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Passing fad or trend for the future?

It is highly likely that fluid marks will become the subject of IP disputes in the near future. Accordingly, brand owners should consider what combinations of IP right they may be able to use in order to protect them

Fluid trademarks are marks which comprise various permutations that enhance the scope of consumer recognition in the marketplace. Such marks are most often seen in respect of either well-known or relatively unknown marks. Well-known marks which have strong brand recognition can withstand slight changes without any resulting consumer confusion, loss of recognition or loss of trademark rights in the amended representations. Relatively unknown marks are not usually commercialised to a significant extent; as a result, slight amendments to the brand have no substantial negative impact. However, caution should be applied to using marks which are capable of becoming generic as fluid trademarks, since presenting the mark in numerous permutations could potentially accelerate the process by which they actually do become generic in the minds of the relevant consumers.

Despite these associated risks, fluid trademarks are rapidly being adopted by many innovative companies. Fluid trademarks are eye-catching and memorable, and incite consumers to engage actively – all of which are positive qualities for any brand developer.

However, a company which is considering using a fluid mark should assess whether such use will be a positive step for the brand in question from both a commercial and a trademark law perspective. It is essential to begin with a strong brand and educate the public with respect to this brand before developing any associated fluid marks.

Conventional wisdom dictates that amending marks through the use of fluid marks will inevitably undermine the distinctiveness of the brand in question, eventually making it weaker rather than stronger. However, evidence from rights

holders which have used fluid marks may indicate otherwise. Representative examples include Absolut Vodka in connection with the shape of its bottle in various different forms and colours and Perrier in relation to the temporary replacement of its name with the words 'Sexier', 'Crazier', 'Flirtier' and 'Sassier' in its signature script. Further, Google has been altering its logo on its website over a period of many years, featuring doodles drawn by competition winners, artistic interpretations and even reflections of world events and memorable anniversaries. In so doing, rights holders are increasingly implementing variations to their existing trademarks, creating a number of different versions in order to keep customers interested and improve their appeal.

Protecting fluid trademarks

Fluid marks which have a short lifespan do not typically warrant protection as registered trademarks, since in these situations registration is most probably neither practical nor economical. However, for rights holders which intend to use fluid versions of their marks in the longer term, it is undoubtedly in their best interests to register such permutations in order to prevent unauthorised third-party use of such marks. Should a rights holder use multiple variations of its main trademarks without the necessary associated protection through trademark registration, then in the event that a third party uses a trademark that resembles any of these variations, the rights holder may well be left without a remedy.

UK registration procedure

It is important to have a clear internal process for the selection of fluid marks. Potential rights holders should ensure

that proposed marks perform the essential trademark function and have distinctive character. Registration is not possible for generic or descriptive marks with no distinctive character. However, descriptive marks may acquire distinctiveness through use in order to secure registration, although this requires the requisite evidence of use over an extended period of time. In situations where a rights holder intends to use a fluid trademark for only a limited period, gathering the necessary evidence of acquired distinctiveness may well prove difficult.

While the United Kingdom no longer considers trademark applications on relative grounds during examination, once a trademark is published, it may be opposed by third parties which own prior rights in either trademarks, designs or copyright. Accordingly, it is important for any potential applicant to conduct clearance searches before filing in order to identify whether there could be any challenges to registration. Further, consideration must be given to the actual marketplace in the event that the applicant could be adopting a fluid mark that may give rise to a claim of infringement.

Since trademark protection is jurisdictional by nature, a potential applicant will need to register each fluid mark in the jurisdiction that is important to its business. Once a mark has been registered in the United Kingdom, it should also be registered with Customs and brought to the attention of trading standards authorities, so that they can identify and seize counterfeit products either at the border or during visits to businesses selling counterfeit goods. A trademark applicant may well want to file for a Community trademark registration in order to protect its mark with customs authorities throughout the European Union.

Potential for revocation for non-use

A primary concern for a rights holder which uses a fluid mark more often than its house mark is that the house mark could become vulnerable to revocation for non-use, unless it is also used regularly in its original form. Accordingly, the rights holder should ensure that it does not lose its house mark through revocation by ensuring that it uses it consistently in association with the goods or services covered by the registration in question.

UK registered designs

A rights holder which is using a fluid mark comprised of a device element should consider protecting the device as a UK registered design.

Designs may be protected if they:

- are novel (ie, no identical design has been made available to the public); and
- have individual character – namely, that an informed user would not consider the design in question to create the same overall impression as another design.

In many situations, protection as a UK registered design may well provide a valuable form of protection for a fluid mark comprised of a device element, since the registration process is relatively fast and incurs no significant costs. This further allows for the possibility of protecting numerous fluid marks on a regular basis. However, care must be taken to ensure that the design in question satisfies the above-referenced registration criteria, particularly with respect to ensuring individual character which is different from earlier third-party trademarks.

Copyright

Fluid trademarks comprised of original artistic device elements may potentially also enjoy protection under copyright law. The Copyright Designs and Patents Act 1988 provides protection for works in which copyright subsists in the United Kingdom; the protection afforded to artistic works would be applicable to such fluid trademarks. The United Kingdom does not have a formal registration process for protecting copyright works; instead, rights are considered to subsist in a work on creation once it has been rendered into a tangible form. Despite the absence of a registration process, a rights holder can take certain measures in order to ensure that copyright in its fluid trademark is protected. Where applicable, the rights holder should, make an appropriate assertion of its IP rights and keep detailed records

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of the process of creating the design in question in order to support possible future enforcement.

Conclusion

In recent years the use of fluid trademarks has increased significantly. While there are numerous unresolved issues with regard to the scope of their protection and enforcement, it is highly likely that such rights will become the subject of IP disputes in the near future. Accordingly, rights holders should consider what combinations of IP right they may be able to use in order to protect such rights and be sensitive to the potential impact that fluid trademarks may have on their core brands. [WTR](#)