

The Trademark

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Dheeraj Kapoor



Shilpi Jain

Unconventional trademarks: An Indian perspective

Dheeraj Kapoor and Shilpi Jain, LexOrbis, explore unconventional trademarks such as colors, shapes, sounds, etc. and inform us of their place in Indian trademark law.

Protection and enforcement of unconventional trademarks such as colors, shapes, sounds, motions, smells, and tastes has always been a subject of interesting debate under Indian law. This is due to the fact that they add tremendous brand value to any particular business because of the enhanced power of recollection they effectuate.

The Trade Marks Act, 1999 (“Act”) expressly recognizes *shape of goods, combination of colors* and, when read with the corresponding new Trade Marks Rules, 2017 (“Rules”), sound as an acceptable trademark. Although *taste, smell, motion* etc. have not yet been expressly recognized as trademarks, if they are found to test well on the touchstone of *distinctiveness* and *capability of being represented graphically*, they would deserve the trademark status in India. In India, it may take many precedents and legislative amendments before all aspects of unconventional trademarks are comprehensively codified as a benchmark for times to come.

While Indian jurisprudence on this subject is still evolving, an interesting example of trademark protection recently accorded to the image of a building in respect of services for providing food and drink and temporary accommodation: namely, the famous **Taj Mahal Palace Hotel** is one to be reckoned with. Although it may be argued that the trademark applied for is only the image of the building taken from a particular point-of-view and thus, a device mark or, at best, the trade dress, it surely does entail an unconventional nature of protection given the architectural monument as its subject matter.

In India, **colors** or combination of colors, if capable of distinguishing the goods or services of one trader from those of others, would be recognized as trademarks. The color mark must be such that it acts as a ‘badge of origin’. An example of a suitable form of description for a trademark that consists of a combination of colors applied to a pharmaceutical capsule would be: *The trade mark consists of a maroon color applied to one half of a capsule at one end, and a gold color applied to the other half, as illustrated in the representation on the application.* As per the Act, if a mark is registered without limitation of color, it shall be deemed registered for all colors.

Although the law does not explicitly recognize protection of ‘single color’ marks, the Indian courts in some cases have observed that even single colors may be protected, such as in exceptional circumstances where the color is very unusual to a trade and recognized as a ‘badge of origin’. In cases of complex trademarks involving word/figurative elements as well as colors, it is for the applicant to prove that the latter is the essential part of the mark since the word or figurative element is usually presumed to be so.

In *Colgate Palmolive Company and Ors. v. Anchor Health and Beauty Care Pvt. Ltd.*, the color combination of Red and White, which the plaintiff claimed to be a part of its trademark for dental products was in question. It was observed by the Delhi High Court that if a product having distinctive color combination, style, shape, and texture has been in the market for decades, it leads to ineluctable inference of having acquired secondary meaning on account of its reputation and goodwill, earned at huge cost.

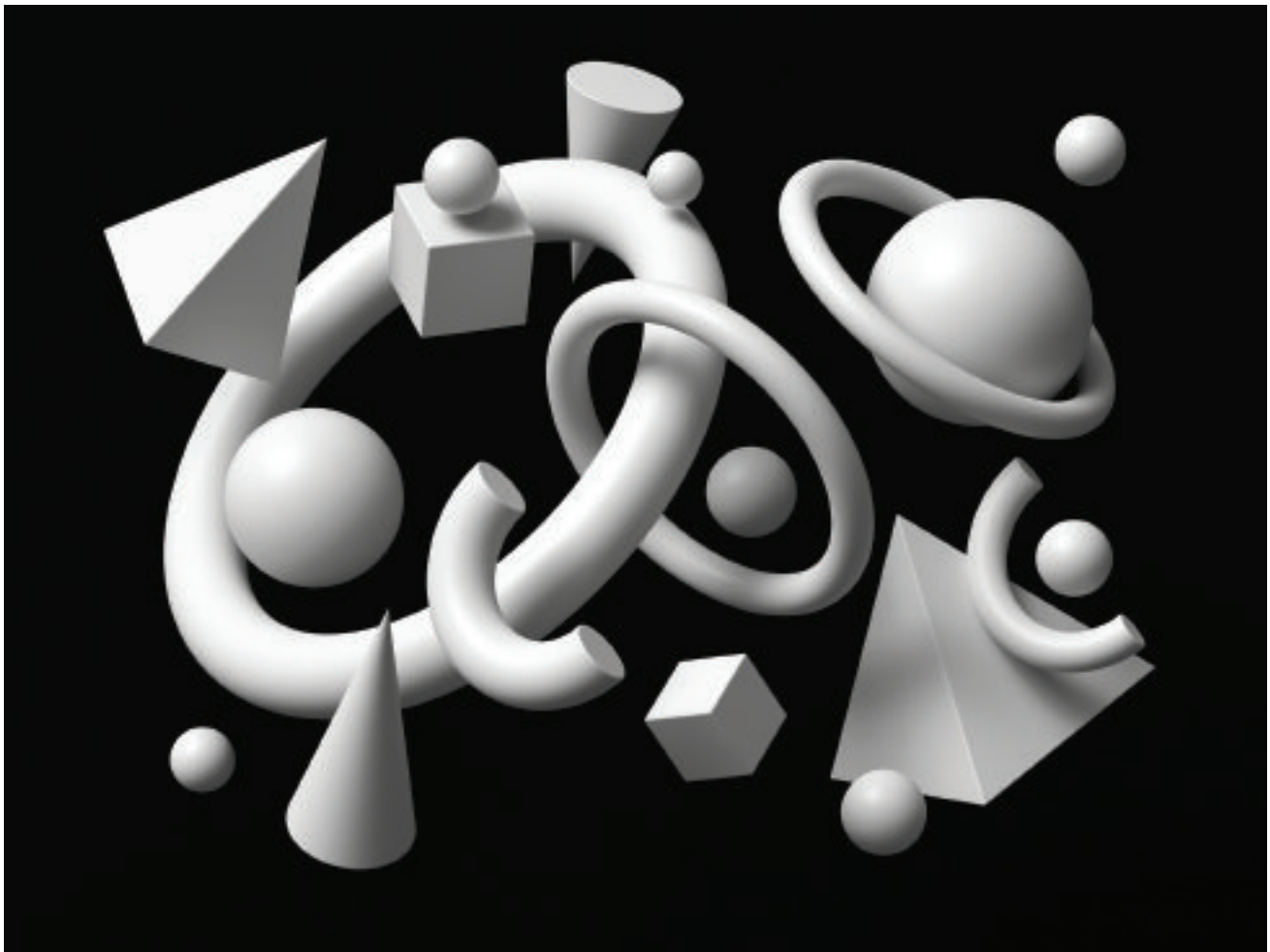
Résumés

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Dheeraj has extensive knowledge and expertise in intellectual property laws, and specializes in handling diverse matters before the High Courts, Intellectual Property Appellate Board, Trade Marks Office and the Copyright Office as well as advisory on various related laws. He is intricately associated with the legal research and publication team of LexOrbis, and has authored many articles and papers in leading IP publications and advises many Fortune 500 companies, multi-national corporations, small and medium-sized enterprises, and technology start-ups. He can be contacted at: dheeraj@lexorbis.com

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Shilpi has extensive knowledge of IP contentious and non-contentious matters. She regularly provides opinions and advice in relation to trademark matters and other IP related issues. She is also closely associated with the legal research and publication team of LexOrbis and has authored several articles and papers in leading IP publications. She can be contacted at: shilpi@lexorbis.com



However, more recently in *Britannia Industries Ltd. v. ITC Ltd.*, the Division Bench of the Delhi High Court held that since ITC failed to establish that the **combination** of **yellow** and **blue** in its trade dress has become a ‘badge of its goodwill’, Britannia could not be restrained from using the same colour combination in its trade dress for biscuits.

As far as **shapes** are concerned, distinctive shapes of goods or their packaging or any other three-dimensional objects capable of being represented graphically would be worthy of trademark protection in India. Although the Act includes “shape of goods” in the definition of trademarks, apart from the touchstone of distinctiveness, it also lays down certain additional tests before they can be recognized as having the trademark status. These tests are as follows:

- (1) The “shape of goods” should not result from the very nature of the goods themselves (*for instance, the **basic shape** of an egg tray to contain /hold eggs*);
- (2) The shape should not be such as is necessary to obtain a technical result (*functionality test; for instance, a round-edged shape of a pharmaceutical capsule meant to be swallowed; or a bar of soap with indentations along its sides to allow a better grip, which would be a shape consisting exclusively of features for achieving a technical result*);
- (3) The shape should not be such as to give substantial value to the goods (*this is to exclude shapes that add some value either in the design or appearance of the goods, disregarding the main function attributable to a trademark i.e. source identification. This is determined by a comparison between the shapes sought to be registered and the shapes of equivalent articles*).

Further, it is important to understand that if the “shape of goods” does not succeed on the above tests, no matter how much distinctiveness they would have acquired through use, they would still not be accepted

for registration. Thus, the above tests act as a statutory bar to the registration of shape marks.

Some shapes of goods, which have been protected as trademarks in India, include the shape of Zippo brand of lighters, the shape of bottles of John Distilleries Limited, and those applied for by the Coca-Cola Company.

Coming to the topic of **sound** as trademarks, they are registrable and deserve full protection especially with the explicit recognition given to them under the new Rules. Applications for sound marks must now be submitted in an MP3 format, not exceeding 30 seconds in length and recorded on a medium allowing easy and clearly audible replay. This needs to be accompanied with a graphical representation of the notations constituting the sound mark. Although “notations” has not been defined under the new Rules – and there is no explanation given as to what may be acceptable to fulfill the requirement of “a graphical representation of its notations” – generally, modern staff notations are acceptable for musical compositions. However, the fact that the scope of these terms has not been defined or restricted to a particular manner of rendering the notations graphically, the legislative intent appears to be inclusive and progressive. Thus, if the graphical notations are unambiguous and clearly define the sound mark, they would be acceptable, which is particularly useful in the case of a sound that is not musical and rather arbitrary noise but is still capable of being registered on account of its distinctiveness. On the other hand, an original tune may entail trademark protection across classes on account of its inventiveness. Surely, the uniform process under the new Rules coupled with digitization of records would simplify sound mark searches in order to ascertain conflicts and for due diligence activities.

In India, sound marks such as the Yahoo yodel and the corporate

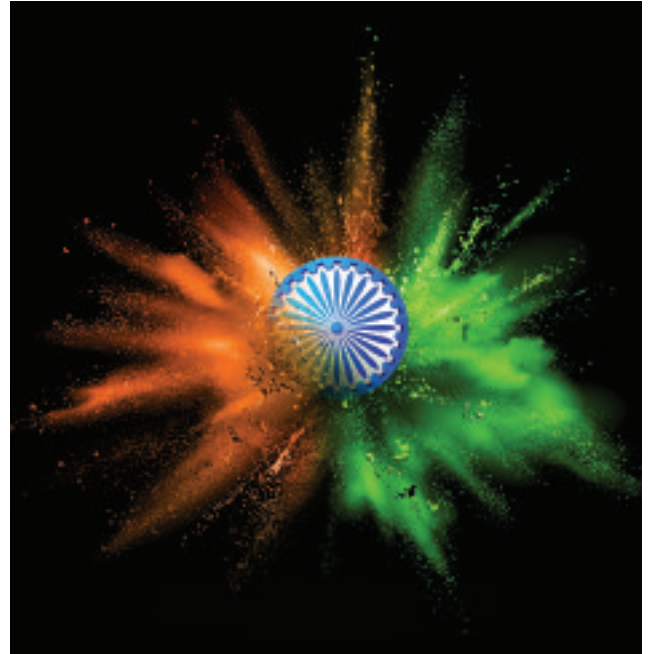
jingle of ICICI Bank have already been registered. The former is the first sound mark to be granted registration in India and the latter is the first sound mark to be registered in the name of an Indian entity. Other sound marks registered in India include the sound of 'Hisamitsu' sung over certain musical notations on a 'proposed to be used' basis and the popular musical sequence of "Raymond: The Complete Man".

Motion or animated marks are also non-conventional in nature and signify a given movement of things which act as a source identifier having commercial association and brand value. In these marks, the moving or sequential images uniquely identify the commercial origin of products or services. Although Indian Trademark Law does not expressly recognize motion marks, their acceptability can be gauged from the position that they can be both distinctive and graphically represented. One such motion mark that has been granted registration in India is the famous Nokia Hand-Shake trademark, which has been represented graphically through a series of images in sequence.

In India, the possibilities of the law recognizing **smell and taste** as legitimate trademarks are yet to be realized and explored as the difficulties associated with their graphical representation must be analyzed and resolved. Further, since India is likely to follow the same position as the EU – and to some extent the US (more liberal) – smells and flavors that are inherent or quintessential to the product itself would be excluded from registration. Until the development of further jurisprudence in India on this subject, there are chances that smell and taste marks would not be granted registration on the basis of inherent distinctiveness. In order to prove acquired distinctiveness, there may be a significant burden to show that the smell or taste has come to be associated exclusively with the applicant.

Unconventional trademarks can play an important role in corporate branding and adoption of color branding strategies, sound and shape marks could be a smart move in increasingly competitive markets to ensure that the purpose and quality of products/ services are not the only factors that sustain their appeal.

While we await further development of jurisprudence in this sphere of law, the current trend shows that Indian courts/tribunals are ready to adopt a broad approach while protecting unconventional marks.



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