
LAW RELATED TO MOTION MARK: A COMPARATIVE STUDY OF INDIA AND USA

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ABSTRACT

This article will examine the registrability of non-traditional trademarks, with a particular focus on motion marks. Motion and multimedia marks are classified as non-traditional trademarks. Identifying challenges and opportunities that an owner may have when seeking a registration of motion mark. The researcher has made attempt to define all the essentials requirements which is needed for the registration of motion mark. This article will examine the registration of motion marks, the evolution of relevant case law, and its potential to provide valuable assistance for future applicants. The current definitions of the term 'mark' are excessively restrictive, hindering the protection of motion and multimedia marks. This study seeks to elucidate the challenges associated with the protection of motion marks in India and to compare them with the United States, where the registration of motion marks is not a cumbersome process.

Keywords: Motion Mark, Non-traditional trademark, Registration.

INTRODUCTION

The word “Intellectual Property” refers to intangible creations of the mind such as inventions, designs, symbols, names etc. The Intellectual Property Rights gives the opportunity to the owners who is the intangible creations of mind to commercialize their creations. The intellectual property law protects the intellectual property rights which covers areas such as trademark law, patents, copyright, etc. Intellectual Property Rights (IPRs) refer to the legal rights granted to persons over their creative work, as stated by WIPO. Trademarks are an essential aspect of intellectual property rights (IPR), which falls under the category of industrial property. The emergence of the Trademark can be attributed to the process of industrialization and the widely used manufacturing of goods. Trademark protection is afforded to traditional marks such as logos, symbols, images, captions, signs, and names. However, due to the intense and escalating competition among manufacturers of tangible goods today, it has become vital for them to differentiate themselves in the marketplace. Consequently, brands have embraced innovative and unconventional trademarks for product identification in the marketplace. As we can see in market there is cut throat competition between business tycoons and they are presenting their brand in innovative way so that they can easily recognize in world by their brand name. A trademark is fundamentally utilized to promote a product and to enhance its recognition among consumers. It protects buyers from being confused and enables them to recognize the goods from others of the same kind.

REVIEW OF LITERATURE

This section reviews the existing literature and aims to elucidate the contributions of prior scholars to the specified research domain. It entails the examination of books, reports, and legal publications related to topic;

- **Elizabeth Verkey's** book "Intellectual Property Law and Practice" serves as a valuable resource for comprehending the fundamental principles of Intellectual Property. This book is beneficial for litigating Intellectual Property Rights infringement cases, as it elucidates precedents from many countries worldwide.
- **V K Ahuja's** book “Intellectual Property Rights in India”, Volume I endeavors to examine and interpret all Acts and Regulations pertaining to intellectual property rights comprehensively, supplemented with commentary and case law. A comprehensive synopsis of all International Agreements, Treaties, and Conventions regarding

Intellectual Properties is provided at the conclusion of the book to enhance readers' understanding.

- **Alexandra J. Roberts** article “Of Marks and Minors” discussed and analyze the position of non- conventional marks including motion marks focuses on its uniqueness and challenges in terms of registration.
- **McCarthy, J. Thomas** article “Trademarks and unfair competition” discussed regarding registration of non-conventional marks and their distinctiveness requirement.

RESEARCH OBJECTIVES

- To understand the concept and evolution of trademark and motion marks
- To examine the legal provisions pertaining to motion marks under Indian Trade Marks Act,1999 and Lanham Act,1946.
- To compare the legal provisions of motion marks of India and USA and its challenges.
- To recommend the possible measures to facilitate the protection of motion marks that may be explicitly incorporated in Indian Trade Marks Act.

RESEARCH QUESTIONS

- What is motion mark under Trade Mark law in India and Lanham Act in USA?
- How do India and USA governs their law related to motion marks and what are the principal differences between their legal frameworks?
- How the concept of motion marks developed in India and USA and what elements affect their protection in both the nations?
- What obstacles and challenges are faced in the enforcement of motion marks in both jurisdictions?

RESEARCH METHODOLOGY

The present study is doctrinal in nature. The pertinent materials were gathered from primary and secondary sources. Data and materials were collected from statutes, international treaties, and conventions, as well as legal and judicial precedents, including published works, law journals, national journals, and relevant websites.

WHAT IS TRADE MARK?

A trademark is a unique word, phrase, symbol, and combination of these things that identifies your goods and differentiates it from all others of its kind. The role of trademark is to guide the consumers to recognize a brand and distinguish with others. A 'trademark' refers to a mark that

can be represented graphically. A 'trademark' is capable of differentiating the goods or services of one individual from those of others and can include the shape of goods, their packaging, and combinations of colors, among other elements. A trademark is a unique symbol to goods available for sale in the marketplace, serving to differentiate them from like products. Section 2(1) (zb) a trademark is a mark capable of being represented graphically and capable of distinguishing the goods or services from one person to another. According to section 2(m) of the Trade Marks Act, 1999, a mark encompasses any device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging, or combination of colors, or any amalgamation thereof, which can be graphically represented and is capable of distinguishing the goods or services of one entity from those of others. In the case of *Lakme Ltd v. Subhash Trading and Ors* the court held that the definition of mark is inclusive in nature.

EVOLUTION OF TRADE MARK IN INDIA

The evolution of trademark law can be attributed to the commencement of the Industrial Revolution, which facilitated mass manufacturing and distribution of commodities. As a competitive market economy developed, manufacturers started to identify their items with specific symbols, marks, or devices to differentiate their commodities from comparable offerings produced and sold by others. Furthermore, manufacturers commenced promoting their products by affixing their brands to them. This resulted in the trademark gaining goodwill and repute among purchasers of products. The inaugural multilateral convention at the international level, known as the Paris convention for the Protection of Industrial Property, was established in 1883.¹ If we turn the pages of history we can analyze and see how human mind was creative during 5000 BC in ancient Europe the first indications of ownership are shown by Bison paintings on the walls of the Lascaux Caves in southern France was recognized. In 600 BC, in ancient Egypt Artisans integrated distinctive symbols or designs into their creations to indicate the origin of a certain object and its creator. In 1266 AD the Parliament of England enacted its inaugural statute regarding trademarks. The Bakers Marking Law mandated that each baker affix a distinctive mark on the bread they produced.² The principle that 'no individual possesses the right to represent their goods as those of another' and 'no individual has the right to misrepresent their goods as those of another' was established in the case *Southern v How*³, 1617, wherein a clothier, renowned for marking his own garments, was

¹ V K Ahuja, *Law Relating to Intellectual Property Rights in India* 254, Lexis Nexis Gurgaon, 2nd edition 2013.

² Available at; <https://respectfortrademarks.org> (last visited on Sep 30. 2024)

³ Popham's Reports 143.

exploited by another party to perpetrate deception and generate profit. The Courts recognized these principles and gave the remedy of passing off. This case is considered as a first case of infringement of trade mark. A passing off action necessitates that a trader demonstrates the existence of a deception that misled consumers. The rights for passing off is available till date. The concept of getting recognition and registration of conventional marks is existing from ancient time but the idea of getting registration of non- conventional mark which includes motion mark is a totally new concept which was not existing in ancient times. The Indian legal system has also acknowledged the conventional marks as words, logos, etc. but the growing intricacy of branding strategies in the worldwide market has accentuated the acknowledgement of non -conventional marks including motion mark. India adopted the British Trademark Act of 1938 and formulated their first legislation on the matter as the Trademark Act of 1940. After independence India established the Trade and Merchandise Marks Act in 1958. The Act is presently in effect as The Trade Marks Act, 1999 which commenced on December 30,1999.

EVOLUTION OF TRADE MARK IN USA

The framers of the United States in Constitution did not explicitly empower Congress to enact federal trademark legislation, perhaps due to the absence of precedents and a recognized necessity for such legislation. Prior to 1870, individual US states resolved trademark and unfair competition cases through common law. According to state common law, the individual or entity that can prove the oldest uninterrupted use of a trademark within a specific commercial sector in a particular state is granted exclusive rights to that mark in that state. In 1791, a sailcloth maker from Massachusetts requested the establishment of a federal trademark law. The issue was sent to Secretary of State Thomas Jefferson. Jefferson authored a study advocating for the prudence of such legislation, proposing that manufacturers should be permitted to register their marks with the local U.S. district court for those utilized in interstate commerce and beyond.⁴ Smith or Adams the business person label their products with trademarks that are sufficiently distinctive to eliminate 'source confusion' among consumers. However, they had to achieve this task during a period when identifying existing identical trademarks was unfeasible. California established the first state trademark registry in 1863, prompting other states to adopt similar measures⁵. However, due to the absence of mandatory trademark registration, it was impossible to ascertain if a minor producer in a distant region of

⁴ Available at: <https://www.americanbar.org>. (last visited on Oct 5,2024)

⁵ Carma Gorman, The Role of Trademark Law in the History of US Visual Identity Design,31, Des. Issues.16 (2015).

the state was already utilizing a trademark akin to one's own. Consequently, establishing a new trademark or entering a new state was invariably a significant risk. The origin of U.S. trademark law was enacted by the Trademark Act of 1870 which was subsequently declared unconstitutional. Presently in USA the trademark law is governed by Lanham Act of 1946 which established an extensive federal framework for trademark registration and protection. In 20th centuries certain products got trademark protection such as Coca-Cola (1893), Aunt Jemima (1893), and kodak (1888). In recent past years USA has acknowledged protection for non- conventional trademarks such as sound mark, color mark, motion mark etc. illustrating the expanded range of brand identifiers in contemporary commerce world.

WHAT IS CONVENTIONAL AND NON – CONVENTIONAL MARKS?

Conventional trademarks are defined as unique indications or expressions that distinctly distinguish and differentiate the products or services of one source from those of another. These identifiers can consist of words, phrases, symbols, designs, or a combination of these components. These marks are so identifiable in nature that a person of prudent nature can easily recognize it.

A Non– Conventional trademark also known as non- traditional is a mark which doesn't come under the purview of conventional mark like this mark are not graphically represented and which can be visible or non – visible. Non-traditional trademarks pertain to all five senses. They would encompass;⁶

- (i) visual cues such as color, shapes, moving images, holograms, etc., or
- (ii) non-visible signs such as scent, sound, taste, or texture.

Trademark protection is granted solely to marks that can be graphically depicted. However, a non-conventional trademark can be registered and protected if they can establish a distinct level of recognition among consumers. To get registration of non – conventional marks the procedure is rigid.⁷

WHAT IS MOTION MARKS?

The Trade Marks Act,1999 exclusively does not define motion mark. A motion mark is a non-conventional mark which refers a mark characterized by the movement or alteration in the position of its elements. It may be a brief segment that integrates both visual image and audio.

⁶ Lisa P. louse, “Non- Traditional Trademarks: A Critique” 55 J. Intell. Prop. (2020).

⁷ *ibid.*

In US law also there is no explicit definition of motion mark. Section 2(c) of the Lanham Act forbids the registration of any mark that "consists of or comprises a name, portrait, or signature identifying a specific living individual, unless accompanied by their written consent." These marks encompass holograms, gestures, and movement, which can integrate colors, sounds, and elements of product design because of multimedia technology. This category of trademark registration involves the utilization of a series of images or illustrations to represent the trade. A holographic mark denotes a visual sequence utilized to identify the commercial origin of goods or services. Hologram has been utilized for decades as a security measure against imitation. Some motion marks which are registered in India and USA are: Nokia's Connecting Hands this was the first mark which was filed for registration but it gets registration as device mark, UPL Ltd.'s logo, Amazon Technologies Inc, Toshiba Corporation this are the motion marks which is registered in India. In USA also there are certain number of motion marks which are registered that are PEABODY hotels "duck mark," Apple SIRI personal assistants lighting effects, Yahoo's Yodel, Lamborghini wing door etc.

LEGAL FRAMEWORK FOR MOTION MARKS IN INDIA

Trademarks are of paramount importance in the contemporary corporate environment as protectors of brand identity and consumer confidence. Trademarks function as unique identifiers for products and services, allowing consumers to make informed purchasing choices and cultivate brand loyalty. Trademarks are essential to brand protection, consumer trust, and market competition, significantly influencing the evolving commercial scene. A trademark encompasses any device, brand heading, label, ticket, name, signature, word, letter, numerical, shape of goods, packaging, or any combination of colors, as defined in Section 2(1) (zb) of the Trade Marks Act, 1999⁸. Prior to 2017, registration of motion mark was unfeasible according to Rule 2(1)(K)⁹ of the Trade Marks Rules, 2017 a trademark may be graphically represented by a series of images, sequential frames of the moving mark and accompanying explanations. Trademark for the purposes of a registration system, the definition must address two objectives:¹⁰

- i. accurately capturing the features of a trademark while ensuring that these attributes are sufficiently definite or

⁸ Section 2(1) (zb) of The Trade Marks Act, 1999.

⁹ Section 2(1) (K) of the Trade Mark Rules 2017.

¹⁰ www.pfdcoffe.com. (last visited on Sep.11, 2024).

- ii. definitive for presentation in a register.

The concept of motion marks is not explicitly defined in the Act so the process for registration of non- conventional marks is rigid in India as compared to USA. Indian courts and registrar have shown a tendency to recognize and protect motion marks as a subset of visual marks. The Indian Trade Marks Act of 1999 delineates the various grounds for the relative grounds for refusal of trademark registration largely under Section 11.¹¹ This section outlines the specific reasons for which the Registrar of Trademarks may deny trademark registration. Section 11 explicitly forbids the registration of a trademark that is identical or similar to a pre-existing trademark for identical or comparable products or services, provided that such resemblance is likely to induce public confusion or deception. “Section 9¹² of the Act establishes the absolute grounds for refusal of registration” of trademarks under the Act. This prohibit the registration of trademark on certain specified grounds like kind, quality, quantity, intended purpose and GI if any mark is having all these essentials, then the mark will not be registered.

Pre – Requisite Condition for Registration of Motion Marks in India:

The applicant must fulfill certain conditions in accordance with the registration of motion marks in India;

- Distinctiveness

The mark must differentiate the goods or services of one entity from those of other. A motion mark just like any other mark exhibit distinctiveness. The mark must have visual sequence that must be distinctive and recognizable. In *Re James' Trademark*, it was determined that for a mark to be unique, it must be of a kind that, in instances of infringement, it is evident that infringement has occurred and that the mark is distinguishable from all other marks within the same category of goods¹³. In the matter of *Cadbury Brothers Ltd.'s Application*, it was determined that 'distinctive' signifies that upon seeing the name, one's mind instantly associates it with the individual or entity responsible for the sale or production of the product, exclusively identifying that individual, corporation, or organization¹⁴. The distinctiveness can be of two types inherent and acquired distinctiveness.

¹¹ Section 11 of the Trade Marks Act, 1999.

¹² Section 9 of the Trade Marks Act, 1999.

¹³ *Re James Trade Mak*, (1977) R.P.C. 168(U.K.)

¹⁴ *Cadbury Brothers Ltd Application*, (1915) 32 R.P.C 202 (U.K.)

- Graphical Representation

As stated under section 2(1) (zb) of the Act the mark must be graphically represented. The Indian Act does not explicitly prohibit registration; however, it faces challenges in accommodating motion trademarks because to the absence of set rules for their graphical representation. This condition presents the greatest barrier in registering a motion mark to illustrating the movement of its elements and accompanying sound on paper can be challenging. Currently, a motion mark can only be depicted through a sequence of static images. The Indian Office must commence the acceptance of video clips of such marks to enhance comprehension of their nature.

- Functionality

The functionality of a trademark is a fundamental need. A motion trademark must be functional, meaning it should affect sales or generate profit for the brand through its use; however, the applicant is prohibited from monopolizing general elements that are common and important to all traders in the business. Consequently, an applicant must provide direct or indirect evidence to obtain registration for a motion trademark.

Some of the motion marks that are registered in India are:

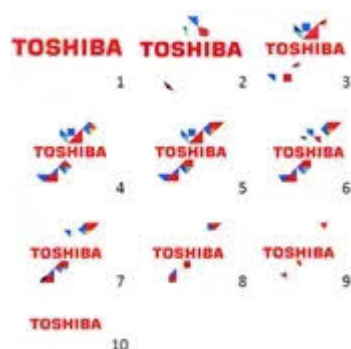
The very first motion mark that was registered in India was “Nokia’s Connecting Hand’s mark” the application was for the registration of motion mark but it was registered as device mark. The challenge before trade mark registry was that the it was not capable to prove the moving elements of the mark, that is the reason the “Connecting Hand” was registered as device mark in India. The mark could not represent in paper form describing each element of the mark. The registration of motion marks can be done in different forms such as computer-generated animation this is used for advertising purpose. Other form involves movement in products and last form is hand movements generally known as motion mark.



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¹⁵ Nokia Connecting Hand Registration, reg. no.1349307. 2003(India).

TOSHIBA,¹⁶ following its successful registration as the first motion trademark in the UK, applied for registration in India in 2019. The registry first objected to the registration of the trademark, citing that motion trademarks are not permissible in India. Till now there is no approval of application status of registration as motion mark.



LEGAL FRAMEWORK FOR REGISTRATION OF MOTION MARK IN USA

In USA trade mark law is govern by Lanham Act ,1946 which is a principal federal statute relating to trademarks. The basic criteria for registration of motion mark in United States is that the applicant mark must be unique and able to identify with other products. Section 2¹⁷ of the Lanham Act provides a negative definition of a trademark and delineates the prerequisites for its registration. This legal law stipulates that a trademark must meet criteria such as non-functionality, distinctiveness, or acquired distinctiveness to assist consumers in distinguishing a particular product from others. The U.S. courts and USPTO had recognized the protection of motion mark like other conventional mark if the mark has acquired distinctiveness through use in commerce.

Pre – Requisite Condition for registration of motion marks in United States are;

- Uniqueness

The mark must be unique and it should differentiate with others marks if marks lack distinctiveness, then the applicant must prove that mark has acquired distinctiveness by substantial commercial usage. It is one of the most important criteria to fulfill to get registration as motion mark.

- Non - Functional Aspect

¹⁶ Toshiba Movement Trademark Motion Mark, application no. 4093005.2019 (India).

¹⁷ Section 2 of the Lanham Act, 1946.

The motion mark must not perform a functional purpose a graphical depiction of the mark must be provided to function as its "drawing." mark may provide either a single point in the movement or up to five freeze frames depicting different stages of the movement. Section 2(e)(5) of the Lanham Act forbids the registration of a mark that is entirely functioning.

- Identify Source

The mark must be an audiovisual file that displays the complete motion mark as utilised in commerce. The file must be in MP3 or WAV format for audio and JPEG or PDF format for images. The file must not surpass 5 MB in size or 5 minutes in duration. It must articulate the motion mark in explicit and succinct terms, including its length, sequence, direction, velocity, and auditory characteristics.

The above conditions are mandatory to get motion mark registration in USA the US Patent and Trademark Office (USPTO) will consider the entire motion sequence and how is represented.

In the case of *Qualitex Co. v. Jacobson*¹⁸ the US supreme court in this case draw the conclusion that non- traditional mark can be registered for example motion mark if they had distinctiveness in the mark and non-functionality requirements. In *Louboutin v. Yves Saint Laurent America Holding, Inc.*, the court emphasised the practical approach to restricting the functional aspect of a product under trademark law, asserting that it should be governed by patent law.

*Lamborghini Door*¹⁹ Opening Motion Case in this registration was approved due to the motion distinctiveness in Lamborghini design and its attainment of secondary significance. The case attributes that such as automobile doors can qualify as a protectable motion mark if it possess adequate distinctiveness.



¹⁸ *Qualitex Co. v. Jacobson Products Co*, 514 U.S. 159 (1995).

¹⁹ *Lamborghini's door* Reg. No. 5145164 (2017).

The U.S. in 1996 got its first motion mark registered of Columbia Pictures of women carrying a torch.²⁰ Since that time USA is accepting registration of motion marks.



MGM's Roaring Lion²¹ Case the Metro-Goldwyn-Mayer registered its renowned roaring lion trademark in 1928. The mark got registered by demonstrating that the moving image of the lion's roar had attained uniqueness and was linked to the company brand. This case was one of the initial cases of motion mark establishing a precedent for how corporations may safeguard moving visuals within their trademarks.



Google's Animated Search Doodles Case they had get registration of "Google Doodles" as motion marks. Google effectively registered several of its animated logos explaining that mutable visuals can attain trademark protection if they are adequately unique.



²⁰ Columbia Pictures Industries, Inc., Reg. No 1916779 (1996)

²¹ Roaring Lion Motion Mark, Reg No. 1309057

CHALLENGES AND COMPARATIVE ANALYSIS OF MOTION MARK

Motion marks being a non- traditional mark faces issue at the time of registration as compare to static visual symbols like logos or word mark. There are certain challenges which are faced to get registration of motion mark that are; issue of representing of motion mark graphically. A motion mark must be represented through a series of sequence images showing the movement for which applicant is applying for registration. In this mark the major issue is the determination of similarity between the marks. In case of raising objections to the infringement it is difficult to establish the similarity between the motions.

There are no statutory legal provisions given in the Trade Marks Act, 1999 and Lanham Act 1970, of USA which directs for the registration of motion mark. It seems like the concept of motion mark is naïve for India the act directly did not strict but there is no provision which specifically grant for registration. USA is liberal towards registration of motion mark so one of oldest motion mark was registration in USA Columbia picture.

The subsequent challenge is to ensure the accurate depiction of the motion mark. The trademark registry during registration process necessitates for fixed representation of the mark.

One of the significant issues to get registration of motion mark is distinctiveness. A mark must possess distinctiveness to qualify for registration the applicants must establish that customers connect the movement with their brand.

Generally, in consumers are more familiar with conventional marks, with respect to motion marks the identification and interrelation of motion mark with items require more time.

In USA if United States Patent and Trademark Office (USPTO) is satisfied that a motion mark is distinctiveness and it is non- function then registration can be done. Subsequently in India the trademark registry asks from applicants to submit a series of photos that depicting the motion.

In compare to USA, in India there are a smaller number of motion marks that are registered from this researcher has analyse India follows rigid system for registration of non- conventional mark.

FUTURE APPROACH TOWARDS REGISTRATION OF MOTION MARKS

In the era of digitalisation where all the things are interlinked with technology and the motion marks continues to grow with moving images especially in fields of entertainment, business

and advertising it is necessary to courts to grant trademarks to motion mark. As a researcher as discussed above countries like the USA where motion marks are registered and has set precedent. The Indian Trade Marks Act focuses on conventional marks that are easy to understand and represent. But this is very high time for the nation in global trade that country should grants registration to motion mark. India could approach for clear guidelines in registration of motion marks; it could be video submissions or detailed graphical sequences that represent the mark in a standard way.

In future the more countries potentially could recognize motion marks as an essential part of brand identity in a digital age.

CONCLUSION

India does not bar registration of motion mark only the procedure for registration is rigid and cumbersome. The acknowledgment of a motion mark is creating new opportunities for company. Although corporations have historically engaged with clients through animations, such animations can now be safeguarded under Indian Trademark law as motion marks. Motion marks as trademarks are seldom registered, as their significance has just recently emerged with technology advancements in this field. The USA is more progressive in accepting registration of non-traditional trademarks like motion marks, in parallel India is developing its stance on motion marks. In comparative analysis between both the jurisdictions in context of motion marks USA has structured approach towards motion marks and other side India is on the path to refining its legal approach towards registration of non-traditional marks.

SUGGESTIONS

- There is need of explicit rules for the registration of motion marks to guarantee uniformity.
- There is need of more awareness in respect of non-conventional marks especially in India where a large public segment is not aware about motion marks, consumers are more familiar to conventional marks.
- The application procedure for registration of motion marks is rigid there is need for enhanced analysis and documentation procedure for assessing visual and auditory elements.