GRAPHICAL REPRESENTATION IN THE FORM OF LABEL MEREK/MARK ETIQUETTE IN THE CONTEXT OF NON CONVENTIONAL TRADEMARK REGISTRATION IN INDONESIA

Ilham Azenal Sacabrata

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Corresponding author’s email: sacabrata@gmail.com

Abstract
Legal developments have introduced new types of trademarks that differ from conventional ones. This article describes the registration process for nonconventional trademark categories, particularly sound, scent, and taste marks. With reference to studies and cases in the European Union (EU) and the United States (US), this study illustrates that graphical representation, as a prerequisite, stifles the registration of nonconventional trademarks. Under Trademark Directive 2008, the EU requires graphical representation, which has become a problem in the registration of nonconventional trademarks. The US, having no such requirement, tends to be more flexible in registering nonconventional trademarks. This article also argues that graphical representation is immaterial and its removal from relevant provisions increases legal certainty and flexibility. The problem of nonconventional trademark registration incurred by the graphical representation requirement is likely to be experienced by Indonesia, which aims to encompass the protection of nonconventional trademarks. Indonesian Trademark Law requires Label Merek, which in common practice is considered merely as a graphical representation that consists of lines, images, and characters, as a minimum requirement for trademark registration. Considering Label Merek only as a graphical representation stifles the registration of nonconventional trademarks. Therefore, Label Merek should be construed broadly to protect nonconventional trademarks.

Keywords: Trademark, Nonconventional Trademark, Label Merek, Graphical Representation

Abstrak
Perkembangan hukum dewasa ini menelurkan tipe merek yang berbeda dari merek yang dikenal pada umumnya. Tulisan ini menerangkan kategori merek-merek non-konvensional antara lain merek aroma (scent mark), merek suara dan merek rasa (taste mark) dari sisi pendaftaran atas merek-merek tersebut. Selanjutnya, tulisan

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Kata Kunci: Merek, Merek Non-Konvensional, Label Merek, Representasi Grafis
I. Introduction

Signs have an important role in enterprises’ efforts to attract the attention and preference of consumers and obtain their loyalty.² Traditionally, the signs commonly used to distinguish goods as trademarks are mainly words, devices, designs, and logos. Despite slight differences among countries, the scope of trademarks has been considerably stable and discussions of this scope have been ongoing for decades.³

Rapid technological changes and an increasingly competitive market have prompted many companies to formulate new branding strategies to increase their products’ recognizability in consumer’s minds.⁴ This development has given rise to nonconventional trademarks alongside conventional ones. Each nonconventional trademark has a distinct nature and power of attraction through consumers’ sense of sight, sound, touch, smell, and taste. However, compared with conventional trademarks, nonconventional trademarks may have a broader range with regard to functionality because average consumers sometimes do not perceive nonconventional marks as a trademark associated with a particular product origin. At present, nonconventional trademarks face difficulty in being represented in a suitable form or having their monopoly extent ascertained so that they can be registered as trademarks.⁵

Over the years, many countries have faced obstacles for nonconventional trademarks (particularly sound, scent, and taste marks) to be registered under trademark protection. The primary reason is induced by graphical representation as a requirement for trademark registration.⁶ Graphical representation requires the proposed mark to be capable of being described by means of lines, images, and characters. For nonconventional trademark registration, this requirement is difficult to satisfy due to the nature of nonconventional marks themselves.

Many countries, such as Singapore⁷, India⁸, Brunei⁹, and China¹⁰, implement graphical representation as a requirement for trademark registration. Indonesia, under Law No.20 of 2016 concerning trademarks requires Label Merek,¹¹ which is a graphical representation by means of images, lines, or characters, as a minimum requirement for trademark registration.

This paper illustrates, through studies and cases, that graphical representation as a prerequisite stifles the registration of nonconventional trademarks. The Sieckmann case, an influential case concerning nonconventional trademarks, illustrates the

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¹¹ See Law no.20 of 2016 Concerning Trademark Article 4 Sub Article (4)
difficulty for a scent marking particular and non-visual trademark in general, to meet
the graphic representation requirement.\textsuperscript{12} In 2011, Max Planck Institute proposed
the removal of graphic representation as a requirement for trademark registration
in the wording of the European Trademark Directive,\textsuperscript{13} which indicates that graphic
representation is outdated and stifles the registration of nonconventional marks,
particularly sound, scent, and taste marks.

According to the Academic Draft \textit{(Naskah Akademik)} of Law No.20/2016
Concerning Trademarks (hereafter referred to as \textquotedblleft Academic Draft\textquotedblright),
Indonesia aims to encompass a wide range of trademarks, which include nonconventional ones
such as sound, hologram, shape, and scent\textsuperscript{14}, but still uses the traditional mode of
registration that involves a graphical representation on paper and online forms,
by which all trademark registrations can be indexed.\textsuperscript{15} Such a situation raises two
substantial questions. The first is whether or not graphical representation restrains
nonconventional trademark registration. The second question, if the answer to
the first is in the affirmative, focuses on what Indonesia should do to facilitate the
registration of nonconventional trademarks in the context of common practice, which
considers Label Merek as a graphical representation by means of images, lines, or
characters, to achieve the objective of the Academic Draft of Indonesian Trademark
Law (ITML) encompassing on conventional trademarks.\textsuperscript{16}

If competent authorities merely regard Label Merek as a graphically represented
form, as in common practice, the aforementioned objective would face obstacles in
the long run due to the difficulty of registering nonconventional trademarks with
such as requirement.\textsuperscript{17} Therefore, an important task is to determine how Indonesia
should address this issue.

With reference to recent studies and international cases, this study aims to
illustrate that graphical representation stifles the registration of nonconventional
trademarks, particularly non-visual ones such as sound, scent, and taste marks.
Moreover, this paper aims to establish that the graphical representation requirement
is immaterial and therefore, adoptable measures should be formulated so that
Indonesia can facilitate the registration of nonconventional trademarks.

The rest of this paper is organized as follows. The first part provides an account of
how each nonconventional mark (specifically non-visual trademarks such as sound,
scent, and taste marks) can differ in terms of registration. The next part examines
the use of graphic representation as trademark registration and demonstrates
through cases in the European Union (EU) and United States (US) that graphical
representation stifles the registration of nonconventional trademarks, and then
describes graphical representation in Indonesia. The third part examines the relevance
of graphic representation at presenting relation to trademark registration in the light
of recommendations by the Max Planck Institute to abolish graphic representation
and the implication of such requirement with regard to legal certainty and flexibility.
The last part examines the measures that Indonesia can take concerning the issue of
representation form for nonconventional trademark registration.

\textsuperscript{13} Max Planck Institute for Intellectual Property and Competition Law, \textit{Study on the Overall Functioning of the European Trade Mark System} \textit{[2011] 67}.
\textsuperscript{14} National Law Development Agency of the Ministry of Justice and Human Rights of the Republic of
Indonesia, \textit{Academic Draft of Indonesian Trademark Law} \textit{[2015] 21, 31 and 38}.
\textsuperscript{15} Ibid. 39.
\textsuperscript{16} Ibid.
\textsuperscript{17} \textit{cf.} Bolte \textit{(n 5) 6}.
II. CATEGORIES OF NONCONVENTIONAL TRADEMARKS

A. Sound Mark

A sound mark is also known as an aural mark or an audio signature. A sound mark may consist of songs, strings of notes with or without words, well-known and unusual sounds in nature, jingles, electronic sounds, or a combination thereof. Some examples of sound marks are the followings: Tarzan’s yell, theme song of the “Merrie Melodies” cartoon series, AT&T spoken letters, the sound of “Ooh its So Good,” and the “Sweet Georgia Brown” melody.

The likelihood of a sound mark to be registered depends on whether such a mark has a distinctive feature, which also depends on whether the average consumer will perceive the mark as a representation of a certain product. However, a mere onomatopoeia is unable to fulfill the graphical representation requirement. For example, classical music pieces may be acceptable as trademark, *prima facie*. Nevertheless, the examiners must know how such musical compositions can be perceived as a trademark. A mere sequence of musical notes does not establish a clear representation due to the low possibility of ascertaining the pitch or note duration, and is therefore unlikely to be registered.

Problems that may occur in seeking a sound trademark registration relate to graphical representation of the sound mark. In addition, whenever average consumers have any contact with a sound mark, they usually perceive such mark by hearing and not by seeing. Thus, a sound mark lacks an inherent visible form. Nevertheless, numerous legal sources have noted that sound marks can obtain a graphic representation and are thus able to be registered. The European Court of Justice (ECJ) confirms, through the *Shield Mark* case, that sound marks can be registered subject to distinctiveness and graphical representation.

B. Scent Mark

The first recognition awarded to a scent mark was in 1990, when the US Patent and Trademark Office (PTO) allowed the registration of a scent reminiscent of plumeria blossom for “sewing thread and embroidery yarn.” In the United Kingdom, “a floral/fragrance/smell reminiscent of roses” has been successfully registered for tires. Scent marks can be differentiated as having a functional smell that comes from the nature of the product and a nonfunctional smell that is not derived from the nature of the product itself, e.g., perfumes.

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18 cf. Lukose, (n 3) 205.
19 US Registration no: 2210506, a yell consisting of a series of approximately ten sounds.
20 US Registration no: 2473248, the mark consists of thirty musical notes.
21 US Registration no: 1761724, the mark consists of the spoken letters ‘AT &T’.
22 US Registration no: 200096.
23 US Registration no: 1700895.
24 cf. Lukose, (n 3) 198.
25 Ibid.
26 cf. Bolte (n 5) 23.
30 cf. Lukose, (n 3) 203.
According to Bolte, 31 scented marks can be classified into three categories: primary, secondary, and arbitrary (or accessory) scents. A primary scent is one that an average consumer buys due to the fragrance itself, for instance, a perfume. A secondary scent, such as the smell of shampoo, has another function besides its first function. The main function of shampoo is hair cleaning and the secondary is having a pleasant smell. The arbitrary or accessory scent connects matters that are known not to have a distinct scent. An example of such scent is the “smell reminiscent of roses” for tires registered in the UKPTO. The last category of scent mark has been generally seen escapable of indicating the origin of goods or services offered by an enterprise.

In terms of scent mark registration, several issues have to be emphasized. In the case of Sieckmann v. Deutsches Patent- und Markenamt, Dr. Ralf Sieckmann applied the scent mark described as “a balsamically fruity scent with a slight hint of cinnamon.” The court held that a trademark may consist of a sign, which is not in itself capable of being perceived visually but can be represented graphically. 32 Moreover, the ECJ held that the representation must be clear, precise, self-contained, easily accessible, intelligible, durable, and objective. 33 The court held that with regard to scent marks, alchemical formula described in written words cannot satisfy the requirement of graphical representation. The chemical formula represents neither the substance scent nor the substance itself. Furthermore, an odor sample is not sufficiently durable and stable. 34

C. Taste Mark

To be available for registration, a taste (or gustatory) mark must be capable of serving the function of a trademark in particular as an indication of the origin of one undertaking’s product (an essential function of the trademark). 35 For instance, the taste mark of “an artificial strawberry flavor” for medicines has been denied registration as a community trademark by the EU’s Office for Harmonization in the Internal Market (OHIM). The OHIM ruled that average consumers are unlikely to perceive such a flavor as an indication of the origin of a certain undertaking’s product in relation to that of another undertaking’s product, and consumers are more likely to think of this flavors feature that disguises the unpleasant taste of the medicine. 36

In terms of registration, the important issue is whether a taste mark can be distinguished as such to be considered as a trademark. A scent mark applying for registration needs to show that its characteristics are distinctive enough to indicate the origin of the product, which shows that the mark differs from the marks of other products. Simply put, to qualify as a trademark, a taste mark must be distinctive and able to be perceived by the average consumer as a trademark (through an indication of its product origin). 37

To be available for registration, a taste mark must prove that the proposed mark has acquired distinctiveness. However, a taste mark is unlikely to obtain distinctiveness in any jurisdiction without strong evidence to prove that the mark has acquired

31 cf Bolte (n 5) 24.
33 Ibid, para 55.
34 cf Lukose (n 3) 204.
35 cf Gibbons (n 4) 181.
distinctiveness. Different from other nonconventional trademarks, such as sound and scent marks, a taste mark can be applied only to goods and not services. A report by the World Intellectual Property Organization’s (WIPO) Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) states that the requirement of graphic representation can be fulfilled by describing the taste in writing and indicating that such a description refers to a taste mark. However, prior to the fulfillment of the graphic representation requirement, such a mark needs to satisfy conditions of non-functionality test. These conditions are highlighted in the US Appeal Board’s decision on the case of N.V. Organon.

III. GRAPHICAL REPRESENTATION IN INDONESIA, EU, AND THE US

A. Graphical Representation in Indonesian Trademark Law in the Form of Label Merek

In the free market era that Indonesia will face in 2020, solid protection of intellectual property rights is necessary. New investments are unlikely to enter Indonesia without such protection, and one way to encourage investments is by protecting trademarks.

Law No.15/2001 concerning trademarks (hereafter called the “previous trademark law”) does not provide adequate protection for nonconventional trademarks, in particular non-visual marks such as sound, scent, and taste marks. Thus, a new law is required. After 15 years of using the outdated trademark law, Indonesia introduced Law No.20/2016 concerning trademarks (hereafter called “ITML”) which took effect on November 25, 2016.

One of the rationales for introducing ITML 2016, as stated in its Academic Draft, is the significant development in the protection of nonconventional trademarks. To protect this new type of trademarks, Indonesia believes that a new law is needed, which encompasses the nonconventional trademarks, including, but not limited to, sound and scent marks. The new law covers not only the conventional marks consisting of words, devices, and logos but also nonconventional trademarks, particularly non-visual ones.

Different from the EU’s Trademark Directive 2008, which prescribes graphical representation as a requirement for trademark registration, Indonesia does not expressly state such as a requirement but rather, the use of graphical representation as a form of representation for trademark registration is derived from common practice. In other words, what is being prescribed as a minimum requirement for trademark registration is merely perceived as graphically represented form.

The Academic Draft of ITML and ITML itself prescribe Label Merek, a form by which a proposed mark is represented, as a minimum prerequisite for trademark registration under Article 13(2). However, common practice in Indonesia still regards Label Merek as a representation that consists of images, lines, or characters; in other words, a graphically represented form. ITML prescribes the proposed mark to be placed in the form of Label Merek/Mark Etiquette, which commonly requires
a graphic image affixed on a 4 cm × 6 cm column on the application form as the minimum prerequisite for registration. The trademark would be included in a trademark register for the interest of third parties. To date, no case is known of a nonconventional mark registration that initiates the use of a representation beyond graphic representation (particularly for scent and taste marks). However, under ITML, applicants are required to submit a sound recording (a new form of representation) alongside the musical notation (a graphical representation form).

According to the Academic Draft of ITML 2016, Indonesia has a non-exhaustive list of what constitutes trademarks, which aims to cover recent developments and nonconventional trademarks. The obstacle is that Indonesia does not describe how to register such marks. The Academic Draft of ITML 2016 merely describes the objective of trying to encompass nonconventional trademarks without having any clear measure on how to register such marks. Such a situation is expected because at present, the appropriate form for representing nonconventional marks, particularly scent and taste marks has yet to be found.

Requiring a graphical representation for trademark registration is likely to stifle the registration of nonconventional trademarks. Furthermore, both the Academic Draft of ITML 2016 and ITML 2016 itself do not convey any provision regarding the registration process for these new types of trademarks. The lack of option to register nonconventional trademarks may cause difficulties and legal uncertainties in registration. Legal uncertainties may discourage trademark proprietors from registering nonconventional marks due to unknown possibilities and consequences, such as whether the mark is able for registration and whether it can be used properly as a trademark.

No case of nonconventional trademark registration is known in Indonesia to date. However, adequate legal protection for nonconventional trademarks is still necessary because these trademarks are likely to have an important role in indicating the origins of certain products in the future. However, using Label Merek as merely a graphically represented form may cause problems in nonconventional mark registration. Therefore, to achieve the objective stated in the Academic Draft, Indonesia has to change the way Label Merek is perceived.

B. Graphical Representation in the EU

Community Trademark System (CTM) has been established by the EU through which a trademark registration is protected in all EU member states if the application is submitted to the OHIM. The CTM registration has no effect on national trademark rights, and parties who are seeking protection for their mark may file a trademark registration through the OHIM or their national trademark office or both.

Council Regulation on Community Trademark Article 4 imposes graphical representation as a prerequisite for trademark registration. The reason for imposing such a requirement is that, given the purpose of registration, a mark should be capable of being published and recorded. Thus, a graphic representation is required so that interested parties (competent authorities, a person seeking trademark protection, and/or an average consumer) can ascertain the monopoly extent given by

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44 Law No. 20 of 2016 Concerning Trademark Article 4 Sub Article (4)
45 Ibid., Article 4(7)
46 Ibid.
47 Cf. Lukose (n 3) 202.
48 Cf. Carapeto (n 2) 36.
the trademark on the existing mark through a search on the trademark register.\footnote{Ibid., 37.} The Sieckmann case maintained that “graphic representation had to enable the sign to be represented visually, particularly by means of images, lines or characters, so that it could be precisely identified.”\footnote{See Sieckmann v Deutsches Patent-und Markenamt (C-273/00, EU:C:2001:594)} However, a sign can be regarded as a trademark that is not in itself capable of being perceived visually provided that it can be represented graphically, particularly by means of images, lines, or characters, and that the representation is clear, precise, self-contained, easily accessible, intelligible, durable, and objective.\footnote{Ibid., H11 1}

The following are key cases concerning nonconventional trademarks in Europe: Sieckmann, Shield Mark, and Libertel. The Sieckmann case is considered as a landmark case in this area. Ralf Sieckmann applied for trademark protection for a scent mark by filing “methyl cinnamate,” a chemical formula used for various purposes in classes 35, 41, and 42, through the German PTO (DPMA). The chemical formula had a strong and aromatic odor usually contained in fruits such as strawberries. The applicant’s description of the scent as “balsamically fruity with a slight hint of cinnamon” was rejected by the DPMA. Subsequently, the applicant filed a lawsuit at the ECJ against the DPMA’s judgment. However, the ECJ upheld the DPMA’s decision on the grounds that (a) the chemical formula did not represent the odor of a substance and it was not clear and precise;\footnote{Ibid., para 69} (b) the description of the odor was not sufficiently clear, precise, and objective;\footnote{Ibid., para 70} (c) the odor sample deposit did not constitute a graphic representation and the sample was not sufficiently stable or durable;\footnote{Ibid., para 71} and (d) graphic representation was not satisfied by the chemical formula, description in written words, deposit of an odor sample, or a combination thereof.\footnote{Ibid., para 73}

The proposed mark filed at the Benelux Office for Intellectual Property used in the Shield Mark case consisted of the first nine notes of “Fur Elise” and the crowing of a rooster. The main concern in this case was whether sound could be regarded as a trademark under Article 2 of European Community Directive 89/104 and under the conditions required for graphical representation. The court ruled that sound could reconsider trademark if it was capable of distinguishing the goods or services of one undertaking from those of other undertakings and if it could be represented graphically.\footnote{See Shield Mark BV v Kist (tlaMemex) (C-283/01) [2004] All ER (EC) 277, [2005] 1 CMLR 41, [2004] Ch 97, [2004] ETMR 33, [2004] RPC 17, [2004] 2 WLR 1117, ECJ.}

The Shield Mark case decision has been interpreted using the criteria derived from the Sieckmann case that “a trademark can consist of a sign that is not capable of being perceived visually if the sign can be represented graphically, particularly by means of images, lines, or characters and if the representation is clear, precise, self-contained, easily accessible, intelligible, durable, and objective.”\footnote{Ibid., H12 2} The ECJ held that for sound marks, “the graphical representation criteria are not satisfied by a description in written language, an indication that it is the cry of an animal, a simple onomatopoeia or a sequence of musical notes.”\footnote{Ibid., H16 6} Such criteria are met “when the sign is represented by a stave divided into measures and showing in particular clef, musical notes, and...
rests whose form indicates their relative value and, where necessary, accidentals.\textsuperscript{59}

In the Libertel case, signs that were used in the application form were an orange rectangle in the space for reproducing the trademark and the word "orange" (without reference to any color) code in the space for describing the trademark.\textsuperscript{60} The application was refused and subsequently, the applicant appealed to the Netherlands Supreme Court, which referred the questions to the ECJ concerning registration of a color mark. The ECJ maintained that a color sign can be regarded as a trademark provided that it is graphically represented in a clear, precise, self-contained, equally accessible, intelligible, durable, and objective form, for instance, by using an internationally recognized identification code (criteria derived from the Sieckmann case).\textsuperscript{61} Furthermore, the proposed mark must show that it is capable of identifying the product or services for which registration is sought as originating from a particular undertaking and distinguishing that product or service from those of other undertakings.\textsuperscript{62}

Considering the EU cases that had been refused mainly because the proposed mark could not satisfy the graphic representation requirement, we can argue that the graphical representation requirement stifles the registration of nonconventional trademarks.

C. Graphical Representation in the US

The basis of trademark registration in the US is the Lanham Act of 1946, which has been amended approximately 30 times to expand the scope of what constitutes a trademark. In the US, the extent of what constitutes a trademark is vastly broader than that in Europe. So, long as the trademark is in use and has a distinctive feature, a sign is able for registration because US laws impose no limitation on what defines a trademark.\textsuperscript{63} Trademark protection in the US is slightly different from that in Europe. Trademark rights in the US are conferred on the basis of use rather than a single application-based system such as that in the EU. The primary requisites for obtaining trademark protection in the US are whether the mark is in use and whether it has a distinctive feature.\textsuperscript{64}

Nevertheless, limitations remain on the protection extent for nonconventional trademarks. In the US, scent is capable of performing an essential function as a trademark, which is to indicate the origin of the product. Such a situation is exhibited by the USPTO’s approval of the registration of “a scent reminiscent of plumeria blossoms” for sewing thread and embroidery yarn with the rationale that this particular mark has gained a distinctive character through use and is therefore capable of functioning as a trademark.\textsuperscript{65} Trademark practice in the US provides a system that allows nonconventional marks, which are not functional but have distinctiveness, to be registered only on the Supplemental Register.\textsuperscript{66} The functional doctrine prevents trademarks from protecting a sign that performs a function of the product for which registration is sought; thesis the domain of patent law.

\textsuperscript{59} Ibid., H15 5.
\textsuperscript{60} See LibertelGroep BV v Benelux-Merkenbureau (Case C-104/01).
\textsuperscript{61} Ibid., H4 1.
\textsuperscript{62} Ibid., H6 3.
\textsuperscript{64} Cf. Carapeto, (n 2) 34.
\textsuperscript{66} Cf. Carapeto, (n 2) 35.
Although the ECJ held that “balsamically fruity with a slight hint of cinnamon,” which describes the chemical methyl cinnamate in the Sieckmann case, was unlikely to satisfy the graphical representation requirement, and therefore refused registration, the USPTO accepted the registration of “a high-impact, fresh floral fragrance reminiscent of plumeria blossom” for sewing thread and embroidery yarn. In the Clarke case, the Trademark Trial and Appeal Board (TTAB) maintained that a scent can perform as a trademark for sewing thread and embroidery yarn. The applicant Celia Clarke appealed the USPTO decision to refuse the registration of her scent mark, which was used on sewing thread and embroidery yarn. The TTAB ruled that the scent used in association with the yarn did not inherently come from the product itself but was a feature provided by the applicant. The average consumer would not expect the yarn to have such a distinctive scent and the yarn would still function in the same manner even without the distinct scent affixed to it; thus, the scent would qualify for registration of trademark. Such a success was also due to the use of Clarke’s trademark in the market. Clarke used advertising to inform and educate the average consumer that the scent was a brand of her product, and therefore, the consumer associated the scent with the product. The aforementioned factors were the rationale for why Clarke’s scent mark was eligible for trademark registration.

The US representative conveyed, on the 17th Session of the WIPO SCT, that “the threshold issue of how to represent these ‘signs’ graphically in an application and subsequently, how to search them when examining for conflicting applications and registrations, should not be the sole reason for not accepting these marks for registration.” This statement implies that rejecting nonconventional trademarks, particularly those of non-visual ones (sound, scent, and taste marks) based on the description requirement, is implausible.

Other samples of successful registration of nonconventional trademarks in the US, mostly in the Principal Register, are the following: (1) a “flowery musk scent” for retail store services featuring communication products and services and consumer electronics in class 35; (2) “the scent of bubble gum” for shoes, sandals, flip flops, and accessories in class 25; (3) “the scent of piña colada” for musical instruments in class 15; (4) “a rose oil scent of fragrance” for advertising and marketing in class 35; and (5) “the scent of strawberry” for toothbrushes in class 21.

Numerous nonconventional trademarks, particularly non-visual ones, have been registered in the US because the country does not require graphical representation for trademark registration. The Lanham Act merely prescribes that the proposed mark be in use and capable of functioning as a trademark (including having a distinctive feature) to be able for registration.

IV. IS GRAPHICAL REPRESENTATION STILL RELEVANT?

A. Graphical Representation Stifles the Registration of Nonconventional
Trademarks

Several cases have demonstrated how graphical representation stifles the registration of nonconventional trademarks, particularly non-visual ones. However, the graphical representation requirement for trademark registration is adopted in domestic laws in many countries. Many countries have laws that require graphic representation for a proposed mark to be regarded as a trademark even though such graphic representation is not mandatory under the World Trade Organization (WTO) Agreement on Trade-related Aspects of Intellectual Property Rights (TRIPS). Article 15 of the TRIPS Agreement allows WTO member countries to decide whether or not to adopt graphical representation in their domestic laws by stating that "members may require, as a condition of registration, that signs be visually perceptible." Such a provision implies that sound, smell, and taste marksman be excluded from registration regardless of how distinctive those marks are. To be able for registration, a proposed mark must be able to be represented graphically and such capability must be displayed on the application form. Graphic representation is a crucial part of trademark registration as it defines the proposed mark. Furthermore, graphical representation is treated as a reference on the extent of monopoly of the mark. The graphical representation enables the mark to be represented visually and thus be precisely identified. Such a requirement is designed to cover visual and non-visual marks. Therefore, the graphical representation requirement is merely procedural or technical condition for trademark registration.

Graphical representation has been regarded as an important aspect of trademark registration for years. The rationales for why graphical representation is a prerequisite of trademarks in the first place is that it determines the extent of protection of such mark conferred by trademark right, thereby making such mark accessible to competent authorities (in terms of registration application examination, publication, and maintenance of the trademark register) and the public, particularly economic operators (in terms of knowing the registration or application for registration made by the competitor and having access to information on the rights of third parties and acting accordingly).

The landmark Sieckmann case has set certain criteria, known as the Sieckmann criteria, which influence all subsequent cases of nonconventional trademark application after 2002. The Sieckmann case shows a clear implication that the scent mark is regarded to be incapable of satisfying graphic representation, and thus cannot be registered. Shortly after the Sieckmann case ruling, the OHIM Board of Appeals held that the taste mark could not satisfy the graphical representation requirement either. The OHIM and/or EUIPO used the ruling on the Sieckmann case as a stopping mechanism because all the proposed scent and taste marks were considered as “non-submitted” and therefore not being examined any further. The Fourth OHIM
Board of Appeals decided that after the *Sieckmann* case ruling, no further room for interpretation would be allowed concerning graphical representation for scent mark applications.86

Another implication of the *Sieckmann* case is the issue incurred by the valid and existing registration for a scent mark for “the smell of fresh cut grass” in a tennis ball,87 which was registered in October 2000, two years before the ruling on the *Sieckmann* case. The *Sieckmann* case further implies that after the ruling, registering a scent mark was practically impossible due to the incapability of satisfying the graphical representation. The registered scent mark of “the smell of fresh cut grass” was not declared invalid after *Sieckmann*, but it expired in 2006 because the application was not renewed. The proprietor may have allowed the mark to expire because of the complexity of its legal situation.88

B. Recommendation to Abolish Graphical Representation by Max Planck Institute and Abolition of Graphical Representation in Trademark Directive 2015

In July 2009, the European Commission (EC) invited research institutions to study the overall functioning of the Trademark System in Europe.89 The invitation indicated the need to reform the system and implied doubts concerning the relevance of graphical representation in nonconventional trademark registration.90 The EC asked the question “To what extent is the required capability of being represented graphically still a relevant and appropriate requirement for a sign to qualify as a trademark with regard to nontraditional trademarks? What could be appropriate alternative requirements to establish instead of it?”91

The research institution that obtained the contract to conduct the study was Max Planck Institute.92 The Institute opined that graphical representation was extremely restrictive and involved problems concerning legal certainty in relation to nonconventional trademark registration, and that another preferable ways available to represent nonconventional trademarks. According to the Institute, “The fact that Article 4 CTMR and Article 2 TMD in their present form demand graphical representation instead of being open for other forms of representation is often criticized as too restrictive. Whereas the issue has become moot where feasible ways of graphical representation have been identified through case law and practice, there is still considerable uncertainty with regard to some categories of nontraditional marks, like mere sounds (by contrast to musical tunes), smells, tastes, or haptic marks. Furthermore, in cases such as musical tunes and sound marks, representation by other than graphical means (e.g., by sound recordings) may even be preferable to mere graphical representation, if it allows for a more precise identification of the mark and thereby serves the aim of enhanced legal certainty. Apart from that, however, to allow for more flexibility with regard to the means of representation should not...
grant dispense from the basic concept underlying the list of criteria enunciated in the *Stickman* case. Whereas they do not have to be repeated literally, those principles should be expressed in the law in a general form.\(^93\)

After having reviewed the relevance of graphical representation with regard to nonconventional trademark registration, Max Planck Institute proposed to dispense graphical representation as a prerequisite for trademark registration: “The Study proposes that the requirement of graphical representation should be deleted from the wording of the relevant provisions so as to not bar the option for developing new ways of representation which may be equally informative and reliable. However, this should not detract from the level of legal security prescribed in the ECJ’s *Sieckmann* judgment (C-273/00).”\(^94\) The latter sentence does not necessarily mean that all of the *Sieckmann* criteria\(^95\) need to be established, but rather the legal certainty brought upon the *Sieckmann* case should be sustained.\(^96\) Nevertheless, the Max Planck study suggested that the set of criteria raised in *Sieckmann* should not be removed.

After the Max Planck Institute’s proposal on April 21, 2015 to remove the graphical representation in the relevant provisions, the reform of the EU Trademark System has been agreed upon. The changes that occurred in the provision are described in the following.

Prior to the amendment, the Trademark Directive 2008 provides that “[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.”\(^97\)

After the amendment of the EU Trademark System, Article 3 of Trademark Directive 2015 now reads: \(^98\) “A trade mark 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: (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.”

Furthermore, Recital 13 of Trademark Directives 2015 (replacing the old Recital 8 of Trademark Directives 2008) states: “To this end, it is necessary to list examples of signs which are capable of constituting a trademark, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings. In order to fulfill the objectives of the registration system for trademarks, namely, to ensure legal certainty and sound administration, it is also essential to require that the sign is capable of being represented in a manner which is clear, precise, self-contained, easily accessible, intelligible, durable, and objective. 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

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\(^93\) cf Max Planck Institute for Intellectual Property and Competition Law (n 7) 67 2.13.

\(^94\) Ibid, Para 59.


\(^96\) cf Friedmann (n 80) 935.

\(^97\) Trademark Directive 2008 Article 2.

\(^98\) Trademark Directive 2015 Article 3.
guarantees to that effect."\textsuperscript{99}

\section*{C. Legal Certainty vs. Flexibility?}

Recital 13 of Trademark Directive 2015 states that the removal of graphic representation will result in the increase of legal certainty and flexibility.\textsuperscript{100} Bolte\textsuperscript{101} argues that such a claim is legitimate, although commonly, the relationship between legal certainty and flexibility is contradictory. Such result is expected to take effect by placing the wording of “generally available technology” when representing trademarks; however, the representation must be of “appropriate form.”

The term “generally available technology”\textsuperscript{102} increases the flexibility with regard to nonconventional trademark registration by allowing other forms of representation that can be available to the applicant who seeks trademark protection. Moreover, such wording is not limited by a certain time, which implies that generally available technology refers to any available technology at the time of the interpretation of the recital. For instance, if the recital is construed in 2035, the generally available technology refers to the technology available in that particular year. Thus, new forms of representation may emerge over time, which would result greater flexibility because the directive would not have to be amended every time a new technological development that can be used for trademark representation arises.\textsuperscript{103}

On the other hand, the wording of “appropriate form” in Recital 13 of Trademark Directive 2015 maintains the legal certainty of the trademark registration system. The wording ascertains that representations should still be adequate and suitable even if such representations used generally available technology.\textsuperscript{104} The representations are regarded as being inappropriate form if they satisfy the Sieckmann criteria prescribing that the representations must be clear, precise, self-contained, easily accessible, intelligible, durable, and objective.\textsuperscript{105}

Permitting new forms of representations for trademark registration would most likely increase legal certainty as the representations become more precise than previous representations. For instance, the representation through mere musical notation for sound mark is not regarded as legally certain because the notation is more imprecise and less intelligible than the reproduction of the sound itself when perceived by the average consumer. Removing the graphical representation enables the applicant to easily assure the average consumer about the monopoly extent of the sign conferred by trademark rights.\textsuperscript{106}

Trademark Directive 2015 paves a way for new forms of trademark representation. In case the new forms lack qualities, the set of criteria prescribed in the Sieckmann case needs to be complied with. Scent and taste marks maybe represented through the medium of technology, which is expected to be generally available to the public. However, the representation forms of these marks may lack clarity and precision because the average consumer would have difficulty ascertaining the monopoly extent.

\textsuperscript{99} Ib\textit{id}, Recital 13.

\textsuperscript{100} Legislators foresee that by removing graphical representation entails the increase of both legal certainty and flexibility.

\textsuperscript{101} cf Bolte (n 5) 49.

\textsuperscript{102} See Recital 13 of Trademark Directive 2015.

\textsuperscript{103} cf Bolte (n 5) 49.

\textsuperscript{104} Ibid.


\textsuperscript{106} Ibid 50.
of the mark by examining the representation. Such a situation will have an adverse
effect on the legal certainty. Thus, the technology used for representation should be
continuously developed so that inappropriate form to represent nonconventional
marks, particularly non-visual ones, would be found.107

V. MEASURES CONCERNING LABEL MEREK/MARK ETIQUETTE IN INDONESIA

ITML prescribes Label Merek as a minimum requirement for trademark
registration, which, in common practice in Indonesia, solely considered as a graphically
represented form consisting of images, lines, or characters.108 This perspective could
cause problems because graphical representation is likely to stifle the registration
of nonconventional marks, particularly non-visual ones, as demonstrated in the
preceding sections.

The author of this paper believes that to achieve the objective of ITML, which
is to encompass the protection of nonconventional trademarks, 109 Label Merek as
a requirement for trademark registration must be interpreted broadly beyond the
graphically represented form to encompass the representation form that has yet
to be known. The Academic Draft of ITML expressly stated that Label Merek was a
sample of a mark. Therefore, the sample does not necessarily have to be in graphical
form but could be represented in other forms not limited to graphic representation;
for instance, submitting a sound recording (alongside a musical notation)110 that has
been accepted as a suitable form of representation for registering sound marks in
Indonesia. When Label Merek is not construed broadly in conducting trademark
registration, other new forms of representation, particularly for nonconventional
marks, are not likely to be refused registration because such forms are not stipulated
in ITML or have never been used previously in Indonesia.

Competent authorities should not consider trademark registration merely in
relation to graphically represented form because doing so would stifle nonconventional
trademark registration. Rather, competent authorities must see beyond common
practice and not directly refuse the registration of other forms of representation for
certain proposed marks merely because these marks are uncommon, have never been
used, or no such representation form is stipulated under ITML. Furthermore, construing
Label Merek broadly can enable the law to encompass forms of representation using
technology that have yet to be developed but may soon be available to the public. Thus,
the law need not be amended every time other trademarks and representation forms
are introduced, thereby increasing the flexibility of relevant laws.111

However, such representation must be suitable so that problems can be prevented.
To ascertain if form of representation is suitable, the “appropriate form” concept
stipulated under Trademark Directive 2015112 can be adopted. To safeguard the legal

107 Ibid.
108 Common practice in Indonesia perceives Label Merek as a representation form which consists of
lines, images, and characters. Such form must be placed on a 4 cm x 6 cm column affixed on the application
form. The purpose is for the third party to be able to ascertain the monopoly extent of the trademark by
looking at the trademark register.
109 cf National Law Development Agency of the Ministry of Justice and Human Rights of the Republic of
Indonesia (n 13) 38.
110 Law No. 20 of 2016 concerning Trademark Article 4 Sub Article (7).
111 cf Bolte (n 5) 49.
certainty, the criteria introduced by Sieckmann\(^\text{113}\) must be used as conditions to be satisfied prior to trademark registration. Indonesia can decide which criteria are needed to be set as conditions to ascertain the suitability of the form of trademark representation.

Construing *Label Merek* broadly to encompass other representation forms, which are not limited to graphically represented forms, paves the way for the protection of scent and taste marks, which are non-graphical in nature. However, at the moment, the technology that can provide the appropriate form of those non-visual marks is not yet available. Although the Academic Draft of ITML states the need to protect nonconventional trademarks, particularly scent and taste marks, the new Trademark Law of Indonesia has yet to protect such nonconventional marks because registering such marks is not yet a common practice.\(^\text{114}\) Nevertheless, the notion of protecting scent and taste marks should not be ruled out just yet, because technology that can be used for the appropriate form of representation is continuously developing. Interpreting *Label Merek* not merely as a graphically represented form leads to the theoretical possibility for scent and taste marks to be protected by the Trademark Law of Indonesia.\(^\text{115}\)

### VI. CONCLUSION

Nonconventional trademarks (particularly sound, scent, and taste mark), which are non-graphical in nature, are likely to face challenges when graphical representation is set as a requirement for trademark registration. This condition is demonstrated by cases in the EU, where graphical representation is a major problem in nonconventional trademark registration. Furthermore, the indication that graphical representation is outdated and stifles the nonconventional trademark registration is shown by the Max Planck Institute’s proposal to remove graphic representation as a requirement for trademark registration, followed by its removal under EU Trademark Directive 2015. Conversely, in the US, the registration of nonconventional trademarks seems more acceptable than that in the EU because the US does not implement graphical representation under its trademark law. Indonesia, under Law No.20 of 2016 concerning trademarks, does not expressly state that graphical representation is a requirement for trademark registration. The use of graphical representation as a requirement for trademark registration is derived from common practice. *Label Merek* as a minimum requirement is merely regarded as a representation form that consists of lines, images and characters (in other words, a graphically represented form in common practice). Seeing *Label Merek* merely as a graphically represented form is likely to stifle the registration of nonconventional trademarks. Therefore, *Label Merek* needs to be construed broadly beyond the graphically represented form to encompass the protection of nonconventional trademarks.

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\(^{114}\) cf National Law Development Agency of the Ministry of Justice and Human Rights of the Republic of Indonesia (n 13) 21, 31 and 38.

\(^{115}\) cf Bolte (n 5) 46.
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