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TITLE

**REGISTRABILITY OF SCENT MARKS: COMPARATIVE ANALYZES
OF INTERNATIONAL BEST PRACTICES AND ARMENIA
REGULATION**

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Оглавление

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INTRODUCTION

Trademark and its importance have been a constant issue since early ages. Due to globalization and the development of international commerce, the significance of trademarks started to increase, and therefore the need for legal protection and specific regulations concerning the trademarks arose. As it is known, the primary function of trademark is the indication of the source of the product. It gives a purchaser a particular quality not being discernible by the eye.

It is essential to understand the concept of a trademark. Generally, there are many definitions provided by international agreements and national jurisdictions concerning trademark, however one of the most precise definition is provided by World Intellectual Property Organization (WIPO) according to which: " A trademark is any sign that individualizes the goods of a given enterprise and distinguishes them from the goods of its competitors."¹ Usually, trademarks consist of logos, words or certain words and letter, which constitute a logo, and which can be visually perceived. However, trademarks are not limited only to visual marks but also include so-called non-conventional marks, for instance, sound, taste and scent. Nowadays those marks have become more important for companies in the current market and many companies do not limit their products only to visual effects, but also engaging other sense of human body, for example, adding smell to their products, which differentiates their product from many other products of competitors. As regards the scent, scent marketers state that, unlike the other senses, which convey messages to the brain through a series of intermediary synapses, the scent has a direct connection to a brain. Therefore, the fragranced products directly work on the consumer's emotions.² As a result, when a particular scent becomes identified with a product, producer try to find ways to secure legal protection over the scent, so that other products trying to imitate the scent, will be deprived of marketing the product with the same scent. By providing protection to scent marks, brands will be able to protect the distinctive aspects that make their company's unique services and products. Trademarking scents is a fascinating and unique branding tool, as the

¹ WIPO Introduction to trademark law and practice, chapter 1, page 10 (2nd edition 1993)
https://www.wipo.int/edocs/pubdocs/en/wipo_pub_653.pdf

² Aroma: The Cultural History of Smell: author Constance Classen, David Howes, Anthony Synnott, p. 192

medical world has widely noted that the sense of smell is closely linked with one's memory and can trigger emotion and nostalgia. This link makes trademarking scents a potential subliminal tool to channel that emotion and nostalgia directly into a company's branding.³

However, this area of intellectual property that is non-conventional trademarks, is new and thus there does not exist as much data as for other contemporary trademark-related issues, moreover among those non-conventional marks, particularly scent marks are in need of a better and clear legal definition.

Scent marks are considered one of the most problematic types of marks regarding registration since they are defined subjectively and mostly open to interpretation. Notably, the primary issue concerning the scent marks is that they are considered one of the most challenging marks to be represented graphically, which is a fundamental principle for all registration systems that the character of a trademark as well as its content and the scope should be defined as precise and clear as possible in the application.

The main purpose of this paper is to examine whether scent marks generally can be registered as a trademark in practice. Particularly, when does a scent reach the threshold of nonfunctionality and distinctiveness that enables it to be protected as a trademark? Furthermore, what kind of evidence should the applicant provide in order to get the scent marks registered as a trademark? In this regard, international best practices will be studied, including the world's major intellectual property jurisdictions.

³ Yes, You Can Trademark Smells, But It's Not Easy. Eric. C. Turnbull (2018)
<https://www.orlaw.com/intellectual-property/2018/04/13/yes-can-trademark-smells-not-easy/>

CHAPTER 1: DOMESTIC REGULATION

The Armenian Law on Trademark, which came into force in 2010, provides the regulation concerning trademarks. According to the law mentioned above the trademark is a sign used to distinguish goods and/or services of one person from goods and/or services of another person. Moreover, article 8 of the same Law provides certain types of marks which can be registered as a trademark. Particularly according to the article:

Trademarks are capable of registration only when are presented graphically, particularly:

- 1) words, phrases, names or slogans,
- 2) letters or numbers,
- 3) pictures, images or symbols
- 4) three-dimensional images, in particular, the appearance of the product or its packaging (container),
- 5) holograms, colors, combinations of colors or compositions;
- 6) Sounds
- 7) any combination of marks mentioned in the 1-6 points⁴

Based on the abovementioned article, the scent marks are excluded from the scope of the protected types of trademarks. Furthermore, the trademarks capable of registration are restricted to those marks, which can be presented graphically.

In order to present a much-detailed explanation why Armenian legislation does not provide protection to scent mark, an interview was conducted by the author with the former Deputy Head of Armenian Intellectual Property Agency (Agency) Andranik Khachikyan who was engaged in the drafting process of RA Trademark Law. In this regard, the explanation provided by Khachikyan is based on the followings:

According to Khachikyan's explanation,⁵ firstly, there is a global requirement that the trademarks must be visually perceived, as well as be capable of graphical representation. This is because an ordinary person receives more than 80% information visually and the remaining 20%

⁴ RA Trademark Law, Article 8 (2011) <https://www.aipa.am/hy/gen-info/>

⁵ Interview with Andranik Khachikyan, Former Deputy Head of Armenian Intellectual Property Agency (April 10, 2019)

receives by other human senses. As a response to the question whether a scent mark can be somehow be presented graphically, particularly by mean of providing chemical formula, it was mentioned that this method would be challenging, because finding and understanding the chemical formula of a scent can be quite difficult for the general public. Furthermore, the experts of the intellectual property agency are as well ordinary people who are specialized in the field of trademarks, but not in chemistry in order to understand the chemical formula of the scent. Additionally, usually the scents are made of sophisticated chemical compounds and even professionals in the sphere of chemistry may not be able to understand the formulas. In addition, the last argumentation concerning the chemical formula was that formula does not represent the scent of the substance, but the substance as such.

As regards the graphical representation through verbal description and deposit of a scent sample, it was stated that the description is not sufficient, since it is strictly specific and each person can perceive the description subjectively. Moreover, a verbal description is not considered as a clear and precise description of a scent and is not enough to satisfy the requirement of graphical representation. Eventually, considering the next mean presented by the author, which is the deposit of scent samples, it was mentioned that the scent sample does not constitute a graphic representation and is not sufficiently stable and durable. As a result, the registration of scent marks by the abovementioned means will not ensure the preconditions for their identification, which is required for granting legal protection. Additionally, Khachikyan pointed out that one of the essential processes in trademark registration is the ability to compare the new mark with already registered other trademarks, which will be impossible in case of scent marks.

As regards the question whether generally there is a need to provide a registration to scent marks in the future, the answer was that nowadays in Armenian reality, particularly from the perspective of business there is not a strict demand, moreover, the Agency has not received an application aimed to register a scent mark so far. However if considering certain situations when businesses will not be able to continue their regular workflow without having their scent marks registered, it may be taken into consideration to create specific regulation for the registration of scent marks.

Furthermore, considering the distinguishable element of the scent marks in the market, Khachikyan pointed out that the ordinary consumer does not buy a product for their smell, in contrast, they remember the name and the logo of the product which actually make a product

distinguishable. Finally, the summarizing answer to the question was that legislations are made to regulate issues, which arise in practice. Consequently, a strict need and the demand is not high enough to provide protection to scent marks nowadays. In addition to this, Khachikyan mentioned that if a person aims to register a scent, it can be reserved or may alternatively be protected through patent.

Considering all those mentioned above, all those reasons mentioned are not credible justification to bar the protection of scent marks. Since considering the fact that the primary function of a trademark is to distinguish and identify the source of a particular good or service, and if the scent mark satisfies the main requirement of a trademark there shall not be any ground to refuse the registration of a scent as a trademark.

Considering the research of international best practice, which is presented in Chapter 2, will be clear whether scent marks in practice are capable functioning as a trademark, and whether there is a specific mechanism through which the registration process is regulated.

CHAPTER 2: INTERNATIONAL BEST PRACTICE

Scent Marketing

The trademark is a communication sign in the marketplace. Nowadays, companies are constantly trying to find different ways to have the unique, fabulously redesigned goods and services, because of a vast number of competitors in nowadays marketplace. While the eye-catching marks are on the top among the trademarks, however, there are many marketing advantages to employing and registering scent marks, and the effort is worthwhile if it results in a unique source indicating as an identifier that may have a more profound influence on consumers than a typical visual trademark. This is because consumers react strongly to scent, and as a result, scent marks can create greater brand strength. Additionally, scientific research supports the belief that scents can be an essential tool used in marketing and branding. However, due to the lack of certainty in the legal sphere concerning the protection of scent marks and numerous issues that can occur, the producers are not enough motivated about this type of

branding. Moreover, they are confused about whether the investment made by them in the scent marketing would worth it all. Trademarks, which as scent marks act on the nose as identification signs, cannot be excluded on principle from protection under trademark law. People interact with each other not only through sights and sounds but also through smell. The 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 affect the human's behavior. Moreover, 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 scent marks

Among the benefits of scent marketing is increasing sales. Particularly, the scented products can create an emotional connection with the customer, which can lead to enhance the sales of the product. Moreover, scents tend to expand brand recognition.

However, as mentioned above, the registration of scent marks is quite problematic in practice nowadays. Scent marks cannot be graphically represented as easily as visual marks. Although, there are countries which take into consideration the advantages of scent marks in practice and provide protection under their jurisdiction. Among those countries are The US⁶, Australia⁷, Canada⁸, Hong-Kong⁹, Korea¹⁰, as well as Andean Community¹¹ (including Peru, Columbia, Ecuador and Bolivia), EU¹² countries etc.

International Agreements on Trademark

⁶ U.S. Trademark Law

<https://wipolex.wipo.int/en/text/375756>

⁷ Trade Marks Act (1995)

<https://wipolex.wipo.int/en/text/501305>

⁸ Trade-mark Act (R.S.C.,1985, c. T-13)

<https://wipolex.wipo.int/en/text/508815>

⁹ Trade Marks Ordinance

<https://wipolex.wipo.int/en/text/451035>

¹⁰ Trademark Act,

https://elaw.klri.re.kr/eng_service/lawView.do?hseq=38409&lang=ENG

¹¹ Decision 486, Common Provisions of Industrial Properties (2000)

<https://wipolex.wipo.int/en/text/223717>

¹² Regulation (EU) 2017/1001 of the European Parliament and of the Council, chapter 2, section 1, article 4 (2017)

<https://wipolex.wipo.int/en/text/484647>

International agreements on trademarks do not precisely refer to scent marks and some of them explicitly prohibit the registration of scent marks as a trademark. In this regard, according to the Trademark Law Treaty (TLT), article 2 (1) which states: “This Treaty shall apply to marks consisting of visible signs, provided that only those Contracting Parties which accept for registration three-dimensional marks shall be obliged to apply this Treaty to such marks.”¹³ The abovementioned article specifically excludes the scent mark registration. Unlike the TLT, the Singapore Treaty generally applies to all marks that can be registered under the law of a Contracting Party. Most significantly, it is the first international instrument dealing with trademark law to explicitly recognize non-traditional marks. Singapore Treaty is applicable to all types of marks, including non-traditional visible marks, such as holograms, three-dimensional marks, color, position and movement marks, as well as non-visible marks such as sound, olfactory or taste and feel marks¹⁴.

World Trade Organization Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS),¹⁵ sets much valuable provision for the trademark protection, and can be considered one of the international agreement, which provides more precise definitions for trademarks. However, the TRIPS agreement states that member states may require as a condition of registration, that sign be visually perceptible, which means that it is up to the national regulations whether they permit registration of signs which are not visually perceived, such as sounds, tastes and scent marks. Additionally, the Madrid Agreement¹⁶ concerning the International Registration of Marks provide a precise definition of marks within the context of the agreement. Therefore, it is possible to grant protection to scent marks under the agreement.

Paris Convention for the Protection of Industrial Property also does not provide a definition of a trademark, however, it does leave contracting parties free to incorporate relevant specification in their domestic laws, leave to the domestic jurisdiction of contracting parties to decide what a registrable trademark is.¹⁷

¹³ Trademark Law Treaty, article 2 (1), (1994)

<https://wipolex.wipo.int/en/text/294358>

¹⁴ Summary of the Singapore Treaty on the Law of Trademarks (2006)

https://www.wipo.int/treaties/en/ip/singapore/summary_singapore.html

¹⁵ Agreement on Trade-Related Aspects of Intellectual Property Rights, Article 15(1), online: World Trade Organization (WTO)

https://www.wipo.int/treaties/en/text.jsp?file_id=305907#part2.2

¹⁶ Madrid Agreement Concerning the International Registration of Marks

<https://wipolex.wipo.int/en/text/283529>

¹⁷ Paris Convention for the Protection of Industrial Properties (1883) <https://wipolex.wipo.int/en/text/287556>

Australia

As regards the Australian Trade Mark Act (hereinafter referred to as TMA) “a trademark is a sign used, or intended to be used, to distinguish goods or services dealt with or provided in the course of trade by a person from goods or services so dealt with or provided by any other person”.¹⁸ The “sign” in the abovementioned article is described as following: “sign includes the following or any combination of the following, namely, any letter, word, name, signature, numeral, device, brand, heading, label, ticket, aspect of packaging, shape, color, sound or scent”.¹⁹Therefore, based on the TMA scent marks are considered registrable. Particularly section 40 of the TMA specifies, “An application for the registration of a trademark must be rejected if the trademark cannot be represented graphically”.²⁰This means that the registration of any sign will not be capable of registration if it cannot be visually perceived. Consequently, one of the main issues is the strict requirement of the graphical representation.

In this regard, a more precise regulation concerning the scent mark registration is provided by the Australian Trade Mark Office Manual of Practice and Procedure.(hereinafter referred to as Manual) Particularly, it is mentioned that “the capability of a scent to distinguish an applicant's goods and/or services should be decided on the same general criteria as is any other kind of trademark” Therefore, it is important to find out what type of scents do not constitute a distinctive character. Additionally, the Manual states that the natural scent products do not have an inherent distinctiveness. For example, perfumes and Eau de colognes, essential oils for perfumery or cooking, the scent of cedar for timber products and herbal scents/essences for culinary use. This kind of scents are considered as a natural attribute of the good, therefore refers to the good but not to the trade source. Additionally, another type of scent products, which do not have an inherent character are the ones, which are artificially added to the product to mask the unpleasant odor of it. For example, can be regarded the cleaning products and detergents which naturally have an unpleasant odor. Eventually, the scents which are common in

¹⁸ Trade Marks Act 1995, part 3, section 17 (2018)

¹⁹ Trade Marks Act 1995, part 2, section 6 (2018)

²⁰ Trade Marks Act 1995, division , section 39, article 40 (2018)

<https://wipolex.wipo.int/en/text/501305>

a trade, for instance, the scents which are added to make a product more pleasant, among them can be considered a lemon scent added to dishwashing products. In the abovementioned cases, the scent does not have an inherent distinctiveness and does not indicate the origin of the product.²¹

According to the Manual, in order for the scent to be distinguishable under section 17 of the TMA, it should be a scent apart from the product itself. “It should be neither a natural characteristic nor an expected characteristic of the product, but something added to identify the applicant's goods from those of others in the same market”.²²

As regards the application for the scent mark registration and as it was mentioned in section 40 of the TMA, the scent mark should be presented graphically to be capable of registration. According to the Manual, the graphical representation can be a verbal description of a scent mark. The representation must be in a certain way that an ordinary person can be able to identify the trademark. As regards the sample of the scent, it is not considered mandatory to at filling, however, can be taken into consideration during the examination phase. Finally, the description must include information concerning the scent as well as the way the scent will be used in respect of the goods or services claimed in the application.²³

Based on the abovementioned, though it is problematic to register a scent mark in Australia, however, like any other trademark, for the scent to be registrable, it should be presented with a concise, written description of the scent and how it will be applied.²⁴

In this regard, a successfully registered scent mark in Australia so far is the Eucalyptus Radiata scent applied to golf tees.

USA

²¹ Trade Marks Office Manual of Practice and Procedure, part 21, nontraditional signs, 7.2.1

²² Ibidem

²³ Trade Marks Office Manual of Practice and Procedure, part 21, nontraditional signs, 7.1

http://manuals.ipaustralia.gov.au/trademarks/Part_21_Non-traditional_Signs/21.7_Scent_trade_marks.htm

²⁴ IP Australia, Other types of trademarks

<https://www.ipaustralia.gov.au/trade-marks/understanding-trade-marks/types-of-trade-marks/other-types-trade-marks>

The USA was the first to permit the registration of scent marks. The primary federal trademark statute of law in the United States is the US Trademark Act of 1946 (hereinafter referred to as Lanham Act). According to the Lanham Act the term “trademark” is any term, name, symbol, device, or any combination thereof used to identify goods or services, which is used by a person who has legitimate intention to use in commerce in order to identify and to distinguish his or her goods from goods sold by others, as well as to indicate the source, even if that source is unknown. Based on the definition provided by Lanham act, the trademark capable to registration is described broadly, and it does not explicitly exclude or include the protection of scent marks. Therefore, the registration of scent marks will be possible as long as it is used in trade to identify and distinguish goods or services and to indicate the source. ²⁵

The United States Trademark Association Committee, in its review of the Lanham Act, explicitly stated that a scent could fall under the federal definition. The Committee determined that the terms 'symbol, or device' should not be deleted or narrowed to preclude registration of such things as color, shape, smell, sound, or configuration which functions as a mark. ²⁶

The fundamental case concerning the scent marks is the case *Re Clarke*. ²⁷ In 1990 the United States Patent and Trademark Office and Appeal Board (TTAB) ordered the Patent Trademark Office (PTO) to issue the trademark registration for a fragrance. Particularly, the applicant Celia Clarke appealed the refusal of the Trademark Examining Attorney to register the applicant's asserted scent mark for "sewing thread and embroidery yarn." The examiner attorney refused the registration on the ground that the applicant's mark does not function as a trademark because it does not identify or distinguish the applicant's good from those of others. The applicant described the mark in words, particularly "*The mark is a high impact, fresh, floral fragrance reminiscent of Plumeria blossoms.*" ²⁸

The Examining Attorney observed that applicant's mark is analogous to other forms of product ornamentation in that it is not the type of matter, which consumers would tend to perceive as an indication of origin. The Examining Attorney also refused registration on the basis

²⁵ US Trademark Law § 45 (15 U.S.C. § 1127)

<https://wipo.lex.wipo.int/en/text/191404>

²⁶ United States Trademark Association Trademark Review Commission Report and Recommendations to USTA President and Board of Directors, (1987)

https://www.ipmall.info/sites/default/files/hosted_resources/lipa/trademarks/PreLanhamAct_092_TCR_E.pdf

²⁷ *In re Clarke*, 17 U.S.P.Q.2d 1238, 1239 (T.T.A.B. 1990).

<https://ipmall.law.unh.edu/content/ttab-trademark-trial-and-appeal-board-1-re-celia-clarke-dba-clarkes-osewez-serial-no-758429>

²⁸ *Ibidem*

that the applicant's alleged mark was de jure functional, assertedly because of the competitive need for free access to pleasant scents or fragrances.

Eventually, after the refusal, the applicant submitted a declaration mentioning several facts and grounds on which the scent mark should be registered. After the review, the examining attorney accepted that there was not an innate bar to the registration of the scent mark as a trademark.

Based on the following grounds the TTAB ordered the PTO to issue a scent trademark registration:

1. The applicant was the only person marketing scented yarns and threads
2. The fragrance was not an inherent attribute or natural characteristic of the good, but a feature supplied by the applicant
3. The applicant emphasized and promoted the scent mark in advertising
4. The applicant demonstrated that customers, dealers and distributors of her product had come to recognize the applicant as the source of these goods.²⁹

Hence, In order to prove the fact that the scent mark is distinctive, the applicant used the ‘secondary meaning’, which was demonstrated through the 4th ground mentioned above.

Additionally, the examining attorney mentioned that the applicant has not explicitly promoted the particular scent as an indication of origin. Applicant's advertising refers to "Clarke's Distinctive Soft-Scented Yarns," but no reference is made to a specific fragrance.

Therefore, based on the examination of the attorney the applicant showed that the scent acts as a source identifier without performing any other significant function, as a result, passed the nonfunctionality test. At the same time, she stated that the Plumeria blossoms scent was an arbitrary feature of the yarns and threads that it produced, and did not present a significant obstacle to competitors as they could adopt other scents for their yarns and threads.³⁰

It is worth mentioning that one of the essential elements, in this case, was that the applicant aiming to prove the fact that the scent mark is distinctive, used the so-called ‘secondary meaning’. The US legal system refers to situations when, despite the fact that a scent mark has a lack of distinctiveness, however, is able to demonstrate an exclusive and constant use of the scent within a specified period.

²⁹ Ibidem

³⁰ Ibidem

The Trademark Manual of Examining Procedure (TMEP) provides a specific mechanism through which the registration of scent marks is regulated. Particularly it states: The scent of a product may be registrable if it is used in a nonfunctional manner. Scents that serve a utilitarian purpose such as the scent of perfume or an air freshener are functional and not registrable. For example, an application to register scent for an air freshener or an application to register the sound of a ring tone for downloadable ring tones must be refused as functional, as the proposed marks are essential to the use or purpose of the goods.³¹

In this regard, it is essential for the applicant to show that the scent serves no important practical function other than help to identify and distinguish goods. Therefore, products that are scent related, particularly perfumes or air fresheners cannot be capable of registration.

Based on the abovementioned, the applicant trying to register a scent mark should provide an amount of evidence required to establish that a particular scent functions as a trademark is substantial.

As regards the application of the scent trademark registration, the TMEP specifies the requirements while filling an application. Notably, it states that the applicant is not required to submit drawing if the mark consists only of a non-visual mark. In these cases, the applicant must submit a detailed description of a scent mark.³²

Additionally, in order to show that the scent identifies and distinguishes the goods and indicates their source, the applicant must submit a specimen that contains a scent and that matches the required description of the scent or flavor. In most cases, the specimen consists of the actual goods themselves so that the examining attorney can be able to smell the scent, in order to determine whether the specimen shows the use of the mark in connection with the goods. When submitting such a specimen, the applicant should clearly indicate on the specimen itself that it is a specimen for a scent or flavor mark application so that the USPTO properly route the actual specimen to the examining attorney.³³

Currently, there are 13 scent trademarks, which have successfully been registered as a trademark in USPTO. Among them is the scent of Play-Doh for toy modelling compounds. The description of the scent is the following: “sweet, slightly musky, vanilla fragrance, with slight

³¹ Trademark Manual of Examining Procedure, Scent, Fragrance, or Flavor, § 1202.13
<https://tmep.uspto.gov/RDMS/TMEP/current#/current/TMEP-1200d1e2882.html>

³² Trademark Manual of Examining Procedure, “Drawing” of sound, scent, or non-visual mark, § 807.09
<https://tmep.uspto.gov/RDMS/TMEP/current#/current/TMEP-800d1e1656.html>

³³ Trademark Manual of Examining Procedure, Specimens for Scent and Flavor Marks § 904.3(m)
<https://tmep.uspto.gov/RDMS/TMEP/current#/current/TMEP-900d1e994.html>

overtones of cherry, combined with the smell of a salted, wheat-based dough”.³⁴ The applicant company mentioned that “the smell has always been synonymous with childhood and fun” and explains that the trademark allows it to protect “an invaluable point of connection between the brand and fans.”³⁵

Another registered scent trademark is the scent of bubble gum for “shoes, sandals, flip flops, and accessories, namely, flip flop bags” owned by Grendene S.A.³⁶. Those two registered scent trademarks are registered in Principal Register. It is worth mentioning that Lanham Act provides two separate registers for the registration of trademarks with the USPTO. Particularly, Principal Register and the secondary register, which is the Supplemental Register³⁷. The Principal Register is the site for the registration of marks that are distinctive by virtue of either their unique characteristics or their long and exclusive use as well as marks that have acquired secondary meaning. The Supplemental Register provides protection to mark, which are not distinctive but are capable of acquiring distinctiveness. If the mark acquires distinctiveness through the time, it is possible to obtain registration in Principal Register. In this regard, worth mentioning the Verizon scent mark³⁸ which is registered on the Supplemental Register because acquired distinctiveness was not shown by the applicant. During the prosecution of this mark, the Examiner held that “prospective consumers are unlikely to perceive a scent as a service mark for ‘retail store services featuring communication products and services, consumer electronics, and demonstration of products’ because stores commonly use scents to create ambience in stores.

EU

The regulation concerning trademarks went through several changes in the EU. Particularly, in 2009 with the Council Regulation (EC) No 207/2009 on the Community trade mark, Article 4 stated that: a trademark may consist of any signs capable of being represented

³⁴ Registration No. 5467089 <http://tmsearch.uspto.gov/bin/gate.exe?f=doc&state=4810:1ahggr.2.5>

³⁵ Times Free Press

<https://www.timesfreepress.com/news/business/aroundregion/story/2018/may/19/business-briefs/471175/>

³⁶ Registration No. 4754435 <http://tmsearch.uspto.gov/bin/gate.exe?f=doc&state=4810:1ahggr.2.12>

³⁷ INTA, The US Trademark Registers: Supplemental v Principal, Vol 6, No. 9 (2012)

<http://www.inta.org/intabulletin/pages/theustrademarkregisterssupplementalvsprincipal.aspx>

³⁸ Registration No. 4618936 <http://tmsearch.uspto.gov/bin/gate.exe?f=doc&state=4806:hlx2hn.2.6>

graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or their packaging, provided that such signs are capable of distinguishing the goods or services”³⁹. Before the abovementioned regulation, the verbal description of the scent mark was considered a proper graphic representation. As an example, of a successfully registered trademark in the EU was the “smell of fresh cut grass” for tennis balls in 1996. Particularly, during the examination process, the examiner stated that the verbal description such as “the smell of fresh cut grass” does not satisfy the requirement of graphical representation, not a graphical representation of the scent mark itself and the mark as applied for is in fact simply a description of the mark, moreover a mark that is not depicted in the application form in any shape or form.⁴⁰ However, on 11 February 1999 The Board of Appeals of Office for Harmonization in the Internal Market (OHIM) found that the verbal description of scent was enough to fulfill the requirement of graphical representation. Additionally, as regards the distinctive character of the scent, it was mentioned that the smell of freshly cut grass is a distinct smell, which everyone immediately recognizes from experience.⁴¹

The Board is satisfied that the description provided for the scent mark sought to be registered for tennis balls is appropriate and complies with the graphical representation requirement.”⁴²

The trademark has already expired due to non-renewal.

Another remarkable case was in 2001, where the appellant (Myles LTD) filed a notice of appeal against the decision on 11 November 1999. The appellant tried to register the scent of raspberries to engine fuels and as a graphical representation of scent used a verbal description.

As for the grounds of the appeal the appellant mentioned that the verbal description of the scent meets the requirement of graphical representation. Additionally, the appellant referred to the decision of the Second Board of Appeal of 11 February 1999, (the smell of fresh cut grass) mentioning that the abovementioned case was entirely comparable with the present case. Particularly, emphasizing that the scent of raspberries was a clearly distinguishable smell, which everyone could recognize from direct experience. The applicant pointed out that the scent is reminiscent of the pleasant taste of raspberries, raspberry sweets, picking raspberries in the

³⁹ Council Regulation on the Community trade mark (2009)

<https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=celex%3A32009R0207>

⁴⁰ Vennootschap Onder Firma Senta Aromatic Marketing’s Application, 1999, E.T.M.R. 429,

http://www.copat.de/download/R0156_1998-2.pdf

⁴¹ Ibid

⁴² Ibid

woods, which makes the scent also distinctive.⁴³

Based on the observation The Board held that the scent of “raspberry” can represent it clearly, precisely and objectively, however the marks lacked distinctiveness, since it was part of the product. Additionally, it was stated that signs could not be trademarks unless they can be perceived independently of the article of which they represent a property. The goods mentioned in the application (fuels), have a strong intrinsic smell, which is usually experienced as unpleasant, and the consumers would regard the scent not as an indicator of product origin, but as an attempt to mask the unpleasant smell of the fuel oil. The consumers in this case would not take in the scent of raspberries separately from the product. Additionally, the scent would be recognized only as an improvement in the image, similar to a decorative element, and not as a sign acting indication of origin and distinctive feature.⁴⁴ Therefore, the verbal description as a regards the graphical representation of the scent mark was satisfied, however, application was rejected on the ground that the mark lacked distinctiveness.

Among the case history, it is worth mentioning one of the famous cases in EU concerning the graphical representation of scent marks: the Sieckmann v. Deutsches Patent-und Markenamtcase, (The German Patent and Trade Mark Office) in 2002.⁴⁵

Particularly, the applicant intended to register a scent mark “balsamic-fruity odor with slight cinnamon notes”. In the application, the applicant described the mark as a pure chemical substance methyl cinnamate and added a sample of the odor and its chemical formula. Based on the observations the court found that:

1) The graphic representation a chemical formula, few people would recognize in such a formula the odor in question. Such a formula is not sufficiently intelligible.

2) In respect of the description of an odor, although it is graphic, it is not sufficiently clear, precise and objective.

3) As to the deposit of an odour sample, it does not constitute a graphic representation⁴⁶ for the purposes of Article 2 of the First Council Directive 89/104/EEC.⁴⁷

⁴³ Court decision 5.12.2001, Myles Ltd. Application, (R 711/1999-3), OHIM Board of Appeal.
<http://www.copat.de/markenformen/wrp2002/wrp10.pdf>

⁴⁴ Ibid

⁴⁵ Sieckmann v. Deutsches Patent-und Markenamt, C 273, 2002
<https://eur-lex.europa.eu/legal-content/EN/TXT/?uri=CELEX%3A62000CJ0273>

⁴⁶ Ibid

⁴⁷ First Council Directive 89/104/EEC, article 2, 21 December 1988
<https://eur-lex.europa.eu/legal-content/en/TXT/?uri=CELEX%3A31989L0104>

This decision made the requirement of graphic representation obligatory making the registration of scents virtually impossible.

However, the criteria concerning the requirement of graphical representation established by the Sieckmann case was removed due to the EU new regulation which entered into force in 1 October 2017. According to the abovementioned regulation “A trade mark 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:

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

(b) being represented on the Register of European Union trade marks (‘the Register’), in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor.”⁴⁸

Based on the abovementioned article, the specific regulation of the graphical representation was eliminated, however, the requirement of the clear and precise representation of the scent mark must be presented in order for the scent to be capable of registration.

As a result, the exclusion of the requirement of the graphical representation, will facilitate the registration of scent marks in the EU will provide a new incentives for the potential applicants in registering their scent marks.

However, despite the fact that the requirement of graphic representation was eliminated from the concept of the EU trademark, scent marks can be capable of registration only when the requirement of distinctiveness and the capacity of distinguishing the products and/or service in respect of which it is supposed to be used. In this regard, it is worth mentioning that when a scent mark is only used in connection with products which have a smell, for example, cleaning materials or insecticides which are added to the product in order to mask the natural unpleasant smell, or when the scent itself is the product, for example, perfumes or fresheners, such scent marks will not be regarded product having a functional character and deprived of distinctiveness. As a result, those scent marks will not fulfil the requirements of a trademark.

As regards the functionality of scent marks, worth mentioning the Chanel case. Particularly, in 1994, French company Chanel tried to register ‘Chanel No.5’ as a trademark by submitting to the United Kingdom Trade Mark Registry an application. In order to satisfy the the

⁴⁸ Regulation (EU) 2017/1001 of the European Parliament and of the Council, chapter 2, section 1, article 4 (2017) <https://wipolex.wipo.int/en/text/484647>

requirement of the graphical representation, the scent was described as: “The scent of aldehydic-floral fragrance product, with an aldehydic top note from aldehydes, bergamot, lemon and neroli; an elegant floral middle note, from jasmine, rose, lily of the valley, orris and ylang-ylang; and a sensual feminine note from sandal, cedar, vanilla, amber, civet and musk.”⁴⁹ However, based on the examination, the application was rejected on the ground that smell of the perfume was the product itself and not the indication of its origin, thus, could not present a scent mark.

Hong-Kong

Hong-Kong Trademark Ordinance (chapter 559) precisely provide a protection to scent marks. Particularly, 3rd chapter of the abovementioned Ordinance states: “trade mark” means any sign which is capable of distinguishing the goods or services of one undertaking from those of other undertakings and which is capable of being represented graphically.” Additionally, subsection 2 of the same chapter, points out: Without affecting the generality of subsection (1), a trade mark may consist of words (including personal names), indications, designs, letters, characters, numerals, figurative elements, colors, sounds, smells, the shape of goods or their packaging and any combination of such signs.” As regards the requirement for the proper registration of scent marks, the scent mark must be distinctive like any other trademark, as well as, the applicant must mention they apply specifically for a scent mark registration, and provide a description of the scent.

CHAPTER 3: ANALYZES

Taking into consideration the international best practice concerning the scent marks, it becomes clear that several world’s major jurisdictions grant protection to scents as a trademark. In addition, apart from qualifying scent as a mark eligible for trademark protection, there is a specific mechanism through which the scent marks are registered, and the general requirement concerning the graphical representation is satisfied.

⁴⁹ Chanel’s No. 5 Application, 31.11.1994.

In order to find out whether scents can function as a trademark, there are several criteria that a scent should satisfy to be regarded as a trademark. One of those criteria is functioning as a distinguisher. Particularly, the practice showed that scents affixed to products that are not scented could be considered distinctive. The distinctive feature of products enables consumers to find the product in the market even if they do not remember their name. As a traditional trademark, scent marks also can be inherently distinctive or can acquire distinctiveness through time.

Inherent distinctiveness of scent marks is possible when the scent is affixed to an unscented product or when the scent is unique enough to attract consumer's recognition. For instance, one of the cases presented in Chapter 2 "the smell of fresh cut grass" for tennis balls was found as a distinctive, since the smell is a distinct smell, which everyone immediately recognizes from experience. As for the acquired distinctiveness, it is known that marks that are not inherently distinctive may be granted protection if they acquire distinctiveness through use and time. In this regard, worth mentioning the famous case *In re Clarke*, presented in Chapter 2. Based on the fact that Clarke was the only producer in the market of scented yarns and threads and, as such, his scent mark had acquired distinctiveness over time and through use.⁵⁰ The scent of "plumeria blossoms" was found as an origin indicator because consumers who had taken prior access to the scent could use it for source recognition and identify the product origin. In this light, the mental association of the scent with the product afforded the scent a so-called secondary meaning. Applying the criteria of the Clarke test would mean that acquired distinctiveness may be affirmed where the individuality of the market presence of scented products is so strong that the consumer recognizes the smell as an indication of origin of a certain undertaking.⁵¹

However, if the scent itself is distinctive, it may not be granted protection on the ground of the function it serves in relation to a product. In relation to perfumes, where the scent per se determines the purchase, the smell attributes such substantial value to the goods. By being the product themselves, perfumes are functional in the utilitarian sense and shall, therefore, be refused registration.⁵² This happened with the Chanel perfume case, where the application was rejected on the ground of functionality.

⁵⁰ See footnote 27

⁵¹ Karapapa, *Registering Scents as Community Trademarks* (2010)

⁵² *Ibid*

Even if the scent mark is able to function as a trademark, it also has to meet the requirement of graphical representation in order to be capable of registration. The graphical representation is considered a general requirement. Based on international practice, many jurisdictions provide a specific mechanism through which the requirement of graphical representation is met. Particularly, the way to meet the abovementioned requirement the applicant should provide 1) a clear, precise and objective description of a mark, which is considered the main requirement concerning the graphical representation of the most jurisdiction regarding the scent mark registration. Additionally, even though that the chemical formula of the scent and the deposit of the sample are not considered mandatory for several for jurisdictions in the registration process, however, the combination of the three will definitely provide better grounds for the registration.

CONCLUSION

Given what has been outlined in the present Paper it should be highlighted that scent mark can actually function as a trademark in practice if it meets all the requirements of a trademark. Furthermore, besides granting protection to scent marks, many jurisdictions also provide a specific mechanism through which scent marks will be capable of registration.

Additionally, considering all the benefits that the scent marks have in the marketing industry, the producers while venturing this type of branding strategy in their businesses, must make sure that their rights will be protected. At least by granting protection to the scent trademarks will deprive the competitors to add a similar scent to their product.

Some of the main advantages of registering a trademark include:

1. it grants the right to use the registered trademark symbol: ®;
2. grants access to courts through the filing of a trademark infringement lawsuit;
3. allows plaintiffs to obtain monetary remedies, including infringer's profits, damages, costs, and, in some cases, treble damages and attorneys' fees that result from infringement claims;
4. acts as a bar to the registration of confusingly similar marks;
5. can serve as the basis for the international use of the mark.⁵³

Moreover, from the perspective of investments, a particular investor who manufactures a scented product with a registered scent trademark will not be motivated to invest in a country, where scent marks are not legally protected since his or her rights concerning the trademark will not be secured. Therefore, considering the fact that scented products are increasing in the market nowadays, there is a need to make an amendment in RA jurisdiction in order to create favorable investment climate for investors.

⁵³ Making sense of the nonsensical: A look at Scent Trademarks and their complexities
<https://www.ipwatchdog.com/2017/12/21/scent-trademarks-complexities/id=91071/>

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