

## Slogans and phrases

Slogans often consist of expressions that are catchy, clever or topical. They are frequently used with a main trade mark or house mark to create a positive sentiment, aura or cachet to be associated with that brand of goods or services. Slogans are not objectionable in themselves as trade marks; the principal difficulty with them is that they are often incapable of serving as badges of origin because they consist of indistinctive, descriptive or generic matter.

### Descriptive slogans and phrases

Where a phrase is made up of a combination of words which an average consumer would regard as one of the normal ways of referring to the goods or services or of representing their characteristic, objection may be raised under section 11(1)(c), in addition to section 11(1)(b). Evidence of acquired distinctiveness will be required in support of the application. For example, DAY BY DAY is descriptive of products which are produced each day or are delivered each day to the point of sale. The mark may serve to designate the time of delivery of goods and their qualities. It would be too readily and aptly applicable to goods such as dairy produce to be distinctive of them. So would ALL NATURAL! for textiles and garments made of natural fibres, or foodstuffs free of artificial flavourings. The grant of exclusive rights in the use of DAY BY DAY and ALL NATURAL! would unfairly restrict the freedom of other honest traders in describing the kind and intended purpose of their goods and should be refused under section 11(1)(c).

In the UK, the phrase BAGS OF STYLE has been refused registration in classes 3, 8 and 11 for being a normal way of referring to an essential characteristic of the goods, and WHERE ALL YOUR FAVOURITES COME TOGETHER for confectionery for being a natural or normal way of referring to a quality of the goods (the package contains a variety of confectionery items which sales or other research have identified as consumer favourites). CONTROL PAIN LIVE LIFE for pharmaceutical substances, medical and healthcare services, as well as DVDs, publications and educational

services relating to medical, pharmaceutical, lifestyle and healthcare matters, conveys an obvious message in relation to the intended purpose of the goods and services. It indicates that the goods and services would limit or check any discomfort and would help the consumer to live life to the full. THE ART OF THE PERFECT CUP in respect of devices for making drinks and beverages and the constituent ingredients of beverages describe the intended purpose of the goods, namely that they provide the consumer with the skilful creation of the perfect cup of their chosen beverage. That the mark may have a degree of eloquence does not equate to it being an unnatural way of referring to the goods or a characteristic of them. There is also nothing unusual about the combination of the words “the art of the” and “perfect cup”.

In the Hong Kong SAR, the Registry has refused registration of REACH EASY in respect of massage machines and apparatus as the mark would be immediately associated with certain characteristics of the goods in question, that is, reaching areas of the body easily. It is common for traders to commend their massage products as having special features or functions for massaging hard-to-reach areas with ease.

As regards objection under section 11(1)(c), there is no requirement that the mark be in current use by other traders, nor is there a requirement that the mark should designate a single or exclusive characteristic; it is sufficient that at least one of its meanings is descriptive.

## **Lack of distinctive character**

As far as assessing distinctiveness is concerned, every trade mark, of whatever category, must be capable of identifying the product as originating from a particular undertaking, and thus distinguishing it from those of other undertakings (DAS PRINZIP DER BEQUEMLICHKEIT (“The Principle of Comfort”) [2005] E.T.M.R 58). The test for registering slogans is no different than for any other type of marks but as slogans are often used for advertising purposes they may not be so readily accepted by the general public as an indication of trade source as would more traditional signs such as words, brands, logos and figurative marks. Because many slogans are well adapted to be used in relation to goods or services of different traders,

they may not be sufficiently distinctive for registration as trade marks. Evidence of acquired distinctiveness will be required.

A mark may not be exclusively descriptive of the relevant goods or services and so not fall foul of section 11(1)(c), but it may nevertheless be devoid of distinctive character and so fall foul of section 11(1)(b) (*HAVE A BREAK* [2004] FSR 2). The mere fact that a sign does not convey any information about the nature of the goods or services concerned is not sufficient to make that sign distinctive. The sign *REAL PEOPLE*, *REAL SOLUTIONS*, whilst it does not have a direct and exclusive descriptive connotation, nonetheless taken as a whole would be understood as signifying that the applicant's services consist in providing pragmatic solutions devised by and for real people.

### ***Normal use in advertising to be considered***

In examining a mark, we should have regard to the natural use of the mark applied for, not only on packaging of goods, but also in the context of advertising.

A slogan which consists merely of ordinary dictionary words that come easily to mind so as to convey a promotional message, such as *SAY IT WITH ... (THE GOODS)* would most likely be perceived as a promotional statement that the goods are a means through which to convey a special message, rather than as carrying trade mark significance. Objection should be raised based on section 11(1)(b).

A certain degree of self-glorification or exaggeration is typical in advertising. For example, *LIVE RICHLY* is a simple laudatory formula meaning that the applicant's services enable consumers to live richly. Traders in all fields of activity can be expected quite legitimately, to wish to use such kind of phrases in promoting their goods or services, so that registration of such phrases by one trader is likely to embarrass others in advertising and conducting their business. *FROM GREAT PEOPLE TO GREAT PERFORMANCE* has been refused registration by the Registry as being catchy and exaggerated expressions meaning great staff and great

performance for mere promotional purposes.

It is customary for advertisements to use abbreviated language. For example, the average consumer would see the abbreviation “WHERE ALL YOUR FAVOURITES COME TOGETHER” for what it is, namely an abbreviation for the expression, “This is where all your favourites come together in one box”. For the mark “BEST BUY”, the mere omission of an article (a best buy or the best buy) does not make it a lexical invention or give it a distinctive character.

Since the average consumer is not very attentive, if a sign does not immediately indicate to him the origin of the designated goods or service, but just gives him purely promotional, abstract information, he will not take the time either to enquire into the sign’s various possible functions or mentally to register it as a trade mark.

In relation to the marks “for you...” and “FOR YOU”, they are more likely to be seen as an invitation to the consumer to look at a list of goods/services in advertising, or an indication on packaging that the contents are for the benefit of the customer. The expression is not origin specific.

### ***Value statements***

Value statements such as CARING FOR THE ENVIRONMENT or customer service statements such as PUTTING YOU FIRST could never be distinctive as to origin, as they can practically apply to any trader in any class of goods or services.

### **“Neutral” phrases**

Sometimes a “neutral” or axiomatic phrase is used as the trader’s name for his goods. Evidence is usually required to show that the phrase has a branding function. Specifically, an applicant will have to show by evidence that the public has been

educated as to its trade mark significance, and that it is recognised by the public as a trade mark. For example, THE TRAVELLER'S RIGHT TO KNOW was refused registration in the UK under section 11(1)(b) in the absence of use and recognition as a trade mark.

The mark HAVE A BREAK ([2004] F.S.R.2) is considered an origin neutral invitation to consume a snack when it is used in the course of promoting a snack food product. It is found, on a prima facie basis, to have no distinctive character in relation to snack products.

As regards evidence of use, we need to consider whether there has been use of a mark as a trade mark, and whether as a result of such use, the relevant class of persons actually perceive the product or service, designated exclusively by the mark applied for, as originating from a given undertaking. It is not sufficient that consumers may be caused to wonder whether or not this might be the case or simply be 'reminded' of the undertaking concerned", in this case KIT KAT.

The best evidence will be of the mark being used on its own, without any other trade mark, so that the slogan may be taken as an indication of origin and not merely as informational or otherwise non-trade mark matter.

## **House mark appearing in a slogan**

Adding a house mark to the slogan will improve its capacity to distinguish, for example, adding the house mark IWC in "IWC ENGINEERED FOR MEN", and HUDSON in "HUDSON FROM GREAT PEOPLE TO GREAT PERFORMANCE".

On the other hand, adding a house mark sometimes has the opposite effect of adding to the impression that the house mark is being used descriptively, such as in the use of the brand name DAIRY FARM in "Freshest milk from THE DAIRY FARM", and THE WAREHOUSE in "Style straight to you from THE WAREHOUSE".

## Comparison with other slogans and phrases

As a note of caution, consideration of other cases provides comparable value only. Instead, the question one should always ask is “is this mark registrable?”, not “how similar is this mark to one that has been registered or not been registered?” (see *BAGS OF STYLE*, a decision of the Appointed Person, Simon Thorley QC, 22 November 2001).

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