

The taste of ripe strawberries: representing non-visual trademarks

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March 2008

There have been many attempts to extend the conventional definition of a trademark into unexplored areas such as sounds, smells, taste, colour and 3D shapes. But how do you graphically represent, and protect, a sign that can not be perceived visually?

Trademarks are traditionally understood to identify the commercial origin of a product¹. Protection was reserved for marks that are easily perceived as source identifiers such as words, logos, names, acronyms, and graphic designs. The increasing intensity of commercial competition, and the growth of consumer society, has forced brand owners to look for new ways to distinguish their products from those of their competitors.

There have been numerous attempts to extend the conventional definition of a mark into unexplored areas, and to open to registration, non-conventional marks such as sounds, smells, taste, colour and 3D shapes. This move has found immense support in the branding literature².

European Trademark offices are increasingly facing applications for non-visual marks such as 'the scent of cinnamon', 'the roar of a lion' and the 'taste of ripe strawberries'. However the trademark registration system is built around the notion of 'representative registration'³, and on filing a trademark application, the applicant is required to provide adequate representation of the sign. But how do you graphically represent a sign that can not be perceived visually?

European Legislation

Trademarks can be protected throughout the European Union (EU) by registering the mark as a community Trademark with the office for harmonization in the internal market (OHIM). This statutory right is governed by the [Community trademark regulation \(CTMR\)](#)⁴, which is harmonized across the European Union through the [EU Trademark directive \(TMD\)](#)⁵.

According to Article 2 of the TMD and Article 4 of the CTMR:

A Trade mark may consist of any sign 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

While the legislation provides a list of possible signs, it is not exhaustive. In theory any sign which is distinctive and can be represented graphically, may be registered.

In *Phillips v Remington*, a sign was regarded as: '...anything which conveyed information'. However, in practice non-conventional marks such as sounds, smells, or taste, face the difficulty of graphic representation, as they can not be perceived visually per se. Shape and colour marks can be represented graphically, but may face the difficulty of being devoid of distinctive character.

Sieckmann Criteria

[*Sieckmann v. Deutsches Patent- und Markenamt*⁶](#), is widely recognised as a landmark decision of the European Court of Justice (ECJ) on the graphical representation of non-conventional trademarks. The case involved an application which described a sign that was 'balsamically fruity with a slight hint of cinnamon' for the chemical methyl cinnamate. The application was accompanied with an odour sample and the chemical formula of the smell.

The ECJ ruled that the requirement of graphical representation is not satisfied by

- Scientific formula
- Description written in words
- Depositing a sample of odour or
- Combination of these methods.

The court also confirmed that Article 2 of the TMD does cover signs that can not be perceived visually, if they can be represented graphically by the means of images, lines or characters, where the representation must be clear, precise, self-contained, easily accessible, intelligible, durable and objective. These are known as the Sieckmann criteria.

It is clear that the rationale behind the ECJ's decision is to enable people checking the trade marks register to be clear about what is registered, given the nature of the registry.

Smells marks (olfactory)

As mentioned above, olfactory marks are potentially registrable, as they can indicate the commercial origin of goods or services. But in practice it is difficult to fulfil the requirements of graphical representation.

The UK's first olfactory trade mark was granted to Japan's Sumitomo Rubber Co. in 1996 for 'a floral fragrance of roses as applied to tyres'. The mark was later transferred to Dunlop Tyres. The same year, Unicorn Products, a London-based maker of sports equipment, registered a UK trade mark for 'the strong smell of bitter beer applied to flights for darts.'

Prior to Sieckmann, OHIM manifested a lenient attitude: The smell of freshly cut grass⁷ was registered as a Community Trademark for tennis balls. However, In Sieckmann the ECJ referred to this as a 'pearl in the desert'.

More recently, the European courts rejected the 'smell of ripe strawberries'⁸ on the ground that there is no 'generally accepted international classification of smells' (such as Pantone for colours) that would sufficiently identify the smell.

The Sieckmann decision makes it very difficult, if not impossible, to register a smell as a mark. The previously obtained registrations also face the danger of attack on their validity. This case has been seen as closing the door to smell marks in Europe. At least until a new method is devised to sufficiently identify smells.

Sound marks (*Aural*)

It has been increasingly recognized that sound marks play an important element in branding and corporate advertising. Jingles such as the Nokia ring tone, 'Roar of a lion' used by MGM, and the chime used by NBC, all have distinctive character, and assist in the public clearly identifying the commercial origin.

Like smell marks, sounds are capable of distinguishing the goods and services of one undertaking with those of another⁹. However, unlike smells there are many ways in which a sound may be recorded.

In [*Shield v Kist*](#)¹⁰ the ECJ considered the application for two sound marks:

1. The first nine notes of Beethoven's Für Elise- represented by musical notation; and
2. The crowing of a cock –Represented by an onomatopoeia (KuKelekuuuuu) as well as a verbal description 'The crowing of a cock'

It was held that the seven Sieckmann requirements were satisfied by musical notation if it is 'represented by a staff divided into measures and showing, in particular, a clef, musical notes and rests whose form indicates the relative values and, where necessary, accidentals (sharps, flat, natural)'

However, the Verbal description and onomatopoeia were rejected on the grounds that they lacked clarity and precision¹¹. The courts stated that there was no consistency between the onomatopoeia itself and the actual sound. Also, the perception of it was culturally subjective, for example in English the sound of a cock crowing would be represented as 'cock- a-doodle-do'.

In application made by MGM Lion corp.¹² a sound spectrogram or sonogram adequately represented the 'the roar of a lion' as it depicted pitch, progression overtime and volume.

In the United Kingdom the 'sound of a barking dog' for paints and varnishes has been registered by ICI

It is clear to see that unlike smells, sounds can be represented graphically and are regarded as trademarks worth protecting.

Taste marks (*Gustatory*)

Unlike sound and smell marks, taste marks can only be applied to goods and not services.

In the case of Eli Lilly¹³, an application was made for the '[Taste of strawberries](#)' for pharmaceuticals, and was represented using a verbal description. It was held that not only did the mark lack distinctive character, but the verbal description was not sufficiently precise and did not satisfy the Sieckmann requirements.

In the Benelux countries there have been a few taste marks such the 'taste of liquorice' applied to the Paper Goods and Printed Matter. This was represented using a written description.

However, In light of Sieckmann it seems highly unlikely that a taste mark will be registered in the future.

Summary

The protection of non-conventional marks, particularly those that are non-visual, is still an undeveloped part of intellectual property law. Unlike conventional trade marks, sounds, smells and tastes are usually intrinsic features of products, and it can be argued that such characteristics should not be allowed to be monopolized. It is clear that the tough criteria set in the Sieckmann case prevents such monopolies, and aims to promote the innovative traders who use novel signs to market their products.

Those applicants who, prior to Sieckmann, managed to obtain registration for non-visual marks, will face a tough task in enforcing them. Even though registration provides prima facie evidence of graphical representation and distinctive character, registration alone will not suffice to succeed on a claim for trademark infringement, dilution, or an opposition on its validity.

References

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3. Sherman and Bently, 180-93, see M. Handler and R. Burrell, *Making sense of Trade Mark law* (2003)
4. Community Trade Mark Regulation [EC] No 40/94
5. First Directive 89/104/EEC
6. Sieckmann v. Deutsches Patent- und Markenamt (Case 273/00, 12 December 2002)
7. Vennootschap onder Firma Senta Aromatic's application (1999)
8. Eden's application [CFI T -305/04]
9. provided that they pass the test of CTM test for distinctiveness
10. Shield Mark BV v. Joost Kist, [2004] RPC 17 –ECJ
11. Paragraphs 59 RCJ
12. MGM Lion corp. TM application [2004] ETMR 34
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