

The Non-Conventional Trademarks and Their Registration Challenges

Yashodhara Pattanaik

Research Scholar, Faculty of Legal Studies, SOA National Institute of Law, Siksha O Anusandhan (Deemed to be) University, Odisha, India.

Abstract—Non-Conventional Trademarks are no ordinary types of marks; they challenge the IPR world with their presence and are redefining the definition of trademark. Found in various forms such as smell, shape, color, sound and dimension, the general public seems to love these kind of marks more than the conventional ones. However, despite their unique and public engaging approach, they bring forth plethora of challenges for registration. In this study we shall understand about these new kinds of marks and their registration capabilities; and even though they scream difficulty they are indeed interesting and seem to be promising that they'll be the new age marks, the trend setter.

I. INTRODUCTION

Trademarks are that intellectual property which shows ownership of a particular product. A sign of TM or ® is used besides the brand to show the ownership. Since the onset of intellectual property, trademark has been a significant type of right that guarantees protection to the owner of the mark. In these recent years, there has been evolution in the types of marks. These are no ordinary types of marks; they challenge the IPR world with their presence and are redefining the definition of trademark. With having creativity at its peak in them, these are new world marks that products are using and consumers are excited to see and feel these one of a kind marks.

Trying new things might result in a good or bad. The trial in using these new kinds of trademarks although is still ongoing, but the results seem promising. To keep consumers with them brands are using these new kind of marks to entice them, even if they are difficult to cultivate and get registered; brands are confident in its use to lure the customers especially the Gen Z who are impatient and want a fix to everything that's boring.

II. OBJECTIVE AND METHODOLOGY

The present research work is explanatory in nature. The objective of this research work is to understand about the non-conventional trademarks that are being discussed in the IPR domain. Though the topic is at nascent stage in the IPR field, I've made sure to highlight the need for continuous research. With the onset of various forms of trademarks, I am very delighted to know about non traditional trademarks as this research has drastically changed my perspective about trademarks. Not limiting to traditional marks, these new age trademarks are more fun and captivating in the eyes of a consumer although they have more to research. The present topic is purely doctrinal and thus, uses only secondary sources. Therefore, I have made use of articles, commentaries and of course the Internet sources only.

III. DISCUSSION

3.1 Non-Conventional Trademark – The What?

From Kingfisher to Titan, from BMW to 501 cigarettes; one can see trademark all around. Be it a multi-star restaurant or a small tea shop, trademarked products can be found any and everywhere in our country. Bvlgari, Mercedes, McDonald's, Laneige, Ballantine, Bata, Bisleri, Surf Excel, GoDaddy, Tanishq, you name it. Thanks to the TRIPS agreement signed by India on the 1st of January 1995 every brand name, trademark, service mark will get protection, recognition and indefinite renewal of trademark. But even after the daily meet some might not know what trademark is.

Trademark is a type of intellectual property with an objective to protect and prevent unfair competition among parties in the trade market. It's a sign or an indication that declares ownership of the product belonging to a specific brand or company.

The general definition says trademark is *any symbol, word or combination thereof used to represent or*

identify a product. Trademark Act 1999 defines trademark in sec. 2 (1) (zb) as 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; and—

- (i) in relation to Chapter XII (other than section 107), a registered trade mark or a mark used in relation to goods or services for the purpose of indicating or so as to indicate a connection in the course of trade between the goods or services, as the case may be, and some person having the right as proprietor to use the mark; and
- (ii) in relation to other provisions of this Act, a mark used or proposed to be used in relation to goods or services for the purpose of indicating or so as to indicate a connection in the course of trade between the goods or services, as the case may be, and some person having the right, either as proprietor or by way of permitted user, to use the mark whether with or without any indication of the identity of that person, and includes a certification trade mark or collective mark

The types of marks we usually see are in the form of words like Titan, logos like Kellogg's K, numerals like 555 detergent bar, packaging like Frooti, slogans like Vimal Pan Masala. But it's seen in these recent years there's a change in trend. It was and is a necessary criterion that a mark that is to be trademarked should be capable of being represented graphically in paper form. There are also some marks that do not fall under the normal category of trademarks as mentioned by WIPO. Then what about those which cannot be graphically represented like, sound marks or smell mark or shape mark; and those who do not match the standard set for being a trademark like color marks or motion marks. There are quiet many different types of marks that cannot get any recognition due to merely being different than the conventional types of marks. Being different from the traditional marks, they hold less space in the IPR world. But the change in trend made them the talk of the town. These different trademarks also be addressed as non-conventional trademark, are the marks that do not follow the traditional norm also

defying the trademark criteria. Trademarks are generally words, phrases, logos and symbols used by producers to identify their goods. However, shapes, sounds, fragrances and colors may also be registered as trademarks. These non-conventional trademarks changed the flow of the stream.

How can fragrance be graphically represented? Should we just start sniffing?

What about sound marks? All ears open.

Then what about taste? Do we have to lick it?

Can a particular type of packaging be considered as an IP product even?

Questions are piling up in our conservative brain as to how such things can be trademarked. Whether they can truly be trademarked even? DevGangjee in Non-Conventional Trade Marks in Indiataalks about the graphical representation criteria of trademark and how that affects these non-conventional marks. These not so traditional trademarks are sure a challenge when it comes to registering them. Like it's obvious that a smell marks cannot be graphically represented; so does the sound marks and taste marks. We need to see them in order to register them, atleast that's what being graphically represented means. But surprise! These marks can actually be graphically represented in the not so conventional way though, but it still works. These marks are definitely a game changer for they are difficult in registering but worth the effort. Fashion brands and Entertainment Industry is looking forward to marking their masterpieces as theirs as these unconventional trademarks have given them a sense of relief and promise of protection. It's a revolution in the world that something that cannot be seen with naked eyes with gets protection. With the WIPO seconding and accepting this change it's time these non-traditional marks rise up and gain an individual stature, changing the course of the trademark and shaking the IPR realm. People throughout the globe have had mixed responses, some are positive and some not. It's natural as every time something out of the box happens there's always a group in support and another group opposing it and some fellow intellectuals are still debating. Nevertheless, these non-conventional marks are really something as people have started lining up in front of the Trademark Office to have them registered.

3.2 Their Classification

According to its definition trademark is a visual symbol in the form of word(s), numeral(s), picture or design. The description is generally for the traditional types of trademarks. The non-conventional is categorized into two types; the visual marks and the non-visual marks.

VISUAL MARKS

These marks are something that we can see and can be graphically represented but we debate over it being trademarked. Its understandable for people to question like how can a packaging be trademarked? It only sees the garbage bin just a couple of minutes after we open the product. Is it even necessary to give the animations protections? It's a tech savvy era man! Anyone can do it.

Amongst all these questions, people forget that genuine and uniqueness is what needs protection and it is what creates difference. We can further classify these marks into:

- Trade dress- These are what the eye sees when we want to purchase a product, the products appearance. It's packing or its shape. A different appearance is always enticing to public, encouraging them to buy that product. It is these packaging or containers which are different than the competing/ similar products that need protection.

Examples: Frooti packaging, the red color packaging of Kitkat, Ferrero Rocher chocolate packaging.

- Motion marks- These are digital animated logos. With the emerging digitization the need for the multimedia logos arises as well. As the youth of this generation is more invested in the digital world, there is a rise amongst the motion marks. With common type of digital applications being made every now and then, a motion mark might help grabbing the target for an application or product.

Examples: Nokia's opening logo, Toshiba's opening logo, Netflix's opening logo.

- Holographic marks- Consisting holographic elements these are the

advanced form of three dimensional marks. This is the highest form of technology used for marking a product. EUTMIR defines a hologram mark as a trade mark consisting of elements with holographic characteristics, and adds that it 'shall be represented by submitting a video file or a graphic or photographic reproduction containing the views which are necessary to sufficiently identify the holographic effect in its entirety.'

Example: Glaxo Group's trade mark registrations for the holograms that appear on their packaging of goods such as toothpaste, dental floss and mouth wash.

NON-VISUAL MARKS

These marks are the marks which we cannot see with our naked eyes but can feel. These marks bend the criteria of trademark since they can only be sensed. Now questions will arise, how can we trademark something that we can just sense? Its beyond the laws of intellectual property. But, with the gross change and development in different fields, this impossible has become possible gaining thousands of how.

These marks can be divided as-

- Smell mark- These marks do not apply to perfumes but to products that give out a significantly unique smell. In case of smell mark, different products have different distinct smell. These smell marks are one of the features that sets the products apart from the similar product. Even though its difficult to put it in graphical form, people have still come up with ideas to set aside that problem and mark the scents as theirs.

Example: Bubblegum scent sandals of Grendene footwear company, Pina colada scent to coat ukuleles of Eddy Finn Ukulele & Co., the Coconut smell that fills the Flip Flop Shop (Flip Flop is a footwear shop).

- Sound mark- These are the marks that are associated exceptionally with a particular product. These are indicators that a sound belongs to a particular product. In this e-era, sounds play an important role in setting distinctness and adding value to a brand and its products.

Example: Four note bell sound of Britannia Industries, Sound of lion roars at the beginning of MGM produced film corporation, Yahoo's yodel.

- Texture mark- These are the marks which gives the feel of the product through touch. If you think cotton, linen, or velvet dress material is counted in it then, NO! They're not. Being the least common non-conventional mark, these textures should not at any way add a value to the functional purpose of the product. The texture should only be an additional treat in the overall product.

Example: Leather texture of a Louis Vuitton bag, lacquered red sole on Christian Louboutin heels, texture of a Chanel bag.

- Taste mark- Out of all the non-conventional trademark, this mark is the easiest to represent as the written form of the taste does gives a good idea of the taste of the product. However there is a problem when addressing its functionality. A dish like pizza or pasta can barely be trademarked as its only addition or subtraction of spices. Similarly, pulao and biryani, they cannot be trademarked considering they are more or less made from the same types of spices add or minus some.

As of now no taste has been trademark registered. Though two applications did come forward but they were eventually rejected.

With the traditional marks these additional marks are now recognized by the WIPO as well. These might not be common now but in the near future these will be in frequent use.

3.3 The Dilemma

The legal requirements to register a trademark under the Trade Marks Act, 1999 are as follows:

- The mark should be capable of being represented graphically in paper form;
- The mark should be capable of distinguishing the goods or services of one undertaking from those of others; and
- The mark should be used, or proposed to be used, in relation to goods or services for the purpose of indicating, or so as to indicate, a connection in the course of trade between the goods or services.

Any product qualifying through the criteria get registered under the Trade Marks Act 1999 and gets to the TM after the brand name.

In case of the non-conventional trademarks the criteria and process are all the same. But the part of graphical representation is a headache. Graphically representing smell, sound, hologram, texture are deadly difficult. But, that didn't stop people from marking them although widespread consumer use in enough to get the trademark recognition. Though the numbers of these non-conventional trademarks are relatively low, it's certain that it will rise in the coming future.

According to sec. 26 of Trademark Rule 2017-

Representation of trademark- (1) Every application for the registration of a trademark, and where additional copies of the application are required, every such copy, shall contain a clear and legible representation of the trademark of size not exceeding 8 cm x 8 cm.

(2) Where an application contains a statement to the effect that the applicant wishes to claim combination of colours as a distinctive feature of the trademark, the application shall be accompanied with reproduction of the trademark in that combination of colours.

(3) Where the application contains a statement to the effect that the trademark is a three dimensional trademark, the reproduction of the trademark shall consist of a two dimensional graphic or

photographic reproduction as follows, namely:—

(i) the reproduction furnished shall consist of three different view of the trademark;

(ii) where, the Registrar considers that the reproduction of the trademark furnished by the applicant does not sufficiently show the particulars of the three dimensional trademark, he may call upon the applicant to furnish within two months, up to five further different views of the trademark and a description by words of the trademark;

(iii) where the Registrar considers the different views or description of the trademark referred to in clause (ii), still do not sufficiently show the particulars of the three dimensional trademark, he may call upon the applicant to furnish a specimen of the trademark.

(4) (i) Where an application for the registration of a trademark consists of shape of goods or its packaging, the reproduction furnished shall consist of at least five different views of the trademark and a description by word of the trademark.

(ii) If the Registrar considers the different views or description of the trademark referred to in clause (i) do not sufficiently show the particulars of the shape of goods or its packaging, he may call upon the applicant to furnish a specimen of the goods or packaging, as the case may be.

(5) Where an application for the registration of a trademark consists of a sound as a trademark, the reproduction of the same shall be submitted in the MP3 format not exceeding thirty seconds' length recorded on a medium which allows for easy and clearly audible replaying accompanied with a graphical representation of its notations.

If the Registrar is not satisfied with any representation of a trademark, he may at any time require another representation satisfactory to him to be substituted before proceedings with the application.

It was seen that, the said rule talks about registration of sound marks, giving a green signal for that to be recognized as a trademark.

Sec. 2 (1) (k) of Trademark Rules 2017 states- "Graphical representation" means the representation of a trademark for goods or services represented or capable of being represented in paper form and include representation in digitized form". Some marks such as holographic mark, motion mark and trade dress can be represented digitally, hence easing up the registration process. Generally, an application to register these is not any different than that a regular trademark except these marks are shown digitally instead of paper. As for taste mark, even if theoretically it is possible, in practice it is difficult. There has been attempt to trademark taste but failed in functionality. Registering taste mark is a herculean task and might stay so for the time being. Similarly, texture mark is even difficult to register. Even if one can feel the texture of the product representing graphically is not possible. A product may be widely known for its texture but its next to impossible to graphically represent it. For registering smell mark, the chemical configuration is required. In graphical representation, the person registering for smell mark has to right down the chemical formula of the scent. "Commenting on this matter and whether it might work in the UK, Matt Jones, Partner at leading IP law firm EIP, had this to say: Trademarking a scent can certainly make sense in the business world. In this case, the scent of Play-Doh might cause one to recall fond childhood memories, and may serve as a powerful badge of origin for parents. So you can understand why Hasbro would like to protect this aspect of its product to ensure others cannot simply copy it. Trademarking a scent may make business sense, but one would question whether this would be legally possible in either the UK or the EU. While in the US they seem to have obtained a trademark based on a written description of the scent, this would be harder to do here. To get a trademark here, you have to represent your sign in a clear, precise, objective, accessible, intelligible and durable way. The chances of Hasbro being able to use the same language to get a trademark here are slim because, amongst other things, it would probably not be deemed clear, precise and objective. Filing a sample of the aromatic stuff in question probably would not work either, as that might not be accessible or durable enough. Even a full chemical structure would probably not be sufficient, as that would probably not be intelligible in terms of representing the smell in question. It will be interesting to see if

they pursue a scent mark in the UK or EU and, if so, what approach they decide to take.”

Play-doh was the first one in the entire world to have the smell mark. This soon became a talk of the town and more scents were registered thereafter. Registering smell might not be easy but it certainly not impossible. Registering such unique kind of marks is difficult but, they guarantee ownership and protection of the product creating chances of monopoly for the brand.

IV. CONCLUSION

The Trademarks Rules and WIPO have given these non-conventional trademarks a chance to enter the IPR domain and so far they’ve proved to be the marks of modern days. Though these marks still are unknown to many there has been discussion on their uses by people who wish to protect and monopolize their product. The modern day marks are not feasible in the eyes of law. The laws throughout the world have yet to give them the recognition they deserve in the current reality.

In a country like India, where trademark is in its early stages and where duplicity of trademarked products is seen frequently, giving recognition to such challenging marks is a dream. Registration of conventional mark takes a great time and with serious lacuna in the legal system, unfair competitions and chor bazar’s existing, there is no chance these non-conventional can take up the fight.

This non-conventional trademark still have way to go and challenges to face and show people who have been questioning their very existence of their necessity, why they deserve to stay and deserve an identity of their own. But one thing on which we can count on is that, they are going to grow big and bold in the future, breaking every traditional norm set by and changing the game.

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