



Intellectual Property Briefing

Slogans – how to protect your brand equity

Slogans are becoming increasingly important tools in brand development and achieving customer recognition, but once you have created a catchy slogan or tag line how do you protect the goodwill this confers on your brand and stop others from cashing in on your reputation?

Following a number of recent UK and EU decisions, the UK Trade Marks Registry has recently updated its practice on accepting slogans for registration as trade marks.

What are the advantages of registering a trade mark?

A slogan may be protected by copyright, or, if it is represented in a particular style or as part of a logo, registered as a design. However, wider protection can be achieved by registering it as a trade mark, which gives the owner the right to prevent anyone else using that trade mark (or something confusingly similar to it) for the same type of goods or services for which it is registered.

One of the main advantages of registering a slogan as a trade mark is so that the owner can take immediate action to prevent infringement and seek compensation for any damage to its reputation. If the slogans are not registered as trade marks then, although the owner is not without protection, the legal process is much more difficult and costly with a greater burden of proof which means there is much less certainty of success.

Can a slogan be registered as a trade mark?

The good news is that slogans can be registered as trade marks. However they must have the capacity to “individualise” the goods and services of a particular business and not be comprised of signs or indications that describe those goods and services or their essential characteristics. In addition the usual requirements that the marks are not descriptive or devoid of distinctive character still apply.

Key recommendations

- If you use or intend to use a slogan which is not descriptive or laudatory and which is capable of identifying your goods and services and distinguishing them from other businesses, or if you have used a slogan for a long time, then you should consider registering it as a trade mark.
- You should always check to make sure that any slogans or other trade marks or brand names that you use (or intend to use) are not already being used by others and have not been registered as trade marks.

What slogans have been accepted for registration?

Some examples of slogans that have been accepted include:

- **OPEN POUR ENJOY LIFE ONCE MORE**
(for foodstuff)
- **TIME HAS QUALITY**
(for paints)
- **THE DIFFERENCE IS...THE QUALITY OF THE PROMISE**
(for insurance)
- **IT'S YOUR TURN TO PLAY**
(for cooking apparatus)
- **CATCH A WRINKLE IN TIME**
(for cosmetics)

In these instances the slogans were found to have the capacity to distinguish goods from one undertaking from those of other undertakings for the relevant goods or services because they were an unusual combination of words, a fanciful allusion or impenetrable.

However care needs to be taken, as "*...average consumers are not in the habit of making assumptions about the origin of products on the basis of such slogans*". This means that a slogan which serves a promotional function that is not obviously secondary to any trade mark meaning will be objectionable. This isn't a case of applying a higher evidential standard for slogans, compared to other marks, but merely recognition that the public is slower to recognise slogans as a badge of origin.

It is not necessary for a slogan to contain an additional element of imagination or originality for it to be accepted but because slogans are often used in advertising it is necessary to consider notional and fair use in that context. The fact that no one else is using the slogan does not necessarily mean that it will be accepted for registration.

So what obstacles are there to registering a slogan as a trade mark?

The Registry will object to the registration of a slogan if it is comprised of a word combination that a consumer would regard as a normal way of referring to the goods or services or of representing their essential features or intended purpose. However, the obviousness of the description need not be fatal to the application if the slogan is an unusual way of conveying a descriptive message. If your slogan is not a normal way of designating your goods or services, or a commonplace phrase then it is more likely to be accepted for registration.

- You should avoid using slogans which are already being used by others, consist of descriptive terms or which can be used in a general sense within the trade, as these will not be accepted for registration in most cases.

- When choosing a slogan you should also try to avoid using laudatory terms, motivational or inspirational statements in relation to services, statements which are purely for promotional or marketing purposes and any statements about the customer, as these will prove difficult to register and protect.

- It is important once you have registered a trade mark to monitor the activities of others and police, as failure to take action may dilute your brand and you may even lose your trade marks.

The Registry will consider the following in determining whether to accept a slogan:

- **Use of plain language:** to describe the intended purpose of the goods, even if the statement is not factually correct.
- **Use of common descriptive phrases:** which designate an essential characteristic of the goods or services.
- **Normal use in advertising:** in particular the use of shorthand when promoting the goods or services.

In considering these requirements it may be the case that ambiguous slogans have a better chance of success, **BUT** where a slogan has two meanings it will not be accepted for registration if one of them is a description of the goods or services.

Even if all of these tests are met, the Registry may still find that a slogan is devoid of any distinctive character because it sends a message that could apply to **ANY** undertaking and is not therefore capable of individualising the goods or services of a particular business.

The following types of slogans have been identified as lacking distinctive character:

- **Value statements:** straightforward value statements that could apply to any undertaking.
- **Motivational statements:** inspirational or motivational statements, particularly for services, although an opaque reference in respect of goods may be acceptable.
- **Customer service statements:** straightforward statements about customer service that could apply to any undertaking.
- **Purely promotional statements:** use of a well-known advertising strap line followed by the name of the goods that fulfil a purely marketing function.
- **Statements about the customer:** slogans used to decorate goods, particularly clothing, are unlikely to be perceived as a sign of trade origin.

Nevertheless, it may also be possible to register a slogan if it has been used for a long time and acquired a level of distinctiveness through such use.

At Berg Legal we provide a full range of branding services including trade mark registrations. To discuss how we can assist you with these issues, please contact either Stephen Foster, Head of our Corporate and Commercial Department at stephenf@berg.co.uk or Paul Tomlinson who is a solicitor in the IP team at pault@berg.co.uk. Alternatively you can call Stephen or Paul on 0161 833 9211.

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