

# The changing dynamics of fluid trademarks

**Manisha Singh and Santa Bathla of LexOrbis investigate the use of fluid trademarks: what they are, how best to use them, and how to protect them to maximise your brand's success.**

In today's rapidly growing markets consumers are becoming increasingly aware and their behaviour and perception towards businesses and brands is rapidly evolving. To keep up with constantly changing trends in the market, brands need to focus on innovation and creativity to keep consumers from losing interest in them. Moreover, brands need to communicate and engage with their consumers in a more innovative and eye-catching manner in order to survive in this fast-changing and ever-evolving environment.

With the Internet becoming the new marketplace for all commodities, companies and brands have amplified their presence online to attract consumers and expand their business. For many years, big brands have been using their established and well-known trademarks in a static manner, however, the advent of technology has forced a wave upon these companies to adapt to new trends and display their existing brands with a fresh appearance in an attempt to build or improve consumer interest and strengthen brand loyalty.

This method of adapting an existing trademark to be portrayed in a new and similar manner is a concept called 'Fluid Trademarks'. While fluid marks have not been defined under the Indian Trade Marks Act, 1999, they currently exist in an unconventional manner as elaborated by way of examples in the latter part of this article.

## What is a fluid trademark?

To understand fluid trademarks, we must recognize the need of companies to evolve their existing brands along with the short-term attention span of the everyday consumer. Fluid marks are usually logos that can be changed by using a combination of different colors, adding movements, or combining different kinds of images to make it look attractive yet identifiable for the digital world.

These marks involve creativity and adopting



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different, colorful variations of a particular trademark. Thus, a Fluid Trademark will typically contain the features of the original mark, however, it will include new design elements.

Such marks, known as living marks, are different from other marks since their key characteristic is that they keep changing from time to time. However, these marks are based on existing well-known marks and are only variations of the same existing mark.

From a business and marketing point of view, fluid trademarks are an advantageous tool to draw the attention of the consumer as their creativity and freshness is likely to be received by consumers in a different way.

While the advantages of fluid marks outweigh the disadvantages, it is worth mentioning that fluid marks should only be exercised by well-established brands who have obtained a strong brand identity with their original trademark. For smaller businesses whose brands have not been well established, there is a high risk of diluting the original trademark and ultimately confusing the consumer.

For years, the conventional school-of-thought for trademarks has been to use the same presentation of the mark, over and over without significant change.

## Examples of fluid trademarks

The most common and notable example of fluid trademarks is the "Google Doodle", which adopts a new appearance including font, color, and style on many international festivals, landmark dates and/or events. For example, on a given holiday such as Christmas, Google will adopt a red, white, and green color scheme along with animations of snowfall, figures of Santa etc., to display its well-known trademark. Google adopted another such fluid mark on India's 74th Independence Day, which incorporated several cultural elements of India, as can be seen overleaf:





## Résumés

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Manisha overviews and supervises all practice groups at the firm. Manisha is known and respected for her deep expertise on prosecution and enforcement of all forms of IP rights and for strategizing and managing global patents, trademarks, and designs portfolios of large global and domestic companies. Her keen interest in using and deploying latest technology tools and processes has immensely helped the firm to develop efficient IP service delivery models and to provide best-in-the-class services. She is also known for her sharp litigation and negotiation skills for both IP and non-IP litigations and dispute resolution. She has been involved and successfully resolved various trademarks, copyright, and design infringement and passing off cases in shortest possible time and in most cost-efficient manner applying out-of-box strategies and thinking.

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Sanat specializes in trademarks law for national and International clients. He concentrates his practice on brand adoption, protection, launch risks, prosecution, maintenance, brand conflict resolution and general advisory on trademarks and copyrights. He also advises clients on brand protection strategies in the digital sphere and curiously follows International IP developments to stay one step ahead.

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We must recognize the need of companies to evolve.”



Such marks have become increasingly popular and create engagement with the consumer as well as refresh the identity of the mark in the minds of the digital audience.

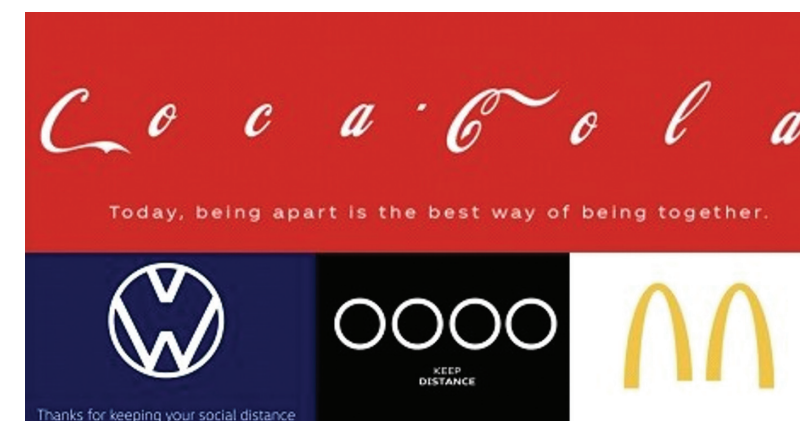
While many other market players have recently adopted Fluid marks, one particular brand has replaced its own word mark while using fluid marks. PERRIER, the famous sparkling water brand, launched a campaign in the year 2006, wherein it used words ending with the suffix “ier” such as “crazier”, “scarier”, “prettier” and “riskier”. However, the main brand name PERRIER remained identifiable despite the word change, due to the words appearing on the well-known label and bottle.

During the Covid-19 pandemic particularly, several brands have adopted fluid marks to convey the message of social distancing and wearing masks. For example, in India, Subway incorporated a face mask on the SUBWAY logo as shown below:

Other companies in India such as Zomato, MakeMyTrip redBus, Radio Mirchi, and Indian state-owned Coal Mining and refinery company, Coal India, also participated in this wave of adopting fluid marks to convey the message of wearing masks to their consumers, as can be seen in the next column;



Similarly, on a global level, big brands like McDonald's, Coca-Cola, Burger King, Nike, and more have adopted new and creative variants to their established trademarks to communicate better with their consumers as shown below:



Despite the notable and popular examples mentioned above, fluid trademarks are a relatively new phenomenon and are not defined under the Trade Marks Act, 1999 or in any international regulation or treaty.

### Challenges with fluid trademarks

While these established brands may use fluid marks as an efficient marketing strategy to draw attention of their customers, new businesses and brands, however, may not find this method of using a trademark as advantageous. This is because using a new manner of representing one mark which may depart from its original identity, can be risky. Hence, a brand that has not yet been properly established in the minds of the public is likely to confuse the consumer about the original trademark of the brand.

Keeping in mind the trademark law principles, fluid trademarks need to be carefully controlled, as an ever-changing mark may lead to weakening or destruction of the identity of that trademark, thereby increasing the risk of dilution. In addition to this, a constant change of representation of a mark is likely to face challenges in building brand recognition as well as any enforceable rights in additional elements of the brand identity. Thus, brand owners and their counsels should consider the pillars of their brand identity and



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which incorporated several cultural elements.”

be careful when adopting or adding new elements to their brand logos.

### Protection of fluid trademarks

Under the UK trademark law, an application can be filed as a series of marks. 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” Moreover, a European Court of Justice, in *Rintisch v Eder (C-553/11)*, has held that, “a rights holder was not precluded from relying on use in a different form from that in which the trade mark had been registered, provided the differences between the two forms did not alter the distinctive character of the mark.”

In another such case, the European Court of Justice was of the opinion 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 trade mark, it must continue to be perceived as an indicating origin for the use to qualify as genuine.”<sup>1</sup>

While the legal scenario on Fluid Marks is still not defined, an excellent example regarding the enforcement of fluid marks in the United States is that of *Louis Vuitton Malletier v Dooney Burke*, wherein the plaintiff produced a series of handbags featuring their signature toile monogram mark in 33 bright colors on a white or black background. The defendant subsequently launched its own series of handbags featuring the monogram “DB” in a variety of bright colors, similar to that of Louis Vuitton.

As a result, on appeal, the United States Court of Appeal for the Second Circuit, held that Louis Vuitton's multicolored monogram pattern mark was original in the handbag market, and thus it was inherently distinctive and had acquired secondary meaning, and was therefore protectable.

With regard to the Indian Trade Marks Law, it may be mentioned that although there is no explicit provision under the Trade Marks Act, 1999 to provide protection to fluid marks, Section 55 of the Trade Marks Act, 1999 reads as below:

**“Use of one of associated or substantially identical trade marks equivalent to use of another –**

(1) Where under the provisions of this Act, use of a registered trade mark is required to be proved for any purpose, the tribunal may, if and, so far as it shall think right, accept use of a registered associated trade mark, or of the trade mark with additions or alterations not substantially affecting its identity, as an equivalent for the use required to be proved.”

<sup>1</sup> E 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>2</sup> <https://indiankanoon.org/doc/1281255/>

The above provision of the Trade Marks Act, 1999 may be interpreted as providing protection to a variant of a registered trademark consisting of additions or alteration, however, it is important that the same does not substantially affect the identity of the registered trademark.

Thus, when applying this provision to the examples mentioned above, it may be possible to argue, on a case-to-case basis, that the identity of the underlying trademark has been retained while adding additional elements to make a fluid trademark, the use of which should be accepted as the use of the registered trademark. However, it is yet to be seen how the relevant Tribunals or High Courts interpret this provision when dealing with fluid trademarks in India.

### Conclusion

In addition to the above, although there is currently little or no legislation on protection of fluid marks both on an international and on a national level, the position on the protection of creation and use of the new variants of an existing trademark is regularly evolving and developing. Accordingly, such practices amounting to use of a mark as a fluid mark is likely to be recognized by the Courts under the provisions of Trade Marks Laws.

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Having said the above, there are also ways to use fluid trademarks that will increase trademark rights rather than weakening them, if adopted correctly. Since fluid trademarks consist of recognisable elements of the original trademark, they are likely to enhance consumers recognition as long as the underlying mark has established a strong brand presence with consumers.

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