
Non-Conventional Marks: The Future of Trademarks

*Mrs. Reshma Nikhil Pai Angle

What is a Trademark?

Trade mark is one of the branches of Intellectual Property Rights. A trademark is a brand name. It is a weapon in the hand of registered proprietor or owner of the mark to stop other traders from unlawful use of the mark.

A trademark identifies the source of one seller's goods and distinguishes those goods from similar goods of other sellers. A trademark is an identifying symbol in the form of a word, pictorial representation or a label applied to goods or services with a view to indicate to the consumers that the goods are manufactured by a particular person and conform to a certain quality. It gives the buyer an assurance of the make and quality of the article he is buying.

A trademark performs the following functions:-

1. It identifies the product and its origin and distinguishes them from other seller's goods
2. It assures quality
3. It advertises the product
4. It creates an image for the product and the trade mark in the minds of the consumers thereby creating goodwill for the product as well as the manufacturer

S. 2(zb) of the TradeMarks Act, 1999 defines a "Trademark" as – "trade mark means a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others and may include shape of goods, their packaging and combination of colours."

Going further, S. 2(m) of the TradeMarks Act, 1999 defines a "Mark" as – "mark includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination thereof"

Thus, 'trademark' is defined primarily as a mark which is capable of being represented graphically and which can distinguish the goods or services of one person from the other. The definition of "mark" says that it may include shape of goods, their packaging and combination of colours. Thus, for a 'trademark' to get registered it must be a graphical representation having attributes to distinguish the particular goods from similar goods of another manufacturer.

Essentials of a Trademark

The basic requirements which need to be fulfilled for a mark to be called as a valid trademark are:

1. Distinctiveness: It must be distinct. Distinctiveness is some quality in the trademark which earmarks the goods as distinct from goods or services of other manufacturers.
2. Graphical representation: It must be capable of being represented graphically. Graphical representation is a *sine qua non* for a trademark registration in India. The mark must be able to be produced in a physical form and represented in a 'paper form'. Though the Trademarks Act, 1999 provides for registration of shape of goods, packaging and colour combination as trademarks, it does not cover smells, sound, taste and holograms as trademarks even though they add to the distinctiveness of the mark. Graphical representation of the mark means such representation of the mark as can elucidate the mark itself in order to determine the subject of protection provided by the registered mark to its proprietor. Rule 25(12)(b) of the Trademarks Rules, 2002 mandates the graphical depiction of the mark in an application for trademark registration while Rule 28 & 30 requires that it be represented on paper in a durable form. This requirement often acts as an impediment to the recognition of non-conventional trademarks in India.

Non-conventional Trademarks

Non-conventional or non-traditional trademarks are relatively new on the Intellectual Property scene. Any mark that does not come under the traditional categories of trademarks such as letters, words, logos, numerals, pictures, and symbols may be termed a non-conventional trademark. These trademarks are exceptional and unique in nature because unlike their traditional counterparts, they are sometimes non-ocular eg., sound, smell, feel and taste; some are non-static eg., moving image marks and digital marks; while others are gestures and holograms. These marks have revolutionized the fields of trademark law as well as marketing. Some of these have in recent times been more widely accepted due to legislative

* Assistant Professor, S.S. Dempo College of Commerce & Economics, Cujira, Bambolim, Goa

changes and the broad-mindedness of the judiciary, eventually expanding the definition of the term 'trademark'. Non-conventional trademarks therefore consist of marks which originate from shapes, sounds, smells, three-dimensional shape, tastes and textures.

Types of non-conventional trademarks:

1. Sound Trademark: A sound trademark is a non-conventional trademark wherein an audio clip performs the function of a trademark of uniquely identifying the commercial origin of products or services. Internationally, the most celebrated case is that of Metro Goldwyn Mayer (MGM) Corporation who had applied for the registration of a sound, that of a Lion roaring, by submitting a sonogram for the "Lion's roar". The application interestingly, though refused in the European Union, was granted in the US. The first sound mark to be registered was in USA for the chime of NBC entertainment. Some of the other famous registered sound marks are that of Nokia's tune, Intel's five – tone sound, Time warner – Looney Tunes theme, Pillsbury – Dough boy's giggle, American Airlines – "Ding" for flight attendant, Twentieth Century Fox – Starting Drum Roll, etc.

The Trademarks Act does not expressly exclude sound marks from registration, neither does it emphasize that a trademark must be visually perceptible. The Act provides only that the trademark must be "capable of being represented graphically" besides being distinctive. A trademark may also consist of a sound and musical notes, with or without words and qualify, prima facie, for acceptance provided there is evidence of distinctiveness.

2. Colour Trademark: Colour combined with words, designs, symbols, logos and other such distinguishable signs have traditionally qualified for a trademark, but whether any colour by itself is eligible has been a topic of debate. The distinctiveness of colours in trademarks and the ability to differentiate between different shades of a same colour has been often disputed.

The concerns are that if a particular shade of a colour was protectable, it would lead to lengthy trademark infringement suits over 'shades' of colour which would delay the process of trademark registration. Another hindrance to recognizing colour as a trade mark was the 'Functionality Doctrine' which states that a colour cannot be a trademark if the colour is functional in nature. However, there is no clear-cut definition for functionality. For example, the smell of lemon for garbage plastic bags; the smell itself though distinctive, can also be functional because it also camouflages the smell of waste and garbage. Some examples of colour trademarks include the colour purple for Cadbury's Chocolates, the colour magenta for T-Mobile, and the colour orange for the mobile operator Orange.

In India, in case of colour marks, the Act recognises the role of colours in adding distinctiveness to a mark by providing that if a mark is restricted to a particular colour, this fact will be considered when determining its distinctiveness. However, whether a colour by itself is entitled to protection as a mark still remains a grey area. The onus lies on the applicant to provide substantial evidence and prove that the said colour or combination of colours is solely associated with them and exclusively designates their goods and that the consumer associates the colour with those goods and to show that the colour has acquired distinctiveness or secondary meaning. In case of marks which are not inherently distinctive, brand owners can still apply for a trademark if they can prove that the mark has acquired distinctiveness due to usage over a long period of time. Although the Act does not specifically provide for the registration of a single colour as a trademark, it does not expressly prohibit it also. However, in practice, a combination of colours having a distinguishing feature stands a better chance of registration.

3. Smell/ Scent/Olfactory Trademark: Smell is said to be one of the most powerful types of human memory which is increasingly being used by manufacturers to boost their sales. This is done by associating pleasant scents with the products they sell and this becomes the trademark identifying the goods in the eyes of the buyers. The first smell mark to be registered was in the United Kingdom by Sumitomo Rubber for "a floral fragrance or smell reminiscent of roses as applied to vehicle tires". Other examples of famous smell or olfactory marks include 'strong smell of bitter beer', 'smell, aroma or essence of cinnamon' for furniture and parts and fittings, 'smell of fresh cut grass' for tennis balls, etc. The Sieckman case was the landmark case for the registration of olfactory trademarks. In *Sieckmann v Deutsches Patent- und Markenamt* case, Mr Sieckman filed an application to register "balsamically fruity smell with a slight hint of cinnamon" by providing a chemical formula of the smell along with an odour sample of the chemical sign in a container. The German Patent Office and later on in appeal, the European Court of Justice both rejected the application by saying since it could not be represented graphically it did not satisfy the meaning of a trademark and that a chemical formula would not meet the graphical

representation criteria because it did not represent the smell, rather it represented the substance. It also said that the general public would not understand the chemical formula as a smell. It further stated that the chemical structure and makeup of the sample provided could begin to change and degenerate with the passage of time due to various factors and this could lead to a change in the smell of the deposited sample which would make the sample useless.

The US and EU positions are the same when it comes to smells inherent in the product itself; both jurisdictions do not allow registration of such a mark.

In India olfactory marks though not expressly prohibited, follow the same position as the EU and the US for smell to be registered i.e., as long as there is graphical representation and distinctiveness of the mark it is registered. However in India there have been no smell trademarks registered.

Smell/scent /olfactory trademarks however are generally less in number as compared to other non-conventional trademarks. This is due to many reasons: Firstly, representing the mark graphically is almost impossible which proves as an obstacle to registration. A commonly used form of “graphical representation” of a scent is describing the smell as a chemical formula. However, writing the chemical formula for a smell would represent the substance rather than the smell of that substance. Secondly, to register a smell mark the applicant must also be able to visually represent the scent mark and must prove its distinctiveness from the product itself, which is another herculean task as proving distinctiveness between two smells is very confusing. Thirdly, a bottled sample of the smell if given for registration would decay over time and could therefore not be kept on a trademark register. Fourthly, an additional obstacle to registration of smell marks is that the smell must not result from the nature of the goods itself. This was the ground for rejecting an application by Chanel to register its well-known No. 5 fragrance as a smell mark in the United Kingdom – the scent of the perfume being the very essence of the product. However, there have been some cases where smell mark descriptions have passed the distinctiveness test and were successfully registered: a Dutch company’s tennis balls with the scent of newly mown grass; and UK registrations for tires with “a floral fragrance/smell reminiscent of roses” and darts with “the strong smell of bitter beer.”

4. Motion/Moving Image Trademark: Motion trademarks are also known as animated marks, moving marks, or movement marks. Moving images in the form of a film clip, video, animation, logos, etc. also qualify for trademarks in some countries. For eg., the roar of a lion in a MGM cartoon/film is registered as a motion mark. The requirements of a motion trademark however involve the detailed description of the various components or elements of the trademarks and their interaction with each other explained in a sequence of steps.

Motion marks are the most common of the multimedia marks. The 20th Century Fox Film Corporation logo (US), Lamborghini moving image trademark for car doors opening and turning upward (EU), Kraft Foods UK Ltd. moving image trademark for chocolate and chocolate confectionery (UK) are some of the moving image trademarks registered internationally.

5. Hologram Trademarks: Holograms have been used for security purposes on credit cards, concert tickets, certain currencies etc. since a long time to prevent counterfeiting and fraudulent replication, as replication of a hologram is more difficult. The basic requirements for a trademark registration of distinctiveness apply to a hologram too. However, the difficulty arises in graphically defining the mark during trademark registrations. Holograms by their very nature possess multiple images or colours that are visible only when viewed from different angles. This makes it difficult to capture the hologram in paper form, as the paper print is not able to show the movement of the images. The image may work electronically, but on paper, the published mark will only be a figurative mark i.e., a substitute of the mark itself which needs graphical representation and adequate written description in order to succeed in registration. Applicants face difficulty in describing the hologram in as much detail as possible, and providing visual views of the hologram in various frames with descriptions of angle and appearance.

6. Touch/Feel/Tactile mark: Products sometimes, are manufactured in such a way that the goods or their packaging have a particular sensation to the touch, which distinguishes them from those of competitors. This particular feel reflects the quality of the product as well as sometimes the origin. For example, ‘tissues that are particularly soft or moist or products that may be held in the hand more comfortably’ describe a touch mark. The difficulty however arises in representing the touch mark graphically.

7. Taste/Gustatory mark: The manufacturers of some goods consider the flavor/taste of their products as being a trademark of the company, and the recipes often are closely guarded trade secrets. However, in

some cases it becomes difficult to distinguish between the natural flavor of a product and the recipe adopted by a manufacturer to distinguish its goods from those of competitors. For eg., the flavor of Cola drinks. Taste being very subjective, it sometimes becomes extremely difficult to define and compare one taste with another.

8. **Shape Marks:** The Trade Marks Act, 1999, includes shapes and packaging of goods in the definition of trademarks as long as it is capable of being represented graphically and is able to distinguish goods and services of one person from those of another. Three dimensional marks or shapes which are distinctive have been registrable as trademarks since 1996. However, statutory protection for the same was granted since 2003. Shape marks are not considered to be inherently distinctive in nature. The applicant has to prove that the shape of the mark has acquired distinctiveness

Along with the other conditions that a trademark needs to fulfill for registration, shape marks are required to fulfill following conditions:

1. The shape should not result from the nature of the goods themselves. For example, the shape of a water bottle
2. The shape should not be such that it would be necessary to obtain a technical result. Eg., shape of a hammer or knife
3. The shape should not be such that it gives substantial value to the goods. This excludes aesthetic shapes or shapes which add value either in the design or appearance of the goods
4. The shape has to be unique for registering on 'intent to use' basis. This can be done by providing evidence of distinctiveness acquired by use and that the shape mark is solely associated with that industry, through trade magazines, catalogues and industry specific publications.

One difficulty involved in registration of shape marks is whether the shape of goods may be protected under the Designs Act or Trademark Act, as the definition 'design' under the Indian Designs Act, 2000 excludes trademarks.

9. **Trade Dress:** Trade dress refers to features of the visual or sensual appearance of a product that may also include its packaging, shape, combination of colors which may be registered and protected from being used by competitors in relation to their business and services. The characteristic includes their shape (3 dimensional), packaging, color, graphic design of the product. Trade dress protection is intended to protect consumers from packaging or appearance of products that are designed to imitate other products. For eg., Apple Inc. recently secured the registration over the design of its flagship Apple Stores as trade dress.

Trade Dress may get protection as a trademark if it creates the overall look and feel of a brand in the marketplace, or if the consumer really believes that the trade dress is a source

Position in India

In India, non-conventional trademarks are relatively new on the Intellectual property arena. The new trademark rules, 2017 have ushered in a new era for registration of unconventional marks in India. Sound marks can now be registered by submitting a sound clip along with the musical notations. The first sound mark to be granted in India was for the Yahoo "yodel" in 2017, and ICICI bank is the first Indian entity to get its jingle registered as a sound mark. Britannia 'Goodday' biscuits jingle "Ting, ting di ting" is another famous sound mark.

Colour marks can be registered by submitting a reproduction of that combination of colors. The onus is on the Applicant to show that the colour or sound has acquired distinctiveness or secondary meaning due to continuous *bona fide* usage. However, as far as smell mark are concerned, there the Act does not have any provision for registration.

The Trademarks Act specifically provides for the registration of the shapes of goods, packaging and colour combinations as trademarks. Although it does not specifically mention smells, sounds, tastes and holograms, the prevailing legal opinion seems to suggest that the definition of a 'trademark' is wide enough to include non-conventional marks.

In the case of *Colgate Palmolive Company v Anchor Health and Beauty Care Pvt Ltd.* the court observed that a colour combination is a 'trademark' within the definition of the act, as there is no exclusion in the definition and even a single colour is entitled to protection under the law of passing off. This dispute concerned the defendant's colour combination of red and white in respect of dental products, which was similar to the plaintiff's colour combination of one-third red and two-thirds white on its product container.

However in the case of *Cipla v MK Pharma* the court diverged from the view expressed in Colgate Palmolive and held that a single colour or a colour combination is not a trademark and is incapable of protection under the common law of passing off. The plaintiff claimed that its blister packaging containing a distinctive orange-coloured, oval-shaped tablet constituted a trademark. However, the judge was of the view that “even if there has been deliberate copying of the similar colour and shape of the plaintiff’s tablets, that would not amount to passing off, since colour and shape are not indicative of the drugs, neither are they associated with the trade mark”.

Conclusion

Intellectual property law, in India in particular, has come a long way and has gathered a lot from the experiences of the European Union and the USA intellectual property regimes. Sometimes, even where conventional marks do not get registered, today unconventional marks get registered as trademarks.

However, in spite of all this, the hurdle of graphical representation and establishing uniqueness and distinctiveness still prevails which makes registration of non-conventional trademarks much more stringent as compared to other countries, and proves to be a deterrent in the registration of non-conventional trademarks.

In today’s digitalized and highly globalized world, use of non-conventional trademarks is bound to increase with advances in technology and means of communication. Hence, increase in registration of non-conventional trademarks, recognition of smell marks in India, would lead to a new breakthrough in the world of Intellectual Property and would give people a chance to protect the unique and distinct character of their trademark without having to worry about infringement.

References:-

1. <https://rostrumlegal.com/journal/non-conventional-trademarks-analysis-of-the-indian-structure/> as accessed on 08-04-19 at 6.45 pm
2. <http://www.mondaq.com/india/x/39286/Trademark/Flavor+Fragrance+and+Sound+Whether+Registrable+as+Trademarks+Under+Indian+Trademark+Law> as accessed on 08-04-19 at 6.50 pm
3. <http://www.mondaq.com/india/x/472602/Trademark/NonConventional+Trademarks+in+India> 15-01-19
4. <http://www.mondaq.com/india/x/597356/Trademark/unconventional+trademarks+in+india> as accessed on 08-04-19
5. <http://www.intepat.com/blog/trademark/smell-trademarks-india/> as accessed on 23-11-18 at 5.45 pm
6. http://www.legalserviceindia.com/articles/collour_marks.htm as accessed on 23-11-18 at 8.45 pm
7. <https://selvams.com/blog/aural-and-olfactory-marks> as accessed on 18-11-18 at 9.35 pm
8. http://www.wipo.int/wipo_magazine/en/2009/01/article_0003.html as accessed on 18-11-18 at 5.30 pm
9. Sieckmann v Deutsches Patent- und Markenamt (Case – C-237/00)
10. <http://trademarklawindia.blogspot.com/2011/12/smells-or-scents-as-trademarks.html> as accessed on 18-11-18 at 6.35 pm
11. http://www.pmgip.com/trademark_registration_for_shape_mark.html 16-04-19
12. <http://www.mondaq.com/india/x/612218/Trademark/The+Shape+Mark+Conundrum+Vis+Vis+Acquired+Distinctiveness> 16-04-19
13. <http://www.mondaq.com/india/x/262928/Trademark/Trade+Dress+Concept+And+Indian+Practice> as accessed on 16-04-19 at 9.45 pm
14. <https://trademarks.justia.com/858/70/yahoo-85870007.html>
14. Colgate Palmolive Company v Anchor Health and Beauty Care Pvt Ltd 2003 VIII AD Delhi 228

#####