

How to Register Unconventional Trademarks?

By: Namita Sirsiya

Introduction

New technology is being developed in whole of the world. Different types of products are being created and sold it by the way of advertisement. The word “Trademarks” means, any mark be it a word signature, name, labels, device, numerals, or combination of colours used by an undertaking on goods or services or other articles of commerce to distinguish it from other similar goods or services. The History of trademark is an old as the history of mankind. It began with the beginning of the circulation of goods. In ancient times, craftsmen and merchants used to affix ‘production marks’ to prove ownership marks and to distinguish their goods from inferior quality goods. The Parliament of England’s owes the credit to pass the first trademark legislation in 1266 requiring bakers to use a distinctive mark for their bread.

France passed Manufacture and Goods Mark Act in 1857 and Britain passed Merchandise Marks Act in 1862. The U.S Congress established a federal trademark regime in 1870. In India the earliest law relating to trademarks was the Trade and Merchandise Act,1958.

It was later replaced by the Trademarks Act,1999, through which the law relating to trademarks was amended and consolidated. Introduction of the new Act was considered necessary by the legislature so that India could comply with the Trade- Related Aspects of Intellectual Property Rights (TRIPS). Agreement and to meet its obligation as the member of the World Trade Organisation

The India Legislature and the Judiciary have adopted a developing approach towards the Trade Mark laws and hence the position in India is not yet concrete. The Indian Judiciary is taking guidance from precedents where the matter is settled to develop its law.

Essential ingredients for a trademark

1. It should be distinct :-

A trademark like 'Apple' for computers may be regarded as distinctive because it has nothing to do with apples, and similarly it would not be distinctive for actual apples and someone who is growing or selling apples may not use it as a trademark. So in general a trademark is not distinctive if it is descriptive.

2. It should not be deceptive:-

Typically a trademark would be one that says that the goods for which it is used to have certain qualities when they don't have them in reality

Infringement of trademark :-

Infringement is a breach of violation of another's right. As per Black's Law Dictionary infringement means an act that interferes with one of the exclusive rights of a patent, copyright and trademark owner.

According to Trademark Act, a mark shall be deemed to be infringed Mark if :-

- It is found copy of whole registered mark with a few additions and alterations,
- The infringed mark is used in the course of trade
- The use of the infringed mark is printed or usual representation of the mark in advertisement . Any oral use of trademark is not infringement
- The mark used by the other person so nearly resembles he mark of the registered proprietor as is likely to deceive or cause confusion and in relation to goods in respects of which it is registered.

According to Section 26 of the Trademark Act, 1999, the use of a trademark by a person who not being registered proprietor of the trade mark or a registered user thereof which is identical with,

or deceptively similar a registered trademark amounts to the infringement of trademark and the registered proprietor can take action or obtain relief in respect of infringement of trademark.

Supreme Court has held that in an action for infringement of the two marks are identical, then the infringement made out, otherwise the court had to compare the marks, the degree of resemblance by phonetic, visual or in the basic ideas represented by the registered proprietor, whether the essential features of the mark of the registered proprietor is to be found used by other person than only the court may conclude the matter.

What are Unconventional Trademarks ?

Unconventional trademarks also known as non- conventional or non-traditional trademarks. The unconventional trademarks are relatively new on the Intellectual Property scene . Any mark that does not come under the traditional categories of trademarks such as words, letters, logos, symbols, numerals and pictures may be termed as non- conventional trademark. It consist of marks originating from shapes, sounds, smells, tastes and textures.

These trademarks fulfil the conditions of being a trademark but are difficult to register because of their unusual nature. Trademarks are governed by International treaties like the Madrid Protocol which allow a trademark to be registered in any or all member countries through a single application filed at any of the member countries. However, when it comes to non-conventional trademarks most countries have their own laws regarding what can be allowed and the extent to which the trademark laws can protect non- conventional trademarks.

Types of Unconventional Trademarks:

1. **Sound trademark:-** It is a non/ conventional trademark. Sound trademark functions uniquely to identify the commercial origin of products or services is achieved by means of an audio clip.

2. **Colour trademark** :- It is combined with words, designs, symbols, logos and other such distinguishable signs have been traditionally eligible for a trademark, whether colour alone is eligible has been surrounded in shades of grey. The distinctiveness of colours and the ability to differentiate between shades of a colour have been points in question.

Concerns grew that if colour alone was protectable, trademark infringement suits would lead to lengthy litigations over shades of colour which would slow down the process of trademark registration.

3. **Smell Trademark**:- It generally refers to smell or olfactory trademarks which is generally less in comparison to others non-conventional trademark. And the main reason behind that is that these trademarks are very rare and representing them graphically in an almost impossible and difficult work.

The smell of freshly cut grass for tennis balls was registered as a European Trademark; in the UK the smell of beer (bitter ale) has been registered for dart flights and the smell of roses for tires. An example of a registered smell trademark in the U.S is a “vanilla” scent or fragrance when applied to office supplies, namely, file folders, hanging folders, paper expanding files, etc.

4. **Motion trademark** :- Moving images in the form of a film clip, video, animation, logos, etc. can also qualify for trademarks in some countries. Motion trademark may also be known as animated marks, moving marks or movement marks. The requirements of a motion trademark involve the detailed description of the various components or elements of the trademarks.

5. **Hologram Trademarks** :- It used for security purposes on credit cards, concert tickets, certain currencies etc. The purpose of use it to prevent counterfeiting and fraudulent replication, as replication of a hologram is considered more difficult. These trademarks of holographic have been registered by a few European countries and also in U.S. The main difficulty arises in the method of graphically defining the mark in trademark registration.

Hologram by their nature possesses multiple images or colours that are visible only when viewed from different angles. The images may more electronically, but on paper, the published mark will only be a substitute of the mark itself; a figurative mark which needs graphical representation and adequate written description if it is so succeed.

6. **Touch Mark** :- Sometimes, a particular feel will reflect the quality of the product rather than the origin, but this type of mark may include, for examples, tissues that are particularly soft or moist or products that may be held in the hand more comfortably. The functionalist doctrine may bar protection if the touch is essential to the use and purpose of the inherently affects its cost or quality.

7. **Taste Mark** :- In many cases it will be difficult to distinguish between the natural flavour of a product and the recipe adopted by a manufacturer to distinguish its goods from those of competitors. The flavour of cola drink is a good example. The manufacturers of such goods would certainly consider the flavour of their products as being a trademark of the company, and the recipes often are closely guarded trade secrets. Taste is very subjective, and therefore it would be extremely difficult to define and compare one taste with another.

Registration of Unconventional Trademarks in India

A trademark may be a word, signature, name, device, label, numerals or combination of colours used by an undertaking , on goods or services or other articles of commerce to distinguish it from other similar goods or services originating from different a different undertaking. Under the Trademarks Act, 1999, goods and services are classified according to the international classification of goods and services. Schedule IV of the Act provides a summary list of such goods and services falling in different classes: but this is merely indicative. The Registrar is the final authority in the determination of the class in which particular goods or services fall.

Laws in India :-

The new trademark rules that came into existence on 6th March 2017 ushered in a new era for registration of unconventional marks. The new trademark rules provide for the registration of sound marks under Rule 26(5). Sound mark can be registered by submitting a sound clip along with the musical notations. Color marks can be applied for by submitting a reproduction of that combination of colours.

The Trademark Act, 1999 draws influence from both US trademark law as well as UK. The doctrine of functionality which is an essential part of US law finds place in Indian Trademark law as well. Similarly, graphical representation is mandatory for a mark to be granted registrations in both India law as well as UK.

Conclusion:-

According to Article -15 of the TRIPS Agreement, Trademark as any sign, of any combination of signs, capable of distinguish the goods or services of one undertaking from those of other undertakings. This means that it is not compulsory of the Trademark to be visually perceptible so far TRIPs Agreement is concerned.

The Indian Trademark Regime has, so far, imitated the position of European Union as far as requirement of graphical representation for a trademark is concerned. The Indian Trademark Act, 1999 puts obligation of capability of graphical representation for the registration of trademark.

Thus, it makes registration of non-conventional trademarks much more stringent in India than in the United States. The non- conventional trademarks possess capability of source identifier despite not easily graphically representable.

The Indian Trademark Act, 1999 has put an unnecessary burden of capability of graphical representation as a condition for registration of a trademark. In the increasingly globalised world, the use of sound, scent, colour, motion or holograms as a trademark is bound to increase in the nearby future. Thus, we should liberalise our trademark regime by diluting the requirement of graphical representation for non- conventional trademarks.