

THE STATUS AND PRACTICES OF INTELLECTUAL PROPERTY IN MALAYSIA

Sanjeetha Sidhu

Mentari School of Law, Kuala Lumpur, Malaysia.

ABSTRACT

This paper discusses the status and practices of Intellectual Property (IP) in Malaysia starting with an introduction of what IP is all about and its origins. Heads of IP such as patents, trademarks and copyrights are mentioned. The weaknesses of the current trademark laws in Malaysia in comparison with similar laws from other jurisdictions such as Europe, Australia and the United Kingdom are analysed. Unusual trademarks are briefly introduced and the registrability of such marks, for example, olfactory marks re-highlighted.

1.0 Introduction

1.1 The Nature of Intellectual Property Rights

As the words indicate, IP is an asset product of the creativity of the human mind, or intellect. The earliest use of the term appears to be from an October, 1845 Massachusetts Circuit Court ruling in the patent case *Davoll et. al v. Brown*¹. Justice Charles L. Woodbury wrote in that decision, "only in this way can we protect IP, the labours of the mind, productions and interests as much a man's own...as the wheat he cultivates or the flocks he rears". The term also appeared in Europe during the 19th century. French author A. Nion mentioned "*propriété intellectuelle*" in his *Droits civils des auteurs, artistes et inventeurs*, published in 1846, and there may well have been earlier uses of the term.

The use of the term to describe these statutorily granted rights has increased markedly in recent times, though it was rarely used without scare quotes until about the time of the passage of the Bayh-Dole Act in 1980². However, worldwide use of the term was uncommon until actively promulgated by the World IP Organization (WIPO) which was established in 1967.

The first codification of IP can be traced to the Jewish laws in the Talmud, which declared a prohibition against "Gnevat ha daat", literally the theft of ideas. The type of ideas subject to theft and further explanation may be found in the Shulkhan Arukh. Both texts preceded the Statute of Anne by a few hundred years.

With the French Revolution, which followed the American Revolution, there was debate in Europe over the nature of protection for copyrights and patents; those who supported unlimited copyrights frequently used the term *property* to advance that agenda, while others who supported a more limited system sometimes used the term *intellectual rights* (*droits intellectuels*). The system currently used by much of the Western world is more in line with the second view, with limited copyrights that would eventually expire. However, the French Civil Code notion of "moral rights" had connotations similar to natural rights that were inconsistent with the U.S. tradition. The term "IP" did not occur in the United

States Copyright Statutes, except in certain footnotes citing the titles of certain Bills. The term used in the statutes and in the Constitution was "exclusive rights".

IP laws are territorial such that the registration or enforcement of IP rights must be pursued separately in each jurisdiction of interest. However, these laws are becoming increasingly harmonised through the effects of international treaties such as the WTO Agreement on Trade-Related Aspects of IP Rights (TRIPS Agreement), while other treaties may facilitate registration in more than one jurisdiction at a time.

Some see IP rights principally as economic or commercial rights, and others as akin to political or human rights. The TRIPS Agreement treats them in the former sense, while recognising the need to strike a balance between the rights of inventors and creators to protection, and the rights of users of technology³. The Universal Declaration of Human Rights has a broader definition recognising "the right to the protection of the moral and material interests resulting from any scientific, literary or artistic production of which he is the author", balanced by "the right...to share in scientific advancement and its benefits"⁴.

We therefore consider that an IP right is best viewed as one of the means by which nations and societies can help to promote the fulfillment of human economic and social rights. Regardless of the term used for them, we prefer to regard IP rights as instruments of public policy which confer economic *privileges* on individuals or institutions solely for the purposes of contributing to the greater public good. The *privilege* is therefore a means to an end, not an end in itself. The crucial issue is to reconcile the public interest in accessing new knowledge and the products of new knowledge, with the public interest in stimulating invention and creation which produces the new knowledge and products on which material and cultural progress may depend.

¹ *Woodbury & Minot, CCD Mass. 7 F. Cas. 197, 1845*

² Paper by Mark A. Lemley, "Property, Intellectual Property, and Free Riding"; see Table 1, pp. 4-5.

³ Article 7 of TRIPS

⁴ United Nations (1948) "*Universal Declaration of Human Rights*", UN, Geneva, Article 27. Source: <http://www.un.org/Overview/rights.html>

1.1.1 Heads of Intellectual Property

IP and the body of law developed for its protection falls into four major classes: patents, copyrights, trademarks and trade secrets.

Patents, or utility patents as they are more formally known, are applied to product and process inventions. Some countries have a lesser form of patent protection, known as the utility model or petty patent that provides weaker protection for more modest and typically adaptive inventions.

Copyrights protect creative works such as books and music. They have also been used in recent years to protect computer programs (some applications of which, in some countries, can be accorded patent protection). Some countries protect the work of performers, phonogram producers and broadcasters through copyrights or specific rights called "neighbouring rights."

Trademarks reserve a portion of the language (e.g., Ford, Chevrolet, Dodge, all originally family names) or symbols (McDonalds', 'Golden Arches" or Gucci's stylised G) for the identification of a particular product or service.

Trade secrets do not apply to specifically identified products but protect a firm or individual from the unauthorised disclosure of proprietary information. Less common types of protection include the plant patents available in the United States to protect inventions of asexually bred plants and design patents, by which shapes such as the original Coca-Cola bottle can be protected.

Trademarks: Trademarks provide exclusive rights to use distinctive signs, such as symbols, colours, letters, shapes or names to identify the producer of a product and protect its associated reputation. In order to be eligible for protection, a mark must be distinctive of the proprietor so as to identify the proprietor's goods or services. The main purpose of a trademark is to prevent customers from being misled or deceived. The period of protection varies, but a trademark can be renewed indefinitely. In addition, many countries provide protection against unfair competition, sometimes by way of preventing misrepresentations as to trade origin regardless of registration of the trademark.

1.1.2 Trademark Status and Practices in Malaysia

A trademark is a mark which distinguishes the goods and services of one trader from those of another. A trademark includes words, logos, pictures, names, letters, numbers or a combination of these. A trademark is used as a marketing tool to enable customers to recognise the product of a particular trader. Malaysia adopts the 8th Ed. of the Nice International Classification of Goods and Services. There are 35 classes for goods and 10 classes for services. The class headings for the 45 classes have been lodged with the WIPO. However, class headings only serve as general indications of the type of goods or services and may not cover all the goods or services in the class.

A trademark serves several functions. It includes:

- **Origin Function** - A trademark helps to identify the source and those responsible for the products and services sold in the market.
- **Choice Function** - A trademark enables consumers to choose goods and services with ease while shopping.
- **Quality Function** - Consumers choose a particular trademark for its known quality.
- **Marketing Function** - Trademarks play an important role in advertising. It is normal for consumers to make purchases based on continuous influence of advertising.
- **Economic Function** - An established trademark is a valuable asset. Trademarks may be licensed or franchised.

Trademarks registration provides for exclusive rights i.e. the registered trademarks owners have exclusive right to use their trademarks in trading. They also have the rights to take legal action for infringement under the Trademarks Law against others who use their trademarks without consent. They can either take civil action or lodge complaints to the Enforcement Division for appropriate actions under the Trade Description Act 1972. In Malaysia, registration of trademarks is not compulsory unlike registration of companies

and business. Unregistered trademarks may still obtain protection under Common Law by virtue of use and reputation. "Passing off" action against an infringer can still be instituted.

However, protection through usage is rather difficult and tedious. The trademark owner must convince the court, firstly, that the infringing act misleads the public and secondly, the infringing goods and services may be mistaken from his own goods and services. If protection of trademarks is required in other countries, it will be necessary to apply for registration separately in each country. However, a Malaysian application can be used as a basis for claiming priority in countries which are party to the Paris Convention and WIPO.

The registration procedure is as follows:

1. The procedure to file and prosecute a trademark application is similar to the procedure in other common-law countries. Malaysia adopts a 'first to use' system as compared to a 'first to file' system. Registered marks can be revoked if a registered trademark has not been used in trade for a continuous period of 36 months without any legally acceptable reason.
2. Each application must be for single mark in a single class. T class without the payment of any additional fees.
3. If the mark applied for is acceptable to the Trademark Office, it is advertised in the Government Gazette for any member of the public to oppose the application. A period of 2 months is given for the filing of any opposition. If no opposition is received, the work proceeds to registration. Conversely, after objections and/or oppositions are overcome, the mark proceeds to registration.
4. Upon registration, the trademark is valid for 10 years from date of filing of application; renewable for every 10 years thereafter.
5. If the application does not face any objections or oppositions, the trademark will be registered within 2 years.

1.2 Protection for the Functional Aspects of a Product in Malaysia

Section 3(1) of the Trademarks Act 1976⁴ defines a trade the application can include several goods or services all falling within the same international mark as follows:

"trademark means, except in relation to Part XI, a mark used or proposed to be used in relation to goods or services for the purpose of indicating or so as to indicate a connection in the course of trade between the goods or services⁴ and a person having the right either as proprietor or as registered user to use the mark whether with or without an indication of the identity of that person, and means, in relation to Part XI, a mark registrable or registered under the said Part XI."

(i) Colour

This definition only encompasses a 'mark' as a registrable trademark in Malaysia as opposed to the wider concept of 'signs' in the other jurisdictions. With regards to this, many non-conventional marks including colour cannot be rendered as trademarks and are therefore excluded from the domain of registration⁴. However, it must be noted that *Section 13(1) Trade Marks Act 1976* does provide that a trademark may be limited in whole or in

part to one or more specified colours and, in any such case, the fact that the trademark is so limited shall be taken into consideration for the purpose of determining whether the trademark is distinctive. *Section 13(2)* goes on to say that where a trademark is registered without limitations as to colour, it shall be deemed to be registered for all colours⁴.

(ii) Shape

Three dimensional marks are not specifically provided for in the Trademarks Act of 1976. However, it must be noted that in practice, the registration of a shape mark has been accepted by the Registrar in light of s.6.26, Manual of Trademark Law & Practice in Malaysia (WIPO, Geneva 1989).

(iii) Scent

Malaysia has not followed the developments in other countries that have adopted an extended form of source identifiers to other non-verbal symbols. However, as ascertained from the above discussion, many of the other jurisdictions have themselves not truly recognized, the registration of olfactory marks due to the fact that of all the more unusual kinds of signs/marks, scent is probably the most unusual and the most difficult to represent graphically.

2.0 Non-conventional Marks

2.1 Introduction

A non-conventional trademark or a non-traditional trademark is any new type of trademark which does not belong to any pre-existing category of trademark. It seeks to protect the functional aspects of a product. This often makes it difficult to register such a mark even though it may nevertheless fulfill the essential trademark function of uniquely identifying the commercial origin of products or services.

Certain types of non-conventional trademarks have become more widely accepted in recent times as a result of legislative changes which expand the definition of ‘trademark’⁴ and now sets down a standardised, inclusive legal definition. This paper would deal with colour trademarks, shape trademarks (also known as 3 dimensional trademarks or 3D trademarks) and scent trademarks (also known as smell/olfactory trademarks)⁴.

The words of Professor David Vaver⁴ are worth taking into account:

“...‘unconventional marks’ are today’s more *outré* elements: smell, sound, colour, shape, even taste and gesture. Until recently, such things were thought to be unregistrable and largely unprotected at common law. This position is changing internationally. Smell, sound, colour and even shape marks now appear on many trademarks registries and in trademark legislation and treaties. They are, even when unregistered, gaining protection in both common law and civilian legal systems. This process is worth reflecting on before these unconventional trademarks of today become the conventional trademarks of tomorrow.”

This chapter would attempt to examine the contemporary position of the European Union (United Kingdom), the United States of America and also Australia with regards to unconventional trademarks. A comparative study of these advance jurisdictions would only

allow us to thoroughly comprehend the scope of this area of trademark protection laws and its applicability in Malaysia in light of the provisions laid down in the Trademarks Act 1976⁴.

2.1.1 Registrability of Colour Trademarks

A colour trademark is a non-conventional trademark where at least one colour is used to perform the trademark function of uniquely identifying the commercial origin of products or services.⁴

“Colour can be, or be part of, a protectable trademark: the blue, white and gold oblong Visa trademark for credit cards is a well-known example. The difficulty of course is that colour is popularly thought of as an inherent property of matter (although technically, it is the brain’s reaction to light reflecting off matter). Added colour is often used simply for functional purposes (a red traffic light) or to decorate products or make them more attractive. Colours are therefore not inherently trademark material, but can become so by use. The more common the colour, the less likely it is that the consuming public will regard it as a trademark, but this factual assumption can be overcome by evidence. The broader the range of goods or services applied for, the greater care is needed before deciding whether to register the trademark, lest other traders be stopped from using colour simply as a selling feature of their goods. Traders could also monopolise the whole spectrum by registering large numbers of colours and shades.”⁴

Colours have been increasingly used as trademarks in recent times though it has traditionally been difficult to protect colours as trademarks through registration, as a colour as such was not considered to be a distinctive mark. This issue was addressed by the TRIPS Agreement, which broadened the legal definition of trademark Article 15 reads as follows:

Article 15:

Protectable Subject Matter

1. Any *sign*, or any *combination of signs*, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark. Such *signs*, in particular words including personal names, letters, numerals, figurative elements and combinations of *colours* as well as any combination of such signs, shall be eligible for registration as trademarks. Where signs are not inherently capable of distinguishing the relevant goods or services, Members may make registrability depend on distinctiveness acquired through use. Members may require, as a condition of registration, that signs be visually perceptible.

From the TRIPS Agreement, it can be ascertained that the traditional concept of marks have now been replaced by the wider concept of signs. Therefore, it would seem now that ‘any sign or indication capable of being represented graphically can be registered as a trademark.’⁴

The case of *BP Amoco Plc v John Kelly Ltd and Glenshane Tourist Services Ltd*⁴ best illustrates the recent developments in this area as it is the first infringement case

concerning a colour mark under the UK jurisdiction. In this case, the plaintiff BP Amoco Plc is a well-known multi-national corporation which is concerned in exploration for and production of oil and gas, refining and the marketing and sale of oils, fuels, lubricants and chemicals. It brings this action against the first defendant John Kelly Ltd, a Northern Ireland registered company also involved in the sale and distribution of oils, fuels and lubricants, though on a much smaller scale.

Kelly operates a small chain of petrol filling stations in Northern Ireland operating under the trade name TOP. One of its licensees or franchisees is the second defendant which runs a filling station under the TOP brand at Glenshane Road, Maghera and County Londonderry. BP's case against the defendants is that they are infringing BP's UK registered trademarks numbers 1469512 and 1469513 by using the colour green on the whole or a substantial part of the exterior of the TOP service stations in Northern Ireland and that they are thereby committing the tort of passing off their TOP branded filling stations and premises and oils, fuels and lubricants as and for those of BP or as otherwise connected with BP's business. BP seeks injunctive relief and other remedies arising out of the alleged infringement of its rights. Girvan J opined in his judgement as follows:

“As I stated earlier, I am satisfied that the trademarks related to a particular and limited shade of green. It appears to be clear from the authorities under the 1938 Act such as *Smith Kline & French Laboratories Limited v Sterling Windthrop Group Limited [1976] RPC 511* that colour marks or combinations can in appropriate cases give rise to good trademarks. This remains so under the 1994 Act with its extended definition of trademark as a sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of another. However, a mark which purports to cover a whole spectrum of colour would lack the necessary distinctive character to qualify for registration. Thus, in *Re Orange Limited's Application [1998] ETMR 337* the Third Board of Appeal in the Office of Harmonisation in the Internal Market (Trade Marks and Designs) stated:

“It is true that a colour per se may be generally protectable as a community trademark under article 4 of the Community Trade Mark Regulation (CTMR). However, as a rule, its registration can be precluded by the absolute grounds of refusal laid down in Article 7(1) (b) or (c) or (d) of CTMR, unless it is, for example, a very specific colour shade or very specific goods or services or the applicants can successfully argue that the trademark has become distinctive in consequence of the use which has been made of it (Article 7(3) of CTMR).”

Although those remarks were made in respect of a community trademark application, the principles applicable under the CTMR do not appear to be different from those applicable under the Trade Marks Directive.

2.1.2 Registration of Shapes (Trade Dress) as a Trademark⁴

“Trade dress may also be a registered trademark of one or more features of a product or service if the features in combination may be protected through a trademark registration if the likely impact on consumers is to identify or distinguish the source or origin of the

product or service.”⁴ However, one major obstacle to registration of trade dress is the prohibition against registering functional aspects of the product. In order for trade dress to be registered as a trademark, it must not include any functional aspect of the product.

To allow for functional aspects of products to be registered as trademarks would undermine patent law (and industrial designs) by giving a perpetual monopoly over functional aspects of a product, contrary to patent law. If functional aspects were registrable, competitors would be prevented from being able to copy the function, thus frustrating competition. In explanation, the holder of a patent or a design right--valid, invalid, or since expired, should not be encouraged to bolster this monopoly through a trademark on the same feature. So functional and ornamental features (elements that are integral to a product or that make it attractive) should not usually be accepted as trademarks.⁴ Therefore, even if a shape is found to be distinctive⁴, it must pass two further thresholds. Firstly, it must not designate the kind, quality or intended purpose of the product or service and secondly, it cannot consist exclusively of “the shape which results from the nature of the goods themselves, or the shape of goods which is necessary to obtain a technical result, or the shape which gives substantial value to the goods.”⁴

The case of *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd*⁴ best elucidates the contemporary position in Europe⁴ with regards to registration of shapes as trademarks. The claimant in 1966 put on the market in the United Kingdom an electric shaver with a head consisting of three rotary blades arranged in a triangular pattern and some 20 years later registered for the shaver a trademark comprising a graphic representation of its head. The claimant was the only company selling rotary shavers in the United Kingdom until 1995, when the defendant began manufacturing and selling a shaver similar to that of the claimant’s.

In the claimant’s action for infringement of its trademark, the defendant counterclaimed for revocation of the trademark. The judge ordered revocation of the trademark, on the grounds, inter alia, that it was incapable of distinguishing the claimant’s goods from those of other undertakings, was devoid of distinctive character and consisted exclusively of a shape which was necessary to obtain the technical result of shaving with rotary cutters. On the claimant’s appeal, the Court of Appeal referred to the Court of Justice of the European Communities for a preliminary ruling a number of questions on the interpretation of provisions of *First Council Directive 89/104/EEC* on trademarks.⁴ The first question was whether there was a category of marks which, while not being disqualified from registration on the ground that they lacked distinctive character or were merely descriptive or customary within the trade under article 3(1)(b)-(d) of the Directive and had not acquired distinctive character through use under article 3(3), could be refused registration on the ground that they could not constitute a trademark, under article 3(1)(a), because they did not satisfy the requirement in *Article 2* that in order to be a trademark, a sign had to be capable of distinguishing the goods or services of one undertaking from those of another.

The second question was whether the shape of an article was only capable of distinguishing, for the purposes of *Article 2*, if it contained a capricious addition. Other questions concerned acquired distinctiveness under *Article 3(3)* and the scope of the

prohibition under *Article 3(1) (e)*, second indent, of the registration of signs consisting exclusively of ‘the shape of goods which is necessary to obtain a technical result’.

It was held in that case that there was no class of trademarks having a distinctive character by their nature or by the use made of them which was not capable of distinguishing goods or services within *Article 2 of Directive 89/104*, and hence there did not exist a class of marks which were not excluded from registration by virtue of *Article 3(1)(b), (c) and (d) and 3(3) of the Directive* but were none the less excluded by *Article 3(1)(a)* on the ground that they were incapable of distinguishing the goods of the mark's proprietor from those of other undertakings.

That, in the case of a sign comprising the shape of a product, *Article 2* simply required that the shape was capable of distinguishing that product from those of other undertakings. That, where a trader had been the only supplier of particular goods to the market, extensive use of a sign consisting of the shape of the goods could be sufficient to give the sign a distinctive character for the purposes of *Article 3(3)* where, as a result of the use, a substantial proportion of the relevant class of persons, namely, average consumers of the category of goods or services in question who were reasonably well informed, observant and circumspect, associated that shape with that trader and no other, or believed that goods of that shape came from that trader; that the identification, by the relevant class of persons, of the product as originating from a *given undertaking had to be as a result of the use of the sign as a trademark*⁴; and that the requirements that had to be satisfied under *Article 3(3)* had to be shown to exist by reference to specific and reliable, rather than abstract and general data.⁴ [emphasis added]

That, on the proper interpretation of the second indent of *Article 3(1)(e)*, that provision precluded registration of a sign consisting exclusively of the shape of a product if the essential functional features of the shape were attributable only to the product's technical result, even if there existed other shapes which would allow the same technical result to be obtained. “The rationale behind this is to prevent trademark holders from depriving competitors of the opportunity to manufacture and sell goods with the same function or, at any rate, of the free use of the shape in question.”⁴

3.0 Olfactory Marks

The definition of "sign" in Section 6 of the Trademarks 1995 Act allows for the registration of sounds or scents as trademarks. While these types of trademarks are not as common as trademarks consisting of words or devices, identification of goods or services via the auditory or olfactory senses is entirely possible. These "sensory" marks must meet the same requirements as any other trademark. They must be capable of distinguishing the goods or services of the trademark owner from the similar goods and services of other traders.

Section 40 of the Act specifies that "an application for the registration of a trademark must be rejected if the trademark cannot be represented graphically". This requirement has the most impact in regard to sensory trademarks such as sound and scent trademarks because other kinds of signs are, by their nature, graphical.

The onus lies with the applicant to ensure that the trademark is adequately represented. The application must include a graphical representation of the trademark (e.g. “the scent of apple blossoms”) as well as a concise and accurate description of the trademark (e.g. “the scent of apple blossoms applied to car tyres”).

In some cases, the description may also be used as the representation where there is no other form of graphic representation. A precise word description of the trademark would be a satisfactory representation of a scent trademark; however the results of analytical techniques would not be as they would not be readily understood by the ordinary person searching the Register. For example, the results of analytical techniques such as infrared spectroscopy; vacuum, fractional and molecular distillation; nuclear magnetic resonance; vacuum fractionation; "electronic nose" analysis and chromatographic techniques would not be acceptable.

If the description or representation of the trademark is not satisfactory in that it does not demonstrate the nature of the trademark sufficiently or show each feature of the trademark sufficiently, the applicant may be requested to provide a description or further description of the trademark and specimen of the trademark (subreg 4.3(8))⁴

An actual sample of the scent is not required at filing but may be needed during the course of examination. Examples of acceptable descriptions are as follows:

- The trademark is a scent mark. It consists of the smell of roses applied to plastic storage boxes for domestic purposes. The application is a scent mark, consisting of the smell of apple blossoms applied to car tyres.
- The mark comprises the strong smell of bitter beer applied to the flights of darts.⁴
- The applications that failed to overcome the trademark examiner’s objections include the trademarks:⁴
- The scent of musk applied to human skin by hand painting the liquid scent over temporary tattoo transfers, stencils and other body art designs for goods in Class 3 including perfumery, essential oils and cosmetics.
- The scent of eucalyptus, including the eucalyptus scent derived from eucalyptus trees and/or from eucalyptus essential oil for goods in Class 3 including powders/washing powders used for washing clothes by machine, by hand and by soaking.
- The scent of coffee for goods in Class 3 including self tan lotions, sun-tanning preparations, hair lotions, hair shampoos, hair conditioners, essential oils, lotions for cosmetic purposes and make-up preparations.
- The scent of Melon Midori (Bronson and Jacobs) for goods in Class 3 including self tan lotions, shampoos and conditioners, hair products, sun-preparations, body lotions and perfumes.
- The scent of lemon for goods in class 34 including tobacco; cigarettes; cigars.

Why should the smell of a perfume be treated differently than e.g. a sound trademark, where the sound of the music or jingle is the sensorial perception itself, too? In all of the successful registrations the smells have been suggestive additions to the basic product. But what if the products are perfume or toiletries, where the smell forms an essential if distinctive ingredient of the product? A-G Colomer cited the Benelux Trademark registry

as having allowed registration of an olfactory trademark for cosmetic products, but commentators and many trademark registries said that in these cases the smell functions as part of the product and not as an indication of source.

What if the basic product smells unpleasant and the fragrance renders it more acceptable? In another case⁴, OHIM rejected an application to register the 'smell of raspberries' for diesel and domestic fuel. The Office took the view that consumers would not regard the scent as distinctive of the applicant's product but rather as one of industry's many attempts to make these goods smell more pleasant.

It can be argued that the perfume consists of a neutral carrier liquid that is mixed with many different aroma essences – then these essences could be registered trademarks as their gaseous aggregate state (the smell) is different from the (fluid) carrier liquid.⁴

4.0 Resolution

Relying on an olfactory sense, rather than on the visual or auditory to identify a proprietor is perhaps a new concept, but the question of the capability of a scent to distinguish an applicant's goods and/or services should be decided on the same general criteria as with any other kind of trademark. That is, on the basis of whether other traders would want or need to use it in the ordinary course of their business, without improper motive.⁴ The categories should be;

4.1 Natural Scent of a Product

The natural scent of a product will have no inherent adaptation to distinguish the goods. Into this category come goods such as perfumes and eau de colognes for personal use; essential oils for perfumery or cooking; the scent of cedar for timber products and herbal scents/essences for culinary use. These scents either form the goods themselves or are a natural attribute of the goods. The scent thus refers to the goods, and not to the trade source.

4.2 Masking Scents

In addition to the natural or inherent scents of goods, many producers use scents to mask unpleasant natural odours in the goods they sell. A masking scent has a functional purpose, and is not capable of distinguishing for that reason. Examples of this type of scent could be the use of lemon to scent domestic bleaches and laundry sprays and lavender to scent carpet deodorants.

4.3 Scents Which Are Common to a Trade.

A non-functional use, but nevertheless use which is common to the trade and hence not adapted to distinguish, is use of a scent to make a product more pleasant or attractive. Potential purchasers of these goods are unlikely to consider these fragrances as an indication of the origin of the goods because the use of fragrance on such goods is common to the trade. For example, the scent of lemon has been added, over a considerable period of time, to dish washing detergents and laundry products.

4.4 Scents Which May Be Capable of Distinguishing

To be capable of distinguishing the applicant's goods, the scent needs to be something apart from the goods themselves. It should be neither a natural characteristic nor an expected characteristic of the product, but something added to identify the applicant's goods from those of others in the same market. Examples which have been accepted in other jurisdictions include the smell of beer for dart flights and a smell reminiscent of frangipani flowers for embroidery yarn, as well as various fruit perfumes for motor oils. In these cases, the perfume did not consist of the natural scent of the product, nor was there an expectation that the product be perfumed. The scent was something unusual added to the goods to assist in identifying them via olfactory means from the similar products of other traders.

Seeing as it is difficult to give an actual example of a smell trademark in current use that would qualify for registration, this appears to be a form of marketing that is not widespread. It is unclear whether this form of trademark will be applied for and registered in significant numbers in the future. However, future technology may make it possible to incorporate smells into a trader's get up more easily and we may be yet to see these types of marks being used to their full extent.

5.0 Conclusion

It can be gleaned from this paper that the contemporary trends are not being adopted in Malaysia. This could lead to malfunctioning of the business world. If we intend to promote business and competition, our legislation should be amended to allow registrability of non-conventional marks. Nonetheless, it must be noted that such extension must still remain within the demarcations set out by a proper legal framework be it domestically or internationally. It is safe to conclude that Malaysia being a member of the World Trade Organisation is still lagging behind⁴ in this area of the law and efforts have to be contributed towards an inexorable development of trademark registration which is consanguineous to what is taking place around the world in order to co-exist in harmony.

REFERENCES

- A. Toutoungi "Nestlé v Unilever: A case of Over-egging the Pudding?" COMMENT [2003] EIPR 575.
- Bently and Sherman Intellectual Property Law 2nd edition (Oxford University Press 2004).
- C. Gielen, "European Trademark Legislation: The Statements" [1996] EIPR 83.
- C. Gielen Nauta Dutih Amsterdam "N-28 News Section: National Reports": [2003] EIPR.
- C. Schulze, "Registering Colour Trademarks in the European Union" [2003] EIPR 55.
- D. Vaver "Unconventional and Well-Known Trademarks" *Singapore Journal of Legal Studies* [2005] 1-19.

H. Burton “The UK Trademarks Act 1994: An Invitation to an Olfactory Occasion?” [1995] 8 EIPR 378.

http://en.wikipedia.org/wiki/Colour_trademark

http://en.wikipedia.org/wiki/Non-conventional_trademark

Ida Madieha bt Abdul Ghani Azmi Trademarks Law in Malaysia (Sweet & Maxwell Asia 2004).

J. McCutcheon “How Many Colours in the Rainbow? The Registration of Colour Per Se under Australian Trademark Law” [2004] EIPR 27.

Jeremy Phillips Trademark Law: A Principal Anatomy (Oxford University Press 2003).

M. C Janssens “The ‘Toblerone’ Chocolate Bar Case in Belgium” COMMENTS [2004] EIPR 554.

M. Schwarz “Registration of Colours as Trademarks” [1995] 8 EIPR 393.

Mark Davison, Kate Johnston, Patricia Kennedy Shanahan’s Australian Law of Trademarks & Passing Off 3rd Edition (Lawbook Co. 2003).

N. Dawson “The Power of Colour in Trademark Law” [2001] EIPR 383.