
OLFACTORY TRADEMARK - A COMPARATIVE ANALYSIS OF ATTEMPTS TO REGISTER OLFACATORY TRADEMARKS

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ABSTRACT

Meeting the needs and wants of buyers is the ultimate trick for the business sharks to maximize consumer fans and exorbitant profits. Infusing certain unique retrofits to a product can leave a profound psychological impression on the consumer which encourages him to prefer a particular brand that provides a better impression. Unconventional or non-conventional trademarks include a variety of sensory experiences that create an emotional and memorable experience for the consumer, enabling him to distinguish one brand from the other. Specifically, an olfactory trademark, or scent mark, is a distinctive fragrance used to uniquely identify a product or service, serving as a sensory brand element that differentiates it in the market. This Paper aims to analyze the legal position of olfactory trademarks in India compared to foreign jurisdictions and the challenges faced in recognition of the same in India. It further seeks to study the various successful and unsuccessful attempts to register olfactory trademarks that have been put forth before various authorities to decide.

Keywords: trademark, infringement, unconventional trademarks, olfactory trademarks, smell

1. INTRODUCTION

1.1. Trademark

A Trademark being a source of intellectual property, is sign or representation that helps consumers to differentiate one product from another. It can be a symbol, logo, design, phrase, or combination of these things. WIPO Defines Trademark as a sign capable of distinguishing the goods or services of one enterprise from those of other enterprises. Trademarks are protected by intellectual property rights.

The primary function of a Trademark is to identify the source of goods or services and prevent consumers from confusing them with those from other sources. It provides legal protection to the brand owners and safeguards consumers from potential confusion between brands. JT McCarthy claims that trademarks typically serve the following purposes in his work, Trademarks and Unfair Competition: One trader's products are recognized, and they are differentiated from those sold by other traders (the Identification Function). It indicates that a single source supplies all products with a specific trademark (the Resource Function). It serves as a primary tool for product promotion and sales and indicates that all products bearing a specific trademark are of the same potential [the Quality Function] and finally, the advertisement function as a silent salesman.¹

1.2 Unconventional Marks

Traditionally, conventional marks including logos, symbols, pictures, captions, signs, names, and similar components were the main targets of trademark protection. Nonetheless, it is now more important than ever for physical goods producers to set themselves apart from the competition in today's market.² Businesses seek to establish a distinctive brand that appeals to customers and makes an impression by investigating distinctive trademark choices³. Unconventional trademarks are recognised a result of the impression a trademark creates on the sensory receptors of the consumer population thus enabling them to

¹ Kenneth B. Germain, TRADEMARKS AND UNFAIR COMPETITION By J. Thomas McCarthy. Rochester, New York: Lawyers Co-Operative Publishing Co., (2d ed. 1984). Pp. 2269, including Index, Table of Cases, Table of Statutory Citations, Table of Figures, Table of Forms, and Appendices., 34 Cath. U. L. Rev. 595 (1985). Available at: <https://scholarship.law.edu/lawreview/vol34/iss2/12>

² Tanusree Roy, Registrability of Smell Mark as Trademark: A Critical Analysis, 4 Journal on Contemporary Issues of Law 121, 121-130 (2018).

³ Academike. (2024, August 14). Exploring the realm of Non-Traditional Trademarks: An Indian perspective. *Academike*. <https://www.lawctopus.com/academike/exploring-the-realm-of-non-traditional-trademarks-an-indianperspective/>

differentiate one brand from another. These trademarks like include sound marks, holograms, haptic or touch marks, taste or gustatory marks and olfactory marks (smell).

2. OLFACTORY TRADEMARKS

Olfactory means 'relating to the sense of smell'. The sense of smell enriches our experience of the world around us. It creates a lasting impression in our minds and help us determine what is good and bad for us, both consciously and otherwise. Olfactory trademarks improve olfactory memory by helping consumers use aroma to recognize a particular product. There may be Odor marks on the product or its packaging. In the words of words of the Office and the rulings of the European Court of Justice, "where smell is affixed to a generally unscented product or when the scent is notably unique so as to elicit consumer awareness⁴." It is an olfactory trademark. Thus, it is essential that the smell is not the functional character of the product.

2.1. Kinds of olfactory Marks

Olfactory marks can be divided into three categories based on the particular products they are associated with. "Primary scent markings" are those seen on deodorants, perfumes, and other products that release fragrances just for that purpose and serve no other purpose. "Secondary scent marks" refer to products such as soaps, beauty bars, body washes, body lotions, serums, detergents, and so on that are not utilized for their intended purpose but yet include a necessary scent component. Finally, Items such as an embroidery thread that are not impacted in any manner by the presence of a scent are referred to as having "unique scent markings."⁵

2.2. Legal Status of Olfactory Marks across Borders:

2.2.1. Status of Protection of Olfactory marks in the International Legal Regimes

The Madrid Protocol didn't provide much on the subject matter of registration of trademark. The Paris Convention leaves it up to the domestic laws of the individual nations to include or exclude any type of unconventional trademarks from trademark

⁴ Shambarta M., "Can Non-Traditional Signs, such as Colours, Scents and Sounds Be Protected Under Trademark Law? if Not, What are the Alternatives to Do So? a Comparative Analysis Between Europe and United States of America", Marinos Shambartas, available at: <http://www.msllawyers.eu/legalarticles-publications-law.asp?id=10> (last visited on November 06, 2024).

⁵ Meenu Maheshwary "Olfactory Trademarks - a Need to Create a Space for its Sense!", Mondaq.Com, Sept. 20, 2013, available at: <https://www.mondaq.com/india/trademark/263798/olfactory-trademarks---a-need-to-create-a-space-for-its-sense> (last visited on Nov. 2, 2024)

protection. On a prima facie understanding, it seems that the TRIPS Agreement does not permit the registration of odors as trademarks. However, contrarily, attempting to understand the requirements under Article 15⁶ of the TRIPS Agreement, it is stated that non-visual marks may be protected as trademarks if they are employed as marks having a unique distinctiveness, and be capable of being represented graphically and perceived⁷.

2.2.2. Status of Protection of Olfactory marks in the European Legal Regime

According to the most recent changes to the European trademark law, a mark can be protected as a trademark as long as it can be used to differentiate one good or service from another and is "represented on the register in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor." For a smell mark to be registered, it must also be presented "in a manner which is clear, exact, self-contained, easily accessible, comprehensible, durable, and objective." Finding the most effective way to represent an olfactory mark is necessary in order to get the Office to accept and permit trademark registration⁸.

2.2.3. Olfactory Marks in the USA

Unlike the European Union, the United States of America was the first to permit the registration of olfactory markings. "The terms' symbol, or device should not be deleted or narrowed to preclude registration of things like a color, shape, smell, sound, or configuration which functions as a mark," the US Trademark Association's Trademark Review Commission affirmed after examining the Trademark Act of 1946. Olfactory marks can be effectively registered in the United States under the Lanham Act, 1946, since they qualify for registration under Section 2(f) of the Act⁹ based on two criteria: non-functionality and distinctive features.

⁶ Article 15 of Trips Agreement

⁷ <https://nluassam.ac.in/docs/Journals/IPR/vol1-issue-2/3.pdf>

⁸ BN, A. (n.d.). LEGAL STATUS OF OLFACTORY MARKS UNDER THE TRADEMARK LAW REGIME. In *NLU Journal of Intellectual Property Rights* (Vol. 1, Issue 2). <https://nluassam.ac.in/docs/Journals/IPR/vol1-issue-2/3.pdf>

⁹ 2(f) Lanham Act, 1946

2.2.4. Recognition of Olfactory Marks in Australia

Australian courts take a similar stance on non-traditional marks, applying the Sieckmann test when evaluating them. Shapes, colors, fragrances, and sound are all specifically included in the Australian Trademark Act's definition of a trademark; nevertheless, the mark must be represented graphically. Section 17 of the Trademarks Act of 1995 allows for the registration of scent marks. "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" is what Section 17 defines as a trademark.¹⁰

3. CONCEPT OF OLFACTORY MARKS IN INDIA

According to Section 2(zb) of the Trademark Act, 1999 "trademark" means a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others and may include shape of goods, their packaging and combination of colors¹¹; The Phrase "may include" in 2(zb) of the Act¹², implies that the section is not exhaustive and further expands the scope of the term trademark, which may result in the inclusion of various others expressions also called the un-conventional trademarks.

Currently, there is no legislation that protects unconventional trademarks except sound marks¹³. According to Rule 26(5) of the Trademarks Rules, 2017¹⁴, "When a sound is used as part of a trademark registration application, a copy of the sound that is no longer than 30 seconds in length and has been recorded on a medium that allows for easy and audible replay is required, along with a graphical representation of the sound's notations." This is the only exception to the Indian legislation regarding non-conventional marks¹⁵.

3.1. Challenges involved in recognition and registration of olfactory marks in India

Graphical Representation of Smell Marks: India has adopted a strict approach to trademark representation; in order for a mark to be registered as a trademark, it must be able

¹⁰ EleniMezulanik, *The Status of Scents as Trademarks: An International Perspective*, (2012)

¹¹ Trademarks Act, 1999

¹² Section 2(zb), Trademarks Act, 1999

¹³ <https://www.scconline.com/blog/post/2023/03/18/the-case-of-unconventional-trade-marks-does-the-trade-marksact-1999-need-reform/>

¹⁴ Rule 26(5) of the Trademarks Rules, 2017

¹⁵ Amlegals, D. O. (2023, May 17). *Recognition Of Smell As A Trademark In India*. Law Firm in Ahmedabad. <https://amlegals.com/recognition-of-smell-as-a-trademark-in-india/>

to be shown on paper, which may not be possible.

Proving the distinctiveness of the product: In order for a perfume or aroma to possess a unique quality, it is important to confirm that it has not been obtained from the inherent quality it holds¹⁶.

The Doctrine of Functionality: Any feature of a product which is also its functional feature (purpose of the product) is not eligible for protection. Making an effort to prove that a certain item's scent is not its useful aspect might be quite challenging.

Smell as a subjective perspective: It is frequently claimed that human perception of smell is subjective, making it unsuitable as a reliable trademark for distinguishing goods or services¹⁷. **Depletion Doctrine:** There is a finite range of sensory marks (like color, scent, or sound) that consumers respond to. Granting exclusive trademark rights to one such mark limits the availability of desirable marks, harming competition. This is particularly relevant for olfactory marks, as scent preferences vary across cultures. Granting exclusive rights to one fragrance reduces competition both domestically and globally¹⁸

The Indian Draft Manual of Trademarks, 2015 offers the most conclusive guidelines on their status in India. "Consumers of such fragranced goods are unlikely to attribute the origin of the products to a single trader based on the fragrance," the Manual states, adhering to the guidelines set in the Ralf case¹⁹. Whatever the situation, a mark will not be deemed to be a trademark for the purposes of registration until it is "graphically represented." Therefore, unless olfactory markings are given in a way that satisfies this graphical representation criteria, the Manual categorically denies their registration²⁰.

4. CASE ANALYSIS OF SUCCESSFUL AND UNSUCCESSFUL ATTEMPTS TO REGISTER OLFACTORY MARKS

4.1. Trademark application for Tyer smelling like roses:

In the case of **Sumitomo Rubber Industries**²¹ in March 2023, Sumitomo Rubber Industries,

¹⁶ Ibid

¹⁷ *Olfactory Trademarks in India: Status & Challenges*. (n.d.).

<https://www.indialawoffices.com/legalarticles/olfactory-trademarks-in-india>

¹⁸ *Law and 'Odor': Establishing a Case for Olfactory Marks in Indian IP Landscape – NLIU Cell for Studies in Intellectual Property Rights*. (2023, September 30). <https://csipr.nliu.ac.in/copyright/law-and-odor-establishing-a-case-for-olfactory-marks-in-indian-ip-landscape-part-i/>

¹⁹ Case C-273/00, 2003 E.T.M.R. 37

²⁰ Ibid

²¹ Sumitomo Rubber Co'U.K. Reg. No. 2001416/filing date Oct. 31, 1994.

a Japanese company, filed an application for an olfactory trademark in India for tires that smell like roses. The trademark registry objected to the application because it doesn't accept smell trademarks. The application was filed for an olfactory trademark described as *floral fragrance/ smell reminiscent of roses as applied to tyres*" under application no. 5860303 in class 12 for "tyres for vehicles". Sumitomo's application is particularly interesting because this was the first olfactory trademark registration in the UK and has since lapsed.

4.2. Court Lays Down Seven-fold Test:

In the case of *Ralf Sieckmann v. Deutsches Patent und Markenamt*²², the European Court of Justice emphasized the importance of graphical representation for scent trademarks. The Court established the "Sieckmann seven-fold test," which outlined the necessary criteria for a valid graphical depiction of a scent. According to this test, a scent must be depicted in a way that is clear, precise, self-contained, easily accessible, intelligible, durable, and objective. This decision clarified the requirements for registering olfactory trademarks in the European Union, ensuring that scent representations meet specific standards for clarity and distinctiveness.

4.3. Our Tennis ball Smells like freshly cut grass: Please Provide for Trademark Registration:

A tennis ball manufacturing company from Holland, Venootschap onder Firma Senta Aromatic Marketing's²³ tennis balls smell like freshly cut grass and the use of the olfactory mark is solely reserved by the manufacturer. The jurisdiction of European Union granted protection to this mark on the grounds that smell can act a source of identification in the scenario where the smell is widely recognised and appropriate smell for a tennis ball.

4.4. Chanel's Rejected Trademark Application²⁴ – Sorry it's functional:

In 1994, the UK Trademark Registrar received an application to register the scent of Chanel No. 5 perfume as an olfactory trademark. Despite the fragrance's iconic status and its association with famous ambassadors like Marilyn Monroe and Keira Knightley, the registration was rejected. The court ruled that the scent of Chanel No. 5 was an essential characteristic of the product itself, making it a functional aspect rather than a distinctive,

²² *Ralf Sieckmann v. Deutsches Patent und Markenamt* [C-273/00, 2003 E.T.M.R. 37]

²³ 1999 ETMR 429 (Eur. Comm. Trade marks Office, Second Board of Appeal)

²⁴ Chanel's Application, 31-10-1994, cited from Nathan K.G. Lau, "Registration of Olfactory Marks as Trademarks: Insurmountable Problems?", 16 Singapore Academy Law Journal, pp. 264, 265 (2004)

nonfunctional feature that could serve as a trademark. Trademark law requires that marks must distinguish one product from others, and the court found that the fragrance was too integral to the perfume's identity to be considered a separate, identifiable mark. This decision underscored the difficulty in granting trademark protection to scents, as they are subjective and hard to standardize. The rejection also highlighted concerns about monopolizing functional features of a product, which could stifle competition. Despite the ruling, Chanel No. 5 remains one of the most recognizable and beloved fragrances in the world.

4.5. Stitching Threads with Fragrance of Plumeria Blossoms²⁵- Granted!

In 1990, the first olfactory trademark in the U.S. was granted for the scent of plumeria blossoms, used by Osewez in embroidery yarn and stitching thread. The trademark was approved after consumers associated the distinctive fragrance with the product, and the scent was prominently featured in the company's advertisements. This marked a key development in recognizing scents as a trademark element in specific industries.

4.6. Pepper Mint Aroma of Nitroglycerin Spray²⁶:

The pharmaceutical company Pohl Boskamp applied for trademark registration for the peppermint flavor and scent of its Nitroglycerin spray used to treat cardiac symptoms. Testing revealed that the peppermint flavor played a key role in enhancing the product's effectiveness for treating certain chest conditions. As a result, the peppermint scent was deemed functional, and the product was not eligible for trademark registration. While the functional aspect of trademark law is crucial, cases involving olfactory trademarks highlight its restrictive nature. This can hinder efforts to protect unique sensory elements of products, limiting the ability to secure intellectual property rights for distinctive, non-visual features that play a vital role in a product's identity or performance.

4.7. Raspberry scent Fuels:²⁷

In the 2001 decision by the Third Board of Appeal in the UK, Myles Limited's application for trademark registration of the "scent of raspberries" for fuels, including motor and diesel fuels, was rejected. While the scent could be represented graphically, it was denied

²⁵ Clarke, In re, 17 USPQ2d 1238 (TTAB 1990)

²⁶ *In re Pohl-Boskamp GmbH & Co.*, 106 U.S.P.Q.2d 1042 (TTAB Feb. 25, 2013). (2013, June 25). Lexology. <https://www.lexology.com/library/detail.aspx?g=01526ea5-8d80-4978-811c-aaaa95786d6d>

²⁷ In Case R 711/1999-3 MYLES LIMITED

registration because it lacked distinctiveness as a trademark. The Board ruled that the raspberry scent did not sufficiently differentiate the product from others in the market, failing to meet the criteria for a registrable trademark.

4.8. Furniture Products smelling sweet as Cinnamon:²⁸

In John Lewis's case, the company sought to register the scent of "cinnamon" as a trademark for its furniture products. However, the Principal Hearing Officer denied the application, reasoning that the perception of the scent could vary based on individual circumstances. He argued that the cinnamon smell lacked sufficient definition and precision, making it unclear and potentially confusing. This lack of distinctiveness could lead to ambiguity, as similar smells could be mistaken for the trademark, thus failing to meet the criteria for registration.

5. CONCLUSION AND SUGGESTIONS

Smell is a unique and powerful sensory experience that can have a significant emotional and psychological impact on individuals. This has led to the emergence of sensory neuromarketing as an effective tool in influencing consumer behavior. Despite its growing importance, Indian trademark law does not specifically address the concept of olfactory trademarks. The Trademarks Act, 1999, and the Trade Marks Rules, 2017, primarily focus on visual and graphical representations of marks, without offering clear guidelines for registering smell-based trademarks. Although there is no outright ban on olfactory trademarks, the legal framework currently lacks precise provisions for their recognition and registration.

Globally, the concept of smell marks has yet to gain significant traction in the intellectual property field, and there remains considerable ambiguity surrounding their legal status. This highlights the need for greater clarity and encouragement for innovations, as well as the global transfer of technology in the domain of sensory trademarks. In particular, there is a need to establish clear criteria for the distinctiveness of unconventional trademarks, especially regarding the issue of graphical representation for smell marks, which are inherently nonvisual.

As technology and innovation continue to advance, there is a growing acceptance of unconventional trademarks, including smell-based marks. However, a structured and systematic approach to their registration is crucial. To facilitate this, there is a pressing need

²⁸ John Lewis of Hungerford Ltd's Trade Mark Application p [2001] RPC 28

to relax the current interpretations and legal constraints surrounding smell marks. A more flexible and standardized approach, particularly regarding the graphical representation of olfactory trademarks, would help harmonize global requirements and encourage broader adoption of sensory-based trademarks in the future.