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THE TRADEMARK PROTECTION OF ADVERTISING SLOGANS: A MODERN PERSPECTIVE

INTRODUCTION

Commentators define the term "slogan" as a group of words¹ or a catch phrase used mainly in advertising and promotion.² Manufacturers or their advertising agencies design a slogan to coax consumers to purchase goods.³ A trademark, by comparison, is a name or symbol used to identify and distinguish goods and to indicate the source of the goods.⁴ Since advertising slogans are not intentionally created to function as trademarks, manufacturers or their advertising agencies have inherent difficulty getting trademark protection for slogans.⁵

The Lanham Act permits registration of slogans that function as trademarks.⁶ A slogan functions as a trademark if the slogan identifies and distinguishes the goods and indicates its source, or if the slogan is capable of doing so.⁷ A mark's distinctiveness turns on the degree of recognition of the mark in the minds of the relevant customer class.⁸ Courts and the Patent and Trademark Office ("PTO") should consistently give advertising slogans the same protections usually afforded other marks.⁹ Historically, however, this has not been the case.¹⁰ Numerous courts and even the PTO, had, in the past, misconstrued the proper standards and or relied on improper factors when they considered whether a slogan was worthy of trademark protection or registration.¹¹ In 1966, Martin J. Beran wrote, "there is still a tendency on the part of the Patent Office to

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2. 2 R. CALLMAN, UNFAIR COMPETITION AND TRADE-MARKS 147 (2d ed. 1950).
3. Id. at 149.
5. CALLMAN, supra note 2, at 147-49, see S. Lefkowitz, I Remember It Well-I Think!, 79 TRADEMARK REP. 395, 405 (1989).
7. 1 J.T. McCarthy, supra note 6, at § 7:5, 191-92.
8. Id. § 11:1, at 433.
9. Id. § 7:5, at 188-92.
treat slogans as 'second class trademarks', scrutinizing them somewhat more strictly than non-slogan trademarks. . . ." 12

Mr. Beran enumerated three stages of development in the evolution of slogans under the Lanham Act. 13 Initially, the Lanham Act, as a matter of law did not permit registration of slogans. 14 In the second stage, the Lanham Act permitted registration of slogans on the principal register, but the PTO was cautious and placed a very heavy burden upon the slogan owner to prove his right to registration. 15 In the third stage, the courts and the PTO put less emphasis upon the differences between slogan trademarks and non-slogan trademarks when they determined registrability of slogans. 16 Mr. Beran, however, predicted that, "the time is rapidly approaching when slogans will be considered, in actuality, on a par with non-slogan marks for purposes of registration in the United States Patent Office." 17 We are now in the fourth and final stage of slogan evolution under the Lanham Act. As Mr. Beran correctly predicted twenty-five years ago, the courts and the PTO no longer differentiate between slogans and non-slogan trademarks.

This note explores court and PTO opinions and their gradual award of trademark registration and protection under the Lanham Act to slogans. Part I discusses the Lanham Act, including how marks receive trademark protection, the proper factors to be considered, and the modern construction of the Lanham Act. Part II examines the cautious approach the courts and the PTO took in awarding trademark registration and protection to slogans during the first three stages of slogan trademark evolution under the Lanham Act. Part III explores the fourth and final stage of evolution—the modern liberal view that guided courts and the PTO to finally grant slogans the same status as conventional marks.

PART I
LANHAM ACT
REGISTRATION OF TRADEMARKS

In 1946, Congress passed the Lanham Act. 18 The Act permits

13. Id. at 239.
14. Id. at 239-40.
15. Id. at 240. Some legislators have feared that the registration of too many advertising slogans could clog the trademark registers because most slogans have short life spans. Taylor, Loss of Trademark Rights Through Nonuse: A Comparative Worldwide Analysis, 80 TRADEMARK REP. 197 (1990).
17. Id. at 242.
18. See 15 U.S.C. §§ 1051-1127; The Lanham Act is also known as the Trademark Act of 1946. Id.
registration of marks which distinguish the goods of the applicant from the goods of others on the "principal register" and permits registration of marks which are capable of distinguishing the applicant's goods from those of others on the "supplemental register." Registration on the principal register provides very strong protection to the applicant. Such registration is prima facie evidence of ownership of the mark and of the exclusive right to use the mark. It also gives constructive notice of the claim of ownership and may be used to stop importation into the United States of goods bearing an infringing mark. The mark becomes incontestable after five years on the principal register.

Marks registered on the supplemental register do not receive any of the aforementioned benefits, although, there are some advantages. First, federal courts will automatically exercise jurisdiction over an infringement claim and will dispense with the amount in controversy requirement. Second, the PTO publishes the mark in the Official Gazette of the Patent and Trademark Office. Attorneys use this publication as a source when they perform a preliminary trademark search. Thus, registration on the supplemental register gives informal notice to potential infringers that someone else is already using that mark. Third, the PTO may cite the applicant's registered mark against the application of a second applicant who attempts to register a substantially similar mark, even if the second applicant files for the principal register.

A mark must be either "inherently distinctive" or must have already acquired "secondary meaning" to be registrable on the principal register. "Inherently distinctive" marks are deemed distinctive in the minds of consumers as soon as they are adopted and used. Three types of marks are inherently distinctive: "fanciful," "arbitrary," and "suggestive" marks.

20. Id. § 1091.
21. See supra note 6, § 19:5, at 883-84.
24. 1 J.T. McCarthy, supra note 6, § 19:5, at 884.
27. 1 J.T. McCarthy, supra note 6, § 19:8, at 888.
29. 1 J.T. McCarthy, supra note 6, § 19:8, at 888. These three benefits also apply to the principal register. Id. § 19:5, at 883-84.
31. 1 J.T. McCarthy, supra note 6, § 15:1, at 656. "[I]nherently distinctive words and symbols need no proof of distinctiveness." (footnote omitted) Id. § 11:1, at 433.
32. Id. § 11:1, at 433.
First, "fanciful" marks are coined words consisting of new and unique combinations of letters that are totally unfamiliar to consumers, which are invented expressly to function as trademarks. Ko-
dak, Sanka, and Exxon serve as examples of fanciful trademarks. Second, "arbitrary" marks are common words in everyday use that, when used as trademark[s], bear no relationship to the product. The common word or words "do not describe the product, nor indicate use, or suggest a specific quality." Camel cigarettes and Arrow shirts exemplify arbitrary marks. Third, "suggestive" marks lead the consumer to envision the characteristics or attributes of the goods without actually describing them. For example, "Coppertone" suntan oil suggests the effect the product has on the user's skin and "Halo" shampoo suggests an attribute of the hair after use of the product. Often the line drawn between arbitrary marks and suggestive marks is a fine one. Courts, however, have little legal reason to distinguish between suggestive and arbitrary marks because both are registrable without further proof of distinctiveness.

The fourth type of mark registrable on the principal register is a "descriptive" mark which has acquired "secondary meaning." A "descriptive" mark describes a particular use, size, class of user, ingredient, characteristic, or function of a product to one who is unfamiliar with that product. The Lanham Act does not award the strong protection of registration on the principal register to marks which are "merely descriptive" because competitive sellers need to use them to describe their goods. "Secondary meaning" is another way of saying that a mark "has become distinctive" under section 2(f) of the Lanham Act. A descriptive mark acquires "secondary meaning" when the buyer associates the mark with a particular product or service, in addition to its primary meaning.

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33. Id. § 11:2, at 435-36; J. OATHOUT, TRADEMARKS 42 (1981).
34. 1 J.T. McCARTHY, supra note 6, § 11:2, at 438; J. OATHOUT, supra note 33, at 42-43.
35. 1 J.T. McCARTHY, supra note 6, § 11:4, at 439; J. OATHOUT, supra note 33, at 43.
36. Id.
37. J. OATHOUT, supra note 33, at 43.
38. See id. at 43-44.
39. Id. at 44.
40. 1 J.T. McCARTHY supra note 6, § 11:4, at 440.
41. Id.
42. Id. § 11:18, at 482.
43. J. OATHOUT, supra note 33, at 44.
44. 1 J.T. McCARTHY, supra note 6, § 11:6, at 446.
46. See 1 J.T. McCARTHY, supra note 6, § 11:21, at 493.
47. See supra note 27; see infra note 55 and accompanying text.
48. J. Oathout, supra note 33, at 44.
The mark must denote only one seller or source when the buyer hears the mark.49 "Holiday Inn" hotel and "Pocket Books" paperback books are examples of descriptive marks that have acquired secondary meaning, i.e., have become distinctive.50

Even if a descriptive slogan is registered, the registrant is not the absolute owner of all words and phrases within the slogan. The fair use doctrine provides a statutory defense to a trademark infringement claim when a party uses an element (i.e. a word or phrase) of another party's trademark, and the element is used in good faith to describe to users the first party's goods or services.51

A cursory analysis of the Lanham Act shows that slogans ought to be registrable on the principal register in the same manner as conventional marks.52 Section 2(f) of the Lanham Act states:

[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 ... (e) consists of a mark which, (1) when used on or in connection with the goods of the applicant is merely descriptive ... of them.]53

Section 45 of the Lanham Act states "[t]he term 'trademark' includes any word, name, symbol, or device or any combination thereof" and that "[w]ords used in the singular include the plural and vice versa."54 Since slogans are combinations of words, they fall squarely within the language of the Lanham Act; therefore, the courts and the PTO should affirmatively recognize them as trademarks.55 Courts and the PTO should permit slogans on the principal register if the slogans are not merely descriptive, as is the case with respect to all other marks, and should not subject slogans to any additional analyses.56 Section 23 of the Lanham Act expressly permits registration of slogans on the supplemental register if the slogans are capable of distinguishing the applicant's goods and are not registrable on the principal register.57

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49. 1 J.T. McCARTHY, § 11:9, at 453-54.
50. Id. OATHOUT, supra note 33, at 44.
52. See infra note 131 and accompanying text.
55. See infra note 95 and accompanying text.
56. Id.
Part II
THE COURTS AND THE PTO AWARD SLOGANS
LESS PROTECTION THAN OTHER MARKS UNDER THE LANHAM ACT

The courts and the PTO tended to give less regard to slogans than to other marks during the first three stages of development of slogans under the Lanham Act. This attitude may stem from the almost total lack of protection of slogans under the Trademark Act of 1905. The Trademark Act of 1905 did not generally permit registration of slogans. Rather, the 1905 Act only permitted registration of fanciful and arbitrary marks. The PTO viewed slogans as mere advertising creations that consisted of multiple words, and were rarely persuaded that a slogan, on its own, identified and distinguished goods. In fact, the PTO reasoned that because a slogan's purpose was to persuade consumers to purchase a particular product, that it was an entity completely different from a trademark and was, therefore, not registrable as a trademark. The PTO construed the 1905 Act so strictly, that even if an advertising slogan acquired secondary meaning, the PTO refused registration of the slogan. Early courts opined that slogans were inferior to non-slogan marks and were incapable of distinguishing goods.

59. See Beran, supra note 12, at 239-40.
60. See Lefkowitz, supra note 5, at 405; 3 R. Callman, TRADEMARKS AND UNFAIR COMPETITION 1268-69 (2d ed. 1950) (explaining that slogans that were inherently distinctive or that acquired secondary meaning would be protected on the theory of unfair competition, rather than on the theory of trademark infringement).
61. Lefkowitz, supra note 5, at 422-23. A descriptive slogan was registrable under the 1905 Act only if it fit the "10 Year Proviso." 2 Nims, UNFAIR COMPETITION AND TRADEMARKS § 229, at 778 (4th ed. 1947). Satisfaction of the "10 Year Proviso" required the mark be actually and exclusively used in commerce for a period of ten years. Lefkowitz supra note 5, at 401. Satisfaction of the "10 Year Proviso" is comparable to secondary meaning. Id. at 401-02. "A resort to the '10 Year Proviso' was almost impossible" because the PTO considered slogans to be mere creatures of advertising and were reluctant to hold slogans to be distinctive of the goods separate and apart from the word mark. Id. at 405.
62. Lefkowitz, supra note 5, at 399; 1 J.T. McCarthy, supra note 6, § 5:3 at 137. See also 2 Nims, supra note 63, § 229(a) at 776.
63. Lefkowitz, supra note 5, at 405.
64. Id. at 422-23.
65. See, e.g., In re Dolly Varden Chocolate Co., 2 F.2d 943 (D.C. Cir. 1924) (refusing registration of slogan "WHEN WORDS FAIL-SEND" for candy company). See also 3 Callman, supra note 60.
66. See, e.g., Burnel Handkerchief Corp. v. Cluett, Peabody & Co., 127 F.2d 318, 321 (C.C.P.A. 1942) (refusing registration of "HANDKERCHIEF OF THE YEAR" which had been used extensively for handkerchiefs).
Trademark Protection of Slogans

STAGE ONE
THE LAMHAM ACT DOES NOT PERMIT THE REGISTRATION OF SLOGANS ON THE PRINCIPAL REGISTER

Even after Congress passed the Lanham Act, the courts and the PTO remained skeptical of the validity of slogans as trademarks.\(^6\)
Both bodies strictly construed the Lanham Act, and determined that slogans were not registrable on the principal register.\(^6\)

The Lanham Act expressly defines a slogan as a mark registrable on the supplemental register,\(^6\)
yet the definition of marks registrable on the principal register does not expressly include slogans.\(^7\)
The courts and the PTO viewed this omission as an implied exclusion of slogans from the definition of marks registrable on the principal register.\(^7\)

STAGE TWO
SLOGANS ARE REGISTRABLE ON THE PRINCIPAL REGISTER, BUT ARE JUDGED WITH CAUTIOUS SCRUTINY

Somewhat of a turning point occurred in 1952. The District Court of the District of Columbia held that “certain combinations of words, albeit that they are also slogans, may properly function as trademarks.” The District Court overruled the Commissioner of the PTO and granted registration on the principal register for the slogan “THE FATE OF A FABRIC HANGS BY A THREAD.”\(^7\)

The PTO

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67. Lefkowitz, supra note 5, at 423.
68. See id.; See also Ex parte Robert Hall Clothes, Inc., 97 U.S.P.Q. (BNA) 462 (1953); Ex parte Chicago Roller Skate Co., 86 U.S.P.Q. (BNA) 176 (1950) (refusing registration of “FOR HEALTH’S SAKE*ROLLER SKATE”); Ex parte William Skinner & Sons, 82 U.S.P.Q. (BNA) 315 (1949) (refusing registration of “LOOK FOR THE NAME IN THE SELVAGE” where applicant claimed extensive use for over fifty years); Ex parte Booth Bottling Co., Inc., 80 U.S.P.Q. (BNA) 78 (1949) (refusing registration of the slogan “5 FULL GLASSES IN EVERY BOTTLE” for soft drinks, even though applicant used slogan extensively, because slogan only indicated quantity and was not capable of distinguishing goods).
71. Robert Hall Clothes, 97 U.S.P.Q (BNA) at 464-65 (refusing registration of “WHY PAY FOR OVERHEAD WHEN YOU CAN’T WEAR IT” for company that sold clothing). The omission of slogans as a type of mark registrable on the principal register, “seem[ed] to indicate an intention to confine the registration of slogans used on goods to the Supplemental Register.” Id. at 464. One commentator criticized the inconsistency of this construction, arguing that since registration is granted on the supplemental register if the mark is capable of distinguishing goods, “the next step . . . is the realization of such capability,” warranting registration on the principal register. Beran, supra note 12, at 223.
examiner and the Commissioner both initially refused registration of the mark because the slogan was merely laudatory and incapable of indicating the source of the goods. The District Court, however, found the slogan to be an arbitrary mark, and thus, inherently distinctive for registration purposes on the principal register.

Although this decision established a precedent upon which future decisions could be based, some courts distinguished it on the ground that the slogan was part of a composite mark and continued to neglect the validity of slogans as trademarks registrable on the principal register. For example, the Examiner refused registration on the supplemental register of the slogan "USEFUL NEWS FOR IMPORTANT PEOPLE" as a service mark for advertising space in a periodical because the slogan was "trite and unimaginative." The Examiner held the phrase to be a merely factual statement inherently incapable of distinguishing any service, but did not include a discussion of descriptiveness in his rejection. Rather, the Examiner explained that a slogan required some "ingenuity in its phraseology or in its application of the goods" and needed to "say something a little different from what might be expected."

yarns. The slogan was below the phrase "fashion approved" and was above a circle on a black rectangular tag. Id.; see also Wehringer, Slogans—Tests as Trademarks, 42 J. Pat. Off. Soc'y 781, 782 (1960); see also Beran, supra note 12, at 222-23.

74. Id.
75. See, e.g., Ex parte Gulf States Paper Corp., 101 U.S.P.Q. 464 (Comm'r Pat. 1954) (permitting registration of "QUALITY COUNTS" on principal register based on evidence of acquired secondary meaning via continuous use for almost fifty years.). The Commissioner posed the question: "What does . . . [the slogan] mean to purchasers?" The Commissioner answered it stating: "whatever its original signification [sic] may have been, and whatever its present general significance may be, when 'QUALITY COUNTS' appears on wrapping paper and paper bags, it means a product manufactured and sold by this applicant." Id. at 465. The Commissioner also mentioned that the slogan was "a terse phrase which suggests that applicant's products are quality products." Id. Although the basis for the decision was distinctiveness acquired via secondary meaning, this implies the Commissioner also thought the slogan was a suggestive, inherently distinctive mark. See Beran, supra note 12, at 229.

76. A composite mark is a combination of two or more elements that are considered as one entity. Even if the elements are descriptive, the combination as a whole may be nondescriptive. 1 J.T. McCarthy, supra note 6, § 11:10 at 457. Section 6 of the Lanham Act permits the Commissioner to require that an applicant disclaim his rights in descriptive portions of composite marks. Id. at 459.
79. Id. at 323.
80. Id. at 323-24. The Examiner believed a slogan's distinctiveness turned on its creativity.
The true shift in slogan opinions occurred in 1955 when the Commissioner permitted registration on the principal register of the slogan "MOVING AIR IS OUR BUSINESS" based upon evidence of acquired distinctiveness for a company that made electric fans that circulated air. Without regard for the slogan nature of the mark, the Commissioner simply questioned whether the mark distinguished the applicant's goods from those of others.

Note, however, that at this stage, the courts tended to award protection only to marks that acquired secondary meaning and did not acknowledge the possibility that a slogan could be inherently distinctive. For example, the Commissioner granted registration on the principal register for the slogan "TOPS FOR GOOD DRINKS" in 1956 for bottle caps. The Commissioner found the slogan had a "dual connotation, or double entendre" and that the industrial purchasers at whom the slogan was aimed would "recognize the phrase as indicating origin." As evidence of secondary meaning, the applicant submitted letters from beverage bottlers who insisted that the slogan "unequivocally" indicated the applicant as the source.

The Board also noted the double entendre in the slogan "NO BONES ABOUT IT" for the applicant's boneless ham when it granted registration of the slogan on the principal register based on evidence of secondary meaning. The evidence indicated the ham...


82. Ex parte Robbins & Myers, Inc., 104 U.S.P.Q. (BNA) 403 (Comm'r Pat. 1955); see also Beran, supra note 12, at 230.

83. Ex parte Robbins, 104 U.S.P.Q. (BNA) at 403.

84. Derenberg, 48 Trademark Rep. at 1039; see 101 U.S.P.Q. at 465. Although the Commissioner alluded to the possible suggestiveness of the slogan "QUALITY COUNTS," he based his decision upon secondary meaning in the minds of consumers. See Ex parte Redmond Company, Inc., 117 U.S.P.Q. (BNA) 484 (Comm'r Pat. 1958) (permitting registration on principal register for "THE BIG NAME IN SMALL MOTORS" for electric motors where evidence slogan had been so widely advertised that it became synonymous with applicant's goods and actually identified goods.).


86. "TOPS" could describe the actual bottle caps (bottle tops) for drinks or the high quality of the bottle caps.

87. 111 U.S.P.Q. (BNA) at 244.

88. Id.

89. In re National Tea Co., 144 U.S.P.Q. (BNA) 286, 287 (T.T.A.B. 1965) ("The ... [slogan] ... has a double connotation or significance as applied to hams which well might attract the attention of a prospective customer." Id.); see Beran, supra note 12, at 231-32.
had been sold widely and extensively throughout many states for three years with the slogan prominently displayed on its label.\textsuperscript{90}

**STAGE THREE**

SLOGANS ARE REGISTRABLE ON THE PRINCIPAL REGISTER, OFTEN IN A MANNER COMPARABLE TO NON-SLOGAN MARKS

In the third stage, the heavy burden of proving secondary meaning began to shift from the applicant to the PTO or the party opposing registration. The Court of Customs and Patent Appeals (CCPA)\textsuperscript{91} started its trend of granting registration on the principal register unless evidence indicated the slogan was not registrable. The CCPA held that if a slogan is "capable of functioning as a trademark... [then] registration is mandatory unless it is prohibited for one of the reasons expressly set forth in Section 2 of the Lanham Act."\textsuperscript{92} The court also noted that a slogan is a "combination of words that fits the definition of a trademark under Section 45 of the Lanham Act."\textsuperscript{93} The court granted registration of the slogan "USE ME NEXT—I'M READY FOR SERVICE" for wire cloth, because the slogan was capable of functioning as a trademark and neither the Board nor the Examiner (both of whom the court overruled) questioned the distinctiveness of the slogan. Rather, the Board and the Examiner pointed only to the inability of the slogan to function as a trademark.\textsuperscript{94} The court mentioned that the Board or Examiner may have questioned a lack of secondary meaning, but, if so, did not state it clearly enough for secondary meaning to be an issue on appeal.\textsuperscript{95} This decision did not cause a drastic change in the way slogan cases were decided. Some courts may have viewed this opinion as overbroad and, thus, did adopt its heretofore most liberal Lanham Act construction.\textsuperscript{96}

This liberal view did become a trend a few years later.\textsuperscript{97} The

\textsuperscript{90} Id. at 287.
\textsuperscript{91} In 1982, this court was succeeded by the Court of Appeals for the Federal Circuit.
\textsuperscript{92} In re Wisconsin Wire Works, 291 F.2d 958, 959 (C.C.P.A. 1961) (emphasis added).
\textsuperscript{93} Id.
\textsuperscript{94} Id. at 958-59.
\textsuperscript{95} Id. at 958.
\textsuperscript{97} But see In re Kenner Products Co., 148 U.S.P.Q. (BNA) 360 (T.T.A.B. 1967) (refusing registration on principal register of slogan "BABY'S FIRST PLAYTHING" for hanging crib mobile toy). The Board held "there is not one scintilla of imagination or ingenuity in its phraseology" even though exclusive and continuous use for
Board held in In re David Crystal, Inc., the slogan “SPORTSWEAR FOR EVERYWEAR” was an inherently distinctive mark and was registrable on the principal register. The Board noted the double entendre of the slogan as well as its alliteration. The key determination, however, was in the Board’s liberal construction of the Lanham Act. The Board reversed the Examiner, who characterized the mark as “a trite combination of words in the nature of an advertising slogan . . . [which did] not appear to be capable of distinguishing applicant’s goods from those of others,” on a finding that the slogan fit Section 2 of the Lanham Act. The slogan was used as a primary means of identification for the goods, so it was not “merely descriptive . . . [nor] incapable of distinguishing applicant’s goods” from the goods of others.

The Board also held the slogan “FROM MAINE’S COOL BREEZE TO THE FLORIDA KEYS” to be inherently distinctive of applicant’s moving and storage services. The Examiner denied registration based on the literal meaning of the slogan, which described the place to which the applicant would move a customer. The Board, however, noted that since the applicant was not confined to such a narrow job description, the slogan was not descriptive. Furthermore, the Board viewed the slogan as suggestive of applicant’s services. This decision seems to be an even further shift away from the prior burden placed upon the applicant to prove his worthiness of protection for his slogan.

The CCPA permitted registration of the slogan “YOU CAN LOOK UP TO PREFORMED” for pole line hardware used in the electrical trade. The Board denied registration because the large-lettered word PREFORMED dominated the rest of the phrase,

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99. Id. at 95. “[T]he mark possesses a double entendre in suggesting that applicant’s suits and dresses can either be worn any place or for a variety of different occasions.” Id.
100. Id. at 95-96.
101. Id. at 95. Applicant submitted specimens of hang tags from applicant’s dresses which bore the slogan to show applicant used the slogan to identify the goods. Id.
103. Id. (i.e., the slogan suggested the applicant’s capability of moving people long distances and their availability for service beyond a locality.).
104. The Board reiterated the applicant’s claim that the slogan was poetical or allegorical. Apparently, however, the Board also found the slogan suggestive without regard to such factors that might have been necessary in prior years to get registration. “True, the mark comprises bad poetry but nevertheless it is suggestive in connotation rather than descriptive.” Id.
105. In re Preformed Line Prods., Co., 359 F.2d 907 (C.C.P.A. 1966) Slogan had been in use for five years.
which consisted of much smaller letters, and because the word PRE-FORMED alone had already been denied registration for its inability to distinguish goods.\textsuperscript{106} The court's concise opinion flatly stated that the slogan as a whole identified and distinguished applicant's goods. There was no reference to acquisition of secondary meaning and no reference to specific facts indicating why or how the slogan functioned as a trademark.\textsuperscript{107} This case seems to be the entry into stage four.

\section*{PART III}
\section*{STAGE FOUR}
\textbf{THE LANHAM ACT PROTECTS SLOGANS AS TRADEMARKS SUBJECT TO THE SAME SCRUTINY AS NON-SLOGAN MARKS}

The fourth and final stage in the evolution of trademark protection of slogans started as early as 1970 in the famous case \textit{Roux Laboratories, Inc. v. Clairol, Inc.}\textsuperscript{108} Clairol attempted to register the slogan "HAIR COLOR SO NATURAL ONLY HER HAIRDRESSER KNOWS FOR SURE" on the principal register for hair color products.\textsuperscript{109} Roux, a competitor, opposed the registration of Clairol's slogan, and asserted that the slogan was merely descriptive, incapable of functioning as a trademark, and that registration would usurp language that could be used by Roux or others in the hair color industry.\textsuperscript{110}

The court assumed the slogan was "descriptive" of the goods,\textsuperscript{111} but stated that in order to determine whether the slogan was "merely descriptive," the court needed to "ascertain the reaction of those to whom [the slogan] . . . [was] directed—the consumers."\textsuperscript{112} Rather than question the "ingenuity" or "alliteration" of the slogan, the court at last focused on whether the slogan functioned as a trademark.\textsuperscript{113} The answer to this question was "yes." Clairol submitted strong circumstantial evidence from which the court inferred that the slogan acquired secondary meaning in the eyes of consumers.\textsuperscript{114} The court also found that Roux and other competitors did not

\textsuperscript{106} Id. at 907.

\textsuperscript{107} Id. at 907-8. This author believes the opinion is overly concise.


\textsuperscript{109} Id. at 824.

\textsuperscript{110} Id. Roux asserted the prior use in advertising of various fragments of the slogan for describing Roux's products and expressed fear that registration would enable Clairol to harass competitors who use similar descriptive phrases. \textit{Id.}

\textsuperscript{111} Id. at 826.

\textsuperscript{112} 427 F.2d at 825 (cites omitted).

\textsuperscript{113} Id. at 825-31.

\textsuperscript{114} Id. at 824-25. Applicant submitted evidence of an extensive advertising campaign that cost Clairol over twenty-two million dollars. The court considered such factors as the amount of money spent on advertising, the repeated use of the
need the entire slogan to describe features of their products, having used similar descriptive expressions in the past.\textsuperscript{115}

In 1974 the CCPA relied on \textit{Roux} in permitting registration on the principal register of "WE PRINT-IT IN A MIN-IT" as part of a service mark for copying services.\textsuperscript{116} The court noted that "[t]he slogan is a rhyming couplet and distinctive in its use of hyphens in 'PRINT-IT' and 'MIN-IT' and the misspelling of the latter."\textsuperscript{117} The solicitor suggested the court disregard the special misspelling and hyphenation and consider only the sound of the slogan, "we print it in a minute," to show the slogan merely described the applicant's printing services.\textsuperscript{118} A misspelling of a word will not generally turn a descriptive word into a non-descriptive mark.\textsuperscript{119} The court, however, held the slogan was not merely descriptive of the printing services and ignored the contention that other copying services would be likely to advertise that they, too, can "print it in a minute."\textsuperscript{120}

The following year the CCPA expressed language strongly supporting the treatment of slogans in the same manner as conventional marks.\textsuperscript{121} Marriott Corporation filed for registration of the slogan

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slogan, enormous sales figures, and estimates of the number (in millions) of people who received audio and visual impressions of the advertising (how many people the advertising reached). \textit{Id.} From this circumstantial evidence, the court found "applicant has so extensively promoted its slogan that it must have made some impact on the purchasing public as an indication of origin." \textit{Id.} at 827 (emphasis in original). Circumstantial evidence may be used to prove the state of mind of buyers. 1 J.T. \textit{McCarthy}, \textit{Trademarks and Unfair Competition} § 15:10 (2d ed. 1984).

\textsuperscript{115} 427 F.2d at 829. \textit{Roux} has used the following quotes in its advertising: "only you and your hairdresser know where nature stopped and Roux began" and "so matches nature’s look that no one knows it’s there!" \textit{Id.} at 824, n.3. Clairol only owns the slogan, itself, and the policy of fair use does not always give Clairol the right to stop a competitor from using certain words in the slogan; only infringing use of a substantially similar slogan can be enjoined. \textit{See supra} note 33 and accompanying text.

\textsuperscript{116} \textit{In re} Kopy Kat, Inc., 498 F.2d 1379 (C.C.P.A. 1974) The service mark consisted in its entirety of a large drawing of two cats, one holding papers and the other holding envelopes. Above the cats is "KOPY KAT" in very large letters. The slogan "WE PRINT-IT IN A MIN-IT" is in smaller print below the cats. \textit{Id.} at 1380.

\textsuperscript{117} \textit{Id.} at 1381.

\textsuperscript{118} \textit{Id.}

\textsuperscript{119} \textit{See} 1 J.T. \textit{McCarthy}, \textit{supra} note 116, § 11:12, at 460. The court neither explicitly rejected nor accepted the solicitor's contention regarding the misspelling. Later in the decision, though, the court acknowledged the misspelling as a relevant factor. \textit{Kopy Kat}, 498 F.2d at 1381-82.

\textsuperscript{120} 498 F.2d at 1381. The court cited numerous cases where registration of slogans was permitted such as the \textit{Enka} decision, \textit{Redmond} and \textit{Roux} (cites omitted). However, in each of these cases, these descriptive slogans had been registered on the basis of very strong evidence of secondary meaning. Moreover, New York City copy shops frequently devote advertising space to describing the speed of their copying services. Therefore, this decision may have been too liberal.

\textsuperscript{121} \textit{In re} Marriott Corp., 517 F.2d 1364 (C.C.P.A. 1975).

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"WE SMILE MORE" as a service mark for its hotel and restaurant services. In opposition to many earlier court views, the court here asserted, "[u]niqueness is not a necessary characteristic of a slogan serving as a trademark." The court admitted the slogan was a common ordinary expression, however, and found the slogan suggestive of "... the facial expression of persons performing the services [rather than descriptive of the] services themselves." The court specifically noted that even where marks are descriptive, upon determining distinctiveness, marks "... must be considered in their entireties."

In 1979 the Board cited the language of the Marriott decision and took it a step further; "a slogan or expression does not necessarily have to be unique or catchy or rhyming to perform the function of a mark." The applicant's attempt to register the slogan "THINK ABOUT IT" as a service mark for banking and financial services failed but not because of any anti-slogan attitude of the Board. On the contrary, the Board confidently stated "[t]here can be no doubt that slogans are registrable on the Principal Register when they" function as a trademark. The Board denied registration after a careful analysis of the specimens which led to their conclusion that, in this case, consumers would only consider the ordinary meaning of the slogan and would not view the slogan as distinctive of the applicant's services.

The Board used this reasoning again in 1988 when it denied registration of the slogan "HI-YO-SILVER" on the principal register "as a trademark for cinematographic films, audio and video tapes, cassettes and cartridges, and viewers for use with photographic transparency slides." Applicant acknowledged the coined na-
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The use of the slogan, its extensive use for fifty years in "Lone Ranger" radio shows and comic strips, and its close link to the "Lone Ranger" character. The Board, however, looked to the "... use of the term as evidenced by the specimens of record," and found the slogan, although distinctive of the character, did not function as a trademark to indicate Southbrook Entertainment as the source of the videocassettes. Although the slogan was exclaimed by the Lone Ranger character at the beginning of each videocassette episode and the slogan appeared at the bottom of the screen, the Board held that consumers would view the slogan as nothing more than an expression of the character.

The Board reiterated the logic of its Southbrook decision when it cancelled Anheuser-Busch's (respondent) registration of "THE ORIGINAL PARTY ANIMAL" as a trademark for respondent's beer. Owen Ryan (petitioner) filed to register "PARTY ANIMALS" as a mark for crackers and was opposed by respondent. Petitioner then petitioned to cancel the registration owned by respondent on grounds that the slogan did not function as a trademark for respondent's goods (beer). The Board held that "THE ORIGINAL PARTY ANIMAL," featured as a slogan beside the now-famous promotional character "Spuds Mackenzie" on the ad and the displays used to promote respondent's beer was only descriptive of the character "Spuds Mackenzie" and was not distinctive of respondent's goods. The slogan never stood alone in the beer ads, but was only used in conjunction with the "Spuds Mackenzie" character. The public would not perceive the slogan as indicating the source

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132. Id. at 1166-67.
133. Id. at 1167.
134. Id. The Board contrasted this case with the MGM Lion which roars at the beginning of each MGM film and indicates to viewers that the film was produced by MGM. The slogan exclaimed by the Lone Ranger character, on the other hand, does not indicate that Southbrook Entertainment produced the films nor manufactured them. Id. at 1167-69.
135. Owen Ryan & Assocs. v. Anheuser-Busch, Inc., Cancellation No. 17,939 slip op. (May 16, 1990), vacated and remanded with instruction to dismiss with prejudice on other grounds (T.T.A.B. February 20, 1991). This unreported decision was vacated by consent of both parties pursuant to a settlement agreement. Respondent's slogan was registered as a trademark for Budweiser Beer and Bud Lite Beer. Id. at 1-2.
136. Id. at 1. Petitioner claimed "the continued existence of said registration stands as a potential cloud on the right to register 'PARTY ANIMALS' by Petitioner." Id.
137. Id. at 1. Respondent submitted specimens of displays associated with the goods. These displays show a large dog, the words "Spuds Mackenzie," and directly underneath, the slogan "THE ORIGINAL PARTY ANIMAL." In each display, the beer Bud Light is shown, however, the beer is not in close proximity to the slogan. The slogan only modifies the character name. Id. at 10-11. Respondent also submitted printed articles about the character Spuds Mackenzie who is referred to in the articles as "THE ORIGINAL PARTY ANIMAL." Id. at 11, n.5.
of the beer, and thus, did not function as a trademark for the beer.139

The Board unabashedly expressed the liberal approach of the fourth stage in a 1985 case.140 The National Training Center for Lie Detection published The Journal of Polygraphic Science with the title printed in very large bold type across the cover of the periodical.141 The slogan “DEDICATED TO ACHIEVING THE HIGHEST LEVEL OF PROFESSIONALISM” was printed in the upper right hand corner of the cover in extremely small type.142 The court provided an interesting rationale for granting registration on the principal register for the slogan: “[b]ecause we have not been persuaded that applicant’s admittedly laudatory phrase . . . does not function as a mark, we believe that the asserted mark does so function and should be allowed for publication.”143 The heavy burden of proof placed upon the applicant had shifted completely in the other direction. Applicant presented neither exhibits nor promotional materials, nor affidavits attesting to recognition of the slogan as a mark.144 The Board stated, “[t]he ultimate test is what the customers (subscribers and readers in this case) understand by the phrase from the manner and context of use.”145 This determination was made with reference only to samples of the journal at issue. No other proof was requested.146

This liberal attitude was also exemplified by the Board in a 1986 case.147 There, the Board permitted the applicant to register “AMERICA’S BEST CHEW” on the principal register because it acquired secondary meaning through extensive use on packaging and in advertising for over thirty years.148 This seems unusual in light of the history of similar slogans. Just two years before this decision, the Carvel Corporation was denied registration on the supplemental register for the slogan “AMERICA’S FRESHEST ICE CREAM.”149 The Board held Carvel’s slogan was merely a common, laudatory mark that was incapable of indicating origin to the purchasing public.150 The Board distinguished “AMERICA’S BEST CHEW” from

139. Id. at 12.
141. Id. at 799.
142. Id.
143. Id. at 800.
145. Id.
146. Id.
148. Id. (Citing the Burmel decision for the proposition that a purely laudatory expression cannot function as a trademark, regardless of extensive use).
"AMERICA'S FRESHEST ICE CREAM" because "the word 'chew' is [not] synonymous with 'chewing tobacco'" and "... the generic or common descriptive name of the goods is not part of the slogan."\textsuperscript{151} The Board concluded that since the slogan has not been proven unregistrable, it is registrable.\textsuperscript{152} Although the Board distinguished these cases, it is highly doubtful that such a conclusion would have been reached twenty years earlier.

\textbf{CONCLUSION}

The slogan has endured a long struggle in its effort to be treated with the same respect as other marks. The questions of ingenuity, uniqueness, and rhyme have fallen by the wayside. The PTO does not sponsor a contest to see who can write the catchiest slogan. Rather, today, a slogan is registrable if it functions as a trademark or is capable of functioning as a trademark and if no evidence proves otherwise.

\textit{Evynne Grover}

\textsuperscript{151} 231 U.S.P.Q. at 414-15.
\textsuperscript{152} Id.

\textsuperscript{Burmel, supra note 68. See, e.g., In re Melville Corp., 228 U.S.P.Q. (BNA) 970 (T.T.A.B. 1986) (refusing registration of slogan "BRAND NAMES FOR LESS" for retail clothing store services because it was incapable of indicating source regardless of the millions of dollars spent advertising the slogan and the billions of dollars in sales).