

NON-TRADITIONAL TRADEMARKS: A CRITIQUE

*Lisa P. Lukose**

Abstract

In the globalized era where cross border trade takes place in international market, trademark has become a key tool to denote a company's identity. A good trademark carries its own image, attaches distinct personality to the goods and becomes the essence of competition. The modern trademark law reflects some novel developments as to the *make* and *appearance* of 'mark' itself. The 'modern market' is in the busy process of inventing new products with 'typical odour' 'special touch' and 'unique sound' in order to present more 'sensory' consumer goods to the 'modern customers'. Although these novel trademarks have not yet reached a high acceptance in all jurisdictions, use of such marks is common in contemporary market. In modern times, new forms of sensory trademarks have come to be globally accepted as intellectual property as the result of certain legislative amendments or judicial interpretations. In the modern market, non-traditional trademarks still remain a developing practice and the case-law on this subject matter is evolving. However, studies show that there is an increasing demand from the proprietors for the registration of non-traditional marks in the international trade. On the contrary, there is no uniform standard across the globe in examination, registration and enforcement of these marks. Against this backdrop, this paper captures the brief history of non-traditional trademarks, the rationale of its protection under the legal regimes, through various case studies, prevalent in United States (US), European Union (EU) and India for its registration and enforcement. It also examines how these modern marks discharge their functions as a trademark. The paper also analyses the issues arising from the lack of uniform practice in the examination and registration of non-traditional trademarks worldwide. It concludes with suggestions for harmonization of examination and registration process across various registries.

I Introduction

THE HISTORY of trademarks is as old as the history of mankind. It began with the beginning of the circulation of goods. The Roman blacksmiths are believed to be the first users of identification marks on their swords. In ancient Greek and Rome, potters used 'potters marks' to identify the maker of the vases. The 'merchants mark' appeared in the 10th century particularly to prove ownership rights of missed goods due to shipwrecks and other disasters. The craftsmen and merchants used to affix 'production marks' in guilds to distinguish their goods from inferior quality goods.

* Associate Professor, University School of Law and Legal Studies, GGS Indraprastha University, New Delhi.

This helped them to maintain trust in the guilds and to take action against the manufacturers of inferior quality goods for not meeting the guild's standards. The Parliament of England owes the credit to pass the first trademark legislation in 1266 requiring bakers to use a distinctive mark for their bread. France passed Manufacture and Goods Mark Act in 1857 and Britain passed Merchandise Marks Act in 1862. The US Congress established a federal trademark regime in 1870. Trade Marks Registration Act, 1875 permitted formal registration of trade marks at the UK Patent Office. 1875 Act defined trade mark as "a device, or 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." With the passage of time different methods of identification and distinction developed.¹ In modern legal sense, any mark, device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or any combination thereof can now be used as a trademark.² The Trade Related Aspects of Intellectual Property Rights (TRIPS) Agreement³ 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.

II Historical overview

The conventional and traditional trademarks such as plain words, devices, logos and designs have been used since long for distinguishing goods. Over time, other elements besides words, logos, colour combinations and graphic designs have come to serve as identifiers of the source of goods/services, thus serving the function of trademarks. These new marks go beyond the traditional trademarks in nature, characteristics, scope and economic potentials. The digital and social media revolution brought paradigm shift in the branding strategies. Non-traditional trademarks are the most striking branding strategy of the 21st century.⁴ The technological revaluation persuaded many companies to experiment with 'extreme branding' with the aid of colour;⁵ sound;⁶ smell;⁷ scent of raspberries;⁸ touch⁹ and so on.

1 Lionel Bentley, Jennifer Davis, *et.al.* (eds.), *Trademarks and Brands: An Interdisciplinary Critique* (Cambridge University Press, UK, 2008)

2 The Indian Trademark Act, 1999, s. 2(m).

3 The Agreement on the Trade Related Aspects of Intellectual Property Rights, 1994, art. 15.

4 Lindstorm Martin, *Brand Sense: Build Powerful Brands through Touch, Taste, Smell, Sight and Sound* (Kogan Page Publisher, 2005).

5 For *e.g.*, pink colour for fiber insulations of Owens Corning.

6 *Dhin chik dhin chik* tune of ICICI is an example.

7 For *e.g.*, floral scent of thread as found in *In Re Celia Clarke*, USPQ 2d 1238 (1990) (TTAB).

Shape, colour, 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. For instance, the coca-cola contour bottle, which was originally designed in 1915, received trademark registration only in 1960. Coco-cola's bottle shape of packaging has achieved iconic status and in itself it is the single most recognizable brand in the world.¹⁰ Colour trademarks were in existence since 1830s. Tiffany maintains a colour trademark on its distinctive 'tiffany blue' packages - special blue boxes for its jewelry. Tiffany blue is a shade of light blue created by the company for its own products from 1845.¹¹

Another example is pink colour trademark. From 1956, Owens Corning Corporation's¹² insulation has been dyed pink to provide visual contrast. Due to this, the company became so associated with its pink insulation product that it registered the word mark PINK for its insulation. Although colour combinations, had long been protectable as trademark, it was only in 1980s that the US law recognized a single colour as a trademark when Owens-Corning launched the *Think Pink* campaign for its fibreglass building insulation. Eventually through judicial settlement¹³ in 1985, pink colour was held to be protectable as a trademark and the US court ruled that the company had the right to prevent others from using 'pink colour' for insulation.¹⁴

History also reveals that even a stitching pattern can be a trademark. From 1873 Levi Strauss & Co. consistently applied the arcuate stitching pattern design or a protruding piece of fabric (protruding red tab) to jeans as trademarks.¹⁵ Since 1924 Metro-Goldwyn-Mayer Corporation (MGM) used lion's roar as sound mark to

8 *Myles Ltd.'s Application* (2003) ETMR 56.

9 Velvety surface of wine bottle of Diageo is an example.

10 B.M. Katherine, "Non-traditional Trademarks: Tips for the 21st Century" *Brands in the Boardroom* 37-39 (2011).

11 Tiffany's Blue Book published this colour long back in 1845 with PMS number 1837 signifying Tiffany's year of foundation. They spent more than one century to establish colour alone as a trademark. Tiffany blue reveals the story of creativity in selection of a non-traditional trademark and more than 100 years dedication in the promotion of the colour mark to develop into a famous brand icon. See, Michelle Gonzale, "So Let the Paint be Spread, We're Painting the Soles Red" 15 (1) *Wake Forest Journal of Business And Intellectual Property Law* 52 (2014).

12 Owens Corning Corporation is rated as the world's largest manufacturer of fiberglass and related products.

13 *Re Owens-Corning Fiberglas Corp*, 774 F.2d 1116 (Fed. Cir. 1985).

14 The cartoon character of the Pink Panther is being used by Owens Corning as a visual representation. According to the company, for years, it has used the colour pink and the Pink Panther as a way to distinguish its insulation products from other companies. Also see, Jerome Gilson and Anne Gilson LaLonde, "Cinnamon Buns, Marching Ducks And Cherry-Scented Racecar Exhaust: Protecting Nontraditional Trademarks" 95 (4) *TMR* 773-820 (2005.)

15 To promote the images of the arcuate stitching design and the red tab, the company ran regular advertising campaigns and it could establish consumer recognition in these marks.

announce the beginning of movie. It filed trademark application to register the sound mark in 1985.¹⁶ The NBC chimes got sound trademark registration way back in 1950. Intel uses its sound mark as an audio signature since 1994 and is registered in multiple countries worldwide and heard every three seconds somewhere in the world. Trademark rights in a non-traditional mark are being established through consumer recognition.

III Registrability of non-traditional trademarks

To be eligible for protection and registration, the trademark has to comply with certain statutory requirements. These requirements may vary from country to country depending on its national legislation. This flexibility is provided by the TRIPS Agreement itself though international treaties such as Paris Convention, Madrid System, Trademark Law Treaty, Singapore Law Treaty *etc.* try to achieve some degree of standardization and uniformity. It is generally difficult to obtain registration for non-traditional trademarks than for conventional trademarks.¹⁷ Many countries provide some form of protection to non-traditional trademarks. Some countries like India's legislation is silent or does not have explicit provision as to the registrability of non-traditional trademarks. However, in such situation the trademark registration manual of the concerned trademark registries provides the necessary guidelines as to the examination procedures and registrability criteria of non-traditional trademarks. Like conventional trademark, under article 15 of the TRIPS, non-traditional trademarks must meet the basic pre-requisites: distinctiveness, visual perception or graphical representation. It must consist of a distinctive sign that is capable of serving as a source identifier. It must not cause confusion in the mind of the public and must not deceive the public.¹⁸ These basic requirements can be applied differently based on local practices.¹⁹ A particular kind of non-traditional trademarks or a particular way of graphical representation, acceptable in one country may not suffice in another country.²⁰

16 USPTO registration no: 1395550.

17 See L. Kenneth Port, "On Nontraditional Trademarks" 38(1) *Northern Kentucky Law Review* 1-58 (2012).

18 V. A. Mohta, *Trademarks, Passing off and Franchising* (All India Reported Pvt. Ltd., Nagpur, 2004).

19 Lisa P. Lukose, "Unconventional Trademarks: Novel Trends in the Modern Trademark Law" 1(1) *CNU Law Journal* 22-33 (2010).

20 For *e.g.*, a particular colour registrable in one jurisdiction may not be registrable in other being a culturally or religiously relevant colour. Also see, Neha Mishra, "Registration of Non-Traditional Trademarks" 13(1) *Journal of Intellectual Property Rights* 43 -50 (2008).

IV Special characteristics

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. However, these trademarks are comparatively difficult to be registered due to statutory omissions and lack of uniform practice. As discussed above trademark laws of several jurisdictions encompass non-traditional trademarks as eligible subject matter of protection by not excluding them from the definition of trademark. They encompass a full spectrum of sensory perception beyond commonplace visual signs. These are marks based on appearance, shape, sound, smell, taste and texture. Undoubtedly, they are innovative creations. They may either be visible signs such as colour, shapes, moving images, holograms or non-visible signs such as sounds, scents, tastes and textures. Non-traditional trademarks are inventive ways to communicate with consumers the source of origin of goods/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 higher degree of commercial impression with its unique smell or touch. Factors to determine whether these signs could be registered include: the commercial impression of the mark, the relevant practices in the trade – whether the sign is unique in the particular field or is only a refinement of a common feature and whether there are any secondary uses of the sign. A mark that did not inherently function as a mark because of its nature, evidence of acquired distinctiveness would be required. To be registrable these marks should not be functional, for example, functional scents if inherent in the product itself, such as smell for perfume, are not accepted for registration in many jurisdictions. According to the ‘test of functionality’, even if a sign was used and could possibly serve as a mark, it might not be capable of distinguishing as a public policy matter, if it was essential to the use or purpose of the product or if it affected its cost or quality.²¹

V Rationale for protection

The TRIPS Agreement specifically recognizes the registration of shape of goods, their packaging, trade dress and combination of colours as trademarks. Even though marks such as smells, sounds, taste, touch, holograms *etc.* are not explicitly mentioned in the definition clause, a plain reading of the section suggests that since the agreement provides an inclusive definition, it is wide enough to include these unconventional marks within its ambit. All jurisdictions provide inclusive definition of trademark

21 “Non Traditional Trademarks”, *available at*: <http://www.inta.org/TrademarkBasics/FactSheets/Pages/NontraditionalTrademarksFactSheet.aspx>. (last visited on Feb. 24, 2015).

and as such there is no statutory prohibition to protect non-traditional trademark provided other statutory requirements are complied with. Non-traditional trademark performs four essential functions: it (i) identifies the source or origin; (ii) links the mark, the product and the proprietor; (iii) guarantees quality and (iv) advertises the product.²² It has greater potential than that of conventional trademarks. They have most impact on consumers in the new environment of international trade. Since the primary function of trademark is to identify the product, the recognition of non-traditional trademarks is important especially where people in low literacy areas, are unable to recognize conventional marks and usually identify goods by their shapes, colour, touch or smell. They have become significantly important for a section of society like the visually impaired and the illiterate wherein people are unable to recognize the conventional trademarks.

The recognition of unconventional 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 recognised and granted registration for several unconventional trademarks. Like conventional trademarks, to an enterprise, unconventional trademarks' assets are of great commercial value and an important part of evolving business strategy and intellectual property portfolio.²³

VI Categories of non-traditional trademarks

There are non-traditional trademarks which relate to all five senses. They would contain any (i) visible signs such as colour, shapes, moving images, holograms *etc.* or (ii) any non-visible signs such as smell, sounds, taste or textures.²⁴ The Manual (Draft) of Trademarks Practice and Procedure of Indian Trademark Registry, 2015 states that colour, sound, shape of goods, packaging and smell trademarks fall under the category of unconventional trademarks.²⁵ The level of protection countries afford to these marks varies among jurisdictions. What is treated as a protectable mark in one country may not be

22 Kerly, *Law of Trademarks and Trade Names* (Sweet and Maxwell, South Asian edn., 2007).

23 See Graham Dutfield and Uma Suthersanes, *Global Intellectual Property Law* (Edward Elgar Publishing Ltd., 2008).

24 Harsimran Kalra, "Unconventional Trademarks: The Emergent Need for a Change" 4 *India Law Journal* (2007), available at: http://www.indialawjournal.com/volume_4/issue_1/article_by_harsimran.html (last visited on Feb. 25, 2015).

25 Sr. No. 3.2.4 of Draft Manual, 2015 at 143, available at: http://www.ipindia.nic.in/tmr_new/TMR_Manual/TMR_DraftManual_11March2015.pdf (last visited on May 28, 2015).

given protection in another country. From a global perspective, the following are the main categories of non-traditional trademarks that can be registered.

- i. Smell/scent/olfactory marks;
- ii. Sound/aural marks/audio signature;
- iii. Tactile/touch/textue/haptic marks;
- iv. Single colour marks;
- v. Shape marks/three dimensional/3D marks;
- vi. Taste/gustatory marks;
- vii. Holograms; and
- viii. Moving images/motion/animated marks.

Smell marks

Smell marks are also known as scent/olfactory marks. Scent is theoretically protectable as a trademark. Generally, smell marks are applied on cleaning preparations, cosmetics and fabric softeners. For the first time, recognition to the smell marks was given by the US courts²⁶ 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. Smell was compared to colours in this case, though this is scientifically unrecommended. The court differentiated between functional and non functional smells - smell not being an inherent attribute of products from those products which have it as its inherent attribute such as perfumes *etc.* In *John Lewis of Hungerford Ltd's Trade Mark Application*²⁷ the trademark was graphically represented by the description that 'the trade mark comprises of the smell, aroma or essence of cinnamon' in respect of furniture. The application was refused on the ground that the wording 'smell, aroma or essence of cinnamon' lacked precision as a result of the degree of subjectivity it allowed in the determination of the question whether a fragrance exemplified 'the smell, aroma or essence of cinnamon' and the extent to which differing perceptions of different individuals could equally be regarded as bench marks for the interpretation of the wording in question. In *Venootschap Firma Senta Aromatic Marketing's Application*²⁸ a written description of "smell of fresh cut grass" was accepted for tennis balls.

²⁶ *In Re Celia Clarke*, USPQ 2d 1238 (1990) (TTAB).

²⁷ (2001) RPC 575.

²⁸ (1999) E.T.M.R 429 OHIM BoA R 156/1998/2.

“The scent of raspberries” was accepted in *Myles Ltd.’s Application*²⁹ in respect of fuel and diesels. In Britain, the Sumitomo Rubber Company successfully registered “a floral fragrance/smell reminiscent of roses” as applied to tyres. The world’s leading manufacturer of darts, Unicorn Products, obtained a trademark for “the strong smell of bitter beer on the flight” of their darts. Smell mark can be afforded protection in India if the applicant proves that: (i) the smell is used as a trademark; (ii) it is not an inherent or natural characteristics of goods but is added by the applicant to identify its goods; (c) the public regard the smell as a mark which identifies the applicant’s goods and (d) the mark is represented graphically.

There are certain practical issues with respect to smell marks’ registration. In *Sieckmann v. Deutsches Patent-und Markenamt*³⁰ the applicant had described the scent as “balsamically fruity with a slight hint of cinnamon”. The court initially observed that a trademark may consist of a sign which is not in itself capable of being perceived visually, provided that it can be represented graphically. Secondly, a graphical representation must be *clear, precise, self contained, easily accessible, intelligible, durable and objective*. The court ruled that in respect of an olfactory sign, the requirements of graphical representability are not satisfied by a chemical formula, by a description in written words. Chemical formula depicting the scent does not represent the odour of a substance, since it is not sufficiently intelligible, clear and precise. Moreover, a formula does not represent the odour, but the substance itself. A deposit of an odour sample does not constitute a graphic representation. Odour samples are not sufficiently stable and durable.

Smell gets affected by temperature, humidity and wind conditions. It can get strengthened or weakened. The perceptibility is yet another factor in the determination of smell and therefore, physical, mental abilities, individual’s sensitivity and health have a pivotal role. The problem may arise more so than with sound marks, in representing the mark graphically. Many products have added fragrance, as in the case of perfumes, cosmetics, fabric conditioners, detergents *etc.*, to make the product more aromatic or pungent. Potential purchasers are unlikely to consider these scents as an indication of the origin of goods. Hence it is uneasy to prove that a particular smell indicates the goods of a particular trader. The courts have held that a smell mark does not satisfy the requirements of graphical representation if it is merely presented in the form of a chemical formula, by a description in written words, or by the deposit of the odour sample or by a combination of those elements.

29 *Supra* note 8.

30 C-273/00, 2002 E.C.R. I-1173.

Sound marks

Sound trademarks are also referred to as aural marks/audio signature. The sound of the famous Tarzan yell;³¹ merrie melodies theme song;³² the spoken letters 'AT & T';³³ the sound 'ooh it's so good';³⁴ the melody 'sweet Georgia Brown'³⁵ are famous examples of sound marks registered in US. In India, if sound marks can be represented graphically they are not excluded from registration. Yahoo's yodel became the first sound mark to be granted by Indian Trade Marks Registry (2008) followed by ICICI's '*dbin chik dbin chik*' (2011). US, Austria, Denmark, France, Germany, Ireland, Italy, the Office for Harmonization in the Internal Market (OHIM), Spain, Sweden, UK, Norway, Switzerland, Germany recognize sound marks. The test is "whether other traders are likely, without improper motive, to wish to use the sound in the ordinary course of their business." The acceptability of a sound, like words or other types of trademarks, depends upon whether the sound is or has become a distinctive mark.

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. For instance, pieces of classical music may be acceptable as trademark, *prima facie*. However, the examiners have to see how more than a few bars of classical music can serve as a trademark. A mere sequence of musical notes does not make it possible to determine the pitch or the duration of the notes, which are essential parameters of the remedy sought to be represented, and hence fail to meet the requirements of clear representation. Whole or large sections of classical pieces are likely to be rejected on the ground that they are not likely to be treated as a trademark. The acceptability of a sound mark depends upon whether the sound is or has become a distinctive sign; that is whether the average consumer will perceive the sound as a trademark showing an exclusive association with a product. Similarly, a simple onomatopoeia cannot, by itself, satisfy the requirement of graphical representation. If the sound sign is represented graphically by a simple onomatopoeia, it is unclear whether the sign is the onomatopoeia itself, as pronounced, or the actual sound or noise of which the onomatopoeia is the phonetic imitation. Even where it is made clear that the sign is the onomatopoeia as pronounced, it is likely to lack the required clarity or precision not least because onomatopoeia may be perceived differently, depending on the individual. The World Intellectual Property Organisation (WIPO) Standing

31 Registration no: 2210506, a yell consisting of a series of approximately ten sounds.

32 Registration no: 2473248, the mark consists of thirty musical notes.

33 Registration no: 1761724, the mark consists of the spoken letters 'AT & T'.

34 Registration no: 200096.

35 Registration no: 1700895.

Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) suggests “offices may require that the representation of sound marks consist of a musical notation on a staff, a description of the sound constituting the mark, or an analog or digital recording of that sound – or of any combination thereof. Where electronic filing is available, an electronic file may be attached to the application. However, for some jurisdictions, only a musical notation on a staff may be considered to adequately represent the mark.”³⁶

Sound mark will qualify for acceptance only with evidence of factual distinctiveness. The examples are: very simple pieces of music consisting only of one or two notes; songs commonly used as chimes; well-known popular music in respect of entertainment services, park services *etc.*; children’s nursery rhymes (especially in respect of marks on goods/services aimed at children) and music strongly associated with particular regions or countries for the type of goods/services originating from or provided in that area. Where the mark consists of a non-distinctive sound but includes other distinctive elements, such as a word, it may be considered as whole for the purposes of registration. The registrar may require the applicant to provide such further information about any music tendered for registration as the examiner may need in order to determine whether the mark is distinctive or not. To be registrable, the proposed sound must be capable of graphical representation. Most sounds are capable of being represented graphically by visual notation, for example, musical notation. Sound marks can be represented by musical notation and/or description of the sound in words.³⁷ The title of the piece of music alone may not satisfy the requirement of graphical representation. The instrument on which the music is played needs to be included if it forms part of the mark or if the sound emanates from a musical instrument. Graphic/electronic measurement of the volume and character of the sound needs to be given in the representation. Where the sound is partially represented by visual notation, a clarifying description in words of the sound should be included in the application. Onomatopoeic words, sonograms or spectrograms may also be accepted as graphical representations. The sound made by goods during their use, and which arises purely as a function of that use, may not serve as a good sound mark. Sound mark also must be non-functional. The sound of a siren does not serve as a trademark for a siren. On the other hand, if the applicant can prove that the sound, although descriptive, has acquired ‘distinctiveness through use’, the application may be considered. For instance, a toilet flushing

36 Report of the Standing Committee, on the law of Trademarks, Industrial Designs and Geographical Indications, WIPO SCT/16/9 2007.

37 Martin Lindstorm, *Brand Sense: Build Powerful Brands through Touch, Taste, Smell, Sight and Sound* (Kogan Page Ltd., 2005).

sound for plumbing services, which has acquired distinctiveness through use, may be granted registration.³⁸

Tactile marks

Tactile marks are also known as touch/texture/haptic marks. A distinctive touch such as ‘velvety surface of a wine bottle’ or ‘feel of cotton’ is conceptually protectable as a trademark to indicate the source of its origin. Touch marks are also known as haptic marks owing its origin from Greek *haptēsthai*, meaning ‘pertaining to touch’. In 2006, the International Trademark Association adopted ‘a resolution supporting the recognition and registration of touch marks’. In 1996, Louis Vuitton Malletier sought US trademark protection for its ‘distinctive man-made textured pattern utilized as a surface feature’ on its luxury luggage and leather products. The Trade Marks Registry of the German Patent and Trade Mark Office in 2003 granted trademark on the basis of an application filed in the name of Underberg AG for several goods in classes 32 and 33. Kimberly-Clark has federal trademark registration for ‘the configuration of the container used to dispense’ facial tissue. United States Patent and Trademark Office (USPTO) also allowed Kimberly-Clark’s intent-to-use application for its raised, alternating dot pattern on paper towels. Touchdown marketing has a registered a trademark in the ‘pebble-grain texture’ and ‘soft-touch feel’ of its basketball-shaped cologne dispenser and Fresh Inc. has a registered mark on ‘cotton-textured paper’ that wraps its soap products. In 2006 American Wholesale Wine & Spirits, Inc. obtained trademark registration for a sensory, touch mark and used with its Khvanchkara wine. The registration’s description of the mark is that of a velvet textured covering on the surface of a bottle of wine.

Transforming touch into protectable sensory branding is not an easy task. Like other non-traditional trademarks, tactile mark should not be functional. A cell phone designed to get warmer in one’s pocket as it rings in order to gain the user’s attention or an artificially sticky steering wheel which enhances its performance may not be registrable. If the touch is ‘essential to the use and purpose of the article or which inherently affects its cost or quality’, then it will not warrant a legal protection. Tactile mark does not automatically function as a trademark upon its first use. Artificial textures are not automatically eligible for trademark protection. Rights over the tactile marks are generally claimed by the established use over a period of time. There is a dearth of recognized tactile marks and these are least common non-traditional trademarks. Hence, the legal authority is scarce.

38 Also see, Hui Huang, “Comparative Study of Law on Trademark Application and Opposition in China and other Countries”, available at: [http:// www.ipr2.org/storage/Huang-EN932.doc](http://www.ipr2.org/storage/Huang-EN932.doc) (last visited on Feb. 18, 2015).

Colour marks

The definitions of mark and trademark refer only to a combination of colours. Hence, a combination of colours may *prima facie* be registrable. Combination of colours or even a single colour in combination with a word or device is statutorily registrable. Single colour is seldom used as the principal means of distinguishing the trade source of the goods or services. However, they are capable of being used as secondary trademark if the proprietor has used the mark distinctively to educate the public that it is a trade mark. Regard must also be paid to the general public interest of not unduly restricting the availability of colours for other traders. A single colour will only in exceptional circumstances be capable of denoting the origin of a product or service. A single colour may be registerable as a trade mark if it is very unusual and peculiar in a trade and is recognized by traders and consumers alike that it serves as a badge of origin for that class of goods as held in *Dyson Ltd's Trade Mark Application*.³⁹ As held in *Ty-Nant Spring Water Ltd.'s Trademark Application*,⁴⁰ colours *per se* without any unusual or fanciful features would be devoid of any distinctive character, since they are considered to be in the public domain and form part of the store of signs available to all traders. Evidence filed to support a claim of factual distinctiveness colour must be very strong and persuasive. It has to clearly demonstrate that the colour mark exclusively designates the applicant's goods or services to the relevant consumer. There is more likelihood of establishing factual distinctiveness where the goods or services are restricted and the relevant market is specific.

The US Supreme Court found in *Qualitex Co. v. Jacobson Products Co.*,⁴¹ a green-gold colour used on dry cleaning press pads registrable as a trademark where the colour had acquired distinctiveness. According to the court, it is the 'source-distinguishing ability' of a sign that permits it to serve as a trademark and not its ontological status as colour, shape, fragrance, word or sign. In this case, green was held to be 'secondary' colour, it was used in such a way that the brand was totally identified with the green-gold colour. There was no functional implication. However, even with acquired distinctiveness a colour may not succeed registration if the colour is required generally in the trade. In a 2012 judgment Christian Louboutin's red colour used on the soles of Louboutin shoes was granted protection for its red colour trademark.

39 2003 RPC 47.

40 (1999) ETMR 974.

41 514 U. S. 159 (1995).

42 Neha Mishra, *supra* note 20.

43 C-104/01[2003] E.C.R. I-379.

The registrability of colour mark depends on how the colours are presented and what they are applied to.⁴² In *Libertal*⁴³ the European Court of Justice (ECJ) held that a mere sample of colour particularly on a paper is unlikely to be sufficiently durable for the purposes of graphical representation. Designating a colour using an internationally recognized identification code will constitute a graphical representation, being precise and stable. If the colours are within a figurative arrangement such as a circle or square, then as few as two colours could be accepted, but if they are applied to the packaging of the product, they are less likely to be recognized as a trademark. In such cases evidence of factual distinctiveness will be required. One of the basic principles of colour trademark laws is that a functional colour cannot be trademarked. In other words, if a company makes lawn mowers, no protection can be granted for green as a functional colour in this case because green is the colour of lawns.

A single colour *per se* need not be considered as inherently distinctive. In *Ke Owens-Corning Fiberglas*, a colour pink could be registered for the fibrous glass residential insulation. In *KWS Saat*⁴⁴ an application for single colour orange trademark in respect of 'seeds and treatment installations for seeds, consultancy services and agricultural, horticultural and forestry products' was rejected on the ground of lack of distinctiveness. However, if a particular colour of packaging has become distinctive in fact as indicating the goods of a particular trader, there must not be any impediment in accepting the mark for registration. Several national trademark offices including those in Germany, Sweden, UK, Norway *etc.* recognize the registrability of single colour *per se* with proven secondary meaning or acquired distinctiveness. If a colour is fanciful in relation to goods/services, it may be treated as inherently distinctive and afford registration. In order to constitute a trademark, a colour or combination of colours must be capable of distinguishing the goods or services of one trader from those of other traders.⁴⁵

According to the draft manual for Trademark Practice and Procedure of Indian Trademark Registry, one means of signifying the trade mark significance of colours is to use them as a livery, *i.e.*, as a consistent colour scheme applied to a range of products of the same general kind so as to designate the trade source. The use of such liveries for buses, trains and vehicle service stations are good examples of such use in relation to services. On the other hand, evidence that an applicant uses a wide range of colour schemes in relation to goods or services of the same kind tends to

44 C-447/02, October 21, 2004, ECJ.

45 For the discussions on consumer protection aspects of trademarks, see Lisa P. Lukose, "Consumer Protection *vis-a-vis* Trademark Law" 1(1) *International Journal on Consumer Law and Practice* 89-101 (2013).

point away from the trade mark significance of any one such colour scheme. Further, word marks constituted by names of colours, which consist solely of names of single colour lack the required inherent distinctiveness unless it is unusual or unlikely to be needed for use by competitors for the goods concerned. But fanciful names such as 'pea-green' for travel services, or 'red and white' for cigarettes may have inherent distinctiveness. Distinctiveness can be established through prior use. There are also reasons of public interest to prevent the registration of single colour *per se* marks because the number of colours available is limited. According to the international colour codes, the number of existing colours is 1,800. On the question of secondary meaning, certain factors have to be considered for assessing whether a secondary meaning has been acquired or not. The extent of third party usage and the attention of the consumer should be directed towards the colour of the product in case of any sale or advertisement of the product.

Taste or gustatory marks

Taste trademarks are extremely unlikely to be held inherently distinctive in any jurisdiction without strong prove of acquired distinctiveness. Unlike sound and smell marks, taste marks can only be applied to goods and not services. WIPO SCT report states that the graphic representation requirement can be satisfied by using a written description of the taste and an indication that it concerns a taste mark. However, it has to pass the non-functionality test. The US appeal board decision in *In Re N.V. Organon*⁴⁶ highlights this aspect. The trademark application for 'an orange flavor' for pharmaceuticals for human use, namely, antidepressants in quick-dissolving tablets and pills was denied registration being not capable of trade mark protection. As per the board, "the flavor would not in fact act as a trade mark in any event." It was also held that the applicant's taste would not function as a trademark since there are numerous other orange flavored medicines. Consequently, an orange flavor for antidepressants would not be distinct of N.V. Organon's product. The board said: "There are many oral pharmaceuticals with an orange taste, and by their nature, taste marks are not inherently distinctive." The appeals board also noted that flavor is a characteristic of the goods and not their origin. As the trademark trials and appeals court pointed out, it is difficult to define how taste can act as a trademark when consumers only taste goods after purchase. Registration of a flavor mark will require a substantial showing of acquired distinctiveness. OHIM boards of appeal rejected an application by Eli Lilly⁴⁷ for "the taste of artificial strawberry flavour" as gustatory trademark for pharmaceutical preparations by stating that "it is in any event clear that such a taste cannot distinguish

46 79 U.S.P.Q. 2d (BNA) 16.39 (TTAB 2006).

47. Case R 120/2001-2.

the pharmaceutical preparations of one undertaking from those of another.” The court added: “Moreover, the taste is unlikely to be perceived by consumers as a trade mark; they are far more likely to assume that it is intended to disguise the unpleasant taste of the product.”

Holograms and moving images

Motion marks include holograms, gestures, motion or moving image marks which can combine colours, sounds and aspects of product designs. They are the result of multimedia technology. This category of marks registration usually requires the use of a sequence of pictures or drawings to depict how the trademark functions. A hologram mark represents a picture sequence used to perform the trademark function of identifying the commercial source of goods/services. Holograms have been used for decades as security devices against counterfeiting. In recent times holograms are being increasingly used as trademarks though the graphical representability requirement creates a problem for trademark proprietors. A portion of the sequence comprising the entire moving image, such as the first or last frame could be provided as long as the description of the mark clearly references the entire sequence. A single image may not adequately represent the mark, and it may be preferable to juxtapose several representative frames, to give a better sense of the overall sequence.

Several motion marks have been registered by the USPTO including a mark “consisting of a pre-programmed rotating sequence of a plurality of high intensity columns of light projected into the sky to locate a source at the base thereof” for high intensity search lights. Another registered mark consists of “the stylized words ‘FREE BREATHER’ which appeared in a fixed position on the right side of a logo” for providing an information service on the subjects of asthma and allergies through internet. A dandelion flower was represented fancifully on the other side of the logo. The motion feature of the mark was that the individual seeds of the flower’s puff ball stage got dispersed owing to the wind which had an effect over the words. The application provided four different freezed frames of the moving mark. The different frames were taken at different points of movement. In certain jurisdictions, the motion of the Lamborghini car door has been given protections as a motion trademark, because of the unique movement of the door as it is opened or closed.

In EU, though article 4 of Council Regulation, 1993 recognizes any sign capable of being represented graphically as mark, the *Steckmann* decision restricts the scope for a broad interpretation of the provision. As per the decision, graphical representation, by images, lines or character, must be clear, precise and durable. This definition leaves scope only for simply structured holograms. Even holograms

or moving images are not specifically included in India in the definition of mark or trade mark. However, there appears to be no reason why they may not be registered as trademarks. Century Fox Film Corporation's logo with floodlights trailing back and forth across the sky is a registered trademark with USPTO. In US, the trademark manual states that a hologram used in varying forms does not function as trademark in the absence of evidence that consumers would perceive it as a trademark.

Shape marks

The UK Trade Marks Act, 1994 and the Indian Trade Marks Act, 1999 specifically included the shapes within the definition of trade mark. Shapes with significant functional features are unregistrable. The Indian Trade Marks Act 1999 specifically provides that a mark shall not be registered as a trade mark if it consists exclusively of (a) the shape of goods which results from the nature of the 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.

Inherent distinctiveness of three-dimensional trademarks which includes the shapes of products has been outlined over the years by the ECJ and OHIM and Indian judiciary. In the US, the Lanham Act does not specifically define shape to be a trademark but modern practice has included shape and design of a product in a 'trade dress'. Shape of the product can be a trademark if it has acquired distinctiveness and is not functional. In *Bongrain's Trademark Application*⁴⁸ the court rejected an application for three-dimensional shape of a cheese in flower-like form since the mark was devoid of distinctive character. It also held that there is a public interest in preserving certain signs for other traders to use in relation to the same or similar goods to maintain freedom of action and competition. Public's perception of a sign is generally of paramount importance and the public is not generally accustomed to the shapes conveying trademark significance. It is easier to register a mark if it is demonstrated that a shape mark has in fact acquired distinctiveness through use. In *Coca-Cola Co. v. A.G. Barr & Co.*,⁴⁹ it was argued that the shape of the bottle was distinctive and indicative of the connection to the company.

VII Graphical representation *vis-a-vis* non-conventional trademarks

Graphic representation is the *sine qua non* of trademark registration. Global trademark regime requires the fixation or graphic representation of the trade mark although, fixation criterion is not mandatory under the TRIPS Agreement. However, TRIPS Agreement under article 15 leaves it for the member countries to fix such a criterion by stating that "members may require, as a condition of registration, that signs be visually perceptible." In order to be the subject of a valid application or registration, the sign must be capable of being represented graphically. The applicant has to file an acceptable

48 [2004] EWCA Civ. 1690.

49 1961 RPC 387.

graphic representation and the capability must be realized on the application form. The selection of the graphic representation is an important step for any applicant because the trade mark is defined by the graphic representation. The graphic representation provides a fixed point of reference showing what the mark is. The function of the graphical representation is to enable the sign in question to be represented visually, so that it can be precisely identified.

Under Indian trademark law, the sign must be capable of being represented graphically. Unless this requirement is satisfied it does not constitute a trade mark. The expression “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”. The graphic representation is essential for traders to be able to identify with clarity what the registered trade mark is. This is rather similar to the fixation criterion as required in some countries including EU. The requirement is not onerous, especially for smell trademarks where the law does not require proprietors to write down the complex and usually secret chemical formula; rather, what is required is some point of fixation. As mentioned earlier, the description of a mark as ‘the smell of fresh cut grass’ in relation to tennis balls was held to be an adequate representation of the mark.⁵⁰ In relation to sound marks, the general practice of various registries is that the graphic representation of sounds must be made either by musical notation (with stave, clef, notes and rests) or by a sonogram with a timescale and a frequency scale. A colour can be considered to be graphically represented if filed in the form of a written description (*e.g.*, sky blue) with the relevant code from an internationally recognized colour identification system. Similarly, the graphical representation of a hologram mark will be required to show various views depicted in the hologram, so that all the material features of the mark can be discerned. Movement marks can be represented by a series of still images provided it is made clear that the mark is a moving image, what the image depicts, how many images are involved, their order and the fact that there is a single sequence of movement.⁵¹

Further, a mark need not be defined with absolute precision. The degree of precision required depends on the mark itself and its distinctive character. For any mark there is a degree of permissible variation in its graphical representation. The question whether any particular graphic representation in respect of an unconventional trademark is sufficient or not is a matter for the national court to determine. *Sieckmann* criteria is widely recognized as a landmark decision on the graphical representation of non-conventional trademark wherein the ECJ ruled that the requirement of graphical

50 *Supra* note 28.

51 M.M.S. Karki, “Nontraditional Areas of Intellectual Property Protection: Colour, Sound, Taste, Smell, Shape, Slogan and Trade Dress” 10(6) *Journal of Intellectual Property Rights* 499-506 (2005).

representation is not satisfied by (i) scientific formula; (ii) description written in words; (iii) depositing a sample of odour; or (iv) combination of these methods. Registrable marks do not include signs that cannot be perceived visually, if they can be represented graphically by the means of images, lines or characters, where the representation must be *clear, precise, self-contained, easily accessible, intelligible, durable and objective*. These are generally known as the *Steckmann* criteria. As the *TREAT* case⁵² suggests marks “particularly colours and the appearance of the goods or their packaging, often pose particular problems.” Such marks are seldom used as the principal means of distinguishing the trade source of the goods or services. Nevertheless, they are capable of being used as secondary trademarks. The key issue will usually be whether the proprietor has used the mark distinctively to educate the public that it is a trade mark.

VIII Suggestions and conclusion

In the light of TRIPS Agreement and other related international legal instruments on trademark, there is a need for harmonization of trade mark systems worldwide. Hence, it is desirable to protect non-traditional trademarks in the interest of global trade. This also emphasizes the need to encourage investment flows and transfer of technology in the global as well as national market. This is particularly significant since Madrid system of international registration of trademarks facilitates international registration. Non-traditional trademarks pose certain difficulties in terms of interpretation and application of traditional/conventional trademark principles. There are two significant issues: *firstly*, the harmonization of criteria for the registration of these marks, and whether an office/trademark registry that accepts for registration could apply to them by analogy the same criteria it applied to traditional marks. *Secondly*, the harmonization of modalities for registration, in particular what would be considered an appropriate representation of the sign. These registrations are not dominant in trademark registers of the jurisdictions to provide sufficient benchmarks. It should be clarified whether the trademark registry should apply the same criteria of distinctiveness than for more traditional marks and what the criteria would be for graphical representation, particularly of non-visible signs. For example, in the case of olfactory marks, whether the trademark registry could accept a chemical formula and/or other means of representation? As for colour *per se* marks, would the plain reproduction of that colour suffice or would the colour code need to be provided, or should the trademark registry require that the colours as applied in the packaging or as applied to the goods be detailed in the application form? At least the WIPO should come out with uniform guidelines concerning graphical representation of non-traditional trademarks. The WIPO Standing Committee on Information Technologies (SCIT) can provide proper guidelines with regard to the representation, description and the application of trademark principles to non-traditional trademarks.

52 (1997) E.T.M.R. 118.

There are still grey areas in this regard: (a) the potential economic relevance of these marks for less developed markets; (b) the possibility of overlapping protection, for example with copyright, in the case of motion marks, with patent and design in case of shape trademarks; and (c) the need to consider the exhaustion of rights and limitations and exceptions to protection, for example in the case of colour, which may be viewed as a public good over which there should not be, at least in principle, any proprietary rights. There must be studies by WIPO to bring clarity on these issues. Such studies would be helpful to find common approaches. A wise combination of practical examination techniques, basic trademark analysis and some policy discussion may help to set the boundaries between different intellectual property rights. Certain registries such as USPTO, IPO have developed specific examination practices to deal with them in an *ad hoc* manner since they were receiving more applications for non-traditional trademarks over the years. There must be the harmonization of requirements for the graphical representation of new types of signs. There must be guidelines for uniform registration procedure with regard to non-traditional trademarks.

With the growth of development in technology, there is seen a deviation from the conventional trademarks; and non-traditional trademarks are getting accepted worldwide. In the legal practices of different jurisdictions there is nothing to show for treating non-traditional trademarks differently from traditional trademarks. 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 relation to non-traditional trademarks protection can be given, if the sign passes the tests of distinctiveness and geographical representation. For those signs where distinctive character can be proved, the requirement of graphical representation should not bar registration. In the modern global market, where traders market their products internationally, it is desirable to have a uniform policy among the TRIPS member states to provide for the registration of non-traditional trademarks. Where more and more jurisdictions come forward with relaxed and liberal interpretation of trademark, the inconsistencies existing in some countries surrounding the interpretation of graphical representation seem to hinder proprietors selling goods in international markets under non-traditional trademarks. This reminds the international community the urgent need to develop a uniform policy for the registration and protection of non-traditional trademarks. There should be more acceptance of the Singapore Treaty on Trademark, 2006 which came into force in 2009. The various national laws are being amended to include non-traditional trademarks either implicitly or explicitly as it opens up an entirely new avenue to explore and come up with more and more branding options. In the present era of international trade, harmonisation of the trademark application and examination procedure of non-traditional trademark and development of common approaches are the need of the hour.