

**What Makes Sense in One Country May Not in Another:
A Survey of Select Jurisdictions re Scent Mark Registration, and a Critique of
Scents as Trade-marks**

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I. Introduction

It is possible to register scent marks in some common law countries. However, many countries expressly prohibit the registration of trade-marks that are not comprised of words or graphic representations. Meanwhile, it is debatable whether scent marks qualify for trade-mark registration in many jurisdictions.

This paper has two goals. The first is to conduct a comparative survey of a select group of countries, comprising some of the world's major intellectual property jurisdictions, as well as international agreements pertaining to trade-marks, to determine whether scents are registrable as trade-marks. The second goal is an evaluation of whether scents should be registrable as trade-marks. This is achieved by examining research on the human perception of odours. A critical analysis of scent mark registration indicates that while scent marks initially appear to be an innovative way to distinguish wares and services, scents are impractical as trade-marks given the highly subjective nature of human smell. In addition, universal preferences and aversions to odours mean that there are few scent marks to be used in trade, resulting in reduced competition and trade-mark depletion.

II. Comparative analysis of trade-mark regimes

1. International agreements

No international treaty concerning trade-marks explicitly mandates contracting parties to register scent marks. In fact, the *Trademark Law Treaty* explicitly states it is inapplicable to scent marks.¹ Neither the *Madrid Agreement Concerning the International Registration of Marks*² nor the *Protocol Relating to the Madrid Agreement Concerning the International Registration of*

¹ *Trademark Law Treaty*, Article 2(1)(b), online: World Intellectual Property Organization (WIPO) <<http://www.wipo.int/clea/docs/en/wo/wo027en.htm>>.

² *Madrid Agreement Concerning the International Registration of Marks*, online: WIPO <<http://www.wipo.org/madrid/en/index.html>>.

*Marks*³ conclusively define what “mark” 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*⁴ also does not define “trade-mark” for the purposes of that particular convention. However, the *Paris Convention* does leave what is a registrable trade-mark to the domestic law of contracting parties.⁵ Similarly, the World Trade Organization’s *Agreement on Trade-Related Aspects of Intellectual Property Rights* states contracting parties may limit trade-mark registration to only visibly perceptible signs.⁶

2. Domestic law

The fact that many international treaties pertaining to trade-marks do not define “trade-mark” and/or allow contracting parties to determine what is a registrable mark within their jurisdictions is paralleled in the lack of universal acceptance for scent mark registrations. Some jurisdictions surveyed permit scent mark registration, while others explicitly ban scent mark registration in their statutes. It may be possible or impossible to register scent marks in many other jurisdictions, depending on how the applicable domestic law is interpreted.

What follows is a classification of nine important trademark jurisdictions into three categories: (1) countries that explicitly prohibit scent mark registration; (2) countries that explicitly allow and/or have allowed scent mark registration, and (3) countries where the registrability of scent marks is unclear. In the last category, an analysis of the appropriate statutes and case law has been conducted to determine whether scent marks are potentially registrable.

³ *Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks*, online: WIPO <<http://www.wipo.org/madrid/en/index.html>>.

⁴ *Paris Convention for the Protection of Industrial Property*, online: WIPO <<http://www.wipo.int/clea/docs/en/wo/wo020en.htm>> [*Paris Convention*].

⁵ *Ibid.*, Article 6.

⁶ *Agreement on Trade-Related Aspects of Intellectual Property Rights*, Article 15(1), online: World Trade Organization (WTO) <http://www.wto.org/english/docs_e/legal_e/legal_e.htm> [*TRIPS Agreement*].

i. Countries explicitly prohibiting scent mark registration

Brazil

The only marks that can be registered in Brazil are visually perceptible signs.⁷ Therefore, scent marks cannot be registered under Brazilian trade mark law.⁸

China

Article 8 of Chinese trademark statute restricts registered trademarks to visible symbols.⁹ Therefore scent marks are not registrable in China.¹⁰

Mexico

Article 88 of the Mexican *Industrial Property Law*¹¹ states that only visible signs may be registered as trade marks. Therefore scent marks do not qualify for trademark registration in Mexico.

ii. Countries that explicitly authorize and/or allow scent mark registration

Australia

Scent marks are explicitly registrable under sections 7 and 17 of the Australian *Trade Mark Act of 1995*.¹² Section 17 defines a “trade mark” as a sign used, or intended to be used, to distinguish goods or services dealt with or provided in the course of trade by a person from goods or services so dealt with or provided by any other person, while section 6 defines a “sign” as including

⁷ “Trademarks: Questions Most Often Asked”, online: Instituto Nacional da Propriedade Industrial (INPI), online: <<http://www.inpi.gov.br/idiomas/ingles/index.htm>>. See also Anne Marie Greene, ed. *Trademarks throughout the World*, 4th ed., looseleaf (Deerfield, IL: Clark Boardman Callaghan, 1989) at B-66 [*Trademarks throughout the World*].

⁸ According to the website of INPI, the Brazilian government agency overseeing trade mark registration, Brazilian trade mark law does not protect scent, sound and flavour marks. See “Trademarks: Questions Most Often Asked”, *ibid.*

⁹ *Trademark Law of the People’s Republic of China*, online: isinolaw Research Centre <http://www.isinolaw.com/jsp/law/LAW_Articles.jsp?CatID=288&LangID=0&StatutesID=2002619&ChapterID=-1>.

¹⁰ Scent marks are not protected under Chinese unfair competition law, as the unfair competition statute only contemplates the unfair use of well-known marks which constitute names, packaging or decorations. *Law of the People’s Republic of China Against Unfair Competition*, Article 5(2), online: isinolaw Research Centre <http://www.isinolaw.com/jsp/law/LAW_Articles.jsp?CatID=385&LangID=0&StatutesID=131669&ChapterID=-1>.

¹¹ *Industrial Property Law (Ley de la Propiedad Industrial)*, online: World Intellectual Property Organization (WIPO) <<http://clea.wipo.int/PDFFILES/English/MX/MX016EN.PDF>>.

¹² *Trade Marks Act 1995 (Cth)*, online: SCALEplus (Australian Attorney-General Dept.) <<http://scaleplus.law.gov.au/home.htm>>.

scent. A search of the Australian trade-mark register at the time of writing indicates that there is one scent mark application¹³ currently being examined, while five scent mark applications have lapsed and therefore remain unregistered.¹⁴

Since section 40 of the Australian trade mark statute specifies that an application for trade mark registration in Australia must be rejected if the mark cannot be represented graphically, providing a sample of the scent mark with the trade mark application will not satisfy Australian registration requirements. The wording of sections 27(3)(a) and 40 of the *Trade Mark Act of 1995* indicate that the writing requirement could be satisfied by providing the scent's chemical structure.¹⁵ However, as none of the scent mark registrations currently in the Australian trade-mark database represent the mark in terms of a chemical formula and instead describe the mark in words¹⁶, whether representing a mark by chemical formula would satisfy Australian trade-mark registration requirements remains untested.

It is possible that representing a scent mark by the scent's chemical formula in Australia may constitute deception under section 43 of Australia's *Trade Marks Act 1995*¹⁷, as the chemical formula of a scent does not represent the odor of the compound used in the scent mark, but the compound itself. A chemical formula is not how a consumer of the goods or services associated with the scent would experience the mark. Representing a scent mark by the scent's chemical

¹³ TM No. 936188, online: ATMOSS (Australian Trade Mark On-line Search System) <http://pericles.ipaustralia.gov.au/atmoss/falcon.application_start>.

¹⁴ TM No. 700019, 727820, 762286, 821444, and 823865, online: ATMOSS, *ibid*.

¹⁵ *Supra* note 12, ss. 27(3)(a) and 40. Section 40 states "An application for the registration of a trade mark must be rejected if the trade mark cannot be represented graphically", while s. 27(3)(a) reads:

(3) Without limiting the particulars that may be included in an application, the application must:
(a) include a representation of the trade mark.

For a discussion on how to represent smell and sound marks graphically, see Debrett Lyons, "Sounds, Smells and Signs" (1994) 16 E.I.P.R. 540.

¹⁶ *Supra* notes 13 and 14.

formula may be considered deceptive. Thus, an application for scent mark registration describing the scent mark in terms of chemical formula can be potentially rejected on the basis of the mark description.¹⁸ Given this potential for rejection, in the absence of a ruling by the Australian trade-mark authority, it is advisable to represent a scent mark in words, not chemical structures. Such a representation could include the chemical name of the scent, or description of the scent mark's fragrance.¹⁹

European Union – European Community Mark (ECM)

The European Community Mark (ECM) is alternative and complimentary to trade-mark registration in individual European Union²⁰ countries.²¹ The ECM provides protection for a trade-mark meeting the ECM registration requirements for the entire market within the European Union. The objective of the ECM is to allow applicants to file one trade-mark application for the entire European Union, removing the need for applicants to register trade-marks separately in each European Union member state.²² According to the regulation governing ECMs²³, an ECM may consist of any signs capable of graphical representation that are capable of distinguishing the

¹⁷ Section 43 reads: “An application for the registration of a trade mark in respect of particular goods or services must be rejected if, because of some connotation that the trade mark or a sign contained in the trade mark has, the use of the trade mark in relation to those goods or services would be likely to deceive or cause confusion”.

¹⁸ *Ibid.*

¹⁹ A search of the Australian trade mark register indicates that scent mark applications have described such marks in terms of their fragrance.

²⁰ The member states of the European Union (EU) are Austria, Belgium, Denmark, Finland, France, Germany, Greece, Ireland, Italy, Luxembourg, the Netherlands, Portugal, Spain, Sweden and the United Kingdom (U.K). “Member States of the Union European”, online: Europa – the European Union On-Line <<http://europa.eu.int/abc-en.htm>>.

²¹ “The Trade Mark and Internalization of Markets: The role of the Community trade mark”, online: Office for the Harmonization of Internal Markets (OHIM) – Trade Marks and Designs <<http://oami.eu.int/en/mark/role/brochure/br1en07.htm>>.

²² “Community Trade Mark”, online: Europa – the European Union On-Line <<http://europa.eu.int/scadplus/leg/en/lvb/l26022a.htm>>.

²³ Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark, online: Office for the Harmonization of Internal Markets (OHIM) – Trade Marks and Designs <<http://oami.eu.int/en/mark/aspects/reg/reg4094.htm>> [*Community Trade Mark Regulation/CMTR*].

goods or services of one business from those of another.²⁴ Signs which do not conform to these requirements cannot be registered.²⁵

Previously, the graphic representation requirement for European Community scent marks was satisfied by a written description of the scent employed in the mark.²⁶ This changed with the recent European Court of Justice (ECJ) decision in *Sieckmann v. Deutsches Patent-und Markenamt*.²⁷ In *Sieckmann*, the Applicant sought registration of the compound methyl cinnamate as a scent mark in association with classes 35²⁸, 41²⁹ and 42³⁰ of the *Nice Agreement on the International Classification of Goods and Services for the Purposes of the Registration of Marks*.³¹ The Applicant described the mark in his application as the “pure chemical substance methyl cinnamate (= cinnamic acid methyl ester)”. The trade-mark application also included the chemical structure of methyl cinnamate, a description of methyl cinnamate’s scent³², and a scent sample.

²⁴ *Ibid*, Article 4. Article 4 provides a non-exhaustive list of potential signs: words (including personal names), designs, letters, numerals, and the shape of goods or of their packaging.

²⁵ *Supra* note 23, Article 7(1)(a).

²⁶ See *Vennootschap Onder Firma Senta Aromatic Marketing’s Application*, [1999] E.T.M.R. 429 (OHIM (2d Bd. App.) [*Vennootschap*]). In *Vennootschap*, the Applicant sought to register a scent mark described as “the smell of fresh cut grass” used in association with tennis balls. The Board of Appeal reversed the trade-mark examiner’s decision that the word description of the mark’s scent did not satisfy the graphical representation requirements of the *CMTR*, stating “[t]he smell of freshly cut grass is a distinct smell which everyone immediately recognizes from experience” (at 433). The Board then stated the written description provided for the mark complied with the graphical representation requirement of the *CMTR*, Article 4. For a case comment on the *Vennootschap* decision, see Peter M. Turner-Kerr, “European Community: Trade Marks – Application to the European Trade Marks Office OHIM for Registration of an Olfactory Mark”, (2001) 23(2) E.I.P.R. N19.

²⁷ Case C-273/00, 12 December 2002, online: European Court of Justice <<http://curia.eu.int/en/content/juris/index.htm>> [*Sieckmann*].

²⁸ Advertising, business management, business administration, and office functions. *Nice Classification*, online: WIPO <<http://www.wipo.org/classifications/fulltext/nice8/enmain.htm>>.

²⁹ Education, providing of training, entertainment, sporting and cultural activities. *Nice Classification*, *ibid*.

³⁰ Scientific and technological services and research and design relating thereto, industrial analysis and research services, design and development of computer hardware and software, and legal services. *Nice Classification*, *supra* note 28.

³¹ Online: WIPO <<http://www.wipo.int/clea/docs/en/wo/wo019en.htm>>.

³² The Applicant stated that the scent of methyl cinnamate was usually described as “balsamically fruity with a slight hint of cinnamon”. *Sieckmann*, *supra* note 27 at ¶13.

In *Sieckmann*, the ECJ attempted to reconcile the requirement of ECMs being graphically represented in trade-mark applications with the lack of an express prohibition against scent mark registration in the *Community Trade Mark Regulation (CTMR)*. The ECJ interpreted Article 2 of the *CTMR* as denoting that a ECM “may consist of a sign which is not in itself capable of being perceived visually”³³, provided that the sign can be represented graphically by images, lines or characters and that the representation of the sign is “clear, precise, self-contained, easily accessible and durable.”³⁴ The Court ruled that requirements of graphic representation for scent marks are not satisfied by one, or any combination of the following: the scent’s chemical formula, a description of the scent in written words, or deposit of a scent sample.³⁵

Sieckmann effectively bars registration of scent marks under the ECM system, as most scent marks applicants would describe the scent mark by the very methods the ECJ found unsatisfactory for the *CTMR* graphical representation requirement. While alternatives such as spectrographic profiles of a scent mark initially appear to fit within the ECJ’s test for graphic representation (i.e. images, lines or characters), it is unlikely that spectrographs would qualify as graphic representation under *Sieckmann*. This is because the ECJ in *Sieckmann* accepted the arguments that a chemical formula is not sufficiently intelligible by most consumers as indicating the scent mark, nor does a chemical formula represent the odour of a substance.³⁶ Given that spectrographs are not sufficiently intelligible by most consumers, as they are only comprehensible to those with specialized training, and that spectrographs are in fact an alternative representation of a compound’s chemical structure, it is unlikely that spectrographic representations of a scent mark would satisfy the *Sieckmann* test. In the absence of an ECJ

³³ *Supra* note 27 at ¶45, 55.

³⁴ *Supra* note 27 at ¶55.

³⁵ *Supra* note 27 at ¶73.

decision on scent marks contrary to *Sieckmann*, it will be very difficult, if not impossible, to register scent marks under the ECM system.

United Kingdom (U.K.)

The United Kingdom's trade-mark statute, the *Trade Marks Act, 1994*, defines "trade mark" as any sign that is can be represented graphically and distinguishes the goods or services of one undertaking from those of another.³⁷ Examples of registrable trade-marks enumerated in the *Trade Marks Act, 1994* include designs, the shape of goods or their packaging, words (including personal name), designs, letter and numerals.³⁸ Signs which cannot be graphically represented are disqualified from trade-mark registration.³⁹ While the U.K. trade-mark statute does not explicitly authorize scent mark registrations, the presence of scent mark registrations⁴⁰ in the U.K. trade-mark registrar makes it clear that scent marks are indeed registrable in the U.K.. Additionally, the trade-mark tribunal in *John Lewis of Hungerford Ltd.'s Trade Mark Application* stated that signs do not have to be visually perceptible in order to be capable of registration under U.K. law.^{41,42}

While the *Hungerford* decision initially appears to be a victory for the registration of non-visual marks in the U.K., the decision does not provide any clear instruction re how applicants are to fulfill the direction from *Hungerford* that non-visual signs must be graphically represented in

³⁶ *Supra* note 27 at ¶69.

³⁷ (U.K.) 1994, c. 26, s. 1(1), online: U.K. Patent Office, <<http://www.patent.gov.uk/tm/legal/tmact94.pdf>>.

³⁸ *Ibid.*

³⁹ *Supra* note 37, s. 3(1)(a).

⁴⁰ Examples of currently registered scent marks include Trade Mark 2001416 ("The trade-mark is a floral fragrance/smell reminiscent of roses as applied to [tires]") and Trade Mark 2000234 ("The mark comprises the strong smell of bitter beer applied to flights for darts"). Trade Mark Register Enquiry, online: UK Patent Office (UKPO) <<http://webdb4.patent.gov.uk/tm/number/>>.

⁴¹ *John Lewis of Hungerford Ltd.'s Trade Mark Application*, [2001] 28 R.P.C. 575 at 591(Appointed Person) [*Hungerford*].

⁴² The *Trade Marks Registry Work Manual* notes the *Trade Marks Act, 1994* does not exhaustively define what constitutes a sign. *Trade Marks Registry Work Manual*, Chapter 6.2.2 "Examination – "Any sign" at 15, online: UKPO <<http://www.patent.gov.uk/tm/reference/workman/index.htm>> [*Trade Marks Registry Work Manual*].

trade mark applications.⁴³ On one hand, the *Hungerford* decision states the graphic representation requirement does not mandate trade-mark “applicants to perform the impossible task of filing a visible representation from which an invisible sign can be directly perceived”.⁴⁴ On the other hand, a graphic representation “cannot do more than define the relevant sign in terms of the presentational criteria it must fulfill”.⁴⁵ The tribunal further states the identity of a smell mark must be “clearly and unambiguously” recorded in the trade mark application.⁴⁶

Hungerford is problematic for scent mark registration on many levels. First, despite the tribunal’s caveat that it was not requiring applicants to perform the impossible task of filing a visible representation of an invisible sign⁴⁷, *Hungerford* does indeed require that applicants graphically represent an invisible mark. Second, as the tribunal in *Hungerford* failed to define what constitutes clear and unambiguous graphical representation of scent marks, and the presentation criteria such marks are required to fulfill, trade-mark applicants post-*Hungerford* have no idea of criteria they must fulfill to successfully register scent marks.

The issues regarding what constitutes sufficient graphic representation and presentation criteria for invisible marks have yet to be presented before the U.K. courts. Thus, there are no judicial criteria for the graphical representations of scent marks in U.K. trade-mark applications. However, the U.K. Patent Office’s *Trade Marks Registry Work Manual* provides criteria concerning acceptable forms of graphical representation. In the Registrar’s view, a sign is graphically represented when:

⁴³ *Supra* note 41 at 592.

⁴⁴ *Supra* note 41.

⁴⁵ *Supra* note 41.

⁴⁶ *Supra* note 41 at 592.

⁴⁷ *Supra* note 41.

- a. “it is possible to determine from the graphical representation precisely what the sign is that the applicant uses or proposes to use without the need for supporting samples, etc.;
- b. the graphical representation can stand in place of the sign used or proposed to be used by the applicant because it represents that sign and no other;
- c. it is reasonably practicable for persons inspecting the register, or reading the Trade Marks Journal, to understand from the graphical representation what the trade mark is.”⁴⁸

The *Trade Marks Registry Work Manual* adds some important caveats to the above criteria. First, descriptions in words are unlikely to be accepted as a graphical representation of a trade-mark.⁴⁹ However, there may be instances where a word description will be acceptable if the description is sufficiently precise. Second, it is unlikely that the description of a scent in words will possess enough precision to be accepted as a graphical representation of a mark. The U.K. Patent Office has anticipated that unless a scent can be defined precisely by some other form of representation which is consistent with the three graphic representation principles, it may be impossible to graphically represent a scent mark and obtain a scent mark registration.⁵⁰ The test that U.K. trade-mark examiners are to use in assessing whether a scent is a registrable trade-mark is: (1) can the applicant show that the smell is used a trade-mark?; (2) is the smell an inherent attribute or natural characteristic of the goods or is the smell added by the applicant to identify the goods?; (3) will the public regard the smell as sign which identifies the applicant’s goods?; and (4) is the mark represented graphically?⁵¹

⁴⁸ *Supra* note 42, Chapter 6.2.3 “Examination – Acceptable forms of graphical representation” at 16. These criteria expand upon the principle in the UK trade-mark appeal board’s in *Ty Nant Water Ltd.’s Trade Mark Application*, [2000] R.P.C. 55 (Appointed Person), where Mr. Geoffrey Hobbs Q.C. held that a sign (such as a scent or sound) could be represented graphically, even through interpretation or analysis might be required to identify the sign.

⁴⁹ *Supra* note 42, Chapter 6.2.3.3 “Examination – Descriptions in words” at 19.

⁵⁰ *Supra* note 42, Chapter 6.2.3.8 “Examination – Smell marks” at 24.

⁵¹ *Supra* note 42, Chapter 6.63 “Examination – Smells” at 112.

Despite the U.K. Patent Offices's criteria for scent mark registration, the lack of a legally binding test for scent mark registrability combined with the vague and contradictory principles of *Hungerford* means there is no clear test for assessing the chances of a scent mark registration in the U.K. In the absence of such a test for scent mark registration, the future of scent mark registration in the United Kingdom remains uncertain.

United States of America (U.S.)

Scent marks are registrable in the United States. The first American scent mark registration was granted by the Trademark Tribunal and Appeal Board (T.T.A.B.) in the decision *In Re Celia Clarke, DBA Clarke's Osewez*.^{52,53} The mark asserted by the applicant in *Clarke* was "a high impact, fresh, floral fragrance reminiscent of Plumeria blossoms"⁵⁴ for use with sewing thread and embroidery yarn. The T.T.A.B. held that there was no reason to bar the scent mark's registration as the scent functioned as a trademark for the Applicant's wares as defined by the *Lanham Act*.⁵⁵ Specifically, the T.T.A.B. found: (1) the Applicant was the only person marketing scented yarns and threads; (2) fragrance was not an inherent attribute or natural characteristic of the goods but a feature supplied by the Applicant; (3) the Applicant emphasized and promoted the scent mark in advertising; and (4) the Applicant demonstrated that customers,

⁵² U.S.P.Q. 2d 1238 (1990) (T.T.A.B.) [*Clarke*].

⁵³ For a comprehensive examination of non-traditional trade-marks in the United States, see Thomas P. Arden, *Protection of Nontraditional Marks: Trademark Rights in Sounds, Scents, Colors, Motions and Product Design in the U.S.* (New York: International Trademark Association, 2000) [*Protection of Nontraditional Marks*].

⁵⁴ *Supra* note 52. The scent mark's registration (Reg. No. 1,639,128) was cancelled in 1997 for failure to file a s. 8 declaration of use under the American *Trademark Act*, 15 U.S.C. 1127 (*Lanham Act*).

⁵⁵ Section 45 of the *Lanham Act*, *ibid.*, defines "trademark" as any word, name, symbol or device, or any combination thereof which identifies and distinguishes a person's goods (including unique products) from those manufactured or sold by others and indicates the goods' source, even if that source is unknown. The T.T.A.B. in *Clarke*, *supra* note 52 at n. 5, observed that its conclusion that scent marks were not precluded from trademark registration was in line with the 1987 recommendations of the Trademark Review Commission of the United States Trademark Association. The United States Trademark Association Trademark Review Commission Report and Recommendations to USTA President and Board of Directors, (1987) 77 T.M.R. 375 at 421.

dealers and distributors of her products had come to recognize the Applicant as the source of these goods.⁵⁶

The importance of *Clarke* extends beyond its significance as granting the first U.S. scent mark registration.⁵⁷ First, the T.T.A.B. explicitly recognized that scents can function as trade-marks under American trade-mark law.⁵⁸ Second, the T.T.A.B. reiterated the principle in American trade-mark law that the fragrances of products noted for their fragrant features are not registrable.⁵⁹⁶⁰ Third, the T.T.A.B. implicitly established in *Clarke* criteria for registrability of scent marks in the U.S. This test contains four elements: (1) does the scent mark distinguish the Applicant's wares from competing goods⁶¹? (2) is the scent an inherent attribute or natural characteristic of the goods to which it is applied⁶²? (3) has the mark been used by the Applicant in advertising and promotion of the wares⁶³? and (4) has the Applicant demonstrated that those who regularly encounter the wares to which the scent is applied come to associate the Applicant as the source of those goods by the scent mark?⁶⁴ While the T.T.A.B. in *Clarke* did not explicitly specify whether scent marks must be distinctive to be registrable, to not hold scent marks to the

⁵⁶ *Supra* note 52 at 1239.

⁵⁷ A search of the U.S. Patent and Trademark Office's trademark database on February 4, 2003 found five active scent mark registrations: Reg. No. 2,560,618 (the scent of bubble gum used for oil based metal cutting fluid and oil based metal removing fluid for industrial metal working), Reg. No. 2,644,707 ("a fragrance intended to evoke the scent of various orchard fruits" applied as "fragrances sold as an integral component of preparations for cleaning, polishing, moisturizing, and protecting furniture, paneling, wood and other hard surfaces", and three scent marks associated with lubricants and motor fuels for land vehicles, aircraft and watercraft (Reg. No. 2,596,156, strawberry; Reg. No. 2,568,512, grape; and Reg. No. 2,463,044, cherry). Trademark Electronic Search System (TESS), online: United States Patent and Trademark Office (USPTO) <<http://www.uspto.gov/main/trademarks.htm>>.

⁵⁸ *Supra* note 52 at 1239.

⁵⁹ *Supra* note 52 at n. 4.

⁶⁰ See *In re Gyulay*, 3 U.S.P.Q. 2d 1009 (1987).

⁶¹ This applies the definition of "trademark" defined by s. 45 of the *Lanham Act*.

⁶² While the T.T.A.B. noted that the scent used in *Clarke* was not an inherent attribute of the products to which the mark was applied, Arden, *supra* note 53, observes that other non-traditional marks have been registered in the U.S. that reflect an inherent characteristic of the corresponding wares, e.g. the exhaust sound of motorcycles in use, the sound emitted by a radiation detection device in use, and a water stream design made by jet ski engines when a jet ski is operating. See *Protection of Nontraditional Marks*, *supra* note 53 at 11.

⁶³ This resembles the "use in commerce" definition of the *Lanham Act*, s. 45.

⁶⁴ This element of the test again applies the definition of "trademark" outlined in s. 45 of the *Lanham Act*.

same distinctiveness standard required of other trademarks contrary to the definition of “trademark” contained within in the *Lantham Act*⁶⁵ and followed by the T.T.A.B. in *Clarke*.

Clarke elucidates the principle it is acceptable practice describe a scent mark in words when seeking an American scent mark registrations.⁶⁶ The *Trademark Manual of Examining Procedure* states trade-mark applicants are not required to submit a drawing of the mark if the mark consists solely of a non-visual mark such as scent or sound.⁶⁷ Instead, applicants should submit a detailed written description which clearly describes the non-visual mark.

iii. Countries where scent mark registrability remains undetermined

Canada

The Canadian *Trade-Marks Act*⁶⁸ includes under the definition of “trade-mark” marks that are used by a person for the purpose of distinguishing or so as to distinguish wares or services manufactured, sold, leased, hired or performed by said person from those manufactured, sold, leased, hired or performed by others.⁶⁹ However, the statute does not define whether a “mark” for the purposes of a trade-mark is limited to visual representations, or could include non-visual marks such as scent marks. It is therefore uncertain at first glance whether scent marks are registrable in Canada.

While scent marks are not explicitly contemplated in the *Trade-Marks Act*, an analysis of Canadian law indicates that scent marks are potentially registrable as trade-marks in Canada.⁷⁰

⁶⁵ *Supra* note 55.

⁶⁶ *Supra* note 52 at n.6. The TTAB pithily observed “the era of ‘scratch and sniff’ [trade-mark] registrations is not yet upon us”.

⁶⁷ *Trademark Manual of Examining Procedure* (2002) WLTMEP3d 807.11 (WL).

⁶⁸ R.S.C. 1985, c. T-13.

⁶⁹ *Ibid.*, s. 2.

⁷⁰ For an alternative perspective, compare Susan King, “Are Sounds and Scents Trade-marks in Canada?” (1992) 1 *Bus. & Law* 6-7.

First, scent marks are not explicitly prohibited from trade-mark registration in Canada.⁷¹ Second, one can use dictionaries to interpret the meaning of “mark” used in the *Trade-marks Act*’s definition of trade-mark. According to the *Oxford English Dictionary*, a mark is “an indicator, quality, occurrence, etc. indicative of something; a distinctive or distinguishing feature or characteristic”.⁷² Using this definition, it could be argued that the occurrence of a scent wafting from a product indicates trade source and therefore constitutes a mark, if the use of a particular scent mark used on that product distinguishes the product in the marketplace. Alternately, one could argue that a scent that is a distinctive or distinguishing feature of a particular ware also constitutes a mark. As either argument would fall within the definition of trade-mark under the Canadian legislation, a scent mark could possibly be registered in Canada if all remaining registration requirements are satisfied.

Despite the absence of an express prohibition against scent mark registration, and a favourable interpretation of the term “trade-mark” as defined in Canadian legislation, those seeking to register scent marks in Canada may still struggle in securing a scent-mark registration. The first barrier is *Playboy Enterprises Inc. v. Germain*⁷³ which interprets the meaning of “trade-mark” and use of marks under Canadian legislation. The second problem is whether scent marks may be considered clearly descriptive or deceptively misdescriptive, a barrier to trade-mark registration under the *Trade-marks Act* s. 12(1)(b).

The Federal Court’s decision in *Playboy Enterprises* potentially frustrates a Canadian scent mark registration two ways. First, *Playboy Enterprises* unambiguously states that marks “...must be

⁷¹ *Supra* note 68, s. 9.

⁷² *The Oxford English Dictionary*, 2d ed., s.v. “mark”, online: Oxford English Dictionary Online <<http://dictionary.oed.com>>.

something that can be as something that can be represented visually”.⁷⁴ Second, the court ruled in *Playboy Enterprises* in order for a mark to be considered used in association with wares, per the *Trade-marks Act* s. 4⁷⁵, the mark must be a visual indication of source.⁷⁶ Thus, it appears that *Playboy Enterprises* precludes the registration of all non-visual marks in Canada, including scent marks.⁷⁷

The second barrier to scent mark registration in Canada is whether such marks can be construed as clearly descriptive or deceptively misdescriptive of the character or quality of the wares associated with the mark.⁷⁸ For example, a scent mark that utilizes a scent associated with the wares employing the mark could be viewed by a trade-mark examiner as descriptive of the wares associated with the mark (e.g. a lemon scent mark applied to a container of lemon juice). Similarly, the use of a scent mark for wares that are not normally associated with the mark’s fragrance could be construed as deceptively misdescriptive (e.g. the same lemon scent mark applied to a container whose contents are another citrus juice such as lime or orange).

The impediments that *Playboy Enterprises* and the *Trade-marks Act* s. 12(1)(b) present to Canadian scent mark registrations can be refuted by distinguishing both the case and statute from

⁷³ (1987) CarswellNat 680, 15 C.I.P.R. 24, (*sub nom. Playboy Enterprises Inc. v. Germain (No. 1)*) 16 C.P.R. (3d) 517, 13 F.T.R. 178 (F.C. T.D.) [*Playboy Enterprises*].

⁷⁴ *Supra* note 73 at ¶10.

⁷⁵ s. 4(1) states: “A trade-mark is deemed to be used in association with wares if, at the time of the transfer of the property in or possession of the wares, in the normal course of trade, it is marked on the wares themselves or on the packages in which they are distributed or it is in any other manner so associated with the wares that notice of the association is then given to the person to whom the property or possession is transferred”.

⁷⁶ *Supra* note 73 at ¶13. The judgment reads: “Therefore, in order to be deemed to be used in association with wares, at the time of transfer of the property in or possession of such wares, the trade mark must be something that can be seen, whether it is marked on the wares themselves or on the packages in which they are distributed, or whether it is in any other manner so associated with the wares that notice of the association is then given to the person to whom the property or possession is transferred”.

⁷⁷ It should be noted that following the *Playboy Enterprises* decision, the first sound mark registration in Canada (TMA 359318) was issued in 1989. Trade-marks Database, online: Canadian Intellectual Property Association (CIPO) <<http://www.cipo.gc.ca>>.

⁷⁸ *Supra* note 68, s. 12(1)(b).

the particular scent mark registration being sought. The facts in *Playboy Enterprises* can be distinguished from most instances of scent mark use, as the word mark at issue in *Playboy Enterprises* was not applied to the wares; the registrant verbally used the mark when showing the wares to customers and purchasers, identifying the individual wares as “‘Playboy’ hair piece[s]”.⁷⁹ How the mark was used in *Playboy Enterprises* contrasts with instances where a scent mark is applied to the goods and the goods are packaged in a manner that a purchaser would notice the scent mark when buying the product.

Playboy Enterprises is also problematic in that the court, when developing its definition for “mark”, relied on the 1931 decision *Wrights’ Rope Ltd. v. Broderick & Bascom Rope Co.*⁸⁰ which defined “mark” using a dictionary contemporary to that era.⁸¹ While it is appropriate for the courts to refer to dictionaries to determine the meaning of words and the use to which the object denoting the word is commonly put⁸², it should be noted that dictionaries and other reference books do not always reflect the true meanings of words⁸³, particularly when the reference sources in question are over 50 years old. As Canadian courts have ruled that dictionaries are to serve as guides only and may be sometimes inadequate⁸⁴, the inadequacy of a dictionary to convey a contemporary meaning of a word must be taken into account when a meaning or use for that word has developed since the dictionary was compiled. This principle applies when defining the word “mark”, as there now exist non-traditional marks such as scent,

⁷⁹ *Supra* note 73 at ¶9.

⁸⁰ [1931] Ex. C.R. 143 at ¶4-5 [*Wrights’ Rope*].

⁸¹ *Supra* note 73 at ¶11.

⁸² *Aladdin Industries Inc. v. Canadian Thermos Products Ltd. and Registrar of Trade Marks*, [1969] 57 C.P.R. 230 at ¶244 (Ex. Ct.) [*Aladdin Industries*]. See also *Coca-Cola Co. of Canada Ltd. v. Pepsi-Cola Co. of Canada Ltd.*, [1942] 1 C.P.R. 293 at 299.

⁸³ *Aladdin Industries, ibid.*

⁸⁴ *Bagagerie S.A. v. Bagagerie Willy Ltée.*, [1992] 45 C.P.R. (3d) 503 at ¶38 (F.C.A.). See also *Café Supreme F et P Ltée. v. Registrar of Trade-marks* [1984], 4 C.P.R. (3d) 529 (F.C. T.D.). See further *Aladdin Industries, supra* note 82.

sound and colour which are relatively recent trade-mark innovations⁸⁵ that did not exist at the time of the *Wrights' Rope* decision. Further, non-visual marks (i.e. sounds) have been registered by the Canadian trade-mark authority.⁸⁶ It is thus inappropriate to rely on jurisprudence that defines trade-marks as exclusively visual when such a definition is outdated.

Scent mark registration may not be automatically barred on the basis that the scent is clearly descriptive or deceptively misdescriptive of the character or quality of the wares associated with the mark. For a mark to be objectionable as clearly descriptive of wares under s. 12(1)(b), the mark must be: (1) clearly descriptive, and not merely suggestive, of the wares associated with the mark; and (2) material to the composition of the wares.⁸⁷ For a mark to be deceptively misdescriptive, the mark must relate “to the composition of the goods or falsely or erroneously [describe] something which is material or purport to qualify something as material to the composition of the goods”.⁸⁸

Despite evidence that the *Playboy Enterprises* definition of “mark” is outdated, and the fact that a scent mark may not be clearly descriptive or deceptively misdescriptive of the wares and services an applicant wishes to associate with the mark, the method of protecting scent mark rights in Canada via registration of a proposed mark is likely to be fraught with difficulties because of *Playboy Enterprises* and s. 12(1)(b). To avoid the time and expense of appealing a

⁸⁵ According to the U.K. Patent Office, the marking of goods to distinguish them from those of other traders originated in ancient times. The *Oxford English Dictionary* indicates that trademarks have been used since at least 1571, while the U.K. Patent Office states the concept of a mark being distinctive of a trader's good and thus attracting valuable good will developed in the 19th C. *The Oxford English Dictionary*, 2d ed., s.v. “trademark”, online: Oxford English Dictionary Online <<http://dictionary.oed.com>>. “A brief history of trade marks”, online: U.K. Patent Office <www.patent.gov.uk/tm/history/index.htm>.

⁸⁶ *Supra* note 77.

⁸⁷ *Provenzano v. Registrar of Trade Marks*, [1977] 37 C.P.R. (2d) 189 [*Provenzano*]. See also *Thermogene Co. Ltd. v. La Compagnie Chimique de Produits de France Ltée*, [1926] Ex. C.R. 114 at 118. See further *Deputy Attorney General of Canada v. Jantzen of Canada Ltd.* [1965] 1 Ex. C.R. 227.

⁸⁸ *Provenzano*, *ibid.* at 189-190.

trade-mark examiner's rejection of a scent proposed scent mark, there are two alternative strategies that, while untested, could result in a Canadian scent mark registration.

The first strategy is for non-Canadian applicants resident in countries which allow scent mark registration to register the scent mark in their home jurisdiction prior to submitting a Canadian application to register the scent mark under s. 14(1) of the *Trade-marks Act*. To ensure a successful registration of a foreign scent mark in Canada, the foreign registration must meet two requirements in addition to those enumerated under s. 14(1).⁸⁹ Specifically, the foreign trademark registration on which the Canadian application relies must (1) exist at least until the date upon which registration is granted in Canada⁹⁰, and (2) have been duly completed – i.e. the mark in the foreign registration must have been properly registered according to rules and procedures of the foreign trade-mark registry.⁹¹

The second strategy utilizes s. 12(2) of the *Trade-marks Act* to register a scent mark, that otherwise would be disqualified from registration by s. 12(1)(b), which has been used by the applicant or the applicant's predecessor in title such that the mark has been become distinctive when the trade-mark application is filed.⁹² To become registered under s. 12(2), the mark must be distinctive (i.e. actually distinguish the wares or services associated with the mark from

⁸⁹ s.14(1) of the *Trade-marks Act* reads: "Notwithstanding section 12, a trade-mark that the applicant or the applicant's predecessor in title has caused to be duly registered in or for the country of origin of the applicant is registrable if, in Canada,

(a) it is not confusing with a registered trade-mark;

(b) it is not without distinctive character, having regard to all the circumstances of the cases including the length of time during which it has been used in any country;

(c) it is not contrary to morality or public order or of such a nature as to deceive the public;

(d) it is not a trade-mark of which the adoption is prohibited by s. 9 or 10.

⁹⁰ *W.R. Grace & Co. v. Union Carbide Corp. et al.*, [1987] 14 C.P.R. (3d) 337 at 345 (F.C.A.) [*W.R. Grace*].

⁹¹ *Ibid.* at 345-346.

⁹² The material date for determination of distinctiveness under s. 12(2) is the date when the trade-mark application is filed. See *Carling Breweries Ltd. v. Molson Companies Ltd. et al.*, [1984] 1 C.P.R. (3d) 191 at 195 (F.C. T.D.).

competing wares and services⁹³). The applicant must also provide evidence detailing (1) how long the mark has been used in Canada and (2) the extent to which the mark has been used in Canada.⁹⁴ The applicant may be required to furnish any other evidence the Registrar requires to evaluate the applicant's s. 12(2) registration.⁹⁵

While a trade-mark registration via s. 12(2) registration does provide a possible means of securing a scent mark registration in Canada, there are two potential drawbacks to this type of registration. First, in the absence of a registration, the applicant's competitors may copy the scent mark thus rendering the mark indistinct. While the applicant could initiate a passing-off claim against the competitors, whether the applicant would win would depend on the particulars of the case. Further, the applicant would have to wait until the passing-off action was concluded before filing a s. 12(2) registration, thereby delaying the registration process. The second drawback is a registration under s. 12(2) can be restricted to defined territorial areas of Canada if the evidence supplied by the applicant under s. 32(1) indicates that the mark is not distinctive nationally.⁹⁶ Therefore, unless the wares and/or services associated with the scent mark have a national presence, the applicant may not receive national protection for his/her scent mark.

Japan

The current Japanese *Trademark Law*⁹⁷ defines a "trademark" as "characters, figures, signs, three-dimensional shapes or any combination thereof, or any combination thereof with colors".⁹⁸

While the Japanese trade-mark statute does not define what a "sign" is, interpreting the meaning

⁹³ *Supra* note 68, s.2.

⁹⁴ *Supra* note 68, s. 32(1).

⁹⁵ *Supra* note 68, s. 32(1).

⁹⁶ *Supra* note 68, s. 32(2).

⁹⁷ *Trademark Law*, online: Japan Patent Office (JPO) < <http://www.jpo.go.jp>>.

⁹⁸ *Ibid.*, Article 2(1).

of “sign” using dictionary definitions⁹⁹ indicates that it possible that a sign, when conceptualized as a non-traditional trade-mark such as scent, could include non-visual marks. Further, the statute does not state that trade-mark registration under the Japan *Trademark Law* is limited to only visual marks¹⁰⁰, or nor is the registration of non-visual marks barred by statute.¹⁰¹ Accordingly, it may be possible to obtain trade-mark registration for scent marks in Japan if all of the registration requirements are satisfied.¹⁰²

III. A critique of scents as trade-marks

While scent marks appear to be an innovative way to distinguish goods and services, there is a strong case against the ability of scents to function as reliable indications of trade source. Scientific research on the human sense of smell indicates the highly subjective nature of odour perception undermines the ability of scents to act as objective and reliable indications of source. This not only prevents scents from functioning as trade-marks,¹⁰³ but also subverts reliable judicial administration. Universal preferences for certain scents¹⁰⁴ will also deplete the limited number of desirable scents available for scent marks, resulting in scent mark depletion.

⁹⁹ *The American Heritage® Dictionary of the English Language* defines “sign” as “[s]omething that suggests the presence or existence of a fact, condition or quality; an outward indication of the existence or presence of something not immediately evident”. *The American Heritage® Dictionary of the English Language*, 4th ed., s.v. “sign”, online: yourDictionary.com <www.yourdictionary.com>. *The Oxford English Dictionary* defines “sign” as “[a] mark or device having some special meaning or import attached to it, or serving to distinguish the thing on which it is put; a token or indication (visible or otherwise) of some fact, quality, etc.”. *The Oxford English Dictionary*, 2d ed., s.v. “sign”, online: Oxford English Dictionary Online <http://dictionary.oed.com>.

¹⁰⁰ *Supra* note 97, Article 3.

¹⁰¹ *Supra* note 97, Article 4.

¹⁰² This is a change from the previous Japanese trademark legislation. Previously, only written trade-marks were registrable in Japan; non-traditional marks such as scents, sounds and tastes were not registrable. See *Trademarks throughout the World*, *supra* note 7 at J-8 to J-9.

¹⁰³ *Contra* Faye M. Hammersley, “The Smell of Success: Trade Dress Protection for Scent Marks” (1998) 2 Marq. Intell. Prop. L. Rev 105. See also James E. Hawes, “Fragrances as Trademarks” (1989) 79 T.M.R. 134. See further Moon-Ki Chai, “Protection of Fragrances under the Post-sale Confusion Doctrine” (1990) 80 T.M.R. 368. For a comprehensive critique of scent marks, particularly applied to American law, see Bettina Elias, “Do Scents Signify Source? An Argument against Trademark Protection for Fragrances” (1992) 82 T.M.R. 475. For an American legal perspective on potential problems arising from scent marks, see Lee B. Burgunder, “Trademark Protection of Smells: Sense or Nonsense” (1991) 29 Am. Bus. L.J. 459.

¹⁰⁴ Piet Vroon, *Smell: The Secret Seducer*, trans. by Anton van Amerongen & Hans de Vries (Farrar, Straus & Giroux: New York, 1997) at 87.

1. Scents are too subjective to function as trade-marks

A trade-mark's function is to act as an indicator of source for goods and services. Thus the function of a trade-mark is objective – either the mark functions as an indication of a particular source or it does not. Unfortunately for scent marks and the legal systems they populate, the human sense of smell is not objective but instead very subjective. Some individuals have a keener sense of smell than others.¹⁰⁵ How a human perceives an odour is dependent on many factors¹⁰⁶ such as age¹⁰⁷, sex¹⁰⁸, environment¹⁰⁹ (e.g. whether the person smokes, their exposure to environmental toxins), hormonal cycling,¹¹⁰ health (e.g. disease¹¹¹, whether one takes medications that affect the sense of smell¹¹², pregnancy, dementia¹¹³, hormonal disorders¹¹⁴). Cultural background may also impact scent perception.¹¹⁵ Even when one of the factors affecting smell is controlled, there is still great individual variation in how odours are perceived.¹¹⁶

¹⁰⁵ W.S. Cain & J.F. Gent, “Olfactory Sensitivity: Reliability, Generality, and Association with Aging”, (1991) 17 J. Exp. Psych.: Human Perception and Performance 382.

¹⁰⁶ For general overview of the human sense of smell, see *supra* note 104.

¹⁰⁷ *Supra* note 104 at 75-81.

¹⁰⁸ Olfaction research employing identical male twins and female twins has reinforced previous findings that females more accurately identify odours than males. See Nancy L. Segal, “Twin Research on Olfactory Characteristics” in Avery N. Gilbert, ed., *Compendium of Olfactory Research Supplement. Explorations in Aroma-Chology: Investigating the Sense of Smell and Human Response to Odors 1982- 1994* (Dubruque, Iowa: Kendall/Hunt Publishing, 1995) at 27. See also R.L. Doty *et al.*, “Sex Differences in Odor Identification Ability: A Cross-Cultural Analysis” (1985) 23 *Neuropsychologia* 667. See further *supra* note 104 at 83-86.

¹⁰⁹ *Supra* note 104 at 81-83.

¹¹⁰ R.G. Mair *et al.*, “Olfactory Sensitivity during the Menstrual Cycle” (1978) 2 *Sensory Processes* 90.

¹¹¹ *Supra* note 104 at 175.

¹¹² *Supra* note 104 at 175.

¹¹³ *Supra* note 104 at 178.

¹¹⁴ *Supra* note 104 at 177.

¹¹⁵ Saho Ayabe-Kanamura *et al.*, “Differences and Similarities in the Perception of Everyday Odors: A Japanese-German Cross-Cultural Study” (1998) 855 *Annals of N.Y. Academy of Sciences* 694.

¹¹⁶ Elderly individuals are less able to detect weak odours, rate detectable odours as less intense and show defects in odour identification. Research on whether age-related olfactory loss is uniform across different smells concluded that there is individual variation in how the perception of specific odorants declines with age. See Marcia Levin Pelchat, “Is Age-Related Olfactory Loss Uniform Among Odorants?”, in Tyler S. Long, ed., *Compendium of Olfactory Research Supplement. Explorations in Aroma-Chology: Investigating the Sense of Smell and Human Response to Odors 1995-2000* (Dubruque, Iowa: Kendall/Hunt Publishing, 2001) [*Compendium of Olfactory Research*] at 3, 7, and 11.

Proponents of scent marks as reliable source indications often base their arguments on claims that odours provide the strongest memory cues.^{117, 118} Such arguments are undermined by research which compares odour-elicited memories to other memory experiences. Odours, and by extension scent marks, “...do not trigger more accurate memories than those triggered by any other sensory stimuli.”¹¹⁹ However, odour-triggered memories are more emotionally charged than memories stimulated by audio or visual stimuli.¹²⁰ Separate research indicates memories triggered by odours are thought of and talked about less than memories evoked by words and pictures.¹²¹ The case for reliance on traditional visual trade-marks is further strengthened by observations that visual-based memory is more reliable than scent based memory.¹²² The sum of the research on odour-triggered memories and accurate memory recollection indicates that odours are not superior memory cues if “superiority is based on a cue’s ability to elicit more accurate recollections”.¹²³

Arguments for scent marks ability to function as a reliable cue for trade source are further countered by the repeated and demonstrated difficulty of human identification of odours.¹²⁴ Even

¹¹⁷ See Hammersley, *supra* note 103 at 128. See also Dawes, *supra* note 103.

¹¹⁸ This draws on the Proustian phenomenon, so-called because Marcel Proust in his autobiography *The Remembrance of Things Past* described the how the aroma from dipping a madeleine biscuit into linden tea evoked a long forgotten memory.

¹¹⁹ Rachel S. Herz, “How Odor-Evoked Memories Differ from Other Memory Experiences: Experimental Investigations into the Proustian Phenomenon”, in *Compendium of Olfactory Research II*, *supra* note 116 at 35. It has been observed that exact odor identification is often elusive, resulting in what has been termed the “tip of the nose” phenomenon. See H.T. Lawless & T. Engen, “Associations to odors: Interference, memories, and verbal labeling” (1977) 3 J. Exp. Psychol: Human Learn Mem 52. For a general overview of odor memory, see Trygg Engen, *Odor Sensation and Memory* (New York: Praeger, 1991).

¹²⁰ Herz, *Compendium of Olfactory Research II*, *supra* note 116 at 35.

¹²¹ D.C. Rubin, E. Groth and D.J. Goldsmith, “Olfactory Cueing of Autobiographical Memory” (1984) 97 Am. J. Psych. 493.

¹²² See Elias, *supra* note 103 at 481.

¹²³ Herz, *Compendium of Olfactory Research II*, *supra* note 116 at 36.

¹²⁴ In various experiments, subjects can only name approximately half of the everyday items they are given to smell. For the remaining items, there is variation in how close the subjects are to identifying the actual odorant, ranging from good approximations (e.g. cherry for a strawberry odorant) to poor ones (e.g. identifying a strawberry smell as

when odours are correctly identified, there is a chance that the person identifying the odour will describe the smell in terms that are different from the classification system used to evaluate test subject's accuracy, distorting measures of odour identification accuracy.¹²⁵ The common difficulty of humans in identifying odours would also lead to problems in communicating scent marks on the trade-mark register.

The subjectivity of human smell renders scents ineffective as trade-marks in four ways. The first reason relates to changes in scent perception as both humans and the scent mark itself age. Heterogeneous losses in scent sensitivity with age¹²⁶ present a barrier to the use of scents as an indication of trade source, as the perception of a scent, particularly a fragrance composed of many different scents, may be perceived differently by young, middle-aged, and elderly consumers.¹²⁷ The subjective nature of scent detection by the consumer undermines the ability of a scent mark to function as a consistent indication of trade source. Changes that occur over time in a scent due to diffusion of the scent's molecules would also dampen the ability of scent marks to function as reliable indicators of source. This is because the mark itself would change from the instant it is applied to the wares to the time that the consumer encounters the product. Consumers may perceive the same scent mark differently if they encounter the mark at different times after the mark has been applied to the wares.

that of soy sauce). Frank R. Schab & William S. Cain, "Memory for Odors" in D.G. Laing, R.L. Doty, & W. Breipohl, eds., *The Human Sense of Smell* (New York: Springer-Verlag, 1991) at 231.

¹²⁵ For example, perfumers' classifications for odors often prove problematic for the general population. See J. Stephan Jellinek, "Perfume Classification: A New Approach", in S. van Toller and G.H. Dodd, eds. *Fragrance: The Psychology and Biology of Perfume* (New York: Elsevier Applied Science, 1992). For a comparison of different classification systems for odorants, see Lyons, *supra* note 15.

¹²⁶ *Supra* 116 at 11.

¹²⁷ Pelchat, *supra* note 116, contemplated that middle-aged individuals might "experience an imbalanced or qualitatively different impression of a [scent] mixture than young adults", while "the very old might experience a more balanced, but distinctly weaker impression of an odour..."

The second reason why scents are ineffective as trade-marks is the inability of consumers to correctly identify a scent with a particular product. For example, if the advertising campaign for a product promotes the product's chocolate scent mark, but the consumer mistakes the scent mark for another odour such as cola, the consumer may become confused as to whether (s)he is purchasing the product advertised. In this example, the consumer will have to rely on other source identifiers, such as the product's name and maybe even traditional visual trade-marks, to correctly match the chocolate scent-mark with the product. Reliance on visual cues to confirm that the consumer is purchasing the intended item renders scents marks superfluous.

Another example where scent marks can mislead consumers is in the area of product recommendation. Imagine a scenario where a consumer A has a terrific experience with a product Y whose scent mark A detects as an apple scent. A recommends Y to consumer B, who seeks to capture A's positive experience. Unsurprisingly, given the highly subjective nature of human smell, A and B experience and label odors differently. What A detects as an apple scent, B identifies as a pear scent, and vice versa. Because of this difference in scent perception, B, going solely on A's description of Y's scent mark, buys the wrong product (product Z). Unfortunately for B, product Z is unsatisfactory. B informs A of the negative product experience. In the absence of any other trade source identifier information, A may readily conclude that the source of product Y manufactures goods of unreliable quality and ceases to buy that product.

Both of the aforementioned examples illustrate the third inadequacy of scent marks – the inability of scents to function as stand alone trade-marks. Given the subjective nature of human smell, consumers will have to rely on trade source criteria other than scent to confirm that they are recapturing the desired product experience. Because of the need for further information to

confirm that the correct product choice has been made, scent marks do not stand on their own – hence they are not “stand alone” marks. This reduces scent marks to mere promotional gimmicks, rather than a reliable system of product and trade source identification.

The fourth, and most serious, inability of scents to function as trade-marks impacts the reliability of judicial administration. The subjective nature of smell will unavoidably affect how the trier of fact perceives the evidence in a scent mark infringement case. This will result in unpredictable outcomes in scent mark litigation. While flexible, as opposed to strict, judicial administration may be more just in some instances, the highly subjective nature of scent perception means that litigants will truly be entering a lottery system when they proceed to trial for scent mark actions.¹²⁸ The end result is neither flexible nor strict judicial administration, but arbitrary results that will deleteriously impact scent mark litigation.

2. Universal scent preferences will result in scent mark depletion

Depletion theory is a doctrine that has been applied in American trade-mark law to colour trade-marks.¹²⁹ This theory operates on the principle there are a limited number of sensory devices (i.e. colour, scent or sound marks) that will be favourably perceived by consumers. Granting a trade-mark monopoly over one of the few desirable marks available “depletes” the remaining pool of desirable marks and thus adversely affects competition. However, if there are a large or even infinite number of sensory devices that will be positively received by consumers, then removing

¹²⁸ Scent marks could pose a problem particularly in jurisdictions where trade-mark litigation proceeds via jury trial. If the jury cannot reach a cohesive conclusion on the scent evidence presented at trial because of individual differences in smell perception, a mistrial will result. Repeated mistrials resulting from scent mark litigation will promote inefficiency in the legal system and waste valuable resources.

¹²⁹ For an alternative discussion of depletion and scent marks, see Burgunder, *supra* note 103.

one trade-mark out of this deeper pool via trade-mark registration does not significantly affect competition.¹³⁰

Depletion doctrine is readily applicable to scent marks as there are cross-cultural preferences and aversions to smells.¹³¹ Shared cultural scent preferences mean there are relatively few desirable scent marks to be shared among traders. Granting a scent mark registration for one of these marks will deplete the pool of desirable scent marks, reducing competition. Further, the international nature of trade-mark registration means that a scent mark registration in one country has the potential to deplete the available pool of scent marks in other countries. Given universal human preferences for certain odors, a scent mark registration in one country potentially depletes the pool of marks both nationally and internationally. This reduces competition on a local and global scale.

IV. Concluding comments: The future of scent marks

Scent marks appear to be an innovative and catchy way for traders to market their goods and services. However, an equally strong case can be made that scent marks pose a significant dilemma for trade-mark law. The difficulties in representing scent marks in trade-mark registries, the inability of scent marks to function as stand alone identifiers of trade source, the subjective nature of scent perception, and scent depletion theory ultimately combine to undermine the utility of scent as trade-mark.

The comparative analysis of trade-mark regimes at the beginning of this paper highlights that the future of scent marks is uncertain. No international treaty mandates the registration of scent

¹³⁰ Depletion theory can also be viewed in terms of proportionality – the fewer the desirable trade-marks, the less the competition. For an alternative explanation of depletion theory, see Burgunder, *supra* note 103 at 472.

¹³¹ *Supra* note 104.

marks.¹³² In fact, some treaties, such as *Trademark Law Treaty*, explicitly state the terms of the treaty do not apply to scent marks.¹³³ Regarding national laws, some jurisdictions are more tolerant of scent marks than others. For example, the Australian trade-mark statute now expressly contemplates scent mark registration¹³⁴, and jurisdictions (e.g. Japan¹³⁵) that previously forbade scent marks are now silent on the issue of registrability. The *Sieckmann* ruling has created a contradictory situation in Europe with respect to registration of scents under the European Community Mark (ECM) system.¹³⁶ ECM applicants are not barred from applying for scent registrations, but simultaneously do not have readily apparent, acceptable methods to describe scent marks on trade-mark applications. Meanwhile, there are jurisdictions whose laws are silent on the registration of scent marks, such as Canada, and a number of countries (e.g. Brazil, China and Mexico) which forbid scent mark registration.

While it is uncertain whether scent marks will become more commonplace and more widely accepted for trade-mark registration within individual jurisdictions, a lack of uniformity re scent mark registrations may have deleterious effects on national economies. For example, companies that seek scent mark registrations to promote their wares and services may migrate from jurisdictions that bar scent mark registrations to those which allow scent mark registrations (e.g. United States). The effect of such migration would ultimately depend on the efficacy of scent marks to function as indicators of trade source, which would also relate to consumer acceptance of such non-traditional marks. Because scent marks are currently very rare, it remains to be seen

¹³² See *supra* notes 1 – 6 and accompanying text.

¹³³ *Supra* note 1.

¹³⁴ *Trade Mark Act of 1995*, *supra* note 12, ss. 7, 17.

¹³⁵ See *supra* notes 97 – 102 and accompanying text.

¹³⁶ See *supra* notes 26 – 36 and accompanying text. Recall that the ECJ ruled in *Sieckmann* that scent marks are indeed registrable, but then prohibited commonly contemplated methods of communicating the scent mark on the trade-mark registrar, including chemical formula, description in words, and scent samples.

whether these marks are merely a passing marketing fad or may, in some cases, become some of the most commercially valuable marks of the future.