

The scent of a trademark: removal of graphic representability requirement

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The EU Directive 2015/2436 (“The Directive”), which aims to approximate the laws of the member states relating to trademarks, discards the graphic representation requirement for trademark applications. We will look into the potential impact on trademark registration and have a glimpse at the challenges that might arise from it.

According to the new definition of signs which are capable of constituting a trademark, provided by the EU Directive 2015/2436, the capability of the graphic representation of the sign intended for registration is no longer a requirement.

The following table highlights the revision of the sign’s definition, brought on by the Directive 2015/2436 which is replacing Directive 2008/95/EC:

Directive 2015/2436

Article 3.

Signs of which a trade mark may consist

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; 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.

Directive 2008/95

Article 2.

Signs of which a trade mark may consist

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

Besides the removal of the graphic representability requirement, colors and sounds are mentioned explicitly as sign examples. The main modification, the removal of graphical representability requirement, is detailed in the Preamble of the Directive, according to which 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.*" To fulfill trademark registration conditions, the sign shall also be capable of: "*...being represented in a manner which is clear, precise, self-contained, easily accessible, intelligible, durable and objective.*"

The seven representation requirements (*clear, precise, self-contained, easily accessible, intelligible, durable and objective*) were stated by the European Court of Justice in the case [Ralf Sieckmann v Deutsches Patent- und Markenamt](#) (ECJ, Judgement of 12-Dec-2002, C-273/00). This case was related to the applicant's intention to register an olfactory trademark - a "methyl cinnamate" scent, based on its chemical formula, a written description and a sample. The Court stated that to be registrable, a sign shall meet the seven representation requirements referred above. At the time, the Court noted that it was mandatory for the sign to be suitable for graphical representation.

By the removal of graphic representability requirement for [trademark applications](#), the European legislature widened not only the requirements for a trademark application but also the underlying concept of trademarks as an IP right in Europe. Moreover, this change may be considered a small, yet important, step toward the worldwide harmonization of trademark regulations.

In the United States, the US Trademark Act clearly states that: "*...the applicant is not required to submit a drawing in case the mark consists only of a sound, scent or other completely non-visual matter.*" Likewise, the Australian IP regulations accept the registration of scents and sounds as trademarks.

New representation methods for non-conventional signs

Considering the representation of [non-conventional signs](#), useful guidance is provided by the European Commission Implementing Regulation 2018/626 related to European trademarks:

- **Sound marks:** Trademarks consisting of sounds shall be represented by an audio file or by an accurate musical notation;
- **Motion marks:** Trademarks consisting of a movement or a change shall be represented by a video file or by a series of sequential still images;
- **Multimedia marks:** Trademarks consisting of both image and sound shall be represented by an audiovisual file;
- **Hologram marks:** Trademarks comprised of elements with holographic characteristics shall be represented by a video file, graphics or photographic reproduction.

Unfortunately, the European regulations seem to remain silent concerning olfactory trademarks. Nevertheless, past cases may present valuable suggestions for future applications, considering the new legal environment proposed by the Directive 2015/2436. Some notable prior cases are shown in the following section.

Olfactory trademarks: European jurisprudence

Currently, the [TMview online database](#) notes that there is only one olfactory trademark still active in Europe: the UK trademark with Application number UK00002000234, owned by Unicorn Products Limited for "*the strong smell of bitter beer applied to flights for darts.*"

What is the reasoning behind this singular active olfactory trademark in Europe? The difficulty that lies in registering a scent as a trademark. The following examples might shed some light on such a challenge.

1. ECJ, Judgement of 12-Dec-2002, C-273/00

In the final decision on Ralf Sieckmann v Deutsches Patent- und Markenamt case, the court noted that the chemical formula of the scent is not sufficiently intelligible, clear or precise. And neither was the written description, although it fulfilled the requirement of graphic representability. Regarding the scent sample itself, the court stated that it is not adequately stable or durable. Finally, the decision was based on the fact that the submitted chemical formula, written description and the scent sample did not satisfy the graphic representability requirement.

2. ECJ, Judgement of 27-Oct-2005, T-305/04/00

In another case, [Eden SARL v OHIM](#), the European Court dismissed the applicant's action for registration of a scent trademark based on the written description: "smell of ripe strawberries" and an image of a strawberry. Regarding the written description, the court noted that the described smell could refer to several varieties and it is neither objective, clear nor precise. Related to the graphic representation – the strawberry image – it was considered by the court to be even less accurate than the written description, as that the image represented the fruit which emits the scent and not the scent itself.

Nevertheless, there was also a case that ended with a successful decision for the applicant. The written description was considered enough for a scent's registration:

3. OHIM, Judgement of 11-Feb-1999, R 156/1998-2

Vennootschap onder Firma Senta Aromatic Marketing [successfully registered](#) a scent trademark for tennis balls that smelled of "fresh cut grass," due to the decision stated by OHIM Second Board of Appeal. In this case, the Board noted not only that the written description gave a clear and unambiguous idea of what the mark represents when used in connection with tennis balls, but also stated that the description complies with the graphical representation requirements. Nevertheless, it remains, to this day, a controversial decision, even though the trademark is no longer active, due to non-renewal.

Considering the above cases, the graphic representation requirement played an essential role in the judgments. Therefore, the jurisprudence is expected to change due to the new and looser representability concept. Step by step, scent trademarks have higher chances of transitioning from non-conventional trademarks to a more conventional trademark status.

New representability concept: Implementation challenges

The removal of the graphic representability requirement by the Directive represents an important step toward the development of IP rights according to the challenges and requirements of the current business environment. It will become easier to register sounds, fragrances and signs in motion. Although legally possible, this will pose significant challenges for the scientists who would develop new representation technologies.

There are already electronic devices that can recreate various scents according to a computer's instructions. The representation of scents may soon become accepted as electronic files. There are good chances for this solution to comply with all the seven Sieckmann's case requirements, including the capability of a sign representation to be easily accessible. The reason is that the files can be published, and the scent may then be reproduced at will. The development and speed of adoption of this type of technology will set the pace for the registration process and publication of scent trademark applications. A scent trademark will then become similar to a word or logo trademark.

The new concept will also pose a challenge for the National Trademark Offices (applying the new representation concept in practice) and for the European Court of Justice (interpreting the European regulations).

Regarding European trademark applications, the new representation concept is already applicable, being stated for the first time by the EU Regulation 2015/2424 (which entered into force on October 1, 2017) and being maintained by the current act – EU Regulation 2017/1001. In respect to national applications, it has to be noted that this legal modification may be considered of significant importance not only due to the effects that it provides but also since it is a novelty for all the EU member states. All the national trademark regulations enacted before Directive 2015/2436 provided the requirement of a sign to be capable of being represented graphically.

At the publication date of this article, the EU Directive 2015/2436 has been transposed in most member states, while the legislative process is still in progress in others. In order to receive a complete status of the Directive's transposition in all the European Union member states, please access the link [Download the transposition status document here!](#)

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