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Is there such a thing as a trademark for slogans?

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Preface

When I chose the topic ‘Is there such a thing as a trademark for slogans?’ as my final scientific project of my Master’s programme at Lund University I was far from a mind-set answer to this seemingly simple question. The more I proceeded in my research in the subject and the more investigative effort I put on, the further away I appeared to move from either, ‘Yes’ or ‘No’ as an answer. This was when I learned to accept a complicated solution to a straightforward query. And I acknowledged the chance to thereby fit both of the possible results at once. I impartially prepared to disclose any result: Ad utrumque.

Reaching a more profound stage of my work, I realised the need to discuss the particulars in order to deliver a basic answer. To me, this is what scientific work is about.

I would like to thank the Office for Harmonization in the Internal Market, especially OHIM Academy, for providing the opportunity to present my Master’s thesis at OHIM Universities Network 2014. The discussions with the participants during the event gave me further inspirations on the hot topic whether trademarks for slogans exist. Finally, I would like to thank my supervisor Ulf Maunsbach for guidance during the course of research and methodical advice.
### Abbreviations

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<thead>
<tr>
<th>Abbreviation</th>
<th>Full Form</th>
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<tbody>
<tr>
<td>appl.</td>
<td>application</td>
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<tr>
<td>BGH</td>
<td>Bundesgerichtshof (Federal Court of Justice of Germany)</td>
</tr>
<tr>
<td>BPatG</td>
<td>Bundespatentgericht (German Patent Court)</td>
</tr>
<tr>
<td>CJEU</td>
<td>Court of Justice of the European Union</td>
</tr>
<tr>
<td>DPMA</td>
<td>Deutsches Patent- und Markenamt (German Patent and Trademark Office)</td>
</tr>
<tr>
<td>e.g.</td>
<td>exempli gratia (for example)</td>
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<tr>
<td>EU</td>
<td>European Union</td>
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<tr>
<td>etc.</td>
<td>et cetera (and so on)</td>
</tr>
<tr>
<td>GC</td>
<td>General Court of the European Union</td>
</tr>
<tr>
<td>ibid.</td>
<td>ibidem (in the same place)</td>
</tr>
<tr>
<td>i.e.</td>
<td>id est (that means)</td>
</tr>
<tr>
<td>MarkenG</td>
<td>Markengesetz (German Trademark Act)</td>
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<tr>
<td>no.</td>
<td>number</td>
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<td>OHIM</td>
<td>Office for Harmonization in the Internal Market</td>
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<td>para.</td>
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<td>sec.</td>
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<td>WIPO</td>
<td>World Intellectual Property Organization</td>
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Part A: Introduction

I Subject
A trademark helps customers to distinguish goods and services of a company from those of others. It can create value and growth for a company. Recently, the number of trademark applications in the Community trademark system has risen immensely - in 2012, 107,900 trademark application were filed, Two years before, applications totaled 98,217 and only 49,503 a decade earlier.\(^1\) The growing popularity of trademarks and their increased market implementation is remarkable. The same trend may be observed for slogans that are more and more frequently marketed by undertakings. They make it easier for consumers to associate a certain product with a particular undertaking and to get an idea about the marketed product and the supplier’s purpose. However, the protection of a motto or phrase poses particular difficulties by cause of their distinct nature. But since slogans are of high value for undertakings, the question arises whether slogans can be protected. The thesis at hand will analyse the protection of slogans as trademarks.

II Purpose
The thesis at hand is based on the question whether such a thing as a trademark for slogans exists. The purpose of this thesis is to assess the legal status of slogans and their chances to receive trademark protection. The situation of legislation and jurisdiction in Europe and Germany is to be object of the analysis. German practices were chosen as a comparison to European practices because Germany is the member state of the European Union with the most exercise on the registration of slogans as trademarks. It will be examined what kind of criteria has been used by all relevant decision making bodies of the European and German system and whether those bodies take the same or different approaches. From this analysis, criteria that increase and diminish the distinctiveness of a slogan will be collated.

Included in the analysis is the purpose to determine whether slogans should be, compared to other word marks, subject to an extraordinary assessment.

III Method

The thesis will be approached by the traditional legal dogmatic method and the comparative method. The European and German protection of slogans as trademarks will be compared. For this reason, both the German trademark legislation and the European Trademark Directive will be introduced and analysed. Moreover, international agreements which form a global minimum consensus in this matter will be presented. For the purpose of determining the relevant provisions of trademark law in the context of slogans, basic provisions of the Trademark Directive\(^2\) and Regulation\(^3\) will be summarized.

After having provided this legal background, the legislations at issue will be used to examine applications for registration of slogans before the Office for Harmonization in the Internal Market (hereinafter: OHIM) and the German Patent and Trademark Office (Deutsches Patent- und Markenamt, hereinafter: DPMA). Both authorities decide as the first instance on trademark applications and partly as appeal institution too. OHIM publishes most of their decisions on the webpage whereas the DPMA does not make its decisions accessible. The reasoning of those decisions that were not accessible was developed from the argumentation of the courts.

Moreover, the OHIM Guidelines that are used by OHIM in the course of examination will be part of the analysis. Those Guidelines are not legally binding. Nevertheless, since they are yearly updated and take into account all recent decisions of the European courts, they provide a good measure for the assessment of trademark registrations.

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In addition to that, cases before the General Court of the European Union (hereinafter: GC) and accordingly the former and renamed Court of First Instance as well as the Court of Justice of the European Union (hereinafter: CJEU) will be analysed. For the purpose of comparison, decisions of the German Patent Court (Bundespatengericht, hereinafter: BPatG) and the Federal Court of Justice of Germany (Bundesgerichtshof, hereinafter: BGH) will be analysed respectively. Those decisions are announced as official documents on the webpage of the courts. German courts do not name the applicant whereas European courts give the precise name of the undertaking that applied for trademark protection. Consequently, the applicants’ names cannot be included in the analysis of German jurisprudence except for the case when the decision has been discussed publicly with the applicant’s name.

Opinions from Advocate Generals, who advise the courts on legal matters, are not legally binding. They will be used to show a particular standpoint on a crucial matter of law.

From the conducted analysis of Community trademark applications and trademark applications in Germany, criteria that influence the distinctiveness of a slogan will be developed. Criteria from all relevant decision-making bodies will be included even though – in the case of an appeal – only rulings from the highest instances are binding. This can be justified by the fact that those criteria should not be part of a list of absolute criteria but only indicating the likelihood of distinctiveness. Besides, those authorities decide on trademark registration in reference to trademark legislation and delivering an in-depth discourse of trademark applications.

During the course of analysis, the traditional legal method approach will be used taking into account legislation and judicial decisions as well as legal writings concerning both European and German practices of trademark protection for slogans.
IV Limitations

The thesis at hand focuses on the registrability of slogans. Infringements of trademark rights will consequently only be mentioned briefly. An emphasis will be put on the more recent status of protection of slogans focusing on the decisions from the past twenty years. Thus case law dating back longer is fairly limited and will be only used in order to show differences in the past and current jurisprudence. The current case law has either overruled or confirmed the case law from the past. The latter is consequently less relevant. Moreover, unfair marketing practices are fairly limited.
Part B: The Basics of Trademark Law

I Functions of Trademarks

Trademarks are signs that are capable of distinguishing the products or services of an undertaking from those of another. Those signs can be words, characteristic shapes of a product or even colours or sounds. Registering a trademark confers the exclusive right on the owner to use the sign. The owner is therefore able to promote the reputation of the mark in knowledge that others will not be able to exploit the mark’s reputation. Trademark rights are consequently essential for the concept of undistorted competition in the market.\(^4\) The CJEU developed the ‘essential function’ of a trademark for the first time in *Hoffmann* as to guarantee the identity of the origin of the trade-marked product to the consumer, by enabling him without any possibility of confusion to distinguish that product from products which have another origin.\(^5\) The second function of a trademark is to give the owner the exclusive right to market goods which are protected under the mark.\(^6\) Additional functions were acknowledged by the CJEU, e.g. the function to guarantee the quality of goods and services and the functions of communication, investment and advertising.\(^7\) However, the function of identifying the origin of the goods or services remains the essential and most important function.

II Harmonisation of Trademark Law

Trademark law has been harmonised in Europe, both through international agreements and European secondary law. Nowadays, a minimum standard of protection exists globally.

\(^4\) Case C-206/01 *Arsenal FC v Reed* [2003] para. 47.
\(^5\) Case C-102/77 *Hoffmann La-Roche v Centrafarm* [1978] para. 7.
\(^6\) *Tritton*, Intellectual Property in Europe (Thomson Sweet & Maxwell 2008) r. 3-002.
\(^7\) Case C-487/07 *L’Oréal SA v Bellure NV* [2009] para. 58.
II.1 International Agreements

II.1.(a) Paris Convention
On the international side, the Paris Convention precludes the contracting states from discriminating between its nationals and nationals of other contracting states. It creates common standards on substantive trademark law, whereas the procedural trademark law is to be determined by national laws. All European countries have acceded to the Paris Convention but it has only force of law when it is enacted in an appropriate way in the domestic legislation. Attention is paid to Article 6bis which provides protection for marks that are ‘well-known’. The owner of well-known trademarks is entitled to prevent the registration or the use of a mark which constitutes a reproduction, an imitation, or a translation, liable to create confusion. This protection is primarily for jurisdictions which do not otherwise afford protection to unregistered trademarks. The scope of Article 6bis of the Paris Convention is limited to the use or registration of marks confusingly similar which are used on the same or identical goods to those for which the well-known mark has been used.

II.1.(b) TRIPS
TRIPS, the Agreement on Trade Related Intellectual Property which binds all members of the World Trade Organization, sets the minimum requirements for trademark protection. It regulates all basic issues of trademark law, e.g. registrability, the rights conferred by a mark, the protection and the requirement of use. TRIPS provides a number of additional obligations over the protection required by the Paris Convention. Article 16 of TRIPS extends protection for well-known marks, as provided by Article 6bis of the Paris Convention, to services and even dissimilar goods or services. Member States are nevertheless free to provide for more extensive protection.

8 Tritton, r. 3-006.
II.1.(c) Madrid Protocol

When the EU discussed the implementation of the Community trademark, the World Intellectual Property Law Organization (hereinafter: WIPO) introduced the Madrid Protocol for the international registration of trademarks. The European Community is a signing applicant of the Madrid Protocol. However, it is of minor importance for the thesis at hand focusing on European and German legislation.

II.2 European Secondary Law


The Community trademark system has been designed to co-exist with the national trademark systems which are necessary for undertakings that do not wish to protect their marks at EU level. The Council emphasised when addressing the financial perspectives of OHIM in 2007 that the establishment of OHIM had contributed substantially to strengthen the competitiveness of the EU.\(^9\)

\(^9\) Press Release on 2801\(^{st}\) Council Meeting Competitiveness of 21 and 22 May 2007 p. 44.
Over the years, due to decisions of OHIM and, if appealed, the GC and the CJEU, a substantially uniform interpretation of the Trademark Directive and the Regulation has been developed.

Recently, the European Commission proposed amendments of the European Trademark Legislation. The proposals have the aim to foster innovation and economic growth by making the trademark registration system all over the EU more accessible and efficient for business in terms of costs and complexity, increased speed, greater predictability and legal security. The proposals are based on a study by the Max Planck Institute for Intellectual Property and Competition Law, which was published on 8 March 2011. The Commission proposed inter alia to remove the requirement of ‘graphic representability’ in Article 4 of the Regulation and to replace it by ‘being represented in a manner which enables the competent authorities and the public to determine the precise subject of protection afforded to its proprietor’. According to the Commission, Article 4 of the Regulation is out of date and would create legal uncertainty with regard to nontraditional trademarks.

Additionally, trademarks applied for in a foreign language will not be eligible for protection if their registration is refused on absolute grounds when translated into an official Member State language.

The proposals also concern streamlining procedures, such as the abolition of Community trademark applications at national offices because in 2012, 96.3 percent of those applications were filed through the OHIM e-filing system anyway. It is proposed that applicants will no longer have one month to pay the application fee for a European Trademark, as the application fee will instead be payable on application. The concept of ‘one-class-per-fee’ is introduced both for Community trademark applications and for national

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11 Proposal for a Regulation of the European Parliament and of the Council to approximate the laws of the Member States relating to trade marks.
12 Ibid. p. 4, 9.
13 Ibid. p. 10.
14 Ibid. p. 5-6.
15 Ibid. p. 6.
trademark applications, enabling businesses, and in particular small businesses, to register a trademark for only one product class instead of three.\textsuperscript{16} Moreover, the Commission proposes a framework for mandatory cooperation between the national offices and OHIM in Article 123c with the aim of promoting convergence of practices and the development of common tools.\textsuperscript{17} Those European Commission’s proposals are to be adopted by the European Parliament and the Council under the co-decision procedure.

III Procedure of Trademark Registration

III.1 Community Trademark Registration
OHIM examines Community trademark applications. Appeals against first instance decisions, taken by OHIM, are decided by the OHIM Boards of Appeal. Those appeals must be filed within two months after service of the decision, according to Article 59 of the Trademark Regulation. The Boards of Appeal are independent and not bound by any instructions when deciding a case. Their decisions are liable to actions before the General Court whose judgments are subject to a right of appeal before the Court of Justice of the European Union.


III.2 Trademark Registration in Germany
In Germany, the DPMA examines trademark applications. The applicant may raise objections (‘Erinnerung’) to decisions of the DPMA, according to

\textsuperscript{16} Ibid. p. 16-17.
\textsuperscript{17} Ibid. p. 10.
IV Basic provisions of the European Trademark Directive

As a starting point of the analysis, general provisions that are of importance concerning trademark registration will be presented.

IV.1 Signs of which a trademark may exist

Article 2 of the Directive and Article 4 of the Regulation respectively state that a trademark may consist of any sign that is capable of being represented graphically, provided that it is capable of distinguishing the goods or services of one undertaking from those of another. This definition combines the requirements of graphic representability and distinctive character.

A number of unusual trademarks, such as shapes, sounds and smells have been tried to register in the past years. In Sieckmann\(^\text{18}\), the Court set out criteria for the graphic representability which were cited in a number of cases. These ‘Sieckmann-criteria’ all concern the graphic representability in the register that must be clear, precise, self-contained, easily accessible, intelligible, durable and objective.\(^\text{19}\) This landmark decision of the CJEU meant the end for olfactory signs as well as a number of other non-conventional trademarks like sound signs\(^\text{20}\) and colour marks\(^\text{21}\). If the European Commission’s proposals will be adopted (see above II.2) and the

\(^{18}\) Case C-273/00 Sieckmann [2002].
\(^{19}\) Case C-273/00 Sieckmann [2002] para. 55.
\(^{20}\) Case C-283/01 Shield Mark v. Joost Kist [2003].
\(^{21}\) Case C-104/01 Libertel Groep v Benelux-Merkenbureau [2003].
requirement of graphic representability will be abolished, the jurisprudence on non-conventional trademarks will be subject to change.

However, slogans consist of words which are beyond no doubt capable of being represented graphically. Consequently, this requirement does not constitute any problem and will therefore not be further assessed.

**IV.2 Absolute grounds for refusal**

Absolute grounds as an objection to trademark registration refer to the sign itself focusing on the inherent registrability of a sign whereas relative grounds concern the conflict with earlier rights of a third party. Article 3 of the Directive and Article 7 of the Regulation respectively set out the particular absolute grounds for rejection of registration: non-distinctive, descriptive or customary signs, signs that are contrary to public policy, that deceive the public, that cover a sign of high symbolic value or that were applied for in bad faith.

**IV.2.(a) The requirement to comply with the definition of a mark**

Firstly, signs which do not comply with the definition of a trademark as defined above in IV.1 are prevented from registration by Article 3 (1) (a) of the Directive and Article 7 (1) (a) of the Regulation. That ground of refusal relates only to the graphic representability and not to distinctive character as Article 2 of the Directive and Article 4 of the Regulation do. As already stated, the requirement of graphic representability does not have a great impact on the registration of slogans and is consequently of minor importance in this thesis.

**IV.2.(b) The requirement of distinctive character**

Secondly, Articles 3 (1) (b), (c) and (d) of the Directive prevent the registration of terms that lack distinctiveness. The corresponding provisions of the Regulation are Article 7 (1) (b), (c) and (d). Assessing the requirement of distinctiveness, it has to be determined whether the public
perceives the sign as indication of trade origin. The relevant public consists of the average consumer of the goods or services in question who are reasonably well informed and reasonably observant and circumspect.22

Even though the Directive and the Regulation distinguish between non-distinctive and descriptive signs, the approach of the CJEU highlights distinctiveness as the essential requirement. Consequently, it has stated that descriptive signs are necessarily devoid of distinctive character. 23 This means that non-distinctiveness is understood as a wide absolute ground which always includes descriptive signs but may include other non-descriptive signs, too. This approach has been criticised in literature, for example by representatives of the German approach 24 which will be discussed further in V.2.

Article 3 (1) (b) of the Directive and Article 7 (1) (b) of the Regulation preclude the registration of signs that are devoid of any distinctive character. A sign is distinctive if ‘it may be immediately perceived as an indication of the commercial origin of the goods or services in question, so as to enable the relevant public to distinguish, without any possibility of confusion, the goods or services of the owner of the mark from those of a different commercial origin’.25 The public interests behind this provision are, on the one hand, to prevent registration of signs which are not capable of fulfilling the essential function of a trademark26 and the need to not unduly restrict the ability of operators to trade on the other hand. Both interests come into play in regard to slogans; especially the public interest in traders not being unduly restricted in their ability to describe and promote their products because of the monopolisation of a product-describing phrase.

24 Eisenführ/Schennen, Gemeinschaftsmarkenverordnung (Carl Heymanns 2013) sec. 7, r. 4, 142-144.
26 Case C-329/02 SAT.1 Satellitenfernsehen GmbH v OHIM [2004] para. 23.
IV.2.(c) The requirement of non-descriptive character

Signs which may serve in trade to designate characteristics of products, i.e. descriptive signs, may not be registered, pursuant to Article 3 (1) (c) of the Directive and Article 7 (1) (c) of the Regulation. The purpose behind this provision is to keep descriptive terms available for use by all. Signs that describe the product, e.g. scent for perfume, cannot be registered. It does not matter whether the terms are actually being used - it is sufficient that they could be used for the purpose of describing a characteristic of a good or service.

For an objection under this provision to be valid, the relevant public must be able to immediately and without further reflection make a definite and direct association between the mark and the goods or services applied for.

The issue of what kind of characteristics of the goods and services need to be described is subject to debate. There is generally reference to only ‘essential characteristics’ of the goods and services. Nevertheless, in POSTKANTOOR, the CJEU stated that ‘any undertaking must be able freely to use signs and indications to describe characteristics whatsoever of its own goods, irrespective of how significant the characteristics may be commercially’. Later on, the GC referred again to essential characteristics stating that ‘euro’ in EUROPREMIUM does not designate the goods and services at issue either directly or by reference to one of their essential characteristics and is therefore not descriptive of them.

As can be seen from above, the function of keeping any particular mark available for public use was considered relevant by the CJEU for both, the requirement of distinctiveness and the requirement of non-descriptiveness. In Libertel, the Court held that in ‘assessing the potential distinctiveness of a given colour as a trademark, regard must be had to the general interest in not unduly restricting the availability of colours for the other traders who offer for sale goods or services of the same type as those in respect of which

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32 Case T-334/03 Deutsche Post Euro Express GmbH v OHIM [2005] para. 36.
registration is sought. The late Advocate General Colomer depicted a different opinion arguing under Article 3 (1) (b) of the Directive, a general interest to preserve availability is irrelevant. In the case *Nichols*, he stated that the interest to ensure that certain very frequently occurring surnames are available to all present and potential operators cannot be taken into account. He reminded of the purpose of this provision which is to prohibit the registration of signs that are devoid of distinctive character. Consequently, availability for the public is not in line with the purpose of the provision.

Considerations of common use of the sign in question have been accepted by the Court as a reason for refusal of registration only in relation to the absolute ground of descriptive signs, as stipulated in Article 3 (1) (c) of the Directive and Article 7 (1) (c) of the Regulation respectively. The CJEU has stated that the criterion of current common use or capability of common usage may not be relevant in relation to the objection of distinctiveness, Article 3 (1) (b) of the Directive and Article 7 (1) (b) of the Regulation respectively. Thus, registration may be refused on the ground that the sign is commonly used or capable of common use only in relation to descriptive signs. This may not apply to signs which are devoid of distinctive character in itself, e.g. simple letters. For the thesis at hand, the criterion of common usage is consequently of importance concerning descriptive slogans. This criterion of common usage has to be distinguished from acquired distinctiveness through use according to Article 3 (3) of the Directive and Article 7 (3) of the Regulation respectively. Acquired distinctiveness through use will be discussed further in IV.3.

Prohibited from registration are also signs which are customary in trade or bona fide established practices, with regard to Article 3 (1) (d) of the Directive and Article 7 (1) (d) of the Regulation respectively. In the case *Merz & Krell*, the German Patent Court (BPatG) asked the CJEU in a

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33 Case C-104/01 Libertel Groep v Benelux-Merkenbureau [2003] para. 60.
34 AG Colomer in Case C-404/02 Nichols v Registrar of Trade Marks para. 42.
35 Case C-37/03 BioID AG v OHIM [2005] para. 62.
36 Case C-329/02 SAT.1 Satellitenfernsehen GmbH v OHIM [2004] para. 36 and confirmed by Case C-37/03 BioID AG v OHIM [2005] para. 62.
preliminary ruling procedure for an interpretation of Article 3 (1) (d) of the Directive. More precisely, the enquiry dealt with the question whether Article 3 (1) (d) of the Directive precludes registration of a trademark only where the signs or indications describe the properties or characteristics of the goods and services in respect of which the mark is sought to be registered or also where those signs or indications are advertising slogans, indications of quality or incentives to purchase even if they do not describe the properties or characteristics of those goods and services. The Court replied that Article 3 (1) (d) of the Directive must be interpreted as meaning that it subjects refusal to register a trademark to the sole condition that the signs or indications have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought. Applying that provision, it is consequently immaterial whether the signs or indications in question describe the properties or characteristics of those goods or services.\(^{37}\) As a result, BRAVO could be registered for writing implements and the rejection of the German Patent- and Trademark Office (DPMA) on the ground that it was a term of praise or an advertising slogan could not be held.

**IV.3 Acquired distinctiveness through use**

Signs that are not inherently distinctive may acquire distinctiveness through use when they are used in the marketplace in such a manner that the public will perceive them to be indicative of trade origin. Article 3 (3) of the Directive and Article 7 (3) of the Regulation state that those ‘de facto distinctive marks’ can be registered. This provision is only relevant to overcome the lack of distinctive grounds. The distinctiveness test resembles the distinctiveness-assessment of Article 3 (1) (b) of the Directive and 7 (1) (b) of the Regulation: the public must perceive it as indication of origin. The assessment in relation to used marks is exclusively concerned by the

\(^{37}\) Case C-517/99 *Merz & Krell* [2001] para. 41.
A sign which is not inherently distinctive may become distinctive through use. According to the CJEU in the landmark decision *Windsurfing Chiemsee*, this is the case when the sign has gained a new significance from the perspective of at least a significant proportion of the relevant class of people.

In the same decision, the CJEU developed factors which are relevant when assessing the extent of the distinctive character acquired through use: the market share held by the mark; how intense, geographically widespread and longstanding use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations as well as sales figures and opinion polls.

In a case concerning the sign POSTKANTOOR, the CJEU went even further stating that the mark had to become part of an everyday language and to acquire its own meaning which is not itself descriptive.

In *Philips*, the CJEU clarified that a monopoly position is not necessarily opposed to registration through acquired distinctiveness. In the same judgment, the Court requires the extensive use as a mark for registration because of acquired distinctiveness.

Community trademarks can only become distinctive, if they acquired distinctiveness in a substantial part of the European Union where the mark was considered to lack distinctiveness.

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43 Ibid.
IV.4 Relative grounds for refusal

In case of conflicting earlier rights, trademark protection must be refused. Article 4 of the Directive and Article 8 of the Regulation set out relative grounds: If a trademark is identical to an earlier registered trademark; or if a trademark is similar and there exists a likelihood of confusion; or if it is similar and the applicant takes unfair advantage of the distinctive character; or the use would infringe non-registered trademarks or other intellectual property rights, it is precluded from registration.

Relative grounds for refusal of trademark registrations are of minor importance in this thesis because relative grounds do not affect the registrability of slogans as trademarks.

V Basic provisions of the German Trademark Act

Since the thesis at hand compares the situation of slogans as trademarks in Europe and Germany, the German Trademark Act (Markengesetz, hereinafter: MarkenG) will be presented briefly. The introduction of the MarkenG in 1995 transposed the Trademark Directive. The German legislation is very similar and partly identical in the wording to the Trademark Directive.

V.1 Signs of which a Trademark may exist

Sec. 3 I MarkenG defines which signs are capable of being protected as trademarks. It combines the types of signs - namely personal names, designs, letters, numerals, sound marks, three-dimensional designs, the shape of goods or of their packaging, as well as other wrapping, including colours and colour combinations - with the function of a trademark to distinguish goods or services from one undertaking from those of other undertakings. Signs must also be capable of graphic representation, according to sec. 8 (1) MarkenG.
V.2 Absolute Grounds for Refusal

Absolute grounds for refusal are stated in sec. 8 MarkenG. The enumeration starts with graphic irrepresentability. It is followed by signs that are devoid of distinctive character, descriptive, customary in the common language, misleading the public, contrary to public policy, consisting of sovereign state symbols or which have been applied for in bad faith of which the first two are of major importance for slogans.

V.2.(a) The requirement of graphic representability

The condition of graphic irrepresentability is mentioned as an absolute ground for refusal of trademark registration in sec. 8 (1) MarkenG. It will not be discussed any further due to its essentially identical content with Article 2 of the Directive and Article 4 of the Regulation which was part of the assessment of the European legislation in IV.1.

V.2.(b) The requirement of distinctive character

Sec. 8 (2) No. 1 MarkenG excludes signs from registration that are devoid of distinctive character and that are descriptive. The German jurisprudence had a very wide understanding of the need of free availability to avoid monopolies and used the ground of non-distinctiveness rarely and as an exception. But this approach was given up since it differs substantially from the European approach which contrarily focuses on the requirement of distinctiveness when assessing the absolute grounds. This finds support in the fact that the draft of the first Trademark Directive provided priority of distinctiveness but was changed due to the operation of inter alia the German delegation.

Since 1995, the German Trademark Act recognises the advertising function as a third function of trademarks, which supports the conception to require the same level of distinctiveness for slogans as for other marks. The

45 Ströbele/Hacker, Markengesetz (Carl Heymanns 2012), sec. 8 r. 66.
46 Article 2 of the draft of the first trademark directive from July 1979.
47 Ströbele/Hacker, sec. 8 r. 66.
wording of the German legislation differs from the European legislation by the implement of ‘[…] jegliche Unterscheidungskraft fehlt.’ (lack of any distinctiveness). However, European secondary law phrases ‘no distinctiveness’ instead of ‘lacking any distinctiveness’. Nevertheless, the different text of the German Trademark Act cannot give rise to a different legal evaluation as the European Trademark Directive is binding on the Member States.

According to the definition of the BGH, a sign is distinctive for the purpose of sec. 8 (2) No. 1 MarkenG if the public perceives it as a mean identifying an undertaking from other undertakings. This is motivated by the main function of a trademark - to guarantee the ‘Ursprungsidentität’ (identity of origin). Any degree of distinctiveness, however slight it is, suffices to justify registration of a sign as trademark. Thus, a broad standard applies in the assessment of distinctiveness. The BGH states this expressly in its decisions.

V.2.(c) The need to preserve availability

The need to preserve availability of a sign is another absolute ground for non-registration, covered by sec. 8 (2) No. 2 MarkenG. It excludes signs from registration which consist exclusively of signs or indications which may serve, in the course of trade, to designate the nature, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the services or to designate other characteristics of the goods or services. The function of this provision is the protection of competitors from the monopoly of a word or a row of words.

The German word ‘Freihaltebedürfnis’ (the need to preserve availability) is not congruent with the term of descriptive signs. It has a more restrictive meaning since not any descriptive sign is excluded from registration, but only signs which need to be free for usage for everybody.

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48 Court order BGH from 16/12/2004 ref. I ZB 12/02, court order BGH from 31/03/2010 ref. I ZB 62/09.
49 Court order BGH from 22/01/2009 ref. I ZB 52/08.
50 Court order BGH from 22/01/2009 ref. I ZB 52/08, court order BGH from 22/01/2009 ref. I ZB 34/08, court order BGH from 24/05/2007 ref. I ZB 37/04.
According to German jurisprudence, if a sign can be identified without further ado and without uncertainties as descriptive in respect of the goods and services in question, the public does not perceive it as indication of origin. For example, ‘marktfresh’ (fresh from the market) could not be registered for groceries because it was descriptive.\(^{51}\) In the same line of reasoning, ‘BerlinCard’ was held to be descriptive for a number of goods and services concerning entrance cards etc. for Berlin.\(^{52}\) ‘Streetball’ could not be registered for sports clothes and sports shoes because it implied a hint of the intended purpose.\(^{53}\)

V.3 Acquired distinctiveness through use

Sec. 8 (3) MarkenG provides that none of the absolute grounds for refusal in sec. 8 (2) No. 1 to 3 shall apply if the trademark has, before the date of decision, established itself in affected trade circles as the distinguishing sign for the goods and services for which the application has been filed.

In order to acquire distinctiveness, the sign must have been used as a trademark. It is not sufficient that the public is familiar with a sign and connects it in any way with the applicant.\(^{54}\) The public rather needs to understand the sign as an indication of origin.

In the *Windsurfing Chiemsee* case, the German District Court of Munich (Landgericht München) asked the CJEU in a demand for preliminary ruling whether the German jurisprudence which related the extent of acquired distinctiveness to the degree of the need to preserve availability of a sign for public use was in line with Article 3 (3) of the Trademark Directive. In particular, it asked whether it is in line with Article 3 (3) of the Directive to require, in case of descriptive terms, more than 50 percent of acquired distinctiveness in the market. The Court held that it is impermissible to differentiate according to the need to preserve availability.\(^{55}\) The decisive criterion is rather that a significant proportion of the relevant class of

\(^{51}\) Court order BGH from 01/03/2001 ref. I ZB 42/98.

\(^{52}\) Court order BGH from 16/12/2004 ref. I ZB 12/02.

\(^{53}\) Court order BGH from 15/01/2009 ref. I ZB 30/06.

\(^{54}\) Ingerl/Rohnke., Markengesetz (C.H. Beck 2010), sec. 8 r. 324.

persons identifies the goods as originating from a particular undertaking because of the mark.\textsuperscript{56} It however admitted that well-known geographical names can only acquire distinctiveness through use if there has been a long-standing and intensive use.\textsuperscript{57} The BGH stated in the following jurisprudence that, in principle, 50 percent of acquired distinctiveness must be presumed as a minimum.\textsuperscript{58} However, in exceptional cases, it can be deviated from the 50 percent minimum. Remarkably, in the case of KINDER (children), the BGH required, contrary to the ruling in \textit{Windsurfing Chiemsee}, an almost unanimous acquired distinctiveness because ‘Kinder would clearly describe the consumers’ of the chocolate bar in question.\textsuperscript{59} In \textit{Porsche Boxster}, the BGH based its decision solely on the experience in regard to the perception of the public.\textsuperscript{60} But this approach which was taken relating to a very well-known car producer cannot be applied for all kinds of word marks.\textsuperscript{61}

Some opinions in German literature do not take the 50 percent market acceptance as an absolute criterion and use the criteria developed by the CJEU additional.\textsuperscript{62} Others disregard the jurisdiction of the CJEU and use the 50 percent market acceptance as an absolute criterion.\textsuperscript{63}

\textbf{V.4 Relative grounds for refusal}

Sec. 9 MarkenG precludes the registration of trademarks which conflict with earlier rights. More precisely, it precludes registration of a trademark that is identical with an earlier filed trademark having identical goods and services, a trademark that is similar to an earlier filed trademark having similar goods or services and creating a likelihood of confusion, or a trademark that is

\begin{footnotesize}
\textsuperscript{56} Cases C-108/97 and C-109/97 \textit{Windsurfing Chiemsee v Huber} [1999] para. 52.
\textsuperscript{57} Cases C-108/97 and C-109/97 \textit{Windsurfing Chiemsee v Huber} [1999] para. 50.
\textsuperscript{58} Court order BGH from 01/03/2001 ref. I ZB 54/98, court order BGH from 19/01/2006 ref. I ZB 11/04.
\textsuperscript{59} Court order BGH from 28/08/2003 ref. I ZR 257/00 para. 40.
\textsuperscript{60} Court order BGH from 15/12/2005 ref. I ZB 33/04.
\textsuperscript{61} Schurgacz, Die Sloganparodie im Markenrecht (Dr. Kovač 2009), p. 103.
\textsuperscript{62} Goldmann, Der Schutz des Unternehmenszeichens (Carl Heymanns 2005) p. 132; Fezer, Markenrecht (C.H.Beck 2009), sec. 8 r. 430.
\textsuperscript{63} Ströbele/Hacker, sec. 8 r. 336; Göttig, Gewerblicher Rechtsschutz (C.H.Beck 2010), sec. 48 r. 13.
\end{footnotesize}
identical or similar with an earlier filed trademark having identical or similar goods or services and taking unfair advantage of or being detrimental to the distinctive character of that earlier mark. The relative grounds will no further be part of the assessment at hand due to their dispensability for the registrability of slogans.
Part C: Slogans as Trademarks

I Definition of commercial Slogans

Slogans can be divided in political slogans and commercial slogans. A political slogan is defined as a motto associated with a political party or movement or other group, whereas a commercial slogan is a short and striking or memorable phrase used in advertising. A commercial slogan has the purpose to remind the consumer of a specific brand and to influence future purchases. Slogans might be presented with a short melody which makes the slogan even more memorable. An example is the well-known I’M LOVIN’ IT from McDonald’s.

II European Practices concerning Trademark Protection for Slogans

General considerations on trademark protection of slogans will be put in front followed by an in-depth case-study of four relevant cases on registrability of slogans.

II.1 Slogans as Community Trademarks de lege lata

Community trademark protection will be analysed on the basis of the particular requirements for registration.

II.1.(a) The requirement of distinctiveness

Slogans have an inherent advertising function. They are often descriptive or laudatory. It is consequently more difficult to establish distinctiveness of a slogan. Laudatory word marks, such as SUPER or TOP are generally not registrable. Those generic laudatory terms cannot be regarded as appropriate.

64 Oxford dictionary ‘slogan’.
for the purpose of identifying the commercial origin of the goods.\textsuperscript{65} However, if laudatory terms have an element of inventiveness, e.g. ULTRAPLUS or EUROPREMIUM, they can be registered.\textsuperscript{66} The GC held in a case concerning the application for registration of the phrase LOOKS LIKE GRASS...FEELS LIKE GRASS...PLAYS LIKE GRASS for synthetic surfacing that a particular rhetorical flourish, poetic character or rhythm may confer distinctiveness on a slogan.\textsuperscript{67} Nevertheless, it was held to be devoid of distinctive character in the end.

If the relevant public perceives the phrase immediately as a mere promotional formula or slogan, the phrase is devoid of distinctive character, as held in MEHR FÜR IHR GELD (more for your money).\textsuperscript{68} The same approach was taken by the GC concerning the phrase REAL PEOPLE, REAL SOLUTIONS for technical support services in the computer industry.\textsuperscript{69}

II.1.(b) Requirement of non-descriptiveness

It is hard to draw a line between descriptive and non-distinctive signs in the reasoning of the European judicature because, as covered above, the main focus is set on the requirement of distinctiveness which is seen as a wider requirement always including descriptive signs.

Slogans might be unregistrable because they are descriptive. In \textit{RheinfelsQuellen H. Hovelmann v OHIM}, the GC affirmed the rejection of OHIM to register VOM URSPRUNG HER VOLLKOMMEN (perfect from the point of origin) for beers on the ground that its meaning was descriptive.\textsuperscript{70}

Concerning descriptive slogans, the criterion of common usage is of importance. The fact that the phrase is commonly used by the public indicates its need to be preserved available. The CJEU confirmed in \textit{Erpo Möbelwerk} that the approach of common usage of the phrase DAS PRINZIP

\textsuperscript{65} Case T-242/02 Sunrider Corp v OHIM [2005] para. 95.
\textsuperscript{66} Case T-360/00 Dart Industries v OHIM [2003] para. 47, case T-334/03 Deutsche Post Express v OHIM [2005] para. 54.
\textsuperscript{67} Case T-216/02 Fieldturf v OHIM [2004] para. 31.
\textsuperscript{68} Case T-281/02 Norma Lebensmittelfilialbetrieb v OHIM [2005] para. 29.
\textsuperscript{69} Case T-130/00 Sykes Enterprises v OHIM [2002] para. 28-30.
DER BEQUEMLICHKEIT (the principle of comfort) applies not to Article 3 (1) (b) as it was held by the GC but only to Article 3 (1) (c).\textsuperscript{71}

II.1.(c) Acquired distinctiveness through use

In general, undertakings can make use of signs unwilling to apply them as a trademark while the public nevertheless perceives them as such. Regarding those marks that are – just like slogans – not intentionally marketed as trademarks, the question arises whether the applicant needs to have purposively set out to use the mark as a trademark or whether it is merely sufficient that the public has come to recognise the mark as a trademark. According to Tritton, those marks usually become by reason of extensive and often exclusive use recognised by the public as being the product of a particular undertaking and not by the intentional marketing as a trademark and, therefore, the applicant’s intention is irrelevant for the establishment of a trademark.\textsuperscript{72}

An example is served by the phrase HAVE A BREAK…HAVE A KIT KAT which was used over many years by Nestlé in relation to advertising its KIT KAT chocolate bar. Nestlé tried to register HAVE A BREAK which was used only in conjunction with the trademark KIT KAT. The CJEU held that in both cases - may the acquisition of distinctive character be a result of the use as part of the trademark or in conjunction with a registered mark - it is sufficient that the relevant class of persons actually perceives the product or services as originating from a given undertaking.\textsuperscript{73} Thus, a slogan may acquire distinctiveness if, for the relevant class of persons, the sign does not only fulfil the advertising function but also the function to guarantee the origin of the product.

\textsuperscript{71} Case C-64/02 Erpo Möbelwerk v OHIM [2005] para. 46-48.
\textsuperscript{72} Tritton r. 3-091.
\textsuperscript{73} Case C-353/03 Nestlé v Mars [2005] para. 30.
II.2 Analysis of Community Trademark Applications for Slogans

In the following, three cases of slogan Community trademark applications will be analysed that went through all four instances of the registration decision, namely the OHIM examiner, the OHIM Boards of Appeal, the General Court of the European Union (former Court of First Instance) and the Court of Justice of the European Union. The two most recent (4th and 5th case) examined in this matter date from February and March 2014 and have only been treated by the General Court so far.

II.2.(a) Erpo Möbelwerk – Das Prinzip der Bequemlichkeit

Erpo Möbelwerk, a German furniture manufacturer, applied for the registration of the slogan DAS PRINZIP DER BEQUEMLICHKEIT (the principle of comfort) for the classes 8 (hand tools and implements (hand-operated); cutlery; side arms; razors), 12 (vehicles; apparatus for locomotion by land, air or water) and 20 (furniture, mirrors, picture frames; goods of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics) of the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks (hereinafter: Nice Agreement).

II.2.(a)(aa) OHIM examiner decision from 04/06/1999

The examiner held that the sign could not be registered as a trademark because it lacked distinctiveness, according to Article 7(1) (b), (c) and 7 (2) of the Regulation. The slogan conveys a describing message, used in common language. ‘Comfort’ is a word used very often to describe the above mentioned classes objectively. Examples are comfortable couches, comfortable car seats, comfortable or convenient usage of hand tools. ‘Comfort’ is consequently not specifically peculiar for the relevant groups of goods and services. The examiner stated moreover, that the connection...
with the word ‘principle’ does not make the slogan characterizing because a lot of manufacturers use principles for their product philosophy. Thus, the slogan is purely descriptive and cannot be registered in accordance with Article 7 (1) (b) of the Regulation.

The examiner found furthermore the registration not in accordance with Article 7 (1) (c) of the Regulation. It was presumed that a lot of manufacturers of the relevant group of goods use a ‘principle of comfort’ to market their products. Hence, there is a need to preserve availability in the interest of the specialist circle for these words. The examiner referred to the decision COMFORT PLUS where this word mark could not be registered for carpets and other flooring.\(^75\) The examiner held moreover that this slogan is not comparable to the slogans BEAUTY ISN’T ABOUT LOOKING YOUNG BUT LOOKING GOOD\(^76\) and FRÜHER AN SPÄTER DENKEN!\(^77\) (Think earlier about later!) which were not descriptive. Similarly, DU DARFST\(^78\) (You may) could only be registered because it is necessary to interpret the word mark in context with the relevant group of goods.

The examiner pointed out that absolute grounds of registration appearing in the German speaking Community apply in the whole Community, according to Article 7 (2) of the Regulation. A complaint was filed against the examiner’s decision underlining the alleged distinctiveness of the formula.

**II.2.(a)(bb) OHIM Boards of Appeal Decision from 23/03/2000\(^79\)**

The 3\(^{rd}\) Board of Appeal started its assessment with the requirement of Article 4 of the Regulation: signs that can constitute a trademark. Long word marks can only constitute a trademark if they are uniform in their appearance. According to the Board, the slogan DAS PRINZIP DER BEQUEMLICHKEIT (the principle of comfort) applies to the requirement of uniformity.\(^80\)

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\(^76\) Decision R 72/98-2 from 11/02/1999.
\(^77\) Decision R 153/98-2 from 04/05/1999.
\(^78\) Court order BPatG from 22/01/1997 ref. 28 W (pat) 35/96.
\(^79\) Decision R 392/99-3 from 23/03/2000.
\(^80\) Decision R 392/99-3 from 23/03/2000 para. 15.
The Board continued the assessment with Article 7 (1) (c) of the Regulation concerning the need to preserve availability of descriptive signs. Only directly descriptive signs are precluded from registration. On the contrary, unclear and incomprehensible signs are registrable, e.g. NETMEETING. The Board held furthermore that signs which lack distinctiveness are according to Article 7 (1) (b) not registrable. The sign must be able to indicate the origin of the product. The Board stated that the principles developed for word marks may also be used for combined word marks. The fact that slogans have most likely a marketing function next to the function of guaranteeing the indication of origin does not preclude slogans from registration per se. The Board referred to the decisions GREAT BOOKS OF THE WESTERN WORLD, THE WORLD LEADER IN TELEPHONE MARKETING SOLUTIONS, BEAUTY IS`NT ABOUT LOOKING YOUNG, BUT LOOKING GOOD, THE WORLD`S BEST WAY TO PAY. Indicators for the distinctiveness of a slogan are shortness, conciseness, originality, ambiguity and the need of interpretation; but the requirements thereof should not be overstated.

The Board of Appeal moreover pointed out that the overall impression of a trademark is significant for the assessment, rather than the single parts of it, for both the assessment on absolute grounds and the assessment on relative grounds. But the sign in question consists of two common words in the German language. The public understands the meaning of the slogan at first sight. Comfort is a common characteristic of furniture and also vehicles, considering the seats and the handling of the vehicle. The combination of the two purely descriptive words does not create the minimum requirement of distinctiveness because the indication of quality does not become vague or unclear through the combination of words – it points out the indication of

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82 Decision R 175/98-3 from 09/09/1999.
83 Decision R 232/99-3 from 26/10/1999.
84 Decision R 72/98-2 from 11/02/1999.
85 Decision R 45/99-1 from 15/07/1999.
87 Case C-251/95 SABEL v Puma [1997] para. 23.
88 Decision R 392/99-3 from 23/03/2000 para. 24-25.
quality even more. The Board of Appeal held moreover that the slogan lacked any additional element of originality. Thus, the slogan does not prove distinctive character for the classes 12 and 20, namely vehicles and furniture.

The complainant stated that it will make use of disclaimers, according to Article 38 (2) of the Regulation, meaning that it will not claim exclusive use of the single words ‘principle’ and ‘comfort’ but only of the combination of the words. Regarding this point, the Board of Appeal concluded that this will not change the result because, as described above, not only the two single words but also the combination thereof does not have distinctive character.

Nevertheless, the Boards of Appeal found the slogan to be distinctive for class 8, namely hand tools and implements (hand-operated), cutlery, side arms and razors. The difference to the classes 12 and 20 is that for goods of the class 8, comfort is not a typical characteristic and hence, not descriptive and an indication of quality at first sight. For those goods, the deciding characteristics are rather safety, facileness and effectiveness in usage or aesthetics.

The Board of Appeals followed case law of the Boards of Appeal refusing registration of slogans that were exclusively descriptive and not distinctive, e.g. GREAT BOOKS OF THE WESTERN WORLD, THE WORLD LEADER IN TELEPHONE MARKETING SOLUTIONS, BOUQUET DE PROVENCE and THE PROFESSIONAL FLASHLIGHT. The applicant submitted pleas to the GC.

II.2.(a)(cc) General Court decision from 11/12/2001

The GC found that both pleas of infringement brought up by Erpo Möbelwerk are founded.

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90 Ibid. para. 29.
91 Ibid. para. 30.
92 Ibid. para. 32.
93 Ibid. para. 33.
94 Decision R 175/98-3 from 08/09/1999.
95 Decision R 232/99-3 from 26/10/1999.
96 Decision R 218/99-2 from 17/12/1999.
98 Case T-138/00 Erpo Möbelwerk v OHIM [2001].
Firstly, it held that Article 7 (1) (c) of the Regulation was infringed. According to the GC, the Board of Appeal did not apply the principle of assessing a sign as a whole - on the basis of all the elements and not only single elements - correctly.\(^99\) It found that the ‘comfort’ element designates on its own a quality of the goods concerned which may be relevant when the class of persons targeted makes the decision to purchase. However, DAS PRINZIP DER BEQUEMLICHKEIT, when considered on the basis of all its elements and read in its entirety, cannot be regarded as consisting exclusively of signs or indications which may serve to designate the quality of the goods concerned.

Secondly, the GC found that Article 7 (1) (b) of the Regulation was infringed. According to the GC, the Board of Appeal stated wrongly that the lack of an original element leads to the lack of distinctiveness.\(^100\) The GC claimed that the Board of Appeal had not demonstrated that the combination of the words ‘the principle of’ with a term designating a characteristic of the goods or services concerned is commonly used in business communications and, in particular, in advertising. But, according to the GC, this would be the only reason justifying a refusal on grounds of Article 7 (1) (b) of the Regulation.\(^101\)

In the author’s opinion, the GC misread the decision of the Board of Appeal producing the argument that the slogan was not interpreted in its entirety. The Board analysed both words ‘Prinzip’ and ‘Bequemlichkeit’ and then analysed the combination thereof and it moreover pointed out that a mark can only be assessed as a whole\(^102\) and showed in its assessment very detailed that the two words are descriptive and that the combination of those words does not lead to any need of interpretation which would lead to distinctiveness. The court’s reproach is therefore ill-founded in this regard. Furthermore, it is irreproducible why the only reason for refusal on grounds of lacking distinctiveness should be the common use in business communications of the slogan. The lack of distinctiveness in the case at


\(^{100}\) Ibid. para. 44.

\(^{101}\) Ibid. para 46.

\(^{102}\) Decision R 392/99-3 from 23/03/2000 para. 21.
hand is – as demonstrated correctly by the Board – the result of the discussed combination of product describing words.

The disputed perceptions gave way to an appeal to the CJEU against the GC’s decision.

II.2.(a)(dd) CJEU decision from 21/10/2004

On appeal, OHIM sought to annul the judgment of the GC emphasizing in its arguments that slogans, like colour or shape marks, need an additional presentational element because of their purely advertising function.

The CJEU confirmed the judgment of the GC concerning Article 7 (1) (b) of the Regulation. It stated that the Board of Appeal based the assessment of distinctiveness on the wrong requirement of originality. The Court held that there should be no stricter criteria for the distinctiveness of slogans – even though there might be difficulties in establishing distinctiveness of slogans because the relevant public’s perception is not necessarily the same for each category of trademark. For example, in the matter of three-dimensional trademarks, the Court held that authorities may take account of the fact that average consumers are not in the habit of making assumptions about the origin of products on the basis of such three-dimensional trademarks. The Court indicated that the same may apply to slogans but dropped this argument and said that the same criteria should be applied for all trademark categories.

Secondly, the Court dealt with the criterion developed by the GC in paragraph 46 of its judgment according to which a trade mark is not devoid of distinctiveness within the meaning of Article 7 (1) (b) of the Regulation unless it is demonstrated that the phrase concerned is commonly used in business communications and, in particular, in advertising – the existence of such a situation not having been established in the contested decision. The Court found that it is not appropriate to limit the scope of Article 7 (1) (b) of the Regulation to trademarks for which registration is refused by reason of

103 Case C-64/02 Erpo Möbelwerk v OHIM [2004].
104 Case C-64/02 Erpo Möbelwerk v OHIM [2004] para. 18.
105 Case C-468/01 Procter & Gamble v OHIM [2004] para. 36.
106 Case C-64/02 Erpo Möbelwerk v OHIM [2004] para. 35-36.
the fact that they are commonly used in business communications and, in particular, in advertising. The reason thereof is that each of the grounds of refusals of Article 7 (1) of the Regulation has to be examined separately. The Court consequently confirmed the case law that a mark is distinctive if it serves in trade to distinguish the goods or services of one undertaking from those of another. This is the requirement of distinctiveness and not whether the phrase is commonly used in business communications and advertising. Nevertheless, the Court held that this error by law has no influence on the outcome of the dispute: According to the CJEU, the contested decision of the Board of Appeal should be annulled because registration of the mark was refused on the basis of the incorrect criterion concerning distinctive character within the meaning of Article 7 (1) (b) of the Regulation, namely the absence of an additional element of imagination or an additional element of originality.

II.2.(b) Audi – Vorsprung durch Technik

The German car manufacturer Audi applied for trademark protection of the word mark VORSPRUNG DURCH TECHNIK (advantage/advance through technology). Registration of the mark was sought in a number of classes under the Nice Agreement (9, 12, 14, 16, 18, 25, 28, 35 to 43 and 45, i.e. apparatus, vehicles, metals, paper, leather, clothing, games, services like advertising or telecommunication and legal services).

II.2.(b)(aa) OHIM examiner decision from 12/01/2005

The examiner held that VORSPRUNG DURCH TECHNIK can be translated as ‘Advance or advantage through technology’. For all technology related goods, hence the classes 9, 12, 14, 25, 28, 37, 38, 39, 40, 42, the word sign must be understood as an objective message which does not have a wider meaning than the descriptive one and is consequently not eligible for protection.

107 Ibid. para. 40.
108 Ibid. para. 49-50.
109 Appl. no. 003016292.
This may be different for class 12, namely vehicles, apparatus for locomotion by land, air or water. In this class, the word mark might have acquired distinctive character. But this was not proven yet by the applicant. The examiner held that the slogan is a banal and grammatically correct sentence in the German language. It will be perceived as an indication of quality of the product or service rather than a trademark. It will be understood as promotional formula only and thus lacks the minimum requirement of distinctiveness of Article 7 (1) (b) of the Regulation. The examiner consequently dismissed the registration of the sign for all technology related goods in classes 9, 12, 14, 25, 28, 37, 38, 39, 40, 42.

II.2.(b)(bb) OHIM Boards of Appeal decision from 16/12/2005

Having filed the complaint, Audi claimed that the distinction between the goods for which registration was allowed and the goods for which registration was refused is arbitrary. The complainant stated moreover that the word ‘Vorsprung’ is not related to quality. The slogan rather consists of a reduced causal clause which gives food for thought. The 2nd Board of Appeal held that the slogan ‘Vorsprung durch Technik’ was used by the complainant for several years in relation with the sale of cars and has become popular in this context. Proof of the popularity of the word mark is the decision of OHIM of 27th April 2001 which approved the registration of the sign ‘Vorsprung durch Technik’ for class 12. Thus, the contested decision must be annulled concerning the refusal of registration for class 12.

The Board of Appeal confirmed OHIM’s decision concerning the other classes. Contradictorily, it considered the distinction between technology-related and not technology-related goods questionable and stated that all goods or services are somehow related to technology. The slogan states that a technically advanced producer will produce better goods and services. This banal objective message is not distinctive. In the consequence, the Board held that registration for all the other classes, except for class 12, must be denied because of the lacking proof of acquired distinctiveness.

It is not clear from this reasoning, in the author’s view, whether the Board of Appeal allows only registration of the slogan for class 12 or if it allows registration of the slogan for class 12 and additionally the other classes for which the examiner approved registration in the first place.

II.2.(b)(cc) General Court Decision from 09/07/2008

On appeal to the Board’s decision, the CG concluded that the distinctiveness can be assessed only by reference, first, to the goods or services in respect of which registration is sought and, second, to the relevant public’s perception of that sign and that the Boards of Appeal had done this assessment in the contested decision. The Court referred to case law established in the decisions on the slogans LOOKS LIKE GRASS … FEELS LIKE GRASS … PLAYS LIKE GRASS and LIVE RICHLY. This case law must be interpreted as meaning that there is no need of detailed analysis of all the goods and services in question if the examiner or the Boards of Appeal can demonstrate that the relevant public perceives all the goods and services in the same manner. The Boards of Appeal undertook such an assessment and came to the conclusion that the relevant public perceives the goods and services in the same way and that the distinction made by the examiner must be objected.

Moreover, the GC held that the sign may be ambiguous, a word play, imaginative, surprising or unexpected. But this does not mean that it is distinctive. It has only distinctive character if it is perceived by the relevant public immediately – without likelihood of confusion – as indication of origin. This is settled case law and was held for example in BEST BUY, REAL PEOPLE, REAL SOLUTIONS and LIVE RICHLY.

The Court confirmed the ruling of the Board of Appeal that the slogan at hand is perceived as a promotional formula for the following reasons:

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111 Case T-70/06 Audi v OHIM [2008].
113 Case T-216/02 Fieldturf v OHIM [2004].
114 Case T-320/03 Citicorp v OHIM [2005].
115 Case T-70/06 Audi v OHIM [2008] para. 32.
116 Ibid. para. 41.
117 Case T-122/01 Best Buy Concepts v OHIM [2004].
118 Case T-130/01 Sykes Enterprises v OHIM [2003].
119 Case T-320/03 Citikorp v OHIM [2005].
Firstly, the word ‘technology’ has a very wide meaning in the German language and can consequently not make each group of goods or services distinctive. Secondly, the word ‘advance/advantage’ has a laudatory meaning. Thirdly, since the registration concerns a wide relevant public, other companies that sell goods and services to the same public should be able to use this laudatory sentence.\(^{120}\)

As a second complain, the complainant referred to Article 38 (3) and 73 (2) of the Regulation according to which decisions shall be based on reasons or evidence on which the parties concerned have had an opportunity to present their comments. According to the complainant, the Board of Appeal stated that registration should be denied for more classes than initially held by the examiner. The complainant was not heard about those groups and consequently claims that its right to be heard was violated. But the GC found that the operative part of the decision of the Board is clear on the fact that only the part on class 12 of the first instance decision of the examiner should be annulled.\(^{121}\) OHIM moreover specified that the last sentence of the contested decision was incomplete and to be understood in the way that the application for trademark registration should be refused except for class 12 and except for the classes which were allowed for registration by the first-instance decision.\(^{122}\)

The following appeal of Audi brought the case before the CJEU.

II.2.(b)(dd) CJEU decision from 21/01/2010\(^{123}\)

The CJEU annulled the judgment of the CG in so far as the GC held, on the basis of an erroneous assessment, that the 2\(^{nd}\) Board of Appeal had not infringed Article 7 (1) (b) of the Regulation.

The CJEU stated that the judgment infringes Article 7 (1) (b) of the Regulation because the GC interpreted the following principles established by case law erroneously: Because of their very nature, word marks consisting of advertising slogans, may face difficulties in establishing

\(^{120}\) Case T-70/06 Audi v OHIM [2008] para. 43-45.
\(^{121}\) Ibid. para. 63.
\(^{122}\) Ibid. para. 57.
\(^{123}\) Case C-398/08 Audi v OHIM [2010].
distinctiveness. But, this does nevertheless not lead to the conclusion that there should be specific criteria for the distinctiveness of slogans, such as ‘imaginativeness’ or even ‘conceptual tension which would create surprise and so make a striking impression’ in order to have the minimal level of distinctiveness.\footnote{Case C-398/08 Audi v OHIM [2010] para. 36-39.}

According to the CJEU, the GC based its judgment on the fact that that mark is perceived as a promotional formula, i.e. its finding was made precisely on the basis of the trademark’s laudatory or advertising use.\footnote{Ibid. para. 41.} The Court points out that the mere fact that the public perceives the slogan as promotional formula is not sufficient in itself to support the conclusion that the slogan is not distinctive.\footnote{Ibid. para. 44.} The sign can, even though it has a laudatory character, serve to guarantee to consumers the origin of the goods and services.

The court furthermore highlighted that, even though the presence of characteristics like a number of meanings, a play on words or being perceived as imaginative, surprising and unexpected and easily remembered, is likely to endow this mark with distinctive character, those characteristics are not absolute requirements for distinctiveness.\footnote{Ibid. para. 47.} The Court continued its assessment with stating that signs or indications that are also used as advertising slogans, indications of quality or incitements to purchase the goods or services covered by those marks convey by definition, to a greater or lesser extent, an objective message and that those marks are not by virtue of that fact alone devoid of distinctive character. However simple such a message may be, it cannot be categorised as ordinary to the point of excluding, from the outset and without any further analysis, the possibility that that mark is capable of indicating to the consumer the commercial origin of the goods or services in question.\footnote{Ibid. para. 58.} The CJEU concluded that the Board of Appeal held wrongly that the slogan was not distinctive on the ground that it conveys an objective message.

The CJEU based the finding that the slogan has distinctive character on the following arguments: Firstly, the combination of words VORSPRUNG

\begin{itemize}
\item \footnote{Ibid. para. 41.}
\item \footnote{Ibid. para. 44.}
\item \footnote{Ibid. para. 47.}
\item \footnote{Ibid. para. 58.}
\end{itemize}
DURCH TECHNIK (meaning, inter alia, advance or advantage through technology) suggests, at first glance, only a causal link and accordingly requires a measure of interpretation on the part of the public. Secondly, the slogan exhibits a certain originality and resonance which makes it easy to remember. And thirdly, inasmuch as it is a widely known slogan which has been used by Audi for many years, members of the relevant public may be used to establishing the link between that slogan and the motor vehicles manufactured by Audi making it easier for that public to identify the commercial origin of the goods or services covered.\textsuperscript{129}

In the author’s opinion, the CJEU took a much more flexible point of view concerning the registration of slogans in this decision than before, especially when saying that the slogan’s objective and simple message cannot oppose registration. The Court’s first two conclusive arguments were not newly developed: It has been settled case law that the need of interpretation and originality are criteria which are likely to endow the mark with distinctive character. Newly developed in this judgment is the conception that the use of the mark for a certain group of goods will help the public to identify the commercial origin of other goods and therefore make it distinctive. It is not clear though what the relation between this criterion and acquired distinctiveness through use is. It can probably be understood as a pre-stage of acquired distinctiveness through use indicating concrete distinctiveness.\textsuperscript{130}

II.2.(c) Smart Technologies – Wir machen das Besondere einfach

The Canadian technology supplier Smart Technologies applied for registration of the word sign WIR MACHEN DAS BESONDERE EINFACH (we make special (things) simple) as a Community trademark. The goods in respect of which registration was sought are in Class 9, i.e. computerised systems for capturing coordinate inputs, namely graphics,

\textsuperscript{129} Ibid. para. 59.
\textsuperscript{130} Löffel, GRUR-Prax 2011, 115, 117.
script, drawings and gestures, for interaction with a computer generated display utilising a pen, stylus, finger or hand.

II.2.(c)(aa) OHIM examiner decision from 07/04/2009

The examiner refused the registration of the trademark in respect of all the goods referred to in the application on the grounds that it lacked distinctive character, according to Article 7 (1) (b) of the Regulation.

In the notice of refusal, the examiner firstly recalled that a sign should be assessed at a whole and that the attention of the relevant public may vary with regards to the goods and services in question. The attention of computer specialists in the German speaking community will be high. The examiner held moreover that the structure of the expression does not diverge from German grammar rules and the consumer will therefore perceive it as usual expression. It was found furthermore that the semantic content of the slogan indicates characteristics of the goods relating to the market value. According to the examiner, the public understands the message that due to the normally complicated internal structure of the goods concerned, complicated use is expected but it is in fact simpler than expected. The examiner concluded that there is nothing beyond the promotional laudatory meaning that would enable the relevant public to memorise the sign easily and instantly as a distinctive trademark for the products.

Having examined the applicant’s observations, the examiner maintained the objection. It firstly recalled the CJEU’s standpoint on the distinctiveness of slogans, as developed in Erpo Möbelwerk and Audi. It furthermore stated that slogans – that do not primarily fulfil traditional function of a trademark – are only distinctive for the purpose of Article 7 (1) (b) of the Regulation if they may be perceived immediately as an indication of the commercial origin of the goods and services in question, so as to enable the relevant public to distinguish without any possibility of confusion the goods or services from the owner from those of another producer. It was moreover pointed by the examiner out that even though the awareness of the relevant

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131 Appl. no. 007355902.
132 OHIM notice of grounds for refusal from 21/01/2009 appl. no. 007355902.
public will be relatively high concerning technical goods, their awareness will be relatively low when it comes to purely promotional indications. The examiner made clear that the lack of prior use as well as an unusual character do not make the sign automatically distinctive.

II.2.(c)(bb) OHIM Board of Appeal decision from 29/09/2009

On appeal, the Board of Appeal confirmed the examiner’s decision and dismissed the appeal.

II.2.(c)(cc) General Court decision from 13/04/2011

Having accepted the appeal, the GC found that the decision of the Board of Appeal did not infringe Article 7 (1) (b) of the Regulation and consequently dismissed the action brought by Smart Technologies.

It firstly recalled the judgment of Audi v OHIM concerning the distinctiveness of a slogan. It concluded that a mark consisting of an advertising slogan must be regarded as being devoid of distinctive character if it is liable to be perceived by the relevant public as a mere promotional formula. However, such a mark must be recognised as having distinctiveness if, apart from its promotional function, it may be perceived immediately as an indication of the commercial origin of the goods or services in question.

Secondly, the GC stated that the mark is made up of five German standard words and consists of a perceivably laudatory message considering that the relevant public will be made up of German speaking specialists in the computer field who will not find any unusual variations in regard to German rules of syntax and grammar.

The CG furthermore pointed out that the specific features of that mark do not confer any particular originality or resonance and do not trigger in the minds of the relevant public a cognitive process or interpretative effort such

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133 OHIM Board of Appeal decision from 29/09/2009 not published.
134 Case T-523/09 Smart Technologies v OHIM [2011].
136 Ibid. para. 33-34.
as to make that mark, in the perception of that public, anything other than a mere advertising message extolling the qualities of the goods.\textsuperscript{137}

The GC finally dismissed the argument, relied on by Smart Technologies, that in referring to the manufacturer by using the element ‘wir’ (‘we’) the mark applied for contains an indication of the commercial origin of the goods and services covered because, according to the GC, the use of that element takes away nothing from the fact that the mark remains a mere advertising slogan liable to be used by any trader.\textsuperscript{138} Nonetheless, Smart Technologies proceeded to the CJEU.

\textbf{II.2.(c)(dd) CJEU decision from 12/07/2012\textsuperscript{139}}

The CJEU recalled the principles of distinctiveness of a slogan established by case law, in particular by \textit{Erpo Möbelwerk v OHIM} and \textit{Audi v OHIM}.

Firstly, it found that the findings of the GC in paragraph 31 of the judgment under appeal did not disclose a misreading of the principles established by this Court: ‘In so far as the public perceives the mark as an indication of the commercial origin of goods or services, the fact that the mark is at the same time understood – perhaps even primarily understood – as a promotional formula has no bearing on its distinctive character’.\textsuperscript{140} According to the CJEU, the GC based its conclusion on the fact that the relevant public would not tend to perceive in the sign any particular indication of commercial origin, beyond the promotional information that the goods in question make the performance of a complex task simple. Consequently, the GC did not base its conclusion on the mere fact that the sign was a promotional formula and thus, the CJEU rejected the first limb of the first ground of appeal.

Secondly, the CJEU stated that the GC did not, contrary to the complaint of Smart Technologies, create a subcategory of word marks for slogans. It did

\textsuperscript{137} Ibid. para. 37.

\textsuperscript{138} Ibid. para. 40.

\textsuperscript{139} Case C-311/11 \textit{Smart Technologies v OHIM} [2013].

\textsuperscript{140} Case C-311/11 \textit{Smart Technologies v OHIM} [2013] para. 32.
not apply stricter criteria than those established for word marks. The Court rejected therefore the second limb of the first ground of appeal.\textsuperscript{141}

The Court held, thirdly, that the fact that the relevant public is made up of German speakers who are specialists in the computer field has no decisive influence on the legal criteria used to assess the distinctiveness of a sign. Even though attention of a specialist public is higher than that of an average consumer, it does not necessarily follow that a weaker distinctive character is sufficient where the relevant public consists of specialists.\textsuperscript{142} The Court added that, in any event, findings in relation to the attentiveness, the perception and the attitude of the relevant public concern appraisals of fact. Those appraisals of facts are not part of the assessment of an appeal which lies according to Article 256 (1) TFEU on point of law only.\textsuperscript{143}

\textbf{II.2.(d). Oetker v OHIM - La qualité est la meilleure des recettes}

A recent decision of the General Court concerned the French slogan LA QUALITÉ EST LA MEILLEURE DES RECETTES which was tried to be registered as Community trademark by the German food producer Dr. August Oetker Nahrungsmittel for classes 16, 29, 30 and 32, namely books and newspapers, foodstuff, baking products and beverages. It can be translated as ‘Quality is the best recipe’.

\textbf{II.2.(d)(aa) OHIM examiner decision from 24/08/2010}\textsuperscript{144}

The examiner refused the registration of the slogan on the ground that it lacked distinctiveness.

Firstly, it is recalled that the distinctiveness has to be assessed with regards to the goods or services in question and the relevant public. It stated moreover that the attention of the consumer depends on the kind and quality

\begin{flushright}
\textsuperscript{141} Ibid. para. 40-44.
\textsuperscript{142} Ibid. para. 48.
\textsuperscript{143} Ibid. para. 51.
\textsuperscript{144} Appl. no. 009011669.
\end{flushright}
of the goods. The examiner reminded of the fact that a compound trademark has to be assessed as a whole.

The examiner went on saying that the relevant public of the products at issue are average consumers of the French speaking community since the slogan is in the French language.

It was held that the slogan consists of several words that describe the goods and is thus devoid of distinctiveness. According to the examiner, the relevant public will perceive the slogan as advertising statement that conveys the message that the positive characteristics of the goods will help to produce the best recipes. The relevant public will therefore perceive it only as promotional formula and not as indication of origin. It is not unusual and a normal characteristic of foodstuff, baking products and beverages to be of a quality that helps to produce good recipes. Consequently, the application must be refused for the classes 29, 30 and 32. Only for class 16, books and newspapers, the slogan could be registered.

The applicant referred to the CJEU’s decision in VORSPRUNG DURCH TECHNIK pronouncing the comparability of this slogan and the one at issue. But the examiner held that the two cases are not comparable neither regarding the word row, the message, the language nor the goods.

II.2.(d)(bb) OHIM Board of Appeal decision from 08/07/2011

Upon the applicant’s appeal, the Board of Appeal confirmed the decision of the examiner.

It stated that there is nothing grammatically incorrect or syntactically unusual about the structure of the sign applied for since it complies with French rules of grammar or syntax. Moreover, it was found that for foodstuffs and beverages, relevant consumers will perceive the sign as a plain statement making clear that they are confronted with products which are produced by using methods that guarantee a high quality. According to the Board, French speaking consumers will clearly, directly and

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146 Case T-234/01 Andreas Stihl v OHIM [2003] para. 32.
149 Ibid. para. 19.
unambiguously understand that promotional meaning and perceive the sign as referring to a positive aspect of the goods at issue.\textsuperscript{150} The everyday language and the lack of any hint of fantasy or resonance and the fact that the public perceives it only as promotional formula opens out to the slogan’s non-distinctiveness.\textsuperscript{151}

The Board examined furthermore, whether the slogan had acquired distinctiveness, according to Article 7 (3) of the Trademark Regulation. This is the case – as previously pointed out – if a significant proportion of the relevant section of the public identifies the goods or services concerned as originating from a particular undertaking because of the mark. The Court recalls the elements that were developed in the \textit{Windsurfing Chiemsee}\textsuperscript{152} decision that have to be considered in this assessment. Since the sign lacks distinctiveness with regards to the French speaking public, it must be established that the sign acquired distinctiveness in the French speaking community. The fact that the mark was used in Germany as the German translation ‘Qualität ist das beste Rezept’ is consequently irrelevant since a mark has to acquire distinctiveness in the particular geographic zone where it was found to be devoid of distinctive character.\textsuperscript{153} The Board concluded that the applicant did not provide sufficient evidence for the presence and degree of recognition of the slogan in the French speaking community.\textsuperscript{154}

**II.2.(d)(cc) General Court decision from 12/02/2014\textsuperscript{155}**

In the following instance, the GC confirmed the decision of the Board of Appeal. Firstly, the GC referred to the recent CJEU’s decisions on slogans (\textit{Audi} and \textit{Smart Technologies}). The complaint of the applicant that the Board had only examined the single words of the slogan was dismissed because, according to the GC, the Board had also assessed the mark as a whole.\textsuperscript{156} The complainant submitted moreover that the slogan is a paradox which has to be interpreted by the consumer. The GC rejected that argument

\textsuperscript{150} Ibid. para. 24.
\textsuperscript{151} Ibid. para. 26.
\textsuperscript{152} Cases C-108/97 and C-109/97 \textit{Windsurfing Chiemsee v Huber} [1999].
\textsuperscript{153} Ibid. para. 37.
\textsuperscript{154} Ibid. para. 39.
\textsuperscript{155} Case T-570/11 \textit{Dr Oetker v OHIM} [2014].
\textsuperscript{156} Case T-570/11 \textit{Dr Oetker v OHIM} [2014] para. 40.
because the slogan conveys a simple advertising message without any ambiguity.\textsuperscript{157} The GC clarified furthermore that the Board did not reject registration on the ground that the slogan is a long word order or cannot prove an imaginative element; it only used the criteria as indications of distinctiveness.\textsuperscript{158}

Concerning the comparison of the slogan at issue with Audi’s VORSPRUNG DURCH TECHNIK, the GC stated that not only length, language and content are different but also the relevant goods. The consumer has a higher attention concerning cost-intensive cars than concerning day-to-day foodstuffs and beverages.\textsuperscript{159}

Finally, the GC confirmed the decision of the Board in regards of acquired distinctiveness.

\textbf{II.2.(e) Deutsche Bank AG – Passion to Perform}

The German global banking and financial services company Deutsche Bank AG obtained from WIPO an international trademark registration designating the European Union for the word sign PASSION TO PERFORM. The registration was made in respect of the classes 35, 36, 38, 41 and 42 of the Nice Classification, namely, advertising, insurance, telecommunication, education and technological services.

\textbf{II.2.(e)(aa) OHIM examiner decision from 29/08/2011\textsuperscript{160}}

The examiner refused registration on the ground that the sign lacked distinctive character. The applicant filed an appeal to the Boards of Appeal.

\textbf{II.2.(e)(bb) OHIM Board of Appeal decision from 24/04/2012\textsuperscript{161}}

The 4\textsuperscript{th} Board of Appeal upheld the refusal of registration. It found that the relevant public consists of end consumers and commercial undertakings in

\textsuperscript{157} Ibid. para. 43.
\textsuperscript{158} Ibid. para. 47-54.
\textsuperscript{159} Ibid. para. 60.
\textsuperscript{160} OHIM decision from 29/08/2011 not published.
\textsuperscript{161} Decision R 2233/2011-4 from 24/04/2012.
the United Kingdom and Ireland and that their attention regarding a promotional formula is relatively low. It examined moreover that the single parts of the sign as well as the sign as a whole is lacking originality and conveys the simple message that Deutsche Bank AG will perform the services with passion. According to the Board, the slogan will be understood by the relevant public only as laudatory formula and consequently not fulfil the function of a trademark to distinguish the services in question from those of another undertaking. The applicant proceeded to the General Court.

II.2.(e)(cc) General Court decision from 25/03/2014\textsuperscript{162}

The GC confirmed the decision of the Board of Appeal. Firstly, it reminded of the CJEU’s case law on the distinctiveness of slogans, as developed in \textit{Erpo Möbelwerk, Audi} and \textit{Smart Technologies}. It found furthermore that the Board of Appeal did not require an additional original or fanciful element. The GC referred to case law stating that the attention of the public regarding advertising slogans is relatively low – irrespective of whether it involves more or less attentive consumers. The CG held that the average consumer perceives the mark as a whole without analysing the independent parts of it. Thus, the overall impression of the sign should be assessed. According to the GC, the sign in question does not provide several meanings – the message is clearly the performance of the services in question with passion. Besides, the fact that the slogan combines an emotional word with an intellectual word does not confer distinctiveness on the slogan. According to the GC, this combination is not unusual regarding the services in question. Regarding the applicant’s submission that the slogan was registered in several anglophone countries, the GC stated that this does not decisively influence the distinctiveness of a sign because the Community trademark system is independent from national systems. The GC concluded that the sign was devoid of distinctive character.

\textsuperscript{162} Case T-291/12 \textit{Deutsche Bank AG v OHIM [2014].}
II.3 The CJEU’s approach and general view on OHIM’s requirements

From the analysis of the recent cases, it is observable that the CJEU provides a line of analysis concerning the distinctiveness of slogans. Firstly, signs that are used as advertising slogans containing indications of quality or incitements to purchase are not excluded from registration merely by virtue of such use. The fact that it is more difficult to establish distinctiveness of a slogan does not justify laying down stricter requirements than for other signs than slogans. Moreover, an advertising slogan cannot be required 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 required under Article 7 (1) (b) of the Regulation.

In addition to that, the mere fact that a mark is perceived by the relevant public as a promotional formula and that, because of its laudatory nature, it could in principle be used by other undertakings, is not sufficient, in itself, to support the conclusion that this mark is devoid of distinctive character.

In so far as the public perceives the mark as an indication of that origin, the fact that the mark is at the same time understood as a promotional formula has no bearing on its distinctive character.

It is apparent from the analysis of the three cases that the CJEU in the last years tended to implement less strict requirements for the distinctiveness of slogans. While it said in Erpo Möbelwerk v OHIM that a slogan may be understood both as indication of origin and as promotional formula it held in Smart Technologies v OHIM that it may be even primarily understood as a promotional formula. Only a slogan that consists exclusively of a promotional formula is devoid of distinctive character.

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It is, in the author’s opinion, questionable whether the decision on Audi’s slogan VORSPRUNG DURCH TECHNIK is an outstanding exception of trademark registration of a slogan. In fact, the CJEU used the same reasoning in this case like in other cases concerning the distinctiveness of a slogan. The decisive fact was in this case that the slogan was used for other goods and consumers are thus used to establish the link between the slogan and the undertaking and are consequently enabled to make the link between other products and the undertaking in question, too. It is also argued in literature that this criterion does not really fit into the regular test of distinctiveness for a trademark application and indicates the somewhat exceptional character of the decision which therefore cannot be seen as a U-turn in European case law on the distinctiveness of a slogan.167

The GC and the CJEU criticised the Board of Appeal several times for applying different or stricter criteria for assessing the distinctiveness of trademarks consisting of advertising slogans.168 The GC’s and CJEU’s reproach seems unjustified in the author’s opinion. After all, the Boards of Appeal has not put up a new requirement for a sign to be original or imaginative in order to be distinctive. It was simply held that original or imaginative signs are more likely to possess distinctiveness than a sign that is banal. OHIM states clearly in the new Guidelines that no stricter criteria should apply to slogans than to other signs in the examination of absolute grounds.169

II.4 OHIM Guidelines on Slogans

OHIM uses guidelines for the examination of Community trademarks. These guidelines are the main reference for users of Community trademarks reflecting OHIM practices. They contain general instructions and are not

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167 Altenburg, INTA Bulletin Vol. 66 No. 16.
legally binding. OHIM updates and aligns the Guidelines with recent examinations and jurisprudence. It gives a good summary of the present situation of trademark protection of slogans. The first set of OHIM’s most recent Guideline updates entered into force in February 2014. The second work package will be delivered in June 2014.

With regards to the distinctiveness of slogans, the Guidelines state that the CJEU has ruled that no stricter criteria should apply to slogans than to any other type of signs. A slogan will be found devoid of distinctive character if the public perceives it only as promotional formula. The Guidelines furthermore set criteria that should be used during the assessment of distinctiveness which were developed in VORSPRUNG DURCH TECHNIK and WIR MACHEN DAS BESONDERE EINFACH: a number of meanings, a play on words, elements of conceptual intrigue or surprise, so that it may be perceived as imaginative, surprising or unexpected, some particular originality or resonance and/or a slogan triggering in the minds of the relevant public a cognitive process or requiring an interpretative effort. Mentioned are also the criteria of unusual syntactic structures and the use of linguistic and stylistic devices such as alliteration, metaphor, rhyme, paradox, etc. Nevertheless, the lack of pronouns, conjunctions or prepositions is not always sufficient to produce distinctiveness, bearing the short and simplified character of slogans in mind. For example, in SAFETY 1ST, the use of ‘1st’ instead of ‘first’ was found to be not sufficient to add distinctiveness to the sign. Furthermore, vague signs that require interpretation are more likely to be distinctive. Besides, the Guidelines state that, as held in WIR MACHEN DAS BESONDERE EINFACH, a relevant public consisting of specialists is not decisive when assessing the distinctive character.

The Guidelines furthermore explain that a sign like MORE THAN JUST A CARD for bank or credit card services that describes the goods and services in the usual language is devoid of distinctive character. It is furthermore recalled that laudatory messages cannot be distinctive. For example, WE

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170 Guidelines for Examination in the Office, Part B, Examination 02/01/2014.
PUT YOU FIRST. AND KEEP YOU AHEAD presents the advantage of helping to procure the best position in the business and keeping it. The slogan SAVE OUR EARTH NOW, an appeal with the word ‘now’ which is commonly used in marketing to urge consumers to consume without waiting, cannot be distinctive, either. The Guidelines explain moreover that slogans lacking a secondary meaning, having no fanciful elements or conveying a plain and direct message are devoid of distinctive character. For instance, the slogan DRINK WATER, NOT SUGAR conveys the message to drink real water instead of sugary drinks.

Concerning the assessment of descriptive slogans, the OHIM Guidelines provide that a slogan is not registrable when it immediately conveys the kind, quality, intended purpose or other characteristics of goods or services. It is inappropriate to apply stricter criteria to slogans than to other word marks during the assessment of descriptiveness.

III German Practices concerning Trademark Protection of Slogans

Having treated European practices on slogan registrability, the comparison to be made calls for a detailed examination of the German method in conferring slogans with trademark protection.

III.1 Slogans as German Trademarks de lege lata

The before discussed requirements (Part 2 V) set out in the MarkenG put a certain barrier to the registration of slogans that shall be analysed in the following.

III.1.(a) The requirement of distinctiveness

A slogan is distinctive if the public perceives it as an indication of origin of the goods or services in question. This is, without doubt, the case when the

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172 Guidelines for Examination in the Office, Part B, Examination 02/01/2014 p. 43.
slogan contains an independent distinctive part, like an already registered trademark. Thus, the slogans HOFFENTLICH ALLIANZ VERSICHERT\textsuperscript{173} (hopefully ensured by Allianz) could be registered for class 36, insurances, because it contains the distinctive word mark ‘Allianz’.

The German Federal Court of Justice (BGH) ruled that slogans should not be subject to stricter conditions than other word marks given that trademarks have three different functions, including the advertising function.\textsuperscript{174} It has to be determined whether the public’s perception of a slogan is limited to the advertising function or whether it can be extended to the function of indicating origin.

The BGH developed in its jurisprudence criteria that increase the distinctiveness of a slogan: short and striking character, originality as well as ambiguity and consequently the need of interpretation.\textsuperscript{175} The BGH held furthermore, that there is no need of an additional imaginative element as partly required by the German Federal Patent Court (BPatG).\textsuperscript{176} In any case, even though an additional imaginative element is not required, it helps to increase distinctiveness.

The BPatG in the function of the lower instance of appeal of decisions of the German Patent- and Trademark Office (DPMA) had used in the past a different approach for the registration of slogans. It stated that particular originality and a significant imaginative excess of slogans are required to establish distinctiveness of a slogan.\textsuperscript{177} Some Senates were of the opinion that only original slogans can be able to indicate the origin.\textsuperscript{178} Thus, the BPatG denied the distinctiveness of most of the slogans that lacked a direct indication of origin.\textsuperscript{179}

\begin{flushright}
\textsuperscript{173} DPMA Ref. 396013112.
\textsuperscript{174} Court order BGH from 08/12/1999 ref. I ZB 2/97.
\textsuperscript{175} Court order BGH from 08/12/1999 ref. I ZB 2/97.
\textsuperscript{176} Court order BGH from 13/06/2002 ref. I ZB 1/00.
\textsuperscript{177} Court order BPatG from 23/10/1996 ref. 29 W (pat) 47/95.
\textsuperscript{178} Schurgacz, p. 67.
\textsuperscript{179} Court order BPatG from 23/10/1996 ref. 29 W (pat) 47/95, court order BPatG from 26/02/1997 ref. 29 W (pat) 163/95, court order BPatG from 14/05/1997 ref. 26 W (pat) 7/97.
\end{flushright}
But, due to the jurisprudence of the BGH, the BPatG changed its jurisprudence and accepted the registration of slogans more frequently. It adopted the approach by the BGH for the first time in EIN SCHÖNES STÜCK NATUR (a beautiful piece of nature) by stating that there are no stricter; additional requirements, like originality or an imaginative excess, for the registration of slogans.\textsuperscript{180} It also uses the criteria developed by the BGH but recognizes that the lack of those indications does not lead to non-distinctiveness.\textsuperscript{181} That shows the tendency of registering slogans. This may trace back to the fact that Senates presumed that the public is by now used to the fact that original advertising slogans are capable of identifying the commercial origin.\textsuperscript{182}

However, the BPatG does still not agree with the standpoint of the BGH that a foreign pre-registration increases the distinctiveness of a slogan.\textsuperscript{183} In recent decisions, the BPatG focused on ambiguity and the need of interpretation. Slogans that did not have several meanings or had not to be interpreted were not distinctive. Consequently, the slogan GUT, WENN SICH KOMPETENZEN ERGÄNZEN \textsuperscript{184} (Good when competences complement one another), DIE BANK, DIE BEWEGT (The bank that moves)\textsuperscript{185}, PARFUM ART OPENS YOU THE WORLD OF LUXURY\textsuperscript{186} and FIT FOR MOBILE SERVICES\textsuperscript{187} were found to be devoid of distinctive character. Contrary, BERLIN MACHT SCHULE\textsuperscript{188} (Berlin sets a precedent/a pun referring to school projects); … DA GEH‘ ICH HIN\textsuperscript{189} (… I’ll go there/impossibility to have the offered products for destination) and TRINK WASS\textsuperscript{190} (drink something/implying the first letters of water) found trademark protection because they needed to be interpreted on the ground of ambiguity.

\textsuperscript{180} Court order BPatG from 22/12/1999 ref. 28 W (pat) 54/99.
\textsuperscript{181} Court order BPatG from 22/07/2003 ref. 24 W (pat) 32/02.
\textsuperscript{182} Grabrucker, GRUR 2000, 366, 375.
\textsuperscript{183} Heermann, WRP 2004, 263, 269.
\textsuperscript{184} Court order BPatG from 02/08/2005 ref. 33 W (pat) 29/05.
\textsuperscript{185} Court order BPatG from 25/04/2006 ref. 33 W (pat) 2/06.
\textsuperscript{186} Court order BPatG from 04/10/2005 ref. 24 W (pat) 300/03.
\textsuperscript{187} Court order BPatG from 26/10/2005 ref. 29 W (pat) 268/03.
\textsuperscript{188} Court order BPatG from 26/07/2005 ref. 33 W (pat) 212/04.
\textsuperscript{189} Court order BPatG from 07/06/2005 ref. 27 W (pat) 201/04.
\textsuperscript{190} Court order BPatG from 15/11/2005 ref. 33 W (pat) 402/02.
Some authors of trademark literature follow the former jurisprudence of the BPatG by requiring a significant imaginative excess or an element justifying protection. But the majority of the literature criticized the BPatG for its former jurisprudence. The criteria developed by the BGH (short and striking character, originality as well as ambiguity and consequently the need of interpretation) are accepted very well by the major part of literature.

III.1.(b) The requirement of non-descriptiveness

Purely descriptive or laudatory slogans may be prohibited from registration. For example, BIER MUSS BILLIG SEIN (Beer has to be cheap), DIE QUALITÄT MACHT'S (It’s the quality that makes it) and LEISTUNG OHNE HAST (service/performance without rushing) would be precluded from registration. Similarly, the BGH found the phrase GUTE ZEITEN, SCHLECHTE ZEITEN (Good times, bad times) non-registrable for films, TV content and books because the phrase refers to the content of the TV series in question. On the contrary, FOR YOU was registered for tobacco products. The BGH held that the BPatG was wrong in stating that the slogan was descriptive. In fact, it does not describe characteristics of tobacco products. It is rather a laudatory message which bears no relation to the product and thus, does not fall within the scope of sec. 8 (2) No. 2 MarkenG. The BGH used the same reasoning in TEST IT for tobacco products.

III.1.(c) Acquired distinctiveness through use

The slogan KEINER BRINGT MEHR MENSCHEN IN DIE EIGENEN VIER WÄNDE – SCHWÄBISCH HALL (Nobody brings more people in

193 Kaulmann, Der Schutz des Werbeslogans vor Nachahmung (Carl Heymanns 2006) p. 56 ff. and Dallmann, Nachahmungsschutz für Werbeschlagwörter und Werbeslogans (Nomos 2005) p. 120.
194 Eisenmann/Jautz, Grundriss Gewerblicher Rechtsschutz und Urheberrecht, r. 255i.
195 Court order BGH from 17/05/2001 ref. I ZB 60/98.
196 Court order BGH from 15/07/1999 ref. I ZB 47/96 para. 16.
197 Court order BGH from 23/11/2000 ref. I ZB 34/98.
their own four walls – Schwäbisch Hall) was held by the DPMA to be devoid of distinctive character because it, firstly, only describes the service in question, namely building houses and, secondly, because of the need to preserve availability of the geographic indication of the town ‘Schwäbisch Hall’. The BPatG overruled this decision stating that the slogan had acquired distinctiveness.\(^{198}\) To be more precise, Schwäbisch Hall could prove 67 percent of acquired distinctiveness. This led to registration according to sec. 8 (3) MarkenG.

The BPatG found moreover that the slogan FREUDE AM FAHREN (pleasure while driving) had acquired distinctiveness.\(^{199}\) The applicant showed sales figures and advertising expenses and demonstrated that those efforts had affected the public’s perception of the slogan successfully. 70 percent of the respondents of more than 16 years of age were familiar with the slogan and 47 percent thereof identified BMW as the correct car producer marketing the slogan. The BPatG held that the fact that less than 50 percent of the respondents recognized the slogan as identification of origin is compensated by the fact that the survey was not restricted to the actually relevant public of car drivers and potential car drivers or buyers. The BPatG also recognised the fact that the slogan found disproportionately severe access to public press and specialist literature as a criterion for acquired distinctiveness. A detailed list of usage of the slogan was given by the BPatG.\(^{200}\) Consequently, even though the slogan was not inherently distinctive, it could be registered on the ground of acquired distinctiveness through use.

**III.2 Analysis of German Trademark applications**

In the following, three cases of trademark applications in Germany that went through all national instances will be analysed. The German counterpart instances vis-à-vis the European decisive bodies are the German Patent- and Trademark Office (DPMA), the German Federal Patent Court

\(^{198}\) Court order BPatG from 14/07/2009 ref. 33 W (pat) 121/07.

\(^{199}\) Court order BPatG from 10/12/2003 ref. 28 W (pat) 121/01.

\(^{200}\) Court order BPatG from 10/12/2003 ref. 28 W (pat) 121/01 p. 6-7.
(BPatG) as the lower court of appeal and the Federal Court of Justice of Germany (BGH) as the supreme court in private law. The decisions concern the slogans RADIO VON HIER, RADIO WIE WIR, WILLKOMMEN IM LEBEN and LINK ECONOMY.

III.2.(a) Radio von hier, Radio wie wir
The MDR Saxony-Anhalt radio station filed an application for the registration of the slogan RADIO VON HIER, RADIO WIE WIR (Radio from here, radio like us) as a trademark on 30th June 1992.

III.2.(a)(aa) DPMA decisions
The DPMA refused the registration on the ground that the slogan lacked distinctiveness. According to the DPMA, the public encounters advertising slogans, also in rhymes, every day. They can only perceive it as an indication of origin if it consists of an independent part which is capable of being protected. The slogan in question would only consist of an advertising hint that radio was made at a certain place, in a certain manner but would not indicate the origin.
The second examiner’s decision in the request of appeal had the same reasoning.

III.2.(a)(bb) BPatG decision from 23/10/1996
According to the BPatG, the slogan at issue is an advertising statement that describes the services in question. The slogan indicates a localized and local resident-related programme but it does not indicate the supplier of the service. The content focuses on a down-to-earth-mentality and attachment to the homeland which convey the message of being understood and feeling in good hands. The public might think about and interpret the slogan but it will be aware of the fact that it describes the content of the programme. The BPatG added that the slogan did possess neither an imaginative excess nor

201 Court order BPatG from 16/01/2001 ref. 33 W (pat) 135/00.
originality which would confer distinctiveness on them. It named as an example of originality the contradiction between the actual wording of the slogan and the recognizably intended message.

The BPatG specifically stated about class 42 (goods and services of accommodation and food) that the slogan is not related to goods and services of this class but it does not indicate the origin of the host either. It indicates only that the host is somehow involved in a radio programme. Consequently, the BPatG held that the slogan could not be registered due to the lack of distinctiveness.

III.2.(a)(cc) BGH decision from 08/12/1999

Admitting appeal against the BPatG’s ruling, the BGH held in its decision that slogans should not be subject to stricter requirements than other word marks concerning the distinctive character. It moreover set out indications of distinctiveness which are shortness, originality and conciseness.

The BGH found that the requirements for distinctiveness established by the BPatG were too demanding. Thus, it cannot be required that the slogan consists of an independently characterizing part or that the slogan provides an additional imaginative element.

Even though the public will perceive slogans more often as an advertising description than an indication of origin, it is not approvable to make them subject to stricter conditions. The advertising function and the function to guarantee the origin are not mutually exclusive. Consequently, slogans do only lack distinctive character if they are purely descriptive or laudatory. Moreover, long word orders will be in principle devoid of distinctive character.

In addition to the indications shortness, originality and conciseness, the BGH mentioned also ambiguity and the need of interpretation as support for distinctiveness. The court added that the requirements for originality should not be overstated. It concluded that anyway, a broad standard should be used for the assessment of distinctiveness and that any distinctiveness suffices to make the slogan registrable.

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202 Court order BGH from 08/12/1999 ref. I ZB 2/97.
According to the BGH, the slogan at issue is short and concise and clearly
different from a long word order. It is easily memorable because of the
simple statement formed as a rhyme. The ambiguity furthermore makes the
customer reflect on the interpretation of the slogan. The BGH found that the
descriptiveness of the slogan in question is only one possibility to interpret
the slogan and can therefore not be decisive for the distinctiveness.
According to the BGH, the first part of the slogan in question RADIO VON
HIER (radio from here) may be understood as indication of the commercial
origin. The second part may be understood as an invitation for the audience
to identify themselves with the service. Consequently, the BGH found that
the ambiguity suffices to affirm distinctiveness of the slogan.

III.2.(b) Willkommen im Leben
The applicant tried to register the slogan WILLKOMMEN IM LEBEN
(Welcome to life) for different goods of the classes 9, 16, 38, 41 and 42 of
the Nice Agreement, i.e. recordings, all types of printed matters, offering
and giving information stored in a database.

III.2.(b)(aa) DPMA decision from 21/01/2005
The DPMA refused to register the slogan for some goods of class 38 (sound
recording carriers, printed matter and offering and communication of
information saved in computer databases). The examiner found that the sign
was devoid of distinctive character because it was a slogan formed
according to the rules of common language and generally understandable. It
is a greeting with which somebody is welcomed in life, e.g. the birth of a
child or a new beginning after the overcome of a crisis or an addiction. The
examiner found furthermore that the imprecision in the wording does not
lead to distinctiveness. According to the DPMA, the public is used to short
and striking terms in advertisements and consequently, the term cannot have
another meaning than an objective message. The applicant proceeded to the
BPatG.
III.2.(b)(bb) BPatG decision from 23/03/2008

In conformity with the DPMA decision, the BPatG held that the slogan in question is a general phrase which is used in the context of welcoming newborns or a new beginning after difficult situations. It is supposed to convey positive feelings in advertisements. The BPatG gave evidence for the common use of the phrase as titles of books, articles and TV series. According to the BPatG, the different possibilities of interpretation do not lead to the distinctiveness of the sign because each of the possibilities is an objective banal message without any individuality and not capable of distinguishing goods and services from one undertaking from those of another.

Moreover, the BPatG stated that foreign pre-registration can be an indication for the distinctiveness of a sign. However, in the present case, the fact that the mark was registered in Switzerland and Austria did not help the distinctiveness of the sign because the requirement of a foreign language was not fulfilled.

The BPatG concluded that the slogan was devoid of distinctive character.

III.2.(b)(cc) BGH decision from 04/12/2008

The BGH confirmed the decision of the BPatG. It firstly repeated the consistent case law concerning the distinctiveness of a slogan. (see above V.1.c) It stated afterwards that the slogan at issue lacks distinctive character, even when considering a broad standard in the assessment, because it is a banal statement describing the goods and services in question.

The BGH moved on saying that the uncertainty in regard to the content does not help to fulfil the requirement of distinctiveness. Even though ambiguity and need of interpretation increase the likelihood of distinctiveness, in this case, they do not lead to distinctiveness because all possible interpretations are limited to objective messages.

Finally, the BGH found that the fact that the sign was pre-registered abroad in the German speaking countries Austria and Switzerland did not change

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203 Court order BPatG from 26/03/2008 ref. 29 W (pat) 23/05.
204 Court order BGH from 04/12/2008 ref. I ZB 48/08.
the findings on distinctiveness. It concluded that such a pre-registration in foreign countries should be considered in the assessment of distinctiveness but in this case, the pre-registration did not establish distinctive character.

III.2.(c) Link economy

The applicant applied for registration of the slogan LINK ECONOMY for goods and services of the classes 16, 35 and 41, namely printed matter, advertising and education.

III.2.(c)(aa) DPMA decision from 26/04/2006

The DPMA rejected the registration partly for some goods of the classes applied for. It stated that the slogan means 'economy of links' and consequently describes the goods and services in question. According to the examiner, the internet is a very promising market with regard to advertising income and the message conveyed by the slogan is therefore rather clear. Consequently, the DPMA refused registration because of the need to preserve availability.

III.2.(c)(bb) BPatG decision from 18/03/2009

Contrary to the DPMA, the BPatG found that the objection of lacking distinctiveness is rather fulfilled than the objection due to the need to preserve availability.

The BPatG recalled the requirements for distinctiveness of a word mark: A word mark is devoid of distinctive character if it has a purely descriptive content or if it is an usual term in German or another known language which is perceived by the public as such and not as indication of origin, e.g. through the use in advertising. According to the BPatG, LINK ECONOMY cannot be found in a German or English dictionary. However, it has an understandable meaning. It can be easily understood by the public as ‘the value of a webpage’.

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205 Court order BPatG from 18/03/2009 ref. 29 (W) pat 72/06.
The BPatG gave furthermore evidence for the use of the word order in the sense of ‘value of a webpage or a link’. The court highlighted that links are of great importance in the field of advertising for the purpose of sales promotion and image-building. The meaning of the slogan is consequently apparent.

The BPatG examined every class that was applied for separately. It was found that concerning class 16 (printed matters) the word order described the goods and services in question. Regarding class 35 (advertising), it was held that there was a close factual reference to the goods and services under this category. As for class 41 (education) it was pointed out that the word order was only a thematic indication. Consequently, the BPatG found the slogan to be devoid of distinctive character for all the applied classes.

III.2.(c)(cc) BGH decision from 21/12/2011

On appeal, the BGH found that the BPatG was wrong to refuse registration. It concluded that it had too strict requirements for the distinctiveness. It firstly recalled settled case law: A sign is distinctive if it guarantees the commercial origin and distinguishes goods and services from one undertaking from those of another. This is the main function of a trademark. Since the lack of any distinctiveness leads to the non-registrability of the sign, a broad standard may be used for the assessment of the distinctiveness. The relevant public which consists of well informed, observant and circumspect consumers of the goods and services in question delivers the decisive point of view as to which distinctiveness is to be rated.

The BGH found that, in fact, there is no indication of lacking distinctiveness if a word sign is not obviously descriptive and not commonly used. This broad and generous standard applies also to slogans which, as confirmed by settled case law should not be subject to stricter criteria than other word marks. Thus, only if the slogan is descriptive or laudatory it lacks distinctiveness. The BGH recalled the criteria which increase the distinctiveness of a slogan and assesses afterwards the slogan LINK ECONOMY. According to the BGH, the slogan at issue is not descriptive.

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206 Court order BGH from 21/12/2011 ref. I ZB 56/09.
for the goods and services in question, contrary to the conclusion of the BPatG. The BPatG’s conclusion was founded on several interpretative steps and not on spontaneous perception. An analysis in such detail is impermissible because the public does not perceive the sign immediately as descriptive but would need to make the effort of several steps of interpretation.

Moreover, LINK ECONOMY is not a common or usual statement or advertising message. It cannot be seen from the webpages that used the sign that the word order had become commonly used in Germany or that they shaped the perception of the public.

According to the BGH, the interpretation of the BPatG that the slogan is understood as ‘the value of a webpage’ is only one possible interpretation. The DPMA bore in mind different interpretations for the slogan at issue, e.g. ‘activities in the internet and their economic meaning’ or ‘the economy of links’. This is confirmed by the BGH which concluded that the slogan is short, precise and original. Because of the ambiguity it needs to be interpreted and has those above mentioned different possibilities of interpretation. The BGH consequently referred the matter back to the DPMA because it had not assessed the distinctiveness of the slogan yet, since it had too much focused on the need to preserve availability.

III.3 Reflection of the approaches of the BGH and BPatG

The jurisprudence of the BGH has been quite clearly accommodating to the jurisdiction of the CJEU. The general statements concerning the distinctiveness of slogans are identical and will therefore not be repeated.

Furthermore, it has been pointed out throughout the analysis above that the BPatG did take a different approach from the BGH. In the beginning, the BPatG required a slogan to be original and having an additional imaginative element to be distinctive. Even though the BPatG is in the process of evolving and adapting its assessment of distinctiveness, meaning that it uses those criteria not as absolute requirements anymore, it still emphasises the criteria of originality and additional imaginative elements quite a lot. The BGH implements those criteria only as elements capable of increasing the
likelihood for distinctiveness but makes it clear that the non-existence of those criteria does not lead to non-distinctiveness. On the contrary, the BGH stresses the importance of the fulfilment of the main function of a trademark as element of distinctiveness: the fulfilled function to guarantee the origin of goods and services.

IV Criteria influencing the Distinctiveness of a Slogan

Following the analysis of legislation and jurisprudence on national and European level as conducted above, common criteria may be developed from the partially repeated utilization of different arguments and formulas. Their presentation forms the outcome of the thesis at hand and marks the main conclusion on the subject.

IV.1 Criteria that diminish the Distinctiveness of a Slogan

The assessment has shown that there are certain findings commonly upheld by different decision making bodies that have a negative influence on the degree to which a slogan may be perceived as distinctive. They can be summarized in the following criteria.

IV.1.(a) Descriptive sentences

First of all, descriptive sentences cannot be registered. An example is the CJEU’s case of Erpo Möbelwerk v OHIM where the slogan DAS PRINZIP DER BEQUEMLICHKEIT (the principle of comfort) was held to be devoid of distinctive character because it described the goods applied for which were mainly furniture for which the consumer always expects a certain level of comfort. Similarly, the BGH found the phrase GUTE ZEITEN, SCHLECHTE ZEITEN (Good times, bad times) non-registrable for films, TV content and books because it refers to the content of the soap

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207 C-64/02 Erpo Möbelwerk v OHIM [2005].
opera TV series of the same name. Like furniture expectedly providing comfort to the consumer, viewers of a TV drama series anticipate the reflection of character stories with ups and downs as a matter of course. In both cases the descriptive element stood for a certain quality of the offered good that was a general and natural characteristic thereof thus diminishing distinctiveness of a slogan for a particular product.

IV.1.(b) Phrases of general laudatory or positive character

Laudatory terms cannot be registered. Exemplarily, positively-connoted superlatives such as ‘the best’, ‘the cheapest’ and ‘the friendliest’ are devoid of distinctive character because they are purely laudatory. For example, the Board of Appeal upheld the rejection of registration of VISA’s slogan WORLD’S BEST WAY TO PAY for financial services in class 36. Moreover, the GC declared the slogan BEST BUY as ordinary English words that indicate an advantageous relation between the price of the service and their market value. The services in question were business management consultancy, installation and maintenance of automotive audio equipment and technical consultancy etc. The court added that the mere omission of an article (such as ‘a best buy’ or ‘the best buy’) in its structure is not sufficient to make it a ‘lexical invention’ which would be distinctive. The BGH mentioned and confirmed in its decisions on the slogans RADIO VON HIER, RADIO WIE WIR and LINK ECONOMY that laudatory phrases may not be subject to trademark registration but did not expressly recognise a laudatory element in any of the two slogans. In German jurisprudence, the identification of laudatory terms serves mostly as a supportive argument and represents in itself a requirement of minor importance.

European instances seem to require only a low level of laudatory quality in slogans to reprehend their lacking distinctiveness. However, like in German

208 Court order BGH from 17/05/2001 ref. I ZB 60/98.
209 Visa Inc. American multinational financial services corporation.
210 Decision R 45/1999-1 from 15/07/1999.
211 Case T-122/01 Best Buy Concepts v OHIM para. 28.
212 Ibid. para. 32.
national instances, the criterion of laudatory terms was not implemented as a self-standing premise.

**IV.1.(c) General Statements**

General statements lack distinctiveness because those phrases are commonly used and must be open for use by competitors. OHIM held that the phrase REAL PEOPLE, REAL SOLUTIONS consists of a term that other traders who wish to convey the same message should be free to use.²¹³ The applicant sought protection for this slogan for telemarketing and technical support within the classes 35, 37 and 42. The GC confirmed that decision by stating that the consumers would perceive this mark as mere promotional formula. Even though the relevant public’s awareness is relatively high when purchasing computer equipment, they will not see this purely promotional formula as decisive.²¹⁴ However, the GC did not refer directly to the non-registrability of general statements. Nevertheless, this criterion developed by OHIM may be used in the assessment of distinctiveness.

**IV.1.(d) Long Word Orders**

Long word orders are less likely to distinguish goods and services from one undertaking from those of another. Especially in Germany, this statement can be found in decisions on the distinctiveness of slogans.²¹⁵ As an example, the word order DIE VISION: EINZIGARTIGES ENGAGEMENT IN TRÜFFELPRALINEN; DER SINN: JEDER WEISS, WAS WANN ZU TUN IST UND WAS NICHT ZU TUN IST; DER NUTZEN: ALLE TUN DAS RICHTIGE ZUR RICHTIGEN ZEIT (The vision: unique commitment in chocolate truffles; the purpose: everybody knows what to do and what not to do; the benefit: everybody does the right thing at the right time) was held to be too long to be easily remembered by the consumer.²¹⁶

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²¹³ OHIM decision from 15/03/2000 appl. no. 001040534.
²¹⁴ Case T-130/01 Sykes Enterprises v OHIM para. 24.
²¹⁵ Court order BGH from 08/12/1999 ref. I ZB 2/97.
²¹⁶ Court order BGH from 01/07/2010 ref. I ZB 35/09.
On the European level, this criterion is less often used. However, the WIPO Intellectual Property Handbook states that a relatively long advertising slogan recommending the goods to the consumer would be, even when reproduced on the packaging, much too complex to be understood by consumers as a reference to the origin of the product.\textsuperscript{217}

**IV.1.(e) Banal grammatically correct sentences**

The CJEU’s later ruling in the matter notwithstanding, OHIM held in its decision concerning the slogan VORSPRUNG DURCH TECHNIK from Audi that banal grammatically correct sentences may not be subject of registration.\textsuperscript{218} The same reasoning was used by the GC in Smart Technologies concerning WIR MACHEN DAS BESONDERE EINFACH stating that this slogan consists of no unusual variations in regard to German rules of syntax and grammar.\textsuperscript{219} The OHIM Board of Appeals also noted in LA QUALITÉ EST LA MEILLEURE DES RECETTES that there was nothing grammatically incorrect or syntactically unusual about the sentence.\textsuperscript{220} In summary, grammatically and syntactically correct phrases are less likely to be conferred with distinctiveness especially when short and simple in their meanings.

**IV.2 Criteria that increase the Distinctiveness of a Slogan**

On the other hand, the decision making bodies acknowledged a number of attributes that affect a slogan’s distinctiveness in a positive way. A digest of these attributes provides classifiable criteria.

**IV.2.(a) Part of the slogan is a registered trademark**

The existence of a registered trademark in the slogan increases the distinctiveness of a slogan. A reference to a word mark in a slogan enables consumers to associate the message of a slogan with the specific source of

\textsuperscript{217} WIPO Intellectual Property Handbook, sec. 2.361.
\textsuperscript{218} OHIM decision from 12/01/2005 appl. n. 003016292.
\textsuperscript{219} Case T-523/09 Smart Technologies v OHIM [2011] para. 33.
\textsuperscript{220} Decision R1798/2010-G from 08/07/2011 para. 16.
origin. For example, CONNECTING PEOPLE, which is highly descriptive for phone services, received Community trademark protection together with the brand name ‘NOKIA’. Similarly, HOFFENTLICH ALLIANZ VERSICHERT (Hopefully insured by Allianz) was more likely to receive distinctiveness because of containing the trademark ‘Allianz’.

IV.2.(b) Extensive use

The extensive use of a slogan as a trademark increases the likelihood of being capable of registration because of acquired distinctiveness in the relevant area where it was in the first place found to be devoid of distinctiveness. For example, the phrase HAVE A BREAK which is inherently devoid of distinctive character could be registered because it was used over many years by Nestlé in relation to advertising its KIT KAT chocolate bar. Similarly, the slogan KEINER BRINGT MEHR MENSCHEN IN DIE EIGENEN VIER WÄNDE – SCHWÄBISCH HALL had acquired distinctiveness in Germany due to its general popularity connected with the corresponding undertaking. As mentioned above, German jurisprudence required a 50 percent threshold of acquired distinctiveness measured by publicity polls. However, the CJEU requires only ‘a significant proportion of the relevant public’ which was not specified yet thus exposing a flexible gap.

IV.2.(c) Contextual use

Next to acquired distinctiveness through use as criterion abolishing the lack of distinctiveness, the hardly categorisable criterion of ‘use’ was introduced by the CJEU in Audi v OHIM as element being capable of increasing the distinctiveness of a slogan. More precisely, the Court held that ‘the fact that members of the relevant public are used to establishing the link between that slogan and the motor vehicles manufactured by that company also makes it easier for that public to identify the commercial origin of the goods’ in question. The associative link could only be established because of the

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221 Trademark no. 004728481.
222 DPMA Ref. 396013112.
223 Case C-353/03 Nestlé v Mars [2005].
224 Court order BPatG from 14/07/2009 ref. 33 W (pat) 121/07.
contextual use of the slogan with Audi as car manufacturer. It further helps to identify the origin of the goods applied for.

**IV.2.(d) Suggestive character**

Suggestive character may help to raise the distinctiveness of a slogan. For example, the Board of Appeal held that the slogan FRÜHER AN SPÄTER DENKEN! suggests in an encoded way to think already now about the future which is emphasized by the exclamation mark. The Board consequently referred the application back to the examiner to assess the distinctiveness of the slogan for investment counseling and financial services.

**IV.2.(e) Shortness and conciseness**

While long slogans have a hard time to be perceived by the public as indication of origin, very short slogans are more likely to be perceived as distinguishing goods and services of one undertaking from those of another. Moreover, providing a short slogan with a precise message may have a great impact on the distinctiveness. This criterion is especially used by the German instances, after being developed by the BGH in RADIO VON HIER, RADIO WIE WIR. With regards to the criterion of conciseness, *Dallmann* believes that it may be a self-standing criterion for distinctiveness. This opinion misconceives that even a concise slogan may be descriptive or advertising.

On the European level, the Board of Appeal regarded the criteria of shortness and conciseness as indications of distinctiveness in their decision on DAS PRINZIP DER BEQUEMLICHKEIT. Moreover, the criterion of shortness is stipulated in the OHIM Guidelines.

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227 See IV.1.(d).
228 *Dallmann*, p. 120.
IV.2.(f) Additional element of originality

A slogan is original if it contains a creative idea. This criterion is very subjective and consequently difficult in practice. It has been disputed for a while. Nevertheless, it was made clear in the jurisprudence that originality is not an absolute criterion. A slogan does not need to be original in order to be distinctive – but being original does increase the distinctiveness of a slogan to a greater extent.

The German BPatG used the criterion of ‘imaginative excess’ for a while as an absolute criterion to affirm distinctiveness but this jurisprudence was abandoned in order to comply with the jurisprudence of the BGH. Nevertheless, it remains a criterion that increases the distinctiveness of a slogan. The OHIM Board of Appeal stated in their decision concerning the slogan DAS PRINZIP DER BEQUEMLICHKEIT that the mark lacks an additional element of originality, thus an additional element of imagination or any fanciful element.\(^\text{231}\) The GC criticized the Board for using this criterion as conferring distinctiveness on a slogan and concluded that an additional element of originality is not necessary but helpful for the distinctiveness. In the new version of the OHIM Guidelines, the criterion of a particular originality or resonance is stipulated as increasing distinctiveness of a slogan.\(^\text{232}\)

IV.2.(g) Particular linguistic and stylistic devices

The GC held in their decision on the slogan LOOKS LIKE GRASS…FEELS LIKE GRASS…PLAYS LIKE GRASS for synthetic green surfaces that a particular rhetorical flourish, poetic character or rhythm may increase the distinctiveness of a slogan.\(^\text{233}\) The BGH held in their decision on the slogan RADIO VON HIER, RADIO WIE WIR that the slogan is easily memorable because of the simple statement formed as a rhyme.

\(^\text{231}\) Decision R 392/1999-3 from 23/03/2000 para. 30.
\(^\text{232}\) Guidelines for Examination in the Office, Part B, Examination 02/01/2014 p. 19.
\(^\text{233}\) Case T-216/02 Fieldturf v OHIM [2004] para. 31.
Additionally, the updated version of OHIM’s Guidelines states that the use of linguistic and stylistic devices such as alliteration, metaphor, rhyme, paradox, etc. may increase the distinctiveness of a slogan.\textsuperscript{234}

\textbf{IV.2.(h) Ambiguity and the need of interpretation}

The criteria of ambiguity and need of interpretation were developed by the BGH in their decision on the slogan RADIO VON HIER, RADIO WIE WIR. In Germany, they are used more and more frequently as the main criteria for determining the distinctiveness of a slogan.

On the European level, the Board of Appeal stated in the case of Erpo Möbelwerk’s slogan DAS PRINZIP DER BEQUEMLICHKEIT that vague, unclear and incomprehensible signs are more likely to be distinctive.\textsuperscript{235} The GC held in the \textit{Audi v OHIM} case concerning VORSPRUNG DURCH TECHNIK that a slogan which is ambiguous, a word play, imaginative, surprising or unexpected proves to be registered easier.\textsuperscript{236} The CJEU confirmed and specified that a number of meanings, a play on words or being perceived as imaginative, surprising and unexpected and easily remembered may confer distinctiveness on a slogan.\textsuperscript{237} The GC held in the \textit{Smart Technologies v OHIM} case that the distinctiveness of a slogan is increased if it triggers in the minds of the relevant public a cognitive process or interpretative effort.\textsuperscript{238} The updated version of the OHIM Guidelines refers to exactly this criterion developed by the GC as well as a number of meanings and a play on words and elements of surprise as criteria for increasing distinctiveness too.\textsuperscript{239}

According to Schurgacz, ambiguity is sufficient for creating distinctiveness; the other criteria may join cumulatively but are not obligatory.\textsuperscript{240} A similar approach can be noticed by the BGH in its recent decisions. However, in the author’s opinion, ambiguity cannot be seen as self-standing criterion for

\begin{footnotesize}
\begin{itemize}
\item \textsuperscript{234} Guidelines for Examination in the Office, Part B, Examination 02/01/2014 p. 19.
\item \textsuperscript{235} Decision R 392/1999-3 from 23/03/2000 para. 29.
\item \textsuperscript{236} Case T-70/06 Audi v OHIM [2008] para. 41.
\item \textsuperscript{237} Case C-398/08 Audi v OHIM [2010] para. 47.
\item \textsuperscript{238} Case T-523/09 Smart Technologies v OHIM [2011] para. 37.
\item \textsuperscript{239} Guidelines for Examination in the Office, Part B, Examination 02/01/2014 p. 19.
\item \textsuperscript{240} Schurgacz, p. 70.
\end{itemize}
\end{footnotesize}
distinctiveness. A slogan can also be distinctive if it does not have several meanings.

**IV.2.(i) Uniformity in the appearance**

The Board of Appeal indicated in its decision concerning PRINZIP DER BEQUEMLICHKEIT that a slogan may be distinctive if it appears to be uniform.\(^{241}\) However, the Board omitted any more detailed specifications on ‘uniformity’. It may be speculated that uniformity refers to an inner coherence of the slogan.

**IV.2.(j) Unusual syntactic structure**

Reversely to what has been stated in IV.1.(e) on grammatically and syntactically correct phrases, incorrect grammar or syntax make a slogan more distinctive. In addition to that, the OHIM Guidelines provide that an unusual syntactic structure may increase the distinctiveness of a slogan.\(^{242}\)

**IV.2.(k) Foreign pre-registration**

Both, BPatG and BGH held in the case on the slogan WILLKOMMEN IM LEBEN that the pre-registration of a slogan in foreign countries should be considered in the assessment of distinctiveness. However in this case, pre-registration in Austria and Switzerland did not influence the distinctiveness because the requirement of a foreign language was not met.\(^{243}\)

However, when the applicants Oetker Nahrungsmittel KG and Deutsche Bank AG tried to enforce the argument that the slogan was registered in another country, the GC dismissed this argument because of the autonomous system of the Community trademark.\(^{244}\)

\(^{241}\) Decision R 392/1999-3 from 23/03/2000 para. 15.

\(^{242}\) Guidelines for Examination in the Office, Part B, Examination 02/01/2014 p. 19.

\(^{243}\) Court order BPatG from 26/03/2008 ref. 29 W (pat) 23/05 and Court order BGH from 04/12/2008 ref. I ZB 48/08.

V Categorisation of Slogans as traditional or nontraditional Trademarks

After having analysed European and German practices of trademark protection for slogans, the question will be addressed whether slogans should be classified as ordinary trademarks or nontraditional trademarks.

V.1 Definition of traditional and nontraditional Trademarks

Traditional trademarks consist for example of letters, numerals, words, logos, pictures, symbols, or combinations of one or more of these elements. Nontraditional trademarks include marks based on appearance, shape, sound, smell, taste and texture. The latter often do not have the main function of guaranteeing the origin of the product. However, they may fulfill the essential function of a trademark.

V.2 Importance of Classification

The question whether slogans are treated as traditional or nontraditional trademarks is of importance concerning criteria for registration. Nontraditional trademarks may be able to guarantee the origin of the product but however, have not been designed with the intent to fulfil the essential function of a trademark. Since the purpose of nontraditional trademarks is often not the main function of trademarks it is more difficult to prove the distinctiveness of nontraditional trademarks. Consequently, specific criteria were developed for the assessment of distinctiveness of nontraditional trademarks. For example, regarding three-dimensional trademarks, the shape applied for as a trademark must depart significantly from the norm of the sector in question in order to be distinctive.245 Colour marks were found to be only in exceptional circumstances inherently distinctive but more likely to acquire distinctiveness through use.246

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246 Case C-104/01 Libertel Groep v Benelux Merkenbureau [2003] para. 66.
The question whether slogans should fall in the category of nontraditional trademarks is consequently of importance because, in that case, special criteria could be required for the registration of slogans as trademarks.

**V.3 Dispute on Classification**

The concept of a ‘slogan’ was developed by case law which did not consider slogans as a special subcategory of word signs, or even a distinct category thereof. The CJEU has, on several occasions, classified word signs with a laudatory connotation as slogans.  The CJEU emphasises in this context that the same criteria for distinctiveness should be applied to all word marks. However admits that it is more difficult to prove the distinctiveness of a slogan because of the main advertising function. But it clarified that those difficulties do not justify laying down specific criteria for slogans supplementing or derogating from the criterion of distinctiveness.

On the contrary, it is argued in literature that slogans should be treated as nontraditional trademarks. According Castonguay, a member of the WIPO Magazine editorial team, slogans form a specific category of signs, as is the case for three-dimensional marks. The reason hereof lies in their nature as they do not directly designate a good or service but support it in commercial terms by enabling the public to link a slogan to a specific company. Slogans thus represent significant investment and effort by companies to draw consumers to their products. It is moreover argued by Keeling, member of the OHIM Boards of Appeal, that it would be counter-intuitive and contrary to the perceptions of the ordinary consumer to categorize slogans as conventional trademarks. For example, average consumers do not

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251 Castonguay, WIPO Mag. April 2010.

252 Keeling, Clearer it could be! Some comments on recent European case law on slogans as distinctive trade marks, p. 219.
consciously think of the shape of the Coca-Cola-Bottle as a trademark. Similarly, they do not knowingly think of the slogan ‘Always drink’ in combination with ‘Coca-Cola’ to represent a trademark in itself.

The opinion that slogans should be treated as nontraditional trademarks finds support in the marketing perspective. The marketing expert David A. Aaker defines a slogan as being ‘the ribbon that ties the package together and provides an extra touch’. According to him, a slogan is an adjunct to the trademark, which can be changed from time to time without changing the trademark itself.

On one occasion, the CJEU has recognized that the case law concerning three-dimensional trademarks is also relevant to word marks consisting of advertising slogans. It held that this would be especially of importance when assessing the distinctiveness of a slogan because the promotional function of an advertising slogan was not of secondary importance to the function of guaranteeing the origin of the product but the main function. Nevertheless, the Court dropped this argument and went on saying that those difficulties do not necessitate stricter criteria for slogans. This latter statement was confirmed by the Court in Smart Technologies v OHIM as well as Audi v OHIM and the most recent GC’s decisions of Dr. Oetker v OHIM and Deutsche Bank AG v OHIM. In the author’s opinion, this reasoning seems contradictory.

V.4 Conclusion
The above discussed position of the CJEU is contradictory. On the one hand, it is emphasised that it is more difficult to establish the distinctiveness of a slogan because of the inherent advertising function. On the other hand,

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254 Case C-64/02 Erpo Möbelwerk v OHIM [2004] para. 35.
255 Ibid. para 36.
256 Case C-311/11 Smart Technologies v OHIM [2012].
257 Case C-398/08 Audi v OHIM [2010].
258 Case T-570/11 Dr Oetker v OHIM [2014].
259 Case T 291/12 Deutsche Bank AG v OHIM [2014].
it is stated repeatedly that this does not justify laying down stricter criteria to slogans.

In the author’s view, it has to be borne in mind, when assessing the distinctiveness of a slogan, that average consumers are not in the habit of making assumptions about the origin of the product on the basis of a slogan. It is consequently more difficult for a slogan to have inherent distinctive character than for an ordinary word mark. This should justify the requirement of specific criteria for the assessment of slogans.
Part D: Final Conclusion

The situation of trademark protection in regard to slogans is far away from being clear. In an enormous number of cases, trademark protection for slogans is denied on the ground that they lack inherent distinctiveness. It is more likely to receive trademark protection through acquired distinctiveness through use.

From the comparison of German and European practices, the conclusion may be drawn that over the past years, the German jurisprudence evolved to be almost identical to the European jurisprudence. Both jurisdictions use similar or partly even identical criteria to assess the distinctiveness of a slogan. The former jurisprudence, especially of the BPatG, set up stricter requirements for the distinctiveness of slogans and affirmed distinctiveness mostly only in cases where the slogan had acquired secondary meaning or was particularly original. However, nowadays, the jurisprudence homogenously uses less strict requirements and tends to register slogans more often. This approach assimilates to the more frequent use of slogans as marketing tools and the familiarisation of the public to slogans as instrument to indicate the commercial origin of products.

It nevertheless still proves to be difficult to establish distinctiveness of a slogan because of their very nature. Slogans have the main function of marketing the product, whereas the function to indicate origin is of secondary importance. The essential function of a trademark is in the case of slogans less apparent. Thus, slogans may still be capable of enabling consumers to connect the origin of a product to a slogan. This is most likely the case when the slogan has been used extensively and has acquired the status that the public makes the link between the slogan and the origin of the marketed product. An example is the popular slogan ‘I’m lovin’ it’ which enables consumers to know immediately and without doubt McDonald’s as the origin of the products because it has been used a lot by McDonald’s since 2003.
In literature, the opinion exists that restrictive requirements for registration equal a de facto denial of registrations of slogans and that losing the priority of registration is an economic restriction of the applicant seeking trademark protection.\textsuperscript{260} Therefore, slogans should not be deprived from trademark registration and requirements on the distinctiveness of slogans should not be too demanding in order to enable their registration in a greater number of cases.

On the contrary, other opinions argue for a more restrictive approach of the assessment of trademark protection for slogans because of their inherent advertising function. According to Keeling, authorities apply ‘rigorously scientific methods in order to arrive at the one-and-only legally correct decision in each case’ just to circumvent discrimination.\textsuperscript{261}

The latter approach seems more comprehensible and convincing. The application of the same criteria for all types of marks equals an artificial sustainment of legally correctly constructed methods. In fact, these methods are contradictory when stating that it is more difficult to establish distinctiveness of a slogan but denying another assessment than that of other signs. Consequently, these methods should be reviewed.

The introduction of specific abstract criteria for slogans seems appealing at first. However, a determination of specific criteria is difficult because, as analysed above, they are very subjective. The most convincing criteria which may be used as requirements are ambiguity and originality. Those criteria confer distinctiveness on a slogan. But especially originality is a very personal sensation. Personal and subjective criteria are difficult to stipulate as absolute and generally comprehensible requirements.

In consequence, even though the stipulation of specific criteria for the distinctiveness of slogans seems reasonable, it is rather not practically applicable. However, it should be avoided to stick too much to the fact that

\textsuperscript{260} Schurgacz, p. 72.
\textsuperscript{261} Keeling, p. 234.
the same criteria must be applied to all types of signs. The decision making bodies should not be afraid of the statement that the developed jurisprudence concerning a word mark might not be applicable to a particular slogan.

*Castonguay* said correctly that there can be no ideal, one-size-fits-all approach. During the assessment of the distinctiveness of a slogan, all elements that were found in case law and collated above may be considered when examining the registrability of a slogan. Trademark protection for slogans should be assessed on a case-by-case-basis.

The final conclusion may be drawn that there is such a thing as a trademark for slogans. It will however remain difficult to prove inherent distinctiveness of a slogan. More likely than inherent distinctiveness is that the slogan acquires secondary meaning through extensive use and becomes distinctive. What remains essential is the essential function of a trademark: A slogan may be registered if it serves to distinguish goods and services from one undertaking from those of another – either because it is directly capable of guaranteeing the origin of a product or because it became capable of doing so through the use of the slogan.

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