



Trade Mark Menu - Smells Off!

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The registrability of smells as trade marks is now in serious doubt. Late last week, the ECJ held that the current methods used to identify olfactory marks on the register did not satisfy the Directive's requirement for graphical representation. This decision runs contrary to the practice in the OHIM where half a dozen or so olfactory trade marks have been registered using forms of description now rejected by the ECJ.

Background

In the case in question, an application had been made to the German Patent and Trade Mark Office for a trade mark for various services consisting of a scent which was described as "balsamically fruity with a slight hint of cinnamon". Aside from this verbal description the application also included a description of the chemical structure of the scent as well as the actual chemical formula and a sample of it in a container – all the standard means applicants have used to describe olfactory marks in the past (with some success in the OHIM – see Comment section below). The application was refused by the Patent Office on the basis of its lack of distinctiveness.

On appeal, the German court held that, in theory, odours may be capable of being accepted in trade as an independent means of identifying an undertaking and that the mark as deposited would be capable of distinguishing the services and would not be purely descriptive of their characteristics. However, the court found that there were doubts as to whether an olfactory mark could satisfy the requirement of graphic representability. The question was referred to the ECJ.

The ECJ decision C-273/00 (*Sieckmann v Deutsches Patent- und Markenamt*)

The ECJ held that non-visual trade marks can be registered *provided* they are capable of being represented graphically "particularly by means of images, lines or characters" and provided that the representation is "clear, precise, self-contained, easily accessible, intelligible, durable and objective". However the ECJ found that these requirements were not satisfied by a chemical formula, description in words, deposit of an odour sample or by any combination of these elements.

The ECJ referred to and agreed with submissions by the UK Government that the chemical formula did not represent the odour of the chemical itself - "Upon reading the chemical formula few people will understand what product it represents and, even if they do, they may well not understand what the product smells like. Furthermore identifying the nature of the [mark] from a number of chemical formulae would cast an undue burden on those consulting the register".

Despite their rejection of the formula approach, the UK Government had submitted that a description in words could be a valid graphical representation of an odour although difficulties in making the description sufficiently clear and precise would make the circumstances in which such a representation would be acceptable very rare. However following submissions by the Commission, the ECJ concluded that subjectivity would ultimately lead to different interpretations and therefore a description in words although graphic was not sufficiently clear, precise and objective.

The sample approach was dismissed by the ECJ as not constituting a graphic representation and in any case the instability of compounds meant that no lasting olfactory impression could be lodged.

Comment

The more generous approach of the OHIM to the registration of smells as Community Trade marks in the past will now have to be reconsidered. Past registrations, which have included the smell of fresh cut grass for tennis balls, now appear doubtful. Certainly any current application for national and Community olfactory trade marks will now be in difficulties.

The ECJ has so robustly dismissed the chemical formula, written description and deposit approaches to graphic representation of olfactory marks that it is hard to imagine what method could now be found to represent such a mark given the current state of technology.

The question of whether sounds marks are registrable and if so how to provide details of them that will fulfil the "graphic representation requirement" has recently been referred to the ECJ by the Dutch Supreme Court. It will be interesting to see if sounds fair any better than smells.

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