



THE FIVE SENSES AND NON TRADITIONAL TRADEMARKS

By *Sanya Kapoor & Riya Gupta*
From *Amity Law School, Delhi*

ABSTRACT

In this era with rampant globalization and cross border trade corresponding to international markets, the use of trademarks, to protect the company's identity has become a common phenomenon. It's a well known fact that a good trademark carries its own image, attaches distinct personality to the goods and becomes the essence of competition. In the modern trademark law, some novel innovations have been made including trademarks corresponding to the various sensory organs of a human such as sight, odour, sensory and touch. Further, diverse studies have concluded that various proprietors are coming forward for the registration of their non-conventional trademarks however on the contrary, due to the lack of legal backing, these trademarks remain unenforceable many a times across various jurisdictions and therefore provide a major hindrance to the world of commercial trade. Against this backdrop, this paper captures the registrability of various non-conventional trademarks brimming the commercial market and also brings forward the acceptance rate and scenario over various jurisdictions with specific focus on India. It also attempts to highlight and make some suggestions for better enforcement of these untraditional trademarks and better harmonization with the conventional trademarks and legal ideology of a state.

INTRODUCTION

A trade mark could be said to entail any word, symbol, name, device, packaging, shape of goods or combination of colours or any combination which is capable of lending the distinctiveness to the goods being produced and marketed under the mark so adopted. This is the scope of what are commonly known as 'Traditional Trade Marks' which are backed by the Indian legal provisions. The Trade Mark Act, 1991 defines "trade mark" 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...' ¹

However, in today's world, with the aggressive rate of rising competitiveness in the commercial and physical commodities markets around the world, the production and distribution corporations have to be creative and it has become imperative for them to stand out from their competitors in order to sustain a goodwill in the market. Further, registration of a trademark helps to instil consumer confidence and prevent confusion about the source of products sold under a trademark. Consumers rely on trademarks in most cases where it is difficult to inspect a product quickly and cheaply to determine its quality.² It is here that the use of non-traditional trademarks can come into play. Such production and distribution houses tend to invest largely in non-traditional trademarks like smell, sound or

¹Section 2(zb), The Trade Mark Act, 1991.

²Roth Melissa, Something old, something new, something borrowed, something blue: A new tradition in non-traditional mark registrations, *Cardozo Law Review*, 27 (2005) 457.



colour combinations, which are based on the different senses of a human, in order to distinguish their products from the established standards.

Non-traditional trademarks can be divided into two groups of visible signs (colours, moving images, etc.) and non-visible signs which relate to all five senses (sounds, smells scents, tastes and textures). Due to the dynamic interpretation with regards to the general, universal understanding of term 'Trade Mark', various non-traditional marks have become widely accepted, being reflected in many inclusive legislations and international treaties such as Agreement on Trade-Related Aspects of Intellectual Property Rights, 1995 (TRIPS).³ The TRIPS Agreement defines trademark on a functional basis and provides a list of marks that can be considered to be trade marks however, the list is non-exhaustive. Therefore, even the TRIPS Agreement cannot paint a clear picture as to the admissibility and registrability of non-conventional trademarks.⁴ It is only the Singapore Treaty on the Law of Trademarks, 2006 and the 2011 Regulations on this Treaty⁵ which has been the first piece of formal normative provisions expressly recognizing non-conventional trademarks. While including colour, sound and smell

marks, the Regulations have also recognized hologram marks, position marks, motion marks and 3D marks among others.⁶

Despite the repeated use of these non-conventional marks in the global market, it lacks a universal validation owing to the existence of territory wise registration. But at the same time one of the most imperative changes has been introduced by these modern trademark forms in the present trademark law along with the constant struggle for the law makers to guarantee a balance between development intellectual property laws and technological improvements and that they are at par with one another.⁷

This article attempts to highlight the registrability of non-conventional trademarks over various jurisdictions along with India and it also tries to highlight the nuances involved in this niche specification of the legal world. It aims to provide a background of the various technicalities involved in the registration and protection of the non-conventional trademarks which, though have been in the commercial world for quite some time, still remain in controversy and the subject of various debates.

REGISTRABILITY OF NON-CONVENTIONAL TRADEMARKS

Interestingly, non-conventional trademarks, which have found place in the commercial

³Hereinafter referred to as the TRIPS Agreement.

⁴Sankalp Malik, 'Property Rights Over Fragrances, Smells And Perfumes Protecting Your Aroma Creation Against Competitive Imitation & Registering Scents As Community Trade Marks', An Open Access Journal from The Law Brigade (Publishing) Group.

⁵Singapore Treaty on the Law of Trademarks, 2006 & Regulations under the Singapore Treaty on the Law of Trademarks, 2011 (Rule 3), available at http://www.wipo.int/wipolex/en/treaties/text.jsp?file_id=290013.

⁶International Trademark Association Bulletin, Vol. 61, No. 9, 1st May, 2006.

⁷Garry Trillet, Registrability of smell colour and sounds: how to overcome the challenges dressed by the requirements of graphical representation and distinctiveness within European Union Law.



world quite recently, associate with the five senses of a human. The Manual (Draft) of Trademarks Practice and Procedure of Indian Trademark Registry, 2015 states that colour, sound, shape of goods, packaging and smell trademarks fall under the category of unconventional trademarks.⁸ However, considering a global perspective, the below-mentioned fall under the categories of non-conventional trademarks:

1. The Sense of Sight:

i) Colour marks

Usually a combination of colours is easily registrable as a non-conventional trademark. The perfect example of which is when *Tiffany & Co* successfully registered the robin's egg colour "Tiffany blue" for its boxes and bags. However the real controversy arises when the registrability of a single colour mark is considered.⁹ It was held in *Dyson Ltd's Trade Mark Application*,¹⁰ that a single colour may be registrable as a trade mark if it is very unusual and peculiar in a trade and is recognized by traders and consumers alike that it serves as a badge of origin for that class of goods. According to the recent decisions of the court, it is the 'source-distinguishing ability' of a sign that permits it to serve as a trademark and not its ontological status

as colour, shape, fragrance, word or sign¹¹ and in reference to this *Christian Louboutin's* red colour used on the soles of Louboutin shoes was granted protection for its red colour trademark.¹²



TIFFANY & Co.



Further, the registrability of colour mark depends on how the colours are presented and what they are applied to¹³ and that a mere sample of colour particularly on a paper is unlikely to be sufficiently durable for the purposes of graphical

⁸S. 3.2.4 of Draft Manual, 2015 at 143, available at: http://www.ipindia.nic.in/tmr_new / TMR_Manual/TMR_DraftManual_11March2015.pdf (last visited on May 28, 2015).

⁹MMS Karki, Nontraditional Areas of Intellectual Property Protection: Colour, Sound, Taste, Smell, Shape, Slogan and Trade Dress, JIPR 10(6) 499-506 (2005).

¹⁰Dyson Ltd's Trade Mark Application 2003 RPC 47.

¹¹Qualitex Co. v. Jacobson Products Co. 514 U. S. 159 (1995).

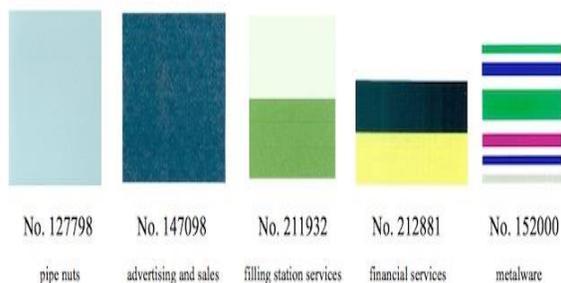
¹²Christian Louboutin v Van Haren Schoenen Case C-163/16.

¹³Neha Mishra, "Registration of Non-Traditional Trademarks" 13(1) Journal of Intellectual Property Rights 43 -50 (2008).



representation¹⁴ as it will have to be backed by strong evidence of factual distinctiveness. The Court further recognized the 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.¹⁵

Some examples of trademarks in the form of colors and their combinations that are already registered in Ukraine



Citing another example, in the case of *KWS Saat*¹⁶ an application for single colour orange trademark in respect of ‘seeds and treatment installations for seeds, consultancy services and agricultural, horticultural and forestry products’ was rejected on the ground of lack of distinctiveness. Adding on to that 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.’*¹⁷ This shows that distinctiveness is absolutely mandatory to get a colour registered as a trademark and thus various countries including Germany, Sweden, UK, Norway etc. recognize the registrability of single colour provided it is proven with acquired distinctiveness.

Considering the scenario in India, as per the draft manual for Trademark Practice and Procedure of Indian Trademark Registry, one of the means of registering a colour as a trademark is to use them as a livery, i.e., as a consistent colour scheme applied to a range of products of the same general kind so as to designate the trade source which has been used for buses, trains and vehicle service stations nowadays. Further, *in the case of Colgate Palmolive Company v Anchor Health and Beauty Care Pvt Ltd.*¹⁸ the court ruled that a colour combination was a ‘trademark’ under the act, as the act’s definition includes no exclusion and even a single colour is entitled to protection under the law of passing off. This is testimony to the fact that the Indian legislation has started recognizing the non-conventional trademarks and have provided them with legal sanctity.

ii) Moving Trademarks

¹⁴‘Libertal’ C-104/01[2003] E.C.R. I-379.

¹⁵Londe Anne Gilson La, “Cinnamon Burns, Marching Ducks And Cherry-Scented Racecar Exhausts: Protecting Non- Traditional Trademarks” Trademark Reporter, 95, 773 (2005).

¹⁶*KWS Saat AG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-447/02, 2004, ECJ.*

¹⁷Article 15(1)- The Agreement on the Trade-Related Aspects of Intellectual Property Rights, 1994.

¹⁸*Colgate Palmolive Company v Anchor Health and Beauty Care Pvt Ltd.*108 (2003) DLT 51, 2003 (27) PTC 478 Del.



Moving images in the form of a film clip, video, animation, logos etc. which can combine colours, sounds and aspects of product designs can also qualify for trademarks in some countries. Motion trademarks may also be known as animated marks, moving marks, or movement marks. They are the result of multimedia technology. They are used by the company as an innovative marketing strategy to attract consumer towards their product. Any motion mark is made by using animation and different computer programs and any moving object which exist around that company.¹⁹

The requirements of a motion trademark involve the detailed description of the various components or elements of the trademarks and their interaction with each other explained in a sequence of steps.²⁰ It also requires the use of a sequence of pictures or drawings to depict how the trademark functions. A portion of the sequence comprising the entire moving image, such as the first or last frame could be provided as long as the description of the mark clearly references the entire sequence.²¹ The description of the Columbia motion trademark²² is described as consisting of “A moving image of a flash of light from which rays of light are emitted against a background of sky and clouds. The scene then pans downward to a torch being held by

a female figure on a pedestal. The word “COLUMBIA” appears across the top running through the torch and then a circular rainbow appears in the sky encircling the figure.” Just like the US, the European Union has also allowed registration of motion trademarks. The arrangement and opening of the doors of a Lamborghini has a motion trademark²³ which has the description “The trademark refers to a typical and characteristic arrangement of the doors of a vehicle, for opening, the doors are “turned upwardly”, namely around a swivelling axis which is essentially arranged horizontal and transverse to the driving

direction”. Moving trademarks are, in fact, video fragments. The standard should be established that such trademarks must be accepted and reflected in the register in a certain video format. It would also be reasonable to consider the possibility of registering a combination of sound and moving marks (actually, it is a video with sound). Taking into account the pace of the development of 3D technologies, such trademarks may also constitute shape trademarks (a 3D video with sound). Meanwhile, it is necessary to set a uniform standard for the submission of such material. The respective video fragments should be available for review and analysis in the register.²⁴

¹⁹**Michal Ziolkowski**, Motion Trademarks As An Element Of Brand Promotion, <https://www.iplawwatch.com>.

²⁰ Susan Binsy, Recent developments in non-traditional trademarks, <http://www.manupatra.com> (21 November 2006).

²¹ **IPVigil, Non-Conventional Trademarks-India, June 26, 2015.**

²²USPTO TM 1975999.

Any motion mark should have the capability of depicting itself on paper while applying

²³CTM 1400092.

²⁴Lisa P. Lukose, Non-Traditional Trademarks: A Critique.



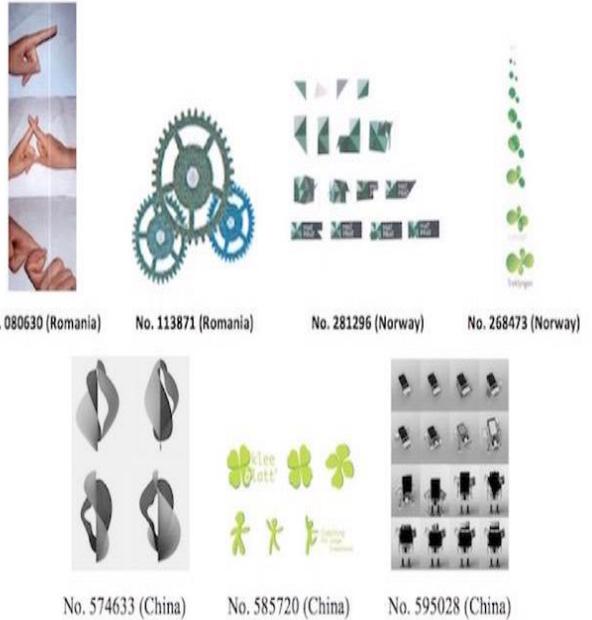
for registration in the intellectual property office of India. Submitting a motion mark involves the same criteria of evaluation as do other forms of trademarks, but motion marks have remained a small fraction of trademark submission in India. While submitting the registration of motion mark the company or individual has to keep in mind that any movement occurring in the mark should be represented in the sequence, it is being presented for the product.²⁵ The succession of images in the mark being registered as motion mark is the most critical aspects which may be subject to protection. Presentation of such marks is interpreted liberally by the registrar of the trademark.

Sony Ericsson submitted a flipbook depicting of up to 20 images which allowed the examiner of the trademark to flick through the pages and see the motion in the pictures. This application was initially rejected by the examiner but was then accepted on appeal.²⁶

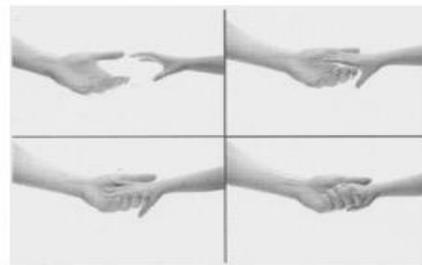
Until recently, trademark application of motion marks did not fulfil the condition of graphical representation, and hence, it was hard to register it as a trademark of the company. Even if the trademark is presented before the registrar graphically, this representation must be clear, precise, self-contained, easily accessible, intelligible, durable and objective. The definition of the trademark under the Indian Trademark Act is an inclusive one and covers within its

ambit anything that is capable of being graphically represented and distinguishing any product.

Some examples of registered moving trademarks in other countries



One of the most perfect illustrative examples of moving trademarks is the universally known handshake on the opening introduction in old Nokia cell phones. This is how this trademark was registered:



International Registration No. 820269

Dated November 14, 2003

²⁵ Archi, Registration of Motion Mark as Trademark, April 27, 2018.

²⁶Case R 443-2010/2 (Sept. 23, 2010).



Interestingly, the description of this mark directly states as follows: “The mark consists of an animation created by showing the pictures in a consecutive manner”.

iii) Shapes Trademarks

The UK Trade Marks Act, 1994 and the Indian Trade Marks Act, 1999 specifically included the shapes within the definition of trade mark. Shapes with significant functional features are unregistrable. The Indian Trade Marks Act 1999²⁷ like the UK Trademarks Act 1994²⁸ specifically provides that a mark shall not be registered as a trade mark if it consists exclusively of (a) the shape of goods which results from the nature of the goods themselves; or (b) the shape of goods which is necessary to obtain a technical result; or (c) the shape which gives substantial value to the goods.

Inherent distinctiveness of three-dimensional trademarks which includes the shapes of products has been outlined over the years by the ECJ and OHIM and Indian judiciary. In the US, the Lanham Act does not specifically define shape to be a trademark but modern practice has included shape and design of the product in the concept of ‘trade dress’.²⁹

Shape of the product can be a trademark if it has acquired distinctiveness and is not functional. In *Bongrain’s Trademark*

*Application:*³⁰ the court rejected an application for three-dimensional shape of a cheese in flower-like form since the mark was devoid of distinctive character. It also held that there is 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. Public’s perception of a sign is generally of paramount importance and the public generally does not make assumptions about the origin of a product from its shape. It is easier to register a mark if it is demonstrated that a shape mark has in fact acquired distinctiveness through use.

In *Coca-Cola Co. v. A.G. Barr & Co.*,³¹ the unique contour bottle, familiar to consumers everywhere, was granted registration as a trademark by the USPTO in 1977 as it was widely believed that most customers associate shape of the bottle with Coca-cola because of which it can be said that the shape is distinctive and has acquired secondary meaning.³²

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

²⁷The Trademarks Act 1999, Section 9 (3).

²⁸UK Trademarks Act 1994, Section 3(2).

²⁹Haggerty Thomas P, A blue note: The Sixth Circuit, production design and the confusion, Tulane Journal of Technology & Intellectual Property, 8 (2006) 219.

³⁰Bongrain SA v Trademark Registry, [2004] EWCA Civ. 1690.

³¹Coca-Cola Co. v. A.G. Barr & Co., 1961 RPC 387.

³²http://www.coca-colaindia.com/about_us/refreshing_facts. Asp (21 November 2007).



sign can be considered a shape mark, reference should be made to³³:

- 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. In the case of *Gibson Guitar Corp.*,³⁴ the Sixth Circuit stated that trademark and trade dress are two distinct legal concepts, and while the Lanham Act defines a trademark, trade dress is not explicitly defined in the Act. Citing the Supreme Court, the Sixth Circuit described trade dress as the ‘design or packaging of a product which has acquired a secondary meaning sufficient to identify the product with its manufacturer or source.’ An applicant seeking a trademark registration for product packaging must prove both that the trade dress is inherently distinctive and has attained secondary meaning and that it is not functional.³⁵

The Indian courts have recognised trademark rights in the shape of goods, provided that the shape can serve as a source identifier. In *Gorbatschow Wodka KG v John Distilleries Limited*³⁶ the Mumbai High Court prohibited the defendant from using a bottle shape that was identical or deceptively similar to that used by the plaintiff. The

court specifically stated that the shape of goods or their packaging is capable of trademark registration.

Similarly, in *Zippo Manufacturing Company v Anil Moolchandani*³⁷ the plaintiff sold lighters bearing the mark ZIPPO and held the rights to the mark relating to the 3D shape of its lighters. The defendant sold counterfeit Zippo lighters, imitating the plaintiff’s product. The court prohibited the defendant from selling lighters under the ZIPPO mark and with a 3D shape that was identical or similar to that of the plaintiff’s lighter.

Besides protection of trade dress has, in recent years received express recognition in a number of international treaties like TRIPS [Article 15(2)], Article 1708 of NAFTA, Articles 2 and 4 of the European Trademark Harmonization Directive and Article 6 of the Mercosur Protocol. The Indian Trademarks Act, 1999 also specifically recognizes trade dress.³⁸

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.

iv) Hologram Trademarks

Holograms have for long been used for security purposes on credit cards, concert tickets, certain currencies etc. The purpose of use is to prevent counterfeiting and

³³Guido 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>.

³⁴*Gibson Guitar Corp v Paul Reed Smith Guitars, LP*, 423 F 3d 539, 543 (6th Cir 2005).

³⁵Supra 15.

³⁶*Gorbatschow Wodka KG. v. John Distilleries Limited* (Notice of Motion No.3463/2010 in Suit No.3046/2010)

³⁷ *Zippo Manufacturing Company v Anil Moolchandani*, 2011 (48) PTC 39.

³⁸ Susan Binsy, Recent developments in non-traditional trademarks, <http://www.manupatra.com> (21 November 2006).



fraudulent replication, as replication of a hologram is considered more difficult. In recent times holograms have been increasingly used as trade marks in the marketplace.³⁹

Holographic trademarks have been registered by a few European countries and also in the US. The basic requirements for a trademark registration apply to a hologram too, i.e., the mark should be distinctive enough to be used by a business to uniquely identify itself and its products and services to consumers. The main difficulty arises in the method of graphically defining the mark in trademark registrations. Holograms by their very nature possess multiple images or colours that are visible only when viewed from different angles. The image may work electronically, but on paper, the published mark will only be a substitute of the mark itself; a figurative mark which needs graphical representation and adequate written description if it is to succeed. Applicants wishing to register their hologram as a mark should therefore seek to describe the hologram in as much detail as possible, providing visual views of the hologram in various frames with descriptions of angle and appearance.⁴⁰

Use of high-resolution frames avoiding fading or picture overlapping may be an

option, as descriptions of the visual effects alone might not be allowed⁴¹

In the United States, the trademark manual for examination requires under 1202.14 that a hologram used in varying forms does not function as a mark in the absence of evidence that consumers would perceive it as a trademark. In *re Upper Deck Co.*⁴², where the Board held that a hologram used on trading cards in varying shapes, sizes, and positions did not function as a mark, because the record showed that other companies used holograms on trading cards and other products as anti-counterfeiting devices, and there was no evidence that the public would perceive applicant's hologram as an indicator of source.



The VF – Video Future hologram trademark (CTM 2117034) registered by GDS Video.

³⁹Namita Sirsiya, How to Register Unconventional Trademarks?, <https://www.latestlaws.com> (June 26, 2018)

⁴⁰Non-Conventional Trademarks- Analysis Of The Indian Structure RLR Volume IV Issue I.

⁴¹Sieckmann, Ralf “Holograms: the next generation of trademarks?”, CPA’s IP Review, Winter 2005/06, Issue 13, page 26.

⁴²Re Upper Deck Co., 59 USPQ2d 1688 (TTAB 2001).



2. **The Sense of Smell:** Smell and Olfactory Marks: these type of marks are theoretically registrable as a trademark and it was recognized for the first time by the American courts wherein the application for registering the written description of the smell of ‘a high impact, fresh floral fragrance reminiscent of *Plumeria blossom s*’ for sewing thread and embroidery yarn was accepted as a graphical representation and granted trademark protection.⁴³

However when we consider the registrability of scent marks, various jurisdictions have held differing opinions. In *John Lewis of Hungerford Ltd's Trade Mark Application*⁴⁴ the trademark was graphically represented by the description that ‘the trade mark comprises of the smell, aroma or essence of cinnamon’ in respect of furniture. The application was refused on the ground of lack of precision as a result of the degree of subjectivity it allowed. Further, “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.⁴⁵ In 1994, the

globally well-known brand *Chanel* applied for the registration of their signature perfume fragrance product, ‘Chanel No. 5’ based on its fragrance. They attempted to represent their smell mark graphically by describing the perfume in their application as “*The scent of aldehydic-floral fragrance product*”⁴⁶ however; this application failed to proceed and was rejected because the perfume which was the smell mark which sought to be registered was also the end product in its finality. Further, the mark could not be considered indicative of the origin of the product.



⁴³In *Re Celia Clarke*, USPO 2d 1238 (1990) (TTAB).

⁴⁴ *John Lewis of Hungerford Ltd's Trade Mark Application*(2001) RPC 575.

⁴⁵ 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-smellof-ripe-strawberries-representing-non-visual-trademarks](http://www.iam-media.com/Magazine/Issue/29/Industry-insight/The-smellof-ripe-strawberries-representing-non-visual-trademarks) (last visited April 6, 2015) .

⁴⁶ *Chanel's Application*, 31.10.1994; cited from Nathan K G Lau, “Registration of Olfactory Marks as Trademarks: Insurmountable Problems?” 16 *Singapore Academy L. J.* 264, 265 (2004).



On the other hand, in Britain, the *Sumitomo Rubber Company* successfully registered “a floral fragrance/smell reminiscent of roses” as applied to tyres.⁴⁷ The world’s leading manufacturer of darts, *Unicorn Products*, obtained a trademark for “the strong smell of bitter beer on the flight” of their darts.⁴⁸

In the landmark case *Ralf Sieckmann v. Deutsches Patent und Markenamt*,⁴⁹ Mr. Sieckmann sought trademark protection in respect of his conglomeration of businesses. He represented the mark by denoting its chemical composition - $C_6H_5-CH = CHCOOCH_3$ and also submitted a sample, stating that the scent was usually described as “balsamically fruity with a slight hint of cinnamon”. The application was rejected at various levels and the ECJ decided that graphical representation per se is not enough for registration, and it must meet the

⁴⁷ Sumitomo Rubber Co. U.K. Reg. No. 2001416/filing date Oct. 31, 1994.

⁴⁸ Unicorn Products U.S. Reg. No. 2,596,156, strawberry; 2,568,512, grape; U.S. Reg. No. 2,463,044, cherry.

⁴⁹ *Ralf Sieckmann v. Deutsches Patent und Markenamt*, Case C-273/00, 12 December 2002, European Court of Justice.

following criteria:

- i. It must be complete, clear and precise, so that object of the right of exclusivity is immediately clear.
- ii. It must be intelligible to those persons having an interest in inspecting the register, i.e. other manufacturers and consumers.⁵⁰

In Indian context, the Registry has directly applied the Sieckmann test, stating that though smells are registrable, the fulfilment of the graphical representation criteria becomes difficult to post the Sieckmann holding.⁵¹ It is disappointing to note that the Registry has not suggested any alternative method of graphical representation in spite of stating that smells are registrable.⁵² Further, the Draft Manual states that, “Consumers of such fragranced goods are unlikely to attribute the origin of the products to a single trader based on the fragrance. Whatever may be the case, for purposes of registration as a trade mark, unless the mark is ‘graphically represented’ it will not be considered to constitute as a trade mark.”⁵³ The Manual puts it very bluntly that a smell mark can be registered in India only if it is able to be represented graphically, so that the primary purpose it being capable of differentiating one product

⁵⁰ Arka Majumdar, Subhojit Sadhu and Sunandan Majumdar, “The Requirement of Graphical Representability for Non-Conventional Trademarks”, *JIPR* 11 (5) 313-317 (2006).

⁵¹ Section 5.2.3, Draft Manual of 2015.

⁵² *Ralf Sieckmann v. Deutsches Patent und Markenamt*, Case C-273/00, 12 December 2002, European Court of Justice.

⁵³ Available at http://www.ipindia.nic.in/writereaddata/Portal/IPO/GuidelinesManuals/1_32_1_tmr-draftmanual.pdf, page 86.



from the other for the consumer can be achieved with ease.

3. The Sense of Sound:

Sound or Aural marks: some of the famous sound marks are the Tarzan yell, the Merrie Melodies theme song and the melody of 'Sweet Georgia Brown' to which we all can associate very well. Registrability of sound marks opened the Pandora box of doubts which was very well showcased by *Harley Davidson's* attempt to register 'the mark consisting of the exhaust sound of the applicant's motorcycles, which sparked a major controversy on the same. Now, the acceptability of a sound mark depends upon whether that sound has acquired a distinctive sign. It may consist of strings, notes, jingles, natural sounds, unnatural sounds produced by electronic equipments etc.⁵⁴ The World Intellectual Property Organisation (WIPO) Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) suggests, "[o]ffices may require that the representation of sound marks consist of a musical notation on a stave, a description of the sound constituting the mark, or an analog or digital recording of that sound. However, for some jurisdictions, only a musical notation on a stave may be considered to adequately represent the mark."⁵⁵

⁵⁴Nineteenth 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).

⁵⁵Report of the Standing Committee, on the law of Trademarks, Industrial Designs and Geographical Indications, WIPO SCT/16/9 2007.

Sound mark will qualify for acceptance only with evidence of factual distinctiveness including songs commonly used as chimes; well-known popular music in respect of entertainment services, children's nursery rhymes. Further, the sound marks shall be capable of graphical representation⁵⁶ by way of musical notation and/or description of the sound in words.⁵⁷ Onomatopoeic words, sonograms or spectrograms may also be accepted as graphical representations. On the other hand, if the applicant can prove that the sound, although non-descriptive, has acquired 'distinctiveness through use', the application may be considered. For instance, a toilet flushing sound for plumbing services, which has acquired distinctiveness through use, may be granted registration.⁵⁸

Considering the Indian context, India has been successful in protecting the sound marks considerably. Some examples could be, the sound of a human voice yodelling the words "Yahoo" was granted registration as a trademark in 2008,⁵⁹ Nokia registered the sound of the guitar tunes playing whenever one of their devices is switched on, National Stock Exchange trademarked its theme song

⁵⁶Shield Mark BV v. Joost Kist h.o.d.n. Memex, Case C-283/01.

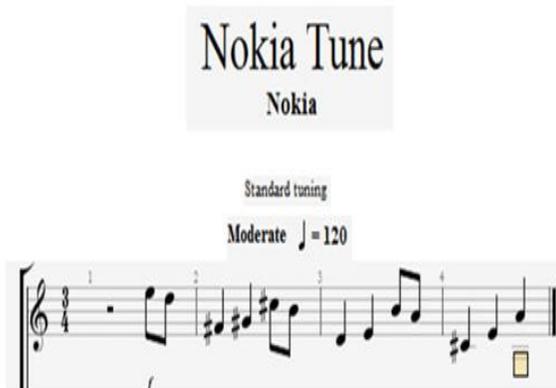
⁵⁷Martin Lindstorm, Brand Sense: Build Powerful Brands through Touch, Taste, Smell, Sight and Sound (Kogan Page Ltd., 2005).

⁵⁸Hui Huang, "Comparative Study of Law on Trademark Application and Opposition in China and other Countries", available at: <http://www.ipr2.org/storage/Huang-EN932.doc> (last visited on Feb. 18, 2015).

⁵⁹ Available at <http://www.livemint.com/Home-Page/5z2B1NQy3YyPkpRDp789M/Yahoo-awardedIndia8217s-first-sound-mark-Nokia-in-queue.html>.



and *ICICI* bank has trademarked their 'corporate jingle', well-known and used in their commercial advertisements prominently. Further, after the introduction of the new Trade Mark Rules, 2017,⁶⁰ the process of sound mark registration has been stream lined, with more emphasis on digitization. Earlier, to register a sound mark, the applicants had to file applications with graphical representation or by spelling out the tune which lacked practicality. However, now the new provision requires the sound to be submitted in MP3 format not exceeding 30 sec length and graphical representation of the sound notations with TM-A form.⁶¹



However, even after so many amends in law, two of the primary issues confronting the registration of sound as a trademark and

according such marks the statutory benefits of registration are:⁶²

- a. How to represent the mark to enable it to be clearly articulated, and to ensure that it can be readily interpreted and searched.
- b. The requirements of affixation, in particular with reference to wares, in terms of how the mark is to be connected with the wares. And it has become imperative to list down solutions for the aforementioned problems now.

4. The Sense of Touch:

Tactile or Haptic Marks: Haptic marks are basically associated with a distinctive touch like the velvety surface of a wine bottle or the feel of cotton and are protected as trademarks so as to indicate its origin. Rights over the tactile marks are generally claimed by the established use over a period of time. There is a dearth of recognized tactile marks and these are least common non-traditional trademarks. Hence, the legal authority is scarce.

However, owing to the below-mentioned examples it can be comprehended that this type of trademark has also been gaining popularity. Some examples include: in 1996, *Louis Vuitton Malletier* sought US trademark protection for its 'distinctive man-made textured pattern utilized as a surface feature' on its luxury luggage and leather products;⁶³ *Kimberly-Clark* has federal trademark registration for 'the configuration of the container used to dispense' facial tissue and the United States Patent and Trademark Office (USPTO) also

⁶⁰Rule 26, Trade Mark Rules, 2017.

⁶¹Intepat Team, Registering Sound Marks in India-Trade Mark Rules 2017, available at <http://www.mondaq.com/india/x/603306/Trade-mark/Registering+Sound+Marks+in+India+Trade+Mark+Rules+2017>.

⁶²T. Priyadarshini & Neetika Yadav, *Nokia's Triumph in 2007 - Registrability of Sound Marks and Areas of Concern*, Indian L.J. (2007).

⁶³Supra 24.



allowed Kimberly-Clark’s intent-to-use application for its raised, alternating dot pattern on paper towels; *Touchdown marketing* has a registered a trademark in the ‘pebble-grain texture’ and ‘soft-touch feel’ of its basketball-shaped cologne dispenser and Fresh Inc. has a registered mark on ‘cotton-textured paper’ that wraps its soap products; and in 2006 *American Wholesale Wine & Spirits, Inc.* successfully obtained U.S. Reg. No. 3,155,702, for “a sensory, touch mark” alone and used with its Khvanchkara wine.⁶⁴



And perhaps owing to these trademarks, in the year 2006, the International Trademark Association adopted ‘a resolution supporting the recognition and registration of touch marks’. This is an attempt to protect the tactile trademarks and get them registered as per the legal norms.

The Sense of Taste: Taste or Gustatory Trademarks: Taste trademarks are extremely unlikely to be held inherently distinctive in any jurisdiction without strong prove of acquired distinctiveness. Unlike sound and smell marks, taste marks can only be applied to goods and not services. WIPO SCT report states that the graphic representation requirement can be satisfied by using a written description of the taste and an indication that it concerns a taste mark. However, it has to pass the non-functionality test.⁶⁵ The US

⁶⁴Christina S. Monteiro - A Nontraditional Per-Spectrum: The Touch of Trademarks, June 15, 2010 Vol. 65 No. 11.

⁶⁵Standing Committee On The Law Of Trademarks, Industrial Designs And Geographical Indications, 2006.



appeal board decision in *In Re N.V. Organort*⁶⁶ highlights this aspect. The trademark application for ‘an orange flavor’ for pharmaceuticals for human use, namely, antidepressants in quick-dissolving tablets and pills was denied registration being not capable of trade mark protection. It was also held that the applicant’s taste would not function as a trademark since there are numerous other orange flavored medicines. The appeals board also noted that flavor is a characteristic of the goods and not their origin. As the trademark trials and appeals court pointed out, it is difficult to define how taste can act as a trademark when consumers only taste goods after purchase. Registration of a flavor mark will require a substantial showing of acquired distinctiveness.

OHIM boards of appeal rejected an application by Eli Lilly⁶⁷ for “the taste of artificial strawberry flavour” as gustatory trademark for pharmaceutical preparations by stating that “it is in any event clear that such a taste cannot distinguish the pharmaceutical preparations of one undertaking from those of another.” The court added: “Moreover, the taste is unlikely to be perceived by consumers as a trade mark; they are far more likely to assume that it is intended to disguise the unpleasant taste of the product.” In this case, the

Court implicitly recognized that taste marks could be registered as trademarks. The Board also debated on the issue of how taste marks could be represented without reaching a specific conclusion. However, it can be safely assumed that graphical representation for taste marks will be required to meet the standards set for sound and smell marks, in which case it might be difficult to get recognition for taste marks in most cases.

One substantial impediment to enforcement of flavour marks is functionality because they need to be available to all competitors. Examples would include mint toothpaste for adults and bubble gum toothpaste for kids. Flavours may also be found to be generic because they are used frequently by different manufacturers. Only an unusual flavour like melon or caramel or peanut butter added to a toothbrush or dental floss would be more likely to be protected than the same for cookies or bread.⁶⁸

INDIAN SCENARIO

The trademark law in India has developed a lot since the last decade. To meet its obligation under the **Paris Convention for Protection of Industrial Property and the TRIPS Agreement, the Trademarks Act, 1999** was enacted. After the enactment of the Act, a lot of further development was made, for instance, electronic filing of a trademark application.⁶⁹

⁶⁶Re N.V. Organort, 79 U.S.P.Q. 2d (BNA) 16.39 (TTAB 2006).

⁶⁷Eli Lilly and Co. v INPI, Court of Appeal of Paris, 4th Chamber, October 3, 2003, Recueil Dalloz, Vol. 184 (2004), No. 33, p 2433.

⁶⁸Supra 15.

⁶⁹ [https://economictimes.indiatimes.com/small-biz/legal/recent-developments-in-intellectual-](https://economictimes.indiatimes.com/small-biz/legal/recent-developments-in-intellectual)



In India, Section 2 (1) (m) of the Trade Marks Act of 1999 defines a “ mark” as “ includes a device, brand, heading, signature, word, letterlabel, ticket, name, numeral, shape of goods, packaging or combination of colors or any combination thereof.” This definition seems to be influenced by the United Kingdom⁷⁰. Therefore, the list is not construed to be exhaustive, and the Draft Manual provided by the Controller General of Patents Designs and Trade Marks (CGPDTM) indicates that marks which are not visually perceived will be given special consideration on a case-by-case basis⁷¹.

The draft manual of trademark published by Trademark Registry explains in 4.2.4 Acceptable forms of graphical representation. “*In the Registrar’s view a mark is graphically represented when:*

- a) *the representation of a trade mark is in paper form*
- b) *it is possible to determine from the graphical representation precisely what the mark is that the applicant uses or proposes to use without the need for supporting samples etc;*
- c) *the graphical representation can stand in place of the mark used or proposed to be used by the applicant*

property-laws-in-india-part-2/articleshow/47780087.cms.

⁷⁰GANGJEE, Dev. Non-Conventional Trade Marks in India. National Law School of India Review, Vol. 22, No. 1, pp. 67–96 (2010) p.2.

⁷¹Ch II, Section 3.1, Draft Manual, 2015.

because it represents the mark and no other;

d) it is reasonably practicable for persons inspecting the register, or reading the Trade Marks Journal, to understand from the graphical representation what the trade mark is.

Hence, in nutshell, the mark is eligible of protection under the Act if it is capable of being represented graphically on paper in a meaningful way. Non-conventional visible marks can be easily graphically represented on paper hence those can be registerable under Indian Trademark Act.

With respect to shape of goods the Act categorically provides protection since it can be easily graphically represented. Shape requirements for graphic representation can be met by providing a pictorial representation in conjunction with a written description. The pictorial representation will need to clearly show all features of the mark.

With respect to Colour mark, the Act allows only “combination of colours” hence protection to single colour as a trademark is not categorically allowed for registration under the Current Act. Although, the draft Trademark Manual the Trademark Registry accepts principle laid down – “*A single colour may be registerable as a trade mark if it is very unusual and peculiar in a trade and is recognized by traders and consumers alike that it serves as a badge of origin for that class of goods.*”⁷² However, with respect

⁷²Supra 10.



to other types of non-conventional trademark such as smell, taste, sound are traditionally difficult to “*Graphically represent*” to meet the trademark Act requirement.

With respect to the sound mark, the Draft trademark manual explains sound mark as – “*Act does not explicitly exclude “sound marks” from registration nor does it say that a trade mark must be visually perceptible. It only provides that the trade mark must be “capable of being represented graphically” besides capable of distinguishing.* The Draft Manual applies, although indirectly, the Sieckmann standards with regard to the requirement of graphical representation.⁷³ Although the Manual indicates that the description requirement is met by musical notation in case of a mark consisting of musical elements, there is no indication as to the sound marks consisting of non-musical elements.

When India granted registration for sound trademarks, India simply borrowed the Shield Mark doctrine which was given in the case of *Shield Mark BV v Joost Kist*⁷⁴, by the ECJ in which it opined that if the sound was distinctive and people were able to recognize it, there was no reason why such sound couldn't be registered as a trademark.

As indicated above, the definition of trade mark makes it clear that in order to constitute a trade mark it should be “represented graphically” [section 2(1)(zb)] An application which does not meet this requirements will face an objection under

⁷³Ch II, Section 5.2.2 Draft Manual, 2015.

⁷⁴*Supra* 46.

this section and in the case of “smell mark” the greatest handicap will be the inability of traders to meet the requirements for graphical representation.

SUGGESTIONS AND CONCLUSIONS

Essentially there exists no difference between “non-conventional” and a “conventional” trademarks and there is no justification in wrangling about whether the former express an unreasonable restriction of free intellectual property resources or not. Non-conventional marks are strikingly unsteady of origin and are seldom used without additional words or figurative marks to support them. Since the trademark law is of an international spirit, it is apparent that the same is versatile in nature and the local laws have to keep on reforming themselves quite often in order to adjust with the changes and to be able to resolve the technical encumbrances it may have to come across regularly.

There is a plausible sense that Indian trademark law has effectively caught up with contemporary marketing techniques. What one does not see is the ambiguity and anti-competitive issues that such subject matter forms. The draft manual deciphers several of these issues and presents an entire structure within which to allow steady evolution of principles in this arena. Considering, India is an acutely active member in the world intellectual property field, it ought to be able to amend its laws and defend the businesses of numerous makers and also the goodwill of the consumers.

The TRIPs Agreement as well as the US trademark regimedo not make ability of graphical representation as a pre-requisite for trademark. The Indian Trademark



Regime resembles the stand of European Union as far as condition of graphical representation for a trademark is concerned. The non-conventional trademarks retain capability of source identifier despite not comfortably graphically representable. Thus, we can conclusively state that the Indian Trademark Act 1999 has put an unessential hindrance of capability of graphical representation as a condition for the registration of a trademark. In the developing globalized world, the use of colour, sound, scent, motion or holograms as a trademark is bound to grow in the near future. Thus, we should expand our trademark regime by diffusing the requirement of graphical representation for the non-conventional trademarks.

