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India's approach to non-conventional trademarks

Non-conventional marks are slowly gaining acceptance in India. However, trademark laws and procedures are still evolving, making it important to keep abreast of the latest developments

As technology continues to evolve, products are being distributed, sold and advertised in new ways. The challenge is how to protect and enforce the selling power of a brand that is no longer limited to a trademark, but rather is a combination of a colour scheme, a layout and product packaging. In addition, slogans, jingles and advertising storylines can all help to create an association with a brand. In the late 1990s non-conventional trademark forms such as sound, taste, touch, colour and olfactory marks grew in importance. In practice, such representations can successfully serve the purpose of trademarks; therefore, issues arise regarding the recognition and acceptability of rights to such marks, and whether such rights are protectable.

In India, the Trademarks Act 1999 replaced the Trade and Merchandise Marks Act 1958 and amended and consolidated the law relating to trademarks in India. Primarily, the new act was considered necessary for India to comply with the Agreement on Trade-Related Aspects of Intellectual Property Rights and to meet its obligations as a member of the World Trade Organisation. Under the old act, unconventional trademarks such as colour combinations *per se*, three-dimensional marks, smells, sounds and tastes were incapable of being registered. However, the new act specifically provides for the registration of the shapes of goods, packaging and colour combinations as trademarks. Although smells, sounds, tastes and holograms are not specifically mentioned, the prevailing legal opinion seems to suggest that the newly amended definition of a 'trademark' is wide enough to include non-conventional marks.

The act recognises that colours add to the distinctiveness of a mark by providing that if a mark is restricted to a particular

colour, this fact will be taken into account when determining the distinctiveness of the mark. However, whether a colour by itself is entitled to protection as a mark remains a grey area. Most applications are filed for words, designs, symbols, logos and other such distinguishable signs – in particular colours – to add distinctiveness to a mark.

The act does not specifically provide for the registration of a single colour, although it does not expressly exclude the notion. However, in practice, a combination of colours stands a better chance of registration, provided that it is capable of distinguishing the goods of one trader from those of another.

In other jurisdictions, colour marks have been granted registration, thereby giving the proprietor exclusive rights to a single colour (eg, the colour purple for Cadbury's Dairy Milk chocolate) or a colour combination *per se*. However, in India, such marks continue to be accepted for registration only as device marks. In other words, applications do not specify the exact colour or shade number of a standard colour matching system, but rather represent a device or band of the subject colour. For example, the Standard Chartered Bank obtained registration for its corporate colour combination of green and blue, but this is registered as a device mark, not a colour mark. It will be interesting to see whether the courts will view third-party use of such a colour combination as trademark infringement if such use is in a different manner from that for which the pattern is registered.

To date, the Trademarks Registry has reportedly accepted no single colour marks for registration. Brand owners fear that since the act contains no clear provisions on the registration of a single colour and there is strong evidence to suggest that factual

distinctiveness is required, the possibility of such an application being rejected is high. It is hoped that this area of the law will evolve as the registry examines more colour mark applications in the future.

Given the limited number of colours, there is concern that by allowing registrations of colours *per se*, sooner or later the available stock of colours will become depleted and thus anti-competitive. Therefore, there are stringent criteria for accepting single colour marks for registration. According to the draft Trademarks Manual guidelines, in exceptional circumstances a single colour can be considered for registration if the colour is capable of denoting the origin of a product or service and has acquired a high level of distinctiveness. Alternatively, unregistered colour marks can be protected under the law of passing off on the basis that their use shows that they have acquired a reputation that is protectable. The definition and ambit of passing off is wide enough to include all trademarks, including non-conventional marks.

In *Colgate Palmolive Company v Anchor Health and Beauty Care Pvt Ltd* the court observed that a colour combination is a 'trademark' within the definition of the act, as there is no exclusion in the definition and even a single colour is entitled to protection under the law of passing off. This dispute concerned the defendant's colour combination of red and white in respect of dental products, which was similar to the plaintiff's colour combination of one-third red and two-thirds white on its product container. Diverging from the view expressed in *Colgate Palmolive*, in *Cipla v MK Pharma* the court held that a single colour or a colour combination is not a trademark and is incapable of protection under the common law of passing off. The

plaintiff claimed that its blister packaging containing a distinctive orange-coloured, oval-shaped tablet constituted a trademark. However, the judge was of the view that “even if there has been deliberate copying of the similar colour and shape of the plaintiff’s tablets, that would not amount to passing off, since colour and shape are not indicative of the drugs, neither are they associated with the trade mark”.

Such inconsistent views result in confusion surrounding the principles of protection that are applicable to colour marks. It is hoped that things will become clearer as the courts examine more cases.

Meanwhile, India is one of the few countries in Asia to have opened its doors to the statutory protection of sound marks.

The Trademarks Registry granted India’s first sound mark registration for Yahoo’s three-note yodel in 2008. The application was filed in 2004 with the following description: “the mark consists of the sound of a human voice yodeling the word Yahoo.”

Subsequently, Allianz is reported to have successfully registered its sound mark in India and the Trademarks Registry has recently accepted Intel’s application for registration of its sound mark. The Trademarks Registry has also examined an application for a sound mark filed by an Indian entity. ICICI Bank successfully secured registration for its corporate jingle and is thus the first Indian entity to obtain a sound mark registration – a promising development in this area of trademark law.

Although it is encouraging that the Trademarks Registry has opened its doors to the registration of sound marks, the act does not specifically mention or define non-conventional marks such as olfactory, colour, taste and sound marks. In the absence of clear provisions, it is necessary to rely on a broad definition of a ‘trademark’ that can be interpreted to cover such marks.

According to the definition of a ‘trademark’ in India and a number of other jurisdictions, an essential criterion for registration is that the mark in question be capable of being graphically represented. However, the act does not specify what constitutes graphical representation. For example, sound marks can be represented only aurally, not visually. When Yahoo’s sound mark application was filed, there were no clear guidelines on the requirements of graphical representation in relation to sound marks or the procedures to be followed. Therefore, applicants had to rely on criteria laid down by the courts of other jurisdictions.

Identifying the need for clear guidelines,



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the Trademarks Registry has released a draft Trademarks Manual outlining the practices and procedures for trademark proprietors. Among other things, the objective of the manual is to lay down a framework for the uniform, transparent and efficient operation of the Trademarks Registry. It is expected that the introduction of the manual will greatly assist in the examination of non-conventional marks and the establishment of factual distinctiveness.

The manual identifies a range of trademarks as non-conventional marks, including colour marks, sound marks, shapes of goods or packaging, olfactory marks and holograms. Furthermore, it is prescribed that a trademark may consist of a sound and be represented by a series of musical notes with or without words. The representation must be clear, precise, self-contained, easily accessible, intelligible, durable and objective.

Applications for sound marks must clearly state that they are sound marks; otherwise, the application will be examined as if it were a word or device mark. For musical notations, the graphical representation requirements are met by representing the sign through a musical staff divided into measures and showing, in particular, a clef, musical notes and rests indicating relative values, sharps, flats and naturals (accidentals).

Consequently, applications to register whole or large sections of classical pieces are likely to face objection on the grounds that they are not regarded as trademarks. No sound marks will qualify for acceptance without evidence of factual distinctiveness.

The test for determining whether a sound mark qualifies for registration once it has passed the graphical representation requirement is to consider whether the mark is distinctive *per se* or capable of distinguishing the goods or services of the proprietor from those of others. Generally speaking, behind the successful registration of a non-conventional mark, there is robust evidence of factual distinctiveness. To date, the Indian courts have examined no cases in relation to the enforcement of sound marks. However, it will be interesting to see the judicial view that is taken.

Non-conventional marks are gaining acceptance in India, but laws and procedures are still evolving. With new technological developments and the growing ease with which consumers can access information on devices that produce high-quality graphics and sound, the need for trademark protection will become greater. **WTR**