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SCENTS AS TRADE MARKS TODAY

Bachelor's thesis

Programme Law, specialisation Intellectual Property

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Tallinn 2018

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The document length is 11092 words from the introduction to the end of conclusion.

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ABSTRACT

The main purpose of this paper is to address the issue of the poor legal definition of scents as trade marks that it is today. The concept of trade marks is expanding. It is no longer limited to just visual marks, but to sounds and smells and even tastes as well. Through this expansion, particularly scents and smells are in need of a better and clearer legal definition.

This thesis is a qualitative research process which is primarily exploratory research. The author has done most of his writing based on trade mark related literature and is very interested in addressing the future of scent trade marks. Within this thesis, the author reviews the history and development of scents as trade marks, and addresses the problem of scent mark registration today. Moreover, he examines the current legislation and its international case law.

The trade mark legislation in the U.S.A and in the EU has been vastly different. While the U.S.A has readily allowed the scent mark registration, the EU has required graphical representation for trade marks, making the registration of scents marks almost impossible. However, by the recent reform of the EU trade mark law, the requirement of graphical representation has been removed and replaced by criteria established within the Sieckmann case. However, it is yet to be seen whether this will be enough to ease scent mark registration in the EU.

The research summary suggests what are the future adjustments for a clearer definition for scents as trade mark.

Keywords: Trade mark legislation, Scent mark, Regulation (EU) 2015/2424, Directive (EU) 2015/2436, Graphical representation.

LIST OF ABBREVIATIONS

CFI	Court of First Instance
CJEU	Court of Justice of the European Union
CM	Certification Mark
CTM	Community Trade Mark
CTMR	Community Trade Mark Regulation
ECJ	European Court of Justice
EUIPO	European Union Intellectual Property Office
EUTM	European Union Trade Mark
EUTMD	European Union Trade Mark Directive (2015/2436)
FCI	Court of First Instance
IP	Intellectual Property
IPR	Intellectual Property Rights
OHIM	Office for Harmonization in the Internal Market
TLT	Trademark Law Treaty
TRIPS	The Agreement on Trade-Related Aspects of Intellectual Property Rights
TPP	Trans-Pacific Partnership Agreement
USPTO	United States Trademark and Patent Office
WIPO	World Intellectual Property Organization
WTO	World Trade Organization

INTRODUCTION

What legally constitutes a scent as a trade mark? What type of unresolved legal issues have arisen so far? The aim of this thesis is to answer the research question and produce feasible proposals and implications for a better and stronger definition of scents as trade marks.

The problems regarding scents as trade mark will pose fresh problems for lawyers, consumers and market strategists in the alike, which is what makes this area of intellectual property law interesting and intriguing.

The focus of my research will be to assess the legal problems associated with the current definition of scents as a trade mark in the legislation, potential future problems, as well as to analyse where these problems arise from, and by this information study how this could be improved by clearer definition.

Thesis Background

In order to thoroughly cover this area of intellectual property law, the author shall need to go through a lot of basic information and data concerning trade marks. This includes a brief introduction to trade marks in general, non-traditional or visual trade marks, the protection of trade marks, international trade mark legislation and case law related to scent and smell trade marks.

It is important for the readers of this paper to understand that this area of intellectual property law is quite new, and thus there does not exist as much data as for other contemporary trade mark related issues, such as taste or sound marks. In order to put things into contrast, performing a Google search with the words "scent"+ "trade" + "mark" gives approximately 600 000 hits, but

replacing the word "scent" with "sound", a Google search finds over 65 million hits. This is over 100 times more hits for sounds.¹

Thesis Purpose

The underlying hypothesis for this thesis is that the legal definition of scents as a trade mark is poorly described and apt to legal arguments, and subsequently in need of a better and clearer definition. The thesis research question is the following: What legally constitutes a scent as a trade mark and what type of unresolved legal issues have arisen so far? Furthermore, what type of adjustments would be needed for a clearer legal definition for scents as trade marks.

¹ www.google.com, accessed 27th, February 2017.

1. TRADE MARKS IN GENERAL

The main purpose of a trade mark is to identify its origin, and thus protect the product, assure its quality and advertise the product². A registered trade mark can consist of any sign or symbol that is capable of being represented and of distinguishing certain goods or services of one undertaking from those of another.³ An application to register a trade mark may be made by anyone who is using, or authorizing the use of, the mark or intends to do so.⁴ A company's trade mark is important because it is used as a marketing tool and promotes the quality of the goods or services which it provides. Trade mark can visually consist of a certain logo or words, or certain words or letters which constitute a logo. Globally known examples of these are for instance the American multinational technology company Apple whose trade mark is, of course, an apple, but has a bite mark on it. This could perhaps indicate that it is a forbidden fruit, yet someone has taken a bite out of it. A good example for a trade mark which consists of certain letters forming together is the car manufacturer Volkswagen's trade mark. It consists of the letters V and W, which are put on top of each other forming a visual logo of the letters, which of course are the manufacturers initials. These are examples, where the definition of a trade mark is quite straight forward because they can be easily distinguished by graphical representation.

² Bahattacharjee, S., Rao, G. *Journal of Intellectual Property Rights. The Broadening Horizons of Trademark Law – Registrability smell, Sports Merchandise and Building designs as Trademarks.* Vol. 10. 2005, p 119-126.

³ United Kingdom Trade Marks Act 1994, and Council Regulation (EC) No 40/94 of 20 December 1993 on the Community Trade Mark.

⁴ Spence, M. *Clarendon Law Series, Intellectual Property*, Oxford, United Kingdom, 2007, p 9.

1.1 Non-Conventional Trade Marks

But trade marks do not limit only to visual marks and symbols.⁵ Today, even certain shapes of a consumer product can constitute a trade mark⁶. Sounds⁷, tastes and scents⁸ have become more and more important to companies in the current market. Many people can still remember the legendary "Nokia Tune". It is a phrase from a composition for solo guitar, Gran Vals, by the Spanish classical guitarist and composer Francisco Tárrega, written in 1902.⁹ It became the first recognizable and identifiable musical ringtone on a mobile phone, thus, a sound mark, which Nokia Corporation later registered.¹⁰ Additionally, other globally well-known examples of registered sound marks are the Twentieth Century Fox drumroll, NBC chimes and the lion roar of the MGM.¹¹ All of these are registered U.S trade marks. Even in the case of these non-conventional trade marks, defining them is simple because tunes too can be represented graphically. However, this is not the case regarding smells, which brings challenges as to the legislation of smells as trade marks, as will be described in Chapter 2.

1.2 The Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS)

TRIPS is an international agreement set in 1995, which sets minimum standards for the regulation for national governments on the forms of all intellectual property rights (IPR), including the protection of trade marks, copyright and related rights, industrial designs, patents, geographical indications and integrated circuits. TRIPS affects all countries which are members of the World Trade Organization (WTO).¹²

TRIPS lays down many valuable provisions for trade mark protection, and it can be considered the only international agreement which provides a clear definition for trade marks. However, it

⁵ *Ibid.*, p 10.

⁶ Court decision, 18.6.2002, Philips Electronics NV v. Remington Consumer Products Ltd., EU:C:2002:377, (C-299/99).

⁷ Court decision, 27.11.2003, Shield Mark BV v. Joost Kist hodn MEMEX, EU:C:2003:641, (C-283/01).

⁸ Court decision, 12.12.2002, Sieckmann v. Deutsches Patent- und Markenamt, EU:C:2002:748, (C-273/00).

⁹ Skinner, T. Burley, R. Grade Seven, Classical Guitar Playing, London, United Kingdom, 2008, p 10.

¹⁰ United States Trademark and Patent Office (USPTO), Serial Number: 75743899, US Registration Number: 2413729.

¹¹ Chasser, A. H. Wolfe, J C. Brand Review, Connecting Intellectual Property, Branding, and Creativity Strategy, New Jersey, U.S.A, 2010, p 63.

¹² Agreement on Trade-Related Aspects of Intellectual Property was concluded as part of the Uruguay Round on the re-negotiation of the GATT in 1994, which established the WTO. It entered into force on January 1, 1995.

has been left up to the national jurisprudence of the member states to determine whether they allow the registration of signs, which are not visually perceptible, e.g. sound, taste and olfactory marks.

1.3 European Union Trade Mark

The European Union Trade Mark (EUTM) is a trade mark which has been registered or has a pending registration in the European Union (EU).¹³ The EUTM system creates a unified trade mark registration system in Europe, whereby one registration provides protection in all member states of the EU. The system is administrated by European Union Intellectual Property Office (EUIPO), which is responsible for the registration of EUTMs.

As of March 23rd, 2016, Community Trade Marks are known as European Union Trade Marks. Within this thesis, there are mentions of both CTM's and EUTM's, due to the recent change of the verbal concept.

1.4 Directive 2008/95/EC of the European Parliament and the Council

Directive 2008/95/EC of the European Parliament and the Council to approximate the laws of the Member States relating to trade marks repealed the previous EU trade mark Directive 89/104/EC in 2008.¹⁴ It “aims at approximating EU countries' laws relating to trade marks, in order to foster the free movement of goods and services and free competition within the internal market. This approximation concerns the fundamental rules on trade marks acquired by registration. EU countries retain the right to organise the procedural aspect and the protection of trade marks acquired through use. The Directive in question also lays down a framework governing trade marks in respect of goods or services which are:

- a) the subject of registration as individual trade marks, collective marks, guarantee or certification marks in an EU country, or in the Benelux Office for Intellectual Property;

¹³ European Union Intellectual Property Office. Accessible: <https://euipo.europa.eu/ohimportal/en/trade-marks-in-the-european-union>, February 22nd, 2017.

¹⁴ Directive 2008/95/EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks. Accessible: <http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:L:2008:299:0025:0033:en:PDF>, January 7th, 2017.

b) the subject of international registration having effect in an EU country. “

The Directive also lays down a framework for several other important factors, such as the signs of which a trade mark may consist, grounds of refusal for a trade mark, use of trade mark, licensing and the rights conferred by a trade mark, plus many other important matters relating to trade marks, yet it mentions nothing about non-traditional trade marks, such as sound or scent marks.

2. SCENTS AS TRADE MARK

2.1 The Human Sense of Smell

Humans have five senses: taste, sight, touch, hearing and smell. The sense of smell, also known as olfaction, is carried out by two small odour-detecting patches – made up of about five or six million yellowish cells – high up in the nasal passages.¹⁵

For comparison, a rabbit has 100 million of these olfactory receptors, and a dog 220 million. Humans are nonetheless capable of detecting certain substances in dilutions of less than one part in several billion parts of air. Although the human sense of smell is feeble compared to that of many animals, it is still very acute. We can recognize thousands of different smells, and we are able to detect odours even in infinitesimal quantities.¹⁶

Thus, it is no wonder that humans have tried to reproduce smells that we find pleasant, and found that they have commercial value.

2.2 Can a Smell Have an Influence on the Decision-Making Process of Purchasing Goods?

Since the sense of smell has been a central factor in the evolution of mammals, it is no wonder, that olfactory memory represents one of the strongest and most reliable kinds of human memory. But in the meantime, it is a most underused practice to connect a certain brand to consumers, where for example the smell of roses could attract potential customers to buy a certain product.¹⁷ Smells

¹⁵ Fox, K. The smell report. Social Issues Research Centre. An overview of facts and findings, 2006, p 1.

¹⁶ *Ibid.*

¹⁷ Carey, B. New York Times, Familiar scents improve memory during sleep, 2007. Accessible: <http://www.nytimes.com/2007/03/08/health/08iht-sleep.4847539.html>, February 16th, 2017.

have also been proven to have the ability to make us recall memories and by that way cause certain emotions. Thus, it could attract customers in the decision-making process of purchasing goods or services. In relation to this, the key could be that trade mark designers build an association in the consumer's mind that these distinctive and non-functional features are unique to their product line.¹⁸ In reality, this could mean that when there exists a high-quality product manufacturer with a registered scent mark, this particular smell could potentially subconsciously signal product users and potential buyers of high standards.

Additionally, particular odours could help consumers locate certain products via the sense of smell, even if they would not remember the product's name.¹⁹ And even if consumers are incapable of describing the essence of the odour in words, scents can help to identify the product simply by stimulating their olfactory memory.

2.3 Scent Mark Registration

As mentioned above, even though it is a rather problematic, trader can nowadays register a certain olfactory (odour, scent or smell) mark as a trade mark. Non-conventional and especially non-visual trade marks cannot be graphically represented as easily as visual marks. 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.²⁰

Using a chemical formula, a practitioner can determine what kind of odour is to be protected and apply for a trade mark for the scent. This method may be challenging, because finding and understanding the content of a chemical formula may be complicated for the general public. However, this does not produce a credible justification to exclude scents from trade mark protection. The fact that the understanding of trade mark registration may be unclear to consumers should not have an effect on the process of legal protection. Future business practitioners will be aware of all this, as well as of other complicated issues, such as what inventions have been patented, and thus should not have a problem with this approach.

¹⁸ Chasser, A. H., Wolfe, J. C. *Brand Review, Connecting Intellectual Property, Branding, and Creativity Strategy*, New Jersey, U.S.A, 2010, p 54.

¹⁹ Karapapa, S. *The Trademark reporter. The Law Journal of the International Trademark Association*, Vol. 100, November – December, No. 6, 2010, p 1342.

²⁰ *Ibid.*

Additionally, it is not plausible to think that ordinary consumers would perform research on the current trade mark register on this matter.

2.4 Scent Marks in the European Union

Before 2008, the EU had gone through two severe changes regarding trade mark law. The first major modification was the implementation of the Harmonization Directive in 1989²¹. The second, an even more drastic change was done by the adaptation of the Community Trade Mark Regulation (CTMR) in 1993²².

The next major reform was made in 2009 with the Council Regulation (EC) No 207/2009 on the Community trade mark, where Article 4 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, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.”²³

Previously, the graphic representation requirement for European Community scent marks was gratified by a written description of the scent which was employed in the mark.²⁴ This changed in 2002 with the European Court of Justice (ECJ) decision on Sieckmann v. Deutsches Patent-und Markenamt²⁵, which is arguably the most famous case regarding non-traditional trade marks. This decision cemented the requirement of graphic representation and virtually made the registration of scents impossible. This particular case and its legacy in the legislation of scent marks shall be elaborated in Chapter 3. However, recently the new EU Directive²⁶ will give registrars room at easing the strict rules set by the Sieckmann case. How this new Directive will be implemented in the area of scent marks is yet to be seen, but in any case the seven criteria established by the

²¹ Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to Trade Marks, recitation 9, 1989 O.J. (L 40/1).

²² Council Regulation (EC) No 40/94 of 20 December 1993 on the Community Trade Mark.

²³ Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark, 2:1 art 4.

²⁴ Vennootschap Onder Firma Senta Aromatic Marketing’s Application, 1999, E.T.M.R. 429, (OHIM (2d Bd. App.)

²⁵ Sieckmann, *Supra nota* 8.

²⁶ Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate laws of the Member States relating to trade marks. Accessible: <https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=CELEX%3A32015L2436>, May 9th, 2018.

Sieckmann case will continue to be the cornerstones in scent mark registration. The new EU Directive will be addressed in Chapter 2.5.

Nevertheless, there has been exceptions: the requirement of graphical representation for scent marks was tested already back in 2001, when the Office for Harmonization in the Internal Market (OHIM) revisited the meaning of "graphical representation" with respect to the scent of raspberries, as Myles Ltd. applied that particular scent to its engine fuels.²⁷ The registration was initially refused on the ground that the application did not contain a graphical representation of the mark nor a precise description of it, but OHIM eventually decided that the "smell of raspberries" as well as the smell of "fresh cut grass" were sufficient enough for CTM (now known as EUTM) protection.

2.4.1 Amending Regulation (EU) No. 2015/2424

Especially after the Sieckmann case ruling, once again graphical representation was required early onwards in applications for trade marks. All of this changed on March 23, 2016 when the Regulation no. 2015/2424 entered into force in order to amend Regulation 207/2009 on Community Trade mark and its corresponding Regulation no. 2868/95 of implementation.²⁸

The particular regulation entailed numerous amendments, such as the change of name of the Office for Harmonization in the Internal Market (OHIM), which from now on will be known as the European Union Intellectual Property Office (EUIPO), and the replacement of the name "Community Trade Mark" (CTM) by the name "European Union Trade Mark" (EUTM).

However, the most notable novelty is the removal of the requirement of graphical representation from the concept of trade marks, which was set out in Article 4 of the previous regulation and laid down in practice in Sieckmann. This new concept of EU trade mark law is applicable as of October 1, 2017.

²⁷ Court decision 5.12.2001, Myles Ltd. Application, (R 711/1999-3), OHIM Board of Appeal. Accessible: <http://www.copat.de/markenformen/wrp2002/wrp10.pdf>, 12th, December 2017.

²⁸ Council Regulation (EU) 2015/2424 of 16 December 2015 amending Council Regulation (EC) No 207/2009 on the Community trade mark and Commission Regulation (EC) No 2868/95 implementing Council Regulation (EC) No 40/94 on the Community trade mark, and repealing Commission Regulation (EC) No 2869/95 on the fees payable to the Office for Harmonization in the Internal Market (Trade Marks and Designs). Accessible: <https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=celex%3A32015R2424>, March 18th, 2018.

Before Regulation no. 2015/2424, the graphical representation had been one of the key factors in order to gain registration for a scent mark. The requirement for graphical representation was made clear by the ECJ in the Sieckmann case (C-273/00) in 2002.²⁹ Now the representation of a sign by the use of images, lines or characters is no longer required due to the new concept.

The new concept of trade marks is disclosed in the new regulation's 4th Article as follows:

“An EU trade mark may consist of any signs, in particular words, including personal names, or designs, letters, numerals, colours, the shape of goods or of the packaging of goods, or sounds, provided that such signs are capable of:

(a) distinguishing the goods or services of one undertaking from those of other undertakings; and

(b) being represented on the Register of European Union trade marks, (“the Register”), in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor”.³⁰

Thus, graphical representation is no longer required for trade marks. It is still, however, considered necessary that such representation fulfills the remaining requirements, which were established in Sieckmann, as it is pointed out in the explanatory statement no. 9 of Regulation no. 2015/2424:

”In order to allow for more flexibility while also ensuring greater legal certainty with regard to the means of representation of trade marks, the requirement of graphic representability should be deleted from the definition of an EU trade mark. A sign should be permitted to be represented in any appropriate form using generally available technology, and thus not necessarily by graphic means, as long as the representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective.”³¹

²⁹ Sieckmann, *Supra nota* 8.

³⁰ Council Regulation (EU) 2017/1001 of 14 June 2017 on the European Union trade mark, chapter 2, section 1, art 4. Accessible: <http://eur-lex.europa.eu/legal-content/EN/TXT/?qid=1506417891296&uri=CELEX:32017R1001>, November 11th, 2018.

³¹ Explanatory statement no. 9 of the Council Regulation no. 2015/2424 of 16 December 2015. Accessible: <http://eur-lex.europa.eu/legal-content/en/TXT/?uri=CELEX%3A32015R2424>, November 11th, 2017.

2.4.2 Directive (EU) No. 2015/2436

A further step with Regulation 2015/2424³² for the modernization and harmonization on trade mark laws were made with the EU Trade Mark Directive (EUTMD) 2015/2436³³, which replaced the previous EUTMD 2008/95.³⁴ It also brought forth some interesting features regarding scent marks and the European trade mark law in general. The adopted improvement has brought significant changes to Community trade mark, as well as to EU national state trade mark owners. The new EUTMD consists of two statutory components:³⁵

1. The Community Trademark Regulation (Regulation 2015/2424), which sets out rules applicable to EU trade marks. It has been in force since March 23rd, 2016. However, not all changes have been implemented immediately.
2. The new Trade mark EUTMD intends to further harmonize the EU national trade mark systems between Member States. It came into effect on January 13th, 2016, however, as a Directive, it requires implementation individually by EU Member States. There are two deadlines currently running for the several alterations, and most of the changes are to be implemented by January 14th, 2019 at the latest. The other deadline is for the mandatory office proceedings for the revocation and invalidity set out in Section 2. These changes are to be implemented by January 14th, 2023.

According to the EUTMD Article 3, a trade mark may be registered if it capable of:

- “(a) distinguishing the goods or services of one undertaking from those of other undertakings; and
- (b) being represented on the register in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor.”

³⁶

³² Regulation 2015/2424, *Supra nota* 28.

³³ EUTMD 2015/2436, *Supra nota* 26.

³⁴ Council Directive 2008/95/EC on 22 October 2008 to approximate the laws of the Member States relating to trade marks. Accessible: <http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:L:2008:299:0025:0033:en:PDF>, May 9th, 2018.

³⁵ EUTMD 2015/2436, *Supra nota* 26.

³⁶ *Ibid.*

More specifically, the EUTMD states that trade marks can be represented in any appropriate form using generally available technology, and thus not necessarily by graphic means, provided that the representation is “clear, precise, self-contained, easily accessible, intelligible, durable and objective” (i.e. the seven Sieckmann criteria). Thus, the biggest changes that the EUTMD brought forward was the removal of the graphical representation, and basically replacing it with the Sieckmann Criteria.

Now, after the removal of the graphical representation requirement, the Directive does not only make registration easier, but it also requires Member States to bring into force the essential laws and administrative provisions in order to comply with the new requirements of the Directive by January 14th, 2019.³⁷

2.5 Scent Marks in the U.S.A

The primary federal trade mark statute of law in the United States is the Lanham Act, which provides for a national system of trade mark registration and protects the owner of a federally registered mark against the use of similar marks, if such use is likely to result in consumer confusion, or if the dilution of a famous mark is likely to occur.

As mentioned, the registration of a scent mark in the EU is very rare and requires fulfilment of a very strict criteria. Whereas the EU has a strict and almost negative aspect against the registration of scents as a trade mark, the US legislation and legal practice has a much more openminded and positive aspect towards the registration.

The starting point in the US is that any symbol can serve as a trade mark if it is able to identify a particular individual commercial source. According to US case law, trade mark protection has been extended to, for example, restaurant’s interior decoration³⁸ and clothing appearance³⁹. According to the US legislation, scent marks are registrable as long as the word, name, symbol, or

³⁷ Lauber-Rönsberg, Anne. The trademark reporter. - The Commercial Exploitation of Personality Features in Germany from the Personality Rights and Trademark Perspectives. - July-August 2017 Vol. 107 No. 4, 2017, p 827.

³⁸ Court decision 26.6.1992, *Two Pesos, Inc. v. Taco Cabana, Inc.* 112 S Ct2753, 23 U.S.P.Q. 2d, 1081.

³⁹ Court decision 22.3.2000, *Samara Brothers, Inc. v. Wal-Mart Stores, Inc.* 49 U.S.P.Q. 2d, 1260 (CA 2).

device, or any combination thereof is used in business trade to identify and distinguish goods or services from those of other similar goods or services, and to indicate its source of origin.⁴⁰

The requirements for registering a scent or even a sound mark consists of a detailed written description of the mark, in lieu of a drawing.⁴¹ This made it easier for business practitioners to gain registration for their non-conventional marks within the market.

2.6 Problems Relating to the Registration of Scent Marks

Oddly enough, even though there are several international Conventions and agreements relating to trade marks, the problematics arising from the registration of olfactory marks depend widely on the country. According to an international questionnaire done by WIPO, 20 out of 72 Offices replied that they accepted smells and scents for registration as a mark.⁴² Like any other type of mark, scent marks need to pass the registrability test, and it has been found that there is no reason to deny the registration of a smell if it functions as a trade mark for goods. In other words, the Seven criteria mentioned in the Sieckmann Case (“Sieckmann Seven Criteria”, see Chapter 3) can indeed be considered as criteria for marks to be registered.

National and regional trade mark legislation may significantly differ as to the means considered to become acceptable for the graphic representation of scent marks. However, it has proven difficult to determine whether a description in words would fulfil the requirement for a smell.⁴³ For example, in the U.S.A. (a member state of WIPO), when applying for a scent or other non-visual mark as a trade mark, applicants are not required to submit a drawing of the mark.⁴⁴ The purpose of the drawing is for the applicant to show the mark which seeks to register. This does not concern smell, sound or other non-visual marks.⁴⁵ However, a detailed written description which clearly

⁴⁰ U.S Lanham Act § 45 (15 U.S.C. § 1127).

⁴¹ Bartkowski, M. Journal of Contemporary Legal Issues. - New Technologies, New Trademarks: A Review Essay, Vol 19, 2010, p 436.

⁴² WIPO, Standing Committee on the Law of Trade Marks, Industrial Designs and Geographical Indications, Sixteenth Session - Geneva, 2006.

⁴³ *Ibid.*

⁴⁴ USPTO Trademark Manual of Examining Procedure, 800 - 46.

⁴⁵ *Ibid.* 800 – 46.

describes the non-visual mark is mandatory.⁴⁶ Another difficulty and a contentious issue regarding scent marks is that of whether they are even capable of being represented graphically.

OHIM Board of Appeal⁴⁷ had considered that the words "smell of fresh cut grass" were enough to fulfil the requirements for graphic representation of that smell. This view subsequently endorsed another board to find equally acceptable the verbal formula of "the scent of raspberries".⁴⁸ The central point was that both Boards considered the smells to be "well-known" for everyone, thus there would be no need of further graphic representation.⁴⁹

⁴⁶ *Ibid.*, chapter 800 – 65, 67.

⁴⁷ *Vennootschap*, *Supra nota* 24.

⁴⁸ *Myles Ltd.* (R 711/1999-3), *Supra nota* 27.

⁴⁹ Phillips, J. *Trade Mark Law, A Practical Anatomy*, Oxford, United Kingdom, 2003, p 155.

3. IMPORTANT CASE LAW RELATED TO SCENTS AS TRADE MARKS

The purpose of this chapter is to demonstrate the problems associated with the scent mark registration process. Each of these decisions which confirm OHIM's position, demonstrates and highlights how difficult it has been in fact to register a scent mark in Europe.

3.1 Sieckmann v. Deutsches Patent-und Markenamt 2002, C-273/00

Within this case, the applicant pursued registration of the compound methyl cinnamate as a scent mark in association with the Nice Agreement on the International Classification of Goods and Services for the Purposes of the Registration of Marks. The applicant defined the mark in his application as "the pure chemical substance methyl cinnamate (= cinnamic acid methyl ester)" and stated that the scent was usually described as "balsamically fruity with a slight hint of cinnamon". The trade mark application also included the chemical formula of methyl cinnamate ($C_6H_5-CH=CHCOOCH_3$) and a sample of the scent.⁵⁰

The patent and trade mark office rejected the application by stating that a sign cannot be regarded as a trade mark as defined by Council Directive 89/104/EEC. Later, on an appeal it was recognised that even though a scent mark can distinguish one good from another, it was still unclear whether it could be graphically represented satisfactorily under the definition of Article 2 of the Directive. This led to two questions being submitted by the applicant to the court:

- 1.) Whether the expression "signs capable of represented graphically" includes only the signs which are visible or includes signs which cannot be perceived visually, but can be represented graphically, i.e. colours, smell etc.?

⁵⁰ Sieckmann, *Supra nota* 8.

2.) Does a scent mark, when represented by a chemical formula, or when provided by an odour sample, or by a description, or by combining all of the mentioned fulfil the criteria of graphical representation under Art. 2?

The ECJ interpreted Article 2 of the CTMR as denoting that a European Community Mark “may consist of a sign which is not in itself capable of being perceived visually”⁵¹, provided that the sign can be represented graphically by images, lines or characters, and that the representation of the sign is “clear, precise, self-contained, easily accessible, and durable.”⁵² The Court ruled that requirements of graphic representation for scent marks are not satisfied by one, or any combination of the following: the scent’s chemical formula, a description of the scent in written words, or deposit of a scent sample. The intention of graphical representation was to enable a consumer to remember the origin, quality and reputation of an undertaking and differentiate it from other undertakings. To fulfil the criteria of graphical representation it must meet two requirements:

1. To retain honour right of exclusivity the mark must be complete, clear and precise,
2. For the purposes of examination, the mark must be intelligible.

Specifically, the chemical formula was considered to be non-representative of the scent in question and it also lacked a satisfactory level of intelligibility, clarity and precision. The written description: “balsamically fruity with a slight hint of cinnamon” was also considered to lack clarity and objectiveness. Furthermore, the provided sample of the scent was considered to be unsatisfactorily durable and stable and therefore, it could not be considered a graphical representation.

These observations lead to the seven precise criteria which now comprise the legal standard within the EU, known as the Sieckmann Criteria, or the Sieckmann Seven.

These standards state that the scent must be:

⁵¹ *Ibid.*

⁵² *Ibid.*

1. clear (not ambiguous or open to interpretation),
2. precise (simple description of the scent is not enough e.g. a mere description of "smell of summer"),
3. self-contained (e.g. a chemical formula),
4. easily accessible (e.g. an international database),
5. intelligible,
6. durable (the graphical representation must remain consistent) and finally,
7. it must be objective.

The ruling of the Sieckmann case has effectively been barring the registration of scent marks under the European Trade Mark system, as most scent marks applicants would describe the scent mark by the very methods which the ECJ found unsatisfactory for the CTMR graphical representation requirement. While alternatives such as petrographic profiles of a scent mark initially appear to fit within the ECJ's test for graphic representation (i.e. images, lines or characters), it is unlikely that spectrographs would qualify as graphic representation under Sieckmann.⁵³ This is because the ECJ in Sieckmann accepted the arguments that a chemical formula is not sufficiently intelligible by most consumers as indicating the scent mark, nor does a chemical formula represent the odour of a substance. Given that spectrographs are not sufficiently intelligible by most consumers, as they are only comprehensible to those with specialized training, and that spectrographs are in fact an alternative representation of a compound's chemical structure, it is, again, unlikely that spectrographic representations of a scent mark would satisfy the Sieckmann test. In the absence of an ECJ decision on scent marks contrary to Sieckmann, it has been very difficult, if not impossible, to register scent marks under the European Trade Mark system before the new EUTMD 2015/2436.

Having regard to the position of the ECJ regarding scents as a trade mark, the ECJ has stated that a trade mark can consist in other ways than visually observable signs, such as smells and sounds.

⁵³ Gow, L. *Business Law Review*. – Creating a Stink. – Vol. No. 28, 2007, p 86.

To present a few examples of approved CTMs (now known as EUTMs), which have been acknowledged as scent marks by OHIM, are “the smell of fresh cut grass” for golf balls⁵⁴, (in the case, a mere text description: “the smell of fresh cut grass” was considered sufficient as a graphic description), as well as for tennis balls⁵⁵ “smell of fresh cut grass” and “the scent or smell of raspberries” for engine fuels⁵⁶. (In the latter case, a mere text description: “the smell of fresh cut grass” was considered sufficient as a graphic description.)After the EU trade mark reform alongside the Regulation 2015/2424⁵⁷, the graphical representation requirement has been erased since October 1st, 2017. In addition to the regulation, the EUTMD 2015/2436 provides similar provision, which are to be altered into the national laws of the Member States by January 14, 2019.⁵⁸ As it is stated in the Regulation 2015/2424 explanatory statement no. 9, in the future, EU trade mark law allows signs to be represented in any appropriate form using generally available technology and not necessarily by graphic means, thus including sonograms as a means of graphic representation.⁵⁹ This is predicted to give flexibility regarding the registration of scent marks, as well as other non-conventional marks.⁶⁰

The aftermath of the Sieckmann case has been enormous. The judgement which resulted from it has guided the way of scent mark registration to the point that EUTMD implemented it within its provisions by replacing the graphical representation requirement by adopting the seven Sieckmann Criteria. However, the question whether a scent mark, (or any other trade mark) fulfils the Sieckmann Criteria needs to be answered considering the specific facts of each case individually.⁶¹

⁵⁴ Vennootschap, *Supra nota* 24.

⁵⁵ *Ibid.*

⁵⁶ Myles Ltd. (R 711/1999-3), *Supra nota* 27.

⁵⁷ Regulation 2015/2424, *Supra nota* 28.

⁵⁸ Lauber-Rönsberg, A. The trademark reporter. - The Commercial Exploitation of Personality Features in Germany from the Personality Rights and Trademark Perspectives. - Vol. 107 No. 4, 2017, p 827.

⁵⁹ *Ibid.*, 827.

⁶⁰ *Ibid.*,

⁶¹ Troussel, J-C., Meuwissen, Stefaan. ERA Forum. – Because consumers do actually eat trade marks: an assessment of current law regarding non-conventional trade marks in the European Union - Vol. 13, 2012, p 426.

3.2 Vennootschap onder Firma Senta Aromatic Marketing, R 156/1998-2

In 1999, the Community Trade Mark Office (nowadays known as European Union Trade Mark and European Union Intellectual Property Office) considered whether the scent of fresh cut grass could be registered as a trade mark for tennis balls. Initially, the application was refused on the ground that the words “the smell of fresh cut grass” did not qualify as an adequate graphical representation of the mark capable of depiction in a shape or form as required by Article 4 of the CTMR.⁶²

On appeal, the Board of Appeal decided that the scent of fresh cut grass is a distinct scent known to, and recognizable by, the majority of the population from experience, and thus that the mark's description was appropriate for registration. In fact, it is the only scent mark to have gained approval in the EU. However, in 2006 the registration lapsed, when the applicant did not seek renewal for the scent mark.

This ruling (R 156/1998-2), by OHIM in 2009 is notable, because it is clearly an exception among the decisions for scent mark registration. The application was accepted based on the verbal description of the product, “the smell of fresh cut grass” for tennis balls, which would not later have been acceptable based on the Sieckmann criteria.

3.3 OHIM Board of Appeal R 711/1993-3 (Der Duft von Himbeeren, Smell of Raspberries)

This particular case concerned a scent mark for a gasoline which was applied by just mere textural description: “Der Duft von Himbeeren” (“smell of raspberries”).⁶³ This was seen sufficient enough as such to fulfil the graphical representation requirements which are laid down in Article 4. However, the application was declined due to its lack of distinctive character.

It is still to be questioned how broadly the results of the board of appeal cases are apt to similar type of cases regarding the registration of olfactory mark. Therefore, the OHIM research

⁶² Vennootschap, *Supra nota* 24.

⁶³ Myles Ltd. (R 711/1999-3), *Supra nota* 27.

department still rejected scent marks, unless they consisted of a visible graphical description of the mark.⁶⁴

The stated OHIM Board of Appeal cases brought forth the registration problematics regarding olfactory marks within the ECJ. The outcome of the Sieckmann case made the ECJ declare that in principle a trade mark can indeed consist of a mark which cannot be apprehended via sense of sight if it can be graphically represented. Moreover, the graphical representation must allow the mark the ability to be visually represented via shapes, lines or inscriptions etc. and thus, to be accurately identified.⁶⁵

Considering scent marks, the ECJ acknowledged that the requirements of graphic presentation cannot be met by a chemical formula, a written description and a deposit of an odour sample, or a combination of these means. Unless you are a chemist, very few people recognize the odour in question on the basis of the chemical formula because it is not sufficiently understood. In addition, the chemical formula does not actually describe the odour of the substance but the substance as such, and it is therefore not sufficiently clear and precise. The ECJ again stated that storing an odour sample is not a graphical representation, nor is it a sufficiently stable and durable method. Consequently, the ECJ concisely stated that in the case of scent mark, the requirements for the presentation of a graph cannot be met by a chemical formula, verbal description or by storing an odour sample alone, or combination of these means, nor can their clarity and precision requirements.

3.4 Eden Sarl v. OHIM, T-305/04, (Odeur de Fraise Mûre, Smell of Strawberries)

In 2005 Eden tried to register the smell of ripe strawberries as a scent mark, but was rejected by OHIM in its solution T-305/04 on the familiar grounds, the lack of graphical representation. The Board of Appeal, as well as the Court of First Instance (FCI) also rejected the appeal. The particular mark was applied for a cleaning agent and other similar goods, and it was described as: "the smell of ripe strawberries". Within the box, an image of strawberry was presented, but this mere picture

⁶⁴ Von Mühlendahl, Alexander: The Office for Harmonization in the Internal Market and its Board of Appeal: Registrability of Community Trade Marks. Dutch Group of AIPPI. Symposium Intellectuele Eigendom 17.3.1999, OAMI News 3/1999.

⁶⁵ Salmi, H., Häkkänen, P., Oesch, R., Tommila, M. Tavaramerkki, Helsinki, Finland, 2008, p 273.

was not considered to graphically represent the smell of strawberries. The FCI also stated that the scent was not distinctive for the goods in question, since the following description:” the smell of ripe strawberries”, given in the application may refer to several varieties and thus to various scent fragrances. It is neither unambiguous, nor punctual, and thus it cannot eliminate the subjectivity of the character recognition and detection process. The difficulties of scent mark registration overall is highlighted by this judicial process, where a specialist panel smelled the different species of strawberries, and was able to distinguish five of the nine different varieties, thus contradicting the applicant’s argument that all varieties of strawberries have the same smell.

The FCI also found that the image of a strawberry that only presents the berry that presumably produces the same scent as the odour in question, cannot be considered a graphic representation of the odour. Furthermore, since many strawberries have a different flavour depending on the variety, an image of strawberry, whose variety had not been refined, did not allow the identification of the applied smell to be clearly and accurately identified.

It was concluded by the court that the combination of verbal and figurative elements was inadequate to constitute a scent mark because each element taken separately was incapable of forming such a mark. The visual image of the strawberry did not in fact give any more information than for instance the verbal description of the chemical formula given in the representation of the scent in the Sieckmann case and thus, was decided similarly by the court.

3.5 OHIM Board of Appeal, R 186 / 2000-4 (Fragrance)

In 2005, this application for a fragrance for cosmetic and other goods, which was verbally described by multiplying the scent of ingredients and by adding a coloured” image ” scents, was rejected because it did not meet the requirements of acceptable graphic presentation, although the verbal description of the product was acceptable.⁶⁶

⁶⁶ Institut pour la Protection des Fragrances, R 186/2000-4, 2005, ETMR 42 (4th BOA), §§ 17-19.

3.6 OHIM Board of Appeal R 445 / 2003-4 (El Olor a Limon, Scent of Lemon)

The application for the odour of the shoe and shoe laces described with the wording “el Olor a Limón” (“scent of lemon”) was denied because it did not meet the requirements of acceptable graphic presentation.⁶⁷ This OHIM’s decision R 445/2003-4 in 2005 confirmed that although a smell is commonly recognizable for all, its description is not a valid mean for trade mark registration.

3.7 John Lewis of Hungerford Ltd’s Trade Mark Application, RPC 575

A trade mark application to register the aroma of cinnamon in respect of furniture.⁶⁸ The Trade Marks Registry objected the registration in an official letter dated 14th March 1995 on the following grounds: (1) the sign put forward for registration was not capable of being represented graphically; and (2) it was a sign that other traders may legitimately wish to use.

The Applicant responded in February 1996 maintaining that the sign it wished to register could not properly be said to be incapable of being represented graphically because it was, in fact, done so in the application for registration by the words “the smell, aroma or essence of cinnamon”. The registrar held that the representation of the mark was too ambiguous to satisfy the requirements of the Trade Marks Act 1994. In addition to the fact that verbal description of the smell was not sufficient for registration in this case, it is notable, that not even the chromatographic analysis of the scent was accepted as graphical representation of the scent.

3.9 Clarke’s Plumeria Blossoms 1990

Clarke’s Plumeria Blossoms was the first registered scent mark by the U.S Patent and Trademark Office on December 3rd, 1990.⁶⁹ Application was applied to register a scent mark for a particular fragrance for “sewing thread and embroidery yarn”. The odour was described as being

⁶⁷ Case OHIM Board of Appeal R 445 / 2003-4.

⁶⁸ Trade Mark Application Decision in the Name of John Lewis of Hungerford PLC, Application Number: 2,000, 169.

⁶⁹ USPTO, Serial Number: 73758429. Registration Number: 1639128. Accessible:http://tsdr.uspto.gov/#caseNumber=+1,639,128&caseSearchType=US_APPLICATION&caseType=SERIAL_NO&searchType=statusSearch. – February 12th, 2018.

”reminiscent of Plumeria blossoms.” The Board found that the particular odour was not a natural or inherent feature of the goods and also emphasized that it was addressing the use of a scent on a product that was not ordinarily known to be scented.⁷⁰ The particular scent mark was cancelled in 1997.⁷¹

3.10 Myles Limited’s Application, Appeal No. R0711/1999-3 (Smell of Raspberries).

An application was filed for ”the scent or smell of raspberries” for motor oil, however, it was denied on the grounds that it was not distinctive enough.⁷² The Third Board of Appeal recognized the difficulty of graphical representation of scent marks, but nevertheless considered it was not impossible, that in an exceptional case, a scent can be represented completely, clearly, precisely and objectively.⁷³

3.11 Chanel No. 5 Application

Another example of the challenges for presenting scents graphically is the application made by Chanel, which pursued to the unsuccessful registration of the world wide famous “Chanel No. 5” as a scent mark. Within the attempt, the graphical representation of the scent was described as:

“The scent of aldehydic-floral fragrance product, with an aldehydic top note from aldehydes, bergamot, lemon and neroli; an elegant floral middle note, from jasmine, rose, lily of the valley, orris and ylang-ylang; and a sensual feminine note from sandal, cedar, vanilla, amber, civet and musk.”⁷⁴

The particular scent mark application was rejected on the ground that the smell of the perfume was the product itself and not the indication of its origin, thus, could not present a scent mark.

⁷⁰ Handelman, J. A. Guide to TTAB Practice. Wolters Kluwer Legal & Regulatory, U.S.A, 2017, p 82.

⁷¹USPTO, Serial Number: 73758429. Registration Number: 1639128. Accessible: http://tsdr.uspto.gov/#caseNumber=+1,639,128&caseSearchType=US_APPLICATION&caseType=SERIAL_NO&searchType=statusSearch, February 12th, 2018.

⁷² Myles Ltd. (R 711/1999-3), *Supra nota* 27.

⁷³ *Ibid.*, Decision of the Third Board of Appeal of 5th December 2001. chapter 14. Accessible: <http://www.copat.de/markenformen/wrp2002/wrp10.pdf>, February 12th, 2018.

⁷⁴ Chanel’s No. 5 Application, 31.11.1994.

It is also worth mentioning that on the very same day on October 11th, 1994, two more scent mark applications were made to be registered. These applicants were Sumitomo Rubber Co., which applied for “floral fragrance reminiscent of roses as applied to tyres”⁷⁵ and Unicorn Products, which applied for “the strong smell of bitter beer applied to flights for darts”.⁷⁶ Despite Chanel’s rejection, both of these scents gained registration.

3.12 Qualitex Co. v. Jacobson Products Co

The U.S courts are guided by the ruling Qualitex case.⁷⁷ Even though this particular case is not about scent marks, it still plays a major role on the registration regarding non-conventional trade marks in the U.S.A.

The U.S. courts opposed colour marks for a long period of time until it made a major decision in 1995, ending all debates concerning the protection and registration of colours as trade marks. This was the outcome of the decision of the Qualitex case, where the Supreme Court held that no special legal rule should deny colours to serve as a trade mark if they fulfil the usual legal trade mark requirements.

The court stated that the arguments which are usually raised against the protection of colours as trade marks are not convincing enough to elide it from the area of protection.

The Supreme Court concluded that a green-gold colouring of Qualitex’s dry cleaning press pads did not violate the functionality doctrine, since the colour served no function in the product’s operation other than as a symbol identifying its source of origin, which is the main idea behind a trade mark.

⁷⁵ Sumitomo Rubber Co’s Application No. 2001416, 31.11.1994.

⁷⁶ Unicorn Products’ Application No. 2000234, 31.11.1994.

⁷⁷ Court decision 28.3.1995, *Qualitex Co. v. Jacobson Products Co.* 514 U.S. 159, U.S.P.Q.2D (BNA) 1161.

4. THE DEBATE FOR AND AGAINST SCENT MARKS

Even though some countries have made legislative provisions for smell as a trade mark of particular goods, it is still safe to say that the jurisprudence need to be developed in this scenario.

Today, Europe and Australia are strongly guided by the Sieckmann Case, and the U.S is guided by the Qualitex Case⁷⁸ ruling of the Supreme Court.

Basically, the most famous arguments in favour and against accepting scents as trade marks have been concluded by two legal experts already in the early 90's. They recognized the judicial ambivalence of the registration of scents as trade marks; and the points they made in their debates are still valid today. Arguments in favour of scent marks were done by a jurist named J. E. Hawes, who can be considered as the first jurist to support the protection of scents as trade mark.⁷⁹ Contrary to J. E. Hawes, Bettina Ellias criticized J. E. Hawes by arguing that smells or fragrances should not be protected as a trade mark.⁸⁰ The arguments for and against have been listed below in separate categories as positive and negative.⁸¹

4.1 Positive Arguments Arising from the Protection of Scent Marks

- a) "The role of fragrance in many of today's products highlights the function of a product's smell not only to sell but also to distinguish."⁸²

⁷⁸ *Ibid.*

⁷⁹ Kumar, A. Journal of Intellectual Property Rights Protecting Smell Marks: Breaking Conventionality. Vol 21, May 2016, p 129-139.

⁸⁰ *Ibid.*

⁸¹ Ellias, B. Do scents signify source: An argument against trademark protection for fragrances, Trademark Reporter, 82, 1992, p 477.

⁸² Brown, A., Grant. A. The Law of Intellectual Property in New Zealand, Butterworths & Wellington, Toronto, 1989, p 134.

With this argument, Hawes tries to illustrate that a scent as a trade mark does not only limit to the fact that a certain smell could possibly be a factor in the purchase of a certain product, but also distinguishing it from other, perhaps similar products. This could be referred to as a "blind mans trade mark". This is a new point of view, and it means that one is able to distinguish a product by smell, not necessarily by a visual trade mark.

- b) "A strong relationship exists between scent and human memory, which makes scents effective trademarks. Whenever people think they are recalling odours, they are actually thinking of some object associated with an odour."⁸³

As mentioned above, smells do in fact have a strong influence on human memory, and they can even bring forth certain emotions, thus, a smell can indeed be considered as an effective trade mark. Smells can also work on a subconscious level and attract consumers later in time, however, it is not necessarily as straight forward as Hawes declares. A certain odour, particularly if it is a well-known odour, does not always make you think of an object associated with that odour. For instance, the smell of freshly cut grass might make you think of summer, instead of a tennis ball (see the *Vennootschap Case*⁸⁴).

- c) "A long-term odour memory can be established with only one exposure and then, like a bad habit, this odour connection is difficult to unlearn and forget as once humans have made one association with a scent, it is difficult for them to replace the association with another one."⁸⁵

This argument is rather similar to the previous. In the author's opinion, Hawes is a bit too straight forward in thinking that once humans have made one association with a certain scent, there is no turning back, "unlearning" and forgetting it.

- d) "Registration of fragrance marks must be differentiated from other types of trademarks.⁸⁶ For example, as to protect a word we just need to give the word, say Dell. Similarly, it can be seen that various applicants who followed the same formula were denied of the protection to their smell mark because the mark applied by them was too wide to be protected, example being Clarke's

⁸³ Faye, M. H. The smell of success: Trade dress protection for scent marks, *Marquette Intellectual Property Law Review* 2, 1989, p 105.

⁸⁴ *Vennootschap, Supra nota* 24.

⁸⁵ Engen T. *Odor Sensation and Memory*, California, U.S.A, 1991, p 5.

⁸⁶ World Intellectual Property Organisation (WIPO), 'Relation of Established Trade Mark Principles to New Types of Marks' (SCT 17/3), 30 March 2007.

scent 'plumeria blossoms'⁸⁷. So, keeping in mind the different nature of the sense, mere little description of the scent should suffice the drawing requirements."

4.2 Negative Arguments Arising from the Protection of Scent Marks

- a) "In order for a fragrance to be protected, two conditions are prerequisites otherwise the basic jurisprudence will fail itself:
1. Consumers must have access to a product's scent before they purchase the product; only if this is true can the scent indicate origin and thereby influence the decision to purchase, because if the consumer must wait until the product is put to use at home in order to smell its scent, the opportunity for scent to function as a trade mark at the point of sale is lost."⁸⁸

The author disagrees, the idea that the inventor of the scent should bring it to the market in order to file for the registration for the trade mark cannot be a prerequisite. On the contrary, this would jeopardize the trade mark by giving the competitors a chance to mimic the particular scent.

2. "The consumer must not only be able to recognize a product's scent as familiar, but he or she must also be able to link the scent with the identity of the product (or manufacturer) on a reliable basis. In her opinion these two conditions will not be met in majority of the cases."⁸⁹

Here Bettina Ellias is failing to recognize that the trade mark is important for the manufacturer, so that it can protect the scent from competitors copying it. She also fails to consider the possibility that scent marks are not only limited to products but can also stand alone, for instance as a fragrance for a perfume, where it is not necessarily important for the consumer to know whether it is a trade mark or not.

⁸⁷ *Supra nota* 67, p 29.

⁸⁸ Ellias B. Do scents signify source: An argument against trademark protection for fragrances, *Trademark Reporter*, 82, 1992, p 475.

⁸⁹ *Ibid.*, p 477.

- b) "Even if a product's fragrance functions as an origin-identifier, the manufacturer seeking to protect that mark from infringement must be able to demonstrate that similar scents will create a likelihood of confusion."⁹⁰

- c) "Similar fragrance blends, like similar colours can be difficult to distinguish without expert assistance and the practical difficulties in the administration of fragrance marks are likely to prove even more onerous than in the colour mark context."⁹¹

The author agrees completely. This is the main reason why scent registration as a trade mark is difficult. Without clear and precise rules regarding the registration, it is likely that there will be more problems in the future. This highlights the need of clearer legislation for olfactory marks.

⁹⁰ *Ibid.*, p 479.

⁹¹ *Ibid.*, p 480.

5. DIFFICULTIES IN PROTECTING SCENT MARKS

The main purpose of a trade marks is to distinguish and guarantee the identity of the origin of a certain product in the market. Consumers are not to be confused with similar marks. The most important quality of a trade mark is therefore its distinctiveness from other marks. The ambiguous issue with a scent mark is that such a mark may identify the commercial origin of an anonymous product or service, and in that case, how the legal protection afforded by these brands differs from that of traditional trade marks. On the other hand, a necessity for a law is a measure of predictability. Legally, there cannot be certainty without predictability.⁹²

5.1 The Need for Protection and Competitive Problems

The use of scents is common for example in cosmetics such as cleansers and facial-creams, but in addition, particular business areas such as candy stores may be provided with a certain scent to attract customers as well as to build and improve business image. As it is mentioned earlier, a scent can subconsciously affect customers in several ways. Thus, it would be important for a business to protect its genuine scent as intellectual property.

In spite of the clear need for protection, scents registered as trade marks are rare in both Europe and in the United States. However, scent marks as well as other non-traditional marks are attracting more and more businesses for commercial use. Thus, legislators need to prepare for a broader view of intellectual property and recognise that future technology may also play a part in what is to come.

Sometimes the visual sign of a product has little to do with the origin and distinction of the scent as a trade mark. For instance, a scent can be attached to the product packaging, and therefore it

⁹² Van Meerbeeck, J. The principle of legal certainty in the case-law of the European Court of justice: from certainty to trust *European Law Review*, issue 41 (2), 2016, p 275- 288.

can be part of the product, although the scent is not recognized by the consumer at the time of the purchase. Consequently, odours which are for example stored within a package of goods should be able to be protected as scent marks.

The protection of odours does not necessarily play a primary role in how consumers can differentiate one product or service from another. But scent marks need protection because they are important tools in modern brand marketing. Thus, in a modern environment, a scent mark can be of importance to the business owner as an independent property right, even if it would not necessarily have a major impact on how consumers differentiate between goods and services.

5.2 Protection of Other Non-Traditional Trade Marks

Colours and shapes are designed to appeal to consumers and to create positive associations about the product's image and practical benefits. Colours can also function as part of the overall look of the product so that the product can be quickly identified with them, which is a particularly important part of a trade mark. One could argue that from the point of view of brand thinking, colours are the key factor in communicating the products personality and thus, the most important part of the trade marks totality.

However, scent marks should not be placed differently on the grounds that they have less importance to consumers than for instance colours or sounds.

5.3 Ruiz Jarabo-Colomer Controversy

Article 4 of the CTMR determined that a trade mark must be graphically presented. On September 19th, 2002, Advocate General Ruiz Jarabo-Colomer submitted in his Opinion to the German court's request for a preliminary ruling that, even though an odour may be a trade mark, registration is not applicable because such a mark cannot be sufficiently described graphically.⁹³ However, regarding scents, this is of course ambiguous. He did not deny that scents can be described in the chemical

⁹³ Schlussanträge des Generalanwalts Dámaso Ruiz-Jarabo Colomer, vom 6. November 2001 (1), Rechtssache C-273/00 Ralf Sieckmann gegen Deutsches patent- und Markenamt, Parts 41-47.

formula by writing, but he argued that scent cannot be described to business practitioners and consumers sufficiently clearly and unequivocally for registration.

This opinion on the subject brings forth two observations:

First, since it can be argued that the presentation of the chemical formula is a graphic description of the scent, the Opinion of the Advocate General contains important regulatory criticism. According to him, the graphic description is too blurred with respect to scents.

Second, the notion that a scent could be protected if it can be graphically described, brings legal certainty to the protection of the scent. Nevertheless, there remains uncertainty towards to which odour is protected, and how extensive the need for protection would be. However, the protection of fragrances does not differ so much from other trade mark conflicts so that the scents should be completely excluded from protection.

This debate brought up by Ruiz Jarabo-Colomer has been considered a major part in the process which lead to an incentive to ease the requirement of graphical representation, and later to the wording of the EUTMD 2015/2436 and Regulation 2015/2424 in 2015.

6. THE FUTURE ADJUSTMENTS FOR A CLEARER DEFINITION FOR SCENTS AS TRADE MARK

While the EU Regulation no. 2015/2424⁹⁴ and lately the EUTMD 2015/2436 brought new insight relating to scents as trade marks, it is still however, missing a clearer definition. One notable adjustment which is stated in the explanatory statement no. 9 of Regulation no. 2015/2424, is that as long as the representation is clear and precise, a sign should be permitted to be represented in any appropriate form using generally available technology.⁹⁵ However, the Regulation came into force on March 23, 2016, and the EUTMD recently, so we are yet to see how the case law develops.

6.1 The Electronic Nose and E-Sensing

Although the representation of a sign by the means of images, lines or characters is no longer required, it is still, however, necessary that the representation of a scent as a trade mark fulfills the remaining requirements established by the ECJ in Sieckmann⁹⁶. The Sieckmann Seven Criteria are included in the explanatory statement no. 9 of Regulation no. 2015/2424, which points out that:

“In order to allow for more flexibility while also ensuring greater legal certainty with regard to the means of representation of trade marks, the requirement of graphic representability should be deleted from the definition of an EU trade mark. A sign should be permitted to be represented in any appropriate form using generally available technology, and thus not necessarily by graphic means, as long as the representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective”.⁹⁷

⁹⁴ Regulation 2015/2424, *Supra nota* 28.

⁹⁵ Explanatory statement of Regulation no. 2015/2424, *Supra nota* 31.

⁹⁶ Sieckmann, *Supra nota* 8.

⁹⁷ Explanatory statement of Regulation no. 2015/2424, *Supra nota* 31.

In addition to the deletion of the requirement of graphical presentation, the use of technology to represent a sign is a novel idea in this statement. Thus, the question for any available and existing technology arises. Interestingly enough, there exists machines that can enable the presentation of a sign accordingly to such requirements. Over the last decade, "electronic sensing" or "e-sensing" technologies have undergone important developments from a technical and commercial point of view. This is a topic which has received little attention in regard to trade mark law. Using electronic sensing we could potentially create an international database for all trade marks which possess an olfactory feature.

An electronic nose is a machine that is designed to use sensor arrays in order to detect and discriminate among complex scents and odours.⁹⁸ The electronic nose consists of chemical sensors connected to a pattern-recognition system which responds to scents it detects nearby.⁹⁹ Different scents cause different responses within the electronic sensors of the nose and deliver a signal pattern characteristic of a particular aroma which the computer examines and compares the aroma to different samples using pattern recognition.¹⁰⁰ The technology of electronic noses, are used for the quality control of a wide range of commercial products, for instance beverages, but for other goods as well, such as cosmetics, and even for medical diagnosis.¹⁰¹

6.2 The Scent Dome

The Scent Dome is a device which can be attached to a computer to create smell simulations for PC users.¹⁰² The inner part of the machine contains expendable cartridges that are filled with aromatic oils, each of which is translated and encoded in a binary mode. The idea of the Scent Dome was launched in early 2004 and was the first serious attempt to create a smell peripheral. It works by storing a cartridge of twenty base aromas, each of which can be released individually in set amounts, or mixed and matched by the control software in differing amounts to create virtually any possible smell.

⁹⁸ Pearce, T.C., Schiffman, S.S., Neagle, H.T. & Gardner, J.W. Handbook of Machine Olfaction, Electronic Nose Technology, New Jersey, U.S.A, 2006, preface XVII.

⁹⁹ Caballero, B., Finglas, B., Toldra, F. Encyclopedia of Food Sciences and Nutrition, Massachusetts, U.S.A, 2003, p 5174.

¹⁰⁰ *Ibid.*, p 5173.

¹⁰¹ Pearce, T.C., Schiffman, S.S., Neagle, H.T. & Gardner, J.W. (2006). *Supra nota* 95, p 450.

¹⁰² Could olfactory displays improve data visualization? Washburn, D.A. & Jones L.M, Computing in Science & Engineering, 6(6), 2003, p 80-83.

Unlike smell samples, the scents released from the Scent Dome do not lack stability and durability. In fact, it is quite the contrary, as long as the digital instructions are correct, the scent will be precise, and the release can be repeated as many times as it is needed.

6.3 The Future Adjustments to Trade Mark Law Made by Electronic-Sensing

As it is stated above, electronic-sensing (e-sensing) has already been used in various of fields. In order to put this technology into a day-to-day perspective, e-sensing has already known to been used in medical fields to diagnosing patients of lung cancer or other medical conditions by sensing volatile organic compounds that indicate the patient's health status,¹⁰³ as well as to detecting whether food has started to go bad, and bacterial or insect contamination.¹⁰⁴ Certain national law enforcements have also been known to use e-sensing as a measure to detect odourless chemicals to fight drug smuggling and detecting bombs at airports etc., and hence, possibly replacing canine units.¹⁰⁵ However, it is unlikely that this this will happen in the near future, since the cost of a well-functioning e-sensing devices are rather high.

The list of where e-sensing is used goes far beyond of what is stated above. Therefore, keeping in mind the growing scale of use and interest in e-sensing in the future, the idea of adopting this same technology into trade mark law might not be so far-fetched as one might think. However, as it has been brought up already, e-sensing has been known to be quite expensive, but there are many companies that are currently developing computerized olfactory technologies.¹⁰⁶ And much like any other technology, the cost will come down after it progresses over time.

One could argue that the EU might be leaning towards this idea by its recent amending of the Trade Mark Directive into a more wide and positive direction regarding non-conventional trade marks. The removal of the graphical representation within the new Regulation 2015/2424 is a perfect example of this supposition. The Article 15(1) of the TRIPS Agreement¹⁰⁷ could be

¹⁰³ Timms, C. J., Thomas, P. R., & Yates, D. H. Detection of gastro-oesophageal reflux disease (GORD) in patients with obstructive lung disease using exhaled breath profiling. *Journal of breath research*, vol 6, 2012, no. 1, p 1.

¹⁰⁴ Degenhardt, D. C., Greene, J. K., Khalilian, Ahmad. Temporal Dynamics and Electronic Nose Detection of Stink Bug-Induced Volatile Emissions from Cotton Bolls. *Psyche: A Journal of Entomology*. 2012, p 1–9.

¹⁰⁵ Yinon, Jehuda. Detection of Explosives by Electronic Noses. University of Central Florida. *Analytical Chemistry*, 2003, p 99.

¹⁰⁶ Kumar, S. & Marescaux, J. *Telesurgery*, New York, 2007, p 142.

¹⁰⁷ The Agreement on Trade-Related Aspects of Intellectual Property Rights, art 15(1), Protectable Subject Matter. Accessible: https://www.wto.org/english/docs_e/legal_e/27-trips_04_e.htm, May 10th, 2018.

considered another, where non-conventional marks are not directly ruled out as a protectable subject matter.

Today, the technology has reached a threshold where it is possible to compress odours into a digital format and be downloaded, stored and easily accessed by smartphones via internet.¹⁰⁸ The rapid advances in technology overall will have us expect that e-sensing will be commonplace in the future. Adopting this technology into trade mark law could potentially solve the problem for typical scent mark related issues.

¹⁰⁸ Friedmann, D. *Journal of Intellectual Property Law & Practice*. EU opens door for sound marks: will scent marks follow? Vol. 10, No. 12, 2015, p 932.

CONCLUSION

What legally constitutes a scent as a trade mark and what type of unresolved legal issues have arisen so far? Furthermore, what type of adjustments would be needed for a clearer legal definition for scents as trade marks, and what potential problems could arise in the near future?

Smells may play a major factor on determining one's actions. They can indeed affect consumers decision making on both a conscious as well as on unconscious level. Certain scents can bring forth ancient memories and have an effect on sentimental level bearing and generating nostalgia as well as other state of minds, and therefore be a very important tool in marketing. Subsequently, smells may also have commercial value, and manufacturers have applied for particular smells to be recognized as trade marks. However, gaining registration for a scent mark (or olfactory mark) is not as easy as it is for conventional trade marks. National legislation and legal praxis differs slightly from country and continent, and nowhere is it considered something to be taken for granted. In the EU, only few olfactory marks have been accepted as a trade mark in spite of applications made for several other scents. Following the ruling in the Sieckmann case in 2005, registration of scent marks became virtually impossible. The requirement of graphical representation has been an insolvable obstacle for applicants of scent marks.¹⁰⁹ The new EUTMD 2015/2336 has abolished the requirement, yet the strict criteria established in Sieckmann remain as a prerequisite in the new legislation. Nonetheless, with the facilitation of the requirement of graphical presentation in the EU legislation, scent marks today have a brighter future than before.

Globally, many competent authorities are aware of the breaking of conventionality among trade marks and have taken in account the required precautions by enlightening legislators about the possibility of future adjustments regarding non-conventional marks. It could be said that the future is preparing for scent marks. One example of this is the Article 18.18 of the Trans-Pacific

¹⁰⁹ *Ibid.*

Partnership Agreement (TPP) signed on February 4th, 2016. The particular Article not only establishes the fact that trade marks should not need to be necessarily visually observable to gain protection, but that the parties of the treaty should make their “best efforts” to register scent marks.

¹¹⁰ This is indeed an upright step forward. More international treaties and conventions regarding trade marks should take part in regarding the future of non-conventionality. There has been a large number of international conventions and agreements regarding trade marks, such as the Nice Agreement¹¹¹, Vienna Agreement¹¹², Madrid Agreement¹¹³, TRIPS¹¹⁴, Trade Mark Law Treaty¹¹⁵ and Paris Convention¹¹⁶. These agreements and conventions have provided many benefits for trade mark holders and applicants, such as classification for marks and possibilities to register trade marks more conveniently in several nations. However, it is impossible to overlook the fact that none of the agreements or conventions provide any international consideration for the registration or protection of scents as trade mark. Moreover, the recent tension concerning global trade, with the US possible withdrawing from certain free trade agreements, could well have an unpredictable effect on trade mark registration.

After analysing the positions of different countries, it can be understood that the courts have been directed by academic literatures written by attorneys and legal experts on this issue. The groundbreaking decision of the U.S Supreme Court in the *Qualitex* case¹¹⁷ opened up the possibility of protection for non-conventional trade marks in the U.S. Hawes and Hamersley are known to have supported the granting of registration to scent marks in their writings regarding U.S case law, meanwhile the ECJ followed the writings of Ellias, who found some gaps in the former theories regarding the registration of non-conventional trade marks. However, it is still important to remember that the Sieckmann test has been accepted and is used almost worldwide to determine whether a sign is capable of registration or not. Yet, while the decisions from Sieckmann and Eden cases confirm that scents can indeed function as trade marks, Eden additionally determines that

¹¹⁰ Trans-Pacific Partnership Agreement, art 18.18; Types of Signs Registrable as Trademarks. Accessible: <https://ustr.gov/sites/default/files/TPP-Final-Text-Intellectual-Property.pdf>, April 22nd, 2018.

¹¹¹ Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks 11th edition, set into force January 1st, 2017.

¹¹² The Vienna Agreement Establishing for International Classification of the Figurative Elements of Marks concluded in 1973. Seventh edition, set in force January 1st, 2013.

¹¹³ Madrid Agreement for the International Registration was signed on 14 April 1891, came into force 1892.

¹¹⁴ Agreement on Trade-Related Aspects of Intellectual Property was concluded as part of the Uruguay Round on the re-negotiation of the GATT in 1994, which established the WTO. It entered into force on January 1, 1995.

¹¹⁵ Trademark Law Treaty 1994 came into force on 1 August 1996.

¹¹⁶ Paris Convention for the Protection of Industrial Property was signed on 20 March 1883, came into effect on 7 March 1884 and has been revised several times, the last occasion being the Stockholm Amendment in 1967.

¹¹⁷ *Qualitex*, *Supra nota* 76.

scent mark owners and applicants should try to avoid choosing scents that could be considered flexible. Eden further demonstrates that trade mark owners should avoid selecting scents that may be considered variable. A description should be both unequivocal and precise, and evidence supporting the unequivocal nature of the proposed scent may be helpful. Any evidence that may be interpreted subjectively should be avoided. The Board of Appeal's decision in *Vennootschap* could be considered as the “rising tide” signal for scent marks before Regulation (EU) 2015/2424.

The new EU Regulation no. 2015/2424 and the EUTMD 2015/2436 have made the playing field for future scent marks wider by the deletion of the requirement of graphical representation from the concept of trade mark set out in Article 4 of Regulation no. 207/2009. Now when the problem relating to graphical representation, and thus, registration is removed, we could presume that more businesses and especially larger companies might want to expand their brand and trade marks to scents (keeping in mind the Chanel No. 5 scent mark application¹¹⁸). This potential “onslaught” of scent marks in the market could lead to many complications which is why there is a need for clear and precise statutory provisions, or “a set of ground rules”. Before the removal of the graphical representation clause, the Sieckmann seven criteria could have been considered as a limiter of scent marks. Not anyone could have successfully registered a scent mark. Now, after the removal however, we could see the very same ongoing phenomenon that currently determines websites globally. For an extended period of time, all one needed to do is register a certain website in time, and consequently prohibit anyone else from using it.

So how does one prevent these potential problems? The distinction of a scent as unique is the starting point for a scent to be recognized as scent mark. The scent must be atypical enough to be able to stand out from scents used by other business practitioners. Therefore, the threshold should and will be set high in order to maintain the balance between competition and exclusivity in the market. However, it must also be such an unusual odour that its protection does not unduly limit the freedom of competitors to operate. This is obviously something that is not done overnight, not to mention that we are yet to see how the new case law develops from Regulation no. 2015/2424 and the EUTMD.

Since the new wording of the Regulation No.2015/2424 Section 9 states that: ”A sign should be permitted to be represented in any appropriate form using generally available technology, and thus

¹¹⁸ Chanel’s No. 5 Application, 31.11.1994.

not necessarily by graphic means...”, one, a rather interesting approach would be to make practical the use of the “available technology” in question. The EUIPO could update itself technologically and incorporate this technology within its everyday work tools, thus creating a world-wide international electronic database for scent marks as a trade mark register. As it has been mentioned, there are number of companies currently developing computerized olfactory technologies. This area of technology is expanding rapidly and has already been introduced to medical professionals to help diagnose diseases, as well as in other fields. The same technology and methods could be adopted into trade mark protection. This would solve the problem for governments that are trying to find out ways to clearly and effortlessly define one odour from another, and then to be able to observe the distinctive characters of the scents in question from those already in the market. The requirement of easy accessibility could be accomplished by attaching a scent dome (or another similar e-sensing device) to a PC for those who would be interested consulting the trade mark, or in this case the scent mark register electronically. Additionally, the threshold to gain registration should be held high in order to avoid onslaught, and eventually an overload of scent marks. Adding a random odour or a simple smell on a product should not, of course, constitute a scent mark. By providing an opportunity to sample the odour of the scent mark electronically into the database, would also provide clarity on the market as well as prevent potential disputes regarding the mark in the future. In addition, olfactory scent mark registration could implement any other available technology which would enable quick access to identification and differentiation among scents as trade mark.

Despite the removal of the graphical representation requirement from the concept of EU trade mark law, a scent mark could only be registered if it also met the distinctiveness requirement, e.g. if it can distinguish the product or service in question, hence, work as a trade mark. In respect to this, when a scent mark is to be used relating to a certain product or service which usually have an odour, for example adding a scent mark to a product which already smells (e.g. a perfume or a candle), such a mark will most likely be considered lacking distinctive character and thus, it would be unable to gain registration. However, on the contrary side, when a scent mark is added to a product which does not have a conventional odour itself (e.g. darts & tennis balls), it should have a higher potential of gaining registration and protection.

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