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> "U.S. REGISTRATIONS INCLUDE "A MARK UNIQUE IN FORMAT – LIVE MOTION – FOR THE FAMOUS MARCH OF THE DUCKS HELD TWICE DAILY AT THE PEABODY HOTEL IN MEMPHIS."

Animated "Motion Trademarks" Grow in Popularity and Legal Protection Around The World

By Belinda J. Scrimenti *

Digital technology has led to innovative advertising and marketing. Brand owners are increasingly using the technology to create and protect new forms of trademarks, consisting of motion, holograms, and other multimedia features. While U.S. trademark law has protected these types of marks for many years, much of the international trademark community had trailed behind. But that is changing as modernized intellectual property laws now allow trademark holders in much of Europe, Asia, and North America to embrace and protect the motion mark movement.

The U.S. Led the Way In Multimedia Marks

Now one of the oldest motion marks still on the U.S. trademark register, Columbia Pictures registered in 1996 its iconic multimedia logo featuring a woman carrying a torch and wearing a drape, known as "Columbia, a personification of the United States."[1]

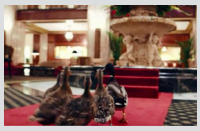
In 2003, the author registered on the U.S. Register a mark unique in format – covering live motion – for the famous March of the Ducks held twice daily at the Peabody Hotel in Memphis.[2] The March has delighted hotel guests and fans for over 80 years. The registration covers actions of the "Duckmaster" rolling out a red carpet, and five trained ducks marching down the carpet, up steps, and into the ornate hotel fountain. The ducks swim all day in the fountain and then march back at night.

Motion mark registrations in the U.S. span many formats. Many consist of animated computer sequences and short videos, ranging from an animated Microsoft Windows® logo,[3] to the United Airlines "Big Metal Bird,®"[4] the opening Lamborghini "wing" door,[5] and the launching Quicken Loans' Rocket Mortgage rocket.[6]

A U.S. applicant must describe the motion mark and provide a drawing that either shows a single point in the movement or "up to five freeze frames showing various points in the movement." The specimen must 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)."[7]

1. U.S. Reg. No. 1,975,999. A video of the mark is viewed at http://bit.ly/2lZJbdm.

2. U.S. Reg. No. 2,710,415. A video of the mark is viewed at http://bit.ly/2krMlpF.



3. U.S. Reg. No. 3,926,321 (now cancelled).

4. U.S. Reg. No. 5,187,557. A video incorporating the animated bird logo is viewed at http://bit.ly/2mlhZFV.

5. U.S. Reg. No. 2,793,439.

6. U.S. Reg. No. 5,040,974. A video of the mark is viewed at http://bit.ly/2lXqqqR.

7. 37 C.F.R. §2.52(b)(3). *See* TMEP §807.11; §904.03(l).

International Modernized Laws Permit Multimedia Mark Registrations

The European Union Intellectual Property Office (EUIPO) updated its regulations in October 2017 to permit easier registration of non-traditional marks, by eliminating the requirement of a mark's "graphical representation." In 2019, most EU countries harmonized their laws with the EUIPO directive. Now, a mark needs only to be represented in a manner "which enables the competent authorities and the public to determine the clear and precise subject matter of the protection."[8] The representation must be "self-contained, easily accessible, intelligible, durable and objective." The motion mark must be represented by either a video file or a series of still sequential images showing the movements or position changes.

Prior to the new regulations, as in the U.S., Microsoft had successfully registered a motion mark for its logo sequence.[9] Exemplary EUIPO registrations under the new directive include a mark, owned by a Danish pump manufacturer, Grundfos Holding A/S, featuring an animated logo,[10] and Google's registered hologram of its iconic "G."[11]

After the U.K.'s January 2019 amendments brought the U.K. in line with the EUIPO,[12] Toshiba registered the first U.K. motion mark, featuring origami-style folding colored triangles.[13] St. Modwen Properties PLC, a real estate developer, also registered a complex animation of its swan logo followed by the motion of drawing of an urban skyline.[14]

Germany implemented the EU directive in January 2019, and the French government published February 2019 amendments to conform with the directive[15] which are expected to come into force soon.

European counsel caution that there is little legal certainty regarding such non-traditional marks. Many are likely to be refused as non-distinctive, and proving acquired distinctiveness is difficult and held to strict standards. Appeals have had limited success. However, a Turkish applicant was partially successful on appeal to the EUIPO Board of Appeal in registering a video of a chef "salting meat" in an unusual (and allegedly distinctive) movement. The Board ruled the mark lacked distinctiveness for food-providing services, but allowed registration for goods and other Class 43 services.[16]

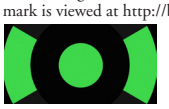
Some Asian jurisdictions have also been forerunners in protecting motion marks. Korea requires proof of acquired distinctiveness, typically through extensive evidence of use in Korea over a long period. Nevertheless, motion marks and holograms were registered there years ago, including Sony's nearly decade-old animated "Make.Believe" logo[17] and a Korean product certification hologram.[18]

Since 2015, Japan has permitted registration of "dynamic design" marks, as long as distinctiveness is proven. Numerous motion marks have since registered, including United's "Big Metal Bird" mark, based on an International Registration under the Madrid System.[19]

Canada and Mexico's recently amended trademark laws now officially allow such registrations. Canada's new law, effective June 17, 2019,[20] specifically authorizes "moving image" marks and an array of other non-traditional marks. Even before implementation, the Canadian Trademark Office granted a very few moving image registrations, including the famed James Bond gun barrel sequence.[21]

8. Article 4 of EUTM Regulation (Regulation No. 2017/1001).
9. EUIPO Reg. No. 008553133.

10. EUIPO Reg. No. 018020711. A video of the mark is viewed at http://bit.ly/2lXqFSN.

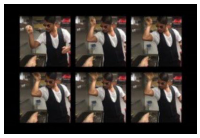


11. EUIPO Reg. No. 017993401; Also registered in the UK, Reg. No. UK00003375918. A video of the mark is viewed at http://bit.ly/2kxtWYM.

12. Section 1(1) of the UK Trade Mark Act 1994 (as amended).
13. UK Reg. No. UK00003375593. A video of the mark is viewed at http://bit.ly/2lYu2cj.

14. UK Reg. No. UK00003395854. A video of the mark is viewed at http://bit.ly/2krN6z1.

15. Article L.711-1 of the French Intellectual Property Code.
16. D Et Ve Et Ürünleri Gida Pazarlama Ticaret Anonim Sirketi, EUIPO Board of Appeal, Case R 2661/2017-5 (June 8, 2018).



17. Korea Reg. No. 45-0033542. In Korea, the registration certificates bear a series of images reflecting the animation.

18. Korea Reg. No. 41-0354050.

19. International Register, Reg. No. 1290466.
20. Section 30(2)(c) and (d) of the Trademarks Act and paragraph 31(e) of the Regulations.
21. Canada Reg. No. TMA980395. *See also* Reg. No. TMA969658 (United "Big Metal Bird" motion mark).

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A Canadian application must include an electronic representation of the trademark in the form of a moving image (animation) clip that shows the full range of the moving image and must include "a clear and concise description of the whole visual effect of the animation from start to end."[22] However, Canadian counsel warn that allowance will require extensive evidentiary proof of acquired distinctiveness in Canada as of the date of filing, probably three to five years of use across Canada, and possibly even survey evidence.

Mexico's new 2018 law deleted the bar against registering "animated or changing shapes." The law now recognizes that a registrable mark requires only that the "sign" (the term for a not-yet registered mark) need only be "perceptible to the senses and susceptible to representation in a manner that clearly and precisely allows the subject matter of protection to be determined."[23] Draft regulations are still pending, and further legislative amendments are possible.

Nevertheless, protection for motion marks is far from universally accepted. Progress is slow in much of Latin America and several Asian countries, where many non-traditional marks are still prohibited. But the most glaring exception to protection is China, where such marks are still expressly barred from registration. Until that changes, workarounds include copyright protection of works analogous to films, and filing for a series of trademarks reflecting static images of steps in a mark's animation.

Overall, the good news is that global trademark laws are making progress in keeping up with the realities and demands of advertising and marketing. Animated motion marks – once somewhat rare – are becoming more important and valuable to brand owners. The current trend shows they are also becoming more protectable under the trademark laws. So brand owners should be bold in adopting and registering these creative new types of trade identifiers. ■

22. *See* June 17, 2019 Practice Notice for Non-Traditional Trademarks.
23. Mexico Industrial Property Law, Articles 88-89.

* Ms. Scrimenti thanks her foreign colleagues for their assistance with updates on their respective jurisdictions: Canada - Marijo Coates, Deeth Williams Wall LLP; China - Spring Chang and Laura Li, Chang Tsi & Partners; France and EU - Pascal Lefort, Duclos, Thorne, Mollet-Viéville & Associés; Germany and EU - Claus Eckhartt and Christine Fluhme, Bardehle Pagenberg; Korea - Young-June (Jay) Yang, Alex Hyon Cho, and Hyun-Joo Hong, Kim & Chang; Mexico - John Murphy, Arochi & Lindner; and United Kingdom - Edmund Harrison, Mewburn Ellis. Other information is sourced from International Trademark Association Non-Traditional Marks Committee summaries and data.

*firm*UPDATE

APPOINTMENTS

Thad Chaloemtiarana

Thad has been appointed to the Trademark Reform Task Force for the ABA Section of Intellectual Property Law, which will review and comment on behalf of the Section on proposed trademark reform legislation in Congress.

Janet Marvel

Janet has been appointed Editor-In-Chief of *Landslide* Magazine, the flagship publication of the ABA Section of Intellectual Property Law.

Robert Sacoff

Bob represented the AIPPI US Group in the international debate and Resolution on "Copyright in Artificially Generated Works" at the AIPPI World Congress in London from September 14-18. Bob also has been re-appointed to the AIPPI Standing Committee on Geographical Indications.

Belinda Scrimenti

Belinda has been elected Co-Chair of the DC Bar Intellectual Property Community (f/k/a "Section") Steering Committee.

PRESENTATIONS

Jessica Ekhoff

Jessica will be teaching the trademark portion of the CBA's Patent, Trademark, and Copyright Basics for New Attorneys seminar on October 15.

Jonathan Jennings

On October 25, Jonathan will speak on right of publicity and privacy issues at the Practicing Law Institute's live and webcast program in New York City entitled "'Technotainment' 2019: Distributing Content Across Multiple Platforms." On November 1, Jonathan will also speak on important trends in trademark law at UIC John Marshall Law School's 62nd Annual Intellectual Property Law Conference in Chicago.

*firm*UPDATE (cont.)

PUBLICATIONS

Seth Appel

Seth co-authored "The Evolving Landscape of Disparaging and Scandalous Trademarks: Historical and Public Relations Perspectives," which was published in the July/August 2019 edition of *Landslide* Magazine.

Jonathan Jennings

In his US Update column in the September 2019 issue of Pharmaceutical Trade Marks Group's publication *Law Lore & Practice*, Jonathan analyzed a recent TTAB decision on the expectations of patients and healthcare professionals in determining the relatedness of goods and services.

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