



## INDIAN PERSPECTIVE ON UNCONVENTIONAL TRADEMARKS

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### ABSTRACT:

When we discuss a brand, a name, a logo or a symbol which graphically represents a particular product, we identify a trademark in it. The main concern for the customers when they purchase the products or hire the services from the market are the quality and goodwill of the products and services. Trademark helps the consumer in differentiating the product and services from that of the others. Recently, Intellectual property rights have gone through various advancements among which, specifically, trademark has evolved rapidly. The Trade Related aspects of Intellectual Property Rights (TRIPS) is an international agreement on Intellectual property which perceives the various kinds of trademarks including the non-traditional ones. India being a member nation of the World Trade Organization (WTO) has become a signatory to the TRIPS agreement, and hence it has made few improvements in its legal provisions relating to Intellectual Property Rights (IPR) in order to conform to the TRIPS agreement. Trademark can be classified in contemporary trends as conventional and non-conventional trademarks. Trademarks which can be visually and graphically represented and identified are conventional trademarks, like name, signature, logo, color combinations, symbols etc. Non-Conventional trademarks includes smell mark, sound mark, taste mark, touch mark, motion mark and hologram mark. Granting of trademark protection to these non-conventional marks is slowly gaining recognition in several countries. But under Indian Trademark Regime, non-convention trademark registration is difficult because of the pre-requisite condition on the graphical representation of the trademark which is followed strictly.<sup>3</sup> This article discusses about the issues and the need for protection for such non-conventional marks in the recent era.

**KEY WORDS:** Trademark, TRIPS, WTO, Intellectual Property Rights, Conventional trademarks, Non-conventional trademarks, Graphical representation

### 1. INTRODUCTION:

A trademark is defined under the Indian Trademark Act as a mark which is capable of graphically representing and differentiating the products or services of one person from that of the other and it can be in the form of a word, letter, signature, logo, numerals, headings, phrase, symbol, design, shape of the products, their packaging and combination of colors.<sup>4</sup> From the definition, it is very clear that the two main requisites should be present in the mark for it to be registered and granted protection under trademark regime in India. One of the requisites is the graphical representation of the mark and the other important requisite is the distinctiveness of the mark which helps the consumers in distinguishing the product/ service of one from that of the other. Traditional/ conventional trademarks follow these two requisites strictly for its registration and protection under the Indian Trademark Law.

Recently non-conventional trademarks have emerged as the focus light dealing with contemporary issues of the trademark regime. It is more of a practical application when we discuss about the graphical representation of a non-conventional trademark. The question whether non-

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<sup>3</sup> Tanisha Agarwal & Vanshaj Mehta, "Hear Me, Touch Me, Taste Me, Smell Me: Conventionalizing Non-Conventional Trade Marks in India", Journal on Contemporary Issues of Law, Volume 3 Issue 5, ISSN 2455-4782.

<https://jcil.lsyndicate.com/wp-content/uploads/2017/06/TanishaVanshaj.pdf>- Last visited on 21/07/2021.

<sup>4</sup> Sec 2(m) & Sec 2(zb) of The Indian Trade Marks Act, 1999

'Sec 2(m) "mark" includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination thereof'.

'Sec. 2(zb) "trade mark" means a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others and may include shape of goods, their packaging and combination of colours'.

conventional trademarks like smell, sound, taste are distinct and whether they can be distinguished from one and another is still a grey area. There are some countries that have adopted new regulations and framed laws for the protection of non-conventional trademarks.

On the other hand, India has adopted a stringent process for registering a non-conventional trademark. The trademark law requires graphical representation of the mark which helps in distinguishing the product from that of the other. The non-conventional trademarks like smell mark, taste mark, sound mark etc., do not have such graphical or visual representation.

But there has been framework for the establishment of rules and regimes for the purpose of handling the contemporary issues relating to non-conventional trademarks. According to 'Rule 26(5) of the Trade Mark Rules which provides that when the application has been made for a Sound Trademark, it shall be reproduced in MP3 format not exceeding the length of 30 seconds, recorded on a medium that allows for easy and clearly audible replaying quality along with a graphical representation of its notation'.<sup>5</sup> In the case of a sound mark, the representation of a specific musical note must be submitted at the particular place which is provided for the registration of the trademark. The requirement for registering such sound mark is to prove factual distinctiveness of the sound, which means that the public at large can recognize the sound with that particular product or service. 'The MGM's Lion Roar' is an example of a sound mark. Likewise, the Yahoo Inc., was granted sound mark in India in the year 2008. The sound comprised of a human male voice making a song like cry of the brand name yahoo.

The different types of non-conventional trademarks are as follows:

### 1.1 SMELL MARK:

Smell is one of the five senses of a human being, for which the companies and businesses have started showing keen interest in introducing products with pleasant smell to attract consumers. One of the criteria to obtain registration of a trade mark is to graphically represent the mark but the main issue is the question on how smell can be graphically represented? Noting down the chemical formula of the smell will signify the substance used to produce that particular smell rather than the smell. The smell should be distinct and it cannot per se be qualified to be registered as a trademark, without the required reference with the product. In addition, to register the smell mark, the smell should not be a naturally derived scent originating from the product and be a mere result of the properties of the product.<sup>6</sup> Example: A Dutch company registered the scent of freshly mown grass for its tennis ball.<sup>7</sup>

### 1.2 TASTE MARK:

Some Jurisdictions have started accepting taste marks for trademark registration.<sup>8</sup> The important criterion for registering a trademark according to the legal regime is to prove that the product/ service is distinct and not misleading, generic, descriptive or similar to another trademark. If the mark of the particular product or service passes the test of distinctiveness and if it can be graphically represented, it becomes eligible for trademark registration and protection. But the question is how to graphically represent taste mark and can taste be described in words? Another important lacuna is whether taste marks if granted protection under trademark law, will it conflict with the functionality doctrine? For instance, the taste of a mango in a mango juice cannot be granted taste protection under trademark law as it does the same function which is inherent to it, i.e., the flavor of mango. So, a product which is there for human consumption is disqualified for protection of trademark under taste category by applying the functionality doctrine.

### 1.3 SOUND MARK:

One of the non-conventional trademarks is a sound mark. Sound mark helps in identifying the product or services by carrying a musical note like the ringtone of Nokia mobile or a sound note like the 'yahoo yodel'. Under trademark law, graphical representation of the mark is required and it is possible to show a graphical representation for the sound mark by writing down the musical notes. The registration of such sound mark however requires a distinctiveness and to prove that the average consumers will relate the product or service to such sound mark. For instance- In India, the corporate jingle 'Dhin Chik Dhin Chik' of ICICI Bank is a sound mark which is protected under trademark law.<sup>9</sup>

### 1.4 MOTION MARK:

A motion mark comprises of a moving logo, a symbol, a video, a name etc., which is used by the company or a person who owns the product or service as an initiative to gain consumer attention towards their products and services. Computer programs and animation software helps in

<sup>5</sup> Rule 26(5) of the Trade Mark Rules, 2017.

<sup>6</sup> Potentiality of 'Smell' as a Trademark and its limitations.

<https://iprindia.org/potentiality-of-smell-as-a-trademark-and-its-limitations/> -Last visited on 21/07/2021

<sup>7</sup> Making a mark, WIPO

[https://www.wipo.int/edocs/mdocs/sme/en/wipo\\_smes\\_waw\\_10/wipo\\_smes\\_waw\\_10\\_ref\\_theme\\_03\\_01.pdf](https://www.wipo.int/edocs/mdocs/sme/en/wipo_smes_waw_10/wipo_smes_waw_10_ref_theme_03_01.pdf) - Last visited on 21/07/2021

<sup>8</sup> For example, in the Benelux Office the following mark has been registered (DE SMAAK VON DROP BX No. 625971). "The trademark consists of the taste of liquorice applied to goods in class 16 (taste mark)". See RØNNING, op. cit., "Taste marks".

<sup>9</sup> Dheeraj Kapoor, 'India: Sound Marks: A New Perspective' - <https://www.mondaq.com/india/trademark/598438/sound-marks-a-new-perspective> - Last visited on 27/7/2021

creating a motion mark.<sup>10</sup> Motion marks are registered in few countries. For instance, the trademarks of Motion Pictures, 20th Century Fox Movies, Columbia Pictures are widely known motion marks registered in USA,<sup>11</sup> where the phrase '20th Century Fox' appears in three lines in golden color while the music plays in the background and the camera moves from left top to right bottom while the phrase is brought in the middle of the screen as shown in the Ice Age animation movie and Deadpool movie. The Trademark Act in India does not define a motion mark. Graphical representation of motion mark is also difficult since the appropriate representation of motion mark will include the movement of the particular word, logo, symbol etc., of the mark along with the sound which is hard to represent in written form. Motion mark in India per se cannot be presented for registration, but it has to be presented as a combination of marks to the registrar for registration.<sup>12</sup> Due to strict scrutiny for the registration of motion mark, the registration of the same under trademark law is quite rare in India.

### 1.5 TOUCH MARK:

Touch is one of the senses of a human being. The feel of the texture of a product can be used as a business strategy to gain consumers. Touch mark is one such non-conventional marks and for its registration under Trademark law, it is required that such touch mark needs to be distinctive to the average consumers and should be capable of graphical representation. Touch mark is also known as 'texture mark'. The touch mark should not just be a product/ service decoration or packaging rather it should possess the requirement of a standard trade mark. The touch mark should not attribute to the functionality of the product. It should be capable of graphical representation and should make the consumer associate the mark with the product/ service. In many countries including India, claim for protection under trademark law for touch mark is rare when compared to other non-conventional marks since it is very difficult to graphically represent the feel of the product texture. No such touch marks have been claimed for registration before the Controller General of Patents Designs and Trademarks, Ministry of Commerce and Industry, Government of India since touch mark is considered as the least sought mark for registration due to the complexity of the graphical representation.

### 1.6 HOLOGRAM MARK:

Another such non-conventional trademark is the 'Hologram mark', where the hologram is used for identifying the origin of the products or services. Hologram mark will possess multiple colors that can be viewed in different angles.<sup>13</sup> Duplication and false replica are prevented by such hologram marks. For registration of such mark under trademark law, the mark should be graphically represented depicting all the material features including the images seen in different angles which is quite difficult since the hologram viewed in different angles will show varying colors. The application for registration should contain a written specification describing the varying images of the hologram when it is viewed from different angles which is difficult to express in written form.<sup>14</sup>

## 2. ISSUES & CHALLENGES

From the above-mentioned analysis, it is obvious that certain criterion needs to be satisfied in order to register an unconventional trademark.

The mark should be distinctive and able to differentiate the product/ service from that of other. Graphical representation of the mark is required for its registration.

The article discusses the issues relating to the registration of unconventional trademark since graphical representation of such trademark like taste mark, touch mark, motion mark, hologram mark & smell mark is not possible. The Indian Trademark Law does not have any specific provisions relating to unconventional trademarks except for sound marks which is mentioned under Rule 26(5) of the Trade Mark Rules. The Indian Trademark Law does not define unconventional marks, neither does the act mention any procedures for their registration. So, there is lack of provisions with respect to such unconventional marks which needs to be addressed. Graphical representation being a prerequisite condition for registration of trademark is proving to be a challenge for the registration of unconventional trademarks in India.

## 3. SUGGESTIONS & CONCLUSION:

Since there is lack of provisions with respect to unconventional trademark, reliance should be placed on the definition of trademark which covers the term mark in its ambit. The Trademark Act defines "mark" as a 'device, brand, heading, label, ticket, name, signature, word,

<sup>10</sup> Archi, 'Registration of Motion Mark as Trademark' - <https://blog.iplleaders.in/motion-mark-as-trademark/> - Last visited on 27/7/2021

<sup>11</sup> Agarwal Tanisha & Mehta Vanshaj, "Hear Me, Touch Me, Taste Me, Smell Me: Conventionalizing Non-Conventional Trade Marks in India", Journal on Contemporary Issues of Law, Volume 3 Issue 5, ISSN 2455-4782.

<https://jcil.lsyndicate.com/wp-content/uploads/2017/06/TanishaVanshaj.pdf> - Last visited on 27/07/2021.

<sup>12</sup> Choudhary Hardik, 'Are Motion Trade Marks Protected?' - <https://www.algindia.com/article-is-a-motion-mark-protected-in-india/> - Last visited on 27/7/2021.

<sup>13</sup> Supra 9

<sup>14</sup> Movement marks and holograms-

[https://www.ipd.gov.hk/eng/intellectual\\_property/trademarks/registry/Movement\\_marks\\_and\\_holograms.pdf](https://www.ipd.gov.hk/eng/intellectual_property/trademarks/registry/Movement_marks_and_holograms.pdf) - Last visited on 30-07-2021

letter, numeral, shape of goods, packaging or combination of colors or any combination thereof<sup>15</sup>. The Indian Trademark regime should be amended so as to include in its ambit unconventional trademarks which are emerging in the contemporary trends. Under Sec 2(m) of the Trademarks Act, unconventional marks should be included along with other conventional marks. The non-conventional trademarks are distinct and acts as a source identifier, despite the graphical representation of such mark being difficult to demonstrate. The TRIPS Agreement does not state that the graphical representation of the trademark as a mandatory criterion for registration. Similarly, the United States trademark regime does not make the graphical representation as an essential requisite for the trademark registration which is also an important reason for the emergence of unconventional trademark registration in U.S.A.

Therefore, one important change that needs to be brought in the Indian trademark regime is to liberalize the requirement of graphical representation when it comes to registration of unconventional marks. The important factor that should be considered for the registration of such unconventional marks is to check if they are distinct and capable of distinguishing the products or services from that of the other. So, if an unconventional mark has acquired a distinctive and unique character that helps the consumers at large in identifying and associating the goods or services with its source, then such unconventional mark should be eligible for registration and the requirement of graphical representation should be relaxed.

Thus, it is widely observed and felt that the graphical representation criterion alone acts as the hindrance in implementing the unconventional trade mark registration in the Indian trade mark regime. It is high time that these amendments and relaxations to the Indian trade mark laws are made so that India is placed on par with the dynamic IP regimes followed by the developed nations around the globe.



<sup>15</sup> Sec 2(m) of The Trade Marks Act, 1999