Non-traditional trademarks
Registration of aural and olfactory signs as trademarks in accordance with the latest amendments of the European Trademark Regulation 2015/2424 and Trademark Directive 2015/2436

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Summary

Trademarks are an essential and usual part of business. Even though the most part of signs registered in the European Union consists of ‘traditional’ marks (such as words, letters, numerals, etc.), with the development of technologies the registration of ‘non-traditional’ marks (such as colours, sounds, holograms, smells, etc.) became possible and sometimes daily practice.

In 2015, European Commission and European Parliament faced the necessity to harmonize an established trademark system by amending the regulations. One of the main changes was the removal of the graphical representation requirement which opens new possibilities for trademark holders in relation to register non-traditional marks like olfactory marks that were not generally accepted for the registration before.

This thesis is a brief research of the requirements that are established for the registration of non-traditional marks and the future perspective of European trademark regulation due to the latest amendments.
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Introduction

Trademarks are used for an identification of a particular goods and services. With the registration of a mark a trademark owner receives a right to prevent an unauthorized use of the mark and a right to use a trademark in order to distinguish goods and services from competitors’. Registration of a trademark gives a monopoly to its holder, so that the owner is able to prevent third parties from using this trademark.

The European Court of Justice (ECJ) called a usage of a trademark an indicator of goods and services as one of the essential function of the trademark\(^1\). The articles of the Directive and the Regulation do not mention this essential function but Recital 16 (former Recital 10) of the Direction states that:

“The protection afforded by the registered trade mark, the function of which is in particular to guarantee the trade mark as an indication of origin, should be absolute in the event of there being identity between the mark and the corresponding sign and the goods or services. The protection should apply also in the case of similarity between the mark and the sign and the goods or services.”

Another trade mark function is a brand image which applies in markets “where goods are not so differentiated where consumers make purchase choices relying also and mainly on the “brand image” of the mark”\(^2\).

Even though a trade mark is often perceived as a two-dimensional word, slogan or symbol which is registered to distinguish goods and services, non-traditional or non-conventional trademarks take a stronger position in the European trade mark law every year. Applicants for non-traditional trademarks have to face immense number of barriers during the registration process comparing to traditional word and figurative marks.

Non-traditional trademarks are considered as ‘a new type’ of a trade mark which do not belong to ‘pre-existing’, already known and regulated list of trade marks. Non-conventional

\(^1\) ECJ 23 May 1978, Case 102/77, Hoffmann-La Roche/Centrafarm), Decision, § 7

“the essential function of the trademark . . . is to guarantee the identity of the origin of the trademarked product to the consumer or ultimate user, by enabling him without any possibility of confusion to distinguish that product from products which have another origin.”

ECJ 17 October 1990, Case C-10/89, HAG II, Judgment, § 14

“In order to determine the exact scope of this right exclusively conferred on the owner of the trade mark, regard must be had to the essential function of the trade mark, which is to guarantee the identity of the origin of the marked product to the consumer or ultimate user by enabling him without any possibility of confusion to distinguish that product from products which have another origin.”

Trademarks can be divided into two groups of visible signs (colours, moving images, etc.) and non-visible signs which relate to all five senses (sounds, smells, scents, tastes and textures).

In recent times, single colour trademarks, motion trademarks, shape trademarks (3D trademarks) and sound trademarks have become more widely accepted and registered. For instance, 3D marks, colour per se marks and sound marks can be found on the official page of the European Union Intellectual Property Office (EUIP) as an examples of trademarks which can be registered as well as word marks, figurative marks and figurative marks with letters.

Within the framework of this thesis a special interest for me was found in two categories of non-traditional trademarks – sound marks and smell marks. Sounds signs (also known as aural trademarks) as a trademark are becoming more and more popular in the marketplace. However, it has been traditionally difficult to register a sound sign due to the graphical representation requirement which in some cases leads to problems for trademark owners. Smell signs (also known as olfactory trademarks) have been even more problematic kind of a trademark to register because of the graphical representations of the marks which simply cannot be produced.

Facing the necessity to harmonize trademark registration systems in European Union, European Commission and European Parliament amended Council Regulation №2007/2009 on the Community trademark and Directive 2008/95/EC “in order to make them more efficient for business in terms of lower costs and complexity, increased speed, greater predictability and legal security”\(^3\) and “to modernize the trademark system in Europe, reduce the inconsistencies within the existing regulatory framework, and improve cooperation among trademark offices”\(^4\).

Under the latest amendments of the European trademark regulation, a graphical representation requirement was removed. This essential amendment that will apply only from October 1, 2017 may change the situation regarding the registration of sound and smell signs and other non-traditional trademarks within the European trademark law.

**Purposes of the thesis and research questions**

The purpose of the thesis is to study international, European and national trademark systems related to protection of aural and olfactory trademarks.

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Regarding sound and smell marks, basing on the latest amendments, a couple of essential questions arise. For instance, how ‘traditional’ the registration of sounds may become, will any other kinds of presentation of sound be accepted and will it be possible to designate sound marks as traditional.

Regarding smell signs the following questions may be asked: will it become possible to register a smell mark in the European market, with the removal of graphic representation requirement there is a question of how and in which form smell signs will be presented to the Office and will this kind of presentation be considered sufficient for the registration. Another question is what might be done with the temporary effect of the smell. Will it be possible to keep samples of the smell and will they be the same after some time? Also, if there is a necessity of granting the registration to smell sign as a trademark. Would it change the essential function of a trademark?

**Method and Materials**

Protection of non-traditional trademarks has been regulated in four main dimensions that were used during the work on this thesis:

1) International level including the Paris Convention, the Madrid Agreement, the TRIPS Agreement and the Trademark Law Treaty which in one way or another touched the regulation of non-traditional trademarks. During the analysis of international systems, WIPO and SCT were also included even though their opinions and conclusions are only recommendations and are not obligatory, and are used in order to overview enforceability of international acts in various national jurisdictions.

2) Regional level – the BOIP regulates and provides the information about the kinds of marks that are eligible for registration as trademarks including some kinds of non-traditional marks and does not directly excludes non-visual marks from the registration.

3) European level includes two main regulations – Trademark Regulation 2015/2424 and Trademark Directive 2015/2436 which are the main subject of this thesis due to the latest amendments of the legislation. Also, case law and EUIPO practice that clarify the majority of questions regarding non-traditional trademarks.

4) National regulation of European Union Member States in this thesis is based on examples of German, French and Swedish national trademark system. Moreover, trademark system and case law of the United Kingdom and the United States of America show examples of complying with the legislation regarding aural and olfactory trademarks.
Methodological basis of this research includes general scientific and legal methods and comparative, logical and systematic analysis of laws and regulations.

**Delimitation**

The thesis is focused on two types of non-traditional trademark – aural and olfactory marks. At the moment sound marks are eligible for registration as trademarks in the European Union but the situation with smells as trademarks is more complicated. Nevertheless, both of these categories are the main scope of this research.
Chapter I. Legal background

Traditional examples of trademarks are limited to word, symbol design, or a combination of thereof. Even if there may be any difference of marks from country to country, these categories have been kept the same. The definition of non-traditional trademarks is extremely wide and generally unconventional marks are considered as ‘a new type’ of a trademark which do not belong to ‘pre-existing’, already known and regulated list of trademarks and the definition of a non-traditional trademark is extremely wide.

The Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) that was established by the World Intellectual Property Organization (WIPO) in its analysis of the non-traditional trademarks divided them into visual trademarks (three-dimensional marks, colour marks, holograms, motion marks and others) and non-visual trade marks (sound marks, olfactory marks, taste marks, texture marks).

1.1 International regulation

The Paris Convention for the Protection of Industrial Property does not give a definition of not traditional nor non-traditional trademarks stating only that “The conditions for the filling and registration of trademarks shall be determined in each country of the Union by its domestic legislation” and thus do not exclude non-traditional trademarks from the scope of trademark protection. At the same time, it is up to domestic countries regulation to include or exclude non-conventional marks from the protection.

The Madrid Agreement and the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks and the Agreement Concerning the International Registration of Marks are also silent on the issue of a trademark definition and do not specify the scope of a mark. Nevertheless, “it is possible to construe that non-traditional trademarks such as “sound” may be included”. At the moment, filing of an application for any mark under the Madrid Agreement is acceptable.

The definition of a trademark is given in Article 15 (1) of the Agreement on Trade-Relates Aspects of Intellectual Property Rights (TRIPS Agreement) stating that “Any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking

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from those of other undertakings, shall be capable of constituting a trademark” 8. Also, this article provides a non-exhaustive list of marks which can be considered as trademarks: “Such signs, in particular words including personal names, letters, numerals, figurative elements and combinations of colours as well as any combination of such signs, shall be eligible for registration as trademarks.” 9. Even though this list of marks is non-exhaustive, the TRIPS Agreement does not exclude the possibility to register non-visual non-traditional trademarks stating that: “Members may require, as a condition of registration, that signs be visually perceptible.” 10. According to this statement, as long as non-visual signs are used as a trademark, have a distinctive character and can be visually perceptive (which can be a requirement for some countries) they might be registered as trademarks.

For instance, during one of the meeting concerning the TRIPS Agreement Bolivia proposed to add a solution regarding non-visual trademarks. It proposed that “sounds, smells, three-dimensional shapes and so forth are capable of being represented graphically and, therefore, should be eligible for registration as long as they have distinctive character” 11. Nevertheless, those types of marks should be distinguished from the goods to which they are attached, for instance, regarding perfumes and other fragrance products, the smell of the perfume cannot be protected as an olfactory mark by trademark law.

The only international treaty that directly excludes non-traditional marks from the trademark protection is Trademark Law Treaty which was signed in 1994:

“This Treaty shall not apply to hologram marks and to marks not consisting of visible signs, in particular, sound marks and olfactory marks” 12.

However, the International Classification of the Figurative Elements of Marks (Vienna Classification) provides a list of non-traditional trademarks which may be registered including sound marks (Category 24.17.10 Musical symbols) and colour marks (Category 29.1 Colours).

The international treaties provide only basic protection for conventional and some non-conventional trademarks and leave it up to their members’ discretion if they want to protect non-traditional trademarks or to directly exclude, for instance, non-visual trademarks from the

9 Ibid.
10 Ibid.
possibility to gain trademark protection. Moreover, because of the lack of unified international regulation, domestic laws of treaties members vary widely.

1.2 Regional regulation – the Benelux Office for Intellectual Property

Another organization which is responsible for registration of trademarks is the Benelux Office for Intellectual Property (BOIP). It is the official body in the Benelux territory and was established by the Benelux Convention on Intellectual Property. Article 2.1 (1) of the aforementioned Convention formulates a list of signs that may constitute a Benelux trademark and requirements of the Office for a registration of a trademark:

“I. The names, drawings, imprints, stamps, letters, numerals, shapes of goods or packaging and all other signs that can be represented graphically and that serve to distinguish the goods or services of an undertaking shall be considered as being individual trademarks.”¹³

Also, the official website of the BOIP provides with the information about the kinds of trademarks that may be registerable if all of the requirements are fulfilled: word marks, device mark (logos and labels) and other kinds of marks such as shape marks (three-dimensional marks), colour marks and sound marks (which are eligible for registration if they are presented in the form of a musical stave). In the meantime, the BOIP reserve a right to refuse in a registration of trademark if a person files a sign which cannot be a trademark. Other types of non-traditional trademarks as olfactory marks can also be registered if they meet all the requirements of the Office.

Thus, the BOIP unlike some international regulations provides with trademark protection for not-traditional marks and does not directly exclude non-visual marks from the registration.

1.3 European Union regulation

European Union Trademark Law is based on two main pieces of legislation: the Trademark Directive 2015/2436 (which “seeks to harmonize the national trademark systems of the EU Member States”¹⁴) and the European Union Trademark Regulation 2015/2424 (which “establishes directly applicable rules for an EU-wide trade mark system – the community trademark”¹⁵).

¹⁵ Ibid.
Facing the necessity to harmonize trademark registration systems in European Union, European Commission and European Parliament amended Council Regulation №207/2009 on the Community trademark (to the EU Trademark Regulation 2015/2424) and Directive 2008/95/EC (to the Trademark Directive 2015/2436) “in order to make them more efficient for business in terms of lower costs and complexity, increased speed, greater predictability and legal security”\textsuperscript{16} and “to modernize the trademark system in Europe, reduce the inconsistencies within the existing regulatory framework, and improve cooperation among trademark offices”\textsuperscript{17}. Moreover, according to the Press Release of the Office for Harmonization in the Internal Market (OHIM) from 24.12.2015, Community trademark will be renamed to ‘the European Union trademark’\textsuperscript{18}.

Within the framework of the European Union an EUTM (former OHIM registration system) was established and it is “a single registration that provides protection in all 28 Member States of the European Union and it is much cheaper alternative to obtaining national trademark registration in all Member States”\textsuperscript{19}. A person who is seeking a trademark protection may also file a domestic application or an EU trademark application, or both. Also, according to the International Trade Mark Association announcement in compliance with the latest amendments of the Amending Regulation “it will be necessary to ensure that all offices are equipped to manage different kinds of non-traditional filings and provide for search mechanisms (author’s note: for instance, accepting MP3 files for the purpose of registering sound marks)”\textsuperscript{20}.

According to Trademark Directive and Trademark Regulation a trademark “\textit{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}”\textsuperscript{21}. Also, it is stated that signs that seek the registration should be capable of: “\textit{(a) distinguishing the goods or services of one}

\textsuperscript{18} Casado, L., McDonald, R. Press Release of the Office for Harmonization in the Internal Market (trade marks and designs), EU Intellectual Property Office – new name for the EU’s largest intellectual property agency, 24.12.2015, p.1: “as from 23.3.2016, which will be 90 days after the legislation came into force, OHIM will be known as the European Union Intellectual Property Office (EUIPO), while the Community trademark will be renamed the European Union trademark.”
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”

1.4 Graphical representation requirement within the framework of the European Union trademark regulation

Graphical representation requirement was an essential requirement for the registration of any kind of trademark. According to the Court’s decision in Sieckmann case the graphic representation “must enable the sign to be represented visually, particularly by means of images, lines or characters, so that it can be precisely identified”

The necessity of this requirement can be explained through the essential functions of the graphic representability requirement, such as to define a mark as it helps to perceive it unambiguously, to determine a precise protection for this mark, to provide an information about the presented sign for the competent authorities to fulfil their obligations in relation to the examination of a mark.

Considering the fact that the representation requirement was an inseparable part of the application, the removal of a graphical representation requirement while filing the trademark application should be considered as one of the key areas of amendments. The graphical representation requirement was considered as an obstacle to the registration of smells and touch marks. That is why as soon as the latest amendments come into the force it may become easier for trademark holders to file and register non-traditional trademarks, for instance such as sound marks, movement marks or smell marks (which faced difficulties during the process of registration at the territory of the European Union due to lack of the graphical representation).

The definition of ‘a trademark’ under Article 2 of the old Trademark Directive 2008/95/EC was:

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

According to the latest amendments of Article 4 of Trademark Regulation and Article 3 of Trademark Directive the necessity of a sign to be represented graphically was removed and non-traditional marks such as colour signs, shape signs and sound signs were added to the list:

“A trademark may consist of any signs, in particular words, including personal names, or designs, letters, numerals, colors, the shape of goods or of the packaging of goods, or sounds, provided that such signs are capable of:

- Distinguishing the goods or services of one undertaking from those of other undertakings; and
- 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.”

Moreover, Recital 13 of the Trademark Directive states that:

“To this end, it is necessary to list examples of signs which are capable of constituting a trade mark, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings. In order to fulfil the objectives of the registration system for trademarks, namely to ensure legal certainty and sound administration, it is also essential to require that the sign is capable of being represented in a manner which is clear, precise, self-contained, easily accessible, intelligible, durable and objective (the legislator names the criteria established by Ralf Sieckmann v Deutsches Patent und Markenamt). A sign should therefore 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 offers satisfactory guarantees to that effect.”

Nevertheless, the removal of the graphical representation requirement from the definition of a trademark in Article 4 was counterbalanced by the legislators by amending Article 7(1)(e) of the Trademark Regulation and Article 4(1)(e) of the Trademark Directive and adding the words “or another characteristic” to all three sub-points of these two articles24. According to the

1. The following shall not be registered: (e) signs which consist exclusively of:
   (i) the shape, or another characteristic, which results from the nature of the goods themselves;
   (ii) the shape, or another characteristic, of goods which is necessary to obtain a technical result;
   (iii) the shape, or another characteristic, which gives substantial value to the goods.
Merriam-Webster online dictionary “characteristic” is “a distinguishing trait, quality, or property” and it may include not only shapes but also colour, smell, sound, touch, etc. It is possible that these amendments would outweigh the removal of graphic representation requirement and may become a real threat to the registration of non-traditional signs and that is why trademark owners will have to keep an eye on how the ECJ would interpret the meaning of “another characteristic” in the context of the amended Trademark Regulation and Directive.

Moreover, the removal of the graphical representation requirement was also clarified by the Office: “This means that signs can be represented in any appropriate form using generally available technology, as long as the representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective”\(^\text{25}\).”

The new Regulation’s amendments will apply from October 1, 2017 – 21 months after the publication of the Regulation and Directive and Member States have to implement the changes into domestic law till January 15, 2019.

Thus, it is impossible to register signs which do not conform the requirements of European regulations. In order to be registered, a trademark has to satisfy three main criteria:

1) It must be an acceptable sign\(^\text{26}\) – as it is defined in the ‘list’ of signs of which an EU trademark may consist in the Regulation 2015/2424. Two categories of non-traditional marks such as ‘sounds’ and ‘colorous’ will be added to this ‘list’ from October 1, 2017;

2) It must be capable of distinguishing the goods and services of one undertaking from those of other undertakings\(^\text{27}\) - every sign which is applied for the registration must be capable of distinguishing in some way;

3) It must be applied for in an acceptable representation\(^\text{28}\) - this criterion depends on when the European Union trademark application was filed. If an application was submitted before October 1, 2017 then a sign should be capable of being represented graphically. Applications that will be filed after this date (when the amendments come into the effect), a sign must be applied for “in a manner which enables the


\(^{27}\) Ibid.

\(^{28}\) Ibid.
competent authorities and the public to determine the precise subject of the protection afforded to its proprietor”

1.5 National regulation

Taking into account that Member States have time till January 2019 for implementing the latest amendments into their domestic law, it is necessary to evaluate their level of protection of non-traditional trademarks.

1.5.1 Germany

Regarding the number of registered national sound marks Germany upholds the first place comparing to other Member States.

Under the current Trademark Law which was revised in 1996 because of the need to ratify the EU Trademark Directive, non-traditional trademarks are the subject of protection (Section 3):

“(1) All signs, particularly words including personal names, designs, letters, numerals, sound marks, three-dimensional designs, the shape of goods or of their packaging, as well as other wrapping, including colors and color combinations, may be protected as trademarks if they are capable of distinguishing the goods or services of one enterprise from those of other enterprises”

In the meantime, Section 8 provides the necessity of graphical representation: “(1) Signs eligible for protection as a trade mark within the meaning of section 3 which cannot be depicted graphically shall be excluded from registration”. According to this legislation sound marks may be registered if they are capable of distinguishing from other marks and comply with the graphic representation requirement.

In relation to scent marks, they might be registered as trademarks under the German trademark law if their distinctive character will be proven. However, after the Sieckmann case the German Patent and Trademark Office had not yet accepted any submitted graphical presentation of olfactory marks.


31 Ibid, Section 8.
1.5.2 France

Being a Member State of the European Union, French regulation of trademarks also requires the capability of distinguishing from other marks and graphical representation of marks. Article L711-1 of the Code de la propriété intellectuelle states that:

“Signs may include: (a) denominations in all forms, such as: words, combination of words, surnames and geographical representations, pseudonyms, letters, numerals, abbreviations; (b) audible signs such as: sounds, musical phrases; (c) figurative signs such as: (...) shapes, particularly those of a product or its packaging, or those that identify a service; arrangements, combinations or shades of colour.”32

Even though France as a Member State has to be in congruence with the European regulation, “the standards for the requirement are deemed less strict than other member states”33. For instance, for sound mark “a submission of musical notation is recommended for sound marks consisting of musical elements, but descriptions by text or sonogram is permitted for trademarks that have won musical elements.”34

1.5.3 Sweden

According to the Swedish Trademarks Act a sign that is “capable of being represented graphically, particularly words, including personal names, figurative elements, letters, numerals, and the shape of goods or of their packaging, provided that the signs are distinctive”35 can be registered as a trademark. There is no direct limitation of signs that cannot be registered although signs that are not capable of being represented graphically, for instance, scents cannot be registered. For a trademark to be adequately graphically represented it must be clear, precise, self-contained, easily accessible, intelligible, durable and objective.

To sum up, in compliance with the European regulation Germany, France and Sweden had to codify the graphical representation requirement which according to the latest amendments they will have to revoke before January 15, 2019. At the moment, all the applications submitted before October 1, 2017 must comply with the requirement of graphical representation in order to

be registered. The domestic regulation of Germany and France already includes non-traditional trademarks such as sounds, colours per se and shapes in the trademarks list. In Swedish turn, the legislation does not provide a trademark protection for non-traditional trademarks except for shapes of goods.
Chapter II. Aural trademarks.

Sound provides people with information about the world around them. Sound marks which are used to uniquely identify the origin of goods or services became a common practice nowadays but recognizing sounds as trademarks was not always feasible. Generally, music tones, ring tone, noises, songs, sound of flowing water, sound of moving plant and leaves and etc., can potentially be a sound mark. The only problem that might appear with sound marks is how to represent them graphically for authorities to accept it.

2.1 International and European regulations of sound marks

Category 16 of the Vienna Agreement Establishing an International Classification of the Figurative Elements of Marks states that sound recordings or reproductions may be registered as trademarks. Moreover, Code Category 24.17.10 creates a possibility to register musical symbols. Auxiliary Sections Associated with Principal Section 24.17.10 clarifies different types of sound marks which are entitled to registration as a trademark: “A 24.17.11 Treble clefs alone; A 24.17.12 Notes alone; A 24.17.13 Treble clefs with notes and stave or with stave alone; A 24.17.14 Other musical symbols”36.

The possibility of registration of sounds and noises as trademarks is not guaranteed by international regulations. For instance, TRIPS Agreement states the requirement of distinctiveness of the mark as an essential one and leaves the decision about obligingness of the graphical representation requirement at Members’ disposal (TRIPS Agreement, art. 15). At the same time, even though the list of the trademarks which is stated by TRIPS Agreement is non-exhaustive, sound marks are not mentioned as signs which are eligible for registration as trademarks.

The BOIP also does not mention a sound mark as a sign which may be considered as ‘an individual trademark’ although the official website of the BOIP reckons sound marks as signs which are eligible for registration in case of their fulfillment of all requirements including the graphical representation requirement (it shall be represented in the form of a musical stave).

Unlike international regulations, the Amended Regulation of the European Union (Trademark Regulation and Trademark Directive) not only removed the graphical representation requirement (stating that “a sign should therefore 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 offers satisfactory guarantees to that effect”\(^{37}\) but also added various non-traditional categories of marks which are eligible for registration as trademarks including sound marks: “A trademark may consist of any signs, ... including... sounds...”\(^{38}\).

### 2.2 A distinctive character of a sound mark

Both the international and European regulations point out the essential requirement of a distinctive character of the sign, leaving an indispensable requirement of graphical representation up to the Members (in case of the international regulation) or removing the necessity of this representation completely. Nevertheless, the Amendment Regulation includes the requirements which were established in Sieckman case stating that “it is also essential to require that the sign is capable of being represented in a manner which is clear, precise, self-contained, easily accessible, intelligible, durable and objective”\(^{39}\) and to satisfy these requirements it is necessary for a trademark holder to represent the potential trademark in any way which will prove that the sign is eligible for registration.

The criteria of having a distinctive character of a sound mark applies in the same way as to other types of trademarks. Registrability of a sound mark depends on “whether the sound is capable of identifying the goods and services as originating from a particular undertaking, and thus distinguishing it from other undertakings”\(^{40}\) just like word marks or other types of trademarks.

However, the average consumer sometimes might not perceive a sound mark as a trademark at the same way as other categories of marks and this may rise problems in order to establish the distinctive character of the mark. For instance, a sound mark which contains of a simple note or a combination of musical notes “is unlikely to be recognized as a trademark in respect of goods which can emit sound”\(^{41}\). Companies which produce mobile phones and computers may register a sound mark for their products, for instance, a single beep or a series of musical notes when the computer is turned on and off.

The example of sounds which might be considered as non-distinctive is “the ‘pop’ of a cork in relation to champagne, ‘a ping’ sound in relation to microwave ovens or the retail of

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\(^{38}\) *Ibid.,* Art.3.


\(^{40}\) Intellectual Property Department, the Hong Kong Special Administrative Region, Trademark Registry, Sound marks, October 24, 2008, p.4.

\(^{41}\) *Ibid.*
microwaves, the sound of glass breaking for glass or windscreen repair services”\textsuperscript{42}. Also, a complete song or a long piece of musical notation (even if this sound is familiar to the public) probably wouldn’t be registered as a trademark as it may not fulfill the distinctive requirement. Music which is commonly used for special occasions or sounds which an average consumer associates with a particular goods or services may need an additional evidence of distinctiveness (for instance, trying to register the sound of “The Blue Danube” waltz for the ice cream van). Moreover, common sound like children giggling for child care services or well-known pop-music for amusement park services may also face difficulties with the registration due to the lack of distinctive character. Nevertheless, when the filed for registration sound mark contains a non-distinctive sound but is combined with other elements such as words which are distinctive, it will be considered as a whole and might be registered.

\textbf{2.3 Musical notation as a graphical representation of a sound mark}

In 1999, the Nokia’s EUTM application was received by the Office for the registration of the musical symbol which included the graphical representation in the form of musical notation:

\begin{center}
\includegraphics[width=0.8\textwidth]{nokia_tune.png}
\end{center}

\textsuperscript{43} The Nokia tune which is also called ‘The Grande Valse’ is the first identifiable musical ringtone on a mobile phone.

In the Opinion of Advocate General on the \textit{Shield Mark BV v Joost Kist} case it was pointed out that a sound which was filed for the registration needs to be accompanied by musical notation as it makes the sound “perfectly recognizable and leaves no room for doubt”\textsuperscript{44}.

\textsuperscript{42} \textit{Ibid.}
\textsuperscript{43} European Union Trademark №001040955.
A sound file of the Nokia tune: https://upload.wikimedia.org/wikipedia/commons/b/bd/Nokia_tune.ogg.
\textsuperscript{44} Opinion of Advocate General Ruiz-Jarabo Colomer, delivered on April 3, 2003 on Case C-283/01 Shield Mark BV v Joost Kist, para 39.
Moreover, according to the Opinion there is only one way of presenting the sounds – by setting them out on a musical stave as “the notes written on the stave, together with the key, which determines the tonality, the time signature, which determines the rhythm, (...) and also an indication of the instruments which are to interpret them; (...) they are their ‘fingerprint’”\(^ {45} \). This form of the graphical representation fulfills the requirements which were indicated in Sieckmann case (which was recently implemented to the Amended Regulation – Recital 13 Trademark Directive) as, according to this case, the sign shall be “clear, precise, self-contained, easily accessible, intelligible, durable and objective”.

Among registered European Union trademarks the trademark holders used a lot of different variations of how to represent the sound mark graphically, including musical notation, the combination of consecutive notes, the combination of the spoken words which are superimposed over musical sounds and others. The SCT in its analysis of non-traditional trademarks stated that:

“Offices may require that the representation of sound marks consist of a musical notion on a stave, a description of the sound constituting the mark, or an analog or digital recording of that sound – or of any combination thereof. Where electronic filing is available, an electronic file may be attached to the application. However, for some jurisdictions, only musical notation on a stave may be considered to adequately represent the mark.”\(^ {46} \)

This description allows national EU Intellectual Property offices to decide by their own if they want to apply more or less strict rules for the graphical representation requirement of sound marks.

2.4 Spectrogram and textual description as a graphical representation of a sound mark

Nevertheless, sometimes it is impossible to represent a sound in the form of musical notation. For instance, the lion’s roar at the opening of the Metro-Goldwyn-Mayer Pictures (MGM) films cannot be represented in the form of musical notation on a stave as it is a non-musical sound and that is why it was filed in the form of a spectrogram:

\(^ {45} \) Ibid.
Moreover, the trademark holder added a textual description of the sound to the application:

The sound mark is a sound of a lion roar having a duration of approximately 2.5 seconds. It is composed of two successive roars (0 to around 1.4s and 1.4 to 2.6), the second one having a slightly lower amplitude. The sound is non-harmonic, has fast (>15Hz) non-periodic amplitude envelope modulation (perception of sound roughness) and has dominant frequency content in the low and low-medium range (approximate -6dB range: 40 to 400 Hz for both roars with a peak at 170 Hz for the first one and a peak at 130 Hz for the second one). The perceived dominant frequency range (related to the spectral centroid) of the first roar increases until around 0.35s and decreases afterwards. In the second roar, it increases until around 1.7s, decreases until around 2.2s, increases again until around 2.3s and decreases afterwards.48

At first the OHIM’s Fourth Board of Appeal came to the conclusion that a representation by a spectrogram and textual description do not satisfy the graphical representation requirement, however, later MGM submitted a new application which included a revised form of representation which fulfilled all the Office’s requirements.

Even though the Office accepted the revised application of ‘roar of a lion’, in the Tarzan’s yell case, an applicant submitted a detailed representation in a form of a spectrogram with sound wave images depicting a yell and accompanied by text:

“(...) the yell consisting of five distinct phases, namely sustain, followed by ululation, followed by sustain, but at a higher frequency, followed by ululation, followed by sustain at the starting frequency”49

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47 European Union Trademark №005170113.
48 Ibid.
49 Decision of the Fourth Board of Appeal of September 27, 2007 in Case R 708/2006-4, para 2.
The application was found not clear and easily accessible as a competitor in order to understand a mark “should be able to transform the image into a sound, at least in his brain for himself, or otherwise by transforming it into a sound through technical means”\(^\text{50}\). Moreover, the Board of Appeal held that a verbal description gives only some vague idea pf what an applicant wants to protect but does not clarify the sound itself. Thus, the applicant’s graphical representation was found not intelligible or clear and was not registered as a trademark.

It is important to notice that in the Opinion of Advocate General on the *Shield Mark BV v Joost Kist* case it was pointed out that a textual description of the sound might be too vague for the registration of the sound. Of course, if it comes as an additional part to the musical notation, for instance, it will be considered as a clarification of the sound. Nevertheless, if the application contains only textual description of the sound, as regards to musical notes, “to state that the trademark consists of a specific sequence (for example “E, D#, E, D#, E, B, D, C, A”)”\(^\text{51}\) it will be insufficient and meaningless as the registration will not be granted. However, there might be situations in which textual description of the sound would be “sufficiently expressive and satisfy the purpose of the provision”\(^\text{52}\).

Later the ECJ agreed to the Opinion of Advocate General and held that “the representation of a sound sign by a description using a written language cannot be precluded *a priori* that such a mode of graphical representation satisfies the requirements”\(^\text{53}\) and in *Shield Mark* case this kind of presentation does not make it possible to determine the scope of protection which is sought for these signs.

### 2.5 Sonogram and oscillogram as a graphical representation of a sound mark

Another way of fulfilling the graphical representation requirement is submitting the application of a sound mark in the form of sonogram:

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\(^{50}\) *Ibid*, para 23.

\(^{51}\) Opinion of Advocate General Ruiz-Jarabo Colomer, delivered on April 3, 2003 on Case C-283/01 Shield Mark BV v Joost Kist, para 43.

\(^{52}\) *Ibid*, para 44.

\(^{53}\) Judgment of the Court (Sixth Chamber), November 27, 2003 in Case C-283/01 Shield Mark BV v Joost Kist h.o.d.n. Memex, para 59.

For instance, a German company HEXAL AKTIENGESELLSCHAFT filed an application for a sound trademark in the form of a sonogram in 2004. The application which was refused at the beginning because of the fact that “reading and understanding a sonogram at a comparable level to reading musical notation is not straightforward and takes time to get used to: …understanding possible only with the involvement of an expert, no certainty without technical equipment or consulting an expert”\(^{55}\). Later the Board of Appeal annulled this decision and held that a graphical representation in the form of ‘a complete sonogram’ is sufficient and that “it is possible to learn how to understand sonograms, just as one can learn how to understand foreign languages or musical notation”\(^{56}\). Moreover, the sonogram was accompanied by the textual description: ‘Arzneimittel Ihres Vertrauens: HEXAL’ [HEXAL – medicine you can trust].

Furthermore, an application for a sound mark can be filed in the form of oscillogram:


\(^{56}\) Ibid.
In 2016, Polish company applied for the registration of the sound mark including into the application the oscillogram of the sound, its sound file and textual description:

A sound mark consisting of a selection of the noises made by a variety of bird species, arranged in a specific consecutive order. The sound components of the sequence comprise the noises made by the following birds: four different noises made by the swallow, and the jay, starling, blackbird, swallow hawk and hobby. The total duration of sound is 35 seconds.

The OHIM decided in 2005 that if an applicant wants to apply for the registration of a sound mark – “one sound file containing the sound may be filed as an attachment to the electronic application form” but it shall be presented in the .mp3 format and “its size shall not exceed one Megabyte and it shall not allow loops or streaming”. The first applicant which successfully obtained a registered Community sound mark using this option was INLEX IP Expertise. Later Deutsche Telekom has also registered its jingle as a sound mark under the Madrid Protocol.

2.6 Shield Mark v Mr. Kist case

One of the essential cases in which a number of questions about how the graphical representation requirement might be satisfied for sound marks was Shield Mark v Mr. Kist case.

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57 European Union Trademark №015129547.
58 Ibid.
59 Decision № EX-05-3 of the President of the Office for Harmonization in the Internal Market (Trademarks and Designs) of October 10,2005 concerning electronic filing of sound marks, Art.4.
Shield Mark owned 14 sound marks: eleven of those had as their theme “elegiac notes of the étude for piano ‘Für Elise’ and three were the sounds of a cockcrow. Four out of the eleven trademarks of the first group were represented in a form of “a musical stave with the first nine notes of the piece in question”\textsuperscript{60}. The third and fourth marks were accompanied by the description: “The mark is formed by the musical reproduction of the notes (graphically) represented on the stave. In the first of the latter two marks it is stated that the music should be played on a piano”\textsuperscript{61}. Two other trademarks were filed as word marks and their applications included the following description: “consists of the first nine notes of ‘Für Elise’”\textsuperscript{62}. Two more marks were applied with the same word description but as sound marks with the additional information that “the mark consists of the musical reproduction of the notes described and should be played on a piano”\textsuperscript{63}. Another three marks were filed (one of them as a word mark and two others as sound marks) with the description “E, D#, E, D#, E, B, D, C, A”\textsuperscript{64} – this form of the graphical presentation was not accepted by the ECJ which stated that “such a description (…) does not make it possible to determine the pitch and the duration of the sound forming the melody”\textsuperscript{65}.

Regarding three other marks which contained the sound of a cockcrow, two of them were based on the denomination ‘kukelekuuuuu’, and the last one had a textual description: “sound mark consisting of an onomatopoeia representing a cockcrow”\textsuperscript{66} (the onomatopoeia was presented in various forms depending on the official languages of the European Union, for instance, ‘kikiriki’ in German, ‘cock-a-doodle-doo’ in English, ‘kukeliku’ in Swedish). According to the Court’s decision this kind of representation was not sufficient for a registration and that “a simple onomatopoeia cannot without more constitute a graphical representation of the sound or noise of which it purports to be the phonetic description”\textsuperscript{67}.

\textsuperscript{60} Opinion of Advocate General Ruiz-Jarabo Colomer, delivered on April 3, 2003 on Case C-283/01 Shield Mark BV v Joost Kist, para 5. Trademark numbers are 517166, 835113, 931683 and 931688.
\textsuperscript{61} Ibid.
\textsuperscript{62} Ibid, para 6. Trademark numbers are 535083 and 835115.
\textsuperscript{63} Ibid, para 6. Trademark numbers are 931687 and 931689.
\textsuperscript{64} Ibid, para 7. Trademark numbers are 839419, 931684 and 931686.
\textsuperscript{65} Judgment of the Court (Sixth Chamber), November 27, 2003 in Case C-283/01 Shield Mark BV v Joost Kist h.o.d.n. Memex, para 61.
\textsuperscript{66} Opinion of Advocate General Ruiz-Jarabo Colomer, delivered on April 3, 2003 on Case C-283/01 Shield Mark BV v Joost Kist, para 8. Trademark numbers are 835114, 931685 and 931682.
\textsuperscript{67} Judgment of the Court (Sixth Chamber), November 27, 2003 in Case C-283/01 Shield Mark BV v Joost Kist h.o.d.n. Memex, para 60.
Mr. Kist provided a legal consultancy specializing in advertising trademark law and copyright law and he in 1995 he used same sound signs and marketing techniques as Shield Mark for his advertising campaign and that was the reason or Shield Mark to bring the action against Mr. Kist.

The questions which were brought up before the ECJ included if sound marks and noises can be regarded and registered as trademarks, if sound marks need to be represented graphically and if they do in which form should they be presented.

Regarding the question “if sound marks and noises can be considered as trademarks” the Court pointed out that first of all, the protection given to a trademark in one Member State should be equal to that afforded in another Member State throughout the entire territory of the European Union. Thereby as a lot of Member States expressly state that sounds are signs eligible for registration as trademarks (for instance, Germany, Austria, France) and other Member States make no reference to sounds but at the same time do not preclude them from the list of signs that might be registered as a trademark, sound marks should be considered as trademarks throughout the entire European Union. Moreover, the Directive does not contain an exhaustive list of signs of which a trademark may consist and has never precluded sound marks as trademarks thus if a sound satisfies the mandatory requirements of being capable to distinguish and being represented graphically (as case was reviewed in Court before the latest amendments) it might be registered as a trademark.

Moreover, the Advocate General in his Opinion on the Case explained the necessity of the graphical representation requirement stating that symbols which are claimed to be registered as trademarks should be known very precisely because “the authorities responsible for the registration institution (…) must be able to know precisely the object on which the protection is conferred” in order to distinguish goods and services from other undertakings.

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68 Opinion of Advocate General Ruiz-Jarabo Colomer, delivered on April 3, 2003 on Case C-283/01 Shield Mark BV v Joost Kist, para 27.
Chapter III. Olfactory marks

People interact with each other not only through sights and sounds but also through smell. Smell evokes different memories and associations for different people. It cannot be perceived identically but it can be registered as a trademark and have legal protection. Various studies prove that the smell can effect the human’s behavior. For instance, “the smell of the beach soothes people who suffer from relatively severe forms of chronic anxiety”\textsuperscript{69} or “an apple-spice fragrance helps stop panic attacks and reduces stress levels”\textsuperscript{70}. People are surrounded by smells that help to transfer information about the product and that is why companies all over the world try to receive trademark protection for their olfactory marks.

Scent marks can be divided into three categories according to the type of product they relate. “Primary scent marks” are those which have for sole purpose the emission of a fragrance, such as perfumes, air fresheners and etc. “Secondary scent marks” include products that do not serve the main purpose of the object but which nonetheless from a necessary attribute, such as soaps and detergents. “Unique scent marks” are concerned with products which are not enhanced as such by addition of a scent, such as embroidery yarn.\textsuperscript{71}

Olfactory marks may stimulate the consumer’s olfactory memory by helping them to identify a specific product with the use of smell. This kind of mark may be attached to the product or its packaging. However, in order for a sign to achieve a trademark protection it must be distinctive. According to the Office’s and ECJ’s decisions, a distinctive character of a mark can be fulfilled “only when scent is attached to a normally unscented product or when the scent is specifically unique so as to attract consumer recognition”\textsuperscript{72}.

In order to receive the trademark protection, a sign should be presented in a clear and precise way. One of the main arguments of why a smell cannot have a trademark protection is that it is possible for a specific smell to be perceived differently by different people. Thus, even if a smell is distinctive and characteristic it may trigger absolutely different olfactory memories of customers and trademark investigators. Moreover, there might be a problem of the language meaning that it is problematic to find a satisfactory and precise description of a sign. When describing a smell people usually do not define a particular smell but refer to the object they

\textsuperscript{69} Guicioni, B. Wellness Education Centre, Anxiety Info Kit (University of Guelph), OMNI Magazine, 10(12) (1988) 28.
\textsuperscript{72} Shambarta, M. “Can non-traditional signs, such as colours, scents and sounds be protected under Trademark law? If not, what are the alternatives to do so? A comparative analysis between Europe and United States of America”, p. 10.
associate a smell with. This lead to the problem of absence of clear and independent ‘nomenclature’ that can be used for a description of olfactory marks.

### 3.1 International and European regulations of olfactory marks

Unfortunately, the possibility of registering a smell sign is not stated not by the international nor by the European legislation. Even though olfactory marks are not subjoined to the list of marks that are eligible for registration as trademarks, they are not excluded from it. The Paris Convention, for instance, leave it up to domestic countries regulation to include or exclude any kind of non-traditional trademarks from the protection.

The possibility of registration of smells as trademarks is excluded from the TRIPS Agreement. At the same time it does not directly states that olfactory marks cannot be registered as trademarks. Per contra, trying to interpret provisions of article 15, non-visual trademarks can be registered if they are used as trademarks, have a distinctive character and can be visually perceptive.

There were attempts to codify non-conventional marks as signs that can be registered as trademarks, for instance, Bolivian suggestion to amend TRIPS Agreement by adding specific provisions about non-visual trademarks that should be eligible for registration as long as they have a distinctive character and can be represented graphically. However, the only international treaty which directly regulates but, unfortunately, at the same time excludes olfactory marks from the trademark protection is Trademark Law Treaty.

As long as a sign is capable of being distinguished from other goods or services and, according to the latest amendments of the European trademark regulation, of “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”[73]. Also, in order to register an olfactory mark, it must be represented “in a manner which is clear, precise, self-contained, easily accessible, intelligible, durable and objective”[74]. It is necessary to find the right way of representing an olfactory mark for the Office to accept and permit the registration of a trademark.

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3.2 Ralf Sieckmann v Deutsches Patent- und Markenamt case

One of the most important cases regarding the registration of not only olfactory marks but of all non-traditional marks is the Sieckmann case in which Mr. Sieckmann applied for the registration of a smell mark as a distinctive mark which consisted of:

“The pure chemical substance methyl cinnamate (= cinnamic acid methyl ester) with the structural formula - C6H5-CH = CHCOOCH3. Samples of this olfactory mark can also be obtained via local laboratories listed in the Gelbe Seiten (Yellow Pages) of Deutsche Telekom AG or, for example, via the firm E. Merck in Darmstadt”75.

Also, the applicant gave details where one could obtain the chemical and submitted a sample of an odour in a container stating that “the scent was usually described as balsamically fruity with a slight hint of cinnamon”76.

The questions which were brought up by the Bundespatentgericht (the German Federal Patent Court) before the European Court were: if signs such as olfactory signs which neither can be directly represented graphically nor can be perceived visually but can be reproduced with the use of certain additional aid shall be considered and registered as trademarks. Moreover, if the graphical representation requirement is satisfied when an odour “is reproduced (a) by a chemical formula; (b) by a description (to be published); (c) by means of a deposit; or (d) by a combination of the abovementioned surrogate reproductions”77.

While considering the possibility of the registration of olfactory marks as trademarks it is important to firstly find an answer to the question whether there is a necessity of having smell signs as trademarks and how will it influence the essential functions of a trademark. One of the essential functions of a trademark is to be a sign which distinguishes the goods and services of one undertaking from those of another. The distinction between signs must be visible for an ordinary consumer in order to “promote free competition in the market”78. Moreover, a trademark can be perceived as a part of communication, an information which a manufacturer gives to the consumer in order to make him aware of the goods. As communication is a relation between two persons who are trying to transfer the information to one another, all senses might

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75 Opinion of Advocate General Ruiz-Jarabo Colomer, delivered on November 6, 2001 on Case C-273/00 Ralf Sieckmann, para 9.
76 Ibid, para 11.
77 Judgment of the Court, December 12 2002 in Case 273/00 Ralf Sieckmann, para 19(2).
78 Opinion of Advocate General Ruiz-Jarabo Colomer, delivered on November 6, 2001 on Case C-273/00 Ralf Sieckmann, para 17.
be involved. Thus, in order to pass on the information correctly the perception of signs by consumers and manufacturer should be the same and the representation of the sign must be clear and precise.

3.2.1 The distinctive character and graphical representation of an olfactory mark basing on the Sieckmann case

As one of the essential function of a trademark is to represent the distinctive character of a sign it can be presented in any form and with use of any organ a person uses to communicate with the outside world. The distinctiveness of the sign can be perceived by the sense of sight, hearing, touch, taste and, of course, smell.

Although it is possible to transfer a message through any sense, this message may be perceived differently. The reason for this is that “perception of the outside world by human beings differs, depending upon the sense or window through which it takes place”\(^{79}\). According to the Opinion of the Advocate General Ruiz-Jarabo Colomer to this case based on the M.A. Perot-Morel article ‘Les difficultés relatives aux marques de forme et à quelques types particuliers de marques dans le cadre communautaire’ out of all sense signs the senses of taste and touch are not capable of proving its distinctive character (for instance, in order to perceive ‘a taste of apple’ mark it will be necessary either to try an apple and then the fruit itself will be a sign or to try an apple-flavoured product and in this case this product will be a distinctive sign and not the taste). Thus, “only those signs and signals that can exist spatially, such as visual, auditory and olfactory signs, and can be perceived independently of the article of which they represent a characteristic, can be trademarks”\(^{80}\). Nevertheless, a description of a colour or sound can be as difficult and unclear as that of an olfactory sign.

At the same time in neurophysiology there is a distinction between ‘mechanical’ (this group consists of touch, sight and hearing, “which are easily comprehensible because they relate to the concept of shape and form and can be described relatively objectively”\(^{81}\)) and ‘chemical’ senses (smell and taste which are “more problematic due to the absence of precise rules for determining their content”\(^{82}\)). These difficulties may lead to impossibility of presenting not only the distinctive character but also a sign itself.

The necessity of representing a sign is linked with the identification function of a trademark. With the possibility to perceive a sign visually comes a legal certainty in a sign. Ruiz-

\(^{79}\) Ibid, para 24.
\(^{80}\) Ibid, footnote 25.
\(^{81}\) Ibid, para 25.
\(^{82}\) Ibid, para 25.
Jarabo Colomer, the Advocate General, pointed out that “graphical representation *per se* is not enough: it must meet two criteria. Firstly, it must be *complete, clear and precise*, so that the object of the right of exclusivity is immediately clear. Secondly, it must be *intelligible* to those persons having an interest in inspecting the register, in other words other manufacturers and consumers.”

Later the ECJ agreed to the Advocate General’s Opinion and held that the representation of the sign shall be “clear, precise, self-contained, easily accessible, intelligible, durable and objective”, the exact wording was used in Recital 13 of Trademark Directive after the latest amendments which will apply from October 1, 2017.

Moreover, the Advocate General noticed that just a chemical formula of a sign cannot be clear and precise enough to satisfy the requirements. Also, there will be a need to make an experiment in order to prove that a chemical formula is actually a sign which is described verbally, for instance, the formula C6H5-CH=CHCOOCH3 is ‘a balsamically fruity scent with a slight hint of cinnamon’ and only few people will be able to perform an experiment basing on the presented chemical formula.

In addition, the precise smell might change depending on thermal decomposition, the ambient temperature or because of the lower and higher concentrations of compounds or the substance bearing the odour. For example, H.E. Meister in its article stated that “‘freshly-cut grass’ does not smell the same in his home town as in Alicante”.

Also, just a textual description of a sign cannot be sufficient for the registration of a mark due to the lack of precision and clarity. A textual description does not present enough information for a person to understand the smell and might even create more questions. For instance, ‘a balsamically fruity scent with a slight hint of cinnamon’ does not give a precise understanding of what is ‘balsamically’ or ‘fruity’, how intense ‘a slight hint’ should be to create the exact same smell. Of course, the description might be longer and more accurate but instead of answering it may lead to new questions.

Also, submitting of just a sample of the chemical product that produces the smell would not be sufficient for granting a trademark protection. The depositing of a sample will cause another problem in the future – how to publish the registered smell mark and ‘the passage of time’. Because of the volatility of smell’s compounds the smell can change or disappear completely over some time. It was mentioned by the Court during the proceeding that as a

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83 Opinion of Advocate General Ruiz-Jarabo Colomer, delivered on November 6, 2001 on Case C-273/00 Ralf Sieckmann, para 38.
84 Judgment of the Court, December 12, 2002 in Case 273/00 Ralf Sieckmann, para 74(1).
trademark protection can be renewed for varying periods the representation of a mark must be
durable which is difficult to comply with due to the possibility of changing or complete
disappearing of a smell in the course of time.

In case of submitting an olfactory mark with a chemical formula, textual description of a
smell and a smell’s sample it might be considered as clear and precise information about a mark
but sometimes they may lead to the greater uncertainty. A person who is inspecting a mark may
decide that a described smell in the application and a smell presented as a sample are not
identical and refuse in granting the registration.

As it was decided by the Court in the Sieckmann case a trademark may consist of a sign
which is not capable to be perceived visually by itself such as an olfactory mark on condition
that it can be presented graphically with the use of “images, lines or characters”66. At the
meanwhile, it is not sufficient to submit an application for an olfactory mark consisting of a
chemical formula of a sign, a description in written words, a deposit of an odour sample or a
combination of those elements. Moreover, the representation must be clear, precise, self-
contained, easily accessible, intelligible, durable and objective.

3.3 Additional ways of representing smells

There are additional ways of representing a smell, for instance, sensory assessment is a
statistical analysis of human senses including smell for evaluating consumer products. A group
of human assessors are tested and basing on the result a company knows ‘the insights’ about the
product. This test includes three sub-sections: analytical testing (the test is based on the number
of questions about the product which allow to obtain objective facts about the product), affective
testing (includes consumer testing with small focus groups who may be asked to describe or rate
a smell) and perception test (which examines the biochemical and psychological aspects of
sensation).

Another system to ‘record’ a smell is gas chromatography. ‘The Madeleine’ is a kind of
camera that records smells. Around the object one needs to place a funnel to capture the smell.
Then a pump sucks the air across an odour trap made of Tenax – a porous polymer resin which
adsorbs the volatile particles that make up the smell. The odour is captured in ‘an odour trap’
which needs to be submitted for further analysis, for instance, to a fragrance lab in a gas
chromatography-mass spectrometry. The GS-MS machine processes particles of a captured smell

66 Judgment of the Court, December 12, 2002 in Case 273/00 Ralf Sieckmann, para 74.1.
and produces ‘a graph-like’ formula of a smell. Basing on the formula it is possible to recreate the precise odour later.

‘The Madeleine’ was presented as a prototype of a device to ‘record’ aromas in 2013 by Amy Radcliffe, a Master’s student of Central Saint Martins, London. The idea of this prototype is that users will be able to take their ‘odour traps’ to the local lab and process the formula or an identic smell. Even though ‘the Madeleine’ is just a prototype it might be the future of olfactory marks. A company that wants to submit a new smell mark would attach not only a textual description, its own chemical formula and a sample but also an official graph-like formula from a fragrance lab which would allow to recreate a precisely identical sample of an odour. Of course, before the practice of using ‘the Madeleine’ and processing the formula in local labs is an everyday routine it would be rather costly for companies and ‘an ordinary’ person might have difficulties with understanding the presented formula to recreate an odour.

Also, digital scent technology is a specific engineering discipline dealing with olfactory representation. The main goal of this technology is to transmit and receive ‘scent-enabled’ digital media including web pages, video games and movies. For instance, in 2015 FeelReal presented a special ‘mask’ for virtual reality. This mask is loaded with cartridge which produced seven (for now) unique smells: ocean, jungle, fire, grass, powder, flowers and metal. These smells waft through odour generating vents, which are connected to the headset by Bluetooth and powered by a battery with a four-hour life cycle. The mask is also equipped with dual-sided vents for hot and cold air (for simulating the wind) and for the water mist which is sprayed on one’s cheeks.

‘An electronic nose’ is a device to detect odours. In this case a smell is perceived as a global fingerprint which can be recorded by ‘the e-sensing’ instruments that consists on head space sampling, sensor array and pattern recognition modules for generating a pattern for characterizing odours. At first, ‘an electronic nose’ needs to be trained with different samples of smells in order to create a basic database of reference. After that an instrument can detect new samples comparing them to the compounds in its database and analyze them. However, there is a possibility of wrong interpretation of odours which consist of multiple different molecules as a device might register them as different compounds.

‘A scent dome’ is another prototype of a device that creates smell simulations for PC users. The inner part of this device contains a replaceable cartridge that is filled with aromatic oils. Each aroma is translated and encoded in a binary mode and can be released individually and in a combination thus it can create thousands of different smells. Digital instructions are sent by
a special commuter programme on a web site and the device activates and heats the scent which vaporizes and the PC user can smell it.\textsuperscript{87}

The sphere of an olfactory representation is in a constant development but more in a virtual reality domain than in trademark. At the same time, trademark holders can try to use the inventions from other spheres in order to prove to the distinctiveness and clarity of a mark.

3.3.1 \textit{Eden SARL v. Office for Harmonization in the Internal Market case} – ‘The smell of ripe strawberries’

An olfactory mark can be also represented in a form of an image. For instance, an image representing a strawberry was attached to the application of a French company – Laboratories France Parfum SA (‘LFP’)

for an olfactory mark with the verbal description ‘the smell of ripe strawberry’. The Office rejected the application stating that the image of strawberry shows the berry itself instead of the smell of a strawberry and that can confuse the public.

The Court of First Instance had to decide if the combination of the verbal and figurative elements is sufficient for the registration of an olfactory mark. Regarding the textual description, the Court held that the word element is not clear and precise since “the smell of strawberries differs according to the variety”\textsuperscript{88} and that this kind of representation creates a contradiction between the description itself and the actual smell. Moreover, as the Court pointed out the research of the European Cooperation in the field of scientific and technical research proved that “the different varieties of strawberries produce significantly different smells”\textsuperscript{89}. Therefore, the description ‘the smell of ripe strawberries’ was not objective, clear and precise.

In relation to the image of the strawberry the Court agreed with the decision of the Board of Appeal and held that the image “represents only he fruit which emits a smell supposedly identical to the olfactory sign at issue, and nit the smell claimed”\textsuperscript{90} and thus it cannot be regarded as sufficient graphical representation of a sign.

Hence, the Court agreed with the decisions of the OHIM and the First Board of Appeal of OHIM and held that the olfactory sign in question did not meet the requirements of graphical representation and therefore cannot be registered as a trademark.

\textsuperscript{87} Karapapa, S. “Registering Scents as Community trademarks”, 2010, p.24.
\textsuperscript{88} Judgment of the Court of First Instance (Third Chamber), October 27, 2005 in Case T-305/04, Eden Sarl V Office for Harmonisation in the Internal Market (Trade Marks and Designs), para 27.
\textsuperscript{89} \textit{Ibid}, para 31.
\textsuperscript{90} \textit{Ibid}, para 40.
3.4 Odour classification systems

As the ECJ held in Sieckmann case, the representation of a sign has to be clear, precise, self-contained, easily accessible, intelligible, durable and objective. To comply with these requirements an applicant needs to find a way of representing an olfactory mark graphically. One of the possibilities which Mr. Sieckmann did not put forward was “the defining the odour by reference to accepted standard of classification for odorants”\(^{91}\).

For a long time, scientists attempted to create a unified odour system which would help to categorize smells. One of the first systems was developed by the Swedish taxonomist, physician, and zoologist Carl Linnaeus and it included seven categories of smells.

In 1895, Hendrik Zwaardemaker elaborated Linnaeus’ system into ‘Zwaardemaker smell system’ by adding two more odours. This system was generally accepted till twentieth century and included nine categories: ethereal (like ether or beeswax), aromatic (like spice or camphor), fragrant (like lavender or rose petals), ambrosiac (like amber or musk), alliaceous (like garlic or onion), empyreumatic (like roasted coffee or tobacco smoke), hircine (like strong cheese or rancid food), foul (like bedbugs or coriander flower), and nauseous (like faeces or rotten eggs). Later he added between two and five sub-divisions of each class (a total of 30 subclasses at all). This system was considered as the first detailed and comprehensive but nevertheless, “a detailed examination of the botanical and chemical examples given by Zwaardemaker for a few of his subclasses (…) implies that still more subclasses might be needed”\(^{92}\).

Hans Henning attempted to classify smells by reducing Linnaeus’ classes to six categories (flowery, putrid, fruity, spicy, burnt, resinous) and by arranging them into “an olfactory prism” and stating that non-corner smells are the combinations of these categories:

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Nevertheless, the Henning’s olfactory prism was criticized by chemists like, for instance, Malcolm K. Macdonald who used thirty-five odorants which were tested by three observers in order to define if Henning’s prism may be used and came to conclusion that “Henning’s theories (…) may not be applied rigorously, nor does the smell prism represent so definitely understood a system of qualities as does the color pyramid”\(^93\).

Another odour classification was proposed by US chemists Ernest Charlton Crocker and Lloyd F. Henderson in 1927. This system was based on four primary odours: fragrant, acid, burnt, and caprylic (goat-like or putrid). The system permits to rate any given odour in regard to intensity in each of four categories in a 9-point scale (0-8 inclusive). Thus, for instance, “acetic acid is characterized as 3803 – moderately fragrant, very acid, not at all burnt, and moderately caprylic”\(^94\). However, the system is considered as inadequate due to the fact that in order to divide and define the standard odours in each group, “they must differ significantly, one from the other, and may be arranged in order of intensity by any person with a reasonable good, normal sense of smell”\(^95\). These requirements arise a number of questions such as what can be considered as ‘a normal sense of smell’ and how to deal with odours that cannot fall into these four categories or there is no significant difference between them.

Nowadays there is a certain necessity of a universally accepted odour classification system. Unfortunately, all of the systems that were presented previously were found inadequate and insufficient due to their subjective character and impossibility to characterize every smell.

3.5 The practice of registering olfactory marks in the USA

In contrast with the European Union, the United States were the first one to permit the registration of olfactory marks. After reviewing of the Trademark Act of 1946 it was verified by the Trademark Review Commission of the United States Trademark Association that “the terms ‘symbol, or device’ should not be deleted or narrowed to preclude registration of such things as a color, shape, smell, sound, or configuration which functions as a mark”\(^96\).

The first registered olfactory mark was a trademark for sewing thread and embroidery thread, consisting of ‘a fragrance of fresh flowers reminiscent of mimosa’ in September 19

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For proving the fact that the olfactory mark is distinctive the applicant used the so-called ‘secondary meaning’: the applicant demonstrated that customers can recognize the product by the specific smell of scented yarns and threads which was accepted by the Appeal Board. Moreover, the Trademark Trial and Appeal Board of United States in the decision of granting this trademark stated that this kind of registration may apply only to products which are ‘used on a non-functional manner’ meaning that a trademark protection for products such as eau de cologne or detergent is not possible due to the their ‘nature’. The fact that these products have different smell by themselves stops the Office from granting the protection as an olfactory mark should serve a purpose of identifying and distinguishing a brand.

Also, for instance, in June 2001 a trademark for ‘the smell of cherries to identify synthetic lubricants for racing cars or motor vehicles’ for motor shows was registered as an olfactory mark and renewed in 2011.

The legal system of the United States is familiar with ‘the secondary meaning’ that includes the possibility to register a mark even if it has a lack of distinctiveness but is capable to demonstrate the exclusive and uninterrupted usage of a particular sign over a specified period. Section 2(f) of the Lanham Act states that “nothing shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant’s goods in commerce”97. Thus, as long as customers perceive a sign as a trademark of a company even though it is not registered it may be eligible for registration.

‘Secondary meaning’ is also known to the European trademark regulation. Article 4(4) of the Directive and Article 7(3) of the Regulation state that a trademark shall be registered if a sign acquired a distinctive character from “the use which has made of it, before the date of application for registration”98. Whether an olfactory mark achieved ‘a secondary meaning’ depends on the access that consumers have to the scent and if they can recognize and associate a particular smell with a product or a company.

3.6 Vennootschap onder Firma Senta Aromatic Marketing v. Office for Harmonization in the Internal Market case – ‘The smell of freshly-cut grass’

97 The Lanham (Trademark) Act (15 U.S.C), last updated in February 2016, Article 1052(f) (Section 2 of the Lanham Act).
In the framework of the European Union, the former Office for Harmonization on the Internal Market allowed the registration of ‘the smell of freshly-cut grass’ as a trademark for tennis balls. The examiner of the application first refused the registration due to the lack of the graphical representation through the mere wording. Nevertheless, later the Board of Appeal decided that:

“The smell of freshly-cut grass is a distinct smell which everyone immediately recognizes from experience. For many, the scent of fragrance of freshly-cut grass reminds them of spring, or summer, manicured lawns or playing fields, or other such pleasant experiences. The Board is satisfied that the description provided for the olfactory mark sought to be registered for tennis balls is appropriate and complies with the graphical representation requirement of Article 4 CTMR”99.

However, this decision has never been repeated by the Office. In 2002, the European Court of Justice held in Sieckmann case that the graphical representation which was given by the applicant (including chemical formula, textual description and a sample in a container) was not sufficient enough for granting a trademark protection. Unfortunately, after that decision none of the applied olfactory marks were found sufficient for the EUIPO and at the official webpage of the Office only 7 applications are published (including ‘the smell of freshly-cut grass’) and none of them have trademark protection at the moment. At the same time, olfactory marks are not excluded from the list of marks which are eligible for registration. In fact, the ECJ refused all the requested registrations because samples which were submitted were not durable and stable and could not be “easily and objectively perceived by the public through the consultation of the OHIM public database”100. As long as these conditions are met, the registration of olfactory trademarks will be more possible. As it was mentioned above, there are alternative ways of presenting a smell mark in a graphic form. Devices such as ‘the Madeleine’ and ‘the electric nose’ may be used as well for the representing of a smell before the Office.

3.7 The practice of registering olfactory marks in European countries

In 1994, the French company Chanel attempted to register ‘Chanel No.5’ as a trademark by submitting to the United Kingdom Trade Mark Registry an application with the textual description of a sign: “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,

100 Escoffier, L., Jin, A. “To scent, or not to scent, that is the question: a comparative analysis of olfactory trademarks in the EU and US as good brand opportunities for SMEs”, WIPO SMEs Newsletter, April 2011.
rose, lily of the valley, orris and ylang-ylang; and a sensual feminine note from sandal, cedar, vanilla, amber, civet and musk. The scent also being known by the written brand name No. 5"\textsuperscript{101}. However, the United Kingdom Office rejected the application due to the nature of the product – the applicant tried to register the essence of the product.

The United Kingdom Trade Mark Registry allowed the registration of two olfactory marks: Sumitomo Rubber Co sought to register ‘the fragrance of roses’ which applied to tires (trademark №2001416) and Unicorn Products applied for the registration of ‘the smell of bitter beer’ for darts (trademark №2000234). Moreover, the United Kingdom Government in its written observations mentioned that “the practice in relation to this kind of trademark is currently changing”\textsuperscript{102}. Nevertheless, in June 2000 the Trade Mark Registry refused to register a mark which consisted of the ‘smell, aroma or essence of cinnamon’ for articles of furniture (trademark №2000169) due to the lack of definition. Judge A. James argued that the smell of cinnamon is not as distinctive and recognizable as smell of freshly-cut grass and that the interpretation of this smell may be different.

In France, for instance, fragrances can be protected by copyright. French copyright law protects original creations that are a result of an intellectual activity. Thus, a fragrance in an olfactory form that results from such activity can be protected under the French copyright law. Moreover, in 2006, the French Supreme Court held that “the fragrance of a perfume, which results from the simple implementation of a skill may not benefit from the protection of copyright”\textsuperscript{103}. At the same time, even though the French Bulletin Officiel de la Propriété Industrielle publishes the applications for olfactory marks, none of them have been registered so far.

\textsuperscript{101} Chanel’s Application, October 31, 1994.
\textsuperscript{102} Judgment of the Court, December 12, 2002 in Case 273/00 Ralf Sieckmann, para 33.
\textsuperscript{103} Supreme Court decision, №02-44718, June 13, 2006. Translation: Brad Spitz, France: no copyright protection for perfume, February 17, 2014.
Conclusions

Trademarks are used for communication and identification of goods and services for competitors and average consumers. This kind of information can be brought by different means including traditional and non-traditional trademarks.

As it is stated in the Trademark Directive and Trademark Regulation of the European Union a trademark 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”\textsuperscript{104}, meaning that traditional and non-traditional marks can be equally registered as trademarks. Even though some kinds of non-visual marks like olfactory marks are not included to this list, they are not directly excluded from the registration.

International and European regulations regarding all types of non-traditional trademarks can be considered as not developed enough. Only certain types of unconventional marks such as colour marks, shapes and in some cases sound marks are codified by various regulations.

A legislator usually does not include or exclude other types of non-traditional trademarks like olfactory and movement marks from regulations and requirements and leaves it to Member States’ domestic law legislators due to the difficulties connected to the way of representing this kind of signs before the Office.

The removal of graphic representation requirement may open new possibilities for trademark holders. Of course, the legislator introduced special grounds for refusal for authorities stating that the representation of a sign has to be clear and precise.

During the work on this thesis two categories of unconventional marks drew my attention – aural and olfactory marks and the problems that may acquire with the registration process of these kinds of marks.

Sounds are one of the most important ways of communication and transferring information about goods and services. As long as trademark holders attempted to register sound marks as trademark they faced the problem of the right way of representing a sign for the Office to accept it.

The forms of representation of sound marks which were accepted by the Office changed with the course of time. Starting with musical notation on a stave as the only acceptable form

and ending with spectrogram, textual description, sonogram and oscillogram as additional ways of officially representing sounds and noises.

Even though sound signs are not considered as ‘traditional’ marks, nowadays their registration is more likely than it was before. Moreover, the European Trademark Regulation and Directive added sounds to the list of marks which are eligible for registration and removed the requirement of graphical representation which was the most questionable and complicated provision for trademark holders.

Sound marks cannot be considered as ‘traditional’ marks as they are non-visual marks that need additional means for understanding these kind of signs by authorities and average consumers. Moreover, ‘traditional’ marks include marks that are already known and codified by Member States. In case with sound marks they are not only excluded from the list of signs eligible for registration in some domestic regulations of Member States (which should change till January 15, 2019) but also not codified by the majority of international regulations.

The latest amendments of the European Regulation might simplify the whole procedure of the registration of sound marks as trademarks. Even though the graphical representation requirement is cancelled, trademark holders who seek protection for their sound marks would probably continue submitting the applications with the representation of the mark in any possible form, for instance, in the form of musical notation, sonogram or just textual description. In this case, it will be easier for the authorities to decide if a mark is capable of being distinguished from other goods and services and if it is clear, precise, self-contained, easily accessible, intelligible, durable and objective in order to comply with the requirements of the Amending Regulation.

Another essential requirement for a sign is a criteria of having a distinctive character. Regarding sound marks this criteria applies in the same way as to other types of traditional and non-traditional marks. The sound mark should identify the goods or services and thereby distinguish them from other undertakings for authorities, competitors and average consumers.

Thus, many problems with the representation of sounds and especially noises that existed earlier have been solved nowadays. Since various forms of representing a sound became available and sufficient for the registration of sounds and noises today these cases are not ‘rare occasions’ anymore but a reality. Not surprisingly, at the official webpage of the European Intellectual Property Office 264 applications for European Union sound marks are published and only 26 of them were refused.
It is obvious that the question of registration of olfactory marks as trademarks can be considered as much more complicated comparing to the other non-traditional marks, namely sound marks. At the same time, there is no doubt that smell sign may be registered as a trademark if it is represented clearly and precisely. The smell mark may be attached to the product or its packaging but nevertheless it must be distinctive.

While considering the possibility of registering smells as olfactory marks it is important to first of all answer the question whether there is an essential necessity of having smell marks on the market. In my opinion, as one of the functions of trademarks is communication smell marks should be considered important. In order to pass information to one another all senses are involved and smell is one of the ways to perceive this information. Of course, the perception of signs by consumers might be different and that is why there is a need of unified global smell classification system. However, olfactory marks do not change the essential function of trademarks and only present more ways of representing goods and services.

However the problem is how and where to store smells. The precise smell that can be submitted to the Office might change after some time or disappear completely and it is very unlikely that all of the samples will be preserved somewhere in Alicante's Office. Moreover, there is another reasonable question: how to publish the registered smell mark for competitors to understand it. That is why prospects of wide use of olfactory signs are relatively vague.

The crucial question of graphical representation of smell was solved by the Amendment Regulation that removed the graphical representation requirement and basing on the Sieckmann case decision included the particular requirements for the presentation of a sign – it must be clear, precise, self-contained, easily accessible, intelligible, durable and objective. And as it was decided in the Sieckmann case it is not sufficient to submit an application of an olfactory mark with only a chemical formula of a sign, a description in written words, and a deposit of an odour sample or a combination of those elements.

Thus, the registration of smells is a complicated and questionable process which is not established by the Office or any Member State due to the representing and storing problems. In my opinion, if the Office considers the representation by textual description, a chemical formula and a sample as not sufficient for the registration then the removal of graphical representation requirement will not change the situation. Trademark holders that seek legal protection for olfactory marks need to come up with an idea of how to create a mechanism that will secure precise and durable representation of the smell. I believe it can be achieved with the help of
inventions in the area of new technologies like virtual reality domain or with the development of a unified odour classification system.

To conclude, there are pluses and minuses of the registration of non-traditional marks. On the positive side, it is a new form of marks that expand capabilities of trademark holders to promote their products in the market, to diversify forms of its protection and hence to increase their competitiveness. On the negative side, there are issues with creation of unified rules and practices let alone presenting and storing of some marks due to its specific nature. If in the case of sounds these issues are more or less resolved, then in the case of olfactory marks the situation is still unclear and regulation needs to be developed further.
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