



INDIA: CONVENTIONALISATION OF NON-CONVENTIONAL TRADEMARKS

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ABSTRACT

The TRIPS agreement perceives different kinds of trade marks. Being a member country, India has also made several changes in its trade mark law to comply with provisions of the TRIPS agreement. With the advent of the digital age, internet has given way to new ways of marketing. However, with easy accessibility of information, it is increasingly easier for a person sitting in a different continent altogether to infringe upon the 'source identifier' of your brand. Hence, more companies are adopting methods of sensory marketing to create a distinctive and long-lasting impression in the minds of the consumers. It is also an established fact that human beings resonate with the memories of their senses. Their senses of smell, sound, shape, touch, vision (identifying a color) may often result in them associating with a product. The registration of this distinctive sound is one of the several illustrations that companies are undertaking innovative and distinctive methods of marketing. The acquired distinctiveness has set the way for evolution of non- conventional trademarks around the globe. However, the issue regarding the registrability of these kinds of trademarks still remains uncertain and its protection under legal regime is still evolving through various precedents. There have been several such cases discussing the enforcement of these trademarks; however, there is a lack of uniformity regarding the same across various jurisdictions of the world. This is the result of the uncertain nature of these trademarks. The subjective nature of perceiving a smell, graphical representation, distinctiveness, functionality is some of the issues which are examined in this paper. The examples of non-

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conventional trade marks in India have been highlighted, discussing the procedure as well as the practicality of actually granting the registration and enforcing them in the courts of law.

INTRODUCTION

“Muddai Lakh Bura Chahe to Kya Hota Hai? Wahi Hota Hai Jo Manjure Khuda Hota Hai!” Doesn’t this ring a bell? In the year 2015, Mehboob Productions Pvt. Ltd. acquired a trade mark protection for this iconic dialogue as a sound mark. What differentiates little hearts biscuits by Britannia from other biscuits? It’s distinctive shape. It is a registered trade mark too.³ The thump sound from Royal Enfield attracting every passer-by on the street distinguishes it from other bikes.⁴ Many such trademarks have acquired a secondary meaning so much so that they are capable of being registered as a trade mark.

The Standing Committee on the Law of Trade Marks, Industrial Designs and Geographical Indications (SCT) that was established by the World Intellectual Property Organization (WIPO) in its analysis of the non-traditional trademarks⁵ divided them into visual trade marks (three-dimensional marks, colour marks, holograms, motion marks and others) and non-visual trade marks (sound marks, olfactory marks, taste marks, texture marks). The TRIPS agreement perceives different kinds of trade marks. Being a member country, India has also made several changes in its trade mark law to comply with provisions of the TRIPS agreement.

WHAT IS A NON-CONVENTIONAL TRADE MARK?

Traditionally, a trade mark was limited to words, logos and symbols. According to Section 2(z) (b) of Indian Trademarks Act, 1999, a trade mark is limited by the inclusion of the term ‘being capable of graphical representation’. However, the main purpose of a trade mark is to act as a source identifier, which does not necessarily have to be in a written form or a graphical notation. An unconventional trade mark may be in the form of a smell, sound, hologram, colour, taste or shape. A mark does not always require a visual representation to distinguish it from other goods and services. Furthermore, the definition of trade marks in the Act also includes ‘shape of goods’, ‘packaging’, and ‘combination of colours’.

³ Trade Mark Number 4274917 in class 30 dated 26/08/2019 acquired by Britannia Industries Limited from Trade Marks Registry India.

⁴ Trade Mark Number 3044833 in class 12 dated 01/09/2015 acquired by Eicher Motors Limited from Trade Marks Registry India.

⁵ Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications, Representation of Non-Traditional Marks, Areas of Convergence, Twentieth Session, Geneva, December 1 to 5, 2008

A. SMELL MARKS

In the case of Ralf Sieckmann v. Deutsches Patent und Markenamt of 2002, a smell described as "*as balsamically fruity with a slight hint of cinnamon*" for "methyl cinnamate" scent had been applied for registration. *The European Court of Justice ruled that (a) a chemical formula stated only the substance and not the odour of the substance and was not sufficiently intelligible, nor sufficiently clear and precise; (b) a written description was not sufficiently clear, precise and objective; and (c) a physical deposit of a sample of the scent did not constitute a graphic representation, and was not sufficiently stable or durable.* This case stresses on the relevance of the graphical representation as a criteria for granting of protection as a trade mark.

However, it is simultaneously argued that the consumers associate the smell, sound, colour or shape with a product. Some successfully registered smell marks are a Dutch company's tennis balls with the scent of freshly mown grass; the UK registrations for tires with "a floral fragrance/smell reminiscent of roses" and darts with "the strong smell of bitter beer."⁶

As recently as in May 2018, Hasbro Inc., a leading toy manufacturing company has been granted registration for sweet, slightly musky, vanilla fragrance, with slight overtones of cherry, combined with the smell of salted, wheat-based dough smell of its product 'Play Doh'.⁷



B. SOUND MARKS

Yahoo yodel⁸ was the first trade mark in India to get registration as a sound mark.⁹ Hero Motor Corp. has successfully registered its sound mark which is repetition

⁶ *Smell, Sound and Taste – Getting a Sense of Non-Traditional Marks*, WIPO MAGAZINE, February 2009, also available at https://www.wipo.int/wipo_magazine/en/2009/01/article_0003.html

⁷ Trade mark Number 5,467,089 in class 28 dated May 15, 2018 acquired by Hasbro Inc. from United States Patent and Trade mark Office.

⁸ Yahoo! Yodel <https://www.youtube.com/watch?v=iC1a8xXQQDo>

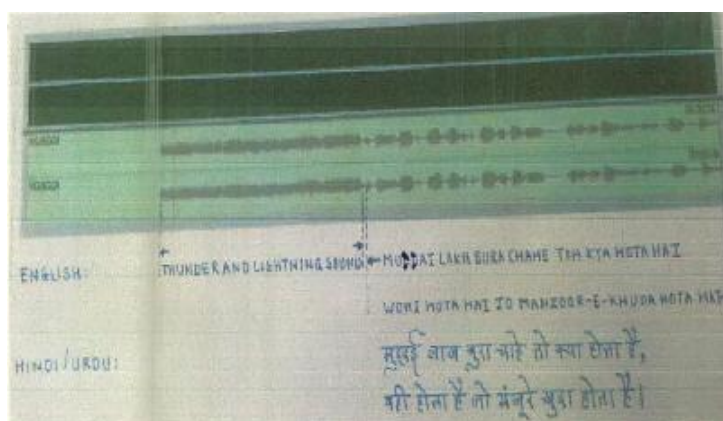
⁹ Trade Mark Number 2529021 in class 99 dated 10/05/ 2013 by Hero MotorCorp Limited from Trade Marks

of the word ‘Vroom’ in India.¹⁹³ Registrability of sound marks depends on whether the sound is or has become a distinctive trademark to accept a sound like words or other trademarks and people should be able to easily identify these sounds. As the applications for registration of sound marks are gaining popularity in India, the Indian trade mark office incorporated the following:

1. The application must clearly state that the mark is a sound mark, failing which the application will be considered as if it were a word / device mark.
2. Sound marks must be represented with graphic representation of the sign by a musical state divided into measures and showing in particular, a clef, musical notes and rest, indicating relative value, sharps, flats and naturals.¹⁹⁴ Some other trademarks which are registered in India include:

- Four note bell sound of Britannia Industries¹⁰
- Nokia’s guitar notes on switching on the device¹¹
- Theme Song of National Stock Exchange¹²

As mentioned in the introduction, the iconic dialogue “‘Muddai Lakh Bura Chahe to Kya Hota Hai? Wahi Hota Hai Jo Manjhire Khuda Hota Hai!’” registered by Mehboob Production Pvt. Ltd.¹³ was acquired as a sound trade mark by submitting graphical notations of the same. The image of the graphical notes submitted before the Trade Marks Registry, India is reproduced below:



Registry India

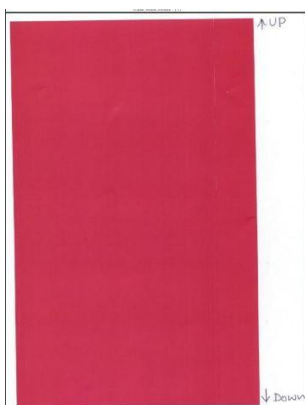
¹⁰ Trade Mark Number 1913366 in class 99 dated 25/01/2010 by Britannia Industries Limited from Trade Marks Registry India

¹¹ Trade Mark Number 1365394 in class 99(41,9 & 38) dated 20/06/2005 by Nokia Corporation from Trade Marks Registry India

¹² Trade Mark Number 2152242 in class 36 dated 31/05/2011 by National Stock Exchange of India from Trade Marks Registry India

¹³ Trade Mark Number 3027897 in class 41 dated 10/8/2015 by Mehboob Productions Pvt. Ltd from Trade Marks Registry India

C. COLOUR MARK



Indian law first incorporated the registration of single colour marks in the Manual of Trade Marks, Practice and Procedure, 2015, wherein it was stated that the colour mark shall be protected on strict evidence of acquired distinctiveness and protection granted strictly to the extent of that particular shade of colour.¹⁴ The blue colour of Parachute Coconut oil bottle was also recognised as a source identifier by the Delhi High Court.¹⁵ Other successful cases of single colour trademarks registrations include entities like Victronix AG (#1394234-brown colour label)¹⁶ and Telekom AG (#1462271-magenta colour label)¹⁷ have successfully registered their single colour marks in India.¹⁸ The magenta colour label acquired by Telekom AG is reproduced below:

D. SHAPE MARK:

Under Section 2(z) (b) of Trade Marks Act, 1999 a specific mentioning will be found that shape of goods can qualify to be registered as a trade mark. It is pertinent to mention that the packaging of a product which constitutes trade dress of a mark is specifically defined in the Trade Marks Act, 1999 under Section 2 (q) which includes box, wrapper, container, bottle etc. Saffola 5 ltr. Oil Can¹⁹ shape with two handles, the exclusive dotted pattern on the packaging of the products by Modern Food Enterprises Pvt. Ltd.²⁰ are registered as a trade mark in purview of trade dress of a product qualified as a source identifier. The 3D Shape of Ferrero Rocher packaging

¹⁴ Manual of Trade Marks, Practice and Procedure, 2015 pg. 57 and 84

¹⁵ *Marico Ltd. vs. Mr. Mukesh Kumar & Ors.* 2018(76)PTC168(Del)

¹⁶ Trade Mark Number 1394234 in class 8 dated 19/10/2005 by Victronix AG from Trade Marks Registry India

¹⁷ Trade Mark Number 1462271 in class 38 dated 19/06/2006 by Deutsche Telekom AG from Trade Marks Registry India

¹⁸ *IP Expressions, A biannual publication from the Office of Controller General of Patents, Designs and Trademarks, India Vol No.1 Issue 2, January, 2015*

¹⁹ Trade Mark Number 2505358 in class 29 dated 2/04/2013 by Marico Limited, Trade Marks Registry India

²⁰ Trade Mark Number 3805040 in class 30 dated 13/04/2018 by Modern Food Enterprises Private Limited, Trade Marks Registry India

has also recently acquired a registration for its distinctive shape.²¹ Interestingly, Jaguar Land Rover Ltd.²² has acquired trade mark registration for shape of its car in India.

In *Gorbatschow Wodka Kg. Vs. John Distilleries Ltd.*²³ the Hon'ble Bombay High Court observed that *"Parliament has therefore statutorily recognised the shape in which goods are marketed, their packaging and combination of colours for part of what is described as trade dress. A manufacturer who markets a product may assert the distinctive nature of the goods sold in terms of the unique shape through which the goods are offered for sale."*

The shape of bottle which the Plaintiff has adopted has no functional relationship with the nature of the product or the quality required of the container in which Vodka has to be sold. The shape to use the language of a leading authority on the subject, is capricious. It is capricious that it is novel and originated in the ingenuity and imagination of the Plaintiff"

So much so that in the year 2006, Bochasanwasi Shri Akshar Purushottam Swaminarayan Sanstha²⁴, has acquired trade mark registration for exquisite monument Akshardham building. The representation as submitted before the Trade Marks Registry, India is reproduced hereinbelow:



²¹ Trade Mark Number 2349844 in class 30 dated 18/06/2012 by Ferrero S.P.A., Piazzale Pietro Ferrero, Trade Marks Registry India

²² Trade Mark Number 2820937 in class 99 dated 1/10/2014 by Jaguar Land Rover Ltd, Trade Mark Registry India

²³ 2011 (47) PTC 100 (Bom)

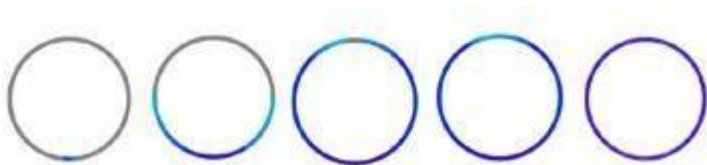
²⁴ Trade Mark Number 1429078 in class 41 dated 14/03/2006 by Bochasanwasi Shri Akshar Purushottam Swaminarayan Sanstha, Trade Mark Registry India

E. MOTION MARK:

A motion mark is an animated moving logo which is made to move in a specific way through programming and animation. Motion marks are an effective method for companies to communicate with the consumers and are gaining importance with technological advancement in this area.

Nusret Salt Bae, well known international chef became the internet sensation in the year 2017 for the way he cuts his meat and mostly for sprinkling salt in a particular way. He applied for this unique technique as a motion mark in European Union and acquired the same as it became a source identifier. India is also not far behind in registration of motion as a trade mark. A motion mark is an animated moving logo which is made to move in a specific way through programming and animation. UPL Limited, a company based in Mumbai has also been granted registration for the animation of their logo as motion mark.²⁵

In the year 2017, Amazon Technologies, Inc²⁶ has registered the moving light sequence used in its Echo device as a motion trade mark in India. The representation as submitted before the Trade Marks Registry is reproduced below:



F. FLUID MARK:

Fluid trademarks are different methods of capturing various versions of a particular mark. The versions may not vary much from each other. They are designed in such a manner that various versions identify with one source. One of the most popular fluid marks is Google Doodle which changes frequently to commemorate various events. Similarly, In India, the iconic girl who is the face of Amul is used in various cartoons in different ways like visual commentary of contemporary social and political issues to promote its brand. During the ongoing Covid-19 era, numerous brands including Mc Donalds, Audi, BMW, Starbucks (mermaid with mask over its face) and Nike (Swoosh now says Just don't do it) have adopted fluid marks as a way of marketing.

²⁵ Trade Mark Number 4192672 in class 44 dated 30/05/2019 by UPL LTD., Trade Mark Registry India

²⁶ Trade Mark Number 3468096 in class 35 dated 27/1/2017 by Amazon Technologies, Inc., Trade Marks Registry, India

G. TASTE MARK:

Taste marks overcame the hurdle of graphical representation by using written description of the taste and indication that it concerns a taste mark but taste may be defined as a functional feature of any product which still poses a barrier in registration of a taste mark. A taste mark is only applied in relation to goods and not services. This is resultant of the very nature of a taste mark. However, some jurisdictions have accepted Taste marks.²⁷

Eli Lilly's attempt to register the taste of artificial strawberries noting in its decision in case R 120/2001-2, *"Any manufacturer... is entitled to add the flavour of artificial strawberries to those products for the purpose of disguising any unpleasant taste that they might otherwise have or simply for the purpose of making them pleasant to taste... Moreover, the taste is unlikely to be perceived by consumers as a trademark; they are far more likely to assume that it is intended to disguise the unpleasant taste of the product..."* A similar attempt by N.V. Organon to register an orange flavour for pharmaceuticals was rejected by the USPTO.²⁸

H. TOUCH MARK

The touch mark should be distinctive to the users; i.e. it must not be just an eye-catching or ornamental element. It must be further than decoration and packaging of the goods or services that it is demonstrating and must possess the characteristic of a standard trade mark. One example of a touch mark is that of the texture of a Louis Vuitton bag.²⁹

ISSUES REGARDING REGISTRATION AND PROTECTION OF A NON-CONVENTIONAL TRADE MARK

For any mark to be eligible for registration it has to meet the statutory obligations but it should also have acquired distinctiveness. The basis of non-conventional trademarks to stand as a trade mark is the distinctiveness that the general public recognises pertains to the non-conventional part of the product such as shape, smell, colour or sound rather than the name of the product itself.

²⁷ For example, in the Benelux Office the following mark has been registered (DE SMAAK VON DROP BX NO. 625971). "The trademark consists of the taste of liquorice applied to goods in class 16 (taste mark)".

²⁸ USPTO, June 14, 2006, In re N.V. Organon

²⁹ The Contemporary Issue of Non-conventional Trade Marks, Dipak Rao & Sana Singh, Lexology, available at <https://s3.amazonaws.com/documents.lexology.com/ebe88cd8-9ed8-4d56-8ee2-a9123af2fb19.pdf?AWSAccessKeyId=AKIAVYILUYJ754JTDY6T&Expires=1592240024&Signature=iGwXi1AOjRF5E%2FG5Te8ZCR0%2F%2BtA%3D>

In simple terms it can be said that the feature of a mark and/or a product that meets the eye of the general public the most with a capacity to build goodwill on that very aspect even if it is non-conventional, can be registered as a trade mark. Owing to the unconventional nature of these trademarks, the process of registration is also complex in comparison to that of a traditional trade mark.

Distinctiveness:

The first and foremost obstacle in this scenario is the proof of being 'distinctive'. It is extremely important for a trade mark to be distinctive, as well as capable of distinguishing its goods and services from those of others. A practical approach for a sound mark would be to provide a digital recording because every person is not capable of reading a musical notation. It would appear that graphical notation should not pose an issue so long as a sound is distinctive. Simple forms of music with one or two notes which are used as nursery rhymes may not be granted as registration as they would not qualify as a 'distinctive' sound. One of the distinctive sound marks which have recently acquired registration is Twentieth century fox's Fanfare distinctive sound composed in 1993 by Alfred Newman.³⁰

In the case of *Gillette v Reckitt Benckiser*, which was a case of disparagement, the Hon'ble Delhi High Court held that the use of a blue colour razor by the defendant in the advertisement was not justifiable. According to the Court, the defendant's argument that the shape of the razor was different could not be supported, because the defendant could have used any other colour, and the use of blue colour means that a viewer would necessarily co-relate the razors in the advertisement with the razors of the plaintiff.³¹ The Indian judiciary has recognised the association of colour with that of a product in several such instances.

Cadbury had also applied for registration of purple colour which but was refused. The court found issue with the wording: "Being the predominant colour applied to the whole visible surface of the packaging goods" as it felt the term 'predominant' was too broad. Nestle had opposed the application on the ground that the colour 'purple' did not possess a distinctive character and was not capable of being registered as a trade mark. Cadbury proved that the colour purple on the wrappers has gained a distinctive character.³² However, when Cadbury tried to register for its shades, it was refused.³³

³⁰ Trade Mark Number 3249610 in class 42 dated 03/05/2016, Trade Marks Registry India

³¹ *Gillette v Reckitt Benckiser*, CS(OS) 251/2016

³² *Société des Produits Nestlé S.A. v. Cadbury UK Limited*. [2012] EWHC 2637 (Ch) (1 October 2012)

³³ *CADBURY UK LIMITED v. THE COMPTROLLER GENERAL OF PATENTS DESIGNS AND TRADE MARKS & SOCIÉTÉ DES PRODUITS NESTLÉ S.A.*(Case No.: A3/2016/3082)

The 'RED SOLE' of Christian Louboutin one of the top luxury brands in the world for female shoes was granted registration in Indian Trade mark office on 25 November 2015. The registration of a single colour as a trade mark was granted for 'RED SOLE' in 'Christian Louboutin v Abu Baker & Ors. against infringement and came to be known as a well-known mark. In another Delhi High Court judgment, trademark protection was denied even though the same court had earlier granted it the status of a well-known mark.³⁴ Louboutin should not be able to stop its competitors from using the colour red in their shoe designs because it would be too broad and is not distinct.

For example, the exhaust roar of Harley Davidson's motorcycles seems to be very characteristic, but the Japanese manufacturers, Suzuki, Kawasaki, Yamaha, and Honda, as well as American manufacturer, Polaris objected saying that other motorcycles can also make similar sounds. Further, it was not necessary that all motorcycles of Harley Davidson would produce a similar sound.³⁵ The point to be noted here is that a mark does not have to be inherently distinctive but can acquire a secondary meaning by use. It is also argued that a smell, sound or colour may often be an essential feature of a trade mark, making it functional in nature. The colour combination of green and yellow was recognised as a well-known mark in case of Deere and Co v S Harcharan and a suit of infringement was won by John Deere as the Defendant's products bore a striking resemblance to John Deere's famous tractor which had 'the body of the vehicle painted yellow and green for the wheels and seat painted yellow'.³⁶

Graphical representation

The criterion of graphical representation acts as a barrier to registration of a smell mark in India.

In the case of Shield Mark BV v Joost Kist³⁷, it was pointed out that a sound which was filed for the registration needs to be accompanied by musical notation as it makes the sound "perfectly recognizable and leaves no room for doubt". The draft manual requires graphical notation as a condition, but Manual does not differentiate between musical and non-musical sounds. How can one to depict a non-musical sound using graphical notation alone? The

³⁴ *Christian Louboutin SAS vs. Pawan Kumar and Ors.* (12.12.2017 - DELHC) 2018(73)PTC403(Del)

³⁵ *Honda AG v Harley-Davidson Inc*, 108 F 3d 1393 (Fed Cir 1997); *Harley-Davidson Inc v William Morris D/B/A Bill's Custom Cycles*, 19 F 3d 142 (3d Cir 1994); *Harley-Davidson Inc v Selectra International Designs*, 861 F Supp 754, 754 (E D Wis 1994).

³⁶ *Deere and Co v S Harcharan Singh* (2015 (63) PTC433(Del))

³⁷ *ECJ Case C-2-283/01*

Yahoo registration in India comes to relevance here. If the mark is identical to the one filed in the US,³⁸ then it has both a verbal and a musical component. This verbalised component (a human voice yodelling ‘Yahoo’) cannot be adequately represented by musical notes alone. A news report suggests that a digital sample of the ‘Yahoo’ sound was submitted along with musical notation³⁹ and this is in keeping with international trends. If it is represented as a written description, this leads to ambiguity. There are a number of ways of vocalizing ‘Yahoo’. In the Indian context, the most vivid version is undeniably associated with the song ‘Yahoo! Chaahe Koyi Mujhe Junglee Kahe’ from the Hindi film *Jungle* (1961).⁴⁰

Any motion mark should have the capability of being ‘graphically represented’ to obtain registration in India. A motion mark is usually accompanied by a series of sequential still images showing the movement or change of position forming the sequence of motion for which the Applicant is seeking registration.

Doctrine of Functionality

The doctrine of functionality states that if products functional features are given a trade mark it would create a certain level of monopoly in the market. For example, the shape of a blade cannot be registered as it provides a technical result of its shape nature. If it is granted a trade mark registration, it would result in an unhealthy anti-competitive advantage to the owner of the trade mark. This barrier to registration applies to both technical features as well as aesthetic features. It affects any feature that “is essential to the use or purpose of the article or if it affects the cost or quality of the article”⁴¹

This poses an obstacle for registration of an unconventional trade mark. In the past, beer was sold in transparent bottles with no colour which resulted in the beer smelling bad because the UV Rays of Sun affected the transparent bottle. To come to a solution, brewers started using brown colour for beer bottles. However, because of shortage of brown bottles during World War II, it was swiftly replaced by use of ‘green’ bottles which also continued to keep the

³⁸ US Serial No. 75807526 and Registration No. 2442140.

³⁹ P. Manoj, Yahoo Awarded India’s First Sound Mark; Nokia in Queue LIVE MINT, Aug. 22, 2008; Yahoo! Yodels into India’s Trade Mark Registry MANAGING INTELLECTUAL PROPERTY WEEKLY NEWS, Sep. 1, 2008.

⁴⁰ A potentially (copyright) infringing clip is at: http://www.youtube.com/watch?v=IKBmYXt_v7w

⁴¹ Qualitex Co. v. Jacobson Prods. Co., 514 U.S. 159, 162, 165 (1995) (Supreme Court).

problem of UV Rays away. These two colours are used since then to attract various customers resulting from a rather functional feature. However, a trade dress or a shape of the beer bottle could be granted a registration. But slowly and steadily as single colour marks gained momentum, it was not a big deal to register a red sole or blue colour coconut oil bottle because of the fact that a feature may not only be added to benefit in use or any practical purpose but capriciously in order to give a distinctive appearance or characteristic to the company's product.

The main concern which is present in such cases is the uncertainty involved in getting registration for a functional feature or concept which would result in a permanent legal monopoly. This doctrine can be viewed as a part of the analysis in unfair competition, not as part of the analysis for trademark infringement claims.

Conflict with the statute

To register a non-conventional trade mark in India the first hurdle is from the Trade Marks Act, 1999 itself.

The shape mark has to qualify the criteria under Section 9 (3) of the Trade Marks Act, 1999. Under Section 9 (3), confining a trade mark to absolute ground of refusal of registration, implies that a shape of goods cannot be registered as a trade mark (a) if it results from the nature of goods itself (b) if it is necessary to obtain a technical result and (c) if it gives substantial value to the goods.

Section 10 of the Trade Marks Act gives liberty and/or discretion to the Tribunal to decide distinctive character of a trade mark where colour combination is wholly or partly forms integral part of the trade mark and is sought for protection.

Other Intellectual Property (IP) protection conundrum

The protection of non-conventional mark under Trade Marks Act always raises a conflict between other intellectual property protections as these marks technically constitute subject matter of other intellectual property and by stretching the scope of the same they are being registered under Trade Marks Act for acquiring perpetual protection and monopoly or exclusivity in the market.

A process patent for a distinctive smell could also be granted. In 2019, a chemical with the trade name Thesaron, became an essential ingredient in a new perfume, Silver Shadow Altitude, released by Davidoff, a brand owned by Coty. Drug companies have long made a lot of money by patenting new molecules. The scent makers Symrise of Holzminden, Germany; Givaudan of Geneva; International Flavours and Fragrances of New York; and Takasago of Tokyo spend billions on research to find new smell molecules, patent them and sell them. Each molecule is assessed for potential commercial value and each must pass toxicology tests. Those selected for the patent process are submitted to patent offices around the world. Responses typically arrive in six months to several years. In the United States, patents generally run for 20 years, but after about ten years, scent makers start selling captives to their competitors, sacrificing exclusivity but generating another revenue stream. One recent successful Takasago captive is l-muscone. A musk, l-muscone has been known for years, but no one could come up with a way to make it economically until Takasago did. It then patented not the molecule but the synthesis pathways to produce it.⁴² This could also be another way to protect a smell mark. If the essential molecule or the process itself is granted a patent then no one could reproduce the smell except the original creator in the first place, or it would amount to patent infringement.

The Courts in India are frequently seen facing challenge in drawing distinction from design as all the features in a shape mark which are subject matter of Designs Act as well. Section 2 (d) of the Designs Act, 2000 specifically describes that the shape of goods is liable to protection as a design. The basic difference is that the shape that qualifies as a trade mark should be directly relatable to the source of the goods; on the other hand the aesthetic appeal is sufficient for a shape to be registered as a design. The recent trend acquired by the manufacturers is that a registration of design is acquired in the beginning which is termed for 15 years and upon maturity the same is applied as a trade mark for acquiring perpetual protection for the mark.

Carlsberg had constituted a suit for design infringement and passing off of their "TURBO" beer bottles against Som distilleries' "HUNTER" beer bottles with numerous identical features. It was argued by the Defendant that in the earlier decisions of *Micolube* and *Dabur India v R.K. Industries* it was constituted that joinder of design infringement and passing off cannot be entertained. However, it was argued by lawyers representing Carlsberg that the

⁴² Chandler Burr, *Ahhh, the Seductive Fragrance of Molecules Under Patent*, THE NEW YORK TIMES (February 23, 2008), <https://www.nytimes.com/2008/02/23/business/worldbusiness/23perfume.html>

joinder was disallowed in case of Dabur India v R.K. Industries because one of the causes of action was not covered as a part of Court's jurisdiction. After dwelling into the past decisions the court came to the conclusion that a composite suit can be filed for design infringement and passing off. The five judge bench also clarified that the remedy for passing off for a registered design can be brought if the said design is not functioning as a trade mark and if passing off is claimed for trade dress or any other similar kind of infringement. The difference between a claim for registered design and trade dress was brought out in this judgment in the following way: "...if the registered design per se is used as a trade mark, it apparently can be cancelled. The larger legal formulation in Mohan Lal (supra), that a passing off action i.e. one which is not limited or restricted to trademark use alone, but the overall get up or "trade dress" however, is correct; as long as the elements of the design are not used as a trademark, but a larger trade dress get up, presentation of the product through its packaging and so on, given that a "passing off" claim can include but is also broader than infringement of a trademark, the cause of action against such use lies."⁴³

Shape marks are also subject matter of copyright under the scope of artistic work. The packaging of the product or shape of product is often found to be registered as a copyright for acquiring maximum protection.

Infringement of non-conventional trademarks

The issue regarding enforcement of a smell mark is related to be the 'subjective perception of smell mark'. A smell might be perceived in a different way by certain people. This makes it tough to decide 'what constitutes as infringement of a smell mark?'

Perception of smell of an individual is result of various factors such as temperature, humidity and wind conditions as well personal factors of age, gender or genetic factors. Further, some people do not have a strong sense of smell as compared to others. These factors might make it difficult to explain in court how one smell is infringing the other smell mark. As far as smell mark is concerned, there has not been litigation so far. This makes it even more confusing as there is no precedence on the process of infringement being handled by any court till date.

While this practice is becoming widely used, it is not an infallible method of detecting scent infringement or making scent profiles, as the court noted in Sherrell Perfumers Inc. v. Revlon Inc., without a universal method of identifying and classifying scents and given their

⁴³ Carlsberg Breweries A/S.Vs. Som Distilleries and Breweries Ltd., C.S. (COMM) 690/2018 (India)

subjective nature, consumers are bound to be confused as more scents enter the marketplace. Without the ability to distinguish scents accurately, proving infringement might be an almost impossible task.

India has never seen an infringement suit for a smell/olfactory mark. Nevertheless, many non-conventional marks such as sound marks, colour combinations as well as single colour marks, shape marks and motion marks have been granted Protection in India. This shows that India is progressing towards registration of non-conventional marks and it won't be long before a smell mark will be granted registration as well.

And as far as infringement of smell marks is concerned, the 2015 Regulation of the European Union has provided for the use of generally available technology in order to represent the olfactory mark. Hence, the following technologies could be used to identify a smell:

- i) Sensory assessment (which might not always work, as we have established above)
- ii) Scentography is the technique of creating and storing odour by artificially recreating a smell using chemical and electronic means.
- iii) Digital Scent Technology is a specific engineering discipline dealing with olfactory representation. The main goal of this technology is to transmit and receive 'scent enabled' digital media including web pages, video games and movies.
- iv) 'An Electronic Nose' is another device used to detect odours.
- v) 'A Scent Dome' also known functionally as "smell sampling by PC" is a peripheral device attachable to PC used for creating smell simulations for the users.⁴⁴

Although, there has been no case of infringement for such a trade mark but how far would the rights extends for motion marks? Can Amazon take action against any other User Interface which contains blue gradient or circles or circles with voice assistance? It is interesting to find out how far our legal framework can reach to ensure the brands upcoming rights to protect.

⁴⁴ Sankalp Malik, Keshav Seth, Aditya Puri, *PROPERTY RIGHTS OVER FRAGRANCES, SMELLS AND PERFUMES PROTECTING YOUR AROMA CREATION AGAINST COMPETITIVE IMITATION & REGISTERING SCENTS AS COMMUNITY TRADE MARKS*, The Law Brigade (Publishing) Group, August 2018, <http://thelawbrigade.com/wp-content/uploads/2019/05/Sankalp-Keshav-Aditya.pdf>

CONCLUSION

A particular feature of a product which is desired by general customer at large so much so that the said uniqueness itself becomes distinctive acquiring goodwill for that product. The distinctive quality of a product such as smell, touch, sound, shape is non-traditional source identifiers such as traditional notations as a brand name or a logo.

A non-conventional trade mark becomes a source identifier in the minds of public comparatively quicker than that of a traditional trade mark. In India, a trade mark is a perpetual existing intellectual property, upon which the manufacturers possess a right to protect the non-conventional features of their product specifically under Trade Marks Act. Smell and touch marks are yet to be acceptable as a trade mark in India. The non-conventional trademarks are difficult to become generic as compared to traditional trade mark. The non-conventional trademarks might get the well-known status easily due to their prolonged usage and popularity. The non-conventional trademarks are definitely proving to be the means of increasing creativity in manufacturers to make their product distinctive in nontraditional way.

On the other hand, the disadvantage of acquiring registration of a non-conventional trade mark is that it may lead to unfair competition and monopoly in the market. This may lead to other manufacturers facing difficulty in achieving a substantial market for their product. In India, a strong mechanism is required to identify the non-conventional trademarks through strong legislative back up. As analyzing the distinctiveness and deciding if the mark is worthy of protection is discretion of the examiner and/or registrar, the legislature shall consider engaging experts in the field to determine the registrability of the non-conventional trade mark.

Therefore, it can be said that India being fairly accustomed to non-conventional trademarks still has a long way to go in recognizing the status of the said marks statutorily.
