

SLOGANS

Copyright © 2022 Intellectual Property Office of Singapore.

You may download, view, print and reproduce this document without modifications, but only for non-commercial use. All other rights are reserved. This document and its contents are made available on an "as is" basis, and all implied warranties are disclaimed. The contents of this document do not constitute, and should not be relied on as, legal advice. You should approach a legal professional if you require legal advice.

This Work Manual Chapter (Version 3.1) has been updated on 11 November 2022. This update seeks to ensure that the cited legislation and corresponding references in the chapter are current, as a result of the legislative amendments and fee updates implemented on 29 April 2022. There are no substantive amendments made to the previous Version 3, June/2017.

SLOGANS

Contents	Page
1. INTRODUCTION	2
2. RELEVANT LEGISLATION.....	3
3. THE TEST FOR ASSESSING THE REGISTRABILITY OF SLOGANS.....	4
4. SLOGANS OBJECTIONABLE UNDER SECTION 7 OF THE ACT	5
4.1 Objection under section 7(1)(c) of the Act.....	5
4.2 Objection under section 7(1)(b) of the Act.....	5
5. FACTORS TO BE CONSIDERED IN ASSESSING THE REGISTRABILITY OF SLOGANS	6
5.1 Normal or common way of referring to the goods and/or services of their characteristics.....	6
5.2 Pure promotional statements	8
5.2.1 Abbreviated/ Ungrammatical slogans	10
5.2.2 Exaggeration	11
5.3 Value statements	12
5.4 Inspirational or motivational statements.....	12
5.5 Customer service statements	13
5.6 Commonplace salutations.....	13
5.7 Personal statements	14
5.8 Use of slogans by other traders	14
6. ENHANCING REGISTRABILITY OF SLOGANS	15
6.1 Ambiguity	15
6.2 Inclusion of “house” mark.....	16
6.3 Overcoming absolute grounds: acquired distinctiveness.....	16

1. INTRODUCTION

This chapter is concerned with the registrability of slogan marks.

2. RELEVANT LEGISLATION

Trade Marks Act 1998 (2020 Rev. Ed.)

Absolute grounds for refusal of registration

7. – (1) The following must 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 must 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 ASSESSING THE REGISTRABILITY OF SLOGANS

The fact that slogans may be used for advertising and promotional purposes does not exclude the registration of slogans as trade marks.

The test for assessing the distinctive character of slogans under the Trade Marks Act (the “Act”) is no different than that for traditional signs such as words, logos and figurative marks. It would not be appropriate to apply criteria which are stricter than those applicable to these traditional signs to slogans.

However, slogans may not be so readily accepted by the relevant public as an indication of trade source because of their inherent promotional and advertising quality, unlike traditional signs such as words, logos and figurative marks.

In other words, the perception of the relevant public is not necessarily the same in relation to each of those categories of marks, and it may therefore prove more difficult to establish the distinctiveness of marks comprising slogans than traditional signs. In assessing whether a slogan qualifies as a badge of origin, the Registry may take account of the fact that average consumers are not in the habit of making assumptions about the origin of goods or services on the basis of slogans (see *Case C-64/02 P, OHIM v Erpo Möbelwerk*).

As a general guide, as with any sign for which registration is sought, the following should be considered when assessing whether a mark comprising a slogan qualifies for registration under the Act:

1. The distinctiveness of a mark must be assessed, firstly, by reference to the goods and services in respect of which protection is sought and, secondly, by reference to the way in which the mark is perceived by the relevant public, constituted by average consumers of those goods or services.
2. A mark must not be registered if at least one of the possible meanings of the mark is capable of designating a characteristic of the relevant goods or services.
3. The fact that no one else uses the mark does not make the mark automatically distinctive.
4. The obviousness of the description need not be fatal to the application if the mark is an unusual way of conveying a descriptive message.
5. It is not necessary for the mark to display ‘imaginativeness’ or even ‘conceptual tension which would create surprise and so make a striking impression’ in order to have the minimal level of distinctiveness.

4. SLOGANS OBJECTIONABLE UNDER SECTION 7 OF THE ACT

Marks comprising slogans may be objectionable under section 7(1)(b) and/or (c) of the Act.

4.1 Objection under section 7(1)(c) of the Act

A slogan which consists exclusively of terms which may serve, in trade, to designate the characteristics of the goods and/or services is not registrable. Such characteristics would include the “quality” as well as “intended purpose” of the goods or services.

Not acceptable

PROPER SIZE. PERFECT FIT.

in respect of clothing and shoes

Not acceptable

EDUCATION IS OUR BUSINESS

in respect of education services

4.2 Objection under section 7(1)(b) of the Act

The fact that a slogan does not convey any information with regard to the nature of the goods or services concerned does not mean that it possesses an inherent capacity to distinguish.

In other words, a slogan that is not exclusively descriptive of the relevant goods and services may nevertheless be devoid of any distinctive character, that is, it is incapable of denoting the trade origin of the goods and services.

It should be noted that the grounds of distinctiveness and descriptiveness, although overlapping to some extent, are independent grounds for refusing registration and should be separately examined and considered.

Not acceptable

WHERE BRANDS MEET PEOPLE

in respect of advertising, publicity and brand
management services

Not acceptable

THE DOCUMENT COMPANY

in respect of paper products and paper
manufacturing services

5. FACTORS TO BE CONSIDERED IN ASSESSING THE REGISTRABILITY OF SLOGANS

5.1 Normal or common way of referring to the goods and/or services of their characteristics

Slogans are deemed descriptive if they consist of a word combination that an average consumer would regard as a normal or common way of referring to the goods and services or of representing their essential features.

Not acceptable

MAKES LIFE BETTER

- Class 7: Machines and machine tools, among others
 Class 9: Apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; compact discs, DVDs and other digital recording media, among others
 Class 11: Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes, among others

(Re an Application for a mark “MAKES LIFE BETTER” by Aki Habara Electric Corporation Pte Ltd in Classes 7, 9 and 11, [2004] SGIPOS 13)

The mark was objected to under sections 7(1)(b) and 7(1)(c) of the Act.

The mark was found to be non-distinctive on the basis that it was unable to distinguish the goods claimed from goods of other traders in the absence of any prior use. The relevant consumer would have to be educated by the salesman that the slogan was the brand name of the claimed goods. It was held that while the words “Makes Life Better” did not describe what the products are, they described “what can be attained by using these electronic products – a better life”, thus designating the kind of goods and quality of the goods or intended purpose of the goods under section 7(1)(c) of the Act.

Not acceptable

HOME CALLS FOR COMPUTERS

- Class 37: Repair, maintenance and installation services
 Class 42: Design and development of computer hardware and software services

(Decision of the Intellectual Property Office of New Zealand, Trade Mark Application No. 802604)

The mark was objected to under, among others, section 18(1)(c) of the New Zealand Trade Marks Act 2002 (which is equivalent to section 7(1)(c) of the Act).

The mark was found to “simply describe the nature of the services for which the Applicant sought registration”, and was also “apt for [the] normal description of the Applicant’s services” for which registration was sought. It was further decided that the average consumers would

“immediately understand” that the Applicant provided home call services for computers, and hence the mark was objectionable.

Not acceptable

GUARANTEED TO KEEP YOU DRY

- Class 24: Textiles and textile goods, not included in other classes; bed covers; table covers
 Class 25: Clothing, footwear, headgear

(Decision of the Intellectual Property Office of Hong Kong, Trade Mark Application No. 300709984)

The mark was objected to under, among others, section 11(1)(c) of the Trade Marks Ordinance (Cap.559) of Hong Kong (which is equivalent to section 7(1)(c) of the Act).

The mark was found to be descriptive of the goods claimed, because the combination of the words was a mere assurance to the relevant consumer that the goods would prevent them from getting wet. The message conveyed by the mark was therefore “loud and clear”.

In light of the clear message being conveyed by the mark, it will be perceived as a designation of a characteristic of the goods in question and not as an identifier of trade source. The mark was on this basis also found to be non-distinctive.

Acceptable

DAZ PRINZIP DER BEQUEMLICHKEIT (“THE PRINCIPLE OF COMFORT”)

- Class 8: Tools (hand-operated); cutlery
 Class 12: Land vehicles and parts therefor
 Class 20: Household furniture, in particular upholstered furniture, seating, chairs, tables, unit furniture, as well as office furniture

(Case C-64/02 P, OHIM v Erpo Möbelwerk)

In the case above, although the message conveyed is clear, it is not usual or common for the word “comfort” to be prefaced with “The principle of”. The slogan, as a whole, is an unusual way of conveying a descriptive message.

5.2 Pure promotional statements

Slogans which the relevant public perceive as mere promotional statements and not indicative of the commercial origin of the goods and services in question cannot be registered.

This however does not mean that all promotional statements are devoid of distinctive character and not registrable.

An advertising slogan is likely to be distinctive if, apart from its promotional function, the public perceives it as an indication of the commercial origin of the goods or services in question.

Not acceptable

A UNIQUE EXPERIENCE...MINT

Class 30: Confectionery, chewing gum, bubble gum, candy, mints, drops and lozenges

(Case R 1733/2011-2, WM Wrigley JR Company v OHIM)

The mark was objected to under, among others, Article 7(1)(b) and (c) of the Community Trade Mark Regulation (CTMR) of the European Union (which is equivalent to section 7(1)(b) and (c) of the Act).

The mark was found to be non-distinctive on the basis that it was a plain and banal incitement to consumers to purchase the goods claimed based on a straightforward promise of their unique taste. On a holistic assessment, it was observed that the mark was self-explanatory that conveyed a laudatory message immediately discernible by the relevant consumer, that is, that the consumer would experience an extraordinary, unique and remarkable mint-flavoured taste sensation upon consuming the claimed goods. Accordingly, the mark could not be said to designate a specific commercial origin since it referred to a desirable feature of the goods claimed.

Not acceptable

Building Tomorrow's Enterprise

Class 35: Advertising, business management, business administration and office functions, among others

Class 36: Insurance, financial affairs, monetary affairs and real estate affairs

Class 38: Telecommunications, among others

Class 42: Design and development of computer hardware and software services, among others

(Case R 374/2014-2, Infosys Limited v OHIM)

The mark was objected to under, among others, Article 7(1)(b) of the Community Trade Mark Regulation (CTMR) of the European Union (which is equivalent to section 7(1)(b) of the Act).

The mark was found to be non-distinctive on the basis that apart from its promotional meaning, the slogan “Building Tomorrow’s Enterprise” did not contain any element that enables the relevant public to immediately perceive it as an indication of the commercial origin of the services sought to be registered.

Even though the mark possessed some graphical elements (that is, the positioning of the words and differences in colour), it was held that it was common for promotional purpose to use common graphical methods to mix the size and colours of the letters and words in a mark and to place the words one below the other, and that the public was used to seeing such banal features and would therefore not give these features any significance beyond a pure promotional function. Hence, the effect of the graphical elements was limited and was unable to divert the attention of the relevant public from the clear and unambiguous laudatory meaning resulting from the expression “Building Tomorrow’s Enterprise”.

Not acceptable

FEEL THE DIFFERENCE

- Class 5: Infant foods; milk and milk powder for infants
 Class 29: Milk and milk products in this Class; other goods which include milk or milk products and ingredients

(Case R 2276/2011-2, A2 Corporation Limited v OHIM)

The mark was objected to under, among others, Article 7(1)(b) of the Community Trade Mark Regulation (CTMR) of the European Union (which is equivalent to section 7(1)(b) of the Act).

The mark was found to be non-distinctive as the meaning of the mark in connection with the claimed goods did not amount to anything more than a plain laudatory message that the claimed goods are different from a competitor’s goods. It was observed that the mark did not constitute a play on words, nor did it possess any element of originality or resonance to make it easy to remember. Accordingly, it was decided that there was nothing in the expression beyond its obvious and promotional meaning to enable the relevant public to memorise it instantly as a distinctive mark for the goods concerned. The mark was therefore rejected because it was banal, with a clear and unambiguous meaning.

Not acceptable

BETTER MARKETS MAKE A BETTER WORLD

- Class 36: Financial services, namely institutional sales and trading, execution services, principle trading, liquidity providing, market making, and operating a market for matching buy and sell orders

(Case R 826/2013-1, KCG IP Holdings LLC v OHIM)

The mark was objected to under, among others, Article 7(1)(b) of the Community Trade Mark Regulation (CTMR) of the European Union (which is equivalent to section 7(1)(b) of the Act).

The mark was found to be non-distinctive. It was observed that the mark merely promoted the claimed services as providing “better (financial) markets, which in consequence, make a better world”. In other words, the mark would directly lead the average consumer to understand that “secure and reliable markets lead to empowered investors and efficient deployment of capital”.

In respect of the structure and wording of the mark, although there was a repetition of the word “BETTER” and alliteration of the letter “M” in the words “MARKETS” and “MAKE”, it was held that these characteristics were simple and popular in advertising language in respect of enhancing the overall promotional character of the expression, but did not assist the average consumer in regarding the mark as an identifier of trade source.

Acceptable

WE RESTORE, YOU RECOVER

- Class 37: Carpet upholstery and drapery cleaning, and spot and stain removal services; air-dust cleaning services; disaster restoration services, namely, restoring building interiors, carpet and furnishings damages by fire, water, smoke and other disasters; carpet repair services; commercial and residential building cleaning services;
- Class 40: Carpet, upholstery and drapery odour removal services; providing carpet and upholstery dyeing, tinting and colourising services; mould inhibition services of buildings and their contents.

(Case R 2197/2011-2, Rainbow International Carpet Dyeing and Cleaning Company v OHIM)

The mark was found to be registrable on the basis that the word combination did not consist conclusively of a sign which designated the services in question directly. Instead, it was observed that as a whole, the mark conveyed an “intention or promise on the part of the proprietors, and the effect of the promised restoration”, and did not imply a “sufficiently direct and specific relationship between the mark and services (for which registration [was] sought)”.

Additionally, it was determined that the mark “openly embodied a play on words” – while the primary clause “WE RESTORE” merely informed the average consumer that the applicant is involved in restoration services, the secondary clause “YOU RECOVER” had an “unexpected meaning”, because it could be interpreted as the average consumer “recovering” a lost item or one’s health, stability or peace of mind after a shock, illness, disappointment or trauma. Accordingly, it was found that the mark had a double meaning, and this linguistic trick was “surprising and unexpected”, therefore imparting distinctive quality to the mark as a whole.

5.2.1 Abbreviated/ Ungrammatical slogans

It is to be borne in mind that in advertising, it is customary to use shorthand when promoting goods and services to capture the attention of potential customers. Phrases used in advertising may not always be confined to strict grammatical usage.

Therefore, the fact that a slogan is abbreviated or not strictly grammatical does not mean that the mark possesses the sufficient distinctive character for registration.

Not acceptable

ONLY JEANS WEAR

Class 25: Clothing, footwear and headgear

(Case R 153/2000-1, Holdingselskabet af 25/3-1983 A/S v OHIM)

The slogan consists of three ordinary English words which immediately inform consumers that the goods in question are made from jeans material. Although the expression is ungrammatical, this does not outweigh the descriptive nature of the mark so as to impart distinctive character for the purposes of registration.

Not acceptable

AMAZING STARTS NOW

Application filed in respect of goods in Classes 7, 9 and 11

(Case R 1124/2013-1, Samsung Electronics Co. Ltd v OHIM)

The mark was objected to under, among others, Article 7(1)(b) of the Community Trade Mark Regulation (CTMR) of the European Union (which is equivalent to section 7(1)(b) of the Act). The slogan conveys a promise that the claimed goods will immediately provide an amazing experience to the consumer. The relevant consumer would generally not expect advertising slogans to be precise or to fully describe the characteristics of the goods and services. Rather, it is a common characteristic of advertising slogans to merely convey abstract information of the claimed goods and services. In other words, it is customary in trade to use short and succinct phrases when promoting the goods or services so as to capture the attention of potential customers. They are not intended to provide a full picture about the goods or services being advertised.

In this case however, the fact that “amazing starts now” contains a grammatical flaw does not alter the perception of the relevant public to view the expression as laudatory. The flaw does not stop the consumer from understanding the expression nor does it add any element which would open the expression to any additional interpretation.

5.2.2 Exaggeration

An average consumer is reasonably well-informed, observant and circumspect.

Such a consumer would be exposed to a wide range of techniques used by traders in advertising their goods and services. The consumer will be aware that exaggerated expressions are

commonly employed by traders for advertising purposes. Such expressions would not, however, be perceived by consumers as an indicator of trade origin.

Not acceptable

ENDLESS POSSIBILITIES

Class 18: Handbags; covers for interchangeable handbags; purses, general tote bags, luggage, waist packs, and duffle bags

(Case R 122/2013-1, Miche Bag, LLC v OHIM)

The mark was objected to under, among others, Article 7(1)(b) of the Community Trade Mark Regulation (CTMR) of the European Union (which is equivalent to section 7(1)(b) of the Act).

The mark was found to be non-distinctive as the relevant consumer would understand the expression “**ENDLESS POSSIBILITIES**” immediately as a laudatory indication that the claimed goods provided the consumer with manifold appearances, functions and/or facilities. Additionally, it was observed that in relation to handbags with multiple functions and facilities, the mark clearly and directly indicated, with some promotional exaggeration, that the average consumer had endless possibilities to change their appearance and/or functions. It was also determined that the mark “delivered a laudatory message, which, albeit abstract, can be related to the goods, and the relevant public [had] no reason to enter into any further analysis of interpretation which would endow the expression with a certain originality and resonance which [made] it easy to remember”.

5.3 Value statements

Value statements which are straightforward and could apply to any undertaking are devoid of any distinctive character.

For example, “**CARING FOR THE ENVIRONMENT**” for recycling services, “**LOVE PEOPLE, RESPECT PEOPLE**” for consultancy services, “**CHERISH THE OLD**” for nursing home services, and “**FIGHT FOR JUSTICE**” for legal services would be examples of value statements which are objectionable as trade marks.

5.4 Inspirational or motivational statements

Inspirational or motivational types of slogans are considered to be non-distinctive particularly for services.

For example, “**GIVE YOUR BEST**” for sports coaching services, “**GO FOR IT**” for training services, “**UNLOCK YOUR POTENTIAL**” for education services and “**BELIEVE IN YOURSELF**” for counselling services would be examples of inspirational or motivational statements which are objectionable as trade marks.

5.5 Customer service statements

Simple and straightforward statements about customer service that could apply to any undertaking have no distinctive character, and thus objectionable as trade marks.

Not acceptable

SMARTER. BOLDER. FASTER.

Class 36: Real estate brokerage services

(Re Trade mark application number 1502579(36) “SMARTER. BOLDER.FASTER.” in the name of Century 21 Real Estate LLC, [2014] ATMO 15)

The mark was objected to under, among others, Article 7(1)(b) of the Community Trade Mark Regulation (CTMR) of the European Union (which is equivalent to section 7(1)(b) of the Act). The mark was objected to on the ground that it lacked inherent distinctiveness. It was found that any real estate brokerage, without improper motive, would wish to claim that their sales staff were “smarter, bolder, and faster”, and was therefore not distinctive of the Applicant.

Not acceptable

WITH YOU AT EVERY STEP

Class 41: Educational and training services relating to diseases and disorders in the field of neuroscience; arranging and conducting classes, seminars and workshops relating to diseases and disorders in the field of neuroscience;
 Class 44: Medical services in the field of neuroscience; medical information in the field of neuroscience.

(Case R 1572/2013-2, Novartis AG v OHIM)

The mark was objected to under, among others, Article 7(1)(b) of the Community Trade Mark Regulation (CTMR) of the European Union (which is equivalent to section 7(1)(b) of the Act). There is nothing in the slogan that might, beyond its obvious promotional meaning, enable the relevant consumer to memorise it easily and instantly as a distinctive mark for the services concerned. Educational and medical services are typically the kind of services where the client needs to be accompanied, and needs support at every step. The sign applied for is not being rejected merely because it is a promotional slogan, but rather because it is a banal informative slogan, with a clear and unambiguous laudatory meaning.

5.6 Commonplace salutations

Salutations such as “**HAPPY BIRTHDAY TO YOU**”, “**THANK YOU SO MUCH**”, “**SO LONG FAREWELL**” and “**MERRY CHRISTMAS**” are prefatory greetings or well-wishing statements which are often used on many goods and services.

Consumers are more likely to perceive such slogans as a common salutation rather than a trade mark denoting trade origin of the goods and services claimed. Therefore, these salutations would be objectionable as trade marks.

5.7 Personal statements

Personal statements in the form of slogans such as “**I ♥ SINGAPORE**”, “**HERE COMES TROUBLE**”, “**DO YOU LIKE ME**” are often used on goods such as T-shirts, bandanas or badges.

Consumers are more likely to perceive such slogans as a personal statement about the wearer/user or a personal statement by the wearer/user of the goods claimed rather than a trade mark denoting the trade origin of the goods. Therefore, these personal statements would be objectionable as trade marks.

5.8 Use of slogans by other traders

The assessment of the registrability of an expression is to be based on the nature of the trade mark itself – not by reference to whether traders other than the applicant are using the expression in relation to similar goods and services.

However, if other traders are using the expression, that fact may confirm a finding that the mark is an expression of everyday speech, used in common parlance, or uses no element of fancifulness, sense of humour or surprise. Therefore, such an expression lacks the inherent capacity to distinguish the applicant’s goods and services from those of others.

Even if the applied-for expression has not been used by other traders, the applicant’s pioneer use of it does not attribute to the overall distinctiveness of the mark. Assessment of distinctiveness of a mark is based on whether it is perceived as a badge of trade origin.

6. ENHANCING REGISTRABILITY OF SLOGANS

The fact that slogans may be used for advertising and promotional purposes does not exclude the registration of slogans as trade marks.

To enhance the prospects of registrability of a slogan mark, it is essential that there must be elements in the slogan which assist the relevant consumer to regard the slogan as an indicator of source of the goods and services claimed, beyond the inherent promotional nature of the slogan.

6.1 Ambiguity

Ambiguity may enhance the prospects of acceptance of a slogan mark.

However, the mere fact that the meaning of a mark is ambiguous or is not strictly grammatically accurate does not necessarily mean that the mark is registrable.

A slogan with two meanings will be objectionable if one of them describes a characteristic of the goods or services.

Not acceptable

GIVING YOU YOUR PERSONAL SPACE

Class 39: Provision of storage facilities for use by others

Example 6.1.1

In the example above, there could be more than one interpretation of the mark. It can yield the meaning of “giving a person space to breathe or to think through things”, or the literal meaning of “providing personal storage space”. Considering that one of the meanings is descriptive of the intended services (“provision of storage facilities for use by others”), the mark will be objected to under section 7(1)(c) of the Act.

Acceptable

OWN THE TREE

Class 8: Hand tools and implements (hand-operated); axes.

Example 6.1.2

The expression applied for constitutes a play on words and is imaginative. The linguistic trick is surprising and unexpected, and the mark requires a degree of interpretation of the relevant public that is being exposed to it. The play on words can therefore be expected to set off a cognitive process in the minds of the relevant public.

Acceptable

SITEINSIGHTS

Application filed in respect of goods and services in Classes 9, 35 and 42

(Case R 879/2011-2, IgnitionOne N.V. v OHIM)

Example 6.1.3

The mark is found to possess some degree of originality and expressiveness that makes it easy to remember. It should be observed that ‘SITEINSIGHTS’ contains a play on words as the words ‘SITE’ and the part ‘SIGHT’ in ‘INSIGHTS’ are homonyms.

6.2 Inclusion of “house” mark

Generally, the addition of a house mark to a slogan may enhance the overall distinctive character of a slogan, and therefore enhance the prospect of registrability of a slogan, particularly where the house mark is itself, a distinctive trade mark.

For example, while “**HAVE A BREAK**” for chocolate confectionery may not be registrable, “**HAVE A BREAK, HAVE A KIT-KAT**” would be registrable on the basis that “KIT-KAT” as the house mark has distinctive character, and can impart a unique quality to the mark such as to enhance the overall registrability of the mark.

6.3 Overcoming absolute grounds: acquired distinctiveness

Notwithstanding that a mark may fall afoul of the grounds in section 7(1) of the Act, it is still acceptable for registration if it has acquired distinctiveness by virtue of the use made of it, as prescribed under section 7(2) of the Act.

In assessing the acquired distinctiveness of a mark, the following may be taken into account:

- (i) the market share held by the mark;
- (ii) how intensive, geographically widespread and long standing use of the mark has been;
- (iii) the amount invested by the undertaking in promoting the mark;
- (iv) the proportion of the relevant class of persons who, because of the mark, identify goods or services as originating from a particular undertaking;
- (v) statements from chambers of commerce and industry or other trade and professional associations.

The Registrar will 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 goods or services, designated exclusively by the mark applied for, as originating from a given undertaking (see *Windsurfing Chiemsee Productions v Boots (Case C-108/97)*). 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. 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.

Acceptable

NO MORE TEARS

Application filed in respect of goods in Classes 03 and 05

(Community Trade Mark application number 003429883; United Kingdom registration number 1500571)

Example 6.3.1

In the case above, the mark was refused on the basis that it would merely be perceived as a laudatory slogan informing that the goods are “gentle and will not sting or produce tears”. It was noted that the mark proceeded to registration in the UK and OHIM on the basis of distinctiveness acquired through use.

(Reference should be made to the Trade Marks Work Manual’s section on Evidence of Distinctiveness Acquired Through Use for more information.)