

# NON CONVENTIONAL TRADE MARKS IN INDIA

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*Dev Gangjee analyses the registration of non conventional shape marks in India, with specific focus on the Indian Trademark Registry's Manual for Trade Mark Practice and Procedure. He compares the procedural and substantive provisions in the Manual with the law prevailing in jurisdictions such as the European Union and the United States, and in light of various anti-competitive concerns, proposes a "cautious reception" for such marks.*

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## I. INTRODUCTION

In recent years, trade mark<sup>1</sup> registries and courts have grappled with applications for silhouettes, shapes, scents, textures, tastes, short cartoons, single colours, body movements, technical concepts, the positions of labels on products and Tarzan's yell as trade marks. This invasion of the unconventional is due to

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1 This article begins with an appeal to readers. Indian legislation and judicial pronouncements still refer to 'trade marks' and not 'trademarks', which is American usage. Since trade marks, merchandise marks, hall marks and other categories emerged as a result of historically contingent processes, using 'trade marks' is a useful reminder of the justificatory basis for such protection and still the official usage under Indian law.

the abstract nature of the legal definition of a trade mark. On the one hand, trade mark law has embraced an open-ended definition that emphasises the functional, rather than the ontological status of a sign. Any sign which does the communicative work of a trade mark, by distinguishing goods or services on the basis of trade origin, can be registered as one. On the other hand, trade mark registration systems have historically developed around paradigmatic subject matter: a conventional or traditional trade mark that is visual and consists of words, devices or a combination of the two.<sup>2</sup> The need to reconcile these conflicting imperatives – the trade mark registration system is open to all categories of signs and it's apparently 'business as usual', yet the registration system was designed with only words and figurative devices in mind – requires a careful reconsideration of certain basic assumptions underpinning this area of intellectual property.

While such new types of marks raise interesting conceptual questions,<sup>3</sup> they are of a more immediate and pragmatic concern to an Indian audience. It has been widely reported that the Indian trade mark registry recently registered a sound mark for Yahoo,<sup>4</sup> followed by another for Allianz Aktiengesellschaft,<sup>5</sup> while the Delhi High Court has responded favourably to a trade mark infringement claim to protect the shape of Zippo lighters.<sup>6</sup> There is a client driven interest in exploring

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- 2 For descriptions of conventional trade mark subject matter, See: R.H. Falconer, *Big Future for Nontraditional Marks*, NAT. LAW. J.L. C28 (1998) ("In the past, trade marks tended to fit a mould. They were words or symbols that derived their strength from their relative degree of distinctiveness and the amount of use they enjoyed in sales, advertising or both"); WIPO Secretariat 'New Types of Marks' (SCT/16/2) Sep. 1, 2006, at 3 ("The types of signs that are nowadays considered as being capable of constituting a trade mark have expanded beyond words or figurative devices").
  - 3 As a normative question, should we have such an open ended definition? Additionally, if our frame of reference and doctrinal toolkit (including core concepts like trade mark distinctiveness or likelihood of confusion analysis) have developed around words and images, can these be effectively redeployed for new categories of marks? What sorts of analogies will be drawn? And will we (perhaps unconsciously) draw on concepts borrowed from copyright law or design law when dealing with musical sounds marks or three dimensional/trade dress marks? Since these Intellectual Property regimes pursue different objectives, is such borrowing appropriate?
  - 4 P. Manoj, *Yahoo Awarded India's First Sound Mark; Nokia in Queue* LIVE MINT, Aug. 22, 2008; *Yahoo! Yodels into India's Trade Mark Registry* MANAGING INTELLECTUAL PROPERTY WEEKLY NEWS, Sep. 1, 2008.
  - 5 *Yet Another Sound Mark Granted*, available at <http://spicyipindia.blogspot.com/2009/07/yet-another-sound-mark-granted.html>.
  - 6 *Zippo*, IA 7356/2006, (High Court of Delhi) (13 July 2006) (H.R. Malhotra, J). The decision is of symbolic importance but very limited precedential value since it concerns an *ex parte ad interim* injunction order, based on a *prima facie* case of infringement. There is no detailed analysis applying the infringement test to shapes and the validity of the shape mark was not challenged.

these possibilities. It is also an opportune moment to reflect on such marks because the Trade Mark Registry is currently revising its Manual for Trade Mark Practice and Procedure.<sup>7</sup> Several sections of the Manual consider new types of marks, since the Trade Marks Act of 1999<sup>8</sup> and the Trade Marks Rules of 2002<sup>9</sup> specifically refer to non conventional subject matter, in contrast to the Trade and Merchandise Marks Act of 1958.<sup>10</sup> Experience across jurisdictions suggests that the tribes of signs prepared to take advantage of this hospitality can be divided on the basis of sensory perception. These separate into visible signs (3D marks, colours, holograms, slogans, titles of media works, motion or multimedia signs, position marks and gestures) and non-visible signs (sounds both musical and non-musical, olfactory marks, tastes, textures).<sup>11</sup> The Manual serves as a guide for the examiners who apply the law, while ensuring transparency for the users of the registration system.<sup>12</sup> It is an evolving document and “*will be updated from time to time in the light of important judgments and decisions of courts involving interpretation of the provisions of the Act and Rules*”.<sup>13</sup> The Manual is also open to comparative legal developments, while it serves as a reference point for three constituencies – legal practitioners and their clients, the trade mark registry examiners and those who adjudicate on trade mark law, including the Intellectual Property Appellate Board and the judiciary.<sup>14</sup> This article is primarily addressed to these three constituencies and responds to issues considered in the Draft Manual.

Before commencing with the analysis of procedural and substantive rules, one preliminary point is worth emphasising. Despite the Draft Manual being open to comparative law influences, sounding a note of caution is appropriate. Given their shared common law orientation, Indian trade mark legislation as well as judicial doctrine has historically followed the contours of British law.<sup>15</sup>

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7 A draft of the Trade Marks Work Manual [hereinafter “Draft Manual”], Jan. 23, 2009, available at [http://ipindia.nic.in/tmr\\_new/default.htm](http://ipindia.nic.in/tmr_new/default.htm).

8 No. 47 of 1999. [Hereinafter “the Act of 1999”]. The Act came into effect on Sep. 15, 2003. See, Gazette of India, Notification No. SO 1048(E) (15/09/2003).

9 See, Gazette of India Extraordinary Pt. II Sec. 3(i) GSR 114(E) (26/2/2002). [hereinafter “the Rules”].

10 No. 43 of 1958. [hereinafter “the Act of 1958”].

11 WIPO Secretariat, *supra* note 2.

12 Draft Manual Ch. I, at 5.

13 *Ibid.*

14 For the importance of Registry practice, as reflected in the Manual, see, § 98 of the Act of 1999.

15 See, *Sunder Parmanand Lalwani v. Caltex (India) Ltd.*, AIR 1969 Bom 24, 32 (High Court of Bombay) (“*Our Trade Marks law is based on the English Trade Marks law and the English Acts*”); Draft Manual Ch II, at 1.2 (“*To a large extent the practice of the Registry in India broadly corresponds with the practice prevailing in the UK*”).

However, with the Trade Marks Act of 1994, British Law has begun an irreversible drift away from its common law origins and becomes increasingly European, with a number of civil law concepts and interpretative techniques informing the development of substantive trade mark law.<sup>16</sup> Registered trade mark law in England today looks very different from the pre-1994 law, whereas there is arguably greater doctrinal continuity between Indian Acts of 1958 and 1999. Other common law jurisdictions have noticed this widening gap as well, while re-emphasising the importance of local conditions and requirements. The South African Supreme Court of Appeal has noted that:<sup>17</sup>

The British Trade Marks Act 1994 (Ch.26) had to conform to the [European] Directive and its interpretation by the [European Court of Justice (ECJ)] binds the English courts. This does not mean that we are bound to follow these authorities... [The South African Act] must be interpreted and applied in the light of our law and circumstances. Local policy considerations may differ from those applicable in Europe.

Consequently even though the language of the Indian Act of 1999 often closely follows the UK's Trade Mark Act of 1994, Indian courts retain interpretative freedom and can retain the common law approach of the Act of 1958 in certain areas, or otherwise depart from UK precedent. Ironically, the common law approach to registered trade marks is no longer an option for UK courts – the home of the common law – since they are now bound by ECJ precedents. UK law is now European law, whereas the very basis for following it in the past was the common law connection. In the pages that follow, the key insight to remember is that Indian trade mark law need not be 'Europeanised' by stealth. The rest of this article is divided into three further

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16 See, the manner in which the European Court of Justice bypassed the literal wording of the legislation and adopted a teleological or purposive approach in *Zino Davidoff SA v. Gofkid Ltd.*, (C-292/00) [2003] 28 FSR 490 (European Court of Justice). More importantly, much of European trade mark law has developed against the backdrop of European rules on the free movement of goods in the common market, while these considerations do not apply in the Indian context. For this history, see, I. Simon, *How does Essential Function Drive European Trade Mark Law?*, 36 I.I.C. 401 (2005); F.K. Beier, *The Development of Trade Mark Law in the Last Twenty-Five Years* 26, I.I.C. 769 (1995).

17 *Triomed (Pty) Ltd v. Beecham Group Plc*, [2003] F.S.R. 27 (Supreme Court of Appeal of South Africa) (Harms, J.A.); See also, *Nation Fittings v. Oystertec Plc and Anr.*, [2005] S.G.H.C. 225, 72 (High Court of Singapore). ("Although the [Singapore Act] is based on the UK 1994 Act and the UK 1994 Act is, in turn, based on the European Directive, the interpretation of our Act is not (unlike the 1994 UK Act) subject to the Directive").

sections. Section 2 considers overarching themes, focussing on both procedural issues raised by the registration of non conventional marks, as well as principled objections in cases where the needs of competitors or consumer interests are threatened by granting a trade mark. Section 3 goes on to consider two particular categories of subject matter – pure colour marks and shapes or 3D marks – in greater detail. These are the most conventional of the non conventional marks and the Registry should see higher numbers of applications in these two areas. Section 4 concludes.

## II. OVERARCHING ISSUES

At present, the demand for non conventional marks is relatively modest. When it comes to filing statistics, the Registry's most recent Annual Report still only refers to the conventional categories of word, device, number, letter and letter and numeral.<sup>18</sup> Yet interest in such marks is gathering pace and this promises to be a future growth area, as producers and advertisers strive to stand out from the crowd through innovative marketing techniques.<sup>19</sup> The "*diversity of signs which enterprises seek to develop as trade marks and to use in the marketplace... shows that trade mark law is subject to a dynamic process from which new types of marks may constantly evolve*".<sup>20</sup> In response, the World Intellectual Property Organisation (WIPO) has prepared a series of documents on non traditional marks, based on a detailed survey of national registration practices.<sup>21</sup> This transition from words and devices to an apparently unrestricted field of candidates is made possible by the functional manner in which a trade mark has been defined.

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18 *Annual Report of the Office of the Controller General of Patents, Designs and Trade Marks* 42 (2007-2008).

19 Two practitioner monographs highlight the growing importance of this area: See, T.P. ARDEN PROTECTION OF NONTRADITIONAL MARKS (2000); S. SANDRI & S. RIZZO NON-CONVENTIONAL TRADE MARKS AND COMMUNITY LAW (2003). The International Trade Marks Association (INTA) has also prepared a number of recent reports on non traditional marks. See: [http://www.inta.org/index.php?option=com\\_content&task=view&id=1396&Itemid=231&getcontent=3](http://www.inta.org/index.php?option=com_content&task=view&id=1396&Itemid=231&getcontent=3); See also, A.I.P.P.I. Summary Report: Q181: *Conditions for Registration and Scope of Protection of Non-Conventional Trade Marks* (2004), available at <https://www.aippi.org/?sel=questions&sub=listingcommittees>; Special report on Non Traditional Trade Marks across 15 jurisdictions in *World Trade Mark Review* (Aug 2009).

20 WIPO Secretariat 'New Types of Marks' (SCT/16/2) Sep. 1, 2006, at 57.

21 WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT), Sessions 16-21. Documents at: <http://www.wipo.int/sct/en/meetings/>.

### A. A Functional Definition of a Trade Mark

National laws and international treaties refer to an open-ended definition of a trade mark. Article 15(1) of TRIPS<sup>22</sup> acknowledges that any “*sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trade mark*”. US statutory language takes a similar form: A trademark is a designation which includes, “*any word, name, symbol, or device, or any combination thereof [which] serves to identify and distinguish [the mark owner’s goods] from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown*”.<sup>23</sup> As the US Supreme Court observed, since “*human beings might use as a “symbol” or “device” almost anything at all that is capable of carrying meaning, [the statutory definition] read literally, is not restrictive*”.<sup>24</sup> The ECJ has joined this chorus on a harmonious note in *Sieckmann*<sup>25</sup> and subsequent decisions which also interpret the equivalent definition in Article 2 of the EU Trade Marks Directive.<sup>26</sup> All these provisions emphasise the communicative ability that a candidate must possess. The sign should have the potential to be distinctive; it must indicate origin and thereby distinguish or differentiate the goods or services upon which it is used from others on the marketplace.<sup>27</sup> Moreover, the law recognises that brand owners can educate the relevant public that a sign is being used as a trade mark, through the doctrine of acquired distinctiveness or secondary meaning.<sup>28</sup> An example would be the triangular shape of Toblerone

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22 Agreement on Trade-Related Aspects of Intellectual Property Rights, Apr. 15, 1994, Marrakesh; Agreement Establishing the World Trade Organization, Annex 1C (1994) 33 I.L.M. 1197.

23 15 USC § 1127 (Lanham Act § 45).

24 *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 162 (1995).

25 *Sieckmann v. Deutsches Patent - und Markenamt*, (C-273/00) [2003] E.T.M.R. 37, 43-45 (European Court of Justice) [hereinafter “*Sieckmann*”].

26 First Council Directive 89/104/EEC of Dec. 21, 1988 to Approximate the Laws of the Member States relating to Trade Marks OJ 1989 L40/1. The substantive provisions under consideration remain unmodified in its successor, Directive 2008/95/EEC of Oct. 22, 2008 OJ 2008 L299/25.

27 Indian statutory language draws on U.K. law, which in turn is derived from E.U. trade marks legislation. According to consistent E.C.J. case law, for a trade mark to possess distinctive character, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings. *See*, *Procter & Gamble v. OHIM*, (C-473/01 P and C-474/01 P) [2004] E.C.R. I5173, 32 (European Court of Justice). This ability to distinguish based on origin is also referred to as the essential function of a trade mark. *See generally*, *Simon*, *supra* note 16.

28 *See*, Proviso to § 9(1), Act of 1999. (“*Provided that a trade mark shall not be refused registration if before the date of application for registration it has acquired a distinctive character as a result of the use made of it or is a well-known trade mark*”). For acquired distinctiveness, *see generally*, *Mahendra & Mahendra Paper Mills Ltd v. Mahindra & Mahindra Ltd.*, (2002) 2 S.C.C. 147 (Supreme Court of India).

chocolate, which has acquired trade mark significance over time.<sup>29</sup> This open ended approach to subject matter is also evident in the Act of 1999. A trade mark is defined in section 2(1)(zb) as follows: “‘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”.

A ‘mark’ is further defined in section 2(1)(m): “‘mark’ includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination thereof”. While this is an inclusive definition, the Draft Manual clarifies that certain categories of marks, such as shapes, colours, sounds and smells, “will require special consideration”.<sup>30</sup> This ‘special consideration’ can be analysed along the lines of certain overarching themes, cutting across all categories of non conventional subject matter. These arise in response to two general questions: (1) To what extent can the principles applicable to conventional trade marks accommodate unconventional subject matter?<sup>31</sup> (2) Where gaps exist in existing rules, what should be the form and content of new supplementary rules? In the following paragraphs, I focus on two of these overarching themes – one concerning procedure and the other concerning the substantive exclusion of certain types of marks. At the initial stages of applying for registration, procedural requirements pose a challenge for certain types of marks. Additionally, as a question of principle or policy, should we permit the registration of certain shapes, colours or other signs which also perform a technical function? Here we encounter the danger of conflating rights over a mark with rights over a thing itself, or a commercially significant property of a thing.

### ***B. Graphical Representation and Procedural Requirements***

The first set of challenges arises when an application is made to register unconventional subject matter. How does one adequately flatten out and represent a sound, scent or texture using words and drawings? A registration based trade mark system is justified on the basis that “it enables those engaged in trade, and the public more generally, to discover quickly and cheaply which signs third

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29 T. Helbling, *Shapes as Trade Marks? The Struggle to Register Three-Dimensional Signs: A Comparative Study of United Kingdom and Swiss Law*, I.P.Q. 413, (1997). For litigation concerning the imitation of the triangular shape, see, *Toblerone/Harrods Gold Bar*, Brussels Court of Appeal, Jun. 2, 2004 (Unreported); *Mars v. Kraft The Hague*, Court of Appeal, Jan 3, 2008 (Unreported).

30 Draft Manual Ch II, at 3.1.

31 See generally, WIPO ‘Relation of Established Trade Mark Principles to New Types of Marks’ (SCT 17/3) Mar. 30, 2007.

*parties have already claimed*".<sup>32</sup> The system therefore depends on the register containing accurate information and this is where the graphical representation requirement, to fix the sign as a reference point, becomes relevant.<sup>33</sup> The ECJ elaborated upon the rationale for this requirement in *Sieckmann*, concluding that the graphical representation must be "*clear, precise, self-contained, easily accessible, intelligible, durable and objective*" (*Sieckmann* criteria).<sup>34</sup> According to the ECJ these criteria have broader significance since they clearly "*define the mark itself in order to determine the precise subject of the protection*"; enable the registry to fulfil their bureaucratic obligation to examine and process trade marks; and also enable competitors to conveniently identify protected marks.<sup>35</sup> Burrell and Handler refer to these as the definitional, bureaucratic and informational functions of the trade mark register.<sup>36</sup> Courts have subsequently appreciated the need for clear and precise trade mark registrations when it comes to the scope of exclusive rights: "*The form in which a trade mark is registered is important for a number of reasons. The trade mark as registered is a fixed point of reference by which infringement is to be judged. The registered mark must be considered in the precise form in which it is registered.*"<sup>37</sup>

The Draft Manual therefore devotes several pages to the graphical representation requirements for colour, sound, scent, hologram and shape marks.<sup>38</sup> It specifies that the graphical representation should be independently sufficient to identify the applicant's mark; the representation should stand in place of the mark; and it should enable those inspecting the register to understand what the mark is.<sup>39</sup> In doing so, it expressly maps on to UK registration practice and adopts the *Sieckmann* criteria.<sup>40</sup>

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32 R. Burrell 'Trade Mark Bureaucracies' in G. Dinwoodie and M. Janis (eds.) *TRADE MARK LAW AND THEORY: A HANDBOOK OF CONTEMPORARY RESEARCH* 95-98 (Edward Elgar, Cheltenham, 2007). However, Burrell is critical of the claim that trade mark registers accurately reflect the scope of the registered rights; registers often provide ambiguous information.

33 Graphical representation is an essential element of the definition of a trade mark in § 2(1)(zb) and specifically defined in Rule 2(1)(k) to mean "*the representation of a trade mark for goods or services in paper form*". Presumably this will include e-filing forms as well.

34 *Sieckmann*, *supra* note 25, at 55.

35 *Ibid.*, at 48- 54.

36 *See*, R. Burrell & M. Handler *Making Sense of Trade Mark Law*, I.P.Q. 388 (2003). However, the authors are critical of the effectiveness of these functions.

37 *L'Oreal SA v. Bellure, NV*, [2006] E.W.H.C. 2355 (Ch) (European Court of Justice); [2007] ETMR 1, 82 (Lewison J.)

38 *See generally*, Draft Manual Ch II, at 5.2.

39 *Ibid.*, at 4.2.4.

40 *Ibid.*, at 5.2.2.1 ("*The representation must be clear, precise, self-contained, easily accessible, intelligible, durable and objective*").



However, the result of applying these criteria in *Sieckmann* was that while scent marks in theory can be registered, in practice a successful registration is unlikely. In that case, Ralf Sieckmann applied to the German trade marks registry to register a scent mark for various services. He attempted to represent the mark by (i) indicating the name of the chemical substance, methyl cinnamate; (ii) the structural formula for that substance ( $C_6H_5-CH = CHCOOCH_3$ ); (iii) indicating laboratories where samples may be obtained; (iv) submitting an odour sample in a container; and (v) describing the scent in words as “*balsamically fruity with a slight hint of cinnamon*”. Yet each of these methods of representation was problematic. For instance, the ECJ ruled that while the description of “*balsamically fruity with a slight hint of cinnamon*” was easily accessible and intelligible, it was not clear, precise or objective (what is a ‘fruity’ scent and how much cinnamon does a ‘hint’ refer to?). On the other hand, the chemical formula was objective but unintelligible to laypersons and would require reference to external, expert resources to decode so it was not self-contained. It also referred to the substance, not the scent itself and was an indirect proxy instead of a direct representation. On closer scrutiny, the *Sieckmann* criteria seem to have been developed with traditional visual marks in mind,<sup>41</sup> and in satisfying some criteria an applicant may lose out on others. While visual marks such as words or devices can satisfy all seven criteria, for non-visual marks this appears difficult.<sup>42</sup> In later decisions, the ECJ has relaxed the ‘self-contained’ requirement and conceded that external clarificatory references may be necessary for greater precision, but only up to a point. In *Libertel*,<sup>43</sup> where the court confronted an application for the pure colour orange for telecommunications related goods and services, it decided that merely reproducing the colour on a sheet of paper was not sufficiently durable (due to fading over time) and the written description might be imprecise (how many shades did ‘orange’ encompass?). However an external reference point such as an internationally recognised colour code was permissible since such codes were deemed to be precise and stable. The UK Trade Marks Registry has subsequently accepted these colour codes,<sup>44</sup> along with a written description of the colour (e.g. ‘dark blue’) as adequate graphical representation. Nevertheless it specifies that

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41 Burrell and Handler, *supra* note 36, at 399.

42 On this basis the Draft Manual follows the *Sieckmann* approach and disallows scent marks on the basis of graphical representation.

43 *Libertel Groep BV v. Benelux-Merkenbureau*, (C-104/01) [2003] E.T.M.R. 63 (European Court of Justice).

44 For further details on colour codes, *see*, UK TM Registry Practice Amendment Notice 2/06 (Apr. 12, 2006). (“*There are a number of colour identification systems in existence e.g. Pantone®, RAL and Focoltone®*”).

while a degree of interpretation, via external reference resources, may be permissible there are limits to this process:

It must be reasonably practicable for persons inspecting the register, or reading the Trade Mark Journal, to be able to gain an understanding from the graphical representation of what the trade mark is. Representations which are precise but impossible to interpret without costly specialist equipment or services, place too high a burden on third parties and are likely to be rejected because they are not “easily accessible”.<sup>45</sup>

Thus external references are permitted provided they are easily accessible and colour codes are deemed to satisfy this. By contrast, the Draft Manual adopts a curiously worded and ambiguous approach for representing single colours.<sup>46</sup> It acknowledges the UK position permitting colour codes, then states that the ‘law or practice in India does not provide for such interpretation’.<sup>47</sup> It goes on to refer to a case<sup>48</sup> where the applicant used extremely technical terminology to describe a colour and thereby failed the graphical representation requirement, as the basis for Indian law, *without specifying what will satisfy graphical representation criteria for colours marks*. Since the Manual also refers to the distinctiveness test for single colour marks in the same section, one presumes these marks can be represented but there is an explanatory gap here as to how this should happen. An emerging international consensus suggests that single colours can be graphically represented through a combination of a sample (e.g. coloured sheet of paper), the common name of the colour, reference to an international colour code and a written description including details regarding how the single colour will be used on specific goods or services.<sup>49</sup> It is submitted that the Indian Registry should consider this option. There are a number of principled arguments against registering single colours,<sup>50</sup> but a procedural requirement is not the place to fight this battle.

Turning to sound marks, we again observe the ECJ’s retreat from a strict interpretation of the *Sieckmann* criteria. In *Shield Mark*<sup>51</sup> the court had to determine

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45 *Ibid.*

46 Draft Manual Ch II, at 5.2.1.2.

47 *Ibid.*

48 Ty Nant Spring Water Ltd’s Application, [2000] R.P.C. 55.

49 WIPO ‘Representation and Description of Non-Traditional Marks – Possible Areas of Convergence’ (SCT 19/2) Apr. 28, 2008, at 23- 28.

50 Considered in § 3(i) below.

51 *Shield Mark BV v. Joost Kist*, (C-283/01) [2004] R.P.C. 315 (European Court of Justice) [hereinafter “*Shield Mark*”].

the adequacy of graphical representation for both musical<sup>52</sup> and non-musical<sup>53</sup> sound marks. For musical sounds, it concluded that sufficiently detailed musical notation would suffice – for e.g. a stave divided into bars and showing, in particular, a clef, musical notes and rests whose form indicates the relative value and, where appropriate, accidentals and all of this notation determining the pitch and duration of the sounds.<sup>54</sup> In response to the argument that not everyone can read musical notation and it may not be intelligible, the court suggested that even “if such a representation is not immediately intelligible, the fact remains that it may be easily intelligible”.<sup>55</sup> However for non-musical sounds, a description in words (“the sound of a cock crowing”) was insufficiently precise while the onomatopoeia (for e.g. “Cock-a-doodle-doo”) created a gap between the sign as registered and the actual sound of a cock crowing.<sup>56</sup> This gave rise to a puzzle – how were non-musical sounds to be represented graphically? Jurisdictions which have a more flexible representation requirement, such as the US, have avoided this problem by simply requiring the deposit of a digital recording of the sound, which is then available online on the trade mark register.<sup>57</sup> However given the language of ‘graphical’ representation, the EU’s Office of Harmonisation for the Internal Market<sup>58</sup> felt compelled to experiment with depicting sounds through complex graphical sonograms,<sup>59</sup> before conceding that the gains in precision and objectivity were offset by losses in intelligibility.<sup>60</sup> Deciphering these graphs was the province of experts and a complex as well as incomplete substitute for the sound. The compromise finally adopted was a digital sound recording deposit as well as a graphical representation in some form.<sup>61</sup>

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52 The first nine notes of Beethoven’s popular composition Für Elise.

53 The sound of a cock crowing.

54 *Shield Mark*, *supra* note 51, at 62.

55 *Ibid.*, at 63.

56 *Ibid.*, at 60.

57 For an enjoyable overview of sound mark recordings in the US and several examples, *see*: <http://www.uspto.gov/go/kids/kidsound.html>.

58 The Office for Harmonisation in the Internal Market (OHIM) is the body responsible for registering European Community-wide trade mark and design rights.

59 In a decision concerning the registrability of MGM’s roaring lion. *See, Metro Goldwyn-Mayer (MGM) Lion Corp’s Application Case* (R-781/1999-4) Aug. 25, 2003, OHIM 4th BoA, *available at*: [http://oami.europa.eu/legaldocs/boa/1999/EN/R0781\\_1999-4.pdf](http://oami.europa.eu/legaldocs/boa/1999/EN/R0781_1999-4.pdf).

60 In a decision concerning the registrability of Tarzan’s yell. *See, Edgar Rice Burroughs Inc (TARZAN yell)* (R 708/2006-4), Oct. 27, 2007, OHIM 4th BoA., *available at*: [http://oami.europa.eu/LegalDocs/BoA/2006/en/R0708\\_2006-4.pdf](http://oami.europa.eu/LegalDocs/BoA/2006/en/R0708_2006-4.pdf).

61 *See, Decision No Ex-05-3 of the President of OHIM of 10 October 2005 concerning electronic filing of sound marks available at* <http://oami.europa.eu/en/office/aspects/pdf/ex05-3.pdf>.

For registration in India, the Draft Manual seems to follow the teachings of *Shield Mark* insofar as detailed musical notation is required,<sup>62</sup> but the Manual does not differentiate between musical and non-musical sounds. How is one to depict a non-musical sound (e.g. a dog barking) using musical notation alone? The Yahoo registration in India is a helpful case study. If the mark is identical to the one filed in the US,<sup>63</sup> then it has both a verbal and a musical component. This verbalised component (a human voice yodelling 'Yahoo') cannot be adequately represented by musical notes alone. If it is represented as a written description, this leads to ambiguity. There are a number of ways of vocalising 'Yahoo'. To me, the most vivid version is indelibly associated with the song 'Yahoo! Chaahe Koyi Mujhe Junglee Kahe' from the Hindi film *Junglee* (1961).<sup>64</sup> If 'Yahoo' can be yelled or yodeled with considerable variation, then words are an imprecise technique by which to represent this sound mark. A news report suggests that a digital sample of the 'Yahoo' sound was submitted along with musical notation<sup>65</sup> and this is in keeping with international trends. An emerging consensus – in a world of easily digitised music and online information resources – suggests that alongside a written description and musical notation, an electronic deposit of the sound mark<sup>66</sup> is a *cumulative representation package* which will satisfy all of the *Sieckmann* criteria, even though sound clips are acoustic representations and not graphical ones.

The deposit of sound marks in digital form also brings us to a more general concern. To enable the trade mark register to perform its informational function in a meaningful manner, it should be easily and widely accessible. How is the sound clip easily accessible if it exists as a CD-ROM in one of the five Indian trade mark registry offices?<sup>67</sup> Amidst widespread internet usage and a commitment to e-governance, the Indian Trade Mark Registry is to be encouraged in its project to establish a freely searchable and accessible online Register of Trade Marks. At present, there is only a limited, subscription based option for searches.<sup>68</sup> India is a recognized global leader in information technology and the Indian Intellectual

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62 Draft Manual Ch II, at 5.2.2 (“Accordingly, a trade mark may consist of a sound and represented by a series of musical notes with or without words”).

63 US Serial No. 75807526 and Registration No. 2442140.

64 A potentially (copyright) infringing clip is at: [http://www.youtube.com/watch?v=1KBmYXt\\_v7w](http://www.youtube.com/watch?v=1KBmYXt_v7w)

65 P. Manoj, *supra* note 4.

66 WIPO Secretariat 'Non-Traditional Marks – Key Learnings' (SCT 18/2) Oct. 31, 2007, at 20-26.

67 Located in the cities of Mumbai, Delhi, Kolkata, Ahmedabad and Chennai.

68 See, <https://www.ipindiaonline.gov.in/etmr/publicSearch/searchmain.aspx>.

Property Office generates considerable revenues through its registration activities, so finances should not be an obstacle. Recent years have seen a commitment to digitisation<sup>69</sup> and a limited sample of registrations is presently available online.<sup>70</sup> Major trade mark jurisdictions such as the US, with its Trademark Electronic Search System (T.E.S.S.)<sup>71</sup> and the EU, with its Community Trade Marks Online (CTM-ONLINE)<sup>72</sup> have freely searchable online trade mark registers, which helps ensure that graphical representation and the process of registration in general fulfill their public information functions.

Finally, there are two concluding points of interest when it comes to procedural requirements for non conventional marks. The first of these concerns the flagging up of non conventional marks on the application form, so that special rules can be applied. The Trade Marks Rules<sup>73</sup> and Manual<sup>74</sup> are very clear that in certain cases, the application forms must indicate the manner in which a mark is non conventional. A drawing of a 3D mark should not be treated as a simple device mark at the time of registration, since this allows an applicant to escape the stricter scrutiny applicable to shape marks, considered in Section 3 below. The importance of this categorisation on the application form is noted in the OHIM Examiner's Manual: "*The categorisation of marks (word, figurative etc) serves a number of functions. Firstly... it establishes the legal requirement for the mark to be represented, secondly it can help understand what the applicant is seeking to register and finally it facilitates research in our database*".<sup>75</sup>

However, given the open ended definition of a trade mark, not all categories of non conventional marks are mentioned in the Rules, so this leads to the second

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69 Annual Report (2007-2008), at 41 ("*The registry is also in the process of switching over to Web enabled services including e-filing*"); Future Vision Statement at [http://ipindia.nic.in/tmr\\_new/default.htm](http://ipindia.nic.in/tmr_new/default.htm).

70 See, Sample of Register of Trade Marks for Test Display at [http://ipindia.nic.in/tmr\\_new/default.htm](http://ipindia.nic.in/tmr_new/default.htm).

71 <http://tess2.uspto.gov/>.

72 <http://oami.europa.eu/ows/rw/pages/QPLUS/databases/searchCTM.en.do>.

73 See, Rule 25(12): An application for the registration of a trade mark for goods or services shall ...

(c) be considered as a three dimensional trade mark only if the application contains a statement to that effect;

(d) be considered as a trade mark consisting of a combination of colours only if the application contains a statement to that effect.

74 See, Draft Manual Ch II, at 5.2.2 ("*applications for sound marks must clearly state that they are sound marks*").

75 OHIM Examiner's Manual (Jun 2009), at 2.7.1.

point. Trade Mark examiners are entitled to ask for further and better particulars, including a written description of the trade mark being applied for.<sup>76</sup> While the written description requirement is not compulsory,<sup>77</sup> for suspected non conventional marks this should be liberally used to request additional information so the sign being applied for can be defined appropriately. The aim of this section of the article has been to highlight the importance of procedure when it comes to non conventional marks. The next section turns to more substantive concerns.

### *C. Outer Limits: Can anything be a Trade Mark?*

Since we have an open ended definition of a trade mark, can an entire building be a trade mark? Should a building be a trade mark?<sup>78</sup> Unsurprisingly, new categories of subject matter have precipitated mixed responses. On the one hand trade mark law is expected to keep pace with consumer perceptions. If consumers experience colours or shapes as indications of commercial origin, the underlying 'marketplace communication' logic of trade mark protection demands that this is incorporated into the registration system. Protecting the communicative integrity of trade marks (including non conventional ones) is assumed to serve a dual purpose. By granting exclusive rights to the sign, consumer deception or confusion as to origin is prevented, while simultaneously shielding legitimate producers against a particular species of unfair competition.<sup>79</sup> Conversely, it is easy to see why granting legal monopolies of potentially unlimited duration<sup>80</sup> in commonplace single colours or familiar musical tunes to one producer would generate discomfort. This leads to the question of outer limits.

One method of excluding subject matter is to ask whether consumers are likely to perceive certain types of signs as trade marks i.e. whether they are

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76 For e.g., see, Rule 29(3)(ii): "Where, however, the Registrar considers that the reproduction of the mark furnished by the applicants does not sufficiently show the particulars of the three dimensional mark, he may call upon the applicant to furnish... a description by words of the mark".

77 Rule 25(12): "An application for registration of a trade mark for goods or services shall:-  
a) Explain with sufficient precision a description by words of the trade mark, if necessary to determine the right of the applicant".

78 See, *The Rock and Roll Hall of Fame v. Gentile Productions*, 134 F.3d 749 (1998) (Court of Appeal (First Circuit)) (The claimant unsuccessfully argued that the design for the Rock and Roll Hall of Fame and Museum in Cleveland, Ohio – effectively the building itself – was a trade mark).

79 This is the standard account in Anglo-American trademark jurisprudence. See generally, W.R. CORNISH & D. LLEWELYN, *INTELLECTUAL PROPERTY* 586-587 (2003); J.T. MCCARTHY, *MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION* Ch. 3 (2006).

genuinely “*capable of distinguishing*” as required by section 2(1)(zb). Even if they do, there may be valid reasons for keeping certain signs off the register. Here the debates swirl around the core concept of distinctiveness and the functionality prohibition, which is explicitly based on policy grounds. Beginning with distinctiveness, if a colour or shape is perceived only fleetingly, or understood to be doing something else apart from indicating the product’s trade origin, it will not satisfy the distinctiveness requirement. Examples include a colour used as a simple decoration or to make a product more visible, or if the trade dress is merely protective packaging for the product inside. Since the essence of a trade mark is to distinguish by indicating trade origin, a sign which is “*devoid of distinctive character*” will fail the absolute grounds contained in section 9 of the Act of 1999. Distinctiveness as a threshold for colour marks is considered in greater detail in section 3(i) below. When it comes to functionality, the focus shifts to the downstream effects of granting a single producer exclusive rights to the mark in question. The US Supreme Court summarises it thus:

The functionality doctrine prevents trade mark law, which seeks to promote competition by protecting a firm’s reputation, from instead inhibiting legitimate competition by allowing a producer to control a useful product feature. It is the province of patent law, not trade mark law, to encourage invention by granting inventors a monopoly over new product designs or functions for a limited time... after which competitors are free to use the innovation. If a product’s functional features could be used as trade marks, however, a monopoly over such features could be obtained without regard to whether they qualify as patents and could be extended forever (because trademarks may be renewed in perpetuity).<sup>81</sup>

In the US, functionality is a broad prohibition and applies to all categories of trade marks. So if a particular product shape is chosen because it produces a technical result, such as the face plate of the electric razor which produced a closer shave in the ECJ’s *Philips* decision,<sup>82</sup> the result is an undesirable monopoly in a technical feature leading to an anti-competitive advantage for a single

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80 Trade mark registrations can be renewed every 10 years and, unlike patent, copyright or design protection the rights do not expire so long as registration persists. *See*, § 25, Act of 1999.

81 *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 162, 164-165 (1995).

82 *Philips Electronics v. Remington Consumer Products*, (C-299/99) [2002] E.T.M.R. 81 (European Court of Justice).

producer. This barrier to registration applies to both technical features as well as aesthetic features. It affects any feature that “*is essential to the use or purpose of the article or if it affects the cost or quality of the article*”.<sup>83</sup> The critical inquiry is whether the exclusive use of that sign would put competitors at a significant non-reputation related disadvantage. Such signs are generally excluded from registration regardless of whether they are distinctive and in fact serve to indicate trade origin. Functionality for shapes is considered in greater detail in section 3(ii) below. The reasoning behind functionality also suggests the need for a more comprehensive review of the overlaps between other categories of intellectual property and trade mark law.<sup>84</sup> Here several important questions remain unanswered. If Indian classical music compositions or *raagas* in the public domain can be registered as sound marks, how will that affect the ‘limited monopoly’ logic of copyright law, which presumes that cultural works should be freely available where copyright protection did not exist or has expired? Should we address this concern by not allowing the registration of public domain materials in the first place, or by granting a narrow scope of protection if they are registered, or by incorporating specific defences into trade mark law to allow third party use in a non-confusing manner?

So far we’ve looked at discrete categories of non conventional subject matter – shapes, smells, sounds – but since the definition of a trade mark is truly open ended, why stop there? What about themes, concepts, combinations of elements and other abstractions?<sup>85</sup> Some of these implications were explored by various decision makers in the *Dyson* litigation, which strikingly illustrates the range of techniques used by registries and courts in response to the discomfort generated by overbroad applications. According to the applicant, the mark consisted “*of a transparent bin or collection chamber forming part of the external surface of a vacuum cleaner as shown in the representation*”. The graphical representation included two photographs of two separate models of vacuum cleaners with the externally visible transparent collecting bin displayed. In effect, Dyson appeared to be claiming the *concept of a transparent collecting bin on vacuum cleaners* as their trade mark, bolstered by the fact that they had enjoyed a period of patent enabled monopoly for those vacuum cleaners in the marketplace. The UK hearing officer<sup>86</sup>

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83 *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 162, 165 (1995) (Supreme Court).

84 *See*, WIPO Secretariat ‘Trademarks and their Relation with Literary and Artistic Works’ (SCT/16/5) Sep. 1, 2006.

85 For examples, such as a ‘rugby themed restaurant’, *See*, UK TM Registry’s Practise Amendment Notice PAN 7/07 on Signs at <http://www.ipo.gov.uk/t-pan-707.htm>.

86 *Notetry Ltd’s Application* (O29502), UK Trade Mark Registry, Jul. 23, 2002 (Allan James).



objected on the basis that since the sign communicated a functional message it would be unlikely to communicate an origin-indicating message to consumers and therefore lacked inherent distinctiveness.<sup>87</sup> A transparent bin was a feature indicating (i) the cleaner was bagless and (ii) the level of vacuumed up contents, warning the user when it was full. It is interesting to note that the technical function of the bin related to both a lack of distinctiveness (it would be seen as a useful feature and not as a trade mark) and to possible functionality objections. However under UK<sup>88</sup> - and Indian<sup>89</sup> - legislation, functionality objections only apply to shape or 3D marks and Dyson was careful to state that they were not applying for a particular shape. Instead, their application was pitched as a general product feature across their range of vacuum cleaners. On the issue of acquired distinctiveness, it was held that since the bins had not been promoted specifically as individual trade marks, there was no acquired distinctiveness. Customers made loose or temporary associations between the product feature and the first company to market it, but that was inadequate for trade mark purposes.

On Dyson's appeal, the High Court<sup>90</sup> was unpersuaded by the applicant's arguments that a feature which was unique or striking was also inherently distinctive. While most "*consumers sampled spoke of the striking and unusual appearance created by the transparent bin and of why they found that a useful feature*",<sup>91</sup> this was not sufficient for distinctiveness. The signs under consideration were "*descriptive of what the bin, or the machine as a whole, is or does. They say nothing about the machine's commercial origin. The fact that it is a new type of cleaner does not of itself serve to associate it with any particular trader or manufacturer*".<sup>92</sup> However the court was uncertain about the existence of acquired distinctiveness in a situation where a patent monopoly for the product allowed Dyson to be the only producers on the market with that feature. Dyson claimed that during the period of the patent monopoly, the public had come to associate the transparent bin with their company. Should they be allowed to convert a patent monopoly into trade mark rights in this manner? Therefore the court referred the matter to the ECJ, asking for a clarification about the sorts of associations that would satisfy acquired distinctiveness. In particular

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87 In effect the functionality objection was converted into a distinctiveness objection.

88 As reflected in § 3(2) of the UK Trade Marks Act, 1994.

89 § 9(3), Act of 1999.

90 *Dyson Ltd v. Registrar of Trade Marks*, [2003] E.W.H.C. 1062 (Ch) (Court of Justice of the European Communities (Third Chamber)); [2003] E.T.M.R. 77 (Ch D) (Patten J.).

91 *Ibid.*, at 37.

92 *Ibid.*, at 33.

did the transparent bins have to be actively promoted as trade marks during this period or would a vague or loose association between feature, product and source suffice?

In a surprising development, the Advocate General and ECJ<sup>93</sup> evaded the questions referred on acquired distinctiveness and chose to respond by first setting up and then dismantling the claim that Dyson's application qualified as a 'sign'. As "*a concept which appeals to the imagination*" and exists in the mind alone, this was not a sign and therefore could not be a trade mark. The ECJ went on to develop the test for separating abstract concepts from more tangible signs by relying on whether the subject matter could be perceived by one of the five senses. Since according to the EU definition of a trade mark<sup>94</sup> the application fell at literally the first step on the road to registration, it couldn't be saved by acquired distinctiveness. Finally, in parallel Community Trade Mark proceedings, it was decided that the Dyson application failed the graphical representation requirement as the written description and accompanying images did not convey a clear and unambiguous representation of the mark.<sup>95</sup> OHIM emphasised the fact that innumerable permutations and combinations of transparent bins rested upon that one written description with the two rather lonely accompanying photographs. The graphical representation was inadequate.

What is common to all these decisions is the unease that surges through them, driven by the prospect of allowing the applicant to gain a potentially permanent legal monopoly in a functional concept for vacuuming technology. The ECJ explicitly stated in *Dyson* that the sign requirement was a necessary filter "*to prevent the abuse of trade mark law by obtaining an unfair competitive advantage*".<sup>96</sup> Through this application, we see the requirements of a sign (or presumably 'mark' under section 2(1)(m) in India), graphical representation, inherent and acquired distinctiveness and functionality all explored as methods for excluding problematic subject matter.

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93 *Dyson Ltd v Registrar of Trade Marks*, (C-321/03) [2007] E.T.M.R. 34 (European Court of Justice).

94 Article 2 of the Trade Marks Directive 89/104/EEC stated: "*A trade mark may consist of any sign capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings*" (Emphasis added).

95 See, *Dyson Ltd's Application* (R 655/2001-1) Jul. 2, 2002 (Clear Bin). In response, Dyson unsuccessfully attempted to argue before OHIM that the application related to a series of marks.

96 *Dyson*, *supra* note 93, at 34.

### III. SPECIFIC CATEGORIES: COLOURS AND SHAPES

Three dimensional or shape marks as well as single or pure colours are relatively well established categories of non conventional subject matter. They are perhaps the most conventional of the unconventional and over the past few decades, courts have identified specific concerns and developed doctrines in response to them, since the registration of such marks raises the possibility of an unfair legal monopoly being granted to a single producer.

#### A. Colour Marks

Apart from graphical representation difficulties, there are a number of reasons why a cautious approach to the registration of such marks is preferred. To begin with, the issue of whether a pure colour is too abstract to be a sign or mark – in a manner similar to *Dyson* – has been acknowledged. In *Libertel*,<sup>97</sup> the ECJ stated: “[An abstract] colour per se cannot be presumed to constitute a sign. Normally a colour is a simple property of things. Yet it may constitute a sign. That depends on the context in which the colour is used”.

In *Heidelberger*,<sup>98</sup> the court considered the related issue of a combination of two pure colours. Here it was “necessary to establish that in the context in which they are used colours or combinations of colours which it is sought to register in fact represent a sign”.<sup>99</sup> Therefore, to satisfy graphical representation, a mere statement such as ‘Blue and Red’ would not be sufficient. For an application concerning “two or more colours, designated in the abstract and without contours, [these] must be systematically arranged by associating the colours concerned in a predetermined and uniform way”.<sup>100</sup> Even single colours are always applied to particular surfaces in specific ways and the application form should contain this limitation.<sup>101</sup>

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97 *Libertel*, *supra* note 43, at 27.

98 *Heidelberger Bauchemie*, (C-49/02) [2004] E.T.M.R. 99 (European Court of Justice).

99 *Ibid.*, at 24.

100 *Ibid.*, at 33.

101 The Advocate General in *Libertel* was critical of the argument that an abstract colour is specific enough to be a mark. *See at*, *Libertel Groep BV v. Benelux-Merkenbureau*, (C-104/01) [2003] E.T.M.R. 41, 67-68 (Adv. Gen. Opinion), colour is always the attribute of something else. Unlike the signs listed in Article 2 of the Directive, such as words, designs, letters, numerals, the shape of goods or their packaging, a colour alone has no independent existence... it would not be possible to determine precisely how the colour applied for will appear on the goods in relation to which the application for registration is made. It could equally well extend to the colouring of the whole of their external surface or their packaging, or appear on only some of these, or (in the case of very distinct designs) be surrounded by the generic colour of the goods.

Adopting this reasoning, the Draft Manual also suggests that unless “*the colours are used... in a special or particular pattern or arrangement, it is likely to be more difficult to prove that in such cases colour would lend distinctiveness as a badge of origin*”,<sup>102</sup> i.e. the colours may be considered generally decorative or a mere property of things, and not sufficiently distinctive as a trade mark. On the issue of distinctiveness, a more controversial question is whether colours will ever be able to satisfy the inherent distinctiveness requirement. The essential enquiry here is concerned with assessing whether the relevant public encountering the colour ‘cold’ i.e. for the first time ever, will understand it to be performing a trade mark function. For words marks, traditional examples for this are fanciful or invented words such as ‘XEROX’ or ‘KODAK’. For colours, we should not presume too readily that such signs operate as trade marks, since “*there is a public interest in not limiting the availability of colours for other traders*”.<sup>103</sup> Therefore, in following the UK/EU approach, the Draft Manual rightly adopts a cautious stance towards assessing distinctiveness for colours:

As colour per se is not normally used by traders as a means of brand identification, unlike words or pictures, consumers are not in the habit of making assumptions about the origin of goods and services based solely on their colour or the colour of their packaging. *It follows therefore that a single colour will only in exceptional circumstances be capable of denoting the origin of a product or service.* Marks consisting of a single colour will usually be liable to objection under Section 9(1)(a) of the Act because they inherently lack the capacity to distinguish. (Emphasis in the original)

However this approach leaves open the possibility that in exceptional circumstances, a single colour may have inherent distinctiveness i.e. the consumer will assume it is doing the work of a trade mark. By contrast, the US position is that a pure colour can never have inherent distinctiveness; it can only acquire distinctiveness over time: According to the Supreme Court:

A ‘product’s colour is unlike “fanciful,” “arbitrary,” or “suggestive” words or designs, which almost automatically tell a customer that they refer to a brand... [Instead] over time, customers may come to treat a particular colour on a product or its packaging (say, a colour that in context seems unusual, such as pink on a firm’s insulating material or red on the head of a large industrial bolt) as signifying a brand.”<sup>104</sup>

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102 Draft Manual Ch II, at 5.2.1.

103 *Ibid.*, at 5.2.1.2.

104 *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 162-163 (1995).

Under the new trade marks regime, the Indian Registry and judiciary retain the flexibility to adopt the US approach instead of the UK/EU one. Careful thought should be given to this choice and it is submitted that the preferred approach is to always ask applicants to demonstrate acquired distinctiveness in the marketplace before granting registration. The Registry should firmly close the door to the inherent distinctiveness possibility. As far as acquired distinctiveness for colours is concerned, the Manual is clear: “*Wherever the exclusive right to colour is sought, weighty evidence should be necessary to overcome objection under Section 9(1)(a) of the Act.*”<sup>105</sup> Here again, it is important to note that there must be evidence that consumers recognise the colour and use it as a trade mark for specific goods and services, not that they merely associate the colour with the producer. I associate the colour red with Eveready batteries, but also with Vodafone, Virgin and Coca Cola.<sup>106</sup> Loose associations are not sufficient to satisfy distinctiveness, no matter how long the usage has been for.

Two further issues need to be considered with an eye to future litigation. The first is the question of whether colours can also be considered functional. Take the example of the colour pink used on surgical wound dressings, which closely resembles the colour of human skin,<sup>107</sup> or the use of fluorescent yellow on safety clothing. The US has a general doctrine of functionality which includes colour marks, but - as we see in the following Section of this paper - Indian legislation only explicitly refers to functionality based objections for shapes in section 9(3). It is open to the IPAB or the courts to adopt this general doctrine of functionality – used defensively to prevent the registration of marks or revoke them – and apply it to all types of non conventional marks. One can imagine not only functional colours and shapes but also functional scents<sup>108</sup> or tastes<sup>109</sup> and a

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105 Draft Manual Ch II, at 5.2.1.3.

106 Not to mention associating it with sunsets, traffic lights and poorly researched student essays.

107 In *Re Ferris Corporation*, 59 U.S.P.Q. 2d 1587 (T.T.A.B. 2000).

108 Either with technical functionality such as the smell of Odomos, All Out or Good Knight mosquito repellents; or with aesthetic functionality such as the pleasing fragrance of perfumes. Any feature which adds non-trade mark value to a product and is not protected by another IP right should be free to be imitated. This is what ensures a competitive marketplace.

109 In *re Organon, NV* 79 U.S.P.Q. 2d 1639 (T.T.A.B. 2006) (The sign applied for was the flavour orange. The T.T.A.B. held that exclusive rights over a pleasant orange taste would be an important advantage over conventional antidepressant tablets. These pills were designed to dissolve on a patient's tongue; consequently, there is a practical need for the medicine to have an appealing taste).

broad functionality doctrine is a necessary corrective to a broad definition for a trade mark. The second issue considers the possibility of litigation over whether one colour infringes another. Here interpreting the scope of the rights narrowly under sections 28 and 29 will be important, as will defences like descriptive fair use under section 30 (2)(a).<sup>110</sup> Certain colours, such as Green for environmental goods and services, should never be registered<sup>111</sup> and even if they are, others should be allowed to continue using them descriptively. Litigation concerning the use of colour marks has already commenced. BP has litigated on the basis of its registration for a particular shade of green for its service stations,<sup>112</sup> while Cadbury's has been involved in extensive litigation in Australia over the use of purple for chocolates.<sup>113</sup> Once such marks are registered, applying the principles of comparison developed for words or images under infringement provisions will also have to be adapted for colours, shapes and sounds.

### **B. Shapes**

When it comes to shapes, from a comparative perspective two main clusters of issues can be observed. The first cluster concerns establishing distinctiveness for shapes, while the second concerns functionality based objections to the registration of certain types of shapes. Beginning with distinctiveness, the Indian Registry has adopted the EU's position that the same distinctiveness criteria – as required by section 9(1) – should apply for all types of trade marks, including shapes.<sup>114</sup> Here establishing acquired distinctiveness for shape or 3D marks, under the proviso to section 9(1), is relatively straightforward.<sup>115</sup> The Manual adopts

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110 The use is non-infringing under § 30(2)(a) if “*the use in relation to goods or services indicates the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services or other characteristics of goods or services*”.

111 As noted in the Draft Manual Ch II, at 5.2.1.2.

112 BP Amoco Plc v. John Kelly, [2001] F.S.R. 21 (High Court of Justice in Northern Ireland); BP Amoco Plc v. John Kelly, [2002] F.S.R. 5 (Court of Appeal in Northern Ireland) (on appeal).

113 Cadbury Schweppes Pty Ltd v. Darrell Lea Chocolate Shops, [2006] F.C.A. 446 (Federal Court of Australia); Cadbury v. Darrell Lea, [2007] F.C.A.F.C. 70 (Federal Court of Australia); Cadbury v. Darrell Lea, [2008] F.C.A. 470 (Federal Court of Australia).

114 Draft Manual Ch II, at 5.2.5.3.

115 Draft Manual Ch II, at 5.1.3.

A mark that is said to have acquired a distinctive character must be shown to have come to operate as a guarantee of origin. For that to be so consumers must rely on it as a means of returning to the same undertaking if their experience of its products is positive, or to avoid that undertaking if their experience is negative..

the *Windsurfing* factors<sup>116</sup> to help structure the evidence required: the applicant's market share under that mark, the intensity and geographically widespread usage, investment in promoting the mark, evidence of consumer recognition of the sign as a mark and evidence from the trade that the sign is considered to function as a mark. However, one of the fundamental requirements is that the *shape must have been used as a trade mark*;<sup>117</sup> it is not sufficient to claim a shape mark based on evidence of general advertising containing pictures of the product shape and consumer recognition of the associated word mark. If the applicant submits general evidence of advertising expenditure, it could relate to their word mark instead and that is no good. What is needed is evidence that relates precisely to the 3D sign applied for.<sup>118</sup> The evidence must specifically show that the relevant public trusts the shape to indicate commercial origin in the same way that they would trust a word mark.<sup>119</sup> Ultimately, through evidence of acquired distinctiveness, the shape must be able to stand alone as a trade mark.<sup>120</sup>

Turning to inherent distinctiveness, matters are more complicated. It is possible to file for registration on the basis that a shape has inherent distinctiveness, since there is no differentiation between the various categories of marks and the same standards are applied. However, this has an important caveat:

Whilst the legal test for distinctiveness is the same for shape marks as for other marks, recognition must be given to the differing perceptions of the average consumer in relation to non-traditional trade marks. In particular, the average consumer may not as readily accept the appearance of the goods themselves as an indication of trade origin. This is because "average consumers are not in the habit

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116 *Windsurfing Chiemsee GmbH v. Boots- und Walter Huber*, (C-108/97) [1999] E.T.M.R. 585 (European Court of Justice).

117 *See*, 'Mark must have been used distinctively – as a trade mark', Draft Manual Ch II, at 5.1.3.1.

118 *BIC SA v. OHIM*, (T-262/04) [2005] E.C.R. II-5959 (Ct. of First Instance (Third Chamber)) (3D disposable lighter shape application where much of the evidence was only relevant for advertising the word mark 'Bic').

119 The Draft Manual refers to the ECJ's decision in *Philips Electronics v. Remington Consumer Products*, (C-299/99) [2002] E.T.M.R. 81 (European Court of Justice).

120 *Nestlé v. Mars*, (C-353/03) [2005] E.C.R. I-6135, 26 (European Court of Justice) ("*In regard to acquisition of distinctive character through use, the identification... of the product or service as originating from a given undertaking must be as a result of the use of the mark as a trade mark*"); *August Storck KG v. OHIM (Storck I)*, (C-24/05 P) [2006] E.C.R. I-5677, 61- 62 (European Court of Justice) (Where the applicant sought to register the shape of a sweet, a picture of the sweet on the external packaging was considered use to describe the contents of the packet and not use of the shape as a trade mark.).

of making assumptions about the origin of the products on the basis of their shape or the shape of their packaging in the absence of any graphic or word element".<sup>121</sup>

By adopting this understanding of consumer perception regarding shapes, the Manual echoes the findings in the ECJ's *Henkel* decision.<sup>122</sup> As a practical matter, it is therefore difficult for shape marks to establish inherent distinctiveness. Yet according to the ECJ, such distinctiveness is still attainable for a sign "*which departs significantly from the norm or customs of the sector and thereby fulfils its essential function of indicating origin*".<sup>123</sup> The Manual also adopts this position.<sup>124</sup> There is an obvious danger here. The trade mark registry will no doubt be approached by applicants with novel, well designed or highly stylised products claiming that they also function as trade marks. However a shape which is simply different or varies from that of competing products is not inevitably a trade mark. Trade mark law is not to be confused with the law of Design protection. The requirement that the shape departs significantly from the norm *and thereby fulfils* its origin indicating function needs to be taken seriously.

In the EU, unsuccessful arguments to lower this inherent distinctiveness threshold have included suggestions that (a) the 3D sign is simply a variant (or an aesthetically striking or attractive variant) of a common shape and therefore perceptibly different;<sup>125</sup> (b) the distinctiveness threshold is crossed if a 3D sign is simply novel (never been done before);<sup>126</sup> (c) if its components such as geometric shape and color, albeit individually commonplace, combine in non-obvious ways;<sup>127</sup>

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121 Draft Manual Ch II, at 5.2.5.3.

122 *Henkel v. OHIM*, (C-456/01 P & C-457/01 P) [2004] ECR I-5089, 38 (European Court of Justice). This was further endorsed in *Mag Instrument Inc v. OHIM*, (C-136/02 P) [2005] E.T.M.R. 46 (European Court of Justice) (The application was for stylised torch shapes and the ECJ held that while in theory they could have inherent distinctiveness, it was unlikely in practice for this reason).

123 *See*, for instance, the authorities cited in *Deutsche SiSi-Werke v. OHIM*, (C173/04 P) [2006] E.T.M.R. 41, 31 (European Court of Justice).

124 Draft Manual Ch II, at 5.2.5.4 (A "*mark constituted by a shape must be sufficiently different from a shape which is - a) characteristic of the product; b) the norm or customary in the sector concerned*").

125 *Mag Instrument Inc v. OHIM*, (C-136/02 P) [2005] E.T.M.R. 46 (European Court of Justice).

126 *Procter & Gamble v. OHIM*, (C-468/01 P to C-472/01 P) [2004] E.C.R. I-5141(ECJ); [2004] E.T.M.R. 88 (European Court of Justice).

127 *Ibid.* For the combination of features argument, *see also*, *Eurocermex v. OHIM*, (C-286/04 P) [2005] ECR I-5797 (European Court of Justice); *Procter and Gamble v. OHIM*, (T 241/05, T 262/05 to T 264/05, T 346/05, T 347/05, T 29/06 to T 31/06) [2007] E.C.R. II-1549 (Court Of First Instance).



(d) there are sufficient differences between the features of the sign and that of similar products, which is not attributable to a technical reason;<sup>128</sup> (e) the relevant public are specialists and sensitive to minor differences;<sup>129</sup> and (f) where the 3D mark is for everyday consumer products, the average consumer is attentive to minor differences during such purchases.<sup>130</sup> European registries and courts have resisted such arguments and the consistent message is that “*departs significantly from the norm*” will not be watered down. The Draft Manual acknowledges this danger and suggests that for inherent distinctiveness arguments to be successful, some additional factor – apart from the unusual nature of the shape – is required. This could be “*evidence that, contrary to the normal assumption made about consumers habits, consumers in the relevant sector do in fact rely upon the appearance of the shape of the product or its packaging as a means of identifying the origin of the product*”.<sup>131</sup> Thus the formula for inherent distinctiveness for shapes mandates that it (a) departs significantly from the norm and thereby indicates origin; as well as (b) it is applied to goods for which consumers are unusually sensitive to this difference.

The final section of this paper considers the functionality based policy objections to the registration of certain types of shape marks. These policy exclusions override distinctiveness and they are contained in section 9(3):

- (3) A mark shall not be registered as a trade mark if it consists exclusively of-
  - (a) the shape of goods which results from the nature of the goods themselves; or
  - (b) the shape of goods which is necessary to obtain a technical result; or
  - (c) the shape which gives substantial value to the goods.

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128 Henkel v. OHIM, (C-456/01 P & C-457/01 P) [2004] ECR I-5089 (European Court of Justice).

129 Axions and Christian Belce v. OHIM, (T-324/01 and T-110/02) [2003] E.C.R. II-1897 (ECJ); De Waele v. OHIM, (T-15/05) [2006] E.C.R. II-1511 (Court of First Instance); Georg Neumann v. OHIM, (T-358/04) [2007] E.C.R. II-3329 (European Court of Justice).

130 Henkel v. OHIM, (C-456/01 P & C-457/01 P) [2004] ECR I-5089 (European Court of Justice); Procter & Gamble v. OHIM, (C-468/01 P to C-472/01 P) [2004] E.C.R. I-5141 (European Court of Justice); [2004] E.T.M.R. 88 (European Court of Justice).

131 Draft Manual Ch II, at 5.2.5.3. The authority for this proposition is Daimler Chrysler v. OHIM, (T-128/01) [2003] E.T.M.R. 87 (European Court of Justice) (Purchasers of motor vehicles habitually make assumptions about the commercial origin of the vehicle based on external features or shapes.).

Explanation — For the purpose of this section, the nature of goods or services in relation to which the trade mark is used or proposed to be used shall not be a ground for refusal of registration.

These rules mirror Art 3(1)(e) of the EU's Trade Marks Directive and Art 7(1)(e) of the Community Trade Mark Regulation.<sup>132</sup> The basis for these absolute grounds for refusal was identified by the ECJ in *Philips*:

The rationale of the grounds for refusal of registration laid down in Article 3(1)(e) of the Directive is to prevent trade mark protection from granting its proprietor a monopoly on technical solutions or functional characteristics of a product which a user is likely to seek in the products of competitors.<sup>133</sup>

While there has been little judicial consideration of “*shapes which result from the nature of the goods*” (section 9(3)(a)), the rationale for this provision is to keep free basic shapes of goods that should be available for use by the public,<sup>134</sup> and there may be more than one basic shape for those goods which need to be kept free. By contrast, we find a more detailed consideration of the rule that a “*mark shall not be registered... if it consists exclusively of... the shape of goods which is necessary to obtain a technical result*” (section 9(3)(b)). This provision was extensively debated during the *Philips* litigation concerning the shape of a 3-headed electric rotary shaver and two issues arose for consideration:

1. If a shape has both technical features as well as non-technical features, is it still a shape *exclusively* orientated towards a technical result? Alternatively, if the shape also has some non-technical (i.e. stylised or capriciously chosen) features, should it escape this prohibition? The ECJ's response was that the first step is to identify the ‘essential characteristics’ of a shape. All of the shape need not be technical, but if its essential characteristics were technical, then the prohibition applied.<sup>135</sup>
2. What was the significance of *necessary*? Philips argued that other possible shapes existed for electric razors and the triangular shape it had chosen

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132 Council Regulation (EC) No 40/94 of 20 Dec 1993 on the Community Trade Mark L 11, 14/01/1994 p. 1. This has been recently replaced by Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community Trade Mark.

133 *Philips*, *supra* note 82, at [78].

134 *Philips v. Remington*, [1999] RPC 809, 820 (CA) (Aldous LJ). This position is also followed in the Draft Manual Ch II at [5.2.5.1]. Further guidance on this provision can also be found in *Société de Produits Nestlé v. Unilever*, [2002] EWHC 2709 (Ch) (Shape of the ‘Viennetta’ ice cream).

135 *Philips Electronics v. Remington Consumer Products*, (C-299/99) [2002] E.T.M.R. 81 79-80 (European Court of Justice).

was not the only possibility. Since choices and alternatives existed, its shape was not 'necessary' i.e. the only possible way to achieve that result. However the ECJ adopted a causal understanding of this requirement – where 'the essential functional characteristics of the shape of a product are attributable solely to the technical result' i.e. where the shape was chosen with a technical end-result in mind, this was sufficient to attract the prohibition.<sup>136</sup>

In a recent application of the *Philips* principles, the ECJ Court of First Instance's (CFI's) recent *Lego* decision<sup>137</sup> has confirmed that 'exclusively' and 'necessary' are to be interpreted purposively, in order to give some teeth to this prohibition. Lego, in their ongoing quest for eternal life under the shelter of IP law, had applied to OHIM to register the shape of their familiar toy bricks as a trade mark. The bricks are constructed so as to reconcile the competing technical demands of interlocking securely enough to build a structure, whilst also being easily pulled apart by a young child. The court adopted the approach to these exclusions set out in *Philips*: 'exclusively' suggested that the essential characteristics or features of a shape should achieve a technical result (as opposed to requiring that *all* of the shape produces a technical result), and 'necessary' meant that there should be a causal connection between the shape chosen and the desired result (the existence of other available shapes did not matter). This decision is also interesting for its analysis of the points of intersection between patent and trade mark law in this area. However its significance lies in the articulation of a test to identify the 'essential characteristics' of a shape. Lego proposed that such features or characteristics 'must be determined from the point of view of the relevant consumer and not by experts according to a purely technical analysis'.<sup>138</sup> The CFI disagreed with this 'eye appeal' test and adopted a more teleological approach.<sup>139</sup> The court concluded that:

The 'perception of the target consumer is not relevant to the analysis of the functionality of the essential characteristics of a shape. The target consumer may not have the technical knowledge necessary to assess the essential characteristics of a shape and therefore certain characteristics may be essential from his point of view even though they are not essential in the context of an analysis of functionality

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136 *Ibid.*, at 83.

137 *Lego Juris v. OHIM, Mega Brands*, (T-270/06) [2009] E.T.M.R. 15 (European Court of Justice).

138 *Ibid.*, at 52.

139 In doing so, they have departed from the 'eye impact' approach previously adopted by the UK courts. *See, Koninklijke Philips Electronics v. Remington Consumer Products & Rayovac*, [2006] E.W.C.A. Civ. 16 (Court of Appeal (Civil Division)).

and vice versa. [These characteristics] must be determined objectively... on the basis of its graphic representation and any descriptions filed at the time of the application for the trade mark'.<sup>140</sup>

*Lego* is also noteworthy because it raises an issue considered by the US Supreme Court in *Traffix Devices*,<sup>141</sup> namely the evidentiary significance of a pre-existing patent relating to the shape being claimed as a trade mark. The US decision established that a "prior patent... has vital significance [and] is strong evidence that the features therein claimed are functional".<sup>142</sup> *Lego* had a patent relating to the grip-and-release technical features of the brick and, while this did not establish an irrefutable presumption, the CFI confirmed that a prior patent can be used as evidence that the essential characteristics of the brick were functional.<sup>143</sup> It is suggested that the Indian Registry should adopt the US approach to prior patents, since it sets up a rebuttable presumption that the shape is functional and then shifts the burden on to the applicant to then argue that the essential characteristics of the shape are not covered by the patent.

The final policy exclusion is for shapes which "gives substantial value to the goods" (section 9(3)(c)). The Draft Manual is clear on the policy basis for this exclusion: "This provision is intended to prevent the securing of a permanent monopoly in the type of design of goods which should be protected under Designs legislation, limited in length of time".<sup>144</sup> The Manual is clear that certain purely ornamental products such as jewelry will be caught by this provision. However, for other stylised shapes, it is "appropriate to consider whether a substantial proportion of the value of the product to the consumer is attributable to its shape. In many cases this will require a comparative evaluation of the value of the shape in question as compared to those used on competing products".<sup>145</sup> Here, a more detailed and helpful test can be found in a recent OHIM Board of Appeals decision concerning an attempt to register pencil (or organ pipe) shaped loudspeakers. In *Bang and Olufsen*,<sup>146</sup> the Board decided that since the speakers added substantial value, registration as a trademark would circumvent the limited duration of design or copyright protection otherwise available for such

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140 *Lego Juris v. OHIM, Mega Brands*, (T-270/06) [2009] E.T.M.R. 15, 70 (Court of First Instance).

141 *Traffix Devices v. Marketing Displays*, 121 S. Ct. 1255 (2001) (Supreme Court).

142 *Ibid.*, at 1260.

143 *Lego Juris v. OHIM, Mega Brands*, (T-270/06) [2009] E.T.M.R. 15, 86 (Court of First Instance).

144 Draft Manual Ch II, at 5.2.5.3.

145 *Ibid.*

146 *Bang & Olufsen* (R 497/2005-1) Sep. 10, 2008, OHIM 1st BoA (Unreported), available at [http://oami.europa.eu/LegalDocs/BoA/2005/en/R0497\\_2005-1.pdf](http://oami.europa.eu/LegalDocs/BoA/2005/en/R0497_2005-1.pdf).

aesthetically attractive shapes. Significantly, the test for 'substantial value' adopted by the Board was to enquire whether the shape "*has the potential to determine to a large extent the consumer's behavior to buy the product... [i.e.] where the shape is the only or one of the essential selling features of the product*".<sup>147</sup>

As to whether consumers were moved to buy the product because of its design features, the Board identified two pertinent questions: (a) What relevance does the manufacturer give to the shape of the product as a marketing tool? Here look at the applicant's own statements in advertisements, trade literature etc. (b) Do 'consumers actually buy the product for its aesthetic value'? Here the registry should look at empirical evidence from the retail sector. With this final policy exclusion, we conclude our survey on shapes.

#### IV. CONCLUDING OBSERVATIONS

In reading interviews of Indian practitioners on the registration of non conventional shape marks in India, one is immediately struck by the sense of excitement at the possibilities. There is a palpable sense that Indian trade mark law has finally caught up with modern marketing techniques.<sup>148</sup> What one does not see discussed is the host of puzzles and anti-competitive concerns that such subject matter raises. By raising these issues, this article seeks to introduce some balance to the discussion. Registries and court around the world are adopting a cautious approach to such subject matter. The Draft Manual picks up on several of these issues and provides a robust structure within which to allow the gradual evolution of principles in this area. It should prove to be a valuable and flexible resource. Non conventional marks are remarkably unsteady badges of origin and rarely used without additional word or figurative marks to back them up. No manufacturer of mineral water is likely to do away with the company name or brand and rely solely on the shape of the bottle when selling the product. Additionally, the thought of a single manufacturer claiming exclusive rights to a colour across a wide range of goods and services is an unwelcome one. Such marks should therefore be given a cautious reception.

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147 *Ibid.*, at 24.

148 See for e.g., M.S. Nair *Sounding the Bugle of Non-Conventional Marks in India*, Sep. 2009 ("*Trade mark law in India is widening its horizons to include marks of various kinds in the Indian trade mark register. The registration of trade marks is essential owing to the brand association developed with customers.*") P. Manoj, *Supra* note 4; (Anand & Anand referred to the grant of Yahoo's sound mark as "*a very healthy development for the country*" while according to Majmudar & Co, "*it is welcoming to note that India's trade mark office recognizes the intellectual property involved in the sound bites which are used as source identifiers of goods and services*").