The Requirement of Graphical Representability for Non-Conventional Trademarks

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Received 29 June 2006, revised 9 August 2006

Non-conventional trademarks are steadily gaining ground in today’s commercial world. This necessitates their registration and protection by legal machinery. The requirement of graphical representability may prove to be the greatest impediment in the way of getting such non-traditional marks like sound, smell and colour registered, for they cannot be put down in pen and paper. Consequently new methods of registering such trademarks need to be evolved, especially in view of the fact that the law in most countries today have expressly or otherwise accommodated such new types of marks as trademarks.

Keywords: Non-conventional trademark, graphical representation, odour marks, colour marks, sound marks

A mark is a sign or indication made by a person or thing. When made by a person, the sign may carry some significance, for instance, the sign may convey some information, or it may demarcate the source of the object on which the mark is made.¹

A trademark is nothing but a sign or a mark serving some purpose for its owner. The word ‘mark’ has been defined in Section 2(1)(m) of the Indian Trade Marks Act, 1999 (the Act) as:

‘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.

The definition is wide one, and merely illustrative. It would be worth noting that the last three categories in this definition, i.e. ‘shape of goods’, ‘packaging’, and ‘combination of colours’ were not there in the definition of ‘mark’ in the previous Act², and are often referred as ‘non-conventional trademarks’, as opposed to the other components of the list that may be termed as ‘conventional trademarks’. Other types of non-conventional trademarks that have come up with the advent of new technologies, savvy marketing techniques and aggressive advertising strategies, include sound marks, odour marks, taste marks, touch marks, motion marks and hologram marks.³

Growth of Non-Conventional Trademarks

The efficacy of any trademark would depend on its ability to create an impact on the minds of the potential customers of that product. If characterization of a product or its representation is unique, it would appeal to people’s perception and senses in a very significant manner. This has led to the advent of a number of unusual non-orthodox trademarks by the manufacturers. Besides, the advent of Internet and electronic commerce has also increased the range of signs that businesses would like to use as registered trademarks. For example, motion and sound marks would capture the attention of Internet users much more efficiently than traditional marks, which in turn have catapulted their popularity in today’s commercial world.⁴

Problem with Non-Conventional Trademarks

Trademark has been defined in Section 2(1)(zb) of the Act as any mark which is distinctive, i.e. capable of distinguishing goods and services of one undertaking from another, and capable of being represented graphically. The definition thus, lays down two broad criteria that a mark has to satisfy in order to become a trademark. The definition of mark is an inclusive one, and therefore non-conventional marks can very well fit into the ambit of trademark if they satisfy the criteria of both distinctiveness and graphical representability.

However, there are also several problems, which make the registration of non-conventional marks as trademarks difficult. The first problem is the distinctiveness criterion itself. Though certain non-conventional trademarks like, shape and colour, can be identified uniformly by consumers, for others like smell and taste marks, perceptions about the mark

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may vary, giving rise to confusion among consumers. But this is only a practical difficulty, and not a legal impediment to obtain registration, as a mark can acquire distinctiveness through use and thereby qualify to be a trademark, even though it may not be inherently distinctive.\(^5\)

The second problem is graphical representability of the mark to be registered, especially in case of odour and sound marks. This is the basic premise of the paper and other barriers to registration of non-conventional trademarks are not dealt with in the paper.

**Graphical Representability: General Overview**

In order to be the subject of a valid application for registration, the sign must be represented graphically\(^6\) as required by Section 2(1)(zb) of the Act. The words ‘capable of being represented graphically’ would mean that the mark should be such as capable of being put on register in a physical form and also being published in the journal.\(^7\) The graphical representation provides a fixed point of reference, showing what the mark is.\(^8\)

In *Swizzels Matlow Ltd’s Application (No 2)*,\(^9\) the Court explained two chief reasons for the requirement of the graphical representation criterion:

(a) To enable traders to identify, with clarity, what other traders (carrying on the same business or otherwise) have applied for registration as a trademark, and for which product.

(b) To enable the public to determine, with precision, the sign which forms the subject of the trademark registration.

Graphical representability is not an objective criterion because the degree of precision, which will render it identifiable, is not spelt out anywhere. However, a cursory reading of the provisions of the Act makes it clear that such representation must be sufficient to permit full and effective implementation of the same. For instance, clear and unambiguous representation of a trademark provides an evidentiary benefit for maintaining a case for trademark infringement under Section 29 of the Act.\(^10\)

The wide subjectivity for adjudging whether a mark has been graphically represented or not has been hedged in with certain guidelines in UK, and a mark is said to be graphically represented upon satisfaction of three broad criteria.\(^11\)

(i) From the graphical representation itself, it is possible to ascertain the mark without the need for any supporting examples.

(ii) The graphical representation can stand in place of the mark itself.

(iii) The persons inspecting the trademarks register or reading the trademark journal can be reasonably expected to understand the nature of the trademark from its graphical representation. Any colour standards, musical notation, or scientific measurements put forth to represent marks must be precise and:

(a) make it reasonably practical for users of the system to be able to obtain a clear understanding of the mark, and

(b) be able to accurately compare the sign, the applicant uses or proposes to use with other similar signs.

The aforementioned guidelines, though not applicable in the Indian context, may nevertheless provide some insight as to how the term, graphical representability, is to be construed. In the Indian context, the term has to be liberally interpreted, not only to accommodate non-conventional trademarks, but also while keeping in mind the legislative intent in laying down the wider test of graphical representability instead of ‘visual perceptibility’ as used in TRIPS.\(^12\) Further, the requirement of graphical representation should be read in the context of the Act itself, and the rules framed under it. Most notably, Rule 2(1)(k) of the Trade Marks Rules, 2002 defines ‘graphical representation’ as the representation of a trademark ‘in paper form’. This makes it clear that whatever representation of the trademark is done, it has to be done on paper, that is, in accordance with the form prescribed for its registration application.

**Graphical Representation of Non-Conventional Trademarks**

Graphical representation of non-conventional trademarks is more of a practical than a legal problem. Coupled with distinctiveness, it may pose as a serious obstacle in the way of registering non-conventional trademarks. This is particularly true in case of odour, sound and colour marks.
Odour Mark
This is a very uncommon and controversial trademark that has gained a lot of attention in recent times. In spite of the problems in registering odours as trademarks, few odours have already been registered as trademarks, whereas, several other applications for registration of odours have been withdrawn or rejected at trademark registries of different countries.

One such illustrative case in which the registration of smell mark was rejected on the basis of non-fulfillment of the graphical representability criterion, among other factors, is that of Ralf Sieckmann v German Patent Office. The chief issue in this case was whether an olfactory mark described as ‘balsamically fruity scent with a slight hint of cinnamon’ could be registered as a trademark in respect of certain services.

On reference being made to the ECJ by the German Federal Patents Court, the ECJ decided that graphical representation per se is not enough for registration, and it must meet the following criteria:

- It must be complete, clear and precise, so that object of the right of exclusivity is immediately clear.
- It must be intelligible to those persons having an interest in inspecting the register, i.e. other manufacturers and consumers.

Having laid down these criteria, the Court observed the following difficulties encountered in graphically representing smell marks:

1. Representation as a drawing was not possible.
2. Representation by chemical formula would not suffice, as the chemical formula represents the substance itself and not its odour.
3. Further, representation by chemical formula lacks clarity and precision, not only because of the fact that very few people would have the requisite technical knowledge to interpret the odour of a substance from its formula, but also owing to the reason that the same substance would produce different smells at different temperature, concentration, etc.
4. Deposit of a sample of the substance with the registry was not a feasible alternative, since, firstly, it was not a graphical representation, and secondly, odour being volatile may fade and even disappear over a period of time.

Finally, the Court decided that clear and precise graphical representation is impossible for olfactory signs, and although they may be distinctive, they could not be registered as trademarks at that point of time.

The scenario is different in US, where the Trademark Manual of Examining Procedure states that trademark applicants need not submit a drawing of the mark if the mark consists solely of a non-visual mark such as scent or sound. Instead, applicants are expected to submit a detailed written description which clearly describes the non-visual mark. The first case where registration of smell mark was allowed in the US was In Re Celia Clarke; though this case did not deal directly with graphical representation. The applicant filed for a trademark protection of a scent with the description, ‘a high impact, fresh, floral fragrance reminiscent of Plumeria blossoms’ for use with sewing thread and embroidery yarn. Though initially the registration was refused, it was allowed on appeal because the appellate board felt that if the applicant’s scent did function to indicate origin; potential consumers might readily be able to distinguish among the vast array of scents in identifying competing sources of goods.

Recently, Noble laureates, Dr Richard Axel and Dr Linda B Buck showed that each olfactory receptor cell in the human body is associated with only one corresponding odourant receptor gene. Most odours are composed of multiple odourant molecules, and each odorant molecule activates several odourant receptors, leading to the formation of an ‘odourant pattern’. As a result, a precise ‘odour matrix’ (similar to colour charts in the Pantone system) can be formulated for the purpose of classifying and identifying odours. This may solve the problem of graphical representability of smell marks to the extent of possibility of representation of such marks. But the other problems highlighted in Sieckmann’s case, namely, accuracy of such representation and feasibility of depositing samples with registry remain unresolved. Though no concrete solution can be offered as of now, the aforementioned scientific discovery may provide an approach to tackle the problem of representing scent marks.

Sound Mark
This is yet another non-conventional trademark faced with the problem of graphical representability. The normal way of graphical representation of sound mark is the use of musical notations and written
description. 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. But this proposition has been rejected by the INTA as being impracticable, for firstly, sound cannot be published by the Trademark Registry and people have to go to the registry to hear it, and secondly, it would be difficult for the registry to store so many sound samples.

Sound marks can be validly registered as trademarks in US, UK and Canada. Though certain orthodox stances were taken by the judiciary on this issue in the initial years, registration of sound marks have become commonplace in recent times. Further, though sounds can be graphically represented with the aid of musical notes, the acceptance of different forms of graphical representation of sound marks by different trademark registries is an issue in hand.

In the case of Shield Mark BV v Joost Kist h.o.d.n. Memex, the ECJ observed that requirement of graphical representation was not satisfied when the sound 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
- An indication that it is the cry of an animal
- By means of a simple onomatopoeia
- By means of a sequence of musical notes

On the other hand, graphical representability requirements are satisfied where the sound is represented as ‘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’.

Sound marks can also be accommodated into the Indian trademark law framework. The Shield Mark solution as pronounced by the ECJ is too technical a solution to follow, and a practical alternative would be storage of the sound mark in a computerized trademark registry, which could be accessed by everyone. Along with this, a written description of the mark in the form of musical notes should be deposited with the registry, which would benefit the experts who can read notations in case any dispute should come up.

**Colour Mark**

Colours can be used as trademarks in two forms—as a single colour, or as a combination of colours. The latter has been expressly included as a form of mark that can be used as a trademark, in several national legislations. This inclusion resolves earlier confusions as to whether combination of colours could be a ‘mark’ at all, and whether it could be distinctive enough to be registered as a trademark, both of which were answered in the affirmative by the House of Lords in Smith Kline and French Laboratories Ltd v Sterling Winthrop Group. But to examine the issue of graphical representation of non-conventional trademarks, it would be important to look into the decision of the ECJ in Libertel Groep BV v Benelux Trade Mark Office.

In this case, the issue was whether a mark consisting of a single colour ‘orange’ could be registered as a trademark. The ECJ reiterated the criteria for graphical representation as laid down in the Ralf Sieckmann case, and held that such representation must be ‘clear, precise, self-contained, easily accessible, intelligible, durable and objective’. In this case, the query related to a sample of the colour on a flat surface, a description in words of the colour and internationally recognized colour identification code. The Court undertook to find out whether this representation fulfils the criteria laid down as above. A sample of colour alone cannot pass the test, because it is not durable and would lose its original shade with the passage of time. However, designation of a colour using an internationally recognized identification code like Pantone may be considered to constitute a graphic representation, for such codes are deemed to be precise and stable.

The ECJ’s ruling in Libertel case is a very pragmatic approach to the problem, and use of the Pantone colour system can be immensely helpful in this regard. The Pantone is a commercial system that designates specific shades numerically and categorizes over thousand such shades by unique codes. Therefore, to solve this graphical representability issue, India may follow the Pantone or any internationally recognized colour identification code, keeping in view other objectives like those of preventing colour depletion and anti-competition.

**Conclusion**

The protection of trademarks is the law’s recognition of the psychological function of symbols. New forms of such symbols or marks that
have greater psychological import on consumers, and hence more commercial significance, should be provided similar protection as other traditional forms of marks. Difficulty in registering such marks as trademarks on paper should not act as a deterrent to their use, and new methods of identifying and classifying such marks should be evolved to afford protection to the users of such non-conventional trademarks and newer ones that may come up in near future.

References

1. Philips v Remington (1998) ETMR 124, a sign is ‘anything which can convey information’.
2. Section 2(1)(j) of the Trade & Merchandise Marks Act, 1958 defines mark as ‘Mark includes a device, brand, heading, label, ticket, name, signature, word, letter or numeral or any combination thereof’.
5. Section 9(1) of the Act mandates that lack of distinctiveness would be an absolute ground for refusal of registration. However, the proviso to the said section virtually obliterates its effect by laying down that the requirement of distinctiveness for obtaining registration is done away with if the mark has acquired distinctiveness through use, and in that case it can be registered as a trademark.
6. The law in UK is quite similar in this regard. As per Section 1 of the UK Trade Mark Act, 1994, a trademark is a ‘sign capable of being represented graphically’.
10. Section 29 of the Act requires the mark allegedly infringing an earlier trademark to be deceptive similar to or identical with the latter.
12. Article 15 of TRIPS, 1994 lays down that ‘Members may require, as a condition of registration, that signs be visually perceptible’.
13. In UK, a registration has been made by Sumitomo Rubber Industries Ltd for a trademark described as a floral fragrance/smell reminiscent of roses as applied to tyres.
14. The odour of the perfume no 5 of Chanel was sought to be registered in UK, but withdrawn due to technical difficulties in describing the odour. Initially it was described as: ‘The scent of aldehydic-floral fragrance product, with an aldehydic top note, from jasmine, rose, bergamot, lemon and neroli; and elegant floral middle note, from jasmine, rose, lily of the valley,orris and ylang-ylang: and a sensual feminine base note, from sandal, cedar, vanilla, amber, civet and musk. The scent is also known by the written brand name No. 5’. This inadequacy in description may provide a clue as to why odour marks are hard to be registered as trademarks.
21. Playboy Enterprises Inc v Germain, 16 CPR (3d) 517 (1987), where Panard J observed on the issue of graphical representation of sound mark with musical notes: ‘I am of the opinion that, use of a verbal description is not use of a trade mark within the meaning of the Trade Marks Act. A mark must be something that can be represented visually.’
22. Like the lion roar for Metro Goldwyn-Mayer, and the chime of 20th Century Fox, which consists of ‘Nine bars of primarily musical chords in the key of B flat; the chords consisting of four, eight and sixteenth notes’.
24. The definition of ‘mark’ in Section 2(1)(m) and ‘trademark’ in Section 2(1)(zb) of the Trade Marks Act, 1999 expressly includes ‘combination of colours’ as a mark that can be registered as a trademark.
25. (1975) 2 All ER 578. In this case, the unique combination of colours applied on drug capsules were held to be ‘marks’ within the meaning of Section 68(1) of the Trade Marks Act, 1994. Further, the Court ruled that the said colour combinations were distinctive because they were ‘adapted...to distinguish SKF’s goods from other manufacturers’. Moreover, the colour combinations of the capsules had acquired distinctiveness through use, and were registrable as trademarks.