

The olfactory brands in the legal business world: Reference to Comparative Law

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Nowadays, the high competitiveness of the market has encouraged businessmen to use all available technical progress to the implementation and evolution of a product, therefore this process is generally accompanied by enormous efforts of research and development. However, positioning a product or service in the market does not only depend on its inner characteristics, but consumer's loyalty must be achieved, for which the use of all kinds of incentive is required to attract their attention. That is why the unconventional signals are constituted¹, as new forms of product differentiation, because "traditionally, in the field of distinctive signs, the differentiation of products or services in the market has been made through the use of signs or media of a visual or auditory nature, nevertheless, more and more entrepreneurs and experts in marketing appreciate the enormous potential of other signs perceptible by senses other than sight or hearing, particularly smells that stand out for their enormous power of remembrance²."

OLIVENCIA Corinne, expert from the Office for Harmonization in the Internal Market (OHIM) of Europe says: "It is said that olfactory memories are among the most evocative, and the manufacturers are increasingly interested in us associating their products with pleasant aromas".³

On the other hand, for an aroma to fulfill the function of a brand, the consumer must identify the product through the olfactory sign, even when having to compare it with other products offered. Also, the consumer must be able to associate it with a specific business origin.

The samples of olfactory marks in the commercial world are varied, for example: *Singapore Airlines* uses a unique fragrance with an exotic touch, becoming part of their identity and contributing in creating a more pleasant experience for the traveler.

A brand that is already using olfactory marketing successfully is the fashion firm *Abercrombie & Fitch*. Their header fragrance, *Fierce*, is always present in all the stores of the brand. *Fierce* it is a strong and daring aroma that connects with younger consumers. As a result, *Fierce* is one of the best-selling fragrances in the United States and in Europe among the adolescent audience.

¹ Non-traditional or new brands 1.The International Trademarks Association (INTA) establishes a double classification: main non-traditional brands referring to the appearance of the product, service or its container and shape of the product or its container, and more unusual brands within non-traditional ones, including here the sounds smells, taste and touch. There are other brands such as those formed by a single color, the three-dimensional, moving images or holograms that although they reach the consumer through their eyes are considered non-traditional.

² Vid. Hernández Alfaro, Mati, "New products and olfactory brands", in <http://www.registrodemarcas.com>, consulted on January 4, 2013.

³ Query by email made to Olivencia Corinne, expert of the OHIM on March 4, 2013.

Para *Sumitomo Rubber, Co.* the floral fragrance record used in tires was approved in the United Kingdom, and *Unicorn Products* had the same luck when they registered the smell of beer that spreads by throwing a dart in Niza's 28 class.

Also famous is *the smell of fresh cut grass* for tennis balls and the scent of raspberry for fuel products which we will make reference in subsequent epigraph.

Bankinter, the sixth largest commercial bank in Spain, already uses the smell as mean of differentiating its services, and it is the first bank in the world that has made the leap towards aromatic marketing, for this, they have created their own fragrance, which consists of "the smell of orange with a jasmine aftertaste". This fragrance is used as a hallmark of the bank in different supports that identify it, from the headquarters and offices thereof, even the stationery used in communications being addressed to customers.

From the above we can say the olfactory brands have come to stay and leave their undying mark in the world of Industrial Property, since as the Mexican lawyer OLAMENDI expressed: "The future smells of fresh grass".⁴

In that sense, it is valid to refer to the technical-comparative analysis of the registration capacity of olfactory marks in foreign legislations.

The Paris Convention in its article 6.1 says what: "The determination of the conditions of deposit and registration of trademarks will be left to the discretion of national laws.

Also, ADPIC in their article 15.1 leaves this particular in the hands of domestic laws.⁵

The Singapore Treaty of 2006⁶ states that marks consisting of signs are protectable if they can be registered as trademarks in accordance with their laws, falling responsibility in national legislations once again.

The Regulation 40/94 of the **European Community** does not consider them, although its acceptance could be presumed as long as they can be represented graphically, by saying in their Article 4 that all the signs that can be object of a graphic representation may constitute Community trademarks.

The US Office (USPTO), requires for olfactory brand applications an adequate description of the brand. Due to the absence of a clear definition of what is considered by the USPTO as a graphic representation of a smell, the applicants have assumed as an equivalent their precise verbal description.

Besides, according to the usual practice in that country, the required element in these types of brands is the consumer must experience the smell of the brand at the point of sale.⁷

⁴ Vid. OLAMENDI, Gabriel, *op.cit.*p.2.

⁵ "A trademark or combination of signs capable of distinguishing the goods or services of a company from those of other companies may constitute a trademark or brand. Such signs may be registered as trademarks or brands, in particular the words, including people's names, letters, numbers, figurative elements and the combinations of colors, as well as any combination of these signs. When the signs are not intrinsically capable of distinguishing relevant goods or services, the Members may make the possibility of registering them subject to the distinctive character they have acquired through their use. Members may require as a condition of registration that the signs be visually perceptible".

⁶ The Singapore Treaty on the Law of Trademarks was adopted in March 2006 at a diplomatic conference that brought together 147 member States of WIPO in Singapore. Without establishing an international obligation to register and protect non-traditional trademarks, the Treaty establishes a multilateral framework for the definition of criteria on how holograms, animated trademarks, color marks and position marks should be reproduced in trademark applications and trademark registrations, and marks consisting of non-visible signs. The Singapore Treaty entered into force on March 16, 2009.

⁷ Report adopted by the Committee of the OMPI, SCT/18/10.

On the other hand, in the **United Kingdom, New Zealand and Australia**, countries members of the British Commonwealth, it is understood that the ability of an aroma to distinguish the goods or services of an olfactory brand is evaluated using the same criteria as in the case of any other brand, that means, determining if other merchants would want or legitimately need to use the aroma in the normal course of their commercial activity.

So, if we go back to Latin America, we should start by quoting Directive 486 of 2000, instrument that in matters of trademark applies to the Andean Community (CAN). The previous norm in its article 134 refers to the signs that may constitute trademark and clearly indicates the protection of olfactory trademarks.

From Reading Article 134 of the above mentioned norm we deduce the general requirements established for all brands are applicable to olfactory signs, hence, it is prudent to mention them:

- 1) Distinctiveness
- 2) Perceptibility
- 3) Susceptibility of graphic representation

Now, when it comes to adapting these general requirements to olfactory brands, starting with the distinctiveness, we must stick to the specific case, that means, it will be the positioning of the olfactory brand that is intended to be registered, which will allow establishing whether it meets this requirement.

Regarding perceptibility, we have the opinion of GODOY PÉREZ: "Perceptibility is not limited, because nowhere in the law it says, to be visually perceptible. It means it has to be perceptible by the senses and assimilated by intelligence. Nothing prevents for such perceptibility to be done then, by the sense of smell".⁸

About the graphic representation of olfactory brands, GODOY PÉREZ says: "It is not enough any graphic representation, if it does not meet two conditions. The first, that is complete, clear and precise, so that it is clearly know, what exclusively protects. The second, that is intelligible for those who may be interested in consulting the registry, which are other producers and consumers".⁹

Reviewing the Law of Trademarks and Other Distinctive Signs of **Nicaragua** of April 16, 2001, we notice a greater protection of non-traditional brands, expressly in Article 3, where it establishes the registration of sound, three-dimensional, color, slogans, advertising phrases and other perceptible signs. That opens a broad spectrum by using the perceptible term, since it offers the possibility of valuing the protection of olfactory, gustatory, gestural and tactile brands among others.

Following the same examination path, we have the legislation of **El Salvador**, which can be considered more advanced in the protection of non-traditional brands, because in its Article 4 it establishes within the signs that can constitute a trademark: sound marks, olfactory marks, three-dimensional marks and colored marks.

The Trademark Law 22.362 of **Argentina** from January 2, 1981, although it does not make explicit reference to so-called olfactory marks: fragrances, scents or smells, it allows a broad interpretation of the registration of distinctive signs, by stating in Article 1 that it may be considered a brand: "one or more words with or without conceptual content; the drawings; the emblems; the monograms; the engravings; the prints; seals; the images; the bands; the combinations of colors applied in a specific

⁸ Vid. GODOY PÉREZ, Juan Manuel, "The olfactory and auditory marks from the normative regulation of the Andean Community", en <http://www.uned.ac.cr>, consulted on December 21, 2012.

⁹ *Idem*

place of the products or of the containers; the wrappers; the containers; the combinations of letters and numbers; the letters and numbers for their special drawing; advertising phrases, reliefs with distinctive capacity and any other sign with such capacity”.

It turns out that in praxis the first olfactory trademark registration in Latin America took place in Argentina, granted to the French company L'Oréal, which in November 1997 had filed six trademark applications, claiming rights over six different fragrances applied to packaging for hair products.

In Brazil, the National Institute of Industrial Property understands that trademarks are registrable in so far as they are visually perceptible, therefore the Brazilian Law 9.279 of the Industrial Property of May 14, 1996 does not protect the gustatory, olfactory and sound signs.

On the other hand, the World Intellectual Property Organization (WIPO), regarding the conditions for registration and the scope of the protection of non-conventional trademarks, resolved to promote that an odor may be susceptible to registration as a trademark and an olfactory trademark must be represented by means that describe or reproduce the odor unequivocally. Also, it was proposed that trademark offices should cooperate to harmonize and promote effective non-conventional brand representation methods.

After the study conducted we can conclude there is currently consensus at the level of Comparative Law, about the reception of olfactory brands, but its specific treatment is heterogeneous, while in the Common Law there is no requirement at all regarding its graphic representation, in community law this requirement has been made mandatory, restricting in particular the possibility of access to the registration of such signs.

Finally, due to the above, we have chosen a phrase from the Advocate General at the European Court of Justice Ruiz-Jarabo Colomer: “(...) *the abstract suitability of the signs that are apprehended by the sense of smell to fulfill a representative function is beyond dispute. If you want to symbolize the products or services of a certain origin, to distinguish them from those that have a different origin; if it is a matter of recalling a concrete lineage, a quality, a business reputation, it is best to go to a sense that, like the sense of smell, has undeniable, even persuasive evocative qualities*”.

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