

**NON-CONVENTIONAL TRADEMARK WITH SPECIAL REFERENCE
TO INDIA AND U.S.A- AN ANALYSIS**



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SUPERVISOR CERTIFICATE

It is to certify that Ms. Rituparna Sarmah is pursuing Master of Laws (L.L.M) from National Law University, Assam and has completed her dissertation titled "NON-CONVENTIONAL TRADEMARK WITH SPECIAL REFFERNCE TO INDIA AND U.S.A - AN ANALYSIS" under my supervision. The research work is found to be original and suitable for submission.

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DECLARATION

I, Rituparna Sarmah, pursuing Master of Laws (LL.M.) from National Law University, Assam, do hereby declare that the present dissertation titled "NON-CONVENTIONAL TRADEMARK WITH SPECIAL REFFERNCE TO INDIA AND U.S.A - AN ANALYSIS" is an original research work and has not submitted, either in part or full anywhere else for any purpose, academic or otherwise , to the best of my knowledge.

Date:

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PREFACE

The scope of Trademarks in the present environment of trade is to a great extent broadened by the globalisation, changing trends of business and marketing strategy. Traditionally, a trademark only consists of a symbol, logo, name etc. or combination of these elements. But now in the present world, trademark cross the boundaries of these traditional trademarks and no longer limited to these symbol, words and devices. Now a consumer wants to buy a product by getting attracted to a particular colour, trade dress or appearance, smell, taste of a particular product and identify the product by these elements. It seems like we are discussing about some other things and not trademarks. But no; we are discussing about the "Non-Conventional Trademarks" or the "sense based trademarks or modern marks" which are not included in the traditional forms of marks and which aims to attract customers by its aesthetic quality or eye appealing appearances or by a pleasant aroma and can identifiable by using the five senses of human being as a source indicator of the product. Now we can identify the Cadbury chocolate by its beautiful purple colour wrapper, identify the service of yahoo by its memorable three note yodel of yahoo or associate the famous 4 note sound with Britannia biscuit or the eye-catching way of opening the door with the Lamborghini car.

With the emergence of competitive market the manufactures and business entities are constantly working toward incorporating these non-conventional trademarks not merely as a source indicator but also to attract more customers; thereby making a strong consumers base and a significant reputation of its goods and services in the market.

But the journey of recognition and protection of these non-conventional trademarks are not as smooth as its traditional counterparts. In this paper the researcher will analyse the position, recognition, registration issues of these non- conventional trademark in the light of the laws of U.S.A and India and will also deal with the issue of overreaching the scope of trademark law and other important issues with regard to it.

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Table of Cases

1. *A. Leshen & sons Rope Co. v. Broderick & Bascom Rope Co.*
2. *AstraZeneca v. Dr. Reddy*
3. *Cadbury India limited and others v. Neeraj Food products*
4. *Campbell Soup Co. v. Armour & Co.*
5. *Christian Louboutin Sas v. Nakul Bajaj*
6. *Cluett Peabody & Co. Inc v. Arrow Apparals*
7. *Colgate Palmolive Company v. Anchor Health and Beauty care pvt ltd.*
8. *Dap Products, Inc. v. Color Tile Mfg.*
9. *Deere and Co. and Ors. v. S. Harcharan Singh and Ors*
10. *Ferro Spa & Nr. v. M/S Ruchi International & Anr*
11. *Gibson Guitar Corp v. Paul Reed Smith Guitars*
12. *Gorbatschow Wodka KG V. John Distilleries Ltd.*
13. *Imperial Tobacco v. registrar, Trademarks*
14. *In ITC Ltd. v. Britannia Industries Ltd.*
15. *In Re Celia Clarke.*
16. *In re Florists Transworld Delicery*
17. *In re Pohl-Boskamp GmbH & Co*
18. *In re Remington Products Inc.*
19. *In reVertex Grp.*
20. *In William Grant & sons ltd v. Mc Dowell &Co ltd*
21. *Inwood Laboratories, Inc. v. Ives Laboratories, Inc*
22. *Kawasaki Motors Corp USA v. Harley Davidson Michigan Inc.*
23. *M/s Castrol Limited & Anr. vs. Iqbal Singh Chawla & Anr*
24. *Master Distributions Inc. v. Pako Corpn.*
25. *In re N.V. Organon.*
26. *Qualitex Co v. Jacobson Products Co.*
27. *Ramdev Food Products (P) Ltd. v. Arvindhbai Rambhai Patel*
28. *Siekmann v. Deutsches Patent-und Markenamt*
29. *TraFFix Devices, Inc. v. Mktg. Displays, Inc.*
30. *Two Pesos Inc. v. Taco cabana Inc.*
31. *V.K. Industries v. H. Mehta*
32. *Wal-Mart Stores Inc v Samara Bros Inc.*

33. *Zippo Manufacturing Company v. Anil Moolchandani and Ors.*

Table of Statutes

1266-Bakers Marking Law.

1862-The Merchandise Marks Act

1875-The Trademark Registration Act

1870-Federal Trademark Act

1877-Specific Relief Act

1889-Indian Merchandise Marks Act

1908-The Registration Act

1940-The Lanham Act

1940-The Trade Mark Act

1958-Trade and Merchandise Marks Act

1999-The Trademark Act

Table of Abbreviations

AIR	All India Reporter
APEC	Asia-Pacific Economic Cooperation
CGPDTM	Controller General Of Patent, Designs and Trademark
E.U	European Union
GATS	General Agreement on Trade in Services
INTA	International Trademark Association
IPR	Intellectual property Law
MoU	Memorandum of Understanding
PTC	Patent and Trademark Case
TMEP	Trademark Manual of Examining Procedure
TRIPS	Trade Related Aspects of Intellectual Property Rights
TTAB	Trademark Trial and Appellate Board
U.K	United Kingdom
U.S	United States
USPTO	United States Patent and Trademark Office
WIPO	World Intellectual Property Organisation
WTO	World Trade Organisation

Table of Contents

Certificate

Declaration

Preface.....*i*

Acknowledgement.....*ii*

Table of Cases.....*iii*

Table of Statues.....*iv*

Table of Abbreviations.....*v*

CHAPTER I

INTRODUCTION

1.1 Research Background.....1

1.2 Statement of Problem.....2

1.3 Aim of the Research.....2

1.4 Objectives of the Research3

1.5 Scope and Limitation of the Research.....3

1.6 Literature Review.....3-8

1.7 Research Questions.....8

1.8 Research Hypotheses.....9

1.9 Research Methodology.....9

1.10 Research Design.....9

CHAPTER II

AN OVERVIEW OF TRADEMARK LAW

2.1 Introduction.....11

2.2 Conceptual Understanding of Trademark-Its Meaning and Definition.....	12
2.3 Function of a Trademark	13
2.4 Characteristics of a Trademark.....	14
2.5 Forms of Trademark.....	14
2.6 Objective of Trademark Law.....	16
2.7 Economic Significance of Trademark.....	16
2.8 International Convention and Agreements on Trademark.....	18
2.8.1 Paris Convention for the Protection of Industrial Property.....	19
2.8.2 TRIPS Agreement and WTO.....	19
2.8.3 Madrid agreement on the International Registration of Marks and Protocol Relating to Madrid Agreement	20
2.9 Conclusion.....	20

CHAPTER III

UNDERSTANDING NON-CONVENTIONAL TRADEMARK

3.1 Introduction.....	22
3.2 Concept of Non-Conventional Trademark.....	22
3.3 History of Non-Conventional Trademark.....	23
3.3 Rationale for protection of Non-Conventional Trademark.....	25
3.4 Kinds of Non-Conventional Trademark.....	26
3.4.1 Visible Non-Conventional Trademark.....	26
3.4.1.1 Colour Mark.....	27
3.4.1.2 Motion Mark.....	29
3.4.1.3 Hologram Mark.....	30

3.4.1.4 Three-dimensional Mark.....	30
3.4.1.5 Shape and Appearance.....	31
3.4.2 Non-Visible Non-Conventional Trademark.....	33
3.4.2.1 Sound Mark.....	33
3.4.2.2 Smell Mark.....	34
3.4.2.3 Taste Mark.....	34
3.4.2.4 Touch Mark.....	34
3.6 International Framework on Non-Conventional Trademark.....	35
3.7 Conclusion	37

CHAPTER IV

INDIAN POSITION WITH REGARD TO NON-CONVENTIONAL TRADEMARK

4.1 Introduction.....	39
4.2 Concept and Protection of Trademark under the Trademark Act, 1999.....	40
4.2.1 Definition and Scope of Trademark.....	40
4.3 Non-Conventional Trademark in India-An Overview.....	40
4.4 Recent Growth in India Concerning Non-Conventional Trademark.....	41
4.5 Judicial Approach in Case of Non-Conventional Trademark.....	44
4.6 Procedural Requirement and Difficulty in Registering Non-Conventional Trademarks in India.....	44
4.6.1 Criteria of Distinctiveness.....	45

4.6.1.1 Types of Distinctiveness.....	45
4.6.2 Graphical representation.....	46
4.7 Status of Non -Conventional Trademarks in India.....	47
4.7.1 Colour Mark.....	47
4.7.2 Sound Mark.....	49
4.7.3 Shape and Trade Dress.....	50
3.7.4 Three-dimensional Marks and Moving Image Mark.....	52
3.7.5 Smell Mark.....	52
3.7.6 Taste Mark and Touch Mark.....	54
3.7.7 Image Mark.....	54
3.8 Conclusion.....	54

CHAPTER V

UNITED STATES APPROACH TO NON-CONVENTIOANL TRADEMARK

5.1 Introduction.....	57
5.2 The Concept of Trademark Under the Lanham Act, 1940.....	58
5.3 Non-Conventional Trademark in the U.S.A -An Overview.....	60
5.3.1Requirements for Registration of a Non-Conventional Trademark.....	60
5.3.1.1 Representation of Non-Conventional Trademark.....	61
5.3.1.1 The Distinctiveness criterion.....	61
5.3.1.2 The Functionality Doctrine.....	62
5.4 Present Status of Various Non-Conventional Trademarks In the U.S.A.....	64

5.4.1 Colour Mark.....	64
5.4.2 Sound Mark.....	66
5.4.3 Scent Mark.....	66
5.4.4 Shape Mark.....	68
5.4.5 Motion Mark or Moving image Mark.....	67
5.4.6 Taste Mark.....	70
5.4.7 Hologram Mark.....	70
5.4.8 Texture Mark.....	71
5.5 Conclusion.....	72

CHAPTER VI

COMPARATIVE ANALYSIS BETWEEN INDIA AND U.S.A.

6.1 Introduction.....	73
6.2 Analysis on the Basis of Scope of Non-Conventional Trademarks.....	73
6.3 Analysis on the Basis of Judicial Approach.....	74
6.3 Analysis on the Procedural Requirement.....	75
6.3. Graphical Representation.....	75
6.3.2 Distinctiveness.....	76
6.3.3 Doctrine of Functionality.....	76
6.4 The "Anything Goes Doctrine".....	77
6.5 Analysis on the Basis of Present Status of Non-Conventional Trademarks in Both the Countries.....	77
6.6. Conclusion.....	78

CHAPTER VII

CONCLUSION AND SUGGESTION

7.1 Research Findings..... 80

7.2 Suggestion.....85

BIBLIOGRAPHY.....93

CHAPTER-I

INTRODUCTION

1.1 RESEARCH BACKGROUND:

"The talent for discovering the unique and marketable characteristics of a product and service is the most valuable asset of a trademark"–

Primo Angeli

Intellectual property refers to the creation of one's own mind and the result of human intellect: which include the invention, literacy, music and artistic works, symbols, names, images used in commerce.¹ People apply their creativity, skill, and labour and dedicated their time and an enormous amount of money to create it. As a reward of their endeavour; law relating to Intellectual Property recognize and protect this "fruit of one's own labour" from getting misappropriated. Various forms of intellectual property such as Patent, Trademark, Geographical Indication, Copyright deals with different kinds of intellectual property by giving an exclusive right to the owner of the creation to use and exclude others from using it without the consent of the owner.

One of the important forms of Intellectual property is the trademark; which is associated with the fields of economics, trade, and business. From the ancient times, a trademark has been used to identify various goods and services coming from a particular source; and the form of the trademark has always been some word, symbol, a combination of colour, or what we generally called as a "mark". But with the growth of trade and technology around the world, the creative minds of the human being also approached the concept of the trademark in a different way to cope up with the changing trends of business and marketing. Now in order to build a strong consumer base; business entities began to use some sense appealable marks such as some moving image, sound, scent, some pleasant flavour, a touch as a trademark for their goods and services. In the legal parlance, these marks are termed as "non-conventional trademarks" or as the WIPO refers it "Non-Traditional trademark² or 'new types of marks'.

These kinds of trademark are regarded as non conventional or non traditional; because these marks are not traditionally used as a trademark until the recent times in the course of business; and represent a novel concept of mark. Also because they have some serious issues with regard to their registration, their capability as functioning as a

¹ WIPO Document, "What is Intellectual Property?"

http://www.wipo.int/edocs/pubdocs/en/intproperty/450/wipo_pub_450.pdf, (June 21, 2018).

² see WIPO Document, "Smell, Sound and Taste-Getting a sense of Non-Traditional Marks"
,http://www.wipo.int/wipo_magazine/en/2009/01/article_0003.html (June 21, 2018).

trademark and the effect on the available forms of marks or encroaching upon the other forms of intellectual property or creating a monopolistic tendency in the market.

This research work on the subject '*Non-Conventional Trademark with Special reference to U.S.A and India-An Analysis*' is of immense importance in the present era in the view of the recognition and protection of these non-conventional trademarks. In the recent ten years, various studies have been done in defence of these non-conventional trademarks, analyzing their importance, capability and various mode of representation in order to protect these kinds of trademark.

In the present study, the researcher has focuses on resolving the impediment of the graphical representation of non-conventional trademark and in finding an alternative method to it. The present study is an endeavour to analyze the non-conventional trademark in context of United States of America and India, their impact on the economy and the business world. An endeavour is also made to suggest some alternative method of representation for non-conventional trademarks in India in lights of the United States; so as to facilitate the smooth registration process of non-conventional trademark.

1.2 STATEMENT OF PROBLEM:

The researcher has identified the following problems pertaining to the research:

- According to the conservative school of thought, non-conventional trademarks or sense based trademarks cannot perform the function of a trademark as its traditional counterparts as a consumer cannot readily recognize these marks as a source indicator.
- Non-conventional trademarks are often difficult to protect due to the issue of distinctiveness and graphical representation.
- Expanding the scope of a trademark may have the potential to encroach upon the other forms of Intellectual property or the depletion of available resources to be used by the competitors in the market.

1.3 RESEARCH AIMS:

After identifying the research problem, the aims of this research work are drawn from the review of literature and selection of methodology. The aim of this research is to study the scope of protection of non-conventional trademarks and to analyze the future possible growth of in the field of non-conventional trademarks.

1.4 RESEARCH OBJECTIVES:

The main objectives of the research are as follows:

- To analyze the conventional function performed by a non-conventional trademark.
- To study the nuances of registration and difficulty in registration for non-conventional trademarks.
- To analyze the issue of distinctiveness and graphical representation of non-conventional trademark.
- To comparatively study the status of various existing non-conventional trademark in U.S.A and India.

1.5 SCOPE AND LIMITATION:

The Scope of the research is confined to the general understanding of non-conventional trademark, their scope of protection and the issues regarding it. The scope of the research is limited only to the law regarding non conventional trademark in the U.S.A. and India. Due to certain limitation as to time and money; the researcher has made the best efforts to utilise the available resources to find out the relevant information by using doctrinal method so that the necessary information and real problem regarding non conventional trademark can be identified.

1.6 DETAILED LITERATURE REVIEW:

A detailed literature review is a primary step for a research in any field. It serves an important purpose and is extremely needful for a well-designed research paper. It helps the researcher to identify the area where the researcher going to focus and helps in formulating the research question and to collect the source of data. The present literature review is done for the purpose of identifying present awareness of non-conventional trademark and identifies the gaps in the concerned field.

Books:

(i)Dr. V.K Ahuja, "Law Relating to Intellectual Property Rights":

This book deals with the conceptual discussion of intellectual property law, starting with the origin and development of intellectual property law. Apart from the other forms of intellectual property; this book very comprehensively discuss the origin of Indian trademark

law, The object behind it, the forms of a trademark under the Indian Trademark Act, registration procedure and remedies under the Indian Trademark Act. With regard to the non-conventional trademark, this book only deals with the basics of these trademarks with the example of various countries and discuss the method of representing it, as mentioned in the WIPO Handbook on Intellectual property Law. From this Book, The researcher got the basic idea of trademark regime in India and some forms of non-conventional trademarks.

(ii) P. Narayanan, "Law of Trademark and Passing Off": This is a significant book with regard to trademark and passing off in India. This book in depth deals with the Intellectual property regime in India apart from beautifully discussing the trademark evolution and jurisprudence. The requirement and importance of graphical representation, the distinctiveness criterion required for registration of a trademark in India are very elaborately discussed in the book. From this book, the researcher gets the clear understanding of this most crucial issue of the non-conventional trademark in India. But it is pertinent to note that this book does not deal with graphical representation and distinctiveness criterion from the viewpoint of the non-conventional trademark. Non-conventional trademark has not got many pages dedicated in the book. But the book in-depth analysis the base of trademark law on which non-conventional trademark stands.

(iii) Lionel Bentley (ed.), "Trademark and Brands- an Interdisciplinary Critique": This book is the compilation of various articles which deals with the very important base of non-conventional trademark, i.e. the relation between economics and Trademark Law. Various articles in this book very widely discuss the economic importance of a trademark, the relation between trademark and branding, the importance of branding and how brand or trademark plays an important role in the minds of the customers and emotionally connect a customer towards a particular good or services. This book also discusses that what sort of marketing strategy should be adopt to attract a consumer. From this book, the researcher could get the understanding of the most important rationale for protecting a non-conventional trademark and able to analyze the need of economic perspective for the growth of trademark; particularly non-conventional trademark in India.

(iv) J.P Mishra," An Introduction to Intellectual Property": This book deals with the comprehensive understanding of basics of a trademark. From this book, the researcher got the understanding of objective and characteristic and various forms of non-conventional

trademark. Most importantly this book very beautifully discusses the International framework related to trademark. From this book the researcher got a clear perspective of protection of trademark in the important International forum such as TRIPS, Madrid agreement and protocol relating to it, Paris convention which is equally important from the viewpoint of non conventional trademark. From this book researcher was able to analyze the scope of non conventional trademark under the definition given by the these international convention and the scope of registration of these trademark under the International framework.

(v) K.C Kailasam, "Venkateswaran on Law of Trademarks and Passing off" This book very descriptively deals with the trademark regime in India with the help of various judicial pronouncement and discuss the regime of the trademark from the judicial point of view apart from giving a clear comment on each provision of trademark act 1999. From this book, the researcher gets a clear perspective of the judicial approach with regard to non-conventional trademark. This book deals with the sound, smell, colour mark especially from the perspective of U.K. The Indian stand with regard to these marks is not clear from this book.

(vi) Mary LaFrance, "Understanding Trademark Law": Apart from dealing with the nature and protection of trademark and the detailed discussion on the subject matter of trademark, this book basically deals with the trademark law from the United States perspective; which is one of the edifices of the present research paper. The book very elaborately discusses the history of Trademark Law in the U.S.A., enactment of the Lanham Act and trademark law regime in the U.S.A under the Lanham Act. The book analyzes the prime requirement of registering a trademark in the U.S.A i.e. the doctrine of functionality and the detailed discussion on distinctiveness. Along with the distinctiveness criterion, the functionality doctrine is of immense importance in the granting registration to non-conventional trademark, because these non-conventional trademarks are more prone to be functional. So it is very important to get a clear understanding of this doctrine. This book enabled the researcher in filling that gap.

Journals:

(i) Vatsala Sahay, "Conventionalizing Non-Conventional Trademarks of Sounds and Scents: A Cross Jurisdictional Study": This article deals with the three specific non-conventional trademark- the sound, scent and shape mark in a comparative manner among the United States, European Union and India and maintained a defensive position for these

marks. From the article, the researcher gets a clear picture of non-conventional trade mark jurisprudence in these three countries and how they deal with the protection of these marks. After analyzing the position in these three countries; the author concluded that compared to EU and India; U.S.A has a liberal approach towards the non-conventional trademarks and EU has maintained a cautious approach to non-conventional trademark. It further concluded that from the Draft manual of trademark practice and procedure in India, 2015 it is evident that India has simply imitated the EU position of non-conventional trademarks. **The author also vehemently opposes the contention that non-conventional trademarks are placing an unnecessary restriction on the available intellectual property.** This article helps the researcher to main a defensive position for the non-conventional trademark in arguing in favor of them. But the gap lies in the issues of functionality in considering non-conventional trademarks.

(ii) Neha Mishra, "Registration of Non -Traditional Trademarks": This article deals with the most important issue of non-conventional trademark, i.e. the registration of these marks. The paper deals with the registration of sound, color, shape, smell and taste mark across the jurisdiction of United States, European Union, United Kingdom and India in the light of landmark cases with regard to it. The author discussed the issue that whether non-conventional trademarks are able to register or not and concluded in a more or less negative manner, but recognized that by the adequate scientific measures, these impediments can be removed. From this article, the researcher gets a clear aspect of the registration issues faced by the non-conventional trademark and in analyzing and finding whether some alternative method can replace the impediments in the registration process for non-conventional trademarks.

(iii) Kritarth Pandey and Virendra Singh Thakur, "Non-Conventional Trademark-A Legal Analysis":

This article deals with the basic understanding of non-conventional trademark in lights of TRIPS agreement and discusses the sound mark, scent mark, sound mark, hologram mark and moving image mark and their registration in the U.S.A, India and in EU. This article critically analyzes the requirement of graphical representation in India and considers it as an impediment to the non-conventional trademark in the light of U.S.A laws and TRIPS Agreement. This article helped the researcher in analyzing the requirement of graphical representation and in arriving at the conclusion that whether the graphical representation is

actually an impediment for non-conventional trademarks and if it is; then whether any other method is available in representing these marks for registration in India.

(iv) Arka Majumder, Subhojit Sandhu, and Sunandan Sarkar,"The Requirement of Graphical Representability for Non-conventional Trademarks": This article broadly discusses the meaning and understanding of graphical representation and the importance of it. This article also addresses an important issue of graphical representation of smell mark and also suggested a mechanism similar to Pantone colour code for smell marks in order to differentiate it. This article deals with the requirement of these mark in India from the viewpoint of trademark manual and very briefly discuss the possibility of registering these marks in India by a positive conclusion. This article helped the researcher in analyzing the issue of graphical representation India and what are the possibilities in India for the protection of non-conventional trademark from the viewpoint of registration.

(v) Madhu Rewari," Redefining Brand Identity in India": This article published in the INTA Bulletin very beautifully presented the position of non conventional trademark in India in a comprehensive manner. This article presented the picture of Indian trademark regime with regard to non-conventional trademark and the judicial approach towards these trademarks in India. The articles do not address the issues regarding non-conventional trademark in India. But presented a clear picture of recognized in conventional trademark by Indian Judiciary and registered non conventional trademark in the Trademark registry in India. This article helped the researcher a certain extent in analyzing the growth of non-conventional trademark in India.

(vii)Lisa P. Lukose, "Non-Conventional Trademarks: A Critique": This article deals with the origin and history of non-conventional trademark and the present scenario of non-conventional trademark around the globe. The author describes the various forms of non-conventional trademarks such as smell, taste, sound, tactile mark by referring to the WIPO WCT committee and also discusses the issue of registering these marks with the help of relevant case laws from U.S.A and E.U. From this article the researcher gets a clear picture with regard to history and evolution of non-conventional trademark with the numerous examples from around the globe.

(viii) Dev Gangjee, "Non-Conventional Trademarks in India:"

This is a significant article analyzing non-conventional trademark in India specifically in the color and shape mark in the light of the Draft Manual of Trademark, 2015. The author comparatively analyzes the Draft Manual in comparison to other jurisdiction such as Europe and U.S.A. It analyzes the functional requirement of a non-conventional trademark in light of U.S.A. and suggests the similar kind of treatment for all non-conventional trademarks in India in the interest of competitiveness in the market. This article also touched a very important issue with regard to non conventional trademark; that whether by granting protection to it; we are pushing the boundaries of trademark law and whether it amounts to overlapping or depletion of other available forms of intellectual property. From the article, the researcher able to get an idea of the future of non-conventional trademark in India according to the draft manual and also able to analyzes the overreaching character of non-conventional trademark to the other forms of Intellectual property.

(ix) Nikhil Kashyap and Priyanka Ghai, "Non-Traditional Trademarks: An Unprotected Arena": This article deals with the protection of the non-conventional trademark in the international level as well in India. The article descriptively deals with the meaning, definition, and growth of trademark in light of U.S.A, E.U and Indian Law. But the author raises the issue of lack of harmonization in laws dealing with the non-conventional trademark around the world and argued for a harmonizing mechanism to effectively deal with non-conventional trademark across the globe. The article helped the researcher in understanding the importance of these trademarks at the international level and how the conflicting laws of the countries affect the recognition and protection of it.

1.5 RESEARCH QUESTIONS:

After a detailed literature review of the existing literature on the non-conventional trademarks and studying the gaps, the researcher has framed the following research questions:

1. Whether the non-conventional trademarks are capable of performing the function of a traditional trademark?
2. Whether non-conventional trademarks are distinctive and can be graphically represented? And whether graphical representation requirement can be replaced by any other alternative method?

3. Whether non-conventional trademark encroach upon the other available form of Intellectual property and the depletion of available resources to be used by the competitors in the market?

1.5 RESEARCH HYPOTHESES:

- Non- conventional trademarks are capable of performing the function of a trademark in the same way as its traditional counterparts.
- The impediment of graphical representation can be resolved by other alternative methods.

1.7 RESEARCH METHODOLOGY:

Research methodology adopted in this topic is the doctrinal method in which the researcher focused on the primary and secondary source of data. In the primary source of data the researcher refers to the legislative material i.e. Central acts, case law research of Supreme Court and High Courts and secondary source available in the legal databases (Manupatra, Sconline, Hein Online, Jstor, Westlaw), law reviews of National Law University, Assam. Further, in order to enhance this research project, the researcher has used the analytical approach where a few comparative studies are also made in light of U.S.A and India.

1.8 RESEARCH DESIGN:

In the light of the objective and research question formulated by the researcher, the study has been classified in the following chapters for convenience and systematic study.

- The **first chapter titled 'Introduction'** deals with the background of the research, the basic understanding of Non-conventional trademark and why it is seeking attention towards it. This chapter lays the foundation of the dissertation by pointing out the aims and objective of the research, the issues with regard to the non-conventional trademark and Research questions, the hypotheses formulated and a detailed literature review.
- The **second chapter titled 'An Overview of Trademark'** deals with the basic concept of trademark, its function and importance in trade and commerce as it is the base for understanding Non-conventional trademark, Apart from this, the chapter deals with the object of Trademark Law and International framework with regard to Trademark.

- The **third chapter titled 'Understanding Non-Conventional Trademark'** deals with the changing trends of trademark jurisprudence by understanding the basic concept of non-conventional trademark and its history and why this modern day mark is desirable in modern trends of business in the globalized world. This chapter elaborately deals with the kinds of non-conventional trademark and its desirability and International framework with regard to the protection of these non-conventional trademarks.
- The **fourth chapter titled 'Indian Position with regard to Non-Conventional Trademark'** deals with the history and evolution of Indian Trademark Law and how the Indian trademark Law regime incorporated unconventional trademark. This chapter further deals with what is the possibility of non-conventional trademark registration in India and its position in protecting the non-visible form of non-conventional trademark and procedural difficulties in the way of these trademarks.
- **The fifth chapter titled' US approach to non-conventional trademark'** deals with the evolution of non-conventional trademark in U.S.A. and the procedural formalities and difficulties in registering the non-conventional trademark in the U.S.A. This chapter further deals with the status of various non-conventional trademarks in the U.S.A with the help of relevant case Laws.
- **The sixth chapter titled "Comparative analysis between U.S.A and India"** deals with the comparative study of the U.S.A and India in its approach towards protecting the non-conventional trademark and its similarity and differences in the scope of protection of these marks and the procedural requirement along with the present status of the non-conventional trademark in these two countries.
- **The seventh chapter titled' Conclusion and Recommendation'** deals with some growing concern of non-conventional trademark and issues with regard to it which has been facing criticism. Further, this chapter deals with the suggestion with regard to filling the gap in the Indian trademark regime with regard to registration of non-conventional trademark, possible changes that can be brought in the Indian trademark law.

CHAPTER II

AN OVERVIEW OF TRADEMARK LAW

2.1 Introduction:

The concept of trademark is not a novel one. The idea of trademark is as old as human civilization. In the ancient times; people used marks in the branding of livestock depicted in the Stone Age cave paintings and to identify personal property to prevent the theft. It is considered as the first use of marks.³ With the development of human civilisation; the use of trademark can be traced back to the Romans and Greek civilisations. At that time, people used to produce clay pots and marked them with "x" or "*" mark. With the passes of time; these marks were replaced by names of the potter, monarch or region. But along with it, the practice of deception also started and similar kinds of inferior quality pots made in the name of some well known pot makers were found. As an evidence of these deceptions, these Roman potteries with imitated marks upon are now preserved in the British Museum. However in spite of the practice of imitation, there was no mechanism to prevent it. Then in the 10th century, there was a practice of using "trader's marks with illustrative descriptions" for the protection of piracy.

Thereafter the concept of trademark took a new dimension in 2nd Millennium AD when the Kings and Emperors used these marks to identify their bravery and services rendered by them. From this practice the individuals and the families involved in particular manufacturing or trade got the desire to use a particular mark to differentiate their goods and services; thus the practice of trademark was also evolved.

In the end of 14th century one new type of mark 'producers or guild marks' was applied in Western Europe, which was used to indicate the trade association to which the craftsman belongs to. But Trademark as an asset of commercial development was realized only in the 19th century.⁴

³WIPO Magazine, "Trademarks Past or Present", http://www.wipo.int/wipo_magazine/en/2005/02/article_0003.html (May 17,2018).

⁴ see WIPO Document, " Trademark Basics",http://www.wipo.int/edocs/mdocs/sme/en/wipo_smes_hyd_07/wipo_smes_hyd_07_www_91793.pdf (May 15,2018).

Evolution of Trademark Law:

The Law of Trademark was not an outcome of any revolution; rather it evolved from the common Law of fraud and law of unfair competition. So to protect the rights of original manufactures, need of a trademark law was felt.⁵ The first and earliest trademark legislation was the 'Bakers Marking Law, 1266' which was enacted by British parliament making obligatory for every baker to put a particular type of mark on the bread he used to baked.⁶ After that, 'The Merchandise Marks Act, 1862'; a criminal statute was enacted to deal with the falsely marking goods and forge trademark. Simultaneously with the law of protecting the trademark, a need was also felt for a law to govern the registration of trademark. So as an outcome; the first legislation for registration of trademark 'The Trademark Registration Act, 1875' was passed in England.⁷ In the international level, Paris Convention for protection of Industrial property was the first international step towards trademark adopted in 1883.⁸

2.2 Conceptual Understanding of Trademark:

Whenever we see a mark on a particular product which is a golden arch "m"; the first thing that comes to our mind is that; the product is coming from the famous franchise McDonald's, likewise when we see a white colour 'f' written in a blue background our mind will automatically connect it to the famous social media site face book.

Thus, a trademark can be defined as a symbol in the form of a word, a device, or a label applied to articles of commerce or services with a view to indicate the purchasing public that the goods or services are coming from a particular source so as to distinguished them from similar goods manufactured or dealt in by another entity; thereby prevent consumer confusion. The word trademark is often equated or popularly known as "brand name."⁹

According to WIPO¹⁰ a " Trademark can be defined as a sign or combination of signs which has the capability of distinguishing the goods and services of one enterprise from that of

⁵ *Ibid.*

⁶ *supra*, note 3.

⁷ *supra*, note 4.

⁸ Dr. V.K Ahuja, LAW RELATING TO INTELLECTUAL PROPERTY RIGHTS, 2nd ed. 2013, pp. 277-278.

⁹ P. Narayanan, LAW OF TRADEMARK AND PASSING OFF, 6th ed. 2004. P. 1.

¹⁰ WIPO is the self-funding global forum of United nations for Intellectual property services, policies, information, and cooperation. the mission of WIPO is to develop an effective and balanced international intellectual property system that enables innovation and creativity for the benefit of all nation.

another¹¹ and the owner of the trademark will have an exclusive right to use or apply that mark on his goods or services in the course of business and also confers the rights to authorize other to use that mark in return of a payment."¹²

2.3 Function of a Trademark: A trademark primarily performs the following function

- **Trademark identifies the goods of one trader and distinguishes them from goods sold by others.**¹³ It denotes the origin of the product and gives an indication to the purchaser as to the manufacturer or the quality of the goods, or the trade hands through which they pass on their way to the market.¹⁴ It enables the customers to trust in a given enterprise, not necessarily known to him for being responsible for the product sold under the trademark.¹⁵
- **It signifies that all goods bearing a particular trademark are of an equal level of quality:** Trademark gives the purchaser an assurance to the quality of the product he is buying; as the quality is not solely identifiable by eyes. Consumers buy a particular product on the faith of the mark being genuine and representing a quality equal to that which he had previously bought.¹⁶
- **It acts as a prime instrument in advertising and selling of the goods and can be considered as a marketing tool.**¹⁷: Advertisements play a very important role in the mind of the customers which convince the customers to buy a particular product or using a particular service or to fix his priorities over several goods coming from different sources. If advertisement on the screen has appealed to the sense of the customer; whether economic or *aesthetic* his preference is sure to be tilt towards that product and it is cannot be done without using their trademark in the advertisement so that the consumer can easily identify the product; thereby avoiding the search cost .Hence this can be termed as the "motivating function of a trademark."¹⁸

¹¹ WIPO Document, "Trademark", <http://www.wipo.int/trademarks/en/>(April 28, 2018).

¹² WTO Document, "Trademark", https://www.wto.org/english/tratop_e/trips_e/ta_docs_e/modules3_e.pdf(April 28, 2018).

¹³ *supra* note 6.

¹⁴ *supra* note 7.

¹⁵WIPO Intellectual Property handbook,http://www.wipo.int/edocs/pubdocs/en/intproperty/489/wipo_pub_489.pdf (April 28, 2018).

¹⁶ *supra*, note 8

¹⁷*supra*, note 9.

¹⁸ J.P Mishra, AN INTRODUCTION TO INTELLECTUAL PROPERTY, 2nd ed.2009, p.215.

2.4 Characteristic of a trademark: A trademark should have these following characteristics. These are:

- **Distinctiveness:** The first and foremost characteristic of a trademark is distinctiveness. To be capable a trademark, it should be distinct. 'Distinctiveness' means that the mark is adapted to distinguish a product of one proprietor from that of another. Generally 'distinctiveness' means some quality which marked the goods from those of others. In *Imperial Tobacco v. registrar, Trademarks*,¹⁹The Calcutta High Court stated that distinctiveness means some quality in the trademark which earmarks the goods so marked as distinct from those of the other producers of such similar goods.*.
- **Source indicator:** A trademark should have the capability of conveying the information to consumers that a product or services are coming from a particular source. The mark should able to indicate the connection between the product and the source from where it comes. For example, when as a consumer we see that curvy shape while colour plastic bottle with a red wrapper on it and the word Coca-Cola written on it, it can be easily identified as the product coming from the famous Coca-Cola Company.
- **Registered and unregistered:** A trademark can be either registered or unregistered. However, registration ensures ownership of trademark and it enables him protection by proving his title against any infringement of the mark. But that does not mean that an unregistered mark is completely unprotected. The owner of the unregistered trademark can protect the trademark under the common law action of passing off.²⁰

2.5 Forms of Trademark: Trademark has various forms. These forms are associated with a particular industry or business entity. These are:

- **Collective marks:** A collective trademark can be define as a trademark belongs to an association of persons and distinguish the goods and services of one association from that of another.²¹ But this association of persons does not include partnership firms. For example, the trademark held by Tata, PepsiCo, Godrej, Bajaj etc.
- **Service marks:** Trade in services has become a major business activity at both national and International level and with the development of the World Trade Organisation and General Agreement on Trade in services (GATS) service has

¹⁹ AIR 1977 Cal 413.

²⁰ Dr. M.K Bhandari, LAW RELATING TO INTELLECTUAL PROPERTY RIGHTS,3rd ed. 2012,p. 166.

²¹ *supra*, note 18.

* The distinctiveness of a trademark will be elaborately discussed under chapter V of this work.

become very frequent. Under the Law of Trademark, a service mark can be defined as a service of every description which is available to the potential consumer including the services in connection with banking, insurance, communication, education, transport etc.²² So service mark means a mark which is connected with these above mentioned services as to distinguish them from the entity providing similar services.²³

- **Certification Marks:** Certification marks means a trademark which has the capability of distinguishing the goods and services in connection with which it is used in the course of trade and is certified by the proprietor of the mark in respect of the quality, origin, mode of manufacturing the goods and other characteristics. However, it does not include a mark in the name of a person who carries trade in goods of the certified kind. Some examples of Certification marks are the Hallmark certification mark for jewellery and Ag-mark certification mark for food items and ISI mark etc.²⁴
- **Well Known trademark:** well-known trademark means a mark which is so familiar and popular among a substantial segment of the public which uses such goods or services that if such mark is used in relation to other goods and services; consumers will believe that these goods or services are coming from the first mentioned source.²⁵ Examples of some well-known trademark are Whirlpool, Amul, TATA, Reliance etc.
- **Domain name:** With the development of the Internet and the world of e-commerce, the services rendered and the product sold on the internet also began to be recognized and qualified for giving protection the internet world. That is where the concept of domain name came into the picture. Domain name is the address of a particular company on the internet which provides certain services or sells products in the e-commerce sector which indicate the source of the goods or services coming from that particular company. The domain name in the world of the internet can be equated with a trademark in the real world. In the sector of e-commerce, business entity registers a domain name which usually uses the same name or trademark as used in the physical world to indicate goods or services of a particular company in cyberspace. For example, the domain name of the company Yahoo is www.

²² Section 2(z) of the Trademark Act, 1999.

²³ *Ibid.*

²⁴ *supra* note 18.

²⁵ *supra* note 16.

Yahoo.com or of Amazon's www.amazon.in. Here Amazon.in is the domain name of that company.²⁶

2.6 Objective of Trademark Law:

The object of Trademark legislation is to confer the right to the trademark holder in respect of the trademark, to prescribe the mode of acquisition of it and the method of transferring those rights. It also provides the procedure for infringement of the trademark, the procedure of enforcement of those rights and deals with the remedy thereof. This branch of intellectual property is growing rapidly with the scientific and technological development and different types of marketing strategy being adopted by the modern business entities. Even the very nature of trademark and their function has a gone a sea of changes over time. So we can infer that in future time there will be more changes to be taken place in the trademark legislation.

With regard to object of trademark law, Delhi High Court in *Cadbury India limited and others v. Neeraj Food products*²⁷, observed that "the spirit, interment, and purpose of a trademark legislation is to protect the trader and consumer against dishonest adoption of one's trademark by another with the intention of capitalizing on the attached reputation and goodwill." In *Cluett Peabody & Co. Inc v. Arrow Apparels*²⁸, the court held that protection of the proprietary rights of the holder of a registered trademark is the object of trademark legislation. Later in *Ramdev Food Products (P) Ltd. v. Arvindbhai Rambhai Patel*²⁹, the court held that the establishment of a connection between the goods sold and its source thereof suggesting the quality of goods is the intrinsic purpose of a trademark.

2.7 Economic Significance of Trademark:

In the aspect of the trademark, the economic literature as yet has not systematically studied the role of a trademark. Although significant contribution with this regard appeared in the last century when Chamberlin, one of the most quoted economists of that era dealt with the analysis of trademark and market power in his famous study 'The Theory of Monopolistic Competition'. But surprisingly his study had been ignored for many years. After that Landes, Posner, and Ecomides presented an analysis of the rationale behind trademarks and trademark

²⁷ 2007(35) PTC 95(Del) at p.126.

²⁸ (1998) 18 PTC 156 (Bom).

²⁹ (2006) 8 SCC 726; (2006) PTC 281.

laws in modern economics. This study was considered as the most thorough theoretical study of the trademark.³⁰

In standard economic literature and law, the trademark has always been considered as an important incentive for the growth of business entities. It enables the business enterprises to invest in the quality of the product in connection with which the mark is used and act as a preventive measure for a specific market failure; that is because a trademark assures the quality of the product. According to Peter Drucker, a well-known management expert *"business entities have two basic functions; first is innovation and the second is marketing. This two functions guide a business entity to make a profit in terms of money in process of proving quality service and products to the customer. And in these two functions Intellectual Property plays an important role of which the most important is the marketing"*.³¹

Trademarks play an important role in marketing of a product by its unique appeal, distinctiveness which can build a strong consumer base for a particular business entity. Another important role of trademark from the economic perspective is that; use of a trademark significantly lowers the search cost of customers. Trademark reduces the difficulty of the customer spending time in searching for a product; just a look at a specific trademark and the customers will know that this is the particular product he wants.

Trademarks also play an important role in branding of a particular product or services. In the marketing world, the popular term used are the "brand or brand names" which are interchangeable with the trademark; although a product's brand is much wider concept than of a trademark as the making a strong brand and a brand equity is a bigger challenge than choosing or maintaining one or more trademarks. But whenever we equate a trademark with brand or brand name it also acts as or can act as the most effective way to make the profit for a business entity. The way to profit through branding is through three elements;

- Brand recognition i.e. when a customer buy a product for the first time,
- Brand preference i.e. customer is again willing to buy the same product resulting from the same source because it assures a particular quality

³⁰ Andria Mangani, "An Economic Analysis of Rise of Service Marks", 11 JIPR (2006), p.1, Also available at <http://docs.manupatra.in/newslines/articles/Upload/589A2791-68DA-4E51-88BD-2CC308533F9A.pdf> (May 16,2018).

³¹ WIPO Document, "The role of Trademark in marketing",http://www.wipo.int/export/sites/www/sme/en/documents/wipo_magazine/02_2002.pdf,(May 2, 2018).

- Brand insistence; which is a point where a customer completely refuses to buy any other alternative with respect that previous product.³²

Other studies also showed that with the concept of trademark, branding, and advertising there is a significant change in the concept of marketing. While earlier it was only the quality or characteristics of the product that performed the prime role in identifying it, nowadays the product always takes the back seat and it is the trademark or the brand and selling of the brand which plays the prime role in identifying that product in the market and to attract customers towards it.³³

Trademark also plays a vital role in maintaining the competition in the market. Trademark is the essence of competition. It encourages and promotes competition in the market their by enhancing creativity and economic development of a nation. It also helps in maintaining the product quality.³⁴It also plays a key role in the safeguarding of a business and makes an own place in the market. Now a day's business undertaking gives immense attention in registering and protecting its trademark because they can add substantial value to the products. One reason is that trademark links a product to something like images, a set of values or celebrity; and this linkage increases the products appeal to consumers, thereby confers an additional attribute upon the product. A second reason is that a trademark leads consumers to perceive a product in a way that makes them more willing to purchase it because the trademark has an intrinsic aesthetic appeal to consumers.³⁵

So, the role of a trademark which signifies a brand is not merely a source indicator but goes far beyond than that. *"The economic significance of a trademark therefore, evolved from being a sign that indicates origin; to linking product with the brand's image and for conferring emotional and psychological attributes derived from the images."*³⁶

2.8 International Convention and Agreements for Protection of Trademark:

Trademark plays a very important role in the field of trade and commerce. The need and importance of trademark in the course of trade were soon realized and recognized in the global platform. Hence there were several attempts at the international level for the protection of the trademark. With the increasing realization for protection of trademark; some

³² *Ibid.*

³³ Andrew Griffiths, 'A Law and Economic perspective on trademarks', Lionel Bentley (ed.), TRADEMARKS AND BRANDS-AN INTERDISCIPLINARY CRITIQUE, 1st ed. 2010, pp. 247-248.

³⁴ *supra*, note 21.

³⁵ *supra*, note 33.

³⁶ *Ibid.*

significant treaties and convention was made in the global level; which are discussed as follows:³⁷

2.8.1 Paris Convention for the Protection of Industrial Property:

The Paris Convention for Protection of Industrial Property was signed at Paris on 20th March, 1883 which is applicable to patents, trademarks, industrial designs, utility models, service marks, trade names and geographical indication.³⁸It was the first global effort for the protection of the trademark. The Paris Convention does not deal with the filing and registration of marks, which are left to each contracting state according to their municipal law and only deals with the protection of the trademark in the contracting parties. The Convention provides that a mark registered in any of the contracting state is capable of registration in any other member countries, and the lapse of the term of registration in one contracting state does not affect the registration of the Trademark in another contracting state.³⁹

2.8.2 Madrid Agreement and Protocol:

A trademark is territorial in nature. It is recognized as having a separate existence in each nation and is entitled to protection only in the nation according to its municipal Law. It is called the doctrine of territoriality.⁴⁰ But to register a trademark in every country in which a business entity needs protection is very complex and too expensive. Therefore a need was felt for a mechanism which can facilitate an international registration of a trademark. As an outcome, the Madrid Agreement and Protocol related to it was adopted for facilitating the International registration of trademarks. This international registration is administered by Madrid agreement, 1891 and the protocol relating to it; which was adopted in 1989. This system of international registration of a trademark is governed by the WIPO International Bureau.⁴¹ It was aimed at providing an international registration of mark by the filing of a single application and by paying one set of fees for protection in 117 countries. It also provides for renewal, modification of trademark and plays an important role in expanding the global trademark portfolio.⁴²The application for international registration can be filed only by a legal person or a legal entity provided he has a personal or business one of the system's

³⁷ *supra*, note 18.

³⁸ WIPO Document," Summary of the Paris Convention for the protection of industrial Property", http://www.wipo.int/treaties/en/ip/paris/summary_paris.html (April 30,2018).

³⁹ *Ibid*.

⁴⁰ *supra*, note 3.

⁴¹ WIPO Document, <http://www.wipo.int/export/sites/www/about-ip/en/iprm/pdf/ch5.pdf> (April 28,2018).

⁴² WIPO, "Madrid-The International Trademark System ",<http://www.wipo.int/madrid/en/> (April 28,2018).

member. This means that you must either; be domiciled, have an industrial or commercial establishment in, or be a citizen of one of the 117 countries covered by Madrid System.⁴³ An international registration for trademark lasts for 10 years and can be renewed.⁴⁴

2.8.3 TRIPS Agreement and WTO:

In the field of Intellectual Property; The Trade-Related Aspects of Intellectual Property Rights (TRIPS) is the most important effort in the global scale. TRIPS was adopted on April 15, 1994 at Marrakesh (Morocco) and came into effect on 1st January, 1995 to administer a mutually supportive relationship between WIPO and WTO.⁴⁵ It lays down the minimum standard for intellectual property regulation by WTO member nation.

Section 2 of Part-I of the TRIPS agreement specifically deals with the trademarks. Article 15 of the TRIPS agreement defines Trademark as "Any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings. Such signs, in particular words including personal names, letters, numerals, figurative elements and combinations of colours as well as any combination of such signs, shall be eligible for registration as trademarks. Where signs are not inherently capable of distinguishing the relevant goods or services, members may make registration depending on distinctiveness acquired through use. Members may require, as a condition of registration, that signs be visually perceptible."⁴⁶ By virtue of article 16.1 "The owner of a registered trademark must be granted the exclusive right to prevent any third party not having the owner's consent from using in the course of trade an identical or similar signs for goods or services in respect of which the trademark is registered-where such use would result in a likelihood of confusion. In case using an identical sign for identical goods or services, a likelihood of confusion must be presumed."⁴⁷

2.9 Conclusion: A Trademark can be termed as the best salesman of a product. While indicating a source of the product and ensures the customers as to the origin of the goods and services and the quality, it also driven consumer choice when purchasing a particular product because of the appealing form or the aesthetic value of it. It also ensures the quality of the product. Thus trademark protects the reputation and goodwill of the company as well as

⁴³ WIPO Intellectual Property Hand Book: Policy, Law, and use, <http://www.wipo.int/export/sites/www/about-ip/en/iprm/pdf/ch5.pdf> (April 28,2018).

⁴⁴ *Ibid.*

⁴⁵ *supra* note 41.

⁴⁶ Article 15, TRIPS Agreement.

⁴⁷ Article 16.1, *Ibid.*

protects the customer from confusion. So in the modern era of business trademark not only remains as merely a source indicator, but also bears the burden to make a profit for a business entity.⁴⁸It can be considered as the face of that business entity. It makes the trademark of a company known to the public as belongs to them so as to secure profits from the reputation of their trademark.

The concept of trademark and the law governing trademark is directly proportional to business practice and competition. A considerable amount of money, time, thinking effort is put to make a business entity and a more lot of creativity, research, effort and time are invested to make a trademark in order to protect their business and it becomes a stamp of quality or as the researcher already mention; the face of the product. So it can be concluded that trademark is not only an indication to the origin of the product but also has a very important role to play in the marketing and the profit of a business entity.⁴⁹

⁴⁸ *Ibid.*

⁴⁹ *supra* note 35.

CHAPTER III

UNDERSTANDING NON-CONVENTIONAL TRADEMARK

3.1 Introduction:

In the course of business, a trademark has always held a key position to denote a product's identity and its source. It carries its own image and a distinct personality to the goods and services. With the growth of the ideas of trade, business and marketing; the concept of the trademark has also evolved. Generally When we called 'trademark' the notion in the minds of people is that of a sign, a mark or a logo, word which is visually perceptible and that is what was traditionally used by companies as their trademarks. But with the globalization and changing techniques of marketing and from the behavioral study of consumers in the modern trends of business; trademark practice also takes some new development as to the appearance and the characteristics of the mark so as to attract consumers towards a particular product. Companies are coming out with more innovative, creative techniques to identify or distinguish their product and also to occupy a certain position in the mind of the consumers to make their business more profitable. In this course a practice was began to add a typical aroma, a special touch, an unique packaging, shape, some moving image and a unique sound or a particular shade of colour as a trademark to attract 'modern customers'. For example 4 string musical note of Britannia biscuit, that purple colour shade of the immensely popular Cadbury chocolate or the shape of the Coca-Cola bottle. These marks which are not traditionally used as a trademark in the course of business are called as 'non-traditional trademarks' or 'non-conventional trademarks' or we can even term them as *the modern marks*.⁵⁰ *"This shift arose primarily to complement the efforts of brands to remain memorable and distinct from their competitors by appealing to all the five senses."*⁵¹

3.2 Concept of Non-Conventional Trademark:

The term non conventional trademark means and includes a mark which does not come under pre-existing or the traditional category of trademark such as word, logos, symbol, pictures or

⁵⁰ Vatsala Sahay, "Conventionalising Non-Conventional Trademarks of Sounds and Scents: A Cross Jurisdictional Study", 6 NSLR (2011), p.129 , available at <http://www.commonlii.org/in/journals/NALSARStuLawRw/2011/9.html> (May 19, 2018).

⁵¹ Lesley Matthey, "Rock, Paper, Scissor, Trademark- A Comparative Analysis of Motion as a feature of trademarks in the United States and Europe", https://heinonline.org/HOL/Page?handle=hein.journals/cjic14&div=21&g_sent=1&casa_token=&collection=journals (May 14, 2018).

the combination of these elements⁵² and which is unique, unlike their traditional counterparts. These are the moving image mark, building mark, slogan mark, shape and packaging of goods, gestures marks, and hologram marks, colour marks and also include marks which are non- visible and multisensory in nature, such as smell, sound, taste and feel marks. Non-conventional trademark has begun a revolution in both in the fields of trademark law as well as marketing.⁵³

While there is no comprehensive definition of non-conventional trademark; from the WIPO Standing Committee Report⁵⁴ we can infer the meaning of non-conventional trademark, which provides that: "The types of signs that are nowadays considered as being capable of constituting a trademark have expanded beyond words or figurative devices. Moreover, visually perceptible signs are being used in trade together with signs, which may not, in themselves be visually perceptible, but have a potential for distinguishing goods and services. Other signs may be visible and yet differ from the traditional notion of signs constituting trademarks by one or more of their features."⁵⁵ So, in the absence of a comprehensive definition; we can define non-conventional trademark as a trademark which do not come under the traditional types of trademark or beyond the traditional notion of trademark and which can be either visually perceptible or not visually perceptible.

Some of these trademarks are widely accepted across jurisdiction for their innovative effect in creating an impact on the mind of the consumers. According to the marketing specialist "*if a customer heard a nice, comforting and familiar sound associated with a product or fragrance associated with a particular product they are most likely to buy it.*"⁵⁶

3.4 Historical Overview and Development of Non-Conventional Trademark:

As the researcher already discussed in the second chapter, The evolution of trademark can be traced back to ancient period where it was used to identify a particular goods or services and was only limited to some words or symbols as trademark. But with the growth of trade and business as well as the technology; the scope of these trademark has widened to include this

⁵² Kritarth Pandey and Virendra Singh Thakur, "Non Conventional Trademark-A Legal Analysis", 3 IJLP (2015), p. 2. Available at https://papers.ssrn.com/sol3/papers.cfm?abstract_id=2399286 (May 19, 2018).

⁵³ Sahil Tandon, "A Research Study on Non-Traditional Trademarks", <https://scholararticles.wordpress.com/2015/08/27/a-research-study-on-non-traditional-trademarks/> (May 19, 2018).

⁵⁴ SCT is a permanent committee of WIPO which aims to study Design, Trademark and Geographical Indication

⁵⁵ WIPO Standing Committee Report on Law of Trademarks, Industrial Design and Geographical Indication, "New Types of Marks", http://www.wipo.int/edocs/mdocs/sct/en/sct_16/sct_16_2.pdf (May 20, 2018).

⁵⁶ Nikhil Kashyap and Priyanka Ghai, "Non-Traditional Trademarks: An Unprotected Arena", <http://journal.lawmantra.co.in/wp-content/uploads/2015/08/52.pdf> (May 19, 2018).

modern types of marks such as smell, sound, colour. However it is pertinent to note that though we call it as 'modern marks' these non-conventional trademarks is being the matter of concern from 19th century itself.⁵⁷The need and importance of these non-conventional trademarks were felt by the companies almost a decade ago when they used a certain colour, pattern, design, sound, shape to signify their goods and a strategy to attract consumers towards their product. But the formal registration and statutory protection of these non-conventional trademarks was a subsequent development. For example, the colour trademarks are used since 1830. From 1845, Jewellery Company Tiffany maintains a shade of light blue colour for its distinctive blue colour packaging boxes for jewellery, the distinctive shape of the Coca-cola bottle was registered in 1960. Over the course of time, it has acquired a significant status and became one of the most popular and recognizable brands of the world. With respect to single colour trademark registration, another example is the 'dyed pink colour' of Owens Corning Corporations for its insulation product from 1956. Its pink insulation colour became so popular that the company even registered the word mark PINK for its insulation. Finally, in 1985 the court held that the pink colour used by the company for its insulation product can be protected as a trademark and the company had the right to prevent others from infringing that shade of pink colour for insulation.⁵⁸

In case of sound marks; way back in 1950 the NBC chimes got sound trademark registration. The Metro-Goldwyn-Mayer Corporation (MGM) used a sound of 'Lion roar' to announce the beginning of a movie and filed the application for registration in 1985. Apart from these, there are also endless examples of registration of non-conventional trademark from the past. But now with the development of the strategies of business, globalisation, growth in technology, digital and social media revolution; the branding strategies of companies are also evolved to attract the consumers by using some creative and innovative ways of branding; which also includes attracting the five senses in the human body. **Non Conventional trademark can be considered most appealing, successful and important branding strategy in the 21st century.**⁵⁹

⁵⁷ Roberto Carapeto, "A reflection about the Introduction of Non-Traditional Trademarks", <http://www.waseda.jp/foaw/icl/assets/uploads/2016/02/c35688e10d1c61201172065546b98301.pdf> (May 5, 2018).

⁵⁸ Lisa P. Lukose, "Non-Conventional Trademarks: A Critique", http://14.139.60.114:8080/jspui/bitstream/123456789/34744/1/011_Non-Traditional%20Trademarks%20a%20Criique%20%28197-215%29.pdf (May 19, 2018).

⁵⁹ *Id.* at 2.

3.4 Rationale for protection of Non-conventional Trademark:

- Non-conventional trademark is equally important as its traditional counterpart. These are important especially for visually impaired people, children and in the society where there is low literacy rate; where people are unable to recognize or read as to what is written on the product so that they can easily identify a product from its shape, colour or smell.⁶⁰ In the Indian aspect, it was observed in the case of *V.K. Industries v. H. Mehta, Registrar of Trademarks* that:

*" The need for a dual protection i.e. protection both to the manufacturer and the customer, is essential in a developing country like India and other under-developed countries in the world because the mass of the people in such countries belong to illiterate, uneducated or the semi-educated class who would not be able to distinguish the product of a manufacturer... and would have to depend on some sort of a mark whether consisting of a name, a word, a device or a representation with a view to distinguish the goods of a particular manufacturer ., in which they may be interested from those of the others and the chances of deception, particularly of ordinary man with average and imperfect recollection, are almost proverbial in such societies."*⁶¹

For Example; generally it can be seen that children often demand a chip's packet having a particular colour packaging, or the illiterate people often go to shops and demand a particular colour packaging of toothpaste, detergent powder, like for them the green colour detergent means the 'Tide detergent powder' in a light green colour packet or the blue detergent which means the famous 'Surf Excel'. So it can be proved that colour does play the role of a source indicator. Especially in Countries like India where there is low literacy rate, uneducated or semi-educated class of people; colour plays an important role in identifying the product.

- Another reason is that unlike the notion about the traditional trademark, only visual perceptibility of a trademark is not a sine qua non for building brand image in the minds of the consumers. Being multisensory in nature; non-conventional trademark can also attract a wider section of consumers to influence their purchasing decision. Non-conventional trademarks add an aesthetic value to the products which makes a product

⁶⁰ Lisa P. Lukose," Unconventional Trademarks: Novel trends in Modern Trademark Law, 1 CNLU LJ (2010), P. 24, available at <http://www.scconline.com/DocumentLink/38hi86yS> (May 20, 2018).

⁶¹ 1997 Law Suit (Del) 462.

more appealing and eye-catching to consumers.⁶² For example; we as consumers often get attracted to the beautiful shade of coffee brown colour smooth wrapper used in Cadbury Bournville Chocolate or the attractive packaging of the famous Ferrero-Rocher chocolate and can very well identify it as the source indicator of the product.

- Non-conventional trademark encourages business entities to develop a novel and innovative techniques and creative ways of branding. Thereby facilitating the prime object of intellectual property law. By applying for these non-conventional trademarks; business undertaking can increase benefits for themselves by reaching out to a new purchaser or newer markets.⁶³
- These modern trademarks are necessary to protect in the interest of the global trade. In the era of globalisation, it will act as a trigger in terms of economic development in the field of international trade and commerce. For example, the unique opening style of the doors of Lamborghini car attract a wide range of customers from around the globe to buy that particular car and apart from that it also encourages the transfer of technology and invests in the national as well as in the global market.⁶⁴ Sri Lanka, Japan, Australia, U.S.A, E.U and also India including several other countries have recognised the need of protection of the non-conventional trademark. In the light of international convention and agreement, particularly according to the TRIPS agreement, there should be a harmonious mechanism for the recognition and protection of the non-conventional trademark.⁶⁵

3.4 Kinds of Non-conventional Trademark:

Since the scope of non-conventional trademark is wide in nature without a precise definition of it, the WIPO standing committee on the Law of Trademark, Industrial designs, and Geographical Representation (SCT) upon its research on non-conventional trademark; divided it into visual and non-visual Trademark.⁶⁶

3.4.1 Visible Marks:

3.4.1.1 Colour:

Colour always able to attract the attention of the human mind; and the companies are making a constant effort to use the colour or combination of colours not only to their products

⁶² *supra* note 50.

⁶³ *Ibid.*

⁶⁴ *supra* note 60.

Also see Shikhar Sinha and Kunal Gopal, "Tracing the Jurisprudence of Smell Marks As A Trademark", 3 HNLU SBJ (2017) P.<http://www.scconline.com/Members/SearchResult2014.aspx?documentLink=JTXT-0002690257> (May,18,2018).

⁶⁵ *Ibid.*

⁶⁶ *supra*, note 6.

but also in advertising of the product, packaging of the product or even in their outlets of sale.⁶⁷ In commercial aspect colour always plays an important role in the identification of a product and to add an aesthetic value to it. For example, the attractive purple shade of a packaging of a chocolate will always lead our mind to the Cadbury chocolate; no matter the whether the word Cadbury is written in Japanese, Chinese or in any other language.⁶⁸

Colour can be a trademark in two forms-

- Combination of colour or
- Single colour.

When a combination of colours is widely accepted across jurisdictions; the issue of single colour as a trademark are included in a very less number of national legislation.⁶⁹

Be it the business of starting from the pharmaceutical sector, packaging of product , industrial equipment or any clothing or accessory, companies has always use a distinctive colour to identify their products.⁷⁰Currently, many countries like Argentina, Australia, Austria, Belarus, Brazil, Bulgaria, Belarus, China, U.S.A, Denmark, France, Germany, Italy etc. recognize the combination of colour as a trademark.⁷¹

Single colour as a Trademark:

While across jurisdiction including India combination of colour is accepted as a trademark, the issue of single colour as a trademark is yet not resolved in most of the jurisdiction. In the modern trends of business; companies are constantly making effort to register single colour as a trademark; because these colours itself became the face of the product, for example, the purple shade of Cadbury chocolate or bright red colour heels of Christian Louboutin shoes or the dark blue colour of Nivea cream.

At present many counties like Australia, Austria, Bangladesh, Belarus, France, Finland, Germany, New Zealand, Pakistan, Philippines, Singapore, Spain, U.K, Ukraine etc. recognize the single colour as a trademark.

⁶⁷ *Id.* at 3.

⁶⁸ Sakshi Mahajan & Aastha Tandon, " Legal Acceptability of Single Colour as a Trademark", 4 CNLU LJ (2014), p. 79. available at <http://www.scconline.com/DocumentLink/8e9Zh387> (May 20, 2018).

⁶⁹ Arka Majumder, Subhojit Sandhu and Sunandan Sarkar, "The Requirement of Graphical Representability for Non-conventional Trademarks", 11 JIPR (2006), p. 316. available at <http://nopr.niscair.res.in/bitstream/123456789/3588/1/JIPR%2011%285%29%20313-317.pdf> (May 20, 2018)

⁷⁰ *supra* note 68.

⁷¹ WIPO Standing Committee Report on Law of Trademarks, Industrial Design and Geographical Indication, "Summary of Replies to the Questionnaire on Trademark Law and Practice", http://www.wipo.int/export/sites/www/sct/en/meetings/pdf/wipo_strad_inf_1_rev_1.pdf (May 19, 2018).

The issue of single colour as a trademark has a basis on some theories as follows which will be elaborately discussed in the subsequent chapters.^{72*};

- colour depletion theory
- Secondary meaning
- Functionality
- Distinctiveness

- **Colour trademark in the pharmaceutical industry:** While there are many products or services where colour plays an important role, the researcher wants to highlight the importance of colour as a trademark in the pharmaceutical sector. In this sector, the colour or combination of the colour of the pills, liquid medicine, and colour of the packaging plays a very important role and raise more concern as it directly associated with the health of the people. For example, when as a consumer we see a white colour round shape pill in a purple colour packaging we believe it to be 'paracetamol' or a pink colour liquid tonic we know that it is 'Gelusil'. Because these are very popular medicine and widely used among customers for a very long time. So even the slightest similarity, misrepresentation or deception with other medicine will cause a great threat to human health. Although it can be argued that people buy medicine on prescription and not based on colour bur in a country like India having a low literacy rate and some medicine are also available even without prescription, there is no need to further elaborate as to why protecting colour or even a single colour as a trademark in the pharmaceutical sectors is of utmost importance.⁷³

Studies also showed the impact of colour on the patient's mind. According to a 2011 survey conducted by University of Bombay, India "to determine the extent of influence of colour of a pill has an inclination to take that pill,....revealed that the patient may want to refrain from taking a particular pill of a specific Colour, where specific tastes are associated with the medicine⁷⁴ and the colour, shape, taste pill can

⁷² *supra* note 70.

⁷³ Dhir & Dhir Associates, "Trademarks in the Pharma Sector-A Ready Reckoner", <http://www.dhirassociates.com/images/Trade-marks-in-the-Pharma-Sector-A-Ready-Reckoner.pdf>, (2nd May 2, 2018).

⁷⁴ Kiran George, *AstraZeneca v. Dr Reddy's-Colour as a Pharmaceutical Trade Dress*, <https://spicyip.com/2015/12/astrazeneca-v-dr-reddys-colour-as-a-pharmaceutical-trade-dress.html>, (2nd May, 2018).

*Under chapter IV and V.

have an effect on how patients feel about their medication, that effectively gives the pill a boost, improves outcomes and might even reduce side effects."⁷⁵

In the light of above discussion *AstraZeneca v. Dr Reddy* is a significant case with regard to the non-conventional trademark in the pharmaceutical sector. In this case Astra Zeneca, a U.S.A based pharmaceutical company sued Dr. Reddy laboratories in Delaware Court for using the purple colour of the generic version of AstraZeneca's *Nexium*, an antacid pill, being sold by Dr Reddy laboratories on the ground that the purple colour used by Dr Reddy laboratories is similar to plaintiff's *Nexium* Tablets; therefore infringing their trademark. In this case Court granted a temporary injunction in favour of the AstraZeneca.⁷⁶ Another example is the diamond shape blue colour Viagra tablets of Pfizer that registered in EU.⁷⁷

According to an another study conducted by U.S with a pharmacist in a leading hospital in India⁷⁸ proved pharmacist spent many in offering explanations to convince patients to switch from a familiar tablet identifiable in a particular colour / shape to a generic equivalent in a different colour/ shape.⁷⁹ But, in this context, it needs to be asked whether the increased transaction costs by virtue of monopoly rights over colour / shape are justifiable, particularly when viewed in the context of limited social benefits accrued by way of grant of monopoly rights over colour/ shape.

3.4.1.2 Motion Marks:

Motion marks or moving image mark is a kind of non-conventional trademark which is very popular in the multimedia industry.⁸⁰To register a motion trademark requires a sequence of drawing and pictures of the elements of trademark and depict how they function with the interaction of each other. The motion mark of Columbia is a registered trademark in the U.S.A where the word 'COLUMBIA' appears across the top running through the torch and then a circular rainbow appears in the sky encircling the figure.⁸¹ Another example of motion trademarks are the 'movement of Lamborghini car door' which is registered because of its

⁷⁵ ScienceDaily, "Color and Shape of pills affects how patients feel about their medication", <https://www.sciencedaily.com/releases/2010/11/101115110959.htm> (May 20, 2018).

⁷⁶ Kiran George, *AstraZeneca v. Dr. Reddy's-Colour as a Pharmaceutical Trade Dress*, <https://spicyip.com/2015/12/astrazeneca-v-dr-reddy-colour-as-a-pharmaceutical-trade-dress.html>, (2nd May, 2018).

⁷⁷ EUIPO Registration No: 001909472,

⁷⁸ Arul Scaria and Kavya Mammen, *Non-Traditional Trademarks in the Pharmaceutical Sector: Non-traditional barriers to Access to Medicine?*, https://www.researchgate.net/publication/318679382_Non-traditional_Trademarks_in_the_Pharmaceutical_Sector_Non-traditional_Barriers_to_Access_to_Medicine (May 14, 2018).

⁷⁹ *Ibid.*

⁸⁰ Dr V.K Ahuja, *LAW RELATING TO INTELLECTUAL PROPERTY RIGHTS*, 2nd ed. 2013, p. 281.

⁸¹ *supra*, note 52.

unique way of opening the door⁸² and the moving image trademark of Kraft foods for chocolate registered in U.K.⁸³

At present countries like Norway, Singapore, South Africa, US, Russian Federation, Sweden etc. recognizes moving image trademarks.

3.4.1.3 Hologram Mark:

A hologram is a three-dimensional trademark created with photographic techniques which are generally used for security purposes on tickets or certain currencies in order to prevent fraudulent misrepresentation. Hologram marks are recognised in the U.S.A and many of the European Countries, but registration of hologram as a trademark is difficult as it keeps changing its colour and appears different from different angle; and thereby making it difficult to represent it in the paper form for the purpose of registration⁸⁴. As per the WIPO standing committee report, "One possible approach to the representation of marks consisting of holograms; is to describe it in as much detail as possible, providing visual views of the holograms in various frames with descriptions of angle and appearance. Use of high-resolution frames avoiding the fading or picture overlapping may be an option, as descriptions of the visual effects alone might not be allowed."⁸⁵

At present, the Countries which recognize non-conventional trademarks are Australia, Austria, Columbia, Denmark, Finland, France, Germany, Hungary, Sweden, Switzerland, South Africa etc.⁸⁶

3.4.1.4 Three-dimensional Mark:

A shape of the product and their packaging qualify for registration under the three-dimensional trademark which is one of the most common forms of a non-conventional trademark. The Coca-Cola Company obtained a 3D registration of the Coca-Cola bottle in Japan.⁸⁷ Over time the shape of this coca bottle is easily identified by consumers even if the wrapper is peel off the bottle. Consumers can easily identify that the bottle is coming from the coca cola company by its unique shape.

⁸² *supra* note 53.

⁸³ WIPO Magazine, "Smell, Sound and Taste-Getting sense of Non-traditional Marks", http://www.wipo.int/wipo_magazine/en/2009/01/article_0003.html (May 20, 2018).

⁸⁴ *supra* note 52.

⁸⁵ WIPO Standing Committee Report on Law of Trademarks, Industrial Design and Geographical Indication, "New Types of Marks", http://www.wipo.int/edocs/mdocs/sct/en/sct_16/sct_16_2.pdf (May 20, 2018).

⁸⁶ *supra* note 21.

⁸⁷ *supra* note 30, at 283.

At present the Countries like Argentina, Australia, Austria, Canada, China, Denmark, Finland, Austria, France, Hungary, Italy, Japan etc. recognize the three-dimensional trademarks.⁸⁸

3.4.1.5 Shape and Appearance Mark:

This type of Non conventional trademark may be three dimension presentation of the product or container of the product or shape of the mark and appearances may include the whole packaging of the product, colour or combination of colours applied to the product or to the packaging of it. This is frequently referred to as trade dress.⁸⁹ For e.g., Mc Donald's golden arches or the shape of the well-known confectionary company Ferrero-Rocher chocolate.

The characteristics of these marks include the graphic design, three-dimensional shape of the product, packaging and even also include the appearance of a restaurant. Actually, it indicates the manner in which a place of business or a product is "*dressed up*" in order to go to the market.⁹⁰ The most popular shape mark registered is of the shape of Coca-cola bottle. In the European Union, the triangular shape of "Toblerone chocolate" is registered as a trademark.

Shape mark and trade dress is extremely important in the modern business and are the most popular non-conventional trademark because it is most effective in attracting consumers towards particular product or services. For example in the food industry appearance or trade dress plays a very important role. Now days people no longer come to restaurants to satisfy the basic facet- which is the hunger because if they do; they will only pay a commodity price and not the value-added price. What attract customers to go to a particular restaurant again and again is the ambience of the restaurant which make their restaurant unique, it's about a group of people who render services in that restaurant wearing a particular dress code. It create aspiration for customers to come back to the restaurant; because of the *look and feel* or what we called trade dress of a restaurant or *look and feel* of the menu.⁹¹ For example, when selecting a restaurant apart from the taste and price of the food we also consider its ambience and their unique way of serving.

So, it can be affirmed that shape and trade-dress plays a very important role in almost every sector of trade and business.

⁸⁸ *supra* note 36.

⁸⁹ *supra*, note 82.

⁹⁰ M M S Karki, " Nontraditional Areas of Intellectual Property Protection: Colour, Sound, Taste, Smell, Shape, Slogan and Trade Dress", 10 JIPR 920050, p. 503. Available at <http://nopr.niscair.res.in/bitstream/123456789/3701/1/JIPR%2010%286%29%20499-506.pdf> (May 19, 2018).

⁹¹ *see* Anand & Anand, " Indian Restaurant Congress 2017 Indian Restaurant Congress 2017", <http://updates.anandandanand.com/indian-restaurant-congress-2017/> (May 20, 2018).

3.4.2 Non-visible Trademarks:

3.4.2.1 Sound Mark:

The sound mark can be considered the most conventional form of non-conventional trademark, because sound marks are becoming more usual in the modern trends of business. Intel's "bah bo bha", Dulux's sound of a barking dog, sound of a lion roar of Metro Goldwyn Corporation(MGM), Tarzan's yell, Britannia's four-note musical sound are very familiar sounds trademarks registered across the globe.⁹²

If a sound persists in the mind of the listener and they can immediately associate that particular sound to a source of goods or services, provided the procedural requirements are fulfilled; it can be registered as a trademark.⁹³ According to INTA, "an appropriate sound is capable of registration and protection in the same way as that of other traditional forms of marks. Sound can be an important element in the branding of a good or services. It helps the consumers to distinguish a particular service or product from that of another."⁹⁴

A sound mark can consist of a string, notes, songs with or without words, well-known sounds of nature; provided it has a factual distinctiveness or a secondary meaning. Most importantly in the case of well known popular music, music strongly associated with particular regions, nursery rhymes; the issue of factual distinctiveness plays a very important role in registration.⁹⁵ Some examples of registered sound marks are Merrie Melodies theme song; the spoken letters 'AT & T';³³ the sound 'ooh it's so good'; the melody 'sweet Georgia Brown' are famous examples of sound marks registered in the US.

At present countries like Austria, Denmark, France, Germany, Ireland, Italy, the Office for Harmonization in the Internal Market (OHIM), Spain, Sweden, UK, Norway, Switzerland, Germany recognize sound marks. With regard to representation of the sound mark; as per the WIPO SCT committee, it can be represented in a musical notation, a written description of the sound, analogue or digital recording or by way of electronic filing.⁹⁶

3.4.2.2 Smell Marks:

Smell mark or olfactory mark is the most unconventional and controversial type of non-conventional trademark, but at the same time it is the most interesting trademark which is

⁹² *supra* note 60.

⁹³ *supra* note 34.

⁹⁴ Neha Mishra, "Registration Of Non -Traditional Trademarks, 13 JIPR (2003), p. 46. available at <http://docs.manupatra.in/newline/articles/Upload/0BA24F3D-DE7F-4172-9CBF-E9B72391C5CC.pdf> (May 20, 2018).

⁹⁵ *supra* note 42.

⁹⁶ WIPO standing committee *supra* note 16.

gaining a lot of concern in the present day.⁹⁷ Smell is considered to be the most influential type of human memory. Companies add a pleasant aroma to their product to make their product distinct from other or to attract customers and to make a strong impact in the human memory. But often a question raised is that -whether consumers able to distinguish the product depend upon in fragrance or smell? There are several studies in support of this. A study conducted by Rockefeller University of New York City reveals that "an average person can differentiate approximately 1 trillion smells and also revealed that while human eyes use just 3 light receptors to see millions of colours, the nose has 400 different Olfactory receptors."⁹⁸

From this observation, it is evident that the human brains can memorize many different types of scent and therefore a product can be identified by their scent or aroma. Apart from that, even if we study consumer behaviour it can be seen that we often identify a product by its smell without looking to the product itself. Apart from identification another most important role of a smell mark is that it adds an aesthetic value to the product which can appeal the consumer's senses. By adding a pleasant aroma in their product; business entities not only make their product distinctive but also make it more attractive to consumers to buy that product. For example a strawberry scent applied to a tyre or machine appliances. By the smell trademark; people can connect to that source of the product by its smell without looking what is written on it. So the smell is indeed require a recognition and protection as a trademark across the jurisdiction.

The first smell mark registration was granted in U.S.A⁹⁹ in 1990 for sewing thread and embroidery yarn which was a scent of 'a high impact, fresh floral fragrance reminiscent of Plumeria blossoms' and was represented in a detailed written description.¹⁰⁰ Another example is 'cherry scent for synthetic lubricants' registered for racing vehicle. In United Kingdom 'Floral fragrance reminiscent of roses for tyres' of Sumitomo Rubber Co. and the smell of 'the strong smell of bitter bear applied to flights for darts' of Unicorn product was registered

⁹⁷ *supra* note 69.

⁹⁸ Luv Virmani, "Protecting Non-Conventional Trademarks", <http://jurip.org/wp-content/uploads/2017/08/Luv-Virmani.pdf> (May 21, 2018).

⁹⁹ In re Celia Clarke, USPQ 2d 1238 (1990) (TTAB), cited in Meenu Maheswary, "Olfactory Marks: A Need To Create A Change For Its Sense", <http://www.mondaq.com/india/x/263798/Trademark/Olfactory+Trademarks+A+Need+To+Create+A+Space+For+Its+Sense> (May 18, 2018).

¹⁰⁰ *supra* note 60.

as a trademark.¹⁰¹ "The scent of Bubble gum applied in oil-based metal cutting and metal removing fluid in metalworking industries is registered in Australia."¹⁰²

3.4.2.3 Taste Mark:

Taste marks; also known as gustatory marks are treated in the same manner as the smell mark because of its issue regarding representation in order to register it.¹⁰³ Taste plays an important role in identifying or distinguishing a product from that of another and also adds an aesthetic value. With regard to the Taste mark registration, the prime issue lies with the distinctiveness of trademark or whether the consumer can be able to distinguish it. A taste cannot be registered a trademark unless it is used in a manner calculated to project to purchasers or potential purchasers a single source or origin for the goods in questions.¹⁰⁴ That means either it should be inherently distinctive or over the course of business consumers able to distinguish it. Because a taste mark like the other non-conventional trademark neither can be immediately perceive as trademark nor can be inherently distinctive.¹⁰⁵

Flavour or taste mark also tend to fail in functionality* because taste has to be available to other competitors in the market as well. So a very unusual taste like a flavour of caramel or peanut butter added to a toothbrush is more likely to be protected than the use of the same taste in cakes and bread.¹⁰⁶

3.4.2.4 Touch Mark:

Another very uncommon mark in the field of non-conventional trademark is the 'Touch mark' which is also known as 'Tactile marks' or 'Haptic' marks owing its origin *haptesthai* which means pertaining to touch. Touch mark can add to goods, in which the end product of a manufacturer has such a quality that it can be identified by touching the product itself like a feel of cotton or velvety surface of a perfume bottle and thus distinguish it from other similar products.¹⁰⁷ The tactile trademark was first granted in at the German Patent and Trademark Office in 2003 to the Kimberly-Clark for its 'raised, alternating dot pattern on paper towels'.

¹⁰¹ *Ibid.*

¹⁰² *supra* note 90.

¹⁰³ *supra* note 94.

¹⁰⁴ Amanda E. Campton, "Acquiring a flavor for trademarks: There is no common taste in the World", 8 NJTIP (ISSUE 3), P.343. available at <https://scholarlycommons.law.northwestern.edu/cgi/viewcontent.cgi?article=1109&context=njtip> (May 19, 2018).

¹⁰⁵ *Ibid.*

¹⁰⁶ *supra* 94.

¹⁰⁷ *supra* note 53.

The corporation 'Touchdown Marketing' has registered a trademark for the 'pebble-grain texture' and 'soft-touch feel' of its basketball shape cologne dispenser. Another corporation; Fresh Inc. has a registered Trademark on 'cotton-Textured paper' used for wrapping its soap products. Wholesale Wine & Spirits, Inc. an American Company has a registered tactile mark for its 'Khvanchkara wine'.¹⁰⁸ Another example is the Louis Vuitton Malletier's tactile marks for their luxury lines of luggage and other leather products which are registered in the US.¹⁰⁹

With regard to tactile mark, in 2006 INTA¹¹⁰ adopted a resolution supporting the protection and registration of touch mark. According to it though tactile marks are not recognised in most of the Countries; the marketing researcher has recognised the relation of senses to consumer behaviours and the consumers can very well identify a product by the sense of touching. Apart from that a 2009 study in the Journal of Consumer Research suggest that touch increases a consumer's sense of ownership and also drive a customer buying choice. Nowadays common market practices such as Apple's retail stores, free trial offers like test driving of cars are in practice to engage consumers through sensory touch experience.¹¹¹ But it can be seen that despite having an important role in the marketing strategies of business; this form of trademark are recognised only in a few countries.

*"Transforming touch into protectable sensory branding, much as with other non-traditional marks is a multifaceted task. Capturing touch's potency requires the courage to balance need with risk. But for those that dare to think beyond commonplace of a two-dimensional marks, a mark successfully using touch can be met with registrable rewards."*¹¹²

3.5. International Framework of Non-Conventional Trademark:

In the International level, the Paris Convention does not mention the meaning and definition of a trademark, so there is no scope to infer any meaning of non-conventional trademark from the Paris Convention. The convention left it to the national laws of the member countries to the scope and registration process of the trademark.

¹⁰⁸ *supra* note 58.

* The concept of functionality will be discussed under chapter IV.

¹⁰⁹ U.S.A Reg. No 2,263,903.

¹¹⁰The International Trademark Association (INTA) is a non-profit global association of brand owners and professionals supporting trademarks and other related Intellectual property for the growth of innovation and economic development and consumer trust.

¹¹¹ Christina S. Monteiro, "A Nontraditional Per-Spectrum: The Touch of Trademarks", <http://www.inta.org/INTABulletin/Pages/ANontraditionalPerSpectrum.aspx> (May 26, 2018).

¹¹² *Ibid.*

The Madrid Agreement on the International Registration of Trademark and Madrid protocol also does not conclusively define the trademark. But currently, it is possible to register all forms of a trademark under the Madrid Agreement.¹¹³

With this regard The TRIPS agreement provides an open-ended definition of a trademark; thereby giving a scope for the inclusion of non-conventional trademark.¹¹⁴ Article 15 of the TRIPS acknowledges that " Any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark. Such signs, in particular words including personal names, letters, numerals, figurative elements and combinations of colours as well as any combination of such signs, shall be eligible for registration as trademarks."¹¹⁵ This definition provided by the TRIPS agreement is functional in nature, which is based on the distinct function capable of performing by the trademark and it also provides an inclusive broad definition of a trademark. So from this definition, it can be concluded that the TRIPS Agreement does not exclude the non-conventional trademark from its scope of what can be a trademark. Article 15.1 further states that "Members may require, as a condition of registration, that signs be visually perceptible."¹¹⁶ Thereby leave it to the member Countries whether they want to limit the scope of the trademark to a visually perceptible trademark or to expand it to non-visual trademarks.

The Singapore Law Treaty on Law of Trademarks (16 March 2009), is the only International framework which expressly provides for the protection of the Non-conventional trademark. It aims to standardize procedure among all regional and national trademark registries without creating an obligation for the protection and registration of the non-conventional trademark in the International level and sets out multilateral framework concerning representation of motion, colour, hologram and position and also of non-visible signs.¹¹⁷

Another significant committee with regard to non-conventional trademark is the WIPO SCT (Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indication. It consists of the representative of WIPO member states and observer organization which deals with the description and possible representation of non-conventional trademark.

¹¹³ Carapeto, *supra* note 57.

¹¹⁴ Dev Gangjee, " Non-Conventional Trademarks In India", <http://docs.manupatra.in/newslines/articles/Upload/BB1047DA-5CCF-41BC-9C82-487F5DC570D3.pdf> (May 20, 2018).

¹¹⁵ Article 15.1 of the TRIPS Agreement.

¹¹⁶ *Ibid.*

¹¹⁷ *supra* note 56.

The report is based on the questionnaire and suggestion on taste mark, sound mark, hologram mark, 3d mark etc. given by the WIPO member countries.¹¹⁸

3.7 Conclusion:

"In order to have a viable future, brands will have to incorporate a brand platform that fully integrates the five senses."

*Martin Lindstrom**

Innovation has the highest amount of valuation in today's world. By arguing in defence of these non-conventional trademarks it can be concluded that these trademarks are of immense importance in today's marketplace and in the business strategy. People continuously use their five senses when have to recognise something like flavour of an ice cream or a particular brand of noodles by its taste or smell food, in, recognise someone by the sound of their voice. Non conventional are developed on the basis of these five senses and are a welcoming development.¹¹⁹ Advertising experts also support this view by stating that "sensory branding" incorporating the five senses of sight, scent, sound, taste, and touch can be quite effective in building a strong brand message and attracting consumers.¹²⁰ As the Branding guru, Martin Lindstrom warns that "if branding wishes to survive another century it will need to change track. Mere communication in an already overcrowded world simply won't do it."¹²¹ So these non-conventional trademarks play a vital role in the modern trends of business.

Although some of these trademarks are not able to be perceived visually as discussed above; but they add an additional value to the product to attract new sets of consumers thereby encourage competitiveness and innovation in the market. These trademarks create an aesthetic effect (attractive and effective designs and create a visual effect being appealing or eye-catching) apart from performing the function which a traditional trademark can perform. So there is no reason to treat these non-conventional trademarks differently from its conventional counterparts. The protection of non-conventional trademarks is also advocated by INTA which stated that "**non-traditional trademarks may function as trademarks and, therefore, in appropriate circumstances should be entitled to trademark recognition, registration and protection.**"¹²²

¹¹⁸ *Ibid.*

¹¹⁹ *supra* note 50.

¹²⁰ Lisa P. Ramsey, "Non-Traditional Trademarks and Inherently Valuable expression", https://papers.ssrn.com/sol3/papers.cfm?abstract_id=3104939, (5 May 2018)

¹²¹ Jerome Gilson and Anne Gilson LaLonde, "Cinnamon Buns, Marching Ducks and Cherry-Scented Racecar Exhaust: Protecting Nontraditional Trademarks", <https://www.brinksgilson.com/files/141.pdf> (May 22, 2018)

¹²² INTA, Non Traditional marks, <https://www.inta.org/Advocacy/Pages/Non-traditionalMarks.aspx> (May 6, 2018).

But it is pertinent to note that this non-conventional trademark is not easy to register and acceptable in most of the countries and has to undergo under constant scrutiny. It might be so because traditionally, these kinds of trademarks are not immediately viewed as a trademark and are not used as a trademark in the course of business. More importantly, a consumer has to understand that mark as the source identifier of the product and able to distinguish it from a similar kind of product. This is because the law of a trademark is concerned with the mind of the Consumer and not the trademark holder.¹²³ But that does not mean that these non-conventional trademarks are not capable to perform the function performed by the traditional types of a trademark. By its capability to attract the human senses it can very well perform the role of a source indicator thereby performs the traditional function of a trademark.

The researcher wants to conclude the chapter with a quote of Rajendra Mishra, General Counsel of Indian Hotels Company Limited (IHCL) made with regard to granting the status of image mark to the Hotel Taj that ***“One look at that property and you know it is the Taj. We don’t even need a signboard over there...that’s exactly what a trademark is...”***¹²⁴

¹²³ *supra* note 104.

¹²⁴ Inika Charles, "Taj Mahal Palace Hotel First Building to Receive Trademark in India", <https://spicyip.com/2017/06/taj-Mahal-palace-hotel-first-building-to-receive-trademark-in-india.html> (May 20, 2018).

CHAPTER IV:

INDIAN POSITION WITH REGARD TO NON-CONVENTIONAL TRADEMARK

4.1 Introduction:

In India, the existence and the use of a trademark can be traced back to the earliest period of human civilisation. Studies showed that it was the ancient Mohenjo-Daro and Harappa civilisation; where the first use of a trademark was found. In the era of that civilisation at around 2500-3500 BC; the Indus merchants were used to stamped their products with seals.. The use of trademarks can also be found among Sindhus. The Sindhus merchants used to put certain kinds of seal in clay tags as a trademark to label the products manufactured by them.¹²⁵

So far the legislation relating to the trademark in India is concerned; it was the Indian Merchandise Marks Act, 1889 which is considered to be the first legislation on trademark in India. This Act continued for about 51 years. Thereafter, it was replaced by the Trademark Act, 1940. Prior to the enactment of the Trademarks Act, 1940; the disputes relating to the infringement of trademark were decided in the light of the Specific Relief Act, 1877 and the problem relating to registration of trademarks was tackled by obtaining a declaration under the Registration Act, 1908. The Trade Marks Act 1940 for the first time introduced the system of registration of the trademark and provided statutory protection to such registered mark. But with the passage of time and due to the changing economic system of the world, after the Second World War, the Trademarks Act 1940 could not keep pace with the changing times and became obsolete. Therefore it was replaced by the Trade and Merchandise Marks Act 1958.¹²⁶ But a need was felt to make a comprehensive Law to review the 1958 Act to keep pace with the development in trade and commerce and the global trade in order to increase the transfer of technology and investment flows. Further, as India became a party to the TRIPS agreement, it was obligatory to bring the Indian trademark law in conformity with the provisions of TRIPs agreement. Therefore The Trademark Act, 1999 was enacted which came into force in September 15, 2003 and is the current legislation governing trademarks in India.¹²⁷ The new act, among the other positive changes, provided the scope for protecting

¹²⁵ see Anuradha Maheswari, " Trademark Basics", http://www.wipo.int/edocs/mdocs/sme/en/wipo_smes_hyd_07/wipo_smes_hyd_07_www_91793.pdf, (May 20, 2018).

¹²⁶ Ishtiaque Ahmed, " A Comparative study of Problem of Protection Trademarks in India and the U.S.A", http://shodhganga.inflibnet.ac.in/bitstream/10603/171402/8/08_chapter%202.pdf (20 May 2018).

¹²⁷ *supra* note 8.

non-conventional trademark in India under which a shape of goods, a combination of colours, packaging of goods are expressly provided for registration as trademarks and also provides scope to include other kinds of non-conventional trademarks by virtue of inclusive definition of mark given under the act.¹²⁸

4.2 Concept and Protection of Trademark under the Trademark Act, 1999:

4.2.1 Definition and Scope of trademark:

The Indian Trademark Act, 1999 provides an open-ended definition of the trademark. Section 2(z)(b) of the Act defines Trademark as a mark which has the capability of distinguishing the goods and services from one entity to that of another which may include the shape of goods their packaging, a combination of colours and which can be graphically represented. Further, the act gives an inclusive definition of the mark as a “mark includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination thereof.”¹²⁹ And as per rule 23(2) of the Trademark rules, 2017; an application for registration of a trademark should be able to represent the trademark graphically.^{130*}

The definition of trademark enumerated in the act is an open-ended and much wider in scope; compared to the previous Acts in India. The definition of marks under the Trademark Act, 1999 is an inclusive definition whereas 'includes' is generally used as a word of extension but the meaning of a word or is extended when it used the word 'include'. Therefore according to the rule of interpretation of statutes, an inclusive definition is broad enough and open-ended to include other relevant things apart from what is mention in the definition.¹³¹ Therefore provides a scope to include different kinds non-conventional under it; though not specifically mentioned.

4.3 Non-conventional Trademark in India-An Overview:

In India, although the scope of the non-conventional trademark has not been defined, some visible form of a non-conventional trademark is expressly mentioned for registration like the shape of goods, packaging and combination of colour. However, there is no mention of the non-visible non-conventional trademark such as tactile mark, gustatory mark, olfactory mark and also some other visual form such as moving image, hologram, and gesture marks. But

¹²⁸ Madhu Rewari, "Redefining Brand Identity in India", https://www.inta.org/INTABulletin/Pages/Brand_Identity_in_India_7217.aspx(May 6, 2018).

¹²⁹ Section 2(m) of The Trademark Act, 1999.

¹³⁰ Rule 23(2) of Trademark rules, 2017.

¹³¹ *supra*, note 68.

from the inclusive definition of a mark provided under section 2(m), it cannot be said that non-conventional trademark is excluded from the purview of Indian Trademark Law, provided they fulfil the criteria of distinctiveness and graphical representation. This definition reveals the intention of the legislature to give a flexible scope for protection of trademark to as to enable India to keep pace with the global trade.¹³² In addition to the Trademark Act, rule 26 of the trademark rules 2017 laid down the requirement and the manner in which an application for registration of a non-conventional trademark can be filed at the office of the Controller General of Patent, Designs and Trademark (CGPDTM).

In the Recent years, various companies applied to Indian Trademark registry and approach to Courts for the protection of shapes, taste, texture, taste, short cartoons, single colours, technical concept and movements as a trademark. This urge to protect the non-conventional trademark is due to the "abstract legal definition of a trademark under the Trademark Act, 1999. While on one hand it has given an open-ended inclusive definition of trademark that emphasis on functional rather than ontological status of a sign; which distinguish the goods and services from those of other similar business in the course of trade, while on the other hand, it stipulates the strict requirement of graphical representation of the trademark in order to register it. In addition to that; our registration system historically revolved around a traditional trademark that is visually perceptible such as word, figurative devices. So there is a need to reconcile these conflicting interests in order to protect the non-conventional trademarks under the Intellectual property regime."¹³³

Since the Trade Mark Act does not define graphical representation, a Draft Trade Marks Manual was released, outlining the practices and procedures in the examination of non-traditional marks. The manual recognizes a wide range of non-traditional trademarks, such as colour marks, sound marks, shapes of goods or packaging, smell marks, and hologram mark. The manual sets out a detailed process of filing applications for non-traditional trademarks for the successful registration of a non-conventional trademark.¹³⁴

4.4 Recent Growth in India Concerning Non-Conventional Trademark:

Over the past few years with its booming economy, India has become a popular destination for many multinational companies seeking to create profit by creating and developing new markets. With the initiatives of "Creative India: Innovative India" and "Make in India", and

¹³² Madhu Rewari, "Redefining Brand Identity in India", https://www.inta.org/INTABulletin/Pages/Brand_Identity_in_India_7217.aspx(May 6, 2018).

¹³³ *supra* note 114.

¹³⁴ *supra* note 132.

the National IPR Policy 2016, Government of India has been trying to promote Intellectual property Rights in India and in making India a knowledge-driven and pro-IP economy by protecting and promoting innovation.¹³⁵ Recently a MoU was signed in March 2018 between Canada and India to promote innovation and creativity for the economic developments of both the countries.¹³⁶ In addition to that, the role of trademark registry in the recent years is also commendable, starting from increasing the manpower, technological advancement starting from electronic service of examination, automated registration certificate, and most importantly effort in clearing the massive backlog application for trademark registration, faster processing of trademark application.¹³⁷

In case of non-conventional trademark, there is a wider acceptance by the trademark registry by granting registration to sound mark, colour mark, shape mark, image mark.¹³⁸ In 2008, Indian trademark registry registered the sound mark (yahoo's yodel) for yahoo¹³⁹ thus became the first Country in Asia to grant sound trademark, which is followed by the recognition of shape mark Allianz Aktiengesellschaft¹⁴⁰.

The most recent and a new direction of Indian trademark law towards non conventional trademark can be seen 2017, when the Indian Trademark registry registered the Hotel Taj Mahal Palace in Mumbai, the most recognizable and the over 100-year-old building in India as "image mark" under class 43 of Niche classification for services of drink and food, temporary accommodation on the ground of acquired distinctive.¹⁴¹ Thus Hotel Taj becomes the first private hotel in India to get a trademark for its architectural design. Hotel Taj has a high level of distinctiveness not only in India but in the whole world and people around the globe can easily identify the building; that it is the five-star hotel Taj Palace and able to associate the mark with goods and services from there. Thus it becomes Evident that Indian

¹³⁵ Asia IP, "Recent Advances in the Indian Trademarks Office And The Way Forward", <http://updates.anandandanand.com/recent-advances-indian-trademarks-office/>, (May 6, 2018).

¹³⁶ Capital Market, " Cabinet approves MoU between India and Canada on IPRs", http://www.business-standard.com/article/news-cm/cabinet-approves-mou-between-india-and-canada-on-iprs-118032900171_1.html (May 31, 2018). MoU available at <http://pib.nic.in/newsite/PrintRelease.aspx?relid=178179>.

¹³⁷ Ibid. also see Annual Report of the Office of the Controller General Of Patents, designs and Trademarks (2016-2017) p. 7 available at http://www.ipindia.nic.in/writereaddata/Portal/IPOAnnualReport/1_94_1_1_79_1_Annual_Report-2016-17_English.pdf

¹³⁸ *supra* note 135.

¹³⁹ Shamnad Basheer, " Breaking News; India's First Sound mark Registered", <https://spicyip.com/2008/08/breaking-news-India's-first-sound-mark.html> (May 22, 2018).

¹⁴⁰ *Ibid.*

¹⁴¹ Praveen Anand and Geetanjali Vishwanathan, " Trademarking the Taj", <https://www.vantageasia.com/trademarking-the-taj/> (May 22, 2018).

trademark legislation is flexible in accepting these modern-day marks provided they are capable of fulfilling the registration requirement.^{142*}

4.5 Judicial Approach in India in Case of Non-Conventional Trademark:

With the increasing use of a unique and innovative way to attract consumers by business entities; the recognition and protection of non-conventional trademarks becomes a very important issue. Indian Judiciary adopted a very cautious approach while dealing with the cases pertaining to non-conventional trademarks. There are various judicial precedents in India where Courts have taken a liberal view and given recognition to some of the non-conventional trademarks.¹⁴³

In the Case of *Christian Louboutin Sas v. Nakul Bajaj*¹⁴⁴, The Delhi High Court recognised the red colour sole used in popular Christian Louboutin shoes; as a distinctive feature of the product and recognized that colour as the trademark of the Christian Louboutin shoes, thus paved the way for recognition of single colour trademark in India.

In *Cadbury India Ltd. V. Neeraj Food Products*¹⁴⁵ Cadbury filed a case against Neeraj food products on the ground that the product named James Bond chocolate of Neeraj Food products was similar in nature to the chocolate produced by Cadbury under the registered Trademark GEMS. In this case apart from holding that the trademark used by the Neeraj food product was phonetically similar to that of the plaintiff, the Court also hold that the packaging of the product used by the Neeraj food products was deceptively similar to that of Cadbury; hence granted an injunction restraining the Neeraj food products from using the mark GEMS BOND as well packaging similar to Cadbury.¹⁴⁶

Recognising packaging of a product; the Delhi High Court in the case of *ITC Ltd. v. Britannia Industries Ltd.*¹⁴⁷. The High Court of Delhi granted an injunction in favour of ITC, restraining Britannia from using the wrapper similar to the ITC's.¹⁴⁸ Pertaining to shape marks, in the case of *Gorbatschow Wodka KG V. John Distilleries Limited*¹⁴⁹, where John Distillers Limited had adopted a deceptive variation of the shape of the bottle produced by Gorbatschow Wodka KG to contain its vodka; The Bombay High Court by recognising shape

¹⁴² *supra*, note 124.

¹⁴³ *supra*, note 134.

¹⁴⁴ 2014 (60) PTC 8 (Del).

¹⁴⁵ 142 (2007) DLT 724.

¹⁴⁶ see *supra* note 143.

¹⁴⁷ 233(2016)DLT259.

* The procedural requirements will be elaborately discussed under Para 4.6 of this chapter.

¹⁴⁸ see *supra* note 27.

¹⁴⁹ 2011 (47) PTC 100 (Bom).

of the bottle used by Gorbatschow as trademark, observed that- by using a similar shape of a bottle, a considerable number of consumers were tricked into believing that the product of John Distillers had originated from or had some association with Gorbatschow Wodka KG.¹⁵⁰ In a recent case, *Ferro Spa & Nr. v. M/S Ruchi International & Anr.*¹⁵¹ Delhi High Court on 2nd April, 2018 had granted a temporary injunction in favour of the plaintiff and also imposed damages of 10 Lac on the defendant for infringing the trade dress of the plaintiff. In this case, the defendant's chocolate Golden passion's trade dress was similar to the trade dress used by one of the biggest confectionary producing company of the world Ferro Group's Ferro-Rocher Chocolate; which has been available in India for a considerable period of time and also has a strong consumer.¹⁵²

4.6 Procedural requirement and Difficulty in registering Non-conventional trademarks in India:

The definition of trademark under the trademark act is inclusive and therefore there is no reason why non-conventional trademark cannot be protected under the Act.¹⁵³ But in order to get registered as a trademark; it has to fulfil certain procedural requirements. However, there are several hindrances which makes non-conventional trademark difficult to get registered. These difficulties are the criteria of:

- Distinctiveness and
- Graphical representation.¹⁵⁴

According to the definition of trademark under the Trademark Act, 1999 and trademark rule; a trademark in order to get registered should be distinctive in nature and should be capable for graphical representation. These two requirement causes hindrance to an extent in registering some of the important forms of non-conventional trademark in India. So in order to deal with this requirement, it is important to understand the concept of distinctiveness and graphical representation in details.

¹⁵⁰ *Ibid.*

¹⁵¹ CS(COMM) 76/2018.

¹⁵² *see* indiankanoon, [https://indiankanoon.org/doc/98126141/\(May 22, 2018\)](https://indiankanoon.org/doc/98126141/(May 22, 2018)).

¹⁵³ *supra* note 69.

¹⁵⁴ *Ibid.*

4.6.1 Distinctiveness:

As mentioned earlier, distinctiveness is the primary requirement of a trademark. The word 'distinctive' means that the mark has the ability to distinguish a product of one proprietor from that of another. Generally distinctiveness means some quality which marked the goods from those of others. In *Imperial Tobacco v. Registrar of Trademarks*,¹⁵⁵ Court held that "A trademark is considered as distinctive, if goods identified by it would for that reason be thought by the relevant class of persons or at least a significant proportion thereof to have come directly or indirectly for one and the same undertaking."¹⁵⁶

4.6.1.1 Types of Distinctiveness:

Distinctiveness is of two types:

- Inherent distinctiveness
- Acquired distinctiveness

Inherent distinctiveness means that; a mark of the product has some inherent qualities or a natural characteristic which makes it distinctive or capable of distinguishing the goods from that of another person.¹⁵⁷ For example the colour purple for a chocolate product.¹⁵⁸ While acquired distinctiveness means that the product doesn't have any inherent character which makes it distinct but acquired a distinct character during the course of trade over a span of time. For example, a green colour used for the packaging of a herbal product is not inherently distinctive but over the course of time it can acquire distinctiveness when people starts associating that green colour in relation to that herbal product.

While the concept of distinctiveness is enumerated under section 9 of the Trademark Act, 1999, which provides that "a trade mark shall not be refused registration if before the date of application for registration it has acquired a distinctive character as a result of the use made of it."¹⁵⁹ In addition to that; section 32 of the Act states that if a mark has been wrongly registered or if it lacks inherent distinctiveness, it shall not be declared invalid if the mark has acquired its distinctiveness after the registration and before the commencement of any legal proceeding against it ; challenging the validity of its registration.¹⁶⁰

¹⁵⁵ AIR 1977 Cal 413.

¹⁵⁶ [2000] R.P.C 893.

¹⁵⁷ *supra* note 8.

¹⁵⁸ Dr. B.L. Wadhwa, LAW RELATING TO INTELLECTUAL PROPERTY, 5th ed. 2011, p.135

¹⁵⁹ Section 9(1) of the Trademark Act 1999.

Are non conventional trademarks are distinctive?

In case of a non-conventional trademark especially single colour mark, olfactory mark, taste mark, touch marks, often question arises is that- whether these trademarks are distinct in nature? It is argued that smell and sounds are often is the result of the feature of the product or even essential to the product; so therefore is not distinctive. For example, the smell of Asian paint cannot be trademarked because it is a smell common to all paints and is the consequence of its composition. But the consumers may associate a certain smell with a product, like rose fragrance with the Sumitomo tyres and hence they are liable to protect as a trademark. This conflict can only be solved on a case to case basis and it is not possible to make a general notion that non-conventional trademark should not be registered as a trademark on account of lack of distinctiveness.¹⁶¹

4.6.2 Graphical representation:

Another and the most crucial requirement to register a trademark is that it should be capable of graphical representation. The graphical representation must enable the sign to be visually represented; particularly by means of images, lines or characters so that it can be precisely identified.¹⁶²Section 2(1)(k) of the trademark rule, 2017 states that "graphical representation means the representation of a trademark for goods and service in the paper form and includes representation in the digitised form."¹⁶³It is the *sine qua non* for the registration of a trademark under the trademark act. Even if a trademark has sufficient distinctiveness it will not get registered if it not capable of being put on the application for registration in a physical form and not able to publish in the trademark journal.¹⁶⁴ In order to get registered as a trademark, the applicant has to file a proper and precise graphic representation. It provides point of reference showing exactly what a trademark is.

However it is pertinent to note that in the global trademark regime, the graphical representation is not mandatory under the TRIPS agreement.¹⁶⁵

This graphical representation based system is justified on the basis that "*It enables those engaged in trades and the public to discover quickly and cheaply which signs third parties have already claimed.*"¹⁶⁶The Indian registration system, therefore, maintain a register which

¹⁶¹ *supra*, note 50.

¹⁶² K.C Kailasam," VENKATESWARAN ON LAW OF TRADEMARKS AND PASSING OFF", 6 ed. 2015, p. 113.

¹⁶³ section 2(i)(k) of The Trademark Act,1999.

¹⁶⁴ *supra*, note 69.

¹⁶⁵ *supra*, note 108.

¹⁶⁶ *supra*, note 114.

contains accurate information about the mark and that is why graphical representation requirement becomes relevant.¹⁶⁷ On another ground, this requirement is justified because it provides an evidentiary benefit in maintaining a case under section 29 of the Trademark Act, 1999. That is why graphical representation requirement is given importance under the Indian trademark regime.¹⁶⁸

Graphical representation is the first set of challenges when an application is filed to register a non-conventional subject matter as a trademark. While some of the visible non-conventional trademarks can be easily meet this criterion; but how one can graphically represent a fragrance a particular product, taste of a product or a sound in words and drawings. Graphical representation along with the criteria of distinctiveness may possess a real obstacle in registering a non-conventional trademark. But these are actually a practical difficulty and not a legal impediment.¹⁶⁹

4.7 Status of Non -Conventional Trademark in India:

In the recent years, it can be seen that Indian trademark registry has registered many of the non-conventional trademarks under various categories of marks. In this section, the researcher will discuss these trademark and issues taken into consideration while granting registration to these non-conventional trademark.

4.7.1 Colour trademark: In India, colour mark can be considered as the most common form of non-conventional trademark. Under section 2(zb) of the Trademark Act, 1999 'combination of colours' is specifically mention to be considered as a trademark and rule 26(2) of Trademark Rule 2017 lays down that an application for registration of combination of colour shall be accompanied with the reproduction of the trademark in that combination of colours. For a combination of colour to be protected as a trademark, it should pass the test of distinctiveness under section 9(1)(a) of the Trademark Act, 1999. The registration of colour mark will depend upon their uniqueness and how they are used in relation to goods and services. When application based on merely on colour applied to the packaging of the goods it has to be shown that how unusual the combination in relation to the goods.

The Draft Manual; on Trademark Practice and Procedure, 2015; apart from dealing with the combination of colour; dealt with the registration of single colour as a trademark which depends upon the acquired distinctiveness. With regard to the Single colour as trademark, the

¹⁶⁷ *Ibid.*

¹⁶⁸ *supra*, note 69.

¹⁶⁹ *Ibid.*

draft manual stated that "A single colour may be registered able as a trademark if it is very unusual and peculiar in a trade and is recognized by traders and consumers alike that it serves as a badge of origin for that class of goods. As colour *per se* is not normally used by traders as a means of brand identification, unlike words or pictures, consumers are not in the habit of making assumptions about the origin of goods and services based solely on their colour or the colour of their packaging. It follows therefore that single colours will only in exceptional circumstances be capable of denoting the origin of a product or service. Marks consisting of a single colour will usually be liable to objection under Section 9(1) (a) of the Act because they inherently lack the capacity to distinguish."¹⁷⁰

Till 2018, a shade of Pink Colour mark For Deutsche Telecom Ag.¹⁷¹, a combination of green and blue Colours as a device mark for Standard Chartered Bank was registered in India¹⁷² Indian trademark registry has registered a brown colour shade mark for VICTORINOX AG.¹⁷³ Apart from that; judicial recognition was granted to a green and yellow colour scheme trademark for the corporation John Deere in the case of *Deere and Co. and Ors. v. S. Harcharan Singh and Ors*¹⁷⁴, In *Colgate Palmolive Company v. Anchor Health and Beauty care Pvt Ltd.*¹⁷⁵ the Court held that "a colour combination is a trademark under the act, as the act's definition includes no exclusion and even a single colour is entitled to protection under the law of passing off." This dispute concerned the defendant's red and white colour combination for dental products, which was similar to the colour combination of one-third red and two-thirds white on the plaintiff's product container.¹⁷⁶

For colours, we should not presume instantly that such mark would operate as a trademark because "there is a public interest involved in not limiting the availability of Colours for other Trademarks."¹⁷⁷ Therefore Courts and trademark registry should adopt a careful approach while granting protection to Colour trademarks. Another issue is that -possibility of future litigation in case of colour trademark; with regard to functional aspect of it*, For example, colour pink used for human dressing, green for tea packaging. These types of colours should

¹⁷⁰ Draft Manual of Trademark Practice and Procedure 2015, http://ipindia.nic.in/writereaddata/Portal/IPOGuidelinesManuals/1_32_1_tmr-draft-manual.pdf (May 22, 2018)

¹⁷¹ Registration no 1462271 in Class 38.

¹⁷² Registration No 1656431.

¹⁷³ Registration No 1394234 in Class 08.

¹⁷⁴ 2015 (63) PTC 433 Del.

¹⁷⁵ 2003 (27) PTC 478 Del.

¹⁷⁶ lexicology, "India: a Shift In Protection Non-traditional Trademarks", <https://www.lexology.com/library/detail.aspx?g=95c2ba66-dea8-40bd-9fd2-3f2f824a4197> (May 22, 2018).

¹⁷⁷ *supra*, note 114.

not be registered and even if it is registered; the others involving in the same business should be allowed to use it in a descriptive manner. Under The Indian trademark law the doctrine of functionality only applies to objection for shape and not for colour. So granting a colour trademark which is functional in nature can give rise to litigation.¹⁷⁸

From an economic perspective, it can be assumed that role of colour in brand development makes it utmost important for the Indian legal system to protect even the single colour under the Indian trademark law. However, we cannot ignore the conflict which can arise because of what we called as "consumer recognition and technological identification". Therefore a cautious approach should be taken by the authorities while granting registration to colours that might get separated by Pantone or RAL, but it may appear same to a consumer.¹⁷⁹

4.7.2 Sound Mark:

Sound marks are the mostly registered non-conventional trademark in India. While the Indian Trademark Act does not expressly exclude the sound mark from the purview of trademark, Indian trademark registry was hesitant to allow the sound trademark protection .But in 2008 India took a paradigm shift by granting trademark registration to the three note YAHOO'S yodel¹⁸⁰ (human voice yodelling the word yahoo) to Sunnyvale, California-based Internet firm Yahoo Inc.'s three-note Yahoo yodel by the Delhi branch of the Trademark Registry. It was registered in classes 35, 38 and 42 for a series of goods including email, advertising and business services and managing websites.¹⁸¹ It was presented through musical notes.

By granting the sound trademark, India became the first country in Asia to grant a trademark protection to sound mark.¹⁸² This was followed by sound mark registration of Allianz Aktiengesellschaft, a German Company. By registering its corporate Jingle 'dhin chik dhin chik',¹⁸³ ICICI Bank became the first Indian business entity to get a sound mark registration. Another sound mark registration was the Nokia tune sound mark registration¹⁸⁴ and the

¹⁷⁸ *Id.* at 87.

¹⁷⁹ *supra* note 98.

¹⁸⁰ Registration No. 1270406.

¹⁸¹ Nishith Desai Associate,"

http://www.nishithdesai.com/fileadmin/user_upload/pdfs/Research%20Papers/Intellectual_Property_Law_in_India.pdf (May 10, 2018).

*The concept of Functionality will be discussed under chapter V.

¹⁸² Anand & Anand," Flashback: Yahoo Gets Its Yodel", <http://updates.anandanand.com/flashback-yahoo-gets-its-yodel/>(May 10, 2018).

¹⁸³ Registration No: 1807773.

¹⁸⁴ Registration No: 1365394.

famous sound used in the advertisement of Britannia biscuit. The most recent sound mark registered was of National stock exchange's theme song.¹⁸⁵

While previously, the only way to represent a sound mark was the graphical representation; with the enactment of Trademark Rule, 2017 India took a new shift by incorporating "representing in the digitized form" for registration of sound mark,¹⁸⁶ thereby paving the way to easily register a sound mark, which can be avail by submitting a mp3 form of the sound along with the graphical representation of it.¹⁸⁷ Further section 26(5) of the rule expressly provided that "*in the application for sound mark registration, the sound can be represented in the MP3 format which is recorded in a medium allows for a clear and audible replaying along with the graphical representation of musical notation.*"¹⁸⁸

From the point of distinctiveness of sound mark the Draft Manual specified that "The acceptability of a sound mark must, like words or other types of trademarks, depend upon whether the sound is or has become a distinctive mark; i.e. whether the average consumer will perceive the sound as a source indicator. Prima facie, no sound marks will qualify for acceptance without evidence of factual distinctiveness. In particular, the following sounds may not be accepted for registration as trademarks since these are incapable of distinguishing goods or services of one person from those of others-

- Very simple pieces of music consisting only of only 1 or 2 notes;
- Songs commonly used as chimes;
- Well known popular music in respect of entertainment services, park services;
- Children's nursery rhymes, for goods or services aimed at children;
- Music strongly associated with particular regions or countries for the type of goods/services originating from or provided in that area."¹⁸⁹

4.7.3 Shape and Trade Dress:

Under the Indian Trademark Act, the shape of goods and packaging of colours is specifically mentioned to be protected as a trademark. In case of shape mark, there is no issue with graphical representation; as it can be easily represented graphically with the photographs of it. However, issue arises with distinctiveness and functionality. Starting with distinctiveness,

¹⁸⁵ Registration no 2152242.

¹⁸⁶ *supra* note 98.

¹⁸⁷ Rule 2(k) of The Trademark Rule, 2017.

¹⁸⁸ Rule 26 of *Ibid.*

¹⁸⁹ *supra* note 170..

as enumerated in section 9 of the Trademark Act; a shape mark can't be registered if it lacks an inherent distinctiveness, but the same can be registered under the criteria of acquired distinctiveness. Moving to the functionality issue; certain shape is absolutely prohibit for registration on the grounds which are mention under section 9(3) as follows: ¹⁹⁰

- **If the shape of goods results from the nature of the goods themselves:**

The purpose of Section 9(3)(a) is to keep available some basic shapes of goods that can be used by the other competitors in the market.

- **The shape of goods necessary to obtain a technical result:** Means the mark should not have any functional efficacy.

- **The shape which gives substantial value to the product:** According to the Draft manual "This subsection deals with shapes which add substantial value to the goods, disregarding the main function attributable to a trademark i.e. source identification function"¹⁹¹

The first shape mark that was recognized in India was the shape of Zippo Lighters in *Zippo Manufacturing Company v. Anil Moolchandani and Ors.*¹⁹² But the Indian judiciary dealt with trade dress in details in *William Grant & sons ltd v. Mc Dowell &Co ltd*¹⁹³. In this case, Grant filed a suit restrain Mc Dowell From imitating the trade dress of trade dress of GLENFIDDICH Scotch whisky sold in a green bottle bearing a label with distinctive trade dress of black cylindrical cartoons. Plaintiff filed the suit for trademark infringement and passing off against Mc dowel that was using the similar trade dress as of GLENFIDDICH. In this case, the Delhi High Court grant an interim injunction restraining McDowell from dealing in alcoholic beverages marked McDowell's Single Malt Whisky and from using packaging (including bottles, labels and containers) that was a colourable imitation and substantial reproduction of the plaintiff's GLENFIDDICH label.¹⁹⁴

In *M/s Castrol Limited & Anr. vs. Iqbal Singh Chawla & Anr*¹⁹⁵, Castrol sued the defendant for selling 4T oil by the name "Lumax Active" who were said to have to infringe the trademark "Castrol Active" of the plaintiff. The claim was based on its trade dress and shape of the container of the bottle. The Court held that without the trade dress and packaging of both the products there is not any deceptive similarity but with the trade dress and the

¹⁹⁰ see Section 9 (3) of The Trademark Act, 1999.

¹⁹¹ *supra* note 170.

¹⁹² CS(OS) 1355/2006.

¹⁹³ 1997 (17) PTC 134.

¹⁹⁴ Indiankanoon, [https://indiankanoon.org/doc/202693/\(May 22, 2018\)](https://indiankanoon.org/doc/202693/(May 22, 2018)).

¹⁹⁵ CS (OS) 4 of 2011.

packaging it is evident that the defendant intention is to get benefit from the goodwill of the plaintiff's product.¹⁹⁶

3.7.4 Three-dimensional marks and moving image mark: In case of a three-dimensional trademark; the rule 26(3) of the Trademark rule, 2017 provides that the application shall consist of a two-dimensional graphics or photographic reproduction as follows:

- The reproduction should consist of a three-dimensional view of the product.
- In case the reproduction is not sufficient according to the registrar to show the particulars of a three-dimensional mark; he may call upon the applicant to furnish within two months up to five other different views of the trademark and a description by words of the trademark.
- Where the registrar finds that representation under clause (i) and (ii) are not sufficient then, he may call upon the applicant to furnish a specimen of the trademark.

As per the Draft manual "The requirement of distinctiveness for the three-dimensional mark is the same as for other trademarks. However, besides distinctiveness, functionality aspect as per section 9(3) will also arise."¹⁹⁷

Example of a three-dimensional trademark in India is the Lux Soap bar with flowers designed on it. It was registered in 2015.

3.7.5 Smell Mark:

Smell mark is the most unconventional trademark in India. The registration of smell mark in India is difficult due to the requirement of graphical representation and the issue of distinctiveness. The issue of distinctiveness with regard to smell mark is already discussed in the previous chapter. But moreover distinctiveness, the prime hindrance in relation to smell mark registration is the graphical representation. The question always arises that how can one represent a scent in the paper form? But it does not mean that the trademark regime in India does not recognize the importance of smell as a trademark. The draft manual clearly elaborates the importance of smell mark in the modern business. It stated that "As a marketing strategy, manufacturers of goods introduce scents to make their products more pleasant or attractive. These goods can include cleaning preparations, and fabric softeners. Even less obvious goods are now manufactured with particular scents to add to the product's

¹⁹⁶ Gautam Kumar, "India: Protection Of Trade Dress – Developing Jurisprudence", <http://www.mondaq.com/india/x/689348/Trademark/Protection+Of+Trade+Dress+Developing+Jurisprudence> (12 may,2018)

¹⁹⁷ *supra* note 170.

appeal, for example, magazines, pens, paper and erasers." But Regarding its difficulty for registration; the manual further states "whatever may be the case, for the purposes of registration as a trademark, unless the mark is 'graphically represented' it will not be considered to constitute as a trademark."So the manual also primarily emphasised on graphical representation.

In case of smell trademark, the Indian position is derived from that of Europe. In Europe also graphical representation is the prime requirement to register a trademark. In the landmark case *Siekmann v. Deutsches Patent-und Markenamt*¹⁹⁸ the application was to register a smell mark comprised of a chemical substance cinnamic acid methyl ester(chemical formula was provided as $C_6H_5-CH=CHCOOCH_3$). The odour sample was submitted in a container and had described the scent as 'balsamically fruity with a slight hint of cinnamon'. The Court held that the requirement of graphical representation in case of smell mark is not satisfied by a chemical formula, since it is sufficiently intelligible, clear and precise. Moreover a formula doesn't represent an odour but the substance itself. It also held that the deposit of an odour sample does not constitute a graphic representation, as they are not sufficiently stable and durable."

At present there are many countries which provide registration for smell marks such as ;Argentina, Australia, France, Columbia, Costa Rica, Ireland, Italy, Norway, New Zealand, South Africa, Switzerland and UK and the U.S¹⁹⁹

In Australia, The Trademark act 1955 explicitly provides for the registration of scent mark under section 6 of the act.²⁰⁰Under the act, the representation of the mark can be satisfied by a detailed written description. The sample of the smell is not required at the time of filing the application but may be needed during the course of the examination.²⁰¹

In Hong Kong also under section 3 of Trademark ordinance, 2009 trademark includes the smell and it should be capable of representing graphically. Intellectual Property Department, Government of Hong Kong stated that "A chemical formula without words describing what the smell is will not be readily intelligible to persons searching the register of trademarks.

¹⁹⁸ 2003 ETMR 37.

¹⁹⁹ *supra*, note 55.

²⁰⁰ Lorraine M. Fleck," What Makes Sense in One Country May Not in Another: A Survey of Select Jurisdictions re Scent Mark Registration, and a Critique of Scent as Trade- marks", <http://www.copat.de/markenformen/eugh-kom/fleck.pdf> (May 22, 2018).

²⁰¹ Report of APEC Survey on Non-Traditional Trademarks 2008, available at <https://www.apec.org/Publications/2008/04/Report-for-APEC-Survey-on-Non-Traditional-Trade-Marks> (May 22, 2018).

²⁰²"So it can be infer that in Honk Kong the requirement of graphical representation with regard to smell mark can be fulfilled by representing the chemical formula of the scent in a detailed written description.

3.7.6 Taste Mark and Touch Mark:

In case of taste mark also the Indian position is similar to that of smell mark as it is also difficult to represent a taste mark in graphical form. There are countless examples depicting how taste mark is important in identifying a product today. In addition to that; touch mark is also not registered under the Indian Trademark Law. Surprisingly the Draft Manual is also completely silent on these important non-conventional trademarks.

3.7.7 Image Mark:

Image trademark is the new paradigm shift in the Trademark law in India or we can say a new direction to the non-conventional trademark in India. India again became the first Asian country to grant an image trademark when it registered the Iconic Hotel Taj Mahal Palace in Mumbai as the image mark in 2017. The other image trademarks registered around the world are the Eiffel tower in Paris and Opera house in Sydney.

With regard to image trademark, apart from graphical representation- which can be fulfilled by presenting photographs, the image trademark has to be distinctive. Distinctive; in the sense that if someone is in the vicinity of the building or say Taj, they don't need the nameplate to identify that this is the hotel Taj.²⁰³

3.8 Concluding Remark:

From the above chapter it can be concluded that non-conventional trademark is not prohibited from registration or not excluded from the purview of the trademark Act, 1999; due to the non-exhaustive nature of the definition of a mark. In the recent years, India went further in the arena of non-conventional trademark by grating many sound marks, trade dress, colour mark registration. India was the first country to grant sound trademark registration in Asia.²⁰⁴ And most importantly; the feather on the cap was the registration of Hotel Taj Palace of

²⁰² see Cap. 559 Trade Marks Ordinance, https://www.ipd.gov.hk/eng/faq/trademarks/tm_cap559.htm#a25, (13 May 2018)

²⁰³ Sonam Joshi, "How Mumbai's Taj Mahal Hotel Became The First Indian Building To get A Trademark", https://www.huffingtonpost.in/2017/06/20/how-mumbais-taj-mahal-palace-hotel-became-the-first-indian-buil_a_22491458/ (May 27, 2018).

²⁰⁴ *supra* note 128.

Mumbai as the image mark in 2017; which clearly indicate that India no way lagging behind in protecting the non-conventional trademark. Another significant change in the Indian trademark regime in 2017 is the incorporation of "digitized form" as a form of representing sound trademark under the trademark rule 2017, which is a remarkable step in the field of sound trademark.

However it is pertinent to note that many of the non- conventional trademark like the smell mark, taste mark or the feel mark has not been granted registration in India due to the impediment of graphical representation under the Indian trademark regime. While as the researcher discussed above the Draft Manual has dedicated a few paragraphs dealing with the smell mark registration but unless the provision and suggestion of the manual are not incorporated in the Trademark Act, the position of smell mark registration lies in the midway and we cannot reach to any particular conclusion.²⁰⁵ But despite the criticism regarding graphical representation of smell mark or taste mark in the form of chemical formula or sample or description; some of the recent studies shows that *"it is not impossible to present a scent graphically as each of the compounds in the scent has its own chemical structure and it will react differently if it is subjected to bombardment by a stream of electrons as it will fragment in a particular pattern and leave behind a unique print of the compound. .As it is possible to present a graphical representation of sound through time domain waveform it is possible to represent a smell mark graphically. It shows that there is a possibility for the chemical formula to serve as a sample of a particular olfactory mark as it enables any person to recreate the mark, thus overcoming the issue of an odour sample decaying over time."*²⁰⁶ So applying these analytical techniques of chemical compounds we can assume that this sensory trademark may be represented graphically. But these analytical techniques are not yet applied in any country so far.

Further solving the issue that- smell mark is difficult to differentiate; a precise "odour matrix" similar to the Pantone system of differentiating colour can be used for classification and identification of smell mark.²⁰⁷ Another way for registration of these smell and taste marks is that registration procedures of these types of marks should be differentiated from those of the others. As for example to protect a word we have to represent the word, similarly keeping in

²⁰⁵ Abhijeet Kumar, " Protecting Smell mark: Breaking Conventionality", <http://nopr.niscair.res.in/bitstream/123456789/34726/1/JIPR%2021%283%29%20129-139.pdf>(13 May 2018)

²⁰⁶ Kherk Ying Chew, Future Development for Olfactory Mark In Australia, <https://www.bakermckenzie.com/en/insight/publications/2018/04/future-development-for-olfactory-marks-in-malaysia> (May 13, 2018).

²⁰⁷ *Supra*, note 69.

mind the nature of the trademark and its senses, the representation of these mark should be treated differently like the description of scent with its chemical formula should suffice the graphical representation requirement.

Dealing with the impediment of graphical representation, EU took a welcoming step in 2017. In EU from 1 October 2017, the graphical representation requirement is not necessary for the registration of a trademark and that the mark can be represented by means of available technology.²⁰⁸

Non-conventional trademark is gaining recognition in India but the laws and the procedure with regard to it are still in the developing stage. However, it is pertinent to note that Indian judiciary is keen towards recognition of non-conventional trademark. In many cases, court had recognized shape mark, trade dress, and colour mark. As these non-conventional trademarks found protection, it is hopeful that the smell mark, taste mark, feels mark will also get the same recognition in upcoming years.²⁰⁹ Further, it is important to understand that; unable to register these trademarks are only a practical difficulty and not a legal impediment. So by Technological development and scientific analytical techniques these issues can be resolved in India.

²⁰⁸ Rebecca Atkins, "European Trade Mark Reform Round Up – Removal Of The Requirement For Graphical Representation", <http://www.mondaq.com/uk/x/683274/Trademark/European+Trade+Mark+Reform+Round+Up+Removal+Of+The+Requirement+For+Graphical+Representation> (May 13, 2018).

²⁰⁹ *supra*, note 204.

CHAPTER V

UNITED STATE APPROACH TO NON-CONVENTIONAL TRADEMARK

5.1 Introduction:

In the U.S.A; the history of a trademark can be traced back to the state Common Law which provided protection to the trademarks. It was only in July 1870 when the Federal Trademark Act was enacted to protect the trademarks. The 1870 act was the first law in U.S.A dealing with the trademarks. But the problem to the act came when in 1897 the U.S.A Supreme Court declared that the law was in conflict with the provisions of the Patent in the U.S.A Constitution and therefore unconstitutional. So in the place of this act, a trademark law was enacted on March 3, 1881, which dealt with the trademark used in the interstate commerce as well as commerce with Indian tribes and based on the interstate commerce clause in the U.S.A Constitution. But this law too was not able to deal with the changing development in the field of trade and commerce, and therefore had to undergone major amendments in the year 1905. Finally, on 5th of July 1946, the Lanham Act was passed which is the governing statute of trademark in the U.S.A. Today The Lanham act provides the most extensive protection to the trademark although state common law is still available.²¹⁰ The Lanham Act was named after a member of Congress who had completely devoted himself to the enactment of the act.²¹¹

The United States Patent and Trademark Office (USPTO), is the federal agency which govern the registration of trademark and grants of patent by virtue of Article 1, section 8, clause 8 of the U.S.A Constitution which provides that the legislative branch promotes the science and arts by granting the exclusive right to the authors and inventors for a limited time period to secure their respective creation.²¹² It provides a nationwide protection for the trademark and it is the prima facie evidence of its validity.²¹³

²¹⁰ Nidhi Hriday Buch, " A study of jurisdictional issues in the post trips in regeime in India with particular reference to trademark violation", http://shodhganga.inflibnet.ac.in/bitstream/10603/68188/13/13_chapter%205.pdf (May 29, 2018).

²¹¹ *supra*, note 126.

²¹² USPTO, <https://www.uspto.gov/about-us> (May 23, 2018).

²¹³ Kexin Li, " Where Is The Right Balance?-Exploring The Current Regulation On Nontraditional Three-Dimensional Trademark Registration In The United States, The European Union, Japan and China", <https://hosted.law.wisc.edu/wordpress/wilj/files/2013/01/Li.pdf> (May 23, 2018).

5.2 The Concept of Trademark under the Lanham Act, 1940:

In the United States, Section 45 of the Lanham Act defines trademark as 'The Trademark includes any word, name, symbol, or device or any combination thereof- which is used by a person or which a person has a bona fide intention to use in commerce to identify his or her goods and distinguish the goods, including a unique product, from those manufactured and sold by others and to indicate the source of the goods, even if that source is unknown.'²¹⁴ So the definition of trademark given under the Lanham Act is an inclusive and broad definition; and not strictly includes only those mentioned under it. The only requirement under the section is that the mark should be used in the course of commerce and should have the capability of distinguishing the goods.

But the scope of trademark took a new direction with the landmark case of *Qualitex Co v. Jacobson Products Co.*²¹⁵ Where the Supreme Court gave the widest interpretation and held that a trademark can be 'almost anything that is capable of carrying meaning'. The case was about the registration of a shade of a 'green colour used in dry cleaning press pads' where the colour had acquired distinctiveness. With regard to this, the Court held that it is the source-distinguishing ability of a sign that permits it to serve as a trademark and not its ontological statuses such as colour, shape, fragrance, word or a sign.²¹⁶ It is recognised as "*the anything goes doctrine*" under the trademark regime. It was the most influential case in the U.S.A which broadened the scope of a trademark and opens the door for the registration of non-conventional trademarks.

Section 1052 of the Lanham Act is the relevant provision which lays down the criteria of what can be trademarked. The provision is negatively worded: it lays down what cannot qualify for a trademark. The only positive requirement is that apart from being non-functional, the mark should be distinctive, or have acquired distinctiveness, enabling consumers to distinguish the goods of the holder from that of others.²¹⁷

5.3 Non-conventional Trademark in the U.S.A -an overview:

In the earlier period of U.S.A, The trademark used in course of trade was only limited to drawing and symbols which was used to identify the potteries, armours and jewellery. In the

²¹⁴ § 45 (15 U.S.A.C. § 1127).

²¹⁵ *Qualitex Co v. Jacobson Products Co.*, 514 US 159 (1995).

²¹⁶ see Brinks Hofer Gilson & Lion, "The sound of Unconventional mark on the United States", <http://www.worldtrademarkreview.com/Magazine/Issue/08/Country-correspondents/United-States-Brinks-> (May 22, 2018).

²¹⁷ see U.S.A. Lanham Act, 15 U.S.A.C. § 1052.

same way, the early trademark legislation in the U.S.A. was only limited to visible form or the conventional form of trademarks. Under the first trademark legislation of U.S.A, 1870; only visually perceptible trademark was capable of registering as a trademark. After that in 1905, Congress amended the law to limit the registration of trademark only to those marks which are inherently distinctive which meant that marks which are descriptive of nature or which marks are not immediately perceived by consumers were not capable of registration. But the Lanham Act brought a new direction to the U.S.A trademark regime. It broadened the scope of a trademark. Under the Act, a trademark which is not inherently distinctive will not be denied registration if it acquires a distinctiveness over time. Most importantly the act broadened the scope of a trademark to protect the non-conventional trademark by giving an inclusive definition of marks; by not expressly excluding the non-conventional trademarks such as sound, smell, taste. So the Lanham Act can be regarded as the milestone in the trademark regime in U.S.A and also with regard to non-conventional trademark. Actually, it was the varied ways of consumer's acceptance according to which the business entities change the branding or the marketing strategy of the good which ultimately results in the change in the law.²¹⁸

As the researcher mentioned in the above paragraph, it was the *Qualitex* case which gave the widest meaning to the concept of the trademark in. Apart from laying down the anything-goes doctrine, it held that it is the source indicating capability of a trademark and not its ontological character as shape, colour, fragrance, a word that serves the basic purpose of a trademark. As far as a trademark can identify the source it can be capable of registration as a trademark, provided it can fulfil the procedural requirement. (The researcher will discuss the procedural requirement of Trademark under U.S.A law in the subsequent paragraph). So trademark was no longer limited to just the visually perceptible form but also expand to the non-visible form such as sound, smell colour and also to the visually perceptible trademark such as a hologram, moving image mark etc.²¹⁹ At present in the U.S.A; sound mark, colour mark, hologram mark, motion mark, gesture, a combination of colour and single colour are capable of trademark registration and a lot of these non-conventional trademarks are already registered.

²¹⁸ Amanda E. Campton," Acquiring a flavor for trademarks: There is no common taste in the World", 8 NJTIP(ISSUE 3), P.343.

<https://scholarlycommons.law.northwestern.edu/cgi/viewcontent.cgi?article=1109&context=njtip> (May 19,2018).

²¹⁹ *Ibid.*

Perhaps the oldest non-conventional trademark to get registration in the U.S.A is the National Broadcasting Company's (NBC) jingle in 1970 under the category of sensory marks.²²⁰

5.3.1 Requirement for Registration of a Non-conventional Trademark:

5.3.1.1 Representation of Non-Conventional Trademark: In the U.S.A trademark (inclusive of non conventional trademark) can be represent in two forms²²¹ :

- Drawing requirement
- Detailed description

In the U.S.A a lot non-conventional trademark need to represent by "drawing requirements". The drawing has to clearly represent the mark sought to be registered. The details of drawing are laid down in TMEP 807. The drawing is required to ensure the nature of the mark and sought to reproduce the mark in the Trademark Official Gazette.²²² But it is pertinent to note that the drawing is not required in case of non-visible non-traditional trademarks i.e. in sound, scent and Flavour. In order to submit an application for registration of this mark, a detailed written description is required which explain the mark in clear terms and in case of the sound mark, an electronic file such as MP3 or the CD or DVD version is required. If a mark comprises of both visual form and non-visual form of the mark then the applicant has to submit a drawing for the visual part and a detailed written description of the non-visual mark. In case a drawing is failed to provide a clear description of the mark the attorney will need further a detailed written description of the mark.²²³

In order to get the registration of the non-conventional mark, the subject matter of the mark should be eligible for registration according to the definition of trademark and it should be associated with good/services. Whether the non-conventional trademark is eligible for registration or not is depend upon two prime factors as follows:

- Distinctiveness
- Doctrine of functionality

²²⁰ Harsimran Kalra, " Unconventional trademarks: the emergent need for a change", http://www.indialawjournal.org/archives/volume4/issue_1/article_by_harsimran.html (May 26, 2018).

²²¹ See TMEP § 807.

²²² *Ibid.*

²²³ *Ibid.* at 2

* The concept of inherent and acquired distinctiveness is already discussed under the chapter IV.

5.3.1.2 Distinctiveness: The first and foremost requirement in order to register a non-conventional trademark in the U.S.A is that the mark should be distinctive in nature. Distinctiveness is of two types:

- Inherent distinctiveness*
- Secondary meaning or acquired distinctiveness*.

The distinctiveness of a mark also includes the question which the U.S.A registry takes into consideration that whether the mark is capable of serving the function of a trademark? That means whether consumers can identify a mark as the source indicating the characteristic of the product or merely identifying as some decorative feature in the product not? The mark should be used in 'manner calculated to project the purchasers or potential purchasers; a single source or origin for the goods in question.'²²⁴ If a mark is used in a manner where the mark does not serve this basic function of trademark, the mark is not capable of registration. In order to ascertain it; the examining authority should look into the overall commercial impression of the mark.²²⁵

With regard to position of distinctiveness under the U.S.A trademark regime, the WIPO's report on U.S.A Trademark regime stated that-"To establish actual evidence that a mark can function as a trademark is to establish its distinctiveness. In order to determine whether a mark is distinctive or not, the determination must be made in relation to the particular goods and service; in relation to which the mark is sought registration and not as a whole. If a mark is per se distinctive it is called inherent distinctiveness. But if a mark sought for registration is not inherently distinctive then the registry will take into consideration the proof of acquired distinctiveness or the secondary meaning. This means that; though the mark is not inherently capable of performing as source indicator or lack of inherent distinctiveness then it has acquired distinctive in the course of its business and the consumers able to identify the mark as the source indicator."²²⁶

This requirement of acquired distinctiveness or secondary meaning is very important in the case of colour, sound, taste and smell marks. U.S court in *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*²²⁷ had explained the concept of acquired distinctiveness as, "to establish secondary meaning, a manufacturer must show that, in the minds of the public, the primary significance of a product feature or term is to identify the source of the product rather than

²²⁴ *In re Remington Products Inc.*, 3 USPQ2d 1714, 1715 (TTAB 1987).

²²⁵ WIPO Document, " Non-Traditional Marks at the U.S.A. Patent and Trademark Office", http://www.wipo.int/export/sites/www/sct/en/comments/pdf/sct17/us_2.pdf

²²⁶ *Ibid.*

²²⁷ 456 U.S.A. 844, 850, n.10, 214 USPQ 1, 4, n.10(1982).

the product itself'. If the applicant can provide substantial evidence that a product though lack of inherent distinctive but has acquired distinctiveness in relation to the concern goods and services; then the mark should be capable of registration.²²⁸ **The acquired distinctiveness also termed as factual distinctiveness.** Distinctiveness is a critical issue in case of the non-conventional trademark. Though some of the visual forms of trademark can be inherently distinctive such moving image but many of the non-conventional trademarks such as colour, some popular kind of sound which is common to all in the course of life, flavour, scent can never be inherently distinctive and therefore the applicant has to prove the acquired distinctiveness.

5.3.1.3 The doctrine of Functionality:

This doctrine enumerates that a trademark will be refused to protection if the feature of the mark is essential to the goods or purpose of the product or if it affects the cost and quality of the product to which it is being applied.²²⁹ In order to determine the functional feature the product, the examining authorities will look into the industry as well as require information from the applicant to determine whether the characteristic or feature of the product is functional in nature and also inquire if the utility patent covers the feature.

The purpose of the doctrine is to encourage the competitiveness in the market by keeping a balance between trademark law and patent law.

As per section 29(e)(5) of the Trademark Act, 15 U.S.A.C. §1052(e) (5) a mark should not be registered if the mark as a whole is functional. Further section 2 (f) of the act provides that the mark may not be registered as a trademark if it is a whole is functional although it has become distinctive. In the U.S.A functionality of a mark is broad prohibition and it is applicable to all categories of marks including non-conventional trademark. This restriction is applicable to both technical features as well as aesthetic features.²³⁰ This functionality doctrine is extremely important in case of a non-conventional trademark in order to register it. For example, an application for the scent of deodorant or air fresheners cannot be granted registration or application to register a sound for a downloadable ringtone cannot be registered as a trademark on the ground of functionality because the proposed mark is essential to the use of the goods. In the case of *In Re vertex Grp.*²³¹ application was rejected

²²⁸ *supra* note 225.

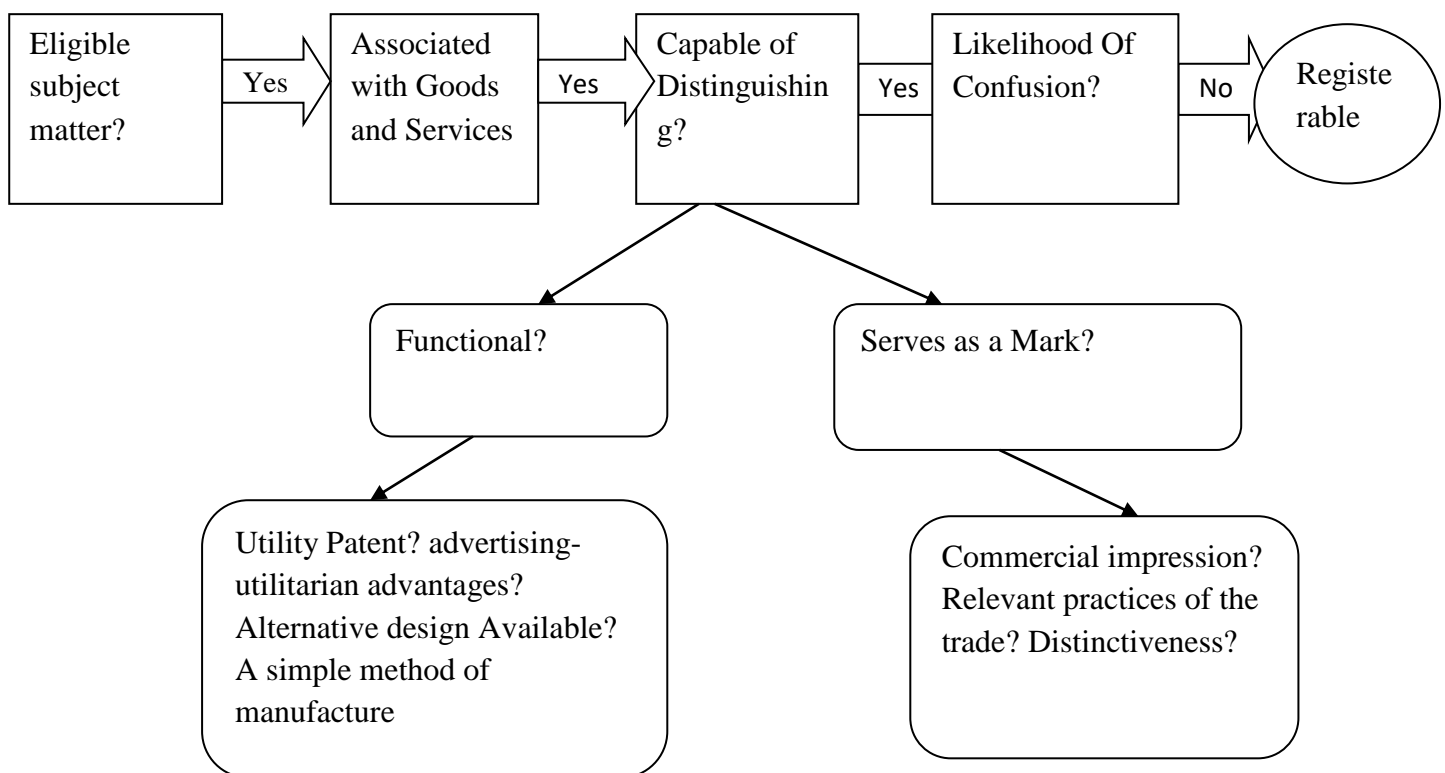
²²⁹ *TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S.A. 23,33, 58 USPQ2d 1001, 1006 (2001);

²³⁰ *supra*, note 114.

²³¹ *LLC*, 89 USPQ2d 1694, 1700 (TTAB 2009).

for a loud sound of the alarm; as evidence showed that use of a loud sound for an alarm is important and granting its registration would affect the other entities engage in the same business. In the case of *In re Florists Transworld Delicery Inc.*,²³² application was rejected for the colour black to be applied in floral packing on the ground of functionality; because it was held that "there was a competitive need for others in the industry to use black in connection with floral arrangement and flowers in order to communicate a desired sentiments or occasion such as elegance, beverage and or Halloween"²³³

This flowchart will depict the procedure that U.S.A Patent and Trademark Office (USPTO) the registration of the non-conventional trademark.



Source: WIPO Document, "Non-Traditional Mark at the U.S.A Patent and Trademark Office"²³⁴

²³² 106 USPQ2d 1784, 1791 (TTAB 2013).

²³³ *Ibid.*

²³⁴ WIPO Document, " Non-Traditional Mark at The U.S.A Patent and Trademark Office", http://www.wipo.int/export/sites/www/sct/en/comments/pdf/sct17/us_2.pdf (May 26, 2018).

5.4 Present status of various Non-Conventional Trademarks in U.S.A:

5.4.1 Colour Marks:

In the U.S.A the combination of colour gets registration upon fulfilling the procedural requirements of non-functionality and distinctiveness. However, the issue and criticism lie in the registration of single colour as a trademark. In *A. Leshen & Sons Rope Co. v. Broderick & Bascom Rope Co.*²³⁵ The Supreme Court denied the recognition of a single colour. This was followed by the *Campbell Soup Co. v. Armour & Co.*²³⁶ In this case, the plaintiff sought an injunction to prohibit the use of red & white labels on food product labels used by the defendant company Armour. In this case; Court of Appeals, the third circuit denied the trademark protection of colour. The Court gave two reasons for it:

- First; that the use of colour is an industry norm and by protecting the single colour trademark of the plaintiff company will lead to monopolization of the red colour which would hinder the competitiveness in the market.²³⁷
- The second reason was the very important ' **colour depletion theory**. Which means that since the range of colour is limited, monopolizing a single colour or to give an exclusive right to a business entity over a single colour will soon deplete the stock of colour and thus will lead to ant competitiveness.²³⁸ Court held that granting a right of a sole colour to plaintiff would deplete the limited available colour and thereby violate the public policy.²³⁹

This judgement was followed by many cases afterwards in which the court upheld the colour depletion theory and denied the trademark registration of single colour.²⁴⁰ Later in *Master Distributions Inc. v. Pako Corpn. (MOT)*²⁴¹, the eight circuit held that "We are not persuaded by the three traditional arguments against the protection-the colour depletion theory, shade confusion theory and the functionality doctrine. Nor we are impressed by the argument that consistency and predictability require a per se prohibition against trademark protection for colour alone. We believe that not allowing manufacturers to protect colour marks when all *the traditional requirements have been made will actually promote inconsistency and*

²³⁵ *A. Leshen v& sons Rope Co. v. Broderick & Bascom Rope Co.*, 50 L Ed 710: 201 US 166, 171 (1906)

²³⁶ 175 F 2d 795, 81 U.S.AP.Q. 430 (3rd cir)cert. denied, 338 US 847, 83 U.S.A.p.q. 543 (1949)

²³⁷ *supra* note 68.

²³⁸ *supra* note 98.

²³⁹ *supra* note 15.

²⁴⁰ *Deere & Co. v. Farmhand Co.*, 560 F supp 85, 217 U.S.A.P.Q 252.

²⁴¹ 61 USLW 2529, 25 U.S.A.P.Q. 2d 1794.

confusion.²⁴² Thus single colour trademark was recognised in the U.S.A. However it is pertinent to note that the colour depletion theory as laid down in the *Campbell case* cannot stand in the present day because of technological development and use of artificial intelligence in U.S.A. Because now it is possible to create different shades of colour as the PANTONE COLOUR CODE; which is able to make a lot of different shade of colours making it possible for trademark registration.

From these above cases it is evident that, judiciary tilted more towards the protection of single colour trademark by narrowing down the factors to be taken into consideration when ascertaining the secondary meaning of the trademark and thereby facilitated the registration of a single colour trademark in the U.S.A.²⁴³ However the present laws states that a mark which is descriptive in nature which describes the intended purpose of the mark, function or use of the goods, characteristics of the product; cannot be protected unless the secondary meaning is proved. So the colour in order to qualify for registration has to acquire distinctiveness or to have a secondary meaning.²⁴⁴ Some examples of registered colour trademark in U.S.A. are Tiffany's blue colour used in its jewellery boxes, and catalogues, Home depot's shade of orange colour for retail home improvement stores, Shade of pink colour used by Owens Corning's insulation products.²⁴⁵ In the case of *Dap Products, Inc. v. Color Tile Mfg*²⁴⁶ a red colour are registered for tile mastic on acquired distinctiveness or secondary meaning ;as the public began to associate that particular colour with goods and services coming from a particular source.²⁴⁷

With regard to representation of the Colour mark, The TMEP provides that all marks other than the scent mark and sound mark would require a drawing. If an application is filed without drawing that will be denied at the filing date.²⁴⁸ The drawing must be substantially the exact representation of the mark used or intended to use.²⁴⁹ The issue of whether the proposed colour mark is functional requires consideration of the manner in which the mark is used.²⁵⁰

²⁴² 61 USLW 2529, 25 U.S.A.P.Q. 2d 1794.

²⁴³ *supra*, note 98.

²⁴⁴ *supra*, note 68, also see *Two Pesos Inc. v. Taco cabana Inc.*, 23 USPQ 2d 1081.

²⁴⁵ Justin M. Jacobson, "A Look at the Non-Traditional Trademarks: Color, Sound & Scent In The United States", <http://www.intellectualpropertyblawg.com/trademarks/non-traditional-trademarks-color-sound-scent-us> (May 22, 2018).

²⁴⁶ *supra*, note 98.

²⁴⁷ *supra*, note 245.

²⁴⁸ TMEP § 1202.05(d).

²⁴⁹ see TMEP § 1202.05(d)(i).

²⁵⁰ TMEP § 1202.05.

5.4.2 Sound Mark:

In the U.S.A; the sound mark registration basically needs that a sound mark should function as a source indicator and that whether the mind of the listeners can immediately associate that sound with the particular goods or service.²⁵¹ Sound mark can include series of a musical note with or without words or words accompanied by music.²⁵² With regard to the representation of the sound mark-if the filing is in the electronic form i.e TEAS application (Trademark Electronic Application System) then have to submit an audio reproduction in electronic file in .wma.,mp3 and when submitted in a paper form application, the reproduction should be in a digital video disc (DVDs) or Compact Disc (CD).²⁵³

A sound which is distinctive in nature can be registered, but when the sound is a commonplace sound like alarm, telephone tone, etc. then proof of acquired distinctiveness is required. Some example of registered sound marks in U.S.A are the the famous lion roar sound of Metro-Goldwyn Mayer, New York stock exchange's bell sound, Tarzan's yell,²⁵⁴ ALFAC insurance's sound of duck quacking the word AFLAC.²⁵⁵ However in the *Kawasaki Motors Corp USA v. Harley Davidson Michigan Inc.*²⁵⁶ the exhausting sound of a motorbike was refused on the ground of functionality and also because it was common to all bikes.

5.4.3 Scent Mark:

In the U.S.A The Trademark Manual of Examining Procedure enumerated provision that a smell mark can be represented by a detailed written description of the mark,²⁵⁷The scent has to be distinctive of the product and should not be functional or utilitarian. For e.g fragrance of a perfume cannot be registered. With regard to smell mark registration in the U.S.A., *In Re Celia Clarke*²⁵⁸, is the first case associated with it. Here the Court recognized that non-

²⁵¹ *supra* note 246.

²⁵² See TMEP § 1202.15.

²⁵³ See TMEP § 807.09

²⁵⁴ *supra* note 251.

²⁵⁵ *Ibid.*

²⁵⁶ 1997 TTAB LEXIS 11 (TTAB 1997).

²⁵⁷ *supra*, note 56.

²⁵⁸ USPQ 2d 1238(1990) (TTAB). "In the said case, the applicant, Celia Clarke, manufactured sewing thread and embroidery yarn. She applied for a mark that she described as "a high impact, fresh, floral fragrance reminiscent of Plumeria blossoms. The Examining Attorney rejected the application on the ground that the mark did not distinguish Clarke's goods from other competitors; that is, the mark did not function as a trademark. Clarke argued that hers was the only scented embroidery yarn, and therefore, was inherently distinctive. The Examining Attorney responded that the scent did not function to indicate origin, rather it was an arbitrary scent to make the product more pleasant. Furthermore, the Examining Attorney noted that Clarke had made no showing that the particular scent indicated origin, nor did Clarke specify a fragrance on the product's packaging. Clarke appealed to the TTAB which reasoned that Clarke was the only manufacturer of yarn with a scent; she advertised her yarn with the scent feature, and she had demonstrated that consumers recognized the scent as an

functional smell marks can be registered as trademarks when it accepted an application for registration of 'a high impact, fresh floral fragrance reminiscent of plumeria blossoms' for sewing thread and embroidery yarn.²⁵⁹ But this Judgement was criticised on the ground that it neglected the ospherosiology or the science of smell and that it ignored many scientific evidence like the effect of humidity and temperature on the strength of a smell, incapability of spectral analysis of smell for registration and that scents do not have independent identity rather have to be associated with some other memories to recall it and also that deletion and detection of smell depend upon Individual health and mental capability.²⁶⁰ But however, this judgement was acknowledged by the Supreme Court in *Qualitex Co. v. Jacobson Products Co. Inc.*²⁶¹ where the court held that "scent marks can be affixed directly to infuse into the product, like the 'Plumeria Blossom' scented yarn or raspberry scented upholstered furniture or could even be fixed in a scratch-and-sniff or scented card".

Therefore it can be inferred that U.S.A is the one of the few jurisdictions in the world in which a smell can be registered without the strict interpretations of graphical representation. As a result, many smell marks are register till now in the U.S.A. These are mainly Eddy Finn Ukulele Company's 'pina colada' smell, Strawberry scented toothbrushes of the Lactona Corporation, Grendene's 'bubble gum' scented foot wares. A more recent example was of Amyris Biotechnologies, In.'s citrus scent for bio fuel.²⁶²

Unlike many other Jurisdiction in the U.S.A also; smell marks registration is not that frequent, it is because the Trademark Manual of Examining Procedure lays down the requirement of substantial evidence to prove distinctiveness.²⁶³ If an applicant is unable to show that a scent has acquired distinctiveness then it can be only registered on supplemental register.²⁶⁴ In *In re Pohl-Boskamp GmbH & Co.*,²⁶⁵ The scent of peppermint for a "pharmaceutical formulation of nitro-glycerine" failed to function as a trademark because of insufficiency of evidence on acquired distinctiveness.²⁶⁶

indicator of origin. Thus, according to the TTAB, these facts presented a "prima facie case of distinctiveness" for the fragrance mark.

²⁵⁹ *supra* note 56.

²⁶⁰ *supra*, note 94.

²⁶¹ 131 L Ed 2d 248: 514 US 159 (1995).

²⁶² Fish & Richardson, "Nontraditional Trademarks: Marketing to the sense with Shape, Color, and More", <https://www.fr.com/news/nontraditional-trademarks-marketing-to-the-senses-with-shape-sound-color-and-more/> (May 28, 2018).

²⁶³ TMEP § 1202.13.

²⁶⁴ *Ibid.*

²⁶⁵ 106 USPQ2d 1042,1052 (TTAB 2013).

²⁶⁶ *see* TMEP § 1202.13

So in the U.S.A, scents that be protected as a trademark as follows:

- The mark should not be functional in nature.
- There should be substantial proof of acquired distinctiveness.
- A detailed written description is required.
- A specimen of the scent can be submit along with the application, e.g. Amyris Corporation soaked some cotton balls in the citrus-scented biofuel and submits the cotton balls with the application.²⁶⁷

5.4.4 Shape Mark:

The shape mark is not expressly defined or mentioned under the Lanham Act. But it constitutes a device or symbol within the meaning of § 2 of the Trademark Act, 1946.²⁶⁸ It is the distinctive appearance of the product inclusive of its wrapper, its colour, its flavour, packaging, a shape of the container, labels used in it and the design of the product.²⁶⁹ But now the trademark practice in the U.S.A included the design and shape of the product under the name "trade dress".²⁷⁰ Shape of the product can itself be a trademark in the U.S.A provided that it is non-functional and acquired distinctiveness.²⁷¹ Because, generally a trade dress is functional; so cannot be protected as a trademark if the feature of that trade dress is essential to the use or purpose of the article or if it affects the cost or quality of the article²⁷² and lacks its inherent distinctiveness. Therefore without having the secondary meaning or acquired distinctiveness, it is not capable of registration.

One of the famous shape trademarks around the world is the shape of the Coca-Cola bottle; which was registered in the U.S.A in 1977. It was reasoned that the shape of the bottle was so popular that people from any corner of the world would recognise the product that it is coming from the source Coca-Cola, therefore has acquired a secondary meaning.²⁷³ In *Gibson Guitar Corp v. Paul Reed Smith Guitars*,²⁷⁴ the Supreme Court described a trade dress as the "design or packaging of the product which has acquired a secondary meaning sufficient to identify the product with its manufacturer or source."²⁷⁵ With regard to the representation of

²⁶⁷ *supra* note 262.

²⁶⁸ 15 U.S.A.C. §1052.

²⁶⁹ *supra* note 94, also see TMEP § 1202.02.

²⁷⁰ *Ibid.*

²⁷¹ *Wal-Mart Stores Inc. v Samara Bros Inc.* 529 US 205,2130214 (2000).

²⁷² TMEP § 1202.02(a).

²⁷³ *supra*, note 269.

²⁷⁴ LP, 423 f 3D 539, 543 (6 the Cir 2005).

²⁷⁵ *supra*, note 273.

the shape mark, TMEP provides that the shape mark should be represented in the form of drawing.²⁷⁶

The criteria of the shape trademark were first laid down in the landmark case *Wal-Mart Stores Inc v Samara Bros Inc*.²⁷⁷ In this case; the Supreme Court held that the design or the shape of the product can never be inherently distinctiveness. So in order to get a trademark registration of the shape mark; it has to fulfil two requirements:

- The first is that shape should be non-functional, that means its feature of the mark should not be the result of the product itself.
- The shape should have a secondary meaning.

While expanding the scope of shape mark or trade dress; the court also recognised that children's outfit constitute a product design, In the *Two Pesos*²⁷⁸ the court even recognised that a restaurant's interior can be termed as a product packaging. Another recent example of shape mark registered in the U.S.A is the shape of the fragrance bottles of the luxury brand *Kenzo*.²⁷⁹

5.4.5 Motion Marks or the Moving Image Mark:

In the U.S.A; a motion mark should be represented by a drawing of a single point of the movement of the mark or five freeze frames depicting the different movement of the mark accompanied with the description of that mark.²⁸⁰ The registration of motion mark is comparatively easy as it does not require acquired distinctiveness and generally it is non-functional in nature.²⁸¹ Some examples of the registered moving image mark in the U.S.A are the 20th century Fox Film Corporation logo with floodlights trailing back and forth across the sky was registered as a trademark in USPTO.²⁸² Another very significant motion mark registered in U.S.A. is the unique motion of opening the door of Lamborghini car.²⁸³

²⁷⁶ see TMEP § 1202.02(c)(i).

²⁷⁷ 529 US 205,2130214 (2000).

²⁷⁸ 505 U.S.A. at 763, 23 USPQ2d at 1081.

²⁷⁹ Kexin Li, "Where Is The Right Balance?-Exploring The Current Regulations On Non-Traditional Three-Dimensional Trademark Registration In The United States, The European Union, Japan and China" <https://hosted.law.wisc.edu/wordpress/wilj/files/2013/01/Li.pdf> (May 22, 2018).

²⁸⁰ 37 CFR §2.52(b)(3) *Motion marks*, TMEP 807.11

²⁸¹ *supra*, note 262.

²⁸² *supra*, note 8.

²⁸³ WIPO document, "Non-Traditional Marks At The U.S.A Patent and Trademark Office", http://www.wipo.int/export/sites/www/sct/en/comments/pdf/sct17/us_2.pdf (May 25, 2018).

5.4.6 Taste Mark:

Taste mark or as the U.S.A refers it 'flavour mark' is difficult to register in the U.S.A. and can be regarded as the most uncommon form of non-conventional trademark. It is treated in the same way as scent mark, because a taste mark can never be inherently distinctive. It generally regarded as the result or characteristic of the goods and it tends to serves a utilitarian purpose rather than indicating a source.²⁸⁴ So to register a scent mark the applicant has to show a substantial proof of acquired distinctive and the non-functional character of the mark.²⁸⁵

According to TMEP, a scent mark can be represented by a detailed written description.²⁸⁶

The significant case with this regard is the *In re N.V Organon*.²⁸⁷ where the application for registering an orange flavour for pharmaceuticals products for human use namely, antidepressants in quick-dissolving tablets and pills was denied registration and held that "It is not clear whether that mark is cable of serving as a source indicator because a flavour mark generally serves a utilitarian function and therefore functional in nature."²⁸⁸ *In the case of In re Pohl-Boskamp GmbH & Co.*²⁸⁹ the application for registration of peppermint flavour for a pharmaceutical product was denied registration on the ground of lack of substantial proof of acquired distinctiveness.²⁹⁰ The Trademark Trial and Appeal Board affirmed the refusal to register on the grounds that the mark was functional and also failed to function as a mark, but did not rule out that taste could never function as a mark.²⁹¹

Currently, the USPTO has no registered taste marks. But that does not mean that a taste mark is not capable of registration in the U.S. provided the mark is distinctive and non-functional.

5.4.7 Hologram Mark:

In the U.S.A the requirement of registration of a hologram mark is that it should have consumer recognition. According to the TMEP; hologram used in varying forms cannot function as a trademark in the absence of evidence that consumer would perceive it as a trademark.²⁹² It also provides that hologram should not show two or more view (different

²⁸⁴ see TMEP § 1202.13

²⁸⁵ TMEP § 1202.13

²⁸⁶ TMEP § 807.09

²⁸⁷ 79 USPQ2d 1639 (TTAB 2006).

²⁸⁸ see TMEP § 1202.13

²⁸⁹ 106 USPQ2d.

²⁹⁰ *Ibid.*

²⁹¹ WIPO document, " Non-Traditional Marks At The U.S.A Patent and Trademark Office", http://www.wipo.int/export/sites/www/sct/en/comments/pdf/sct17/us_2.pdf (May 25, 2018).

²⁹² TMEP § 1202.14

subject matter in each view).²⁹³ If it is so, then the application will be refused on the ground that the applicant seeks registration for more than one mark.²⁹⁴ In the case of *In re Upper Deck Co*,²⁹⁵ it was held that hologram used in the trading card may not serve the function of a trademark because some record showed that other companies were using such hologram for a non-trademark purpose, therefore there was no evidence that public could perceive the hologram as the source indicator.²⁹⁶ However at present, various hologram marks are registered in the U.S.A, For example, the hologram mark registered for the charge and credit card service of the American Express Company.

5.4.8 Texture mark: In the United States, from some recent years texture marks or tactile marks have been driven by fashion and its products.²⁹⁷ In the U.S.A; the basic criteria of a tactile trademark application are:

- The touch mark should be distinctiveness; which can be either inherent distinctiveness or acquired distinctiveness.
- The mark should not be functional in nature. That; it is not the result of a simple or an inexpensive method of production and not protects a utilitarian feature of the product.
- Consumers should be able to identify it as the source indicator of the product and not perceived the mark as a mere ornamentation.²⁹⁸

In order to file an application for registration of touch mark in the U.S.A, the touch mark should be represented by a drawing and a written description.²⁹⁹ Perhaps the earlier touch mark registered in the U.S.A is the 'distinct man-made textured pattern utilized as a surface feature' on luxury line of luggage and related leather products by Louis Vuitton Malletier in 1996. In the same year; the Dooney & Bourke sought to register features of its leather handbags including their "pebble-grained texture". In the aspect of fashion; Christopher Krahenmann, registered a 'raised Braille characters' as touch mark to be used in jewellery.³⁰⁰

²⁹³ *Ibid.*

²⁹⁴ *Ibid.*

²⁹⁵ 59 USPQ2d 1688 (TTAB 2001).

²⁹⁶ see WIPO document, " Non-Traditional Marks At The U.S.A Patent and Trademark Office", http://www.wipo.int/export/sites/www/sct/en/comments/pdf/sct17/us_2.pdf (May 25, 2018).

²⁹⁷ Christina S. Monteiro, " A Non-traditional Per-Spectrum: The Touch of Trademarks", <http://www.inta.org/INTABulletin/Pages/ANontraditionalPerSpectrum.aspx> (May 26, 2018).

²⁹⁸ *Ibid.*

²⁹⁹ *Ibid.*

³⁰⁰ *Ibid.*

Another example is the touch mark of velvety texture on the surface of the wine bottle held by the American Wholesale Wine & Spirits. Inc.³⁰¹

5.5 Conclusion:

The U.S.A has always been a pro-IP Country; and from the above discussion, we can certainly conclude that with regard to trademark; legislation and Courts of the U.S.A has a very welcoming approach. First of all, the Lanham Act gives an inclusive definition of the trademark which lays down that the mark should have a distinctive character and capable of identifying the source of the product. The graphical representation is not the impediment attached to the definition of a trademark. For this inclusive nature of the definition, a non-conventional can be registered under the U.S.A trademark regime. Secondly from the Qualitex Case's "anything goes" doctrine; anything can be a trademark in the U.S.A if it is distinctiveness and non-functional. That is why a lot of non-conventional trademarks had been registered in the U.S.A. Even if the taste mark had not been registered yet or application for registering taste mark was refused, it was not because taste mark could not be registered in the U.S.A. but because the applications were failed in the test of functionality. If a taste mark can fulfil the test of distinctiveness and functionality, it can be registered in the U.S.A. Thirdly, with regard to representation of the mark, U.S.A takes a very appreciable approach where it provides that for visual kinds of non conventional trademark; representation can be in the form of drawing and expressly exclude the non visual trademark i.e. sound, smell, and taste from the representation in the form of drawing. They can be represented by a detailed written description and in case of a sound mark; an electronic file of the sound is required. By demarcating the two types for their representation, U.S.A allows a wide range of non-conventional trademark to be registered under it. So it is the apparent U.S.A has a liberal approach with regard to non-conventional trademark.³⁰²

³⁰¹ *supra*, note 296.

³⁰² *supra*, note 50.

CHAPTER VI

COMPARATIVE ANALYSIS BETWEEN INDIA AND U.S.A

6.1 Introduction:

In the recent years the world has seen a remarkable development in the trademark jurisprudence. Trademark legislation around the globe evolved in way that had allowed the producers, manufactures and business entities to develop their brand strategy for attracting customers toward their goods and services; thereby paving the way to make more profit and establish a reputation in the market. In other terms the trademark protection laws of different country has granted the business entities to engage in a "extreme Branding Strategy" whereby the producer and manufactures target to attract the five senses of human body; by the use of sound, smell, moving image, taste, touch etc and thereby not only restrict the form of a trademark in two dimensional form. So the trademark laws which only considered some symbol, logos or devices act for trademark now started to give the similar kind of recognition to non-conventional trademarks.³⁰³

Among the other Countries in the World; U.S.A and India has also witnessed a radical change in the field of non-conventional trademark. The researcher has chosen U.S.A. for comparative study with India because the U.S.A is a developed country which is known as a 'pro-IP Country.' Non-conventional trademark In the U.S.A had gained recognition in the early 1970's but in India non-conventional trademarks are in the nascent stage. It was only in 2002, when sound trademark got registered in India. A comparative analysis of non-conventional trademark in these two countries will give a comprehensive balanced approach to a better recognition and protection of non-conventional trademark in India in light of the United States.³⁰⁴

6.2 Analysis on the Scope of Non-Conventional Trademarks:

When we analyse the definition of trademark in these two countries, it is evident that both the countries gives an open ended and an inclusive definition of the trademark .Section 45 of the Lanham Act starts the definition of trademark as "a trademark includes....."³⁰⁵ And in India; section 2(zb) of the Trademark Act define trademark as "Trademark as a mark.....which may

³⁰³ *supra*, note 220.

³⁰⁴ *Ibid.*.

³⁰⁵ *supra* note 114.

include...³⁰⁶ So the definition of trademark in both the countries is flexible; which is very beneficial for the recognition and protection of a non-conventional trademark. Because though not expressly mentioned in the definitions; various kind of non-conventional trademark can be included in it. For example the sound trademark of "yahoo's Yodel" was registered in India in 2002, the Taj Mahal palace hotel was granted trademark as image mark in 2017, though both of these marks are not expressly mention in the definition. In the same way in U.S.A; smell mark was granted for a fresh smell of Plumeria Blossom for sewing thread and embroidery yarn.

6.3 Analysis on the Basis of Judicial Approach:

Apart from the trademark registry, Judiciary of both the countries has also takes a liberal approach and gives a wide interpretation of the definition of trademark ;so as to give protection to these non-conventional trademark. Judiciary had played a very important role in both the Countries in recognizing these non-conventional trademarks. For example, in the *Christian Louboution case*³⁰⁷, the Delhi High Court recognized that a single colour can be a trademark and thereby gave interim injunction in favour of the plaintiff in order to protect the distinct red colour of its shoes. Again, in *Colgate Palmolive case*³⁰⁸, the court recognised that a single colour a can be a trademark and *Zippo manufacturing case*³⁰⁹, the Delhi High Court recognised that a shape can be a trademark. In the U.S.A also a lot of smell mark, sound mark was recognised by the judiciary. For e.g. in the *Qualitex case*³¹⁰, the Court laid down 'the anything goes doctrine' which gave a wide interpretation to the definition of trademark. In *In Re Celia Clarke*³¹¹, the court recognised the smell as a trademark. But analysing the case laws mentioned in the above chapters it is evident that while in the U.S.A; judiciary is more concerned with the mode of representation of non- conventional trademarks, Indian judiciary focuses in recognising a non-conventional trademark rather its mode of representation ;which is the prime impediment in registering a non-conventional trademark in India.

But in this aspect; we cannot state that judiciary takes a biased or liberal approach to the non conventional trademark. Rather it takes a cautious approach in recognizing it, because these non-conventional trademarks sometimes tend to overlap with the other kinds of intellectual property, for example between shape or trade dress of a product and the design law and

³⁰⁶ Section 2(zb) of The Trademark Act,1999

³⁰⁷ *supra*, note 144.

³⁰⁸ *supra*, note 175.

³⁰⁹ *supra*, note 192.

³¹⁰ *supra*, note 215.

³¹¹ *supra*, note 258.

because it also has the tendency to deplete available sources for the other competitors in the market.

6.3 Analysis on the Procedural Requirement:

Though the natures of the definition of trademark in both the countries are similar, but it is pertinent to note that the condition of granting registration to non-conventional trademark is to a certain extent is different in both the countries. In order to analyze it better the researcher will separately discuss the following requirements:

6.3.1 Graphical representation:

In the U.S.A, the definition of trademark only provides that the mark should be distinctive and should be capable of identifying the origin or source of the product. But as per the definition of Trademark under the Trademark Act, 1999, the definition is coupled with the capability of the mark to represent it graphically apart from being distinctive. It is what constitutes the definition of trademark in India. That means if the non-conventional trademark is not capable of graphical representation, the application will be refused on that ground. That is why a lot of non-conventional trademark is not possible to get registered in India. For example taste mark, smell mark, touch mark are never be able to get registered in India.

On the other hand; U.S.A demarcated the representation of these trademarks on the basis of the mark itself. The TMEP lays down two different mode of representation. For the visual kind of non-conventional trademark i.e. the moving image, shape, combination of colour; the representation should be made in the form of drawing or in case the drawing is not able to perfectly describe the mark, then only written description of the mark is required. While in the case of non-visual non-conventional trademark i.e. sound, taste, and smell; only the written detailed description of the mark is required, which make it comparatively easy to register a non-conventional trademark in the U.S.A. But In India there is no such different mode of representation for trademark is provided and detailed written description is not accepted in India. All kinds of trademarks are treated in the same way in India, i.e. it should be represented graphically. Only in the Trademark rule 2017, it was incorporated that sound mark can be filed in digital format along with graphical representation i.e. the musical notes. But for other kinds of trademark graphical representation is the strict requirement.

6.3.2 Distinctiveness:

The position on distinctiveness is the same in both the Countries. Distinctiveness is the prime requirement of a trademark to be eligible for protection and non-conventional trademarks are not exception to it. Laws of both the Countries require that a mark should be distinctive in order to be eligible for protection. In case of inherent lack of distinctiveness; the examiners will look into the acquired distinctive of the mark. This requirement of distinctiveness is applicable for all kind of marks.

6.3.3 Functionality Requirement:

Doctrine of functionality plays a very important role in the U.S.A trademark regime. In the U.S.A., trademark to be eligible for protection have to be non-functional i.e it should not be serve a utilitarian function. By its nature; non-conventional trademarks have a tendency to be functional and that is where the check lies. U.S.A laws have a broad prohibition on functionality and it is applicable to all kinds of marks whether visually perceptible or not.³¹² Even if a trademark has inherent or acquired distinctiveness; it is not capable of registration if it is functional in nature. The functionality approach of U.S.A is appreciable as it is in the in the interest of promoting competition in the market. U.S.A Supreme Court summarised that "The functionality doctrine prevents trademark law, which seeks to promote competition by protecting a firm's reputation, from instead inhibit legitimate competition by allowing a producer to control a useful product feature."³¹³

On the other hand in India, The functionality doctrine is not applicable to all kinds of trademarks. Functionality prohibition in India only applies to shape or three-dimensional trademarks. The Trademark Act, 1999 expressly recognised the functionality doctrine only to shape marks under section 9 (3) of the act. This doctrine is not adopted wholly to be applicable to all kinds of trademarks. Apart from shape marks, all trademarks only have to fulfil the distinctiveness and graphical representation requirement. But from the researcher's point of view functionality requirement is extremely important for maintaining and promoting fair competition in the market, because granting a trademark registration without the functionality test may deplete the sources to be available to other competitors in the market. Though this functionality requirement makes it tough for non-conventional trademark to pass the eligibility test; but in defending non- conventional trademark we cannot

³¹² *supra*, note 114.

³¹³ *supra*, note 215.

ignore the need of functionality test. So it is open to the Courts or to the trademark registry to adopt the functionality requirement for all kinds of non- conventional trademarks as a defensive weapon to prevent use of marks that would hinder the competition in the market.³¹⁴

6.4 The "anything goes Doctrine":

U.S.A has always been a pro-IP Country. In the U.S.A; the Scope of trademark is very broad. There is no outer limit of granting trademark registration under the Lanham Act. Because as held in the landmark case *Qualitex*, in U.S.A 'anything can be a trademark as long as it qualify the test of functional and distinctiveness'. In addition to that mode of representing a mark in the U.S.A is also favourable for non-conventional trademark. That is why non-conventional trademark has a very wide scope to get protection in U.S.A. But it is pertinent to note that in this process U.S.A does not ignore the other forms of intellectual property such as patent. Because as mentioned in the chapter V; while grating a trademark, the examiners will also look into that whether the trademark is covered by any utility patent. But on the Other hand this anything goes doctrine is not possible to apply in the Indian scenario; because the definition of trademark under the act is coupled with the requirement of graphical representation.³¹⁵Therefore marks which are capable of graphical representation can only be registered in India.

6.5 Analysis On The Basis of Present Status of Non-Conventional Trademarks in Both the Countries:

In the U.S.A; presently the trade dress, three-dimensional mark, sound mark, smell mark, single colour, hologram mark, moving image mark, tactile mark, gesture mark are capable of registration. Although, till now no taste or flavour mark is registered in the U.S.A; But as already mentioned in the last chapter it does not mean that under the U.S.A taste mark are not possible of registration. In the *N.V Organon* case the application was refused only because the mark was functional. But if a taste mark is non-functional and distinctive; then a taste mark is capable of registration in U.S.A.On the other hand; in India, the registration of combination of colours, packaging of product or shape, sound mark, three-dimensional marks has got registration till now. The smell mark, taste mark tactile mark or gesture marks are not yet capable of getting registration in India due to the above mentioned procedural difficulties.

³¹⁴ Dev Gangjee, " Non-Conventional Trademarks In India", <http://docs.manupatra.in/newsline/articles/Upload/BB1047DA-5CCF-41BC-9C82-487F5DC570D3.pdf> (May 20, 2018).

³¹⁵ See *supra*, note 94.

In comparison to U.S.A; in which a lot of non-conventional trademarks had got registered; while in India only a few non- conventional trademark are registered till now. Though smell mark is discussed in the draft manual 2015, but until the provision of the manual is incorporated in the Trademark Act, 1999; there is no certainty of smell trademark registration In India.

6.6. Conclusion:

Non-conventional trademarks are of immense importance irrespective of the status of the countries; and representations of these trademarks are even more important to bring them in existence. From the above analysis we can conclude that the representation requirement of trademarks in the U.S.A are more favourable for non-conventional trademarks than in India because of the different mode of representation of these marks in U.S.A i.e. accepting a detailed written description for the registration of smell, taste and sound mark. Even the TRIPS agreement does not mandate for a requirement of graphical representation. But in India due to the lack of this demarcation in the mode of representation of these marks or we can say the sole criteria of graphical representation hampers the registration of various kinds of non-conventional trademark. So in light of the TRIPS agreement, India can dilute this requirement of graphical representation or can at least prescribe different mode of representation for different kinds of marks in light of U.S laws. In addition to that, non - functionality requirement used in the U.S.A; which is very favourable for maintaining fair competition in the market is also absent in India for all types of mark. So the researcher would suggest that the Indian registry or the court should adopt this functionality approach.

Adding to that, finally it can be concluded that U.S.A approach of "anything can be a trademark" along with the requirement of detailed written description of the mark is completely unsuited for the current trademark Law regime in India, because as already mentioned; definition of trademark under the Indian act is coupled with the requirement of graphical representation.

But never the less we should not forget that the status of these two countries is different from each other. While U.S.A is the most developed Country in the world, India is a developing Country and it is constantly working for making It a Pro-IP Country. As the researcher already mentioned; in India there is a radical change in the IP sector. So we cannot straightforwardly state that India is not keen to protect these important 'sense based non conventional trademark', as this difficulty in registration is only a practical difficulty and

India is working towards it. It can be witnessed from incorporating digital means for sound trademark registration in the Trademark Rules 2017. It is also pertinent to note that within its practical possibilities India is recognising some of the non-conventional trademark such as the image mark of Hotel Taj. So there is a hope that in the coming years; Indian trademark regime will be more favourable for these non-conventional trademarks. In addition to that from the Indian perspective; there is also need to create an awareness to the manufactures and business entities in India so that they can make a strong consumers base by applying these sense based non-conventional trademarks in the course of their business

CHAPTER VII

CONCLUSION AND SUGGESTION

7.1 Research Findings:

Trademark law was, is and will continue to be one of the most important branches of not only in Intellectual property but of law as a whole. The rationale behind the importance of trademark is manifold. A trademark is not only important from the view point of law but also from the point of view of economics, because it is the face or identity of a product or services coming from a particular company. Consumers buy these products or availed these services believing only on the trademark which carries the reputation and assures the quality guaranteed by the company. When consumers want to buy these products; apart from the quality or characteristics of the goods they also attracted towards the aesthetic appeal or some eye catching character or the appearance or a nice aroma of the product. So to attract the customers; a product or services have to bear these aesthetic features. That is where our 'modern marks' or non-conventional trademarks come into picture. These marks has the capacity to attract the five senses of human body and is capable of remaining in the mind of consumers for a longer period of time by identifying a particular source of the product. It also helps the business entities by making its consumers bound to stick to that product.

Firstly, it can be seen that scholars and researcher always raise the question that are these non-conventional trademark are capable of performing the same function as their traditional counterparts or whether they should be treated in the same way as their traditional counterparts. Arguing in the defence of these "new salesman in the market" or how we termed as "the non-conventional trademark" the researcher wants to conclude that these non-conventional trademarks are not different from the conventional trademarks. A traditional form of trademark such as words, symbol; distinguishes a product from another similar kind of product and also indicate that source of the product. Likewise, the same function is performed by the non-conventional trademarks. The unique opening style of Lamborghini car clearly differentiate it from other similar cars and indicate that these cars are coming from the company Automobili Lamborghini S.p.A or that that beautiful bright red colour indicate that the pair of shoe is from the popular brand Christian Louboutin. These marks are termed as non-conventional not because they cannot be treated in the same way as the conventional forms of marks but because they are not commonly used as a trademark from the ancient time and the consumers are always perceive these traditional forms of marks as trademark. But

Nevertheless the customers are now very well can perceived these non-conventional trademarks because we continuously use our five senses when we recognise some sound, taste, colour, or a touch.³¹⁶ Consumers attracted towards these marks which ultimately 'tie' a customer to a particular product or services. Furthermore, visual perceptibility is not a *sine qua non* for building brand association in the minds of the consumers."³¹⁷ However it is true that these non-conventional trademarks have to face some challenges in fulfilling the procedural requirement i.e. the graphical representation and the distinctiveness criteria to be registered and protected as a trademark, **but it is pertinent to note that traditional trademarks are also not immune from the test of procedural requirement. They also has to fulfil the condition enumerated in the respective legislation of a Country.** For example if a traditional form of trademark is not able to fulfil the condition lay down in the section 9 of The Trademark Act, 1999; they are absolutely prohibited from registering as a trademark. While the traditional forms of marks can fulfil the requirement more easily than a the non-conventional mark, this practical impediment in representing non-conventional trademark also can be removed by some alternative measures; which the researcher will discuss in the subsequent paragraph of this chapter. Most importantly with regard to the legislation of both the countries(For the purpose of this research paper U.S.A and India) it can be safely concluded that non-conventional trademarks are no exception to the conventional forms of trademark and therefore there is no reason as to why they should not be treated as the same way as their traditional counterparts or even we can conclude that they should place in the higher notes than conventional trademark because they can very well add the brand value to a particular goods or services and can attract a consumer to a great extent.

Secondly, the most important issue regarding non-conventional trademark is that whether these non-conventional trademarks are its distinct and whether it can be represented graphically. With this aspect the researcher wants to conclude that- positive affirmation or negative affirmation in this issue cannot be given by treating non -conventional trademark as a whole. It varies from application to application basis. Even we cannot state that smell mark or taste mark is not distinctive in nature. It will be decided on how these marks are used in relation to a particular product or whether the mark can establish them as distinctive from the view point of customer over the course of time. When some of the scholars argued that human minds are not able to differentiate between a different scent and taste, the researcher

³¹⁶ *supra* note 50.

³¹⁷ *Id.* at 128.

negates this argument by providing arguments based on scientific study in the previous chapter.*

With regard to registration requirement of graphical representations, these non-conventional trademarks face the major difficulty; especially by the non-visible forms of non-conventional trademark i.e. the sound, taste, and smell. While some of the countries accept the detailed written description of the mark, other countries like India, does not accept the written description as it contend that detailed written description cannot depict an actual smell or taste clearly. But it is imperative that these trademark while being distinctive in nature and non-functional they should not be denied registration based on the practical impediment of representation as they are not legally prohibited. That is why the concerned authorities should adopt some alternative measures with regard to it. Apart from that; various scientific study* also shows that written description of a taste or smell can very well meet the representation requirement of these trademark and that trademark registry can safely depend on these written description of marks.

Thirdly, in the present day; the most important issue with regard to these non-conventional trademarks are that these trademarks represent an unnecessary restriction or tends to overlap with the other forms of intellectual property or whether it amounts to depletion of available sources for the other competitors in the market other forms of intellectual property. Whether there is any boundary for what can be a trademark or are we pushing the boundaries of what can be a trademark? These are the most important question in the field of non-conventional trademark. Dealing with questions; the first thing is that defending the non-conventional trademark, we should not be blindly support of extending the scope of trademark or pushing the boundaries of a trademark. As associated with the field of Intellectual property law we should also be concerned with the other forms of intellectual property such as design, patent, copyright and geographical indication. **One cannot deny the fact that these trademark as a whole has the capability of expanding to a large extent. That is because trademark law is associated with the consumer perception. If consumer perceives a particular 'thing' associated with the product as a trademark, it could have the tendency of becoming a trademark.** Conventionally we couldn't even think that a particular flavour of a medicine or other edible thing to be trademark or a feel we get by touching a velvety bottle can be trademark or even the sound associated with our favourite brand of biscuit in their advertisement could be a trademark. But now they are trademarks, because first our minds associated that sound to that particular brand of biscuit so that we can differentiate it from other products.

Eight years ago, in a significant article written by Dev Ganjee, a lecturer in intellectual property, London School of Economics in his article "Non-Conventional Trade Marks In India" raise the same issue that with respect to outer limits of a trademark and having an open ended definition of trademark given under the Indian Act (even under the TRIPS Agreement) He questioned that "*Can An entire building be a trademark? Should a building be a trademark? Unsurprisingly, new categories of subject matter have predicated mixed responses.*"³¹⁸ Answering this question eight years later we have to accept that trademark had already pushed its boundary, because an entire building is a trademark now in India; 'the image mark of Hotel Taj palace, Mumbai.'

Considering the communicative element of a trademark with a customer's mind; whether we are restrict the available limited resources that can be used by other manufacturer or business entities by granting exclusive right over some of the subject matter. For example if Indian classical musical composition "the ragas" that are there in the public domain can be registered as a sound mark, whether will that effect the limited monopoly concept of copyright Law, which presumes that cultural works should be freely available where copyright protection is not there or has already expired . Because tough specific types of sound mark are mention in the draft manual that cannot be trademark on factual distinctiveness such as common music, popular rhymes but as the same is not incorporated in the Trademark Act itself, the risk is lies thereto. But it can be concluded that from the nature of definition of trademark under TRIPS, India, U.S.A and most of the Countries; we cannot presume that exactly where the scope of trademark can be restricted.

Fourthly, by analyzing the scope of non-conventional trademark in the U.S.A and India; the researcher wants to conclude that; from the registration point of view the process of registration of trademark in the U.S.A. is more favourable for non-conventional trademark than to India. This is because it prescribes two modes of representation for non- conventional trademark i.e. for visually perceptible marks-drawing is required and for non- visual marks sound, taste, scent mark only a written detailed description is accepted. While in India graphical representation of a mark is *sine qua non* for trademark registration; which makes the non-visual non-conventional marks difficult to get registered in India. Due to this graphical representation requirement the smell mark, taste mark are not registered in India and in spite of the capability of touch mark of graphical representation these marks are too not yet registered in India. Though smell marks are mentioned in the Draft manual 2015, But

³¹⁸ *supra*, note 307.

as long as it not incorporated in the Trademark Act, position with regard to these marks in The Indian Act is not certain.

Furthermore from the position of these two countries with regard to non-conventional trademark it can be concluded that the American Approach of ' Anything goes' attitude is completely unsuitable for the legal regime of trademark law in India; because of the restrictive nature of the trademark definition i.e. the definition of the trademark is coupled with the requirement of graphical representation. But it is pertinent to note that to promote the protection of these trademarks we cannot blindly follow the U.S.A regime.

However we should not forget the fact that the status of these two counties is different. U.S.A, a developed country is always being a Pro-IP Country. While India being a developing Country is in the constant effort of making it a Pro-IP Country. In between 2016-2017 Indian trademark regime undergone a radical changes starting from the changes in filing procedure, more digitization, incorporation of acceptance digital copy of sound along with graphical representation for sound trademark registration. Granting image trademark for hotel Taj Palace Mumbai are some of them. So in the upcoming years we can hope for changes in the mode of representation of the non-conventional trademark in order to facilitate more registration. In addition to that, from the analysis of Indian cases with regard to non-conventional trademark it can be concluded that judiciary had also recognised the importance of non-conventional trademark and keen to protect these marks by judicial pronouncement. So as the shape mark of Zippo lighter, red colour of Christian louboution shoes are recognised as non-conventional trademark, the other non-conventional trademarks which are currently protected may also get protection by the judiciary in the upcoming years.

Hence, the hypotheses formulated for the research i.e 'Non- conventional trademarks are capable of performing the function of a trademark in the same way as its traditional counterparts' and that 'the impediment of graphical representation can be resolved by other alternative methods' stands proved and the grounds are:

- A traditional form of trademark such as words, symbol distinguish a product from another product coming from different source and also indicate that source of the product; the same function is performed by the non conventional trademarks. For example whenever we see a bright purple colour packaging of a chocolate, we can immediately identify it as the Cadbury Dairy milk chocolate irrespective of whether the word Cadbury is written in Chinese, Japanese or Arabic or when we hear the sound of that familiar 4 note sound of an advertisement we can readily perceived it as the advertisement of Britannia biscuit.

- These marks are termed as non-conventional not because they cannot perform the source indicating function as performed by a traditional trademark but because they are not commonly used as a trademark from the ancient time and the consumers used to perceive these traditional forms of marks as trademark.
- The impediment of graphical representation under the Trademark Act, 1999 can be resolved by technological advancement such as Artificial Intelligence (AI) which can perceive the smell with artificial nose. Another alternative is that instead of prescribing same mode of representation for all kinds of marks, the act can lay down mode of 'detailed written description' for the representation non visible trademark as being practiced in the U.S.A'. In addition to that, the researcher had already produced scientific information in the previous paragraphs which proved that a detail written description can very well represent a smell or a taste.

7.2 Suggestion:

After a comprehensive study of the non-conventional trademark and its related aspects; following are some of the suggestion which the researcher has put forward that may help in the field of non conventional trademark.

- **Firstly**, that India should not blindly follow the 'anything goes' doctrine of U.S.A. But in order to facilitate the registration process of non conventional trademark India can adopt two approach
 - Firstly- The U.S.A's method of prescribing different mode of representation for different kinds of marks. India should prescribe graphical representation for all marks except the non-visual non-conventional trademark for which it should prescribe a written detailed description or adopt some new technology such as artificial intelligence. As like the sound mark; where the trademark rule 2017 prescribes a digital file, a sample of tactile mark should be accepted for the registration of touch or feel mark as in the U.S.A.
 - The other alternative approach is that it could repeal the requirement of graphical representation and incorporated some technological measures instead of that. This suggestion is based on the recent amendment of EU Trademark Law. As India, EU also graphical representation is sine qua non for registration of non

conventional trademarks. But after the 2017 amendment this impediment is removed by incorporating technological measures to represent the trademarks.

But the researcher would prefer the first method because by adopting the second method India has to completely amend the definition of trademark because graphical representation requirement it attached to it. So India can adopt the first method by way of exception to the definition of trademark and then to prescribe the different modes of representation in the Trademark Rules.

- **Secondly**, Government should endeavour to incorporate new scientific measures and techniques to be used by Indian Trademark registry in order to facilitate the registration of non-conventional trademark. For example govt endeavour should be put in making a similar system as PANTONE colour code to differentiate and distinguish various types of smell marks. The Government should take initiative to encourage and explain the importance of these marks. Because the non-conventional trademarks are not so common in the business practices today in India which lead to less numbers of registration of these mark. So there is a need to make the Indian business entities more informed so they able to create a strong consumer base not only in India but also in the interest of global trade.
- **Thirdly** India should adopt the functionality doctrine of U.S.A to be applicable to all kinds of marks in the interest of maintain and promote the competitiveness in the market for the better economic development of the country, business entities and also in the interest of consumer welfare.³¹⁹
- **Fourthly**, we regard to outer limits of the trademark or the issue of pushing the boundaries of trademark; the researcher wants to suggest that even though the definition of trademark under section 2(1)(zb) focus on the 'capable of distinguishing' character of a mark; for valid reasons certain kinds of marks should be keep out of the purview of the register so as to the prevent the overreach of the scope of trademark. This approach should be adopted not only in India but also internationality so as to prevent the overlapping of trademark law with other forms of IP or to prevent the depletion of other available sources.³²⁰ Because it is the only way of keeping a trademark within the boundary of trademark regime when there is an open ended and non exhaustive definition of trademark.

³¹⁹ see *supra*, note 307.

³²⁰ *Ibid.*

- **Lastly**, in the interest of competitiveness in the market we need to keep certain marks to be available for use by all market operators dealing with such kinds of goods or services. Because with the evolution of non-conventional trademarks enlarges the reservoir of signs to use as trademark. This in turn indicates that a wide range of marks will be under the exclusive control of particular business entities.

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