

NON CONVENTIONAL TRADEMARKS: A LEGAL ANALYSIS

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DOI: doi.org/10.55662/IJLDAI.2022.8401

ABSTRACT

The traditional range of trademarks has been limited to word, symbol or design or a combination thereof. Even if there are small differences from country to country, this scope is somewhat steady and the expansion of this scope has been discussed for more than 100 years. Any trademark that does not fall within that traditional scope of ‘word, symbol or design or a combination thereof’ shall be considered as a non conventional trademark.

With the industries seeking new forms of protecting their marks with sensory appeal through colour, scent and sound, the adoption warrants special consideration. Across the globe, though these marks have attained attraction, the difficulty in graphical representation of these marks hinders their statutory recognition.

Over time, colour and colour combinations play an important role in distinguishing products in the marketplace. The use of single colour per se has got recognition in many jurisdictions. Yet another important leap is in the introduction of sound marks and scent marks in commerce. The reduction of these marks into a description in paper is what makes it difficult to provide statutory recognition.

Though this new concept of unconventional trademarks is helpful to the customers and innovative to the producers, this has expanded the subject matter eligible to be protected. This expansion has erased the clear delineation between patent, copyright and trademark law and

leads to overlaps that allow multiple bodies of intellectual property law to simultaneously protect the same subject matter. The overlapping of intellectual property rights are not yet addressed among nations. Often these overlaps can create overprotection of intellectual property by avoiding some of the carefully developed doctrines designed to limit protection under a specific body of intellectual property law.

CONCEPT OF TRADEMARK

A trademark is a limited property right in a word, phrase, or a symbol. Trademarks are words, phrases, symbols, or designs or a combination of words, phrases, symbols, or designs, that identify a business (or individual) as the source of goods or services provided under or in connection with the mark. They are intangible property that denote a particular standard of quality, distinguish one party's goods or services from those of another, symbolize the goodwill of the owner, and protect the public from confusion and deception. A trademark protects the right to distinguish the owner's goods or services from other goods or services that might be confused with the owner's. The prevention of confusion is the touchstone of trademark protection.ⁱ

Statutorily, trademark is defined as “trademark means a mark capable of being represented graphically and which is capable of distinguishing goods or services of one person from those of others and may include shape of goods, their packaging and combination of colours.”ⁱⁱ Selecting a trademark may not be easy. It may be tempting to choose a word that seems “catchy” and describes a feature or characteristic of your goods or services. However, as a general rule, terms that are merely descriptive of products and services can be difficult to protect as marks, and the more descriptive your mark is of your goods or service, the more difficult it may be to stop your competitors from using it. The strongest marks typically have no meaning in relation to the goods or services for which they are used.

The relative strength of a particular trademark depends upon where it falls within a range of five categories: fanciful, arbitrary, suggestive, descriptive, or generic. The greatest protection comes for fanciful marks consisting of invented words such as XEROR, KODAK etc. The next strongest protection comes for arbitrary words, which are commonplace words used in a manner that is unrelated to their dictionary meaning. The least protection comes for descriptive marks that do little more than describe the characteristics or contents of the product. Finally

generic names, which merely state what the product or service is, cannot function as trademarks.ⁱⁱⁱ

Trademarks, often known and used as brand names, are a part of everyday life. The main purpose of a trademark is to enable the public to recognize the goods or services as originating in a particular company or being a particular product or service. Trademarks are protected by law in order to serve this source-indicating function and prevent the public from being confused about the source of the goods or services. By doing this, a trademark also helps to assure that the trademark owner, and not an imitative competitor, will reap the rewards associated with a desirable product.

NON-CONVENTIONAL TRADEMARKS- THE EMERGENCE

The open ended definition of trademark as provided under the TRIPS gave the world opportunity to register trademarks other than the traditional forms of trademark like pictures, words and their combinations. Non-conventional trademarks are exceptional and unique in nature because unlike traditional trademarks, they are sometimes non-ocular like sound, smell, feel and taste; some are not static like moving image marks and digital marks; and others such as gestures and holograms.^{iv} Shape, color, stitching pattern, design and sound were in use by different companies for more than a decade to signify brand origins, although their legal protection and registration were subsequent development.

Marketing specialists believe that if a customer heard a familiar, comforting sound associated with particular kind of tea, he would be more likely to choose it or that the smell of freshly cut grass emanating from tennis balls would make the consumer a winner.^v At this time most of the consumers recognize a variety or brand not just by its name and infamy but also the demonstrative attachment that they have towards the particular brands. Pleasing to the artistic sense of the consumer has become one of the preliminary objectives of all businesses. The modern technology has produced products more to see, smell, touch, taste or hear in the physical world than people would otherwise get through their non augmented faculties.

Non-conventional trademarks are inventive ways to communicate with consumers the source of origin of goods or services. It offers dynamic opportunity to the traders in the global market. These marks bear a high potential of economic assets and leave on consumers high degree of

commercial impression with its unique smell or touch. The TRIPS recognizes the registration of shape of goods, their packaging, trade dress and combination of colors as trademarks. Smells, sounds, taste, holograms are not explicitly mentioned in the definition, but a plain reading of the section suggests that since the agreement provides an inclusive definition, it is wide enough to include these non-conventional trademarks within its ambit. The importance of protecting non-conventional trademarks is that they identifies the source or origin, links the mark, the product and the proprietor, guarantees quality and advertises the product.^{vi}

Since the primary function of a trademark is to identify the product, the recognition of non-conventional trademarks is important as they have greater potential than conventional trademarks. Also, people in low literacy areas usually identify a product by their shape, color or smell. Non-conventional trademarks is also helpful for visually impaired and the illiterate people. In view of the developments in trading and commercial practices and the increasing globalization of trade and industry, several countries including US and EU have recognized and granted registration for several non-conventional trademarks.

To categorize different signs that may be registered as trademark, the Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (in short, SCT) grouped them according to whether they are visually perceptible or whether they may be perceived by senses other than the sense of sight. Visible signs include three dimensional marks, colour marks, holograms, slogans, titles of films and books, motion or multimedia signs, position marks and gesture marks. While non visible sings include sound marks, olfactory marks and taste marks.^{vii}

Colour is essential to the brand building process because it's the most visible first point of communication. All goods have some colour but it is primarily used as ornamentation. If colour has acquired distinctiveness for goods or services and is not functional, colour alone can be registered and protected in the same manner as a traditional word or logo trademark. Colour marks consist exclusively of one colour (or rarely more than one colour) on a certain product, on all or part of the product itself or on all or part of its packaging. Several colour marks are registered with the USPTO, for example, for tools and construction materials, and some are registered for medical equipment. More familiar consumer products also enjoy colour registration protection. The eye-catching robin's-egg blue colour is registered for Tiffany's boxes and bags and the unexpected green colour is registered for ketchup.

Signs consisting of a sound which are capable of distinguishing the goods or services of one undertaking from those of other undertakings and are capable of being represented graphically are registerable as trademarks. If a sound lingers in the mind of the listener and the listener subsequently associates a source or event with that sound, then it can be said that the particular sound can serve as a source of identity. Sound mark can be in the form of onomatopoeia and musical notes. A sound mark may consist of songs, strings of notes with or without words, jingles, well-known sounds which occur in nature, unusual sounds which occur in nature or electronic sounds not occurring in nature. The Yahoo yodel, Metro Goldwyn Mayer's roar of the lion or Nokia tunes do remind us something about the sound being related to a particular product. As a result of this, consumers over a period of time tend to associate certain sounds as a source identifier or as a badge of origin.^{viii} As sound marks cannot be perceived visually, the graphical representation of a sound mark has to define clearly what constitutes the mark as applied for, so that the precise subject of the protection afforded by the registered mark can be determined.

Holograms have for long been used for security purposes on credit cards, concert tickets, certain currencies etc. The purpose of using hologram is to prevent counterfeiting and fraudulent replication, as replication of hologram is considered more difficult. Holograms by their nature possess multiple images or colours that are visibly only when viewed from different angles. Hence, holograms are difficult to capture in paper form, because the paper print will not be able to show the movement of the images.

Slogans are usually regarded as one protected under the copyright law. But the registration of a slogan as a trademark affords them a broader scope of protection. The advertising power of slogans has been recognized by advertisers for decades. In the present world, modern advertising campaigns are often defined by a catchy slogan. Titles fulfilling necessary requirements for individualization and distinctiveness can be registered as trademark consisting of words, so its graphic representation is simple. The main challenge for trademark applicant is crossing with author copyright and publisher or promoter trademark. In certain jurisdictions, titles may be protected under *sui generis* systems. Such systems require that even where titles are basically understood as separate identifiers of works, they must, just like trademarks, be distinctive and not descriptive in respect of the work identified.^{ix}

A trademark consisting of an element of motion or movement of a certain object is called a motion or multimedia sign. The peculiar feature of a motion sign is that it is visually

perceivable combination of the object and the movement. The development of TV and internet has resulted in the widespread use of motion or multimedia signs. Position marks are specified by the position in which they appear or are fixed on a particular product. Usually position marks are registered as figurative or three dimensional marks. Regarding the graphic representation of position marks, SCT states that representation could include ‘a picture or drawing showing the special position of the mark with regard to the product, as well as a description in words.’^xIn the case of position marks also, the challenge is the difficulty in proving distinctiveness of the sign. Examples of position marks include: label with metal button in the middle of the ear of a teddy bear^{xi} and red aglets on shoe laces.^{xii}

Gesture marks can be registered as motion or figurative marks. Thus, graphic representation could be achieved through a single drawing or several frames depicting the gesture, accompanied by a written description. If it is considered as a motion mark, the sign would be represented with a series of still pictures or an electronic file showing the gesture, together with a description of the mark indicating the gesture concerned.^{xiii}

Olfactory marks or smell marks are potentially registerable, as they can indicate commercial origin of goods or services. A clear, precise, self-contained, easily accessible, intelligible, durable and objective representation could make a smell registerable as trademark. Similarly, flavour can also be registered as trademark. If a flavour is used in a manner calculated to project to purchasers or potential purchasers a single source or origin for the goods in question then it can be registered.

PROTECTION REQUIREMENTS

Trademarks are social and legal entities. This derives from the fact that misallocation of property rights in trademarks might have significant effects on society. Trademarks are, thus, jointly “authored” and owned by trademark owners and the consuming public. From amongst the theories that justify trademarks are theories that have been formulated some time ago such as Locke’s labour theory and Hegel’s personality theory.

Unlike other intellectual property rights, trademark laws did not embody any sign of utilitarian grounds for its justification. In the United Kingdom, trademark legislations did not refer to utilitarian grounds, whereas the case of copyright legislation is different. For example, the

Statute of Anne, the first Copyright Act provided explicitly in its preamble that this Act is “for the encouragement of learning, by vesting the copies of printed books in the Author’s or Purchasers of such copies. However, the lack of reference to utilitarian and economic grounds in trademark legislations does not mean that trademarks could not be justified on such grounds. Menell argues that utilitarianism is the principal theory to be applied to trademarks. According to him, “trademark law is principally concerned with ensuring that consumers are not misled in the marketplace and hence is principally amenable to economic analysis”.^{xiv}

The commonly used non-conventional trademarks include sound marks, smell marks, colour marks, three dimensional marks. The evidence surrounding the use of the mark will decide whether it functions as a trademark, not the intent of the party that attempts to establish it as such.^{xv} To determine whether a particular feature is merely decorative, the USPTO considers the following features: (1) the commercial impression of the proposed mark; (2) the relevant practices of the trade (3) secondary source, if applicable and (4) evidence on distinctiveness.^{xvi}

The recognition of non-conventional trademarks could also be justified in view of the developments in trading and commercial practices and the increasing globalization of trade and industry. Several countries including US and EU have recognized and granted registration for several unconventional trademarks. Like conventional trademarks, to an enterprise, non-conventional trademarks’ assets are of great commercial value and an important part of evolving business strategy and intellectual property portfolio.

The most important function of a trademark is that it helps the consumers in distinguishing the products of one producer from that of another. In this regard, the existence of non-conventional trademarks can also be justified. A non-conventional trademark makes it easier for the consumers to identify a product as belonging to a producer from those of similar kind. Sounds, colours and particular shapes attributed to a product will receive easy attention and will be easily recognized from a group of similar products. The producers will find it cheaper to advertise the products since these non-conventional trademarks once identified by the consumers will always be remembered. Thus non-conventional trademarks give economic benefit to the producers. Hence it can be summarized that non-conventional trademarks are equally important as that of conventional trademarks.

OBSTACLES

Non-conventional trademarks face the same challenges as descriptive marks and must undergo the same scrutiny in order to serve as a trademark. Non-conventional trademarks are not immediately viewed as a trademark, in part because they have not traditionally been used as such. More importantly, consumers need to be conditioned to perceive the claimed trademark as a source identifying feature: one that help a consumer distinguish one brand of goods and services from that of another. The law is concerned with the mind of the consumer and not the trademarks holder.^{xvii} In other words, trademarks should be viewed by the consumer as a brand, not as decorative or functional feature of the goods or services. Like descriptive marks, this is typically the case for non-conventional trademarks as they are perceived as simply a functional feature of the goods or services.

The greatest need for using non-conventional trademarks arises because market-savvy companies want to design and advertise their products in such a manner that it appeals to the consumer's aesthetic sense. However, while a non-conventional trademark is also entitled to protection as much as conventional trademark, there are certain underlying problems with the nature of such marks that impede the registration process.

The most striking factor about an olfactory mark is that it cannot be perceived visually. The question whether an olfactory mark can be considered as a trademark was considered for the first time in the Sieckmann case^{xviii} before the European Court of Justice (ECJ) which held that visual perception is not necessary as far as the mark can be graphically represented. Similarly in the case of R v. John Lewis^{xix}, the UK court refused an application for the 'smell, aroma or essence of cinnamon' as a trademark for furniture as the verbal description of smell was not enough to make a graphical representation. Meanwhile, in US, the Trademark Manual of Examining Procedure (TMEP) allows that a mark such as scent and sound that cannot be graphically represented can be explained by a written detailed description. In the case of In Re Celia Clarke^{xx}, the Court recognised that smell marks can also 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. Scientific evidence points out that temperature, humidity, and wind conditions can all strengthen or weaken the potency of a scent. Further scents have no independent identity, but rather must be associated with other memories to enable recall.

Taste marks are marks that are to be treated similar to smell marks. One of the important case in this regard is that of Eli Lilly's case where a company tried to register artificial strawberry flavour as a gustatory trademark for pharmaceutical products. In that case, the Court implicitly recognized that taste marks could be registered as trademarks. But the particular trademark application was rejected as it was found that most pharmaceutical companies added artificial flavours to their medicines to disguise the unpleasant taste. The other important issue was that most customers would not recognise the strawberry taste as a trademark for a product but only regard it as a method of disguising the unpleasant taste of the medicine. One substantial impediment to enforcement of flavour marks is functionality because they need to be available to all competitors. However, it can be safely assumed that graphical representation for taste marks will be required to meet the standards set for sound and smell marks, in which case it might be difficult to get recognition for taste marks in most cases.

Similar is the case with sound marks. The ECJ in the Shield Mark case^{xxi} dealt with the registration of sound marks. The court held that sound marks were registrable but the requirement of graphical representation along with distinctiveness of sound had to be met with. It was also stated that written description of a sound, onomatopoeia and musical notes were not enough. The problem with written sound marks like notations is that while it might include pitch, it will not include the tone. The TRIPS Agreement, EC directive and Community Trademark (CTM) are all silent on sound marks. The International Trademark Association (INTA) Resolution of 1997 on the inclusion of sound marks as registrable marks has analysed various impediments to the registration of sounds as trademarks, such as, enforceability, functionality of such sounds, problems of graphical representation and physical affixation which they say can be solved with the help of traditional trademark principles.

When it comes to recognition of combination of colours, it is unproblematic as it has been explicitly accepted by legislations and cases a distinctive by itself. The issue remains singularly focused on cases involving use of a single colour as a trademark. The ECJ discussed this issue in the Libertel case^{xxii}. The court's main emphasis was on the issue of graphical representation of the colour marks. The Court recognized existence of an internationally recognized colour identification code like the Pantone Code which is a commercial system that designates specific shades numerically and categorizes over thousands of shades by unique codes.

Although the European Community Trademark harmonization directive (EEC directive) and the amended state laws already took into consideration the new trademark forms such as

sounds, signs and smells the major problem is the requirement of ‘graphical representation’ of the mark, which can be found in each of those statutes.^{xxiii} Thus the most important requirements that need to be fulfilled in order to register a trademark are the capability of being represented graphically and the fact that a sign shall not be registered if it “consists exclusively of the shape which results from the nature of the goods themselves”. The latter condition concerns, products such as perfumes, where the smell cannot be registered as trademark, because of the perfume’s fragrance results from the nature of the good itself.

The importance of requirement of graphical representation has in fact practical reasons. The only way a trademark can be recorded in the register office is by means of a piece of paper that is visible and can be read by everybody. Therefore, the sign must be expressed by writing, drawing or by a graph- that is, by a diagram representing a mathematical or chemical relationship. The representation must be clear and precise and also intelligible to those who consult the register. This consultation right include of course every manufacturer who may seek to register a similar sign but also every consumer and the general public. The object of representation is specifically to avoid any element of subjectivity in the process of identifying and perceiving the sign. The means of graphic representation must be unequivocal and objective.^{xxiv}

In the light of all these, it can be said that while it is possible to include a lot of non-conventional trademarks within the definition, the requirement of graphical representability seems to be an impediment. The American Supreme Court has taken an ‘anything goes’ approach while dealing with the non-conventional trademarks. While in Europe, the Sieckmann approach has ensured that the courts adopt a stringent test for the graphical representation of a trademark. But in India, even the case laws are mostly silent in this regard except in the matter of shapes and hence a lot depends on the interpretation of the Rules and the prescribed forms.

With the growth of development in technology, there is seen a deviation from the conventional trademarks, and non-conventional trademarks are getting accepted worldwide. But the international standards determining the registrability of signs as marks vary from country to country. However, the questions of distinctiveness and graphical representation are understood in more or less same degree in different jurisdictions. In the present era of international trade, harmonisation of the trademark application and examination procedure of non-conventional trademark and development of common approaches are the need of the hour.

The concept of non-conventional trademarks is recognised in most of the countries, but no proper legislative provisions are there to safeguard them. Some countries have adopted changes to their national legislations to include non-conventional trademarks. Still, the legal regime in case of non-conventional trademark is in a developing stage. The absence of legislative provisions makes the court to apply their discretion while deciding cases. The new marketing and advertising strategies and changing consumer perceptions have led to the evolution of new types of trademarks in the market. But, the difficulty in representing these marks graphically and the possible chances of overlapping with other intellectual property rights like copyright often creates hurdles in protecting the non-conventional trademarks.

ENDNOTES

ⁱ Adam L Brookman, *Trademark Law: Protection, Enforcement and Licensing*, 7 (2nd ed., 2017).

ⁱⁱ Section 2 (1) (zb) of Trademarks Act, 1999.

ⁱⁱⁱ 3 HOSSEIN BIDGOLI, *THE INTERNET ENCYCLOPEDIA* 449 (2004).

^{iv} Neeti Suri, *Single Colour Mark: It's Registrability in the United States and the United Kingdom*, http://www.legalserviceindia.com/articles/collour_marks.htm (last updated July 4, 2022.).

^v *Smell, Sound and Taste: Getting a sense of Non-Traditional Marks*, *WIPO MAGAZINE* (Feb 2009) http://www.wipo.int/wipo_magazine/en/2009/01/article_0003.html.

^{vi} KERLY, *LAW OF TRADEMARKS AND TRADE NAMES* (2007).

^{vii} SCT Report, 16th session, Geneva, November 13 to 17, 2006, para 3.

^{viii} TOBIAS COHEN JEHOAM, CONSTANT VAN NISPEN AND TONY HUYDECOPER, *EUROPEAN TRADEMARK LAW: COMMUNITY TRADEMARK LAW AND HARMONIZED NATIONAL TRADEMARK LAW* (2010).

^{ix} SCT Report, 16th Session, Geneva, 16/2, November 13 to 17, 2006, para 32.

^x SCT Report, 20th Session, Geneva, 20/2, December 1 to 5, 2008. Area of Convergence No. 5, para 5.01.

^{xi} *Steff v. OHIM*, ECLI:EU:T:2014:6.

^{xii} *Think Schuhwerk v. OHIM*, ECLI: EU:C:2014:2222.

^{xiii} SCT Report, 17th Session, Geneva, May 7 to 11, 2007, para 27.

^{xiv} II P. S. Menell, *Intellectual Property: General Theories* in B. BOUCKAERT AND G DE GEEST, *ENCYCLOPEDIA OF LAW AND ECONOMICS* 156-163 (2000).

^{xv} *In re Morganroth*, 208 U.S.P.Q. 284 (T.T.A.B. 1980).

^{xvi} United States Patent and Trademark Office, *Trademark Manual of Examining Procedure*, Refusals on Basis of Ornamentation Section 1202.03.

^{xvii} Thomas R Lee, *Trademarks, Consumer Psychology, and the Sophisticated Consumer*, http://works.bepress.com/cgi/viewcontent.cgi?article=1000&context=thomas_lee (last updated July 4, 2022).

^{xviii} [2002] ECR I-11737.

^{xix} [2001] RPC 28.

^{xx} USPQ 2d 1238 (1990) (TTAB).

^{xxi} *Shield Mark BV v. Joost Kist Memex*, Case No. C- 283/01.

^{xxii} Case No. C-104/01.

^{xxiii} *Infra* Chapter IV.

^{xxiv} Paul Leo Carl Torremans, *Trademark Law: Is Europe moving towards an unduly wide approach for anyone to follow the example?* 10 *JOURNAL OF INTELLECTUAL PROPERTY RIGHTS* 127-132 (2005).