

Motion in trademark law: motion marks

Motion as a trademark

Although the Office for Harmonization in the Internal Market (hereinafter referred to as OHIM) refused applications for the registration of motion marks in the past, Nederlandsch Octrooibureau recently noted that motion marks are increasingly being accepted for registration. A known example of a motion mark that was successfully registered is the animation illustrated above, which belongs to Microsoft. In order to be granted trademark rights, one of the requirements laid down in the European trademark laws is that it must be possible for the mark in question to be represented graphically. The rationale underlying this requirement is that it must be possible to register a trademark and therefore the sign must be capable of being represented graphically.

Graphic representation

In case law, the concept of graphic representation is explained in greater depth. According to the case law, the graphic representation of a trademark can take the form of figures, lines or characters. The graphic representation must be clear, precise, self-contained, easily accessible, intelligible, durable and objective. Scents, for example, still do not fulfil the requirement for

graphic representation. Even though it is possible for a scent to be represented in the form of a chemical formula, only very few people will be able to understand the scent from the formula. Until recently, trademark applications relating to motion marks also did not fulfil the requirement for graphic representation. Now that applicants are representing and describing the motion more clearly, dozens of motion marks have since been accepted for registration. Nevertheless, OHIM recently refused an application relating to a motion mark again.

Refusal of motion mark

OHIM was of the opinion that the application for registration submitted by Sony Ericsson in relation to its motion mark was not sufficiently clear. In the view of the OHIM, the 20 images that were submitted and the associated description did not depict a clear and unequivocal sequence. It was not actually possible to understand the motion involved and the images did not depict everything that was described. Sony Ericsson subsequently added a clearer description to its application, however the application was refused for a second time. During an appeal against the refusal, the judgment relating to the refusal was set aside. The OHIM's Board of Appeal ruled that

in arriving at their opinion, the examiners had not been consistent. The Board of Appeal found that the motion mark did in fact fulfil the requirement in terms of graphic representation. The mark was ultimately registered on 18 March 2011.

Practical tips when registering a motion mark

On the basis of the appeal proceedings, we have been able to determine that it must be possible for the content of a mark to be understood without a great deal of intellectual energy and imagination. The mark must also comply with the requirements in terms of graphic representation. For the purpose of its appeal, Sony Ericsson submitted a “flipbook” consisting of 20 images, in order to convey the motion involved. Flicking through the pages enables the reader to view the images in rapid succession and the motion then becomes clear. When filing an application for registration of a motion mark, it is therefore advisable to also submit a flipbook. The description must also clearly describe the contents of each image and the sequence in which they appear.

Conclusion

The acceptance of a European motion mark is opening up new doors for business. Even though companies have been communicating with their customers using animations for a long time now, animations can now be protected under European trademark law in the form of a motion mark.



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