

---

# **“SMELL” AS A TRADEMARK: LIMITATIONS AND SUGGESTIONS**

---

Alan Baiju & Malavika Manoj, Jindal Global Law School

## **ABSTRACT**

Trademarks play a key role in the business world due to increasing competition by facilitating a company’s ability to be different from the competitors, by presenting them with distinguishing characteristics which in turn helps garner a relatively large consumer base. The trademark regime has now seen the emergence of unconventional forms of trademarks such as smell, sound, and taste marks. This article aims to examine the possibility of smell as a trademark with respect to the graphical representation and functionality test as well as discuss functional suggestions that would pave the way for easy registration of such unconventional trademarks.

## Introduction

Section 2 of the Indian Trademarks Act, 1999 defines “mark” as a “device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging, or combination of colours or any combination thereof”. While the traditional understanding of the word ‘trademark’ has to do with a visual mark that helps a buyer differentiate between two products, the ever-evolving technology and marketing strategies have resulted in the acceptance and acknowledgment of more unconventional trademarks like scent. Unlike other unconventional trademarks such as sound marks, smell marks (alternatively referred to as ‘scent marks’) prove to be much more complex as they lack any form of definite representation. Although no smell marks have been registered to date before the registry in India, the possibility of trademark protection for a scent has been the subject of judgements passed by courts in EU and other foreign jurisdictions. However, India’s position, while slow, is not stagnant and we are on our way to accepting more newfangled marks and making registration accessible for a huge variety of scent marks.

## Hindrances of Smell Mark Registration

### A. Graphical Representation of Fragrances

Trademarks are often confined to words, logos, or symbols which are used in relation to any goods or services that can be easily depicted in a graphical form. Smell trademarks are perhaps one of the most difficult types of trademarks to encapsulate graphically. As seen in the well-known case of Sieckmann v. Deutsches Patent-und Markenamt (herein referred to as the “Sieckmann case”) trademark registration for the fragrance of ‘methyl cinnamate’ was denied due to a failure to comply with the rule requiring pictorial representation. Similarly, the registrability of ‘the aroma of raspberries’ with respect to fuels, including motor fuels, particularly diesel as a heating fuel, gasoline, and engine fuel was questioned in the case of Myles Limited’s Application . In the instant case, the fragrance was denied registration because, while it could be graphically depicted, it lacked distinctiveness as a property. In India, Section 2(zb) of the Trademarks Act specifies that a trademark is a mark that can be expressed “graphically”. The mere chemical composition of the ‘smell’ does not amount to an appropriate graphical representation, making the registration procedure much harder. Such a description is just a characteristic of the substance rather than the scent itself. Further, the smell must evoke a connection with the good/service of the proprietor and give it a sense of uniqueness and

distinction to qualify as a trademark. In the case of *R Vs John Lewis*, the scent mark 'the smell, aroma, or essence of cinnamon' was attempted to be registered as a trademark in relation to furniture products. The Principal Hearing Officer declined registration, reasoning that an individual's impression/perception of the scent would vary depending on the circumstances, that the scent could not stand alone because it lacked distinctiveness and that it was not specific enough to avoid any confusion caused by other similar scents. The Indian Draft Manual of Trademarks, 2015, also asserts the same principles requiring graphical representation as stated in the Sieckmann case, but the same is not enforceable as a legal authority. Due to the lack of the aforementioned criteria, fragrance marks cannot be registered under Indian trademark law.

### **B. Satiating the Doctrine of Functionality**

The limitations of graphical representations do not appear to be the only legal stumbling block to registering smell marks. The functionality doctrine is one of the most serious legal impediments to the registration of fragrance marks. To elaborate, in instances where the mark does not serve as a source identifier but is tied with the function of the goods/services sold by the proprietor, the mark would be less likely to be registered. An example of this would be attempting to register citrus/lemon scents for a room freshener. Thus, for a scent mark to pass the registrability threshold, the scent must not be of functional/essential nature to the good/service.

By permitting a trademark owner to control a beneficial product feature, the functionality doctrine/theory aims to avoid trademark law from impeding competition. As a result, if an applicant can demonstrate that the fragrance serves just as source identification and has no other major function, the scent will most likely pass the non-functionality test. However, the application of this doctrine turns out to be precarious with regard to scent marks. The non-functionality doctrine/test is however not without its downsides.. The renowned fragrance line by the French fashion house "Chanel", widely used by the fashion industry for decades - 'Chanel No. 5', is an excellent illustration of this intricacy. The fact that a brand as well-known, in the fragrance world, as Chanel No. 5 has not been successful in registering its iconic fragrances as scent marks is quite ludicrous. It enables the possibility of the iconic smell being duplicated without the commodity owner having any legal redress.

Furthermore, there are additional ways in which the functionality doctrine obstructs the registration of smell trademarks. Consider the example of a pharmacological business, 'Pohl

Boskamp' which had filed a trademark registration request for the flavour and peppermint scent of its nitroglycerin spray used to alleviate chest symptoms. During the examination stage where the registration's validity was being determined, it was discovered that the peppermint flavour was very efficient in treating some types of chest difficulties. As the peppermint fragrance was essential and tied to the function performed by the good for which the proprietor sought protection, the mark was deemed not registrable. While the importance of the functionality doctrine in trademark law is undeniable, cases like this one involving olfactory trademarking highlight the theory's restrictive nature, which, in turn, might obstruct the protection of a potential intellectual property.

### Suggestions

A novel and instrumental method to distinguish deceptively similar smells from one another is through the usage of "Electronic Sensory Analysis". The trade mark registry in the case R v John Lewis had refused the graphical representation requirement because the description of scent by an electronic sensory analysis using chromatographic techniques was insufficient, stating that even with the requisite equipment, it would be unintelligible to anyone inspecting the register unless the details of the test conditions were included. Such a stance taken by the court does not, however, negate the validity and efficacy of this method. Therefore, the results of such an analysis combined with a clause mandating "disclosure of test conditions" would go a long way in ensuring an intelligible difference to anybody inspecting the registry of a claim for smell marks. In addition to these, other olfactory measures, such as employing sophisticated and technologically advanced smell sensors, will help pave new paths in ensuring objectivity in the registration of smell marks.

The apparent nature of smell is such that its durability is next to impossible and therefore, the sample deposition of a smell mark is bound to lose its intensity, especially over long spans of time. Even if the provisions of the Indian Law are such that they allow for the submission of samples in a sealed envelope, the contents are bound to volatilize over time, making a lasting olfactory impression impractical. This hurdle can be mitigated by obtaining samples on a pre-mandated timeline from laboratory suppliers or manufacturers of fine organic chemicals. Provisions must be made in the Draft Manual of trademarks practices and procedure that allow for qualified professionals to undertake such tasks. Such a step would also be beneficial for the increased accessibility of smell marks. Further, a "scenography camera", which is a

revolutionary piece of technology, can be utilized and would positively impact the approach and ease of smell registration. This device is capable of storing and retrieving minuscule quantities of a specific smell thereby greatly increasing the durability of the smell. This would in turn aid in mitigating the problem of retaining and storing “scent marks” in the registry.

Therefore, for the successful registration of a smell mark, the application must be accompanied by a well-articulated and scientifically detailed description of a smell and this would be subject to the scrutiny and approval of a qualified board of professionals.

## **Conclusion**

The most powerful sensory feature of the human body is the olfactory sense, as it communicates directly with the brain functions without the need for an intermediate thinking chain. The action of customers identifying the distinctive fragrance and tracking the product's origins is in complete compliance with trademark law standards, and hence, it is only fair to give ‘scents’ a specified designation as a trademark. While there are undeniable limitations for the same, with the right legislative aim and the incorporation of innovation of technology, there is a high possibility that potential fragrance markings will be recognized as trademarks with no restrictions in the future. Scent marks have been granted recognition as unconventional trademarks in India statutorily and Indian IP offices have been privy to the concept, but the same is yet to be actualized, despite fragrances/scents being a component of our culture.

While the Indian Intellectual Property Law has readily accepted sound marks as valid trademarks, the same law has been reluctant to accept smell marks as valid trademarks. In order to do away with the discrimination between two unconventional trademarks and pave way for easy registration, the expansion and amendment of Indian trademark law needs to take place, such that it caters to issues that arise when applicants attempt to meet an integral ingredient of trademark i.e., graphical representation.