Can you trademark a moving image?

Artists need to go through the motions to protect their moving masterpieces.

In June, the multinational Japanese conglomerate Toshiba made history when it obtained the first UK Trade Mark Registration for a multimedia ‘motion’ mark registration.

The artwork in question depicts the Toshiba logo set against a background of folding and unfolding coloured triangles, reminiscent of the classic Japanese art form of origami. It serves as an imaginative representation of the fusion between history, tradition, and future innovation in the digital age. But why is this registration so ground-breaking? And what can both artists and designers take away from this?

Original image: iStock
The Bass & Co. Pale Ale triangle logo made history when it became the first UK trademark registration on 1st January 1876. Laster, the Patents, Designs, and Trade Marks Act 1883 conferred protection for a limited category of marks. In particular, it was possible to obtain a UK Trade Mark Registration for names, signatures or a distinctive device, mark, brand, heading, label, ticket, or fancy word or words not in common use. There have been a number of significant developments since which have broadened the categories of marks eligible for registration. Many of these changes were introduced to recognise changes to branding and marketing.

The harmonisation of EU and UK law, resulting from the UK’s membership of the EU, made it possible to protect the non-traditional aspects of a brand, such as colours, shapes, smells, holograms and sounds.

One specific example is the trademarking of the scent of Play-

Doh, which was registered in June 2018 as a “sweet, slightly musky vanilla fragrance, with slight overtones of cherry, combined with the smell of salted, wheat-based dough.” Toshiba’ trade mark registration for a multimedia ‘motion’ mark is the latest example of how IP law adapts when technological innovations create new possibilities for artists and designers.

Image: iStock<

Moving images are typically protected by way of copyright. Unlike registered trade mark protection, copyright has a finite lifespan (typically 70 years from the end of the calendar year in which the author dies), and there can be difficulties in proving the existence, scope and ownership of the copyright. Successful enforcement is also often dependent

on proving that a third party has copied the work without consent.

Whilst many moving images will not satisfy the requirements for trade mark registration, and copyright is likely to remain the most appropriate form of IP protection in the circumstances, the recent changes to UK Trade Mark practice opens the door for artists and designers to protect aspects of moving images that perform a trade mark function (i.e. indicate trade origin).

Although there are a number of jurisdictions around the world that protect the work of artists and designers by recognising motion marks, protection is typically obtained by filing a series of static images that cumulatively depict a moving image.

Image: iStock

This can potentially create ambiguity as to the scope of the rights conferred by the registration. However, with the UK Intellectual Property Office implementing new changes to its trademark practice earlier this year, the UK is now one of the few jurisdictions in the world where it is possible for artists to obtain protection for a multimedia mark, provided that the mark in question satisfies the conventional requirements for registration.

We can see that moving images are becoming an increasingly prevalent aspect of digital marketing, and this case demonstrates that trademark law is evolving to recognise and protect innovative approaches to branding.

Whilst the registration of the UK’s first multimedia mark is

testament to the UK’s progressive attitude to IP, it is important for artists and designers to understand exactly which aspects of their works are potentially eligible for trade mark protection, the benefits and rights conferred by registration, and the steps that need to be taken to maintain and enforce their rights.

Jason Chester is a chartered and European trade mark attorney at Marks & Clerk.

https://www.digitalartsonline.co.uk/features/creative-business/can-you-trademark-moving-image/