

A New Dimension of Distinctiveness: Legal Frameworks Governing Unconventional Marks

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<b>KEYWORDS</b> <i>Trademarks, Symbols, Non-Traditional Marks, United States, European Union, Distinctiveness.</i> ..	<b>ABSTRACT</b> In the evolving landscape of branding and marketing, traditional trademarks such as words, logos, and symbols are no longer the only tools for brand recognition. Businesses now seek to distinguish their products through unconventional trademarks, including sounds, scents, colors, holograms, and even motion. This paper critically analyzes the legal frameworks governing such non-traditional marks in India and compares them with international regimes, particularly in the United States and the European Union. It highlights the challenges surrounding registration, distinctiveness, and enforcement, and explores the scope of legal reform to accommodate the dynamic nature of modern brand identity.
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1. INTRODUCTION

Trademarks serve the fundamental purpose of identifying the source of goods or services and distinguishing them from those of others. However, the modern marketplace is shifting towards more sensory and immersive branding experiences. This shift has prompted businesses to adopt unconventional marks, leading to a demand for a more flexible legal framework that goes beyond traditional visual identifiers. The concept of trademarks has traditionally revolved around conventional identifiers such as words, logos, symbols, and designs visual signs that distinguish the goods or services of one entity from another. Rooted in the principles of consumer protection and brand identity, trademark law aims to prevent confusion in the marketplace, protect brand reputation, and reward innovation and goodwill built over time. However, the dynamics of commerce, branding, and consumer perception have dramatically evolved in recent decades. In a saturated global market, companies are constantly seeking innovative and immersive ways to stand out. This has led to the emergence of unconventional or non-traditional trademarks, which go beyond the visual and textual touching upon other sensory dimensions such as sound, scent, shape, motion, color, and even taste. The growing importance of sensory marketing and brand experience has significantly influenced the role of trademarks in modern commerce. Brands now strive to create a multi-sensory identity that resonates emotionally with consumers, fosters recall, and enhances loyalty. For instance, the iconic MGM lion’s roar, the scent of Play-Doh, or the distinctive shape of the Coca-Cola bottle are not merely aesthetic or functional elements—they are strategic assets in brand recognition and differentiation.

This transformation in branding practices has put pressure on existing legal frameworks, which were predominantly designed for traditional marks. The shift from text and image to sound and smell has created complex challenges in terms of registrability, representation, enforceability, and legal interpretation. Key concerns include the requirement of graphical representation, the ability to define the scope of protection, and the subjective nature of some unconventional marks that resist easy categorization. While international trademark regimes have started recognizing and adapting to these developments albeit cautiously India’s legal infrastructure remains relatively underdeveloped in this respect. Although the definition of "trademark" under the Trademarks Act, 1999 is broad enough to theoretically encompass unconventional marks, in practice, the Indian Trademark Registry has adopted a conservative approach, recognizing only a limited subset, such as sound marks, and even then, in very few cases.

This research paper aims to explore and critically analyze the legal frameworks governing unconventional trademarks,.



focusing on the Indian context while drawing comparisons with international practices in jurisdictions such as the United States and the European Union. It delves into the nature of these marks, the challenges they pose in terms of registration and enforcement and evaluates whether existing laws are equipped to accommodate the evolving nature of brand identity. The paper concludes with recommendations for legislative and procedural reforms that could enable Indian trademark law to embrace this new dimension of distinctiveness. In the era of global consumerism, trademarks have become much more than mere commercial symbols they are powerful vehicles of brand identity, consumer loyalty, and corporate goodwill. Traditionally, trademarks were understood to consist of visual representations such as names, logos, slogans, or labels. These conventional marks have long served the essential function of identifying the source of goods or services, helping consumers make informed choices, and protecting businesses from unfair competition. However, with the increasing sophistication of marketing strategies and the advent of sensory branding, companies now seek to create more immersive and emotionally resonant brand experiences. As a result, there has been a marked shift from conventional visual marks to unconventional or non-traditional marks which include sound, scent, taste, touch, shape, motion, color, holograms, and even position marks. These types of marks engage consumers beyond the visual sense, appealing to auditory, olfactory, tactile, and other perceptual dimensions, thus creating a multi-sensory brand experience.

This evolution poses a fundamental challenge to traditional trademark jurisprudence: How do legal systems that were originally designed to protect static, visual identifiers accommodate marks that are non-visual, subjective, and often abstract? What does *distinctiveness* mean in the context of a color or a sound? How can such marks be represented graphically, and how do we determine the boundaries of protection? These questions strike at the core of trademark theory and practice, raising complex issues of registrability, enforceability, consumer perception, and public interest. Internationally, trademark regimes are slowly adapting to this shift. For instance, the United States, through the Lanham Act and landmark decisions like *Qualitex Co. v. Jacobson Products*, has recognized color and sound as valid trademarks under certain conditions. The European Union, following the 2017 amendment to its Trademark Regulation, has relaxed the requirement of graphical representation, allowing digital submissions such as MP3s and MP4s to support non-traditional marks. Meanwhile, WIPO has actively encouraged member states to modernize their trademark systems to accommodate a broader spectrum of brand identifiers.

In India, however, the adaptation has been more cautious and limited. Although the definition of a "trademark" under Section 2(1)(zb) of the Trade Marks Act, 1999 is worded broadly enough to theoretically include non-traditional marks, practical implementation remains restrictive. The Indian Trademark Registry, while having made minor procedural adjustments such as allowing sound mark filings in the Trademarks Rules, 2017 has yet to embrace the full range of unconventional marks in registration or enforcement. Most applications for such marks are either not accepted, not encouraged, or are left to judicial interpretation on a case-by-case basis. This lag is particularly concerning in the context of a rapidly digitizing and globalizing Indian market, where brand value is increasingly tied to experience and engagement. As Indian businesses seek to compete on a global stage and international brands continue to expand into India, the absence of a comprehensive legal framework for unconventional marks may hinder innovation, brand building, and fair competition.

Therefore, this paper seeks to undertake a critical and comparative analysis of the legal frameworks governing unconventional trademarks, with a special focus on India. It will examine the conceptual underpinnings of non-traditional marks, the criteria for their protection, and the institutional and procedural challenges involved in their recognition. Further, it will assess the Indian legal system's readiness to respond to this shift and propose recommendations for reform based on international best practices. By addressing these issues, the paper contributes to the growing discourse on how trademark law must evolve to reflect the realities of modern branding and consumer behaviour where the next frontier of distinctiveness may not be seen, but heard, felt, or even smelled.

### ***Unconventional Marks***

The evolution of branding strategies in the 21st century has given rise to what are now termed as unconventional or non-traditional trademarks those which move beyond traditional representations such as names, logos, or symbols, and utilize other sensory, spatial, or multimedia elements to perform the core trademark function: distinguishing the goods or services of one entity from those of another. At the heart of this concept lies a broader understanding of distinctiveness the ability of a mark to be uniquely associated with a particular source in the minds of consumers. As branding becomes increasingly experiential and consumer preferences are shaped by a variety of sensory cues, the law must grapple with the reality that trademarks are no longer confined to what can be seen or read. Unconventional marks represent an expanded horizon for brand protection, reflecting the changing landscape of consumer engagement and technological advancement. However, their legal recognition remains patchy and jurisdiction dependent. The key challenge lies in balancing innovation with legal certainty, ensuring that these marks are not only registerable but also enforceable while safeguarding the interests of consumers and competitors. This growing category of trademarks pushes traditional legal concepts to evolve, particularly in areas like distinctiveness, graphical representation, functionality, and consumer perception. In the following sections, we will examine how jurisdictions like India, the United States, and the European Union have attempted to navigate this complex and rapidly developing area of trademark law.

***Unconventional marks typically include the following categories:***



### ***Sound Marks***

A sound mark is a trademark where sound performs the role of a source identifier. Sound marks are typically short and distinctive audio elements, such as jingles or musical signatures, that are immediately associated with a brand. Examples: The Intel chime, Nokia ringtone, MGM lion's roar. The Indian Trademarks Rules, 2017, expressly allow the submission of sound marks in MP3 format with a graphical representation in musical notation. The challenges is proving distinctiveness, especially for common or musical elements, preventing functional or descriptive use.

### ***Scent/Olfactory Marks***

Scent marks involve the use of smell as a means of identification. They are among the most difficult types of unconventional marks to protect due to subjectivity and issues with representation and permanence. Examples: A floral fragrance for sewing thread (registrable in the U.S.); a scent of fresh-cut grass for tennis balls (attempted registration in EU). The Challenge is lack of uniform method for graphic representation; varying perception among individuals; volatility and shelf-life of scents; functionality doctrine.

### ***Color Marks***

A color or a combination of colors can serve as a trademark if it has acquired secondary meaning and is not functional. Examples: Tiffany & Co.'s robin egg blue; Louboutin's red sole (limited scope in some jurisdictions). Legal Tests- The color must not be essential to the use or purpose of the product and must not affect cost or quality (functionality doctrine). Indian Position: No statutory bar; however, few successful registrations due to high threshold of distinctiveness.

### ***Shape/Three-Dimensional Marks***

These marks protect the shape or configuration of a product or its packaging, provided that the shape is distinctive and not purely functional. Examples: Coca-Cola contour bottle, Toblerone chocolate bar shape. Indian Law recognizes 3D marks under Section 2(1)(m) of the Trademarks Act, 1999; however, courts remain cautious, often rejecting marks that appear functional or generic.

### ***Motion Marks***

Motion marks are composed of moving images or animations that identify the commercial origin of goods or services. These are particularly relevant in digital media and advertising. Examples: The animated Pixar lamp; Lamborghini's upward-swinging car doors (attempted). It is difficult to graphically represent in static form; may require video files (MP4) and visual cues to meet representation criteria.

### ***Hologram Marks***

These consist of images or effects that change when viewed from different angles, using holographic technology. They are futuristic and rare but hold branding potential in luxury goods and tech products. There is lack of mechanisms to depict changes in angle and perspective in a static application format.

### ***Taste Marks***

Although the idea of registering a taste as a trademark is conceptually intriguing, it is legally contentious. Taste is subjective and depends on the interaction of multiple senses. Additionally, taste is often considered inherently functional in consumable products. In *Libertel Groep v. Benelux-Merkenbureau*, the EU clarified that taste marks pose significant problems for representation and objectivity. (India: No recognition or filing system in place).

### ***Touch/Texture Marks***

These marks rely on the feel or texture of a product or its packaging to create brand recognition. While uncommon, they can be relevant for high-end goods like leather, textiles, or packaging. Examples: Velvety or rubberized coatings; embossed surfaces. High subjectivity; practical difficulty in filing and comparing textures; lack of a standardized medium for representation.

### ***Position Marks***

A relatively newer category, these marks protect the specific placement of a mark on a product rather than the mark itself. Examples: The red sole applied only to the underside of a high-heeled shoe (Louboutin); Levi's red tab on jeans. It is relevant in use in fashion and luxury sectors; requires consistent use and consumer recognition.

### ***Multimedia Marks***

These include combinations of sound, motion, and visual effects that together form a single, cohesive source identifier. Examples: Startup animations with accompanying jingles (e.g., Netflix "ta-dum" sound and visual flash). Recently accepted in the EU; India has not formalized procedures yet.

### ***The Legal Framework in India***

India's trademark law is governed primarily by the Trademarks Act, 1999, which aligns broadly with international standards



and fulfills obligations under the TRIPS Agreement. While the Act provides a relatively broad definition of a “trademark,” the actual recognition, registration, and enforcement of unconventional marks within the Indian legal framework remain limited and underdeveloped. While the Trademarks Act, 1999 and Rules, 2017 provide a theoretical foundation for the recognition of unconventional marks, India’s legal and administrative ecosystem has not evolved in step with market realities. The limited recognition of sound and shape marks a tentative beginning, but for Indian trademark law to support modern branding strategies, it must go further. A comprehensive reform—including procedural rules, examination manuals, and judicial training is urgently required to ensure that Indian law keeps pace with global developments and supports the innovation economy. In the next section, we will explore how leading jurisdictions such as the United States and the European Union have approached these issues, offering models and insights for India to consider. This section critically analyzes how the Indian legal system currently accommodates unconventional trademarks, with a focus on statutory provisions, procedural aspects, judicial trends, and gaps in regulatory practice.

### ***Statutory Framework: Broad in Text, Narrow in Practice***

Section 2(1)(zb) of the Trade Marks Act, 1999 defines a trademark as:

“...a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others...”

The term “mark”, as defined in Section 2(1)(m), includes:

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

This broad wording opens the door to recognition of non-traditional marks like shape, color combinations, and packaging, and theoretically allows for the inclusion of more novel categories such as sound, motion, or even scent marks.

However, two major statutory requirements limit the scope for unconventional mark registration:

Graphical representation: The requirement that a mark must be capable of being graphically represented acts as a significant barrier for non-visual marks such as scents, tastes, and certain sounds. And distinctiveness: The mark must be inherently distinctive or capable of acquiring distinctiveness through use. Proving this for unconventional marks is challenging without long-standing and widespread consumer recognition.

### ***Trademark Rules, 2017: A Step Forward***

The Trademarks Rules, 2017, marked a progressive step by explicitly recognizing sound marks for the first time in India. Rule 26 provides that: A sound mark application must include a sound clip in MP3 format, not exceeding 30 seconds and it must also include a graphical representation of the sound in musical notation. This allowed the Indian Trademark Registry to accept sound marks from applicants such as Yahoo! (yodel) and ICICI Bank’s jingle, both of which were successfully registered. Despite this development, no similar procedural mechanism exists for other types of unconventional marks, such as:

- Motion (animation) marks
- Scent or taste marks
- Holograms
- Texture or position marks

This lack of procedural clarity discourages both legal practitioners and brand owners from pursuing registration of such marks in India.

### ***Registry Practice and Administrative Interpretation***

While the statutory language seems inclusive, the Indian Trademark Registry has taken a conservative approach in practice. The Registry’s primary focus remains on conventional word marks, logos, and composite visual marks. A review of published trademarks in the Trademarks Journal shows very few, if any, successful registrations for unconventional marks beyond sound and 3D shapes. Even within the scope of shape marks, the Registry often invokes the functionality doctrine refusing registration if the shape contributes to the functional utility of the product. This is consistent with Section 9(3) of the Trademarks Act, which bars registration of shapes: that result from the nature of the goods; that are necessary to obtain a technical result and that give substantial value to the goods. These restrictions, while rooted in consumer protection and competition policy, create a high bar for businesses attempting to register product configurations or packaging as trademarks.

### ***Judicial Interpretation: Few Precedents, Conservative Outlook***

Indian courts have not had extensive opportunity to interpret unconventional marks. However, existing judgments reveal a cautious and doctrinally rigid approach:

In *Colgate Palmolive Company v. Anchor Health & Beauty Care Pvt. Ltd.* (2003), the Delhi High Court considered trade



dress and packaging but emphasized the need for *distinctiveness* and *consumer association*. In *Toblerone's attempted registration* of its triangular chocolate bar shape, the Registry rejected the application, invoking functionality and lack of distinctiveness. Courts have occasionally shown openness to *trade dress* protection under the common law of passing off, especially in cases involving packaging or get-up, but such protection is still narrower compared to what statutory registration could offer.

### ***Enforcement Challenges***

Even when unconventional marks are registered, enforcing rights remains difficult: Proof of Use i.e. establishing genuine use in commerce for non-visible marks like sound or scent is procedurally complex and consumer perception i.e. courts and enforcement agencies require evidence that the average consumer associates the unconventional feature with a particular source also, Judicial Familiarity i.e. many judges and enforcement authorities are unfamiliar with the nuances of non-traditional marks, leading to inconsistent or hesitant rulings. Additionally, India lacks specialized guidelines or examination manuals for evaluating unconventional marks, unlike the EUIPO or USPTO.

### ***Comparative Gaps and the Need for Reform***

Compared to jurisdictions like the United States (under the Lanham Act) and the European Union (post-2017 Trademark Regulation), India's framework is still in its nascent stage. While the global trend is moving toward greater inclusivity and flexibility dropping graphical representation requirements, adopting digital submissions, and allowing broader forms of distinctiveness India has not yet updated its laws to reflect this transformation.

Some of the key gaps include: Absence of provisions for scent, taste, motion, or hologram marks, lack of digital-friendly submission formats beyond sound, no clear guidance on how to examine and determine distinctiveness for non-traditional marks, absence of judicial and administrative precedent to create a consistent body of law etc.

### ***Comparative International Analysis: Global Approaches to Unconventional Trademarks***

As unconventional marks increasingly become tools of brand differentiation in global markets, jurisdictions around the world have been compelled to rethink the scope of trademark law. While some countries have proactively expanded their legal and administrative frameworks to accommodate non-traditional marks, others remain cautious, often prioritizing administrative convenience and doctrinal conservatism over market innovation.

This section undertakes a comparative analysis of the approaches adopted by the United States, the European Union, and select common law jurisdictions like Australia and the UK, highlighting their progress, procedural models, and jurisprudential trends in contrast to the Indian position.

#### ***United States: Expansive Interpretation Under the Lanham Act***

The United States has been one of the earliest adopters of unconventional trademarks, thanks to the flexible wording of its governing statute, the Lanham Act. No graphical representation requirement: A mark must be capable of distinguishing the applicant's goods/services and must be perceived as a mark by the public. Sound, scent, color, and even motion marks are registrable. The USPTO's Trademark Manual of Examining Procedure (TMPE) provides detailed guidelines for examiners handling unconventional marks.

**Cases wherein registration was granted:** *NBC's chimes* were the first registered sound mark (1947) for sound, *Scent of plumeria blossom in sewing thread* (In re Clarke, 1990), *Qualitex Co. v. Jacobson Products Co., Inc.* (1995) US Supreme Court held that a single color can be registered if it acquires secondary meaning, registration granted to leather texture for book covers, touch (Knightsbridge Collection). US courts emphasize "acquired distinctiveness" and non-functionality, making it a relatively flexible but still well-regulated space. Motion and multimedia marks can be submitted as video clips, with accompanying textual descriptions.

#### ***European Union: Modernization and Removal of Graphical Representation Requirement***

The EU Trade Mark Regulation (EUTMR), amended in 2017, made a landmark change by removing the requirement for graphical representation, thus acknowledging the technological evolution of trademark filings. It accepts audio, video, and multimedia files for unconventional marks, uses "what you see is what you get" principle: the mark must be clear, precise, self-contained, and objective. The EUIPO Guidelines provide detailed technical requirements and formats (e.g., MP3 for sound, MP4 for motion).

#### **Accepted Categories:**

- Sound: Intel's five-note jingle.
- Motion: Sony Ericsson's animation.
- Hologram: Registered in several tech and cosmetic products.
- Color: Christian Louboutin's red sole (protected as a position mark with color limitation).





- Pattern, position, multimedia: Explicitly recognized and codified.

However, Scent and taste marks have faced rejection due to subjectivity and lack of consistent representation methods (e.g., *Sieckmann v. Deutsches Patent- und Markenamt*).

#### ***United Kingdom: Post-Brexit Continuity with EU Practice***

Despite Brexit, the UK Intellectual Property Office (UKIPO) has largely retained the EU's modernized approach. Graphical representation is not required; the focus is on clarity and objectivity. It accepts digital files for sound and motion marks, allows position and multimedia marks with precise descriptions. Color marks require extensive evidence of acquired distinctiveness. The UK courts have taken a cautious but open stance on unconventional marks, often emphasizing public perception and market context.

#### ***Australia: Balancing Innovation with Regulatory Clarity***

Australia's Trademarks Act 1995 provides a liberal definition of trademarks, which includes shape, color, sound, and scent. Marks must be capable of being represented in a manner that enables examination, publication, and clarity. Digital files are permitted, and the IP Australia Manual outlines procedures for unconventional marks. In *Philmac Pty Ltd v The Registrar of Trademarks* -denied a scent mark due to lack of consumer association. *BP's green color for fuel stations*-allowed after showing acquired distinctiveness.

#### ***Doctrinal Challenges in Recognizing Unconventional Marks***

While the legal infrastructure in several jurisdictions has begun to accommodate unconventional trademarks, the theoretical and doctrinal foundation of trademark law still poses significant challenges. These difficulties stem from the traditional understanding of what a trademark is, how it functions, and the philosophical balance between private rights and public interest. This section explores the doctrinal hurdles in recognizing unconventional marks, focusing on core principles such as distinctiveness, functionality, graphical representation, consumer perception, and public domain considerations.

#### ***The Principle of Distinctiveness***

At the heart of trademark law lies the principle that a mark must distinguish the goods or services of one entity from those of another. While this is relatively straightforward for traditional marks like names, logos, and slogans, unconventional marks present unique challenges:

##### ***a. Inherent vs. Acquired Distinctiveness***

Most unconventional marks are not inherently distinctive. For instance, a scent or a shape is usually perceived as a functional or aesthetic feature rather than a source identifier.

This requires evidence that consumers associate the mark exclusively with the source. However, proving this for non-visual marks like sounds, colors, or textures often requires costly surveys, long-term use, advertising data, and public recognition—creating a high barrier for most applicants.

##### ***b. Ambiguity in Distinctiveness Tests***

Courts and registries struggle with consistency in applying distinctiveness tests. What constitutes “distinctive” in one jurisdiction may fail in another. In unconventional marks, consumer perception becomes speculative and context-dependent, making doctrinal clarity difficult.

A long-standing principle in trademark law is that functional features cannot be protected as trademarks. This ensures free competition by preventing monopolies over useful product features. What is “Functional”? A feature is functionally barred if it: Is essential to the use or purpose of the product, affects cost or quality, or Is dictated by technical necessity.

For example: The shape of a bottle that makes it easier to grip may be functional, the scent of perfume that forms a core selling point is functional.

*Overlap with Patent Law:* Many unconventional marks, particularly shapes, colors, or packaging sit uncomfortably at the intersection of trademark and patent law. Trademark law offers potentially perpetual protection, unlike patents which are time-limited. Granting trademark protection over a functional design feature may amount to an unfair extension of monopoly.

#### ***Subjectivity in Functionality Analysis***

The analysis of whether a mark is functional often involves subjective judicial discretion, especially in shapes or colours. There is no consistent test across jurisdictions, leading to unpredictability in registration and enforcement.

#### ***The Graphical Representation Requirement***

One of the most contested doctrinal hurdles, particularly in jurisdictions like India—has been the requirement that a trademark must be graphically representable.

Graphical representation ensures that: The mark is clearly defined, it can be published, searched, and examined and rights



can be clearly demarcated to third parties. Limitations for Non-Visual Marks, Sound: Musical notation may not accurately capture tones or voice modulation, Scent: There is no universally accepted method to graphically represent smells and motion or Holograms: Static images fail to convey movement or 3D effects.

The EU's removal of the graphical representation requirement in 2017 marked a doctrinal shift toward technological neutrality. However, India and many common law countries still retain this requirement, preventing expansion of trademark law into sensory dimensions.

### ***Consumer Perception and Evidence Standards***

Trademark rights depend heavily on how the relevant public perceives the mark. But with unconventional marks:

#### ***a. Measuring Perception Is Complex***

There are no straightforward ways to measure how consumers identify a source through scent, texture, or taste. Evidence usually requires expert surveys, market studies, and extensive marketing campaigns—resources that are not accessible to smaller businesses.

#### ***b. Varying Standards Across Jurisdictions***

The US uses consumer survey evidence more flexibly, EUIPO and UKIPO often rely on objective standards and public interest analysis and Indian courts rarely admit or assess such consumer studies in detail for trademark cases. Unconventional marks often derive from features freely available in nature or common in trade, raising concerns about appropriation of public domain elements. Many industries use standard color codes (e.g., red for emergency, green for environment). Over-protection may limit freedom of communication, protecting natural or widely used fragrances could unfairly block market access. Ordinary shapes that serve functional purposes (e.g., a rectangle for a smartphone) should remain free for all to use. Courts must balance brand identity protection against market freedom and consumer choice, which is particularly difficult with unconventional marks. In many jurisdictions, especially India, courts and examiners lack exposure to unconventional marks. Challenges can be judicial unfamiliarity which may lead to conservative judgments and reliance on rigid doctrines. Examining officers are not trained to assess distinctiveness or non-functionality in complex or sensory-based marks and absence of case law causes uncertainty for applicants and IP professionals

### ***Judicial and Administrative Treatment of Unconventional Marks***

This section examines landmark cases and registration attempts across various jurisdiction especially India, the United States, and the European Union to demonstrate how courts and trademark offices have dealt with unconventional marks. The case studies shed light on practical issues such as the threshold for distinctiveness, evidentiary standards, examiner discretion, and consumer perception.

#### ***India: Emerging Attempts and Institutional Reluctance***

Although India introduced recognition of sound marks in 2017 and permits registration of color and shape marks, the practical success rate remains low, largely due to strict evidentiary requirements and procedural conservatism.

*Yahoo! Sound Mark* - Yahoo Inc. filed for the registration of its distinctive three-note "Yahooooo!" yodel under sound mark category. It was successfully registered as one of India's first officially accepted sound marks. Set a precedent for accepting sound marks under Rule 26(5) of the Trademark Rules, 2017. Yahoo's long-standing market presence, global branding, and strong advertising evidence were critical to proving distinctiveness.

*Zippo Lighter Shape Mark*- Zippo Manufacturing sought to register the unique rectangular shape of its flip-top lighters. Registration was denied. The shape was held to be functional, aiding in grip and usability—hence not eligible under Section 9(3) of the Trademarks Act, 1999. Demonstrates the application of the functionality doctrine in India and the challenges shape marks face.

#### ***United States: Expansive Interpretation and Precedent-Setting Cases***

The USPTO has accepted numerous unconventional marks, aided by liberal statutory interpretation and a robust body of precedent.

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

Issue: Whether a single color (green-gold) used on dry-cleaning press pads could be trademarked.

Ruling: U.S. Supreme Court held that color alone could be protected if it acquired secondary meaning. Landmark ruling that opened doors for color trademarks across industries. Affirmed that color could serve a source-identifying function when not functional.

*In re Clarke, 17 USPQ2d 1238 (TTAB 1990)*- Applicant sought to register a scent of plumeria blossoms for sewing thread and embroidery yarn. Registration was approved. First-ever registration of a scent mark in the U.S. The case emphasized non-functionality and distinct consumer recognition of scent as a brand identifier.



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### ***European Union: Technological Shift but Jurisprudential Restraint***

The EU, despite removing the graphical representation requirement, has shown judicial restraint especially in sensory-based marks.

***In Sieckmann v. Deutsches Patent- und Markenamt (C-273/00, ECJ, 2002)***- Mr. Sieckmann attempted to register a scent described in chemical terms and accompanied by a physical sample. Scent- “Balsamically fruity with a slight hint of cinnamon.” *Court* rejected the application. The scent failed the Sieckmann criteria: clarity, precision, objectivity, durability. It Effectively barred scent marks in the EU until technological representation standards evolve. The case introduced the "Sieckmann Seven Criteria" for representability, which influenced EU and global trademark law.

### ***In Louboutin’s Red Sole Case (CJEU, 2018)***

Issue: Whether the red sole of high-heeled shoes was a valid trademark or a functional design.

Ruling CJEU ruled that the color positioned on a part of the product (sole) could be trademarked and was not purely functional. It reinforced the concept of position marks and confirmed that color, if distinctive and non-functional, could be protected.

## **2. CONCLUSION**

The evolution of trademark law into the realm of unconventional marks signifies a major shift in the way brand’s express identity in the modern marketplace. As commerce becomes more sensory, immersive, and experiential, traditional notions of trademarks limited to names, logos, or symbols no longer suffice. Brands today seek to protect not only what consumers see or read but also what they hear, smell, touch, and even taste. This transformation, however, challenges the foundational doctrines of trademark law. The paper has explored the conceptual scope, legal framework, and doctrinal challenges surrounding unconventional marks, with a special focus on the Indian legal context. While international jurisdictions such as the United States and the European Union have pioneered mechanisms to accommodate these new forms of marks often supported by a robust jurisprudential and evidentiary ecosystem—India still finds itself at a nascent yet promising stage. Through comparative analysis and case law exploration, it becomes evident that the recognition of unconventional marks demands a delicate balance between private rights and public interest. Without adequate doctrinal clarity and legislative support, attempts to register such marks may result in legal uncertainty, monopolization of functional features, or stifling of fair competition. India’s journey toward recognizing unconventional marks is commendable but incomplete. A progressive and technology-sensitive legal environment is essential for embracing the next dimension of distinctiveness one that goes beyond sight and words into a full spectrum of human sensory perception. To establish a robust and inclusive regime for unconventional trademarks, India must undertake a combination of legislative, administrative, and judicial reforms like amend the Trademarks Act to Remove the Graphical Representation Requirement. Section 2(1)(zb) still implies a need for visual representation, which bars marks like scents, tastes, and motion. The definition of "trademark" should be amended to allow “perceivable and identifiable” marks using digital or sensory-compatible formats, following the EU’s 2017 reforms. It may open up registration possibilities for sound, scent, motion, and multimedia marks, Issue Specific Guidelines for Unconventional Marks, draft and notify detailed practice manuals or examination guidelines specific to sound marks, color and shape marks as well as motion, scent, hologram, texture marks. Clearly define criteria for distinctiveness, non-functionality, and evidence. This would reduce discretion-based inconsistencies and empower examiners and applicants with clarity. Build Examiner Capacity and Sensory Assessment Infrastructure, Training the Trademark Registry officials in technical evaluation of unconventional marks, create partnerships with institutions for scientific testing labs, sound libraries, and digital evidence standards, equip examiners with tools to assess non-visual representations (e.g., waveform readers, olfactory standards, motion clips). Introduce Flexible Evidentiary Standards, accept alternate forms of representation: Sound files (e.g., MP3), digital video, chemical formula with scent samples and textural swatches, allow market surveys, expert opinions, and consumer perception studies as legitimate evidence of acquired distinctiveness. Encourage Judicial Precedents and IPAB Special Benches, promote special IP benches or tribunals (e.g., within the IP Division of the Delhi High Court) to adjudicate unconventional mark disputes, encourage the development of Indian jurisprudence through detailed reasoning, referencing international benchmarks, and setting authoritative precedents. Promote Awareness and Stakeholder Engagement, launch awareness campaigns among startups, MSMEs, design firms, and advertising agencies about the potential of non-traditional brand protection and involve IP lawyers, judges, and industry stakeholders in policy consultations to ensure balanced reform. Create a Public Repository of Registered Unconventional Marks, establish a searchable database of registered sound, color, shape, and other non-traditional marks in India, and improve transparency and assist applicants in conducting effective clearance searches. Unconventional marks represent the next frontier of brand communication in a digital and sensorial age. If India aspires to be a global IP leader, it must move beyond traditional boundaries and embrace this new dimension of distinctiveness with clarity, openness, and innovation.





## REFERENCES

- [1] The Trade Marks Act, No. 47 of 1999, § 2(1)(zb) (India).
- [2] Trade Marks Rules, 2017, Rule 26(5), Gazette of India, Part II, Sec. 3(i) (India).
- [3] Council Regulation (EC) No. 207/2009 of 26 Feb. 2009 on the Community Trademark, 2009 O.J. (L 78) 1 (as amended).
- [4] Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 Dec. 2015 Amending the Community Trade Mark Regulation, 2015 O.J. (L 341) 21.
- [5] Qualitex Co. v. Jacobson Prods. Co., 514 U.S. 159 (1995).
- [6] In re Clarke, 17 U.S.P.Q.2d (BNA) 1238 (T.T.A.B. 1990).
- [7] Christian Louboutin v. Van Haren Schoenen BV, Case C-163/16, EU:C:2018:423.
- [8] Ralf Sieckmann v. Deutsches Patent- und Markenamt, Case C-273/00, EU:C:2002:748.
- [9] Yahoo! Inc., Trademark Application No. 1270400, Indian Trade Marks Registry.
- [10] Zippo Manufacturing Co., Trademark Application (India) – Rejection under functionality grounds. (Unpublished, Registry Order).
- [11] Irene Calboli, Color, Shape, and Scent as Non-Traditional Trademarks: How far Should We Go?, 92 Trademark Rep. 101 (2002).
- [12] Dev Gangjee, Non-Conventional Trademarks and the Trouble with Functionality, 3 I.P.Q. 288 (2011).
- [13] David C. Hilliard & Alan R. Thiele, Protection of Product Configuration and Design Features: Trademark and Trade Dress Law, 87 Trademark Rep. 254 (1997).
- [14] P. Narayanan, Law of Trade Marks and Passing Off (6th ed. 2017).
- [15] J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition (5th ed. 2023).
- [16] World Intellectual Property Organization (WIPO), Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications: Non-Traditional Marks, WIPO Doc. SCT/25/4 (2011), <https://www.wipo.int>.
- [17] European Union Intellectual Property Office (EUIPO), Guidelines for Examination of EUTMs – Non-Traditional Marks, <https://euipo.europa.eu>.
- [18] Indian Trade Marks Registry, Manual of Trade Marks Practice and Procedure, <https://ipindia.gov.in>.
- [19] U.S. Patent & Trademark Office, Trademark Manual of Examining Procedure (TMEP), <https://tmep.uspto.gov>.
- [20] Shwetank Upadhyay, Unconventional Trademarks in India: The Legal Landscape, SpicyIP (Oct. 15, 2021), <https://spicyip.com>.

