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“Potentiality of ‘Smell’ as a Trademark and its limitations”

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Introduction

‘Non-traditional trademarks’ is one of the most relevant issues under Trademark law. The Indian Trade Marks Act defines ‘mark’ as a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination thereof.¹ As evident from the wordings of this provision, the list is not exhaustive, and an interesting subject under non-traditional trademarks is that of ‘scent marks.’ Since the term “trademark” is given a dynamic interpretation, such non-traditional trademarks like scent have been acknowledged in several national and international jurisdictions.² However, there are several points of contentions in this regard that arise when registering these features as trademarks. One of such perplexities is the complication arising in fulfilling the requisite of graphical representation of the feature in question for being trademarked. Further, the functionality doctrine stands incongruous with such registrations.

Complexity of Graphical Representation of Scent Marks

Scent marks are an outcome of the business practice entailing the act of giving a certain smell factor to the products by the manufacturers, giving them a sense of distinctiveness from other products of similar nature. However, the complication arises due to the requirement of a graphical representation of the smell, for it to be registered as a mark. The same was held in the famous case of *Ralf Sieckmann v. Deutsches Patent und Markenamt*.³ In this case, a registration for trademark was requested for the smell of ‘methyl cinnamate’, but the same was denied because of the failure in complying with the norm requiring graphical representation. In the Indian context, Section 2(zb) of the Trade Marks Act mentions that ‘Trademarks’ is a mark, capable of being represented “graphically”.⁴ This complicates the registration process as mere description of the chemical composition of the ‘smell’ cannot be qualified as an adequate graphical representation. Such description is an attribute of the substance itself, and not of the scent. For the requisite qualification as a trademark, the smell should directly be attributed to the concerned commodity, and give it a sense of particularity

¹ Section 2 of Indian Trademarks act, 1999

² Nick Greene, *The 10 Current Scent Trademarks Currently Recognized by the US Patent Office*, MENTAL FLOSS (Jan. 6, 2021, 04:15 PM), <https://www.mentalfloss.com/article/69760/10-scent-trademarks-currently-recognized-us-patent-office#:~:text=According%20to%20The%20Wall%20Street,the%20protection%20of%20a%20scent>

³ Ralph Sleckman v Deutsche Patent- und Markenamt, ECLI:EU:C:2002:748

⁴ The Trademarks Act, *supra* note 1

and distinctiveness. The ‘smell’ *per se* cannot qualify to be trademarked, without the needed association with a commodity. Further, the smell cannot be an outcome of the properties of the commodity, emanating naturally from the product. Although not enforceable as an authority of law, The Indian Draft Manual of Trade Marks, 2015⁵, enumerates the same standards requiring graphical representation, as laid down in the Sieckmann case.⁶ It noted that under the Indian Trademark law, scent marks cannot be registered due to the lack of the aforementioned factor. However, the Indian courts have pushed the boundaries by granting the unconventional trademark registration to the manufacturers of ‘Zippo Lighters’.⁷ Although the subject matter for this registration was the shape of the lighter, the court did go beyond the conventional limitations of trademark registration, and granted the manufacturers protection against potential counterfeiting of the shape. Another instance of similar ‘un’conventionalism can be noted from Yahoo’s trademark registration of its characteristic ‘sound’ under the Indian Trademarks Act, 1999.⁸ Nevertheless, the limitations of graphical representations does not stand to be the only legal limitation to the registration of smell marks.

Scent Marks and the Functionality Doctrine

One of the most significant legal challenges to the registration of scent marks is the notion of functionality doctrine.⁹ According to the same, features of a product that carry the nature of being a *function* of it, are not eligible for being protected under trademark law. Any legitimate registration for trademark, in this case: scent marks, ensures the exclusivity of its usage for an indefinite period of time, subject to the condition that the usage is concerned with commercial domain. The essence of the functionality doctrine lies in preventing monopoly of an entity over a vital feature of the product, that can play a crucial role in the product lines of a competitive entities. Intuitively, this doctrine can be construed as a tool for promoting healthy competition. However, the application of this doctrine turns out to be

⁵ Government of India, *Manual of Trade Marks*, MINISTRY OF COMMERCE & INDUSTRIES (Jan. 6, 2021, 04:25 PM), http://www.ipindia.nic.in/writereaddata/Portal/IPOGuidelinesManuals/1_32_1_tmr-draft-manual.pdf

⁶ *Supra* Note 3

⁷ Zippo, IA 7356/2006, DELHI HIGH COURT (Jan. 6, 2021, 04:25 PM), <https://spicyip.com/2006/08/zippo-shape-mark-protected-by-indian.html>

⁸ Manoj P, *Yahoo Awarded India’s First Sound Mark; Nokia in Queue*, LIVE MINT (Jan. 6, 2021, 04:35 PM), <http://www.livemint.com/Home-Page/5z2B1NQUy3YyPkpRDp789M/Yahoo-awarded-India8217s-first-sound-mark-Nokia-in-queue.html>

⁹ Cornell Law School, *Functionality Doctrine* (Jan. 6, 2021, 05:00 PM), [https://www.law.cornell.edu/wex/functionality_doctrine_\(trademark\)#:~:text=The%20functionality%20doctrine%20prevents%20trademark,control%20a%20useful%20product%20feature.](https://www.law.cornell.edu/wex/functionality_doctrine_(trademark)#:~:text=The%20functionality%20doctrine%20prevents%20trademark,control%20a%20useful%20product%20feature.)

dicey when applied in regards to scent marks. It poses concerns on the essence of the doctrine, and paves way for ramifications.

An apt example to elucidate this complication can be the world famous and renowned fragrance line by Chanel, widely used by fashion industry since decades, '*Chanel No. 5*'. Now a conformity with the functionality doctrine renders olfactory marks from beauty or self-care products like cologne or perfume, ineligible for registration as a trademark. To conclude that a fragrance line, as renowned as *Chanel No. 5*, is not protected under trademark by the force of law is preposterous at the least. It opens possibilities of the iconic scent being copied, without any legal recourse for the commodity owner. Moreover, there are other ways in which the functionality doctrine poses obstacles in the path of trademark registration for scents. For instance, a request for trademark registration was filed by 'Pohl Boskamp', a pharmaceutical company, for the flavour and peppermint smell of their nitroglycerin spray used for treating chest pains.¹⁰ When the examination was conducted for determining the validity for the registration, it was observed that the peppermint flavour was particularly more effective at treating certain categories of chest complications. Thus, this provided the *functional* aspect of the peppermint flavour, and was consequently rendered ineligible for registration. While the vitality of functionality doctrine to trademark law is indisputable, such instances regarding olfactory trademarking exposes the restricting aspect of this doctrine that can pose a hindrance in the path of protection of a potential intellectual property.

Tracing the acceptance of smell marks as a valid trademark in foreign jurisdictions:

- **UK:** UK first recognized smell as an eligible feature of a product to be considered as a trademark in 1996, when it granted smell trademark to Sumitomo Rubber Company, for the rose flavoured fragrance applied to their tyres. Later, the trademark was transferred to 'Dunlop Tyres'. In another instance, registration of smell trademark was granted to 'Unicorn Products' for the bitter beer smell of their product darts.¹¹
- **US:** The first trademarked that issued to a "smell" was granted in 1990, to a 'plumeria blossom scented thread' used for embroidery. The request for the same was filed by a Californian company OSEWEZ.¹² However, currently the trademark has lapsed. In

¹⁰ United State Patent and Trademark Office, *Pohl-Boskamp GmbH & Co.*, (Jan. 6, 2021, 05:45 PM), <https://ttabcenter.com/ttabcase/pohl-boskamp-gmbh-co-kg-2/#gsc.tab=0>

¹¹ Raja Selvam, *What is Smell Trademark or Scent Trademark?*, SELVAM & SELVAM, (Jan. 11, 2021, 6:30 pm), <https://selvams.com/blog/smell-trademark/>

¹² *In re Celia Clarke, DBA Clarke's OseweZ*, TTAB, No. 758429 (Sep. 19, 1990)

total, less than a dozen smell marks are currently registered as valid trademarks in the US. Some smell marks that have been successfully registered by US Patent and Trademark Office (USPTO) as trademarks include bubble-gum flavoured smell of sandals, combustion engine lubricant with a smell of cherry, strawberry and grapes, and a strawberry smelling toothbrush.¹³ The most recent successful trademark registration for a smell was issued to the toy company Hasbro, for the distinctive smell of their popular toy ‘Play-Doh’, in 2018.¹⁴

- **China:** As per the trademark law in China, smell marks cannot be registered as a trademark due to the lack of visible representation.¹⁵ Contrastingly, Hong Kong Trademark Ordinance allows registration of smell marks, and the IP department of Hong Kong in fact, encourages such registrations.¹⁶

Conclusion

Olfactory sense is the strongest and most potent sensory aspect of the human body, communicating straight with the brain functions without intermediate chain of thoughts. There are various commodities a buyer tends to consume merely by the virtue of the factor of ‘smell’. With rapid advancement in the selling regime, markets have the potential to capitalize the association of a distinctive smell with the product. The customers identifying the distinctive smell and tracing the origin of the product stands in direct conformity with the principles of trademark law. It is thus only reasonable to impart a specific identification to ‘scents’ as a trademark. It is undeniable that there are limitations to the same, as discussed above. But with right legislative intent, and incorporation of technological advancement, it is feasible possibility that potential scent marks get the requisite acknowledgement as a trademark, without sundry limitations.

¹³ Nick Greene, *The 10 Current Scent Trademarks Currently Recognized by the U.S. Patent Office*, MENTALFLOSS, (Jan. 11, 2021, 7:00 pm), <https://www.mentalfloss.com/article/69760/10-scent-trademarks-currently-recognized-us-patent-office>

¹⁴ Rachel Siegel, *Remember how Play-Doh smells? U.S. trademark officials get it.*, THE WASHINGTON POST, (Jan. 11, 2021, 7:10 pm), <https://www.washingtonpost.com/news/business/wp/2018/05/24/remember-how-play-doh-smells-u-s-trademark-officials-get-it/>

¹⁵ Angell Xi, *Trademark registration and use in China*, LEXOLOGY, (Jan. 11, 2021, 7:45 pm), <https://www.lexology.com/library/detail.aspx?g=a3b92efc-94f2-4ba4-ba25-f1f98a068dfb#:~:text=What%20may%20and%20may%20not%20be%20protected%20and%20registered%20as%20a%20trademark%3F&text=Unlike%20those%20mentioned%20above%2C%20smell, and%20protected%20as%20a%20trademark.>

¹⁶ Editor, *Registration of Trademarks in Hong Kong & Latest Legal Developments in Hong Kong and Mainland China’s Trademark Law*, LORENZ & PARTNERS, (Jan. 11, 2021, 8:00 pm), https://lorenz-partners.com/download/hong_kong/NL200E-Registration-of-Trademarks-in-Hong-Kong-Nov15.pdf