

OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET  
(TRADE MARKS AND DESIGNS)

The Boards of Appeal

**DECISION  
of the Third Board of Appeal  
of 5 December 2001**

In Case R 711/1999-3

**MYLES LIMITED**

Grosvenor House, 66/67 Athol Street  
Douglas, Isle of Man  
IM99 1XJ British Isles  
UNITED KINGDOM

Appellant

represented by Patentanwälte Schütz & Partner, Schottenring 16, Börsengebäude,  
A-1010 Vienna, Austria

Appeal relating to Community trade mark application No 1 222 090

**THE THIRD BOARD OF APPEAL**

composed of S. Sandri (Chairperson and Rapporteur), A. Bender (Member) and  
T. Margellos (Member)

Registrar: E. Gastinel

gives the following

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Language of the case: German

DECISION OF 5 DECEMBER 2001 – R 711/1999-3 – The scent of raspberries

## Decision

### **Summary of the facts**

1. By an application received by the Office on 28 June 1999 the appellant sought to register an olfactory mark stated as follows:

#### **The scent of raspberries**

for the following goods:

Class 4 - Fuels, including motor fuels, particularly diesel as heating fuel, fuel and engine fuel.

In addition, the applicant gave the following description of the trade mark in the application: 'The trade mark consists of the scent or smell of raspberries, applied to the said goods.'

2. In its decision of 1 October 1999 ('the contested decision'), the examiner refused to grant a date of filing in accordance with Article 27 and Article 26(1)(d) and under Article 4 of Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark ('CTMR'), OJ 1994 L 11, p. 1, OJ OHIM 1/95, p. 53) and Rule 3(2) and (3) of Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Council Regulation (EC) No 40/94 on the Community trade mark ('IR'), OJ 1995 L 303, p. 1, OJ OHIM 2-3/95, p. 259), on the following grounds:

- Examination of the application revealed that it did not contain any representation of the trade mark, and that it therefore could not be treated as an application for a Community trade mark. Article 4 CTMR contains one of the fundamental principles of the Community trade mark system, according to which the sign to be examined must be capable of being represented graphically.
- Under Article 27 and Article 26(1)(d) CTMR, a representation of the trade mark was one of the preconditions for granting a date of filing. Rule 3 IR specified that in cases 'other than' word marks, the trade mark must be reproduced on a sheet of paper separate from the sheet on which the text of the application appears. As well as the actual representation, the application may contain a description of the trade mark in words.
- The content of a trade mark application must be determined absolutely clearly from the outset, that is, it must reveal what, according to the intention of the applicant, is to be subject to protection.
- The decision of the Second Board of Appeal of 11 February 1999, R 156/1998-2 – 'the smell of fresh cut grass' (OJ OHIM 10/99, p. 1239), was to date an exception and contrasted with a series of comparable decisions of the Boards of Appeal, e.g. of 7 October 1998, R 1/1998-2 – 'Sound mark

consisting of a click sound', of 21 January 1998, R 4/1997-2 –'Vacuum packing' and of 12 February 1998, R 7/1997-3 –'Orange'.

3. The appellant filed notice of appeal against this decision on 11 November 1999. As grounds for the appeal the appellant submitted the following arguments:
  - The representation by means of the written words 'the scent of raspberries' is a clear representation which meets the requirements of Article 4 CTMR.
  - The decision of the Second Board of Appeal of 11 February 1999, R 156/1998-2, 'the smell of fresh cut grass', is entirely comparable with the present case. The scent of raspberries is a clearly distinguishable smell which everyone could recognise from direct experience, and which is reminiscent of the pleasant taste of raspberries, raspberry sweets, picking raspberries in the woods, etc. It is therefore also distinctive.
  - The present case is not, however, comparable with the other decisions cited by the examiner, since these in particular did not relate to olfactory marks.
4. The appeal was submitted to the examiner for interlocutory revision pursuant to Article 60 CTMR. It was remitted to the Boards of Appeal on 3 January 2000.
5. Reference is made to the documents in the file, in particular the submissions of both parties, which have been considered by the Board and taken as a basis for its decision.

### **Grounds of appeal**

6. The appeal complies with Articles 57, 58 and 59 CTMR and Rules 48 and 49 IR and is therefore admissible.
7. The requirement of representation of the olfactory mark applied for has been met in this specific case, and the date of filing must therefore be granted. However, examination of the trade mark in relation to absolute grounds for refusal reveals that the trade mark, while capable of being registered, is devoid of any concrete distinctive character.

### *Date of filing and representation of the trade mark applied for, Article 26 CTMR*

8. In the present case the first issue is to decide whether the application for a Community trade mark can be granted a date of filing. One of the minimum formal requirements for an application to be granted a date of filing is a 'representation' of the trade mark in accordance with Article 27 and Article 26(1)(d) CTMR, which the Office must officially examine pursuant to Article 36(1)(a) CTMR and Rule 9(1)(a) (iv) IR.
9. This legal requirement of representation as a precondition for a date of filing to be granted corresponds to the principle of certainty in registration law and to the principle of reliance founded thereon. It is intended inter alia to determine the precise subject matter of the protection under the trade mark application, from the application date. The requirements to fulfil this precondition are not specifically

defined for olfactory marks in either the Regulation on the Community trade mark or the Implementing Regulation.

10. The starting point for interpretation is the premise that every representation of the trade mark in the Register must be complete, clear, precise and objective. This requirement is not an end in itself, but is justified by the technical needs of a formal registration procedure.
11. First, the representation must be complete and encompass the trade mark as a whole. In addition, it must be so clear and precise that the Office is able to undertake the examination for absolute and relative grounds for refusal, publish the trade mark in the Community Trade Marks Bulletin and register it in the Register of Community Trade Marks. Such a representation must also be so unequivocal that competitors can undertake investments in reliance on the precisely-outlined scope of the trade mark and the courts and parties are in a position to establish and assess properly any trade mark infringements (cf. Decision of the Third Board of Appeal of 12 February 1998 in Case R 7/1997-3 – ORANGE, OJ OHIM 7-8/98, p. 898 (German version) and 5/98, p. 641 (other language versions)).
12. It is also necessary to apply objective criteria by which everyone can know beyond any doubt precisely what trade mark is protected. As Advocate-General Ruiz-Jarabo Colomer has appositely remarked, there are ‘no sense organs which are objective and others which are subjective’ (Case C-273/00, *Ralf Sieckman*, Opinion of 6 November 2001). The problem of the subjectivity and relativity of communication lies in the nature of human perception. All attempts to solve the problems in this area must however also take into account the principle of legal certainty.
13. The trade mark must be able to be understood on inspection of the Register. It would not as a rule be acceptable for a representation of the trade mark to require inordinate exertion from the person inspecting the Register, or special expertise as a scientist or researcher, in order to recognise from the representation in the Register what the sign is.
14. The requirements of completeness, clarity, precision and objectivity are rarely found together in olfactory marks, since a smell is normally composed of a number of chemical constituents, which leads to various notes, evaporates, is subjectively perceived differently, and can generally be described imperfectly in words. However, it is not impossible that in an exceptional case a scent can be represented completely, clearly, precisely and objectively.
15. This is the case with ‘the scent of raspberries’, that is, the scent which emanates from this mostly red fruit, a berry-like drupelet fruit which has been gathered and cultivated since time immemorial. The scent of raspberries is unequivocal and precise. Admittedly, the scent of raspberries is sometimes equated with its taste, and it should be remembered that the applicant has not sought to register a taste mark. Also, the scent of raspberries is weaker in the natural state than in a purée.

16. The scent of raspberries does not remain vague and imprecise, however, and it is always recognisable by reference to the fruit. There is no room for a subjective interpretation on the part of the consumer or the Office. A description of the sign in words constitutes sufficient representation to send a clear and unvarying message, since the scent of raspberries is a unique, pure smell.
17. This distinguishes the present case from, for example, a trade mark consisting of the smell of ‘cinnamon’, since the latter smell cannot be recognised by the consumer until he has directly experienced this scent or its aroma (cf. Decision of 16 June 2000 of the Trade Mark Office of the United Kingdom, upheld on appeal by a decision of 19 December 2000, trade mark No 2 000 169, RPC 2001, p. 575). In the case of ‘the smell of fresh cut grass’ (cf. Decision of the Second Board of Appeal of 11 February 1999 in Case R 156/1998-2 – The smell of fresh cut grass, loc. cit.) the smell does not come from the grass itself, the type of which is unspecified, but is affected by the cutting, which moreover must be fresh, i.e. have been done within a short, but unspecified period of time. In the case of the olfactory mark of the chemically pure substance methyl cinnamate, described as ‘balsamic-fruity with a slight hint of cinnamon’ (cf. C-273/00, *Ralf Sieckman*, request for a preliminary ruling from the Bundesgerichtshof (German Federal Court of Justice)), the smell is not obvious to the consumer, since the smell must first be produced with a mixture of different constituents. In this case, therefore, a chemical formula represents only the substance, and not its smell, which is also not clear from the description.
18. The representation can not be considered as imprecise on account of the applicant stating in the description of the trade mark in the application that the smell is to be ‘applied’ to the goods. Application of the trade mark directly to the goods is one of the possible ways of using a trade mark, in addition to, for example, applying the trade mark to the packaging, using it in advertising, etc. The description of the trade mark in the application should not be understood as intending to protect a mixture of smells, such as a mixture of a raspberry smell and a diesel smell. The application is only for the scent of raspberries. In view of that, the manner of use of this trade mark, for example as an additional ingredient in other smells, is of no consequence in the context of establishing the precise content of the trade mark.
19. The Board is not convinced by the counter-argument that the smell does not have a definite content, since it may be perceived differently due to various factors, being affected for example by the concentration and quantity, the temperature, the carrier material, the odorous substances, etc., as well as by subjective factors such as memories. These arguments can be applied to any type of trade marks. Likewise, the meaning of a word mark or acoustic mark may change according to the context or interpretation, and its perception may change according to size and placing, and also due to subjective factors. This does not matter as long as the trade mark itself is clearly represented in the Register.
20. Lastly, the examiner’s objection under Rule 3(2) IR is not justified. The provisions in Rule 3 IR for the ‘representation of the trade mark’ to be filed with the application appear to be tailored too closely to the traditional forms of trade marks, such as word marks and figurative marks, and must therefore be viewed by the Office in the context of the requirements of the principle of certainty in

registration law and in the light of the legislature's decision in favour of a wide opening for novel forms of trade mark as evidenced by the wording of Article 4 CTMR.

*Registrability, Article 7(1)(a) and Article 4 CTMR*

21. To grant a date of filing under Articles 26 and 27 CTMR does not however mean that the trade mark application must be published. On the contrary, the trade mark must be examined further by the Office of its own motion, in particular in relation to possible absolute grounds for refusal under Article 38 and Article 7 CTMR.
22. It is true that, formally, the appeal is only directed against the refusal of a date of filing. However, the arguments of the Office in its objections and its rejection decision, and of the applicant before the examiner and the Board of Appeal, relate also particularly to the refusal of protection as a trade mark, and the Board therefore regards it as proper to exercise its discretion under Article 62(1) CTMR to act in this regard within the competence of the Examination Division (cf. Decision of the Third Board of Appeal of 12 February 1998, R 7/97-3 – ORANGE, paragraph 16, loc. cit.; Judgment of the Court of First Instance in T-163/98, *Baby-dry* [1999] ECR II-2383, OJ OHIM 11/99, p. 1487, paragraph 43). The applicant had the opportunity to comment on the problem areas concerned.
23. In the present case 'the scent of raspberries' is registrable and is not excluded by Article 7(1)(a)) CTMR from registration as a sign which does not conform to the requirements of Article 4 CTMR.
24. In assessing a sign's ability to be registered account must be taken of Article 4 CTMR, which reads as follows in material part:  
 'A Community trade mark may consist of any signs capable of being represented graphically, particularly words, ... 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.'
25. The trade mark is a communication sign in the marketplace. Trade marks are communication signs between undertakings and people and which relate to a product or undertaking. One of a person's five senses is the sense of smell. Trade marks which as olfactory marks act on the nose as identification signs cannot be excluded on principle from protection under trade mark law.
26. The Board is of the view that smells, considered in the abstract, may be capable of becoming accepted in trade as an independent means of distinguishing between undertakings within the meaning of this provision. Although olfactory marks are not expressly mentioned in Article 4 CTMR, it is clear from the wording thereof that the list of certain forms of trade mark is given merely by way of example, and does not preclude other kinds of trade mark. This has been recognised repeatedly by the Office's Boards of Appeal, for example in relation to colour marks. The wording of Article 4 CTMR also admits the interpretation that smell signs are registrable in theory.

27. It follows from a systematic and teleological interpretation that the wording ‘any signs’ in Article 4 CTMR must therefore be construed as a very broad, ‘open’ and general term encompassing all conceivable types of marks, including olfactory marks, in so far as they are capable in the abstract of distinguishing the goods of one undertaking from those of its competitors (cf. Decision of 19 December 1998, R 122/1998-3, LIGHT GREEN, paragraph 17).
28. In this context it is also necessary to assess the further condition according to which only signs ‘capable of being represented graphically’ can be Community trade marks. This is because graphic representability must be interpreted narrowly, and in relation to the form of trade mark specifically claimed in the application.
29. In the absence of a predetermined meaning, therefore, it is necessary to examine the purpose (*ratio*) of the graphical representation requirement. There is no need to interpret the wording ‘capable of being represented graphically’ more restrictively than the purpose demands. The broad understanding of signs which are eligible to be trade marks is the expression of a modern understanding of trade marks, according to which today novel signs such as colours, acoustic marks, holograms, olfactory marks and other signs can be used as trade marks, in order to perform a trade mark function in the market.
30. The Board also notes that the wording of Article 4 CTMR does not itself preclude the possibility that signs may function as trade marks even when they cannot be perceived visually. Article 15(1), last sentence, of the Agreement on Trade-related Aspects of Intellectual Property Rights (TRIPs) (OJ OHIM 11/96, pp. 1583 and 1601) confirms that Member States may, but need not, demand that signs be visually perceptible.
31. This demonstrates that in order to be capable of being a trade mark, there is no condition that the trade mark itself must be capable of direct graphic representation as in the case of a word mark or figurative mark. Under some circumstances, to be capable of indirect representation will also suffice, at least when the desired form of trade mark, by its very nature, cannot be directly represented in writing or in an image, as is the case, for example, with acoustic or olfactory marks, and provided the requirement of certainty is satisfied in relation to the date of filing. In such cases, a precise description or, for example, a musical notation will suffice if such a trade mark is not to be barred from registration *ab initio*. In the present case of the trade mark, ‘the scent of raspberries’, it must be considered that the mark is capable of registration.

*Concrete distinctive character, Article 7(1)(b) CTMR*

32. In the present case, however, the trade mark has no concrete distinctive character for the goods applied for. In the view of the Board of Appeal ‘the scent of raspberries’ is not capable of overcoming the absolute ground for refusal due to lack of distinctive character under Article 7(1)(b) CTMR.

33. In the examination of the various grounds for refusal it must be borne in mind that this does not provide for different criteria applying to different categories of trade marks (cf. Judgment of the Court of First Instance in T-30/00, *Henkel v OHIM – ‘Tabs’*, paragraph 48).
34. Under Article 7(1)(b) CTMR, however, a trade mark is not eligible for registration if it is devoid of any distinctive character for the goods sought to be registered. The distinctive character of a trade mark serves the trade mark’s function of characterising its commercial origin and so rendering the goods distinguishable according to their commercial origin, as opposed to their nature (cf. Judgment of the Court of First Instance of 26 October 2000, T-360/99, *Community Concepts v OHIM ‘Investorworld’*, paragraph 33).
35. Under Article 7(1)(b) CTMR, trade marks are excluded from registration if they are devoid of distinctive character, that is, if they lack the inherent concrete capacity to be recognised, in trade, as a means of distinguishing the goods or services of one undertaking from those of other undertakings. In particular, the trade mark must be capable of acting as an indication of origin. The criteria for judging the distinctive character of olfactory marks are no different from those which apply to the other categories of trade mark.
36. In accordance with this provision and irrespective of any actual use of the sign in the marketplace, the Board must examine whether there appears to be no possibility that the sign in question may be capable of distinguishing, in the eyes of the public to which it is addressed, the goods concerned from those of a different origin (cf. Judgments of the Court of First Instance in T-87/00, *EASYBANK*, paragraph 40, and T-30/00, *Henkel v OHIM*, ‘*Tabs*’, paragraph 61).
37. The Community trade mark system does not prescribe that trade marks must be used before registration is sought. The fact that the consumer has become accustomed to a particular sign is not to be taken into consideration, except as regards trade acceptance under Article 7(3) CTMR in the case of an application which would otherwise be rejected under Article 7(1)(b), (c) or (d) CTMR, which has not however been argued here (cf. Judgment of the Court of First Instance, T-30/00, *Henkel v OHIM*, ‘*Tabs*’, paragraph 47).
38. Registration was sought for the following goods: ‘Fuels, including motor fuels, particularly diesel as heating fuel, fuel and engine fuel’. The goods claimed are widely distributed consumer goods. Consequently, it is general trade circles that are targeted, from car drivers to homeowners. It is therefore appropriate to take into account generally the presumed expectations of an average consumer who is reasonably well-informed, observant and circumspect. In addition, it is necessary to consider that the level of attention of the average consumer, owing to the nature of the goods concerned, is not high (cf. Court of Justice of the European Communities (CJEC) Judgments in C-210/96, *6-Korn-Eier* [six-grain eggs] – *Gut Springenheide*, paragraph 31, OJ OHIM 3/99, p. 561, and C-342/97, *Lloyd*, OJ OHIM 12/99, p. 1569, paragraph 26).

39. The average consumer is affected, when perceiving a trade mark, by a large number of different elements, in particular the first impression made by the trade mark in question and the likely perception of the goods in respect of which registration is sought (cf. Judgment of the Court of First Instance, T-24/00, *The Sunrise Corporation v OHIM ‘VITALITE’*, paragraph 15). In assessing whether a trade mark can act as a communication sign, it is necessary to examine whether the relevant trade circles currently associate the sign with the group of goods concerned, or whether this may reasonably be expected in future.
40. In applying these criteria, however, it should be taken into account that perception by the relevant trade circles is not the same with an olfactory mark as with a word mark. Even the novel forms of trade mark, such as colour marks, acoustic marks, taste marks or tactile marks, must have a functionally independent and autonomous character relative to the goods. Signs cannot be trade marks unless they spread out in space and can be perceived independently of the article of which they represent a property. This relationship between the goods and the trade mark should be stable and durable over time, so that the decision to purchase is always made regarding a trade mark which maintains the same state.
41. As regards examination of the specific goods in the application, it should first be noted that the generic trade description ‘fuels’ also includes scented candles and scented paraffin, which are already on the market. Such goods give off a particular scent when burned. Raspberry scent is for these scented fuels an essential property of the goods, and as such is clearly not of distinctive character.
42. However, the application also lists other fuels among the goods sought to be registered, namely motor fuels, particularly diesel as heating fuel, fuel and engine fuel. It should be noted that all these goods have a strong intrinsic smell which is usually experienced as unpleasant. The addition of raspberry scent has little or no effect on the consumer’s impression of the smell of these goods overall, even though the scent of raspberries may render the goods’ own smell somewhat more pleasant.
43. Nevertheless, the consumer does not take in the scent of raspberries separately from the goods. The addition of raspberry scent to fuels such as diesel or heating oil, which generally smell unpleasant, is similar to the perfuming of unpleasant-smelling rooms with scented sprays. The consumer will therefore see the added raspberry scent as one of the industry’s many attempts to make the smell of these goods more pleasant. The consumer described above recognises the scent only as an improvement in the image, similar to a decorative element, and not as a sign acting as an indication of origin and a distinctive feature.
44. Consequently, and in view of the weak scent of raspberries and the strong intrinsic smell of fuels, such as diesel, the Board takes the view that the consumer will not orient himself by the smell as a trade mark. He will consider the smell to be only a ‘fragrancing’ of the goods and not a trade mark. As regards the overall impression created by the description of the smell and by the goods sought to be registered, to which this scent is to be applied, the trade mark applied for does not enable the relevant trade circles when selecting a product for purchase to distinguish the

goods in question from those with a different trade origin, which may also include added scents.

45. In the form applied for, the sign cannot guarantee to the consumer the identity of origin of the goods in the application, nor can it enable him to recognise the trade mark independently of the goods. It is not possible to establish from the application whether the mere statement ‘the scent of raspberries’ fulfils the conditions of independence and durability.
46. The trade mark application’s lack of capacity to indicate the origin of the goods, established by an a priori examination and irrespective of actual use of it, is moreover not affected by the fact that there are probably at present few, if any, suppliers offering ‘raspberry diesel’ or similar. Experience in comparable markets, however, shows that it is probable that smell additives will be developed for diesel.
47. In so far as the appellant cites R 156/1998-2 – ‘the smell of fresh cut grass’, it should be noted that every application must be judged according to the concrete circumstances of the individual case. The circumstances of that case were different. Furthermore, the other decisions of the Boards of Appeal cited by the examiner are ultimately not comparable with this case, particularly since they do not concern olfactory marks.

**Order**

On those grounds,

**THE BOARD**

hereby:

**Dismisses the appeal.**

S. Sandri

T. Margellos

A. Bender

Registrar:

E. Gastinel