

# The Copyrightability of Perfumes: I Smell a Symphony

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*"Perfume is an art form. In the same genre as music and painting. It requires talent, expertise and most of all passion."<sup>1</sup>*

Since the time of the Victorian Era, perfumes have been described in the vocabulary of music. For example, Marie Antoinette's perfumer, Jean-Louis Fargeon, described perfume like a musical composition, "I have ordered my entire life as I ordered my scented compositions. First one strikes a chord in the major mode before letting escape head notes which then rush forward-foolishly, lively, and impatiently like youth. Middle notes follow-sweet, accomplished and vibrant like the full realization of a personality. Finally, heavy, lasting, and tenacious, the bass notes sound."<sup>2</sup> The creation of perfume is a creative and artistic endeavor much the same way that a painting, sculpture or work of music are creative endeavors. Therefore, it would be fair to protect perfume creators through the copyright laws in much the same manner as other artists are protected. However, this issue has never to date been addressed by the U.S. Copyright Office or U.S. federal courts.

This article will address the issues of both perfume copyrightability and the appropriate scope of protection for perfume copyrights. The article begins with a brief summary of the history of the perfume industry. Next, it examines recent Dutch and French decisions on copyright protection for perfumes. Third, it analyzes the issue of perfume copyright protection under U.S. law as well as the appropriate scope of such copyright protection. Following this analysis, the article will conclude that U.S. courts should recognize copyright protection in perfumes, but should also carefully

limit such protections so as not to unduly restrict competition in the industry.

## A BRIEF HISTORY OF THE PERFUME INDUSTRY

The perfume industry has grown from small custom production houses producing simple floral scents to a 20-billion dollar industry selling an image in a bottle to consumers at all price levels. The Roman philosopher Seneca posited that "all art is but imitation of nature."<sup>3</sup> Perfume has exemplified this concept for thousands of years with fragrances that imitate nature in unique and creative ways. The Persian doctor Avicenna, for example, created perfumes over a thousand years ago by distilling and combining various roses and other flowers.

The perfume industry constantly strives to create new scents which, like works of music, convey abstract and complex meanings and associations. The modern perfume industry is characterized by advanced distillation techniques and the use of synthetic molecules to create unique and intriguing scents. The luxury house Chanel's classic scent *Chanel No. 5*, originally released in 1921, is considered by many to be one of the first modern perfumes. The creators of Chanel No. 5 were innovators in the use of synthetic molecules, such as aldehydes, that evoke natural scents like those of rose and jasmine. Today it is estimated that a bottle of the perfume Chanel No. 5 is sold somewhere in the world every 55 seconds.<sup>4</sup>

For many consumers, it is worth paying a premium to have access to a popular scent, while other consumers have discovered a backdoor to a popular perfume via "scent-alikes" or copies of popular scents. These unlicensed copies of scents are created to ride the coattails of the more popular original fragrance by directly copying the original scents and formulas. Scent-alike perfumes can achieve a significant segment of the market because perfumes in most countries have not been protected by copyright or any other intellectual property statute. Importantly, consumers generally cannot distinguish any difference between the original fragrance and the copy, which is not surprising, since quite often the copy

fragrance is made with nearly the exact ingredients and process as the original.

## DUTCH SUPREME COURT DECISION ADDRESSING THE PERFUME COPYRIGHT ISSUE

In the recent decision of *Lancome v Kecofa*,<sup>5</sup> the Dutch Supreme Court was presented with the question of whether a perfume, Lancome's *Tresor*, could be protected from a scent-alike called *Female Treasure* produced by Kecofa B.V. The Court held that Lancome's *Tresor* was protected by copyright which was infringed by a product using 24 of *Tresor's* 26 ingredients.

In reaching this decision, the Dutch court first addressed whether the fleeting nature of perfume precludes copyright protection.<sup>6</sup> The court concluded that while, "the scent itself is too fleeting and variable and dependent on the environment," to be protected by the copyright laws, "material [liquid] that gives off the scent can be perceived through the senses and is sufficiently concrete and stable to be considered a 'work' under the Copyright Act."<sup>7</sup> The Court concluded that since the liquid satisfied the fixation requirement and the perfume was a creative composition, the perfume qualified as a work under the Copyright Act and was thus protected by copyright.

## FRENCH DECISIONS ADDRESSING PERFUME COPYRIGHTABILITY

The French Cour de cassation, France's Supreme Court, has twice taken the position that works intended for consumption primarily through the sense of smell, such as perfumes, lack the creativity to constitute copyrightable expressions. Creators of perfumes, the Court has reasoned, are more akin to craftsman, whose works are not copyrightable, than to writers, whose works are protected.

For example, in *Bsiri-Barbir v. Haarman & Reimer*, the Court de cassation ruled that perfumes, "are not eligible for protection under French copyright law because they are a product of the application of purely technical knowledge and lack, therefore a discernable association with the individual personalities of their creators."<sup>8</sup> For the *Bsiri-Barbir* court, perfumers work as artisans, not as artists in applying the technical skill of perfumery. The court therefore found that perfume does not merit copyright protection because its creativity does not rise to the level of art.

The Cour de cassation recently reasserted its position that a perfume does not rise to the level of copyrightable work in a recent decision overturning a French appellate court's decision that had ruled otherwise. In *Beaute Prestige Int'l v. Senteur Mazal*, the plaintiff claimed that defendant's perfumes *L'Homme* and *Inmate for men* infringed on plaintiff's copyright in Jean-Paul Gaultier's *Le Male*. The Cour d'appel de Paris ruled that notwithstanding the Cour de cassation's decision in *Bsiri-Barbir*, perfume could be copyrightable "precisely because they could embody the imprint of their creators' personalities."<sup>9</sup> The Cour d'appel's *Beaute Prestige* decision was ultimately reversed by the French Cour de cassation on July 1, 2008, which held that perfume is not eligible for copyright protection for the same reasons previously stated in the *Barbir* decision.<sup>10</sup>

In prior years, on the other hand, some French courts had ruled that perfume should be eligible for copyright protection. In 1999 the French Tribunal de commerce ruled that the perfume *Angel* by Thierry Mugler was not merely the product of technical skill but an original work eligible for copyright protection.<sup>11</sup> The Tribunal de commerce noted that *Angel* brought unique scents together in its bouquet, and found unavailing the argument that perfumes are ineligible for copyright protection because their experience is too fleeting and varying in nature. The Tribunal compared the experience of smelling a perfume as akin to listening to the varying nature of music that is susceptible, like perfume, to the environment of the listener or wearer.<sup>12</sup>

Following in the footsteps of the *Angel* decision the Cour d'appel de Paris decided in January 2006 that various perfumes by L'Oreal, Prestige, Parfums Cacharel, Parfums Ralph Lauren and Parfums Guy Laroche could be protected by copyright.<sup>13</sup> The *L'Oreal* court reasoned that the French copyright statute did not exclude perfumes from being protected, French copyright law does not require the work to be fixed, only perceptible, and a perfume should therefore be copyrightable if it is original and reveals the creativity of its author.<sup>14</sup> After finding that the plaintiffs' perfumes were original and therefore protected by copyright, the court concluded that defendant's perfumes infringed upon plaintiffs' various copyrights. The court used chemical analyses and testing on the public in reaching its conclusion on the issue of infringement. As discussed below, this article finds these



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French pro-copyrightability decisions, as well as the decision of the Dutch Supreme Court, as better models for United States courts to follow.

### **PERFUME COPYRIGHT PROTECTION UNDER UNITED STATES LAW**

Surprisingly, the issue of copyrightability of perfume is yet to be addressed by any U.S. court. However, the issue of protecting a scent has been litigated in various other contexts, such as under the trademark law. For example, *In re Clarke*, the Trademark Trial and Appeal Board ("TTAB") permitted a Californian company to register a plumeria flower scent as a trademark for its sewing thread and embroidery yarn.<sup>15</sup> Although registration of the mark had initially been rejected, the TTAB found that because the scent served a *non-functional purpose*, and the owner had provided enough evidence to support a showing of acquired distinctiveness, the scent could be registered.<sup>16</sup> A perfume's scent, however, is not eligible for trademark protection because the scent serves as the functional purpose of the product. Unlike the *Clarke* case above where the scent of the sewing thread and yarn served no purpose other than as a source identifier, perfumes primary function is to provide the wearer with a pleasant scent. Thus, trademark law does not provide an alternative to copyright law for protection of the scent of the perfume.

### **U.S. COPYRIGHT ACT SUBJECT MATTER REQUIREMENTS**

Can perfumes qualify as appropriate copyright subject matter under the U.S. Copyright Act ("The Act")? The Act provides that, "copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible

medium of expression, now known or later developed."<sup>17</sup> The requirement of originality simply requires that the work, "owes its origin to the author, i.e., is independently created and not copied from other works."<sup>18</sup> There is no requirement that a copyrighted work be novel in the meaning of the Patent Act, and "[a]ny "distinguishable variation" of a prior work will constitute sufficient originality to support a copyright if such variation is the product of the author's independent efforts, and is more than merely trivial."<sup>19</sup> With a palette of hundreds of varieties of natural scents and many more synthetic scents, as well as variations in quantity and ratio, a perfumer has an almost endless ability to create original perfumes. Therefore, a perfumer clearly has the ability to create a perfume that differs from other preexisting perfumes so as to qualify as an original work.

Moving on to the requirement of "works of authorship," this language, according to the House Report on the matter is, "purposely left undefined . . . to incorporate without change the standard of originality established by the courts."<sup>20</sup> The House Report further provides that an expansion of copyrightable subject matter is appropriate to cover works, "in existence for generations or centuries [but that] have only gradually come to be recognized as creative and worthy of protection."<sup>21</sup> The House Report foresaw that certain mediums of expression can develop into creative works and that the Copyright Act should extend to such works. The perfume industry appears to have evolved to such a state of creativity.

The final requirement for subject matter of copyright under U.S. law, to be "fixed in any tangible medium of expression," requires that the expression of an idea have some concrete form which can be perceived "either directly or with the

aid of a machine.” Fixation in a tangible medium further requires that the expression be, “sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration.” It should be noted that broadcasts of television and radio, which are not stable or permanent, are therefore only protected by the Act under a specific section that provides for such protection.<sup>22</sup> Perfumes, while detected by their scents,<sup>22</sup> are embodied in tangible liquids. Furthermore, these liquids have a sufficiently permanent duration, since most perfumes have a long shelf life, particularly if they are made with alcohol. There is therefore sufficient basis to conclude that perfume satisfies all of the requirements of copyright subject matter under the Act.

### THE APPROPRIATE SCOPE OF PROTECTION FOR PERFUME COPYRIGHTS

In deciding the question of infringement, courts employ a substantial similarity test to make a factual determination as to whether a particular work has actually infringed upon the rights of another. The question of infringement is a fact specific issue and the test for how literal the copying must be will vary according to the context.<sup>23</sup> In areas of works of human expression that allow for large variations and robust creativity, courts will allow for a greater scope of copyright protection. As one court put it, “[t]he law is more protective of highly original and highly expressive works than it is of functional and nonfiction works.”<sup>24</sup> On the other hand, with respect to works of human expression which have less room for creativity, courts permit only “thin” copyright protection, using a “striking similarity” test or identical copying test in deciding whether a work has actually infringed upon another work. Such an identical copying test permits for other authors in such narrow domains the ability to create new works that bear some similarity to other works that are not identical copies. The concept of thin copyright protection in a narrow domain of creativity is “separate from but related to the concept of idea-expression merger.”<sup>25</sup>

While the field of perfumery has a tremendous amount of possible creations, the human sense of smell cannot distinguish among minor variations. Therefore, thin copyright protection should be appropriate for such works. Previously decided cases involving infringement of animal pins

provide a good example of this concept. In the case of *Herbert Rosenthal Jewelry Corp. v. Grossbardt*, the court found a clear case of infringement where the defendant produced jeweled turtle pins *precisely identical* to those of plaintiff which were found to be infringing.<sup>26</sup> In a case decided a year later, a defendant created jeweled bee pins identical to those of Herbert Rosenthal Jewelry Corp. *except* for the pattern of veins in the wings.<sup>27</sup> The court, finding there to be “no greater similarity between the pins of plaintiff and defendant than is inevitable from the use of jewel-encrusted bee forms in both,” held that there had been no copyright infringement.<sup>28</sup> Similarly, in order to permit the manufacture of different, although related fragrances, courts should employ an identical or essentially identical copying test in their infringement analysis. By placing a restriction on the scope of copyright protection, the field of possible scents will not be overtaken by a few dominant rights holders, and those perfumers who seek to create an original and separately recognizable scent will still be rewarded for their ingenuity and artistic contributions.

### CONCLUSION

This article advocates in favor of the application of copyright protection to perfumes. As the creation of perfumes is a creative endeavor, the works created should receive protection in much the same manner as other creative works such as music, painting and literature. To deprive the perfumers of copyright protection for their works would not provide the appropriate incentive and rewards for this artistic endeavor.

However, this article recognizes the importance of not extending an overly broad scope of protection to perfume copyrights. Copyrights on perfumes should protect only against identical or essentially identical copying, since the creativity of perfumes is sharply constrained by precise objectives and human limitations. The perfumer, while creative, is much more confined by practical considerations than are authors and playwrights, and are subject to the limited ability of the consuming public to finely distinguish between scents. Although the benefits of perfume copyright protection to the perfumer are undeniable, the courts must not lose sight of the interests of competitors. A carefully defined and limited scope for perfume copyrights will permit

fair competition while creating the most favorable environment for rewarding creativity and for the continued growth and expansion of the perfume industry. **IPT**

### ENDNOTES

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28. *Id.* at 742.