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The future of Scents as
Trademarks in the European
Community
Based on a comparison to the American
Experience

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Contents

SUMMARY	1
PREFACE	2
ABBREVIATIONS	3
1 INTRODUCTION	4
1.1 Background	4
1.2 Purpose	5
1.3 Method and Material	6
1.4 Previous Research on Scents as Trademarks	7
1.5 Limitation	7
1.6 Disposition	8
2 THE SENSE OF SCENTS	9
2.1 The Human Sense of Smell	9
2.2 The Commercial Sense of Scents	10
2.3 Summary	11
3 THE FUNCTION OF SCENTS AS TRADEMARKS	12
3.1 Scents as Registrable Subject Matter under Trademark Law	12
3.1.1 Signs of which a trademark may consist	12
3.1.2 Recognition of signs consisting of scents	14
3.2 The Distinctive Character of Scent Marks	14
3.2.1 Inherent distinctiveness	15
3.2.1.1 Generic scent marks excluded	17
3.2.1.2 Descriptive scent marks excluded	17
3.2.2 Acquired distinctiveness	18
3.2.2.1 Pre-sale source identification	20
3.2.2.2 Post-sale source identification	21
3.2.2.3 Proof of acquired distinctiveness	21
3.3 The Risk of Scent Depletion	22
3.4 The Functional Character of Scents Marks	24
3.5 Summary	25

4	REGISTRATION PROBLEMS OF SCENT MARKS	27
4.1	Requirement of Graphical Representation	27
4.2	Graphical Representation of Scent marks	28
4.2.1	Scent perception	28
4.2.1.1	Verbal description	28
4.2.1.2	Analysing diagram	30
4.2.1.3	Image	32
4.2.2	Substance	32
4.2.2.1	Chemical formula	32
4.2.2.2	Deposition of a smell sample	33
4.2.3	Combination of scent perception and substance	34
4.3	Summary	35
5	DIFFICULTIES IN PROTECTING SCENT MARKS	36
5.1	Use against which a Trademark is protected	36
5.2	Difficulties in establishing Infringement	36
5.3	Summary	38
6	CONCLUSIONS	39
	BIBLIOGRAPHY	43
	TABLE OF CASES	47

Summary

The principal function of a trademark is to give consumers a guarantee of the identity of a market product, by enabling the consumers to distinguish that product from others of a different provenance. In order to make a product stand out in the market place, the industry constantly seeks to invent and use new ways to appeal to customers. Lately, unconventional sensory marks, such as scents have made a commercial revolution. As a result, the demand for legal protection steadily increases.

Historically, the first scent mark was registered as a trademark in the United States in 1990 and almost a decade later the only CTM of a scent was recognised. Since then, several trademark applications concerning scents have been refused and according to a recent ruling of the ECJ, it now seems unsure whether or not a scent can be registered as a trademark in Europe. The purpose of this thesis is therefore to examine if scents actually can function as trademarks, whether they are registrable or not, what difficulties they would provoke in determining infringement and, by way of a comparative analysis with the American experience, what their solutions may be in the future in the European Community.

Even though scents have implicitly been recognised, the capability to constitute a trade sign under trademark law, remains a difficult matter. They have, in reason of the subjective nature of their perception, difficulties in functioning as reliable indications of trade source. Additionally, a scent cannot be a natural characteristic of the product nor can it, function as essential to the use or purpose of the product. As a result, scents can only function as trademarks under circumstances where the scent is new in relation to the product to which it is affixed or when the scent is particularly unique and used on normally unscented products. Furthermore, in order to be registered, the scent has to fulfil the requirement of graphical representation, the only means of presenting the essence of the mark in printed form. However, the deposit of smell- samples is not possible and the submission of graphical representation in the form of "electronic nose" analysis and chromatography have been rejected, as well as the representation by a chemical formula, verbal description or the combination of these reproductions. Although considered not sufficiently precise and clear, verbal descriptions seem to be the only possible solution to afford trademark protection with today's existing technology. Scent mark infringement is also difficult to detect since it depends on the consumer's recollection and ability to differentiate scents resulting in an unpredictable outcome.

To conclude, it is not impossible but extremely hard to satisfy the criteria for trademark registration of a scent and neither is it guaranteed that the protection afforded by registration can be assured in a trademark action. Unless the criteria are not set down, it seems like scent will have no future in Europe as trademarks.

Preface

I would like to give my appreciation to my supervisor Hans-Henrik Lidgard for his guidance and support in allowing me to write this thesis. I would also like to thank my family and friends for their valuable help.

Malmö, May 3rd 2004

Abbreviations

CIF	Court of First Instance of the European Communities
CFR	Code of Federal Regulations
CTM	Community Trade Mark
CTMR	Community Trade Mark Regulation
EIPR	European Intellectual Property Review
EC	European Community
ECJ	European Court of Justice
EU	European Union
OHIM	Office for Harmonization in the Internal Market
PTO	Patent and Trademark Office
Reg.No.	Registration Number
TMEP	Trademark Manual of Examining Procedure
TMR	Trade Mark Reporter
TMRWM	Trade Mark Registry Work Manual (UK)
TTAB	Trademark Trial and Appeal Board
UK	United Kingdom
USA	United States of America
USC	United States Code
USPTO	United States Patent and Trademark Office
USPQ	United States Patent Quarterly

1 Introduction

For as far back as archaeologists can determine, men have been fascinated by the seemingly magical potency of aroma. Our ancestors depended upon their sense of smell for survival, using their highly developed sense of smell not only to avoid danger, but also to select culinary and medicinal plants. Today, it is well known that odours and fragrances interact powerfully with our emotions in our daily lives, consciously and subconsciously, instantaneously calling up memories of past experiences. This association between smell and memories can be used in marketing. A familiar scent can trigger memories of a particular product or service. The use of scents in marketing is highly real and practitioners are familiar with sensorial power as a product strategy and as an essential part of an innovative trademark.¹ Though, in order to register a scent as a trademark, it has to be able to function as one.

1.1 Background

For thousands of years, trademarks have been used to give the customer a guarantee of the identity of the market product, by enabling the consumer to distinguish that product from others of a different provenance. Trademarks are nowadays seen as a badge of origin and a guarantee of consistency, carrying an implied assurance of quality, arising from personal experience of the product, word-of-mouth recommendation or the image of the market product projection by advertising.² In consequence, trademarks become crucial elements in the process of reaching decisions about what to buy. Trademarks have therefore turned into nothing more, nor less than the fundament of most market competition.³

As a key factor of market-oriented economies, the proper use of trademarks is important to the success of a wide range of businesses. Traditionally, in order to establish identity and recognition, manufacturers have used visually observable trademarks consisting of words or devices. As modern capitalism has grown, the drive to sell products and services by means of some marks has invaded more and more fields and today, trademarks may consist of slogans, colour-, three-dimensional- and motion signs.⁴ The list of trademarks is still growing as businesses look for new ways to protect features that make their products stand out in the marketplace. In past years, manufacturers have tried more and more to develop and use new forms of trademarks that appeal to the senses of the consumer, like sound and scent

¹ Löfgren, Chrster; *Doft för lojalitet*, BRAND NEWS, Stockholm No 7/ 2003, at.9.

²Michaels, Amanda; *A practical guide to trademark law*, Sweet & Maxwell, London, 3rd edition, 2002, at 1.3-1.6.

³Cornish, Wiliam R; *Intellectual property: Patents, Copyright, Trade Marks and Allied rights*, Sweet & Maxwell, London, 4th edition 1999, at 15-04 and 15-25.

⁴ *Id.* at 15-04

marks.⁵ These marks have potentially been available across the European Union for about ten years, but whether they are worth the legal work necessary remains unanswered. Although sound marks seem to have gained recognition⁶ recently, the situation of scents marks remains controversial.

Both in the EU and USA, there is little legislation and jurisprudence concerning scent marks. Historically, the first scent mark was registered and recognised in the United States in 1990⁷ and since then, five other scent marks have been registered there. The Europeans were not to follow this trend until nine years later, in 1999, when the first and only CTM consisting of a scent was recognised⁸. From that point forward, some member states have recognised scent marks through their national legislation whereas others remain more conservative.

It is certain that scent marks challenge legal provisions on trademarks.⁹ One of the problems concerning scent marks deals with its functionality as a trademark since the scent used cannot be an inherent or natural characteristic of the product.¹⁰ Other objections embody the ability of the human sense to objectively identify and distinguish a manufacturer's goods or services from those of another. Furthermore, in order to obtain registration of the mark, the scent has to fulfil the requirement of graphical representation, the only means of presenting the essence of the mark in printed form. The purpose of this requirement is to ensure that infringement rights can be determined and third parties can understand, from the graphical representation, the nature of the mark.¹¹ The possibility to meet this requirement appears almost remote following the ruling of the ECJ in the *Sieckmann-case*¹² from 2002 that runs contrary to the earlier practice in the OHIM¹³. Accordingly, the future of scent marks in Europe now emerges unsure.

1.2 Purpose

The purpose of this thesis is to evaluate the limits of scent marks in terms of protectable subject matter and the scope of protection granted. Therefore, based on the current legal, practical, commercial and technical concerns, the aim is to present the specific issues related to registration and protection of

⁵ Zendel, Daniel and Prah, Dennis S; *Making sense of trademarks*, TRADEMARK WORLD 21, August 1996,

⁶ Decision of the ECJ 27 November 2003, *Shield Mark B.V v Joost Kist*, Case C-283/01.

⁷ *Re Clarke* 17 USPQ 2d 1238 (1990).

⁸ Decision of the Second Board of Appeal of the OHIM 11 February 1999, Case R 156/1998-2.

⁹ Lunell, Erika; *Dofter och ljud som föremål för varumärkesrätt-nagra kommentarer kring "Sieckmann-fallet"*, NIR vol.2, 2003, at 124.

¹⁰ Hawes, James E; *Fragrances as trademarks*, 79 TMR 134, 1989, at 134-135.

¹¹ Chaudri, Abida; *Graphically speaking*, TRADEMARK WORLD 157, May 2003, at.26.

¹² Decision of the ECJ 12 December 2002, *Sieckmann v Deutsches Patent- und Markenamt*, Case C-273/00.

¹³ Decision of the Second Board of Appeal of the OHIM, *supra* note 8.

scent marks and, by way of comparative analysis with the United States experience, what their solutions may be in the future in the EU.

More specifically, the objective is to focus on the practical viability of scents as trademarks and how scents would fulfil the criteria for validity by considering whether the sense of smell can truly distinguish scents. Supposing they can, the obstacles to offering the protection of trademark law will be examined, as well as the difficulties inherent in the technical requirement for registration of translating the scent into graphic form and the practical difficulties involved in determining infringement.

1.3 Method and Material

From a trademark perspective this thesis seeks to examine the status of scent marks. The object of examination is if and how scents satisfy the legal requirements of current trademark regulations. Consequently, a *regulation-oriented approach* has been chosen as model of method. This means that the legal requirements, legal technical issues and their related application problems will, in their constituent elements, be examined individually through a descriptive and above all analytic method throughout the main chapters of this thesis. In the end chapter, the different elements will be placed in their context in order to bring forward a principal analysis of the subject.

The subject by its nature operates in a symbiotic relationship with its economic environment. Therefore, examination of economic aspects is inevitable although the normal approach is from a purely legal perspective.

Additionally, some issues that are relevant and important for the understanding of the legal analysis relates to areas of technology and biology and will in brief be presented through a descriptive method in order to present only the essential of what has been developed in these areas.

Finally, this thesis aims to evaluate the situation of scent marks in the EC and since the practice and doctrine is poor, the analysis will in part be based on the American experience. A comparative method will be used, not with the main purpose to highlight differences and similarities but, in order to advance the discussion and to underline the problems of the subject as well as its solutions. Each legal system will therefore be examined as they apply to each step of the subject analysis.

Scent marks from a legal-technical point of view have won little recognition therefore the material is limited. The resources used consist mostly of case law, registrations, and applications regarding scent marks under the American Lanham Act, the European CTMR and national legislation from some EU member states. Many articles are also used from American, European and certain national member state's law journals and other periodicals.

1.4 Previous Research on Scents as Trademarks

Scents as trademarks is not completely a new phenomena, however not many studies have been made on this topic. The first article to properly analyse the possibilities of registering "*Fragrances as trademarks*" (1989) was made by James E. Hawes, the lawyer of the proprietor of the first registered scent mark in the USA. It was followed by a critical study belonging to Bettina Elias "*Do scents signify source?*" (1992) that particularly applied to American law. These two articles, are the most interesting since they can be considered to establish the grounds on the subject and thereby acting as important references to following studies. Although not as developed but still of importance, the article "*Trademark Protection of Smells: Sense or Nonsense*" (1991) by Lee B. Burgunder should also be mentioned from an American legal perspective representing potential problems arising from protecting scent marks.

Furthermore, many articles treating non-traditional or non-visual trademarks include scent marks in their analysis. Several texts regarding the criteria of the requirement of graphical representation set out by the ECJ in the recent ruling of the Sieckmann-case have also been published. Although the list of these kinds of articles can be long, they remain representative of what the Advocate General Colomer and the Court stated without going into any profound study.

1.5 Limitation

This thesis seeks to evaluate the possibilities of protecting scent marks by means of trademark protection and not by additional institutes that might, by their scope of application, also encompass trademarks. Therefore, the doctrine of unfair competition, dilution, copyright, patent and other areas of law applicable to scents will not be examined. Issues which are interesting but not of immediate concern of this discussion, such as deceptive marks or marks contrary to public moral will be left out.

The discussion is directed towards material problems related to trademark protection of a scent. Procedural matters will not be discussed more than necessary for understanding the subject matter of this thesis. Accordingly, the individual state's common law and statutory scheme of registration and protection of trademarks will be excluded from this presentation.

The subjects of comparison in this thesis are the EC and the USA. Due to European harmonisation and integration, EC legislation is closely intertwined with national member states' legislation. An analysis of the EC must therefore in some contexts include the situation in the member states'

to be complete. On this point, references are limited to the liberal common law system in the UK and the more restrictive positions in Sweden as well as in France as representing the civil law culture.

1.6 Disposition

The function of the human sense of smell and its power in a commercial context will be described in chapter 2 in order to present the reasons and interests for protecting scents under trademark law. Chapter 3 aims to examine if scents can function as trademarks by analysing if they can constitute protectable subject matter and if they have a distinctive character. Chapter 4 will evaluate different means of graphical representations of scent marks in order to establish if scents can be registered as trademarks. The analysis in chapter 5 deals with inherent difficulties in establishing infringement of protected scent marks. Each individual chapter includes a summary to illustrate important issues addressed to facilitate comprehension.

Finally, a conclusion will sum up relevant observations made and will present an overall analysis of scents as trademarks.

2 THE SENSE OF SCENTS

Smells are emanations carried by a fluid that are perceived by the olfactory apparatus.¹⁴ A smell that is pleasant is referred to as a scent, fragrance or aroma whereas an odour is perceived to have a distinctive and unpleasant smell.¹⁵ Consequently, a smell can be either pleasant or unpleasant. This quality can incidentally change as the quality of a smell depends on the context in which the smell is perceived as well as its concentration and intensity¹⁶, depending on the sensibility of the human sense of smell.¹⁷

2.1 The Human Sense of Smell

The human sense distinguishes between three "mechanical" senses, touch, sight and hearing, and two chemical ones, taste and smell. They all stimulate the cerebrum area of the brain, which is the seat of conscious thought. Though, the human sense of smell is privileged, given that it is the only one of our five senses that has direct contact with the limbic system of the brain in which are located the centre of memory, emotion and motivation.¹⁸ Basically this means that while the other four senses require conscious evaluation to produce a response, the olfactory system can and do directly trigger both memory and emotional responses.

As a consequence, our sense of smell plays a greater role in our actions than we realise. On a primitive level, humans like other organisms use chemical sense to move toward the good and away from the bad. Because the limbic system grew out of the olfactory system, the emotional dichotomy between good and bad reflects the chemosensory one.¹⁹ The emotional potency of scents therefore makes feelings either positive or negative, about people, places and things. This fact appears to be so whether or not we are conscious of the odour.²⁰

As a result, smell is one of the most powerful senses in evoking memory and emotion. Product advertising is all about creating powerful memory around their brand and consequently scents has a commercial sense.²¹

¹⁴ Franzosi, Mario and authors; *European Community Trade mark, Commentary to the European Community Regulations*, Kluwer Law International, The Hague, 1997, at 185-186.

¹⁵ Collins Cobuild English dictionary, Harper Collins Publishers Ltd. 1995, Glasgow (Editor in chief, John Sinclair).

¹⁶ Kanfoudi, EM; *Les caractéristiques des odeurs*, *Analisis Magazine*, 1996, vol.24, n°8.

¹⁷ Franzosi, *supra* note 14, at 185-186.

¹⁸ Hawes, *supra* note 10, at 134, see also Holloway, Marguerite; *The Ascent of Scent*, *Scientific American*, November 1999, vol. 11, at.30.

¹⁹ Holloway, *supra* note 18, at.30.

²⁰ Hawes, *supra* note 10, at134.

²¹ Löfgren, *supra* note 1, at 9.

2.2 The Commercial Sense of Scents

It is well known that the economic logic of the market brings its actors to constantly develop new signs that will stand out in the market place.²² To reach the consumers, it has today become substantial for business to have a strong marketing that is based on consumer behavioural processes and of constructs such as perception, learning, memory, involvement, motivation, attitude, self-concepts, brand personality and consumer lifestyles.²³ As a consequence, the smell of a product can be a major determinant of its reception in the market place. Smells sell. And things that smell better, sell better.²⁴ The companies adding fragrances to products consistently report the aroma to be an important element of the product's appeal.²⁵ They know that fragrances help to make life more pleasurable, for aesthetics play a significant and increasing role in consumer satisfaction, and fragrance is an element crucial to the aesthetic appeal of any product.²⁶ Consequently, a fragrance can be seen as an essential strategic weapon for business.²⁷

Today, almost every consumer product on the market contains some type of fragrance²⁸. One category of fragrances is "*primary scents*" that include those products which are purchased primarily for their appeal to the sense of smell. Perfume in all its forms, essential oils and environmental fragrances such as air fresheners and potpourri are typical examples of primary scents. "*Product scents*", on the other hand, refer to those fragrances that are added to products having a primary function other than scenting.²⁹ For instance, fabric softeners can be given a "soft" smell and an old car can be given a "new" smell.³⁰ Under this category falls the so-called unscented products that often are scented to mask the chemical odours of their ingredients.³¹ These products range from cosmetics, shampoo, soap, lotion, facial tissues, cat litter, floor wax, household cleaners, detergents and toilet bowl cleansers to taco chips, paper products, plastic trash bags, dolls and toy soldiers.³² While some of these normally unscented products go unnoticed by consumers, an added fragrance can become an important motivation for the purchase, especially since actual product performance sometimes varies little between brands. This has been proved through laboratory studies showing that subjects using identical products will more highly rate the performance of the pleasantly scented version.³³

²²Astic, Valérie and Larrieu, Jacques; *Des rugissements aux odeurs: l'évolution des marques commerciales*, Recueil Dalloz, 1998, 41 Cahier Chronique, at 389.

²³Swann, Jerre B; *Trademarks and marketing*, 91 TMR 787, 2001, at 790.

²⁴Hawes, *supra* note 10, at 135.

²⁵Löfgren, *supra* note 1, at 11.

²⁶Hawes, *supra* note 10, at 139.

²⁷Troussel, Jean-Christophe and Van der Broecke, Pieter; *Is european trademark law getting in good shape?*, 93 TMR 1066, 2003, at1066.

²⁸Hawes, *supra* note 10, at137.

²⁹Elias, Bettina; *Do scents signify source? An argument against trademarks for fragrances*, 82 TMR 475, 1992, at 476.

³⁰Hawes, *supra* note 10, at 137, see also Astic, *supra* note 22, at 390.

³¹Elias, *supra* note 29, at 478.

³²*Id.*, at 476; see also Hawes, *supra* note 10, at136.

³³Elias, *supra* note 29, at 478.

Furthermore, it needs to be added that some companies today even specialise in advising and helping other companies with their "multisensory marketing", including scents. Their strategy is to advise companies to use scents in marketing with the goal to create attention, give product information, intensify the degree of recognition, and build up mark loyalty as well as to communicate product qualities. Actually, scents put on a product, in an office or in a shop make more people react than when using traditional methods.³⁴ This is because *a scent has a power of persuasion greater than words, appearances, feelings or willpower.*³⁵

2.3 Summary

In our daily lives, scents interact, both consciously and subconsciously, with our moods and feelings, evoking memories and effecting our actions. The scent of a product can efficiently create a powerful memory around their brand, thereby effectively influencing its reception in the marketplace.

³⁴ Löfgren, *supra* note 1, at 11.

³⁵ Süskind, Patrick; *Perfume: The Story of a Murderer*, Diogenes Verlag, 1. Aufl., Zürich, 1985, at 107.

3 THE FUNCTION OF SCENTS AS TRADEMARKS

The function of a trademark is to guarantee the identity of the origin of a market product to the consumer or ultimate user by enabling him without any possibility of confusion to distinguish that product from products that have another origin.³⁶ The most important quality of a mark is therefore its distinctiveness³⁷. But before examining if scents are distinctive, it is necessary to explore if they are recognised as registrable subject matter under trademark law.

3.1 Scents as Registrable Subject Matter under Trademark Law

3.1.1 Signs of which a trademark may consist

Generally, a trademark is defined as a "sign that individualises the goods of a given enterprise and distinguishes them from the goods of its competitors". However, most international regulations give non-specific definitions of what can be registered as a trademark and no international treaty concerning trademarks explicitly mandates contracting parties to register scent marks. In fact, *the Trademark treaty* explicitly states it is inapplicable to scent marks.³⁸ Neither *the Madrid Agreement Concerning the International Registration of Marks*³⁹ nor *the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks*⁴⁰ conclusively defines what "trademark" means within the context of those agreements. It is therefore possible that a scent mark could receive protection under either agreement. Similarly, *the Paris Convention for the Protection of Industrial Property*⁴¹ also does not define "trademark" for the purposes of that particular convention. However, the Paris Convention does leave what is a registrable trademark to the domestic law of contracting parties.⁴² Likewise, *the TRIPS Agreement* states contracting parties may limit trademark registration to only visible perceptible signs.⁴³

³⁶ Decision of the ECJ 17 October 1990, HAG Case C-10/89, paragraph 14; Decision of the ECJ 4 October 2001, Merz & Krell Case C-517/99, paragraph 22.

³⁷Michaels, *supra* note 2, at 2.1.

³⁸ Trademark Law Treaty 1994, Article 2(1)(b).

³⁹ Madrid Agreement for the International Registration 1891.

⁴⁰ Protocole relation to the Madrid Agreement concerning the International Registration of Marks 1989.

⁴¹ Paris Convention for the Protection of Industrial Property 1883.

⁴² *Id.*, Article 6.

⁴³ The World Trade Organisation's Agreement on Trade-Related Aspects of Intellectual Property Rights 1994, Article 15(1).

At the European Community level, the definition of what can potentially constitute a trademark following *the Council Regulation 40/94/EEC*⁴⁴ on the *Community Trade Mark (CTM)*, is very open. Article 4 provides the non-exhaustive definition of a trademark as "any sign capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services from those of other undertakings".

The same non-exhaustive definition is given by Article 2 of *the First Council Directive 89/104/EEC*⁴⁵ to the approximation of the national trademark laws of the European Member states.⁴⁶

While some examples of signs are given, the term "sign" is deliberately left undefined. Thus, dictionary definitions reveal that the word has a wide meaning, which covers both visual and sensory mechanisms for conveying information.⁴⁷ Along the same line, the Explanatory Memorandum issued by the Commission when commenting on the provision in the draft CTMR, stated very clearly "no type of sign is automatically excluded from registration as a Community trade mark".⁴⁸ Thereby, solid colours or shades of colours and signs denoting sound, *smell* or taste are in theory not excluded from constituting a trademark under European trademark law provided that they are capable of being represented graphically.⁴⁹

Similarly, *the American Federal Lanham Act*⁵⁰ states that "the term "trademark" includes any word, name, symbol, or device, or any combination thereof - (1) used by a person, or (2) which a person has bona fide intention to use in commerce and applies to register on the Principal Register established by this Act, to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown".⁵¹

The United States Trademark Association has interpreted the terms "symbol, or device" not to be deleted nor narrowed to preclude registration of such things as a colour, shape, *smell*, sound, or configuration which functions as a mark.⁵² Thereby, the scope of subject matter for trademark

⁴⁴ Council Regulation 40/94/EEC of December 20th, 1993 on the Community Trade Mark (CTMR).

⁴⁵ First Council Directive 89/104/EEC of December 21st, 1988 to Approximate the Laws of the Member States Relating to Trade Marks.

⁴⁶In implementing the Directive, the Swedish Trademarks Act of December 16, 1994 included in its article 1, based on article 2 of the Directive, that "the ornamental aspects of goods or their packaging" may constitute a trademark.

⁴⁷ Collins Cobuild English dictionary, *supra* note 15.

⁴⁸ Troussel, *supra* note 27, at 1069.

⁴⁹ Franzosi, *supra* note 14, at 179.

⁵⁰ Lanham (Trademark) Act of July 5, 1946 (15 U.S.C. §§ 1051-1127).

⁵¹ 15 U.S.C. § 1127.

⁵² Hawes, *supra* note 10, at 143.

protection is theoretically unlimited, confined only by the requirement of the trademark act to identify source.⁵³

As a result, the tendency in the EU as well as in the USA seems to be that the word "any" has been taken more and more literally including non-perceptible signs such as scents.⁵⁴

3.1.2 Recognition of signs consisting of scents

The recognition of scents as registrable subject matter finds its explanation in the object itself of trademarks, which is to enable consumers to identify goods and services by their origin and quality.⁵⁵ The aim is not to identify a good or service with one undertaking in particular, but to identify it as one of the goods or services designated by the same trademark, even though its origin may be unknown. All products bearing the same trademark should originate from the same manufacturer, regardless of that manufacturer's identity.⁵⁶ To quote the Advocate General Colomer⁵⁷, the matter of trademarks is actually "*a dialogue between manufacturer and consumer. The manufacturer gives the consumer information in order to make him aware of the goods, and sometimes persuades him as well. A trademark is in reality communication*" as the trademark is a message that brings undertakings and consumers into contact in the market place. For consumers to receive the message, it first needs to be assimilated by their senses. Hence, any message capable of perception by the senses can constitute an indication for the consumer and consequently be a sign capable of fulfilling the function of a trademark.⁵⁸

Even though, any message can constitute a sign capable of identifying the goods of an undertaking, this capability is not always the same since the perception of the outside world by human beings depends upon the sense through which it takes place.⁵⁹ This leads the analysis to examine whether scents, perceived through the sense of smell, are distinctive.

3.2 The Distinctive Character of Scent Marks

Everyday life testimony that consumers sometimes forget a product's name but yet they do remember some other distinctive features about it that allows

⁵³ Halpern, Sheldon W; Nard, Craig Allen and L. Port, Kenneth; *Fundamentals of United States intellectual property law: Copyright, Patent and Trademark*, Kluwer Law International, The Hague, 1999, at 288.

⁵⁴ *Id.*

⁵⁵ Decision of the ECJ Merz & Krell, *supra* note 16, paragraph 21-22.

⁵⁶ Opinion of Advocate General Cosmas delivered 5 May 1998 in the Joined Cases C-108/97 and C-109/97 Windsurfing Chemisee, point 27.

⁵⁷ Opinion of Advocate General Colomer delivered on 6 November 2001, the Sieckmann-case C-273/00, point 19.

⁵⁸ Perot-Morel; *Les difficultés relatives aux marques de forme et à quelques types particuliers de marques dans le cadre communautaire*, Rivista de diritto industriale, part 1, p.247, 1996, at 257.

⁵⁹ Opinion of Advocate General Colomer, *supra* note 57, point 24.

them to locate what they want. This feature can be the product's container or something about the package or its *smell*.⁶⁰ Maybe without being able to describe the smell exactly in words, they do recall the familiar smell of that particular shampoo, soap, perfume, detergent, and fabric softener or facial tissues they once were in contact with. Given the direct interaction between smell and memory, it is understandable that consumers can use odours to distinguish and identify the origin of the article to which it is affixed.⁶¹

The distinctive character is the main legal requirement for a trademark registration in the USA, as well as in the EU⁶². Exactly what these criteria embody regarding scent marks is not clear and the significant absence of references on this point requires an inquiry. However, as trademarks in general, a scent mark can be distinctive at the time it is adopted or, through use it may acquire distinctiveness.

3.2.1 Inherent distinctiveness

The American Lanham Act clearly states that no trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on account of its nature.⁶³ Marks that are proved inherently distinctive, i.e. arbitrary⁶⁴, fanciful⁶⁵, or suggestive⁶⁶, are thereby immediately registrable on the US Principal Register, provided they do not consist of or comprise an immoral, deceptive or scandalous matter.⁶⁷ However, the US practice is to consider scent marks as ornamental or functional features of a product and are therefore *non-inherently distinctive*.⁶⁸

In the EU, on the other hand, once the scent is considered a sign under article 4 CTMR, it is the registrar's task to prove that the mark lacks inherent distinctiveness. Distinctiveness of a particular mark is an issue for article 7(1)(b) CTMR, which assumes that the sign is a trademark and provides that the trademark shall not be registered if, considered on its individual merits, the mark is "devoid of any distinctive character".

It is the practice of trademark authorities and case law that give an indication of how to use the criteria, which in fact seems different

⁶⁰ Hawes, *supra* note 10, at 143.

⁶¹ *Id.*, at 142.

⁶² Halpern, *supra* note 53, at 303.

⁶³ 15 U.S.C. § 1052.

⁶⁴ *Arbitrary marks are words or symbols which already exist in the language, but are used as trademarks on goods or services with which they are not normally associated*, see further Halpern, *supra* note 53, at 303.

⁶⁵ *Fanciful marks are invented words which do not exist in any language and that are created solely for the purpose of using the term as trademark*, see further Halpern, *supra* note 53, at 304.

⁶⁶ *A mark is suggestive when it suggests the good or services but does not go so far as to actually describe them*, see further Halpern, *supra* note 53, at 305.

⁶⁷ 15 U.S.C. § 1052.

⁶⁸ Burton, Helen; *The UK trade marks act 1994: An invitation to an olfactory occasion?*, 8 EIPR 378, 1995, at 379.

depending on the mark and products in question⁶⁹. A scent mark may be distinctive when used in connection with one product and non-distinctive when used with another.⁷⁰ The criteria will therefore vary from case to case and the examination should be made individually⁷¹. Only when the nature of the scent and the ability to be identified by the public individual of the goods or services of which it represents, can smells be inherently distinctive for trademark purpose. This relationship between scent and product should be durable over time so that the decision to purchase is always made regarding a scent that maintains the same state.⁷²

Satisfaction of these criteria however only seems possible by affixing a particularly unique scent to a normally unscented product. An unusual product feature would then be remarkable enough to create the necessary mental link in consumers' mind. This seems to be the reason why "*the smell of fresh cut grass*"⁷³ for tennis balls was allowed CTM registration. Due to the unique combination provided and that the applicant was the only manufacturer providing scented tennis balls, it was evident that consumers could immediately identify the source whereby the examiner under Appeal clearly stated that distinctiveness was not the issue⁷⁴. Similarly, "*a floral fragrance/smell reminiscent of roses applied to tyres*"⁷⁵ and "*the strong smell of bitter beer applied to flights for darts*"⁷⁶ were allowed registration under the UK Trade Marks Act⁷⁷.

The CTM Examiner implicitly confirmed this theory in a later case. He stated that "a particular fragrance" was devoid of distinctive character in relation to the normally scented products for which the mark was applied, but remained silent concerning the same fragrance in relation to the normally unscented products for which the mark also was applied.⁷⁸ In appeal, registration was however refused for not fulfilling the requirement of graphical representation whereby the Board did not further examine the question of distinctiveness.⁷⁹

⁶⁹ Wessman, Richard; *Det varumärkesrättsliga kravet på särskilningsförmåga i EU*, NIR vol.1, 2002, at 17.

⁷⁰ Kinter, Earl W and Lahr, Jack; *An Intellectual Property Law Primer*, Clark Boardman Corp.Ltd, New York, 1982, at 257.

⁷¹ Wessman, *supra* note 69, at 21; see also Decision of the ECJ 20 September 2001, *Baby-Dry* Case C-383/99.

⁷² Decision of the Third Board of Appeal of the OHIM 5 December 2001, Case R 711/1999-3, point 6.

⁷³ CTM Reg. No. 428870.

⁷⁴ Decision of the Second Board of Appeal of the OHIM, *supra* note 8, point 6a.

⁷⁵ UK reg.No: 2001416.

⁷⁶ UK reg.No: 2000234.

⁷⁷ UK Trade Marks Act 1994 implementing the Directive 89/104/EEC.

⁷⁸ CTM application No. 521914.

⁷⁹ Decision of the Forth Board of Appeal of the OHIM 19 Januari 2004, Case R-186/2000-4, point 22.

3.2.1.1 Generic scent marks excluded

Although scents can function as an identifier⁸⁰ it may not be distinctive if the scent is a generic designation of the goods or services to which it has been affixed.⁸¹ This doctrine applies both in the USA⁸² and in the EU⁸³.

By definition, a generic identifier is associated with an entire product class and, therefore, cannot serve to distinguish particular products within that class.⁸⁴ A scent, even though inherently distinctive may also lose its character if the scent becomes generic by use. For instance, paper towels that smell like lemons, an association to freshness and cleanliness are marketed to have the power to clean surfaces and soak up spills. After a successful advertising campaign, customers start asking for lemon-scented towels, not because of any inherent efficiencies, but simply because of its smell. In this way, the lemon smell loses its distinctiveness as an identifier for many purchasers and becomes a generic element of a new product class: lemon-scented towels.⁸⁵

The prohibition of generic features also has significance in terms of economic policy. For instance, a company that has exclusive rights to a generic feature might enjoy substantial marketing advantages. Competitors would therefore be forced to incur additional marketing costs to educate consumers about the nature of their products because the most common description has been appropriated. Efficient to the first company marketing it, it is, by evidence, economically inefficient to competitors in the market place.

3.2.1.2 Descriptive scent marks excluded

As with generic marks, descriptive marks are not protectable because they consist of information that a competitor need in order to sell the relevant goods or services. In this sense, descriptive marks are unable to identify a consistent source⁸⁶ and there is no reason why this should not apply to scent marks.⁸⁷

Registration is refused under the Lanham Act⁸⁸ if a trademark is purely descriptive, that is, exists *exclusively* of signs that convey information about qualities, or ingredients of the product without requiring any imagination on

⁸⁰ Hawes, *supra* note 10, at 142.

⁸¹ Kinter, *supra* note 70, at 257.

⁸² 15 U.S.C. §1064(3).

⁸³ Article 7(1)(d) CTMR and article 3(1)(d) of the Directive.

⁸⁴ "Generic" is defined as "relating to or characteristic of a whole group or class", Collins English Dictionary, 3rd ed, 1994.

⁸⁵ Burgunder, Lee B; *Trademark protection of smells: sense or nonsense*, 29 AMERICAN BUSINESS LAW JOURNAL 459, Fall 1991, at 469.

⁸⁶ Helpert, *supra* note 53, at 307.

⁸⁷ Annand, Ruth and Norman, Helen; *Blackstone's Guide to the Community Trademark*, Blackstone Press Limited, London, 1998, at 41.

⁸⁸ 15 U.S.C. § 1052.

the part of the consumer. Similarly, article 7(1)(c) CTMR excludes registration of "*trademarks which consist exclusively of signs...which may serve, in trade, to designate...intended purpose (or) value*" of the goods or other characteristics of the goods. Only exclusively descriptive marks can be refused registration under this article, but if the descriptive mark also consists of other elements it will instead be refused as devoid of any distinctive character under article 7(1)(b). This is the reason why most European scent marks have been refused trademark protection on the basis of article 7(1)(b) even though they were considered descriptive.

Product scents can be added for the purpose of odour masking and thus be descriptive by conveying a value of the goods.⁸⁹ This was considered to be the case of raspberry scent added to fuel such as diesel or heating oil since it did not allow the consumers to take in the scent of raspberry separately from that of fuel. The Fourth Board of Appeal of the OHIM thereby considered it similar to the perfuming of unpleasant smelling rooms with scented spray. Consequently, the consumer would only recognise the scent as an improvement of the image similar to a decorative element and not a sign acting as an indication of origin.⁹⁰

A given scent, although purely ornamental by its general use, might become a value by consumer who render this feature indispensable to the success of the product.⁹¹ Therefore, descriptive marks raise problems since they provide information about the product at no additional cost. If there are no equally suitable descriptive scents with which competitors may market their goods then some may be disadvantaged. In this sense, the CTM registrar refused to register a "particular" product scent because it was considered an ornamental feature and common use to scent the cosmetic products in question.⁹² Consequently, potential purchasers of these goods are unlikely to consider a scent as an indication of the origin of the goods. This was also the reason why the Swedish PTO found a fragrance for perfumery products lacking in distinctive character.⁹³

Ornamental and aesthetic features can function as a source identifier without enhancing competition and be registered as trademarks when the scent is proved to have acquired distinctiveness.

3.2.2 Acquired distinctiveness

The overwhelming presumption in trademark law is that non-distinctive marks are unregistrable. The rationale for refusing protection is that of non-distinctive marks should not be monopolised by one party and should be

⁸⁹ Elias, *supra* note 29, at 499.

⁹⁰ Decision of the Third Board of Appeal of the OHIM, *supra* note 72, point 6.

⁹¹ Elias, *supra* note 29, at 497.

⁹² CTM application, *supra* note 81.

⁹³ Swedish Application No. 199800821 and No. 199800822.

available for all without hindrance.⁹⁴ An exception to this rule is that non-distinctive marks that have acquired distinctive character through use and serve to distinguish the goods or services of one party from another. These exceptions can obtain the benefits of registration.⁹⁵

Non-inherently distinctive marks may qualify for registration under the American Lanham Act if it is proved they have acquired secondary meaning⁹⁶ i.e. through continuous and exclusive use of the mark for a period of five years. Extended use of the mark offers the opportunity for an association between the good and the mark. If consumers come to know the mark in this manner, secondary meaning has been successfully created.⁹⁷ Indeed, the practice is to require such evidence in the case of applications to register scent marks.⁹⁸ In this context, it is important to notice that generic marks can never be proved to have acquired distinctiveness in the USA, whereas this is possible in Europe.

Claiming acquired distinctiveness in the EC, under article 7(3) CTMR⁹⁹, can only assist in overcoming the absolute grounds of refusal which relate to lack of inherent distinctive character¹⁰⁰ and can therefore not cure objections raised under article 7(1)(a) concerning signs not suitable to be a trademark.¹⁰¹ In contrast to the US practice, it is not a requirement that the use takes place during a certain time before the application for registration of a CTM.¹⁰² However, the applicant must be able to prove¹⁰³ that the mark is used in the EC in at least a substantial part thereof and in such a way that a sufficiently large part of the relevant class of persons recognises the sign as a distinctive trademark.¹⁰⁴

Acquired distinctiveness of scent marks has so far not yet been claimed in Europe, which is why the American tradition will show the way. As in the case of inherent distinctiveness, a scent that is new and unusual in relation to the product to which it is affixed is more likely to be noticed by the public and thereby easier to prove acquired distinctiveness. This was the case *In re Clarke*¹⁰⁵, where the US T.T.A.B. held that since Clarke was the only manufacturer to market yarns and threads with a fragrance, it weighed in favour of acquired source identification.¹⁰⁶ The importance of *Clarke*

⁹⁴ Smith, Geoffrey; *Registering non-distinctive marks*, Trademark World 148, August 2002, at 37.

⁹⁵ Afossi-Divol, Joan; *L'usage et l'enregistrement, élément essentielle de l'harmonisation du droit des marques*, Press Universitaires de Strasbourg, Strasbourg, 2003, at 422.

⁹⁶ 15 U.S.C. §1052 (f).

⁹⁷ Helpern, *supra* note 53, at 308.

⁹⁸ *re Clarke*, *supra* note 7.

⁹⁹ The same rule applies as an option to the member states under article 3.3 of the Directive CEE/89/104.

¹⁰⁰ A trademark which offends article 7(1)(b),(c) or (d) CTMR may still be registered if it has acquired distinctiveness.

¹⁰¹ Guideline 8.1.2, OHIM OJ 9/96, p.1330.

¹⁰² Annand, *supra* note 87, at 48.

¹⁰³ *see* Section 2.2.2.3.

¹⁰⁴ Decision of the ECJ 4 May 1999, Windsurfing Chiemsee Case C-108/97 and 109/97.

¹⁰⁵ *re Clarke*, *supra* note 7, at 1238.

¹⁰⁶ *Id.*, at 1240.

extends beyond its significance as granting the first scent mark registration; implicitly it established the criteria for determining distinctiveness of scent marks in the USA. It was stated that the scent mark must conjure a mental association with its source in customers' minds. For this to occur, consumers must have access to the scent, use that access in recognising the source of the product and be capable of actually accurately identifying the source by smell.¹⁰⁷ In traditional view of trademarks, this occurs before a sale is made¹⁰⁸, but how it applies to scent marks will now be further developed.

3.2.2.1 Pre-sale source identification

Regarding primary scents, the requirement of access is normally satisfied since testers at the point of sale normally are offered the fragrance, being the product in question.¹⁰⁹ Product scents, on the other hand, are affixed to household and personal products sold in supermarkets where pre-purchase samples usually are not given. Therefore, the consumer is only to decide the purchase on the basis of the product packaging unless they open it, but not all products are opened or sampled so easily.¹¹⁰ In the *Clarke* case, the packaging of Clarke's scented yarn permitted the consumer to smell the Plumeria fragrance before purchase¹¹¹. The USPTO now requires the scent to be advertised on the outside of the product.¹¹² This is a solution that also should be required in Europe. In the future, this problem may be solved by new technology devices that will enable consumers to smell a variety of products or brands at the point of sale through touch-screen computers that emit the scent when touching a picture of the product to which it is affixed.

In the case where the consumers do have access to the scent, they must also be able to recognise the scent as familiar in addition to linking it with the identity of the product or its manufacturer.¹¹³ Smells can conjure up associated memories, but when it comes to recalling a particular smell itself, there is scientific support for the conclusion that the sense-memory link is weak due to the subjectivity of the human sense of smell. For instance, in a scientific study, an object was presented with common odours such as lemon, mint and banana and only about one-third of the scents could be named correctly.¹¹⁴ Indeed, there is a risk that persons identifying a smell will describe it in different terms although it has been correctly identified. In another study the particular smell of "BAZOOKA bubble-gum" could be identified and linked to chewing "gum".¹¹⁵ Although, according to Bettina Elias¹¹⁶ this could not be considered as recognition since the consumers in the tests did not mention "BAZOOKA bubble-gum". Further, for the sense-

¹⁰⁷ Burton, *supra* note 68, at 379.

¹⁰⁸ Elias, *supra* note 29, at 479.

¹⁰⁹ *Id.*, at 517.

¹¹⁰ *Id.*, at 480.

¹¹¹ re Clarke, *supra* note 7, Applicant's Reply Brief, at 6.

¹¹² U.S. Serial No.74-720993, see also 37 CFR §2.20.

¹¹³ Elias, *supra* note 29, at 480.

¹¹⁴ Elias, *supra* note 29, at 481.

¹¹⁵ *Id.*; see also Hawes, *supra* note 10, at 136.

¹¹⁶ Elias, *supra* note 29, at 481.

memory link to function efficiently, a person needs to have had previous contact with the scent and normally under pleasant circumstances since the memory is in close relation to emotions. For example, the smell of fresh cut grass reminds most people of summer and vacations. In this case, the sense-memory link can be described as strong. The same thing can be said of sweet scents like the smell of strawberries. Often, these smells are linked to childhood experiences for most individuals but then the cultural background of each person varies and will impact on the function of the sense-memory link to particular scents. The sense-memory link also has to function after the purchase is made.

3.2.2.2 Post-sale source identification

As opposed to the pre-sale context, access to the smell in a post-sale perspective is not precluded with either product or primary scents. The scents may then be considered separately from their packaging and be all that potential purchasers have to concentrate on for recognition.

Primary scents, being the product itself, lingers after use and will likely be remembered since the fragrance will be separated from its visual packaging.¹¹⁷ Likewise, many personal care and household products have a lasting fragrance. The lasting nature of a product scent can actually be a valued attribute among consumers¹¹⁸ that allow them to create a sense-memory link with use. Most product scents, would only be likely to function as post-sale source-identifiers where the scent is particularly unique, since only then would it be remarkable enough to become sufficiently familiar for a purchaser to associate with its source.

Of course, as in the *Clarke-case* and "*the smell of fresh cut grass*"-case, a product scent almost certainly would become a source-identifier if it were uncommon in the context of a given product. This is actually the case of all registered scents marks. To add some American examples, *the scent of strawberry, grape or cherry* is used for motor fuel¹¹⁹ and, *the scent of bubble gum* for oil based metal cutting fluid and oil based metal removing fluid for industrial metal working¹²⁰.

3.2.2.3 Proof of acquired distinctiveness

¹¹⁷ *Id.*, at 484.

¹¹⁸For instance, floor cleaners in Venezuela contain a strong fragrance since the Venezuelan consumer relies on the strong scent to inform others that her house is clean. Even less heavily scented products can leave a lingering fragrance after use as for example a shampoo. The fragrance can then acquire distinctiveness if consumers can smell it on other's hair and identify the shampoo used. See further Elias, *supra* note 29, at 485.

¹¹⁹ US Reg. No. 2,596,156, strawberry; 2,568,512, grape; US Reg. No. 2,463,044, cherry.

¹²⁰ US Reg. No. 2,560,618.

It is only when the Applicant can prove by showing that a substantial number of consumers recognise the scent as a trade sign, that it can be registered on the basis of acquired distinctiveness.¹²¹ The evidence should show the place, time, extent and nature of the use and it may be in the form of documents and items such as packaging, labels, price lists, catalogues, invoice, photographs and advertisements.¹²² The examination in the USA is moreover based on the success in the market, duration of use, attempts to imitate and the impact on competition.¹²³

Regarding scent marks, particular problems might arise concerning advertisement, which constitutes important evidence. The applicant must show that the promotional efforts stress the origin of the scent. Verbal descriptions alone are unlikely to convey the particular scent to the consuming public.¹²⁴ In the *Clarke case*, the applicant was the only purveyor of her product and her advertisement made reference to "Clarke's Distinctive Soft-Scented Yarns". Although the Examining Attorney believed this description to be vague, the T.T.A.B. found the advertisement as having sufficient evidence that consumers, dealers and distributors recognised the source of the products by their scented characteristics.¹²⁵ The decision also took into account that the scent was advertised on the outside of the product¹²⁶.

On the other hand, advertisement by featured scent strips or scented cards could be sufficient evidence.¹²⁷ In the future, sufficient evidence could be established by advertisement on the Internet using, new technology which could allow the creation of devices providing PC users smell-simulations through digital signals. (See further under section 4.2.2.2).

Even though scents can be proved distinctive, other obstacles still exist to scents being granted trademark protection.

3.3 The Risk of Scent Depletion

Depletion theory is a doctrine that has been applied in American trademark law to colour trademarks. This theory operates on the principle that there are a limited number of sensory devices that will be favourably perceived by consumers. Granting a trademark monopoly over one of the few desirable marks available "depletes" the remaining pool of desirable marks and thus

¹²¹ Smith, *supra* note 94, at 37; see also Hawes, *supra* note 10, at 153.

¹²² Guideline 8.12.1, OHIM OJ 9/96, p.1332; *Statements in writing sworn or affirmed or having similar effect under that law of the state in which the statement is drawn up are other forms of evidence. These may come from experts in the trade or trade associations. The results of opinion polls may also be submitted.*

¹²³ Helpert, *supra* note 53, at 308-309.

¹²⁴ Elias, *supra* note 29, at 494.

¹²⁵ *re Clarke*, *supra* note 7, at 1240.

¹²⁶ 37 CFR §2.20.

¹²⁷ Article: *Med näsa för varumärken*, BRAND NEWS No 07/2003, at 26; see also Elias, *supra* note 29, at 524.

adversely affects competition. If there are a large or even infinite number of sensory devices that can be positively perceived by consumers, then removing one trademark out of this deeper pool via trademark registration does not significantly affect competition. Given the similarity of fragrance to colour, in terms of composition, it is possible that the same principle would apply to fragrances.¹²⁸

Not all scents are suitable for all products. To the extent that a particular fragrance conjures up existing associations or has become an expected scent for a given product, the number of fragrances from which a competitor might choose may be limited.¹²⁹ According to Hawes, the existence of innumerable possible scent combinations and variations available makes scent depletion an unrealistic fear.¹³⁰ However, there should be sufficient scent alternatives to support a vigorously competitive market system. Studies have shown there may be as many as ten thousand distinguishable smells, although individual abilities differ greatly.¹³¹ Further study is required to determine the number of distinguishable smells existent under purchasing conditions. Certainly, this number will be less than ten thousand but enough to assure competition in the marketplace.

Although there are many available smells, one needs to be concerned that certain scents may be more sales effective and perhaps more limited. Consequently, if similar scents are monopolised, only the mark owner could produce variations on this theme. If it is true that there are only a few possibilities from which to produce new scents then fragrance depletion could be actualised.¹³² Over all, customers prefer scented products. There may be cross-cultural preferences and aversions to smells. Shared cultural scent preferences mean that there are relatively few desirable scent marks to be shared among traders. Given the universal human preferences for certain odours, a scent mark registration in one country potentially depletes the pool of marks both nationally and internationally, reducing competition on both a local and global scale.

Even though there might not be a great variety of existing scents that immediately conjure up associations, such scents can be developed. With strong marketing and use of products that relates to or create pleasant experiences, a basic, created scent can, over time, become functional by establishing a sense-memory link. Although this may be possible, it requires scientific and commercial research resulting in high costs and without any guaranty of efficiency.

Based on the number of possible alternatives, depletion concerns are probably not as significant for smells as they may be for colours. Given the

¹²⁸Burton, *supra* note 68, at 381; see also Elias, *supra* note 29, at 488.

¹²⁹Elias, *supra* note 29, at 489.

¹³⁰Hawes, *supra* note 10, at 153.

¹³¹The average person can recognise two thousand or more scents while a trained expert can recognise up to ten thousand. See further Burgunder, *supra* note 85, at 473.

¹³²Burton, *supra* note 68, at 381.

underlying goal of preventing market foreclosure by monopolising trade signs, this concern is probably more efficiently dealt with under the theory of scent functionality.

3.4 The Functional Character of Scents Marks

Even if distinctive, it is likely that the scent will be barred trademark protection because of the function the scent may serve¹³³, as when *Channel* applied for trademark protection of its perfume fragrance "No.5" in the UK. The rule derives from the American doctrine of functionality, which is a judicially created rule that prohibits anyone from claiming an exclusive right to a feature of a product that contributes to or performs a function of that feature.¹³⁴ The fundamental purpose of the doctrine is to ensure that competitors remain free to copy useful product features, thereby enhancing competition.¹³⁵

Generally, when a sensory product feature serves a primarily utilitarian purpose, the US courts and the USPTO have denied it protection under trademark law. But if the sensory product feature is non-essential to the use or purpose of the article¹³⁶, or if it is a mere matter of trade dress, or one that serves only the incidental use of identifying the manufacturer's goods, the courts and the PTO have found it non-functional and with a showing of acquired distinctiveness have extended protection.¹³⁷ In *Clarke*, the T.T.A.B. assumed that applying the scent of Plumeria blossoms to yarns and threads had no functional implications.¹³⁸ The USPTO stated, however, that its decision to register the scented mark would not constitute a precedent for extension of similar protection to perfumes or other products for which scent is an inherent, functional characteristic.¹³⁹

The utilitarian functionality doctrine also exists in Europe, as stipulated in article 7(1)(e) CTMR. This article states that the shape of a product shall not result from the *nature* or *substantial value* of the good itself. If this article is applicable to scents is discussible since it exclusively concerns shapes. By reading the OHIM Examination Guidelines one can however find that "*a liquid can have any shape*".¹⁴⁰ It can be concluded that perfume, which consists of a natural carrier of liquid can have any shape, whereby the article could be extended application to scents. Furthermore, the substantial value exception affects the consumer's motive for buying the goods¹⁴¹, which in

¹³³ Elias, *supra* note 29, at 495.

¹³⁴ Stolte, Keith M; *Functionality challenges to incontestable trademark registrations before and after the Trademark Law Treaty Implementation Act*, 92 TMR 1094, 2002, at 1095.

¹³⁵ *Id.*, at 1098

¹³⁶ *Id.*

¹³⁷ Clarke, Nancy L.; *Issues in the federal registration of flavors as trademarks for pharmaceutical products*, Intellectual Property Law Review (Clark Boardman Callaghan) 459, 1994, at 466-467.

¹³⁸ re Clarke, *supra* note 7, at 1239.

¹³⁹ Clarke, *supra* note 137, at 473.

¹⁴⁰ OHIM Examination Guideline 8.6, OHIM OJ 9/96, at 1331.

¹⁴¹ Annand, *supra* note 87, at 45.

the case of perfume is its smell. Perfume scents would then be excluded trademark protection. Even if smells can have utilitarian properties, it may not always be possible to distinguish those from aesthetic features necessary for effective competition in an industry¹⁴². This is probably why the tendency in Europe is to exclude registration of perfume scents on the basis of article 7(1)(c) CTMR concerning descriptive marks as referred to the aesthetic function of the scent.

The problem of applying article 7(1)(c) alone or in relation with 7(1)(b) on perfume scents is that trademark registration then is possible if acquired distinctiveness can be established. Therefore, there is an interest to extend the application of article 7(1)(e) to scents since the criteria of this article cannot be overcome by proving acquired distinctiveness according to article 7(3). This would be perfectly in line with the underlying trademark principle of "independence of mark and product". As a result, the scent of perfumes can never be registered for the items themselves, but only in respect of other goods, for example, lip gloss or drawer liners, in respect to its indication of trade source.¹⁴³

3.5 Summary

Any sign capable of perception by the senses can fulfil the function of a trademark which is to guarantee the identity of a market product's origin. Given the direct interaction between smell and memory, scents can have this function. The main legal requirement for trademark registration is that the sign have distinctive character. It is the practice of trademark authorities and case law to give an indication of what this requirement embodies. The evidence shows that only by the nature of the scent and its ability to be identified by the public, individually of the product, can a scent be inherently distinctive. It follows that generic scent marks are not distinctive. Likewise, a sign that is descriptive (i.e. conveying a value to the product like the scent of cosmetics) is seen as a decorative element and not as an indication of origin and is therefore not inherently distinctive. In opposition to the European practice, scents are always considered non-inherently distinctive in the USA.

Non-inherently distinctive marks are registrable, both in the EU and in the USA if it can be established, through evidence such as advertisement, tags and labels, that the scent has acquired distinctiveness through use. The use of the mark offers the opportunity for an association between the mark and its source, either at the point of sale or once the purchase is made and the product is put in use. Just as in the case of inherent distinctiveness, acquired distinctiveness is most likely to be established when a normally unscented product is added a particularly unique scent. It is then remarkable enough to create a mental link in consumers' minds, as is the case of "*the smell of fresh*

¹⁴² Burgunder, *supra* note 85, at 478.

¹⁴³ Lyons, Deberett; *Sounds, smell and signs*, 12 EIPR 540, 1994, at 540.

cut grass" for tennis balls. Inherently distinctive or through acquisition, this is actually the case of all registered scents marks.

To the extent that a particular fragrance conjures up existing associations or has become an expected scent for a given product, the number of fragrances from which a competitor might chose may be limited. It is however unlikely that depletion concerns will bar trademark protection of scents, which is the case if the scent is a natural characteristic of the product, having a function that is essential to the use or purpose of the article. A perfume can therefore not be afforded trademark protection.

4 REGISTRATION PROBLEMS OF SCENT MARKS

As set out in article 4 CTMR, the registrability of a trademark depends on its capability to be represented graphically. Technically, this means that it should be possible to reproduce the sign in paper form so that it can be recorded, published and visually understood.¹⁴⁴

4.1 Requirement of Graphical Representation

Registration of a trademark grants its owner an exclusive right to use the mark. For reasons of legal certainty, the mark has to be defined in a comprehensive manner¹⁴⁵ so that the precise subject of the protection afforded by registration can be determined.¹⁴⁶ The requirement of graphical representation has for this reason been imposed in the EU in order to make the mark accessible to the competent authorities and the public, particularly to economic operators.¹⁴⁷ The authorities must know the nature of the sign of which a mark consists in order to fulfil their obligations in relation to the prior examination of registration applications and to the publication and maintenance of an appropriate and precise register of trademarks. Economic operators must be able to find out about registration or applications made by their competitors and thus receive information about the rights of third parties.¹⁴⁸

Although not a requirement in the legal system of the USA, graphical representation is demanded in the registration application that has to be filed by a special form of drawing of the mark¹⁴⁹ and often also by a specimen proving the actual commercial use of the mark.¹⁵⁰ The graphical representation is not onerous for most marks, consisting simply of words, devices, letters, numerals, or other two- or three-dimensional signs. Regarding scent marks, the issue is more contentious, since the sign in itself is not visible.

¹⁴⁴ The definition of graphic is "of or relating to writing or other inscribed representations", see further Lawry, Mark and Dickerson, Jeremy; *The curse of invisibility*, TRADEMARK WORLD 164, February 2004, at 28.

¹⁴⁵ Opinion of Advocate-General Colomer, *supra* note 57, point 37.

¹⁴⁶ Decision of the ECJ, *supra* note 12, paragraph 48.

¹⁴⁷ *Id.*, paragraph 49.

¹⁴⁸ *Id.*, paragraph 51-52.

¹⁴⁹ TMEP 807.11. For marks consisting of a word, letter or numeral not in a special form it is sufficient to have it typewritten in capital letters on paper. A special form of drawing is only demanded in the case of marks containing a stylised or design element. See also 37 CFR §2.52(a)(3).

¹⁵⁰ 37 CFR §2.56.

4.2 Graphical Representation of Scent marks

In the USA, the requirement of drawing has been waived for scent marks since it is considered not representable by a drawing. Instead, the applicant is required to file an adequate description of the mark.¹⁵¹

The rules governing representation of a CTM set out in the OHIM Examination Guidelines do not mention scent marks. Firm guidelines¹⁵² have however been offered by the ECJ in the *Sieckmann-case*. Accordingly, a scent is registerable "*provided that it can be represented graphically, particularly by means of images, lines or characters, and that the representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective*".¹⁵³ Although uncertain if these issues can be fulfilled, several possibilities exist to represent scents graphically.

4.2.1 Scent perception

4.2.1.1 Verbal description

Although graphic, the ECJ held that the description of an odour is not sufficiently clear, precise and objective¹⁵⁴. This is undoubtedly true regarding the scent described in the *Sieckmann-case* as "*balsamically fruity with a slight hint of cinnamon*", since it is not understandable what is meant by "balsamic", "fruity" or how intense the "hint" of cinnamon is supposed to be. With this description, it is impossible to identify the olfactory sign.¹⁵⁵ However, it would seem wrong to altogether preclude written descriptions as a suitable way of graphically representing smells.

Even though no scent can be described in such a way as to enable anyone accurately to identify or to duplicate it, a verbal description, if well written, can provide sufficient information to characterise the fragrance's complexities in fair detail.¹⁵⁶ This has been the ground for accepting written descriptions in earlier practice of the OHIM as well as some national PTOs. "*A floral scent reminiscent of Plumeria blossoms*" was allowed trademark registration in the *Clarke-case* that thereby elucidate the principle that it is acceptable to describe a scent mark in words when seeking an American scent mark registration^{157 158}. Likewise, the UK TMRWM accepts word

¹⁵¹ TMEP 807.11, see also 37 CFR § 2.51(c).

¹⁵² These issues are not confined solely to scents but also to other non-visual and visual signs. See, Decision of the ECJ 27 November 2003 *Shield Mark* Case C-293/01, that confirm the requirements set out in the *Sieckmann-case* apply to sound marks.

¹⁵³ Decision of the ECJ, *supra* note 12, paragraph 55.

¹⁵⁴ *Id.*, paragraph 70.

¹⁵⁵ Opinion of Advocate-General Colomer, *supra* note 57, point 41.

¹⁵⁶ Hawes, *supra* note 10, at 144. See also TMEP 808.02. The description should state accurately what the mark comprises and should not create a misleading impression by either positive statement or mission.

¹⁵⁷ Accordingly, other scent marks in the USA have been described as follows: "*the scent fo bubble gum used for oil based metal cutting fluid and oil based metal removing fluid for industrial metal*

descriptions of scent marks if they are sufficiently precise.¹⁵⁹ "*The strong smell of bitter beer*"¹⁶⁰ and "*the smell reminiscent of roses*"¹⁶¹ were accepted as adequate descriptions in the UK practice. Not as precise was "*the smell of cinnamon*", since it could differ widely depending upon the different context in which people may have experienced the smell¹⁶².

Another important ruling that sparked sharp discussion was that of the Second Board of Appeal at the OHIM deciding the description "*the smell of fresh cut grass*", clear enough since it was "*a distinct smell which everyone immediately recognises from experience. For many, the scent or fragrance of freshly cut grass reminds them of spring, or summer, manicured lawns or playing fields, or other such pleasant experience*".¹⁶³ It has been claimed that the decision was reached with little consideration of the issue being whether the description was sufficient objective to fulfil the requirement of graphical representation.¹⁶⁴ It followed that even if the smell can be recognised through personal experience, it would differ according to the conditions of its origins, as for example the kind of grass and conditions such as if the grass is dry or damp when cut. Hence, compared to the typical smell common to fresh cut grass, possible differences may exist but they would be negligible to the consumers in relation to tennis balls. Despite these doctrinal objections, once again the (Third) Board of Appeal of the OHIM stated that the verbal description of a "unique, pure smell" that is well-known to consumers "in an exceptional case" could satisfy the requirement of graphical representation.¹⁶⁵ This was the case of "*the scent or smell of raspberries*", although the application was rejected by the Board for lack of distinctiveness.¹⁶⁶

Seemingly, the central question is whether the mark is sufficiently described for third parties to determine its scope. When actually describing a smell, people usually refer to an object. A distinct fragrance smells like something, thus, people do not describe the smell, but the object where the smell comes from. That is because there is no clear and independent nomenclature that can be used for the description of smells. It might be acceptable to describe a scent as "the smell of X as emitted by Y". This would allow the nature and conditions of the smell to be clearly and unambiguously described.

working" (Reg. No. 2560618); "*a fragrance intended to evoke the scent of various orchard fruits applied as fragrances sold as an integral component of preparations for cleaning, polishing, moisturising, and protecting furniture, paneling, wood and other hard surfaces*" (Reg. No. 2644707); and three scent marks associated with lubricants and motor fuels for land vehicles, aircraft and watercraft (Reg. No. 2596156, strawberry; Reg. No. 2463044, cherry; Reg. No. 2568512, grape).

¹⁵⁸ re Clarke, *supra* note 7.

¹⁵⁹ UK TMRWM, Chapter 6.2.3.8."Examination - Smellmarks", at 24.

¹⁶⁰ UK Reg., *supra* note 79.

¹⁶¹ UK Reg., *supra* note 80.

¹⁶² John Lewis of Hungersford Ltd's Trade Mark Application [2001] 28 R.P.C 575, at 591.

¹⁶³ Decision of the Second Board of Appeal of the OHIM, *supra* note 8, paragraph 13-14.

¹⁶⁴ Turner-Kerr, Peter; "*The smell of fresh cut grass*", 2 EIPR N-19, 2001, at N-20. Turner-Kerr also claims that the Board failed to address the examiners' concerns as to whether a verbal description was sufficient to fulfill the requirement for a graphical representation.

¹⁶⁵ Decision of the Third Board of Appeal of the OHIM, *supra* note 72, at 3.

¹⁶⁶ *Id.*

Thus, as described by Advocate General Colomer, "*sensory perception can only be described as more or less perfect, and consequently the recipient's description of what he perceives will only be accurate to a greater or lesser degree*"¹⁶⁷. But when the targeted section of the public smell the scent, and if they generally describe it in the same or with similar words as those used in the description, it could be considered to give sufficient information of what the mark precisely embodies and thereby satisfy the requirement of graphical representation.¹⁶⁸ The solution should therefore not be to categorically refuse to accept such descriptions or declare them unsuitable *ab initio*, but to decide on a case-by-case basis whether a given smell is capable of being described in an adequately precise manner. Apparently, this is what the OHIM decided to do. In a recent decision of the Fourth Board of Appeal of the OHIM, a verbal description was refused because it was not sufficiently precise or clear.¹⁶⁹ But the board did however examine the description proving that the possibility to graphically represent scent marks by verbal descriptions is not completely abandoned.

4.2.1.2 Analysing diagram

Scent evaluation can be made by sophisticated system of gas **chromatography** (GC) or high-performance liquid chromatography (HPLC) that provide good qualitative and quantitative information about complex mixtures. These methods use a column packed with special adsorbents to separate different compounds and produces a graphic output indicating a plot of the amount of each compound against the time taken for its separation.¹⁷⁰ Considering that smells are emanations carried by a fluid (air or liquid) that are perceived by the olfactory apparatus, it should at least theoretically be possible to represent a scent by chromatography.

However, the method of chromatography is still under development and currently when translated into graph form, it may be unreliable since some chemicals will not contribute to scents¹⁷¹. The active components of a volatile mixture are nothing more than the important sensorial elements that are determined by simply sniffing the released compounds in order to complement the information from the chromatography.¹⁷² Exact identification of the components is then made by mass spectrometry (MS) that provide structural information about the components at even low levels of concentration.¹⁷³ The information given is precise and allows the scent to be reconstituted.¹⁷⁴

¹⁶⁷ Opinion of Advocate General Colomer, *supra* note 57, point 26.

¹⁶⁸ If the members of the courts are incapable of surely assess this from their own personal experience or knowledge, it could be clarified on the basis of a public opinion poll.

¹⁶⁹ Decision of the Fourth Board of Appeal, 19 Januari 2004, case R-186/2000-4, paragraph 17-18, 19.

¹⁷⁰ Hawes, *supra* note 10, at 140; see also Lyons, *supra* note 143, at 541.

¹⁷¹ Components with very particular scents can be refine in very low concentrations and may not give detectable results as well as odourless components may give strong results; see furter Le Pen, Jean-Jaques; *Le nez électronique*, Expertises, May 1998, at 133.

¹⁷² Lyons, *supra* note 143, at 542.

¹⁷³ Le Pen, *supra* note 171.

¹⁷⁴ Stix, Gary; *Scent Prospectors*, Scientific American, May 1997, at 21.

Neither the ECJ nor the OHIM pronounced whether the requirement of graphic representation could be satisfied by chromatography. The only CTM application filed with chromatography was withdrawn¹⁷⁵! Similarly, Swedish and French trademark applications were withdrawn after the PTOs announced the graphical representation was not fulfilled for lack of information on the technical conditions under which the chromatography was performed in this particular case.¹⁷⁶ Thus in the UK, the use of chromatography was declared unintelligible to persons inspecting the Register of trademarks, who without further information would be unable to identify the smell.¹⁷⁷

Another 'smell-seeing' device to measure odours is the **electronic nose**. It consists of an array of chemical sensors with overlapping selectivity profiles for the smell (gas mixtures) to be measured and followed by data-collection and then identified by pattern-recognition techniques. The pattern can further be processed to yield a computer generated 'olfactory image' of the gas mixture in graph form.¹⁷⁸ More sophisticated, the **colorimetric electronic nose** is based on colour changes that occur in gas-sensitive metalloporphyrin dyes. By fixing an array of different metalloporphyrins in silica gel, unique and directly visible colour patterns can be produced when the arrays are exposed to organic vapours. They obtain unique colour fingerprints of vapours. Although this is the most sensitive chemical sensor, it is still not as sensitive as a natural nose but the colorimetric changes of an array for metalloporphyrins upon exposure to organic vapours can replace, with the help of the eye and brain, the various systems used for odour classification.¹⁷⁹

A CTM application¹⁸⁰ of a particular scent represented by a 'colour-olfactory-image' was recently reported before the Fourth Board of Appeal of the OHIM, who held that the image did not correspond to the requirement of graphical representation. The Board concluded that the image was not sufficiently intelligible (at least not for the general public) since few people would recognise in such an image the identity of the scent in question. Neither was it sufficient that the sign could be reproduced, yet by technical equipment. The representation also has to provide the public with necessary conventionally acceptable indications of how to interpret it and consequently the representation was not self-contained.¹⁸¹

¹⁷⁵ CTM Application No. 566596.

¹⁷⁶ Sweden Application No. A98/821 and A98/822 (Two applications were made for the same scent concerning different products). French Application No. 97-658 685 and 97-698179.

¹⁷⁷ Hungersford, *supra* note 162, at 587.

¹⁷⁸ Le Pen, *supra* note 171, at 133; see also Lundström, Ingemar; *Picture the smell*, Nature vol. 406, 17 August 2000, at 682.

¹⁷⁹ Lundström, *supra* note 178, at 682-683.

¹⁸⁰ CTM Application, *supra* note 81.

¹⁸¹ Decision of the Fourth Board of Appeal of the OHIM 19 Januari 2004, Case R-186/2000-4, paragraph 17-18, 20.

Scent characterisation, by technical instruments, would not only increase the burden of the PTOs for the capability to confirm the accuracy of the characterisation but also render the consumer recollection harder, since this is what is actually protected against confusion. The OHIM did not exclude the possibility to use technical equipment to characterise and reproduce the scent. Such equipment is not easily accessible for the public consulting the register. Legal certainty would therefore be hard to afford. This elaboration would also be non-efficient from an economic point of view, since the applicant, the PTO and all persons consulting the register would have to run an analyse of the scent every time the mark is to be determined, not to mention having access to the technical equipment in the first place. In most cases, this would also include assistance of professionals.

4.2.1.3 Image

By means of an image of a strawberry, a CTM application was refused registration for a scent described as "the smell of ripe strawberry".¹⁸² The decision is currently under appeal, but is likely to be confirmed by the Board of Appeal. Even though graphical, the image represented a strawberry and not the smell of a strawberry. This engenders ambiguity to the public who might understand that it is the image and not the scent that is represented. Therefore, the requirement of graphic representation can not be satisfied. It is unlikely that an image, in form of a picture or photo, might ever be able to identify a scent in an intelligible, clear and precise manner.

4.2.2 Substance

4.2.2.1 Chemical formula

In the *Sieckmann-case*, the applicant sought registration of the compound methyl cinnamate as a scent mark for services ranging from education and training to veterinary and agricultural services, scientific research and computer programming. The applicant described the mark in his application as the '*pure chemical substance methyl cinnamate*' and included its chemical formula $C_6H_5CH=CHCOOCH_3$.¹⁸³

The ECJ clearly stated that the requirement of graphic representation was not satisfied by a chemical formula since it "*does not represent the odour of a substance, but the substance as such and nor is it sufficiently clear and precise*".¹⁸⁴ Chemical formulae are unsuitable because one and the same product may emit different olfactory signs depending on such random factors as its concentration, ambient temperature or the carrier to which it is applied.¹⁸⁵ Even if it were made clear in the application that the protection

¹⁸² CTM Application No. 1122118.

¹⁸³ Decision of the ECJ, *supra* note 12, paragraph 11.

¹⁸⁴ *Id.*, paragraph 69.

¹⁸⁵ Opinion of Advocate-General Colomer, *supra* note 57, point 40.

was claimed for the smell of the substance and that additional information such as temperature were provided, this objection would probably not be overcome.

Further on, the ECJ accepted the arguments that a chemical formula is not sufficiently intelligible since only a few people are in a position to identify a smell when they read the chemical formula. This must be the correct approach and an argument that it would mitigate against the graphic representation of sound marks in form of musical notes would fall as a reasonably large percentage of the population can read musical notation. In addition, the publication of the chemical formula in the trademark register would allow competitors to easily copy the smell.

4.2.2.2 Deposition of a smell sample

In the USA, deposition of specimen is not a requirement but may serve to clarify the verbal description. The specimen may be a label, tag, container or a display associated with the goods.¹⁸⁶ The submission of scent specimens can be problematic since there are no reliable ways to preserve scents. Commonly, the best way is to store the scents in cool, dark, dry and tight containers¹⁸⁷ but the creation of special depositories at each PTO for scent samples is not a good solution. It would be cost-inefficient, as regards to space and maintenance, neither would it render the scent mark easily accessible for the public and economic operators.

As to the deposit of an odour sample, the ECJ clearly declared in the *Sieckmann-case* that it "*does not constitute a graphic representation*". Moreover, an odour sample is not sufficiently stable or durable¹⁸⁸ as referred to the volatility of the chemical components that eventually leads to changes in a particular composition and ultimately to the evaporation and disappearance of the smell. The USPTO resolved the issue by allowing the deposition of strips of blotter paper soaked in the fragrance provided that it is submitted in an airtight plastic bag¹⁸⁹. The applicant also has to replace the specimen every five years in order to ensure its duration.

In contrast to the ECJ, the Advocate General Colomer stated that depositing a sample "*may be permissible*" but difficulties of registration would then occur, as regards to clarity and precision that would compound further problems associated with the publication of the marks.¹⁹⁰ As it is the sign that is afforded protection through registration and since a scent is not visible, what could then be better than allowing the public consulting the register to actually smell the scent?

¹⁸⁶ TMEP § 905.01 and 37 CFR § 2.58(b).

¹⁸⁷ Löfgren, *supra* note 1, at 12.

¹⁸⁸ Decision of the ECJ, *supra* note 12, paragraph 71.

¹⁸⁹ US No. 74-20993.

¹⁹⁰ Opinion of Advocate General Colomer, *supra* note 57, point 42.

In the society of the 21st century, the register of trademarks can be consulted on the Internet. New technology has allowed the creation of a peripheral device called a 'scent dome' that allows PC users smell-simulations. The 'scent-dome' attaches to a PC and is roughly the size of a computer speaker. Inside sits a replaceable cartridge that contains different aroma oils synthesised from 'natural primary scents' as for instance the aroma of a fruit. Actually, the natural item is broken down into its basic chemical components from which the molecules are taken and replicated into the oil used in the cartridge. Each aroma is assigned a binary code and can be released either individually or in union¹⁹¹, based on the digital instructions sent either through a computer program with a simple 'mouse click' or triggered by a digital scent track on a web site. The digital signal activates the reservoir containing the aromas demanded which will be heated until they begin to vaporise and float through the holes of the device and to the user's nose.^{192 193}

Once the 'scent dome' becomes openly available, similarly to sounds and graphics, in accordance with images or texts, it will be a means to represent a smell in a *clear, precise, self-contained, easily accessible, intelligible, durable and objective*" manner. However, time will show if this is possible.

4.2.3 Combination of scent perception and substance

If none-of the reproductions proposed can individually meet the criteria set out by the ECJ on the graphical representation, the sum of all those reproductions would only increase the number of messages intended to identify the sign, which therefore constitutes a risk of different interpretations resulting in even more uncertainty.¹⁹⁴ The ECJ held in the *Sieckmann-case* that the combination of a verbal description, chemical formula and a deposit of an odour sample was not able to satisfy the requirements of graphical representation and in particular those of clarity and precision.¹⁹⁵

Other combinations could be contemplated. Similarly to the American experience, verbal descriptions and smell samples are the means most likely to be accepted as graphical representations. Therefore, an objective and

¹⁹¹ Although there are only 20 aromas per cartridge, these can be mixed to create thousands of different smells and concentrations.

¹⁹² Tanaka, Jennifer, *Touch me, Feel me*, Newsweek, September 11, 2000, at 80; *What you didn't learn in Marketing*, Sales & Marketing Management vol. 152 issue 12, December 2000, at 20; Rogers, Michael; *Bringing Net Users to Their Senses* Library Journal vol.126 issue 1, Winter 2001, at 8. And Gollobin, Kelly, Computer Reseller News, Issue 929, 22 January 2001, at 39.

¹⁹³ This device was originally developed by the American company called DigiScents. As the ran out of means during 2003, it seemed to be the end of the 'scent dome'. However, Triscent took over and is further developing the technique. Currently, a UK net provider, the Telewest Broadband is testing this device though internet. In order to participate the user has to have the 'scent dome', which costs around 250 pounds, which only works with a high-speed, broadband connection. See further: BBC NEWS: Published: 2004/02/19, available at <http://news.bbc.co.uk/go/pr/fr/-/2/hi/technology/3502821.stm>.

¹⁹⁴ Opinion of Advocate General Colomer, *supra* note 57, point 43.

¹⁹⁵ Decision of the ECJ, *supra* note 12, paragraph 72.

clear verbal description combined with a smell-sample in form of scent strips or by the scent-dome might be envisagable. This is also the technique that has been used for decades in the fragrance industry.¹⁹⁶

Whether a scent can be perceived clearly in the same way by different people, given the variances in scents and difficulties in graphical representation, should be determined on a case by case basis.

4.3 Summary

As a requirement for trademark registration, a sign has to be capable of graphic representation. Even though scents are non-visible, they can be represented graphically by means of images, lines or characters, provided that *the representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective*. This is for reasons of legal certainty since the representation should allow persons consulting the register to define the mark and to determine the precise subject of protection afforded by registration. How to fulfil the criteria is however unsure since the practice of competent authorities more or less has rejected all existing technical possibilities. A verbal description's ability to be clear, precise and objective depends on the subjectivity of the human sense of smell. The use of electronic sensory analysis in form of electronic noses or gas-chromatography were considered unintelligible and hardly accessible. Neither could the requirement be satisfied by a chemical formula since it does not represent the odour of a substance, but the substance itself. As to the deposit of a smell-sample, it does not constitute a graphic representation and cannot be considered durable although this could be solved by new technology. The combination of these reproductions would increase the number of different interpretations resulting in even more uncertainty. The capability of scents to be clearly identified through their representation should not automatically be rejected but decided on a case-by-case basis.

¹⁹⁶ Hawes, *supra* note 10, at 145

5 DIFFICULTIES IN PROTECTING SCENT MARKS

The protection afforded by registration confers to the proprietor of a mark the exclusive right to use it in commerce that prevents the public from being confused as to the source of products. Regarding scent marks, there are no guidelines or case-law concerning infringement but it would certainly be more difficult to prove than in the case of traditional trademarks.

5.1 Use against which a Trademark is protected

Registration of a trademark affords its owner an *exclusive right* to use the mark in commerce. This includes the right to use the trademark on or in connection with identified goods or services as well as the right to licence this right to third parties. All other uses, or attempts to use the mark by others or by adoption of similar mark on similar goods and services may give rise to infringement.¹⁹⁷

The protection afforded to a trademark proprietor against third party use of the trademark is absolute. Trademark use means use in the course of trade, commercial activity involving the production and supply of goods and services on a specific market.¹⁹⁸ Consequently, commercial situations may occur where a similar or identical scent is used on products that are dissimilar to the ones the scent is granted protection. Regarding scent marks, such use could under some circumstances be detrimental to the trademark's repute and be subject for a dilution- or unfair competition-claim. Whether or not such use is hard to establish extends beyond the scope of this thesis, but the difficulties in establishing infringement will further be examined.

5.2 Difficulties in establishing Infringement

In order to establish infringement of a trademark under the Lanham Act, the plaintiff has to prove there is a *likelihood of confusion*, mistake or deception regarding the source or origin of the goods or services on the part of the purchasers.¹⁹⁹ Similarly, the CTMR provides the holder of a registered trademark to prevent the use of a similar sign in relation to similar goods or services if there exists a likelihood of confusion on the part of the public, including the likelihood of association between the sign and the

¹⁹⁷ 15 U.S.C. § 1114(1) and article 9(1) CTMR and article 5(1) of the Directive.

¹⁹⁸ McDermott, Chris McLeod; *Infringement and trademark use*, Trademark World 150, October 2002, at 24.

¹⁹⁹ 15 U.S.C. § 1114(1)(a).

trademark.²⁰⁰ The test of likelihood is an overall impression of the two marks compared that encompass the nature of the goods or services, the end users, the method of use and whether the business using the signs are in competition with each other. As to any other trademark, these principles also apply to scent marks.

However, the test of likelihood would not be exactly the same as for any other trademark considering that the comparison would call upon the consumer's recollection of an earlier scent.²⁰¹ It is therefore the same criteria as when determining the scent's distinctiveness that will decide the likelihood of confusion, which is afflicted by the strength of a sign in the marketplace. Thereby the scope of the likelihood question considers the possible confusion at the point of sale as well as when third parties might be misled by viewing the items after the purchaser has put them into their intended use.

Confusion may result when a consumer subconsciously calls to mind the registered mark when seeing the alleged infringing sign or vice versa. Supposing for instance, that a laundry detergent is advertised for its superior bleaching powers and happens to be imbued with a distinctive scent that no other manufacturer uses. A competitor perceives that consumers like the new scent and adds it to its low quality, non-whitening detergent. A prospective consumer notices the grubby, greying clothes of his neighbour while a whiff of the unique fragrance floats by. The result could be consumer confusion and harm the first user.²⁰²

Scent mark infringement is however difficult to detect. The likelihood of confusion should be proved among the general public or among users other than the original purchaser. Such evidence may be hard to establish since the ability to detect and differentiate scents varies between individuals and may depend on factors such as age, sex, hormonal cycling, environment and even cultural differences. The courts will have the same difficulties in deciding whether there is infringement or not. Without expert assistance, uniformity among judicial determinations would be difficult to achieve. However, leaving infringement determinations to a perfumery expert is not appropriate since he has an extraordinary sense of smell compared to the ordinary consumer who comes in contact with the products in the marketplace.

Finally, infringement decisions will only rely upon consumer surveys that will depend on the subjectivity of the human sense of smell. It thereby seems hard to succeed with an infringement claim concerning a scent mark unless the mark has a strong place in the market i.e. distinctive.

²⁰⁰ Article 9(1)(b) CTMR.

²⁰¹ Hawes, *supra* note 10, at 155.

²⁰² Elias, *supra* note 29, at 485.

5.3 Summary

Trademark protection grants its owner an *exclusive right* to use the mark in commerce and claim infringement if there is a likelihood of confusion of the scent on the part of the public. The test of likelihood would call upon the consumer's recollection of an earlier scent. Scent mark infringement is however difficult to detect since the ability to differentiate scents varies between individuals.

6 CONCLUSIONS

Used as a strategic weapon for business, scents have become an innovative and catchy way for traders to market their goods and services to appeal to customers. However, an equally strong case can be made that scent marks pose a significant dilemma for trademark law.

Even though scents are implicitly recognised, the capability to constitute a trademark sign is challenging given the parameters of trademark law. The subjective nature of perception makes it difficult for scents to function as reliable indications of trade source. Although some smells are very distinctive, such as bread fresh from the oven or cigar smoke, there are still bound to be shades of differences and impressions made on individuals exposed to the mark. Some individuals have a keener sense of smell than others and how a human perceives a scent is dependent on many factors such as age, sex, health, environment and cultural differences. Even when a scent is correctly identified, there may be a risk that the persons identifying the scent will describe it in different terms. It is only the nature of the scent and its ability to be unvaried when identified by the public that a scent can be distinctive enough for trademark purpose.

In addition, any source identification function is outweighed by the economic interest in giving competitors free and unfettered access to the feature so that they can compete effectively. Primary scents like perfumes and air fresheners are thereby completely excluded from trademark protection in the USA for their functional natural characteristics, whereas they are only considered devoid of inherent distinctive character in Europe for reasons of their generic or descriptive nature. Consequently, these scents can theoretically be afforded trademark protection under the CTMR if acquired distinctiveness can be established. This cannot on any grounds be in line with the trademark principle of "independence of mark and product" considering that the scent is the product itself and is thereby the only motivation for purchase. The problem is also closely linked to how the competitive market should be determined in order to define the scope of third party rights. With an abstract market definition, trademark protection would be rather meek to competition since there are thousands of perfumery scents in the market. On the other hand, a narrowed market definition would limit the competitive alternatives or even lead to market foreclosure giving the proprietor an unwarranted market power. Since trademark policy is designed to limit consumer confusion without providing competitive advantages, perfumery scents should be excluded trademark protection on an absolute basis even in Europe. Considering that a perfume consists of a natural carrier of liquid that can have any shape, a solution would be to extend the application of article 7(1)(e) CTMR in order to completely exclude trademark registration of perfumery scents.

As a result, scents can only, as shown by practice, function as trademarks under circumstances where the scent is new in relation to the product to which it is affixed or when the scent is particularly unique and used on normally unscented products. The scent is thereby sufficiently outstanding to create a mental association to the source in consumers' minds. It is the memory function of the sense of smell that is used and since this sense-memory link is closely intervened with emotions, people link smells to experiences. Therefore, scents that remind people of pleasant things, such as vacations, sweets, flowers, freedom, calm and security compounding to a strong sense-memory link, can be used for trademark purpose because of their distinctive character. The question that then arises is whether or not the available pool of such particular scents is limited so as to disadvantage competitors from choice. Considering the fact established that there are at least ten thousand distinguishable smells, one can deduce that fear of scent depletion would be unrealistic.

Another perplexing issue is if the consumers come to define a smell only in terms of a particular product, then they will be confused if other producers apply that smell. Considering that trademark law prevents third parties from using the protected mark under circumstances likely to cause confusion this could be prevailed by infringement claims. However, scent mark infringement would be hard to establish since the test of likelihood or confusion would call upon the consumer's recollection of scents. The evidence would then be established by consumer survey, resulting in a decision that entirely depends on the subjective nature of human scent perception. The outcome would be unpredictable and litigants would truly be entering a lottery system when proceeding to trial for scent mark actions unless they are sure that their scent has certain market strength. An unsuccessful trial would have important economical consequences. Not only does the trademark reputation risk to be harmed, but the owner also loses an important business asset and all efforts and investment put into research and development. Actually, while the cost of a trademark application is relatively low, the cost of research and development necessary for a successfully registered and protected scent mark might be considerably high. Scientific and commercial research is necessary in order to assure that the scent will be distinctive and conjures a sense-memory link in order to function as a trademark. Assurances that the scent will appeal to consumers and be suitable in relation to the product require investigation as well as how to technically and durably affix the scent on the product or in advertisement. Not until the scent is actually put on the market will it be sure that the scent will function as a trademark and that sufficient protection can be afforded. In reason hereof, trademark practitioners look for other openings that are more cost-effective, which is probably one of the reasons why only six CTM applications for scents have been filed so far.

The major obstacle to scents marks registration is the lack of means existing that would seemingly satisfy the criteria set out for fulfilling the European legal requirement of graphical representation of non-visible signs. The ECJ declared this possible by means of images, lines or characters, provided that

the representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective. However, on basis of these criteria the deposit of smell- samples is not possible and the submission of graphical representation in the form of "electronic nose" analysis and chromatography have been rejected, as well as the representation by a chemical formula, a verbal description and the combination of these reproductions. Truly, the purpose of the requirement is to enable economic operators and authorities to define the precise subject of the protection granted. Transparency is therefore vitally important. The public must be able to see trademarks for what they are, easily and without extraneous information, materials or expensive tools, to determine the precise nature of a trademark.

Although considered not sufficiently precise and clear, verbal descriptions seem, to be the only possible way out to afford trademark protection with today's existing technology. As long as the description of the mark gives sufficient information about what the mark precisely embody, the formal requirement of graphical representation would be fulfilled. Depending on the nature of the smell, a well-written description can sufficiently inform the identity of a smell that is well known. The most precise and least ambiguous way to describe a scent, since no referential nomenclature exists, is for people to actually describe the object from where the smell comes instead of the smell itself, for example " the smell of X as emitted by Y". Considering the main purpose is a sufficiently clear representation for third parties to determine the scope of the mark, what would be more precise than the same description that the targeted section of the public would use to define the scent in question? Additionally, if one were to seriously follow the criteria set out by the ECJ that actually condemns registration of scent marks, then it would ultimately call into question the graphic representability of many other trademark forms. For instance, colour trademarks look different depending on the light, word marks may vary in sound depending on who pronounces them and sound marks depends on the musical instruments playing the mark as well as the subjectivity of the listener. All in all, a verbal description seems a suitable way of graphically representing scents in exceptional cases, which also has been confirmed by the American experience. The solution should therefore be, while waiting for technology to develop, to decide on a case-by-case basis whether a given smell is capable of being accurately described.

Changes in how trademarks are stored on the register could also contemplate to overcome the issue of graphical representation. This is if use is made of computer technology to record a scent faithfully and make it accessible to a person consulting the register on the internet, by means of a new technology device called a scent-dome that will allow PC-users direct smell-simulations. The future will show if this will be an acceptable way of graphically represent scents.

Finally, it is not impossible but extremely hard to satisfy the criteria of distinctiveness as well as those of graphical representation required for trademark registration of a scent mark. It is neither sure that the protection

afforded by registration can be assured in a trademark action. However, the interaction between trademark law and its economic environment is one aspect of the complex symbiotic relationship that exists between a legal system and the society in which it operates. The field of trademark law is living and should therefore be capable of responding to changing markets and the ingenuity of human. Seen as cost-inefficient to develop scents that will fulfil the requirements, companies will look for alternatives and unless the criteria are set down, it seems like scent will have no future as trademarks.

Astic	Astic, Valérie and Larreu, Jaques; <i>Des rugissements aux deurs:l'évolution des marques commerciales</i> , Recueil Dalloz 1998, 41 Cahier Chronique, at 389.
Brand News	<i>Med näsa för varumärken</i> , BRAND NEWS, Stockholm, No 07/2003, at 24.
Burgunder	Burgunder, Lee.B.; <i>Trademark protection of smells: sense or nonsense</i> , 29AMERICAN BUSINESS LAW JOURNAL 459, Fall 1991.
Burton	Burton, Helen; <i>The UK trade marks act 1994: An invitation to an olfactory occasion?</i> 8 EIPR 378, 1995.
Clarke	Clarke, Nancy L.; <i>Issues in the federal registration of flavours as trademarks for pharmaceutical products</i> , IPLR (Clarke, Boardman, Callaghan) at 459, 1994.
Chaudri	Chaudri, Abida; <i>Graphically speaking</i> , Trademark World 157, May 2003.
Elias	Elias, Bettina; <i>Do scents signify source? An argument against trademarks for fragrances</i> , 82 TMR 475, 1992.
Hawes	Hawes, James E; <i>Fragrances as trademarks</i> , 79 TMR 134, 1989.
Lawry	Lawry, Mark and Dickerson, Jeremy, <i>The curse of invisibility</i> , Trademark World 164, February 2004.
Le Pen	Le Pen, J.J; <i>Le nez électronique</i> , Expertises, Mai 1998, at 133.
Lunell	Lunell, Erika; <i>Dofter och ljud som föremal för varumärkesrätt - några kommentarer kring "Sieckmann-fallet"</i> , NIR vol. 2, 2003, at 124.
Lyons	Lyons, Deberett; <i>Sound, smell and signs</i> , 12 EIPR 540, 1994.
Löfgren	Löfgren, Christer; <i>Doft för lojalitet</i> , BRAND NEWS, Stockholm, No 07/2003, at 9.
McDermott	McDermott, Chris McLeod; <i>Infringement and trademark use</i> , Trademark World 150, October 2002.
Perot-Morel	Perot-Morel, M.A.; <i>Les difficultés relatives aux marques de forme et à quelques types particulières de marques dans le cadre</i>

- communautaire*, Rivista di Diritto Industriale, parte I, vol.6, 1996, at 247.
- Smith Smith, Geoffrey; *Registering non-distinctive marks*, Trademark World 148, August 2002.
- Stolte Stolte, Keith M, *Functionality challenges to incontestable trademark registrations before and after the Trademark Law Treaty implementation Act*, 92 TMR 1094, 2002.
- Swann Swann, Jerre B; *Trademarks and marketing*, 91 TMR 787, 2001.
- Troussel Troussel, Jean-Christophe and Van der Broeche, Pieter; *Is European community trademark getting in good shape?*, 93 TMR 1066, 2003.
- Turner-Kerr Turner-Kerr, Peter; *"The smell of fresh cut grass"*, 2 EIPR N-19, 2001.
- Wessmann Wessmann, Richard; *Det varumärkesrättsliga kravet på särskilningsförmåga i EU*, NIR vol. 1, 2002, at 16.
- Zendel Zendel, Daniel and Prahl, Dennis; *Making sense of trademarks: an international survey of non-visual marks*, Trademark World 21, August 1996.

Press

- Gollobin Gollobin, Kelly; Computer Reseller News Issue 929, 22 January 2001, at 39.
- Holloway Holloway, Marguerite; *The Ascent of Scent*, Scientific American, 1999, vol.11, at 28-30.
- Kanfoudi Kanfoudi, EM; *Les caractéristiques des odeurs*, Analisis Magazine, 1996, vol.24, n°8.
- Lundström Lundström, Ingemar; *Picture the smell*, Nature vol.406, 17 August 2000, at 682.
- Rogers Rogers, Michael; *Bringing Net Users to Their Senses* Library Journal vol.126 issue 1, Winter 2001, at 8.
- Stix Stix, Gary; *Scent prospectors*, Scientific American, May 1997, at 20.
- Süskind Süskind, Patrick; *Perfume: The Story of a Murderer*, Diogenes Verlag, 1. Aufl., Zürich, 1985.

Tanaka Tanaka, Jennifer; *Touch Me, Feel Me*,
Newsweek, 2000, September 11, vol. 9, at 80.

*What you didn't learn in Marketing, Sales &
Marketing Management* vol. 152 issue 12,
December 2000, at 20.

BBC NEWS BBC NEWS: Published: 2004/02/19, at
<http://news.bbc.co.uk/go/pr/fr//2/hi/technology/3502821.stm>

Dictionnary

Collins Cobuild English dictionnary (Editor in chief, John Sinclair), Harper
Collins Publishers Ltd., Glasgow, 1995.

Table of Cases

ECJ

- C-10/89 SA CNL- SULAL NU v. HAG GF AG, Decision 17 October 1990, [1990] ECR I-3711.
- C-108/97 and 109/97 Windsurfing Chiemsee Produktions- und Vertriebs GmbH v. Boots-und Segelzubehör Walter Huber and Franz Attenberger, Decision 4 May 1999, [1999] ECR I-02779.
- C-383/99 Procter & Gamble Company v. OHIM, Decision 20 September 2001, [2001] ECR I-6251.
- C-517/99 Merz & Krell GmbH & Co, Decision 4 October 2001, [2001] ECR I-6959.
- C-273/00 Ralf Sieckmann v. Deutsches Patent- und Markenamt- Chanel's Application, Decision 12 December 2002, [2002] ECR I-11737.
- C-283/01 Shield Mark B.V v. Joost Kist, Decision 27 November 2003, (unreported).

OHIM

- R 156/1998-2 Venootscap onder Firma Senta Aromatic Marketing, The Second Board of Appeal, 11 February 1999.
- R 711/1999-3 Reinard Bleier, The Third Board of Appeal, 5 December 2001.
- R 186/2000-4 Institut pour la Protection des Fragrances (I.P.F.), The Fourth Board of Appeal, 19 January 2004.

US

Re Clarke 17 USPQ 2d 1238, TTAB (1990).

UK

John Lewis of Hungersford Ltds. Trade Mark Application [2001] RPC 575.