E- Journal of Academic Innovation and Research in Intellectual Property Assets (E-JAIRIPA)
Vol. I (I), July-Dec. 2020, pp. 116-132

NON-CONVENTIONAL TRADEMARKS IN INDIA: THE WHAT, THE WHY AND THE HOW

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ABSTRACT

Due to the cut-throat competition prevalent in the market today, companies and corporates are often forced to spend a huge chunk of their resources, financial and otherwise, on developing their goodwill and brand image. They often spend considerable amount of time and effort in distinguishing their products from those of their competitors and also try their level-best to make their goods and services stand out. Consumers, nowadays, hence recognise products and brands and buy accordingly. The scent, colour, shape, sound, etc. of goods and services thus play an important role in product recognition in present-day society. In such a scenario, there are increased chances of trademark infringement, passing off, deception, etc. which is highly likely to negatively impact businesses and their reputation. This is where unconventional trademarks come into the picture. However, unconventional marks are a relatively new concept in India and thus there is a dearth of legal jurisprudence in this regard. Also, despite the existence of the TRIPS agreement and other such international conventions and treaties, trademark laws are not uniform and hence differ from jurisdiction to jurisdiction. In addition to this, not all types of unconventional trademarks have received adequate legal acceptance in India and the world over. This paper hence mainly focuses on examining the legal status of unconventional trademarks in developed countries such as the European Union and the United States, analysing the position of such marks in India and thereafter arriving at suitable suggestions and recommendations as to how the current legal scenario in India with regard to unconventional marks can be further improved. The paper also seeks to understand more about unconventional marks by throwing light upon their evolution, classification, etc.

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INTRODUCTION

Trademark law is one of the most intriguing topics under the realm of intellectual property and there have been so many developments in this particular area of law recently. A trademark is basically an intellectual property that helps consumers identify a particular brand, service or goods in the market.[3] It protects the manufacturer or proprietor of the goods from unlawful imitation of the product and preserves the interest of the consumers as well as helps avoid unwanted confusion.[4] Generally, trademark protection is given to traditional marks like logos, symbols, images, captions, signs, names, etc. but due to the aggressive and ever-increasing competition between manufactures of physical commodities nowadays, it has become extremely important for them to stand out in the commercial market.[5] Thus, brands have become more creative and adopted new non-conventional trademarks for identification of their products in the market.

Non-conventional or non-traditional trademarks are basically marks that are not included in the traditional set of marks and hence include touch, smell, colour, shape, texture, sound, taste etc.[6] Usually, trademark protection is given only to marks which can be graphically represented, yet non-conventional trademarks are registered and given protection due to the ability of these marks to create a particular level of identification in the minds of consumers.[7] The registration and protection of trademarks is governed by the TRIPS agreement and as far as the agreement is concerned, a trademark should be able to perform its primary functions and it is not mandatory for a trademark to be tangible, visually perceptible or graphically representable.[8] Therefore, registration of non-conventional trademarks, especially sound, has become very common in US and EU.

As per the Indian Trade Marks Act, 1999, registration of trademarks is only possible if it has the ability to distinguish itself from other products and has the capability to be graphically

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[3] Vatsala Sahay, Conventionalising Trademarks of Sounds and Scents: A Cross-Jurisdictional Study, 6 NALSAR Student Law Review 128, 128-141 (2011).
[4] Tanusree Roy, Registrability of Smell Mark as Trademark: A Critical Analysis, 4 Journal on Contemporary Issues of Law 121, 121-130 (2018).
[5] Sanya Kapoor & Riya Gupta, The Five Senses and Non-Traditional Trademarks, 8 Supremo Amicus 214, 214-231 (2015).
[6] David Vaver, Unconventional and Well-Known Trade Marks, Singapore Journal of Legal Studies 1, 1-19 (2005).
[7] Faye M. Hammersley, The Smell of Success: Trade Dress Protection for Scent Marks, 2 Intellectual Property Law Review 105, 105-156 (1998).
[8] Dr. Mwirigi K. Charles & T. Sowmya Krishnan, Registrability of Non-Conventional Trademarks: A Critical Analysis, 6 International Journal of Research and Analytical Reviews 914, 914-923 (2019).

represented.[9] In the case of non-conventional trademarks, though they perform the primary function of a trademark, the registration is so far a difficult procedure in the country mainly due to its distinctiveness criterion and its lack of ability to be graphically represented.[10] There are also chances that these marks can give rise to confusion among the consumers, thus defeating the very purpose of trademarks.[11] However, non-conventional trademarks is still a developing concept in India and there has been a lot of debate and discussion whether it can be considered as a trademark in the absence of its ability to be graphically represented.[12] The article mainly tries to throw light upon the position of protection and registration of non-conventional trademarks in India and also tries to highlight the complexities and technicalities involved in the protection of non-conventional trademarks by analysing the position of this concept cross-jurisdictionally.

LITERATURE REVIEW

Vatsala Sahay in **"Conventionalising Trademarks of Sounds and Scents: A Cross-Jurisdictional Study"[13]** examines the status of unconventional trademarks such as sound, scent and shape in three different jurisdictions: EU, US and India. From this article, it can be understood that the United States adopted a rather liberal approach whereas the European adopted a rather cautious approach and India, being a former British colony, basically just followed the example that had been set by the European Union with regard to the registration and application of non-conventional trademarks.

Dev Gangjee in **"Non-Conventional Trademarks in India"[14]** focuses on three main aspects: the functional definition of the term 'trademark', graphical representation and other such procedural requirements for the registration and application of such marks in India and the outer limits of the said definition, i.e., what all can be brought under the ambit of the term. With respect to the requirement for graphical representation, the article draws attention to the difficulty that is faced by firms in representing sound, scent or texture marks on paper using words, drawings, etc. The paper also explains the Seickmann criteria and its

[9] Section 2, Trade Marks Act, 1999.
[10] Supra 3.
[11] Arka Majumdar, Subhojit Sadha & Sunandan Mujumdar, The Requirement of Graphical Representation for Non-Conventional Trademarks, 11 Journal of Intellectual Property Rights (2006).
[12] Sudipta Bhattacharjee & Ganesh Rao, The Broadening Horizons of Trademark Law - Registrability of Smell, Sports Merchandise and Building Designs as Trademarks, 10 Journal of Intellectual Property Rights 119, 119-126 (2005).
[13] Vatsala Sahay, Conventionalising Trademarks of Sounds and Scents: A Cross-Jurisdictional Study, 6 NALSAR Student Law Review 128, 128-141 (2011).
[14] Dev Gangjee, Non-Conventional Trade Marks in India, 22 National Law School of India Review 67, 67-96 (2010).

corresponding provisions in the Draft Manual of Trade Marks Practice and Procedure along with the Shield Mark case in an attempt to explain the graphical representation requirement in a better manner.

Tanushree Roy in **"Registrability of Smell Mark as Trademark: A Critical Analysis"**,[15] mainly focus on three main areas, the importance of smell mark in the global scenario as well as its position in countries like U.S, EU, Australia, New Zealand and India, the advantages as well as the disadvantages that is associated with the registrability of smell mark as trademark and a very crisp critical analysis on the smell mark according to the information obtained to the author through the research conducted by her. Along with his, the author also discuss about the challenges that is associated with the registration of smell mark in the present times.

Kuruvila M Jacob and Nidhi Kulkarni in **"Non-Conventional Trademark: Has India Secured an Equal Footing"**[16] first and foremost chalk out the problems such as 'piracy', 'plagiarism' and 'intellectual theft' that would result if trademarks were not granted to inventors and creators of intellectual property. They also draw attention to the objective behind the granting of trademark status, i.e., protection of innovative capabilities and stifling of anti-competitive tendencies. In addition to this, they discuss the evolution and types of unconventional trademarks and the legal position of these marks in India placing special emphasis on graphical representation. They also attempt to throw light on the vague definitions provided in domestic legislations such as the Trade Mark Rules, 2017.

Riya Gupta and Sanya Kapoor in "**The Five Senses and Non-Traditional Trademark"**[17] puts light upon the registrability of non- conventional marks and their relevance in our commercial markets. The author mainly gives emphasise upon the situation in India and the changing perspective towards the non-conventional trademark in different places. The paper also focus upon the need to bring immediate changes in the existing law and provides some suggestions for a better enforcement of non- conventional trademarks.

[15] Supra 4
[16] Kuruvila M Jacob & Nidhi Kulkarni, Non-Conventional Trademark: Has India Secured an Equal Footing, Indian Journal of Intellectual Property of Law 47, 47-72 (2018).
Kuruvila M Jacob & Nidhi Kulkarni, Non-Conventional Trademark: Has India Secured an Equal Footing, Indian Journal of Intellectual Property of Law 47, 47-72 (2018).
[17] Supra 5

TYPES OF UNCONVENTIONAL TRADEMARKS

A. Smell Trademarks/Olfactory Trademarks

Smell is one of the most powerful senses of human beings, which has the ability to recollect past experience effortlessly. Though many countries have accepted the registration and protection of the smell of products as trademarks, the registration still continues to be a difficult process due to its inability to be graphically represented and the herculean task required to shows its distinctiveness from the product.[18] In many cases, the smell has been illustrated by writing down the chemical formula of the substance. However, there are companies that completed all the required tests successfully and registered smell as their trademark. For instance, the scent of roses of a UK tyre company, smell of beer in the dart flights of a London- based company are famous examples of smell trademarks.[19]

B. Taste Trademarks

The illustration of taste mark is considered to be one of the most difficult and challenging when compared to other non-conventional trademarks, but some countries have accommodated the registration of flavour as a trademark to identify products in the commercial market.[20] Generally, the illustration of taste mark is made by providing a written explanation of the taste. Just like smell mark, it is mandatory that the taste mark should be distinctive from the inherent function performed by the product.[21] However, there are a lot of debates and discussions on the registration of taste as trademarks for services.

C. Motion Trademarks/Movement Trademarks

Few countries accept the trademark registration of moving pictures, videos, cinematography, video clips of documentaries or films, etc.[22] Famous motion trademarks include the 20th Century Fox Movies, Columbia Pictures, Microsoft Windows logo that appears when we open a Windows desktop. etc.[23] In India, the registration of motion marks is rising into prominence when compared to other non-convention marks due to many big movie companies prevailing in the country.

D. Touch Trademarks/Texture Trademarks

Touch mark, also known as texture mark, is not as frequently used like other trademarks and

[18] Smell, Sound and Taste-Getting a Sense of Non-Traditional Marks, WIPO (Aug 29, 2020, 8:12 PM), http://www.wipo.int/wipo_magazine/en/2009/01/article_0003.html, last seen on 10/11/2016.
[19] Id.
[20] Thomas A. Gallagher, Non-Traditional Trademarks: Taste/Flavour, The Trademark Reporter (Aug 29, 2020, 8:20 PM), http://www.inta.org/TMR/Documents/Volume%20105/vol105_No3_a4.pdf.
[21] Id.
[22] Archi Bhatia, Registration of Motion as Trademark, iPleaders (Aug 29, 2020, 8:30 PM), https://blog.ipleaders.in/motion-mark-as-trademark/.
[23] Id.

is therefore the least claimed non-conventional trademark. For registration of a touch mark, it is extremely important that it should carry a meaning and should not be a mere ornamental packaging of products or services.[24] The velvet touch trademark of Khvanchkara wine bottles and leather-like material on the packaging of brandy or grappa are examples of touch as trademark.[25]

E. Hologram Trademarks

Hologram marks are non-conventional trademarks that use a combination of images and colours that are visible only when viewed from a particular direction and therefore it is extremely difficult to show the trademark on paper since it will not be able to capture all the motion of the mark.[26] These types of marks are mainly used by companies to avoid unwanted false imitation of goods and services. The trademark on the toothpaste of Glaxo Groups is one of the most famous examples of the hologram mark.[27]

F. Colour Trademarks

Colour is something which is seen everywhere and the distinctiveness of colour is therefore an unsolved question. The colour trademark is accepted for combination of colour but registration of a single colour mark still forms a grey area as it lacks the intrinsic ability to be distinctive and it may lead to confusion for consumers as there are lot of shades for a single colour.[28] Another problem pertaining to the registration of single colour is that, if trademark registration is allowed for a single colour, then it will cause problems from the other front runners and hence it will end up in no one using the colour as the number of colours are very limited. Royal purple colour of Cadbury, a protected shade of pink of the Barbie company, Canary yellow of 3M company are some of the well-known colour trademarks in the world today.[29]

G. Shape Marks

Just like colours, textures and other non-conventional trademarks, the shape of a product can also be protected if the consumer identifies that particular shape with the product. The Trade Mark Act, 1999 and the UK Trade Mark Act, 1994 include shapes as marks in their definition of trademark.[30] However, just like other non-traditional trademarks, registration of shape

[24] Tanisha Agarwal & Vanshaj Mehta, Hear Me, Touch Me, Taste Me, Smell Me: Conventionalizing Non-Conventional Trademark in India, 3 Journal of Contemporary Issues of Law 1, 1-22 (2017).
[25] Id
[26] Id
[27] Id.
[28] M M S Kharki, Non-Traditional Areas of Intellectual Property Protection: Colour, Sound, Taste, Smell, Shape, Slogan and Trade Dress, 10 Journal of Intellectual Property Rights 499, 499-506 (2005).
[29] Id.
[30] Lisa P. Lukose, Non-Traditional Trademarks: A Critique, 57 Journal of the Indian Law Institute 197, 197-215

marks face a lot of challenges due to its inability to be graphically represented as well as difficulty in showing distinctiveness. Yet, there are a lot of companies that were able to protect the shape of the product such as the shape of a chocolate called Toblerone, shape of zippo lighters, shape of Coco-Cola bottles, etc.[31]

H. Sound Trademarks

Sound mark or auditory marks can be anything which is auditory in nature. When compared to other non-conventional trademarks, sound mark is the most registered and protected one and it is gaining wide popularity in many countries especially in US.[32] Sound mark performs the function of helping consumers uniquely identify a particular product in the commercial market without causing much confusion. Unlike other non-conventional trademarks, sound mark has the capability to be graphically represented using a series of musical notes with or without the usage of words. Some of the oldest and famous registered trademarks in this regard are the sound of Harley Davidson, Nokia tune, Tarzan Yell, etc.[33]

EVOLUTION OF UNCONVENTIONAL TRADEMARKS

Traditional trademarks such as logos, symbols, captions, signs, names and images have been used to distinguish products, services or brands since a very long time but there has been a paradigm shift in branding strategies in recent years due to which unconventional marks such as colour, shape, smell, taste, etc. have been used by different companies to distinguish their products in the global market.[34] The debates and discussions on trademark protection of non-conventional marks has been prevailing for more than 100 years now. Even though legal protection and registration of non-conventional trademarks has developed very recently, it has been used by many famous brands for more than a decade now.[35] For instance, the shape of the bottle of the Coca-Cola drink, the blue gift box of the Tiffany company that helps to create a unique identification among the consumers and the pink colour trademark of the Owens Corning Corporation are some of the initially registered well-known non-conventional trademarks.[36]

(2015).

[31] Dr. Mohan Dewan, Registering Shapes in India: Guidelines and Processes, Lexology (Aug 29, 2020, 1:00 PM), https://www.lexology.com/library/detail.aspx?g=94e581ac-5333-4a72-8dfc-111d746af82d

[32] Id.

[33] Harshada Wadkar, Non-Conventional Marks, Lexology (Aug 30, 2020, 8:50 PM), https://www.lexology.com/library/detail.aspx?g=4339efff-eba0-4339-a5f9-47f2d72ae7d1.

[34] Lindstorm Martin, Brand Sense, Build Powerful Brands Through Touch, Taste, Smell, Sight and Sound, Kogan Page Publisher (2005).

[35] Supra 19.

[36] Id.

The WIPO established a committee for the study of trademark called the Standing Committee on the Law of Trademark. The committee analysed non-conventional trademarks and classified them into visual and non-visual marks. Visual trademarks include colour, shape and holograms while non-visual trademarks include sound, taste, smell and texture. Later in 1956, it was understood that the definition given to trademark was very general in nature. The issue was first time discussed in the Vienna meeting and then in Brussels.[37] In 1994, the TRIPS agreement sanctioned the start of development in trademark rights. The definition offered by the TRIPS agreement on trademark was wide and was given on the basis of the nature of the marks that can be considered as trademark and according to the functional definition, the unique function of trademarks is also imperative to grant protection.[38] Article 15 of the TRIPS agreement provided a very ambiguous list of what can be considered as trademark which included signs, logos, symbols, letters and combination of colours or signs as well. As far as the TRIPS agreement is concerned, unconventional trademarks should also be protected since they are used as a trademark and also have unique character that will help to distinguish a particular product.[39] From the 19th century, a lot of solid scholastic works as well as debates were conducted in Europe pertaining to the granting of protection to non-conventional trademarks. An argument in Bolivia was also conducted in the early 20th century in which non-conventional marks like sound, shape, etc. was granted protection as they were capable of being represented graphically and had distinctive character.[40] Though registration and protection of non- conventional trademarks have been continuously stirring for the last 20 years, they still have a lot of problems especially in case of visually non-perceptible non-traditional trademarks like smell, touch and taste as they could create a lot of confusion in the mind of consumers and also due to the inability of these marks to be graphically represented.[41]

[37] Tanisha Ranjan, India: Protection of Non-Conventional Trademarks, Fast forward Justice's Law Journal (Aug 25, 2020, 9:00 PM), https://fastforwardjustice.com/india-protection-of-non-conventional-trademarks/.
[38] Kenneth L Port, On Non-Traditional Trademarks, William Mitchell College of Law Legal Studies Research Paper Series (Aug 27, 2020, 8:00 AM), https://ssrn.com/abstract=1564230.
[39] Id.
[40] Shikhar Sinha & Kunal Gopal, Tracing the Jurisprudence of Smell Marks as a Trademark, 1 HNLU Student Bar Journal 61, 61-69 (2017).
[41] Id.

POSITION OF UNCONVENTIONAL TRADEMARKS UNDER EU AND US JURISDICTION

1. EU

The Trade Marks Act, 1994; enacted in implementation of EU Directive 89/104/EEC; controls and regulates trademarks and their registration in the United Kingdom and their dependency, the Isle of Mann.[42] The first olfactory mark to have been sought under the Act had been the fragrance of the perfume Chanel No. 5 by the company Chanel in 1994. The scent was, however, not granted trademark status as the fragrance, which was to be trademarked, and the perfume, which was the product, were deemed to be one and the same.[43] At around the same time, however, the applications of Sumitomo Rubber Co.'s scent of roses with respect to their tyres[44] and Unicorn Products' smell of beer with regard to their darts[45] were accepted by the UK Patent Office.

Graphical representation has always been an important consideration for the acceptance or rejection of any application in the European Union. In the landmark case of Raf Sieckmann v. Deutsches Patent und Markenamt,[46] an application for the trademarking of a particular scent was submitted by Mr. Sieckmann on behalf of his company and the chemical composition, chemical formula, description in words, sample, etc. of the said scent were also attached along with the application. Trademark status was, however, not granted as the graphical representation that had been provided was deemed to not have been sufficient. In this regard, the ECJ pacing reliance on Article 2 of EU Directive 89/104/EEC, opined that samples did not amount to graphical representations and that though description in words was tantamount to graphical representation, it was not possible to properly understand a scent through such description. They also opined that chemical compositions, chemical formulas and the like only depicted ingredients to create the scent and not the scent per se. The court thereafter highlighted the importance of graphical representation and held that such representation must be *"clear, precise, self-contained, easily accessible, intelligible, durable and objective"*. This is now

[42] Paul Leo Carl Torremans, Trademark Law: Is Europe Moving Towards an Unduly Wide Approach for Anyone to Follow the Example?, 10 Journal of Intellectual Property Rights 127, 127-132 (2005).
[43] Nathan K G Lau, Registration of Olfactory Marks as Trademarks: Insurmountable Problems?, 16 Singapore Academy Law Journal 264, 265 (2004).
[44] Sumitomo Rubber Co's Application No. 2001416, 31 October 1994.
[45] Unicorn Products' Application No. 2000234, 31 October 1994.
[46] Raf Sieckmann v. Deutsches Patent und Markenamt, Case C-273/00, European Court of Justice.

referred to as the Sieckmann test. It was applied in several other cases later on including the case of Apple Inc v. Deutsches Patent und Markenamt.[47]

In the landmark case of Shield Mark BV v. Kist,[48] wherein the company Shield Mark BV filed a suit against their competitor Joost Kist for infringement of their aural mark, the ECJ held that a sound could be trademarked so long as it was distinctive in nature and could be represented graphically. Placing reliance on Article 2 of EU Directive 89/104/EEC and the Seickmann case, they opined that description in words such as *"crow of a rooster"*, *"first nine notes of Fur Elise"*, etc. would not amount to graphical representation. They also opined that onomatopoeia would not amount to graphical representation but that representation by way of musical notes or other such notations would suffice. In this case, only those sounds which had been trademarked in this manner hence received protection. This case also became the basis for many future judgements and decisions in Europe and other countries such as India as well. However, as the requirement of graphical representation has now been removed as per EU Trademark Directive 2015/2436 and EU Trademark Regulation 2015/2424, registration of unconventional trademarks such as marks pertaining to smell, taste, movement, touch, colour, shape, sound, etc. have become much easier.[49]

2. **US**

The approach toward unconventional trademarks is very different in US when compared to other countries like EU and India. In US, the provisions for registration and protection of trademarks are laid under the Lanham Act. As per the Act, *"protection can be granted to any words, symbols, name or any combination if they are used to identify and distinguish goods or services of one undertaking from those of other undertaking"* and therefore the ability to be graphically represented is not mandatory in the country.[50] The purpose of graphical representation for the registration of trademarks is to make other companies aware about what has been trademarked.[51] Section 1052 of the Lanham Act gives a negative definition of trademark and also specifies about the pre-requisites for its registration. According

[47] Apple Inc v. Deutsches Patent und Markenamt, Case C-421/13, European Court of Justice

[48] Shield Mark BV v. Kist, Case C-283/01, European Court of Justice.

[49] Supra 37.

[50] Linda B. Samuels & Jeffrey M. Samuels, Colour Trademarks: Protection under U.S. Law, 15 Journal of Public Policy & Marketing 303, 303-307 (1996).

[51] Kuruvila M Jacob & Nidhi Kulkarni, Non-Conventional Trademark: Has India Secured an Equal Footing, Indian Journal of Intellectual Property of Law 47, 47-72 (2018).

to this legal provision, a trademark should fulfil requirements such as non-functionality, distinctiveness or acquired distinctiveness which will aid the consumers to identify a specific product from other products.

The 1988 Congress purposefully retained terms like 'symbols' and 'devices' in the definition of trademark under Section 15 of the Act in order to include registration of non-conventional trademarks like smell, sound, shapes, etc.[52] Therefore, the legal statute in US for trademark does not prevent the registration and protection of sounds and scents. The liberal nature of the Supreme Court in the registration of unconventional trademarks is made evident in the case of Qualitex Co. v. Jacobson Products and Co.[53] In this case, the Supreme Court stressed upon the primary function of a trademark, i.e., distinctiveness as imperative for registration and protection and not its capability to be graphically represented.[54]

Trademark law in US mainly concentrates upon a functionality doctrine known as doctrine of protection. According to this doctrine, the trademark should not have a direct connection with the products or services. In the case of Re Celia,[55] the court held that the function of the product marketed should not have any connection with the smell of the product which is registered as its trademark. In the landmark case of Louboutin v. Yves Saint Lauret America Holding, Inc.,[56] the court highlighted the practical method of impeding the functional feature of a product under the trademark and said that it should be brought under the patent law.

There are mainly 2 types of functionality known as traditional functionality and aesthetic functionality that can be used as a defence for trademark infringement claim. The defence of traditional functionality can be used if it is *"essential to the use and purpose of the product"* or if *"it effects the cost or quality of the product"* and in this case, the state will not grant protection of trademark. Furthermore, it is considered to be more rational to give patent protection rather than trademark protection as it can be renewed. Even if the product does not feature traditional functionality, it is mandatory to pass the aesthetic functionality test which will provide it with more competitive benefits. Altogether, it is very evident that the registration and protection of non-conventional trademarks such as scent, sound and

[52] S Rep 515, 100th Cong 2nd Session 44 (1988).

[53] Qualitex Co. v. Jacobson Products Co., 514 US 159 (1995).

[54] Brinks Hofer Gilson & Lione, The Sound of Non-Conventional Marks in the United States, World Trademark Review 94, 94-95 (2007).

[55] Re Celia, 217 U.S.P.Q.2d.1238 (1990).

[56] 392Louboutin v. Yves Saint Lauret America Holding, Inc., 696 F.3d 206 (2012).

other visually imperceptible marks that can be clearly illustrated is very flexible and versatile in US.

One of the oldest and most well-known non-traditional mark that was registered in 1970 was the NBC Jingle under the set of sensory marks. Later, other companies were also successful in registering their marks such as the MGM and their lion roar, 20th Century movies, etc. The approach of US is very liberal towards unconventional marks and they are always open to new developments.

POSITION OF UNCONVENTIONAL TRADEMARKS IN INDIA

Section 2(1)(zb) of the Trade Marks Act, 1999 defines a trademark *as "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"* and Section 2(1)(m) defines a mark as *"A device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination thereof"*. Unconventional trademarks are hence slowly but steadily making their way into Indian jurisprudence.

3. **Sound Trademark**

Yahoo Inc.'s three-note yodel[57] and ICICI Bank's corporate jingle,[58] granted trademark status in 2008 and 2011 respectively, are two of the best examples of sound marks in the country; the former being the first sound trademark to be granted in India and the latter being the first sound trademark to be granted to an Indian entity. Britannia Industries' four-note bell sound, Nokia mobile phone's default ring tone, MGM film's lion's roar, Raymond: The Complete Man's musical sequence, Edgar Rice Burroughs' Tarzan yell, National Stock Exchange's theme song, etc. are some of the other examples of sound marks in the country.[59]

For a sound to be registered as a trademark in India; an MP3 recording of the said jingle, chime or musical composition, which is not more than 30 seconds in length, has to be submitted to the Office of Registrar of Trade Marks as per Section 26(5) of the Trade Marks Rules, 2017. Additionally, a graphical representation of its notations also has to be submitted. Furthermore, according to the Draft Manual of Trade Marks Practice and Procedure, the application submitted should clearly

[57] P. Manoj, Yahoo Awarded India’s First Sound Mark; Nokia in Queue, Live Mint, Aug. 22, 2008.

[58] ICICI Secures Rights for Corporate Jingle, The Indian Express, Mar. 12, 2011.

[59] Labna Kably, Jingles and Chimes can make Trademark Noise, The Times of India, Mar. 27, 2017.

indicate that the trademark is being sought for a sound. Otherwise, the trademark being sought will be presumed to be for a word and will be examined as such.[60]

Just like in case of conventional trademarks, the distinctiveness of the mark, i.e., whether or not the sound has become synonymous with the product or service in the minds of consumers, will be the chief criteria for acceptance or rejection of the mark.[61] Additionally, the draft manual also stipulates that musical notes with or without words may be used in order to represent the jingle, chime, musical composition, etc. graphically, thereby conferring more clarity on Section 26(5) of the Rules.[62] The Shield Mark doctrine also finds application in India in this context.

4. Colour Trademark

Colour marks may be of two types: those pertaining to single colours and those pertaining to combination of colours.[63] Combination of colours find mention in Sections 2(1)(m), 2(1)(zb) and 10(1) of the Trade Marks Act, 1999. In furtherance to this, Section 26(2) of the Trade Marks Rules, 2017 stipulates that a reproduction of the mark should accompany applications seeking trademark for a combination of colours. However, single colour trademarks do not find mention anywhere in the Act. Additionally, Section 9(1)(a) of the Act prescribes that trademarks which are not distinctive should not be registered. This limits the scope of trademarking of colours in India as single colours are easily available and widely used and can hence be argued to not be distinctive in nature. Furthermore, the colour depletion theory, i.e., the limited availability of colours in the world also comes into the picture.[64] It can therefore be said that the law on trademarking of colours in India is ambiguous and that a huge amount of discretion in this regard has been conferred on the judiciary.

It can also be observed that the courts themselves have often delivered contradictory or conflicting judgements over the years. The exact position of colour trademarks in India is thus unknown. In the case of Colgate Palmolive Co. v. Anchor Health and Beauty Care Pvt. Ltd.[65] in 2003, the Delhi High Court restrained the defendant from

[60] Serial Number 12.2.5 of the Draft Manual of Trade Marks Practice and Procedure.
[61] *Id.*
[62] *Id.*
[63] Althaaf Marsoof, The Registrability of Unconventional in India and Sri Lanka: A Comparative Analysis, 12 Journal of Intellectual Property Rights 497, 497-506 (2007).
[64] Dev Gangjee, Non-Conventional Trade Marks in India, 22 National Law School of India Review 67, 67-96 (2010).
[65] Colgate Palmolive Co. v. Anchor Health and Beauty Care Pvt. Ltd., (2003) DLT 51.

using the red and white colour combination of the plaintiff in the packaging of their products and also opined that copying the colour of another product was tantamount to passing off. However, 4 years later, in the case of Cipla Ltd. v. MKI Pharmaceuticals,[66] wherein the plaintiff had sought an interim injunction restraining the defendant from using orange colour, similar to that of the plaintiff, in the production of their products; the court opined that there could not be monopoly over colours and thereafter held that copying the colour of another product did not amount to passing off.

Later on, the High Court of Delhi reiterated the Colgate Palmolive Co. judgement in the cases of Dabur India Ltd. v. Shree Baidyanath Ayurved Bhawan Pvt. Ltd.[67] and Seven Towns Ltd. and Ors. v Kiddiland and Ors.[68] A similar judgment was also passed in the case of Deere and Co. and Ors. v. S. Harcharan Singh and Ors.[69] However, in the case of *Britannia Industries Ltd. v. ITC Ltd.*,[70] wherein it had been alleged that the yellow and blue colour combination of ITC's Sunfeast Farmlite Digestive All Good Biscuit had been copied by Britannia's Nutri Choice Digestive Zero Biscuit, the Delhi High Court opined that ITC was not entitled to an interim injunction in this regard as it had failed to prove that this colour combination had become a "badge of its goodwill". Furthermore, in the case of *Christian Louboutin Sas v. Abu Baker and Ors.,*[71] *the court placing reliance on* Sections 2(1)(m) and 2(1)(zb) of the Trade Marks Act, *opined that* it was not possible to trademark single colours. The court hence held that the plaintiff's trademark, i.e., red colour on the soles of ladies' footwear had not been infringed by the defendant and thereafter dismissed the suit.

5. Shape Trademark

Shape of goods receives recognition as a trademark under Sections 2(1)(m) and 2(1)(zb) of the Trade Marks Act, 1999 just like combination of colours; provided the shape is distinctive in nature and can be graphically represented. Shape as a trademark also finds mention in Section 9(3) of the Act wherein it is stipulated that the shape to be trademarked should be distinctive from the good or service and

[66] Cipla Ltd. v. MKI Pharmaceuticals, (2007) (36) PTC 166 Del.
[67] Dabur India Ltd. v. Shree Baidyanath Ayurved Bhawan Pvt. Ltd., (2012) (51) PTC 441 (Del).
[68] Seven Towns Ltd. and Ors. v Kiddiland and Ors., (2016) (68) PTC 308 (Del)
[69] Deere and Co. and Ors. v. S. Harcharan Singh and Ors., (2015) (63) PTC 433 (Del).
[70] *Britannia Industries Ltd. v. ITC Ltd.,* 2017 (70) PTC 66 (Del).
[71] *Christian Louboutin Sas v. Abu Baker and Ors.*, (2018) 250 DLT 475.

should hence not be due to the nature of the product. The Section also prescribes that the shape must not have functional considerations, i.e., should not be in order to obtain a technical result. Additionally, the Section prescribes that the shape should not add any extra value to the good or service such that trademarking it would result in loss in value of the product to the manufacturers of similar goods and services. The Draft Manual of Trade Marks Practice and Procedure confers further clarity on shape marks and their registration in India.

Indian courts have also been more or less consistent in their judgements with regard to shape as a trademark. In the case of Lilly ICOS LLC and Anr. v. Maiden Pharmaceuticals Ltd.,[72] wherein it had been alleged that the almond shape of the plaintiff's product had been copied by the defendant, the Delhi High Court passed judgement in favour of the plaintiff and thereafter issued an injunction against the defendants in this regard as it was of the opinion that the defendant had adopted such shape with deceptive intent. Furthermore, in the case of Gorbatschow Wodka KG v. John Distilleries Ltd.,[73] the Bombay High Court held the shape of the plaintiff's vodka bottles to be a trademark and thereafter granted them an injunction against the defendants as it agreed with their claim that the shape of their bottle was distinctive in nature and also contributed to the goodwill of their product.

It is also important to note that even prior to the enactment of the present Act, shape had been recognised by the Indian Judiciary as trademark. In the case of MRF Ltd. v. Metro Tyres Ltd.[74] in 1990, wherein the plaintiff had sought a permanent injunction restraining the defendant from manufacturing and selling tyres with tread patterns similar to their own, the Delhi High Court favoured the plaintiffs as it was of the opinion that similar patterns as in the present case would result in confusion amongst consumers with regard to the origin of the product. A similar judgement was also passed later on in the case of Zippo Manufacturing Company v. Anil Moolchandani and Ors.[75] in 2011.

Other Unconventional Trademarks

Apart from the above-mentioned sound, colour and shape marks; there also exists

[72] Lilly ICOS LLC and Anr. v. Maiden Pharmaceuticals Ltd., 2009 (39) PTC 666 (Del).
[73] Gorbatschow Wodka KG v. John Distilleries Ltd., 2011 (47) PTC 100 (Bom).
[74] MRF Ltd. v. Metro Tyres Ltd., 1990 PTC 101.
[75] Zippo Manufacturing Company v. Anil Moolchandani and Ors., 2011 (48) PTC 390 (Del).

several other unconventional trademarks in India such as smell, taste, touch and movement marks. However, these marks have neither been included in nor excluded from Indian trademark laws such as the Trademarks Act, 1999; Trade Marks Rules, 2017 and Draft Manual of Trademarks Practice and Procedure. Additionally, though words such as "shape of goods" and "combination of colours" find mention in the definition of the term "trademark" provided in the Trademarks Act; smell marks, taste marks, touch marks, movement marks, etc. do not find mention anywhere in the Act, let alone this particular definition. It can hence be said that India suffers from a dearth of laws in this regard and it is therefore difficult to determine the exact legal position of these marks in the country. In addition to this, provisions such as Section 26(1) of the Trademarks Rules, that makes the graphical representation of marks mandatory for the grant of trademark status, further complicate and act as barriers to the registration of these marks.[76]

CONCLUSION

Trademarks help consumers in recognising product origin and thereby help in the building of goodwill, brand image, reputation, etc. Trademarks are also likely to create brand loyalty amongst consumers. Businesses, nowadays, hence spend a considerable amount of their time, money and effort in making their goods and services unique so as to distinguish them from those of competing firms manufacturing and selling similar products. However, gone are the days when product differentiation was brought about merely through conventional trademarks. Nowadays, all possible senses of a consumer such as smell, sound, taste, touch, etc. are targeted and utilized by firms in this regard. In such a scenario, there is an increased chance of trademark infringement, passing off, etc. which will negatively impact businesses. This is where unconventional trademarks come into the picture. However, the concept of unconventional marks has not been properly explored in India and there is hence a dearth of legal jurisprudence in this regard. Despite the existence of several laws and legislations in the country pertaining to trademarks such as Trade Marks Act, 1999; Trade Marks Rules, 2017 and Draft Manual of Trade Marks Practice and Procedure; not all types of unconventional marks have received adequate legal acceptance. Also, the number of unconventional marks that have been registered in India is very less when compared to other countries such as the

[76] Neha Mishra, Registration of Non-Traditional Trademarks, 13 Journal of Intellectual Property Rights 43, 43-50 (2008).

European Union and the United States. It is highly advisable that India take a leaf out of the trademark laws of some of these developed countries and enact necessary provisions in the existing statutes.

After careful analysis of legal provisions, illustrations and case laws, the following recommendations and suggestions have been arrived at:

- In India there is not a single case of registration of sensory trademarks such as smell, taste, and touch since the ability of graphical representation is made mandatory as per trademark act 1999. For the development of non-visual non-conventional trademark in India, it should be dealt under the TRIPS agreement where graphical representation is not considered an impediment for registration of trademark if it can pass the test of distinctiveness.
- There should be an international uniform policy for the registration and protection of non-conventional trademark so that international brands do not face a difficulty to sell their products in different jurisdictions.

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