

NON-CONVENTIONAL TRADEMARKS AND ITS PROSPECTS

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Going the unconventional way: Non-conventional trademarks and its prospects

“Innovation means you” is a tagline used by the Philips technology and to a certain context this tagline is defining the future of the human race. The entire human race has progressed on this very principle of “innovation”, starting from lighting fire from rubbing stones to an age where lighters hit the spark. This has also been seen in the field of intellectual property rights. This field has seen some drastic changes, from the times where people didn’t even knew the meaning of the term to a time when people are asking trademarks for those things as well which can only be felt and not seen. The present essay aims at highlighting the importance of trademarks in some non conventional areas like smell and colour, which cannot be touched or seen but has a major impact on the minds of the consumer. Not only have they created an impact on the minds of the consumers but also on the business lines as now brands like channel and yahoo have got their scents and doodles trademarked respectively. This has all together changed the way people used to think about trademarks and has introduced a completely new line of business products into the trademark sector.

These trademarks are particularly challenging because they alter the definition of the trademarks, though the purpose remains intact. This essay deals with the trademarks

Trademarks play a very important role not only in the realm of the intellectual property but also from the perspective of the general development in the society. The idea behind trademarks is multi layered. A trademark is economically efficient because it allows the consumer to identify the service or good that he prefers and to buy that to the exclusion of others in the future.¹ Moreover, since good quality is associated with that particular trademark, infringement claims exist when another undertaking uses a similar mark.² This prevents the latter from

¹ I J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION 2-3 (4th ed. 2000)

² Zippo Mfg. Co. v. Rogers Imports, Inc., 216 F. Supp. 670, 137 U.S.P.Q. 413 (S.D.N.Y. 1963)

unjustly enriching from the labour and reputation of the holder of the original mark, and protects consumer interests.³ Traditionally this was restricted to the graphical representation and therefore only a certain logos/ designs were registered as trademarks. But with the evolution of technology and the perception of the consumer mind sets, it was felt that the trademarks are lacking a certain crucial aspect. Increasingly all over the world, recognizing the potential contained therein, different combinations have been sought to be trademarked.⁴ This includes a variety of things ranging from the Intel jingle to the shape of the Coca Cola bottle. The common feature of these trademarks is that they are not visually perceptible but yet they have been trademarked because of certain level of identification involved from the consumer point of view. While such new types of marks raise interesting conceptual questions,⁵ they are of a more immediate and pragmatic concern to an Indian audience. It has been widely reported that the Indian trade mark registry recently registered a soundmark for Yahoo⁶ followed by another for Allianz Aktiengesellschaft. Hence the paper aims to answer certain crucial and overreaching issues that are crucial in the ambit of the non conventional trademarks:

1. Is their inclusion leading to a depletion of available intellectual property resources and creating an unfair competitive and monopolized market?
2. Are these marks capable of fulfilling the purpose of the trademarks?
3. Finally, does the fact that these marks are not visually perceptible create any confusion on what has been registered?

GRAPHICAL REPRESENTATION OF NON CONVENTIONAL TRADEMARKS

A. Odour mark

This is the trickiest and perhaps the most interesting a trademark of all, as it presents an altogether and therefore they have gained a lot of attention in the recent times. In spite of the problems accounted for in the registration of the unconventional patents, few odours have already been registered as trademark and many withdrawn or registered at the registries of different countries.⁷ One such illustrative case where smell mark was rejected on the basis of non-fulfilment of the graphical represent ability

³B.V.D. Co. v. Kaufmann & Baer Co., 272 Pa. 240, 116 A. 508 (1922); Palmer v. Harris, 60 Pa. 156 (1869)

⁴David Vaver, Intellectual Property: The State of the Art, 116 L.Q. REV. 621, 625 (2000).

⁵Yet Another Sound Mark Granted, available at <http://spicyipindia.blogspot.com/2009/07/yet-another-sound-mark-granted.html>

⁶*Ibid* note 2

⁷e M. Handler, The distinctive problem of European trade mark law, E.I.P.R. 2005, 27(9), p. 309

criteria among other factors is that of *Ralf Seickman v. German Patent Office*⁸. The scenario is different in USA where, trademark manual examining procedure states that trademark applicants needs not submit a drawing of the trademark, if the mark consist of solely of non visual marks such as sound or scent.⁹

B. Sound marks

Using sound as a unique identifier for a brand hasn't been a marketing tool for very long. The first successful application for a sound mark was registered in 1978 and was filed by NBC, one of the country's largest media conglomerates.¹⁰ The Lanham Act, which established the main chunk of the U.S.'s modern trademark law, allows for "any word, name, symbol, or device" to be registered by that mark's owner as long as they have a bonafide right to its use and intend to use it in commerce.¹¹ So there really isn't anything in the Lanham Act that precludes the registration of a sound mark.¹² In *Shield Mark BV vs Joost Kist*¹³ the ECJ basically repeats the criteria from *Sieckmann v German Patent Office*¹⁴ that graphical representation, preferably means by images, lines or characters, and that the representation must be clear, precise, self-contained, easily accessible, intelligible, durable and objective. This definition generally encompasses sound marks, and therefore an applicant for a CTM may use musical notation to graphically represent their trademark.¹⁵ A piece of music—a tune or a ring tone on a telephone—can be easily registered as a trademark (provided, of course, that it meets the Community trademark tests for registrability and distinctiveness).¹⁶

⁸http://www.wipo.int/sme/en/documents/wipo_magazine/7_2

⁹ [http://nopr.niscair.res.in/bitstream/123456789/3588/1/JIPR%2011\(5\)%20313-317.pdf](http://nopr.niscair.res.in/bitstream/123456789/3588/1/JIPR%2011(5)%20313-317.pdf)

¹⁰Russell H. Falconer, Big Future for Nontraditional Marks, NAT'L L.J., May 18, 1998, at C28 (discussing risks and opportunities of nontraditional mark use); Jerome Gilson & Anne Gilson LaLonde, Cinnamon Buns, Marching Ducks and Cherry-Scented Racecar Exhaust: Protecting Nontraditional Trademarks

¹¹Mitchell Study on Trademark Litigation,

<http://www.wmitchell.edu/iintellectualproperty/?page=321&Mitchell+Study+on+-Trademark+Litigation>

¹²Metro-Goldwyn-Mayer Lion Corp., Reg. No. 1,395,550 ("The mark comprises a lion roaring.").

¹³World Intellectual Property Organization [WIPO], Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications: Summary of Replies to the Questionnaire on Trademark Law and Practice

¹⁴World Intellectual Property Organization, Member States Agree to Move Ahead With Efforts To Harmonize Trademark Law, http://www.wipo.int/pressroom/en/html.jsp?file=/redocs/prdocs/en/2001/wipoupd2001_154.html

¹⁵Edward Grosek, The Multilateral Agreements that Protect Trademarks and Marks that Indicate Origins of Source

¹⁶Timothy W. Blakely, Beyond the International Harmonization of Trademark Law: The Community Trade Mark as a Model of Unitary Transnational Trademark Protection

C. Scent trademarks

The first undertaking which sought to register a scent under the 1994 Act was Chanel for the scent of its fragrance Chanel No. 5. The application was rejected on the grounds of being functional; the fragrance was the product itself.¹⁷ On the same day, Sumitomo Rubber Co. sought the registration of “a floral fragrance/smell reminiscent of roses as applied to tyres”¹⁸ and Unicorn Products sought to register “the strong smell of bitter beer applied to flight darts”.¹⁹ Both these applications were successful.²⁰

While in USA the first scent to receive trademark protection was the scent described as a “high impact, fresh, floral fragrance reminiscent of Plumeria blossoms.”²¹ The normal restrictions for determining what can be trademarked were laid down. The scent had to be distinctive of the product and it could not be utilitarian or functional. Therefore the fragrance of a perfume could not be registered.²² Moreover, in terms of graphical representation, the court stated that while drawings were not required, description of the scent was required.²³

NON CONVENTIONAL TRADEMARKS AND ITS PROTECTION UNDER VARIOUS JURISDICTIONS

I. Non conventional trademarks :USA

Granting protection to untraditional trademarks has been significantly easy in the US where TMs have been defined broadly and there exists no prerequisite of a “graphical representation.”

²⁴In other words, marks which consist only of a sound, a scent, or other completely non-visual

¹⁷ Chanel’s Application, 31 October 1994, cited from Nathan K G Lau, Registration of Olfactory Marks as Trademarks: Insurmountable Problems?

¹⁸ Sumitomo Rubber Co’s Application No. 2001416, 31 October 1994

¹⁹ Unicorn Products’ Application No 2000234, 31 October 1994

²⁰ Another relevant case which came before the OHIM is the case of ‘Freshly Cut Grass’, Second Board of Appeal, European Court of Justice, Case R 156/1998. An application was sought to register the “smell of freshly cut grass” for tennis balls, in the European Community. The OHIM held that the smell was distinctive, and the description was in compliance with Article 4 of the Community Trade Mark Regulations

²¹ In re Clarke, 17 USPQ2d 1238 (TTAB 1990). The goods for which this scent was required was sewing thread and yarn required for embroidery

²² Perhaps there has been only one other scent that has received trademark protection in the USA. This is that of office supplies such files and folders manufactured by Smead Manufacturing Company. The scent was described as that consisting of a Vanilla scent or fragrance. The registration number is No. 3143735. See Jacey McGrath, The New Breed of Trade Marks: Sounds, Smells and Tastes, 32 VICTORIA UNI. WELLINGTON L. REV. 277, 278

²³ <http://www.commonlii.org/in/journals/NALSARStuLawRw/2011/9.pdf>

²⁴ e David Vaver, Recent Trends in European Trademark Law: Of Shapes, Senses and Sensation, 95 THE TRADEMARK REPORTER, 895, 900 (2005); Jerome Gilson et al., Cinnamon Buns, Marching Ducks and

matter, which would only require a detailed verbal description, are equally capable of protection under the US laws.²⁵ Perhaps the oldest untraditional mark to be registered is the National Broadcasting Company (NBC) jingle which received protection in the US in 1970 under the category of Sensory Marks.²⁶ The jingle, with a vague description of notes used, was not accompanied with a notation sheet. Furthermore, singular colours, and smell or olfactory marks have also acquired the status of TMs when they do not perform any function in the relevant industry and have acquired distinctiveness.²⁷

Section 1052 of the Lanham Act is the relevant provision enabling determination of what can be trademarked.²⁸ 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.²⁹

The registration of non-conventional marks is further helped by the decision of the U.S. Supreme Court in *Qualitex Co v. Jacobson Products Co.*³⁰, wherein it held that a trademark can be “almost anything at all that is capable of carrying meaning”.³¹

II. Non conventional trademark: EUROPE

European trademark law comprises the national laws of countries in line with European Directives, along with the decisions of the European Court of Justice (ECJ); the Madrid Protocol acting as another significant source of norm-setting.³² Trademarks can either be

CherryScentedRacecar Exhaust: Protecting Nontraditional Trademarks, 95 *The Trademark Reporter* 773, 777 (2005)

²⁵LyndraZadra-Symes, Sounds, Smells, Shapes and Colours: Protection of Nontraditional Trademarks in the U.S., available at http://www.kmob.com/pdf/Sounds_Smells_Shapes_and_Colors.pdf

²⁶Brinks Hofer Gilson &Lione, The Sound of Unconventional Marks in the United States, *WORLD TRADEMARK REV.* 94

²⁷*Ibid* 23

²⁸*Ibid* 24

²⁹U.S. Lanham Act, 15 U.S.C. § 1052

³⁰*Qualitex Co v. Jacobson Products Co.*, 514 US 159 (1995)

³¹Brinks Hofer Gilson &Lione, The Sound of Unconventional Marks in the United States, *WORLD TRADEMARK REV.* 94

³²Paul Leo Carl Torremans, Trademark Law: Is Europe Moving Towards an Unduly Wide Approach for Anyone to Follow?

registered at a national level or achieve the status of a Community Trademark (throughout EU) by registration at the Office for Harmonisation in the Internal Market (OHIM).³³

III. Non conventional trademarks: INDIA

The scenario in India is very different as compared to case in US and EU; very few unconventional marks have received registration in India. Nonetheless, unlike the Trade and Merchandise Marks Act of 1958, the Trade Marks Act of 1999 (the Act) and the Trade Marks Rules of 2002 do refer to non-conventional trademarks.³⁴ Another interesting document which needs to be referred to is the Draft Manual for Trademark Practice & Procedure (Draft Manual).³⁵

A reading of Sections 2(1)(zb)³⁶ and 2(1)(m)³⁷ of the Act shows that the definition of “trade mark” has been widened to include shapes, packaging and combination of colours. As specified in the Manual,³⁸ this is an inclusive definition including any mark as long as the mark is capable of being represented graphically and capable of distinguishing the goods or services of one person from that of the others. Nonetheless, it has been stated that colours, shapes, sounds and smells will require “special consideration” during registration.

With respect to the graphical representation of sound marks, India has simply imported the Shield Mark doctrine.³⁹ Nonetheless, with regard to distinctiveness, the Manual specifically

³³David Vaver, Intellectual Property: The State of the Art, 116 L.Q. REV. 621, 625 (2000)

³⁴See TajKunwar Paul et al., Reincarnation of Trade Mark Law in India, 86 J. PATENT AND TRADE MARK OFFICE SOCIETY 237, 240 (2004)

³⁵The Draft Manual serves the purpose of a guide to the trade mark examiners, traders and the general public, in order to achieve uniformity and precision in practice. Nonetheless, as stated, if anything in the Manual is at variance with the Act and the Rules, the latter will prevail. See Preface and Section 5, The Draft Manual (Revised) for Trademark Practice & Procedure, available at http://ipindia.nic.in/tmr_new/TMR_Manual/DraftManual_TMR_23January2009.pdf

³⁶“Trade mark” is defined as a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from choose of others and may include shape of goods, their packaging and combination of colours , and in relation to Chapter XII (other than section 107), a registered trade mark or mark used in relation to goods or services for the purpose of indicating or so as to indicate a connection in the course of trade between the goods or services, as the case may be, and some person having the right as proprietor to use the mark, and in relation to other provisions of this Act, a mark used or proposed to be used in relation to goods or services for the purpose of indicating or so to indicate a connection in the course of trade between the goods or services, as the case may be, and some person having the right, either as proprietor or by way of permitted user, to use the mark whether with or without any indication of the identity of that person, and includes a certification trade mark or collective mark.

³⁷“Mark” includes a device, brand, heading, lable, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination thereof.

³⁸See Section 3, Draft Manual.

³⁹See Section. 5.2.2.1, Draft Manual

lists sounds which are not distinctive and thus will not be registered.⁴⁰ The registry has not probed into music which provides a certain distinctive character but rather there is an exhaustive list for the same. In case of scent also the registry goes by the Shield Mark doctrine and seeks a graphical representation for the registration of the scent despite acknowledging the fact that registration of scent is a crucial aspect.

Judicial precedents of non conventional trademarks in India

Three non-conventional trademarks have received registration in India so far. Yahoo!'s yodel is the first non-conventional mark to be registered. The yodel was represented through musical notes.⁴¹ The shape of the Zippo lighter was also granted registration, which was later confirmed in a trademark infringement suit in the Delhi High Court, on the ground that it was distinctive.⁴² The latest nonconventional trademark to be registered is a sound mark, held by a German company Allianz Aktiengesellschaft.⁴³ The Trademark Registry in India has granted registration to ICICI Bank Ltd for its sound mark by registering the very notes that form the jingle. ICICI Bank is the first Indian entity to obtain sound mark registration.⁴⁴

There are certain reasons why still Indian courts are apprehensive of granting non conventional trademarks as some say that it is restricting the free access to intellectual property rights, but eventually this is a positive phenomenon. The idea behind giving trademarks is to mark something distinctive, which is a great help to consumers. Similarly in non conventional trademarks there are lot many consumers who are illiterate or are visually impaired, for them the distinguishing character is the shape or the sign, hence this aims at creating a multi sensory perception⁴⁵ and thereby stimulating an entire market for it.

Secondly there is an argument that possibly this is the very functionality of the product to have a certain smell or shape and therefore this cannot be trademarked. But eventually this might be not be true in every case as for example asian paints cannot get a certain smell trademarked

⁴⁰These include, inter alia, nursery rhymes and simple pieces of music of only 1 or 2 notes. See Section 5.2.2.2, Draft Manual

⁴¹Peter Ollier, Yahoo Yodels into India's TM Registry, 183 MANAGING INTELLECTUAL PROPERTY 14 (2008); ShamnadBasheer, India's first "Sound Mark" Registered, SPICYIP, 19 August, 2008, available at <http://spicyipindia.blogspot.com/2008/08/breaking-news-indias-first-sound-mark.html>

⁴²Zippo v. Anil Manchandani (unreported, CS (OS). 1355/2006). See also ShwetareeMajumdar, "Zippo shape mark protected by Indian Court", SpicyIP blog, August 18th, 2006, available at <http://spicyipindia.blogspot.com/2006/08/zippo-shape-mark-protected-by-indian.html>

⁴³Santosh Singh, Yet Another Sound Mark Granted, SPICYIP, 30 July 2009, available at <http://spicyipindia.blogspot.com/2009/07/yet-another-sound-mark-granted.html>

⁴⁴ <http://www.mondaq.com/india/x/472602/Trademark/NonConventional+Trademarks+in+India>

⁴⁵ <https://spicyip.com/2010/09/guest-post-defence-of-non-conventional.html>

because all these perfumes have a smell but there are various other products like as discussed above channel 5 perfume, which has a distinctive smell and therefore can be trademarked.

CONCLUSION

The definition of the trademark incorporated in the trademark act paved the way for the invasion of non-conventional trademark.⁴⁶ The traditional concept was associated with the visual difference in the product, however in the recent years there has been a paradigm shift which has the psychological impact of trademarks on consumers such as the nonconventional trademarks which gained an increased commercial significance and therefore deserves the protection.⁴⁷ The few barriers associated with the non-conventional trademarks must not serve as a deterrent to their use, on the contrary new classification and methods should be incorporated. As the non-conventional resources are on the latest tool in the present era of innovation.⁴⁸ However India is one of the countries who protect the non-conventional trademarks which is highlighted by the fact that the trademark registry has accepted the sound trademark of Intel. The supplement of draft manual is a crucial one as it issued the guidelines for regulating the same with the greater aim for uniformity, transparency and efficiency in operation. The concept and law related aspect of non-conventional trademarks are evolving in India. However, there is a need for uniformity across the globe.

As McCarthy has remarked, **“One cannot come to the bottom-line conclusion that any item is “in the public domain” until one has exhausted all of the possible areas of exclusive intellectual property rights.”**⁴⁹ And therefore that is the reason why in the USA and in the EU, non-conventional trademarks ranging from the smell of freshly cut grass (for tennis balls) to the Intel jingle have received trademark protection.

⁴⁶Non-conventional trademarks in India by devGangjee, may 30 2010 available at <https://spicyip.com/2010/05/non-conventional-trademarks-in-india-by.htm/>

⁴⁷Barbara Berg, The scent of surprise, <http://fhcrc.org/visitor/nobel/buck/article.html> (10 March 2006)

⁴⁸Non conventional trademarks .11 July 2008 available at <http://lawquestinternational.com/2008/11/07/non-conventional-trademarks>

⁴⁹ Supra note 45