

ROLE OF GRAPHICAL REPRESENTATION IN TM REGIME IN INDIA

Written by Shilpi Chatterjee

4th Year BA LLB Student, KIIT School of Law, KIIT University, Bhubaneswar

ABSTRACT

Recent years have witnessed a dynamic evolution in the jurisprudence of trademark (“TM”) protection laws on account of unprecedented technological progression which allowed producers across the globe to participate in “extreme branding” aimed at making the public at large recognize their product with the help of sound, packaging shape, colour and smell, among others aids. Such other aids, that are not restricted to two dimensional representations, constitute unconventional trademarks. Trademark laws, which earlier only took cognizance of words, symbols, letters, devices and colour combinations, now give similar treatment to unconventional TMs. The present note advocates the emergent need for amendment in the Trade Mark laws in India on the lines of the European Union (“EU”) laws as against the system prevalent in the United States of America (“US”)

INTRODUCTION

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

A TM is nothing a sign or a mark serving some purpose for its owner . As the word mark is defined under sec 2(1) (m) of TM act of 1999 as:-

" mark" includes a device, brand , heading , label ticket, name, signature, word, letter, numerical, 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 the shape of goods, packaging or combination of colours were not there in the definition of "Mark" in the previous act¹ and are often known as non conventional trademark. Other kind of TM they have come up with the advent of new technologies, marketing and techniques and aggressive advertising strategy includes sound mark , taste mark, smell mark, motion marks , hologram marks , colour marks,²

¹ GROWTH OF NON CONVENTIONAL TRADEMARK

The efficacy of any TM would depend on its ability to create an impact on the mind of the potential customers of that product. If a 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 lead to the number of non- orthodox trademarks by the manufacturers. Besides the advent of internet and electronic commerce has also increased the range of signs that business would like to use as registered TM . For example sound and motion marks would capture the attention of internet users much more efficiently than traditional marks , which in turn have captured their popularity in today's commercial world³.

¹ Section 2(1)(j) of Trade and MERCHANDISE MARKS ACT OF 1958 INCLUDESS "Mark" as ticket , label, name ,signature word, letter or numeral or combination thereof.

² For the classification of Non traditional trade mark, *see* The basis of non traditional trademarks http://www.insta.org/info/basis_nontrd.html (Nov 10 2005)., visited at 12.45 pm on 10 may,2017.

PROBLEMS OF NON CONVENTIONAL TM

TM is defined under sec 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 represented graphically. The definition lays down two broad criteria that the mark has to satisfy in order to become a TM and therefore non- conventional TM can very well fit into the ambit of TM if they satisfy the criteria of distinctiveness and graphically represent ability

However there are other problems also which makes the non conventional TM registration difficult. The first problem is the **distinctiveness** though certain non - conventional TM can be identified like shape and colours by its consumers for others like smell and taste marks, perception of marks may vary, giving rise to confusion among consumers. But this is only a practical difficulty, and a not legal impediment to obtain registration as a mark can acquire distinctiveness through use and thereby qualify to be a TM, even though it may not be inherently distinctive.⁴

The second problem is **graphically representability** of non - conventional TM in case of odour and sound marks.

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³ http://www.wipo.org/sme/en/documents/wipo_magazine/7_2 (10 November 2005), visited on 5.5.2017 at 11pm

⁴Section 9 of the act says that lack of distinctiveness will be an absolute ground for refusal of TM registration but the requirement of distinctiveness so for obtaining registration will be done away with if the mark has acquired distinctiveness through use and in that case it can be registered as TM

⁵The law in UK is quite similar in this regard. As per sec 1 of TM act,1994 , a TM is a 'sign capable of being represented graphically'

⁶KC KAILASAM & RAMU VEDARAMAN , *LAW OF TM & GEOGRAPHICAL INDICATIONS* p.132 (2nd edition ,Wadhwa & company, Nagpur), 2005

⁷KITCHIN DAVID, LLEWELYN DAVID , *KERLY'S Law of TM & Trade Names*, p.10 (13thedition, Sweet & Maxwell, London), 2001

GRAPHICAL REPRESENTABILITY: GENERAL OVERVIEW

In order to be subject of valid application for registration, the sign must be represented graphically⁵ as required by the section 2(1) (zb) of the act. The words 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 a journal⁶. The graphical representation provides a fixed point of reference showing what mark is.⁷

In *Swizzels Matlow Ltd's Application*⁸ the court explained two chief reasons for the requirement of graphical representation:-

- a) Enable the traders to identify with clarity, what other traders have applied for registration as a TM, and for which product.
- b) To enable the public to determine, with precision, the sign which forms the TM registration.

Graphical Representability is not an objective criterion because the degree of precision, which will render it identifiable, is not spelt anywhere. For example clear and unambiguous representation of a TM provides an evidentiary benefit for maintaining a case for TM infringement under sec 29 of the act⁹. Therefore the scheme of rights and liabilities established under can be effectively realized only if the graphical representation discloses the identity of the sign it purports, to represent, unmistakably¹⁰. UK has stated certain guidelines where a mark is graphically represented upon satisfaction of three broad criteria :-

- a) From the graphical representation itself, it is possible to ascertain the mark without the need for any supporting examples
- ³b) The geographical representation can stand in place of mark itself.

⁸*Swizzels Matlow Ltd's Application*, (2000) ETMR 58

⁹Sec 29 of the act requires the mark allegedly infringing an earlier TM to be deceptively similar or identical with the latter

¹⁰UK TM Registry Work Manual, August 1998 edition, p.18, reinforced by Practice Amendment Circular cited in ref.8

c) The person inspecting the TM register or reading the TM journal can be reasonably expected to understand the nature of a TM from its graphical representation. Any colour standard or musical notation put before to represent marks must be precise and:

- Reasonably practical for users to be able to obtain a clear understanding of the mark
- be able to accurately compare the sign the applicant uses or proposes to use with the other similar sign

The stated guidelines though not applicable in Indian context. In Indian context the term has to be liberally interpreted not only to accommodate non-conventional TM but also keeping in mind the legislative intent in laying down the wider test of geographical representability instead of 'visual perceptibility' used in TRIPS¹¹. Further the act lays down the ingredient of graphical representability in the Rule 2(1)(k) of the TM rules, 2002 defines as the graphical representation as a representation in a **paper form**. This makes it clear that whatever representation of TM is done it has to be done on paper.

GRAPHICAL REPRESENTATION OF A NON-CONVENTIONAL TM

Graphical representation of TM is more of a practical than a legal one. Coupled with distinctiveness, it may pose as a serious problem in a way of registering non-conventional TM. This is particularly true in case of odour, sound and colour marks.

Odour Mark

This is a very uncommon and controversial TM that has gained a lot of attention in recent times. In spite of the problems in registering odours as TM, few odours have already been registered as TM¹² whereas several other applications for registration of odour have been withdrawn¹³ or rejected at TM registries of different countries.

One such illustrative case in which registration of smell mark was rejected on the basis of non-fulfilment of graphical representability criterion, among other factors, is that of *Ralf Sieckmann v German Patent Office*¹⁴. The chief issue of this case was whether an olfactory mark described as a "balsamically fruity smell with a hint of cinnamon" could be registered as a TM in respect of certain services.

On reference being made to the ECJ that graphical representation per se is not enough for registration and must meet the following criteria:-⁴

- It must be clear, complete and precise
- It must be intelligible to those persons having an interest in inspecting the register i.e. other manufacturers and consumers.

Having laid down this criteria the court observed various difficulties in graphically representing the 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 as same substance would produce different smells at different temperatures.
- 4) Deposit of sample of substance with the registry was not feasible since it was not graphical representation, secondly odour being volatile and may fade and even disappear over a period of time.

⁵ The situation is different **In U.S**, where the TM manual of examining procedures states that the TM applicant need not submit a drawing of the mark if the mark consists solely of a non-

¹¹Article 15 of TRIPS, 1994 lays down that, 'Members may require, as a condition of registration, that signs be visually perceptible'.

¹²In UK, a registration has been made by Sumitomo Rubber Industries Ltd for a TM described as a floral/fragrance/ smell reminiscent of roses as applied to tyres .

¹³The odour of perfume was sought to be registered in UK, but withdrawn due to technical difficulties in describing the odour. Initially it was described as : scent of aldehydic floral fragrance product . This scent is also known by a written brand name. This inadequacy in description may provide as a clue as to why odour marks are hard to be registered as a TM.

¹⁴ *Sieckmann v German Patent and Trademark Office* (case C-273/00) before ECJ , December 12, 2002

¹⁵ http://www.uspto.gov/web/offices/tac/tmep/0800.htm#_Toc1, visited on 25.3.2016 at 11pm

¹⁶ *In Re Celia Clarke* ,USPQD 2d 1238 (1990) (TTAB).

¹⁷ Barbara Berg , The scent of surprise , <http://www.fredhutch.org/en.html./article> (10 March 2006), visited on 25.3.2016 at 11pm

visual mark such as scent or sound¹⁵ Instead that the applicants are required to submit a detailed written description which clearly describes the non-visual mark. The first case where registration of smell mark was allowed in US was *In Re Cilia Clarke*¹⁶ though this case did not deal directly with the graphical representation. The applicant for a TM protection for a scent with a 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 applied 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 vast array of scents in identifying competing sources of goods.

Recently, Nobel 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 odourant molecules activates several odourant receptors leading to formation of an odourant pattern¹⁷. This may solve the problem of graphical representability of smell mark to the extent of possibility of representation of such marks, but the other problems highlighted in the *Sieckmann's case* namely accuracy of such representation and feasibility of depositing samples with registry remains unsolved. Though no concrete solution is offered as off now.

Sound Mark

This is another type of non conventional TM faced with the problem of graphical representability. The normal way of graphical representation of sound mark is use of musical notations and written descriptions. 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 a gives a description of the music but not the music itself. An apparent solution will be to deposit a digital recording of the sound with the registrar instead of graphical representation But this has been rejected by the INTA as firstly sound cannot be published by the TM registry and people have to go to the registry to hear it and secondly it will be difficult for the registry to store so many sound sample.

Sound can be validly registered as TM in UK, US and Canada. Certain orthodox stances were taken by the judiciary, registration of sound mark have become commonplace in recent times¹⁸.

Further, though sounds can be graphically represented with the aid of musical notes, the acceptance of different forms of graphical representation of sound mark by different TM registries is an issue in hand.

In the case of *Shield Mark BV v Joost Kist h.o.d.n Memex*¹⁹ the ECJ observed that the 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 sign consists of a notes going to make up a musical work
- An indication that is a cry of an animal.
- By means of simple onomatopoeia.
- By means of 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'.

⁶In case of UK Thus, granting protection to untraditional trademarks has been significantly easy in the where TMs have been defined broadly and there exists no prerequisite of a "graphical representation." In other words, marks which consist only of a sound, a scent, or other completely non-visual matter, which would only require a detailed verbal description, are equally capable of protection under the US laws. Perhaps the oldest untraditional mark to be registered is the National Broadcasting Company (NBC) jingle which received protection in the US in 1970 under the category of Sensory Marks. The jingle, with a vague description of notes used, was not accompanied with a notation sheet. Sound Marks thus pioneered the evolution of trademarks to include sensory and other unconventional marks that satisfied the criteria of (a) acquired secondary meaning, (b) Functionality Test, and (c) likelihood of confusion in the absence of protection; apart from other procedural requisites.

Secondary meaning or acquired distinctiveness is a must for registration of any mark. In *Inwood Laboratories, Inc. v. Ives Laboratories, Inc*²⁰ it was observed that "to establish secondary meaning, a manufacturer must show that, in the minds of the public, the primary

¹⁸Like the Lion roar for MGM 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 sixteen notes'

¹⁹ Case no C- 283/01 before the ECJ, lexisweb.co.uk/cases/2003/November/shield-mark-bv-v-joost

significance of a product feature or term is to identify the source of the product rather than the product itself". The acquired distinctiveness of a mark which is often termed as its factual distinctiveness differs from inherent distinctiveness in the sense that while inherently distinctive marks are distinctive from the very inception, a mark will be considered to have acquired distinctiveness if it can be shown that irrespective of its primary meaning the mark now conveys to the consumers information as to the "badge of origin" of the product .

Therefore in order to prove that the concerned mark has acquired distinctiveness it has to be shown that the mark, which was initially lacking distinctiveness, has assumed a new meaning in the mind of the purchasing public which has displaced the primarily non distinctive meaning of the mark. The Supreme Court of the United States in another judgment noted the difference between designs and words, i.e., marks falling in the category of traditional trademarks, and sounds and smells, in that the latter category of marks would be virtually incapable of being inherently distinct . The standard for distinctiveness is therefore higher vis-à-vis untraditional trademarks as these take more time and use to be established. Further, some of the marks, such as a sound mark, that is of shorter duration and comprises of a few notes or a very familiar tune, may not warrant registration unless it may be proved to have acquired such distinctiveness of higher standard .

⁷**The Functionality Test** envisages the refusal to grant TM protection when the feature is essential to the genre of goods to which it is being applied, or when grant of such protection makes the production cost-prohibitive examples of which have been discussed above. The criteria though not easily met, leaves much scope for speculation in the absence of mandatory representation.

Sound mark has also acquired in Indian TM and the solution given by ECJ was technical and the practical alternative would be storage of sound mark in a computerized TM registry which could be accessed easily. Along with this written description it should have musical notes deposited with the registry.

Colour Trademark

²⁰ *Inwood Laboratories v. Ives Laboratories*, 456 U.S. 844 (1982)

Colours can be used as TM in two forms - as single colour and as combination of colour. The latter has been expressly included as a form of mark that can be used as a TM in several other legislations²¹. This inclusion resolve earlier confusion as to combination of colour could be a mark at all, and whether it could be distinctive enough to be registered as TM, both of these were answered in the affirmative by the House of Lords in *Smith Kline And French Laboratories Ltd v Sterling Winthrop Group*²². But to examine the issue of graphical representation of non - conventional TM, it would be important to look into the decision of the ECJ in *Libertel Groep BV v Benelux TM office*²³. In this case the issue was whether the mark consisting of single colour 'orange' could be registered as a TM. ECJ reiterated the criteria of graphical representation and held that such representation must be clear, precise, self-contained, easily accessible, intelligible durable and objective as stated in *Ralf Sieckmann Case*.

⁸In this case query, related to a sample of colour on a flat surface, a description in words of the colour and intentionally 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's not durable and will lose its original shade with the passage of time. However, designation of 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. From the above, it is amply clear that registration of untraditional marks in EU is indeed difficult in the face of the strict legislation 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 codes²⁴. Therefore to solve this graphical representability issue, India may follow the Pantone or any internationally recognized colour

²¹ The definition of Mark un sec 2 (1) (m) and TM in sec 2(1) (zb) of the TM act of 1999 expressly includes 'combination of colour' as a mark that can be registered as TM.

²² (1975) 2 All ER 578. In this case unique combination of colours applied on drugs capsules were held to be marks. Further, the court ruled that the said colour combinations were distinctive because they were adapted...to distinguish SKF's goods from other manufactures'. Moreover, the colour combination of the capsules has acquired distinctiveness through use and were registerable as TM

²³ <http://lexisweb.co.uk/cases/2003/may/libertel-groep-bv-v-benelux-merkenbureau-case%C2%A0c-104/01> visited on 5.5.2017 at 11pm.

identification code, keeping in view other objectives like those of preventing colour depletion and anti- competition.

A COMPARISON IN THE LIGHT OF INDIAN REGIME

The 1999 Act defines trademarks in the following terms: “trade mark means a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others and may include shape of goods, their packaging and combination of colours.” The 2002 Rules define graphical representation to mean the representation of a trade mark for goods or services in paper form. Thus, it can safely be asserted that graphical representation is a *sine qua non* for TM Registration in India. Another important criterion to be satisfied is distinctiveness. The proviso to section 9 (1) of the Trade Marks Act, 1999, recognizing this concept of “acquired distinctiveness” *inter alia* provides that “a trade mark shall not be refused registration if before the date of application for registration it has acquired a distinctive character as a result of the use made of it”. Similarly, Section 32 of the Act states that a mark which is wrongly registered (because it lacks inherent distinctiveness) shall not be declared invalid if the mark has acquired distinctiveness after registration and before commencement of any legal proceedings.⁹ It is pertinent to note that with some of the TM Registries in India, amongst the various unconventional TMs, sound marks have found most favour. For instance, the Yahoo “yodel” and the sound mark for Allianz **Aktiengesellschaft** have been registered in India in the last two years. Though there has not been a determination on whether sonograms would qualify as graphical representation envisaged under the 1999 Act, the arguments that expert opinion is required for both forms of representation subsists, thus validating the use of sonograms. It has been reported that Yahoo had in fact submitted a notational reproduction of the sound along with its digital copy, which practice if adopted would constitute a constructive step towards effective TM protection, provided the same are made available on the TM Registry websites to give constructive notice to the public. The 2002 Rules also emphasize on the need for graphical representation. The 2002 Rules provide for registration of 3D marks by means of graphical representation of a maximum of eight views and a specimen, but is silent on other untraditional TMs. The Revised Trade Mark Manual (here-in-after ‘the Manual’) has welcomed the progress

²⁴ The United Parcel Service holds a registration for the colour chocolate brown, which is equivalent of the Pantone colour designated by the code ' PANTONE 462 C'.

in the development of unconventional trademarks making distinctiveness a prerequisite for registration. Taking a balanced view, it has clarified that while untraditional marks such as colour and sound constitute categories capable of trademarks registration, registration may be granted only in cases where the use of the mark is exceptional and has acquired secondary meaning.

The Indian system has definitely garnered a lot from the experiences of the European Union and the United States, and while its decision to not grant trademark-ability status to olfactory and gustatory marks is based on practical impediments of today, the same may be subject to change, considering the growing commercial and advertising trends coupled with the leaps that technology is taking.

CONCLUSION

Tweaking of the laws shall be necessary in case untraditional TMs are to be granted effective protection. Reasons for this are more in developing countries, including India. Firstly, each variety of unconventional trademarks may be accurately represented through different mediums. Verbal description may not adequate. Granting registration to sound marks in the bold manner adopted in the United States, creates significant fear of trespass upon the rights of the proprietor and simultaneously ambiguity with respect to the scope of commons leading to disputes both at the level of registration and use. Description as used in the NBC jingle in the United States would make it extremely difficult for other sound marks with similar notes to be registered, and also would not bar the registration of the same melody in another scale.

Further, Smell marks are also not adequately represented through verbal description. An application for registration of a particular odour, such as vanilla, would be best accompanied with a representation in the form of samples, but these too would be hard to make available in trademark registries all over the world. Also an electronic nose for determining smells and the PMS may help in registration of colours, but it is a long way before such technology is made are readily available with trademark attorneys who could make the applicants aware. Doubtless, it would take even longer for such technology to be available with small and medium sized enterprises , especially in developing countries such as India.