

# Saint Louis University Public Law Review

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Volume 20  
Number 2 *Intellectual Property: Policy  
Considerations From a Practitioner's  
Perspective (Volume XX, No. 2)*

Article 5

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2001

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### Recommended Citation

Churovich, Douglas D. (2001) "Scents, Sense or Cents?; Something Stinks in the Lanham Act," *Saint Louis University Public Law Review*: Vol. 20 : No. 2 , Article 5.

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## SCENTS, SENSE OR CENTS?; SOMETHING STINKS IN THE LANHAM ACT

### SCIENTIFIC OBSTACLES TO SCENT MARKS

DOUGLAS D. CHUROVICH\*

It might well be true, as Shakespeare has suggested, that a rose by any other name would smell as sweet.<sup>1</sup> Yet does it necessarily follow that a rose by any other name would point to source? Evidently so, if the rose is instead plumeria blossoms. Reasoning that the Trademark Act of 1946 (the “Lanham Act”) was intended to liberalize trademark law, and relying upon favorable comparisons between scents and both colors and sounds (both having already been granted trademark status), in 1990, the Trademark Trial and Appeal Board in *In re Clarke* reviewed and approved an application to protect the “fresh scent of plumeria blossoms,” over the rejection of the Trademark Examiner.<sup>2</sup> To-date, no federal court has directly addressed the appropriateness of designating or recognizing scents *per se* as trademarks.<sup>3</sup>

However, an exploration of osphresiology,<sup>4</sup> the science of smells, reveals dramatic distinctions between the properties of scents and the properties of both colors and sounds that frustrate the implementation and use of scents as trademarks, and thereby undermine *In re Clarke*. In the context of trademark use, these properties create overwhelming obstacles to trademark enforcement and present substantial administrative difficulties, while offering trademarks with very little real commercial benefit. Consequently, as will be shown, the landmark *In re Clarke* decision was ill-advised since it was founded upon a

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1. During the famous balcony scene in *Romeo and Juliet*, Juliet cries, “What’s in a name? That which we call a rose, by any other name would smell as sweet.” WILLIAM SHAKESPEARE, *ROMEO AND JULIET*, act 2, sc. 2.

2. *In re Clarke*, 17 U.S.P.Q.2d 1238, 1239 (T.T.A.B. 1990).

3. In *Qualitex Co. v. Jacobson Products Co.*, the Supreme Court examined the issue of color marks, and without direct comment referred to the *In re Clarke* decision as an example of existent non-traditional trademarks. 514 U.S. 159, 162 (1995).

4. See CULTIVATION AND UTILIZATION OF AROMATIC PLANTS 815 (C.K. Atal & B.M. Kapur eds., 1989), available at <http://www.vedamsbooks.com/no9168.htm> (last visited June 11, 2001).

poor, if not non-existent, understanding of osphresiology and the misguided application of legal principles that fail to apply to scents. Simply put, scents should not be afforded the status or protections of trademarks under the Lanham Act.

## I. INTRODUCTION

### A. *Questions In The Air*

Could a retailer, under the Lanham Act, be enjoined from placing one manufacturer's scented yarn on a shelf next to another manufacturer's packaged pouporri? Or for that matter, next to cigars or cigarettes? Could the same retailer be restricted from eating a limburger cheese sandwich in the vicinity of a display containing that same yarn? Would employees, handling and selling the yarn, be forced to wear unscented deodorants and perfumes? Now that a trademark has been registered for a fragrance added by a manufacturer to her yarn, any or all of these situations could conceivably violate the misrepresentation provisions of the Lanham Act.<sup>5</sup> Yet, as unreasonable as these scenarios may appear, each is only further complicated when multiple products and scent marks are present.

Of course, even in this simple example, each of the scenarios raises one or more significant trademark issue, such as infringement (is one product's scent too similar to another's, even if on entirely different goods?); depletion (are all the "best" scents already taken?); dilution (which and how many scent marks can be brought to a specific market without weakening a competing strong mark?); federal guidelines for labeling laws (is the labeling invalid when a scent mark loses its potency?); and unfair competition (can one scent mark legally mask, overpower, or interfere with another?). Clearly, an unlimited number of scenarios can be imagined which could lead to these and other legal questions the Lanham Act is not equipped to resolve.

Perhaps these fictitious scenarios are exaggerated; perhaps not. The following exploration of the unique nature of scents and their relation to protection as trademarks will reveal how such claims may not be beyond the realm of possibility or reason, and how underlying fundamental assimilation problems reasonably justify a refusal to extend trademark protection to scents.

### B. *In re Clarke: Quite a Yarn.*

In the landmark case *In re Clarke*, an applicant, Celia Clark d/b/a Clarke's OSEWEZ, filed for trademark protection for a scent having the following description: "The mark is a high impact, fresh, flora fragrance reminiscent of

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5. Lanham Act § 45, 15 U.S.C. § 1127 (1989).

Plumeria blossoms,” for “sewing thread and embroidery yarn.”<sup>6</sup> The Trademark Examiner refused registration, initially based on two criteria: (1) “the scent does not function as a trademark because it does not identify or distinguish applicant’s good from those of others”; and (2) the scent is *de jure* functional.<sup>7</sup> On appeal to the Trademark Trial and Appeal Board, the Examiner dropped the second basis and only argued the first.<sup>8</sup> It is significant to note that the Examiner’s *de jure* functionality argument posited that the scent should not be granted trademark protection “because of the competitive need for free access to pleasant scents or fragrances.”<sup>9</sup> Accordingly, the Board merely discussed the associative link between the applicant’s particular scent and her product, and did not even address the question of the adverse impact on competitiveness the registration of a scent mark would cause.

Ms. Clarke presented an affidavit to argue that, to her knowledge, her products were the only yarns and threads on the market that were scented, and that she had advertised the fact that her products were scented.<sup>10</sup> Ms. Clarke further asserted that her customers favorably associate her products with the plumeria blossom scent and that her scent was distinctive because it was not otherwise associated with thread and yarn, and because competitors could use other scents, “such as that of a lily of the valley, a carnation or a rose.”<sup>11</sup> Apparently relying on the *Owens-Corning* decision, Ms. Clarke then continued to compare scents to colors, and in particular, pink fiberglass insulation.<sup>12</sup> The Examiner, likewise, relied upon a comparison between scents and colors as the basis of argument, and went so far as to concede that there is no “inherent bar” to registering scent trademarks.<sup>13</sup> Furthermore, the Examiner conceded (erroneously, as the reader will learn later in this commentary) that “if applicant’s scent does function to indicate origin, potential consumers may readily be able to distinguish among the vast array of scents in identifying competing sources of goods.”<sup>14</sup>

Instead, the Examiner merely argued that scents are not the type of feature consumers typically use to associate with the source of a product, and that Ms. Clarke had not “specifically promoted the *particular* scent as an indication of origin.”<sup>15</sup> Owing to the evidence in Ms. Clarke’s affidavit, uncontroverted by

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6. *In re Clarke*, 17 U.S.P.Q.2d at 1238 (Ms. Clarke’s Application No. 758,429 was filed on Oct. 18, 1988).

7. *Id.*

8. *Id.*

9. *Id.*

10. *In re Clarke*, 17 U.S.P.Q.2d at 1238.

11. *Id.* at 1239 (quoting Applicant’s brief at p.13).

12. *Id.*

13. *Id.*

14. *Id.*

15. *In re Clarke*, 17 U.S.P.Q.2d at 1239 (emphasis in original).

the Examiner, the Board rejected the Examiner's arguments, finding that the scent did serve to identify source and that Ms. Clarke had established a *prima facie* case of distinctiveness for the scent.<sup>16</sup> The Board reversed the Examiner's refusal to register.<sup>17</sup> No further appeal has been taken.

### C. *The Underlying Purpose Of The Lanham Act*

#### 1. Realization

In recommending passage of the Lanham Act, the Senate Committee on Patents identified two fundamental goals underlying any trademark legislation; first, the public must be protected from confusion among products in commerce, and second, the goodwill of manufacturers and merchants must be protected.<sup>18</sup> To all parties in a bona fide transaction, these goals underscore the importance of conveying accurate and reliable product source information from seller to purchaser. However, prior to enactment of the Lanham Act, conflicts among existing state and federal unfair competition statutes, coupled with restrictive court interpretations contrary to consumer protection and evolving business demands severely hampered success in obtaining these legislative goals.<sup>19</sup> Moving beyond the Trademark Act of 1905, the drafters of the Lanham Act sought to liberalize and expand existing trademark protection in order to keep pace with modern business practices.<sup>20</sup> Yet the legislation had to maintain a balance between the two conflicting interests of protecting both consumers and business good will, while limiting interference with legitimate competition.

#### 2. Liberalization

A liberal approach to trademark legislation, as envisioned by the Senate Committee on Patents, was adopted, and incorporated directly into the sweeping language of the Lanham Act.<sup>21</sup> Accordingly, the statute defines a trademark in broad terms, as "any word, symbol, or device of any combination thereof [which a manufacturer or a merchant uses] to identify and distinguish his or her goods . . . from those manufactured or sold by another . . ."<sup>22</sup> Drafted in 1946, the definition's plain language provided an umbrella of protection for virtually all traditional trademarks recognized in the time period, including product names, logo's, and identification tags. Notably, scents were

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16. *Id.* at 1239-40.

17. *Id.* at 1240.

18. S. REP. NO. 1333, pt. 1, at 4 (1946), *reprinted in* 1946 U.S.C.C.A.N. 1274.

19. *Id.* at 3.

20. *Id.*

21. Lanham Act, *supra* note 5.

22. *Id.*

not specifically named as potential trademarks in the Lanham Act definition, and until the *In re Clarke* decision, were not favored with protection.

However, just as changes in business practices created a demand for better protection that ultimately lead to the Lanham Act, new and emerging marketing demands have since pushed for even more liberal interpretation of the terms within the Act that define a trademark. One indication has been the recent approval, in the famous *Owens-Corning* decision, of trademark protection for color *per se* in which the Court stated, “The purpose of the Lanham Act was the modernization of trademark law, to facilitate commerce and to protect the consumer.”<sup>23</sup> Building upon, and perhaps encouraged by the *Owens-Corning* decision, the Trademark Review Commission of the United States Trademark Association, on reviewing the Lanham Act in 1987 declared that the terms “symbol, or device” should be read “expansively” and should not in themselves preclude the registration of, *inter alia*, “smells.”<sup>24</sup> Thus, through an evolution of judicial statutory interpretation, and the Trademark Commission’s expansive interpretation, scents (a.k.a. “smells”) *per se* can now obtain trademark protection. Unfortunately such protection only frustrates the intent behind such liberalization.

### 3. Modernization v. Monopolization

A delicate balance was struck in the Lanham Act to both cope with evolving business needs and protect the consumer from confusion while warding off the potential for “fostering hateful monopolies.”<sup>25</sup> In promoting liberalization, the Senate Committee on Patents argued that trademarks do not truly grant limited monopoly rights to owners, but rather enhance commerce by aiding consumers in the purchase selection process.<sup>26</sup> So stated, the fundamental intent of trademarks, to promote the dissemination of accurate source information to the relevant segment of the public, doubtless rings true and will encounter few detractors for the vast majority of trademarks.

However, in attempting to keep pace with market demands, the Lanham Act, as expanded by the Trademark Review Commission’s interpretation, severely strains the boundaries of the trademark protection envelope. In so doing, it threatens to overreach the basic intent behind trademarks and threatens its own internal balance. When protection is granted for product features that approach the boundaries of the envelope, the distinctions between trademark protection and monopolization begin to blur and the Committee’s argument weakens. When at the boundary itself, even a slight misstep in

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23. *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 1119 (Fed. Cir. 1985).

24. The U.S. Trademark Assoc. Trademark Review Comm. Report and Recommendations to USTA President and Board of Directors, 77 T.M.R. 375, 421 (Sept.-Oct. 1987).

25. S. REP. NO. 1333, *supra* note 18, at 2.

26. *Id.*

interpretation or legal application can inadvertently result in the creation of a monopoly.

4. Consternation

In the case of scents, the boundary has been met and surpassed. The Trademark Review Commission's broad interpretation of the definition of trademarks under the Lanham Act was adopted and incorporated into caselaw by the *In re Clarke* decision, in which the Trademark Trial and Appeal Board utilized the Commission's inclusion of scents as potential trademarks to justify its approval of registering a fragrance added to yarn and thread.<sup>27</sup> One might anticipate, as did Clarke's attorneys, that since the intent of the liberalization of trademark law was to respond to rational needs of evolving business practice, that *In re Clarke* would have opened the floodgates to a wave of registrations for scent-oriented trademarks.<sup>28</sup> Further, that if, as proposed here, scent marks may actually afford the registrant a monopolistic grant, products would soon be enhanced by perfumes and fragrances. However, little commercial interest has been generated by the decision as there have been few scent marks filed,<sup>29</sup>

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27. *In re Clarke*, 17 U.S.P.Q.2d at 1240.

28. Malcolm Gladwell, *Trademark - Picks Up the Scent; Thread's Smell Gets Legal Registration*, WASH. POST, Dec. 4, 1990, at A15.

29. To-date, there have only been ten (10) applications filed for scent marks, by only four (4) separate applicants:

<u>Serial No.</u>	<u>Scent</u>	<u>Goods</u>	<u>Filed</u>	<u>Status</u>
<i>First Applicant</i> 74-720993	cherry	lubricants, fuel and oil additives	Aug 25, 1995	Opposition Pending
75-404020	almond	fuel additives	Dec 11, 1997	Abandoned
75-360106	tutti-frutti	fuel additives	Sept 19, 1997	Abandoned
75-360105	citrus	fuel additives	Sept 19, 1997	Abandoned
75-360103	bubble gum	fuel additives	Sept 19, 1997	Abandoned
75-360104	rape	fuel additives	Sept 19, 1997	Allowed Feb 5, 2001
75-360102	strawberry	fuel additives	Sept 19, 1997	Allowed Feb 14, 2001

and no further opinions have been published regarding scent marks. The solution to this apparent enigma lies in the nature of scents themselves.

## II. OSPHRESIOLOGY AND THE ESSENCE OF SCENTS

Osphresiology<sup>30</sup> is an extremely complex and generally overlooked science that embodies analysis of properties that reach to the very core of trademark protectability for scents under the Lanham Act. Accordingly, before the merits and implications of conferring trademark protection to scents can properly be assessed, the basic elements of osphresiology must be explored and understood.

### A. *Vibration Theory*

The foundation of osphresiology rests upon a concept known as vibration theory. Within this theory exist two principle aspects; first, the creation of a stimulus at a molecular level, and second, the body's method of detecting the stimulus so created.

Virtually all substances, to varying degrees, release molecules possessing excess energy into the atmosphere in an excited state commonly referred to as "gaseous."<sup>31</sup> Bouncing about from atom to atom, this excess molecular energy forces the molecule's chemical bonds, bound by elastic forces, to stretch and distort in a multitude of directions, only to rebound like a rubber band, and thereby create repetitive vibrations.<sup>32</sup> These vibrations are constrained to specific frequency modes determined by the atomic and chemical interrelationships among the atoms in the molecule. Consequently, each molecule creates its own distinct and consistently repeatable pattern of frequencies.<sup>33</sup> Taken as a whole, the vibration patterns are as unique to a molecule type as fingerprints are to humans, and utilizing infrared absorption spectroscopy, a plot, just as unique and representative of each molecule type,

<i>Second Applicant</i> 75-301972	apple	leather bit for animals	June 2, 1997	Pending
<i>Third Applicant</i> 75-120036	lemon	toner cartridges	June 17, 1997	Allowed July 17, 1997
<i>Fourth Applicant</i> 76-079064	bubble gum	lubricants & fuels, chemicals	June 20, 2000	Pending

30. See CULTIVATION AND UTILIZATION OF AROMATIC PLANTS, *supra* note 4.

31. R. H. WRIGHT, THE SENSE OF SMELL 19 (1982).

32. *Id.*

33. *Id.*



can readily be obtained.<sup>34</sup> These vibration patterns can potentially be sensed by any observer near the source.

Situated in the olfactory cavities of the human nose are the sensory organs known as “receptors” that actually detect and sense odors.<sup>35</sup> When a gaseous molecule makes physical contact with one or more of these receptors, a transfer occurs in which the receptor either removes or adds to the molecule’s excess energy level in discrete bundles corresponding to the molecule’s modal vibration frequencies.<sup>36</sup> This vibration energy transfer is then registered as an encoded pattern by the receptor, and the brain cross-references the pattern against its existing database for a potential correlation and identification or, alternatively, for comparison to known scents.<sup>37</sup> The sensory phenomenon known as a “scent” is made up of this entire systematic process encompassed in vibration theory.

The complexity of molecular structures and chemical bonds, and the physics that define their associations, dictate that the energy transfer plots for various scents are at the same time random and discrete.<sup>38</sup> As a result, there exists no spectrum among scents which allows for relational comparative analyses of either individual scents or series of scents.<sup>39</sup> Simply put, each scent is discretely unique, and only random vibrational similarities between different molecule types offer the potential for comparative analysis.

#### *B. Aspects And Application of Vibration Theory*

In order for a scent to be detected by a human, the gaseous molecules must travel from their source to the location of the potential observer. Since the molecules must make actual contact with the observer, the potential for detection will be inextricably bound and limited to the general vicinity of their source, and the potency of the scent will diminish in an exponential manner the further the observer is from that source. Consequently, at some distance, owing to dispersion and dilution physics, augmented by the effects of depletion at the source, the potency of the scent will ultimately reach undetectable levels. A great many variables may enter the equation when attempting to determine the actual potency and range limitations for any scent under any given set of circumstances, including, but not limited to, molecular size and weight, volume of the source, chemical reactivity, environmental conditions, and the presence of other gaseous chemicals.<sup>40</sup> Accordingly, complications in scent

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34. *Id.* at 27.

35. *Id.* at 107.

36. WRIGHT, *supra* note 31, at 51.

37. *Id.* at 3.

38. *Id.* at 22.

39. *Id.* at 111.

40. *See, e.g., id.* at 122, 147-49.

recognition due to such factors generally manifest themselves in proximity effects.

The complicated nature of scents lends itself to a myriad of unique identification and recognition difficulties of particular interest to the inclusion of scents as trademarks. First, temperature, humidity, and wind conditions can all strengthen or weaken the potency of a scent.<sup>41</sup> With a grasp of the mechanisms underlying scents, each of these factors can readily be assessed at an intuitive level. Clearly, if heat adds energy to an environment and causes temperatures to rise, molecules will become more active and the potential for scents to propagate will increase and occasion a corresponding increase in the potency of those scents. However, the addition of too much heat can cause an over-excitement of the molecules and result in distorted vibrational modes and chemical changes that will alter the scent produced. In contrast to heat, since humidity is no more than a measure of the amount of moisture in the atmosphere, an increase in humidity equates to more water molecules in the air, making it more difficult for scent molecules to propagate and dampening the potency of nearby scents. As far as wind is concerned, anyone who has tried to locate the source of an odor in drafty conditions will testify as to the confusion caused by the scent's wafting in different directions.

These fundamental effects are further complicated by a series of more insidious, yet equally significant effects that arise when two or more sources of scents are in close proximity to one another. Gaseous molecules from one source can affect the scents produced by gaseous molecules from a second source through physical, chemical and/or physiological interference. From a physical standpoint, the molecules of the first scent can entirely mask the second scent by desensitizing the olfactory receptors and preventing the second scent's molecules from transmitting any encoded signals to the brain.<sup>42</sup> In such a situation the potential exists for a single source to completely negate the scents produced by a neighboring source. Should the two gaseous molecules be chemically reactive, the two may form a new compound with either an entirely different scent or no discernible scent at all.<sup>43</sup> In a similar vein, should both scents reach the olfactory receptors in tact, it is possible for the scents to blend and send a single, mixed pattern to the brain; in essence creating a different scent altogether.<sup>44</sup> As illustrated, the simple act of placing one item with a scent in close proximity to another may create a condition with the potential to adversely impact one or both of the scents. Yet, as confusing as all this may be, these effects are understandably compounded, and the possibility

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41. WRIGHT, *supra* note 31, at 45.

42. *Id.* at 34.

43. *Id.* at 26.

44. *Id.* at 34.

for even more confusion arises, when more than two scent sources are present in the same vicinity.

Finally, even spectral analysis of scents fails to provide a safe harbor for trademark registration comparisons. Studies have indicated that in some cases a molecule having as few as three infrared absorption plot peaks matching those of a second molecule may create a replecant scent, discerned by humans as nearly identical to the scent created by the second molecule.<sup>45</sup> Although a quantitative study has not been conducted to identify the extent of this phenomenon, the fact that it exists at all presents disturbing and until further examined, lingering questions concerning the degree of certainty scent recognition can be afforded.

Each of the foregoing modification factors may originate through common everyday occurrences such as the placement of a scented object in a drafty room, or next to an ashtray, or even next to a window. Yet even on an individual basis, each can have a dramatic, and in some cases, a catastrophic effect upon a given scent from an analytic and quantitative standpoint. While such complications represent significant tangible detection and recognition difficulties that must be addressed when discussing Lanham Act protection for scent, the qualitative and subjective aspects of scents also bears consideration.

### C. *Memory Association And Scents*

Complicating the study of osphresiology are the lesser understood human elements of memory association and sensitivity. At the core of human scent recognition and memory association is a primal, and some believe instinctive, warning system that operates on both conscious and subconscious levels to alert the individual to potentially life-or-death changes in the immediate environment.<sup>46</sup> The term “memory associations” connotes the fact that scents have no independent identity, but rather must be associated with other memories to enable recall.<sup>47</sup> Unlike general memories, which are merely tied to the conscious mind and readily updated, scent memory associations often last a lifetime and are exceedingly difficult to replace with revised associations.<sup>48</sup> Yet at the same time these memory associations are very limited in that the number of actual scents an individual can store in memory has been shown, by some estimates, to be as low as sixteen.<sup>49</sup> As a result, the vast majority of scents are remembered in a secondary subjective manner, relative only to how they compare to other scents. Since an individual’s actual scent memory associations are themselves relationally based, most memories

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45. *Id.* at 83.

46. TRYGG ENGEN, ODOR SENSATION AND MEMORY 10 (1991).

47. *Id.* at 6.

48. *Id.* at 8.

49. *Id.* at 9.

of scents are little more than a memory of a comparison to a memory of an impression.

Furthermore, detection and accurate recognition of scents depends heavily upon individual sensitivity, an ability that can be affected by a number of personal variables. Some of the more pertinent variables can be classified into two categories that include natural predispositions, such as physical and mental peculiarities, and the state of an individual's personal health.

At an elementary level, differences in physical and psychological makeup provide some individuals with greater sensitivity to scents than others, and that sensitivity can be of a general or specific nature.<sup>50</sup> This bears particular consideration in that existing scent memory associations, coupled with physical olfactory limitations, will generally cause an individual to associate scents similar to those associations in ways that correspond to personal memories.<sup>51</sup> Hence, deeply ingrained personal attitudes lead individuals to unwittingly superimpose their own latent impressions upon their memories of specific scents. While this process may be necessary to allow the individual to remember a given scent, it taints the accuracy of that scent memory and clouds the effectiveness of attempting to compare that scent with another individual's recollection of the same scent. Adding to the potential for confusion is the human capacity for adaptation, which manifests with regard to scents in the body's ability to ignore a scent when exposed for some duration.<sup>52</sup> Obviously, an individual can only discern a noticeable scent, and an individual with a lingering adaptation to a given scent will be severely hampered in identifying or even detecting that scent until the adaptation wears off.

The possibility that an individual may have slight or severe nasal blockage due to a headcold or any infection or disease must also be recognized as a crucial factor in individual sensitivity. Such physical ailments can not only mask and distort scents, but have the capability of preventing detection of scents altogether.<sup>53</sup> Thus, due to the topical and subjective nature of scent memory associations, the accuracy of any such memories obtained through the haze of nasal congestion must surely be doubted. In all fairness, however, it might be argued that ill health represents an anomaly to the norm, and thus cannot be properly considered in this analysis. Yet this only begs the question of just where the norm lies. For although acute anosmia (loss of smell) has

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50. Gladwell, *supra* note 28, at 115.

51. ENGEN, *supra* note 46, at 79.

52. *Id.* at 18. Continued exposure to a scent can result in adaptation, a condition in which the perception of scent intensity will steadily decrease to virtual insensitivity, while the actual intensity remains constant. This phenomenon apparently spans the distance between the physical and psychological; some researchers claim receptors become desensitized, while others claim the brain filters out the repetitive patterns.

53. *Id.* at 101.

been described as a disability affecting only three percent of the population,<sup>54</sup> milder ailments, such as colds, influenza, or allergies, are very common and should be included as a part of the norm. At the risk of jumping ahead, it should be noted that although a cold or allergies will have little effect on a consumer's ability to discern differences in wordmarks, configuration marks, or even color or sound trademarks, such common ailments can functionally impair the consumer who may otherwise rely upon a scent mark. Hence, even if the average individual suffers from an impaired sense of smell for only two or three weeks each year due to all of these maladies combined, the potential for confusion in society at large becomes quite substantial.

The personal modification factors discussed clearly have a dramatic effect on individual responses to scents in an everyday setting. Studies have revealed that even when a single scent is presented and recognized by a group of individuals, the scent will elicit a broad spectrum of reactions, from distaste to indifference to pleasure.<sup>55</sup> Only if the scent is unfamiliar will the group respond in a similar manner, for due to the primal warning system, an unfamiliar scent will be perceived with uncertainty and distrust.<sup>56</sup> In either event, any group consensus concerning the perceptions or merely the attributes of a scent will be virtually unobtainable.

#### *D. Scents v. Colors and Sounds*

In light of the greater public awareness of the sciences behind colors and sounds,<sup>57</sup> it is perhaps understandable that analogies are often drawn between scents and these two more widely recognized sensory mediums that already enjoy trademark protection in order to justify extending trademark protection to scents. Although at a superficial level the sense of smell might seem very similar to the sensory mechanisms manifested in colors and sounds, such an assumption, and any such extrapolations as may rely upon such an assumption, are fraught with error. Only once an adequate scientific foundation has been laid, can an accurate comparison be drawn between scents and both colors and sounds.

As discussed above, scents are by nature unique and complex, and most significantly are very subjective relative to detection, recognition and memory. By comparison, colors and sounds, though bearing superficial similarities to scents, actually differ dramatically in a series of important respects.

To the extent that scents, colors and sounds are all sensory mechanisms, they share certain characteristics common to senses in general. For example, in order for any of the three senses to detect a change in environment, a

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54. *Id.* at 90.

55. *Id.* at 41.

56. ENGEN, *supra* note 46, at 16.

57. *Id.* at xi.

stimulus must be initiated at the respective sensory organ, and the impetus for such stimuli in each situation is a molecular-level energy transfer. However, colors and sounds transmit their sensory message by means of transfer mechanisms very different from scents. While the physiochemical interactions necessary to detect scents require direct physical contact between nasal receptors and molecules emitted from the source, the energy-encoded information bearing an object's colors are transmitted in the medium of light, and energy-encoded information from a sound source travel through a wave of transmitted energy across molecules bridging the distance between the source and the observer.<sup>58</sup> As a result, there is a physical segregation between the source and the observer for colors and sounds, but not for scents. The energy-based transfer mechanisms for colors and sounds, limited primarily by energy transfer mechanics as opposed to molecular dispersion, not only enable colors and sounds to travel far greater distances than scents, but also facilitate the transmission of their energy-encoded information through cables and over the airwaves, unlike scents.

Another striking and fundamental difference between scents and both colors and sounds is the inability to establish any relational correlation between different scents, when one of the most well-understood attributes of colors and sounds is their spectral nature.<sup>59</sup> These properties mark a crucial distinction. While a specific color or sound can readily be compared to a different color or sound in a simple and convenient manner that is easily utilized and universally recognized by the general public, scents must suffer through either a complex scientific analysis or a confusing plethora of verbal descriptors that may lead to an uncertain result.

It must be pointed out that most of the modification factors for scents, discussed *supra*, also have effects on colors and sounds. However, as a practical matter, the relative impact such factors impart on colors and sounds is substantially less significant in the context of human observation and recognition. For example, the observer-source proximity requirements demanded by scents subjects them to severe limitations in detection and recognition. Thus, neighboring scents can seriously impact an observer's ability to recognize any or all of each scent in the area. In contrast, two objects sitting side-by-side, each consisting of a different color, may interfere with the observer's color perception, but only to a very limited extent.<sup>60</sup> The same is true of sounds, for unless a cacophony greets the ear, a multitude of sounds can be witnessed and still the observer will be able to identify individual sounds.<sup>61</sup>

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58. ROBERT W. BURNHAM ET AL., COLOR: A GUIDE TO BASIC FACTS AND CONCEPTS 18 (1963); WILLIAM A. YOST & DONALD W. NIELSEN, FUNDAMENTALS OF HEARING 14 (1977).

59. BURNHAM ET AL., *supra* note 58, at 19; YOST & NIELSEN, *supra* note 58, at 170.

60. BURNHAM ET AL., *supra* note 58, at 63.

61. YOST & NIELSEN, *supra* note 58, at 129.

In another comparison, while scents bow readily to the whims of the elements, colors and sounds both share an exceedingly high degree of tolerance to such factors.<sup>62</sup> These differences are only heightened by the series of factors that can potentially impact or impair an individual's scent detection and scent memory associations.

### III. SCENTS: NO SENSE UNDER THE LANHAM ACT

Having properly explored in the previous section the physical and physiological attributes of scents, this section will build on that foundation to determine whether scents can or should reasonably be afforded trademark protection. Included will be discussions of several key issues associated with trademark law and the Lanham Act.

#### A. *Inherent Confusion Imparts Consumer Confusion*

As is evident from the discussion in the preceding section, scents, by their very nature, are highly subjective. Anyone ever attempting to describe an odor has encountered the difficulty inherent in communicating that information to another individual. Accordingly, several questions immediately present themselves. Upon what basis does one describe an olfactory impression to another? How can one be sure that the other individual has had similar or sufficient experiences upon which to compare the description communicated and arrive at the desired or correct understanding? Even if a sample of the odor was available and presented, is there any guarantee the second individual will sense and remember the odor in the same way as the first? What could influence, or even destroy the proposed communication? Perhaps the second individual is suffering from a mild headcold, or just drank a cup of herb tea. What if the second individual was in a different city? An unlimited list of distortion inducing factors can be imagined that would directly influence or even preclude the line of communication sought by the two individuals. The subjective and keenly personal nature of scents guarantees that confusion would always be present in varying degrees as between two or more individuals. Hence, it would be dubious indeed to claim that any two individuals ever had the same true understanding of any given scent.

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62. Light moves so rapidly, 186,000 mi/sec, and with such high energy that the minor deviations in atmospheric conditions that may be encountered relevant to trademark considerations will impart no significant changes upon the color of the light. BURNHAM ET AL., *supra* note 58, at 39. The speed of sound varies with temperature, density, and humidity of the air. Sound wavelength varies with the density of air. Since wavelength is directly proportional to the speed of sound, sounds themselves are sensitive to such environmental conditions. However, since these factors only result in minor deviations in air density, sounds are likewise only minimally impacted. YOST & NIELSEN, *supra* note 58, at 15.

With respect to trademark protection, the inherent confusion associated with identification and communication regarding scents translates directly into unacceptable consumer confusion. In analyzing the potential for confusion, the Court in *In re E.I. DuPont de Nemours & Co.* set forth the factors to be used in the Federal Circuit and by the Patent and Trademark Office to determine the existence of a likelihood of confusion between marks.<sup>63</sup> The very first factor on the list addresses the concern over actual similarity between competing marks.<sup>64</sup> Since similarity is based upon consumer perception, recognition and memory, the weaknesses inherent in the application of these factors to scents indicates a degradation toward identity, even when little or no similarity exists on an analytical level.<sup>65</sup> Thus, for example, a consumer trying to recall a scent in order to select a specific scented fiberglass product from a shelf filled with scented products, may recognize the presence of different scents but may only be able to perceive the similarities.

Further, two additional factors the Patent and Trademark Office must consider are the nature and extent of *actual* and *potential* confusion (emphasis added).<sup>66</sup> Clearly, if scents are in and of themselves confusing to individuals, and difficult, if not impossible to communicate, actual confusion already exists, as does ample potential for additional confusion. For example, should the consumer seeking a specific scented fiberglass product look to another customer or a store clerk for aid, any communication would be thwarted by each individual's inability to articulate the necessary information accurately. The first consumer will be unable to explain his needs, and the second consumer or the clerk, each carrying their own preconceptions concerning

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63. The Federal Circuit has identified thirteen factors, the "Du Pont factors," that are relevant when analyzing whether a likelihood of confusion exists between two marks, including:

(1) the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression; (2) the similarity or dissimilarity and nature of the goods or services as described in an application or registration in connection with which a prior mark is in use; (3) the similarity or dissimilarity of established, likely-to-continue trade channels; (4) the conditions under which and buyers to whom sales are made, i.e., "impulse" vs. careful, sophisticated purchasing; (5) the fame of the prior mark (sales, advertising, length of use); (6) the number and nature of similar marks in use on similar goods; (7) the nature and extent of any actual confusion; (8) the length of time during and conditions under which there has been concurrent use without evidence of actual confusion; (9) the variety of goods on which a mark is or is not used (house mark, "family" mark, product mark); (10) the market interface between applicant and the owner of a prior mark; (11) the extent to which applicant has a right to exclude other from use of its mark on its goods; (12) the extent of potential confusion, i.e., whether *de minimis* or substantial; and (13) any other established fact probative of the effect of use.

*In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973).

64. *Id.*

65. BEVERLY W. PATTISHALL ET AL., TRADEMARKS AND UNFAIR COMPETITION 177 (1994).

66. *Du Pont de Nemours*, 476 F.2d at 1361.



different scents, will be hard pressed to respond correctly. As might be expected, the confusion associated with recognizing and describing the distinctive qualities of specific scents translates into an impossible task under the test of likelihood of confusion. Such examples serve to highlight the fundamental difficulties in the application of the trademark confusion doctrine to scents, which alone should preclude the inclusion of scents under the Lanham Act. Yet further bolstering this argument are additional legal concerns.

*B. Scent Marks Dissipate Under The Aesthetic Functionality Doctrine*

Case law readily acknowledges that commonly understood, strictly utilitarian applications of scents, including such product features as the fragrances associated with perfumes and deodorants, violate the Lanham Act and will not be afforded trademark protection.<sup>67</sup> However, as already illustrated, scents differ markedly from other sensory mechanisms, including colors and sounds. Therefore, it must be questioned whether those differences are of such a nature that in the final analysis all scents must necessarily be classified as utilitarian. This is particularly crucial when considering the impact of the aesthetic functionality doctrine.

Aesthetic functionality is defined by the Restatement (Third) of Unfair Competition § 17 (Tentative Draft No. 2, March 23, 1990) as:

A design is functional because of its aesthetic value only if it confers a significant benefit that cannot be duplicated by the use of alternative designs. Because of the difficulties inherent in evaluating the aesthetic superiority of a particular design, a finding of aesthetic functionality generally will be made only when objective evidence indicates a lack of adequate alternative designs. Such evidence typically exists only when the range of adequate alternative designs is limited by either the nature of the design feature or the basis of its aesthetic appeal. The ultimate test of functionality, as with utilitarian designs, is whether the recognition of trademark rights would significantly hinder competition.

The doctrine is intended to flush out those product features that would otherwise be afforded trademark status, but which intrinsically provide a definite marketing or commercial advantage that must be made available to all competitors. In the murky waters of aesthetic marketing the distinctions can be very difficult to discern. In examining actual trademark applications, the courts initially applied a strictly utilitarian approach,<sup>68</sup> then moved to a broad interpretation that defined an aesthetic feature as functional even if it only

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67. *In re Clarke*, 17 U.S.P.Q.2d at 1239.

68. Deborah J. Krieger, *The Broad Sweep of Aesthetic Functionality: A Threat to Trademark Protection of Aesthetic Product Features*, 51 *FORDHAM L. REV.* 345, 359 (1982).

impacted a utilitarian or useful purpose of the item.<sup>69</sup> However, as declared by the Court in *In re Morton-Norwich Products, Inc.*, a feature is now considered aesthetically functional if it is superior in either function or economy of manufacture.<sup>70</sup> Although it is conceded that the second prong of the *Morton-Norwich* test has little bearing on the present analysis, it will be shown that scents, as a class, fail to pass the first prong *en mass*.

The argument follows two lines of reasoning. First, because scents represent a unique sensory mechanism, once added as a feature, they incorporate an entirely new and marketable dimension into the original product. Second, scents initiate deep, physiological reactions within the observer-consumer that serve utilitarian functions. These reactions occur regardless of whether the scent holds any meaning as to source.

When a consumer chooses between several products, each of the actual product features that interest that consumer will generally be examined for quality, at least on a cursory level. It is irrelevant in the context of trademark protection what weight that consumer ultimately places upon each or any of those features; so long as the features as a whole represent the actual product the consumer wishes to purchase, each such feature is functional and not protectable under the Lanham Act.<sup>71</sup> “The functionality doctrine prevents trademark law, which seeks to promote competition by protecting a firm’s reputation, from instead inhibiting legitimate competition by allowing a producer to control a useful product feature.”<sup>72</sup> In the context of an inquiry into functionality, the Federal Circuit agreed with the Court of Customs and Patent Appeals that “[w]hether competition would in fact be hindered is really the crux of the matter.”<sup>73</sup> Of course, the aesthetic functionality doctrine serves to secure that even aesthetic features fit within this criteria. Hence, under the functionality doctrine, product features must be primarily non-functional and cloaking the features with the monopoly of trademark protection must not hinder competition in order for the feature to be protectable under the Lanham Act.

Yet scents simply cannot be segregated from their source, either physically or through memory recall, and while many products may have little or no

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69. *Id.* at 361.

70. *In re Morton-Norwich Products Inc.*, 671 F.2d 1332, 1339 (C.C.P.A. 1982).

71. *Midwest Indus., Inc. v. Karavan Trailers, Inc.*, 175 F.3d 1356, 1361-62 (Fed. Cir. 1999) (citations omitted) (“To guard against such anti-competitive effects, the Court of Customs and Patent Appeals invoked the doctrine of ‘functionality’ to limit the scope of trade dress protection. The court held that a seller of goods could not obtain trademark protection for a trade dress or product configuration that was primarily utilitarian, or ‘functional.’ The court then defined as ‘functional’ any feature that possessed such utility that its protection would hinder competition.”).

72. *Id.* at 1362.

73. *Id.* at 1361 (quoting with approval *In re Mogen David Wine Corp.*, 328 F.2d 925, 933 (C.C.P.A. 1964) (additional citations omitted)).

readily discernible scent, all products have colors and configurations. Thus, again looking at fiberglass insulation as an example, instead of arbitrarily changing an existing feature such as color from yellow to pink, adding a scent would change the entire product from generic, having virtually no scent, to, e.g., a plumeria scented fiberglass insulation. That is, the change incorporated by adding an “arbitrary” scent to a product is so dramatically different from merely changing an already existing feature, that the result will be an entirely new product. As a result, the new product in the fiberglass example will be “plumeria scented fiberglass insulation,” not merely fiberglass insulation that happens to smell like flowers.

Furthermore, unlike other product features, scents impart memory associated impressions on the consumer which result in a very real personalization to the product. While this effect will vary from consumer to consumer, and the individual reactions elicited due to the effect may be difficult to ascertain, none the less when scents are added to a product, they manifest in a functional feature. Referring again to the fiberglass once the manufacturer has the product smelling like plumeria blossoms, any consumer not affected with anosmia, and in the vicinity of the product will have little choice in either consciously or unconsciously sampling that aesthetic feature of the fiberglass insulation. Although a positive reaction to the scent cannot be guaranteed, one of the scent’s aesthetic functions has already succeeded; attracting the attention of potential customers. Assuming that the manufacturer has conducted an adequate market study and has ascertained that fiberglass insulation buyers, as a group, do indeed favor the scent of plumeria, blossoms, the scent then fulfills its second aesthetic function by pleasing the manufacturer’s actual and potential purchasers. At this point, the scent may actually help serve as an indicator of source (disregarding for the moment all the subjective and detection hurdles associated with scents), but clearly, that protectable function is inconsequential since the aesthetically functional features of the scent provide the insulation with a superiority of function.

Recalling the Restatement definition of aesthetic functionality, it might be argued that competition would not be unduly burdened by scent marks since competitors have a wealth of alternatives available to them, and they could simply select a different scent for their own products. However, this argument is improperly placed. As stated by the court in *Morton-Norwich*, “there exists a fundamental right to compete through imitation of a competitor’s product . . .”<sup>74</sup> Thus, the mere possibility that an alternative product can be developed cannot serve as a bar to permitting competitive imitation. Taken as a whole, the incorporation of a new product dimension and the advent of additional functional aesthetic features make adding an “arbitrary” scent to a product tantamount to creating an entirely new product, and not simply a new

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74. *Id.* at 1334.

product identity. As a result, the aesthetic functionality doctrine effectively precludes serious consideration of granting scents trademark protection.

*C. Secondary Meaning: To Be Or Not To Be*

It must be conceded up front that scents, by their very nature, must be possessed of a secondary meaning since each scent is stored by the brain as a memory association referenced to some other sensory impression. This would certainly appear to argue favorably for adopting their use as trademarks. However, in order to show secondary meaning under the Lanham Act, a mark must point the consumer in the direction of some independent source<sup>75</sup>, and there simply is no guarantee that scents represent a reliable mechanism to convey such an important message absent confusion. Hence, whether scents are capable of attaining secondary meaning in the trademark sense is a difficult question at best. Fortunately, the answer no longer need be found.

In order to manage the multitude of differences in distinctiveness among traditional trademarks, a judicial glossary slowly evolved that now incorporates a series of definitions for terms used to describe alpha-marks.<sup>76</sup> Unfortunately, just as in the case of trade dress, the protectable overall visual image of a product or service, none of these descriptors can properly be used to discuss scents. The decision in *Two Pesos, Inc. v. Taco Cabana* remedied this situation by declaring that a showing of secondary meaning is not required for inherently distinctive trade dress to gain trademark protection under the Lanham Act.<sup>77</sup> In its decision, the Supreme Court accepted the impossibility of attempting to apply verbal descriptors to strictly visual impressions, and in so doing has allowed subsequent trade dress claims to speak for themselves if they exhibit inherent distinctiveness.

Yet not every example of trade dress is inherently distinctive. Where the inherent distinctiveness of a particular trade dress must be ascertained, the *Chevron* test provides guidance. This test states that even when a trade dress lacks secondary meaning, protection will be granted if “the features of the trade dress sought to be protected are arbitrary and serve no function either to describe the product or assist in its effective packaging . . .”<sup>78</sup> At this juncture we may quickly dispense with the question of whether scents are inherently distinctive and thereby protectable under the Lanham Act. For having already fully explored the aesthetic functionality doctrine and found that added scents are indeed functional features, and in fact actually transform the original

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75. *Union Carbide Corp. v. Ever-Ready, Inc.*, 531 F.2d 366, 370 (7th Cir. 1976).

76. *Big O Tire Dealers, Inc. v. The Goodyear Tire & Rubber Co.*, 561 F.2d 1365 (10th Cir. 1977).

77. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 771 (1992).

78. *Chevron Chem. Co. v. Voluntary Purchasing Groups, Inc.*, 659 F.2d 695, 702 (5th Cir. 1981), *cert. denied*, 457 U.S. 1126 (1982).

product into a new product altogether, it becomes clear that under the *Chevron* test, scents do function as product descriptors and therefore cannot have inherent distinctiveness.

#### *D. Administrative Nightmares*

One of the more apparent areas of conflict for assimilating scents into the trademark umbrella is coping with administrative difficulties involved in the effort. Armed with an understanding of olfactory science, the reader can now better understand the reasons behind the difficulties and grasp the extent of the problem. Because of the complexity of exploring each of these issues, only the difficulties associated with registration will be examined in depth, while other prominent concerns will be mentioned in passing.

How will the trademark be registered? One apparently simple approach might be to store a registration sample of the product at some Patent and Trademark Office warehouse. But a physical sample would soon lose its potency, and would be subject to contamination from other vital samples in the warehouse. In any event, just how large of a sample will be required to meet all of the needs of the Patent and Trademark Office? Each examiner may need to utilize a part of the sample for comparative analyses against new applications, for oppositions and cancellation proceedings, and for infringement claims. Likewise, should an infringement case reach the courts, more samples, from a dedicated and registered source, may again be called for. Even this limited list of problems point out the impossibility of the option, and that another method must be found.

Another apparently simple approach would be to require the applicant to submit a non-comparative written description of the scent that would be retained on file. However, the flaws in this approach are just as simple; accurate scent descriptions cannot effectively be communicated through language. All of the personal perceptions, biases, and physical limitations would frustrate any such attempt. Furthermore, this approach will unduly burden the system with unmanageable strife during the processing of each scent claim, since the claimant will undoubtedly seek to register a description as vague as possible to attain the broadest possible protection while the Examiner will look for a narrow and specific description for ease in administration. Without a context within which to even frame such a dispute, both the applicant and the Examiner would merely be drawing proverbial lines in the sand with both ignorant of where the desert was located. But suppose the registration applicant merely described the scent as “rose”?

Unfortunately, relying upon well recognized scents, even those as often discussed as that of a rose, provides no safe harbor from inherent confusion. Any attempt to capture in words the essence of the rose’s scent will fail. Consider: The scent is sweet. It is fragrant, not pungent, and floral in nature. It might be argued that a rose carries a musty component. Some might say it has

a fruity component, others would disagree. The number of available common descriptors thereafter soon wanes. Direct comparisons to other scents would be no more than shooting at a moving target, since the comparison scents would suffer the same problems as the rose scent. Yet without the use of comparisons, the description quickly and irreparably stumbles.

A third option might be to describe the differences between the subject scent and other scents such as those associated with, for example, a gym locker, a carp, or a pine tree. While offering the pretence of recognition, this method, too, is fraught with pitfalls. For example, how different is the smell of a rose from that of a lilac, a tulip, or a chrysanthemum? While one person may identify certain smells with a rose, another person may identify the same smells with any of a myriad of other flowers. In fact, for all the items that can be named with scents that differ greatly from that of a rose, there are a similar number that differ only slightly. Furthermore, even in this simplistic example, numerous questions arise, such as: Should the claimant choose a red rose or a white rose?; Should the rose be just budding, in full bloom, or fading?; Is there a standard growing environment for all rose bushes such that their blooms all smell exactly the same? These, and other questions, undermine the certainty of identification necessary for effective trademark registration. Hence, in the end, even seemingly well known scents do not have the recognition potential demanded of a trademark.

Rejecting the first three options, a more complex registration alternative would be to generate an energy plot of the scent and secure the plot in a file. Certainly, in this manner the true identity of the specific scent would be recorded. However, since it is quite possible to replicate a scent by matching as few as three vibrational peaks, and since very similar scents may have entirely different spectral plots, the potential for proliferation of confusingly similar scents cannot be overlooked. Furthermore, given the very narrow focus of the infrared plots, and the accordingly narrow protection thus afforded, it is doubtful such protection would generate much interest from potential claimants. Consequently, as with the previous two approaches, the practical difficulties associated with a system based upon retaining infrared plots outweigh any potential benefits.

The problems associated with registration are only the very first to be encountered. As the process continues, serious unanswerable questions will arise concerning infringement. For example, on a fundamental level, what would constitute infringement of a scent mark? That is, how similar is too similar? A quick cross-reference to the discussion of registration above will highlight the extremely nebulous nature of such questions. Even if a recordation standard is ultimately established, how will infringement be regulated and enforced? Is there any effective testing procedure that can be feasibly administered in an infringement suit? If a jury is seated, will each be required to ascertain the similarities between competing scents? How can

either party in such a suit possibly hope to recognize, much less speak to the subjective perceptive scent memories of each juror and the judge, particularly when the judge and jury are unable articulate the memories themselves? What types of criteria must be met before an individual is qualified to sit on such a jury? While such questions are daunting, it is perhaps even more disturbing that the answers are as evasive and insubstantial as the scent memories that are causing them to be asked.

#### E. Depletion

The doctrine of depletion provides that trademark protection will be refused for a potential mark if the foundation for the claim has a limited number of possible variations and would restrict the number of potential competitors entering the market, thus unfairly hindering competition.<sup>79</sup> Prior to the Lanham Act, depletion theory was applied by courts to all forms of trade dress when applicants sought to protect basic designs and features of their products.<sup>80</sup> However, subsequent to passage of the Lanham Act, the primary focus of debate over the depletion doctrine has centered on colors.<sup>81</sup>

Two characteristics of colors provide fuel for a difficult and heated debate over the applicability of the doctrine. One side of the argument posits that since colors are defined by a continuous spectrum reaching from the infrared at one end to the ultraviolet at the other, there exist, by definition, an infinite number of colors available for trademarks.<sup>82</sup> However, the opposing argument holds that since only a select few primary colors are readily recognizable, and all other colors are merely blends of the primaries,<sup>83</sup> that from a practical standpoint a given market will rapidly be depleted of all primary colors.<sup>84</sup> While the argument still merits consideration, in approving trademark protection for the color "pink," the court in *In re Owens-Corning Fiberglass Corp.* interjected another perspective by establishing that situations presenting a lack of competitive need will moot the argument altogether and allow for protection in spite of theoretically possible depletion.<sup>85</sup> Hence, in approving a trademark for color *per se*, the *Owens-Corning* court sidestepped the argument central to the depletion doctrine, and concentrated on practical concerns over monopolistic potential.

In light of the *Owens-Corning* decision, particularly since the mark in question was a color, proving that the depletion doctrine must still be

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79. *Campbell Soup v. Armour & Co.*, 175 F.2d 795, 799 (3rd Cir. 1949).

80. *Morton-Norwich*, 671 F.2d at 1336.

81. *Owens-Corning*, 774 F.2d at 1120.

82. *Id.* at 1122.

83. BURNHAM ET AL., *supra* note 58, at 119.

84. *Owens-Corning*, 774 F.2d at 1120.

85. *Id.* at 1122.

considered with regard to scents becomes at the same time straightforward and problematic. Obviously, the primary argument concerning depletion can now be easily answered and set aside. Since scents are discrete and essentially random in nature, and therefore lack any spectral attributes, the first side of the argument must be vacated. Thus, the depletion doctrine would appear to readily apply to scents. However, the decision in *Owens-Corning* cannot be so easily dispensed with. For if the premise of *Owens-Corning* is that depletion should be recognized only when commerce is threatened by monopoly, then the lack of commercial interest in scent marks since *In re Clarke* would imply that scents do not suffer from that potential threat. The answer to this apparent enigma lies in the very argument that undermines the commercial justification for granting scent marks.

#### IV. COMMERCIAL CENTS

It might well be argued that if scent marks actually create monopolies and represent a valid threat to competition, that following *In re Clarke*, manufacturers and merchants would be flooding the Patent and Trademark Office with scent mark applications. However, that flood has been the smallest of trickles.<sup>86</sup> Of these applications, four have been abandoned, one is being opposed, and three have been allowed. This, of course, begs the question; if scent marks are so commercially significant, why has there been such a dearth of applications over the past decade? The simple answer is that the market, ahead of the legal community, already understands the inherent limitations of such "marks." It is hoped this commentary will provide the reader with as much or more understanding than may already exist in the market.

Of course, markets can be fickle. Should greater interest in scent marks somehow kindle, it is not difficult to imagine rows of similar goods on a store shelf, each with its own registered scent, competing with one another for the limited olfactory capabilities of the consumers who wander by. Aside from potentially repelling the very consumers being sought to entice, such an olfactory onslaught can only lead to a confusing cacophony. Further, as scents are wont to do, each of these products' smells will drift on the wind and violate the airspace of its competitors. A race for the most potent scent sources with the most lingering and overpowering qualities will ensue, resulting in a haze of oppressive odors that eventually mask all of the marks combined. Businesses instinctively or empirically weigh such pitfalls against any potential benefit of a scent mark in a business expenditure analysis.

From the practical standpoint of running a business, each expenditure must be weighed in light of what and how much potential benefit the business will gain as a return, with the result classified as return on investment. As already

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86. *See supra* note 29.



discussed, scents differ greatly from traditional symbol and device trademarks, and suffer from several distinct and important disadvantages. The significance of these drawbacks has apparently not been lost upon the business community, particularly in light of the potential costs of establishing and maintaining a trademark.<sup>87</sup> Although it is theoretically possible to establish an extremely strong association between a scent and a product, from a business standpoint this is likely greatly outweighed by the risks associated with obtaining a scent mark, including: potential for confusion, proximity requirements, inability to transmit the mark, preexisting customer perceptions, packaging and labeling concerns, and unknown scope of trademark protection. Any or all of these risks could eliminate the return on investment charged to obtaining a scent mark. As a result, it is likely businesses have simply concluded that any available marketing funds would be better spent elsewhere.

#### V. *IN RE CLARKE*: THE DECISION MADE IN THE DARK

“We did this as a kind of gimmick . . .”<sup>88</sup>

At the heart of the *In re Clarke* decision is a single fundamental question: Are consumers purchasing the scented products because the fragrance assures them they are receiving a specific product from a specific source, or, are they purchasing the product because the idea of a using scented yarn appeals to them? Although all of the Board’s arguments are ancillary to this question, each will be addressed in turn.

The Board found it significant that Clarke was the only person to market scented yarns and threads, and emphasized the scent in her advertising.<sup>89</sup> But merely because she put out verbal advertising that said her yarn was scented like “plumeria blossoms” provides no assurance that if a consumer were to smell that scent, it would remind them of her yarn. In addition, while advertising and marketing expenditures do play a role in determining whether a trademark has attained a secondary meaning, the significance here is irrelevant given the relationship between scents and secondary meaning.

The fact that Clarke was able to demonstrate that customers, dealers, and distributors recognize her as the source for her scented products,<sup>90</sup> is likewise unconvincing. At the time of the decision, Clarke was the only person marketing scented yarn and thread.<sup>91</sup> With no other sources available, and

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87. *Owen-Corning*, 774 F.2d at 1125 (In advertising alone, Owens-Corning spent over \$42 million to promote “pink” for its fiberglass products.).

88. *Gladwell*, *supra* note 28.

89. *In re Clarke*, 17 U.S.P.Q.2d at 1239-40.

90. *Id.* at 1240.

91. *Id.* at 1239.

given the novelty of the product, it would be surprising to find that those individuals did not identify her as the source at that time.

As already demonstrated, any reliance on colors or sounds to justify granting protection is misplaced. In *Clarke*, the Board reiterated, with apparent approval, the *Clarke* brief, citing *Owens-Corning* and drawing a comparison between the color “pink” and the scent of plumeria blossoms.<sup>92</sup> Again, the *Owens-Corning* decision bears little weight on the issue at hand, and the *In re Clarke* Board therefore erred in adopting the applicant’s analogy arguments. Perhaps the one justification the Board reasonably relied upon was the liberalization of trademark law under the Lanham Act and the expansive definition of trademarks according to the Commission.<sup>93</sup> Yet, even a lay understanding of the science underlying the scent phenomenon leads to the inescapable conclusion that in spite of the Commission’s position, scents are not suited to be trademarks.

Having set aside each of the Board’s arguments, we now return to the question first presented in this section. Although we lack the benefit of a proper survey, it seems improbable that Clarke’s customers would purchase a scented yarn or thread, and put up with the smell for the prolonged periods of time required for most craft activities, only to insure they bought the correct product. Would, for example, Clarke’s customers purchase the yarn if the scent was that of mustard or dung? Rather, it seems much more likely that a pleasant scent could be a highly desirable feature for a product that could make craft activities more enjoyable to the purchasing consumer. This, of course, goes full circle to functionality.

Finally, two small, yet significant details concerning the *In re Clarke* case shed additional light on this important question. The first item, easily overlooked in the details of the Board’s brief decision, was the fact that one of articles placed on record for evidence by Clarke was a thread and yarn craft kit “for making a scented skunk.”<sup>94</sup> It is doubtful that the kit would have value, or indeed even be the same product, without yarn and thread that was scented.

At the very top of this section is the second item, a quote made by applicant Celia Clarke concerning her scent mark application: “We did this as a kind of gimmick . . .”<sup>95</sup> While one must applaud her honesty, one must also question Ms. Clarke’s sincerity in pursuing the application for any legitimate business purpose. That a landmark decision concerning the Lanham Act should be decided because of a whimsical desire on the part of some applicant, when the Lanham Act was implemented to aid businesses in legitimate

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92. *Id.*

93. *In re Clarke*, 17 U.S.P.Q.2d at 1240.

94. *Id.* at 1239.

95. *Gladwell*, *supra* note 28.

marketing concerns, serves to highlight the distortions surrounding the entire concept of scent marks.

## VI. CONCLUSION

Although the Lanham Act was intended to liberalize trademark law and expand the scope of protection afforded product identifiers in order to meet the evolving needs of business, scents were not originally contemplated by the drafters, and only through subsequent interpretation has the door been opened to their inclusion. Yet, any scents that pass through that door will be riding in upon an ill wind. The very nature of scents is such that they are inherently confusing, and in any application will impart functional attributes to a product. Furthermore, any possible benefit businesses may be derived from utilizing scent marks will be vastly overshadowed by the administrative burden their management will impose and the regulation and enforcement quagmire they present. Thus, in spite of the decision in *In re Clarke* there simply exists no business need for scent marks, and granting trademark protection to scents flies in the face of the Lanham Act's purpose. Scents are unfit for trademark consideration and the entrance into the umbrella of protection under the Lanham Act should be closed.