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The protection of olfactive marks in Mexico

Carlos Alberto Reyes of OLIVARES analyzes the application and grant process of scent marks to provide guidance on best practices for successful protection in Mexico.

Before the modifications to the Mexican Industrial Property Law (the IP Law) on May 18, 2018, the article 88 of this Law defined a mark as being a “visible sign” capable to distinguish products or services from others of the same type or category on the market. Thus, to be subject of protection as a mark, a sign had to be both distinctive and *visually perceptible*.

As we know, this definition of mark excludes from protection all non-visible signs, and the article following the mentioned above, article 89, confirm this by listing some visually perceptible signs as the ones that could constitute marks and receive protection through a mark registration, *namely*, words and visible figures, three-dimensional shapes, trade names and company or business names, and the proper name of a natural person.

The modifications of the Mexican Industrial Property Law of May 18, 2018, in force since August 10, 2018, modified this mark’s definition in article 88, determining that a mark is a distinctive sign capable to be perceived by the senses and susceptible to be represented “*in a way that shall clearly determine the object of the protection*”, which opened the way, for the first time in Mexico, to obtain protection as mark for signs that may be perceived by senses other than the sight (the so-called non-visible signs).

In agreement with this new definition of mark, the article 89 of the IP Law was also modified to list some non-visible signs that could now constitute marks, and expressly included “sounds” and “odors”. It is important to mention that this regulation was identical in our 2020’s Industrial Property Law, the so-called Federal Law for the Industrial Property Protection (hereinafter the Federal IP Law), in its articles 171 and 172.

However, no provision in the Federal IP Law, nor any later regulation, stated how to clearly define – namely, with precision and clarity – the subject matter of protection in a mark application for an olfactive mark. However, this is a crucial matter in a marks protection: how to clearly



Carlos Alberto Reyes

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determine and delimit the scope of protection requested for these marks and, what is the scope of protection when the mark registration is granted.

This is very important because it allows any person consulting the marks Registry to clearly notice the granted mark’s scope of protection, in other words, what is exactly granted registration, and, at the same time, to know the very limits of the granted exclusive rights of use. On the other side, the clear definition of the right granted should allow any examiner or officer of the Industrial Property Office (the IP Office) to determine – as objectively as possible – the existence or not of likelihood of confusion with other olfactive marks and, when there might be infringement by thirds of the granted mark.

But defining an odor is not an easy matter, for example, in wine tasting, when smelling the same wine at the same time, some persons will identify berries and cannell while others will be sure of smelling citric fruit, marmalade, and odor cloves. We all know from our own experience that something that is perceived by smell can be identified or defined very differently and in as many ways as persons are smelling the same odor at the same time. Also, the smell of some simple natural products, for example, fruits, coffee, spices, can significantly vary not only depending on the time of production but also depending on the place they were produced or the way they were processed.

How could you then clearly define the object of the protection granted for an olfactive mark for registration purposes, and, after being registered, how could a third access the mark Registry and be sure of what was exactly the subject matter of protection through such mark registration. Additionally, how could an examiner of the IP Office objectively determine the existence of a likelihood of confusion or infringement? Or how could we feasibly argue against such likelihood of confusion or infringement presumption from an examiner of the IP Office?

In this regard, the possible proposed solutions for this problem are varied, and some of them have been discarded because a reliable solution for this problem of clearly defining the object of the protection in the case of olfactive marks has not been found. Moreover, we need to take into account that our Federal IP Law **clearly requires**, in its article 171, any sign perceptible by the senses be **"capable of being represented in such a way as to enable to determine the clear and specific subject-matter of the protection"** to qualify as a mark.

The first proposed solution we can mention is to deposit the chemical formula of the olfactive mark, but this is not a feasible solution as chemical formulas cannot be available other than for a specialist in chemistry and neither a third nor an IP Office mark examiner would be able to determine the specific subject-matter of the protection granted for an olfactive mark – when consulting the marks' Registry – unless being also able to "read" a chemical formula, which is very unlikely.

The second proposed solution is to deposit a sample of the odor, but this is not a feasible solution either as the smells are not stable and durable and, as mentioned before, are also subject to interpretation. Finally, the third solution is to describe the mark in words, which is the one that has been adopted by the Mexican IP Office. In this regard, describing a smell in words can be quite easy, but, in my personal advice, it can

Résumé

Carlos Reyes joined OLIVARES in October 2008 and has more than 30 years of experience in Intellectual Property prosecution and IP litigation. His practice is now mainly focused on the areas of counseling and trademark registration. In summary, he provides counseling regarding trademark registrability bringing his experience on trademark prosecution and litigation, answering objections related to absolute and relative grounds of refusal, and preparing and filing trademark oppositions before the Mexican PTO (IMPI).

As Senior Attorney in the OLIVARES trademark team, he has helped to secure trademark protection in Mexico for several important trademarks, in particular relating to trademark distinctiveness and likelihood of confusion.

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hardly represent the mark **“in such a way as to enable to determine the clear and specific subject-matter of the protection”**.

Thus, since the very beginning, when the modifications to the Industrial Property Law came in to force on August 10, 2018, the formal requirement for an olfactive mark application is then to include a description in words of the applied-for mark. Also, to this date, the Registry shows 125 olfactive mark applications, of which only 11 have been granted registration (four of them after a Court of Appeal ordered the Mexican IP Office to register the marks after a refusal was issued). In brief, the IP Office has constantly refused registration to olfactive mark applications mainly based on the following causes of refusal:

- When according to commercial practices the odor has become a usual or generic element of the products or services and, consequently, the odor cannot accomplish any distinctive function or be identified as from a particular origin by the consumer. Under these arguments, the IP Office has refused registration to those olfactive mark applications for odors that are commonly used in relation to the purported products or services. For example, an olfactive mark application for the odor of canella in relation to class 35 retail services was refused on the basis that it is usual and expected for odors to be added in commercial establishments to improve the shopping experience, persuading the consumers to stay longer and improve the sales.
- When the odor is considered descriptive of the purported products or services and, thus, the olfactive mark cannot accomplish any distinctive function. The cited refusal cause relates the signs that, when considered as a whole, are held to be descriptive of the goods or services they intend to distinguish. Under this provision, the Mexican IP Office has refused olfactive mark applications when the odor is considered an inherent attribute or natural characteristic of the products or services. In particular, the IP Office has constantly refused mark registration under this cause for fruit odors in relation to class 32 beverages, floral or fruit odors for class 03 fabric softeners, disinfecting, and cleaning products, mint or chocolate odors for class 28 toys and pet toys, fruit, and

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species odor in relation to class 05 electrolytes, to cite some examples. In all these cases, the IP Office estimates that certain odors are not registrable as olfactive marks when the purported products naturally have them or when the consumers expect them to have odors. Thus, when having an odor is not held to be identified in relation to a particular source because the odor is natural or inherent to the product, as in the case of fruit juices or beverages, or, as in the case of fabric softeners, or cleaning or disinfecting products, when the products are normally added odors.

- In some refusal decisions, the Mexican IP Office has also argued that the applied-for olfactive marks were considered confusingly similar to another olfactive mark, that was estimated as a well-known mark. These decisions concerned the odor of chewing gum applied to children's shoes and shows the limits of the protection granted to olfactive marks derived from a description in words. That is because, how could we define what a bubblegum odor is? Taking-into-account that bubblegum can have quite varied and different odors, depending on the flavor they have, or even for the same flavor, depending on the producer.

In respect thereof, we may consider that a mark described as the **“odor of bubblegum applied to children's shoes”** allows any person to “determine the clear and specific subject-matter of the protection”, but the commented decisions from the IP Office seem to contradict this conclusion.

Indeed, while it is not disputed that nobody thought in applying a “kind of bubblegum odor” to children's shoes, and that this new idea and the olfactive undisputed distinctive mark that derived from it – that we could even accept as highly distinctive or well known – we cannot be in agreement on the widest scope of protection that has been granted to it by the Mexican IP Office, the same that we consider derives from the limits of granting olfactive marks protection from a description of these marks in words.

That said, in the commented decisions, the IP Office has refused other olfactive mark applications for “children's shoes” described as “the odor of strawberry”, “the odor of mint”, “the odor of lemon”, “the odor of vanilla” or “the odor of chocolate”, on the basis of a presumed existence of a likelihood of confusion with said well-known



mark described as the **"odor of bubblegum applied to children's shoes"**, which led us to believe that for the IP Office any fruit or species or sweet food odor would be then considered as confusingly similar to such "bubblegum" olfactive mark.

In conclusion, while describing an olfactive mark in words can be considered a suitable and feasible solution for granting protection to these marks, it is very doubtful that a word description could determine clearly and specifically the subject matter of the protection granted, as demonstrated by the children's shoes bubblegum odor mark decisions.

On the other side, the owner of the well-known bubblegum odor mark felt the need to register the mark and to include a very specific description and later filed a mark application describing it as an **"olfactive mark applied to footwear with a bubblegum scent of fruity and floral aromas, with accents of red fruits (raspberry, strawberry and cherry) and flashes of citrus fruits (bergamot, orange, pineapple and mango), some sweet notes of jasmine and violet and a subtle blend of vanilla, musk and**

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cinnamon", which in my advice proves that it considered itself that **"odor of bubblegum applied to children's shoes"** was not sufficient to determine the clear and specific subject-matter of the protection.

Candidly speaking, we might consider requiring applicants of olfactive marks to combine a word description with samples and a chemical formula of the mark. The samples and chemical formula could be consulted if a more accurate definition of the scope of protection granted to the mark is required, when determining the likelihood of confusion or even in litigation matters.

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