

Protection of Non-Traditional Trademarks under Sri Lankan Law: A Critical Perspective

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In the past few years, there has been some debate as to whether non-traditional trademarks (including sound, touch, taste and feel marks) should find protection under the intellectual property laws of Sri Lanka. The original drafters of Sri Lanka's IP legislation omitted this category of marks from the scope of registrable trademarks for extremely valid reasons, such as the dearth of local innovation in the area and the cumbersome nature of the examination and protection process. This paper hopes to revisit some of these arguments in light of modern developments and consider whether non-traditional trademarks should be admitted to the category of marks receiving protection under the Sri Lankan law. The paper will adopt a doctrinal approach with some elements of sociolegal inquiry in order to ascertain the views of experts in the field. It will first define non-traditional trademarks and analyse both the Sri Lankan and global rules governing trademarks, including approaches of jurisdictions that allow non-traditional trademarks to be registered. It will then consider the economic, social and cultural reasons for both allowing and denying the registration of non-traditional trademarks in Sri Lanka, with reference to both researches already done and empirical research conducted specifically for the purpose of this paper. Finally, the paper offers some projections for the future of non-traditional trademarks in Sri Lanka.

I. Introduction

Non-traditional NTTMs (or non-conventional) trademarks have been at the forefront of debate for the past two to three decades, having received attention from both academia¹ and the judiciary.² As the availability of traditional (or conventional) trademarks dwindles due to the high levels of competition that arise due to the increasing sophistication of markets and consumers, manufacturers turn more frequently to the hitherto uncharted territory that is the non-traditional trademark arena, hoping that it will give their product or service the exclusivity that is required for brand promotion.

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¹ Irene Calboli and Martin Senftleben (Eds), *The Protection of Non-Traditional Trademarks: Critical Perspectives*, (OUP 2018).

² Case C-273/00 *Ralf Sieckmann v Deutsches Patent- und Markenamt* [2002] ECR I-11737

While certain types of NTTMs have already received protection in the trademark offices of certain countries, a few have posed problems even in jurisdictions where trademark protection is relatively sophisticated. (For example, in the Sieckmann case, which is discussed later in this paper, the European Court of Justice refused smell marks on the ground that there was no graphic representation).

What is perhaps important to remember is that the subject matter of what we may define today as a NTTM is also dynamic and subject to change. In the future these may be converted to traditional trademarks.

In analysing the area of NTTMs, we find a great deal of flexibility granted to individual states by the various international instruments that govern trademarks. Therefore it is useful to inquire into the practices of these states and entities in finding out how NTTMs are defined, what types of marks are excluded and from an administrative viewpoint, what types of resources are required to examine and grant protection to NTTMs.

II. Non-traditional Trademarks: Definition and Scope of Application

There is no explicit category of trademarks that are defined as non-traditional trademarks. Trademarks are defined by certain parameters, and the scope of these can be as wide as to admit certain types of trademarks, or narrow as to deny these, protection as valid marks under a particular legal system.

An NTTM is generally taken to mean any “new” type of trademark which does not belong to a pre-existing, conventional category of trademark. While it may prove difficult to obtain registration for, it may nevertheless fulfil the essential trademark function, which is as a distinct identifier of goods and services. The term is broadly inclusive of marks based on appearance, shape, sound, smell, taste and texture.³

The most basic difference between the traditional trademark and a NTTM is perhaps the requirement of visibility. All traditional trademarks are capable of being visible signs, and in some jurisdictions (including Sri Lanka) the requirement of visibility is retained. However, all visible signs are not completely basic and may themselves also pose certain challenges in registration. For example, three dimensional marks, position marks and

³ Mohammed Ali, ‘A Look at Non- Conventional Trademarks’ (February 2015) <<https://www.tamimi.com/law-update-articles/a-look-at-non-conventional-trademarks/>> accessed 28 September 2022.

holograms are also included as visible signs.⁴ The main requirement for registration for three dimensional marks is that of distinctive character and the capability to distinguish. Regarding position marks or moving marks, WIPO's stance is that the graphical representation of a mark that shows a numbered sequence of pictures, which is sufficiently unambiguous, may be acceptable as a trademark. The representation of the mark can contain several pictures, which show how the mark "moves", but it is noted that there is not yet a consensus on how many pictures shall or may be contained in the graphical representation of the mark. Holograms are also accepted as visible signs, and can be registered by taking a photocopy of the hologram, which shows the hologram in its entirety.⁵

Colour marks are another category of marks that are definitely visible but have posed problems for the trademark system due to the concerns relating to monopolies, since the actual range of colours available is limited, but may be expanded slightly due to the development of technology that will allow us have various shades of the same colour. What is important is whether the colours are used in such a way that they function as a trademark of the applicant, which usually presupposes several colours being used, that the colours are used in an unusual fashion in relation to the goods, and that the colours are not perceived as mere ornamentation. While unambiguous and distinctiveness are at the top of the list of considerations, the other consideration of whether a registration in any way unduly limits the availability of colours for other traders which offer similar goods or services as the ones stated in the application is also relevant. It is noted therefore that colour marks will only have distinctive character in exceptional cases. However, colour marks may acquire distinctive character through use and thus become registrable. Some of these concepts have been discussed in detail in the *Libertel* case.⁶

Non-visible signs pose an entirely different set of challenges. Since visibility of the sign is not possible to establish, the sign may be acceptable if it displays distinctive character and is capable of graphical representation. However, graphical representation is also something that should be perceivable by sight, and to this extent non-visible marks such as sound, smell, taste and touch marks do pose challenges.

⁴ WIPO, 'Visible Signs' <https://www.wipo.int/export/sites/www/sct/en/comments/pdf/sct17/dk_1.pdf> accessed 27 September 2022.

⁵ *ibid.*

⁶ Case C-104/01 *Libertel Groep BV and Benelux-Merkenbureau* [2003] ECR I-03793

Of the list given above, sound marks at least can be represented in a manner where the graphical representation is visible. The European Court of Justice has affirmed this in the judgement in *Shield Mark and Joost Kist, Für Elise*⁷, which dealt with the registrability of a sound mark, elaborating that the requirements of graphical representation require that it be clear, exact, independent, easily accessible, comprehensible, lasting, and objective. Therefore, it may be stated that sound marks form a type of trademark that is not visible in its creation, but rather becomes so by being a graphically represented mark.

The same criterion may be applied to olfactory/smell marks, where a particular smell is taken to be the mark of a particular good or service. Some useful instruction is found in the *Sieckmann* judgment⁸ on smell marks, where the European Court of Justice stated that to be registrable, a sign shall meet the seven representation requirements; namely, to be *clear, precise, self-contained, easily accessible, intelligible, durable and objective*). At the time, the Court noted that it was mandatory for the sign to be suitable for graphical representation and therefore denied trademark registration. At the time of the judgment, the requirement of graphical representation of smell marks was not fulfilled by 1) a chemical formula, which is not comprehensible, 2) a written explanation, which is not sufficiently clear, exact or objective, 3) a deposit of a sample of the scent, which is inconstant. A combination of these methods does not fulfil the demands either.⁹

It has been noted that the *Sieckmann* ruling does not comment on the use of gas chromatograms, which can be used to graphically represent a smell. However, there are certain conditions to be fulfilled if a gas chromatogram is to be used to represent a smell, and it appears that the technology at present does not support a constant and exact depiction so as to make it unambiguous. So far, only two applications for smell marks have been filed: VA 1997 05710 for bubble bath and VA 1997 05711 for perfume. These cases were refused on the basis of ambiguous graphical representation in the form of gas chromatograms¹⁰. However, there may be hope for the future where

⁷ Case C-283/01 *Shield Mark BV v Joost Kist h.o.d.n. Memex* [2003] ECR I-14313

⁸ *Sieckmann* (n 2)

⁹ WIPO (n 4)

¹⁰ Heidi Rehné and Janne Britt Hansen, 'Denmark' (August/September 2009) *World Trademark Review* <<https://www.worldtrademarkreview.com/article/1C58DEAF69BDCBF9F7AC8E46CDEFDD58D3B5C5A6/download>> accessed 28 September 2022.

technology may be advanced to the extent that a smell mark may fulfil the requirements of graphical representation.

Regarding taste and touch/feel marks, technically these could be registered if they meet the requirements for graphical representation. At present, there is no provision to convert taste or touch into a form that is graphically representable, but again as with smell marks, it may only be a matter of time before technology will be advanced enough to provide a graphical formula that meets the requirements laid down in both the *Fur Elise* and *Sieckmann* cases.

III. Global Legal Framework for Protection of Non-traditional Trademarks

Although the Paris Convention has been the ‘cornerstone’ of the international regulation of industrial property for nearly a century, it makes no provision for the definition of a trademark.¹¹ It leaves this to be decided by individual nations but mandates that trademark protection should be offered by member states.

The TRIPS Agreement is the first international instrument to provide a consolidated definition of trademarks, which was absent from the Paris Convention.¹²

Article 15.1 of the TRIPS establishes that ‘any signs and combinations of signs that are capable of distinguishing the goods or service of one undertaking from those of other undertakings, shall be capable of constituting a trademark’. However, TRIPs provide only the basic threshold and there is nothing to prevent individual nations from applying more expansive definitions (TRIPs + provisions) TRIPs also does not insist that the sign be visible, so that there is considerable leeway in that regard for the term “sign” to be interpreted as a non-visible sign. Thereby, all trademarks that are capable of graphical

¹¹ Paris Convention for the Protection of Industrial Property (Paris Convention), signed on 20 March 1883, as revised in Brussels on 14 December 1900, in Washington, DC on 2 June 1911, in The Hague on 6 November 1925, in London on 2 June 1934, in Lisbon on 31 October 1958, and in Stockholm on 14 July 1967, and as amended on 28 September 1979. Also see Gustavo Bravo, ‘From Paris Convention to TRIPS: A Brief History’ (2001–2002) JCLI 445, 449. See also L A Ellwood, ‘The Industrial Property Convention and the “Telle Quelle” Clause’ (1956) Trademark Reporter 36, 38.

¹² Daniel Gervais, *The TRIPS Agreement: Drafting History and Analysis* (Sweet & Maxwell 1997) 105.

representation may be admitted by TRIPS members as valid trademarks, but this is left to the individual capacities of each member.

IV. Sri Lankan Legal Framework for Protecting Non-traditional Trademarks

The Sri Lankan law relating to intellectual property is contained in the IP Act No 36 of 2003. Section 101 defines a trademark as “any visible sign serving to distinguish the goods of one enterprise from those of another enterprise.” Service marks are defined as “any visible sign serving to distinguish the services of one enterprise from those of another enterprise.” Therefore, the first requirement is that the sign be capable of “visible” representation. This rule out any trademarks that are capable only of being graphically represented.¹³

A. Comparative Perspectives on Protecting Non-traditional Trademarks

In looking for comparative perspectives, it is useful to look at the practice of a jurisdiction that is advanced in its interpretation of NTTMs. This is not to say that such practices can be duplicated in a jurisdiction that lags behind in many areas, but rather to assess the widest extent of the scope of the protection currently offered. In this aspect, the jurisprudence of the European Court of Justice is most useful.

In the Sieckmann case, which has also been mentioned before, the applicant intended to register an olfactory trademark - a “methyl cinnamate” scent, based on its chemical formula, a written description and a sample. The Court stated that to be registrable, a sign shall meet the seven representation requirements; namely, to be *clear, precise, self-contained, easily accessible, intelligible, durable and objective*). At the time, the Court noted that it was mandatory for the sign to be suitable for graphical representation and therefore denied trademark registration as this condition was not capable of being met.

¹³ At present the NIPO receives about 5-6,000 applications for visible signs as trademarks each year, which are almost evenly divided between foreign and local applicants. A little less than half this number is registered each year, with a larger proportion of registered marks belonging to foreign applications. This may be due to defects in local applications caused by improper adherence to registration requirements. See, the statistics page for trademarks of NIPO <https://www.nipo.gov.lk/web/index.php?option=com_content&view=article&id=8&Itemid=130&lang=en#trademarks> accessed 28 September 2022.

This led to the Directive 2015/2436¹⁴ which replaced Directive 2008/95/EC.¹⁵ The Directive had the effect of both removing the graphic representability requirement, as well as mentioning explicitly as examples of signs, both, colours and sounds. The main modification, the removal of graphical representability requirement, is detailed in the Preamble of the Directive, according to which a: *“sign should therefore be permitted to be represented in any appropriate form using generally available technology, and thus not necessarily by graphic means, as long as the representation offers satisfactory guarantees to that effect.”* To fulfil trademark registration conditions, the sign shall also be capable of: *“...being represented in a manner which is clear, precise, self-contained, easily accessible, intelligible, durable and objective.”*¹⁶

As further improvement on this, the Regulation 2018/626 brought in additional guidance on the matter of sound, motion, multimedia and hologram marks.¹⁷ Accordingly, trademarks consisting of sounds shall be represented by an audio file or by an accurate musical notation; trademarks consisting of a movement or a change shall be represented by a video file or by a series of sequential still images; trademarks consisting of both image and sound shall be represented by an audio-visual file and trademarks comprised of elements with holographic characteristics shall be represented by a video file, graphics

¹⁴ Article 3 states: *trade mark may consist of any signs, in particular words, including personal names, or designs, letters, numerals, colours, the shape of goods or of the packaging of goods, or sounds, provided that such signs are capable of:*

(a) distinguishing the goods or services of one undertaking from those of other undertakings; and

(b) being represented on the register in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor.

¹⁵ Article 2 states: *A trade mark may consist of any signs capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.*

¹⁶ Victor Danciu, ‘European Union: The Scent of a Trademark: Removal of Graphic Representability Requirement’ (2019) <<https://www.mondaq.com/trademark/788476/the-scent-of-a-trademark-removal-of-graphic-representability-requirement>> accessed 28 September 2022.

¹⁷ EUR-Lex, Commission Implementing Regulation (EU) 2018/626 (March 2018) <https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=uriserv:OJ.L_.2018.104.01.0037.01.ENG> accessed 29 September 2022.

or photographic reproduction. These regulations have not given a clear indication about olfactory trademarks.¹⁸

Following the adoption of certain EU regulations on the matter, the UK Trademarks Act of 1994 has also taken away the requirement of graphical representation. It now requires only that the mark should be a sign “which is capable- (a) of being represented in the register in a manner which enables the registrar and other competent authorities and the public to determine the clear and precise subject matter of the protection afforded to the proprietor, and (b) of distinguishing goods or services of one undertaking from those of other undertakings.” It further explains this by stipulating that “a trademark may, in particular, consist of words (including personal names), designs, letters, numerals, colours, sounds or the shape of goods or their packaging.”¹⁹ Previously, the law required that a graphical representation of the sign be provided and that that representation be “adequate.”

In the United States, the US Trademark Act states that: “...*the applicant is not required to submit a drawing in case the mark consists only of a sound, scent or other completely non-visual matter.*”²⁰

Australian IP regulations accept the registration of scents and sounds as trademarks²¹, but it retains the graphic representation requirement. It has been noted that “it would seem that it is difficult to represent sounds and smells graphically, unless by way of indirect description such as a graph of the sound’s frequency changes or a spectrometer analysis of the composition of a smell. However, the Regulations provide a method to overcome this difficulty

¹⁸ Danciu (n 16). Danciu notes that there is only one olfactory trademark that is active at present. It is the UK trademark with Application number UK00002000234, owned by Unicom Products Limited for “*the strong smell of bitter beer applied to flights for darts.*”

¹⁹ Trademarks Act 1994, (Unofficial Consolidated Version) <https://assets.publishing.service.gov.uk/government/uploads/system/uploads/attachment_data/file/957352/unofficial-trade-marks-act-1994.pdf> accessed 28 September 2022.

²⁰ Danciu (n 16).

²¹ The Australian Trade Marks Act of 1995 defines a trademark as a “sign” (section 17, and section 6 defines a “sign”) to include “the following or any combination of the following, namely, any letter, word, name, signature, numeral, device, brand, heading, label, ticket, aspect of packaging, shape, colour, *sound or scent.*” (emphasis added) <<https://www.legislation.gov.au/Details/C2017C00046>> accessed 29 September 2022.

and sounds in the form of music have been frequently described by submitting the musical composition in conventional written form.”²²

B. Advantages and Challenges of Admitting Non-traditional Trademarks in Sri Lanka

The experts interviewed for this part of the research were from varied backgrounds. Some of them were experienced practitioners in the area of intellectual property, while views of IP administrators were also sought. As such, their views were rather diverse.²³

Practitioners tend to lean towards the view that admitting NTTMs in Sri Lanka would be advantageous to the economy, because they believe it could stimulate innovation and also bring in other trading advantages. For example, if Sri Lanka were to be viewed as a country that had a liberal IP regime, then it might encourage foreign investment, which is a priority area for the government at present, given ongoing economic crisis. In any case they feel that this is an inevitable progression, and that it could only be a matter of time before NTTMs find their way into the market. These practitioners also point out that the registration system cannot in any event prevent NTTMs from being operational within Sri Lanka, since the common law protection for passing off also exists under the law, as it was operational even prior to the legislation, and it was not explicitly removed as a source of trademark protection. These provisions continue under unfair competition provisions in the IP Act (section 160).

Officials involved in the regulation and protection of trademarks tend to adopt a more cautious approach, they point out that protection of NTTMs through a registration system would necessitate the provision of more sophisticated facilities and that these are not available, nor will be in the near future. The office is already burdened with a heavy workload associated with ordinary trademarks, and the introduction of new areas without recruitment and training of new staff will be difficult to handle. This concern was appreciated by the practitioners as well.

Officials are also of the view that granting protection to NTTMs now or in the near future will be disadvantageous to local innovation as there is little or no

²² ‘Sounds, smells and shapes - Has trademark protection been extended too far in Australia?’ White SW Computer Law < <https://computerlaw.com.au/doku.php?id=ssstm>> accessed 29 September 2022.

²³ Names are not revealed upon request. Interviews available on file with author.

local innovation at present, and they fear that such moves would stifle local innovation altogether. Practitioners believe that even though there is no local innovation at present, allowing NTTMs may be helpful in promoting innovation by providing points of comparison. In any case, since NTTMs may operate within the legal system even without the assistance afforded by a registration system, there is nothing to prevent NTTMs owned by foreigners from coming in.

Practitioners do acknowledge that allowing registration for NTTMs will require certain resources to be allocated, both for training staff in the exercise of examination and also to deal with the increased number of applications.

V. Conclusions and Recommendations

From the preceding discussion, the following points may be ascertained:

NTTMs are not readily accepted even in jurisdictions considered to be “sophisticated” or “advanced” where the judiciary feels that the conditions for registrability are not capable of being met.

However, it may be observed that NTTMs are gradually being accepted in jurisdictions where a certain level of sophistication of products and capacity exist to allocate resources for examination. (this will of course have to be verified by checking on budgetary allocations in EU, US and Australian trademark offices) This is supported by rapid advances in technology that make it possible for the statutory requirements to be met in a stable and consistent manner.

While certain jurisdictions still retain the visibility requirement, certain others have moved a step further by relaxing it to the level of the graphic representation requirement, while others have progressed even beyond that and removed the graphic representation requirement, focusing instead on a set of criteria that require certain conditions to be met without graphic representation. These are elaborated in case law; namely, the *Libertel* and *Sieckmann* cases.

Specific focus on Sri Lanka indicates that the visibility requirement is retained for trade and service marks. However, given that registration is not the only means of protecting trademarks, and that the common law action of passing off is available, along with unfair competition provisions, it may be possible to work NTTMs in Sri Lanka. The difference of course will lie in a more extensive burden of proof under the common law than under a registration system.

Given the expert views, now may not be the right time to initiate a discussion on the permissibility of allowing NTTMs to be registered in Sri Lanka. More training of personnel will be required. Also, some cost-benefit analysis may need to be done to evaluate its usefulness to the Sri Lankan economy.