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**INNOVATIVE DIMENSION: UNDERSTANDING THE CONCEPT OF
NON-CONVENTIONAL TRADEMARKS IN INDIA**

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ABSTRACT

This article discusses the evolving landscape of non-conventional or non-traditional trademarks as recognised within the Indian legal framework. Traditionally, trademarks have been associated with distinctive logos, symbols, or names, but in recent years, non-traditional forms such as sounds, scents, colours, and even holograms have gained recognition. In today's dynamic business landscape, the concept of trademarks has transcended conventional boundaries, giving rise to a fascinating realm known as non-traditional trademarks. This article aims to explore the multifaceted world of non-traditional trademarks, encompassing elements such as colour, sound, scent, shape, motion, and beyond. As traditional trademarks face evolving challenges in a technologically driven era, this article intends to comprehend the legal, practical, and strategic aspects surrounding the registration, protection, and enforcement of non-conventional trademarks i.e. brand identifiers.

This article further addresses the examination of the distinctiveness and functionality criteria governing non-traditional trademarks, shedding light on the intricate balance required for successful registration. It also sheds light on the intersection of the non-traditional trademarks and the pharmaceutical industry, in light of a case wherein the Apex Court of India has laid down certain factors for determining deceptive similarity between pharmaceutical trademarks. The law thus extends trade mark protection to features such as shape of goods, packaging, sound, smell, and combination of colours amongst others, as long as they fulfil the quintessential function of trademark- 'source identification'.

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INTRODUCTION

Black's Law Dictionary defines 'Mark' as 'The sign, writing, or ticket put upon manufactured goods to distinguish them from others, appearing thus in the compound, "trade-mark." Section 2(l)(m) of the Trade Marks Act, 1999 defines mark to include 'a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination thereof.' According to Section 2(l)(zb), a "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'.²

In *Laxmikant V. Patel v. Chetanbhat Sha*³, the Supreme Court stated that the definition of trade mark is very wide and means, *inter alia*, a mark capable of being represented graphically and which is capable of distinguishing goods or services of one person from those of others. Mark includes amongst other things name or word also. Name includes any abbreviation of a name.

The function of a trademark is to give an indication to the purchaser or possible purchaser as to the manufacturer and quality of the goods. It tells the person who is going to buy, that the product presented to him is either what is known to him under the similar name as coming from a source with which he is familiar or that it is what he has heard of before as coming from that source.⁴ It is on the faith of the mark being genuine and representing a quality equal to that which he has previously found a similar mark to indicate that the purchaser makes his purchase.⁵

In the dynamic arena of intellectual property law, the concept of trademarks has traditionally been associated with recognisable symbols, names or distinctive logos that serve as indicators of origin for goods and services. Generally, trademark protection is given to traditional marks like logos, symbols, images, captions, signs, names, etc. but due to the aggressive and ever-increasing competition between manufactures of physical commodities nowadays, it has

² The Trade Marks Act 1999, Section 2(zb)

³ AIR 2002 SC 275

⁴ Elizabeth Verkey, *Intellectual Property* 155 (1st edn., 2015) 155

⁵ *Torrent Pharmaceuticals Ltd. v. Wellcome Foundation Ltd.*, (2002) 24 PTC 580 (Guj)

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become extremely important for them to stand out in the commercial market.⁶ However, the evolving nature of commerce and creativity has led to the emergence of what is commonly referred to as “non-traditional trademarks”. Unlike their conventional counterparts, these marks encompass a diverse range of elements such as colours, sounds, scents, shapes, and even unconventional visual designs. Non-conventional or non-traditional trademarks are basically marks that are not included in the traditional set of marks and hence include touch, smell, colour, shape, texture, sound, taste etc.⁷ For a non-traditional trademark to be inclusive under the Trade Marks Act, 1999, it must satisfy the criteria of being distinctive in nature as well as be capable of being graphically represented.⁸ It may be noted that non-traditional trademarks are generally not deemed distinctive under the Trade Marks Act, 1999, rather the same are deemed to have acquired secondary distinctiveness for the purpose of registration as such. The Agreement on Trade-Related Aspects of Intellectual Property Rights (“TRIPS”) also takes an inclusive approach with regard to definition of a trademark and this has provided flexibilities with regard to registration of non-traditional marks in the member states.⁹

TYPES OF NON-TRADITIONAL TRADEMARKS

COLOUR MARK

In determining registrability of colour marks, courts have considered factors such as nature of the goods, how the colour is used, the number of colours or colour combinations available, the number of competitors, and customary marketing practices.¹⁰ A colour is not the property

⁶ [Sanya Kapoor & Riya Gupta, The Five Senses and Non-Traditional Trademarks](#), 8 *Supremo Amicus* 214, 214-231 (2015).

⁷ David Vaver, *Unconventional and Well-Known Trade Marks*, *Singapore Journal of Legal Studies* 1, 1-19 (2005). 5Faye M. Hammersley, *The Smell of Success: Trade Dress Protection for Scent Marks*, 2 *Intellectual Property Law Review* 105, 105-156 (1998).

⁸ The Trade Marks Act 1999, Section 2(zb)

⁹ Art.15 (1) TRIPS: “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.”

¹⁰ Elizabeth Verkey, *Intellectual Property* (1st edn., 2015) 159

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of any individual, but colour combinations used in a particular pattern may create identification with a product. In the case of *Red Bull AG v. Rohidas Popat Kapadnis & Anr.*¹¹, the Plaintiff was aggrieved by the Defendants' adoption of an identical silver and blue colour combination for identical energy drinks. The comparative products and packaging of the Plaintiff and the Defendants is shown below: -

Fig. 1 Comparative products and packaging of the Plaintiff and the Defendants



The Honourable Bench of Delhi High Court protected the Red Bull's signature 'Blue and Silver' colour combination and directed the products to be disposed of by the Defendants during usual course of business, subject to payment of monetary damages to the tune of Rs. 13 Lakhs to Red Bull and were further directed to not sell any further product under the infringing mark/label.

For registrability of single colour trademarks there needs to be a 'plus' factor or a secondary meaning to the colour when it is attached to the product.¹²

Functionality Doctrine:

The functionality doctrine prevents certain features or aspects of a product from being protected as trademarks if those features serve a functional purpose. If the feature of the product for which protection is sought is useful or affects the cost or the quality of the article,

¹¹ [2023] SCC OnLine Del 6595

¹² <https://www.mondaq.com/india/trademark/782690/single-colour-trademarks---the-dilemma> (Visited on January 04, 2024)

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such that granting trademark protection to the feature would put competitors at a significant disadvantage, the feature is not entitled to trademark protection. When considering colour marks, the functionality doctrine aims to balance the need to protect competition and innovation with the right of businesses to protect their distinctive brand identifiers. The functionality doctrine typically arises when the colour in question serves a functional purpose, meaning it provides a utilitarian or practical advantage to the product.

SOUND MARK

In case of sound marks, alternative methods have emerged for their visual representation: depictions by oscillogram, spectrum, spectrogram and sonogram are being accepted. The Trademark Rules, 2017 explicitly recognise the legitimacy of sound marks, by prescribing the manner in which applications for sound marks should be made.¹³

In India, the first sound mark was registered on August 18, 2009. This mark was registered in favour of California based Internet firm Yahoo Inc.'s for its three-note Yahoo yodel. Internationally, some famous sound marks registered are the Tarzan yell, the lion roar of MGM, the intro music of Twentieth Century Fox Films and the bell of New York Stock Exchange as well as McDonald's "I'm lovin' it" jingle.

In *Shield Mark BV v. Joost Kist*¹⁴, the ECJ dealt with the graphical representation of both musical and non-musical sounds. While a detailed notation of musical sounds was enough, non-musical sounds were deemed to be far more complicated to be registered because a worded description of these would not be "precise". Thus, the ECJ held that digital recordings along with graphical representation were required for the non-musical sounds due to the variation in the level of intelligibility.

SHAPE MARKS

As per the trademark law, exclusive rights to the design of a product can be granted if the product's shape is distinctive and immediately represent its origin. Thus, a product's shape is registered as a trademark it has acquired a secondary meaning over the course of time. In

¹³ Trademark Rules 2017, Rule 26(5)

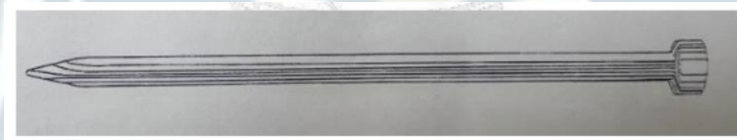
¹⁴ (2004) RPC 315 (ECJ)

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order for a shape mark to enjoy trademark protection, proprietors must expend time and resources to show successfully that they have infused acquired distinctiveness specifically into the product's shape through ingenious advertising, promotion and consequent sales.¹⁵

The Hon'ble Bench of Delhi High Court while enunciating on the legal position on shape trademarks in India, stated in the case of *Knitpro International v Examiner of Trade Marks Through the Registrar of Trade Marks*¹⁶, that in order for a shape trademark to be registered, it has to be shown that the said shape is not the generic shape of the product. It has to be a distinctive shape that associates the mark with the source by itself without anything further like a name or logo appended on it. The shape must have lost its inherent or generic meaning and ought to have acquired a secondary connotation. The standard of distinctiveness required to be acquired would be quite high.

Fig. 2 The image of the knitting needle sought to be registered by the Appellant



TASTE MARKS

For the representation of taste mark graphically, the WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) reports that “graphic representation requirement was satisfied by using a written description of taste and an indication that it concerns a taste mark”.

The law of the European Union such as the *EU Trademark Regulation of 2017*, does not specifically mention about taste marks, and neither has there been any registered taste trademarks, but the criteria for recognising taste as a mark was examined in the case of *Eli Lilly v. OHIM*¹⁷, where “strawberry flavour” in a particular medicine was to be registered. It was observed that this particular taste could not be registered as it lacked distinctiveness and

¹⁵ <https://law.asia/high-court-decodes-registration/> (last visited on 20:26, 19.02.2024)

¹⁶ [2022] 293 DLT 1; [2022] SCC OnLine Del 2096

¹⁷ *Eli Lilly v. OHIM*, R 120/2001-2

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did not possess any characteristic which would help in distinguishing the product. It was further observed that the taste played a functional role in enhancing the taste of the medicine, and therefore it could not be registered as a trademark.

In the United States of America, the Lanham Act, does not explicitly bar unconventional trademarks, yet there has not been any successful registration of a taste mark. Although, there have been instances where taste as a mark has been rejected. One such instance was observed in the case of *NY. Pizzeria, Inc v. Ravinder Syal*¹⁸, wherein the registration of taste of pizza was rejected. It was held that in order to be a considered as taste mark, the taste should have acquired a secondary meaning, which implies that the consumer must be able to associate the taste to the brand.

MOTION MARK

A motion mark is a moving animated object or logo. Microsoft windows logo, which can be seen once we open the windows PC or laptop, is a well-known example of a registered motion mark. The opening and closing of Lamborghini doors have been protected under motion marks in United States of America. The actual use of a multimedia mark for a brand or a product is dependent on the individual registration of a trademark, and whether the legislative forums of the jurisdiction in which the individual or brand is filing for matriculation recognises motion trademarks or not.¹⁹

RELIGIOUS SYMBOLS

It is seen that no fixed criteria are laid down in this regard that whether religious symbols can be trademarked or not. Certain principles which have emerged are that the generally religious marks or symbols should not be allowed registration, as laid down in the Eighth Report on the Trade Marks Bill, 1993 submitted by the Parliamentary Standing Committee.

¹⁸ *NY. Pizzeria v. Ravinder Syal*, 56 F. Supp. 3d 875 (S.D. Tex. 2014)

¹⁹ <https://www.barandbench.com/apprentice-lawyer/motion-trademarks-the-new-age-brands> (last visited on 19:48, 24.02.2024)

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The question that came before consideration in a recent decision of Supreme Court, in the case of *Lal Babu Priyadarshi v. Amritpal Singh*²⁰ was that whether the word "RAMAYAN" (name of a holy book) can be registered as a trade mark in accordance with the provisions of the Trade Marks Act, 1999 (Act) or its registration is prohibited under Section 9(2) of the Act? The Apex Court dismissed the appeal and held that no person can claim the name of a holy or religious book (such as Quran, Bible, Ramayan, Guru Granth Sahib etc.) as a trademark for his goods or services.

The issue that came up for consideration before the Bombay High Court was whether Respondent's mark "MAHALAXMI" used on brooms is similar to plaintiff's mark "LAXMI"? The High Court in *Freudenberg Gala Household Product Pvt. Ltd. vs. GEBI Products*²¹ held that it is not an infringement since the names of Hindu Gods are not exclusive and such word cannot be monopolized by one party.

PATTERN MARKS

Pattern marks, which involve a specific arrangement, design, or pattern of elements, fall under the category of non-traditional trademarks. The recognition and protection of these non-traditional marks have expanded in response to the evolving nature of branding. In India, a pattern may be registered if it satisfies all the necessities of a trade mark as provided under Section 2(1)(zb) of the Trade Marks Act, 1999.

In the case of *Louis Vuitton Malletier v. Mr. Manoj Khurana & Ors.*²², the Hon'ble High Court of Delhi held that the trade marks associated with the plaintiff including the LV Logo, the Toile Monogram and the Daimler pattern are well-known throughout the world and therefore, the Hon'ble Court granted permanent injunction against the defendant for infringing the trade marks of the plaintiff including the Daimler pattern mark.

In yet another recent decision in the case of *Levi Strauss & Co. v. Imperial Online Services Pvt. Ltd. & Ors.*²³, the Hon'ble Delhi High Court opined that the 'Arcuate Stitching Design'

²⁰ [2015] 16 Supreme Court Cases 795

²¹ MANU/MH/1859/2017

²² [2015] SCC OnLine Del 11683

²³ [2022] SCC OnLine Del 5046

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mark on Levi's jeans has achieved a level of widespread recognition among the public which uses garments carrying this mark. The application of this mark to other goods or services is likely to be interpreted as suggesting a connection between those goods and the Plaintiff. Therefore, the Plaintiff's mark stands out as an exceptionally distinctive mark and has acquired a secondary meaning through extensive use spanning over one and a half centuries. As a result, a decree was granted by the Honourable Bench of Delhi High Court declaring the aforementioned mark as a 'well-known' mark as it serves as a unique identifier in respect of the goods of the Plaintiff.

Fig. 3 Plaintiff's 'Arcuate Stitching Design Mark' on Levi's jeans



Fig. 4 The infringing mark used by the Defendants



OLFACTORY MARK

Smell marks can also be granted protection provided the applicant is able to represent the mark. The smell sought to be registered should be distinctly represented and should not be one that emanates from the product.

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Sieckmann case²⁴ was for a trademark protection sought for the olfactory mark deposited with the Office, of the pure chemical substance methyl cinnamate (= cinnamic acid methyl ester), whose structural formula was also given. An odour sample of the sign in a container was also submitted and it was stated that the scent was usually described as ‘balsamically fruity’ with a slight hint of cinnamon. The court however, disregarded chemical formula as an adequate representation as few people would recognise in such a formula the odour in question. Such a formula is not sufficiently intelligible. A chemical formula does not represent the odour of a substance, but the substance as such, and nor is it sufficiently clear and precise. It is, therefore, not a representation.

THREE-DIMENSIONAL MARKS

A three-dimensional shape or stylisation can be protected / registered as a trademark in India. Under the Trade Mark Rules, the same are deemed capable of being graphically represented by reproducing a two-dimensional graphic or photographic reproduction, with at least five different views of the said mark. Three-dimensional marks can be visually appealing and inherently distinctive as well, thereby being capable of distinguishing the goods of one from another. Some examples of three-dimensional marks which have been registered and accepted as trademarks in India are, *inter alia*, the packaging of Toblerone Chocolate and the distinct shape of a Zippo Lighter.

PERSONALITY RIGHTS

Personality rights encompass the rights which individuals have over their name, image, voice, reputation, likeness or other facets of their identity. Such rights empower individuals to take legal action if an unauthorised third party attempts to exploit their reputation or such personal information for commercial gain. The personality rights of an individual have evolved over time to give rise to the right of publicity or celebrity rights.

A novel approach acknowledges that certain celebrities are not merely associated with their names or faces but have developed iconic gestures, dance moves, or poses that instantly recognisable by the public. While specific statutes for safeguarding celebrity rights may be absent, these rights are typically safeguarded through the statutory framework of Trademark and Copyrights Legislations. The registration of a trademark holds dual importance in

²⁴ *Ralf Sieckmann v. Deutsches Patent und Markenamt*, 2002 ECR I-11737: 2002 All ER (D) 185

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relation to celebrity rights. Firstly, it signals that the celebrity is willing to authorize or license their personality for merchandising within the specified class of goods and services. Secondly, the trademark registration provides a mechanism for the celebrity to protect their aspects of personality from unauthorized usage. Courts in India have accorded protection to film titles, characters and names under trademark laws.²⁵

Recognising that Anil Kapoor's name, voice, image and other elements of his persona have acquired a unique distinctiveness due to his reputation, appearance in over 100 films, TV show, web series and advertisement, the Honourable Bench of Delhi High Court passed an interim order protecting the personality rights of Bollywood actor Anil Kapoor and restrained various entities from misusing his image, name, voice or other elements of his persona for monetary gain without his consent.²⁶

NON-CONVENTIONAL TRADEMARK PROTECTION IN THE PHARMACEUTICAL INDUSTRY

Pharmaceutical companies are relying on non-traditional ways for trademark protection of the drugs in addition to just the brand name or drug name for their products. This helps to avoid deception and confusion amongst the consumers and also highlights the distinctiveness of the trademark. The non-traditional marks or the non-conventional marks, specifically in the pharmaceutical industry include the shape of drugs, colour combinations of drugs, and trade dress.

The Supreme Court of India, in the case of **Cadila Health Care Ltd v. Cadila Pharmaceuticals Ltd.**²⁷ laid down certain factors for determining deceptive similarity between pharmaceutical trademarks, which include:

- The nature of the marks i.e. whether the marks are word marks, label marks or composite marks;
- The degree of resemblances between the marks, i.e. similarity of idea or sound;

²⁵ Titus & C Advocates 2008, India guide: Character merchandising in India, <http://www.asialaw.com/Article/1970665/Channel/16681/India-Guide-Character-merchandiing-in-India.html> (18 January 2010).

²⁶ *Anil Kapoor v. Simply Life India & Ors.* [2023] SCC OnLine Del 6914

²⁷ [2001] (5) SCC 73

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- The nature of products;
- The class of purchasers, their education and intelligence and the degree of care they are likely to exercise in purchasing and/or using the goods;
- The mode of buying the products or placing orders for the products; and
- Any other surrounding circumstances which can be relevant to the extent of dissimilarity between the competing marks.

It has been opined by the Delhi High Court that the test for comparison of two trademarks related to medicinal products need to be far stricter than the one applied to other goods, as any confusion in the same would result in public injury.²⁸ Additionally, sound marks have been registered by pharmaceutical companies in India, such as the sound mark “HI-SA-MI-TSU” by Hisamitsu Pharmaceutical Co. Inc. of Japan. “The Purple Pill” of AstraZeneca’s Nexium and the “Red and White” Dyazide of SK&F’s, have been registered as colour trademarks, thus helping the companies to create their distinctive brand image.

CONCLUSION

Thus, it is understood that, following are the essentials of trademarks:

- (i) It should be a mark;
- (ii) It should be capable of being represented graphically; and
- (iii) It should be capable of distinguishing the goods or services of one person from those of others.

The procedural problems lie with the registration of non-conventional trademarks due to the lack of a uniform global practice. It is very often difficult to extend protection to the non-conventional trademarks due to the prerequisites of graphical representation, distinctiveness, and functionality (i.e. the product's function and purpose cannot be the same). Moreover, the open-ended nature of the definitions of the term “trademark” cause ambiguity at a global platform. In order to overcome this issue, there is a need for a more uniform and consistent policy which applies to all the countries under the WTO.

²⁸ *FDC Limited v. Nilrise Pharmaceuticals Pvt. Ltd. and Another* [2022] 295 DLT 437; [2022] SCC OnLine Del 3058
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In the realm of non-traditional trademarks, akin to their traditional counterparts, registration is subject to meeting stipulated conditions as outlined in the trademarks act. The meticulous fulfilment of these conditions, as prescribed in the Trade Marks act, 1999, becomes imperative for securing legal protection. Much like the conventional trademarks, non-traditional elements must demonstrate distinctiveness, avoiding functionalities that might hinder their eligibility for registration. Non-traditional trademarks play a pivotal role in the digital era, influencing consumer perceptions in e-commerce platforms, social media, and virtual spaces. The case laws discussed here illuminate both successful and unsuccessful attempts at registering and enforcing non-traditional trademarks, offering valuable lessons for future endeavours.

In conclusion, the exploration of non-traditional trademarks has unravelled a captivating landscape where innovation intersects with legal considerations, shaping the future of brand identity protection. As businesses embrace novel ways to distinguish themselves, the challenges and opportunities surrounding non-conventional trademarks become increasingly apparent. The delicate balance between distinctiveness and functionality, coupled with the need for a nuanced understanding of jurisdiction-specific regulations, underscores the importance of strategic planning in securing and safeguarding these unique brand identifiers. Thus, in essence, the journey through non-traditional trademarks reveals not only the legal intricacies but also the boundless opportunities for businesses to creatively express their brand identity and through this, it is understood that trademarks including the non-conventional ones perform it's vital function of 'source identification'.

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