

“Navigating the Complexities: Challenges in Protecting Non-Conventional Trademarks”

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INTRODUCTION

Trademarks are also a crucial component of intellectual property that has seen consistent advancement in recent years. In its traditional sense, trademarks are marks that consumers can use to identify and distinguish a variety of products, services, or brands in the market. They are designed to prevent unauthorized use and avoid market confusion while serving producers as well as consumers.¹ Traditional trademarks are logos, insignias, images/chapters/colors, slogans, and some names or words.

As the competition in the market is rising, new and unusual trademarks are nowadays adopted by manufacturers to give their products a competitive advantage.² The 21st Century has seen many of the existing industries expanding with the primary aim of offering something more unique than before prompting brands out there to look at different ways/forms for trademark protection rather than just in traditional categories. Non-conventional trademarks, such as shapes, colors, and smells are marks that exist at the outer edges of traditional trademark law. Such marks tend to fall outside the box of established types partially, hence their often-complicated registration and protection.

Their peculiar nature gives them an inherent complexity regarding registration as these are mostly non-traditional trademarks. In contrast to common trademarks, which can be perceived and if desired – graphically shown not all types of non-conventional trademarks have a clear form. This can be difficult for registration authorities to evaluate or enforce

¹ Sanya Kapoor and Riya Gupta, “The Five Senses and Non-Traditional Trademarks” 8 *Supremo Amicus* 214 (2015).

² Faye M. Hammersley, “The Smell of Success: Trade Dress Protection for Scent Marks” 2 *Intellectual Property Law Review* 105 (1998).

Challenges aside, this dynamic definition of a trademark creates endless opportunities for the protection and branding of many unique signs differentiating goods and services in trade.

Over time, the legal definition of a trademark expanded to incorporate an ever-increasing variety and evolving nature of marks. Definition of Trademark: As per Section 2(1)(zb)³ of trademark laws- “Trademark” means a mark capable of being represented graphically and which is capable. This broad definition has allowed the inclusion of non-traditional marks, which can be difficult to show graphically but still are important in creating specific consumer profiles.

The appearance of non-standard trademarks mirrors the technological movement and thinking shift in consumer recognition techniques. For example, the TRIPS Agreement concerning a system of international registration and other issues related to market protection that claims a trademark need not be visually perceptible or graphically representable⁴. The move is forward-thinking as this approach has allowed for the inclusion of other non-traditional trademarks like unconventional sounds in both US and EU trademark registrations, expanding the legal protection available to mark owners.

With a growing and more versatile market, the defense of non-traditional trademarks gains importance.⁵ The fast expansion and complicated environment of design applications pose a challenging task for patent offices and trademark registries worldwide, regardless of how significant or meaningful legal applications may be.⁶ Businesses are using these novel marks more frequently, which makes the legal framework more important to adjust. If not, focus will need to be placed on how they can best function as dynamic parts of our established systems, which were designed long before they were created and have so far done a good job of protecting against competition through mostly discrete signs with clear meanings that fulfill functions predicated on uniformity across member countries globally harmonizing occasionally minor variations without so much friction.

NON-CONVENTIONAL TRADEMARK AND ITS TYPE

Non-conventional trademarks are distinguishing marks that do not belong in the logotype category and do not fall into conventional categories like graphics or letters. The Trademark

³ Section 2, Trade Marks Act, 1999 (India).

⁴ Arka Majumdar, Subhojit Sadha, and Sunandan Mujumdar, “The Requirement of Graphical Representation for Non-Conventional Trademarks” 11 Journal of Intellectual Property Rights (2006).

⁵ Ibid

⁶ Supra note 2 at 2

Act of 1999 in India does not identify non-conventional trademarks officially, in contrast to the European Union where they are formally acknowledged. A trademark is defined as a mark that can be visually represented, which encompasses a variety of aspects such as product designs, packaging, and color schemes, under Section 2(zb) of the Act. Rule 2(k) of the Trademark Rules, 2002⁷ goes on to say that a mark has to be visually depicted in order to be registered as a trademark. This means that the trademark must be demonstrated in writing or through visual depiction, making it discernible for registration and protection purposes.

TYPES OF NON-CONVENTIONAL TRADEMARKS:

1. Shape Marks

Shape markings refer to a product's distinctive three-dimensional forms that set it apart from competing goods.⁸ These trademarks may consist of a product's unique packaging or container form. Two famous instances are the triangle-shaped packaging for Toblerone chocolate bars and the recognizable shape of the Coca-Cola bottle. *Koninklijke Philips Electronics NV v. Remington Consumer Products Ltd*⁹ is a noteworthy form mark case. Philips brought an infringement lawsuit against Remington in this instance because the two companies sold trimmers that resembled three-headed rotary shaver designs. For this shape, Philips had already received a trademark.¹⁰ The European Union Court of Justice, however, invalidated Philips' registration, finding that the shape was useful and required to achieve a technological result.

2. Color Marks

Color markings are distinctive color schemes or combinations of colors used to distinguish and identify a brand. The establishment of brand identification and awareness may depend heavily on these markers.¹¹ Examples of well-known color marks are the deep purple of Cadbury chocolates and the characteristic pink used by T-Mobile. In order to protect color marks, it is frequently necessary to provide evidence that the color has become unique via

⁷ Id., art. 2

⁸ Lisa P. Lukose, "Non-Traditional Trademarks: A Critique" 57 *Journal of the Indian Law Institute* 197 (2015).

⁹ Case C-299/99, *Koninklijke Philips Electronics NV v. Remington Consumer Products Ltd*, [2002] ECR I-5475.

¹⁰ *Supra* note 3 at 2

¹¹ M M S Kharki, "Non-Traditional Areas of Intellectual Property Protection: Colour, Sound, Taste, Smell, Shape, Slogan and Trade Dress" 10 *Journal of Intellectual Property Rights* 499 (2005).

prolonged use—that is, that customers have come to identify the color with the brand in particular.¹²

3. Sound Marks

Sound marks are distinctive noises or jingles connected to a specific brand. These sound signatures have the potential to be very important for brand identification. In their respective domains, the Intel "bong" sound and the NBC chimes are acknowledged as trademarks.¹³ For sound markings to be eligible for protection, they must be unique and able to identify the source of products or services. Sound markings can be difficult to record and replicate, but they are becoming more and more valued as strategic tools for branding.

4. Smell Marks

Smell trademarks are identified by distinctive odors associated with a product. These symbols are uncommon and present distinctive difficulties when it comes to being registered and safeguarded.¹⁴ A smell trademark example is the unique odor of Play-Doh, which has been officially trademarked for the toy product. Registering smell marks is challenging due to the inability to visually represent or describe smells, leading to increased difficulty in demonstrating their uniqueness.¹⁵

5. Taste Marks

Taste indicators consist of distinct flavors that distinguish a product. Protecting these less common marks poses more challenges than protecting other types of non-traditional trademarks.¹⁶ For example, a specific drink or sweet could be considered a taste mark if it has a unique flavor. Safeguarding taste trademarks involves proving that the taste is not just special but also helps in identifying the origin of the product, a process that can be complicated and subjective.

6. Texture Marks

¹² Ibid

¹³ Harshada Wadkar, "Non-Conventional Marks" Lexology (Aug. 18, 2024, 8:50 PM), <https://www.lexology.com/library/detail.aspx?g=4339effeba0-4339-a5f9-47f2d72ae7d1>.

¹⁴ "Smell, Sound and Taste-Getting a Sense of Non-Traditional Marks" WIPO (Aug. 19, 2024, 8:12 PM), http://www.wipo.int/wipo_magazine/en/2009/01/article_0003.html, last seen on Aug. 10, 2024.

¹⁵ Ibid

¹⁶ Thomas A. Gallagher, "Non-Traditional Trademarks: Taste/Flavour" The Trademark Reporter (Aug. 19, 2024, 8:20 PM), http://www.inta.org/TMR/Documents/Volume%20105/vol105_No3_a4.pdf.

Texture marks pertain to the tactile qualities of a product's surface that help distinguish it. This might involve the distinct texture of a material utilized in garments or furnishings. The texture should be unique and able to distinguish the product as coming from a particular source.¹⁷ One illustration of texture marks is the unique grain design implemented by Louis Vuitton in their "EPI STYLE" leather handbags. During the Louis Vuitton v. Malik¹⁸ case, the Delhi High Court issued a temporary order supporting Louis Vuitton due to the uniqueness of the EPI pattern used since the 1980s.

7. Holographic Trademarks

Holographic logos combine images and hues that can only be seen from certain perspectives, making them difficult to copy and therefore increasing their resistance to counterfeiting. These trademarks are frequently utilized to avoid the unauthorized copying of goods and services. An important instance is the holographic logo that Glaxo Group employs on its toothpaste containers.¹⁹ Holographic trademarks, due to their dynamic nature, provide an added level of security, making them a useful means of safeguarding brand identity. Unconventional trademarks are a dynamic part of trademark law that showcases the various methods brands use to stand out in the market. Although traditional trademarks such as logos and names have been around for a while, the emergence of unconventional marks like shapes, colors, sounds, and textures shows the necessity for a trademark protection approach that is adaptable and all-encompassing.²⁰ The legal system in India and worldwide is constantly modifying to accommodate these advancements, guaranteeing that all forms of trademarks, both traditional and non-traditional, are appropriately safeguarded to promote equitable competition and brand authenticity.

EVOLUTION OF NON-CONVENTIONAL TRADEMARK

Businesses have historically depended on conventional trademarks like logos, symbols, captions, signs, names, and images to differentiate their products from those of their

¹⁷ Tanisha Agarwal and Vanshaj Mehta, "Hear Me, Touch Me, Taste Me, Smell Me: Conventionalizing Non-Conventional Trademark in India" 3 Journal of Contemporary Issues of Law 1 (2017).

¹⁸ (CS (OS) 1825/2003)

¹⁹ Supra note 8 at 4

²⁰ Ibid

rivals. Traditional symbols have been crucial in establishing brand recognition, enabling consumers to easily distinguish among different products and services. Yet, there has been a notable change in branding tactics lately, prompting companies to consider unique trademarks like colors, shapes, scents, and flavors to differentiate their products in the international market.²¹

This change in trademark usage has ignited significant argument and conversation during the last hundred years. Despite well-known brands using non-conventional trademarks for many years, the legal protection and registration of these marks are recent advancements.²² A few well-known non-traditional trademarks that were adopted early on are the recognizable form of the Coca-Cola bottle, the unique Tiffany blue gift box from Tiffany Company, and the pink color trademarked by Owens Corning Corporation.

These symbols are now essential components of the brands' identities, aiding consumers in quickly recognizing and linking them to their specific products.

The World Intellectual Property Organization (WIPO) acknowledged the importance of dealing with the intricacies related to non-traditional trademarks and formed the Standing Committee on the Law of Trademarks.²³ This committee was assigned the responsibility of examining and classifying various kinds of trademarks. Following a detailed investigation, the committee categorized non-traditional trademarks into two primary groups: visual and non-visual. Visual trademarks consist of characteristics like color, shape, and holograms, whereas non-visual trademarks involve qualities such as taste, smell, texture, and sound.

The development of trademark definitions has played a crucial role in this conversation. It was evident by 1956 that the definition of a trademark was very wide. This understanding arose from conversations at the Vienna gathering and subsequently at the Brussels meeting. These initial discussions laid the groundwork for the evolution of trademark rights as they are currently known.²⁴

The TRIPS Agreement, established in 1994, marked a significant milestone in the

²¹ Supra note 11 at 4

²² Supra note 13 at 4.

²³ Martin Lindstrom, *Brand Sense: Build Powerful Brands Through Touch, Taste, Smell, Sight and Sound* (Kogan Page Publisher, 2005).

²⁴ Kenneth L. Port, "On Non-Traditional Trademarks" William Mitchell College of Law Legal Studies Research Paper Series (Aug. 17, 2024, 8:00 AM), <https://ssrn.com/abstract=1564230>.

development of trademark protection. The TRIPS Agreement revolutionized trademark law by offering a comprehensive definition of what qualifies as a trademark. As specified in Article 15 of the TRIPS Agreement, trademarks encompass a broad variety of symbols, logos, letters, colors, and combinations thereof. This inclusive definition was created to guarantee that trademarks serve their main purpose²⁵ of differentiating products and services, thereby offering safeguard for a variety of marks.

The incorporation of non-traditional trademarks in the TRIPS Agreement marks a major step forward in protecting trademarks. The agreement recognizes that untraditional marks, while not traditional, are effective identifiers for products and can have distinctive qualities important for brand distinction. This acknowledgment enables the safeguarding of trademarks like exclusive fragrances or specific textures, which are crucial in distinguishing products in the market.²⁶

In Europe since the 1800s, there has been a significant amount of scholarly research and conversations focused on safeguarding non-traditional trademarks. During the beginning of the 20th century, Bolivia was leading discussions about safeguarding non-traditional marks like sounds and shapes.²⁷ The talks focused on if these marks can be visually portrayed and how their distinct attributes can be legally safeguarded.

Even though advancements have been achieved in the past twenty years in terms of non-traditional trademark registration and protection, numerous obstacles still exist. Especially challenging are trademarks that are not easily noticed by consumers, like odors, tactile sensations, and flavors.²⁸ The graphical representation of these marks can cause confusion and complications during registration due to their complexity.

To conclude, the realm of trademark protection has changed greatly from classic to non-traditional marks. Although traditional trademarks have always been essential for defining brand identity, non-traditional trademarks are now being acknowledged for their distinctiveness in differentiating products. The TRIPS Agreement has been pivotal in broadening trademark protection to cover unconventional marks, recognizing their

²⁵ Id., art.15

²⁶ Ibid.

²⁷ Paul Leo Carl Torremans, "Trademark Law: Is Europe Moving Towards an Unduly Wide Approach for Anyone to Follow the Example?" 10 Journal of Intellectual Property Rights 127 (2005).

²⁸ Ibid

significance in the global marketplace.²⁹ Yet, obstacles regarding the registration and safeguarding of unconventional trademarks continue to exist, especially for those marks that are not easily identifiable or visually depicted. Ongoing conversations and legal advancements will be crucial in dealing with the complexities of branding strategies and ensuring adequate protection for all kinds of trademarks.

CHALLENGES WITH NON-CONVENTIONAL TRADEMARK

When considering the registration of non-traditional trademarks, it is crucial to recognize that a broad approach might lead to a high volume of applications for unique marks. Such widespread registration could potentially obstruct the business activities of others by creating conflicts or overlaps with existing trademarks.³⁰ This is particularly relevant when considering the need for harmony between international agreements like TRIPS and domestic laws. For effective protection and registration of non-traditional trademarks in India, it is essential to align domestic legislation with global standards while addressing specific legal challenges.³¹

The TRIPS Agreement and other international conventions emphasize the importance of accommodating a wide range of trademarks, including non-traditional types such as scents and sounds. To achieve this, Indian domestic laws must be revised to facilitate the registration of these unconventional marks while clearly defining any potential overlaps with other forms of intellectual property protection.³² For example, there are gray areas where non-traditional trademarks might intersect with copyright protections in the case of motion marks or with patent and design rights for shape trademarks.

One significant issue is the requirement for a "graphical representation" of trademarks, which presents a challenge for marks such as scents or aromas. The existing requirement stipulates that a trademark must be depicted on paper or through a visual medium. This rule, while ensuring that marks are discernible and tangible for registration, poses difficulties for marks

²⁹ Supra note 16 at 5

³⁰ P. Manoj, "Yahoo Awarded India's First Sound Mark; Nokia in Queue" Live Mint, Aug. 02, 2024.

³¹ Neha Mishra, "Registration of Non-Traditional Trademarks" 13 Journal of Intellectual Property Rights 43 (2008).

³² Supra note 27 at 8

that are inherently non-visual, such as smells or sounds.³³ For instance, representing a scent through a chemical formula or description does not adequately capture the sensory experience associated with the trademark, making it challenging to fulfill the graphical representation requirement.

However, some non-traditional trademarks, such as color marks, can be registered more readily if the applicant demonstrates that color or combination of colors has become distinctive through secondary means. This involves proving that the color has been used extensively enough for consumers to associate it specifically with the applicant's goods. While registering a color trademark can be relatively straightforward under these conditions, other non-traditional marks still face significant hurdles.³⁴ For example, depicting a scent or sound graphically remains a complex challenge, impeding the registration process for such marks.

In light of these challenges, recent updates to trademark regulations represent a positive step forward. The evolving legal framework must continue to adapt to the growing prominence of non-traditional trademarks and their niche markets.³⁵ To better support these innovations, a more comprehensive definition of trademarks is needed. The legislation should explicitly address the boundaries between different forms of intellectual property protection, ensuring that non-traditional trademarks do not inadvertently overlap with existing copyrights, patents, or designs.

The experience of jurisdictions with advanced trademark laws, such as the United States under the Lanham Act of 1946, can provide valuable insights for Indian domestic legislation.³⁶ The Lanham Act has established a robust framework for the protection of various types of trademarks, including non-traditional marks. By drawing from the principles and practices of such established systems, India can enhance its trademark laws to better accommodate and protect non-traditional trademarks.³⁷

In conclusion, the registration and protection of non-traditional trademarks in India present both opportunities and challenges. While the recent developments in trademark regulations mark significant progress, there is still a need for more detailed and comprehensive

³³ Supra note 23 at 7

³⁴ “Yet Another Sound Mark Granted” available at <http://spicyipindia.blogspot.com/2009/07/yet-another-soundmark-granted.html>.

³⁵ Supra not 4 at 2

³⁶ The Lanham Act of 1946 (United States).

³⁷ Supra note 24 at 7

legislation. By aligning domestic laws with international standards and addressing the specific issues related to the graphical representation of non-traditional marks, India can create a more effective and inclusive trademark system. This will not only facilitate the protection of innovative brands but also ensure a balanced and fair market environment for all businesses.

“THE METAVERSE: RETHINKING INTELLECTUAL PROPERTY PROTECTION IN A DIGITAL FRONTIER”

As the Metaverse—an expansive, immersive virtual environment—edges closer to becoming a mainstream reality, the way brands engage with consumers is poised for a dramatic transformation. The Metaverse, often described as the next evolution of the Internet, merges elements of augmented reality (AR), virtual reality (VR), and traditional digital interfaces to create a persistent, interactive virtual world.³⁸ In this new digital landscape, users engage through avatars, participate in virtual events, and explore a variety of experiences, from virtual travel and concerts to shopping and socializing.³⁹

While the Metaverse remains largely conceptual and under development, companies are already making strides to establish a presence within this burgeoning digital space. For brand owners aiming to extend their reach into the Metaverse, the new environment presents both substantial opportunities and complex challenges.⁴⁰ One of the primary concerns is ensuring that intellectual property (IP) protection keeps pace with the evolving digital landscape. A robust, comprehensive IP protection system is essential for safeguarding brand identity and maintaining competitive advantage in this emerging domain.

Challenges of Protecting Brands in the Metaverse

The Metaverse introduces unique challenges for IP protection, especially concerning trademarks. Unlike traditional trademarks, which are often visual and tangible—such as logos, product names, and packaging—the Metaverse encompasses a broader range of elements that can include color schemes, virtual goods, and interactive experiences.⁴¹ As a

³⁸ World Intellectual Property Organization, Member States Agree to Move Ahead With Efforts To Harmonize Trademark Law, available at: http://www.wipo.int/pressroom/en/html.jsp?file=/redocs/prdocs/en/2001/wipoupd2001_154.html (last visited Aug. 23, 2024).

³⁹ Adam L. Brookman, *Trademark Law: Protection, Enforcement and Licensing*, 7 (2nd ed., 2017).

⁴⁰ *Ibid.*

⁴¹ *Supra* note 34 at 10

result, brand owners must navigate a complex landscape where traditional trademark laws may not fully apply or may require adaptation.

One of the key challenges is determining how to protect and enforce trademarks in a space where conventional forms of trademark representation might not suffice. In the Metaverse, brands can leverage virtual billboards, sponsor events, and establish virtual “malls” to interact with users. These new forms of engagement complicate the traditional trademark framework, which is primarily designed for physical goods and services.⁴²

Moreover, the rise of decentralized applications and non-fungible tokens (NFTs) adds another layer of complexity. Brands are already using NFTs to offer digital versions of products, such as virtual clothing lines or limited-edition items. For example, Louis Vuitton’s interactive game “Louis” allows users to customize avatars with virtual NFTs featuring the brand’s trademarked prints and colors.⁴³ Similarly, Dolce & Gabbana has launched a line of branded NFT-based digital wearables, providing fans with access to both virtual and physical versions of the items. Gucci’s collaboration with Roblox exemplifies the potential for virtual goods to command higher prices than their physical counterparts, as a digital Gucci Dionysus bag sold for nearly \$4,100 on the Roblox marketplace—substantially more than the price of the real bag.

The Need for Comprehensive IP Protection

The rapid evolution of the Metaverse underscores the need for a more comprehensive approach to trademark protection. As brands begin to offer digital goods and services, the risk of trademark infringement and counterfeiting becomes more pronounced.⁴⁴ The challenge lies in predicting and mitigating these risks in a new and rapidly developing environment where traditional infringement models may not apply.

Trademark owners must ensure that their IP protection strategies encompass the Metaverse’s full range of virtual interactions. This includes securing trademark rights for virtual goods and services and addressing potential overlaps with other forms of intellectual property, such as copyrights for motion marks or design rights for shape trademarks.

Current Efforts and Case Studies

⁴² Ibid

⁴³ Supra note 1 at 2

⁴⁴ Supra note 2 at 2

Several forward-thinking brands have already taken steps to secure their trademarks within the Metaverse. For instance, Converse has filed multiple applications to obtain trademark protection for virtual goods and services related to its iconic ALL STAR CHUCK TAYLOR logo (Application # 97107382). Abercrombie & Fitch has similarly sought protection for virtual goods featuring its distinctive bird and moose designs (Application Nos. 97106352 and 97106342). Nike has been particularly proactive, submitting trademark applications for various aspects of its brand, including the NIKE logo (Application # 97095855), the JUST DO IT slogan (Application # 97096236), and the AIR JORDAN logo (Application # 97096945).

These examples illustrate a growing recognition of the need to adapt trademark protection to the Metaverse's unique characteristics. However, the current IP protection system remains largely based on traditional trademark classifications.⁴⁵ As marketing strategies continue to evolve and the digital realm expands, there is a pressing need for IP laws to adapt to new forms of non-traditional trademarks.

Adapting IP Laws for the Metaverse

To effectively address the challenges posed by the Metaverse, IP laws must undergo significant reform. The existing rigid classification system for trademarks needs to evolve to accommodate a broader range of digital and virtual elements. This includes developing new legal frameworks that recognize and protect non-traditional trademarks, such as virtual goods, digital experiences, and interactive branding elements.⁴⁶

The experience of jurisdictions with advanced IP systems, such as the United States under the Lanham Act of 1946, offers valuable insights.⁴⁷ The Lanham Act provides a robust foundation for protecting various types of trademarks, including those in digital and virtual contexts. By drawing on these principles, Indian domestic legislation and other jurisdictions can develop more comprehensive and flexible IP protections tailored to the Metaverse.

The Metaverse represents a transformative shift in how brands interact with consumers and how intellectual property is managed. As this digital frontier continues to develop, brand owners must navigate a complex and evolving landscape to protect their trademarks

⁴⁵ Supra note 23 at 7

⁴⁶ Supra note 39 at 11

⁴⁷ Supra not 36 at 10

effectively.⁴⁸ Ensuring that IP laws adapt to the Metaverse's unique requirements will be crucial for maintaining brand integrity and competitive advantage in this new virtual environment. By adopting a more inclusive and forward-thinking approach to IP protection, brands can better safeguard their interests and capitalize on the opportunities presented by the Metaverse.

REGISTRABILITY OF NON-CONVENTIONAL

TRADEMARKS IN INDIA: CHALLENGES AND FUTURE

DIRECTIONS

The landscape of trademark registration is evolving with the growing prominence of non-conventional trademarks, including sounds, smells, shapes, and textures. In India, the legal framework traditionally focused on conventional marks such as logos and names, but there is increasing interest in protecting non-traditional marks as brands seek to innovate and differentiate themselves.⁴⁹ However, registering non-conventional trademarks in India presents unique challenges, primarily due to the requirement for graphical representation and the need to demonstrate acquired distinctiveness. This article explores these challenges, examines recent developments in Indian trademark law, and discusses the implications for brand protection in both the physical and virtual realms.

1. Legal Framework for Non-Conventional Trademarks

1.1. Graphical Representation Requirement

Under Indian trademark law, specifically Section 2(zb) of the Trademark Act of 1999, a trademark must be capable of being represented graphically to qualify for registration. This requirement can be particularly challenging for non-conventional trademarks such as sounds and smells.⁵⁰ For instance, sound marks, which involve distinctive auditory elements like jingles or specific tones, are difficult to capture visually. Similarly, smell marks, which pertain to unique scents associated with products, cannot be easily depicted graphically.⁵¹

Historically, this requirement created significant barriers for non-traditional marks. However, recent amendments to the Trademark Rules in 2017 have provided some relief. The rules now

⁴⁸ Tobias Cohen Jehoram, Constant van Nispen & Tony Huydecoper, *European Trademark Law: Community Trademark Law and Harmonized National Trademark Law* (2010).

⁴⁹ Supra note 31 at 9

⁵⁰ Supra note 17 at 5

⁵¹ Supra note 16 at 5

allow the submission of MP3 files or video files for sound marks and chemical formulas or descriptions for smell marks under Section 2(qa).⁵² These provisions aim to address the graphical representation challenge by accommodating the unique characteristics of non-conventional marks. Despite these advancements, practical difficulties remain in fully representing and registering such marks.

1.2. Distinctiveness and Secondary Acquired Distinctiveness

To be eligible for registration, a trademark must be distinctive. Non-conventional trademarks often lack inherent distinctiveness and must therefore demonstrate secondary acquired distinctiveness.⁵³ This means that the mark must have gained recognition through extensive use, enabling consumers to associate it uniquely with the brand.

The requirement for secondary distinctiveness involves proving that the mark has become recognizable over time as a source identifier. This process can be arduous and requires substantial evidence of use and consumer recognition.⁵⁴ The Indian Trademark Act mandates this demonstration to ensure that non-traditional marks are not merely descriptive or functional but have achieved a level of distinctiveness that warrants protection.

2. Recent Developments and Case Law

2.1. Case Studies on Non-Conventional Trademarks

Recent cases in India illustrate the challenges and successes associated with non-conventional trademarks:

2.2. Recent Amendments and International Trends

The Trademark Rules 2017 were a significant step toward accommodating non-conventional trademarks, but further reforms may be necessary. Internationally, jurisdictions like the European Union and the United States have established more comprehensive frameworks for non-traditional trademarks. For example, the EU's Trademark Regulation and the US Lanham Act provide detailed guidelines for registering sound, smell, and color marks, offering valuable insights for India's evolving trademark system.⁵⁵

3. Future Directions and Recommendations

⁵² Section 2(qa) of Trademark Act “In this Act, unless the context otherwise requires, any reference— (a)to “trade mark” shall include reference to “collective mark” or “certification trade mark”

⁵³ Supra not 4 at 3

⁵⁴ Supra note 1 at 2

⁵⁵ Supra note 2 at 2

3.1. Need for Legislative Reform

The current legal framework in India requires further adaptation to address the complexities of non-conventional trademarks. Legislative reforms should include clearer provisions for the registration of non-traditional marks, such as sounds and smells, and provide guidance on the graphical representation requirements. Aligning Indian trademark law with international standards can facilitate the protection of innovative brand elements and enhance consistency in global trademark practices.

3.2. Embracing Technological Innovations

Leveraging technological advancements can aid in overcoming the challenges of graphical representation.⁵⁶ For example, virtual reality (VR) and augmented reality (AR) technologies can offer innovative ways to represent non-conventional trademarks in a visually accessible format. Collaboration between legal and technological experts can drive the development of new solutions for trademark registration and protection.

The registrability of non-conventional trademarks in India presents both opportunities and challenges. While recent amendments and case law have made strides toward accommodating these marks, significant hurdles remain, particularly concerning graphical representation and secondary distinctiveness.⁵⁷ As branding strategies evolve and the Metaverse expands, Indian trademark law must adapt and provide comprehensive protection for innovative brand elements. By embracing legislative reforms and technological innovations, India can better support the evolving needs of brand owners and ensure effective protection in both physical and virtual environments.

CONCLUSION

The evolving landscape of trademark law underscores a shift from traditional to non-conventional trademarks, reflecting broader changes in branding strategies and market dynamics. Traditional trademarks—logos, names, and symbols—have long served as the cornerstone of brand identity, aiding consumers in distinguishing products and ensuring market clarity. However, as brands seek more distinctive ways to stand out, non-conventional trademarks, such as shapes, colors, sounds, smells, and textures, have emerged, pushing the boundaries of trademark protection.

⁵⁶ Supra note 4 at 3

⁵⁷ Surpra note 8 at 4

In India, the Trademark Act of 1999 and its rules have historically emphasized graphical representation, posing challenges for registering non-traditional marks. While recent amendments, such as those introduced in the Trademark Rules of 2017, have made provisions for sound marks and scent descriptions, significant hurdles remain. The requirement for graphical representation continues to complicate the registration of marks that cannot be easily visualized, such as odors and specific textures.

Internationally, frameworks like the European Union's Trademark Regulation and the US Lanham Act have made notable strides in accommodating non-traditional trademarks. These jurisdictions have developed more nuanced guidelines that recognize the unique nature of non-traditional marks and provide clearer pathways for their protection. Their approaches offer valuable insights for India as it navigates the complexities of adapting its trademark system to better address these innovative forms.

The Metaverse—a burgeoning digital realm combining virtual reality (VR), augmented reality (AR), and digital interfaces—further complicates trademark protection. As brands explore new ways to engage with consumers through virtual goods and experiences, the need for a comprehensive intellectual property (IP) framework becomes increasingly evident. Traditional trademark laws often fall short in this digital context, necessitating reforms to protect virtual assets and interactive elements effectively.

India's trademark legislation must undergo significant reform to address these evolving challenges. Key areas for improvement include:

1. **Enhanced Definitions and Provisions:** India should expand its trademark definitions to clearly include non-traditional marks and provide specific guidelines for their registration. This includes developing criteria for non-visual trademarks and aligning with international standards to facilitate global brand protection.
2. **Technological Integration:** Embracing technological advancements, such as VR and AR, can offer new methods for representing non-traditional trademarks in a format that meets legal requirements. Collaborations between legal experts and technologists can drive innovation in how trademarks are visualized and protected.
3. **Secondary Distinctiveness:** The process of demonstrating secondary distinctiveness for non-traditional marks should be streamlined. Clearer guidelines and support mechanisms can

help brand owners more effectively prove that their marks have gained recognition and distinctiveness through extensive use.

4. International Alignment: Aligning Indian trademark laws with international frameworks, such as those provided by the TRIPS Agreement, can help ensure consistency and facilitate cross-border protection. Learning from jurisdictions with advanced systems can guide the development of a more robust and adaptable trademark regime in India.

In summary, while India has made progress in accommodating non-traditional trademarks, there is still much work to be done. The rapid evolution of branding strategies, coupled with the rise of digital spaces like the Metaverse, calls for a more flexible and comprehensive approach to trademark protection. By reforming legislation and leveraging technological advancements, India can better support the protection of innovative brand elements, ensuring fair competition and safeguarding brand integrity in both physical and virtual environments.