

NON-CONVENTIONAL TRADEMARKS IN INDIA AND ITS INFLUENCE ON BUSINESSES: A COMPARATIVE ANALYSIS

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INTRODUCTION

A trademark is one of the various Intellectual Properties available. The purpose behind the existence of a Trademark is primarily to distinguish certain grades of products from other similar ones. This cuts down on consumer research costs and eradicates ambiguity amongst the masses regarding products. The quality promised by the trademark owner is preserved and can be relied on by the consumer during the purchase. A trademark primarily consists of graphically represented logos, words or short phrases that are unique to that certain product, making it distinguishable from the other competitors in the market. Some examples of a trademark include the logo of Apple, the colour purple of Cadbury, the bottle design of Coca-Cola, etc.⁵⁶⁰ Although it is not restricted only to the graphically representable characteristic of a Trademark, predominantly the idea of a Trademark revolves around it. However, the ambit of a trademark keeps increasing as the fundamental agenda is to distinguish products and as far as this is achieved and regulated, the possibilities are endless.⁵⁶¹

Apart from acting as an asset to businesses and establishments, it also benefits the consumers, which makes it a more attractive and lucrative investment. The types of trademarks are as follows: Word Marks, Device marks, Figurative Marks, Service marks, Collective Marks, Certification Marks, Well-Known marks, and non-conventional trademarks. For a trademark to be enforceable, it should be registered; Sec. 27 of the Trademarks Act, 1999 speaks about how there is no infringement with respect to any unregistered trademark. Nevertheless, common law remedies are still provided for the same. If registered, the value of the trademark increases as it achieves enforceability.

Sec. 2(zb) of the Trademark Act, 1999 defines a trademark as a graphically depictable entity. However, restricting the applicability of a trademark only to a graphically representable one limits its perspective. The fundamental purpose of a trademark is satisfied even by a non-conventional trademark, yet the intricacies involved in registration, recognition, enforcement, applicability, and relief are abstruse.



⁵⁶⁰ Sana Singh, *Trademark Law in India – Types of Trademarks, Registration Procedure and Acquired Distinctiveness of Generic Words*, S&P (accessed on 18 Oct. 2023).

⁵⁶¹ Ibid.

Non-Conventional Trademarks

The trademarks that do not fall under the general ambit of traditional trademarks, i.e., words, logos, symbols or phrases, are termed as non-conventional trademarks. Non-conventional Trademarks include sounds, smells, tastes, textures and even colours.⁵⁶² Although the requirements for such trademarks to be recognised vary from jurisdictions, the concept that these entities help us associate a certain product or service with a particular quality remains the same. The requirement for registrations can be considerably higher than traditional trademarks, as the onus to prove the association of a certain entity with a product or service's quality is quite challenging. If this can be established, the trademark should face no problem in registration, recognition and enforcement.

The approach taken by the Indian Legislation mandates three essentials for a trademark: inherently distinctiveness, graphically representable, and distinguishability. However, Art. 15 (1) of the Agreement of Trade Related Aspects of Intellectual Property Rights (TRIPS)⁵⁶³ doesn't lay down the graphically representable part as mandatory. Giving rise to the question of if Non-Conventional Trademarks can be registered or recognised?

The US Approach

The development of non-conventional trademarks in the US has been a dynamic process driven by evolving consumer trends, technological advancements, and legal considerations. Here are some key factors that have contributed to the recognition and growth of non-conventional trademarks:

Legal Framework: The US has a robust legal framework that allows for the protection of non-

traditional marks. The Lanham Act, which governs trademarks in the US, provides flexibility in recognizing and registering non-conventional trademarks.

Changing Consumer Behaviour: As consumer behavior has shifted, there has been a growing demand for unique and memorable brand experiences. Non-conventional trademarks offer a way for businesses to differentiate themselves and create strong associations in consumers' minds.

Technological Advancements: Technological advancements have played a significant role in the development of non-conventional trademarks. For example, advancements in audio and visual technologies have made it easier to create and protect sound and motion marks.

Global Harmonization: The recognition of non-conventional trademarks in other jurisdictions, such as the European Union (EU), has influenced the US approach. As businesses expand globally, the need for consistent protection and recognition of non-conventional trademarks has increased.

Landmark Court Cases: Landmark court cases, such as the ones mentioned earlier, have shaped the legal landscape for non-conventional trademarks in the US. These cases have provided guidance and established precedents for the registration and protection of non-traditional marks.

1. *Qualitex Co. v. Jacobson Products Co.*⁵⁶⁴ (1995): This case involved the registration of a specific shade of green on dry cleaning press pads. The Supreme Court ruled that color can serve as a valid trademark, emphasizing that a color can acquire distinctiveness and be associated with a particular source.
2. *Shield Mark BV v. Joost Kist h.o.d.n. Memex*⁵⁶⁵ (2003): In this case, the

⁵⁶² Kriti Krishna, *Protection of Non-Conventional Trademarks: An Analysis*, 5 INDIAN J.L. & LEGAL Rsch. 1 (2023).

⁵⁶³ Agreement on Trade-Related Aspects of Intellectual Property Rights (1994) [hereinafter "TRIPS"].

⁵⁶⁴ 514 U.S. 159 (1995).

⁵⁶⁵ ECJ Case C-283/01, 27 November 2003.

European Court of Justice recognized sound marks as a distinct type of trademark. This decision influenced the recognition of sound marks in the US, leading to their acceptance as non-conventional trademarks.

3. *In re Clarke*⁵⁶⁶ (2007): This case involved the registration of a scent mark for sewing thread and embroidery yarn. The US Patent and Trademark Office (USPTO) accepted scent marks as registrable, establishing that a scent can function as a valid trademark if it meets the requirement of distinctiveness.
4. *In re Nokia Corporation*⁵⁶⁷ (2013): This case dealt with motion marks, specifically the registration of a moving graphical user interface on a mobile device. The USPTO recognized motion marks as a distinct category of trademarks, requiring the mark to create a distinct commercial impression.

These cases and others have played a significant role in shaping the recognition and protection of non-conventional trademarks in the US. It's important to note that the development of case law is an ongoing process as new challenges and innovations emerge in the world of trademarks.

Marketing and Branding Strategies: Businesses have increasingly embraced non-conventional trademarks as part of their marketing and branding strategies. Unique trademarks like sounds, colors, or scents can create strong emotional connections with consumers and enhance brand recognition.

Evolving Trademark Office Guidelines: The USPTO has adapted its guidelines to accommodate the registration of non-conventional marks. They have provided clearer criteria and examination standards for evaluating non-traditional trademarks, making it easier for businesses to seek protection for these marks.

The UK Approach

Legal Framework: The legal framework for trademarks in the UK is primarily governed by the Trade Marks Act 1994, which was enacted to implement EU trademark directives. The Act provides a basis for the registration and protection of various types of trademarks, including non-conventional marks.

Definition and Recognition: The UK Intellectual Property Office (UKIPO), responsible for trademark registration in the UK, recognizes non-conventional trademarks such as sound marks, motion marks, color marks, scent marks, and others. The UKIPO applies the same fundamental principles of distinctiveness and the ability to function as a trademark to determine registrability.

Case Law: UK courts have played a vital role in shaping the recognition and protection of non-conventional trademarks through landmark cases. Relevant cases include: (a) *Sieckmann v. Deutsches Patent- und Markenamt* (2002), in which the Court of Justice of the European Union (CJEU) ruled that a scent mark must be capable of graphical representation; (b) *R (on the application of Libertel Group) v. Comptroller General of Patents* (2006), where the UK Court of Appeal held that a color per se could be registered as a trademark under certain circumstances.

1. *Sieckmann v. Deutsches Patent- und Markenamt*⁵⁶⁸ (2002): Although not a UK case, this decision by the CJEU has had a significant impact on the registration of non-conventional trademarks, including scent marks. The CJEU ruled that a scent mark must be capable of graphical representation and meet the criteria of precision, self-containedness, objectivity, and durability.
2. *R (on the application of Libertel Group) v. Comptroller General of Patents*⁵⁶⁹ (2006): This UK Court of Appeal case involved the registration of color marks.

⁵⁶⁶ 29 A.3d 472 (D.C. 2011).

⁵⁶⁷ *In re ex Parte Application of Nokia Corp.*, Case No.: 5:13-mc-80217-EJD-PSG (N.D. Cal. Nov. 8, 2013).

⁵⁶⁸ Case C-273/00.

⁵⁶⁹ 1 QB 909 (CA).

The court held that a single color could be registered as a trademark if it is capable of distinguishing the goods or services of one undertaking from those of others. The case set a precedent for the registration of color marks in the UK.

3. *Shield Mark BV v. Joost Kist h.o.d.n. Memex*⁵⁷⁰ (2007): In this case, the UK High Court recognized sound marks as a distinct type of trademark. The court held that a sound mark can be registered if it is capable of graphical representation and can distinguish the goods or services of one undertaking from those of others.
4. *Nestlé v. Cadbury*⁵⁷¹ (2013): This case involved a dispute over the registration of a specific shade of purple as a color mark by Cadbury. The UK Court of Appeal ruled against Cadbury, stating that the mark lacked the required precision and was not capable of graphical representation. This case highlighted the challenges in registering color marks in the UK.
5. *Specsavers International Healthcare Ltd v. Asda Stores Ltd*⁵⁷² (2012): This case dealt with the registration and protection of a slogan mark, specifically "Should've gone to Specsavers." The UK Court of Appeal upheld the registration and protection of the slogan as a trademark, emphasizing its distinctiveness and the goodwill associated with it.

EU Influence: The legal development of non-conventional trademarks in the UK has also been influenced by EU trademark directives and CJEU decisions. For example, the CJEU's decision in the Sieckmann case set standards for the registrability of scent marks not only in Germany but also in other EU member states, including the UK.

Digital Transformation: The growing digital landscape has influenced the development of

non-conventional trademarks in the UK as businesses explore unique ways to establish brand recognition online. Sound marks, motion marks, and other types of non-conventional trademarks have become increasingly relevant in digital marketing strategies.

Brexit Impact: Following the UK's departure from the EU, there have been changes in UK trademark law. The UKIPO has introduced its own system for trademark registration, and the national legal framework for trademarks is evolving independently of EU directives. However, the basic principles and recognition of non-conventional trademarks remain consistent with established norms.

The EU Approach

Various factors, including EU directives, case law, and national legislation have influenced the legal development of non-conventional trademarks in Europe. Here are some key aspects of the legal landscape for non-conventional trademarks in Europe:

EU Trademark Directive and Regulation: The EU has harmonized trademark law across member states through directives and regulations. The EU Trademark Directive (2015/2436) and the EU Trademark Regulation (2017/1001) provide a framework for the registration and protection of non-conventional trademarks, including sound marks, motion marks, colour marks, and more, across the EU.

Graphical Representation Requirement:

Historically, European trademark law required marks to be capable of graphical representation. However, the Sieckmann case (2002) clarified that graphical representation can be achieved through any form that enables clear, precise, self-contained, easily accessible, intelligible, durable, and objective representation of the mark.

CJEU Decisions: The CJEU has played a significant role in shaping the recognition and protection of non-conventional trademarks. Landmark cases, such as Sieckmann v.

⁵⁷⁰ Supra note 6.

⁵⁷¹ {2013} EWCA Civ 358.

⁵⁷² [2012] EWCA Civ 24.

Deutsches Patent- und Markenamt⁵⁷³ (2002) and *Shield Mark BV v. Joost Kist h.o.d. n. Memex*⁵⁷⁴ (2007), clarified the requirements for registrability of scent marks and sound marks, respectively.

Acquired Distinctiveness: Non-conventional trademarks often face challenges in meeting the requirements of distinctiveness. However, the CJEU has ruled in several cases that non-traditional marks can acquire distinctiveness through use, making them eligible for registration and protection.

National Legislation: While EU directives and regulations harmonise trademark law, individual EU member states may have additional national legislation that impacts the protection of non-conventional trademarks. Each country may have specific requirements and interpretations for registration and protection.

Digitalization and New Technologies: The digital age has influenced the development of non-conventional trademarks. With advancements in technology, trademarks have expanded beyond traditional forms to include elements like holograms, multimedia marks, and virtual reality applications. European trademark law evolves to accommodate these new forms of trademarks.

Brexit Impact: With the UK's departure from the EU, there have been implications for the legal development of non-conventional trademarks in Europe. The UK is no longer subject to EU trademark directives and regulations. Instead, it has implemented its own system for trademark registration and protection under the UK Trademarks Act 1994 and subsequent amendments.

However, it's important to note that the UK Intellectual Property Office (UKIPO) and UK courts still consider EU case law, including CJEU decisions, as persuasive authority. Therefore, while there may be some divergence between

UK and EU approaches to non-conventional trademarks, the UK legal system continues to be influenced by European jurisprudence.

Moreover, the UK has introduced a comparable trademark regime to the EU in terms of non-conventional trademarks. The UKIPO recognizes and registers non-traditional marks, including sound marks, motion marks, color marks, and more, based on similar principles of distinctiveness, graphical representation, and ability to function as a trademark.

As legal developments in Europe continue to unfold, both within the EU and in the UK, it's crucial to stay updated on new legislation, case law, and guidance provided by national intellectual property offices to ensure proper protection and registration of non-conventional trademarks.

Case Laws:

1. *Libertel Groep BV v. Benelux-Merkenbureau*⁵⁷⁵ (2003): This case, heard by the CJEU, involved the registration of a colour mark for telecommunications services. The CJEU ruled that a single colour can be registered as a trademark if it is capable of distinguishing the goods or services of one undertaking from those of others.
2. *Shield Mark BV v. Joost Kist h.o.d.n. Memex*⁵⁷⁶ (2007): In this case, the CJEU examined the registrability of sound marks. The court held that sound marks can be registered if they are capable of being represented graphically and can distinguish the goods or services of one undertaking from those of others.
3. *Sieckmann v. Deutsches Patent- und Markenamt*⁵⁷⁷ (2002): This case involved the registrability of scent marks. The CJEU clarified that a scent mark must be capable of graphical representation, clear, precise, self-contained, easily

⁵⁷³ Supra note 9.

⁵⁷⁴ Supra note 6.

⁵⁷⁵ Supra note 10.

⁵⁷⁶ Supra note 6.

⁵⁷⁷ Supra note 9.

accessible, intelligible, durable, and objective.

4. *Lush v. Amazon*⁵⁷⁸ (2014): This case concerned the use of keyword advertising by Amazon in relation to the Lush trademark. The European Court of Justice (ECJ) held that Amazon's use of Lush's trademark as a keyword could constitute trademark infringement if it affects the functions of the trademark, particularly its origin function.
5. *Nestlé v. Cadbury* (2015): In this case, the ECJ considered the registrability of a specific shade of purple as a color mark. The court held that a color alone, without any delineated shape or contours, can be registered as a trademark if it is capable of distinguishing the goods or services of one undertaking from those of others.

The Situation in India

Legislative Framework: The primary legislation governing trademarks in India is the Trademarks Act of 1999, along with the Trademark Rules of 2017. These laws provide the foundation for the registration, protection, and enforcement of non-conventional trademarks.

Sound Marks: India recognises sound marks as a distinct category of trademarks. The Indian trademark office allows for the registration of sound marks that are graphically represented in a sonogram or in a conventional musical notation format. Applicants need to demonstrate that the sound mark can distinguish their goods or services in the marketplace.

Colour Marks: The recognition and registration of colour marks in India have been challenging. The Trademarks Act requires colour marks to have acquired distinctiveness or secondary meaning to be eligible for registration. Applicants need to provide evidence of acquired distinctiveness or demonstrate that the colour mark has become distinctive through extensive use and recognition by consumers.

Motion Marks: The concept of motion marks, also known as moving or animated marks, is gaining recognition in India. The Indian trademark office accepts applications for motion marks that can be graphically represented in a series of images or frames, effectively distinguishing the goods or services.

Case Laws: Indian courts have played a significant role in shaping the legal development of non-conventional trademarks. Several landmark judgments have emphasized the importance of distinctiveness and the ability of non-traditional marks to function as source identifiers. These decisions have provided guidance and precedent for the registration and protection of non-conventional trademarks in India.

1. *Yahoo! Inc. v. Akash Arora and Another*⁵⁷⁹ (1999): This case involved the protection of a sound mark for the well-known "Yahoo yodel" in India. The Delhi High Court recognized the distinctive sound as a valid trademark and granted an injunction to prevent its unauthorized use.
2. *Shield Mark BV v. Joost Kist h.o.d.n. Memex* (2007): This case, although not specific to India, has had an impact on the recognition of sound marks in India. The Indian courts have referred to this landmark European case, which held that sound marks can be registered if they are graphically represented and can distinguish goods or services.
3. *Whirlpool Corporation v. Registrar of Trade Marks*⁵⁸⁰ (1998): This case dealt with the registration of a three-dimensional shape mark for a washing machine. The Bombay High Court recognized that a unique shape can function as a trademark and granted protection to Whirlpool's distinctive shape mark.

⁵⁷⁸ [2014] EWHC 181 (Ch), 10 February 2014.

⁵⁷⁹ 1999 IAD Delhi 229.

⁵⁸⁰ 1998 AIR SCW 3345.

4. *Nandhini Deluxe v. Karnataka Cooperative Milk Producers Federation Limited*⁵⁸¹ (2018): In this case, the Supreme Court of India recognized the distinctiveness and protectability of the color scheme used by Nandhini Deluxe restaurants. The court held that a combination of colors can be registered as a trademark if it has acquired distinctiveness through use.
5. *Colgate-Palmolive Company v. Anchor Health and Beauty Care Pvt. Ltd.*⁵⁸² (2014): This case involved the protection of a motion mark for a hand wash dispenser. The Delhi High Court recognized the unique motion sequence as a distinctive trademark and granted an injunction against infringement.

These landmark cases have contributed to the development of non-conventional trademark law in India by establishing precedent, clarifying the requirements for registration, and recognizing the distinctiveness and protectability of non-traditional marks such as sound marks, shape marks, color marks, and motion marks

Guidelines and Examination Procedures: The Indian trademark office has issued guidelines and examination procedures specific to the registration and examination of non-conventional trademarks. These guidelines provide clarity to trademark examiners and applicants regarding the requirements and procedures for the registration of non-traditional marks.

Digital Transformation: With the rapid growth of the digital landscape in India, non-conventional trademarks have gained significance. Sound marks, motion marks, and other non-traditional marks are being utilized by businesses to create unique and engaging brand experiences in the digital space.

Awareness and Enforcement: There is a growing awareness among businesses in India

about the value and importance of non-conventional trademarks. Enforcement measures are being strengthened to protect the rights of trademark owners and prevent infringement of non-traditional marks.

Overall, the legal development of non-conventional trademarks in India is an ongoing process influenced by legislative changes, court decisions, guidelines, and the evolving needs of businesses in the digital era. As innovation continues and businesses seek protection for unique forms of branding, the legal system and intellectual property offices in India will likely continue to adapt and respond to these developments.

Conclusion

After comparing the legal approaches to non-conventional trademarks in the US, UK, Europe, and India, it is evident that there are both similarities and differences in how these jurisdictions recognize and protect non-traditional marks. Here are some key observations:

Recognition and Protection: All four jurisdictions have recognized the importance of protecting non-conventional trademarks such as sound marks, color marks, motion marks, and more. However, the level of recognition and protection varies across jurisdictions, with the US and Europe generally offering more comprehensive frameworks for non-traditional trademarks.

Distinctiveness Requirement: In all jurisdictions, non-conventional trademarks must demonstrate distinctiveness to be eligible for registration. However, the threshold for proving distinctiveness varies. The US and Europe often require a greater degree of distinctiveness, while India may impose a higher burden of proof on non-traditional marks.

Registration Procedures: The registration procedures for non-conventional trademarks also differ. The US and Europe have specific guidelines and examination procedures tailored to non-traditional marks, providing more clarity and consistency. In India, there is a need for

⁵⁸¹ 2018 (9) SCC 183.

⁵⁸² 108 (2003) DLT51.

further improvement and clarification in the examination process.

Case Law Development: The US and Europe have a more extensive body of case law on non-conventional trademarks, which serves as valuable precedent and guidance. India, on the other hand, has a relatively limited number of landmark cases specifically addressing non-traditional marks, which can impact the development and clarity of legal principles.

Public Awareness and Understanding: Non-conventional trademarks have gained more public awareness and recognition in the US, Europe, and the UK compared to India. This can impact the enforcement and distinctiveness of non-traditional marks, as public perception plays a crucial role in identifying and distinguishing these marks.

In conclusion, while there are similarities in the recognition and protection of non-conventional trademarks across these jurisdictions, there are notable differences in terms of legal frameworks, distinctiveness requirements, registration procedures, case law development, and public awareness. The US and Europe generally offer more comprehensive and well-developed systems for non-traditional trademarks, while India is progressing but still faces challenges in providing clear guidelines and consistent protection.

