

**‘Substantial evidence is the requisite or mere hindrance
under Trademark act 1999’**

Aastha Sharma

Student of School of law, Sandip university, Nashik,
Maharashtra.

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Abstract

In recent decades, staying up with the globalization and aggressive commercialization, the ambit of intellectual property has been taken to unprecedented levels. The law in regards to protection of trademarks has been no exemption in such manner. As time passes, the ambit of trademark protection law is being widened from one side of the planet to the other. Trademark is an exclusive bundle of legal rights granted to its holder, it prohibits its further publications i.e. passing off/ infringement. According to a study by fortune business sight. The global perfume market is projected to grow from USD 30.6 billion in 2021 to USD 43.2 billion in 2028 at a CAGR of 5.0% in the 2021-2028 periods. Trademarks are now a distinct intangible identity as well in the form of olfactory marks, taste marks, music marks, etc. but how would you even place the intangible marks like smell along with the traditional marks like letters, numbers, etc. This article is an attempt to scrutinize the significance of olfactory marks to be regarded as an Intellectual Property and a detailed study of all the possible hindrances in the way.

Introduction

Products of industrial utilities are not developed overnight it requires earnest efforts and dedication, especially in the case of Intellectual Properties. Trademark is defined under Section 2 (zb) of the Trade Marks Act, 1999 as, "trade mark means 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 the shape of goods, their packaging, and combination of colours.¹

- With the increase in the vitality of market subjects and the rapid advancement in technology, trademarks are becoming more diversified. They are no longer limited to tangible assets like- letters, numbers, graphics, etc. They have their exclusive legal identity in the form of intangible and non-conventional forms as well which is directly linked to the olfactory organs of the human body.
In the given piece, various questions like in what possible circumstances will a non-conventional mark are registered as a trademark? Like the traditional marks, does smell also have its substantial requisites and a formal procedure to be registered? We will discuss all the formal procedures and the process involved in them.
- What are the possible hindrances to slow down the pace of development in non-conventional marks and why are they even important? Law does not work as the safeguard of a particular individual it sees the whole society and takes care of the repercussions of their actions.
- Will an olfactory mark ever get legal recognition? or already did. We will be discussing in detail and what were be the facts, held and the raised issues in the first ever registered olfactory mark based in an American company called osewez and why it does not exist today.
- Trademark is not limited to the extent of national frontiers it has its significance across international borders. Queries like - what does the international legal provision of the USA and member nations of the European Union (France, Germany) has to say will be enlightened.
 - Small Tour: ‘Smell and its relationship with Trademark’.
 - Smell:
_Won't you be more inclined toward the smell of freshly cut grass emanating from tennis balls; would they make you a winner? How about a comforting and homely smell associated with a particular type of tea?²

¹ Indian Trademarks act, 1999, under section 2

² Javvad, Olfactory marks (smell marks)
<https://www.legalserviceindia.com/legal/article-2928-olfactory-marks-smell-marks-.html>

These are the innovative and dynamic strategies that a manufacturer practices to draw its targeted consumer's attention and it is pretty much fair to give them a chance to associate their product with the extremely important aspect of the human body that certainly has its private control over what one does and how one lives. It is an interesting thought if the producers would have linked their products to our long memory lane and helped to give us a more personalized experience but there's a catch. To register a smell mark which is also called the olfactory mark, it has to go through various hindrances.

One of such perplexities is the complication arising in fulfilling the requirements of graphical representation³ and such a precise and accurate description of the product that it won't be confused with any other existing scent. The aroma has to be a distinct feature, affixed or infused into the product as an additional feature. It strictly cannot arise from the base product itself. A Trademark subject has to be capable of proving the innovation and intellect effort of an enterprise to be considered for being trademarked. Further, the functionality doctrine stands incongruous with such registrations.⁴

▪ Trademark:

It comes from the very basic human psychology that whenever an individual invests his intellect ideas, efforts, and time into a certain product it needs to be protected especially when it has the properties to draw more and quick attention. It is fair to ask for the protection of one's innovative ideas otherwise it will be irrelevant and very easily copied and exploited and a great dissuasion to the young innovative minds and this exact urge to protect the innovative ideas and an urgent need (to distinguish the property of an individual from any other product) was the whole purpose of developing the Intellectual Property Rights (IPR). Trademarks being one of the most significant

³ Harsh Pati Tripathi, "Potentiality of 'Smell' as a Trademark and its limitations" DPIIT, MCI Chair on Intellectual Property Rights & Centre for Intellectual Property Rights Research and Advocacy National Law School of India University, Bangalore.

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types under the Intellectual Property Laws exist in our society from the earliest recorded knowledge. Its development is quite evident right from ancient times. China first introduced pottery about 5000 years ago. Trademark has its significance ever since. It has been treated as an intangible asset that is subject to civil remedies in case of any infringement.

The impact that an olfactory mark can bring is quite underestimated today, as it gives an opportunity to directly deal with the functionality of the brain and can bring unbelievable personal touch to the product. With due reference to the 2006 movie called 'Perfume- The story of a murderer' set in 18th century – Paris, a story of a man with an impeccable and acute sense of scents, no other sense can override its utmost significance.

▪ First ever registered olfactory trademark and the valid grounds :

The USA registered the first ever olfactory mark which was approved in the year 1990. It is called the Frangipani Fragrance (a high-impact, fresh, floral fragrance reminiscent of plumeria blossoms) on the nice category 23 with the trademark registration number 1639128, it was mainly about the yarn and thread for weaving and the name of the owner company is OSEWEZ based in California.

Now, it is important to know in what possible circumstances, the company was able to convince the Trademark review and appeal board of the USA to grant them legal recognition. Following are the valid grounds for its registration.

There were basically 3 major grounds that restricted the board to find any ground for refusal:

First, the manufacturer was the only producer of embroidery thread and yarn of fragrances and was enjoying an absolute monopoly over the product.

Second, the feature in question was an additional feature, not an inherent or the natural property of the product itself.

Third, the applicant proved that consumers have realized this smell as scented corresponding sources of goods. This

case was crucial and did open the gates for prospects of smell as a trademark. Unfortunately, this trademark no longer exists because it was not renewed on time.

After the success of Osewez, there was another landmark and formal registration. Hasbro, Inc. the world's second-largest toy maker and distributing company, applied for the trademark of their Play-Doh compounds which refresh the vivid memories of childhood and the fun associated. Hasbro can now not only protect the valuable bond between its brand and fans but has the right to sue against any infringement for the years to come.⁵

There are reasons which certainly keep the hope of manufacturers to give the impactful impression to its consumers alive and the reason is the various examples of cases discussed above where the authority does provide the affirmation for the smells to be regarded as the trademark. For any enterprise, it is fascinating to have a legal immunity towards their intellectual property, especially over non-conventional trademarks like taste marks, Music marks, Holograms, or various olfactory marks which are quite difficult to attain but at the same time very impressive in practical corporate world.

- International Regimes:

Trademark as intellectual property is not only important concerning national regimes but to clarify its status and procedure we need to dig into its treatment globally.

01- USA: The status of smell as a trademark is not given in an American statute, In USA Intellectual Property Rights are governed by the principles of the Lanham Act, 1946 which limits the definition of Trademarks to the extent of Traditional and conventional marks, it does not recognize the non-conventional marks like- Smell.⁶

Breakthrough case laws are happening all the time, they are gradually pushing the extent of US IP laws. For instance, the landmark judgment in **Two Pesos, Inc. v. Taco**

Cabana, Inc., 505 U.S. 763 where the significant emphasis was laid down on trade dress and it confronted to include size, shape, colour or colour combinations, texture, graphics, or even particular sales techniques within itself.

Further, it was clarified in the Harvard Law review, in which it was held in the article that it is relevant to include sensory marks like- smell or colour. Hence, this case was among the initial case laws where the USA became more open toward the smell being considered intellectual property.⁷

In the light of the above-discussed case law, it is clear that the olfactory marks are recognized by the United States Patent and Trademark Office, there was another breakthrough case of **Qualitex Co. v Jacobson Prods. Co.**⁸ where the court held that Scents can be affixed or infused into a product like the Plumeria Blossom-scented yarn or hypothetical raspberry scented upholstered furniture as long as it is non-functional and has non-distinctiveness characteristics, US trademark and Patents office is open to its registration.⁹

02- European Union: Unlike any other nation, European Union was supportive in terms of recognizing olfactory marks as intellectual property-backed with legal immunity. Requisites to the trademarks were divided into two major phases. One is the period before 2015 and another is after 2015.

Before 2015, like any other mark, olfactory marks also have to go through the same eligibility criteria as any other conventional marks like mark, logo, pattern, etc. There was no such reason to restrict the smell marks and give the same recognition. One of the member nations - France pointed out a few requisites to meet to be considered for the registration, it includes: Monopoly over the product, non-functional doctrine, acquiring the distinctiveness feature,

⁵ Advances in Economics, Business and Management Research, Volume 178, FU Shuju, New Challenge on Intellectual Property: Smell Trademark.

⁶ Advances in Economics, Business and Management Research, Volume 178, FU Shuju, New Challenge on Intellectual Property: Smell Trademark.

⁷ Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763.

⁸ Qualitex Co. v. Jacobson Products Co., 514 U.S. 159 (1995)

⁹ Javvad, Olfactory marks (smell marks) <https://www.legalserviceindia.com/legal/article-2928-olfactory-marks-smell-marks-.html>

non-inherent property, etc. These were similar conditions as followed in Germany.

However, there was a shift after the period of 2015 in the provisions of the EU trademark system; Directive 2015/2424 eliminated the need to graphically represent the smell in question. It was a drastic change; as long as the mark is clear, accurate, independent, easy to get, understandable, persistent, and clearly stated then the 'graphical representation' won't stand cause any inconvenience. This makes olfactory marks acceptable in EU nations.

▪ Hindrances: 'Substantial Requisites for a smell to be regarded as a Trademark'

01. Non functionality doctrine- Though olfactory marks gained recognition in the eyes of law there was a certain need for substantial shreds of evidence to make the smell in question eligible to be trademarked. The very first requisite to accomplish was to prove the non-functionality doctrine, it shall be proved that the smell in question has to be a distinct feature of the product and must have intellect and innovative ideas involved and it cannot be an inherent property or a characteristic of the principal product itself.

02. Visual representation- Another challenge is the almost impossible visual representation of smells. It has to be so precise and accurate in the description that there would be no possibility for a consumer to get confused with any other existing product available in the market. Since writing down the composition of a smell on paper may not look like a bigger task but it will not be able to exactly tell you the chemical compounds which are responsible for the production of the smell so in question.

Although it seems all easy to register a smell mark in theory in actual sense it is very difficult to register a smell mark, The current EU case law follows the sense of a decision of the ECJ in 2002 (**case Sieckmann v. DPMA**). It held that the registration of invisible perfumes is impossible as it cannot be described on paper i.e. the graphical representation, a mere chemical compound formula is not sufficient to describe the output, a formula might tell you

the output but the smell cannot be relied upon over a mere chemical equation owing to the unstable and random nature of scents.¹⁰

One can trademark a chemical formula or the input, not the actual output and there are other possible ways to make another chemical composition that might resemble the trademarked smell. Authorities cannot register a smell based on a mere chemical equation as it is unfair.

03. Acquired Distinctiveness- Another important feature is that the smell shall acquire distinctiveness. Even a non-functional smell in a product may be considered for the registration in the absence of substantial distinctiveness to the supplement registrar. After the scent, mark has existed for four to five years and the applicant can demonstrate the acquired distinctiveness, then a new application can be filed to the principal registrar.¹¹

04. The arbitrary and unstable nature of smell- It is a big hindrance to being registered as an olfactory mark, there are possibilities of variations in the smell, and for instance, it is likely to smell different in high and low temperatures, at high altitudes. A very big challenge is to do the marketing before actually introducing it in the market since today there are no readily available and economically accessible prototypes available that can spread fragrances and smells on the internet (we won't be surprised to see such innovations shortly) it is not feasible to call potential consumers to the store and feel the fragrances, even if one tries it is a long, non-economical and hectic strategy.

Today, the Internet plays a vital role and makes marketing easy; unfortunately, smells cannot be promoted or be spread through distance.

05. Right to choose- Another very crucial aspect is that in the case of other non-conventional marks like Music trademarks – people who did not like it can put on their headset and choose not to listen, in the case of traditional

¹⁰ Sieckmann v. Deutsches Patent unter markenamt, case, C- 273/00, 2003 E.T.M.R. 37.

¹¹ Javvad, Olfactory marks (smell marks) <https://www.legalserviceindia.com/legal/article-2928-olfactory-marks-smell-marks-.html>

marks there is a choice to not look at certain images, but how would you control the olfactory organs of the human body? There is no choice but to force them and it is a strong invasion and consumers tend to lose their right to choose.¹²

▪ Bottom line:

Imagine, You're scrolling through Amazon and want to try a new Gucci perfume, and technology lets you feel the divine aroma sitting at your home, or let's say Starbucks lets you feel the refreshing smell of freshly roasted coffee beans on your fingertips, don't be surprised if you will find such option in the upcoming decades.

The olfactory sense is the strongest and among the most impactful organs of the human body, It connects you directly to the functionalities of the brain without any intermediate thoughts. It is fair to have a desire to get the legal trademarks associated with this sense but the law sees a bigger picture and merely based on some chemical compound formulas one cannot ask for remedies. With due consideration of the hindrances for an olfactory mark to be registered as a trademark, there is hope, seeing the rapid development and continuous growth in technology it is not too much to ask to presume that our engineers and scientist have already started working on prototypes that can graphically represent smells.

The prospect of smell to be regarded as a Trademark is uncertain. On one hand we have successful cases where UK registered 'tires have a floral/ rose- evoking smell' and darts have 'a strong beer flavor' They were successfully registered because they were not the inherent property of the feature itself it was the distinctiveness of the product hence were successful.¹³

On the other hand we have instances: In 2005, the European court rejected an application for a scent trademark which was described as "the smell of ripe strawberries". The chief justice of the European court held that the description is

unclear and vague as there can be various varieties of ripe strawberries.

In 2006, under '**Bsiri-barbir v. Haarmann Reime**' the French supreme court rejected the application of perfume and held that a perfume cannot be protected under IP laws as it was a pure application of technical knowledge and there was no element of creativity and innovative intellect present.¹⁴

Seeing the everyday advancement in technology, we never know, our scientist and engineers are already working on prototypes where intangible properties like smell can also be graphically represented or something like I- Smell.

Someday Starbucks will also show its monumental interest to register the unique smell of freshly roasted beans on the internet. Substantial requisites, DO NOT STOP THEM!

¹² Advances in Economics, Business and Management Research, Volume 178, FU Shuju, New Challenge on Intellectual Property: Smell Trademark.

¹³ *Ibid*

¹⁴ *Ibid*