

ROCK, PAPER, SCISSORS, TRADEMARK? A COMPARATIVE ANALYSIS OF MOTION AS A FEATURE OF TRADEMARKS IN THE UNITED STATES AND EUROPE

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INTRODUCTION

Imagine the following series of events taking place at the red carpet premiere of a highly-anticipated summer blockbuster. A bright red Lamborghini pulls up to the venue just minutes before the movie starts, and as the doors of the car move up vertically, the male action star steps out to greet raucous fans and flashing cameras. As the TV crews move in and the paparazzi swarm, the movie star waves, and then pursuant to a lucrative endorsement deal, he taps the right side of his nose with an extended pointer finger. Then, inside the theater, the lights dim and drums sound, followed by a booming series of horns, while “20th Century Fox” moves into view with its spotlights waving back and forth. Finally, in the last scene of the movie, after thwarting his attacker and possibly saving the world, the star jumps onto a Yamaha speed boat and rides into the sunset with water spraying from the back of the jet.

In this scenario, from the moment of the actor’s appearance on the red carpet through the last scene of the film, a person attending the movie premiere is exposed to four different “moving” trademarks: the rising Lamborghini doors,¹ the Derbyshire Building Society’s tapping of the nose gesture,² the 20th Century Fox animated sequence,³ and the jet stream of water from a Yamaha

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¹ Automobili Lamborghini Holding S.p.A., United States Patent and Trademark Office (“U.S.P.T.O.”) Registration Number (“Reg. No.”) 2793439 (“The mark consists of the unique motion in which the door of a vehicle is opened. The doors move parallel to the body of the vehicle but are gradually raised above the vehicle to a parallel position.”).

² Derbyshire Building Society, U.K. Reg. No. 2012603 (“The mark is a gesture made by a person by tapping one side of his/her nose with an extended finger, normally the index finger of the hand on the side of the nose being tapped.”).

³ Twentieth Century Fox Film Corp., U.S.P.T.O. Reg. No. 1928423 (“The trademark is a computer generated sequence showing the central element from several angles as though a camera is moving around the structure. The drawing represents four ‘stills’ from the sequence.”).

boat.⁴ Moving trademarks, or “motion marks,”⁵ are one variety of nontraditional identifiers⁶ recognized in the United States and Europe as being capable of distinguishing the source of goods and services. Traditionally, trademarks are embodied in letters, numerals, words, logos, pictures, symbols, or a combination of these elements.⁷ However, recent interpretation of the broad statutory language of the Lanham Act,⁸ European Community Harmonization Directive,⁹ and TRIPs Agreement,¹⁰ leaves open the possibil-

⁴ Yamaha Motor Corp., Ltd., U.S.P.T.O. Reg. No. 1946170 (“The mark is comprised of a three dimensional spray of water issuing from the rear of a jet propelled watercraft and is generated during the operation of the watercraft.”).

⁵ The term “motion mark” will be used throughout the article to describe several types of moving trademarks detailed *infra* Part I.A.

⁶ Other nontraditional trademarks include color, sound, scent, taste, tactile, and hologram. For a detailed analysis of nontraditional marks in the United States, see Jerome Gilson & Anne Gilson LaLonde, *Cinnamon Buns, Marching Ducks and Cherry-Scented Racecar Exhaust: Protecting Nontraditional Trademarks*, TRADEMARK PROTECTION AND PRACTICE (Matthew Bender ed., Supp. 2005). See also THOMAS P. ARDEN, PROTECTION OF NONTRADITIONAL MARKS: TRADEMARK RIGHTS IN SOUNDS, SCENTS, COLORS, MOTIONS AND PRODUCT DESIGNS IN THE U.S. (2000).

⁷ “Most people think of a trademark or service mark as a static, two-dimensional word, design or logo used to identify a product or service.” Daniel I. Schloss, *A New Reality: Special Problems in the Registration of Nontraditional Trademarks*, 5:4 INTEL. PROP. STRATEGIST 1 (Jan. 1999).

⁸ See 15 U.S.C. § 1127 (2005).

The term “trademark” includes any word, name, symbol, or device, or any combination thereof - (1) used by a person, or (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this Act, to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.

Id.

⁹ See Council Directive 89/104, art. 2, 1989 O.J. (L 40) 1 [hereinafter Directive] (Article 2 of the Directive includes “Form” (“capable of being represented graphically” so it can be recorded and published) and “Content” (“distinguishing the goods or services of one undertaking from those of other” requirements); see also Nguyen Nhu Quynh, *Special Trade Marks – Legislation and the Situation in the European Community* (2002) (unpublished master thesis, Lund University), available at <http://www.copat.de/markenformen/eugh-kom/quynh.pdf>.

¹⁰ See Agreement on Trade Related Aspects of Intellectual Property Rights, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, Legal Instruments – Results of the Uruguay Round vol. 31, 33 I.L.M. 81 (1994) [hereinafter TRIPs Agreement]. Article 15(1) of TRIPs states, “[a]ny sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark.” Both the United States and the European Community are signatories of TRIPs. See Quynh, *supra* note 9, at 13 (“So far, TRIPs is the sole international agreement providing a definition of trade mark in its art 15(1).”).

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ity that almost anything can function as a trademark, as long as consumers associate the symbol with its source.¹¹

Trademark law seeks to preserve the consumer's association between product and producer. As "the symbolic representation of brands,"¹² trademarks possess enormous economic power in their ability to provide customers with a clear visual or conceptual image that identifies the source of specific goods and services.¹³ Companies spend billions of dollars on advertising and branding strategies in order to attract public interest and keep their goods distinct from those of competitors in the minds of consumers.¹⁴

¹¹ *Qualitex Co. v. Jacobson Product Co., Inc.*, 514 U.S. 159 (1995), is the landmark Supreme Court case that opened the doors for consideration of nontraditional marks in the United States:

Both the language of the Act and the basic underlying principles of trademark law would seem to include color within the universe of things that can qualify as a trademark. The language of the Lanham Act describes that universe in the broadest of terms Since human beings might use as a "symbol" or "device" almost anything at all that is capable of carrying meaning, this language read literally, is not restrictive.

Id. at 162. See also Robert E. Hanlon & Eileen Visco, *Registration of Nontraditional Marks Different Issues Arise in the United States than in Other Jurisdictions*, METROPOLITAN CORP. COUNS. 8 (June 2002).

¹² Randall Frost, *Trademarking: Senses & Sensibility*, www.brandchannel.com/features_effect.asp?pf_id=207 (last visited Oct. 9, 2005).

¹³ *Id.* Tracing the history of branding in America, "[a]fter World War II . . . [t]rademark designers sought to create distinctive and memorable symbols that provided positive images of companies and their products. Trademarks promoted an identifiable individuality and quality with an image that was easy for the consumer to identify and recall." *Id.*

¹⁴ See *Scandia Down Corp. v. Euroquilt, Inc.*, 772 F.2d 1423 (7th Cir. 1985). Judge Easterbrook notes:

Confusingly similar marks make consumers' task in searching for products harder. The similar mark also dilutes the hostage value of the first, because the firm that created the mark may lose business on account of the inferior products of its rival, while the rival may not lose as much business as its own quality dictates because customers mistakenly blame the first firm for the failings of the second. As marks become less useful for identification, search, and hostage purposes, firms invest less in them and consumers suffer.

Id. at 1430. See also LEE WILSON, *THE TRADEMARK GUIDE: A FRIENDLY HANDBOOK TO PROTECTING AND PROFITING FROM TRADEMARKS* (2004).

When marketers today speak of branding, they are talking about marketing efforts aimed at creating a relationship between their products and their customers When such a relation can be established, it is a very powerful connection And in a world where almost all products are sold by brand – by trademark – and practically nothing is sold *without* a brand name, brands and the personalities they exemplify are the keys to survival of a product in the marketplace.

Id. at 4.

Every year, the United States Patent and Trademark Office (“USPTO”) receives thousands of trademark applications¹⁵ from businesses seeking to establish their brands in the marketplace. Given this fierce competition for consumer interest, companies are constantly looking for innovative ways to make their products stand out through different sensory techniques.¹⁶

By employing the use of nontraditional trademarks in advertising and marketing, brands have the opportunity to connect with consumers on multiple, unique levels.¹⁷ Nontraditional marks attract attention by appealing to all five senses, and “the effects of powerfully sensual encounters with brands on consumers is not to be dismissed lightly.”¹⁸ Although registration of unconventional identifiers is often more difficult, as evidenced by examiner opposition in the past,¹⁹ currently the USPTO and the Office for Harmonisation in the Internal Market (“OHIM”)²⁰ both recognize

¹⁵ In 2005, the USPTO received 323,501 applications for trademark registration, including additional classes. In the same year, 143,396 trademarks including additional classes were registered. See UNITED STATES PATENT AND TRADEMARK OFFICE, TABLE 15: SUMMARY OF TRADEMARK EXAMINING ACTIVITIES 2005, PERFORMANCE AND ACCOUNTABILITY REPORTS, available at http://www.uspto.gov/web/offices/com/annual/2005/060415_table15.html.

¹⁶ See Schloss, *supra* note 7, at 1. (“[I]n this age of innovative new marketing techniques and electronic commerce, traditional word marks and two-dimensional logos may no longer be enough to capture the attention of media-savvy consumers.”).

¹⁷ “Brand owners are always looking for new and exciting ways to make their products more distinctive than those of their competitors. Shapes, sounds, colors, and now even smells are becoming increasingly popular ways to promote goods and services.” Seiko Hidaka et. al., *A Sign of the Times? A Review of Key Trade Mark Decisions in the European Court of Justice and their Impact Upon National Trade Mark Jurisprudence in the EU*, 94 TRADEMARK REP. 1105, 1120 (2004). See Gilson & LaLonde, *supra* note 6, at 64-65 (“Nontraditional marks can stir the imagination, and many (like marching ducks, duck calls and scented exhaust fumes) are just plain funny Such marks can be or can become strong, memorable and long-lasting.”).

¹⁸ Frost, *supra* note 12.

¹⁹ See *In re Clarke*, 17 U.S.P.Q.2d 1238 (T.T.A.B. 1990). On October 19, 1988, Celia Clarke applied to register a scent mark, “a high impact, fresh, floral fragrance reminiscent of plumeria blossoms” as applied to sewing thread and embroidery yarn (U.S.P.T.O. Reg. No. 1639128). Although registration of the mark was initially rejected, TTAB found that the owner had provided enough evidence to support a showing of acquired distinctiveness: “In her advertisements and at craft fairs, applicant has promoted her products as having a scented nature. We believe that applicant has presented a prima facie case of distinctiveness of her fragrance mark.” *Id.* at 1240. See *infra* Part II.B, discussing the grounds for denying registration of the Lamborghini moving doors in the European Community.

²⁰ OHIM is the equivalent of the USPTO in the European Community and presides over registration of Community Trade Marks (CTM). See 4 J. THOMAS MCCARTHY, TRADEMARKS AND UNFAIR COMPETITION § 29:35 (4th ed. 2005).

color and sound marks,²¹ and the USPTO has also registered scent marks.²² These marks identify some of the most well-known products and services available to the common consumer, including, for instance, the NBC “chimes,” the color pink for fiberglass, America Online’s “You’ve Got Mail” message, and the color brown for the United Parcel Service (“UPS”).²³

In comparison to their nontraditional brethren, “motion marks” are a relatively obscure form of unconventional trademark, and have yet to appear as the subject of any Trademark Trial and Appeal Board (“TTAB”)²⁴ proceeding in the United States, whereas color, sound, scent, and taste marks have all been addressed individually by the USPTO or appellate courts.²⁵ Nevertheless, there are approximately twenty motion marks currently registered in the United States.²⁶ Based on the lack of available

²¹ See, e.g., National Broadcasting Company (“NBC”) “Chimes,” U.S.P.T.O. Reg. No. 0916522; Qualitex yellow and gold pads, Qualitex Co. v. Jacobson Product Co., Inc., 514 U.S. 159 (1995); Tiffany, Inc. “eggshell blue,” U.S.P.T.O. Reg. No. 2359351; CTM Application No. 000031336 for single lilac/purple color; CTM Application No. 001040955 for the “signature tune of the Nokia called Prelui.”

²² See U.S.P.T.O. Reg. No. 2463044 (for “cherry scent” as applied to synthetic lubricants for high performance racing and recreational vehicles). Registration of scent marks in the European Community has been rejected on the grounds that such marks cannot be visibly represented. See Case C-273/00, Ralf Sieckmann v. Deutsches Patent- und Markenamt, 2003 E.T.M.R. 37 (2002).

²³ See NBC “Chimes,” *supra* note 21; Owens-Corning Fiberglass, U.S.P.T.O. Reg. No. 25182851; America Online, U.S.P.T.O. Reg. No. 2821863; United Parcel Service, U.S.P.T.O. Reg. No. 2901090. What is particularly interesting about the UPS color mark is the recent advertising campaign which focuses on the color by promoting the slogan, “What Can BROWN Do for You?” (U.S.P.T.O. Reg. No. 2649286). See Gilson & LaLonde, *supra* note 6, at 6. This type of advertising is especially important for the registration of color marks, since a showing of secondary meaning is required, and advertising touting the color mark may be used as evidence for establishing acquired distinctiveness. See also ARDEN, *supra* note 6, at 81-85.

²⁴ TTAB has jurisdiction over appeals filed by applicants following a denial of registration of their marks by a USPTO examining attorney. See 15 U.S.C. § 1070 (2005).

²⁵ See *Qualitex*, *supra* note 21 (addressing color); *Kawasaki Motors Corp. v. H-D Michigan Inc.*, 43 U.S.P.Q.2d 1521 (T.T.A.B. 1997) (action involving the registration of the Harley Davidson engine’s sound, which was denied); *In re Clarke*, 17 U.S.P.Q.2d 1238 (T.T.A.B. 1990) (initial denial of registration for scent reversed); *N.V. Organon Corp.*, U.S.P.T.O. Application Serial No. 76467774 (final registration denied on April 11, 2005 for orange flavored “[p]harmaceuticals for human use, namely, antidepressants in quick-dissolving tablets and pills.”) The applicant appealed this final denial, but the TTAB affirmed the examining attorney’s decision not to register. See *In re N.V. Organon*, 79 U.S.P.Q.2d 1639 (T.T.A.B. 2006).

²⁶ As of March 13, 2006. There is also one registered motion mark on the supplemental register (see *American Association of Neurological Surgeons*, U.S.P.T.O. Reg. No. 2315036), and approximately ten applications for motion marks currently under review.

case law, it remains unclear whether the USPTO has ever denied an applicant's registration for a motion mark. Although the International Trademark Association ("INTA") does not include motion marks on its list of "main types" of nontraditional marks,²⁷ the OHIM has approved several motion marks for community registration,²⁸ and individual member states such as the United Kingdom, Germany, and the Benelux Office have registered them extensively.²⁹

Motion marks offer companies a particularly powerful branding tool because they are exclusively visual. In this respect, they

Figures based on a search the author conducted in the U.S.P.T.O. TESS database looking for the following terms in the description of the mark, using "[DE]" after the following key terms in a free form search: "motion mark," "movement mark," "animated sequence," "computer generated sequence," "motion is a feature," "motion as a feature," "freeze frames," "frames," and "motion sequence." A search for "motion" [DE] returns 381 results, and while some of these are motion marks, primarily, the results reflect symbols or graphics that merely give the appearance of motion. Suggestions for improving the cataloging of motion marks will be discussed *infra* Part III.A.

²⁷ See *Nontraditional Trademarks*, http://www.inta.org/index.php?option=com_content&task=view&id=178&Itemid=132&getcontent=1 (last visited Oct. 22, 2006). INTA's list of "main types of nontraditional trademarks" includes: appearance, shape, sounds, scents, taste, and touch. *Id.* Internationally, INTA is an extremely influential organization which not only publishes a number of periodicals including the TRADEMARK REPORTER, but is also involved in drafting legislation relating to trademarks and unfair competition throughout the world. Its website states, "after 125 years, INTA continues its mission to represent the trademark community, shape public policy and advance professional knowledge and development." See Inta.org, About INTA, http://www.inta.org/index.php?option=com_content&task=view&id=14&Itemid=37&getcontent=4 (last visited Oct. 22, 2006).

²⁸ Community registration "has a uniform effect throughout the European Community and automatic legal force without the need for separate national legislation." See MCCARTHY, *supra* note 20. See also Vattenfall AB CTM Reg. No. 1772615 ("The mark is a moving trademark consisting of the letter L with a light beam moving from right to left."); Berggren OY CTM Reg. No. 1864610 ("The mark comprises six still pictures representing a moving image."); Nokia CTM Reg. No. 3429909 ("The mark comprises an animation which consists of four images depicting hands coming together, shown in succession from left to right and from top to bottom.").

²⁹ See *supra* note 2 (The United Kingdom treats motion marks very favorably, and even recognizes gesture marks with secondary meaning, such as the Derbyshire Building Society's gesture mark. The "Special Circumstances" note accompanying the Derbyshire Building Society gesture mark registration on the UK Patent Office website states, "proceeding because of distinctiveness acquired through use."); Henkel KGaA Registration No. 30157686 (Germany has several registered motion marks); Mars B.V. Reg. No. 520574 (The Benelux Office, which administers the unified trademark law of Belgium, the Netherlands and Luxembourg, also recognizes several motion marks including the Mars registered gesture mark for "Kit Kat" bars.); Dr. Ralf Sieckmann, *Annex to Non-traditional Trade Marks – Motion Marks*, <http://www.copat.de/markenformen/bewegungsmarken2006.pdf> (last visited Oct. 22, 2006) (contains a collective representation of motion marks registered around the world).

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are closer to traditional marks that combine words and symbols, and therefore consumers may recognize them more readily.³⁰ Similarly, the kinetic or animation component makes motion marks uniquely suited for multimedia advertising in film, television, and on the internet³¹ by reaching consumers in a potent visual capacity when their attention is directed at a single screen.³² Being able to

³⁰ See Gilson & LaLonde, *supra* note 6, at 5 (“Motion, sound and product packaging marks will probably fare best of the nontraditionals. They are most like the traditional trademarks with which courts and consumers are familiar.”). Companies that have several registered design marks can also add movement to these symbols and register them as motion marks. In this respect, motion marks add another level of distinctiveness to a brand that already has a recognized presence in the minds of consumers. The 20th Century Fox moving spotlight sequence, *supra* note 3, is a good example, because the company also has a registered design mark with just the name 20th Century Fox and spotlights drawn overhead, which is comparable to one view or “still” from the moving image mark. See U.S.P.T.O. Reg. No. 2547183.

³¹ While some motion marks include actual physical movement of the product, as in the cases of the Lamborghini doors, *supra* note 1, and Yamaha boat, *supra* note 4, most of the well-known motion marks currently registered or under review belong to production studios, internet providers or websites. See, e.g., 20th Century Fox, *supra* note 3; Columbia Tristar, U.S.P.T.O. Reg. No. 1975999; Microsoft Corporation “E,” U.S.P.T.O. Serial No. 78318565; RKO Pictures, U.S.P.T.O. Reg. No. 2690376; and Hanna-Barbera Studios, U.S.P.T.O. Reg. No. 1339596.

³² “Branding of City Space” is an increasingly popular form of marketing, particularly in urban settings where TV screens can be found in subways, elevators, store windows, and even large intersections, such as Times Square in New York City. NAOMI KLEIN, *NO LOGO: TAKING AIM AT THE BRAND BULLIES* 12, 34 (Picador 1999). There are currently eighty LED (light-emitting diode) screens placed throughout subway entrances in New York, which deliver “8 million plus impressions daily.” Kathy Prentice, *Your Client’s Message, Artfully Done: Manhattan Street Fare: Sponsoring Digital Signage*, MEDIA LIFE, Oct. 30, 2005, <http://www.medialifemagazine.com/cgi-bin/artman/exec/view.cgi?archive=121&num=976>. The State of New York’s Metropolitan Transportation Authority (MTA) recently announced plans to put digital signage in the new New York City subway model R160. See Patrick Arden, *Subway of the Future*, METRO N.Y., Nov. 29, 2005, at 2, available at http://ny.metro.us/metro/local/article/Subway_of_the_future/195.html#email.

With respect to the internet, the Ninth Circuit noted the power of attracting consumer attention online in *Brookfield Commc’ns, Inc. v. West Coast Entm’t Corp.*, 174 F.3d 1036 (1999) and *GOTO.com, Inc. v. Walt Disney Co.*, 202 F.3d 1199 (2000), cases involving similar use of trademarks and domain names, where the court found in favor of Plaintiff in both situations. “Both companies, apparently recognizing the rapidly growing importance of Web commerce, are maneuvering to attract customers via the Web,” *Brookfield Commc’ns*, 174 F.3d at 1057. See also LISA E. CRISTAL & NEAL S. GREENFIELD, *TRADE-MARK LAW & THE INTERNET: ISSUES, CASE LAW, AND PRACTICE TIPS* (2001).

Logos are especially important on the Internet. The Internet is the ultimate visual medium, and enticing eyeballs to stay at a web site is critical to the site owner’s success. Additionally, the average Internet user is thought to have a short attention span . . . popular marketing wisdom states that these users will wait no more than eight seconds for a web page to capture their interest before going elsewhere. To keep the user from fleeing, some web site owners first display an eye catching visual symbol while the rest of the web page loads. This

use motion marks in these varying technological capacities contributes to brand survival, as “some trademarks are positioned so that they can even move across rather wide technology gaps, and these are the ones that seem to live on and on Trademark versatility is linked to its longevity.”³³ Motion marks, in the form of gesture marks and even a possible extension into physical movements, also have the potential to push the boundaries of trademark law.³⁴ In terms of registration, motion marks have the unique benefit of being capable of graphic representation, bypassing the problem with scent, taste, and at times, sound marks.³⁵ In addition, some motion marks might be considered inherently distinctive,³⁶ whereas the USPTO has expressly stated that other nontraditional marks, such as color, require a showing of secondary meaning to be registered.³⁷

Despite these advantages to the use of motion marks in advertising and branding, they are still underutilized as far as nontraditional marks go, and they face barriers in registration. The lack of available case law addressing motion marks and the consequential absence of judicial precedent means that the scope of protection afforded to these marks is undefined, as compared to the protections afforded to other unconventional identifiers. As a result,

symbol is most often a familiar and attractive logo, usually associated with a company or product that most appeals to the web site's likely customers.

Id. at 155.

³³ GORDON V. SMITH, *TRADEMARK VALUATION* 118-119 (1997).

³⁴ See Robert M. Kundstadt et al., *Are Sports Moves Next in IP Law?*, NAT'L L.J., May 20, 1996 at C1. See generally WILLIAM M. BORCHARD, *TRADEMARKS & THE ARTS: HOW PERFORMERS, VISUAL ARTISTS AND OTHER CREATORS CAN BENEFIT FROM THE TRADEMARK LAW* (1999).

³⁵ For a comprehensive review of the challenges related to registration of nontraditional marks such as color, sound and scent, see Melissa E. Roth, Note, *Something Old, Something New, Something Borrowed, Something Blue: A New Tradition in Nontraditional Trademark Registrations*, 27 *CARDOZO L. REV.* 457 (2005).

³⁶ See ARDEN, *supra* note 6, at 56. The fact that some motion marks are inherently distinctive not only facilitates registration, but also underlies the importance of protecting such marks. As Frank Schechter concluded in his legendary article, “the preservation of the uniqueness of a trademark should constitute the only rational basis for its protection” Frank I. Schechter, *Rational Basis for Trademark Protection*, 40 *HARV. L. REV.* 813, 831 (1926-1927). Gesture marks cannot be inherently distinctive and definitely require a showing of secondary meaning. See *supra* note 29 (describing the “Special Circumstances” note accompanying the Derbyshire Building Society gesture mark registration).

³⁷ See U.S.P.T.O. Trademark Manual of Examining Procedure (“TMEP”) § 1202.05(a) (4th ed. 2005) (“Color marks are never inherently distinctive.”); Gilson & LaLonde, *supra* note 6, at 3 (explaining that other nontraditional marks that are not inherently distinctive, such as scent, flavor, and select sound marks).

owners of motion marks are at a disadvantage in terms of protecting their intellectual property rights, since there is no basis for determining what constitutes infringement of motion or moving images.

This note will provide a framework for understanding and comparing different types of motion marks through a comprehensive review of existing marks and registration practices in the United States and Europe. Part I will describe several uses of motion as a feature of trademarks, review current methods of registration, and explore how gestures and physical movements can be used to identify the source of goods and services. Part II will discuss the limited case law addressing registration of motion marks and the underlying implications for determining the scope of protection. Part III will offer simple solutions for improving registration and cataloguing of motion marks, so that owners and practitioners will be able to search for registered marks and applications more efficiently. Finally, Part III will attempt to outline the scope of protection afforded to motion marks and theorize how courts might approach an infringement action.

I. USE AND REGISTRATION OF MOTION MARKS IN THE UNITED STATES AND EUROPE

Today, it is fair to say that virtually any device or symbol that makes, or could make, a commercial impact upon a relevant body of consumers, may be registrable as a mark and/or provide the basis for obtaining injunctive relief from the courts.³⁸

A. *Types of Motion Marks*

“Motion marks” fall under the broad category of “nontraditional” trademarks,³⁹ and the term references any trademark or service mark that claims motion or movement as a feature of its use in commerce.⁴⁰ “Motion mark”⁴¹ may be used to describe an

³⁸ Russell H. Falconer, *Big Future for Nontraditional Marks*, NAT'L L.J., May 18, 1998, at C28.

³⁹ See *supra* note 6.

⁴⁰ The movement aspect of motion marks draws attention in such a way that they have been described as a “cross between sensory marks and design marks.” Erik W. Kahn & George Stephanopoulos, *Starting to Register: Moving-Image Marks*, NAT'L L.J., May 20, 1996, at C25.

⁴¹ Internationally, several other terms are used to describe motion marks. In Canada, they are called “kinetic” or “animation” marks. See Bob H. Sotiriadis & Laurent Carriere, *The Statutory Protection of Non-Traditional Trade-Marks in Canada: A Few Reflections on*

additional subcategory of unconventional marks, as there are several different types of trademarks that claim motion as a feature.⁴²

The first general category of motion marks involves short sequences of computer-generated animation, distinguishable as “moving image” marks.⁴³ These are the most prevalent forms of motion marks and are often utilized by film, television and internet companies to designate their goods and services.⁴⁴ Often, moving image marks add animation to previously registered trademarks comprised of either words or symbols.⁴⁵ Some moving image marks also incorporate music or other sounds to accompany the animated sequence,⁴⁶ or a specific combination of colors.⁴⁷ This type of motion mark is easily marketed to the public through use on electronic billboards, in television commercials, movie theatre previews, and online advertising.

The second type of motion mark involves moving aspects of the product itself, or a defined motion produced by the goods. In the United States, the best examples of this type of motion mark are the upwardly-moving Lamborghini doors⁴⁸ and the three-di-

their Registrability and Distinctiveness, <http://www.robic.com/publications/Pdf/235E-BHS.pdf> (last visited Oct. 22, 2006). In the European Community, they are called “movement marks.” See, e.g., Case 772/2001-1, Automobili Lamborghini Holding S.p.A.’s Application, 43 E.T.M.R. 542, 545 (2005).

⁴² Hologram marks are another form of nontraditional identifier that incorporates aspects of motion, and there are a variety of hologram marks registered in both the United States and the European Community. However, this note will confine its analysis to the types of motion marks discussed *infra* Part I.A.

⁴³ See Nokia CTM Reg. No. 3429909, *supra* note 28.

⁴⁴ See Twentieth Century Fox, *supra* note 3; RKO Pictures, *supra* note 31; Microsoft Corporation U.S.P.T.O. Serial No. 78318565.

⁴⁵ Twentieth Century Fox also has a registered mark that combines one “still” from its motion mark and the company name. U.S.P.T.O. Registration No. 0336090. It also has a graphic mark featuring one “still” with the spotlights crossed over “20th Century.” U.S.P.T.O. Reg. No. 1256722.

⁴⁶ It is possible that the sound incorporated in some moving image trademarks would be eligible for independent registration as a sound mark. For instance, Twentieth Century Fox has a separate registration for the musical sequence of its blaring horns and drums that accompany the registered motion mark. See Twentieth Century Fox, U.S.P.T.O. Reg. No. 2000732, <http://www.uspto.gov/go/kids/soundex/74629287.mp3> (last visited Oct. 22, 2006).

⁴⁷ See Bayer Consumer Care AG CTM Reg. No. 2421667 (“The mark designates a movement respectively a series of moving pictures. A set of three pictures (from the left to the right) regarding a wave/sweep is shown, whereas the colour within the wave/sweep is changing from red into green in direction from the bottom (left corner) to the top (right corner) with a frequency of 1 second. Green (pantone 347), yellow (pantone 102), red (pantone 485).”).

⁴⁸ See Automobili Lamborghini Holding S.p.A., *supra* note 1.

mensional spray of water produced by the Yamaha speed boat.⁴⁹ A more unusual example is the Peabody Hotel Chain's service mark, which is comprised of its daily "Duck March."⁵⁰ A rare example of a service mark incorporating physical movement,⁵¹ the Duck March is a procession which occurs daily at the Peabody hotels, involving live ducks which emerge from an elevator and proceed down a red carpet before jumping into a fountain located in the hotel's lobby.⁵² Generally, motion marks incorporating product features will be subject to scrutiny and possible opposition on grounds of functionality.⁵³ Nevertheless, these marks are incredibly unique, and represent the endless creative possibilities that motion marks afford to manufacturers and service providers.

The third form of motion mark is a gesture mark, which involves particular hand movements or a combination of physical

⁴⁹ See Yamaha Motor Corp., Ltd., *supra* note 4.

⁵⁰ See Peabody Management, Inc., U.S.P.T.O. Reg. No. 2710415:

The mark consists of the live visual and motion elements of The Peabody Duck March as performed at The Peabody Hotels, only one segment of which is depicted in line art in the drawing. The motion elements include the red carpet being rolled out, the appearance of the ducks and uniformed Duckmaster at the elevator door, and the march of the ducks down the red carpet, up the steps, and into the fountain where they begin swimming. The mark also includes the fanfare in reverse sequence.

Id.

⁵¹ Although gesture marks, discussed *infra* Part I.A., can be considered physical movements, the Peabody Duck March represents one of the only motion marks to actually incorporate a somewhat choreographed sequence. The registration of this sequence has important implications for any future registration of physical movement. Although this service mark uses animals, it would be hard to distinguish it from a similar procession performed by employees if that demonstration was distinctive enough to act as an indication of source for services.

⁵² The Peabody Hotel Group also tried to register the "Legend of the Ducks," but the application was officially denied in a hearing on June 30, 2005. The decision is not citable as precedent of the TTAB. See U.S.P.T.O. Application, Serial No. 76068295, 2005 T.T.A.B. LEXIS 268. The Ducks march daily at 11:00 a.m. and 5:00 p.m. See *The Legend of the Ducks*, http://www.peabodymemphis.com/peabody_hotels/the_peabody_ducks.cfm (last visited Oct. 22, 2006).

⁵³ See *infra* Part II.B (discussing grounds for denying Automobili Lamborghini's registration in the European Community). Under American trademark doctrine, these motion marks may be able to overcome a functionality challenge because they are probably not "essential to the use and purpose" of the device. See *Traffic Devices Inc. v. Marketing Displays, Inc.* 532 U.S. 23, 35 (2001). However, the same marks might be challenged under the doctrine of "aesthetic functionality," because they may put other manufacturers of similar products at a "non-reputational competitive disadvantage." See *Abercrombie & Fitch Stores, Inc. v. American Eagle Outfitters, Inc.*, 280 F.3d 619, 641-43 (6th Cir. 2002). See generally *Brunswick Corp. v. British Seagull*, 35 F.3d 1527 (Fed. Cir. 1994); *Wallace Int'l Silversmiths, Inc. v. Godinger Silver Art Co.*, 916 F.2d 76 (2d Cir. 1990).

movements that indicate the source of goods or services. Although there are currently no registered gesture marks in the United States,⁵⁴ a recent complaint filed in California federal court seeks injunctive relief for “misappropriation of a hand signal.”⁵⁵ Internationally, gesture marks are recognized in the United Kingdom and the Benelux Office,⁵⁶ and the OHIM just recently approved registration of Deutsche Telekom’s “T” gesture.⁵⁷ Gesture marks are primarily used in relation to service marks and require a showing of secondary meaning.⁵⁸ Some gesture marks are also depicted in

⁵⁴ Deutsche Telekom, however, filed an application to register its “T gesture,” *see infra* note 57, in the United States on August 8, 2002. Deutsche Telekom, U.S.P.T.O. Serial No. 76473999 (“The mark consists of a person whose hands are in motion coming together to form the letter ‘T.’”).

⁵⁵ Former professional wrestler Page Falkinburg, also known as. “Diamond Dallas,” filed a complaint against Rapper Jay-Z for copyright and trademark infringement arising out Jay-Z’s commercial use of the “Diamond Cutter” hand signal during concert performances and on album covers. *See* Diamond Dallas Page v. Shawn Carter, No. 2:05-CV-8475 (C.D. Cal., filed Dec. 2, 2005). Although the mark itself is not registered, Falkinburg claims the sign has acquired secondary meaning:

At every wrestling event, Plaintiff’s flash of the Diamond Cutter hand sign would work the crowd into a frenzy as fans would cheer and flash the Diamond Cutter Trademark back to Plaintiff. In fact, athletes and celebrities in the entertainment industry also recognized the Diamond Cutter hand sign as Diamond Dallas Page’s trademark and would flash the Diamond Cutter Trademark to Plaintiff.

Complaint at 3, *Id.* *See also* *Diamond Dallas Sues Jay-Z over “Diamond Cutter” Hand Sign*, MTV NEWS, Dec. 6, 2005, http://www.mtv.com/news/articles/1517546/20051206/jay_z.jhtml?headlines=true (last visited Oct. 22, 2006); Diamond Dallas Homepage, <http://www.diamonddallaspage.com> (depiction of gesture itself as well as t-shirts with the gesture on them); Roc-A-Fella Records Homepage, <http://www.rocafella.com> (numerous photos depicting Jay-Z making the gesture); JAY-Z, THE DYNASTY ROC LA FAMILIA, *album cover* (Roc-A-Fella Records 2000) (Jay-Z making the gesture); JAY-Z, KINGDOM COME, *album cover* (Roc-A-Fella Records 2006) (Jay-Z making the gesture).

⁵⁶ *See* Derbyshire Building Society, *supra* note 2; Mars B.V. Benelux Reg. No. 520574.

⁵⁷ *See* Deutsche Telekom AG CTM Reg. No. 002818334.

Two hands form a “T,” in which, from the position of the viewer, the right hand, stretched out flat with fingertips pointing upwards (so that only the narrow edge of the hand is visible) moves from the upper left of the image to the centre, while the left hand, also stretched out flat with fingertips pointing upwards and viewed from the side, moves from the upper right of the image to the centre; both hands then meet in the centre of the image with the upwards-pointing fingertips of the right hand touching the surface of the left hand roughly in the centre; the viewer therefore sees a side view of the descending left hand coming to rest on the fingertips of the ascending right hand; as a result of this movement, the viewer is able at this point to recognise the letter “T.”

Id.

⁵⁸ Because gestures and other physical movements are commonly associated with famous performers, these marks are inherently tied to rights of publicity and celebrity, evidenced by the complaint filed by “Diamond Dallas.” *See supra* note 55. *See* Sam Coates

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moving images, such as the Nokia mark comprised of two hands coming together.⁵⁹ Although not technically claimed as “gestures,” it is possible that these marks could bridge the gap between physical and graphic representation, since there is essentially no difference between the computer sequence of moving image marks and corporal performance of gesture marks.⁶⁰ Additionally, gestures have powerful marketing ability as the most basic form of human communication.⁶¹ There is perhaps no better indication that a consumer population has been reached by advertising than consumers’ mimicking of the trademark owner’s gesture.⁶²

and Sam Lister, *Why You Can’t Take Jonny’s Cradle to the Rave*, *TIMES* (London), Nov. 25, 2003, at Home News 3, available at WLNR 5132003 (After the UK won the Rugby world cup in 2003, professional rugby player Jonny Wilkinson announced his intention to register “The Cradle.”); see also Christina Michalos, *Sports Stars Can Make a Smart Move to Stamp Their Mark*, *TIMES* (London), Dec. 2, 2003, at Law 3, available at WLNR 5137999 (“Before he takes a penalty or conversion kick, the England fly half carries out his now famous ritual, involving a series of preparatory movements culminating with his hands clasped before him in a prayer-like gesture.”).

⁵⁹ See Nokia, *supra* note 28. Nokia applied for U.S. registration of this moving image mark on June 15, 2004, Serial No. 79003468.

The trademark consists of an image of a man’s hand and a child’s hand which appear in sequence, whereby the man’s hand and the child’s hand converge in the positions illustrated in the top left and right figures, and the man’s hand and child’s hand touch and clasp in the positions illustrated in the bottom left and right figures respectively.

Id. The mark has been used in TV advertisements in connection with Nokia’s word mark “Connecting People,” (U.S.P.T.O. Reg. No. 2623913), where the hands are shown connecting on the screen of a cellular phone during the commercial. Commercial Advertisement (television broadcast).

⁶⁰ This underlies one of the most problematic aspects of current registration practices, since often the computer-generated sequence is something that could be physically represented or imitated, and rarely is there a distinction between the two. See *infra* Part II, note 91 and accompanying text.

⁶¹ The most obvious example of this is sign language. But the use of gestures to communicate is a concept well ingrained in modern society. It is fair to argue that some gestures, such as the sign for peace, carry potent messages depending on who performs them. In this respect, gestures can carry very clear messages to the person to whom they are directed, e.g., the implications of giving the “thumb’s up” sign, or perhaps a more crude gesture, to underscore a point. In light of the connection made between certain celebrities or athletes and unique gestures, see *supra* note 58, these motion marks represent truly interactive branding and advertising opportunities in terms of making a sensory connection with the consumer.

⁶² Consider a gesture, originally performed by a TV or film character, which eventually transcends the screen as viewers incorporate the gesture into their own vocabularies. By using the gesture, these fans are clearly showing their interest in the original work and therefore become advertising vehicles themselves. An interesting example of this comes from the NBC sitcom *Friends*, which incorporated its own gesture in the 4th season and continued to use it throughout the series. See, e.g., *Friends: The One With Joey’s New*

B. *Registration of Motion Marks*

In the United States, the first registered motion mark was for “[t]he audio and visual representation of a coin spinning on a hard surface, used in TV advertising,”⁶³ issued on February 19, 1957.⁶⁴ Nevertheless, the United States Code of Federal Regulations governing Rules of Practice in Trademark Cases (“the Code”) made no reference to the fact that trademarks may include motion until the Code was amended in 1999.⁶⁵ The phrase “motion mark” was not included until the Code was amended in 2003.⁶⁶ Pursuant to these requirements in the Trademark Manual of Examining Procedure, a motion mark may be registered by submitting a detailed description of the mark, and either a drawing that shows a single point of movement, or several “freeze frames” showing the move-

Girlfriend (NBC television broadcast Oct. 30, 1997). It is plausible that there are fans that use this gesture in their daily lives.

⁶³ See ARDEN, *supra* note 6, at 15. See also *Northwestern Bank of Commerce Corp.*, U.S.P.T.O. Reg. No. 0641872. Although the mark is now dead, it was registered for use in connection with “banking services.” *Id.*

⁶⁴ See ARDEN, *supra* note 6, at 15. This first motion mark registration came several years after the first sound mark was registered by NBC in 1950, U.S.P.T.O. Reg. No. 523616. *Id.*

⁶⁵ See 64 Fed. Reg. 48,920 (Sept. 8, 1999) (amending 37 C.F.R. § 2.52(a)(2)(iv) (1999)) to read:

If the mark includes motion as a feature, the applicant may submit a drawing that depicts a single point in the movement, or the applicant may submit 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. The applicant must also submit a detailed written description of the mark.

Subcommittee D of Committee No. 205 of the Section of Intellectual Property Law of the American Bar Association made a similar suggestion in its Proposed Resolution 205-5:

Given the increasing number of applications to register unconventional marks, the onus should be on the applicant to provide a clear explanation of the mark in the first instance. Therefore, our Subcommittee proposes that the description of the mark be mandatory in all applications for unconventional marks, and that 37 C.F.R. § 2.35 and TMEP § 808 be amended accordingly.

See Committee No. 205 – Unfair Competition C Trade Identity, *Proposed Resolution 205-5 Survey of Law on Unconventional Trademarks*, A.B.A. SEC. OF INTELL. PROP. LAW, 1997-1998 ANNUAL REPORT (Mark K. Dickson, ed. 1998), available at <http://www.abanet.org/intelprop/annualreport05/content/97-98/COMMITTEE%20NO%20205.pdf>. Note that currently TMEP § 808.01 is entitled “Guidelines for Requiring Description,” and prior to this amendment, a description of the applied for mark was only submitted if the examining attorney required one. TMEP § 808.01.

⁶⁶ See 68 Fed. Reg. 55,764 (Sept. 26, 2003) (amending 37 C.F.R. § 2.52(b)(3)) to list special drawing requirements for “motion marks.” See *supra* note 65. See also TMEP § 807.11.

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ment in sequence.⁶⁷ The examining procedure for motion marks can be analogized to that of trade dress; the mark “is protectable if its subcomponents are distinctive and if the entire image has limited duration.”⁶⁸ Other than the drawing and description requirements, there are no other rules that specifically address, or provide guidelines for registering motion marks in the United States.⁶⁹

In the European Community, a motion mark may be registered as long as it is capable of being represented graphically,⁷⁰ the mark is used in a substantial part of the European Community,⁷¹ and the mark does not meet objection under Article 7(1)(b) for being non-distinctive.⁷² Still, a mark would be able to overcome an initial Article 7 objection through a showing of acquired distinc-

⁶⁷ At one point, a videotape of the sequence could be submitted as specimen of use in commerce. See ARDEN, *supra* note 6, at 32. Modern technology, however, provides a more efficient option for submitting “stills” through the use of photos from a digital camera or frames from computer-generated animation, both of which can be attached to electronic trademark applications. *Id.* at 31.

⁶⁸ Erik H. Kahn, *On the 'Net, Unusual Marks Gain In Importance*, NAT'L L.J., Oct. 19, 1998, at C13.

⁶⁹ The UK Trade Marks Works Manual (“UK Manual”) has far more specific rules for motion marks in particular. See UK Manual § 16.5.1, “Movement marks require the same degree of clarity of representation as any other application; i.e. the representation must be clear, precise, self-contained, easily accessible, intelligible, durable and objective (Sieckmann criteria).” *Id.* Furthermore, the UK Manual provides a definition of a “distinctive” motion mark:

Whether the average consumer will perceive the moving image(s) as meaning that the goods or services are exclusively associated with one undertaking. Consideration should also be given to whether other economic operators are likely, without improper motive, to wish to use the same or similar image(s) in the ordinary course of their business. For example, a moving image/hologram of a teapot pouring tea into a cup will not be distinctive for e.g. café services or for tea, but a spinning gyroscope would be distinctive for these goods and services.

Id. at § 16.5.2.

⁷⁰ See Case C-273/00, Ralf Sieckmann v. Deutsches Patent- und Markenamt., 2003 E.T.M.R. 37.

⁷¹ Determinations of distinctiveness are also tied to use of the mark in the EC such that it is recognized as being distinctive at the time of application. See The Community Trademark, in 3-10A TRADEMARK PROTECTION AND PRACTICE § 10A.09 (Matthew Bender ed., 2005).

⁷² “The OHIM Board of Appeals has found that nondistinctiveness and descriptiveness do overlap, stating that the more likely a mark is to describe the goods the less likely it is to be distinctive of those goods.” *Id.* Similar to the language of the UK Manual, *supra* note 69, the OHIM would be less likely to register a motion mark if it involved a graphic representation of the goods that was merely moving.

tiveness.⁷³ Similar to the types of drawings submitted in the United States, applications for motion marks are accompanied by a multi-frame drawing showing how the mark moves in sequence.⁷⁴

II. MOTION MARKS: BOTH BENEFICIAL AND PROBLEMATIC

Given that the possibilities for non-logo based trademarks are apparently limitless, why are we not looking at a bandwagon rolling full speed ahead?⁷⁵

The answer to this question with respect to motion marks is inherently related to the lack of case law addressing registrability and the absence of any concrete understanding as to how registration affords protection.⁷⁶

Nontraditional marks are particularly helpful for strengthening brand recognition in an era where consumers have become accustomed to words and symbols representing the source of goods.⁷⁷ From an economic standpoint, “the more resources the firm spends developing and promoting its mark, the stronger its mark will be, and the lower, therefore, consumer search costs will be; thus, the firm will be able to charge a higher price.”⁷⁸ Yet, a firm will only invest in a motion mark if it can subsequently enforce its exclusive

⁷³ See The Community Trademark, *supra* note 72. See also Council Regulation 40/94, art. 7(3), 1993 O.J. (L 011) (EC), available at <http://oami.eu.int/en/mark/aspects/reg/reg4094.htm#0070> [hereinafter Regulation].

⁷⁴ Note that TMEP § 807.13 provides a maximum number of five “freeze frames” for showing the sequence of movement, whereas in the European Community, several motion marks include significantly more “stills” such as Bi-d.tv Ltd CTM Reg. No. 2441292, which includes 130 frames. See Katrine A. Levin, *Registration of Nontraditional Trademarks in the U.S. and E.U.*, 11 INTELL. PROP. STRATEGIST 3 (Aug. 2005) (comparison of registration practices in the United States and European Community).

⁷⁵ Frost, *supra* note 12.

⁷⁶ See *infra* Parts A and B, which discuss in detail the problems resulting from the lack of case law addressing motion marks.

⁷⁷ Jerre B. Swann, Sr. et al., *Trademarks and Marketing*, 91 TRADEMARK REP. 787, 805 (2001) (“Consumer attitudes can shift dramatically overnight; and only strong brand stewardship and continual investment, not reliance on old fortresses, can preserve a position in the market place.”).

⁷⁸ See William M. Landes & Richard A. Posner, *The Economics of Trademark Law*, 78 TRADEMARK REP. 267, 277 (1988). Consumer search costs “depend on the availability of words (or other symbols) that a firm can use as its trademark.” *Id.* at 278. The ability of motion marks to draw the consumer’s attention and present information in a purely graphic way facilitates sensory memorization of the brand; “because it is harder to recall long than short phrases, a lengthy advertising message that is difficult to recall will convey less information about the firm’s product, so search costs will rise.” *Id.* Thus, the use of motion marks is one example of how companies can expand their branding options and also reduce consumer search costs.

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rights.⁷⁹ Although motion marks may be inherently distinctive,⁸⁰ imaginative, and technologically compatible with modern branding strategies,⁸¹ they present a costly problem to a trademark owner because there is no clear guide for what aspects of a motion mark are actually protected.⁸²

Defining the scope of protection for motion marks is hindered by the failure of accompanying descriptions to articulate what the trademark owner is trying to protect.⁸³ The Lanham Act defines a trademark as any “word, name, symbol, or device, or combination thereof,”⁸⁴ and motion marks can stand as the ultimate mixture of all of these elements, grouping words, graphics, colors and even sounds into one single trademark. Although this type of sensory overload may be effective for attracting attention, it creates a problem for owners seeking trademark protection if the descriptions do not communicate what specific movement is unique to the mark.⁸⁵ Furthermore, an applicant may only try to register a single mark in any given application.⁸⁶ In a proceeding denying registration to a design mark on the grounds that it encompassed more than one

⁷⁹ “If the law does not prevent it, free riding will eventually destroy the information capital embodied in a trademark. The prospect of free riding may therefore eliminate the incentive to develop a valuable trademark in the first place.” *Id.* at 272.

⁸⁰ “The [USPTO] has not given any indication that motion marks cannot fall within the inherently distinctive category.” *ARDEN*, *supra* note 6, at 56.

⁸¹ Particularly with multimedia advertising on television, in movies and on the internet. *See supra* note 32. *See also*, Kahn, *supra* note 68 (“As the Internet revolutionizes commerce, nontraditional marks will increasingly become the sole source of brand identification. Trademark lawyers and intellectual property owners must continue innovating methods of protecting marks that live, and refuse to stand still, on the Internet.”).

⁸² Gilson and LaLonde suggest that “enforcing motion marks in infringement and dilution cases should be much like enforcing traditional word and logo marks.” Gilson and LaLonde, *supra* note 6, at 48. However, in light of the OHIM Lamborghini decision and other problems discussed throughout this note, such actions may be far more complicated with respect to protected aspects of motion. *See infra* Part III.B.

⁸³ *See infra* Part III.A for a further discussion of the problems with current registration practices and suggestions for improvement.

⁸⁴ 15 U.S.C. § 1127.

⁸⁵ *See, e.g.*, Hanna-Barbera Prod., Inc., U.S.P.T.O. Reg. No. 1339596 (“The mark consists of an animated sequence of the star in motion, the end of which is shown in the drawing.”). Although the applicant specifies that the mark incorporates animation and the drawing shows a circle with a star in the middle, there is no way of knowing in which direction the star actually moves, be it clockwise, counter-clockwise, or some other pattern. This is further complicated by the fact that the drawing is not represented in “stills” showing how the star moves, but rather a single drawing of how the star ends its movement.

⁸⁶ 15 U.S.C. § 1051(a)(1) (2005); 37 C.F.R. § 2.52 (“An application must be limited to only one mark.”). Pursuant to TMEP § 807.01, an examiner should refuse registration if the matter presented in the drawing specimen does not constitute a single mark.

trademark,⁸⁷ the TTAB noted that “the various patterns will create any number of different commercial impressions. Similar comments apply to third-party motion marks.”⁸⁸ Although this opinion by one examining attorney does not stand as absolute grounds for refusing registration, it highlights the problem of determining what specific aspects of a motion mark are protectable when such marks incorporate words and designs that can function independently as trademarks.⁸⁹

Current registration and cataloguing of motion marks present additional challenges to determining the scope of protection for movement. The graphic representation of motion marks used for trademark applications is completely inadequate for showing the true nature of the mark. Although a much larger number of “stills” may be submitted to the OHIM as compared to the USPTO,⁹⁰ only the actual animated sequence or digital footage of gestures and product movement can truly demonstrate the mark as used in commerce. Furthermore, the lack of differentiation between the frames submitted for computer generated sequences versus gestures and products creates even greater ambiguity as to the nature of the registered mark.⁹¹

⁸⁷ See *In re Hays and Clodfelter*, 62 U.S.P.Q.2d 1443, 1445 (T.T.A.B. 2002).

⁸⁸ Basically, the examiner in this instance was analogizing the problem of the mark in question to motion marks, which may contain a number of individual trademarks. *Id.* at 1446. The 20th Century Fox motion mark, *supra* note 3, combines independently registered word, design, and sound marks. See *supra* note 3; *supra* note 30.

⁸⁹ This idea of endless “commercial impressions,” brings up another issue relating to consumer recognition of motion marks. Although their attention may be drawn to the movement, there is a question as to whether a consumer actually recognizes it as an indication of source. This in turn creates an even bigger problem for showing acquired distinctiveness for gestures and other descriptive or suggestive motion marks. See Gilson and LaLonde, *supra* note 6, at 4 (“A major problem with enforcement in this context is that consumers may not perceive certain nontraditional marks as trademarks at all. They may see them as merely decorative, as an inherent part of the product or as an attempt to amuse, rather than as indicating the source of the goods.”).

⁹⁰ TMEP § 807.13 limits the number of “freeze frames” to five. See *supra* note 74.

⁹¹ The “stills” included in an application for a moving image trademark and a gesture mark are the exact same; that is, the frames show how the mark moves in sequence. However, if the applicant does not claim that the mark is an actual gesture and just submits stills of an individual performing the motion, there is no way of knowing whether or not they intend that same footage to be a moving image mark or an independent gesture. Merely describing the nature of the movement does not distinguish between the two different types of motion marks.

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A. *Twentieth Century Fox v. Twenty-First Century Fox*

Although the TTAB has never specifically addressed the registrability or protectability of motion marks, there is one proceeding that sheds some light on the problem of determining what property rights are exclusive to the owners of such marks in the United States.

On August 17, 2000, the TTAB refused registration for the word marks “21st Century Fox” and “Twenty-First Century Fox,”⁹² because the marks were confusingly similar to the registered trademarks of Twentieth Century Fox Corp.⁹³ Although the denied application was only for word marks, Twentieth Century Fox’s motion mark was included among the listed registrations that provided grounds for refusal.⁹⁴ While the registered motion mark does incorporate “20th Century Fox” in the moving sequence, the Corporation owns separate registrations for this particular word mark,⁹⁵ as well as its accompanying designs.⁹⁶ The fact that the examining attorney found the applied-for word marks to be confusingly similar to the registered motion mark begs the question of what the motion mark actually protects: the word and design, or the actual movement?

If the purpose of registering the motion mark was to protect the special sequence of graphic movement, then there is no reason why this registration should be included as part of the grounds for refusal of a word mark that incorporates no motion at all. It is possible that the motion mark was viewed as incorporating multiple trademarks, one of which is the word mark “20th Century

⁹² *In re* Richard Wynn, 2000 T.T.A.B. LEXIS 570, 571 (Aug. 17, 2000) (not citable as precedence for the TTAB). See Richard H. Wynn, U.S.P.T.O. Application Serial Nos. 75011915, 75011916, filed Oct. 30, 1995.

⁹³ 15 U.S.C. § 1052(d) (2005):

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it . . . (d) Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.

Id.

⁹⁴ *In re* Richard H. Wynn, *supra* note 92, at n.10.

⁹⁵ See Twentieth Century Fox Corp., U.S.P.T.O. Reg. No. 1237164.

⁹⁶ See Twentieth Century Fox Corp., U.S.P.T.O. Reg. Nos. 1011919, 1256722, 1465225, and 1602948.

Fox.”⁹⁷ However, it is equally plausible that the examining attorney did not recognize the movement of the mark and unique camera angles as being the protected elements. Although this decision underscores the point that motion marks can bring additional levels of protection to already registered word and design marks, it represents the problem of determining whether registration really protects the unique movement of the images, or merely the same words and symbols already protected in other graphic forms.

B. *The Lamborghini OHIM Appeal*

On September 23, 2003, the OHIM First Board of Appeal⁹⁸ officially denied registration of the Lamborghini “scissor” doors as a Community motion mark, dismissing Automobili Lamborghini Holding S.p.A.’s appeal from an examiner’s initial objection.⁹⁹ This decision is one of the first in the United States and Europe to specifically address the registrability of a motion mark, and the court’s reasoning is particularly important with respect to understanding the scope of protection afforded to motion marks in the European Community.

Automobili Lamborghini applied for a Community Trade Mark (CTM) on November 26, 1999,¹⁰⁰ claiming priority based on

⁹⁷ This view however, would run contrary to the TMEP one mark requirement. *See supra* note 86. 15 U.S.C. § 1051(a)(1); 37 C.F.R. § 2.52 (“An application must be limited to only one mark.”).

⁹⁸ “Any final decision by one of the Office’s bodies, in so far as it has adversely affected one party, is subject to appeal on the initiative of that party. The appeal is brought before the Office’s Boards of Appeal.” *See* Office for Harmonisation in the Internal Market, *The Community Trade Mark in Practice* § 3.14, <http://oami.eu.int/en/mark/role/brochure/br1en25.htm> (last visited Oct. 22, 2006).

⁹⁹ Case R-772/2001-1, Automobili Lamborghini Holding S.p.A.’s Application, 43 E.T.M.R. at 545 In an eerie twist of intellectual property fate, September 23, 2003 was also the date on which Lamborghini’s application to register the same moving doors was published for opposition in the United States. The U.S. application was originally filed on December 28, 1999 and the mark was registered on December 16, 2003. *See* Automobili Lamborghini Holding S.p.A., *supra* note 1.

¹⁰⁰ *See* CTM Application No. 001400092 (“The trade mark refers to a typical and characteristic arrangement of the doors of a vehicle. For opening the doors are ‘turned upwardly,’ namely around a swiveling axis which is essentially arranged horizontally and transverse to the driving direction.”). Automobili Lamborghini also submitted a four picture series depicting the movement of the doors as they open. *Id.* Despite the fact that the applications were filed one month apart, there are several key differences between the language used in the OHIM and American applications. *See supra* note 1. In the American application, the movement of the doors is described as “the unique motion” compared to the OHIM “typical and characteristic arrangement.” In addition, the American application states that the mark “consists of” the motion as opposed to “refers to” the arrange-

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an application filed in Germany.¹⁰¹ The examiner objected to the application on two grounds:¹⁰² first, because the mark lacked distinctive character,¹⁰³ and second, because the mark consisted solely of the shape of a product which was necessary to achieve a technical result.¹⁰⁴ With respect to distinctive character, the examiner found that other car companies also used upward-moving doors on their models, and therefore Lamborghini's doors did not stand as an indication of product source, but rather "as a characteristic feature of a category of (sports) cars."¹⁰⁵ Furthermore, the examiner felt the mark consisted of a three-dimensional shape, and since there were limited manufacturing possibilities for car doors, the shape was necessary for the technical function of the product.¹⁰⁶

ment, indicating that the mark is the movement itself, as opposed to the doors. This type of distinction and the importance of phrasing descriptions of motion marks will be discussed *infra* Part III.

¹⁰¹ Case R-772/2001-1, Automobili Lamborghini Holding S.p.A's Application, 43 E.T.M.R. at 544. German Registration No. 39942129, applied for on July 17, 1999 (has since been abandoned). See Dr. Ralf Sieckmann, *Annex to Non-traditional Trade Marks – Motion Marks*, <http://www.copat.de/markenformen/bewegungsmarken2006.pdf> (last visited Oct. 22, 2006).

¹⁰² Initial objection found in a letter dated Dec. 4, 2000. Case R 772/2001-1, Automobili Lamborghini Holding S.p.A's Application 43 E.T.M.R. at 545.

¹⁰³ See Regulation, *supra* note 73, at Art. 7(1)(b). Article 7 covers "Absolute Grounds for Refusal" in the European Community and Article 7(1) states, "the following shall not be registered . . . (b) trade marks which are devoid of any distinctive character."

¹⁰⁴ See *id.* at Art. 7(1)(e)(ii); "the following shall not be registered . . . (e) signs which consist exclusively of . . . (ii) the shape of goods which is necessary to obtain a technical result." This particular provision can be analogized to the doctrine of functionality in American Trademark law, which prevents registration of the shape of a product where:

The design affords benefits in the manufacturing, marketing, or use of the goods or services with which the design is used, apart from any benefits attributable to the design's significance as an indication of source, that are important to effective competition by others and that are not practically available through the use of alternative designs.

RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 17 (1995); see also 15 U.S.C. § 1052(e)(2)(5) (2005). For a detailed discussion of the meaning of Article 7(1)(e) in comparison to American Functionality doctrine, see Alison Firth, *Shapes as Trade Marks: Public Policy, Functional Considerations and Consumer Perception*, 23(2) E.I.P.R. 86 (2001).

¹⁰⁵ Case R-772/2001-1, Automobili Lamborghini Holding S.p.A's Application, 43 E.T.M.R. at 543.

¹⁰⁶ *Id.* See also Case C-299/99, Koninklijke Philips Elec. NV v. Remington Consumer Prods. Ltd., 81 E.T.M.R. 955 (2002). Philips sued Remington for infringement of the shape of its three-headed shaver, but the European Court of Justice denied relief. "In a policy driven decision, the Court held that even where alternative technical solutions were available, trade mark protection was not the correct way to protect such shape, this was the domain of patents and designs, which are of shorter duration." Hidaka, *supra* note 17, at 1122. Nevertheless, on January 26, 2006, the decision was reversed on appeal. See Philips

Automobili Lamborghini sent notice and grounds for appeal on January 11, 2001.¹⁰⁷ The company argued that the mark was distinctive and tried to clarify that the application was confined to door movement running parallel to the body of the car, where other upward-moving models ran perpendicular to the body.¹⁰⁸ Although Mercedes-Benz also manufactured a vehicle with parallel-moving doors,¹⁰⁹ Lamborghini argued it had priority since the model was only available to the public after its date of application.¹¹⁰ Lamborghini also denied that the movement of the doors was a technical necessity and emphasized that the purpose behind Ferruccio Lamborghini's design was "to create a completely new door configuration which had a particular recognition value and represented an unmistakable sign of a Lamborghini."¹¹¹ In a second letter of appeal, the Company argued alternatively that Article 7(1)(e)(ii)¹¹² could not be used as a basis for refusal, because it applies to the shape of a product, whereas the application was for the movement alone, and not the shape.¹¹³

The First Board of Appeal ("the Board") found Lamborghini's distinction between movement and shape unconvincing, and this reaction illustrates the profound problem of identifying the scope of protection afforded to all varieties of motion marks. Because the movement involved the shape or technical arrangement

v. Remington – The Result, http://ipkitten.blogspot.com/2006_01_01_ipkitten_archive.html (last visited Jan. 26, 2006).

¹⁰⁷ Case R-772/2001-1, *Automobili Lamborghini Holding S.p.A's Application*, 43 E.T.M.R. at 543.

¹⁰⁸ Doors that move upwards, but perpendicular to the car body, are also called "gull-wing" doors, and were first used on a Mercedes SL 300 in the early 1950s. These doors are also hinged to the roof of the car, as opposed to the base. For pictorial reference, see Gull-wing doors, WIKIPEDIA, THE FREE ENCYCLOPEDIA, http://en.wikipedia.org/wiki/Gull-wing_doors (last visited Oct. 23, 2006).

¹⁰⁹ The model referred to by the examiner is the Mercedes "Vision" model. However, this vehicle and the new Mercedes-Benz SL McLaren model both have a different type of door, called a "Butterfly" door, the movement of which differs slightly from the Lamborghini "scissor" door. The Butterfly doors move parallel to the body of the car and then rotate towards the roof, whereas the Lamborghini doors move vertically without any additional rotation. Photographs of the Mercedes-Benz SL McLaren are available at http://www.mercedes-benz.co.uk/pc/web_special_en/flash.html (last visited Oct. 23, 2006).

¹¹⁰ Case R-772/2001-1, *Automobili Lamborghini Holding S.p.A's Application*, 43 E.T.M.R. at 546.

¹¹¹ *Id.* The examiner subsequently refused the application again on Aug. 10, 2001. Lamborghini sent its second letter of appeal on Nov. 26, 2001.

¹¹² See *supra* note 104.

¹¹³ Case R-772/2001-1, *Automobili Lamborghini Holding S.p.A's Application*, 43 E.T.M.R. at 547.

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of the goods, the Board held “the trademark is therefore necessarily three-dimensional in nature and, if it is not based on a specific shape, amounts to nothing more than a characteristic mechanical movement which equates to a technical function of a car door.”¹¹⁴ This statement can be interpreted as an indication that the Board does not recognize unique motion as being capable of distinguishing the source of goods as a trademark. Although the Lamborghini motion mark can be distinguished from those involving computer generated sequences or gestures,¹¹⁵ movement is the defining feature of those marks as well. If motion is not protected by the OHIM, then there is no purpose in registering motion marks as CTMs because owners will have no basis for protecting these marks from infringement.

Despite the fact that there were other movement marks registered at the time the Board made its decision,¹¹⁶ there is no mention or comparison of them in response to Lamborghini’s argument that the subject matter of the application is movement rather than shape. Instead, the Board relegates the concept of movement marks to something which is uniquely adopted into German trademark law, without acknowledging its already established place in the European Community.¹¹⁷

An additional problem with this holding for motion mark owners comes from the denial of registration on the basis that the doors were non-distinctive, an argument founded on competitive use of moving doors in the automotive industry. By failing to explore what type of motion makes the Lamborghini doors different from other companies’ doors, the Board established a troubling precedent for any owner seeking to bring action for infringement of its motion mark.¹¹⁸ The first disconcerting possibility is that fu-

¹¹⁴ *Id.* at 543.

¹¹⁵ See *supra* Part I.A, describing various types of motion marks.

¹¹⁶ See, e.g., Vattenfall AB CTM Reg. No. 1772615, *supra* note 28, registered on Sept. 1, 2003.

¹¹⁷ “The Board is aware of the fact that the concept of the ‘movement mark’ has been adopted into German trade mark legal doctrine. In his book, *Markenrecht* (ed. 1997) Dr. Karl-Heinz Fezer asserts that the subject-matter of the trade mark protection of a stylised movement as a motive mark is not only a concrete sequence of images, but also a stylised movement.” Case R-772/2001-1, *Automobili Lamborghini Holding S.p.A.’s Application*, 43 E.T.M.R. at 549.

¹¹⁸ There is no evidence in the case that surveys were used to show consumer recognition of the Lamborghini doors. An interesting piece of evidence that may have been helpful to Lamborghini’s position comes from the song “How We Do” by rapper The Game (also known as Jayceon Taylor), featuring 50 Cent. The lyrics boast, “I put Lamborghini

ture courts may deem a motion mark non-distinctive by virtue of a competitor's use of a related, though not identical, movement in their trademark.¹¹⁹ In addition, the court's approach implies that the specific way in which movement is incorporated into a mark would not be considered in an action for infringement.

Overall, the Board's decision in the Lamborghini case blatantly challenges the notion of whether motion marks are, in fact, protected in the European Community. If movement is not the feature of the mark that draws the court's attention, then what is protected when such a mark is registered? This case underscores the problem of defining the protected aspects of these marks and emphasizes the importance of the language used in motion mark applications to describe and disclaim the aspects the owner seeks to protect. Perhaps if Lamborghini had phrased its application differently, emphasizing the precise movement of its doors and distinguishing how this movement differs significantly from that of other manufacturers, they may have fared better with the examiners. For instance, Lamborghini could have sought protection for only "scissor" doors where there is no rotation, rather than describing the mark as "typical" upward movement of a car door.

Several motion marks have been registered since the Lamborghini appeal, which helps to draw the distinction between motion marks featuring product functions and those comprised of computer-generated sequences.¹²⁰ Nevertheless, as the Lamborghini

doors on my Es-co-lade," *How We Do*, on The Documentary (Aftermath Entertainment 2005), indicating that moving doors of this kind, at least in the minds of certain consumers, are uniquely associated with the Lamborghini brand. The author would like to thank Jonathan Marks for bringing this gem of pop culture to her attention.

¹¹⁹ This reasoning suggests that the mere presence of competition condemns a motion mark to being non-distinctive, and yet, one of the underlying reasons for trademark registration is to define what makes an owner's mark distinguishable from other marks that might include comparable elements. The protection afforded by registration promotes investment in the brand, and in turn reduces consumer search costs. *See* Landes & Posner, *supra* note 78, at 277.

¹²⁰ *See, e.g.*, Berggren OY CTM Reg. No. 1864610.

[T]he mark comprises six still pictures representing a moving image (the numerical indications do not belong to the mark). Picture number 1 is the starting point with a stylized green coloured bird starting to open its wings. In the subsequent pictures the bird's wing/s is/are opening progressively to the highest position which is shown in the final picture number 6. The process described above then repeats itself beginning from picture 1.

Id. Note that this description is far more detailed than that provided by Lamborghini, *supra* note 1, but still fails to precisely describe the movement. For instance, the description does not indicate the angle of the wings in picture 1 versus picture 3, the direction in

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case is unique in its specific discussion of registration of movement, the reasoning of the First Board¹²¹ must be weighed carefully by owners seeking to register any kind of motion mark in the European Community, particularly with respect to asserting property rights over unique movement.

III. SIMPLE SOLUTIONS

As the rapid evolution of trademark formats converges with the explosive growth of information technology, they produce both opportunity and risk. The opportunity lies in the nearly limitless creativity to develop new types of trademark formats or to identify nontraditional marks that have existed unnoticed for years. The risk lies in the fact that each new product might run afoul of a previously unidentified mark or one being used in an unconventional, new market that has sprung up in the information age. In short, a critical juncture in the way trademarks are selected, cleared and used is approaching rapidly.¹²²

Despite the potential problems associated with protecting motion marks, there are changes that could easily be made to the registration process to more clearly define the property rights that individual applicants assert with respect to motion. Furthermore, a preemptive discussion about litigating motion marks in an infringement context will serve as a theoretical guide to both practitioners and trademark owners faced with choosing whether to assert these exclusive rights. The following proposals directly address some of the existing questions and concerns over how to search for, register, and protect motion marks.

A. *Changing Registration, Publication, and Database Content*

A registered trademark constitutes prima facie evidence of an owner's priority and exclusive rights to use the mark in commerce.¹²³ Yet, trademark owners can only enforce these rights and protect their marks from infringement and dilution by staying informed of recent applications. Given the enormous number of new

which the bird is flying, the amount of time the sequence takes to complete and start over, or the angle at which a consumer would view the mark.

¹²¹ Registration was denied on the grounds that the mark was non-distinctive and designed to achieve a technical result. See *supra* notes 103-4.

¹²² Falconer, *supra* note 38, at C28.

¹²³ See 15 U.S.C. § 1115(a) (2005); Directive, *supra* note 9, at Art. 5(1)(b).

trademarks issued each year,¹²⁴ the registration process in both the United States and the European Community functions to inform trademark owners and applicants about those marks under review so that they can file timely oppositions if necessary.¹²⁵ Furthermore, maintaining extensive databases for cataloguing application specimens, registered marks and abandoned or cancelled marks, helps facilitate efficient due diligence searching prior to filing an application.¹²⁶ Yet, in order to guide applicants in choosing their own marks wisely and in order to notify trademark owners of applications they should oppose, these databases must accurately represent trademarks through drawings and descriptions.¹²⁷ Part of the problem with defining the scope of protection for motion marks stems from inadequate registration practices and database cataloguing. Because applications do not clearly describe what property rights the owners are seeking with respect to motion and because the drawings submitted do not adequately reflect the movement of the mark, it becomes extremely difficult to determine, through either publication or searching, what motion marks are currently registered or under review.¹²⁸

The USPTO and OHIM should update current processes of registration and cataloguing of motion marks so that these processes more clearly reflect the marks' unique nature. This can be accomplished through the use of computer video files that,

¹²⁴ See *supra* note 15. In 2005, the OHIM registered 59,759 trademarks. See *Statistics of Community Trade Marks 2005*, <http://oami.eu.int/pdf/office/SSC009%20%20Statistics%20of%20Community%20Trade%20Marks%202005.pdf> (last visited Oct. 23, 2006).

¹²⁵ Both the USPTO and OHIM periodically publish compilations of recent trademark applications for opposition once they have passed initial review by examining attorneys. The *Trademark Official Gazette* and *Community Trade Marks Bulletin* are both available in print or online at their respective websites, www.uspto.gov and <http://oami.eu.int/en/mark/default.htm>.

¹²⁶ Although this section will suggest several options for renovating the TESS and CTM databases, they are nevertheless invaluable sources of trademark information, and both the USPTO and OHIM should be commended for offering open access to the international public. The fact that these databases are available on the internet gives every trademark owner, applicant and practitioner a wealth of knowledge at the click of a mouse.

¹²⁷ See generally Hidaka, *supra* note 17.

Where non-standard marks may be registrable, the problem is how adequately to represent them on the register? The key is to enable anyone, when looking at the register, to be able clearly to ascertain the scope of the registrant's monopoly. Whilst this can be easily done with a word or logo mark, it is less simple with non-standard marks.

Id. at 1129.

¹²⁸ See *supra* note 85 (concerning the inadequate description and drawing accompanying Hanna-Barbera's registered motion mark).

when downloaded, show the marks' actual movement as opposed to various "stills" or "freeze frame" drawings. The USPTO recently added a parallel option for sound marks, which may now be heard by downloading samples from the TESS database.¹²⁹ Given the recent glut of electronic filings, there is no reason why file attachments of the actual computer-generated sequences or videos of products and gestures could not be substituted for freeze frame depiction.

Another beneficial modification to the processes of registration and cataloguing would involve the categorization of motion marks as distinct from other nontraditional identifiers. The OHIM CTM database places motion marks within the "Others" designation, while all other nontraditional marks have their own categories.¹³⁰ Yet, CTM-Online allows a user to search by trademark "type." Because the "Others" category also includes applications for trade dress and other source-designating designs, it would be far easier to review motion mark applications and registrations if one could select "motion mark" from the list of options when using CTM-Online to search by trademark "type." In the United States, the Trademark Manual of Examining Procedure could be amended to require all accompanying descriptions to include the specific phrase, "motion mark."¹³¹ This would clarify that motion is a fea-

¹²⁹ Under the Trademark Document Retrieval ("TDR") option on the USPTO TESS database, application sound specimens have links so that a user searching the site can listen to them. Since sound marks can be submitted as either .wav or .mp3 files in an electronic filing, it is not difficult to provide the same files for the public. See TMEP § 807.09 (describing procedures for sending .wav files in connection with electronic applications). See, e.g., the NBC "Chimes," *supra* note 21, MP3 file, available at <http://www.uspto.gov/go/kids/> (follow "listen to a mark" hyperlink) (last visited Oct. 23, 2006). A large sample of both registered and applied for sound marks are catalogued in one place on the kids-friendly portion of the USPTO website, <http://www.uspto.gov/go/kids/> (follow "listen to a mark" hyperlink) (last visited Oct. 23, 2006).

¹³⁰ See *Statistics of Community Trade Marks*, *supra* note 124 (providing registration numbers for "Colour," "Sound," "Hologram," and "Olfactory" categories of CTMs).

¹³¹ See *supra* note 65 (detailing the description requirement for all motion mark applications); 37 C.F.R. § 2.52(b)(3) (2005). Although all motion mark applications must be accompanied by a detailed description, there is no requirement that they be referred to as a "motion mark."

Both the TMEP and OHIM Examination guidelines could also be amended to include better guidelines for examining motion marks, using the UK Examining Manual as a model. See UK Trade Marks Works Manual, *supra* note 69, at § 16.5.2 (giving guidelines for determining distinctiveness with respect to motions and requiring an examiner to consider whether the average consumer would recognize the mark as representing the source of goods or services, and whether competitors in the same industry would want to use a similar graphics or features in the ordinary course of business). In at least one instance, the

ture of the mark and would also facilitate searching on the TESS database by providing a consistent term to look for under the marks' accompanying descriptions.¹³² Another option would be to create a separate mark design code for motion marks, given that the use of freeze frame drawings makes any motion mark application distinct from other applications.¹³³ This would provide yet another method for finding motion marks more easily, since searching by "drawing code" is one way to limit the search results on TESS.

USPTO has deemed a motion mark non-distinctive for purposes of registration on the Principal Register, but allowed registration on the Supplemental Register, which is reserved for non-distinctive marks that are still capable of distinguishing the source of goods and services. See 15 U.S.C. § 1091 (2005); American Association of Neurological Surgeons motion mark, U.S.P.T.O. Reg. No. 2315036. This particular motion mark involves a rotating brain, which is merely descriptive of the services "providing a wide range of information in the field of neurological surgery via a global computer information network." *Id.* This is consistent with the UK Trade Marks Works Manual approach to determining distinctiveness of motion marks, "for example, a moving image/hologram of a teapot pouring tea into a cup will not be distinctive for [example] café services or for tea, but a spinning gyroscope would be distinctive for these goods and services." See UK Trade Marks Works Manual, *supra* note 69, at § 16.5.3.

¹³² On the TESS database, a user can perform either a "free form" or "structured" search and locate files based on language used in the description of the mark, or [DE]. This suggestion would also be consistent with the application requirements for other non-traditional marks, such as color. Pursuant to TMEP § 807.07(a)(i), "if an applicant submits a color drawing, the applicant must claim color as a feature of the mark." 37 C.F.R. § 2.52(b)(1).

It is also worth noting that recently, a PTO examining attorney specifically requested an applicant to amend its description to include "motion mark," and would not publish the mark for opposition until the change was made. See *Elfenworks* Application Serial No. 76620534, Trademark Document Retrieval, Outgoing Office Action dated June 22, 2005. ("Applicant must submit a concise description of the mark indicating that it is a motion mark.").

The author contacted the examining attorney directly to inquire about this request. Unfortunately, the USPTO Office of Public Affairs would not allow the attorney's comments to be incorporated in this note. E-mail from Ruth Ann Nyblod, Office of Public Affairs, United States Patent and Trademark Office, to Lesley Matty (Feb. 15, 2006) (on file with author).

¹³³ For "Special Form Drawings," used when an applicant "seek[s] to register a mark that includes a two or three-dimensional design; color; and/or words, letters, or numbers or the combination thereof in a particular font style or size," 37 C.F.R. § 2.52(b); TMEP § 807.04, section 807.18 separates drawing design codes by the following numbers: (2) marks comprising only a design, (3) marks comprising words plus a design, (5) marks comprising stylized letters and/or numerals with no design feature, and (6) "drawings" of non-visual marks. Currently, most motion marks on the USPTO TESS database fall under either mark design code (2) or (3). Nevertheless, given that design code (6) is reserved for "sound, scent and non-visual marks," 37 C.F.R. § 2.52(e); TMEP § 807.09, it would be equally feasible to designate a separate category for those marks that claim motion as a feature, and incorporate a specific type of freeze frame drawing.

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In addition to requiring the phrase “motion mark” in every description, applicants should be compelled to describe the movement in exact detail so that an examiner, or anyone searching the database, could visualize the mark without the actual drawing.¹³⁴ This would clarify what property rights are asserted in an application, e.g., rights as to camera angles, the subject matter, number of movements, direction of motion or any other combination of elements. Applicants should also be made to disclaim certain aspects of the mark for which they are not seeking protection.¹³⁵ Overall, demanding particularized descriptions will help to illuminate ownership rights, aiding future applicants who are trying to create their own motion marks by providing a solid basis for comparison.¹³⁶

B. *Litigating Motion Marks*

In 1925, esteemed legal scholar Learned Hand wrote, “there is no part of the law which is more plastic than unfair competition, and what was not reckoned an actionable wrong 25 years ago may have become such today.”¹³⁷ There is perhaps no better language to describe the current situation with motion marks, for even today it seems far-fetched that there would be an action for infringement or dilution of this type of trademark. However, it is entirely possible, if not probable, that, in the future, there will be either litigation by independent parties or appeals to the USPTO and OHIM

¹³⁴ See Deutsche Telekom AG, *supra* note 57. This is a good example of how well-articulated descriptions can produce a clear visual image of the mark without having to look at the stills or other drawings.

¹³⁵ Hanna-Barbera Prod., Inc., *supra* note 85, might disclaim use of a moving star in any other pattern or direction other than that used in registered animated sequence. Twentieth Century Fox might disclaim use of moving spotlights other than crisscrossing above the words “20th Century Fox,” but might claim property rights over the unique camera angle at which the mark moves into view.

Although the American Association of Neurological Surgeons motion mark is only on the Supplemental Register, the application disclaimer states, “no claim is made to the exclusive right to use a realistic depiction of a brain apart from the mark as shown.” See *supra* notes 26, 131. Although this disclaimer does not reference the direction in which the brain moves, this type of language certainly helps to clarify the owner’s property rights upon registration.

¹³⁶ This would also help litigants in an infringement action, because the marks could be compared based on the descriptions and disclaimers in addition to the general sequence of movement.

¹³⁷ Ely-Norris Safe Co. v. Mosler Safe Co., 7 F.2d 603, 604 (2d Cir. 1925). This is also the opening quote from Frank I. Schechter’s legendary article, Schechter, *supra* note 36, at 813.

after a denial of registration.¹³⁸ In either situation, there will be little to no guidance for evaluating motion marks in this context.¹³⁹ Analogies can be made to other nontraditional marks; however, with respect to color, sound, and even scent, the average lay person can clearly identify exactly what is protected upon registration, and can, thus, make a comparison where two marks are alleged to be confusingly similar.¹⁴⁰ On the other hand, with respect to motion marks, balancing the factors for determining infringement or likelihood of confusion is complicated by the fact that either an examining attorney or judge will first determine what to compare, from among numerous different aspects of the sequence: the motion it-

¹³⁸ The complaint filed by Diamond Dallas Page against Jay-Z, *see supra* note 55, is one current example of an action involving a motion mark that presents an unprecedented question of property rights in the United States with respect to a physical movement. Although this action may be resolved through settlement before the issue is thoroughly considered by the court, the case presents a legitimate question of unfair competition under the Lanham Act, given that the gestures are virtually identical in terms of similarity and both parties use the gesture in commerce in connection with the sale of goods and promotion of services. *See* 15 U.S.C. § 1125(a)(1) (2005).

Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or (B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities, shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

Id.

¹³⁹ Other nontraditional marks will probably face similar uncertainty when it comes to litigating property rights.

In an enforcement action, courts may have difficulty determining the similarity of two flavor or scent trademarks, for example. In traditional word trademark enforcement, courts typically compare sound, appearance and meaning for similarity. However, in nontraditional trademark enforcement, there are few such benchmarks, and a court in a scent infringement case, for example, is faced with devising a different yardstick for determining similarity for likelihood of confusion purposes.

Gilson & LaLonde, *supra* note 6, at 3-4.

¹⁴⁰ Although it may be difficult for courts to determine what constitutes similarity of color, sound, and scent marks in terms of infringement, *id.*, the subject matter for comparison is clearly defined from the outset. Because motion marks combine a number of different visual elements, they are more complicated for purposes of comparison than other nontraditionals.

self, the visual angles, the subject matter, or the overall look and feel of the mark.¹⁴¹

In the European Community, the primary factors used to assess likelihood of confusion between trademarks are reputation of the mark, similarity of sign/mark, and similarity of the goods and services.¹⁴² In the United States, each federal circuit court has its own list of factors for comparison of marks in an infringement action;¹⁴³ however, a recent empirical study shows that similarity of the marks is the most important factor across the circuits.¹⁴⁴ The TMEP also lists a number of factors for an examiner to consider in determining whether to refuse registration, and similarity of the

¹⁴¹ See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 21(a) (1995), listing the following factors that may be important when considering likelihood of confusion:

- (a) the degree of similarity between the respective designations, including a comparison of (i) the overall impression created by the designations as they are used in marketing the respective goods or services or in identifying the respective businesses; (ii) the pronunciation of the designations; (iii) the translation of any foreign words contained in the designations; (iv) the verbal translation of any pictures, illustrations, or designs contained in the designations; (v) the suggestions, connotations, or meanings of the designations.

Id. The Federal Circuit Court of Appeals articulated in *In re National Data Corp.*, 753 F.2d 1058, 1058 (Fed. Cir. 1985), that trademarks should be considered in their entirety in the context of determining likelihood of confusion. However, the court also clarified:

On the other hand, in articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties (footnote omitted).

Id. The OHIM Examination Guidelines state in § 7.4.2, “the strategy will have to take into account the whole impression conveyed by the trade mark, rather than simply comparing individual elements. It is quite possible for trade marks to have several elements in common without there being a possibility of confusion between them.” OHIM, *Examination Guidelines*, § 7.4.2, <http://oami.eu.int/en/mark/marque/directives/exam.htm> (last visited Oct. 23, 2006).

¹⁴² See Hidaka, *supra* note 17, at 94.

¹⁴³ For a compilation of each circuit’s individual list of factors, see DINWOODIE & JANIS, *TRADEMARKS AND UNFAIR COMPETITION LAW AND POLICY*, Figure 7.1, 470 (Aspen Publishers 2004).

¹⁴⁴ See Barton Beebe, *An Empirical Study of the Multifactor Tests for Trademark Infringement*, 95 CAL. L. REV. (forthcoming 2006), available at www.bartonbeebe.com. The results of this study are based on a review of all U.S. District court decisions between 2000 and 2004 that incorporate thorough analyses of each circuit’s version of the multifactor test. The results also indicate that the second most important factor is bad faith intent of the defendant. *Id.* at 35. Based on the cases covered in the study, the results indicate that if a court does find in favor of plaintiff with respect to similarity of the marks, the plaintiff will not be able to succeed overall in an infringement or unfair competition action. *Id.* at 33-34.

marks in their entirety is listed as the first consideration.¹⁴⁵ Therefore, although there are a number of other important factors which contribute to likelihood of confusion as to source,¹⁴⁶ in the United States, determining similarity of marks is the most critical, and as will be discussed below, it is also the most difficult factor to assess in the context of motion marks.¹⁴⁷

To illustrate this point, one might consider a hypothetical case involving the Nokia moving image mark comprised of two hands coming together and grasping each other.¹⁴⁸ The unique motion of this mark consists of two hands converging at the center of the screen, palms facing forward, which at first glance seems relatively simple. Yet, when one contemplates the details of the sequence, it remains unclear whether Nokia has property rights over any use of moving hands that grasp, over only moving hands that converge at the center of the screen, or over hands that grasp with palms facing forward from the viewer's perspective.¹⁴⁹ A very strict interpretation of motion marks would confine similarity to the actual movement, based on location and point of view, not the general content of the sequence. However, a more liberal interpretation, taking into account the overall look and feel of the mark, may deem any other moving image that involves two grasping hands to be confusingly similar to this mark, as an indication of source.¹⁵⁰

¹⁴⁵ See TMEP § 1207.01.

In an *ex parte* case, the following factors are usually the most relevant: The similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. The relatedness of the goods or services as described in an application or registration or in connection with which a prior mark is in use. The similarity or dissimilarity of established, likely-to-continue trade channels. The conditions under which and buyers to whom sales are made, i.e. "impulse" vs. careful, sophisticated purchasing. The number and nature of similar marks in use on similar goods. A valid consent agreement between the applicant and the owner of the previously registered mark.

Id.

¹⁴⁶ Other important factors are strength of the plaintiff's mark, proximity of the goods and services, and intent of the defendant. See Beebe, *supra* note 144, at 35-42.

¹⁴⁷ Although gesture marks and products featuring motion will present less of a problem, determining likelihood of confusion is complicated by the fact that many moving image marks are associated with similar goods and services, particularly in multimedia industries such as film and television. See *supra* note 32 and accompanying text.

¹⁴⁸ See *supra* notes 28 and 59.

¹⁴⁹ Note, *supra* note 59, that the hands in question belong to a child and an adult, which could create an additional question over Nokia's property rights.

¹⁵⁰ Cf. note 135, American Association of Neurological Surgeons motion mark disclaimer. Similar questions may arise with respect to motion marks that use specific charac-

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Although U.S. courts prefer to examine trademarks in their entirety,¹⁵¹ a different standard should be adopted for determining similarity of motion marks in an infringement or dilution context. Courts must carefully consider the unique movements that render a motion mark worthy of protection, particularly when the plaintiff owner has separate registrations for words or symbols which are incorporated into the motion sequence of a moving image mark. Special emphasis must be placed on the succession of movements contained in the mark; otherwise, registration of motion marks means little in terms of affording the owner exclusive property rights. Even if the words or symbols in two moving image marks are different, plaintiffs should still assert rights to the registered movement.

Articulating unique movement should be easier for gestures and product features. However, given the First Board of Appeal's

ters, such as the Elfenworks moving image mark (*supra* note 132), which involves a flying "Elf" or fairy. It is possible that any applicant seeking to register a motion mark that includes a similar character would be deemed confusingly similar, even if it moved differently from the Elfenworks "Elf."

Determining similarity for motion marks is even more difficult for marks that incorporate separately registered words and symbols, such as the Twentieth Century Fox motion mark. See *supra* Part II.A, notes 95, 96, and accompanying text, discussing the separate registrations for "20th Century Fox" as a word mark and also a design mark. If a competitor production studio with a distinctly different name created a moving image mark featuring the same camera angles as those used by Twentieth Century Fox or incorporated moving spotlights, a court would most likely say that the marks were not confusingly similar. Nevertheless, it is these elements that make the motion mark unique, memorable, and therefore distinctive for purposes of registration.

It is also worth noting that a motion mark deemed "famous" could qualify for dilution protection under § 43(c) of the Lanham Act. In fact, dilution claims may be a more effective approach for protecting motion marks since dilution is not premised on consumer confusion, but rather a competitive use that "dilutes the distinctive quality of the mark." 15 U.S.C. § 1125(c)(1) (2005). See Maureen Morrin & Jacob Jacoby, *Trademark Dilution: Empirical Measures for an Elusive Concept*, 19(2) J. PUB. POL'Y & MKTG. 265, 266 (2000).

In cases of trademark dilution, consumer confusion, mistake or deception can be, but need not be, present. Thus, even if consumers are fully aware that, though they bear the same mark, two different goods or services come from two different and completely independent sources (i.e., consumers are not confused), a case still can be made that the mark has been diluted.

Id. Thus, a dilution claim would be particularly appropriate in the aforementioned, hypothetical case of a competitor production studio using similar camera angles as those of the Twentieth Century Fox motion mark.

¹⁵¹ See *supra* note 141. This preference is also known as the "anti-dissection" rule. See MCCARTHY, *supra* note 20, § 23:41.

analysis in the Lamborghini OHIM case,¹⁵² practitioners and trademark owners must carefully draw courts' attention to the details that distinguish one motion mark from another. The USPTO and OHIM have determined that certain motion marks are distinctive enough to justify registration. Although the scope of protection for movement itself is questionable, the lack of case law on this issue can work in a motion mark owner's favor if he can clearly express the movement and what property rights are reserved for this particular aspect through registration.

CONCLUSION

Only time will tell how motion marks will be judged in the future, and how trademark owners will proceed in enforcing their property rights to moving images, unique product motion, gestures, and physical movements. It is important, for now, for potential trademark owners to proceed with caution when applying to register a motion mark and to be precise in each application as to what defines the unique movement, aside from the words or symbols that may be protected separately.

Although this is cautionary language, it is equally important to remember that motion marks fulfill unique branding and advertising purposes and provide nearly endless opportunities in a technologically driven age. The Nokia "connecting people" moving image mark has been discussed in detail, but the June 15, 2004 application for this mark in the United States is relatively recent.¹⁵³ The two latest applications for motion marks in the United States¹⁵⁴ were filed by Microsoft Corporation under § 1(b), Intent to Use.¹⁵⁵ Furthermore, the Page Falkinburg case over the "Dia-

¹⁵² Where the court failed entirely to consider the way in which the Lamborghini "Scissor" doors move differently from the "Butterfly" or "Gull-Wing" doors used by competing manufacturers. *See supra* Part II.B.

¹⁵³ The majority of motion mark registrations and applications in the United States and EU have filing dates after 2000. *See infra* note 155 for the most recent motion mark applications.

¹⁵⁴ As of March 13, 2006.

¹⁵⁵ *See* Microsoft Corp., U.S.P.T.O. Serial No. 76653549 and Serial No. 76653574, both dated Jan. 7, 2006. Both of these applications do use the phrase "motion mark" in the description. ("The mark consists of a generally rectangular shape with curved sides and a circle in the lower portion. This is a motion mark depicted in five drawings. The circle inside the rectangle illuminates first and then darkens. This illumination/darkening motion then encircles the upper portion of the rectangle.").

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mond Cutter” gesture is only at the pleading stage.¹⁵⁶ Though the court may very well dismiss the action, there is also a possibility that the case will be fully litigated and provide the first U.S. decision with respect to gestures.¹⁵⁷

As technological forms of advertising continue to appear at every corner, the “branding of Cityspace”¹⁵⁸ will inevitably advance the creation and expansion of trademarks in digital form. After all, “nearly every major city has seen some variation of the 3-D ad takeover, if not on entire buildings, then on buses, streetcars or taxis . . . [which] with the help of digital imaging and large pieces of adhesive vinyl, have become ads on wheels”¹⁵⁹ In light of this visual takeover, this article highlights the problems that motion marks face, but it is not meant to deter potential trademark owners from registering their motion marks. Rather, it encourages careful applications and descriptions of such marks in order to foster creativity without compromising property rights just because motion marks are unconventional.

¹⁵⁶ According to the court docket, both Jay-Z and Roc-A-Fella Records were required to file their Answers to the Original Complaint by Mar. 8, 2006. *See supra* note 55.

¹⁵⁷ *See supra* note 138, discussing the possibility of settlement. It is also possible that the case will not be decided on doctrine relating to trademark or unfair competition, but rather rights of Celebrity and Publicity. *See supra* note 58.

¹⁵⁸ *See* KLEIN, *supra* note 32, at 34.

¹⁵⁹ *Id.* at 37.

