

UNCONVENTIONAL TRADEMARKS

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Abstract :

In this increasingly competitive world, there are many businesses upcoming and entrepreneurship is at its peak like never before to gain success in this field businesses need to earn brand recognition and brand loyalty. The first method to gain brand recognition is Brand differentiation and there are various ways to achieve this one of the ways is a differentiated Trademark. Businesses try to formulate a differentiated smell, taste, color, shape, etc, and here comes the importance of unconventional trademarks. Though this is quite a new concept in India but is slowly and gradually gaining importance and even though there is not much legal background available in this domain the importance of this type of trademark can't be ignored. This project attempts to provide basic information regarding all types of unconventional trademarks. This project also focuses on the importance and challenges of unconventional trademarks. This project contains information regarding the evolution of unconventional trademarks and their position in India

Keywords: Unconventional , Trademark, Sound , Smell , Shape

Aims and Objective :

1. This project aims to provide the importance of unconventional trademarks.
2. This project aims to provide information regarding the evolution of unconventional trademarks.
3. This project aims to provide details regarding the status of unconventional trademarks in India .

Hypothesis:

While unconventional trademarks offer exciting branding opportunities, their legal protection remains fragmented and uncertain, requiring strategic approaches and potential legislative reforms to unlock their full potential.

Research Questions :

1. What are the advantages of unconventional trademarks?
2. What are the challenges faced by the unconventional trademarks?
3. How there has been an evolution of unconventional trademarks?
4. What is the position of unconventional trademarks in India?

Research Methodology

Research project type: This project is a "Doctrinal" study on the topic of "UNCONVENTIONAL TRADEMARKS." Doctrinal research involves reading books and other well-known works rather than conducting actual fieldwork.

Research work's source: This project draws on primary (bare acts, statutes, etc.) as well as secondary (books written by various writers, periodicals, the internet, etc.) sources.

Scope And Limitation

SCOPE: This project's extensive scope includes the study of Unconventional trademarks.

LIMITATION: There were infrastructure, labor, and financial limitations for this project, which might have an impact on how quickly and to what degree it was implemented.

Literature Review

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

Rachana Kurup ,Nikita Aksa

This paper on unconventional trademarks by the author gives deep insights into the different types of unconventional trademarks and their conditions of registration. It also discusses the positions of these trademarks in various countries regarding the availability of legislation on them. This paper also contains various sorts of judicial pronouncements regarding different kinds of unconventional trademarks thus giving a clear view of the court's stance on this types of trademarks.

Introduction

Intellectual Property Rights allow people to assert ownership rights on the outcomes of their creativity and innovative activity in the same way that they can own physical property. ¹Intellectual property works are the creation of the mind and the efforts of the owner of that intellectual property work and it is like the property and the assets of the owner of the intellectual property work. A trademark is a tool that is in the form of a mark or symbol that is used for differentiating or distinguishing goods or services from each other.

Trademark is defined in the Trademarks Act of 1999 as “a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others and may include shape of goods, their packaging and combination of colours².”

Trademark has the quality of creating unique goods and services and they act as a medium for creating a unique status of your goods or services till now traditional trademarks such as the logo and brand names are the major trademarks in use but unconventional trademarks are also taking the lead. Unconventional trademarks include sound, smell, taste, etc which are those trademarks that influence the senses and have an intangible attribute.

As the world grew and the economy of the countries expanded it forced the economies all over the world to open their economic boundaries and because of this multinational companies increased worldwide and international trade increased which increased the consumer base for the companies and options for the consumers and thus the need for differentiating the goods and services increased and use of trademarks was strengthened so that the unique status of goods or services can be maintained and this can't be done solely by the conventional trademarks so this increased the role of unconventional trademarks as they were useful in creating a memorable distinctiveness of the goods and services.

¹ Anita Rao and V. Bhanaji Rao, Intellectual Property-A Primer (1st edn, Eastern Book Company, Year) 1.

² Trademarks Act 1999 c 1, s 2(zb)

As the use of unconventional trademarks is growing it is imposing various challenges related to registration, accurate representation, and providing correct distinctiveness and these problems need to be tackled so that the best use of unconventional trademarks can be made.

Types of Unconventional Trademarks

Unconventional trademarks are those trademarks that don't come under the purview of traditional trademarks and don't involve a mark or symbol but include those things that stimulate the senses like smell, shape, color, etc and they are now used to create a distinct status of the goods or service.

The Manual (Draft) of Trademarks Practice and Procedure of the Indian Trademark Registry, 2015 states that unconventional trademarks include the color, shape, sound, packaging, and smell of goods.³

There are various types of unconventional trademarks some are visible which can be seen like colour, shape, motion, etc and some are non-visible which include smell, taste, etc.

Colour

Colour is a type of unconventional trademark that is used to differentiate between goods and services. The main issue lies with using colour as a trademark is that if a single colour is used as a trademark and is made capable of registration then first of all due to the limited availability of colours if a single colour is registered as a trademark for a good or service it will cause disadvantage to other persons and a single colour has a low distinctive value and single colour has a lot of different shades so it will be difficult for the consumers to differentiate between the products.⁴

³ Draft Manual, 2015, Sr. No. 3.2.4 at 143, available at: http://www.ipindia.nic.in/tmr_new/TMR_Manual/TMR_DraftManual_11March2015.pdf

⁴ M M S Kharki, 'Non-Traditional Areas of Intellectual Property Protection: Colour, Sound, Taste, Smell, Shape, Slogan and Trade Dress' (2005) 10 Journal of Intellectual Property Rights 499, 499-506.

As per Indian law, the Trademarks Act 1999 states that only a combination of colours can be registered as a trademark and a single colour cannot be registered as a trademark.⁵ Because the reason behind such a provision is that if single colour is allowed for registration then it will lead to exhaustion in that particular trade and it will give a competitive disadvantage to other players in that trade. Like in the case of **Cadbury**, if the registration of purple colour is allowed then it will lead to the exhaustion of that colour for all the other competitors who are producing chocolates.

Another rule regarding registration of colour involves the “Functional Doctrine” which states that registration will not be allowed for that feature of the product which affects the cost or quality of the product and keeps the other competitors at a disadvantage. This was observed in the case of **Marico Limited vs Mr Mukesh Kumar & Ors.**⁶ In this case, Marico Ltd which is known for their famous brand Parachute Oil sued Mukesh Kumar and Ors for trademark infringement they claimed that the unique colour combination created a distinct image of their brand in their consumer’s minds and this was used by Mukesh Kumar's and Ors for their medicine capsules. The court ruled in favour of Mukesh Kumar and Ors. By applying the Functional Doctrine and holding that the specific colour for which Marico Ltd. Is demanding protection has a functional nature and is used in the pharmaceutical industry and has a technical function hence protection can’t be granted because this will cause disadvantage to competitors and consumers relying on such capsules.

Movement

This is also a unique kind of trademark which evolved as the technology grew and it is also now a way to create a distinctiveness among the goods and services. There are various countries which accept the registration of motion trademarks which include moving pictures, videos, cinematography, video clips of movies and documentaries.⁷ Some real-world examples include the 20th century Fox Movies, Microsoft Windows Logo etc.

⁵ Trademarks Act 1999 c 1, s 2(1)(m)

⁶ Marico Limited v Mr. Mukesh Kumar & Ors. [2018] AIR ONLINE 1322 (Del).

⁷ Archi Bhatia, 'Registration of Motion as Trademark' (2020) iPleaders <https://blog.iplayers.in/motion-mark-as-trademark/> Accessed 9 February 2024.

Indian law is silent about the registration of motion as a Trademark and it has neither excluded nor included the registration but as many countries are now accepting this as a trademark, it can be registered as a trademark if it possesses a distinctive value and is capable of differentiating a goods and services .

Shape

It is also an unconventional trademark and can be used as a trademark as it possesses a distinctive value and many times we can identify a particular goods and services from the shape of the product itself. There are various brands which have registered certain shapes as trademarks like the bottle of Coca-Cola, the shape of Zippo lighters etc.

The Indian Trademarks Act, 1999 states that among other things, a trademark may consist of the shape of goods and their packaging as long as the shape can be graphically represented and clearly separates the items sold under the brand from those of another manufacturer.⁸

Registration of shape will not be possible in the case where the shape mark of the goods is the result of the nature of the goods, is necessary to obtain a technical result and gives a substantial value to the goods.⁹

All these provisions are added in the conditions for registration to protect other competitors because if such shape will be allowed to register which is necessary to obtain a technical result then other competitors will not be allowed to manufacture such goods. For ex. If a sphere shape is granted registration as a trademark for a tennis ball-making company then other tennis ball manufacturers will not be able to manufacture such goods because every tennis ball is of sphere shape and it is a technical part of that product and neither it has a distinctive value which can help the customers to differentiate between the brands.

For registration of shape as a trademark there are basically two criteria , firstly there should not be a functional purpose of the trademark and secondly the trademark should have lost its

⁸ Dr. Mohan Dewan, 'Registering Shapes in India: Guidelines and Processes' (2020) Lexology <https://www.lexology.com/library/detail.aspx?g=94e581ac-5333-4a72-8dfc-111d746af82d> Accessed 9 February 2024.

⁹ Trademarks Act 1999 c 2, s 9(3)

generic nature and has gained a secondary meaning which is making able the customers to identify a particular brand through its trademark.

This was discussed in the case of **M.R.F. Limited v. Metro Tyres Limited, 1990 PTC 101**¹⁰ where the plaintiff sued the defendant for infringing their shape trademark and using the similar tread pattern in their tyres of auto rickshaw. The court ruled in favour of the plaintiff and observed that even though the functional nature of such tread pattern which involves better grip and other functions is outweighed by the non-functional nature of tread pattern which was able to create a distinction and thus by focusing on the distinctiveness and secondary meaning of the shape trademark the court rule in favour of the plaintiff.

Smell

A smell mark is a claim of a person over the smell. Through smell our brain tends to create or remember memories and we then associate with them or try to find out when we smell the scent thus this can act as a trademark for creating a distinct status of the products and through this customers can very well differentiate between the products.

There are three kinds of smell which can be protected through the trademarks law, firstly there is a primary smell mark which is emitted from the product which has the sole purpose of emitting fragrance like perfumes and deodorants, Secondly, there are secondary smell marks which come out from the product which doesn't have the sole purpose of emitting fragrance but still have scents like soap, washing powder etc. and lastly there are unique smell marks which comes out of the product who has no primary or secondary function of emitting smell but still fragrance is added to such products for differentiating them from other products like adding smell to a eraser or shoes etc. The registration of unique smell marks is quite easier than the remaining type of smell marks.¹¹

¹⁰ Mrf Limited v Metro Tyres Limited. [2019] AIRONLINE 972 (Del) / (2019) 262 DLT 734.

¹¹ Comparative Analysis of Olfactory Trademarks in Different Jurisdictions' Kashish World <https://www.kashishworld.com/blog/comparative-analysis-of-olfactory-trademarks-in-different-jurisdictions/> Accessed 11 February 2024

Many countries have accepted the registration of smell marks as trademarks like in the US and UK, Smelling marks can be registered as trademarks Sumimoto, a tire company, registered a smell mark for their tires which carry a rosy fragrance.¹²

However, scent marks are still not authorized to be registered as trademarks in India. The Trademarks Rules, 2017 (hereinafter referred to as the "Rules") specify that "When a sound is used as part of a trademark registration application, a copy of the sound that is no longer than 30 seconds in length and has been recorded on a medium that allows for easy and audible replay is required, along with a graphical representation of the sound's notations." This is the only specific provision under Indian legislation for non-conventional marks.¹³ But this can be used to judge the fact that due to the lack of a graphical representation of the smell the registration of smell marks as trademarks in India is a difficult task. Although the chemical composition of the solution of products can be stated chemical position is said to provide only the substance involved not the smell.

Taste

Taste can also act as an unconventional trademark as many products can have unique taste but the registration of taste as a trademark is a very difficult task because taste is quite a generic term and it is very difficult to differentiate between taste. For example, if in the case of chocolate, any company wants to register a sweet taste as a trademark then it will not be registered because many chocolate-making companies can have the sweet taste of their product and if this is registered as a trademark then other competitors will be at a disadvantage.

There are many countries where trade as a trademark has been recognized and registered like USA, UK, EU, and Canada. In the case of *Eli Lily v. OHIM*¹⁴ where strawberry taste was registered for medicine but it was rejected because there was no distinctiveness and this taste also served the functional purpose of enhancing the taste so this could not be registered.

¹² IPLF - 'Analyzing Smell Trademarks: Laws, Significance, and Issues' (2021) IP and Legal Filings <https://www.ipandlegalfilings.com/analyzing-smell-trademarks-laws-significance-and-issues/> Accessed 11 February 2024.

¹³ Ananya Pandey - 'Recognition of Smell as a Trademark in India' (2023) AMLEGALS <https://amlegals.com/recognition-of-smell-as-a-trademark-in-india/> Accessed 11 February 2024.

¹⁴ *Eli Lily v. OHIM* R 120/2001-2

In UK Benelux Office of Intellectual Property, where the “taste of liquorice” has been registered based on a written description.¹⁵

However, there has never been an attempt to register taste as a trademark in India because, first, taste lacks distinctiveness as a trademark; second, the Trademark Registry's Draft Manuals on Trademark Practice, which discuss unconventional marks like color, shape, and sound, make no mention of a product's taste; third, it is impossible or very difficult to represent taste graphically.

Sound

Sound as a trademark is easy to register as compared to other unconventional trademarks because firstly it carries a distinctiveness with it and people can easily recognise the sound or the musical note with a person or brand and secondly it can be represented graphically by the series of musical notes with or without words and thus because of this nature of sound the registration of a sound mark as the trademark is easy. Some prominent sound marks have been registered like the tune of Nokia which is easily recognisable by the people and by just listening to the tune we can know that the particular product belongs to Nokia. Although sound as a trademark is not particularly mentioned in the Trademarks Act 1999, the Draft Manuals on Trademark Practice used by the Trademark Registry mentions sound as an unconventional Trademark.

¹⁵ Ketan Joshi J.N. Kishore [Taste as an Unconventional Trademark in India] [2023] [Maheshwari & Co. Blog] <https://maheshwariandco.com/2023/01/18/taste-as-an-unconventional-trademark-in-india/> accessed 12 February 2024

Touch

It is extremely difficult to register touch as a trademark since it must have a purpose and not just be a decorative way of packaging goods and services. Touch is also a type of unusual trademark and the least common trademark.

Examples of touch as trademarks are the velvet touch trademark of Khvanchkara wine bottles and the leather-like texture on brandy or grappa packaging.

Evolution of Unconventional Trademark

Earlier trademarks included only the mark, symbol, signs, images, etc and these were used to create a distinct status of products and services but as globalization grew and the branding strategies of companies evolved, new ways of creating a distinct status also evolved and this gave birth to unconventional trademarks and even though the laws and regulations regarding the protection of unconventional trademark is coming into play now but the existence of this trademark has been since 100 years and companies like Coca-Cola has protected their shape of bottles as a trademark since a long time.¹⁶

The US has been an initial player in recognising this mode of trademark and has registered many unconventional trademarks such as the sound trademark in the case of NBC Jingle and Coca-Cola bottle shapes but moving towards the rest of nations the case was not the same and due to lack of legislation the recognition of these trademarks was not available in many nations.

Technology also played a major role in the advancement of these trademarks because due to the advancement of technology, there was the birth of motion pictures, animation, etc which also later became a type of unconventional trademark and there are several examples like the opening animation of Windows was registered as trademark.

¹⁶ Rachna R Kurup , Nimita Aksa Pradeep], 'NON-CONVENTIONAL TRADEMARKS IN INDIA: THE WHAT, THE WHY AND THE HOW' [2020] E-Journal of Academic Innovation and Research in Intellectual Property Assets (E-JAIRIPA) <https://cnlu.ac.in/wp-content/uploads/2022/08/9-Rachna-R-Kurup-and-Nimita-Aksa-Pradeep.pdf> accessed 12 February 2024

A Standing Committee on Trademark Law was created by WIPO. This committee examined a variety of non-traditional trademarks and categorized them into visual and nonvisual categories based on characteristics like color, taste, smell, holograms, and shapes, among other things. Article 15 of the TRIPS agreement also stipulated that signs, logos, symbols, letters, and combinations of colors or signs should all be protected as trademarks due to their unique characteristics that allow them to distinguish themselves from other goods and services.

Position of Unconventional Trademark in India

Section 2(1)(zb) of the Trade Marks Act, 1999 defines a trademark as “A mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others and may include the shape of goods, their packaging and combination of colours” and Section 2(1)(m) defines a mark as “A device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination thereof”.¹⁷ This definition of Trademark does not include and talk about unconventional trademarks.

Unconventional marks including sound, color, and shape are mentioned in the Trademark Registry's Draft Manuals on Trademark Practice. Nevertheless, not all non-traditional trademarks are yet covered.

India has started giving recognition to unconventional trademarks in the case of Yahoo and ICICI, the soundtrack was registered as a trademark and Yahoo's three-note yodel was the first soundtrack trademark to be registered in India, and ICICI Corporate Jingle was the first soundtrack to be registered as a trademark by an Indian Entity.

¹⁷ Supra note 2

Regarding colors, Sections 2(1)(m), 2(1)(zb), and 10(1) of the Trade Marks Act, 1999 provide provisions for registering colors as trademarks in India, such as combinations of colors. A court has a great deal of latitude when it comes to registering colors, even if a single color is not specified in the statute since it lacks uniqueness and combinations of colors are permitted. The Delhi High Court ruled in favor of Colgate Palmolive Co. v. Anchor Health and Beauty Care Pvt.Ltd in 2003¹⁸, prohibiting the defendant from using the red and white color for their product. However, the court later took a different stance in Cipla Ltd. v. MKI Pharmaceuticals¹⁹, ruling in favor of the defendant and declaring that there cannot be a monopoly over color.

The shape also finds its position in the legislation in the Shape of goods receives recognition as a trademark under Sections 2(1)(m) and 2(1)(zb) of the trade Marks Act, 1999 and it can be registered as a trademark in India.

Various unconventional trademark are not recognised and are not able to be registered in India because of the requirements by the Indian law firstly the capacity to be graphically represented and even though Yahoo was granted registration of sound mark as their trademark it has submitted it musical notes and then when it was successfully represented then it was allowed registration but various unconventional trademarks like the smell , taste are unable to be graphically represented thus they are not registered in India . Secondly the possession of distinctiveness is a compulsory criteria for registration of trademark in India and many unconventional trademark does not possess distinctiveness like taste and single colour thus they are not represented.

While the Indian system's decision to deny olfactory and gustatory marks trademark-ability status is based on current practical obstacles, it has undoubtedly learned a lot from the experiences of the European Union and the United States. However, given the rapid advancements in technology and the expanding commercial and advertising trends, this decision may be subject to change.²⁰

¹⁸ *Colgate Palmolive Co. v. Anchor Health and Beauty Care Pvt. Ltd.*, [2003][DLT] [51]

¹⁹ *Cipla Ltd. v. MKI Pharmaceuticals*, [2007][36][PTC][166][De]

²⁰ Harsimran Kalra ' Unconventional trademarks: the emergent need for a change ' [IndiaLawJournal]https://www.indialawjournal.org/archives/volume4/issue_1/article_by_harsimran.htm | accessed 12 February 2024

Importance and Challenges

Unconventional trademarks have been of a lot importance because of the growing techniques of branding and companies using these trademarks are capable of standing out of the other competitors in the market and in the era of traditional trademarks like signs, logos, images, captions etc , the use of unconventional trademarks such as colour, shapes, smell etc help the businesses to stand out of the competition and gain an edge. Companies like Coca Cola who own the shape trademark of their bottle, Nokia who own the sound trademark of their jingle are successful in standing out of their competition and are easily recognisable by their customers.

Unlike the traditional trademark, the unconventional trademark is successful in establishing an emotional connection with people because it stimulates sensory organs like smell involves the nose and taste involves the tongue. Businesses use this unconventional trademark to make their customers remember their products easily .

These unconventional trademarks also help to create a unique brand element which are crucial for product marketing like in the case of MRF Tyres the tread pattern over their tyre was protected by the court and thus it protected its brand element.

But apart from these unconventional trademarks also face various sorts of challenges. In various nations still, there are not proper legislations for the registration of these trademarks and because of this they are not properly recognised adding there is a complex system of registration of trademarks in various nations which are not passed by the unconventional trademarks like taking the example of India the requirement of Distinctiveness and graphical representation is not passed by many unconventional trademarks like smell and taste because of which also they are unable to be registered here. So the main drawbacks like the distinctiveness or the proper mechanism of proving the distinctiveness is lacking in the unconventional trademarks because of which it is not gaining much importance in the realm of trademarks.

Conclusion

Trademarks have always been used to create a distinct status of the products and status and from past times there was the use of traditional trademarks like marks, symbols, images, captions etc later on as technology grew and the economy grew more and more branding strategies increased which gave birth to the Unconventional trademark. It includes various sortsof trademarks like smell, colour, taste, shape etc and many nations have recognised this type of trademark and registered this type of trademark still due to lack of proper legislation in India there is no such scope of this trademark in India and the various requirements by the Indian legislature for registration of trademark make this trademark unable to be registered and due to its drawbacks also it is not widely recognised.

After going through the position of Unconventional trademarks in various jurisdictions it can be suggested that there is a requirement of a uniform policy for registration and recognition of unconventional trademarks so that there can be ease to register this type of trademark in various jurisdictions and India should especially strengthen its legislation and increase its scope to let the unconventional trademark enter the realm of the trademark.

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