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REGISTERING SCENTS AS COMMUNITY TRADE MARKS

By Stavroula Karapapa*

I. INTRODUCTION

The registration of scents as Community trade marks (CTMs) has been much debated in the wake of the landmark 2002 case, Sieckmann v. Deutsches Patent-und Markenamt.1 While this case established criteria for the trademark registration of scents that appear difficult to satisfy, the possibility of registering scents as trademarks continues to represent a great potential for industry. Indeed, scents have long been used on the market in a commercial context2 to strengthen product recognition by consumers belonging to different cultural backgrounds.3 This is probably because of the unique function of olfaction, which, as opposed to the other human senses,4 has an unparalleled ability to evoke memories. This so-called Proustian memory5 has a rapid impact on the subconscious and the power to generate strong memory associations. Through

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4. Olfaction is privileged compared with the other senses, as it is directly linked with the limbic system of the brain, which in turn connects to the amygdala (the emotion centre) and the hippocampus (the memory centre). While messages involving other senses have a circuitous route so that a conscious evaluation is necessary in order to produce a response, the olfactory system evokes, automatically and unconsciously, memories and emotional responses. See, e.g., Marguerite Holloway, The Ascent of Scent, 11 Sci. Am., Nov. 20, 1999, at 28; see also David H. Zald & José V. Pardo, Emotion, Olfaction and the Human Amygdala: Amygdala Activation during Aversive Olfactory Stimulation, 94(8) Proc. of the Nat’l Acad. Sci. of the U.S.A. 4119 (1997); Suzanne Christiansen, The Coming Age of Aroma-Chology, Soap, Cosmetics, Chemical Specialties, April 1991, at 31; Jean-Francois Blayn et al., Questions de Parfurmerie: Essais Sur l’Art et la Creation en Parfurmerie 13, 24 (Paris: Corpman Editions, 1988).
olfactory trademarks, companies seek to gain legal control of the memory association of smells to products.

Indeed, it is neither a scent as such nor its formula that may be eligible for trademark protection. The formulae of perfumes and fragrances are most commonly reserved as trade secrets or may alternatively be protected through patents. In the Netherlands, the liquid or other substance emitting the scent may benefit from copyright protection. Under trademark laws, however, it is the association of smells to products or services that may be protected. As is the case with other non-conventional marks, such as shapes and colours, the registration of a smell as a trademark gives the owner a sort of indirect monopoly on the substance itself. A trademark creator is granted protection for isolating an appropriate olfactory sign from the existing common sensory “wealth” and transforming it into a symbol, which performs a trademark function by its association with products or services.

The instances in Europe where trademark protection of scents has been granted are surprisingly limited; at the Community level, there has so far been only one olfactory trademark registered, for the “smell of fresh cut grass” for tennis balls. While this solitary registration may have briefly raised the expectations of trademark applicants in registering scents, things changed with the Sieckmann case in 2002. In this case, a scent described as “balsamically fruity with a slight hint of cinnamon” for services in

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9. Id. at 164.


Classes 35, 41, and 42\textsuperscript{12} was refused registration. The core argument behind this refusal was the failure to adequately represent the scent graphically, as required by the CTM Regulation. The applicants had filed a verbal description of the scent as well as a chemical formula and a scent sample. The European Court of Justice (ECJ) ruled that none of these methods of representation nor their combination satisfied the requirement of graphic representation. The Court went on to confirm that a trademark may indeed consist of a sign that cannot be perceived visually, if the sign can be “represented graphically by means of images, lines or characters,” given the representation is “clear, precise, self-contained, easily accessible, intelligible, durable and objective.” In the wake of the \textit{Sieckmann} case, many commentators have argued that the possibility of registering smells as trademarks has been precluded.\textsuperscript{13}

The question has since been often asked whether olfactory trademarks are practically viable within the framework of CTM protection. And while several objections have been raised as to the viability of scents as trademarks, this question strikes at the heart of three critical issues on which trademark registrability is premised. The first is that non-visual signs are not expressly excluded from the definition of \textit{trademark}. Does this amount to an endorsement of their inclusion? The second is that, while trademarks should primarily function as badges of origin,\textsuperscript{14} it is not easy to establish that scent marks are capable of fulfilling this function. Many products on the market are scented, so the question of whether scents can function as trademarks (i.e., as origin indicators) is highly controversial. The third is that, even if olfactory marks are signs capable of functioning as distinguishers in a trademark sense, they still need to satisfy the graphic

\textsuperscript{12} Class 35: Advertising; business management; business administration; office functions.

Class 41: Education; providing of training; entertainment; sporting and cultural activities.

Class 42: Providing of food and drink; temporary accommodation; medical, hygienic and beauty care; veterinary and agricultural services; legal services; scientific and industrial research; computer programming; services that cannot be placed in other classes.


\textsuperscript{14} Amanda Michaels, A Practical Guide to Trademark Law 1.3-1.6 (London: Sweet & Maxwell, 3d ed. 2002).
representation requirement\textsuperscript{15} to be registered as trademarks in Europe. With respect to scents, however, the fulfilment of this requirement is contestable; scents lack visual perceptibility and, because of the lack of objective smell recorders, they cannot easily be translated into paper form as required by the law. In fact, most of the attempts to graphically capture the olfactory intangible have so far failed.\textsuperscript{16}

This article provides answers to the aforementioned questions through an examination of the legal issues that arise in relation to the registration of scents as CTMs. In particular, it synopsises and comprehensively reviews the main arguments against scent-mark registrability and provides guidance as to how scents can be registered as trademarks in Europe. The main points that are discussed are the conditions under which scents are capable of functioning as trademarks and the possible ways scents can be graphically represented for the purposes of trademark protection within the meaning of Directive 2008/95/EC (Trademark Directive)\textsuperscript{17} and Council Regulation (EC) 207/2009 (Community Trade Mark Regulation—CTMR).\textsuperscript{18}

II. THE ELIGIBILITY OF SCENTS FOR REGISTRATION AS TRADEMARKS

To be eligible for CTM protection, scents must fall within the definition of \textit{trademark} according to the CTMR and be able to function as such.

\textbf{A. Scents as Subject Matter of Trademark Law}

Apart from the Trademark Law Treaty,\textsuperscript{19} which expressly excludes olfactory marks from its scope of application, all other international agreements, conventions, and treaties provide broad

\begin{enumerate}
\item \textit{See} Article 2(1)(b) of the Trademark Law Treaty adopted at Geneva on Oct. 27, 1994: “This Treaty shall not apply to hologram marks and to marks not consisting of visible signs, in particular, sound marks and olfactory marks.”
\end{enumerate}
and non-specific definitions of the registrable subject matter under trademark law. The Paris Convention, for instance, does not provide a specific definition of the term *trademark* and leaves the contracting parties free to incorporate relevant specifications in their domestic laws. The Madrid Agreement and the Madrid Protocol remain silent, whereas the Agreement on Trade-Related Aspects of Intellectual Property Rights 1994 (the TRIPS Agreement) remains neutral by stating that the contracting parties may provide that only visually perceptible signs are eligible for protection. This means that the registration of scents as trademarks is not *ab initio* excluded.

At the European level, the CTMR provides a rather broad definition of what can potentially constitute a trademark. Article 4 of this Regulation provides that a trademark may consist of:

> any signs capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.

At first blush, all the examples of acceptable signs listed in the definition of CTM refer to visually perceptible insignia. However, the use of the word *particularly* in this definition suggests that the

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21. *Id.*, Art. 6(1): “The conditions for the filing and registration of trademarks shall be determined in each country of the Union by its domestic legislation.”
24. See Art. 15(1) of the TRIPS Agreement: “Any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark. Such signs, in particular words including personal names, letters, numerals, figurative elements and combinations of colours as well as any combination of such signs, shall be eligible for registration as trademarks. Where signs are not inherently capable of distinguishing the relevant goods or services, Members may make registrability depend on distinctiveness acquired through use. Members may require, as a condition of registration, that signs be visually perceptible.”
26. Identical to this definition was one provided earlier by Article 2 of the Trademark Directive, which approximated the substantive trademark laws of the Member States with a view to enhancing the effective operation of the single market. Directive 2008/95, *supra* note 17.
list of the signs mentioned is not a *numerus clausus*;\(^{27}\) rather, it has a merely explanatory character.

In this light, it is essential to determine the notion and scope of the term *sign*. The term has not been defined under CTM law. As Sandri and Rizzo point out, a *sign* is any element that also represents something other than itself.\(^ {28}\) Inherent in this concept is the capacity of a sign to convey a message; such message, however, is not communicated only through visual symbols. Both visual and sensory mechanisms have the capacity to convey information. This is affirmed by the Official Commentary to Article 3 (later Article 4) of the Proposal for the CTMR, which states that “no category of signs is excluded *a priori* from registration as a Community Trademark.”\(^ {29}\) In *Myles Ltd*,\(^ {30}\) the Office for the Harmonisation of the Internal Market (OHIM) explicitly took the stance that the olfactory mark functions as a communication instrument operating through a human being’s sensorial perceptions.\(^ {31}\) In this light, scents were considered to constitute signs for the purpose of CTM protection.

But even if scents qualify as signs eligible for trademark protection, their extensive use in the market inevitably raises the question of whether they are capable of functioning as trademarks. This issue is examined below.


\(^{28}\) Stefano Sandri & Sergio Rizzo, Non-Conventional Trade Marks and Community Law 5 (Marques: The Association of European Trademark Owners, 2003). For some interesting considerations on what constitutes a sign eligible for trademark protection, see Libertel Groep BV, Case C-104/01, id., and Heidelberger Bauchemie GmbH, Case C-49/02, id.

\(^{29}\) Official Commentary, Doc. 1-682/80 COM (80) 635 of Nov. 19, 1980. The registrability of non-visual signs is also admitted by the ECJ. See Sieckmann, Case C-273/00, and Shield Mark, Case C-283/01.

\(^{30}\) Myles Ltd.’s Application (for the scent of raspberries), R 711/1999-3, [2003] ETMR 56.

\(^{31}\) Id., § 25 (note, however, that in this case the Office refused registration because of lack of distinctive character).
CTMs are considered to be multifunctional. They are badges of origin, indicators of consistent quality, and information conveyors. The utility of this information is judged on the basis of the distinctiveness of each mark; in order to fulfill its primary function—namely, the indication of origin—and, consequently, the other functions, a trademark must be distinctive.

It is questionable whether scents affixed to products can function as trademarks. Practice indicates that scents affixed to products that are not normally scented would stand a greater chance of being considered distinctive. Examples of successful registrations of this type of scent in the United Kingdom and the United States include the “smell of fresh cut grass” for tennis


33. Art. 4 of Regulation 207/2009, supra note 18: “A Community trade mark may consist of any signs capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.” Art. 2 of Directive 2008/95, supra note 17: “A trade mark may consist of any sign capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.” As badges of origin, trademarks are not to guarantee that the products and services emanate from a specific undertaking; rather they are meant to certify that these products or services originate from the same manufacturer, regardless of his identity. Opinion of Advocate General Cosmas in Windsurfing Chiemsee Produktions- und Vertriebs GmbH v. Boots- und Segelzubehör Walter Huber and Another, [1999] ECR I-02779, § 27.

34. The link between the trademark and an identifiable level of quality enables the trademark owner to create in the mark a certain level of consumer goodwill. The latter gives the mark its modern commercial value and also motivates firms to develop and maintain consistent quality.

35. Opinion of Advocate General Colomer, supra note 7, § 19.

This issue has also been discussed in recent decisions of the ECJ where further functions have been developed: communication, investment, and advertising. In this respect, see L’Oréal SA v. Bellure, Case C-487/07, OJ C 180/6 of Aug. 1, 2009. See also joint cases Google France, Google Inc. v. Louis Vuitton Malletier, C-236/08, Google France v. Viaticum Luteciel, C-237/08, and Google France v. CNRRH Pierre-Alexis Thonet Bruno Raboin Tiger, a franchisee of Unicis, C-238/08, OJ C 134 of May 22, 2010, at 2. See also Die BergSpechte v. Günter Gunz, Case C-278/08, OJ C 134 of May 22, 2010, at 3.

36. Sandri & Rizzo, supra note 28, at 18. The distinctiveness requirement is laid down under Articles 4 and 7 of Regulation 207/2009, supra note 18. For an analysis of this requirement, see Annette Kur, Fundamental Concerns in the Harmonisation of (European) Trademark Law in Dinwoodie & Janis (eds.) Trademark Law and Theory 151, 159 (Edward Elgar Publishers, 2008); see also Michaels, supra note 14, at 2.1.
balls, the “scent of roses” applied to tyres, the “strong smell of bitter beer” applied to flights for darts, and the “scent of strawberry, grape or cherry” for motor fuel. The capacity of olfactory marks to function as trademarks and the conditions under which scents have or can acquire distinctive character through use are examined below. This examination shall go through the specific objections raised against the capacity of scents to function as trademarks.

1. Olfactory Marks and Distinctiveness

The distinctive features of products enable consumers to locate them, even where they do not remember their name. Such features can be the packaging, the colours on the packaging, or even the product’s smell. Even if consumers are unable to describe the essence of the smell in words, scents can help them identify the product by stimulating their olfactory memory. To pass the distinctiveness test and be eligible for trademark protection, scent marks should be able to conjure this mental link. As with traditional trademarks, olfactory marks may be distinctive at the time that the application is filed (inherent distinctiveness) or may acquire distinctiveness through use (acquired distinctiveness).

a. Inherent Distinctiveness

By virtue of Articles 4 and 7(1)(b) of the CTMR, a trademark cannot be registered if it is “devoid of any distinctive character.” With respect to olfactory marks, the assessment of distinctiveness depends on the specific combination of the mark with the products in question; a smell may be distinctive in relation to one product but not in relation to another. As a consequence, an examination should take into account the special conditions of each case.

Based on the jurisprudence of the OHIM and the ECJ, one could argue that the fulfilment of the inherent distinctiveness requirement in relation to olfactory marks is possible only when a

41. Hawes, supra note 2, at 143.
42. Id. at 142.
scent is affixed to a normally unscented product or when the scent is particularly unique so as to attract consumer recognition. This is how a mental link would be created in the consumer’s mind. For instance, “the smell of fresh cut grass”\(^{44}\) for tennis balls was found to be distinctive and was, therefore, accepted as a CTM. As the applicant would be the sole manufacturer producing scented tennis balls, consumers could instantly recognise its products.\(^{45}\) On the same grounds, “the strong smell of bitter beer” applied to flights for darts\(^{46}\) and “a floral fragrance/smell reminiscent of roses” applied to tyres\(^{47}\) were allowed registration in the United Kingdom under the provisions of the Trade Marks Act.\(^{48}\)

(1) Generic Olfactory Marks

Even though scents can function as identifiers, as Hawes rightly points out,\(^{49}\) they might be devoid of distinctive character in a trademark context. This occurs when scents consist in generic designations of the goods and services to which they have been applied.\(^{50}\) As with conventional trademarks, a generic identifier is connected to an entire product class and, as such, cannot distinguish specific products within that class. Also, a scent may lose its inherent distinctiveness if it becomes generic through use. For instance, the scent of lemon affixed to washing detergents has become so popular and so commonly used that it must now be considered generic with respect to these products. The popularity of a scent with regard to a product is reinforced by the development of “smell codes”—of which our olfactory civilisation is full—under which certain scents carry and transmit common messages to a great majority of consumers. Once a smell code exists with respect to a scented product, the scent is devoid of

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44. CTM Reg. No. 428870/filing date Dec. 11, 1996.
45. Vennootschap onder Firma Senta Aromatic Marketing’s Application, Case R 156/1998-2, [1999] ETMR 429, at point 6a; see also Jeremy Phillips, Trade Mark Law: A Practical Anatomy 5.121, 5.122 (OUP, 2004). Phillips considers a number of hypothetical scenarios in which the scented tennis balls are sold in a sports shop and concludes that “it will be hard to capitalise on our current understanding as means of determining how the law is likely to apply.”
49. Hawes, supra note 2, at 142.
50. Article 7(1)(b) of Regulation 207/2009, supra note 18; Article 3(1)(b) of Directive 2008/95, supra note 17. These articles concern signs without distinctive character.
distinctive character and becomes a generic feature of a product class.

(2) Descriptive Olfactory Marks

As with generic marks, descriptive marks cannot benefit from trademark protection on the basis that they constitute useful information enabling competitors to sell their products and services. Descriptive marks do not meet the distinctiveness threshold required to identify a consistent manufacturing source; hence, they are excluded from trademark registrability. This principle of trademark law is explicitly stated under Article 7(1)(c) of the CTMR, which lays down an absolute ground for the refusal of registration. Under this article, “trademarks which consist exclusively of signs which may designate intended purpose (or) value” or other relevant characteristics of marked goods or services are banned from registration.

b. Acquired Distinctiveness

The reason for not granting trademark protection to non-distinctive marks is to leave these marks available for use without any hindrance so as to enhance competition in the market. However, marks that are not inherently distinctive may be granted protection when they have acquired distinctiveness through use.

Regarding scent marks, no claims of acquired distinctiveness have been raised so far in Europe. We can draw some conclusions, however, from American examples and see how these can possibly fit into the European trademark context. The criteria for establishing acquired distinctiveness of scent marks in the United States were developed in In re Clarke. Clarke was the sole manufacturer in the market of scented yarns and threads and, as such, his scent mark had acquired distinctiveness over his products through use; the scent of “plumeria blossoms” was found to serve as an origin indicator because consumers who had had

55. Id. at 1240.
prior access to the scent could use it for source recognition and identify the product origin with precision. In this light, the mental association of the scent with the product afforded the scent a so-called secondary meaning. Applying the criteria of the Clarke test in Europe would mean that acquired distinctiveness may be affirmed where the individuality of the market presence of scented products is so strong that the consumer recognizes the smell as an indication of origin of a certain undertaking.

To establish acquired distinctiveness, the applicant must prove that “a significant proportion of the relevant class of persons identify goods as originating from a particular undertaking because of the trade mark.” In the context of olfactory marks, the use of advertisements as evidence of acquired distinctiveness is contestable. In the United States, for instance, the applicant must prove that his promotional efforts were made to lead to the origin of the scent; mere verbal descriptions of olfactory marks do not suffice as proof because they may not be able to convey a given scent to consumers; yet, the use of scented strips in advertisements is considered to constitute sufficient evidence.

2. Scent “Originality”

Both in inherent and acquired distinctiveness, an olfactory mark can function as a product distinguisher and an origin identifier in two main types of circumstances. The first is when the scent is uncommonly or arbitrarily associated with a given product. The second is when the scent is exceptionally unique and remarkable enough to attract consumer recognition. The common denominator here is that scent marks need to meet a sort of “originality” threshold to be protected, despite the fact that trademark law provides no such requirement. This means that signs do not have to be original, imaginative, unusual, or fanciful to be registered; however, marks that meet such a description are simply more likely to perform a distinguishing function compared

58. In In re Clarke, for instance, the advertisement referred to “Clarke’s Distinctive Soft Scented Yarns.” In re Clarke, supra note 54, at 1240.
60. Phillips, supra note 45, at 4.112.
with banal, commonplace, and derivative signs. This is not to say that the ECJ applies different criteria to establish distinctiveness with regard to smells, which is certainly not the case. Because of their very nature, however, scent marks, as opposed to visible signs, may face more difficulties in getting registered and, as a result, may need to be either affixed to a product in a unique way or applied to a given product in an imaginative, original manner. Case law of the ECJ on shape marks indicates that signs different from words and figures possess little inherent capacity of communicating information as to the origin of a product or a service. This means that consumers have greater difficulty perceiving them as badges of origin. The same principle also applies to smells.

In this author’s view, the lack of visibility in olfactory insignia is overcome by a sui generis originality standard for distinctiveness to be established. Certainly, there is a grey area as to the nature and the limits of this standard, as Simon rightly observes. While originality does not flow as a mandatory condition set by law, a mark is unlikely to be considered capable of impressing itself on consumer consciousness as a product distinguisher unless some level of originality exists.

3. Scent Depletion

The “depletion” theory presents yet another obstacle in scent-mark registrability. This theory holds that the number of sensory signs that will be favourably perceived by the consuming public is limited. A trademark monopoly over one of those desirable marks depletes their availability and forecloses the market. On this ground, trademark registration cannot be granted. Some commentators, such as Burton and Elias, argue that the same principle could apply by analogy to olfactory marks because of the


64. Note that depletion issues have also been dealt with in Libertel Groep BV v. Benelux-Merkenbureu, Case C-104/01, [2003] ECR I-3793, and in Heidelberger Bauchemie GmbH, Case C-49/02, [2004] ECR I-6129.

similarities that they present with chromatic indicia. The basis of this argument is that not all scents are suitable for a given product; suitability in this context is determined on the basis of the message that the scents convey. For example, the scent of lemon is desirable in relation to washing detergents, while the smell of fried potatoes or fish for the same product class would not be suitable. This limits the number of possible olfactory options and combinations. As a result, the number of suitable and sales-effective scents may be a portent of fragrance depletion.

4. Scent Functionality

Even if a scent is distinctive, it may not be granted protection on the basis of the function it serves in relation to a product. In Europe, the functionality doctrine finds ground in Article 7(1)(e) of the CTMR. Under Article 7(1)(e), to be registered as trademarks, shapes should not give a "substantial value" to the goods themselves. Maniatis argues that the current approach of the Community laws on trademarks, which exclusively refers to shapes, is narrow. Yet, extending its application to scents is contestable. The "substantial value" clause, as read in the context of Article 7(1)(e)(iii), is practically translated into those features of a product that stimulate consumer motivation for purchase. These features are certainly not restricted to the sphere of product shape; they could be read to refer to the overall product appearance, and to include colours, symbols, or even scents. In relation to perfumes, where the scent per se determines the purchase, the smell attributes such substantial value to the goods. By being the product themselves, perfumes are functional in the utilitarian sense and shall, therefore, be refused registration. This was the case with Chanel perfume, where the applicant sought unsuccessfully to register the perfume CHANEL NO. 5 as a trademark in the United Kingdom in 1994.

66. Burton, supra note 56, at 381; Elias, supra note 59, at 488.
67. Elias, id., at 489.
68. Burton, supra note 56, at 381.
69. Registration is refused to "signs which consist exclusively of: (i) the shape which results from the nature of the goods themselves; or (ii) the shape of goods which is necessary to obtain a technical result; or (iii) the shape which gives substantial value to the goods."
71. For a discussion on the availability of trademark protection for scents, see Maniatis, supra note 13, at 217.
Even if an olfactory mark is able to function as a trademark, it has to meet another requirement in order to be registered: it has to be graphically represented.

III. THE GRAPHIC REPRESENTABILITY OF SCENTS FOR THE PURPOSES OF TRADEMARK PROTECTION

To comply with the requirement of graphic representation, trademark applicants should render the sign precisely and comprehensively\(^{72}\) in a graphic form, such as through writing, drawing, or a graph.\(^{73}\) This requirement, which is laid down in Article 4 of the CTMR,\(^ {74}\) offers transparency and legal certainty to those consulting the register.

In relation to scent marks, graphic representation is the most important obstacle in seeking trademark registration;\(^ {75}\) the graphic representation has to be “clear, precise, self-contained, easily accessible, intelligible, durable and objective.”\(^ {76}\) It is questionable how these criteria can be met with respect to scents which by nature are devoid of visual character.\(^ {77}\) While the OHIM Examination Guidelines remain silent on this issue,\(^ {78}\) a variety of methods has been used to graphically depict the olfactory intangible. Most of these methods were considered together in the Sieckmann case\(^ {79}\) but were rejected. In this case, the applicant


\(^{74}\) This article states that “A Community trade mark may consist of any signs capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging.” See also Art. 2 of the Directive 89/104, supra note 17: “A trade mark may consist of any sign capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging.”

\(^{75}\) Burrell & Handler, supra note 15, at 390; see also Zendel & Prahl, supra note 15, at 25.


\(^{77}\) Lawry & Dickerson, supra note 16, at 28.

\(^{78}\) OHIM Examination Guidelines, OJ 9/96.

\(^{79}\) Sieckmann, Case C-273/00; the same requirements established in Sieckmann apply to sound marks: Shield Mark BV v. Kist, Case C-283/01, [2003] ECR I-14313.
sought to register an olfactory mark for his services\textsuperscript{80} at the German Patent and Trademark Office. The scent had been described by means of three different methods: the chemical formula of the scent, a sample of the same in a container, and a verbal description. Registration was refused, and the applicant appealed to the Federal Patent Court. The Court sought guidance from the ECJ as to whether the condition of graphic representation could be satisfied by either one or a combination of the methods that the applicant had used. The ECJ held that the key requirement of graphic representation was not met in the Sieckmann application. However, it went on to state that a scent mark can be registered “provided it can be represented graphically, particularly by means of images, lines or characters, and that the representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective.”\textsuperscript{81} These criteria, the satisfaction of which appears remote, albeit not impossible, established the threshold of registrability of olfactory marks in the European Community, leading commentators to state that registration of scents as CTMs is virtually precluded.

While conventional trademarks have to be capable of being graphically represented, in the wake of the Sieckmann case this test of capacity has been transformed into a test of adequacy. This is to say that whereas there are many possible ways of capturing the olfactory intangible from a technical point of view, these ways are not adequate for the purposes of trademark law. This is because, for reasons of legal certainty, trademarks need to be easily understood by those consulting the Community Trade Marks Bulletin. It is questionable, for instance, how many people could perceive how a scent mark really smells from a chromatogram. So even though the chromatogram would be an accurate description of a scent, it would not, for the purposes of trademark registration, be an intelligible, and hence, adequate, method of graphically representing the scent mark.

An evaluation is made below of the individual merits of each method of graphic representation of scents and of their combination to produce a rendition that adheres to the rationale of the graphic representation requirement.

\textsuperscript{80} See supra note 12 and accompanying text.

\textsuperscript{81} Sieckmann, Case C-273/00, § 55.
A. Methods for the Graphic Representation of Scents

1. Verbal Description

According to the ECJ, the verbal description of a scent may be graphic and yet not sufficiently clear, precise, and objective.\(^{82}\) In Sieckmann, the description of the scent as “balsamically fruity with a slight hint of cinnamon” did not convey beyond doubt the essence of the terms balsamically and fruity nor did it communicate the intensity of a “hint” of cinnamon. These expressions were tainted by subjectivity, and as such they were not found suitable for unambiguously identifying the olfactory mark.\(^{83}\) Certainly, one could argue that a verbal description of a smell could sufficiently capture its essence.\(^{84}\) This could be the case, however, only if the smell were highly distinctive and often experienced by many people, as was the case with the smell of “fresh cut grass.” The Second Board of Appeal (BOA) of the OHIM found the verbal description of this smell\(^{85}\) precise enough; it was a “distinct smell which everyone immediately recognises from experience. For many, the scent or fragrance of freshly cut grass reminds them of spring, or summer, manicured lawns or playing fields, or other such pleasant experience.”\(^{86}\) To some commentators, this ruling failed to consider the level of descriptive objectivity required for the graphic representation requirement to be met.\(^{87}\) This point is strengthened by the subjectivity of olfactory perception,\(^{88}\) which is to an extent an expression of personal experiences. However, the particularity of scented tennis balls makes the considerations over the olfactory subjective look negligible as a result of the unique character of the combination of the scent with the products in question.

Complex blends of smells, such as a smell that is “balsamically fruity with a slight hint of cinnamon,” are rather unusual and not often experienced by many people; as such, they cannot be verbally

\(^{82}\) Id.

\(^{83}\) Opinion of Advocate General Colomer, supra note 7, § 41.

\(^{84}\) Hawes, supra note 2, at 144.

\(^{85}\) Vennootschap onder Firma Senta Aromatic Marketing’s Application, Case R 156/1998-2, [1999] ETMR 429.

\(^{86}\) Id., §§ 13-14.

\(^{87}\) Peter Turner-Kerr, The Smell of Fresh Cut Grass, 2 EIPR N-19, N-20 (2001): “In what way for example does the ‘smell of fresh cut grass’ differ from fresh cut grass or just cut grass?”

depicted in a way that could be considered acceptable for the purposes of graphic representation, because they do not have the capacity to trigger precise sensory memories.

Even though a verbal description might, under its individual merits, be inadequate as a graphic representation of an olfactory mark, the jurisprudence of the OHIM demonstrates that it is not rejected *ab initio*; on the contrary, its adequacy is examined on a case-by-case basis. For instance, the Fourth BOA of the OHIM, in a 2005 decision, did not *a priori* reject a verbal description, but, after examining it, held that it lacked precision and clarity. Arguments that reject the verbal description of olfactory marks as a clear and precise representation remain in law as apodictic statements and cannot cover all applications for the registration of olfactory marks.

### 2. Chemical Formula

In *Sieckmann*, the applicant described the olfactory mark as the “pure chemical substance methyl cinnamate” and included this chemical formula: C6H5-CH=CHCOOCH3.90 To the ECJ, such a representation did “not represent the odour of a substance, but the substance as such” and was not “sufficiently clear and precise.”91 The chemical formula could not be a sufficient representation of a scent because a product may emit various olfactory signs depending on random factors, such as its concentration, the ambient temperature, or the substance carrying the scent.92 Thus, the graphic representation requirement was not met.

At the same time, the chemical formula was found to lack sufficient intelligibility; only qualified individuals would be in a position to deduce a scent from a mere chemical formula.93 By contrast, musical notations representing acoustic marks can be read by a greater percentage of the population. Practically, this means that perceiving a smell through its graphic representation should not only be *easy* but also *instantaneous*. Third parties consulting the register should not be involved in a
disproportionately high degree of analysis or competence in order to identify the mark in question.  

3. Scent Sample

On the submission of a scent sample, the ECJ held in Sieckmann that because of the ephemeral nature of scents, this sample did not constitute a graphic representation. Such a specimen was found to be neither stable nor durable, and the volatility of the chemical constituents could have led to the gradual evaporation of the smell; this could have jeopardised the publication of the mark as a prime purpose of graphic representation. On this point, the ruling went against the opinion of Advocate Colomer who, acknowledging the representation difficulties of scents, stated that “depositing a sample may be permissible.” Given that scents lack visibility, a sample could enable third parties consulting the register to perceive the scent in a more reliable and unambiguous manner through their noses.

4. Image

Although graphic, an image representing a strawberry was refused registration for a scent described as “the smell of ripe strawberry.” The reason for the rejection was that the image depicted a strawberry instead of the smell of a strawberry, and this depiction could possibly have confused the public. On appeal, the BOA confirmed this decision and stated that the figurative representation of the strawberry did not provide, either individually or in combination with a verbal description, an objective, clear, and precise representation. Describing a scent by means of an image, picture, or photo is highly unlikely to be accepted as an intelligible, clear, and precise form of graphic representation of the scent because it does not depict the scent as such.

95. Sieckmann, Case C-273/00, § 71.
96. Id.
97. Opinion of Advocate General Colomer, supra note 7, § 42.
5. Scent Diagrams

In order to satisfy the graphic representation requirement, “esoteric”\textsuperscript{100} scientific techniques have been used, such as chromatography and electronic nose devices.

\textit{a. Chromatography}

The determination of the chemical components of a given scent can be realised by means of a sophisticated method called gas chromatography or high-performance liquid chromatography. This method evaluates and analyses the chemical structure of a scent and provides information on the quality and quantity of the components of complicated olfactory mixtures. This process utilises a column adjusted to special absorbents that distinguish and separate the different compounds of a scent. The chromatogram that results from this separation process is a graphic output, similar to an electrocardiogram, which plots the quantity of each sensorial element against the time taken for its separation.\textsuperscript{101} The reliability of this method for the purpose of scent representation is, to date, uncertain. This is because some chemicals that are refined in very low concentrations may not be detected, whereas odourless compounds may give very strong results.\textsuperscript{102}

Chromatography can, however, be effective when combined with mass spectrometry. The latter method provides information on the structure of chemical components even at very low concentration levels.\textsuperscript{103} This information reaches a sufficient level of precision and, consequently, it may even be used to reconstitute a scent.\textsuperscript{104}

While these methods may be efficient in representing the components of olfactory mixtures, they cannot be considered adequate graphic representations in the trademark sense, because they are less precise than the chemical formula and even less intelligible. For instance, the OHIM rejected a chromatogram meant to represent the “smell of an amber, woolly aroma, with Virginia tobacco undertones and a mace topnote” for not being intelligible to the public.\textsuperscript{105} Thus, even though chromatography

\begin{footnotesize}
\begin{enumerate}
\item[100.] Bently & Sherman, \textit{supra} note 113, at 740.
\item[101.] Debrett Lyons, \textit{Sounds, Smells and Signs}, 16(12) EIPR 540-543, 541 (1994); \textit{see also} Hawes, \textit{supra} note 2, at 140.
\item[102.] Lyons, \textit{id.}; \textit{see also} Jean-Jacques Le Pen, \textit{Le nez électronique}, Expertises 133 (1998).
\item[103.] Le Pen, \textit{id.}
\item[105.] CTM Application No. 000566596/filing date June 25, 1997.
\end{enumerate}
\end{footnotesize}
produces scientifically acceptable results if combined with mass spectrometry, for the purposes of trademark registrability, it is considered an unintelligible method for representing scents.

**b. Electronic Nose**

Scent measurement can also be accomplished through the electronic-nose device. This device consists of an array of chemical sensors with overlapping selectivity profiles. The sensors measure the scent, collect the quality and quantity data of its composition, and identify it by means of pattern-recognition methods. The end result of this process is the generation of an “olfactory image” of the scent in a graphic form.106

More sophisticated and scent-sensitive devices also exist, such as the colorimetric electronic nose. This device functions on the basis of colour changes that occur in gas-sensitive metalloporphyrin dyes. Upon exposure to organic vapours, an array of such dyes produces unique and visually observable colour patterns that compose the unique colour identity of scents. Even though not as sensitive as a natural nose, the colorimetric electronic nose is considered to constitute an extremely scent-sensitive chemical sensor. It has been argued that the sensitivity of this device in identifying and reproducing a scent by means of a colour pattern could replace the various methods utilised for the purpose of scent classification.107

In a juridical context, however, such colour patterns are inadequate means for graphically representing olfactory marks. In fact, the only CTM application108 that contained a representation of this type, and, in particular, a “colour-olfactory-matrix” of red, green, and blue stripes was rejected. To the fourth BOA of the OHIM, this representation was devoid of intelligibility; very few could comprehend this form of representation as depicting a particular fragrance. As a result, this representation did not provide the public with conventionally acceptable indications regarding the interpretation of the colour image and, hence, it was not self-contained.109 Therefore, at present, the colourful images resulting from electronic-nose devices are considered incapable of producing adequate graphic representations of olfactory marks.

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108. CTM Application No. 000521914/ filing date Apr. 11, 1997.
6. Combination of the Aforementioned Methods

The inability of the aforementioned methods to individually describe the olfactory mark with clarity and precision does not mean that their combination would necessarily be more reliable.\textsuperscript{110} In fact, in \textit{Sieckmann}, Advocate General Colomer concluded that the sum of those methods would be likely to create yet more uncertainty.\textsuperscript{111}

Given the difficulties concerning the graphic representation of olfactory marks, Colomer expressed the view that, currently, scents cannot be represented graphically.\textsuperscript{112}

\textbf{B. The Future of the Graphic Representation of Scents}

While there is no solid argument against the registrability of scents as CTMs, there is one important obstacle of a practical nature: the fulfilment of the graphic representation requirement. In conventional trademarks, such as words or figurative marks, the graphic representation requirement is easily met because the mark sought to be registered and the one featured on the Registry page perfectly coincide.\textsuperscript{113} This perfect coincidence is not possible for scent marks. To date, the only representative methods that are not \textit{ab initio} rejected as inadequate are verbal descriptions. Yet, revolutionary methods of projecting scents through digital media have emerged, which could promise a new era in decoding sensory perception.

One should keep in mind that the maturation of the Trademark Directive,\textsuperscript{114} the rules of which were transferred into the CTMR,\textsuperscript{115} was a long process in which the legislators chose to comply with the practical necessities of a traditional Registry so as to accelerate the harmonisation of the national trademark laws of the Member States. In view of that historical timing, the OHIM registration system is to a certain extent outdated and takes no

\begin{footnotes}
\item[110] Opinion of Advocate General Colomer, supra note 7, § 43.
\item[112] Opinion of Advocate General Colomer, supra note 7, § 47(2).
\item[114] Directive 2008/95, supra note 17.
\item[115] Regulation 207/2009, supra note 18.
\end{footnotes}
account of modern electronic techniques and technological methods.\textsuperscript{116}

In 2005, the European Commission enacted a Regulation\textsuperscript{117} to update the registration procedure. This Regulation amends the rules implementing the CTMR\textsuperscript{118} and, contrary to its predecessor, contains specific provisions as to the electronic filing of marks. In particular, it introduces the possibility of an electronic filing of acoustic marks, in addition to a graphic representation of the mark in the form of musical notation, provided that the applicants meet the criteria specifically established by the ECJ in \textit{Sieckmann}. What is interesting in this context is that electronic sound samples can be provided in addition to a musical notation.

Albeit promising in relation to the registration of non-conventional trademarks, this Regulation makes no specific reference to olfactory marks. This silence appears to be intentional in the light of the \textit{Sieckmann} case, which preceded the Regulation. It raises the question, however, of whether an analogical interpretation of these rules is plausible and legally justifiable so as to cover olfactory marks, and, if so, to what extent. To begin with, one has to state the obvious: because the registry is slowly but gradually being updated via rules that accept the submission of electronic sound samples, this update may also apply by analogy to the registration of scent marks.

Certainly, the Regulation applies to the juridical situations specifically mentioned, that is, to acoustic marks. However, it may also cover other juridical situations, such as smells, as a result of the substantial similarities that they present to sound marks. Both olfactory and acoustic marks are forms of non-conventional trademarks that can be reproduced in a stable and durable manner by virtue of the use of modern techniques. It is true that the reproduction of sounds has not only been stable and durable but also highly accessible for decades, whereas this is not the case for smells. So, for an \textit{argumentum a simili} to be coherent and legally plausible, an examination of the similarity of the reproduction of olfactory and acoustic marks via electronic means is essential. The examination should therefore focus on the availability of technological means with the capacity to create

\textsuperscript{116} Sandri & Rizzo, supra note 28, at 36.


olfactory electronic files and to reproduce them to those consulting the register in a stable and durable manner.

1. Smell Sampling via PC

The “scent dome” is a peripheral device that creates smell simulations for PC users. The device, which is the size of a computer speaker, is attachable to computers. The inner part of the device contains a replaceable cartridge filled with aromatic oils synthesised from “natural primary scents,” such as the scent of lavender or coffee. Each aroma is translated and encoded in a binary mode and can be released either individually or in a combination so as to create thousands of different smells and concentrations. In fact, the different smells start life as files of digitised information and are released according to the digital instructions sent by a computer programme or by a digital scent track on a website. This digital signal activates an individual scent or a combination of scents contained in the cartridge and heats them, so as to vaporise and emit their aromatic potency through the device and to the nose of the PC user.

2. Smell Sampling at the Trademark Registry

Contrary to physical scent specimens, scent samples resulting from scent dome devices do not suffer from instability or lack of durability; if the digital instructions are given correctly, the olfactory outcome is precise and stable. And despite the fact that after its emission from the device the scent might soon evaporate, one can repeat this process to obtain the precise smell. So, even though the smell is not durable, it can be repeatedly released under electronic instructions. The criterion of easy accessibility may be fulfilled provided that those interested in consulting the register electronically have a scent dome device attached to their PC. As the device has been developed by several companies and can be purchased for about 300 USD, it would be accessible to potential users. Therefore, although not graphic, scent sampling adheres to the rationale of the graphic representation requirement.

119. Scent dome devices have been developed by several companies, such as DigiScents and Aromajet.com.
120. Mark Rogers, Bringing Net Users to their Senses, 126 (1) Library journal 8 (2001).
121. See, e.g., http://www.aromajet.com/game.htm.
as synopsised in the triptych of its main functions, that is, property-definable, informative, and administrative functions.

Given that electronic sampling as a form of reproducing acoustic marks was introduced by the Commission as an acceptable, albeit non-graphic, means of representing marks, this possibility could also apply to olfactory marks. It should be noted that the submission of electronic scent files should be made in addition to a verbal description of the scent. This analogical expansion is justified on the basis of the similarities that the electronic auditory reproduction presents to electronic scent sampling as realised via the scent dome devices. Certainly, the use of such devices is not common at present, but it would come as no surprise to see them become a part of the routine digital environment of the near future.

IV. CONCLUSION

The possibility of protecting olfactory marks as trademarks represents a crossroad, where European trademark law is currently standing in a state of ambivalence. While the threshold of scent-mark registrability set in Sieckmann is high, the possibility of registering scents as trademarks is not entirely foreclosed. In Europe, trademark registration is premised upon three requirements. First, there has to be a so-called “sign” eligible for trademark protection. The concept of a sign, which is incorporated in the definition of what constitutes a trademark, may include scents. This is because this definition is broad and the list of protectable insignia enumerated as examples is meant to be non-exhaustive. This conclusion has been confirmed by the OHIM, which does not a priori exclude scents from registrability.

The second requirement for trademark registrability is the capacity of signs to function as trademarks and primarily as indicators of origin; in other words, they must be distinctive. Distinctiveness is difficult to establish in relation to olfactory marks; to be distinctive in a trademark sense, scents should be capable of functioning as trademarks in and of themselves, that is, not in relation to visual indicia. This is why generic and descriptive olfactory features are excluded from registrability on the basis that they cannot be distinctive in a trademark context. Yet, a mark that is devoid of inherent distinctive character can serve a distinguishing function when, following its use, it is perceived as a trademark by the consumers. Scents may be capable of functioning as trademarks in two cases. First, this may happen when the scent is particularly unique. Second, a scent may be distinctive when it is affixed to a product or service in a rather uncommon, or even arbitrary, manner. This was, for instance, the
case with respect to the only registered olfactory CTM so far, which is the “smell of fresh cut grass” for tennis balls.

The third major requirement for trademark protection is graphic representation. Regarding olfactory marks, the fulfilment of this requirement is the prime obstacle to registrability. Most of the methods for scent representation that have been created so far have been unsuccessful in practice. With a single exception, the OHIM has consistently rejected these methods as inadequate to comply with the rationale of the graphic representation requirement. The criteria established in Sieckmann to evaluate the adequacy of graphical representations of scents have set a high threshold for this requirement to be met. However, albeit arduous, it is not impossible to graphically represent scents for the purposes of trademark protection. This is because the adequacy of verbal scent descriptions is not a priori precluded; certainly, such descriptions are more likely to be successful in relation to distinct, well-known, unadulterated scents than to complex olfactory mixtures, as a result of the absence of a formal referential nomenclature. At the same time, the optional electronic filing of acoustic marks that was introduced in a 2005 Regulation in addition to musical notation may by analogy apply to scent marks insofar as the use of technological devices creating smell simulations for PC users is generalised. These durable and stable simulations capture the essence of olfactory marks in a manner similar to the way electronic auditory files reproduce the sound of acoustic marks. The introduction of an olfactory database could assist the representability of scents in addition to an adequate verbal description and enable those consulting the register to perceive scents in a way that the nose “knows” better.