

# NON-CONVENTIONAL TRADEMARKS AND ITS ISSUES RELATED TO REGISTRATION IN INDIA

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**ABSTRACT:** *In recent years, the field of IPR has seen a huge number of advancement, particularly concerning trademarks. The TRIPS agreement perceives different kinds of trademarks. India has likewise rolled out fundamental improvements in its laws to conform to the TRIPS agreement. There are specific kinds of Non-conventional trademarks which are far away from the present trademark laws, both at the universal and national level. Non-conventional trademarks are developing their own area in the present business world. This requires registration and protection through possible lawful legislation. The prerequisite of graphical representability may be the best obstruction in the method to get such non-conventional trademarks like sound, smell and colours, registered, for they cannot be carefully recorded down in pen and paper. Thus, new strategies for registering such trademarks should be advanced, particularly in the perspective that the law in many nations today have explicitly or generally accepted such kind of marks as trademarks. Hence, this paper deals with non-conventional trademarks (exclusively sound marks, smell marks and colour marks) and critically examine its problem related to graphical representation and how the non-conventional trademark is registered in India.*

**Key Words:** : *Non-conventional Trademarks, Graphical Representation, Smell Marks, Sound Marks, Colour Marks.*

## 1. INTRODUCTION

Trademark plays a vital role not just in the domain of the intellectual property yet in addition from the point of view of the general advancement in the society. The object behind trademarks is multi-layered. A trademark is financially productive in light of the fact that it enables the customer to recognize the service or goods that he inclines toward and to purchase that to the avoidance of others in the future<sup>1</sup>. Moreover, since great quality is related with that specific trademark, infringement claims exist when another undertaking utilizes an alike mark<sup>2</sup>. This block the latter from unreasonably improving from the labour and reputation of the holder of the original mark, and secures customer interests<sup>3</sup>. Traditionally this was confined to the graphical representation and along these lines just a specific logo/designs were registered as trademarks. In any case, with the development of innovation, technology and the view of the consumer's mentality, it was felt that the trademarks are deficient with regard to a specific critical aspect. Increasingly everywhere throughout the world, perceiving the potential contained in that, different combinations have been looked to be trademarked<sup>4</sup>. The basic component of these trademarks is that they are not visually perceptible but rather, yet they have been trademarked as a result of certain dimension of distinguishing proof required from the consumers point of view.

Generally trademarks can be defined as any mark which is distinctive to the product and was related to the origin of the product. An unconventional trademark is another sort of trademark which does not fall into the classification of traditional or conventional trademarks. These trademarks satisfy the states of being a trademark yet are hard to register as a result of their unusual nature.

Whereas in recent times, the registering authorities have confronted numerous difficulties because of the quantity of trademarks brought before them for being registered. This rise in the quantity of unconventional trademarks can be ascribed to the non-concrete legal definition provided for a trademark<sup>5</sup>. On one hand, trademark laws stress on having an open definition for the term, where the function of the mark is given importance. Any mark which satisfies the commercial function of distinguishing the said product from

<sup>1</sup> J. Thomas McCarthy, McCarthy on Trademarks and Unfair competition 2-3 (4th ed. 2000)

<sup>2</sup> Zippo Mfg. Co. v. Rogers Imports, Inc., 216 F. Supp. 670, 137 U.S.P.Q. 413 (S.D.N.Y. 1963)

<sup>3</sup> B.V.D. Co. v. Kaufmann & Baer Co., 272 Pa. 240, 116 A. 508 (1922); Palmer v. Harris, 60 Pa. 156 (1869)

<sup>4</sup> David Vaver, Intellectual Property: The State of the Art, 116 L.Q. REV. 621, 625 (2000).

<sup>5</sup> *Non-Conventional Trade Marks In India* By Dev Gangjee Vol. 22(1)

different product can be registered as a trademark. <sup>6</sup>On the other hand, the improvement of the law relatesto a trademark has been in a way which gave more inclination to conventional and traditional marks. Section 2(1)(zb) deals with the definition of “trademark”.The definition in this section is wide one, and simply illustrative. It would be important that the last three classifications in this definition, for example i.e. ‘shape of goods’, ‘packaging’, and ‘combination of colours’ were not there in the definition of mark in the previous act and are often referred as ‘non-conventional trademarks’, as opposed to other components of the list that may be termed as ‘conventional trademarks’ <sup>7</sup>

Different kinds of unconventional trademarks that have developed as a result to new technologies, and marketing and advertising strategies include sound marks, odour marks, taste marks, touch marks, motion marks, hologram marks.

Certain conditions are required to be satisfied to register an unconventional trademark-

- i. The mark should be intrinsically distinctive.
- ii. The mark should be able to distinguish the particular product from other products.
- iii. The mark should be capable of graphical representation

Hence the paper discuss the problem related to registering unconventional trademark and plans to answer certain significant and exceeding issues that are essential in the ambit of the unconventional trademarks:

1. Is their inclusion leading to a depletion of available intellectual property resources and creating and unfair competitive and monopolized market?
2. Are these marks fit for satisfying the purpose of the trademarks?
3. Finally, does the fact that these marks are not visually perceptible cause any confusion on what has been registered?

## **2.DEVELOPMENT OF NON-CONVENTIONAL TRADEMARKS**

The viability of any trademark would rely upon its capacity to make an effect on the minds of the potential consumers of that product. If characteristic of a product or its representation is special and unique, it would attract individuals' recognition and senses noteworthy. This has prompted the appearance of various unusual trademarks by the manufacturers. In addition, the development of Internet and e-commerce has likewise expanded the scope of signing that organization might want to use as registered trademarks.

For instance, motion and sound marks would catch the consideration of Internet clients significantly more productively than conventional marks, which have shot their prominence in the present business world. <sup>8</sup>

## **3.ISSUES WITH NON-CONVENTIONAL TRADEMARKS**

Trademark has been defined in section2(1)(zb) of the Act as any mark which is distinctive, for example, capable of distinguishing goods, and services of one person from that of other and capable of being graphically represented. The definition in this way, sets down two wide criteria that a mark needs to fulfill to become a trademark. The definition of mark is a comprehensive one, and along these lines non-conventional marks can fit into the ambit of trademark in the event that they fulfill the criteria of both distinctiveness and graphical representability .

There are additionally a few issues, which make the registration of non-conventional marks as trademarks troublesome. The principal issue is simply the distinctiveness criteria. Despite the fact that certain non-

<sup>6</sup>*Unconventional Trademarks: The Emergent Need For A Change* by HarsimranKalra

<sup>7</sup>Section (zb) of Trade marks Act,1999- "trade mark" means a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from choose of others and may include shape of goods, their packaging and combination of colours , and

1. in relation to Chapter XII (other than section 107), a registered trade mark or mark used in relation to goods or services for the purpose of indicating or so as to indicate a connection in the course of trade between the goods or services, as the case may be, and some person having the right as proprietor to use the mark, and

in relation to other provisions of this Act, a mark used or proposed to be used in relation to goods or services for the purpose of indicating or so to indicate to a connection in the course of trade between the goods or services, as the case may be, and some person having the right, either as proprietor or by way of permitted user, to use the mark whether with or without any indication of the identity of that person, and includes a certification trade mark or collective mark.

<sup>8</sup> Beyond Tradition: New ways of making amark,  
[http://www.wipo.org/sme/en/documents/wipo\\_magazine/7\\_2004.pdf](http://www.wipo.org/sme/en/documents/wipo_magazine/7_2004.pdf)

conventional trademarks like, shape and colour, can be recognized consistently by consumers, for others like smell and taste marks, recognition about the mark may differ, offering ascend to perplexity among consumers. Be that as it may, this is just a practical difficulty, and not a lawful obstacle to get registration, as a mark can acquire distinctiveness through use and in this way meet all requirements to be a trademark, despite the fact that it may not be inherently distinctive.<sup>9</sup>The second issue is graphical representability of the mark to be registered.

#### **4. NON-CONVENTIONAL TRADEMARKS AND ITS GRAPHICAL -REPRESENTATION**

For the subject of a valid application for registration, the sign must be graphically represented<sup>10</sup> as required by Section 2(1)(zb) of the Act. The words 'capable of being represented graphically' would imply that the mark ought to be such as capable of being put to register in a physical structure in a form and furthermore being published in the journal<sup>11</sup>. The graphical representation gives a fixed perspective, indicating what the mark is.<sup>12</sup>

In SwizzelsMatlowLtd's Application(no 2),the Court clarified two main purposes behind the necessity for the criteria for graphical representation:

- a) To empower traders to recognize, with clarity, what other traders (carrying on a similar business or something else) have applied for registration as a Trademark, and for which product.
- b) To empower people in public to decide, with accuracy, the sign which forms the subject of the trademark registration.<sup>13</sup>

A mark is said to be graphically represented upon fulfilment of three criteria.

- i. From the graphical representation itself, it is conceivable to find out the mark without the requirement for any supporting examples.
- ii. The graphical representation can remain instead of the mark itself.
- iii. The people investigating the trademarks register or reading the trademark journal can be sensibly expected to comprehend the object of the trademark from its graphical representation. Any colour standards, musical notation, or scientific measurements set forth to represent marks must be exact and
  - a) make it sensibly practical for users of the framework to most likely acquire a reasonable comprehension of the mark, and
  - b) be ready to precisely compare the sign, the applicant uses or reason to use with other similar signs.<sup>14</sup>

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<sup>9</sup>9. Absolute grounds for refusal of registration.-

(1) The trademarks -

(a) Which are devoid of any distinctive character, that is to say, not capable of distinguishing the goods or services of one person from those of another person.

(b) Which consist exclusively of marks or indications which may serve in trade to designate the kind, quality, quantity, intended purpose, values, geographical origin or the time of production of the goods or rendering of the service or other characteristics of the goods or service.

(c) Which consist exclusively of marks or indications which have become customary in the current language or in the bona fide and established practices of the trade.

Shall not be registered :

**Provided** that a trade mark shall not be refused registration if before the date of application for registration it has acquired a distinctive character as a result of the use made of it or is a well-known trade mark.

<sup>10</sup>Section 1 of Trademark Act,1994, UK- Trade marks.

(1) In this Act a "trade mark" means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings.

A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging.

<sup>11</sup> K.C. Kailash & RamuVedaraman, Law of Trade Marks & Geographical Indications, 2<sup>nd</sup>edn Wadhwa & company, Nagpur),2005, p.132

<sup>12</sup>Kitchin David, Llewelyn David et al., Kerly's Law of Trade Marks & Trade Names,13<sup>th</sup>edn (Sweet & Maxwell, London),2001,p.10.

<sup>13</sup>SwizzelsMatlowLtd's Application (No.2), (2000) ETMR 58.

<sup>14</sup>UK Trade Mark Registry Work Manual, August 1998 edition, p.18, reinforced by Practice Amendment Circular 2/100 cited in ref.8.

Graphical Representation of Non-conventional Trademarks is to a greater extent a practicable issue than a legal issue. Combined with distinctiveness, it might act like a genuine obstruction in the method for registration non-conventional trademarks. This is especially true in the case of smell, sound and colour marks.

#### **4.1. Smell mark**

This is an extremely controversial trademark that has a great deal of consideration in recent times. In spite of the issues in registering smells as trademarks, few products have already been registered as Trademark<sup>15</sup>, whereas many smells have just been pulled back or dismissed at trademark registers of various nations<sup>16</sup>. One such illustrative case in which the registration of smell mark was dismissed based on non-satisfaction of criteria of graphical representability, among different variables, is that of *Ralf Sieckmann v German Patent Office*. The main issue for this situation was whether an olfactory mark portrayed as 'balsamically fruity scent with a slight hint of cinnamon' could be registered as a trademark in regard of specific services.

On reference being made to the ECJ by the German Federal Patents Court, the ECJ decided that graphical representation as such is not sufficient for registration, and it must meet the accompanying criteria:

- i. It must be clear, complete and exact, with the goal that object of the privilege of exclusivity is promptly clear.
- ii. It must be understandable to those people having an enthusiasm for investigating the register, for example different manufacturers and consumers.

Having set out these criteria, the court observed the accompanying challenges experienced in graphically representing smell marks:

- i. Representation as a drawing was impossible
- ii. Representation by chemical formula would not do, as the chemical formula represents the substance itself and not its smell.

Further, registration by chemical formula needs clarity and accuracy, not just as a result of the way that not very many individuals would have the requisite technical knowledge to interpret the smell of a substance from its formula, yet in addition attributable to the reason that a similar substance would give distinctive smells at various temperature, concentration, and so on,

Store of a sample of the substance with the registry was not a possible option, since, firstly, it was not a graphical representation, and secondly, smell being unpredictable may fade and even vanish over some undefined time frame.

Finally, the court decided that reasonable and exact graphical representation is unimaginable for olfactory signs, and in spite of the fact that they might be distinctive, they could not be registered as trademarks.<sup>17</sup>

The situation is different in US, where the Trademark Manual of Examining Procedure expresses that trademark applicants need not present a drawing of the mark if the mark comprises exclusively of a non-visual mark, for example, smell or sound. Rather, applicants are relied upon to present a detailed written description which obviously describes the non-visual mark.<sup>18</sup> The main situation where registration of smell mark was permitted in the US was in *Re Celia Clarke*; however this case did not deal with graphical representation. The applicant petitioned for a trademark protection of an aroma with the description, 'a high impact, fresh, floral fragrance reminiscent of Plumeria blossoms' for use with sewing string and weaving yarn. In spite of the fact that at first the registration was rejected, it was permitted on advance in light of the fact that the appellate board felt that if the applicant's fragrance functioned to demonstrate origin; potential customers may promptly have the capacity to recognize among the wide range of smells in distinguishing goods of competing nature<sup>19</sup>.

Recently, Noble Laureates, Dr Richard Axel and Dr Linda B Buck demonstrated that each olfactory receptor cell in the human body is related with a single comparing odourant receptor gene. Most smells are made out of different odourant molecules, and each odourant molecules initiates a few odourant receptors, prompting

<sup>15</sup> In UK, registration has been made by Sumitomo Rubber Industries Ltd for a Trademark described as a floral fragrance/ smell reminiscent of roses as applied to tyres

<sup>16</sup> The odour of the perfume was sought to be registers in UK, but rejected due to technical difficulties in describing.

<sup>17</sup> Case No. C-273/00 before the ECJ, <http://www.copat.de/markenformen/c-273-00EN.pdf>.

<sup>18</sup> [http://www.uspto.gov/web/offices/tac/tmep/0800.htm#\\_Toc100467391](http://www.uspto.gov/web/offices/tac/tmep/0800.htm#_Toc100467391).

<sup>19</sup> In *Re Celia Clarke*, USPQ2d 1238(1990)TTAB)

the arrangement of an 'odourant pattern'<sup>20</sup>. Therefore , an exact 'odour matrix' (like shade outlines in the Pantone framework<sup>21</sup>) can be defined to classify and distinguishing smells. This may tackle the issue of graphical representability of smell marks to the degree of probability of representation of such marks. In any case, other issues featured for Sieckmann's case is exactness of such representation and attainability of keeping samples with registry remain uncertain. Despite the fact that no answer can be offered as of now, the previously mentioned discovery may give a way to deal with the issue of representing smell marks.

#### **4.2.Sound mark**

This is one more non-traditional trademark looked with the issue of graphical representability. The ordinary method for graphical representation of sound mark is the utilization of musical notations and written description. As a practical manner, nonetheless, not every person can read written music. Additionally , written musical notes while demonstrating pitch ,ordinarily will not show tone, and distinctive tones can be utilized, in particular, musical notes give a 'description' of the music however not simply the music. An obvious solution is to deposit a digital recording of the sound with the registrar rather than graphical representation. Yet, this suggestion has been dismissed by the INTA as being impracticable, for initially, sound cannot be distributed by the Trademark Registry and individuals need to go to the registry to hear it, and also, it would be troublesome for the registry to store such a significant number of sound samples.<sup>22</sup>

Sound marks can be legitimately registered as trademarks in US, UK and Canada. Despite the fact that specific standard positions were taken by the judiciary on this issue in the initial years,<sup>23</sup> registration of sound marks have turned out to be typical in recent times. Further, however sounds can be graphically represented to be with the guide of musical notes, the acknowledgment of sound marks by various trademark registries is an issue in hand. <sup>24</sup>

On account of *Shield Mark BV v Joost Kist h.o.d.n.Memex*, the ECJ observed that registration of graphical representation was not fulfilled when the sound is graphically represented by methods for a description utilizing the written language, as such,

- i. An indication that the sign comprises of the notes going to make up a musical work.
- ii. An indication that it is the cry of an animal
- iii. By methods for an arrangement of musical notes

On the other hand, graphical representability requirements are satisfied where the sound is represented as 'a staff divided into measures and showing, in particular, a clef, musical notes and rests whose form indicates the relative value and, where necessary, <sup>25</sup>accidentals'.<sup>26</sup>

Sound marks can likewise be obliged into the Indian trademark law system. The Shield Mark solutions as articulated by the ECJ is too technical solution for pursue , and a functional option would be storage of the sound mark in an trademark library in a computerized manner, which could be accessed by everybody. Alongside this, a written description of the mark as musical notes ought to be kept with the registry , which would profit the specialists who can peruse notations on the off chance that any debate should come up.

#### **4.3.Colour marks**

Colours can be utilized as trademarks in two structures as a single colour, or as a combination of colours. The last has been explicitly included as a type of mark that can be utilized as a trademark, in a statute of few

<sup>20</sup> Barbara Berg, The scent of surprise , <http://fhcrc.org/visitor/nobel/buck/article.html>

<sup>21</sup> Frankfurt J. Mishawaka Rubber & Woollen Co. v S S Kresge Co.(1942), cited in Barrett Margreth, Intellectual Property :Cases and Materials (US),2001,p.674.

<sup>22</sup> INTA Reports, 1997 as cited in Nguyen Nhu Quynh, Special Trade Marks- Legislation & the situation in the European community, Master Thesis, Lund University, Sweden, 2002. <http://www.copat.de/markenformen/engh-kom/quynh.pdf>

<sup>23</sup> Playboy Enterprises Inc v Germain, 16 CPR (3d)517(1987), where Pinard J observed on the issue of graphical representation of sound mark with musical notes: 'I am of the opinion that, use of a verbal description is not use of a trademark within the meaning of the Trademarks Act. A mark must be something that can be represented visually.

<sup>24</sup> Like the lion roar for MGM , and the chime of 20<sup>th</sup> century Fox, which consists of 'Nine bars of Primarily musical chords in the key of B flat :the chords consisting of four ,eight and sixteen notes'.

<sup>25</sup> Arka Majumdar, Subhjit Sadhu and Sunandan Majumdar, The Requirement of Graphical Representability of Non-Conventional Trademarks, Journal of Intellectual property Rights, vol.11, sep. 2006, pp.311-317

<sup>26</sup> Case No. C-283/01 before the ECJ, [http://www.copat.de/markenformen/jj010283\\_en.pdf](http://www.copat.de/markenformen/jj010283_en.pdf)

national<sup>27</sup>. This incorporation settle prior confusions with respect to whether combination of colours could be a 'mark' at all, and whether it could be particularly distinctive enough to be registered as a trademark, the both of which were replied in the agreed by the House of Lords in *Smith Kline and French Laboratories Ltd v sterling Winthrop group*<sup>28</sup>. To analyze the issue of graphical representation of non-conventional trademarks, it is vital to investigate choice of the ECJ in *Liberal Group BV v Benelux Trade Mark Office*<sup>29</sup>.

For this situation, the issue was whether a mark comprising of a single colour 'orange' could be registered as a trademark. The ECJ emphasized the criteria for graphical representation as set down in the *Ralf Sieckmann case*, and held that such representation must be 'clear, exact, independent, effectively open, comprehensible, tough and target'. For this situation, the question identified with sample of the colour on a flat surface, a depiction in expressions of the colour, and universally recognized colour identification code. The court embraced to see if this representation satisfies the criteria set down as above. A sample of colour alone cannot breeze through the test, since it is not sturdy and would lose its unique shade with the progression of time. Notwithstanding, assignment of a colour utilizing any internationally recognized colour identification code like Pantone might be considered to establish a graphical representation, for such codes are esteemed to be exact and stable.

The ECJ's decision in *Libertel case* deal with the issue, and utilization of the Pantone colour framework can be massively useful in such manner. The Pantone is a business framework that assigns explicit shades numerically and classifications more than thousand such shades by extraordinary unique codes. Hence to unravel this graphical representability issue, India may use the Pantone or any internationally recognized colour identification code<sup>30</sup>, keeping in view different goals like those of averting colour exhaustion and hostile to rivalry.

## **5.REGISTRABILITY OF NON-CONVENTIONAL TRADEMARKS IN INDIA:**

### **5.1.Registration of Sound Trademark:**

Prior to the notification of the said Rules, the registration of sound marks were practically very troublesome. The person who is filing the application, used to record sound marks by representing them graphically or by spelling out the tune. However, after enactment of Trademarks Rules 2017, the facility for the registration of a Sound mark.

The Rules which are amended have provision for filing an application for registration of sound marks. A sound file in MP-3 format not exceeding thirty seconds along with graphical representation of its notation would be required to be submitted with the application. TM-A provides that in case of sound marks representation of specific musical notes must be submitted at the place provided for the trademark.<sup>31</sup>

### **5.2.Registration of Colour Trademark**

The procedure of registration of colour trademark is given in the Trademark Act. As a matter of first importance, the individual who needs to procure registration to file an application for registration of trademark in the regard of goods or services to the competent Registrar of Trademark. The application can be either accepted or rejected by the Registrar. If the application is accepted then the application is advertised. After the advertisement if there is no opposition for the application then the particular trademark shall be registered by the Registrar.

<sup>27</sup> The definition of mark in section 2(1)(m) and 'trademark' in section 2(1)(zb) of the Trademarks Act, 1999 expressly includes 'combination of colours' as a mark that can be registered as a trademark.

<sup>28</sup> *Smith Kline and French Laboratories Ltd v sterling Winthrop group* (1975) 2 All ER 578. In this case, the unique combination of colours applied on drug capsules were held to be 'marks' within the meaning of section 68(1) of the Trademarks Act, 1994. Further, the Court ruled that the said colour combinations were distinctive because they were 'adapted...to distinguish SKF'S goods from other manufacturers'. Moreover, the colour combinations of the capsules had acquired distinctiveness through use, and were registrable as trademarks.

<sup>29</sup> Case No. C-104/01 before the ECJ, [http://www.copat.de/markenformen/c-104\\_01en.pdf](http://www.copat.de/markenformen/c-104_01en.pdf)

<sup>30</sup> The United Parcel Service holds a registration for the colour chocolate brown, which is equivalent of the Pantone colour designated by the code 'Pantone 462 C'.

<sup>31</sup> Rule 26 of Indian Trade Marks Rules (2017) reads as follows: "(5) Where an application for the registration of a trademark consists of a sound as a trademark, the reproduction of the same shall be submitted in the MP3 format not exceeding thirty seconds' length recorded on a medium which allows for easy and clearly audible replaying accompanied with a graphical representation of its notations."

**5.2.1.Registration of Single colour Trademark**

Registration of single colour trademark is allowed in irregular cases because large number of the normal consumers not expect the origin of goods and services based exclusively on their colour. On the presence of two things it can be registered. They are

- If it is not very usual and peculiar in a business or business organizations
- If it is recognised by customers that it serves as a symbol of origin for particular goods.

In majority of the cases application for single colour trademark registration is questioned by the Trademark Examiner since they do not have the ability to distinguish particular products from analikeproducts.

**5.2.2.Registration of combination of colour trademark**

Registration of trademark is allowed for the combination of colours. Two things are required for this reason:

- They should be unique
- They are capable of distinguishing goods and services from one individual from that of other.

For obtaining combination of colour trademark registration it is necessary to prove that the colours are probably going to strike the consumer as a sign of trade source.

To stay away from any sort of objection evidences should be presented at the time of registration which unmistakably shows that colour trademark is capable of representing product of a specific business organisation and it is exclusively identified with the business only. In India single colour trademark registration is very uncommon. When compared to single colour trademark, the number of registration for the combination of colour trademark is very huge, even though the registration procedure is same for both<sup>32</sup>.

**5.3.Registration of Smell Trademarks:**

Under the Indian Trademarks Act, a trademark is defined as a mark which are capable of being graphically represented and which is capable of distinguishing the goods or services of one individual from those of others. So, according to Rule 25 (12)(b) of the Trademark Rules, 2002<sup>33</sup>, an application for registration of trademark mandates its graphical representation while Rule 28<sup>34</sup> and 30 requires that it be mark for which are to be protected should be represented on paper, in a durable form<sup>35</sup>. Therefore, this requirement acts as a barrier to the recognition of olfactory marks as a legitimate trademark in India.

The very reason for such a low registration in other nations and simultaneously no registration of smell marks in India is because they are defined subjectively and are always open for interpretation. The difficulties that arise from humans opinion of odours lead to the argument that subjective opinions are inadequate when deciding whether the smell mark functions as a trademark. Later smell trademarks are one of the most difficult types to trademark which are hard to represent graphically<sup>36</sup>.

<sup>32</sup>Dev Gangjee, Non-conventional Trademarks in India, Manupatra, 2010.

<sup>33</sup> Rule 25(12) - An application for the registration of a trade mark for goods or services shall—  
(b) be able to depict the graphical representation of the trade mark;

<sup>34</sup>Rule 28.- Representation of mark.—

(1) Every application for the registration of a trade mark, and where additional copies of the application are required every such copy, shall contain a representation of the mark in the space (8cm x 8cm) provided on the application form for that purpose: Provided that in any case the size representation shall not exceed 33 centimetres by 20 centimetres with a margin of 4 centimetres on the left hand side.

The trademarks rules, 2002

<sup>35</sup> Rule 30.- Representations to be durable and satisfactory.—

(1) All representations of trade marks shall be of a durable nature, and each additional representation required to be filed with an application for registration shall be mounted on a sheet of strong paper of the size of approximately 33 centimetres by 20 centimetres, leaving a margin of not less than 4 centimetres on the left hand part of the sheet.

(2) If the Registrar is not satisfied with any representation of a mark he may at any time require another representation satisfactory to him to be substituted before proceedings with the application.

(3) Where representation of a trade mark cannot be given in the manner set forth hereinabove, a specimen or copy of the trade mark may be sent either in full size or on a reduced scale and in such form as the Registrar may think most convenient.

<sup>36</sup> Angela Dsouza, Smell marks: The New Rage in Trademarks, Intepat, 2016, [https://www.intepat.com/blog/trademark/smell-trademarks-india/?utm\\_source=Mondaq&utm\\_medium=syndication&utm](https://www.intepat.com/blog/trademark/smell-trademarks-india/?utm_source=Mondaq&utm_medium=syndication&utm)

## **6.CONCLUSION AND SUGGESTIONS**

Generally the trademark law recognizes the protection of mark which has psychological functions. If any symbols or marks, which has new forms, that made great psychological impact on the consumers mind and also have great economic significance, are to be protected under Trademark law. Trouble in registering such marks as trademarks on paper ought not go about as an impediment to their utilization, and new techniques for distinguishing and categorizing such marks ought to be advanced to manage the cost of protection to the customers of such non-traditional trademarks. In case of Smell marks, most smells are made of different odourant molecules, and each odourant molecules initiates a few odourant receptors, prompting the arrangement of an 'odourant pattern'. Therefore, an exact 'odour matrix' (like shade outlines in the Pantone framework) can be defined to classify and distinguishing smells. This may tackle the issue of graphical representability of smell marks to the degree of probability of representation of such marks. Even National Flags of countries all over the world is identified using the combinations of colour. In case of single colour trademarks, the colour utilizing any internationally recognized colour identification code like Pantone might be considered to establish a graphical representation, for such codes are esteemed to be exact and stable. The sound trademark the Rule 26 of Trademark Rules, 2017 gives guidelines for its Representation. While dealing with the particular provision related to sound mark one can see that they have included mp3 format that too not exceeding 30 seconds and in addition should present the graphical representation of the sound mark.

While dealing with all the provisions of Non-conventional trademarks it is clear that the present legislation have made the registration of Non-conventional trademark more difficult, since there is no separate registration procedure for Non-conventional Trademarks. So necessary steps has to be taken by the Legislature to amend the present Trademark Laws which will make the Registration of Non-conventional much more easier.

## **REFERENCES**

1. J. Thomas Mccarthy , Mccarthy on Trademarks and Unfair competition 2-3 (4th ed. 2000)
2. Zippo Mfg. Co. v. Rogers Imports, Inc., 216 F. Supp. 670, 137 U.S.P.Q. 413 (S.D.N.Y. 1963)
3. B.V.D. Co. v. Kaufmann & Baer Co., 272 Pa. 240, 116 A. 508 (1922);
4. Palmer v. Harris, 60 Pa. 156 (1869)
5. David Vaver, Intellectual Property: The State of the Art, 116 L.Q. REV. 621, 625 (2000).
6. Non-Conventional Trade Marks In India By Dev Gangjee Vol. 22(1)
7. Unconventional Trademarks: The Emergent Need For A Change by Harsimran Kalra
8. Section (zb) of Indian Trademarks Act, 1999
9. Beyond Tradition: New ways of making amark, [http://www.wipo.org/sme/en/documents/wipo\\_magazine/7\\_2004.pdf](http://www.wipo.org/sme/en/documents/wipo_magazine/7_2004.pdf) (10 november 2005)
10. Section 9 of Indian Trademark Act, 1999.
11. Section 1 of Trademark Act, 1994, UK- Trade marks.
12. K.C. Kailash & Ramu Vedaraman, Law of Trade Marks & Geographical Indications, 2<sup>nd</sup> edn Wadhwa & company, Nagpur, 2005, p.132
13. Kitchin David, Llewelyn David et al., Kerly's Law of Trade Marks & Trade Names, 13<sup>th</sup> edn (Sweet & Maxwell, London), 2001, p.10.
14. Swizzels Matlow Ltd's Application (No.2), (2000) ETMR 58.
15. UK Trade Mark Registry Work Manual, August 1998 edition, p.18, reinforced by Practice Amendment Circular 2/100 cited in ref.8.
16. In UK, registration has been made by Sumitomo Rubber Industries Ltd for a Trademark described as a floral fragrance/ smell reminiscent of roses as applied to tyres
17. The odour of the perfume was sought to be registers in UK, but rejected due to technical difficulties in describing.
18. Case No. C-273/00 before the ECJ, <http://www.copat.de/markenformen/c-273-00EN.pdf> (10 november 2005)
19. [http://www.uspto.gov/web/offices/tac/tmep/0800.htm#\\_Toc100467391](http://www.uspto.gov/web/offices/tac/tmep/0800.htm#_Toc100467391).
20. In Re Celia Clarke, USPQ2d 1238 (1990) TTAB)
21. Barbara Berg, The scent of surprise, <http://fhcrc.org/visitor/nobel/buck/article.html> (10 march 2006)
22. Frankfurt J. Mishawaka Rubber & Woolen Co. v S S Kresge Co. (1942), cited in Barrett Margreth, Intellectual Property : Cases and Materials (US), 2001, p.674.
23. INTA Reports, 1997 as cited in Nguyen Nhu Quynh, Special Trade Marks- Legislation & the situation in the European community, Master Thesis, Lund University, Sweden, 2002. <http://www.copat.de/markenformen/engh-kom/quynh.pdf>
24. Playboy Enterprises Inc v Germain, 16 CPR (3d) 517 (1987)



25. Like the lion roar for MGM , and the chime of 20<sup>th</sup> century Fox, which consists of 'Nine bars of Primarily musical chords in the key of B flat :the chords consisting of four ,eight and sixteen notes'.
  26. Case No. C-283/01 before the ECJ, [http://<sup>1</sup>/www.copat.de/markenformen/jj010283\\_en.pdf](http://www.copat.de/markenformen/jj010283_en.pdf)
  27. The definition of mark in section 2(1)(m) and 'trademark' in section 2(1)(zb) of the Trademarks Act, 1999
  28. Smith Kline and French Laboratories Ltd v sterling Winthrop group(1975) 2 All ER 578..
  29. Case No. C-104/01 before the ECJ, [http://www.copat.de/markenformen/c-104\\_01en.pdf](http://www.copat.de/markenformen/c-104_01en.pdf)
  30. The United Parcel Service holds a registration for the colour chocolate brown, which is equivalent of the Pantone colour designated by the code 'Pantone 462 C'.
  31. Rule 26 of Indian Trade Marks Rules (2017)
  32. Dev Gangjee, Non-conventional Trademarks in India, Manupatra(2010)
  33. Rule 25 and Rule 28(1) and Rule 30 of Indian Trademark Rules,2017.
  34. Angela Dsouza, Smell marks: The New Rage in Trademarks,Intepat,2016, [https://www.intepat.com/blog/trademark/smell-trademarks-india/?utm\\_source=Mondaq&utm\\_medium=syndication&utm](https://www.intepat.com/blog/trademark/smell-trademarks-india/?utm_source=Mondaq&utm_medium=syndication&utm)
  35. Arka Majumdar, Subhojit Sadhu and SunandanMajumdar,The Requirement of Graphical Representability of Non-Conventional Trademarks, Journal of Intellectual property Rights,vol.11,sep. 2006,pp.311 -317
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