

L E X

WITNESS

Volume 10 Issue 11 | June 2019

₹65 US \$6 UK £4

expert speak



Dr. Manoj Kumar
Founder,
Hammurabi & Solomon

P50



Smita Paliwal
Associate,
King Stubb & Kasiva

P61



Niraj Singh
Partner,
RNS Associates

P64

let's arbitrate



S. Ravi Shankar
Sr. Partner, Law Senate

P56

insight



Robert Kang
Professor, Loyola Law
School, Los Angeles



Mike Morgan
Partner,
McDermott



Jessi Sawyer
Associate,
McDermott



Austin Mooney
Associate,
McDermott

P18

The Legal Quandary of Abrogation of Article 370

P08

the pondering pill



Krishna Venkat
Co-founding Partner,
Anoma Legal

P16

expert speak



Atmaja Tripathy
Associate, TMT Law Practice
Karan Kapoor
Associate, TMT Law Practice

P20

expert speak



Shumi Wasandi
Associate,
Singh & Singh

P38

expert speak

Namrta Sudan Rai
Associate Partner,
Dhir & Dhir Associates
Isha Singh
Associate, Dhir & Dhir Associates

P28



Non-Traditional Trade Marks: Relevance & Acceptance in India

■ Shumi Wasandi



he trademark owners have been adopting various forms of marks to distinguish their trade from others. The everlasting zeal to be

different and achieve recognition have led to the development of non-traditional trademarks such as sound, smell, taste marks which are being increasingly accepted around the world. Besides, the advent of the Internet and e-commerce have also increased the range of signs that businesses would like to use as registered trademarks. For example, motion and sound marks would capture the attention of Internet users much more efficiently than conventional marks, which in turn have catapulted their popularity in today's commercial world.¹

The traditional or conventional types of trademarks generally include those consisting of letters, numerals, words, logos, pictures, symbols, or combinations of one or more of these elements.² On the other hand non-traditional or unconventional trademarks include marks which are visually perceptible like colour (with delineated contours), the shape of goods, packaging and also non-visually perceptible such as sound, smell, touch and taste trademarks, which can be perceived by other senses of human body.³

The controversy surrounding the non-

traditional marks lies not only because of their type but also because of the scarcity of jurisprudence in their evolution in terms of their representation, registration and enforcement which on the other hand is well-settled in case of traditional marks.

Though the European Union (EU) and the United States of America (USA) provides for a substantial amount of jurisprudence on non-traditional trademarks, we still cannot say it is well-settled or bereft of conundrums. In India, the acceptance has already set in for the non-traditional trademarks and has moved forward in recognising these marks.

Here is an analysis of non-traditional trademarks in India. However, before discussing the relevance and acceptance of non-traditional trademarks in India, it is important to discuss its relevance and acceptance in the international scenario.

TRIPS ON NON-TRADITIONAL TRADE MARKS

The Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS)⁴ 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." The definition is exhaustive underlining that the function of the trademark predominantly is distinguishing the goods or services from those of others.



C-139, Defence Colony
New Delhi - 110024, India
T: +91 11 - 4987 6099
T: +91 11 - 4982 6000 to 6099
E: email@singhandsingh.com



Hence, there is no bar on the types of trademarks. The agreement also gives discretion to the member countries to make their own registration procedure as long as the trademarks and the interests of the trademark owners are protected.

NON-TRADITIONAL TRADE MARKS IN THE EUROPEAN UNION

In the European Union, the development of law on non-traditional trademarks can be attributed to the judicial decisions. The evolution of the law can be traced in back to the landmark cases such as the Sieckmann⁵ case on smell marks, the Shield Mark⁶ case on sound marks, the Libertel⁷ case on single colours, and Eli Lilly's⁸ case on taste marks, which brought a paradigm shift in the development of non-traditional marks not only in Europe but also inspired other jurisdictions to open

doors and cope up with the changing environment.

The non-traditional trademarks have now obtained statutory backing through the texts of the EU Trade Mark Regulation (EUTMR) and the Trade Marks Directive (TMD), which has been brought into force from 1st October, 2017⁹. The new legislation has removed the requirement for "graphical representation" when registering a trademark. Article 4, EUTMR and Article 3, TMD now define signs of which a trademark may consist as follows: "A trademark may consist of any signs, in particular words, including personal names, or designs, letters, numerals, colours, the shape of goods or of the packaging of goods, or sounds, provided that such signs are capable of: Distinguishing the goods or services of one undertaking from those of other

undertakings; and being represented on the register in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor." Thus, signs can be represented in any appropriate form as long as the representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective. The figurative, position, pattern, colour (single/combination), shape can be represented in JPEG format and sound, hologram, multimedia can be represented in JPEG or MP3 or MP4 format. However, the representation of the smell, taste and touch marks is still not clear.

NON-TRADITIONAL TRADE MARKS IN THE UNITED STATES OF AMERICA

In the USA, the Lanham's Act, 1946 definition of 'trademark' is an inclusive

one indicating that it does not exclude the non-traditional or the non-conventional trademarks. A trademark, in the USA, is “any word, name, symbol, or design, or any combination thereof, used in commerce to identify and distinguish the goods of one manufacturer or seller from those of another and to indicate the source of the goods.”¹⁰ This broad definition has no prerequisites of a graphical representation.

The US Court in *Re Celia Clarke* case,¹¹ for the first time, gave recognition to the smell marks, wherein the application for registering the written description of the smell of ‘a high impact, fresh floral fragrance reminiscent of Plumeria blossoms’ for sewing thread and embroidery yarn was accepted as a graphical representation and granted trademark protection.

Therefore, it can be said that any mark is registrable which fulfils the criteria of distinctiveness and settled principles of traditional trademarks. It is safe to say that USA does not differentiate between the traditional or non-traditional trademarks.

NON-TRADITIONAL TRADE MARKS IN INDIA

India has shown a modern approach

towards non-traditional marks, though it can be said that there are certain grey areas especially in the field of smell, taste and touch marks. The sound marks have been given protection since 2008 when YAHOO YODEL was granted registration. The trademark registration manual of the Trade Marks Registry provides the necessary guidelines as to the examination procedures and registrability criteria of non-conventional trademarks.¹² However, it is silent on the procedure of registration of the smell, taste and touch marks.

On one hand, trademark law has embraced an open-ended definition that emphasizes the functional aspect of a mark. Any mark which does the communicative work of a trademark by distinguishing goods or services on the basis of trade origin can be registered as one. And, on the other hand, trade mark registration systems have historically developed around paradigmatic subject matter: a conventional or traditional trademark that is visual and consists of words, devices or a combination of the two. The arguments stem from the fact that the registration procedure for these marks rest upon the requirement of graphical representation which is difficult to be fulfilled in the case of non-traditional marks. The requirement is

clear but to make a visual graphical representation of these unusual marks is a difficult task.¹³

A trade mark is defined in section 2(1)(zb) as follows: “‘trade mark’ means 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”.¹⁴

Where the ‘mark’ is defined in section 2(1)(m): “‘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”.¹⁵ While this is an inclusive definition, the Manual clarifies that certain categories of marks, such as shapes, colours, sounds and smells, will require special consideration.¹⁶

Rule 2(1)(k) of the Trade Mark Rules, 2017 says that graphical representation means the representation of a trade mark for goods or services in paper form.

Even though mark has been given inclusive definition, to qualify as a trademark the conditions to be fulfilled are -

¹⁰Dev Gangjee, “Non-Conventional Trademarks in India” 22(1) NLSIR (2010)., ¹¹Lisa P. Lukose, “Unconventional Trademarks: Novel Trends in the Modern Trademark Law” 1(1) CNLU Law Journal 22-33 (2010).

¹²The Manual (Draft) of Trademarks Practice and Procedure of Indian Trademark Registry, 2015, ¹³The Agreement on the Trade Related Aspects of Intellectual Property Rights, 1994, art. 15., ¹⁴Sieckmann v. Deutsches Patent-und Markenamt, C-273/00, 2002 E.C.R. I-1173., ¹⁵Shield Mark BV vs. Joost Kis, [2003] EUECJ C-283/01, ¹⁶Libertel Groep v Benelux Merkenbureau, 2004 FSR 465, ¹⁷Trade Mark Application [2004] ETMR 4.

¹⁸https://euipo.europa.eu/tunnel-web/secure/webdav/guest/document_library/contentPdfs/trade_marks/draft-guidelines (last visited on April 5, 2018).

¹⁹15 U.S. Code § 1127: The term “trademark” includes any word, name, symbol, or device, or any combination thereof—(1) used by a person, or (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter, to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown., ²⁰USPQ 2D 1238(1990)., ²¹A draft of Manual Trade Marks, Practice and Procedure, [hereinafter referred to as *The Manual*] 10th March, 2015, India, available at http://www.ipindia.nic.in/writereaddata/Portal/IPOGuidelinesManuals/1_32_1_tmr-draft-manual.pdf (last visited on April 1, 2018)., ²²Dev Gangjee, “Non-Conventional Trademarks in India” 22(1) NLSIR (2010).

²³The Trade Marks Act, 1999, sec. 2(1)(zb)., ²⁴The Trade Marks Act, 1999, sec. 2(1)(m)., ²⁵The Manual, Chapter III at 3.2.4., ²⁶Supra note 12.

1. Mark
2. capable of being represented graphically
3. capable of distinguishing the goods or services of one person from those of others.

Recognizing these non-conventional marks began in 2008 when the first sound mark, the Yahoo Yodel was registered and since then there has been no looking back. Further, shape marks are also gaining acceptance. The Manual released in 2015 by the Indian Trade Marks Registry moving with the evolution of these non-traditional marks incorporated and laid down the procedure and examination of these type of marks.¹⁷

SOUND MARKS

After Yahoo Yodel, ICICI got its sound mark registered for its corporate jingle “Dhin Chik Dhin Chik.” The acceptability of a sound mark depends on whether the sound is potentially distinctive or has acquired distinctiveness. The trademark registry allowed registration of another sound mark in India of Allianz Aktiengesellschaft¹⁸, and of Tarzen Yell for Edgar Rice Burroughs.

COLOUR MARKS

The combination of colours is clearly accepted as a trademark. However, the Manual states that for a colour mark to be a registered mark, a colour or combination of colours must be capable of distinguishing the goods or services of one trader from others.¹⁹ 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.²⁰ This was seen when Cadbury tried to get its colour purple registered in India, but it was denied.²¹

The significance of colour marks can be attributed to the fact that visually colours have the power to attract. Again, the colours have to be extensively used to become distinctive to get it registered as a trademark.²² The procedure under the Trade Marks Rules, 2017 for the registration of combination of colour as trademark is clearly stated to avoid any discrepancies.²³

Therefore, in India, the colour combination has already been incorporated in the definition of trade mark. Single colour, generally, cannot be monopolized unless it is proved that it has acquired distinctiveness and secondary meaning with respect to the goods it has been applied to.²⁴

SHAPE MARKS

When it comes to shape marks, one has to establish distinctiveness for shapes as required by section 9(1) of the Trade Marks Act, 1999 and should not fall under functionality based policy objections to registration of certain types of shape marks as laid under Section 9(3) of the Act.²⁵ The Manual adopts the factors to help structure the evidence required such as the applicant’s market share under that mark, the intensity and geographical usage, investment in promoting the mark, evidence of consumer recognition of the sign as a mark, and evidence from the

trade that the sign is considered to function as a mark. However, one of the fundamental requirements is that the shape must have been used as a trademark. It is not sufficient to claim a shape mark based on evidence of general advertising containing pictures of the product shape and consumer recognition of the associated word mark. The evidence must specifically show that the relevant public trusts the shape to indicate commercial origin in the same way that they would trust a word mark. The Birkin Bag as shape mark in the name of Hermès International has been granted registration by the Trade Marks Registry. The procedure for representation of the shape marks is clearly laid down in the Trade Marks Rules, 2017.²⁶

SMELL, TASTE AND TOUCH MARKS: A SPECIAL CASE

A trademark may be a sound, smell, taste, and touch mark and be represented by a series of musical notes, chemical formulas, precise description of the touch with or without words there is no bar but the condition is that it must be graphically represented on application form. Further, the representation must be clear, precise, self-contained, easily accessible, intelligible, durable and objective.

The Trade Mark Draft Manual has welcomed the progress in the development of non-conventional trademarks by taking a balanced view through clarifying that while non-conventional marks constitute categories



capable of trademarks registration, registration may be granted only in cases where the use of the mark is exceptional, has acquired secondary meaning, and capable of graphical representation. The requirement of representation imposes the greater challenge for the registration of non-traditional marks especially, touch, smell,

and taste. The Draft Manual leaves ends loose with respect to these marks. The Draft Manual provides a robust structure within which it allows gradual evolution of principles in this area. But the question is will it prove to be a valuable and flexible resource? This question can only be answered in time.^W

¹⁸Ibid, ¹⁹The Draft Manual, Chapter II at 2.7.8., ²⁰Ibid., ²¹Another case on the same lines wherein single colour registration was not granted. *GM Pens International v. Cello Plastic Products Co.* 115 (1969) D.L.T. 125(5)., ²²It is noteworthy that Pepsi-Cola spent more than US \$ 500 million in a worldwide market campaign called 'Project Blue' to strengthen and personalize the blue colour as Pepsi identifier., ²³Rule 23(2)(d) under the Trade Mark Rules, 2017 lays down that colour marks shall be considered a trademark consisting of combination of colours only if it contains a statement to that effect. Further the registration shall only be granted if the application is accompanied with the reproduction of the trademark in that combination of colours. Rule 26(2) absolutely establishes that the colour combination should be claimed as the distinctive feature of the trademark under the application to be granted protection through registration., ²⁴The intention of allowing registration of the combination of colours as opposed to single colours can be firstly, if the colours are not used in a special pattern or particular pattern or arrangement or in a manner, it is unlikely that they would enjoy distinctiveness as a badge of origin and secondly, fear of colours to be depleted.

²⁵A mark shall not be registered as a trademark if it consists exclusively of: (a) the shape of goods which results from the nature of goods themselves; or (b) the shape of goods which is necessary to obtain a technical result; or (c) the shape which gives substantial value to the goods.

²⁶Rule 23 (2) (c) under the Trade Marks Rules, 2017 lays down that the application for the registration of a three dimensional mark as a trademark must contain a statement to that effect; also under rule 26 clause 3 the legislature lays down that, the representation of the trademark shall be made in a two-dimensional graphic or photographic reproduction as follows: a) The reproduction of the trademark shall consist of three different views of the trademark; b) Where, the Registrar considers the above is not a sufficient representation of the three-dimensional trademark, he may call upon the applicant to furnish within a period of two months, up to five different views of the trademark; c) Lastly, the Registrar may call upon the applicant to furnish a specimen of the trademark where the above representation is not sufficient.



Shumi Wasandi is currently working with Singh & Singh Law Firm as an Associate under Mr. Sudeep Chatterjee, Partner. Her practice areas include Trademark Prosecution & Opposition, and Cancellation Action before Trade Marks Registry, Intellectual Property Appellate Board & Copyright Prosecution. She also has a keen interest in Media & Sports Law.