NON-CONVENTIONAL MARKS

Introduction

What is the first scene that comes up when a Tom & Jerry episode is about to begin? The Lion’s Roar. What is the basic difference between Pepsi and Coke? The taste and shape of the bottle. The moment you enter Starbucks what pleases one the most? The ambience and the smell of coffee.

Traditionally, trademarks are limited to words, logos or symbols that can be represented graphically in relation to any goods or services. The definition of a trademark under the Trade Marks Act, 1999 as per Section 2(zb) is “trade mark means a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others and may include shape of goods, their packaging and combination of colours.” However, with the passage of time, not only logos, symbols or taglines are being associated to goods and services but also sound, taste, smell, texture, hologram, motion, shape and the ambience of the goods or services. Thus when a mark goes beyond the realms of the traditional conventional category of being judged solely by the eye it is known as Non-Conventional Mark.

The Indian legislation has no specific provisions for Non-Conventional Marks except for the mention of sound marks. Under Rule 26(5) of the Trade Marks Rules, 2017 “when the application has been made for a Sound Trade mark, it shall be reproduced in MP3 Format not exceeding a length of 30 seconds, recorded on a medium that allows for easy and clearly audible replaying quality along with a graphical representation of its notation.” However, it is interesting to note that TRIPS too does not have provisions for Non-Conventional Marks. Article 15 of TRIPS states that “Such signs, in particular words including personal names, letters, numerals, figurative elements and combinations of colours as well as any combination of such signs, shall be eligible for registration as trademarks.” Thus from Article 15 it is clear that only those signs which are capable of representation are considered as trade marks.

Types of Non-Conventional Marks:

Sound Marks

Sounds have a big impact on how consumers perceive a brand. With the growth of e-media, sounds play a big role in identifying a product or service thus adding value to the brand. A sound mark is a mark where the sound is used to perform the function of uniquely identifying the commercial origin of products and services. Sound marks function as source indicators when they assume a definitive shape and arrangement and create in the minds of the listener an association of the sound with a good or service.1 Yahoo’s Yodel is the first sound trademark to be registered in India.2 Some of the famous sound marks registered in USA are the sound of the famous Tarzan yell, the lion roar of Metro-Goldwyn-Mayer Corporation, the

1 TMEP §1202.15
2 Yahoo! Yodel https://www.youtube.com/watch?v=iC1a8xXQQDo
music consisting of drums, trumpets and strings in the Twentieth Century Fox Films, the sound of the crowd and the bell of New York Stock Exchange, McDonald’s Corporation's five-note "I'm lovin' it" jingle.

The first sound mark to be granted registration by the Trademark Registry was the Yahoo! Yodel in the year 2008. After that no such marks have come before the registry for registration.

**Smell Marks**
When the source identifier of goods is a smell, then it is termed as Smell Mark. Smell Marks are a lot tougher than sound marks to be registered because they lack any form of representation. While sound marks can be presented in a MP3 format, smell marks lack any such characteristics. One of the serious problems with regards to smell marks is the representation in a visual way. Writing down the chemical formula for a smell as it is deemed to represent the substance rather than the smell. Another problem is that the storage with the registry. If the registry is provided with the sample of the smell, then how long will it be durable without its smell evaporating over time is a question regarding smell marks. One of the basic criteria for registering a smell mark is that it should describe the product it has been applied for. For example, the smell of a perfume cannot be trademarked as it would be describing the goods that is the perfume. Some of the examples of smell marks that are registered by the USPTO are bubble gum scent for sandals, toothbrush with the smell of strawberry, lubricants for combustion engines with the smell of strawberry, cherry and grape. In India, no smell marks have been registered till date. The UK's first smell trademark was granted to Japan's Sumitomo Rubber Co. in 1996 for fragrance of roses applied to tyres. The mark was later transferred to Dunlop Tyres. The same year, Unicorn Products, a London-based maker of sports equipment, registered a UK trade mark for the strong smell of bitter beer to be applied to darts.

In India, no smell mark has been registered till date before the registry.

**Hologram Mark**
Holography is a photographic technique that records the light scattered from an object, and then presents it in a way that appears three-dimensional. A hologram is a cross between what happens when you take a photograph and what happens when you look at something for real. Like a photograph, a hologram is a permanent record of the light reflected off an object. But a hologram also looks real and three-dimensional and moves as you look around it, just like a real object. That happens because of the unique way in which holograms are made. The major difficulty with regards to Hologram marks is its difficulty to prove as the source identifier of the product. American Express owns a trademark registration in USA for a hologram that is applied on the surface of its credit card.

India by far hasn’t received any application for the registration of hologram mark.

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4 Chris Woodford, Holograms, EXPLAINTHATSTUFF, August 1, 2018, https://www.explainthatstuff.com/holograms.html
Motion Mark
A motion mark is moving animated object or logo which is used by a company as a marketing strategy to gain a customer base. A motion mark is made by using computer programs and software along with animation techniques. In Europe, Sony Ericsson submitted a flipbook depicting of up to 20 images which allowed the examiner of the trademark to flick through the pages and see the motion in the pictures. This application was initially rejected by the examiner but was then accepted on appeal. A well-known example of a motion mark registered is Microsoft windows logo which we see once we open the windows PC or laptop. The opening and closing of Lamborghini doors have been protected under motion marks by USA.

Motion mark as a trademark is rarely registered as they have just gained importance with technological advancement in this arena.

Texture Mark
Texture Marks are those which give the feel of the product through touch. Just like smell marks, these are difficult to be registered as there can be no representation of the feel of the texture such as fabrics, bottles, etc. They are the least common Non-Conventional Marks. It should be noted that the texture should not be attributing to the functional purpose of the product. Thus for example, the texture of a toothbrush’s hair cannot be trademarked as they are supposed to be pliable to enable its reach all inside the mouth. On April 29, 2004, the Intellectual Property Institute of Ecuador (IEPI) issued what is, apparently, the world’s first registration certificate for a texture trademark. IEPI found that the “OLD PARR” SURFACE TEXTURE proposed mark complied with all legal requirements of the Ecuadorian Intellectual Property Law and the Andean Community of Nations, by way of Decision 486. In US, leather texture wrapping around the middle surface of a bottle of wine is registered as a texture mark. In this case, the distinctive crinkled (crackle-glass) texture of the OLD PARR bottle was reproduced on the printed page of the Ecuadorian IP Gazette by a dual-printing process in which the inked portion was printed first, followed by a second raised impression or embossed printing of the texture mark itself on the same page.5

No texture marks have come for registration before the Indian registry.

Taste mark
Taste marks are easier to be represented graphically as the written description of the taste can be used to indicate the taste of the goods. However once again, the challenge lies in functionality. A trademark for the taste of pizza or pasta cannot be granted as it inherently performs the function of making the same- i.e. adding flavour to the dishes. Thus we see thousands of chefs making dishes with the same ingredients and with no or hardly any changes. Any product meant for human consumption may inherently disqualify for taste protection under trademark given the functionality doctrine. So, Lays can’t stop competitors from selling Magic Masala as a flavour of chips unless a maker has stolen the trade secret of Lays. The question lies when the taste of one product is applied to another. For e.g. mango is usually associated with desserts but what if a naan is made out of mango? The question is not whether the same would be consumed or not, it is whether it can be granted trademark or not. Till date, no registration has been granted for taste marks in the world. Two notable

applications for registration of taste mark came before the European Union Intellectual Property Office (EUIPO) and the United States Patent And Trademark Office (USPTO) but both of them ended up being rejected.

Till date, no application for having a taste mark registered have come before the registry.

**Trade Dress**
Trade dress is the overall look and appearance of a product or packaging that signifies the source of the product to the buyer. One of the classic examples of trade dress is the visual appeal of a Coca Cola bottle. The shape of the bottle, the red label along with the red cap all comprise of trade dress. In short, trade dress is the overall look and feel of the product. Another example of product design trade dress is the configuration of the iPhone being rectangular with rounded corners. Thus trade dress goes much beyond the product itself. It is about how impactful and visually appealing is the product to the consumers. Although the Trade Marks Act, 1999 includes most of the aspects of trade dress under the definition of mark but if the aspect goes beyond the domain of a product and starts identifying itself with aspects other than just the product. For e.g. the overall look and appeal of a restaurant.

In the case of Colgate v. Anchor, Delhi High Court gave protection to the colour combination of one third red and two third white on the container of the plaintiff as a trade dress.

**Judicial Approach**
With regards to non-conventional trademarks most of the landmark judgements are from U.K. and U.S.A. Some of them are listed as below:

**Ralf Sieckmann v. Deutsches Patent und Markenam**

**Year:** 2002

**Type of mark:** Smell

This is widely recognised as a landmark decision of the European Court of Justice (ECJ) on the graphical representation of non-conventional trademarks under the European Trade Marks Directive.

The case involved a "methyl cinnamate" scent, which the applicant had described "as balsamically fruity with a slight hint of cinnamon". The ECJ ruled that (a) a chemical formula stated only the substance and not the odour of the substance and was not sufficiently intelligible, nor sufficiently clear and precise; (b) a written description was not sufficiently clear, precise and objective; and (c) a physical deposit of a sample of the scent did not constitute a graphic representation, and was not sufficiently stable or durable.

The case illustrates difficulties with the graphical representation of scent marks, as the ECJ held that these representations, whether individually or collectively, could not satisfy this requirement.

**Shield Mark BV v. Joost Kist**

**Year:** 2003

**Type of mark:** Sound

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6 ECJ Case C-273/00  
7 ECJ Case C-283/01
In *Shield Mark v Kist*, the ECJ has decided the conditions under which sound trademarks can be registered. Some of the relevant guidelines are stated as under:

**Whether sound marks can be trademarks** - Sound marks are capable of being trademarks under Article 2 of European Directive 89/104 if they are capable of distinguishing the goods or serviced from one undertaking from those of other undertakings and if they are being capable of being represented graphically.

**Whether sound marks can be represented graphically** - following its Sieckmann, the ECJ reiterated that a trade mark can consist of a sign that is not capable of being perceived visually (such as a sound or an smell mark), as long as it can be represented graphically, particularly by means of images, lines or characters and if its representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective.

*Qualitex Co. v. Jacobsen Products Co., Inc*\(^8\)

**Year**: 1995  
**Type of mark**: Colour  
In this U.S case relating to the trademark of special shade of green used on dry cleaning pads, the Court held that a colour is also capable of satisfying the requirement that a person use or intend to use the mark to identify and distinguish the goods. Over time customers start identifying a particular product with its colour thus acquiring a secondary meaning. There is no objection to the use of colour as a mark under the functionality doctrine of trademark law. This doctrine permits legitimate healthy competition among the traders by not allowing a producer to control a useful product feature. A product feature is functional if exclusive use of the feature would put competitors at a significant non-reputation-related disadvantage. Sometimes colour does not play an essential role in the product’s use or purpose and does not affect cost or quality, so the doctrine of functionality does not create an absolute bar to the use of colour alone as a mark. Thus in the given case though the colour had acquired a secondary meaning it did not per se describe the function of the product. So, colour can sometimes meet the basic requirements for use as a trademark. It can be a symbol that distinguishes a company’s goods and identifies their source, without serving any other significant function.

*Two Pesos, Inc., v. Taco Cabana, Inc*\(^9\)

**Year**: 1992  
**Type of mark**: Trade Dress  
Taco Cabana, a fast food Mexican restaurant chain in San Antonio, Texas, had a specifically-designed look or “trade dress”. Two Pesos, another similar restaurant chain based in Houston, Texas, opened a few years later with a remarkably similar look. In 1987, Taco Cabana sued Two Pesos in the United States District Court for the Southern District of Texas for trade dress infringement under § 43(a) of the Lanham Act, 15 U.S.C. § 1125(a) (1982 ed.), and for theft of trade secrets under Texas common law. In this case the Supreme Court held that trade dress can be protected under the Lanham Act based on inherent distinctiveness even if there is no proof of a secondary meaning.

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\(^8\) 514 U.S. 159 (1995)  
\(^9\) 505 U.S. 763 (1992)
Recovery is usually available for trademark infringement without a secondary meaning, and there is no persuasive reason for treating trade dress differently from other types of trademark. Requiring a secondary meaning would go against the purposes of the Lanham Act.

_N.Y. Pizzeria, Inc v. Syal_\(^{10}\)

**Year:** 2014

**Type of mark:** Taste

This was the case where the question of whether a flavour can be trademarked came before the Court. The court agreed that a flavour could be trademarked, but added that it would have to identify the source of the product. It was noted that, just as colours, flavours cannot be inherently distinctive and must acquire secondary meaning to be used as a trade mark.

It was also noted that flavours are functional and that the functional features of a product are not protectable. The Supreme Court defined in a footnote in _Inwood Laboratories, Inc._, quoted in _Qualitex_, that the functionality doctrine “forbids the use of a product's feature as a trademark where doing so will put a competitor at a significant disadvantage because the feature is "essential to the use or purpose of the article" or "affects [its] cost or quality."

The court noted that “[t]he functionality doctrine is a significant hurdle for any party seeking to protect a flavour as a trademark,” citing the _In re N.V. Organon_ Trademark Trial and Appeal Board (TTAB) case, where the TTAB denied trade mark registration to the orange flavour of a pharmaceutical pill, as the flavour has for function to cover the unpleasant taste of the medicine. The functionality hurdle is even higher for the flavour of a particular food, as “[t]he flavour of food undoubtedly affects its quality, and is therefore a functional element of the product.” The Court thus dismissed the trade mark infringement pizza flavour claim.

_Wal-Mart Stores, Inc. v. Samara Brothers_\(^{11}\)

**Year:** 2000

**Type of mark:** Trade Dress

This was a case of trade dress protection with regards to children’s clothing. The U.S Supreme Court held that for an action for infringement of unregistered trade dress, a product’s design is distinctive, and therefore protectable, only upon a showing of secondary meaning. The fact that product design almost invariably serves purposes other than source identification not only renders inherent distinctiveness problematic; it also renders application of an inherent-distinctiveness principle more harmful to other consumer interests," Justice Scalia wrote for the Court. "Consumers should not be deprived of the benefits of competition with regard to the utilitarian and esthetic purposes that product design ordinarily serves by a rule of law that facilitates plausible threats of suit against new entrants based upon alleged inherent distinctiveness," Justice Scalia concluded.

_Vision Sports, Inc. v. Melville Corp_\(^{12}\)

**Year:** 1989

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\(^{10}\) Civil Action No. 3:13-CV-335

\(^{11}\) 529 U.S 205,216 (2000)

\(^{12}\) 12 USPQ 2d 1740
**Type of mark:** Trade Dress

In this case with regards to trade dress the court held that "In contrast, trade dress involves the total image of a product and "may include features such as size, shape, colour combinations, texture, or graphics. Trade dress protection is broader in scope than trademark protection, both because it protects aspects of packaging and product design that cannot be registered for trademark protection and because evaluation of trade dress infringement claims requires the court to focus on the plaintiff's entire selling image, rather than the narrower single facet of trademark."

*Colgate Palmolive Company And Ors. v Anchor Health And Beauty Care Pvt & Anr.*

**Year:** 2003

**Type of mark:** Trade Dress

In this case the Delhi High Court held that in the case of passing off and for that purpose infringement of trade mark which are already in existence, the second or for that purpose the subsequent comer has certain obligation to avoid unfair competition and become unjustly rich by encashing on the goodwill or reputation of the prior comer. They have to establish and bank upon on their own trade dress or distinctive features so as to establish their own merit and reputation and attract the attention of the purchasing public and if there are no substantial dissimilarities of marks, colour combination, get up or lay out on the container or packing or covering of the goods of the prior comer these are likely to create confusion in the minds of customers between his goods and the goods of the prior comer in the market as underlying and hidden intention of the second comer is to encash upon the successful rival. Thus in the given case an injunction was granted to the defendant from using the colour combination of red and white in that order as trade dress on the container and packaging of its goods- “Tooth Powder”.

*Eli Lilly/ The taste of artificial strawberry flavour*

**Year:** 2003

**Type of mark:** Taste

This was a case where an application was filed before the Office For Harmonisation In the Internal Market (Trade Marks and Trade Designs) [now known as European Union Intellectual Property Office] to trademark the flavour of strawberry for pharmaceuticals. This was rejected on the grounds that it lacked any distinctive character. The mark was presented with a verbal description and thus lacked a written description to be filed mandatorily in order to describe the mark. Thus it can be concluded from this judgement that applying for a taste mark for a medicine is a futile exercise as this is generally done to offset to bitter taste of the medicines. Adding a flavour to a medicine is usually performing a functional aspect of the product.

**Issues**

Given the sparing use of Non-Conventional Marks in India, we still have a long way to go in the implementation of the same. There haven’t been any substantial cases before Indian

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13 108 (2003) DLT 51
14 R120/2001-2 (4- Aug. 2003)
courts for registration of Non-Conventional Marks except a few related to trade dress protection.

Some of the glaring problems with regards to Non-Conventional Marks are as follows:

A. The lack of explicit provisions makes the process of recognising the Non-Conventional Marks a lot tougher. Thus the need of the hour is a law on Non-Conventional Marks. Another issue is that how far would the law recognise the Non-Conventional Marks so that it doesn’t become an overreaching limit. It is difficult to recognise sensory marks because of their lack of written representation. This is true especially in cases of smell and touch marks. Non-Conventional Marks are a grey area which require a lot of thought to be put into to derive at provisions which would not give an upper hand to the well-known marks.

B. The international convention on IPR- TRIPS itself excludes Non-Conventional Marks outside the ambit of trademark. Thus many countries have been questioning as to whether TRIPS itself needs a change to incorporate Non-Conventional Marks. But another aspect to this is that TRIPS lays down the minimum criteria’s to be followed by the member nations. Thus any nation can go TRIPS plus but not TRIPS minus. It is because of this, countries like USA have Non-Conventional Marks included in their legislation.

C. Another issue is the criteria of distinctiveness or secondary meaning along with the graphical representations. This is especially difficult with regards to smell marks. The written representation of the chemical formulas can be done for scent marks but in case of good items this gets tougher. Also due to the problems with regards to storage, registration of smell marks is rare. This problem can be solved by creating a framework where smells can be registered through the virtual reality domain with sensory functions. Thus there could be a system which stores the smell for infinity without any chances of evaporation or distortion.

Conclusion

*Non-Conventional Marks: Moving past archaic laws or an overreaching issue?*

A trademark is a source identifier that is intended to prevent consumer confusion as to the source of a particular good or service. With the source identifier changing with time, the recognition of trademarks has moved beyond the domain of goods and services. Today products are recognised with their smell, taste, colour, combination of colours, feel, shape, etc. Consider the McMaharaja burger of McDonalds- the taste of it- where taste mark comes into picture, the connection to the jingle “Pa pa ra ra I’m lovin’ it!”- this is where sound mark comes into picture, the spicy smell of the burger- olfactory mark and the way the burger looks like- the shape of a mark, the overall feel of the burger- trade dress. Thus from the above example it is clear that if Non-Conventional Marks were to implemented as easy as a traditional trademark, it would create monopoly and unfair competition into the market. A spicy burger will look and smell almost the same if made by a competitor. Thus seeking
protection under all the realms of Non-Conventional Marks would destroy the very essence of free trading economy by promoting unhealthy competition. Thus in a country like India, Non-Conventional Trade Marks still have a long way to go. With the emergence of new technologies and advancement into the identification and association of a trademark, going beyond the traditional approaches is a must.