

The Viability of Smell Mark: Challenges in Registration and Enforcement

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ABSTRACT

Every day that goes by, the scope of trademark protection legislation is being extended globally. In the ever-changing field of IPR, property law, trademarks have historically been linked to both visual and auditory components, including sounds, words and logos. However, non-traditional trademarks like smell marks have drawn attention as effective instruments for product differentiation as branding tactics gets more complex. Unconventional trademarks, including taste, smell colour, sound etc., are examples of recent trademark innovations.

As one of the strongest senses associated with emotion and memory power, scent presents an ideal opportunity for companies to differentiate their goods using olfactory trademarks, which is also known as smell marks. In addition to seeing and hearing, individual also utilizes smell to communicate with each other. When people started to smell something, they form distinct association and recall their memories. Although it cannot be mistaken for being identical, it may be legally protected by being registered as a trademark.

The registration of non-traditional trademarks, such as smell marks, has prompted heated controversy in trademark law, raising questions regarding their registrability and enforcement. This article critically investigates the validity of smell marks within existing trademark regimes, focusing on the challenges associated in their registration and enforcement by citing various case laws to substantiate the same. This study adds to the greater discussion on non-traditional trademarks especially smell mark, by underlining the need for a more adaptable legal framework that allows for innovation while maintaining clarity and enforceability. The study analyses the situation in India regarding smell mark and in the end Suggestions have been provided for easy incorporation of smell marks into the Indian trademark system.

KEYWORDS: trademark law, smell mark, intellectual property rights, olfactory marks.

BACKGROUND OF THE STUDY:

For many years, trademarks have been crucial in the sphere of intellectual property law, serving as labels that distinguish products and services from those of rivals. A trademark is defined as any term, phrase, symbol, design, or combination of these components that identifies and differentiates the origin of one party's goods or services from those of another³. Today, trademarks are recognized as identifiers of origin

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³ 2(1) (zb), The trademark act 1999 No 47, act of parliament, 1999, TRIPS agreement on trade related aspects of IPR article 15(1), Apr.15, 1994.

and promises of consistency, conveying an implicit commitment to quality based on personal experiences with the product, recommendations from others etc. As a result, trademarks have evolved into the foundation of most market competitions. A trademark serves not just as a marker of origin, but also as a barrier to customer misunderstanding and a way of creating a brand's identity and exclusivity. This exclusive right, which is recognized under intellectual property law, encourages innovation and investment by giving brand owners the legal authority to prevent others from using indistinguishable trademarks.

Trademarks are essential to the expansion of modern economies and companies. However, standard trademark categories including words, pictures, characters, numbers, and three-dimensional symbols are no longer enough to meet the demand due to the market's rapid expansion. To satisfy this need, new forms have developed, such as music, fragrances, colours, and other distinctive characteristics. A unique musical trademark may make an immediate and lasting effect on you while you are out on the street having a discussion and don't have time to notice the trademark in writing. Regarding these innovative types of trademarks, such as music, smell, colours, and others, it becomes essential to investigate how to assess their distinctiveness and uniqueness, how to secure trademark applicants' applications, how to shield their rights, and how to regulate appropriate use by others. As companies constantly look for innovative methods to attract consumer interest and cultivate brand loyalty, unconventional identifiers like smell mark have gained more significance.

Despite being the least explored among the five human senses, the sense of smell plays a vital role. Humans have the ability to recall and distinguish 1000s of different fragrances. The sense of smell allows individuals to perceive scents with each breath they take. Smell has the ability to influence and activate an individual's memories as well as their mood, cognition, and behaviour.⁴ For example, pleasant smells can lift one's mood whereas unpleasant smell might lower it. Thus, odours can influence social conduct and define a person's inner ego. Smell marks seek to use aroma as a way of product identification and customer association, allowing firms to build distinct identities that extend beyond visual or aural recognition. The idea of employing fragrances as trademarks raises questions, particularly considering their subjective perception and the complexity associated in distinguishing identification and consistent replication.⁵ According to WIPO's international questionnaire, only 20 of 72 trademark offices acknowledged aromas and fragrances as registered mark.⁶ As a result, not all smells qualify for trademark protection since they must have a distinguishing natural feature.

REVIEW OF LITERATURES:

FU Shuju,(2021), new challenges on intellectual property: smell trademark advance in economics, business and management research, volume 178.⁷

The article explores the complexities of registering smell marks as trademarks in different jurisdictions, particularly the United States, the European Union, and China. It highlights the challenges associated with olfactory trademarks, such as issues of stability, subjectivity in scent recognition, and the difficulty of conveying scent through digital channels. While the U.S. has granted some smell trademarks like Hasbro's

⁴ Basbaum et al; the sense: a comprehensive reference(2007)

⁵ Snajana, analyzing smell trademarks: laws,significance and issues (2021)

⁶⁶⁶ WIPO, Report of Standing Committee on the Law of Trade Marks, Industrial Designs and Geographical Indications, Geneva 16 (2006).

⁷ <https://doi.org/10.2991/aebmr.k.210601.083>.

Play-Doh scent, the EU's strict graphic representation requirements have often blocked similar registrations, despite recent legislative shifts that theoretically allow for non-visual trademarks. Although legal amendments have opened the door for smell trademarks in China, practical registration remains elusive. The author suggests that overcoming these barriers requires clear and objective criteria, which could harmonize international standards and advance the acceptance of sensory marks globally. Finally, the author proposed more study or research into the actual uses and problems of smell trademarks to help policymakers and legal practitioners adjust to this developing field of intellectual property.

Abhijeet Kumar (2016), protecting smell marks: breaking conventionality, journal of intellectual property rights, volume 21 pp129-139.⁸

The article discusses about the emerging recognition of smell marks as trademarks. The author found that Smell influences consumer behaviour and brand identity yet legal protection remains limited. Reviewing developments in jurisdictions like the U.S., the E.U., and India, the author highlights successes in scent recognition as trademarks (e.g., *Qualitex*) alongside obstacles, such as the stringent Sieckmann test in the EU, which demands clear graphical representation. With proponents citing smells unique branding potential and opponents questioning its practical enforceability, the author concludes that India could advance its trademark regime by considering global practices and integrating smell documentation technologies to better support non-conventional marks. The author recommended for the incorporation of drafts manual suggestion which should be integrated into the trade mark act to facilitate the registration of smell marks.

Tanusree Roy (2023), Registrability of smell mark as trademark: a critical analysis, Journal on contemporary issues of law, volume 4 issue 3⁹.

The article delves into the complexities surrounding the registration of smell marks as trademarks. The author explores the international stance on smell marks, highlighting the lack of uniformity across jurisdictions, with countries like the U.S. and the EU adopting varying standards. The article emphasizes the challenges smell marks face, notably the difficulty of graphical representation, a requirement for trademarks and the subjective nature of smell perception among consumers, which complicates its consistency as a brand identifier. Through various case analyses, the author illustrates both successful and rejected scent mark registrations, critiquing the inherent limitations of olfactory trademarks in contrast to traditional visual marks. The author ultimately argues that, while smell can add a unique dimension to brand identity, its registration as a trademark is constrained by both practical and legal hurdles, advocating for harmonized global standards to address these issues.

Stavroula Karapapa(2010), registering scents as community trademarks, The trademark reporter, 100(6). Pp. 1335-1359.¹⁰

The article examines the feasibility of trademarking scents/smell in the European Union, particularly following the landmark *Sieckmann v. Deutsches Patent-und Markenamt* case. This case set up stringent requirements for smell trademarks, necessitating that they should be graphically representable in a way that is clear, precise, durable, and objective. The article explores various methods proposed for representing scents graphically i.e. Verbal descriptions, chemical formulas, chromatograms, and scent samples, all of which face challenges in meeting legal criteria. The discussion highlights the potential for

⁸ <https://nopr.niscpr.res.in/bitstream/123456789/34726/1/JIPR%2021%283%29%20129-139.pdf>

⁹ <https://jcil.lsyndicate.com/wp-content/uploads/2023/06/Registrability-of-Smell-Mark-as-Trademark-final-Tanushree-Roy-9.pdf>

¹⁰ <http://ssrn.com/abstract=2574642>.

technological advancements, such as electronic scent devices, to aid in scent representation, thereby enhancing the practicality of olfactory trademarks. Despite these technological prospects, the author emphasizes the continuous difficulty of meeting the Sieckmann requirements, concluding that, while trademarking smells is theoretically possible, practical constraints make it impossible under the present legal system.

Mohit Joshi (2020), smell mark: A new era, international journal of law management and humanities, Vol.3 Iss 3; 607.¹¹

The article discusses the evolving recognition and registration challenges of non-traditional trademarks, particularly smell marks, within IPR. It highlights how traditional trademarks have expanded to include unconventional elements such as sounds, shapes, and scents under international agreements like TRIPS, although actual registration frameworks vary by jurisdiction. The author reviews the historical acceptance of scent trademarks, noting landmark cases like the 1990 U.S. case of *In re Clarke* that set a precedent for smell marks in American law. Although countries like the United States and Australia have incorporated policies that permit smell mark registration under certain conditions, the Indian legal framework remains restrictive, reflecting a reliance on traditional trademark interpretations. The article was concluded by emphasizing the potential for legal adaptations in response to commercial trends, foreseeing future inclusivity for smell marks in countries like India.

Pooja Kulkarni (2022), smell as a trademark: its registrability and challenges in India and other countries, international journal for legal research & analysis, Vol 2. Iss 6.¹²

The article, explores the complexities of registering smell as a trademark within IPR. This area, part of non-conventional trademarks, remains contentious, particularly in India, where graphical representation is a legal requirement. The study addresses the concept of smell marks, discusses the challenges they face in India's legal framework, and compares this with global practices, including cases from the UK, US, and EU. The author highlights that despite the sensory appeal and brand value of smells, their intangible nature hinders straightforward registration. The article concludes with a call for India to expand its trademark regime to accommodate non-traditional marks, suggesting international legal alignment and improved domestic provisions.

Apoorva BN, (2020), legal status of olfactory marks under the trademark law regime, NLUA journal of intellectual property rights, vol1. Iss 2. Pp 37-48.¹³

This article provides a comprehensive examination of the challenges and legal frameworks surrounding olfactory marks in trademark law. It categorizes olfactory marks into three types: primary scent markings, secondary scent marks, and unique scent markings, emphasizing their potential to enhance brand recognition through sensory association. The author highlights the lack of explicit international and European regulations for olfactory marks, noting that while they are not expressly prohibited, they face significant hurdles in achieving trademark protection due to requirements for graphical representation and distinctiveness. Judicial interpretations from key cases in Europe illustrate the complexities involved, particularly regarding how scents can be represented and perceived. The article concludes that while olfactory marks hold potential for trademark protection, significant legal hurdles remain, primarily due to the subjective nature of scent perception and stringent requirements for graphical representation in various jurisdictions.

¹¹ <https://ijlmh.com/smell-mark-a-new-era/>

¹² <https://www.ijlra.com/productImage/Pooja%20Kulkarni.pdf>

¹³ <https://nluassam.ac.in/docs/Journals/IPR/vol1-issue-2/3.pdf>

Linda Annika Erlandsson (2004), the future of scents as trademark in the European community (based on a comparison to the American experience), Lund university publications.¹⁴

This article delves into the intricate legal issues surrounding the registration and safeguarding of scent marks in Europe, making comparisons with the situation in America. It sheds light on the hurdles involved in recognizing scents as trademarks due to their subjective characteristics and the strict criteria for graphical representation, which complicate the registration process. Although there has been some historical acknowledgment of scent marks, the study concludes that significant obstacles persist, including challenges in demonstrating distinctiveness and proving infringement, indicating that without more definitive legal standards, scents may find it difficult to establish themselves as trademarks in Europe. The article underscores the necessity for a more clearly defined legal structure to support the integration of scents in branding and marketing efforts.

RESEARCH PROBLEM:

A recent advancement in intellectual property rights involves non-conventional trademarks. Trademarks such as scents, sounds, gestures, and holograms can be registered if they meet specific conditions. Although olfactory trademarks could improve brand distinction and consumer awareness, their legal acknowledgment is still restricted because of strict criteria for graphical representation, individual interpretations of scent, and varying standards in various jurisdictions. Consequently, there are no standardized regulations for registering and enforcing smell trademarks, especially in India, where existing laws fail to sufficiently address these unique identifiers. The study aims to address these gaps by exploring the legal hurdles and proposing solutions for better integration of smell marks into trademark law.

RESEARCH OBJECTIVE:

The article's primary objective is to comprehend and analyse the variety of non-traditional trademarks, with a focus on scent as a trademark. This study assesses the function of Smell Mark in global development by doing comparative evaluations of several nations. In order to propose a more flexible legal framework that would facilitate these new branding strategies, the research aims to examine the problems associated with smell mark registration and enforcement under the Trade Mark Act of 1999.

RESEARCH QUESTION:

1. What is a scent mark, and what difficulties does it encounter with regard to subject perception, graphical representation, and distinctiveness?
2. What are the legal framework governing the registration and the position of smell marks in various countries, particularly in India?
3. How do existing case laws illustrate the difficulties and successes in registering smell marks?

RESEARCH HYPOTHESIS:

If smell markings are accepted in India, a more adaptable and understandable legal framework is required to permit their registration and enforcement, enabling them to operate as valid non-traditional trademarks. According to this idea, adding smell marks to trademark laws will encourage creative branding while ensuring that trademark protection is clear and enforceable.

¹⁴ <https://lup.lub.lu.se/luur/download?func=downloadFile&recordId=1557334&fileId=1564287>.

RESEARCH METHODOLOGY:

With a thorough examination of secondary materials, the researcher has embraced doctrinal research. The data, statistics, and laws referenced in this work was taken from a variety of trustworthy websites, publications, and articles. Additionally, the researcher primarily utilized a qualitative method of research.

SCOPE AND LIMITATION OF THE ARTICLE:

The article's scope includes a thorough analysis of scent marks as non-traditional trademarks, with a specific emphasis on the difficulties associated with their registration and enforcement under different legal systems, especially in India. This research aims to assess the potential for safeguarding scent marks through trademark protection, rather than relying on additional legal frameworks that could also include trademarks. Consequently, the principles of unfair competition, dilution, copyright, patent, and other relevant legal domains concerning scents will not be explored. Reliance on secondary data may not fully capture every nuance of practical applications or new trends pertaining to scent marks because this study is doctrinal in nature. Furthermore, non-conventional trademarks such as smell marks struggle to meet the graphical representation criteria established by the Indian Trademark Act of 1999. To date, the registration process in the country has been difficult due to the necessity for uniqueness and the inability to be visually portrayed.

CHAPTERS

1. DEFINITIONS

1.1 WHAT IS TRADEMARK?

According to the Trademark Act of 1999, "trademark" has a wide and nuanced definition in India and other nations. To guarantee that trademarks may be adjusted to reflect changes in the industry, lawmakers sought extensive protections. Trademark protection is important because it gives the owner legal rights to prohibit others from using identical marks that may confuse customers. The Bombay High Court emphasized the purpose of trademark law in the case of *cluett peobody & co. inc. v. Arrow Apparel*,¹⁵ by stating protection of the proprietary rights of the holder of registered trademark is the objective of the trademark legislation. More recently, the Delhi High Court noted in *Cadbury India Ltd. v. Neeraj Food Products*¹⁶ that the fundamental purpose of the Trade Marks Act, 1999, is to prevent dishonest trademark adoption with the aim of profiting from the goodwill and reputation that a trademark has gained. Thus trademark are serious business.¹⁷

As per **section 2(1)(m)**¹⁸ of the Trademark Act, 1999 defines "mark" as a device, brand, heading, label, ticket, name, signature, word, letter, numerical, shape of products, packaging, or colour combination. The trademark Act 1999 defines "trademark" in **section 2(1) (zb)**¹⁹ as a graphic mark that distinguishes one person's goods or services from others, including shape, packaging, and colour combinations. According to **rule 2(k)**²⁰ of the trade marks rules 2002, the trademark that is being claimed must be able to be graphically depicted.

¹⁵ *cluett peobody & co. inc. v. Arrow Apparel*, 1997 SCC OnLine Bom 574.

¹⁶ *Cadbury India Ltd. v. Neeraj Food Products*, 2007 SCC OnLine Del 841.

¹⁷ *People v. wangdu*, 872 N.Y.S 2d 693 (table) N.Y.City crim.Ct., 2008

¹⁸ the Trademark Act, 1999 No 47, act of parliament, 1999

¹⁹ the Trademark Act, 1999 No 47, act of parliament, 1999

²⁰ The trademark rules, 2002, parliament of India.

A trademark is a graphic representation that distinguishes one person's goods or services from another. It can include product shape, packaging, and colour scheme. The TRIPs Agreement defines a trademark under Article 15(1), as any sign or combination of signs that distinguishes one undertaking's goods or services from others. There are two types of trademarks: conventional (traditional) and non-conventional (contemporary). A trademark is typically a term, name, symbol, or other sign that identifies a manufacturer's products and services. In today's trademark world, non-traditional trademarks include smell, sound, and taste, among others. Non-conventional trademarks are still underutilised in India, despite increasing popularity in recent years.

1.1.1. NON- CONVENTIONAL TRADEMARK

Non- conventional trademarks have a long history dating back to the middle ages. Although they were not officially noted or documented, prevailing customs indicated that specific types of marks were recognized and used to differentiate products from their competitors in the marketplace. An unusual instance of an unconventional trademark recognized during that period was the distinct tone produced by tapping a pewter piece against another metal, creating a specific sound that set it apart from others.²¹ Thus these trademarks doesn't fall under the ambit of the conventional definition of trademark. These markings include three-dimensional marks, sound marks, motion marks, position marks, holographic marks, and slogans, feel marks, smell marks, and taste marks. They are not limited to words, symbols, names, devices, packaging, or combinations of collars. Nonetheless, the visual depiction of these unconventional marks presents a challenge that needs to be addressed.

1.2 WHAT IS SMELL MARK?

We frequently ignore the unseen yet potent force of smell, which influences our memories, emotions, and choices. The sense of smell plays a quiet yet significant role in our lives, whether it's the comforting aroma of a cherished person's fragrance or the invigorating smell of freshly grounded coffee. In the realm of business and branding, scent is increasingly recognized as a novel resource, paving the way for olfactory branding, which utilizes unique aromas to foster enduring connections and customer loyalty²². A smell mark is a kind of unconventional trademark that employs fragrance to identify a product or brand. Smell marks challenge the limitations of trademark law, forcing legal institutions to evolve further. While visual and aural marks are widely recognized, scent marks provide a challenge to standard trademark registration requirements such as uniqueness and representation. Thus successfully registering a scent mark can create a precedent for future cases and broaden trademark law to fully incorporate sensory branding.²³

2. REGISTRABILITY OF SMELL MARK

One novel and difficult area of intellectual property law is the idea of registering scent marks as trademarks. Smell markings are olfactory trademarks that use aroma to accomplish the same objective as traditional trademarks, which use visual components like names, logos, and symbols to differentiate products or services. Theoretically, smell marks can be registered, but in practice, this is quite improbable. The interpretation of trademarks, particularly in relation to unconventional trademarks, requires careful

²¹Gary Richardson, NBER working paper series, National Bureau of Economic Research, Massachusetts, Cambridge (2008).

²²*Olfactory marks (smell marks)* (no date) *Legal Service India - Law, Lawyers and Legal Resources*. Available at: <https://www.legalserviceindia.com/legal/article-2928-olfactory-marks-smell-marks-.html>.

²³ *Importance and challenges of protecting smell marks in India* (2022) S.S. Rana & Co. Available at: <https://ssrana.in/articles/importance-and-challenges-of-protecting-smell-mark>.

consideration. Generally the smell mark registration are less due to difficulty of graphical representation. A significant advancement in Indian trademark law occurred with the introduction of the new Trademark Rules in 2017. Aside from sound marks and shape marks, no other unconventional trademarks receive explicit protection. However, a mark can become a trademark in India if it is visually depicted and satisfies the uniqueness requirements. A brief examination of the definitions provided in both national and international contexts suggests that one of the primary issues is to develop a broad and functionally-based understanding of trademarks. As a member country, India has adopted a flexible definition that encompasses elements such as shape, packaging, and colour combinations. In this regard, unconventional trademarks are not entirely excluded from consideration. Fundamentally, there are two essential criteria that a mark must meet to qualify as a trademark: distinctiveness and graphical representation.

2.1 DISTINCTIVENESS

Distinctiveness pertains to a trademark's capability to indicate the source of products or services and differentiate them from competitors in the marketplace. In the case of a scent mark, distinctiveness necessitates that the fragrance is distinctive, serves no practical purpose, and is directly linked to a particular brand in the minds of consumers. The unique characteristics of products allow consumers to find them, even if they can't recall their names. These characteristics may include packaging, colours on the packaging, or even the scent of the product. Even if consumers struggle to articulate the specific scent, aromas can assist them in recognizing the product by triggering their olfactory memory. In order to qualify for trademark protection and meet the 'distinctiveness' criteria, scent trademarks must evoke this cognitive association.

There are two types under this concept one is inherent distinctiveness and acquired distinctiveness;

INHERENT DISTINCTIVENESS: A fragrance that is uniquely identifiable should be atypical for the product type and not frequently linked to it. In most legal areas, inherent distinctiveness for scent trademarks is seldom acknowledged due to the sensory characteristics of smell. Consider a situation where a company aims to trademark the aroma of freshly cut grass for tennis balls. Typically, tennis balls lack a recognizable scent linked to them, making the fresh-cut grass smell a potential differentiator if consumers start associating that distinct fragrance with this particular tennis ball brand. Nevertheless, the viability of such a trademark application hinges on demonstrating that the scent is non-functional (meaning it doesn't improve gameplay or provide any practical benefits) and is distinct enough for consumers to promptly identify the product's origin.

In the case of *re Clarke*²⁴, The petitioner sought to register the fragrance of a plumeria blossom for sewing threads and embroidery yarn. The USPTO acknowledged the fragrance as inherently distinctive due to its rarity within the category. Consumers could link the plumeria scent specifically to Clarke's product, thereby meeting the distinctiveness criterion. This case stands out as one of the few instances where a scent mark was deemed inherently distinctive, given that the scent was completely unexpected for such a product (sewing threads), and no competing products featured a similar fragrance.

ACQUIRED DISTINCTIVENESS (SECONDARY MEANING): A scent can acquire distinctiveness when consumers gradually connect it to a particular brand, often as a result of significant use and promotion. For example, think about a shampoo brand that features a distinctive coconut-vanilla fragrance. At first, this scent may not stand out distinctly, as coconut-vanilla is a common association with various personal care items. However, if the brand continually promotes and utilizes this specific scent over time,

²⁴ re Clarke 17 USPQ2d 1238, 1239 (TTAB 1990).

consumers may begin to connect that particular coconut-vanilla fragrance exclusively with the brand's shampoo. This developed association can result in secondary meaning, which may render the scent eligible for trademark protection. In order to establish a secondary meaning, the fragrance needs to be utilized consistently for an extended duration, allowing consumers to associate it with a specific brand. After secondary meaning is established, the fragrance may be eligible for trademark registration as a non-functional brand identifier, as demonstrated in cases such as *In re Clarke*.

According to Articles 4 and 7(1) (b) of the Community Trademark Regulation, a trademark cannot be registered if it lacks distinctiveness. In the case of olfactory marks, the determination of distinctiveness is influenced by the specific connection of the mark to the relevant products; a scent that is distinctive for one product may not be distinctive for another. Therefore, the examination must consider the unique circumstances of each individual case. Although it is feasible to register a scent trademark in certain areas, it is incredibly difficult due to strict requirements for distinctiveness. The United States has allowed a limited number of smell trademarks, provided the scent is deemed unconventional and not utilitarian. In contrast, the European Union mandates both a graphical representation and distinctiveness, which greatly restricts the ability to register scent trademarks.

2.3 GRAPHICAL REPRESENTATION:

Another essential criteria for registration of trademark is graphical representation. Trademark law typically necessitates that a mark is depicted visually to maintain clarity, objectivity, and uniformity in the registration process. This is essential for public awareness and allows others to understand the full scope of the rights granted. In other words, the mark should be able to be depicted in both printed and digital formats. The graphical representation must be clear, precise, self-sufficient, easily understandable, long-lasting, and objective. For unconventional trademarks, it is often not feasible to represent the entire mark graphically, as the law does not provide explicit definitions for graphical representation, aside from rules concerning shape, colour, and sound marks recently. When Yahoo submitted its application for registering sound marks, India had no clear guidelines regarding the graphical representation requirements for sound as trademarks. As a result, the petitioner relied on the standards established in various legal precedents from other regions of the world. In doing so, they specifically referenced procedures and practices in the United Kingdom and adhered to the *Sieckmann*²⁵ criteria. Conventional trademarks, including logos, names, and symbols, are primarily visual, making them easy to depict graphically. In contrast, smell marks, which are non-visual, pose specific difficulties in meeting this requirement, particularly under the earlier "*Sieckmann Criteria*" of the EU, which require representation to be clear, precise, self-contained, and objective.

2.3.1 ATTEMPTS TO GRAPHICALLY REPRESENT SMELL MARKS:

Chemical Formulas: One approach that has been tried is using a chemical formula to convey the scent. Nevertheless, this method frequently does not capture the true essence of the smell, since chemical formulas merely outline the ingredients rather than the sensory experience itself. In the case of *Sieckmann*, the applicant characterized the olfactory mark as the "pure chemical substance methyl cinnamate," providing its chemical formula: $C_6H_5-CH=CHCOOCH_3$. The ECJ determined that such a depiction "does not represent the odour of a substance, but the substance itself" and was not "sufficiently clear and precise." The chemical formula could not adequately represent a scent, as a product may produce various

²⁵ *Sieckmann v. Deutsches Patent- und Markenamt* (Case C- 273/00, ECJ, December 12, 2002)

olfactory impressions depending on factors like its concentration, ambient temperature, or the medium carrying the scent. Consequently, the requirement for graphic representation was not fulfilled. This is because the experience of smell is based on individual perception and cannot be fully represented by a chemical formula. For example, although $C_6H_5-CH=CHCOOCH_3$ (methyl cinnamate) has a clear chemical composition, it fails to convey the “balsamically fruity” quality that Sieckmann sought to register. The shortcomings of this method in effectively conveying the scent experience to the public reveal a notable deficiency in existing legal frameworks. While future progress in digital and sensory technologies may provide alternative solutions, chemical compositions on their own are presently inadequate for smell mark registration in the majority of jurisdictions.

Colour Coded Systems: Systems that use color coding have been proposed as a creative method to visually depict scent markings. The concept involves assigning colors to express the qualities or notes of a scent, with particular colors symbolizing distinct smells or olfactory elements. Nonetheless, these systems encounter major challenges due to the absence of standardization, objectivity, and widespread legal approval. The goal of the system is to develop a visual signal that can express scent qualities without depending on intricate descriptions or personal interpretations. Certain scent branding firms have sought to develop color-odor mapping that link colors to broad scent categories. For instance, a gentle purple might symbolize lavender, while a bright yellow could signify citrus. However, these connections lack standardization and are not widely accepted. The mapping that different cultures or individuals have with particular colors can differ significantly, rendering these mappings unpredictable and inconsistent.

Despite its graphic nature, an illustration of a strawberry was denied registration for a fragrance characterized as “the scent of a ripe strawberry.”²⁶ The refusal was based on the premise that the visual representation illustrated a strawberry rather than conveying the aroma of the fruit, which could mislead consumers. Upon appeal, the Board of Appeal upheld this ruling, asserting that the visual depiction of the strawberry failed to offer an objective, clear, and accurate representation, either on its own or alongside a verbal description. This situation demonstrates that simply linking colors to fragrances probably won't meet legal standards, as colors do not provide the specificity and precision required for scent trademarks. Color-coded systems do not adequately represent smell marks in trademark law because they lack precision, uniformity, and objectivity. Without the establishment of a standardized system, their practical use may continue to be limited.

2.3.2. Other attempts to graphically represent smell mark:

- a) Advancements in digital and technology are creating fascinating opportunities for the depiction and communication of scent marks. Innovations like electronic scent markers, scent-emitting devices, and digital scent storage hold the potential for a more objective representation of smell marks. Nonetheless, these technologies are still in their early stages and have not yet gained widespread acceptance or practicality in trademark legislation.
- b) Descriptive writing seeks to convey a scent in a way that allows for an understanding without the need for a direct olfactory experience. The goal is to articulate the scent in a manner that enables both the public and evaluators to accurately visualize or conceive of it. Smell is a multifaceted sensory perception, and even familiar scents such as “freshly mowed grass” can be perceived differently by different people. This variability in interpretation makes it challenging to rely on written descriptions as definitive identifiers for trademark applications.

²⁶ *EDEN sarl vs OHIM (Odeur de fraise mure)* ECLI:EU:T:2005:380

3. REGISTRABILITY OF SMELL MARK IN DIFFERENT COUNTRIES

3.1 POSITION IN UNITED STATES:

The largest capitalist nation in the world is the United States. In the US, new companies are popping up every day thus Scents and goods connected to smell are the focus of several businesses. The US approach towards smell mark is very different from other countries like European countries and India. There are a limited number of registered scent trademarks in the United States because of the strict criteria. The United States Patent and TradeMark Office (USPTO) concluded that since scents are not specifically excluded from the statute, they are eligible for registration under Section 2(f) of the Lanham Act, confirming that scents can function and fulfil the objectives of a trademark. According to the Act, "protection can be provided for any words, symbols, names, or combinations thereof if they serve to identify and distinguish the goods or services of one entity from those of another." Consequently, being capable of graphic representation is not a requirement in the country. A negative definition of a trademark is provided in Section 1052 of the Lanham Act, along with information on the requirements for registration. This legal provision states that a trademark must meet certain criteria, such as non-functionality, uniqueness, or acquired distinctiveness, in order to help customers distinguish one product from another. A prominent case is the approval of the fragrance of Plumeria blossom for thread and embroidery yarn (In *Re Clarke*, 1989), where the USPTO allowed the registration after the applicant proved that the scent was non-functional and served to identify the source.

In the 1988 Congress, terms such as 'symbols' and 'devices' were preserved in the definition of trademark found in Section 15 of the Act, which permits the registration of non-traditional trademarks such as smells, sounds, and shapes. The US legal framework does not prohibit the registration and protection of sounds and fragrances. The Supreme Court's progressive stance in *Quinitex Co. v. Jacobson Products and Co*²⁷. Highlights distinctiveness as the key purpose of a trademark. In the case of *In re Pohl-Boskamp GmbH & Co*²⁸, the Trademark Trial and Appeal Board (TTAB) upheld the denial of Pohl-Boskamp's request to register a peppermint flavor and scent for its nitroglycerin spray designed to alleviate angina. The Board concluded that both the flavor and scent were functional under Section 2(e)(5) of the Trademark Act, as they played a role in the product's efficacy and were not simply decorative. Furthermore, the TTAB ruled that the applicant did not provide sufficient proof that the marks had acquired distinctiveness, noting the presence of rival products with similar traits and a lack of evidence that consumers identified the flavor and scent as indicators of origin. As a result, both refusals were affirmed, highlighting the difficulties associated with obtaining registration for non-traditional trademarks in a competitive landscape.

As a result, the United States takes a careful and selective approach to smell mark registration, emphasizing that only smell that are used simply as identifiers and lack any functional component are eligible for trademark status.

3.2 POSITION IN EU COUNTRIES

The registration of scent trademarks in Europe encounters major obstacles mainly because of the need for graphical representation as specified in the European Union Trade Mark Regulation (EUTMR). As stated in Article 4 of the EUTMR, a trademark must be displayed in a way that enables both relevant authorities and the public to understand the exact extent of the protection granted to its owner. This stipulation has proven particularly challenging for scent marks, as odors are not easily represented visually. Historically, trademarks had to be visually depicted in order to be registered under EU law, which made scent marks

²⁷*Quinitex Co. v. Jacobson Products and Co*, 514 US 159(1995).

²⁸*In re Pohl-Boskamp GmbH & Co*, 106 U.S.P.Q.2d 1042 (TTAB Feb. 25, 2013)

especially challenging. Words or chemical formulae alone were insufficient to describe a smell since they lacked the clarity, accuracy, and accessibility that the general public and other traders required.

In the matter of *Ralf Sieckmann v. Deutsches Patent and Markenamt*²⁹, the significance of pictorial representation was emphasised. The European Court of Justice developed the "Sieckmann seven-fold Test" in this case, stating that a graphical portrayal of odours must meet the following conditions to be valid: "clear, precise, self-contained, easily accessible, intelligible, durable, and objective." Post-Sieckmann Developments In 2017, the EU Trademark Reform eliminated the rigorous necessity for a "graphical" representation, paving the way for various clear and exact representations, such as digital formats. Despite this improvement, the representation issues for scents persist. In the absence of a universally accepted method for scent representation, there has been minimal advancement in the registration of smell trademarks within the EU. In the case of *Odeur de fraise mure* (2005)³⁰, a trademark registration application was submitted to register the aroma of ripe strawberries. The General Court of the European Union ruled that the given description was inaccurate and ambiguous since it was too general and could be used to describe several types of strawberries. The court underlined that it did not meet the conditions for registration under Article 4 of the EUTMR since the representation of the scent was unclear. While scent trademarks are legally permitted in the EU, no smell trademark has been successfully registered under the updated regulations due to the challenges of objectively depicting and describing fragrances. Other non-conventional trademarks, such as sounds and colors, are more frequently registered because they can be represented more accurately in a manner that satisfies legal criteria. The EU still recognizes the potential for scent trademarks, but practical obstacles render their registration nearly impossible for the time being. Currently, the EU Intellectual Property Office (EUIPO) mainly authorizes visual, sound, and other non-traditional trademarks that fulfil representational requirements.

The Trade Mark Reform Package, comprising Directive 2015/2436 and Regulation (EU) 2015/2424, seeks to update trademark law within the EU. A key change is the elimination of the stringent requirement for trademarks to have a graphical representation, allowing for a wider interpretation of how trademarks can be presented. Rather than requiring a visual illustration, applicants must depict their mark in a way that allows both the relevant authorities and the public to clearly and precisely understand the scope of the protection granted to them (Article 3(b) of the Directive). To summarize, although recent changes have established a more adaptable system for registering smell trademarks in Europe, considerable obstacles persist due to technological constraints and regulatory limitations regarding representation techniques. The success of forthcoming applications will probably rely on the advancement of dependable technologies that can effectively depict scents in accordance with EU trademark regulations.

3.4 POSITION IN UK

The UK enacted a new trademark law to implement the Community Trademark Regulation of 1993. The successful registration of a rose-like floral scent for tires by *Sumitomo Rubber Co.*³¹ and a beer-like scent for darts flights by Unicorn Products came next. Similar to the ECJ decision, the issue even existed in the UK with the marks' pictorial portrayal. In addition to being necessary for the mark to be registered and published, visual representation also makes it possible for the parties to search the trademark register and determine the scope of already-existing trademark rights. In a case involving the registration of cinnamon's scent or aroma on furniture, the Principal Hearing Officer emphasised the challenge of registering smell

²⁹ C-273/00, 2003 E.T.M.R. 37

³⁰ Edén SARL V. OHIM, T- 305/04

³¹ BananaIP Counsels, <https://www.bananaip.com/non-conventional-trademark-smell-marks/>.

marks by pointing out that a man's perception of the scent is likely to be influenced by the circumstances under which they have been evaluated. According to the OHIM Third Board of Appeal in another instance of this type, it is crucial that the mark has distinctive character in addition to graphical representation. The inability of an olfactory mark to be visually seen led to the question of whether it could be a trademark subject matter in any way. In the *Sieckmann v. Deustches Patent-und Markenamt*³² case before the European Court of Justice, the answer to this question was addressed for the first time. Instead than focussing on visual perception, the ECJ highlighted the mark's pictorial representation. Instead than focussing on visual perception, the ECJ highlighted the mark's pictorial representation. However, the ECJ also determined that graphical representation alone is insufficient for registration and that it must meet the following requirements: To make the purpose of the right of exclusion instantly apparent, it must be comprehensive, specific, and unambiguous. It must be understandable to those who are interested in looking through the register, such as other consumers and manufacturers. Thus, while olfactory mark registration is legal and open in the UK in theory, in practice it is completely the opposite, particularly with regard to Sieckmann, as court rulings have invalidated written descriptions, chemical formulas, samples, and electronic sensory analysis.

3.5 POSITION IN NEW ZEALAND

New Zealand's stance on smell marks is notably more cautious than that of other nations, especially the United States and the United Kingdom. Although New Zealand acknowledges smell marks as a category of non-traditional trademark, the actual results have been minimal, with only four applications submitted and none successfully approved. In 1995, for instance, The Boots Company Plc. attempted to trademark the scent of cinnamon for pharmaceuticals. This application, along with three others, did not succeed in passing the examination phase. While uncommon, it is still feasible to register a scent as a trademark if it fulfils Intellectual property office of New Zealand's (IPONZ) requirements for distinctiveness: The scent is not a natural or inherent trait of the goods or services. Therefore, perfumes and air fresheners are unlikely to be regarded as distinctive since their fragrance is vital to their functional purpose; and the scent is not widely recognized in the industry.³³ For instance, one could not trademark the scent of coconut for tanning products or the scent of lemon for cleaning products, as these fragrances are commonly used by others in the market. In conclusion, registering a scent mark in New Zealand entails providing a precise description, establishing uniqueness without functioning, and going through an inspection and potential opposition procedure. Thus, while the legal structure in New Zealand allows for smell marks, its real-world implementation is considerably more limited compared to some other jurisdictions where such marks have been successfully recognized.

3.6 POSITION IN INDIA

As of May 2024, scent markings are not specifically recognized as trademarks under Indian law, and there are no formal rules governing their registration. Since smell marks are not specifically recognized under the Trade Marks Act of 1999, their legal status in India is still in its infancy. Conventional trademarks like words, logos, and symbols are mainly covered by the Act, but non-traditional marks—including scent marks—face considerable registration difficulties because there are no particular rules or regulations in existence. The Indian legislation regarding trademarks aligns closely with international agreements, and it is broad in nature, meaning it neither specifies nor rules out the possibility of registering non-conventional marks as trademarks.

³²*Sieckmann v. Deustches Patent-und Markenamt*, C-273/00, 2003 E.T.M.R. 37

³³AJ Park, <https://www.ajpark.com/insights/guide-to-protecting-your-trade-mark-in-new-zealand/>.

Analysing Sections 2(1) (zb) and 2(1)(m) of the Trademarks Act, 1999³⁴ in India indicates that the definition of a trademark has been broadened to include shapes, packaging, and combinations of colours. According to Section 319 of the Draft Manual, any mark that can be graphically depicted and can distinguish the goods or services of one individual from those of another is recognized as a trademark. It has been observed that during the registration process, greater emphasis should be placed on colours, shapes, sounds, and scents. Furthermore, an application for trademark registration must contain a graphical representation of the trademark as stipulated by Rule 25 (12) (b) of the Brand Rules, 2002, while Rules 28 and 30 require that the trademark is presented on paper in a permanent format.³⁵ In 2009, the Trademark Office published a Draft Manual that discusses the registration procedure for non-traditional marks and provides detailed guidelines concerning them³⁶. To date, the provisions outlined in the Draft Manual have not been added to the Trade Marks Act of 1999. As a result, the process for registering smell marks as individual trademarks has yet to reach a conclusive outcome. For the scent mark to be registered in India, uniqueness and visual representation are therefore required. It is more difficult to register because of these strict requirements and unclear legal paths.

Currently, India does not have any registered smell marks, resulting in confusion for businesses looking to safeguard distinctive scents. The lack of established legal precedents makes the registration process even more challenging. Recently, Sumitomo Rubber Industries Limited has made a significant effort to secure an olfactory trademark for tires that emit a floral fragrance. If approved, this application could be the first successful registration of a scent trademark in India. The company has already obtained a similar scent trademark in the UK.³⁷ Sumitomo's application might trigger conversations about revising Indian trademark laws to better support non-traditional trademarks. As international practices change, Indian legislators may face growing pressure to rethink current regulations that impede the registration of smell marks. In contrast to regions such as the United States and the European Union, where certain scent trademarks have been acknowledged, India's legal system remains cautious about recognizing non-traditional trademarks. In conclusion, despite the potential and interest in olfactory trademarks in India, there are still a lot of legal and administrative obstacles to overcome.

4. RECOMMENDATIONS

Create Comprehensive Standards for Graphical Representation: India might think about setting up standards for the graphical representation of scents, which could encompass descriptive terminology, chemical structures, or digital scent technologies as substitutes. This would aid in streamlining the registration process for smell marks and make it easier for applicants to navigate. Otherwise India's trademark legislation should remove the requirement for graphical representations, similar to the approach taken in the EU and the USA, permitting descriptions or digital representations instead.

Consider potential revisions to the Trademark Act of 1999: Investigate the possibility of amending the Trademark Act to specifically acknowledge non-conventional marks, including scents, sounds, and colours. A modification that accepts these marks as valid types of trademarks would create a more thorough framework that supports contemporary branding approaches.

Implement a Flexible Distinctiveness Criterion for Scent Marks: Create distinctiveness guidelines that

³⁴ The Trademark 1999. Act no. 47 of 1999, Act of Parliament.

³⁵ The Trademark rules (2002)

³⁶ Mirdula Bhatt(2023), the case of unconventional trademarks – does the trade marks act 1999 need reform, SCC blog

³⁷ Lokesh Kansal & Malabika Boruah (2024), sound marks & smell marks in India, Naik Naik&co.

focus on non-functional scent attributes, guaranteeing that scent marks are unique without being inherently linked to the product's functionality. This method would be in harmony with global standards, notably the U.S. framework, which requires scents to be distinctive and non-functional in order to be eligible as trademarks.

Frame proper definitions: Sometimes a buyer's inclination to buy particular products is determined just by the "smell," hence a precise description for an unconventional mark is required. India has not yet recognized scent as a trademark. Nevertheless, the country has successfully acknowledged certain non-conventional marks, such as sound marks and color marks. Therefore, Indian law and the judiciary need to interpret the concept of trademarks more broadly by explicitly including non-conventional trademarks in its definition.

Develop alternative form of representations: Written descriptions, chemical structures, or sample submissions are all valid forms of representation for olfactory marks.

Enhance Awareness Among Companies and Intellectual Property Experts: Organize workshops, seminars, and educational sessions to inform businesses, legal practitioners, and examiners about olfactory trademarks and their possible significance in branding. These initiatives would cultivate interest and educate stakeholders on the registration process, boosting demand and support for legislative reforms.

Digitalization technology: Promote the use of chromatographic and other technologies that offer an objective foundation for identifying smells. Mass spectrometry is a crucial tool in digitalization technology for smell, which captures unique chemical profiles of scents. This technology enables precise identification and comparison of sensory trademarks, providing a standardized, objective representation for trademark registration and enforcement, despite being experimental.

Establish a Pilot Program for Scent Mark Registration: To explore the practical effects of integrating smell marks, a pilot initiative could be initiated. This program would permit the trial submission of scent mark applications, allowing the government to gather data and adjust policies as necessary prior to broader implementation.

International Collaborative Initiatives: Collaborating with global IP organizations like WIPO to participate in and gain insights from worldwide standards concerning non-traditional trademarks. Aligning India's practices with international benchmarks could enhance cross-border trademark safeguarding and strengthen the Indian system's ability to address unconventional marks more effectively.

CONCLUSION

The ability of a trademark to leave an impression on consumers and aid in differentiating one trader's goods from another is its fundamental component. In contrast to uniqueness, which is a trademark's inherent quality, graphic representation has emerged as a criteria with the evolution of the trademark law framework. Therefore, rather than ignoring the topic entirely, we should be able to find ways to address any issues that are present in that field allowing such marks to be registered. Even International conventions must address advancements in non-conventional markings. The difficulty of registering these marks as trademarks, whether in digital or physical form, shouldn't stop people from using them and coming up with creative new ways to recognize and classify them. It should be created to provide protection to the owners of both these unusual trademarks and any new ones that could emerge in the near future. The study highlights the need for a more adaptable legal structure that takes into account non-traditional marks like scent marks, particularly in India where current laws are inadequate. By putting forward concrete recommendations for reform, the study advocates for a legal environment that not only

recognises scent marks but also facilitates their registration and enforcement, thereby aligning with global practice and strengthening intellectual property rights in this emerging sector.

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