

BEYOND WORDS AND DESIGNS: THE EMERGENCE OF NON-CONVENTIONAL TRADEMARKS

Aditi Inamdar
ILS Law College

INTRODUCTION

Imagine you have a small home bakery, called “Sugar Rush Bakery” that sells a variety of baked goods, including cookies called “Sugar Rush Cookies.” You have spent years building the reputation of Sugar Rush Cookies, and the cookies have become well-known and highly sought-after in your city. One day, a national bakery chain called “Sweet Treats Bakery” begins selling its own line of cookies called “Sugar Rush Cookies.” The cookies from Sweet Treats Bakery are similar in appearance and flavour to those from Sugar Rush Bakery, and are being sold in the same stores as your Sugar Rush Cookies are sold. You, as an owner of Sugar Rush Bakery are concerned that consumers may become confused and think that the Sweet Treats Bakery cookies are actually Sugar Rush Cookies. This could lead to a loss of sales and damage to the reputation and value of Sugar Rush Cookies. A brand that you have built over the years is now vulnerable to attempts of infringement by a bigger chain. What remedy is available to you, as the original owner of Sugar Rush Cookies?

This is where ‘trademark’ comes in. According to WIPO (World Intellectual Property Organization), “*trademark is a sign capable of distinguishing the goods or services of one enterprise from those of other enterprises.*”¹ Trademarks are protected by intellectual property laws and can include elements such as taglines, phrases, logos, symbols, and more. Trademarks serve several important functions, including advertising and promoting a product, helping consumers identify and distinguish a product from others, and ensuring the quality of a product. In today's competitive market, it is essential for businesses to have strong intellectual property protections, including trademarks. As a result, the scope of trademark protection has expanded to include unconventional elements and innovative approaches to safeguard a company's products and brand.

¹Trademarks, World Intellectual Property Organisation, available at: <https://www.wipo.int/trademarks/en/> (last visited on December 29, 2022).

The essence of trademark protection lies in the distinct elements that are used to identify a particular product. Trademark protection is centered around the unique elements that are used to identify a particular product. These elements can include sensory characteristics such as smells, tastes, textures, shapes, colours, and sounds, which are known as ‘non-conventional trademarks’. Non-conventional trademarks are rare and can be challenging to register due to a number of issues that exist in the international and Indian scenario. Some well-known examples of non-conventional trademarks include the well-known "Barbie Pink" colour trademarked by Mattel, or the distinctive smell of "Play-Doh" which has been trademarked by the toy manufacturer Hasbro. It is important for businesses and creators to be aware of the challenges and issues that may arise in the protection and enforcement of non-conventional trademarks, as well as the legal definitions and requirements for these types of marks. To ensure that non-conventional trademarks receive the same level of protection and respect as traditional trademarks, it may be necessary to consider the remedies and solutions that can be implemented to overcome these challenges and issues. This includes understanding the strategies and approaches that can be used to protect and enforce rights in non-conventional trademarks.

NON-CONVENTIONAL TRADEMARKS: MEANING AND SIGNIFICANCE

According to The TRIPS agreement, a trademark is defined in the following manner:

*“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 trademark. Such signs, in particular words including personal names, letters, numerals, figurative elements and combinations of colours as well as any combination of such signs, shall be eligible for registration as trademarks. Where signs are not inherently capable of distinguishing the relevant goods or services, members may make registrability depend on distinctiveness acquired through use. Members may require, as a condition of registration, that signs be visually perceptible.”*² Upon studying the definition carefully, we see that the TRIPS Agreement stresses upon the visual aspect of the trademark. However, non-conventional trademarks, although some of them may be non-visual, do fall under the scope of this definition as they are capable of distinguishing a product from another. Careful perusal of the definition of trademarks in TRIPS tells us that it is not mandatory for a trademark to be

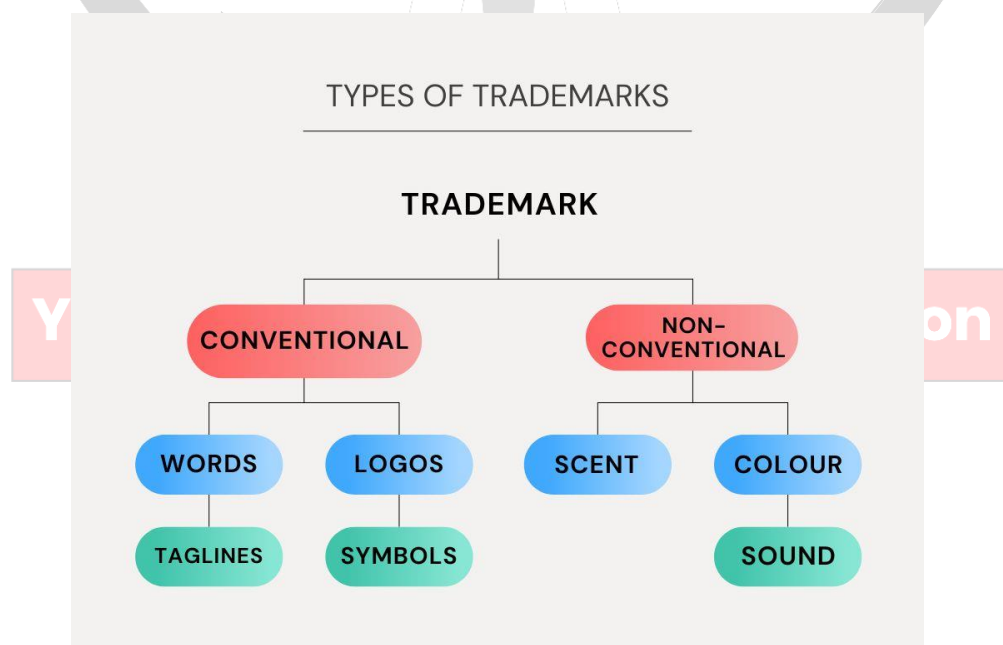
²Trade Related Aspects of Intellectual Property (TRIPS), available at: https://www.wto.org/english/res_e/publications_e/ai17_e/trips_art15_jur.pdf (last visited on December 29, 2022).

visually or graphically represented to be eligible for registration and protection. Therefore, there has been an emergence of granting non-conventional trademarks in various countries like The USA, UK, as well as in countries in Europe.

Non-conventional trademarks can be defined as the distinctive elements that are used to identify and distinguish a particular product or brand, where the distinctive elements are based on olfactory, auditory, visual or any other sensory attributes. The peculiarity of non-conventional trademarks is that they are 'out of the ordinary' – they do not fit into the outline of traditional trademarks which applies to words, phrases, logo, etc. With consumer demands mounting, new products and services are available in the market. In recent years, the increased competition in the market has made it more important than ever to protect the identity of a business in order to stand out and succeed. Traditional trademarks like words or symbols may get overused, and new avenues are explored by the creator to advertise their product. Thus, using non-conventional elements and getting them protected legally helps businesses as well as creators retain their unique brand identity.

NON-CONVENTIONAL TRADEMARKS: TYPES

Non-conventional trademarks are a subcategory of trademarks that differ from the more traditional, commonly recognized types of trademarks that are typically encountered. Non-conventional trademarks can be further classified into 2 categories, viz. Visual and Non-Visual.



Visual trademarks:

Simply put, these are the types of trademarks which can be represented graphically and perceived through the eyes. Visual trademarks are also further categorised based on the elements involved. Colour or colour combinations are the most popular non-conventional elements which are trademarked.

1. *Colour trademarks:* A colour trade mark is sought for protecting a certain colour or colour combination used to identify a certain brand. For example, the distinct ‘eggshell blue’ colour, which is exclusively trademarked by the famous jewellery brand “Tiffany and Co.”. The brand Tiffany has become so closely associated with the distinctive shade of blue that it uses in its packaging and branding that people often think of that colour when they think of the brand. Other examples include the registered pink colour by the American insulation company Owens Corning, or even the trademarked Magenta colour used by the telecom giant T-Mobile.

2. *Multimedia mark:* A red-coloured ‘N’ appears on a black screen, with the famous ‘tudum’ sound and you instantly know it is Netflix – this is what a multimedia mark is. Multimedia marks are a very new category and comprise of a combination of visual and animated elements. They differ from logos in the sense that they are in motion, and not stationery. A multimedia trademark protects the typography and other design elements which may be used by the brand in its marketing and branding efforts, such as trailers, posters, and other promotional materials. Netflix was recently granted a multimedia mark protection for its unique animated logo, in Turkey.³

3. *Trade dress:* Trade dress refers to the overall appearance of the products, which may include any graphics, packaging, shape or other visual elements. Although it sounds very similar to design, there lies a thin line of separation between both. Design is more focused on aesthetic elements, and trade dress is the visual outline of a product. Although both require that elements should not be functional, ornamentation is emphasised upon more in design. On the other hand, trade dress is stressing upon the distinct visual appearance of the product as a

³Merve Macit, “Netflix animated ident logo becomes the first multimedia mark to be registered in Turkey”, *World Trademark Review*, July 07, 2022, available at: <https://www.worldtrademarkreview.com/article/netflix-animated-ident-logo-becomes-the-first-multimedia-mark-be-registered-in-turkey> (last visited on December 29, 2022).

whole, which will communicate the source of the product to the consumer. Design protection has its own legal framework, while trade dress is protected under trademark law.

Some famous examples of trade dress include the signature scarlet-coloured base of heels made by Christian Louboutin or the shape of the Coca-Cola bottle.

Non-visual trademarks:

Apart from visual trademarks, an interesting variety of unique elements are eligible for trademark protection. Various attributes such as scent, texture, sounds, etc. which cater to different senses are capable of trademark protection if they are distinct in nature.

1. *Scent trademark*: Scent marks are a type of trademark protection granted to products having a distinctive smell. The registration of smell marks is one of the most difficult amongst all other trademarks and it is only on rare instances that such protection has been granted. To get protection for a scent, typically a sample has to be submitted along with a description of the scent. Proving the distinctiveness has turned out to be an insurmountable task for many brands. A perfume or a distinct fragrance can be capable of protection under scent marks. The most famous example of a scent mark is Play-Doh, which was granted a trademark for the smell of its clay. The scent was described by their parent company, Hasbro, as “*a combination of a sweet, slightly musky, vanilla-like fragrance, with slight overtones of cherry, and the natural smell of a salted, wheat-based dough*”⁴ and they received exclusive protection for their scent in 2018 by the United States Patent and Trademark Office⁵.

2. *Sound trademark*: When we listen to a specific ‘jingle’ or a ‘tune’, for example the Nokia tune, we immediately associate that tune with a brand. This is the essence of a sound trademark. A sound trademark caters to the auditory senses and can be registered by submitting a recording of the sound for examination. There have been many instances wherein brands have received the green-light for protection of their advertisement jingles or specific sounds. Some popular examples include the Nokia tune, the theme sound of Looney Tunes, the four notes of bellsringing by Britannia, etc. A very interesting fact to note here is

⁴“Hasbro Trademarks a Favorite Smell from Childhood: The PLAY-DOH Scent”, May 18, 2018, *available at*: <https://newsroom.hasbro.com/news-releases/news-release-details/hasbro-trademarks-favorite-smell-childhood-play-doh-scent> (last visited on December 29, 2022).

⁵*Supra* note 4.

that the bike manufacturer Harley Davidson had tried to get a sound trademark for the roaring of the engine in 1994!⁶

3. Tactile Trademarks: Another rare and intriguing category of non-visual unconventional trademarks is tactile trademark. These are also called ‘touch trademarks’ or ‘texture trademarks’ and is granted protection for a distinctive ‘feel’ or texture of a product. Awareness with respect to this type of trademark is comparatively less and there have been a select few companies who have been bestowed with such protection. A sample of the product has to be provided here as well, for examination of distinctiveness. The first ever trademark granted under this type was for a Whiskey company called Diageo. The company received protection for their ‘crackle-glass texture’ of their bottle⁷.

Other categories of non-conventional trademarks include:

Taste trademark: A taste trademark is granted for products like food, beverages, or even medications, for a distinct taste.

Shape trademark: A distinct shape comes under the purview of shape trademark protection.

Hologram trademark: A 3D holographic image which is applied to the product for verification of the quality or origin of the product is eligible for protection under this type of trademark.

While some unique categories of trademarks, such as non-conventional trademarks, have gained recognition internationally, there is relatively little awareness of these types of trademarks within the domestic market. However, as more multinational companies and international brands establish a presence in India, the number of brands operating in the country is increasing. In this highly competitive environment, it is important for Indian companies to consider adopting innovative measures, such as the use of non-conventional trademarks, to help their own brands stand out and not get lost among the numerous other brands in the market.

⁶Sathurshan, “Did You Know Harley-Davidson Tried To Trademark Their Exhaust Sound?”, iMotorbike, available at: <https://imotorbike.my/news/en/2020/01/harley-davidson-sound-trademark/> (last visited on December 29, 2022).

⁷Non-Conventional Trademarks, available at: <https://www.theipmatters.com/post/non-conventional-trademarks> (last visited on December 29, 2022).

NON-CONVENTIONAL TRADEMARKS: THE INDIAN SCENARIO

The primary legislation that governs the registration and protection in India, The Trade Marks Act, 1999⁸ does not particularly emphasize upon recognition of non-conventional trademarks. The Act does not mention or address registration of non-conventional trademarks.

However, the definition of trade mark enshrined in section 2 (zb) of The Act makes it clear that any graphically representable trade mark, which is capable of distinguishing goods and services from others can be eligible for protection under The Act⁹. Due to no specific mention to non-conventional trademarks, it is uncommon for business to apply for such protection. However, non-conventional trademarks can be included in the scope of this definition if they can meet the requirements for trademark registration, i.e., if it can be depicted in a visual manner, and it helps the consumer differentiate the product from other products.

Although registration of non-conventional trademarks has not become main-stream in India yet, there have been occasions where such trademark protection has been granted to certain conglomerates. Following are certain real-life examples of non-conventional trademarks granted in India:

Yahoo Tune: The Yahoo 'yodel' is a very famous tune which is immediately recognised by consumers. Yahoo's three note sound was the first-ever sound trademark to be granted protection in India. A graphical representation of the notes of the tune was submitted by Yahoo! as a sample to the apex trademark protection granting body of the country, The Indian Trade Marks Registry. While Yahoo!'s sound was already granted protection from the US Patent office, the company sought to protect its unique tune in India in 2008. The well-known firm, Anand & Anand had legally represented the company during the whole registration process. When the exclusive rights to use the tune was conferred, it marked a watershed moment in the IPR segment of India. The acquisition of a sound trademark by Yahoo! demonstrated the value of non-conventional trademarks as a tool for protecting and promoting a brand in the highly competitive Indian market¹⁰.

Other sound marks in India include ICICI Bank jingle, the theme song of the National Stock Exchange and the tune of Nokia.

⁸ The Trade Marks Act, 1999 (Act 47 of 1999).

⁹ *Supra* note 8, s.2 (zb).

¹⁰ P. Manoj, "Yahoo awarded India's first sound mark, Nokia in queue", *Livemint*, August 22, 2008, available at: <https://www.livemint.com/Home-Page/5z2B1NQUy3YyPkpRDp789M/Yahoo-awarded-India8217s-first-sound-mark-Nokia-in-queue.html> (last visited on December 29, 2022).

LIMITATIONS IN THE LEGAL FRAMEWORK FOR NON-CONVENTIONAL TRADEMARKS IN INDIA

No non-traditional trademarks have been registered in India except for sound trademarks. The reasons why we see only a handful of non-conventional trademarks being registered domestically is due to certain ambiguities and issues afflicting the legal structure of laws relating to the same. Following are the issues which are becoming hurdles to recognition of 'sensory' trademarks in India:

Lack of legislations: The Trade Marks Act of 1999 has no provisions related to non-conventional trademark. Thus, in a way, there is no official recognition of non-conventional trademarks as far as Indian Intellectual Property law is concerned. Thus, there is a dire need for clear protocol to be established related to non-conventional trademarks

'Graphically Representable' as an obstacle: As mentioned in the article above, one of the restrictions to eligibility of registration of a trademark is that it must be graphically represented. While sound marks can be graphically represented by writing the notations of the tune, in other cases it is not possible to do so. This is a restraint for business who want to protect their distinguishing factors such as smells, textures or tastes.

Lack of Awareness: While non-conventional trademarks have started becoming the new normal in foreign countries, India is still taking baby steps with respect to non-conventional trademarks. It is thus important to make substantial efforts to 'spread the word' about non-conventional trademarks in India.

CONCLUSION

There is a saying that goes 'Necessity is the mother of invention'. In terms of non-conventional trademarks as well this phrase is true. The world is teeming with various businesses, new brands and novel ideas. To protect these ideas and maintain the position in the market, one needs to have a unique identity to survive. And for this purpose, non-conventional trademarks have begun to gain importance. Albeit non-conventional trademarks, such as scent, sound, touch, and taste trademarks, presents certain challenges in terms of obtaining and enforcing protection, their usage is becoming more widespread as businesses and creators aim to safeguard and enhance their brand in a fiercely competitive global market. It is expected that the recognition and protection of non-conventional

trademarks will continue to increase in the future as more companies leverage this innovative method of brand promotion and protection.



Your One Stop Legal Destination