

Juridiska Institutionen

Examensarbete höstterminen 2017

Juristprogrammet

30 högskolepoäng

The Future of Scent as Trademarks in the European Union

*A comparative study of the challenges and possibilities for protection of
olfactory signs in the European Union and the United States*

Robin Klingberg

Handledare: Jens Andreasson

Examinator: Ulf Petrusson



UNIVERSITY OF GOTHENBURG
SCHOOL OF BUSINESS, ECONOMICS AND LAW

Abstract

The use of trademarks date back to the ancient Egypt. “Databases” of trademarks dating back to the middle ages have even been found. Trademarks was initially used to mark one’s product in trade, swords or pottery as examples, to inform customers of the source of origin. Even if today this still is the essential function of trademark, they serve several other purposes and are used in many different ways as well. They are not only used to brand a product, but also pre emptively in advertising to promote a product. As the uses and functions of trademarks have changed since ancient Egypt, different types of signs used have changed as well. Today, many would consider sound jingles or even colors per se obvious trademark choices as part of a marketing strategy. Though lurking somewhat in the shadows for at least three decades, olfactory signs have yet to reach their breakthrough.

Some brave individuals have used scents as a part of an innovative marketing strategy and in the 90’s even got legal protection for them. However, in early 21st century a judgment came down from the European Court of Justice, making future registration of olfactory signs practically impossible as it seemed, until this day. The recent trademark reform have abolished the requirement of graphical representation, removing a big obstacle for signs that are not by themselves visible. It follows that this might be the big breakthrough that olfactory signs have waited for.

This thesis aims to compare the trademark systems of EU and US, to understand how olfactory signs are handled and what challenges to protecting them exist in the EU. It starts by concluding that the fundamental differences between the two systems, user-based and register-based, make the solutions found to protecting olfactory signs not directly transplantable in the existing EU trademark system. However, some possibilites to import certain aspects of the user-based system was found, albeit, requiring amendments. Next, it demonstrates how solutions to register other unconventional signs, like a color per se or a sound, might not be suitable for olfactory signs. Finally, it is suggested that the abstract and subjective concept of a smell could make olfactory signs unsuitable for a registration-based trademark system which allows for less flexibility in its register than a use-based trademark system.

Table of Contents

1	The Usage of Olfactory Signs in Advertising.....	5
1.1	Purpose of the Thesis.....	6
1.2	Method and Delimitations	6
1.2.1	<i>Comparative Study</i>	7
1.2.2	<i>Challenges and Factors That Could Affect the Outcome</i>	9
1.3	Material.....	10
1.4	Outline	11
2	Comparative Study - Authority for Protecting Olfactory Signs.....	13
2.1	The Function of a Trademark	14
2.2	Can a Scent Function as a Trademark?	16
2.2.1	<i>Can a Scent Constitute a Sign?</i>	16
2.2.2	<i>Can a Scent Identify a Source?</i>	19
2.2.2.1	Inherently Distinctive Scents	19
2.2.2.2	Acquired Distinctiveness	22
2.2.2.3	Functionality	25
2.3	Representation of an Olfactory Mark	29
2.3.1	<i>Requirement of Samples and of Actual Use</i>	35
3	Findings and Discussion.....	38
3.1	Challenges to Protecting Olfactory Signs in the EU	38
3.1.1	<i>Representation</i>	39
3.1.2	<i>The Guidelines</i>	39
3.1.3	<i>Legal Principles</i>	40
3.2	Possible Solutions Found in the US	41
3.2.1	<i>Description in Words</i>	42
3.2.2	<i>Deposited Sample</i>	43
3.2.3	<i>Considerations Comparative Study</i>	44
3.3	Possible Solutions Found with Other Unconventional Signs.....	45
3.3.1	<i>Colors</i>	45
3.3.2	<i>Sounds</i>	46
3.3.3	<i>The Subjective Nature of a Trademark</i>	47
4	Conclusions	49

Abbreviations

7th Cir. - United States Court of Appeals for the Seventh Circuit.

C.F.R. – Code of Federal Regulation.

CJEU – Court of Justice of the European Union.

Cust. & Pat. App. – Court of Customs and Patent Appeals.

ECG – European General Court.

ECJ – European Court of Justice.

EU – European Union.

EUIPO – European Union Intellectual Property Office.

EUTM – European Trademark.

EUTMR – European Trademark Regulation.

EUTMIR – European Trademark Implementing Regulation.

F. – Federal Reporter.

FR. – Federal Register.

F. Supp. - Federal Supplement.

Fed. Cir. – United States Court of Appeals for the Federal Circuit.

GC – Gas Chromatography.

INTA – International Trademark Association.

MS – Mass Spectrometry.

OJ – Official Journal of the European Union.

OHIM - Office for Harmonization in the Internal Market, today *European Union Intellectual Property Office*.

P.L. – Public Laws.

S.D.N.Y. - The United States District Court for the Southern District of New York.

SSRN – Social Science Research Network.

Supreme Court – Supreme Court of the United States.

TMEP – Trademark Manual of Examining Procedure.

TTAB – Trademark Trial and Appeal Board.

T.T.A.B. – See TTAB.

U.S. – United States Reports. Not to be confused with *the US*, see terminology.

U.S.C.A. – United States Code Annotated.

USPTO – United States Patent and Trademark Office.

U.S.P.Q. – United States Patents Quarterly.

Terminology

The Court – This term aims at the European Court of Justice.

Sign or Symbol – A feature or badge that could indicate origin.

Scent – An objective characteristic of an object, compare smell.

Smell – The subjective sensory experience that emerges when receptors of the olfactory bulb are exposed to a scent.

Trademark or Mark - A sign or symbol that enjoys protection.

Olfactory sign – A *scent* that is distinctive in relation to the object's market and serves as a source identifier.

The Regulation – This term aims at Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark, (2017) OJ L 154/1, [cit. EUTMR], when other regulations are aimed at it will expressly be written.

The US – United States of America. Not to be confused with *U.S.*, see abbreviations.

The Office – This term aims at the European Union Intellectual Property Office.

The Guidelines – Guidelines for Examination of European Union Trademarks in the Office.

1 The Usage of Olfactory Signs in Advertising

As long as civilized men have had noses, scent has played a part in differentiating things from each other. It is said that Cleopatra VII scented the sails of her ships with perfume to add another dimension when watching her fleet arrive. A more recent example is from the beginning of the 20th century, Paris, where cigarettes were sprayed with scents to make them more attractive to women. Today the market faces different problems than Cleopatra did. Unconventional trademarks are an essential part of an innovative trademark strategy. They bear high economic value for companies when marketing their products. It is an obvious fact that the visual part of advertising is becoming more and more saturated, in the sense that we for instance do not take notice of billboards or other visual ads to the same extent as when there were fewer of them. All the visual impressions have a numbing effect on the consumer. The need for exploring other types of advertising is growing bigger. This means that the need of protection for other types of advertising is also growing bigger. In modern times, techniques for spreading fragrances on the internet or even directly to your mobile device are developed, but so far there is no *quid pro quo* in the European Union (EU). Legal protection for olfactory signs is of the utmost importance to keep this innovation going. The need is no different from that of the beginning of IP law, and the same pros and cons for protecting other types of trademarks applies to protection of olfactory signs.

Previous in EU, the smell of fresh cut grass was accepted and protected as an olfactory trademark for tennis balls.¹ A description of the scent in words fulfilled the requirement of graphical representation. That registration has expired and the development of trademark law in the EU have taken a turn for change. Some four years after the registration of the smell of fresh cut grass, Mr. Sieckmann wanted to register a sign with the German Patent and Trademark Office² but the registration was rejected and the matter was referenced to the European Court of Justice for a preliminary ruling. The questions referred to the Court regarded what signs can be protected pursuant to the Directive 89/104/EEC³, and what are the requirements for graphic representability. Luckily, the Court came to the conclusion that olfactory signs may function as trademarks. However, the requirements for graphical representation was not met by a deposited sample, a description in words, the chemical formula or a combination thereof.

¹ Decision of the Second Board of Appeal of 11 February 1999, *The smell of fresh cut grass for tennis balls*, R 156/1998-2, application No 428 870. [cit. Fresh cut grass]

² Deutsches Patent- und Markenamt.

³ Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks, (1989) OJ L 040/1.

The future for olfactory signs does not look any brighter today than what Mr. Sieckmann experienced. So, is it a waste of money and resources to use scents as a part of your market strategy? As research shows our olfactory is the sense that has the biggest impact on us, closely linked to our memories the brain accurately registers and remembers smells with 65% accuracy after a year, while visual recall is about 50% after three months.⁴ 75% of our daily experienced emotions are generated by scents.⁵ The market understanding seem to be that smells trigger memories in a much more efficient and striking way, than visual perception alone does.⁶ Therefore, it is no wonder that scents are used more and more frequently as a part of an innovative market strategy used in commerce by a wide span of actors, reaching from clothing stores like Abercrombie & Fitch to the properties of the Ritz-Carlton.

1.1 Purpose of the Thesis

The purpose of this thesis is to analyze management of olfactory signs in the European Union and compare this with an analysis of the management of olfactory signs in the United States, where registration of olfactory signs is possible. The result of this comparison will be the foundation for a discussion on challenges and possibilities for protection of olfactory signs in the European Union and provide for a better understanding on the management of olfactory signs.

1.2 Method and Delimitations

To narrow the scope of the thesis and make it less abstract, the legal analysis will be derived from an actual case; Mr. Sieckmann's attempt to register an olfactory sign. The case is the most significant regarding registrability of olfactory signs since this is where the Court formulated the seven-tier test that is the foundation for deciding if a sign is to be registered as a trademark or not. This will keep the paper on track, making it less abstract and avoid to many what ifs. In general, every section of the thesis will go from legal texts and rulings made by courts to theoretical discussions and conclusions, including the authors reflections and those of legal scholars in the field.

⁴ Bell, Stephen, Porter Bell, Coley, *Future Sense: defining brands through sense*, Market Leader: the journal of the marketing society, issue 38 (2007), pp. 60-62, p. 60. [cit. Bell & Bell 2007]

⁵ Bell and Bell 2007, p. 60.

⁶ Vlahos, James, *Scent and Sensibility*, sept. 9 2007, New York Times; "Using the power of scent to create and drive the emotional connection between costumer and brand", <http://www.scentsphere.com/scent-activation.html>; Patel, Shareena, *Scent marketing can increase perception of a brand's advertising by 19 %*, <http://www.printpower.eu/UK/Scent-Marketing-can-increase-perception-of-a-brands-advertising-by-19>.

Since Sieckmann is a relatively old case, however not obsolete, and there has been a much more recent trademark reform, the research will process past and current trademark law to highlight changes since the case that can be applied in the discussion on optional solutions for protecting olfactory signs. The thesis will apply a comparative analysis of how the European Trademark (EUTM) is managed in the EU and the management of a federal registered trademark in the US trademark system to highlight similarities and differences between the two trademark systems.

1.2.1 Comparative Study

The main reason for choosing a comparative method is because registration of olfactory signs is possible in the US trademark system. This makes the trademark system of the US an important source for understanding ways of protecting olfactory signs. The analysis, however, is not to be used as compelling arguments before a court or to justify the protection of olfactory sign. Rather, the comparative analysis is made partly to better understand the difficulties an applicant faces when applying for registration of an olfactory sign in the EU, and partly to seek solutions to these difficulties in a legal system where protection of olfactory signs is possible. The focus is to weigh different solutions and consequences against each other in the pursuit of better understanding the management of olfactory signs in the EU. This will allow for conclusions on suitability of potential solutions to be transplanted in the EU trademark system.

As Zweigert and Kötz expresses it, the only things which are comparable are those which fulfil the same function.⁷ The protection of trademark in both systems serve the purpose of protecting signs that indicate origin from a single source from being exploited by others than the rightful proprietor. This functionalistic approach of the comparison suits the research because the aim is to understand how the same problem, protecting olfactory signs used in commerce, is solved in the EU and the US respectively. The challenge is to formulate a question without the presumption of similarities in legal concepts.⁸

A relevant formulation of a research question would be *how are olfactory signs, that are used in commerce to differentiate goods and services from those of others, protected in the EU and the US?* This is the function that will be the focus of the comparison. The outcome of such research question is not dictated by on forehand determined legal concepts in one of the systems. By this formulation in mind, the thesis starts from neutral ground and allows for a

⁷ Zweigert, Konrad & Kötz, Hein (1998), *Introduction to comparative law*, 3. rev. ed., p. 34, Oxford: Clarendon. [cit. Zweigert & Kötz 1998]

⁸ Valguarnera, Filippo, *Kapitel 6: Den komparativa metoden*, p. 153, in Korling, Fredric & Zamboni, Mauro (editor) (2013), *Juridisk metodlära* (pp. 141–174), 1 ed., Lund: Studentlitteratur. [cit. Valguarnera 2013]

useful comparison, which is preferable.⁹ With this question in mind, the thesis can study the solutions in the two systems without the presence of legal concepts that potentially could disrupt the results.

According to Bogdan, it is not suitable to limit a study to a small part of the legal systems. The study must consider that identical problems may not be regulated using the same institutions in both systems.¹⁰ This gives that also legal principles and overall similarities and differences in legal concepts must be considered in both systems. For example, registration in both systems does not serve the same purpose due to the common law tradition in the US. With registration the rights are created in the EU, whilst registration only is evidence of already existing rights in the US. By taking this into account, some critique against functionalism is avoided.¹¹

The comparative study is based on US federal laws and legislation, EU legislative acts, EU and US case law, decisions of the European Union Intellectual Property Office (EUIPO) and the United States Patent and Trademark Office (USPTO). When sources are contradicting to each other, more recent sources prevail over older sources. Besides this principle, in the EU legal system the legislative acts have been valued highest, ranking the treaties of the EU first, followed by regulations and then directives. The legislative acts are followed by case law from the European Court of Justice (ECJ) then the European General Court (EGC) and lastly decisions of the EUIPO and its examining guidelines. The Code of Laws of the United States of America (USC) have been valued highest in the US legal system. Next is case law from the Supreme Court, followed by decisions of the Trademark Trial and Appeal Board (TTAB), decisions of the USPTO and then the trademark manual for examining procedures. In both systems, articles and books written by legal scholars have been used for general understanding and to substantiate conclusions made, but their legal value is secondary to the sources mentioned above. International treaties and other similar sources of international law have been excluded because they are the same in both systems and would not contribute meaningfully to the comparison. It is assumed that both trademark systems fulfill their commitments to these international treaties.

⁹ Valguarnera 2013, p. 153; Bogdan, Michael (2003), *Komparativ rättskunskap*, 2 ed., p. 57, Stockholm: Norstedts juridik. [cit. Bogdan 2003]

¹⁰ Bogdan 2003, p. 47.

¹¹ Valguarnera 2013, p. 154; Michaels, Ralf (2006), *Chapter 10: The Functional Method of Comparative Law*, p. 371, in Reimann, Mattias, & Reinhard, Zimmermann (editor) (2006), *The Oxford Handbook of Comparative Law* (pp. 339-382), New York; Oxford University Press.

For the reasoning in the EU, a teleological perspective is used, in the US, a black-letter law mindset is applied. This is because the EU has a more democratic reasoning built-in in its legislative process, making the intent of the legislator important for the application of the law. In the US, as a legal system with common law tradition, the black-letter law is a well-established principle, meaning that the law is what has been written down. This will allow the reasoning to be more free when it comes to the EU trademark system, whereas the US trademark system more strict and less open for interpretation, which is suitable to exclude externalities in the US trademark system and avoid fallacies.

This thesis will be limited to the situations applicable for olfactory signs. General differences between the two legal systems, not affecting the registration and protection of olfactory signs, will be outside the scope of the thesis. The interest of the thesis is the EU trademark system, thus any potential conclusions on how to amend the US trademark system that may be drawn from the research will be left to the reader.

As is apparent from the comparison, an olfactory sign may distinguish goods of one undertaking from those of others, thus fulfilling the essential function of a trademark. Since fulfilling the essential function of trademarks is enough for a sign to be considered a trademark, other possible functions of trademarks will be outside the scope of this thesis. This does not exclude that olfactory signs cannot fulfill other functions of trademarks, whatever they may be, that is another discussion outside the scope of the thesis.

1.2.2 Challenges and Factors That Could Affect the Outcome

A challenge is how to value case law and doctrine on trademark law in EU relating to previous provisions, given the new trademark reform package. The lack of EU case law relating to olfactory signs, means that, where relevant, analogies with case law regarding other nontraditional marks must be made to make a useful comparison between the systems. Due to the nature of the nonvisual aspect of nontraditional trademarks, they often face similar challenges. Such analogies are not unknown in case law, the Court stated that the same conditions apply for olfactory signs and sounds regarding graphical representation, due to their nonvisual nature.¹² Therefore, analogies may be fair, given a principal level of this area of trademark law.

Another challenge is to acquire correct and up-to-date knowledge of trademark law in the US. To overcome this, the author will firstly obtain an overview of the trademark system in the US

¹² Judgment of 27 November 2003, *Shield Mark*, C-283/01, EU:C:2003:641. [cit. *Shield Mark*]

by reading introductory works and articles on the subject. Secondly, the author will further read references from previous mentioned works and articles. Lastly, to acquire correct knowledge, the author will turn to reliable sources such as those published by governments. Regarding the last-mentioned source, it is important to respect the hierarchy of legal sources in the US. Bogdan mentions a common mistake made is valuing the importance of formal legislation wrong, especially between Western-continental and Anglo-American legal systems.¹³ By being aware of the differences in the importance of case law in the US and in the EU the author will avoid this common mistake.

Problems with translation might show themselves in a comparative work, both as assumptions on similarities between legal concepts as well as linguistic concepts. Bogdan mentions foreign legal terms without a Swedish equivalent, for example the English term *trust*.¹⁴ Other dangers are equality in linguistic meaning, however, the terms not being equal regarding their legal relevance, comparing *marriage* and *äktenskap*.¹⁵ To avoid this, the author will read and understand material without previous assumptions of definitions of legal concepts derived from the learned legal dictionary. Also, the author will take aid from law dictionaries.

To prioritize different arguments and giving them value in relation to each other will be a challenge. The ECJ might value arguments differently than what is made in this thesis. This is recognized and the implications of this is minimized by mimicking the same logic and rationale that the Court expresses in different cases and by taking advantage of analogies already made by the Court. Still there is a risk that the Court for example does not find the analogies and considerations made in this thesis to be adequate.

Since the study only focuses on the formal protection in the US through registration, this could have effect on the conclusions made. The practical protection is ultimately decided in opposition to registration or the enforcement of these rights in infringement proceedings. It may be that, even if registered, the scope of the protection is still difficult to identify, thus making the registration in the US a false sense of security.

1.3 Material

Besides the legislative acts, the study is mainly based on five cases. Two cases from the EU. Firstly, Sieckmann, which is a principal case regarding how to decide what signs may be

¹³ Bogdan 2003, p. 44.

¹⁴ Idem, p. 48.

¹⁵ Idem, p. 49.

registered for protection. Secondly, Ripe Strawberries, in which Sieckmann was further defined. Three cases from the US is also studied. Firstly, In re Clarke,¹⁶ which is the first ever registered olfactory, making it a principal case in which the Board clarified some aspects relating to unconventional trademarks. However, trademark law is not static. Therefore, Clarke's old registration, that even has lapsed, is accompanied by the more recent and alive registration of Grendene¹⁷ on the principal register for the bubblegum scent of sandals to understand how requirements may have changed. To understand the difference between the two registers, a third registration from the US will be studied. The registration on the supplemental register for the flowery musk scent sprayed in electronics stores by Verizon¹⁸ will serve as this comparison between the registers. This last application is a scent in relation to services, whereas the other four are for goods. Trademarks for goods and trademark for services differ in some respects, why general conclusions are made with caution and consideration to this.

However, a comparison between these two systems cannot be made in a vacuum, only considering these five mentioned cases. Therefore, to put conclusions in a bigger context or clarify some aspects further, some parts from other cases in the two systems are relevant to take into consideration. Due to the overall lack of cases regarding olfactory signs, cases regarding other unconventional trademarks facing similar problems when trying to register for protection will be included in the material. Such analogies are a commonly used method when faced with a problem that previously has not been regulated. In many of the cases regarding olfactory signs, there can be found references to other unconventional trademarks, most of the time to color marks.

1.4 Outline

The second chapter of this paper is made up of the comparative study. In 2.1 the overall function of trademarks in the two systems is studied and in 2.2 it is shown how scents are managed and how they might fit in. In section 2.3 different methods of representation, and how they are managed, are presented. In the third chapter the findings of the study are presented and discussed. In 3.1 the main challenges for registering scents as olfactory signs in the EU is discussed. First, challenges connected to the representation of an olfactory sign. Second, how

¹⁶ In Re Clarke, 17 U.S.P.Q.2d 1238 (T.T.A.B. 1990), [cit. Clarke 1990]; Celia Clarke, *The mark is a high impact, fresh, floral fragrance reminiscent of Plumeria blossom*, US application serial No 73758429, (USPTO 1988), [cit. Clarke 1988].

¹⁷ Grendene, S. A., *The mark consists of the scent of bubble gum*, US application serial No 86265443, (USPTO 2014). [cit. Grendene]

¹⁸ Celco Partnership, *The mark consists of a flowery musk scent*, US application serial No 86122975, (USPTO 2013). [cit. Verizon]

the Guidelines of the EUIPO constitutes a bar for registration. Third, how the principle of legal certainty makes up an obstacle to registering olfactory signs. The fourth chapter concludes.

2 Comparative Study - Authority for Protecting Olfactory Signs

First the comparison will be made on a general level, to get acquainted with the two trademark systems and their foundations. This is important to later be able to understand why a solution can work in one of the systems that perhaps is incompatible with the other.

The trademark system in the US is based on common law rights. The registration is only evidentiary in relation to the rights that are actually created by use of the sign in commerce.¹⁹ In contrast to this use-based trademark system, the EU has a strict registration-based system regarding the EUTM.²⁰ As this thesis will show, this fundamental difference between the systems is often the core of why issues are dealt with differently. However, despite this difference as a starting point between the two systems, they both acknowledge the opposing systems solutions as well.

To some extent, the codification of common law rights in the US has extended the rights past what can be considered common law rights. The right of incontestability²¹ and the concept of dilution²² that, according to Kenneth L., converts the trademark right to a property right which the common law never treated it as.²³ On the EU side, the Union allows for Member States to protect unregistered signs, very similar to common law rights.²⁴

The term trademark differs in definition between the two systems. Even if a trademark per se is protected in both system, a difference in what is protected as a trademark can be discerned in the two legal systems. The US system protects a sign as a trademark if it is used in commerce, is distinctive and identifies origin, which is a broader and more comprising definition than that of the European system. Except the previous requirements, the EU adds the criterion that the sign must be capable of being represented in a sufficiently clear and precise manner to be protected as a trademark.²⁵

¹⁹ Halpern, Sheldon W., Seymore, Sean B. & Port, Kenneth L. (2015), *Fundamentals of United States intellectual property law: copyright, patent, and trademark*, 5. ed., p.245, Alphen aan den Rijn: Kluwer Law International. [cit. Halpern et al. 2015]

²⁰ Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark, (2017) OJ L 154/1, art 6. [cit. The Regulation or EUTMR]

²¹ 15 U.S.C.A. §§ 1065, 1115, (Westlaw through P.L. 115-90). [cit. 15 U.S.C.A.]

²² 15 U.S.C.A. § 1125(c).

²³ Port, Kenneth L. (1994), *The Unnatural Expansion of Trademark Rights: Is a Federal Dilution Statute Necessary?*, p. 487, Seton Hall Legislative Journal, Vol. 18, pp. 434-488; William Mitchell Legal Studies Research Paper

²⁴ Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks, (2015) OJ L 336/1, recital 11.

²⁵ Judgment of 12 December 2002, *Sieckmann*, C-273/00, EU:C:2002:748. [cit. Sieckmann]

This was a simplification on what may constitute a trademark, the following sections will elaborate on these criteria, and what is expected of an olfactory sign to be protected as a trademark. The difference between what may constitute an EU trademark and what may constitute a Federal registered trademark is important because it reflects the different foundations of both systems, use-based and registration-based protection.

2.1 The Function of a Trademark

This section will explore the purpose of trademarks and dissect the concept to further understand if a scent can fit in.

The essential function of a trademark in the EU is to guarantee the origin of the goods to the consumer.²⁶ The Court have accepted other functions of a trademark as well.²⁷ Kur & Dreier means that many interests and functions are protected by trademark law but only one is essential and the others are accessory.²⁸ Even when denying protection to other functions, the trademark system is intact as long as protection is granted against the disruption of the function of indicating commercial origin.²⁹ This would conclude that the trademark system would no longer be intact if none, or even insufficient, protection is given to olfactory signs that indicate commercial origin.

Also in the US, it is considered that trademarks exist to indicate origin.³⁰ The Supreme Court stated in *Qualitex* that trademark law prevents others from copying a source identifying mark.³¹ Some argues that what may be protected under trademark law is unlimited, since courts are very likely to recognize any aspect of a product that indicates origin as a trademark.³² What is important for a trademark is its distinguishing function, which in turn eases the decision making for the consuming public.³³ Hunter means that this is the dominant approach to trademark law in the US.³⁴

²⁶ EUTMR, recital 11. The provision uses the words *in particular*. However, settled case law refers to this function as the essential.

²⁷ Judgment of 18 June 2009, *L'Oréal and Others*, C-487/07, paras 58, 65, EU:C:2009:378.

²⁸ Kur, Annette & Dreier, Thomas K. (2013), *European intellectual property law: text, cases and materials*, p. 201, Cheltenham: Edward Elgar. [cit. Kur & Dreier 2013]; see also, Judgment of 23 May 1978, *Hoffman-La Roche v Centrafarm*, C-102/77, para 7, EU:C:1978:108; Judgment of 29 September 1998, *Canon*, C-39/97, para 28, EU:C:1998:442.

²⁹ Kur & Dreier 2013, p. 201.

³⁰ 15 U.S.C. § 1127.

³¹ *Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159, 163-164 (1995). [cit. *Qualitex*]

³² Halpern et al. 2015, p. 260.

³³ Hunter, Dan (2012), *Intellectual property [Electronic resource]*, p. 141, New York: Oxford University Press. [cit. Hunter 2012]

³⁴ Hunter refers to *Scandia Down Corp. v. Euroquilt, Inc.*, 772 F.2d 1423, 1429 (7th Cir. 1985). "Trademarks help consumers to select goods. By identifying the source of the goods, they convey valuable information to consumers

It is obvious that trademarks can benefit both proprietor and consumer. However, the same legal guarantee is not apparent in the EU as in the US for the consumer to trust the quality of the goods that is branded with the trademark. So-called naked licensing, when a licensor is not policing the quality of the goods branded, is not allowed in US and quality control is a legal requirement for a proprietor to keep its rights in a trademark.³⁵ This is not existent in the EU, making it possible to keep trademark rights even if a licensee uses the trademark on goods with considerably lower quality than what a consumer might have come to expect from that trademark.

Considerations

What is concluded from the research made is that the essential function of trademarks is the same in both legal systems. Further it can be concluded that the base for the essential function is in both system consumer protection in some way. Trademarks enable the consuming public, without the possibility of confusion, to distinguish a product from products which have another origin. When a sign indicates origin, even if that sign is an olfactory sign, it would be of the utmost importance to protect it sufficiently to keep the trademark system intact.

Even if the essential function of a trademark is the same in both systems, a slight difference in justification of that function can be seen. Where in the US a strong consumer protection idea can be seen present in trademark law, in the EU this is absent. The research did show other functions for trademarks in the EU. However, none where consumer protection was directly apparent, only visible as a downstream consequence of other functions. The consumer seems to be used as an indicator for the proprietor to know if its rights in a trademark have been infringed, by applying a likelihood of confusion test for example.

The further effect of consumer protection being more important in the US is uncertain. The reason for not regulating this in the EU is also uncertain. A possible explanation for the absent regulation might be differences in perspective regarding what the market itself might regulate. It can be argued that naked licensing is not necessary to regulate, since a licensor will lose goodwill in his trademark if the quality of the goods branded with the mark is lower, thus, naked licensing is not an attractive business opportunity. Yet, it is regulated in the US and one might assume that it is so for a reason. Further study is needed, but for the sake of this thesis it is

at lower costs. Easily identified trademarks reduce the costs consumers incur in searching for what they desire, and the lower the costs of search the more competitive the market.”.

³⁵ 15 U.S.C.A. § 1127.

important to highlight that this is a difference in underlying principles of trademark protection that might affect the tendency to protect olfactory signs.

2.2 Can a Scent Function as a Trademark?

The following section seeks to establish if a scent can be considered to function as a trademark. If not, then there is no need to further investigate why scents are not registered, the question is answered by scents not fulfilling the function of trademarks; an absolute ground for refusal.³⁶

By investigating if there is room in the legislation of the two legal systems to consider scents and protect them as trademarks, the following sections will elaborate on how olfactory signs fulfill the different requirements of being a *sign* that fulfills the *essential function* of a trademark, namely *identifying* source origin and *distinguishing* goods of one undertaking from those of others. A comparison will be made between the different views of scents as trademarks. As will be apparent, the requirements differ between the two legal systems.

2.2.1 Can a Scent Constitute a Sign?

The provision on what may constitute an EU trademark refers to *any sign*.³⁷ The Regulation lists potential signs in its article 4; this list is preceded by the term *in particular* which indicates that these are examples and that the list is not exhaustive.³⁸ This conclusion was made regarding the predecessor to the current Regulation. However, even if colors and sounds were added as examples of trademarks, it seems to be accepted with other signs than those mentioned.³⁹ The aim of changing the provision seem to be to of create a future proof and technique neutral provision for the protection of trademarks.⁴⁰ To construct an exhaustive list must be considered contradictory to this aim. Given that scents still are not explicitly excluded, the same reasoning seen in the Sieckmann case is applicable.⁴¹

In Sieckmann, the Court used a teleological method when interpreting of which signs a trademark may consist. The Court stated that the purpose of the article was to define the types of sign of which a trademark may consist and even if listed only signs which are by themselves

³⁶ EUTMR, art 7(1)(a).

³⁷ EUTMR, art 4.

³⁸ Sieckmann, para 44. For this reasoning see also, Pila, Justine & Torremans, Paul L.C. (2016), *European intellectual property law*, p. 367, Oxford: Oxford University Press. [cit. Pila & Torremans 2016; Aplin, Tanya Frances & Davis, Jennifer (2013), *Intellectual property law: text, cases, and materials*, 2. ed., p. 328, Oxford: Oxford University Press. [cit. Aplin et al. 2013]

³⁹ EUTMIR, art 3.

⁴⁰ EUTMR, recital 10; EUTMIR, art 3; European Commission, COM(2013) 0161 final, *Proposal for a Regulation of the European Parliament and of the Council amending Council Regulation (EC) No 207/2009 on the Community trade mark*, Aim of the Proposal 1.2, Increasing Legal Certainty 5.3.

⁴¹ Sieckmann, paras 44-45 ; Shield mark, para 35, confirming Sieckmann.

visible, the Court found it clear from the wording that these were examples and the list was not exhaustive. Thus, since scents were not explicitly excluded they may constitute a trademark.⁴²

There are some limits on what can be a trademark in the EU. Abstract concepts are excluded, signs need to take a specific form.⁴³ However, the Court stated in *Sieckmann* that it is not a requirement that the sign in itself is capable of being perceived visually.⁴⁴ The purpose of limiting the scope on what may constitute an EU trademark is in particular to prevent the abuse of trademark law to obtain an unfair competitive advantage that is not related to reputation.⁴⁵ Even if a fragrance is abstract in the sense that one cannot see or touch it, the meaning of abstract concept pursuant to the *Dyson* case was the indefinite number of undetermined shapes of the applied for mark that construed an abstract concept that was considered unregistrable matter.⁴⁶ When applying for registration of a specific and particular scent, this should not be an issue.

Any sign in the EU legal text can be compared with *any word, name, symbol or device* that is found in the US. Also this definition of protectable signs in the US trademark system is broad enough to include a wide scope of signs or symbols.⁴⁷ In a report the Senate expressly states that the definition of a trademark is broadened to reflect contemporary marketing practice, and that *symbol or device* is to indicate that the definition includes color, shapes, sounds and configurations where they function as a trademark.⁴⁸ When amending the provisions in 1987, the Review Commission specifically stated that “‘Symbol or device’ should not be deleted or narrowed to preclude registration of such things as a color, shape, smell, sound or configuration which functions as a mark”.⁴⁹ Extracts from a leading case on the protection of nontraditional trademarks from each trademark system will demonstrate similarities on this broad definition between the trademark systems.

⁴² *Sieckmann*, paras 44-45.

⁴³ Judgment of 25 January 2007, *Dyson*, C-321/03, paras 35,40, EU:C:2007:51. [cit. *Dyson*]

⁴⁴ *Sieckmann*, para. 45.

⁴⁵ Judgment of 24 June 2004, *Heidelberger*, C-49/02, para 24, EU:C:2004:384; See further discussion of the consequences of this limitation for olfactory signs under the section 2.2.2.3 Functionality.

⁴⁶ *Dyson* para. 40.

⁴⁷ 15 U.S.C.A. § 1127, “*Any word, name, symbol or device*” that identifies a person’s goods or services; see also Halpern et al. 2015, p. 260.

⁴⁸ See S. Rep. No. 515, 100th Cong., 2ND Sess., 44 (1988); see also, Arden, Thomas P. (2000), *Protection of nontraditional marks: trademark rights in sounds, scents, colors, motions and product design in the U.S.*, p.4, New York: INTA. [cit. Arden 2000]

⁴⁹ Trademark Review Commission, *Report & Recommendations*, 77 Trademark Rep. 375, 421 (Sept.-Oct.1987); for this reasoning see Arden 2000 p. 4.

In a case regarding registration of a color per se, the US Supreme Court held that: “Since human beings might use as a ‘symbol’ or ‘device’ almost anything at all that is capable of carrying meaning, this language, read literally, is not restrictive.”⁵⁰ The language referred to in the quote is the definition of a trademark in the Lanham Act.⁵¹

In the EU, a similar line of reasoning to this can be found in the Advocate General's opinion regarding the Sieckmann case. The Advocate General argues that trademarks are in reality communication between seller and the consuming public, and as such, the messages communicated can be affixed to any medium that the receiver is able to decode from.⁵² Even if the Court was more concise in its judgment of the Sieckmann case and the motivation was based more on legal argumentation than the AG did, the outcome was the same. The core of the motivation that olfactory signs may constitute a trademark was that they are not expressly excluded from the non-exhaustive list of what may constitute a trademark.⁵³

What may constitute a trademark has also been put to the test in the US in an appeal for registration of an olfactory sign.⁵⁴ The Trademark Trial and Appeal Board reversed an examining attorney's refusal to register an olfactory sign as a trademark. The attorney argued in the appeal brief that the consuming public would not perceive the fragrance as an indication of origin rather than mere ornamentation. TTAB relied on the Trademark Review Commission recommendations when stating “we see no reason why a fragrance is not capable of serving as a trademark to identify and distinguish a certain type of product”.⁵⁵

In its decision the Court of Appeal made clear that the judicial interpretation on the definition of a trademark in the Lanham act section 45 includes a wide variety of items or concepts which functioned to indicate origin, such as sounds or colors. In the decision, the Court of Appeal cited *In re Owens-Corning*.⁵⁶ The case regarded a color per se, pink, as a trademark in relation to fibrous building material. The jurisprudence under the Lanham Act developed in accordance with the statutory principle that if a mark is capable of being or becoming distinctive of applicant's goods in commerce, then it is capable of serving as a trademark.⁵⁷

⁵⁰ Qualitex at 162.

⁵¹ 15 U.S.C.A. § 1127.

⁵² Opinion of 6 November 2001, *Sieckmann*, paras 19-21, C-273/00, EU:C:2001:594. [cit. Sieckmann Opinion]

⁵³ Sieckmann, paras 43-45; Later confirmed in for instance, *Shield Mark* para 35.

⁵⁴ Clarke 1988, 1990.

⁵⁵ Arden 2000, p. 9.

⁵⁶ *In re Owens-Corning Fiberglass Co.*, 774 F.2d 1116, (Fed. Cir. 1985). [cit. Owens-Corning]

⁵⁷ Owens-Corning, 1120.

By application of the rationale of Owens-Corning, which is the most closely analogous determinations according to the examining attorney, it was concluded that it does not exist an inherent bar to the registrability of an arbitrarily-chosen, non-functional scent.⁵⁸

In a more recent case of principal value to the US trademark system, the US Supreme Court elaborates and clarifies that “It is the source-distinguishing ability of a mark – not its ontological status as a color, shape, fragrance, word or sign – that permits it to serve these basic purposes”.⁵⁹

Considerations

The trademark systems both have broad enough definitions on what types of sign or symbols may constitute a trademark to include olfactory signs. In neither of the systems, the very nature of the sign should be ground for refusal to register. As can be seen in the provisions of each trademark system, it is the functioning of that symbol that sets the limit for its registration. Regardless of the nature of a sign, if it is in fact identifying goods and distinguishing them from goods of other undertakings, that sign is indeed fulfilling the essential function of a trademark.

Both the EU and the US trademark systems are open, in theory, to protect all and any signs, including olfactory signs, that carry some type of message regarding identity of origin to the public. As seen from the justification to protect non-conventional signs, the importance lies with the signs function as a carrier of information of origin.

2.2.2 Can a Scent Identify a Source?

The message that the sign needs to send to a consumer is regarding the origin of the branded product. Accordingly, the distinctiveness of a sign is a pre-requisite for it to be able to indicate the specific origin of the products branded with the sign. The following section will therefore investigate whether a scent can distinguish a product from others to the extent that a consumer considers that particular scent as originating from a specific manufacturer. Last in this section will be a discussion on a bar to registration, namely the so-called functionality doctrine.

2.2.2.1 Inherently Distinctive Scents

As stated initially in this thesis, there have been olfactory signs that were considered distinctive and registered in the EU. *The smell of fresh cut grass* was considered distinctive in relation to tennis balls because everyone immediately recognizes it from experience. However, later development in law has made this practice obsolete.

⁵⁸ Clarke 1988, *Examining Attorney's Appeal Brief*, p. 3.

⁵⁹ Qualitex at 164.

In Sieckmann the Court did not address the question on distinctiveness of olfactory signs because it was not considered a question to be referred by the national court. The case focused on what might be a sign that carries information to consumers and the graphic representability of signs which are not in themselves capable of being perceived visually. However, the Court has addressed the distinctiveness of colors in Libertel, a case subsequent to the Sieckmann.

In the case Libertel, the Court concluded that a color per se possess little inherent capacity for communicating specific information, especially since they are commonly used to advertise goods, without any specific message.⁶⁰ However, the Court stated that even if colors often are seen as property of things, this cannot rule out the possibility that a color per se may in some circumstances be capable of distinguishing goods of one undertaking from those of others.⁶¹ The color is not excluded from having distinguishing capabilities due to its nature as a color, but rather without context it is not considered to have any inherent distinctive capability.

In the US, the Supreme Court has made an analogy between scents and colors, meaning that both is seen as a natural characteristic of the goods and cannot be inherently distinctive.⁶² Since fragrances generally are considered characteristics of the goods, they are categorized as signs that are merely descriptive of the goods and as such may not be registered on the Principal register without acquired distinctiveness through use in commerce, secondary meaning.⁶³

Contrary to this was an application for a mark consisting of a lemon fragrance in relation to toner for digital laser printers that was published for opposition for registration on the principal register on an intent to use application. The approval of the lemon fragrance apparently resulted from a finding that the olfactory mark could be inherently distinctive.⁶⁴ However, the application was abandoned without the applicant submitting a statement of use. The final determinations of distinctiveness are made after the applicant has submitted specimens of use in commerce. If an applicant is unable to demonstrate that a scent has acquired distinctiveness, the scent can be registered only on the Supplemental Register.⁶⁵ This means that the starting point that fragrances may never be inherently distinctive in the US could be considered intact.

⁶⁰ Libertel, para 39.

⁶¹ Libertel, paras 40-42.

⁶² *In re N.V. Organon*, 79 U.S.P.Q.2d 1639, 1654, (T.T.A.B. 2006). [cit. Organon]

⁶³ United States Patent and Trademark Office, *Trademark manual of examining procedure*, §§ 1209.01 & 1209.01(b), issue of 14 January 2017, Washington, D.C.: Dept. of Commerce, Patent and Trademark Office. [cit. TMEP]

⁶⁴ Arden 2000, p. 55.

⁶⁵ TMEP § 1202.13.

The applicant *In re Clarke* argued in the appeal to differentiate the analogy to the cases *Owens-Corning* concerning color, and *Star Pharmaceutical*⁶⁶ concerning taste, made by the examining attorney as grounds for refusal.⁶⁷ The applicant argued that regarding sewing thread, no other manufacturer applied scent to their products and therefore, argued Clarke, applying her scent made it inherently distinctive because she applied for a particular scent – not just any scent.⁶⁸

Considerations

According to case law and doctrine in the US, a fragrance cannot be inherently distinctive. It is generally seen as a natural characteristic of the goods. Given this, a starting point in the US is that a fragrance is descriptive until proven otherwise. When used in a non-descriptive manner, a fragrance may be considered to function as a trademark. However, it requires substantial evidence to establish that a fragrance functions as a trademark.

Both legal systems consider colors as characteristics of the goods or simple property of things. In the US, the Supreme Court found by analogy that this is true for scents as well. In the EU, however, since applicants have had trouble with representing their olfactory signs, the Court has not addressed the distinctiveness to the same extent in the cases studied. Neither has the Court ruled out a scent's potentially distinctive character acquired through use.

Due to the similar views on color signs and the similar reasoning regarding the lack of inherent distinctive capabilities of color signs that was found, it would not be unthinkable that also in relation to scents similar views could be adopted. If an olfactory sign is taken out of its context it is not likely that a consumer will instantly perceive the fragrances of goods as signs identifying the commercial origin.⁶⁹ This is so because, like colors scents are often applied ornamentally to products, to provide for a pleasant smell. If most commonly used ornamentally and seldom as a trademark, the consuming public will most likely perceive them as merely characteristics of the goods.

What is then learned from the comparison is that scents could be considered simple property of things in the EU as well, meaning incapable of being inherently distinctive. Based on the research, the author deems it rather likely that the Court would come to this conclusion as well because it is the common approach when assessing unconventional signs.⁷⁰

⁶⁶ *In re Star Pharmaceuticals, Inc.*, 225 U.S.P.Q. 209 (T.T.A.B. 1985).

⁶⁷ Clarke 1988, *Appeal Brief*, pp. 5-7.

⁶⁸ Clarke 1988, *Appeal Brief*, p. 7.

⁶⁹ For similar reasoning, see Libertel, para 65.

⁷⁰ See for instance, Libertel; Judgment of 24 October 2007, *Henkel*, C-144/06 P, EU:C:2007:577. [cit. Henkel]

2.2.2.2 *Acquired Distinctiveness*

As the previous section concluded, olfactory signs will in both systems be seen as simple property of things or characteristic of goods, which means they would be considered descriptive of the goods. This view on scents as a natural characteristic of goods provides an obstacle hindering protection much like what descriptive wordmarks face. The following section will elaborate on acquired distinctiveness. Capturing the exact point where an olfactory sign is no longer merely descriptive of the product is difficult. This thesis will however not elaborate further in this regard, the aim is merely to confirm whether it is possible for an olfactory sign to be distinctive in relation to a product or service.

In neither of the two legal systems will a sign which is merely descriptive be protected.⁷¹ The view is that merely describing the product cannot inform the consumer of its origin.⁷² However, both systems acknowledge that a descriptive sign can acquire distinctiveness,⁷³ meaning that the sign has achieved some recognition of distinctiveness in the eyes of the consuming public. This is also referred to as the sign has acquired a secondary meaning, apart from being descriptive of the goods.⁷⁴

As seen from three applications for registration of olfactory signs in the US, they all face rejection on the ground that they do not function as trademarks to indicate the source of the goods and distinguish them from others.⁷⁵ Because of this presumption, an evaluation of acquired distinctiveness needs to be assessed on a case by case basis. In Clarke the sign was first rejected because the examining attorney found that the olfactory sign was not sufficiently promoted in the advertisement.⁷⁶ TTAB then clarified that it is sufficient to promote the product as scented, because of the unique nature of the goods, failure to indicate the specific scent was considered not significant.⁷⁷ On basis of the advertisement and other material submitted to the Board, it found that Clarke had emphasized the scented feature of her goods in advertising and even demonstrated that customers and distributors recognized her as the source of these goods.

⁷¹ EUTMR, art 7(1); U.S.C.A. § 1052(e).

⁷² For this reasoning in the EU see for instance, Henkel; Aplin et al. 2013, p. 342; For this reasoning in the US see for instance, *Park 'N Fly v. Dollar Park and Fly, Inc.*, 469 U.S. 189 (1985).; Halpern et al. 2015, p. 262;

⁷³ EUTMR, art 7(2); U.S.C.A. § 1052.

⁷⁴ U.S.C.A. § 1052; Hunter 2012, p. 149.

⁷⁵ Clarke 1988, *Rejection letter*, p.1; Grendene, document 12, *Offc Action Outgoing*; Verizon, document 14, *Offc Action Outgoing*.

⁷⁶ Clarke 1988, *Examining Attorney Appeal brief*, p 4.

⁷⁷ Clarke 1990, p. 5.

Other factors that the Board valued as evidence for acquired distinctiveness was that the scent was applied to the product, thus, not a naturally inherent attribute of it. This, in addition to the scent being arbitrarily chosen, was also considered to indicate that the scent was more likely to be perceived as a badge of origin.⁷⁸ The Board admitted that it is difficult to describe a scent and noted in the decision that the description of the scent will appear on the registration certificate because the era of “scratch and sniff” is not yet present.⁷⁹

The Board also noted in *Clarke* that since the applicant was the only one applying a scent to her products, this could also aid the scent being perceived as indicating origin. The subsequent application of *Grendene* supports this view, as the applicant also was alone in scenting its products, sandals. In contrast to these two cases is the *Verizon* application for a *flowery musk scent* in relation to consumer electronics. Here the examining attorney found that it is common in the business to use scents to create ambiance in stores. The scent was considered an olfactory sign, however, not enough evidence to show acquired distinctiveness was provided. Therefore, the principal register was of limited scope and it was registered on the supplemental register instead.⁸⁰

The *Bubblegum* scent for sandals was first refused as not inherently distinctive. It was later accepted, after amending the application to include acquired distinctiveness, referring to almost 14 years of use and submitting over 150 pages of evidence in the form of articles, pictures, websites and reviews of the sandals. The amount of evidence submitted in the *Verizon* case was substantially less and existed mostly of statements of use.

In another case the scent had been in use for at least five years prior to the application. Further it was submitted that at least 5000 bottles of lubricant scented with the scent had been sold annually and during this period the product was advertised.⁸¹ The evidence submitted by the applicant to establish acquired distinctiveness is insufficient. The examining attorney explained that more evidence is needed when a mark is so descriptive that consumers are less likely to perceive it as indicating a source.⁸² The examiner pointed out that it has been in use for less than 10 years, that the volume of sales was relatively low over a five-year period, and the applicant failed to submit specific figures regarding its advertising expenditures.⁸³

⁷⁸ *Clarke* 1990, p. 5f.

⁷⁹ *Clarke* 1990, p. 6.

⁸⁰ *Verizon*, document 10, *Examiner's Amendment*.

⁸¹ *Mike Mantel DBA Manhattan Oil, The mark consist of the grape scent of the goods*, US application serial No 77179347, (USPTO 2008).

⁸² *Idem, Examining Attorney's Appeal Brief*.

⁸³ *Ibidem*.

In the EU, when assessing whether a sign has acquired distinctiveness, the same criteria applies to all categories of trademarks.⁸⁴ In relation to olfactory signs the Third Board of Appeal has also made use of this practice when assessing if *the scent of raspberries* had acquired distinctiveness.⁸⁵ Even if the same criteria apply to all categories of trademarks, the Court acknowledged in *Libertel* that the perception of the relevant public is not necessarily the same in relation to all categories of trademarks.⁸⁶ Because of the nature of some signs, the Court stated that without prior use distinctiveness is inconceivable, save for exceptional cases and particularly where the number of goods for which the mark is claimed is very restricted and the relevant market very specific.⁸⁷

Factors taken into account when assessing acquired distinctiveness in the EU could be, but do not seem limited to; the market share of the sign used, how geographically widespread and long-standing the use has been, the amount invested in promoting the sign and the proportion of the relevant public that sees the sign as a badge of origin.⁸⁸ These are all recognized from evidence brought forward by applicants in the studied cases from the US. As seen in the US, also in the EU if an applicant is the only proprietor of a descriptive sign in relation to certain goods, acquired distinctiveness will more likely be successfully proven.⁸⁹

If an applicant is unable to demonstrate that a scent has acquired distinctiveness, the scent can be registered only on the Supplemental Register. A number of applications have been amended from registration on the Principal Register to applications for registration on the Supplemental Register after refusal to register due to failure to prove acquired distinctiveness.⁹⁰ After five years of registration on the Supplemental Register and additional evidence of acquired distinctiveness, the olfactory sign may be amended to the Principal Register upon application.

⁸⁴ See for instance Judgment of 18 June 2002, *Philips*, C-299/99, para 48, EU:C:2002:377; Judgment of 8 April 2003, *Linde*, C-53/01, para 46, EU:C:2003:206; Judgment of 21 October 2004, *OHIM v Erpo Möbelwerk*, C-64/02P, paras 32,44, EU:C:2004:645; for this reasoning, Aplin et al. 2013, p. 343.

⁸⁵ Decision of the Third Board of Appeal of 5 December 2001, *The Scent of Raspberries*, R 711/1999-3, para 33.

⁸⁶ *Libertel*, para 65.

⁸⁷ See for instance, *Libertel* para 66; Judgment of 21 January 2010, *Audi v OHIM*, C-398/08P, para 38, EU:C:2010:29.

⁸⁸ Judgment of 4 May 1999, *Windsurfing Chiemsee*, C-108/97, para 31, EU:C:1999:230; Judgment of 29 September 2010, *CNH Global v OHIM*, T-378/07, para 32, EU:T:2010:413.

⁸⁹ European Union Intellectual Property Office, *Guidelines for examination in the Office*, issue of 1 October 2017 final, part B, section 4, chapter 6, 5.3. [cit. The Guidelines]

⁹⁰ See for instance, *The Smead Manufacturing Company*, *The mark consists of an apple cider scent or fragrance*, US application serial No 78649230, (USPTO 2005).

The Smead Manufacturing Company, *The mark consists of a peppermint scent or fragrance*, US application serial No 78649175, (USPTO 2005).

Considerations

As seen and understood from the US, it is a substantial amount of evidence needed to prove acquired distinctiveness. The assessment must be made on a case by case basis. Even if neither of the trademark systems seem to set out special rules depending on the type of trademark, problems connected to the abstract and non-visual nature of a scent could be discerned. No particular difference in what may be submitted as evidence was found.

How the scent is perceived by the consuming public and the market is important, and in both systems an olfactory sign has an uphill battle when proving distinctiveness because the common perception with the consuming public that a scent often is ornamental in relation to products. It follows that being the only proprietor of an olfactory sign in relation to a limited number of goods and that the scent is arbitrarily chosen and unexpected in relation to those goods, are factors that seem to increase the chances that relevant public could perceive the scent as an olfactory sign.

A common line of thought discerned in the US is that it is easier to perceive an unexpected scent as an olfactory sign. The belief seems to be that when a product has a surprising and unexpected smell, consumers are more susceptible to wonder about origin. This is seen when scenting a product that usually is not scented. When a scent is commonly used as ornamentation, or in the Verizon case to create ambience in retail stores, something more is required for a scent to function as a trademark.

When the applicant is the only one scenting its products, the bar for showing acquired distinctiveness seems lower. In such case the consuming public need not be aware of the type of scent only that the product is scented. It is obvious that it is easier to remember *if* a product smelled, rather than *what* the product smelled. Which can be concluded would be needed to be demonstrated if another manufacturer were scenting their products. In either case, it seems an applicant need to submit concrete evidence in favor of the scent being perceived as a trademark.

2.2.2.3 *Functionality*

Even if an olfactory sign has acquired recognition of distinctiveness, it may not serve a utilitarian purpose for the goods or services scented with it. If a scent adds to the product value or consists exclusively of a characteristic that results from the nature of the goods themselves it cannot be registered as an olfactory mark. This is true in the EU as well as in the US.⁹¹ In the

⁹¹ EUTMR, art 7(1)(e); 15 U.S.C.A. § 1052(e)(5).

EU, the pursued objective in this regard is to prevent the exclusive rights conferred by a trademark to extend the protection of rights regulated by other legislation, such as patent or design protection.⁹² Also in the US the purpose of the functionality doctrine is defined as maintaining a proper balance between trademark law and patent law.⁹³

Functional trademarks have been defined in the US in relation to colors as a product feature that is *essential to the use or purpose of the article or if it affects the cost or quality of the article*.⁹⁴ As early as Clarke, it was noted that registrability of olfactory signs in relation to perfumes could be troublesome, the TTAB limited the scope of the decision to explicitly exclude applicability in relation to perfumes due to similar reasoning.⁹⁵

Another part of the functionality doctrine was found to be public policy regarding competitive need. In *Libertel*, the number of shades of a color per se that could be used as signs was expected to be limited because the consumer rarely has the chance to directly compare color marks with different shades.⁹⁶ Similar arguments were found in the US regarding a scent reminiscent of plumeria blossoms that was rejected by the examining attorney on the basis that the mark was de jure functional. The motivation was that there is a general competitive need for other manufacturers to freely add pleasant scents to their sewing thread.⁹⁷ This was countered by the applicant, Clarke, with being akin to the color depletion argument found to be unpersuasive in the *Owens-Corning* case.⁹⁸ Another decision⁹⁹ was submitted as an example that refusal to register a mark based on a theory of functionality required the examining attorney to establish some overriding public policy or intent.¹⁰⁰ In the US, this public interest is taken into account when assessing if a product feature is considered functional, however the public interest is not

⁹² EUTMR, art 7(1)(e)(i), interpreted in Judgment of 18 September 2014, *Hauck*, C-205/13, paras 19-20, EU:C:2014:2233; Judgment of 14 September 2010, *Lego Juris v OHIM*, C-48/09P, para 43, EU:C:2010:516; For this conclusion see, the Guidelines, part B, section 4, chapter 6, 1.

⁹³ *Qualitex* 164-165.

⁹⁴ *Qualitex* 165; *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844, 850 (1982).

⁹⁵ Clarke 1990, p. 5, note 4.

⁹⁶ *Libertel*, para 47.

⁹⁷ Clarke 1988, *Examining Attorney Appeal Brief*.

⁹⁸ Just because many products incorporate or have a color does not mean that particular colors or color combinations are not registrable. Just because sounds might be employed in the offering of services does not mean that a particular sequence of sounds is not registerable; see also *Owens-Corning*, 1120.

⁹⁹ *In re DC Comics, Inc.*, 215 U.S.P.Q. 394 (Cust. & Pat. App. 1982).

¹⁰⁰ Clarke application, p. 55f.

crucial to the assessment.¹⁰¹ In the EU it is not necessary for the EUIPO to show that there exists a need to keep a descriptive sign free.¹⁰²

Supporting the view that it is not hindering other manufacturers from using scents or even floral scents in relation to their sewing thread, Clarke argued that she seeks registration for a specific floral scent. As the registration of pink was held to not present a significant obstacle for competitors neither should the registration of the particular scent of plumeria blossoms present a significant obstacle for competitors.¹⁰³ Upon further consideration of Clarke's argument that the scope of protection sought is limited to one very specific fragrance, the examining attorney withdrew the ground for refusal that the applied for mark is de jure functional.¹⁰⁴ In Grendene the applicant argued that sandals are not known for their scent and there would be no other reason to scent sandals other than for that scent to serve as an indicator of origin.¹⁰⁵

In the EU, the OHIM refused a flavor sign with public policy as a ground. The OHIM held that the taste of strawberries is common, and every manufacturer is entitled to use the taste to disguise unpleasant tastes or simply for the purpose of making pharmaceutical preparations taste pleasant.¹⁰⁶ In the US, *a scent of peppermint* in relation to pharmaceuticals was held to be devoid of distinctive character, partly because competitors scented competing products, even with similar scents. Because of this it was concluded that such scents would not be likely to be perceived as olfactory signs but had a utilitarian purpose.¹⁰⁷ The TTAB has also refused the registration of a flavor sign for pharmaceuticals on similar grounds. The Board held medicine to generally have a disagreeable taste and therefore it exists a practical need for it to taste pleasant to increase willingness and ability to take the prescribed medicine.¹⁰⁸ Hindering competition too much is considered if the competitors is put at a disadvantage that is non-reputation related.¹⁰⁹

¹⁰¹ Handelman, Jeffrey A. (2012), *Guide to Trademark Trial and Appeal Board Practice*, 7.27, New York: Wolters Kluwer, referring to *In re Morton-Norwich Products, Inc.*, 671 F.2d 1332, 1340-41, (Cust. & Pat. App. 1982); *Valu Engineering, Inc. v. Rexnord Corp.*, 278 F.3d 1268, 1276 (Fed. Cir. 2002).

¹⁰² See for instance Judgment of 4 May 1999, *Windsurfing Chiemsee*, C-108/97, para 35, EU:C:1999:230; Judgment of 12 February 2004, *Postkantoor*, C-363/99, para 61, EU:C:2004:86; for similar reasoning see also the Guidelines, Part B, section 4, chapter 1, 5.2.

¹⁰³ Clarke 1988, *Appeal Brief*, p. 11.

¹⁰⁴ Clarke 1988, *Examining Attorney's Appeal Brief*, p. 1.

¹⁰⁵ Grendene, document 9, *Response to office action*, p. 3.

¹⁰⁶ Decision of the Second Board of Appeal of 4 August 2003, *The taste of artificial strawberry*, R 120/2001-2, paras 15-16.

¹⁰⁷ *In re Pohl-Boskamp GmbH & Co.*, 106 U.S.P.Q.2d 1042, 10 (T.T.A.B. 2013).

¹⁰⁸ Organon, pp. 10, 15.

¹⁰⁹ Qualitex 1164.

Considerations

Many products have a natural scent to them. This is an inherent product attribute, and as such, protection of it could interfere with market competition in a non-reputational manner. In both systems the public interest of keeping a product feature free for competitors to use seem to be of importance. Therefore, shall natural scents, or scents that enhances value of the goods, be free for competitors to use in their line of business as well. It was also found that the provisions regulating the functionality was in both systems concerned with trademark protection not being abused to prolong the protection of rights relating to other intellectual property, such as patents or design.

In the EU, a functional or descriptive sign is an absolute ground for refusal. An exception exists if the descriptive sign has acquired distinctiveness. In the US, it is regulated the other way around, where the main rule is that signs that have acquired distinctiveness shall not be prevented from registration unless they are merely descriptive or serve a utilitarian purpose. These opposites seem to be technical and no implications were found regarding how the requirements show themselves when assessing registrability of signs.

By analogy with how the systems argue in relation to color, the number of scents which the consuming public is able to distinguish is limited, since the relevant consumer seldom has the chance to directly compare goods or services with various scents. This means that, even if we remember smells more accurately, also the number of different scents that can be used as trademarks are limited equally. Added to this is another reason for a limited number of scents being available. Not all scents are suitable for every product, a common example is the smell of fish in relation to household cleaning material. Even if it would make a potentially distinctive smell in relation to the market, it probably would be considered repellent, making the product undesirable to consumers and the trademark useless.

By analogy with the functionality of tastes in relation to pharmaceuticals, the conclusion would be that if scenting a product that in general have a disagreeable smell, that scent would probably be seen as a utilitarian function that cannot be protected under trademark law. Every competitor should have the right to scent unpleasantly smelling products. However, products that are usually not scented, because it historically has been no need to scent them for it to be sold, seem to point towards that scenting them would not serve a utilitarian purpose in relation to the product but rather exists as a distinguishing feature, a trademark.

There are similarities in how a functional aspect of a sign is treated in both systems. The cases relating to olfactory signs point in the same direction regarding the argumentation on public interest to not unduly hinder competition and the purely functional aspect of being ornamental to the product or to disguise an unpleasant smell. A more general conclusion is, taking into account how olfactory signs are descriptive of the goods and often has a functional aspect, that the type of goods that could successfully be branded with a scent seem to be more limited than is the case for other types of signs. This obstacle is closely linked to the perception of a scent, not just a legal obstacle. The historical use of scents to disguise unpleasant smells seem to have marked scents, so they rarely are perceived as trademarks, but rather ornamental or functional.

Over 2 million trademarks are registered with the USPTO, only three olfactory marks have been granted full protection.¹¹⁰ This is noteworthy; that in a trademark system where protection is possible, still only an evanescent number of olfactory signs are registered. This could be so because proprietors find themselves with enough protection as is, due to the use-based nature of the US trademark system. The question of why not more olfactory signs are registered calls for another study, however, it is outside the scope of this paper.

After evaluating these requirements, it can be concluded that, so far, a sign fulfilling the above-mentioned requirements is only enough to protect a trademark in the US. To be granted protection as a EU trademark, a third criterion must be fulfilled, namely, the seven-tier test of representability laid down in the Sieckmann case. The requirement for representation, along with the requirement for use, is considered in the following in relation to the registration.

2.3 Representation of an Olfactory Mark

Even if a scent has acquired distinctiveness, thus, has overcome the hurdle of being merely descriptive of the goods, the representation of that olfactory sign for the purpose of registration seem to compose a problem in the EU. It is a natural requirement for registration that a mark be represented somehow. This is of importance for the identification of the mark and to determine the scope of protection.¹¹¹ This is not something unique in neither of the legal systems. However, until recently, the EU trademark system required a graphical

¹¹⁰ United States Patent and Trademark Office, *Performance and Accountability report*, fiscal year 2017, table 15.

¹¹¹ Sieckmann, paras 34-35.

representation.¹¹² This requirement has created difficulties in registering nontraditional marks but is since the recent trademark reform abolished.¹¹³

A description in words was previously enough in relation to the mark *the smell of fresh cut grass* for tennis balls,¹¹⁴ and *the scent of raspberries* for engine fuels.¹¹⁵ These descriptions fulfilled the requirement for graphic representation in the EU around the same time that Celia Clarke registered her olfactory sign *a high impact, fresh, floral fragrance, reminiscent of Plumeria blossoms* in the US.¹¹⁶ However, the acceptance of a description in words was duly limited by the Court in Sieckmann, whereas no significant change can be seen in the US practice on this point.¹¹⁷

The previous requirement for graphical representation in the EU can be compared to the requirement in the US, of submitting a clear drawing that depicts the mark when the application is filed.¹¹⁸ However, the US systems in relation to sound, scent, and other non-visual marks, only requires a detailed description instead.¹¹⁹ As can be seen in the application of successfully registered trademarks, this description can be in words.¹²⁰ In contrast to this, a description in words of a scent is in the EU considered to be *imbued with subjectivity and can be interpreted in a subjective way, that is, differently by different people*,¹²¹ and therefore not acceptable as representation of a mark.

In T-305/04,¹²² the applicant argued that the applied for sign refers to a scent that does not vary from one type of ripe strawberry to another, therefore the description in words, *the smell of ripe strawberries* in combination with a picture of a ripe strawberry, must be seen as unequivocal, precise and objective. The applicant argued that everybody recognizes the smell from memory; a reasoning that is strikingly similar to that of the decision on the *smell of fresh cut grass*.¹²³ The Court of First Instance, however, pointed out that the mere finding that it was possible to

¹¹² Council Regulation (EC) No 207/2009 of February 26 2009 on the Community Trademark, art 4, (2009) OJ L 78/1.

¹¹³ EUTMR, art 4.

¹¹⁴ Fresh cut grass.

¹¹⁵ Decision of the Third Board of Appeal of 5 December 2001, *The Scent of Raspberries*, R 711/1999-3, application No 1 222 090

¹¹⁶ Clarke 1988.

¹¹⁷ For similar conclusion see Seville, Catherine (2016), *EU intellectual property law and policy [Electronic resource]*, 2 ed., p. 276 Cheltenham: Edward Elgar. [cit. Seville 2016]

¹¹⁸ C.F.R. T. 37, Ch. I, Subch. A, Pt. 2.52.

¹¹⁹ C.F.R. T. 37, Ch. I, Subch. A, Pt. 2.52(5)(e).

¹²⁰ See for instance, Clarke 1990; Grendene.

¹²¹ Sieckmann, para 65.

¹²² Judgment of 27 October 2005, *Eden v OHIM*, T-305/04, EU:T:2005:380. [cit. Ripe Strawberries]

¹²³ Fresh cut grass, para 14.

differentiate the varieties of strawberries by their smell in five of the nine crops analyzed in the study annexed to the application was sufficient to show that strawberries do not have just one scent.¹²⁴ The reference to ripe strawberries could be understood as different scents, consequently, the sign was deemed neither unequivocal nor precise and did not eliminate all elements of subjectivity in the process of identifying and perceiving the sign claimed.¹²⁵

In the US, there seem not to be specific criteria relating to the accuracy of the detailed description. In the EU, description in words have been questioned as to their accuracy. In his opinion on the Sieckmann case the AG pointed out this: How intense is the slight hint of cinnamon?¹²⁶ In a subsequent case the Court of First Instance argued similarly: Which type of ripe strawberry is referred?¹²⁷ The objectivity and precision of a description in words has still not been questioned in the US since Celia Clarke, where signs described as *flowery musk scent*¹²⁸ or *the scent of bubblegum*¹²⁹ has been accepted.

The recent trademark reform in the EU changed the requirement from, a sign necessarily being graphically represented, to, *be represented in any appropriate form using generally available technology*.¹³⁰ This, however, has not made the Sieckmann case law obsolete. The very wording of the court in the case is instead codified in the Regulation, requiring the representation to be *clear, precise, self-contained, easily accessible, intelligible, durable and objective*.¹³¹ Thus, this obstacle for registration of olfactory signs prevailed the trademark reform in the EU.

In Sieckmann, the Court denied other representations as well. A chemical formula was not acceptable representation, because it does not represent the olfactory sign but rather the substance to which the scent is a characteristic.¹³² However, other reliable methods to represent the scent itself exists, such as gas chromatography (GC), mass spectrometry (MS) or colorimetric sensor array, which produce a graph or a picture of the components making up the scent. From this graph or picture, it is possible to scientifically reproduce the scent by giving

¹²⁴ Ripe Strawberries, para 32.

¹²⁵ Ripe Strawberries, para 33.

¹²⁶ Opinion of 6 November 2001, *Sieckmann*, C-273/00, para 41, EU:C:2001:594.

¹²⁷ Ripe Strawberries, para 33.

¹²⁸ Verizon.

¹²⁹ Grendene.

¹³⁰ EUTMR, recital 10.

¹³¹ EUTMR, recital 10; see also Max Planck Institute for Intellectual Property and Competition Law (2011), *Study on the Overall Functioning of the European Trade Mark System*, p. 68. [cit. The Trademark Study]

¹³² Sieckmann, para 69.

digital instructions to a scent creating device.¹³³ However, both methods have been rejected by the OHIM on the ground that they are not intelligible,¹³⁴ albeit they have not been tested before the General Court or the ECJ.¹³⁵

In an appeal by Institut Pour la Protection des Fragrances, the OHIM board of appeal noted that the relevant public would not be able to make out the scent from a picture of a colored rectangle, it would take a professional to understand the scent behind the picture.¹³⁶ A reproduction seem to be needed for the intelligibility. In her article Karapapa mentions a device called Scent dome that exists, though not common, but that it would come to no surprise if they would become in the near future.¹³⁷ Many years have passed but neither they nor similar devices seem more common today than 8 years ago.

In the US, a GC graph was submitted as evidence in proceedings for alleged infringement.¹³⁸ One expert explained that no conclusion on the similarities of scents can be drawn from comparison of the graphs of the two perfumes alone. This is primarily so because though the chemical compositions of two perfumes may differ slightly, not every chemical compound present in a perfume produces a scent.¹³⁹ The expert also points out that differences in the graphs may result from the how the tests were performed and may not reflect any real differences in chemical composition.

Another representation tested before the Court is a deposited sample. The sample was not considered to be graphical representation, neither durable nor stable.¹⁴⁰ Because a trademark can be renewed for varying periods, making the protection of a trademark indefinite in theory, the representation must be durable.¹⁴¹ After the abolition of the graphical requirement, the

¹³³ The technical process of producing the graph or picture is not necessary to explain in this context. Besides, there are variations in methods to perform the same task of creating this graph, unless using the same method the results would not be comparable. It would require a standardized method for this to be useful.

¹³⁴ Karapapa, Stavroula (2010), *Registering Scents as Community Trade Marks*, The Law Journal of the International Trademark Association, vol. 100 No 6 2010, p. 1353-1354, [cit. Karapapa 2010], referring to, Novagraaf Nederland B.V., EU application No 000566596, (EUIPO 1997) & Novagraaf France, EU application No 000521914, (EUIPO 1997).

¹³⁵ The Trademark Study, p. 66.

¹³⁶ Decision of the Fourth Board of Appeal of 19 January 2004, *a hint of green lawn, hesperidia (bergamot, lemon), flowers (orange blossom, jacinth) roses, musk*, R 186/2000-4.

¹³⁷ Karapapa 2010, p. 1357.

¹³⁸ *Sherrell Perfumers, Inc v. Revlon, Inc., et al.*, 483 F. Supp. 188 (S.D.N.Y. 1980)

¹³⁹ *Idem*, at 193.

¹⁴⁰ Sieckmann, para 71.

¹⁴¹ *Idem*, para 53.

EUTMIR explicitly states that a deposited sample is not considered a proper representation of a trademark.¹⁴²

The seven-tier test laid out in the Sieckmann case was put to use in a case regarding sound marks.¹⁴³ The representation of the sound mark applied for did not meet the criteria. However, the Court did have a solution as to how sound marks could pass the test, something the Court did not suggest in relation to olfactory signs. What is interesting is that the Court clarified that the criterion of intelligible representation is met even when not immediately intelligible.¹⁴⁴ Due to the technology advancement in the years since the refusal of the applications mentioned in note 129, it exists techniques and devices for reproducing scents from instructions similar to notes for reproducing sound marks on an instrument.¹⁴⁵ Though most of them are limited, and focused on elevating gaming experiences or creating a pleasant environment. The point is that the technique exists, but have another focus than making registration of olfactory signs possible. Even several online databases with instructions of varying accuracy for creating scents exist.¹⁴⁶

In Sieckmann the Court stated that a combination of representation elements is not able to satisfy the requirements for representation.¹⁴⁷ Meaning that lacking in some criteria cannot be remedied by adding another method of representation because the combination of methods would be subject to more possible interpretations.¹⁴⁸ However, in Libertel, a subsequent case regarding the registration of a color *per se*, the Court stated that where a sample of the color is not enough to fulfill the requirement, it can be combined with a description in words. If that would still not fulfill the requirements for representation, in particular those relating to precision and durability, this could be remedied by adding a color designation from an internationally recognized identification code.¹⁴⁹ This, however, should not be seen as overriding Sieckmann in any way because there seem to be an overlaying principle that a single main method of representation must fulfill all of the criteria on its own.¹⁵⁰

¹⁴² EUTMIR art. 3(9).

¹⁴³ Shield Mark.

¹⁴⁴ *Idem*, para 63.

¹⁴⁵ <http://www.microfab.com/vapor-generation/aromajet>; www.Feelreal.com; Kim, H., Park, J., Noh, K., Gardner, C. J., Kong, S. D., Kim, J. and Jin, S. (2011), *An X–Y Addressable Matrix Odor-Releasing System Using an On–Off Switchable Device*, *Angewandte Chemie International Edition*, vol. 50 issue 30, pp. 6771–6775.

¹⁴⁶ <http://www.fragrancesoftheworld.com/FragranceDatabase>; <http://www.basenotes.net/fragrancereviews/>.

¹⁴⁷ Sieckmann, para. 73.

¹⁴⁸ For a similar reasoning see Sieckmann Opinion, para 43.

¹⁴⁹ Libertel, para 38.

¹⁵⁰ *Idem*, paras 36-38; The conclusion is made on the fact that the accompanied description in words still must on its own fulfill all the criteria, and that an internationally recognized identification code fulfills all the criteria, save for perhaps the criterion relating to being self-contained.

The applicant in T-305/04 tried to differentiate its application to the one in Sieckmann, stating that the description in words and the picture should be regarded as a whole, making out the representation of the sign together. The Court of First Instance replied to this that the description in words and the picture convey the same information, a ripe strawberry. Therefore, the combination of them cannot amount to more than the sum of the two parts.¹⁵¹ In the IPF appeal mentioned above, the OHIM also noted that the additional description did not remedy the lack of intelligibility.

Considerations

The US method of representation, a description in words, is accepted as representation in the EU. However, in many situations the description does not meet the requirement of the Sieckmann criteria. Noteworthy is that the precision of the description never was an issue for the applications in the US. A description in words accompanied with a product sample infused with the applied for mark was enough for the examining attorney to identify the olfactory sign.

The reason for a description in words being a sufficient method of representation in the US is assumed to be because the scope of protection is not necessary to determine on basis of the register. This is traced back to the use-based foundation of that trademark system, where the scope of protection is based on the actual use that can be shown during a process of discovery.

A description in words is often imbued with subjective factors and therefore have trouble meeting the criteria of clarity and precision. As seen in Shield Mark, it was explained that musical notation meets these criteria. Even if it was found not *immediately* intelligible, it was enough that it could be *easily* intelligible according to the Court. It was not further explained what being *easily intelligible* meant, but it is assumed that the Court intended the use of instruments as a part of the intelligibility.

Because of technology advancement we can reproduce scents in a way similar to the reproduction of acoustic marks. Instructions for a digitized scent could be compared to notes for a melody. It is assumedly so, that a greater number of people could have a clue of the nature of the sound than how the olfactory sign would smell. However, it is required that the exact identity of the sign could be determined on basis of the register, which is equally not true in the two cases. A hunch or feeling of how an acoustic mark might sound is not the same as determining the exact identity by experiencing the mark with one's ears.

¹⁵¹ Ripe Strawberries, para 46.

Still, even if representing the scent with a picture it would not be the actual smell, thus, lacking in the same criteria as a chemical formula. Well, this is equally true with notes for a sound mark. The notes do not represent the actual sound, but merely instructions to be followed so the sound could be reproduced on an instrument. In relation to scents, the picture would give instructions as to how to reproduce the exact compound that emits the scent. However, it has been found that the instruments needed to reproduce a scent from a GC/MS graph is not easily accessible and the scent reproducing devices accessible to the public are limited in the number of scents that can be created. Further, it seems as common guidelines on how to perform these tests is needed to produce reliable results. With common guidelines for the tests the chemical profiles could be objectively compared, however, more information than the graph would still be needed to know if every chemical also affects the scent.

To continue the analogy with methods for reproducing sounds, the Scent dome are much more complex than a loudspeaker. Even if mentioned in Karapapa's article that sounds have been reproduced for much longer time than scents, it is not mentioned the complexity of scents, and the fact that we have far less knowledge about our olfactory bulb than how our hearing works. If the Scent dome is not calibrated correctly, who is responsible for the sensory experience being correct? Even if every consultant is expected to buy a Scent dome, a standardized method on the calibration of these is needed. In addition to this, a sound consists of waves of air whilst a scent is far more complex structure of up to hundreds of components that is needed to be added to the Scent dome.

Applying the solution of the Court from *Libertel* on olfactory sign, the question arises as to what may constitute an internationally recognized identification code. There exist several codes that identify scents that are used internationally within the fragrance industry, to classify and reproduce fragrances. Albeit, a common code has not been found. Additionally, the problem of intelligibility would still be present since few, if any, would know the smell from a code, not very different from the chemical formula. Thus, this method of representation still needs to be accompanied with a method of reproduction.

2.3.1 Requirement of Samples and of Actual Use

As seen above, the trademark system in the US is founded on the fact that rights are created by actual use of a sign in commerce. Given this requirement of use in the US, it is not strange that an applicant also must prove use when applying for a federal registration. This requirement of proving use can also be derived from the legal basis for the trademark register. The first time

the US congress tried to regulate trademark law, the statute was considered unconstitutional.¹⁵² This is because the powers conferred on the congress are related to commerce. The first legislative try had the progress clause as legal base, the second time around they based the statute on the commerce clause.¹⁵³

A deposited specimen must allow for the trademark to be readily discernable to the examining attorney. This requires submitting an actual sample of the scented goods themselves. As seen in Clarke, the examining attorney demanded a new sample to be submitted because the previous one had faded.¹⁵⁴ Where specimens and drawing submitted with application for federal registration of trademark are inconsistent, one should look at specimens, not drawing, to determine what applicant wishes to register, as specimens show what mark is owned by applicant, ownership being prerequisite to registration.¹⁵⁵

While a deposited sample is a legal requirement in the US,¹⁵⁶ it is not accepted nor seen as a proper representation of the sign in the EU. The electronic filing system allows for more methods of representation than before, a trademark is permitted to be represented in any appropriate form using generally available technology.¹⁵⁷ The recent trademark reform also exemplifies, for instance in relation to color, the mark being represented by submitting a reproduction of the color, or in relation to sound, an audio file reproducing the sound.¹⁵⁸

In the US, the sample is also provided as evidence for actual use of the sign in commerce.¹⁵⁹ In the EU, the trademark study discussed a requirement of declaration of use.¹⁶⁰ This would have made the two systems more similar. However, the proposal was recommended against because it would have changed one of the foundational principles of European trademark law.¹⁶¹ Kur means that actual use is not of minor importance in the EU. She refers to the preamble and recital 10 stating that without use, protection of a trademark cannot be justified.¹⁶²

¹⁵² *Trademark Cases*, 100 U.S. 82 (1879).

¹⁵³ Halpern et al. 2015, p. 245.

¹⁵⁴ Clarke 1988, *Examining Attorney Letter of Rejection*.

¹⁵⁵ *In re ECCS, Inc.*, 94 F.3d 1578, 1581 (Fed. Cir. 1996).

¹⁵⁶ C.F.R. T. 37, Ch. I, Subch. A, Pt. 2.56.

¹⁵⁷ EUTMR, recital 10.

¹⁵⁸ EUTMIR art. 3(1)(f), (g).

¹⁵⁹ 15 U.S.C.A. § 1127.

¹⁶⁰ The Trademark Study, part III, para 2.111.

¹⁶¹ *Idem*, para 2.109; However, the proposal was stated as a possible last resort.

¹⁶² Kur, Annette (2012), *Convergence After All? A Comparative View on the U.S. and EU Trademark Systems in the Light of the "Trade Mark Study"*, p. 322, 19 Journal of Intellectual Property Law 305, pp. 306-324, referring to regulation 207/2009 recital 10, (After the trademark reform, the same statement can be read in Regulation 2017/1001 recital 24).

The systems are alike to the extent that they both recognize the principle that only trademarks in use should be protected. Differences, however, is found in the mechanisms to uphold such a principle. In the EU, since prior registrations are only relative grounds for refusal, the system relies on the private sector to defend their right.¹⁶³ Whereas in the US, the examining attorney makes a search of the register and takes initial responsibility to exclude identical or similar signs to be registered, albeit, not total responsibility.

The search is made with key words and phrases from the description of the olfactory sign. In the register search for the Verizon application the examining attorney used, inter alia, scent, musk, floral, flower and rose as search terms. The callback is manually checked, and if identical or similar marks appear the registration is refused.

Considerations

The requirement of actual use in the US, and with that the requirement of proving use by depositing a sample, is beneficiary in relation to olfactory signs. By this legal requirement to deposit a sample, the obstacles of representing olfactory are circumvented. With the deposited sample, the exact mark can be experienced by the examiner, or a consultant of the register.

Problems with accepting samples is their durability, which the Court has pointed out in Sieckmann, in relation to olfactory signs, and in Libertel, in relation to colors per se. As seen in the Clarke application, a new sample can be deposited when the previous one has faded. This illustrates the core problem found in the EU with deposited samples not being durable.

There has been discussion on the possibility to file an electronic file reproducing the olfactory sign, like an audio file for sound marks.¹⁶⁴ As mentioned in that article an examination between the similarity of reproduction of olfactory and acoustic marks via electronic means is essential.¹⁶⁵ What was overlooked, however, is the differences in complexity of the composition of a sound and a scent. To with precision determine this difference is outside the scope of this thesis, enough is to conclude that a scent can contain many odorants while a sound comprises of air waves.¹⁶⁶

¹⁶³ EUTMR, art 8.

¹⁶⁴ Karapapa 2010.

¹⁶⁵ Karapapa 2010, p. 1356.

¹⁶⁶ <https://www.liveabout.com/common-perfume-ingredients-a-to-z-list-346106>.

3 Findings and Discussion

As the research has shown, the only bar for registering an olfactory sign was not the graphical requirement. The abstract nature and subjective sensory experience of scents seem to make up inherent obstacles when seeking protection in a registration-based trademark system. As many stated before, the legal theoretical possibility to register olfactory signs exists. However, even after the abolition of the graphical requirement, there are other criteria that bars registration of olfactory signs since the sign needs to be identified and determined on the basis of the register.

The terminology regarding olfactory signs has been found to be inconsistent in the sources. This has created a discrepancy when discussing registrability of scents, because different terms give rise to different ideas of exactly what is sought protection for. A *scent* could not be registered, the scent is a simple property of things and therefore descriptive and avoid of distinctive character. In situations, for example when a scent is arbitrary in relation to the product of which it is applied to, it has the capacity of being distinctive. However, when acquired distinctiveness we should no longer talk about a scent, rather an *olfactory sign*. In a legal analysis regarding registrability, it would not be suitable to refer to the *smell* of a product because this will never be anything else but subjective.

The smell of something is the highly subjective phenomena occurring in the brain when odor receptors process the scent information received. Due to this subjective nature, and the boundaries of words since there are no common nomenclature, when describing a sensory experience like a smell, there can be no certainty that others will come to the same understanding of what scent gave rise to that particular smell with that individual. This is so, because the description would be second hand information that is based on another individual's sensory experience, and in all honesty the description would not describe the scent, but the smell.

If distinction is kept in terminology the discussion would be more productive and fruitful because it would be easier to accept methods of representation that focuses on the objective characteristics of a product that is its scent, and not the smell perceived as a subjective sensory experience of a person.

3.1 Challenges to Protecting Olfactory Signs in the EU

Today, the Sieckmann seven-tier test is still used to sort out what signs can be registered. The result of the created test was twofold, it allowed for a broader spectrum of types of signs to be registered. At the same time, the test limits what signs can be registrable when it excludes broad

definitions of signs, to avoid hindering competitors to use alternative, but equally attractive, signs.

3.1.1 Representation

As seen from the research, the representation of an olfactory sign has historically been troublesome. Different methods have been tried but since the change in case law that was confirmed in Sieckmann, no method have been sufficient. However, it was not to visualize the invisible sign that was the only problem. Therefore, it cannot be expected that the abolishment of this requirement will alone make it possible to register olfactory signs.

The abolishment was important and affected trademark registration, making the procedure more technique neutral. It is this, indirect effect, that could lead to the possibility to register olfactory signs. The research has shown that the methods that were accepted as graphical representation, description in words, were lacking in other requirements set up, particularly those relating to clarity and precision. Requirements which are necessary for a sound administration of a registration-based trademark system because rights are conferred by the registration.

A deposited sample was not considered graphical but could fulfill the other requirements except the one relating to durability. However, the EUTMIR expressly states that a deposited sample is not considered proper representation, without further explanation.

3.1.2 The Guidelines

Both now and historically do the legislative acts present obstacles for registering olfactory signs. However, it is the same obstacles regardless of the nature of the applied for sign, they do not discriminate. Even if the Implementing Regulation do not exemplify a method for representation in relation to olfactory signs, as it does in relation to other types of signs, it does not exclude the possibility to represent olfactory signs. The Guidelines, however, discriminate against olfactory signs as an application will be deemed not filed.

When comparing guidelines used by the offices in each respective trademark system, they offer substantive differences on how to deal with olfactory signs. When consulting the Manual, an examining attorney in the US is informed that *the scent of a product may be registrable if it is used in a nonfunctional manner*.¹⁶⁷ However, scents that serve a utilitarian purpose are regarded functional. The Manual exemplify perfumes and air-fresheners as having a utilitarian purpose.

¹⁶⁷ TMEP, 1202.13.

However, the amount of evidence required to establish that a scent functions as a trademark is substantial.¹⁶⁸

When working at the EUIPO the examiner is faced with an opposite instruction, *olfactory marks are currently not acceptable*.¹⁶⁹ The Guidelines state that any application for an olfactory sign will not be treated as an application for an EUTM, status of the application will be set to ‘deemed not filed’, making it not possible to appeal.¹⁷⁰

The assumption is that the guidelines does not compose a real challenge, but rather exists as an effect of the current view regarding olfactory signs. However, the fact that it is written black on white do impose a sort of structural resistance that is not imposed on conventional trademarks. The Guidelines are described as general instructions which have to be adopted to the particularities of a case. They can only take into account what is already known, such as that the specific means of representing an olfactory sign in Sieckmann is not enough to satisfy the requirement. The Guidelines cannot predict or speculate on other means of representation that has not been ruled upon as sufficient or not.

The guidelines at the time of the Strawberry case did not present a definite obstacle for an application, they referred to Sieckmann and stated that there is currently no means of representing smells graphically. Today, however, they instruct the examiner that smells are not accepted, and will not be rejected but deemed not filed. Since the guidelines are not legal text, thus not binding, it is assumed that this obstacle exists to avoid the costs of mischief applications. Thus, they should be considered a bogey but as seen from the Strawberry case, the guidelines still could be something an applicant has to argue against.

However, for the sake of the rest of the paper, to continue the further analysis, this obstacle is disregarded as the author deems it likely that a serious and novel attempt for an application of an olfactory sign could be considered.

3.1.3 Legal Principles

The research showed a criterion of sufficiently clear and precise representation found for the registration of trademarks in the EU. In the US no such requirement was found in relation to signs which in themselves are not visible, such as olfactory signs. The strict criterion in the EU revolves around the seven-tier test found in the Sieckmann ruling. The reason for having such

¹⁶⁸ TMEP, 1202.02(a)-1202.02(a)(viii), regarding functionality; TMEP 1202.13, regarding evidence.

¹⁶⁹ The Guidelines, part B, Examination, 9.11.2.

¹⁷⁰ The Guidelines, part B, Examination, 9.11.2.

strict requirements for representation in the EU is because a consultant of the register must be able to determine the clear and precise identity of the sign to know the scope of protection granted by the register. This is founded in the register-based trademark rights and is pursuant to the principle of legal certainty.

An application for a trademark registration that is open for interpretations cannot provide a clear and precise identity of the sign. Since the EU has developed a trademark system where rights originate from the registration, it is important that those rights can be determined by the register. The use-based system in the US offers more flexibility, on the expense of legal certainty. The flexibility lies with the acceptance of the system to alter the use of the trademark as time passes, to widen the scope of protection. Whereas in the EU, with the exception of well-known brands, the registration is static and the use of the trademark is not protected outside the scope determined by the registration.

The possibility to change or alter an already existing registration is restricted. Save for alterations of name or address of the proprietor not substantially affecting the identity of the trademark, an EUTM shall not be altered in the register.¹⁷¹ The rationale of Article 54 EUTMR is precisely to exclude any alteration of the registered EUTM that could affect its scope of protection or the assessment of the use requirement, so that rights of third parties cannot be affected.¹⁷²

The challenge is to find methods of representation that do not risk the legal certainty. The Court cannot change the requirements for representation just because one type of sign is harder to represent. However, the Court can accept different means for representation that is most suitable for that type of mark. This is obvious from the recent reform, allowing e-filing with different formats most suitable for the different types of marks.

3.2 Possible Solutions Found in the US

In the judgment for the appeal, *In re Clarke*, TTAB remarked that the registration will not be a “scratch and sniff”, because this era is not yet upon us. However interpreted, this phrase pinpoints challenges to protection that olfactory signs face in the EU. In the US, where concerns of the register are secondary, the olfactory sign received federal registration because it fulfilled the essential function of a trademark and the representation by a sample and accompanying description in words was sufficient.

¹⁷¹ EUTMR, art. 54.

¹⁷² The Guidelines, Part E, 9.

If the Clarke appeal was put in an EU context, when it has been decided that the scent fulfills the essential function of a trademark the Court would state that there are problems with determining the scope of protection for the scent. Thus, it cannot be registered because the deposited sample would not be durable and the description in words would be imbued with subjective factors and lacking in clarity and precision. As seen in the Sieckmann case, the description in words are subjective and the sample would not survive the passage of time, making it hard or even impossible for future generations to determine the scent of the trademark.

3.2.1 Description in Words

As seen from the comparative study, in the US the requirement for representation of an olfactory sign is a description in words. Therefore, this was not an issue in the appeals that has been studied. The lack of elaboration in relation to this has resulted in no further guidance as to how this form of representation works in practice or why it could be accepted. Some conclusions can, however, be made on the basis of the applications, despite this.

The description in words is not required to be self-contained, as in the EU. In collaboration with the deposited sample, the two make out the whole. The description in words can be seen as a way of categorizing the sign by hinting what object may emit a similar scent as the olfactory sign. Without the sample, however, the description must be seen as a circular argument if one is supposed to recognize the scent. In an EU context it could be explained as the description being imbued with subjective factors and only by smelling the actual product one could with clarity and precision determine the scent.

The reason this circular argument, that is the description in words, seem to work in the US is because the use-based trademark system. This allows for the reproduction of the sign to occur outside of the register, while it is required in the EU that the sign is reproduced *on* the register. The scent could as well be represented with a number instead of the description, because the process of identifying the sign takes place when sniffing the product or service that is represented by that sign. Albeit, for categorization, it is easier with a description on the register because a junior proprietor of a scent that is not for example reminiscent to blossoms, do not have to smell products in that category.

The problems for a description in words to fulfill the requirements for proper representation of a trademark in the EU can be demonstrated with an example based on the case T-305/04. It was found that different types of ripe strawberries smell different. This would mean that even if all consultants of the register have a memory of the smell of ripe strawberries, and they all would

categorize that smell as ripe strawberries. However, it is not the same objective scent that is the foundation of the smell that comes to the consultants' minds because they have not necessarily smelled the same variant of ripe strawberry. Similarly, a registration for *the color of a ball* cannot be registered.

For the same reason, a description in words that specifies the variety of ripe strawberry could not be accepted. *The scent of the strawberries I grow in my backyard*. Since the consultants that have not smelled *that specific* type of ripe strawberry they could not know how it smells, therefore the only smell that could come to their mind would be that of *another variant* of ripe strawberry that they have a memory of. Thus, a very precise and specific description in words would not be sufficiently intelligible for consultants to identify the correct olfactory sign. To continue the color analogy, *the color of the ball I played with as a child* is a precise description but would not be sufficiently intelligible.

Besides this, it seems that description in words do not describe the actual olfactory sign, but rather tends to describe the object emitting that scent. As seen in the constructed examples above, they all describe the object and not the actual sign in question. What if something else smelled as ripe strawberries? What if my car has the same color as the ball I played with? In relation to colors we have named them, the ball was red as is my car. However, this common nomenclature has not been found in relation to scents.

It follows, that if allowing description in words it would only be the categorizing aspect of that could be used in the EU, to give a consultant of the register a hint that a part of that category is protected. However, this is not satisfactory because a method of determining the exact scope and identity would still be needed and the other method of representation must fulfill the Sieckmann criteria on its own, according to case law. This is seen in relation to colors and a generally recognized color code accompanied with a description in words.

3.2.2 Deposited Sample

As the research shows, problems with determining the scope of protection in the US are expected to be handled in future infringement proceedings. Since rights in the EU are based on and acquired by a registration, that registration must provide for an exact description to precisely identify the mark and to determine the scope of protection. The use-based system of the US offers more flexibility because the scope of protection can be determined on a case by case basis if a subsequent sign is considered by a proprietor to be infringing his senior rights.

It is obvious that transplanting the solution of determining the scope of protection in future infringement proceedings is not possible in the EU because it would transform the entire system from a registration-based to a use-based, which has no support in the statutes.

From Sieckmann we learned that a deposited sample was not considered a graphical representation. This requirement is, as already mentioned, abolished today and a sign is permitted to be represented in any appropriate form as long as it fulfills the Sieckmann criteria. A deposited sample would represent the exact sign registered, which would serve the aim of enhanced legal certainty by allowing this more specific representation. It would be as accessible as the register has been historically. No instruments or gadgets would be required to experience the olfactory sign other than the consultant's own senses. Meaning that a deposited sample would fulfill most of the criteria.

Objections that could be expected against allowing a sample are still those relating to durability and possibly accessibility. The study did not show why a sample must be durable for an indefinite time, other than this is the possible amount of time that a trademark could be protected in theory. From the US we learned that despite the theoretical indefinite protection of a trademark samples can be deposited. Due to the expected lifespan of a fragrance to be 3-5 years, a sample must be re-deposited before the scent is gone. In addition to amending EUTMIR 3(9), by allowing for sample deposit and sample renewal, the infrastructure for storing and exhibiting deposited samples is needed. This would solve the issue of durability; however, the structure of the EU system today, do not allow for this, as is illustrated by the amendments needed.

In relation to the accessibility of a deposited sample with the EUIPO it is obviously not as accessible as the e-filing system allows for. However, it is not less accessible than the register has been historically, before the possibility of e-filing. Today, a sample is not considered proper representation.

3.2.3 Considerations Comparative Study

Even if olfactory signs face the same difficulties when seeking protection in the two legal systems, the difficulties are handled on different levels of the system. As seen, the US allows for a deposited sample and a description in words to be the representation seen on the register. However, this representation serves different purposes in the two legal systems. In the US the representation is merely evidence of rights, while in the EU the rights conferred by a trademark are created by the representation on the register. Rights are created by use in the US, and

ultimately, they are determined during a process of discovery when the proprietor shall present evidence for the use that will serve as base for the scope of protection.

Should the EU accept the method for representing an olfactory sign in the US, many amendments would be necessary. Legislative changes to accept submitting samples and the deposition of a renewed sample when the old one is wearing off would be needed. In addition to this, infrastructure at offices around the Union to allow consultants to perceive the olfactory sign would be needed. This would be a step in the wrong direction regarding accessibility, since all the other signs now are available to be reproduced from the EUIPO website. These changes would ultimately change the very nature of the trademark system as it is today and would not be suitable given the direction of development that the EU trademark system seem to be headed in.

The foundational differences between the trademark systems seem to hinder a direct transplantation of solutions for registering olfactory signs in the EU. The concern of the US trademark system seems to be more with acquired distinctiveness and the actual use of the sign, whilst in the EU the concern is legal certainty and a sound administration of the system. The strict Sieckmann criteria may very well have been put in place to settle the worries that too broadly defined unconventional trademarks may be registered. However, business reality seems to continue to push in a direction for possible protection. Consequently, it is still relevant to seek a solution, albeit, the pragmatics of the US might impose too much change for the EU trademark system to handle.

3.3 Possible Solutions Found with Other Unconventional Signs

This section will present findings on how other unconventional signs have mastered the seven-tier test set out in the Sieckmann judgment. It will be discussed how those solutions may or may not apply to olfactory signs.

3.3.1 Colors

When registering a color per se it shall be represented by submitting a reproduction of the color and an indication of that color by reference to a generally recognized color code. As seen from the research this is not understood as neither intelligible nor accessible, however, easily intelligible and sufficiently accessible. These color designation systems are not exhaustive, the consist of a limited number of colors and shades of colors exist that do not correspond with a designated code in the system. Therefore, it can be assumed that it would not be required of a scent catalogue to be exhaustive.

Both color vision and sense of smell are complex processes occurring when the brain processes data received by the different receptors. For it to be possible to construct an internationally accepted designation code for scents, the information perceived by the olfaction must be categorized. Concluded from this study is that colors and scents are perceived with senses of different complexity, thus, they would need different methods of categorization.

When faced with the number of a color from this system, one still needs to consult an additional register to fully understand the actual color hiding behind that number. This means, that even if an internationally accepted code would be submitted to the Court as representing an olfactory sign, it probably would not be accepted. This because the same problem of intelligibility would exist, because to fully experience the scent one would have to reproduce it according to a mixing guide.

Even if a generally recognized scent code was created, the reproduction of that olfactory sign would still face technological problems. In the case of a color, a simple computer screen can create reproductions of colors from designation codes. When considering olfactory signs, a more advanced machine is needed. As seen, it is not likely that such a machine would be considered accessible.

3.3.2 Sounds

A sound mark shall be represented by submitting an audio file reproducing the sound or by an accurate representation of the sound in musical notation. An audio file can be seen as instructions sent to a loudspeaker which in turn reproduces the instructed frequencies by moving back and forth, pumping sound waves into the air. In articles, this is seen similar to electronic instructions for reproducing a scent. The musical notation can be viewed as representing the components of a sound sign.

In some articles, musical notation was compared to a GC/MS graph or another method for translating scents into pictures or sounds, which shows the components of an olfactory mixture. Even if these methods have not been scrutinized by the ECJ, OHIM rejected them as unintelligible. These methods may in theory resemble being to olfactory signs what musical notation is to sounds, however, differences in the reproduction can be discerned. Because of this, and the following reasons, it seems likely that also the ECJ would reject this method of representation.

Foundations of music is taught in elementary schools and each human possesses an instrument for reproducing sounds, albeit with different accuracy, the voice. These factors radically

improve the accessibility and intelligibility in decipher musical notation. Even if previous encounters of a sound sign have not occurred, a consultant can easily reproduce it on the basis of musical notation. In relation to scents, little if nothing is taught in elementary school about reproducing them and the human olfaction can only perceive scents and not reproduce them outside the brain. It follows that a consultant must previously have encountered the scent to make this reproduction in the brain, a memory connection of a previous smell. This makes these translation methods only useful for comparing similarities between olfactory signs, and not perceiving them as reproduced on the register.

The advancements of digital scent technology have also been discussed in other articles, many of them a few years old today. They foresaw a development in the area that would make it possible to have a so-called scent speaker at home. This future is today, however very limited. Unlike sounds, a scent cannot be created “out of thin air”. It follows, that for such an apparatus to emit olfactory signs on the basis of instructions from the register, the consultant would have to have access to hundreds of chemicals, many of which private persons are not allowed to possess, to reproduce only a single sign. This cannot be considered sufficiently accessible. The limit of commercially available scent speakers has been found to be somewhere around 7 cartridges of substances that can be mixed for different scents. This is much more limited than what is used in commercial scents.

The author is not ruling out the possibility for these scent speakers to develop and work in a home environment. However, the many chemicals used in one scent and the many potential olfactory signs that may be registered, makes it unsuitable, costly and impractical to reproduce them in a home environment. More likely would it be to construct this at EUIPO and its representatives around the union, with the loss of accessibility in the same way as seen in relation to a deposited sample. Albeit not less accessible than before the e-filing system, it might be considered sufficiently accessible.

3.3.3 The Subjective Nature of a Trademark

Different types of signs differ in how abstract they are perceived. The common nomenclature of colors and sounds make them easy to grasp. It could be seen as a scale of abstraction and subjectivity, where scents can be put on the far end being the most abstract and subjective, visible signs on the opposite end, and sounds somewhere in between.

These subjective perceptions constitute no or small problems in relation to conventional types of signs. The observations made in the thesis make it clear that a trademark needs to be

perceived in person to fully be able to, with clarity and precision, identify and determine the scope of protection.

It is certainly so, that environmental factors will affect the perception of a visual mark or a sound mark. A consultant will experience a slight difference in the shades of the mark if the lighting when perceiving the mark is different. Using different loudspeakers or listening in an environment with a lot of background noise would definitely affect the perception of a sound mark. The humidity in the air would affect to some extent both hearing and smelling.

One can never know if two individuals have the same sensory experience of a sign. Even if this is true also for visible signs, they can be pointed at and with ease determined that the same sign is observed by all at the same time. It follows that by pointing at a certain field of a visible sign we can agree what to call it, we have developed a common nomenclature for these situations.

Because of the absence of a common nomenclature in relation to scents, a scent cannot be meaningfully described in words for the purpose of trademark protection. Firstly, when describing a scent, we describe memories of that scent or the object connected to the scent, the scent of an object, and not the scent itself. This is due to lack of common nomenclature. Secondly, even if a common nomenclature would be decided, we have no method that allows us to objectively observe a scent. Should an individual perceive a scent and then describe this with a common nomenclature, it would still not be the scent that is described, it would be the sensory experience, the smell.

Even if there are methods for translating scents into pictures, making a visible comparison between components in different olfactory signs possible, this does not rule out the possibility that only minor differences in concentration of chemicals might have a bigger impact when the sign is perceived.

Environmental factors do also have an affect on how a scent is perceived. This means that even if the exact scent is represented and reproduced, the environmental factors as well as the individual condition of the perceiver must also be reproduced for the perception of the sign to be the same. It could be argued that the objective scent is the same regardless of the environmental factors, and this is probably so. However, it would have little value that the representation is objective and static if the sign is perceived differently every time the register is consulted due to worldly and individual factors, even by the same consultant.

As stated, the essential purpose of trademarks is to indicate origin, further purposes can be seen such as, for instance, avoid consumer confusion, prevent freeriding or protecting the link of association between the mark and the manufacturer. It is argued that *scents* can fulfill the essential purpose of trademarks, but how could the *smell* affect these other purposes? Since a scent could be perceived differently depending on environmental factors or the state of the individual, it is possible that the sensory experience of that scent could trigger memories of a different scent. This is for certain similar to likelihood of confusion.

The two signs that would be compared in a likelihood of confusion test would be the two distinctive scents, the olfactory signs. However, what is causing the confusion is the smell that is perceived by the individual. A common condition that affects the olfactory bulb is a common cold. In other words, the protection of the objective scent would have no practical function if environmental factors affect individuals to the extent that they confuse marks when perceiving them.

It follows from this, that even if technical advances would allow for an intelligible and accessible reproduction of olfactory signs, the many factors affecting the sensory experience would still be present. This could mean that olfactory signs are registered and protected but consumers could potentially still confuse the signs due to the subjective perception of the signs. As stated in the beginning of this section, this is true to some extent for all types of trademarks. However, in relation to other types, in particular, the conventional trademarks, the same level of abstract or subjective perception is not true.

4 Conclusions

The original function of a trademark to indicate origin has been the focus of this study. The research has shown that both systems have a broad interpretation on what could be considered a trademark. A sign, symbol or device; regardless of what it is labeled it has been found that the important aspect is that it conveys information about the origin of the product.

When assessing if a scent conveys information about the origin to a consumer, how consumers normally think about scents is an important argument in both systems. The thesis shows that it is argued in both systems that a product's scent usually is considered an attribute, or even to disguise unpleasant smells. It follows that a scent is considered a characteristic of the product, and as such, descriptive of the product.

Neither systems accept the registration of a merely descriptive sign. An applicant must prove that the consuming public considers the scent to not only give the product a pleasant smell, but also that it conveys information about the origin of the product, so called secondary meaning. When secondary meaning is established, it can be useful to refer to it as an olfactory sign. This is assessed on a case by case basis. When being the only proprietor to scent the products the very use of an olfactory sign is in itself distinctive, thus, less evidence is required to prove acquired distinctiveness. The amount of evidence seems to be dependent on the type of product; as seen by analogy to taste signs, a scent in relation to products that usually are scented to disguise an unpleasant smell would rarely be considered an indication of origin.

When the scent fulfills a function, as the scent of lemon in relation to household products does to leave a fresh and pleasant smell after cleaning, not even a scent with acquired distinctiveness could be registered in neither of the systems. Both systems justified this by arguing that this would give the proprietor a non-reputation related advantage that is not desirable.

When considering representation of the olfactory sign on the register, differences in what is accepted was found. The US trademark system requires a sample of the trademark as used on the product in commerce, and it is allowed with a description in words. Both these methods of representation face resistance when used in the EU; a sample is not deemed durable, a description in words is seldom clear and precise enough because it is often imbued with subjective factors. The US trademark system must allow a sample because the registration system is based on common law rights, thus, the system cannot protect signs that are not used and the sample is evidence of use in commerce. The US trademark system can allow flexible description of the mark because the rights are not to be determined on the basis of the register.

The thesis has shown that the fundamental differences between the EU and the US trademark systems comprises a bar to direct transplantation of solutions. The solutions found for registering olfactory signs in the US are rooted in the common-law mindset that rights are created from use and the register is only evidentiary in relation to those rights. This gives the trademark register in the US a sort of flexibility regarding what information must be available on the register. As mentioned, the purpose of the register is evidence of rights and the exact scope of protection is determined during a process of discovery in potential proceedings regarding opposition or infringement for example.

When the rights are determined on the basis of the register, the flexibility found in the US cannot be allowed. As the ECJ has stated, it would affect the sound administration of the

trademark system and legal certainty. Thus, to uphold the trademark system it is required that the mark is reproduced on the register, this is linked to the criterion of intelligibility. From the comparison it seems that this requirement of reproduction is what is barring registration for olfactory signs today.

Methods for representing an olfactory sign that exists today, however, they do not allow for a sensory experience of the olfactory sign. If a consultant has not smelled the scent prior to consulting the register, the consultant of the register can have no understanding of the actual sign, thus lacking in intelligibility. An adequate method of reproduction on the register is missing. Even if many methods to reproduce scents are available, they often lack in accessibility. In addition to this, because of the absence of a standardized method for identification and reproduction of scents, the objectivity cannot be secured.

With other unconventional trademark, such as colors and sounds, methods for representing and reproducing the mark on the register are accepted and fulfills the Sieckmann criteria.

In relation to colors, a generally accepted designation code is accepted as representation. When considering such code for olfactory signs it could fulfill the criteria of objectivity, clarity and preciseness. However, a designation code is basically nothing else than an agreed upon nomenclature. Given that a description in words often is imbued with subjective factors or otherwise lacking in clarity or precision, a generally accepted designation code may remedy that. However, even from a clear, precise and objective description in words a consultant cannot understand the olfactory sign without prior experience of it. Changing the words to numbers in a designation system will not add to the understanding of the sign. Why this system works for colors is because the designated code can easily be translated and reproduced on the monitor that is used for the consultant to have a sensory experience of the color mark, something that is not sufficiently developed in relation to olfactory signs today to meet the criteria for sufficient representation.

In relation to sound, the mark shall be represented by submitting an audio file reproducing the sound or by an accurate representation of the sound in musical notation. When considering these methods regarding olfactory signs we see that a musical notation can be compared with the generally accepted designation code for colors; a common nomenclature for sounds. This nomenclature is generally understood amongst the citizens, even if not immediately intelligible this is considered easily intelligible. As seen above, using a common nomenclature does not

solve the issue with olfactory signs because something more is needed to allow for a sensory experience.

A submitted audio file of a sound mark can be seen as digital instructions for a loudspeaker to perform a certain task. Similar machines called scent speakers exist on the market; however, the complexity of a scent puts higher demands on those machines than is needed to create a sound. It follows that the generally available scent speakers are not advanced enough to reproduce the many number of complex olfactory signs that potentially could be registered.

Considering the complex nature of a scent, and the fact that it is seen as merely descriptive of the goods, the use-based trademark system in the US was found to be more favorable for registering olfactory signs. The pragmatic view and the focus on the sample of the trademark as foundation for the rights conferred seem to work in favor of olfactory signs. This because the abstract nature and complex composition of scents does not seem to allow them to be represented in a static and objective way that is required for legal certainty and a sound administration of a register-based trademark system as in the EU. Too many factors seem to affect the sensory experience of a scent, making the smell that is perceived not objective in time, not even to the same perceiver. In the light of this research, it is suggested that olfactory signs might not be suitable for registration in the EU without significantly altering the trademark system, even if technical advances make reproduction more accessible.

References

Legal rules and Regulations

Council Regulation (EC) No 207/2009 of February 26 2009 on the Community Trademark, (2009) OJ L 78/1.

Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark, (2017) OJ L 154/1. [cit. The Regulation or EUTMR]

Commission Implementing Regulation (EU) 2017/1431 of 18 May 2017 laying down detailed rules for implementing certain provisions of Council Regulation (EC) No 207/2009 on the European Union trade mark, (2017) OJ L 205/39. [cit. EUTMIR]

Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks, (1989) OJ L 040/1.

Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks, (2015) OJ L 336/1.

United States Code Annotated, Title 15, chapter 22, (Westlaw through P.L. 115-90). [cit. 15 U.S.C.A]

Code of Federal Regulations, Title 37, (Westlaw through 2018; 83 F.R. 7922). [cit. C.F.R. T. 37]

Guidelines

United States Patent and Trademark Office, *Trademark manual of examining procedure*, issue of 14 January 2017, Washington, D.C.: Dept. of Commerce, Patent and Trademark Office. [cit. TMEP]

European Union Intellectual Property Office, *Guidelines for examination in the Office*, issue of 1 October 2017 final. [cit. The Guidelines]

Literature

Aplin, Tanya Frances & Davis, Jennifer (2013), *Intellectual property law: text, cases, and materials*, 2. ed., Oxford: Oxford University Press. [cit. Aplin et al. 2013]

Bogdan, Michael (2003), *Komparativ rättskunskap*, 2 ed., Stockholm: Norstedts juridik. [cit. Bogdan 2003]

Halpern, Sheldon W., Seymore, Sean B. & Port, Kenneth L. (2015), *Fundamentals of United States intellectual property law: copyright, patent, and trademark*, 5. ed., Alphen aan den Rijn: Kluwer Law International. [cit. Halpern et al. 2015]

Handelman, Jeffrey A. (2017), *Guide to Trademark Trial and Appeal Board Practice*, New York: Wolters Kluwer.

Hunter, Dan (2012), *Intellectual property [Electronic resource]*, New York: Oxford University Press. [cit. Hunter 2012]

Kur, Annette & Dreier, Thomas K. (2013), *European intellectual property law: text, cases and materials*, Cheltenham: Edward Elgar. [cit. Kur & Dreier 2013]

Michaels, Ralf (2006), *Chapter 10: The Functional Method of Comparative Law*, in Reimann, Mattias, & Reinhard, Zimmermann (editor) (2006), *The Oxford Handbook of Comparative Law* (pp. 339-382), New York; Oxford University Press.

Pila, Justine & Torremans, Paul L.C. (2016), *European intellectual property law*, Oxford: Oxford University Press. [cit. Pila & Torremans 2016]

Seville, Catherine (2016), *EU intellectual property law and policy [Electronic resource]*, 2 ed., Cheltenham: Edward Elgar. [cit. Seville 2016]

Valguarnera, Filippo, *Kapitel 6: Den komparativa metoden*, in Korling, Fredric & Zamboni, Mauro (editor) (2013), *Juridisk metodlära* (pp. 141–174), 1 ed., Lund: Studentlitteratur. [cit. Valguarnera 2013]

Zweigert, Konrad & Kötz, Hein (1998), *Introduction to comparative law*, 3. rev. ed., Oxford: Clarendon. [cit. Zweigert & Kötz 1998]

Journal Articles

Karapapa, Stavroula (2010), *Registering Scents as Community Trade Marks*, *The Law Journal of the International Trademark Association*, vol. 100 No 6 2010, pp. 1353-1354. [cit. Karapapa 2010] available at INTA: http://www.inta.org/TMR/Documents/Volume%20100/vol100_no6_a3.pdf. [Accessed 2017-10-10]

Kim, H., Park, J., Noh, K., Gardner, C. J., Kong, S. D., Kim, J. and Jin, S. (2011), *An X–Y Addressable Matrix Odor-Releasing System Using an On–Off Switchable Device*, *Angewandte*

Chemie International Edition, vol. 50 issue 30, pp. 6771–6775. doi:10.1002/anie.201102759, available at Wiley: <http://onlinelibrary.wiley.com/doi/10.1002/anie.201102759/full>. [Accessed 2018-01-12]

Kur, Annette (2012), *Convergence After All? A Comparative View on the U.S. and EU Trademark Systems in the Light of the “Trade Mark Study”*, 19 Journal of Intellectual Property Law 305, pp. 306-324. Available at University of Georgia: <http://digitalcommons.law.uga.edu/cgi/viewcontent.cgi?article=1069&context=jipl>. [Accessed 2017-11-28]

Port, Kenneth L. (1994), *The Unnatural Expansion of Trademark Rights: Is a Federal Dilution Statute Necessary?*, Seton Hall Legislative Journal, Vol. 18, pp. 434-488; William Mitchell Legal Studies Research Paper, Available at SSRN: <https://ssrn.com/abstract=1717981>. [Accessed 2017-12-15]

Reports

Arden, Thomas P. (2000), *Protection of nontraditional marks: trademark rights in sounds, scents, colors, motions and product design in the U.S.*, New York: INTA. [cit. Arden 2000]

Bell, Stephen, Porter Bell, Coley, *Future Sense: defining brands through sense*, Market Leader: the journal of the marketing society, issue 38 (2007), pp. 60-62. [cit. Bell & Bell 2007]

European Commission, COM(2013) 0161 final, *Proposal for a Regulation of the European Parliament and of the Council amending Council Regulation (EC) No 207/2009 on the Community trade mark*.

Vlahos, James, *Scent and Sensibility*, sept. 9 2007, New York Times.

Max Planck Institute for Intellectual Property and Competition Law (2011), *Study on the Overall Functioning of the European Trade Mark System*, Munich. [cit. The Trademark Study]

Trademark Review Commission, *Report & Recommendations*, 77 Trademark Rep. 375, (Sept.-Oct.1987).

United States Patent and Trademark Office, *Performance and Accountability report*, fiscal year 2017.

Senate Report No. 515, 100th Congress, 2ND Session, (1988).

Web Pages

Patel, Shareena, (2015-12-10), <http://www.printpower.eu/UK/Scent-Marketing-can-increase-perception-of-a-brands-advertising-by-19>. [Accessed 2017-11-13]

<http://www.scentisphere.com/scent-activation.html>. [Accessed 2017-11-13]

<http://www.feelreal.com>. [Accessed 2017-11-13]

<http://www.microfab.com/vapor-generation/aromajet>. [Accessed 2017-11-14]

<http://www.fragrancesoftheworld.com/FragranceDatabase>. [Accessed 2017-11-13]

<http://www.basenotes.net/fragrancereviews/>. [Accessed 2017-11-13]

<https://www.liveabout.com/common-perfume-ingredients-a-to-z-list-346106>. [Accessed 2017-12-12]

Case law

EU

Judgment of 23 May 1978, *Hoffman-La Roche v Centrafarm*, C-102/77, EU:C:1978:108.

Judgment of 29 September 1998, *Canon*, C-39/97, EU:C:1998:442.

Judgment of 4 May 1999, *Windsurfing Chiemsee*, C-108/97, EU:C:1999:230.

Judgment of 18 June 2002, *Philips*, C-299/99 EU:C:2002:377.

Judgment of 12 December 2002, *Sieckmann*, C-273/00, EU:C:2002:748. [cit. Sieckmann]

Judgment of 8 April 2003, *Linde*, C-53/01, EU:C:2003:206.

Judgment of 6 May 2003, *Libertel*, C-104/01, EU:C:2003:244. [cit. Libertel]

Judgment of 27 November 2003, *Shield Mark*, C-283/01, EU:C:2003:641. [cit. Shield Mark]

Judgment of 12 February 2004, *Postkantoor*, C-363/99, EU:C:2004:86.

Judgment of 24 June 2004, *Heidelberger*, C-49/02, EU:C:2004:384.

Judgment of 21 October 2004, *OHIM v Erpo Möbelwerk*, C-64/02P, EU:C:2004:645.

Judgment of 27 October 2005, *Eden v OHIM*, T-305/04, EU:T:2005:380. [cit. Ripe Strawberries]

Judgment of 25 January 2007, *Dyson*, C-321/03, EU:C:2007:51. [cit. Dyson]

Judgment of 24 October 2007, *Henkel*, C-144/06 P, EU:C:2007:577. [cit. Henkel]

Judgment of 18 June 2009, *L'Oréal and Others*, C-487/07, EU:C:2009:378.

Judgment of 21 January 2010, *Audi v OHIM*, C-398/08P, EU:C:2010:29.

Judgment of 14 September 2010, *Lego Juris v OHIM*, C-48/09P, EU:C:2010:516.

Judgment of 29 September 2010, *CNH Global v OHIM*, T-378/07, EU:T:2010:413.

Judgment of 18 September 2014, *Hauck*, C-205/13, EU:C:2014:2233.

Decision of the Second Board of Appeal of 11 February 1999, *The smell of fresh cut grass for tennis balls*, R 156/1998-2, application No 428 870. [cit. Fresh cut grass]

Decision of the Second Board of Appeal of 4 August 2003, *The taste of artificial strawberry*, R 120/2001-2, application No 1 452 853.

Decision of the Third Board of Appeal of 5 December 2001, *The Scent of Raspberries*, R 711/1999-3, application No 1 222 090.

Decision of the Fourth Board of Appeal of 19 January 2004, *a hint of green lawn, hesperidia (bergamot, lemon), flowers (orange blossom, jacinth) roses, musk*, R 186/2000-4.

Opinion of 6 November 2001, *Sieckmann*, C-273/00, EU:C:2001:594.

US

Trademark Cases, 100 U.S. 82 (1879).

Inwood Laboratories, Inc. v. Ives Laboratories, Inc., 456 U.S. 844 (1982).

Park 'N Fly v. Dollar Park and Fly, Inc., 469 U.S. 189 (1985).

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

In re ECCS, Inc., 94 F.3d 1578 (Fed. Cir. 1996).

In re Owens-Corning Fiberglas Co., 774 F.2d 1116 (Fed. Cir. 1985). [cit. Owens-Corning]

Valu Eng'g, Inc. v. Rexnord Corp., 278 F.3d 1268 (Fed. Cir. 2002).

Scandia Down Corp. v. Euroquilt, Inc., 772 F.2d 1423 (7th Cir. 1985).

Sherrell Perfumers, Inc v. Revlon, Inc., et al., 483 F. Supp. 188 (S.D.N.Y. 1980).

In re Morton-Norwich Products, Inc., 213 U.S.P.Q. 9 (Cust. & Pat. App. 1982).

In re DC Comics, Inc., 215 U.S.P.Q. 394 (Cust. & Pat. App. 1982).

In re Star Pharmaceuticals, Inc., 225 U.S.P.Q. 209 (T.T.A.B. 1985).

In Re Clarke, 17 U.S.P.Q.2d 1238 (T.T.A.B. 1990). [cit. Clarke 1990]

In re N.V. Organon, 79 U.S.P.Q.2d 1639 (T.T.A.B. 2006). [cit. Organon]

In re Pohl-Boskamp GmbH & Co., 106 U.S.P.Q.2d 1042 (T.T.A.B. 2013).

Trademark Applications

Celia Clarke, *The mark is a high impact, fresh, floral fragrance reminiscent of Plumeria blossom*, US application serial No 73758429, (USPTO 1988). [cit. Clarke 1988]

The Smead Manufacturing Company, *The mark consists of an apple cider scent or fragrance*, US application serial No 78649230, (USPTO 2005).

The Smead Manufacturing Company, *The mark consists of a peppermint scent or fragrance*, US application serial No 78649175, (USPTO 2005).

Mike Mantel DBA Manhattan Oil, *The mark consist of the grape scent of the goods*, US application serial No 77179347, (USPTO 2008).

Cellco Partnership, *The mark consists of a flowery musk scent*, US application serial No 86122975, (USPTO 2013). [cit. Verizon]

Grendene, S. A., *The mark consists of the scent of bubble gum*, US application serial No 86265443, (USPTO 2014). [cit. Grendene]

Novagraaf Nederland B.V., *The mark represents the smell of an amber, woody aroma with Virginia tobacco undertones and a mace topnote*, EU application No 000566596, (EUIPO 1997).

Novagraaf France, *The trade mark is a graphic representation of a particular fragrance. A lawn green note, citrus (bergamot, lemon), pink floral (orange blossom, hyacinth), musky*, EU application No 000521914, (EUIPO 1997).

Note: Jag, Robin Klingberg, registrerades på kursen första gången HT17. Jag har inte tidigare deltagit vid något examinationstillfälle.