

THE SMELL OF TRADE MARKS

"Balsamically fruity with a slight hint of cinnamon" – does that smell familiar?

Is what you smell the same as what I smell? Is it distinctive and clearly identifiable? And will it smell the same next week?

These questions among others have escalated up to the European Court of Justice (ECJ) in a recent trademark case.

A trademark is a badge of origin. The ECJ recently re-iterated that the essential function of a trademark is to guarantee the identity of the marked product or service to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the product or service from others, which have another origin.

Words make up the vast majority of trademarks. For example, the title of your daily newspaper identifies its origin. Logos make another important set of trademarks, with the Shell Logo identifying the goods and services of an Anglo-Dutch oil company. More unusual trademarks exist, the shape of a Coca-Cola bottle and the musical ditty associated with the Direct Line Insurance advertisement. However, can a smell ever act as a trademark?

The European Trade Mark Directive states that a trademark may consist of 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 can distinguish the goods and services of one undertaking from those of others. The list of what constitutes a trademark is non-exhaustive. The possibility is held out that anything can act as a trademark and be registered as such. A recent ECJ case considered the question of whether a smell can act as a trademark and be registered as such.

Last December, the ECJ upheld the decision of a German national court to refuse the registration of a trademark which consisted of a smell, as used in relation to the sale of advertising services amongst other services, which in words was described as "balsamically fruity with a slight hint of cinnamon". The Applicant not only described the trademark in words, but also provided the chemical formula of the underlining composition of the smell, derived from methyl cinnamate. The Applicant also volunteered to provide a sample of the smell in a sealed container to be deposited at the German Trade Mark Office and to be held on file, so that people could "sniff" the trade mark.

The ECJ found that the definition of a trademark in the Directive is not exhaustive, and although it does not mention signs which are not in themselves capable of being perceived visually such as odours and music, the definition does not explicitly exclude these signs acting as trademarks. However, although a trademark can consist of any sign which itself cannot be perceived visually, such a sign must be capable of being represented graphically, particularly by means of images, lines or characters, and that the representation must be clear, precise, self-contained, easily accessible, intelligible, durable and objective.

Why does the ECJ place the qualification that a trademark must be represented graphically and in a clear way in order to constitute a registered trademark? In one word the answer is “certainty”. A Trade Mark Registration is a monopoly right, an incredibly strong legal weapon, giving the holder the exclusive right to use that trademark or to prevent its use and the use of similar trademarks. A viewer of the Register, usually a potential competitor, must be able to determine in a clear and certain way what the registered trademark represents. A smell can be contrasted to a tune, which can be shown graphically as a musical score.

The ECJ felt that to describe an odour in words is imbued with subjectivity, which would be interpreted differently by different people. Describing the smell in a chemical formula does not represent the odour of the chemical itself. Few people would understand what a chemical formula represents and, even if they did, may not understand what the product smells like. Furthermore, identifying the nature of the smell from a chemical formula would put undue burden on those consulting the Register. Finally, a physical sample of the smell will degrade over time. Consequently, its chemical composition and its smell will change.

Although the ECJ held out the possibility that anything can act as a trademark including a smell, given that a smell is near impossible to describe in a clear and concise manner with present technology, the possibility of registering a smell would appear to be ruled out. Until technology has advanced to “smell a trade mark out”, interested businesses may have to be satisfied with registering the words, shapes, musical ditties and logos under which they market their products and services.

February 2003

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