



INTERNATIONAL LAW  
JOURNAL

---

**WHITE BLACK  
LEGAL LAW  
JOURNAL  
ISSN: 2581-  
8503**

*Peer - Reviewed & Refereed Journal*

The Law Journal strives to provide a platform for discussion of International as well as National Developments in the Field of Law.

[WWW.WHITEBLACKLEGAL.CO.IN](http://WWW.WHITEBLACKLEGAL.CO.IN)

### **DISCLAIMER**

No part of this publication may be reproduced or copied in any form by any means without prior written permission of Editor-in-chief of White Black Legal – The Law Journal. The Editorial Team of White Black Legal holds the copyright to all articles contributed to this publication. The views expressed in this publication are purely personal opinions of the authors and do not reflect the views of the Editorial Team of White Black Legal. Though all efforts are made to ensure the accuracy and correctness of the information published, White Black Legal shall not be responsible for any errors caused due to oversight or otherwise.

WHITE BLACK  
LEGAL

## **EDITORIAL TEAM**

### **Raju Narayana Swamy (IAS) Indian Administrative Service officer**



Dr. Raju Narayana Swamy popularly known as Kerala's Anti-Corruption Crusader is the All India Topper of the 1991 batch of the IAS and is currently posted as Principal Secretary to the Government of Kerala. He has earned many accolades as he hit against the political-bureaucrat corruption nexus in India. Dr Swamy holds a B.Tech in Computer Science and Engineering from the IIT Madras and a Ph. D. in Cyber Law from Gujarat National Law University. He also has an LLM (Pro) (with specialization in IPR) as well as three PG Diplomas from the National Law University, Delhi- one in Urban Environmental Management and Law, another in Environmental Law and Policy and a third one in Tourism and Environmental Law. He also holds a post-graduate diploma in IPR from the National Law School, Bengaluru and

a professional diploma in Public Procurement from the World Bank.

### **Dr. R. K. Upadhyay**

Dr. R. K. Upadhyay is Registrar, University of Kota (Raj.), Dr Upadhyay obtained LLB, LLM degrees from Banaras Hindu University & PHD from university of Kota. He has successfully completed UGC sponsored M.R.P for the work in the Ares of the various prisoners reforms in the state of the Rajasthan.



## **Senior Editor**

### **Dr. Neha Mishra**



Dr. Neha Mishra is Associate Professor & Associate Dean (Scholarships) in Jindal Global Law School, OP Jindal Global University. She was awarded both her PhD degree and Associate Professor & Associate Dean M.A.; LL.B. (University of Delhi); LL.M.; PH.D. (NLSIU, Bangalore) LLM from National Law School of India University, Bengaluru; she did her LL.B. from Faculty of Law, Delhi University as well as M.A. and B.A. from Hindu College and DCAC from DU respectively. Neha has been a Visiting Fellow, School of Social Work, Michigan State University, 2016 and invited speaker Panelist at Global Conference, Whitney R. Harris World Law Institute, Washington University in St. Louis, 2015.

### **Ms. Sumiti Ahuja**

Ms. Sumiti Ahuja, Assistant Professor, Faculty of Law, University of Delhi,

Ms. Sumiti Ahuja completed her LL.M. from the Indian Law Institute with specialization in Criminal Law and Corporate Law, and has over nine years of teaching experience. She has done her LL.B. from the Faculty of Law, University of Delhi. She is currently pursuing PH.D. in the area of Forensics and Law. Prior to joining the teaching profession, she has worked as Research Assistant for projects funded by different agencies of Govt. of India. She has developed various audio-video teaching modules under UGC e-PG Pathshala programme in the area of Criminology, under the aegis of an MHRD Project. Her areas of interest are Criminal Law, Law of Evidence, Interpretation of Statutes, and Clinical Legal Education.



### **Dr. Navtika Singh Nautiyal**

Dr. Navtika Singh Nautiyal presently working as an Assistant Professor in School of Law, Forensic Justice and Policy Studies at National Forensic Sciences University, Gandhinagar, Gujarat. She has 9 years of Teaching and Research Experience. She has completed her Philosophy of Doctorate in 'Inter-country adoption laws from Uttarakhand University, Dehradun' and LLM from Indian Law Institute, New Delhi.

### **Dr. Rinu Saraswat**



Associate Professor at School of Law, Apex University, Jaipur, M.A, LL.M, PH.D,

Dr. Rinu have 5 yrs of teaching experience in renowned institutions like Jagannath University and Apex University. Participated in more than 20 national and international seminars and conferences and 5 workshops and training programmes.

### **Dr. Nitesh Saraswat**

E.MBA, LL.M, PH.D, PGDSAPM

Currently working as Assistant Professor at Law Centre II, Faculty of Law, University of Delhi. Dr. Nitesh have 14 years of Teaching, Administrative and research experience in Renowned Institutions like Amity University, Tata Institute of Social Sciences, Jai Narain Vyas University Jodhpur, Jagannath University and Nirma University. More than 25 Publications in renowned National and International Journals and has authored a Text book on CR.P.C and Juvenile Delinquency law.



### **Subhrajit Chanda**



BBA. LL.B. (Hons.) (Amity University, Rajasthan); LL. M. (UPES, Dehradun) (Nottingham Trent University, UK); PH.D. Candidate (G.D. Goenka University)

Subhrajit did his LL.M. in Sports Law, from Nottingham Trent University of United Kingdoms, with international scholarship provided by university; he has also completed another LL.M. in Energy Law from University of Petroleum and Energy Studies, India. He did his B.B.A.LL.B. (Hons.) focussing on International Trade Law.

## ***ABOUT US***

WHITE BLACK LEGAL is an open access, peer-reviewed and refereed journal provide dedicated 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

# **UNDERSTANDING NON-CONVENTIONAL MARKS: RECOGNITION, ENFORCEMENT, AND JURISDICTIONAL ANALYSIS**

AUTHORED BY - SAI RISHIKA SADA

Student pursuing BALLB (H) at Christ (Deemed to be) University

## **Abstract**

Trademarks have moved beyond the classic visual markers like names and logos to cover a broader array of non-conventional marks (NCMs) like sound, colour, shape, scent, motion, and holograms. These non-traditional identifiers have emerged as effective branding aids in a world that is becoming increasingly competitive. Their recognition and protection, however, are still patchy across jurisdictions. This article conducts a comparative study of the United States, the European Union, and India in terms of treating NCMs.

The U.S. follows a liberal policy under the Lanham Act that protects marks on the basis of distinctiveness and non-functionality. The EU, though initially formalistic in light of the graphical representation requirement, has updated its system post-2015 reforms to accommodate digital representations of NCMs, but continues to grapple with smell and taste marks. India, on the other hand, is conservative, with a statutory requirement for graphical representation confining protection primarily to sound, shape, and colour combinations. Based on analysis of leading cases and legislation, this paper identifies gaps in harmonisation, difficulties of distinctiveness and functionality, and enforcement problems. It finishes with suggestions for legislative change, procedural refinement, and institutional strengthening to create more effective, consumer-focused protection of non-conventional marks in India and to bring India into line with international standards.

**Keywords:** Non-Conventional Trademarks, Graphical Representation, Distinctiveness, Functionality doctrine.

## Introduction

Trademarks are one of the most important branches of Intellectual Property. It allows various businesses to protect themselves by giving them a unique identity, which eventually helps consumers to recognise and differentiate them from other businesses or brands. Initially, Trademarks were limited to names, logos, symbols, etc., which were easy to represent graphically and were easily seen. But due to globalisation and huge competition between businesses, they want to stand out in creative ways. This marked the evolution of Non-Conventional Marks. These marks go beyond the simple logo, symbols, words, etc., they consist of colours, shapes, sound, smell, holograms, motion, etc. The purpose of these marks is to attract customers and build a strong connection through these marks. The famous non-conventional Marks that have built strong connections among consumers are the Nokia ringtone, Cadbury purple colour, etc. Article 15 of the TRIPS agreement<sup>1</sup> defines trademarks as “any sign” that distinguishes the goods or brands from others and can be protected. This can be interpreted that non-conventional marks could be protected, as it does not mention anything that trademarks should be visually or graphically representable<sup>2</sup>. Also, the World Intellectual Property Organisation (WIPO)<sup>3</sup> has classified the non-conventional marks into two broad categories- visual marks, which include colours, shape, holograms, etc. and non-visual marks such as sound, taste, texture and smell. We can say that there is room for broad protection. But in practice, different countries treat non-conventional marks differently. In the United States of America, the Lanham Act<sup>4</sup> does not require a visual or graphical representation. It focuses on distinctiveness from other businesses or brands. This is the reason many unusual or non-conventional marks, such as MGM’s lion roar, NBC’s three-note chime and many more, were protected in the United States<sup>5</sup>. The European Union mainly followed a traditional approach earlier. They believe in graphical representation. They are open to non-conventional marks unless there is a graphical presentation of such marks, for example, in the case of Sieckman, where the court refused the protection cause the chemical proposition given by them was not clear and precise. But now, there is an addition along with a graphical representation; they can submit sound files, videos, and digital images<sup>6</sup>. In India, there is a more conservative approach.

---

<sup>1</sup> Agreement on Trade-Related Aspects of Intellectual Property Rights art. 15, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, 1869 U.N.T.S. 299.

<sup>2</sup> Abhijeet Kumar, *Protecting Smell Marks: Breaking Conventionality*, 21 J. Intell. Prop. Rts. 129 (2016)

<sup>3</sup> WIPO, *Smell, Sound and Taste—Getting a Sense of Non-Traditional Marks*, WIPO Mag. (2009).

<sup>4</sup> Lanham Act, 15 U.S.C. §§ 1051–1141n (2018).

<sup>5</sup> J. & A. Gilson LaLonde, *Cinnamon Buns, Marching Ducks and Cherry-Scented Racecar Exhaust*, 95 Trademark Rep. 1223 (2005).

<sup>6</sup> Shusaku Hidaka et al., *A Sign of the Time?*, 94 Trademark Rep. 1105 (2004).

Section 2(1) (zb) of the Trademarks Act 1999<sup>7</sup> requires a graphical representation. But there has been recognition of Yahoo yodel, ICICI Bank's jingle, and Colgate colour<sup>8</sup>. The courts are still rigid in the protection of smell marks, taste marks or other sensory marks. Scholars note that the rigidity of laws makes it difficult to align with TRIPS and other international trends. This paper seeks to address the gaps by examining the recognition and enforcement in jurisdictions like the United States of America, the European Union and India by analysing the case laws, statutory frameworks and debates by scholars on non-conventional marks, which demand legal reforms and technical advancements in the world.

### Understanding Non-Conventional Marks

The concept of Trademarks has gradually evolved from traditional recognition to more modern recognition due to changes in business practice, consumer behaviour and technological capabilities. The statutory definitions of non-conventional marks are as follows:

- TRIPS Agreement: Article 15 of the TRIPS Agreement defines Trademarks as follows: *"Any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark. Such signs, in particular words including personal names, letters, numerals, figurative elements and combinations of colours, as well as any combination of such signs, shall be eligible for registration as trademarks. Where signs are not inherently capable of distinguishing the relevant goods or services, Members may make registrability depend on distinctiveness acquired through use. Members may require, as a condition of registration, that signs be visually perceptible."*<sup>9</sup> It can be said that there is room for non-conventional marks in the definition of trips. As the definition does not limit trademarks to words, logos, or insist on a graphical representation.
- Lanham Act : § 45 (15 U.S.C. § 1127) defines trademark as follows *"The term "trademark" includes any word, name, symbol, or device, or any (1) used by a person, or (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter, identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown"*.<sup>10</sup> Same as the TRIPS

<sup>7</sup> Trade Marks Act, No. 47 of 1999, § 2(1)(zb) (India).

<sup>8</sup> Vatsala Sahay, *Conventionalising Non-Conventional Trademarks of Sounds and Scents*, 6 NALSAR Student L. Rev. 128 (2011).

<sup>9</sup> TRIPS Agreement, supra note 1, art. 15.

<sup>10</sup> Lanham Act, supra note 2, § 45 (15 U.S.C. § 1127).

agreement, courts in the US has interpreted “device” broadly to include non-conventional marks and give them protection.

- EU Trademark Regulation: Article 4 of the REGULATION (EU) 2017/1001 OF THE EUROPEAN PARLIAMENT AND OF THE COUNCIL defines Trademark as follows “An EU trade mark may consist of any signs, in particular words, including personal names, or designs, letters, numerals, colours, the shape of goods or of the packaging of goods, or sounds, provided that such signs are capable of: Distinguishing the goods or services of one undertaking from those of other undertakings; and being represented on the register of European Union Trademarks in a manner which enables the component authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor<sup>11</sup>.” Europe earlier, before the 2017 regulations, did not have this approach; before, they followed a traditional approach, sticking to graphical representation.

- Indian Trademarks Act 1999: Section 2 (1)(zb) defines trademark as follows — “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<sup>12</sup>.” Smell marks, motion marks, and other sensory marks have limited protection in India under this act, but sound marks can be protected through valid musical notations.
- Many academics have defined non-conventional marks beyond the visual imagination. They highlight two elements, the first of which goes beyond traditional logos or words, and the second, which will still serve the fundamental purpose of trademarks to distinguish a brand from others.<sup>13</sup>

The types of Non-conventional marks can be classified as follows:

- a) Colour Marks- These are the most recognised non-conventional marks worldwide. They may include a single or a combination of colours.
- b) Sound Marks- These marks include jingles, tunes and other audio identifiers which are required to be expressed by musical notations or MP3 for their protection.
- c) Smell Marks- These marks are most difficult to protect as it is difficult to represent such marks, but still, some countries have given protection to these marks.<sup>14</sup>

---

<sup>11</sup>Directive 2015/2436, supra note 3.

<sup>12</sup> Trade Marks Act, No. 47 of 1999, supra note 4, § 2(1)(zb) (India).

<sup>13</sup> Sudipta Bhattacharjee & Ganesh Rao, *The Broadening Horizons of Trademark Law*, 10 J. Intell. Prop. Rts. 120 (2005).

<sup>14</sup> Douglas Churovich, *Scents, Sense or Cents?*, 20 St. Louis U. Pub. L. Rev. 293 (2001).

- d) Shape Marks- These marks are usually protected in many countries as they are considered under the traditional definition of trademarks, which can be protected.
- e) Motion Marks- These marks usually include moving images or animations, which are usually represented by MP4 videos for protection.
- f) Taste Marks- As it is a sensory mark very difficult to represent to provide protection. No country has yet given protection to these types of marks.
- g) Texture Marks- These are the marks that rely on distinctive textures that consumers associate.
- h) Hologram Marks- These are usually hologram images, meaning that when looked at from different angles, they appear to be different images. Like other sensory marks, representation is an issue, but the European Union has allowed such marks to be represented through appropriate digital files.

### **Recognition and Enforcement of NCM across Jurisdictions**

The United States of America

The USA has been the most progressive jurisdiction when the matter of protecting non-conventional marks comes into the picture. This is mainly because of open interpretation of the Lanham Act<sup>15</sup> definition of trademarks makes it more flexible to include non-conventional marks, as it does not impose a requirement of graphical representation. Thus, the U.S. is often called the **most “future-ready” jurisdiction** for non-conventional marks. This is the reason the USA has protected various non-conventional marks, provided they meet two criteria: distinctiveness and non-functionality<sup>16</sup>. The following summarises the status of various non-conventional marks in the USA.

- Sound marks – The NBC’s<sup>17</sup> three noted chimes and MGM’s<sup>18</sup> roar were registered in the USA as trademarks on the grounds of distinctiveness and consistent use. Though a graphical representation is not possible, a sound recording or an MP3 is acceptable.
- Colour Marks – The Landmark case **Qualitex Co. v. Jacobson Products Co. (1995)**<sup>19</sup> was a milestone in USA trademark jurisprudence. **Qualitex Co. manufactured dry cleaning pads in a distinctive colour combination of green and gold. Jacobson**

<sup>15</sup> Lanham Act, supra note 5, § 45 (15 U.S.C. § 1127).

<sup>16</sup> Faye M. Hammersley, *The Smell of Success: Trade-Dress Protection for Scent Marks*, 2 Marq. Intell. Prop. L. Rev. 105 (1998).

<sup>17</sup> re National Broadcasting Co., 105 F.2d 836 (C.C.P.A. 1939).

<sup>18</sup> In re Metro-Goldwyn-Mayer Lion Corp., 202 U.S.P.Q. (BNA) 913 (T.T.A.B. 1979).

<sup>19</sup> *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159 (1995).

Products Co., which is a competitor, started selling in the same colour combination. Qualitex Co. filed for an infringement. The issue that arose was whether a single colour or a combination of colours can be trademarked under the Lanham Act. The US Supreme Court held that colour can be held as a trademark and protection can be given if it acquires distinctiveness and is not functional. This case opened the door to many other colour trademark cases. Cases like Owens Corning and Christian Louboutin built on these principles. It inspired debates in the EU (*Libertel* case) and India (Colgate, Britannia).

- **Smell Marks** – In the USA, the first smell mark granted was for a yarn thread with the scent of plumeria blossoms. The trademark was granted to the company named OSEWZ. In the year 1990, in the famous *Re Clarke* case<sup>20</sup>, the Trademark Trial and Appeal Board granted protection on the following reasons: fragrance was not an inherent part of yarn goods, the scent feature was highlighted, and customers associated the scent with the applicant's goods. This case gave other jurisdictions a model.<sup>21</sup>
- **Shapes Marks:** These marks can be easily represented and thus have protection in the USA. In the landmark case of *Wal-Mart v. Samara Brothers*<sup>22</sup>, Samara manufactured children's clothing with a unique design. Wal-Mart instructed its manufacturers to make dresses in the same manner as Samara. Samara filed an infringement. The main issue here was whether a product design that is distinctive can be protected. The Supreme Court held that a product of design cannot be inherently distinctive unless there is a secondary meaning – a consumer's association with that specific source.

The courts in the USA use the functionality principle for preventing the monopolisation of features which has to be used by every brand. The doctrine of functionality can be in two strands

- **Utilitarian Functionality:** A feature essential to the use, purpose, cost, or quality of the article cannot be protected.
- **Aesthetic Functionality:** A design or feature whose beauty itself drives consumer demand cannot be monopolised if doing so would hinder competition.

**The principle of functionality was derived from a landmark case of Christian Louboutin**

---

<sup>20</sup> *In re Clarke*, 17 U.S.P.Q.2d 1238 (T.T.A.B. 1990).

<sup>21</sup> J.E. Hawes, *Fragrances as Trademarks*, 79 Trademark Rep. 134 (1989).

<sup>22</sup> *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205 (2000).

**v. Yves Saint Laurent (2012)<sup>23</sup>. Louboutin had a trademark of red soles on women's shoes. YSL later sold shoes with red uppers and red soles. Louboutin sued YSL for infringement. The court later said it upheld the trademark of Louboutin's red sole but denied exclusivity of the entire shoe being red. It refined the functionality principle.**

Enforcement in the USA usually depends on proving the likelihood of confusion. The courts in the USA relied on consumer surveys, market recognition, advertisements, etc.<sup>24</sup> For example, in colour marks, an extensive marketing campaign demonstrating consumer association with the mark is crucial. The USA, hence, can be said to strike a balance; it welcomes recognition of NCM but polices the boundaries carefully to prevent anti-competitive monopolisation.

### European Union

The European Union has a very complex and evolving relationship with non-conventional marks. Unlike the USA, which is liberal and flexible from the start because of the trademark definition in the Lanham Act, the European Union followed a very traditional approach, which needed a graphical representation. This made non-conventional marks impossible to register in the EU for decades. However, there was an adoption of **Directive (EU) 2015/2436<sup>25</sup>** and the **EU Trade Mark Regulation (EUTMR 2017/1001)<sup>26</sup>**, which totally removed the requirement of graphical representation. Today, the EU trademark is considered to be one of the most structured and vigilant systems in dealing with non-conventional Marks. Alike the USA, the EU has the same criteria for recognition, the first one being Distinctiveness (Where the consumers identify the brand by perceiving the sign) and the second one being Non-functionality (the feature is not an essential to nature or technical function). After the change in regulation, the European Union has recognised various forms of non-conventional marks. The following summarises the status of various non-conventional trademarks in the European Union

- Sound Marks: In the case of *Shield Mark BV v. Joost Kist*<sup>27</sup>, Shield mark registered various sound marks, such as a rooster's crow and many more. Kist used the same sound. The issue that arose in the case was whether a sound mark can be treated as a

---

<sup>23</sup> *Christian Louboutin Sas v. Abu Baker*, 250 DLT 475 (Del. 2018).

<sup>24</sup> Michelle Gonzale, *So Let the Paint Be Spread: Louboutin Red Sole*, 15(1) Wake Forest J. Bus. & Intell. Prop. L. 92 (2014).

<sup>25</sup> Directive 2015/2436, supra note 6.

<sup>26</sup> Regulation 2017/1001, of the European Parliament and of the Council of 14 June 2017 on the European Union Trade Mark, 2017 O.J. (L 154).

<sup>27</sup> *Shield Mark BV v. Kist*, Case C-283/01, [2003] E.C.R. I-14313 (ECJ).

trademark. The court ruled that sounds are capable of being protected as trademarks, but the representation must be precise.<sup>28</sup> Musical notations were accepted, whereas verbal descriptions were denied. This brought up change, and after the regulation, they can now upload digital files, MP3.

- **Colour Mark:** In the case of *Libertel Groep BV v. Benelux-Merkenbureau*<sup>29</sup>, Libertel sought registration of the colour orange for telecommunication services. The office refused it on the grounds of lack of distinctiveness. The court ruled that: One colour can be distinctive and registrable. Uniqueness must normally be acquired through secondary meaning (consumer association). Pantone or another standardised colour code would be adequate as a representation. Paved the way for single-colour marks in Europe, but with a high threshold<sup>30</sup>. And also in the case of *Heidelberger Bauchemie GmbH* An application was filed for registration of a combination of colours (blue and yellow) "in every form possible." The court dismissed the application, ruling that the absence of a permanent arrangement rendered the representation indefinite and unclear. Suggested that colour combinations should be demonstrated systematically (e.g., in a special order or sequence), rather than as a list of colours
- **Smell Mark :** In the case of *Sieckmann v. Deutsches Patent- und Markenamt*<sup>31</sup>, Sieckmann tried to register a scent that was described as "balsamically fruity with a light touch of cinnamon." He provided (a) a chemical formula, (b) an oral description, and (c) a physical sample. The issue arose whether this fulfilled the requirement of graphical representation.<sup>32</sup> Registration was denied by the Court. It set down the renowned Sieckmann criteria: a trademark has to be "clear, precise, self-contained, easily accessible, intelligible, durable, and objective." Sieckmann's approaches were deficient in any of them:
  - a) The chemical formula was incorrect and not clear.
  - b) Verbal description was subjective.
  - c) A physical sample was not durable.

Effectively shut the door on EU smell and taste marks for over a decade. The case is often used globally as the rationale for why smell marks are so rare. Even post-2015 reforms,

---

<sup>28</sup> Shusaku Hidaka et al., *A Sign of the Time?*, 94 *Trademark Rep.* 1105 (2004)

<sup>29</sup> *Libertel Groep BV v. Benelux-Merkenbureau*, Case C-104/01, [2003] E.C.R. I-03793 (ECJ).

<sup>30</sup> O. Sahin, *The Past, the Present and the Future of Colour and Smell Marks*, 38(8) *Eur. Intell. Prop. Rev.* 504 (2016).

<sup>31</sup> *Raf Sieckmann v. Deutsches Patent- und Markenamt*, Case C-273/00, [2002] E.C.R. I-11737 (ECJ).

<sup>32</sup> H. Burton, *The UK Trade Marks Act: An Invitation to an Olfactory Occasion?*, 17 *EIPR* 378 (1995).

eliminating graphical representation, there are still practical issues: odours and tastes are subjective, variable and don't have universally accepted digital code systems (whereas colours have Pantone or sounds have MP3). Therefore, extremely few such programs are successful.

- Shape Mark: The EU has applied most stringently the requirements regarding shape marks, primarily due to functionality concerns. Following are landmark cases
  - a) Procter & Gamble v. OHIM, P&G<sup>33</sup> tried to trademark the three-dimensional shape of the soap tablet. The Court rejected the application, citing that the shape was not distinctive but functional. Implies that typical product forms have high barriers.
  - b) Lego Juris v. OHIM<sup>34</sup>, Lego tried to trademark the red shape of its toy brick. The Court held that the shape was defined by technical function (interlocking). Hence, not registrable. It is a Landmark ruling reaffirming the functionality exception under Article 7(1)(e) of the EUTMR.
  - c) Guerlain Lipstick Case<sup>35</sup>: Guerlain attempted to trademark the boat-shaped lipstick case. The EU General Court allowed registration, ruling that the distinctive, boat-shaped appearance was highly unusual compared to industry standards and was distinctive. Rare success for shape marks. Suggested greater openness to such distinctive and non-functional designs<sup>36</sup>.

- Motion and Hologram Marks

Motion marks were very challenging in the graphical representation era because they needed to be explained in a line of static images.

- a) Pre-reform: Practically impossible to register successfully.
- b) Post-2015: The candidates can now upload MP4 files.

Examples include Microsoft's Windows logo animation and Lamborghini's car door-opening animation. Hologram marks can also occur following reforms. These are presented as video files of the moving image.

The European Union follows a three-functionality principle under Article 7 (1)(e) of the **EU Trade Mark Regulation**<sup>37</sup> first one being the Nature of goods( Marks cannot consist of the

---

<sup>33</sup> Procter & Gamble Co. v. Office for Harmonisation in the Internal Market (OHIM), 2001 E.C.R. I-6251.

<sup>34</sup> Lego Juris A/S v. Office for Harmonisation in the Internal Market (OHIM), 2010 E.C.R. I-8403.

<sup>35</sup> Guerlain v. European Union Intellectual Property Office (EUIPO), ECLI:EU:T:2021:443 (Gen. Ct. July 14, 2021).

<sup>36</sup> K. Kunststadt, *Demand for Sound Marks in Europe?*, 9 J. Intell. Prop. L. & Prac. 706 (2014).

<sup>37</sup> European Parliament and of the Council of 14 June 2017 on the European Union Trade Mark, art. 7(1)(e), 2017 O.J. (L 154) 1.

shape resulting from the goods themselves, for example, an apple-shaped apple), the second one Technical function ( Shapes which are required to obtain a technical result cannot be registered) and the last one Substantial Value (Feature giving substantial evidence cannot be monopolised).

**NCM enforcement in the EU is generally met by two obstacles:**

**Proving distinctiveness: Courts must be convinced that the marks are truly recognised by consumers, which is difficult to prove, usually through consumption surveys, ad expenditures, or market share. For instance, in colour cases such as Libertel, applicants were forced to demonstrate very extensive use. Defining the scope: being extremely abstract, these designations can sometimes lose their borders very quickly, making it difficult to define the exact scope of infringement. The Directive (EU) 2015/2436<sup>38</sup> and the Regulation (EU) 2017/1001<sup>39</sup> gave a system of modernisation: allowed sound, motion, multimedia, and hologram marks, principally empowered recognition of NCMs. Harmonised the practices within the Member States. This made the EU a much friendlier jurisdiction for NCMs compared to the much more rigid framework that it had earlier. However, smell and taste marks continue to be almost impossible due to scientific and evidentiary challenges.**

India

India has a special place in the argument on non-conventional marks (NCMs). Whereas the sophisticated United States or the European Union, having moved from rigidity to cautious acceptances, India has stuck with its conservative and formalistic approach. Its trademark law system remains grounded on the expectation of graphical representation, rendering protection to most non-conventional marks challenging.

But India is a rapidly expanding consumer marketplace where multinationals are anxious to maintain distinct brand identifiers. This has brought courts, the Trade Marks Registry, and authors to grapple with NCMs. The end result is a patchwork regime: sound marks and shapes are relatively better established, colour marks are randomly dealt with, and smell/taste marks lie outside the purview of protection. The Trade Marks Act, 1999, states that a trademark is

---

<sup>38</sup> Directive 2015/2436, supra note 7

<sup>39</sup> Regulation 2017/1001, of the European Parliament and of the Council of 14 June 2017 on the European Union Trade Mark, 2017 O.J. (L 154).

defined under Section 2(1)(zb):

"Trade mark means a mark capable of being represented graphically and capable of distinguishing the goods or services of one person from those of others."<sup>40</sup> Meaning Graphic representation is necessary → this rules out smells and tastes because there isn't any accepted graphical coding that can be used across the board. The mark should be able to identify goods/services → either inherently distinctive or under secondary meaning.

Section 2(1)(m) of the Act defines "mark" in wide terms: "includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination thereof."<sup>41</sup> That is to say, the law provides for controlling colours and shapes, but smell and sound have not been mentioned. Clothes and registry practice have developed, however, to interpret sound in the sense of "device." The Trade Marks Rules, 2017<sup>42</sup> also simplify procedures: Rule 25: sound marks should be filed in MP3 form not exceeding 30 seconds along with a visual representation (musical notations). This legalised India's acceptance of sound marks following cases such as Yahoo.

#### Categories of Non-Conventional Marks in India

##### a) Sound Marks

India judicially and statutorily recognises sound marks. The first Indian sound mark was Yahoo! yodel in 2008. The Delhi High Court had already directed Yahoo's claim against "yahooindia.com", highlighting the uniqueness of its jingle<sup>43</sup>. Other sound marks are the ICICI Bank corporate jingle, the Nokia ringtone, and the Allianz SE tune. Rule 25 specifically states with regard to sound marks and is therefore the most developed NCM category in India.<sup>44</sup>

##### b) Colour Marks

India's colour mark system is incoherent: *Colgate-Palmolive v. Anchor* (2003)<sup>45</sup>: Colgate has sold peanut-red and ivory-white packaging for years. Anchor launched colour-similar packaging. Delhi High Court declared that colour combination can be the cause of action for passing off. This was a landmark, after *Qualitex* in the U.S. *Cipla v. MKI*<sup>46</sup>, Cipla requested exclusivity in respect of yellow colour inhalers. The claim

---

<sup>40</sup> Trade Marks Act, No. 47 of 1999, supra note 8, § 2(1)(zb) (India).

<sup>41</sup> Trade Marks Act, No. 47 of 1999, § 2(1)(m) (India).

<sup>42</sup> Trade Marks Rules, 2017, Rule 26(5) (India)

<sup>43</sup> *Yahoo! Inc. v. Akash Arora*, 78 (1999) DLT 285 (Del. High Ct.).

<sup>44</sup> Vatsala Sahay, *Conventionalising Non-Conventional Trademarks* (2011).

<sup>45</sup> *Colgate Palmolive Co. v. Anchor Health & Beauty Care Pvt. Ltd.*, (2003) DLT 51 (Del.).

<sup>46</sup> *Cipla Ltd. v. MKI Pharmaceuticals*, 2007 (36) PTC 166 (Del.).

was refused by the Delhi High Court, with the view that single colours are functional and could not be monopolised<sup>47</sup>.

*Britannia v. ITC* (2017)<sup>48</sup>, Britannia resisted the utilization by ITC of yellow-blue colour for biscuits. The Delhi High Court declined to confer exclusivity on the basis that colours generally applied to trade cannot be monopolised.

Therefore, courts permit protection for combinations of colour (red-white in Colgate) but refuse monopoly over a single colour or functional shape.

c) Shape Marks

Section 2(1)(m)<sup>49</sup> and Section 9(3)<sup>50</sup> of the Trade Marks Act provide protection for shape, if:

Is not functional (technical requirements/nature of goods). Is distinctive and not generic. Cases like *Gorbatschow Wodka KG v. John Distilleries* (2011)<sup>51</sup>: Bombay High Court safeguarded the shape of the dome-like vodka bottle, considering that shape per se can be an identifier. And also in case *Zippo Manufacturing v. Anil Moolchandani* (2011)<sup>52</sup>, the Delhi High Court shielded the traditional Zippo lighter shape, on the basis of extended use and consumer identification.

*Ferrero Rocher Case* (2018)<sup>53</sup>, Ferrero asserted exclusive rights in the gold-foil ball-shaped chocolate packaging. The court acknowledged the trade dress but highlighted distinctiveness by reputation.

d) Motion and Multimedia Marks

Still underdeveloped. The Registry started to accept video file applications (MP4), but hardly any have been approved. There is no pivotal judicial ruling yet.

e) Smell and Taste Marks

India's strict graphical representation requirement makes these impossible. The registry and courts have rejected such filings. In comparison to the U.S. (*Re Clarke*), India has never allowed smell/taste registration.

Academics contend India is behind NCM recognition, thus TRIPS Article 15 non-compliant (any indication likely to distinguish goods). Last-minute moves to harmonise Section 2(1)(zb) by excluding graphical representation.

---

<sup>47</sup> Dev Gangjee, *Non-Conventional Trade Marks in India*, 22 Nat'l L. Sch. India Rev. 67 (2010).

<sup>48</sup> *Britannia Indus. Ltd. v. ITC Ltd.*, 2017 (70) PTC 66 (Del.).

<sup>49</sup> Trade Marks Act, No. 47 of 1999, § 2(1)(m) (India).

<sup>50</sup> Trade Marks Act, No. 47 of 1999, § 9(3) (India).

<sup>51</sup> *Gorbatschow Wodka KG v. John Distilleries Ltd.*, 2011 (47) PTC 100 (Bom.).

<sup>52</sup> *Zippo Mfg. Co. v. Anil Moolchandani*, 2011 (48) PTC 390 (Del.).

<sup>53</sup> *Ferrero Rocher v. Ruchi Int'l*, 2010 (44) PTC 292 (Del. High Ct.).

India's NCM regime is conventional and unpredictable. Sound and shape marks are accepted judicially, colour marks experience adverse judgments, and smell/taste are still impossible. India's legislation continues to fall behind the world as compared to the open-minded U.S. and reformed EU.

## Recommendations

Non-Conventional Marks (NCMs) such as sound, colour, shape, smell, taste, movement, and holograms are being employed as powerful tools of branding within the paradigm of a globalised economy. However, their protection is tainted with representation, distinctiveness, functionality, enforcement, and harmonisation issues. Based on a comparative examination of the U.S., EU, and Indian regimes, the following policy recommendations are made to plug the lacunae.

1. Relaxation of Graphical Representation Requirement: The requirement of graphical representation has been a hurdle to the recognition of smell, taste, and sound marks for a long time<sup>54</sup>.

U.S.: No requirement of graphical representation under the Lanham Act, but wide discretion to NCMs.

EU Reform: Directive 2015/2436 abolished the strict requirement of graphical representation and replaced it with a "clear and precise representation" test, allowing MP3s, MP4s, and digital files.

India: Section 2(1)(zb) of the Trade Marks Act, 1999 still necessitates a graphical representation.

India must revise its Act to eliminate or update this provision. Instead, it should permit electronic filing (audio, video, smell cartridges, Pantone codes), just like overseas.

2. Distinctiveness: NCMs are irregularly examined for distinctness by courts. Indian courts were unstable in *Colgate v. Anchor*<sup>55</sup> (permitting colour combination) and *Cipla v. MKI*<sup>56</sup> (denying monopoly on one colour). Trademark offices need to release examination guidelines (like EUIPO's Examination Guidelines) that outline how to examine each of these types of NCMs for distinctiveness:

---

<sup>54</sup> V. Ahuja, *Non-Traditional Trade Marks: New Dimension of Trade Marks Law*, 32(11) EIPR 575 (2010).

<sup>55</sup> *Colgate Palmolive Co. v. Anchor Health & Beauty Care Pvt. Ltd.*, (2003) DLT 51 (Del.)

<sup>56</sup> *Cipla Ltd. v. MKI Pharmaceuticals*, 2007 (36) PTC 166 (Del)

Sound: Use, advertising recognition through consumers.

Colour: Proof of acquired distinctiveness by surveys, advertising, use of Pantone.

Shape: Not functional or traditional, and will need to acquire secondary meaning.

Smell/Taste: Extremely high level of evidence — association with consumers has to be made with strong evidence.<sup>57</sup>

### 3. Codification of the Functionality Doctrine

Functionality is yet to be a rule formulated by the courts in India, and therefore, there is uncertainty (e.g., *Britannia v. ITC* on biscuit packaging).

U.S. Practice: The Supreme Court in *TraFFix* and *Louboutin* reaffirmed utilitarian and aesthetic functionality doctrines<sup>58</sup> with authority.

India needs to include functionality statutorily in the Trade Marks Act with special provisions excluding protection of features necessary for use or appearance.

### 4. Specialised NCM Examination Unit

Trademark offices are not specialised for NCM examination, leading to inconsistency in decision-making.

Establish a special unit in the Indian Trade Marks Registry to handle only NCMs.

### 5. Specialised IP Benches in High Courts

NCM cases require an advanced understanding of consumer behaviour and global IP trends. Establishment of specialised IP benches in High Courts and NCLT (for corporate overlap cases) to rule on NCM cases. Judges should be trained in international NCM cases.

### 6. Consumer-Centric Enforcement Tests

It is harder to prove association for NCMs than for word marks. More reliance on consumer perception studies and fewer on subjective judicial inferences can help<sup>59</sup>.

Example: In Yahoo's sound mark, surveys would be more efficacious at proving association than judicial recognition.

---

<sup>57</sup> Kenneth L. Port, *The Expansion Trajectory: Trademark Jurisprudence in the Modern Age*, 92 J. Pat. & Trademark Off. Soc'y 474 (2010).

<sup>58</sup> Robert Bone, *Enforcement Costs and Trademark Puzzles*, 90 Va. L. Rev. 2099 (2004).

<sup>59</sup> Barton Beebe & Jeanne Fromer, *Are We Running Out of Trademarks?*, 131 Harv. L. Rev. 945 (2018).

## 7. Training Enforcement Authorities

Indian customs, police, and IP enforcement officials might not be aware of NCMs. There can be workshops for the enforcing agencies such that they can identify fakes by colour, sound, or packaging trade dress.

## Conclusion

The development of unusual marks demonstrates the active method through which enterprises engage clients beyond language and symbols. Protection is scattered and in abeyance due to obsolete legal demands, evidence issues, and a lack of harmonisation.

Recommendations on statutory, procedural, judicial, policy, and international fronts are necessary. The U.S. offers a liberal model; the EU has updated its system; India needs to reform its law, registry, and enforcement in order to be competitive in the world.

By embracing such reforms — specifically modifying the Trade Marks Act, modernising filing infrastructure, equipping enforcement officers with training, and enhancing international harmonisation — India can bridge the gap and become a frontrunner in the recognition and enforcement of NCMs.

WHITE BLACK  
LEGAL