

Olfactory and Sound Marks in the European Union

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The European Court of Justice (ECJ) has recently ruled on several issues of interpretation concerning the First Council Directive 89/104/EEC to approximate the laws of the Member States relating to trade marks (the European Union Harmonization Directive), concerning olfactory and sound marks. Katrine Levin, trade mark lawyer at London law firm Field Fisher Waterhouse explores the issues.

The European Union Harmonization Directive provides that a trade mark may consist of a sign if the sign is capable of being represented graphically and if it is capable of distinguishing the goods or services of one undertaking from those of another. Thus, a mark can consist of any sign that is capable of graphic representation and that is distinctive. It is accepted that scents and sounds, while generally not inherently distinctive, can acquire distinctiveness through extensive use. However, the ECJ was recently faced with questions of interpretation regarding whether olfactory and sound marks are capable of graphic representation.

Olfactory and sound marks have been registered in the European Union (EU) in the past. For example, trade mark registrations have been granted for the strong smell of bitter beer as applied to flights for darts; the scent reminiscent of roses as applied to car tyres; the smell for fresh cut grass as applied for tennis balls; the roar of the MGM lion; and the sound of a dog barking.

However, subsequent to the recent ECJ decisions, proprietors wishing to protect olfactory and sound marks will find that whereas protection is still available for sound marks, it no longer appears available to olfactory marks in the EU.

Olfactory Marks

The future of olfactory marks in the European Union has been severely undercut by the recent decision from the ECJ (C-273/00, December 12, 2002). The ECJ considered a request for a preliminary ruling on questions of interpretation of the European Union Harmonization Directive. The questions arose from German proceedings (*Sieckmann v Deutsches Patent- und Markenamt*) involving an olfactory mark for a scent described as “balsamically fruity with a slight hint of cinnamon” as applied to a variety of services. The description was accompanied by the chemical formula of the scent as well as an odour sample which was submitted with the application.

The first question of interpretation, brought before the ECJ, applied equally to all non-visual marks. It was whether a trade mark can consist of a sign which is not in itself capable of being perceived visually. If this was answered in the affirmative, the ECJ was then asked to consider whether the requirement of graphic representation, as it applies to olfactory marks, can be satisfied by a chemical formula, by a description in written words, by a deposit of an odour sample or by a combination of any of these methods.

Can a non-visual sign function as a trade mark?

The ECJ ruled that a trade mark may consist of a sign which is not in itself capable of being perceived visually, if it has distinctive character and if the sign can be represented graphically, such as by images, lines or characters. The graphic representation must be clear, precise, self-contained, easily accessible, intelligible, durable and objective.

In issuing this ruling, the ECJ has provided guidance not only with respect to olfactory marks but also regarding all non-visual signs, including sounds.

Can a sign consisting of a scent satisfy the graphic representation requirement?

In issuing its ruling with respect to the second question, the ECJ followed the opinion of the Advocate General, which addressed in turn each method of satisfying the representation requirement.

A chemical formula was stated not to meet the graphic representation requirement because it represents the substance *per se* rather than its odour. A chemical formula does not provide information about the scent itself because the same product may emit different odours depending on external factors such as temperature or the composition of the surface to which the substance is applied. Further, the average member of the public would not be able to interpret the chemical formula as a smell, a fact which would also hinder any registered searches for the mark.

A written description was stated not to be sufficiently clear and precise to meet the graphical representation requirement. For example, in the case before the ECJ the applicant was seeking to register a scent that is “balsamically fruity with a slight hint of cinnamon”. This description presents a fair amount of uncertainty as to what is meant by “balsamically fruity” and what is the contemplated strength of the “slight hint” of cinnamon.

Deposits of a sample of the chemical compound emitting the claimed scent were stated not to satisfy the graphical representation requirement on account of several reasons. One reason is that such a deposit cannot be registered or published in a clear or accurate way. Another reason is that the chemical structure and composition of the deposited sample is likely to degenerate and change through time due to the volatility of its components or to other factors. This will lead to a change in or to the loss of the claimed scent and render the deposit useless.

Any combination of the above methods were stated to be as unsatisfactory to meet the graphic representation requirement as each method individually. A combination of the methods would only increase general confusion because of the number of different interpretations of the smell that would be offered in a situation where a chemical formula is accompanied by an odour sample and complemented by a written description.

Based on the foregoing factors, the ECJ ruled that in respect of olfactory marks, the requirements of graphic representation are not satisfied by a chemical formula, by a description in written words, by a deposit of an odour sample or by a combination of any of these methods. This decision casts a shadow, if not the final curtain, on the registrability of olfactory marks in the EU at least for the immediate future, for it is difficult to imagine any alternative means, in addition to the methods already excluded, of meeting the graphic representation requirement for an olfactory mark.

Sound Marks

Sound marks will continue to be accepted in the EU, as evidenced by the recent ECJ decision on the matter (C-283/01, April 13 2003). In this case, the ECJ considered a request for a preliminary ruling on questions of interpretation of the European Union Harmonization Directive arising from proceedings in the Netherlands (*Shield Mark B.V. v. Joost Kist h.o.d.n. Memax*) and involving enforcement of the following sound marks: (1) a notation of the first nine notes to Beethoven's *Fur Elise* and (2) an onomatopoeic word "kukelekuuuuu", representing the Dutch imitation of the cockerel crow.

The first question of interpretation before the ECJ was whether a sound can function as a trade mark and, if so, whether all Member States should accept sounds as trade marks. The ECJ was also asked to consider whether the requirement of graphic representation, as it applies to sound marks, can be satisfied by a musical notation, an onomatopoeic description (written description of a vocal imitation), a sound or digital recording, or any combination of these methods.

Can a sign consisting of a sound act as a trade mark and satisfy the graphic representation requirement?

The ECJ reiterated that a non-visual sign, including a sound, can function as a trade mark but only if it has distinctive character and is capable of being represented graphically, in a clear, precise, self-contained, easily accessible, intelligible, durable and objective way. The ECJ then ruled that whether a sound should be afforded trade mark protection in a Member State is for the national courts to decide, taking into account all the relevant factors of the case.

The ECJ then considered whether the graphic representation requirement could be met by a musical notation, an onomatopoeic description, a sound or digital recording or any combination of these methods. The ECJ ruled that a musical notation satisfies the graphic

representation requirement. However, a written description, whether onomatopoeic (e.g., “kukelekuuuuu”) or of any other kind, does not satisfy the graphic representation requirement.

The ECJ did not rule on whether a sound or digital recording would satisfy the graphic representation requirement or whether a combination of several methods may do so where an individual method will not. Although the court did not expressly state as much, it appears that the ECJ is leaving the unanswered questions to the discretion of the national courts of the Member States.

In view of the above, sounds are capable of obtaining trade mark protection in the European Union, given distinctive character and given that the sound is capable of being represented by a musical notation. The fate of sounds not capable of being represented by a musical notation is less clear.

Katrine Levin can be contacted at London law firm Field Fisher Waterhouse
e: kxl@ffwlaw.com

Field Fisher Waterhouse 35 Vine Street London EC3N 2AA
Tel +44 (0)20 7861 4000 Fax +44 (0)20 7488 0084 e-mail info@ffwlaw.com london@thealliancelaw.com
www.ffwlaw.com www.thealliancelaw.com CDE 823

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