

Inttl Innove



NON-CONVENTIONAL TRADEMARKS:
A MARKETING GIMMICK
ADOPTED BY BRANDS

The term "trademark" is defined as “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”, as per Section 2(1)(zb) of the Trademark Act, 1999. While the definition is remarkable for its simplicity, it is equally remarkable for the scope of items embraced within the definition.

Businesses across sectors conventionally tend to identify their goods/services with unique words, symbols, logos, devices, etc. These marks enable them to stand out and distinguish their goods/services from others; for example, ADIDAS as word mark,



as logo mark and as



combination of

word as well as logo mark. However, with the emerging times, the marks are also emerging to be “non-conventional” in nature. This shift has further been supported by the advent of creative marketing strategies to have a stronger recall value to ones’ goods/services. The rise of Non-conventional trademarks offers businesses creative alternatives to traditional marketing, while simultaneously expanding their reach and recognition amongst the general public and members of the trade. Through non-conventional trademarks, a brand may create a new identity amongst its consumers by unconventional mediums such as sound, color, touch, etc., and that is only the beginning of the creativity playing to its best.

Let’s explore the various types of non-conventional marks which a business can adopt as part of their IP portfolio to enhance their value and recognition as a brand:

Color Mark

A mark in which there is at least one colour used that performs the function of a trademark can fall within the ambit of non-conventional trademark.

Colour marks can be utilized as trademarks in two manners i.e. Single colour, or as a combination of colours. The most important factor to be considered while granting a trademark including a color trademark is whether the mark is distinguishable and distinctive to serve a source identification function and not merely a decorative or utilitarian purpose.

Example:



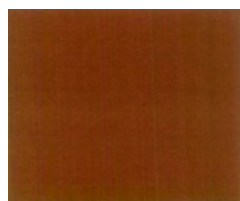
Lilac of Milka-chocolate



Blue of Tiffany and Co.

A single colour may be registerable as a trade mark if it is very unusual and peculiar in a trade and is recognized by traders and consumers alike that it serves as a badge of origin for that class of goods.

Example:



This brown colour has been registered as a colour mark by Victronix AG under Application No. 1394234, (2005) in India



This magenta colour has been registered as a colour mark by Telekom AG under Application No. 1462271, (2006)

A combination of colours may be registrable, however, the same considered on its uniqueness and usage. If the combination of colours can be as a figurative mark, then the combination of colours could be considered registrable. In case, the colours just are functional and indicate trade source, the same are less likely to proceed for registration.

While applying for a combination of colours, the points necessary to be considered are:

- How unusual the colour combination is in relation to the goods
- Whether, the combination is likely to indicate source of trade

Example:



Deere & Company registered this combination of colours green and yellow as colour marks under Application No. 1551759, (2008)

Sound Mark

A mark that uses sound to perform the trademark function of uniquely identifying the commercial source of items, goods/services or the function of trademark. A trademark application for a sound mark must satisfy two conditions –

- The application must clearly state that the mark is a sound mark.

- Must be represented with graphic representation of the sign by a musical staff divided into measures and showing in particular, a clef, musical notes and rest, indicating relative value, sharps, flats and naturals.

As per Rule 26(5) of the Trademark Rules, 2017, where an application for registration of a trademark consists of a sound as a trademark, the reproduction of the same shall be submitted in MP3 form not exceeding 30 seconds length recorded on a medium which allows for easy and clearly audible replaying accompanied with a graphical representation of its notations.

Example:



“VROOM” registered as a sound mark by Hero Motor Corp under TM No. 2529021, (2013)



Yahoo!'s three-note yodel on August 18, 2008. (Registration No. 1270407). Sound of a human voice yodelling the word Yahoo!

Three Dimensional (3d) Mark

A 3D mark includes both the shape of the goods and their packaging. The brands and businesses can protect the ornamental or aesthetic nature of their products. The shape of a product can't obtain trademark protection if it results from the nature of the product itself, or if it gives substantial value to the product, or if it is necessary to obtain a technical result.



The 4-bar Shape of the KitKat Chocolate

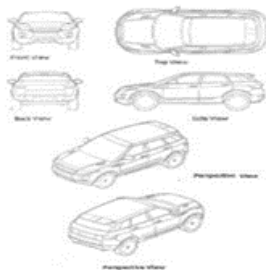


The Packaging of a Toblerone Chocolate Bar

The Trade Marks Rules, 2017 provides certain registrability rules with respect to “Three dimensional trademark”

- Rule 25(12) mandates the applicant to make a specific statement in the application that the mark sought for registration is a three dimensional trade mark.
- Rule 26(3) states that “Three dimensional trademark can be registered by reproduction of the trademark, which shall consist of a two dimensional graphic or photographic reproduction.”
- Rule 26(4) states that “the shape of the goods, shall consists of shape of goods or its packaging, can be registered through the process of reproduction of at least five different views of the trademark and a description by word of the trademark.”

Example:



The shape of the Jaguar Car was registered as a shape mark by Jaguar Land Rover Ltd. under Application No. 2820937, (2014).



Chivas Bottle was registered as shape mark under Application No. 4052515, (2019) by Chivas Holdings (Ip) Limited.

Touch Mark

A distinctive touch such as that of a soft surface is protectable as a trade mark to indicate the source of origin. Merely decorative and ornamental tactile elements that are not so basic and necessary as to be functional can be protected as trademarks, provided the same are not purely for decorative purpose and that they have acquired distinctiveness by use.

A touch trademark shall not be eligible for legal protection as a “Trademark” in the following cases:

- If the mark is an essential use or purpose of the goods or
- If the mark inherently affects its cost or quality of such touch mark

There are by far no touch marks registered in India.

However, the Delhi High Court recognized Louis Vuitton’s rights over its iconic ‘Epi Leather’ surface pattern and restrained the Defendants from using a similar pattern of ‘ridges and valleys’ in a passing off action - Louis Vuitton v. S. Malik (2003).

Epi Leather surface pattern



Motion Mark

A motion trademark is a moving logo which is used by the company as an innovative marketing strategy by the companies to attract consumer towards their product. Any motion mark is made by using animation and different computer programs and any moving object which exist around that company.

For registering a motion trademark, the company or individual has to keep in mind that any movement occurring in the mark should be represented in the sequence, it is being presented for the product.

Example:



Nokia Connecting Hands (Motion Mark):
Registration Number: 1246341



Amazon Techonologies Inc., registered its
BLUE RING MOTION MARK which is
found on its ECHO product as a motion
trademark under Application No. 3468096,
(2017)

Position Mark

The particular positioning of the mark which could indicate the origin and owning a distinctive character can fall within the ambit of position mark. A position mark can be represented by an image, which shows how the mark is positioned on the product, along with its size and proportion as compared to the overall product.



Device of under garment
(Registration No.:1882598)



'Arcuate Stitching Design': Reg. No.
851939
in name of Levi Strauss & Co.:
Declared as Well-Known Trademark

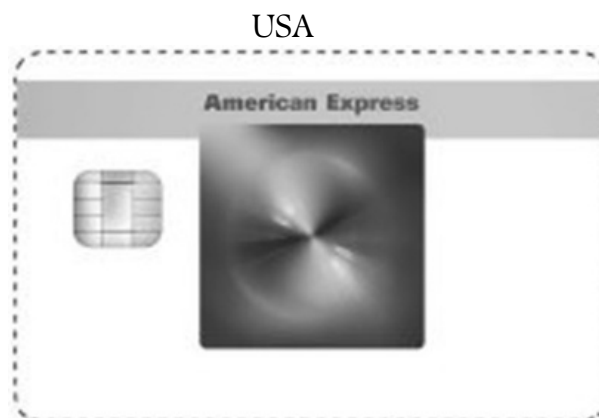
Hologram Mark

A hologram is a permanent record of the light reflected off an object. However, it also appears real and three-dimensional, and like a real object, it moves as you look around it. Hologram serves the purpose of a trademark, that is, uniquely identifying the commercial origin of goods and services.

There appears no trade mark application for registering a hologram in India till date.

However, hologram marks have been registered in other jurisdictions.

Example:



AMERICAN EXPRESS (Reg. No. 3045251) in Class 36 (USPTO)

Smell Trademark

The smell is a non-visual sense which can trigger and impact an individual's memory, mind and mood. The distinctive smell which can be associated with a specific product to identify certain goods/services can act as its trademark. Smell trademarks are also referred as scent trademark or an olfactory trademark.

Smell marks can be afforded protection in India if the applicant proves that:

1. the smell is used as a trade mark;
2. the smell is not an inherent characteristic of the good but serves to identify the Applicant's goods;
3. the consumers regard the smell as a mark which identifies the applicant's goods/services;
4. the mark is capable of being represented graphically.

India by far hasn't received any application for the registration of touch mark. However, smell marks have been registered in other jurisdictions.



Verizon's "flowery musk scent" for "retail store services featuring communication products and services and consumer electronics; demonstration of product" (U.S. Reg. No. 4,618,936)



Lactona Corpora's "scent of strawberry" for "toothbrushes impregnated with the scent of strawberries" (U.s. Reg. No. 3,332,910)

Taste Trademark

A flavour can qualify as a trademark only when the flavour is inherently distinguishable or the consumers are able to associate a particular taste to a brand and the same acts as a source identifier. Taste marks need to be specified with the help of distinguished written descriptions. The challenge in getting a taste mark registered lies in the aspect of functionality.

India by far hasn't received any application for the registration of touch mark. However, there have been futile attempts in other jurisdiction:

Example:



Orange flavour for antidepressant pills, was found to be non-registerable as it was functional, because the taste masked the otherwise unpleasant drug taste
(In re NV Organon, 79 USPQ2d 1639 (TTAB 2006))



Peppermint flavour and smell for a nitroglycerin spray used to treat chest pain was refused registration for being functional and also failed to serve as a source identifier.
(In re Pohl-Boskamp GmbH & Co KG, 106 USPQ2d 1042 (TTAB 2013)).

Challenges Faced by Non-Visual Marks: Smell and Taste Marks

According to Section 2(1)(zb) of the Trademarks Act, 1999, one of the criteria for registration is that the mark is capable of being graphically represented. Graphical representation means “representation of a trademark for goods and services represented

or capable of being represented in paper form and includes representation in digitised form”, as per Rule 2(1) (k) of the Trademark Rules 2017. The non-visual mark i.e. smell and taste mark cannot be graphically represented.

With regard to smell marks, submission of a physical sample of the product is also not viable option as owing to its nature of the goods, it could decay with time. The only way is to write down the exact description of the smell with precision and accuracy. Since, the Trade Marks Act presently does not permit the use of such description and requires a graphical representation for registration of a trademark. The same remains a challenge to registration of a smell mark. Further, the major aspect of the smell is also being distinctive and functional in nature and the same is to be taken into consideration while applying for a smell trademark.

With regard to taste mark, a pen down of the aroma and flavoring compound could be an option to describe the taste of the product and its association with the brand. However, as a criterion, the mark should be able to be graphically represented. Presently, the Trade Marks Act stands do not permit the use of such description for registration of a trademark. One of the other major challenges faced with respect to taste marks are with regard to being functional in nature. However, since no applications from taste mark has been filed in India, the remains a gray area.

CONCLUSION

Trademarks help consumers in identifying the source of the product or services and thereby help in the building of goodwill, brand image, reputation associated with the brand. Trademarks likely to create brand loyalty amongst consumers.

Businesses, nowadays, spend a considerable amount of their time, money and effort in making their goods and services unique so as to distinguish them from those of competing firms manufacturing and selling similar products and in maintaining their IP portfolio.

The businesses have flipped a coin and gone are the days the brands were recognized just by the way of conventional trademarks. There has been paradigm shift in branding strategies in recent years and brands are exploring the non-conventional trademark for creating an association thereof. The sensory branding has been playing a vital role by incorporating the five senses of sight, smell, sound, taste, and touch. The same has been proven to very effective in building a brand and attracting and retaining customers. In a technology driven world, the role of these new types of branding is growing and is likely to do so in future as well. These provide a massive commercial advantage across the marketplace.

There are existing challenges that need to be overcome in terms of clarifying the subjective and objective restrictions for registration of such marks. The law has some work to do if it is to catch up and allow protection to certain of these non-traditional trade marks. However, the business can explore creativity in marketing their products by means of sensory branding.

Disclaimer: The information contained in this article is provided for informational purposes only, and should not be construed as legal advice on any subject matter.

intladvocare

Delhi NCR | Mumbai

Reach us at: [intl@intladvocare.com](mailto:inttl@intladvocare.com)