



## THE CONTEMPORARY ISSUE OF GRAPHICAL REPRESENTABILITY OF NON- CONVENTIONAL TRADEMARKS

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### ABSTRACT

The rise of non-conventional trademarks is becoming increasingly apparent in today's commercial sphere. This underscores the urgency for their registration and safeguarding through legal channels. The prerequisite of graphical representation poses a significant hurdle for registering non-traditional marks like sound, smell, and colour, as they are not capable of being adequately depicted on paper. Hence, there is a pressing need to develop novel methods for registering such trademarks, especially considering that the laws in many countries have already incorporated or implicitly acknowledged these new forms of marks as eligible for trademark protection. This research paper critically examines the definitional ambiguities concerning trademarks enshrined within the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS), with particular emphasis on non-traditional trademarks, notably those lacking

visual perceptibility. Despite TRIPS' endeavour to institute a unified structure for intellectual property regulation by providing the minimum standards to be followed member states, the treatment of non-traditional trademarks remains contentious due to inconsistencies within the agreement. These trademarks, incorporating sensory attributes such as sounds, scents, and tastes, present intricate challenges in meeting TRIPS' criteria, especially pertaining to graphical representation and distinctiveness.

**Keywords:** Distinctiveness, Graphical representation, Intellectual Property, Non-traditional trademarks, Trademark law, TRIPS Agreement, Visual perceptibility.

### INTRODUCTION

A mark is a sign or indication made by a person or thing. When made by a person, the sign may carry some significance, for instance, the sign may

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convey some information, or it may demarcate the source of the object on which the mark is made.

A trademark, within the legal framework of the Indian Trademark Act, 1999, is essentially a sign or symbol that holds significance for its proprietor. The term ‘mark’ is defined under Section 2(1)(m) of the Act as follows: Section 2(1) (j) of the Trade & Merchandise Marks Act, 1958 defines mark as ‘Mark includes a device, brand, heading, label, ticket, name, signature, word, letter or numeral or any combination thereof’

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

The definition provided is expansive and primarily illustrative in nature. It is noteworthy to observe act. The inclusion of the last three categories—‘shape of goods’, ‘packaging’, and ‘combination of colours’— In this definition, there is a departure from the definition of ‘mark’ as stipulated in the preceding act.<sup>3</sup> These categories are often denoted as ‘non-conventional trademarks’, contrasting with the other elements of the list which may be termed as ‘conventional trademarks’.

With the emergence of new technologies, sophisticated marketing methodologies, and assertive advertising tactics, additional forms of non-conventional trademarks have surfaced. These encompass sound marks, odour marks, taste marks, touch marks, motion marks, and hologram marks.<sup>4</sup>

The term “trademark” is defined within Section 2(1) (zb) of the Act, elucidating it as any mark that possesses distinctiveness, indicating its capability to differentiate goods and services of one enterprise from those of others. Furthermore, a trademark must be competent of graphical representation. The definition delineates two overarching criteria that a mark must meet to attain trademark status. It is noteworthy that the

definition of a mark is all-encompassing within legal parameters, thus allowing non-conventional marks to fall within the purview of trademark protection provided they comply with both the prerequisites of distinctiveness and graphical represent ability.

The matter pertaining to the graphical representation of non-traditional trademarks arises due to the unique nature of these marks, such as sounds, smells, tastes, textures, and movements, which cannot be easily depicted in traditional graphic formats like images or words. Unlike conventional trademarks, which are typically represented visually through logos or symbols, non-conventional trademarks present a challenge in terms of capturing their essence in a graphical form that can be registered and protected under trademark law. For example, representing a sound mark like a jingle or a smell mark like a particular fragrance in a traditional graphic format poses difficulties, as these sensory experiences cannot be adequately conveyed through visual means alone. Similarly, texture or touch marks, which relate to the feel or texture of a product, present challenges in graphical representation. The issue becomes more complex when considering the legal requirement for trademarks to be graphically represented for registration purposes. Many trademark laws around the world, including those in India, require trademarks to be represented graphically in the application process. However, the traditional understanding of graphical representation may not fully accommodate non-conventional trademarks. As a result, there is ongoing debate and discussion among legal practitioners, policymakers, and trademark offices on how to effectively address the graphical representation of non-conventional trademarks. This includes exploring alternative methods of representation, such as audio or video files for sound marks, chemical formulas for scent marks, or written descriptions for taste marks. Overall, the issue underscores the need for flexibility and adaptability in trademark law

3 Trade & Merchandise Marks Act, 1958, S 2(1) (j), No. 43, Acts of Parliament, 1958 (India).

4 WIPO, <https://wipo.int/web/wipo-magazine/articles/smell-sound-and-taste-getting-a-sense-of-non-traditional-marks-36622> (Last visited Sept. 25, 2024)

to accommodate the evolving nature of branding and marketing practices, while ensuring that the essential function of trademarks in identifying and distinguishing goods and services is preserved.

Nevertheless, numerous challenges impede the registration of non-conventional marks as trademarks. The primary challenge lies within the distinctiveness prerequisites itself. While certain non-conventional trademarks, such as shapes and colours, may be uniformly recognizable by consumers, others, like smell and taste marks, may evoke varying perceptions among consumers, leading to potential confusion. However, it's imperative to note that this presents a practical difficulty rather than a legal impediment to registration. A mark has the potential to acquire distinctiveness through use, thereby meeting the criteria to be recognized as a trademark, even if it lacks inherent distinctiveness initially.<sup>5</sup> The second obstacle pertains to the graphical representation of the mark intended for registration, particularly concerning non-conventional marks. This aspect constitutes the fundamental foundation of this paper, while other impediments to the registration of non-conventional trademarks are not explored herein.

## **WHAT ARE NON-CONVENTIONAL TRADEMARKS?**

“There is a new category of modern marks which are protectable only in some countries, these marks include three-dimensional marks, such as the shape of goods or their packaging, colours, per se, sound marks, motion marks, position marks, hologram marks, hologram marks, slogans, smell marks, feel marks and taste marks. Graphically representation of some of the modern marks is a serious problem.”<sup>6</sup>

Non-conventional trademarks sometimes referred to as non-traditional trademarks, deviate from the traditional forms of word marks and logos. They encompass unique attributes beyond simple

text or graphic symbols, serving as identifiers for the origin of goods or services. These marks represent innovative forms of brand representation that go beyond conventional boundaries, reflecting the evolving landscape of intellectual property rights. Here's a summary of non-conventional trademarks:

Non-conventional trademarks span across a spectrum of categories, each exhibiting distinct features. These categories encompass sound marks, colour marks, shape marks, motion marks, position marks, and smell and taste marks, each contributing to the expanding array of trademark representation beyond conventional boundaries.

A non-conventional trademark serves the fundamental purpose of uniquely designating the industrial origin of products or services. In contemporary times characterized by heightened competitive dynamics among rivals vying for recognition of their offerings, non-conventional marks have emerged as a prevalent method of identification in the marketplace. However, historically, the protection of such marks as trademarks through registration has posed challenges, given their departure from conventional notions of “trademark” status. Nevertheless, with the rapid pace of global advancement and technological evolution, the imperative for safeguarding these marks has become increasingly pronounced. Signs that function as indicators of source to consumers, irrespective of their visual perceptibility, embody significant value and warrant protection against misappropriation.

The initial hurdles concerning the graphical representation of these “signs” in an application, and subsequently, their searchability during examination for conflicting applications and registrations, should not serve as the sole grounds for rejecting these marks for registration. Sensory marks, including movement marks, colour marks, holograms, and configurations, all serve as distinctive indicators of origin and should not

5 Tejas Singh, Trademarks: *Distinctiveness is an Exception of Descriptiveness*, SCCOnline, (last visited Sept.26, 2024) <https://www.sconline.com/blog/post/2021/08/24/trademarks/>

6 V K AHUJA, LAW RELATING TO INTELLECTUAL PROPERTY RIGHTS, 265 (Lexis Nexis 2017).

be disqualified from registration merely due to the potential challenges they pose in search and examination processes. Indeed, such marks may cater to segments of society previously overlooked by manufacturers, highlighting their potential societal value and underscoring the necessity for their protection.

In today's commercially driven world, there exists a pressing necessity to afford protection to non-conventional marks. These trademarks serve a segment of society that has historically been marginalized. Specifically, individuals with visual impairments or low literacy levels encounter significant challenges in visually perceiving and associating with products and services. Consequently, their purchasing decisions often rely on external perspectives, leading to confusion and difficulty in differentiation as consumers. Non-conventional trademarks hold promise in addressing these challenges and providing clarity and accessibility to this underserved demographic.

**Sound Marks:** Sound marks are defined by unique auditory characteristics, such as jingles, musical sequences, or distinctive sounds. These marks are recognized by their specific auditory elements and are used to distinguish products or services.

A multitude of sound marks have been successfully registered in various countries globally. Examples include recognizable jingles like the Nokia ringtone and the iconic "roar of a lion" associated with MGM, where sound sonograms or spectrograms effectively capture the roar's unique characteristics such as pitch, temporal progression, and volume. Additionally, the distinct chime utilized by NBC serves as a recognizable identifier, aiding in product differentiation and establishing their commercial provenance.<sup>7</sup>

The European Union has officially registered the distinctive sound mark associated with Nokia

Corporation, thereby granting legal recognition and protection to the company's signature tone.

**Colour Marks:** Colour marks use specific colours to distinguish products or services. They are visually distinctive and recognized based on colour alone. Iconic examples include Tiffany Blue for jewellery and UPS Brown for package delivery.

Cadbury has obtained trademark protection for the colour "purple" specifically designated as Pantone 2685C for its chocolates in the United Kingdom.

**Shape Marks:** Shape marks use the specific shape or packaging of a product or its container as a trademark. They are distinctive due to their unique appearance and can include product design elements.

An instance of a non-traditional visual mark is exemplified by the distinctive triangular shape of Toblerone chocolates, which has been acknowledged and protected within the European Union.

**Motion Marks:** Motion marks incorporate movement or animation as trademarks. They are recognized by their unique moving elements, often used in advertising or branding.

The first motion mark in India was granted to Nokia Corporation. (*having registered trademark number 1246341 in Class 99*)

**Position Marks:** Position marks relate to the specific position of a trademark on a product. They distinguish products or services based on where the mark is placed, such as logos on clothing.

In the United States of America, registration of motion marks is permitted. It is noteworthy that one of the earliest motion marks registered in the U.S. was by Columbia Pictures in 1996.<sup>8</sup> This motion mark features a logo depicting a woman carrying a torch and wearing a drape, recognized

7 FASTER CAPITAL, <https://fastercapital.com/topics/introduction-to-sound-marks.html> (last visited Mar. 29, 2024)

8 Belinda J. Scrimenti, *Animated "Motion Trademarks" Grow in Popularity and Legal Protection Around the World*, LexisNexis (last visited Jan. 19, 2024) <https://www.lexisnexis.com/community/insights/legal/practical-guidance-journal/b/pa/posts/animated-motion-trademarks-grow-in-popularity-and-legal-protection-around-the-world?srsId=AfmBOoqvMtK84fhr2N34mk5UDJRbhUSrGjxnuXbLpaqc48ctkDodod>

as “Columbia, a personification of the United States.”<sup>9</sup>

**Smell and Taste Marks:** Smell and taste marks use distinctive scents or flavours as trademarks. They identify products through unique sensory experiences, such as perfumes with specific scents or food products with distinct flavours.

## REGISTRABILITY OF NON-TRADITIONAL TRADEMARKS

Ensuring eligibility for trademark protection and registration mandates compliance with distinct statutory criteria, which can vary across different countries under their respective national laws. The TRIPS agreement accommodates this diversity by aiming to establish standardized norms across various international agreements, including The Paris Convention, the Madrid System, the Trademark Act Treaty, the Singapore Law Treaty, and others.

Securing certification for non-conventional marks presents a notable challenge compared to conventional marks. In certain jurisdictions, such as India, pertinent legislation remains silent, lacking explicit provisions addressing the registrability of non-traditional marks. This dearth of statutory clarity underscores the complexities inherent in navigating the registration process for marks falling outside conventional parameters. Numerous jurisdictions extend protection to non-traditional marks, albeit with varying degrees of specificity. However, comprehensive guidelines governing examination protocols and the criteria for registering non-traditional trademarks are typically delineated within the trademark register handbook issued by the relevant trademark registry. This handbook serves as an authoritative resource, furnishing precise instructions to trademark examiners and applicants alike regarding the evaluation and registration procedures pertaining to non-traditional trademarks, thereby ensuring adherence to established legal principles and

standards. Like conventional trademarks, non-traditional trademarks must satisfy essential criteria, as stipulated under Article 15 of the TRIPS Agreement. These prerequisites typically encompass distinctiveness and either visual or graphic representation. Additionally, the symbols or signs in question must originate from a distinct source and possess the capability to function as exclusive identifiers of that source. Nonetheless, it is imperative that non-traditional trademarks do not engender confusion or deception among the public. Furthermore, it's noteworthy that a particular type or graphical representation deemed acceptable for non-traditional trademarks in one jurisdiction may not meet the standards of adequacy in another jurisdiction.

## GRAPHICAL REPRESENTABILITY: GENERAL OVERVIEW

To qualify for a valid registration application, the sign must meet the graphical representation as criteria as mandated by Section 2(1) (zb) of the Act. The term “capable of being represented graphically” entails that the mark should possess the attribute of being feasibly depicted in physical form for registration purposes and subsequently published in the relevant journal.<sup>10</sup>

In the case of “Swizzels Matlow Ltd. Application (No 2)”,<sup>11</sup> the bench elucidated on the primary justifications underlying the graphical representation criterion:

- Firstly, it serves to provide clarity for traders, enabling them to discern precisely which trademarks have been sought for registration by other traders, particularly within the same industry or related sectors, and for what specific products or services.
- Secondly, it facilitates the public in accurately identifying the mark that is the subject of the trademark registration, ensuring transparency and precision in the trademark system.

<sup>9</sup> U.S Registration No. 1975999.

<sup>10</sup> KC KAILASAM & RAMU VEDARAMAN, LAW OF TRADEMARKS & GEOGRAPHICAL INDICATIONS, 132 (2<sup>nd</sup> ed. 2005).

<sup>11</sup> *Swizzels Matlow Ltd's Application (No 2)*, (2000) ETMR 58.

The criterion of graphical representability lacks objectivity due to the absence of explicit guidelines defining the requisite level of precision necessary for identification. However, an examination of the statutory provisions within the Act reveals that the graphical representation must meet the standard of being substantial enough to enable the complete and efficient execution of its intended purpose. For example, a precise and unequivocal depiction of a trademark offers evidentiary advantages in substantiating a claim for trademark violation pursuant to Section 29 of the Trademark Act. Hence, the framework of rights and obligations delineated within the Act can be adequately implemented solely when the graphical representation distinctly reveals the identity of the sign it intends to depict.<sup>12</sup>

In the United Kingdom, efforts have been made to mitigate the considerable subjectivity involved in assessing whether a mark has been graphically represented. A mark is considered to meet the graphical representation requirement when it satisfies three broad criteria.<sup>13</sup>

- The graphical representation should sufficiently depict the mark on its own, without additional examples.
- The graphical depiction serves as a direct substitute for the mark.
- Individuals reviewing the trademarks register or perusing the trademark gazette should reasonably comprehend the trademark's essence from its graphical depiction solely. Any specifications regarding color standards, musical notation, or scientific measurements employed for representing marks must adhere to a standard of precision.
- The criteria regarding color standards, musical notation, or scientific measurements employed for mark representation should be practically feasible to ensure that users

of the system can readily grasp the essence of the mark.

- Users should be able to conduct accurate comparisons between the sign utilized or proposed by the applicant and other similar signs.

While not directly applicable within the Indian legal framework, the guidelines offer valuable insight into the interpretation of the term “graphical representability.” Within the Indian legal context, it is imperative to adopt a liberal interpretation of the term “graphical representability.” This approach is necessary not only to accommodate non-conventional trademarks but also to align with the legislative intent behind implementing an extensive criterion of graphical representability, rather than the narrower concept of “visual perceptibility” as stipulated in TRIPS.<sup>12</sup> Moreover, it is essential to interpret the requirement of graphical representation within the framework of the Act and the rules promulgated thereunder. Particularly significant is Rule 2(1)(k) of the Trademarks Rules, 2002, which defines ‘graphical representation’ as the portrayal of a trademark in paper form. This stipulation clarifies that any depiction of the trademark must adhere to the requirement of being in paper format, as per the prescribed form for its registration application.

## GRAPHICAL REPRESENTATION OF NON-CONVENTIONAL TRADEMARKS

The graphical representation of non-conventional trademarks is present primarily as a practical challenge rather than a purely legal one. When combined with the requirement of distinctiveness, it can indeed serve as a significant hurdle in the registration process for non-conventional trademarks. This holds especially true in the context of odor, sound, and color marks.

Graphic representation stands as an indispensable requirement for trademark registration. Within the framework of the

<sup>12</sup> *Supra* note 10.

<sup>13</sup> “UK Trademark Registry Work Manual, August 1998 edition, p. 18, reinforced by Practice Amendment Circular 2/00 cited in ref. 8.”

international trademark system, it necessitates the mark to be fixed or graphically represented, the TRIPS Treaty does not prescribe specific parameters for fixation. Nevertheless, pursuant to Article 15 of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS), Member States retain the authority to institute such a criterion, wherein it is stipulated that “Members may stipulate visual perceptibility as a prerequisite for registration.” Accordingly, an adequate graphical representation must be provided alongside the application form, ensuring its capacity for realization. For every applicant, the choice of graphical representation holds significant weight, as the mark is delineated by the selected graphical representation. A clear and unequivocal point of reference establishes the identity of the mark within the graphical representation. The primary purpose of the graphical image is to visually depict the sign in question, ensuring accurate identification. The sign must be capable of graphical representation in compliance with Indian trademark law. Failure to meet this requirement precludes it from being recognized as a trademark. The term “trademark” is elucidated as “a mark capable of graphical representation,” as per Rule 3(1)(k) of the Trademark Rules. This provision specifies that “graphical representation” entails portraying a trademark in printed format for goods or services. Furthermore, a mark need not be defined with absolute precision. The requisite level of accuracy is contingent upon the inherent characteristics of the mark and its capacity for distinction. Permissible deviations exist in the graphical depiction of each mark. It is within the purview of the national court to ascertain whether a specific graphical representation for an unconventional trademark is deemed sufficient or not. The Sieckmann Criteria represent a landmark decision concerning the graphic representation of non-conventional trademarks. According to the ECJ ruling, “the requirement for graphical representation is not met (i) by scientific formula; (ii) by wording alone; (iii) by providing an odour sample; or (iv) by a combination of these methods. Marks that are not visually perceptible encompass signs that can be graphically represented through

images, lines, or characters, provided that a clear, precise, self-contained, easily accessible, sustainable, and objective representation is attainable.” The Sieckmann criteria are widely recognized within legal circles. As highlighted in the TREAT case, specific marks, especially those pertaining to the colour and appearance of items or packaging, often present challenges. These marks are typically not the primary means of distinguishing the commercial origin of products and services but may function as secondary trademarks. The key consideration usually revolves around whether the owner has clearly employed the mark to signal to the public its status as a trademark.

Traditionally, graphical representation of trademarks has been limited to visual images or symbols that can be depicted on paper or electronically. However, with advancements in technology and changes in consumer behaviour, new methods of graphical representation have emerged. These include audio files for capturing distinctive sounds associated with a product or service, chemical formulas for describing scents or tastes, and written descriptions for trademarks that cannot be easily represented visually or audibly. Conducting a comparative analysis involves evaluating the strengths and weaknesses of these various methods in the context of trademark law and practice. Each approach may have distinct advantages and limitations, depending on factors such as the type of trademark, ease of understanding, and legal recognition. For example, audio files may be effective for capturing distinctive sounds but could be challenging to represent accurately in written or visual form. Similarly, chemical formulas may provide precise descriptions of scents or tastes but may lack the immediate recognisability of visual symbols. Legal implications include updating trademark laws and regulations to accommodate alternative methods and ensuring compatibility with existing systems. Feasibility considerations include technology accessibility, cost, and stakeholder acceptance. Exploring innovations, conducting comparative analysis, and addressing legal implications and feasibility are essential steps in advancing the

recognition and protection of non-conventional trademarks.

## INTERPRETATION OF ARTICLE 15.1 OF TRIPS

National laws and international treaties refer to an open-ended definition of a trademark. Article 15(1) of TRIPS acknowledges that any “any sign, or any combination of signs, capable of distinguishing the goods and services of one undertaking from those of other undertakings, shall be capable of constituting a trademark”

Though concise in form, the definition of trademark and the subject matter protected therein bear a great deal of substance. The first sentence provides that “any sign...shall be capable of constituting a trademark”. This definition provides that “any sign” be taken as potential trademark. What is interesting to note is that the first sentence of Article 15.1 does not exclude sounds and scents from qualifying for trademark protection.

On the other hand, the second sentence provides that “in particular” the given subject matter “shall be eligible for registration as trademark” (i.e. personal names, letters, numerical letters, figurative elements and combination of colors as well as any combination of such signs) the visually perceptible signs are not included herein.

The fourth sentence allows the Members to condition registration on visual perceptibility. This makes it clear that though, the provision has the capacity to cover sounds, scents, tastes and textures under its ambit for protection after they qualify themselves as potential signs, but they aren't accorded for protection. Thus, the fourth sentence allows the exclusion of subject matter. “In United States- Section 211 of the Omnibus Appropriation Act, the Appellate Body rejected an argument that members must register trademarks that meet the requirements of Article 15.1”<sup>14</sup>

It follows that the wordings of article 15.1 which allow WTO members to set forth in their domestic legislation conditions for the registration of trademark, that do not address the definition of either ‘protectable subject-matter’ or of what constitutes a trademark.

In our view Article 15.1 of the TRIPS Agreement limits the rights of members to determine the ‘conditions’ for filing and registration of trademarks under their domestic legislation pursuant to Article 6(1) (of the Paris Convention (1967) as incorporated in the TRIPS Agreement) only as it relates to the distinctiveness requirements enunciated in Article 15.1.

This operational definition, combined with practical observations from the marketplace wherein shapes, product packaging, and colors may serve as indicators of commercial origin, has contributed to the formal acknowledgment of Non-Conventional Marks as viable subject matter.<sup>15</sup>

Trademark law is anticipated to evolve in alignment with consumer perceptions. Should consumers come to perceive colors or scents as indicative of commercial origin, the principles of trademark protection necessitate their inclusion in registration practices and doctrines.

The statutory language in the United States follows a similar structure: A trademark is defined as any designation encompassing, “any word, name, symbol, or device, or any combination thereof [which serves to identify and distinguish the mark owner’s goods] from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown”. As noted by the US Apex Court, since “human beings might use as a “symbol” or “device” almost anything at all that can carry meaning, (the statutory definition) read literally, is not restrictive”.

The European Court of Justice (ECJ) has echoed this sentiment in a harmonious manner in the Sieckmann case and subsequent judgments, which also interprets the analogous definition

14 WTO ANALYTICAL INDEX, [https://www.wto.org/english/res\\_e/publications\\_e/ai17\\_e/ai17\\_e.htm](https://www.wto.org/english/res_e/publications_e/ai17_e/ai17_e.htm) (last visited 6 Feb. 2024)

15 WIPO Standing Committee on the Law of Trademarks, Industrial Design and Geographical Indication (Sessions 17), Geneva May 7 to 11, 2007, [http://www.wipo.int/meetings/en/details.jsp?meeting\\_id=12643](http://www.wipo.int/meetings/en/details.jsp?meeting_id=12643), (Last Visited on Feb. 20 2024).”



found in Article 2 of the EU Trademarks Directive. These regulations underscore the communicative capacity required of a candidate. The sign shall demonstrate the potential for distinctiveness: it must signify origin and thereby serve to distinguish the goods or services upon which it is utilized from others in the marketplace. Furthermore, legal principles acknowledge that brand owners could inform the pertinent public that a particular sign is being utilized as a trademark, through the doctrine of acquired distinctiveness or secondary meaning. This broad approach to subject matter is also apparent in the provisions of the Act of 1999. Section 2(1)(zb) defines a trademark as follows: “trademark” signifies a “mark capable of being represented graphically and having the capacity to distinguish the goods or services of one person from those of others, which may encompass the shape of goods, their packaging, and combinations of colors.”

A mark is further defined in section 2(1)(m): “Mark” includes “a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination thereof;” While the definition provided is comprehensive, the Draft Manual further elucidates that certain categories of marks, such as shapes, colours, sounds, and smells, will necessitate special consideration. This ‘special consideration’ can be examined within the context of overarching themes that apply across all categories of non-conventional subject matter.

The agreement like Trade Related Aspects of Intellectual Property Rights (TRIPS) agreement which sets down a standard, inclusive of legal definition. Thus, these unique marks are becoming the way of the future and are trending to alter the traditional principles of trademark law in their letter and spirit.

## **NON-CONVENTIONAL TRADEMARKS IN INDIA**

India’s legal system is gradually adapting to the complexities of non-traditional trademarks. While the process for registration and protection is more stringent, it provides robust mechanisms

to safeguard innovative branding elements. Businesses looking to register non-traditional trademarks must be prepared for a detailed and potentially lengthy process, requiring strong evidence of distinctiveness and public association with their brand.

The Trademarks Act of 1999 and the Trademarks Rules of 2002 in India broaden the definition of trademarks to include non-conventional marks, such as shapes, packaging, colours, sounds, and scents. This is a significant shift from the Trade and Merchandise Marks Act of 1958, which did not explicitly address non-conventional trademarks. The Draft Manual for Trademark Practice and Procedure provides guidance on these provisions, emphasizing the need for graphical representation and the ability to distinguish goods or services.

### **Scope of Protection**

Sections 2(1)(f), 2(1) (zb), and 2(1)(m) of the Trademarks Act broaden the definition of “trademark” to include non-conventional marks. According to Section 3 of the Draft Manual, any mark capable of graphical representation and distinguishing the goods or services of one person from those of others qualifies as a trademark. However, it notes that colours, shapes, sounds, and smells require special consideration for registration.

### **Sound Marks**

India has adopted the Shield Mark doctrine for sound marks, which requires their graphical representation through musical notes. The Trademark Registry does not question whether these representations are universally intelligible but evaluates their distinctiveness. Non-distinctive sounds are not registrable. Yahoo!’s yodel was the first sound mark registered in India in 2008, represented through musical notation. Other notable registrations include ICICI Bank’s jingle and Nokia’s signature ringtone.

### **Scent Marks**

Scent marks face significant challenges due to the graphical representation requirement, as

mandated by the Sieckmann test. The Trademark Registry acknowledges scents as registrable but has not developed methods to meet this requirement, creating a gap in practical implementation. Various scientific approaches, such as using odour matrices or gas chromatography, have been proposed to visually represent scents. However, these methods are yet to be adopted by the Trademark Registry.

### Shape Marks

Shapes and packaging are included in the definition of trademarks under the Trademarks Act, provided they can be graphically represented and distinguished from others' goods or services. The Act's criteria for shape marks include:

1. **Not Resulting from Nature:** The shape should not result from the nature of the goods themselves.
2. **Unique and Distinctive:** The shape must be unique and can be proved distinctive through use.
3. **Non-functional:** The shape should not be necessary to obtain a technical result or be a result of functionality.
4. **Not Adding Substantial Value:** The shape should not add substantial value to the goods aesthetically or in design.

The Indian Trademarks Rules, 2002, require applicants to provide a two-dimensional graphic or photographic representation of the mark, including multiple views and a written description. The Registrar may request additional views or a specimen for clarification.

### Legal Developments and Case Law

Indian courts have begun to recognize the importance of trade dress, particularly in the context of transnational reputation. In the case of *William Grant & Sons Ltd. v. McDowell & Co Ltd.*, the court addressed trade dress in a passing-off action, emphasizing its significance. For single-color trademarks, inherent distinctiveness is not recognized, as demonstrated by the rejection of Cadbury's attempt to trademark purple. However, combinations of colours, like the white and red

associated with Colgate products, can acquire secondary significance and be registrable.

### TRIPS Agreement and Graphical Representation

The TRIPS Agreement (Article 15.1) requires that trademarks be visually perceptible, typically in printed form. However, Indian law interprets this as "graphical representability," allowing for a broader range of representations. This interpretation aligns with evolving trademark laws to accommodate non-conventional marks.

In summary, while the Trademarks Act of 1999 and the Trademarks Rules of 2002 have expanded the scope of trademark protection to include non-conventional marks, practical challenges remain. The requirement for graphical representation poses significant hurdles, particularly for scent marks. Sound and shape marks have seen some success in registration, but their distinctiveness and functionality continue to be closely scrutinized. The evolving legal landscape in India reflects ongoing efforts to balance international standards with local practices, providing new opportunities for protecting innovative trademarks.

### SUGGESTIONS

- To assist potential applicants seeking registration of non-conventional trademarks, it would be advantageous for the intellectual property offices of Member countries with established regimes for non-conventional trademarks to provide the following information on their websites: Guidelines for the examination of Non-Conventional Trademarks and rulings from significant cases.
- Also, with regards to India, there have been some changes in the Legislation. Though amendments have enhanced the scope of trademark by including non-conventional trademarks under the definition of the 'trademark', but still there are some marks left outside it which needs to be embedded under the newly revised legislation

- The term “graphical representation,” as delineated in Rule 2(1)(k) of the Trademark Rules, 2002, could potentially undergo refinement to accommodate the evolving landscape of trademark methodologies, departing from the exclusive stipulation of graphical representation limited to “paper form.”
- This initiative would not only benefit applicants seeking registration of non-conventional trademarks. Furthermore, they serve as a valuable point of reference for jurisdictions with less established protection frameworks for non-conventional trademarks. It could provide a foundational understanding of the most effective methods for safeguarding Non-conventional Trademarks. This would effectively address the issue of ambiguity arising from the application provisions of TRIPS within the national legislation of different Member nations. It would streamline the implementation of, if not a standardized system, at least a equivalent framework for the registration of Non-conventional trademarks. Consequently, we would move towards a system of non-conventional trademark protection that aligns with the level of protection afforded to Traditional trademarks.
- Non-traditional marks are increasingly being recognized in India, prompting the evolution of laws and procedures. With advancements in technology and the widespread accessibility of high-quality graphics and sound-producing devices, there arises a growing demand for protection in this domain. Therefore, it is important to have consistency in the way that the offices examine applications for registration of non-traditional marks, Additionally, an analysis of judicial enforcement practices underscores the significance of protecting non-conventional trademarks. This observation substantiates the hypothesis asserting the merit of safeguarding non-traditional trademarks. And finally, the TRIPS agreement being disadvantage and incompetent for the registration of Non-Conventional Trademarks within the ambit of Article 15.1.
- Therefore, it is important to have consistency in the way that the offices examine applications for registration of non-traditional marks, and how the courts approach enforcement. This also contributes to the hypothesis asserting that the non-conventional trademarks are worthy of protection and ultimately, the future seems promising for non-traditional trademarks.

## CONCLUSION

Recently, non-conventional trademarks have seen rising utilization as marks within the marketplace. Nonetheless, historically, safeguarding these marks under trademark law has posed challenges due to difficulties associated with their registration. The lack of recognition of these marks as potential trademarks stemmed from their omission within the existing legal framework. This concern was remedied by the World Intellectual Property Organization (WIPO) under the auspices of the WTO Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS), which broadened the scope of the interpretation of trademark to include “any sign capable of distinguishing the goods or services of one undertaking from those of another undertaking” as outlined in Article 15.1

All Member nations of the TRIPS Agreement have integrated the principle of differentiation between the goods and services of one entity and those of others into their interpretation of a ‘trademark’, in accordance with the principle outlined in Article 15.1 of the TRIPS Agreement. Article 15.1 further delineates the primary types of signs eligible for trademark protection within Member nations.

While the TRIPS definition of trademark is expansive, aiming to encompass any sign that could function as a trademark, the requirement of visual perceptibility posed challenges in registering these

emerging types of marks, which were perceptible but not strictly visual. While most Member Nations mandate that a mark be capable of graphical representation for registration, certain Member nations impose an additional requirement of visual perception. With regards to this latter stipulation, sound marks and scent marks are automatically precluded from trademark protection since sound and scent are not visually perceptible. In essence, while the definition under TRIPS did not explicitly exclude non-conventional and multisensory marks, it failed to adequately protect such marks.

The divergence in the advancement of trademark regimes among Member nations is the primary factor contributing to the procedural disparities observed in each nation's approach to registering Non-conventional Trademarks. Trademarks have traditionally been construed as signs comprising visually perceptible elements such as letters, numerals, and figurative elements. Consequently, Member nations with a conservative stance towards trademark protection may exhibit limited receptivity towards granting protection to marks lacking visual distinction. Moreover, the absence of uniformity or consistency in the substantive criteria and examination procedures among Member Nations may exacerbate this situation. Further obstacles in the journey to protect non-conventional marks arose due to the lack of any universally recognized method for submitting representations of marks that are non-visible, such as touch marks, taste marks, and the like.

In conclusion, the issue of graphic representability for non-conventional trademarks highlights the dynamic nature of trademark law, calling for innovative approaches to ensure adequate protection for emerging forms of brand identity in an increasingly complex marketplace. In the context of non-conventional trademarks, particularly those that are not visually perceptible, the interpretation of a trademark in the TRIPS Agreement can present a challenge. TRIPS Article 15 defines a trademark as "any sign capable of distinguishing the goods or services of one undertaking from those of other undertakings." This definition is broad and inclusive, suggesting that trademarks need not be limited to visually perceptible signs. However, the

issue arises when considering the requirement of graphical representation traditionally associated with trademarks. While TRIPS do not explicitly mandate visual perceptibility, the practical application of trademark law often necessitates some form of graphical representation for registration and enforcement purposes. This requirement has historically posed difficulties for non-traditional marks that do not lend themselves easily to graphical depiction, such as sound marks, scent marks, and taste marks. The contradiction lies in the tension between the broad definition of a trademark in Article 15 and the practical requirement of graphical representation. While the definition encompasses non-traditional marks, the insistence on graphical representation may exclude certain types of non-visually perceptible marks from protection under traditional trademark systems. This discrepancy highlights the need for flexibility and adaptation in trademark laws to accommodate non-conventional trademarks effectively. It also underscores the ongoing debate and challenges surrounding the recognition and protection of non-traditional marks in the international legal framework governed by agreements like TRIPS.

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