

Vanilla with cherry overtones: Pursuing a nontraditional trademark

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Smell is the most evocative of senses.

Marcel Proust famously was inspired by the “episode of the madeleine” to write a sweeping seven-volume memoir, his master work, which nobody has ever finished reading.¹

Real estate agents recommend baking chocolate-chip cookies in houses open to potential purchasers. Cookies in the oven, and in particular their vanilla note, evoke feelings of home, the holidays, happiness and comfort.

Researchers have found that men are more attracted to the smell of bacon than many commercially sold — and far more expensive — scents.

Why are we discussing vanilla, bacon and French pastries?

Trademarks are at heart about how people discern where things they buy come from. How they feel about these goods and services, we call “goodwill.” The practice of trademark law is really about what people associate with what their senses perceive.

Does that sensation evoke a particular company’s goods or services? If the scent of cookies can evoke grandma’s kitchen and the freedom of childhood, then why not the scent of Play-Doh?

A flurry of writing has greeted the Patent and Trademark Office’s recent issuance of a registration for Play-Doh’s “sweet, slightly musky, vanilla fragrance.” In fact, the trademark examiner’s decision in that case flowed naturally from prior cases addressing the distinctive source-identifying capacity of what are called nontraditional trademarks.

In the United States there is no set form of a trademark; so long as it may be perceived by a consumer and associated with a product or service, anything goes. The Supreme Court confirmed this in *Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159 (1995), when it interpreted Section 45 of the Lanham Act, 15 U.S.C.A. § 1127, as permissive rather than restrictive.

And Hasbro Inc.’s application regarding Play-Doh was not the first to try at registering a scent mark. The first such trademark recognized by the PTO covered “high impact, fresh, floral fragrance reminiscent of Plumeria blossoms” for thread and yarn.²

Others followed. Among them are the bubble gum smell of Grendene jelly sandals,³ a piña colada scent for ukuleles⁴ and the “flowery musk” scent of a Verizon store.⁵ Successful registrations, however, are the exception.

The challenge, and what makes nontraditional marks so much more difficult to register than standard word or symbol marks, is establishing that the asserted trademark is capable of identifying source — that it is distinctive and not simply a functional aspect of the product.

Ironically, the product most famed for scent — perfume — cannot rely on trademark protection for those scents. This is because for perfumes, scent is entirely functional.

To take a nonperfume example, a pharmaceutical company failed to obtain registration for the scent and flavor of peppermint for a medical nitroglycerin spray where prosecution revealed that the peppermint actually made the spray more medically effective — a death sentence for the claim of distinctiveness.⁶

PLAY-DOH’S JOURNEY

Play-Doh launched in 1956 and is now the child’s modeling compound of choice in the United States. If you want to compete, it is the one to copy.

Some of us have even combined the smell experience of the product with the taste experience.

In February 2017 Hasbro filed to register its “non-visual Play-Doh scent mark” as a trademark for toy modeling compounds.

Anticipating that distinctiveness would be an issue for such an ordinarily functional property as product smell, Hasbro asserted acquired distinctiveness based on more than five years’ use of the fragrance.

The examiner initially refused to register the mark on the basis that five years was not sufficient to establish distinctiveness where there was no evidence that the smell was anything more than a “nondistinctive feature of the product’s design.”

Many companies scent their modeling products in various ways, the examiner correctly noted. The scent must be presumed to be functional.

In an act of charitable clarity, the examiner laid out a lovely evidentiary road map in the form of 15 questions that called for the sorts of evidence that would make or break Hasbro's case for distinctiveness.

Among the evidence and information invited were:

- Promotional materials referencing the scent.
- Information about the scent of other modeling compounds.
- Information about alternative compositions available for the ingredients in the scent.
- Information about whether such alternative compositions – if any – were equally efficient or competitive.
- Data about whether the ingredients in the scent were naturally occurring in Play-Doh or added.
- An explanation of any functional advantages of the scent over other scents, such as whether the scent's ingredients made the product stay moist longer, hold color better, improve the texture, or improve pliability.
- Information regarding whether the scent was an artifact of the use of wheat or other ingredients in the compound.
- Evidence showing whether all the colors had the scent.

Hasbro responded by molding a mountain of evidence in its attempt to convince the PTO of the scent's distinctiveness.

"More than 3 billion cans" of Play-Doh, Hasbro noted, had been "squished and squashed" since 1956, and the product has been scented consistently for more than 60 years.

Hasbro provided evidence about other products' fragrances, both to show that Play-Doh's scent is unique and to show that scents are not purely functional in the market but instead are used to distinguish these products.

Hasbro also provided declarations showing the history and advertising that had made Play-Doh's scent famous, such as its "Stop and Smell the Play-Doh" advertising campaign.

It also pointed out that in total it has spent billions to advertise and sell Play-Doh, and it emphasized the product's significant social media and internet presence.

Hasbro noted Play-Doh's induction into the Toy Hall of Fame. The New York Times had run articles about Play-Doh. It further noted that trademark experts have written blog pieces and articles attesting to Play-Doh's scent as famous and iconic.

In response to specific questions, Hasbro provided the PTO various jars of actual modeling compound so the examiner could smell them all.

A declaration established for the PTO that the scent ingredients had no functional impact on the product, such as to increase shelf-life or improve color.

As Hasbro acknowledged, the smell of wheat is present in the product. But it said that smell combines with other distinctive scent additions to create the asserted trademark scent we all know.

The rest is history: On May 15 the PTO granted Hasbro's request and issued a trademark covering "a scent of a sweet, slightly musky, vanilla fragrance, with slight overtones of cherry, combined with the smell of a salted, wheat-based dough."⁷

SCENT MARKS ARE A SUBSET OF NONTRADITIONAL MARKS

Scent marks are a subset of what have come to be called "nontraditional marks," a catchall phrase for any trademark that is not a word, symbol or design.

In light of *Qualitex*, there is no reason why almost anything detectable to human senses cannot serve as a trademark.

With varied success, trademark owners have forged ahead with applications to register scents and other nontraditional marks, including sound, flavor, product packaging or shape, motion marks and even texture.

Tiffany's robin's-egg blue, Homer Simpson's cry of "D'oh!," ING's bouncing orange ball, the texture of leather and even a restaurant design featuring goats eating grass on a rooftop have all been registered as trademarks.

Failures are much more common. Harley-Davidson poured untold time and resources into an attempt to register its engine sound, which the company said sounded like "potato-potato-potato."

Drug manufacturers have tried to register an orange flavor for antidepressants and, in a separate case, a peppermint flavor and scent for a heart medication.

The orange flavor, it turned out, improved patient compliance in taking their medication, and the peppermint chemicals made the heart medication more effective.

In other words, in both cases, the flavor was merely functional and thus not entitled to trademark protection.

WHAT DOES THIS ALL MEAN FOR NONTRADITIONAL MARKS?

What makes the Play-Doh story so useful is that it emerges from the simple prosecution "conversation" between applicant and examiner.

The result is not a court ruling on legal principles that we must plumb for practical advice but instead a toolbox for handling applications for nontraditional marks.

While we expect that fragrance marks will continue to be rarely granted, the prosecution of Hasbro's registration is a gift to practitioners.

It sets forth a comprehensive list of questions upon which an applicant can lay the groundwork for creating and later registering a nontraditional trademark such as a scent mark.

So what can we learn from it?

First, nontraditional trademark registration continues to be difficult and expensive. Companies should be aware of the opportunity to create distinctive marks outside of the traditional word and symbol space and be intentional in doing so.

They should not waste money and resources trying to assert elements common to the products and services in their market or that serve a function for the product or service.

Instead, advocates should guide them to consider what competitors are doing and think about ways to stand out.

A good time to contemplate these issues is during a regular audit of a company's branding.

Here, lawyers can educate marketing staff on the selection of and support for nontraditional marks, both to help them recognize when the company has already created one over the years, and how to go about creating new ones.

We learned from Hasbro's efforts what sort of information and evidence the PTO will expect to see for an applicant to clear the high hurdle of establishing distinctiveness and nonfunctionality for scent and other nontraditional marks.

To show distinctiveness, you will probably need to exceed the basic expectation of advertising figures and sales numbers. Your client should be thinking from the outset about who will tell and what evidence will support the story of distinctiveness and nonfunctionality.

Anticipate the need to address questions about whether a chosen trademark serves a functional purpose for the goods or services.

Evidence that an applicant advertised an asserted trademark as serving a competitive function for the product will be problematic. For instance, an ad might claim a chocolate flavor makes children glad to take their vitamins.

A mark must be clearly defined and consistently used so that it creates the desired association in the mind of consumers.

Lawyers should encourage clients to consider what competitors are doing and not waste resources asserting rights in a common feature of a product in the market, such as a fruit flavor for lip balm.

Successful product colors, for example, will quickly be adopted by competitors. Clients will need to consider whether they are prepared for the effort and expense of enforcement so that they will be able to say they are the only ones using a certain sound, color or texture.

Although nontraditional mark registrations are difficult to obtain and protect, a mark that survives examination and enforcement will likely be a valuable part of a company's portfolio — something highly evocative for consumers and often one that, like Nokia's famous ringtone or the color of a Tiffany jewelry box, becomes embedded in U.S. culture.

NOTES

¹ MARCEL PROUST, À LA RECHERCHE DU TEMPS PERDU (1927).

² *In re Clarke*, No. 758,429, 1990 WL 354572 (T.T.A.B. Sept. 19, 1990).

³ Scent Mark, Registration No. 4,754,435.

⁴ Non-Visual "Tropical Scent" Mark, Registration No. 4,144,511.

⁵ Scent Mark, Registration No. 4,618,936.

⁶ See *In re Pohl-Boskamp GmbH & Co. KG*, Nos. 85007428 and 85008626, 2013 WL 1234849 (T.T.A.B. Feb. 25, 2013).

⁷ Non-Visual Play-Doh Scent Mark, Registration No. 5,467,089.

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