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An Analysis of New Developments in Unconventional Trademarks

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ABSTRACT

In today's developed new technology day-to-day life, product advertising has also changed. Creating a product depends on the customer's view of recognizing its mark. A number of techniques play a role in capturing the attention of the customer in product shapes, smell, sound, tastes, and textures. A non-conventional trademark helps to create recognition for a product or a brand. The study is about the various forms of non-conventional trademarks and their protection at the Indian, EU and international levels. The origin and historical view of non-conventional trademarks begin with the circulation of goods. Roman blacksmiths were the first to use identification marks on their swords. In order to distinguish the goods and services and to attract customers from other products by visible and non-visible signs, they are the design, logos, color combinations, words, motion, hologram, texture, 3D, taste, sound, and scent. The Trade and Merchandise Act, 1958, was the earliest law relating to trademarks in India and was replaced by the Trade and Mergers Act, 1999. The TRIPS Agreement helps to connect members of the World Trade Organization. It's very difficult to obtain registration for non-conventional trademarks, which vary from country to country depending on national legislation. Provided by the TRIPS Agreement through international treaties such as the Paris Convention, Madrid System, Trademark Law Treaty, Singapore Law Treaty, etc. In Indian legislation, non-conventional trademarks have no explicit provision. The basic prerequisites under Section 15 of the TRIPS are distinctiveness, visual perception, or graphical representation, giving valid guidelines for registration. According to EU legislation, legal protection can only be obtained through registration. CTM (community trademark) played a role in uniform registration in the European Union.

Keywords: History, registration, protection.

I. INTRODUCTION

A trademark is one of the intellectual property laws that protects commercial creative work that helps to distinguish goods, businesses, or services. According to the Trademark Act of 1999, "trademark" 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 the

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shape of goods, their packaging, and a combination of f color. In simple terms, any marks that do not fall under the category of conventional trademarks or traditional trademarks are called non-conventional trademarks or non-traditional trademarks. Non-conventional trademarks are irregular in nature, and even though all the conditions of a trademark are fulfilled, it's difficult to register. Classified as visible and non-visible signs, for example, colors, shapes, moving images, and holograms are visible signs, while sounds, scents, tastes, and textures are non-visible signs. ICICI Bank is India's first non-conventional trademark registration for its sound mark. In 2017, trademark rules accepted sound as a trademark, along with the Trademark Act of 1999. It is considered a trademark in India if the status of the mark can be represented graphically and in a distinctive category. An unconventional trademark is still in its developing stage and requires many codified laws to identify it.

II. ORIGIN

In ancient Greece and Rome, “potters marks” were used by potters to find the maker of the vases. During the 10th century, the “merchants mark” appeared to prove ownership rights to missed goods due to shipwrecks and other disasters. The “production marks” used by the merchants to affix inferior-quality goods to distinguish their goods The guild's standards are to be maintained for the customers' trust in order to provide action to be taken against the manufacturers who spoil the interior quality goods.

The Parliament of England was the first trademark legislation in 1226 to use distinctive marks for their bread. In 1857, the Goods Mark Act and the Merchandise Marks Act were passed by France and Britain, respectively. In 1870, a federal trademark regime was established by the US Congress. In the 1875 Act, a trademark was defined as “a device, mark, or name of an individual or firm printed in some particular and distinctive manner; or a written signature or copy of a written signature of an individual or firm; or a distinctive label or ticket” Any mark, device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging, or any combination of all of these are used as trademarks in the current legal sense. (TRIPS) The Trade Related Aspects of Intellectual Property Rights define a trademark as “any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings”.

(A) Historical overview

The most striking branding strategy of the 21st century is non-conventional trademarks. Paradigm shifts in branding strategies were brought about by digital and social media. The technological revolution persuaded many companies, with the help of color, sound, smell, scent

of raspberries, touch, and so on, to experiment with “extreme branding”. To signify brand origin, shape, color, stitch pattern design, and sound for more than a decade, many companies have developed legal protection and registration.

In 1915, the Coca-Cola Contour Bottle was designed and registered in 1960. Coca-Cola's bottle shape and packaging make it the most recognizable brand in the world for its unique iconic status. In 1830, the color trademark was first introduced in ‘tiffany blue’ packages, special blue boxes for its jewelry in the shade of light blue. Visual contrast has been dyed pink by Owens Corning Corporation's insulation since 1956. The company became more associated with its pink insulation product, and the word pink got registered. Although US law recognized single color combinations, they were registrable as trademarks in the 1980s. The accurate stitching pattern design was used uniformly by Levi Strauss & Co. in 1873. Metro-Goldwyn-Mayer Corporation (MGM) has used the lion's roar as a sound mark since 1924; the sound trademark was registered in 1985. Every three seconds, somewhere in the world, Intel Sound is used. Since 1994, its sound mark has been registered as an audio signature and is registered worldwide in many countries

The definition of a trademark clearly includes shapes, colors, packaging, etc. In spite of that, during registering trademarks like smell, sound, shapes, color, etc. Interpretation of Sections 2(1)(zb) and 2(1)(m) of the Trademarks Act read together: Section 2(1)(m) A mark includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging, or combination of colors, or any combination thereof. The three phases should be noted in Section 2(1)(m): definition, shape of goods, packaging, and combination of colors are the non-conventional trademarks. Section 2(1)(zb) of the Trade Marks Act, 1999 states that two conditions have to be satisfied before it becomes a trademark, i.e., distinctiveness (distinguishing goods and services) and graphical representation.

III. REGISTRATION

Non-conventional trademark registration is more difficult than for conventional trademarks. This non-conventional trademark registration has been legally protected by EU legislation. Registration of non-conventional trademarks requires a certain set of procedural examination and registrability criteria: distinctiveness, visual perception, or graphical representation. Community regulation and the Directive on trademarks (TM Directive) were triggered by the EU, giving the advantage of uniform protection by single registration. Simply implies that the condition for registration of a trademark harmonizes the national laws of the member states, but the final interpretation lies with the court. CTM came fully into force on April 1, 1996.

Registration involves OHIM (Office of Harmonization in the Internal Market) filling out a single application. Article 4 of the CTM Regulation defines three parts, namely, a mark must be:

(i) A sign: A sign is the first requirement of a registered trademark. Article 4 of the CTM Regulation and Article 2 of the TM explain signs as words, letters, and shapes of goods. As stated by the CJEU, it is “to prevent the abuse of trade mark law by obtaining an unfair competitive advantage”. ECJ stated signs as “that it is listed non-exhaustive and not limited to visual perceptible matters”, the word non-perceptible signs as colors, taste, and sounds. Article 15(1) of the TRIPS Agreement provides that “Members may require, as a condition of registration, that signs be visually perceptible.”

(ii) Capable of being represented graphically: The second requirement after signs for registration is to be represented graphically. It is more difficult to register non-conventional trademarks like smells, colors, and tastes. According to Sieckman criteria, “for a sign to be registrable as a trademark, the graphic representation must be clear, precise, self-contained, easily accessible, intelligible, durable, and objective”. In community legislation and in the EU, the registration of a trademark is refused due to inadequate graphical representation. Two-dimensional presentation is necessary for graphical representation by way of letters, written characters, or a picture. Two dimensions can be labeled as administrative necessities for precise identification for the OHIM trademark registry to make the process easier to record, search, and advertise trademarks.

In Indian legislation, the mark should be represented graphically under the following conditions:

- The sign can be precisely determined by the graphical representation.
- The mark or sign can be replaced by a graphical representation.
- It is practicable for a person to understand what the trademark stands for.
- Representing graphically means to use physical form in such a way to publish in the journal and to show the perfect reference point about the mark.

Unless the graphical representation is satisfied under the Indian trademark law, it is not considered a trademark. "Trade mark" is defined, inter alia, to mean “a mark capable of being represented graphically.” Rule 2(1)(k) of the Trademark Rules, 2002 clarifies that “graphical representation means the representation of a trade mark for goods or services in paper form”. Article 15 of the TRIPS Agreement says conditions should be registered as visually perceptible.

Graphical representation is not mandatory under the TRIPS Agreement.

Example: In the smell marks, the fresh cut smell of grass in tennis balls isn't possible to represent in a drawing; representation by chemical formula would not suffice because very few people would have the requisite technical knowledge to interpret the odor of a substance from its formula, but also owing to the fact that the same substance would produce different smells at different temperatures, concentrations, etc. Finally, in the smell mark, firstly, it is difficult to represent graphically, and secondly, the odor may disappear or fade, even being volatile in nature. In relation to sound marks, graphical representation is done by musical notation or by a sonogram and frequency scale. A color mark should be filed with the relevant color code recognized by an international color identification system. In the hologram mark, various views involved in the 3-D picture are required to show all the material features of the mark by way of drawing or painting. And in movement marks, it should be represented by way of image depictions, a clear view of the moving images, how many images are involved, and should be in the order explaining the fact that it is a single movement image.

(iii) Distinguishing the goods: Article 2 of the Directive states, "Capable of distinguishing goods of one undertaking from those of other undertakings, requirements are the same for all categories of trademarks" Article 3(1)(b) of the Directive says that a trademark that is free from distinctiveness cannot be registered or, if registered, is invalid. It is clear to see that the third requirement is the most difficult to satisfy. After comparing the other non-conventional trademarks, make that one property unique to show the difference from other properties. Color marks are found to be much more difficult to distinguish from other products than sound and shape marks. In line with what the CJEU says about the mark being distinctive, "the mark must serve to identify the product in respect of which registration is applied as originating from a particular undertaking". The CJEU said the procedure for the distinctive character is that, firstly, when the registration is sought, the distinctiveness must be assessed by the goods or services. Secondly, customer perception, so therefore, to satisfy the customers, the identification of the product or service is used as a sign. When we see a mark, the first thing that comes to mind for the customer is the brand, but in the case of color, such a requirement is problematic when compared to words or symbols.

IV. PROTECTION OF TRADEMARK IN INDIA

Trademarks, once protected, offer protection against unauthorized use by third parties inside the country of registration. There are five types of trademark protection.

- **Service mark:** Service Mark is any word, name, symbol, device, or any combination thereof. It helps to distinguish one service provider from the other used in commerce to identify a service for the protection of goods. Service marks do not cover physical goods but only the provision of services. identification and protection of goods made available to potential users in connection with the business as banking, communication, education, financial insurance, shit funds, real estate, transport, storage material treatment, processing, supply of electrical or other energy, boarding, lodging, entertainment, amusement, construction,repairs, conveying of news, information, and advertising.
- **Collective mark:** means a “mark which is utilized for goods and services with the same characteristics that are to be traded by one or more persons acting jointly or as a legal entity for differentiation with other goods or services of the same kind.” A collective mark belongs to an association of persons, not a partnership firm, whereas a trademark refers to an individual. Useful to the people who produce agricultural goods like basmati rice, Alfonso mangoes, etc. Protection through registration is applicable to collective marks in a prescribed form and should also satisfy the graphical representation test.
- **Certificate Mark:** defined in the Trademarks Act, 1994, sec. 50, “as a mark indicating that the goods or services in connection with which it is used are certified by the proprietor of the mark in respect of origin, material, mode of manufacture of goods or performance of services, quality, accuracy, or other characteristics.” Certification marks used by the manufacturer or the service provider are eligible to certify, register, and protect the goods or services. Mark should be capable of distinguishing the goods or services with respect to their origin, material used, type of manufacturing of the goods, kind of performance of the services, quality, and accuracy. The proprietor of the mark certifies by examining that it possesses certain characteristics, and it should be capable of being represented graphically.
- **Trade dress** refers to the look or feel of a product or business as a combination of elements or images that it creates as a whole. Trade dress may include a few important features like packing, size, shape, color, color combination, texture, graphics, design, placement of words, and decorations on a product. Trade dress can be easily copied, so it is highly recommended for protection under the Lanham Act.
- **Well-Known Marks:** “A mark which has become well known to the substantial segment of the public familiar with a particular type of goods or services for which it is used”. Necessary measures should be taken by the registrar to protect a well-known trademark

against similar trademarks. Brands that have grown with India in every nook and cranny are Amul, and the 'Amul butter girl' is one of the recognized brands, and Amul was given the status of a well-known trademark. Other related brands like Pepsi, Coca-Cola, Benz, etc. Infringement case of the mark in the name of "IMUL" owned by the 'Ichhamati Co-operative Milk Producers Union Limited' that the impugned mark was similar to Amul brand, which would cause confusion among consumers. It is important to note that once the brand is recognized as a well-known mark, the mark is to be followed for all future proceedings.

V. PROTECTION OF TRADEMARK IN INTERNATIONAL DIMENSION

The Paris Convention, established in the year 1883, has the motive of creating interaction and recognition between different countries' national intellectual property rights. Among other intellectual property rights of registerable nature, the concept of priority was achieved in this convention. The priority period is six months in the case of trademarks; this has given a level of international protection for trademarks because the first to file a trademark application is in most countries. This is not the case in the UK, because without registration, passing off is sufficient to use the trademarks and rights, which acts as an obstacle to any subsequent application to register by a third party. International protection of 'well-known' trademarks is another relevant provision in the Paris Convention. Even if registered or unregistered, where the action of passing does not exist, the person can own a well-known mark.

(A) TRIPS Agreement:

Article 15(1) of the Agreement on Trade-Related Aspects of Intellectual Property Rights defines trademarks 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 reflects trademarks origin and distinctive functions. The criteria for trademark protection throughout the world is that a sign must be fulfilled and goods and services must be visually distinctive from other products in order to serve as trademarks. Practically all national trademark laws provide for the protection of visually perceptible signs, in particular the following types: words, including personal names; letters, numerals; figurative elements and devices; combinations of colors; pictorial devices, such as logotypes, paintings, figures, and drawings; and combinations of the above. Many national trademark systems use three-dimensional signs, product packaging, or product shape, for instance, as trademarks. On the basis of new marketing, advertising strategies, and the developing nature of consumer perceptions, new types of trademarks may evolve, like olfactory marks, multimedia marks, etc., provided that further conditions are

fulfilled, such as compliance with standards of morality or public order.

The scope of protection of trademarks of the TRIPS Agreement (Article 16) includes the power to oppose the user without consent in the course of similar or identical goods or services. In order to avoid confusion, an identical sign on goods or services needs to be within a category or class to justify protection. Article 16 supplements Paris Convention rules on "well-known" marks, essentially limiting the class of persons to whom a trademark or service mark must be well known in order to qualify for protection.

(B) Protection in the EU Dimension:

Trademark law within the EU has just been the beneficiary of a massive program of reform and innovation under the stimulation of the single market initiative. Trademark Protection: The varied system of member states under the Madrid Agreement results in ten members for the protection of trademarks within the community, varying from country to country. In order to do that, there was a defective legal regime, so they established the Working Party in 1964 for the protection of trademarks by analyzing the problems faced in the community. In 1980, a memorandum was formed by the commission, a committee of 17 experts, and interested parties to discuss the proposals. The Council of Ministers, after consultation with the European Parliament, receives the proposal from the experts. The proposal was twin-pronged in its attack, consisting of a directive to harmonize national laws and a regulation to create a European Community-wide trademark.

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