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# Unfair competition and the legal protection of the unregistered scent marks in UAE: a comparative study

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**Abstract:** This article presents a new systematic analysis of the effectiveness of an unfair competition claim in the UAE for protecting the unregistered scent mark. The main aim of this article is to discuss the specificity of an unfair competition claim for civil protection of unregistered scent marks. This objective will be achieved by: 1) an analysis of the requirements for filing an unfair competition lawsuit; 2) discussing the difficulties in the registration of scent mark; 3) presenting the provisions of the UAE jurisdictions concerning the unfair competition lawsuit; 4) concluding the most important acts of unfair competition related to the scent mark. In this context, it is particularly important to analyse the specific aspects that should be taken into consideration when applying an unfair competition lawsuit to protect the legitimate interest of the owner of the unregistered scent mark. The article concludes that the judiciary in UAE should play a prominent role in protecting the unregistered scent mark used by national and foreign investors until the intellectual property laws settle on the mechanism for registering this type of unconventional mark.

**Keywords:** scent mark; unfair competition; compensation; liability; UAE.

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## 1 Introduction

Producers must understand the essential role that the senses can play in shaping consumer decisions, as the senses are heavily relied upon in making consumption decisions (Agarwal, 2015). As regards the olfactory sense, the scents have become a source of competitive advantage for enterprises and essential part of the moral capital of many companies (Hammersley, 1998; Binctin, 2005). And it must be managed strategically and proactively (Meng et al., 2021).

For example, the scent mark along with several unconventional marks, such as sound, colour, and flavour has become a major driver of the US marketing sector (Gilson and Lalonde, 2005). The effective use of trademarks is linked to several enterprise performance indicators, including profitability, market value, and the ability to survive in the market (Sandner and Block, 2011).

Science has proven a strong link between olfactory cues and human memory (De Bruijn and Bender, 2018). Scents, even more than visuals, are a potent tool for evoking a memory or reaction in customers. Therefore, scents may form attractive brands, because they may be used to identify the source of products and services, and perform the essential function required by trademark laws (Brill, 2022).

**Table 1** The relationship between scent brand and economic growth of businesses

<i>The role of scent mark</i>	<i>Expected impact on consumers</i>
Creates a memorable brand experience	The scent can create a lasting impression on customers, making the brand more memorable.
Enhances customer engagement	A pleasing aroma can enhance the customer's experience, making them feel more comfortable and inclined to spend more time in store or establishment. The longer customers stay, the higher the likelihood of increased purchases.
Builds a strong brand identity	A signature scent can become an inherent part of your brand identity. When consistently used, this scent can reinforce your brand in people's minds, leading to increased recognition and loyalty.
Stimulates positive emotions	Scent can evoke a wide range of emotions. By choosing a scent that triggers positive feelings, businesses can create a more enjoyable and satisfying customer experience, leading to repeat business.
Differentiating your brand from competitors	A unique signature scent can help to brand stand out. It adds an extra dimension to the brand identity and gives customers a reason to choose this brand over others.

*Source:* AOK Marketing, grow your Business (Unlocking the Power of Scent Marketing: Enhancing Brand Positioning through Olfactory Experience)

In general, the scent mark is a signal that can only be perceived by the sense of smell and is used to represent a mental association between consumers and products. The natural characteristic of goods is not sufficient as such to indicate the source of these products and to distinguish them from other similar products (Abdo, 2018).

Arguably, the legal recognition of the possibility of registering a scent as a trademark is increasing in various jurisdictions.<sup>1</sup> However, the process of registering the scent is slow in practice and this is proven by statistics issued by various trademark offices<sup>2</sup> and the World Intellectual Property Organization.<sup>3</sup> The main cause of this may be the practical challenges involved in examining the scent mark to determine whether it qualifies for registration as an invisible mark, which makes it necessary to study appropriate legal means to protect the unregistered scent mark.

The importance of the study is evident in providing legal protection for unregistered scent marks, given that the legal regulation of these marks is new to the legal environment of the UAE. Contemporary national and foreign investments also turn their attention to scent trademarks to attract consumers, seeking to protect these trademarks even if there are difficulties in registering them. Hence, this study, relying on the comparative analytical approach, focuses on achieving several specific objectives:

- 1 Explaining the practical difficulties facing the registration of the scent mark so far.
- 2 Proving that an unfair competition lawsuit is an appropriate alternative to protecting an unregistered scent mark.
- 3 The judiciary has a major role in protecting the distinctive scent mark in the UAE until the legal regulation of non-traditional marks is stabilised.

## 2 The scent mark deserves civil protection once it is used


To overcome the practical difficulties of registering a scent mark, we find that trademark offices in different countries followed one of two methods:

- 1 verbal description with sample deposit
- 2 chemical description with sample deposit.

### 2.1 Verbal description with sample deposit

Countries such as the USA<sup>4</sup>, the UK<sup>5</sup>, Oman<sup>6</sup> and the Gulf Cooperation Council States<sup>7</sup> have followed this mechanism in registering the scent mark. Accordingly, an application to register the scent mark requires the submission of a detailed non-comparative written description utilising the perfumery radar methodology of the scent, which would be kept on file. Thus, if a mark is merely a scent, an applicant is not obliged to provide a drawing or graphical representation.

**Figure 1** Difficulty of relying on written description to register a scent mark (see online version for colours)

Sign	Case No
 <p data-bbox="231 1247 476 1293">Mark description: Smell of ripe strawberries</p>	<p data-bbox="695 1145 862 1173">EUTM No 1 122 118</p>
<p data-bbox="225 1321 1056 1432">27/10/2005, T-305/04, Odeur de fraise mûre, EU:T:2005:380, § 34          “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”.</p>	

*Source:* EUIPO, Guidelines for Examination of European Union Trade Marks (Absolute grounds for refusal)

Furthermore, according to the TMEP, the applicant must submit a specimen that contains the scent and matches the required description of the scent to prove that the specimen of the scent certainly identifies and distinguishes the products and indicates their origins.<sup>8</sup> These specimens submitted to register specific scents as a trademark are kept in a cool,

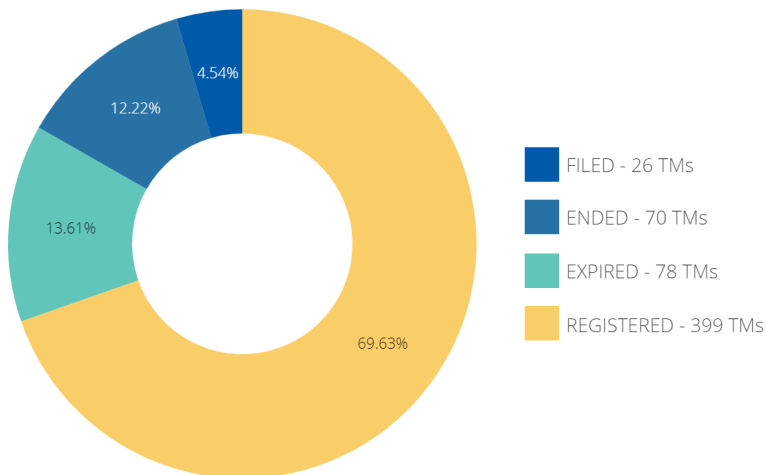
dark, and dry place inside tight containers to preserve them throughout the storage period, with the specimens replaced every five years to ensure their sustainability (Erlandsson, 2004).

It is widely common that it is extremely difficult to describe the scent impression to someone else (Churovich, 2001). Hence, it might be challenging to describe a scent mark because articulating a scent in writing is often inaccurate (Brill, 2022). On the other hand, because the scents in a submitted specimen can vary over time as a result of volatilisation or other occurrences, a deposit cannot create a persistent scent imprint that might serve as a graphic representation (Brill, 2022).

## 2.2 *Chemical formula with sample deposit*

Countries such as the European Union<sup>9</sup> and the UAE<sup>10</sup> have followed this mechanism in registering the scent mark. For instance, in the Ralf Sieckmann case (Ralf Sieckmann v Deutsches Patent, 2002), the European Court of Justice upheld the decision of the German Patent and Trademark Office, which refused to register the scent of balsamically fruity with a slight hint of cinnamon as a scent mark in respect of various services, based on the fact that the chemical formula (C<sub>6</sub>H<sub>5</sub>-CH = CHCOOCH<sub>3</sub>.) provided by the applicant is not sufficient to distinguish the scent mark objectively, accurately and clearly as a condition for legal protection (Torremans, 2005).

**Figure 2** Registered scent marks according to the Madrid Agreement (see online version for colours)



*Source:* WIPO – Global Brand Database (2024)

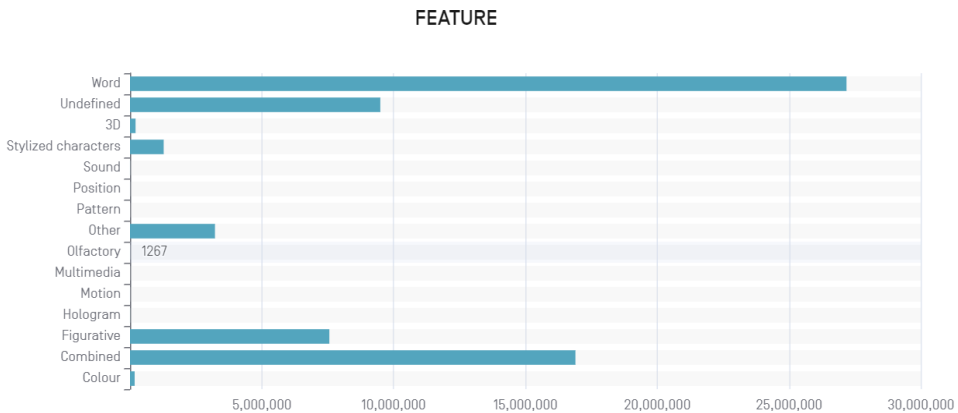
Additionally, because there are several elements that impact how a scent is perceived, such as the concentration, quantity, temperature or substance bearing the scent, the chemical formula as a graphical representation of a scent mark does not make it possible to identify the scent with confidence (Ralf Sieckmann v Deutsches Patent, 2002). Furthermore, few people can understand chemical formulas, which contradicts the requirement of sufficiency and clarity necessary for registering a trademark (Tréfigny, 2003; Yayon-Dauvet, 2011). Likewise, the UAE legislator obligated the registration

applicant to provide a written description of the chemical composition, which makes the legal protection of the scent mark insufficiently effective due to previous practical difficulties. Therefore, it would have been more appropriate for registration to require the verbal description or chemical composition and leave the matter to the discretion of the examiner.

In light of those difficulties regarding scent mark registration, very few scent marks have been registered.<sup>11</sup> Furthermore, any trademark holders may be reluctant to submit an application to register the scent marks that they use to distinguish their products or services, which makes resorting to unfair competition lawsuits an appropriate solution for legal protection of the unregistered scent trademark in the event of violations therein. Especially in countries whose laws do not allow the registration of invisible marks, such as Jordan, Iraq and Egypt.

In fact, it might be exceedingly difficult for applicants to prove the instinctiveness and non-functionality of scent marks (Compton, 2010), so that the attempts to register scent marks have failed due to the need for a sufficiently clear and accurate graphical representation of scent marks (Castaldi, 2018). This may explain why the number of scent marks registered in the world is low.

**Figure 3** Cumulative number of olfactory marks compared to other brands (see online version for colours)



Source: Global Brand Database (2024)

Currently, registration of a scent trademark is a procedural requirement to grant the trademark owner criminal protection and is merely a simple proof of the applicant's ownership of that trademark. Therefore, registering a trademark is not a legal act that creates the right to ownership of the trademark, and this means that the right is established for whoever used the trademark first.

Likewise, most Arab jurisdictions<sup>12</sup> consider the person who registered the trademark to be its owner if this is accompanied by its use for five years following its registration. These jurisdictions also gave the right to every person who had previously used the trademark to appeal the invalidity of its registration during that period. The period requirement can be ignored if it is proven that the trademark registration was done in bad faith.

In other words, ownership of a scent trademark is acquired by the fact of its use, not by the priority of its registration. Therefore, if a person is proven to have an apparent and undisputed use of a trademark for a scent, and another person precedes him in registering the same scent to distinguish similar products or services, ownership of the trademark reverts to the person whose use is proven. Thus, the Jordanian Supreme Court of Justice (The Jordanian Court of Cassation, Civil Provisions, 1996) confirmed that if the right of the applicant for registration of a trademark conflicts with the right of a previous user of the mark, the previous user shall have priority over the applicant for registration.

It is worth mentioning that the civil protection of trademarks in the USA is based on common law (Section 43/a of the Lanham act) (Marx, 1983). Therefore, the registration of a scent mark does not necessary create rights, as the holder's rights may exist in both registered and unregistered scent marks (Hammersley, 1998).

Ultimately, the UAE legislator did not allocate the scope of legal protection for the scent mark under a special regulation. Thus, the same provisions as for the traditional trademark are applied to it. In other words, the scent mark is protected if it is registered within the UAE and any other country in which it is registered, unless its owner succeeds in registering it internationally in accordance with the protocol relating to the Madrid Agreement concerning the international registration of marks. In this case, the scent mark is protected within all countries that accede to the agreement.

### **3 Unfair competition in the scope of unregistered scent marks**

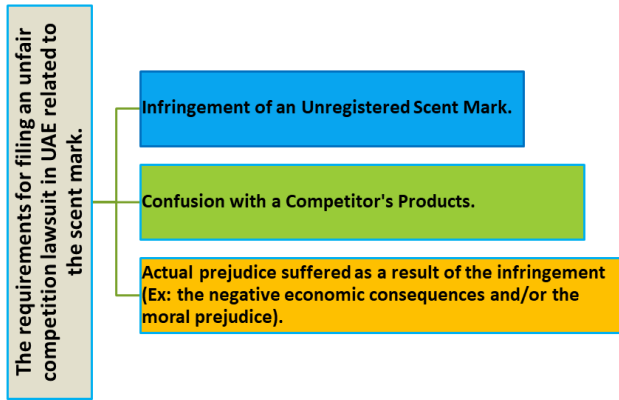
Currently, it is a recent feature that the common law of unfair commercial practices extends to aggressive, misleading and deceptive practices (Howells et al., 2009). Arguably, the unfair competition lawsuit constitutes the most important mechanism invented by jurisprudence and applied by the judiciary to confront illegal industrial and commercial practices. Its application is limited to cases in which legal protection of the infringed right or the legitimate interest of the plaintiff cannot be achieved except through this claim (Larrieu, 2010; Ulmann and Marchand, 2015). Thus, legal protection can be secured for interests that are not considered by specific regulations in some countries (Cour de cassation, chambre commerciale, 2007, 1978), such as those arising from the use of scent marks.

In all fairness, it might be argued that adding an arbitrary scent to a product will place the manufacturer in a better competitive position within the market. Bringing a legal claim for unfair competition in the field of unregistered scent marks would achieve the two most important goals sought by trademark laws:

- 1 the public would be shielded against product confusion in the marketplace
- 2 the goodwill of manufacturers, merchants and service providers can be protected.

In most Arab jurisdictions<sup>13</sup>, unfair competition is any act of competition contrary to customs and principles followed in commercial transactions and, in particular, infringement of third-party trademarks, and any action or claim that could cause confusion about the products. Consequently, every unfair competition obligates its perpetrator to compensate for the damage caused, and the court may rule – in addition to compensation – to remove the damage and publish a summary of the ruling at the expense of the convict in one of the daily newspapers.<sup>14</sup>

**Figure 4** Unfair competition lawsuit in the UAE judiciary (see online version for colours)



Source: Author’s own elaboration

At present, in the UAE<sup>15</sup> and in Egypt<sup>16</sup>, civil protection of an unregistered trademark is implied by filing an unfair competition lawsuit. This is consistent with the Paris Convention for the Protection of Industrial Property, where all actions that would create confusion with a competitor’s products are acts of unfair competition.<sup>17</sup>

According to those two laws, the trader is prohibited from disclosing false information about the origin or specifications of his goods or other matters related to the nature or importance of the goods. Further, the trader shall not adopt fraud and deceit in disposing of his goods, nor to pursue any other false methods to attract the customers of another competing trader. Imitating a competitor’s scent mark to attract customers by misleading them about the products they are accustomed to buying is undoubtedly a deceptive method and constitutes unfair competition.

The Jordanian legislator is clearer on the issue of protecting an unregistered mark by unfair competition lawsuit, as article (2/b) of the Unfair Competition and Trade Secrets law stipulates, “A. Any competition contradictory to the honest practices in the commercial and industrial activities shall be deemed one of the unfair competitions acts and particularly the following... B. If the unfair competition related to a trademark used in the kingdom either being registered or not and causes public misleading, provisions of paragraph (A) of such article shall be applied”.

In this regard, the Jordanian Supreme Court of Justice (The Jordanian Court of Cassation, Civil Provisions, 2007) confirmed that the scope for creating confusion among the public regarding products is wide and includes imitation of the trademark, or everything that is used to identify the product and distinguish it from other products. This includes the external appearance of the product, in which the competitor tries to present the product as belonging to its competitor and create a feeling that there is a state of unity between them, as a result of using the competitor’s trademark or the distinctive shape of the goods with the intention of profiting from the competitor’s reputation and the trademark confusion. For this reason, the registration is not a requirement to protect the user of the trademark against practices that constitute unfair competition for him.

In another ruling, the same court (The Jordanian Court of Cassation, Civil Provisions, 2012) explicitly confirmed that the Jordanian legislator made it clear in the Unfair Competition Law in Paragraph (B) of article (2) that one of the unfair competition acts is

related to a trademark used in the Kingdom, whether registered or unregistered, which leads to misleading the public.

Likewise, the Federal Supreme Court in the UAE and in Egyptian Court of Cassation decided that only the owner of the trademark is authorised to use it (The UAE Federal Supreme Court, Civil and Commercial Provisions, 1994; Egyptian Court of Cassation, Civil Cassation, 2012). It added that if another competitor attempts to use the trademark to distinguish similar products or services, this will constitute an assault on the right of the trademark owner, resulting in damage as a result of weak confidence in the good or service, which gives him the right to file an unfair competition lawsuit. The court affirmed that the holder of the trademark is entitled to civil protection, whether his mark is registered or unregistered, in contrast to the criminal protection provided by the trademark law, which is only given for registered trademarks.

Accordingly, if the scent mark is used but not registered, legal protection based on unfair competition is the only means to protect its holder from moral and financial harm because of its infringement (Samaha, 1991; Zain al-Din, 2010). In other words, the basis of this claim is a violation of the general obligation imposed on all competitors in the market to follow methods of fair competition (Al-Qalioubi, 1999).

#### **4 Tort liability requirements: distinctive, competitive position and damage**

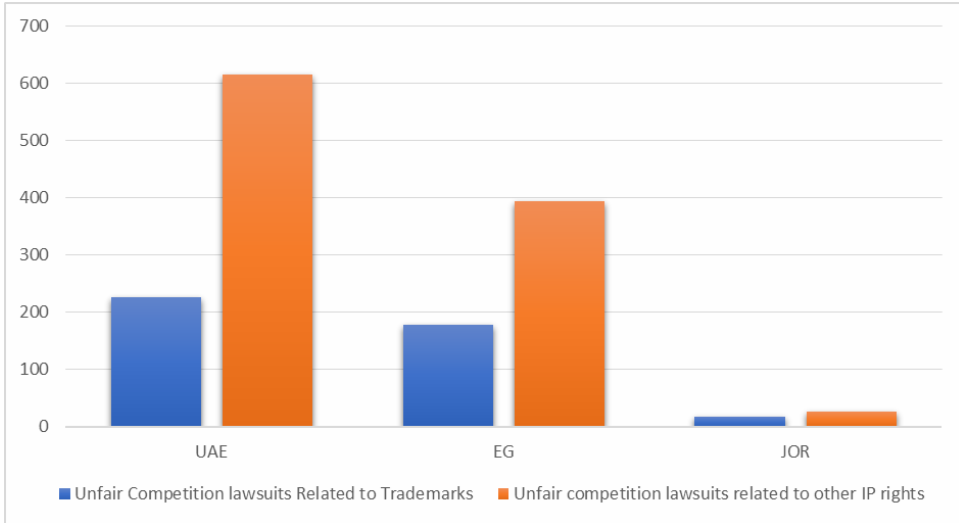
Based on the above, unfair competition over an unregistered scent mark is the behaviour of a market participant that gains or seeks to gain an advantage over its competitors by misrepresenting the use of a scent mark that competitor else used first.

In that regard, when a third party uses a scent mark that is confusingly similar to a reputable mark, this third party would unfairly be taking advantage of the unique quality or reputation of the scent mark in question. Therefore, there must be mechanisms that protect competition and set controls against those who try to exploit it illegally, in a way that harms honest competitors and the interests of the consuming public (Zain al-Din, 2010; Al-Saghir, 2004; Samaha, 1991).

##### *4.1 Poof of the distinctive character of the scent mark used*

A trademark will not achieve its main function of distinguishing the source of goods and services unless it essentially involves some characteristics and qualities that give it its own identity and distinguish it from marks for similar goods (Al-Saghir, 2004). Consequently, as will be shown, the requirement of a distinctive character in a trademark as a condition for its registration is well established in Arab intellectual property laws<sup>18</sup> and comparative laws.<sup>19</sup> As a notable example, according to the Emirati and Egyptian laws, the marks devoid of any distinctive character shall not be registered as trademarks.<sup>20</sup> The trademark must have a special overall appearance that enables it to perform its role in indicating the products or services associated with it and distinguishing them from other similar products or services (Al-Saghir, 2004). As a result, the law will not protect any non-distinctive mark, and no one may monopolise it (Smith, 2002).

**Figure 5** Statistics indicate that more than a third of unfair competition cases in the UAE, Egypt and Jordan related to trademarks (see online version for colours)



Source: East Laws Database (2024)

Despite this, the requirement that the scent be distinctive to deserve legal protection does not mean that the scent must be innovative. Rather, the distinction may stem from the originality of the scent presented to the associated product or service and the fact that it clearly indicates to consumers its source (Ribeiro da Cunha and Randakevičiūtė-Alpman, 2020).

In this regard, trademark offices have settled on three important matters:

- a A scent mark can be registered, if it is not inherent or natural to the good (Rettew, 2012). The scent to be registered as a trademark must represent merely a complementary characteristic or aesthetic element of the product, without a direct relationship to its main characteristics, and not be linked to any utilitarian function.<sup>21</sup> For example, the scent of strawberry is registerable for a company that sells toothbrushes.<sup>22</sup>
- b The plaintiff must prove that a smell has acquired a ‘secondary meaning’ in the designated market (Castaldi, 2018). In other words, the scent mark must refer consumers to a specific source to avoid confusion. Generally, a scent mark that would mislead consumers cannot be registered (Azéma and Galloux, 2006; Passa, 2013).
- c The scent mark must be in use. While providing evidence for that usage is not a difficult task, however providing the distinctive character and dealing with its functionality issues can be complicated.

Building upon earlier ideas on scent mark, the scent not registerable if commonly used in specific products. Although the scent of lemon is inherently distinctive, however, it cannot be used as a scent marker to distinguish a detergent product, as it has become a scent known to the public as a characteristic of cleaning products and that lemon contains chemical properties capable of removing stains (Burgunder, 1991).

In unfair competition cases, the functionality doctrine allows a defendant to refute such a claim by proving that the scent trademark reflects a functional aspect of the product. If the court determines that the scent trademark was allegedly infringed upon is functional, then that scent is not a protected trademark, and the unfair competition suit will fail (Reimer, 2012).

Consequently, as will be shown, case law readily acknowledges that well recognised utilitarian uses of scents, such as those found in perfumes and air fresheners, will not be protected by trademarks.<sup>23</sup> For example, the peppermint scent was deemed invalid as a trademark to distinguish ‘pharmaceutical formulations of nitro-glycerine’, because pharmaceutical preparations often contain a peppermint product than as indicators for manufacturers.<sup>24</sup>

In this regard, the Paris Court of Appeal refused to award compensation in an unfair competition lawsuit for violating an unregistered trademark, because the trademark that was the subject of unfair competition was merely a general designation, and that the competitor’s use of the same designation cannot cause confusion for the plaintiff’s enterprise (Cour d’appel de Paris, 2004).

#### *4.2 Existence of a competition situation between the owner of the scent mark and the defendant*

Taken as a whole, it is simple to imagine a store shelf filled with rows of identical products, each with its own registered scent, competing with one another for consumers’ limited olfactory abilities (Churovich, 2001).

To file an unfair competition lawsuit, it is required that there be a competitive situation between the perpetrator of the unfair competition act or the defendant and the one whose legitimate commercial interest was attacked, as each of them targets the same category of consumers with their products or services, which can be inferred from the first word of the name in which jurisprudence called this lawsuit ‘competition’ (Linda, 2013).

Thus, the absence of competition between enterprises eliminates the risk of confusion between the products or services they provide (Legeais, 2014). However, the parties to an unfair competition lawsuit must offer products in the same or at least a similar category, allowing them to have common customers (Courtieu, 2014; Passa, 2013). In all cases, this remains a matter of fact, subject to the discretion of the trial judge (Samaha, 1991).

Hence, to file an unfair competition lawsuit to protect the scent mark, it is required that the violation occurred within the framework of competitive activity, and that the defendant be a competitor to the owner of the infringed scent mark in the same market and seeks to achieve economic gains on a basis that violates honourable commercial and industrial customs.

#### *4.3 Damages Resulting from infringement of an unregistered scent mark*

Acts of unfair competition are all acts by which the trader seeks to benefit from the reputation of other competitors, but in a way that violates honest commercial norms aimed at protecting honest competitors and consumers and maintaining a decent level of economic relations (Legeais, 2014; Larrieu, 2010). These actions were prohibited by the Arab laws under study, which recognised legal liability for the damages resulting from them.<sup>25</sup> Judicial rulings also confirmed that using a competitor’s trademark (such as a

scent mark) despite not waiving it constitutes unfair competition (UAE Federal Supreme Court, 1995).

For instance, imitating a distinct scent mark and placing it on similar products to attract customers of the owner of the counterfeit scent mark by introducing confusion into their minds or by placing it on similar products of lower quality in a way that harms the reputation of the trader that owns the original scent mark would make customers withdraw from him and thus create turmoil within his enterprise. Eventually, this might lead to his exit from the market.

In general, acts of unfair competition based on introducing confusion into the minds of consumers through assault on the scent mark can be inferred by projecting the following stable judicial principles regarding trademarks:

- a Scent mark counterfeiting (misrepresentation and deception): this hypothesis occurs if a merchant reproduces a distinctive scent mark of a competing merchant's product and associates it with its products to attract the competitor's customers by creating confusion in their minds or disparaging and belittling the original products. This often leads to harming the reputation of the merchant who owns the scent mark and causing confusion within his enterprise (Cour de cassation française, Chambre commerciale, 1981).

The Egyptian Court of Cassation decided that a merchant's use of a trademark – such as a scent mark – that is identical to a competing merchant's trademark, thus confusing even the average consumer due to his inability to distinguish the counterfeit trademark from the original trademark, was unfair competition (The Egyptian Court of Cassation, 2000). It is worth noting that assessing the incident of imitation of a scent mark or not is an objective issue that falls within the jurisdiction of the trial court without oversight by the Supreme Court, as long as it bases its ruling on well-established and precise reasons that are supported by expert reports (The UAE Federal Supreme Court, Civil and Commercial Rulings, 1998).

- b Use of identical or virtually identical scent mark: the act of unfair competition in this case is represented by the perpetrator using a counterfeit scent mark without requiring that he be the one who imitated it himself. The perpetrator aims to attract clients of the enterprise that owns the original scent mark in violation of honourable commercial customs and to achieve economic gains at the expense of the competitor's reputation.
- c Dealing with products bearing a counterfeit scent mark: the owner of the scent mark has the right to file an unfair competition lawsuit against anyone who sells, displays or possesses products bearing the counterfeit scent mark to prevent damages that may befall him as a result of introducing confusion into the minds of consumers.

Notably, on the one hand, various jurisdictions have determined that acts resulting from negligence, recklessness and lack of caution may be sufficient to establish a claim of unfair competition, and there is no need to prove intentionally attacking the legitimate interests of competitors (Picod et al., 2008; Cour de cassation française, chambre commerciale, 2013). On the other hand, all acts that constitute the element of fault in an unfair competition lawsuit, as a commercial dispute, can be proven by all means of proof (Cour de Cassation française, Chambre commerciale, 1992). Consequently, the owner of the infringed scent mark can prove the infringement by submitting documents, reports,

chemical analyses, or witness testimony and any other methods of proof that are appropriate to the nature of the infringed right, provided that the court accepts them. Ultimately, the fact that scents are perceived differently, based on the surrounding circumstances and their qualities, further complicates the judiciary's task of conducting a potential confusion analysis in a scent trademark infringement claim (Brill, 2022).

Furthermore, an unfair competition lawsuit is one of the most important forms of tort liability, so repairing the damage resulting from the fault is the goal of filing a lawsuit (The Egyptian Court of Cassation, Commercial and Economic Circle, 2023; The Egyptian Court of Cassation, Civil Cassation, 1956). Thus, the judiciary decided that the award of compensation requires proof of the damage suffered by the merchant as a result of his competitor's actions that violate honourable commercial and industrial customs (Cour de Cassation française, 2e Chambre civile, 2010; Cour d'appel de Metz, 2008).

The damage to the owner of the scent mark resulting from acts of unfair competition may be material, such as the loss of a portion of sales (Passa, 2013), or moral, such as the collapse of the trader's reputation in the market as a result of the use of the counterfeit scent mark to distinguish inferior products (Schmidt-Szalewski, 2011). However, the owner of the scent mark has the right to ask the court for indemnification for the damage he suffered resulting from acts of unfair competition.

## 5 Conclusions

In many Arab countries, the law does not require mandatory trademark registration, such as the scent mark, and leaves this matter to the discretion of business owners. However, the law allows for some protections available to a person who uses an unregistered scent mark, provided the conditions required by the law are met. This could raise a legal issue if someone uses a scent mark in bad faith on products or services that have already been used by someone else without registering it in order to compete unfairly with him.

In summary, the scents are inherently complex and distinctive, and most significantly, highly subjective in terms of detection, identification, and remembering. Therefore, scent seems to attract customers and improve their loyalty to a given good or service from a specific source, such that it is considered part of the moral capital of the investment. Despite this, dealing with the legal challenges inherent in the quest to include smells within the trademark umbrella is one of the more obvious areas of contention. Accordingly, an unfair competition lawsuit can be considered an ideal solution to protect the unregistered scent mark.

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## Notes

- 1 15 U.S. Code § 1127 (Lanham Act); art 3 (1) of Commission Implementing Regulation (EU) 2018/626 of 5 March 2018 laying down detailed rules for implementing certain provisions of Regulation (EU) 2017/1001 of the European Parliament and of the Council on the European Union trade mark; Federal Law No. 36 of 2021 on Trademarks (UAE); Law No. 21 of 1957 on Trademarks and Trade Names, as amended up to Law No. 9 of 2010 (Iraq); Law on Industrial Property Rights promulgated by the Royal Decree No. 67/2008 (Oman); GCC Trademarks Law.
- 2 No active registered scents in the UAE, Jordan, Iraq, Egypt, Oman, and Kuwait (verified by the author, last update on 14/10/2023). There are currently no active registered scents with the EU, and less than a dozen active registered scent trademarks in America, available at: <https://www.briffa.com/blog/if-you-smell-what-ip-is-cooking/> (last access 14 October 2023).
- 3 WIPO, Global Brand Database, the registered olfactory trademark statistics, available at: [https://branddb.wipo.int/en/explore/visu?sort=score%20desc&strategy=concept&rows=30&asStructure=%7B%22\\_id%22:%222fb1%22,%22boolean%22:%22AND%22,%22bricks%22:%225B%7B%22\\_id%22:%222fb2%22,%22key%22:%22type%22,%22value%22:%225B%22TRADEMARK%22%5D%7D%5D%7D&\\_id=1697002207777&fcmarkFeature=Olfactory&fcstatus=Registered](https://branddb.wipo.int/en/explore/visu?sort=score%20desc&strategy=concept&rows=30&asStructure=%7B%22_id%22:%222fb1%22,%22boolean%22:%22AND%22,%22bricks%22:%225B%7B%22_id%22:%222fb2%22,%22key%22:%22type%22,%22value%22:%225B%22TRADEMARK%22%5D%7D%5D%7D&_id=1697002207777&fcmarkFeature=Olfactory&fcstatus=Registered), (Last Access 11/10/2023).
- 4 Trademark Manual of Examining Procedure, United States Patent and Trademark Office, October 2015, §807.09. See: <https://mpep.uspto.gov/RDMS/TMEP/current#/current/d1e2.html>.  
Also see: §904.03(m) ‘Specimens for Scent and Flavor Marks: “To show that the specimen for a scent or flavour mark actually identifies and distinguishes the goods and indicates their source, an applicant must submit a specimen that contains the scent or flavor and matches the required description of the scent or flavor”’.
- 5 See: Registration No. UK 00002001416, filed on 31st October 1994, entered in the register on 9th April 1996, available at: <https://www.ipo.gov.uk/tmcase/Results/1/UK00002001416?printFriendlyView=True>.  
Registration No. UK 00002000234, filed on 31st October 1994, entered in the register on 3rd May 1996, available at: <https://www.ipo.gov.uk/tmcase/Results/1/UK00002000234?legacySearch=False>.
- 6 Article (46/5) of Regulation No. 105/2008 under the Law on Industrial Property Rights and Their Enforcement for the Sultanate of Oman, available at: <https://www.wipo.int/wipolex/en/text/179951>.
- 7 Article (4/7) Implementing Regulations of the Trademarks Law of the Gulf Cooperation Council States: ‘Smells marks shall be given in a written description’. See: <https://www.wipo.int/wipolex/en/text/566978>.
- 8 Trademark Manual of Examining Procedure, United States Patent and Trademark Office, October 2015, §904.03(m).
- 9 Article (3/1) of Commission Implementing Regulation (EU) 2018/626 of 5 March 2018 laying down detailed rules for implementing certain provisions of Regulation (EU) 2017/1001 of the European Parliament and of the Council on the European Union trade mark.
- 10 Article (4/5) of Decision No. 57/2022 On Executive Regulations of the Federal Decree-Law No. 36/2021 on Trademarks: ‘Written description of the chemical composition, if the trademark is for an odour’.
- 11 See for example: (USPTO) Registration No. 5940433, filed on 1st February 2019, entered in the register on 17 December 2019, available at: <https://trademarks.justia.com/884/12/scent-mark-scent-contained-within-purity-wax-and-wax-press-products-for-the-manufacture-of-cad-cam-milled-dental-wax-patterns-88412035.html>.  
(USPTO) Registration No. 5735892, filed on 6 December 2018, entered in the register on 23 April 2019, available at: <https://trademarks.justia.com/882/20/scent-mark-scent-contained->

within-purity-wax-and-wax-press-products-for-the-manufacture-of-cad-cam-milled-dental-wax-patterns-88220183.html.

(USPTO) Registration No. 5467089, filed on 14 February 2017, entered in the register on 15 May 2018, available at: <https://trademarks.justia.com/873/35/non-visual-play-doh-scent-87335817.html>.

Registration No. UK 00002001416, filed on 31st October 1994, entered in the register on 9th April 1996, available at <https://www.ipo.gov.uk/tmcase/Results/1/UK00002001416?printFriendlyView=True>.

Registration No. UK 00002000234, filed on 31st October 1994, entered in the register on 3rd May 1996, available at: <https://www.ipo.gov.uk/tmcase/Results/1/UK00002000234?legacySearch=False>.

- 12 see article (64) of Egyptian law No. 82 of 2002 on the Protection of Intellectual Property Rights: (The person who has registered a trademark and who has made use of it for a period of five years as of the date of its registration shall be deemed the owner of such a trademark, unless precedence of use by a third party is proven. A prior user of the mark may, within the said period of five years, challenge the validity of its registration. The registration of a mark may, however, be challenged at any time, where the registration is made in bad faith). See also: article (18) of United Arab Emirates Federal Law No. 36 of 2021 on Trademarks; article (65) of Commercial Law No. 68 of 1980 as amended by Decree-Law No. 10 of 1987 and Law No. 1 of 2001; article (7) of Trademarks Law of the Gulf Cooperation Council States (the GCC Trademarks Law).
- 13 Article (66) of Egyptian Commercial Code promulgated by Law No. 17 of 1999: ‘All act contravening the customs and norms observed in commercial dealing shall be considered an illegal competition. In that shall be included in particular, the encroachment on a third party’s trademarks...’ ; Article (2/A) of Jordan law No. 15 of 2000 on Unfair Competition and Trade Secrets; Article (60) bis of the Kuwait Trade Law No. 1980, added by Law No. (13) of the year 1996; Article (49) of Oman Royal Decree 55/90 Promulgating the Commercial Law. To-date, in Arab Jurisdictions, no court has addressed the appropriateness of designating or recognising scents per se as trademarks.
- 14 See comparative law: 15 U.S. Code § 1125 (a) Lanham Act: (1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, device, any combination thereof, any false designation of origin, false or misleading description of fact, false or misleading representation of fact, which – (A) is likely to cause confusion, or to cause mistake, or deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or ... shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act. Also: Restatement (Third) of Unfair Competition, Current through June 2009 by the American Law Institute. Chapter 3: The law of trademarks, available at: [http://is.muni.cz/th/169953/pravf\\_m/Extract\\_III.pdf](http://is.muni.cz/th/169953/pravf_m/Extract_III.pdf).
- 15 Articles (62-63) of UAE Federal Decree-Law No. 50/2022 Issuing the Commercial Transactions Law, available at: [https://www.moec.gov.ae/documents/20121/0/DecreeLaw\\_50\\_2022\\_pdf/d34d9209-b407-6e73-9acb-3b01522e94e6?t=1673496808487](https://www.moec.gov.ae/documents/20121/0/DecreeLaw_50_2022_pdf/d34d9209-b407-6e73-9acb-3b01522e94e6?t=1673496808487).
- 16 Article (66) of the Egyptian Commercial Code, available at: WIPO Lex, Egypt, Commercial Code (promulgated by Law No. 17 of 1999).
- 17 Article (10bis) of the Paris Convention for the Protection of Industrial Property.
- 18 Article (67) of Egyptian IP law; Article (4/5) of the UAE Trademarks law; Article (7/2) of Jordan trademarks law and article (62/1) of Kuwait trademarks law.
- 19 Article (7/1/b) of (EU) Regulation No. 2017/1001.
- 20 Article (67) of Egyptian IP law; Article (4/5) of the UAE Trademarks law.
- 21 Trademark Manual of Examining Procedure, United States Patent and Trademark Office, October 2015, §1202.13 ‘Scent. The scent of a product may be registrable if it is used in a non-functional manner’.

- 22 US Registration No. 3332910, filed on 22/11/2004, entered in the register on 6/11/2007, available at: [https://tsdr.uspto.gov/#caseNumber=76621553&caseType=SERIAL\\_NO&searchType=statusSearch](https://tsdr.uspto.gov/#caseNumber=76621553&caseType=SERIAL_NO&searchType=statusSearch).
- 23 United States Patent and Trademark Office, in re Clarke, 17 U.S.P.Q.2d 1238 (T.T.A.B. 1990); see also: USPTO, June 1996, Reg. No. 75,120,036.
- 24 United States Patent and Trademark Office, In re Pohl-Boskamp GmbH & Co., 106 U.S.P.Q.2d 1042, 1052 (T.T.A.B. 2013).
- 25 See Article (62) of UAE Federal Decree law, Article (2) Jordan unfair competition and trade and article (66) of Egyptian Commercial.