

Olfactory marks revisited

While smell marks are protectable under EU trademark law, the requirement that signs be ‘graphically representable’ has proved a serious stumbling block to registration and one that is unlikely to be removed by the new proposed Community Trademark Regulation

Scents are increasingly being used as marketing devices for (at least at first glance) unrelated products. While Abercrombie & Fitch sells its store scent Fierce commercially as a perfume and several fashion labels have turned to olfactory logos in order to enhance consumer awareness and brand loyalty, Mercedes – not yet known to be in the perfume business – has created four different scents for the enjoyment of customers travelling in its S-class model.

In order to enhance and diversify the customer experience, Mercedes uses specific scents in its showrooms. The four custom-made scents in the new S-class have been developed for the same reason. Thus, it seems fitting to revisit smell marks and the European experience with regard to the scope of registration, protection and marketing.

Current challenges in registering olfactory marks in Europe

In general, smell marks are protectable under trademark law. However, according to Article 4 of the EU Community Trademark Regulation, a sign must be graphically representable and capable of distinguishing the goods or services of one undertaking from those of others. It has never been questioned whether olfactory trademarks can be considered as signs – the problem has always been the issue of graphical representation.

Initially, a mere verbal description of the smell was found sufficient to fulfil the criterion of graphical representation. The description “smell of fresh cut grass” (OHIM, WRP 1999, 681) was registered and cleared only because the trademark was not renewed. The description “smell of a raspberry” was also found to be graphically representable (in the specific context, registration was denied due to lack of distinctiveness for strongly scented fuel as perfumed candles or perfumed oil would have to be included, and the court found that raspberry scent is used for these goods already without this being perceived as an indication of source – OHIM, GRUR 2002, 348).

However, the European Court of Justice (ECJ) found in *Sieckmann* that a mere verbal description of the scent is insufficient to fulfil

the criterion of graphical representation (ECJ, GRUR 2003, 145 – *Sieckmann*). Following *Sieckmann*, the ECJ required that a graphical representation be clear, precise, self-contained, easily accessible, intelligible, durable and objective (the so-called ‘*Sieckmann*’ factors). The court found that a sample of the smell, a chemical formula, a verbal description or a combination of these would not fulfil these criteria – a chemical formula would not represent the odour of a substance, but only the substance itself (ECJ, GRUR 2003, 145).

This has led to a situation where no new olfactory trademarks are being registered at all, the Office for Harmonisation in the Internal Market (OHIM) stating that: “smell or olfactory marks are not currently acceptable. This is because a graphical representation must be clear, precise, self-contained, easily accessible, intelligible, durable and objective (see judgment of 12/12/2002, C-273/00, *Sieckmann*). As in the case of all the other types of marks, a mark description cannot replace the graphical representation. Although it may be graphic, a description of a smell is neither clear, precise nor objective and therefore no filing date can be attributed because the mark cannot be graphically represented. Such cases (see also decision of 04/08/2003, R 120/2001-2, the taste of artificial strawberry flavour) will not be rejected but rather deemed not filed.” (Guidelines for Examination in the Office, Part B, Examination, pp 23-24)

While various different approaches have been taken in order to try to find a way to represent an olfactory trademark graphically, all have so far been denied in line with OHIM’s guidelines. Among these have been a representation code by means of colours (OHIM, GRUR Int 2004, 857; hint of fresh green grass) and a combination of a description and a picture (General Court, GRUR Int 2006, 134: smell of a ripe strawberry). In Switzerland – where trademark law also requires graphical representation – one applicant attempted to overcome this stumbling block by providing a recipe for sugar-roasted almonds in order to represent the “smell of candied almonds” graphically. Although the preparation was described step by step, all ingredients were specified in detail (eg, the type of water and the chemical formula for the sugar used) and the conditions in the kitchen were mentioned (eg, tiled floor, closed windows, temperature of 20 degrees celsius), the approach was denied due to the lack of graphical representation (Swiss Federal Administrative Tribunal, opinion dated May 26 2011, B-4818/2010). The court found that the recipe was insufficiently clear and objective. It failed to make clear that the taste and smell of cinnamon, as a natural product, would vary. Further, there was a lack of objectivity, as a human component would come into play – even when baked following the same recipe, cakes differ considerably from one another (para 6.3.2).

It remains to be seen whether the new proposed Community Trademark Regulation will improve the registration requirements for smell marks. Removing the requirement for graphical representation simplifies the situation for trademark applicants only at first sight – the criterion of representation must still be met. Applicants will need to consider carefully the new Article 4(b), which replaces the graphical representation requirement. This specifies that the sign to be registered must be capable of: “(b) being represented in a manner which enables the competent authorities and the public to determine the precise subject of the protection afforded to its proprietor.” Thus, the term ‘graphical requirement’, which was open to interpretation, is replaced by the even less clear requirement of “enabling competent authorities and the public to determine the subject of protection”. It remains to be seen whether deleting the graphical representation requirement will – according to Recital 9 of the proposal for a new Community Trademark Regulation – “allow for more flexibility while ensuring greater legal certainty with regard to the means of representation of trade marks”.

However, Recital 9 does give some hints on how to interpret the new requirement: “A sign should be permitted to be represented in any appropriate form, and thus not necessarily by graphic means, as long as the representation enables the competent authorities and the public to determine with precision and clarity the precise subject matter of protection.”

The requirements of clearness and precision are not new – applicants have had to meet them since *Sieckmann*. As to the other *Sieckmann* factors (ie, that a mark be self-contained, easily accessible, intelligible, durable and objective), the provision does not appear to set out anything new. In order for both competent authorities and the public to determine the precise subject matter of protection, the mark must be represented in a way that is intelligible, objective and easily accessible. Otherwise, the public – which is not deemed the equal of a competent authority – might be unable to determine the subject matter of protection. The requirement of durability must be met as well, as the public and competent authorities must be in a position to determine the scope of protection until the last day of a mark’s validity. Further, the requirement of representation still exists and must still be self-contained, as it cannot be expected that the public will further interpret the subject matter of protection or collect information from different sources other than the trademark register.

This is supported by Recital 5.3 of the proposed new Community Trademark Regulation: “In the latter cases, representation by other than graphical means (e.g. by a sound file) may even be preferable to graphic representation, if it permits a more precise identification of the mark and thereby serves the aim of enhanced legal certainty. The proposed new definition leaves the door open to registering matter that can be represented by technological means offering satisfactory guarantees. The idea is not to go for a boundless extension of the admissible ways to represent a sign but to provide for more flexibility in that respect while ensuring greater legal certainty.”

Thus, while the new approach might do away with some problems (eg, in the field of sound marks), the above-mentioned issues in registering olfactory marks will likely remain, as it seems that the proposed regulation merely repackages the old *Sieckmann* factors.

However, it remains to be seen whether these criteria will, in future, be interpreted in a more lenient fashion. In the meantime, the German Patent Court has submitted questions to the ECJ on the scope of graphical representation. In this case, Apple sought trademark protection for the layout and design of its retail stores. It provided a sketch depicting a store including ceiling design, lighting and the use of light-brown rectangular tables, which were drawn in perspective. The judges were unsure whether this alone would

suffice for graphical representation, respectively with regard to the criteria of sufficiency and clarity, as the absolute size of the shop and the relation of the parts to each other could not be inferred from the drawing. Thus, the German Patent Court asked the ECJ whether a drawn representation alone would suffice to meet the criterion of graphical representation or whether a description of the layout or indications of a scale should be added (BPatG, GRUR 2013, 932; C-421/13). Thus, it remains to be seen whether the ECJ will relax the *Sieckmann* factors.

Other approaches to protecting scents

Unless one is content to limit the scope of protection to the name of the perfume (which can be protected under trademark law) or the flacon and the packaging (which can be protected under both trademark and/or design law), it is important to consider other protection possibilities.

France in particular has extensive case law on copyright protection for scents. Initially, scents were found to be works of the mind if they showed the input of the creator and were original (*Société Bellure v SA L’Oréal*, Court of Appeal of Paris, opinion dated January 25 2006 – not to be confused with a UK case between the same parties in 2010). However, this ruling was revoked by the French Supreme Court in *Bsiri-Barbir v Haarmann & Reimer* (June 13 2006). The court found that the fragrance did not constitute a tangible form of expression, but a mere implementation of know-how. The Dutch Supreme Court has held, however, that perfumes are eligible for copyright protection (LJN AU8940, *Kekofa v Lancôme*, opinion dated June 16 2006).

As – with the exception of copyright in France – scent generally is not directly protectable, the so-called ‘perfume clause’ of Article 4(g) EU Directive 2006/114/EC is of great importance, as it may protect scents implicitly: “Comparative advertising shall, as far as the comparison is concerned, be permitted when the following conditions are met: (g) it does not present goods or services as imitations or replicas of goods or services bearing a protected trade mark or trade name.”

The perfume clause covers the marketing of scents as an imitation of perfumes for which a trademark was originally registered. In this regard, the ECJ decision in *L’Oréal v Bellure* has made the marketing of smell-alikes difficult, as the court ruled that a comparison must be regarded as unlawful not only if the imitation is explicitly communicated in the advertisement, but also if it is only implicitly communicated.

Thus, despite the still rather slim possibility of obtaining a scent trademark in Europe, other options are available to protect such marks to a certain extent. [WTR](#)

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