

What Constitutes A "Mark" For The Purposes Of Trademark Registration? A Critical Review

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Abstract

This paper critically investigates the eligibility criteria of the marks for the registration of trademarks in conventional and non-conventional trademarks. What qualifies as a mark has witnessed a sea change, and the Trademark law and international treaties thereto reflect those changes. However, due to technical inability or market practice differences, organisations have witnessed the acceptance of some marks in one territory, but in another, it is not approved. These variations and divergent practices of the different trademark jurisdictions sometimes result in conflicting claims by different owners. Statutory and administrative differences exist within the ambit of conventional and non-conventional trademarks. The graphical representation of conventional trademarks appears almost similar in different territories, whereas non-conventional trademarks lack standardisation. Some non-conventional marks, such as colour and sound marks, can be graphically represented. In contrast, others, such as olfactory, texture, taste, and motion marks, need an innovative mechanism. The practice of different topography is divergent, and they apply different policies.

Keywords: Trademark Registration, Procedural Law, Trademark Eligibility, Mark, Conventional Trademarks, Non-Conventional Trademarks.

1. Introduction

Legal protection for trademarks has expanded widely in the last century¹. Since the recognition of new subject matter of trademarks to new causes of action, trademark owners have benefited due to additional protection. The rising significance of the brand in generating and constructing goodwill has led trademark owners to pursue this protection². The range of topic that qualifies as trademarks is extensive. Currently, they are explicitly allowed for word and design trademarks as well as trade dress, which include colour marks, trade dress, and packaging. Registering a mark confers advantages, such as access to incontestability status, prima facie proof of validity, and nationwide constructive use³.

What constitutes a mark for trademark protection is defined by the legislature of various jurisdictions. Section 2 (1)(m) of the Indian Trademark Act, 1999 defines Mark: "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"⁴. In the

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¹Jr Michael S. Mireles, Aesthetic Functionality, 53 TEXAS INTELLECT. PROP. LAW J. 1689 (2013).

²Id.

³Id.

⁴ The Trademarks Act , 1999, S 2, No. 47, Acts of Parliament, 1999 (India).

case of *Abercrombie and Fitch*, a landmark case in the United States of America, the court held that “we conceive of no “thing” inherently incapable of carrying meaning, anything can come to distinguish goods in commerce and thus constitute a mark within the meaning of the trademark”⁵. Hence, the owner can attach a “trademark meaning” to almost any symbol or device⁶.

However, the debate on the registrability of marks is an old one that is still going strong today in nearly every jurisdiction based on conventional and non-conventional marks. Some countries make rules and regulations for registering non-conventional marks, while others do not. Recently, the European Union has made amendments to the rules for the registration of non-conventional marks. Given this backdrop, it is essential to examine the current position of mark eligibility criteria for trademark registration, especially with reference to India.

The existing studies on this topic are limited, especially ones covering the non-conventional trademark that too in the Indian context. Overall, the registration of trademark law with respect to conventional and non-conventional trademarks is a complex and evolving area of trademark law (Qian Zhan, 2017)⁷. Non-conventional trademarks are new types of trademarks that do not belong to a pre-existing conventional mark. Non-conventional marks raise new challenges for trademark registration procedures (Yospin, 2019)⁸. There is no specific law governing non-conventional trademarks in some jurisdictions, like the UK, EU, and India, which creates uncertainty and challenges for owners of marks seeking the protection of such types of marks (Mishra, 2008)⁹. The legal framework for the protection and registration of non-conventional marks is underdeveloped in the US, EU, and India (Gibbons, 2019)¹⁰. After the EU legislation amendment, there are more opportunities for owners of marks to develop new types of non-conventional marks, but there are still challenges in terms of registration and protection (Tolulope Anthony Adekola, 2019)¹¹. Overall, the registration of non-conventional trademarks creates unique challenges and opportunities for the owner of the trademark to protect their trademark. The legal landscape is evolving, and there is a need for further clarity and guidance in this area. Our study is an attempt to understand the comprehensive and systematic aspects related to non-conventional trademarks and builds a case for re-evaluating the ‘mark’ eligibility criteria.

This paper first elucidates some international treaties and conventions that provide criteria for the registration of marks. Secondly, it explains the theoretical background with particular emphasis on the functionality theory, which includes both utilitarian and aesthetic theories. Thirdly, it discusses how the requirement for graphical representation for trademark registration varies across jurisdictions. Fourthly, it looks into the registration of non-traditional marks as trademarks. Finally, it ends with the concluding thoughts.

⁵ *Abercrombie & Fitch Company v. Hunting World Incorporated*, 537 F. 2d 4 (2d Cir. 1976).

⁶ *Id.*

⁷ Qian Zhan, *The International Registration of Non-traditional Trademarks: Compliance with the TRIPS Agreement and the Paris Convention*, 16 *WORLD TRADE REV.* 111 (2017).

⁸ By Matthew, *Posted April & In Intellectual Property, NON-CONVENTIONAL TRADEMARKS*, 2 (2019).

⁹ Neha Mishra, *Registration of Non-Traditional Trademarks*, 13 43 (2008).

¹⁰ Gabrielle E. Brill, *Make Some Sense of Scent Trademarks: The United States Needs a Graphical Representation Requirement*, 56 *UNIV. RICHMOND SCH. LAW* 22 (2022).

¹¹ Tolulope Anthony Adekola, *Abolition of graphical representation in EU trademark directive: Should countries with similar provisions follow EU’s footsteps?*, 24 *J. INTELLECT. PROP. RIGHTS* 62 (2019).

2. International Treaties and Registration of Trademark

International agreements have been signed to facilitate the international protection of trademarks¹². Several international agreements have been signed to facilitate the international protection of industrial property rights; the oldest is the Paris Convention¹³, while the most recent treaties are the Tripartite Agreement¹⁴ and the Marrakesh Convention¹⁵. Some of these treaties, which serve as important milestones in the journey of trademark legislation, are briefly described below.

Paris Convention

The Paris Convention for the Protection of Industrial Property has been the cornerstone of the international regulation of industrial property for nearly a century; it makes no provision for the definition of a trademark¹⁶. However, the Paris Convention stipulates that trademarks registered in members of the state of origin are protected by other members of the Union of States. The principles of independence and *telles que* are covered in Article 6 and Article 6quinquies of the Paris Convention, respectively¹⁷. The Paris Convention says nothing about the trademark registration. In light of the various requirements for trademark registration in multiple jurisdictions, it is commonly acknowledged that one of the important responsibilities of international trademark law is to resolve these challenges¹⁸. It is necessary to establish a uniform trademark definition. The purpose of establishing a general trademark definition is to find a concept that includes the categories that are capable of protection within individual countries¹⁹. This convention does not cover the registration of non-conventional trademarks. These absent provisions are covered under the TRIPS Agreement, the major highlights of which are discussed below.

TRIPS Agreement

The TRIPS agreement defined the term trademark. Article 15.1 of the TRIPS agreement provides that 'any signs and combinations of signs that are capable of distinguishing the goods or service of one undertaking from those of other undertakings, shall be capable of constituting a trademark'²⁰. Hence, the 'essential characteristic' of trademarks is that they must have the capability of distinguishing goods or services. According to F. Schechter, the only rational basis for trademark protection is distinctiveness²¹. The term capable of distinguishing includes marks that actually distinguish as well as marks that have the

¹²Joanna Schmidt-Szalewski, *The international protection of trademarks after the TRIPS agreement*, 9 *DUKE J. COMP. INT. LAW* 189 (1998).

¹³ Paris Convention for the Protection of Industrial Property (Paris Convention), Signed on March 20, 1883, as revised in Brussels on December 14, 1900, in Washington, DC on June 2, 1911, in the Hague on November 6, 1925, in London on June 2, 1934, in Lisbon on October 31, 1958, in Stockholm on July 14, 1967 and in Stockholm on September 25, 1979.

¹⁴ Agreement on Trade related aspect of Intellectual Property Rights, Signed on April 15, 1994.

¹⁵ Marrakesh Agreement Establishing the World Trade Organization, Signed on April 15, 1994.

¹⁶Zhan, *supra* note 7.

¹⁷By L A Ellwood & B Li, "TELLE QUELLE" CLAUSE The Preface to the 5th Edition of Sebastian's Law of Trade Marks, 1911.

¹⁸Zhan, *supra* note 7.

¹⁹Id.

²⁰ Article 15 of Trips Agreement.

²¹The Rational Basis of Trademark Protection Author (s): Frank I. Schechter Source: *Harvard Law Review*, Vol. 40, No. 6 (Apr., 1927), pp. 813-833 Published by: The Harvard Law Review Association Stable URL: <http://www.jstor.org/stable/1330367>, 40 813 (2017).

capacity to distinguish. Distinctiveness could be called a universal criterion; registration of a trademark and its application though differs from one jurisdiction to another²². Article 1.1 of the TRIPS Agreement provides that each member of the agreement may resort to its legal system and practice to carry out such an assessment²³. Article 15.1 clarifies the definition by giving examples of signs that are eligible for registration as trademarks, such as words, including personal names, letters, numerals, figurative elements, and combinations of colours. However, this article also did not say anything regarding non-conventional trademarks. The absence of defining the non-conventional trademark does not mean that the members of WTO (as TRIPs Agreement form part of WTO) are strictly prohibited from registration of non –conventional trademarks.

Madrid Agreement and Protocol

The Madrid Agreement and the Protocol relating to that Agreement deal with the international trademark registration. These conventions are silent on the definition of a trademark and do not specify the scope of a mark²⁴. Both conventions are also silent on subject matters of non-conventional trademarks, while they provide international trademark registration through the World Intellectual Property Organization (WIPO).

Trademark Law Treaty

The Trademark Law Treaty is the only international treaty that directly and expressly excludes non-traditional marks from trademark protection²⁵. As we have seen, several treaties deal with trademark protection, but they are not related to trademark registration.

There are two treaties which deal with trademark registration procedures: the **Nice Classification** and the **International Classification of the Figurative Elements of Marks** (Vienna Classification)²⁶. Some international treaties, such as the Paris Convention, Madrid System, Trademark Law Treaty, and Singapore Law Treaty, try to achieve some degree of standardization and uniformity of trademark law²⁷. However, complexity and ambiguity still exist when it comes to non-conventional trademarks.

In the next section, we describe the underlying theoretical foundation that justifies trademark registration.

3. Theoretical Foundations

Unlike other Intellectual Property (IP) rights, for instance, patents, utility models, designs act, and even copyright law considering here patents, utility models, designs, and even copyrights are different from trademarks due to the continuous use of marks and perpetual ownership of the trademark. Patents, designs and copyrights are granted for some specific period, while trademarks are perpetual rights with renewal and fee payment. This can make a successful product the object of permanent exclusivity. This opportunity of perpetuity brings the problem of functionality as every firm will be willing to take more and more trademarks for as many features of a product as possible to prevent the competitors from using them²⁸. Hence, the theoretical underpinnings of trademarks are distinct from those of other IP rights.

²²Zhan, supra note 7.

²³ Article 1 of Trips Agreement.

²⁴ The Madrid Agreement and Protocol.

²⁵ The Trademark Law Treaty, Signed on 1994.

²⁶ Aishwarya Vatsa, Subject Matter and Pre-Requisites for Protection of Non-Conventional Trademark, 8 CHRIST UNIV. LAW J. 61 (2019).

²⁷Id.

²⁸Csenge Merkel, Doctrine of Functionality in Trademark Law: an Eu and a Us Perspective, 98 241 (2021), www.jstor.org/stable/41350238.

The functionality doctrine, which governs the trademark, states that a trademark cannot cover the product's qualities that identify its source but is also necessary for the product to function properly²⁹. Functionality in trade mark law is a term designating a set of legal provisions that deny trade mark protection to signs consisting of specific product features that are technically or aesthetically important for competitors and consumers, especially those which can impede the risk of effective competition on the market³⁰. In other words, granting legal exclusivity via trade mark registration on such a 'functional' sign on behalf of one undertaking would necessarily restrain competitors' ability to trade in products with identical or similar features that could also be important for consumers. Thus, from an entrepreneurial perspective, trademarks play a paramount role³¹.

Two types of functionality theories play an important role in determining the subject matter of a trademark. One is Utilitarian Functionality Theory, and the other is Aesthetic Functionality Theory.

Utilitarian Functionality

Utilitarian functionality attempts to prohibit trademark law from protecting symbols and devices with some utility³². According to the utilitarian functionality theory, some courts focus on the right of the public to copy unpatented articles. Specifically, utilitarian functionality is discussed in relation to how it is believed to regulate the area where patent and trademark rules meet³³. If goods or products feature as patentable, then that product or goods cannot come under the subject matter of trademark. For instance, the blue dot on Sylvania camera flash bulbs was determined to be functional since a change in the dot's color was utilised to identify defective bulbs during the production process, as well as bulbs that had developed air leakage after purchase³⁴.

Aesthetic Functionality

The aesthetic theory denies trademark protection that would eliminate a competitive market for the product on which the trademarked feature appears³⁵. The notion of "aesthetic functionality" refers to signs and objects that serve no practical purpose but have some merit warranting their exclusion from the scope of trademark law³⁶. Typically, this has to do with defending the interests of clients and customers. This theory provides a wider scope of features and products that may be trademarked. Because it is difficult to decide which test to employ and how to apply it, answering the question of what is functional is challenging. However, because trademark law has the potential to stifle competition, aesthetic theory has drawn the attention of the US Supreme Court, other courts, and academics³⁷. Courts have developed six tests from the case law to implement the aesthetic theory. 1) Comparable alternatives, 2) essentiality to usage, 3) relation to usage, 4) ease of manufacture, 5) effective competition, and (6) de facto/de jure functionality.³⁸ Courts

²⁹Robert G. Bone, Trademark functionality reexamined, 7 J. LEG. ANAL. 183 (2015).

³⁰Lavinia Brancusi, Why is the Functionality Doctrine in Trade Mark Law worth Advanced (Re)Consideration?, 1 CONTEMP. CENT. EAST EUR. LAW 43 (2019).

³¹Id.

³²Michael S. Mireles, supra note 1.

³³Justin Hughes, Cognitive and Aesthetic Functionality in Trademark Law, 36 CARDOZO LAW REV. 1227 (2015).

³⁴Id.

³⁵Saks Fifth, When in Doubt, Wear Red: Understanding Trademark Law's Functionality Doctrine and Its Application to Single-Color Trademarks in the Fashion Industry, 445 KANSAS LAW REV. (2016).

³⁶Michael S. Mireles, supra note 1.

³⁷Id.

³⁸Fifth, supra note 35.

divide on the application of the aesthetic functionality doctrine to protect the features of the trademark owner and the competitiveness of the marketplace. The problem focuses on ornamental features that have the potential to influence consumer behaviour, but are neither essential nor helpful to the primary function of the product.

In brief, the features which fuel the aesthetic functionality debate are the very features that lie in the unsettled terrain between the “utilitarian” and the “aesthetic” theories of functionality. The utilitarian theory holds that such ornamental features are functional because they possess some quantum of value beyond identifying their source. On the other hand, the aesthetic theory maintains the opposite view; these features are not functional because they do not significantly endanger the competitiveness of their respective products’ markets³⁹.

In sum, the functionality theory emphasises what aspects would not be protected rather than what features might qualify for trademark protection. It follows from the above discussion that the subject matter of trademarks is not just restricted to the scope of legislative activity. However, the court also plays a significant role in determining whether marks are eligible for trademark registration⁴⁰. Next, we discuss the case of graphical representation as the foundational notion governing trademarks and how it varies in two jurisdictions, namely India and the EU.

4. Graphical Representation: The Case of European Union and India

4.1. Graphical Representation in Conventional Trademark

One of the fundamental prerequisites for the registration of a trademark is the graphic representation of marks. Several countries’, trademark laws feature the necessity of a graphical representation clause⁴¹. Although the TRIPS Agreement does not specifically indicate that trademarks must be depicted graphically, it does state that WTO members may stipulate that a sign must be visible to be registered. As a result, the TRIPS Agreement does not require graphic representation and instead emphasizes visual perceptibility⁴². According to WIPO, 62 out of 73 national offices and 2 out of 3 intergovernmental organizations accept graphical representation as an important element for trademark registration, and it is included in trademark definition⁴³. The term ‘graphical’ is normally associated with the idea of a picture or writing which may capture the main features of the mark. It is suitable for words, names, letters, figurative elements, combinations of color, the shape of goods and their packaging, any combination of those signs, and even numerals⁴⁴. Therefore, the graphical representation should be independently sufficient to identify the applicant's mark; the representation should stand in place of the mark; and it should enable those inspecting the register to understand what the mark is⁴⁵. In the landmark case of the UK of Swizzels Matlow Ltd.’s Appl⁴⁶, the court held that there could not be a trademark if there could not be a trademark registration without the same being reduced to paper graphically. The court continues by citing two justifications for the requirement: first, to make it easier for businesses to recognize what other businesses have registered as

³⁹Id.

⁴⁰Merkel Supra note 27.

⁴¹Adekola, supra note 11.

⁴²Id.

⁴³ WIPO SCT, STANDING COMMITTEE ON THE LAW OF TRADEMARKS, INDUSTRIAL DESIGNS AND GEOGRAPHICAL INDICATIONS Seventeenth Session Geneva, May 7 to 11, 2007 (2007).

⁴⁴Id.

⁴⁵Dev Gangjee, National Law School of India Review Non Conventional Trade Marks in India, 22 (2010).

⁴⁶SwizzelsMetlow Ltd.’s Appl UK (1998 RPC 244).

trademarks, and second, to make it easier for the general public to understand what is being registered. Graphical representation thus becomes vital in determining the subject of the registration⁴⁷.

In the European Union (EU), the criteria for determining a sign's eligibility for trademark protection are harmonized to a large extent. The requirement of graphical representation is that a sign sort to be registered in the EU must be distinctive and must also be 'clear, precise, self-contained, easily accessible, intelligible, durable and objective'⁴⁸. Three reasons are given to justify the requirement of graphical representation. First, the graphical representation requirement, establishes the parameters for protecting the sign sought to be protected, is comparable to a patent claim in a patent application. Second, the requirement for graphical representation is informative in nature; it makes it possible for the sign to be easily accessible by the general public and rival companies and is designed to give third parties a chance to inspect the sign in order to prevent potential infringement of rights granted⁴⁹. Third, the demand for graphical representation aids in managing registered signs for administrative purposes, particularly in the classification and comparison of old and new signs⁵⁰.

In India, the Trademark Act, 1999 and Trademark Rules, 2017 necessitate graphical representation. According to section 2(1) (zb) of the act, a trademark means a mark which is capable of distinguishing of the goods or services of one person from those of others, and may include the shape of goods or their packaging and combinations of colours⁵¹. The words, capable of being represented graphically would mean that the mark should be such as capable of being put on register in a physical form and also being published in the journal. Rule 2 (1) K of the Trademark rules 2017 establishes that graphical representation means a mark for goods or services represented or capable of being represented in paper form and includes representation in digitized form⁵². From the above rules and the definition given in Section 2(1) (zb) of the act, it is clear that, in any case, any representation of a mark can be reducible to a paper format by filling the form TM A, which is prescribed for the application form for registration of a trademark. The Supreme Court of India affirmed this proposition in the case of *Laxmikant V. Patel v Chetanbhat Shah & Anr*⁵³, the court held that the definition of trademark, inter alia, was observed to have three distinct elements: it should be a mark, capable of being represented graphically and should be capable of distinguishing the goods or services of one person from those of others. Thus, it is clear that the graphical representation of a trademark is an essential element of the subject matter of the registration of a trademark.

However, this graphical representation requirement may pose certain problems for other types of signs or marks, particularly for non-conventional marks or non-visible signs. There are problems with graphical representation, especially with sound marks, colour marks, smell marks, taste marks, motion marks, touch marks, etc. Many of these marks do not satisfy the criteria of graphical representation.

4.2. Graphical Representation in Non-Conventional Trademark

⁴⁷Ieee- Vppc, E NERGITIC M ACROSCOPIC R EPRESENTATION AND OTHER G RAPHICAL D ESCRIPTIONS » Invited session organized by MEGEVH, 156 1 (2012).

⁴⁸Adekola, supra note 11.

⁴⁹ Article 4 of EUTMR.

⁵⁰Adekola, supra note 11.

⁵¹ Trademark Act, 1999.

⁵² Trademark Rules, 2017.

⁵³*Laxmikant V Patel V. Chetanbhat Shah & Anr*, (AIR 2002 SC 275).

Graphical representation of non-conventional trademarks is more of a practical rather than a legal problem. It may pose serious obstacles to registering a non-conventional trademark⁵⁴. There is a need to ensure legal certainty in the process of registering a mark in non-conventional trademark as well. The EU proposal to reform the trademark law started in 2008, when a research project was handed over to the Max-Planck Institute for Intellectual Property and Competition Law from 2009 to 2011. One of the key recommendations of the report was to have a more flexible law for registration of trademarks⁵⁵. Accordingly, the EU Directive removed the requirement of graphical representation with the aim to pave the way for the registration of more non-visually perceptible marks effective from October 1, 2017.⁵⁶

EU Provisions before the Amendment

Article 4 of the EUTMR prior to the Amendment ascertains: “An EU trade mark may consist of any signs 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”⁵⁷.

EU Provisions after the Amendment

Article 4 of the EUTMR after the amendment states:

“An EU trade mark may consist of any signs, in particular words, including personal names, or designs, letters, numerals, colors, the shape of goods or of the packaging of goods, or sounds, provided that such signs are capable of:

- a) Distinguishing the goods or services of one undertaking from those of other undertaking; and
- b) Being represented on the register of European Union Trademarks (‘the Register), in a manner which enables the competent authorities and the public to determine the clear and precise subject matter afforded to its proprietor”⁵⁸.

From the above amendment, it is clear that the phrase “being represented graphically” is removed from the clause and replaced with the phrase "being represented in the register," which marks a significant difference from the prior provision. This removal implies that signs can be depicted however they like as long as it helps the general public and the appropriate authority comprehend the level of protection given to the mark⁵⁹. This EU trademark law reform altered the landscape of trademark law to the point where some other jurisdictions followed it. Thus, the subject matter of non-conventional trademarks has been expanded by the EU trademark law, and shape marks, sound marks, colour marks, smell marks, taste marks, etc., also constitute the subject matter of non-conventional marks that are now used and registered⁶⁰.

Some significant non-conventional marks and judicial interpretation of them are discussed below.

Odour Marks

⁵⁴Arka Majumdar, Subhojit Sadhu & Sunandan Majumdar, The Requirement of Graphical Representability for Non-Conventional Trademarks, 11 J. INTELLECT. PROP. RIGHTS 313 (2006).

⁵⁵Adekola, supra note 11.

⁵⁶Id.

⁵⁷ Article 4 of the EUTMR prior to Amendment, 2017.

⁵⁸ Article 4 of the EUTMR after the amendment, 2017.

⁵⁹Adekola, supra note 11.

⁶⁰Vatsa, supra note 26.

Odour marks are one of the examples of non-traditional trademarks. The EU court judgment is very important for the registration of smell marks, which deals with the graphical representation of non-conventional marks. In the landmark case, *Ralf Sieckmann V German Patent office*⁶¹ the court interpreted the graphical representation extensively. In this case, the applicant wanted to register a scent that was "balsamically fruity with a faint cinnamon undertone." He did it using three different techniques: a verbal description, a chemical formula, and the submission of an actual sample of the smell. First, the ECJ determined that a mark that cannot be recognized by sight alone may be considered a trademark if it has a distinctive quality and may be visually represented, particularly by utilizing images, lines, or characters. According to the judgment, "signs capable of being depicted graphically are not restricted to those ones which can be received visually"⁶². The Court said, "the graphical representation shall be clear, precise, self-contained, readily accessible, understandable, durable, and objective". The court ultimately decided that neither of the methods used singly nor in combination can graphically describe that the aroma was adequate. However, it argued that the combination of these approaches should not be distinguished because they, when taken as a whole, pass the test even if each method alone does not meet every requirement. Therefore, the registration of smell mark was rejected on the basis of not fulfilment of the graphical representability criteria, among other factors.

Even though Sieckmann sought to register a fragrance mark, the ruling that resulted in the so-called Sieckmann criteria also applies to all intangible marks⁶³. A more detailed explanation of colour and sound marks follows in the next two sub-sections.

Colour Marks

Colours and colour combinations may be trademarked and protected under EU legislation. In the famous case *Libertel Groep BV v. Benelux-Merkenbureau*⁶⁴, Libertel attempted to register the colour orange as a trademark, raising the issue of the registrability of colours as trademarks. The court had to decide whether a colour itself may be unique about particular goods or services. According to the ECJ's ruling, the registration was not approved, reiterating the Sieckmann conditions. The two requirements for a sign to be considered a trademark were evaluated by the ECJ in its reasoning. To begin with, merely reproducing the mark—an orange rectangle with the word "orange" written next to it—on paper is insufficient because such a colour sample may fade with time and fail to meet the requirement for durability. Second, the court observed that, while colours by themselves have limited ability to communicate a clear message to the public, they could theoretically serve the "badge of origin" role. Colours mark registrable in India.

Sound Marks

When it comes to trademark recognition, sound is quite important. Compared to other non-conventional marks, sound marks have been more easily incorporated into the Indian legal system. In the case of *Shield Mark BV v. Joost Kist*,⁶⁵ the court held that Article 2 of the Trade Mark Directives must be construed to suggest that sounds can constitute a trademark, provided that they can be represented graphically and that the directive does not prohibit sound markings per se. The court further established that if the "sign is represented by a stave divided into measures and showing, in particular, a clef, musical notes and pauses

⁶¹ *Ralf Sieckmann V. German Patent office Case C-273/00 ECJ, 2002.*

⁶² *Id.*

⁶³ *Ceipi Centre et al., Centre d ' Études Internationales de la Propriété Intellectuelle HOW TO OVERCOME THE CHALLENGES DRESSED BY THE REQUIREMENTS OF GRAPHICAL REPRESENTATION AND (2013).*

⁶⁴ *LibertelGroep BV V. Benelux- Markenbureau, Case C- 104/01, ECJ, 2003.*

⁶⁵ *Shield Mark BV V. Joost Kist Case C-283/01, ECJ, 2003.*

whose form conveys the relative value and, where necessary, accidentals". Regarding India, sound marks have been recognized when they are represented as musical notes, submitted to the registry in MP3 format at registration, and recorded on a medium that enables simple and audible replaying in conjunction with a musical notation on paper⁶⁶.

5. Conclusion

We have substantiated that there is a lack of law or guidance regarding the registration of non-conventional trademarks in India. The Trademark Act of 1999 contained the terms of graphical representation; this provision was contained in the old Trademark and Merchandise Act of 1958. This law has so far followed the EU's approach. In India, any mark must be reduced to paper form in order to be deemed graphically representable. This is according to the Trade Mark Act of 1999 and the Trade Mark Rules of 2017, both stipulations followed by EU trademark law. Even with the progress made in incorporating colour, shape, and sound marks, the criterion is strict. The recent reduction of the graphical representation criteria by the EU has no practical impact on the registration of non-traditional trademarks. The redesigned EU registration procedure continues to provide challenges for marks that, in the past, did not meet the graphical representation criterion. The graphical representation requirement was changed in this regard, but the improvements made by the EU Trademark Reform Package are more peripheral than it seems.

The new EU regulations aim to simplify the registration procedure while encouraging the registration of non-traditional marks by laying out specific guidelines for their graphical portrayal. For example, the laws governing the registration of olfactory or gustatory markings continue to be murky in many areas. Even if trademark protection has expanded thus far, the openness of the concept still needs to be understood and put into effect outside of the statutory text. We conclude from the various observations stated here that more legal provisions in Indian law are required to accommodate non-conventional trademarks, particularly given the rapidly evolving technical landscape around trademark registration.

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