

The Trademark Reporter®



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TRADEMARK USE ISSUE

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EDITOR'S NOTE

From time to time in the course of human events, *The Trademark Reporter* (TMR) publishes a theme issue. This is one such time. The theme is trademark use.

As the TMR has become increasingly international in focus in recent years, it gives us special pleasure to include in this issue articles focusing on not only United States law but also European law, Chinese law, Brazilian law, and Canadian law, as well as the unique insights and perspectives that come from comparing and contrasting the differing legal regimes. The issue includes articles addressing practical considerations arising from new methods of using trademarks in new media environments; comparing the differing legal structures (common law and use-based on the one hand and civil law and non-use-based on the other) in the United States and Europe; examining the ways in which these differing legal systems have regulated (or not) often highly controversial keyword advertising that forms the backbone of Internet commerce; describing emerging trends in China, particularly regarding what is fair use; elucidating use and registration requirements under Brazilian trademark law (including new developments there); defining trademark use and how the manner of use affects registration, enforcement, and cancellation in Canada (again including new legal developments); analyzing the leveling effects of the Internet in establishing trademark use and trademark rights under U.S. law and the consequences of non-use—namely, abandonment. How “use in commerce” is treated by the Trademark Trial and Appeal Board as distinct from the United States district courts is even at the heart of a case currently pending before the United States Supreme Court.

This summary barely scratches the surface of the use-related issues presented on these pages. On behalf of all of the editors, I hope it sparks timely and topical insights and is, of course, eminently useful.

Jonathan E. Moskin
Editor-in-Chief

COMMENTARY

FLUID TRADEMARKS AND
DYNAMIC BRAND IDENTITIES*By Lisa Pearson**

I. INTRODUCTION

As they strive to humanize their brands and keep them relevant, more and more brand owners challenge trademark fundamentals by rejecting static marks in favor of marks that change frequently—and sometimes constantly. Logos increasingly function as brand ambassadors rather than mere signatures to engage consumers. Trade dress escapes the confines of products and packaging, becoming ever more instrumental in brand identification. These changing source identifiers have come to be known as “fluid marks.” Currently, the law on fluid marks remains nascent. This article offers practical ideas for brand owners and trademark lawyers seeking to keep pace with the brave new world of fluid branding.

A fast taxi ride through the media blitz of Times Square pales in comparison to the information surfeit on the Internet and its digital and electronic spawn. Consumers today are bombarded with ever more information, ever faster and in ever smaller bits and bytes. Companies seek to make their marks flashier to catch attention, more interactive to keep it. Brand owners are increasingly flouting the conventional wisdom that trademark rights are best built by using the same presentation of a mark, without significant change, over and over. They are adopting fluid, interactive trademarks to engage and delight consumers.

Fluid marks often take on their own personalities, not unlike a celebrity endorser or character mascot who speaks for the brand. In her book *Dynamic Identities, How to Create a Living Brand*, graphic designer Irene van Nes explains:

Fifty years ago, a brand was just a single mark used for brand recognition, which set it apart from the rest. Now a brand has become a platform where like-minded people come together, and an experience that creates emotional attachment. Brands

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need to constantly adapt to their fast-changing environment in order to survive. Internet, social medial and technical revolutions have given brands the opportunity to behave like living organisms.¹

Conventional wisdom holds that a mark becomes stronger when used consistently over time, because the public then comes to recognize it as a signifier of source. (Frequency of use may now trump length of use in building brand recognition, as shown by the number of toddlers who already have strong brand preferences.) Yet no matter how desirable consistency and repetition may be from a trademark law perspective, those qualities rarely enliven conversation or vitalize relationships. For this reason, Jose Martinez Salmeron, Executive Creative Director at the advertising agency Ogilvy & Maher, provocatively, and persuasively, argues “If You Love Your Brand, Set It Free”: “Brands should nowadays give themselves permission to be more surprising, to flirt with their customers, to listen to what they have to say and to cater to their desires. A modern brand should take leaps of faith, abandon self-obsessions and embrace risk.”² If your brand fails to do so, he warns, it “could become irrelevant in a hurry.”³

Today’s branding professionals and the public at large have enthusiastically embraced fluid marks. And intellectual property lawyers will just have to adapt or they, too, could become irrelevant in a hurry.

II. WHAT IS A FLUID MARK?

Even if you have never heard of fluid marks, you have probably encountered them in the marketplace. They range from the ever-changing “doodles” on Google’s home page to the borzoi dog colophons on Alfred A. Knopf books. Picture the myriad artistic renditions of the Absolut vodka bottle that graced the brand’s advertisements for decades, the mutable Chiquita banana sticker (this morning, mine read: “Apply sticker to forehead. SmileTM”—and I smiled). MTV. AOL. This list goes on. All of these brands have exchanged static marks in favor of more dynamic presentations.

Because there are many different ways to create a dynamic brand identity, it is perhaps easiest to define a fluid mark by contrasting it to a conventional mark. People typically think of a trademark as a static, two-dimensional term (like APPLE) or

1. Irene van Ness, *Dynamic Identities, How to Create a Living Brand* 6 (2012).

2. Jose Martinez Salmeron, *If You Love Your Brand, Set It Free*, Smashing Magazine, Feb. 8, 2013, <http://www.smashingmagazine.com/2013/02/08/if-you-love-your-brand-set-it-free>.

3. *Id.*

design (like Apple's stylized apple logo).⁴ Of course, even such traditional trademarks get updated from time to time.⁵ Many owners of conventional marks display them in different presentations, or use different variants of their logo for different product lines. They may even adopt non-traditional moving image, sound, or color marks.⁶ None of these qualifies as a fluid mark if the brand owner's intent is to use the same mark, in the same format, for an extended period of time.

In all of these examples, the mark, traditional or not, remains constant for an extended period of time. In contrast, brand owners today are rejecting the notion that a trademark should be constant. Instead, they are embracing change as a built-in element of their marks. From the trademark law perspective, the lessons learned from traditional trademarks and their more familiar variations provide some guidance in navigating the largely unexplored territory of fluid marks.

III. THE IMPETUS FOR THE TREND

Fluid marks are a natural outgrowth of new media and information technology. As a 1998 article put it: "Like hyperactive children, Internet marks do anything they can to get attention. They move, sing, dance, undress, explode, and change. Internet marks cannot be static. If a mark fails to capture attention, Web

4. Trademarks are the modern equivalent of the ancient hallmarks used by silversmiths, chops by Asian artists and brands by ranchers. They function as a signature or, in trademark law terms, a "source identifier." Just as you would run into trouble signing your name differently each time you sign a check, brand owners can run into trouble if they present their trademarks differently at different times. For example, its trademark lawyers would cringe if the John Hancock Life Insurance Company (whose motto is "John Hancock—a name you know and trust") offered its services under the name JOHN on Monday, HANCOCK on Tuesday, J. HANCOCK on Wednesday, JOHN HANCOCK on Thursday and JH INSURANCE on Friday, each time in a different handwriting. A brand owner can certainly own more than one mark, but a mark is by definition a source identifier, and the public may not recognize a particular designation as a source identifier if the designation is not used repeatedly and consistently to identify the same source.

5. AUNT JEMIMA, BETTY CROCKER, and the American Airlines logo are just a few examples of design marks that have evolved considerably over the years. *See generally* Hal Morgan, *Symbols of America* (1987).

6. Non-traditional interactive trademarks are not such a cutting-edge trend any more. NBC registered its three-note chime as a trademark in 1950 (U.S. Reg. No. 523,616); more recent examples of sound marks include the roar of a Harley-Davidson bike (U.S. App. Serial No. 74/485,225, abandoned) and Tarzan's yell (U.S. Reg. No. 2,210,506). Children of all ages may enjoy the audio archive of registered sound marks at the USPTO's "Listen To Soundmarks" page on its website: <http://www.uspto.gov/kids/sound.html>.

The moving image sequences that identify Pixar and DreamWorks movies qualify for trademark protection. And at least two fragrances, a yarn that smells like plumeria blossoms (U.S. Reg. No. 1,639,129, cancelled) and a cherry-scented fuel exhaust (U.S. Reg. No. 2,463,044), may not have caught on in the marketplace but have been registered as U.S. trademarks.

surfers quickly move on.”⁷ Fluid trademarks reflect the information overload and hectic pace of our times.

Kevin Roberts, the CEO of ad agency Saatchi & Saatchi and the author of *Love Marks: The Future Beyond Brands*,⁸ characterizes consumers as “cynical, savvy, and selective”: “You have a famous brand? I couldn’t care less! You’ve got three seconds to impress me, to connect with me, to make me fall in love with your product.” According to Roberts, “You can plot any relationship—with a person, with a brand—by whether it’s based on love or based on respect. It used to be that a high respect rating would win. But these days, . . . [i]f I don’t love what you’re offering me, I’m not even interested.”⁹ Today’s marketers seek to create emotional connections between their products or services and their customers.

One way brands can connect with consumers is by abandoning the traditional view of a trademark as a two-dimensional symbol. “In the industrial age, a logo was just a signature. It should be a message,” comments Marc Gobé, President of Emotional Branding LLC and author of *Brandjam: Humanizing Brands Through Emotional Design* (2007).¹⁰ Fluid marks communicate. They invite consumers to interact, project and connect the dots. Fluid marks help develop long-term relationships (even love affairs) between consumers and their favorite brands.

IV. A TAXONOMY-IN-PROGRESS OF FLUID MARKS

Over the past five years, examples of fluid marks have proliferated. To advance the legal analysis and advise clients in this largely uncharted territory, it can be useful to have a taxonomy to identify different species of fluid marks. Here is my stab at it.

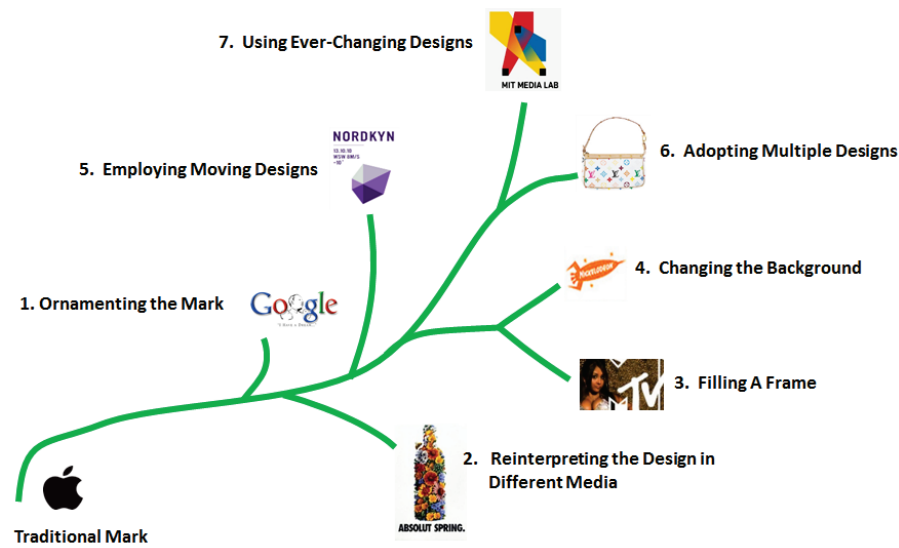
Some fluid marks are hybrids, exhibiting characteristics of more than one species. And given the fertile minds of creative professionals, it is inevitable that new species of fluid marks have been, or will soon be, discovered.

7. Erik W. Kahn, *On the Net, Unusual Marks Gain In Importance*, Nat’l L.J., Oct. 19, 1998, at C13.

8. Kevin Roberts, *Love Marks: The Future Beyond Brands* (2005).

9. Alan W. Webber, *Trust in the Future: When It Comes to Brand Management Kevin Roberts Says That Only Two Things Are Wrong: Brands and Management*, Fast Company Magazine, Aug. 31, 2000, <http://www.fastcompany.com/41364/trust-future>.

10. Valerie Seckler, *Fluid Brand IDs Are Wave of the Future*, Women’s Wear Daily, Apr. 11, 2007, available at <http://www.wwd.com/business-news/marketing-promotion/fluid-brand-ids-are-wave-of-the-future-500232>.



Let’s take a closer look at some fluid marks that exemplify each of these species and the trademark law issues they raise.

A. Ornamenting the Mark

Google, the quintessential information age brand, has used the bully pulpit of its home page to present its famous mark in countless variations representing virtually every known fluid mark species. But when Google first introduced its “doodles” as a regular feature in 2000, Google “doodlers” typically retained most of the basic elements of the Google word mark or logo and added ornamentation, as shown in the variants below:¹¹



Source: <http://www.google.com/doodles/finder/2000/All%20doodles>

The tweaked logos are often delightful, an “in” joke between the search engine and its users. They project Google’s exuberant, innovative brand identity.

11. See the whole collection at <http://www.google.com/doodles/>.

Similarly, in a moving image example, Cartoon Network Studios routinely animated its old logo by splicing in new footage of its characters:¹²



Source: <http://www.youtube.com/watch?v=I4tHvQVkJdE>

In these examples, the essential characteristics of the mark remain constant, but new matter has been added, typically for a limited period of time.

While their trademark lawyers may not like it, many brand owners ornament or partially obscure their marks from time to time. Packaging designers gussy up products for seasonal campaigns. Magazine art directors invade their mastheads with cover art. To minimize the legal risks of embellishing their marks in this manner, brand owners would be wise to focus on:

- Ensuring that the template for the fluid mark—the word or design mark, or both—is a strong, distinctive, and registered mark.
- Frequently displaying the template in its registered form.
- Obscuring as little of the mark as possible.
- Clearing new matter added to the template to ensure it does not infringe someone else's rights and to see whether the new matter itself qualifies for some form of intellectual property protection (most likely copyright).
- Assessing the context and physical location in which the mark is displayed. Google, for example, enjoys a home page advantage, in that visitors to Google.com readily associate

12. Steve Barnes, TV ARK, <http://www2.tv-ark.org.uk/channel4/2004.html> (last visited Nov. 26, 2014).

the fluid variants populating the same spot on its home page with Google as the source—even when the template is hidden in a Jackson Pollack homage or shown in Morse Code.

B. Reinterpreting the Mark in Different Media

Another common way to energize a mark is to reinterpret it in different media. One trendsetter was Absolut vodka, which adopted a brilliant marketing campaign in which artists and designers reinterpreted the now iconic shape of its bottle in scores of different images:¹³



Source: *www.absolutad.com*

New York City’s Museum of Arts and Design, for example, wanted a logo that “seemed inventive and surprising, and that could appear in different ways on different occasions” because “[t]he Museum, after all, is dedicated to artists who take typical forms—say, vessels, or chairs—and transform them over and over again.”¹⁴ Its design firm, Pentagram, proffered the following solution:

13. See <http://www.absolutad.com>. Amazon.com lists not one but two coffee table books on this topic (Richard Lewis’s *Absolut Book: The Absolut Vodka Advertising Story* (1996) and *Absolut Sequel: The Absolut Advertising Story Continues* (2005), as well as Carl Hamilton’s *Absolut: Biography of a Bottle* (2000)).

14. Lisa Strausfeld et al., *New Work: Museum of Arts and Design*, Pentagram Design, Inc. (Sept. 26, 2008), <http://new.pentagram.com/2008/09/new-work-museum-of-arts-and-de/>.



Source: <http://new.pentagram.com/2008/09/new-work-museum-of-arts-and-de>

In the United Kingdom, Channel 4's station identification spots have long recast its logo in different media and used Channel 4's own medium (television) to animate it.¹⁵



Source: <http://www2.tv-ark.org.uk/channel4/2004.html>

As long as the contours of the mark remain constant, this approach is quite similar to the common practice of presenting a mark in different colors and raises similar legal concerns. Obviously, Tiffany & Co. would compromise the strength of its distinctive color mark if it failed to use the same hue of blue consistently. Similarly, reinterpreting the mark in different media can weaken or destroy trade dress rights in any branding indicia that have been jettisoned.¹⁶

15. See Steve Barnes, TV ARK, <http://www2.tv-ark.org.uk/channel4/2004.html> (last visited Nov. 26, 2014).

16. Consider the charming and original brand identity created by Edhv for De Buitenwereld, a restaurant in a beautiful natural setting in the Netherlands (alas, no longer in operation). It employed stop action photography to show different seeds (grass, basil, radish) growing into a living logotype, as shown in the clips at Edhv, <http://www.edhv.nl/edhv/?tag=de-buitenwereld> (last visited Nov. 26, 2014). If the De Buitenwereld mark were reinterpreted in other, inert materials, the brand identity would lose a vital ingredient. Where the medium itself is a source-identifying element of the mark

In other situations, reinterpreting the mark in different media can actually bolster trade dress rights, particularly where the brand owner seeks to develop recognition for a distinctive logotype, shape, or form. The Absolut campaign was a brilliant way to develop the outline of the vodka bottle as a strong source identifier.

The take-aways? Before adopting a fluid mark of any species:

- Identify the distinctive, source-identifying elements of the mark that serve as pillars of the brand (word mark, typography, logo, color, sensory elements such as graphics or sounds, quirky characteristics).
- Strive to keep those pillars constant, although you don't necessarily have to employ every pillar every time the mark appears.
- Wherever possible, protect those pillars by registering them for trademark, copyright, design, or patent protection and using the appropriate legends or notices.
- Registering each variant of a fluid mark may not be legally or financially feasible, and the cost may outweigh the benefit. In jurisdictions such as the United States that do not require trademark or copyright registration to establish protectable rights, brand owners may choose to forgo the advantages of registration and rely on this safety net alone for the new matter in their different iterations.

C. Filling a Frame

Closely related to reinterpreting the mark in different media, filling a frame delineated by the outer contours of the mark is probably the most popular way to implement a fluid brand identity. What characterizes this species is a frame or three-dimensional container displaying different content in the same medium. By way of illustration, MTV recently adopted a new logo to reflect the fact that it no longer offers just "Music Television." It now fills the contours of the MTV logo with photographic images of its stars and content (presumably, after clearing all necessary rights).

(in this case, the live plants), it would be sensible to reinforce that brand identity and forego reinterpreting the mark in different media.



Source: <http://www.creativereview.co.uk/cr-blog/2010/february/mtv-refreshes-logo>

Melbourne, Australia, branded itself as a destination city with another logo template incorporating a distinctive “M.” The Lander firm designed this new identity to be as “as multifaceted as the city itself: creative, cultural, and sustainable. A celebration of diversity and personal interpretation that is both future-proof and iconic.”¹⁷



Source: <http://www.behance.net/gallery/City-of-Melbourne/276451>;
<http://landor.com/#!/work/case-studies/melbourne/>

17. *Melbourne: Designing A Flexible and Future Focused Image*, Lander Associates, LLC, <http://landor.com/#!/work/case-studies/melbourne> (last visited Nov. 26, 2014).

DC Comics also recently selected a transformative logo system based on its monogram.



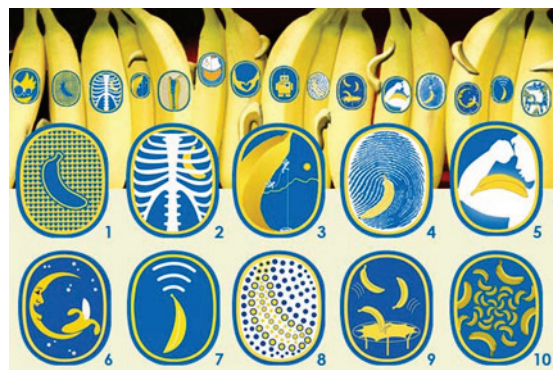
Source: www.landor.com/pdfs/cases/DCEntertainment-11June2012.pdf

The letter D, placed over the letter C, “peels back, reflecting the dual identities and depths of personality that are at the core of the characters” with different imagery filling the negative space within the letters.¹⁸

The foregoing examples all employ logotypes as the frame, but this approach can also work with a strong trade dress element. For example, in the United States, Chiquita Brands has developed strong consumer recognition for the iconic blue and yellow stickers on its bananas and, over twenty years ago, had the foresight to secure a U.S. trademark registration for its ovular sticker design (without words), which is now incontestable. In 2010, Chiquita deployed an interactive website and social media platforms to stage a contest challenging consumers to create new sticker designs for its bananas. Here are the winners chosen by a popular vote:¹⁹

18. *DC Entertainment: Revealing A Dual Identity*, Landor Associates, LLC, <http://www.landor.com/pdfs/cases/DCEntertainment-11June2012.pdf> (last visited Nov. 26, 2014).

19. Ivan Raszl, *Chiquita Banana Sticker Design Contest Winners*, Creativebits.org (Oct. 7, 2010), http://creativebits.org/inspiration/chiquita_banana_sticker_design_contest_winners.



Source: <http://www.slashfood.com/2010/09/29/chiquita-unveils-winning-sticker-design/>

Chiquita kept its brand relevant by trading top-down brand consistency for crowd-sourced brand variety. It encouraged consumers to make the brand their own. And, assuming it secured proper transfers of rights or consents from contestants, Chiquita made a lot of people smile with no apparent damage to its trademark rights.

D. Changing the Background

The flip side to filling a frame is changing the background. The following two examples demonstrate how to do it really well, and how to do it even better.

Children of all ages were desolate when the television network Nickelodeon retired its shape-shifting orange “splat” logo, shown below:



Source: <http://fredalan.org/post/69174412/the-nickelodeon-logo-designed-by-tom-corey-scott>

According to the Fred/Alan Agency, which takes credit for developing this concept way back in 1984: “Movement was the way to go, constant change made for an energetic network, and kids were the most vital force in the world. Give them something they relate to: change. . . . [O]range generally clashed with everything and that would make the logo stand out. . . . The splat could morph into any image we liked.”²⁰

This early fluid branding initiative successfully capitalized on Nickelodeon’s strong word mark and signature color, took full advantage of the television medium with moving image variants, and led to the creation of one of the most entertaining trademark style guides ever.²¹ Just one quibble: Nickelodeon could have presented its word mark in consistent typography without sacrificing any of the fun.

AOL adopted a fluid identity of the same species when it split away from parent Time-Warner in 2009. With the aim of communicating its newly articulated mission to inform, entertain, and connect the world with more original content than its competitors, AOL chose a new “invisible” logo mark, in which the mark appears as negative space juxtaposed against different content.



Source: <http://www.wolffolins.com/work/aol>

Wolf Olins, the design firm, described its first set of AOL logo variants as a starter set, with the idea that the background content could come from any source, including users eager to

20. Fred Siebert, *The Nickelodeon logo, designed by Tom Corey & Scott Nash*, The Fred/Alan Archive, <http://fredalan.org/post/69174412/the-nickelodeon-logo-designed-by-tom-corey-scott> (last visited Nov. 26, 2014).

21. Fred Siebert, *Nickelodeon Logo Logic* (June 7, 2008), <http://www.scribd.com/doc/3262900/Nickelodeon-Logo-Logic>.

create their own customized AOL logos.²² AOL's home page now permits users to customize their screens with their favorite logo art.

According to AOL, though, "It's not about it being 1000 logos . . . it's a consistent wordmark that's consistent and clean."²³ In fact, AOL's fluid branding presents as constant pillars both a word mark and a particular design presentation of that word mark, thereby building recognition for and rights in two brand pillars notwithstanding the changing background scenery. A lesson learned.

E. Employing Moving Designs

There is a new species of fluid mark in which technologically enabled moving images replace conventional logos. They differ from the moving image clips that are currently registrable as trademarks in the United States because they change all of the time and do not feature consistent content with a fixed beginning and end.

One beautiful example of a fluid moving design is the spinning icon designed for Visit Nordkyn, a tourist site for two Norwegian municipalities "as far North as you can go on Europe's mainland." Neue Design Studio developed two trademark assets: the tagline "Where nature rules" and a faceted logo form that changes when the wind or temperature changes.



Source: http://www.underconsideration.com/brandnew/archives/where_the_cold_wind_blows.php

22. Alissa Walker, *Exclusive Interview: Wolf Olins and AOL on Why AOL's New Brand Is from the Future* (Dec. 10, 2009, 1:45 am), <http://www.fastcompany.com/1483322/exclusive-interview-wolff-olins-and-aol-why-aols-new-brand-future>.

23. *Id.*

The website visitnordkyn.com automatically updates the logo every five minutes based on a feed of weather statistics from the Norwegian Meteorological Institutes.²⁴

Olo, which offers wireless Internet in emerging markets, quite literally permits users to play with its mark. Taking good advantage of new multi-touch technology and custom software, Olo encourages users to entertain themselves by manipulating the logo on their smartphones and tablets.



Source: <http://www.bibliothequedesign.com/projects/branding/ollo/>

According to its creators, Olo's flexible branding system has the potential to create "an infinite number of digital assets."²⁵

The trade dress of these two moving logos certainly seems distinctive and strong enough to warrant protection. But, it would be a nightmare to try to register these moving logos as such under

24. *Where the Cold Wind Blows*, http://www.underconsideration.com/brandnew/archives/where_the_cold_wind_blows.php (last visited Nov. 26, 2014).

25. <http://www.bibliothequedesign.com/projects/branding/ollo/> (last visited Nov. 26, 2014).

the current U.S. trademark rules; it is hard enough to register a straightforward moving image mark that does not mutate. This is one area where it would make good sense to re-examine the rules.

In the meantime, assuming the fluid moving logo will be in widespread use in the United States, the best bet would be to rely upon common law trademark rights, unfair competition, and the broad prohibitions of Section 43(a) of the Lanham Act, which protect unregistered source identifiers against uses likely to create confusion, mistake, or deception. U.S. copyright law (for original artwork, animations, or software), or patent law (for novel technological inventions) might also provide some measure of protection.

F. Adopting Multiple Designs

In some cases, fluidity can be achieved by owning a relatively small nuclear family of design marks. For example, Louis Vuitton has recast its classic LV toile monogram in new presentations created by fashion designer Marc Jacobs and artist Takashi Murakami, among others, and a number of these new variant patterns, such as the cherry-strewn and multicolored designs, have become so popular that they, too, function as traditional trademarks in their own right. What may have started out as an example of ornamenting a mark has now become a valuable portfolio of LV marks.

Because the variants are relatively few in number, and because their owner has a deep pocketbook, each separate Louis Vuitton variant could easily be registered as a trademark to shore up its protection.

This strategy may also work for other brand owners who use a small family of marks to effectuate their dynamic brand identities. For example, the Casa da Música in Porto, Portugal, has a series of logos inspired by different views of its unique modern building designed by architect Rem Koolhaas, which it also recasts in different colors:²⁶

26. Sagmeister & Walsh, *Casa da Música Identity*, <http://www.sagmeisterwalsh.com/work/project/casa-da-musica-identity/> (last visited Nov. 26, 2014).



Source: http://www.underconsideration.com/brandnew/archives/the_17_sides_of_a_cultural_id.php

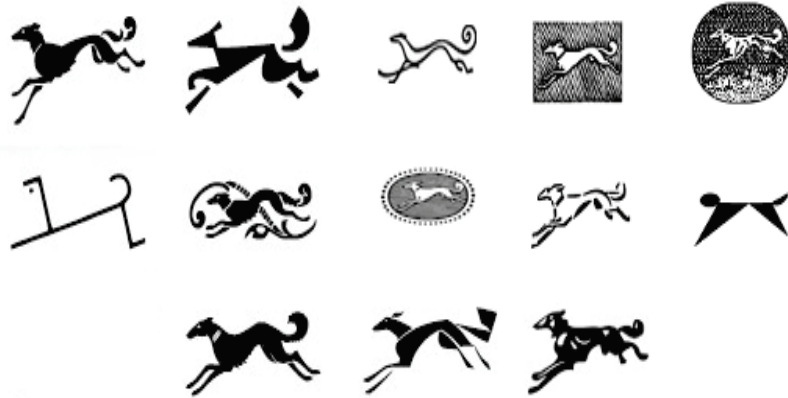
For fluid mark initiatives based upon a manageable number of design variants, it is worthwhile to consider registering each different logo as a separate mark, which would provide better protection than registering a single family member or the family as a group. Also note that both the Louis Vuitton and Casa di Música marks include copyrightable subject matter contributed by well-known creators, underscoring the need to obtain a consent or, even better, a work for hire agreement (if available)²⁷ or written transfer of rights in any such contributions.

G. Using Ever-Changing Designs

The real brainteasers for intellectual property lawyers are trademarks conceptualized as ever-changing. In addition to the Ollo moving design discussed above, consider the following old and new media exemplars:

27. A work made for hire arises under U.S. Copyright law where: (i) the work is created by an employee within the scope of his or her employment; or (ii) the work is specially ordered or commissioned, fits in one of nine categories enumerated in the statute, and the parties agree in a signed writing that the work is a work made for hire. The nine categories include, *inter alia*, a contribution to a collective work, part of a motion picture or other audiovisual work, and a compilation. 17 U.S.C. § 101. Certain logos or designs may qualify as a "contribution to a collective work" if, for example, they were created as a contribution to a website or an overall branding concept incorporated into a brand book to which others contributed. A website might also qualify as an audiovisual work.

- I read my fair share of Knopf books before realizing that its borzoi colophon is a fluid mark: “For every single kind of book Knopf publishes, it seems we have a matching borzoi: minimalist borzois, ornate borzois, borzois with toques. We never get tired of looking through all of them.”²⁸



Source: <http://knopfdoubleday.com/design-a-borzoi-contest>

- Venerable department store Saks Fifth Avenue adopted an award-winning branding initiative that transforms its classic script logo into a striking new graphic image that can be reshuffled endlessly like the ultimate jumble square game.²⁹

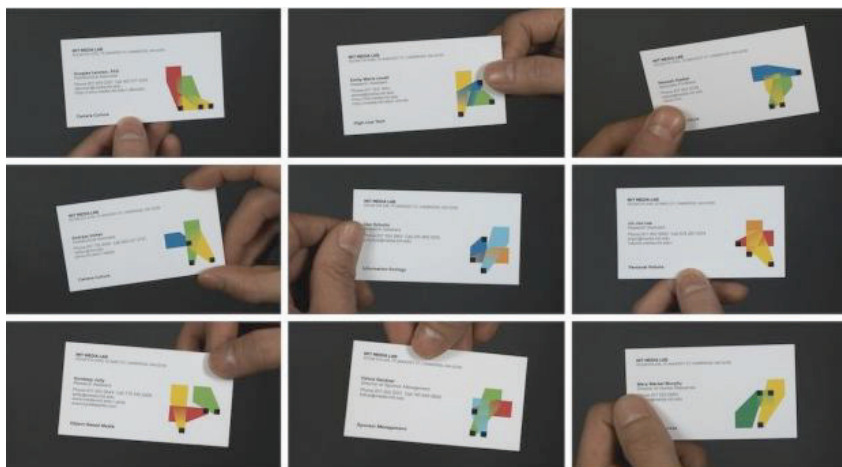


Source: <http://www.pentagram.com/work/#/all/all/newest/223>

28. *Design A Borzoi Contest*, <http://knopfdoubleday.com/design-a-borzoi-contest> (last visited Nov. 26, 2014).

29. Michael Bierut, *New Work: Saks Fifth Avenue*, Pentagram Associates LLC (Sept. 19, 2006), <http://new.pentagram.com/2006/12/new-work-saks-fifth-avenue>.

- MIT Media Lab permits each of its constituents to create his or her own signature logo:



Source: <http://www.creativeapplications.net/processing/mit-media-lab-identity-processing/>

According to its designers, “[t]he new visual identity of the MIT Media Lab is inspired by the community it comprises: Highly creative people from all kinds of backgrounds come together, inspire each other and collaboratively develop a vision of the future. . . .The logo is based on a visual system, an algorithm that produces a unique logo for each person, for faculty, staff and students.”³⁰

Perhaps Knopf could enhance its legal position by using and registering BORZOI as a word mark and taking the position that its design marks are the visual equivalents. Perhaps Saks could register the different graphics on, say, three different size shopping bags as separate marks, and claim protection for a family of marks. Perhaps MIT Media Lab could obtain a color mark registration for the color elements of its visual identity if it did not try to capture the rainbow.

None of these suggestions provides a perfect solution. As trade dress becomes ever more important as a brand identifier, we simply need to come up with some better ways to protect it and, in the meantime, do the best we can with current trademark law and other available IP protection.

30. Richard The, <http://www.richardthe.com/medialab/> (last visited Nov. 26, 2014).

V. BEST PRACTICES

Although the dynamic brand identity trend does have the potential to jeopardize trademark protection, there are ways to use fluid marks to strengthen trademark rights, rather than destroy them. While statutes, cases, rules, and regulations are preternaturally silent on fluid marks, here are some best practices:

1. *Start with a strong mark.* The most suitable marks for use as templates for fluid marks are strong, established marks with a history of use and strong consumer recognition. That way the public will understand the variant as a play on the underlying mark, enhancing the fame and strength of the original.

2. *Register the underlying mark.* Ideally, the underlying mark should be registered. That official certificate can be particularly useful in this context because the interactivity of fluid marks invites others to come up with their own creative iterations. It may not be necessary to register each variant of a fluid mark, but this should be considered on a case by case basis.

3. *Continue to use the underlying mark.* Regardless of whether or not it is registered, the underlying mark should continue to be used. Ongoing use of the underlying mark will keep it alive and avert litigation as to whether it has been abandoned.³¹ It will also establish that the brand owner's priority dates back to its first use of the underlying mark (or the date it filed an application to register the mark, if the application was filed on the basis of an intent to use), rather than first use of the new variant.

4. *Keep brand pillars constant.* Be fluid, be nimble—but don't be random. The new presentations of the mark should respect the pillars of the brand and retain the basic characteristics of the underlying mark in order to strengthen consumer recognition of the mark and its enforceability. For example, Absolut's ad campaigns created widespread recognition of the vodka bottle's distinctive shape, thereby strengthening the protectability of the bottle as trade dress.³² Chiquita's crowd-sourced banana labels similarly reinforced its trade dress rights by maintaining the same contours, borders, colors, and placement on the banana as its usual sticker.

5. *Adopt a signature style.* It also makes good sense to be "fluid" in a signature style. Fluid trademarks that are recognizable

31. Under the Lanham Act, a mark is presumed abandoned after three years of non-use, and in order to hold onto its rights the owner must prove that it always intended to resume use of the mark. 15 U.S.C. § 1127.

32. Where a mark is presented in mutating forms, this may be useful in proving infringement against a broader array of non-identical marks because the public is not conditioned to expect to see the mark in the exact same presentation every time. By analogy, a brand owner who uses parody in its own marketing campaign may have an easier time stopping unwanted parodies because the public is more likely to be confused as to whether the parody was authorized.

riffs on the same underlying mark can enhance the strength of the underlying mark rather than undermine it. For example, if Disney decided to give Mickey Mouse a well-deserved rest as a logo and offer some of its other characters their fifteen minutes of fame, it could design a uniform frame for each of the character's portraits and couple it with the DISNEY house mark. Disney might thereby enhance trademark protection for the mothballed characters and establish additional intellectual property rights in its new presentations.

6. *Protect new IP rights.* This is an important point. The new matter in each variant of a fluid trademark may be protectable under trademark or copyright law in its own right. As previously mentioned, Louis Vuitton reinvigorated its brand when it started recasting its classic LV toile monogram in new presentations, including artist Takashi Murakami's reinterpretation of the monogram in 33 bright colors. Dooney & Bourke, an American handbag company with its own signature logo, found itself on the wrong side of a protracted federal trademark infringement suit when it started selling its It-Bag collection, with bags featuring its DB monogram in a similar multicolored array.³³ And U.S. copyright law protects the new and original artwork with which Google decorates its logo even if that artwork is not used often enough to function as a source identifier in itself.³⁴

33. *Louis Vuitton Malletier v. Dooney & Bourke, Inc.*, 340 F. Supp. 2d 415 (S.D.N.Y. 2004), *aff'd in part, vacated in part*, 454 F.3d 109 (2d Cir. 2006), *on remand sub nom.*, *Malletier v. Dooney & Bourke, Inc.*, 500 F. Supp. 2d 276 (S.D.N.Y. 2007). Dooney & Bourke ultimately won, but after four years of expensive litigation.

In April 2004, Louis Vuitton sued Dooney & Bourke for trade dress infringement and dilution based upon its common law rights in the multi-colored pattern and filed a preliminary injunction motion. After a seven-day hearing, the district court denied preliminary injunctive relief, finding that while the multi-colored design was sufficiently distinctive to qualify for protection, the patterns of the parties' respective bags were not confusingly similar. Louis Vuitton appealed, and the Second Circuit affirmed in part and vacated in part this trial court ruling. Louis Vuitton then abandoned its motion for preliminary relief to pursue a full pre-trial and trial. At the conclusion of fact and expert discovery, Dooney & Bourke moved for summary judgment dismissing all claims. The district court granted that motion on May 28, 2008, finding, *inter alia*, that the designs were not confusingly similar and Dooney & Bourke's bags prominently bore its own registered mark. *Louis Vuitton Malletier v. Dooney & Bourke, Inc.*, 561 F. Supp. 2d 368 (S.D.N.Y. 2008).

34. Under U.S. copyright law, the mere act of reducing a copyrightable work to a tangible medium of expression—putting pen to paper, so to speak—triggers protection. The copyright automatically springs into existence, without further formalities. Nevertheless, obtaining registration and affixing a copyright notice to the work dramatically enhances the protection accorded to it and the remedies available for infringement. If a copyright application is filed within five years of publication, the registration certificate will be *prima facie* evidence in court of the validity of the copyright and of the facts stated in the certificate, including the copyright owner. Registration prior to infringement of the work, or within three months of the work's publication, entitles the copyright owner to seek statutory damages and attorneys' fees. Absent timely registration, the copyright owner can recover only actual damages and/or the infringer's profits, which can be difficult to prove in many

7. *Clear new matter.* Conversely, the new matter in a variant may violate someone else's rights. Edvard Munch, if living, might not be amused to see "The Scream" recast as a Google logo—as it was for his birthday on December 12, 2006. (It is hard to tell from his work whether or not he had a good sense of humor.) In this example, the painting was presumably in the public domain, but a more recent painting might not be.³⁵

8. *Be prepared.* Fluid trademarks invite people to engage, and they probably will. Be prepared for fan use and parody.³⁶ Imitation may be the sincerest form of flattery, but it may also be an infringement. Too much infringement is never a good thing. Terms of use, such as those posted at Google's website, may check some abuse. Many brand owners try to corral the energy and creativity of their fans by providing an authorized forum for submissions (Google and Absolut have both sponsored official contests).

9. *Enforce strategically.* Brand owners need to consider how vigorously they want to police and enforce their marks in this context because they risk alienating their most loyal customers. Word demand letters carefully and, should litigation be perceived necessary to curb abuse, pick the right test case. Otherwise, this marketing strategy may backfire and permanently singe the brand.

10. *Teamwork.* Fluid marks offer unique opportunities for brand owners to deepen and broaden the emotional connections between their brands and consumers. Fluid marks also present unique risks from a trademark law perspective and therefore require strong brand stewardship. Designers, brand managers and intellectual property lawyers should work hand in hand from conceptualization of the fluid mark through the clearance, adoption, use, possible registration, policing and enforcement of each iteration. Their common goals should be to do no harm, have some fun, and, by doing it right, enhance both the brand owner's intellectual property portfolio and the appeal of its brand.

cases. In addition, registration is a requirement for bringing a suit for infringement of a work first published in the United States. 17 U.S.C. § 101.

35. Shortly before the Munch birthday tribute, Google posted a logo that was a similar tribute to artist Joan Miro and received a demand letter from the Artists Rights Society (ARS) on behalf of his estate. ARS President Theodore Feder reportedly said the Miro family was concerned over what they viewed as a violation of copyright and "moral rights." Google responded by taking down the image promptly. Mr. Feder remarked: "A lot of the problems could have been alleviated if Google had informed the family first. . . . But I'm not saying the family would have agreed to it." Anton Gonsalves, *Google Angers Artist's Family In Latest Copyright Flap*, Information Week, (April 21, 2006), available at <http://www.informationweek.com/google-angers-artists-family-in-latest-copyright-flap/d/d-id/1042475>.

36. See, e.g., the collection of Absolut ad spoofs at http://absolutad.com/absolut_gallery/spoofs (last visited Nov. 26, 2014).

VI. CONCLUSION

The design blog Zeroside offers this compelling insight: “Designing a fluid identity can help bring that needed awareness to an organization, but it shouldn’t be a gimmick at heart. This way of thinking about identity design only works when it’s an outgrowth of the brand’s distinctive DNA. . . . Some brands might need to show diversity of service or product, while others see flexibility as a crucial competitive advantage, and other organizations have evolution written into their foundations.”³⁷

From a legal perspective, fluid marks can be as hard to corral as mercury. A brand owner who presents a weak mark in myriad presentations runs the risk of diluting or genericizing it. One who fails to use a mark risks abandoning it. And one who flits from one presentation of a mark to another misses the opportunity to build consumer recognition and enforceable trademark rights in more components of the brand’s DNA.

For these reasons, in exploring the brave new world of dynamic brand identities and fluid marks, brand owners and their counsel must always consider the pillars of the brand and take precautions not to undermine them.

37. *The Future Is Fluid: Inside Dynamic Logos*, Hexanine, LLC (March 9, 2011), <http://www.hexanine.com/zeroside/the-future-is-fluid-inside-dynamic-logos>.