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EDITORIAL NOTE

Intellectual Property is the key driver to propel the economic growth of a nation. Hence, understanding IP gains utmost significance not only from a business point of view but also from a socio-economic perspective. We as nationals of any country should be vigilant in protecting and defending our IP rights. However, there are multiple issues and challenges that need discussions, and reforms. The IP Press Law Review (IPPLR) is an initiative of The IP Press to extend our objectives of spreading awareness on the issues concerning intellectual property rights and related laws. It aims to promote study and research in the field of intellectual property laws in the form of academic literature. This issue reflects some of the key concerns of the Intellectual property regime both under national and international parlance. It is envisioned to embody some of the most brainstorming insights that help readers to grasp the discourse around contemporary developments in the field of Intellectual Property Law. Throughout the year, the editorial board has reviewed the papers with multiple rounds of editing to ensure quality and standard.

This issue presents intriguing issues and challenges pertaining to intellectual property law in the national as well as the international regime. The first paper encapsulates the protection of personality rights under Intellectual property laws and briefly presents the status of multiple jurisdictions. The second paper discusses a pertinent issue of protection of fictional characters that have been a cause of concern in many disputes. The author discusses the theoretical framework and analyses various tests laid down by the judiciary.

The third paper explores religion as a subject and object of the trademark. The author determines the legality of the trademark of religious symbols for private companies and religious organisations. The fourth paper presents a policy discussion on the overlap between trademark and functionality doctrine. The fifth submission deals with the congruence of intellectual property assets in combination and corporate restructuring wherein the author states that IP has immense power to help businesses to grow and hence its valuation becomes an important aspect of commercialization of IP. The sixth paper demonstrates how open-ended section 57 of the Copyright Act, 1957 is which leads to ambiguity. The author asserts reforms in the current provision of moral rights. The seventh paper discusses the recent dissolution of the intellectual property appellate board in the backdrop of the Tribunal Reform Bill, 2021. The eighth paper discusses the relevance of IP Due diligence and suggests quarterly checks and steps carry out the due diligence process to combat the closing down of businesses and lifelong losses. The ninth paper presents analyses of the patent denials in the biotechnology sector and their impact on the industry. The tenth paper presents an interesting analysis of trademarkability of non-conventional trademarks due to hindrances of graphical representation and discusses multiple judgements of the European courts. The last two items present an analysis of two landmark cases, one Monsanto case and two, Phonpe v. Bharatpe trademark tussle.

Happy reading!

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NON-CONVENTIONAL MARKS: GRAPHICAL REPRESENTATIONS AND CONTEMPORARY PROBLEMS

Doyita Mukherjee*

ABSTRACT

It is imperative that as developments take place in the socio-economic realm, lawmakers observe and initiate the same in laws. The field of intellectual property rights has witnessed remarkable developments that have taken place with changing times. One major change that has transpired worldwide, is the inclusion of non-conventional marks in the paradigm of trademark registration. Non-conventional marks are those marks which cover the colour, shape, sound of goods etc. Initially, the trademark registration was only accorded to conventional marks such as the logo, the brand name, device, word etc., but gradually IP domain witnessed the inclusion of unconventional marks.

However, with all these developments, there is still a long road yet to be trod upon. Non-conventional marks is still a grey area in need of research, which brings us to the question as to how limited are the laws on non-conventional trademarks in the light of the recent registrations and rejections. Besides the hindrances in graphical representation of olfactory marks and registration of non-conventional marks leading to monopoly in the market, recent times have witnessed a trend of registrations such as the registration of the non-cylindrical shape of lipstick belonging to the famous French cosmetic brand Guerlain, which has surprised the IP world.¹ However, there is a lack of proper legal framework governing the registrations of such marks leading to ambiguity and resulting in many marks awaiting their registration such as the shoe manufacturer Timbaland who awaits the registration of the shape of their iconic yellow boots. Moreover, recently the European Courts have given a string of judgements rejecting or cancelling shape marks such as Tecnica's famous moon boots² and Logitech microphone shape.³

Keywords: Trademarks, Non-Conventional Marks, Graphical Representation, Olfactory marks, distinctive marks.

*Doyita Mukherjee, Student, Ramaiah College of Law, Bengaluru; doytamukherjee31@gmail.com

¹Leonhard Romisch, "Non-Conventional Marks-A Significant Departure in Lipstick Design", BrandWrites(27th Jan 2022, 11:00 PM), <<https://brandwrites.law/non-conventional-marks-a-significant-departure-in-lipstick-design/>>accessed 15 Jan 2022.

²EUIPO Board of Appeal, R1039/2019-1.

³EUIPO Board of Appeal, R2630/2019-4.

1. INTRODUCTION

Every time we start watching a Netflix Original, we are greeted by the popular “Tu-dum” sound that is stuck in everyone’s head. However, for many it may not have ever crossed their mind that sounds like these are so unique in character that they are in itself able to represent the entity and distinguish its products and services from that of other entities. For instance, the “Tu-dum” sound helps to differentiate Netflix from Amazon Prime, another OTT platform. The moment you hear the sound anywhere, be it your friend’s house or in the mall, you would know that there is a Netflix Original being played there, and you are very less likely to confuse it with an Amazon Original.

Article 15(1) of TRIPS provides that a trademark consist of a sign or a combination of signs which are capable of distinguishing the goods and services of one undertaking from that of another undertaking. ⁴Moreover, Section 2(1)(zb) defines a trademark as a mark which is capable of being represented graphically and has the capability to distinguish the goods and services of one person from that of another person and may include the shape of goods, their packaging and combination of colours.⁵

The purpose for which Trademark is adopted is three-fold. Firstly, a trademark helps to distinguish the products and services of one source from the similar products and services of other sources thereby preventing confusion in the minds of the consumers. Secondly, it provides protection to the trade, business and good-will that the trademark and its owner has earned over time. Thirdly, it provides assurance to consumers that products and services bearing a particular Trade Mark are of equal quality. Further, trademark protection also assists in the advertisement of the particular product bearing the trademark.⁶

Over the years, the Court in many cases has laid down the object behind trademark protection. In the case of *Cadbury India Limited v. Neeraj Food Products*⁷, an observation was made by the Delhi High Court wherein they stated that the prevention of dishonest adoption of one’s trademark intending to make profits out of it by virtue of good-will and reputation of the Trademark is the

⁴ Agreement on Trade-Related Aspects of Intellectual Property Rights 1994, art 15(1).

⁵ Trade Marks Act 1999, s 2 (1) (zb).

⁶ JT McCarthy, *Trademarks and Unfair Competition* (Vol 1, New York, 1973), 86.

⁷ *Cadbury India Limited v Neeraj Food Products* (2007) 35 PTC 95 (Del).

core spirit of the Trade Marks Act, 1999. ⁸Moreover, in the case of *Ramdev Food Products Pvt. Ltd. v. Arvindbhai Rambhai Patel*⁹, the Supreme Court observed that the intrinsic purpose of trademarks protection is establishing a connection between the goods being sold and its source thereof suggesting the quality of products. ¹⁰

The paradigm of Trademark law has undergone a lot of change and has seen evolution as different countries and their respective courts are overburdened with applications for colours, shapes, sounds, smells, motions, tastes to be registered as trademarks. Many of them, like the famous Tarzan Yell or the triangular-shape of the Toblerone chocolate have been registered as trademarks. But, the question arises what are these marks called and how are they registered.

This paper will essentially deal with such marks known as non-conventional marks, their graphical representation and the practical issues that erupt in their registration as trademarks.

A. Non-Conventional Marks – Definition

Section 2(1) (m) of the Trade Marks Act, 1999 provides the definition for “mark” and states that it includes a device, brand, label, ticket, name signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination. Such categories of marks can be divided into two parts namely, the first bracket includes categories such as device, brand, label, ticket, name, signature, word, letter and numeral; the second bracket include shape of goods, packaging or combination of colours. The former categories marks fall under the purview of conventional marks which can be easily graphically represented and registered as trademark, whereas the latter categories which fall outside the purview of conventional marks are known as non-conventional marks.

When you think of Amul Butter, some of the salient features that would come to your mind include the girl in a polka-dotted dress, the style and the font in which “Amul” is written and the tag-line “utterly butterly delicious”. All distinctive features that come to your mind are conventional marks which can be graphically represented and can be used to distinguish the product from similar products by other undertakings, for instance Mother Dairy or Nandini.

⁸ibid.

⁹*Ramdev Food Products v Arvindbhai Rambhai Patel* (2006) PTC 281 (SC).

¹⁰ibid.

On the other hand, when you think of McDonald's, the famous jingle "I'm lovin' it" is bound to play in your head. This jingle has been registered as a sound mark in USA¹¹ as it is capable of creating a unique identification of the brand "McDonald" in the minds of consumers and also possesses the ability to distinguish it from other undertakings like KFC or Burger King.

In other words, non-conventional marks are those marks which are beyond the boundaries of traditional marks and include categories like touch, smell, sound, colour, shape, texture and more. Traditionally, trademark protection is given to those marks which are capable of being graphically represented and can be used to distinguish the goods and services of one undertaking with that of another. In recent times, many non-conventional marks have also been provided trademark protection because they possess the ability within them to create a unique identification of the product in the minds of the public. ¹²Hence, sounds like the Tarzan's yell has been given trademark protection because the sound possesses the ability to create a unique identification in the minds of consumers. ¹³

While registration of protection of non-conventional marks is only a recent phenomenon, debates and discussions regarding it have been going on for several decades. In fact, before registration of the famous shape of Toblerone or Yahoo's three-note yodel, some of the initial well-known registration of non-conventional marks includes the shape of the bottle of Coca-Cola and the blue-coloured gift box of Tiffany's Company that helped to create a unique identification in the minds of people.¹⁴

Solid debates regarding registration and protection of non-conventional marks started taking place in 19th century Europe. It was finally in 20th century Bolivia, where arguments lead to unconventional marks like sound, shape etc. being granted protection because of their ability of being graphically represented and possessing distinctive character. ¹⁵ While it has been twenty

¹¹'I'M LOVIN' IT Trademark Details' (JUSTIA Trademarks) <<https://trademarks.justia.com/782/57/i-m-lovin-78257203.html>> accessed 20 September 2021.

¹² Faye M. Hammersley, 'The Smell of Success: Trade Dress Protection for Scent Marks' (1998) 2 Intellectual Property Law Review 105, 115.

¹³ Trademark Registration no: 2210506.

¹⁴'Smell, Sound and Taste-Getting a Sense of Non-Traditional Marks' (WIPO) <http://www.wipo.int/wipo_magazine/en/2009/01/article_0003.html, last seen on 10/11/2016> accessed 20 September 2021.

¹⁵ Shikhar Sinha & Kunal Gopal, 'Tracing the Jurisprudence of Smell Marks as a Trademark' (2017), 1 HNLU Student Bar Journal 61, 68.

years since the registration and protection of unconventional marks came into being, however, the graphical representation of such marks has posed quite practical problems, particularly for the non-visual marks like sound and smell as they could create confusion in the minds of the general public.¹⁶

B. Graphical Representation of Non-Conventional Marks

Section 2(1) (k) of the Trade Mark Rules, 2017 defines graphical presentation of trademarks as “representation of a trademark for goods and services represented or capable of being represented in paper form and includes representation in digitised form”. Graphical representation of a mark is considered to be an essential condition for it to be eligible for registration in India. In other words, a trademark application needs to be graphically represented and the mark must possess the ability of being represented on paper.

The requirement for a trademark application to be graphically represented is mainly for the following purposes. Firstly, it allows traders to identify which other traders have applied for registration as a trademark and secondly, it also allows the public to determine the subject matter of the registration.¹⁷

While graphical representation of conventional marks did not pose much problems, but as the definition of “mark” widened to include shape of goods, packaging, colours and combination of colours, sound marks etc., and the graphical representation of such non-conventional marks started posing significant challenges. However, with time, law has developed and there are many non-conventional marks that have been graphically represented and thus, provided trademark protection.

i. Sound Marks

Sound marks are those marks which provide identification of products and services through a unique audio clip. Some forms of sound marks include musical notes and onomatopoeia. One of the best examples of sound marks is the Yahoo three-note yodel.

¹⁶ *ibid.*

¹⁷ *SwizzelsMatlow Limited’s Trade Mark Application-R.P.C., Report of Patent, Design and Trademark Cases (1998) Oxford Journals 244-249.*

Initially, sound marks were not recognized as marks, which are capable of registration and trademark protection. However, the situation changed in the case of *Shield Mark BV v. Joost Kist*¹⁸, wherein the European Court of Justice held that in certain situations sound marks can be provided trademark protection provided they were able to fulfil the prerequisites of registration of conventional trademarks i.e. the ability of being graphically represented without causing confusion.

For registering a sound mark in United States, the general principle which was provided by the Court of United States during the registration of the Nokia tune is that the aural perception of the listener which may be as fleeting as the sound itself unless, the sound is so inherently different or distinctive that it attaches to the subliminal mind of the listener to be awakened when heard and to be associated with the source or event with which it struck.¹⁹ Some of the famous tunes and melodies which have been granted trademark protection in the United States include the Tarzan Yell²⁰, Merrie Melodies theme song²¹ etc.

In India, sound marks are allowed for trademark registration and protection. Rule 26(5) of the Trade Mark Rules, 2017 provides that where an application for trademark registration consists of a sound as a trademark, the reproduction of the same shall be submitted in MP3 form not exceeding thirty seconds length recorded on a medium which allows for easy and clearly audible replaying accompanied with a graphical representation of the notations. The first sound mark registration by the Trade Mark Registry was the Yahoo three-not yodel. Some other notable sound mark registrations in India include “VROOM” sound registered as a sound mark by the Hero Motor Corp²² and the famous dialogue “*Muddai Lakh Bura Chahe Toh Kya Hota Hai? Wahi Hota Hai Jo Manjjure Khuda Hota Hai!*”²³ by Mehboob Productions.

¹⁸*Shield Mark BV v. Joost Kist* (2004) R.P.C. 315 (ECJ);

¹⁹T. Priyadarshini and Neetika Yadav, ‘Nokia’s Triumph in 2007- Registrability of Sound Marks and Areas of Concern’ (Indian Law Journal)

<https://www.indialawjournal.org/archives/volume1/issue_3/article_by_priyadarshini.html> accessed 20 September 2021.

²⁰Trademark Registration no: 2210506.

²¹Trademark Registration no: 2473248.

²²Trademark Registration no: 2529021.

²³ Trademark Registration no: 3027897.

ii. Olfactory Marks

Olfactory marks or smell marks is another category of non-conventional marks which has posed quite a problem in being graphically represented. One of the main issues in graphical representation of smell marks is that they can only be represented in a verbal manner, however, verbal form is not an accurate or official method for determining the difference between two smells. However, one method of graphical representation of smell mark could be the chemical formula behind it.

In the case of *Sieckmann v. Deutsches Patent-und Markennamt*²⁴, the smell mark under consideration was not allowed for registration as a trademark on the ground that the mark was found to be unobvious to the average customer. In that case, the Court completely ruled out written descriptions, chemical formulae, samples and graphic profiles as means of identification of smell marks.

In the Sieckmann case, the ECJ laid down requisites that will render a smell mark to remain unregistered. Firstly, the subjective nature of the written description of the smell mark can be interpreted differently by everyone. Secondly, consumers are unable to understand the chemical formula behind the smell mark without the help of experts, therefore the Court ruled out chemical formulae as means of graphical representation of smell marks. Thirdly, change of environment can have an effect on the durability of the scent and lastly, the Court opined that a trademark is required to be represented graphically and should also be “specific, self-reliant, clear, accessible easily, understandable, objective & robust”.²⁵

The Court of United States in the case of *Re Celia Clarke*²⁶ provided that registration of smell marks can be allowed. In this case, the Court made an attempt to bring about a distinction between the different uses of smell marks, in the sense when the smell is not an inherent character of the goods and services and in those circumstances, where the smell is an intrinsic part of the goods and services. In the latter, the smell can't be separated from the goods and services to which it is attached.

²⁴*Sieckmann v Deutsches Patent-und Markenamt*, [2003] C-273/00, E.T.M.R. 37.

²⁵ *ibid.*

²⁶ *In Re Celia Clarke* [1990] 429 ITAB 758.

In India, to this date no smell mark has seen the light of trademark registration. The laws regarding the registration and graphical representation of smell marks have been silent and thus no smell mark has been given trademark protection in India.

iii. Colour Marks

Colour marks are a form of visual non-conventional marks and come in two forms: singular colour mark or combination of colours. In the case of *LibertalGroep v. Benelux Trademark Office*²⁷, the issue came up before court on whether or not the singular colour orange could be registered as a trademark. The European Court of Justice relied upon the *Sieckmann*²⁸ case wherein a criteria was laid down for graphical representation of non-conventional marks stating that the representation should be clear, precise and self-contained. Moreover, it must be durable, objective and easily-accessible.

The Manual of Trademarks, Practice and Procedure 2017²⁹ has laid down the criteria for graphical representation of colour marks. It states that for a colour mark to constitute a trademark, it is imperative that the colour or a combination of colours must be able to bring about distinction between the goods and services of one trader with those of other traders. If there is any particular colour of packaging which has become a distinctive feature of that product or service of a trader, then it should be protected by registration.

For single colour marks, they can be registered as a trademark provided that they are very unusual and peculiar in a trade and recognized by the traders and consumers that it creates a unique identification of the goods and services provided by that trader. Some single colour marks which have been registered in India include the colour "Brown" by Victronix AG³⁰ and the "Magenta" colour by Telekom AG³¹.

For combination of colours, the Manual³² provides that it will be registerable but will be dependent on their uniqueness and the purpose for which they are being used. If the combination of colours

²⁷*Libertal Groep BV v. Benelux Trademark Office* [2003] C-104/01 (ECJ).

²⁸Trademark Registration no: 2473248 (n 21).

²⁹'Draft of Manual of Trademarks, Practice and Procedure', (IPIndia) <https://ipindia.gov.in/writereaddata/Portal/IPOGuidelinesManuals/1_32_1_tmr-draft-manual.pdf> accessed 20 September 2021.

³⁰Trademark Registration No: 1394234.

³¹Trademark Registration No: 1462271.

³²*In Re Celia Clarke* (n 26).

is present as a figurative mark then not more than two colours will be accepted for registration. In case the combination of colours is being used for packaging of a product, then they are prime facie, less likely to indicate source of trade. If colours are being used for packaging, then for it to be registered, it will be evaluated that how unique the colour combination is in relation to goods and whether the combination will create a unique identification of the particular goods in the minds of consumers. One example where a combination of colours was registered as a trademark is the combination of colour “Yellow and Green” registered by Deere & Company³³.

iv. Shape and Packaging of Goods

Shapes of goods have also received trademark recognition in India. Section 9(3) of the Trade Mark Act, 1999 provides that a mark shall not be registered if it consists of the shape of goods which result from the nature of goods.³⁴ The shape should also not have functional considerations³⁵ and should not add extra value to the goods and services.³⁶

Section 26(4) of the Trade Marks Rules, 2017 provides that where an application for registration of trademark includes the shape of goods or its packaging, the reproduction provided shall consist of at least five different views of the trademarks and description by word of the trade mark. Some examples of shape marks being registered in India include the shape of Jaguar Car registered by Jaguar Land Rover Ltd.³⁷ and the Saffola 5 litres Oil Cans which came with two handles by Marico Ltd.³⁸

2. PRACTICAL PROBLEMS AND CHALLENGES ATTACHED TO GRAPHICAL REPRESENTATION OF NON-CONVENTIONAL MARKS

As aforementioned, the trade mark law has evolved a lot in the last century and as a result we have witnessed the inclusion of non-conventional marks in the spectrum of trademark registration. However, there are a number of challenges that stand for an applicant who wishes to get a non-conventional mark registered. For registration of a trademark, it is essential that the subject mark

³³ Registration No: 1551759.

³⁴ Trade Marks Act, 1999, s 9 (3) (a).

³⁵ Trade Marks Act, 1999, s 9 (3)(b).

³⁶ Trade Marks Act, 1999, s 9(3) (c).

³⁷ Trademark Registration no: 2820937.

³⁸ Trademark Registration no: 2505358.

should be graphically represented. While non-conventional marks like word marks or device marks pose no problems in that area, when it comes to non-conventional marks, issues creep up.

Among the non-conventional marks, visual marks like colour or combination of colour and shape marks are not difficult to be registered as they can be graphically represented. However, non-visual marks like smell and sound marks tend to create confusion in the minds of consumers, hence, their registration is littered with quite a few obstacles.

While Indian law recognizes the graphical representation and registration of certain sound marks, the law is still silent when it comes to smell or olfactory marks. The reason behind this could be the difficulty in graphical representation of the same. A smell mark may be represented by chemical formula or the composition details, however, it is challenging because that doesn't help in the identification of the product to which the smell mark is associated. Moreover, as stated in the Sieckmann's case, chemical formulae can hardly be understood by a consumer and for it to be understood, one has to approach experts on the ground. Moreover, most smell marks do not possess the ability of bringing about a distinction between the goods and services of one person and that of another, which is the prime object of getting a trademark protection. However, there are some smell marks which have been able to meet the criteria for distinctiveness and have got trademark protection outside India, for example, the tennis balls of Dutch Company smell of freshly cut grass.

Besides graphical representation, another question that should be posed is how do we store such smell marks? Over the years, the question of graphical representation of smell marks have been raised time and again, but the difficulty in storing olfactory marks has not been the bone of discussion, even though it poses great difficulty in registration of such marks. This is where one can highlight upon the limitation of law, In the light of so many non-registrations of smell marks and some still awaiting for registration, the law should have taken into consideration the absence of any guideline or rule regarding the same. However, we are yet to see the light of the day, when the law will be amended to provide a proper framework for the registration of smell marks. One solution that can be catered through this research paper is that the problem of storage of smell marks can be dealt with in a practical manner with technological advancement. One needs to create a virtual reality system where such smell marks can be stored for an infinity, with such features being incorporated in the system, that ensures it doesn't evaporate or dissolve.

Another non-conventional mark that may cause problems when applied for registration is touch marks. Touch marks or texture, just like smell marks are subjective in nature. It is not a visual mark and hence cannot be seen with bare eyes, but only felt. This poses a problem for a consumer as to how such touch marks can bring about a distinction between the goods of which they are a characteristic feature. For instance, for a consumer it may be difficult and confusing for him/her to understand the difference between the bags provided by two different brands, just by touching it. However, a touch mark which has been registered is the texture of the Louis Vuitton bag.³⁹

While many sounds have been registered as trademarks in the past, yet they pose an issue when it comes to their registration. In the case of *Honda AG v. Harley-Davidson Inc.*,⁴⁰ The exhaust roar of Harley-Davidson bikes could be viewed as a characteristic feature, however, many Japanese manufacturers like Suzuki, Honda and Yamaha and many American manufacturers like Polaris objected to the exhaust roar being provided trademark protection as it was not a distinctive feature of the bike. Many other motor-bikes by other manufacturers could make the same exhaust roar sound, and it would ultimately lead to confusion in the minds of the general public. Thus, only those sound marks which have a very distinctive character in them that helps to distinguish goods of that particular person with that of another or those which have attained a secondary meaning, are eligible for being registered as trademarks.

Another obstacle that comes in the path of registration of non-conventional marks is the doctrine of functionality. The doctrine lays down that if the functional features of a product are given trademark protection then it would create some level of monopoly in the market. For instance, the shape of a razor cannot be registered as it will provide a technical result of its shape nature.⁴¹ The doctrine of functionality applies to any feature that is crucial to the usage and purpose of the product or if it affects the cost and quality of the product.⁴² The main issue in cases related to this

³⁹Dipak Rao & Sana Singh, 'The Contemporary Issue of Non-conventional Trade Marks', (Lexology) <<https://s3.amazonaws.com/documents.lexology.com/ebe88cd8-9ed8-4d56-8ee2-a9123af2fb19.pdf?AWSAccessKeyId=AKIAVYILUYJ754JTDY6T&Expires=1592240024&Signature=iGwXi1AOjRF5E%2FG5Te8ZCR0%2F%2BtA%3D>> accessed on 20th September 2021;

⁴⁰*Honda AG v Harley-Davidson Inc* (1997) 108 F 3d 1393 ;*Harley-Davidson Inc v William Morris D/B/A Bill's Custom Cycles*(1994) 19 F 3d 142; *Harley-Davidson Inc v Selectra International Designs* (1994) 861 F Supp 754;

⁴¹Adv. Ms. MugdhaPalsule& Adv. Ms. Nikita Lakhani, 'India: Conventionalisation of Non-Conventional TradeMarks'<<http://www.cnlu.ac.in/2021/CIRF/5%20Adv%20Mughda%20Palsule%20and%20Adv%20Nikita%20Lakhani.pdf>> accessed on 20September 2021.

⁴²*Qualitex Co. v. Jacobson Prods. Co.* (1995) 514 U.S. 159, 162, 165 (Supreme Court).

doctrine is the uncertainty that lingers in getting registration for the functional feature of a product which might result in legal monopoly.⁴³

Trademark protection of non-conventional marks also creates conflict with other intellectual property protections, as many of these marks also require protection under other intellectual property. In India, courts have often been faced with a conflict between protection of shape marks under design law as well as trademarks law. This is because Section 2 of the Designs Act, 2000 provides that the shape of goods is eligible for protection under Designs Act, 2000.⁴⁴ The difference that lies between a shape getting trademark protection and design protection, is that in the former shape that becomes eligible for trademark registration should be related to the source of the goods, while in the latter's case it is the aesthetic appeal that makes the shape eligible for registration as a design.⁴⁵ Besides, design and trademark protection, shape marks are also a subject matter for copyright protection, and in the past the packaging and shape of goods have also been provided copyright protection.

Recently, the European Court has granted trademark protection to the shape of lipstick of the famous French cosmetic brand, Guerlain. The Court held that the brand's lipstick shape is quite different and unusual from other lipsticks in the market, as it is non-cylindrical in shape and cannot be positioned upright on a flat surface. Moreover, the unusual shape of the Applicant's lipstick will remind one of a boat hull or a cradle and therefore, the public will be able to easily recognize this lipstick as belonging to this particular brand, since it distinctly differs and deviated from the cylindrical shape of lipsticks in the market.⁴⁶

However, this recent development should not constitute the basis for one to assume that the windows of laws regarding non-conventional marks have opened and are changing with relevant times. While the spectrum has definitely widened, however, it is still not at par with recent times. There are still many non-conventional marks, which for years are waiting to be registered, such as the famous shoe manufacturer Timberland still hasn't seen the light of the day for the registration of the shape of its yellow iconic boot which originated in the 1970s. Recently, the famous Moon

⁴³Trademark Registration no: 2505358 (n 38).

⁴⁴ Design Act 2000, s 2.

⁴⁵Trademark Registration no: 2505358 (n 38).

⁴⁶GC,T-488/20-Guerlain.

Boot's Italian manufacturer⁴⁷, Tecnica Group S.A. encountered defeat that resulted in the cancellation of its 3-D shaped boot marks. It was held that the manufacturer's mark was neither inherently distinctive nor had it acquired distinctiveness. Moreover, the shape as a whole didn't depart from the "norms or customs of the sector".⁴⁸

3. CONCLUSION

Customers usually identify goods and services with a particular feature which is so unique to that good or service. It could be conventional marks like the logo or brand name, or it could be non-conventional features like smell, sound or colour.

The trademark laws in India have been revamped to include non-conventional marks as well. Non-conventional marks may get a well-known status only because of its prolonged use and popularity, but cannot become generic as conventional marks. An advantage of protection of non-conventional marks is that they increase the creativity of manufacturers so that they try to make their products more distinctive in a non-traditional manner. It acts as an incentive for many brands and companies to market their goods and services in the most innovative manner possible.

However, the disadvantage attached to trademark registration of non-conventional marks is that it can lead to monopoly and unfair competition in the market. Moreover, marks like taste marks and smell marks cannot be graphically represented and also do not possess the distinctive character to bring about distinction between goods and services.

Indian law regarding trademarks is moving and evolving with time. While non-conventional marks like sound, shape and packaging and colours have been given a legal backing, with time one can expect law to lay down criteria for graphical representation of other non-conventional marks. It is time for India to look at the criteria for registration of non-conventional marks in other countries like the USA and UK, and implement the same here.



⁴⁷Romisch (n 1).

⁴⁸EUIPO Board of Appeal (n 2).