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Non-Conventional Trademarks: The Spectrum of Distinctiveness in the Era of Globalization

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ABSTRACT

The globalisation and commercialization of knowledge have significantly expanded the scope of trademarks. A non-traditional trademark necessitates visual identification and graphical representability, and it consists primarily of a name, word, phrase, logo, symbol, design, picture, or a combination of these features. The use of new types of marks to differentiate products and services from others has also produced a number of concerns about the registration, operation, uniqueness, and recognition of these marks as trademarks while breaking with traditional conventions. There is also the issue of the lack of a common standard for the protection of these non-conventional marks. This study investigates the concept, origin, growth, types and legal issues relating to non-conventional trademarks.

Keywords: *Trademark, Non- Conventional trademarks, Distinctiveness, Smell Marks, Sound Marks, Colour Marks.*

I. INTRODUCTION

We are living in a time of a great variety of goods and services, which can be accessed instantly. At that time, price and quality are not the only decisive criterion for consumers. Purchasing certain products or using certain services may give them also some non-material value, e.g., contribution to their social status or improving their self-esteem. It can be so only when those goods and services are distinctive in the market and a few seconds spent in front of the shelf or a storefront are enough to tell the public about their origination. That is why businesses dedicate a significant part of their time to developing unique source indicators being able to establish an instant link between them and the potential consumers.

The main source indicator used to single out a product or a service is a trademark. Usually, trademarks have been understood as words, figurative elements or combinations thereof,

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“which are capable of distinguishing the relevant goods or services” and signal the public about their origination. Since words or figures may be perceived only by sight, manufacturers` abilities to make their goods and services distinctive have been considerably limited. But technology does not stand still and frontiers of perceptible are being broadened rapidly. That is the reason of new types of signs emergence, which are capable to distinguish goods and services of a certain manufacturer or provider alongside words and devices. That new types of marks are called non-conventional trademarks since they have unique nature, which appeal to all five basic senses of a human: taste, touch, sight, hearing and smell. These marks have greatly favored businesses since now consumers may recognize their goods and services even without seeing them.

II. CONCEPT OF NON- CONVENTIONAL TRADEMARKS

The basic objective of a “Trade Mark (TM) is to allow consumers to recognize the origin of products or services” and thereby differentiate one undertaking's goods or services from those of other enterprises.³

“A trademark is a sort of industrial property that differs from other types of intellectual property in that it is used to distinguish between a firm and its services”. “A traditional trademark consists of a name, term, expression, logo, symbol, design picture, or a combination of these approaches”. There are numerous distinct “non-traditional trademarks” that have acquired significance in recent decades, including “sound marks, olfactory marks, colour markings, forms, and taste marks”.⁴

The registration of a trademark aids in building customer trust and avoiding uncertainty about the origin of things sold under a mark. In the majority of instances, customers rely on trademarks. It is difficult to inspect a commodity quickly and effectively in order to determine its pricing. “The strongest demand for non-traditional trademarks stems from market-savvy enterprises desire to create and sell their products in such a way that it appeals to the consumer’s aesthetic sense”. Despite the fact that a non-traditional mark has the same right to protection as a conventional mark.⁵

Non-Conventional Trademarks are those marks which do not fall under the category of Traditional Trademarks, for example: label, ticket, name etc. Non-Traditional Trademarks can

³Cornish, W and Llewelyn, D and Aplin, T *Intellectual Property, Patents, Copyrights, Trademarks and Allied Rights*

655 (7th edn, Sweet & Maxwell, 2010).

⁴Kerly D M, *Law of Trade Names and Trademarks* 12 (Sweet and Maxwell, London, 2005).

⁵Roth Melissa, *Something old, something new, something borrowed, something blue: A new tradition in non-traditional mark registrations*, *Cardozo Law Review*, 27 (2005) 457.

be in the form of a sound, odour, shape, test, or texture. “Any sign, or combination of marks, capable of identifying one’s products or services from those of other enterprises”, should be capable of creating a trademark. “Such signs, in particular words, letters, numbers, figurative components, and colour combinations, as well as any combination of such signs, are eligible for registration as trademarks”.⁶ Certain kinds of non-conventional Trademarks are now recognised in India as well as at the worldwide level as a result of various International Treaties.⁷

“Non-conventional or Non-Traditional trademarks are basically marks that are not included in the traditional set of marks and hence include touch, smell, colour, shape, texture, sound, taste etc”.

III. ORIGIN OF NON-CONVENTIONAL TRADEMARKS

“The sustainability of any trademark is dependent on its ability to make an impression on the minds of potential purchasers of those goods”. If a “product's or its representation's feature” is exceptional and one-of-a-kind, it will catch people's attention and stimulate their interest. As a result, manufacturers have started to use a variety of unique trademarks. Furthermore, the growth of the “Internet and e-commerce has broadened the range of signs that organisations may choose to utilise as registered trademarks”. “For example, motion and sound markings would capture the attention of Internet users far more effectively than traditional marks”, which have gained significance in the current corporate sector.⁸

IV. GROWTH OF NON-CONVENTIONAL TRADEMARKS

The effectiveness of any trademark is determined by its capacity to make an “impression on the minds of potential” purchasers of those goods. If a product's characterisation or presentation is distinctive, it will significantly appeal to people's perceptions and “senses”. This has resulted in the introduction of a variety of strange non-traditional “trademarks by manufacturers”. Furthermore, the introduction of the “Internet and electronic commerce has broadened the range of indications that firms would like to utilise as registered trademarks”. Motion and sound markings, for example, would catch “the attention of Internet users considerably more effectively than traditional marks”, which has accelerated their popularity in today's commercial sector.

⁶ ‘Protectable Subject Matter’, Article 15 (1) of TRIPS Agreement (1995).

⁷Madrid Treaty, Paris Treaty, Australian Treaty of WIPO.

⁸Beyond Tradition: New ways of making a mark, (January 05, 2022, 4:00 PM), https://www.wipo.int/edocs/pubdocs/en/wipo_pub_900_1.pdf

V. LEGAL ISSUES RELATING TO NON-CONVENTIONAL TRADEMARKS

A trademark is a distinguishing symbol, design, or expression that distinguishes one product or service from another. “Section 2(1) (zb) of the Trade Marks Act of 1999 defines a trademark”⁹. It refers to a product's portrayal or characterization that must be distinctive in order to “appeal to the general public's perception and senses in a significant way”.

The law recognises the function of symbols in trademark protection. Whatever method is used, the goal is the same to express the attractiveness of the product on which the brand appears in the eyes of potential buyers through the trademark.

Trademarks have traditionally been “used to identify the origination of a product”. Aside from “trademarks such as generic logos, devices, or symbols, there is another type of trademark called as non-conventional trademarks”. “Smell Mark, Sound Mark, Taste Mark, Touch Mark, and Color Mark” are the most common types. “To be irreplaceable, one must constantly be unique and distinct”.

The Trade Marks Act of 1999 includes a broad definition of a trademark, “therefore non-conventional trademarks might very well fall under the purview of a trademark provided they meet both the requirements of uniqueness and graphical representability”. “A trademark should have the ability to be unique; it should reveal the source and thus differentiate the goods or services from others”. The notion of a “non-conventional trademark must have the translational capability” to separate one person’s goods and services from another.

VI. TYPES OF NON-CONVENTIONAL TRADEMARKS

(i) **Colour mark:** Colour is something that can be “seen everywhere”, hence the individuality of “colour is an unanswered question”. “The colour trademark is recognised for colour combinations, but registration of a single colour mark remains a grey area since it lacks the inherent capacity to be unique and may cause consumer confusion because there are many shades of a single colour”.¹⁰ “Another issue with the registration of a single colour is that if

⁹Section 2(1)(zb) “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; and—

(i) in relation to Chapter XII (other than section 107), a registered trade mark or a 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

(ii) 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;”

¹⁰M M S Kharki, Non-Traditional Areas of Intellectual Property Protection: Colour, Sound, Taste, Smell, Shape,

trademark registration is authorised for a single colour, it will pose complications for the other front runners, resulting in no one utilising the colour because the number of colours is relatively restricted”. Cadbury's royal purple colour, Barbie's protected shade of pink, and 3M's Canary yellow are “some of the most well-known colour trademarks in the world today”.¹¹

(ii) Smell mark or Olfactory mark: Smell is one of the strongest senses in humans, capable of readily recalling earlier experiences. Though many nations have allowed the registration and protection of product smells as trademarks, the procedure remains tough “owing to its inability to be visually depicted and the momentous job necessary to demonstrate its distinctiveness from the product”.¹² The odour has been illustrated in many situations by putting down the chemical formula of the drug. However, there are firms who have successfully completed all of the requisite examinations and have registered odour as their trademark. For example, a UK tyre company's perfume of flowers and a London-based company's odour of beer in dart flights are both well-known instances of smell trademarks.¹³

(iii) Sound mark: A sound mark, often known as an auditory mark, “can be anything that is audible in nature”. “When compared to other non-conventional trademarks, sound marks are the most registered and protected, and they are gaining popularity in many nations, particularly the United States”.¹⁴ The goal of a sound mark is to assist customers in uniquely identifying a certain product in the commercial market without generating much confusion. Sound markings, unlike other non-conventional trademarks, can be graphically expressed using a sequence of musical notes with or without the use of words. In this regard, some of the oldest and most well-known registered trademarks are the Harley-Davidson sound, Nokia melody, Tarzan Yell, and so on.¹⁵

VII. CHALLENGES OF NON-CONVENTIONAL TRADEMARKS

Generally, “trademark protection is only granted to marks that can be graphically depicted; nevertheless, non-conventional trademarks are registered and protected owing to their capacity to generate a certain level of identification in the minds of the consumers”.¹⁶ The TRIPS agreement governs trademark registration and protection. According to the agreement, “a

Slogan and Trade Dress, 10 Journal of Intellectual Property Rights 499 (2005).

¹¹*Id.*

¹²Smell, Sound and Taste-Getting a Sense of Non-Traditional Marks, WIPO, (January 05, 2022, 5:00 PM), http://www.wipo.int/wipo_magazine/en/2009/01/article_0003.html

¹³*Id.*

¹⁴Dr. Mohan Dewan, Registering Shapes in India: Guidelines and Processes, Lexology, (January 12, 2022, 10:10 AM), <https://www.lexology.com/library/detail.aspx?g=94e581ac-5333-4a72-8dfc-111d746af82d>

¹⁵HarshadaWadkar, Non-Conventional Marks, Lexology, (January 12, 2022, 10:20 AM), <https://www.lexology.com/library/detail.aspx?g=4339efff-eba0-4339-a5f9-47f2d72ae7d1>

¹⁶David Vaver, Unconventional and Well-Known Trade Marks, Singapore Journal of Legal Studies 1 (2005).

trademark should be able to fulfil its essential tasks, but it is not required for a trademark to be tangible, physically detectable, or graphically representable”.¹⁷ As a result, the registration of non-traditional trademarks, particularly sounds, has become quite prevalent in the United States and the European Union.

According to the Indian Trademarks Act, 1999, trademark registration is only feasible if the product can be distinguished from others and can be visually represented.¹⁸ Non-conventional trademarks, despite performing the basic purpose of a trademark, have proven to be a challenging procedure in the nation, owing to the uniqueness requirement and the inability to be graphically depicted. There is also the possibility that these marks will cause consumer confusion, negating the purpose of trademarks.¹⁹

Non-conventional trademarks, on the other hand, are still a growing notion in India, and “there has been much conflict and discussion about whether it may be deemed a trademark in the lack of its capacity to be graphically depicted”.

VIII. CONCLUSION

Under the purview of trademark, protection can be conferred over any sort of non-conventional mark as long as it is capable of serving as a trademark. In that case, the sign must be distinct enough to distinguish one proprietor's products or services from those of other possible competitors in the market in order to be utilised as a trademark. Furthermore, the free mark should comprise any functional element or purely design aspects, including aesthetic or decorative elements. Moreover, the mark should be displayed in a plain and precise manner, including every distinguishing element of that mark in full.

Though there are various issues before giving protection to non-conventional marks, particularly non-visible signs, such complaints are not new and have been present since the notion of non-conventional marks was introduced. The need for the protection of these non-conventional marks, given their economic significance, as well as the need to broaden the scope of trademarks and promote new types of mark, outweighs such issues.

¹⁷Faye M. Hammersley, *The Smell of Success: Trade Dress Protection for Scent Marks*, 2 *Intellectual Property Law Review* 105 (1998).

¹⁸Section 2, *Trade Marks Act, 1999*.

¹⁹Arka Majumdar, Subhojit Sadha & Sunandan Mujumdar, *The Requirement of Graphical Representation for Non-Conventional Trademarks*, 11 *Journal of Intellectual Property Rights* (2006).