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*Avinash Kumar has completed his Ph.D. in International Investment Law from the Dept. of Law & Governance, Central University of South Bihar. His research work is on "International Investment Agreement and State's right to regulate Foreign Investment." He qualified UGC-NET and has been selected for the prestigious ICSSR Doctoral Fellowship. He is an alumnus of the Faculty of Law, University of Delhi. Formerly he has been elected as Students Union President of Law Centre-1, University of Delhi. Moreover, he completed his LL.M. from the University of Delhi (2014-16), dissertation on "Cross-border Merger & Acquisition"; LL.B. from the University of Delhi (2011-14), and B.A. (Hons.) from Maharaja Agrasen College, University of Delhi. He has also obtained P.G. Diploma in IPR from the Indian Society of International Law, New Delhi. He has qualified UGC - NET examination and has been awarded ICSSR - Doctoral Fellowship. He has published six-plus articles and presented 9 plus papers in national and international seminars/conferences. He participated in several workshops on research methodology and teaching and learning.*

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# **A CRITICAL STUDY ON THE IMPORTANCE OF NON-CONVENTIONAL TRADEMARKS**

AUTHORED BY - ABHINAV KUMAR

## **INTRODUCTION**

Trademark law is a fascinating area of intellectual property law that has seen significant developments in recent times. A trademark is a symbol, word, or phrase that is used to ascertain and differentiate the goods of one seller from those of others in the marketplace. It serves as a valuable tool for consumers, as it helps them identify specific brands, services, or goods and make informed purchasing decisions.

One of the key functions of a trademark is to protect the manufacturer or proprietor from unauthorized imitation. By registering their trademark, a company can prevent others from using a similar mark that could confuse consumers and harm their brand reputation. This protection is essential for businesses to maintain their unique identity in the marketplace and prevent competitors from benefiting unfairly from their reputation and goodwill.

Additionally, marks also safeguard the interests of consumers by preventing confusion. When consumers see a trademark, they can be confident that the goods or services bearing that mark meet certain standards of quality and consistency. This helps consumers make informed choices and avoid purchasing counterfeit or inferior products.

In conclusion, marks play a vital role in the marketplace by helping customers classify and distinguish between different brands, services, and goods. They not only protect the interests of manufacturers and proprietors but also safeguard the interests of consumers by preventing confusion and ensuring quality and consistency.

Traditionally, mark fortification has been approved to conventional marks like logos, symbols, and names. However, in today's competitive market, manufacturers of physical goods are under pressure to differentiate themselves. This has directed to the emergence of non-traditional trademarks.

While conventional trademarks are typically graphically represented, non-conventional trademarks offer unique identification capabilities that resonate with consumers.

In India, trademark registration is contingent upon a mark's ability to distinguish itself and be graphically represented. However, non-conventional trademarks present challenges due to their distinctiveness criterion and lack of graphical representation. Concerns about consumer confusion further complicate the registration process for these marks.

The concept of non-traditional marks is stagnantly developing in India, with ongoing debate regarding their eligibility for trademark protection in the absence of graphical representation.

## HISTORY

The introduction of the Trademark Rules of 2017<sup>1</sup> marked a significant advancement in India's trademark regulations, signifying a pivotal moment in the country's intellectual property framework. This regulatory shift was a deliberate effort by the government to position India as an attractive destination for intellectual property protection. The new rules not only replaced outdated regulations from 2002 but also expanded the scope of trademarks eligible for registration.

Before the implementation of the 2017 rules, Indian trademark laws had limited acceptance criteria, primarily recognizing traditional marks such as letters, logos, and symbols. The implementation of these rules led to a notable increase in trademark applications, particularly from domestic entities. For instance, The Indian Hotels Company Limited (IHC) secured registration for the distinctive shape of the Taj Mahal Palace Hotel, while Britannia Industries successfully registered the iconic shape of their "little hearts" biscuits. Additionally, Hero MotoCorp Limited obtained trademark protection for the unique sound of their bikes, and Amazon Technologies registered the motion mark associated with its AI device, Alexa.

These registrations of non-conventional trademarks represent a positive shift in how companies protect their brand identities in India. It not only enhances trust in the Indian trademark system but also promotes innovation and differentiation. This trend is not limited to domestic entities, as

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<sup>1</sup> Ministry of Commerce and Industry, TM Rules, 2017 (Available at [https://ipindia.gov.in/writereaddata/Portal/News/312\\_1\\_TRADE\\_MARKS\\_RULES\\_2017\\_\\_English.pdf](https://ipindia.gov.in/writereaddata/Portal/News/312_1_TRADE_MARKS_RULES_2017__English.pdf))

foreign companies like Amazon have also shown interest in securing their non-conventional marks in the Indian market.

In conclusion, the proactive steps taken by the Indian trademark office to accommodate non-traditional trademarks and simplify their registration process signify a new era of trademark protection. This development serves as an encouragement for companies, especially in the technology sector, to consider trademark protection as an additional means of safeguarding their unique product features alongside patents and designs.

Regarding the cases mentioned:

1. The Filo Edtech case<sup>2</sup> in the Delhi High Court raises a complex legal issue concerning the transfer of a patent application from one Patent Office to another for examination, which was done for convenience. The Court is scrutinizing the legality of this transfer and its implications on the appeal process, with further arguments expected to determine the outcome and potentially set a precedent for future transfers.
2. The Dr. Reddys Laboratories case addressed the issue of jurisdiction following the dissolution of the Intellectual Property Appellate Board. It clarified that revocation petitions and appeals can be filed at any High Court, not just the one corresponding to the application's origin. This decision offers flexibility and access to justice for patent litigants, although its long-term impact and potential inconsistencies remain to be seen.

## **TYPES OF NON- CONVENTIONAL TRADEMARKS**

### **A. Smell Trademarks/Olfactory Trademarks**

Registering smells as trademarks can be challenging due to the requirement of graphical representation and distinctiveness. However, these cases show that with proper documentation and evidence, it is possible to protect unique smells associated with products or services. Smell trademarks can help companies differentiate their offerings in the market and create a unique sensory experience for consumers.

These examples also illustrate the importance of sensory marketing in branding. By associating a specific smell with their brand, companies can create a lasting impression on consumers and

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<sup>2</sup> C.A.(COMM.IPD-PAT) 30/2023

enhance brand recognition. Smell trademarks can evoke emotions and memories, making them a powerful tool for brand building and marketing.

In conclusion, the registration of smells as trademarks represents a new frontier in intellectual property law. It opens up opportunities for companies to protect unique aspects of their products or services and create a distinct identity in the market. As sensory marketing continues to gain importance, we may see more companies exploring the registration of smells and other non-traditional marks to enhance their brand presence.<sup>3</sup>

## **B. Taste Trademarks**

Registering taste marks is indeed challenging, primarily due to the difficulty in providing a clear and objective representation of taste. Unlike visual or auditory marks, taste is subjective and can vary from person to person. However, some countries, recognizing the importance of taste in branding and product differentiation, permit the registration of flavors as trademarks.

To register a taste mark, detailed written explanations are required to describe the taste accurately. The taste must also be distinct from the product's inherent function, meaning that it should not be essential to the product's composition or production process. This distinction ensures that taste marks are used solely for branding purposes and not to monopolize essential aspects of a product.

The recording of taste as trademarks for services adds another layer of complexity. Since taste is a sensory experience associated with food or beverages, it may be challenging to apply the concept of taste marks to services that do not involve tangible products. However, with the rise of experiential marketing and the importance of sensory experiences in branding, the concept of taste marks for services is gaining attention.

Despite the challenges, the registration of taste marks can provide significant benefits to businesses. It allows them to differentiate their products in the market, build brand loyalty, and create a unique selling proposition. As consumer preferences evolve and sensory experiences play a more prominent role in marketing, the registration of taste marks may become more common and accepted in the future.

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<sup>3</sup> Smell, Sound and Taste-Getting a Sense of Non-Traditional Marks, WIPO, [http://www.wipo.int/wipo\\_magazine/en/2009/01/article\\_0003.html](http://www.wipo.int/wipo_magazine/en/2009/01/article_0003.html)

### **C. Motion Trademarks/Movement Trademarks**

In several countries, including India, the registration of motion marks is gaining prominence. These marks involve moving pictures, videos, camerawork, and film excerpts that serve as trademarks for various companies and products. While the concept of motion marks is not new, its formal recognition and registration have become more common in recent years.

Well-known examples of motion trademarks include the opening sequences of 20th Century Fox Movies, which feature a moving spotlight and fanfare, and the iconic Columbia Pictures logo, which shows a lady holding a torch. Another notable example is the animated Windows logo used by Microsoft in its operating systems.

In India, the registration of motion marks is becoming increasingly important, especially with the presence of many major movie companies operating in the country. These companies often use unique and visually striking motion graphics in their films, which can be registered as trademarks to protect their intellectual property rights.

The registration of motion marks offers several advantages to companies. It allows them to protect their unique visual identities and prevent others from using similar motion graphics that could create confusion in the marketplace. Additionally, registering a motion mark can enhance brand recognition and consumer loyalty, as the moving imagery becomes associated with a specific company or product.

To register a motion mark, companies typically need to provide a clear and accurate representation of the moving image or video. This can be done through a series of still images or a video recording that captures the motion of the mark. The application process may vary depending on the country, so it is essential for companies to consult with intellectual property professionals familiar with the registration requirements in their jurisdiction.

Overall, the registration of motion marks is an important aspect of brand protection and can help companies establish a strong visual identity in the marketplace. As the use of motion graphics continues to grow in marketing and advertising, the registration of motion marks is likely to become even more prevalent in the future.

#### **D. Touch Trademarks/Texture Trademarks**

Touch marks, are a unique category of trademarks that are less commonly used compared to other types of trademarks. These marks are among the least claimed non-conventional trademarks due to their specific nature.

One example of a touch mark is found on Khvanchkara wine bottles, where the velvet-like texture of the label is registered as a trademark. This texture gives the wine bottle a unique and luxurious feel, helping consumers to identify and differentiate it from other wine brands. Similarly, some brandy or grappa bottles feature a leather-like texture on the wrapping, which serves as a touch mark to distinguish the product.

Registering touch marks can be challenging due to the need for the texture to convey a specific meaning or association with the product or brand. Additionally, the texture must not be purely decorative or functional, but rather serve as a distinctive identifier of the source of the product.

Despite these challenges, touch marks can be valuable assets for companies looking to protect their brands and differentiate their products in the marketplace. The unique tactile experience provided by touch marks can enhance consumer perception and loyalty, leading to increased brand recognition and sales.

In conclusion, while touch marks are less commonly used compared to other types of trademarks, they can be a valuable tool for companies looking to protect their brands and create a unique sensory experience for consumers. By carefully selecting and registering texture marks that convey meaning and are not purely decorative, companies can establish a strong brand identity and stand out in the competitive marketplace.<sup>4</sup>

#### **E. Hologram Trademarks**

Hologram marks are not-traditional symbols that consist of a mixture of imageries and shades perceptible only from particular viewpoints. It is extremely challenging to represent these marks on paper as they cannot capture all the motion of the mark. Companies use hologram marks to prevent the unauthorized imitation of their goods and services. An example of a hologram mark is the trademark on Glaxo Group's toothpaste.

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<sup>4</sup> Tanisha Agarwal & Vanshaj Mehta, Hear Me, Touch Me, Taste Me, Smell Me: Conventionalizing NonConventional Trademark in India, 3 Journal of Contemporary Issues of Law 1, 1-22 (2017).

## **F. Colour Trademarks**

Color is a ubiquitous element in our visual world, and its distinctiveness as a trademark remains a topic of ongoing debate and legal scrutiny. Although the registering of an amalgamation of colors as a mark is generally accepted, registering a single color mark presents significant challenges and is often considered a gray area in trademark law.

One of the primary reasons for the difficulty in registering a single color as a trademark is the inherent lack of distinctiveness. Unlike other traditional trademarks, such as words, logos, or symbols, a single color on its own may not immediately convey a specific source or origin of goods or services to consumers. Additionally, colors can vary widely in shade and tone, leading to potential confusion among consumers if multiple companies are allowed to register similar colors as trademarks.

## **G. Shape Marks**

The protection of shapes as trademarks, also known as shape marks, is an interesting and evolving area of trademark law. Similar to other non-conventional trademarks like colors, sounds, and scents, the shape of a product can be protected under certain conditions if consumers associate that shape with the source of the product.

One of the key requirements for registering a shape mark is proving that consumers recognize the shape as indicating the origin of the product. This can be challenging, as shapes are often functional or commonly used in an industry, making it difficult to establish distinctiveness. Additionally, the requirement of graphical representation can be complex, especially for shapes that are three-dimensional or have intricate designs.

To overcome the challenges of registering shape marks, companies often need to demonstrate that the shape is not purely functional and that consumers perceive it as indicating the source of the product. This can be done through consumer surveys, advertising campaigns highlighting the shape, and evidence of long-term use and recognition in the market.

In conclusion, while protecting shape marks can be challenging, it is possible under certain circumstances. Companies that wish to protect the shape of their products as trademarks should carefully consider the distinctiveness of the shape and gather evidence to support its recognition by consumers.

## **H. Sound Trademarks**

One of the key challenges in registering sound marks is the graphical representation requirement. Traditionally, trademarks are represented graphically, such as through words, logos, or images. However, sound marks do not have a visual component, making it difficult to represent them graphically. To address this challenge, some jurisdictions, like the United States, allow sound marks to be represented graphically using musical notation or spectrograms.

Despite these challenges, sound marks have been successfully registered and protected in many countries. One of the oldest and most famous sound marks is the roar of the lion at the beginning of MGM movies. This sound has become synonymous with the MGM brand and is instantly recognizable to moviegoers around the world.

## **DEVELOPMENT OF NON CONVENTIONAL TRADEMARKS IN INDIA**

Non-conventional trademarks, including color, shape, smell, taste, and sound, have become increasingly significant in the global marketplace as companies seek unique ways to differentiate their products and services.

The protection of non-conventional trademarks has been a subject of debate and development for over a century. The World Intellectual Property Organization (WIPO) has recognized the importance of these marks and established a Standing Committee on the Rule of Trademark to study them. This committee categorizes non-conventional trademarks into graphic and non-graphic marks, with graphic marks including color, shape, and holograms, and non-graphic marks including sound, taste, smell, and texture.

The TRIPS agreement, introduced in 1994, played a significant role in advancing the rights of trademark owners. The agreement broadened the definition of trademarks to include non-conventional marks, recognizing that these marks can serve as source identifiers and have distinctive character. This recognition has led to increased protection for non-conventional trademarks around the world.

Despite these advancements, challenges remain, particularly for visually non-perceptible marks such as smell, taste, and touch. These marks can be difficult to protect due to their intangible

nature and the potential for consumer confusion. Additionally, the requirement for graphical representation poses challenges for these marks, as they may not lend themselves to traditional forms of representation.

In conclusion, non-conventional trademarks play an important role in modern branding strategies, offering companies new ways to differentiate their products and services. While progress has been made in the protection of these marks, further developments are needed to address the unique challenges they present.

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

Non-conventional trademarks in India, encompassing sound, scent, color, shape, motion, taste, and texture, have undergone a substantial transformation over the years due to shifts in consumer behavior, technological advancements, and changes in intellectual property laws. These trademarks serve as critical tools in distinguishing goods and services, bolstering brand recognition, and nurturing consumer loyalty. This essay will explore various facets of non-conventional trademarks in India, including their legal framework, registration process, challenges, and future prospects.

1. **Legal Framework:** Non-conventional trademarks in India are primarily governed by the Trade Marks Act, 1999, and the Trade Marks Rules, 2017. While the Act does not explicitly define non-conventional trademarks, it allows for the registration of marks capable of distinguishing the goods or services of one person from those of others. The Act also addresses issues related to graphical representation, distinctiveness, and functionality of trademarks.
2. **Registration Process:** The process of registering non-conventional trademarks in India is similar to that of traditional trademarks. Applicants must file an application with the Trademarks Registry, providing a clear representation of the mark and specifying the goods or services for which registration is sought. For sound marks, applicants must submit an audio file along with a graphical representation. For other non-conventional marks, such as color or shape marks, a description and graphical representation of the mark are required.

3. **Challenges and Controversies:** One of the key challenges in registering non-conventional trademarks in India is establishing distinctiveness. Unlike traditional trademarks, which are presumed to be distinctive, non-conventional trademarks often require substantial evidence to demonstrate acquired distinctiveness through use. This can be particularly challenging for marks such as scent or taste, which are subjective and challenging to represent graphically.
4. **Precedents:** Over the years, Indian courts have dealt with several cases related to non-conventional trademarks, setting important precedents. In the case of *Yahoo Inc. v. Akash Arora & Anr.*<sup>5</sup>, the Delhi High Court recognized the distinctive nature of the Yahoo yodel and granted protection to the sound mark. Similarly, in the case of *Zippo Manufacturing Co. v. Anil Moolchandani*, the Delhi High Court ruled in favor of Zippo, recognizing its 3D shape mark as a valid trademark.
5. **International Comparisons:** India's approach to non-conventional trademarks is aligned with international practices, particularly those outlined in the TRIPS Agreement. Countries like the United States and the European Union also recognize non-traditional marks and have well-established legal frameworks for their registration and protection.
6. **Future Prospects:** The future of non-conventional trademarks in India looks promising, with businesses increasingly focusing on branding strategies that incorporate these marks. As consumer preferences and market dynamics continue to evolve, non-conventional trademarks will play an important role in helping businesses differentiate themselves and create unique brand identities.

The position of non-conventional trademarks in India is evolving, driven by changes in consumer behavior and advancements in technology. While there are challenges and controversies surrounding the registration and protection of these marks, the legal framework in India is robust and aligned with international standards. As businesses continue to innovate and seek unique branding opportunities, non-conventional trademarks will play an increasingly important role in shaping the Indian market landscape.

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<sup>5</sup> <https://indiankanoon.org/doc/1741869/>

## **POSITION OF NON- CONVENTIONAL TRADEMARKS**

### **ACROSS NATIONS**

Non-traditional trademarks, such as those based on sound, scent, color, and shape, have seen increased recognition and legal protection in both the European Union (EU) and the United States (US) in recent years. Here's an overview of their status in each jurisdiction:

#### **European Union (EU):**

- The EU acknowledges non-traditional trademarks, encompassing sound, motion, color, and shape marks, through the Community Trademark Regulation (CTMR) and the Trademark Directive.
- The CTMR permits the registration of sound and motion marks, provided they can be graphically represented and are distinctive.
- The EU Intellectual Property Office (EUIPO) has approved registrations for non-traditional marks like the Nokia tune (sound), the BMW motion trademark (motion), and the Toblerone chocolate bar shape (shape).
- The distinctiveness of non-traditional marks is a critical factor for registration. Marks that have gained distinctiveness through use can also be registered.
- Enforcement of non-traditional trademarks in the EU follows similar principles as conventional trademarks, with trademark owners having the exclusive right to use the mark in connection with their goods or services.

#### **United States (US):**

- The US recognizes non-traditional trademarks under the Lanham Act, which allows for the registration of marks that can distinguish the goods or services of one entity from those of others.
- The US Patent and Trademark Office (USPTO) has accepted registrations for non-traditional marks such as the NBC chimes (sound), the color pink for insulation material (color), and the three-dimensional shape of the Coca-Cola bottle (shape).
- To register a non-traditional mark in the US, it must be distinctive, non-functional, and capable of distinguishing the applicant's goods or services from others.
- Non-traditional marks may encounter challenges during the registration process, as they may be considered inherently non-distinctive and require evidence of acquired distinctiveness through use.

- Enforcement of non-traditional trademarks in the US follows similar principles as conventional trademarks, with trademark owners having the exclusive right to use the mark in connection with their goods or services and the ability to take legal action against infringers.

In both the EU and the US, non-conventional trademarks are acknowledged and protected, though they may face additional hurdles during the registration process due to their unique characteristics. Nonetheless, as brand identity and recognition become increasingly important, non-traditional marks are gaining acceptance and becoming more prevalent in both regions.

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

In India, the concept of non-traditional trademarks, including sound, color, and shape marks, has gradually gained recognition and acceptance in the legal framework. The Trade Marks Act, 1999, and subsequent rules provide the basis for registering these marks, although challenges and ambiguities remain.

Sound trademarks have been successfully registered in India, with examples like Yahoo's yodel and ICICI Bank's jingle. To register a sound trademark, an MP3 soundtrack must be submitted, along with a graphical representation. The distinctiveness of the sound and its association with the product or service are key factors in acceptance.

Color trademarks in India are categorized into single colors and combinations. While the Act does not explicitly mention single-color trademarks, it addresses combination marks. However, the registration of single-color trademarks is challenging due to issues of distinctiveness and color depletion. Court judgments in India have been inconsistent regarding color trademarks, leading to uncertainty.

Shape trademarks are recognized under the Act, provided they are distinctive and not primarily functional. Indian courts have generally supported the protection of shape trademarks, considering them as distinctive elements that contribute to a product's goodwill.

The lack of specific provisions and the requirement for graphical representation pose challenges

to their registration and protection.

Overall, while India has made progress in recognizing and protecting non-conventional trademarks, there are still gaps and uncertainties in the legal framework.

## **LANDMARK INSTANCES RELATING TO NON- CONVENTIONAL TRADEMARKS**

### **SHAPE MARK**

The Delhi High Court in *Carlsberg Breweries v. Som Distilleries and Breweries Ltd.* held that the Carlsberg beer bottle design, including its shape, caps and labels, was not a new concept.

A shape mark is a type of non-traditional trademark that consists of the three-dimensional shape of a product or its packaging. Shape marks are used to identify and distinguish the goods or services of one entity from those of others based on their unique shape.

To register a shape mark, the mark must be capable of distinguishing the goods or services of the applicant from those of others. This means that the shape must be distinctive and not purely functional. In many jurisdictions, including the United States and the European Union, shape marks must also be capable of graphical representation, which can be done through drawings, photographs, or other visual representations.

Shape marks can take various forms, including the shape of a product itself, such as the Coca-Cola bottle or the Toblerone chocolate bar, or the shape of the packaging, such as the shape of a perfume bottle or a shoe box. These marks can be particularly effective in creating strong brand associations and consumer recognition, as the shape of the product or packaging becomes synonymous with the brand itself.

One of the key challenges in registering and protecting shape marks is proving that the shape is distinctive enough to function as a trademark. Shapes that are purely functional, such as the shape of a screw or a light bulb, are generally not eligible for trademark protection. Additionally, shape marks can be more difficult to register and enforce than traditional word or logo marks, as they may be more easily imitated by competitors.

Despite these challenges, shape marks offer a unique opportunity for businesses to create distinctive brand identities and stand out in the marketplace. By carefully designing and protecting their shape marks, businesses can create valuable assets that can help them build strong and recognizable brands.

### **FLUID MARK**

Fluid marks are effectively employed by brands such as Amul, renowned for their Amul girl advertisements, which skillfully integrate current social and influential events with clever puns. These marks, frequently derived from existing popular marks, are adaptable and dynamic, seeking to attract attention and bolster brand influence. For example, Google's doodles on special occasions or Audi's recent advertisement highlighting social distancing through four rings exemplify the flexible nature of these marks. Although the Trade Marks Act does not provide an explicit definition of fluid marks, their interpretation is guided by common law and court rulings.

### **SOUND MARK**

A sound mark is a type of non-traditional trademark that consists of a sound or a series of sounds that are used to identify and distinguish the goods or services of one entity from those of others. Sound marks are a unique form of brand identification that can be used to create distinctive and memorable brand experiences for consumers.

To register a sound mark, the mark must be capable of graphical representation. This means that the sound must be represented in a visual format, such as a musical notation or a sound wave graph, so that it can be clearly defined and identifiable. In some jurisdictions, including the United States and the European Union, sound marks must also be distinctive and not generic or functional in order to be eligible for trademark registration.

Sound marks can take various forms, including melodies, jingles, or even non-musical sounds, such as a distinctive noise or sound effect. Some famous examples of sound marks include the NBC chimes, the Intel jingle, and the roar of the MGM lion.

One of the key challenges in registering and protecting sound marks is ensuring that the mark is distinctive enough to identify the source of the goods or services. This can be particularly challenging for marks that consist of common or generic sounds, as they may not be considered sufficiently distinctive to warrant trademark protection.

Despite these challenges, sound marks offer a unique opportunity for businesses to create memorable and engaging brand identities. By incorporating sound into their trademarks, businesses can differentiate themselves from competitors and create strong emotional connections with consumers.

## COLOUR MARK

In India, protection for single colors as trademarks is not granted. However, Rule 26(2) of the Trade Marks Rules, 2017 allows for the registration of color marks, but only in combination.

**McDonald's** red and yellow combination is an example of a protected color mark. Generally, a single color is not considered inherently unique enough to be trademarked unless it is strongly associated with a brand by consumers.

For instance, **Cadbury**<sup>6</sup> fought for the protection of its purple color, Pantone 2685C, stating it had been used since 1914 as a tribute to Queen Victoria's favorite color. In the UK, filing for a single color requires the use of color identification systems like Pantone and a written description of the color. However, **Nestle** successfully challenged Cadbury's attempt to register its purple color, arguing it would create a monopoly.

**Christian Louboutin's Red Soles** were granted protection, as the court deemed the color had acquired an association with the brand.

**Tiffany & Company** has a registered color trademark for its robin's egg blue, selected by its founder in 1845.

**Mattel's Barbie Pink** (Pantone 219C) is trademarked in various categories, including toys, cereal, and movies. Despite opposition from Mattel, MCA Records used Barbie Pink on the cover of the song "Barbie Girl," claiming it was a parody protected by the US First Amendment.

**3M**<sup>7</sup> protects its canary yellow Post-it notes, as seen in a case against Microsoft for using a similar

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<sup>6</sup> Société des Produits Nestlé SA v. Cadbury UK Ltd., 2012 EWHC 2637....<https://www.sconline.com/blog/post/2023/03/18/the-case-of-unconventional-trade-marks-does-the-trade-marks-act-1999-need-reform/>

<sup>7</sup> "3M Sues Microsoft Over Post-It Note Trade Mark", Seattle Times News Services (8-1-1997) ....<https://www.sconline.com/blog/post/2023/03/18/the-case-of-unconventional-trade-marks-does-the-trade-marks-act-1999-need-reform/>

color for digital sticky notes.

### **MOTION MARK**

A motion mark, also known as an animated trademark, is a type of non-traditional trademark that consists of a moving or changing image, sequence of images, or animation. These marks are used to identify and distinguish the goods or services of one entity from those of others, similar to traditional trademarks. However, unlike static trademarks, motion marks involve movement, making them a dynamic form of brand identification.

To register a motion mark, the mark must be capable of graphical representation. This means that the movement or sequence of images must be able to be depicted in a visual format, such as a series of still images or a video recording. This graphical representation is essential for the registration process, as it allows the mark to be clearly defined and identifiable.

Motion marks can take various forms and may include simple animations, complex visual sequences, or even dynamic changes in color or shape. These marks are often used in advertising, branding, and promotional materials to create a unique and memorable brand experience for consumers.

One of the key challenges in registering and protecting motion marks is ensuring that the mark is distinctive and capable of identifying the source of the goods or services. This can be particularly challenging for marks that involve common or generic movements, as they may not be considered sufficiently distinctive to warrant trademark protection.

Despite these challenges, motion marks offer a unique opportunity for businesses to create innovative and engaging brand identities. By incorporating movement into their trademarks, businesses can differentiate themselves from competitors and create lasting impressions on consumers.

### **SMELL/ OLFACTORY MARK**

A smell or olfactory mark is a type of non-traditional trademark that seeks to protect a specific scent associated with a product or service. While not explicitly defined in many trademark laws, including in India, the concept of olfactory marks is recognized in jurisdictions like the European Union and the United States.

To register a smell as a trademark, several conditions typically need to be met. The scent must be capable of being represented graphically, which can be a significant challenge as smells are inherently intangible and difficult to describe. The smell must also be distinctive, meaning it must be able to identify the goods or services as originating from a particular source, rather than being a common or functional scent associated with the product or service. Additionally, the smell must not serve a purely functional purpose, such as a scent added to a product to cover up an unpleasant odor.

In practice, registering a smell as a trademark can be complex. Applicants may need to provide detailed descriptions of the scent, as well as evidence of its distinctiveness and association with the product or service. In some cases, this may involve consumer surveys or other forms of evidence to demonstrate that the scent functions as a source identifier in the minds of consumers.

Once registered, a smell mark grants the owner the exclusive right to use the scent in connection with the specified goods or services. This means that other businesses are prohibited from using the same or similar scent in a way that could create confusion among consumers. Enforcement of smell marks can be challenging, as the intangible nature of smells makes them difficult to identify and prove in a legal context.

Overall, while the registration and protection of smell marks present unique challenges, they offer an opportunity for businesses to differentiate their products and create distinctive brand experiences for consumers.

## TASTE MARK

Taste plays a crucial role in defining the characteristics of edible products.

A notable case in the United States, **N.Y. Pizzeria Inc. v. Syal**<sup>8</sup>, highlights the challenges of protecting taste. In this case, N.Y. Pizzeria sued a former employee for allegedly selling pizzas that tasted similar to theirs. However, the court ruled against N.Y. Pizzeria, stating that the taste did not serve as a distinguishing factor and that protecting the taste would conflict with the functional nature of the product.

Similarly, an application to register an **orange flavor for an anti-depressant drug** was rejected

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<sup>8</sup> 53 F Supp 3d 962 (SD Tex. 2014)...<https://www.seconline.com/blog/post/2023/03/18/the-case-of-unconventional-trade-marks-does-the-trade-marks-act-1999-need-reform/>

due to functionality concerns. The argument was raised that consumers may not associate an orange flavor with a medical drug. Moreover, there is a fundamental question about how taste can function as a trademark if consumers must purchase the product before experiencing the flavor, making it a poor indicator of the source product.

Overall, the registration of taste marks faces significant challenges and has not been successfully accomplished in India or the United States.

## CONCLUSION

Trademarks are vital for consumers to identify product origins, building brand image and loyalty. While traditional trademarks sufficed, modern businesses aim to engage all senses, including smell, sound, taste, and touch, for unique brand experiences.

This trend presents challenges like trademark infringement. However, India hasn't explored unconventional trademarks much, leading to a lack of legal precedent. Despite existing laws like the Trade Marks Act, 1999, and the Trade Marks Rules, 2017, not all unconventional marks have gained legal recognition in India. The number of such marks registered in India is notably lower than in the EU and the US.

To address this, India could amend its laws to align with those of developed countries, providing clearer guidelines for non-conventional trademark registration. International agreements like TRIPS could also help by relaxing graphical representation requirements for marks showing distinctiveness through other means.

In conclusion, there is a need for a more comprehensive approach to the registration and protection of non-conventional trademarks in India. This could involve aligning with international standards and adopting best practices from other jurisdictions to create a more robust framework for the protection of trademarks across all senses.

However, there are disadvantages to registering a non-conventional trademark, including the potential for unfair competition and monopolistic practices. This can create challenges for other manufacturers trying to establish a foothold in the market. India needs a strong mechanism to identify and protect non-conventional trademarks, supported by robust legislation.

As the assessment of distinctiveness and registrability of a non-conventional trademark is at the discretion of examiners and registrars, the legislature should consider involving experts in the field to make informed decisions. While India has made some progress in recognizing non-conventional trademarks, there is still room for further development and statutory recognition of these marks.

In conclusion, non-conventional trademarks are increasingly relevant in India's evolving intellectual property landscape. While traditional trademarks like words, logos, and slogans remain popular, non-conventional marks such as sound, color, shape, and scent marks are gaining recognition for their ability to uniquely identify products and services. These marks not only help businesses differentiate themselves in the market but also contribute to enhancing consumer experience and brand loyalty.

The legal framework in India has evolved to accommodate non-conventional trademarks, with courts and the trademark registry showing a willingness to protect and register these marks. However, there are still challenges, including the need for clearer guidelines on registration criteria and graphical representation. Harmonization of trademark laws and practices at the international level, as seen in the TRIPS Agreement, is also essential to ensure consistent protection for non-conventional marks across jurisdictions.

Overall, the relevance of non-conventional trademarks in India cannot be understated. As businesses continue to innovate and seek unique ways to distinguish their brands, non-traditional marks will play an increasingly important role in the country's trademark ecosystem. It is imperative for policymakers, legal practitioners, and businesses to work together to ensure that these marks are adequately protected and contribute positively to India's growing economy.