

PROTECTION OF NON-VISIBLE MARKS UNDER THE TRADE MARKS ACT, 1999: ISSUES AND CHALLENGES

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ABSTRACT

Traditionally, trademarks have been significant for establishing the brand identity in the ever expanding field of intellectual property. These marks have been mostly visual, like logos, symbols, or phrases that differentiate one entity's products from those of other. However, with an increase in number of consumers and growth of market, a new category of trademarks, known as non-traditional trademarks, has evolved over a period of time. Recent trends, however, indicate that manufacturers are in the need of registration of the non-traditional marks. Non-conventional trade marks, emerging as one of the noticeable strategies of the twentieth century, can further be classified into visible and non-visible marks. This article delves into the fascinating realm of non-visible trademarks in India, examining the legal issues and challenges relating to the registration of such marks. The issues such as visual perception, graphical representations, distinctiveness, and functionality have been discussed in this article.

Keywords: Non-Visible Trademarks, Graphical Representation, Visual Perceptibility, Distinctiveness, TRIPS Agreement

1. INTRODUCTION

Since the time immemorial, trademarks, in some form or the other, have always been the identifier of the source of goods. Trademarks were in use even before human rights were being argued upon by Aristotle, St. Thomas Aquinas, and Immanuel Kant. The history of trademarks dates back to the commencement of the circulation of goods in society. Marks have a history almost as old as humanity and religion. Scientists have discovered relics from ancient Egypt and other countries that were unearthed and had a variety of religious and superstitious symbols engraved on them. Relics from the Greek and Roman eras exhibited potters' marks which were used to identify the potter who created the item.¹ In addition to being used to indicate the source of goods, proprietary marks were frequently derived from a specific house marks. Moreover, the branding for cattle was also based on a specific house mark. When an innkeeper was executed in

¹ Laurence R. Helfer, "Human Rights and Intellectual Property: Conflict or Coexistence?" 5 *Minn. Law Rev* 47 (2003).

the fourteenth century for passing off a substandard wine under a false mark, it became necessary to develop the trademark law to address the breach of customs.²

In 1266, the first Trademark Law which was also known as the Bakers Marking Law, was introduced by the Parliament of England, whereby all the bakers were required to put marks on their bread loaves so that the public could distinguish the bread of a particular baker from that of the other, on the basis of quality, price and quantity. Over the years the trademark law kept on evolving by protecting the rights of the traders and the public as well.

A trademark is a powerful tool for fostering goodwill towards an entity by leaving a lasting impression on the public's mind that ensures satisfaction and sparks their desire for more. India has also seen an immense transition in trade mark law and finally, in the wake of globalization, it amended the law in conformity with the International Conventions and WTO.³

Usually, the trademarks are perceived as those signs or logos that serve to identify the source of products and services. A non-conventional trademark, also termed as non-traditional trade mark is a trademark that is not a part of traditional exhaustive category of traditional trademarks. Even though they frequently pose registration challenges, nevertheless they meet the necessary requirements to be considered as a trademark. The traditional or conventional marks include those consisting of "device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination thereof."⁴

Therefore, the unconventional symbols are derived from the way they look, their form, the sounds they make, their scent, taste, and the feel. The rise in commercial competition and a growing market has forced intellectual property owners to develop innovative ways to stand out from competitors, enhancing their products with a unique advantage. Due to recent legislative developments that have broadened the definition of 'trademark,' non-conventional trademarks have more scope of registration.

2. CONCEPT OF NON-VISIBLE TRADEMARKS

Traditional trademarks in the form of words, logos, and devices have been in use since long time to indicate the source of goods. With time, apart from the logos, colours, and words, other elements have been used to identify the origin of products and services. Non-conventional trademarks are emerging as the most striking branding strategy of the 21st century.⁵ They include (i) visible marks in form of shapes, colours, moving images, hologram etc. or (ii) any non visible marks based on fragrance, taste, sounds, or textures.⁶

3. KINDS OF NON-VISIBLE TRADEMARKS

For over twenty years, various companies have been using the shape, colour, stitching pattern design, and sound to indicate the origin of their brand, even though the legal protection and registration of such marks were developed later. Globally speaking, non-visible trademarks fall into the following primary categories:

- i. Sound Marks;
- ii. Smell or olfactory marks;
- iii. Tactile or touch marks;
- iv. Taste or gustatory marks;

Against this backdrop, this article shall only focus on the issues and challenges regarding the protection of non-visible trademarks.

SOUND MARKS

Sound though, has been categorized as a non-visible mark, however, its visual perceptibility is quite clear and well-settled. These marks are capable of graphical representation through notations and have been granted protection in both civil and common law countries.

The public's perception of a trademark is greatly influenced by its sound. Since sound marks are the only non-visible marks that have been granted protection in India. The Indian Trademark Registry granted the first sound mark, yodel, to Yahoo. On August 18, 2008, it was approved in favour of Yahoo Inc., a California based Internet company, for its three-

²Mark A. Lemley, "Property, Intellectual Property, and Free Riding" 83 *Tex. Law Rev* 1031 (2005).

³Lisa Lukose, "Unconventional Trademarks: Novel Trends in the Modern Trademark Law" 1(1) *CNLU Law Journal* 22-33 (2010).

⁴Section 2(1)(m), The Trade Marks Act, 1999.

⁵L Martin, *Brand Sense: Build Powerful Brands through Touch, Taste, Smell, Sight and Sound*, Kogan Page Publisher, London 6th edn. (2005)

⁶Harsimran Kalra, "Unconventional Trademarks: The Emergent Need for a Change" 4 *India Law Journal* (2007)

note *Yahoo Yodel*.

Following Yahoo Yodel, ICICI applied for the registration of sound mark in India. *Dhin Chik Dhin Chik*, the corporate jingle of one of the biggest private banks in India, got its sound mark registered. It is actually this song that ICICI customers hear when they contact the bank. A sound's potential distinctiveness or degree of acquired distinctiveness determines whether a trademark is acceptable. It refers to the likelihood that the typical customer will interpret the sound as implying that the products or services are only connected with one entity.⁷ Allianz Aktiengesellschaft⁸ of Germany was granted permission by the trademark registry to register yet another sound mark in India.

Following the practice in several jurisdictions, the Indian Trademark Registry has accepted the musical notes of the melody or sound, along with a description of the sound, to be adequate to satisfy the criteria of graphical representation and capable of distinguishing the mark with these registrations and subsequent trademark applications. It is claimed that this can pave way for trademark protection to some of the most recognizable sounds.⁹

It is must to know that definition of a trademark does not require the mark to be visually perceptible, however, it must be able to be represented graphically. Therefore, it can be stated that the sound trademark will meet the criteria for a mark as per the Trade Marks Act.¹⁰ The publication of Yahoo's sound mark for the purpose of any third party to file opposition appeared as: "*The mark consists of the sound of a human voice yodeling the word Yahoo.*" However, the detailed description of the yodel was done by using a musical image of the yodel. The mark is registered under class 35, 42 and 38. Thus, the registration of Yahoo yodel proves the fact that the sound trademarks are eligible for registration as a trade mark in India.¹¹

Furthermore, a sound trademark is a trademark that uses sound, as opposed to visual depiction, to distinguish its products or services. On the other hand, sound mark is also capable of graphical representation through music notations. The sound trademark is a trademark that uses musical notations to distinguish the products of one entity from those of other.

PROCEDURE FOR REGISTRATION OF SOUND MARKS

The word 'trademark' as defined under sec. 2(1) (zb) of the Trade Marks Act 1999 is "a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others and may include shape of goods, their packaging and combination of colours" and since, sound trade mark is a trade mark that performs the function of trademark through audio rather than visual depiction, hence, the requirements for the registration of trade mark is equally applicable on the sound mark as well. Furthermore, the Draft Manual classifies sound marks as one of the non-conventional marks and lays down the directives for the registration of such marks.¹²

Therefore, three conditions can be inferred which need to be satisfied by a mark to be registered as a sound trade mark. Such conditions are:

- (a) For the registration, the initial requirement demands that the sound mark must fall within definition of 'mark', as per the Trade Marks Act, 1999. According to Section 2(1) (m) of the Act, a mark can be "a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging, or a combination of colors, or any combination thereof". The use of the word 'includes' in the definition of mark indicates that it is not limited and therefore, the non-visible marks should not be excluded from being classified as marks. In addition, the judiciary tends to interpret the term 'mark' broadly. The approval of sound marks in India shows the judiciary's willingness to move past traditional trademark beliefs. Therefore, the term 'mark' should be understood in a wider sense.
- (b) Secondly, the mark needs to be graphically representable in order to be registered as a sound trademark. The Trade Marks Act, 1999 does not provide a specific definition for the phrase 'graphically represented,' but the term is easy to understand and implies a depiction that consumers can see and understand. Nonetheless, the definition of 'graphical representation' in the Trade Mark Rules, 2017 is the portrayal of a trademark for goods or services on

⁷ Lisa Lukose, "Non-Traditional Trademarks: A Critique" *Journal of the Indian Law Institute*, Vol. 57, No. 2 (2015)

⁸ *Ibid.*

⁹ V.K.Ahuja, "Modern Trade Marks," 1 (8) *Lex Witness* 8-11 (2010).

¹⁰ M M S Karki, "Non-traditional Areas of Intellectual Property Protection: Colour, Sound, Taste, Smell, Shape, Slogan and Trade Dress" 10(6) *JIPR* 499 (Nov. 2005)

¹¹ *Ibid.*

¹² Sr. No. 3.2.4 of Draft Manual, 2015, Available at: chrome-extension://efaidnbmnnnibpcajpcglclefindmkaj/https://ipindia.gov.in/writereaddata/Portal/IPOGuidelinesManuals/1_32_1_tmr-draft-manual.pdf

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paper. The mark must be presented in paper format as musical notations can also be represented in paper or 2D form, making them eligible for graphical representation.

- (c) Finally, the sound must demonstrate acquired distinctiveness to be registered as a trademark. Nevertheless, it can be argued that initially, no sound can be considered suitable for registration until evidence of having acquired uniqueness is provided.¹³

• OLFACTORY MARKS

Manufacturers of various products use scents to enhance the appeal and enjoyment of their goods as a marketing tactic. Cleaning products, beauty products, and laundry products are among the items. Magazines, pens, paper, and erasers are now made with specific scents to enhance their attractiveness, even if the connection may not be immediately apparent. Customers who use scented products are not likely to indicate the origin of the products simply by the smell. In any situation, a mark must be 'graphically represented' to be eligible for trademark registration.¹⁴

It is crucial to mention that the essence of a trademark's distinctiveness can only be attained when there is a medium that effectively describes the smell/scent of a trademark. A trademark can only be registered when a graphical representation provides a clear, precise, and objective depiction of the mark.

- As per Section 29 of the Trade Marks Act, 1999 to be properly enforced in cases of trademark infringement, ensures that the trademarks are represented in a way that allow for a clear comparison.
- Other traders will be able to accurately identify the products that have already been registered by other traders operating in the same industry.
- The public recognizes the 'smell' that defines the product being sold, in cases where products have similar scents, they can read the label on the back which describes the scent, helping them make a decision.

In India, the potential for the legal acceptance of a smell mark as a valid trademark has not been fully explored. Someday, scents like sandalwood from incense sticks and jasmine from perfume oils could become recognized trademarks if claims for smell trademarks are presented to the trademark registry and Indian law is required to consider new ways of representing smells for trademark registration.

• TASTE OR GUSTATORY MARKS

The WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications provides that graphical representation of gustatory marks is possible by providing a written description of the taste and indicating that it is a taste mark.¹⁵ Nevertheless, it must also undergo the non-functional testing phase.¹⁶ It is, however, difficult to meet the criterion of distinctive character. In India, it is highly unlikely for taste trademarks to be considered inherently distinctive without any evidence of acquired distinctiveness.¹⁷ The Draft Manual fails to recognize taste marks as one of the non-conventional marks; hence, in India the trademark jurisprudence relating to smell marks is still awaiting its dawn.

• TACTILE MARKS

Using touch as a sensory branding is a challenging task. Similar to other non-conventional trademarks, tactile marks should not serve any functional purpose. A cell phone that is programmed to increase in temperature when it rings

¹³ S. Bhattacharjee & G. Rao "The Broadening Horizons of Trade Marks Law Registrability of Smell, Sports Merchandise and Building Designs as Trade Marks, 10 *JIPR* (2005)

¹⁴ Tanusree Roy, "Registrability of Smell Mark As Trademark: A Critical Analysis", *Journal on Contemporary Issues of Law*, Vol IV(3)(2018)

¹⁵ "Standing Committee on the Law of Trademarks, Industrial Designs And Geographical Indications", WORLD INTELLECTUAL PROPERTY ORGANIZATION, GENEVA (May 2009), p.5

Vrinda Sehgal, "Touch, Taste and Position : Non Conventional Trademarks In The Evolving Landscape Of Branding" *LEXOLOGY* (2023), Available at: <https://www.lexology.com/library/detail.aspx?g=630309da-fe34-4181-943d-4c97e31f5a42>

¹⁶ "Smell, Sound and Taste – Getting a Sense of Non-Traditional Marks", *WIPO Magazine* (Feb. 2009); Available at: https://www.wipo.int/wipo_magazine/en/2009/01/article_0003.html

¹⁷ Vrinda Sehgal, "Touch, Taste and Position : Non Conventional Trademarks In The Evolving Landscape Of Branding" *LEXOLOGY* (2023), Available at: <https://www.lexology.com/library/detail.aspx?g=630309da-fe34-4181-943d-4c97e31f5a42>

in order to grab the user's attention, or a simulated sticky steering wheel that improves its functionality, may not be eligible for registration.. Tactile mark does not automatically function as a trademark upon its first use. Artificial textures are not automatically eligible for trademark protection. Rights over the tactile marks are generally claimed by the established use over a period of time,¹⁸ thus, making acquired distinctiveness as one of the important factors for the registration of these marks.

4. PROTECTION: ISSUES AND CHALLENGES

The registration process for smell, taste, and touch marks is ambiguous mostly due to the requirement for 'graphical representation' in the Trademark Law. In addition to this, it is important to discuss the Trademark Rules regarding the protection and registration of non-conventional trademarks. An application for the registration of trademark mandates its graphical depiction, requiring that it be represented on paper, in a durable form.

The title of the Rule 30 of the Trademark Rules requires that the representation must be 'durable' and 'satisfactory'. The term 'satisfactory' gives limited discretion to the Registrar of Trade Marks as the graphical representation made by the applicant must be, satisfactory for the Registrar. The plain reading of the rules suggests that the Registrar has discretion to take a copy of the trade mark if the applicant is unable to submit the graphical representation in the prescribed format of the rules.

The discretion of Registrar regarding his satisfaction for the graphical representation of a trade mark is governed by the trade mark definition and pre-requisite of graphical representation. The mark is graphically represented in Registrar's view when :

The representation of a trade mark is in paper form.

- a) It is possible to determine from the graphical representation precisely what the mark is that the applicant uses or proposes to use without the need for supporting samples etc.
- b) The graphical representation can stand in place of the mark used or proposed to be used by the applicant because it represents the mark and no other.
- c) It is reasonably practicable for persons inspecting the register, or reading the Trade Marks Journal, to understand from the graphical representation what the trade mark is." ¹⁹

A trademark can include a sound, smell, taste, or touch mark, and can be depicted with musical notes, chemical formulas, or a detailed description of the touch with or without words. In line with European Union practice, India also follows the rule that non-visible marks must be capable of being visually perceived in order to qualify for protection under the law. Therefore, these marks must meet the graphic representation requirements when applying for protection. The representation must be clear, precise, self-contained, easily accessible, intelligible, durable, and objective.

It is pertinent to note that the Trade Mark Draft Manual has welcomed the progress in the development of non-visible trademarks by making distinctiveness a prerequisite for registration. Having a fair perspective, it has been explained that non-visible marks can be registered as trademarks, but only if the mark is unique and has gained a secondary meaning, resulting in a stringent requirement for distinctiveness for the marks.

Even though graphical representation and secondary meaning associated with non-visible trademarks are essential, the requirement for representation presents a greater challenge for registering the non-visible marks. The Manual in draft form does not provide clear guidance on these marks, only mentioning the potential issue. If a feasible and cost effective solution is found to eliminate the impediment of graphical representation, non-visible marks can be legally registered as long as they are distinctive. The registration procedure for these marks rests upon the requirement of graphical representation which is difficult to be fulfilled. The graphical representation of these marks is more of a practical problem rather than a legal problem, making the law static, giving protection to only the traditional marks, whereas, the inclusive definition for "marks" and "trademarks" under the Act, makes the law dynamic and more adaptive to the need and changes in the society, fashioning the law related to non-visible marks an unusual blend of static and dynamic provisions, creating one of the most difficult conundrums for the experts. By embracing this perspective, the legislature has established a balance in safeguarding these non-visible marks within trademark law. While offering a broad abstract

¹⁸ Lisa P. Lukose, "Unconventional Trademarks: Novel Trends in the Modern Trademark Law" 1(1) *CNLU Law Journal* 22-33 (2010).

¹⁹ Draft Manual Trademark for the Practice and Procedure (2009), para 4.2.4.;
Available at : chrome-extension://efaidnbmninnibpcapjpcglclefindmkaj/https://anandnataraj.com/wp-content/uploads/2009/05/draftmanual_tmr_23january2009.pdf

definition for judicial interpretation, they have also included a requirement for graphical representation to protect producers from unfair competition.

5. VISUAL PERCEPTIBILITY UNDER THE TRADEMARKS ACT, 1999

The TRIPS intended to make visual perceptibility a condition of registration, but the Indian legislation by including this condition under the very definition of trademark makes it a condition for constituting a trademark, hence for a mark to become a trademark it must be “capable of being represented graphically” otherwise, a mark cannot be called as a trademark. The provision is certainly not TRIPS compliant, since the agreement intends to give a very objective definition to trademarks and the act makes the definition a subjective one, giving rather farfetched discretion to debate upon what constitutes a trademark and what does not. This problem bars not only the registration of non-visible signs as trademarks but also does not put them in the category of being trademarks at all, leaving no scope of protection for them even under concept of passing off as unregistered trademarks. Exclusion from registrability does not mean necessarily exclusion from protection. WTO Members may be authorized to exclude certain marks from registration and yet be obliged to give protection to these marks, but this provision under the Trade Marks Act, 1999 does not even leave this last straw of protection for non-visible marks since, a mark which lacks visual perceptibility is not even a trademark, and is only an ordinary mark. This view also applies to the fact that the Agreement does not leave room for WTO Members to decide what a trademark is. Therefore, in principle, the registration and protection of a scent, taste or touch may depend upon the policy adopted by the national legislation but to decide what a trademark is beyond their jurisdiction. No wonder the jurisprudence relating to non-visible marks in India is scarce, there is no way around these legal impediments under the Indian Trademark Law, and hence the scanty number of applications for the registration of these marks. Non-visually perceptible marks in India are not only fighting for registration as trademarks but are also fighting for their status as trademarks.²⁰ India in order to address this legal impediment can either amend the definition of trademarks, making “capable of being represented graphically” a condition of registration or the Rules to the legislation be amended, altering the definition of “graphical representation” to include a way of representing non-visible marks other than in paper form.

Another suggestion which can be made here is that India may adopt an approach as under the Designs Act, which defines “original” to include the cases which though old in themselves yet are new in their application. Hence, the distinctiveness criteria under the trademark law can be satisfied in the same way, where distinctiveness should not solely be judged on the bases of the trademark but the “trademark when applied to a product” should be distinctive. Like “*cherry blossom scent when applied to plastic bags*” makes it distinctive, because plastic bags normally do not smell of cherry blossoms but when they do, it is unique and distinctive in itself. Once the criterion of distinctiveness is satisfied, the protection should not be refused on the ground that it is not visually perceptible.

6. CONCLUSION

It is evident from the aforementioned discussions that for an non-visible mark feature to be registered as a trademark, it must have inherent distinctiveness. However, for gustatory and tactile marks, the inherent distinctiveness alone would not be enough. Consumers in the specific market sector need to have personal experience with the product in order to recognize its unique qualities through taste or touch. Therefore, these marks need to meet the requirements of obtaining a distinctive character through the use of the mark in connection to the specific product, demanding not only a greater level of inherent distinctiveness but also a greater level of acquired distinctiveness from using the mark. Secondly, the Indian law relating to trademarks is inconclusive which makes it difficult for the protection and registration of non-visible non-conventional trademarks, thus the law requires a harmonious construction of the varied dispositions.

CONFLICT OF INTERESTS

None

ACKNOWLEDGMENTS

None

²⁰ Dev Gangjee “Non Conventional Trade Marks in India” *National Law School of India Review*: Vol. 22:1 (2010)