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LEGAL PROTECTION



PROTECTION OF SLOGANS

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Protection of Slogans

I'M LOVING IT!

BECAUSE YOU'RE WORTH IT!

JUST DO IT!

GOOD FOOD, GOOD LIFE!

.....

All these words immediately bring images of their company to mind, McDonald's, L'Oréal, Nike, Nestle... Are they simply a few words put together to form a sentence? What are these compilations of words?

Slogans, yes slogans, defined as "A catch phrase or small group of words that are combined in a special way to identify a product or company". Like Trademarks, these "slogans" help identify the company and its products, actually more than trademarks, it gives it identity. So, can we therefore count them in as part of a company's assets and as worthy of protection? yes! They are as important, if not more important than the traditional trademark, since auditory marks leave an imprint in one's memory, beyond the instant.

Definition of a Slogan

How can we define a slogan, which is a phrase that can be registered in one's intellectual property?

A Slogan is defined as a short, easily remembered phrase used by an organization so that people will recognize its products or services. The Slogans are usually used in the advertisement campaigns. Some of these Slogans became well-known marks and part of the brand's identity in different industries. Subsequently, the protection of the slogans is essential to multinationals to protect their brands identity. However, the matter of granting legal protection to slogans is not a straightforward one since slogans are at the intersection of several converging intellectual property rights, including Trademark, Copyright and Unfair Competition. Therefore, it is important to understand how companies can achieve such protection and by which means?

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Protection of a Slogan as Trademark

Over time, the term Trademark has grown and evolved. Nowadays almost everything is potentially registerable and protected as Trademark. Trademarks though are a territorial asset and must be registered in each country. Lebanon is not an exception. Therefore, we need to examine how trademark is defined in this jurisdiction.

In Lebanon, Article 68 of the Trademark Law defines Trademarks as names written in a way which distinguishes them from others, titles, nomenclatures, symbols, stamps, letters, protruding marks and drawings, small drawings and figures, in general any sign of any kind intended to distinguish things and show the identity, source, origin of goods or services.

Given this broad definition of trademarks, we can extend to slogans the protection granted by the Trademark Law. However, this does not mean that any slogan can be registered as a Trademark. The inherent characteristics of slogans make it more difficult to immediately extend protection and require further examination. The query whether Slogans may be protected as Trademarks, is haunted by a fear of monopolization of the common language. The second concern is whether a slogan can fulfill the core requirements of a Trademark "to identify and distinguish the source of goods or services" rather than just as being a means to provide promotional information. Nevertheless, the requirements for the registration and protection of a Slogan are stated to be the same as for any other Trademarks. However, Slogans are usually exposed to a more severe "distinctive character evaluation" before being granted protection and registration. Thus, we have seen in practice that many slogans fail to obtain legal protection.

It is thus important to look into the manner in which registration is possible, based on which criteria?

To be entitled for protection and registration, a Slogan should meet at the least, the following criteria:

- (i) The requirement of distinctiveness;
- (ii) It should be used as Trademark and displayed visibly and consistently;
- (iii) It must identify and distinguish the source of goods or services of a producer;
- (iv) It should not be descriptive of the goods or services with which it is used.

Slogans are creative elements of a brand; it falls upon the marketing genius to come up with one that reflects the spirit and character of the company and its products or services. Creative people however do not consider the practical legal repercussions of their expression, and whether what they propose or put out in the public, may be protected and used exclusively. Therefore, it is left up to the legal team to chaperone and guide the marketing when they wish to preserve their nascent embryo. However, the relationship between the legal team and that of the marketing team is not always smooth. Usually the best slogans from a marketing point of view are often those which lack distinctiveness and are considered descriptive. Thus, the best Slogans are so promotional that they cannot be perceived as anything other than Slogans and are the most desirable from a marketing perspective but from a legal perspective, are so generic that is not possible to register them as Trademarks. On the contrary, the Slogans which convey

no promotional information at all might be registered from a legal point of view but from a marketing point of view they are not attractive.

How then to merge the two and bring the Slogan closer to a Trademark and have it registered? We must consider the distinctive nature of the Slogan, and what elements hinder such distinctiveness.

The main elements that diminish a slogan's distinctive character can be summarized as follows:

1- **Sentences that are descriptive for the goods and services applied for:**

Slogans are a good tool to identify a product or service as one of high standing and quality. When you think of L'Oréal Slogan, "Because you're worth it!" you immediately think that the product is a superior one, and that you deserve this pampering and feeling of luxury it gives. This therefore results in increased sales, since in the mind of the consumer, a product which is synonymous with its supreme quality, is one where purchase thinking is immediate. However, this simplistic use of words and phrases, is also a common reason why many slogans fail to be distinctive. For instance, although the previously cited slogan is common when you think about it, the US Court have not always been favorable, and have ruled in one instance that the Slogan "ESCAPE FROM THE ORDINARY" for extraordinary clothing to be purely descriptive phrases.

2- **Phrases of general laudatory or positive character:**

Marketing always attempts to touch the consumer's emotions to generate a positive reaction. Thus, it is more difficult for Marks that have a positive character to receive a trademark protection. The sentence GOIN' THE EXTRA MILE in advertisements for tires, has failed to acquiring protection since it conveys the message that the product (tires) and service are better than others. Although catchy, it is not sufficiently distinct to have Consumers associate the Slogan with a particular brand.

3- **General Statements and claims:**

We are happy! This is an ordinary statement, a positive one and very general, again such statements, which are common and general cannot be protected. A slogan is a group of words that sound catchy; however, this group of slogans shall be denied registration on the same grounds as generic word marks since they are not distinctive, and they must be open to competitors.

4- **Slogans that are extensive in length and/or fail to stand out from other material:**

"To eat one's words" literally when creating a long Slogan. We cannot have a Slogan composed of several words or sentences; we will surely be faced with a denial from protection. A relatively long advertising Slogan is not recommended. The Slogan usually consists of 3 to 6 words maximum. Therefore, when the Slogan is long, there is a risk that the public perceive the Slogan as an advertisement and not a mark.

5- **Explanatory, instructional or informational statements:**

Slogans usually stir feelings, they are not considered as informational, one that are merely used to describe or give information have consistently been denied registration since they are considered common words and they should be free to use by any person or entity. For instance, the Slogan "Drive Safely" by Volvo was denied registration.

But how to increase a slogan's chances of being registered? What are the elements that increase a slogan's distinctive character? We have below a few elements that increase such chances:

1- **Extensive use**

A descriptive word mark or Slogan as stated before is usually not protectable. However, when confronted with the extensive use of such Slogan in the market, such is considered an exception since it has gained public recognition and it identifies the goods or services of a specific producer. The length, manner of use, as well as the nature and extent of advertising are all factors that affect whether a descriptive Slogan might be registered and thus protected or not.

2- **Constructions that are easy to remember:**

Slogans which are composed of surprising elements, memorable words that make them original render the Slogan as memorable enough to acquire distinctiveness from both marketing and legal perspectives.

3- **The existence of a protected word mark in a slogan:**

A Slogan that includes a protected mark can increase the its chances for protection and registration. The reference to a mark in a Slogan makes consumers associate the message of a Slogan with a certain brand name. For instance, "Connecting People" for communication services is highly descriptive. However, the Slogan including the brand "NOKIA Connecting People" has acquired distinctiveness.

We have seen from a general perspective what elements constitute the formation of a protectable slogan, and which hinder such chances. In Lebanon, The Lebanese Judiciary has ruled on several occasions regarding the protection of Slogans as Trademarks.

In one of the leading cases, the Lebanese Court concluded that **"It is possible to consider as a Trademark to benefit from the legal protection available for the latter as stated in Article 72 of the Law No. 2385/24 and to claim personal ownership of this marketing Slogan** otherwise the owner of this Slogan can benefit from his rights as author if this Slogan enjoys an original characteristic".

(The Court of First Instance of Mount Lebanon, decision No. 40/2010 dated 22/07/2010- Not published).

Hence, The Lebanese Judiciary has granted protection to Slogans provided that they distinguish the products and services and show the identity and source of such goods and services.

But is a slogan, a composition of words, just an element of a Trademark? Can we not think of protecting it under Copyrights as well?

Protection of a Slogan as Copyright

The Copyright Law in Lebanon states that the protection of this Law shall apply to every production of the human spirit be it written, pictorial, sculptural, manuscript or oral, regardless of its value, importance or purpose and the mode or form of its expression.

Thus, the slogans which are productions of the human spirit can enjoy protections as copyright. In practice, the courts have granted copyright protection only to slogans which have demonstrated their originality and distinctiveness.

It is worth mentioning that the protection of slogans as copyright does not prohibit their protection as Trademarks if they are eligible to be perceived as Trademarks, thus one does not hinder the other. It is always recommended to opt for Trademark Registration of the slogans even in the cases where they are protectable under copyright protection, since the trademark registration can be renewed continuously and will not fall in the public domain as the copyright.

In other jurisdictions, slogans were denied protection based on copyright Law since they are short phrases not eligible for copyright protection.

However, we have seen Slogans that were famous but were not registrable, however companies have been able to enforce their protection, but how?

Slogans are an asset which gives a company a competitive edge, therefore hijacking one's slogan or imitating it, can be seen as a type of "unfair competition".

Protection of a Slogan by Unfair Competition

Even if not registered as Trademark, a slogan may still be protected by virtue of Unfair Competition. The Unfair Competition is based on the presumption that the competitor derives an advantage from the goodwill and fame of another trader who has acquired such notoriety through his activity and legal efforts. This competitor of bad faith, by having recourse to wrongful methods, such as manipulating slogans, can mislead the consumers and convert them to him, violating principles of integrity and honesty which form part of the commercial practices.

In this context, any use of a misleading slogan by a competitor which can lead to confusion in the consumers mind can be enforced by virtue of Unfair Competition. For example, the use of slogan JUST DID IT is considered an infringement of the well-known slogan JUST DO IT®.

In Lebanon, the Court considered that taking a word from a slogan and register it as Trademark is not considered an infringement of the duly registered slogan since the slogan is protected as a whole and

the protection does not extend to each word of this slogan used separately unless this word constitutes a trademark eligible for protection by itself.

(The Court of Appeal of Beirut, decision No. 222/2011 dated 17/02/2011- Not published)

In Unfair Competition Cases, the potential damage which can result is sufficient for the courts to accept the unfair competition action since the objective in the unfair competition case is not only to indemnify the damaged party, but most importantly it is to stop the illegal acts which constitute the competition.

Conclusion

Slogans are therefore here to serve the consumers as much as the company behind it. It gives guarantee of quality and good service and are therefore not to be messed with as an element of the image of a brand. Therefore, protection of slogan is crucial to protect the company's assets. However, we must be careful then when creating or selecting our Slogan. Based on all the above, in order to be eligible for protection whether as Trademark, Copyright or Unfair Competition, it is crucial to develop a distinctive slogan that escapes the chains of descriptiveness, ensure that this slogan does not infringe upon any third-party rights and avoid any likelihood of confusion with prior trademarks or slogans. Seeking Trademark registration of the slogans when this slogan meets all legal requirements should also be considered.

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