

TRACING THE JURISPRUDENCE OF SMELL MARKS AS A TRADEMARK

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ABSTRACT

Trademarks distinguish goods and services of one person from those of others by acting as indicators of their source. Any trademark law is founded upon the object of safeguarding reputation, and ensuring that the benefits of the said reputation or marks are reaped by owners of the mark, and not their competitors. The smell acts as a potent olfactory sense on which one relies blindfold for his or her daily chores. As evident as it is, many industries, such as perfume and deodorant manufacturing entities, are thriving solely on the basis of smell and are churning are millions of business. Thus, it becomes pertinent to single out those products which are identifiable to its consumer diaspora on the account of its scent. With the advancement in technology, it has become easier to distinguish a particular smell of a particular smell from another smell of other similar product. This, facilitates the need for cementing smell marks as a viable trade mark. Through the course of the paper, we establish the position of smell marks in other leading countries and scope of inculcating it within the definition of a trademark as defined under various treaties and conventions.

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I. TRADEMARKS: AN OVERVIEW

Generically speaking, a trade mark could be said to entail any word, symbols, name, device, packaging, shape of goods or combination of colors or any combination which is capable of lending the distinctiveness to the goods being produced and marketed under the mark so adopted.

As per Section 2(1)(zb) of the Trade Marks Act, 1999 defines trade mark 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 colors.¹ Moreover, Section 2(1)(m) of the Trade Marks Act, 1999 stipulates that a mark includes a device, brand, heading, label, ticket, name signature, word, letter, numeral, shape of goods, packaging or combination of colors or any combination thereof.²

The purpose which the adopted Trade Mark serves is three-fold: (i) it distinguishes a particular product from similar other product by identifying its source or origin which helps in preventing any kind of confusion or deception amongst the consumers of that particular product (ii) it protects the trade and business of the trade mark owner and also the goodwill which the Trade Mark has capitulated over the period of years of its trade. (iii) it gives the assurance that the goods bearing a particular Trade Mark are of an equal quality-wise. Also, it serves as an instrument of the advertisement of the particular product.³

In the case of *Cluett Peabody & Co. Inc. v Arrow Apparels*⁴ it was observed by the Bombay High Court that the protection of the proprietary rights of the holder of a registered Trade Mark is the object of the Trade Mark legislation. Later, In the case of *Ramdev Food Products Pvt. Ltd. v Arvindbhai Rambhai Patel*⁵ it was observed by the Supreme Court that the establishment of a connection between the goods being sold and its source thereof suggesting the quality of goods is the intrinsic purpose of the Trade Mark.

More recently, In the case of *Cadbury India Limited v Neeraj Food Products*⁶ it was observed by the Delhi High Court that the prevention of dishonest adoption of one's Trade Mark with the

¹ Section 2(1)(zb), Indian Trade Marks Act, 1999.

² Section 2(1)(m), Indian Trade Marks Act, 1999.

³ JT McCarthy, Trademarks and Unfair Competition, Vol 1, New York, 1973, p 86.

⁴ *Cluett Peabody & Co. Inc. v Arrow Apparels*, (1998) 18 PTC 156 (Bom).

⁵ *Ramdev Food Products v Arvindbhai Rambhai Patel*, (2006) PTC 281 (SC), p 300.

⁶ *Cadbury India Limited v Neeraj Food Products*, (2007) 35 PTC 95 (Del), p 126.

intention of making profits by the virtue of the reputation and goodwill attained by that Trade Mark is the core spirit of the Trade Marks Act, 1999.

Under Rule 2(k) of the Trade Marks Rules, 2002 it is a pre requisite that the Trade Mark sought to be registered should be capable of being represented graphically.⁷ With this regard, the United Kingdom has taken a step forward and has made the sound marks, whose notations could be written down, and the smell marks, which are capable of being given a definition in terms of its chemical components aided by chromatographical analysis, as eligible for registration.

II. NON TRADITIONAL MARKS

The term Non Traditional trademarks pertains to those trademarks which do not fall under the ambit of the conventional definition of a trademark. These marks are not confined to words, symbols, name, device, packaging or combination of colors but extend to three dimensional marks, sound marks, motion marks, position marks, hologram marks, slogans, feel marks, smell marks and taste marks. Due to the dynamics with regards to the term 'trademark' many of such non-traditional marks has become widely accepted which has been reflected in many inclusive legislations and international treaties such as Agreement on Trade Related Aspects of Intellectual Property Rights. However, graphical representation of such non-traditional marks is an issue to be resolved.

III. SMELL MARKS

Smell 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 sense which is capable of registering itself in the human memory. However, as mentioned earlier, the registration of a smell mark has been enabled subject to the fulfilling of the condition that the smell is graphically represented. This condition is the vortex of the problem with regards to its registration. Merely writing down of the chemical components of the smell is not accepted as it is said to be attributed to the substance itself rather than the smell of the substance. 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

⁷ Rule 2(k), Trade Marks Rules, 2002.

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.

IV. POSITION IN UNITED STATES OF AMERICA

In the USA, the trademark milieu is governed by the Lanham Act which protects those trademarks and the rights of its holders. Section 45 of the Lanham Act, 1946 defines trademark 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 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.”*⁸

This definition, though, does not include smell marks but there is no express exclusion of smell marks of the same. This gap was further bridged in the case of *Two Pesos, Inc. v Taco Cabana Inc.*⁹ where it was held by the US Supreme Court that the Trade dress may entail size, shape, color or color combinations, texture, graphics, or even particular sales techniques within itself.¹⁰ Here, it is pertinent to mention that ‘trade dress’ includes Sensory marks such as smell or color.¹¹

The breakthrough was achieved in *In re Clarke*¹² case where a newly manufactured sewing and embroidery yarn was rejected trademark registration citing the non-distinctiveness of the product from other similar products as the reason. This was argued against by the Petitioner contending that his product was the only scented embroidery yarn being manufactured in the market giving it high impact, floral smell like that of Plumeria Blossoms.¹³ However, this contention of the Petitioner was rejected on the grounds that he failed to associate the scent to the origin of the product and that the scent was not specified on its packaging.¹⁴ Aggrieved, the Petitioner preferred an appeal to the Trademark Trial Appeal Board (TTAB), wherein TTAB opined that a scent is very well capable of distinguishing a product from others. TTAB held that the Petitioners’ product was the only yarn in market with a scent and advertised on the similar

⁸ Section 45, The Lanham Act, 1946.

⁹ *Two Pesos Inc. v Taco Cabana Inc.*, 505 U.S. 763.

¹⁰ *Ibid.*

¹¹ Schechter, *The Rational Basis of Trademark Protection*, Harvard Law Review, 40 (1927) 813.

¹² *In re Clarke*, 17 U.S.P.Q.2d 1238, 1239 (T.T.A.B. 1990).

¹³ *Ibid.*

¹⁴ *Ibid.*

lines and that it has been associated to the origin of the products. Consequently, TTAB gave the yarn a trademark registration reasoning that a unique scent is a prima facie case for distinctiveness of its mark.¹⁵

The judgement given by TTAB in *In re Clarke* was acknowledged by the US Supreme Court in *Qualitex Co. v Jacobson Prods. Co.*¹⁶ 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.*”¹⁷

Therefore, it could be said that smell marks are qualified to registered as a trademark in the USA and is permissible owing to the coupled effect of the judicial decisions and the statutory provisions.

V. POSITION IN UNITED KINGDOM

Trade Marks in United Kingdom are governed by the United Kingdom Trademarks Act, 1994. The day the UK TMA came into existence, Chanel tried to register smell mark as a trademark for its product ‘*Chanel No 5*’ and attempted to represent the smell mark graphically by describing their perfume 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.*’¹⁸ This application as unsuccessful as perfume was not only the smell mark but the end product in its finality and could not be considered as an indicative of the origin of the product.

On the same day, two more application were made to register scent as a trademark whereby Sumitomo Rubber Co. pitched scent of ‘*floral fragrance reminiscent of roses as applied to tyres*’¹⁹ and Unicorn Products pitched the scent of ‘*the strong smell of bitter beer applied to flights for darts*’²⁰ as a trade mark for their end products and both of them were granted registrations.

¹⁵ *Ibid.*

¹⁶ *Qualitex Co. v Jacobson Prods. Co.*, 17 U.S.P.Q.2d 1240 (TTAB, 1990).

¹⁷ *Ibid.*

¹⁸ Chanel’s Application, 31 October 1994.

¹⁹ Sumitomo Rubber Co’s Application No. 2001416, 31 October 1994.

²⁰ Unicorn Products’ Application No. 2000234, 31 October 1994.

Later, In *John Lewis's* case²¹, scent mark of 'the smell, aroma or essence of cinnamon'²² was sought to be registered as a trademark in relation to furniture products. It was denied registration by the Principal Hearing Officer as he reasoned that an individual's perception of would vary depending on the circumstances, that the scent could not stand just by itself as it lacked definition and that it was not precise enough so as to eliminate any sorts of confusion which might arise due other similar smells.

Similarly, in *Myles Limited's* case²³, the registrability of 'the scent of raspberries' with respect to fuels, including motor fuels, particularly diesel as heating fuel, fuel and engine fuel²⁴ was in question. The scent was denied registration on the ground that even though it could be represented graphically, it lacked distinctiveness as an attribute.

More importantly, in *Sieckmann v Deutsches Patent-und Markenamt*²⁵ case, 'the smell of balsamically fruity with a slight hint of cinnamon'²⁶ was not considered as registrable as it was found to be unobvious to the average consumer. This case did not consider and ruled out written descriptions, chemical formulas, samples, electronic sensory analysis and graphic profiles as a means of identification of the smell. Thus, this case onwards, the registrability of smell marks as trademarks have come to a halt given its precedential value.

VI. POSITION IN INDIA

Trademarks in India are governed under the Indian Trade Mark Act, 1999 and it entails within itself any 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 colors.²⁷ Hence, as an observation it could be said that the Indian law defining Trade Mark is on the similar lines as that of the International Conventions and treaties. It could be considered as semi-permeable with regards to smell as though there is no express inclusion of non-traditional marks in the definition but at the same time there is no specific exclusion as well. Further it is stipulated that a mark includes a device, brand, heading, label, ticket, name signature, word, letter, numeral, shape of goods, packaging or

²¹ John Lewis of Hungerford Ltd's Trade Mark Application p [2001] RPC 28.

²² *Ibid.*

²³ Myles Limited's Application [2003] ETMR 56, decided on 5 December 2001.

²⁴ *Ibid.*

²⁵ *Sieckmann v Deutsches Patent-und Markenamt*, Case C-273/00, 2003 E.T.M.R. 37.

²⁶ *Ibid.*

²⁷ *Supra* 1.

combination of colors or any combination thereof.²⁸ This express definition of ‘mark’ acts as a hindrance as it is exhaustive in its nature and restricts the scope for registration for any mark other than those mentioned in the definition given above.

The problem with registration of non-traditional marks like smell marks is that it cannot be represented graphically. However, the Indian Judiciary broke the conventionality by granting protection to the manufacturers of Zippo lighters on the basis of the shape of its Lighters to keep its counterfeiting in check.²⁹ Further, the boundary was pushed wherein Yahoo! registered its sound under the Indian Trade Mark Act, 1999.³⁰

Later, in the year 2009, the Trade Mark office came up with a Draft Manual which gives the non-traditional marks distinct concern and entails certain provisions which deal with the same. As of now, the provisions of the Draft Manual have not been incorporated into the Indian Trade Mark Act, 1999. Consequently, the registration of smell marks as a singular trade mark have not seen their road to finality.

VII. CONVENTIONS AND TREATIES: PAVING THE WAY FOR SMELL MARKS

The Paris Convention does not define a trademark since the member States could never reach a conclusion on it. Moreover, the Convention also does not provide any indication as to how are rights over trademarks obtained, leaving it to the discretion of the national laws of the member states. The scope of a mark has also not been conclusively laid down in the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks. These inconclusive definitions have led some experts to opine that non-conventional marks such as smell and sound marks could be inferred to be eligible to protection under these Conventions.³¹

The TRIPS Agreement defines trademark on a functional basis, that is, on the distinctiveness of the function of trademarks. Though Article 15(1) provides a list of marks that can be considered to be trademarks, the list is non-exhaustive. Neither does the definition conclude whether non-conventional marks in the nature of smell marks be considered as a trademark, nor does it explicitly exclude non-visual trademarks from its definition completely.

²⁸ Supra 2.

²⁹ Zippo, IA 7356/2006 (Delhi High Court); <https://spicyip.com/2006/08/zippo-shape-mark-protected-by-indian.html> last accessed on 2:00 PM, 11/2/2017.

³⁰ Manoj P, *Yahoo Awarded India's First Sound Mark; Nokia in Queue*, Live Mint, 7 (2008); <http://www.livemint.com/Home-Page/5z2B1NQUy3YyPkpRDp789M/Yahoo-awarded-India8217s-first-sound-mark-Nokia-in-queue.html>, last accessed on 1:00 PM on 12/2/2017.

³¹ Pires De Carvalho, Nuno, *The TRIPS Regime of Trademarks and Designs*, Kluwer Law International, 2011.

However the provision also provides that “members may require, as a condition of registration, that signs be virtually representable” which has led many experts opine that the definition was intended to limit itself to only conventional trademarks that can be visually perceptible.³² The author is of the opinion that the definition under the TRIPS Agreement being primarily functional and non-exhaustive, it has left open the possibility of inclusion of non-conventional trademarks within its ambit.

The Singapore Law Treaty by making an amendment to the Trademark Law Treaty of 1994 is the first International instrument to recognize non-conventional marks. Article 2 of the Singapore Treaty provides for the possibility of protecting hologram marks, sounds, smell and others, which had not been covered by the Trademark Law Treaty in the first place. These treaties though focusing more on procedural rather than substantive aspects of the law, do not oblige the member states to protect these new types of marks. However under the Regulations of the Treaty, one finds the application procedures where these new types of rights have been granted protection.³³ 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.

VIII. CONCLUSION

There is no denying the fact that the olfactory sense of the human being is one of the potent and decisive sense as it communicates straight to the human brain without any conscious efforts or any chain of thoughts. The sense of smell marks our decision in our daily lives as well where various products we use are being purchased on the basis of their smell. Be it deodorants, room fresheners, soaps, shampoos, detergents, colognes, condoms, candles amongst various other things. The market nowadays have started to capitalize on the sense of smell by associating a certain smell to their products. The consumers identify these products by their peculiar smell and trace its origin. This is what precisely a trade mark is supposed to. Hence, it would be in the best interest of all that smell marks are given a singular identification as a trade mark.

Primary reason being, as discussed in the course of the paper, that the scent associated with the product not only helps the product sell but also distinguishes it from other similar products as well. Secondly, the human memory works in a strong tandem with the sense of smell

³² Geravis, Daniel, *The TRIPS Agreement; Drafting History and Analysis*, Sweet and Maxwell, 2003.

³³ Trademark System Subcommittee of Intellectual Property Policy Committee under the Industrial Structure Council (2009) Trademark System Subcommittee: Report on the 20th Non-Traditional Marks Committee Meeting.

and attempts to associate every smell with an object which gives out the same. Thirdly, once a human brain associates a particular smell with a particular object over the period of long usage or exposure to the same, then it gets difficult to replace that scent with another. Lastly, Registration of a smell is markedly different from other marks and with a little more descriptive assistance it could very well meet the requirements as that of trade mark under the Indian Trade Marks Act, 1999.

Though, it is not as easy to incorporate the same in practice, but with Government's intervention and technological advancement it could be converted into real trade practice. A mechanism to demarcate one odour from another, which verifies whether or not that odour is associated with a product available in market and helps the consumers the identify the origin of that product solely on the basis of the smell, would iron out the problems associated with the registrability of the smell and could well establish a smell marks as a viable trade mark.