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CRITICAL NOTE ON THE INTERPLAY BETWEEN TRADEMARKS AND BIOLOGICAL SENSES

-Adya Joshi¹

Abstract

The primary and fundamental objective of a trademark is the identification of the source or origin of a product. Through this identification, trademarks serve in assisting the consumer to make a suitable choice regarding any goods or services, as they indicate a particular quality, make and goodwill. Notably, the five senses are the gateway to all perception and knowledge, i.e. it is through sight, smell, sound, taste and touch that human beings create their memories. In this vein, there is a direction correlation between the biological senses and the primary use of trademarks, i.e. providing “memorability” or “recognizability” of a brand or trader. While traditionally, only the sense of sight was accommodated and recognized, in contemporary times, there has been a growing trend in both India and international jurisprudence towards recognition of “non-conventional” marks- such as those associated with “smell”, “sound”, “touch” and “taste”. This dilution is reflected in international treaties such as the TRIPS and the Singapore Treaty, as well as in recent amendments to the Trademark Rules in India. Nonetheless, there are several conundrums and controversies in this regard, particularly while weighing these “non-traditional” marks against the age-old standards of “distinctiveness” and “graphical representation”. Accordingly, this paper seeks to analyse both the legal and practical implications of a trademark jurisprudence centered around the 5 biological senses.

Keywords: Unconventional trademarks, non-traditional marks sound marks, smell marks, TRIPS, graphical representation

¹ Advocate, Supreme Court of India and Delhi High Court

Introduction

The primary and fundamental objective of a trademark, is the identification of the source or origin of a product.² Through this identification, trademarks serve in assisting the consumer to make a suitable choice regarding any goods or services, as they indicate a particular quality, make and goodwill.³ Hence, trademarks communicate valuable knowledge to customers in order to enable them to distinguish products in a market and make their preferred choice. The interplay between the biological senses and trademark law is one of cardinal significance as the five senses are the gateway to all perception and knowledge. It is through *sight*, *smell*, *sound*, *taste* and *touch* that human beings create their memories, thereby linking the biological senses with the primary use of a mark, i.e. providing “memorability” or “recognizability” of a brand or trader.⁴

Nevertheless, traditionally, only the sense of sight was accommodated and recognized, due to the emphasis on *visual* or *graphical representation* for registration of a mark.⁵ To illustrate, early international agreements such as the Paris Convention and the Madrid Treaty and Protocols, were largely concerned with regular or classical marks such as pictorial logos, and did not account for “unconventional” marks.⁶ In this vein, the trend was to largely focus on visually *discernible* signs and symbols while granting trademark monopoly.

However, over the years the position has undergone significant development, with this focus on “sight” being largely diluted. For example, Article 15 of the TRIPS Agreement mandates that while the threshold for assigning a trademark is that the sign or symbol should be capable of distinguishing a product, States *may* additionally stipulate that the mark should be visually perceptible.⁷ In essence, States have been granted the *option* to confer monopoly to marks not fulfilling this traditional criteria as well- thereby paving the way for the other senses to be included within the framework. Furthermore, taking one step forward, the Singapore Treaty has specifically recognised and endorsed “unconventional” and innovative marks such as sound marks.⁸

Hence, the contemporary international framework has created the opportunity for biological senses to be fully accommodated in the trademark law. However, the actual practice in this regard has met several obstacles due to the practical constraints in allowing for marks that may not satisfy the element of graphical

² Sumat Prasad Jain v. SheoJanam Prasad, 1973 SCR (1)1050.

³ Laxmikant Patel v. Chetanbhat Shah, 2002 (24) PTC 1 (SC).

⁴ WIPO, INTRODUCTION TO TRADEMARK LAW & PRACTICE, 1993 (2ND ED.) 30.

⁵ R. Carapeto, *A Reflection on the Introduction of Non-Traditional Marks*, WASEDA BULL. OF COMPARATIVE LAW, V.34 (2016).

⁶ See, The Paris Convention for the Protection of Industrial Property, 1884; the Madrid Agreement Concerning International Registration of Marks, 1891.

⁷ The Agreement on Trade-Related Aspects of Intellectual Property Rights, A.15.

⁸ The Singapore Treaty on the Law of Trademarks, 2006.

representation. In India for example, the Trademark Registry and courts have mitigated the statutory requirement in the Trademarks Act, 1999 in certain scenarios, and yet there are only a handful of marks that rely on the other senses that have actually been registered.⁹ A similar scenario is prevalent in other jurisdictions as well, with trademarks such as smell marks or touch marks being permitted only in the rarest of cases.

In light of the above, this paper seeks critically analyses the interplay between contemporary trademark law and the 5 biological senses- **Sound, Smell, Taste, Touch and Sight.**

I. Sound

Trademarks that rely on the sense of sound, i.e. “sound marks”, have emerged as one of the most popular forms of “unconventional” marks in recent years, with several nations having expressly accommodated them in their domestic frameworks through judicial decisions and otherwise.

To illustrate, while the European Union previously mandated visual *representation* for registration,¹⁰ in the landmark verdict of *Shield Mark BV v. Joost Kist* it was held that this did not imply that only visually *perceptible* marks could be regarded as trademarks.¹¹ The ECJ held that marks such as sound marks were not precluded *per se* from the EU framework, so long as they fulfilled the requirement of graphical representation.¹² However, the court held that this representation of a mark must be in the form of definite images, lines or characters, with a specific exclusion of written descriptions as an onomatopoeia or or a mere sequence of musical notes.¹³ In this manner, a lot of ambiguity was created as to possible additional means of representation, with musical staves seeming like the only possible option.¹⁴

However, this position underwent a sea of change with the adoption of the EU Directive 2015/2436 and Regulation 2015/2424, which abolished the requirement of graphical representation.¹⁵ Hence, post October 2017, applications were permitted to be filed through electronic format as well, thereby paving the way of registration of sound marks via audio clippings and sound files in the European Union.

With respect to the U.S.A., the Lanham’s Act, 1946 does not stipulate any requirement of graphical

⁹ T. Agarwal, *Conventionalizing Non-Conventional Trade Marks in India*, JOUR. OF CONTEMP. ISSUES OF LAW, V.3(5) (2017).

¹⁰ See, E.U. First Council Directive (89/104/EEC) Art.2.

¹¹ *Shield Mark BV v. Joost Kist*, C-283/01, 2003.

¹² *Ibid*, ¶41.

¹³ *Ibid*, ¶59-61.

¹⁴ WIPO, STANDING COMMITTEE ON LAW OF TRADEMARKS, INDUSTRIAL DESIGNS & GEOGRAPHICAL INDICATION, SCT/16/2, 2006.

¹⁵ European Parliament, Directive 2015/2436 2015; Regulation 2015/2424, 2015.

representation¹⁶ and hence, the registration of sound marks within the American framework is permissible simply with a detailed description of the mark. Famous illustrations include the Lion's Roar of MGM¹⁷ and the Tarzan Yell¹⁸, both of which have been registered as "sensory marks".

On the other hand, in India, the Trademarks Act, 1999 explicitly mentions visual representation as a prerequisite for registration of a mark.¹⁹ Nonetheless, over the years, certain sound marks have been registered in India, by some form of graphical representation such as conventional notation. For example, the first sound mark to be registered in India was Yahoo's yodel in 2008; which was followed by numerous others such as ICICI's jingle and Britannia's 4 note bell sound.²⁰ Moreover, the recently promulgated Trademark Rules, 2017 has further facilitated the registration of sound marks by specifically allowing the attachment audio clips in the form of mp3 recordings of thirty seconds.²¹

The above demonstrates that the sense of "sound" has acquired been recognised in some form or the other in trademark jurisdictions across the globe. However, it is imperative to note that the relationship with "sight" has not been completely done away with- as many countries still prefer some form of graphical representation of the mark, *along* with electronic recordings. This perhaps could be understood as representing a practical issue though, rather than a legal one.²²

II. Smell

The sense of "smell", is considered to be more powerful in evoking and creates memories than any other sense, including that of sight. This is due to biological reasons, as the olfactory bulb is directly connected to the areas in the brain that are responsible for emotion and memory.²³ However, the validity of "scent marks" or "smell marks continue to remain contentious and controversial in most jurisdictions.

In U.S.A., as mentioned previously, the governing trademark law does not mandate graphical representation and smell marks are thus not per se excluded. However, even descriptions of such marks are extremely complex to convey with words, and even chemical compositions are reflective of the substance itself, rather than the scent itself.²⁴ Nevertheless, there have been reported instances of descriptions of scents satisfying

¹⁶ See, The Lanham Act, 145 (USA).

¹⁷ Metro-Goldwyn-Mayer Lion Corp., "Lion Roaring", Reg. No. 1395550. (USA).

¹⁸ Edgar Rice Burroughs, Inc., "Tarzan Yell", Reg. No. 2210506. (USA).

¹⁹ See, The Trademark Act, 1999 (India).

²⁰ CIPAM, *Registration of Sound Marks Made Easy*, IP PALETTE ISSUE 3 (2017).

²¹ The Trademark Rules, 2017, Rule.26.

²² A. Majumdar, *The Requirement for Graphical Representability for Non- Conventional Trademarks*, JOUR. OF IPR V.11 314 (2006).

²³ R. Herts, *The Role of Odor-Evoked Memory*, BRAIN SCI. 6(3) 22(2016).

²⁴ S. Sinha, *Tracing the Jurisprudence of Smell Mark*, HNLU STUD. BAR. JOUR. V.1(2) (2017).

the requirement.

The landmark judgment in this regard is *In Re Clarke*, where a distinct fragrance resembling a certain flower that was applied in the context of embroidery yarn and material, was considered to be a valid trademark.²⁵ The main reasons given for granting this were that the applicant was the sole trader who had applied such a smell to this product and because the smell was not natural and did not emanate from the good itself.²⁶ This has led to the USPTO requiring two main features for a smell to be registered- distinctiveness and non-functionality, i.e., the smell should not a function of the product or part of its essential use.²⁷ However, this remains an extremely high threshold and less than a handful of smell marks have been registered since this case. Notable exceptions include a fragrance mark granted to Hasbro for its infamous and unique smell applied to its product Play-Doh.²⁸

With respect to the European Union, the infamous *Sieckmann* case held that in order for a non-visual mark to be registered it had to be graphically represented with preciseness and clarity, and hence the application describing the chemical composition of the smell in this case was rejected.²⁹ While graphical representation has now been formally done away with under EU law, it is still difficult for smells to be registered. A noteworthy illustration in this regard is Chanel's attempt to trademark its iconic "Chanel No.5" perfume. The application was dismissed due to *functionality*- because the fragrance here is the product itself, and hence cannot be regarded as a separate indicator of the source of the product.³⁰ However, a couple of smell marks have been granted in the U.K., including the smell of roses applied to tires,³¹ and the fragrance of beer to darts.³²

In India, till date no registration for a smell mark has been accepted due to the formal requirement of visual representation, as well as the inherent difficulties that have been faced by the American and European jurisdictions. In addition to these explicated above, it is important to note that there are several other challenges for smell marks. For one, universal fondness and aversions to smells exist, thereby leading to a limited number of smells that may be utilized in a business.³³ Moreover, smells can be highly subjective and

²⁵ *In Re Clarke*, 17 U.S.P.Q.2d 1238, 1239, ITAB 1990.

²⁶ *Ibid.*

²⁷ USPTO, Trademark Manual of Examining Procedure, Section 1202.13.

²⁸ Hasbro, "Play-Doh Scent", Reg No 5467089. (USA)

²⁹ *Ralf Sieckmann v. Deutsches Patent und Markenamt*, C-273/00, 2002.

³⁰ A. Kumar, *Protecting Smell Marks- Breaking Conventionality*, JOUR. OF IPR V.21 131 (2016).

³¹ *Sumitomo Rubber Co.*, Application No. 2001416 (1994).

³² *Unicorn Products*, Application No. 2000234 (1994).

³³ L. Fleck, *Survey of Select Jurisdictions in Scent Mark Registration*, CENTRE FOR INNOV. LAW & POLICY STUDENT PUB. GRANT PROG. 20 (2003).

depend on numerous factors, such as environment, humidity, age etc., thereby making it difficult for both consumers and patent offices to distinguish them.

However, there are equally strong arguments in favor of accommodating them, based on their superior ability to condition customers in remembering a certain brand and creating a lasting memory. This is particularly important in age of information overload, as sells and fragrances can assist consumers in narrowing their options and making a suitable choice.

III. Taste

Marks that rely on the sense of “taste” are an interesting form of trademarks that have emerged in recent times. However, as is the case with smell marks, these trademarks also possess inherent limitations, particularly that of distinctiveness and functionality.

In the U.S.A, merely a detailed description of the mark is required, and in that sense, tastes are relatively easier to be conveyed through written words as opposed to smells or sounds.³⁴ However, a unique obstacle for taste marks is that it is only discernible after the customer *consumes* the product- thereby squarely defeating the purpose of trademarks themselves. A notable illustration in this regard is a recent case of *NY Pizzeria v. Ravinder Syal*, in which the plaintiff had attempted to trademark the flavour and taste of the pizzas served at its restaurant.³⁵ The District Court in this case firmly rejected the same, reasoning that the “taste” of a food item is its characteristic, and comes into play only when the customer has already purchased and consumed the product, as opposed to a source/origin identifier.³⁶

In addition, the “functionality” hurdle is equally difficult to overcome for taste marks, as may be demonstrated through *In re N. Oreganon*, where an application for “orange flavour” in respect of certain medical drugs was rejected.³⁷ The application here was dismissed on the ground that flavor commonly performs a utilitarian function, such as disguising the inherent taste of pharmaceutical products, rather than acting as a brand indicator.³⁸

Similar decisions have also been pronounced in the European Union, such as Eli Lilly’s application for a mark over the flavor of artificial strawberries added to its pharmaceutical goods.³⁹ The mark here was rejected, as the examiner pointed out that such flavors would likely to be perceived by the customer to be

³⁴ WIPO Magazine, *Smell, Sound and Taste – Getting a Sense of Non-Traditional Marks*, February 2009, available at https://www.wipo.int/wipo_magazine/en/2009/01/article_0003.html.

³⁵ *N.Y. Pizzeria v. Ravinder Syal*, U.S.A. Dc Texas C.A. NO. 3:13-CV-335, 2014.

³⁶ *Ibid.*, at 13.

³⁷ *In Re N.V. Organon*, 79 USPQ 2d 1639 (TTAB 2006)

³⁸ *Ibid.*

³⁹ *Eli Lilly & Co. Application*, OHIM R 120/2001-2 (2003).

an attempt to mitigate the unpleasant flavor of the product and not as a trademark, and that the same failed to meet any threshold of distinctness.⁴⁰

With respect to India, no such mark has been registered or litigated either, due to the statutory and other limitations. While smell and sound marks have several compelling reasons to accommodate them within contemporary trademark law, the above discussion demonstrates that it is extremely difficult to justify the inclusion of the sense of “taste”. Moreover, the practical and legal issues are prime facie discernible, when we consider the fact that no flavor/taste mark has been registered in the world till date.

IV. Touch

Trademarks that are based on the sense of “touch”, i.e. texture marks, are the least common form of unconventional marks across nations in terms of applications and litigation. Prime facie, visual representation and written descriptions of such marks are extremely difficult to convey and hence there has been limited acceptance of the same.⁴¹ However, the WIPO has noted that in some jurisdictions, it is possible to graphically represented these tactile marks through innovations methods such as providing a samples akin to Braille printing.⁴² Nevertheless, this is extremely rare, with few exception being a trademark granted by Ecuador for a distinctive “crinkled crackle glass) texture” for an alcoholic beverage bottle,⁴³ and a mark granted in the U.S.A. for a leathered wrapping around a wine bottle.⁴⁴

However, it is to be noted that while proving non-functionality and distinctiveness may be difficult in terms of marks based on touch or feel, it is not impossible, and unlike taste marks, the issue here is more practical rather than legal. In this vein, it is opined that texture marks may still be accommodated within contemporary trademark laws.

V. Sight

The sense of “sight” has been give paramount importance within the domain of trademark law and its role is uncontested. Not only has primacy been given to visually perceptible marks, visual representation has also dominated all forms of marks, including unconventional ones. The rationale touted behind the latter is

⁴⁰ Ibid.

⁴¹ WIPO, INTRODUCTION TO TRADEMARKS AND BRANDS FOR SMALL AND MEDIUM-SIZED ENTERPRISES
PUB. NO. 900.1E

⁴² WIPO, STANDING COMMITTEE ON LAW OF TRADEMARKS, INDUSTRIAL DESIGNS & GEOGRAPHICAL INDICATION,
SCT/16/2, 2006.

⁴³ Old Parr, “Texture mark”, Registration No. 29597, 2004 (IEPI).

⁴⁴ David Family Group, “Sensory mark”, Reg. No. 3896100, 2010 (USA).

that of *practicality*, as graphical representation ensures clarity, unambiguity and reasonable comprehension for understanding and distinguishing the mark.⁴⁵ While jurisdictions like the E.U. have diluted this requirement, countries like India continue to have such a stipulation in the written law. Moreover, visual marks in the classical form continue to be one of the most common marks across the globe.⁴⁶

This uncontested and unambiguous role of sight has also ensured that visually perceptible trademarks, have had significant developments within their domain, as they do not have the disadvantages of the other sensory marks, as discussed above. For example, “shape marks” such as Zippo’s lighter have been upheld by Delhi High Court,⁴⁷ “color marks” such as Owens- Corning iconic pink have been recognized in the U.S.A.,⁴⁸ “motion marks” and “hologram marks” have been recognized within the E.U. and many more. This is because that while all the marks based on sight still have to satisfy the regular thresholds for obtaining marks, such as distinctiveness, non- functionality and secondary meaning, they do not have any *inherent* limitations in respect of their *visual nature*. In this vein, marks based on “sight” have significant advantages as compared to other trademarks.

VI. The way forward

Through the course of this paper, the author has demonstrated that while there is a fundamental interplay between biological senses and trademark law, there are several legal and practical issues in accommodating the former within the latter. While the sense of “sight” has firmly established itself within the framework, the senses of sound, smell, touch and taste are yet to acquire universal acceptance.

It is opined that for sound marks and texture marks, the obstacles are more *practical*, rather than legal, and in their cases, every effort should be made to include them, by relying on technology and science to facilitate their registration. At the same time, the author does recognise that smell marks and taste marks do have inherent difficulties as generally they only come into play *after* the consumer has purchased the product, However, for smell marks this is not always the case and hence it is indeed possible to bring them under the purview of trademark law.

Ultimately however, it also depends on the jurisdictional requirements, as there is no mandate in international convention that sensory marks *have* to be recognised. However, it is opined that this should be

⁴⁵ A. Majumdar, *The Requirement for Graphical Representability for Non- Conventional Trademarks*, JOUR. OF IPR V.11 314 (2006).

⁴⁶ WIPO, INTELLECTUAL PROPERTY HANDBOOK, PUB. NO. 489(E) (2008).

⁴⁷ Zippo v. Anil Moolchandani CS (OS) 1355/2006.

⁴⁸ In Re Owens-Corning Fiberglas Corporation, 774 F.2d 1116 (1985).

done due to a number of reasons. Firstly, a sole emphasis on sight is discriminatory towards those who are visually impaired and rely on other senses to perceive the world. A contemporary trademark framework must be inclusive to *all* persons and therefore recognising other senses is an important step in this regard. Moreover, scientifically speaking, the other biological senses such as smell, have an equally if not *more* powerful function in creating memories and connections within the consumers' minds. Therefore, in an era of information and technology overload, the author believes that recognising evolving branding and advertising strategies that rely on different biological senses is equally beneficial to both consumers and traders- and hence must be encouraged at all costs.
