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Systematizing Scents: The Case for Chemically Standardized Nontraditional Scent Trademarks

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SYSTEMATIZING SCENTS: THE CASE FOR CHEMICALLY STANDARDIZED NONTRADITIONAL SCENT TRADEMARKS

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I. INTRODUCTION

[When the modern trademark emerged in the late nineteenth century],¹ no one at the time could envision trademarking words and ideas beyond an item's mere description. Then again, the exponential technological revolution that would take place over the next 250-plus years was also unthinkable. As marketing, science, and technology have progressed exponentially over the years, the possibility of nontraditional trademarks – including color, scent, sound, taste, and touch – to take on a secondary meaning has greatly increased.

Particularly with the recent increase in more-affordable scientific technology, scent trademarks are a nontraditional mark with the potential to add value to a company's intellectual property portfolio.² Because registering a nontraditional scent trademark is still relatively uncommon,³ no better time exists than the present for the United States Patent and Trademark Office (USPTO) to strengthen description requirements before companies are able to saturate the market with broad trademark claims. Further, an uptick in

1. Stacy V. Jones, 'Sweet 'n Low' to Be Listed as Trademark No. 1,000,000, THE NEW YORK TIMES (Dec. 17, 1974), <https://www.nytimes.com/1974/12/17/archives/sweet-n-low-to-be-listed-as-trademark-no-1000000-sweet-n-low-to-be.html> [<https://perma.cc/7PMX-46UD>].

2. Jerome Gilson & Anne Gilson LaLonde, *Cinnamon Buns, Marching Ducks and Cherry-Scented Racecar Exhaust: Protecting Nontraditional Trademarks*, 95 TRADEMARK REP. 773, 820 (2005).

3. Kenneth L. Port, *On Nontraditional Trademarks*, 38 N. KY. L. REV. 1, 50 (2011).

overbroad trademark claims is more likely than not to lead to increased future litigation, in cases of both intentional and unintentional infringement. In a change from the current system, nontraditional scent trademarks should be required to utilize a combination of chemical formulations and descriptive words to prevent excess litigation and overbroad claims.

In this article, I will discuss the current status of the nontraditional trademark system in the United States. In doing so, I will point out the issues between the current trademark registration system and nontraditional scent trademark registrations. From there, I propose a solution for the problems that nontraditional scent trademarks cause in the current trademark registration system.

II. HISTORY OF NONTRADITIONAL TRADEMARKS

Though the complexity of trademark law is exponentially increasing, the practice of reserving trademarks is not a recent development. In 1870, the United States Congress passed a statute that instituted a federal system with the purpose of registering and protecting trademarks.⁴ This statute was the first of its kind, even including civil remedy provisions in cases of wrongful use (i.e., trademark infringement).⁵ The well-meaning statute became a stiff point of contention years later, in the form of *In re Trade-Mark Cases*, a combination of three cases brought before the Supreme Court of the United States (SCOTUS) in 1879.⁶

The issue in the cases dealt with a conflict between the Copyright Clause of the U.S. Constitution and the new statute. The Copyright Clause provides: “[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”⁷ After weighing the arguments from both sides, the new statutory language was struck down, as the language did not comport with the Copyright Clause because “[t]he trade-mark recognized by the common law is generally the growth of a considerable period of use, rather than a sudden invention. It is often the result of accident rather than design . . .”⁸

Essentially, the Court held that trademark creation tends to be closer to spontaneous than intentional, if a spectrum were to be created between the two concepts. This case, though over a century old, set the foundation for trademark

4. *In re Trade-Mark Cases*, 100 U.S. 82, 85 (1879).

5. *Id.*

6. *Id.*

7. U.S. CONST. art. I, § 8, cl. 8.

8. *Trade-Mark Cases*, 100 U.S. at 94.

law and is still useful today when considering the scope of trademark application.

In 1946, in response to the *Trademark Cases*, Congress passed the Lanham Act under the Commerce Clause, which granted the USPTO administrative authority over trademark reservation and protection. In doing so, the USPTO was given the opportunity to define rules, reserve trademarks, and enforce trademark security.

With new legislation comes new disputes over said legislation. As such, courts have had the opportunity over the years to clarify the Lanham Act and trademark-eligible subject matter. Naturally, cases involving product names rose to the Supreme Court, with one in the form of *Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*⁹ In this case, the term “Fish-Fri” – originated by Zatarains, Inc. – had acquired a secondary meaning, associating the term to the original brand, one beyond basic descriptive terms.¹⁰ Because “Fish-Fri” was distinguished from other sources (i.e., companies) and went beyond a functional description, the trademark was allowed.¹¹ In contrast, the term “Chick-Fri” was not found to have acquired a second meaning or trademark protection, as it was not as easily recognized by the local community as “Fish-Fri.”¹² In this manner, the Court forever changed the analysis of secondary meanings, relative to trademarks.

Two Pesos v. Taco Cabana was the first major case to be decided over not only the name or products of an establishment, but the distinctive trade dress of an establishment.¹³ Here, Taco Cabana was found to have infringed on Two Pesos’ distinct trade dress, a motif including “interior dining and patio areas decorated with artifacts, bright colors, paintings and murals.”¹⁴ Even though Two Pesos did not show a secondary meaning to their trademark, the company was still able to maintain the trademark.¹⁵ However, a case came forward to the Supreme Court in 1995 that completely changed the outlook on what could be formally registered as a trademark.

Perhaps no case in history was of greater importance to trademark law, and particularly nontraditional trademarks, than *Qualitex v. Jacobson*.¹⁶ In *Qualitex*, the Court held that there was no special legal rule that prevented a

9. *Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786, 788 (5th Cir. 1983).

10. *Id.* at 795.

11. *Id.*

12. *Id.* at 797.

13. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 764-65 (1992).

14. *Id.* at 765.

15. *Id.* at 776.

16. *See Qualitex Co. v. Jacobson Prods. Co., Inc.*, 514 U.S. 159, 162 (1995).

color from serving as the basis for a company trademark.¹⁷ The Court laid down the standard that “almost anything at all that is capable of carrying meaning” can be considered a trademark.¹⁸ This case, combined with the rulings from prior case law, opened the metaphorical floodgates to allow further registration of nontraditional trademarks.¹⁹

III. PROBLEMS WITH NONTRADITIONAL TRADEMARKS

When it comes to planning for the allowance of more nontraditional trademarks to be filed, one must take a careful look to ensure that the classification system is standardized. Without a standard, worldwide method to organize trademarks by color, sound, scent, and other, it is impossible to guarantee that these trademarks would not be easily infringed upon, either purposefully or accidentally.

Color is arguably the most difficult of the nontraditional trademark types to assure it belongs to the owner, as a showing of secondary meaning is required for registration.²⁰ Much like *In re Trade-Mark Cases*, a color tends to be used initially by an entity, then becomes further associated with the entity over time, almost unintentionally.²¹ Further, it is becoming increasingly difficult to unintentionally infringe on another’s trademark rights, as no nationwide, uniform chromaticity database exists.²² Currently, photos of specimens approved by the USPTO are published in black and white.²³ This makes it more difficult for those trying to avoid infringement to determine the true scope of the trademark.

The forefront problem with registering scent marks digitally with the USPTO is that scents cannot, by definition, be replicated without utilizing chemical formulas and mixture percentages. Although a detailed description of the scent itself is required for the trademark registration to be approved, too much room for error exists when replication of the scent is made impossible. On a molecular level, esters are typically the culprit when something smells pleasant. Chemically, an ester is an acid-derived compound where at least one alkoxy group replaces a hydroxyl group as part of an alcohol/carboxylic

17. *Id.*

18. *Id.*

19. Port, *supra* note 3, at 2.

20. Lawrence B. Ebert, *Trademark Protection in Color: Do It By the Numbers!*, 84 TRADEMARK REP. 379, 391 (1994).

21. *Id.* at 386.

22. *Id.* at 406.

23. Melissa E. Roth, *Something Old, Something New, Something Borrowed, Something Blue: A New Tradition in Nontraditional Trademark Registrations*, 27 CARDOZO L. REV. 457, 481 (2005).

substitution reaction.²⁴ These organic molecules must reach olfactory sensory neurons in one's nasal passages.²⁵ Next, the transmission of electrical impulses must reach one's brain via the olfactory nerve to be perceived correctly as a scent—any breakdown in this chain reaction will register as an improper or different scent.²⁶

Due to this complex pathway, and any breakdowns that may occur along the chain, scents are perceived differently for every single person, leading to a serious issue of uniformity relative to scent trademark registrations. One way to combat this difficulty may come with new advances in technology. Today, nuclear magnetic resonance (NMR) and other advanced tests can be run to determine the molecular structure of a compound.²⁷ If a scent were to be trademarked by a company, it would either need to contain a specific molecule or, more likely, a mixture of molecules—within a percentage range—attributed to the company on a secondary-meaning basis. By requiring scientific precision with the molecular structure of the scent, any room for “operator error” is eliminated by removing the imperfectly precise human body from the equation.

Sound marks are arguably one of the easier nontraditional trademarks to get registered, as their descriptions—pertaining to musical notes, time signatures, pitches, inflections, and words—can be universally replicated to a higher degree of certainty in the music world.²⁸ Thus, trademarks, such as the NBC chimes²⁹ and the Metro-Goldwyn-Mayer lion's roar, were registered years before *Qualitex*.³⁰ After the *Qualitex* decision, the USPTO has broadly interpreted the outer limits of what can be trademarked, taking on an “anything goes” doctrine.³¹ Proof of secondary meaning is also a requirement here, as context to what the sound represents must be provided to gain trademark approval.³² By maintaining a higher degree of replicability, nontraditional-sound trademarks lend inspiration to how nontraditional-scent trademarks should be classified.

24. *Esters*, INTERNATIONAL UNION FOR PURE AND APPLIED CHEMISTRY, <https://doi.org/10.1351/goldbook.E02219> (last visited Mar. 15, 2023).

25. *Smell Disorders National*, INSTITUTE ON DEAFNESS AND OTHER COMMUNICATION DISORDERS (May 12, 2017), <https://www.nidcd.nih.gov/health/smell-disorders> [hereinafter NIDCD].

26. *Id.*

27. Renato Haddad et al., *Perfume Fingerprinting by Easy Ambient Sonic-Spray Ionization Mass Spectroscopy: Nearly Instantaneous Typification and Counterfeit Detection*, 22 RAPID COMM. MASS SPECTROSCOPY, ISSUE 22, 3662 (2008).

28. Roth, *supra* note 23, at 487.

29. “The Musical Notes G, E, C Played on Chimes” (1950) Registration No. 523,616.

30. “The Musical Notes G, E, C Played on Chimes” (1950) Registration No. 1,395,550.

31. *Qualitex*, 514 U.S. at 162.

32. Roth, *supra* note 23, at 486.

IV. DISTINGUISHING SCENT FROM OTHER NONTRADITIONAL TRADEMARKS

Nontraditional trademarks are truly unique, encompassing a variety of characteristics that go above and beyond in protecting a brand. Of these nontraditional marks – color, sound, scent, and sensory – scent is arguably the most difficult to describe and replicate to a non-owner. For example, colors may be difficult to describe, but can be analyzed scientifically through a spectrophotometry experiment, where the intensity of reflected radiation as a function of wavelength is recorded.³³ Similarly, nontraditional sound marks can be reproduced and replayed through the use of recording devices.³⁴ Sensory or tactile trademarks, though generally ignored, can be deciphered by recreating a physical representation of what the trademark description intends to protect.³⁵ Because of the issue of functionality, it is unsurprising that this mark is uncommon today.³⁶ Therefore, nontraditional scent trademarks can be completely distinguished from all the other nontraditional trademarks, as an exact scent and the user's perception of the fragrance can never be perfectly replicated through a basic description alone.

From a chemical standpoint, a compound (i.e., fragrance) cannot be perfectly replicated down to the molecular level, even by the proper manufacturer. When a fragrance is manufactured, there will always be a deviation from the “correct” formula and what the final product turns out to be, even if the products are similar or equal for the average nose.³⁷ Of the 15 live scents currently registered as trademarks with the USPTO, just one was described in a chemical manner.³⁸ Trademark serial number 77,420,841 for medicated pain patches is described as “a scent mark having a minty scent, by mixture of highly concentrated methyl salicylate (10wt%) and menthol (3wt%).”³⁹ Using this very specific description, a company would not need to spend time and money to recreate the scent to determine if it had accidentally infringed on another's scent mark. Further, this method of categorizing scents chemically is more inclusive to persons who have lost their sense of smell permanently (e.g., from the condition anosmia, the complete inability to

33. Ebert, *supra* note 20, at 404.

34. Roth, *supra* note 23, at 487.

35. Gilson & LaLonde, *supra* note 2, at 801.

36. *Id.*

37. Charles Cronin, *Lost and Found: Intellectual Property of the Fragrance Industry; From Trade Secret to Trade Dress*, 5 NYU J. INTELL. PROP. & ENT. L. 256, 288 (2015).

38. U.S.P.T.O. trademark database search, TRADEMARK ELECTRONIC SEARCH SYSTEM, <https://tmsearch.uspto.gov/bin/gate.exe?f=tess&state=4806:dqmypu.1.1>.

39. “A scent mark” having minty scent by mixture of highly concentrated methyl salicylate and menthol. Registration No. 3,589,348.

detect odors) or temporarily (e.g., from infection from SARS-CoV-2).⁴⁰ By portraying the trademark's composition in both a chemical and descriptive manner, this compound method of describing scent trademarks is far superior to any simple description.

Further, a glaring issue must be addressed when it comes to not using a chemical description of a scent trademark. Even if a scent can be replicated, two people may have completely different perceptions of a particular scent.⁴¹ At a primal level, the sense of smell, or olfaction, is a series of chemical reactions and electrical impulses that allow humans to perceive outside sources such as food or threat.⁴² To start this chain reaction, the substance being smelled releases odor molecules—generally from, but not limited to the ester or aromatic families—which bind to olfactory receptor cells (i.e. neurons) deep in the nasal cavity.⁴³ Once these neurons reach a peak electrical threshold, they will fire, sending an electrical impulse via the olfactory nerve to the brain.⁴⁴ From there, the brain will process the signal and make a determination of what a smell means.⁴⁵ Once the brain is brought into the anatomical picture, further neurological differences and disorders at this level will only further alter comparisons of this pathway between two different people.⁴⁶ Clearly, this is a biochemically-complicated chain of events for an action, which is seemingly so simple and taken for granted on a daily basis.

Increased complication of the biological olfactory chain increases the risk that two different people perceiving the same scent will not do so in a manner that fails to protect, or over-protects, the original intent of the nontraditional trademark owner. Further, both intentional and unintentional, ambiguities and vagueness in a nontraditional scent trademark description can cause major confusion within the marketplace itself. For example, trademark serial number 77,755,814, a scent for hair and beauty products, is described in the trademark register as “a high impact fragrance primarily consisting of musk, vanilla, rose, and lavender.”⁴⁷ Is the fragrance one percent musk, vanilla, and rose, while containing 97 percent lavender? Or is the fragrance one percent lavender, vanilla, and rose, while containing 97 percent musk? Without replicating the exact formula, it is impossible to know what this scent will smell like. Take

40. NIDCD, *supra* note, 25.

41. Cronin, *supra* note, 37.

42. NIDCD, *supra* note, 25.

43. *Id.*

44. *Id.*

45. *Id.*

46. *Id.*

47. “A high impact fragrance, reminiscent of vanilla and musk, with hints of floral scents such as rose and lavender, and a warm, spicy undertone” Registration No. 4,057,947.

into account the fact that two people will perceive this scent differently, and the problems are clear. Therefore, this mark appears to be very broad, potentially disallowing competitors from making any type of similar fragrances with those four ingredients. Because of this risk of overbreadth suppressing new trademark claims, chemical descriptions and written descriptions for trademarked scents should be required to prevent overbroad claims and unintentional infringement by competitors.

One of the historical problems with advanced chemical analysis has been the sheer cost to companies and other applicants of doing so. When proton nuclear magnetic resonance (NMR) spectroscopy and gas chromatography (GC) machines first became available commercially, they cost hundreds of thousands of dollars to purchase and to operate, allowing only elite universities and private laboratories to use this equipment. Both machines still generally cost in the thousands of dollars range, but are much more reasonably priced.⁴⁸ Today, a quick internet search can find a company an NMR sample, shipped and tested for under \$100, which is a fraction of the cost to file for a trademark in the first place.⁴⁹ All things considered, sending a fragrance sample to the lab for a minimal fee to protect a business investment in a nontraditional scent mark before filing for a nontraditional scent mark is far preferable to costly litigation that could have been easily prevented.

V. COSTS OF LITIGATION

It is no secret, especially to trademark holders, that litigation is an expensive and arduous process. After taking into consideration attorney's fees, the potential years spent on negotiations, the in-house resource spend, and damages paid to a counterparty, generally the last thing that a company wants to do is infringe on another trademark holder, whether intentionally or unintentionally. Intellectual property litigation disputes can be particularly costly, especially when it comes to the exorbitant damages which can be awarded by juries to trademark holders.⁵⁰ The statute particular to trademark law, which makes in-house corporate attorneys cringe and law firm partners salivate, emanates from the Lanham Act: "plaintiff shall be entitled to recover (1) defendant's profits, (2) any damages sustained by the plaintiff, and (3) the costs of the action."⁵¹ If

48. GC Systems Listings Website, LABX, <https://www.labx.com/gc-systems>.

49. *Process NMR Associates Price Scheduling (Effective August 2016)*, PROCESS NMR ASSOCIATES LLC, <https://www.process-nmr.com/price-schedule/> (last visited Apr. 6, 2023).

50. See generally Michael J. Powell, *Changing Trends in IP Disputes*, in NAVIGATING INTELLECTUAL PROPERTY DISPUTES: LEADING LAWYERS ON PROTECTING IP ASSETS, PREVENTING AND RESOLVING DISPUTES, AND UNDERSTANDING RECENT REGULATIONS (INSIDE THE MINDS) PAGE NUMBER THAT ARTICLE STARTS ON IN BOOK (Thomson Reuters Publishing, 2009).

51. Lanham Act, 15 U.S.C. § 1117(a).

a defendant has been infringing for a long period of time, and has realized a significant profit from infringing on the trademark of another, massive damages awards are foreseeable, especially among larger companies. A perfect example of this scenario is shown in the case *Variety Stores, Inc. v. Wal-Mart Stores, Inc.*⁵² In this case, Variety Stores (Variety) was the rightful owner of valid trademarks “The Backyard,” “Backyard,” and “Backyard BBQ” when referring to “lawn and garden equipment, grills, and grilling products.”⁵³ Wal-Mart, going against the advice of their intellectual property counsel, went forward selling grills and grilling supplies with the “Backyard” mark to the tune of \$45 million for Walmart’s trademark infringement and \$50 million for sales of the infringed goods.⁵⁴

Trademarks of all types are subject to this type of zealous protection, as shown in *Stone Brewing Co. v. MillerCoors*.⁵⁵ Here, Stone Brewing alleged trademark infringement against MillerCoors for use of their “Stone” trademark, relating to beverages.⁵⁶ The jury sided with Stone Brewing, awarding the craft brewery \$56 million in damages because of the trademark infringement.⁵⁷ These two instances of trademark infringements, resulting in significant awards to the trademark holders, are far from anomalies, as the judicial system seems to be content in punishing infringers as a means of equitable remedy.

Though no case yet exists for trademark infringement of a nontraditional trademark, massive awards for damages in traditional trademark cases are reason to believe that a jury wouldn’t hesitate in making a similar award, when the opportunity arises. No matter the outcome of such a hypothetical case, the alleged infringer will always “lose,” even if the jury rules in their favor, when considering steep attorney’s fees and company payroll hours, as well as poor press that would be sure to follow from such a case. However, a case regarding infringement of a nontraditional scent trademark would be much more susceptible to validity attacks, as secondary meaning is a significantly higher bar to achieve than a traditional trademark. Additionally, an appellate court may consider taking up such a case in an effort to narrow the scope of a nontraditional scent trademark.

52. Julianna M. Charpentier & William J. Egan, *Jury Awards 95.5M in Trademark Infringement Case*, THE NATIONAL LAW REVIEW (Mar. 12, 2019), <https://www.natlawreview.com/article/jury-awards-955m-trademark-infringement-case>.

53. *Id.*

54. *Id.*

55. Bianca Bruno & Hillel Aron, *Jury Hands Stone Brewing \$56 Million in Trademark War with MillerCoors*, COURTHOUSE NEWS SERVICE (Mar. 25, 2022), <https://www.courthousenews.com/jury-hands-stone-brewing-56-million-in-trademark-war-with-millercoors/>.

56. *Id.*

57. *Id.*

To counter this possibility as a trademark holder, it would be prudent to supplement a nontraditional trademark application, with measurements of the chemical formula or mixture, such as shown in the aforementioned ‘841 trademark.⁵⁸ If the alleged infringer’s scent being used was similar enough to a trademark, like the ‘841 trademark, the probability that a court will not hold the mark to be overbroad increases, provided a secondary meaning is found. Regardless of the outcome, the substantial trademark infringement awards that juries are consistently pushing out should give companies pause when evaluating nontraditional trademarks in their space.

When considering entering the nontraditional trademark space, both trademark holders and competitors should not overlook the sheer costs involved. For both sides, the attorney’s fees will be high, as the litigation process is expensive. On the nontraditional scent trademark holder side, the costs of filing for the trademark and defending it might go up in smoke if the jury rules against. All the time, effort, and money spent registering and using the scent mark may quickly be found to be wasted. Conversely, a competitor may be found liable for millions of dollars in damages if the jury finds trademark infringement, presuming current trademark damages awards are any indication of how a nontraditional scent trademark battle would go.

To decrease the chances of litigation arising in the arena of nontraditional scent trademarks, trademark applicants should be required to include a description of the chemical formula or mixture used in the scent the applicants send to the USPTO before a trademark can be granted. This description will allow trademark holders a narrower, more likely to be valid, mark, while simultaneously warning competitors not to infringe on their scent mark. By adding a chemical formula or mixture description requirement, the government can get ahead of, and prevent, any litigation that may arise, ultimately saving the time, effort, and money for all parties involved.

VI. CONCLUSION

All in all, the present is the best time to shore up the description requirements to obtain a nontraditional scent trademark that has achieved secondary meaning. Just like the history of trademarks in the United States, the future of technology, marketing, and science can be rather unpredictable, so it is better to be proactive than reactionary. Poorly described, non-standardized, nontraditional trademarks, such as sound and color, have caused, and will continue to cause, issues at the USPTO without further intervention. As of September 7, 2023, just 16 scent trademarks were still marked “live” by the

58. NIDCD, *supra* note, 25.

USPTO, a number that seems certain to climb over the coming decades as businesses look to further separate themselves from their competition. Since a relatively small number of scent marks today are active, it is logical to modify the USPTO description requirement sooner rather than later, to avoid a preventable disaster of endless litigation. By moving to a standardized, chemical-based description requirement, coupled with the currently required description, a more objective standard is achieved. This heightened prerequisite will also allow those who are not able to smell, both temporarily and permanently, to access the nontraditional scent trademark database in a more approachable manner. In the long run, a shift towards adding chemical formula requirements to scent trademark descriptions will prevent both intentional and unintentional trademark infringement claims.