be regarded as distinctive? In other words, can colours alone be used to distinguish a product from others? This has to be answered from the point of view of an average consumer. Thus, the reasonability test will have to be applied.

The general notion is that combination of colours work better as trademarks than a single colour as consumers readily appreciate the distinctiveness of combinations. As for single colours, a very high burden of proof is required to be discharged in order to establish distinctiveness. For instance, the Federal Court of Australia in Woolworths Ltd v BP plc and Cadbury Schweppes Pty Ltd v Darrell Lea Chocolate Shops Pty Ltd was reluctant to acknowledge the distinctiveness of a single colour, despite there being many years of use of a particular colour as the predominant part of the get-up of the enterprise concerned. The Cadbury case best illustrates this fact. An essential part of Cadbury’s argument was that the shade of purple it uses on the chocolate wrappers, considered in isolation, distinguishes Cadbury chocolates from its competitors. In other words, the colour purple in the context of chocolate has a secondary meaning as an identifier of Cadbury chocolate products. Reference was made to a trademark case BP plc v Woolworths Ltd where Finkelstein J held that a shade of green could be registered as a trademark for BP because customers identified BP service stations by green colour alone. However, the fact that the FCA overruled the lower court’s decision in the BP case which raised some doubts as to the correctness of this argument and perhaps was taken into account by the FCA in holding that Cadbury cannot have exclusive rights to a single colour, namely, a dark shade of purple. The FCA observed as follows:

‘96. There is wide awareness amongst Australian consumers of the use by Cadbury of a dark purple colour (i) in connection with the marketing, packaging and presentation of certain chocolate products, particularly, Cadbury Dairy Milk and other block milk chocolate products, and (ii) as a corporate colour.

97. Cadbury does not have an exclusive reputation in the use of this dark purple colour in connection with chocolate. Other traders have, with Cadbury's knowledge, for many years used a similar shade of purple. Cadbury has not consistently enforced its alleged exclusive reputation. In relation to its chief competitor, Nestlé, Cadbury has, for its own commercial reasons, permitted a use of purple in relation to popular chocolate products… … …

100. Cadbury’s use of purple in marketing advertising and promotion is, and is seen by consumers to be, inextricably bound up with the well known name Cadbury in its distinctive script. Cadbury never uses the colour purple in isolation as an indicium of trade.’

This clearly shows the height of the evidentiary hurdle to be overcome in cases concerning the registrability of a single colour as a trademark. However, regardless of what the law provides, should single colours be registered as trademark? It has been submitted that restricting the use of a single colour to a particular trader is against public interest. However, where a single colour fulfills the criteria for registration, in terms of the law it ought to be registered. Perhaps, the argument based on public interest must be linked to the limited nature of the
colour spectrum. Thus, granting of monopoly to use a single colour would restrict trade. It has in fact been observed that:

‘Intellectual property rights (IPR) have often been one basis for powerful anti-competitive collaborations. Since their very purpose is to confer rights to exclude competitors, it is inevitable that they should have been combined into wider accretions of market power...’

However, it must be also noted that mechanisms have been provided to eliminate the unreasonable use of IPR. It has been observed thus:

‘...such privilege is limited only to the reasonable use of IPRs. Competition law seeks to strike a fine balance between IPRs and the efficacy of the economy and thus in cases involving Microsoft and Magill, it was observed that only reasonable exercise of IPRs is exempted from the sanction of Competition law.’

Nevertheless, the argument that colours are limited may be refuted on the following ground. Computer graphics and multimedia, has enabled modern day computers to generating approximately, 1.6 million distinct colours (in a 24 bit computer system). A 32-bit computer has higher capabilities. Computers work on binary numbers (ones and zeros). Thus, each colour is represented by a special binary combination. Perhaps, just as pantone numbers, this too may be a mode by which colours could be registered. The number of colours that can be generated is dependent on the number of binary bits that can be used to represent the colour. Thus, with increasing computer hardware memory, the number of bits that can be used for such a function is considerably large, thus opening gates, to an extremely large number of distinct colours. Therefore, such an argument based on the limitation of colours may not be supported in the present day context.

However, the very fact that computers can be used to generate a large number of distinct colours can be used as the foundation to argue that single colours should not be monopolised. This is an argument with a biological tinge. Though human eye is a very sensitive organ, ability to distinguish between two different shades of colour is limited. As mentioned before, colours are based on binary digits. Hence, a variation of one digit may technically be regarded as a different colour or shade, but may not be evident to the human eye. Therefore, we are placed with a situation where trader A registers a single colour with a specific bit pattern and trader B registers another colour which is a single bit variant of trader A’s colour, which technically is a different colour, but appears to be same to the human eye. Therefore, this would ultimately lead to the lack of distinctiveness between two colours which are so closely connected in terms of binary bit pattern. Therefore, for these reasons it may be submitted that single colours should not be registered as trademarks and it is best to allow traders to use colours as they please and achieve distinctiveness in their marks through the use of combinations rather than single colours.

**Sounds and Scents: The Visibility Issues**

Sounds and scents are best considered together due to their common characteristic of being invisible. In most jurisdictions, sounds and scents have either been expressly recognized as trademarks or at least they have not been excluded from the scope of protection. However, if a sound or scent mark is to be recognized as registrable trademark, it must be established that it is a sign, capable of being graphically represented and can distinguish the product from those of other producers.

**Sound Marks**

Sound can in some instances become a sign, distinct to a particular trader. For example, the distinct start-up tune of the Nokia mobile phone, of Microsoft Windows XP or Samsung phone could be recognized by consumers at first instance and thus are undoubtedly distinctive signs. Therefore, the only problem, if at all, that arises in this context is the graphic representability of these marks.

The ECJ in *Shield Mark BV v Joost Kist* while confirming that the standards for graphics representation as set out in *Sieckmann* apply to sound marks as well, observed as follows:

‘...those requirements are not satisfied when the sign is represented graphically by means of a description using the written language, such as, an indication that the sign consists of the notes going to make up a musical work, the indication that it is the cry of an animal, or by means of a simple onomatopoeia, without more, or by means of a sequence of musical notes, without more. On the other hand, those requirements are satisfied where the sign is represented by a stave divided into
measures and showing, in particular, a clef, musical notes and rests whose form indicates the relative value and, where necessary, accidentals.’

It must be noted that ‘As a practical matter, however, not everyone can read written music. Moreover, written musical notes while indicating pitch, normally will not indicate tone, and different tones can be used, namely, musical notes give a ‘description’ of the music but not the music itself. An apparent solution would be to deposit a digital recording of the sound with the registrar instead of graphical representation’.22 Though the proposition has been rejected for varying reasons, which include, disability of the Trademark Registries to publish sounds, as currently the only mode of publication is by gazette, and as a consequence people have to visit the registry to hear it, and further, it would be difficult for the registry to store so many sound samples.22

However, it must be noted that both India and Sri Lanka have embraced the information era and possess sufficient infrastructure, to implement a paperless system of keeping records. With the development of modern file formats such as mp3, and wav, to store music files with less space, and high compression power which enable files to be reduced in size tremendously through compression, using for instance, the zip file format, sharing, publishing and storing sound files in the Internet has become extremely easy. Therefore, if such a solution is to be adopted, it can be done so, only with a proper online infrastructure and after legal reforms where such forms of registration would be permitted by statute. However, there may be other forms of complications if sound recordings were to be registered as trademarks. How would a party to a dispute produce such form of digital recording as evidence in a court of law? If a register was maintained a certified true copy would be accepted as documentary evidence in India and Sri Lanka, as well as in most other jurisdictions. However, admissibility of a digital sound recording as evidence would depend on the evidentiary provisions of the country. For instance in Sri Lanka, the Evidence (Special Provisions) Act No 14 of 1995, enables computer evidence to be admitted in a court of law, provided the conditions in Section 5 of the Act are met, while in India, the Information Technology Act No 21 of 2000 redefines the term evidence to include electronic records, which is defined in Section 2 as follows:

‘Electronic record…means data, record or data generated, image or sound stored, received or sent in an electronic form or micro film or computer generated micro fiche…’

Further, it must be noted, that in India, the concept of an Electronic Gazette has been recognized and publishing information electronically over the Internet would not be a problem either. Thus, the legal framework for a paperless system is already in existence in India as well as Sri Lanka, of course in the latter to a lesser degree.

Therefore, the move to electronically register sound as well as visual/image marks including colours, would be appropriate to overcome the present practical difficulties. In fact, the use of computer-based registries would also facilitate the electronic filing of shape marks as 3-Dimensional modeling has become the turning point in the electronic era.

**Scent Marks**

Scent is totally a different ball game. Scent cannot be recorded and hence cannot be registered digitally, as suggested for sound marks. On the other hand, graphically representing a smell is not as straightforward as for sound marks. One way to represent a scent is to state the scent of apple blossoms, or the smell of rotten eggs and the like. Such forms of representations are very subjective and do not satisfy the Sieckmann criteria and many interpretations may be given which could cause severe confusion. Perhaps, a better way is to use chemical formulae of the scents. In fact, the ECJ in *Sieckmann v Deutsches Patent- und Markenamt*23 was able to review the suitability of such forms of representation to fulfill the graphic representation criteria. The ECJ came to the following findings:

‘69. As regards a chemical formula, as the United Kingdom Government has rightly noted, few people would recognize in such a formula the odour in question. Such a formula is not sufficiently intelligible. In addition, as that Government and the Commission stated, a chemical formula does not represent the odour of a substance, but the substance as such, nor is it sufficiently clear and precise. It is therefore not a representation for the purposes of Article 2 of the Directive.

70. In respect of the description of an odour, although it is graphic, it is not sufficiently clear, precise and objective.
71. As to the deposit of an odour sample, it does not constitute a graphic representation for the purpose of Article 2 of the Directive. Moreover, an odour sample is not sufficiently stable or durable.

72. If, in respect of an olfactory sign, a chemical formula, a description in words or the deposit of an odour sample are not capable of satisfying, in themselves, the requirements of graphic representability, nor is a combination of those elements able to satisfy such requirements, in particular, those relating to clarity and precision.

73. In the light of the foregoing considerations, the answer to the second question must be that, in respect of an olfactory sign, the requirements of graphic representability are not satisfied by a chemical formula, by a description in written words, by the deposit of an odour sample or by a combination of those elements.

It must be noted however, that finding number 69 (above) in Sieckmann, is in direct conflict with the findings of the same court in the subsequent case of Shield Mark BV, where the courts permitted sound marks to be represented using clefs and staves. Not all could read musical notations and notations were not a representation of the sound itself. Therefore, if the Shield Mark BV approach is applied to odour marks as well, the use of chemical formulae may be regarded as a sufficient means of graphically representing scent. Perhaps what led court in Sieckmann to decide in the way it did was the following argument put forward by the UK Government:

‘…the mere indication of the chemical formula as the graphic representation of an odour does not make it possible to identify the odour with certainty, because of different factors which influence the manner in which it can actually be perceived, such as, concentration, quantity, temperature or the substance bearing the odour.’

Thus, it may be argued, that a chemical formulae along with other standard information that is required to precisely and accurately reproduce the exact scent that was registered would amount to a proper graphical representation of a scent mark. However, the ECJ has been consistent, in matters concerning odour marks and Eden v OHIM is illustrative of this fact. In this case too, the scent of ripe strawberries for shaving creams was rejected for want of graphic representability. As for how scent can be represented graphically, only time will decide. It is best to resort to other modes of registration nurtured by technological advances, which does not require graphic representation.

**When is a Sign Graphically Represented?**

According to the UK Registry Work Manual, a sign is graphically represented when:

(a) it is possible to determine from the graphical representation precisely what the sign is that the applicant uses without the need for supporting samples, etc;

(b) the graphical representation can stand in place of a sign used or proposed to be used by the applicant because it represents that sign and no other; and

(c) it is reasonably practicable for persons inspecting the register; or reading the trademarks journal, to understand from the graphical representation what the trademark is.

As far as colour marks are concerned, durable sample of the colour would clearly fulfill the threefold requirement setout above. However, as the ECJ suggested, in Libertel, does the use of a pantone number, fulfill paragraph (c) above? Similarly, does the use of musical notations to represent sound and chemical formulae to represent scent, satisfy the third criteria? A colour can be easily retraced using the pantone number through a comprehensive colour pallet. A computer can be used for this purpose. Similarly, computer software can be used to reproduce the sound, when a standard musical notation is given. However, this is not the case with scent. The world has so far seen no computer aided technology that can produce a scent using a computer program. This would have to be done physically in a science lab, which is highly impractical. Therefore, the graphics representation of a mark would only be satisfied, if the mark is capable of being represented graphically, and further only if those who inspect such representation can perceive what the mark is without any difficulty and practical limitation.

**The Position in Sri Lanka and India**

The Sri Lanka IP Act defines ‘trademark’ as, ‘Any visible sign, serving to distinguish the goods of one enterprise from those of another enterprise’. The use
of the phrase visible makes the Sri Lankan law unique. Though the ECJ in *Sieckmann* held interpreting Article 2 of the Directive, that signs were not limited to visual signs, but to any sign, which was capable of being represented graphically, can such an interpretation be adopted for Sri Lanka? The express use of the term visible raises doubts as to any possibility to apply a similar interpretation. Does this mean that in Sri Lanka, invisible signs are completely shut out from protection? The answer to this would depend on how the Sri Lankan courts would interpret the phrase ‘sign’.

Since, in most jurisdictions, pantone numbers for colours, musical notes for sounds and chemical formulae with other pertinent scientific data for scents, have been recognized as graphical representations of the sign, it can be said that the sign sought to be registered includes the way in which it has been represented. Thus, the phrase ‘sign’ envisions a broad interpretation. Therefore, if such an interpretation is adopted, the term visible sign would envisage, not only the sign as it is used in trade, but also the graphical representation of it which is used for registration.

To avoid confusion, it has been suggested that ‘...we drop the word visible in the definition and have only the word sign in the definition. That would facilitate easy inclusion of smells and sounds as trademarks in future. We would be proactive and futuristic by adopting such an interpretation.’

However, further change needs to be effected by the terms ‘capable of being graphically represented...’ being added, as otherwise, any sign, visual or otherwise would be registered without being described properly. Thus, the final draft definition would read as, ‘Any sign, serving to distinguish the goods of one enterprise from those of another enterprise and capable of being graphically represented’.

However, Article 15 of the TRIPS Agreement becomes useful in supporting the contrary view that the phrase, visible sign must be strictly interpreted to only include signs which are visible to the human eye. The Article provides that ‘... Members may require, as a condition of registration, that signs be visually perceptible.’ Therefore, it is at the member’s option to require visual perceptibility of the trademark as a precondition for registration and Sri Lanka by the use of the phrase ‘visible sign...’ has opted to incorporate this requirement. Therefore, it is the author’s view that the Sri Lankan legislature has intentionally left out non-visual signs from the ambit of trademarks.

As far as India is concerned, the Indian TM Act does not require a mark to be visually perceptible. It further enacts that a ‘... 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’. Though the definition of mark resembles the UK Trademark Act and the EU Directive, it seems that the phrase ‘sign’ which is used in Europe is broader as manifest from the observation of a UK court that a sign is ‘anything which conveys information’.

Nevertheless, no amendment is required to enable the registration of unconventional trademarks, whether visible or otherwise, provided it can be graphically represented. Though only combination of colours are expressly mentioned in this definition, single colours are not excluded and in fact caught up by the term ‘device’ used in the said definition. Thus, the phrase ‘device’ can be used to bring scents and sounds and many other marks that may come in to use in the future under the definition of ‘marks’.

If one were to go one step further, to include the registration of digital sounds, then, special provision has to be made to facilitate the registration of digital sounds both in India and Sri Lanka.

Copyright to the Rescue? The Erosion of the Distinction between Trademark and Copyright

Trademark is a tool that is used by traders to identify their products from products of others and to prevent consumer confusion. Therefore, it can be said that trademarks are consumer oriented. Copyright on the other hand is attributed directly to the author of original work conferring to the creator of such work economic as well as moral rights. Therefore, while trademark infringement can cause economic loss to the registered owner through consumer confusion, copyright infringement has direct economic ramifications to the author.

There can be situations where original works which are the subject matter of copyright, also display features of trademark and thus the owner of such works may claim under both copyright as well as trademark. For instance, a creative and original slogan while attracting copyright could also be used to indicate the origin of the product in the commercial
sense. Similarly, logos and artistic business symbols could come within the ambit of original artistic work. The same applies to sound marks.

In the modern world creativity plays a significant role in competitive business and therefore, inevitably making of a trademark involves an intense process of creativity and ingenuity. Hence, despite the divergent objectives and distinct development of copyright and trademark, certain overlaps and conceptual interrelations have justified the two concepts being brought under the same umbrella of intellectual property which in turn has blurred the distinction between the two.

In the light of such a link, substantial similarity, which is the basis of a copyright infringement action, could also form the basis of a trademark infringement claim, as more often than not, substantial similarity would amount to confusion as to the source of the product in the mind of an ordinary consumer. However, it cannot be said that the fulfillment of the substantial similarity test in the sphere of copyright infringement, automatically sustains a trademark infringement claim, as the two tests are independent and are applied within clearly set out bounds. This would lead to situations where on the same facts, courts find a violation of copyright but not of trademark. The reverse is equally true. Cases such as *Micronix India v Mr J R Kapoor* and *Anwar Mohammad Khan son of Sri Niyamatullah Khan v Sri Taj Mohammad Khan son of Sri Niyamatullah Khan and others* illustrate the fact that both copyright and trademark infringement claims can be brought together. It was in fact observed in the latter case that:

‘On the other hand, copyright protection can be accorded to some other works, like oral works referred to in Section 6(1) of the Act, even if they are not fixed in material form.’

Thus, the primary requirement is the expression of the idea, and for aural or audio works, it need not be expressed in writing or in any material form. It can further be urged that the same line of argument can be applied to scents as well. The creation of scent is most probably in the scientific domain as contemplated in Section 6(1) of the Sri Lanka IP Act. Thus, where courts refuse to recognize a scent as a trademark owing to the inability to graphically represent it, in Sri Lanka it possibly may be argued that if such a scent amounts to original scientific work, it attracts copyright as the scent by itself is a mode of expression though not in visual or material form. However, though such an argument may be put forward, there are practical limitations, such as, the volatile nature of scents that hinder the recognition of scents as the subject matter of copyright. And further, the term science not being defined in the Sri Lankan IP Act creates further doubt as to the plausibility of this argument.

The position in India may be somewhat different. The Indian Copyright Act of 1957 enacts as follows:

‘Works in which copyright subsists:- (1) Subject to the provisions of this section and the other provisions of this Act, copyright shall subsist throughout India in the following classes of works:

(a) original literary, dramatic, musical and artistic works;
(b) cinematograph films; and
(c) records’

The Section 13 of Indian Copyright Act is dissimilar to the Sri Lankan IP Act in that it does not recognize work in the scientific domain for copyright protection. Thus, the possibility of a scent attracting copyright protection can be ruled out. Further, sounds or
musical works become the subject matter of copyright only once they are printed, reduced to writing or otherwise graphically produced or reproduced and not otherwise. Thus the mode of expression should be in material form. Thus, it may be stated that the requirements for recognizing work as copyright material is more stringent in India than in Sri Lanka. As for single colours, it is highly doubtful that single colours would be considered as original intellectual creations, and therefore, would not be considered for protection under copyright.

Nevertheless, in appropriate circumstances, copyright may come to the rescue, where certain unconventional trademarks are refused registration or recognition. This argument is predicated on the fact that in modern business, trademarks are creative and original intellectual creations of humans which ought to be afforded copyright protection, since significant skill, labour, judgement and effort would have been employed in creating such trademarks. And perhaps, where courts refuse to recognize a trademark, parties can nevertheless attempt to seek relief under copyright law, which relief can in certain instances be justly granted.

**Conclusion**

Computers are slowly but steadily taking over every aspect of human life. Now, we consider our society an e-society, the government an e-government and commerce substituted by e-commerce. The growing use of computers in modern society has been very succinctly stated as follows:

‘At first man was illiterate; long thereafter, but before the invention of paper, he became literate.

In recent times man has become e-literate’

Modern business is now being powered by computers and ‘...With electronic media offering so many benefits to mankind, methods of doing business evolved on par with the latest electronic and communication technology in what is now known as ‘e-commerce’. With these developments, data that are electronically recorded have also acquired great significance in modern litigation. While in the past, laws were introduced to compel recording of transactions into writing and to facilitate the enforcement of paper or documentary transactions, these very laws appear to hinder and obstruct the enforcement of electronic transactions’. In future, every home and office will be computerized and purchase of goods and services will be done online, without any human intervention. Computers will be entering into electronic contracts. In such a scenario, what would be the role of a trademark? And further, would consumer confusion be replaced by computer confusion?

Trademarks perform many economic functions and the changes in the ways humans advertise and promote products have directly influenced the role of a trademark in its evolution process. Trademarks that were used years ago are now being used coupled with unconventional trademarks. Advertising at present is aimed at humans and in most instances are in audio visual form. Therefore, trademarks as they stand today are perceivable by human senses. However, as stated earlier, in the future, computers may be making decisions for humans, and thus, advertising has to be computer oriented. They would be in a form in which computers could understand, in binary digits. In other words, modern trademarks would be totally in digital format, thus the birth of the ‘e-Trademark’ will be a significant landmark in human history. Nevertheless, computers would not replace humans, but only human activity. Computers would be agents of the humankind. Thus, rights of consumers and traders would be of paramount importance. And therefore, even in cases where trademarks are formulated for computers to make purchasing decisions based on such marks, they ought to be protected just as any other traditional mark. Therefore, there would be a situation, where trademarks which are also capable of being identified by computers, would have to be recognized, and thus future laws would have to be framed to permit such forms of e-Trademarks to be registered.

The nature of trademarks are bound to change with the elapse of time as changes in advertising strategies and Information Communication Technology would directly influence the way humans promote and advertise products. Thus, law will have to reflect the needs and aspirations of society and legal evolution will have to take place in the context of intellectual property law. It is time that nations such as India and Sri Lanka legislate for the future.

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27 2003 (3) RAJ 100.
28 2006 (3) AWC 2166.
29 Section 6 (1) of the Sri Lanka IP Act.