

Slogans and common 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.

Lack of distinctive character

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.

Common use in 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. The phrase LIKE NO OTHER is an example. Traders in all fields of activity can be expected quite legitimately, to wish to use it in promoting their goods or services, so that registration of LIKE NO OTHER by one trader is likely to embarrass others in advertising and conducting their business.

Consumers will also be aware that slogans are commonly used in trade for purely advertising purposes and not as readily perceive them as indications of trade source as they would traditional indications such as word brands, logos and device marks.

Value statements

Similarly, 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.

Common descriptive use

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 essential features, 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 IN DAY OUT would be too readily and aptly applicable to goods intended to be used or consumed daily, such as dairy produce, cereals and dietetic and health supplements, 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 IN DAY OUT 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 the quality of the goods.

“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.

See also *Societe des Produits Nestle SA v Mars UK Ltd* [2002] EWHC 2533 (Ch) where the slogan HAVE A BREAK failed to qualify on the evidence filed. What it needed to show was that “the trade mark has come to foster a concrete expectation among customers that the goods originate from one undertaking, not just 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, but sometimes this 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

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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