

THE INVISIBLE TRADEMARK: SMELL MARK

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ABSTRACT

The landscape of trademark law is evolving, with unconventional trademarks such as scent marks becoming increasingly significant. However, these marks present unique challenges, particularly in their representation and registration. One of the primary issues is the inability to graphically represent smells, which is a requirement under the Trademark Act of India. This poses a significant barrier to the registration and protection of scent marks. Also, while some countries have granted trademark registration for scent marks, India's legislation requires unconventional marks to meet the criteria of graphical representation for registration. This discrepancy highlights a gap in the legal protection offered to unconventional trademarks in different jurisdictions. The emergence of new perfume manufacturers, such as Steal perfume (engaging in business online), and offline manufacturers, that engage in cloning perfumes and selling them at lower prices, underscores the urgent need for robust legislation that recognizes and protects scent marks. The absence of such legislation that recognizes and protects scent marks clearly defines the dire need for proper legislation under the Trademarks Act. As such, the absence of legislation hampers innovation and exposes businesses to potential infringement and loss of intellectual property. This research aims to address these challenges by exploring the need for legislative reforms that acknowledge the unique nature of scent marks and provide them with adequate protection under the Indian Trademark Act.

I. INTRODUCTION

In recent times, the Intellectual Property ["IP"] sphere has gained prominence globally, mirroring its effectiveness and pertinence in the face of burgeoning innovations, creations, and emerging fields of trade and business. The domain of trademarks has witnessed substantial growth, with a wave of distinctive brands and businesses making their mark in the market with distinctive strategies, commodities, and services. Trademarks are pivotal in guiding consumers to identify and differentiate their preferred products and services. Therefore, a business's goodwill and reputation hold paramount importance in commerce. Intellectual Property Law protects these intangible assets by pivotally preserving a business's unique identity. Businesses can achieve this by registering trademarks, serve as unique markers for a business and prevent trademark dilution. The law

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provides mechanisms to act against the infringer if someone infringes upon a registered trademark. Thus, the law ensures the exclusivity of the business's identity and helps keep its reputation unblemished.

Emerging trends in branding and advertising have introduced novel marks, which are becoming critical identifiers for the source of goods and services. These marks, characterised by their unique attributes, stand apart from the traditional ones and fall under unconventional marks. On a global level, numerous jurisdictions have recognized these unconventional marks, such as sound, shape, single colour, texture, and gesture, by way of granting registration as a trademark. The Indian Trademark Law does not explicitly cover or mention the concept of unconventional trademarks, but it does not wholly disregard their significance as well. As per Section 2(1) (zb) of the Trademarks Act, 1999, a "trademark" is defined as any mark that can be graphically represented and can distinguish the goods or services of one entity from those of another. This may include the goods' shape, packaging, and colour combinations.¹ Thus, the law stipulates that any mark that can be graphically depicted can seek protection as a registered trademark. Sound marks, which were recognized recently by way of the 2017 Amendment Act and can be graphically depicted as a sequence of notes with or without words, are eligible for trademark protection. On the other hand, securing trademark protection for non-visual marks such as smell and taste remains a significant hurdle. The primary obstacles in their path are their inability to use graphical representation and specific functional considerations.

The perfume and aroma-centric industries are expanding, with an influx of new manufacturers. A few well-known competitors include Chanel, Victoria's Secret, and many more. The power of aroma in determining individual taste and preference is undeniable, and it plays a crucial role in enabling the human memory to recognize a product. Indeed, scent is one of the most effective ways to distinguish one brand's goods from another's. Beyond the realm of patents and trade secrets, there exists a unique case where copyright protection was extended to the fragrance of a perfume. Lancôme, a cosmetics firm based in France, accomplished this unprecedented legal event for the aroma of its Tresor perfume. This marked the first instance in the legal annals where a scent was granted copyright protection.² Thus, protecting the scent marks should extend beyond the chemical formula used to create a specific, unique aroma. Ultimately, scent plays a significant role in influencing consumers' decisions about which products to choose and to be loyal to.

¹ Trade Marks Act, 1999, § 2(1)(zb), No. 47, Acts of Parliament, 1999 (India).

² Thomas G. Field, Jr., *Copyright Protection for Perfumes*, 45 IDEA 19 (2004).

The landscape of trademark law is undergoing a significant metamorphosis. In the past, trademarks were perceived as mechanisms for consumers to recollect brands and for enterprises to make their goods stand out. However, incorporating sensory aspects into products has broadened the ambit of trademark law with the emergence of novel technologies. A significant adjustment has been made to adapt to these alterations in the European Union [“EU”]. The EU trademark directive has widened its definition to encompass eliminating the necessity for graphical representation and permitting the use of diverse technologies.³ This progress step signifies a transition towards accommodating non-traditional marks, thereby blurring the demarcation between conventional and unconventional trademarks.

As businesses increasingly use sensory triggers to establish well-known brands, the line between these two categories must be more apparent. However, as these boundaries become less distinct, legislative frameworks must evolve alongside them. In countries like India, where the current Trademark Act does not provide a comprehensive definition or protection for unconventional marks, there is a clear need for a robust legislative structure.

Establishing a clear legal framework to facilitate and protect unique trademarks, such as smell and colour marks, is crucial. The merging of conventional and non-conventional marks highlights the need for forward-thinking (consider “progressive”) trademark laws that adapt to market changes. Therefore, as the distinction between conventional and non-conventional trademarks continues to fade, legal systems worldwide need to adapt. By developing inclusive legislation that recognizes and protects sensory elements, countries can enable businesses to innovate and create unique brand identities. This flexibility in trademark laws encourages creativity and competition and ensures that businesses’ intellectual property rights are protected in an increasingly sensory-oriented marketplace.

II. CONCEPT OF SMELL MARK

The power of smell is truly remarkable, with its unique ability to evoke vivid memories and play a significant role in the identification of products. This has led to the emergence of scent marks, also known as olfactory marks, which have become an indispensable tool in the business world. These fragrances assist customers in differentiating between various products. Smell marks can be

³ Trade Mark Guidelines: 9.1 Representation, European Union Intellectual Property Office, <https://guidelines.euipo.europa.eu/1803468/1788866/trade-mark-guidelines/9-1-representation> (last visited Apr. 9, 2024).

classified into three distinct categories: primary, secondary, and unique.⁴ Primary scents are the main attraction of a product, influencing consumers' purchasing decisions. These are typically found in products where fragrance is a key selling point, like deodorants and aroma oils. Secondary scents, while not being a product's central feature, enhance the overall user experience. These are commonly found in products like shower gel and washing powders, where the scent complements the primary function of the product.⁵ In the case of unique scents, they are those that stand out due to their unconventional nature. They add unique characteristics to a product, making it distinctive in the market, like tennis balls with green grass' smell, where the scent adds an additional layer of appeal to the product.

The World Intellectual Property Organization [“WIPO”] does not provide extensive information on smell marks but does mention their potential for registration. There are no WIPO treaties that restrict the types of signs that trademarks across jurisdictions can protect. A survey conducted by the WIPO involving seventy-two trademark offices found that only twenty accepted smell marks for registration.⁶ Under the Agreement of Trade Related Aspect of Intellectual Property [“TRIPS”], no comprehensive list of signs can be granted trademark status. Each state has the autonomy to determine whether invisible marks like smells are included or excluded from trademark protection. The Paris Convention, however, does not provide a clear definition of trademark law, leaving room for interpretation by different countries. Some countries, like the United Kingdom [“UK”] and the United States [“U.S.”], allow for the registration of smell marks through verbal descriptions. However, other countries like India and China exercise caution due to the absence of robust provisions for their protection in Trademark Law.

Olfactory marks play a crucial role in branding. They evoke strong memories and assist in product differentiation. Despite variations in acceptance across different countries, their influence on consumer choice is undeniable. This makes them an intriguing and evolving facet of trademark law that continues to shape the sensory experience with products.

⁴ Yaroslava Kudrina, Non-Traditional Trade Marks and the Abolition of the Requirement for Graphical Representation – EU Trademark Registration Process (Spring 2018) (Master's Thesis, Stockholm University), <https://diva-portal.org/smash/get/diva2:1195299/FULLTEXT01.pdf>

⁵ *Id.*

⁶ World Intell. Prop. Org (WIPO), Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications, WIPO Doc. SCT/16/2, ¶ 46.

III. GLOBAL PERSPECTIVES ON SMELL MARKS REGISTRABILITY

In the ever-evolving global economy, the power dynamics have significantly shifted from an industry-led approach to a consumer-oriented one. Over the past few decades, this transition has placed immense pressure on brand owners and traders to innovate and introduce distinctive products into the fiercely competitive market. One sector that has been flourishing is the fragrance industry. The consumer's fascination with the variety of fragrances, from "agarbattis" and aroma oils to perfumes, has led to a surge in unique scent compositions. Therefore, there is an urgent need to register these unique smells as smell marks for their protection. Recognizing these unconventional marks as trademarks worldwide prompted legislators to consider them a new mark for consumers to identify their unique types of products with distinctive fragrances. However, the current legislation is more adept at protecting traditional marks. For instance, in the case of the renowned fragrance brand Chanel, traditional trademarks such as logos and brand names are well-protected under existing legislation. However, when Chanel attempted to trademark its iconic fragrance, Chanel No.5, based on its unique scent, it faced challenges due to the unconventional nature of the olfactory trademarks. This real-world example illustrates the limitations of current legislation in effectively protecting non-traditional trademarks, such as fragrances, thereby highlighting the need for legislative adaptation to accommodate evolving trends in trademark identification.

The first fragrance granted smell mark registration was the Sumitomo Rubber in the UK for its floral fragrance or smell reminiscent of roses as applied to vehicle tyres.⁷ Later, it was followed by the US receiving its smell mark registration in the year 1990 for a sewing thread and embroidery yarn for having a high impact, floral fragrance reminiscent of Plumeria blossoms.⁸ Even though the international community agreed on the term 'Unconventional Trademark', it has yet to provide a broader and more detailed definition. Due to their wide spectrum and unusual nature, unconventional marks like scent, taste, and texture continue to pose challenges for legislators. While international law does not impose a uniform requirement for the protection of non-traditional marks, it offers a degree of flexibility for national legislators. This allows them to make their own determinations and grant protection to unconventional marks if appropriate. Thus, exploring the global perspectives on the registrability of smell marks and the evolution involved helps understand the gaps in the legal provisions of trademark laws in India.

⁷ Tanushree Roy, *Registrability of Smell Mark as Trademark: A Critical Analysis*, 4 J. CONTEMPORARY ISSUES OF L. 121 (2023).

⁸ Mohit Joshi, *Smell Mark: New Era*, 3 IJLMH, 608 (2020).

A. Singapore

Singapore has emerged as a prime example of a jurisdiction that boasts economic sophistication and legal maturity, especially when it comes to IP rules. Over the years, Singapore's IP laws have evolved significantly, notably in the realm of smell marks registration. The pivotal changes occurred through legislative amendments, such as the Singapore Trademarks Act of 1998 and the Trademarks Amendment Act of 2004.

In 1999, the Intellectual Property Office's Registry of Trademarks and Patent Office oversaw Singapore's entire spectrum of Intellectual Property Laws by acceding to the Madrid Protocol Trademark. A pivotal moment came with the Trademarks (Amendment) Act of 2004, aligning Singapore's regulations with the United States Singapore's Free Trade Agreement (USSFTA). Before this amendment, trademark definitions were limited to visually perceptible signs.⁹ However, the 2004 amendment broadened the scope, encompassing unconventional marks like shapes, smells, sounds, colours, and even motion marks. Thus, the very definition of a trademark underwent a fundamental shift. It transformed from "*any **visually perceptible** sign capable of being represented graphically*"¹⁰ to "*any sign capable of being **represented graphically** and which is capable of distinguishing goods or services.*"¹¹ Crucially, this change marked a departure from the traditional two-dimensional concept of words or graphic marks. Now, even non-traditional marks like smell can be registered, signifying a significant legal paradigm shift. This amendment meant that trademarks no longer needed to be visually perceptible for registration. Instead, they must be precisely identifiable and presentable on the trademark register. This shift opened doors for unconventional trademarks, embracing the intangible, such as scent marks. However, despite these advancements, challenges abound. Smell marks, in particular, pose conceptual difficulties due to their intangibility. These ambiguities create hurdles for both inventors and manufacturers of olfactory marks seeking IP protection, as well as for legal systems striving to adapt to these novel trademarks. The evolving landscape of Singapore's IP laws reflects a progressive approach, yet the complexities of registering smell marks highlight the ongoing need for nuanced legal solutions in this domain.

As the familiar elements like logos or words have traditionally dominated the landscape of trademark registration, however, the drive to individualize products and services, coupled with innovative marketing strategies, was employed in the business to set them apart. Unique packaging, distinct shapes, specific colours, scents, and even motion marks have become integral parts of

⁹ Trademarks Act, 1998, § 2(1) (Singapore).

¹⁰ *Id.*

¹¹ Trade Marks (Amendment) Act, 2004, § 2(1) (Singapore).

marketing and branding. Under certain conditions, the modern trademark laws have adapted to this shift, allowing for a broader range of trademarks. The Singapore Treaty on the Law of Trademarks, enacted on March 16, 2009, marked a pivotal moment in recognizing unconventional marks. As a result of the 2006 diplomatic conference in Singapore, this treaty brought together 147 WIPO member states to create an international framework that is modern for harmonising procedures for trademark registration.¹² While the treaty defined criteria for reproducing non-conventional marks like colour, motion, scent, and holograms, it did not mandate global protections.¹³ Nevertheless, it provided representation methods for non-graphic or photographic reproductions, explicitly acknowledging trademarks beyond two-dimensional traditional marks.¹⁴

Currently, unconventional marks are not widespread, but WIPO anticipates their rise in popularity. As businesses continually seek fresh ideas to promote their products in an ever-changing market, these non-traditional trademarks are poised to gain traction over time. In essence, the evolving landscape of trademark law reflects the innovative businesses worldwide. Trademarks have transcended their conventional forms by embracing diverse elements such as shapes, colours, sounds, and even scents. Thus, this Singapore Treaty stands as a testament to this evolution, offering a framework to accommodate these novel trademarks on a global scale. While unconventional marks are still on the rise, they undoubtedly represent the future of branding in our dynamic market. Thus, the advent of the Singapore Treaty has revolutionised the concept of trademarks by recognizing non-conventional trademarks. This treaty thereby paves the way for a new era in branding with the potential for even more innovative forms of trademarks on the horizon; Businesses are encouraged to explore diverse avenues and ensure their products and services stand out in an ever-competitive market.

B. New Zealand

In 1999, New Zealand made a significant legal stride by amending its Trademarks Act of 1953¹⁵ through significant changes in the definitions of signs and trademarks. According to the revised law, a **Trademark** is defined as “*any sign capable of being represented graphically and distinguishing the goods or services of one person from those of another person.*”¹⁶ The critical amendment expanded the concept

¹² Marcus Hopperger, *Non-Traditional Marks – Singapore Treaty Enters Into Force*, WIPO (Feb. 2009), https://www.wipo.int/wipo_magazine/en/2009/01/article_0002.html.

¹³ *Summary of the Singapore Treaty on the Law of Trademarks*, WIPO, https://www.wipo.int/treaties/en/ip/singapore/summary_singapore.html (last visited Apr. 9, 2024).

¹⁴ *Id.*

¹⁵ Trademarks Act of 1953, New Zealand Parliamentary Debates, (1998) 567 NZPD 8298.

¹⁶ Trademarks Act, 2002, § 5(1) (New Zealand).

of **Sign** to include “*a brand, colour, device, heading, label, letter, name, numeral, shape, signature, smell, sound, taste, ticket, or word; and combination of signs.*”¹⁷ This subtle yet impactful alteration broadened the scope of registrable unconventional trademarks, allowing the registration of previously unconventional marks that are invisible, like taste and scent.

Prior to this amendment, companies like Boots Company PLC faced challenges in registering unique trademarks when it attempted to register a cinnamon smell mark for pharmaceutical products but was unsuccessful due to the absence of graphical representation.¹⁸ The amendment ratified this, ensuring that trademarks could mirror the contemporary business’ diverse and innovative nature. This transformation was spurred by global trends, aligning New Zealand with international practices. This inclusivity of unconventional marks was to acknowledge that trademarks were not confined to merely visible marks but could transcend the visual realm by encapsulating sensory experiences like smell, sounds, and tastes in the modern market.

Crucially, the aim of the amendment was not a bid to establish monopolies but rather to foster healthy competition. Thereby, by embracing inclusivity in trademark definitions, New Zealand positioned itself on par with progressive nations, accommodating the evolving needs of businesses. This amendment hindered New Zealand from being open to inventive, unique, and unconventional strategies, providing a conducive environment for businesses to thrive. By including intangible trademarks, New Zealand was at the forefront of intellectual property law, paving the way for other nations to follow similar inclusive definitions for the concept of trademark. This amendment stood as a testament to New Zealand’s commitment to fostering creativity, protecting originality, and ensuring that its legal framework reflected the dynamic, diverse, and inventive landscape of the 21st century.

C. United Kingdom

Prior to the amendment of the UK Trademark Act in 1994, trademarks were defined as “*any sign capable of being represented graphically that can distinguish the goods or services of one undertaking from those of other undertakings. That particularly consists of words (including personal names), designs, letters, numerals, or the shape of goods or their packaging.*”¹⁹ However, with the revision of Section 1 of the Trademark Act, the definition was broadened to include “*any sign which is capable of being represented in the register in a manner which enables the registrar and other competent authorities and the public to determine the clear and precise subject*

¹⁷ *Id.*

¹⁸ Application No. 2,000,169, Trade Mark Application Decision (Oct. 15, 2023).

¹⁹ Trade Marks Act, 1994, §1 (United Kingdom).

*matter of the protection afforded to the proprietor, and of distinguishing the goods or services of one undertaking from those of other undertakings.*²⁰ This change made the concept of both traditional and unconventional trademarks more inclusive. Remarkably, only two applications for smell marks have been approved for registration so far—*Sumitomo Rubber's Co.*²¹ successfully registered a scent mark for “*floral fragrance reminiscent of roses*” as applied to tyres and *Unicorn Products*²² secured registration for a “*strong smell of bitter beer applied to flights for darts.*” The distinct smell emitted upon opening the packaging served as a unique recognition point, rendering them eligible for trademark registration.

Despite this inclusive approach, registering scent or smell marks as trademarks in the United Kingdom have proven challenging. Notable instances have proven that the proprietor of the smell marks failed to secure their registration under the UK Trademark Act. A renowned brand, Chanel endeavoured to register its iconic No.5 fragrance as a smell mark. in the United Kingdom, which was the product’s very essence, connected to its functionality. Chanel meticulously described the perfume composition as an “*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.*”²³ However, their application faced rejection as the perfume was not just a smell mark but the end product itself. This inherent functionality made it unsuitable for trademark registration. Moreover, the application lacked a clear indication of origin, further contributing to its registration denial.

In the case of *John Lewis*²⁴, an attempt was made to register the smell of “*cinnamon*” for use concerning furniture, and its components faced rejection despite graphical representations as the application faced challenges because of distinctiveness. Similarly, *Myles Limited*²⁵ sought to register “*raspberry scents*” concerning fuels, including motor and engine fuels, and the application faced rejection because of the same reason of distinctiveness. In the *Sieckmann v. Deutsches Patent-und Markenamt*²⁶ case, an application for the smell of “*balsamically fruity with a slight hint of cinnamon*”²⁷ was denied registration. The rejection was based on the grounds that the chemical formula depicting the scent did not effectively represent the odour of a substance, lacked intelligibility, and was not clear and precise.

²⁰ S. 1(1) substituted (14.1.2019) by The Trademarks Regulations 2018 (S.I. 2018/825), regs. 1(1), 3 (with Pt. 5).

²¹ Application No. 2001416, Trade Mark Application Decision (Oct. 31, 1994).

²² Unicorn Products’ Application No. 2000234, Oct. 31, 1994, (United Kingdom).

²³ Chanel’s Application, Oct. 31, 1994, (United Kingdom).

²⁴ Debrett Lyons, *Sounds, Smells, and Signs*, 7 Australian Intellectual Property Law Bulletin, 73-75 (1994).

²⁵ Myles Limited’s Application [2003] ETMR 56, United Kingdom, (Dec. 5, 2001).

²⁶ *Sieckmann v. Deutsches Patent-und Markenamt*, Case C-273/00, (European Court of Justice 2002).

²⁷ *Id.*

These cases underscore the complexities associated with registering smell marks in the UK. They emphasize the need for clarity, distinctiveness, and a precise indication of origin in the application process to navigate the intricate landscape of trademark registration.

D. United States of America

The trademark system does not explicitly exclude scents from registration in the United States. The key criterion for registration is distinctiveness, not inherent attributes, or natural characteristics of the goods. There is no theoretical or practical barrier to registering scents. The federal statute of the USA, the Lanham Act, defines a trademark as “includes *any word, name, symbol, or device, or combination thereof. (1) used by a person (2) which a person had a bona fide intention to use in commerce and applies to a register established by the act to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others to indicate the source of goods, even if that source is unknown.*”²⁸ The concept of olfactory marks, or smell marks, is not explicitly mentioned in the trademark definition provided by the act. However, this absence does not prevent recognizing smell marks under the act.

The landmark case that paved the way for recognizing scent marks is the *In Re Clarke*²⁹ case. A woman named Celia started selling yarn imbued with the fragrance of plumeria blossoms. Although the United States Patent and Trademark Office [“USPTO”] initially rejected her application for registering the smell mark, the Trademark Trial and Appellate Board later held that it functioned as a registrable mark for sewing thread and yarn. This ruling emphasized that scent trademarks are registrable if the scent is not a natural part of the product and serves as a unique identifier.³⁰ Thus, in the landmark decision, the court established that the registration of a trademark did not necessitate drawings but rather a detailed description of the scent. This ruling is a significant advancement for unconventional marks. It was referenced in the renowned case of *Qualitex Co. v. Jacobson Products Co. Inc.*³¹, which noted that scent marks could be directly applied to or infused into the product, such as yarn with a plumeria blossom fragrance. This case has set a precedent for future rulings involving unconventional trademarks.

²⁸ Lanham Act, 15 U.S.C. § 1127 (1994).

²⁹ *In re Clarke*, 17 U.S.P.Q.2d 1238 (F.T.A.B.1990).

³⁰ *Id.*

³¹ *Qualitex Co. v. Jacobson Products Co. Inc.*, 514 U.S. 159 (1995).

Thus, in the U.S., the registration of smell marks is less about graphical representation and more about distinctiveness and non-functionality. This implies that if a smell mark has any functional aspect, the application will be immediately denied. For instance, perfumes are not eligible for smell mark registration under U.S. trademark law. Despite these restrictions, the U.S. leads the world in the number of granted smell mark applications. The country's liberal stance towards smell mark registration is highlighted by an instance where a smell mark registration was granted for footwear infused with a coconut fragrance. However, due to certain procedural inconsistencies, the registration was revoked. till date, ten smell marks have been registered under the U.S Trademark Office, which include:

GOODS/SERVICES	SCENTS	REGISTRATION NUMBER AND TM STATUS
Ukuleles Coat	Pina Colada Scent	Reg. No. 85553176 Dead
Verizon Scents	Flowery musk Scent	Reg. No.: 4618936 Dead
Pain Relief Patches	Mint Scent	Reg. No. 3589348 Live
Toothbrushes	Strawberry Scent	Reg. No. 3332910 Dead
Flip Flop Stores	Coconut Smell	Reg. No. 4113191 Dead
Sandals	Bubble Gum	Reg. No.4754435 Live
Advertising and Marketing	Rose Oil	Reg. No. 3849102 Live
Lubricant for Combustion Engines	Super Charged Strawberry Scent	Reg. No.2568512 Live
Lubricant for Combustion Engines	Cherry Bomb Scent	Reg. No. 2596156 Live
Lubricant for Combustion Engines	Groovy Grape Scent	Reg. No. 2463044 Live

Note: Data are from Nick Greene, The 10 Current Scent Trademarks Currently Recognized by the USPTO, Mental Floss³²

With only ten scent marks having received approval from the USPTO, the process of registering scent marks in the United States is intricate and multifaceted. To secure registration, applicants must furnish a written description and a specimen containing the actual fragrance, matching the described aroma. A notable challenge arises from the fact that some scents tend to lose their intensity over time. However, these registered scent marks are a testament to the ever-evolving landscape of intellectual property law.

E. Europe

In 1988, the EU (European Union) introduced its first council directive, a significant event in trademark law. This led to the creation of Community Trademark Regulation [“**CTMR**”], which set up a system for registering rights across the EU. And to manage this process, the Office of Harmonization in the Internal Market [“**OHIM**”] was set up. Before 2008, the European Union underwent substantial trademark law modifications characterised by two significant shifts. Initially, the Harmonization Directive in 1989 set the stage, followed by a more transformative change with the adoption of the CTMR in 1993. The subsequent overhaul in 2009 through Council Regulation (EC) No 207/2009 emphasized that a community trademark could embody diverse forms, from graphical representations like words, designs, and numerals to even the shape of products and packaging, as long as they distinguish one business offerings from those of another.

However, the registration of scent marks within the European Community faced hurdles after the 2002 European Court of Justice [“**ECJ**”] ruling on *Sieckmann v. Deutsches Patent-und Markenamt*, solidifying the necessity for graphic representation. While this ruling significantly impacted scent mark legislation, a recent EU directive aimed to ease the stringent rules established by *Sieckmann*. Nevertheless, the specific application of this new directive to scent marks remains uncertain, though the foundational principles set by the *Sieckmann* case are expected to persist.

Notably, exceptions challenging the need for graphical representation for scent marks emerged earlier, as seen in the 2001 case where the OHIM re-evaluated the definition of “graphical representation” regarding scents like raspberries used by Myles Ltd. Initially rejected, OHIM

³² Nick Greene, *The 10 Current Scent Trademarks Currently Recognized by the USPTO*, MENTAL FLOSS (Oct. 13, 2015), <https://www.mentalfloss.com/article/69760/10-scent-trademarks-currently-recognized-us-patent-office>.

eventually deemed the “smell of raspberries” and “fresh cut grass” sufficient for CTM (now EUTM) protection. A significant turn arrived with Regulation No. 2015/2424, which amended the concept of trademarks within the EU. Effective October 1, 2017, this regulation notably removed the requirement of graphical representation from the definition of EU trademarks, a pivotal shift from the principles entrenched in the Sieckmann case.³³ It emphasized that while graphical representation was no longer mandatory, any representation should meet specific criteria similar to those established in Sieckmann.

According to Article 2, EU Directive 2008/95, which states that signs of which a trademark may consist of:

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

Later, it was replaced by Article 3, EU Directive 2015/2436, which states that signs of which a trademark may consist of:

“A trademark may consist of any signs, in particular words, including personal names, designs, letters, numerals, colours, the shape of goods or the packaging of goods, or sounds, provided that such signs are capable of:

- a) distinguish the goods or services of one undertaking from those of other undertakings; and*
- b) being 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.”*

Furthermore, Directive (EU) No. 2015/2436 further modernized and harmonized trademark laws within the EU, replacing the previous EUTMD 2008/95. This directive aimed to bring uniformity across Member States’ trademark systems. By removing the graphical representation requirement and substituting it with the Sieckmann Criteria, this directive not only simplified registration but also mandated Member States to align their laws and administrative provisions with the new requirements by January 14, 2019.

³³ Regulation of The European Parliament and of The Council on the European Union Trade Mark, E.U. 2017/1001 (2017).

GOOD/SERVICES	SCENTS	APPLICATION NUMBER AND TM STATUS
Tennis Ball	The smell of fresh-cut grass	000428870 Expired
Flight Darts	Strong smell of bitter beer (olfactory mark owned by Unicorn Products Limited for a UK trademark)	UK00002000234 Active

The approach to scent trademark registration differs significantly between the EU and the U.S. Unlike the EU, the U.S. trademark system does not impose any theoretical or practical barriers to registering scents, provided that the scent possesses distinctiveness and is not an inherent or natural attribute of the associated goods. Remarkably, the USPTO has granted registrations for distinctive scents, such as the fragrance of plumeria blossoms for sewing thread and various fruit aromas for lubricants and motor fuels. This divergence in approach underscores the leniency and openness of the U.S. system toward scent trademarks, in contrast to the more restrictive stance adopted within the European Union.

IV. INSIGHTS INTO SMELL MARKS REGISTRABILITY IN INDIA

The definition of a trademark in the Indian context, outlined under Section 2 (1) (zb) of the Trademarks Act of India, has undergone a significant expansion. According to the provision, a trademark is described as *“a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from one person to those of others.”*³⁴ The definition notably includes not just traditional marks but also extends its scope to shapes, packaging, and combinations of colours. However, there is a conspicuous void in the legislation regarding olfactory marks, raising a fundamental question about the protection of scents as trademarks.

The Draft Manual on Trade Marks, which serves as a guide for the practice and procedure of trademark registration in India, delineated the requirements for registering trademarks in India. Rule 23(b)³⁵ of the Trademark Rules, 2017, specifies that the trademarks should be graphically represented during the registration process. This requirement thereby raises concerns about

³⁴ The Trade Marks Act 1999, No. 47 of 1999, § 2(1)(zb) (India).

³⁵ GOVERNMENT OF INDIA: MINISTRY OF COMMERCE & INDUSTRIES, DRAFT OF MANUAL OF TRADEMARKS PRACTICE & PROCEDURE 86 (2017).

olfactory marks as to how scents, which are inherently intangible and invisible, can be adequately graphically represented to meet the legal standards for trademark registration.

Addressing this gap, the Draft Manual on Trade Marks, which serves as a guiding document for the practice and procedure of trademark registration in India, acknowledges the existence of unconventional trademarks, including olfactory marks. However, it underscores a practical dilemma. Fragrances are fleeting and subjective, and it is difficult to associate them with a specific origin without a visual representation. The manual points out that consumers are unlikely to link a particular scent to a single trader, making it challenging for olfactory marks to fulfil the criterion of being graphically represented.

This disparity in Indian trademark law becomes even more apparent when compared to international standards. Numerous countries have adopted a more inclusive approach, allowing for the registration of non-traditional marks like scent marks. India needs to re-evaluate its position considering the global trend towards recognizing the uniqueness of olfactory and taste marks. As businesses increasingly leverage sensory experiences to establish their brand identities, the legal framework must adapt to accommodate these innovations.

India should consider revisiting its trademark laws to accommodate the smell mark under the definition of Trademark and align with international best practices. The existing definition of the trademark in India predominantly revolves around visual representations, such as words, logos, and symbols. However, this definition neglects non-traditional marks like smell marks, which plays a pivotal role in distinguishing the goods and services of one business from another. As a result, a notable gap exists in the current legislation, failing to acknowledge the significance of olfactory branding in contemporary commerce. This omission of smell marks from trademark laws creates a discrepancy in protection that deviates from international best practices. Notably, numerous countries, including members of the European Union and the United States, acknowledge smell marks as valid trademarks. By amending its laws to conform to these global standards, India can promote greater alignment in intellectual property protection and bolster its trade relationships with other nations. A more open system that recognizes the distinctiveness of scents and trademark laws. A more open system that recognizes the distinctive scents, even without a traditional graphical representation, would incentivize businesses to explore new dimensions of branding. Such progress would enhance intellectual property protection and stimulate creativity and entrepreneurship within the Indian market. As the world embraces a more sensory-oriented

approach to branding, India has a valuable opportunity to lead by example that can be drawn from jurisdictions like the United States, where companies such as Verizon have successfully registered scent marks, setting a precedent for recognition of non-traditional marks, embracing the registration of the olfactory mark, thereby ensuring its legal framework remains contemporary and conducive to fostering innovation in the evolving landscape of business and branding.

V. OBSTACLES AND SOLUTIONS OF SCENT MARK REGISTRATION

Registering scent marks faces significant challenges globally due to the elusive nature of scents, making them hard to protect under existing trademark laws. While some countries allow scent mark registration, these provisions are often limited and fail to capture scent marks' uniqueness the uniqueness of scent marks fully. The process of registering a scent mark is complex and demands detailed descriptions and samples that take more work to produce and maintain. Enforcing a scent mark is even trickier since scents cannot be easily monitored or detected, making it challenging to prove infringement, unlike visual marks. In essence, there are significant challenges in scent mark registration:

A. Essential Graphic Representation of Trademarks

The challenge of visually representing smell marks in the trademark is daunting. Traditionally, trademarks have been based on tangible elements - words, logos, or symbols – that can be easily converted into a visual format for legal recognition and protection through graphical representation. However, the emergence of unconventional marks like sound, shape, motion, smell, and taste has pushed the traditional limitations of graphical representation. Among these, smell marks are particularly elusive. Unlike motion or sound marks, smells are subjective and highly variable. Efforts to visually represent these olfactory marks encounter several obstacles. Even if the chemical composition of the smell mark is considered, it does not meet the requirement of representation capable of being visually depicted. The intangible nature of smells and their subjectivity makes it formidable to increase its chance of acquiring registration. The trademark offices struggle with the intricate task of examining and verifying smell marks. The smell marks lack comparable attributes necessary for rigorous trademark examinations. This thereby poses significant challenges in maintaining the integrity and uniqueness of the trademark.

The EU Directive 2015/2436³⁶ has streamlined the process by removing the necessity for graphical presentation, stating that the eligible marks for registration must be clear, precise, self-contained, easily accessible, intelligible, durable, and objective in the manner³⁷ which passed and removed the requirement of graphical representation; it is mentioned that if the mark is clear, precise, self-contained, easily accessible, intelligible, durable, and objective.³⁸ On the other hand, in the USA, there is no requirement for a drawing submission for marks that consist solely of taste, aroma, or other non-visual substances. This indicates that the US does not require a graphical representation for registering smell marks and instead focuses on distinctiveness during registration.

However, India's Trademark Act needs to be more accommodating in defining unconventional marks, and its criteria are rigid, requiring graphical representation. To unlock the potential of registering unconventional marks, including smell marks, in India, removing the graphical representation requirement is imperative. Smell marks offer captivating opportunities for branding and marketing, but universal registration criteria and requirements are essential.

B. Understanding the Principle of Functionality:

The complexities and judicial obstacles associated with the registration of a scent mark are aptly exemplified by the scenario involving Chanel No.5, a prestigious brand specializing in fragrances. (rephrase) The doctrine of functionality plays a significant role in this process. If the mark does not serve as a source identifier but is associated with the function of the goods or services sold by the owner or manufacturer, it is less likely to be registered. Therefore, for a scent mark to be registrable, it must not be functional or essential to the nature of goods or services.

The failure of Chanel No.5 to register their fragrance highlights an absurd situation that allows for the iconic smell to be duplicated without any legal recourse for the owner of such a mark. This lack of legal guarantee for smell mark protection underscores the importance of the non-functionality doctrine in trademark registration requirements.³⁹

However, this doctrine opens a broader scope for copying unique fragrances that have functionality attached to them, such as the distinctive scent of petrichor on perfume and the unique

³⁶ Directive of the European Parliament and of the Council of 16 December 2015 to approximate laws of the Member States relating to Trade Marks, 2015/2436, 13 (2015).

³⁷ *Id.*

³⁸ Regulation of the European Parliament and Council on the European Union Trade Mark, 2017/1001, Art.10 (2007).

³⁹ Alan Baiju & Malavika Manoj, "Smell" as a Trademark: Limitations and Suggestions, 4 INDIAN J.L. & LEGAL RSCH. 1 (2022).

smell of Mysore Sandal Soap, in which the fragrance is extracted from sandalwood oil, which already has a trademark registration.⁴⁰ Nevertheless, it still needs to receive smell mark registration in India. This lack of legal guarantee for smell mark protection underscores the importance of the non-functionality doctrine in trademark law. This doctrine thereby opens a broader scope for cloning unique fragrances that have functionality attached to them. Therefore, instead of focusing on the doctrine of functionality, the trademark office should consider the uniqueness of the fragrances imbued, whether in a soap, perfume, or aroma oil.

The uniqueness of a smell, its ability to stand out as a separate aroma, and key identifiers in consumers' minds should be key identifiers and criteria while registering, and its power to attract the consumer to specific products should be recognized. Thus, they should be granted smell mark protection regardless of their functionality. As consumers often associate specific scents with brands or products, this association can significantly influence their purchasing decisions. Therefore, protecting these unique smells can help businesses maintain their competitive edge and prevent others from capitalizing on their success. Thus, while the doctrine of functionality plays a vital role in trademarking, it should not overshadow the importance of protecting unique and distinctive smells. The trademark office needs to strike a balance between these two aspects to ensure fair competition and promote innovation.

C. Concept of Distinctiveness

Securing a trademark registration hinges significantly on the concept of distinctiveness. For a mark to be eligible for trademark protection, it must meet the criteria of distinctiveness and be able to differentiate goods and services from those of others. This distinctiveness can either be inherent, which means unique in nature, or acquired over time through use. When dealing with non-conventional marks, like smell marks, trademark offices need to approach the issue of distinctiveness cautiously. Although not inherently distinctive, there are various categories of marks that can gain distinctiveness or secondary meaning through use. Take, for instance, flip-flops with a coconut scent. While the smell itself might not be inherently distinctive, its association with a particular product can be established through consistent use. However, smells pose unique challenges in the realm of trademarks; they are inherently subjective, varying from person to person. What might be distinctive to one might not be so to another. Additionally, smells are closely tied to the product's quality, making it hard to argue for their distinctiveness apart from the

⁴⁰ *Mysore Sandalwood Oil*, WIKIPEDIA, https://en.wikipedia.org/wiki/Mysore_Sandalwood_Oil (last visited Apr. 9, 2024).

product itself. Moreover, smells are fleeting; they can change due to factors like temperature and humidity, further complicating the task of proving distinctiveness.

Despite these hurdles, there are ways to enhance the chances of registering a smell mark. One method demonstrates evidence of distinctiveness. This means showing that consumers have associated the smell with a specific source due to its consistent and exclusive use in the market. Advancements in technology have paved the way for creating stable synthetic versions of natural smells. These synthetic scents can meet the graphical representation requirement, which is essential for trademark registration.⁴¹ In essence, while the distinctiveness requirement poses challenges for smell marks, overcoming them is possible. Through careful planning, technological innovations, and strong evidence of use, legal protection can be secured for these unique trademarks, ensuring their recognition in the market.

VI. CONCLUSION AND SUGGESTIONS

The role of trademarks as tools aiding consumers in recognizing product origins is pivotal in building a brand reputation and attracting a broader consumer base. In the modern competitive market, businesses invest significant time and resources in creating unique concepts to outshine their competitors. Notably, unconventional marks targeting human senses like sound, smell, and taste have gained prominence. Smell holds a substantial influence on consumer behaviours, often evoking subconscious responses. Despite the significance of smell marks in consumer consumption, their protection remains an overlooked area in trademark laws, especially in the context of India.

While countries such as the U.S., Europe, and Australia have granted the registration of smell marks, India lags. The existing Indian Trademark Acts lack clarity regarding registering unconventional marks, including smells. The graphical representation requirement further complicates the registration process for invisible marks like taste and smell. This, thus, proves a substantial gap in the existing trademark law.

It is imperative for India to align its stance with international standards. Being potent and decisive, olfactory senses demand safeguarding through smell mark protection. India should take a cue from global practices and amend its trademark definition to encompass unconventional marks

⁴¹ *Digital Scent Technology*, WIKIPEDIA, https://en.wikipedia.org/wiki/Digital_scent_technology (last visited Apr. 9, 2024).

comprehensively, eliminating the need for graphical representation in the case of invisible marks. By way of these changes, it will not only enhance intellectual property laws in the country but also encourage innovation and creativity among businesses, ultimately fostering a more competitive and dynamic market environment.