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abstract

Trademarks reflect our lifestyle like no other intellectual property right. Traditional trademarks in the form of words, pictures, three-dimensional forms and colors today still enjoy great popularity in the field of cosmetics, detergents and cleaners. However, in times when manufacturers and traders offer a plethora of products and the brand awareness of the customer increases, also the demand for signs with high prestige and recognition value will increase. Since 1 October 2017 European trademark applications and since 14 January 2019 national German trademark applications no longer have to be capable of graphic representation. As a result, new forms of trademarks open imaginative possibilities for companies to assign the goods and services they offer to their company. However, this liberalization does not cover all potentially interesting forms of trademarks. In particular, olfactory marks are still excluded from registration because the European Union Intellectual Property Office (EUIPO) as well as the German Patent and Trademark Office (DPMA, Deutsches Patent- und Markenamt) both take the position that a smell cannot be clearly and unambiguously identified with currently available technology. In this article, we report which additional forms of trademarks are now available and how they can be used effectively in the field of cosmetics, detergents and cleaning agents.

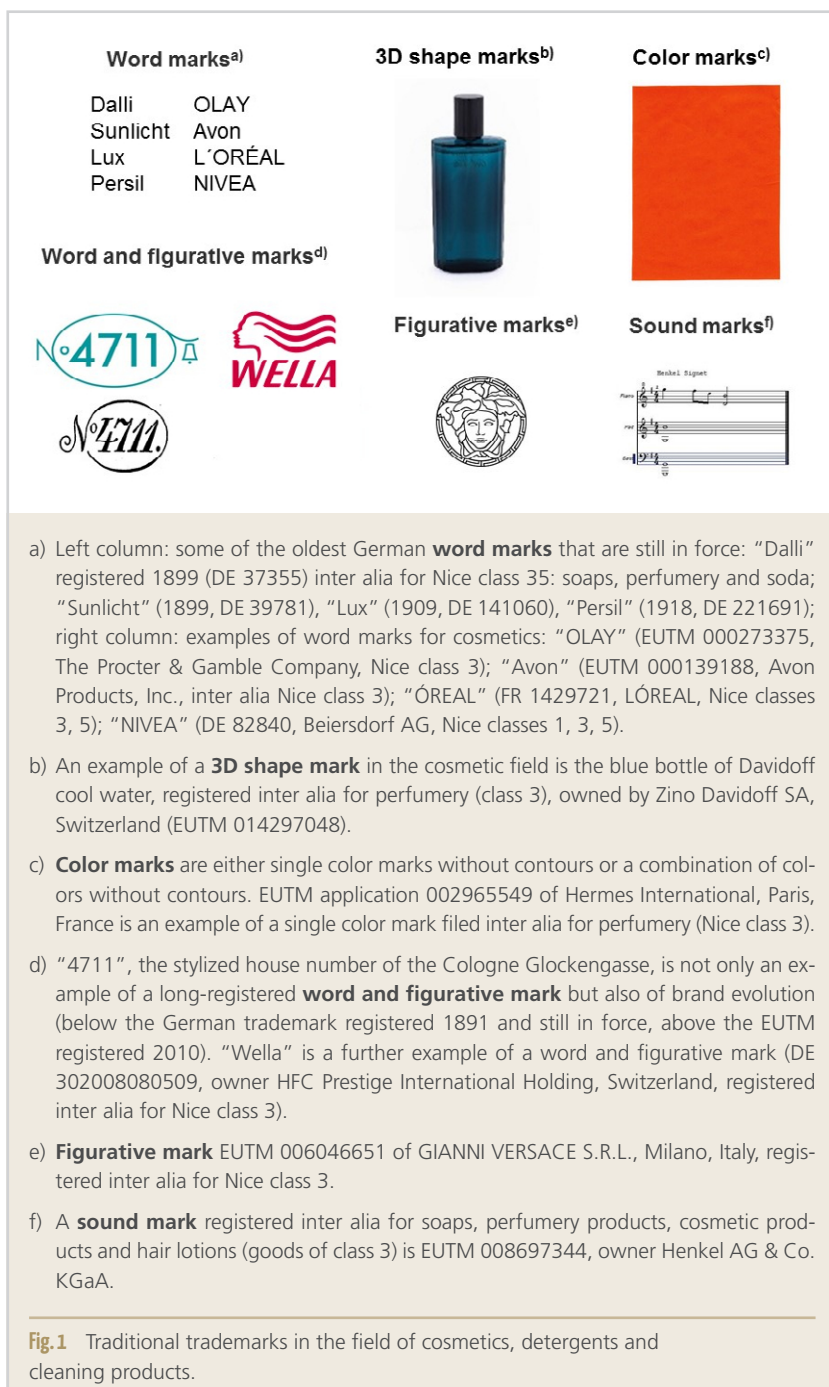
Introduction

Consumers identify with brands. Brands are characteristics that represent the reputation of a company and make its products recognizable in the public eye. They are therefore a decisive orientation for customers when making their purchase decisions and important for the long-term success of a company. A trademark designates those aspects of a brand that are protected legally and that uniquely identify goods and services to a particular company. For a long time, the stock of signs available as potential trademarks has been limited to words, pictures and combinations thereof. In the course of time, other signs like sounds, three-dimensional shapes and colors were admitted for registration as trademarks (Fig. 1). However, until recently one important requirement for European and German trademark applications and in most other jurisdictions was that only signs capable of being represented graphically were admitted for protection [1]. Nevertheless, traditional trademarks have enjoyed great popularity in the field of cosmetics, body cleaning and care, laundry and home care right from the start. In Novem-

ber 1874, the first Trademark Protection Act was passed in the German Reichstag and came into force on May 1, 1875. Some of the oldest brands at all protect products in this field, a couple of them being over 100 years old and still in force today [2].

New Sensual Trademarks for Cosmetics

As product ranges continue to grow and consumers become ever more brand-conscious, the demand for prestigious and highly recognizable signs increases too. This need is met at least in part by changes in European and German trademark law. Already since 1 October 2017 when submitting an EU trademark application the graphical representation requirement no longer applied [3]. On 14 January 2019 the German Trademark Law Modernization Act (MaMoG) came into force transposing the amendments to EU trademark law into German national law (Fig. 2) [4].



This means that, from that date, signs can be represented in any appropriate form using generally available technology, e.g. in a standard audio or picture format as long as the representation is clear, precise, self-contained, easily accessible, intelligible, durable and objective. **Dropping the graphical representation requirement is a paradigm shift!** The question of the admissibility of a trade mark form has changed from the definition of the means of representation (graphic) to the definition of the objective of representation (clearly and unambiguously identifiable). New trademark forms that cannot be represented graphically are now admitted for registration. This opens up a whole new world of possibilities for particularly original and aesthetical marks for cosmetics. These include motion marks, multimedia marks and holograms. Motion marks according to the definition of EUIPO are trademarks that comprise a movement or a change in the position of the elements of the mark. A motion mark can depict the movement of certain objects or figures and may be presented e.g. by a video file showing the movement or change of position or by a sequence of still images. Whereas motion marks do not include sound, multimedia marks consist of a combination of image and sound and may be represented by submitting an audiovideo file. Hologram marks consist elements with holographic characteristics and can be represented by submitting a video file or a graphic or photographic reproduction containing different views that show the holographic effect. **Fig. 3** shows some representative examples of new trade mark shapes which have actually been filed.

Smell/Olfactory Marks are Still not Permitted

Unfortunately, the afore-mentioned liberalization regarding the graphical representation requirement does not yet cover all signs of particular interest for cosmetics, detergents and cleaning agents. The standards set out in Article 3(1) EUTMIR demand that the claimed sign must be clearly and unambiguously identified with generally available technology. In view of this demand, non-traditional trademarks in the form of signs which address senses other than sight and/or hearing, like smell marks, taste marks or



tactile marks, still cannot be protected as EU trademarks. The following examples for the representation of smell marks are actually regarded as non-satisfactory means of representation for EU trademark protection:

Representation and Description in Words

Up to now, only in one single case more than 20 years ago was the literal description of an odor (the smell of fresh cut grass for tennis balls) considered suitable to describe an olfactory sign sufficiently clearly and precisely [5]. However, this no longer corresponds to current practice. In a more recent decision the smell of ripe strawberries was not admitted into the register of European trademarks (Fig. 4). The Court considered that the smell of strawberries varies from one variety to another and the description “smell of ripe strawberries” can refer to several varieties and therefore to several distinct smells. The description was found neither unequivocal nor precise and did not eliminate all elements of subjectivity in the process of identifying and perceiving the sign claimed [6].

Chemical Formula

Representation by chemical formulae is also deemed not sufficient, as the chemical composition (i.e. the recipe of the olfactory composition) defines the substance itself or a mixture thereof and not its scent. According to the official opinion, if at all, only an absolute expert is capable of deducing an odor from a chemical formula. It is held that even then, the representation by chemical formula does not fulfil the demand for clarity and accuracy, as the same substance or mixture of substances delivers diverse odors at distinctive temperature, concentration, fixation, etc.

Deposit of a Sample

After the elimination of the graphical representation requirement one conceivable possibility to represent smells in compliance with Article 4 EUTMR would be the deposition of a sample. However, the actual position of EUIPO is that scent samples do not provide the stability and durability required for trademark protection and Article 3(9) EUTMR [7] specifically excludes the filing samples.

However, this is surely not the last word on this subject as there is an ongoing demand of the applicants for this kind of trademarks and other countries, in particular the United


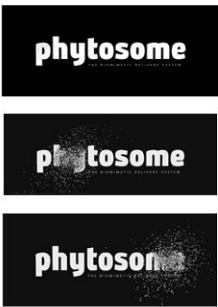

Hologram ^{f)}	Motion ^{g)}	Multimedia ^{h)}
		
<p>f) An example of a hologram mark in the cosmetic field is the sign PLANTE SYSTEM, registered inter alia for soaps and perfumery (class 3), owned by Laboratoires ARKOPHARMA, France (EUTM 012383171). The trademark consists of a hologram composed of the text “PLANTE SYSTEM FRANCE” and four circles, in silver relief on violet holographic paper with highlights placed horizontally.</p> <p>g) Motion marks depict the movement of objects or figures and may be presented as film, recording or a moving logo. An example in the cosmetic field is EUTM 018061460 “phytosome”, registered inter alia for cosmetics (class 3), owned by INDENA S.p.A .</p> <p>h) A multimedia mark is directed to the combination of image and sound. So far (June 2020), there are no multimedia marks filed in the cosmetic area with the DPMA or EUIPO. An example of a multimedia mark is EUTM 017279704, registered for services in intellectual property, owned by IFORI, Belgium.</p>		

Fig.3 New trade mark shapes.

	
<p>Fig.4 Important decisions regarding smell marks: Permitted (single case 1999): “The odor of freshly cut grass” Rejected (current official view): “The odor of a ripe strawberry”</p>	

States, have a more liberal registration practice. Here, the creativity of the applicants is called for in order to be able to identify odors in the future, for example on the basis of a system analogous to the systems used to identify a certain color.

Excursus: Fragrances as Intellectual Property

Fragrances, whether they are intended for the fine fragrance market segment or as component of cosmetics, personal and home care products are a valuable economic good. The perfume industry creates fragrances that add value to a wide variety of products. The fragrance of a product is an essential factor in its success, as it conveys the characteristics of a brand in a uniquely emotional way. Precious perfumes are the epitome of luxury and create a sense of well-being for

their users. But not only perfumes but also fragrances for the large market of everyday products, such as detergents, fabric softeners, cleaning agents, room fragrances, and personal care products, are an essential recognition feature. All these products usually contain their own scent composition, which frequently is a mixture of different scents and for more complex perfumes can contain 20 or more different components. There is therefore a great need for an effective monopolization of fragrances.

Trademarks cannot Protect Fragrances per se

The aim of a smell mark is to monopolize an olfactory impression induced in humans for the purpose of allocating certain goods and services to a specific undertaking. Even if smell marks were allowed, they could only serve the fundamental purpose of each trademark, which is to associate certain products with a specific undertaking. A fragrance itself (e.g. a perfume) cannot be protected as a trademark. Thus, both European and German trademark law stipulate that a trademark cannot be a form that is determined by the nature of the product itself [8]. The autonomy of the trademark in relation to the product necessarily follows from the identifying function of the trademark. The mark which, as a distinctive sign, identifies products on the market must not be identical to the product which it identifies. Therefore, a fragrance as such can only be monopolized by other intellectual property rights [9]. However, one must be aware that each type of intellectual property right has its own aspects and that only trademark protection is suitable and intended to protect signs that are capable of distinguishing the goods or services of firms.

Patent Protection

Patents are granted for any inventions in all fields of technology [10]. As a reward for disclosing his invention the owner of a patent receives a temporary limited monopoly of exclusive use, which lasts up to a maximum of 20 years. Product patents encompass all types of objects, including a single chemical substance (e.g. a single fragrance), a mixture of chemical substances (e.g. a mixture of fragrances or the complete recipe of a perfume), apparatuses (e.g. a perfume dispenser), etc. No other person may, without the patent owner's consent, use the patented product, by making, offering for sale, putting on the market or importing it for the mentioned purposes, or possessing it [11]. The problem is that in order to obtain patent protection, the claimed subject-matter has to be new and must involve a sufficient inventive step. Many single fragrances or simple scent mixtures would very well be suitable as smell marks, but fail because of this hurdle of patent protection. Furthermore, often perfume manufacturers will not want to reveal their specific formulas, i.e. the qualitative and quantitative composition of a perfume, for a limited period of patent protection. In order not to give competitors and especially product pirates the information needed to copy a perfume, frequently the path of secrecy as trade secret is cho-

sen. However, for the protection of new aroma compounds and their use in the production of (unspecified) fragrance mixtures, patent protection is a suitable means of obtaining a protection period of up to twenty years.

Copyright

In Germany copyright is intended to protect authors of works in the literary, scientific and artistic domain [12]. Protected works include written works, musical works, speeches and artistic works, including e.g. works of architecture, photographic and cinematographic works and illustrations of a scientific or technical nature, such as drawings, plans, maps, sketches, etc. It is the author's own intellectual creation that constitutes works within the meaning of the Copyright Act. So the question rightly arises why a perfume should not also enjoy copyright protection. This question has not yet been decided by German courts. In a decision from 2006 the Dutch Supreme Court dealt with whether a perfume (Lancome's "Tresor") enjoys protection against a not exactly identical imitation ("Female Treasure" produced by Kecofa B.V.). The Court held that Lancome's Tresor was protected by copyright and was infringed by the counterfeiting product using 24 of Tresor's 26 ingredients [13]. On the other hand, the Cour de Cassation, France's highest civil court, ruled in 2006 without further explanation that "the fragrance of a perfume, which proceeds from the simple implementation of a know-how, does not constitute the creation of a form of expression that can benefit from the protection of copyright" [14]. According to the authors, the copyright protection of fragrances can be affirmed. In view of the contradictory decisions of different jurisdictions the advice can only be to rely at least additionally on copyright law as one potential claim basis if a fragrance is subject to counterfeiting.

Acknowledgment

A part of this publication was shown as a poster at the 66th SEPAWA Congress, 23–25 October 2019, Berlin, Germany. We would like to thank Oliver Bükler, KnowEx media-consulting GmbH, for the design of the title graphic.

References

- [1] Before it was amended by the German Trademark Law Modernization Act (Markenmodernisierungsgesetz, MaMoG) § 8 (1) of the German Trademark Act ruled: "Signs eligible for protection as a trade mark within the meaning of § 3 which cannot be depicted graphically shall be excluded from registration". A comparable regulation contained § 4 of the European Union trademark regulation (EUTMR) before Regulation (EU) No 2015/2424 entered into force: "A Community trade mark may consist of any signs capable of being represented graphically, ...".
- [2] The first perfume company to register its label as trademark was Johann Maria Farina gegenüber dem Jülichs-Platz, Cologne, Germany (EUTM 002425452, publication of seniority registration of an Italian trademark of April 15, 1870. For more information see "www.dpma.de/english/our_office/publications/milestones/aeltesterparfuemherstellerderwelt/index.html").
- [3] With Council Regulation (EC) No 40/94 of 20 December 1993, the Community trademark was created, a uniform protective right for the entire EU. After a major revision with Regulation (EU) No 2015/2424 dated 23 March 2016, now the European Union trademark regulation (EUTMR) governs the trademark system of the EU. Actually, new article 4 rules: "An EU trade mark may consist of any signs, ... provided that such signs are capable of: ... b) being represented on the Register of European Union trade marks ("the Register"), in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor".

- [4] With the German Trademark Law Modernization Act (MaMoG) the German legislator has transposed the Directive 2015/2436/EU of the European Parliament and of the Council of 16 December 2015 into German law. Actually, new § 8 (1) rules: "Signs capable of being protected as trademarks within the meaning of Paragraph 3 which are not capable of being represented in the register in such a way that the competent authorities and the public can clearly and unambiguously determine the subject-matter of protection shall be excluded from registration as trademarks."
- [5] EUTM No. 000428870 – The smell of fresh cut grass for tennis balls (class 28), Filing date 11/12/1996, Registration date 11/10/2000
- [6] EUTM No 1 122 118: Mark description: Smell of ripe strawberries, Decision 27/10/2005, T-305/04, Odeur de fraise mûre, EU:T:2005:380, § 34.
- [7] Article 3(9) of the EUTMR rules that the filing of a sample or a specimen shall not constitute a proper representation of a trademark.
- [8] Article 7, No. (1), e), i) EUTMR rules: "The following shall not be registered: signs which consist exclusively of the shape, or another characteristic, which results from the nature of the goods themselves." Corresponding § 3 Subsection 2 No. 1 German Trade Mark Act stipulates: "Signs consisting exclusively of a shape which results from the nature of the goods themselves shall not be capable of being protected as trademarks."
- [9] A. Seifert: Intellectual Property Rights in Cosmetics, SOFW Journal 06/18,144, 28-33.
- [10] The TRIPS Agreement (Agreement on Trade-Related Aspects of Intellectual Property Rights) being an annex of the agreement establishing the WTO (World Trade Organization) rules in Article 27 that patents shall be available for any inventions, whether products or processes, in all fields of technology, provided that they are new, involve an inventive step and are capable of industrial application.
- [11] Article 28 no.1 (a) TRIPS Agreement (corresponding rules are contained in the national patent law, e.g. § 9, sentence 2, no.1 German Patent Act).
- [12] German Act on Copyright and Related Rights, § 1: "The authors of works in the literary, scientific and artistic domain enjoy protection for their works in accordance with this Act."
- [13] Hoge Raad der Nederlanden, June 16, 2006, NJ 585.
- [14] Cour de Cassation, Decision of 13 June 2006, International Review on Intellectual Property and Competition Law (IIC) 2006, 988.

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