

LEGAL STATUS OF OLFACTORY MARKS UNDER THE TRADEMARK LAW REGIME

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Abstract

With the gradual advancement of Intellectual Property Law with time, there has been an emergence of certain unconventional marks that have been excluded from Trademark protection in certain jurisdictions, including the Indian IPR regime. One of these unconventional marks is an “Olfactory Mark”. A “Smell” is felt or perceived by an individual by way of the stimuli affecting the olfactory nerves in one’s nasal cavity. Smell is a sense that is used by people to communicate with one another in addition to sight and voice. People have different connections and recollections when they smell things. Although it cannot be mistaken for being similar, it may be protected legally by being registered as a trademark. Numerous studies show that scent has an impact on human behaviour. For example, it is commonly agreed upon that “Petrichor” or the smell of rain when it pours down the earth or mixes with the mud, has a relaxing effect on humans. People are constantly exposed to odours that serve as transmitters of a product's information which is why businesses worldwide wish to have their smell marks protected under the trademark law regime. The aim of this article is to identify the issues arising out of the protection of an olfactory mark under Trademark law and to understand the existing legal framework surrounding olfactory marks in USA, EU, its legal standing in India.

Keywords: Olfactory Marks, Smell, Scent, IPR regime, Trademark law.

1. Concept of Olfactory Marks

Depending on the specific type of products they relate to, olfactory marks may be grouped into three groups, namely:

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1. “**Primary scent markings**” are those that include deodorants, perfumes, and other items that emit scents solely for the purpose of emitting scents and consists of no other function.
2. “**Secondary scent marks**” are items including soaps, beauty bars, body washes, body lotions, serums, detergents etc., that are not used for the object's primary function but where nonetheless, smell serves as an essential characteristic.
3. “**Unique scent markings**” refer to items including an embroidery thread that are not altered in any way by the presence of a smell.¹

By assisting customers in using scent to identify a certain product, olfactory markings help boost their olfactory memory. The item or its wrapping may bear smell marks. However, a mark must be capable of distinction from other similar products in order to receive trademark protection. A distinguishing characteristic of a mark may only be satisfied, in the 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 awareness.”² A mark must be displayed in a clear and particular manner in order to be granted trademark protection.

One of the key objections against trademark protection for smells is that different people may have different perceptions of the same smell. Therefore, even if a scent is distinctive and identifiable, buyers and trademark investigators may associate it with entirely different olfactory experiences. Additionally, a language barrier could make it difficult to discover an accurate and complete description of a mark. Most of the time, when describing a smell, people refer to the thing they connect the smell with rather than defining a specific smell.

¹ 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, 2022).

² 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/legal-articles-publications-law.asp?id=10> (last visited on November 02, 2022).

2. International and European regulations of Olfactory Marks

Unfortunately, neither international nor the European legal frameworks explicitly mention the concept of registering a scent indicator. Olfactory markings are not included under the marks which can be registered as trademarks, but they are also not expressly prohibited from it either.

2.1 Status of Protection of Olfactory marks in the International Legal Regime

The Paris Convention leaves it up to the domestic laws of the individual nations to include or exclude any type of unconventional trademarks from the trademark 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 15 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 perceived.

2.2 Status of Protection of Olfactory marks in the European Legal Regime

As long as a mark can be used to distinguish one product or service from another, and as long as it 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*,”³ as per the most recent amendments to the European trademark regulation, it can be protected as a trademark. A smell mark must also be portrayed “*in a manner which is clear, exact, self-contained, easily accessible, comprehensible, durable, and objective*”⁴ in order to be registered. To get the Office to approve and allow the registering of a trademark, one must figure out the best possible approach to portray an olfactory mark.

2.3 Judicial Interpretations of Protectability of Olfactory Marks in Europe

2.3.1 *Ralf Sieckmann v Deutsches Patent- und Markenamt*

Facts: In this case, Ralf Sieckmann applied a scent called ‘methyl cinnamate’, which was described as having a “balsamically fruity with a slight hint of cinnamon”

³ Regulation (EU) 2015/2424 of the European Parliament and of the Council, “Community Trade Mark and Commission Regulation (EC) No 2868/95 Implementing Council Regulation (EC) No 40/94 on the Community Trade Mark, and Repealing Commission Regulation (EC) No 2869/95” Art 4 (2009).

⁴ European Parliament and of the Council, “Directive (EU) 2015/2436” Recital 13 (2015).

aroma. After Sieckmann's application to register the scent as a trademark was rejected by the German Patent Office, he appealed the decision to the Federal Patent Court of Germany, which referred the case to the European Court of Justice for a preliminary ruling. The European Court of Justice was asked to clarify whether the requirement of graphic representation of a trademark was a valid condition under EU law and whether a chemical formula and a description of the scent could constitute an acceptable form of graphic representation.

The Court's (ECJ) Rationale on association of a smell with that of a product: Being a mark that identifies and distinguishes the products and services of a single enterprise from those of the other is one of the most fundamental characteristics of a trademark. To "*encourage free competition in the market,*" the contrasts and dissimilarities between the marks must be clear to the average customer.⁵ Additionally, a trademark may be seen as a component of communication, a piece of information that a manufacturer provides to the customer to help him get *familiar* with the products. The understanding of a particular mark by customers and manufacturers must be the same and the sign's portrayal must be accurate and clear, in order for information to be conveyed appropriately.

The Court's Rationale on the Graphical representation of an olfactory mark: The submission of an olfactory mark accompanied by a chemical equation, a written account of the scent, and a specimen of the scent may be seen as providing detailed and precise information on the mark, although they occasionally may increase ambiguity. While examining a mark, a person may determine that the scent mentioned in the form and the scent demonstrated in the specimen are different from one another and choose not to issue the registration.

A trademark may include an indication, for instance, in an olfactory mark, that cannot be recognized visually by itself, can be represented graphically using "*pictures, lines, or letters*". In the meantime, submitting an olfactory mark comprising of the chemical representation of a sign, a written description of it, a deposit of an aroma specimen, or a combination of those things is also considered insufficient. The depiction

⁵ Reference for a Preliminary Ruling from the Bundespatentgericht, "Opinion of Advocate General Ruiz-Jarabo Colomer" para 17 (November 6, 2001).

must also be accurate, self-contained, accessible, comprehensible, long-lasting, and objective.⁶ Therefore, in the European standpoint, an olfactory mark is not conferred trademark protection even if a chemical representation of a sign, a written description of it, a deposit of an aroma specimen, or a combination of those things—are all submitted before the Office as they do not satisfy the requirements of a “*graphical representation*”.

2.3.2. *Eden SARL v. Office for Harmonization in the Internal Market case*

In this case, the Laboratories France Parfum SA (LFP) submitted an application for a scent mark with the description “the scent of ripe strawberries and a picture of a fruit as an attachment. The application was initially rejected by the OHIM on the grounds that it did not meet the requirements of graphic representation. LFP appealed the decision to the European Court of First Instance, which upheld the OHIM’s decision.

LFP then appealed to the European Court of Justice, which ruled that a scent mark could be registered as a trademark if it was capable of being represented graphically, and that a picture or graphic representation of the scent could satisfy the requirement of graphic representation. However, the Court also held that a written description alone, without a graphic representation, was not sufficient to meet the requirement. In the case of LFP, the Court found that the picture of the fruit accompanying the description of the scent was not precise enough to enable the scent to be identified with certainty, and therefore the trademark could not be registered. As a result, the Court upheld the rulings of the OHIM and the First Board of Appeal of the OHIM and determined that the olfactory sign in question did not comply with the standards for graphical representation and therefore could not be registered as a trademark.⁷

2.3.3. *Vennootschap onder Firma Senta Aromatic Marketing’s Application*⁸

The applicant filed an application for the registration of a trademark for an olfactory sign with the description “The smell of fresh cut grass” for tennis balls. The application was refused by OHIM on the grounds that the olfactory sign was not capable of being represented graphically and lacked distinctiveness. The applicant appealed the

⁶ *Ralf Sieckmann v. OHIM*, ECLI:EU:C:2002:748, Para. 74.1.

⁷ *Ibid*, para 31 & 40.

⁸ *Vennootschap Onder Firma Senta Aromatic Marketing v. OHIM*, T-331/11, EU:T:2014:555 (2014).

decision to the General Court of the European Union. However, the Board of Appeal later decided that –

Everyone could instantly identify the unique aroma of recently cut grass thanks to personal experience. Many people associate the aroma of freshly cut grass with happy memories of the spring or summer, well-kept lawns or fields, or other similar occasions. The description submitted for the olfactory mark that is being sought to be registered for tennis balls is appropriate, according to the Board, and corresponds with the graphical representation criterion of Article 4⁹ of Community Trade Mark Regulation (CTMR).¹⁰

2.3.4. *Chanel's Trademark Application in the United Kingdom*

In an effort to trademark “Chanel No.5”, the French business Chanel actually filed a trademark application in the United Kingdom in 1994 that included a textual description of a sign. The applicant attempted to register the product’s essence. However, the United Kingdom Office denied the application owing to the nature of the product.¹¹

2.3.5. *Unicorn Products' and Sumitomo Rubber Co.'s applications*

The United Kingdom Trade Mark Registry approved the protection of 2 olfactory marks— Unicorn Products applied to register “*the scent of bitter beer*” for darts (trademark No. 2000234), while Sumitomo Rubber Co wanted to register “*the aroma of flowers*” for tyres (trademark No. 2001416). Additionally, the UK Trade Mark Registry stated in its written notes that “*the practice in respect to this form of trademark is currently evolving.*”¹² However, due to a lack of definition, the Trade Mark Registry declined to register a mark for products of furniture that had the “*smell, fragrance, or essence of cinnamon*” in June 2000 (trademark No. 2000169).

In France, Copyright law is resorted to, to protect scents. Original works produced as a consequence of intellectual activity are protected by French copyright legislation. As a result, a scent created as a result of such action could be covered by French copyright law. The aroma of a perfume, which emerges from the direct application of aptitude, may not profit from the protection of copyright, the French Supreme Court

⁹ European Parliament and of the Council, “Regulation (EC) No 207/2009” Article 4 (2009).

¹⁰ *Case R 156/1998-2, Application No 428.870*, Second Appeal Board, 11 February 1999.

¹¹ The United Kingdom Trade Mark Registry, “Chanel’s Application” October 31 (1994).

¹² *Ralf Sieckmann v. OHIM*, ECLI:EU:C:2002:748, Para. 33.

said in 2006¹³. The applications for olfactory marks are simultaneously published in the French Bulletin *Officiel de la Propriété Industrielle*, but none of them have been registered as of yet.¹⁴

3. Olfactory Marks in The USA

The United States of America was the first to allow the registration of olfactory marks, as opposed to the European Union. The Trademark Review Commission of the United States Trademark Association confirmed after reviewing the Trademark Act of 1946 that “*the terms’ symbol, or device should not be deleted or narrowed to preclude registration of things like a colour, shape, smell, sound, or configuration which functions as a mark.*”¹⁵

3.1. The Case of *In Re Celia Clarke*¹⁶

On September 19, 1990, a trademark for sewing and embroidery thread was registered that had the phrase “*a smell of fresh flowers evocative of mimosa*”. The applicant utilized what is known as ‘*secondary meaning*’ to show that the olfactory mark is distinctive. The applicant showed that buyers can distinguish the goods by the distinctive fragrance of scented yarns and threads, which was recognized by the Appeal Board. Additionally, the Trademark Trial and Appeal Board of the United States noted that this type of registration may only apply to goods that are “used in a non-functional manner” in its decision to grant this trademark, indicating that trademark protection for goods like *Eau de Cologne* or detergent is not possible due to the fact that they noted for such features.

The United States legal system is familiar with the “*secondary meaning*,” which includes the ability to protect a sign regardless of whether it lacks uniqueness but may show the exclusive and continuous use of a certain sign over a set length of time. Nothing shall prohibit the registration of a mark used by the applicant that has distinguished the

¹³ Brad Spitz, “France: No Copyright Protection for Perfume”, *World Intellectual Property Review*, Feb. 17, 2014, available at: <https://www.worldipreview.com/news/france-no-copyright-protection-for-perfume-7345>, (last visited on November 7, 2022).

¹⁴ Reference for a Preliminary Ruling from the Bundespatentgericht, “Opinion of Advocate General Ruiz-Jarabo Colomer” para 17 (Nov. 6, 2001).

¹⁵ United States Trademark Association, Trademark Review Commission, “Report and Recommendations to USTA President and Board of Directors” 375, 421 (1987).

¹⁶ *In Re Celia Clarke*, Serial No. 556840, Appeal No. 94-1549, 38 U.S.P.Q.2d 1197 (Fed. Cir. 1996).

applicant's products in commerce, according to Section 2(f) of the Lanham Act. Consequently, as long as clients consider a sign to be belonging to an entity despite it not being registered, it could be considered to be registered.¹⁷

4. Legal Status of Olfactory Marks in India

Reading Sections 2(1)(zb) and 2(1)(m)¹⁸ of the Trademarks Act, 1999 reveals that the Act has expanded the definition of trademark to encompass forms, packaging, and color combinations. Any mark that can be represented graphically and that may identify the items or services of a single individual from those of others is considered a trademark, according to Section 3¹⁹ of the Draft Manual. However, it has been noted that during registration, additional attention would need to be paid to colours, forms, noises, and fragrances. Additionally, a trademark registration application must include a graphical representation of the trademark in line with Rule 25 (12)(b) of the Brand Rules, 2002, while Rules 28 and 30 dictate that the trademark be displayed on paper, in a permanent manner.²⁰

4.1. Challenges posed in the protection of Olfactory Marks in India

4.1.1 *The issue of being graphically represented*

India does not allow the representation of a trademark in the same manner as the United States, which is more flexible. As was said before, in order for a mark to qualify for registration, a graphical representation is required. Unfortunately, it seems that there is absence of technology that can accurately reproduce the fragrance or scent coming from a product on paper or in any other practical way. This presents a significant barrier to attaching a smell or fragrance mark in India, as well as to its prosecution and compliance. The scent of a product cannot really be represented in the case of smell markings, and just describing or portraying the smell mark using words, chemical formulae, etc. may not be as powerful, clear, and exact as necessary.

¹⁷ The Lanham Act (15 U.S.C. §§ 1052(f)2023), s. 2(f).

¹⁸ The Trademarks Act (Act No. 47 of 1999.)

¹⁹ Draft Manual of Trade Marks- Practice and Procedure, India.

²⁰ The Trademark Rules (2002).

Smell markings do not have any widely acknowledged worldwide categorization of odors, which would simplify the process of recording a smell mark. This is in contrast to color marks and sound marks, which have international classifications like international color codes or musical notations.

4.1.2. Complexity in establishing distinctiveness of the mark

Additionally, it must be demonstrated that a fragrance or aroma did not develop as a result of a natural attribute of the items or goods for which it is used in order for it to become distinctive. It may be challenging to demonstrate the uniqueness achieved by the smell or scent mark or that the aforementioned scent is uniquely connected with that specific brand given that most items marketed nowadays have a pleasant aroma emanating from them.

The accessibility of the smell to the buyer prior to the product purchase is the most fundamental difficulty a smell mark undergoes. If not, the smell's fundamental function as a trademark is thwarted since the customer must wait until the product is used at home before smelling it. He won't be able to associate the smell with the source in this way, which will prevent him from being persuaded to make the purchase.

Another issue that frequently emerges with scent markings is that, despite the fact that a customer may be able to identify the smell or find it familiar, he might not be able to consistently link the smell to the identification of the product or maker. Whether or whether an item's scent serves as a source identification, the manufacturer seeking to prevent infringement of that mark must be able to demonstrate that similar-smelling goods may increase the possibility of misunderstanding.

4.2. The Functionality Doctrine

The functionality doctrine aims to prohibit monopolization over a product feature that might be essential to the competitor entities. This concept states that any aspect of a product that is also a functional component of the product is ineligible for trade mark protection. This presents a significant obstacle for protection of an olfactory mark since it may be practically challenging to demonstrate that a fragrance or smell of a certain product is not the same product's functional characteristic. The idea of functioning poses one of the biggest legal obstacles to the registration of fragrance marks. As per this,

a product's attributes that have the appearance to be a function of it are ineligible for trademark protection. Any valid trademark registration, in this case for fragrance marks, guarantees exclusivity of use for an unlimited length of time, provided that the usage is related to a commercial domain. The functionality doctrine's main goal is to prevent monopolies over important product features that might be extremely important to the product lines of rival companies.

This philosophy might be seen as a means of encouraging healthy competition. However, when it comes to smell markings, the applicability of this notion seems to be iffy. It raises questions about the doctrine's core and opens the path for consequences.

For instance, the pharmaceutical business "*Pohl Boskamp*"²¹ submitted a request for trademark registration for the peppermint flavour and aroma of its nitroglycerin spray used to treat cardiac symptoms. The peppermint flavour was shown to be significantly more effective in treating several types of chest problems when testing was done to determine the validity of the registration. The functional part of the peppermint flavour was therefore given, making this item ineligible for registration. Although the importance of the functioning theory to trademark law is undeniable, cases like those involving olfactory trademarking highlight its restrictive nature, which can obstruct attempts to safeguard potential intellectual property.

5. Conclusion

As we may deduce from the aforementioned standpoints, many approaches have been developed to cope with the use of scent marks in the relevant region. The uniqueness test and distinguishing characteristics are still in the development stage. The requirements that are set forth in relation to these scent marks come from a rather liberal approach rather than an approach that prioritizes the preservation of the public interest. People must first be able to smell the product in order to distinguish it from competing goods before a scent can be considered a unique brand of a product. The aroma will then be the single most influencing factor in a consumer's choice to buy the goods.

²¹ Pohl-Boskamp GMBH & Co. "In Re Pohl-Boskamp GmbH & Co., 106 U.S.P.Q.2d 1042 (TTAB Feb. 25, 2013)", *Lexology*, June 15, 2013, available at: <https://www.lexology.com/library/detail.aspx?g=01526ea5-8d80-4978-811c-aaaa95786d6d> (last visited on November 12, 2022).

The purpose of a trademark is defeated if the customer has wait until the product has been used for the aroma to serve as a trademark. In contrast, James Hawes, an IP lawyer hailing from California, argues that fragrance justifies the product, basing his argument on Hammersley's research.²² According to Hammersley's studies, there is a significant connection between smells and memory. The ability of human memory to form strong connections with scents means that scent markings do affect customer decisions when making purchases of products. They also serve as distinguishing identifiers for identifying goods and services.

Given that traders and product manufacturers use scents as a strong marketing tool, it is argued that India would be required to formulate a new system or alter the Trademarks Act, 1999 to include registration for these non-conventional marks. This is so that the protection be offered to these non-traditional marks as well.

It is clear from this that, despite the fact that Indian registration supports both conventional and non-conventional trademarks, including a variety of them, non-visual trademarks, such as sound markings, there is still a barrier to the registration of marks like scent marks there. This is understandable, given the difficulty in visually expressing the scent markings which would cater to the requirement of being graphically represented. It should be mentioned that other nations throughout the world, including the United States, are implementing new methods and approaches in an effort to promote an increase in the registration of various trade mark types. For instance, the USPTO has waived the limitation that a scent mark must only be represented graphically in order to register in the United States and has permitted delivery of a specimen to the USPTO office. This has prompted several businesses to establish themselves and submit applications for different scent marks in the US. As a result, the next stage should be to embrace new methods and approaches for accepting trademark representation (which need not be graphical). India and EU could revamp their Trademark law regimes or alter the existing ones to include the protection of olfactory marks by repealing the requirement of being represented

²² ZEUSIP, "Can You Smell the Source - an Analysis of Registration of Olfactory Marks," *ZEUS IP Advocates LLP*, available at: <https://www.zeusip.com/can-you-smell-the-source-an-analysis-of-registration-of-olfactory-marks.html> (last visited on January 2, 2022).

graphically in order to receive trademark protection. In this way, the law could be made more liberal, like that of the US Trademark law.

The human body's strongest and most powerful sense is smell, which communicates directly with the brain without any intermediate mental processes. A customer will often choose to purchase certain goods based only on how they smell. Markets have the opportunity to profit from the linkage of a unique fragrance with the product due to the quick development in the marketing regime. Customers' ability to recognize the distinctive scent and trace the product's origins directly complies with trademark law's basic principles. Therefore, giving 'scents' a unique identifier as a trademark is only appropriate. There are unquestionably restrictions on the same, as was mentioned above. However, with a more liberal legislative construct, it is conceivable that prospective smell marks will receive the necessary recognition as a trademark, free from stringent requirements for the same.