Taste, Smell And Sound—Future Trademarks

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This article is based upon a paper presented at the LESI World Conference in Oslo, Norway, on 15-18 June 2003.

- How well do they really function as trademarks?
- The look of non-traditional marks seen from a Scandinavian and European point of view.
- Pro's and con's of choosing such a mark as your trademark.

Introduction

Welcome to the fascinating world of non-traditional trademarks!

The topic for this paper is non-traditional trademarks. I will deal with the non-traditional trademarks in general, (not necessarily limited to taste, smell, and sound marks) and give examples of such marks from the Scandinavian and the European practice.

Different kinds of trademarks have different appearances.

Non-traditional trademarks may have a very different appearance than the traditional trademarks, such as word marks, logos, slogans, figurative marks or even three-dimensional marks. However, they do have some things in common: they all have to meet the requirements in the trademark legislation to receive protection and to be registered. That means they all have to be considered a "trademark." The common definition of a trademark is "a sign which is capable of distinguishing the goods or services of one establishment from those of others, and which is capable of being represented graphically." This means the trademark has to be distinctive and to be able to be graphically represented to be registered. As we will find out in a few minutes, that can now be very tricky for some of the non-traditional trademarks.

Smell marks (also called scent marks)

The smell is the trademark. Only the imagination sets limits to what kind of smell one would like to associate with one's goods/services.

We haven't received any applications for such marks in Norway yet.

The smell of perfume for perfume (goods in class 3) was refused registration in Sweden and Denmark, because the smell would not be recognized as a trademark—it was not considered distinctive for the applied-for goods.

The UK has a few smell marks registered; "the smell of bitter ale for flights for darts," and "the smell of roses for tires." "The smell of cinnamon for furniture polish" was refused, because the smell was not considered clear and precise enough; the public would not have a clear impression of the smell from the word cinnamon.

There can be a grey area between smell as a trademark and smell as a quality (purely functional). For example the smell of lemon for garbage plastic bags; the smell itself can be distinctive, but it can also be functional because it will disguise the smell of waste and garbage.

EU: The smell of fresh cut grass is registered for tennis balls (CTM 428870, R 156/1998-2). To begin with, the examiner refused the mark with the description "The smell of fresh cut grass" as a smell mark for tennis balls, because the words are not a graphical representation of the mark itself.

OHIM's Board of Appeal allowed registration, reasoning the following: "The smell of freshly cut grass is a distinct smell which everyone immediately recognizes from experience. The description complies with the requirement for graphical representation in Article 4 CTMR."

The smell of raspberry was refused for goods in class 4 (fuel, oils), because it lacked distinctive character. Even though the smell itself was considered clear and precise, it was, however, applied/registered for goods which could have raspberries as an ingredient (perfumed candles, fuel, and oils), therefore not being distinctive.

There are two pending cases before the EU; "the smell of vanilla" for goods in the classes 3, 5, 14, 16, 21, 25, 26 and 30, and "the smell of ripe strawberries" for goods in the classes 3, 16, 18 and 25.

The *Sieckmann* case (C-273/00)

The *Sieckmann* case has already become a famous case, which concerns the smell mark described as "balsamically fruity with a slight hint of cinnamon."

The European Court of Justice (ECJ) gave its ruling on December 12, 2002, and it is a clear break from OHIMs view on the registrability of smell marks.

Facts of the case

Mr. Sieckmann filed a trademark with the German Patent Office for services in the classes 35, 41 and 42; services ranging from advertising, education and training to veterinary and agricultural services, scientific research and computer program-

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ming. He stated in the application that it was an olfactory mark (smell mark) of the pure chemical substance methyl cinnamate (= cinnamic acid methyl ester). The chemical formula is C6H5-CH = CHCOOCH3.

The applicant also submitted a sample of the smell and described it as "balsamically fruity with a slight hint of cinnamon."

The German Patent Office refused the application on the ground that it was doubtful whether the trademark was capable of being registered and of being represented graphically. Mr. Sieckmann appealed to the Bundespatentgericht, which sent two questions to the ECJ.

1) Is Article 2 of the Directive to be interpreted as meaning that the expression signs capable of being represented graphically covers only those signs which can be reproduced directly in their visible form or is it also to be construed as meaning signs such as smell or sounds —which cannot be perceived per se but can be reproduced indirectly using certain aids?

2) If the first question is answered in terms of a broad interpretation, are the requirements of graphic representability set out in Article 2 satisfied where a smell 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?

ECJ ruled as follows

Regarding the first question, Article 2 must be interpreted as meaning that a trademark may consist of a sign which is not in itself capable of being perceived visually, provided that it can be represented graphically, particularly by means of images, lines or characters, and that the representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective.

The ECJ stated that few people would recognize in such a formula the smell in question. Such a formula is not sufficiently intelligible. A chemical formula does not represent the smell of a substance, but the substance as such, nor is it sufficiently clear and precise. It is, therefore, not a representation for the purposes of Article 2 of the Directive.

Even though the description of the smell is graphic, it is not sufficiently clear, precise and objective. The deposit of the smell sample does not constitute a graphic representation for the purpose of Article 2 of the Directive. A sample will not be sufficiently stable or durable.

According to the ECJ, the answer to the second question must be that in respect of an olfactory sign, the requirements of graphic representability are not satisfied by a chemical formula, by a description in written words, by the deposit of a smell sample or by a combination of those elements.

The conclusion we can draw from this ruling is that from now on it will be very difficult, if not impossible, to register smells as trademarks. This case will be seen as closing the door for smell marks and will have an impact on the future practice in the EU. However there are still some unanswered questions: What will happen now? What will happen to a mark already registered?

Taste marks

Here it is the taste that will indicate the commercial origin of the goods. And here we can safely say that taste marks can only be applied to goods and not services.

What do you think—could a taste mark really function as a trademark?

Why isn't the taste mark the "new" "hot" trademark?

Let's look at some theoretical examples.

What if you changed the taste of Ketchup to mustard? No, that would probably not work. There is probably ground for refusal because it would deceive the public. And why would you want two things on your hotdog that taste the same?!

What about a certain taste for candy? That is not good either. It would most likely not be considered a trademark; candies are supposed to have different tastes/flavours, since they have no characteristic taste of their own.

What about strawberries that taste like liquorice? That is not good; it would probably not sell that well either.

We can probably conclude that for edible goods a taste mark would as the main rule not function well as a trademark.

What about the non-edible goods?

It would probably not be considered hygienic if it is necessary to taste goods when considering if you want to buy them or not…

What about tennis balls with mint flavour for dogs? It is already on the market. This will probably be considered functional; the purpose is, besides being a ball, to give dogs fresh breath.

What about pacifiers for babies with flavour? It will probably be considered functional as well; the purpose is to calm the babies.

What about stamps and envelopes where the glue has a certain flavour? Would this work or would it be considered functional—replacing bad-tasting glue flavour? Envelopes with the taste of strawberries or chocolate? This might work.

There are no applications for taste marks in Norway or in any of the other Scandinavian countries.

There are a few taste marks registered in the Benelux countries. These marks have a description of the taste with the explanation that it concerns a taste mark. (DE SMAAK VAN DROP BX No. 625971). "The trademark consists of the taste liquorice applied to the goods in class 16 (taste mark)."

Taste marks have many things in common with smell marks. After the *Sieckmann* case there will probably no longer be any possibility to register taste marks. A taste mark would most likely be considered not to meet the requirements of graphical representation.

Sound marks

The sound is the trademark and

indicates the commercial origin of goods or services.

There are many sound marks registered in different countries in the world.

We have received 5 applications for sound marks in Norway. Some are registered and some are still being examined.

Illustration 1 shows an example of a registered sound mark, this one owned by Deutsche Telekom AG. The description of the sound is as follows: "The mark is a sequence of notes of 5 tones, with a special intonation on the sound before the last. The jingle is composed in C Major, the tempo is about 113 beats per minute and was composed in 4/4 time. The logo is played by Stakkato (Volume mezzo forte) on a synthesizer." (Madrid Protocol registration No. 729484).

OHIM has, since its beginning in April 1, 1996, also registered sound marks. Sound marks are specifically mentioned in the Examination Guidelines and in a special section in the application form.

EU has registered the signature tone of Nokia Corporation for goods/services in the classes 9 and 35 (CTM 1040955). See Illustration 2.

MGM Corporation (the movie producer) has applied for registration of a sound (known in the US as the roaring of a lion) and has submitted a sonogram. The application has been refused and the applicant has lodged an appeal. The appeal is still pending. The applicant has registered the sound in the US with the description "The mark comprises a lion roaring" (U.S. No. 73553567)(CTM 143891). See Illustration 3.

Shield Mark vs. Joost Kist

There is a pending case before the ECJ, that presumedly will set the procedure for how to treat sound marks in Europe. The sound mark concerns *Für Elise*, a famous piece of music.

The Advocate General Colomer has given his opinion in this case. He believes that Article 2 of the Directive prohibits member states from refusing to register sound marks that are distinctive and represented graphically using musical notation. He concludes that to be registered, sounds must be represented graphically in a way that is clear, precise, self-contained, equally accessible, intelligible, durable and objective. In general, applications in the form of musical notation meet these requirements, whereas onomatopoeic descriptions (like the rooster's crow) do not. It remains to be seen whether the ECJ will follow Colomer's opinion or whether it will adopt a more restrictive approach.

What can be expected after the Sieckmann case? The ECJ has given an explanation of the requirements a graphic representation has to meet. According to the ECJ, the graphic representation must be:

- self-contained
- clear
- precise

Illustration 1.

Illustration 2.

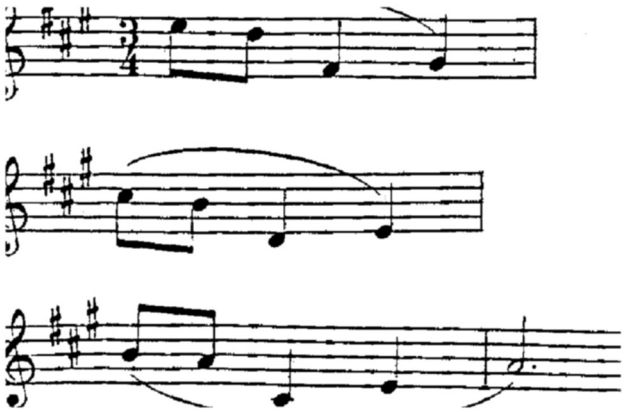


Illustration 3.

- easily acceptable
- intelligible
- durable
- unequivocal
- objective
- graphically particular by means of images, lines or characters.

It might be easier for musical marks (marks with notes) to be registered in the future, than marks which only have a description in words. Even though (from a personal opinion) it is sometimes easier to get the clear understanding of a sound from the description in words than by just reading the notes!

Moving image mark

The moving image is the trademark. This can be a film-clip, video, moving logo for TV-shows, etc.

There are no applications in Norway yet, neither in Sweden as far as I know. Finland has one application which is still under examination. Denmark has registered one moving image mark. See Illustration 4.

http/:/www.vendlet.dk/

This type of mark can create a challenge for the trademark offices on how the mark, if approved or registered, should be published; with still pictures, with the moving image electronically, a description of the mark in words or a combination of these elements?

The UK has registered a moving mark for Kraft Foods UK Ltd. (UK No. 2280003). The mark has a description which says: "The mark consists of the three-dimensional shape breaking apart, as shown in the sequence of still pictures attached to the form of application." The mark is for goods in class 30 (chocolate). The description is not very detailed. See Illustration 5.

The EU has also registered moving marks. The doors of the Lamborghini (CTM 1400092), with a description: "The trademark refers to a typical and characteristic arrangement of the doors of a vehicle, for opening the doors are "turned upwardly," namely around a swivelling axis which is essentially arranged horizontal and transverse to the driving direction." The registration is for goods in the classes 12 and 28 (cars and toy cars). See Illustration 6.

Illustration 4.

Illustration 5.

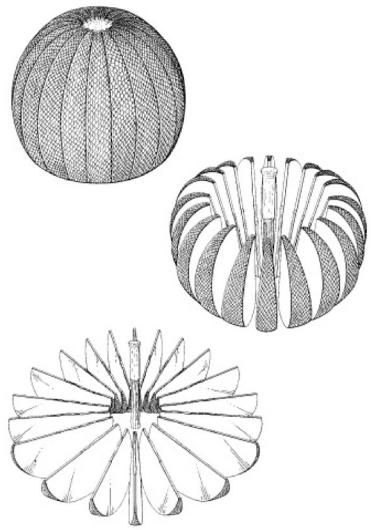
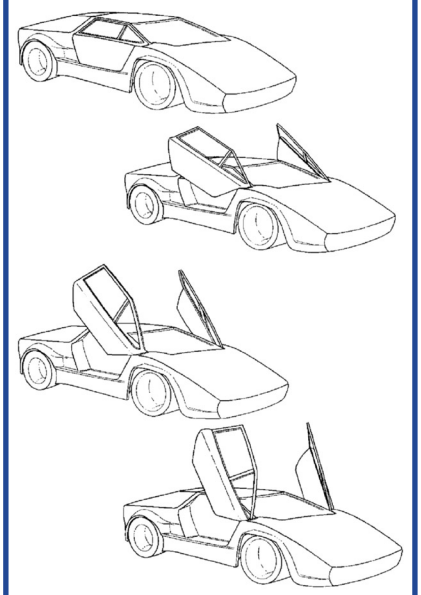


Illustration 6.



After the *Sieckmann* case

Most moving image marks can be represented graphically. The problem here would be the level or degree of distinctiveness. Can a certain movement be a sign that is distinctive? It would have to be examined case by case to see whether a specific moving mark is distinctive. Maybe after show of evidence of use, or maybe being protected by, for example, marketing law or competition law?

Holograms

There are some registrations in Scandinavia regarding holograms.

The EU has also registered holograms. Just a few, but it is specifically mentioned in the application form.

One example is CTM 2117034, which has the explanation: The letter VF in white on blue spheres, the name VIDEO FUTUR in blue on a black background."

The main point with holograms is that depending on the angle you look at it, the image will change. This feature can be difficult to capture when publishing. It depends on the electronic medium in which the mark is published in. On paper, the published mark will only be a substitute of the mark itself, merely a figurative mark, because the paper print will not be able to show the changes of the images, which can be possible when published electronically.

Norway has registered holograms. When we had the Trademark Gazette in paper, it would be shown as a figurative mark. Now when we publish trademarks electronically, it would be possible to show the actual hologram, depending upon the format in which the mark has been submitted to the office.

Gesture marks

This has been mentioned as another kind of non-traditional mark.

Mars BV has a registration in the Benelux Trademark Register for a gesture of two cutting fingers. This

gesture is recognized as the commercial origin for TWIX chocolate. BX No. 520574.

A gesture mark is also registered in the UK Register, which shows a person tapping his/her nose, registered for services in the field of mortgage and investments (UK No. 2012603).

There are no such marks registered in Norway, and not in the other Scandinavian countries as far as I know.

If the gesture is distinctive, there shouldn't be any problems of registering such a mark. The graphic representation can be clear and recognizable.

Colour marks

The colour is the trademark. Many countries have a restrictive practice due to the fact that there is only a limited number of colours in the world. Giving someone an exclusive right to a colour might cause problems for competitors in their way of marketing their goods/services.

One single colour or combinations of colours? Norway has registered the single colour pink with a specific pantone number for insulation and building materials after showing evidence of use in the market.

The UK and the EU have several registrations for colours; the Cadbury's purple for chocolate, BP's green for vehicle service stations and Orange's registration for the colour orange for telecommunication services.

In an appeal from OHIM and the Board of Appeal, the Court of First Instance held that the colour orange (specified as standard HK57) to be registrable for KWS Saat AG for technical and business consultancy in the area of plant cultivation, especially in the seed sector, but not for the seeds themselves. Colour does not attach to a service, because services by nature have no colour.

This case is still pending before the ECJ.

Libertel Groep BV applied the colour orange to be registered for telecommunications materials and services and their material, financial and technical management at the Benelux Office. The application

Illustration 7.

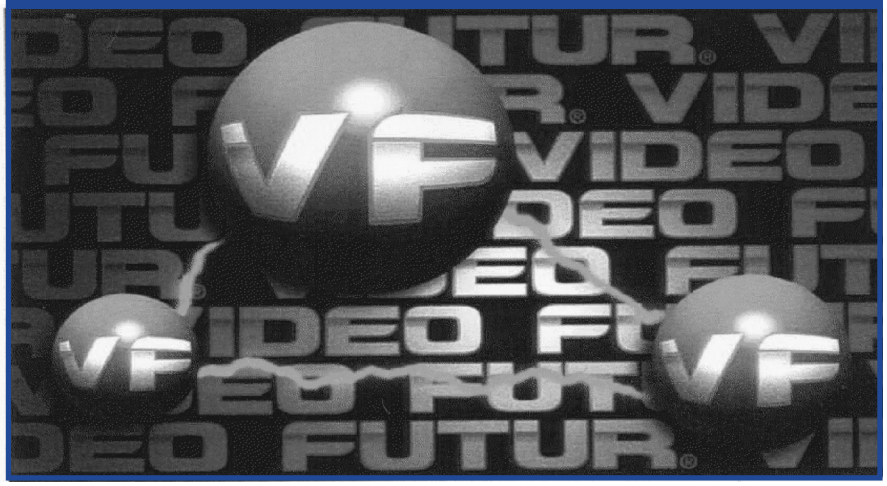


Illustration 8.

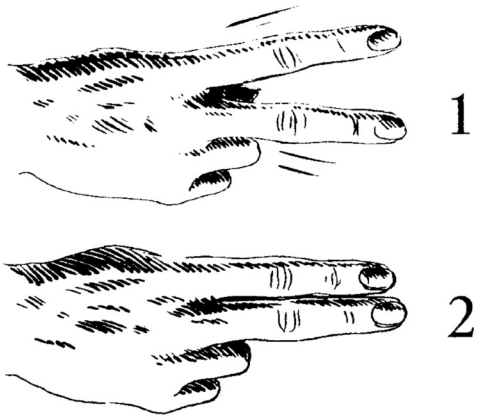


Illustration 9.

The mark is a gesture made by a person tapping one side of his/her nose with an extended finger, normally the index finger of the hand on the side of the nose being tapped. An example is shown to the side.

was refused on the basis that Libertel failed to show that the colour was distinctive for the goods and services in question. On appeal the Court referred to the ECJ the question whether a single specific colour can become sufficiently distinctive to qualify for trademark registration. The Advocate General's Opinion stated that a colour on its own, without any shape or form, is not registrable, as it does not allow the public to distinguish the goods or services applied for from those of other traders. The graphical representation of a single colour must be clear and precise as to the object of the mark and intelligible to competitors and consumers.

The ECJ held in its ruling that a colour per se may have a distinctive character provided it is represented graphically in a way that is clear, precise, self-contained, durable and objective. The latter condition cannot be satisfied merely by reproducing on paper the colour in question, but may be satisfied by designating that colour using an internationally recognized identification code. The ECJ referred to its recent Sieckmann ruling, and took the view that a colour sample did not constitute a graphical representation, but a verbal description of a colour did. The description of a colour using an internationally recognized identification code may be considered to constitute a graphic representation. Such codes are deemed to be precise and stable.

Viking-Umwelttechnik GmbH applied for the combination of the colours green and grey; a green rectangle (Pantone colour reference 396c) above a grey rectangle (Pantone 428u). The application was refused by the OHIM and by the First Board of Appeal on the basis that the green and grey combination was not distinctive for gardening equipment. This decision was upheld by the Court of First Instance.

Feel marks (tactile marks)

A single touch of a certain object might lead to recognition, for instance because the surface touched has a specific recognizable structure or shape.

The glass bottle of Coca-Cola was designed in 1915 to also be recognized in the dark.

I don't know of any specific examples here. One can imagine a feel mark with the feeling of touching velvet, latex, etc. However, after the Sieckmann-case, this kind of mark will be problematic, if not impossible, to register. It would most likely be considered not to meet the requirement of graphically representation.

Licensing of non-traditional trademarks

Non-traditional trademarks can be objects for licensing to the same degree as traditional trademarks.

The following is a list of pro's and con's of choosing such a mark as your trademark.

Pro (for the holder):

- You may have a registration if it meets the requirements to be registered (graphical representation, distinctive, not a smell or taste mark).
- If it is registered, you will have protection against confusingly similar marks which are filed or used after your filing date.
- You may receive some publicity and attention in the market, because these non-traditional marks still (to some degree) have novelty.

Con (for third parties):

- These marks can cause some problems. It can be difficult to establish under searches etc. what kind of protection a mark with better priority has.
- How to perform searches?
- For the holder as well (and the office), it may be difficult to establish exactly the degree of protection the mark has.
- After the *Sieckmann* case; what happens now to marks already registered? Will they be declared invalid?