

Play-Doh's trademark registration passes the smell test

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There is no shortage of controversy in the trademark and branding communities regarding the evolution of how the public, the courts and businesses understand the function of trademarks and brands.

As a result of ready public access to the trademark registration system, poor public education about the role of registration in the trademark scheme, and increasing financial incentives to capture the value of "brand equity," trademark law is no longer the poor cousin of patents it was viewed as a generation ago.

Today, trademarks are red hot — and what is hot expands.

Licensors and managers of brand and celebrity identity use trademarks to capture value and manage any brand, name, personality or concept recognizable by the public and amenable to monetization.

Trademark rights are claimed and licensing tribute paid for the right to depict things like public images of famous buildings, municipal police insignia and anything else people recognize and want to make a part of their fashion or sport lives.

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Whether the public policy goals of trademark and unfair competition laws are served by this development is unclear.

But not every aspect of this trademark expansion is an occasion for sniping by those who question the everything-as-brand-equity model.

One area of trailblazing in trademark law that is not necessarily a "land grab" by major stakeholders —and that suggests intriguing possibilities for legitimate brand building — is the area of nontraditional trademarks.

Nontraditional trademarks are sensory experiences that project brand identity in ways that transcend the traditional trademark paradigms of language (words and phrases) and graphic design (stylized ways of presenting words, logos and pictures).

The first step in this direction was the acknowledgment of trade dress — the distinct, overall way products or services announce who is offering them.

Trade dress can include product packaging as well as the design and color scheme used in a retail facility. In some cases, it can even include the shape and colors consistently used on or in the product.

It was a small but meaningful step from the amorphous extension of trademark rights to holistic experiences, such as trade dress to protection of a brand identity, that ring bells — such as the NBC "chimes" — as well as those that smell funny.

And in May of this year Hasbro, the leading toy maker, succeeded in registering as a U.S. trademark the very smell of childhood fun itself: the aroma of one of its most iconic products, Play-Doh.

REMEMBERING THE SMELL

The legitimacy of this development is demonstrated by the fact that very few people who grew up in America after Play-Doh was introduced to the market in 1956 have any difficulty remembering what Play-Doh smells like, or at least remembering that it has a very distinct and not unpleasant aroma.

That is a brand impression of the highest order. Indeed, scientific studies over recent decades have confirmed the intuition and experience most of us have that smells — the wafting of steam from mom's tomato sauce, the mothballs in grandma's closet, the scent worn by our first love — trigger particularly intense feelings and associations.

In other words, smells are great candidates for trademark protection, including the crown jewel of protection, registration.

What, after all, is a trademark but a sensory signal that connects goods or services with where they come from or, at least, who has approved them?

In fact, nothing in the law of trademark defines what senses must be the ones that are stimulated in this way.

The definition of what may be registered as a trademark under the Lanham Act is not, strictly speaking, defined by that statute

all; it certainly is not defined in the statutory provisions for trademark registration.

Section 2 of the Lanham Act, 15 U.S.C.A. § 1052, bears a title that seems to promise a definition: “Trademarks Registrable on Principal Register.”

Instead, the law delivers only a set of boundaries, starting off with the words, “No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it...”

The reader — the judge, the lawyer, the trademark owner — is presumed to know what a trademark is, for indeed the law of trademark is a creature of common law.

The Lanham Act’s registration provisions thus exist only to secure and protect common law rights, and trademarks that are not registered may still be very good trademarks.

The opposite is also true: Something may be found on the principal register of trademarks at the PTO and still, on legal attack, be found not to be a trademark at all, or perhaps less of one than the registrant thinks.

But, as the Supreme Court has repeatedly recognized, trademark registration is “significant.”

“The Lanham Act confers important legal rights and benefits on trademark owners who register their marks,” the high court said in *B&B Hardware Inc. v. Hargis Industries Inc.*, 135 S. Ct. 1293 (2015).

For that reason, acceptance by the PTO of a new concept in trademark protection by allowance of an application to register a trademark is, unless reversed by a federal court, the functional equivalent of a change, or at least a development, in the substantive law.

So the Play-Doh registration is a big deal.

NOT THE FIRST

Play-Doh is not the first trademark smellstration.

In 1990 a California company got the first aroma trademark for embroidery thread infused with the scent of the plumeria blossom, which required an appeal on its part to the Trademark Trial and Appeal Board.

In *In re Clarke*, 17 USPQ2d 1238 (T.T.A.B. 1990), the TTAB agreed with the applicant that no one else was making the product and that purchasers had come to associate the scented goods with the purchase — the building blocks of trademark identity.

In fact, Section 2 eventually circles back and, after enumerating what trademarks the PTO will not register, provide, “(f) Except as expressly excluded in ... this section, nothing in this chapter shall prevent the registration of a mark used by the applicant

which has become distinctive of the applicant’s goods in commerce.”¹

Courts treat olfactory and other nontraditional trademarks as they treat product configuration in trademark: The mark must have come to be recognized as distinctive by use. Even this formulation, however, does not tell us what a “mark” is.

The TTAB recognized this. But the yarn maker also had to satisfy the TTAB that the aroma was neither an inherent feature of the thread nor a functional one, but, rather, one added to it to project brand identity.

The TTAB, noting that the scent feature was promoted by the brand owner as a way to identify the product, was satisfied on this score too.

Even getting past the hurdle of distinctiveness, it is functionality that is likely to be the sticking point in the area of olfactory trademark protection.² If a product feature is deemed functional, it is not entitled to trademark protection.

It’s hard to say that Play-Doh’s smell is functional, at least in the usual sense.

“In general terms, a product feature is functional if it is essential to the use or purpose of the article or if it affects the cost or quality of the article,” the Supreme Court said in *Inwood Laboratories Inc. v. Ives Laboratories Inc.*, 456 U.S. 844 (1982).

Functionality was not wrestled with very profoundly in *In re Clarke*, though you might expect that it would be.

Isn’t it merely the case that people will enjoy embroidered merchandise if it smells nice more than if it smells like grandma’s mothballs?

In fact, the examining attorney, urging refusal of the scent registration for yarn, wrote, “The rarity of usage of fragrance as a feature of applicant’s goods weighs against registration.”

“It is much more likely that consumers will regard the scent as a pleasant feature of the goods,” the examining attorney added. In other words, the examining attorney believed that rather than projecting brand identity, scent makes the product more desirable.

The TTAB did not really address this argument, instead focusing on the fact that the applicant treated the scented aspect of its product as a trademark.

Implicitly the TTAB was saying the aroma was not something that would enhance the enjoyment of the embroidered goods made with it, or the fun of doing embroidery. It functioned as a trademark, not as a utilitarian aspect of the product.

We have come a long way since *In re Clarke*.

Indeed, the functionality doctrine — particularly the concept of “aesthetic functionality” — has developed to the point where the 9th U.S. Circuit Court of Appeals held — albeit for only a moment in *Fleischer Studios Inc. v. A.V.E.L.A. Inc.*, 636 F.3d 1115 (9th Cir. 2011) — that a trademark can be used as a design without authorization from the mark’s owner because it is not being used as a trademark but, instead, as a “functional aesthetic component” of a product.

The *Fleischer* decision was so controversial that the 9th Circuit pulled it back later that year in *Fleischer Studios Inc. v. A.V.E.L.A. Inc.*, 654 F.3d 958 (9th Cir. 2011).

Clearly, the interplay between function and trademark use is sufficiently more complex now than it was when *In re Clarke* was decided in 1990.

So how does Play-Doh matter?

It’s hard to say that Play-Doh’s smell is functional, at least in the usual sense. Presumably it smells the way it does not because of intentional branding considerations that so impressed the *In re Clarke* panel but to mask what Play-Doh would smell like without perfume.

One account says the scent comes from scientists “trying to develop wallpaper cleaner when they discovered the now iconic children’s toy.”³ Is this purpose not “functional”?

Maybe it is “functional” in a backward way. There is no reason to believe, however, that the Play-Doh smell was intended to make playing with “dough” any more fun, or to add any particular aesthetic quality to it.

In 1956, kids were kids. So the Play-Doh smell is certainly not aesthetically functional.

In contrast, most smell trademarks, from the scented yarn of *In re Clarke* to the strawberry-flavored toothbrush that has a smell trademark registration, probably really are.⁴

But it isn’t it also true that, unlike the fragrant yarn in *In re Clarke*, Play-Doh never sold itself, or, as it is trying to do now, marketed similarly scented licensed products, using the aroma as a brand identifier until just now?

It is, but it is hard to see that factor as a very important one, as it was treated in *In re Clarke*.

It is true that in evaluating whether a trademark is being used “as a trademark,” we would expect it to be promoted as a trademark.

This, however, is easy to fake, and constitutes weak evidence of trademark use.

Certainly when you sell a strawberry-flavored toothbrush you will make that a selling point, but — to the extent such an

“aesthetic” experience is viewed favorably — it is hard not to call this aesthetic functionality.

Play-Doh smells like Play-Doh because it’s Play-Doh.

No one ever bought it for the smell, presumably; they just experienced it, just as we experience the visual experience of a can of Coca-Cola without much caring about it.

We use the red and white design to recognize the Coke, and short of arcane psychological speculation, that is probably where the engagement ends.

For this reason, Play-Doh is the perfect nontraditional trademark.

Whether that status will be of value outside the classroom and translate into the sweet smell of licensing success is a different question.

NOTES

¹ 15 U.S.C.A. § 1052(f).

² Jay M. Burgett, *Hmm ... What’s That Smell? Scent Trademarks — A United States Perspective*, INT’L TRADEMARK ASS’N (Mar. 1, 2009), <https://bit.ly/2MRgesA>.

³ Play-Doh, Demeter Fragrance Library, <https://bit.ly/2xqiYbt>.

⁴ Nick Greene, *The 10 Current Scent Trademarks Currently Recognized by the U.S. Patent Office*, MENTAL FLOSS (Oct. 13, 2015), <https://bit.ly/2PeXAMD>.

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