



Decision of the Second Board of Appeal of 11 February 1999

In Case R 156/1998-2

Venootschap onder Firma Senta Aromatic Marketing Appellant
 Polanerbaan 13e
 3447GN WOERDEN
 Nederland
 Postbus 178
 3440 AD WOERDEN
 Nederland

Markgraaf B.V. Hogeihilweg 3 1101 CA Amsterdam Zui-Oost The Netherlands	Representative
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APPEAL relating to Community trade mark application No 428870

THE SECOND BOARD OF APPEAL composed of K. Sundström (Chairman), J.F. Gormley (Rapporteur) H. Furstner

Registrar: W. Peeters

gives the following **Decision**

Summary of the facts

- 1 In an application filed at the Office on 11 December 1996 the appellant sought to register as an olfactory mark 'the smell of fresh cut grass' for goods, namely, tennis balls in Class 28 of the Nice Classification. The application was accorded the filing date of 11 December 1996.
- 2 By letter dated 25 June 1998, the examiner after an initial examination of the application, expressed the opinion that the trade mark was not eligible for registration by virtue of Article 7 (1)(a) of Council Regulation (EC) No 49/94 of 20 December 1993 on the Community trade mark (OJ 1994 L 11, p.1) (hereinafter 'CTMR'). The examiner stated that: 'the words "the smell of fresh cut grass" are not a graphical representation of the olfactory mark itself and the mark as applied for is in fact simply a description of the mark, moreover a mark that is not depicted in the application form in any shape or form'.'

The examiner invited the appellant to submit observations within a period of two months.

- 3 By letter dated 16 July 1998 the appellant responded to the examiner's objections. It submitted that:
- Olfactory marks are not excluded from protection in the Community trade mark Regulation, the Implementing Regulations or the Examination Guidelines.
 - Olfactory marks should be accepted provided they are "capable of being represented graphically", the rationale of the proviso being that third parties should be able to ascertain the scope of the mark by consulting the publication. This requires analysis of the application on a case by case basis and the way the mark has been described. The decisive question being, whether a third party may readily understand what is being claimed.
 - The mark has been displayed graphically which is all that Article 4 CTMR requires. Since form or shape is not claimed it is not necessary that the mark be "depicted in a shape or form" as suggested by the examiner.
 - The requirement of "capable of being represented graphically" is derived from the European Directive which is valid also for national applications in the member states. In the United Kingdom, which has a very rigid examination practice, similar olfactory marks with a similar type definition of the mark, have been accepted (examples enclosed).
- 4 The examiner, by letter dated 24 August 1998, notified the appellant of his decision to refuse its application. He agreed with the appellant's submission that olfactory marks are not excluded from protection under the CTMR. He stated that, it had not been represented graphically and therefore was refused by virtue of Article 7(1)(a) CTMR. The examiner goes on to say: 'In my view, the mark has not been represented graphically. An olfactory mark has been claimed and a verbal description of the mark has been given. But where is the mark itself? What has been given appears to be a graphic representation of a *report* of what the mark is, and not the mark itself. Indeed, being a verbal report of what the mark is, it is not clear where the scope of protection begins and ends. In what way for example does the "smell of fresh cut grass" differ from fresh grass or just cut grass? Would the scope include cover for the words themselves? These questions emerge because of the lack of definition of the "mark" itself. In point (4) you claim that the mark has been registered in Benelux and that the UK accept "similar" marks. This adds some weight to your argument, but in my view not enough to overcome a substantial objection.'
- 5 The appellant filed a notice of appeal against the decision of the examiner, on 24 September 1998 and to which was attached the Grounds of Appeal.
- 6 The grounds of appeal are as set out hereunder:
- a. The objection is based on non-compliance with Article 7 (1)(a) which in turn refers to Article 4 which requires that the sign:
 1. must be capable of being represented graphically, and,
 2. must be capable of distinguishing the goods or services of one undertaking from those of other undertakings.

The examiner confirms clearly that the only issue is the first requirement, in other words, distinctiveness is not the issue.

- b. The statement by the examiner that the mark has not been represented graphically is easily denied by the facts. The mark has been represented in usual typeface and the indication "olfactory mark" and the description of the mark have been treated in the same graphical way.
- c. The objection seems to be based on the ground that the representation of the mark is a description of the mark and not the mark itself i.e. a smell.

This objection finds no basis in the Regulation and is tantamount to introducing an additional requirement, without any legal basis.

- d. Further, since it is admitted by the examiner in the decision "that olfactory marks are not excluded per se and that each mark of such type must be examined case by case" it should be possible in principle to register the marks under the Regulation. If this objection is maintained, it would in fact amount to an absolute exclusion of olfactory marks, as there is no other more suitable graphical way to represent them.
- e. According to legal text books the reason for the requirement of graphical representation is 'the need to be able to record and publish the mark as well as to search the Register' (*The Community Trade Mark*, INTA 1996, p.13) or 'to enable interested parties to ascertain the scope of existing CTM rights, either by consulting the Community Trade Marks Bulletin or by conducting a search of the Register of CTM's' (*Blackstone's Guide to the Community Trade Mark*, Blackstone Press Limited 1998, p.30).
- f. By representing the mark as has been done in the present application, the mark is defined unequivocally and by adding the Type of mark and Description of mark the mark is clear and the claim is clear, so that recordal, publication or searching do not pose a practical problem. It also prevents questions like: "would the scope include cover for the words themselves" as has been raised by the Examiner.
- g. OHIM's Examination Guideline 8.2 clearly states that sound marks are registrable, in particular musical phrases. According to the same guideline musical annotation may be an acceptable form of graphic representation. In fact sound marks present a similar problem as has been raised by the Examiner in this case in that the musical annotation gives a "description" of the music but not the music itself. Yet, it has been recognised as an acceptable way of graphical representation.

It is clear that olfactory marks cannot be treated differently by applying stricter rules which find no basis in the law.

- h. Article 4 CTMR is based on the Harmonization Directive (Article 2) which has been embodied in the national laws of the Member States. The U.K. and Benelux apply the same "graphical representation" requirement in their registration practice and they admittedly apply the most rigorous standards of examination. Nevertheless, both Registries have accepted similar graphical representations of olfactory marks since

enactment of the new definition (copies enclosed).

- i. It follows from the arguments set out above that olfactory marks can be registered if they are distinctive and that a graphical description of the mark in words, in particular if combined with a Type indication and a further Description which adequately define the mark in line with what has been accepted for other similar marks (sound marks), fulfils the requirement of Articles 7 (1)(a) and article 4 combined.

Reasons

- 7 The appeal complies with Articles 57,58 and 59 CTMR and Rule 48 of Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing the CTMR (OJ No L 303 15-12-1995 p.1) hereinafter referred to as 'IR' or 'the Implementing Regulation'. It is therefore admissible.
- 8 The issue in this appeal is whether the trade mark sought to be registered, which is in the nature of a smell or olfactory mark, is sufficiently represented in graphical form as to satisfy Article 4 CTMR.
- 9 In order to examine that issue it is first necessary to consider the purpose of the 'graphical representation' requirement contained in Article 4 CTMR.
- 10 Articles 4, 26 and 27 CTMR and Rule 3 IR reflect the principle contained in the Community trade mark system that a mere description which does not convey a clear and precise indication of a trade mark cannot be considered to be an adequate graphical representation. The decisions of the Board of Appeal in cases '3D Mark' of 21 January 1998 (Case R 4/97-2 *Antoni Tomas Burakowski and Alison Jane Roberts trading as Antoni & Alison* (OJ 3/98 p. 180)), 'Orange' of 12 February 1998 (Case R 7/97-3 *Orange Personal Communications Services Ltd.* (OJ 5/98 p. 640)) explain the importance and significance of this principle for such purposes as examination, search and registration by the various concerned interests, such as the Office, potential applicants, potential opponents and the public.
- 11 The appellant wants his goods namely 'tennis balls' to be indicated as to source through the medium of a particular smell.
- 12 In contrast to three dimensional and colour marks, which are dealt with under Rule 3 IR, there are no conditions laid down in the Implementing Regulation concerning the representation of olfactory marks.
- 13 The question then arises whether or not this description gives clear enough information to those reading them to walk away with an immediate and unambiguous idea of what the mark is when used in connection with tennis balls.
- 14 The smell of freshly cut grass is a distinct smell which everyone immediately recognises from experience. For many, the scent or fragrance of freshly cut grass reminds them of spring, or summer, manicured lawns or playing fields, or other such pleasant experiences.
- 15 The Board is satisfied that the description provided for the olfactory mark sought to be

registered for tennis balls is appropriate and complies with the graphical representation requirement of Article 4 CTMR.

- 16 Having regard to the foregoing, the contested decision must be annulled and the case remitted to the examiner for further prosecution pursuant to Article 62(1) CTMR.

Order

On those grounds THE BOARD

- 1. Annuls the decision.**
- 2. Remits the case to the examiner.**

K. Sundström J. F. Gormley H. Furstner

Registrar: W. Peeters