

INTERNATIONAL JOURNAL OF LAW
MANAGEMENT & HUMANITIES

[ISSN 2581-5369]

Volume 5 | Issue 1

2022

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Position of Smell Marks and Taste Marks: India vs Developed Nations

AKANKSHA CHOUDHARY¹ AND ASHNA SHAH²

ABSTRACT

“Taste and Smell are often the beggars among the five senses – they leave no written language and therefore no standards other than wholly personal ones”. This quotation said by the famous American writer Frank Schoonmaker holds true even in the Trademark domain, especially in a developing country like India, where smell marks and taste marks have been completely neglected. In this paper, the position of unconventional marks namely smells marks and taste marks in India when compared to the developed countries, has been highlighted. In today’s times, businesses are using smell marks and taste marks as new methods of distinguishing their products and establishing a brand identity in the market. Even consumers have started associating smells and tastes to particular products and brands. Hence, it is of utmost importance to discuss this aspect and protect these unconventional marks. The paper begins with an introduction to the meaning and importance of smell marks and taste marks. After which, the topography of smell marks and taste marks in the developed nations, including but not limited to the United States of America, the European Union and Australia, has been discussed in detail with the help of case laws and statutory provisions. The paper then discusses the situation in India in the context of smell marks and taste marks. Further, suggestions have been listed down which could be used for the easy incorporation of smell marks and taste marks into the Indian trademark system.

I. INTRODUCTION

Trademarks are marks that can represent the source of origin of a good or service. It is a mark that distinguishes the goods and services of one person from another.³ As a link between the producer and the customer, trademarks have grown in importance. It has evolved into a valuable commercial asset for businesses. Traditionally, the Trade Marks Act, 1999 of India protected conventional marks, including labels, brand names, words, packaging, the shape of

¹ Author is a LL.M. candidate at Jindal Global Law School, India.

² Author is a LL.M. candidate at Jindal Global Law School, India.

³ The Trade Marks Act, 1999, § 2 (1) (zb), No. 47, Acts of Parliament, 1999 (India); TRIPS: Agreement on Trade-Related Aspects of Intellectual Property Rights art 15 (1), Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, 1869 U.N.T.S. 299, 33 I.L.M. 1197 (1994) [hereinafter TRIPS Agreement].

goods and a combination of colours.⁴ However, with the changing times and evolving businesses, new forms of marks have been receiving recognition as they act as an indicator of the origin of goods and services. These marks have become popular and innovative methods for branding and advertising. They are newer compared to the traditional marks and are hence called unconventional trademarks. Several unconventional marks such as motion marks, sound marks, single colour marks, shape marks, gesture marks and texture marks are being accepted and registered as trademarks in various jurisdictions. However, non-visual marks such as smell marks and taste marks still face challenges in the process of registration. The issues arise with respect to the functional nature of the mark, the requirement of the graphical representation and the distinctiveness of the mark. The legal basis for protecting smell and taste marks as unconventional trademarks has been examined in this research paper. The evolution of law regarding smell and taste marks in various developed countries such as the United States of America and the European Union has also been discussed comparatively to better understand the jurisprudence surrounding smell and taste marks. Issues about the registration of unconventional marks in India have been highlighted, along with recommendations and suggestions for amending the Indian law to aid the seamless registration of such marks in India in this paper.

II. SMELL MARKS

The smell is one such sense that can trigger and impact an individual's memory, mind and mood.⁵ Our sense of smell is not only the most basic of our five senses, but it also plays a significantly larger influence on our behaviours than we realise. Various brands are making millions by selling their scents and aromas as luxury perfumes, deodorants, itars, scented candles, bathing soaps, chewing gums, cosmetics, cleaners, etc. Smell has also been a distinguishing factor in other industries and factories. Smell marks, also known as scent marks or olfactory marks, have become extremely important for businesses as customers often distinguish products with the help of their smells.⁶ According to an international questionnaire done by World Intellectual Property Organization (WIPO), only 20 out of 72 trademark offices replied that they accepted smells and scents for registration as a mark.⁷ However, it is important to note that not all smells can qualify for trademark protection. The smell needs to be distinctive in nature to be considered as a trademark. Customers should associate the smell with the

⁴ The Trade Marks Act, 1999, § 2 (1) (m), No. 47, Acts of Parliament, 1999 (India).

⁵ Rachel S Herz and Trygg Engen, *Odor Memory: Review and Analysis*, 3 PSYCH. BULL. & R. 300, 300 (1996).

⁶ James E. Hawes, *Fragrances as Trademarks*, 79 TMR 134, 135, (1989).

⁷ WIPO, *Report of Standing Committee on the Law of Trade Marks, Industrial Designs and Geographical Indications*, Geneva 16 (2006).

product. As the application must be accompanied by strong proof of distinctiveness, showing that a smell is distinctive is an expensive process. Details of sales of the items under the mark, marketing expenses, advertisings, statements from industry experts recognising the mark as a source identifier are all examples of evidence that a smell has acquired distinctiveness.

III. TASTE MARKS

Out of all of the non-traditional marks, smell trademarks probably present the closest analogy to the issues faced by trademark owners attempting to claim flavour as a taste mark. Taste marks are the marks in which the taste or flavour of the particular commodity is considered to be the trademark. According to trends followed in various jurisdictions regarding the definition of registrable trademarks, taste marks should fall within the scope of the subject matter of protection of trademarks. A flavour can qualify as a trademark only when the flavour is inherently distinguishable or the purchasers are able to recognise the particular taste as a trademark.⁸ The WIPO Standing Committee on the Law of Trademarks has reported that the requirement of graphical representation can be satisfied by writing the description of the taste as well as by an indication stating that the application is regarding a taste mark.⁹ The real issue with respect to the registration of taste marks lies with the barriers of distinctiveness and functionality. India remains silent with respect to the particular unconventional trademark of taste as there is no mention of taste marks in the Trade Marks Act, 1999¹⁰ or in the draft Trademarks Manual.¹¹ There have been no judicial pronouncements as well regarding the same.

IV. INTERNATIONAL PERSPECTIVE: DEVELOPED NATIONS

It is important to understand the different perspectives of various jurisdictions on the subject matter of smell and taste marks to obtain a comprehensive picture of the development in the field of unconventional marks. In this paper, the important elements and highlights from various jurisdictions such as the United States of America, the European Union, Australia and Canada have been discussed.

1. United States of America:

⁸ Amanda E Compton, *Acquiring a Flavor for Trademarks: There's No Common Taste in the World*, 8 NW J TECH & INTELL PROP 340, 345, (2010).

⁹ WIPO, *Report of Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications*, Geneva 16 (2006).

¹⁰ The Trade Marks Act, 1999, No. 47, Acts of Parliament, 1999 (India).

¹¹ The Draft Manual for Trademark Practice and Procedure (2009). https://ipindia.gov.in/writereaddata/Portal/IPOGuidelinesManuals/1_32_1_tmr-draft-manual.pdf.

In the United States of America (USA), the Lanham Act¹², which governs trademark protection, doesn't explicitly exclude smell marks, and hence it has been followed that smell marks are registrable under Section 2(f) of the Lanham Act. The Trademark Manual of Examining Procedure of July 2021¹³ specifies that a smell mark can be registrable if it is not a functional characteristic of the product. The first scent mark to be registered was in the USA in 1990. The application was for the scent of a sewing thread and embroidery yarn which was described as 'high impact, fresh, floral fragrance reminiscent of Plumeria blossoms.'¹⁴ The Trademark Trial Appeal Board (TTAB) noted that the customers recognised the scent as an indicator of the origin of the products and were able to distinguish it from other products with the help of the scent. The scent of bubble gum for sandals the scent of strawberry for combustion engines have also been registered in the USA. The most recent smell mark registration was granted to Play-Doh for its playing clay in 2020.¹⁵

Further, there have been no successful registrations of taste marks in the United States Patent and Trademark Office (USPTO). A few unsuccessful attempts to register taste marks can be studied by two case laws. In the case of *re NV Organon*,¹⁶ the registration of orange flavour as a mark of the pharmaceutical pill was denied by the Trademark Trial and Appeal Board. The reasoning given by the examining attorney was that the orange flavour of the pills carried a function which was to cover the appalling taste of the antidepressant medicines. The orange flavour was a functional aspect of the medicines and wasn't enough to distinguish the Organon medicine from various other medicines. The said mark could not be registered under the Lanham Act. On the other hand, the TTAB did not close the doors for the registration of taste marks. The TTAB stated that the taste could be protected as a trademark after fulfilling a few requirements. The board further stated that proof of acquired distinctiveness and secondary meaning is required for the registration of taste marks because flavours cannot be considered as inherently distinctive. The second case is in *NY. Pizzeria, Inc v. Syal*¹⁷, where the District Court for the Southern District of Texas dealt with the question of registration of taste as a trademark. The Court mentioned that although a flavour can be protected by a trademark, the product's source needs to be identified to obtain protection. It held that flavour needs to obtain a secondary meaning to be protected. Registration of flavour marks for food commodities is

¹² The Lanham Act, 15 U.S.C. §§ 1051 (1946).

¹³ Trademark Manual of Examining Procedure (TEMP), July 2021, § 1202.13, US Patent and Trademark Office, <https://tmepp.uspto.gov/RDMS/TMEP/current#/current/TMEP-900d1e994.html>.

¹⁴ *re Clarke*, 17 U.S.P.Q. 2d T.T.A.B. 1238 (1990).

¹⁵ Registration No. 5467089, USPTO.

¹⁶ *Re N.V. Organon*, 79 U.S.P.Q.2d (BNA) 1639 (TTAB 2006).

¹⁷ *N.Y. Pizzeria, Inc v. Syal*, 56 F. Supp. 3d 875 (S.D. Tex. 2014).

impossible until and unless it does not acquire a secondary meaning because of the doctrine of functionality. In *re Pohl-Boskamp GmbH & Co KG*,¹⁸ a pharmaceutical company filed applications for registration of two marks, peppermint taste mark and peppermint smell mark for a spray used to treat acute chest pain in situations where blood and oxygen do not flow to the heart in sufficient quantity. The said medicine helps to widen and relax the blood vessels by allowing an increase in blood flow to the heart when sprayed on under the tongue of the patient. The trademark examiner rejected the registration of both the marks on the grounds of peppermint being functional as it helps to relieve the acute chest pain of the patient.

2. European Union:

In the European Union (EU), the Trademark Regulation, 2017 explains trademarks as any signs capable of graphical representation and distinguishing the goods and services of one undertaking from another.¹⁹ While the Regulation is silent about smell and taste marks, registration has been granted for the smell of freshly cut grass for tennis balls on the ground of its distinctiveness in 1999.²⁰ However, in 2003 the registrability of smell marks was discussed at length in the case of *Ralph Sieckmann v Deutsches Patent-und Markenamt*.²¹ In this case, registration was sought for the smell mark of Methyl Cinnamate, which was described as ‘balsamically fruity with a light hint of cinnamon’. The European Court of Justice held that a trademark might consist of a sign that itself cannot be visually perceived, such as smell marks only if it can be graphically represented. The Court further held that graphical representation must be in the form of ‘images, lines or characters’²² and must be ‘clear, precise, self-contained, easily accessible, intelligible, durable and objective’.²³ Chemical formulas, written descriptions and the sample submitted in this case did not satisfy the graphical representation criteria, and hence the application was rejected. Moreover, it was held that the coloured matrix also does not satisfy the graphical representation requirement.²⁴ This requirement for graphical representation was later removed by the EU Directive 2015/2436.

There have been no registrations of taste marks in the European Union Intellectual Property Office (previously known as OHIM); however, the landmark judgment of *Eli Lilly* would help

¹⁸ *re Pohl-Boskamp GmbH & Co KG*, 106 U.S.P.Q.2d 1042.

¹⁹ Regulation 2017/1001 of 14 June 2017 of the European Parliament and of the Council on the European Union trade mark OJ L 154/1, art 4 (2007).

²⁰ *Venootschap onder Firma Senta Aromatic Marketing’s Application* [1999] ETMR 429 OHIM BoA R 156/1998/2; EUTM 000428870.

²¹ C-273/00, *Ralph Sieckmann v. Deutsches Patent-und Markenamt*, (2003) ETMR 37 (EU).

²² *Supra* note 19.

²³ *Supra* note 19.

²⁴ *Institut pour la Protection des Fragrances’ Application*, Case R 186/2000-4, 2005 ETMR 42.

us to understand the situation of taste marks in the EU. In the case of *Eli Lilly v OHIM*,²⁵ the trademark application was trying to seek registration of “strawberry flavour” as a taste mark for pharmaceuticals. The Board of Appeals at OHIM rejected the application of the aforementioned trademark on the grounds of it lacking distinctive character. It was also held that the addition of a flavour to any medicine would be considered a functional aspect. The strawberry flavour did not help to make the product distinguishable from the other medicines available in the market, and neither would the consumers perceive it as a trademark.

In the United Kingdom (UK)²⁶, the application for registering a smell mark protecting Chanel’s perfume was rejected under the UK Trade Marks Act, 1994 on the ground that the protection was sought for the product and not for an indication of the source of its origin.²⁷ However, the UK has at various instances recognised and registered smell marks. There exists a registration for the smell of roses used in tyres²⁸ and a strong smell of bitter beer applied to flights for darts.²⁹

The only successful registration of a taste mark has taken place in the Benelux Office for Intellectual Property Office. The taste mark has been described as “The trademark consists of the taste of liquorice applied to goods in class 16 (taste mark)”.³⁰

3. Australia:

In Australia, though the law itself recognises smell marks, there are very few registrations granted to smell marks. The scent of eucalyptus for golf tees has been registered in Australia. The aroma must be special or distinctive and associated with a specific object or product, or the performance of a service, in order to qualify as a trademark.³¹ There exist no registrations for taste marks.

4. Canada:

Canada recognises taste marks and scent marks as valid trademarks in the Trademarks Act.³² The Trademarks Examination Manual³³ talks about the application of scent marks and taste marks where the “clear and concise description” of the smell/taste has to be compulsorily

²⁵ *Eli Lilly v. OHIM*, R120/2001.

²⁶ The law in UK has been discussed as a part of EU because the situation before BREXIT has been highlighted.

²⁷ *Chanel’s Application*, Oct. 31, 1994.

²⁸ *Sumitomo Rubber Co’s Application* No 2001416.

²⁹ *Unicorn Product’s Application* No 2000234.

³⁰ *De Smaak Van Drop Trade Mark* BX No 625971.

³¹ *Trade Marks Act 1995 (Can)* reg 2 & 40 (Austl.).

³² *Trademarks Act, R.S.C., 1985, c. T-13.*

³³ *Canadian Intellectual Property Office, The Trademark Examination Manual*, <https://www.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/wr01614.html>.

mentioned in the application. It is further stated that scent marks associated with room fresheners and perfumes would not be given protection as their prime objective is to transmit fragrance, and food flavourings would also not be given the protection of taste marks on a similar basis of imparting taste. The Canadian Intellectual Property Office also issued a notice³⁴ where it states that the application needs to include whether the trademark is of the whole or of a part of the scent/taste and the description of the scent/taste should be apt, for example, “The trademark consists of the scent of strawberry” for scent marks and “The trademark consists of the taste of black licorice” for taste marks.

V. SITUATION IN INDIA

The Trade Marks Act of India was enacted in the year 1999, and more than two decades since, the registrations of unconventional trademarks have been less in number when compared to other countries, especially the United States of America, the United Kingdom and nations in the European Union. Although, India has seen some noticeable developments in the arena of unconventional trademarks in the last fifteen years and is slowly taking steps towards the inclusion of unconventional marks in the trademark laws of the country. The Indian Trademark Registry has recognised a few unconventional marks, namely sound marks, colour marks, shape marks, and has also registered the same. The first sound mark to be registered in India was the Yahoo Yodel mark³⁵, and the first Indian company to get its sound mark registered was the ICICI bank which got its corporate jingle registered.³⁶ In the case of Zippo Lighters,³⁷ the counterfeit lighters with the same shape and mark as the Zippo lighters were being sold by the defendant. A permanent injunction was granted in favour of the plaintiffs as the shape was being recognised by the statutory provision in the trademark act. After an in-depth study of the cases, namely, Christian Louboutin SAS vs. Pawan Kumar³⁸ and Christian Louboutin vs. Ashish Bansal³⁹, we can conclude that even when a single colour is peculiar, unique and unusual, then it can be registered as a trademark. It should be closely associated with the product, and the customers should be able to recognise it.

However, there seems to be a dearth of jurisprudence in India when it comes to smell marks and taste marks. We can ascertain that there has been little to no movement in terms of

³⁴ Notice of the Canadian Intellectual Property Office, *Non-traditional Trademarks*, (June 17, 2019), <https://www.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/wr04453.html>.

³⁵ Kuruvila M. Jacob & Nidhi Kulkarni, *Non-Conventional Trademarks: Has India Secured an Equal Footing*, 9 INDIAN J. INTELL. PROP. L. 47, 50-53 (2018).

³⁶ *Id* at 57.

³⁷ Zippo Manufacturing Company v. Anil Moolchandani and Ors., (2011) 48 PTC 390 (Del) (India).

³⁸ Christian Louboutin SAS v. Pawan Kumar, (2017) SCC OnLine Del 12173 (India).

³⁹ Christian Louboutin v. Ashish Bansal, (2018) SCC OnLine Del 10205 (India).

extending protection to smell marks and taste marks. In India, no smell mark or taste mark has been registered to date. The Draft Manual of Trademarks published in the year 2015 by the Office of Controller General Patents, Designs & Trade Marks included smell marks as one of the unconventional marks and further stated that it does not fulfil the criteria of graphical representation under the Indian Trademark system. The Draft Manual did not incorporate taste marks at all, even when it has already been stated by the WIPO Standing Committee on Law of Trademarks, Industrial Designs and Geographical Indications in their 16th session that a written description of the taste should suffice for taste marks. Further, both smell marks and taste marks were noticed to be missing from the Trademark Rules, 2017.⁴⁰

In India, the definition of a trademark specifies that it must be “represented graphically” to be considered a trademark. Accordingly, since smell and taste marks do not meet this requirement, under the Indian trademark system, it is not capable of registration under the current regime. However, it is proposed that the requirement of graphical representation be removed in India, as is the case in the EU and USA. In cases where a description of the mark is clear and precise enough, for the authorities and the public in general to understand the subject matter of protection, it should be accepted for registration. Another primary objection that arises in cases of registration of these marks is the subjective nature attached to it. People might sense smell and taste in different ways due to the climate, quantity, pressure, temperature and other factors. However, the same is the case with other types of trademarks like sound marks as well. Thus, as long as the mark is clearly represented in the application to the Registry, it should be acceptable. The smell and the taste should be the distinguishing feature of the product and should act as the indicator of the origin of the products. Thus, as it is evident, the Indian trademark law and jurisprudence lag in contrast to the laws of developed countries in the context of protection of non-conventional marks such as smell and taste marks.

VI. THE ROAD AHEAD FOR INDIA - SUGGESTIONS

It is in India’s better interest to amend the trademark law to ease the process of registration of unconventional trademarks. Facilitating the registration of unconventional marks is going to be a boon for businesses as well as for consumers. Businesses will be able to protect their unconventional intangible assets like the unique tastes and smell of their products, thereby establishing their brand in the market. From a consumer perspective, when taste and smell marks are given protection, it will be difficult to counterfeit such goods, and hence brand identification will be easier and better quality of products will be available. To put India on an

⁴⁰ The Trademark Rules, 2017 (India).

equal footing with developed nations like the USA and the EU, the following amendments are suggested to the Indian law to permit the registration of unconventional trademarks like taste and smell marks:

1. Remove the graphical representation requirement:

According to Section 2(1)(zb) of the Trade Marks Act, 1999, only marks capable of being represented graphically can be registered as trademarks in India. Since taste and smell are non-visual elements, it is extremely difficult to meet this requirement for graphical representation while applying for a trademark at the Indian trademark registry. This requirement of graphical representation is a major barrier that restricts the registration of smell and taste marks in India. In the EU, to overcome this obstacle, the EU Directive 2015/2436⁴¹ was passed, which removed the requirement of graphical representation for registration of a sign in the EU. According to this Directive, “a sign which distinguishes the goods and services from other undertakings”⁴² is registrable provided it can be represented in the register in any appropriate form using “generally available technology” by which “competent authorities and the public can determine the subject matter of protection” afforded to its proprietor with clarity and precision. The seven representation criteria as laid down in *Ralph Sieckmann v Deutsches Patent-und Markenamt*⁴³ by the European Court of Justice has also been included in this Directive which states that a mark should be represented in a “clear, precise, self-contained, easily accessible, intelligible, durable, and objective manner”.⁴⁴ In the USA, the law specifically states that if the mark consists solely of a sound, aroma, or other wholly non-visual substance, the applicant is not obliged to submit a drawing.⁴⁵ There is no requirement for graphical representation in cases of non-visual signs such as to scents, and hence registration of smell marks is comparatively easier in the USA if it possesses a distinctive character.

It is therefore suggested that like the USA and EU, India should also amend its law to remove the requirement of graphical representation for registration of trademarks. The law also needs to change to cater to the changing markets and business requirements. Removing the criteria of graphical representation will open the doors for the registration of unconventional marks and also make the process easier.

⁴¹ Directive 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate laws of the Member States relating to trade marks, 2015 O.J. (L. 336), 1-36.

⁴² *Id.*, Art. 3.

⁴³ *Supra* note 19.

⁴⁴ *Supra* note 19 & 39.

⁴⁵ 37 C.F.R. § 2.52 (e) (2002).

2. Acceptable forms of representation of marks:

It is suggested that other forms of representation of marks should also be accepted instead of just graphical representation. The European Court of Justice in the Sieckmann case⁴⁶ laid down seven-point criteria for valid representation of marks. While being a landmark decision, the ruling has made it difficult to register smell and taste marks in the form of representation that follows the criteria. A universally accepted or followed manner of representation of marks satisfying the Sieckmann criteria has not yet been recognised. To address this lacuna in the law, alternate methods should be accepted by the Indian Trade Mark Registry for the representation of smell and taste marks. A few possible and acceptable forms of representation of smell and taste marks in registration applications can be explained as follows:

3. Description:

It is contended that a written description of the smell and taste for which protection is being sought would be an efficient form of representation for the purposes of registration. In cases where a description of the mark is clear and precise enough, for the authorities and the public in general to understand the subject matter of protection, it should be accepted for registration. However, when a description is not enough and clear, an exact detailed procedure of obtaining or preparing that smell or taste should be furnished, or a specimen should be submitted along with the description. The applicant should avoid using subjective words in the description. Moreover, the applicant should be careful of how the taste and smell would be perceived in different controlling factors like temperature, pressure, humidity, etc. while providing a comprehensive description of the mark.

4. Specimen Submission and Sampling:

A specimen of the smell or the taste for which protection is sought shall be submitted with the trademark registry along with a description. However, the responsibility of assuring the durability, longevity and consistency of the smell or taste sample submitted shall rest on the applicant. In the USA, an applicant is not required to provide a drawing of the mark is solely a scent, sound or another completely non-visual mark. However, a detailed description of the mark is required in such cases.⁴⁷ Further, the USPTO under the Trademark Manual of Examining Procedure (TMPEP) of July 2021 specifies that in cases of taste and smell marks, the applicant must mail a specimen of the mark to the USPTO which matches the written

⁴⁶ *Supra* note 19.

⁴⁷ 37 C.F.R. § 2.52 (e) (2002).

description submitted in the application.⁴⁸ This method can be efficient if used along with other alternative forms of representation.

5. Digitalization Technology:

Digitalising smells and tastes can allow their storage and easy virtual transmission without the threat of degradation.⁴⁹ Chromatographic technology and other specialised technology can be adopted, which help in identifying smells. This method of representation has been extremely beneficial when it comes to the evidence in infringement cases. In recent years, there has been a drive to improve scent detection and categorisation by establishing chemical profiles of odours using gas chromatography and mass spectrometry, which may then be used to objectively compare odours. Even while this method has been criticised on certain occasions,⁵⁰ courts have earlier used this technology to arrive at decisions.⁵¹ These technologies, however, are in their nascent stage and hence should be used carefully until the technology is perfected.

6. No registration of smell and taste marks that are functional in nature:

The doctrine of functionality works differently in the case of the trademark when compared with other intellectual property laws. The aim of trademark law is to safeguard the symbols of source identifiers that are used by the consumers to know about the quality of a product by accessing the information, rather than incentivising innovation. Subject-matter exclusions per se do not exist in trademark, and as long as there is a source identifier, protection can be granted to all kinds of symbols. A few jurists agree that the promotion of competition in the goods market is the main purpose of the doctrine, while other jurists agree that the doctrine plays a major role in asserting the right of copying.⁵² Such disagreements lead to confusion of the doctrine at the policy level in India. There exists a need to expressly include the doctrine of functionality in the Indian trademark law to prevent unfair practices and unfair monopolies.

The functional nature of the mark has been an important criterion for the registration of non-conventional marks across foreign jurisdictions. A smell or the taste should not be functional in nature. If the smell or taste of a product serves a utilitarian purpose, the mark should not be registered. For instance, the common scent of air freshener or the orange flavour masking the bad taste of medicine being utilitarian in nature will not be registrable as a trademark.

⁴⁸ Trademark Manual of Examining Procedure (TEMP), July 2021, § 904.03 (m), US Patent and Trademark Office, <https://tmep.uspto.gov/RDMS/TMEP/current#/current/TMEP-900d1e994.html>.

⁴⁹ John T. Cross, *Trademark Issues Relating to Digitalized Flavor*, 19 YALE J. L. & TECH., 339, 340-343 (2017), <https://openyls.law.yale.edu/bitstream/handle/20.500.13051/7818/JohnTCrossTrademarkIssues.pdf?sequence=2&isAllowed=y>.

⁵⁰ SHERRELL PERFUMERS, INC V. REVLON, INC., 483 U.S. (S.D.N.Y.) F. SUPP. 188 (1980).

⁵¹ *Chanel, Inc. v. Smith*, 178 U.S.P.Q. 630 N.D.Cal. (1973).

⁵² Robert G. Bone, *Trademark Functionality Reexamined*, 7 JOUR. OF LEG. ANALYSIS, 183, 186 (2015).

Trademark registration has been prohibited by The Lanham Act⁵³ in situations where the mark is functional. The TMEP of July 2021 further clarify that scent and flavour mark may be registrable only if the marks are not functional in nature and have acquired distinctive meaning.⁵⁴ It has been held in the case of *Qualitex Co. v Jacobson Prods. Co.*⁵⁵ that a mark in order to be considered valid for registration must be source-identifying and must not be functional. The functionality doctrine creates a hurdle for parties trying to protect smell and taste as trademarks. The criterion of the functionality of smell marks has been discussed in the case of *Re Clarke*.⁵⁶ It was held that the smell seeking registration could not be the functional aspect of the product. Trademark won't be granted to a product's inherited attribute; trademark would be granted to the only non-functional aspect of a good. Trademark cannot grant protection to a product if the functionality of it is the smell, for example, a perfume. In the case of *NY. Pizzeria, Inc v. Syal*,⁵⁷ it was held by the court that "the functionality doctrine is a significant hurdle for any party seeking to protect a flavour as a trademark". The Court cited the case of *re NV Organon*⁵⁸ where the Trademark Trial and Appeal Board did not grant a trademark to the orange flavour of medicine because the flavour played the function of covering the appalling taste of the pill. It was further held that there is a big hurdle of functionality when it comes to the flavours of food as "the flavour of food undoubtedly affects its quality, and is, therefore, a functional element of the product." The court dismissed the trademark infringement claim with respect to the pizza.

Taking a cue from the law and judicial pronouncements of foreign jurisdictions in the subject matter of functionality of marks, there highlights a need to inculcate the same in the Indian Law. The trademark registry should only consider a taste or smell mark as non - functional if the taste or smell is not an essential characteristic to the use or purpose of the product, does not impact the cost or quality of the product and is not inherent to the product or the consequence of the manufacturing method. Tastes and smells with a utilitarian purpose should not be eligible for registration as trademarks in India.

VII. CONCLUSION

A trademark grants protection and helps the consumers to distinguish between various commodities. With the change in times and technology, the recognition of trademarks is no

⁵³ The Lanham Act 1946, 15 U.S.C.A. § 1052 (e) (5) (2010).

⁵⁴ *Supra* note 46.

⁵⁵ *Qualitex Co. v Jacobson Prods. Co.*, 514 U.S. 159 (1995).

⁵⁶ *Supra* note 12.

⁵⁷ *Supra* note 15

⁵⁸ *Supra* note 14.

longer confined to conventional trademarks. India, as another step towards recognising unconventional trademarks, needs to include taste marks and smell marks in the Trademark Act so that the Indian companies can register their marks; otherwise, they might lose out when it comes to competition in the global world. Despite such huge acceptance on behalf of trademark offices across jurisdictions, there are only a few smell marks and just one taste mark registered. Therefore, it is evident that the issues lie within the process of registration which raises several obstacles in the way of successful registration of smell and taste marks. To address these issues, concrete policies on the matters of graphical representation, functionality and distinctiveness should be developed to enable the registration of unconventional marks. The visual perceptibility of the mark should not be a prerequisite for establishing a brand connection in the minds of customers, and similarly, the requirement of graphical representation of mark shall be removed as is the case in the USA and EU. One of the most important factors in determining the appropriateness of any representation of the sign should be whether it is clear enough for the public to understand the nature of the mark and whether it can be recorded on the registry and published in a suitably understandable manner and that anyone intrigued can obtain the information. Moreover, it is essential to determine the registrability of non-conventional trademarks on a case to case basis rather than imposing blanket legislation restricting registration of all non-conventional marks.
