



## CHALLENGES OF REGISTERING NON-CONVENTIONAL TRADE MARK IN INDIA A BRIEF ANALYSIS

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**ABSTRACT** Trademark registration in India is regulated by controller general of patent, designs and trademarks, Ministry of commerce and Industry, Government of India. Trade marks are registered under the Trade Marks Act, 1999. In the modern market, non-conventional trademarks still remain a developing practice. This paper makes a brief analyses of non-conventional Trade marks in India. To be eligible for protection and registration, the Trademarks have to comply with certain statutory requirements these Requirements may vary from country to country depending on its national Legislation. It is generally difficult to obtain registration for non-conventional Trademarks than for conventional trademarks. In India there is no specific Provision as to the registrability of non-conventional trademarks.

**KEYWORDS :** Trade mark, TRIPS, Registrability, Consumer, Distinctiveness, Graphical Representation

### INTRODUCTION

The world of Intellectual Property Rights has grown in present scenario, and that too with regard to the trade mark. The TRIPS has recognized Various types of trademarks. In order to adhere to the provisions of the TRIPS, as a signatory it is necessary for India to make laws regarding non-Conventional trademarks.

Trademark as those marks which differentiate the product from Another and identify the origin of the said product. It is generally understood that trademark is a sign, design, or expression which identifies products or services of a particular source from those of others. Therefore, the Conventional definition of trade marks has been limited to word, symbol or design or a combination thereof. Here comes a question then what is non-Conventional trademarks? From a general perspective it is understood that trade mark is objective while non-conventional trade mark is subjective. Any trademarks that does not fall within the conventional scope of word, symbol, or design or combination thereof shall be considered as a non Conventional trade mark. The term trademark under the modern definition Can be defined as a designation used to identify and distinguish the goods of a person or services . A trademark is an identifying symbol in the form of word , graphical representation or a label applied to articles of commerce with a view to indicate the consumers that their goods manufactured by a particular person/group and conform to ascertain quality . Trademarks are marks recognized by the human senses those are inclusive of touch, sight, color , sound and taste.

### Nature And Scope Of Non-conventional Trademarks

The Non-Conventional marks are developing their own area in the present consumer world and in the globalized era because of the rapid advancement of new technology and increase in competition, companies and business. They give predominant importance for the marketability of their products and therefore trade mark has become a key tool to denote a company's identity and creating a brand image and distinguishing their products from others. It is a fact that day by day the ambit of trademark protection law is being expanded everywhere throughout the world. Different countries hold different view point when it comes to the registrability of non-conventional trade mark. Indian legislation do not have any specific provision for Non-conventional marks except for the mention of sound marks (under Rule 26(5) of the Trade Marks Rules 2017) by Submitting the sound clip with musical notations and not exceeding thirty seconds. Also, colour marks can be submitted by producing a combination of colours. In India, the sound mark has been registered for yahoo yoodle and ICICI Jingle. It is upon the applicant for the onus to prove that the sound and the colour have distinctive characteristics. There exists no provision to date regarding the smell mark. India has a very rigorous process of registration of non-conventional Trade Marks.

TRIPS (Trade- Related Aspects of Intellectual Property Rights) too do not have provisions for Non-Conventional Marks. Non-conventional marks are those marks which do not fall under the category of conventional marks. The definition of Non-Conventional mark is illustrative. It includes 'shape of goods', 'packaging' and 'combination

of colours' within its ambit. They are basically those marks which are based on appearance, shape, sound, smell, taste, textures etc. Such marks go beyond the purview of conventional category.

In the act Non-conventional trade mark is not specifically mentioned but the definition of Trademark incorporates the non-conventional marks as well. Issues with regard to the Registration of Non-Conventional Trade marks The definition of a non conventional trademarks is extremely wide. The standing committee on the law of trademarks, industrial design and geo graphical indications (SCT), established in 1998 by World Intellectual Property Organization (WIPO) which was established in 1967, up on its studies of non-conventional trademarks divided it into visual trademarks and non-visual trademarks. visual trademarks are three dimensional marks such as color marks, holograms, slogans, title of films and books, motion or multimedia signs, position marks, gesture marks a and non-visual marks such as sound marks, olfactory marks taste marks and texture or feel marks.

The development of the protection of non-conventional marks has been increasing in the past twenty years due to several factors. Different kinds of nonconventional trademarks that have developed as a result to new technologies and marketing and advertising strategies include sound marks, odor marks, taste marks, touch marks, motion marks, hologram marks. The digital and social media revolution brought paradigm shift in the branding strategies. Non-conventional trademarks are the most striking branding strategy of the present business world of twentieth century. Trade mark rights in non-conventional mark are being established through consumer recognition. The basic component of the non-conventional trademarks is not visually perceptible, yet they have been trademarked as a result of certain dimension of distinguishing proof from consumers point of view and its unusual nature. it is a fact that to be irreplaceable one must always be different and distinct. The definition of trademark under the Trade Mark Act ,1999 in India as per section 2(zb) is "trade mark means a mark capable of being represented graphically and which is capable of distinguishing the goods and services of one person from those of others and may include shape of goods, their packaging and combination of colors". This definition is a wide one and simply illustrative and inclusive.

Therefore, non-conventional trademarks can very well fit in the ambit of trademark if they satisfy the criteria of distinctiveness and graphical represent ability. Non-conventional trademarks must have the communicative ability of being able to differentiate the goods and services of a person from another.

In recent years trademarks registries and courts have grappled with applications for shapes, scents, textures, short cartoons, single colors, body movements, technical concepts, the position of label on products etc. Today various countries have recognized non-conventional trademarks like North America United states, Canada, Europe, Switzerland, Germany, France, South Africa, Argentina, Andean community of Nations (it is a union of four South American nations

centered on Andean region-Bolivia, Colombia, Ecuador and Peru aiming integrated economic development), Uruguay, Chile, Australia, Korea, China, Hong Kong, India, Japan.

### Analysis

It is generally understood that one main issue with regard to non-conventional trade mark is that these marks are not visually perceptible and therefore it may make confusion among the consumers. Another issue may be whether the marks fit for satisfying the objectives of trade mark? The other issue is whether the inclusion of non-conventional trade mark registration in Trade Mark Registration will lead to a depletion of a present available intellectual property resources and certain an unfair competitive and monopolized market in the present and future scenario.

Certain conditions are required to register a non-conventional trade mark. The mark should be intrinsically distinctive through its use and thus qualify to be a trademark. The mark should be capable to distinguish the particular product from other products. The mark should be capable of graphical representation. Graphical representation of a mark is considered to be a sine qua non in order to register trade mark in India. A trademark application is needed to be graphically represented and the mark must be capable of being put in the physical form with in the register. Graphical representation of non-conventional trade mark is based on the concept of practical application rather than a legal issue. Evolution of trade marks registration system of conventional subject matter gradually develop.

In India, prerequisite of graphical representation is coupled with other grounds that are mandatory to be met with if a trademark is applied for registration. The principal issue of the trade mark registration is distinctiveness. Any mark, be it a word, device, brand, heading, letter, numeral if capable of distinguishing goods and services of one person from that of another, can be registered as a trade mark. Trade mark which are not capable of distinguishing from the very outset of its being the goods and services of one person from those of another are devoid of distinctive character for those signs where distinctive character can be proved, the requirement of graphical representation should not bar registration, further when there is distinguishing character is lacking can be registered only if evidence to substantiate acquired distinctive character as a result of the use of such trade mark can be presented. When the trademarks are descriptive in nature they must possess the secondary distinctive meaning the goods and services in relation with which the said marks are used relate to a specific brand or the owner. Under the Indian Trade Mark law if a non-conventional trade mark has acquired distinctiveness and is very well known to the customers as a result of its continuous and prolonged use among the popular estimate and that the consumers associate such non-conventional trademarks with its brand or the owner, then such trademarks are permitted to register. In order to register, the brand owner has to submit the evidence to perspicuous continuous and prolonged use and it should be genuine and also other documents showing the expenses incurred on the non-conventional trademarks marketing and advertising focused on to create public awareness among the popular estimate to draw a relation between such trademark and the brand owner serving as an indicator the brand or owner. Non-conventional trademarks will definitely attract a new variety of consumers who are more closely connected to the feel of the trademark rather than its visual appeal.

Trade marks play uniquely a robust role from the view point of general amelioration and inexorable progress in the society. Different types of non-conventional trademarks have developed as a result to new technologies, marketing and advertising strategies include colour mark, sound marks, taste marks, touch marks, motion mark, hologram marks. A trade mark is financially productive in the light of the fact that it enables the customer to recognize the services or goods that he inclines to purchase that to the avoidance of others in the future. Any mark which fulfills the commercial function of distinguishing the said products from other different product can be registered as a trade mark. Essential Functions of Non-Conventional Trade Marks. Non-conventional trademark performs four essential functions

- 1] It identifies the source or origin
- 2] Links the mark, the product, the proprietor
- 3] Guaranties the quality
- 4] Advertise the product

Important conditions required to register a non-conventional trade mark.

1. The mark should be clearly and intrinsically distinctive.
2. The mark should be able to distinguish the particular products from other products.
3. The mark should be capable of graphical representation.

Therefore, the importance of any trade mark is depending up on its capacity to acquire distinctiveness on the minds of the potential consumers with regard to its products. The special distinctive characteristic of a product will attract the consumers. Thus, consumers uniformly identify certain non-conventional trademarks with respect to its distinctive shapes and colour etc. But in the case of smell and taste marks the perception with respect to marks may vary and this will create confusion among the consumers. In order to obtain a valid registration as a mark, it can acquire its distinctiveness even though it is not inherently distinct through its use and thus qualify to be a trade mark. Therefore, the registered mark should be capable to distinguish a particular product from another products. The definition of Trade Marks as per 2(zb) gives paramount importance to two wide criteria viz distinctiveness and graphical represent ability for a mark to become a trade mark.

Section 18 of Indian Act, 1999 states registration of a trademark should be in accordance with Trademark Rules. Rule 25 (12) b of 2002 states that the registration should be in such a manner as it can be graphically depicted. Rule 28 conveys that the trademark has to be represented on the paper. Rule 29(3) states that three-dimensional trademarks can also be registered. Any specification made to the graphical representation must be satisfactory and durable under Rule 30. Graphical representation of a mark is considered to be sine qua non in order to register a trade mark in India. A trademark application is needed to be graphically represented for its registration and the mark must be capable of being put in the physical form with in the register. It is also needed to be published in a journal. Graphical representation of non-conventional marks is a practical issue than a legal issue. Graphical representation is considered to be a serious impediment in registering the non-conventional trademarks especially in the case of smell, sound, and colour mark.

### CONCLUSION

Non-conventional trademarks create a psychological impact on consumers. Non-conventional trademarks are evolving in India. India has adopted more of US view regarding the laws of non-conventional trademarks rather than UK. India still needs to develop a strict enactment regarding non-conventional trademarks through the precedents or the legislative amendments. The need of registration of the non-conventional trademark is because the companies and firms want to advertise and design their products in order to appeal the aesthetic of the consumer. The new Trademarks Rules, 2017 along with Trademarks Act, 1999 has accepted sound as trademark. Though taste, motion, smell, etc are not expressly considered as the trademark. However, if they contain a distinctive category and be able to represent geographically then they get the status of the trademark in India. The concept of non-conventional trademark is at its developing stage and requires many precedents to come to identify it as codified law. The recognition of trademarks has moved beyond the domain of goods and services. Today products are recognised with the smell, taste, colour, combination of colours, feel, shape, etc Registration of non-conventional trademarks like smell marks, colour marks, sound and shape marks are yet to gain momentum. Non-conventional Trademarks still have a long way to go.

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