Protecting Smell Marks: Breaking Conventionality

Abhijeet Kumar†
†Patna High Court, 1/23, Vasudha Bhawan, Indrapuri Rd. No. 1, Patna 800 024, Bihar

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In today’s era, there are examples of many Fortune 500 companies’, products and services of, which directly market their business upon different senses of its consumers, such as smell, taste, sound etc. Smell, one of such senses, has always been one of the strongest which individuals have relied upon in their day-to-day activities. Studies have shown how a particular smell can trigger one’s memory, affect one’s mood and of course make companies, like Chanel, earn millions.

Traditionally, trademark has been affiliated to words, names, symbols or any other sign used for identification of goods and services provided by the manufacturer, which had restricted the provision of protection to goods and services to brand name and logo and not on the specific products. Though the arguments on this issue started in 1980’s only, it is still one of the least discussed aspects of IP in many jurisdictions. Due to the advancement of technology and development of jurisprudence, trademark offices and courts of different jurisdiction have started grating protections to a distinguishable smell/odour which can be represented graphically, in order to determine origin of goods and services. Through this paper the author has analysed the basic science of how a ‘smell’ can be distinguished from another and thus qualifies as a subject matter of protection. Further, the paper also focuses to examine the development of law in regard to protection of smell mark in various jurisdictions and few suggestions have been provided after analysis, which could be adopted by Indian TMO.

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Popular Notion of Trademark

Any word, symbol, image or any other kind of signifier that establishes a difference between a good or service being provided by one company, brand, firm or organization from the goods and services provided by any other company, brand, firm or organization, is generally called as trademark. The TRIPS Agreement has given a similar definition for what all could be capable of constituting a trademark. The Agreement says that—

“any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark.”

The Community Trademark, which covers the whole region of European Union, defines trademark as any sign capable of being represented graphically, which can differentiate between one kind of goods and services of one undertaking from similar kind of goods and services from another undertakings. Meanwhile, laws on trademark in USA trace its origin from a set of statutes which defines trademark similarly.4

Going deeply into the origin of trademarks, it has been found that legal protection was given to the trademark holders by the courts, to protect their marks from being used by another trader at the same time. The rationale behind it was that otherwise it may lead to fraud being committed against the public.5 In England, the Chancery Court in a case held that it would amount to deceit if a trader is deliberately using a mark which has been used by someone else prior to that trader.5 In the late 19th century, when the concept of passing off was brought into notion, it was for the same purpose that if a manufacturer has gained reputation by virtue of use of a particular mark, it should be protected from being used by another manufacturer.7 The economic value attached to the marks and the holder of the marks has been a basic consideration for protection. The motivation for this protection was to prevent the injury done to consumers and producers alike by counterfeit goods.8 Trademarks gained in importance as a link between the producer and the consumer in the seventeenth century, where the advent of mass production meant that goods were marketed nationally and the physical separation of the producer from the consumer resulted in the trademark becoming established as an asset of commercial value.9

1Email: abhijeetkumar12991@gmail.com
The modern concept of trademarks as a method of differentiating products encourages producers to invest substantially in branding. It is substantially different from other types of intellectual property which are protected. While copyright confers a proprietary right in a creation, such as a painting or musical work, the registration of a trademark only grants the right to its use in relation to the class of product for which it is registered. A trademark is not protected for its own intrinsic worth, but for the intangible values surrounding the product and attaching to the mark. Trademarks consequently require continued investment and management to add value.

What can be concluded from this discussion is that trademark is, in general, affiliated to words, names, symbols or any other sign used for identification of goods and services provided by one manufacturer. With passage of time, the development in the area of trademark as well, as a vide area of trademarks has been witnessed these days which is covered under the heading 'non-conventional trademarks’, examples being smell, sound, taste etc. For the purpose of this paper, the scope is limited to smell marks only.

**The Sense of Smell**

With the help of fragrance of any product, the same has been acknowledged since long. Let it be bathing soap, talcum powder, hand wash or even a chewing gum, yet the fragrance or smell itself didn’t get a protection, or even recognition, as a trademark until recent past.

People interact with the world around them through sights and sounds; live largely through eyes and ears. Recent research shows that responding is done, both consciously and subconsciously, to odours as well. From these studies, it appears that the sense of smell not only is the most basic of our five senses, but also may play a far greater role in the actions than are realized.

An individual’s sense of smell results from stimulation of the olfactory glands, at the top of the sinus cavity, which directly trigger the olfactory bulbs in the limbic system of the brain. While odours may evoke a conscious evaluation in the cerebrum, this is not required: the olfactory glands can and do directly trigger both memory and emotional responses.

This is in sharp contrast to the other four senses as they all stimulate areas of the cerebrum, and require a conscious evaluation to produce a response. Thus, the sense of smell has a very privileged and intimate influence over what one do and how one is lived. It can also be understood from the fact that feelings, either positive or negative, about people, places and things, may well be determined by how they smell, and this in fact appears to be so whether or not there is consciousness of their odour.

Various studies have been conducted over the effect of smell on the behaviour of human being. In other words, researchers have been always fond of finding what kind of smell soothes human mind and mood and what disturbs it the most. For example, the smell of the beach soothes people who suffer from relatively severe forms of chronic anxiety, while Yale researchers report that an apple-spice fragrance helps stop panic attacks and reduces stress levels.

In the decades since, the 1950s, many products besides soap have come to depend on fragrance for much of their appeal to consumers, ranging from cosmetics, cat litter, floor wax, facial tissues and toilet bowl cleansers to taco chips, plastic trash bags, dolls and toy soldiers (to which some add a gunpowder fragrance).

Since, basic cleansing agent is same in all the kinds of soap, the fragrance or smell it carries is the bottom line which demarcates a soap of a particular company from soap of another company. The same goes for perfumes and deodorants, room spray and fresheners etc. Laboratory studies have shown that subjects using identical products will rate higher the performance of the pleasantly scented version.

The critical and pervasive role of fragrance in many of today’s products highlights the function of a product’s smell—not only to sell but to distinguish. This distinguishing between different products is also the basic goal of trademark which is to be protected. Many jurists have said that the most basic function of a contemporary trademark is to differentiate a product from others in the marketplace.

**International Development in Subject Matter**

Madrid Agreement and the protocol related to the Madrid Agreement, famously known as Madrid Protocol, were silent on the issue of subject-matter for registration of trademark. So, what kind of marks could be registered and protected and what couldn’t were not dealt within these international agreements. Then was the date of Paris Convention which was brought in for the sole intent of protection of industrial property including trademarks. As the term trademark wasn’t defined in the convention, and neither was the subject-matter laid down in it, it left a
wide scope for inclusion of non-conventional marks into theambits of the trademarks. This becomes more relevant, as the provision of the Convention left the registration formalities to the discretion of the domestic state. The relevant provision of the convention says:

“The conditions for the filing and registration of trademarks shall be determined in each country of the Union by its domestic legislation.”

This gave the domestic countries to make laws in relation to the definition of trademark or sign, where on their discretion they would have included or excluded non-conventional marks from protection.

Trademark Law Treaty, which was signed at Geneva in 1994, is the only international treaty which has made an explicit exclusion of sound and olfactory marks from getting registered as a mark. The relevant provision of the treaty says:

“This Treaty shall not apply to hologram marks and to marks not consisting of visible signs, in particular, sound marks and olfactory marks.”

The Agreement made on Trade Related Aspects of Intellectual Property Rights in the year 1994 (TRIPS) kept its stand neutral by making the provision that the contracting parties may provide that only visually detectable signs or marks should be made eligible for granting legal protection. The use of word may clearly connote that the non-conventional marks, which are not visually detectable are not prima facie ab initio excluded from the scope of this Agreement. So we can say that sound, taste and smell can still be covered under this international Agreement based on the intention and willingness of the contracting parties.

Even though the various countries have signed most of these treaties, agreements and protocols, yet their domestic law varies from each other very much. For this we need to have a look onto the specific legal provisions as present in those states in regard to the protection of non-conventional marks.

**Position of Smell Marks**

On one hand, trademark law has embraced an open-ended definition that emphasises the functional, rather than the ontological status of a sign. In other words, any sign which does the communicative work of a trademark, by distinguishing goods or services on the basis of trade origin, can be registered as one.

While on another, trademark registration systems have historically developed around paradigmatic subject matter: a conventional or traditional trademark that is visual and consists of words, devices or a combination of the two. The need to reconcile these conflicting imperatives - the trademark registration system is open to all categories of signs and its apparently 'business as usual', yet the registration system was designed with only words and figurative devices in mind - requires a careful reconsideration of certain basic assumptions underpinning this area of intellectual property.

There is no doubt that in the recent past there has been a constant shift towards ‘people-driven economy’ from ‘industries-driven economy’, which has given the result that the consumers are the real power holders of the today’s market economy. Consequently, the manufacturers, firms or companies want to be associated with the customers in a comparatively close manner than they were before, for which another shift has been seen in the trademark registration. To make their product more distinctive than the competitors in the market, the producers now prefer the non-conventional or no-standard marks, based on shape, colour, taste, sound and smell, rather than the conventional or readily perceived marks, such as words, slogans, acronyms, designs, logos etc. The acceptance of non-standard marks finds immense support in the branding literature.

In this part, the position of smell mark as a trademark would be analyzed in different countries. First, the history of development of law relating to trademark in the particular nation would be discussed and then discussion on the position for protection of smell marks would be done.

**The United States of America**

As, it is known that the US is the biggest capitalist economy of the world as of now, the rationale behind the trademark protection in the country is to promote competition among the traders, which is basically the fundamental idea beneath a capitalist economy. The Lanham Act, promotes this objective by allowing the registration of marks by traders and by defining the precise rights of the ‘holders’ of those marks. It has been argued that the aim of the Lanham Act are creating the balance and protecting the investment made in the mark by trader from being misused by another trader in the name of ‘free-riding’ and subsequently protecting the interest of the consumers.

A mark can exist even by being unregistered also. The federal registration under the Lanham Act doesn’t as such establish a right in the holder, the commercial
use of such marks does. In a leading case, Federal Circuit Court decided that-

“The purpose of Lanham Act is to eliminate judicial obscurity, to simplify registration and to make it stronger and more liberal, to dispense with mere technical prohibitions and arbitrary provisions, to make procedure simple, and relief against infringement prompt and effective”.  

In another case, while discussing how the purposes of the trademark law are being furthered by incontestability provisions, the Court held that by securing the benefit of the good reputation of the producers, which excellence creates, the trademarks promote the maintenance of quality of the goods and services. Thus, protecting trademarks leads to: protect the public from deceit; to foster fair competition; and to secure to the business community the advantages of reputation and good will by preventing their diversion from those who have created them to those who have not.

The Lanham Act, federal statute of the USA, in its Section 45 gives the constitution and definition of the terminologies used. It 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 register 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.”

It can be concluded from this statutory provision that even though smell mark is not expressly included in the definition clause, yet it has not been excluded from getting registered by the virtue of the phrase or any combination thereof. The US Supreme Court while delivering a judgement held that-

“Trade dress includes features such as size, shape, colour or colour combinations, texture, graphics, or even particular sales techniques”.

Sensory marks, which include scent and colour marks, are a subset of ‘trade dress’. It has been argued by various academicians that till the time the scent is a distinctive and not inherent characteristic of the goods, the registration is not prohibited under the existing law of US. The United States Trademark Association Committee determined that the terms ‘symbol, or device’ should not be deleted or narrowed to preclude registration of such things as colour, shape, smell, sound, or configuration which functions as a mark.

A case regarding a newly manufactured sewing thread and embroidery yarn was brought before the Trademark Trial Appeal Board (TTAB), registration of which was rejected saying that the manufacturer's product didn’t indicate the origin of the product and didn’t distinguish it from other products of the competitors in the market. The appellant argued that that the only embroidery yarn in the market which was scented was being manufactured by the appellant, as it was a high impact, fresh, floral fragrance reminiscent of Plumeria blossoms. The initial examining authority rejected the application of registration on the ground that the applicant failed to show that how the scent was linked to the origin of the product and also that the appellant even didn’t specify on the packing about the fragrance.

On appeal to TTAB, the decision of the examining authority was overturned and the product was registered and the fragrance was given a trademark, on the rationale that a scent is very much capable of distinguishing certain types of products. The TTAB further reasoned that the appellant was the only manufacturer of yarn with a scent; she advertised her yarn with the scent feature, and she had demonstrated that consumers recognized the scent as an indicator of origin, as the presence of a unique scent is a prima facie case for distinctiveness of mark.

Also, the US Supreme Court in the Qualitex case acknowledged the decision of the Board for the grant of protection to smell marks in the Clarke case. The TTAB had held 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”.

Eminent intellectual property attorney from California, James Hawes, who probably is one of the first to raise the voice for including scent in the category of marks, observed that:

“[t]he critical and pervasive role of fragrance in many of today's products highlights the function of a product's smell—not only to sell but to distinguish. Given this most basic fact of the commercial world, it is indeed strange that fragrance has never been viewed ... as a trademark.”
Thus, it is clear that the position of scent or fragrance to get registration as a mark in US is permissible by the virtue of statutory provisions as well as judicial pronouncement, varying from TTAB to the United States Supreme Court.

**European Union**

The Union has witnessed two times drastic changes in the trademark law: first being in 1989, when the Harmonisation Directive was brought in the scene; and then again in the year 1993 when Community Trademark Regulation was adopted. Article 4 of this Regulation is the definition clause which defines ‘trademark’ as “any sign capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings”. The 1989 had the same clause that anything which can distinguish between the goods can be a mark for registration. Much like the Lanham Act, the EU directive recognizes a broad definition of trademarks. Also, like the Lanham Act, it fails to address scent marks explicitly, emphasizing instead a trademark’s ability to distinguish one product from another.

Following the above discussed US Supreme Court decision, the EC Office for Harmonisation in the Internal Market (OHIM) granted registration of marks with fragrances, which was of the smell of freshly cut grass for tennis balls. The Second Board of Appeal said that the smell was so distinct and precise that anyone could recognise it from the experience. Thus, the Board held that the description given for registration was in compliance with the Article 4 of the CTMR.

Unfortunately, the registration permit for olfactory or smell marks after that lived in theory for a while, and not in practice. The European trademark registries refused the registration of a balsamically fruity smell with a slight hint of cinnamon, for services ranging to various fields. Two questions were raised in this regard to the ECJ: (1) whether a mark which cannot be reproduced visibly can nevertheless be reproduced with certain aids, and (2) whether the requirement for graphic representation in Article 2 is met when an odour is reproduced by (a) a chemical formula, (b) a description, (c) a sample or (d) a combination of these elements.

The Court held that the list of signs in Article 2 of the Trademark Directive is not exhaustive and that the provision does not expressly exclude signs which are not in themselves capable of being perceived visually, such as odours. The court went a step further and held that Article 2 must be interpreted as meaning that a trademark may consist of a sign which is not in itself capable of being perceived visually, provided that it can be represented graphically.

The main issue was the graphical representation of the mark, which was a mandatory step to be done. The Court held that- “the representation must enable the sign to be represented visually, particularly by means of images, lines or characters, so that it can be precisely identified”.

Even though the applicant had tried to represent the olfactory mark through the chemical formulas, that wasn’t sufficient as the formula represented the substance as such but not the odour of the substance. Also, while the written descriptions of the methyl-cinnamate were certainly graphic, the court concluded they were not sufficiently precise to satisfy the requirement. Thus unless a situation comes when a smell can be clearly identified with complete clarity the protection of smell marks, if not impossible, then for sure has been made too tough.

Further, another case was rejected by the board for smell mark protection and the reason given by it was: “[T]he coloured matrix filed does not comply with the graphic representation requirements...as it does not allow the relevant public to perceive the identity of the sign or to determine the extent of its protection. It is not sufficient for the sign to be technically capable of reproduction. The [sign] must also be perceived as such by users of the register and it must enable them to obtain the necessary indications in order to be able to interpret this”.

**The United Kingdom**

After the Community Trademark Regulation was brought in the year 1993, a new trademark was enacted in the UK for implementing the provisions of the Regulation. On the day the UK TMA came into force, Chanel sought unsuccessfully to register “Chanel No 5” as a trade mark. Chanel attempted to graphically represent the sign by describing its perfume as:

The scent of aldehydic-floral fragrance product, with an aldehydic top note from aldehydes, bergamot, lemon and neroli; 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 5.62

The application failed because a perfume constitutes the product itself as opposed to an indication of its origin. On the same day, Sumitomo Rubber Co sought to register “a floral fragrance/smell reminiscent of roses as applied to tyres,”63 and Unicorn Products applied to register “the strong smell of bitter beer applied to flights for darts”,64 and both the applications were successfully registered.

The main problem which lies in UK, just like ECJ, is the representation of the smell as required by statutory provisions. The raison d’etre of graphical representation is the need to be able to record and publish the mark, and to enable interested parties to ascertain the scope of existing trademark rights by conducting a search of the trademarks register. This has been touched upon in a number of cases. In Ty Nant Spring Water Ltd's Trade Mark Application65, Geoffrey Hobbs QC sitting as the Appointed Person held that:

The degree of precision with which the sign is represented must be sufficient to permit full and effective implementation of the... Act relating to absolute unregistrability (section 3)66 and relative unregistrability (section 5)67, infringement (section 10)68 and public inspection of the register (section 63)69.

In another case, the applicant sought to register a scent mark described as “the smell, aroma or essence of cinnamon” in respect of furniture. The Principal Hearing Officer concluded that the description of the scent lacked definition and could not stand alone, but relied on the reader's previous experience of the sign.70 He rightly pointed out one of the difficulties in registering olfactory marks: a person's perception of the smell is likely to be influenced by the circumstances in which they have appreciated it. He cited the example of how a cook's perception of what cinnamon smells like might be different from that of a consumer's perception of confections or drinks containing cinnamon. He did not believe that the representation was precise enough to allow Examiners to compare the sign with other potentially confusingly similar signs for the purposes of deciding whether it came under any of the relative grounds of refusal (eg, cinnamon as compared to cloves or cassia) without the use of samples. He observed that a purpose of graphical representation is to:

“... avoid the need for samples of goods, smells, music, etc, having to be stored in relation to Trade Marks Registers, which are inevitably paper or electronically based records.”70

On appeal, the Appointed Person, Hobbs QC, dismissed the appeal. He held that the identity of the smell has to be clearly and unambiguously recorded. He pointed out the difficulty in attaining a precise graphic representation of smells.71 Hobbs QC also highlighted that even modern technological processes such as electronic sensory analysis72 and graphic profiles are unable to provide a satisfactory representation of the applicant's mark.

In another case, OHIM Third Board of Appeal had to decide on the registrability of “the scent of raspberries” for “fuels, including motor fuels, particularly diesel as heating fuel, fuel and engine fuel” in Class 4. The Board rejected the applicant's appeal to register the olfactory mark not on the ground that the mark was incapable of graphical representation, but on the ground that it was devoid of distinctive character.73

The Board sought to distinguish John Lewis71 (cinnamon "cannot be recognised by the consumer until he has directly experienced this scent or its aroma"), Senta55 ("the smell [of fresh cut grass] does not come from the grass itself, the type of which is unspecified, but is affected by the cutting, which moreover must be fresh, i.e., have been done within a short, but unspecified period of time") and Sieckmann v Deutsches Patent-und Markenamt56 ("the smell [described as balsamically fruity with a slight hint of cinnamon] is not obvious to the consumer, since the smell must first be produced with a mixture of different constituents").73

The Board cursorily dismissed the argument that the smell might be perceived differently due to factors such as the concentration and quantity, the temperature, the carrier material and also subjective factors such as memories. It held that such an argument can be applied to any type of trademark, and that this did not matter so long as the trademark itself is clearly represented in the Register.74

In deciding whether marks are similar and whether there is a likelihood of confusion, the test to be applied is that of an average consumer who is reasonably well-informed and reasonably observant and circumspect. This average consumer test can be easily applied to visual or even sound marks, but is impossible to apply to olfactory marks which are
represented in the register by a description and/or a sample. It is impossible to devise an objective average consumer test for comparing olfactory marks due to human limitations in perceiving a smell visually.

The ECJ laid down few pointers for checking if the representation of the mark permits it to be registered as a trademark:

i) Clear;
ii) Precise;
iii) Self-contained;
iv) Easily accessible;
v) Intelligible;
vi) Durable; and
vii) Objective.

Even though in theory the door is left open for the registration of olfactory marks, the door seems firmly shut in practice, especially in light of Sieckmann, as written descriptions, chemical formulas, samples, electronic sensory analysis and graphic profile have been ruled out by the courts.

Australia

The definition of word ‘sign’ as in the 1995 Trademark Act of Australia, explicitly recognises that shapes, colours, scents and sounds can be registered as marks for goods. However, it is very important to note that the Australian courts are also following the Sieckmann test for determining non-standard marks. In other words an application for the registration of a trademark will be rejected if the trademark cannot be represented graphically.

New Zealand

The Trademark Act of 1953 was amended by the Amendment Act of 1999 which made a small though significant change in the statutory provision in relation to the definition of the term trademark and sign. The new definition of word ‘sign’ includes a brand, colour, device, heading, label, letter, name, numeral, signature, smell, sound, taste, ticket or word; and any combination of signs.

TRIPS do not require that sounds, smells and tastes be included in the legislation of Member States as signs capable of constituting a trademark. However, if they are deemed to be signs capable of distinguishing the products of one trader from the products of others, it is certainly arguable that sounds, smells and tastes should be registrable as trademarks.

A scent would have to be extremely unique, or uncommon in the context of a particular product, for it to be remarkable enough to become sufficiently familiar for a purchaser to think of it in connection with a source. It would then operate as a trademark in the post-sale context.

Consumers are also unlikely to use their sense of smell to recognise a scent that has been described in the advertising of the product. Customers will almost always smell such a product to test if the scent is as good as it sounds, thus, to ascertain their preference. The advertising is therefore unlikely to establish secondary meaning for a scent by creating an association between the mark and the source of the goods from which it emanates. So, it can be said that the in New Zealand, smell marks are protected through statutory provisions as well as judicial pronouncements also.

India

The Indian law defining trademark is similar to international treaties, open-ended i.e. neither including nor excluding the scope of non-conventional marks to be registered as trademark. ‘Trademark’ has been defined 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 colours.

The word ‘mark’ has been defined in the statute as well and it includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination thereof. As these definitions are inclusive in nature so prima facie as per the current statutory provision there is no scope for any other kind of sign to be registered other than already mentioned in the statute. But there is a Draft Manual issued by the Trademark Office which clarifies that certain non-conventional mark requires special consideration.

As far as the question is raised for what these considerations could be then it can be understood from the response of the two questions which arises as the disputes:

a) To what extent can the principles applicable to conventional trademarks accommodate unconventional subject matter?; and

b) Where gaps exist in existing rules, what should be the form and content of new supplementary rules?

The problem in Indian Trademark Law is same as other nations that the graphical representation of the
same is not possible. To solve this problem also the Draft Manual has few provisions dedicated to it.\textsuperscript{85}

Meanwhile, the courts have started working in the direction for development of law as it granted registration in few recent cases. It was widely reported that Yahoo registered its sound under Indian Trade Mark Act 1999,\textsuperscript{86} and meanwhile the Delhi High Courts also came forward in order to protect the shape of Zippo Lighters and gave them a registration too based on the shape of the lighters.\textsuperscript{87} These two are also non-conventional marks like smell marks and as they have found protection, it is thoughtful that smell marks will get the same too.

In short, it can be said that unless the provisions and suggestions laid down in the Draft Manual are not incorporated in the Trade Mark Act, registration of smell marks still lies in the mid-way and no particular stand can be given to the same.

The Debate of For and Against

Even though various countries, with passage of time, have made some or the other provision for the protection of smell as a mark of a particular good, but still the jurisprudence need to be developed in this scenario. The test for distinctiveness and basic features of non-conventional trademarks needs to be laid down. The standards laid down by different countries are contradictory in nature in respect to each other.

While the whole Europe and Australia is guided by the Sieckmann test, the United States trademark law is guided by the Qualitex ruling of the Supreme Court. The arguments in favour or against have been basically done by two jurists. J.E. Hawes who was the first one to advocate for the protection of smell marks and Bettina Ellias who criticized Hawes about three years later arguing why smell, scents or fragrances shouldn’t be protected as a mark.

Protecting Smell Marks- Arguments in Favour

a) The role of fragrance in many of today’s products highlights the function of a product’s smell not only to sell but also to distinguish.\textsuperscript{88}

b) A strong relationship exists between scent and human memory, which makes scents effective trademarks.\textsuperscript{89} Whenever people think they are recalling odours, they are actually thinking of some object associated with an odour.\textsuperscript{90}

c) A long-term odour memory can be established with only one exposure and then, like a bad habit, this odour connection is difficult to unlearn and forget as once humans have made one association with a scent, it is difficult for them to replace the association with another one.\textsuperscript{15}

d) Registration of fragrance marks must be differentiated from other types of trademarks.\textsuperscript{84} For example, as to protect a word we just need to give the word, say Dell. Similarly it can be seen that various applicants who followed the same formula were denied of the protection to their smell mark because the mark applied by them was too wide to be protected, example being Clarke’s scent ‘plumeria blossoms’. So keeping in mind different nature of the sense, mere little description of the scent should suffice the drawing requirements.

Protecting Smell Marks- Arguments in Against

b) Even if a product’s fragrance functions as an origin-identifier, the manufacturer seeking to protect that mark from infringement must be able to demonstrate that similar scents will create a likelihood of confusion.\textsuperscript{93}

c) Similar fragrance blends, like similar colours can be difficult to distinguish without expert assistance and the practical difficulties in the administration of fragrance marks are likely to prove even more onerous than in the colour mark context.\textsuperscript{94}

Conclusion

The way things smell is known to be a major determinant of many of one’s actions. At times, people respond to smells on a subconscious or
unconscious level, in part because the sense of smell is the only sense which directly communicates with a part of the human brain more primal than the centre of conscious thought.

In the today’s era the smell is one of the basic factors which helps and command in making various choices of the life. From talcum powder to the body deodorant to bathing soap and room freshener, the actions guided by the smell of various fragrances are found. The practical example can be taken from a day-to-day life when someone is being passed-by and their perfume smells, then the guesses are started to be made that for which brand the perfume is. This is basically what the trademark is supposed to do, link the mark to its origin. And the smell mark does it very efficiently.

It can be very well understood after analysing the position of different countries that the courts of the same has been guided by the scholarly writings of academicians or attorneys on this particular issue. The decision of the United States Supreme Court in the case of Qualitex, although not relied upon in the final judgement, but has used the arguments and rational put forth by Hawes and Hamersley in their writings where they supported the granting of registration to the smell marks in their respective articles. Meanwhile, the European Court of Justice placed its reliance on the writing of Elias who has pointed out some loopholes in the theory of the former authors in regard to registration of non-conventional trademarks. Yet, the Sieckmann test has been accepted almost worldwide as the basic need for granting and evaluating if the sign is capable of being registered as a mark or not.

Yet, when we it is seen from the perspective and rationale of the OHIM, the decision of Sieckmann is in conflict with the basic idea of directive. It was the intention of the directive to leave the discretion in the hands of member states in regards to the procedure concerning registration, revocation and invalidity of a trademark. The judgement, thus, made by the ECJ is in a way violative of the above mentioned principle of the directive.

Various products have been witnessed in the markets which functions, starting from advertisement to consumer control to sale of product, on the basis of the smell the product carry with it. Although it is a weaker senses as compared to sight and hear, but smell has its own role in the day-to-day affair of an individual and in today’s commercial market, where economy is openly handled by the consumers, this sense should be given more weightage than it has got till date.

The Government needs to find out ways how it can clearly demarcate one odour from another, and then to examine the distinctive characteristic of that particular odour from others available in market, whether or not related to the type of goods in question. Further, it should be noted that just a random smell or fragrance of a good can’t be considered as a mark and can’t be given protection as it may not lead back to the origin of the good.

Thus, to conclude it can be said that the Trademark Offices of various countries and International offices should utilise the technology for the purpose of granting the protection to smell marks, by keeping a balance between the founding jurisprudence of trademark and the importance of smell mark in present day context.

References
1 Article 15 (1) TRIPS Agreement: Any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark. Such signs, in particular words including personal names, letters, numerals, figurative elements and combinations of colours as well as any combination of such signs, shall be eligible for registration as trademarks. Where signs are not inherently capable of distinguishing the relevant goods or services, Members may make registrability depend on distinctiveness acquired through use. Members may require, as a condition of registration, that signs be visually perceptible.
3 Clarke B & Kappoulas S, The new forms of registrable marks: Market Uptake in the first five years, Deakin L. Rev., 6 (2001) 70
6 Faulder v Rushton (1903) 20 RPC 477
7 Great Tower v Langford (1888) 5 RPC 273
13 Hawes J E, Fragrances as Trademarks, Trademarks Reporter, 79 (1989) 134
use. the mark already has the property right established by prior

Noting that the federal registration of a trademark does not
stands for any person or business that holds the registration
A "holder" of a mark, for the purposes of this comment,
The Trademark Act of 1946, The United States of America
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Lindstorm M, A Natural History of the Senses (Vintage Books, New York) 1990 39
Madrid Agreement concerning the International Registration of Marks of 14 April 1891, as last amended on 28 September 1979.
Protocol related to the Madrid Agreement concerning the International Registration of Marks adopted at Madrid on 27 June 1899.
Paris Convention for the Protection of Industrial Property of 20 March 1883, as last amended on 28 September 1979
Article 6 (1), Paris Convention for the Protection of Industrial Property.
Article 2 (1) (b) of Trademark Law Treaty 1994
26 Article 15 of Trade Related Aspects of Intellectual Property Rights 1994
29 Gangee D, Non conventional trade marks in India, National Law School of India Review, 22 (2010) 67
31 The Trademark Act of 1946, The United States of America
32 A "holder" of a mark, for the purposes of this comment, stands for any person or business that holds the registration of a trademark for a good or service.
35 Noting that the federal registration of a trademark does not create an exclusive property right in the mark. The owner of the mark already has the property right established by prior use. In re Int'l Flavors & Fragrances, 183 F.3d 1361, 1366 (Fed. Cir. 1999
36 Bongrain Int'l Corp. v Delice de France, Inc., 811 F.2d 1479, 1485 (Fed. Cir. 1987
40 Two Pesos, Inc. v Taco Cabana Inc 505 U.S. 763; John H. Harland Co. v Clarke Checks, Inc., 711 F.2d 966.
41 The term trade dress, which trademark law also protects, traditionally denotes the total image of a product.
47 Qualitex Co. v Jacobson Prods. Co. 514 U.S. 159.
54 Vernooschts onder Firma Senta Aromatic Marketing's Venootschap onder Firma Senta Aromatic Marketing, Case C-273/00, 2003 E.T.M.R. 37.
60 Institut pour la Protection des Fragrances' Application, Case R 186/2000-4, 2005 E.T.M.R. 42.


Section 8, The United Kingdom Trademark Act 1994.


A description of this technique and the UK Registry’s reservations about it can be found in Hobbs QC’s Judgment [32]-[34].


The United Kingdom Trademark Act 1994.


Section 40, the Trademark Act of 1995, Australia.

Section 2(1) Trademarks Amendment Act 1999, New Zealand.


Post-sale confusion was deemed to be relevant in New Zealand as held by Williams J, Levi Strauss & Co v Kimbyr Investments [1994] 1 NZLR 332.

In re Celia Clarke 429 TTAB, Number 758 (accessed on 19 September 1990).

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

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


Manoj P, Yahoo Awarded India's First Sound Mark; Nokia in Queue, Live Mint, 7 (2008).

Zippo, IA 7356/2006 (Delhi High Court).


