

HEAR ME, TOUCH ME, TASTE ME, SMELL ME: CONVENTIONALIZING NON-CONVENTIONAL TRADE MARKS IN INDIA

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ABSTRACT

A trademark may comprise of any symbol capable of being represented graphically, predominantly words, designs, names, numerals, letters, the shape of goods or of their packaging, on condition that that such signs are capable of distinguishing the goods or services of one enterprise from those of other enterprises. A trademarked word or name or symbol etc. is indicated by a suffixed TM symbol in the yet-to-be approved phase and by ® post registration of the trademark. Conventionally, trademarks have been visually and graphically identifiable.

Non-Conventional Trademarks such as – Smell Mark, Sound Mark, Taste Mark, Touch Mark, Motion Mark and Hologram Mark have emerged as the most contemporary issue of the modern trademark regime. Granting of such trademarks is gradually gaining recognition in various countries. India's Trademark Regime still emphasizes on the need of a trademark being capable of graphical representation. However, conventions and treaties in the past have been held where graphical representation of a trademark has not been considered a necessity in granting registration to it.

This paper shall broadly discuss about the need of such marks in the modern era. There have been few precedents around the world in which the judiciary has granted registration for non-conventional trademarks. The present paper will not only highlight the developments in the trademark regime through various treaties around the world as well as legislation reforms in India, but also draw a comparison between India and the United States' take on this moot issue. Contrary to the belief that such marks would result in an anti-competitive trade regime, granting registration of these non-conventional marks would eventually be beneficial and would add to a healthy competitive market economy.

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INTRODUCTION

Section 2, Article 15, Clause 1 of the Agreement on Trade-Related Aspects of Intellectual Property Rights³(TRIPS) 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, shall be capable of constituting a trademark.” Such signs, precisely words comprising personal names, letters, numerals, figurative elements and combinations of colours as well as any combination of such signs, shall be qualified for registration as trademarks. “Where signs are not inherently capable of distinguishing the relevant goods or services, Members may make registrability depend on distinctiveness acquired through use. Members may require, as a condition of registration, that signs be visually perceptible.”⁴ What is necessary under this article is that any sign, or any combination of signs, must be capable of distinguishing the goods or services of one undertaking from those of other undertaking.⁵The problem faced by non-traditional trademark applications is that none of these - Smell Mark, Taste Mark, Motion Mark, Touch Mark, Hologram Mark, etc. - can be visually perceived. Trademarks Act, 1999 defines a "Trademark" as “a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others and may include shape of goods, their packaging and combination of colours.”⁶Non-traditional trademarks are relatively new on the Intellectual Property regime. Any mark that does not come under the traditional categories of trademarks such as letters, words, logos, numerals, pictures, and symbols may be termed as non-traditional trademark. Non-conventional trademarks therefore consist of marks originating from shapes, sounds, smells, tastes and textures.⁷

³ Agreement on Trade Related Intellectual Property Rights, 01/01/1995 [hereinafter *TRIPS Agreement*].

⁴ *Ibid.*

⁵ M.B. Rao &Manjula Guru, *Understanding TRIPS: Managing Knowledge In Developing Countries*, 106 (1st ed., 2003).

⁶ S. 2(zb), Trade Marks Act, 1999.

⁷ *Non-Conventional Trademarks*, IPPRO, available at <http://www.ipproinc.com/admin/files/upload/8ce71cd2d0e3086fd66415325f958236.pdf>, last seen on 10/11/2016.

SMELL MARK

Smell is said to be one of the most powerful types of human reminiscence, and businesses show increasing interest in pairing pleasing scents with their goods. To obtain registration of a smell mark applicants must be able to graphically represent the product's scent and must show that it is distinctive from the product itself. But how does one represent a smell in an illustrative way? Writing down the chemical formula for a smell is challenging as it is deemed to signify the substance rather than the smell of that substance. However, some smell mark descriptions have met the distinctiveness test and been successfully registered, such as a Dutch company's tennis balls with the scent of newly mown grass,⁸ and United Kingdom registrations for tires with "a floral fragrance/smell reminiscent of roses"⁹ and darts with "the strong smell of bitter beer."¹⁰

TASTE MARK

Some jurisdictions have accepted taste marks for registration.¹¹ In one particular instance, the graphic representation requirement was contended by using a written explanation of the taste and an indication that it concerns a taste mark. In assessing the registrability of this type of sign, principles similar to those concerning odors may apply and it could be argued that taste marks may only be applied to goods and not to service.¹² One of the obstacles to registering these marks is how to describe a scent or taste. Another difficulty is whether the scent or taste is "functional."¹³

⁸ *Making a Mark*, WIPO, available at http://www.wipo.int/edocs/mdocs/sme/en/wipo_smes_waw_10/wipo_smes_waw_10_ref_theme_03_01.pdf last seen on 10/11/2016.

⁹ *The Registration of Smell Trademarks in Europe: Another EU Harmonisation Challenge*, Inter-Lawyer, available at <http://www.inter-lawyer.com/lex-e-scripta/articles/trademarks-registration-smell-EU.htm>, last seen on 10/11/2016.

¹⁰ *Smell, Sound and Taste- Getting a Sense of Non-Traditional Marks*, WIPO, available at http://www.wipo.int/wipo_magazine/en/2009/01/article_0003.html, last seen on 10/11/2016.

¹¹ For example, in the Benelux Office the following mark has been registered (DE SMAAK VON DROP BX No. 625971). "The trademark consists of the taste of liquorice applied to goods in class 16 (taste mark)".

¹² *Ibid.*

¹³ Thomas A. Gallagher, *Nontraditional Trademarks: Taste/Flavor*, 105(3), *The Trademark Reporter*, 805, 806 (2015) available at http://www.inta.org/TMR/Documents/Volume%20105/vol105_No3_a4.pdf, last seen on 10/11/2016.

MOTION MARK

Moving cinematography, logos, motion pictures, video clips, film clips, documentary clips are also registered as motion marks in few countries. Numbers of motion of marks have been protected under the Federal Trademarks Act (Lanham Act).¹⁴ For instance the trademarks of Motion Pictures, 20th Century Fox Movies, Columbia Pictures are widely known motion marks registered in USA. Possibly, in the field of media the occurrence of motion marks is extremely felt and recognized. For instance in case of 20th Century Fox Movies the phrase "20th Century Fox" movies appears in two lines in golden color words. The visuals show the phrase while camera moves from right to left bringing the phrase exactly in the middle of the television or theaters screens. In India also the momentum is gaining importance with big movie and media companies looking for motion marks to represent their products and services.¹⁵

TOUCH MARK

Touch is one among the various sense marks and has its presence and appeal in the business realm, yet it appears as a trademark. These marks are also known as touch marks or texture marks which mainly give the sense to the user with reference to its subsistence and the goods or services it is on behalf of. The touch mark should be distinctive to the users; i.e. it must not be just an eye-catching or ornamental element. It must be further than decoration and packaging of the goods or services that it is demonstrating and must possess the characteristic of a standard trademark. However, touch marks which ignite the touch sense of human beings are not being claimed as frequently as compared to other non-traditional trademark and therefore touch marks remain as less celebrated or less claimed marks in the lot of non-traditional trademarks.¹⁶

¹⁴ The Lanham (Trademark) Act (Act of July 5, 1946) (United States).

¹⁵ *Millennium and Generation Next Trademarks: Trends in Branding and Merchandising*, E-Science Central available at <http://www.esciencecentral.org/journals/millennium-and-generation-next-trademarks-trends-in-branding-and-merchandising-ipr.1000117.php?aid=26447>, last seen on 10/11/2016.

¹⁶ *Ibid.*

HOLOGRAM MARK

A Hologram Trademark is a non-conventional trademark where a hologram is used to achieve the trademark function of peculiarly identifying the marketable origin of goods and services. The purpose of such holograms is to prevent false replication. Holograms by their very nature possess multiple images or colors that are visible only when viewed from different angles. Hence, holograms are difficult to capture in paper form, since the paper print will be unable to show the movement of images.¹⁷

It is, however, interesting to note that the Indian Trade Marks Act does not specifically mention or define unconventional marks such as smell, color, taste and sound marks. Furthermore, the Act does not lay down any special procedures or criterion to be followed in an application to register unconventional marks. In the absence of clear provisions, it is possible to rely on the definition of trade mark being sufficiently broad to cover such marks. However, the Trade Marks Registry's position on the filing and acceptance of such unconventional applications has not been made clear. There is no guideline on how the application needs to be submitted, or on the examination procedure, that has been laid out by the Registry.¹⁸

THE CHANGING DEFINITION OF TRADEMARK: VARIOUS TREATIES

Accounts of history related to trade mark law trace its origin to the Roman Empire, more particularly the Blacksmiths who were engaged in making swords.¹⁹ Other accounts of British history trace it back to medieval guilds²⁰ or the sixteenth century decision of *JG v Samford*,²¹ where it was held that an action would lie against use of a low quality cloth with a mark which

¹⁷ Supra 4, at 1.

¹⁸ Ranjan Narula & Rachna Bakhrui, *A guide to pitch perfect sound marks*, 184 *Managing Intellectual Property* 31, 33 (2008) available at <http://heinonline.org/HOL/LandingPage?handle=hein.journals/manintpr184&div=13&id=&page=>, last seen on 10/11/2016.

¹⁹ *Brand Names Before the Industrial Revolution*, National Bureau of Economic Research available at <http://www.nber.org/papers/w13930>, last seen on 10/11/2016.

²⁰ *The Historical Foundations of the Law Relating to Trademarks*, I3PM available at http://i3pm.org/Joomla/index.php?option=com_docman&task=doc_view&gid=70&Itemid=60, last seen on 10/11/2015.

²¹ Graeme B. Dinwoodie & Mark D. Janis, *Trademark Law And Theory*, 7 (1st ed., 2008).

was used by a manufacturer who had gained great reputation for his cloth.²² The first law on trademark was enacted by the Parliament of England under King Henry III's rule in 1266, which mandated all bakers to use a distinguishing mark for their bread.²³ France passed the first comprehensive trademark legislation in 1857 with the "Manufacture and Goods Mark Act".²⁴ In 1862, a law on trademark was passed in Britain which made it a criminal offence to imitate another's trademark with intent to defraud or enable another to defraud.²⁵

There are several international treaties that have affected the development of trademark law around the world. In addition to these, there are regional as well as bilateral treaties between countries. The main purpose of adopting such treaties is protection of rights, harmonization of laws and multilateral filing.²⁶

Foundation of an International Trademark System: Paris Convention

The Paris Convention²⁷ which was signed on 20th March, 1883 is the oldest major international treaty concerned with the protection of Intellectual Property. Paris Convention neither defines the rights it means to protect nor does it propose any minimum standard of protection for these rights.²⁸ The signatory countries have the freedom to set out their own legal framework for the scope and quality of right given under the convention. It provides two important rights, namely the Right of Priority and the Principle of National Treatment.²⁹ Each contracting State must refuse registration and prohibit the use of marks that constitute a reproduction, imitation or translation, liable to create confusion, of a mark used for identical and similar goods and considered by the competent authority of that State to be well known in that State and to already belong to a person entitled to the benefits of the Convention. It also provided for granting of

²² Southern v.How, Popham's Reports 143 (1618), 79 Eng. Rep. 1243 (K.B. 1907).

²³ Ken Albala, *The Sage Encyclopedia Of Food Issues*, (1st ed., 2014).

²⁴ *Well-Known Marks & China's System Of Well-Known Mark Protection*, INTA, available at http://www.inta.org/TMR/Documents/Volume%2095/vol95_no3_a5.pdf, last seen on 10/11/2016.

²⁵ The Merchandise Marks Act, 1862.

²⁶ Marshall A. Leaffer, *The New World Of International Trademark Law*, 2(1) *Marquette Intellectual Property Law Review* 1, 8 (1988), available at <http://www.law.harvard.edu/faculty/tfisher/Leaffer.html>, last visited on 10/11/2016.

²⁷ The Paris Convention, 20/03/1883.

²⁸ *Commentary on the Paris Convention for the Protection of Industrial Property*, LEX-IP, available at <http://www.lex-ip.com/Paris.pdf> last visited on 10/11/2016.

²⁹ *Supra* 25, at 5.

protection to Collective Marks³⁰ and Service Marks³¹. Thus, it can be seen that the convention did not emphasize on the essential features or qualities that should be present in a trademark, like graphical representation which came in later agreements. It left it upon the signatory countries to shape their domestic laws according to the general guidelines provided for in the convention, mainly Right of Priority, National Treatment, Well-known marks, and few common prohibitions on registrability.

Extending the Paris Convention: Madrid System for the International Registration

Madrid system comprising of Madrid agreement and Madrid protocol, have emerged as the absolute and most extensively accepted contemporary international agreement system concerning the international registration of trademarks. The protocol relating to the Madrid Agreement targets to make the Madrid system more flexible and attuned with the domestic legislation of certain countries or intergovernmental organizations that had not been able to agree to the agreement. Thus, this system makes it feasible to protect a mark in numerous countries by obtaining an international registration that has effect in each of the designated contracting parties. It is administered by the International Bureau of WIPO.

Simplification of The System: The Trademark Law Treaty

Work on TLT began under the aegis of WIPO in 1987. The TLT accomplishes procedural harmonization by setting forth a list of maximum requirements that members may impose for various actions. Furthermore, the TLT forbids the imposition of additional and often oppressive formalities of the various national offices that made the system cumbersome. Formerly, the registration of a trademark operated to lead the applicant through a maze of bureaucracy, making the process costly, tough, and time consuming, and the TLT has addressed those problems.

³⁰ *Ibid.*

³¹ *Ibid.*

Classification of Goods and Services: Nice Agreement

The Agreement instituted a classification of goods and services for the purposes of registering trademarks and service marks (the Nice Classification). The trademark offices of the contracting States must specify, in the official documents and publications in relation to each registration, the numbers of the classes of the Classification to which the goods or services for which the mark is registered belong.³²The classification comprises of a list of classes, 34 classes for goods and eleven for services and an alphabetical list of goods and services. The Nice Agreement made a Union, which has an Assembly. Each member of the Union which has followed the Stockholm Act or the Geneva Act of the Nice Agreement is a member of the Assembly. One of the foremost functions of the Assembly is the adoption of the biennial program and budget of the Union.

Balancing the System: TRIPS Agreement

A necessity to improve suitable framework for protection of intellectual property was felt which in turn would expand international trade order as well. In this environment, the discussions concerning Trade-Related Aspects of Intellectual Property Rights (TRIPS) emerged as one of the vital novel areas for debate at the Uruguay Round of GATT, inaugurated in 1986. Along with other agreements to arise out of the Uruguay Round, the Agreement on Trade-Related Aspects of Intellectual Property Rights (the TRIPS Agreement) was finally decided upon at the ministerial meeting in Marrakesh, Morocco in April 1994, and came into force as part of the WTO Agreement on January 1, 1995. TRIPS is one of the most essential and all-inclusive international instrument relating to protection of Intellectual Property Rights. TRIPS shines among all other international treaties on Intellectual Property Rights for the reason that it incorporates all methods of Intellectual Property without separating copyright and industrial property. Further it lays down detailed provisions on enforcement of Intellectual Property Rights.

Articles 15 to 21 of TRIPS lay down the rules for protection of trademark. It is mandatory for a member state to enforce the principles regarding conditions and content of protection of trademark as laid down in articles Art. 15. It provides for a modest definition of trademark

³² Agreement on International Classification of Goods and Services, 1957 (NICE Agreement).

stating that “Any sign or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertaking, shall be capable of constituting a trademark.”³³ This definition very evidently conveys that the agreements on TRIPS provides for both trademarks committed to goods as well as service marks signifying services on the equal footing. It is very specifically provided under the TRIPS³⁴ that the signs that are not inherently capable of distinguishing the relevant goods or services may be evaluated on the condition of its distinctiveness acquired through use.

Influenced by TRIPS and European synchronization, countries have extended their arena of trademark subject matter, giving protection to previously unrecognized categories of marks. These new kinds of marks include the shapes of goods, product containers, product trade dress, and other unusual indicators of origin.³⁵ Moreover, recent legislation³⁶ and case law in a number of countries specifically recognize famous marks.³⁷ Along with treaty observance and harmonization, a number of countries have removed the technical requirements regarding the transfer and licensing of marks. Therefore, TRIPS does not mandate graphical representation as a necessity to register a trademark and even if the signs are not capable of distinguishing, it says that they should be registered on the basis of acquired distinctiveness. These rules, truly, have been laid down keeping in mind the needs and advancements of today’s technologically progressing era.

LEGISLATIVE DEVELOPMENTS IN THE INDIAN TRADEMARK LAW

There was no Trade Marks Act in India until 1940, when the present Act was passed, to provide for the registration and more effective protection of trademarks in India. Soon after the passing of the United Kingdom Trade Marks Act in 1875, there was a request from the Millowners' Association of Bombay and the Bombay Chamber of Commerce to the Government of Bombay in 1877 to introduce in the local Legislative Council a Trade Marks Bill along the lines of the

³³ TRIPS, Article 15(1).

³⁴ *Ibid.*

³⁵ Joanna Schmidt Szalewski, *The International Protection of Trademarks after the TRIPS Agreement*, 9(189) Duke Journal of Comparative & International Law 189, 206 (1998) available at <http://scholarship.law.duke.edu/cgi/viewcontent.cgi?article=1245&context=djcil>, last visited on 10/11/2016.

³⁶ Frederick W. Mostert & Ludwig Baeumer, *Famous and Well-Known Marks* (1st ed., 1997).

³⁷ *Enterprise Rent-A-Car Co. v. Singer*, [1996], 66 C.P.R.3d 453 (Can.).

United Kingdom Statute. Owing to the wisdom of having central legislation on such an imperative matter, the Government of Bombay referred the matter to the Government of India and the latter circulated in 1879 a Trade Marks Bill and another modified Bill in 1880 for public opinion, both of which received considerable opposition from the commercial communities.³⁸ According to the current act a trademark is defined under Section 2 (i) (zb) as "a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others and may include shape of goods, their packaging and combination of colours".³⁹ It was felt that to keep up with the pace of development of industry and trade, India has to amend the existing laws and bring into effect a modified Trade mark legislation. Also, India being a signatory to the TRIPS Agreement, it makes it obligatory for the legislators to modernize the laws in compliance with the TRIPS guiding principles. The new Act has been prepared after a comprehensive review of the existing laws and its comparison with the TRIPS Agreement.⁴⁰

Let us now focus on some of the landmark changes and new additions to the current trademark law of India. The new act had to be in synchronization with the TRIPS Agreement and hence these observations have been noted:

Well Known Marks

Well-known marks were not given any protection under the old Act. Undoubtedly, the cases like *Whirlpool*⁴¹ gave better footage to well-known marks having trans-border reputation. In this branded world, where trademarks are a part of our lifestyle, the laws and regulations have to be straight and strict. The new Act puts forth a legislative shield for well-known marks. However, the criterion for determining a well-known mark is a question of fact and it is to be determined according to the guidelines provided under the new Act which are in terms of the TRIPS Agreement. To add to the express factor provided under the Act, the Registrar, before coming to a conclusion, can also use his discretionary authority to take into account any other facts which he considers to be relevant. Section 11 of the current Act conclusively puts down solid policies

³⁸ T. P. Datta, *Trademark Law in India*, HeinOnline (2006).

³⁹ The Trade Marks Act, 1999.

⁴⁰ Taj Kunwar Paul & Jitheesh Thilak, *Reincarnation of Trademark Law in India*, Journal of Patent and Trademark Office 237 (2004).

⁴¹ *Whirlpool Co. v. N. R. Dongre*, (1995) PTC 415.

concerning to the well-known marks and its safeguard. The rules under the Act also reflect the addition of cross border reputation of well-known marks.

Collective Marks

Collective marks are made a part of the Trademarks Act. A trademark can now be lawfully and authentically owned by more than one person, unlike the earlier position where it could only be owned by one. The provisions relating to collective marks⁴² had been introduced for the first time in India by the 1999 Act. The Act defines a collective mark as a mark distinguishing the goods or services of a group of people, from those of others. The proprietor of the said collective mark would be union of the members and the use of the mark should be governed by the regulations framed by the association in this regard.⁴³

Shape Mark

Shape of goods is included in the meaning of mark⁴⁴ under the new Act. It is for the first time in the trademark law that legislative recognition has been given to shape of goods as a mark proficient of registration as a trademark. Under the old Act, shapes of goods were not considered to be the trademark.⁴⁵ It was something extra added to the goods. A part of the goods was never considered a trademark.

Combination of Colors

The definition of mark under the new Act includes the combination of colors too.⁴⁶ A scheme of coloring applied to goods may have a distinctive character in certain circumstances. If color, is satisfactorily distinctive, can be a very effective sign of origin. A trademark may be limited wholly or in part to any amalgamation of colors. The necessity of such colors arise when the device representing a particular color or colors and the device taken by itself without colors is not distinctive but is capable of distinguishing when represented in particular color or color

⁴² Supra 37.

⁴³ Supra38.

⁴⁴ *Ibid.*

⁴⁵ Supra39.

⁴⁶ *Ibid.*

combination. In such a case the Registrar⁴⁷ is given prudence to impose the limitation of mark to particular color or any combination of colors as a condition to registration.

Trade Dress

The term trade dress in general relates to the look and feel of the product or its packaging. In other words, it is the total image and the overall appearance of the product, a form of Intellectual Property Right.⁴⁸ In India, Trade Dress with respect to passing off is protected under the Trade Mark Act, 1999. The plaintiff has to establish goodwill of the product in the market and association of the trade dress of the plaintiff with the source.⁴⁹ It is then required to find out that the intention of the defendant in copying the trade dress of plaintiff is to deceive the general public that the source of the goods of the defendants are that of the plaintiff's.⁵⁰

India has transformed its IPR regime in all its IP sectors, be it Trademarks, Patents or Geographical Indications. Under the new trademarks Act, various new forms of trademarks are recognized. The Act still, does not recognize the marks like movements marks, smell marks, sound marks etc. In spite of certain limitations, India is all set to keep up with its trade relations with the urbanized world with a brand new IPR regime. Let us look at some of the landmark judgments passed by the Indian Judiciary under the Trade Mark Act, 1999.

The Indian Judiciary dealt with a case, for the first time with respect to trade dress in *William Grant & Son v. Mc. Dowell & Co. Ltd.*⁵¹. The court dealt with an action of passing off and for the first time recognized the importance of trade dress vis-a-vis a trans-border reputation. With regard to shapes, the settled stand of the law is that trade dress should be distinct and must have acquired secondary significance.⁵² In *G. M. Pens International v. Cello Plastic Products Co.*⁵³ the Indian Courts have also addressed the issues of use of a single color and has categorically stated that a single color cannot be inherently distinctive. Recently Cadbury tried registering

⁴⁷ *Ibid.*

⁴⁸ *Blue Bell Bio-Med v. Cin-Bad Inc.*, 864 F. 2d 1253 (1989, 5th Cir.) (United States).

⁴⁹ ShantanuSahai, *Piracy of Trade Dress and the Law of Passing Off: National and International Perspective*, 11 *Journal of Intellectual Property Rights* 201,206 (2006).

⁵⁰ *Colgate Palmolive v. Anchor Health Ltd.* (27) PTC, 478 (Del.).

⁵¹ 1997 (17) PTC 134.

⁵² Neha Mishra, *Registration of Non-traditional Trademarks*, 13 *Journal of Intellectual Property Rights* 43, 50 (2008).

⁵³ 2006 (32) PTC 332.

purple color as their trademark but it was not accepted. Although, with regard to a combination of colors, the position in India is clarified by the statute itself, and the requirements of colors having acquired secondary significance like that of the white and red combination in the case of "Colgate" in certain manner seems alright.⁵⁴In August 2008, the India Trade Marks Registry registered Yahoo! Inc.'s application of the sound mark Yahoo Yodel in respect of services falling in Classes 35, 38 and 42. This is one of the first registrations of such a nontraditional trademark in India.⁵⁵

DEVELOPED VS. DEVELOPING: USA VS. INDIA

The usefulness of any trademark is contingent on its capability to create an impression on the minds of the potential consumers of the associated good. When representation of the product is unique, it tends to appeal to people's sense and perception in a noteworthy way. This has given rise to numerous non-traditional trademarks around the world, getting recognition in a slow and gradual manner under different jurisdictions. Also, the arrival of internet and e-commerce has expanded the range of signs that companies would like to use as registered trademarks. For instance, motion and sound marks can grab the attention of internet users more powerfully than traditional marks, which in turn have projected their popularity in today's commercial world.⁵⁶

Various national laws and international treaties refer to an open ended definition of trade mark. Article 15(1) of TRIPS⁵⁷ defines trademarks and leaves open to the members who are free to determine the appropriate method of implementing the definition within their own legal system and practice. India emphasizes on the need of 'graphical representation'. The Indian Trademark Act defines trademark as "mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others and may include shape of goods, their packaging and combination of colours and."⁵⁸ Thus, unlike the U.S. trademark law;

⁵⁴ Colgate Palmolive Co. Ltd. v. Mr. Patel & Anr.(2005) PTC (31) 583.

⁵⁵ *First Sound Mark Registered in India*, INTA, available at <http://www.inta.org/INTABulletin/Documents/INTABulletinVol63no17.pdf>, last visited on 10/11/2016.

⁵⁶ *Beyond Tradition: New Ways of Making a Mark*, WIPO-MAGAZINE, available at http://www.wipo.int/export/sites/www/sme/en/documents/wipo_magazine/7_2004.pdf last visited on 10/11/2016.

⁵⁷ Supra 31.

⁵⁸ Supra4.

there is a requirement for all the trademarks including that they shall be capable of graphical representation. The 2002 Rules define graphical representation to mean the representation of a trade mark for goods or services in paper form. Thus, it can undoubtedly be affirmed that graphical representation is a sine qua non for Trademark Registration in India. On the other hand, The Lanham Act of the United States defines trademark, essentially, as any word, name, symbol, or device,⁵⁹ or any combination thereof used to identify and distinguish goods or services of one undertaking from those of other undertakings.⁶⁰ Thus, there is no requirement of capability of graphical representation for a trademark. Now, the question is whether the requirement of graphical representation can be done away with without weakening the key function of trademark as the source identifier.⁶¹ The rationale behind graphical representation, while registration of the mark is to permit competitors and others to know what has been trademarked. Regardless of this, there is no need for a mark to be graphically represented for the registration purposes in the United States.

The European Court of Justice (ECJ), first voiced the necessity of graphical representation by laying down certain criteria in *Sieckmann's case*,⁶² concluding that the graphical representation must be “clear, precise, self-contained, easily accessible, intelligible, durable and objective”. Ralf Sieckmann approached the German trade marks registry to register a scent mark for several services. He endeavoured to represent the mark by (i) indicating the name of the chemical substance, methyl cinnamate; (ii) the structural formula for that substance ($C_6H_5-CH = CHCOOCH_3$); (iii) indicating laboratories where samples may be obtained; (iv) submitting an odour sample in a container; and (v) describing the scent in words as “balsamically fruity with a slight hint of cinnamon”. Even then, each of these methods was difficult. For instance, the ECJ said that while the explanation of “balsamically fruity with a slight hint of cinnamon” was without any difficulty available and understandable, but it was not clear, detailed or objective (what is a ‘fruity’ scent and how much cinnamon does a ‘hint’ refer to?). On the contrary, the chemical formula was objective but unintelligible to laymen and would need reference to external, expert resources to decipher so it was not self-contained. Additionally, it referred to a substance, not the odour itself so it was an indirect representation not a direct one. Therefore, the

⁵⁹ Jane C. Ginsburg, *Trademarks And Brands-An Interdisciplinary Critique*, 93 (1st ed., 2008).

⁶⁰ The Lanham (Trademark) Act (Act of July 5, 1946) S. 1127 (United States).

⁶¹ In *Oliveira v. Frito-Lay, Inc.*, 251 F.3d 56, 62 (2d Cir. 2001) (United States).

⁶² *Ralf Sieckmann v. Deutsches Patent and Markenamt*, Case C-273/00, 12 Dec 2002 (ECJ).

court ruled that since it does not meet any of the criteria it fails to get the trade mark registration for the scent. While visual marks such as words or devices can satisfy all seven criteria, for non-visual marks this appears difficult. Even the Indian Trademark registry follows the Sieckmann criteria in its Draft Manual and disallows scent marks on the basis of graphical representation.

In United States, the Supreme Court has taken a tolerant approach with respect to graphically representing colour marks by stressing more on the requirements of acquired distinctiveness and the colour not being functional rather than emphasising on the clear and exact way of representing colour in the *Qualitex* case.⁶³ The Supreme Court held that the application for registration must contain a drawing of the mark- the one represented on the products. *Black & Decker Corporation* has registered the colour yellow for its saw blades.⁶⁴ The explanation complementing the drawing states “the mark consists of the colour yellow applied to the parameter of the saw blade so as to form a yellow rim on the saw blade. The dotted outline of the goods is intended to show the position of the mark and is not part of the mark shown.”⁶⁵ Nevertheless, there is no requirement of use of colour codes which is currently optional.

Moving on to sound marks, the ECJ still continues to keep a stringent prerequisite for graphical representation as in the *Sieckmann* case to represent both musical and non-musical sound marks as observed in the *Shield Mark Case*.⁶⁶ The court held in the case that for musical sounds an adequately thorough musical notation would suffice for example, “a stave divided into bars and showing, in particular, a clef, musical notes and rests whose form indicates the relative value and, where appropriate, accidentals and all of this notation determining the pitch and duration of the sounds.” For registration in India, it is clear from the Draft Manual that it encompasses the principles laid down in the *Shield Mark* for graphically representing a musical notation by laying down that, “Accordingly, a trade mark may consist of a sound and represented by a series of musical notes with or without words”⁶⁷ However, it was astonishing to note that the Manual has no reference to differentiate between musical and non-musical sounds and it seems that they are

⁶³ *Qualitex Co. v. Jacobson Products Co.* (93-1577), 514 U.S. 159 (1995, Supreme Court of the United States).

⁶⁴ *Ibid.*

⁶⁵ *Ibid.*

⁶⁶ *Shield Mark B.V. v. Joost Kist*, C-283/01 [2003] (ECJ).

⁶⁷ Government of India, Ministry of Commerce and Industries, *A Draft of Manual of Trade Marks: Practice & Procedure* IP INDIA (March 11, 2015), available at http://ipindia.nic.in/tmr_new/TMR_Manual/TMR_DraftManual_11March2015.pdf, last visited on 10/11/2016.

both treated at the same level which practically is not possible. The first case which came before the Registry is the Yahoo case⁶⁸ which made an application to register “a human voice yodelling yahoo”.

In the case of *In Re General Electric Broadcasting Co.*,⁶⁹ General Electric Broadcasting Company sought to register, as a sound mark, a ship's bell clock as a service mark for radio broadcasting services. The Trademark Trial and Appeal Board (TTAB) said that this sound mark could not be registered because it was not proven to identify the applicant's services. The Board held that the mark was not inherently distinctive and secondary meaning⁷⁰ had not been proven. The description of the sound is the only means for presenting the essence of the mark in any printed record.⁷¹ This is done because real sound cannot be represented visually and, hence, the U.S. system recognizes the description of the sound in the application as the accepted scope of the mark being sought.⁷²

The Lanham Act seems to allow the registration of scent marks because it has not specifically disqualified them. Furthermore, the United States Patent and Trademark Office has taken a positive position on their registration, identifying scent marks' ability to fulfill traditional trademark objectives and permitting scent mark registration on the principal register. The first scent to receive trademark protection was the scent described as a “high impact, fresh, floral fragrance reminiscent of Plumeria blossoms.”⁷³In this case, plumeria scent attached to sewing thread was registered as a US trademark.

Multimedia production has paved the way for more and more non-traditional trademarks: holograms, gestures and motion or moving image marks. Their registration typically requires the use of a sequence of pictures or drawings to portray how the trademark functions. Motion marks are perhaps the most common of the multimedia marks. Movie enthusiasts are familiar with the 20thCentury Fox Film Corporation logo with floodlights trailing back and forth across the sky, but few know it is a registered trademark⁷⁴. Few lesser known motion marks are the vertical

⁶⁸ *Supra* note 53, at 10.

⁶⁹ *In re General Electric Broadcasting Co., Inc.*, 199 U.S.P.Q. 560 (T.T.A.B, 1978) (United States).

⁷⁰ *Zatarain's, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786, 791 (5th Cir.1983) (United States).

⁷¹ *Kawasaki Motors Corp. v. H-D Michigan, Inc.*, 43 U.S.P.Q.2d 1521 (T.T.A.B, 1997) (United States).

⁷² *Ibid.*

⁷³ *In re Clarke*, 17 U.S.P.Q. 2d 1238 (T.T.A.B 1990) (United States).

⁷⁴ United States Patent and Trademark Office [hereinafter *USPTO*] Reg. No. 1.928.424.

opening of the Lamborghini car door,⁷⁵ the roar of the lion in the initial credit scenes of a movie (owned by MGM),⁷⁶ motion of Harley Davidson motorcycle while on idle⁷⁷ or the vertical spray of water from the back of a Yamaha Watercraft.⁷⁸

Speaking of taste marks, none of the applications for taste trademarks have been granted in the U.S. till date as none have been able to successfully convince the authorities that a flavour deserves trademark protection. In a very thoroughly observed case by flavor lovers, N.V. Organon, a Dutch company, failed to convince the TTAB that its flavor orange deserved trademark protection on antidepressant medication⁷⁹

In the United States, there is only one trademark registered for the feel or touch of the mark. The only registered mark is owned by American Wholesale Wine and Spirits, Inc. which registered the velvet texture covering on a bottle of wine.⁸⁰ Touch marks remain a very rare commodity for trademark offices worldwide. Till date, only three applications have been filed worldwide for the feel of a mark.

The U.S. Trademark Manual for examination requires under 1202.14 that a hologram used in variable forms does not function as a mark in the absence of proof that users would perceive it as a trademark. In re Upper Deck Co⁸¹ the Board held that a hologram used on trading cards in varying shapes, sizes, and positions did not function as a mark, because the record indicated that other enterprises used holograms on trading cards and other products as anti-counterfeiting devices, and there was no proof that the public would perceive applicant's hologram as an indicator of source. The Board noted that "the common use of holograms for non-trademark purposes means that consumers would be less likely to perceive applicant's uses of holograms as trademarks."⁸² There is no conclusive data to show that hologram marks are a significant part of the American Trademark regime.

⁷⁵ Automobile Lamborghini Holding S.P.A., USPTO Reg. No. 2793439.

⁷⁶ Metro-Goldwyn-Mayer Lion Corp., USPTO Reg. No. 1395550.

⁷⁷ Harley-Davidson, Inc., USPTO Serial No. 74485223.

⁷⁸ Yamaha Motor Corp., Ltd., USPTO Reg. No. 1946170.

⁷⁹ In re N.V. Organon, 79 U.S.P.Q.2d 1639 (TTAB 2006)(United States).

⁸⁰ USPTO Serial No. 76634174 (Registered Oct. 17, 2006).

⁸¹ 59 USPQ 2d 1688 (T.T.A.B 2001)(United States).

⁸² *Ibid.*

There are no registrations whatsoever in India when we talk about Scent, Motion, Hologram, Taste and Touch mark. This is largely due to the primary requirement of Graphical Representation, as mentioned earlier. The Indian Trademark Regime has, so far, imitated the stand of European Union as far as the prerequisite of graphical representation for a trademark is concerned. Thus, it makes registration of non-conventional trademarks much more rigorous in India than in the United States. The non-conventional trademarks possess ability of source identifier despite not being easily graphically representable. The working of US Trademark Regime demonstrates this fact.

CONCLUSION

SHOULD GRAPHICAL REPRESENTATION BE THE DECIDING FACTOR?

The TRIPS Agreement does not make ability of graphical representation as an essential condition for registration of a trademark. Similarly, the Trademark Regime of the United States does not require graphical representation of the trademark as a necessary condition for the registration of a trademark. This is primarily why the criteria for the registration of non-conventional trademarks have emerged as much more liberal in the United States in comparison to countries where graphical representation is a requisite for a trademark.

In India, after sustaining the prerequisite of graphical representation, the next obstacle that a mark has to pass is section 9(1) (a) of the Indian Trade Marks Act, 1999 which prescribes “absolute grounds for refusal” Marks which are not prima facie “capable of distinguishing” the goods or services of one person from those of the other are devoid of distinctive character. The foundation of the rationale is not noticeably provided in the statute. However, its purpose is to forbid common registration of marks which do not fall out of the definition of ‘trade mark’ but do not fulfil the function of a trade mark; that is, they do not identify and distinguish goods or services of one person from those of others. The section also contains a proviso by which a trade mark which violates Section 9(1) of the Act may still be registered if it can be shown that on the date of the application the mark has in fact acquired a distinctive character as a result of the use made of it. It suggests that even if certain signs are primarily descriptive of the character or quality of the goods or services they might, through constant use lose their descriptive meaning

and acquire a secondary distinctive meaning to indicate that the goods or services in connection with which they are used are goods made by a particular manufacturer. This was even expounded by the Supreme Court of India in *Godfrey Philips India*⁸³ where it held that “a descriptive trade mark may be entitled to protection if it has assumed a secondary meaning which identifies it with a particular product or as being from a particular source”. Thus, it can be argued that if a non-traditional trademark has acquired distinctiveness as a result of its continuous use, and a lot of people in fact associate the mark with its source, then such marks should be granted registration under this section. The applicants can also provide evidence that the mark was used for the product or service over a long period and the amount of time and money spent on its advertising was focused on educating the consumers to relate the mark as an indicator of origin and not a mere decoration. The company can also take efforts to educate people by the use of the mark in point of sale displays and packaging and use the mark in promotional efforts, including giveaways. The use of slogans is yet another way to promote the mark. Thus, we can categorically hold that the Indian Trademark Act 1999 has put a needless load of capability of graphical representation as a requirement for the registration of a trademark. In the progressively globalizing world, the use of sound, scent, touch, colour, taste motion or holograms as a trademark is guaranteed to rise in the near future. Thus, we should liberalize our trademark regime by watering down the must of graphical representation for such non-conventional trademarks.

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⁸³ 1997 (2) ARBLR 559 Delhi.

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