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ABOUT US

WHITE BLACK LEGAL is an open access, peer-reviewed and refereed journal providededicated to express views on topical legal issues, thereby generating a cross current of ideas on emerging matters. This platform shall also ignite the initiative and desire of young law students to contribute in the field of law. The erudite response of legal luminaries shall be solicited to enable readers to explore challenges that lie before law makers, lawyers and the society at large, in the event of the ever changing social, economic and technological scenario.

With this thought, we hereby present to you

Irene's Take On Progressive Trademarks

Authored By – Adv. Neha Irene Saluja



Introduction

A roar of the lion, at the beginning of MGM produced film, a jingle – “ting ting tiding”, yes you got it right, its Britannia biscuits ad. If you see a large brown truck crossing across the street, you know that there is a delivery for someone. Do you recognise those red sole shoes? Of course the name which comes to our mind is Christian Louboutin.

The success of these trademarks goes beyond their logos. But how does a trademark goes beyond the symbols and logos which are associated with their products? Conventional Trademarks had symbols, logos and tag lines but as the time is evolving, so are the trademarks. Now Progressive Trademarks which are also known as Non-conventional or Traditional Trademarks have into existence. These Progressive Trademarks include smell, colour, sound, ambience, shapes, motion, packaging, texture etc.

What Are Trademarks?

Trademarks are a type of intellectual property that consists of letters, words, designs, logos and symbols which can be used to distinguish the products and services of a particular brand to another brand. By looking at a trademark one can easily identify the brand.

Section 2(z)(b) of the Trademarks Act, 1999 defines Trademarks as a mark which is capable of being represented graphically and is capable to distinguish the goods and services of one person to another and may include the packaging, shape of goods and combination of colours.

Types of Conventional Trademarks

1. **Word Marks** – These may be letters, words or numerals. Some of the word marks are Jeep, Subway, Goggle, Disney, Coca Cola etc.



2. **Device marks** - A device mark is a **design or graphic image** which may or may not have words. It may be represented along with colours. Some of the device marks are Apple, Puma, Android, Java etc.



3. **Service Marks** – These marks are used to distinguish the services offered by a person/company. Some of them are NBC News, Forbes, ESPN, The Hollywood Reporter etc.



4. **Collective Marks** – These marks are owned by the associations or organisations to distinguish themselves or their members from others. Some of the collective marks are CA used by Institute of Chartered Accountants, Reliance, Tata, FTD used by Florists' Transworld Delivery etc.



5. **Certification Marks** – These marks are used to define standards. These marks assure that a product has gone through a standard test of quality. Some of them are ISI Mark, BIS Hallmark, Agmark, FPO etc.



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What Are Progressive Trademarks?

A progressive or non-conventional trademark is technically any new type of trademark that does not fall in the pre-existing statutory conventional categories of trademarks. These types of trademarks can be classified as motion marks, colour marks, sound marks, texture marks, taste marks, olfactory marks etc. The unconventional trademarks get recognition for their inherently distinctive features.

With an increase in the trend of individuals and companies desiring to create a unique identity for themselves, unconventional or non-traditional trademarks have gained prominence in the past couple of years. In preceding times, registering a progressive trademark was never thought of and it was considered non-viable as the Trade Marks authority of India had a retrogressive approach while handling such applications for Trademarks.

However, the Trade Marks Act, 1999 initiated certain statutory provisions to accommodate filing of such progressive trademarks.

Although, progressive trademarks are recognized in foreign jurisdictions but the Indian Trademark

Law recognizes only Colour (Combination of colours), sound marks & shape of goods as registrable marks. According to the Trademark Act, a mark must be either graphically representable in a paper form or should have acquired distinctness or secondary meaning due to its prior use to secure a trademark protection. As taste, smell, texture and hologram marks cannot be represented graphically, hence they cannot be registered in India.

Let us discuss some of the progressive trademarks.

Types Of Progressive Trademarks

1. Colour Trademarks - A trademark can be limited to a specific colour or a combination of colours. The colour, or the combination thereof, must be competent of distinguishing the products of the entity from the others in the market. The applicant must have some definite or adequate evidence as proof to show that the colour or the combination is in line with his goods or services.

Colours can be precious brand signifiers. Once registered they provide the trademark owner with an exclusive right to use that particular shade of colour, in relation to the goods/services for which it is registered and in the territory for which it is registered, and to restrict others from using an identical/similar colour in relation to identical/similar goods/services, in the territory of registration. Colour trademarks are almost impossible to protect. The courts are resistant to endeavour to claim a monopoly on a colour, for general interest and free competition.

Case 1 - Cadbury Purple

The colour, known as Pantone 2685C, was trademarked for Cadbury in 1995 covering chocolate bars and tablets. In the early 2000s when Cadbury attempted to trademark the colour for a wider range of chocolates it was opposed by Nestle. The UK Court of Appeal and UKIPO rejected the appeal on the grounds of imprecise description particularly the word “predominant colour” in the description



Case 2 – RED Sole Shoe

The Red Sole is a Luxury brand by Christian Louboutin and it has a presence in 60 countries worldwide. It has been using the mark since 1992 and the mark has acquired a status of a ‘well known mark’. When it was found that a company named – Ms. Veronica (Mumbai) was manufacturing the red sole shoes in Mumbai, the case of Trademark Infringement was filed against the company. The High Court held that single colour trademark is not recognized in India so the

infringement suit was dismissed. However, the appeal was filed as the brand was a 'well know mark' and it deserved protection from infringement.



The Single colour trademarks attract 95% of opposition and it is not advisable in my opinion to trademark a single colour for your trademark or logo as single colour restricts the scope of the brand from changing its colour. Like if a company is expanding it would like to make a few changes including the trademark or logo. But if the company has registered for a single colour, it will limit its scope. So, while registering a trademark, black and white colour is advisable.

2. Motion Marks – Motion Marks comprise of animated Logos like the windows start-up logo, Netflix opening motion etc. The first motion trademark was accepted in the name of Nokia Corporation's for its trademark CONNECTING HANDS in 2003 in India. This mark was accepted as a device trademark and several still pictures were reproduced as a part of the mark, depicting step by step motions.

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A motion trademark must be demonstrated as a combination of movement and sound. It must be able to show that the motion in question, serves to identify a particular good or product. It may qualify as distinct, if the general public identifies it with a specific product or goods. Fair amount of evidence is required to prove the distinctiveness; however, the proof can come in the form of primary or direct as well as secondary or indirect data. In addition to distinctiveness three dimensional applications must also qualify a requirement of registration. However, it must not put competitors at a disadvantage of not being able to claim general features in a market.

Sony Ericson's Logo

Sony Mobile's moving portrayal of its circular logo with a flowing orange ribbon moving like a liquid. It was represented in the records of the EU IPO as a series of figures (20 figures in all) presented in JPEG format.



Microsoft Windows

Microsoft window's logo is a well-known example of motion mark registered. We see it once we open the windows PC and Laptop.



3. Sound Marks – These are those marks which are perceived by hearing and which are distinguishable by their exclusive and distinctive sound can be registered as sound marks. The use of sound marks as a branding technique has been expeditiously growing across the globe since 2017. These marks are not only restricted to musical works, but also include non-musical sounds. Non-musical sounds have been approved as sound marks owing to their acquired distinctiveness. E.g., MGM Lion's Roar.

Since the emergence of electronic media, sounds have been used to depict a brand, product and service over the traditional mediums, since they are linked to the sensory organs. Sound marks which belong to the domain of sensory marks have been associated with branding even before they acquired legal recognition.

Distinctiveness of a sound mark is very requisite for its registration. Trademark Rules, 2017 (Rule 26) mandates the production of sound mark in a recorded MP3 format along with its musical notations. This aims at approving distinctive and novel marks for protection, which is also a fundamental principle in the domain of trademark law.

NBC Chimes

In the United States, the first sound to acquire legal protection was the “NBC chimes”, which had the musical chords ‘G, E, C’ played on chimes. It was recognized as a sound mark by the United States Patents and Trademark Office (USPTO) in the year 1947.



Yahoo

The first sound mark registration in India was Yahoo. Later, India adopted the provisions of EUIPO and released the Trademark Rules, 2017, which prescribed the manner in which a sound mark should be registered under Section 26. The Trademark Rules, 2017 [Section 26 (1)(iii)(ii)] mandate that a

sound mark seeking registration, should be propounded in an MP3 format with its length not exceeding 30 seconds, and along with a graphical representation through musical notations of the particular mark.



4. Smell Marks – Do you like the smell of wet mud in a rainy season? Can you believe that smell as trademark can also be registered? Well yes, smell is said to be one of the most puissant types of human memory, and businesses show increasing interest in pairing scents with their products. To obtain registration of a smell mark, the applicant must be able to visually represent the product’s scent and must show that it differs from the product itself. E.g., a bottled sample of the smell would decay over the time and could therefore not be kept on a trademark register but how does one represent a smell in a visual way? The answer is - any written description of a smell must be so precise that that particular smell would not be confused with any other. When the smell is unique and cannot be mistaken for an associated product, it can be registered as a smell mark.

A Dutch company’s tennis balls, with the aroma of newly mown grass and Unicorn Products - darts with “the strong smell of bitter beer” are some of the illustrations of the smell marks in UK.



Conclusion

The acceptance of a progressive marks is opening up new doors for business but irregularities do exist since the tools to evaluate distinctiveness are not apt for non-conventional marks like sound marks. Motion mark as a trademark is rarely registered as they have just gained relevance with technological advancement in this arena. At present, the demand for Progressive trademark registration is relatively low. While the groundwork of registering a trademark is the same for both non-conventional & conventional trademarks, what differs is the requirement to graphically represent the unconventional subject matter of the trademark application.

Statutorily there's hardly any mention of these diverse kinds of trademarks both in Indian legislations and in TRIPS, therefore a greater emphasis is placed upon the judicial precedents set over time.

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