

# PROPERTY RIGHTS OVER FRAGRANCES, SMELLS AND PERFUMES PROTECTING YOUR AROMA CREATION AGAINST COMPETITIVE IMITATION & REGISTERING SCENTS AS COMMUNITY TRADE MARKS

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## INTRODUCTION

Trade Marks are used for an identification of a particular good or service. With the legal registration of such a mark a Trade Mark owner/holder receives a right to prevent an unauthorized use of the mark and a right to use a Trade Mark in order to distinguish goods and services from his competitors. Registration of a Trade Mark gives a monopoly to its holder, so that the owner is able to prevent third parties from using this trademark.

A Trade Mark could be said to entail any word, symbol, name, device, packaging, shape of goods or combination of colours or any combination which is capable of lending the distinctiveness to the goods being produced and marketed under the mark so adopted. This is the scope of what are commonly known as ‘Traditional Trade Marks’. It is pertinent to mention here the legal provisions as to Trade Marks under the Indian law.

The **Trade Marks Act, 1999**<sup>1</sup> defines the term “**mark**” in the following manner:

*“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*<sup>2</sup>

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<sup>1</sup> Hereinafter, unless the context otherwise requires, referred to as “Act”

<sup>2</sup> Section 2(m) of the Act

The Act defines “**trade mark**” as:

*““trade mark” 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 colours...”<sup>3</sup>*

Further, in the relation of the provisions of the legislation, a trade mark includes any registered trade mark or mark, or any other mark, used or proposed to be used for the purpose of indicating a connection in the course of trade between the goods or services, and the right of a person as a proprietor or a permitted user, as the case may be, to use that mark.<sup>4</sup>

An understanding of these provisions implies an exhaustive and limited scope of the definition and meaning of marks with regard to their permissibility under the law. These definitions imply that the feature of the mark being represented graphically is essential to the validity and registration of such mark or trade mark. It has also been provided in the Trade Mark Rules, 2002 issued by the Ministry of Commerce and Industry, Government of India, vide a notification dated 26<sup>th</sup> February, 2002, that *““graphical representation” means the representation of a trade mark for goods or services represented or capable of being represented in paper form and includes representation in digitised form”<sup>5</sup>*. Graphical representation is an important aspect of the legal validity of a trade mark, certainly as far as the Indian position is concerned.

### ***Non-Traditional Marks***

However, in today’s world, with the exponential rate of rising competitiveness in the physical commodities markets around the world, production and distribution corporations have to be creative and stand out from their competitors in order to remain in a good market position. It is here that the use of non-traditional trademarks can come into play. Such corporations can invest in non-traditional trademarks like smell, sound or colour combinations in order to distinguish their products from the established standards.

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<sup>3</sup> Section 2(zb) of the Act

<sup>4</sup> Sections 2(zb)(i) & 2(zb)(ii) of the Act

<sup>5</sup> Rule 2(k) of the Trade Mark Rules, 2002

### ***What are non-traditional marks?***

Non-traditional marks are considered to be a new and recent type of trade marks. They pertain to those marks which do not fall under the ambit of the conventional definition of a trade mark. Non-traditional trademarks can be divided into two groups of **visible signs (colours, moving images, etc.)** and **non-visible signs which relate to all five senses (sounds, smells scents, tastes and textures)**. Due to the dynamic interpretation with regards to the general, universal understanding of term 'Trade Mark', various non-traditional marks have become widely accepted, being reflected in many inclusive legislations and international treaties such as Agreement on Trade-Related Aspects of Intellectual Property Rights, 1995 (TRIPS)<sup>6</sup>. However, graphical representation of such non-traditional marks is an issue which is yet to be resolved, particularly in regard to their admissibility under Indian law.

## **OLFACTORY MARKS**

A mark of a particular product which is used to distinguish it from other related products, on the basis of its smell, is known as an 'Olfactory Mark'. Olfactory marks have evolved as a result of manufacturers giving smells or scents to their products in order to make them distinct from other similar products. Olfactory sense is one of the most potent senses capable of registering itself in the human memory.

However, the registration of a smell mark has been enabled subject to the fulfillment of the condition that the smell is graphically represented. This condition is the vortex of the problem with regards to its registration. To qualify as a trade mark the smell should be attributed to the product in particular by reason of giving a scent which is unique to that specific product. There can be no registration of the smell as a trade mark for the smell singularly. If such a smell is to be described then its description has to be so precise and accurate that it cannot be confused with any other smell. Also, the smell to be registered must not be arising out of the nature of the product itself. This means that the smell of a product which has been registered as a trade

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<sup>6</sup> Hereinafter, unless the context otherwise requires, referred to as "TRIPS Agreement"

mark should not be descriptive of the kind, quality, quantity, intended purpose, values, geographical origin or the time of production of the goods.<sup>7</sup>

## TREATIES, CONVENTIONS & INTERNATIONAL REGULATIONS

1. The **Paris Convention for the Protection of Industrial Property of 1883**<sup>8</sup> was the first comprehensive international treatise on the scope of intellectual property such as patents and copyrights. However, the Convention did not define the term ‘Trade Mark’ and did not provide any indication as to how rights over trademarks are obtained, leaving it to the discretion of the national laws of the member States.
2. Even the **Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks of 1989**<sup>9</sup> does not define the meaning of a mark or trademark and neither does it discuss any criteria required for the valid international registration of marks and trademarks. It majorly concerns itself with the application, effects and other procedural aspects of international registration of trademarks.
3. **TRIPS Agreement**<sup>10</sup>

The TRIPS Agreement of 1995 applies to all the 162 members of the World Trade Organization (WTO). **Section 2** contained in **Part II of the Agreement** deals with Trade Marks and their use and protection. **Article 15(1)** of the Agreement reads as follows:

*“Any 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. Such signs, in particular words including personal names, letters, numerals, figurative elements*

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<sup>7</sup> Section 9(1)(b) of the Act

<sup>8</sup> Paris Convention for the Protection of Industrial Property, 1883, available at [http://www.wipo.int/treaties/en/text.jsp?file\\_id=288514#P83\\_6610](http://www.wipo.int/treaties/en/text.jsp?file_id=288514#P83_6610)

<sup>9</sup> Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, 1989, available at [http://www.wipo.int/wipolex/en/treaties/text.jsp?file\\_id=283484#P98\\_17646](http://www.wipo.int/wipolex/en/treaties/text.jsp?file_id=283484#P98_17646)

<sup>10</sup> Available at [https://www.wto.org/english/docs\\_e/legal\\_e/27-trips.pdf](https://www.wto.org/english/docs_e/legal_e/27-trips.pdf)

*and combinations of colours as well as any combination of such signs, shall be eligible for registration as trademarks. Where signs are not inherently capable of distinguishing the relevant goods or services, Members may make registrability depend on distinctiveness acquired through use. Members may require, as a condition of registration, that signs be visually perceptible.”*

The Trips Agreement defines trademark on a functional basis, i.e., on the distinctiveness of the function of Trade marks. Though the aforesaid Article provides a list of marks that can be considered to be Trade marks, the list is non-exhaustive. The definition neither concludes whether non-conventional marks in the nature of olfactory marks can be considered as a trademark, nor does it explicitly exclude non-visual Trade marks from its definition completely.

However, as the last phrase of the Article suggests, the member countries can condition and require visual perception and graphic representation for non-conventional trademarks, through their domestic legislations. As discussed hereinabove, the Act in India mandates graphical representation for the registration of a Trade Mark.<sup>11</sup>

Therefore, even the TRIPS Agreement cannot paint a clear picture as to the admissibility and registrability of non-conventional trademarks including olfactory marks.

**4. The Singapore Treaty on the Law of Trademarks, 2006 and the 2011 Regulations** on this Treaty<sup>12</sup> have been the first piece of formal normative provisions expressly recognizing non-conventional trademarks. While including colour, sound and smell marks, the Regulations have also recognized hologram marks, position marks, motion marks and 3D marks among others.<sup>13</sup>

This Treaty and Regulations focus more on procedural aspects related to non-conventional trademarks rather than substantive aspects, with the latter providing

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<sup>11</sup> *Ibid*

<sup>12</sup> Singapore Treaty on the Law of Trademarks, 2006 & Regulations under the Singapore Treaty on the Law of Trademarks, 2011 (Rule 3), available at

[http://www.wipo.int/wipolex/en/treaties/text.jsp?file\\_id=290013](http://www.wipo.int/wipolex/en/treaties/text.jsp?file_id=290013)

<sup>13</sup> International Trademark Association Bulletin, Vol. 61, No. 9, 1<sup>st</sup> May, 2006



application procedures for these new types of rights to be granted protection. This treaty has systematically codified the description requirements of the mark to be provided in the application form for registration, in addition to the manners of preparing applications for seeking protection of such non-conventional marks.

**5. Article 2 of the 2008 Directives of the European Parliament and its Council<sup>14</sup>** related to trade marks describes signs which a trademark may consist of for the registration of the same, within member states. The provision reads as follows:

*“A trade mark may consist of any signs capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.”*

The aforesaid provision succinctly represents the principal need of graphical representation of a trademark, through visual descriptions like names, designs, numeral and alphabetical figures, which subsequently should be able to distinguish the goods and/or services of the trademark from that of others. Although the letter of the provision seems to denote this meaning, it cannot be ascertained as to whether the same is inexhaustible so as to include non-traditional trademarks within its ambit.

**6. Article 4 of the 2009 Regulations of the Council of the European Union<sup>15</sup>** follow the same definition adopted by the European Union Directives, as quoted above. Albeit, the former, i.e., the Regulations deal with community trademarks of the European Union. Such registered trademarks, their applications and the Regulations apply uniformly to all the member states. A community trademark would not require any registration vis-à-vis the municipal laws of any member state.

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<sup>14</sup> Directive 2008/95/EC of the European Parliament and of the Council to approximate the laws of the Member States relating to trade marks, 22<sup>nd</sup> October, 2008, available at

<https://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:L:2008:299:0025:0033:en:PDF>

<sup>15</sup> Council Regulation (EC) No. 207/2009 of the European Parliament and of the Council on the Community trade mark, 26<sup>th</sup> February, 2009, available at

<https://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:L:2009:078:0001:0042:en:PDF>

Therefore, the position with respect to trademark rules of European Union applying separately to member states and for community trademarks, both primarily require visual and graphical representation of trademarks, thus eclipsing the possibility of admissibility of olfactory trademarks and other non-conventional trademarks.

## POSITION IN THE U.K. & THE EUROPEAN UNION

Trade Marks in the United Kingdom are governed and regulated by the **Trade Marks Act, 1994**.<sup>16</sup> **Section 1(1)** of this Act defines Trade Marks in the following manner:

*“In this Act a “trade mark” means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings.*

*A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging.”*

Thus, at the statutory front, there is no difference between the permissible scope of trademarks and their registration thereof. Although there have been instances of registration of olfactory trademarks in the U.K., which are discussed below.

- In 1994, the globally well-known brand **Chanel** applied for the **registration of their signature perfume fragrance product, ‘Chanel No. 5’ based on its fragrance**. They attempted to represent their smell mark graphically by describing the perfume in their application as *“The scent of aldehydic-floral fragrance product with an aldehydic top note from aldehydes, bergamot, lemon and meroli; an elegant floral middle note, from jasmine, rose, lily of the valley, orris and ylang-ylang; and a sensual feminine note from sandal, cedar, vanilla, amber, civet and musk. The scent also being known by the written Brand Name No. 5.”*<sup>17</sup>

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<sup>16</sup>Available at <http://www.legislation.gov.uk/ukpga/1994/26/data.pdf>

<sup>17</sup> Chanel's Application, 31.10.1994; cited from Nathan K G Lau, “Registration of Olfactory Marks as Trademarks: Insurmountable Problems?” 16 SINGAPORE ACADEMY L. J. 264, 265 (2004)

This application failed to proceed and was rejected because the perfume which was the smell mark which sought to be registered was also the end product in its finality. Further, the mark could not be considered indicative of the origin of the product.

- In the same year, **Sumitomo Rubber Co. successfully registered a smell mark** for their products of automobile tires by describing the mark in their application as “*floral fragrance reminiscent of roses as applied to tyres*”<sup>18</sup>
- Again in 1994, **Unicorn Products** applied for the registration of a smell mark for their products by describing it as “*the strong smell of bitter beer applied to flight darts*”<sup>19</sup>. This **application was also accepted and the mark was registered.**

But The Office for Harmonization in the Internal Market (OHIM) has reportedly disagreed with the decision of granting of registration to the two preceding smell marks.<sup>20</sup>

- **Vennootschap onder Firma Senta Aromatic Marketing v. Office for Harmonization in the Internal Market (case concerning “the smell of freshly-cut grass”)**

In the framework of the European Union, the former Office for Harmonization on the Internal Market allowed the registration of “the smell of freshly-cut grass” as a trademark for tennis balls. The examiner of the application first refused the registration due to the lack of the graphical representation through the mere wording.

Later the Board of Appeal decided that: “*The smell of freshly-cut grass is a distinct smell which everyone immediately recognizes from experience. For many, the scent of fragrance of freshly-cut grass reminds them of spring, or summer, manicured lawns or playing fields, or other such pleasant experiences. The Board is satisfied that the*

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<sup>18</sup> Sumitomo Rubber Co.’s Application No. 2001416 dated 31.10.1994; *cited from* Vatsala Sahay, “Conventionalizing Non-Conventional Trademarks of Sounds and Scents: A Cross-Jurisdictional Study”

<sup>19</sup> Unicorn Products’ Application No 2000234 dated 31.10.1994; *cited from* Vatsala Sahay, “Conventionalizing Non-Conventional Trademarks of Sounds and Scents: A Cross-Jurisdictional Study”

<sup>20</sup> “Smell, Sound and Taste – Getting a Sense of Non-Traditional Marks”, available at [http://www.wipo.int/wipo\\_magazine/en/2009/01/article\\_0003.html](http://www.wipo.int/wipo_magazine/en/2009/01/article_0003.html)



*description provided for the olfactory mark sought to be registered for tennis balls is appropriate and complies with the graphical representation requirement of Article 4 CTMR*".<sup>21</sup>

However, this decision has never again been repeated in any other case decided by the Office.

- In the **John Lewis Case**<sup>22</sup>, scent mark of "*the smell, aroma or essence of cinnamon*" was sought to be registered as a trademark in relation to furniture products. It was denied registration by the Principal Hearing Officer as he opined that an individual's perception of the smell of such product would vary depending on the circumstances. The scent could not stand just by itself as it lacked definition and it was not precise enough so as to eliminate any sort of confusion which might arise due other similar smells.
- In the **Myles Ltd. Case**<sup>23</sup>, "*the scent of raspberries*" with respect to fuels, including motor fuels, particularly diesel used as heating fuel and engine fuel, the registrability of which was in question, was denied registration for a smell mark on the ground that even though it could be represented graphically, it lacked distinctiveness as an attribute.
- **Eden SARL v. Office for Harmonization in the Internal Market (case concerning "the smell of ripe strawberries")** In the Trade Mark registration application of **Laboratories France Parfum SA ('LFP')** which manufactured and sold perfumes, an olfactory mark with the verbal description of having "*the smell of ripe strawberries*" was applied for registration. But the application was rejected by the Office for the reason that image of strawberry on the product, showed the berry itself instead of the smell of a strawberry and that was capable of confusing the public.

**The Court of First Instance** had to decide if the combination of the verbal and figurative elements was sufficient for the registration of an olfactory mark. Regarding the textual description, the Court held that the verbal detail was not clear and precise

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<sup>21</sup> *Vennootschap onder Firma Senta Aromatic Marketing v. Office for Harmonization in the Internal Market*, Decision of the Second Appeal Board of 11.02.1999 in Case R 156/1998-2, Application No. 428.870, para 14-15, available at [http://www.copat.de/download/R0156\\_1998-2.pdf](http://www.copat.de/download/R0156_1998-2.pdf)

<sup>22</sup> *John Lewis of Hungerford Ltd.'s Trade Mark Application*, 2001 RPC 28, available at <https://www.ipo.gov.uk/t-challenge-decision-results/o02401.pdf>

<sup>23</sup> *Myles Ltd.'s Application*, 2003 ETMR 56

since “*the smell of strawberries differs according to the variety*”<sup>24</sup> and that this kind of representation created a contradiction between the description itself and the actual smell. Moreover, the Court pointed out the research of the European Cooperation in the field of scientific and technical research which proved that “*the different varieties of strawberries produce significantly different smells*”<sup>25</sup>. Therefore, the description ‘the smell of ripe strawberries’ was not objective, clear and precise.

The Court further held that the image “*represents only the fruit which emits a smell supposedly identical to the olfactory sign at issue, and not the smell claimed*”<sup>26</sup> and thus it could not be regarded as sufficient graphical representation of a sign. Thus, the application stood rejected.

### **SIECKMANN’S CASE**

The case of **Ralf Sieckmann v. Deutsches Patent und Markenamt**<sup>27</sup> decided by the European Court of Justice (ECJ) marked a monumental shift in the global jurisprudential history and study of olfactory marks.

This case involved the Applicant seeking the registration of a smell mark as a distinctive mark which consisted of “*the pure chemical substance methyl cinnamate (= cinnamic acid methyl ester) with the structural formula - C<sub>6</sub>H<sub>5</sub>-CH = CHCOOCH<sub>3</sub>*”. Samples of this olfactory mark could have been obtained via certain local laboratories which were listed in the ‘Gelbe Seiten’ (Dutch Yellow Pages), as claimed by the Applicant. He further submitted a sample of the odour of such smell mark in a container stating that “*the scent was usually described as balsamically fruity with a slight hint of cinnamon*”<sup>28</sup>

Thus the Applicant represented the mark’s scent by three methods, namely by a verbal description, a chemical formula and the submission of a specimen of the smell.

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<sup>24</sup> Eden SARL v. Office for Harmonization in the Internal Market, Judgment of the Court of First Instance (Third Chamber), 21.10.2005 in Case T-305/04, para 27, available at <https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=CELEX%3A62004TJ0305>

<sup>25</sup> *Ibid*, para 31

<sup>26</sup> *Ibid*, para 40

<sup>27</sup> Ralf Sieckmann v. Deutsches Patent und Markenamt, Case C-273/00, 12<sup>th</sup> December, 2002, European Court of Justice (hereinafter, unless the context otherwise requires, referred to as “Sieckmann’s Case”)

<sup>28</sup> *Ibid*, Para 11 of the judgment

In its assessment, the ECJ firstly held that a sign which is not able per se to be identified by the sense of sight may qualify as a trademark if it possesses a distinctive character and if it can be depicted graphically, especially using pictures, lines or characters for example.<sup>29</sup> In other words, the ruling made clear that signs capable of being represented graphically are not limited to those signs which can be perceived visually. But graphical representation of an olfactory mark among other non-conventional trademarks is the paramount requirement.

The Court went on to say that the graphical representation must be “*clear, precise, self-contained, easily accessible, intelligible, durable and objective*”.<sup>30</sup> These considerations, applying not only to olfactory marks, but also to other non-traditional trademarks has come to be known as the “**Sieckmann seven-fold test**”. Albeit, the Court in this particular case did not provide much guidance on what they elaborately stand for and how they are satisfied in practice. The Court opined that the aim behind the graphic representation criterion is to empower a sign to be depicted visually in order for the scope of protection of the mark to be precisely determined.<sup>31</sup>

But the ECJ decided to refuse registration to this trademark by rejecting the chemical formula, verbal description and the sample of the smell mark submitted by the Applicant. The Court specifically refused the registration even on the basis of combined value of the descriptive features of the mark.

The Sieckmann’s ruling has had a profound impact on the registrability of non-traditional or intangible trademarks, particularly olfactory marks, especially as far as the European Union is concerned. The case has set a very strong precedential value against the registrability of olfactory trademarks, with the applicant satisfying a very rigid requirement of the Sieckmann seven-fold test as stated above. The smell sought to be registered as a mark needs to be distinctive, in the sense that it must serve as a trade origin indicator and not be the outcome of the nature of the product itself. The degree of distinctiveness, originality, accuracy and uniqueness has become the highest in the cases of olfactory marks.

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<sup>29</sup> *Ibid*, para 45 & 46 of the judgment

<sup>30</sup> *Ibid*, para 55 of the judgment

<sup>31</sup> *Ibid*, para 46 & 47 of the judgment

Therefore the case aligned itself with the statutory position applicable in the U.K. and the European Union.

## POSITION IN THE U.S.A.

In the USA the question of Trade Mark and their registration is governed by the **Lanham Act of 1946**<sup>32</sup>. **Section 45** of that Act defines trademarks and reads as follows:

*“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 chapter, 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.”*

This definition is not exhaustive in its nature and does not expressly rule out non-traditional trademarks from its scope. This inclusive scope was further widened by the United States Supreme Court vide its decision in the case of **Two Pesos Inc. v. Taco Cabana Inc.**<sup>33</sup> whereby it held that the Trade dress of a particular product may entail size, shape, colour or colour combinations, texture, graphics, or even particular sales techniques within itself. A trade dress may also include attributes like sounds and smell.<sup>34</sup>

The following judicial decisions and other instances project the much more active registrability of olfactory trade marks in the U.S.A.

- The case of **Clark, In Re**<sup>35</sup> is perhaps the most prominent judicial decisions relating to the successful registration of smell marks.

The Petitioner in this case appealed to the **Trademark Trial Appeal Board (TTAB)** against the decision of rejection of the smell mark of a sewing and embroidery yarn

<sup>32</sup> Available at [https://www.uspto.gov/sites/default/files/trademarks/law/Trademark\\_Statutes.pdf](https://www.uspto.gov/sites/default/files/trademarks/law/Trademark_Statutes.pdf)

<sup>33</sup> *Two Pesos Inc. v. Taco Cabana Inc.*, 120 L Ed 2d 615 : 505 US 763 (1992)

<sup>34</sup> Available at <http://www.inta.org/Advocacy/Pages/TradeDress.aspx>

<sup>35</sup> *Clark, In Re*, 17 USPQ2d 1238, 1239 (TTAB 1990)

manufacture by him, because of the non-distinctiveness of the product from other similar products. The Petitioner contended that his product was the only scented embroidery yarn being manufactured in the market giving it high impact, floral smell like that of a certain Plumeria blossoms.

While upholding the Petitioner's contention by holding that the Petitioner's product was the only one which was dealt and advertised in the market, being indicative of the smell which it sought registration for, the TTAB propounded that a scent is very well capable of distinguishing a product from other like products. Consequently, the TTAB gave the yarn a trademark registration reasoning that a unique scent is a prima facie case for distinctiveness of its mark.

- The above-mentioned judgment given by the TTAB was acknowledged by the **United States Supreme Court** in the case of **Qualitex Co. v. Jacobson Products Co. Inc.**<sup>36</sup> wherein the court observed that, "*Scent marks can be affixed directly to or infused into the product, like the Plumeria Blossom-scented yarn or hypothetical raspberry-scented upholstered furniture, or could even be affixed as a scratch-and-sniff or scented card.*"<sup>37</sup>
- In **October, 2014**, **Verizon** registered a scent mark for their electronic products such as mobile phones and other communication devices by submitting a specimen of a vial of scent oil which was described as having a flowery musk smell.<sup>38</sup>
- Brazilian footwear company **Grendene** successfully trademarked their line of bubble gum-scented jelly sandals in **June, 2015**. Along with their application, they sent the Commissioner for Trademarks one of their manufactured sandals as an example for consideration.<sup>39</sup>

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<sup>36</sup> *Qualitex Co. v. Jacobson Products Co. Inc.*, 131 L Ed 2d 248 : 514 US 159 (1995)

<sup>37</sup> *Ibid*

<sup>38</sup> Available at

[http://tsdr.uspto.gov/#caseNumber=86122975&caseType=SERIAL\\_NO&searchType=statusSearch](http://tsdr.uspto.gov/#caseNumber=86122975&caseType=SERIAL_NO&searchType=statusSearch)

<sup>39</sup> Available at

[http://tsdr.uspto.gov/#caseNumber=86265443&caseType=SERIAL\\_NO&searchType=statusSearch](http://tsdr.uspto.gov/#caseNumber=86265443&caseType=SERIAL_NO&searchType=statusSearch)



- In **2012**, the **Eddy Finn Ukulele Co.** registered an olfactory trademark comprising of the piña colada smell which they had applied to one of their ukulele musical instrument model.<sup>40</sup>
- In **2012**, a coconut smell was trademarked for goods like flip-flops, sandals, beach balls and related accessories.<sup>41</sup>
- In **2010**, a person named **Kalin Manchev** registered the smell of rose oil scent as a mark for various products used in advertising and sampling.<sup>42</sup>
- In **2009**, **Hisamitsu Pharmaceutical Co. Inc.** successfully registered an olfactory trademark having a having a minty scent by mixture of highly concentrated methyl salicylate and menthol for their products of medical equipment used for temporary relief of muscle aches and joints.<sup>43</sup>
- In **2007**, toothbrushes with an impregnated scent of strawberries were trademarked by **Lactona Corporation**.<sup>44</sup>
- In **2001**, a person named **Mike Mantel** registered 3 olfactory trademarks bearing the scents of cherry, strawberries and grapes, respectively. The same was done for synthetic lubricants for different types of automobiles and vehicles including aircrafts and ships.<sup>45</sup>

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<sup>40</sup> Available at

[http://tsdr.uspto.gov/#caseNumber=85553176&caseType=SERIAL\\_NO&searchType=statusSearch](http://tsdr.uspto.gov/#caseNumber=85553176&caseType=SERIAL_NO&searchType=statusSearch)

<sup>41</sup> Available at

[http://tsdr.uspto.gov/#caseNumber=85063625&caseType=SERIAL\\_NO&searchType=statusSearch](http://tsdr.uspto.gov/#caseNumber=85063625&caseType=SERIAL_NO&searchType=statusSearch)

<sup>42</sup> Available at

[http://tsdr.uspto.gov/#caseNumber=77871535&caseType=SERIAL\\_NO&searchType=statusSearch](http://tsdr.uspto.gov/#caseNumber=77871535&caseType=SERIAL_NO&searchType=statusSearch)

<sup>43</sup> Available at

[http://tsdr.uspto.gov/#caseNumber=77420841&caseType=SERIAL\\_NO&searchType=statusSearch](http://tsdr.uspto.gov/#caseNumber=77420841&caseType=SERIAL_NO&searchType=statusSearch)

<sup>44</sup> Available at

[http://tsdr.uspto.gov/#caseNumber=76621553&caseType=SERIAL\\_NO&searchType=statusSearch](http://tsdr.uspto.gov/#caseNumber=76621553&caseType=SERIAL_NO&searchType=statusSearch)

<sup>45</sup> Available at

[http://tsdr.uspto.gov/#caseNumber=74720993&caseType=SERIAL\\_NO&searchType=statusSearch](http://tsdr.uspto.gov/#caseNumber=74720993&caseType=SERIAL_NO&searchType=statusSearch) ;

[http://tsdr.uspto.gov/#caseNumber=75360102&caseType=SERIAL\\_NO&searchType=statusSearch](http://tsdr.uspto.gov/#caseNumber=75360102&caseType=SERIAL_NO&searchType=statusSearch) ;

[http://tsdr.uspto.gov/#caseNumber=75360104&caseType=SERIAL\\_NO&searchType=statusSearch](http://tsdr.uspto.gov/#caseNumber=75360104&caseType=SERIAL_NO&searchType=statusSearch)

The statutory position as well as the view adopted by the judiciary in the U.S.A. regarding the admissibility and registrability of non-traditional trademarks is perhaps the most liberal and inclusive out of any in the world. Even though the Sieckmann ruling had a major precedential impact, its stark rigidity has not seeped through the framework of olfactory trademark registration in the U.S.A.

## **POSITION IN INDIA**

As stated at the start of this work, the question of registrability and forms of Trade Mark in India are governed through the provisions of the Trade Marks Act, 1999.<sup>46</sup>

As is the case with almost all the international conventions, treaties and agreements on this particular subject, the Indian legislation lays great fundamental importance on the ability of a trademark being represented graphically vis-à-vis its admissibility and registration. It primarily deals with marks which are capable of being represented graphically and which are capable of distinguishing the goods or services of one person from those of others. Admissible marks under the legislation have come to include the shape of goods, their packaging and combination of colours also.

But smell marks have a precarious position in the context of the Indian scenario. Their recognition and registration would be a difficult prospect to put into practice mainly because of the rigid statutory force against it and also because of other reasons like inadequate infrastructural requirements for a mark's testing and analysis and increasing homogeneity between domestic and international products.

Nevertheless, it would be wrong to suggest that there is a complete ignorance and rebuff towards the question of admissibility of non-traditional trademarks. Although the aspect of graphical representation still holds the primary requirement to be fulfilled by a prospective registered trademark, the judicial and administrative bodies have allowed for registration of certain non-traditional trademarks when it was adequately shown that such mark clearly distinguished the goods it related to from other relevant products in the market.

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<sup>46</sup> *Supra*, 2 & 3

This can be seen through the following cases and instances:

- In a trademark infringement case of the product of lighters bearing the well-known registered trademark of Zippo Lighters, the **Delhi High Court** in the case of **Zippo Manufacturing Company vs Anil Moolchandani & Ors.**<sup>47</sup>, while granting protection to the Plaintiff Company for its trademark protection, recognized the same on the basis of the unique shape of its cigarette lighters.
- One of the most prominent instances of non-traditional trademark registration in India is the **registration of a sound mark by Yahoo**. The well-known sound of a human voice yodeling the words “Yahoo” was granted registration as a trademark in 2008.<sup>48</sup>
- **Nokia** has also registered the sound of the guitar tunes playing whenever one of their devices is switched on.
- Also, the **National Stock Exchange** trademarked its theme song.
- **ICICI bank** has trademarked their ‘corporate jingle’, well-known and used in their commercial advertisements prominently.
- **Britannia** has also registered a sound trademark of their famous tune of four notes bell.

In the year **2009**, the Trade Mark Office in India constituted a **Draft Manual on Trade Marks** which related to the practice and procedure of registering trademarks in India.<sup>49</sup> The manual gave a considerable amount of impetus to non-traditional trademarks and their registrability. The Draft Manual has been the first and only piece of official communication on the state of non-traditional trademarks in India. The Manual extensively talks about the aspects of non-

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<sup>47</sup> Zippo Manufacturing Company vs Anil Moolchandani & Ors., (2011) 185 DLT 51

<sup>48</sup> Available at <http://www.livemint.com/Home-Page/5z2B1NQYy3YyPkpRDp789M/Yahoo-awarded-India8217s-first-sound-mark-Nokia-in-queue.html>

<sup>49</sup> Available at [http://www.ipindia.nic.in/writereaddata/Portal/IPOGuidelinesManuals/1\\_32\\_1\\_tmr-draft-manual.pdf](http://www.ipindia.nic.in/writereaddata/Portal/IPOGuidelinesManuals/1_32_1_tmr-draft-manual.pdf)

traditional trademarks vis-à-vis their registrability by methods and standards of evidence examination related to such marks.<sup>50</sup>

With regard to smell marks, the Draft Manual states that, “Consumers of such fragranced goods are unlikely to attribute the origin of the products to a single trader based on the fragrance. Whatever may be the case, for purposes of registration as a trade mark, unless the mark is ‘graphically represented’ it will not be considered to constitute as a trade mark.”<sup>51</sup>

The Manual puts it very bluntly that a smell mark can be registered in India only if it is able to be represented graphically, so that the primary purpose it being capable of differentiating one product from the other for the consumer can be achieved with ease.

Even though the Draft Manual on Trade Marks has not been incorporated into the Trade Marks Act, 1999, as stated hereinabove, it is the sole clear and tangible source on the state of non-traditional trademarks in India.

## **THE EUROPEAN UNION REGULATION OF 2015**

On 16<sup>th</sup> December, 2015, the European Parliament and its Council adopted a new regulation concerning community trademarks.<sup>52</sup> Consequently, the Regulation amended the earlier Council Regulation (EC) No. 207/2009 on the Community trade mark<sup>53</sup> and its corresponding Regulation no. 2868/95 of its implementation.

This regulation contained multiple amendments, among others terminological ones, such as the change of the name of the Office for Harmonization in the Internal Market (OHIM), which subsequent to the amendment came to be known as the ‘European Union Intellectual Property Office’ (EUIPO), and the replacement of the name “Community Trade Mark” by the name “European Union Trade Mark”.

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<sup>50</sup> *Ibid*, Page 84

<sup>51</sup> *Ibid*, Page 86

<sup>52</sup> Council Regulation (EU) 2015/2424 of the European Parliament and of the Council, 16<sup>th</sup> December, 2015, Available at [https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=uriserv:OJ.L\\_.2015.341.01.0021.01.ENG](https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=uriserv:OJ.L_.2015.341.01.0021.01.ENG)

<sup>53</sup> *Supra*, 15

But the most significant change which has been brought in with respect to the state of non-traditional marks and olfactory marks in particular, has been incorporated in **Explanatory Statement No. 9 of the Regulation**. The same reads as follows:

*“In order to allow for more flexibility while also ensuring greater legal certainty with regard to the means of representation of trademarks, the requirement of graphic representability should be deleted from the definition of an EU trade mark. A sign should be permitted to be represented in any appropriate form using generally available technology, and thus not necessarily by graphic means, as long as the representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective.”*

As stated hereinbefore in this work, the Sieckmann’s case is the latest binding precedent on the registration of olfactory marks and community trademarks within the European Union. This regulation has confirmed the rules propounded by the Ruling by providing the Sieckmann seven-fold test” as the necessary attributes of a registered non-traditional trademark. The test, which specifically dealt with olfactory marks in the decision of the case, has now been extended to other non-traditional marks by the Regulation.

Nevertheless, the Regulation has expressly provided that graphical representation is not the foremost requirement for the registration of olfactory and other non-traditional marks. A means of generally available technology, practically and easily usable, can be used to represent and denote smell marks. But it is important that the mark, even if not visibly or graphically represented, should mandatorily comply with the Sieckmann seven-fold test, i.e., the mark’s representation should be clear, precise, self-contained, easily accessible, intelligible, durable and objective.

The scope of this normative understanding may still be inflexible and difficult to surmount, but this new implementation has marked a contrasting approach to the global standards of trademark registration which mandate the graphical representation of a mark sought to be registered.



## METHODS OF REPRESENTATION OF SMELLS

From the analysis of various judicial pronouncements and instances of registration of olfactory marks around the world, vis-à-vis the domestic statutory provisions and international regulations, conventions and agreements, a question arises as to how a smell mark comprising of a scent or odour is capable of representation.

The Sieckmann's case which is the foremost precedent on olfactory marks, ruled out the Applicant's use of a combination of a chemical formula, a verbal description and a sample container of the mark's scent for its representation. But, the 2015 Regulation of the European Union has provided for the use of generally available technology in order to represent the olfactory mark. Therefore, it is pertinent to mention the various technological and analytical methods of representing smell marks.

- **Sensory Assessment** is the statistical analysis of human senses including smell for evaluating consumer products. A group of human assessors are tested and basing on the result a company knows 'the insights' about the product. This test includes three processes: analytical testing (the test is based on the number of questions about the product which allow to obtain objective facts about the product), affective testing (includes consumer testing with small focus groups who may be asked to describe or rate a smell) and perception test (which examines the biochemical and psychological aspects of sensation).
- **Scentography** is the technique of creating and storing odour by artificially recreating a smell using chemical and electronic means.

DigiScents Inc was among the more recent pioneers of the technology, developing "DigiScent", which was later renamed as "iSmell", in 1999 as a device that would plug into a computer's USB port and generate scents dependent on the online content being viewed. But the company ceased the trading of this product in 2011.

In 2013, Amy Radcliffe invented a prototype of a camera that recorded and stored smells and odour. The camera, called 'Madeleine', operates by putting the camera's

glass bulb over the subject or the smell environment. An air hose then draws the scent into a trap lined with an absorbent polymer resin. The smell stored in this “odour trap” can then be submitted for consideration and analysis. This machine processes particles of a captured smell and produces ‘a graph-like’ formula of a smell. Basing on the formula it is possible to recreate the precise odour later.<sup>54</sup>

Even though ‘the Madeleine’ is just a prototype it might be the future of olfactory marks. A company that wants to submit a new smell mark would attach not only a textual description, the smell’s chemical formula (if any) and a sample, but also an official graph-like formula from a fragrance lab which would allow recreation of a precisely identical sample of an odour.

But this process involving acquiring the infrastructure, recording of smells and processing the formula in laboratories, could turn out to be a costly process for companies seeking to use ‘the Madeleine’ for representing olfactory marks.

- **Digital Scent Technology** is a specific engineering discipline dealing with olfactory representation. The main goal of this technology is to transmit and receive ‘scent-enabled’ digital media including web pages, video games and movies.

In 2015, a startup named ‘FeelReal’ presented a special mask for virtual reality. This mask contained a cartridge which produces seven unique smells of ocean, jungle, fire, grass, powder, flowers and metal. These smells waft through odour generating vents, which are connected to the headset by Bluetooth and powered by a battery with a four-hour life cycle. The mask is also equipped with dual-sided vents for hot and cold air used for simulating the effect of wind and for the water mist which is sprayed on one’s cheeks.<sup>55</sup>

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<sup>54</sup> Betsy Isaacson, “Scent Camera Called Madeleine Stores Memories as Tiny Perfume Capsules”, available at [https://www.huffingtonpost.in/entry/scent-camera-madeleine\\_n\\_3606779](https://www.huffingtonpost.in/entry/scent-camera-madeleine_n_3606779)

<sup>55</sup> Available at <https://www.mirror.co.uk/news/technology-science/technology/darth-vader-style-virtual-reality-helmet-5614430>

- **‘An Electronic Nose’** is a device used to detect odours. In this case a smell is perceived as a global fingerprint which can be recorded by ‘the e-sensing’ instruments that consists on head space sampling, sensor array and pattern recognition modules for generating a pattern for characterizing odours. At first, ‘an electronic nose’ needs to be trained with different samples of smells in order to create a basic database of reference. After that an instrument can detect new samples comparing them to the compounds in its database and analyze them. However, there is a possibility of wrong interpretation of odours which consist of multiple different molecules as a device might register them as different compounds.
- **‘A Scent Dome’** also known functionally as “smell sampling by PC” is a peripheral device attachable to a PC used for creating smell simulations for the users. The device is manufactured by Trisenx, a company based in Georgia, US. The inner part of the device contains replaceable cartridges filled with aromatic oils, each of which is translated and encoded in a binary mode. Following the digital instructions sent by a computer program or by a digital scent track on a website, these aromatic oils will be heated, so as to vaporize, and released, either individually or in a combination, in order to create thousands of different smells which will be emitted through the device to the nose of the PC user.

Unlike scent samples, the smell released by a scent dome does not face the problems of lack of stability and durability. Moreover, if the digital instructions are given correctly, the olfactory outcome will be precise and, despite the fact that after its emission from the device the scent might soon evaporate, the emission can be repeated as many times as one wishes in order to obtain again and again the precise smell. But the odour recorded and stored in the scent dome can be represented through another system or PC only when it is also attached to a scent dome.<sup>56</sup>

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<sup>56</sup> Will Knight, “Smell device would liven up web browsing”, available at <https://www.newscientist.com/article/dn4705-smelly-device-would-liven-up-web-browsing/>

## CONCLUSION

Through the analysis of the various authorities and international and domestic legislations and rules cited above, it can be easily ascertained that the concept of non-traditional trademarks is relatively new and in its infancy. Even though the general norm relating to the registration of trademarks is that non-traditional marks are not fit for protection under the law due to their inability of being represented graphically or visually, there have been few instances where authorities and Courts have stepped away from this general norm and registered a non-traditional mark. This was down to those marks being able to expressly and definitively distinguish the goods they represented from other related goods in the market.

This particular feature of a trademark being unique, original and distinctive is necessary to achieve its most imperative functions, i.e., protection of the trader/owner of the mark against any infringement of the mark, and the consumer of the goods or services which the mark represents. This was also pointed out by the Delhi High Court in their judgment in the case of **Cadbury India Limited & Ors. v. Neeraj Food Products**<sup>57</sup>. The Court stated the following in **para 73** of the aforesaid judgment:

*“The spirit, intendment and purpose of the Trademark legislation is to protection of the trader and consumer against dishonest adoption of another's well known trademark with the intention of capitalising on the attached reputation and goodwill or dishonest adoption of a trademark which is deceptively similar to the well known trademark. Certainly any other interpretation of the new Act would run counter to the basic intendment of the law.”*

There lies the dilemma with respect to granting protection to non-traditional trademarks. Going by the just and generally acceptable rationale adopted by the Delhi High Court, as quoted above, it is not tough to understand as to why the majority of the cases of registration of non-traditional marks, particularly olfactory marks, around the world, have led to rejection of the grant of registration to them.

It is true that a bare understanding of the traditional concept of olfactory marks would suggest that they would be susceptible to such rationale because of high chances of infringement of

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<sup>57</sup>Cadbury India Limited & Ors. v. Neeraj Food Products, 142 (2007) DLT 724

marks through mainly replicating the chemical formula and verbal description of the marks. This was mainly the reason (the functional reason being chances of confusion to the public and inability of the mark to distinguish the goods it represented) why the Applicant's mark's chemical formula, its verbal description and a sample of the odour were held inadmissible in the Sieckmann's case.

This scenario has seen a considerably progressive change with the possibility of registration of non-traditional marks, particularly olfactory marks, appearing relatively more promising. The most formidable step in this regard has been the implementation of the latest European Regulation of 2015.<sup>58</sup> As mentioned above, the Regulation has done away with the requirement of a trademark to be graphically represented for it to be registered. Upholding the 'Sieckmann seven-fold test' the Regulation has mandated that a mark should be fit enough to achieve its primary purpose which is to eliminate any possibility of confusion in the public or any chances of infringement of the mark, thus requiring it to be distinctive and unique.

The purpose sought to be achieved through this new Regulation has also been resonated in the **Trans-Pacific Partnership Agreement (TPP)** signed by Australia, Brunei, Canada, Chile, Japan, Malaysia, Mexico, New Zealand, Peru, Singapore, the United States of America and Vietnam on **4<sup>th</sup> February, 2016**. **Article 18.18** of the Agreement, dealing with Trade Marks states the following:

*“No Party shall require, as a condition of registration, that a sign be visually perceptible, nor shall a Party deny registration of a trademark only on the ground that the sign of which it is composed is a sound. Additionally, each Party shall make best efforts to register scent marks. A Party may require a concise and accurate description, or graphical representation, or both, as applicable, of the trademark.”*<sup>59</sup>

With respect to the admissibility of olfactory marks among other non-traditional marks, there is no dispute or question with regard to the stance of the **U.S.A.** The difference of evidentiary and procedural regulations between traditional and non-traditional marks is very thin, with the

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<sup>58</sup> *Supra*, 52

<sup>59</sup> Available at <https://www.mfat.govt.nz/assets/Trans-Pacific-Partnership/Text/18.-Intellectual-Property.pdf>



requirement of distinctiveness, uniqueness and accuracy of the marks common to both, as is evident from the various authorities and instances sighted above.<sup>60</sup>

As far as the **U.K.** is concerned, although there were instances of registration of olfactory marks coinciding with the enactment of the Trade Marks Act, 1994<sup>61</sup>, but the John Lewis Case<sup>62</sup> and the Myles Ltd. Case<sup>63</sup> have set the stringent precedent of the opposite. Similarly, in the **European Union**, the Eden SARL Case<sup>64</sup> and the Ralf Sieckmann Case<sup>65</sup> in particular, have refused registration of olfactory marks due to the same being incapable of requisite accuracy and distinctiveness. But the 2015 Regulation has dealt away with requirements of graphical representation and upheld the Sieckmann seven-fold test for ascertaining the admissibility and registration of olfactory and other non-traditional trademarks.

**India** has never seen the registration of an olfactory mark, but there have been notable instances where other non-traditional marks like colour combinations and sound marks have been successfully registered.<sup>66</sup> Based on the said provisions cited above, it can be understood that the statutory position in India is not very favourable towards the registration of olfactory marks. Even though olfactory marks have not been brought into the picture, the state of other non-traditional marks has been considerably improving. Even with the stark challenges involved in the admissibility of olfactory marks, it may just be a matter of time when India follows the international standard and comprehensively practices registration of olfactory trademarks.

In a functional sense, Esther Gomez proposes and explains in her Article that an olfactory trademark is most likely to be regarded as devoid of any distinctiveness if the mark is used for products having a scent, like candles, or where the smell or scent is the product itself, like perfumes, fresheners and purifiers. It would be difficult to establish the distinctiveness of the mark in these cases. Whereas, where the smell mark is sought to be registered for products generally not having any characterizing smell, then such marks entail a higher chance of protection via registration thereof.<sup>67</sup> This has been particularly seen in the *Vennootschap Case*

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<sup>60</sup> *Supra*, 33 to 45

<sup>61</sup> *Supra*, 17 to 19

<sup>62</sup> *Supra*, 22

<sup>63</sup> *Supra*, 23

<sup>64</sup> *Supra*, 24

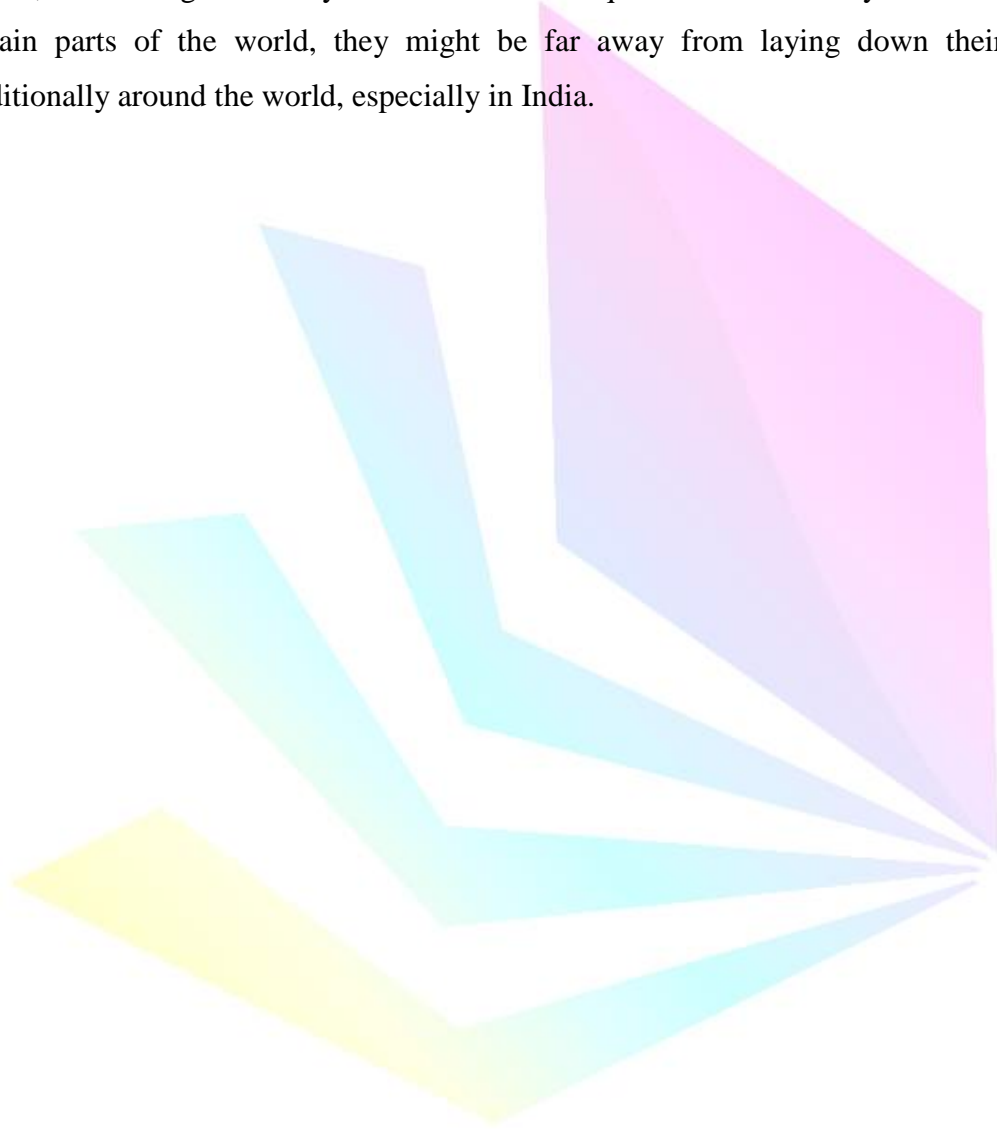
<sup>65</sup> *Supra*, 27

<sup>66</sup> *Supra*, 47 & 48, and Page no. 15

<sup>67</sup> Esther Gomez, "The new EU Regulation and olfactory trademarks", 25.04.200

involving tennis balls<sup>68</sup>, Sumitomo Rubber Co.'s application for automobile tires<sup>69</sup>, Unicorn Product's successful registration for flight darts<sup>70</sup>, the Clark, *In Re* Case involving embroidery yarn<sup>71</sup>, Verizon's smell mark registration for mobile phones and communication devices<sup>72</sup> and various other instances as cited hereinabove.

Therefore, even though olfactory trademarks have acquired a considerably formidable status in certain parts of the world, they might be far away from laying down their marker unconditionally around the world, especially in India.



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<sup>68</sup> *Supra*, 21

<sup>69</sup> *Supra*, 18

<sup>70</sup> *Supra*, 19

<sup>71</sup> *Supra*, 35

<sup>72</sup> *Supra*, 38