

Registration of Non-Traditional Trademarks

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The paper deals with the issue of registrability of various non-traditional trademarks. Non-traditional trademarks include sound marks, odour marks, colour marks, shapes and taste marks. The paper examines the question of registrability of different types of non-traditional trademarks in different jurisdictions like US and EU by referring to landmark cases and provisions in their respective legislations. Some of the interesting cases that have been discussed include the *Harley-Davison* case, *Sieckmann* case, *Shield Mark* case, etc. Presently, there is no law governing non-traditional trademarks exclusively, in India. In the light of European Court of Justice (ECJ) jurisprudence and the law evolved by US courts, the author has tried to draw a picture of the future of non-traditional trademarks in India and analysed whether it could be registered or not. Reference is made to the prevailing Trademarks Act in India and the Rules framed under it. The paper also identifies reasons why non-traditional trademarks especially in case of unconventional sound marks, taste marks, odour marks, etc. might not get adequate acceptability as registered trademarks in the Indian Trademarks Registry Office.

Keywords: Non-traditional trademark, registration, registrability, graphical representation, Trademarks Registry Office, distinctive trademark, functional trademark, secondary meaning.

A trademark is a type of industrial property which is distinct from other forms of intellectual property, which is used to distinguish a business or services. Conventionally, a traditional trademark comprises a name, word, phrase, logo, symbol, design, image, or a combination of these elements.¹ However, there are certain other 'non-traditional' trademarks which have gained prominence in recent times and include sound marks, odour marks, colour marks, shapes and taste marks.

In US, the Lanham Act's definition of 'trademark' encompasses non-traditional marks by not excluding them. It includes 'any word, name, symbol, or device, or any combination thereof' that identifies and distinguishes the goods and services of one person from those of another and indicates their source. The Supreme Court has made it obvious that trademark might include anything that is capable of having some meaning.² On the other hand, the UK Trademark Act in Section 1(1) defines trademark as 'any sign capable of being represented graphically which is capable of distinguishing goods and services of one undertaking from that of other undertakings. A trademark may in particular consist of words, designs, letters, numerals or shape of their goods or packaging'. Thus, unlike

the US position, there is a restriction in UK as to what could possibly constitute a trademark.³ The Article 15.1 of TRIPS Agreement makes a requirement that 'any sign or combination of signs' can be registered as a trademark although it might be required that the mark be 'visually perceptible'. Under EU law, a sign must be capable of being presented graphically in addition to which it must be clear, precise, self-contained, easily accessible, intelligible, durable, objective, distinctive and not deprive the trade or the public of signs that the directive or regulation implies should be free to all.⁴ In India, Section 2(1) (zb) of the Indian Trademarks Act specifies that any mark which is distinctive i.e. capable of distinguishing goods and services of one undertaking from another, and capable of being represented graphically can be a trademark.

Registration of a trademark helps to instill consumer confidence and prevent confusion about the source of products sold under a trademark. Consumers rely on trademarks in most cases where it is difficult to inspect a product quickly and cheaply to determine its quality.⁵

The greatest need for using non-traditional trademarks arises because market-savvy companies want to design and advertise their products in such a manner that it appeals to the consumer's aesthetic sense. However, while a non-traditional mark is also

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entitled to protection as much as a conventional trademark, there are certain underlying problems with the nature of such marks that impede the registration process.

Requirements for Registration of a Trademark

According to Article 2 of the European Directive⁶ and as under the UK Trademarks Act, 1994, the three main requirements for being registered as a trademark are as follows:⁷

- (a) The trademark should be a sign or anything that can convey information.
- (b) The sign should be capable of distinguishing products or services of one undertaking from that of another. This is clearly a requirement of distinctiveness of trademarks.
- (c) The trademark is capable of graphical representation.

Graphical representation of a trademark is undoubtedly an administrative requirement for the purposes of precise identification in the Trademarks Registry. The requirement of graphical representation is thus helpful both to the traders and the people in the Registry office.⁸ Obviously, a clear and precise graphical representation ensures that all the rights and liabilities established under the Act can be availed of.⁹ Article 15 of the TRIPS, 1994 however deviates from the criteria of graphical representation and emphasizes on 'visual perceptibility' on the other hand.

The US Patents and Trademarks Office (USPTO) have stated that any non-traditional trademark can be registered as long as it distinguishes the source of the product and is not functional or descriptive,¹⁰ implying that a non-traditional trademark cannot perform a utilitarian function. With respect to functionality of a given trademark, a few guidelines have been laid down by the USPTO.¹¹

Types of Non-Traditional Trademarks and Their Registrability

Smell Marks

The most striking factor about an olfactory mark is that it cannot be perceived visually. Does that mean an olfactory mark cannot constitute a trademark at all? This question was considered for the first time in the *Sieckmann* case¹² before the European Court of Justice (ECJ) which held that visual perception is not

necessary as far as the mark can be graphically represented. A trademark is registrable in EU if the graphical representation of the mark is self-contained, durable, objective, intelligible and accessible. The requirement of a mark being perceived unambiguously by one and all thus becomes a mandatory requirement for registration, absence of which might lead to infringement. The ECJ, while examining whether a 'balsamically fruity smell with a slight hint of cinnamon' was registrable, concluded that at present, odours cannot be represented graphically as per the legal requirements and therefore cannot constitute trademarks in accordance with Article 2.¹³ Further, the ECJ expressed doubts as to whether the given description of the smell was precise enough to indicate its distinctive character. It also stated that a mere description of the smell would often not suffice for registration neither would a chemical formula¹⁴ or the deposit of a sample.

In the case of *R v John Lewis*,¹⁵ the UK Court refused an application for 'the smell, aroma or essence of cinnamon' as a trademark for furniture as the verbal description of a smell was not enough to make a graphical representation. But the case would have been different if this had been done with reference to certain standards.¹⁶ The smell of fresh cut grass for tennis balls was registered as a European trademark, and the odour of beer for dart flights and of roses for tyres have been registered as trademarks in UK.¹⁷ However, it is possible to criticize these trademark registrations in light of the *Sieckmann* case. One of the most fundamental questions that arise is whether freshly cut grass smells uniformly the same on all occasions and whether a normal person can clearly identify the differences in the smell. The argument that all sensory perceptions are subjective including sound, taste and colour is not completely adequate to counter the requirements under EU trademark law. Thus, for all practical purposes, it is almost impossible to register olfactory marks in Europe as of now till further advances are made in technology.

In US, the Trademark Manual of Examining Procedure (TMEP) allows that a mark such as scent and sound that cannot be graphically represented can be explained by a written detailed description. In the case of *In Re Celia Clarke*,¹⁸ the Court recognized that smell marks can also be registered as trademarks when it accepted an application for registration of 'a high impact, fresh floral fragrance reminiscent of

Plumeria blossoms' for sewing thread and embroidery yarn. Here the Court made a distinction between a fragrance that is used which is not an inherent attribute of the product and fragrances for products like perfumes, cologne etc. where the smell is an essential ingredient of the product. The argument was premised on scents being comparable to colours and hence being registrable.

An argument has however been made that this judgment was due to ignorance of osphresiology, the science of smells and scents. Scientific evidence points to the contrary and such a comparison between smell and colour is misleading.¹⁹ Temperature, humidity, and wind conditions can all strengthen or weaken the potency of a scent. Even spectral analysis of scents fails to make out an accurate standard for trademark registration. Further, scents have no independent identity, but rather must be associated with other memories to enable recall. Detection and recognition of scents depends on individual sensitivity, which is affected by 'personal variables' that include natural predispositions, such as physical and mental abilities, and state of an individual's health.¹⁹

Although a *prima facie* look at the ECJ jurisprudence to suggest that there is absolutely no way of graphically representing sound marks, recent findings by two Nobel laureates, Dr Richard Axel and Dr Linda Buck suggest that a similar system such as the Pantone system can be evolved based on the 'odourant pattern' formed when each odorant molecule activates every receptor.⁹ But, whether this can satisfy the *Sieckmann* test, remains to be seen in the light of the arguments mentioned previously. Mark owners should note that even if a scent mark is registered, enforcement is likely to be difficult.²⁰ Further, proving that consumers perceive a particular scent as a source-indicating trademark rather than merely an appealing feature of the goods or services is a difficult task.²¹ In addition, description of scent marks registered with the USPTO are relatively vague and a court may have difficulty enforcing the scent of 'bubble gum,' 'cherry,' 'grape' or 'strawberry'.²¹

Neither TRIPS nor EC Directive, nor community trademark (CTM) address protection for scent marks. Some countries like Australia, France, Germany do not prevent such kind of registration, leaving the options open. However, in other jurisdictions like Mexico, South Korea, Brazil, Japan, India, etc. scent marks are neither registrable nor have the courts

considered protection of scent marks under intellectual property rights regime.²²

Sound Marks

Sound marks can be inherently distinctive or non-inherently distinctive. While unique sounds do not require to be proved to have a secondary meaning, the same would not be true for commonplace sounds. The ECJ in the *Shield Mark* case²³ dealt with the registration of sound marks. The Court held that sound marks were registrable but the requirement of graphical representation along with distinctiveness of sound had to be met with. It further stated that written description of a sound, onomatopoeia and musical notes were not enough (as in this case, the Dutch onomatopoeia for a cockcrow). In the given case, however, the Court did not lay down appropriate mode of representation for the sound of a cockcrow or any other sound, leaving it to a particular country to decide on its particular requirements. However, the Court indicated that whatever be the mode of representation, it should be clear, precise, self-contained, easily accessible, intelligible, durable and objective. The problem with written sound marks like notations is that while it might indicate pitch, it will not indicate the tone. The other option of digital recording has been rejected by INTA for practical difficulties.⁹ The best approach seems to be to adopt a middle path between the stringent *Shield Mark* case approach and the extremely liberal stance adopted by a few courts in the US and Canada.

In 1950, NBC successfully registered the musical notes G, E, C played on chimes as a trademark for its radio broadcasting services. Other sound trademarks include the MGM lion's roar, the song 'Sweet Georgia Brown' for the Harlem Globetrotters basketball team, the spoken letters 'AT&T' with a distinctive musical flourishing in background, and the beneficial financial services jingle. Despite the successful registration of trademarks in sounds, the USPTO reports that only 23 of the more than 7,29,000 trademarks in force in the United States are sounds and since 1946, there have only been 71 applications to register sounds as trademarks or service marks.²⁴

References might be made here to Harley Davidson's attempt to register 'the mark consisting of the exhaust sound of the applicant's motorcycles, produced by V-Twin common crankpin motorcycle engines when the goods are in use' as a trademark. This rather unconventional application brought into

light several questions regarding registrability of sound marks. Although the exhaust roar of Harley Davidson's motorcycles seems to be very characteristic, Japanese manufacturers, Suzuki, Kawasaki, Yamaha, and Honda, as well as American manufacturer, Polaris objected saying that other motorcycles can also make similar sounds. Further, it was not necessary that all motorcycles of Harley-Davidson would produce a similar sound.²⁵

The TRIPS Agreement, EC Directive and CTM are all silent on sound marks. The INTA Resolution 1997 on the inclusion of sound marks as registrable marks has analysed various impediments to the registration of sounds as trademarks, such as, enforceability, functionality of such sounds, problems of graphical representation and physical affixation which they say can be solved with the help of traditional trademark principles. More or less, INTA seems to have maintained the position that sound that is connected with a product or service may serve as a trademark and therefore, in appropriate circumstances, should be entitled to trademark recognition, protection and registration in the same way and subject to the same standards as any other trademark. Sounds can be an important element in branding and corporate identification. Sounds can help consumers distinguishing a particular service or product from another. Whether a specific sound has the ability to function as a trademark, is a question of fact in each case.²⁶

The Section 103(2) of the 1994 UK Trademarks Act does not specifically exclude or include sound marks as a registrable trademark. Since, the UK Act allows for the representation of a trademark by means other than graphical representation, the possibility of having sound marks exists. Thus, it is upon the applicant to prove that a particular sound mark can function as a trademark.²⁷

Colour Marks

When it comes to recognition of a combination of colours, it is unproblematic as it has been explicitly accepted by legislations and cases as distinctive by itself.²⁸ The issue remains singularly focused on cases involving use of a single colour as a trademark. The ECJ discussed this issue in the *Libertel* case.²⁹ The problem with respect to using a single colour as a trademark seemed obvious but the Court's main emphasis was on the issue of graphical representation of the colour marks. While the Court rejected

deposition of a single sample of a colour, it said that a verbal description could suffice under certain circumstances. Also, the Court recognized existence of an internationally recognized colour identification code like the Pantone Code which is a commercial system that designates specific shades numerically and categorizes over thousands of shades by unique codes. Further, since the Court made a requirement of distinctiveness for colour marks, a need for prior use came into being. Thus, it becomes clear that in order for a colour to be a trademark, the test is three fold- functionality, source indication and distinctiveness.²¹

The US Supreme Court first recognized validity of non-traditional trademarks and trade dress in *Qualitex Co v Jacobson Products Co*,³⁰ where the Court held that colour may be used as a trademark when it has acquired secondary meaning. This indicates that a colour by itself cannot be inherently distinctive. To assess whether a colour has acquired secondary meaning, the following factors have to be considered:

- (a) Extent of third party use;
- (b) Any kind of sales and advertising of the product should direct the attention of the consumer towards the colour of the product; and
- (c) Consumer studies and surveys should indicate towards the importance of the colour. Even for something like drug capsule colours, the trend seems to be to see not whether the colour is functional in the utilitarian sense but rather whether the colour has become a generic indication of a type of drug regardless of source.³¹

Here, references might be made to the traditional rules which were clearly out ruled in the abovementioned case. The traditional rule was supported by the rationales of 'colour depletion' and 'shade confusion'. The 'colour depletion' rationale posited that there were only few discernable colours and once all of them are taken into account, the new entrants might be deprived of taking part in the competition.³² The 'shade confusion' rationale posited that the determination of the issue of likelihood of confusion between shades of colours was too elusive and subjective.¹⁰

Taste Marks

They have to be treated in a manner similar to smell marks. The other issue that has been addressed

very often is that the TMEP should exempt the graphical requirement for taste marks as they are similar to scent marks. In a certain case, a Netherlands corporation tried to register orange flavour for pharmaceuticals but the USPTO did not allow it saying that it did not indicate source of goods nor was it distinctive in nature.¹¹ Further, orange was considered to be functional in nature. The other important case in this regard is *Eli Lilly's* case where a company tried to register artificial strawberry flavour as a gustatory trademark for pharmaceutical products.³³ In that case, the Court implicitly recognized that taste marks could be registered as trademarks. However, particular trademark application was not allowed as it was found that most pharmaceutical companies added artificial flavours to their medicines to disguise the unpleasant taste and therefore, granting exclusive right to the appellant to use this 'sign' would unduly interfere with the freedom of appellant's customers. The other important issue was that most customers would not recognize the strawberry taste as a trademark for a product but only regard it as a method of disguising the unpleasant taste of the medicine.

One substantial impediment to enforcement of flavour marks is functionality because they need to be available to all competitors. Examples would include mint toothpaste for adults and bubble gum toothpaste for kids. Flavours may also be found to be generic because they are used frequently by different manufacturers. Only an unusual flavour like melon or caramel or peanut butter added to a toothbrush or dental floss would be more likely to be protected than the same for cookies or bread.²¹ In *Eli Lilly's* case, the Board also debated on the issue of how taste marks could be represented without reaching a specific conclusion. However, it can be safely assumed that graphical representation for taste marks will be required to meet the standards set for sound and smell marks, in which case it might be difficult to get recognition for taste marks in most cases.

Shapes

While not defined under the Lanham Act, the term 'trade dress' originally, denoted the distinctive appearance of a product including labels, wrapping, and containers used to package a product. However, modern practice has included shape and design of the product in the concept of 'trade dress'.³⁴ In US, shape of the product itself may be a trademark, if it has acquired distinctiveness and is not functional.³⁵

Product designs and shapes are not inherently distinctive and therefore require demonstration of secondary meaning. One of the most popular shape trademarks of all times is that of the Coca-cola bottle. The unique contour bottle, familiar to consumers everywhere, was granted registration as a trademark by the USPTO in 1977. It is widely believed that most customers associate shape of the bottle with Coca-cola because of which it can be said that the shape is distinctive and has acquired secondary meaning.³⁶ Going by the criteria that the US Courts have followed since then, there is a possibility that the Coca-Cola bottle along with the written flowing script of Coca-cola would still get trademark protection today, based on the distinctive packaging of the product and its high level of recognition amongst its users.

In the case of *Wal-Mart Stores*,³⁵ the Supreme Court distinguished between product design and packaging and held that the former can never be inherently distinctive. Thus, in order to register a shape as a trademark, the following factors need to be examined:

- (i) Whether the shape represents a functional feature of the product itself
- (ii) Whether acquired distinctiveness exists

In the case of *Gibson Guitar Corp*,³⁷ the Sixth Circuit stated that trademark and trade dress are two distinct legal concepts, and while the Lanham Act defines a trademark, trade dress is not explicitly defined in the Act.³⁸ Citing the Supreme Court, the Sixth Circuit described trade dress as the 'design or packaging of a product which has acquired a secondary meaning sufficient to identify the product with its manufacturer or source.' An applicant seeking a trademark registration for product packaging must prove both that the trade dress is inherently distinctive and has attained secondary meaning and that it is not functional.²¹

In UK, regardless of factual distinctiveness, registration as a trademark must be refused under Section 3(2) of the 1994 Act to a sign which consists exclusively of the shape:

- (a) which results from the nature of the goods themselves,
- (b) of goods which is necessary to obtain a technical result, or
- (c) which gives substantial value to the goods.³⁹

This becomes clear in the light of dictum in the ECJ in *Philip Electronics v Remington Consumer Product Limited*⁴⁰ where it was held that shapes which are functional and have a technical use such as the shape and configuration of an electric shaver cannot be registered as trademarks. Besides, protection of trade dress has, in recent years received express recognition in a number of international treaties like TRIPS [Article 15(2)], Article 1708 of NAFTA, Articles 2 and 4 of the European Trademark Harmonization Directive and Article 6 of the Mercosur Protocol. The Indian Trademarks Act, 1999 also specifically recognizes trade dress.²²

Indian Position on Non-Traditional Trademarks

As per Section 18 of the Indian Trademarks Act, any application for registration of a trademark should be in compliance with the Rules. According to Rule 25(12) (b) of the Trademark Rules, 2002, the application for registration of a trademark for goods and services has to be such that it can be depicted graphically. Further, Rule 28 makes it clear that the trademark should be such that it can be represented on paper. Rule 30 further makes a specification to the effect that the graphical representation made should be durable and satisfactory. In addition to this, what needs to be remembered is that Rule 29(3) makes it explicit that three-dimensional marks can also be registered and so can a combination of colours. Section 9(3) makes exceptions to registrability of shapes as a trademark if it results from the nature of goods, or to obtain a technical result or where the shape gives substantial value to the goods. It might also be noted that Section 2(1) (m) of the Trademarks Act defines mark to be an inclusive definition consisting of shapes and packaging of goods or a combination of colours.

In the light of all these provisions, one may say that while it is possible to include a lot of non-traditional marks within this definition, the requirement of graphical representability seems to be an impediment. This inevitably means that 'anything goes' approach adopted by the American Supreme Court would be inconsistent if applied to India as the definition of trademark is restrictive in nature. The case laws are mostly silent in this regard except in the matter of shapes and hence a lot depends on the interpretation of the Rules and the prescribed forms. It is likely that Indian Courts in the future might adopt the *Sieckmann* approach and hence under such circumstances,

registrability of a trademark will be contingent on several factors including the graphical representability of a non-traditional trademark, and whether it is durable or satisfactory.

The Indian Courts for the first time dealt in depth with a trade dress case in *William Grant & Sons Ltd v Mc Dowell & Co Ltd*.⁴¹ This case dealt with an action of passing off and for the first time recognized importance of trade dress vis-à-vis a trans-border reputation. With regard to shapes, the settled position of law is that trade dress needs to be distinct and must have acquired secondary significance. The Indian Courts have also addressed the issue of use of a single colour and has categorically stated that a single colour cannot be inherently distinctive.⁴² Recently, Cadbury's tried registering purple colour as their trademark but it was not accepted.⁴³ However, with regard to a combination of colours, the position is clarified by statute and the requirement of colours having acquired secondary significance like that of the white and red in the case of 'Colgate' dental products along with the inscription of Colgate in a certain manner seems uncontroversial.³²

With regard to other non-traditional trademarks such as smell and taste marks, there seems to be no case law whatsoever and this issue remains fairly unexplored. However, requirement of graphical representation makes registration difficult. With regard to sound marks, there however exists a possibility of registration under Indian trademark law as 'visual perceptibility' is not a criterion and there are methods of representing sound marks graphically in a durable and satisfactory manner. However, this area also remains equally unexplored.

Conclusion

While trying to expand the ambit of the kinds of trademarks, the *Sieckmann* approach in Europe has ensured that the Courts adopt a stringent test for the graphical representation of a trademark. While this is extremely helpful in avoiding any controversies for registrability of non-conventional trademarks, it may push out cases where business competition and consumer base expansion warrants use of such marks.⁷ At the same time, the American approach of 'anything goes' attitude along with the requirement of accurate description of non-traditional marks seems to be completely unsuited to the legal environment in countries like India, the main reasons being the way 'trademark' and 'mark' have been defined coupled

with the requirements for registering a trademark. The tenor of the decisions of the Court along with the definitions seems to suggest that the judiciary is keen to facilitate registration of non-traditional trademarks.⁴⁴

Considering the kind of legislation in India with regard to trademarks and the stringent need of graphical representation of any trademark, non-conventional trademarks might not become prominent in the commercial market. The advances in technology will be vital for graphical representation of a sensory trademark. At present, the Trademarks Registry Office in India may not be enabled enough to allow registration by using updated scientific measures. Besides, the basic purpose of a trademark is to indicate the origin of a product, which inevitably leads us to the rationale put forth by the conservative school of thought that believes that sense-based trademarks are neither distinctive nor do they indicate a source under most circumstances thus leading to consumer's confusion.⁵

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