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Registrability of Non-Conventional Trademarks: Position in India, United States & European Union

- Keerthi Depa¹

Abstract

In the realm of Intellectual Property, the registration system for trademarks primarily favours marks that can be graphically represented, constituting what are known as conventional trademarks. On the other hand, non-conventional trademarks are characterized with the help of sensory perception.² The Indian Trademarks Act of 1999 does not explicitly mention non-conventional trademarks, and this favourable treatment towards conventional trademarks is reflecting on the lack of legal backing for registration in the subject matter of non-conventional trademarks. This situation poses a threat to businesses striving to establish and maintain brand recognition, value, goodwill and ultimately their aim to aid consumers in easily identifying or recalling their brands. Against a backdrop of increased competition and technological advancements, various entities and brands struggle with the ambiguity and lack of uniformity in the existing legal framework for registration of non-conventional trademarks. Although the Indian judiciary has, over the years, contributed to shaping the legal landscape for non-conventional trademarks through noteworthy judgments, challenges persist in the registration and enforcement of such trademarks. This paper aims to delineate the distinction between conventional and non-conventional trademarks, while analysing the historical background and the current status of non-conventional trademark registration in India by drawing inferences from the practices in the European Union and the United States. Furthermore, this paper seeks to shed light on the topic and provide insights into the way forward.

Keywords: *Non-conventional Trademarks, Graphical Representation, India, EU, US*

Introduction

A trademark is one of the Intellectual Property Rights, which helps in distinguishing a company or entity's goods and/or services from that of the others. This identification is possible with the help of a brand's distinguished mark such as name, logo, packaging, colour, etc. that are associated with its good and/or services. In a perfectly competitive market, trademarked goods or services from various sellers are seen as

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² Dev Gangjee, 'Non-Conventional Trademarks in India' (2010) 22 NLSIR 67.

identical options or perfect substitutes for buyers. This means that consumers perceive no difference between the offerings and choose based on price or other factors. Whereas, in a market where there is product differentiation competition, trademarked goods or services are still substitutes, but they are not identical. There may be slight differences in quality, features, or branding that make consumers perceive them as distinguished options.³ In this way, the Intellectual Property Law encourages a market with competition and product differentiation.⁴ This is because in order to secure an Intellectual Property Right, say trademark, one needs to create a distinct brand image for their goods and services, rather than copying from players in the market. Therefore, it is fair to say that Intellectual Property Law is playing a crucial role in giving choices to the consumers to pick from varied products and thereby, stirring up the innovation, creation and competition.⁵

Purposes of Trademark

In terms of marketing, a trademark helps the businesses to build a brand image among the consumers through differentiation of products or services, identification of its origin, its quality, advertisement and image creation.⁶ In the quest for creating distinct brand images, companies are coming up with various strategies to make their products stand out and sustain in the product differentiation competition. This can be done through product customisation, labelling, quality, etc. One of the significant functions of trademark is that a mark indicates the origin of the products or services. In this regard, public perception is taken into account in order to ensure that a mark signals the source of the product or services to the consumers. This further helps the consumers in differentiating a product or service and thereby avoiding confusion. For instance, the famous Mc Donald's golden arched "M" logo helps the

³ Mayashree Acharya, 'Functions of Trademark in India' (*ClearTax*, 25 May 2022) <<https://cleartax.in/s/functions-trademarks-in-india>> accessed 10 July 2023.

⁴ WIPO, 'Intellectual Property and Competition Policy' (*WIPO*) <<https://www.wipo.int/competition-policy/en/index.html>> accessed 10 July 2023.

⁵ Acharya (n 3).

⁶ *Ibid.*

consumers to associate the logo with only Mc Donald's and it prevents other restaurants and entities from using that as it would amount to misleading the consumers. In view of quality, a trademarked helps the consumers in identifying the reputation, quality of a product and make them repurchase.

A mark can also help in promoting the goods and services to the public. It serves as a visual cue⁷ for the products or services that an entity is offering and help them to stand out in a competitive market. For example, a half-eaten apple logo represents and promotes all electronic gadgets, which belong to Apple. In the same way, a mark constitutes for a company's reputation and goodwill. This happens by virtue of continued usage of the trademarked product or service, which helps the businesses in establishing an image for themselves. For example, in the market for search engine, the trademark for Google embodies goodwill and reputation and has become synonymous with online searches by virtue of its image creation in the market.

Legal Framework in India

History and Evolution

The first official trademark law was passed in the year 1940. This act was known as the Indian Trademark Act, 1940⁸ and it was in correspondence to the British Trademark Act, 1938. It is a known fact that, the enactment of British Laws has prompted in passing considerable legislation in India. The discussion to have a law governing trademarks in India began in the year 1875 after the enactment of the English Act, 1975 in England. Upon some requests made by the Bombay Chamber of Commerce, a Trademark Bill, 1879 was introduced. However, due to lack of support, this bill remained unpassed.⁹

⁷ Acharya (n 3).

⁸ Hereinafter referred to as the "1940 Act".

⁹ Saloni Thawani, 'History and Development of Trademarks in India', (*BnW*, 2 May 2020) <<https://bnwjournals.com/2020/05/02/history-and-development-of-trademarks-in-india/>> accessed 24 July 2023.

Prior to the 1940 Act, there were several issues pertaining to the passing-off, infringement, etc., which were adjudicated by virtue of Section 54 of the Specific Relief Act, 1877 and the Indian Registration Act, 1908.¹⁰ The 1940 Act was superseded by the Trademark and Merchandise Act, 1958¹¹. This was as a result of the expansion of the trade and commerce industry, which demanded for heightened protection for trademarks. When India became a member of the WTO, it became a signatory to various agreements including the Trade Related aspects of Intellectual Property Rights¹². It is perceived as such that the TRIPS Agreement is inclusive of both conventional and non-conventional trademarks. In order to be compatible with the obligations enshrined under the TRIPS Agreement, the 1958 Act had to be repealed and the Trademarks Act, 1999¹³ came into existence.

In the year 2003, India acceded to the Madrid System and became a signatory to the Protocol on June 23. Madrid System is a union established for the purpose of making the procedure of International Registration of Trademarks. By virtue of this system, a uniform platform is provided to individuals and companies to protect their trademarks internationally. All the member states to this system are exempted from the requirement of registering their trademarks in different countries, for the purpose of attaining an international registration for their marks.

Current Legal Framework

In the Indian scenario, the laws pertaining to trademarks is governed by the 1999 Act and the Trademarks Rules, 2017¹⁴. The term '*trademark*' is defined under section 2(1)(zb) of the 1999 Act, stating that a trademark may consist of "*any sign capable of being represented graphically,*

¹⁰ Suvrais Sarkar, 'History and Evolution of Trademarks in India' 6 WWJ <[https://www.worldwidejournals.com/indian-journal-of-applied-research \(IJAR\)/recent_issues_pdf/2016/November/November_2016_1492175968__242.pdf](https://www.worldwidejournals.com/indian-journal-of-applied-research-(IJAR)/recent_issues_pdf/2016/November/November_2016_1492175968__242.pdf)> accessed 24 July 2023.

¹¹ Hereinafter referred to as the "1958 Act".

¹² Hereinafter referred to as the "TRIPS".

¹³ Hereinafter referred to as the "1999 Act".

¹⁴ Hereinafter referred to as the "2017 Rules".

which is capable of distinguishing the goods or services of one person from those of others.” As per section 2(1)(m) of the 1999 Act, a ‘mark’ is defined as a “*device, label, headings, brand, words, packaging, numerical, name, shape of goods, signature, combination of colours, letter, ticket.*” The 1999 Act accommodates for 45 classes, under which classes 1 to 34 pertain to goods and classes 35 to 45 pertain to services. This trademark classification provides the Act and the procedure of registration of trademarks with a definite structure.¹⁵ The classification is done in accordance with the NICE Classification, which is an “*International Classification of Goods and Services for Registration of Trademarks*”.¹⁶

In view of application for registering a mark, a person or the business must abide by Section 18 of the 1999 Act. Anyone who claims to be the owner of the mark currently in use or intended to be used by them and wishes to register it, must submit a written application to the Registrar.¹⁷ To register a mark for multiple classes of goods and/or services, one application would suffice. However, fee must be paid for each class of goods or services included.¹⁸ The application must be filed at the Trademarks Registry office located within the geographical jurisdiction where the applicant's main business location in India is situated.¹⁹ The Trademark Registry is entrusted with the power to administer the 1999 Act and 2017 Rules. The primary role of the Registry is to facilitate the registration process of those marks that meet the criteria outlined in the 1999 Act and 2017 Rules.

Conventional and Non-Conventional Trademarks

Trademarks can be broadly classified into conventional trademarks and non-conventional trademarks. Conventional or traditional trademarks are said to entail marks such as logos, words,

¹⁵ Intepat Team, ‘Trademark Classification of Goods and Services’ (*Intepat*, 15 November 2022) <<https://www.intepat.com/blog/india-trademark-classification/>> accessed 11 July 2023.

¹⁶ WIPO, ‘NICE Classification’ (WIPO) <<https://www.wipo.int/classifications/nice/en/>> accessed 11 July 2023.

¹⁷ Trademark Act 1999, S.18(1).

¹⁸ Trademark Act 1999, S.18(2).

¹⁹ Trademark Act 1999, S.18(3).

symbols, labels, etc. A non-conventional or unconventional trademark is different from conventional marks with regard to its characteristics, nature and potential.²⁰ These marks take the form of both visible and non-visible marks such as colour marks, shape marks, motion marks, touch marks, sound marks, smell marks, taste marks, etc. The advent of technology, creativity and competition has caused the emergence of unconventional trademarks as the businesses were coming up with new branding strategies to sustain in the market by creating a distinct identification for themselves among the consumers.

Non-conventional trademarks are based on sensory perceptions of human beings such as, vision, touch, sound, smell and taste. These trademarks have been in the market for a long while now, however, in terms of their acceptance, registrability and legality, there is still ambiguity and lack of uniformity. In accordance to the TRIPS Agreement, a trademark is defined based on their functional nature.²¹ The TRIPS Agreement also provided a list of marks that are permitted for registration but this list not exhaustive. This shows that non-conventional trademarks are not receiving enough validation and enforcement in comparison to conventional trademarks. This could be attributed to the hindrance that is caused by the requirement for registration on a territorial basis.²²

Registrability of Non-Conventional Trademarks

The system of trademark registration was designed to only register those marks that can be pictorially or graphically depicted. As per Article 15 of the TRIPS Agreement, Trademarks are defined as any sign or combination of signs that can differentiate goods and services from one another. While the definition does not explicitly mention non-

²⁰ Paridhi Jain, 'A Perspective on Non-Conventional Trademarks and the Difficulties in Extending IP Protection to Them' (*SCC Blog*, 16 September 2022) <<https://www.sconline.com/blog/post/2022/09/16/a-perspective-on-non-conventional-trademarks-and-the-difficulties-in-extending-ip-protection-to-them/>> accessed 12 July 2023.

²¹ Sanya Kapoor and Riya Gupta, 'The Five Senses and Non-Traditional Trademarks' (2005) 8 SA <<https://supremoamicus.org/wp-content/uploads/2018/10/V8A26.pdf>> accessed 12 July 2023.

²² *Ibid.*

conventional trademarks, it is considered to be broad enough to encompass them. Therefore, for a mark to fall within the ambit of non-conventional trademarks, it must possess inherent distinctiveness, be indicative of its origin, capable of graphical representation, and be able to distinguish goods or services from one another.²³ This definition is known for taking an open-ended approach by giving more weightage to the functionality of the mark rather than to its ontological status.²⁴ This means that more focus is on the practical function of the mark and not on its intrinsic nature.

This definition of trademarks outlined under the TRIPS Agreement is considered to have a broad and flexible approach under the presumption that this functionality element of marks would include non-conventional trademarks as well. However, there are certain statutory requirements, which act as prerequisites and need to be complied for the registration of non-conventional marks. Furthermore, laws with regard to registrability of non-conventional trademarks differ from country to country, thereby causing complexity and lack of uniformity. As per the statutory requirements, no mark can be registered unless it performs a communicative work²⁵, which would make the goods or services distinguished from the others in the market and signal the consumers of its origin or source. Another important prerequisite that needs to be met is that the business or person applying for registration must be able to represent the mark in a graphical or pictorial form on paper.²⁶

It is essential that the representations of a trademark effectively depict the mark's characteristics and clearly display each feature to enable thorough examination. In cases where a trademark takes the form of a colour, scent, sound, texture or a combination of these, the registration application is mandated to include a concise and precise description of

²³ Jain (n 20).

²⁴ Gangjee (n 2).

²⁵ *Ibid.*

²⁶ WIPO, 'Representation for Non-Traditional Marks', (WIPO) <https://www.wipo.int/export/sites/www/sct/en/comments/pdf/sct17/au_2.pdf> accessed 15 July 2023.

the trademark.²⁷ The description stated by applicant would be recorded as an endorsement on the registration. The kind of graphical representation chosen varies based on the specific type of mark that is being sought to be registered. The whole purpose of this representation is to provide a clear and descriptive representation of the trademark, thereby enabling anyone examining the Register to easily identify the nature and extent of protection associated with the mark. Furthermore, the written description accommodates for an integral aspect of identification of the trademark.

Therefore, it is now apparent that written description and graphical representation are to be given paramount importance and must be done with utmost care. The next step is to inspect the scope of the claim. This helps in checking if the claim for the registration of the mark is clear and has no ambiguity surrounding it. In order to examine this, both written description and pictorial representation would be considered to check whether they are appropriate or not. Upon examining and establishing that both description and representation are appropriate, it is crucial to ensure that the written description refers to the corresponding graphical representation in the application. Hence, the main issues with regard to registrability of non-conventional trademarks is the aforesaid pre-requisites to be met and the lacuna in the legal framework, which will be addressed in detail in the forthcoming paragraphs.

Types of Non-Conventional Trademarks

In the developing global market, non-conventional trademarks are divided based on five sensory perceptions of humans, as follows:

- *Smell:* The sense of smell is one of the strongest senses of human beings. A smell mark, also known as olfactory or scent marks, can be associated with perfumes and food items. In view of registrability of smell marks, merely providing the scent of a perfume or chemical substance does not amount to sufficient evidence. Therefore, the company or individuals making the claim must demonstrate both the

²⁷ *Ibid.*

geographical circumstances and the specific aroma as supporting evidence. Furthermore, a test of registrability has been established by one of the Member States to the World Intellectual Property Organisation to check whether a scent is eligible for registration.²⁸ The criterion that need to be met are (i) the person or business applying for registration must be the sole entity concerned with the promotion of goods that need to be registered, (ii) the scent associated with the product must be a feature that is distinctive and provided by the applicant and not a natural smell or attribute of that product, (iii) the applicant must actively highlight the fragrance of the product via advertisements, (iv) the applicant must provide evidence showing that dealers, distributors and customers have recognized the applicant as the sole source of the concerned products.

- *Sound:* Sound mark is one of the popular marks that does not fall under the purview of visible marks and emphasises on the importance of making products and services audible to the consumers²⁹. Sound marks are an essential tool in the hands of businesses in promoting and advertising their products and services in the form of theme songs, jingles, etc. For the purpose of meeting the criteria of graphic representation of a sound mark, a written description or a musical notation that describe the sound or music is required.³⁰
- *Sight:* Sense of sight encompasses various visible marks such as colour marks, shape marks, motion marks, etc.
- *Colour Marks:* Colour mark is one of the most registered and famous marks in the realm of non-conventional trademarks. There has been an uprise in the usage of colour marks and its applications

²⁸ WIPO, 'Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications' (2006) SCT/16/2 <https://www.wipo.int/edocs/mdocs/sct/en/sct_16/sct_16_2.pdf> accessed 16 July 2023.

²⁹ Anuja Sarswat, 'Sound Mark Registration Process' (Mondaq, 30 March 2022) <<https://www.mondaq.com/india/trademark/1177272/sound-mark-registration-process>> accessed on 16 July 2023.

³⁰ WIPO (n 26).

for registration and this is because colours have become the major source of identifications to the public eye. To fulfil a branding strategy, these marks are used in the form of combination of colours and single colour, for packaging, TV commercials, display boards, decorations, etc.³¹ However, there is a grey area in this field with regard to whether a single-coloured trademark is eligible for registration. The TRIPS Agreement considers combination of colours mark to be eligible for registration but it does not mention the registrability of single-coloured marks.³²

- *Shape Marks:* Shape marks also known as three-dimensional marks³³. These marks are one of the vital attributes of a product that helps the consumers in identifying the product. In order to qualify for a trademark registration, a shape mark must be distinct from that of the others in the market. However, the mark must not serve any functional purpose. The rationale behind placing a bar on the element of functionality is to exclude those marks which have acquired such shape by virtue of their inherent characteristics and to deliver a technical result.³⁴ Therefore, establishment of distinctive nature and absence of functionality element are the two main clusters, which help in determining the registrability of a shape mark.
- *Motion Marks:* Motion marks are a form of visible trademarks which comprises moving images, holograms, etc. A possible approach to visually representing motion marks is to offer a comprehensive written description, including detailed visual views of the motion from different frames. Since mere submission of written description may not be permissible, there needs to be reliance on visual representation with the help of high-resolution frames.

³¹ *Ibid.*

³² M M S Karki, 'Nontraditional Areas of Intellectual Property Protection: Colour, Sound, Taste, Smell, Shape, Slogan and Trade Dress' (2005) 10 JIPR 499.

³³ Hereinafter referred to as "3D marks".

³⁴ WIPO (n 26).

- *Taste:* Taste marks are also known as gustatory marks. These marks can only be granted to goods and services, where taste of a specific food item or commodity could be trademarked. In accordance with the report by the WIPO Standing Committee on Law of Trademarks, taste marks can be graphically represented by way of describing the taste in writing and by stating that the application pertains to a taste mark.³⁵
- *Touch:* Touch marks are one of the rarest non-conventional trademarks to be claimed for registration, however, they are receiving momentum by virtue of rapid commercialisation and competition in the market. Touch marks are also known as haptics, tactile or texture marks. The main purpose of these marks is to signal the source of the product or services to the consumers. So, when a consumer touches the product, they would be able to recognize origin of the product.³⁶

Legal framework for Non-Conventional Trademarks in India

The Indian jurisprudence for Trademark Law has seen some notable judgements in the cases of registering non-conventional trademarks. However, legal framework for registrability of non-conventional trademarks is still in its stage of infancy. As discussed above, there are no explicit legal provisions concerning non-conventional trademarks enshrined under the 1999 Act. So, it is presumed that the provisions for conventional trademarks would be applicable to non-conventional trademarks. The issue with this application is that there is ambiguity as to the extent of applicability of provisions of conventional marks to non-conventional marks. The definition outlined under Section 2(1)(zb) of the 1999 Act has a rigid application to both visible and non-visible non-conventional trademarks.

³⁵ Akansha Choudhary and Ashna Shah, 'Position of Smell Marks and Taste Marks: India Vs Developed Countries' (2022) 5 IJLMH 2087

³⁶ WIPO (n 20).

It is a known fact that Article 15 of the TRIPS Agreement is an open-ended definition and the scope of it can be determined by Member States in terms of its implementation. Besides meeting the criteria of possessing distinctiveness, the mark is supposed to be graphically represented in India, for it to be registered. This means that for any form of trademark, graphical representation is the “*sine qua non*”³⁷ to get registered in India. The rationale behind representing the mark on a piece of paper is for the sake of reference. This criterion was first stated by the European Court of Justice in the case of “*Ralf Sieckmann*”.³⁸ It was opined in this case that a graphical representation would help in clearly identifying and demarcating the mark by the public, Registry and other players in the market.³⁹ However, the situation is different in the United States, where graphically representing trademarks is not a pre-requisite for registration.

This importance of graphical representation was also supported by the Indian Trademark Office and the same was stated in the Draft Manual of Trademarks.⁴⁰ The aim of “*Trade Mark Manual for Indian Trade Mark Registry*”⁴¹ is to bring and maintain consistency and uniformity in the practice of registration of trademarks, examination of the applications and compliance procedures. The Manual is a compendium⁴² of the legal procedures and provisions pertaining to the registration of trademarks, which needs to be followed by the Trademark Registry. It is issued and updated as and when needed by the office of the Controller General of Patent Design and Trademarks. In case there is any inconsistency between the contents of the Manual and the 1999 Act or the Rules, the latter

³⁷ Tanisha Agarwal and Vanshaj Mehta, ‘Hear Me, Touch Me, Taste Me, Smell Me: Conventionalising Non-Conventional Trademarks In India’ (2023) 3 JCIL <<https://jcil.lsyndicate.com/wp-content/uploads/2023/06/TanishaVanshaj.pdf>> accessed 20 July 2023.

³⁸ Dr. Vishwas Devaiah ‘Non- Conventional Trademarks and Domain Names’ (*INFLIBNET Centre*) <http://epgp.inflibnet.ac.in/epgpdata/uploads/epgp_content/law/08._intellectual_property_law/18_non-conventional_trademarks_and_domain_names/et/8090_et_et.pdf> accessed 20 July 2023.

³⁹ *Ibid*.

⁴⁰ Devaiah (n 38).

⁴¹ Hereinafter referred to as “the Manual”.

⁴² Setindiabiz Team, ‘Download the Latest Trademark Manual of Indian Trademark Registry’ <<https://www.setindiabiz.com/learning/download-latest-trade-mark-manual-of-indian-trade-mark-registry>> accessed 20 July 2023.

prevails. Even though there is no Manual that has been approved with regard to registrability of non-conventional marks, the Draft Manual of Trademarks, 2017 provides guidelines in this subject matter. Furthermore, it was mentioned by the Controller General of Patents Designs and Trademarks⁴³ that the marks which do not fall within the ambit of ‘sense of sight’ would be looked into on a case-to-case basis with special attention.⁴⁴ Since the Manual is an evolving document, it must adhere to the new developments in the age of non-conventional trademarks and provide a detailed procedure for its registration.

Even though India acceded to the Madrid system and became a signatory to the Protocol, it is important to note that the acceptance and registration of non-conventional trademarks varies across different countries. While the Madrid System facilitates for streamlining the registration process for trademarks internationally, the scope and interpretation of Article 15 of the TRIPS and domestic Trademark Laws differs from country to country. So, it can be inferred that the application and registration process for non-conventional trademarks in India is rigid in comparison to that of European Union and United States.

Non-Conventional Marks: Comparison of United States, European Union and India

Smell Marks

- *United States:* The concept of registering smell marks was recognised for the first time in the United States in the year 1990. So, there is a huge acceptance with regard to registrability of smell marks in the United States. In the case of “*In Re Celia Clarke*”⁴⁵, a smell mark for “*scented yarns and threads*” was registered, which possessed the scent of “*fresh, floral fragrance reminiscent of Plumeria blossoms*”. This description of the scent was considered as a graphical representation and the

⁴³ Hereinafter referred to as the “CGPDTM”.

⁴⁴ Kapoor (n 21).

⁴⁵ IN RE CELIA CLARKE, DBA CLARKE’S OSEWEZ [1990] USPTAB 758,429

registration of the scent was successful on the reasoning that the scent was distinctive and non-functional. To evaluate the standard of non-functionality, the criteria that needs to be met is that the scent must not be “*essential to the use and purpose of the product*” or “*affect the cost or quality of the product*”.⁴⁶ The Trademark Trial and Appeal Board held that the fragrance or smell associated with the yarn and threads is added separately by the suppliers and not an inherent feature of the product. This means that the yarn functions independently of the scent and the scent does not serve as a utilitarian purpose⁴⁷ for the yarn. It can be deduced that the functionality element of a scent determines the registrability of the mark.

In the United States, the Lanham Act, 1946 is also known as their Trademark Act. This is a federal statute that governs trademarks, unfair competition and service marks.⁴⁸ Under the Lanham Act, Section 2 discusses about the marks, for which the registration must be refused. This section does not bring non-conventional trademarks under the purview of refusal for registration. Therefore, it can be inferred that non-conventional trademarks are not explicitly exempted from the category of registration and this reasoning was provided by the United States Patent and Trademark Office.⁴⁹ So, in view of the position in United States, smell marks can avail protection under the Trademark Act, 1946, provided they meet the criterion of distinctiveness and non-functionality.

⁴⁶ Rachna R.Kurup and Nimita Aksa Pradeep, ‘Non-Conventional Trademarks In India: The What, The Why and The How’ (2020) 1 E-JAIRIPA <https://cnlu.ac.in/wp-content/uploads/2022/08/9-Rachna-R-Kurup-and-Nimita-Aksa-Pradeep.pdf> accessed 20 July 2023

⁴⁷ Roshni Hedge, ‘Smell Marks & Intellectual Property: A Cross Jurisdictional Analysis’ (Legal Desire, 7 September 2020) <https://legaldesire.com/smell-marks-intellectual-property-a-cross-jurisdictional-analysis/> accessed 20 July 2023

⁴⁸ Nolo, ‘Lanham (Trademark) Act’ (Nolo) <https://www.nolo.com/legal-encyclopedia/content/lanham-act.html> accessed 20 July 2023

⁴⁹ Franco Galbo, ‘Making Sense of the Nonsensical: A look at Scent Trademarks and their Complexities’ (IPWatchdog, 21 December 2017) <<https://ipwatchdog.com/2017/12/21/scent-trademarks-complexities/id=91071/>> accessed 20 July 2023.

- *European Union:* In the United Kingdom, it is the Trademark Act, 1994 that governs trademarks and the system of registration. Significant weightage is given to the requirement of graphical representation in the European Union. The first scent mark that applied for registration was by Channel for their perfume “*Channel No.5*” in 1994. This application was rejected on the grounds that both the scent and the product are indistinguishable in view of an end product and its finality. Even though the brand tried to represent the scent mark on paper by stating “*The scent of aldehydic-floral fragrance product*”, the application was rejected for the aforesaid reasons.

However, in the year 1996, a smell mark was registered for the first time in Britain for the tyres of the company named Sumitomo Rubber Company. They were able to graphically represent their smell mark for the fragrance that was put to their tyres. Later on, a landmark judgement was passed in the case of *Raf Sieckmann v. Deutsches Patent and Markenamt*⁵⁰, which set the precedence for all the case pertaining to the registrability of scent marks. Through this case, the “*Sieckmann Test*” was established, where the court stated that the representation of the mark must be “*clear, precise, self-contained, easily accessible, intelligible, durable and objective*”.⁵¹ As per the factual matrix of this case, the applicant Sieckmann, in pursuit of getting a scent registered, submitted an application which encompassed details concerning its chemical formulae, composition, samples, etc. Regardless of representing the mark on a piece of paper, the mark was not registered on the basis of inadequate graphical representation. The European Court of Justice stated that the compositions, formulae, etc. are merely describing the ingredients of the scent and not the scent.

- *India:* India lacks precedents and instances where a smell mark sought for or attained registration. However, it has been decided by the Registry that the “*Sieckmann Test*” would be applicable while determining registrability of a smell mark. So, similar to the European

⁵⁰ *Raf Sieckmann v. Deutsches Patent and Markenamt* [2002] ECJ 273.

⁵¹ Kurup (n 46).

Union, India follows requirement of having graphical representation of a mark as a pre-requisite. Furthermore, it was stated by the Draft Manual of Trademarks, 2015 that in order for a smell mark to get registered, the applicant must graphically represent the smell mark and that the whole purpose of this representation is to ease the process of product differentiation for the consumers.⁵² Since the *Sieckmann* Test is followed in India, mere listing of chemical composition and ingredients does no amount to graphical representation. Therefore, it is difficult to get smell marks registered in India.⁵³

Sound Marks

- *United States:* Similar to smell marks, even sounds are not expressly mentioned in the Lanham Act, 1946 for registration. In the United States, a sound mark can be registered if it is distinct and operates in the commerce. Unlike the situation in the European Union and India, graphical representation of a sound is not a pre-requisite for registering it. Furthermore, there is no prescribed time duration of the sound clip that is submitted along with the application for registration of the mark, however the maximum limit is 5 MB.⁵⁴ The USPTO has been accepting various sound marks for registration. One of the unusual sounds that the USPTO has registered a distinct yell “EEEEYOYOYO”, which is a signature sound made by a rapper named Pitbull.⁵⁵ This sound is known as “Grito” and the USPTO is convinced that it is associated with the rapper and their performances.⁵⁶ Sound marks in the United States are broadly

⁵² Kapoor (n 21).

⁵³ Pooja Kulkarni, ‘Smell as a Trademark: Its Registrability and Challenges in India and Other Countries’ (2022) 2 IJLRA.

⁵⁴ Selvan & Selvam, ‘Requirements of a Sound Mark – An International Perspective’ (*Selvan & Selvam*, 16 December 2021) <<https://selvams.com/blog/requirements-of-a-sound-mark-an-international-perspective/>> accessed 20 July 2023.

⁵⁵ Pranav Gupta. ‘Pitbull yells out a trademark for himself! How Trade marking sounds have come a long way’ (*The IP Press*, 4 June 2020) <<https://www.theippress.com/2020/06/14/pitbull-yells-out-a-trademark-for-himself-how-trade-marking-sounds-have-come-a-long-way/>> accessed 20 July 2023.

⁵⁶ Nick Reily, ‘Eeeyo! Pitbull has trademarked his signature yell’ (*NME News*, 2 April 2020) <<https://www.nme.com/news/music/eeeyo-pitbull-has-trademarked-his-signature-yell-2651507>> accessed 20 July 2023.

categorised into two kinds by the Trademark Trial and Appeal Board, namely, *inherently distinctive* and *non-inherently distinctive*.⁵⁷ This means that the mark must be inherently distinctive or must possess secondary meaning in order to be registered. To acquire secondary meaning refers to the power that a mark holds in signalling the origin or source of the product or service to the consumers. In the Pitbull case, it was established that his songs exist in a commercial and that they have acquired secondary meaning as when people hear “Grito”, they are aware that it is by and from Pitbull.⁵⁸ Therefore, acquiring distinctiveness or secondary meaning and operating in a commercial space are the requirements for a sound to be trademarked in the US.

- *European Union:* With the case of *Shield Mark v. Joost Kist*⁵⁹, the position on sound mark registration was established in the European Union. Shield brought a suit against Joost alleging that the latter had infringed their sound mark, which was “Beethoven’s musical composition of Fur Elise” and an onomatopoeia “kukelekeuuuuu”.⁶⁰ The musical composition of Fur Elise was represented on the musical stave. The issue in this case was whether a representation of musical notes through transcription on a musical stave and onomatopoeia be registered and given trademark protection. The European Court of Justice opined that mere written description of musical notes would not suffice to attain registrability and that the mark should be represented on a musical stave. In view of onomatopoeia, the European Court of Justice said that the description of “kukelekeuuuuu” is merely a phonetic imitation⁶¹ and therefore, it does not account for graphical representation of a sound. Furthermore, the “Sieckmann Test” was incorporated in this context to explain the importance of

⁵⁷ Xinyu Zhang, ‘From Audio Branding to Sound Trademark: A Comparative Study in the EU and the US’ (2021) 12 BLR <<https://www.scirp.org/journal/paperinformation.aspx?paperid=108713>> accessed 20 July 2023.

⁵⁸ Gupta (n 55).

⁵⁹ *Shield Mark v. Joost Kist*, h.o.d.n. MEMEX Case C–283/01, Reports of Patent, Design and Trade Mark Cases, Volume 121, Issue 9, 2004, Pages 315–326 <<https://doi.org/10.1093/rpc/2004rpc17>> accessed 20 July 2023.

⁶⁰ Devaiah (n 38).

⁶¹ *Ibid.*

graphical representation for sound marks to be registered. Even a Lion's roar and Tarzan's yell was given trademark protection. These sounds did not have any musical representation; however, they were represented through sonogram or spectrogram images. So, the European Union accommodates for non-musical sounds as well, provided they are represented in the form of sonogram or spectrogram images.

- *India:* India has been welcoming towards protection of sound marks. It registered its first sound mark in the year 2008 for a “three-note yodel” sound in human voice for Yahoo. In the year 2011, ICICI Bank was the first entity to get a sound mark registered for its corporate jingle, “*Dhin Chik Dhin Chik*”, which is used in its advertisements.⁶² Even though there were no legal provisions and guidelines pertaining to the registrability of sound marks, India has been progressive in this realm. Later on, with the implementation of the 2017 Rules, a framework was established to streamline and regulate the process of registering sound marks. As per Rule 26(5) of the 2017 Rules, in order to register a sound mark, the recording of the sound must be submitted to the Registry in an MP3 format, which is not exceeding 30 seconds along with the representation of the notes, graphically.⁶³ So, in India, for a sound mark to be registered, a sound clip as per Rule 26(5) and graphical representation must be submitted at the time of application. These practices are influenced from the European Union. However, in both United States and United Kingdom, there is no prescribed time frame for the sound clip.

Colour Marks

- *United States:* Earlier, it was believed in the United States that colour could not operate as trademarks. Moreover, up till 1995, there was debates concerning the issue of registrability of single-coloured

⁶² Anirud Agarwal and Gaurav Bhalla, ‘Sound Mark Registration Process in India’ (*Ahlatwat & Associates*) <<https://www.ahlawatassociates.com/blog/sound-mark-registration-process-in-india/>> accessed 21 July 2023.

⁶³ Trademark Rules 2017, R.26(5).

marks. The registrability of a single colour was feared due to reason that one day all the colours existing would be exhausted after seeking trademark protection. This was known as the “colour depletion” rule.⁶⁴ In the case of *In re Owens-Corning Fiberglass Corporation*⁶⁵ a single-coloured mark, pink, was given trademark protection, which was used for home insulation. The rationale behind granting this trademark was due to the acquired distinctiveness through use. The pink coloured home insulation was advertised and marketed in that colour for more than 30 years.⁶⁶ In the landmark judgement of *Qualitex Co. v. Jacobson Company*⁶⁷, the US Supreme Court granted trademark protection to green-gold colour of Qualitex’s press pads. The Court opined that for a single colour to be registered, it must have a secondary meaning since it cannot be inherently distinctive. Even though the functionality element was not stressed upon, no colour which is attributable to the trade cannot be registered in the United States.

- *European Union:* Both single colour and combination of colours are registrable in the European Union. However, in view of the registrability of a single-coloured mark, in the case of *Libertel Groep BV v. Benelux-Merkenbureau*⁶⁸ related to registrability of orange colour used for telecommunications goods and services, the European Court of Justice opined that a single colour may not act as a “source identifier”⁶⁹ to the consumers and hence, it cannot be registered. But, the Court held that protection could be granted if the applicant shows that they have advertised and marketed that colour enough for their brand in the market and that it has acquired distinctiveness.
- *India:* The stance of registrability of colour marks is ambiguous in India due to a thread of differing judgments, which were contradictory to each other. The major criterion that are looked at, for

⁶⁴ Karki (n 32).

⁶⁵ *In re Owens-Corning Fiberglass Corporation* [1984] 221 USPQ 1195.

⁶⁶ Devaiah (n 38).

⁶⁷ *Qualitex Co. v. Jacobson Company* [1995] 514 U.S 159.

⁶⁸ *Libertel Groep BV v. Benelux-Merkenbureau* [2003] ECJ C-104/1.

⁶⁹ Devaiah (n 38).

a trademark to be registered in India are to establish that the product or service is distinguishable in the market through prior use, or acquire secondary meaning and graphical representation of the mark. The term “*combination of colours*” is explicitly mentioned in the definitions of *trademark*⁷⁰ and *mark*⁷¹ under the 1999 Act. In view of single colours, the 1999 Act does not expressly mention or exclude the registrability of them. Therefore, it can be interpreted that colour marks are accepted and registrable in India.

In the case of *Colgate-Palmolive Co. v. Anchor*⁷², an injunction was passed against the defendant, Anchor company as their actions of using the combination of colours “*red and white*” amounted to passing off. The court held that the combination of one third red and two third white on Colgate products acts as a source identifier and gives a visual impression to the consumers that the described product belongs to Colgate. So, in this case, a combination of colours was accepted and granted protection against the act of passing off. Even though single colours are not explicitly prohibited under the 1999 Act, there have been instances where the judiciary has not granted them any protection. In the case of *Christian Louboutin v. Abu Baker*⁷³, the Delhi High Court did not grant trademark protection to the red coloured sole of the heels on the grounds that it was a single colour. The reliance was placed on Sections 2(1)(zb) and 2(1)(m) of the 1999 Act, under there is only mention of “*combination of colours*” and hence, the intention of the statute is to exclude single colours from the purview of registrability. So, protection was not granted to the red colour mark for Christian Louboutin heels and were exempted from the remedy of passing off, which is guaranteed under Section 27(2) of the 1999 Act.⁷⁴ It can be deduced that unlike in the United States and the European Union, single colour is not granted trademark protection in India.

⁷⁰ Trademarks Act 1999, S. 2(1)(zb).

⁷¹ Trademarks Act 1999, S. 2(1)(m).

⁷² *Colgate-Palmolive Co. v. Anchor Health and Beauty Care* [2003] VIIIAD Delhi 228.

⁷³ *Ibid.*

⁷⁴ Dipak Rao and Sana Singh, ‘Protection Of “Color” under the Trademark Law’ (*Mondaq*, 13 June 2019) <<https://www.mondaq.com/india/intellectual-property/814512/protection-of-color-under-the-trademark-law>> accessed 21 July 2023.

Shape Marks

- *United States:* Even though shape marks are not explicitly mentioned in the Lanham Act, there have been cases where shapes like 3D marks have been granted protection in the United States. The main criterion for registrability in the United States is to acquire distinctiveness and be non-functional. In the case of *Bongrain's Trademark Application*⁷⁵, the application to register the shape of cheese, which is in a flower-like form was rejected. This 3D shape was regarded ineligible for trademark protection on the grounds that it lacked distinctiveness. For a 3D shape to be registered, it must be depicted in the form a drawing. However, if it cannot be depicted in a 3D configuration, upon requesting, the applicants can draw the shape from multiple views. In the case of *Coca-Cola Co. v. A.G. Barr & Co.*⁷⁶, the Coco Cola bottle was granted trademark protection by the USPTO, for its 3D shape. This was granted on the grounds that people associated the 3D shape of the bottle with the brand and the shape acquired distinctiveness.
- *European Union:* In the United Kingdom, shape marks were mentioned under the Trademarks Act, 1994. For a shape to be registered, it must possess distinctiveness, acquire secondary meaning and must not be functional in the European Union. In the case of *Koninklijke Philips v. Remington*⁷⁷, Phillips alleged that Remington committed infringement of their trademarked electric shaver, which has a rotary three headed structure on the top. In response, Remington claimed that the shape was giving a technical result to the product and hence, it cannot be a valid mark. The European Court of Justice held that this essential feature of a three-headed top is attributing to the technical result of the products and that the mark is invalid. As to the question of determining distinctiveness of a 3D shape, the European Court of Justice stated in the case of *Henkel and*

⁷⁵ *Bongrain's Trademark Application* [2004] EWCA Civ 1690.

⁷⁶ 1961 R.P.C. 387 (Scot. Sess. Cas.).

⁷⁷ C-299/99, [2004] ALL ER (D) 301.

*Proctor and Gamble*⁷⁸ that besides the factor of consumer perception, the other important factor is that the more the shape of the mark resembles the shape of the product, the lesser it becomes distinctive.

- *India:* Similar to “*combination of colours*”, even shape marks have made it to the definition mark and trademark under the 1999 Act. India follows the stance taken by the European Union in the registrability criteria of shape marks. As laid out under section 9(3) of the 1999 Act, a shape mark shall not be eligible for registration under three circumstances, which are (i) if the product has received that shape virtue of its natural attributes, (ii) the shape serves a functional element to the product and helps it in achieving technical results, and (iii) adds value to the goods.⁷⁹ These conditions are similar to the ones stated in the case of *Koninklijke Philips*⁸⁰ with regard to the non-functionality standard that needs to be met to be granted trademark protection.⁸¹ In the decision of *Gorbatschow Wodka KG v. John Distilleries Ltd*⁸², it was held by the Mumbai High Court that the shape of the vodka bottles of the plaintiff’s has acquired distinctiveness and goodwill in the market. Therefore, the shape of the bottle was given protection by passing an injunction against the defendants who were using identical shape to that of the plaintiff. Furthermore, in the case of *Zippo Manufacturing Company v. Anil Moolchandani*⁸³, the Zippo company brought a suit against the defendants for allegedly imitating the 3D shape of their lighters. The court restrained defendants from doing so and granted protection to 3D mark of the plaintiff’s lighters.

However, in the case of *Knitpro International v. Examiner of Trademarks Through Registrar of Trademarks*⁸⁴, the application for registering the shape of “*knitting needles*” was refused on the grounds

⁷⁸ *Henkel KGaA v. European Union Intellectual Property Office*, joined Cases C-456/01 P and C-457/01 P, Judgement of the Court (Sixth Chamber) on 29 April 2004.

⁷⁹ Trademarks Act 1999, S. 9(3).

⁸⁰ C-299/99, [2004] ALL ER (D) 301.

⁸¹ *Devaiah* (n 38).

⁸² 2011 (47) PTC 100 (Bom).

⁸³ [2011] (48) PTC 39.

⁸⁴ [2022] C.A. (COMM.IPD-TM) 110/2022.

that it lacked distinctive nature. The jurisprudence for the registration of shape marks was established through this case by the Delhi High Court. The Court has laid out that for a shape to be registered, it must possess both distinctive nature and secondary meaning. Even though this position of shape marks is similar to that of in the United States and the European Union, the criterion established in this case seem much stricter, especially for a country which is struggling to accept and streamline the registration process of non-conventional marks.

Motion Marks

- *United States:* The United States is known for registering one of the oldest motion marks in the history. In 1996, Columbia pictures registered their motion mark of where a woman wearing a drape is holding a torch. This was intended to personify the United States.⁸⁵ For a motion mark to be registered in the United States, the mark must be distinctive and act as a source identifier. To express the commercial impression that the mark intended to convey, the applicant must submit a video file, screenshots or still photos that depict a repetitive motion of the mark. Furthermore, in view of representation, the applicant must submit a various movement of the motion, along with a detailed written description. Some of the renowned motion marks registered in the United States are the Microsoft Window's animated sequence of its logo, the opening and the arrangement of the "wing" door of Lamborghini, etc.⁸⁶
- *European Union:* Earlier, for a motion mark to be registered in the European Union, graphical representation of the mark was a mandatory requirement. However, graphical representation of a

⁸⁵ Anany Banerjee and Sandhya A, 'Importance and Challenges of Protecting Motion Mark – India' (*SS Rana & Co*, 18 April 2022) <<https://ssrana.in/articles/importance-and-challenges-of-protecting-a-motion-mark/>> accessed 23 July 2023.

⁸⁶ Belinda J. Scrimenti, and Pattishall, 'Animated "Motion Trademarks" Grow in Popularity and Legal Protection Around the World' (*LexisNexis*, 6 January 2020) <<https://www.lexisnexis.com/community/insights/legal/practical-guidance-journal/b/pa/posts/animated-motion-trademarks-grow-in-popularity-and-legal-protection-around-the-world>> accessed 23 July 2023.

motion mark is no longer a pre-requisite to register them. This was because mere written description coupled with stills of the motion, were not sufficient in depicting the and hence, rejected by the European Union's Intellectual Property Office. Now, the motion marks can be depicted in the form of video clips, or series of still images, which show the change in movement and position of the motion. However, there is a condition that these marks must be depicted in a precise manner, which a normal person would be able to perceive and understand. These new regulations were adopted in 2017 by the United Kingdom, Germany and France.⁸⁷

- *India:* In order to register a motion mark in India, it must adhere to Rule 2(1)(k) of the 2017 Rules⁸⁸, which is to graphically represent the mark. The representation of a motion mark is allowed only through a piece of paper and no submission of video clips is permitted. This has become a difficult task for the businesses to represent their motion marks and therefore, a lot of applications are getting rejected. However, there are two famous motion marks which have been registered by the Indian Trademarks Registry. The first motion mark to be filed is the “*connecting hands*” motion mark by the Nokia Corporations in the year 2003.⁸⁹ However, this was registered as a device mark, where the mark was depicted by submitting still frames of hands eventually being connected. In the case of Toshiba Corporation, they wanted to register the moving images of their name. Initially, this application was rejected by the Trademark Registry of Delhi and they reasoned this rejection by stating that “*motion marks are not approved in India*”.⁹⁰ However, this decision was reconsidered and their motion mark was registered.

⁸⁷ Sri Hari Mangalam, ‘Motion Trademarks: the new age brands’ (*Bar and Bench*, 2 August 2020) <<https://www.barandbench.com/apprentice-lawyer/motion-trademarks-the-new-age-brands>> accessed 23 July 2023.

⁸⁸ Trademark Rule 2017, R. 2(1)(k).

⁸⁹ Banerjee (n 85).

⁹⁰ Mukesh Kumar, ‘Trademark Protection for Motion Mark’ (Tutorials Point, 14 February 2023) <<https://www.tutorialspoint.com/trademark-protection-for-motion-mark>> accessed 23 July 2023.

In both United States and European Union, necessity of depicting a motion mark on a piece of paper has been removed. The applicants are permitted to depict their motion marks in the form of video clips, still photos and drawings. In this regard, India is having an obsolete legal framework for the registration criterion of motion marks.

Taste Marks

- *United States:* It is highly unlikely for taste marks to be registered in the United States this is because there have been certain instances where registration of taste marks have been unsuccessful. In the case of *In Re N.V. Organort*⁹¹, taste mark application for orange flavour of an anti-depressant pills was rejected. The reasoning provided by the Trademark Trial and Appeal Board was that the taste was not meeting the non-functional standard and lacked distinctive characteristic. Through this case, the Trademark Trial and Appeal Board established that for a taste mark to be registered, the applicant must prove that the flavour has achieved distinctiveness through use and acquire secondary meaning.⁹² Furthermore, it was stated in the case that since a flavour cannot be tasted unless a person consumes it, a taste mark cannot be inherently distinct. Therefore, a taste mark can acquire distinctiveness by virtue of use and secondary meaning.

In another case of *Re Pohl-Boskamp GmbH & Co KG*⁹³, the applicant tried to register two types of marks, namely, “*peppermint smell mark*” and “*peppermint taste mark*”. These marks were pertaining to a spray that relieves chest pain which is caused due to insufficient flow of oxygen and blood to the heart. This was rejected as peppermint was playing a functional role as it helps in treating such chest pains. Therefore, acquiring distinctiveness, secondary meaning and non-functionality element are the criterion for a taste mark to be registered in the United States.

⁹¹ *In Re N.V. Organort*, [2006] 9 U.S.P.Q. 2d (BNA).

⁹² Choudhary (n 35).

⁹³ *Re Pohl-Boskamp GmbH & Co KG* [2013] 106 U.S.P.Q.2d 1042.

- *European Union:* Similar to the situation in the United States, the European Union has not been very receptive to taste marks. There has been no successful registration of taste marks in the European Union. Furthermore, even regulations like the European Union Trademark Regulation, 2017 does not comprise any provisions pertaining to taste marks. However, the criteria to determine the registrability of taste marks was established in the case of *Eli Lilly v OHIM*⁹⁴. In this case, the application for registering taste of medicine which possess the flavour of “*strawberry*” was rejected on the grounds that it lacked distinctive character and was attributing to the functionality of the medicine’s taste by enhancing it. Therefore, the criteria to determine the registrability of a taste mark in the European Union is to distinctiveness and non-functionality.
- *India:* To date, India has not registered a single taste mark. There is no provision for taste marks in the 1999 Act and even the Draft Manual of Trademarks does not mention it. Furthermore, there have been no court rulings pertaining to this subject matter.⁹⁵ The lack of taste mark registrations in India can be attributed to the more stringent criteria for determination, including requirements for distinctiveness, non-functionality, and graphical representation. While India shares common registrability criteria with the United States and the European Union, such as distinctiveness and non-functionality, the unique requirement of graphical representation appears to be the primary hindrance for the registration of taste marks in India.

Touch Marks

- *United States:* A luxury brand that sells luggage and leather-based products, *Louis Vuitton Malletier*, was one of the first companies to get a touch mark registered. In 1996, on the grounds of the texture of

⁹⁴ R 120/2001-2 *Eli Lilly and Company/ The Taste of Artificial Strawberry Flavour* [2004] ETMR 4.

⁹⁵ Choudhary (n 35).

their bags being “*distinctive man-made textured pattern utilized as a surface feature*”.⁹⁶ Furthermore, in the case of Kimberly-Clarke, they were able to register the configuration that is present on their facial tissue dispenser. The USPTO also approved of their paper towels that have a raised and alternating pattern.

- *European Union:* In Germany, the Trademark Registry of German Patent and Trademark office grants protection to tactile marks on the grounds of their acquired distinctiveness through use and there is no requirement of graphical representation. In 2003 the trademark was granted on the basis of an application filed in the name of Underberg AG for several goods in Classes 32 and 33. However, they have no significant registrations of touch marks in the European Union.⁹⁷
- *India:* For a touch mark to be registered in India, it needs to be distinctive and graphically represented. Furthermore, the texture of the product must not contribute to the functionality of the product. It has been noted that no application for registration of a touch mark was placed in India till now.⁹⁸ Owing to the difficulties that an applicant may face in trying to represent a touch mark on a piece of paper, there is no strong case for touch mark registrability in India.

The Way Forward

Upon studying the situation of registrability of non-conventional trademarks in India, in comparison to that of in the United States and the European Union, it is apparent that there is a lot of scope for the Indian legal framework to grow in this subject matter. The following suggestions need to be implemented to better the India scenario with respect to non-conventional trademarks:

⁹⁶ See Kapoor (n 21); Lukose, Lisa P. “Non-Traditional Trademarks: A Critique”, *Journal of the Indian Law Institute*, vol. 57, no. 2, 2015, pp. 197–215. JSTOR, <<http://www.jstor.org/stable/44782501>> accessed 16 July 2023.

⁹⁷ *Ibid.*

⁹⁸ Abhinaya Ramesh and R. Gomathi, ‘Indian Perspective on Unconventional Trademarks’ (2021) 8 JETIR <<https://www.jetir.org/papers/JETIR2108372.pdf>> accessed 10 July 2023.

- *Do away with the mandate for graphical representation:* The pre-requisite to represent a mark on a piece of paper seems to be the biggest barrier to register non-conventional marks, especially non-visible ones such as taste, smell, and touch marks. The fact that there are no successful registrations for the aforesaid marks in India can be attributed to the fact that it is difficult to graphically represent these marks. In both United States and European Union, the laws have been comparatively welcoming towards non-conventional marks, especially to the non-visible ones. This is because they do not have a mandate for graphical representation. In the United States, the law states that there is no requirement for graphical representation and it was eliminated for marks such as smell.⁹⁹ Furthermore, as per the TRIPS agreement, graphical representation is not a mandatory requirement. So, India needs to do away with the requirement of graphical representation to improve and accept non-conventional trademarks.
- *Implementation of Hard Law:* The 1999 Act and the Indian legal framework has been receptive about registration of non-conventional trademarks. There is no explicit mention of non-conventional trademark and the procedure to register them. Until and unless a robust jurisprudence for non-conventional trademarks is developed, there would be no recognition for these marks, especially smell, taste and touch marks. India has been having a parallel legislation with that of the European Union and to some extent to that of the United States. However, India seems to be disregarding certain liberal approaches taken by both the aforesaid jurisdictions and rigorously implementing stricter criteria such as graphical representation for non-visible marks, no submission of video files, etc. Therefore, 1999 Act must be amended in such a way that there is room for non-conventional trademarks as well.
- *Harmonisation of the system:* There is inconsistency with regard to the visibility of non-conventional trademarks in the existing legislations, across various jurisdictions, with regard to their definitions,

⁹⁹ Choudhary (n 35).

registration process, remedies for infringement, etc. Due to technological advancements, all the innovating branding strategies are centred around non-conventional trademarks. So, there is a pressing need for a uniformed policy to accept, protect and ease the registration process of non-conventional trademark across various jurisdictions. This would aid in eliminating the stricter criteria adopted by India and take a harmonised approach. Furthermore, WIPO aims to streamline the process of protection and registration of trademarks.¹⁰⁰ If this process is inclusive of non-conventional marks, it would create openness in this subject matter.

- *Acceptance of Video Clips:* In view of motion marks, India should start accepting the submissions for motion mark in the form of video clips. The fact that only graphical representation is the major criteria to assess the registrability of moving images reflects on the regressive approach being taken place in India. To accelerate the process of registering more motion marks, India should place rely on technology and place reliance on digitalisation of registration process.

Conclusion

It can be concluded that the current legal framework for non-conventional trademark is still obsolete. It is essential for the law makers to venture beyond the bounds of conventional form of trademarks and establish a robust jurisprudence for the protection and registration of non-conventional marks in India. Even the countries, from whom we have adopted the trademark law are departing from a narrow and restrictive approach to a more liberal approach by eliminating the requirement of graphical representation and placing more emphasis on digitalisation of the registration process. This would further the underlying purpose of Intellectual Property Law, which is to safeguard innovation, creation, businesses and sustain competition in the market.

¹⁰⁰ Karki (n 32).