

Trademark And The Changing Ambit Of Trademark In India.**Dr. Ved Pal Singh***
MEENAKSHI DAHIYA***Abstract**

Today Trademark is playing a significant role in identifying the goods and services of varied manufacturer and service providers whether in economic market or on the virtual world. Trade name has acquired a vital role to play to distinguish goods and services of one person from that of another. With the advancement we have upgraded the trademark system in India but still we are lagging behind when it comes to unconventional trademark which is not protected and recognised in India but we can see a change in trademark law and it slowly started protection and giving right to the unconventional trademark like soundmark is recognised and given protection in India. Here the researcher wants to emphasise the lacuna of the trademark law and trademark rules which specifically talks about graphical representation of trademark which is a hindrance in giving protection to unconventional trademark.

Key words: Unconventional trademark, graphical representation, distinctiveness etc.

Introduction

Trademark is the growing concept in the industries whether goods or services related to in any field. Trademark is visual symbol in the form of a word, a device, or label applied to articles of commerce with a view to indicate to the purchasing public that they are the goods manufactured or otherwise dealt in by a particular person as distinguished from similar goods manufactured or dealt in by other person.¹ A person who specifically uses a name, symbol, label or slogan denoting that he dealt in those particular goods and services which are distinctive and are distinguishing from other existing goods and services. Such names, symbol, label or slogan are related by the general public to identify the goods or services of particular manufacturer or person specifically dealing in those goods or services.

The function of the trademark is to identify the source of origin of the goods or services, quality and standard associated with that trademark.

Historical development of trademark

Trademark is the concept which is hundreds of years old and can be traced back from the

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1 P. Narayanan, Intellectual Property Law, 3rd Edn. Fourth Impression, 2006, Eastern Law House.

dissemination of goods. In earlier days the society used to follow the barter system and that time no such concept of trademark was available and known to the people. With the development of the society and the commercial exploitation with the emergence of trading and transportation the concept of commercial goods evolved. Trademark for goods were used for goods in commerce. People started using their names, unique drawings, or simple inscriptions to identify their goods, so they can be distinction between their goods and goods available from varied sources. Archaeologist around the world have excavated artifacts from various places like Egypt, Indus valley, etc. with various marks and symbol carved on the goods.

Potters mark appeared in the Greek and Roman period, where the potters used a specific mark on their vessel which they have created to identify the maker of that vessel. The potter used to specifically mark their vessel with symbols, name or unique drawing to distinguish their vessel from other vessel. If you go through the various archaeological findings, and the inventions which they have done across the globe finding out various hidden cultures and studies they conducted enclosing "Potters mark" are famous and they were the marks which were distinctive in nature to identify the source of origin and was considered as trademark in today context.

With the development over time, different modes of identification and distinction developed in the commercial community to distinguish their goods from others who deal in same trade. "Proprietary mark" which were in the form of name or symbol were attach to goods to make a distinction in the trade from those of others prevailing at that time. Symbols were used in ancient Rome and other countries had similar peculiarity which we have in today's trademarks. As in those days the concept of trademark and protection for such mark was not available to the owner of those goods, so there was no property right given to such marks.

Tracing back around 10 century, "merchant marks"², appeared where we can see that, the impression were made in wet clay on the raw goods which was a symbols for the goods which the traders and merchant used significantly to distinguish their goods. The purpose of the merchant marks were to identify the owner of the goods and the source of origin of the goods, with that it was to identify the owner of the goods in case the goods lost, missed due to shipwreck, attack of pirates and other disasters. The guild community also used specific mark for their goods in order to distinguish their goods, specifying standard and quality and to maintain trust in the guilds those marks were known as "Production marks". The purpose of production mark was to help the consumer to identify the goods and with that it had other

2 Seals were used to make impressions in wet clay as a means of sealing shipments of goods. D. H. Kelley and B. Wells, "Recent Progress in Understanding the Indus Script", *Review of Archaeology*. Vol. 16, No. 1 : 15-23.(1995).

function to assign responsibility for inferior goods like poor quality, lower quality of craftsmanship on goods etc. The whole concept of production mark was to have a distinctiveness, quality and standard of goods amongst the guild community to prosper in the commerce, so a duty was cast on the members of the community to have specific kinds of goods with all standard laid down by guild community. The production mark was not out of free will of the people of the community, but it was a compulsion on the members and which was a responsibility and obligation casted on the member to adhere by the standard of the guild community.

In the Middle ages, with the spark of Industrial Revolution, marks became actively identified with the goods. Laws were enacted for the protection of the interest of the person who created such marks and protection were provided to them in various countries. Various countries enacted special criminal laws protecting trademarks from forgery, counterfeiting and fraud laws and also Civil law protection was gradually developed against use of another's mark without permission i.e. Infringement of others mark for which various remedies were available for such infringement.

Indian trademark Law

The law of trademark in India before 1940 was based on the common law principles of passing off and equity as was followed in England. Cases concerning trademarks were decided in the light of sec. 54 of Specific Relief Act, 1877, while registration was secured by obtaining a declaration as to ownership under the Indian Registration Act, 1908. The first statutory law related to trademark in India was the Trade Mark Act, 1940 which had similar provision like the United Kingdom Trade Marks Act, 1938. The said enactment was amended by the Trade Marks Amendments Act, 1941 (27 of 1941) and later by two other amendments. By the Trade Marks Amendment Act, 1943, the Trade Marks Registry, which was formerly a part of the Patent Office, Calcutta (now Kolkata) was separated from the Patent Office to constitute a Separate Trade Mark Registry under the Registrar of Trade Marks at Bombay (now Mumbai). Thereafter, the Act was amended by Trade Marks Amendment Act, of 1946, to give effect to reciprocal arrangements relating to trade marks between the Government of India and then Indian States and further amendments introduced by Part B States Laws Act, 1951.

Later on the basis of the report of Mr. Justice Ayyangar the Trade Marks Act, 1940 was replaced by the Trade and Merchandise Marks Act, 1958. The Trade and Merchandise Marks Act, 1958 was enacted which consolidated the provisions related to trademarks which were contained in other statutes like Indian Penal Code, Criminal Procedure Code and the Sea Customs Act. The Trade and Merchandise Marks Act, 1958 (Act 43 of 1958) was brought

into force in 25th November, 1959. Certain minor amendments were brought out by the Repealing and Amending Act, 1960 (58 of 1960) and the Patents Act, 1970 (1970).

When a comprehensive view of the 1958 Act be made in view of the new advancement and developments in trading and commercial practices, increasing globalization of trade and industry accross the world, the need was felt to encourage investment flows and transfer of technology, and t simplified procedure and harmonization of trade mark management system in the country. The Trade Marks Bill, 1993 was introduced in the Lok Sabha which was passed by the Lok Sabha on the lines recommended by Standing Committee. However, as the Bill failed to get through Rajya Sabha and lapsed. A new Bill titled as Trade Marks Bill, 1999 (Bill No. 33 of 1999) was introduced in Rajya Sabha and eventually passed by both the Houses of Parlieament, which replaced the Trade and Merchandise Act, 1958. The Trade Marks Act, 1999 which is the current governing law related to registered trademarks in India. The 1999, Trade Marks Act was enacted to comply with the provisions of the TRIPS (Trade Related Aspects of Intellectual Property Rights), as we are the signatory to the TRIPS Agreement. Looking into the present law on trademark we can see that some aspects of the unregistered trademarks are still primarily governed by the common law rules based on the principles evolved out of the judgements of the courts. As under the present trademark law no protection is given to unregistered trademark and unconventional trademarks, in the light where law is ambiguous and not clear on the things, the principles of common law is applied taking into consideration the Indian context of our legal procedure, laws and realities around.

Presently the definition of Trademark is under sec. 2(1) (zb)³, concept of mark is given under sec. 2 (1) (m)⁴, going through this provisions it is clear that it does not protect or recognised the unconventional trademark as such but it totally depends on the interpretation of the various provisons of the Act. The present governing trade mark law has not specifically provided protection to unconventional trademark. Unconventional trade marks are Colour mark, Sound mark, Shape of goods or packaging, Smell mark and Hologram. When we talk about unconventional trademark which can be used for goods or services under the fourth schedule to Trade Marks Rules, 2002 where classification of goods and services provided. With the advancement and technological development manufacturer want to provide distinctive and significant goods and services to the consumer by using different unconventional trademark

3 “trade mark” means 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.

4 “mark” includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination thereof :

which they can relate to goods or services which are unique and significant to an ordinary prudent consumer.

In India, we can witness the people are illiterate in the rural parts of the country and they can identify the goods not by name but the colour or shape or packaging of goods. Consumers in India can identify the source of origin from their own way of identifying the goods or services. The trade marks act have not amended the present trademark law to cover the unconventional trademarks but things are changing and the registration of few unconventional trademark is observed in India. In coming years we will observe changes in the trademark protection for unconventional trademark in India, as we are signatory to various conventions and agreement and we need to be at par with the globalization with other countries.

Unconventional trademark.

Colour Mark is not specifically defined under the trade mark Act, but we can see that the reference is being made under sec. 2(1)(zb) which talks about shape of goods, their packaging and combination of colours which constitute a trademark which can distinguish the goods or services of one person from those of others in the market. When specific colour which can be conceived for goods or services extensively using two or more colours in many different arrangements when combined with different color can become distinctive and associate with particular goods. Its a difficult task using colour as distinctive feature of a trademark. As colour per se is normally not used by manufacturer as means of identification or distinctive character of trademark. Colour has to fulfill and pass through the distinctiveness criteria under the Act.

Single colour may be registered as a trademark if it is very unusual and unique in the trade and is recognised by the traders for the class of goods or services when it carries with it the bandage of origin and can be distinctive with those goods or services and in exceptional circumstances becomes distinctive. Single colour as a trademark is liable for objection under sec. 9(1)(a) as it is devoid of any distinctive character. Single colour also may attract additional objection under sec. 9(1)(b) and (c) as it may serve to designate quality, quantity or indication purpose and may become customary in trade. For example, Red colour is used by fire fighting services or Green colour for Environment and Ecology as they are non-distinctive and fails to be fulfill the condition of distinctiveness. The colour to be distinctive needs to provide for geographical origin of the goods or services and should be able to descriptive because of which single colour cannot be registered as a trademark.

Combinations of colours when they are distinctive and unique are considered as trademark under sec. 2(1)(zb). Combination of colours is registrable under the present law depending on the uniqueness of the colour combination and to which goods they are applied are

distinctive. The court stopped the defendant from using red and white in its packaging and trading as the plaintiff had proprietary rights over the combination when used for toothpastes⁵. Average consumers do recognise the goods or services with the colour combination like Hindustan Petroleum, Bharat Petroleum for their services with respective colour combination or shell for their colour combination. Cadbury's purple colour is protected as a trademark for chocolate products as you can identify purple colour with the cadbury chocolate. Sec. 10 lays down the limitation as to colour and it will be the tribunal which will take into consideration the combination of colours as trademark.

Sound Mark now can be registered as a trademark when it is distinctive and can be graphically represented. A sound mark can be represented graphically in form of musical notes with or without notes or in form of chimes, rhymes etc. Sound and music have become integral part of today's world and technologies avail people sound varied goods and services by which we identify the products or services. For example, the specific sound of Intel and Nokia we recognise that the product or service of specific trader associated with that sound. Sound marks are not new across the world, they are there from last 60 years in other countries. For example National Broadcasting Corporation (NBC) was the first to register trademark for their Radio broadcasting services. One of the famous sound marks is Metro-Goldwyn-Mayer's, Mayer's lion roaring for all their movies which we all are aware of.

Sound marks are protected and registered in other countries which we can observe in the recently defined areas of convergence concerning the representation and description of non-traditional marks, the WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) agreed that "Offices may require that the representation of sound marks consist of a musical notation on a staff, a description of the sound constituting the mark, or an analog or digital recording of that sound – or of any combination thereof. Where electronic filing is available, an electronic file may be attached to the application. However, for some jurisdictions, only a musical notation on a staff may be considered to adequately represent the mark."⁶

OHIM decided in 2005 (No. EX-05-3) that applicants could attach a sound file to electronic or online trademark application forms – this still applies. The attachment must be in MP3 format, must not exceed one megabyte and must not allow loops or streaming. Its purpose is to further clarify and support the application. INLEX IP Expertise was the first applicant to successfully obtain a registered Community sound mark using this option. Deutsche Telekom

5. Colgate Palmolive Company v Anchor Health and Beauty Care Pvt Ltd 2003 (27) PTC 478 (Del)

6 http://www.wipo.int/wipo_magazine/en/2009/01/article_0003.html accessed on 6 August, 2015 at 1.48pm.

has also registered its jingle as a sound mark under the Madrid Protocol⁷.

Indian Trademark Act, 1999 so far has not specifically recognised nor laid down restriction on sound mark, but only states that the trademark must be distinctive and is able to geographically representable. In the year, 2008 the first sound mark was registered in India for a American based Yahoo - online computer services - "YAHOO" yodel⁸. ICICI Bank limited has registered its jingle as a trademark in the year 2011⁹. Sound marks are now being recognised as a trademark for goods or services in the form of jingle, chimes, musical tones, phrase +musical tones etc. Sound mark are considered as distinctive, unique and capable of geographically represented in form of Mp3, notes in form of jingle, in series of musical notes with or without words. Sound marks representation must be precise, intelligible, clear, durable and self-contained one¹⁰. The application for soundmarks must clearly state they are sound marks, otherwise the application will be examined as if it were a word or device mark i.e. in case of Musical notes¹¹. Graphic representation requirement are met by representation of the sign by a musical stave divided into measures and showing , in a particular, a clef, musical notes and rests indicating relative value¹².

Smell mark in India does not get recognition nor protection under the Indian Trademarks Act, 1999 as defined under sec. 2(1)(zb) means mark capable of being represented graphically and capable of distinguishing the goods or services. Smell mark in India is not protected in India, but looking into the goods which are available in markets are scented with different flavours of flowers, fruits and Scents. With the advancement of technology and the taste of consumers we can find majority of cosmetics, insence sticks, soaps and perfumes have a specific scent or smell. Its very difficult to identify the source of origin and uniqueness of this scents associated with those goods and major problem is how to represent the smell geographically. When we go through the Trademark Rules 2002, under Rule 2(1)(k) talks of "graphical representation" means the presentation of trademak for goods or services in paper form¹³, Rule 25 (12)(b) talks about the application for registration of a trademark be able to depict the graphical representation of the trade mark¹⁴, Rule 28 talks about representation on paper form and Rule 30 talks about durable form and satisfactory nature¹⁵. If we undergo the Trademark Act and Trademark Rule its makes difficult to graphically represent scent or smell mark on paper form

7 Ibid.

8 <http://www.uspto.gov/trademark/soundmarks/trademark-sound-mark-examples>.

9 <http://spicyip.com/2011/03/icici-jingle-now-trademarked.html> accessed on 6 August, 2015 at 2.

10 http://ipindia.nic.in/tmr_new/TMR_Manual/DraftManual_TMR_23January2009.pdf

11 Ibid

12 Ibid.

13 Trademark Rules, 2002. (Published as GSR 114(E) dated 26/2/2002 in the Gazette of India Extraordinary pt. II Sec.3(i), dated 26/2/2002).

14 Ibid.

15 Ibid.

and having a durability which is not possible as scent or smell evaporate with times. It is strenuous to represent the smell mark with specific description which is very much subjective in nature and will be interpreted differently by different consumers.

Herein we can refer a registration of Scents as Community trade mark as was debated in Sieckmann case¹⁶ in this landmark case the interpretation of Article 2 of First council Directive 89/104/EEC of 21 December 1988, which means "A trade mark may consist of any sign capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings". Sieckmann submitted for registration application for an odour sample of the sign in a container and stated that the scent was usually described as "balsamically fruity with a slight hint of Cinnamon".

The court was of the view that the scent was refused registration because it failed to adequately represent the scent graphically, as required by the Community Trademark Regulation, it does not indicate source of origin and the scent is not able to be perceived visually¹⁷. Article 2 of Directive must be interpreted as meaning that a trademark may consist of a sign which is not in itself capable of being perceived visually, provided that it can be represented graphically, particularly by means of images, lines or characters, and that representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective. The court was of the view that olfactory signs does not fulfill the requirements of graphical representation by way of chemical formula and stating the description of the written words, even by way of deposit of the odour sample or by combination of all these elements altogether.

Scent can be the subject matter of trademark is very vague and ambiguous proposition in trademark. As the conventions and treaties had provided with broader interpretation of trademark and it is left to the interpretation of domestic laws of the countries. Distinguish goods flavored with scents which are unique and when affixed to products then in that case it is presumed to be unusual and can be distinctive can be registered under the domestic laws. The United Kingdom had registered certain types of scents which are usually affixed to products which were considered as uncommon or even arbitrary in manner like "Smell of fresh cut grass" for tennis balls¹⁸ the "Scent of roses" applied for tyres¹⁹ the "strong smell of

16 Sieckmann v. Deutsches Patent und Markenamt, Case C-273/00, (2002) ECR decided on 12 December, 2002(1)

17 Ibid

18 Vennootschap onder Firma Senta Aromatic Marketing's Application, Case R 156/1998-2, [1999] ETMR 429

19 U.K. Registration No. 2000234/filing date October 31st, 1994

bitter beer" affixed to flights for darts²⁰ and the "Scent of strawberry²¹, grape²² or cherry²³" for motor fuel. Any product or goods which had acquired distinctiveness over period of time can have a registration for scented products. In *re Clarke*²⁴, Clarke was the only sole manufacturer of Scented yarns and threads in the market which had acquired a distinctiveness in his product over time by use amongst the consumer. As the concept of smell mark is changing around the world, in that case we can assume that in near future India will recognise and protect smell mark as a trademark.

Hologram can be a trademark provided they are distinctive and capable of graphical representation as discussed above. Now a days we can see various hologram applied to various products as well as services like appliances, credit card, certificate, currency etc. Hologram can be seen from different angles and the views of hologram same but it is very difficult to depict the various views of the hologram in the paper form as under TradeMark Rule, 2002. In case of hologram you cannot depict all angles in graphical representation. For operating as a trademark the hologram has to comply with the distinguishing characteristic for goods and services to which it is affixed. The distinctiveness of the hologram will be determined with same precision and accuracy as it goes for determination of word mark.

Conclusion

Trademark law is one of the diversified area of protection and need to be given wider protection and should cover the unconventional trademark in the ambit of present Trademark Act 1999. the possibility is their that in near future we can see that unconventional trademarks will specifically get recognised in the trademark law in India. As while going through the trademark law for unconventional trademarks in India we have seen the scenario is changing but no such precise protection is their and the major problem for recognition of unconventional trademark is distinctive feature which is unusual and particularly unique in its kind and geographically representation of such unconventional trademark which is the biggest hurdle to represent unconventioanal trademark in India under the Act and also under the Rule 2002. Unconventioanal trademark is slowly being recognised in some areas but so specific recognition and protection in present act but hope to see more such recognition and protection of unconventional trademark in coming future in India to be at par with the development and advancement.

20 U. K. Registration No. 2001416/filing date October 31st, 1994

21 U. S Registration No. 2,596,156, for strawberry.

22U. S. Registration No. 2,568,512 for grape

23 U.S. Registration No. 2,463,044 for cherry.

24 In *re Clarke*, 17 U. S. P. Q. 2D 1238 (T. T. A. B. 1990)