

NON TRADITIONAL TRADEMARKS: AN UNPROTECTED ARENA BY PROF. NIKHIL KASHYAP & PRIYANKA GHAI *

Abstract

The scope of Trademarks has been greatly broadened by globalization and commercialization of knowledge. Conventionally, a traditional trademark requires visual identification and graphical representability and it mainly comprises of a name, word, phrase, logo, symbol, design, image, or a combination of these elements. However, since the late 1990s unconventional trademark forms are gaining recognition in the commercial world and are being used to supplement the conventional trademarks. Though most of the activity has been noticed in trademarks, copyright is also being used as a tool for protection of unconventional fields of trademarks. The inconsistent recognition to non traditional trademarks has led to a state of ambiguity for the consumers.

Through this paper the authors make an attempt to understand the International as well as the national position with regard to protection of the non conventional trademarks. Further it also deals with all the major non conventional trademarks and their position of registrability in USA, European Union and India. The authors will be concluding with the consolidation of rules on the basis of inconsistent recognition for nontraditional trademarks.

I. Introduction

Globalization and commercialization of knowledge have really broadened the scope of intellectual property. With every passing day, the ambit of trademark protection law is being broadened all over the world¹. Conventionally, a traditional trademark comprises a name, word, phrase, logo, symbol, design, image, or a combination of these elements. However, since the late 1990s unconventional trademark forms such as sounds, signs, tastes, touch and smells are gaining more importance. In France, notably, music and sounds have been eligible for trademark for the last few years². Though most of the activity has been noticed in trademarks, copyright is also being used for protection of unconventional fields, and strong possibilities of such developments in the future are being predicted in the area of patents as well.³

* ASSISTANT PROFESSOR, AMITY LAW SCHOOL CENTRE-II, AMITY UNIVERSITY, NOIDA CAMPUS, UTTAR PRADESH, INDIA and LECTURER, AMITY LAW SCHOOL CENTRE-II, AMITY UNIVERSITY, NOIDA CAMPUS, UTTAR PRADESH, INDIA

¹ Sudipta Bhattacharjee and Ganesh Rao, *The Broadening Horizons of Trademark Law- Registrability of Smell, Sports Merchandise and Building Designs as Trademarks* JIPR 10 (2) 119-126 (2005).

² Florent Latrive Liberation, *The smell of cut grass privatized* (25 Dec, 2010) <http://www.truth-out.org/archive/item/46433-the-smell-of-cut-grass-privatized>

³ MMS Karki, *Nontraditional Areas of Intellectual Property Protection: Colour, Sound, Taste, Smell, Shape, Slogan and Trade Dress*, JIPR 10(6) 499-506 (2005).

LAW MANTRA THINK BEYOND OTHERS

(International Monthly Journal, I.S.S.N 2321 6417)

Journal.lawmantra.co.in

This paper aims to understand the international and Indian position with regard to protection of the non conventional trademarks. This paper tries to deal with all the major non conventional trademarks i.e. smell marks, sound marks, color marks and shapes and their position as to registrability in USA, European Union and India.

Meaning of Trademark

A trademark is a type of industrial property which is distinct from other forms of intellectual property, which is used to distinguish goods, businesses or services⁴. The main function of a trademark is to indicate the source of the product. It gives the purchaser a satisfactory assurance of the make and quality of the article he is purchasing, the particular quality not being discernible by the eye. Thus, it can be said that a trademark performs three functions:

- identifies the product and its origin,
- guarantees its unchanged quality, and
- advertises the product⁵.

The definition of 'Trademark' given under the Trademark Act, 1999, in India and foreign legislations is extremely wide⁶. The very broadness of these provisions goes on to show that the lawmakers intended to retain a certain level of flexibility to allow for enhancement in the ambit of trademarkability⁷. The essential elements of protection under trademark law as enshrined under the statutory provisions of Trade Marks Act, 1999, can be culled out as follows:

- It must be a mark capable of being represented graphically.
- It must be capable of distinguishing the goods or services of one person from those of another
- It must be used or proposed to be used in relation to goods or services and such use must be upon, or in any physical or any other relation whatsoever to the goods⁸.
- The use must be in the course of trade⁹.

Non Conventional Trademarks

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 not static like moving image marks and digital marks; and others such as gestures and holograms, which have revolutionized both the fields of trademark law and marketing.¹⁰ Some of these have been more widely accepted in recent times as a result of legislative changes and the

⁴ Neha Mishra, *Registration Of Non-Traditional Trademarks JIPR* (13)1 43-50 (2008).

⁵ Narayanan P, *Law of Trademarks*, (5th edition Eastern Law House, 2000).

⁶ Section 2(1)(zb) of Trade Marks Act, 1999- 'Trademark' means a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those others and may include shape of goods, their packaging and combination of colours. In fact, 'Mark' has also been defined in the act in section 2(1) (m), in an inclusive fashion.

⁷ Sudipta Bhattacharjee and Ganesh Rao, *The Broadening Horizons of Trademark Law- Registrability of Smell, Sports Merchandise and Building Designs as Trademarks JIPR* 10 (2) 119-126 (2005).

⁸ Section 2(2)(c) of Trade Marks Act, 1999- This provision becomes extremely important where smell is being considered as trademark. Since the relation between the mark and the goods can be any relation whatsoever and not restricted to a physical relation, there cannot be any objection to smell as trademark on that count.

⁹ NARAYANAN P, *supra* note 5.

¹⁰ Neeti Suri, *Single Colour Mark: It's Registrability in the United States and the United Kingdom*, http://www.legalserviceindia.com/articles/collour_marks.htm (last updated April 06, 2015)

broad-mindedness of the judiciary, which have cumulatively led to the expansion of the definition of the term 'trademark'.¹¹

Growth of Non Conventional Trademarks

A trademark is considered effective on the basis of its ability to create an impact in minds of the customers. It is further enhanced if the trademark is unique and innovative in creating the requisite impact on the customer's senses. This has led to the advent of a number of unusual non-orthodox trademarks by the manufacturers.¹²

Marketing specialists believe that if a customer heard a familiar, comforting sound associated with a particular kind of tea, he would be more likely to choose it or that the smell of freshly cut grass emanating from tennis balls – would make the consumer a winner¹³.

Consumers rely on trademarks in most cases where it is difficult to inspect a product quickly and cheaply to determine its quality¹⁴. However, while a non-traditional mark is also entitled to protection as much as a conventional trademark, just how far trademark registration can be stretched to protect these innovative ideas remains to be seen especially taking into consideration that there are certain underlying problems with the nature of such marks that impede the registration process.¹⁵

The major types of Non Traditional Trademarks includes:

- Appearance/ Colour
- Shape
- Sounds
- Scents
- Taste
- Touch

International Framework

The international instruments are silent on the recognition of non-traditional trademarks which provides a wide area for creation and inclusion of the guidelines for the same. Now the author would like to discuss various international conventions and agreements with respect to Non Traditional Trademarks. The **Paris Convention for the Protection of Industrial Property (revised 14 July Stockholm 1967)** does not adopt one definition of trademarks and left the ground open for the registration of trademarks on the basis of guidelines provided by the union. The most important instrument in the field of intellectual property, the **TRIPS Agreement (1994)** in Article 15 (1) defines protectable subject matter of trademark where it provides a wide definition to the trademark. This definition has the requirement of "visually perceptible" which is optional depending upon the volition of the Parties to the Agreement. Thus, it is submitted that there seems to be no impediment to extending the protection to non

¹¹ *Id.*

¹² Arka Majumdar, Subhjit Sadhu and Sunandan Majumdar, *The Requirement of Graphical Representability for Non-Conventional Trademarks*, JIPR 11 (5) 313-317 (2006).

¹³ *Smell, Sound and Taste: Getting a sense of Non-Traditional Marks*, WIPO Magazine, Geneva-February 2009(1), at 4, http://www.wipo.int/wipo_magazine/en/2009/01/article_0003.html

¹⁴ Roth Melissa, *Something Old, Something New, Something Borrowed, Something Blue: A New Tradition In Non-Traditional Mark Registrations*, Cardozo Law Review, 27 (2005) 457; Cited in Neha Mishra, *Registration Of Non-Traditional Trademarks* JIPR (13)1 43-50 (2008).

¹⁵ *Id.*

LAW MANTRA THINK BEYOND OTHERS

(International Monthly Journal, I.S.S.N 2321 6417)

Journal.lawmantra.co.in

traditional trademarks in the form of sound, colour, shape etc. provided they are distinctive in character and the parties are willing to forego the requirement of visually perceptible in relation of non-traditional trademarks.¹⁶ The **Singapore Treaty on the Law of Trademarks**¹⁷ (16th March 2009) aims to standardize such procedures among all regional and national trade-mark registries without necessarily creating an international obligation for the registration and protection of those non-traditional marks. The treaty sets out a multilateral framework for the definition of criteria concerning the reproduction of hologram, motion, color and position marks and of marks consisting of non-visible signs on trademark applications and in trademark registers¹⁸.

Preparatory work for the said was carried out by the WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT). In its last two sessions, the SCT – made up of representatives of WIPO member states and observer organizations – defined a number of areas of convergence concerning the representation and description of non-traditional marks, such as 3D marks, hologram marks, position marks, multimedia marks or sound marks.¹⁹ Those areas of convergence reflect a common approach by all WIPO members to the representation and description of non-traditional marks and provide the first international reference in that area²⁰.

Problem with Non-Conventional Trademarks

The definition of trademark in Section 2(1)(zb) of the Trade Marks Act, 1999 provides two criteria that a mark has to satisfy in order to become a trademark, i.e,

- a) the mark has to be distinctive, i.e. capable of distinguishing goods and services of one undertaking from another, and
- b) capable of being represented graphically. The words ‘capable of being represented graphically’ would mean that the mark should be such as capable of being put on register in a physical form and also being published in the journal²¹. The graphical representation provides a fixed point of reference, showing what the mark is²².

The definition of the trademark is a very wide definition. Non traditional trademarks can be recognized under the definition if it meets out the two conditions of distinctiveness and graphical representation. However, there are other problems that make the recognition of non-conventional marks as trademarks difficult. The first problem is the distinctiveness criterion itself. Though certain non- conventional trademarks like, shape and colour, can be identified uniformly by consumers, for others like smell and taste marks, perceptions about the mark may vary, giving rise to confusion among consumers.

¹⁶ However, it is difficult to understand how the non-traditional trademark in the form of smell can be protected. One possibility would be to afford special status on it, i.e, make exclusive provisions governing the smell marks. That however, does not seem practical as undoubtedly with the passage of time in order to meet the challenges emerging from the globalization and commercialization newer forms of non-traditional Trademarks would emerge.

¹⁷ As on 24th December, 2010, the said Treaty was in force in 19 Countries including US, France and Australia.

¹⁸ It is however, important to note here that as on 24th December, 2010 India has not signed the said Treaty.

¹⁹ *Non-Traditional Marks: Singapore Treaty enters into force*, WIPO Magazine, Geneva-February 2009(1) at 3

²⁰ *Id.*

²¹ KC Kailasam & Ramu Vedaraman, *Law of Trade Marks & Geographical Indications*, 132 (IInd ed., Wadhwa & Company, Nagpur) (2005).

²² Kitchin David, Llewelyn David et al., *Kerly's Law of Trade Marks & Trade Names*, 10 (XIIIth ed. Sweet & Maxwell, London) (2001); Cited in Arka Majumdar, Subhojit Sadhu and Sunandan Majumdar, *The Requirement of Graphical Representability for Non-Conventional Trademarks*, *JIPR* 11 (5) 313-317 (2006).

But this is only a practical difficulty, and not a legal impediment to obtain registration, as a mark can acquire distinctiveness through use and thereby qualify to be a trademark, even though it may not be inherently distinctive²³.

The second problem is graphical representability of the mark to be registered, especially in case of odour and sound marks.

II. Registrability of Non Traditional Trade Marks: International Approach

A) Smell Marks

Smell is said to be one of the most potent types of human memory, and businesses show increasing interest in pairing pleasant scents with their products²⁴. It has been argued that olfactory marks are potentially registrable, as they can indicate commercial origin of goods or services.

It is a fundamental principle for all registration systems that the character of a trademark as well as its contents and scope should be defined as clearly and unequivocally as possible in the application²⁵. But practically the problem in recognizing smell as trademark as there is a requirement of graphical representation, under the Indian law and other legal systems such as the European Union and the United States of America.

The most striking factor about an olfactory mark is that it cannot be perceived visually. Does that mean an olfactory mark cannot constitute a trademark at all? This question was considered for the first time in the *Sieckmann case*²⁶ before the European Court of Justice (ECJ) which held that visual perception is not necessary as far as the mark can be graphically represented²⁷.

The ECJ decided that graphical representation per se is not enough for registration, and it must meet the following criteria:

- It must be complete, clear and precise, so that object of the right of exclusivity is immediately clear.
- It must be intelligible to those persons having an interest in inspecting the register, i.e. other manufacturers and consumers.²⁸

²³ Section 9(1) of the Act mandates that lack of distinctiveness would be an absolute ground for refusal of registration. However, the proviso to the said section virtually obliterates its effect by laying down that the requirement of distinctiveness for obtaining registration is done away with if the mark has acquired distinctiveness through use, and in that case it can be registered as a trademark.

²⁴ Meenu Maheswary, *Olfactory Trademarks - A Need To Create A Space For Its Sense!* <http://www.mondaq.com/india/x/263798/Trademark/Olfactory+Trademarks+A+Need+To+Create+A+Space+For+Its+Sense> (last updated April 06, 2015).

²⁵ Sudipta Bhattacharjee and Ganesh Rao, *The Broadening Horizons of Trademark Law- Registrability of Smell, Sports Merchandise and Building Designs as Trademarks*, JIPR 10 (2) 119-126 (2005).

²⁶ Ralf Sieckmann v. German's Patent Office, Case No. C-273/00. In this case, the applicant not only described the trademark in words, but also provided the chemical formula of the underlining composition of the smell, derived from methyl cinnamate. The applicant also volunteered to provide a sample of the smell in a sealed container to be deposited at the German Trademark Office and to be held on file, so that people could 'sniff' the trademark

²⁷ Neha Mishra, *Registration of Non-Traditional Trademarks*, JIPR (13)1 43-50 (2008).

²⁸ Arka Majumdar, Subhojit Sadhu and Sunandan Majumdar, "The Requirement of Graphical Representability for Non-Conventional Trademarks", JIPR 11 (5) 313-317 (2006).

LAW MANTRA THINK BEYOND OTHERS

(International Monthly Journal, I.S.S.N 2321 6417)

Journal.lawmantra.co.in

Having laid down these criteria, the Court observed the following difficulties encountered in graphically representing smell marks²⁹:

1. Representation as a drawing was not possible.
2. Representation by chemical formula would not suffice, as the chemical formula represents the substance itself and not its odour.
3. Further, representation by chemical formula lacks clarity and precision, not only because of the fact that very few people would have the requisite technical knowledge to interpret the odour of a substance from its formula, but also owing to the reason that the same substance would produce different smells at different temperature, concentration, etc.
4. Deposit of a sample of the substance with the registry was not a feasible alternative, since, firstly, it was not a graphical representation, and secondly, odour being volatile may fade and even disappear over a period of time.

It was finally concluded by the Court that a graphical representation is not possible for smell marks though they are distinctive in nature.

It was held in several early decisions of the Office for the Harmonization of Internal Markets [Trademarks and Designs] (hereinafter, OHIM³⁰) board of appeals, that a mere description would not be sufficient, as, it would only convey a vague idea of the protected subject matter and would therefore be inconsistent with the objective of legal certainty³¹.

“More recently, the European courts rejected the “smell of ripe strawberries” on the ground that there is no “generally accepted international classification of smells” (such as Pantone for colours) that would sufficiently identify the smell. This case has been seen as closing the door to smell marks in Europe. At least until a new method is devised to sufficiently identify smells.”³²

The requirement of a mark being perceived unambiguously by one and all thus becomes a mandatory requirement for registration, absence of which might lead to infringement.³³

The U.S. Trademark Manual of Examining Procedure (TMEP) provides a provision where a mark such as scent and sound which cannot be graphically represented may be explained by a written description.

In the case of *In Re Celia Clarke*³⁴, the Court recognized that non functional smell marks can also be registered as trademarks when it accepted an application for registration of ‘a high

²⁹ *Id.*

³⁰ OHIM is the European Union agency responsible for registering trademarks and designs that are valid in all 27 countries of the EU at <https://oami.europa.eu/ohimportal/en/>

³¹ See, the Decisions: 21.01.1997, R 4/1997-2 – Vacuum packing; 12.02.1998, R 7/1997-3 - ORANGE; 07.10.1998, R1/1998-2–Déclic. Cited in Sudipta Bhattacharjee and Ganesh Rao, *The Broadening Horizons of Trademark Law- Registrability of Smell, Sports Merchandise and Building Designs as Trademarks*, JIPR 10 (2) 119-126 (2005).

³² Alex Butler, *The smell of ripe strawberries: Representing Non-Visual Trademarks*, Intellectual Asset Management, April/May 2008 at 7, <http://www.iam-media.com/Magazine/Issue/29/Industry-insight/The-smell-of-ripe-strawberries-representing-non-visual-trademarks> (last visited April 6, 2015)

³³ Neha Mishra, *supra* note 27.

³⁴ *Re Celia, d/b/a Clarke's Osewez*, 17 USPQ2d 1238 (TTAB 1990). In the said case, the applicant, Celia Clarke, manufactured sewing thread and embroidery yarn. She applied for a mark that she described as "a high impact, fresh, floral fragrance reminiscent of Plumeria blossoms. The Examining Attorney rejected the application on the ground that the mark did not distinguish Clarke's goods from other competitors; that is, the mark did not function as a trademark. Clarke argued that hers was the only scented embroidery yarn, and therefore, was inherently distinctive. The Examining Attorney responded that the scent did not function to indicate origin,

impact, fresh floral fragrance reminiscent of plumeria blossoms' for sewing thread and embroidery yarn.³⁵ Further Court made the distinction between a fragrance that is used which is not an inherent attribute of the product and fragrances for products like perfumes, cologne etc. where the smell is an essential ingredient of the product.³⁶ The argument was premised on scents being comparable to colours and hence being registrable.

This judgment was criticized that it overlooks the scientific evidence which suggests contrary results. Even spectral analysis of scents fails to make out an accurate standard for trademark registration.³⁷ Reception and recognition of scents depends upon the individuals sensitivity.

Smell Mark owners should note that even if a scent mark is registered, enforcement is likely to be difficult.³⁸ Further, proving that consumers perceive a particular scent as a source-indicating trademark rather than merely an appealing feature of the goods or services is a difficult task. In addition, description of scent marks registered with the USPTO are relatively vague and a court may have difficulty enforcing the scent of 'bubble gum,' 'cherry,' 'grape' or 'strawberry'³⁹.

B) Sound Marks

Sound marks may consist of musical sounds, either pre-existing or specially commissioned for the purposes of trademark registration. They may also consist of non-musical sounds, either existing in nature (e.g., animal sounds or sounds produced by meteorological or geographical features) or produced by machines and other man-made devices⁴⁰.

Two of the primary issues confronting the registration of sound as a trademark and according such marks the statutory benefits of registration are⁴¹:

- How to represent the mark to enable it to be clearly articulated, and to ensure that it can be readily interpreted and searched.
- The requirements of affixation, in particular with reference to wares, in terms of how the mark is to be connected with the wares.

rather it was an arbitrary scent to make the product more pleasant. Furthermore, the Examining Attorney noted that Clarke had made no showing that the particular scent indicated origin, nor did Clarke specify a fragrance on the products packaging.

Clarke appealed to the TTAB which reasoned that Clarke was the only manufacturer of yarn with a scent; she advertised her yarn with the scent feature, and she had demonstrated that consumers recognized the scent as an indicator of origin. Thus, according to the TTAB, these facts presented a "prima facie case of distinctiveness" for the fragrance mark.

³⁵ Neha Mishra, *supra* note 27.

³⁶ *Id.*

³⁷ *Id.*

³⁸ Because scent marks cannot be inherently distinctive, they will probably lack strength in a likelihood of confusion determination. It will be difficult for the owner of a scent mark to prove fame in a dilution case and impossible for the mark to be inherently distinctive.

³⁹ Londe Anne Gilson La, *Cinnamon Burns, Marching Ducks And Cherry-Scented Racecar Exhausts: Protecting Non-Traditional Trademarks*, Trademark Reporter, 95, 773 (2005); Cited in Neha Mishra: *Registration Of Non-Traditional Trademarks* JIPR (13)1 43-50 (2008).

⁴⁰ Nineteenth Session of WIPO Standing Committee on The Law Of Trademarks, Industrial Designs And Geographical Indications, Representation And Description Of Non-Traditional Marks Possible Areas Of Convergence (Geneva, July 21 to 25, 2008).

⁴¹ T. Priyadarshini & Neetika Yadav, *Nokia's Triumph in 2007 - Registrability of Sound Marks and Areas of Concern*, Indian L.J. (2007).

LAW MANTRA THINK BEYOND OTHERS

(International Monthly Journal, I.S.S.N 2321 6417)

Journal.lawmantra.co.in

Unlike smells, sounds can be represented graphically and are regarded as trademarks worth protecting⁴². Such representations must be handled carefully in order to meet the requirements of individual trademark offices⁴³.

The European Court of Justice dealt with the registration of sound marks in the *Shield Mark case*⁴⁴. “The Court held that sound marks were registrable but the requirement of graphical representation along with distinctiveness of sound had to be met with. The Court specifically excluded written descriptions that say: the sign consists of the notes making up a musical work; or that it is the cry of an animal; an onomatopoeia; or simply a sequence of musical notes were rejected on the grounds that they lacked clarity and precision. In the given case, however, the Court did not lay down appropriate mode of representation for the sound of a cockcrow or any other sound, leaving it to a particular country to decide on its particular requirements. However, the Court indicated that whatever be the mode of representation, it should be clear, precise, self-contained, easily accessible, intelligible, durable and objective.”⁴⁵

OHIM decided in 2005 (No. EX-05-3) that applicants could attach a sound file to electronic or online trademark application forms – this still applies. The attachment must be in MP3 format, must not exceed one megabyte and must not allow loops or streaming. Its purpose is to further clarify and support the application. INLEX IP Expertise was the first applicant to successfully obtain a registered Community sound mark using this option. Deutsche Telekom has also registered its jingle as a sound mark under the Madrid Protocol.⁴⁶

In US there have been many attempts to register sound marks and have been successful also. Despite the successful registration of trademarks in sounds, the USPTO reports that only 23 of the more than 7,29,000 trademarks in force in the United States are sounds and since 1946, there have only been 71 applications to register sounds as trademarks or service marks.⁴⁷

Harley Davidson’s attempt to register ‘the mark consisting of the exhaust sound of the applicant’s motorcycles, produced by V-Twin common crankpin motorcycle engines is was very much debated. This application opened the Pandora box of doubts in the registrability of sound marks. The sound produced by Harley Davidson’s motorcycles seems to be peculiar, but many other manufacturers objected to the registration of this sound mark. The registration of sound marks in the world lacks uniformity. For instance, Nokia ringtone got registered in U.S.A, Australia and got rejected in Hong Kong which shows the state non uniformity in the world.

With companies approaching different countries of the world for registering their sound marks, it is necessary to consolidate the application of the law in order to ensure uniformity and consistency.

C) Colour Marks

⁴² Alex Butler, *supra* note 32.

⁴³ *Supra* note 13.

⁴⁴ *Shield Mark BV v. Joost Kist h.o.d.n. Memex, Case C-283/01.*

⁴⁵ Neha Mishra, *supra* note 27.

⁴⁶ *Supra* note 13.

⁴⁷ Sappherstein Michael B, *The Trademark Registrability of The Harley-Davidson Roar: A Multimedia Analysis*, B C Law and Intellectual Property & Technology Forum & Journal, 101 (1998).

LAW MANTRA THINK BEYOND OTHERS

(International Monthly Journal, I.S.S.N 2321 6417)

Journal.lawmantra.co.in

Today, Colours and their combination play a vital role in distinguishing and locating the goods manufactured by a specific manufacturer. Colour/s to be recognized as a trademark is always a debatable area. But colour/s are considered registrable as a trademark. Many jurisdictions accross the world recognize considering single colour as a trademark. Unfortunately, there is no global uniformity in statutory definitions or relevant case law concerning whether a single colour, or a combination of colours, can function as a trademark⁴⁸.

The TRIPS Agreement states that ‘Combinations of colors...shall be eligible for registration as trademarks [although] members may make registrability depend on distinctiveness acquired through use [and] members may require, as a condition of registration, that signs be visually perceptible.’⁴⁹ Though, the agreement is silent on the issue of single colour marks⁵⁰.

The European Union directive remain silent on the issue of colour/s to be recognized as a trademark. Thus, each member state may determine whether a colour or combination of colours complies with this definition⁵¹. The registrability of colour to be registered as a trademark was considered by ECJ in the *Libertel case*⁵². The main thrust area of the case was that colour marks can be graphically represented. While the Court rejected deposition of a single sample of a colour, it said that a verbal description could suffice under certain circumstances. Also, the Court recognized existence of an internationally recognized colour identification code like the Pantone Code which is a commercial system that designates specific shades numerically and categorizes over thousands of shades by unique codes. Thus, it becomes clear that in order for a colour to be a trademark, the test is three fold- functionality, source indication and distinctiveness.⁵³

The United States law does not expressly forbids the registration of the colours per se. In the beginning the United States courts were very reluctant to recognize colour/s marks. Subsequently the courts revisited their notion and In the year 1995 in the case of *Qualitex Co v. Jacobson Products Co*,⁵⁴ the United States Supreme Court resolved unanimously that, ‘sometimes, a colour will meet ordinary legal trademark requirements. And, when it does so, no special rule prevents colour alone from serving as a trademark.’ The court concluded that

⁴⁸ MMS Karki, *supra* note 3.

⁴⁹ Article 15(1)- The Agreement on the Trade-Related Aspects of Intellectual Property Rights, 1994.

⁵⁰ MMS Karki, *supra* note 3.

⁵¹ *Id.*

⁵² *Libertel Groep BV v Benelux-Merkenbureau* (2003) Case c-104/01.

⁵³ *Londe Anne Gilson La, Cinnamon Burns, Marching Ducks And Cherry-Scented Racecar Exhausts: Protecting Non- Traditional Trademarks*, Trademark Reporter, 95, 773 (2005). Cited in Neha Mishra, *supra* note 27.

⁵⁴ *Qualitex Co. v. Jacobson Products Co.* (93-1577), 514 U.S. 159 (1995). The Facts of the case were that the petitioner Qualitex Company's used a special shade of green-gold colour on the pads made and sold to dry cleaning firms for use on dry cleaning presses. The respondent, Jacobson Products began to sell its own press pads to dry cleaning firms; and it colored those pads a similar green-gold. Later, Qualitex registered the special green-gold colour on press pads as a trademark. Qualitex subsequently added a trademark infringement count; to an unfair competition claim in a lawsuit it had already filed challenging Jacobson's use of the green-gold colour. Qualitex won the lawsuit in the District Court (CD Cal.1991). But, the Court of Appeals for the Ninth Circuit set aside the judgment in Qualitex's favour on the trademark infringement claim because, in that Circuit's view, the Lanham Act of 1946 did not permit registration of ‘colour alone’ as a trademark. This decision was however, reversed by the US Supreme Court.

LAW MANTRA THINK BEYOND OTHERS

(International Monthly Journal, I.S.S.N 2321 6417)

Journal.lawmantra.co.in

the colours can acquire the distinctiveness with time but they are not to be considered as a conventional trademark per se.

The final position in US is that a colour by itself cannot be inherently distinctive. To assess whether a colour has acquired secondary meaning, the following factors have to be considered:

- (a) Extent of third party use;
- (b) Any kind of sales and advertising of the product should direct the attention of the consumer towards the colour of the product; and
- (c) Consumer studies and surveys should indicate towards the importance of the colour⁵⁵.

Even for something like drug capsule colours, the trend seems to be to see not whether the colour is functional in the utilitarian sense but rather whether the colour has become a generic indication of a type of drug regardless of source.⁵⁶

In respect of recognition of a combination of colours as trademarks it has been explicitly accepted by legislations and cases as distinctive by itself.⁵⁷

D) Shapes

A shape trademark must not to be confused with the shape of a product. Although the sign, particularly the three-dimensional sign, is inherent to the product, it must be conceptually separated from the product and perceived as a trademark (i.e., a sign that distinguishes the product of one undertaking from that of others). To assess whether a sign can be considered a shape mark, reference should be made to⁵⁸:

- the way the product is put on the market and distributed; and
- the way it is advertised.

In addition, attention should be paid to how the shape is perceived by the relevant public.

Over the years both OHIM and the ECJ have offered valuable guidance on how to assess inherent distinctiveness of three-dimensional trademarks including shapes of products. It is noteworthy that most of the decisions in respect of product shape trademark applications have involved rejections of shapes where the owners have not filed evidence of use to support a claim to distinctiveness and secondary meaning⁵⁹.

In *Philip Electronics v. Remington Consumer Product Limited*⁶⁰, Philips commenced proceedings against Remington for infringement of their UK trademark consisting of a two-dimensional picture of the top portion of a three-headed rotary electric shave. Remington counterclaimed that the mark was invalid on, among other grounds, section 3(2)(b) TMA (the shape of goods which is necessary to obtain a technical result). On referral by the UK court

⁵⁵ Neha Mishra, *supra* note 27.

⁵⁶ *Id.*

⁵⁷ *Smith Kline and French Laboratories Ltd v. Sterling Winthrop Group*, (1975)2 All E R 578. The applicant was permitted to register as trademarks ten different color combinations for its sustained-release drugs sold in pellet form within capsules. Registration would be refused if the color or combination of colors was functional or common to the trade.

⁵⁸ Guido Jacobacci and Marilena Garis, *Italy's Cautious Approach To Non-Conventional Trademarks*, World Trademark Review, 90-91 July/August 2007, <http://www.worldtrademarkreview.com/Magazine/Issue/08/Country-correspondents/Italy-Jacobacci-Partners>

⁵⁹ MMS Karki, *supra* note 3.

⁶⁰ *Koninklijke Philips Electronics Ltd. V. Remington Consumers Products Ltd.* (2002) Case C-299/99.

LAW MANTRA THINK BEYOND OTHERS

(International Monthly Journal, I.S.S.N 2321 6417)

Journal.lawmantra.co.in

the ECJ interpreted this to mean 'a sign consisting exclusively of the shape of a product is unregistrable by virtue of this section if it is established that the essential features of that shape are attributable only to the technical result'. On this interpretation of the law, the English Court held the mark invalid⁶¹.

In another case, *Henkel and Procter & Gamble* applied to register the shapes of detergent tablets as trademarks. The question for the Court was whether the mark was devoid of distinctive character (section 3(1) (b) TMA).⁶² The ECJ held that the criterion for assessing the distinctiveness of three-dimensional shape marks was no different from those for assessing the distinctiveness of other categories of mark such as words or slogans.⁶³ However, the Court went on to state that the public's perception of product shape marks was different and, in particular, that the more closely the shape for which registration was sought resembled the shape most likely to be taken by the product in question, the greater the likelihood that the shape was devoid of distinctive character for the purposes of section 3(1) (b) TMA. It also pointed out that 'average consumers are not in the habit of making assumptions about the origin of products on the basis of their shape, or the shape of their packaging'.⁶⁴

In the *re Bongrain's Trade Mark application* case, the applicant sought to register the three-dimensional shape of a cheese in flower-like form. The Court held that the mark was devoid of distinctive character. It also held that there was a public interest in preserving certain signs for other traders to use in relation to the same or similar goods to maintain freedom of action and competition. The decision further stated that the public's perception of the sign was of paramount importance and that the public was not generally accustomed to shapes conveying trademark significance.

It is concluded that inherent registerability of the shape marks is difficult to accept. Though, it may be easier to register a shape mark if it is able to prove that the shape mark has acquired distinctiveness through use with passage of time.

III. Position in India

The Trade Marks Act, 1999 replaced the Trade and Merchandise Marks Act 1958 which comprehensively amended and consolidated the law relating to trade marks in India. Non Traditional trademarks are not capable of being registered under the Trademarks Act, 1958. The requirement of graphical representation makes registration of these marks really difficult. In the present legal framework, the Indian Trademarks Registry is incapable to registering various Non-traditional trademarks.

The trademark registry, while deciding on the particular fragrance, should keep in mind the following points:

- (i) an applicant must establish that the smell is used or intended to be used as a trademark;

⁶¹ *Supra* note 57.

⁶² *Id.*

⁶³ *Id.*

⁶⁴ *Id.*

- (ii) that the smell does not arise from the goods or services, but is added or is a combination created by the applicant; and (iii) that the public associates or will associate the smell exclusively with the applicant for the goods or services specified.⁶⁵

Sound marks can possibly be registered under the Trademarks Act, 1999 as there is no requirement for 'visual perceptibility' in the registration process. Sound marks can also be presented graphically which is required for registration. The legal position existing today seems to be that while sound of a trademark is registrable under the Trademarks Act, 1999, sound as a trademark itself has not been afforded statutory protection.⁶⁶

With respect to colours, the definitions of trade mark and mark only refer to a combination of colors. The difficulty arises when an applicant chooses to make an application for a single colour only. The Indian Courts have recently addressed the issue of use of a single colour and has categorically stated that a single colour cannot be inherently distinctive⁶⁷ (and consequently cannot be the subject matter of protection under the Trade Marks Act, 1999 as it fails to satisfy the dual test as laid down in Section 2 (1) (zb)). Recently, Cadbury's tried registering purple colour as their trademark but it was not accepted.⁶⁸

However, with regard to a combination of colours, the position is clarified by statute and the requirement of colours having acquired secondary significance like that of the white and red in the case of 'Colgate' dental products along with the inscription of Colgate in a certain manner seems uncontroversial.⁶⁹

The new Act specifically provides for the registration of the shape of goods, their packaging and combination of colours as trademarks. Though the Indian Trade Marks Act includes the shape of goods in the definition of trademarks, but the scope of protection is unclear, as statutory protection for the shapes of goods was only introduced in 2003. In India, the dilemma that exists today is whether the shape of goods should be protected either under designs law or trademark law.

A decision by the High Court of Delhi shows some light on the overlapping protection in design and trademark law. In *Corning Inc. & ors. v. Raj Kumar Garg & Ors*⁷⁰, it was clarified that the fundamental distinction between a trademark and a design:

[A] "trademark" signals to the mind, the source or identity of the producer/manufacturer of the article, whereas a "design" appeals to the eye and attracts the consumer/purchaser. A "trademark" may also be attractive and appealing to the eye but it should be directly relatable to the producer/manufacturer of the goods whereas the "design" may be merely appealing or attractive to the eye and need not give any indication to the consumer/purchaser about the identity of the manufacturer or producer of the article."

The court also held that a design protects only the features of shape and configuration. This distinction is significant in view of the inclusion of shapes in the definition of trademarks

⁶⁵ See Rule 25(2) of the Trade Marks Rules, 2002

⁶⁶ Neha Mishra, *supra* note 27.

⁶⁷ G M Pens International v. Cello Plastic Products And Ors. (2005), <http://indiankanoon.org/doc/1406557/>

⁶⁸ Cadbury and the colour purple, <https://yougov.co.uk/news/2013/10/07/cadbury-and-colour-purple/>

⁶⁹ Colgate Palmolive Co. Ltd. & Anr. v. Mr. Patel & Ors. 2005 (31) PTC 583 Del.

⁷⁰ Corning Inc. & ors. v. Raj Kumar Garg & Ors, 2004 (28) PTC 257.

LAW MANTRA THINK BEYOND OTHERS

(International Monthly Journal, I.S.S.N 2321 6417)

Journal.lawmantra.co.in

under the Act, because it may be concluded that whereas trademark law protects the shape of goods, design law merely protects the features of such shapes.”⁷¹

Till date Indian courts have not dealt with the issue of distinctiveness in regard to shape marks. However, it is likely that in near future the courts will be confronted with issue. It has been consistently held that trade dress cannot be inherently distinctive, and while a claim of passing off is available, even in respect of an unregistered design, the plaintiff claiming passing off has to prove that the trade dress has acquired secondary meaning or reputation in the market in relation to the trade dress.⁷² Such reputation need not be based on use in India alone but may also be in the form of trans-border reputation of a trademark that has traveled into India. Such cases have also indicated that the amount of evidence required to establish reputation in relation to a shape mark is likely to be more than that required for a word mark⁷³.

So far as the statutory framework is concerned, Section 18 of the Indian Trademarks Act requires that any application for registration of a trademark should be in compliance with the Rules. According to Rule 25(12) (b) of the Trademark Rules, 2002, the application for registration of a trademark for goods and services has to be such that it can be depicted graphically. Further, Rule 28 makes it clear that the trademark should be such that it can be represented on paper. Rule 30 further makes a specification to the effect that the graphical representation made should be durable and satisfactory. In addition to this, what needs to be remembered is that Rule 29(3) makes it explicit that three-dimensional marks can also be registered and so can a combination of colours.

Section 9(3) makes exceptions to registrability of shapes as a trademark if it results from the nature of goods, or to obtain a technical result or where the shape gives substantial value to the goods. It might also be noted that Section 2(1) (m) of the Trademarks Act defines mark to be an inclusive definition consisting of shapes and packaging of goods or a combination of colours.

“In the light of all these provisions, one may say that while it is possible to include a lot of non-traditional marks within this definition, the requirement of graphical representability seems to be an impediment. It is likely that Indian Courts in the future might adopt the Sieckmann approach and hence under such circumstances, registrability of a trademark will be contingent on several factors including the graphical representability of a non-traditional trademark, and whether it is durable or satisfactory.”⁷⁴

IV. Conclusion

The protection of non-traditional marks is still a grey area in the field of Intellectual property. Unlike conventional trademarks, sounds, smells and tastes are usually intrinsic features of products, and it can be argued that such characteristics should not be allowed to be monopolized. While trying to expand the ambit of the kinds of trademarks, the Sieckmann approach in Europe has ensured that the Courts adopt a stringent test for the graphical

⁷¹ Franck Soutoul and Jean-Philippe Bresson, *3D Trademarks under French and Community practice*, http://www.wipo.int/wipo_magazine/en/2009/01/article_0004.html

⁷² Abhishek Malhotra, *Protection of Shapes under Indian Law INTA Bulletin* Vol. 63 No. 13, July 15, 2008.

⁷³ *Id.*

⁷⁴ Neha Mishra, *supra* note 27.

LAW MANTRA THINK BEYOND OTHERS

(International Monthly Journal, I.S.S.N 2321 6417)

Journal.lawmantra.co.in

representation of a trademark. While this is extremely helpful in avoiding any controversies for registrability of non-conventional trademarks, it may push out cases where business competition and consumer base expansion warrants use of such marks⁷⁵. At the same time, the American approach of 'anything goes' attitude along with the requirement of accurate description of non-traditional marks seems to be completely unsuited to the legal environment in countries like India, the main reasons being the way 'trademark' and 'mark' have been defined coupled with the requirements for registering a trademark. The tenor of the decisions of the Court along with the definitions seems to suggest that the judiciary is keen to facilitate registration of non-traditional trademarks.⁷⁶

Considering the kind of legislation in India with regard to trademarks and the stringent need of graphical representation of any trademark, non-conventional trademarks might not become prominent in the commercial market. The advances in technology will be vital for graphical representation of a sensory trademark. At present, the Trademarks Registry Office in India may not be enabled enough to allow registration by using updated scientific measures. Besides, the basic purpose of a trademark is to indicate the origin of a product, which inevitably leads us to the rationale put forth by the conservative school of thought that believes that sense-based trademarks are neither distinctive nor do they indicate a source under most circumstances thus leading to consumer's confusion⁷⁷.

It is strongly recommended that a consolidation of law is a need of the hour, which helps the legal system to be more uniform and satisfying. This consolidation can be achieved by a binding forum for multilateral negotiation in order to ensure common protection of trade mark and intellectual property rights. The author would like to suggest few rules as a step towards bringing consistency in the recognition of Non Traditional Trademarks; they are:

- The strict requirement of graphical representation of the trademarks for registration needs to be relaxed for the non traditional trademarks;
- The rules for trans-border should be applied on the non traditional trademarks;
- The durability of the trademark should be made as a requirement for registration; and
- Inherent distinctiveness should be made as the sole criteria for the registration of the non traditional trademarks.

These are the few rules which can act as guiding principles in culling out a uniform law for the universal application

⁷⁵ Torremans Paul Carl Leo, *Trademark Law: Is Europe Moving Towards An Unduly Wide Approach For Anyone To Follow The Example?*, JIPR, 10 (2) 128, 131 (2005).

⁷⁶ Neha Mishra, *supra* note 27.

⁷⁷ *Id.*