

Issues and Challenges Relating To Non-Conventional Trademarks

Dr. Reetika

Assistant Professor, C.R. Institute of Law, Rohtak, Haryana

INTRODUCTION

With every passing day the domain of trademark protection law is expanding all over the world. The security of trademark has become imperative in present day competitive world because, every producer of a good or service will want his mark to be unique, eye catching as well as it should be easily distinguishable from others. To be more precise, this paper deals with the expanding boundaries of scope of trademarks. Unlike the case in US and EU, very few nonconventional marks have received registration in India. Trade and Merchandise Marks Act, 1958 does not deal with the nonconventional trademarks such as smells, sound and tastes, colour combinations per se, three-dimensional marks, were incapable of being registered. But the Trade Marks Act of 1999 and the Trade Marks Rules of 2002 deals with the non-conventional trademarks.¹ The Trademarks Registry has released a draft Trademarks Manual outlining the practices and procedures for trademark proprietors. The Draft Manual for Trademark Practice & Procedure is a significant document which provides guidelines to the trade mark examiners, traders and the general public, for attaining consistency and accuracy in practice.²

Key Words: trademark, conventional trademark, non-conventional trademark

TYPES OF TRADEMARKS

There are two types of trademarks, which are as follows:

1. Conventional trademarks
2. Non-conventional Marks

Conventional Trademarks

It includes pre-existing traditional category of trademarks like letters, words, logos, numerals, pictures, and symbols those consisting of letters, numerals, words, logos, pictures, symbols, or combinations of one or more of these elements.

Non-Conventional Trademarks

It is relatively new concept in the Intellectual Property law. Marks which do not come under the traditional categories of trademarks are called as non-conventional trademark. So, Non-conventional trademarks consist of marks originating from shapes, sounds, smells, tastes and textures.

In India, according to the views of Judiciary and the Draft Manual, the non-conventional marks are ordinarily common in beginning but these have to acquire distinctiveness for protection. Distinctiveness of a non-traditional mark is generally satisfied through the doctrine of acquired distinctiveness or secondary meaning. The Draft Manual provides that the non-conventional sign must be capable of distinguishing the goods or services of one person from those of others before it is elevated to the status of trade mark. Thus, the basic element i.e. distinctiveness must be present before registration of non-traditional marks. Non-conventional marks in India are:

¹ See, Taj Kunwar Paul et al., Reincarnation of Trade Mark Law in India, 86 J. Patent And Trade Mark Office Society 237, 240 (2004).

²http://ipindia.nic.in/tmr_new/TMR_Manual/DraftManual_TMR_23January2009.pdf.

1. Colour trademarks
2. Sound trademarks
3. Smell Trademarks
4. Shape of goods
5. Holograms

The registration of non-conventional marks is further helped by the decision of the U.S. Supreme Court in *Qualitex Co v. Jacobson Products Co.*³, wherein it held that a trademark can be “almost anything at all that is capable of carrying meaning.”

Colour Marks

By tradition, colour combined with words, designs, symbols, logos and other such distinguishable signs have been eligible for a trademark. But, the problem is whether a colour by itself is entitled to get protection as a trademark or not. Due to the limited number of colours, there is distress for two things i.e. by allowing registrations of colours per se (i.e. single colour), ultimately the available stock of colours will become depleted or exhausted because there is limited number of colors in the world and thus anti-competitive.

Second, there was concern that if single color alone was protectable, then courts would be overflowing with numerous and lengthy trademark infringement suits and in turn the process of trademark registration would be slow down.⁴ As a result, there are strict requirements for registering single colour marks.

In United States

In U.S, the Supreme Court restricted the admissibility of color trademarks to only those color marks that have attained a "secondary meaning" and are associated with and assist in recognising and distinguishing a particular brand and thus indicate its source.⁵ In addition, if a color is functional in nature than it cannot be registered as a trademark.

In European Union

In case of colour marks, the European Court held that graphic representation must be ‘clear, precise, self-possessioned, independent, easily approachable or accessible, intelligible, durable, and objective.’ A sample of colour alone cannot pass the test of graphical representation because there is a fear of losing original shade with the passage of time. But, to use an internationally recognised identification code for designation of colour may be considered to constitute a sensible graphic representation because such codes are believed to be specific, perfect and stable. For example, the colour purple for Cadbury’s Dairy Milk

In India

Most applications are filed for words, designs, symbols, logos and other such distinguishable signs along with particular colours, to add distinctiveness to a mark. But the problem here is about the register ability of single color alone as a trademark because the Trade Marks Act does not explicitly provides for the registration of a single colour alone, although it does not expressly exclude this concept. However, in practice, instead of a single color, a combination of colours stands in a better chance of registration, provided that it is capable of distinguishing the goods of one trader from those of others. In India, colour marks continue to be accepted only as a device marks for registration. For example, the Standard Chartered Bank obtained registration for its corporate, colour combination of green and blue, but this is registered as a device mark, not as a colour mark.⁶

According to the draft Trademarks Manual guidelines, a single colour can be registered only in exceptional circumstances if the colour is capable of indicating the origin of a product or service and has acquired a high level of distinctiveness. The Draft Manual put emphasis on the careful examination of single colour marks during registration, because of fear of depletion of available stock of colours and there is also a public interest in not limiting the availability of colours for other traders.

³ 514 US 159 (1995).

⁴ Praveen Pani and AnantPuranik, “Non-Conventional Trademarks”
<http://www.ipproinc.com/admin/files/upload/8ce71cd2d0e3086fd66415325f958236.pdf>

⁵ Ibid.

⁶ RanjanNarula Associates, “India’s approach to non-conventional trademarks” “World Trademark Review” August/September 2011, p.108.
www.WorldTrademarkReview.com.

In *Colgate Palmolive Company v Anchor Health and Beauty Care Pvt. Ltd*⁷ the court observed that a colour combination is a 'trademark' within the definition of the Trade Marks Act, 1999 as there is no exclusion of colors as a trademark in the definition and even a single colour is entitled to protection under the law of passing off.

Deviating from the observation expressed in *Colgate Palmolive company case*, in *Cipla v MK Pharma*⁸ the court held that a single colour or a colour combination cannot be a trademark so incapable of protection under the common law of passing off. Due to these inconsistent views, confusion creates which surrounds the principles of protection that are applicable to colour marks. It is expected that in future things will turn out to be settled as the courts examine more cases.

Sound Marks

Now days sound is also used as a trademark. Sound used as a trademark where it performs the trademark function of uniquely identifying the commercial origin of products or services. Sounds are capable of satisfying the trademark criteria, they can serve to identify the source or trade origin of a product or service. Some examples of Sound Marks are: four-note bell sound of Britannia Industries, default ring-tone of a Nokia mobile phone, Yahoo's yodel (songlike cry in which the voice fluctuates rapidly between the normal voice and falsetto), sound of the lion's roar at the beginning of an MGM-produced film Corporation, thunderous sound of Harley-Davidson etc.

In the European Union

In the European Union, for registration as trademark, sounds have to follow all traditional trademark laws. Sound must be represented graphically in a way that is clear, precise, self-contained, equally accessible, intelligible, durable and objective. It means that musical notes that can be represented in the form of musical notations are acceptable whereas noises like a dog barking or a lion roaring which cannot be represented by a musical notation but has to be described onomatopoeically (imitation of a natural sound) or through a sonogram cannot be eligible for a trademark in the European Union.

Metro Goldwyn Mayer (MGM) Corporation had applied for the registration of a sound that was of a Lion's roaring. Corporation submitted a sonogram for the "Lion's roar". But the application was rejected in the European Union. But it was surprising that the same trademark was allowed in the US. Here, the views of both US and EU were poles apart. In the United States, whether a sound can serve as a trade mark depends on the aural perception of the listener which may be as fleeting as the sound itself instead of graphical representation of sound.

In United States

In the United States, whether a sound can serve as a trade mark "depends on the aural perception of the listener which may be as fleeting as the sound itself unless, of course, the sound is so inherently different or distinctive that it attaches to the subliminal mind of the listener to be awakened when heard and to be associated with the source or event with which it struck."

In India

According to the Draft Manual, while considering a sound mark it is the basic requirement that the sound must be capable of indicating the origin of goods, i.e. the average consumer will recognise the sound in the sense that the goods or services are exclusively associated with one undertaking. So, prima facie, no sound marks will qualify for acceptance until there is evidence of factual distinctiveness.

For the time being, India is one of the few Asian countries who have opened its doors to the statutory protection of sound marks. India's first sound mark registration for Yahoo's three-note yodel was granted by Trademarks Registry in 2008. Indian entity ICICI bank has also filed an application for a sound mark which is a constructive development in the area of trademark law. It is the first Indian entity who got success in securing registration for its corporate jingle by registering the very notes that form the jingle.

But the basic requirement is that these sounds must be capable of graphical representation. A musical notation can be accepted as effective graphical description of a sound mark. The source of sound from where it emanates, i.e. musical instrument, should also be mentioned. In case of onomatopoeic words (words formed in imitation of a natural sound),

⁷Madras H.C. (C.S.451, 2008).

⁸MIPR 2007 (3) 170, 2008 (36) PTC 166 Del.

sonograms or spectrograms (an image of a structure that is produced by reflections of high-frequency sound waves), may also be accepted as graphical representations.⁹

Smell Trademarks

In comparison to colour and sound trademarks, the number of smell or scent or olfactory trademarks registered is significantly less. Along with the basic requirements, the smell marks also has to fulfil the basic criterion of distinctiveness. The scent must be distinctive in nature and it cannot be utilitarian or functional. Consequently, the fragrance of a perfume cannot be registered as a trademark for perfume. Besides, in terms of graphical representation, the court stated that though drawings were not required, description of the scent was required.¹⁰

The main problem in accepting smell as trademark, under the Indian law and other jurisdictions like European Union and the United States of America, has been with the requirement of graphical representation.¹¹ How does one 'graphically' represent a scent?

In European Union

This is very uncommon and controversial trademark that has gained a lot of attention in recent times. The basic condition for registration of smell marks is its graphical representation. In Ralf Sieckmann case the registration of smell mark was rejected because of non- fulfilment of graphical representation criterion.

In the end, the European Union court decided that clear and precise graphical representation is not possible. So, they could not be registered only on the basis of distinctiveness.

In United States

In case of US, the condition has been completely different from the European Union. In United States it is not compulsory to represent the odour graphically but only to present a clear description of the odour with the registry.¹² To submit detailed written description which clearly describes the non-visual marks was sufficient. The scent must be distinctive in nature and it cannot be utilitarian or functional. Consequently, the fragrance of a perfume cannot be registered as a trademark for perfume. Moreover, in terms of graphical representation, the court stated that although drawings were not required but description of the scent was required.¹³

In India

The Trade Mark law in India does not specifically mentioned about the smell or scent marks. But it does not mean that definition excludes smell or scent completely. No smell or scent has been advertised in the Trade Marks Journal since the Act and Rules framed there under came into force on 15th September 2003. There are no regulations for measuring distinctiveness of a smell mark. The Draft Trade Mark Manual provides that the registration of Smell trademarks in India faces certain statutory impediments.

A "graphical representation" means the representation of a trade mark for goods or services in paper form.¹⁴ As per Rule 25(2) of the Trademarks Rules, 2002, 'An application to register, a trademark for a specification of goods or services included in any one class shall be made in Form TM-1 and after observing this form, it is almost impossible for the Registry to register smell as a trademark.'¹⁵

The forms are to be found in Schedule 2 of the Trademarks Rules, 2002. In the very start, the TM-1 application necessitates the 'representation' of the trademark to be fixed in the space that is provided for the same. It is the first

⁹ Amitkumar, "Registration of Unconventional Trademarks in India", September 09, 2010.

<http://www.legalservicesindia.com/article/article/registration-of-unconventional-trademarks-308-1.html>

¹⁰ VatsalaSahay, "Conventionalising Non-Conventional Trademarks Of Sounds And Scents: A Cross-Jurisdictional Study" p.

¹¹ Bentley and Sherman, "Intellectual Property Law", Oxford University Press, First edition, 2001, p.773.

¹² <http://www.apripindia.com/newsdetails.php?id=27>

¹³ VatsalaSahay, "Conventionalising Non-Conventional Trademarks Of Sounds And Scents: A Cross-Jurisdictional Study" P.134.

¹⁴ Rule 2 (1) (k) of the Trademark Rules, 2002.

¹⁵ SudiptaBhattacharjee and Ganesh Rao "The Broadening Horizons of Trademark Law Registrability of Smell, Sports Merchandise and Building Designs as Trademarks" Journal of Intellectual Property Rights, Vol. 10, March 2005, p.122.

deficiency of the TM-1 format because it is impossible to attach a representation of the trademark in the case of smell marks for goods or service.

Also, as per Rule 25 (12) (b), the trademark application should be able to depict the graphical representation of the trademark. But it is very difficult that a smell as a trademark cannot be depicted graphically, this problem being present in most jurisdictions of the world. In the case of a three dimensional trademark, the act and the rules have made exceptions; thus, in order to facilitate smell to be registered as a trademark, it would be necessary to introduce an amendment, both in the act and in the rules, as has been done for the combination of colours and three dimensional trademarks.¹⁶

Shape Marks

Shape is also a nonconventional trademark. But the basic condition, i.e. distinctiveness and must be able to distinguish the goods and services of one person from another person.

The shape of a product may be registered as a trademark provided that shape must not be functional in nature. A shape is functional when it affects the products use or performance. The shape of a product can be a trademark on condition that shape doesn't provide superior function. Shape has become associated in the minds of the purchasing public with the manufacturer.¹⁷ Thus if a certain shape is ornamental than more functional and serves no purpose then it may be registered.

In India

Shape marks are entitled to protection under the Indian Trademark Law. The first trademark protection to a shape mark was given by Delhi High Court to Zippo Manufacturing Company¹⁸. In this case the Court observed that "Like other trademarks it would be sufficient for a shape mark to enable the public concerned to distinguish the product from others which have another commercial origin, and to conclude that all the goods bearing it have originated under the control of the proprietor of the shape mark to whom responsibility for their quality can be attributed."

The Trade Mark Act provides that a trade mark shall not be registered if it consists exclusively of;¹⁹

- a) The shape of goods which results from the nature of goods themselves; or
- b) The shape of goods which is necessary to obtain a technical result; or
- c) The shape of goods, which gives substantial value to the goods.

The Trade Mark Draft Manual states clearly that when an application for a trade mark consisting of a shape of goods or packaging is made, the application should be in relation to the goods only and not in respect of the container. In this regard the Draft Manual further provides that the shape should not be descriptive in nature and must be distinguishing from the crowd and in the case of new product development must not be a shape likely to be taken for the product concerned.

Holograms

Holograms comes under the category of non-conventional trademarks, are capable of protection under the trademark law if they are distinctive and capable of distinguishing the goods and services of one person from another person. There is no provision in the Indian Trademark Law which restrict the protection of holograms.

Instances of Registration in India

Till now three non-conventional trademarks have received registration in India. Yahoo!'s yodel is the first non-conventional trademark to be registered. The yodel was represented through musical notes. The shape of the Zippo lighter was also granted registration, which was later confirmed in a trademark infringement suit in the Delhi High Court, on the ground that it was distinctive.²⁰

¹⁶ Ibid.

¹⁷ David Pressmen, Patent it Yourself (13th edition, Nolo, 2008) pg. 18.

¹⁸ Zippo v. Anil Manchandani (unreported, CS (OS). 1355/2006).

¹⁹ Section 9(3) of Trade Marks Act, 1999.

²⁰ Zippo v. Anil Manchandani (unreported, CS (OS). 1355/2006).

CONCLUSION

Non-conventional marks are gaining acceptance in India, but laws and procedures are still evolving. With new technological developments and the growing ease with which consumers can access information on devices that produce high-quality graphics and sound, the need for trademark protection will become greater. Regarding registration requirements, while it is imperative that these marks, apart from being distinctive and non-functional, be capable of being graphically represented since that ensures clarity for all interested parties, it is stressed that neither smell nor sound can be labelled to be incapable of graphical representation.

SUGGESTIONS

1. India laws and procedures are still in evolving stage so provisions should be made keeping in mind the high technological advancements in international trade and business.
2. In order to facilitate smell to be registered as a trademark, amendments should be made, both in the act and in the rules, as has been done for the combination of colours and three dimensional trademarks.
3. We should also follow the European and the American way of accepting sonograms and sound recordings as valid graphical representations in case sound marks.