



RECOGNISING NON-TRADITIONAL TRADE MARKS IN SRI LANKA: INSIGHTS FROM EUROPE

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For many centuries, traders have used symbols and marks to indicate the origin of their goods and today a trademark holds enormous value to its owner. With the development of technologies, non-traditional trademarks have emerged as a powerful tool for brand identity and protection. Therefore, the aim of this research is to explore the extent to which non-traditional trademarks can be recognised in Sri Lanka as viewed through the lens of European experience. A non-traditional trade mark is a mark that can include elements such as colors, sounds, scents, tastes, textures, shapes, moving images, and other non-visual signs. Due to the expansion of the market, the growing use of new branding strategies that utilise non-traditional trade marks has become an important aspect for businesses. Such non-traditional trade marks are recognised by many countries, more specifically by the countries in the European Union. Further, the importance of recognising non-traditional trade marks has been emphasised by IP scholars, members of the legal fraternity and business leaders worldwide, including Sri Lanka. In 2003 Sri Lanka introduced its Intellectual Property Act as a TRIPS compliant legislation. Findings of this research reveal that the current trade mark law regime in Sri Lanka only recognizes visible marks that does not make room for non-visual senses of human beings. As per section 101 of the Act, a trade mark is any visible sign serving to distinguish the goods of one enterprise from those of another. As a consequence, non-traditional non-visible trademarks such as sound, motion, multimedia and hologram marks will not be afforded trade mark protection in Sri Lanka. However, there may be a strong case for Sri Lanka to create a legal environment that recognises non-visible non-traditional trademarks, arguably there is a need for Sri Lanka businesses to protect their non-traditional trade marks in Sri Lanka to expand their business footprints locally and abroad. The same is true for foreign business establishments who need to protect their trade marks in Sri Lanka to expand their business footprint locally as well as abroad. In terms of the implication of this research, the researcher is of the view that this research will enlighten legal reform, and it offers suggestions to policy makers in this country. In this regard, live experiences from the European Union will provide the necessary impetus for Sri Lanka. This research is library-based and carried out by employing both doctrinal and comparative legal research methods.

Keywords: trade mark, non-traditional trade mark, European experience, Sri Lankan Trade mark Regime

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INTRODUCTION

For centuries, traders have used symbols and marks to indicate the origin of their goods and today a trade mark holds enormous value to its owner. With the development of technologies, non-traditional trade marks have emerged as a powerful tool for brand identity and protection. A trade mark is a sign that distinguishes products of one enterprise from that of another. Generally, trade marks can be divided into 'traditional trade marks' and 'non-traditional trade marks.' A traditional trademark consists of words, figures, logo and sign marks. However, a non-traditional trade mark is a mark that can include elements such as colors, sounds, scents, tastes, textures, shapes, moving images, and other non-visual signs (Karunaratna, 2010, p.185). Therefore, the aim of this research is to explore the extent to which non-traditional trademarks can be recognized in Sri Lanka as viewed through the lens of European experience. Due to the expansion of the market, the growing use of new branding strategies that utilize non-traditional trade marks has become an important aspect for businesses. Such non-traditional trade marks are recognized by many countries, more specifically by the countries in the European Union. Further, the importance of recognizing non-traditional trade marks has been emphasized by IP scholars, members of the legal fraternity and business leaders worldwide, including Sri Lanka. Therefore, it is necessary to consider as to how such non-traditional trademarks can be afforded protection in the Sri Lankan trademark legal landscape.

METHODOLOGY

This research follows the qualitative research approach and is carried out as a library-based critical review of literature. According to Terry Hutchinson, the research method is assumed knowledge within the discipline, part of the grab-bag of skills associated with thinking like a lawyer (Hutchinson, 2015, p.132). In terms of research methods, the researcher extensively utilises primary and secondary legal sources; namely, international treaty provisions, statutes, case law, textbooks, journal articles and online materials. Most importantly, this study dwells within the doctrinal or black letter (dogmatic) research methodology which is coupled with comparative legal analysis. The doctrinal legal research involves examination of the existing law on the topic under review (Rattan Singh, 2016, p.311). Therefore, this research carefully analyses both the relevant case law together with detailed consideration of relevant statute law. In comparative legal research, the researcher finds out what the law applies in other countries (in this case the European Union) and considers whether it can be drawn upon with or without modification. Since the EU is considered as one



of the most developed legal regimes, especially regarding non-traditional trade marks, the researcher believes legislative examples and case law emanating from Europe can serve a model for Sri Lanka.

RESULTS AND DISCUSSION

With the evolution of modern technology and growing use of new brand strategies, non-traditional trademarks have gained popularity among businesses, large or small. Sri Lanka is, certainly, no exception to this reality. In 2003 Sri Lanka introduced its Intellectual Property Act as a TRIPS compliant legislation. Findings reveal that the current trade mark law regime in Sri Lanka only recognises visible marks that do not make room for non-visual senses of human beings. As per section 101 of the Intellectual Property Act, a trade mark is any visible sign serving to distinguish the goods of one enterprise from those of another. Consequently, non-traditional non-visible trademarks such as sound, motion, multimedia and hologram marks will not be afforded trade mark protection under the Sri Lanka law. However, there may be a strong case for Sri Lanka to create a legal environment that recognises non-traditional non-visible trademarks.

Arguably, there is a need for Sri Lanka businesses to protect their non-traditional trade marks in Sri Lanka to expand their business footprints locally and abroad. The same is true for foreign business establishments who need to protect their trade marks in Sri Lanka to expand their business footprint locally as well as abroad. In this regard, it should be noted that Sri Lanka's ambition to become a party to the Madrid Protocol (Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks of 1989) administered by the World Intellectual Property Organization (WIPO) to streamline the process of international registration of trade and services marks. The Madrid System enables to protect a mark in many countries by obtaining an international registration and it may be prudent for Sri Lanka to recognize non-traditional trademarks in its legal system. Besides, national registration is a pre-requisite for the international registration of trade mark under the Madrid System.

Since the current trademark law in Sri Lanka does not afford protection for non-traditional trademark, it is necessary to consider live experience of other jurisdictions. In this regard, the lessons from the European Union can be emulated by Sri Lankan policy makers. The EU countries consider trade marks to be an essential and usual part of business, large or small. Even though the lion share of trade marks registered in the European Union consists of traditional /conventional marks such as words, letters, numerals, logo and figures, with the development of technologies the registration of non-traditional / non-conventional marks such as colours, sounds, holograms, smells, taste and multimedia have become innovative means for businesses to differentiate their products and services in day-to-day operations. Therefore, in response to this reality the European Union has introduced a new



trademark system by amending the existing regulations. Most strikingly, one of the most sweeping changes was the removal of the ‘graphical representation requirement’ which opens new possibilities for trademark holders in relation to register non-traditional marks such as sound, olfactory and smell marks. This new legislative change has removed a stumbling block for registration of non-traditional trade marks.

The two legislative changes; namely, the EU Trade Mark Regulation 2015/2424, which came into force on 23 March 2016, and the EU Trade Mark Directive 2015/2436, which came into force on 13 January 2016 are considered as welcome development by business leader and legal practitioners. Because of new trade mark Regulation, trade marks will no longer need to fulfil the requirement for graphical representation as per Article 4 of the EU Trade Mark Regulation 2015/2424 and Article 3 of the EU Trade Mark Directive 2015/2436. The law states that: “ [A] trademark may consist of any signs, in particular words, including personal names, or designs, letters, numerals, colors, the shape of goods or of the packaging of goods, or sounds, provided that such signs are capable of: distinguishing the goods or services of one undertaking from those of other undertakings; and 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.” In essence, “trade marks must be capable of 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.” Due to this new legal position, a wide variety of marks can now be registered in the European Union, and such development can serve as a reference point for other developed and developing countries such as Sri Lanka.



CONCLUSIONS/RECOMMENDATIONS

As discussed above, Sri Lankan policy makers should consider modernising the country's trade mark law regime in accordance with the new business trends and legislative changes in other more advanced jurisdictions such as the European Union. The removal of graphic representation requirement in Europe has offered legal security and protection for trademark owners and business leaders. Therefore, it is imperative to amend the current Intellectual Property Act of Sri Lanka enabling registration of non-traditional trade marks. This change can safely be made by removing the requirement of 'any visual sign' in the definition of a trade mark. Even though graphical representation is not necessary, a sufficient description of non-traditional mark should be provided in the trade mark registry. It is important to accept the position that trade marks must be capable of being represented on the register in a clear and precise manner. Even more importantly, Sri Lankan policy makers must pay attention to develop technological capabilities and digital infrastructure of the National Intellectual property Office to enable registration of non-traditional trade marks. Moreover, registration of new types of marks is not without enormous challenges due to their inherent nature.

All in all, it is imperative to protect non-traditional trade marks in an expanding global marketplace. In terms of the implication of this research, the researcher is of the view that this research will enlighten legal reform, and it offers suggestions to policy makers in this country. In this regard, live experiences from the European Union will provide the necessary impetus for Sri Lanka.

REFERENCES

Agreement on Trade-Related Aspects of Intellectual Property Rights, 1994 (TRIPS Agreement).

Hutchinson, T. (2015). The Doctrinal Method: Incorporating Interdisciplinary Methods in Reforming the Law. *Erasmus Law Review* (3),130-138.

Karunaratna, D.M. (2010). *Elements of Law of Intellectual Property in Sri Lanka*. Nugegoda, Sri Lanka: Sarasavi Publishers.

Paris Convention for the Protection of Industrial Property of 1883, as amended on September 28,1979.

Trillet, G. (2012) Registrability of Smells, Colors and Sounds: How to Overcome the Challenges Dressed by the Requirements of Graphical Representation and Distinctiveness within European Union Law?. *SSRN Electronic Journal* 4.

The Madrid Agreement Concerning the International Registration of Marks of 1891 and Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks of 1989.



The European Union Trademark Directive 2015/2436 [Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks].

The European Union Trademark Regulation 2015/2424 [Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015 amending Council Regulation (EC) No 207/2009].

Rattan Singh R. (2016), *Legal Research Methodology*. Haryana, India: LexisNexis.

Sieckmann v Deutsches Patent- und Markenamt (C-273/00), [2003] Ch 487

World Intellectual Property Organization. (2017). *Making a Mark- An Introduction to Trademarks for Small and Medium-sized Enterprises*. Geneva, Switzerland: WIPO.