WORTHY OF THE NAME®

Motion Marks

by Wayne Covell

Trade marks that move or have motion have been around for a long time. Since 1924 MGM Studios have a motion mark at the start of their feature films showing the image of a roaring lion.[1] It has been parodied many times including a Monty Python version with the lion replaced by a croaking frog. From 1927 Universal Pictures used a biplane flying around the globe with a trail of smoke forming the words Universal Pictures. Like Dr Who, the logo has evolved, but the 100th anniversary of the studio version this year still shows the words *Universal* in a trail around the globe. The 20th Century Fox Searchlights logo with a musical fanfare dates back to 1935.[2] The modern version is easily traced to the original.

Apart from the US, trade mark registration statutes have lagged behind. While rights in moving images have been protected by copyright and passing off, it is only recently that moving or animated images have been registered as trade marks in Australia, Canada and Europe. In Australia this came about with the federal *Trade Marks Act* 1995 and the broad definition of a trade mark in s 17 as a "*sign used, or intended to be used, to distinguish goods or services dealt with or provided in the course of trade by a person from goods or services so dealt with or provided by any other person*." The definition of "*sign*" in s 6 is also expansive although it doesn't explicitly mention motion marks.[3]

Yet there's no doubt that in the public mind distinctive moving images, such as the studio front credits for MGM, Universal and Twentieth Century Fox, have always been viewed as brands and trade marks. To call them non-traditional trade marks is a misnomer. Long before the 1995 Act the High Court considered in 1961 whether an animated, humanized oil drop in two television commercials for Shell petrol infringed a similar, but static oil drop that had been registered as a trade mark by Esso[4] (numbered 135548 and 135549) as shown below:

In the days when the High Court of Australia exercised the original hearing jurisdiction in trade mark matters,[5] Windeyer J decided at first instance that Shell's television commercial did infringe Esso's static marks. But this was reversed by a majority on appeal (Dixon CJ, Kitto, Taylor and Owen JJ) who emphasised that humanized oil drops were not a unique device[6] and that Shell were not using it as a trade mark but, rather, to show *"that the chemical composition of Shell petrol gives it advantages over its rivals*."[7] Kitto J described Shell's television commercials and the alleged infringement as follows:

> *The films were projected on to a screen during the hearing ... In each film a "humanized" oil drop is made to personify the appellant's "Shell" petrol, and to perform a series of exuberant antics designed, in conjunction with some letterpress and the spoken word, to create in the minds of viewers a feeling of pleasure at recognizing desirable attributes in Shell petrol. In the course of his merry pranks, the Shell Eulenspiegel constantly changes in shape and expression. He always has a head the shape of an oil drop drawn to a peak at the top, and generally the head is supported, without a neck, by a body bifurcated to indicate short legs with feet turned outwards. Arms and hands take up varying positions, and what passes for a face expresses varying emotions. On some occasions the figure, in the course of its mutations, approaches fairly closely in appearance to the respondent's trade marks; but the name "Esso" is never seen, and the changes of appearance follow one another so swiftly that the viewer can hardly gain more than a general impression of a Protean creature who could be, having regard to some of his manifestations at least, the man whom the respondent has registered as its trade mark, but could equally be another member of the same tribe. It may be assumed for present purposes, however, that in the course of each film the figure takes on, at least for a moment or two now and then, an appearance substantially identical with that of the trade marks.*[8]

That momentary similarity in the television commercials was not enough to find that there had been an infringement. Taylor J held:

> *I do not doubt that the rights of the proprietor of a trade mark may be infringed by television displays of this character but when the question is whether the device which is used is deceptively similar to a registered mark it cannot be resolved without considering the effect which the display in its entirety would be calculated to produce*.[9]

Although an animated sequence or motion mark was capable of infringing a static mark, when the animated sequence in the Shell commercials was viewed in their entirety "*no viewer would ever pick out any of the individual scenes in which the man resembles [Esso's] trade marks*."[10] Kitto J emphasised that the "*context*" was "*all-important*."[11]

Fast forward to 2012 and it's still the case that in considering whether a registered mark has been infringed — including a motion mark — the marks must be compared in their entirety.

Who's got the jump?

A legal battle currently being played out in Australia is the fight between the Qantas/Jetstar star jump and Toyota's *Oh what a feeling* jump. Since the 1980's the Toyota Motor Corporation Australia Limited has portrayed happy purchasers jumping for joy after buying a Toyota. The Jetstar jump is more recent as it coincided with the creation of Jetstar as a budget airline by Qantas in 2004.

Neither company applied to register their motion marks until this year. In February 2012 Toyota applied for a motion mark (1472463) that shows "*a boy leaping into the air from a standing start extending his arms and legs out to his sides at the same time while in mid air and forming a star shape*." The image below was attached to the application as a still of a scene from the video clip:

The motion mark was accepted by IP Australia in June 2012 in class 12 in relation to "*Motor vehicles, parts and accessories for motor vehicles*." In July 2012 Toyota filed eleven more motion marks containing similar still scenes as shown below:


1500004


1500006


1500008


1500010


15000012


1500013


1500014


1500015


1500016


1500017


1500018

All eleven applications were accepted by IP Australia in September 2012. In that same month Qantas applied for two motion marks containing still scenes as shown below:


1514513


1517025

While Toyota applied only in one class, 12, Qantas have applied for a broad range of goods and services in classes 9, 18, 36, 38, 39 and 43. The Qantas applications are yet to be examined by IP Australia. Interestingly, neither side has applied for advertising, marketing, publicity and retail services in class 35.

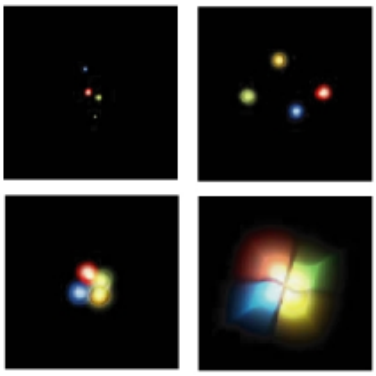
In October 2012 Qantas opposed Toyota's first motion mark application 1472463. No doubt it is considering whether to oppose all or at least some of Toyota's further 11 motion mark applications above.

There are very few motion marks on the Australian trade marks register. So it will be very interesting to see how this dispute is decided or whether both sides settle through a coexistence agreement. The problem that Qantas faces is that not only does Toyota have established user rights in its *Oh what a feeling* jump, the goods and services are different: Toyota's mark is used for cars while the Qantas mark is used for airline services.

Another issue that will bring the High Court's decision in the *Shell Oil Drop* case back into focus is that despite the similarity of the still images above, that is not the issue. As Taylor J held in that case, the issue "*cannot be resolved without considering the effect which the display in its entirety would be calculated to produce*."[12] While Toyota and Qantas filed video clips with their applications[13] unfortunately these are not available for viewing through ATMOSS. But a great deal could turn on comparing the motion marks in their entirety and considering the '*all-important context.*'

Motion mark applications

Motion mark registrations are rare. At the time of writing there are only 10 registrations and 16 pending Australian applications. But the importance of protecting a motion mark is not to be underestimated. Television and film have long been the dominant visual mediums but their convergence with the internet and mobile phone technology has seen an explosion in the use of motion marks. So, in 2009 the Microsoft Corporation filed in various countries[14] for the animated start-up sequence for their software, as shown in the following images:



Part 21.9 of the Australian *Trade Mark Examination Manual* provides some guidelines on applying for motion marks. Generally, in addition to the usual application details the applicant must provide:

- clear representations which show all the features of the trade mark;
- a description of the trade mark which clearly describes all the features of the trade mark; and
- a copy of the actual trade mark such as a video clip.

The first two requirements are similar to those in the US and Europe. A common, if not universal, requirement in trade mark law is that the mark must be capable of being "represented graphically".[15] In the US the applicant may satisfy this requirement by either submitting "*a drawing that depicts a single point in the movement*", or "a square drawing that contains up to five freeze frames showing various points in the movement whichever best depicts the commercial impression of the mark."[16] But, in Australia it need not be a drawing provided it is "*clear representations which show all the features of the trade mark*"; and there is no restriction on the number of freeze frames. In Europe

Sony Ericsson submitted a “flipbook” of up to 20 images which allowed the examiner to flick through the pages and see the motion. While this was initially rejected it was accepted on appeal.[17]

Both the US and Australia require written descriptions of the marks. In Australia, the applicant should avoid language in the description such as ‘as exemplified in’ or ‘an example of which’. The description of the trade mark, provided it is accepted, will then be entered on the register as an endorsement. IP Australia provide the following example as a suitable description and endorsement:

> *The trade mark is a movement mark. It consists of a yellow balloon with a face drawn on it which floats from the bottom left corner of the screen to the top right corner, while the facial expression changes over the course of the traverse from frowning to smiling. The trade mark appears in the video clip attached to the application.*

These endorsements and descriptions are helpful, but have obvious limitations. The whole point of a motion mark is to capture and view motion. Australia and the US allow for the trade mark application to include a specimen of the mark in motion (for example, a video clip), yet surprisingly these are not the actual marks entered on the register. When searching for a motion mark on the register it would really help if you could actually view the specimen of the mark in motion or have a link to it. The High Court in 1961 in the *Shell Oil Drop* case was able to view the two television commercials as intended, that is, in motion on a screen. In the digital age this would be a straightforward proposition. It would make searching easier and increase the value of the registration. Unfortunately, the Australian, US and European online registers lack streaming or downloadable specimens of pending and registered motion marks.

Conclusion

There is no doubt that trade mark applications for motion marks are increasing in Australia, Europe and the US. For many years Canada did not allow for motion mark applications but this was reversed in 2010.

The benefits of a motion mark in the digital age are significant. The limitations of a static trade mark were highlighted in Australia more than fifty years ago in the *Shell Oil Drop* case. A static trade mark only protects a single image whereas a motion mark has the ability to protect several images as well as motion itself. This invariably broadens the ambit of protection and dramatically increases the value of the trade mark.

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1 http://en.wikipedia.org/wiki/Leo_the_Lion_(MGM).
2 http://www.closinglogos.com/page/20th+Century+Fox+Film+Corporation.
3 Section 6 provides ‘***"sign** " includes the following or any combination of the following, namely, any letter, word, name, signature, numeral, device, brand, heading, label, ticket, aspect of packaging, shape, colour, sound or scent*.’
4 *Shell Company of Australia Ltd* v *Esso Standard Oil (Australia) Ltd* (1963) 109 CLR 407; http://www.austlii.edu.au/au/cases/cth/HCA/1963/66.html.
5 Prior to the federal *Trade Marks Amendment Act* 1976.

[6] (1963) 109 CLR 407 at 421 per Kitto J; and at 411 per Windeyer J deciding in favour of the plaintiff at first instance but reversed by a majority on appeal.
[7] (1963) 109 CLR 407 at 426 per Kitto J.
[8] (1963) 109 CLR 407 at 422 per Kitto J.
[9] (1963) 109 CLR 407 at 427.
[10] (1963) 109 CLR 407 at 425 per Kitto J.
[11] (1963) 109 CLR 407 at 423 per Kitto J.
[12] (1963) 109 CLR 407 at 427.
[13] See *Trade Mark Examination Manual,* Part 21.9.
[14] See, for example, US registration 3926321, European CTM registration 8553133 and Australian registration 1321792.
[15] See, for example, s 40 of the Australian *Trade Marks Act* 1995 (Cth) which provides that "*An application for the registration of a trade mark must be rejected if the trade mark cannot be represented graphically."*
[16] http://www.uspto.gov/trademarks/teas/teas_faq.jsp#TEASmotion.
[17] Y Noorlander, *Motion in Trademark Law*, European IP Update 2011.