

Case-law Research Report – The distinctive character of slogans

October 2021

TABLE OF CONTENTS

1. INTRODUCTION	3
2. LEGAL FRAMEWORK.....	3
2.1 EU law	3
2.2 Other instruments.....	4
3. CASE-LAW ANALYSIS	4
3.1 Slogans and their particular perception by the public	4
3.2 The factors of assessment	4
4. CONCLUSIONS	9
ANNEX.....	11

1. Introduction

- 1 The report on *The distinctive character of slogans* is a compilation of case-law from the General Court (GC), the Court of Justice (CJ) and the Boards of Appeal (the Boards or BoA), drawn up with the aim of identifying and analysing the relevant case-law and trends on the topic.
- 2 The purpose is to further support the work of the Boards with a view to maintaining and enhancing the **consistency** of its decision-making practice with the case-law of the European Courts and among the Boards themselves. As such it contributes to improving the **predictability** of decisions and legal certainty in general. Through divulging relevant legal information, it also serves to increase **knowledge, awareness and transparency** among the various BoA stakeholders.
- 3 It is a working document that reflects the existing case-law and the result of discussions within the Consistency Circles and the General Consistency Meeting of the BoA at the given date of the report and should **not be considered to have any binding effect on the BoA**. It has been made available to staff of the BoA and the public in general for information purposes only.
- 4 The descriptiveness, acquired distinctiveness or deceptiveness of slogans are outside the scope of this analysis.

2. Legal Framework

2.1 EU law

- 5 Article 7(1)(b) EUTMR – ‘Absolute grounds for refusal’:

*‘1. The following shall not be registered:
(b) trade marks which are devoid of any distinctive character’.*
- 6 Article 7(2) EUTMR:

‘Paragraph 1 shall apply notwithstanding that the grounds of non-registrability obtain in only part of the Union.’
- 7 Article 59(1)(a) EUTMR – ‘Absolute grounds for invalidity’:

*‘1. An EU trade mark shall be declared invalid on application to the Office or on the basis of a counterclaim in infringement proceedings:
(a) where the EU trade mark has been registered contrary to the provisions of Article 7,’*
- 8 Article 4 of the Trade Mark Directive – ‘Absolute grounds for refusal or invalidity’:

*‘1. The following shall not be registered or, if registered, shall be liable to be declared invalid:
(b) trade marks which are devoid of any distinctive character,’*

2.2 Other instruments

- 9 The Office's Guidelines deal with this absolute ground for refusal in Part B, Examination, Section 4, Absolute Grounds for Refusal, Chapter 3, Non-distinctive trade marks (Article 7(1)(b) EUTMR), Point 4, Slogans: Assessing Distinctive Character.

3. Case-law analysis

- 10 The term 'slogan' is not mentioned in the EUTMR or in the Trade Mark Directive¹. Nevertheless, case-law has developed several factors in the assessment of this type of sign.

3.1 Slogans and their particular perception by the public

- 11 In general, signs consisting of (advertising) slogans² convey a promotional message in connection with the designated goods and services.
- 12 The assessment of the distinctive character of slogans is not subject to stricter criteria than the assessment of other types of signs. Nevertheless, the CJ recognised that the relevant public's perception of slogans is not necessarily the same as in relation to other types of marks and that, in consequence, it may prove more difficult to establish distinctiveness for this category of marks. Indeed, the average consumer is not used to making assumptions about the commercial origin of products on the basis of promotional slogans³.
- 13 Furthermore, the level of attention of the consumer is generally low when it comes to promotional slogans, independently of the goods and services and of the specialisation of the public⁴. As a slogan only conveys abstract information about the goods and services, it is even less likely that the consumer will take the time to enquire into the various possible functions of the expression⁵, namely, whether beyond its purely promotional meaning, it might also designate a commercial origin.

3.2 The factors of assessment

- 14 A sign cannot be refused registration solely on the ground that it is a slogan. The CJ stated in **Vorsprung durch Technik** that '*the mere fact that a mark is perceived by the*

¹ Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks.

² 'A short easily remembered phrase, especially one used to advertise an idea or a product' – Cambridge Advanced Learner's Dictionary & Thesaurus (<https://dictionary.cambridge.org>). 'A short, easily remembered phrase used by an organization so that people will recognize it or its products' – Cambridge Business English Dictionary (<https://dictionary.cambridge.org>). 'A distinctive or topical phrase used in politics, advertising, etc' – Collins English Dictionary (<http://www.collinsdictionary.com>)

³ 21/10/2004, C-64/02 P, Das Prinzip der Bequemlichkeit, EU:C:2004:645, § 32-36; 21/01/2010, C-398/08 P, Vorsprung durch Technik, EU:C:2010:29, § 36-38

⁴ 24/04/2018, T-297/17, We know abrasives, EU:T:2018:217, § 45; 29/01/2015, T-59/14, Investing for a new world, EU:T:2015:56, § 27; 25/03/2014, T-291/12, Passion to perform, EU:T:2014:155, § 32

⁵ 29/01/2015, T-59/14, Investing for a new world, EU:T:2015:56, § 41

relevant public as a promotional formula, and that, because of its laudatory nature, it could, in principle, be used by other undertakings, is not sufficient, in itself, to support the conclusion that that mark is devoid of distinctive character⁶. Indeed, a slogan may function both as a promotional formula and as an indication of the commercial origin of the goods and services.

- 15 The following **non-exhaustive factors** laid down in case-law⁷ may serve to establish distinctiveness for a slogan:
 - a) it has number of meanings;
 - b) it constitutes a play on words;
 - c) it introduces elements of conceptual intrigue or surprise, so that it may be perceived as imaginative, surprising or unexpected;
 - d) it has some particular originality or resonance, and/or triggers in the minds of the relevant public a cognitive process or requires an interpretative effort;
 - e) it has unusual syntactic structures and/or linguistic and stylistic devices such as alliterations, metaphors, rhymes.
- 16 It is important to underline that none of the above factors apply in absolute terms, independently from one another. For instance, the fact that a slogan has a number of meanings does not necessarily mean that it is distinctive. On the other hand, even if a slogan is not capable of setting off a cognitive process in the mind of the relevant consumer, it is not necessarily devoid of distinctive character.
- 17 In **Vorsprung durch Technik** (meaning, among others, ‘Advance or advantage through technology’, a range of goods and services applied for in Classes 9, 12, 14, 25, 28, 37, 38, 39, 40 and 42), the CJ considered⁸, contrary to both the Boards and the GC, that the presence of several of the above factors endowed the sign with a sufficient degree of inherent distinctiveness for it to be registered as a trade mark. The Court clarified that a mark can be perceived by the relevant public both as a promotional formula **and** as an indication of the commercial origin of goods or services. The fact that the mark is perceived as an indication of that origin and at the same time understood – or perhaps even primarily understood – as a promotional formula has no bearing on its distinctive character (§ 45).
- 18 However, that judgment cannot be interpreted as suggesting that any promotional phrase can now be registered as a trade mark simply because it is presented in the form of an advertising slogan⁹.

⁶ 21/01/2010, C-398/08 P, Vorsprung durch Technik, EU:C:2010:29, § 44

⁷ 21/01/2010, C-398/08 P, Vorsprung durch Technik, EU:C:2010:29, § 47, 57; 13/05/2020, T-49/19, Create delightful human environments, EU:T:2020:197, § 27; 08/07/2020, T-696/19, Moins de migraine pour vivre mieux, EU:T:2020:329, § 28

⁸ 21/01/2010, C-398/08 P, Vorsprung durch Technik, EU:C:2010:29, § 47, 58, 59

⁹ 13/05/2020, T-49/19, Create delightful human environments, EU:T:2020:197, § 31-36

- 19 In **Best Buy II**¹⁰, the CJ clarified that the GC's finding that the consumer will perceive the signs at issue **exclusively** as an indication of the advantageous relationship between quality and price and so not at all as an indication of commercial origin, was not incompatible with the principle established in **Vorsprung durch Technik**. Likewise, in **Wir machen das besondere einfach**¹¹ (meaning, 'We make the special simple', the goods applied for in Class 9), the CJ confirmed that the GC's finding that the sign is devoid of distinctive character as it will be perceived as a **mere** advertising slogan did not constitute a misreading of the principle laid down in **Vorsprung durch Technik** that, in so far as the public will perceive the mark as an indication of the commercial origin of goods or services, the fact that the mark is at the same time understood – or perhaps even primarily understood – as a promotional formula has no bearing on its distinctive character. The Grand Board applied the same principles, in reference to **Vorsprung durch Technik** and **Wir machen das besondere einfach**, and found that the mark applied for **La qualité est la meilleure des recettes** (meaning, 'Quality is the best recipe', goods applied for in Classes 29, 30 and 32) will be perceived as **nothing more** than a promotional promise or a marketing incitement to acquire the applicant's goods and thus, devoid of distinctiveness¹².
- 20 In summary, it is not sufficient for a sign to be refused as non-distinctive that it will be perceived as a promotional slogan or, even, primarily as a promotional slogan. What has to be established for a refusal is that it will be perceived **merely** as a promotional slogan and, therefore, incapable of performing the function of distinguishing goods and services, because this 'second' trade mark meaning will not be perceived by the public at all.
- 21 The following recent cases are examples of a consistent application of the abovementioned factors (GC endorsing the Boards) in finding the slogans at issue **non-distinctive**.

Moins de migraine pour vivre mieux¹³

(meaning 'Less migraine for a better life')

Class 16 - Printed materials relating to the treatment of migraines;

Class 44 - Providing information relating to the treatment of migraines.

- not unusual in terms of the rules of French syntax, grammar, phonetics or semantics;
- the expression conveys a simple, clear and unequivocal message to the relevant public;
- does not confer any particular originality or resonance and does not require an effort of interpretation or set off any cognitive process (§ 28).

Create delightful human environments¹⁴

Class 9 - [...] computer programs, downloadable computer programs and mobile device software, all for use in adjusting and controlling the tinting of insulated glass window units;

¹⁰ 13/01/2011, C-92/10 P, Best Buy II (fig.), EU:C:2011:15, § 51-53

¹¹ 13/04/2011, T-523/09, Wir machen das Besondere einfach, EU:T:2011:175, § 31, 40; 12/07/2012, C-311/11 P, Wir machen das Besondere einfach, EU:C:2012:460, § 32-35

¹² 08/07/2011, R 1798/2010-G, La qualité est la meilleure des recettes, § 21-31

¹³ 08/07/2020, T-696/19, Moins de migraine pour vivre mieux, EU:T:2020:329

¹⁴ 13/05/2020, T-49/19, Create delightful human environments, EU:T:2020:197

Class 19 - Insulated glass window units with electrochromic coating for windows used in building construction;

Class 37 - Installation, maintenance and repair services for glass units for windows [...].

- it has a clear meaning and respects the rules of English syntax and grammar, but also the semantic content of the slogan, indicating the intended purpose of the designated goods and services, aims to promote them and not to indicate their origin (§ 27);
- although it follows from the 'Vorsprung durch Technik' judgment that the originality and easy memorable nature of a slogan may constitute relevant factors in determining whether a sign is capable of designating the commercial origin of the goods and services in question, other factors may also be taken into account such as the required effort or the setting off of a cognitive process (§ 34);
- the lack of fancifulness, without being decisive as a necessary condition, must be taken into account as a factor when assessing the distinctive character of a slogan (§ 41).

We're on it¹⁵

A wide range of goods and services in various classes, such as machinery, stationery, services of installation of air conditionings, advertising and business management.

- the sign is a simple, clear and unambiguous idiomatic expression [...]. It does not require an effort of interpretation or does not trigger any cognitive process in the mind of the relevant public (§ 37);
- the expression 'we're on it' [...] will be immediately perceived by the relevant public as an ordinary advertising message promoting a quality of the goods and services. It expresses the idea that the customer will be satisfied and will have nothing to worry about as the supplier or service provider will take care of everything that is necessary, whether it is the sale of goods or the provision of services (§ 38);
- it is a banal message, a promise formulated in such a general way that it is likely to be used by any supplier or service provider to encourage the purchase of products or services (§ 39);
- the level of attention of the professional public may be relatively low in respect of indications of a promotional nature which are not decisive for an informed public (§ 40);
- the fact that the mark applied for may have several meanings is one of the characteristics capable of conferring on the sign a distinctive character, but it is not a decisive factor in finding a distinctive character (§ 42).

GoClean¹⁶

Class 11 - Toilet cisterns; toilet bowls [WC]; water distribution systems.

- the fact that the contested mark does not bring, semantically, any information relating to the nature of the goods concerned does not confer a distinctive character on the mark. In fact, the contested trade mark indicates to the consumer a characteristic of the product relating to its commercial value which, without being precise, derives from information of a promotional or advertising nature which the relevant public will perceive primarily as such, rather than as an indication of the commercial origin of the goods (§ 41);

¹⁵ 13/05/2020, T-156/19, We're on it, EU:T:2020:200

¹⁶ 30/06/2021, T-290/20, Goclean (fig.), EU:T:2021:405

- the relevant public will not need to make any interpretative effort to understand the phrase 'go clean' as an expression inciting to purchase and emphasising the attractiveness of the products in question, addressing consumers directly and inviting them to purchase (§ 42).

22 The following cases are examples of a consistent application of the abovementioned factors (GC endorsing the Boards) in finding the slogans at issue **sufficiently distinctive**.

Wet dust can't fly¹⁷

Class 3 - Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations (...);

Class 7 - [...] vacuum cleaners, power-operated floor scrubbers, power-operated carpet and upholstery cleaning machines, power-operated water extractors;

Class 37 - [...] repair and maintenance of vacuum cleaners, power-operated floor scrubbers, power-operated carpet and upholstery cleaning machines and power-operated water extractors [...].

- the concept of 'wet dust' is **literally inaccurate**, since dust is no longer dust when it is wet. The juxtaposition of those two words gives that concept a fanciful and distinctive character (§ 49);
- the expression 'wet dust can't fly' **calls for an interpretative effort** on the part of consumers, who will be unable to associate it immediately with the goods and services in question. In fact, the intended purpose of the goods and services in question is not to 'wet the dust in order to prevent it from flying'. Furthermore, that slogan exhibits a **degree of originality and a certain resonance** which makes it easy to remember (§ 50);
- the laudatory connotation of a word mark does not mean that it cannot, none the less, be appropriate for the purpose of guaranteeing to consumers the origin of the goods or services which it covers (§ 53).

Love to Lounge¹⁸

Class 25 - Clothing, footwear, headgear [...].

- the contested mark conveys an abstract message referring to the interest of potential consumers in relaxing. It **requires some cognitive effort** on the part of the relevant public. It is a syntactically-correct combination of English words, which can be used in a great number of contexts. Consequently, when the contested mark is used in relation to the goods in question, the relevant public will have to place that mark in a certain context, which requires an intellectual effort (§ 93);
- even though that mark is not highly imaginative, it has a **certain originality** which is likely to be remembered by consumers. It is also not without a '**certain elegance**', due to the combination of the words (§ 94);
- the meaning and the originality of the contested mark will be perceived as an incitement to purchase, but do not constitute a mere piece of information (§ 95).

¹⁷ 22/01/2015, T-133/13, Wet dust can't fly, EU:T:2015:46, § 23-29

¹⁸ 15/09/2017, T-305/16, Love to lounge, EU:T:2017:607, § 93-95

- 23 On one occasion in the past several years, the GC **disagreed** with the Boards that the slogan applied for was devoid of any distinctive character. In **It's like milk but made for humans**¹⁹ (for a range of goods in Classes 29, 30 and 32), the GC found that the mark as a whole was not immediately understandable, but set off an interpretative effort. The GC pointed out that '*the consumer will perceive an opposition between the first part of the mark ('it's like milk') and the second part of the mark ('made for humans')*. As a result, the mark applied for conveys not only the idea that the goods at issue, which are foodstuffs, are akin to milk and are intended for human consumption, but also the idea that milk itself is not; '*the mark applied for calls into question the commonly accepted idea that milk is a key element of the human diet*'; and thus, '*conveys a message which is capable of setting off a cognitive process in the minds of the relevant public making it easy to remember and which is consequently capable of distinguishing the applicant's goods from goods which have another commercial origin*' (§ 44-46).
- 24 This judgment underlines the importance of carefully considering whether the slogan in question has a conceptual intrigue or tension or capacity to set off a cognitive process.

4. Conclusions

- 25 The analysis has shown that the Boards' decision-making practice is highly consistent with the case-law of the European Courts and also amongst the Boards in the assessment of the distinctive character of slogans²⁰.
- 26 The following conclusions can be drawn in order to maintain that high level of consistency:
- (i) As a general rule, a slogan is objectionable under Article 7(1)(b) EUTMR when the relevant public perceives it as a mere promotional formula. On the other hand, a slogan is distinctive when the relevant public, notwithstanding the promotional nature of the slogan, perceives it (simultaneously) as an indication of the commercial origin of the goods or services in question.
 - (ii) It follows that it is not sufficient for a sign to be refused as non-distinctive that it will be perceived as a promotional slogan or, even, primarily as a promotional slogan. What has to be established for a refusal is that it will be perceived **merely** as a promotional slogan and, therefore, incapable of performing the function of distinguishing the commercial origin of the goods and services.
 - (iii) It is sufficient for a slogan to be registered as a trade mark that it is capable of setting off a cognitive process in the minds of the relevant public which makes it easy

¹⁹ 20/01/2021, T-253/20, It's like milk but made for humans, EU:T:2021:21, § 46

²⁰ In relation to the conceptual terminology, it must be noted that 'originality' and 'banality' are sometimes used to argue that the slogan at issue is 'distinctive' or 'non-distinctive', respectively. The GC has nevertheless clarified that 'in the context of trade mark law, the originality of a sign cannot refer to, as in the context of the protection of a work by copyright to the author's proper intellectual creation as such. A trade mark right constitutes a right of use and not creation, in such a way that the original or creative aspect of a sign must be assessed, not for itself, but rather for its effect on the perception of the distinctive character of that sign in the minds of the relevant public' (13/05/2020, T-49/19, Create delightful human environments, EU:T:2020:197, § 35).

to remember and thus to distinguish the applicant's goods and services from those that have a different commercial origin.

Annex
List of reviewed cases

Court of Justice and General Court

11/05/2016, C-636/15 P, 2good, EU:C:2016:342
12/07/2012, C-311/11 P, Wir machen das Besondere einfach, EU:C:2012:460
13/01/2011, C-92/10 P, Best Buy II (fig.), EU:C:2011:15
21/01/2010, C-398/08 P, Vorsprung durch Technik, EU:C:2010:29
21/10/2004, C-64/02 P, Das Prinzip der Bequemlichkeit, EU:C:2004:645

30/06/2021, T-290/20, Goclean (fig.), EU:T:2021:405
20/01/2021, T-253/20, It's like milk but made for humans, EU:T:2021:21
08/07/2020, T-696/19, Moins de migraine pour vivre mieux, EU:T:2020:329
08/07/2020, T-697/19, Weniger Migräne. Mehr vom Leben., EU:T:2020:330
13/05/2020, T-156/19, We're on it, EU:T:2020:200
13/05/2020, T-49/19, Create delightful human environments, EU:T:2020:197
05/06/2019, T-272/18, MobiPACS, EU:T:2019:373
24/04/2018, T-297/17, We know abrasives, EU:T:2018:217
22/03/2018, T-235/17, Mobile living made easy, EU:T:2018:162
28/02/2018, T-843/16, Foto Paradies, EU:T:2018:102
23/01/2018, T-250/17, avanti (fig.), EU:T:2018:24
15/09/2017, T-305/16, Love to lounge, EU:T:2017:607
02/06/2016, T- 654/14, Revolution, EU:T:2016:334
22/01/2015, T-133/13, Wet dust can't fly, EU:T:2015:46
25/09/2015, T-366/14, 2good, EU:T:2015:697
13/04/2011, T-523/09, Wir machen das Besondere einfach, EU:T:2011:175
15/12/2009, T-476/08, Best Buy II (fig.), EU:T:2009:508
11/12/2001, T-138/00, Das Prinzip der Bequemlichkeit, EU:T:2001:286

Boards of Appeal

08/07/2011, R 1798/2010-G, La qualité est la meilleure des recettes

13/05/2021, R 2321/2020-5, Ready 4You (fig.)
10/05/2021, R 2189/2020-1, SMART POINTS
03/05/2021, R 101/2021-4, Snapup
26/04/2021, R 2106/2020-1, Buy 1 plant 10
20/04/2021, R 300/2021-5, No alpha no fee
24/03/2021, R 1214/2020-2, Where is my stuff and what is it doing?
10/03/2021, R 2317/2020-4, Beyond therapeutics
09/03/2021, R 2015/2020-2, Targeting what matters most
12/02/2021, R 1402/2020-5, WIR TECHNIK (fig.)
04/02/2021, R 1913/2020-4, Deutsch to go

19/01/2021, R 1878/2020-2, Your everywhere studio
13/01/2021, R 1749/2020-1, Hasta donde tú quieras
22/12/2020, R 1397/2020-2, Drink it. Feel it. Share it.
02/12/2020, R 1635/2020-5, Enabling anywhere care
13/11/2020, R 1090/2020-4, Beyond sugar
24/08/2020, R 829/2020-4, Bio Hit
13/08/2020, R 672/2020-4, Care people
24/03/2020, R 1656/2019-1, For all curl kind
16/03/2020, R 991/2018-2, Goclean (fig.)
25/02/2020, R 2718/2019-2, Don't just fit in, find your own perfect fit
13/02/2020, R 2366/2019-4, Beyond flavour
02/10/2019, R 1196/2019-4, Beyond artificial intelligence
30/09/2019, R 1197/2019-4, Beyond AI
10/08/2019, R 834/2019-4, Fittest on earth
28/08/2018, R 2648/2017-2, Foot traffic
20/11/2017, R 1209/2017-2, Beyond paint
06/09/2017, R 433/2017-2, As green as white can be