

**PROTECTING NON-CONVENTIONAL TRADEMARKS:
UNWINDING THE SCOPE OF COLOUR, SMELL AND SOUND
MARKS**

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The registrability of non-conventional trademarks has been an imprecise area of IP law and is perceived with a cautious approach in India. This article shall, with the help of various case laws from the United States as well as the European Union, examine and discuss the existing limitations in registration of non-conventional trademarks, review the advantages and disadvantages of such registration of non-conventional trademarks, evaluate the method as to how such marks can fulfill the essential criteria of graphical representation and be presented on print journals; thereby leading the readers to the future prospects of non-conventional trademarks in India and giving an insight regarding how the usage of such unique type of marks is beneficial for the manufacturers, consumers, market and the economy, without compromising the object and purpose of Trade Marks Act, 1999 and Trade Marks Rules, 2017. The article largely focuses on color, smell and sound marks and is chapterized accordingly.

INTRODUCTION

A trade mark is a "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..."¹ Even though words, letters, logos, signatures, alphabets, symbols can commonly be seen around as trademarks, but shape, sound, smell or color trademarks are rare to locate, not just in India but throughout the world. The latter fall under the category of non-conventional trademark and are comparatively difficult to register. The primary reason for this lies in the Essential

¹ Section 2(zb) of The Trade Marks Act, 1999

requirements for registration of a trademark which includes graphical representation of the mark².

Technological developments, enhancement of trade and commerce and the ever growing competition can be attributed for the inception of the different kinds of trademarks which serve the twofold purpose of catching the attention of more and more prospective customers by way of unique representation of the products/ services and at the same time the ability to establish a clear distinction between such products/ services and those of the other traders. Surprisingly, till date there has been no smell mark registration in India even though such registration has not been barred by Indian trademark law³. However, now that the Trademark Rules, 2017 have an express provision for filing applications for sound marks⁴ for which even the definition of 'graphical representation' has been revised⁵, it is therefore all the more plausible that even though the registration of non-conventional trademarks is at an under-developed stage in India but the laws and procedures are nevertheless evolving which indicates that such trademarks can become prominent in the standard commercial market in the near future.

'Brand identity' is highly consequential for any company to survive, and in the present competition-ruled era, the indispensability of brand identity itself presents a clear vision of the prospects of such novel, unique and innovative types of trademarks that stand out from the traditional ones and possess the potential of becoming the most sought after forms of brand protection, not just in India but also other such briskly growing economies of the world. Promotion of innovation in 'types of trademarks' paves way for the customers to be attracted differently by more than one sense and also enables the entities to associate themselves with their products or services in several creative ways. Such distinguished features of recognition, though not always visual, effectively link the product to its source (manufacturer) and should be protected to avoid infringement and passing off by others.

COLOUR

There is no gainsaying the fact that a purchaser is significantly attracted by the visual image of a product, and the colour component of it can be a dominant factor which is able to attract customers to that particular product over another. In fact, in the year 2004, Neuron

² ibid

³ Swaraj Paul Barooah, *The Smell Mark Conundrum*, SpicyIP, Available at <https://spicyip.com/2015/01/guest-post-the-smell-mark-conundrum.html>, published on January 7, 2015

⁴ Rule 26(5) of Trade Marks Rules, 2017

⁵ As per Rule 2(k) of Trade Marks Rules, 2017, 'Graphical representation' means the representation of a trademark for goods or services represented or capable of being represented in paper form and includes representation in digitized form.

published a study of taste-tests between the two soft drinks giants Coca-Cola and Pepsi⁶, to prove that consumers' choice differs considerably when they know which brand's drink they are consuming as compared to when they are unaware of the same. The results revealed that the visual appearance of Pepsi stimulated a different part of the brain from that of Coca Cola. The consumer's choice was based on the neurological response, which in itself was based on the visual stimulus, therefore markedly overriding taste.

The significance of colours in this context is that the colour component of a trademark can become a unique identification 'sign' for the consumers that can help them relate directly to the producer of goods. This is because a captivating colour would leave a long lasting impression on the minds of the consumers and they are unlikely to forget something which is distinctive, appealing and catchy. However, the issue that arises here is whether a colour in itself can function as a trademark or should it be protected only when it is a component of a composite mark, the parts of which when combined, constitute that 'protectable' trademark. Whereas, the registration of a combination of colours as a trademark is comparatively easy. The Trademark Act, 1999 is silent about exclusive protection of any colour as a trademark, therefore not barring such registration. Nonetheless, for such exclusivity, acquired distinctiveness would be an uncompromisable condition, so that the protection is granted only to the colours with which the buyers essentially relate, for instance, the characteristic purple shade of Cadbury Dairy Milk chocolates.

Undeniably, a brand is much more than a mere logo, colour or name, but these visual identifiers, to a large extent, are capable of carrying certain associations in customers' minds. Therefore, it is the ultimate right of the brand to protect its distinctive identifiers, which in turn is beneficial for the consumers as it protects their interests in the sense that the likelihood of them being deceived is reduced appreciably. Owning a colour is a small but important part of building a successful brand for the reason that colours effectively rouse the conscious and sub-conscious senses. However, what should not be ignored is that, there should be precision about the goods or services regarding which the colour protection is sought for. It is particularly necessary to prove, by way of producing sufficient evidence, that the respective colour has acquired distinctiveness through substantial use over the years. This can also involve extensive advertising to inform the public about that colour's significance as a part of the brand, for example, the catchphrase '*Trust Pink, Forget Stains*' by Vanish. Individual colours have been granted independent protection as trademark in the United Kingdom, for example, a particular shade of orange (Pantone no. 151) was

⁶ McClure SM1, Li J, Tomlin D, Cypert KS, Montague LM, Montague PR., *Neural Correlates of Behavioral Preference for Culturally Familiar Drinks*, Volume 44 Issue (2), Neuron, Pg. no. 379-87, (14 Oct, 2004)

trademarked by Orange Brand Services Limited in 2001⁷, and the turquoise shade used on packaging of Heinz baked beans⁸.

Cadbury's attempt for registration of a shade of purple colour⁹ has been controversial especially due to its dispute with Nestle. The application which read "*The colour purple (Pantone 2685C), as shown on the form of application, applied to the whole visible surface, or being the predominant colour applied to the whole visible surface, of the packaging of the goods.*"¹⁰, was opposed by Nestle. The opposition, after being rejected initially by High Court, was ultimately upheld by the Court of Appeal¹¹ wherein, one of the three appeal judges, Sir John Mummery, said, "*The mark applied for thus lacks the required clarity, precision, self-containment, durability and objectivity to qualify for registration.*"¹²

The following cases depict the United States' stance on the colour trademark registration:

- In the paradigmatic case of Owens-Corning¹³, the Court was of the view that a wide variety of marks, including colour marks, should be granted protection under trademark law. Herein trademark was granted for colour Pink with respect to fiber glass insulation, the Court said that the colour was a non-functional part of the product and at the same time acknowledged that Owens-Corning has been extensively advertising its product with substantial emphasis on the colour Pink.
- Green-gold colour registered as trademark for dry cleaning pads in Qualitex Co. v. Jacobson Products Co.¹⁴
- Red colour granted protection for use on cans of tile mastic in Dap Products, Inc. v. Color Tile Mfg.¹⁵

The mounting significance of colour as a component of advertising makes the above mentioned decisions relevant to an expansive range of markets.

Unsurprisingly, such registration of individual colours as trademark faces a lot of objections and criticism. The most prominent one is the '*colour depletion theory*' which purports the "*concern that since the number of colors is limited, to grant exclusive rights in colors would*

⁷ Registration no. UK00002212628 under Classes 9, 16, 35, 38, 39, 40, 41 42

⁸ Sak Onkvisit and John J. Shaw, *International Marketing: Analysis and Strategy*, Pg. no. 320,(4th edition 2004)

⁹ Application No. 2376879, under Class 30

¹⁰ *ibid*

¹¹ *Societe Des Produits Nestle S.A. v. Cadbury UK Limited* [2013] EWCA Civ 1174

¹² Owen Bowcott, *Cadbury's attempt to trademark Dairy Milk purple blocked*, *The Guardian*, 4 October 2013,

¹³ *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116 (Fed. Cir. 1985)

¹⁴ *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159 (1995)

¹⁵ *Dap Products, Inc. v. Color Tile Mfg., Inc.* 821 F. Supp. 488 (S.D. Ohio 1993)

*soon deplete the available stock and, thus, be anticompetitive.*¹⁶ This concern loses its importance in the present world because technological developments have lead us, and robots with such Artificial Intelligence, to create innumerable different shades of colours, and moreover since there are millions of colours and shades already existing, most of which the human eye can differentiate amongst¹⁷, therefore such colour registration would in no way be anti-competitive for the new entrants in the market and would certainly not lead to exhaustion of array of colours. Similar was the observation of the Supreme Court Of The United States in *Qualitex Co. vs Jacobson Prodcuts Co.*¹⁸ wherein the colour depletion theory was rejected on the premise that there are ‘*hundreds of colour pigments that are manufactured and thousands of colours can be obtained by mixing*’, thereby proposing that other sellers in the market would not be out of options to choose from. The Court further said that “*Sometimes, a colour will meet ordinary legal trademark requirements. And, when it does so, no special rule prevents colour alone from serving as a trademark*”¹⁹. A distinct shade of green-gold colour was used, and subsequently registered as trademark, by Qualitex Co. The colour was used on press pads that were sold to dry cleaning firms. Jacobson Products also began selling similar green-gold press pads to dry cleaning firms. Prior to the registration, Qualitex co. had initiated a lawsuit against Jacobson for unfair competition and post-registration the charges of infringement were added to that suit. The District Court delivered its judgement in favour of Qualitex Co. but it was overturned by the Court of Appeals for the Ninth Circuit on the grounds that the registration of a single colour as a trademark was not permitted by the Lanham Act of 1946. The decision of the Court of Appeals, which was under challenge before the Supreme Court of the United States, was finally reversed and the trademark protection for colour was reaffirmed in favour of Qualitex Co.²⁰

The US Courts’ views have since favorably expanded in this regard, narrowing down on certain factors to be considered while deciding whether a colour has acquired secondary meaning, such as the extent of third party use i.e. usage of similar colour by other players in the market, sales and advertising of the product that directs the attention of the

¹⁶ Jeffrey M. Samuels and Linda B. Samuels, *Color Trademarks: Shades of Confusion*, 83 TRADEMARK REP., Pg. no. 554-555 (1993)

¹⁷ Stephen J. Newman, *Kill the “Mere Color” Rule: Equal Protection for Color Under the Lanham Act*, 61 U. CHI. L. REV., Pg. no. 1610 (1994): “The human eye can distinguish between minute differences of hue, value, or saturation . . . under good lighting conditions the average person can distinguish among five million shades.”

¹⁸ Supra note 14

¹⁹ ibid

²⁰ M.M.S. Karki, *Nontraditional Areas of Intellectual Property Protection: Colour, Sound, Taste, Smell, Shape, Slogan and Trade Dress*, Vol 10, Journal of Intellectual Property Rights, Pg. no. 501(10 November 2005)

consumer towards the colour and the significance of the colour as indicated by the consumer studies and surveys.

As far as India is concerned, the draft Manual²¹ noticeably recognizes the potential of a colour by saying that, “In order to constitute a trade mark, a colour or combination of colours must be capable of distinguishing the goods or services of one trader from those of other traders. If a particular colour of packaging has become distinctive in fact as indicating the goods of a particular trader, there is no reason why it should not be protected by registration.....A single colour may be registerable as a trade mark if it is very unusual and peculiar in a trade and is recognized by traders and consumers alike that it serves as a badge of origin for that class of goods.”²² Victorinox AG was able to secure trademark protection for its brown colour (RAL 3003) in India²³. Similarly, Deutsche Telekom AG was granted single colour trademark registration in India for its magenta colour label.²⁴

Examining from an economic outlook, the ability of brand development, brand identification and brand differentiation possessed by a colour makes it imperative for the Indian legal system to protect it under Trademark law. Colours can be graphically represented by referring to Pantone, Focoltone, RAL or other such internationally acknowledged systems for classification of colours. However, the possibility of a conflict, which may arise due to difference between consumer recognition and technical identification, cannot be ignored. The authorities should be cautious while granting trademark registration to colours that are recognized separately on the Pantone scale but may appear the same to consumers.

SMELL

It shall not be deemed incorrect to anticipate that different types of non-conventional trademarks can become more widely accepted in India in the near future, as in recent times we have seen legislative changes expanding the definition of ‘trademark’²⁵. A comprehensive and open-ended legal definition of trade mark²⁶ put forth by the TRIPS

²¹ Manual of Trade Marks Practice and Procedure, issued by Office of Controller General Patents, Designs & Trade Marks, Mumbai on 10, March 2015

²² Draft Manual Ch II, at 3.2.4

²³ Application no. 1394234 under Class 8

²⁴ Application no. 1462271 under Class 38

²⁵ Supra note 4

²⁶ As per Article 15(1) of TRIPS, 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 trade mark*”

Agreement²⁷ and other such intellectual property-centered treaties makes such advancements possible.

A rather difficult undertaking is the registration of smell trademarks, the graphical representation of which requires being non-arbitrary, consistent and meaningful; something that has always been a demanding task and an issue identifiable with all other types of non-conventional trademarks. Nonetheless, smell marks, or scent marks, as they may be called, have found their exclusive place in some of the legislations²⁸. The subjective description and diverse perception of smell marks makes their registration more taxing as compared to visual non-conventional trademarks and therefore the number of smell trademarks throughout the world is considerably less than the number of sound trademarks. A landmark judgement in this regard is that of *Ralf Sieckmann v Deutsches Patent- und Markenamt*²⁹, wherein a smell “*balsamically fruity with a slight hint of cinnamon*” was represented by a chemical formula as well as a verbal description, and a specimen of the smell was also submitted. Although the smell was not granted registration because all three methods of representation were held to be unsatisfactory, however, the ECJ held that “signs capable of being represented graphically are not limited to those signs which can be perceived visually” and further added that the graphical representation must be “*clear, precise, self-contained, easily accessible, intelligible, durable and objective*”³⁰

The United States, in the year 1990, took a liberal view in this regard by allowing registration of ‘*a high impact, fresh floral fragrance reminiscent of plumeria blossoms*’ for sewing thread as a trademark³¹. The applicant, Celia Clarke, contended that hers being the only scented embroidery yarn, made it inherently distinctive. This contention was rejected by the Examining Attorney but later, on appeal, was accepted before the Trademark Trial and Appellate Board which held that considering the consumer recognition and advertisements of the scent mark, it can be conclusively said that the mark is prima facie distinctive.

Verbal description of a smell is generally vague and, for that reason, indistinguishable. Chemical formula, on the other hand, has been adjudged by the European Court of Justice to be insufficient for the reason that not many people would be able to identify the smell

²⁷ Agreement on Trade-Related Aspects of Intellectual Property Rights, Apr. 15, 1994, Marrakesh; Agreement Establishing the World Trade Organization, Annex 1C (1994) 33 I.L.M. 1197

²⁸ Section 6 of the Trade Marks Act 1995 of Australia defines “signs” that can be registered as trademarks and this definition includes “scent”; Similarly, Section 5 of Trade Marks Act, 2002 of New Zealand provides that registrable “sign” shall include smell.

²⁹ *Ralf Sieckmann v Deutsches Patent- und Markenamt* Case C-273/00, 12 Dec 2002, European Court of Justice

³⁰ Sieckmann seven-fold test

³¹ *In Re Celia Clarke*, USPQ 2d 1238 (1990)(TTAB)

on the basis of its chemical formula³², therefore making the number of registered smell marks significantly less as compared to color or sound marks. This issue can be solved by using non-subjective terms in graphical representation that define the smell in a non-arbitrary manner, leaving less for individual interpretation. Exclusion of words of opinion such as pleasant or wonderful, and inclusion of solely descriptive words, would ensure that there is no confusion in perception. Moreover, the fragrance for which registration is sought should not be volatile and the chemical formula of the same should essentially be accompanied with other relevant details such as temperature and concentration at which the smell is produced. While granting smell mark registrations, the Trademark Registry should carefully scrutinize that the public associates the smell with the applicant's goods and that the smell is not a result of the nature of the goods. It is important to note here that even in the United States, the functional scents that result from the nature of the products themselves, such as smell of perfume, are not accepted for registration. Similarly in the UK, the application to register the scent of Chanel No. 5 perfume was rejected on the ground of being inherent to the product itself³³.

Following are a few noteworthy smell registrations in different jurisdictions around the world:

- '*The smell of freshly cut grass*' was registered as a European trademark for tennis balls³⁴.
- In 2006, The Smead Manufacturing Company in the US registered "vanilla" fragrance as trademark for office supplies including file folders, hanging folders and paper expanding files³⁵.
- Smell of roses for tires³⁶ by Sumitomo Rubber Co.³⁷, and smell of beer for dart flights³⁸ by Unicorn Products³⁹ have been registered as trademarks in the UK.

The process of registering a trademark in the EU involves fulfillment of 2 primary conditions before the Office for Harmonization in the Internal Market (OHIM) viz.

³² Supra note 29

³³ Described in the application as "scent of aldehydic-floral fragrance product, with an aldehydic top note from aldehydes, bergamont, lemon and neroli; an elegant floral middle note, from jasmine, rose, lily of the valley, orris and ylang-ylang; and a sensual feminine note from sandal, cedar, vanilla, amber, civet and musk. The scent is also being known by the written brand name No 5."

³⁴ CTM Application No. 428870, registered by Vennootschap onder Firma Senta Aromatic Marketing on 11 October, 2000

³⁵ Registration No. 3143735

³⁶ Described in the application as "a floral fragrance/smell reminiscent of roses as applied to tyres"

³⁷ Registration No. GB 2001416

³⁸ Described in the application as "the strong smell of bitter beer applied to flights for darts"

³⁹ Registration no. GB 2000234

graphical representation of the mark and that the mark should be “capable of distinguishing the goods or services of one undertaking from those of other undertakings”⁴⁰. Such marks need not be limited to words and graphics as long as the above 2 conditions are satisfied.

In the year 2005, The European Court of First Instance, while refusing the registration of a trademark consisting of smell of ripe strawberries, stated that one of the grounds for such refusal is the unavailability of a generally accepted international classification of smells that would identify the mark⁴¹.

A 2014 research published in *Cognition*⁴² purports that the conception that smell cannot be put into words is rather a misconception and this has been supported by studying different cultures, most importantly the Jahai of the Malay Peninsula, to find out that odour naming can actually be as easy as naming a colour. Another study⁴³ at Rockefeller University of New York City reveals that an average person could differentiate among approximately 1 trillion smells. In fact, it also highlights the revelation that the human eye uses just 3 light receptors to see millions of colors, while the nose has 400 different olfactory receptors.

Linnaeus, in 1752, was one of the first ones to suggest that there should be a separate set of classes for odours and his classification includes 7 groups that are Fragrant (eg. floral), Aromatic, Alliaceous(garlicky), Hircine(goaty), Ambrosial (musky), Foul, and Nauseating⁴⁴. Much later, in 1895, Hendrik Zwaardermaker refined this set and added Ethereal and Empyreumatic to the classes apart from creating subclasses under each class. Thereafter, Henry Henning put forth the concept of odour prism and classified the smells into 6 primary odors namely foul (putrid), flowery, burnt, fruity, spicy, and resinous which were all dimensions of his ‘odour prism’⁴⁵. A highly comprehensive odour classification backed by scientific basis was prepared in the year 1995 by J-N Jaubert, C. Tapiero and J-C Dore⁴⁶. The classification had 42 reference odorants such as citral, calone, linalool, nonanal, vanillin, thymol, phenol, etc.

⁴⁰ Article 4 of Community Trade Mark Regulation (CTMR) (Regulation (EC) No. 207/2009) and Article 2 of the European Trademarks Directive (TMD) (Directive 2008/95/EC)

⁴¹ Edén SARL v. Office for Harmonization in the Internal Market [Case T-305/04]

⁴² Asifa Majid & Niclas Burenhult, *Odors expressible in language, as long as you speak right language*, Volume 130 Issue 2, *Cognition*, Pg. no. 266-270 (Feb 2014)

⁴³ Bushdid, C., Magnasco, M., Vosshall, L., & Keller, A. *Humans Can Discriminate More than 1 Trillion Olfactory Stimuli*, Vol. 343 Issue 6177, *Science*, Pg. no. 1370-1372 (21 March, 2014)

⁴⁴ Stephen V. Douthwaite, *Odor Classification*, *FerfumersWorld*, 2000, Available at <https://www.perfumersworld.com/article/odor-classification>

⁴⁵ *Ibid*

⁴⁶ Jean-Noel Jaubert, Claude Tapiero and Jean-Christophe Dore, *The Field of Odors: Toward a Universal Language for Odor Relationships*, *perfumer & flavorist*, Available at

To deal with the issue of graphical representation of smells, efforts shall be made to develop a uniform classification system for identification of smells, like there is Pantone system for colours, or widely agreed criteria having a set of requirements for graphical representation that leads to unambiguity and ease in registration of smells. Such classification should include an expansive array of smells and their combinations, such that the classes therein should be clearly distinguishable. Inclusion of a strength determination factor is also vital so that the pungency of the smell can be measured accurately on a scale, keeping in mind that the smell of a molecule or a substance, comprising the product, can be multi-faceted⁴⁷.

SOUND

The fact that an audio clip can serve the purpose of identification of origin of goods or services has already been acknowledged by a lot of countries, including India⁴⁸. However, what still remains untouched is the scope of constituents of such audio that might include non-musical components like onomatopoeic sounds⁴⁹ such as 'buzz of a bee' or 'bark of a dog'. Such sounds cannot be represented in the form of musical notations and hence, have to be represented in onomatopoeic descriptions, although still comfortably falling under the purview of acceptable graphical representation. The requirement of graphical representation is to ensure that the mark can be published in the journal in 'paper form'. The primary objective behind the essential of graphical representation is to establish the exact scope of protection of that mark and to provide legal certainty for the convenience of the Trademark Registry, the prospective competitors and opponents of the mark, as well as the public at large. Although such onomatopoeic sounds are capable of being represented graphically, but they lack distinctiveness and therefore usually fail to be secured as a trademark. The sound of a cat for pet foods or the sound of a piano for a musical instrument or other such sounds are descriptive about the goods/ services and are therefore non-distinctive.

In India, there have been a few potential developments in this area. The first sound mark registration in India was granted to Yahoo! Inc⁵⁰, in the year 2008, for its Yahoo yodel⁵¹. Three years later, ICICI Bank Ltd.⁵² became the first Indian entity to be granted trademark

<http://www.perfumerflavorist.com/fragrance/research/The-Field-of-Odors-Toward-a-Universal-Language-for-Odor-Relationships-370155731.html> , published on May 1, 1995

⁴⁷ For example, the aroma of chocolate is creamy, sweet, as well as balsamic.

⁴⁸ Supra note 4

⁴⁹ Formation of a word from a sound associated with what is named

⁵⁰ Application no. 1270407 under Classes 35, 38 and 42

⁵¹ Described in the 2004 application as "the mark consists of the sound of a human voice yodeling the word Yahoo."

⁵² Corporate jingle 'Dhin Chik Dhin Chik'

registration for a sound⁵³. Allianz, Intel, Nokia, Britannia, among others, have been able to register their sound marks before the Trademark Registry in India. The most recent registration saw National Stock Exchange of India successfully seek trademark protection for its theme song⁵⁴. With the enactment of Trade Mark Rules of 2017, registering a sound mark in India has become all the more easier because of the introduction of an express provision⁵⁵ for submission of a MP3 format of the sound mark, along with the graphical representation of sound notations, although, a clear and precise definition of ‘notations’ along with a set of standards is still required, which should be satisfied by a sound in order to be granted trade mark protection. As already mentioned, the definition of ‘graphical representation’ now also includes ‘representation in digitized form’⁵⁶.

As for the United States, the registration mainly depends upon the examination that whether the listeners can instantly associate the sound with the source of the product. Metro Goldwyn Mayer (MGM) Corporation created a huge uproar when they trademarked ‘lion’s roar’ in the U.S.⁵⁷, which was possible only because the United States’ requirements are focused more upon the distinctiveness of the sound and overlooks whether the mark applied for is a musical notation or an onomatopoeic description. The Tarzan Yell⁵⁸, the New York Stock Exchange Bell⁵⁹ and ‘D’OH’ grunt of Homer Simpson granted to Twentieth Century Fox Corporation⁶⁰ are other notable sound marks given trademark protection in the US.

⁵³ Shayonee Dasgupta, ICICI jingle now trademarked!, SpicyIP, Available at <https://spicyip.com/2011/03/icici-jingle-now-trademarked.html> , published on 14 March 2011

⁵⁴ Application no. 2152242, under Class 36

⁵⁵ Supra note 4

⁵⁶ Supra note 5

⁵⁷ US Registration no. 1395550

⁵⁸ US Registration no. 2210506; The sound was described in the application as: “A series of approximately ten sounds, alternating between the chest and falsetto registers of the voice, as follows - 1) a semi-long sound in the chest register, 2) a short sound up an interval of one octave plus a fifth from the preceding sound, 3) a short sound down a Major 3rd from the preceding sound, 4) a short sound up a Major 3rd from the preceding sound, 5) a long sound down one octave plus a Major 3rd from the preceding sound, 6) a short sound up one octave from the preceding sound, 7) a short sound up a Major 3rd from the preceding sound, 8) a short sound down a Major 3rd from the preceding sound, 9) a short sound up a Major 3rd from the preceding sound, 10) a long sound down an octave plus a fifth from the preceding sound.”

⁵⁹ US Registration no. 2741129; The sound was described in the application as: “An overtone of D-Sharp, struck nine times at a brisk tempo, with the final tone allowed to ring until the sound decays naturally. The rhythmic pattern is eight 16th notes and a quarter note; The total duration, from the striking of the first tone to the end of the decay on the final one, is just over 3 seconds”.

⁶⁰ US Registration no. 3411881

The Sieckmann criteria's⁶¹ importance was acknowledged and emphasized in refusing the registration for 'the first nine notes of Fur Elise' and 'the crow of a rooster' sounds in the Shield Mark case⁶², wherein the European Court of Justice held that such graphical representations in text form are inadequate and unclear. The Court was of the view that onomatopoeia and generic descriptions lack precision to explain the exact noise and observed that speed, rhythm and tempo are essential ingredients of a sound mark description.

A sound mark may consist of an ordinary sound that can acquire distinctiveness over a period of time by way of extensive advertising and usage, thereby developing the independent individual capability of indicating the source of the product or services. Sounds, especially music, have the ability to alter the decision making process of a purchaser by influencing his emotional state.

CONCLUSION

A major asset of any company, Intellectual Property has now become as influential as the tangible property in terms of enhancing profits and business. IP can help a company to generate funds, build up a superior portfolio and capture a larger region in the market. Hence, the purpose of a trademark is not merely restricted to the identification or advertising of products/services. It is also a goodwill carrier that significantly indicates towards the quality of the products/services and is therefore, an investment in itself.

Having the fifth highest number of trademark applications in the world last year⁶³, the illegal imitation of trademarks in India is no more an uncommon occurrence. The Trademark Registry, the proprietors as well as the Courts constantly look forward for better mechanisms to prevent unjust enrichment. By virtue of technological advancements, more and more people now have better access to devices that can produce high-quality graphics and therefore, there is a greater need to curb trademark infringement and passing off. The replication of non-conventional trademarks is not only difficult but also costly, complicated, time-consuming as well as easily detectable. A limitation in this regard is that such trademarks cannot be used for as many types of products as compared to the conventional visual trademarks. Non-conventional trademarks give the entities more than one layer of protection and are not confined to merely protecting the name or symbol of the brand. Moreover, they also make the product more attractive without compromising on the utility of it. Visual representation, and not visual perception, is the prerequisite for

⁶¹ Supra note 30

⁶² Shield Mark BV v. Joost Kist (Case C-283/01); [2004] ECR I-14313

⁶³ WIPO Statistics Database, 2016

the registration of a trademark. It would be interesting to see how such trademarks develop and create their own influential place in the regular market.