United States: The Sweet Smell of a Successful Registration

An Update on Olfactory Marks

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Trademarks offer consumers a critical shorthand to identify and distinguish among the ever increasing range of available products. Ideally, a trademark acts as a guarantee of consistent quality, an indication of origin, and a valuable marketing and advertising tool capable of conveying an enormous amount of information about a product's character, price, quality, and general desirability without constant consumer re-education. A trademark's effectiveness derives from its ability to convey (first) and to evoke (subsequently) a wealth of information about a product with minimal space, time, and effort.

Psychologists have repeatedly confirmed that among our senses, scent offers the strongest effects on memory, far surpassing sight or sound. Anyone who has found themselves instantly transported to a long ago vacation by the slightest whiff of a fragrance caught in the breeze understands how powerful scent can be. As manufacturers struggle to differentiate themselves from the sea of messages bombarding consumers every moment of every day in every medium, olfactory marks (aka "scent marks") offer trademark owners a uniquely effective method to stand apart from the rest of the more traditional crowd.

What follows is a brief summary of the state of olfactory marks in the United States and in the European Union, and a discussion of some of the key legal issues presented by these still unique types of marks.

The State of Olfactory Marks in the U.S.

The Lanham Act uses the broadest possible terms to describe the range of items that can qualify as trademarks.[1] Although scent marks are not specifically enumerated in the Lanham Act, U.S. law recognizes that scent can function as a source identifier where it has no utilitarian function. Absent evidence that a scent mark has attained secondary meaning (an expensive feature both to establish *and* ultimately to prove), the Trademark Manual of Examining Procedure provides that scent marks are registrable on the Principal Register under Section 2(f) or on the Supplemental Register. The

amount of evidence required to establish that a scent functions as a mark is substantial.[2]

To date, the scent marks accepted for registration in the U.S. have been limited to scents commonly known and readily identifiable to the majority of the public through personal experience. The U.S. Patent and Trademark Office ("USPTO") has issued registrations for a total of five olfactory marks and has passed several additional applications to publication. In each case, the applied-for scents have consisted of a commonplace unadulterated scent immediately intelligible to the majority of the public detailed in a straightforward written description.[3] Following the *Qualitex* decision[4] (imposing the requirement of demonstrable secondary meaning), no scent mark has graduated to registration on the Principal Register.

The State of Olfactory Marks in the European Union

As in the United States, the European Union's Office for Harmonization for the Internal Market ("OHIM") recognizes that olfactory marks are eligible for trademark registration. Unlike the USPTO, however, OHIM has repeatedly grappled with the problem of clear graphical representation of olfactory marks even where the scent consists of a commonplace unadulterated scent capable of a straightforward written description. To date, this issue (as contrasted with the problem of proving secondary meaning) has presented the most significant barrier to registration of these marks before OHIM.

In 1999, the Community Trade Mark Office ("CTM") considered whether the scent of fresh cut grass could be registered as a trademark for tennis balls. Initially, the application was refused on the ground that the words "the smell of fresh cut grass" did not qualify as an adequate graphical representation of the mark capable of depiction in a shape or form as required by Article 4 of the Community Trade Mark Regulation. On appeal, the Board of Appeal decided that the scent of fresh cut grass *is* a distinct scent known to, and recognizable by, the majority of the population from experience, and thus that the mark's description was appropriate for registration. [5]

In 2001, OHIM revisited the meaning of "graphical representation" with respect to the scent of raspberries as applied to engine fuels. The registration was initially refused on the ground that the application did not contain a graphical representation of the mark nor a precise description of it. Although OHIM ultimately upheld the refusal theorizing that the application lacked the necessary distinctiveness in relation to the goods claimed, the office found that "the smell of raspberries," like "the smell of fresh cut grass," was a sufficiently well-known and distinctive scent that the description would otherwise qualify as a sufficient graphical representation eligible for CTM protection. [6]

The Advocate General for the European Court of Justice, on the other hand, has taken a far more conservative view of olfactory marks. In a decision issued November 5, 2001, the AG concluded that olfactory marks are incapable of registration until a satisfactory means of graphic representation for such marks is found.[7] The case that yielded that far-reaching proclamation concerned an application for a fragrance described as "fruity balsamic with delicate hints of cinnamon" for services in classes 35, 41, and 42. The application included a chemical formula and invited readers to sample the scent at local laboratories. Similar to the requirements in the United States, the legislation governing that application provides that to be registrable, a trademark must have a distinctive character and be capable of precise graphic representation comprehensible to those consulting the register. The AG ultimately concluded that the submittal of a scent's chemical formula, a written description, a sample, or a combination of any of the foregoing could not qualify as an acceptable form of graphical representation within the meaning of the rules. As a result of the AG's decision, even commonplace unadulterated scents (such as freshly cut grass) immediately intelligible to the majority of the public and capable of depiction in the form of a straightforward written description will be denied registration.

The Problem of Graphic Representation

The Advocate General's decision identifies one of the most limiting aspects of current protection for olfactory marks. All marks, regardless of type, must be capable of clear and unambiguous graphic

representation to allow for accurate and effective searching and clearance by the trademark office, by third party trademark owners, and, ultimately, by the courts. Other non-traditional marks such as color and sound marks have developed and widely accepted systems for identification. Color marks are referenced by an accepted color code such as the Pantone Matching System. Sound marks are generally represented by musical notations.[8] No such identification system has yet been introduced, however, for the identification of scents.

According to an April 2001 article in *News In Science*, computer-generated scent simulation technology is fully developed and currently available for widespread commercial application.[9] Presuming that olfactory marks will eventually advance beyond a single unblended everyday scent, the implications of this technology for trademark identification purposes is apparent. Assuming widespread access, the olfactory clearance process could become as easy as clicking on an icon or traveling to a link to obtain a whiff of the scent covered by each mark. Alternatively, scent descriptions could be supplemented with graphical profiles or gas chronomographs of the scent created by electronic nose technology.[10] Though the latter methods admittedly require either specialized technology or a certain level of technical skill to interpret them, the same is no less true for musical notation (i.e., the ability to read music) or color marks (access to and familiarity with the Pantone chart).

The Question of Scent Depletion

The overall number of scents of a favorable character which are intelligible to the majority of the public through a straightforward written description and suitable for product identification are, presumably, rather limited. According to this theory, the registration and/or protection of specific scents should be prohibited to avoid depletion of the supply of scents available for use by others.

If this issue sounds familiar to trademark practitioners, it should. This same argument was dissected and dismissed by the Supreme Court relative to color marks as relying upon an occasional problem to justify a blanket prohibition.[11] Yet perhaps these same concerns should have more force in the olfactory context. Pending the adoption of a widely accepted method for the graphic representation of scent, it may be the case that the number of scents available to potential trademark owners is quite restricted. The domain name quandary has aptly demonstrated the problems generated for trademark owners where insufficient options are available to "go around." At first glance, in the scent context, it seems that the functionality doctrine should offer a method to retrieve for wider use those fragrances that have evolved over time into product features necessary for competition.

The Sensory Subjectivity Issue

As we all know, sensory evaluation is often highly subjective. Perceptions of scent may vary widely according to the concentration, purity, quantity, age and temperature of the olfactant and the sensitivity, sophistication, skill and health of the receptor (i.e., customer).[12] This subjectivity explains the growing success of personalized aromatherapy. It answers how some people identify scents of vanilla, anise, apple, cranberry, oak, and pepper in a single sniff of wine and others perceive just … wine.

Arguably the issue of subjectivity should present no greater quandary for olfactory marks than do trademarks generally. The legal standards used to evaluate the similarity of words or colors are no less applicable to determinations based upon gradations of scent. Only experience (and case precedent) is lacking.

The Problem with Functionality

Scents which are neither an "inherent attribute" nor a "natural characteristic" of a product and serve no utilitarian function other than as a source identifier are protectible as trademarks. While determinations of functionality may appear straightforward in evaluating products like perfume, home fragrance products, and household cleaners, these lines of demarcation are quick to blur. What about fragrances added to toilet paper, paper napkins, or paper towels? Where would fragrance-enhanced

light bulbs, pens, or notebooks fall? Does the uniqueness of the fragrance matter in the determination? If so, what about the fragrance of freshly-laundered cotton dispersed by upscale British shirt retailer Thomas Pink through sensors in its New York, Boston, Washington, and San Francisco stores? If you learned that the stores sales increased dramatically following installation of the sensors, would your opinion favor trademark protection, or the converse?

In each of the examples provided above, fragrance is neither an inherent attribute, nor a natural characteristic of the product or service. Yet in each case, the added scent arguably increases the appeal -- the very cachet -- of the product. Does this fact render these added scents functional from a trademark perspective? These are the types of issues our courts have yet to address.

Conclusion

Despite the widely recognized effectiveness of sensory marketing techniques, the interest in olfactory marks has thus far been surprisingly slow to develop. The difficulty and expense associated with establishing secondary meaning for registration purposes is likely partly to blame for the relative dearth of olfactory applications pending before the USPTO. As manufacturers and marketers strain for new ways to distinguish their products and message from competitors, scent marks present a potentially effective new method of reaching the consumer.

Keep your eyes open (and your nose unplugged) for future developments.

[1] *See* 15 U.S.C.A. § 1125(a) (defining a trademark to include "any word, term, name, symbol, or device, or any combination thereof.")

[2] TMEP § 1202.13 (2002).

[3] U.S. Registration No. 1,639,128 issued March 1991 for "a high impact, fresh floral fragrance reminiscent of plumeria blossoms" for "sewing thread and embroidery yarn"; cancelled in 1997 under Section 8 for failure to file continued evidence of use; U.S. Registration No. 2,463,044, registered June 26, 2001on the supplemental register for a "cherry scent" for oil based metal cutting fluid and oil based metal removal fluid. U.S. Registration No .2,568,512, registered August 10, 2001 on the supplemental register for a "bubble gum scent" for lubricants and motor fuels for land vehicles. U.S. Registration No. 2,463,044, registered June 26, 001 on the supplemental register for a "grape scent" for synthetic lubricants for high performance racing and recreational vehicles. U.S. Serial No. 75/404,020, published for opposition August 11, 1998, abandoned July 6, 1999, for an "almond scent" for lubricants and motor fuels for land vehicles, aircraft, and watercraft. U.S. Serial No. 75/360,106, published for opposition July 28, 1998, abandoned April 21, 1999, for a "tutti frutti scent" for lubricants and motor fuels for land vehicles, aircraft, and watercraft. U.S. Serial No. 75/360,105, published for opposition July 28, 1998, abandoned July 6, 1999, for a "citrus scent" for lubricants and motor fuels for land vehicles, aircraft, and watercraft; U.S. Serial No. 75/788,312 for the mark ORCHARD FRUITS and a "fragrance intended to evoke the scent of various orchard fruits" for "fragrances sold as an integral component of preparations for cleaning, polishing, moisturizing, and protecting furniture, paneling, wood, and other hard surfaces."

[4] *Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159 (1995).

[5] *Vennootschap Onder Firma Senta Aromatic Marketing's Application*, February 11, 1999, case R 156/1998-2.

[6] *Myles Ltd. Application*, December 5, 2001, case R 711/1999-3.

[7] *Ralf Sieckmann v. Deutches Patent-und Markenamt*, November 5, 2001, case C-273/00.

[8] U.S. Registration No. 2,315,261, registered on February 8, 2000, for the Intel Inside tune consisting of a "five tone audio progression of the notes D Flat, D Flat, G, D Flat, and A Flat" for computer hardware and software.

[9] *See Now You Can Smell it - Online*, *News in Science*, http://www.abc.net.au/science/news/stories/s278744.htm, April 18, 2001.

[10] *See In the matter of Application No. 2,000,169 to register a trademark in class 20 in the name of John Lewis of Hungerford PLC*, at 5, *available at* http://www.patent.gov.uk.

[11] 514 U.S. at 168.

[12] *Id.*, at 17, *available at* http://www.patent.gov.uk.
