REGISTRABILITY OF SMELL MARK AS TRADEMARK: A CRITICAL ANALYSIS

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ABSTRACT

With each passing day the ambit of trademark protection law is being expanded everywhere throughout the world. The progress and advancement in the area of trademark which has been observed these days covers the heading ‘non-conventional trademarks’, examples being smell, sound, taste etc.

Different countries hold different viewpoints when it comes to the registrability of smell marks. Even though many countries have explicitly barred the registration of such trademarks which lacks words or is incapable of graphical representation, it has been observed that some common law countries permits the registrability of smell marks. But for now whether scent marks are eligible for registration as trademarks is still controversial and arguable.

For the purpose of this article, these copies restricted to smell marks only. This paper deals with three major aspects. To begin with it analyses the international position of smell marks. It further focuses on the arguments advanced for and again registrability of smell marks, and finally concludes by presenting with a critical analysis based on the research conducted.

When we speak of critical analysis of smell mark registration it denotes that even though at first scent marks seem to be novel way of differentiating goods and services but it is not feasible keeping in mind the subjective character of human sense of smell.

Keywords: Trademark; Smell Mark; Intellectual Property Rights; Registrability of Smell Mark
INTRODUCTION

With the rapid advancement of technology and increase in competition, companies and businesses in this epoch hugely rely for the marketability of their products on the different senses of the consumer like smell taste sound etc. Smell, one of such faculties, has dependably been one of the most fundamental which people have depended upon in their everyday exercises. Studies have indicated how a specific odor can trigger one's memory, influence one's state of mind and obviously influence organizations to acquire millions.¹

‘Trademark’ as defined under the Trademark Act, 1999, in India and foreign enactments is to a great extent broad and extensive. These provisions goes ahead to demonstrate that to hold a specific level of adaptability to take into consideration improvement in the ambit of trademark ability, the law makers proposed such wide provisions.² The definition of trademark being a symbol, word, or words, which is capable of distinguishing the goods and services of one manufacturer from those of another and can be graphically represented, is similar to the definition given by the TRIPs Agreement-

“All sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark”.”³

Despite the repeated use of these non-conventional marks in the global market, it lacks a universal validation owing to the existence of territory wise registration. But at the same time one of the most imperative changes has been introduced by these modern trademark forms in the present trademark law along with the constant struggle for the law makers to guarantee a balance between development intellectual property laws and technological improvements and that they are at par with one another.⁴

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³Article 15 (1) TRIPS Agreement.
⁴Garry Trillet, Registrability of smell colour and sounds: how to overcome the challenges dressed by the requirements of graphical representation and distinctiveness within European Union Law.
CONCEPT OF TRADEMARK

According to Section 2(1) (m) of the Trademark Act, 1999- "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”. The Act further goes on to define “trademark” in section 2(1) (zb) 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 and may include shape of goods, their packaging and combination of colours”.

The definition of trademark provided under the TRIPs Agreement is analogous to the above given definition which provides that ‘any sign or any combination of signs, capable of distinguishing the goods or services if one undertaking from those of other undertakings, shall be capable of constituting a trademark.”

Trademark can be classified into two categories: conventional or traditional and non-conventional or modern trademarks. Trademark is, commonly, associated to words, names, symbols or some other sign utilized for recognizable proof of merchandise and services provided by one maker. In the modern era and with the advancement in the region of trademark, a wide region of trademarks has been seen nowadays which is secured under the heading 'non-traditional trademarks', cases being smell, sound, and taste and so on.

SIGNIFICANCE OF SMELL

With the assistance of scent of any item, the same has been recognized since long. Yet the odor or smell itself didn't get a security, or even acknowledgment, as a trademark until later past. It has been discovered that the sense of smell is not only the most fundamental out of the five senses, but also greatly contributes in the daily actions than are realized. It has been evidenced by recent research that even though people interact with the world through sights and sounds but at the same time reaction is given both at the conscious and subconscious level to odors as well.

5 Section 2(1)(m), Trademarks Act, 1999
6 Section 2 (1)(zb), Trademarks Act, 1999
7 Supra note 1
An individual's sense of smell results from stimulation of the olfactory glands, at the top of the sinus cavity, which directly trigger the olfactory bulbs in the limbic system of the brain. While odors may evoke a conscious evaluation ninth cerebrum, this is not required. The olfactory gland scan and do directly trigger both memory and emotional responses. This is in sharp differentiation to the next four senses as they all invigorate region of the cerebrum, and require a conscious assessment to deliver a response. Thus, the feeling of smell has an extremely special and private control over what one does and how one lives.

It can likewise be comprehended from the way that emotions, either constructive or contrary, about individuals, places and things, may well be dictated by how they smell, and this seems, by all accounts, to be so regardless of whether there is awareness of their odor. The basic and inescapable role of scent in a large number of the today’s products features the capacity of an item's odor, not only to sell but also to recognize and differentiate. This recognizing diverse product is likewise the fundamental objective of trademark which is to be secured. Numerous jurists have that the most essential purpose of a contemporary trademark is to separate an item from others in the commercial market place.

POSITION OF SMELL MARKS: INTERNATIONAL DEVELOPMENT

The Madrid Protocol didn’t provide much on the subject matter of registration of trademark. Same was the case in the Paris Convention which focused solely on the protection of industrial property including trademarks and failed to provide the subject matter leaving an opportunity for the insertion of non-conventional marks within the scope of the trademark. Trademark Law Treaty of 1994 has expressly excluded sound and smell marks from getting registered. TRIPS maintained a neutral stand by using the word may, indicating that sound, smell can be protected under it depending upon the intention and willingness of the contracting parties.

It is undeniable that today’s market economy is in the hands of the consumers hence manufacturers prefer to be associated with the consumers more closely than ever and to do so they prefer the non-conventional marks. In order to understand the international development in the trademark regime regarding smell as marks, the author has examined the locus of smell mark as a trademark in different countries.

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8 Supra note 1
9Ibid.
The United States of America: US being the biggest capitalist economy, the basis of trademark protection in the country is to encourage competition among the traders and the same is facilitated by the Lanham Act. The Lanham Act uses the widest possible terms to describe the series of items that can qualify as trademarks.\(^\text{10}\) Although scent marks are not specifically specified in the Lanham Act, U.S. law acknowledges that scent can operate as a source identifier where it has no utilitarian function.

As per section 45 of The Lanham Act, federal statute of the USA, trademark is defined as: “The term “trademark” includes any word, name, symbol, or device, or any combination thereof:

(1) Used by a person, or

(2) Which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this Act, to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.”\(^\text{11}\)

From the above given definition, it is evident that even though smell mark is not explicitly encompassed in the definition, nevertheless it has not be barred from getting registered by virtue of the phrase or any combination thereof. For the first time, recognition to the smell marks was given by the US courts wherein the application for registering the written description of the smell of ‘a high impact, fresh floral fragrance reminiscent of Plumeria blossoms’ for sewing thread and embroidery yarn was brought before the Trademark Trial Appeal Board (TTAB) and was accepted as a graphical representation and granted trademark protection. In the Qualitex case, the US Supreme Court accredited the decision of the Board in order to grant protection to smell marks in the Clarke case. It can be said that both statutory provisions as well as judicial decisions permits registration of scent or smell marks.

European Union: Similar to Lanham Act, a wide definition of trademarks has been acknowledged by the EU directive and is unable to address scent marks clearly. As in the United States, the European Union's Office for Harmonization for the Internal Market ("OHIM") recognizes that

\(^{10}\)Julia Anne Matheson, The Sweet Smell of a Successful Registration, Finnegan (2003), Available at https://www.finnegan.com/en/insights/the-sweet-smell-of-a-successful-registration.html?news=d28c44ca-6b7a-440b-a97d-ee09588e9c02 (last accessed on 26/3/2018)

olfactory marks are eligible for trademark registration. In 1999, the Community Trade Mark Office ("CTM") contemplated whether the scent of fresh cut grass could be registered as a trademark for tennis balls. Initially, the application was refused on the ground that the words "the smell of fresh cut grass" did not qualify as an adequate graphical representation of the mark capable of depiction in a shape or form as required by Article 4 of the Community Trade Mark Regulation. On appeal, the Board of Appeal decided that the scent of fresh cut grass is a distinct scent known to, and recognizable by, the majority of the population from experience, and thus that the mark's description was appropriate for registration.\textsuperscript{12}

The refusal of the registration of a balsamically fruity smell with slight hint of cinnamon by the European trademark registries raised two questions to the ECJ:

(1) First of all a mark which cannot be reproduced visibly can still be reproduced with certain aids

(2) And secondly whether the requirement for graphic representation in Article 2 is met when an odour is reproduced by (a) chemical formula, (b) a description, (c) a sample or (d) a combination of these elements.\textsuperscript{13}

It was held by court that list of signs in Article 2 is not all-inclusive and signs which can’t be observed visually such as smell or odours will not be excluded provided that it can be represented graphically.

**The United Kingdom:** In order to implement the Community Trademark Regulation of 1993 a new trademark was enacted in the UK. Chanel No 5 on that day itself pursued to register it as trademark but it was unsuccessful on account of lack of indication of its origin. This was followed by the successful registration of a floral fragrance similar to roses as applied to tyres by Sumitomo Rubber Co and smell of beer applied to flights for darts by Unicorn Products.

Even in the case of the UK the problem was with the graphical representation of the marks similar to the case of ECJ. Graphical representation is not only necessary for recording and publishing the mark but also to allow the concerned parties to determine extent of existing trademark rights by running a search of trademark register. The Principal Hearing Officer in a case of registration of

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\textsuperscript{12} Supra note 10

\textsuperscript{13} Hikada S & Tatchell Nicola et al., Asign of the times? A review of Key Trade Mark Decisions of the Eurpean Court of Justice and Their Impact Upon National Trademark Jurisprudence in the EU, Trademark Reporter, 94(2004) 1105 at 1115.
the smell or aroma of cinnamon in respect of furniture highlighted the difficulty in registration of smell marks by stating that a man's view of the scent is probably going to be affected by the conditions in which they have been valued. Apart from graphical representation, it is important that the mark is not lacking of unique character as was stated by the OHIM Third Board of Appeal in another such case. Since an olfactory mark is incapable of being perceived visually, it raised a question as to whether an olfactory mark cannot be a subject matter of trademark in any capacity. The answer to this question was dealt with for the first time in the case of Sieckmann v Deutsches Patent-und Markenamt before the European Court Of Justice. The ECJ emphasized on the graphical representation of the mark rather than on visual perception. But at the same time the ECJ decided that graphical representation per se is not enough for registration, and it must fulfill the following criteria: It must be complete, clear and precise, so that object of the right of exclusivity is immediately clear. It must be intelligible to those persons having an interest in inspecting the register, i.e. other manufacturers and consumers.  

Therefore although in UK the registrations of olfactory marks is very much allowed and open in theory but the reality of practice is quite the opposite especially in regard to the Sieckmann as descriptions in writing, chemical formulas, samples, electronic sensory analysis have been struck down by the courts.

**Australia:** Australian courts have similar stand on non-conventional marks which follows the Sieckmann test while considering the non-traditional marks. Even though the definition of trademark in Australian Trademark Act expressly includes shapes, colours, scents and sound, it is subject to the graphical representation of the mark. Scent marks are capable of being registered under Section 17 of the Trade Marks Act 1995. Section 17 provides that a trademark is “a sign used, or intended to be used, to distinguish goods or services dealt with or provided in the course of trade by a person from goods or services so dealt with or provided by any other person”.

**New Zealand:** The amended Trademark Act of New Zealand made a noteworthy change in the statutory provision in regards to the definitions of the term trademark wherein the word sign includes a brand, colour, device, heading, label, letter, name, numeral along with smell, sound,
taste etc. Through this article it has been established that protection of smell marks in New Zealand is granted through both statutory provisions and judicial decisions.

**India:** Definition of Trademark under the Indian law is not quite different from the previous international treaties. It neither includes nor expressly excludes the registrability of non-conventional trademarks. Even though it is open to interpretation, the definition of mark doesn’t involve any non-conventional trademark but the Draft Manual issued by the Trademark Office provides for special consideration for certain non-traditional trademarks. When it comes to the consideration two questions are usually raised. One being the degree to which the standards applicable to traditional trademarks adapt unconventional subject matter and secondly where there is the presence of gaps in the existing law.

Like every other country India is also not free from the issue of graphical representation of the smell marks and to resolve this issue the Draft Manual provisions have been introduced which if not implemented could stunt the growth of registrability of smell marks in India.

**CHALLENGES FACED IN REGISTRATION OF SMELL MARKS**

In spite of the recognition gained by smell marks from various countries, it still lacks backing of strong legal provisions and development is needed in this branch of law. With more countries establishing provisions for the registrability of smell marks a clear contradiction can be seen between the standards laid down for the same by the countries. Where on one hand countries like Australia and Europe depend on the Sieckman test, the United States trademark law is guided by the Qualitex ruling of the Supreme Court.\(^{16}\)

The most basic challenge faced by a smell mark is the consumer’s accessibility to the smell before purchasing the product. If not then the basic purpose of the smell to act as a trademark is defeated because the purchaser has to wait to smell its scent till the product is put to use at home. This way he cannot connect the odor with the origin and hence his decision won’t be influenced at the time of the purchase.

\(^{16}\) Supra note 1
Another difficulty which usually arises in case of smell marks is that even though a consumer recognizes the smell or finds it familiar, he may not be able to connect the smell with the identity of the product or manufacturer on a consistent basis. Regardless of whether an item's aroma operates as a root identifier, the producer looking to shield that mark from infringement must have the capacity to show that comparative fragrances may amount to likelihood of confusion.

Similar aroma mixes, just like similar colours can be hard to recognize without expert help and when it comes to smell marks it proves to more difficult and burdensome than colour marks in case of the practical difficulties faced in its administration.\footnote{Ibid}

**CRITICAL ANALYSIS**

Protection of ‘smell’ as trademark has been a long debated topic. Although various countries have laid down specific provisions in regard to the protection of smell marks, nevertheless the standards laid down by different countries are in conflict with each other.

Some arguments in favor of protecting smell marks highlight the fact that the role of scent in today’s product is not restricted to sell but also extends to distinguish the product. Also it plays an active role in establishing a long duration odor memory. While arguments in against focuses on consumer’s access to product’s scent before they purchase. It speaks of the likelihood of confusion among consumer and the difficulty to differentiate without expert aid.

In my opinion registration of smell marks has more downside than ups the reason being just as in some cases, consumers connect a particular smell with a specific manufacturer, taking into account the subjective nature of human sensitivity and random nature of smell, it should be an issue of concern for the owners to think about using scent as trademarks as a scent on a product may easily alienate consumer if the scent is unappealing to them.

Also, the total numbers of scents of promising character which are known to the mass public through a written description are limited. Therefore registration of specific scents should not be allowed to evade depletion of the supply of scents available for use by others.
The requirement of graphical representation is not satisfied by a deposit of odour sample as it is subject to change due to lack of stability and gets affected by various environmental factors such as temperature, humidity, wind etc.

CONCLUSION

Irrespective of the fact that smell or scent marks can be very innovative, novel and appealing way of marketing and selling goods for sellers yet it has a controversial and doubtful stance when it comes to registrability as trademarks under the trademark laws owing to the following difficulties-

It is often difficult for traders to represent such marks in the trademark registries, it lacks the basis to perform as the sole identifier of the source or origin, the theory of smell depletion and also the fact that smell or scent is subjective in nature and it changes and depends from person to person and so different consumer may perceive it in a completely different way based on their opinion. All these together works in a negative way sometimes and challenge the functionality and efficacy of smell marks as trademarks.

Thus in conclusion it can be said that it is a fact that the way products smell can be a huge determining factor in individual’s life but lack of graphical representation and arbitrary and random nature of smell or scent can sometimes pose a risk in case of registration of a smell mark but a balance between the utilization of technology by various Trademark Offices of different countries and founding jurisprudence of trademark, the lacuna present in process of protection of smell marks can be erased.