

Making Scents of Olfactory Marks



Not only do scents add commercial value to a product, but they can also perform as a distinctive feature of a product. **Manish Biala** and **Ashutosh Upadhyaya** explore the use of scent marks in Europe, the United States and – perhaps one day – India.

We understand that a trademark is a commercial identity, which provides a business an absolute protection against infringement and misuse. The common understanding in case of trademark infringement or passing off is how the impugned mark creates confusion for a consumer with “average intelligence” and “imperfect recollection.” This rule is limited to the visual memory and identification of a consumer. However, it is neither impossible nor difficult for a consumer with “average intelligence” and “imperfect recollection” to identify the source of a product merely by the smell or scent of the product.

Not only do scents add commercial value to a product, but scents can also perform as a distinctive feature of a product and can further help the consumer to identify the product without having to know its trade name. However, this is only possible once the scent of the product is used uninterruptedly as a mark and has acquired distinctiveness amongst its users.

The very first commercial use of a scent mark was by a yarn manufacturer known as Clarke, in the United States.

In re Clarke, 17 USPQ 2d 1238 (1990)

Clarke was a yarn manufacturer who added scent to its product; the packaging was such that the smell of the products was not precluded at the time of the sale. Clarke used a scent of “high-impact, fresh floral fragrance reminiscent of plumeria blossoms” in its product. The scent was initially rejected by the US Patent and Trademark Office (USPTO), but was eventually

allowed on appeal.

It was held by the USPTO's Trademark Trial and Appeal Board on appeal that Clarke was the only manufacturer to market threads and yarns with fragrance, and the fact that Clarke was the only manufacturer weighed in favour of acquired source identification.

Clarke also advertised its products in such a manner which made the added scent a notable feature of the yarn, and consumers bought the company's yarn because of its scent. Also, before purchasing the yarn, consumers were able to smell the product. Such marketing tactics gave Clarke's scented yarn a distinctive feature, making it known solely for its scent.

Essential Requirements for a Scent Mark to be Registered

Distinctive character. Distinctive character is an essential requirement for a scent mark to be registered in both the United States and the European Union. The distinctive character of a product is achieved when the smell of the product is so unusual and unique that it helps the consumers identify the product, without actually having to look at it.

Such distinctive character can either be an inherent quality of the product:

- 1) The registration of a scent mark for a tyre in United Kingdom (Reg. No. 2001416) described the scent as “a floral fragrance/smell reminiscent of roses applied to tyres.”

2) The registration of a scent mark for a dart flight in the UK (Reg. No. 2000234) was described as “the strong smell of bitter beer applied to flights for darts.”

Or, such distinctive quality can be an acquired quality of the product:

1) In 1999, the Second Board of Appeal of the EU’s Community Trade Marks Office allowed the registration of “the smell of fresh cut grass” for tennis balls. The scent in the ball became distinctive over a period of constant use.

2) The USPTO approved the registration of a scent mark for fuel with the scent of strawberry in US Registration No. 2,596,156.

Graphical Representation. As of now, there has not been any registration for a scent mark in India. However, the trademark law for registration is somewhat similar to that to the European Union. The law states that a trademark means a mark that can be graphically represented and is capable of distinguishing goods and services of one from another. It gives a little scope for scent marks in India, provided the same can be represented graphically.

This standard of graphical representation of the mark is followed in both the European Union and India; however, in the US, representation of a scent mark graphically is not a mandatory requirement, as a scent mark is not something which can be represented in graphics or words.

The standard for representing a scent mark graphically was laid down by the European Court of Justice in 2002 in the matter of *Sieckmann v. German Patent and Trademark Office*.

The court in this landmark judgment stated the importance of graphical representation for all nontraditional trademarks. The court observed that non-traditional trademarks like sound and smell (olfactory) which cannot be perceived by a human visually must be represented graphically in order to obtain registration.

The next question is, what kind of representation of the scent qualifies for a registration? The court held in Paragraph 55 as follows:

“[P]rovided that it can be represented graphically, particularly by means of images, lines, characters, and that the representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective.”

Scents Which Do Not Qualify for Registration

Scents in at least three categories will not qualify for registration.

A scent mark with a poor graphical representation. The representation of a scent which does not give any clarity as to what is the claim and what the scent is supposed to smell like will be denied registration.

In *Sieckmann v. German Patent and Trademark Office*, the registration for the scent mark “balsamically fruity with a slight hint of cinnamon” was denied as the court could not decide what was meant by “balsamically” or “fruity” and how much of the hint of cinnamon would be in the smell. Due to lack of clarity in the representation, the registration was denied.

Generic scent marks. Products whose scent has become generic will not qualify for registration, such as rose water, lemon-scented room freshener, scented phenyl, etc.

Functional scent marks. The law states that no one can claim exclusive right over a feature of a product whose major function is to perform that particular feature. This includes scents and perfumes and was the precise reason why the registration of the smell of Chanel No. 5 was denied under the doctrine of functionality: the function of the perfumes is to give



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off a scent, although the smell of Chanel No. 5 was distinctive.

Challenges

Challenges to registering a scent mark include the following:

- 1) It is difficult to find an exact descriptive phrase to graphically represent the scent mark.
- 2) A representation of a mark must be easily understood by an average consumer, such as “smell of freshly cut grass.”
- 3) It is difficult to represent the exact nature of the smell in characters.
- 4) Different people perceive a smell differently.
- 5) Smells can be confusing.
- 6) It is difficult to identify whether a smell is generic or distinctive.

Conclusion

Scent marks, just like traditional trademarks, are capable of providing commercial value to a product. Consumers are capable of remembering the smell and can easily identify the origin of the products through smell. The use of scent sometimes becomes the sole reason behind the purchase by a consumer. In fact, scents and perfumes are all about smell, which, in turn, helps decide brand loyalty. The importance of smell in a product can be showcased by proper placement of the product. Advertisements should also revolve around the origin of the scent, its meaning and essence in the product. **AIP**



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