

## What's That Smell? Play-Doh Leads Charge For Scent TMs

By **Bill Donahue**

*Law360, New York (February 23, 2017, 3:00 PM EST)* -- Trademark registrations for scents are still a rarity, but experts say that could change as more companies like Hasbro — which applied last week to register the smell of Play-Doh — focus on consumers' noses.

The toy giant filed an application with the U.S. Patent and Trademark Office on Feb. 14 to register the smell as a trademark for "toy modeling compounds," describing it as "a unique scent formed through the combination of a sweet, slightly musky, vanilla-like fragrance, with slight overtones of cherry, and the natural smell of a salted, wheat-based dough."

Claiming the scent had acquired enough distinctiveness over the more than 60 years that children have been smelling it to function as a source designator, Hasbro said a registration would "reinforce" the common-law rights it already holds in the "iconic" smell.



Hasbro says the smell of Play-Doh is distinctive enough to be a trademark.

"Hasbro's Play-Doh scent is one of the best-known, most unique and instantly recognizable scent trademarks in the world, and has been serving as a trademark for decades," said Catherine M.C. Farrelly of Frankfurt Kurnit Klein & Selz PC, the lawyer that filed Hasbro's application.

Hasbro's application offers a rare glimpse into the still-nascent realm of scent trademarks, which are inherently difficult to register and account for just a fraction of a fraction of the millions of marks currently registered in the United States.

Since the first smell registration was issued in 1990 for a flowery scent used on yarn, only a dozen or so have followed; of those, most have been on the Supplemental Register for marks that don't meet the full requirements of a federal registration.

The reason for that scarcity isn't exactly a mystery: While companies are theoretically free to protect

smells under the Lanham Act, doing so is far more difficult than with more traditional trademarks like words and symbols.

For starters, U.S. law doesn't protect marks that serve any "functional" purpose beyond designating the source of the goods — a rule designed to prevent a single company from permanently monopolizing a design feature that competitors need to use. That's the domain of patent law, not trademark law.

Meeting that nonfunctional requirement is easy for a word like "Google" or a symbol like Nike Inc.'s swoosh; it's far harder for smells, which often arguably also serve a utilitarian purpose — masking another odor, for example — or inherently arise from the process of manufacturing the product.

In simple terms, "functionality" is why the scent of a perfume can't be a trademark, but it gets more complicated than that. Last year, for instance, the USPTO refused to register the citrus scent of a mining fluid because the odor came from an ingredient that made the product more biodegradable.

Other smell marks have been tripped up by simply being too commonplace. Verizon Wireless Inc. applied in 2013 to register the "flowery musk scent" it pumps into its retail stores, but the company was forced to downgrade it to the Supplemental Register after a USPTO examiner said the smell failed to function as a trademark because other companies "commonly use scents to create ambiance in stores."

Another major hang-up is proving that consumers associate a smell with a brand enough that it can serve as a trademark.

The U.S. Supreme Court has said consumers are predisposed to view even the most unusual features of a product simply as a way to make it more appealing, not to designate who made it, meaning brands must prove that those features have "acquired distinctiveness" to protect them with trademark law. When it comes to smells, the USPTO has said an applicant faces a particularly heavy burden to do so.

"The amount of evidence needed to establish secondary meaning of a scent mark is substantial," said Catherine H. Stockell, a trademark attorney with Fish & Richardson PC. "Applicants have to be able to show that consumers have come to understand the scent as a mark and not merely a descriptive feature of the product."

Other complications abound. How does one send a specimen of a smell to the USPTO, and how does the agency store it permanently without it degrading? How can other companies search for smell marks to ensure they aren't offering something confusingly similar? Is there an objective way to describe a smell, or for examiners to judge it?

Still, experts say that if there's one scent that could clear the hurdles facing smell marks, it's the odor of Play-Doh.

Sure, the smell might be partially derived from ingredients, but it's not exactly essential that modeling clay smell like cherry and vanilla. It's also been used on millions of dollars' worth of products and widely discussed as a source of childhood nostalgia.

In particular, Stockell pointed to Hasbro's decision to license the Play-Doh scent for a cologne line, released for the 50th anniversary of the product's launch, that offered wearers a chance to coat themselves in "a whimsical scent reminiscent of their childhood."

"The expansion of the scent to another product designed to evoke the early childhood pleasures of playing with the modeling clay provides demonstrable evidence that the scent itself has established a secondary meaning," she said.

Though scent mark registrations like the one Hasbro is seeking remain rare, experts say the company certainly won't be the last company to try. Brands are increasingly turning to the nose as a way to differentiate themselves in a crowded marketplace by appealing to an underappreciated sense that can evoke strong reactions in consumers.

And where marketers go, so go trademark attorneys.

"Smell is a very effective way of evoking emotion," said Monica Riva Talley, the head of the trademark practice at Sterne Kessler Goldstein & Fox PLLC. "It's a way to shortcut to brand recognition and goodwill.

"As the marketplace becomes more crowded and it's harder for consumers to differentiate, these kinds of nontraditional trademarks will be really effective tools."

--Editing by Katherine Rautenberg and Kelly Duncan.