# Fragrance As a Trademark

By Dolores T. Kenney, Esq.,
Olson & Hierl, Chicago, Illinois

When you hear the musical note sequence, G, E, C, played on chimes which, for the benefit of readers without musical knowledge, goes "bing bong bing," do you think of a broadcasting company? When you hear the sound of a creaking door, do you think of a particular radio program? When you smell a "high impact, fresh, floral fragrance reminiscent of Plumeria blossoms," do you think of scented sewing thread and embroidery yarn? All of the foregoing intangible, non-visual devices are trademarks.

A trademark, as defined, in part, by the United States Trademark Act "...includes any word, name, symbol or device or any combination thereof..." which identifies or distinguishes the goods of a manufacturer or merchant from those manufactured or sold by others. Symbols and devices can include such things as color, shape, smell, sound or configuration. Sound is a non-visual device that can function as a sound mark. Some familiar sound marks that everyone recognizes include the NBC chimes and the sound of a creaking door that identified the mystery program, "Inner Sanctum."

Like sound, fragrance also is a non-visual device which helps sell products. But unlike sound, no fragrance had been accorded protection as a trademark by the United States Patent and Trademark Office until September 1990, when the Trademark Trial and Appeal Board ruled in favor of Celia Clarke d/b/a Clarke's OSEWEZ.* In that decision, the Board ruled for the first time that fragrance can be capable of serving as a trademark to identify and distinguish certain types of products.

The *Clarke* decision has now added scents to the kinds of intangible sensory subject matter, such as color and sounds, which have qualified for protection under the United States Trademark Act. Although this avenue of protecting fragrances has been opened for the first time, key considerations for registrability require that the aroma characteristics of the fragrance trademark be promoted as a source identifier and not for its scent.

In the *Clarke* case, the applicant offered scented embroidery yarn and threads and placed advertisements stressing the fact that her company was the source of "sweet-scented" embroidery products. The applicant was able to successfully demonstrate to the Court that customers, dealers and distributors had come to recognize her as the source of scented yarns and threads. As a result, her application to register "a high impact, fresh, floral fragrance reminiscent of Plumeria blossoms" for sewing thread and embroidery yarn was granted, thereby reversing the Trademark Examining Attorney's refusal of registration.

In reaching its decision, the *Clarke* Court noted some of the following factors: (1) the applicant was the only person who has marketed yarns and threads with a fragrance; (2) the fragrance was not an inherent attribute or natural characteristic of the applicant's goods, but rather a feature supplied by the applicant; (3) the applicant had emphasized the fragrance characteristic in advertising her goods in advertisements and at craft fairs; and (4) that, because of the unique nature of the applicant's product and her promotion of these products as scented, her fragrance mark was prima facie distinctive even though she had failed to indicate any specific scent or fragrance in her promotional materials.

The *Clarke* Court, in a footnote, observed that the case did not involve either "...the registrability of scents or fragrances of products which are noted for those features, such as perfumes, colognes or scented household products. Nor...the question of descriptiveness of a term which identifies a particular fragrance of a product." In support of its latter observation, the Court cited another decision** which held the mark APPLE PIE to be unregisterable as merely descriptive since the term described the scent released by potpourri simmered in water.

In the past, some of the difficulties with registering intangible trademarks, assuming the intangible mark is properly used as a trademark, lay in satisfying two of the requirements for preparing the trademark application: i.e., the mark must be described by a representational drawing and a specimen must be submitted.

Drawings are incorporated into the search room records of the United States Patent and Trademark Office. Thus,

* In re Clarke, 17 U.S.P.Q.2d 1238 (T.T.A.B. 1990)

** In re Gulay, 820 F.2d 1216, 3 U.S.P.Q.2d 1009 (Fed. Cir. 1987)


0272-2666/91/0004-1101$4.00/00—

one of the problems has been: How to graphically represent a fragrance in a manner that puts the public on notice that it is claimed as a trademark. An analytical spectrum tracing of the fragrance may be one approach, but how would a lay person recognize the scent portrayed in the absence of some verbal description?

Specimens showing how a mark is used also become a permanent part of the applicant's file and the public record. However, the United States Patent and Trademark Office is not presently equipped to be a depository for bottles of fragrance. Moreover, the shelf life of fragrance characteristics is generally limited.

The *Clarke* applicant was able to overcome the drawing requirement by a verbal description of the fragrance and satisfied the specimen requirement by submitting a complete sealed kit containing scented yarn and thread for making a "scented skunk" embroidery. However, in another footnote observation, the Court remarked: "Although advances are continually being made in Office operations and practices, the era of 'scratch and sniff' registrations is not yet upon us."

The *Clarke* Court clearly has indicated that fragrances which function inherently as perfumes would not be given trademark status. But equally clear is the Court's message that a fragrance, properly promoted as a source identifier for a non-perfume product, can function as a trademark. Unfortunately, some scents, such as pine and lemon for cleansers, have been so commonly used that they may no longer be capable of functioning as a source identifier or of distinguishing between such scented household products. Worse yet, the source of some scents, like pine oil, may even be considered generically functional for disinfectants. Generic usage can never be accorded trademark protection.

Perhaps now is the time for the fragrance industry to develop a layman's description of fragrances which would be readily recognizable to the lay public. Under the current trademark laws, a mark need not be used before filing for registration of a trademark. Applications now can be filed based on a bona fide intention to use the mark in commerce. This raises the possibility of filing an application to register a trademark while a product is still in the pre-sale market planning stages. Where the fragrance is key to distinguishing your non-perfume product from other products, promotional materials can be revised and designed to ensure that the fragrance and its proposed usage is properly promoted to function as a fragrance mark. All this can be going on while the intent-to-use application is pending.

Perhaps you or your clients should ask your trademark attorney to do an intellectual property audit of your inventory of product ideas for potentially protectable fragrance marks. The next time your customer smells your product, will they think of you?

**Reference**

Address correspondence to Dolores Kenney, Esq., Olson & Hierl, 20 North Wacker Drive, Suite 3000, Chicago, IL 60606.