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**IN AN ERA OF NON-TRADITIONAL MARKS: THE POSSIBILITIES OF  
TRADEMARKING A SPORTSPERSONS' CELEBRATORY MOVE**

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**ABSTRACT**

Sports celebrations are moments of victory. They are characterised by victory dances and signature celebratory moves by sportspersons, which then dominate our screens and papers. These moves often contribute to building a sportsperson's brand among the masses, which in today's consumer-centric world, is extremely important for a player to secure his mark with the public. However, it has been debated whether the signature moves of sportspersons can be protected under trademark law.

This paper explores the extent to which it is possible to trademark a sportspersons' signature move under trademark laws both internationally and domestically. The paper touches upon an understanding of the types of non-traditional marks under trademark law and then undertakes an analysis of the importance of trademarks in sports. Building upon this base, the paper then delves into the need for registering a celebratory move of a sportsperson as a trademark and the possibilities of it.

The three requirements of graphical representation, distinctiveness and indication of source or origin are analysed in regards to the challenges of obtaining a trademark registration for a sportspersons' celebratory move. The paper lastly argues through an analysis of the various unconventional marks protected under trademark law that a signature or a celebratory move by a sportsperson has all the possibilities to be afforded protection as a trademark.

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## **I. LITERATURE REVIEW**

Joshua A. Crawford's 'Trademark Rights for Signature Touchdown Dances' was referred to. The paper talks about how the signature touchdown danced of NFL (National Football League) players can be protected under trademark law. It argued that since these dances are used commercially in NFL games, the dances should be registrable as trademarks.

The authors have also referred to Henry M. Abromson's 'The Copyrightability of Sports Celebration Moves: Dance Fever or Just Plain Sick?' which asserts that sports celebration moves are copyrightable. By referring to this paper, the present authors have tried to understand how sports celebratory moves are protected under copyright and whether those principles can be inculcated under trademark law as well.

## **II. INTRODUCTION**

Sports have been an integral part of human civilisation. Modern sports can be dated back to as far as 2000 BCE, from when the earliest documentation of modern sports can be obtained.<sup>1</sup> The introduction of the first Olympic Games in Greece in 776 BCE contributed to the spread of competitive sports around the world.<sup>2</sup>

Over the centuries, sports have amassed increasing importance. The Olympic sports, for example, were so important to the Greeks that when the Persians were invading Greece, the Greek capital of Athens had trouble organizing its army as many were busy participating in the Olympics.<sup>3</sup> Today, sports have developed much from their ancient forms and many new sports have been introduced in just the past century.

With the ease in communicating information, from newspapers, radio and television to the internet, sports have attracted more and more attention, some more than others. The corporatization of modern sports has made competitive sports into an arena for marketing, merchandising, franchising and brand building. The same has been true for the sportspersons or the people involved in playing these sports.

Players who bag laurels in their sports become highly popular among the masses and become famous sports personalities with a large mass of people following them in their sports and personal

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<sup>1</sup> Mary Bellis, *A Brief History of Sports*, THOUGHTCO. (Feb. 11, 2020), <https://www.thoughtco.com/history-of-sports-1992447>.

<sup>2</sup> ANCIENT OLYMPIC GAMES, <https://www.olympic.org/ancient-olympic-games> (last visited Feb. 11, 2020).

<sup>3</sup> *Ibid.*

lives. Their influence over the people is comparable to that of a famous celebrity. Maradona, Michael Jordan, Sachin Tendulkar, Usain Bolt, Muhammed Ali, etc... remain some of the most popular sportspersons today. So much so that their name becomes associated with them being the greatest in the sport they play.

However, the biggest way in which modern sports differ from what sports were a few hundred years ago is the fact that money has taken a wholly different role in sports. Merchandising, franchising and branding play a huge role in sports today. Companies are willing to pay huge sums of money to be associated with a particular sporting event or a sportsperson. For example, the Chinese mobile manufacturer, Vivo, entered into agreement with the Board of Cricket Council of India (BCCI) to pay a whopping 2,199 crore rupees over a period of 5 years so that Vivo's brand name is associated with the popular cricket sporting event, the Indian Premier League (IPL).<sup>4</sup> Through the use of sporting events and by having sportspersons endorse their brands, companies today seek to increase their brand value. Perhaps the ex-president of FIFA has aptly described modern sports in general by stating that "football is not only a game but also a product".<sup>5</sup>

#### **A. THE GROWING IMPORTANCE OF BRAND VALUE IN SPORTS**

'Brand value' is defined as the total of how much a person would pay over and above for one brand over another brand.<sup>6</sup> It is brand value which has contributed to sport celebrities like Michael Jordan, Sachin Tendulkar, Sania Mirza and various others to be able to connect on a much larger scale with the public, even with those who do not watch their sports.

Brand value is established not just by becoming popular and successful in the sport they play but also by launching products in their name, featuring them or by launching products with their most famous tag lines. Sportspersons, today, are a brand in themselves.

The biggest benefit in becoming a brand is the potential for endorsements from various companies. Endorsements act as another source of income for sportspersons. In fact, celebrity sportspersons such as Roger Federer and Tiger Woods make a majority of their earnings from

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<sup>4</sup> Urvi Malvania, *Vivo retains IPL title sponsorship; to pay Rs 2,199 cr to BCCI over 5 yrs*, BUSINESS STANDARD (December 16, 2019), [https://www.business-standard.com/article/companies/vivo-retains-ipl-title-sponsorship-to-pay-rs-2-199-cr-to-bcci-over-5-yrs-117062700562\\_1.html](https://www.business-standard.com/article/companies/vivo-retains-ipl-title-sponsorship-to-pay-rs-2-199-cr-to-bcci-over-5-yrs-117062700562_1.html).

<sup>5</sup> Shiren Panjolia, *Sports-IPR-India*, SHIREN PANJOLIA WORDPRESS (Feb. 16, 2017), <https://shirenpanjolia.wordpress.com/2017/02/16/sports-ipr-india/>.

<sup>6</sup> Steve Olenski, *Brand Value: What It Means (Finally) And How To Control It*, FORBES (Sep. 15, 2015), <https://www.forbes.com/sites/steveolenski/2015/09/15/brand-value-what-it-means-finally-and-how-to-control-it/#2ec09b8f13b2>.

endorsements (about 84% and 97% of their earnings respectively).<sup>7</sup> Thus, endorsements not only help a sportsperson to earn more revenue, but also help in building a brand name for oneself.

When a person builds a brand out of himself, he often seeks to capitalize upon ways which shall ensure more revenue or become a source of additional earnings for himself. Apart from endorsements, the other way celebrities and sportspersons alike do this is by trademarking their famous catchphrases, signatures, their name or even the initials of their name. Trademarking their celebratory moves is yet another way by sportspersons to capitalize on their own brand value.

Every player celebrates victory in his or her own unique way. Dances, gestures, shouting slogans, etc... are all part of this celebration. In fact, the way a player celebrates can often tell us a lot about their personalities. This contributes in the masses learning and interacting more with the players and hence helps build up their brand value. But registering as a trademark one's moves and actions requires an understanding of what trademarks are and what are the various types of trademarks which are allowed by law to be registered.

### **III. DEFINING TRADEMARKS - CONVENTIONAL AND NON-CONVENTIONAL MARKS**

Marks have been used to identify and prove ownership of a good since the ancient period. Romans brickmakers, for example, stamped their bricks with their own mark to identify their bricks. In Medieval Europe, sword manufacturers were mandated to insert their unique identification marks on the swords they made so that a defective sword could be traced back to the maker and he be punished.<sup>8</sup>

In Medieval Europe, without any law on the protection of a trademark, trademark was only protected in common law. Modern trademark law is based off on Britain's enactment on the need to register trademarks for their protection against infringement. This was the British Trademark Act of 1975.

Trademark, however, is often commonly misunderstood to be limited to only a word or a logo. This is a very narrow definition of the term as a trademark can be any word, insignia, phrase or symbol which denotes and differentiates a particular product from another.<sup>9</sup> Trademarks are

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<sup>7</sup> Nasha Smith, *13 athletes who make more money endorsing products than playing sports*, BUSINESS INSIDER INDIA (Jun. 14, 2019), <https://www.businessinsider.in/sports/nba/13-athletes-who-make-more-money-endorsing-products-than-playing-sports/articleshow/69792544.cms>.

<sup>8</sup> BananaIP Reporter, *History And Evolution Of The Trademark System*, BANANAIP (Jan. 2, 2019), <https://www.bananaip.com/ip-news-center/history-and-evolution-of-trademark/>.

<sup>9</sup> Carla Tardi, *Trademark*, INVESTOPEDIA, <https://www.investopedia.com/terms/t/trademark.asp>.

helpful as they help in protecting a mark's distinctiveness in its association with a good or service. They also serve as badges of origin of the particular good or service to the consumers.<sup>10</sup>

In India, the Trademark Act, 1999 defines a 'trademark' under Section 2 (zb) as a mark capable of being represented visually, one which can distinguish between the goods or services of one person with those of another. Further, a trademark can also include headings, signatures, labels and names within its definition.<sup>11</sup>

Thus, a trademark is a mark which enables us to distinguish one good or service from another. However, apart from the above inclusions of words, logos, symbols, etc... a trademark can also be as unconventional as a colour, smell, sound, shape or even a video.<sup>12</sup> Such marks are called as non-traditional marks and the registration of such marks can be hard but if they satisfy the requirements of a trademark (that of graphical representation and of making the product distinctive from other similar products), they will be given registration.

From an international perspective, there are about nine types of non-traditional marks which have had successful registration. These are:

- a. Shape marks
- b. Three dimensional marks and holograms
- c. Colour marks
- d. Smell marks
- e. Sound marks
- f. Multimedia marks
- g. Touch and texture marks
- h. Taste marks
- i. Gesture marks

In India, the Manual of Trademarks Practice and Procedure of Indian Trademark Registry, 2015 (Draft), however, only recognizes smell, sound, colour and shape marks under the category of unconventional marks. India still lacks any successful registration for a taste, touch, or gesture mark.

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<sup>10</sup> *Aristo Ltd. v. Rysta Ltd.*, 1945 AC 68.

<sup>11</sup> Indian Trademarks Act, 1999, § 2 (zb), No. 47, Acts of Parliament, 1999 (India).

<sup>12</sup> SMELL, SOUND AND TASTE – GETTING A SENSE OF NON-TRADITIONAL MARKS, [https://www.wipo.int/wipo\\_magazine/en/2009/01/article\\_0003.html](https://www.wipo.int/wipo_magazine/en/2009/01/article_0003.html) (last visited Feb. 21, 2020).

#### IV. TRADEMARKS IN SPORTS

Sportspersons are their own brand today. As with any other successful brand, they too need protection of their brand identity. Often, various people attempt to cash-in on the fame and popularity of famous sportspersons. They do this by launching products bearing their face, name, signatures, jersey numbers or other signs indicating a relation with the player. This leads to the false belief that the particular sportsperson is associated with the product or has endorsed the product.

Thus, sportspersons are quick to trademark things which can be put out as unique about them and by which they can benefit financially from. Names, initials of their names, a player's jersey number, famous catch-phrases, or even a famous pose by a player are trademarked for benefitting from the commercial use of the mark on clothing, shoes and other accessories such as toy figurines, posters, video games, etc.

Further, players in games such as football, cricket, tennis, etc... are associated with various teams. These teams have their own logos, taglines and other ways of identification. The huge business opportunity in the world of sports has also increased the value of these teams. Forbes' 2019 valuations place Dallas Cowboys as the most valuable sports team with the franchise worth more than \$5 billion.<sup>13</sup> Therefore, even teams seek to trademark their names, logos and other unique ways of their identification.

It has hence become important for sportspersons to trademark an aspect of their personalities itself. Renowned footballer Lionel Messi has more than 76 registered marks in his name with successful registration of his last name for jewellery, clothing and sporting equipment.<sup>14</sup> Cristiano Ronaldo's name, initials and player number is also trademarked as 'CRISTIANO RONALDO', 'CR7' and 'CR9'. So is English footballer Harry Kane's initials 'HK'.<sup>15</sup> Perhaps one of the most famous trademarks in the field of football is that of David Beckham's. Beckham has trademarked his name on various products as well as trademarked a logo mark featured on Adidas' Predator Boots.<sup>16</sup>

There are also various internet domain names or website addresses belonging to sportspersons which are registered as trademarks. The use of a domain name showing a false association or

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<sup>13</sup> THE MOST VALUABLE SPORTS FRANCHISES, <https://thebossmagazine.com/most-valuable-sports-franchises/> (last visited Feb. 24, 2020).

<sup>14</sup> Gavin Stenton, *Lionel Messi finally registers his name as a trade mark following long legal battle*, LEXOLOGY (Apr. 30, 2018), <https://www.lexology.com/library/detail.aspx?g=23638806-354d-4d22-962f-d6310a25a0e5>.

<sup>15</sup> Akber Ahmed, *From CR7 to Smokey Beckham — a guide to football trade marks*, LEXOLOGY (Jul. 13, 2018), <https://www.lexology.com/library/detail.aspx?g=5453c74f-abbd-4255-9628-6643b4a50b44>.

<sup>16</sup> Amelia Skelding and Timo Haslam, *Football Players and Trade Marks*, IP COPY (June 28, 2018), <https://ipcopy.wordpress.com/2018/06/28/football-players-and-trade-marks/>.

suggestion of a connection with a sportsperson can damage to the reputation of the sportsperson, his brand or his business. It is also important to protect the name and brand persona of a sportsperson as a domain name trademark as the lack of it can allow cyber squatters to benefit off economically from the confusion created by registering a highly similar or identical domain name. The World Intellectual Property Organisation, in an administrative panel decision, had held that the registration of the domain name <msdhoni.com> by the respondent was in violation of the petitioner and reputed Indian cricket player, M. S. Dhoni for it was confusingly similar to Dhoni's registered trademark of his personal name.<sup>17</sup>

In India, renowned cricketer Sachin Tendulkar has trademarked not just his name but his signature as well. His signature finds use on various sporting goods, clothing and items of stationary (pen, pencils, books, etc).<sup>18</sup> Sports teams such as Chennai Super Kings, Mumbai Indians, etc. have their names, logos and slogans trademarked.

#### **A. SIGNATURE CELEBRATORY MOVES TRADEMARKED BY SPORTSPERSONS**

Throughout the modern history of sports, sportspersons and famous athletes have invented truly unique and sometimes popularised borrowed moves on the field, from goofy dances to simple hand gestures to woo their fans. However, most of these moves are not trademarked. This is because, to be able to trademark a move or a gesture, one must be able to show that the particular action is so different and unique in nature that it can be attributed rationally only to one particular individual and not to multiple persons or brands.

We can find an example of such a unique style in world-renowned athlete, Usain Bolt's trademark of his celebratory pose, the "lightning bolt", which includes Bolt posing legs stretched with his arms and fingers pointed diagonally towards the sky.<sup>19</sup> Mo Farah, a British long-distance runner, has also trademarked his famous victory move, the "Mobot", in the UK IPO.<sup>20</sup>

The game of football has a great many examples of sportspersons trademarking their celebratory moves as a 'device' or an image mark. Renowned Welsh footballer, Gareth Bale, has earned the trademark rights to his "Eleven of Hearts" celebratory move, which involves curving his hands in to form a heart shape with the number '11' in between. The mark has been allowed to be used on

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<sup>17</sup> Mahendra Singh Dhoni and Rhati Sports Management Private Limited v. David Hanley, Case No. D2016-1692 (WIPO Arbitration and Mediation Center).

<sup>18</sup> Trademark Application No. 811442 (India).

<sup>19</sup> 007454523, EUTM file information, European Union Intellectual Property Office, <https://euipo.europa.eu/eSearch/#details/trademarks/007454523>.

<sup>20</sup> Julia House, *Trademarks are Making the News*, ALBRIGHT IP (June 28, 2013), <https://www.albright-ip.co.uk/2013/06/trademarks-are-making-the-news/>.

shoes, hats, bags, umbrellas and jewellery.<sup>21</sup> England striker, Jesse Lingard, has trademarked his famous celebration move, 'JLingz', where he covers his forehead with his fingers forming the initials of his name (in the shape of a 'J' and an 'L'). The trademark is registered for use on clothing, footwear and headgear.<sup>22</sup>

One famous dispute involving the trademark of a sportspersons' move is that of the 'Vicht'. The Vicht was a sign which involved closing the hand in the shape of a duck beak and was trademarked by the Tennis player, Niclas Kroon. However, Kroon's trademark lapsed and he did not file to extend the trademark's registration. Lleyton Hewitt, another Tennis player, chanced upon this opportunity and registered the same mark in his own name.<sup>23</sup>

At the time of penning down this article, the authors have unfortunately not come upon any example of a movement or an action trademarked by sportspersons in India. Though there are many signature moves of Indian sportspersons, such as for example the famous 'helicopter shot' performed by M. S. Dhoni or Sachin Tendulkar's straight drive, none of such moves are completely attributable to Indian players and have been performed numerous times by other players as well, often before them. As we shall see below, distinctiveness is among the basic tenets to obtain registration for an unconventional mark.

## **V. THE HINDRANCES AND POSSIBILITIES OF TRADEMARKING A CELEBRATORY MOVE**

Trademarking celebratory or signature moves of these sportspersons is not easy and even though there are some sports celebrities who have trademarked their celebratory moves, the legal battle is complicated and tough. There are three main requirements to trademark a celebratory move for a sportsperson. These requirements can turn into hindrances if they are not met with.

### **A. GRAPHICAL REPRESENTATION**

The first requirement is that of graphical representation. This can be achieved either by describing the move in precise and elaborate detail or through the graphical medium of a picture or a drawing. Further, criteria such as the intelligibility, preciseness, clearness, durability, accessibility and

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<sup>21</sup> Sion Morgan, *Gareth Bale wins bid to trademark heart goal celebration and shirt number*, WALES ONLINE (Jun 17, 2013), <https://www.walesonline.co.uk/sport/football/football-news/gareth-bale-wins-bid-trademark-4330580>.

<sup>22</sup> *Jesse Lingard seeks to trademark 'Jlingz' nickname and celebration*, NOVAGRAAF (June 20, 2018), <https://www.novagraaf.com/en/insights/jesse-lingard-seeks-trademark-jlingz-nickname-and-celebration>.

<sup>23</sup> Annabel Crabb, *Talk to the hand if you want to use Hewitt's gesture*, THE SYDNEY MORNING HERALD (January 12, 2008), <https://www.smh.com.au/national/talk-to-the-hand-if-you-want-to-use-hewitts-gesture-20080112-gdrwhs.html>.

objectivity of such a graphical representation may also have to be taken into consideration while registering a celebratory move as a trademark.<sup>24</sup> Graphical representation, though, is more of a practical than a legal problem when registering celebratory moves of sportspersons.<sup>25</sup>

In the US case of *Qualitex v. Jacobson*<sup>26</sup>, the issue involved was one of trademarking the colour of dry-cleaning pads of a brand. The case went to the Supreme Court of the United States which rejected the application for the trademark of the colour but however did hold that in some cases, a colour can meet the legal requirements for a trademark. What is to be noted, however, is the Court's explanation that it is not the word, sign, shape, colour or fragrance of a mark but its source-distinguishing ability which allows it to be registered as a trademark. Under the statutory definition of a 'mark' under the Lanham Act (The Trademark Act of the United States), any 'device' or 'symbol' also under the definition. The court noted this and said that the statutory definition is not restrictive and humans can use as a 'device' or 'symbol' almost anything which is capable of having meaning.

The European Court of Justice (ECJ) in *Ralf Sieckmann v Deutsches Patent- und Markenamt*<sup>27</sup> was a landmark decision which came in 2003 which dealt with the issue of trademarking of the applicant's smell mark. While the court did not grant registration for the same, it laid down several guidelines which would allow non-traditional marks (such as smell and sound marks) to be registered as a trademark. The ECJ had ruled in this case that a trademark need not be perceived of visually. *The only requirement for a successful registration is the ability to graphically represent the impugned mark* (emphasis supplied).

When a mark is graphically represented, it is considerably clearer and more precise and ensures an easier protection of the mark under the respective law relating to trademarks. However, Article 15 of the Trade Related Aspects of Intellectual Property Rights (TRIPS), 1994 digresses from this requirement to an extent and stresses for 'visual perceptibility' instead.<sup>28</sup> Yet, keeping in mind that most TRIPS nations only set a framework for each signatory country to follow, and the fact that most nations focus on the requirement of graphical representation rather than the wider term, 'visual perceptibility', if one seeks to trademark their celebratory move, one would still have to confirm to the requirement of representing the move graphically.

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<sup>24</sup> SCT/16/2, Standing Committee on the Law of the Trademarks, Industrial Designs and Geographical Indications, Sixteenth Session, World Intellectual Property Organisation (September 1, 2006).

<sup>25</sup> Arka Majumdar et. al., *The Requirement of Graphical Representability for Non-Conventional Trademarks*, 11, JOURNAL OF INTELLECTUAL PROPERTY RIGHTS, 313 (2006).

<sup>26</sup> *Qualitex Co. v. Jacobson Prods. Co., Inc.*, 514 U.S. 159, 159 (1995).

<sup>27</sup> *Ralf Sieckmann v Deutsches Patent- und Markenamt*, Case C-273/00 ECJ.

<sup>28</sup> The Agreement on Trade-Related Aspects of Intellectual Property Rights, 1994, art. 15.

The graphical representation of celebratory moves often takes the form of an image mark on various goods such as clothing, footwear, headgear, accessories, toys, etc. For example, Usain Bolt has registered his celebratory mark for use on clothing apparel and sports products.<sup>29</sup>

Non-traditional marks such as smell marks and sound marks, which are intangible in nature, face a challenge in graphically representing themselves for registration as a trademark. It has been clarified that the mere writing down of the chemical formula of the smell will not entail registration.<sup>30</sup> Further, neither an odour sample nor a sound sample can be called a graphical representation.<sup>31</sup> The only way to register such unconventional marks is to attach a description so precise that no other sound or smell can be confused with the one trying to obtain a trademark registration. Mere descriptions of such an unconventional mark can create confusion.<sup>32</sup> Similarly, if a sportspersons' move is sought to be trademarked, apart from a graphical representation one would require a description of the mark so precise that on a clear reading of it, the move would not be confused with being similar or identical to a move/action performed by another person. In India, graphical representation is regarded as the sine qua non for registering a trademark. As per Rule 25(12)(b) of the Trademark Rules, 2002, the trademark which is sought to be registered for goods or services must be of such a nature which can be depicted graphically.<sup>33</sup> Rule 28 further goes on to say that the trademark should be able to be depicted on paper.<sup>34</sup> Additionally, Rule 30 states that the graphical representation of the mark should be satisfactory and durable.<sup>35</sup> According to Section 18 of the Trademarks Act, 1999, the application seeking registration of a trademark must conform with the Trademark Rules, 2002.<sup>36</sup>

## **B. DISTINCTIVENESS**

The second requirement or the hindrance to registering a celebratory move as a trademark is that of the move being able to prove its uniqueness and distinctiveness in the class of the goods or services it intends to monopolise on. The move should be such that it distinguishes one good or service from another. Trademark registration would be given only if it can be shown that the celebratory move is so unique as to be attributable only to that sportsperson and no other person

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<sup>29</sup> Sharon Daboul, *Has Usain Bolted the Gates on his Brand?*, LAWYER MONTHLY (August 8, 2017), <https://www.lawyer-monthly.com/2017/08/has-usain-bolted-the-gates-on-his-brand/>.

<sup>30</sup> *Ibid.*

<sup>31</sup> Lisa P. Lukose, *Non-Traditional Marks: A Critique*, *Journal of the Indian Law Institute*, Vol. 57, No. 2 (April-June 2015), pp. 197-215.

<sup>32</sup> *Shield Mark BV v. Joost Kist*, Case C-283/01, Court of Justice of the European Communities.

<sup>33</sup> Trademark Rules, 2002, Rule 25(12)(b).

<sup>34</sup> Trademark Rules, 2002, Rule 28.

<sup>35</sup> Trademark Rules, 2002, Rule 30.

<sup>36</sup> Indian Trademarks Act, 1999, § 18, No. 47, Acts of Parliament, 1999 (India).

or brand. What needs to be proven is that the said move would not create any confusion among the minds of the consumers with other products or services in the same trademark classification which it seeks to cover. Thus, distinctiveness capable of being a source-identifier and the lack of being able to create confusion or deceit in the public mind serves as the second requirement for trademarking a sportspersons' celebratory move.<sup>37</sup>

For example, in June 2017, the lead singer of the rock band 'Kiss', Gene Simmons, attempted to trademark the popular hand gesture called 'Devil's Horns'. However, the application was withdrawn by the singer after facing great public criticism as well as an opposition application from another person. The reason being that this gesture was used by rock stars since ages and had neither been developed by the lead singer nor was the sign associated exclusively with him. Thus, even if Gene Simmons had moved the application for registering the mark, it would not have been successful as the mark is not distinctive and is of a generic nature.<sup>38</sup>

Section 9(1)(a) of the Indian Trademarks Act, 1999 relating to the absolute grounds for refusal of registration of a mark states that a mark devoid of any distinctive character and unable to distinguish the goods or services of one from another, shall not be eligible for registration.<sup>39</sup> The proviso to Section 9(1) clarifies that if a mark has acquired a distinctive character from its use, then it cannot be refused registration.<sup>40</sup> Furthermore, Section 9(2)(a) states that a mark would not be eligible for registration if it is of such a nature that it deceives the public or causes confusion.<sup>41</sup> In *Imperial Tobacco Co. Of India Ltd. vs Registrar Of Trade Marks*,<sup>42</sup> the question before the Calcutta High Court was whether the appellants' mark, 'Simla', for cigarettes had acquired distinctiveness or not as the word 'Simla' is also the name of a chief town in Northern India. Rejecting the appeal to register the mark, the Court stated that distinctiveness in trade is a requirement which has to be proved for registration.

Distinctiveness is at the core of ground for registration of a trademark with the Registrar. Distinctiveness has to be acquired over time. A short period of time is insufficient to prove distinctiveness.<sup>43</sup> It is also incumbent in an action for infringement or passing off to show that the mark has acquired distinctiveness and the general public associates such a mark with the

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<sup>37</sup> V. A. MOHTA, Trademarks, Passing off and Franchising (All India Reporter Pvt. Ltd., Nagpur, 2004).

<sup>38</sup> Amanda G. Ciccattelli, *Why Gene Simmons Abandoned His 'Devil Horns' Trademark Application*, IP WATCHDOG (June 29, 2017), <https://www.ipwatchdog.com/2017/06/29/gene-simmons-abandoned-devil-horns-trademark-application/id=85168/>.

<sup>39</sup> Indian Trademarks Act, 1999, § 9(1)(a), No. 47, Acts of Parliament, 1999 (India).

<sup>40</sup> Indian Trademarks Act, 1999, proviso, § 9(1), No. 47, Acts of Parliament, 1999 (India).

<sup>41</sup> Indian Trademarks Act, 1999, § 9(2)(a), No. 47, Acts of Parliament, 1999 (India).

<sup>42</sup> *Imperial Tobacco Co. Of India Ltd. v. Registrar of Trade Marks*, AIR 1968 Cal 582.

<sup>43</sup> *Metropolitan Trading Company v. Respondent: Mohanlal Agarwal and Ors.*, MIPR 2008 (1) 24.

proprietor's goods or services.<sup>44</sup> Therefore, it would be extremely difficult for a sportspersons' move to be registered as a trademark when no such prior use of the move/action can be attributed to the player showcasing the mark's distinctiveness. While this requirement of distinctiveness is more easily met with when seeking to register traditional marks such as word marks or device marks, the same has to be developed over time with a showcased use of the mark in cases of registering non-traditional marks.

The official website of the Indian intellectual property office does not state that an action or a move can be registered as a trademark. Further, in answering what are the sources of trademarks, the website lists textbooks written by academicians and professional experts as one of the sources, along with international conventions, treaties and decisions of the courts.<sup>45</sup> As we have seen in the above-mentioned examples, marks which are essentially actions of sportspersons have been trademarked. This means that the possibility of registering a celebratory move as a trademark cannot be put out in the case of India, as long as the trademark sought to be registered exhibits the above two requirements.

### **C. INDICATION OF SOURCE OR ORIGIN**

Trademark protection can be extended to anything used to identify a particular good or service and which the human senses are capable of detecting.<sup>46</sup> This statement becomes all the more prominent in light of the *Qualitex*<sup>47</sup> decision. The successful registration of smell marks, sound marks, touch marks, shape marks, etc... are all examples of the veracity of this statement.

One notable work on this subject comes from F. Scott Kieff, Robert G. Karmner and Robert M. Kunststadt who suggest that sporting behaviour, which includes victory celebrations, should in theory be eligible for trademark protection. In fact, they tell us about the third requirement for sports moves to be registered as a trademark, that they should be able to point out to the public a particular good or service which has come to be associated with such a move.<sup>48</sup> If the particular move is not able to point to the source or origin of goods or services, it would not be granted protection under trademark law.

However, it is this third requirement which poses the biggest challenge to trademarking a sportspersons' celebratory move. This is due to the apparent non-attachment of the celebratory

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<sup>44</sup> *Gillette India Limited v. Harbans Lal Malhotra and Sons Private Limited*, 2009 (41) PTC 378 (Cal).

<sup>45</sup> Frequently Asked Questions (FAQ), Intellectual Property India, <http://www.ipindia.nic.in/faq-tm.htm>.

<sup>46</sup> J. T. MCCARTHY, *MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION*, (Thomson West 2014).

<sup>47</sup> *Qualitex Co. v. Jacobson Prods. Co. Inc.*, 514 U.S. 159, 159 (1995).

<sup>48</sup> F. Scott Kieff, Robert G. Kramer & Robert M. Kunststadt, *It's Your Turn, But It's My Move: Intellectual Property Protection For Sports "Moves"*, SANTA CLARA COMPUTER & HIGH TECH L. J., 765, 781-84 (2009).

move to a good or service. How can a sports move serve as an indication of the source or origin of particular goods and services?

Modern technology can prove to be of great help to us in answering this question. For example, a video of the celebratory move may be played during the advertisement of a product or a service so that consumers may start associating the particular move as well as the celebrity performing the move with the good or service. A video may also be attached with a product being sold on an e-commerce website so that every time a person clicks on the particular product to view or order it, the celebratory move associated with the product can play in tandem. The sportsperson may also, while endorsing a particular brand in an advertisement, showcase using the brand's product while displaying his signature dance or move. What this does, in effect, is that it helps in creating a link in the mind of the consumer between the specific good or service and the sportspersons' signature move which creates the second effect of the consumer associating the particular move with only that particular good or service.

In terms of protection as a trademark, such a video may be registered as a multimedia mark. Multimedia marks, also known as moving marks, consist of several images shown together in a fast motion so as to project the images as one moving picture. Earlier, moving marks were registered by separately registering each individual image as a trademark. This was because moving marks were traditionally given protection only in copyright law and the concept of registering the movement as one mark was not recognised in trademark law. However, with the growth of trademark legislation, this has changed.

The US Patent and Trademark Office has been a leader in granting registration to multimedia or moving marks. These range from Microsoft's registration of the animation of the three primary colours swirling to form the Microsoft logo to Lamborghini's registration of the opening of its doors which rotate vertically rather than spread in an outwardly direction.<sup>49</sup> Nokia phones' switching on animation involving the reaching out of two hands towards one another is also a registered multimedia mark.<sup>50</sup>

Pointing out that a good is of or from a certain origin is the essence of trademark law in India.<sup>51</sup>

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<sup>49</sup> MARK PERRY, *GLOBAL GOVERNANCE OF INTELLECTUAL PROPERTY IN THE 21ST CENTURY: REFLECTING POLICY THROUGH CHANGE*, (Springer 2016).

<sup>50</sup> Joan Janneth M. Estremadura, *That's my move! Are motion marks eligible for trademark protection?*, *BUSINESS WORLD* (May 21, 2019), <https://www.bworldonline.com/thats-my-move-are-motion-marks-eligible-for-trademark-protection/>.

<sup>51</sup> K.C. KAILASRAM, *VENKATESWARAN ON TRADE MARKS & PASSING-OFF*, 72, 75 (LexisNexis 2015).

#### **D. OTHER CHALLENGES**

Meeting the above-mentioned three conditions are not the only challenges to registering a celebratory move as a trademark. For example, when registering a sportspersons' move as a multimedia mark, we need to understand that the actual physical move is not being trademarked. Rather, it is the video of the sportsperson performing his celebratory move, taken as a whole, which would become registered. On the basis of the present trademark laws existing worldwide, it is obvious that the physical move cannot be trademarked. Physical moves can only be trademarked in an implicit manner. This implicit registration of the physical move as a trademark can also be seen in the above examples of sportspersons like Usain Bolt and Jesse Lingard who have trademarked their physical moves as image marks for use on clothing, accessories and footwear, etc. With the help of modern technology, we can trademark a signature move in the form of multimedia marks and 3-D marks as seen in the above given examples.

Consider the case of one of the best basketball players, Michael Jordan. Michael Jordan has a signature move called the 'Air Jordan' slam dunk, which has also come to be used as a device mark on Nike products.<sup>52</sup> If another basketball player were to copy Michael Jordan's move, it would not be difficult for fans of basketball to assume that perhaps this other player is also now associated with Nike or perhaps with Michael Jordan's brand persona.

Another issue, which most IP offices around the world would agree upon, is that granting a trademark to an action or a physical movement risks granting the proprietor of the trademark a monopoly on certain aspects which can easily be replicated by competitors unknowingly or unintentionally. Take, for example, Usain Bolt's 'Lightning Bolt' pose. Were the physical move itself trademarked, Bolt would have been in the capacity to sue hundreds, if not thousands of people who have imitated his pose over the years.

#### **VI. CONCLUSION**

Under India's trademark laws, the scope of registering a sportspersons' celebratory move is limited. Unfortunately, India's laws for registering non-traditional motion marks are inadequate. In comparison, the European Union has equipped itself with much better laws to accommodate the registration of non-traditional marks. In India, marks are only considered registrable as trademarks if they can be represented graphically. While this requirement limits the scope of what can be registered as a trademark, it is an important precondition to stop mindless marks from being

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<sup>52</sup> Giuliana R. Garcia, *He Shoots, He Scores...and Receives Copyright Protection? How the Current State of Intellectual Property Law Fumbles with Sports*, DEN. U. SPORTS & ENT. L. J. 81, 108 (2011).

registered. Thus, where a celebratory move, an action or some other movement of the body (or a thing) is sought to be registered as a trademark, such actions have to compulsorily meet the requirements of graphical representation, distinctiveness and indicating the source or origin of the same.

There is a perception that obtaining trademark registration for a non-conventional mark is more of a marketing strategy than genuinely protecting a brand's image or reputation from exploitation. However, with the fast growth of the internet and the rising growth of social media platforms where information is easily disseminated within seconds, the protection of any mark which is distinctive in nature becomes extremely important. Further, with the ways in which our digital world is being continuously reshaped, it should come to us as no surprise if in the future, registration of non-distinctive marks become more popular. Ultimately, such marks present to the mark holder an opportunity to create and develop an asset to be profited from by means of licensing or transferring.