

March 2018

Future Development for Olfactory Marks in Malaysia

Olfactory marks have become part of commerce and advertising, but they continue to struggle to find a place in the current Malaysia trade mark systems. Under the current trade mark landscape in Malaysia, neither sounds nor smell is registrable as they have to be graphically represented.

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Nonetheless, the game may change. Impending accession to the Madrid Protocol, Malaysia may make amendments to the Trade Marks Act 1976 which, among others, would enable the registration of "sound, smell and colours". Whilst anticipating such legislation to be tabled, it is important to understand the commercial value of olfactory marks, and the practical implications to the inherent nature of the olfactory marks.

Commercial Value

Increasingly more businesses are capitalising on olfactory memory to further enhance their advertising and promotional activities. As nicely put forward in *Eden SARL*¹:

"[T]he olfactory memory is probably the most reliable memory that humans possess, and that, consequently, economic operators have a clear interest in using olfactory signs to identify the goods."

In order to protect their commercial interests, business owners seek to register scent as trade marks. Nonetheless, since the first registered olfactory mark in the US in year 1990, successful registrations are few and far between. Examples of registered olfactory marks include:


- (a) eucalyptus smell of golf tees in Australia²;
- (b) strong smell of bitter beer applied to flights for darts in the United Kingdom³;
- (c) flowery musk scent for Verizon in the United States⁴; and
- (d) smell of freshly-cut grass of tennis balls in the European Union⁵

There are several practical implications inherent to the nature of olfactory marks which may deter the registration as trade marks.

Graphical Representation

Scent is invisible to the human eye, which is contrary to the requirement of graphical representation of a registrable mark⁶. In fact, most of the marks are not sufficiently described so the average customer is unable to distinguish the olfactory mark from the other scent⁷.



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- (a) **Verbal Description:** Most registered olfactory marks are graphically represented through verbal description (as above), yet many other applications were rejected for want of clarity and precision. For example, the description of the scent as "*balsamically fruity with a slight hint of cinnamon*" is not sufficiently clear, precise and objective⁸.
 - (b) **Odour Sample:** Any deposit of an odour sample would not constitute a graphic representation since it is not sufficiently stable or durable. In other words, it would eventually decay over time.
 - (c) **Chemical Formula:** It may serve as a clear and precise manner of recording olfactory mark, especially with current technologies such as gas chromatography and digital scent technology⁹. However, the average consumer would not recognise a chemical formula as representing the actual odour. In addition, the formula does not represent the odour of a substance, but the substance itself. Therefore the chemical formula cannot be regarded as a graphic representation.


Despite the above, it has long been accepted in the scientific community that a particular scent is intrinsically tied to the aroma substance that gives rise to that scent¹⁰, and they vary according to their functional groups, sizes and overall shapes of molecules¹¹. As such, there is a possibility for the chemical formula to serve as a sample of a particular olfactory mark as it enables any person to recreate the mark, thus overcoming the issue of an odour sample decaying over time.

With technological advancement, once a widely accepted identification system is introduced (like the Pantone system for colours), olfactory mark registrations might become a more common occurrence.

Non-Functionality: Identification of the Origin of Products

The scent itself is not capable to be protected as trade mark if it is functional. Such scent is functional if it is essential to the use or purpose of the goods, or, if it affects the cost or quality of the product. Examples for such non-protection include:

- (a) Attempted registration of a mint scent for use in connection with face masks for medical use, for "*such a scent likely makes many unpleasant medical tasks more palatable*."¹²
- (b) Attempted registration of the scent of "*Chanel No. 5*", for the scent of a perfume is the good itself¹³;



Any olfactory marks must satisfy the main purpose of a trade mark, which is to indicate the origins of products and services.¹⁴ The romantic allure of perfumes may be considerable, but any attempt to register these scents would be readily dismissed by the trademark registrar.



Conclusion

After 15 years from *Ralf Sieckmenn*, it is interesting to see the future development for registration of olfactory marks. The nature and type of procedural changes that will be implemented in Malaysia are highly anticipated, as it will undoubtedly transform the trade mark landscape in Malaysia.

¹ Case T305-04 *Eden SARL v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* [2005] ECR II-4705 (Court of First Instance, CJEU)

² IP Australia, "Other types of trade marks" (IP Australia, 12 March 2016) <<https://www.ipaustralia.gov.au/trade-marks/understanding-trade-marks/types-of-trade-marks/other-types-trade-marks>> accessed on 28 February 2018.

³ UKIPO, Trade mark number UK00002000234 <<https://trademarks.ipo.gov.uk/ipo-tmcase/page/Results/1/UK00002000234>> accessed on 28 February 2018.

⁴ USPTO, US Registration Number 4618936 <http://tsdr.uspto.gov/#caseNumber=86122975&caseType=SERIAL_NO&searchType=statusSearch> accessed on 28 February 2018.

⁵ Case R 156/1998-2 *Vennootschap onder Firma Senta Aromatic Marketing's Application* [1999] ETMR 429

⁶ Teo Boon Kwang, *Trade Mark Law and Practice in Malaysia* (Butterworth Asia 2001), pp. 53 - 54

⁷ Onur Sahin, "The past, the present and the future of colour and smell marks" [2016] 38(8) EIPR 504 - 516.

⁸ Case C-273/00 *Ralf Sieckmann v Deutsches Patent - und Markenamt* [2002] ECR I-11739

⁹ Cristina Hernandez-Marti Perez, "The possibility of IP protection for smell" [2014] 36(10) EIPR 665 - 674

¹⁰ Hans-Dieter Belitz et al, *Food Chemistry* (4th ed, Springer 2009), pp. 340 - 402

¹¹ <<http://www.scienceinschool.org/2007/issue6/scents>> accessed on 25 March 2018.

¹² USPTO, US Serial Number 78483234 <http://tsdr.uspto.gov/#caseNumber=78483234&caseSearchType=US_APPLICATION&caseType=DEFAULT&searchType=statusSearch> accessed on 13 March 2018.

¹³ C. Benson, "Can a smell be registered as a trade mark?" IHL 2001, p. 64

¹⁴ Section 3 of the Trade Marks Act 1976

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