

SLOGANS

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1 Introduction

This chapter is concerned with the registrability of slogan marks.

2 Relevant Legislation

The Trade Marks Act [Cap. 332, 2005 Ed.]

Absolute grounds for refusal of registration

7. —(1) The following shall not be registered:

(b) trade marks which are devoid of any distinctive character;

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services;

(2) A trade mark shall not be refused registration by virtue of subsection (1) (b), (c) or (d) if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.

3 THE TEST FOR REGISTERING SLOGANS

The test for registering slogans should be no different than that for other types of marks and it would not be appropriate to apply to slogans a stricter test than that applicable to other types. An objection that the mark is lacking in distinctiveness should not be raised even if a mark lacks imagination or originality. Notwithstanding this, it should also be noted that slogans may not be so readily accepted by the general public as an indication of trade source since slogans are often used for advertising purposes, unlike traditional signs such as words, logos and figurative marks. Very often, slogans are incapable of serving as badges of origin since they consist of highly descriptive and non-distinctive material.

As a general guide, the following should be considered when examining slogan marks :

- A trade mark does not need to be original or imaginative to be distinctive.
- The obviousness of the description may not necessarily be fatal to the mark.
- The mere fact that the mark is composed of a well-known phrase will not result in a refusal (unless the phrase also designates an essential characteristic of the goods or services).

4 SLOGANS OBJECTIONABLE UNDER SECTION 7(1)(c) OF THE ACT

Slogans which consist exclusively of terms which may serve, in trade, to designate the characteristics of the goods and services are not registrable. Such characteristics would include the “quality” as well as “intended purpose” of the goods or services.

Slogans which include the applicant’s trade mark will not consist exclusively of a sign which may be used in trade to designate characteristics of the goods and services, eg, LUCENT TECHNOLOGIES WE MAKE COMMUNICATIONS WORK (Class 9) will be acceptable prima facie as it is distinctive.

The following are instances when the slogan would be objectionable.

(a) Normal way of referring to the goods or services or of representing their essential features

Would an average speaking English consumer regard it as a normal way of referring to the goods/services or of representing their essential features?

Not acceptable:

MAKING PROPERTY WORK for printed publications relating to property, property portfolio management, property development, property services and urban regeneration in Class 16

As the mark is not an unusual way of describing the goods, the public would not be able to distinguish them from those provided by other undertakings. For example, a magazine that is entitled **MAKING PROPERTY WORK** sends a very clear and unambiguous message about its subject matter and tells the reader that the magazine may help him in making property work for him. The mark would be perceived as merely advertising or promotional matter.

NOBODY KNOWS COLOR BETTER for upholstery fabric, drapery fabric, decorative trim; bed coverings...in Class 24

The phrase is merely a laudatory statement reflecting the trade mark owner’s knowledge and expertise in respect of the colour of the goods claimed as well as his knowledge and expertise in respect of fabrics incorporating different colours. The phrase should be free for use for use by other traders to use in advertisement to reflect a desirable characteristic (eg, quality), of their goods, such as fabrics of superior colour quality.

The fact that the slogan is not literally true may render the mark non-registrable as consumers are somewhat accustomed to a certain amount of exaggeration in advertisements and would not see it as a trade mark indicating trade origin.

Acceptable:

THE PRINCIPLE OF COMFORT for furniture

Although the message conveyed is clear, it is not usual or common for the word “comfort” to be combined with “The Principle of”.

(b) Common descriptive phrases

Is it a descriptive phrase which is commonly used to designate the essential characteristics of the goods/services?

Not acceptable:

THE ULTIMATE CAR COLLECTION for printed matter; publications, magazines, books....in Class 16

The phrase as a whole indicates goods relating to a large or impressive range or selection of cars. Although the lack of originality in the phrase per se does not make the mark non registrable, it is a common descriptive phrase which other legitimate traders may also wish to use, for example, as the title of a magazine or publication whose subject matter relates to a collection of quality cars or a collection of a wide range of cars.

Acceptable:

JUST DO IT for sports shoes in Class 25

Although the mark is a well-known phrase, it does not designate an essential characteristic of the goods and is thus registrable.

(c) Normal use in advertising

It should be noted that in advertising, it is customary to use short-hand when promoting the goods or services.

Not acceptable:

WHERE ALL YOUR FAVOURITES COME TOGETHER for confectionery; chocolate; chocolate products... in Class 30

The phrase is not invented and is but just a sequence of common ordinary dictionary words which would easily come to mind in order to convey a promotional message. The mark as a whole would be perceived by the general public as no more than a promotional statement that the package contains a variety of confectionery items which are thought to be consumer favourites. Further, the mark is also a natural

abbreviation for the longer expression “This is where all your favourites come together in one box”.

Acceptable:

FROM THOUGHT TO FINISH in Classes 9, 16, 35, 41 & 42

The mark is a play on the well-known phrase “From start to finish”. However, as it is not a normal means of designating goods and services in the development field, the mark was considered imaginative and acceptable.

(d) Ambiguity

As seen in the DOUBLEMINT case, the fact that a phrase is ambiguous is an irrelevant consideration; the phrase is not registrable if one of its possible meanings designates a characteristic of the goods / services concerned. However, the sign may still be registrable where the reference to the goods and services is unclear.

Acceptable:

THE NATURE OF WHAT’S TO COME for vitamins and dietary supplements for human consumption; medicated animal feed supplements... in Class 5

The mark was found to be registrable as the reference to natural products is sufficiently allusive. It is too vague to conclude what the mark is referring to.

5 SLOGANS OBJECTIONABLE UNDER SECTION 7(1)(b) OF THE ACT

A mark is objectionable under Section 7(1)(b) if it sends a message that could apply to any trader and is therefore not capable of individualising the goods or services of one trader. This is so even if it is free from objection under Section 7(1)(c).

In deciding whether the mark is devoid of distinctive character, the approach is to assess the mark as applied for and one should not take into consideration other devices or elements that are employed in use which may be distinctive. The test is **whether the average consumer for the goods will see the mark as a trademark without being educated to think so**. Whether a trademark is capable of fulfilling its essential function depends upon whether the mark has the capacity to function as a trade mark to consumers of the goods in question. **Consumers will be aware that slogans are commonly used in trade for purely advertising purposes and may, therefore, not accept a slogan as an indication of trade source as readily as they would a traditional indication of trade source, such as a word, logo and figurative mark**. On assessing the reaction of the consumer to the mark, use in advertising the goods and use on packaging may be relevant.

Section 7 (1) (b) is also not limited to trade marks refused under section 7 (1) (d) (i.e. trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade). In other words, even if no other trader is currently using the slogan, the slogan may still be objectionable under section 7(1)(b). The scope of section 7(1)(b) means that the trade mark fails to distinguish the goods/services of one trader from the goods/services of another and the distinctive character of a mark must be assessed in relation to the goods/services to which it is applied and the perception of the average consumer.

The following suggests the types of areas where an objection might be relevant (non-exhaustive).

(a) Value/Inspiration/Motivational Statements

Value/inspiration/motivational statements which are straightforward and could apply to any undertaking are devoid of any distinctive character, eg. CARING FOR THE ENVIRONMENT.

(b) Customer Service Statements

Straightforward statements about customer service that could apply to any undertaking are also devoid of any distinctive character, eg. WHERE CUSTOMERS COME FIRST.

(c) Promotional Statements and normal means of marketing the goods or services

Where slogans are concerned, although they need not be original or imaginative to be distinctive, grammatically incorrect language would not lead directly to distinctiveness. It is also to be noted that the elliptical construction of the mark does not add to the distinctiveness of the mark as the average consumer is accustomed to the use of abbreviation in the promotion of goods and services.

REAL PEOPLE, REAL SOLUTIONS for technical support services for the computer industry in Class 42 is devoid of distinctive character as it consists of a sequence of ordinary dictionary words which will be easily understood by the public as signifying that the applicant's services consist in providing pragmatic solutions devised by and for real people. Without education, the sign will be perceived by the relevant public as a promotional slogan, rather than as a trade mark.

LOOKS LIKE GRASS...FEELS LIKE GRASS...PLAYS LIKE GRASS for synthetic surfacing consisting of ribbons of synthetic fibres in Class 27 was also objected to for the same reason.