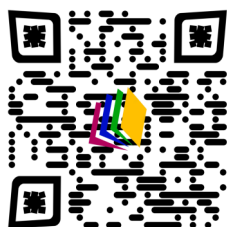




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## **Graphical Representation of ‘Smell’ and ‘Sound’ Mark - Critical Analysis**

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### **ABSTRACT:**

In recent years, a development has been seen in the arena of trademark apart from the regime of traditional trademarks the trade mark registries has seen an increase in the applications for sound, smell, color, tastes, Tarzan’s yell, textures, scent, shapes etc. It is these marks which are termed as non-traditional or non-conventional trademarks. Now a question comes, from where if at all such non-conventional trademarks are entering the domain of intellectual property? Reason behind this invasion lies in the broad and inclusive definition of trademark as it has been kept wide open for interpretation. On one side the trademark has registered in past only those subject matters which are conventional in nature or such mark which are capable of being represented graphically i.e. in visual manner and contains words, figures, signs, symbols etc. On the other side with the development of law relating to trademarks emphasis has shifted towards functional character rather than traditional ontological stand of sign. Anything and everything that is capable of communicating to the public at large the origin of goods and services and is possess distinctive feature, becomes capable of being registered as trademark. This paper evaluates the different position with respect to non-conventional trademarks and their graphical representation and how law has developed with time. In this paper particularly law relating to sound and smell has been dealt in detail. The aim of the paper is to analyze the requirement of graphical representation of Non-conventional trademarks. In this paper in particular ‘sound’ and ‘smell’ marks will be dealt more elaborately. The objective is to critically analyze the position prevailing in US, EU, Germany, Australia and India.

The scope of this paper is limited to the comparative study of ‘graphical representation’ requirement in US, EU, Germany and India with respect to ‘sound’ and ‘smell’. The questions sought to be answered by the paper Is Graphical Representation requirement a pre-requisite for granting trademark? Assuming that it is a pre-requisite then how sound and smell can be represented graphically? Whether requirement of distinctive character alone would ensure the trademark

protection?

**KEY WORDS:** Intellectual Property, Smell, Sound, Trademark, TRIP, Trade, Conventional Trademark

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### **Hypothesis**

Under Article 15 of TRIPS agreement the criteria on which a mark will be eligible for registration as a trademark has been kept open for wide interpretation. Depending upon TRIPS provision different countries have accordingly incorporated it in their national legislation. The traditional approach followed by countries like European Union, United Kingdom, India, USA, and Germany has been that ‘graphical representation’ of trademark is required in form of sign, symbol, numerals, combination of color, letters etc. But with passage of time there has been a shift from traditional or conventional trademark towards non-conventional trademarks and trademark has been granted for sounds, olfactory mark, gustatory mark etc. Seeing the change of position it is a matter of debate that how far such marks and in particular ‘sound’ and ‘smell mark have been able to fulfill the ‘graphical requirement’ and how far they have reached in different jurisdictions.

### **Non-Conventional Trademarks:**

#### **Graphical Representation Requirement**

The Madrid Agreement for the International Registration, 1891, Protocol relation to the Madrid Agreement concerning the International Registration of Marks 1989, The Trademark Law Treaty (TLT) 1994 Geneva, TRIPS Agreement 1994 (herein after called TRIPS), Paris Convention 1967, deals with Trademark. The Madrid Agreement or Madrid Protocol does not define “trademark”. However, TLT is the only international treaty which has excluded smell and sound marks from

being eligible for registration as a trademark.<sup>32</sup>

Section 2 of TRIPS deals with Trademarks and Article 15 provides provision relating to protectable subject matter. Under Article 15 of TRIPS the subject matter which is capable of getting trademark protection is not exhaustive and open ended. Any sign or combination of signs shall be capable of getting trademark protection if they are capable of distinguishing goods or services of one person from that of another.<sup>33</sup> Article 15 further provides few examples as to what signs qualify for trademark registration. The list is only indicative and not exhaustive and they have not mentioned about Graphical Representation criteria as a mandatory one for members and have left it upon members to decide. Further Article 6bis of Paris Convention lays down provision relating to marks. The Convention provides that registration shall not be denied except in the cases where firstly trademarks are devoid of any distinctive character or secondly if contains such signs which indicates intended purpose, quality, origin etc. of the goods.<sup>34</sup> Under Paris Convention also trademark has not been defined and there is no provision imposing condition on member countries or providing them with an option that Graphical Representation can be considered as a condition for granting Trademark protection. It allows member countries to decide what marks are registrable in their national legislation.

According to the Indian Trade Marks Act, 1999, trademark shall be capable of being represented graphically and it must be capable of distinguishing goods and services of one person from that of

others.<sup>35</sup> Given that in TRIPS discretion has been given to member countries with respect to condition relating to visual perceptibility, Indian legislation as specifically covered it under its provision as a prerequisite being considered as a trademark.

The United Kingdom through section 1 of Trade Marks Act 1994, also provides that a 'trade mark' is sign capable of being represented graphically and in turn is capable of distinguishing products or services of one undertaking from those of another. Therefore, the graphical representation criterion which is discretionary under TRIPS has been imbibed in the UK legislation as a mandatory one.<sup>36</sup>

In Germany section 3 of Part 2 of Act on the Protection of Trade Marks and other Signs, provides as to what will make a sign eligible for Trade Mark protection. Differing from other jurisdictions it specifically provides that all signs and in particular 3D- Designs, letters, sound\_marks, color and color combinations etc. can be protected criterion for protection being presence of distinctive character.<sup>37</sup> In Germany graphical representation requirement has not been included in their legislation specifically.

The American Lanham Act of 1946 provides an inclusive definition of trademark under 15 U.S.C. § 1127 comprising of any word, name symbol or device or any such combination used by a person to distinct and identify his goods from others. Under Lanham Act services have not been covered. The Trademark Association of US has further made it clear that terms like "device or symbol" shall not be construed narrowly and can include things like shape, sound, color, smell which will function as a mark.<sup>38</sup>

At the level of European Union, the definition under Council Regulation 40/94/EEC 1993 on the Community Trade Mark as to what will be considered as a Trademark is again wide open for interpretation. Article 4 lays down a very comprehensive and non-exhaustive definition but capable of being represented graphically is one condition for providing the protection. Similar provision is provided under Article 2 of the First Council Directive 89/104/EEC 1988.

### **What Do You Mean by Sign?**

The term "sign" used by international agreements, convention, and treaty has not been defined. Neither national legislature of different countries have defined as to what do you mean by signs such action seems to be a deliberate one. Though few examples as to what constitutes sign has been provided by different jurisdictions. This calls for dictionary meaning of word "sign", it turns out that it has a broad meaning attached to it which includes both visual as well as sensory medium to convey information or instructions.<sup>39</sup> Also there has been no notification or memorandum issued till date by any of the countries specifically excluding any sign from qualifying trademark protection. Therefore, theoretically combination of color or any sign representing taste, smell or sound are eligible for trademark protection if they possess distinctive character and are capable of being represented graphically.

### **Purpose of a Trademark**

The first and foremost objective of a trademark is to differentiate the goods and services of one producer from that of another. Aim is to let the ultimate consumer of such goods and services identify the source of its origin and guaranteeing that the origin is true and free from any confusion.

## **Sound and Smell as Subject Matter of Trademark**

As discussed above the objective is to identify the source of origin. Question arises if at all sound and smell can be registered as a trademark? On what parameters they will be judged. Starting from the “any” used in the definitions it is quite obvious that wide interpretations can be arrived at. How the word has been interpreted in different jurisdiction and what is the current position. In the absence of express provision relating to sound and smell, Germany is an exception in case of sound marks as they have included it in their legislation. Thus development can be traced through judicial pronouncements. Countries like EU, USA have granted taken literal meaning of the word “any” and protection has been granted to both sounds and smell. On the other side in India though protection to sound has been provided, smell as a trademark is yet to see the dawn.

### **“SMELL” And “SOUND” as a Trademark**

In the arena of growing capitalism and expanding horizons the thrust to market the goods and services with the help of mark has been growing tremendously. Use of mark to let the user identify the origin and clear the confusion has allowed more and more signs to invade into the subject matter of trademark. Today not merely traditional marks but also marks such as color, shapes, tastes, 3D- designs etc. are allowed protection as signs under trademark law. In the recent history the producers have tried and developed new variety of marks that can lure sensory organs of the users, for example smell and sound marks.<sup>40</sup>

### **“Smell Trade Marks”**

#### **Graphical Representation Requirement**

Historically trademark law has developed around traditional marks which were visually perceptible

e.g. words, devices etc. Still trademark protection was available to all kind of signs it's only that registration desk comprised of figures and words only. Given that in recent history a shift has been noticed from market-driven society towards a consumer-driven society. As a result of which non-conventional marks have been granted protection. Potentially smell marks have been available across the EU, U.K. and USA majorly for around past one decade. Law and jurisprudence available for smell mark is very little and still controversial. The first case relating to smell mark was recognized and protected by America long back in the year 1990 in *Re Celia Clarke*.<sup>41</sup> Till date only five more smell marks have succeeded in getting registration in USA. In EU first scent mark was recognized as CTM only after 9 years of *Re Clarke*<sup>42</sup> in 1999 where ECJ in the case of *Ralf Sieckmann v. Deutsches Patent und Markenamt*.<sup>43</sup> In many countries olfactory marks have got protection whereas in other countries application for odour mark was rejected or withdrawn. At present the stand remains unclear and controversial. In *Ralf Sieckmann*<sup>44</sup> application for odour mark was rejected as graphical representation criterion was missing. Main issue before GFPC was that can ‘balsamically fruity scent with a slight hint of cinnamon’ is eligible for registration as a trademark in respect of services. On reference to the ECJ, court decided that prima facie graphical representation is not sufficient for registering it as a trademark. Thus, mere chemical formula would not be able to depict odour of a substance also if sample of scent is deposited that would also not fulfill the requirement as chances are there that fragrance will faint with passage of time. Therefore, it must fulfill certain other requirements. Court laid down a seven-step test to determine whether a mark qualifies for protection or not when it is per se capable of graphical representation. Requirements are as

follows:

- Mark must be clear, self-contained, durable, precise, intelligible, easily accessible and objective so that exclusivity is clearly identifiable.
- Court further mentioned that no sign is excluded from trademark protection per se. However, in case of smell marks the graphical representation becomes difficult because:
- It cannot be depicted in form of drawing.
- It cannot be represented through chemical formula because only substance will be depicted not its odour.
- By deposit of physical sample as the same is not feasible because scent may fade or disappear with time and it cannot be said to be a graphical representation.

Therefore, ECJ through its decision in SIECKMANN makes it significantly clear that in case of smell marks clear and precise presentation is not possible graphically. Unless some new technology is invented that will make graphical presentation of smell mark possible, it seems difficult to get it registered even if it possessed distinctive character.

### **Position**

In US position relating to olfactory marks is different. The US court allowed its first trademark protection to a smell mark in 1990 in the case of *Re Clarke*,<sup>45</sup> where the description ‘a high impact, fresh floral fragrance reminiscent of Plumeria blossoms’ was granted protection for its use for sewing thread and embroidery yarn as it fulfilled criteria of non-functionality and possessed distinctive character. In US position relating to non-conventional trademarks is different; one need not

submit a drawing representing the mark. Applicants are required to submit only clear and detailed description in writing if mark is a non-visual one.

In UK though Trade Mark Act, 1994 has incorporated same definition as provided under Article 2 of the 89/104/EEC Directive<sup>46</sup> under section 1(1) and CTMR EC/40/94 has also defined it in same words under Article 4. Such open ended definition allowed for wide interpretation and called for registration of sensory marks.<sup>47</sup> The government also through its White Paper recommended that no legislation shall “either exclude or make specific provision for the registration as trademarks of sounds, colours or smells.”<sup>48</sup> Question arises as to the validity of registrations granted to smell marks in UK prior to the decision of *Ralf Sieckmann*.<sup>49</sup> Though cases exist in Europe in countries like UK, OHIM, Benelux etc. Where protection has been granted to smell marks, but the position at present remains the seven-step test laid down in *Ralf Sieckmann* case.<sup>50</sup>

In India Trade Mark Registry has simply imported *Sieckmann* Test. Holding the view that even though scent marks are eligible for registration yet after the decision in *Sieckmann* case the fulfilment of graphical representation criteria has become more difficult.<sup>51</sup> In India till date no registration has been granted for an olfactory mark. What is worth noting is that the Registry in spite of holding the view that smell marks are registrable, has failed to lay down any alternative for graphical representation requirement.

### **Cases Relating to Smell Mark**

Cases relating to smell mark before landmark judgment of *Sieckmann* on 12<sup>th</sup> December 2002:

- ♦ *Chanel Case*

- ♦ Sumitomo Rubber Co. Case<sup>52</sup>
- ♦ Unicorn Products Case<sup>53</sup>
- ♦ Vennootschap onder Case<sup>54</sup>
- ♦ John Lewis of Hungerford plc. Case

1. In case of Chanel (well-known perfume manufacturer) wanted to register 'Chanel No 5' as a smell mark back in 1994 for its perfume. An application was filed with written description regarding the fragrance. The application was rejected as the description was relating to the product itself and was describing about the product and non-functional aspect was missing. Apart from that shape of the perfume was same as to the nature of good.

2. In Sumitomo's case second application was made by the plaintiff for registering "a floral fragrance reminiscent of roses as applied to tyres." The registration was granted and it gained popularity as first olfactory trademark in UK' history.

3. The case of Unicorn Product was another success in UK in getting a smell mark registered. Application was made under class 28 for registration of 'the strong smell of bitter beer applied to flights for darts', which was successfully registered by Register Office.

4. The case of Vennootschap's called for a controversy in relation to registration of smell as a trademark. Application was made for registering "smell of freshly cut grass" for tennis balls and the same got rejected at an initial stage for the lack of graphical representation as description was not considered to be visual representation by the examiner under Article 4 of CTMR.

However on appeal to SBA of OHIM, question for discussion was whether third party would get a

clear and precise idea about the product for which protection is being claimed or not. Argument was that CTMR does not disqualify smell marks from registration. Finally in 1999 the board cancelled the view taken at first instance and sent it back to the examiner. Board was of the view that fragrance of 'freshly cut grass' is distinctive in nature and reminds one of pleasant experiences, spring, and playing fields. Board further held that graphical representation requirement under Article 4 of CTMR was satisfied from the description provided by the applicant for tennis balls.

This ruling created a havoc arena of graphical representation alleging that CTMR board misinterpreted the meaning of graphical representation. The perception of smell by an individual is a subjective matter and thus will be construed differently by different person. Therefore, main issue of disagreement was written description smell being subjective was not sufficient to satisfy objective requirement under Article 4 of CTMR, Article 2 of the Directive, Article 8(1) of German MarkenG or Section 1(1) of Trade Mark Act, 1994. Also, language problem also arises as usually people do not describe about smell but about the object from which smell is coming. Reason being that object can be described accurately but due to lack of independent nomenclature case id different for smells.

Even though SBA of OHIM has allowed the appeal, this decision is much criticised one and hence not accepted in literature. Holding the view that smell is subjective in nature and therefore cannot be described in words to satisfy the criteria of graphical representation.

5. Case of John Lewis is a more recent one from 2000, where firm applied under class 20 for

registration of 'smell, aroma or essence of cinnamon' for furniture and fittings. The application was rejected and J. A. James while dismissing the application expressed that "he chose not to follow the decision given by SBA in *Vennootschap* (supra).

6. He also held that smell of cinnamon in any circumstances was not easily recognisable and distinctive as that of freshly cut grass and thus its perception will vary from one person to another widely. This leads us to conclusion that in recent past courts have hesitated from granting trademark protection to a smell mark, where such mark is described in written words.

### **Distinctive Character**

Apart from the requirement of graphical representation, which is creating controversy, the mark must fulfil the 'distinctive in nature' requirement. And must be able to identify the source of origin of the product, the distinctiveness must not be the outcome of nature of product itself as it will create confusion in the mind of consumer. On this basis application was rejected in *Chanel* case (supra).

### **Conclusion**

Seeing the past trend of decisions given by various courts we can conclude that till date only few smell marks have been able to get successful registration of their olfactory trade mark. And in order to qualify registration firstly a feature should constitute a 'sign'<sup>55</sup> and the definition of sign is very wide and open. Secondly it must be distinctive in nature. Thirdly it shall be capable of being represented graphically and has to pass the test laid down in *Sieckmann* case. The after effect of *Sieckman* case has made it almost impossible for getting a smell mark registered because there was

no globally recognised classification to test the requirement of smell mark, the *Sieckmann* test is followed internationally. The 'graphical representation' requirement under different jurisdictions is creating an issue and thus making registration of smell marks under Trade Mark regime a difficult task.<sup>56</sup>

### **"Sound Trade Marks"**

Another non-conventional mark facing graphical representation difficulty getting trademark protection is Sound. The usual method of visually representing a sound mark is musical notations or written description. But difficulty arises because every common man is not capable of understanding written music. However, sound is considered to have major role is recognition of trademark. And with the inception of electronic media ads sound has been a constant factor in all the ads and it goes beyond languages.<sup>57</sup> Some frequently used sounds in advertisements are jingles, animal roar etc which indeed helps a consumer in identifying the products and services as they do remember the music from echoic memory. In the words of Kahn, "sound can immediately convey source-indicating qualities."<sup>58</sup> Sound happens to be the most influential medium that affects human emotions, and thus turns out to be more beneficial to the producers.

Sound mark per se has got recognition in countries like UK, USA, India and Canada. Courts also took conservative view at many instances. In *Playboy Enterprises Inc v Germain*<sup>59</sup> Justice Pinard was of the view that use of vocal description is not considered to be a trademark under Trade Mark Act. A mark must be visually perceptible to get protection under Trade Mark Law.<sup>60</sup> Further, graphical representation of sounds is possible through musical notes, yet different jurisdictions follow it differently in cases of sounds mark which

is creating an issue.

### Cases relating to Sound mark

- ◇ Shield Mark BV v. Kist<sup>61</sup>
- ◇ Oliveira v. Frito Lay<sup>62</sup>
- ◇ Kawasaki Motors Corp USA v. Harley-Davidson Michigan Inc<sup>63</sup>

1. The Shield Mark case is considered to be the most relevant decision given by ECJ whereby court discussed as to whether trademark protection can be conferred upon sounds and if yes, according to the provision of Article 2, can they be graphically represented. Court held that for a sign to get trademark protection it must possess two features – 1) capable of being represented graphically and 2) must be distinctive in nature. For sounds ECJ was of the view that it can be represented graphically. Court reiterated the stand taken in Sieckmann case (Supra) and held that sign must be clear, precise and self-contained so that consumer gets an idea as to what is the trademark of the producer. Court came to the conclusion that graphical requirement criteria is not met if sound is described using written words like sign consisting of musical notes, cry on an animal, simple onomatopoeia or sequenced musical notes because it lacked precision and clarity. However ECJ held that Sieckmann test is passed if “a stave divided into bars and showing a clef, musical notes and the rest showing the relative value and where necessary, accidentals’ such representation was intelligible, durable and easily accessible apart from being clear and precise.

2. In case of Oliveira (supra) court held that musical works are eligible for trademark protection and protection cannot be declined merely because it was granted Copyright protection. In the present the plaintiff applied for registration of sound of a

bell tolling for its radio services but his claim was rejected because it had not acquired distinctiveness.<sup>64</sup>

3. In Kawasaki Motor case in this case, the contention of the plaintiff was that Harley-Davidson’s registration for sound of exhaust made by their motorbikes was not maintainable on the basis of doctrine of functionality. The sound over which the defendants got protection was common to all the motorbikes of V-twin engines irrespective of their company. Meanwhile the decision in the instant case was pending Harley-Davidson abandoned their application.

### Conclusion

Although in Sieckmann case registration for smell mark was sought, however the decision pronounced by the ECJ in form of ‘Sieckmann Test’ is uniformly applied to all the non-conventional trademarks. Therefore it can be concluded that in European Countries the decision in Shield Mark case has paved way for the protection of sound as a trademark given that they pass the test of distinctiveness and Sieckmann test for graphical representation requirement.

In US the courts have not hesitated from granting trademark protection if sound fulfilled conventional mark requirement. Sound marks in US are in vogue, Nokia Ringtone, comprising of classical guitar tune got registration in US. In fact unlike EU, US courts have also accepted representations by way of sound recordings and sonograms.<sup>65</sup> Metro-Goldwyn-Mayer (MGM) got its lion roar protected in US back in 1986 for films and as a CTM in 2008; the sound was represented by way of sonogram only. They also got their registration in Canada, paving way for sound marks in Canada.



India courts have simply imported decision of ECJ in Shield Mark case in very few instances registration was granted, first being Yahoo!'s yodel which was represented through musical notes, it was the first non-conventional mark to get trademark protection.<sup>66</sup> Under Indian legislation the latest sound mark protection is held by Allianz Aktiengesellschaft a German company.

Apart from Shield Marks solution many other different ways of dealing with graphical representation requirement have been developed.<sup>67</sup> Various other forms of representations can be sonogram, oscillogram, spectrogram and spectrum. Again question arises as how far it will be accessible and intelligible to public at large and will not turn to be too technical to understand.<sup>68</sup> However till date there has been no discussion on sonogram or oscillogram by the ECJ as a medium for graphical representation.

However OHIM has took a liberal view since 2005 and has tried to solve the issue of graphical representation requirement for sound to a great extent.<sup>69</sup> OHIM allows graphical representations by way of sonogram or oscillogram, if they are clear along with the sound file (size –up to 1mb), in online applications sound file or digital file of sound itself can be attached. Thus, accepting such alternative methods as a valid one.

However, the Shield Mark decision is not easy to follow, being too technical in nature. Alternative solutions can be looked into for easing the path for getting a sound mark protected, for example sound mark can be stored in an electronic form in the Registry office, which would be open for access by one and all. Also, applicant should be required to

deposit description of sound mark in form of musical notes which will help in resolving any issue by the expert who can read and understand musical notations.

From the above discussion in relation to different jurisdictions it can be said that the predilection in countries like USA, EU, UK the use of word “any” in the definition has been considered in its literal terms and therefore signs which are non-perceptible for example sound or smell have been covered under the protection of trademark law of different countries.