

The Legal Challenges of Registering Motion Marks in India: A Comparative Study of Graphical Representation and Distinctiveness with Other Countries

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Abstract

The authors of this research paper explore the evolving issues of non-traditional trademarks in India, with a specific focus on motion marks. Non-traditional trademarks, which include shapes, sounds, smells, tastes, and movements, challenge the conventional scope of trademark law, especially due to the requirement for graphical representation. According to the Trade Marks Act of 1999, trademarks are required to effectively distinguish goods or services and must be represented graphically, which poses obstacles for marks that incorporate dynamic or non-static characteristics. The paper analyses the challenges confronted by motion marks, focusing on the difficulty of capturing and visually representing movement. Additionally, it showcases successful examples, such as the registration of LG's "Falling Drops" and Coca-Cola's animated "Contour Bottle," highlighting the potential for these types of marks to receive legal protection. The paper contends that advancements in technology could influence the future of non-traditional trademark registration in India. This article also investigates the growing acceptance of motion marks (trademarks that are animated or in motion) across different jurisdictions. It addresses the various legal frameworks, registration processes, and associated challenges. Motion marks are increasingly recognized globally, particularly in the United States, the European Union, South Korea, and the United Kingdom. The United States was the pioneer in allowing the registration of motion marks, adopting a more adaptable approach. In contrast, the European Union revised its guidelines in 2017 to allow for digital formats, including video submissions. Likewise, both South Korea and the EU have adjusted their laws to embrace non-traditional trademarks, fostering a more inclusive trademark landscape.

Keyword: Distinctiveness, EU, Graphical representation, International agreement, Motion mark, Unconventional trademark, US

Introduction

The preamble of Trade marks Act of 1999 serves to modify and unify the laws regarding trademarks, ensuring their registration and enhanced protection for goods and services while preventing the misuse of counterfeit marks. India's responsibilities under the TRIPS Agreement for trademark protection include safeguarding distinctive marks, acknowledging service marks, offering unlimited renewal periods for registrations, and eliminating the mandatory licensing of trademarks. With the rise of global trade, brand names, trade names, and marks have grown significantly in value, necessitating uniform minimum

protection standards and effective enforcement procedures, as recognized by TRIPS. As a result, the Trade Marks Act of 1999 was created after a comprehensive examination of the earlier Indian Trade and Merchandise Marks Act of 1958. This 1999 Act, along with its subsequent amendments, aligns with TRIPS and adheres to international standards and practices. A trademark is defined as a mark that can be graphically represented and serves to distinguish the goods or services of one entity from those of others; it can encompass the shape of products, their packaging, and colour combinations. Regarding registered trademarks or marks associated with goods or services, they signify or suggest a trade connection between the goods or services and an individual who has the rights as the proprietor to utilize the mark. Additionally, in relation to other aspects of this Act, a mark utilized or intended for use concerning goods or services indicates or suggests a trade connection between the goods or services and any person with rights, whether as a proprietor or authorized user, to use the mark, regardless of whether the identity of that person is indicated. This definition also includes certification trademarks and collective marks.

A trademark is a sign or combination of sign which is used to distinguish a goods of one person from another person¹. Any mark that does not come under the traditional categories of trademarks such as letters, words, logos, numerals, pictures, and symbols may be termed as non-traditional trademark. Non-conventional trademarks therefore consist of marks originating from shapes, sounds, smells, tastes and textures². Trade marks that are different from the usual trademarks, namely, logos, words, phrases, and symbols are unconventional trademarks. Unique concepts of shape, smell, fluid, motion, and colour come into the picture. Because of their unusual nature, they are comparatively difficult to register, however, if the unique trade mark has been associated with the brand and is a product of original creativity, there are higher chances for it to be accepted by the Registry.

Literature Review

Sapna Singh's article examines trademark law in the cosmetics sector, focusing on unconventional trademarks such as colours, shapes, and scents. It highlights the growing market and issues related to counterfeiting, emphasizing the necessity for robust legal protections. The article analyses international approaches and India's stance on these non-traditional trademarks.³ (Sapna Singh, 2024)

The discussion includes the legal complexities surrounding non-conventional trademarks in India, comparing it to the United States' flexible approach and the European Union's cautious stance. It points out that Indian trademark laws often restrict non-visual marks because of strict graphical representation requirements, resulting in inconsistent rulings concerning colours and shapes. The review suggests that Indian regulations should align with international standards to provide clearer protections.⁴ (Rachna R. Kurup & Nimita Aksa Pradeep, 2020)

This article examines the legal foundations for non-traditional trademarks in both Sri Lanka and India, emphasizing the need for registrability and highlighting the challenges associated with graphical representation requirements. Although both countries comply with TRIPS, it implies that they should work together to identify areas that require reform to align with global norms⁵. (Althaf Marsoof, 2007)

¹ Introduction To Trademarks, Anil Babu Shete

² Non-Conventional Trademarks, IPPRO

³ "Unconventional Trademark Protection in the Cosmetic Industry: Insights from the US, Europe, and Lessons for India" by Sapna Singh

⁴ Non-Conventional Trademarks In India: The What, The Why And The How by Rachna R. Kurup & Nimita Aksa Pradeep

⁵ The Registrability of Unconventional Trademarks in India and Sri Lanka: A Comparative Analysis, by Althaf Marsoof

The article explores the registration process for non-conventional trademarks, particularly motion marks, in the European Union. It highlights challenges such as graphical representation and distinctiveness and analysis relevant European legislation and case law to establish a clear legal framework for applicants seeking to protect their distinctive branding.⁶ (Guðmundur Haukur Guðmundsson, 2014)

This article explores trademark's historical development, types (such as service, collective, and certification marks), and legal characteristics like distinctiveness and non-deceptiveness. It explains the trademark registration process at national, regional, and international levels, also the importance of protecting brand identity. The paper also discusses the duration of trademark protection and the rise of well-known trademarks. The author concludes by highlighting the emerging commercial significance of trademarks, citing examples like Grumpy Cat and Dogecoin. (Ritu Tiwari, 2024)⁷

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In this paper, the author discusses the evolution and recognition of non-conventional trademarks in India. While traditional trademarks require graphical representation, non-conventional marks challenge this norm. The authors argue that acknowledging these marks can enhance competition and align with global trends, highlighting international treaties and comparisons with U.S. trademark law as pivotal to this discourse.⁹ (Tanisha Agarwal & Vanshaj Mehta, 2017)

The document discusses non-conventional trademarks, defined under the TRIPS Agreement, which include marks that don't fit traditional categories like letters or symbols. It categorizes these into visual (e.g., colour, shape) and non-visual marks (e.g., sounds, scents). While the Indian Trademark Act of 1999 recognizes these marks, challenges persist in registration due to graphical representation requirements. Examples include sound marks registered by companies like Intel and ICICI Bank. The evolving legal landscape raises questions about the balance between trademark protection and public access to cultural works. (Dr. Raju Narayana Swamy IAS, 2022)¹⁰

Motion marks, also referred to as animated or movement marks, represent a category of non-conventional trademarks that use movement to distinguish goods or services. The registration of such requires a description of the motion's components and interactions. Both the U.S. and EU recognize motion marks, allowing for their registration under certain criteria, despite challenges in graphical representation and distinctiveness. (Kritarth Pandey, 2014)¹¹

The paper on motion marks, a type of non-conventional trademark, highlights their role in branding through dynamic visual elements. While recognized in jurisdictions like the U.S. and EU, challenges persist regarding their registration due to requirements for distinctiveness and graphical representation.

⁶ Registrability of Motion Marks: Problems and Possibilities by Guðmundur Haukur Guðmundsson

⁷ "Trademark in Sports Law - A Critical Analysis" by Ritu Tiwari

⁸ Introduction To Trademarks, by Anil Babu Shete

⁹ Hear Me, Touch Me, Taste Me, Smell Me: Conventionalizing Non-Conventional Trade Marks in India, by Tanisha Agarwal & Vanshaj Mehta

¹⁰ Nonconventional trademarks in India: Reconciling the American approach of "anything goes" and the Sieckmann approach of Europe, by Dr. Raju Narayana Swamy IAS

¹¹ Non-Conventional Mark: A Legal Analysis, by Kritarth Pandey

The emerging legal landscape reflects a growing acceptance of these marks as vital identifiers in modern India. (Dr. Mwirigi K. Charles* & T. Sowmya Krishnan, 2019) ¹²

Research Problem

The problem addressed here is the registration of motion marks in India and the complicated procedure involved in the registration process.

Research Question

Whether Trade Mark Act 1999 fails to adequately recognise unconventional trademark especially motion marks as compared to other countries?

Research Methodology

In this research study, we used a comparative analysis to substantiate and validate our research problem. We gathered data from various articles and utilized it to propose feasible solutions for the issues identified.

Research Method

In this article the author used secondary data to substantiate the research problem. We collected the data from various literature reviews as well as from several websites of the official trademark registration board to validate our point.

In this article, the author utilized secondary data to support the research problem. We gathered the data from various literature reviews and several official trademark registration board websites to strengthen our argument.

Scope and Limitation

This research examines the evolving challenges and possibilities associated with non-traditional trademarks in India, with a specific focus on motion marks. It discusses the limitations imposed by the Trademarks Act of 1999, which mandates a visual representation to distinguish goods and services. The research highlights the inherent difficulty in visually representing dynamic elements such as movement, which complicates the process of registering motion marks. Through a legal examination, the paper explores how these constraints create obstacles for non-static trademarks, as well as technological advancements that could facilitate improved representation. Additionally, it showcases successful instances like LG's "Falling Drops" and Coca-Cola's animated "Contour Bottle," underscoring the potential for these marks to gain legal protection. The study seeks to investigate how non-traditional trademarks can be incorporated into the existing legal framework balancing innovation with the regulatory requirement for graphical representation.

Indian Law and Motion Mark Discussion – Distinctive Requirement And Represented Graphically

Motion marks are not explicitly protected under Indian laws. Usually, trademarks are protected under trademark act 1999 and Trademark Rules 2017. India is signatory of various international agreements and organisations which also protects trademarks. With liberal interpretation and judicial precedents motion mark is considered to be protected under trademark act 1999 and trademark rules 2017. Multimedia

¹² Registrability of non-conventional trademarks: A critical analysis, by Dr. Mwirigi K. Charles* & T. Sowmya Krishnan

production also being reason for creation of more non-conventional trademarks including holograms, gestures and motion or moving image marks. Their registration requires the use of a sequence of pictures or drawings to portray how the trademark functions. Motion marks are the most common of the multimedia marks.

Section 2(1)(m) of the Trade Marks Act, 1999 defines a “mark” which includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination.

Section 2(1) (zb) defines “trade mark” as “a mark capable of being graphically and which is capable of distinguishing the goods or services of one person from those of others and may include shape of goods, their packaging and combination of colours”.

Rule 2(1)(k) of the Trade Marks Rules, 2017 defines graphical representation as “the representation of a trademark for goods or services represented or capable of being represented in paper form, including representation in digital form”

There are three characteristics of trademark which shall be understood from the above definitions. Trademark should be able to be distinguished from others, it shall not be deceptive, it shall be able to graphically represented.

Graphically Represented

There are no registrations in India with regard to Scent, Motion, Hologram, Taste and Touch mark. This is due to the primary requirement of Graphical Representation. The Indian Trademark Regime has, so far, imitated the stand of European Union as far as the prerequisite of graphical representation for a trademark is concerned¹³. It can be stated that the Indian Trademark Act 1999 has put a burden of capability of graphical representation as a condition for the registration of a trademark. In today’s world, the use of sound, scent, colour, motion or holograms as a trademark is bound to increase in the nearby future. Thus, it is essential to liberalize our trademark regime by removing the requirement of graphical representation for the non-conventional trademarks¹⁴.

In *Swizzels Matlow Ltd Application*¹⁵, The court emphasised two reasons for requirements of graphical representation, 1) To enable traders to identify what other traders have applied for registration for trademark and for which product. 2) To enable the public to determine with precision, the sign which forms the subject of trademark registration. In India, the clarity has not been arrived.

The requirement for graphical representation often leads to difficulties in accurately depicting the movement associated with the mark. Many applications have been rejected because static images fail to convey the dynamic nature of motion marks.

Graphical representation which is stated under Section 2(1) (z b), is the sine qua non of trademark registration in India. This means that the marks should be capable of being printed in a journal or to be precise be in paper form. This requirement is a major hindrance to the registration of non-conventional trademarks in India. Whereas Rule 2(k) of Trademark Rules 2017 extended the said definition to include representation through a digital form also. Graphical representation of motion marks includes movement

¹³ HEAR ME, TOUCH ME, TASTE ME, SMELL ME: CONVENTIONALIZING NON-CONVENTIONAL TRADEMARKS IN INDIA Tanisha Agarwal¹ & Vanshaj Mehta²

¹⁴ Non-Conventional Mark: A Legal Analysis, Kritarth Pandey

¹⁵ *Swizzels Matlow Ltd Application* (No 2) (2000) ETMR 58

of particular word, symbol, logos etc along with the sound which is hard to explain it in a written form. The strict scrutiny in India seems hindrance for not registering huge motion marks for trademarks.

In instance, Colgate's trademark¹⁶ was conveyed through its distinctive colour scheme and packaging design, which needed to be visually illustrated to highlight its uniqueness. The court acknowledged that consumers connected the specific red and white colour combination with Colgate products, thereby emphasizing the necessity for a clear visual representation that could be readily recognized by the public. The court's ruling highlighted that graphical representation must satisfy specific criteria; it should be clear, precise, and self-contained. This is consistent with the standards set forth in cases like *Sieckmann v. German Patent and Trademark Office*¹⁷, which stated that a mark should be presented in a way that is understandable and lasting. In the case of Colgate, the court determined that the graphical representation of its packaging successfully conveyed the mark's identity and distinctiveness.

Despite these challenges, there is a growing recognition of motion marks within the Indian legal framework. The increasing use of technology and multimedia suggests that future amendments may allow for more flexible representations of trademarks. Other jurisdictions have already started accepting video files and other multimedia formats for trademark registration, which could pave the way for similar changes in India.

Distinctiveness

The problem faced by non-traditional trademark applications is that Smell Mark, Taste Mark, Motion Mark, Touch Mark, Hologram Mark, etc. - cannot be visually perceived. Section 9(1) (a) of the Indian Trade Marks Act, 1999 which prescribes “absolute grounds for refusal” Marks which are not prima facie “capable of distinguishing” the goods or services of one person from those of the other are devoid of distinctive character. It may still be registered if it can be shown that on the date of the application the mark has in fact acquired a distinctive character as a result of the use made of it.

It can be argued that if a non-traditional trademark has acquired distinctiveness as a result of its continuous use, and a lot of people in fact associate the mark with its source, then such marks should be granted registration under this section¹⁸.

The level of accuracy required depends on the mark itself and its distinguishing character. There are allowable variations in the graphical representation of each mark. It is up to the national court to determine whether a particular graphic representation in respect of an unconventional trademark is enough or not¹⁹. It must be made from a distinctive sign capable of acting as the identifier of the source. It shall not create confusion in the minds of the public, and should not deceive people.

Therefore, TRIPS do not mandate graphical representation as an essential component to register a trademark and even if the signs are not capable of distinguishing, it says that they should be registered on the basis of distinctiveness on its public use.

The functionality principle refers to the idea that a mark cannot be registered if it serves a purely functional purpose, i.e., if its primary purpose is to perform a function rather than to indicate the source of goods or services. If the movement or animation is merely, it would be ineligible for trademark protection. The functionality principle is typically applied through the lens of distinctiveness, meaning that if the motion

¹⁶ Colgate-Palmolive Co. And Anr. vs Sundeep Enterprises on 1 July, 1995; 1995(35) DRJ119

¹⁷ *Sieckmann v. German Patent and Trademark Office*; C-273/00, 2003 E.T.M.R. 37.

¹⁸ Hear Me, Touch Me, Taste Me, Smell Me: Conventionalizing Non-Conventional Trade Marks In India Tanisha Agarwal & Vanshaj Mehta

¹⁹ Registrability of non-conventional trademarks: A critical analysis Dr. Mwirigi K. Charles* & T. Sowmya Krishnan

element of the mark is essential for the function or purpose of the goods, it will be deemed non-registrable. This aligns with the principle that trademarks are meant to serve as identifiers of source, not to protect functional aspects of a product²⁰.

Few successful registered motions in India

Motion marks are trademarks that protect logos or brand features that use animation or movement in India. A number of well-known firms have successfully filed motion marks to safeguard their dynamic visual identities, despite the fact that they are less common than static marks. For instance, LG's "Falling Drops" animation has been granted a motion mark, signifying creativity and novelty. A key component of Coca-Cola's branding is the animated "Contour Bottle", for which the company has a registered mark. Yahoo! has registered its "Y!" logo animation, which strengthens its online presence. Following its successful registration as a motion trademark in the UK, TOSHIBA submitted an application for trademark registration in India in 2019. It's worth mentioning that after initially objecting to the registration on the grounds that motion trademarks are not allowed in India, the registry ultimately accepted the mark²¹.

Nestlé has the registration for the "KitKat" break animation, which reflects its popular tagline, while Microsoft has a motion mark for the Windows starting animation, which is a crucial component of its user experience. Similarly, Apple's animated logo used in software interfaces is a registered motion mark. By guaranteeing exclusive rights over their unique representations, these registrations protect the dynamic or animated elements that are essential to the companies' identity. Motion marks are becoming more and more important in the digital age as companies try to set themselves apart with interactive and multimedia branding. Though they are very few in number when compared to regular device marks, the aforementioned instances highlight some well-known foreign firms that have acquired motion marks in India.

Nokia's 'Connecting Hands' Logo is Registered as a Device Mark, not a Motion Mark²²

Nokia's "Connecting Hands" logo, which represents communication and connection, is usually displayed as a still image of two hands grabbing together. Even though its visual shape can imply movement or interaction, it is immobile. As a result, it falls within the category of a device mark, which safeguards the logo as a visual representation of the company. For a motion mark to be used, the movement's precise sequence—the motion itself—must be essential to the brand's identity. Motion marks are increasingly being recognised under trademark law for logos and companies that employ animated features or transitions, even when the motion is not always visible. In this regard, they can contend that Nokia's "Connecting Hands" logo, which is utilised in a variety of media, symbolises a progressive motion that ought to have been legally acknowledged as a motion mark.

International Convention With Regard To Motion Mark

1. TRIPS agreement

The implementation of the TRIPs agreement recognizes the evolving trends in trademark law and their importance in today's business landscape. Specific trademarks have influenced current business behaviours, depending on the connections, reputations, and identities created by these marks. The TRIPs

²⁰ Nor- Am Chemical vs O.M. Scott & Sons Co

²¹ Are Motion TradeMarks Protected?

²² Non-Conventional Trademark – A Brief Insight Anoushka Suresh

agreement mandates the acknowledgment and safeguarding of these new developments in trademark protection.²³

Article 15 of TRIPS agreement states that any sign, or any combination of signs, that can distinguish the goods or services of one business from those of others can qualify as a trademark. These signs may include words (including personal names), letters, numbers, visual elements, combinations of colours, or any mix of these signs. If a sign does not inherently distinguish the goods or services in question, members may decide that its eligibility for registration depends on distinctiveness that has been acquired through use. Additionally, members may require that the signs are visually perceptible as a condition for registration²⁴. This article permits the registration of unconventional marks as valid trademarks. The requirements for registering an unconventional mark are simple and reliable. The complex procedure of graphical representation is not strictly enforced, making it easier to register such marks, which are also protected against infringement. But there is no explicit provision which speaks about the registration of motion mark²⁵.

2. Singapore treaty

The Singapore Treaty on the Law of Trademarks was adopted in 2006 and allows for the registration of various non-traditional trademarks, including motion marks, among its signatory countries. This treaty was developed by the World Intellectual Property Organization (WIPO) to establish a standardized administrative process for trademark registration worldwide. Under the rules and regulations of this act, if an application indicates that the mark is a motion mark, the depiction can consist of either a single image or a series of still or moving images that illustrate the movement, at the discretion of the Office. If the Office determines that the submitted image or images do not adequately represent the movement, it may request additional images from the applicant. Additionally, the Office may ask the applicant to provide a detailed description explaining the movement.²⁶

Rule 3(10) provides contracting parties with the flexibility to determine the format and details for displaying non-visible signs. This rule allows contracting parties to request one or multiple representations of marks, without specifying that these representations must be graphical. This ambiguity has led to a broader interpretation of trademark representation. As a result, the term "representation" is now understood to encompass various forms, including graphic images, photographic images, descriptive files, and electronic data. This flexible approach encourages greater creativity in registering non-traditional trademarks and has streamlined the registration process by eliminating the need for a graphical representation.²⁷

Other Country and Their Acceptance

The legal status of motion marks, which are trademarks that incorporate movement or animation, has evolved globally over the years. Various countries have adopted different frameworks to accommodate these dynamic trademarks.

²³ International Treaties and The Law of Trademark; Impact of International Treaties on The Development of The Law of Trademark by Sanjit Kumar Naskar

²⁴ Agreement on Trade-Related Aspects of Intellectual Property Rights, TRIPS agreement

²⁵ Registrability of motion mark: Problems and Possibilities, by Guðmundur Haukur Guðmundsson

²⁶ Regulations Under the Singapore Treaty on The Law of Trademarks, Rule (3)(6) [Motion Mark]

²⁷ The Applicability of The Graphical Representation Requirement on The Registration of Non-Traditional Trademarks: Comparative Analysis of a Possible Update in The Andean Community Regulation in The Light of The European And Chinese Experiences by Natalia P Rez Acevedo

1. US and motion mark

The United States is the first nation to acknowledge the motion mark on a global scale. The first motion mark registration occurred in 1996 for an animated depiction of women bearing a torch, registered by Columbia Pictures Multimedia Limited²⁸. United States Patent and Trademark Office (USPTO) is a federal agency responsible for granting Patent and Trademark in the US. According to Article 1, Section 8, clause 8 of the US Constitution, the government is empowered to promote the progress of science and useful artistic works for a limited period of time by granting exclusive rights to the inventors and the authors for their discoveries and writings. The USPTO registers trademarks once an application is submitted by the inventor in accordance with the Lanham Act.²⁹ This act regulates the registration of trademarks in the United States. And allows for registration of both the traditional and unconventional trademark due to the USPTO's liberal and interpretation of statutes. Section 15 U.S.C. § 1051 outlines the registration process for trademarks, while section 15 U.S.C § 1052 addresses the requirement and uniqueness for the process of registration i.e. how it was particularly differing from other brands present in the market.³⁰

The Trademark Manual of Examining Procedure (TMEP) is a free manual published by the USPTO for the purpose of guidelines and procedure need to be followed while granting trademark and handling the application for such. As per Section 807.11 of TEMP deals with the Marks with Motion. It states that if any applicant wants to register the motion mark then he should submit a drawing that captures one specific moment of that movement or to offer a square drawing featuring up to five freeze frames that depict various phases of the movement, based on which option better illustrates the mark's commercial significance. And here motion means short repetitive action. Along with the drawing he should submit a detailed description of the mark. And according to TMEP Section 904.03(1), specimens for motion marks—trademarks that feature a moving image or animation—must depict the entire sequence of motion through either a series of frames or a video file. Applicants are permitted to submit digital formats (like .mp4 or .gif) through TEAS (Trademark Electronic Application System), along with a comprehensive description explaining the distinctive aspects of the motion. The specimen must also illustrate actual usage in commerce, linking the motion mark to the associated goods or services as a source identifier.³¹

There are several registered motion marks in the United States. In 2003, a motion mark was registered for the famous March of the Ducks, which took place twice daily at the Peabody Hotel in Memphis. This tradition has been practiced by the hotel for over 80 years as a show for guests and fans. The registered motion mark depicts the Duckmaster rolling out the red carpet for five trained ducks to march across.³²

The motion trademark for the Microsoft Windows emblem was officially filed on July 21, 2015, showcasing a sequence in which the four-pane window logo shifts to create a three-dimensional effect. This registration allows Microsoft to protect the unique animated depiction of the Windows logo as it appears during various system processes, such as start-up screens, enhancing brand recognition through animation.³³

²⁸ Motion Trademarks in 2022: Procedure, Benefits, Requirements

²⁹ The United States Patent and Trademark Office (USPTO)

³⁰ U. S. Trademark law, federal statutes

³¹ Trademark Manual of Examining Procedure (TMEP), United States Patent And Trademark Office Eighth Edition, October 2011

³² Animated "Motion Trademarks" Grow in Popularity and Legal Protection Around the World, By: Belinda J. Scrimenti, Pattishall, McAuliffe, Newbury, Hilliard & Geraldson LLP

³³ Registration of motion mark as trademark by Sonisvision

The motion mark for Big Metal Bird was registered in 2017 by USPTO. It was associated with the web series exploring the airline industry³⁴. And Lamborghini has successfully registered a motion trademark for its "Scissor Doors." This trademark pertains to the unique upward motion of the car doors, which first open parallel to the vehicle body before gradually lifting to a fully open stance. This innovative design enhances Lamborghini's brand identity and showcases the distinct aesthetic of their high-performance cars.

In 2016, the "Rocket Mortgage" brand of Quicken Loans secured a U.S. motion trademark for its animated representation of a "rocket launch." This trademark signifies the brand's online mortgage service, employing the imagery of a rocket launch to convey the swift and efficient characteristics of their mortgage application process. It exemplifies a modern branding approach that employs motion to create distinctive and memorable identifiers.³⁵

2. How does the EU recognize motion marks?

Initially, the European Union did not have a clear framework for accepting unconventional trademarks. In the "Sieckmann" ruling by the European Court of Justice in 2002 established key standards for registering unconventional trademarks, like scents and sounds, in the EU. The court ruled that trademarks must be clear, precise, self-contained, understandable, durable, and objective. This decision arose from an attempt to register a scent mark, as descriptions or chemical formulas were deemed insufficient for public understanding. These guidelines ensure clarity and consistency in EU trademark laws.

At that time a Danish biotechnology firm, Nuevolution A/S, encountered difficulties in obtaining approval for a motion mark under EU regulations. Their first application was rejected because the graphic representation failed to adequately depict the movement, which is essential for brand identification. Even after they included sequential still images, the court deemed these visuals insufficient for conveying the intended motion. This case underscored the importance of clear representation in motion marks according to EU regulatory standards. However, recent updates now permit the submission of motion marks in video format to better illustrate dynamic content.³⁶

The recent EU Trademark Regulation (Regulation No. 2017/1001), which came into effect on October 1, 2017, has eliminated the former necessity for trademarks to be graphically depicted for registration. This modification allows applicants to register non-traditional trademarks, such as motion marks, in a variety of digital formats, including video files (e.g., MP4). This change streamlines the registration process for these kinds of trademarks. The regulation seeks to enhance clarity and accessibility within trademark applications by tackling the challenges that previously hindered the registration of motion marks due to graphical representation requirements. This modernization brings the EU trademark system closer to the practices in countries like Australia, which already permit video submissions for the registration of motion marks.³⁷

European Union Intellectual Property Office (EUIPO) is an organisation in charge of overseeing designs and trademarks that are recognised in all EU member states is the. With its headquarters in Alicante, Spain, the EUIPO is in charge of the registered Community design (RCD) and EU trademark (EUTM) systems. With just one application, these systems allow companies and individuals to secure trademark and design rights protection across the EU.

³⁴ Importance and Challenges of Protecting Motion Mark-India, by Ananyaa Banerjee and Sandhya A. Parimala

³⁵ Animated "Motion Trademarks" Grow in Popularity and Legal Protection Around the World, By: Belinda J. Scrimenti, Pattishall, McAuliffe, Newbury, Hilliard & Geraldson LLP

³⁶ Importance and Challenges of Protecting Motion Mark-India, by Ananyaa Banerjee and Sandhya A. Parimala

³⁷ New trademark regulation provides for better options for registering motion marks, by Christina Type Jardorf

The EUIPO, originally established in 1994 as the Office for Harmonisation in the Internal Market, plays a vital role in ensuring legal enforcement, brand protection, and support for innovation across the EU market. By collaborating closely with national intellectual property (IP) offices in EU member states, the EUIPO has expanded its activities over the years. These initiatives include raising awareness about intellectual property and providing digital tools to simplify IP protection. As a result, brand owners can effectively safeguard and enforce their intellectual property rights within the single European market. The EUIPO registers trademarks in accordance with the European Union Trademark Regulation (EUTMR) and the European Union Trademark Implementing Regulation (EUTMIR). Article 3(3)(h) of the EUTMIR outlines the requirements for representing a motion mark. This article specifies that a video file or a series of consecutive still images must be used to demonstrate the movement or change that constitutes the trademark. If still images are used, they should be numbered or accompanied by a caption that explains the sequence of movement.³⁸ Article 4 of the European Union Trade Mark Regulation (EUTMR) states that various types of signs can be registered as EU trademarks. These signs can include words, human names, images, letters, numbers, colours, shapes of objects, their packaging, or even sounds. To qualify as an EU trademark, a sign must meet two criteria: (a) it must distinguish a company's goods or services from those of other companies, and (b) it should be listed in the Register of European Union Trade Marks (referred to as "the Register"), allowing the public and relevant authorities to clearly identify the scope of protection granted to the trademark's owner.³⁹

In January 2019, Toshiba Corporation made history by becoming the first company to register a "motion" trademark under the revised UK trademark legislation. These updates allow for the registration of dynamic or moving marks through the submission of multimedia files, which can include video, holographic, or sound elements. This change represents a significant shift from previous regulations that required trademarks to be submitted as static graphic illustrations. Toshiba's motion mark features a multimedia file that showcases vibrant polygon shapes surrounding its iconic red lettering. This milestone is particularly noteworthy, especially following Google's recent success in registering its first holographic trademark. It highlights the growing acceptance of non-traditional trademarks in the digital era. The Intellectual Property Office (IPO) has recognized the need for modernized trademark regulations that reflect advancements in technology and branding strategies. These changes facilitate easier registration for companies seeking to protect their unique motion marks in an increasingly digital marketplace.⁴⁰

The upcoming motion mark in the European Union features an iconic red apostrophe on a white background. This motion mark transitions from the slogan "The future is exciting" to "Ready?" and is a key part of BT Group plc's branding strategy. It effectively captures BT's commitment to innovation and connectivity. Registered with the UK Intellectual Property Office, this motion mark takes advantage of recent changes in trademark law that allow for the use of digital formats, including video files, as non-traditional trademarks. In a competitive telecommunications landscape, BT's dynamic branding approach is represented by this motion mark, which conveys a sense of readiness and enthusiasm for the technological advancements and connectivity opportunities that lie ahead. This innovative representation

³⁸ COMMISSION IMPLEMENTING REGULATION (EU) 2018/626 of 5 March 2018

³⁹ REGULATION (EU) 2017/1001 OF THE EUROPEAN PARLIAMENT AND OF THE COUNCIL of 14 June 2017 on the European Union trade mark (codification)

⁴⁰ Toshiba registers first UK 'motion' mark under new IP laws

aligns with modern branding practices and reinforces BT's position as a forward-thinking leader in the industry.⁴¹

3. South Korea acceptance of motion mark

South Korea has integrated motion markers into its trademark registration process, aligning with global trends that embrace non-traditional trademarks. Motion marks, which can be registered with the Korean Intellectual Property Office (KIPO), consist of animated or dynamic elements that represent a brand. In South Korea, applicants are allowed to submit motion marks through various media, including video clips that effectively showcase the movements associated with the trademark. This change reflects a deeper understanding of contemporary branding strategies that highlight the significance of dynamic and visual representations in brand identification. South Korea's adoption of motion marks is part of a broader effort to modernize intellectual property laws and facilitate the registration of a diverse range of trademarks. According to Articles 20 and 21, a trademark application will be considered submitted on July 1, 2007, if it meets any of the following criteria: it must be a trademark distinguished by any colour or combination of colours, a hologram, or motion.

- A. The trademark registration application in the Republic of Korea can be submitted under Article 20(2) on or after July 1, 2007, following the submission of an application for registration in the relevant country under Article 20 prior to that date.
- B. Product trademark applications are submitted under Article 21 (1) on or after July 1, 2007, after the products have been showcased at an exhibition specified in any of the subparagraphs of Article 21 (1) before that date.⁴²

The registration of Sony's animated "Make Believe" logo as a motion mark over a decade ago highlights the increasing awareness of trademark protection in South Korea. This logo, known for its dynamic elements that reflect creativity and innovation, was one of the first non-traditional trademarks approved by the Korean Intellectual Property Office (KIPO) after it began accepting multimedia representations. This landmark registration paved the way for other companies to explore dynamic branding strategies, as KIPO requires that motion marks be distinct and easily recognizable through video or sequential images. By permitting animated trademarks, South Korea demonstrates its commitment to keeping pace with international intellectual property trends while addressing the branding needs of tech-driven multinational corporations like Sony.⁴³

Recommendation

When it comes to a distinct, well-defined graphic element, a device mark is typically easier to protect and enforce under trademark law. A motion mark, on the other hand, requires more complex legal protection since it must demonstrate uniqueness in the movements and be consistently recognised in a variety of contexts where movement is essential to the brand's identity. A motion mark should have a broader and more flexible definition. Registering the logo only as a device mark may make it more difficult for Nokia to safeguard the comprehensive character of their brand identification if motion is a key component of how the public perceives the brand. A wider understanding would enable the protection of sequences of motion or suggested movement, regardless of whether those actions are consistently displayed. So Indian

⁴¹ Guidelines for Examination in the Office, Part B Examination

⁴² TRADEMARK ACT, Statutes of the Republic of Korea, Article 10 (Special Circumstances Regarding Colour, Hologram, or Motion Trademark Priority Claims)

⁴³ Animated "Motion Trademarks" Grow in Popularity and Legal Protection Around the World, by Belinda J. Scrimenti, Pattishall, McAuliffe, Newbury, Hilliard & Geraldson LLP

government should revise the Trade Marks Act to explicitly recognize non-traditional marks, such as motion marks. The definition of “Mark” should be expanded. Graphical representation for registration should be liberalised for unconventional marks. Establish clear standards for representation, including acceptance of video files or image sequences, along with detailed descriptions of the motion. And India should align its trademark laws with international agreements like the TRIPS Agreement and the Singapore Treaty. This alignment would enhance the international protection of motion marks for Indian businesses and strengthen India's role as a key player in the global intellectual property landscape.

Conclusion

The registering motion marks in India presents significant obstacles, primarily due to the strict requirements for graphical representation outlined in the Trade Marks Act of 1999. This requirement creates a unique challenge for non-traditional trademarks, as the dynamic nature of motion marks cannot be effectively captured through static images. A comparative analysis with international frameworks, particularly those of the United States and the European Union, reveals a more flexible approach that accommodates the registration of such marks, which in turn fosters innovation and brand differentiation. Successful registration examples from other jurisdictions demonstrate the potential for motion marks to function as effective identifiers in the marketplace. However, India's current legal framework remains largely restrictive, limiting the opportunities for brands to utilize these non-conventional trademarks. With technological advancements and the increasing prevalence of multimedia branding, Indian trademark law must evolve. To align with global standards and create a more inclusive trademark landscape, India should consider revising its requirements for graphical representation. This could involve adopting a more permissive interpretation that accommodates digital representations and dynamic forms of trademarks. Such reforms would enhance legal protections for brands and encourage creativity and competition within the Indian market. Ultimately, embracing motion marks as a legitimate category of trademarks will require a concerted effort from lawmakers, legal practitioners, and stakeholders in the branding industry. By addressing these challenges directly, India can position itself as a progressive participant in the global trademark arena, ensuring that its laws reflect the realities of modern commerce and technology.

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