

# Wake Up and Smell the . . . PLAY-DOH®?

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**It has been about a year since the toy company, Hasbro, Inc. (“Hasbro”), filed with the United States Patent and Trademark Office ('USPTO') to register the scent of PLAY-DOH® toy-modeling compound.**

Although Hasbro only last year sought registration of the PLAY-DOH® scent, the product was first launched into the marketplace over 60 years ago and Hasbro has used the same scent for the product since the 1950s. Its continuous use, advertising campaigns, and high revenue have earned Hasbro the USPTO's approval of the scent, by itself, for federal trademark registration.

## **But a Scent?**

The federal law that governs trademark law, the Lanham Act, defines a trademark as, “any word, name, symbol, or design, or any combination thereof, used in commerce to identify and distinguish the goods of one manufacturer or seller from those of another and to indicate the source of the goods.”

It's easy to understand how a word can function as a trademark—consumers can identify the source of a product and distinguish it based on its name. For example, the word or name PLAY-DOH® functions as a trademark. It is also easy to understand how a design can function as a trademark. The cloud-like design with bubbled font appearing on the PLAY-DOH® containers is a feature of its design mark. Hasbro also has rights in the product packaging—the yellow containers with red lids, in combination, are features of the overall trade dress of the product. Through a word, name, and design, consumers can identify Hasbro as the source of the product. So what about the scent of PLAY-DOH®?

Applicants can register nontraditional marks with the USPTO. Nontraditional marks include other devices used in commerce, such as sound, taste, scent, motion, or even color alone. Famous examples of sound marks include NBC's chime sound (U.S. Reg. No. 916,522) and MGM's lion roar (U.S. Reg. No. 1,395,550). The first scent mark to register was a plumeria blossoms scent for sewing thread (U.S. Reg. No. 1,639,128). Christian Louboutin continues to fight worldwide for his exclusive rights to the color red as a design on soles of shoes ([See design mark](#), U.S. Reg. No. 3,376,197). However, the USPTO is hesitant in granting exclusive rights to an applicant for nontraditional marks without a clear showing that the mark has acquired distinctiveness in the marketplace.

## **The Process of Securing Registration of a Nontraditional Mark**

To secure federal registration, among other requirements, an applicant must submit the mark, the dates of first use of the mark anywhere and in commerce, and specimens, or samples, showing use of the mark. Now, imagine the examiner that

opened an overnight package to find containers of PLAY-DOH<sup>®</sup> toy modeling compounds to smell. What a day at the office!

In the application of the Lanham Act (and supporting case law), a scent mark cannot be registered without evidence that the mark has *become* distinctive through continuous use in commerce. To be registrable as a mark, scent cannot result from the nature of the product itself and/or scent cannot serve a purpose related to the product's functionality. So perfume or air fresheners are out, as are flavored medicines.

This leads us to the scent of PLAY-DOH<sup>®</sup>. Has it acquired distinctiveness as a trademark, distinguishing it from other products in the marketplace and identifying Hasbro as its source? Is the scent functional?

These were the questions asked by the examiner when Hasbro submitted its trademark application for registration on Valentine's Day last year. The examiner also sought answers to inquiries about the functionality of the scent, as it relates to the product and competitors' products in the marketplace.

The USPTO initially refused registration on the basis that PLAY-DOH<sup>®</sup> toy modeling compound's scent was not distinctive and thus incapable of functioning as a mark.

In its response, Hasbro submitted well over 300 pages of evidence substantiating Hasbro's claim that the scent alone has acquired distinctiveness and that the scent alone functions as a trademark. Declarations from company officers, third-party articles and advertisements, proof of extensive advertising expenditure, and product revenue were all presented as evidence of continuous use. In addition to its pages of evidence of acquired distinctiveness, Hasbro sent the USPTO competitors' toy modeling compounds for the examiner's olfactory analysis (really!). The USPTO relied on evidence that competitors were not using a confusingly similar scent to prove that the scent is not a common feature of this type of product, and as such, is distinctive and nonfunctional.

Hasbro does not yet own a federal trademark registration for the scent of PLAY-DOH<sup>®</sup>. While the mark was approved for publication, and published on February 27, 2018, any individual or entity that may be harmed by registration will have 30 days to oppose registration of the mark.

If you do not have any PLAY-DOH<sup>®</sup> toy modeling compound near you, and if Hasbro is right, you probably can imagine the scent. Otherwise, this article will end with how Hasbro described the mark. You can model your childhood memories on Hasbro's description:

The mark is a scent of a sweet, slightly musky, vanilla fragrance, with slight overtones of cherry, combined with the smell of salted, wheat-based dough.

## **Conclusion**

If you use any nontraditional trademarks in your business, or any trademarks for that matter, and you would like to discuss how to select, protect, and enforce your brand, please contact one of our intellectual property attorneys.

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