

Whether subject matter functions as a trademark depends upon the facts in the particular case. For example, in *In re Clarke*, 17 USPQ2d 1238 (TTAB 1990), the Trademark Trial and Appeal Board held that a scent functioned as a mark for "sewing thread and embroidery yarn." The amount of evidence required to establish that a scent or fragrance functions as a mark is substantial. *Cf. In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 227 USPQ 417 (Fed. Cir. 1985).

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IN RE CLARKE

17 U.S.P.Q. 2d 1238 (TTAB 1990)

Applicant, Celia Clarke, doing business as Clarke's OSEWEZ, has appealed from the final refusal of the Trademark Examining Attorney to register applicant's asserted mark for "sewing thread and embroidery yarn." [FN1] Applicant has described her mark in the "drawing" filed with her application as follows: "The mark is a high impact, fresh, floral fragrance reminiscent of Plumeria blossoms."

The Examining Attorney has refused registration on the ground that applicant's asserted mark does not function as a trademark because it does not identify or distinguish applicant's goods from those of others. In the initial refusal, the Examining Attorney observed that applicant's fragrance 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 that applicant's alleged mark was de jure functional, assertedly because of the competitive need for free access to pleasant scents or fragrances. In his appeal brief, the Examining Attorney withdrew the de jure functionality refusal.

In support of her attempt to register this fragrance mark, counsel for applicant submitted a declaration of applicant attesting to the fact that, to the best of her knowledge, no other company has ever offered any scented embroidery yarn or thread; that she has placed advertisements stressing the fact that her company is the source of sweet-scented embroidery products, known in the trade as Russian embroidery or punch embroidery; and that due to the success of her products, applicant is now a major source of yarn and thread and supplies dealers and

1 discloses that the scent applicant has added to her product is not a natural or inherent
2 feature of the goods and does not provide any utilitarian advantage. The Examining
3 Attorney adds that, presumably, if applicant's scent does function to indicate origin,
4 potential consumers may readily be able to distinguish among the vast array of scents
5 in identifying competing sources of goods.

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7 In support of his argument that applicant's fragrance mark is not of a character
8 usually recognized by potential consumers as an indication of origin, he requests the
9 Board to take judicial notice of the fact that there are pleasant, arbitrary and
10 nonfunctional scents in a wide variety of products, including cosmetics and cleaning
11 products, which have the sole purpose of making the use of those products more
12 pleasant or attractive. Therefore, while applicant is the only source of scented yarn
13 and thread, the Examining Attorney argues that potential consumers are unlikely to
14 regard scent in any product as an indication of exclusive origin in view of their
15 conditioning in the consumer product marketplace. The rarity of usage of fragrance
16 as a feature of applicant's goods weighs against registration, according to the
17 Examining Attorney. Rather, it is much more likely that consumers will regard the
18 scent as a pleasant feature of the goods.

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20 While the Examining Attorney concedes that the asserted fragrance may be registrable
21 upon a convincing showing of trademark function, he maintains that applicant has
22 not specifically promoted the particular scent as an indication of origin. Applicant's
23 advertising makes reference to "Clarke's Distinctive Sof-Scented Yarns," but no
24 reference is made to a specific fragrance. Nor does the advertising make any attempt,
25 according to the Examining Attorney, to draw attention to the scent as an indicator
26 of origin.

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28 Upon careful review of this record, we believe that applicant has demonstrated that
29 the scented fragrance does function as a trademark for her thread and embroidery
30 yarn. Under the circumstances of this case, we see no reason why a fragrance is not
31 capable of serving as a trademark to identify and distinguish a certain type of
32 product. It is clear from the record that applicant is the only person who has
33 marketed yarns and threads with a fragrance.⁴ That is to say, fragrance is not an

to identify and distinguish his or her goods, including a unique product, from those manufactured or sold
by others and to indicate the source of the goods, even if that source is unknown.

⁴ It should be noted that we are not here talking about the registrability of scents or fragrances of
products which are noted for those features, such as perfumes, colognes or scented household products. Nor
is this a case involving the question of descriptiveness of a term which identifies a particular fragrance of a
product. In such cases it has been held that a term is unregistrable under Section 2(e)(1) of the Act if it merely
describes an odor or other significant feature of the product. See *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d
1009 (Fed. Cir. 1987) (APPLE PIE held merely descriptive since the term described the scent released by

1 distributors throughout the United States. Applicant also states that her company has
2 received a great number of favorable and positive responses to her unique product
3 and that, to the best of her knowledge, customers, dealers and distributors
4 throughout the embroidery field recognize applicant as the source of scented
5 embroidery yarn and thread. While maintaining that her fragrance is registrable as
6 a mark because it is inherently distinctive of yarns and threads, no other
7 manufacturer having sold such goods, applicant nevertheless argues that she has
8 presented sufficient evidence of recognition of her asserted mark. Applicant
9 concludes, brief, 13:

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11 Other are free to adopt any other scent for their
12 yarns and threads, including floral scents such as that
13 of a lily of the valley, a carnation or a rose to give
14 but three examples. Surely people have come [to]
15 distinguish these floral scents from one another, just
16 as they can distinguish the color pink (for fiberglass
17 insulation) from other warm colors such as red,
18 orange, and yellow. Just as the registration of the
19 color pink for fiberglass insulation has been held to
20 not present a significant obstacle for competitors
21 wishing to produce fiberglass insulation, so does the
22 applicant's particular fragrance not present a
23 significant obstacle to competitors wishing to offer
24 scented yarns.

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26 Applicant has made of record a complete sealed kit containing scented yarn and
27 thread for making a scented skunk.

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29 Expressing unawareness of any precedent dealing with the registrability of an
30 arbitrary, nonfunctional scent, the Examining Attorney states that the most closely
31 analogous determinations appear to be those dealing with colors as trademarks.
32 [FN2] The Examining Attorney concedes that there is no inherent bar to the
33 registrability of an arbitrary, nonfunctional scent or fragrance³ and that this record

³ Section 45 of the Trademark Act, 15 U.S.C. 1127, as amended (eff. Nov. 16, 1989), defines the term "trademark" as follows:

The term "trademark" includes any word, name, symbol, or device, or any combination thereof-

(1) used by a person, or

(2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this Act,

1 inherent attribute or natural characteristic of applicant's goods but is rather a feature
2 supplied by applicant. Moreover, applicant has emphasized this characteristic of her
3 goods in advertising, promoting the scented feature of her goods. Applicant has
4 demonstrated that customers, dealers and distributors of her scented yarns and
5 threads have come to recognize applicant as the source of these goods. In view of the
6 unique nature of applicant's product, we do not believe that the failure of applicant
7 to indicate in her promotional materials the specific scent or fragrance of her yarn
8 (admittedly difficult to describe except in the manner that applicant has done so) is
9 significant. In her advertisements and at craft fairs, applicant has promoted her
10 products as having a scented nature. We believe that applicant has presented a prima
11 facie case of distinctiveness of her fragrance mark. Compare *In re Star*
12 *Pharmaceuticals, Inc.*, 225 USPQ 209 (TTAB 1985) (where applicant failed to
13 demonstrate that the features (colors) sought to be registered had been promoted as
14 a source indicator).⁵

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16 Decision: The refusal of registration is reversed.⁶
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potpourri simmered in water).

⁵ We note that the Trademark Review Commission of the United States Trademark Association, in its review of the Trademark Act of 1946,

determined 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.

The United States Trademark Association Trademark Review Commission Report and Recommendations to USTA President and Board of Directors, 77 TMR 375, 421 (Sept.-Oct. 1987). See also Moon-Ki Chai, "Protection of Fragrances under the Post-Sale Confusion Doctrine," 80 TMR 368, 371-72 (July-Aug. 1990).

⁶ The description of applicant's mark noted above will appear on the certificate of registration as applicant's mark. Although advances are continually being made in Office operations and practices, the era of "scratch and sniff" registrations is not yet upon us.