

# Trademark in Digital Era: Issues in Protection of Fluid Marks Analysis

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## ABSTRACT:

This paper is dealing on the issue of Fluid marks under the Trademarks Act. It is talking about how the change in technology and emerging businesses in digital market have created a new kind of mark which is fluid marks and how big companies are using such marks to attract consumers and expand their business. Before the marks used to be static and it is granted protection by legislations across the world but with the advent of technology and internet today there are marks which are not static, they keeps on changing colours and have a moving object and in some cases it is not consistent it keeps on changing. These are known as fluid marks like Google doodle which doesn't have any protection. This paper will deal with issues concerning fluid marks and marks which are operated online with respect to trademark. The paper will focus on Indian laws as well as international laws and examine laws of various countries with respect to this issue. Thereafter the paper will examine as to why these issues need attention and why there is a need for protection of such marks. This paper will try to analyse the issue by looking at various examples and cases which deals with fluid marks. Finally this paper will try to analyse and suggest some measures to tackle such issues. The issue which is addressed in this paper is that whether fluid marks require any protection under Trademarks act?

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## I. INTRODUCTION

The advent of internet has brought a revolution in the technological field as a result of which many things are operated in the cyberspace the biggest example of this is e-commerce sites and online banking. Many new brands are being established online best example would be Myntra and Flipkart and even the social networking sites like Facebook and twitter where we spend most of our time exist in the cyberspace only. This poses a big issue when it comes to trademark protection of these companies which are operated in cyberspace. Some companies are really big and have their marks online which are a challenge in this digital age to get the mark protected as it is very easy to copy and use those marks online. Since the evolution of social media the online advertisement of brands have increased considerably which can pose a threat of online infringement of their trademarks. This makes it difficult for companies to do trade online as there is a lack of regulation when it comes to protection of trademarks on internet. Before the marks used to be static and it is granted protection by legislations across the world but with the advent of technology and internet today there are marks which are not static, they keeps on changing colours and have a moving object and in some cases it is not consistent it keeps on changing. These marks are known as fluid marks. However there is no protection for such marks under Indian Trademarks Act, 1999 and it is not the case only with India but in any country there is hardly any regulation regulating fluid marks due to which they lack protection under domestic legislation. Moreover there is no international treaty with respect to intellectual property which provides protection to such marks.

## II. FLUID MARKS

Before proceeding to the issues the first thing one need to understand is what are fluid marks? This is a modern development which was not there before and it is not defined anywhere in the Indian Trademark Act, 1999 or in any international regulation or treaty. Fluid marks are those which is not conventional it exists in an unconventional manner. It can be a logo which can be changed by changing or using combination of different colours, movements can be added to that or it can be combined with different kinds of images to make it attractive for the digital world. It is used by various big companies the best example of this is google doodle.<sup>1</sup>

Fluid marks are also known as ‘living marks’ and they are different from other marks as they can change from time to time. These marks use variations of an existing well known trademark and use some different variations in order to make it fluid. These can often be used for advertising or to mark a special event.<sup>2</sup>

## III. ADVANTAGES AND CHALLENGES OF FLUID MARKS

Fluid marks are an excellent marketing strategy which is something more than a mere trademark. It is very handy in drawing attention of the people due to its creativity and conveys your trademark in a different way. It can be used by a well-established brand which is recognizable as fluid marks can play an important role and can push the boundaries of a trademark in a different way. It allows brands to grow. It can give brand a new dimension and can attract wider customers. Moreover the issues are much more than its advantages. Using of fluid marks is a risky business because every time the mark changes it in a way departs from its original trademark which is the main identity of the brand. So a brand which is not well established it will be a bad strategy to use a fluid mark as it can confuse the consumers as to the original trademark of the brand. There is a high risk of diluting of a trademark by using too much of fluid marks even google use its fluid mark known as google doodle at specific events only not every time.<sup>3</sup>

## IV. THE DIGITAL CHALLENGE

There is a considerable increase in various crimes on online platform which is a concerning issue for the brands doing online trading. According to the World Intellectual Property Organisation (WIPO) there is an increase in cyber-squatting cases in 2016 of top domains with around 3000 cases which are reported which shows that there is 10 percent increase in the number of cyber-squatting cases. Moreover, the online counterfeiting which ten years before was of not much concern to the trademark is now a big issue in front of big brands who are

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<sup>1</sup>Fluid trademarks: *Keeping them underweight*, TRADEMARKS AND BRANDS ONLINE, (Oct 21·2018, 10 am)  
<https://www.trademarksandbrandsonline.com/article/fluid-trademarks-keepng-them-watertight>

<sup>2</sup> *United Kingdom: Dos and don'ts of fluid marketing*, WORLD TRADEMARK REVIEW (Oct 21, 2018, 10:20AM)  
<https://www.worldtrademarkreview.com/united-kingdom-dos-and-donts-fluid-marketing>

<sup>3</sup>Fluid trademarks: *Keeping them underweight*, TRADEMARKS AND BRANDS ONLINE, (Oct 21·2018, 10 am)  
<https://www.trademarksandbrandsonline.com/article/fluid-trademarks-keepng-them-watertight>

doing online business. Also the advent of social networking sites like Instagram, Facebook and Twitter are providing an opportunity to do business for the brands and companies where they can attract and reach out to huge audience easily and the same time it is very efficient also. However at the same time managing these brands on these social media platforms is very difficult task as it exposed to a large number of people there can be false branding of the same as they are connected globally. Protection of these brands from these false online postings on these sites is a challenge to the trademark owners. It makes it very easy for any person to copy that trademark logo from online platform and share the same on these sites which also creates a lot of confusion for the consumers out there to recognise these brands logo as to which one is genuine product from a genuine company or if it is a fake trademark.<sup>4</sup>

Technology plays an equally important role when it comes to protecting brands and their trades in today's digital era. The INTA 2017 showed the role of technology which are used by the brands in recent times for their effective management of their businesses. The use of technology for various purposes like monitoring online business to tackle the issue of infringements of brand as well as their trademarks and to digitise their global trademark. this event clearly showed how these companies are taking help of the technology to increase their efficiency. Therefore today due to the changing role of digital market trademark professionals are facing a great amount of difficulties and complexity in doing their job. A number of factors which are responsible for the same which also include an increase in the number of filings of trademark applications. The United States Patent and Trademark Office (USPTO) reported in 2013 that, between 1985 and 2011, trademark filings grew at an average annual rate of 6.5%, surpassing the GDP considerably. As most of the trademark departments have not grown at the same rate, it is fair to say that those who are working in the industry are facing an enormous workload from this particular aspect alone.<sup>5</sup>

## V. EXAMPLES OF FLUID MARKS

Google was launched in 1998, and since then the search engine Google has designed the company logo on its home page in different ways to mark national holidays or any significant events. Its 'Google doodles' have become increasingly popular and interactive through the years, with some versions which features moving parts and even embedding playable games which made it more interesting and attractive. As google is one of the world's most well established brands therefore, Google can afford to adapt and change its logo on a regular basis; it uses its fame really well to its advantage. However, there are at least two reasons why the fluid mark works really well for Google. The first reason is the "advantage of its homepage" it exists because people who

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<sup>4</sup>Simon Webster, *Challenges for Trademarks in a Digital World: A Review of INTA 2017*, IPWATCHDOG, (Oct 22, 2018, 12:30 AM) <https://www.ipwatchdog.com/2017/06/06/challenges-trademarks-digital-world-inta-2017/id=84072/>

<sup>5</sup>Simon Webster, *Challenges for Trademarks in a Digital World: A Review of INTA 2017*, IPWATCHDOG, (Oct 22, 2018, 12:30 AM) <https://www.ipwatchdog.com/2017/06/06/challenges-trademarks-digital-world-inta-2017/id=84072/>

visit the Google home page expect to see the Google logo in a particular place on the website, and they know Google is the source of the page they are visiting, even if it displays a variant of the usual Google logo. Another example is of Swedish vodka brand Absolut which has long used its distinctive bottle shape as a canvas for various different designs and concepts. It took part in London department store Selfridges' in 2009 on 100th birthday celebrations by creating a bottle in the store's signature yellow.<sup>6</sup>

Another example of fluid marks with recent examples are, television stations such as Channel 4 and Nickelodeon which have used some similar concepts, such as with Channel 4 going as far as to completely deconstruct and rebuild its logo in short animated sequences which usually shown to mark the start and end of an advertising break. "Another different type of fluid mark is an big example of a fluid slogan trademark which is a beverage company's Perrier's temporary replacement of its company name, and thus the Perrier word mark, with the words 'sexier', 'crazier', 'flirtier' and 'sassier' in its signature script".<sup>7</sup>

## VI. LEGISLATIONS GOVERNING TRADEMARK

There is hardly any legislation both under international as well as in national laws which grants protection to fluid marks. Even if the virtual trademarks protected online they are hard to regulate. Article 15 of TRIPS Agreement defines trademark as "*any sign, or any combination of signs, capable of distinguishing the goods and services of one undertaking from those of other undertakings, must be eligible for registration as a trademark, provided that it is visually perceptible. Such signs, in particular words including personal names, letters, numerals, figurative elements and combinations of colours as well as any combination of such signs, must be eligible for registration as trademarks*".<sup>8</sup>

Nowhere in the Trips is agreement it mentioned about fluid marks. There is no mention of fluid marks even in Canadian Trademark Law. As per the Canadian Intellectual Property Office, "*A trade-mark is a word (or words), a design, or a combination of these, used to identify the goods or services of one person or organization.*"<sup>9</sup> So as per the U.S Trademark law which is there under the Lanham Act and its amendments, "*a trademark must meet three fundamental requirements: It must consist of a device, symbol, name, work, "or any combination thereof" that the Patent and Trademark Office or the courts have found to be a valid mark. \*It must be adopted and used by a manufacturer or merchant. It must identify and distinguish goods sold or*

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<sup>6</sup> *Fluid trademarks: Keeping them underweight*, TRADEMARKS AND BRANDS ONLINE, (Oct 21, 2018, 10 am) <https://www.trademarksandbrandsonline.com/article/fluid-trademarks-keepng-them-watertight>

<sup>7</sup> *United Kingdom: Dos and don'ts of fluid marketing*, WORLD TRADEMARK REVIEW (Oct 21, 2018, 10:20AM) <https://www.worldtrademarkreview.com/united-kingdom-dos-and-donts-fluid-marketing>

<sup>8</sup> *Overview: the TRIPS Agreement*, WORLD TRADE ORGANISATION, (Oct 23, 2018, 10:30 AM), [https://www.wto.org/english/tratop\\_e/trips\\_e/intel2\\_e.htm#trademark](https://www.wto.org/english/tratop_e/trips_e/intel2_e.htm#trademark)

<sup>9</sup> *A Guide to Trademarks*, GOVERNMENT OF CANADA (Oct 23, 2018, 9:30 PM), [http://www.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/h\\_wr02360.html#whatAreTM](http://www.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/h_wr02360.html#whatAreTM)

*manufactured by one party from those of another.*"<sup>10</sup> There is also Anti-Cybersquatting Consumer Protection Act (ACPA) which enables "a trademark owner to file suit against a cybersquatter who has registered a domain name that is identical to, or confusingly similar to, or dilutive of a famous mark. For a cybersquatter to be held liable in a civil action for trademark infringement there also needs to be bad faith intent to profit from a mark." "The Internet Corporation for Assigned Names and Numbers' (ICANN) Uniform Domain-Name Dispute-Resolution Policy (UDRP) enables trademark owners to obtain through arbitration domain names that third parties are utilizing that infringe upon their marks."<sup>11</sup>

As per Indian Trademark Act, 1999 section 2 (m) "mark" includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination thereof."<sup>12</sup>

As per above cited international legislations as well as national legislations of countries like U.S, Canada, India there is absolutely no protection for fluid marks. However there are many big companies situated in U.S itself which uses fluid marks such as Google even then there is no protection for such marks. What all these international agreements and legislations are regulating is static marks however when it comes to fluid marks they are non-static for which there is no protection under any of the regulations.

## VII. CASE STUDY OF RUSSIAN TRADEMARK LAW

Therefore even in Russia according to "Article 1482 of Russia's Civil Code, a trademark may be a word, graphic, three-dimensional designation or a combination of these." Therefore, Fluid marks may prove to be an issue for manufacturers that give consumers the option of ordering customised versions of products. As such, the term 'fluid trademark' is nowhere defined under Russian law. However "the current trademark prosecution rules (approved by the Ministry of Economic Development on 20 July 2015 by Decree 482) specifically name 'illuminated' and 'dynamic' (changing) designations as among the characteristics of applied for designations. In such cases, the applicant must provide a video file, including a reproduction of the designation, which gives an exhaustive and clear image regarding the amount, nature, intensity and succession of the changes. The video file should be provided digitally and accompanied by a printed sequence of frames. If the applicant considers that substantial particularities of the illuminated or dynamic designation do not change during the reproduction, then the designation may be represented along with several frame-by-frame images,

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<sup>10</sup> <http://www.jstor.org.nusrlranchi.remotexs.in/stable/pdf/30000492.pdf?refreqid=excelsior%3A9e4b504829101361197e1a5dde549851>(Oct 24<sup>th</sup>2018, 9:30 pm)

<sup>11</sup> *Trademark Protection in the Digital Age*, ASSOCIATION OF CORPORATE COUNCIL (Oct 24, 2018, 9:30PM), <https://www.acc.com/legalresources/quickcounsel/tpitda.cfm>

<sup>12</sup> Indian Trademark Act, 1999 § 2 (m)

*demonstrating the exact number of changing images and the succession of their only (non-alternating) reproduction.”<sup>13</sup>*

There are various fluid trademarks which are registered in Russia. On 7 October 2005 the Russian Patent and Trademark Office (Rospatent) have registered Trademark 296496 which “*included a link to the full trademark (in the form of video file) and the following description: “sound, moving in the following way: in the flashing flame a bird appears, produced by the storming nature of fire. Shooting upwards, it is changed into the aflame impress of the letter “Φ”, imaged as a bird. The impress moves, becoming snow-white shining, with radiant light beams, spreading to all sides.”*In Russia when seeking to register an animation, motion or dynamic trademark, applicants and Rospatent the examiners often encounter difficulties as to the proper indication of the type of mark. There have been many cases where Rospatent required the applicant to amend the type of trademark which applied for animated or moving to a fluid mark – or vice versa.<sup>14</sup>

Therefore under Russian Trademark law there are many kinds of fluid marks are there which are granted trademark protection as they are registered as trademark. However there are no specific legislation which mentions or grants protection to the fluid marks but still they recognise it as a trademark which can be protected under general trademark law to avail the remedy under the domestic legislation.

## VIII. CASE STUDY OF UK TRADEMARK LAW

Therefore, the UK trademark law provides that *an application can be filed as a series of marks. A ‘series’ is defined as a number of marks “which resemble each other as to their material particulars and differ only as a matter of non-distinctive character which would not affect the identity of the trade mark”. An application can include up to six marks, with the first and second marks included in the application fee and further additions attracting additional fees.* Moreover, when the fluid variants diverge considerably from one another, this option cannot be availed. The best example of a fluid mark which is registered as a series trademark is the FINDUS logo, which has been protected as several series marks in various different shades and colours. There is a case where **European Court of Justice (ECJ) in Specsavers (C-252/12)** held that “*use of colour can be significant when it comes to the global assessment of likelihood of confusion or unfair advantage. Where a trademark is registered in black and white, the colour or combination of colours in which it is used can affect how the average consumer of the goods or services at issue will perceive the trademark and will therefore also be relevant in the global assessment of confusion and unfair advantage.*” In **Rintisch v Eder (C-553/11)**, the **European Court of Justice** held that “*a rights holder was not precluded from relying on use in a different form*

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<sup>13</sup> *Perpetual revolution: protecting fluid trademarks in Russia*, WORLD TRADEMARK REVIEW, (Oct 24, 2018, 12:40 PM), <https://www.worldtrademarkreview.com/brand-management/perpetual-revolution-protecting-fluid-trademarks-russia>

<sup>14</sup> *2018 Perpetual revolution: protecting fluid trademarks in Russia*, WORLD TRADEMARK REVIEW, (Oct 24, 2018, 12:40 PM), <https://www.worldtrademarkreview.com/brand-management/perpetual-revolution-protecting-fluid-trademarks-russia>

from that in which the trademark had been registered, provided that the differences between the two forms did not alter the distinctive character of the mark.” Therefore, in this particular case it was found by the ECJ that this can also be applicable where the different form itself was registered as a trademark. In **Colloseum (C-12/12)** case the **European Court of Justice** held that “*in relation to a position mark, that if a mark is used only as part of a composite mark or in conjunction with another trademark, it must continue to be perceived as an indicating origin for the use to qualify as genuine.*” However a fluid mark can also get protection under UK registered design.<sup>15</sup>

The situation in UK is slightly better than in Russia because here there are case laws where ECJ gave rulings which are relevant for fluid marks as well as they can be protected under registered design. So even here there is some kind of remedy available to the fluid trademark owners.

## IX. NEED FOR PROTECTION OF FLUID MARKS

According to the recent estimates by major search engines, like Google and Yahoo, suggest that in just eight years, the Internet has been expanded by a factor of 1,000 – there is an increase in the number of web pages from some 29 million in 1998 to an estimated of 25 billion pages by 2006. In February 2011, the number of indexed websites totalled some 13.86 billion pages. This data gives a clear picture as to the rapid growth of internet. However, with estimated sales of US\$133 billion in 2009, the fastest growing area of counterfeit trade is online.<sup>16</sup>

In November 2009, the Organisation for Economic Co-operation and Development (OECD) stated that “*the share of counterfeit and pirated goods in world trade is estimated to have increased from 1.85% in 2000 to 1.95% in 2007,*” representing a value of some US\$ 250 billion worldwide.”<sup>17</sup>

## X. CONCLUSION

The above data gives a clear idea as to how rapidly there is an increase in the growth of internet as a result of which counterfeiting of trade has also increased rapidly in the world trade which pose a big threat to the online market and for brands which are existing on the online platform. The online trade globally has a very big value in terms of money which also demands to be protected. This makes fluid trademarks really important in this digital era as these trademarks has huge trade across the globe and if there is any infringement of their trademark it will be a huge loss for their business as well as for consumers who are consuming products and

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<sup>15</sup> *United Kingdom: Dos and don'ts of fluid marketing*, WORLD TRADEMARK REVIEW (Oct 21, 2018, 10:20AM) <https://www.worldtrademarkreview.com/united-kingdom-dos-and-donts-fluid-marketing>

<sup>16</sup> *IP Infringement Online: the dark side of digital*, WORLD INTELLECTUAL PROPERTY ORGANISATION, (Oct 24, 2018, 1:30 PM) [http://www.wipo.int/wipo\\_magazine/en/2011/02/article\\_0007.html#9](http://www.wipo.int/wipo_magazine/en/2011/02/article_0007.html#9)

<sup>17</sup> *Magnitude Of Counterfeiting And Piracy Of Tangible Products: An Update*, OECD (Oct 24, 2018, 1:50 PM) <http://www.oecd.org/industry/ind/44088872.pdf>

services of those brands globally. It is a recent development which is a result of technology hence there are hardly any legislation or case laws which deals with fluid marks. Therefore, it is a serious concern which needs attention and every country should draft or incorporate fluid marks in their respective legislations. Since the changing nature of fluid marks are difficult to be protected the focus should be on the core trademark on which the fluid variants are based so that if that core trademark is granted protection the fluid marks related to that main trademark will be easily identified and protected. These brands which have fluid marks have a huge consumer base which if infringed will have a big impact on their business and will affect large number of people.