

Motion Marks: The new moving trade marks and guidance for non-traditional trade mark applicants in UK

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The UK Intellectual Property Office (UK IPO) has recently granted the first multimedia moving trade mark following a change in the requirements for non-traditional trade mark applications under the [2015 Trade Marks Directive](#). The mark was granted to Toshiba and consists of a one second clip of the Toshiba logo surrounded by Origami-style folding coloured triangles, [click here to see](#).

The granting of the mark follows the elimination of the requirement for trade marks to be represented graphically. Instead, intellectual property owners can now use multimedia files to apply for moving trade marks, hologram marks and sound marks, which will enable viewers of the trade mark register to experience the marks exactly as the creator of the mark intended. In the digital age, companies are increasingly looking for innovative and creative ways to promote their brand and these changes will enable them to more easily protect multimedia representations of that brand.

As the 2015 Trade Marks Directive does not contain detailed definitions of the new trade mark types, or lay down specific representation requirements, the European Union Intellectual Property Office (EUIPO), European Commission and the national intellectual property offices have developed a common communication providing guidance to applicants for non-traditional marks. It is hoped that this will assist in the transposition of the 2015 Trade Marks Directive in the most harmonised manner possible, with the intention of improving legal certainty, predictability and accessibility for users.

In summary, the agreed definitions and planned acceptable file formats are set out in the table below:

Type of Trade Mark	Definition	Means of representation	Planned acceptable electronic file formats
Sound	A trade mark consisting exclusively of a sound or combination of sounds.	The mark shall be represented by submitting an audio file reproducing the sound or by an accurate representation of the sound in musical notation.	<ul style="list-style-type: none"> • JPEG • MP3
Motion	A trade mark consisting of, or extending to, a movement or a change in the position of the elements of the mark.	The mark shall be represented by submitting a video file or by a series of sequential still images showing the movement or change of position. Where still images are used, they may be numbered or accompanied by a description explaining the sequence.	<ul style="list-style-type: none"> • JPEG • MP4
Multimedia	A trade mark consisting of, or extending to, the combination of image and sound.	The mark shall be represented by submitting an audio-visual file containing the combination of the image and the sound.	<ul style="list-style-type: none"> • MP4
Hologram	A trade mark consisting of elements with holographic characteristics	The mark shall be represented by submitting a video file or a graphic or photographic representation containing the views which are necessary to sufficiently identify the holographic effect in its entirety.	<ul style="list-style-type: none"> • JPEG • MP4

It is worth noting that motion, multimedia and hologram trade marks are not specifically mentioned in the current legislation of the UK IPO but it will be possible to file them under “Other” trade marks. The common communication states that “Other” marks shall be represented *“in any appropriate form using generally available technology, as long as it can be reproduced on the register in a clear, precise, self-contained, easily accessible, intelligible, durable and objective manner so as to enable the competent*

authorities and the public to determine with clarity and precision the subject-matter of the protection afforded to its proprietor. The representation may be accompanied by a description.”

It will be interesting to see how many brand owners will now look to register non-traditional marks in light of the Toshiba registration. The changes brought in by the 2015 Trade Marks Directive have expanded the categories of non-traditional marks that can be registered, however, issues still remain in relation to other non-traditional marks, such as smell marks.

Whilst the Court of Justice of the European Union has found that an olfactory mark is capable of registration in principle, the practical considerations make it difficult for the mark to be represented in an acceptable format. The EUIPO has stated that the filing of a sample or a specimen does not constitute a proper representation of a trade mark. The reason being that these cannot be clearly and precisely represented and are not generally available for inspection on the intellectual property register by means of commonly available technology. Further, a sample of a scent would not be a durable and stable representation of a trade mark, thereby not complying with the clarity and precision requirements for trade mark applications. For this reason the UK IPO does not currently accept applications for smell or olfactory marks. It will be interesting to see whether changes in technology will make the registration of smell marks and other non-traditional marks possible in the future.

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