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Trademark protection of slogans
in theory and practice
-a comparison between Sweden,
the European Union and the
United States

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Summary

The trademark term has grown and evolved with time. Promoting phrases, i.e. slogans, are one type of mark that may be protected through trademark law. However, this process has not been simple. The inherent characteristics of slogans have caused great hesitation regarding their protection. Slogans consist of a number of words, sometimes full sentences, and often, include advertising messages. Can such marks really fulfill the requirements to qualify for a trademark registration, i.e. be distinctive and not constitute an unacceptable monopoly?

Today, the acceptance of slogans as trademarks is world-wide. The trademark requirements, nevertheless, still eliminate a great number of slogans from receiving protection. Accordingly, slogans with a general laudatory or positive content generally encounter severe difficulties to attain a registration, as well as slogans that are extensive in length. Correspondingly, slogans that are easy to remember, as well as slogans that have been used extensively in marketing, are often protected.

The United States holds an, in certain aspects, leading position in protecting intellectual property; slogans have been protected since the beginning of the 20th century. Sweden constitutes a great contrast, having just recently and thereto, with some reluctance, accepted slogans as trademarks. A close cooperation between the European countries and a legal harmonization within the European Community has forced Sweden to take on an accepting standpoint. Case law from Swedish registration authorities is being synchronized with these new ways. Especially the lower instances seem to take some time to adapt to the changes. Traces of prior views remain and are revealed in a hesitating and inconsequent registration practice and a frequent use of disclaimers.

Preface

I would like to give my appreciations to my supervisor, Per Jonas Nordell for valuable guidance as well as Per Carlson at PBR, Johan Holmér at AstraZeneca, Synnøve Smedal at Kraft Foods and Bengt Staffas at PRV for priceless information and opinions. I would also like to thank Judge Thomas C. Perrone and David F. Perrone.

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Abbreviations

Ds	Departementsserien (the Department Journals, Sweden)
NIR	Nordiskt immateriellt rättsskydd (Nordic Intellectual Property Law Review)
OHIM	Office of Harmonisation for the Internal Market, Alicante
PBR	Patentbesvärsrätten (the Swedish Patent Court of Appeal)
Prop.	Proposition (government bill, Sweden)
PRV	Patent- och registreringsverket (the Swedish Patent Office)
RegR	Regeringsrätten (the Swedish Supreme Administrative Court)
RÅ	Regeringsrättens Årsbok (cases from the Swedish Supreme Administrative Court)
SOU	Statens offentliga utredningar (Official Government reports, Sweden)
TMEP	Trademark Manual of Examining Procedure
USPTO	United States Patent and Trademark Office
VmL	Varumärkeslagen 1960:644 (the Swedish Trademark Act)
WIPO	World Intellectual Property Organization

1 Introduction

The term “slogan”, is of Gaelic origin, and descends from the word “sluagh-gharim”, war cry.¹ The word is interchangeable with the term ”tag-line” that is commonly used in the United States.

The government bill to the Swedish trademark act² states that slogans are sentences, sometimes abridged, or specific expressions with a purpose of impressing something into the public. The term “slogan” has also been explained as a “unique selling proposition”, which is added to a trademark, an explanation or an argument³ and as short, witty commercial sentences used by a producer. In the United States, the Second Circuit stated⁴ that trademarked slogans means a phrase used to promote or advertise a house or product mark.

A slogan usually consists of three to six words. One word might be enough for a slogan to be present. Exhortations should for example normally be considered as slogans⁵ even if they consist of one word, like “SHOUT”⁶ and “JUMP”. The words in themselves usually have a linguistic meaning and are often plain. Many times slogans are also descriptive. Therefore, slogans encounter difficulties receiving protection and where protection is attained, it is limited to the slogan in its whole.⁷

1.1 Background

Originally, a trademark was what the name indicates, that is a mark to put on a product. Over time, the term trademark has grown and evolved. Nowadays almost everything seems to be possible to function as a trademark. Three-dimensional marks and marks consisting of colors, sounds and slogans circulate on the market in great numbers. The development of protecting these marks has however, not been problem-free. The query whether *slogans* may be protected as trademarks, has been bordered with a fear of a monopolization of the common language. It has also been questioned whether a slogan, at all, can fulfill the core requirements of a trademark; a slogan is nothing more than an advertising message, emphasizing a product’s superior qualities. How can such a

¹ The Swedish National encyclopedia, 1995.

² SOU 1958:10 p. 95.

³ NIR 1952 p. 77 Service-merkenes og ferretningsslagordened rettslige stilling, Per Brunsvik.

⁴ Hugo Boss Fashions, Inc. v. Federal Insurance Co., 252 F.3d 608 (2d Cir. 2001).

⁵ Holmqvist p. 431.

⁶ There are several “SHOUT” registrations in Sweden, OHIM and the US. The mark covers products like phone cards (OHIM registration no. 1487842), clothes (Swedish registration no. 361550) and toys (American registration no. 76190669).

⁷ Levin/Bonnier p. 129.

message distinguish a producer's products and services? Today, trademark laws world-wide, states that slogans may be protected as brands. This protection may be achieved in different ways; registration, extensive use or through unfair competition legislation. The requirements for protection are stated to be the same as for any other mark. Despite an acceptance in theory, many slogans fail to attain a protection in practice.

1.2 Purpose

The purpose of this essay is to investigate the current legal status of slogans and their true possibility to receive a trademark protection. The situation in Sweden, the Office of Harmonisation for the Internal Market (OHIM) and the United States will be analyzed.

It will be examined whether slogans are subjects of any extraordinary evaluations, compared to other word marks and if there are any international differences in the protection of slogans. Provided that such differences exist, they will be accounted for.

1.3 Method

Initially, the legal background to the protection will be stated. In doing so, the content of the E.C. Council Regulation No 40/94 on the Community trademark, the Swedish Trademark Act (Varumärkeslagen 1960:644) and the American Lanham Act will be accounted for. To examine the purposes behind the law, government bills⁸ and national doctrine from Sweden and the U.S. will be of interest. Since Sweden is involved in a Scandinavian trademark law cooperative, doctrine from Denmark and Norway are considered to a certain extent.⁹ After building a theoretical base, the actual practice is investigated by looking into case law in OHIM, Sweden and The United States. Hereto, guidelines and internet resources from the different registration authorities will be of great importance. Additionally, various articles from intellectual property periodicals, such as "Nordic Intellectual Property Law Review (NIR)" and "Brand News" are used. At this point, interviews with the Swedish Patent Office¹⁰, PRV and the Patent Court of Appeal, PBR is considered. To receive a more balanced perspective, views of applicants and trademark holders are of importance. Therefore interviews with the multinational companies AstraZeneca and Kraft Foods are conducted.

⁸ Government bills in the Scandinavian countries are in great extent used as tools to interpret legal texts and are highly valued by the courts.

⁹ Denmark and Sweden are also cooperating as members of the European Union. The country of Norway has chosen not to join this cooperation.

¹⁰ The Swedish Patent Office handles national and international patent, trademark and design registrations.

1.4 Limitation

The subjects of comparison in this thesis are Sweden, the European Union and the United States. Due to European harmonization and integration, Swedish and European Community laws are closely intertwined. An analysis of the Swedish system must therefore include the EC to be complete. Thereto, a continuous internationalization of business makes the EU and the United States the two most important market places for Swedish export. This is another important reason for intellectual property specialists, law students and parties involved or interested in international trade to be familiar with the legislations governing these areas. The legislation investigated is limited to the Swedish trademark Act (Varumärkeslagen 1960:644), the E.C. Council Regulation No 40/94 on the Community trademark and the American Lanham Act. The content of the Harmonization directive 89/104 will only be mentioned briefly.¹¹ The individual state's common law and statutory schemes of registration and protection of trademarks in the U.S. will be excluded from this presentation. From the title of this thesis it should also be fairly clear that it is only the trademark perspective that is of interest. Therefore, unfair competition, copyright and other areas of law which may be applicable to slogans will not be examined. An emphasize will be put on the present status of protection of slogans, thus case law dated back longer than ten years is fairly limited.

1.5 Outline

The investigation is divided into four sections:

The first section aims to establish a base of understanding of the different key concepts. Chapter 2 explains the basics of trademark protection, such as what can constitute a trademark, the means of protection and the criteria to receive such a protection. Chapter 3 investigates the structure and purpose of a slogan in an attempt to clarify the term.

The second section consists of chapter 3 and explains “slogan” as a term. The chapter also establishes the historical development of the protection of trademarks that might explain the differentiations between the subjects of comparison, Sweden, the EU and the U.S.

The third section, chapter 4 to 5, attempts to state common principles applicable to the protection of trademarks in general, and slogans in particular. The main source of information will be case law and practice from courts and registration authorities.

The fourth section is an angle to investigate the true extent of a slogan registration. By analysing registries' view on and use of disclaimers, the author hopes to mirror the

¹¹ Note the difference between an EC regulation and a directive: A regulation is directly binding in the member state, while a directive first needs to be implemented in national law.

acceptance of slogans in practice. An extensive use of disclaimers when registering slogans, implies that authorities are still hesitant to give slogans and other word marks an equal playing-field. Chapter 6 will look further into this issue.

The individual chapters are followed by a brief conclusion. The final chapter, chapter 7, consists of a deeper analysis of the slogan-protection overall as it has been penetrated throughout the thesis.

2 THE BASIC STRUCTURE OF TRADEMARK PROTECTION

“A trademark is any sign that individualizes the goods of a given enterprise and distinguishes them from the goods of its competitors.”¹² This sign can be many things, for instance a word, a figure mark or the characteristic shape of a product. A trademark can also consist of several words and/or a sentence. The trademark law is intended to protect marks where there are both private and community reasons to protect these marks. The protection comes in the form of exclusivity, but never in situations where such exclusivity might create production monopolies.

2.1 The trademark term

A trademark was originally supposed to be attached to the product itself or its packaging. Over time trademark protection has been extended to protect the use of marks in advertisements.¹³ Today, trademark acts all over the world state that a trademark may consist of any sign that distinguishes a certain producer’s goods or services (*see table 1 below*). The tendency in the European Union as well as in the United States is that the word “any” has been taken more and more literally. Therefore, if *any* aspect of a product indicates the source or origin of a product, it is very likely that it is recognized as a trademark.¹⁴

Table 1: Trademark defined across jurisdictions

Jurisdiction	Regulation	Content
The EU	The Council Regulation (E.C.) No 40/94 of December 20 th , 1993 on the Community trademark, Article 4	<i>A Community trademark may consist of any signs capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.</i>
Sweden	Varumärkeslagen 1960:644 of December 2 nd , 1960, Article 1, section 2	<i>A trademark may consist of any sign capable of being represented graphically, in particular, words, including personal names, as well as designs, letters, numerals or the shape or the ornamental aspects of goods or their packages, provided that such signs are capable of distinguish goods which are made available in</i>

¹² WIPO p. 60: (C)(b)(i).

¹³ SOU 1958:10 p. 94.

¹⁴ Levin “Nästan allt kan vara ett varumärke” and Halpern p. 288.

		<i>one business activity from those which are made available in another one.¹⁵</i>
The United States	15 U.S.C. § 1127 Lanham Act § 45	<i>The term “trademark” includes any word, name, symbol, or device, or any combination thereof— (1) used by a person, or (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this Act, to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.</i>

2.2 Ways to receive a trademark protection

Exclusivity to a trademark can usually be achieved in two ways, through registration or extensive use.

2.2.1 Protection through registration

An application for a registration can be performed in several different instances. A registration in a national patent office gives a nation-wide protection. In Sweden, the administrative proceedings and examination of registrations start at the Patent Office, *Patent- och registreringsverket (PRV)*. The decision from PRV may be appealed to the Patent Court of Appeal, *Patentbesvärsrätten (PBR)*. The last instance of appeal is the Supreme Administrative Court, *Regeringsrätten*. The protection of trademarks is regulated in *Varumärkeslagen 1960:644*. The United States, on the other hand, is a Common Law jurisdiction and bases trademark protection on prior adoption and use rather than registration.¹⁶ A trademark may, nevertheless, be registered if it has been used commercially before the application or if the applicant intends to use the mark in the future.¹⁷ A registration is issued by *the United States Patent and Trademark Office (USPTO)*. Appeals are handled initially by *the Trademark Trial and Appeal Board*. Thereafter, the appellant can turn to *the U.S. Court of Appeals for the Federal Circuit*. The American trademark register is divided into the Principal Register (regulated in 15 U.S.C. §§1051 through 1072) and the Supplemental Register (regulated in 15 U.S.C. §§1091 through 1096). Marks that are listed in the Supplemental Register are only considered “capable” of becoming trademarks. The degree of required distinctive character is lower than for Principal registration and the register is therefore open to many marks that cannot be listed in the Principal register. As listed in 15 U.S.C. §1094, a registration only provide a limited protection. A registration does, however, act as a bar against registration of marks likely to cause confusion. Registration in the Principal

¹⁵ Translation provided by WIPO (<http://clea.wipo.int>)

¹⁶ Halpern p. 275.

¹⁷ www.uspto.gov.

Register, on the other hand, ensures nationwide rights and is considered to be prima facie evidence of, for example, the validity of the registered mark and the registrant's ownership.¹⁸

A registration may also cover a number of countries. A registration covering up to 179 states is a possibility, for those residents in a country that is assigned to the Madrid Agreement Concerning the International Registration of Marks and the Madrid Protocol. Such a registration is handled by the World Intellectual Property Organization (WIPO). Since January 1st 1996 it is possible to receive a Community trademark that gives the trademark holder a registration valid in the entire European Union. The registration procedure is regulated in the E.C. Council Regulation No 40/94 on the Community trademark and the registration is handled by *the Office of Harmonisation for the Internal Market (OHIM)*. Noteworthy is that, the criteria for registration has to be fulfilled in every individual country for the registration to pass. Any producer from a state affiliated to the Paris Convention or the World Trade Organization may apply to the OHIM for such a registration. An appeal can be brought before *the Office's Boards of Appeal* and thereafter, *the Court of First Instance*. So far, no slogans have made it to the very last instance in Community trademark cases, *the European Court of Justice*.

2.2.2 Protection based on extensive use

A Community trademark can only be obtained through a registration.¹⁹ In Sweden and the United States, however, a trademark protection can also be received through "extensive use" of a mark (VmL 1960:644, Article 2 and the Lanham Act Sec. 2f). Through extensive use, consumers may begin to associate the mark with a single source. This will in some cases create a right to protection. In the U.S. a mark that has succeeded to establish a protection through extensive use, is said to have received a "secondary meaning".

A registration has, nonetheless, some advantages to a non-registered right. A registration gives a constructive notice to the public of the registrant's claim of ownership of the mark. A registration is also a legal presumption of the registrant's ownership of the mark and the registrant's exclusive right to use the mark. A non-registered right is limited to the geographical area where the mark is recognized as a trademark for the specific producer's goods. The result of this is that more than one producer may have the right to use the mark within the same state. There is also a difference in the timeframe for protection. An established mark is only protected as long as it continues to be established, while a registered mark can be renewed every tenth year for as long as the owner wishes (and continues to use the mark and pay renewal fees).

¹⁸ SOU 1958:10 p. 100-101 and Kane p. 6-3.

¹⁹ Article 6 Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trademark.

2.3 The main requirement for trademark protection: distinctive character

2.3.1 The definition of distinctive character

The main requirement for a trademark registration is distinctive character; a mark must identify the origin or ownership of the article to which it is affixed.²⁰ *Generic terms* are not distinctive and may therefore never be registered. Generic terms consist of the common name for a product or service. The term “scent”, for instance, is the generic term to describe fragrance (*see table 2 below*). Nor may merely *descriptive* terms be registered. The main characteristic of a perfume is scent. “Scent” may therefore not be trademarked for that type of products. Some marks manage to give associations to a certain product or quality, without being descriptive. Examples are SMOKELESS for snuff and NIGHT & DAY for contact lenses. These marks are *suggestive*, and fall under the distinctive category. “Scent” may be registered for menthol cigarettes, since it merely gives associations to the product. “Scent” may also be registered for products that it gives no associations to whatsoever, like furniture and flower pots.

Table 2: Distinctive character, explanation of terms²¹

Mark	Generic term	Descriptive	Suggestive	No association
BALANCE	balance	scales	pharmaceuticals	batteries
SCENT	scent	perfume	tobacco	flower pots
SNACK	snack	chocolate, biscuits	dinner service	measuring-tape
THROAT	throat	throat lozenge	ties	wind instrument
KARATE	karate	gold necklaces, diamond rings	coffee	plastics
LEMON	lemon	essence, soda	juice press	computers

Whether a mark is distinctive or not is determined, firstly, by reference to the goods or services in respect to which the registration is sought. The trademark APPLE for apples, does not identify a certain producer’s apples, but has merely a generic character. It is therefore not *distinctive*. APPLE for McIntosh computers gives *no associations* to the product and has therefore a distinctive character. Table 2 explains the terms further by examples.

Secondly, distinctiveness is ruled on the basis of the perception of the relevant consumers. Professionals are more observant of different marks than regular consumers, as any consumer is more observant when they buy expensive products compared to cheap

²⁰ Established by the U.S. Supreme Court in 1916 in the case “Hanover Star milling Co. v. Metcalf” (240 U.S. 403, 412)

²¹ Model by Holmqvist p. 99.

products and products that are dependent on personal preferences (cars, wine etc.).²²
 Consumers are also considered to be more observant when they buy spare parts.²³

2.3.2 Inherently or non-inherently distinctive character

Trademark laws world-wide refuse protection of marks that are devoid of any distinctive character (*see table 3 below*). There are two ways to receive such character. A mark is either inherently distinctive, or may attain such nature after *extensive use* (Regulation 40/94 Article 7.3; VmL Article 13; 15 U.S.C. § 1052 f).

Table 3: Distinctive character as an absolute criteria for trademark protection

Jurisdiction	Regulation	Content
The EU	The Council Regulation (E.C.) No 40/94 of December 20, 1993 on the Community trademark. Article 7	<p><i>Absolute grounds for refusal</i></p> <p><i>1. The following shall not be registered:</i></p> <p><i>(a) signs which do not conform to the requirements of Article 4;</i></p> <p><i>(b) trademarks which are devoid of any distinctive character;</i></p> <p><i>(c) trademarks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service;</i></p> <p><i>(d) trademarks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade;</i></p> <p><i>2. Paragraph 1 shall apply notwithstanding that the grounds of non-registrability obtain in only part of the Community.</i></p> <p><i>3. Paragraph (b), (c) and (d) shall not apply if the trademark has become distinctive in relation to the goods or services for which registration is requested in consequence of the use which has been made of it.</i></p>
Sweden	Varumärkeslagen 1960:644 of	<i>A trademark may be registered only if it is distinctive. A mark which, exclusively or with only minor changes or additions, indicates the kind,</i>

²² Kocktvedgaard/Levin p. 352

²³ Judgment of the Court of First Instance, Second Chamber, of 3 July 2003, T-122/01 BEST BUY; Judgment of the Court of First Instance, of 5 December 2002 REAL PEOPLE, REAL SOLUTIONS; Intellectual property reading material, WIPO, article 2.329 and 2.330.

	December 2 nd , 1960, Article 13	<i>quality, quantity, use, price or geographical origin of the goods or the date of their production shall not in itself be deemed to be distinctive. In the assessment whether a mark is distinctive consideration shall be given to all circumstances and in particular to the scale and the time of the use of the mark.</i>
The United States	15 U.S.C. § 1052	<i>No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it-</i> <i>e) Consists of a mark which (1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively not descriptive of them, ...</i> <i>f) Except as expressly excluded in subsections (a), (b), (c), (d), (e)(3), and (e)(5) of this section, nothing herein shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce. The Director may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made...</i>

Arbitrary, fanciful and suggestive marks are inherently distinctive.²⁴ *Arbitrary marks* are words which already exist in the language, but are used as trademarks on goods/services with which they are normally not associated, like APPLE for computers and CAMEL for cigarettes. *Fanciful marks* are based on invented words, which do not exist in any language. These types of marks are created solely for the purpose of being marks, like for instance KODAK and ROLEX. A *suggestive mark*, as stated above, suggests the nature of goods, without actually describing it. The mark ORANGE CRUSH has been held suggestive when used on a flavored soda beverage and BROWN-IN-BAG has been held suggestive when used on a plastic bag used to cook meat. Other suggestive marks are ACCENTUATE for perfumes and SOFTY for paper.²⁵

Marks which merely indicate a product's kind, quality or are otherwise descriptive are not possible to register (*see table 3 above*). GUARANTEED STARTING as a service mark for automobile winterizing service for example, was refused registration in the

²⁴ Halpern p. 303 f.

²⁵ Holmqvist p. 240 f.

United States because it describes what the service accomplishes.²⁶ There is, however, an exception. Some marks that are not inherently distinctive may acquire distinctive character through extensive use. This is stated in the Council Regulation, article 7.3, the Swedish Trademark Act, article 13 and 15 U.S.C. § 1052 f (*see table 3 above*). Nowhere in these laws is there an exception stated for *slogans*, hence it is a fair assumption that the rule is applicable to slogans as well. There are cases when applicants try to protect *generic names*, i.e. the common name for a product or service. Examples are the marks LITE for low-calorie beer and SHREDDED WHEAT, for cereal (*see table 2 above*). A generic mark can never be distinctive, not even through extensive use, since such a right would lead to a monopolization of the common language.²⁷ America Online Inc., AOL, tried to register the phrase YOU HAVE MAIL which is used to alert an email arrival. The Court concluded that “you have mail” is primarily perceived by consumers as the common name of a service and therefore generic and not able to be registered.²⁸

There is no general timeline in the EU or in Sweden for when a distinctive character has been attained through use. Rather, distinctive character is judged from a case to case basis, considering the use in time and scale. In the U.S an applicant must solely use a mark for five years before the application will give the mark a presumed distinctive character, i.e. “secondary meaning”.²⁹ The registration authority is though, not bound by this presumption. In questionable cases the authorities can require evidence regarding the extent of the use. This time limit may be shortened. If consumers come to know the mark as an indication of source and immediately associate this mark, a secondary meaning has been successfully created at any time.³⁰

2.3.3 The motives behind the requirement of distinctive character

There are two decisive motives behind the distinctive character requirement. First, simple shapes, reproductions of the product itself or generic terms cannot fulfill the necessary function of a trademark, that is, to individualize a certain producer’s goods and distinguish them from other producers’ goods. Secondly, a non-distinctive/simple mark must not be held under one producer’s monopoly. This would restrain other producers’ actions in an unacceptable way.³¹ The market must be open for other producers to loyally advertise and describe their own products.³²

²⁶ Application of Standard Oil Co., 47 CCPA 829, 275 F.2d 945, 125 USPQ 227, 1960.

²⁷ Fears for trademark created monopolies have been immense in English and Swedish trademark history (see Wessman p. 127 and SOU 1958:10).

²⁸ Am. Online, Inc. v. AT&T Corp., 243 F.3d 812 (4th Cir. 2001), 122 S. Ct. 388.

²⁹ 15 U.S.C. § 1052 f Lanham Act §2.

³⁰ Halpern p. 308.

³¹ SOU 1958:10 p. 269.

³² Holmqvist p. 38

2.4 Conclusion

The term “use” is essential for trademark protection. A trademark right in the U.S. is not secured until the mark has been used in connection with the product or service. American as well as European trademark acts state that descriptive marks may receive a protection if they have been used extensively and therefore have established a secondary meaning. To keep an obtained registration, it is not satisfactory merely to pay fees. All marks must also be used continuously: “Use it or lose it.”³³

³³ Kane p. 1-8

3 SLOGAN AS A TERM

3.1 Commercial slogans

Slogans may be divided into two main categories, political slogans and commercial slogans. A *political* slogan has the purpose to affect the political opinions of the public and for example steer the public in a certain direction in a political election. The purpose of a *commercial* slogan is to remind the consumer of a specific brand³⁴ and influence their future purchases. This may be conducted by giving allusions to a certain life style, effectiveness, and worth in price or other qualities that can be appreciated by the potential consumer. For products that are otherwise similar, a striking slogan is essential. A slogan that is funny, inventive or has a double meaning is often remembered and therefore effective.³⁵ A campaign that made an impression on the Swedish coffee consumers is Gevalia's NÄR DU FÅR OVÄNTAT BESÖK/OM DU VILL HA OVÄNTAT BESÖK ("When you get unexpected visits"/"If you want unexpected visits"), with absurd situations rounded up with the subtle clinks of coffee cups. The campaign was also marketed and successful in Denmark and Finland. Pepsi's slogan COME ALIVE WITH PEPSI might have fulfilled its purpose in the American market, but failed the same in China. The reason was the disastrous translation, "revive your dead ancestors".³⁶ Many slogans are presented to their audience in combination with a short, simple and hum-able melody. It is a well-known fact that mans memory for music is extremely well developed.³⁷ A slogan to a tune makes the slogan and its message easy to remember. One example is Green Giant's IN THE VALLEY OF THE JOLLY, HO-HO-HO, GREEN GIANT.³⁸ Another example is McDonald's recent and simple I'M LOVIN' IT.

To sum up what has previously been stated, a "clever" and effective trademark/slogan should fulfill certain criteria. Firstly, it has to be distinctive. A slogan that is not distinctive is usually a failure, not only in a legal perspective, but also in a marketing sense. The purpose of a trademark/slogan is that consumers "buy a brand" that they recognize as originating from a specific producer. Secondly, a slogan should also be easy to remember. One method is to use a slogan that is witty, rhymes and/or is combined with a melody. Thirdly, a slogan must be effective, in the sense that consumers buy the specific brand, and not brands of competitors. Fourthly, a slogan usually has to be internationally marketable. From the Pepsi example above, it is clear that a product that is subject to export must have a brand name/slogan that is viable internationally.

³⁴ Hugo Boss Fashions, Inc. v. Federal Insurance Co., 252 F.3d 608 (2d Cir. 2001).

³⁵ SOU 1958:10 p. 215 f.

³⁶ Tufegdzic p. 73.

³⁷ Fahlnaes, Brand News 04/2002 p. 25, "Ljudvarumärken".

³⁸ Crossen "Which slogans belong in the hall of fame?".

3.2 Slogans versus other marks consisting of several words

Slogans and trademarks consisting of several words are both embraced in the definition “word mark”. A mark consisting of several words is typically an appellation for a certain product or service from a specific producer. A slogan, on the other hand, is typically advertisement for a product that already exists on the market under a word mark.³⁹ Such a previously existing trademark is not an obstacle for the slogan to function as a mark, since a product can be protected by more than one trademark.⁴⁰ The word mark SNICKERS MARATHON can be compared to the slogan SNICKERS MARATHON - THE ENERGY YOU CRAVE.

Throughout Nordic trademark history it has been important to separate these terms, which may be difficult. Before 1960, slogans could basically not be protected at all, while word marks consisting of several words could. Until 1995 slogans could be protected after extensive use, but registration was still not an option. Today, the Nordic trademark acts does not separate the two terms, and it should therefore no longer be necessary to separate them. Perhaps, all the same, this historical differentiation may still be influencing rulings from the registration authorities in Sweden.⁴¹

3.3 The effects of a trademark protection for slogans

Since slogans are a type of trademark, they are protected from infringement, i.e. like hood of confusion and misleading advertising, in the same extent as any other trademark. A trademark owner has the exclusive right to use the mark/slogan. A famous and successful mark is a desirable prey for others than the rightful owner. The Swedish slogan I CAN'T BELIEVE IT'S NOT BUTTER was denied registration by PRV on the grounds that it was infringing the registered mark I CAN'T BELIEVE IT'S YOUGHURT. The case was appealed but withdrawn before a ruling was made.⁴² No other infringement cases exist in Swedish doctrine. The case law in America is, however, extensive. One example is the case WHERE THERE'S LIFE THERE'S BUGS v. WHERE THERE'S LIFE THERE'S BUD.⁴³ Many try to get around the exclusivity requirement by claiming their use to be a parody of the registered mark.⁴⁴ One example is NIKE's well known slogan JUST DO

³⁹ Information from PRV's intranet, provided by Bengt Staffas.

⁴⁰ McCarthy 7-26.2.

⁴¹ Denmark and Norway are both more liberal (see chapter 3.4.1.2.).

⁴² RÅ 1993 not 492.

⁴³ Chemical Corp. of America v. Anheuser-Bush, Inc., 306 F.2d 433, 134 USPQ 524, 2 A.L.R.3d 739 (5th Cir. 1962), 372 U.S. 965, 10L. Ed. 2d 129, 83 S. Ct. 1089, 137 USPQ 913 (1963).

⁴⁴ Litterature regarding parody is extensive. See for example Delin, Leif ”Om parodi” NIR 1959 and Levin, Marianne ”Varumärkesparodier och annan lek med andras kännetecken i ljuset av den nya Kodakregeln” SvJT 1992, s. 705-720.

IT, that was challenged by the slogan JUST DID IT.⁴⁵ The court, nevertheless, ruled the slogan as infringing NIKE's trademark. The JUST DID IT-company was active in the same market, sweatshirt and T-shirts, and there was a potential risk of confusion between the two competitors. Another, more recent case is Fox's attempt to receive an injunction barring Penguin group from using FAIR AND BALANCED on the cover of a book written by Al Franken. The slogan has been a registered Fox trademark since 1998. The use is a clear case of satire and the request was denied accordingly.⁴⁶

3.4 The development of protecting slogans as trademarks

3.4.1 Sweden

Throughout Swedish trademark practice, slogans have been an individual category of marks, separated from word marks. The resistance towards this type of trademark protection has been strong and persistent.

3.4.1.1 The 1884 Trademark act

According to early case law during the 1884 trademark act, slogans could be registered on the same conditions as any other trademark, i.e. if they were distinctive. One example is the phrase TAG DET RÄTTA- TAG CLOETTA ("Have the right thing, have Cloetta") which was trademarked in 1927. Over time slogans were denied registration in a greater extent, see for example the slogan RÄTT BLÖTLAGT, TILL HÄLFTEN TVÄTTAT ("Soaked the right way, halfway washed") (RÅ 1939 H 78).⁴⁷ The criteria for registration continued to strengthen and soon only slogans that contained an invented word could be registered. Examples of such registered marks are LYCKO, ETT LYCKAT NAMN PÅ EN LYCKAD VARA ("Lycko, a successful name for a successful product") that includes the word mark "Lycko" and I FÖRSTA HAND MODERSMJÖLK- I ANDRA HAND GITRIDO MJÖLK ("First choice mother's milk- second choice Gitrido milk") that includes the word mark "Gitrido".⁴⁸ Eventually only slogans added to a figure mark received protection. This did not protect the slogan in itself, but only the combination of text and figure. The Norwegian law and practice until 1960 followed the Swedish development.⁴⁹

⁴⁵ Nike, Inc. v. Just did it enterprises, U.S. States Court of Appeals for the seventh circuit, 6 F.3d 1225; 1993 U.S. App. LEXIS 24985; 28 U.S.P.Q.2D (BNA) 1385.

⁴⁶ McClam "Judge Denies Bid to Block Franken".

⁴⁷ Holmqvist p. 430.

⁴⁸ SOU 1958:10 p. 95.

⁴⁹ Stuevold Lassen p. 29 f.

3.4.1.2 Scandinavian influences and the 1960 Trademark act

Around 1960 Sweden, Denmark, Finland, and Norway all established new trademark laws. These laws were the results of a Nordic legal cooperation, with the goal to attain greater Nordic harmonization. Due to this, government bills and case law from other Scandinavian countries may be of interest when interpreting Swedish law. Sweden, Norway and Finland did all, up till the harmonization, deny slogans the recognition of trademark. The view on slogans in Denmark was quite different. Slogans were accepted as subjects of registration with the Danish trademark act from 1936. In the discussion preceding the Scandinavian harmonization, Denmark was criticized for holding a far too liberal registration practice. Denmark kept the registration of slogans, but began to apply stricter interpretation of the distinctive character requirement.⁵⁰ Due to influence from Denmark, Norway began to consider the possibility to register slogans. Norway, though, kept a restrictive view. It was held that slogans usually are descriptive and excluded from registration. The Norwegian Committee though expressed that a slogan *in some cases* can hold such a witty and surprising content and original form, that the consumer perceives the slogan to be an indication of origin. In those cases, the slogan should receive a registration.⁵¹ How original the slogans had to be to receive protection was not stated, but the committee held that the level at least should be higher than for registration in the privately owned Norwegian slogan register and also somewhat more stern than the Danish registration practice.

Sweden remained reluctant to registration of slogans, but accepted protection based on extensive use.⁵² Other word marks though, even marks consisting of several words, were still able to be registered. The reasons for this distinction are stated in the government bill that preceded the 1960 Trademark act.⁵³ It was considered important that a producer did not attain a monopoly on a sentence or a phrase.⁵⁴ A second consideration was the expected difficulties for the Swedish Patent Office, PRV, to decide if a slogan fulfilled the criteria for registration. For instance, it could be difficult to establish if a slogan was distinctive and whether it was new. The idea was that by giving recognition to slogans only after extensive use, phrases that lacked distinctive character would be disqualified by a natural course. The investigators behind the government bill had disbelieved that a slogan could be distinctive at all. It was held, that a slogan by its nature describes a product or a quality of a product. At the rare occasions where a slogan is considered distinctive, this distinctiveness depends on ingenuity and wit. Due to this, there would be very few slogans that could be registered. Therefore, there would be very little need, if any, to have the option of a registration.⁵⁵ The possibility to protect well-known marks would be satisfactory enough.

⁵⁰ Olsen (NIR p. 95).

⁵¹ Op. cit.; Stuevold Lassen p. 30.

⁵² Holmqvist p. 430.

⁵³ SOU 1958:10 p. 108.

⁵⁴ Zweigbergk (NIR) p. 86

⁵⁵ Op. cit.

The difficulties of separating word marks that could be registered, from slogans that could not be registered, caused a somewhat confusing case law. As long as a slogan consists of a shortened or an uncompleted sentence or phrase and includes an exhortation or a judgment, a differentiation may be possible. Severe difficulties arise if a slogan is composed of a few or even one single word.⁵⁶ During the 1950s some word marks were considered to have some slogan character to them, but were still objects of registration.⁵⁷ Such examples are HÅLLBARHETENS FÄRGER (“Colors of durability”) for paint⁵⁸, SKÖNHET KOMMER INIFRÅN (“Beauty comes from within”) for beauty products and UNDER BARA GERMA (“Underneath only Germa”) for underwear. WORKS OF ART YOU CAN WALK ON did not receive a protection. Neither did the phrases ORIGINAL-ODHNER, EN MASKIN ATT RÄKNA MED (“Original-Odhner, a machine to count on”) for calculators and USE PEAR’S SOAP AND YOU SPARE SOAP which were perceived to be evident cases of slogan. Some of the word marks that were registered during this time may today very well be registered as slogans; GREEN-JOYS BY FOOTJOY for example.⁵⁹ PBR ruled it to be a word mark and therefore possible to register. This latter opinion is erroneous. PBR stated that the mark did not constitute a sentence or an expression that intends to impress something upon the public, since no specific meaning whatsoever can be read from this combination of words. It should be a common opinion that “green” in this context, implies a golf term, and not a color. Since the mark was intended to cover golf shoes it definitely had a specific meaning.

The rocky development of a trademark protection for slogans in Sweden was finally affirmed in law in 1993, due to the European harmonization directive. This will be examined further in detail below.

3.4.2 The EC

In 1992, the EC Trademark directive⁶⁰ brought about changes in the trademark acts throughout Europe. All member countries of the European Union had to have trademark laws that complied with the directive. According to Article 2 in the Directive, the word “sign”, is to be understood in a wide sense. No kind of sign could, in itself, be excluded from protection. Sweden had to accept slogans as trademarks. In the most recent government bill for a new Swedish trademark law⁶¹, slogan is explicitly expressed in the legal text as an example of trademark.⁶² At the present time, Denmark is the only country

⁵⁶ Op. cit.

⁵⁷ Op. cit.

⁵⁸ For the complete international classification list, in accordance to the Nice Agreement, see Supplement A.

⁵⁹ Holmqvist p. 431.

⁶⁰ 89/104/EEC First Council Directive of 21 December 1988 to approximate the laws of the Member states relating to trademarks.

⁶¹ SOU 2001:26.

⁶² The Directive does not mention slogans, but it is stated that the examples in the article are not exhausting.

in the EU that explicitly includes slogans in the national trademark act⁶³, as an example of marks able to be registered.

Five years after enacting the EC Trademark directive, the European Council issued the Community Trademark Regulation No. 40/94, on the 20th of December 1993, after more than 30 years of discussion.⁶⁴ The directive is one of many steps to reach a common European market. With one registration, producers can protect their trademark in the entire community, and receive the same quality of protection everywhere. The first applications were accepted in 1996.⁶⁵ In a memorandum regarding a new trademark system from the EU Commission, it is stated that the term “sign” is to be interpreted in a wide sense⁶⁶ just like in the Trademark directive and slogans have been accepted as trademarks since the Regulation first was adopted.

3.4.3 The United States

Trademarks, including slogans, are regulated through the Lanham Act, which was adopted in 1946. It is important to remember though, that the Lanham Act only codifies common law. Slogans had been a part of United States trademark protection long before the Lanham Act came into force. Pepsi’s slogan EXHILARATING, INVIGORATING, AIDS DIGESTION was adopted in 1903 and Coke’s slogan A DELIGHTFUL, PALATABLE, HEALTHFUL BEVERAGE appeared in 1904.⁶⁷ These slogans were not registered, but they may have been protected due to extensive use. In fact, most trademarks are protected by extensive use and not registration in the US, both historically and presently. The question of protection is often raised first when the mark is threatened by infringement. An example of this is the case Bickmore Gall cure Co. v. Karns, from 1905. The phrase BE SURE TO WORK THE HORSE for a gall cure for animals was infringed by ALWAYS WORK THE HORSE WHILE USING THE CURE.⁶⁸ Another example is the phrase EVERY GOOD NUT THAT GROWS which after long use by Charles S. Cash Inc. received a protection against a competitor’s use of EVERY FINE NUT THAT GROWS.⁶⁹ The use of the slogan NO THIS IS NOT A VICTROLA was also found to be an act of unfair competition, due to a competitor’s right to the slogan NO THIS IS NOT A PHONOGRAPH.⁷⁰

Even though registration has not been the ordinary routine when protecting trademarks/slogans, it is a possibility. The American Patent Office was, however, for a

⁶³ Varemærkeloven § 2 section 1, no. 1 (LOV No. 451, 10th of June 2003).

⁶⁴ Davies p.33.

⁶⁵ SOU 2001:26 p. 425.

⁶⁶ Bulletin of the European Communities, Supplement 5/80, p. 56. The principle is also stated in the recent Examination guidelines from 2003, CTMR 7(1)(a)8.2.

⁶⁷ Crossen “Which slogans belong in hall of fame?”

⁶⁸ Bickmore Gall cure Co. v. Karns, 134 Fed. 833-1905 (C.C.A., 3rd Cir.).

⁶⁹ Cash, Inc., v. Steinbook, 220 App. D. (N.Y.) 569-1927.

⁷⁰ Estate Store Company v. Gray&Dudley, 41 F (2d) 462 (CCA 6, 1930), 6 PQ 20.

long time opposed to register slogans in the Principal Register. Therefore, the Supplemental Patent Office was originally the only possible registration location for slogans.⁷¹ To be allowed in this Supplemental Register, a slogan needs an ounce of distinctiveness and some degree of creativity.⁷² AMERICA'S FRESHEST ICE CREAM for ice cream, did not even reach this modest level, due to its common laudatory and descriptive nature.⁷³ The justification commonly given in the past, for refusing registration in the Principal Register, has been that the slogan constitutes an advertising feature used in connection with the actual trademark upon the goods. Only after considerable resistance was protection accepted in 1952, in the case *American Enka Corp. v. Marzall*.⁷⁴ The plaintiff, American Enka, manufactured rayon yarn and registered a trademark in 1932. The mark consisted of a combination of words, THE FATE OF A FABRIC HANGS BY A THREAD, at the top of a black rectangle with a thread extending vertically thereon with the words "American Enka" at the bottom. In 1947 Enka applied to register the words THE FATE OF A FABRIC HANGS BY A THREAD alone. The examiner, and thereafter also the commissioner, demanded a disclaimer for all words as a condition for registration. The U.S. District court for the District of Columbia was of another opinion. The Court stated that combinations of words, that are also slogans, may function as trademarks. The word combination in this specific case complies with the definition of a trademark and may be registered without a disclaimer.

3.4.4 Conclusion

The evolution of protection of slogans in Sweden has been very fluctuating. Slogans have long been exposed to a more harsh distinctive character evaluation, and it has been questioned whether slogans can fulfill the core objective of trademarks, i.e. indicate the origin of a product or service. This type of mark has just recently received the same status as word marks. The aversion shown by registration authorities and legislators has been wide and deeply rooted. The reason behind the changes and developments that have taken place is influences from other European countries. Denmark has been the leading Scandinavian country in this issue. The Harmonization directive 89/104 finalized the theoretical acceptance of slogans. However, PBR will not apply any revolutionary changes in practice, since so far, there are still no rulings regarding slogans by the European Court of Justice.⁷⁵

Slogans used extensively in marketing have received protection against infringement throughout American trademark history. Yet, as in Sweden, American registration authorities have been opposed to the registration of slogans. The reason for this was that slogans were not considered as being actual trademarks, but only instruments for advertising. In any case, registration of slogans was expressed in the Lanham Act in the

⁷¹ Goldstein p. 279 f.

⁷² McCarthy p. 7-29.

⁷³ *In re Carvel Corp.*, 223 USPQ 65 (TTAB 1984).

⁷⁴ 92 U.S.P.Q. 111, D.D.C. 1952.

⁷⁵ Carlson, December 16th 2003.

mid 1940's, thereby making American slogan protection far advanced of Swedish protection.

4 GENERAL TRADEMARK PRINCIPLES

It is important to emphasize a few general principles that are applicable when determining a mark's distinctive character and possibility of protection. These principles are applicable to all marks. Still they have often been misinterpreted and/or neglected in slogan case law by registration authorities and lower instances.

4.1 Creativity is not a requirement for a trademark protection

The principle, that a mark does not have to be original to receive a trademark protection, is established in OHIM, WIPO and the American Supreme Court. The line between distinctive character and creativity has caused some confusion.

In the European case Clinique Laboratories Inc⁷⁶, the examiner found the mark BEAUTY ISN'T ABOUT LOOKING YOUNG, BUT LOOKING GOOD, devoid of distinctive character for the applied goods (toiletries and body care preparations, perfumery etc.). The examiner claimed that youth, ageing, looking young and looking good are terms frequently associated with products in class 3 and services in class 42. The slogan LOOKING GOOD... is banal and commonplace and far from expressing an "original message", but is merely an unremarkable twist on a venerable, stereotyped theme. A consumer would not recognize the slogan as a distinguishing sign, but merely as a promotional text associated with the product or services.

The Board of Appeal did not agree with the examiner's view that ideas and notions are rendered commonplace, simply because they refer to beauty, youth and ageing. The Board stated that these "cosmetic philosophies" are not commonly descriptive or desirable words or terms, which competitors may wish to use to promote their products. The appellant also disclaimed protection for the words by themselves. The Board thereto stated that originality is not a criterion for the registration of trademarks as the examiner had expressed. Additionally, "being regarded as a promotional text, should be considered a positive property of the trademark rather than a negative one, as it serves not only to identify the origin of the goods or services to which it relates but also a marketing function in that it draws attention to them." The trademark had previously been accepted for registration in the United States. The fact that originality is not a criterion for distinctiveness is also stated in the European cases BEST BUY and EASYBANK.⁷⁷

⁷⁶ Decision of the Second Board of Appeal of 11 February 1999, R 73/1998-2.

⁷⁷ The Court of First Instance April 5th, 2001 Case T-87/00, Bank für Arbeit und Wirtschaft v. The Harmonisation Office, REG 2001.

The Supreme Court in the United States has expressed that trademarks are not dependent on novelty, invention, discovery, or any work of the brain.⁷⁸ The rule is valid for slogans as well. The slogan YOUR FINANCIAL SERVICE IS OUR BUSINESS for insurance planning services was registered by the American trademark Board, with the explanation that slogans do not have to be work of arts to receive protection. Slogans may on the contrary be trite, dull and nonsensical.⁷⁹ The slogan FROM MAINE'S COOL BREEZE TO THE FLORIDA KEYS for moving services was held to be bad poetry, but nonetheless received a registration.⁸⁰

4.2 Distinctive character shall be based on the mark in its entirety.

Another principle, expressed by the EU and Sweden is that distinctive character shall be based on the entire mark. The principle was established in the case *Lloyd Schuh fabric Meyeer & Co GmbH v. Klijsen Handel BV*⁸¹. The court stated that when determining the distinctive character of a mark it is necessary to take account to all relevant factors and, in particular of the inherent characteristics of the mark. Applied to slogans, this causes distinctiveness decisions based on the full content, and not single words. The full meaning of the phrase, in its commercial character, wit, descriptiveness and laudatory character is of importance.⁸² The Swedish Patent Office received a reprimand by the Patent Court of Appeal for the ruling in the case *GROTH&CO 1869 KOMPETENS GENOM SEKLER*.⁸³ PRV rejected the application for a registration of the mark in class 41 and 42. PRV stated that the combination of words had the character of a laudatory description of the services in question. The words KOMPETENS GENOM SEKLER (“competence through centuries”) should thereto, not be monopolized by one producer. Evidence of use was not presented. PRV further stated that the sentence could be registered with a disclaimer, but this was refused by the applicant. Registration was therefore not granted. The Patent Court of Appeal emphasized that a decision regarding distinctive character, shall be based on the sentence as a whole. The expression KOMPETENS GENOM... has a slogan character and is intended to evoke a perception that the services are executed with knowledge and experience. There is no question that the brand in its whole is distinctive, as it is only suggestive for the services in question. Therefore a disclaimer is not necessary.

⁷⁸ Halpern p. 276.

⁷⁹ *In re Sottile*, 156 USPQ 655 (TTAB 1968).

⁸⁰ *In re Lincoln Park Van Lines*, 149 USPQ 313 (TTAB 1966).

⁸¹ *Case C-342/97 Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*

⁸² *Holmqvist* p. 430.

⁸³ *Brand news* 02/2002, 97-05407.

The Court of First instance scrutinized this principle in a recent case.⁸⁴ The question at hand was whether the mark BEST BUY could be considered distinctive enough for registration. Although the mark was composed of several parts, it had, due to a certain principle, to be evaluated in its entirety. It was added, that this principle was not in conflict with a preceding successive analysis of the different elements in the mark: Firstly the word mark BEST BUY is an ordinary English term that states a generally profitable relation between the price and service. The mark is therefore immediately only perceived as a commercial message or a slogan describing a quality within the products. Secondly, it was declared, so as to the fact that two elements are placed next to each other, and the articles “a” and “the” have been excluded, are not enough to create a distinctive character.

The case DAS PRINZIP DER BEQUEMLICHKEIT is another example. The Court of First Instance emphasized that descriptiveness the phrase had to be determined in relation to the whole phrase and not the singular word “bequemlichkeit”. Truly, “bequemlichkeit”, or “comfort” when considered on their own, does refer to a quality of some of the goods concerned (cars and furniture). The slogan in its full, nevertheless, does not consist exclusively of signs or indications which may serve to designate the quality of the goods concerned.

4.3 First use alone is not enough for a mark to receive a distinctive character

There have previously been discussions in American doctrine, whether proof of first use of a mark, may be an element that increases a mark’s distinctive character. It is now confirmed, that being a first user is a factor that affects distinctiveness. The U.S. patent and trademark office’s rules of practice states, that substantial exclusive and continuous use of a mark in commerce for five years, may be accepted as prima facie evidence of distinctiveness. It is however also stated that further evidence may be required. Thereto, first use will never justify registration of a merely descriptive mark.⁸⁵

Swedish doctrine seems confused on the subject, due to a recent judgment from the Court of First Instance.⁸⁶ The judgment has caused belief that a slogan/mark not used by others is different from well known marks and thereby has distinctive character, and an ability

⁸⁴ BEST BUY Judgment of the Court of First Instance, Second Chamber, of 3 July 2003, T-122/01.

⁸⁵ RULES OF PRACTICE & FEDERAL STATUTES, U. S. PATENT & TRADEMARK OFFICE 11th Edition - November 2, 2003, 37 C.F.R. PART 2-RULES OF PRACTICE IN TRADEMARK CASES §2.41b.

⁸⁶ Judgment of the Court of First Instance (Fourth Chamber) of 11 December 2001, Case T-138/00.

to be registered.⁸⁷ A principle of such nature, where distinctive character is based purely on what is new, would lead to bizarre rulings. Neither is this the intention of the Court. The true meaning of the ruling will therefore be necessary to explain in depth.

The trademark in question was the phrase DAS PRINZIP DER BEQUEMLICHKEIT (“the principle of comfort”). The goods for which the mark was sought were hand-operated tools and cutlery, land vehicles and household furniture (seating, chairs etc). The registration was denied by the examiner, as well as the Board of Appeal. The grounds for denial, were based on two regulations; article 7(1)(b) and 7 (1)(c) of Regulation No 40/94. Article 7(1)(b) provides that *trademarks which are devoid of any distinctive character are not to be registered*. Article 7(1)(c) provides that *trademarks which consist exclusively of signs or indications which may serve to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service are not to be registered*.

The judgment delivered by the Board is a confusing mix of the given two articles. The Board claimed that potential customers will believe that the cars and furniture in question have a particular quality, namely that they have been designed in accordance with the rules and principles of comfort. Consumers will therefore, only perceive the mark as a reference to the kind and quality. The slogan additionally lacked creativity. Due to this, the mark was devoid of any distinctive character. The Board of Appeal, however, approved a registration for goods in class 8.⁸⁸

The Court of First Instance was of another meaning. Firstly the argumentation from the Board regarding Article 7(1)(b) was based on lack of additional elements of imagination, which is unacceptable reasoning. Such an additional element, it was stated, is not required for any mark and slogans are not to be judged on different criteria than other marks. The Court added that a dismissal based on article 7(1)(b) would have been justified only if it had been demonstrated that the combination of the words “das Prinzip der Bequemlichkeit” alone with a term designating a characteristic of the goods or services concerned is commonly used in business communications and, in particular, in advertising. Since no such findings were found in the decision, article 7(1)(b) could not be grounds for refusal. Secondly, it was expressed in deciding whether a sign is descriptive or not according to Article 7(1)(c), the entire slogan must be taken into consideration as well as the goods in question. The Court agreed to the fact that “Bequemlichkeit” on its own refers to a quality of the goods concerned, but stated that the slogan in its full did not consist exclusively of signs or indications, which may serve to designate the quality of the goods.

⁸⁷ Brand news nr 02/2002 p. 20 ”Låga krav för varumärkesskydd”, regarding the Judgment of the Court of First Instance (Fourth Chamber) of 11 December 2001, Case T-138/00.

⁸⁸ For the complete international classification list, in accordance to the Nice Agreement, see Supplement A.

In the case FRÜHER AN SPÄTER DENKEN! (“Think sooner about later!”)⁸⁹, the Court stated that the mark is not exclusively descriptive, but may at best be understood by customers as a veiled reference to the specific services (for capital consultation and financial services in class 36). Neither was it proved that the sequence of words, or a substantial part thereof, would normally be used in reference to the services listed in the application, and that this would render the trademark devoid of distinctive character. The fact that the words “*früher*” (sooner) and “*später*” (later), present in the slogan are occasionally used for advertising this does not in itself justify a refusal of the trademark application.

If a phrase is normally used in reference to the services listed in the application, in particular in advertising, it is considered devoid of any distinctive character. According to the Court of First Instance, proof of being the first to use a mark may therefore at best be a proof of the mark as having some distinctive character, but may never rectify mere descriptive character.

4.4 A trademark protection may not create unacceptable monopolies

The main motive behind the requirement for distinctive character is a concern to maintain a competitive market, where all producers compete on the same conditions. This apprehension is not often explicitly expressed to the applicant as a reason for a rejection. Nonetheless, it is often a consideration. Examples of sentences where a free competition have been a concern are the Swedish slogan, A OCH O (α & Ω)⁹⁰ and the American phrases GOIN’ THE EXTRA MILE used by tire dealers⁹¹ and WE TREAT YOU RIGHT by Dairy Queen for fast food outlets.⁹² The First Board of Appeal has however stated, as long as there are other alternatives to convey the same type of message, an exclusive right presents no obstacles for other traders.⁹³ Where such alternatives exist, it is evident that a monopoly is not a hindrance of competition.

⁸⁹ The Board of Appeal (II), R 153/1998-2, May 4 1999.

⁹⁰ Holmqvist p. 432.

⁹¹ Reed v. Amoco Oil Co., 225 USPQ 876 M.D. Tenn 1984.

⁹² American Dairy Queen Corp. v. TRO Inc., 16 USPQ2d 1077 N.D. Ill. 1990.

⁹³ Decision of 6 April 2001 – R 391/2000-1 CREATING YOUR FUTURE.

4.5 Conclusion

Conclusively, the process of determining whether a mark is protectable can be summarized as follows:

The first step is to determine if the mark has a distinctive character. Marks that are either (1) devoid of any distinctive character or (2) marks that are exclusively descriptive may not be registered. In this process it is important to separate distinctive character from creativity. A lack of creativity is not a hindrance for registration. A mark or a phrase that is normally used in reference to the services listed in the application, in particular in advertising, is considered devoid of any distinctive character. Proof of being the first to use a mark may therefore at best be a proof of the mark as having some distinctive character, but may never rectify mere descriptive character. Whether a mark is descriptive or not shall be based on the entire mark and the goods and services applied for. A descriptive mark may still be registered if it has obtained a secondary meaning through use.

The second step expresses a concern to support an open and free market, by accentuating effective competition. A registration of a mark/slogan may not result in unacceptable monopoly. As long as there are other ways of expressing the same message, a trademark protection is possible.

5 ELEMENTS THAT AFFECT A SLOGAN'S DISTINCTIVE CHARACTER

The general idea is that slogans shall encounter the same criteria for protection as any other word mark. However, slogans present some particular difficulties. The criterion for distinctive character has often a devastating effect on slogans. Slogans often, for instance, emphasize the “supreme” qualities of a product. Such descriptive wordings are not distinguishable and cannot be registered, unless they have acquired secondary meaning through use. The following will be an attempt to find common principles to determine slogans’ distinctive character. Slogans that contain pure praise, valuations, long sentences and pure statements are, for example, generally regarded as having less distinctive character. Some of these principles are applicable to all marks, not only to slogans. The order, in which the principles will be presented, does not represent their degree of importance.

5.1 Elements that diminish a slogan’s distinctive character

5.1.1 Sentences that are descriptive for the goods and services applied for

Descriptive marks that exclusively describe the kind, quantity, quality and purpose etcetera of the goods/service may not be registered. One example of such a word mark is BLANKA (“shiny”) for ventilators, since this is a distinguishing quality for products within the sanitary business.⁹⁴ Many times, the content of a slogan is to emphasize the supreme quality of a product or a service. This is natural since the purpose of a slogan is to increase sales. This is also a common reason why many slogans fail to be distinctive.

The sentence BUILDING RELATIONSHIPS, SOLUTION BY SOLUTION⁹⁵ was denied registration by both PRV and PBR on the grounds that it did not reach the necessary level of distinctive character. The sentence describes the process that often is the base when establishing a business relation between producers in an industrial market. The marketing is focused on specific client contacts and consist of an interaction process, in which one tries to solve different kinds of problems. The trademark is therefore intended to describe a certain character of the services, mainly business management and business administration in class 35. A similar reasoning followed the denial of the

⁹⁴ Holmqvist p. 158.

⁹⁵ Brand news 01/2002: International registration 691.213.

registration of the slogan THE VALUE OF WORKING TOGETHER for consultant services.⁹⁶ Neither is the slogan IT'S ABOUT COMMUNICATION BETWEEN PEOPLE, THE REST IS TECHNOLOGY⁹⁷ perceived by the costumers as anything else than a description of the goods and services in question (computer programs and telecommunication). The US Court have ruled the deodorant slogan USE ARRID TO BE SURE⁹⁸ and the slogan ESCAPE FROM THE ORDINARY⁹⁹ for extraordinary clothing to be purely descriptive phrases, impossible to protect from the use of others. Another descriptive slogan is GUARANTEED STARTING as a service mark for automobile winterizing service.¹⁰⁰

Finally, the slogan WORKS OF ART YOU CAN WALK ON in class 19¹⁰¹ was denied protection in Sweden due to lack of distinctive character. PRV and PBR seem to believe that the mark was descriptive for the products listed in the application, namely flooring and building material. A year before a mark for goods in class 11, A WORK OF ART THAT WORKS, did not encounter any difficulties in receiving a registration.¹⁰² There are reasons to believe that the outcome was an oversight and the case would most likely be ruled differently today. One of the authorities in PRV, Lindqvist, states that the mark WORKS OF ART YOU CAN WALK ON is not describing the products but is merely *indirectly* implying artistic quality. Thereto, the words chosen are not such, that they need to be free for the use of other producers.¹⁰³

5.1.2 Phrases of general laudatory or positive character

Marks that have a positive character encounter difficulties when it comes to receiving a trademark protection. The reason is that they generally are descriptive and fall under the same category as mentioned under 5.1.1 above. Word marks may also have a positive character note for example SUPREME and XPERT.¹⁰⁴

The American slogan AMERICA'S BEST POPCORN!¹⁰⁵, as well as THE BEST BEER IN AMERICA¹⁰⁶, were both held merely descriptive and so highly laudatory that they

⁹⁶ PBR 97-494, NIR 1998 p. 125-126.

⁹⁷ Brand news 01/2001, 97-10187.

⁹⁸ Carter-Wallace, Inc. v. Procter & Gamble Co., 434 F.2d 794, 167 USPQ 713 (9th Cir. 1970).

⁹⁹ Norm Thompson Outfitters, Inc., v. General Motors Corp., United States Court of Appeals for the 9th Cir., 448 F.2d 1293; 1971 U.S. App. LEXIS 7914; 171 U.S.P.Q. (BNA) 328.

¹⁰⁰ Application of Standard Oil Co., 47 CCPA 829, 275 F.2d 945, 125 USPQ 227, 1960.

¹⁰¹ 95/021.

¹⁰² 94-029.

¹⁰³ Holmqvist p. 439f.

¹⁰⁴ SUPREME was denied registration (OHIM R 44/1998-3). XPERT could be registered for products in class 9 (apart from computer related products) and class 16 (OHIM R 230/1998-3).

¹⁰⁵ In re Wileswood, Inc., 201 USPQ 400, TTAB 1978.

were incapable of acquiring distinctive character. The slogan HANDKERCHIEFS OF THE YEAR was also denied registration, stating merely a common expression which only indicates a high quality and not origin. Such a general expression shall thereto, be free for any producer to use.¹⁰⁷ Neither is I LOVE YOU for Radio station services a successful concept. The American Court of Appeals declared that there is a limit to the ability to appropriate the language for exclusive commercial use and the claims of the applicant must have reached and surpassed that limit.¹⁰⁸ The sentence GOIN' THE EXTRA MILE in advertisements for tires, conveys the message that the product (tires) and service are better than others. Consumers that are confronted with the slogan do not associate the slogan with a particular tire dealership.¹⁰⁹ The Swedish slogan DE BÄSTA PRESTATIONERNA ÄR DE SOM VARAR¹¹⁰ (“The best performances are the ones that lasts”) was considered by PRV to be primarily a generally applicable statement and not perceived as means of individualization. The First Board of Appeal dismissed VISA International Service Association's registration of the slogan WORLD'S BEST WAY TO PAY for financial services in class 36.¹¹¹ The Board found that the slogan simply states, in ordinary English, that the appellant's services are the best in the world. The simple rhyme is obvious and banal and whilst this marketing slogan perhaps is attractive, it is not distinctive, and it should not be obtained with an exclusive right. The attempt to protect the phrase BEST BUY has been under consideration by the Court of First Instance.¹¹² The services concerned were business management consultancy, installation and maintenance of automotive audio equipment and technical consultancy etc. The Court declared that “Best buy” is an ordinary English word that indicates an advantageous relation between the price of the services and their market value. The relevant public, therefore, perceives it as a mere promotional formula or slogan. It is not enough to exclude articles (such as *a* best buy and *the* best buy) to give the sentence a character of a “lexical invention” and thereto a distinctive character.

5.1.3 General statements and claims

OHIM and the Swedish Patent Office have expressed that ordinary sentences and general statements cannot be protected. This group of slogans is denied registration on the same grounds as generic word marks: Firstly, such marks are usually not distinctive, since they are commonly used, and secondly, this type of marks must be open to competitors.

¹⁰⁶ In re Boston Beer Co. L.P., 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999)

¹⁰⁷ *Burmel Handkerchief Corp. v. Cluett, Peabody&Co, Inc.* 53 U.S.P.Q., BNA, 369.

¹⁰⁸ *M.B.H. ENTERPRISES, INC., v. WOKY, INC.*, No. 80-1210 US Court of Appeals, 7th Cir., 633 F.2d 50; 1980 U.S. App. LEXIS 13120; 208 U.S.P.Q. (BNA) 391.

¹⁰⁹ *Jerry Reed and T.S.C. Productions, Inc., v. Amoco Oil Company*, No. 3-84-0576 US District Court for the middle district of Tennessee, 225 U.S.P.Q. (BNA) 876 October 3, 1984.

¹¹⁰ Brand news 12/2001, 99-05375.

¹¹¹ Decision of the First Board of Appeal of 15 July 1999, R 45/1999-1.

¹¹² Judgment of the Court of First Instance (Second Chamber) of 3 July 2003, T-122/01.

The slogan REAL PEOPLE, REAL SOLUTIONS for telemarketing and technical support within class 35, 37 and 42 was denied registration.¹¹³ The Court found that consumers in this product area are highly aware of marks that might indicate origin, since they are observant of goods and services that are compatible with their computing equipment. Despite this fact, the consumers would perceive this particular mark as a purely promotional indication. The mark is not directly descriptive, but it is easily understood as signifying that the applicant's services consist in providing pragmatic solutions devised by and for real people. The Court found that the slogan had no qualities that enabled the public to simply and directly remember it as a distinctive trademark for the specific goods/services.

Neither can the sentence DET ÄR INSIDAN SOM RÄKNAS ("It is the inside that counts") distinguish provisions (class 30).¹¹⁴ PRV and PBR stated that the words are not perceived by the consumers as means of individualization for the goods in question, but have only the character of a generally applicable verification or statement. The words WE SMILE MORE are also of such common, ordinary and descriptive character that it cannot be justified to give a single producer an exclusive use.¹¹⁵ Another example of a general statement that cannot be protected is THE VALUE OF WORKING TOGETHER.¹¹⁶

There are many borderline-cases that prove that there is a subtle distinction between what is considered registered and what is not, when it comes to general statements. HEWLETT-PACKARD managed to register the sentence VALUE THROUGH PEOPLE.¹¹⁷ The reason stated was that the words do not have any particular meaning by themselves, and they do not refer to kind or quality or other characteristics of the goods. The slogan vaguely suggests the goods/services ability to add value to an organization. Potential consumers are not certain what they are meant to infer from the words "VALUE THROUGH PEOPLE". This vagueness is sufficient to give the sign a minimum level of distinctiveness. Since the mark is not "devoid of any distinctive character" within the meaning of Article 7(1)(b) CTM it may be registered. Neither would the rights of other traders be unfairly affected if a trademark protection were granted, since the combination of the noun "VALUE" with the words "THROUGH PEOPLE" is not ordinarily used or likely to be used in the trade in connection with the goods and services. The expression CREATING YOUR FUTURE was registered under the same pretences. It was ruled not to have any particular meaning by itself when applied to the goods and services in question (video tapes, books and arrangements of seminars in classes 9, 16 and 41). The First Board of Appeal found that the sentence is not ordinarily used or likely to be used in trade with the specific goods and consumers will perceive the message as vague and

¹¹³ Judgment of the Court of First Instance (Second Chamber) of 5 December 2002.

¹¹⁴ Brand news 11/2000, 97-00848.

¹¹⁵ RAMADA INNS, INC., a Delaware corporation, Appellant, v. MARRIOTT CORPORATION et al., Appellees No. 1 CA-CIV 1543 Court of Appeals of Arizona, Division One, Department A 494 P.2d 64; 1972 Ariz. App. LEXIS 559; 16 Ariz. App. 459; 173 U.S.P.Q. (BNA) 443 March 2, 1972.

¹¹⁶ PBR 97-494, NIR 1998 p. 125-126.

¹¹⁷ Decision of the Third Board of Appeal of 26 OCTOBER 2000, R 853/1999-3.

undefined. The sentence is vaguely suggestive, but that is not enough to say that the mark lacks a distinctive character.¹¹⁸

5.1.4 Phrases as questions

Swedish doctrine implies that slogans created as questions have a low degree of distinctive character.¹¹⁹ When examining accepted applications to OHIM, USPTO and PRV it is very difficult to find registered examples of this type of mark. Either, applicants do not desire this type of marks or the registries deny them. One of the few slogans expressed as a question that has been considered possible to register is Microsoft's slogan WHERE DO YOU WANT TO GO TODAY? This was registered in the United States in 1996.¹²⁰ The registration was cancelled in April 26, 2003, but has been followed by registrations in classes 25, 35, 38, 39, 41 and 42. The same slogan was denied registration in Sweden.¹²¹ It was stated that the combination of words primarily appears to be an ordinary phrase that express a question: The sentence does not have a construction or a content that makes it distinguishable for the goods in question (class 9). The slogan was later registered as an EU trademark¹²² and has now therefore a protection in Sweden as well (in classes 9, 16, 35, 41 and 42). Other European marks that have been registered are WHY NOT? (registration no. 183414) for education and design and development of computer hardware and WHY BE NORMAL? (registration no. 1346709) for clothing and sport equipment. Another American slogan that has received protection is the hamburger chain Wendy's WHERE'S THE BEEF?¹²³

5.1.5 Slogans that are extensive in length and/or fail to stand out from other material

WIPO states¹²⁴ that a relatively long advertising slogan, even when reproduced on the packaging, may be much too complex to be understood by consumer as a reference to the origin of the product. The principle is not expressly stated in any case law from OHIM, nor Sweden. Norwegian doctrine however claims that there is a risk that the more words a slogan consists of, the greater is the risk that the public perceive the slogan as advertisement and not a mark.¹²⁵ This opinion is clearly expressed in the United States, where it is closely intertwined with the principle of non-registration of merely informative content (see chapter 5.2.6 below). J. McCarthy claims that the longer the slogan the less probability that it functions as a trademark and the greater the probability

¹¹⁸ DECISION OF 6 APRIL 2001 – R 391/2000-1 Everett W. JAMES, APPEAL relating to Community trademark application No 1103738, The First Board of Appeal.

¹¹⁹ Holmqvist p. 435.

¹²⁰ Registration number 1989047.

¹²¹ 96-663.

¹²² registration number 79814.

¹²³ registration number 1410896.

¹²⁴ WIPO, Intellectual Property Reading material, section 2.347.

¹²⁵ Stuevold Lassen p. 67.

that the slogan is merely advertising copy.¹²⁶ NEXT TIME YOU'RE CAUGHT IN A DOORWAY WITH YOUR ARMS FULL, THINK WIREHANDLER¹²⁷ was considered not to be an indicator of source, but merely informational. Moreover, it was stated that the twelve worded slogan was too long and also buried among too many other words and slogans in advertisements. The slogan was printed in two advertisements that contained a substantial amount of text, including other slogans, such as MORE PULL LESS PUSH, THE WIREHANDLER. The slogan in issue was not emphasized, highlighted, larger or of a different color. The court found that the slogan simply did not stand out amongst all of the clutter. "Rather, it is buried at the bottom of the page and in small print." Due to these reasons, the slogan was found to be very unlikely to function as a trademark.

5.1.6 Explanatory, instructional or informational statements

Throughout American case law practice slogans that are merely informational have consistently been denied registration. For example was the slogan FOR A DAY, A WEEK, A MONTH OR MORE!¹²⁸ found merely informational and not possible to register for hotel services. Denied was also the slogan DRIVE SAFELY for Volvo automobiles. The phrase was found to be an everyday, commonplace safety admonition and therefore not able to be registered.¹²⁹ The same was ruled for Volvo's attempt to register the phrase WATCH THAT CHILD.¹³⁰ THINK GREEN was found impossible to register for weather-stripping and paper products, since it was perceived simply as a slogan of environmental awareness and/or ecological consciousness.¹³¹ In the case *In re Remington Products Inc.*¹³², PROUDLY MADE IN USA, for electric shavers was held incapable of functioning as a mark. Other examples of denied slogans are THE BABY BOOTIE SOCK THAT WILL NOT KICK OFF for socks that was held incapable as functioning as a mark¹³³ and SOIL IT-WASH IT-NEVER NEEDS PRESSING that was held to be merely informative advertising for neckties.¹³⁴

Slogans that are informational, but still distinctive and therefore able to be registered are HAIR COLOR SO NATURAL ONLY HER HAIRDRESSER KNOWS FOR SURE for a hair coloring preparation¹³⁵ and QUALITY THROUGH CRAFTSMANSHIP for radio equipment.¹³⁶

¹²⁶ McCarthy § 11A.

¹²⁷ *Smith v. M&B Sales & Mfg.*, 13 U.S.P.Q.2d 2002, 2010 (N.D. Cal. 1990).

¹²⁸ *In re Brock Residence Inns, Inc.*, 222 USPQ 920 (TTAB 1984).

¹²⁹ *In re Volvo Cars of N. Am. Inc.*, 46 U.S.P.Q.2d 1455 (T.T.A.B. 1998).

¹³⁰ *In re Tilcon Warren, Inc.*, 221 USPQ 86 (TTAB 1984).

¹³¹ *In re Manco Inc.*, 24 USPQ2d 1938, 1942 (TTAB 1992).

¹³² 3 USPQ2d 1714 (TTAB 1987).

¹³³ *In re Sanda Hosiery Mills*, 154 USPQ 631 (TTAB1967).

¹³⁴ *In re Superba Cravats, Inc.*, 149 USPQ 852 (TTAB 1966).

¹³⁵ *Roux Laboratories, Inc. v. Clairol Inc.*, 427 F.2d 823, 166 USPQ 34 (C.C.P.A. 1970).

¹³⁶ *In re The Hallicrafters Co.*, 153 USPQ 376 (TTAB 1967).

5.2 Elements that increase a slogan's distinctive character

5.2.1 Extensive use

As stated earlier, a descriptive word mark or slogan is usually not possible to protect. There is nevertheless, an exception when the mark has gained public recognition, and is closely identified with the goods of one particular producer. The length and manner of use, as well as the nature and extent of advertising, are all factors that affect whether a descriptive mark receives registration or not.¹³⁷ Noteworthy is, however, that the more descriptive a term is, the more difficult it will be to prove a secondary meaning. Thereto a higher percentage of consumer awareness will be necessary.¹³⁸

The slogan EXTRA STRENGTH PAIN RELIEVER for the headache relieving product EXCEDRIN is truly descriptive. It was nevertheless given protection, having achieved a degree of identification with the product through use.¹³⁹ The descriptive Clairol slogan HAIR COLOR SO NATURAL ONLY HER HAIRDRESSER KNOWS FOR SURE was ruled distinctive due to its extensive use in advertising and use in commerce, on displays associated with the goods.¹⁴⁰ American Express was found to have marketed the slogan DON'T LEAVE HOME WITHOUT IT so successfully that a strong trademark protection had arisen.¹⁴¹ American Express spent considerable time and money (around six million dollars over three years) promoting its charge card, and the card is now readily recognizable to a large part of the general public. Thereto, American Express has eighteen million card members in the United States alone. Other American trademarks that have reached secondary meaning are PUT A TIGER IN YOUR TANK (Esso fuel), PROGRESS IS OUR MOST IMPORTANT PRODUCT (General Electric) THE CHAMPAGNE OF BOTTLED BEER (Miller beer) and WE TRY HARDER.¹⁴² On the contrary, the slogan THE VALUE OF WORKING TOGETHER in class 42 was ruled *not* to have enough proof of consumer recognition in Sweden, since the evidence was not representative for the consumer group as a whole.¹⁴³

¹³⁷ USA: 15 USC §1052, see also the case *Smith v. M&B Sales & Mfg.*, 13 U.S.P.Q.2d 2002, 2010 (N.D.Cal. 1990); Sweden: Varumärkeslagen, article 13; EC: Council Regulation no. 40/94, article 7.3.

¹³⁸ WIPO Article 2.337.

¹³⁹ *Bristol-Myers Co. v. Approved Pharmaceutical Corp.*, 149 USPQ 896, N.Y. Sup. 1966.

¹⁴⁰ *Roux Laboratories, Inc. v. Clairol, Inc.*, 57 CCPA 1173, 427 F.2d 823, 166 USPQ 34 (1970).

¹⁴¹ *American Express Company v. Vibra Approved Laboratories Corp. d/b/a Hollywood creations Co.*, US District Court for the southern district of New York, 1989 U.S.; 10 U.S.P.Q.2D; BNA, 2006.

¹⁴² *In re Marriot Corp.*, 517 F.2d 1364, 1367 (C.C.P.A. 1975).

¹⁴³ PBR 97-494, NIR 1998 p. 125-126.

5.2.2 Suggestive character

Suggestive marks are successful trademarks; such marks achieve what many producers want, namely, implying quality and the like without being descriptive. Through use of words like ARISTOCRATE and INTELLIGENCE a producer can give associations to high quality. By using words like PLUS for thermometers and ANATOM for a mattress, the mark can also associate to the kind of product.

The Swedish Patent Court of Appeal, PBR, often register suggestive slogans.¹⁴⁴ PBR annulled the decision from PRV and approved the registration of TOOLS THAT BUILD BUSINESS¹⁴⁵ for goods and services in class 9, 16, 41 and 42 (scientific instrument, paper, education etc). PBR stated that the constellation of words and its content, made the mark easy to remember. It is meant to impress a message into the consumers that the goods and services can be used for development and operation of a business. It does though, not directly, describe the goods and services. It is therefore suggestive. Exclusivity to the phrase would not disturb competitors on the same market. A PART OF YOUR PERSONALITY for credit cards and financial services (class 9, 16 and 36)¹⁴⁶ was equally denied by the PRV and then later approved by the PBR. PRV found the statement having general character and therefore not being a mean of individualization. PBR disagreed, and stated that the purpose of the phrase is to create a feeling with the consumers that the goods sold, complies with his or her lifestyle. The brand is therefore mainly suggestive. Another example is the slogan MAKES ANY TIME SPECIAL (for printed publications in class 16)¹⁴⁷ which PRV ruled as lacking distinctive character, since it contained a merely general statement. PBR found the meaning of the sentence to be the ability to brighten up one's daily life. With that meaning the mark is merely suggestive, not primarily descriptive. Due to this and to the proven use, the mark seen in its entirety was distinctive enough for registration. In the US, the slogan FROM MAINE'S COOL BREEZE TO THE FLORIDA KEYS¹⁴⁸ for moving services, as well as the phrase YOUR FINANCIAL SECURITY IS OUR BUSINESS for insurance planning services¹⁴⁹, were found suggestive and therefore eligible for registration.

An example from OHIM is the sentence FRÜHER AN SPÄTER DENKEN! for assets consultancy consultation and financial services.¹⁵⁰ The Board of Appeal stated that when determining distinctive character of the mark in its whole, it could not be ruled descriptive for the specific services. The mark was rather perceived as a veiled reference to the specific services.

¹⁴⁴ Information from PRV's intranet, provided by Bengt Staffas.

¹⁴⁵ 94-12925, Brand news 5/99.

¹⁴⁶ 97-03854, Brand news 04/2002.

¹⁴⁷ 97-06088, Brand news 02/2002.

¹⁴⁸ In re Lincoln Park Van Lines, 149 USPQ 313 (TTAB 1966).

¹⁴⁹ In re Sottile, 156 USPQ 655 (TTAB 1968).

¹⁵⁰ The Board of Appeal (II), R 153/1998-2, May 4 1999.

5.2.3 Constructions that are easy to remember

Historically in Sweden, originality, humor, wit or surprising elements were absolutely necessary for a slogan to hold distinctive character. It has been stated that these facts no longer affect a trademark's distinctive character. A glance at case law, though shows, that this is a truth with moderation. It has been claimed in Swedish legal literature, that the registration authorities do require strikingness and wit to register a slogan.¹⁵¹ Registries are more willing to register memorable slogans, and the above mentioned elements may increase such an impression. Elements of wit and humor, as well as ambiguity and music, are all effective when it comes to standing out from an intense flow of information.

An example of a creative slogan is UNDERNEATH IT ALL for underwear.¹⁵² The words "underneath it all" are descriptive in nature in that they state that undergarments are worn underneath outer garments. Munsingwear's use of the phrase, nevertheless, was found to reflect creative and imaginative elements and was therefore protectable. Another slogan with a dual message is WE TAKE IT PERSONALLY for transport and distribution services.¹⁵³ The phrase was at first denied registration by PRV and remitted to PBR for retrial. PBR found the phrase having the abstract meaning "we take it personally" but it also associated to the delivering of goods. Due to use, the phrase had managed to receive the necessary level of distinctive character. The witty Swedish sentence TRYCKTA TRÖJOR BEHÖVER INTE KOSTA SKJORTAN in class 35¹⁵⁴ was also considered to possess the necessary distinctive character for registration. The brand insinuates the specific products, without being descriptive, in a way that is distinctive. Another example of a remember able slogan is Mars' A MARS A DAY HELPS YOU WORK, REST AND PLAY¹⁵⁵. The Coca Cola Company has tried a number of different musical slogans and has been very successful with the simple ENJOY COCA COLA.¹⁵⁶ Another producer that frequently uses simple messages in melodies is McDonalds. One of their slogans I'M LOVIN' IT has been registered in the US¹⁵⁷, but not in OHIM nor in Sweden. Many Swedes are familiar with the tune to McDonald's slogans KOM TILL MCDONALDS, VI GER MER! and LIVET HAR SINA GODA STUNDER, but these have also not been registered.

5.2.4 The existence of a protected word mark in a slogan

A slogan that includes a protected word mark can also be subject of a registration. More surprising is that the existence of a protected word mark in a slogan may affect a slogan's registration ability. According to PRV's current instructions applicable on the appraisal

¹⁵¹ Levin/Bonnier p. 31 f.

¹⁵² Maidenform, Inc. v. Munsingwear, Inc. No. 77 Civ. 3108 United States District Court for the Southern District New York, U.S. 195 U.S.P.Q. (BNA) 29 July 29, 1977.

¹⁵³ Brand news 1/99, 95-13647.

¹⁵⁴ PBR 95/424 NIR 1998 p. 124.

¹⁵⁵ Swedish registration number 0256693.

¹⁵⁶ Brand News 04/2002 p. 29.

¹⁵⁷ registration number 78257203, 78257215, 78257216 and 78257217.

of a slogan's distinctive character, the distinctive character is considered to increase if a (probably distinctive) word mark is included in the slogan.¹⁵⁸ The viewpoint is perhaps not that revolutionary. A reference to a word mark in a slogan makes consumers associate the message of a slogan with a certain brand name, i.e. the source of origin. "Connecting people" for phone services is highly descriptive, but together with the brand name "Nokia" it has received an American registration (registration number 2183176) as well as a European registration (registration number 323337). Old Swedish registrations that include word marks are TAG DET RÄTTA TAG CLOETTA; LYCKO, ETT LYCKAT NAMN PÅ EN LYCKAD VARA and I FÖRSTA HAND MODERSMJÖLK- I ANDRA HAND GITRIDO MJÖLK.¹⁵⁹ American examples are EAT FOOTBALL, SLEEP FOOTBALL, DRINK COCA-COLA¹⁶⁰ and HUNGRY? GRAB A SNICKERS¹⁶¹.

5.3 Conclusion

As previously stated in this chapter it is difficult to find generally applicable principles for determining distinctiveness. It is important to keep in mind, when studying case law and registrations practice in this matter, that there is a great discrepancy in the decisions. Courts and registration authorities in OHIM, Sweden and the US have fluctuated between openness and firmness in their views.

Slogans and other trademarks shall be ruled alike. Anything else would cause an unacceptable insecurity for the applicants. Slogans do, nevertheless, struggle more to receive protection and many times fail to hold distinctive character. The reason for this is their natural ability of being descriptive. This chapter has attempted to establish common elements that affect the likelihood of receiving a protection.

The purpose behind the distinctive character requirement is to individualize the products of a certain producer. Elements that cause the mark to disappear in the constant information-flow counteract this purpose. Consumers easily ignore long, descriptive slogans with an informational content. The struggle by producers to achieve marks that stand out, results in various methods: Humor, rhymes and music; it is all about being remembered!

¹⁵⁸ Holmqvist p. 435.

¹⁵⁹ All cases are previously stated in the text.

¹⁶⁰ registration number 2141499.

¹⁶¹ registration number 2511130.

6 THE USE OF DISCLAIMERS

Word marks in general and slogan in particular¹⁶² are often subjects of something called “disclaimer”, which is the act of relinquish ones right to something. A word mark and/or slogan that consist of several words generally include common terms that cannot be registered by themselves. Slogans in particular, also often include descriptive or laudatory elements. A disclaimer is merely a clarification from the registration authorities that the producers do not obtain an exclusive right to these words separately. The word mark POCKO LOCO TORTILLA CHIPS CHILI¹⁶³ includes several elements that cannot be registered: tortilla, chips and chili. The word mark received a registration with a disclaimer for all these words. Other producers are therefore still free to use the terms tortilla, chips and chili when marketing their products. The use of disclaimers by the registration authorities varies from different countries. Swedish registries use the system rather extensively, while OHIM and the USPTO are more restrictive.

6.1 The EC

The disclaimer provision in the EC Council Regulation No. 40/94 is stated in article 38.2: *Where the trademark contains an element which is not distinctive, and where the inclusion of said element in the trademark could give rise to doubts as to the scope of protection of the trademark, the office may request, as a condition for registration of said trademark, that the applicant states that he disclaims an exclusive right to such element. Any disclaimer should be published together with the application or the registration of the community trademark, as the case may be.*

Accordingly, whenever there is a doubt regarding the scope of a trademarks’ protection, OHIM may request a disclaimer of any exclusive right to one or more elements of the trademark. The actual use of this power seems, however, far more restrictive.¹⁶⁴ The Examination Guidelines for the Harmonisation Office¹⁶⁵ establishes the principles for the use of disclaimers. In the guidelines it is stated that disclaimers are only to be used when an “element could give rise to real doubts as to the scope of protection of the mark”. Naturally ordinary words, which would be common to many marks (the, of, etc.), do not need to be disclaimed according to the guidelines. Perhaps more interestingly, neither is elements designating the kind, quality, value or geographical origin of goods or services, i.e. descriptive elements. It is also stated that trademarks which consists of a combination of elements, each of which in themselves is clearly not distinctive, does not need a disclaimer for the separate elements.

¹⁶² Levin/Bonnier p. 129.

¹⁶³ Swedish registration no. 315 597.

¹⁶⁴ Davies p. 38.

¹⁶⁵ Decision No. Ex-96-2 26/3 1996 published in the Official Journal no. 9 1996 p. 1332.

6.2 Sweden

The government bill of the Trademark act from 1960 as well as the actual Trademark act, Article 15, express that disclaimers are to be used when there are uncertainties regarding the scope of a registration:

An exclusive right in a trademark acquired through registration does not include such elements of the mark which cannot by themselves be registered.

Where a mark contains such an element and there are special reasons to assume that the registration of the mark may cause uncertainty about the scope of the exclusive right, this element may be explicitly excluded from the registration.

Oppose to OHIM, the Swedish registries does not hesitate to disclaim descriptive elements. It is, however, possible to escape disclaimers through brand establishment. Article 15.3 states:

Where it is later shown that an element of a mark which has been excluded from the protection, has become eligible for registration, a new registration may be effected of this element of the mark or of the entire mark without such an exception.

The slogan GORE-TEX GUARANTEED TO KEEP YOU DRY¹⁶⁶ is one example of how these principles are used in practice. The sentence was intended to cover clothing and textiles in class 9, 24 and 25. PRV and PBR stated that the words merely expresses that the products, sold under the brand, possesses a relevant quality. Therefore a producers' sole right to the mark is only possible, if the brand has received distinctive character through use. Since such use was not proven, the applicant had to accept a disclaimer for registration to be possible.

The use of disclaimers was rather restricted when the provision was first introduced, but this practice has changed.¹⁶⁷ Disclaimers are requested more frequently, even in the "obvious" cases. Between 1995 and 1996, 30 per cent of all approved registrations contained disclaimers. One highly plausible explanation is the more extensive use of generic words and descriptive texts in trademark applications.¹⁶⁸ More alarming is that PRV's disclaimer practice does not seem to be uniform.¹⁶⁹ Descriptive marks sometimes receive disclaimers for every word that is descriptive and sometimes only for the terms where the descriptiveness is unclear. As stated above, the word mark POCKO LOCO TORTILLA CHIPS CHILI received a disclaimer for every word apart from the producer's name, POCKO LOCO. The registration THE BOSE SOUND DIFFERENCE¹⁷⁰ on the other hand, was registered without any disclaimer. A case where PRV and PBR agree on the ruling is the registration of ALFANATIVE-THE PURE CHOICE. PRV found the phrase to lack the necessary distinctive character, since the phrase constitutes a subjective opinion and imply the nature of the goods (pharmaceutical

¹⁶⁶ International registration 668.634, Brand news 04/2002.

¹⁶⁷ Levin/Bonnier p. 109 f.

¹⁶⁸ op.cit.

¹⁶⁹ op.cit.

¹⁷⁰ registration number 315 638.

preparations, class 5). PBR followed the ruling of PRV and stated that a disclaimer is necessary to be able to register the phrase. The applicant approved to this.¹⁷¹

6.3 The United States

The Lanham Act § 6¹⁷² specifically provide for a disclaimer of a mark component that cannot be registered:

(a) *The Director may require the applicant to disclaim an unregistrable component of a mark otherwise registrable. An applicant may voluntarily disclaim a component of a mark sought to be registered.*

The result of a disclaimer is a limitation of the claim to exclusive rights in the disclaimed matter to its precise relation and association with the entire mark appearing in the registration. However:

(b) *No disclaimer ... shall prejudice or affect the applicant's or registrant's rights then existing or thereafter arising in the disclaimed matter, or his right of registration on another application if the disclaimed matter be or shall have become distinctive of his goods or services.*¹⁷³

When the rule regarding disclaimers firstly was incorporated in 1946, it expressed that the Director “shall” require matter that are not possible to register to be disclaimed. Due to this wording, it became customary to require a disclaimer for “every occurrence, in any type of combination, of every term or symbol which by itself might be refused registration in the first instance under the 1946 Act.”¹⁷⁴ In 1962, the wording was changed and the Director now “may” require a disclaimer. The hopes were that examining attorneys would use disclaimers in a more sensible way, i.e. when it was necessary. In the USPTO’s guidelines regarding disclaimers, The Trademark Manual of Examining procedure¹⁷⁵ it is affirmed that when it is obvious that no claim is being made in any element apart from the entirety, a disclaimer is unnecessary.¹⁷⁶ It is emphasized that a slogan is considered unitary and it should not be broken up for purposes of requiring a disclaimer.¹⁷⁷

In the United States, disclaimed material typically consists of descriptive terms or ornamental designs.¹⁷⁸ Since 1982, the standardized sentence “No claim is made to the

¹⁷¹ Brand news 10/2000, 98-2123.

¹⁷² 15 U.S.C. §1056.

¹⁷³ Kane p.6-29.

¹⁷⁴ TMEP 1213.01(a) Discretion in Requiring Disclaimer.

¹⁷⁵ <http://www.uspto.gov/web/offices/tac/tmep/contents.htm>.

¹⁷⁶ TMEP 1213.01(a) Discretion in Requiring Disclaimer.

¹⁷⁷ TMEP 1213.05(b) Slogans.

¹⁷⁸ Kane p.6-29.

exclusive right to use..., apart from the mark as shown” has been used to express a disclaimer.¹⁷⁹

6.4 Conclusion

OHIM, Sweden and the United States, all seem to have corresponding disclaimer law; an examiner may exclude an uncertain element from registration. When investigating case law, it is nonetheless evident that Sweden is far more willing to use disclaimers than OHIM and the US. PBR claims to avoid the use of disclaimers where it is obvious that a registration does not cover the singular elements.¹⁸⁰ Nevertheless, disclaimers are used too frequently, especially by PRV.¹⁸¹ The reasons for this may be found in Swedish history. Sweden has long been hesitant to register slogans, and a legal change was not made until a European harmonization was inevitable. Even though the legal text now does correspond with the 40/94 Directive, the Swedish Patent Office seems to have a wider perception of what is “uncertain”. OHIM and the USPTO’s guidelines imply that disclaimers should be used with moderation, especially when it comes to slogans. In OHIM, slogans and combinations of words seem to escape disclaimers completely, since it is implicit that these types of marks receive protection in their entirety, and not for individual elements.

The Swedish disclaimer system has, with every reason, been widely criticized in Swedish doctrine. The system is not durable. PBR is currently investigating if disclaimers can be dispensed without completely ruling out the 15th paragraph in VmL. Not only are disclaimers used contrary to OHIM’s guidelines, but thereto, the registration practice is inconsistent. Such unpredictability may cause unnecessary problems and misunderstandings for applicants as well as third parties regarding the extent of protection. One reason for the inconsistency is a delay in implementation of the European regulations. Sweden claims to share the common view in OHIM that marks shall be seen and evaluated in their entirety. This is perhaps true in theory, but not in practice. It seems like PRV still divides slogans into separate elements when investigating the extent of whether they can be protected. This generally leads to rejections of slogans due to lack of distinctive character.

A short-term solution that will benefit the applicants is for the applicants to accept a disclaimer right away. This would increase the chances of receiving a registration and save the applicant time and money. A disclaimer will protect the mark in its entirety, which is the only protection a slogan can receive in any case, with or without a disclaimer. One way to resolve this problem in the future is to introduce a new disclaimer rule that is more compatible with the European practice. Still, it is even simpler just to abolish the disclaimer system in its totality. A notification to the owner in the registration

¹⁷⁹ Kane p.6-29.

¹⁸⁰ Carlson, December 16th 2003.

¹⁸¹ According to Carlson, however, the use lately has decreased; Carlson, December 16th 2003.

document, explaining that no element of the mark receives individual protection should be satisfactory.¹⁸²

¹⁸² Holmér, AstraZeneca, December 16th, 2003.

7 OVERALL CONCLUSIONS

The development and expansion of trademark subjects

The concept of trademark is constantly changing. The past decade has been characterized by a move towards increased openness and acceptance. OHIM and the USPTO, now acknowledge, that any aspect of a product indicates its source of origin. Likewise, the interpretation of distinctive character has become more generous. Together, this has caused the expansion of protectable signs. Sweden, bound by a legal cooperation within the European Community and a dependence on international trade, is highly affected by these changing currents.

The United States has long been the leader in intellectual property protection in certain aspects. The rest of the world is now catching up. Regarding the protection of slogans, the European Union has reached a similar legal level of protection and is now on par with the United States. Internationally, it is the common opinion that the criteria for trademark protection are set and are the same for all word marks. The work on consolidating the practice in the specific member countries is still progressing. However, compared to OHIM and the USPTO, the Swedish Patent Office has been and still is the most hesitant authority to register slogans and often finds them lacking distinctive character. This hesitation is also expressed through a frequent use of *disclaimers*. PBR maintain a careful policy, leaving the lower instance without guidance. PRV, therefore, has an option between judging blindly and falling back into old tracks with a restrictive practice. The result is a haphazard-like case law that lacks judicial reason. It is however, not a matter for PRV to change the case law. Since *Regeringsrätten* (the Swedish Supreme Administrative Court) seem to find PBR competent to take care of this matter, this is where the power lies. PBR has adapted to the legal changes, but pursues a wait-and-see policy in practice. PBR will not take any revolutionary changes merely based on rulings from the Court of First Instance. The European Court of Justice has yet to state its opinion on this issue. From experience, it is widely known that these two courts, do not seldom take different standpoints.

International differences in the methods of protecting trademarks

A European trademark protection, provided by OHIM, can *only* be accomplished through registration. In single countries, an applicant may choose between a registration and a protection based on extensive use. In Sweden, registration is the traditional way to protect trademarks. Protection through use constitutes a natural second option, when the registration has been denied. A registration gives the trademark owner a sense of security. The true scope of ownership is also clear to everyone, owners and competitors. The United States, on the other hand, has a long history of protection through use and this system is still prevailing today. Trademark owners trust the system and do not bother spending time and money to register their marks. The existence of an ownership is therefore not established until a potential question of infringement arises.

New slogan trends

The frequency and composition of slogans follow current marketing trends. Recently, there is a tendency to strive to protect slogans in the form of staccato commands like: JUST DO IT, THINK SMALL and HAVE IT YOUR WAY. Early slogans were wordier. The reason for this may be that this type of slogan gives a strong impression and is easier to remember. Another trend generally visible in marketing is the element of wit. This is also the case for slogans. Previous slogans aimed to convey a suggestive message about the product, implying quality and security. Companies today try to sell their products with humor.

Slogans often fail to fulfill the requirements for protection

Despite a legal equity, it is a fact that slogans do encounter more difficulties in receiving a protection than other word marks. This stricter evaluation should not be necessary, since the protection of slogans is limited to their exact wording. There are many plausible explanations for this difference.

Historically, the strongest motive behind the reluctance to protect slogans was a concern to maintain a competitive market: The common language must not be monopolized and all producers must compete on the same conditions. This motive is deeply rooted and remains today, especially in Sweden.

OHIM and the Swedish Patent Office are still adapting to the concept of slogan registration. The trademark system is built upon a foundation consisting of two concerns, the concern for consumers and the concern for free competition. To protect these interests, certain requirements have to be fulfilled before a protection is granted; a mark must be distinctive, and it must not limit competition in an unacceptable manner. The practical use of these requirements is not simple. Preceding case law is therefore full of general trademark principles. There is a tendency to forget or misinterpret these principles in actual slogan practice. The result is often the denial of the application. One example is the principle of examining a mark in its entirety. A slogan that is divided word by word can generally not receive a trademark protection, since it includes far too many general words.

The inherent character of slogans, such as considerable length and a natural ability of being descriptive, is another explanation why this type of marks fails registration. Since a slogan is not often an actual part of a product's packaging, but only appears in advertising, it may also be more difficult to prove that a slogan is identifying a source. Many word marks are also purely imaginative, which facilitates protection. This thesis has attempted to establish some elements that may affect the plausibility of protection. Such an element is the existence of a protected word mark in a slogan. This way a protection is almost guaranteed, but unfortunately very limited. It may therefore be better to use other existing methods. Also, one method that seems to be popular and effective is wit, humor and double meanings.

The current situation in Sweden causes a great insecurity for applicants that have a hard time evaluating which slogans are worth trying to protect. There is very little guidance to receive from previous registration decisions, which are brief and seldom explained. It is therefore advisable to conduct a thorough investigation before sending in an application to the Patent Office, avoiding the unnecessary expenses that follow a denial. Naturally, this is not an option for applicants with small resources. All applicants, though, will benefit by accepting a disclaimer. Since a disclaimer does not have any affect on the scope of the trademark protection, the system in itself is questionable. As long as the registries have a tendency to accept these registrations to a greater extent, applicants might as well use the system.

Supplement A

NICE CLASSIFICATION OF GOODS AND SERVICES

GOODS

- Class 1** Chemicals used in industry, science and photography, as well as in agriculture, horticulture and forestry; unprocessed artificial resins, unprocessed plastics; manures; fire extinguishing compositions; tempering and soldering preparations; chemical substances for preserving foodstuffs; tanning substances; adhesives used in industry.
- Class 2** Paints, varnishes, lacquers; preservatives against rust and against deterioration of wood; colorants; mordants; raw natural resins; metals in foil and powder form for painters, decorators, printers and artists.
- Class 3** Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.
- Class 4** Industrial oils and greases; lubricants; dust absorbing, wetting and binding compositions; fuels (including motor spirit) and illuminants; candles and wicks for lighting.
- Class 5** Pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides.
- Class 6** Common metals and their alloys; metal building materials; transportable buildings of metal; materials of metal for railway tracks; non-electric cables and wires of common metal; ironmongery, small items of metal hardware; pipes and tubes of metal; safes; goods of common metal not included in other classes; ores.
- Class 7** Machines and machine tools; motors and engines (except for land vehicles); machine coupling and transmission components (except for land vehicles); agricultural implements other than hand-operated; incubators for eggs.
- Class 8** Hand tools and implements (hand-operated); cutlery; side arms; razors.
- Class 9** Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus.
- Class 10** Surgical, medical, dental and veterinary apparatus and instruments, artificial limbs, eyes and teeth; orthopedic articles; suture materials.
- Class 11** Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply and sanitary purposes.
- Class 12** Vehicles; apparatus for locomotion by land, air or water.
- Class 13** Firearms; ammunition and projectiles; explosives; fireworks.
- Class 14** Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments.

- Class 15** Musical instruments.
- Class 16** Paper, cardboard and goods made from these materials, not included in other classes; printed matter; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging (not included in other classes); printers' type; printing blocks.
- Class 17** Rubber, gutta-percha, gum, asbestos, mica and goods made from these materials and not included in other classes; plastics in extruded form for use in manufacture; packing, stopping and insulating materials; flexible pipes, not of metal.
- Class 18** Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips, harness and saddlery.
- Class 19** Building materials (non-metallic); non-metallic rigid pipes for building; asphalt, pitch and bitumen; non-metallic transportable buildings; monuments, not of metal.
- Class 20** Furniture, mirrors, picture frames; goods (not included in other classes) 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.
- Class 21** Household or kitchen utensils and containers (not of precious metal or coated therewith); combs and sponges; brushes (except paint brushes); brush-making materials; articles for cleaning purposes; steelwool; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware not included in other classes.
- Class 22** Ropes, string, nets, tents, awnings, tarpaulins, sails, sacks and bags (not included in other classes); padding and stuffing materials (except of rubber or plastics); raw fibrous textile materials.
- Class 23** Yarns and threads, for textile use.
- Class 24** Textiles and textile goods, not included in other classes; bed and table covers.
- Class 25** Clothing, footwear, headgear.
- Class 26** Lace and embroidery, ribbons and braid; buttons, hooks and eyes, pins and needles; artificial flowers.
- Class 27** Carpets, rugs, mats and matting, linoleum and other materials for covering existing floors; wall hangings (non-textile).
- Class 28** Games and playthings; gymnastic and sporting articles not included in other classes; decorations for Christmas trees.
- Class 29** Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products; edible oils and fats.
- Class 30** Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice.
- Class 31** Agricultural, horticultural and forestry products and grains not included in other classes; live animals; fresh fruits and vegetables; seeds, natural plants and flowers; foodstuffs for animals, malt.
- Class 32** Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.
- Class 33** Alcoholic beverages (except beers).
- Class 34** Tobacco; smokers' articles; matches.

SERVICES

- Class 35** Advertising; business management; business administration; office functions.
- Class 36** Insurance; financial affairs; monetary affairs; real estate affairs.
- Class 37** Building construction; repair; installation services.
- Class 38** Telecommunications.
- Class 39** Transport; packaging and storage of goods; travel arrangement.
- Class 40** Treatment of materials.
- Class 41** Education; providing of training; entertainment; sporting and cultural activities.
- Class 42** Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computer hardware and software; legal services.
- Class 43** Services for providing food and drink; temporary accommodation.
- Class 44** Medical services; veterinary services; hygienic and beauty care for human beings or animals; agriculture, horticulture and forestry services.
- Class 45** Personal and social services rendered by others to meet the needs of individuals; security services for the protection of property and individuals.

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In re Brock Residence Inns, Inc., 222 USPQ 920 (TTAB 1984)

FROM MAINE'S COOL BREEZE TO THE FLORIDA KEYS

In re Lincoln Park Van Lines, 149 USPQ 313 (TTAB 1966)

GOIN' THE EXTRA MILE

Jerry Reed and T.S.C. Productions, Inc. v. Amoco Oil Company No. 3-84-0576 U.S. District Court for the Middle District of Tennessee, Nashville Division 611 F. Supp. 9; 1984 U.S. Dist. LEXIS 23087; 225 U.S.P.Q. (BNA) 876 October 3, 1984

GUARANTEED STARTING

Application of Standard Oil Co., 47 CCPA 829, 275 F.2d 945, 125 USPQ 227, 1960

HAIR COLOR SO NATURAL ONLY HER HAIRDRESSER KNOWS FOR SURE

Roux Laboratories, Inc. v. Clairol Inc. No. 8248 U.S. Court of Customs and Patent Appeals 57 C.C.P.A. 1173; 427 F.2d 823; 1970 CCPA LEXIS 344; 166 U.S.P.Q. (BNA) 34 Oral argument January 7, 1970 June 18, 1970

HANDKERCHIEFS OF THE YEAR

Burmel Handkerchief Corp. v. Cluett, Peabody & Co., Inc. No. 4580 U.S. Court of customs and Patent Appeals 29 C.C.P.A. 1024; 127 F.2d 318; 1942 CCPA LEXIS 59; 53 U.S.P.Q. (BNA) 369

HUNGRY? GRAB A SNICKERS

registration number 2511130

I LOVE YOU

M.B.H. Enterprises, Inc., v. Woky, Inc. No. 80-1210 U.S. Court of Appeals, Seventh Circuit 33 F.2d 50; 1980 U.S. App. LEXIS 13120; 208 U.S.P.Q. (BNA) 391 June 12, 1980, Argued October 15, 1980, Decided

I'M LOVIN IT

registration number 78257203, 78257215, 78257216 and 78257217

NEXT TIME YOU'RE CAUGHT IN A DOORWAY WITH YOUR ARMS FULL,
THINK WIREHANDLER

Smith v. M&B Sales & Mfg., 13 U.S.P.Q.2d 2002, 2010 (N.D. Cal. 1990)

NOKIA-CONNECTING PEPOLE

registration number 2183176

NO THIS IS NOT A PHONOGRAPH

Estate Store Company v. Gray&Dudley, 41 F (2d) 462 (CCA 6, 1930), 6 PQ 20

PROUDLY MADE IN USA

In re Remington Products Inc. 3 USPQ2d 1714 (TTAB 1987)

QUALITY THROUGH CRAFTSMANSHIP

In re The Hallicrafters Co., 153 USPQ 376 (TTAB 1967)

SOIL IT-WASH IT-NEVER NEEDS PRESSING

In re Superba Cravats, Inc., 149 USPQ 852 (TTAB 1966)

THE BABY BOOTIE SOCK THAT WILL NOT KICK OFF

In re Sanda Hosiery Mills, 154 USPQ 631 (TTAB1967)

THE BEST BEER IN AMERICA

In re Boston Beer Co. L.P., 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999)

THE FATE OF A FABRIC HANGS BY A THREAD

American Enka Corp. v. John A. Marzall, Commissioner of patents. U.S. District court for the District of Columbia 1952 U.S. Dist. LEXIS 3557; 92 U.S.P.Q. (BNA) 111 February 2, 1952

THINK GREEN

In re Manco Inc., 24 USPQ2d 1938, 1942 (TTAB 1992)

UNDERNEATH IT ALL

Maidenform Inc. v. Munsingwear Inc. No. 77 Civ. 3108 U.S. District Court for the Southern District New York 1977 U.S. Dist. LEXIS 14726; 195 U.S.P.Q. (BNA) 29 July 29, 1977

USE ARRID TO BE SURE

Carter-Wallace Inc. v. The Procter & Gamble Company, No. 25280 U.S. Court of Appeals for the ninth Circuit 434 F.2d 794; 1970 U.S. App. LEXIS 6513; 167 U.S.P.Q. (BNA) 713

WATCH THAT CHILD

In re Tilcon Warren, Inc., 221 USPQ 86 (TTAB 1984)

WE SMILE MORE

Ramada Inns, Inc. v. Marriott Corp. et al., No. 1 CA-CIV 1543 Court of Appeals of Arizona, Division One, Department A 494 P.2d 64; 1972 Ariz. App. LEXIS 559; 16 Ariz. App. 459; 173 U.S.P.Q. (BNA) 443 March 2, 1972

WE TREAT YOU RIGHT

American Dairy Queen Corp. v. TRO Inc., 16 USPQ2d 1077 N.D. Ill. 1990
Dairy Queen

WHERE DO YOU WANT TO GO TODAY?

registration number 1989047

WHERE'S THE BEEF?

registration number 1410896

YOUR FINANCIAL SECURITY IS OUR BUSINESS

In re Sottile, 156 USPQ 655 (TTAB 1968)

YOU'VE GOT MAIL

U.S. 4th CIRCUIT COURT OF APPEALS America Online Inc v AT&T Corporation
No. 99-2138