

Legal Issues in ‘Unconventional Trademarks’

Issue: Are Motion Trade Marks Protected?

What is a Motion Mark?

- ❖ Falls under the category of unconventional marks.
- ❖ A motion mark can be understood as a mark which consists of a movement or change in the position of the elements of a mark.
- ❖ It can be a short clip combining both moving pictures and sound. It can also be an animation created using a computer program, or some other moving object which exists in the real world. In particular, such a mark may be in the form of a gesture made by a person using various parts of the body, especially the hand.

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- ❖ Eg: Microsoft Windows logo  , Sony Ericsson's logo
- ❖ Only a handful of applications/registrations till date.



Relevant Statutory Provisions

❖ **Section 2(1)(zb) of the Trade Marks Act, 1999 –**

- “...*a mark capable of being represented 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...*”; [Emphasis supplied]

❖ **Section 2(1)(m) the Trade Marks Act, 1999 –**

- ““*mark*” includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination thereof...”

❖ **Rule 2(1)(k), Trade Marks Rules, 2017 -**

- “...*the representation of a trademark for goods or services represented or capable of being represented in paper form and includes representation in digitised form...*”; [Emphasis supplied]

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Issues arising from the Statue

- ❖ Whether the above two provisions are broad enough to include a motion mark?
- ❖ Whether a motion mark can be represented graphically?

Relevant Judicial Decisions

❖ ***M/S. Lakme Ltd. v. M/S. Subhash Trading And Others* [1996 (16) PTC 567 (Del)]**

- “...Section 2 of the Trade and Merchandise Marks Act, 1958 (hereinafter referred to as the Act). The word 'Mark' is defined under sub-clause (i) Section 2 whereas the word 'Trade Mark, is defined under Section 2(v). **The definition of the word 'Mark' as given in the Act is an inclusive definition which includes a device, brand, heading, label, ticket, name, signature word, letter or numeral or any combination thereof.**” [Emphasis supplied]

❖ ***Assam Roofing Ltd. and Ors. v. JSB Cement LLP and Ors.* [AIR 2016 Cal 41]**

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- “...Section 2 (m) "mark" includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination thereof; ...Section 2(m) of the Act gives **an inclusive definition of 'mark'.**” [Emphasis supplied]

Stance of the Trade Marks Registry

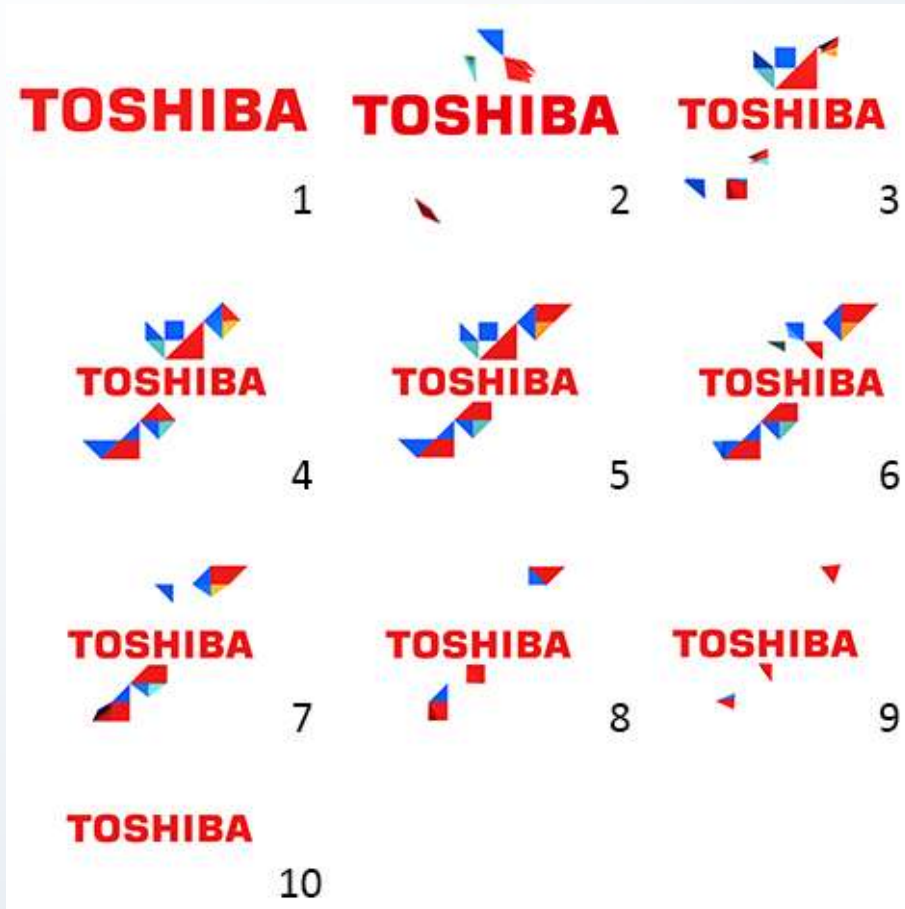
❖ Registration No. 1246341



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Stance of the Trade Marks Registry (Contd.)

- ❖ Registration No. 4093005 -TOSHIBA - MOVEMENT TRADEMARK (MOTION MARK)



Application No: 4093005 in Class/Classes : 7

In the name of M/s: **KABUSHIKI KAISHA TOSHIBA**, also trading as Toshiba Corporation

Gentlemen/Madam,

The above mentioned application has been examined under the provisions under the following sections :

1. Other Objection/Requirement/Conditions/Restrictions.

motion marks are not accepted in India.

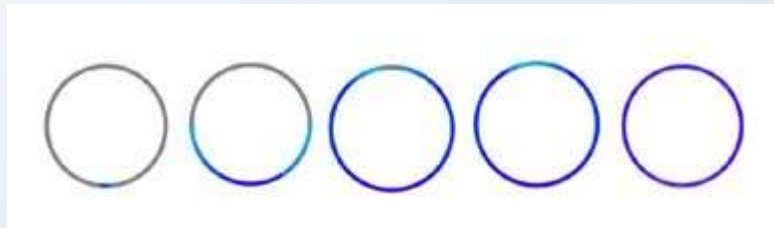
Stance of the Trade Marks Registry (Contd.)

- ❖ Registration No. 4192672 –UPL Ltd.



- ❖ Application No. 3468095 -BLUE RING MOTION MARK (Device)

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Observations from the Currently Registered Motion Marks

- ❖ Initial refusal to recognise motion marks.
- ❖ Current registrations only include the graphical representation (paper form) of the moving elements of the motion mark.
- ❖ These registrations do not cover the moving elements of the motion marks.
- ❖ The constraint is the strict requirement of graphical representation of a mark.

Approach Followed in Other Jurisdictions

❖ **United Kingdom:**

- The mark shall be represented by submitting a **video file** or by a series of sequential still images showing the movement or an **audio-visual file** containing the combination of the image and the sound.
[Emphasis supplied]

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Approach Followed in Other Jurisdictions (Contd.)

❖ United States of America:

- The drawing for a motion mark may depict a single point in the movement, or up to five freeze frames showing various points in the movement, an acceptable specimen should show the entire repetitive motion in order to depict the commercial impression conveyed by the mark (e.g., a **video clip, a series of still photos, or a series of screen shots**). [Emphasis supplied]

❖ European Union Intellectual Property Office:

- Updated their regulation in 2017: The requirement of '*graphical representation*' was replaced by the requirement '*which enables the competent authorities and the public to determine the clear and precise subject matter of the protection of trademark*'.

Conclusion: The Way Forward

- ❖ Need to relax the criterion of graphical representation.
- ❖ Representation of motion marks should be permitted in multimedia formats such as MP4 files so as to remove the dependency of graphical representation alone.
- ❖ This does not require an amendment to the Trade Marks Act, 1999 or the Trade Marks Rules, 2017.
- ❖ A clarification from the TM Registry or inclusion in the Draft Manual should suffice.

THANK YOU!

Questions?

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