

**THE CRITERIA FOR REGISTRATION OF SCENT TRADEMARKS UNDER THE
ARGENTINE LAW ON TRADEMARKS AND
DESIGNATIONS NO. 22.362**

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ABSTRACT

This paper analyses the criteria for the registration of scent trademarks in Argentina under the *Law on Trademarks and Designations No. 22.362* of 26 December 1980. This will be done by analysing the case of *L'Oreal v. Antiall S.A. s/ Cese de Oposición al Registro de Marca*,¹ which not only examines local doctrines on scent trademarks, but also considers foreign precedents when deciding their registration in Argentina. The work includes the author's comments on the ruling and concludes with remarks on the related TRIPS² Agreement provisions on trademarks.

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¹ *L'Oreal v. Antiall S.A. s/ Cese de Oposición al Registro de Marca*, *Derechos Intelectuales No. 11*, Apéndice, (2005), pp. 231-234.

L'Oreal (applicant) claimed the scents of 'Damask', 'Cherry', 'Watermelon', 'Banana-Melon', 'Grape' and 'Cherry-Raspberry', to be applied to the packages of products under Class 3 of the Nice Classification. Antiall filed oppositions during administrative proceedings before the Trademark Office on the grounds that the scent trademarks should not be categorized as signs, were not trademarks, lacked distinctiveness and, finally, that the applicant L'Oreal did not have a legitimate interest under Article 4 of *Law No. 22.362*. Applicant and Opponent failed to reach an agreement by negotiation. Consequently, L'Oreal brought a court action to have the Antiall's oppositions set aside. Finally, Justice Wathélet ruled against Antiall (defendant) and the six oppositions were withdrawn.

² Agreement on Trade-Related Aspects of Intellectual Property Rights, 15 April 1994, Marrakesh Agreement Establishing the World Trade Organization (WTO), Annex IC. Text available on the WTO website at <http://www.wto.org>

Introduction

Non-Traditional Trademarks³ are usually classified under two main categories: 'Visible Marks' (i.e., colors, shapes, moving images/motion marks, holograms, positions⁴ and gestures⁵) and 'Non-Visible Marks' (e.g. sounds, tastes, textures and scents).

Article 1 of the *Law on Trademarks and Designations No. 22.362* provides protection for signs that may be registered as trademarks to distinguish goods and services.⁶ The criteria for registration is established in the last paragraph of Article 1, which specifies that any sign which complies with the distinctiveness requirement may be eligible for protection under *Law No. 22.362*.

The protection of scent trademarks is a new issue under Argentina's *Law No. 22.362*. Though the legislation does not explicitly mention scent trademarks, coverage of the subject matter is implied in the text.

³ See WIPO Magazine. July-August 2004. 'Beyond Tradition. New Ways of Making a Mark'. Available at http://www.wipo.int/sme/en/documents/wipo_magazine/7_2004.pdf [Accessed on 1 May 2011].

⁴ A 'position mark' is a mark that consists of figures and positions of the figure. Even if the figurative element in the mark is in itself not distinctive, the mark may have distinctiveness when attached to a product in a particular position. See http://www.jpo.go.jp/iken_e/pdf/iken_e_newtype/iken_e_sinsyouhyou.pdf [Accessed on 1 May 2011].

According to the definition by WIPO's Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications, a position trademark shall be deemed as one of non-traditional trademarks. The application for registration of such trademarks shall contain a reproduction, which shall be clear and explicit enough to enable the examiner of the Trademark Office to verify the object to be protected. In such applications, the part that needs no protection shall be marked with the dotted line. If necessary, the position where the trademark is applied shall be illustrated. Now, position trademarks can be registered as a type of individual trademarks to receive protection in some European countries, such as Germany and France.

See <http://www.ccpit-patent.com.cn/News/2009030301a.htm> [Accessed on 1 May 2011].

⁵ An example of a 'gesture trademark' is tennis player Lleyton Hewitt's characteristic hand signal. The gesture and the accompanying 'C'mon' are claimed to be known as 'doing a Lleyton'. See <http://www.australiantrademarkslawblog.com/2008/01/articles/choosing-a-brand/lleyton-hewitts-trade-marks-may-overreach/> [Accessed on 22 April 2011].

With regard to an application for the registration of a gesture mark, the representation of such a mark may consist of a single picture when the mark is treated as a figurative mark or several frames depicting the gesture, if the mark is considered a motion mark. A written description explaining the gesture may also be submitted. See Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications. 'Representation of Non-Traditional Trademarks. Areas of Convergence'. Document prepared by the Secretariat. WIPO/STrad/INF/3. Original: English. 5 May 2009. Available at: http://www.wipo.int/sct/en/meetings/pdf/wipo_strad_inf_3.pdf [Accessed on 1 May 2011].

⁶ *Law No. 22.362* Article 1: 'The following may be registered as trademarks to distinguish goods and services: one or more words, with or without meaning; drawings; emblems; monograms; engravings; stampings; seals; images; bands; combinations of colors applied to a particular place on the goods or their packaging, wrappers or containers; combinations of letters and of numbers; letters and numbers insofar as they concern the special design thereof; advertising phrases, relief having distinctive capacity; and all other signs having such capacity.' Available at http://www.wipo.int/clea/docs_new/pdf/en/ar/ar006en.pdf [Accessed on 1 May 2011].

In light of this context, this paper will discuss two main issues. The first is the appropriateness of applying the graphical representation requirement⁷ to the registration of scent trademarks in Argentina. This issue is also the subject of debate at the WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications.⁸ The second issue that will be discussed is how to comply with the ‘distinctiveness requirement’ set out in Article 1⁹ of *Law No. 22.362*.

The approach to addressing both issues will involve exploring solutions concerning the registration of scent trademarks at the domestic level by analysing rules, judicial decisions, and foreign administrative practices.

Argentine Trademark Law No. 22.362

Law No. 22.362 provides the legal framework for trademark protection in Argentina.¹⁰ It regulates their acquisition, scope and how the trademark owner’s rights can be extinguished. It also establishes criminal penalties for several types of violations relating to registered trademarks.¹¹

The Law protects any distinctive signs that are not explicitly excluded in its text¹², and which identify and distinguish goods or services in industry and commerce. In addition to preventing consumer confusion, *Law No. 22.362* is also concerned with addressing acts of unfair competition.

⁷ See First Directive 89/104/EEC of the Council, of 21 December 1988, to approximate the laws of the Member States relating to trade marks, Article 2: ‘Signs of which a trademark may consist. A trade mark may consist of any sign capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings’. Available at <http://oami.europa.eu/en/mark/aspects/direc/direc.htm>. [Accessed on 1 May 2011].

⁸ Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications, 17th Session, Geneva, 7 to 11 May 2007. Methods of Representation and Description of New Types of Marks. Available at http://www.wipo.int/edocs/mdocs/sct/en/sct_17/sct_17_2.doc [Accessed on 20 June 2010].

⁹ See footnote 6 and accompanying text.

¹⁰ See *Law No. 22.362*, Chapter I, Trademarks, Title 2, Registration Formalities and Procedure, Articles 10 to 22. Available at http://www.wipo.int/meetings/en/details.jsp?meeting_id=12643 [Accessed on 1 May 2011].

¹¹ *Law No. 22.362*, Chapter III, Illicit Acts, Title 1, Punishable Acts and Relevant Actions. Available at http://www.wipo.int/clea/docs_new/pdf/en/ar/ar006en.pdf [Accessed on 1 May 2011].

¹² *Law No. 22.362*, Article 3: ‘The following may not be registered: a) a trademark identical to one previously registered or applied for to distinguish the same goods or services; b) trademarks similar to others already registered or applied for to distinguish the same goods or services; c) appellations of origin, whether national or foreign. "Appellation of origins" is understood to mean the name of a given country, region, place or geographical area that serves to designate a product emanating there from, the qualities and characteristics of which are exclusively due to the geographical environment. An appellation of origin shall also be considered to be that which refers to a given geographical area for the purposes of particular goods; d) trademarks which are liable to induce error as to the nature, properties, merit, quality, manufacturing methods, purpose, origin, price or others characteristics of the goods or services that they are intended to distinguish; e) words, drawings and other signs that are contrary to morality or public order; f) letter, words, names, distinctive signs and symbols that are used or must be used by the State, provinces and municipalities and by religious and health organizations; g) the letters, words, names or distinctive signs that are used by foreign States and international bodies recognized by the Argentine Government; h) the name, pseudonym or portrait of a person, without his consent or that of his heirs down to the fourth degree inclusive; i) the names of activities, including names and

In order to secure a trademark, an application must be filed with the National Board of Industrial Property (INPI).¹³ Once a trademark application is filed, it is published in the Official Gazette for the purposes of notifying potential objectors to its registration.¹⁴

Oppositions to the registration of a trademark must be lodged with the National Board of Industrial Property (INPI) within 30 days from the publication, as provided for in Section 12.¹⁵

Within the said period, the National Board of Industrial Property (INPI) carries out a search of the trademark and renders an opinion as to its registrability.¹⁶

The applicant is to be given notice of the oppositions filed, and of the objections that may have been raised to the application.¹⁷

If oppositions are unresolved by negotiation between applicant and opponent within the one-year term fixed in Section 16¹⁸, the applicant must proceed according to Article No. 17 of *Trademark Law No. 22.362*, which provides that legal action¹⁹ to have an opposition set aside will be filed with the National Board of Industrial Property. Within ten days of receiving the Bill of Complaint, the Board will forward it, together with the attachments and a copy of the administrative proceedings relating to the opposed mark, to the Federal Court of Civil and Commercial Matters of the Federal Capital.

company names which describe an activity, to distinguish goods; nevertheless, acronyms, words and other signs having distinctive capacity and forming part of such names may be registered to distinguish goods or services; j) advertising phrases that lack originality’.

Available at http://www.wipo.int/clea/docs_new/pdf/en/ar/ar006en.pdf [Accessed on 1 May 2011].

¹³ *Law No. 22.362*, Article 10: ‘Persons wishing to obtain registration of a trademark shall file an application for each class in which registration is sought; the application shall include their name, domicile and a special address stipulated in the Federal Capital, a description of the trademark and a statement of the good or services that it is intended to distinguish’.

Available at http://www.wipo.int/clea/docs_new/pdf/en/ar/ar006en.pdf [Accessed on 1 May 2011].

¹⁴ *Law No. 22.362*, Article 12: ‘Where the Application Authority finds that the legal formalities have been complied with in respect of the filing of an application for registration, it shall publish the application for one day in the Trademark Gazette at the applicant’s expense’. Article 13: ‘Oppositions to the registration of a trademark must be lodged at the National Board of Industrial Property within 30 calendar days from the publication provided for in Section 12’.

Available at: http://www.wipo.int/clea/docs_new/pdf/en/ar/ar006en.pdf [Accessed on 1 May 2011].

¹⁵ In accordance with Article 13 of *Law No. 22.362*, paragraph 1.

¹⁶ In accordance with Article 12 of *Law No. 22.362*, paragraph 2.

¹⁷ In accordance with Article 15 of *Law No. 22.362*.

¹⁸ *Law No. 22.362*, Article 16: ‘After one year has passed from the notification period provided under Section 15, the application shall be declared abandoned if any of the following cases: (a) if the applicant and opponent have failed to reach an agreement enabling and administrative decision to be taken, and if the applicant fails to institute court action within the said term; (b) if the court action instituted by the applicant lapses’.

¹⁹ In accordance with *Mediation Law No. 24,573*, of 4 October 1995, enacted 25 October 1995, trademark conflicts leading to a court action are required to have exhausted a prior stage of mediation. In other words, potential plaintiffs ought to request mediatory proceedings before bringing a court action. See ‘Compulsory Mediation in Argentina’ by Martín Echeverry.

Available at <http://www.etccheverry.com/compulsory.html> [Accessed on 1 May 2011].

Also see M. Borgarello, ‘Mediación y régimen marcario’, *Revista Jurídica La Ley. Suplemento de Resolución de Conflictos*, RC (1997), 3-5.

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The said Court will assign the Federal First Instance Court that will decide on the stated grounds of the opposition.²⁰

It is worth noting that the National Board of Industrial Property (INPI) does not examine or adjudicate on the grounds of the opposition.²¹ The judge assigned to the case rules on the matter, and then informs the National Board of Industrial Property (INPI) of the outcome.²²

When no notice of opposition is filed within the period referred to in Article 12 of *Law No. 22.362*, or all opposition proceedings are withdrawn or decided in favor of the applicant, the Registrar will then be in a position to decide whether to register the trademark.

The registration²³ is granted after the Trademark Office determines whether the application complies with the formal requirements of *Law No. 22.362*. The registration is valid for ten years and may be renewed for subsequent ten-year periods.

When trademarks have been granted in violation of a legal provision, they may only be annulled or extinguished through a court order in accordance with Article 23(c) of *Law No. 22.362*.

Administrative decisions refusing a trademark registration may be appealed before the First Instance Court on Civil and Commercial Matters. The matters are tried in accordance with the rules for ordinary proceedings.²⁴

Registration of scent trademarks in Argentina

Under Article 1 of *Law No. 22.362*, traditional trademarks have included:

... one or more words, with or without meaning; drawings; emblems; monograms; engravings; stampings; seals; images; bands; combinations of colors applied to a

²⁰ During the opposition procedures before the Federal First Instance Court on Civil and Commercial Matters, opponents to the registration of a trademark may expand the scope of their challenge in their initial Bill of Complaint.

²¹ Unless the parties by common consent waive the judicial action provided for in Section 17 of *Trademark Law No. 22.362*, within the one-year term fixed in Section 16, and communicate this to the National Board of Industrial Property, accordingly with Article 19 of *Law No. 22.362* which provides: ‘Where an opposition has been filed, the applicant and opponent may, by common consent, waive judicial action and, within the one-year term fixed in Section 16, communicate this to the National Board of Industrial Property. A decision shall then be rendered, after both parties have been heard and any pertinent evidence has been submitted, and such decisions shall not be subject to appeal. The regulation shall establish the procedure to be followed’. It is important to note that L’Oreal and Antiall S.A. did not opt to follow the alternative proceeding before the National Board of Industrial Property.

²² In accordance with Article 18 of *Law No. 22.362*.

²³ *Law No. 22.362*, Article 4: ‘The ownership of a trademark and the exclusive right to use it shall be acquired through registration. In order to become the registered owner of a trademark, or exercise the right to oppose the registration or use thereof, it shall be essential that the applicant or opponent have a legitimate interest’.

Available at http://www.wipo.int/clea/docs_new/pdf/en/ar/ar006en.pdf [Accessed on 1 May 2011].

²⁴ In accordance with Article 21 of *Trademark Law No. 22.362*, it must be lodged within 30 working days from notification of the trademark rejection, before the National Board of Industrial Property, which will proceed as established in Section 17.

particular place on the goods or their packaging; wrappers; containers; combinations of letters and of numbers; letters and numbers insofar as they concern the special design thereof; advertising phrases; reliefs having distinctive capacity and all other signs having such capacity.

Scent trademarks are trademarks that are perceptible fragrances or scents²⁵, and constitute one example²⁶ of 'Non-Traditional Signs'.²⁷ The first applications for scent trademarks in Argentina were filed on 17 November 1997 by L'Oreal. The filings were for the scents of 'Damask', 'Cherry', 'Watermelon', 'Banana-Melon', 'Grape', and 'Cherry-Raspberry', as applied specifically to the packages of hair lotion products under Class 3 of the Nice Classification.²⁸

The applications became the subject of a third-party opposition procedure conducted before a First Instance Court on Civil and Commercial Matters²⁹ in *re L'Oreal v. Antiall S.A. s/ Cese de Oposición al Registro de Marca*³⁰. The ruling was delivered on 17 June 2004 by Justice Marcelo Wathélet. Despite the fact that the defendant, Antiall, failed to appear before the court, Justice Wathélet proceeded to rule on the merits of the objection. He decided against the Antiall's opposition.

²⁵ *Trademark Law No. 22.362* does not expressly refer to the registration of scent trademarks. However, since the law adopts wide criteria when referring to possible distinctive signs, many authors (e.g. Otamendi, among others) support the registration of olfactory signs. Dr. Otamendi states that if the scent in question is not the necessary scent of the product itself, it should be eligible for registration. He concludes that the reasoning also applies to perfumery products, where the scent sometimes determines the selling power. J. Otamendi, *Derecho de Marcas*, (Editorial Lexis Nexis, 2006), page 57.

²⁶ Although the case-law in study allowed the claimed scents under *Law No. 22.362*, the said 'Non Traditional Signs' suggest many questions regarding their ability to comply with the function of identifying origin among competitors, and eliminating consumer confusion. See *infra* footnotes 46 and 65 and accompanying texts.

²⁷ On this matter, it has been said that 'Non-Traditional Trademarks' are very much traditional to the extent they have been used since the Middle Ages when the profession of 'crieur' (shouter) was regulated and organized under guilds. Crieurs had the function of advertising out loud the products and the prices of taverns and wine shops. They performed a function of controlling prices (the prices of wine were regulated in the Middle Ages) but they also performed a function of advertising and distinguishing products as well as of attracting clients into the shops that hired them. See N. Pires de Carvalho, *A Estrutura dos Sistemas de Patentes e de Marcas - Passado, Presente e Futuro* (Rio de Janeiro: Editorial Lumen Júris, 2009), page 635.

²⁸ Class 3 of the Nice Classification Eighth Edition specifies that: 'Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices'. On the other hand, under the General Remarks section, it provides alternative criteria. Available at <http://www.wipo.int/classifications/nivilo/nice/index.htm?lang=EN#> [Accessed on 1 May 2011].

²⁹ In Argentina, the Federal First Instance Court on Civil and Commercial Matters is the first one to study a legal dispute. It may make findings of fact and law. The Second Instance Court is a Court of Appeals which may make findings of law, but may not make any new findings of facts.

³⁰ L'Oreal was the applicant who claimed the scent trademarks to be applied to the packages of hair lotions of Class 3 of the Nice Classification, during Administrative Proceedings before INPI. Then it was the plaintiff before the First Instance Court of Civil and Commercial Matters that decided on the grounds of Antiall's oppositions to the smell trademarks registration.

Antiall was the opponent during Administrative Proceedings before INPI, and the defendant who failed to attend the court proceedings.

The Ruling

Justice Wathelet reviewed the arguments Antiall had made during the administrative proceedings before the Trademark Office. These included claims that the L'Oreal applications of the scent trademarks should not be categorized as signs, were not trademarks, lacked distinctiveness, and that L'Oreal did not have a legitimate interest under Article 4³¹ of *Law No. 22.362*.

Justice Wathelet noted that L'Oreal had also submitted documentary evidence to demonstrate the originality of its products and the distinctiveness of those signs which identified them. This was specifically with respect to the claimed scents, which when applied to the hair lotion packages, were alleged to constitute differentiating assets of the claimed trademarks. L'Oreal had argued that 'shapes', 'colors' and 'scents' were all eligible for protection under *Law No. 22.362*.

After careful consideration of (i) Antiall's³² and L'Oreal's arguments and (ii) documentary evidence submitted by L'Oreal before the Court, Justice Wathelet concluded that L'Oreal had a legitimate interest under Article 4³³ of *Law No. 22.362*.

In his decision, he held that, as applied to product packaging, the scents constituted 'signs' which met the distinctiveness requirement that was the prerequisite criterion for trademark protection under Article 1³⁴ of *Law No. 22.362*.

In support of his conclusion, Justice Wathelet cited Article 15 of the TRIPS Agreement³⁵, which provides that:

Any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark. Such signs, in particular words including personal names, letters, numerals, figurative elements and combination of colours as well as any combination of such signs, shall be eligible for registration as trademarks. Where signs are not inherently capable of distinguishing the relevant goods or services, Member may make registrability depend on distinctiveness acquired through use. Members may require, as a condition of registration, that signs be visually perceptible.³⁶

³¹ See *supra* footnote 23 and accompanying text.

³² Antiall's arguments were submitted when filing opposition to L'Oreal's trademarks during administrative proceedings before the Registrar's Office, on the grounds that: (i) L'Oreal's applications should not be categorized as signs; (ii) were not trademarks; (iii) lacked distinctiveness; and (iv) L'Oreal did not have a legitimate interest under Article 4 of *Trademark Law No. 22.362*.

³³ See *supra* footnote 23 and accompanying text.

³⁴ See *supra* footnote 6 and accompanying text.

³⁵ Available at http://www.wto.org/english/docs_e/legal_e/27-trips_04_e.htm

[Accessed on 1 May 2011].

³⁶ 'The signs that can constitute trademarks (i.e., that can assist consumers in selecting the specific goods and services they wish to buy) are those that can distinguish goods and services from other goods and services. In other words, only distinctive signs can constitute trademarks'. N. Pires de Carvalho, *The TRIPS Regime of Trademarks and Designs*, Second Edition, Kluwer Law International BV (The Netherlands: 2011), page 284.

It is also important to note that visual perceptibility is not a mandatory requirement of *Law No. 22.362*.

Justice Wathelet also cited commentator Dr. Jorge Otamendi³⁷, who acknowledged that *Law No. 22.362* did not expressly include any provision regarding scents, fragrances or scent trademarks. However, Dr. Otamendi argued that anyone who provided a package with a special scent was entitled to exclusively claim that scent under *Law No. 22.362*.

Justice Wathelet pointed to Dr. Otamendi's observation that Article 1 of the law mentioned 'all signs having distinctive capacity'. A limitation in the interpretation of the law would impede the registration of signs that complied with the distinctiveness criteria, and would thus facilitate the piracy of successful products. In Dr. Otamendi's view, the wording of Article 1 allowed for the adoption of broad criteria for trademark registration. Consequently Dr. Otamendi concluded that olfactory signs were protectable subject matter under Article 1³⁸ of *Law No. 22.362*.

Justice Wathelet also noted Dr. Otamendi's qualification that the applicant for the scent trademark would need to describe the scent in question as accurately as possible: (i) either in words by referencing the object associated with the smell, or (ii) by providing the chemical components that will produce the scent when applied to the product packaging.

Moreover, Justice Wathelet cited doctrines developed in the European Union concerning the graphical representation requirement contained in Article 2 of the First Council Directive 89/104/EEC.³⁹ The Article states that 'a trade mark may consist of any sign capable of being represented graphically'.⁴⁰

Justice Wathelet explained that the Office of Harmonization in the Internal Market (OHIM)⁴¹ had rejected a trademark consisting of the 'Scent of Fresh Cut Grass' in *Case R 156/1998-2 Vennootschap onder Firma Senta Aromatic Marketin*⁴² for distinguishing tennis balls because the scent could not be graphically represented through any determined figure or form.

However, this decision was later reversed by the Second Board of Appeal on 11 February 1999. The reversal was made on the grounds that in contrast to 'Three Dimensional and Color Marks', which are dealt with under Rule 3 of the Implementing Regulation⁴³, there had been no conditions laid down in the Implementing Regulation concerning the representation of scent trademarks.

³⁷ See J. Otamendi, *Derecho de Marcas* (Buenos Aires, 2006), pp. 56-57.

³⁸ See *supra* footnote 6 and accompanying text.

³⁹ See *supra* footnote 7 and accompanying text.

⁴⁰ Justice Wathelet stressed that there is no doubt that under the *Community Trade Mark Act* the graphic representation requirement is mandatory, but it is not under *Trademark Law No. 22, 362*.

⁴¹ Available at <http://oami.europa.eu/ows/rw/pages/index.en.do> [Accessed on 1 May 2011].

⁴² Community Trade Mark application No. 428870. The Decision of the Second Board of Appeal of 11 February 1999 is available at

http://oami.europa.eu/legaldocs/boa/1998/EN/R0156_1998-2.pdf [Accessed on 1 May 20 2011].

⁴³ <http://oami.europa.eu/ows/rw/resource/documents/CTM/regulations/2868en-codified.pdf> [Accessed on 1 May 2011].

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The issue had led to the question of whether, under the *Community Trademark Act*, the given description provided clear and sufficient information on the exact nature of the trademark when used in connection with tennis balls.

In the opinion of the Second Board of Appeals, the smell of freshly cut grass was a distinct scent which everyone immediately recognized from experience. For many, the scent reminded them of spring or summer, manicured lawns, playing fields, or other such pleasant experiences.⁴⁴

In that vein, the Board of Appeals was satisfied that the description provided for the scent trademark was sufficient to comply with the graphical representation requirement provided in the Implementing Regulation. This was the basis upon which the initial trademark refusal was overturned. The case was remitted to the examiner for further prosecution pursuant to Article 62(1) of the Community Trade Mark Regulation (CTMR).⁴⁵

In support of his decision that L'Oreal's trademarks were eligible for protection under *Law No. 22.362*, Justice Wathelet also cited the underlying reasoning of the *Case R 156/1998-2 Vennootschap onder Firma Senta Aromatic Marketing*.

Finally, Justice Wathelet noted that: 'olfactory perception is absolutely subjective, and the effective protection of the right (trademark) will be achieved as long as the Registrar adopts effective and sufficient actions.'⁴⁶ In the light of this detailed analysis, Justice Wathelet rejected Antiall's oppositions.

The Court notified the ruling against Antiall's oppositions to the National Institute of Industrial Property (INPI), in accordance with Article 18⁴⁷ of the *Trademark Law No. 22.362*.

It was on that basis that the registration process continued before the Registrar's Office. In order to provide for the effective protection of its scent trademarks with respect to future applications, L'Oreal was required to submit documents, samples and any other evidence for evaluation by the Trademark Office.⁴⁸

⁴⁴ See *supra* footnote 42 and accompanying text.

⁴⁵ *Ibid.*

⁴⁶ Dr. Wathelet might bear in mind that the registration of traditional signs has some legal consequences that were barely achieved in the case of scent trademarks.

⁴⁷ *Law No. 22.362*, Article 18: 'The judge assigned the case shall inform the National Board of Industrial Property of the outcome of the action brought to have the opposition set aside, for such purposes as may be relevant'. Available at http://www.wipo.int/clea/docs_new/pdf/en/ar/ar006en.pdf [Accessed on 1 May 2011].

⁴⁸ Scent trademarks are subject to the same prohibitions which control Trademark Law. See G. A. Sena, G. Gustavo, 'Nuevos Objetos de Protección en el Derecho de Marcas', *Derechos Intelectuales N° 11*, (Editorial Astrea, 2005), pp. 222-227.

L'Oreal submitted new descriptions for the fragrances of 'Damask'⁴⁹, 'Cherry'⁵⁰ and 'Watermelon'.⁵¹ These new descriptions not only included the scientific names⁵² of the substances or extracts from which the claimed scents were derived, but also the corresponding samples of the hair lotion packages in question.

After a brief legal report on L'Oreal's compliance with the legal requirements, the Trademark Office issued the scent registrations under *Law No. 22.362*. They also retained the packages of samples under storage, which remain hermetically sealed at the Trademark Office. This preservation measure may be interpreted as the Trademark Office's intention to clarify the scope of three of the six scent trademarks'.

In spite of the fact that no samples were deposited for applications Nos. 2.115.162, 2.115.165 and 2.115.166, covering the 'Banana-Melon', 'Grape' and 'Cherry-Raspberry' scents, they were all successfully registered by the Trademark Office under *Law No. 22.362*.

Conclusion

The L'Oreal case illustrates a highly controversial issue with no clear or universal answers to the questions of what 'scent trademarks' are, and how they should be registered.⁵³

⁴⁹ As described in Application No. 2.115.161, the trademark consists of a 'Scent of Damask' applied to the package of products under Class 3 of the Nice Classification. The scent in question is obtained by applying (i) Sage (*Salvia officinalis*) leaves extract and (ii) Chamomilla Recutita (matricaria) extract to the said packages.

⁵⁰ As described in Application No. 2.115.163, the trademark consists of a 'Scent of Cherry' applied to the package of products provided by Class 3 of the Nice Classification. The scent in question is obtained by applying Prunus Dulcis substance to the said packages.

⁵¹ As described in Application No. 2.115.164, the trademark consists of the 'Scent of Watermelon' applied to the packages of products under Class 3 of the Nice Classification. The scent in question is obtained by applying Prunus Armeniaca extract to the said packages.

⁵² The scientific need for simple, stable and internationally-accepted systems for naming objects of the natural world has generated many formal nomenclatural systems. Scientific names are very useful to identify organisms in that a given scientific name is universally used for a particular organism throughout the world. Probably the best known of these nomenclatural systems are the five codes of biological nomenclature that govern the Latinized Scientific Names of Organisms.

Available at <http://www.journal.au.edu/au techno/2001/oct2001/howto.pdf> [Accessed on 1 May 2011].

⁵³ Article 15 of the TRIPS Agreement provides: 'Protectable Subject Matter'... Members may require, as a condition of registration, that signs be visually perceptible.' The same provision is included in Article 5.2 of the Protocol on the Harmonization of Norms regarding Intellectual Property in the Mercosur Matters of Trademarks, Indications of Source and Appellations of Origin. Available at http://www.mercosur.int/msweb/Normas/normas_web/Decisiones/ES/Dec_008_095_pdf [Accessed on 1 May 2011].

For a European Union approach see <http://oami.europa.eu/en/mark/aspects/pdf/JJ000273.pdf> Judgment of the Court, 12 December 2002. Case C- 273/00. Reference to the Court under Article 234 EC by the Bundespatentricht (Germany) for a preliminary ruling in proceedings brought by Ralf Sieckmann on the interpretation of Article 2 of First Council Directive 89/104 of 21 December 1988 to approximate the laws of the Member States relating to trade marks (O j 1989 L 40, page 1). It concluded in respect of an olfactory sign that the requirements of graphic representability are not satisfied by a chemical formula, by a description in written words, by the deposit of an odour sample or by a combination of those elements. [Accessed on 1 May 2011].

THE CRITERIA FOR REGISTRATION OF SCENT TRADEMARKS UNDER THE
ARGENTINE LAW ON TRADEMARKS AND
DESIGNATIONS NO. 22.362

Under Argentine Trademark Law the criteria for trademark registration is expressly mentioned in the last paragraph of Article 1 of *Law No. 22.362*⁵⁴, which provides that any sign which complies with the distinctiveness criterion is eligible under the law.

Justice Wathelet's ruling approved of Dr. Otamendi's broad interpretation, which stated that Article 1 of *Law No. 22.362* did not include a requirement that the signs be graphically represented in order to obtain trademark protection. In support of this proposition, the judge cited Article 15 of the TRIPS Agreement and the European Union's First Directive 89/104 of the Council of 21 December 1988.⁵⁵

When Justice Wathelet said 'olfactory perception is absolutely subjective, and the real protection of the right (trademark) will be achieved as long as the Registrar adopts effective and sufficient actions' he may have been aware that current registration procedures and administrative practices before the Trademark Office were obstacles to the registration of 'Non-Traditional' signs such as fragrances.⁵⁶ Hence, Justice Wathelet's words may be understood as an implicit instruction for the Trademark Office to adopt progressive administrative practices that provide 'real' and 'effective' protection to scent marks.

However, what type of effective measures should be taken by the Trademark Office in order to comply with the judgment?⁵⁷ The Registrar's decision to request documents, evidence or samples, and the storage of L'Oreal's packages of scent samples at the Trademark Office was a positive approach to the administrative impediments of dealing with the registration of scent trademarks under *Law No. 22.362*.

The need to minimize such impediments is also recognized by Article 62.1 of the TRIPS Agreement⁵⁸, which provides that:

Members may require, as a condition of the acquisition or maintenance of the intellectual property rights provided for under Sections 2 through 6 of Part II, compliance with reasonable procedures and formalities. Such procedures and formalities shall be consistent with the provisions of this agreement.

The TRIPS Agreement does not provide a definition of 'reasonable' as used in Paragraph 1 of Article 62. Therefore, Member States enjoy some flexibility in the implementation of this requirement. However, 'reasonable' may be interpreted as imposing necessary administrative formalities that are not overly restrictive or burdensome to the applicant's efforts to protect their intellectual property rights.⁵⁹ This would include providing for the ready protection of scent trademarks as is possible under *Law No. 22.362*.

⁵⁴ See *supra* footnote 6 and accompanying text.

⁵⁵ See *supra* footnotes 7 and 40 accompanying texts.

⁵⁶ L. E. Bertone and G. Cabanellas de las Cuevas, *Derecho de Marcas, Designaciones y Nombres Comerciales*, Volumen I, (Buenos Aires: Editorial Heliasta SRL, 2003), pp. 434-435.

⁵⁷ It is worth pointing out that it was Justice Wathelet himself who brought up the issue that there could be potential problems in the scope of protection and the enforcement of the rights.

⁵⁸ Available at http://www.wto.org/english/docs_e/legal_e/27-trips_06_e.htm

[Accessed on 1 May 2011].

⁵⁹ See UNCTAD-ICTSD Project on IPRs and Sustainable Development, *Resource Book on TRIPS and Development*, (Cambridge University Press, 2005), pp. 621-622.

In the L'Oreal case, the Trademark Office also decided to grant protection for 'Banana-Melon', 'Grape' and 'Cherry-Raspberry' scents under *Law No. 22.362*. In those cases, the Trademark Office implicitly admitted that a mere written description of the claimed scents complied with *Law No. 22.362*, as had been decided in '*Case R 156/1998-2 Vennootschap onder Firma Senta Aromatic Marketing*'.⁶⁰

Consequently, noting the conditions included in paragraph V of Justice Wathelet's ruling, and the administrative decision of accepting a mere written description for three of the six claimed scents⁶¹, it is unclear if the deposit of the packages with the Registrar's Office may be interpreted as being mandatory or optional.⁶²

Though the Registrar's criteria were ambiguous, and the registration process was slow⁶³, the actions it did take were probably inspired by Justice Wathelet's ruling. This was the first to deal with such 'Non-Traditional Signs' under Argentine *Law No. 22.362*.

Finally, the case-law discussed highlights the importance of authorities in administrative offices responsible for trademark applications, when deciding the scope of trademark protection. Justice Wathelet's ruling evidences this fact.⁶⁴ This point is worth noting, as the commitment of administrative offices to the proceedings that take place before them is crucial for the efficiency of the intellectual property system.

⁶⁰ See *supra* footnote 42 and accompanying text.

⁶¹ 'Banana-Melon', 'Grape' and 'Cherry-Raspberry' scents.

⁶² The use of Examination Guidelines may be helpful for the registration of 'Non-Traditional Signs', both for applicants and examiners, in order to know how to examine and comply with legal requirements in a clear and uniform way.

⁶³ The six scent trademarks were registered on 30 January 2009.

⁶⁴ Pires de Carvalho observes that another problem associated with non-visually perceptible trademarks is in the manner to prove their existence, either for the purpose of registering them or with the objective of enforcing them. The author also remarks that one commentator has noted that the purpose of registration is to inform third parties about the existence of rights. There is a public policy dimension in such information, because only adequate publicity of property rights ensures legal security. See N. Pires de Carvalho, *The TRIPS Regime of Trademarks and Designs*, (The Netherlands: Kluwer Law International BV, 2011), pp. 307-308.

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