

The Broadening Horizons of Trademark Law —Registrability of Smell, Sports Merchandise and Building Designs as Trademarks

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With every passing day the ambit of trademark protection law is being broadened all over the world. This paper deals with three such important aspects – three new areas on which trademark protection is being envisaged, which have, of late, given rise to serious debate in juridical circles. To be more precise, this paper deals with the registrability of smell, sports merchandise and building designs as trademarks. The paper is exploratory in nature and does not take any stand as to whether a particular thing should be trademarkable or not. It rather culls out and analyses the arguments advanced for and against such broadening of trademark laws.

Keywords: Trademark law, unregistered trademarks, club merchandise, building designs

In the recent years, keeping pace with the globalization and aggressive commercialization, the ambit of intellectual property has been taken to unprecedented levels. The law regarding protection of trademarks has been no exception in this regard. With every passing day, the ambit of trademark protection law is being broadened all over the world.

Essential Elements for Protection under Trademark Law

The definition of ‘Trademark’ given under the Trademark Act, 1999, in India and foreign legislations is extremely wide¹. The very broadness of these provisions goes on to show that the lawmakers intended to retain a certain level of flexibility to allow for enhancement in the ambit of trademarkability.

Function of a Trademark

The primary function of a trademark is the indication of source of the product². It gives the purchaser a satisfactory assurance of the make and quality of the article he is purchasing, the particular quality not being discernible by the eye³. To summarize, trademark performs three functions – (i) identifies the product and its origin, (ii) guarantees its unchanged quality, and (iii) advertises the product⁴.

Hence, essential elements of protection under trademark law can be culled out as follows:

- It must be a mark capable of being represented graphically⁵.
- It must be capable of distinguishing the goods or services of one person from those of another⁶.
- It must be used or proposed to be used in relation to goods or services and such use must be upon, or in any physical or any other relation whatsoever to the goods⁷.
- The use must be in the course of trade⁸.

At this juncture, one more point becomes extremely relevant – the fact that, under the trademark laws all over the world, the same good may bear more than one trademark⁹. This becomes relevant for the present paper because in the new areas of trademarkability that the paper seeks to analyse, the relevant goods or services might already be protected by a conventional trademark. The legality of plurality of trademarks, preempts any objection on the basis of pre-existing trademarks on the relevant goods or services.

Analysing the Usage of Smell as Trademark

Under the TRIPS regime, the definition of trademark has been given in a very broad manner¹⁰. Members are free to determine whether to allow the registration of signs which are not visually perceptible (e.g. sound or smell marks)¹¹.

Even in the WIPO, the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications, in its Eighth Session¹²

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discussed suggestions for the further development of international trademark law. It was decided that provisions will be proposed to give a more complete and broader definition of a mark¹³.

Problems with Registrability of Smell as a Trademark

The main problem in accepting smell as trademark, both under the Indian law and other jurisdictions such as the European Union and the United States of America, has been the problem with the requirement of graphical representation¹⁴. It is a fundamental principle for all registration systems that the character of a trademark as well as its contents and scope should be defined as clearly and unequivocally as possible in the application. It was therefore held in several early decisions of the Office for the Harmonisation of Internal Markets [Trademarks and Designs] (hereinafter, OHIM) board of appeals, that a mere description would not be sufficient¹⁵, as, for instance, the description of a colour would only convey a vague idea of the protected subject matter and would therefore be inconsistent with the objective of legal certainty¹⁶.

Judicial Trends *vis-à-vis* Registrability of Smell

The 2nd Board of Appeals at OHIM held that a smell mark could be registered on the basis of the description 'smell of fresh cut grass'¹⁷.

This decision, however, did not change the general line observed by OHIM examiners to refuse applications where the graphical representation is substituted by a description. Only in one additional case, the 3rd Board of Appeal found that the description 'scent of raspberries' was precise, clear and unequivocal enough to furnish a sufficiently secure representation of the smell¹⁸.

The UK registry has accepted the description of 'the strong smell of bitter beer' applied to flights for darts as a sufficient description to satisfy the graphic representation requirement¹⁹. 'Smell reminiscent of roses' applied to tires was also accepted as a sufficient description²⁰. At this juncture, the decision in the case of *R v John Lewis*²¹, deserves a mention. In that case, an application was made to register a mark described as 'the smell, aroma or essence of cinnamon', for furniture. The application was refused by the registry and that aspect of the decision is being highlighted by most eminent authors on intellectual property laws as indicative of the fact that a verbal description of smell would not be enough to satisfy the graphical representation requirement²². With due respect, it is

submitted that they have missed out on an interesting aspect of the judgement. It was held that, though the description 'the smell, aroma or essence of cinnamon' was not sufficient, it was sufficient to register "the smell of cinnamon as emitted by 'x'; with the nature and condition of 'x' clearly defined; if 'x' in those conditions was and was likely to remain, generally accessible for use as a benchmark of the specified smell. Hence, the crux of the matter is that the verbal description should be comparable to a standard which is generally accessible.

Again, this case also rejected the description of smell through an electronic sensory analysis by chromatography techniques to be insufficient to fulfill the graphical representation requirement. This was also taken into account and highlighted by authors who are pessimistic about the trademarkability of smell marks²³. The logic given by the Court in support of this decision is that it would be unintelligible to anyone inspecting the register, even with necessary equipment, unless the details of the test conditions applied are also disclosed²⁴. Hence, through a proper disclosure of the test condition, applied electronic sensory analysis by chromatography techniques can be used to suffice the requirement of graphical representation²⁵. However, all the above discussion becomes merely academic in nature in the European Union as the uncertainties with respect to smell marks have been brought to an end by the European Court of Justice (ECJ) decision of 12 December 2002²⁶. The case concerned an application for a smell mark filed with the German Patent Office, which was described as 'balsamically fruity with a slight hint of cinnamon'. The applicant not only described the trademark in words, but also provided the chemical formula of the underlining composition of the smell, derived from methyl cinnamate. The applicant also volunteered to provide a sample of the smell in a sealed container to be deposited at the German Trademark Office and to be held on file, so that people could 'sniff' the trademark²⁷.

The ECJ held that

"Article 2 of Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trademarks must be interpreted as meaning that a trademark may consist of a sign which is not in itself capable of being perceived visually, provided that it can be represented graphically, particularly, by means of images, lines or characters, and that the

representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective.

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.”

Hence with the existing modes of representing it, smell cannot be trademarked in the EU after this decision.

The situation in USA in this regard²⁸, however, is different. Prior to the case of *In Re Clarke*, it has not always been clear whether a fragrance claiming use in the manner of a trademark could be registered²⁹. In 1990, an examiner's refusal to register a scent mark was appealed to the Trademark Trial and Appeal Board. The mark was described as ‘a high impact, fresh, floral fragrance reminiscent of plumeria blossoms’ for use with yarn and thread. The Board reversed the examiner’s refusal, holding that ‘fragrance can be capable of serving as a trademark to identify and distinguish’ goods³⁰. However, the Board drew a clear distinction between a fragrance used in the identifying manner of a trademark that is not an ‘inherent attribute’ of the product, which may be registered, and the ‘fragrances of products which are noted for those features, such as perfumes, colognes, or scented household products’, which may *not* be registered. It would seem that, like a distinctive shape that is an inseparable feature of a product, an odour that is inherent in the function or nature of a product, could not look to a claim of trademark rights for protection³¹.

The *plumeria* blossom scent registration has since expired, but there are a number of registrations of scents as trademarks currently in force, including ‘a scent mark having the scent of bubble gum’ for use with ‘oil based metal cutting fluid and oil based metal removing fluid for industrial metal working’³².

Conclusion

Smell has an important role to play in the evaluation of brand. First of all, it is something new and therefore helps the brand to stand out from the crowd, giving it something that the others have not got. In the past, some companies created their own smell logo without even realizing it. The study of these cases brings to light important data with regard to the effectiveness of fragrance marketing. In fact, subjects studied during the research associated the

smell of vanilla with the trademark ‘Borotalco’, not simply baby's talcum powder. French subjects associated the smell of cedar wood with the brand name ‘Crayola’, manufacturers of pencils. These examples help to show how a smell common to a number of similar products automatically becomes the fragrance logo of the largest-selling brand in the public's mind³³.

The hesitation to bring olfactory creations under intellectual property law has been due to the absence of an instrument able to achieve a designation and comparison of two fragrances³⁴. Smell sensors bring about an answer to this situation since they are able to carry out a designation and graphic representation of a fragrance enabling protection to be obtained by trademark law. The designation of two perfumes can be done by using a FOX 4000 instrument. This instrument has been used in order to carry out an analysis of a sample of the perfume to be protected. This analysis results in the production of a digital file used for preserving the proof of the sample analysis result, and for carrying out a ‘Patchwork’ type graphic representation.

This representation makes it possible to represent the mark graphically, and to distinguish the designated product or service from competitive products or services³⁵. This way the problem of judging deceptive similarity can also be taken care of in cases of infringement. All this paper tries to point out is that a new path has been opened and the Courts in India should be open to these new ideas. It would be presumptuous to claim that smell trademarks will be registered immediately, but, nevertheless, it is submitted that, filing a sensory mark, such as a fragrance, for a trademark comes under the same process as filing a sound or musical sequence for a trademark, which has been accepted for a few years.

It is admitted that legal proceedings cannot be based on the sole results of a smell designation instrument. However, these techniques can be used as a vital addition to other tools, such as, sensory analysis³⁶. On a legal level, it is appropriate to remember that the mark to be protected is not the graphic representation being filed, but the mark itself, namely, the fragrance of a perfume, or product or service. Therefore, it is appropriate to complete the filing of the trademark with different details, which enable current imperfections of the graphic representation given by smell sensors to be offset, allowing an unequivocal and incontestable

identification of the fragrance being filed for trademark³⁷.

Olfactory measurement methods mentioned above contribute a valuable complement by supplying data that is independent of the human perception of experts or groups of people brought together for sensory analysis. Joint use of these two methods will enable the legal expert and judge to have at their disposal an instrument of designation and comparison, which has been lacking until today and hence most of the problems regarding trademarkability of smell can be taken care of.

As has been seen above and is generally understood, in order to persist, a trademark has to be registered with regard to ownership to avoid litigation that may arise in the future. An application for a trademark in India is to be made to the Registrar of Trademarks, as per Section 18(1) of the Trademarks Act of 1999. As per Rule 25(2) of the Trademarks Rules, 2002, 'An application to register, a trademark for a specification of goods or services included in any one class shall be made in Form TM-1.

The TM-1 application format is important as it is to be submitted to the Registrar of Trademarks, which would further be considered by the competent authority. The authors have some observations with regard to the application format, which would indeed make it almost impossible for the Registry to register smell as a trademark.

The forms are to be found in Schedule 2 of the Trademarks Rules, 2002. At the very outset, the TM-1 application requires a 'representation' of the trademark to be fixed in the space that is provided for the same. This would be the first deficiency of the TM-1 format; it would be impossible to attach a representation of the trademark in the case of smell to be a trademark for goods or service.

Also, as per Rule 25 (12) (b), the trademark application should be able to depict the graphical representation of the trademark. It is quite clear that a smell as a trademark cannot be depicted graphically, this problem being present in most jurisdictions of the world. It is opined by the authors that, in the case of a three dimensional trademark, the act and the rules have made exceptions; thus, in order to facilitate smell to be registered as a trademark, it would be necessary to introduce an amendment, both in the act and in the rules, as has been done for the combination of colours and three dimensional trademarks.

Thus, it can be fairly concluded that, in the present legal framework, the Indian Trademarks Registry is incapable to register smell as a trademark; an amendment of the trademark law would be required. The trademark examiners, while deciding on the trademarkability of a particular fragrance, should keep in mind the following points: (i) an applicant must establish that the smell is used or intended to be used as a trademark; (ii) that the smell does not arise from the goods or services, but is added or is a combination created by the applicant; and (iii) that the public associates or will associate the smell exclusively with the applicant for the goods or services specified³⁸.

Analysing the Usage of Club Merchandise as Trademark

With every passing day, the craze and hero-worship centered on sporting activities is reaching new heights. The amount of money invested in various sporting clubs has reached unprecedented levels. In this backdrop, it is but natural that these clubs would seek exclusivity in selling their merchandise to the sports fans and recover some part of the astronomical money spent by them. However, such seemingly legitimate expectations have not been met by the street vendors selling club merchandise in some cases and has led to litigation – the most important of them being the case of *Arsenal v M. Reed*³⁹. Matthew Reed, an Arsenal fan, sold shirts, scarves and hats bearing the Gunners' logo, which was the trademark of the club. Arsenal brought the case to protect its right to 'Arsenal', 'Gunners' and the club 'crest and cannon' emblem⁴⁰.

Mr Justice Laddie ruled that the club had failed to show that Matthew Reed, an Arsenal fan, had infringed the club's trademark by selling shirts, scarves and hats bearing the Gunners' logo⁴¹.

He also rejected the club's claim that Mr Reed, Stanford Le Hope, Essex, was 'passing off' the merchandise as genuine Arsenal products⁴², but said there were enough uncertainties in trademark law to warrant a further hearing—either by the Court of Appeal or the European Court of Justice. The outcome surprised soccer clubs following the case and anxious to protect the considerable sums of soccer merchandise revenue⁴³. In ECJ, it was held that

“It is ‘simplistic reductionism’ to limit the function of a trademark to the indication of trade origin. The trademark acquires a life of its own, making a statement and about quality, reputation

and even, in certain cases, a way of seeing life. The reasons why consumers choose to buy goods and services are irrelevant. What matters is that the people, for whom goods or services are intended, acquire or use them because they incorporate the distinctive sign.”

This decision will make it much easier not only for sports clubs, but also for pop groups, character merchandisers and other trademark owners to control their markets. Street traders may be driven underground⁴⁴ (Laddie J, however, refused to accept this decision and thereby rekindled the debate).

The principles stated in the Arsenal case were echoed in the arbitral decision by WIPO in Galatasaray case also.

Galatasaray Case⁴⁵

The Galatasaray is a very well-known association football (soccer) club founded in 1905 in Istanbul, Turkey. It has repeatedly won the Turkish Super League Cup and in 1999-2000, it won the UEFA Cup. The second complainant is a connected company which owns the registered trademarks used by the club. The third complainant is another connected company which manages marketing operations in respect of the club's trademarks. The complainants have registered various trade or service marks (hereinafter both referred to as trademarks) in Turkey, including 'Galatasaray Spor Kulubu GS 1905,' 'GS 1905 Galatasaray Spor Kulubu 1980' and logos comprising a monogram combining the letters 'G' and 'S', together with '1905' or a depiction of a lion or bird. The 'GS' monogram is used on the team shirts and on the complainants' website, which also advertises merchandise using the name 'Galatasaray Store' with the first letters of these words picked out in a different colour.

The respondent registered the domain name, gsstore.com, on 16 December 1999. The domain name currently resolves to a blank page and there is no evidence of any practical use of the domain name by the respondent. The respondent's contact address on the Registrar's WHOIS database is 'hostmaster@gameshark.com.'

- The complainants contended first that the domain name is identical or confusingly similar to trademarks in which they (or one of them) have rights. They point out that the dominant feature of the domain name is 'GS' and that these are the

initials of the name of the club, 'Galatasaray Spor'⁴⁶.

- Secondly, the complainants maintain that the respondent has no rights or legitimate interests in respect of the domain name. They point out that the respondent is not known by this name, that it does not have any permission of the complainants to use it, and that it has made no bona fide use of it⁴⁷.
- Thirdly, the complainants alleged that the respondent registered the domain name and is using it in bad faith. They asserted that the respondent was clearly aware of the complainants' extensive reputation, intended it to refer to the complainants and hoped that the complainants would pay for it. They noted that it is common for leading football clubs to use such names for the sale of merchandise, as in the case of a rival Turkish football club, Besiktas Jimnastik Klubu, which has a website at 'www.bjkstore.com'.
- The complainants further assert on similar grounds that the respondent registered the domain name in order to prevent them from reflecting their trademarks in a corresponding domain name. In this connection, they also note that passive holding of a domain name can constitute use in bad faith.
- Finally, the complainants alleged that the respondent has tried to take unfair advantage of the reputation of their trademarks by creating a likelihood of confusion⁴⁸.

The WIPO Panel held that the letters 'GS' could stand for many businesses or other organisations with names consisting of words beginning with 'G' and 'S', including the name 'gameshark' which the respondent uses in its email address; and 'store' is generic. Furthermore, the respondent is in the USA, a country where the 'beautiful game' of association football has become more popular in recent years, but is still far from being a dominant sport. There is no reason to suppose that the respondent had heard of the complainants, still less that the respondent knew that they used or were called by the initials 'GS'.

The complainants' assertion that the respondent knew about the complainants and intended the domain name to refer to them is not challenged by the respondent, but the Panel did not consider that it is bound to accept an unsubstantiated assertion which appeared improbable on the basis of the available information⁴⁹.

The complainants' representatives have made every point which could be made in support of their case that the respondent has acted in bad faith. However, the fact is that there was no evidence to support this contention, and on the available information it seemed unlikely⁵⁰.

The Panel was not satisfied on the balance of probabilities that the domain name was registered or is being used in bad faith. The complaint was, therefore, rejected⁵¹. However, the Panel was satisfied that the impugned domain name is confusingly similar to the complainants' marks and that the respondent had no rights or legitimate interests in respect of the domain name. Hence, the only decisive factor was that the respondent was from USA, where football was less popular.

Conclusions

Considering the potential pecuniary benefits for the various sports clubs and consequentially the national exchequer, the logos of the various clubs should be allowed to be registered as trademarks to earn revenue from the monopoly in club merchandise as well as domain names. A good example would be the logo of the Mohun Bagan Football Club – *Sailboat*.

However, at this juncture a note of caution must be sounded. Though the logos belonging to various sporting events or clubs can be protected under Indian Trademark Law as per the decision in *ICC Development International Limited v Arvee*⁵², by the Delhi High Court, it should be noted that the same can be misappropriated without any legal remedy under Indian laws by aggressive merchandising tactics, known as 'Ambush Marketing'⁵³.

Analysing the Usage of Building Designs as Trademark

In Cleveland, Ohio, The Rock and Roll Hall of Fame is situated. Perhaps believing that the Museum was too laid-back, the Museum commissioned the world-famous architect, I.M. Pei, to redesign the facility so that it would symbolize "*the freedom, youthful energy, rebellion and movement of rock and roll music*". In September 1995, Pei's creation opened to acclaim. Eye-catching features include a triangular facade of steel and glass, and a fusion of interdependent, odd shaped buildings overlooking Lake Erie⁵⁴.

In 1996, Charles Gentile, a professional photographer, began selling a poster featuring a sunset photograph he had taken of the Museum.

Shortly after the Gentile poster hit the market, the Museum sued for trademark infringement basing its claim on an unregistered trademark in its building design. The Museum argued that Gentile's sale of the poster might confuse the public into believing that the poster was produced, or sponsored by, the Museum, when that was not so⁵⁵.

The case is not some quaint, curiosity over the travails of a famous museum, but has a more serious side to it. The importance of the case lies in this question--can a building, as a building, serve as a trademark?

The Appeal judge then commented on what he called the principal difficulty with the Museum's position:

"Although the Museum has used drawings or pictures of its building design on various goods, it has not done so with any consistency ...consistent and repetitive use of a designation as an indication of source is a hallmark of a trademark."

The Rock and Roll Museum case⁵⁶ therefore highlights two important background points of trademark law, and a third more pressing issue for advertising agencies.

- First, a trademark must distinguish one's goods and services from another. If it does not, the word, phrase, design or object does not constitute a trademark. For example, the words 'Del Monte' will point to their goods as emanating from that vendor as opposed to another vendor.
- Second, the case shows that trademarks must be used in a consistent way. The Rock and Roll museum used different versions of its building on the goods that it merchandised. There is no law that prevents you from having more than one design of your trademark; however, unless at least one consistent version of the mark is used, the trademark may not be capable of gaining the recognition needed to distinguish the seller's goods or services from those of another⁵⁷. What the case also highlights is that a building may well be capable of serving as a trademark. To be clear, not all buildings will constitute a valid trademark. However, as the above discussion shows, had the museum used its building's design in a consistent way, it would have at least been able to get out of the starting gate by showing that there was a possible trademark present that was possibly capable of protection.

As a matter of fact, the trademark law of America has recognized the availability of buildings to serve as trademarks for many years. A federally registered trademark exists for the art deco spire of the Chrysler Building and the neoclassical facade of the New York Stock Exchange⁵⁸. In fact, approximately one hundred buildings have federally registered trademarks⁵⁹. However, the Sixth Circuit's decision in *Rock and Roll Hall of Fame and Museum, Inc v Gentile Productions* altered the scope of protection that such trademarks enjoy. Traditional trademark law suits involving building designs deal with potential infringers creating similar building designs. The *Rock and Roll Hall of Fame* case differs because it involves protection of a building design depicted on museum merchandise and a competing poster embodying a photograph of the design. Two different courts, in the *Fotomat Cases*⁶⁰, analysed the problem of functionality in relation to a drive-thru photo developing business' kiosk design. In *Fotomat I*⁶¹ a New Jersey district court stated that trademark protection only existed for building design elements that are distinctive, nonfunctional, or arbitrary. In *Fotomat II*⁶, a Kansas district court found that the plaintiff's overall building design, the same design as in *Fotomat I*, could serve as a valid trademark. The court held that, while a building design might have some functional elements, it could still be protected if the design was not 'in essence' functional⁶³.

Conclusion

Landmark buildings can be used as trademark. Two building designs are registered to McDonald's Corporation for restaurant services. In India, for example, the building of the National University of Juridical Sciences can be used as trademark. As a result, if agencies, which offer tuitions for NUJS entrance exam, advertise with the photograph of NUJS building; they can be sued for hefty amounts.

References

- 1 Section 2(1) (zb) – 'Trademark' means a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those others and may include shape of goods, their packaging and combination of colours. In fact, 'Mark' has also been defined in the act in section 2(1) (m), in an inclusive fashion
- 2 Powell's Tm. (1893) 10 RPC195, at 200 followed in *Sumat Parsad v Sheojanan Prasad* AIR 1972 SC 2488 at 2490
- 3 *Ibid*
- 4 See, Industrial Property, WIPO, September 1978, p 219. Quoted from Narayanan P, *Law of Trademarks*, 5th edition (Eastern Law House), 2000, p 13
- 5 Section 2(1) (zb)
- 6 *Ibid*
- 7 Section 2(2) (c). This provision becomes extremely important where smell is being considered as trademark. Since the relation between the mark and the goods can be any relation whatsoever and not restricted to a physical relation, there cannot be any objection to smell as trademark on that count
- 8 *Aristoc v Rysta* (1945) 62 RPC 65 at 79. See also, *Astronaut Tm.* (1972) RPC 655 at 671. Quoted from Narayanan, *supra* note 4
- 9 "There appears to be nothing wrong in two trademarks (and logically any number of trademarks) having different connotations being used alongside each other under the Trademark Act, or at common law, provided of course and so long as there is a proper connection in course of trade." Held in 'GE' Trademark, 1969 RPC 418 at 463; Quoted with approval by Narayanan, *supra* note 4
- 10 Any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings can be used as trademark – Article 15, TRIPS
- 11 http://www.wto.org/english/thewto_e/whatis_e/eol/e/wt_o07/wto7_17.htm
- 12 Held in Geneva, 27 - 31 May 2002
- 13 For example, by going beyond current definitions such as 'visible signs' (Article 2(1) (a) Trademark Law Treaty)
- 14 See Bentley and Sherman, *Intellectual Property Law*, Oxford University Press, First edition, 2001, p.773. See also, Guy Triton, *infra* note 21, Kerly's *Law of Trademarks and Tradenames*, 13th edition, Kitchin, Llewellyn, Mellor, Meade, Moody Stewart eds. Sweet and Maxwell, p. 15, David Bainbridge, *Intellectual Property*, 4th edition, Financial Times, Pitman Publishing, 1999, p 554
- 15 See, http://www.juridicum.su.se/english/master/ipl/reading%20Material/A%20Kur%20european_trademark_1_a.htm
- 16 See, the Decisions: 21.01.1997, R 4/1997-2 - Vacuum packing; 12.02.1998, R 7/1997-3 - ORANGE; 07.10.1998, R 1/1998-2 – Déclic. Available at *Ibid*
- 17 See Tritton Guy, *Intellectual Property in Europe*, 2nd edition, Sweet and Maxwell, 2002, p 215-216
- 18 The decision of 5 Dec. 2001, R 711/1999-3, available at *supra* note 19. However, ultimately the trademark wasn't granted. The smell mark was not considered sufficiently distinctive for the products for which it was intended to be used, namely fuels, including motor fuels. But the requirement of graphic representation was held to be satisfied through the verbal description
- 19 <http://www.copat.com/markenformen/eugh-kom/pinsent.pdf>
- 20 The case of Sumitomo tires. Quoted from http://www.jenkins-ip.com/serv/t_trad03.htm
- 21 [2001]R P C 28
- 22 See Bentley and Sherman, *Intellectual Property Law*, Oxford University Press, First edition, 2001, p742 in footnote 43
- 23 *Ibid*. See also, Lyons D, Sound, smells and signs, *European Intellectual Property Review*, 1994, 540
- 24 See *supra* note 24
- 25 And anyway detailed disclosure is not an unreasonable requirement

- 26 C-273/00, http://www.juridicum.su.se/english/master/ipl/reading%20Material/A%20Kur%20european_trademark_la.htm
- 27 <http://www.copat.com/markenformen/eugh-kom/pinsent.pdf>
- 28 17 USPQ2d 1238
- 29 See Cornish W R, *Intellectual Property*, 4th edition, Sweet and Maxwell, 1999, p 683, footnote 63. See, Amanda Michaels, *A Practical Guide to Trademark Law*, 3rd edition, Sweet and Maxwell, 2002, p13-18
- 30 See *Intellectual Property – Cases and materials*, D Lounge, M La France, G. Myers eds, American Casebook Series, West Book Series, West Group, 1998, p136 – 139
- 31 See Cornish W R, *Intellectual Property*, 4th edition, Sweet and Maxwell, 1999, p 675
- 32 US Registration No 2,560,618, <http://www.bohanlaw.com/tmscent.html>
- 33 http://www.profumo.it/perfume/olfactory_communication/olfactory_marketing.htm. Our memory for smells works in such a way that our first memories of smells that go back to our childhood are the most powerful in their ability to recreate pleasant feelings as well as being the easiest to trigger off. Our memory for smells never disappears and the ease with which we associate smells to certain situations depends on the importance of the situation in which the smell was perceived during the learning process
- 34 See *supra* note 18
- 35 http://www.profumo.it/perfume/olfactory_communication/olfactory_marketing.htm
- 36 Sensory analysis can be defined as the examination of the organoleptic properties of a product on the sensory organs. The methods are not arbitrary or intuitive, but they obey rigorous statistical and scientific rules, which come under international standards. Sensory analysis allows the degree of similarity between two perfumes to be quantified, and this degree of similarity to be pinpointed in comparison with other perfume pairs
- 37 <http://www.bohanlaw.com/tmscent.html>
- 38 See Rule 25(2) of the Trade Marks Rules, 2002
- 39 These points have been taken from The Guidelines for Trademark Examination issued to the trademark examiners in America. The guidelines are in file with the author
- 40 <http://www.telegraph.co.uk/money/main.jhtml?xml=/money/2001/04/07/cnfoot07.xml>. Last visited on 22/6/2003. See also, Sudipta Bhattacharjee, Ambush marketing - The problem and the projected solutions *vis-a-vis* intellectual property law – A global perspective, *Journal of Intellectual Property Rights*, 8 (5) 2003, 375-378
- 41 <http://www.legalday.co.uk/lexnex/simkins190602.htm>
- 42 *Ibid*
- 43 On this aspect See Bhattacharjee Sudipta, Ambush marketing - The problem and the projected solutions *vis-a-vis* intellectual property law – A global perspective, *Journal of Intellectual Property Rights*, 8(5) 2003, 375 -378
- 44 *Supra* note 44
- 45 *Ibid*
- 46 <http://arbiter.wipo.int/domains/decisions/html/2003/d2003-0006.html>
- 47 *Ibid*
- 48 *Ibid*
- 49 *Ibid*
- 50 *Ibid*
- 51 <http://www.arb-forum.com/domains/decisions/114523.htm>
- 52 (2003) 26 PTC 245 (Del). where a suit was filed for an injunction against defendants using the slogans “ *Philips: Diwali Manao, World Cup Jao*” and “*Buy a Philips Audio System, Win a Ticket to the World Cup*”. ICC had already applied for the registration of words ‘*ICC Cricket World Cup South Africa 2003*’. The grounds raised were, *inter alia*, of passing off and ambush marketing. The Court rejected this on the grounds that the logo of ICC has not been misused and hence there is no scope amongst the purchasers of the defendants’ goods that there is any connection between the defendants and the official sponsors of the event
- 53 Ambush marketing, sometimes referred to as parasitic marketing, has been broadly defined as “the unauthorized association of a business or organization with the marketing of a particular event - gaining benefit for the marketing right or licensing fee applicable in order to be associated with an event, such as a sporting event. For further details, refer the author’s article ‘Ambush marketing - The problem and the projected solutions *vis-a-vis* intellectual property law – A global perspective’, at *supra* note 43
- 54 <http://www.ipwatchdog.com/coltsvbaltimore.htm>
- 55 *Supra* note 49
- 56 *Rock and Roll Hall of Fame and Museum v Gentile Productions*, 134 F.3d 749 (6th Cir. 1998)
- 57 *Supra* note 49
- 58 Dunlap David W, *Who owns N.Y. Skyline? Check the fine print*, *International Herald Trib* (Neuilly-sur-Seine, France), 1 Sept 1998, at 20. The art deco spire of the Chrysler Building may be found as federal trademark number 1126888, and the façade of the New York Stock Exchange may similarly be found as number 1761655. *Id*
- 59 Goldsmith Tara J, Comment, *What’s wrong with this picture? When the Latham Act clashes with artistic expression*, 7 *Fordham Intell. Prop. Media & Ent. L J*, 821, 831 n.49 (1997)
- 60 See, Spence Andrew T, When a landmark cannot serve as a trademark: Trademark protection for building designs in light of *Rock and Roll Hall of Fame and Museum, Inc v Gentile Productions*, *Journal of Law and Policy*, 2, 2000, 518
- 61 *Fotomat Corp v Photo Drive-Thru, Inc (Fotomat I)*, 425 F. Supp. 693 (D.N.J. 1977); *Fotomat Corp v Cochran (Fotomat II)*, 437 F. Supp. 1231 (D. Kan. 1977)
- 62 *Fotomat Corp v Cochran (Fotomat II)*, 437 F. Supp. 1231 (D. Kan. 1977). Both cases dealt with the building design of Fotomat’s photographic service business, which it had previously registered as a trademark with the United States Patent and Trademark Office
- 63 See, Magdo Christine, Protecting works of fashion from design piracy, <http://leda.law.harvard.edu/leda/data/36/MAGDO.html>. Fotomat’s distinctive yellow roof and kiosk design had been provided trade dress protection even though it functioned as shelter in addition to identifying the photo developer