

# “Real Stupidity Always Trumps AI” – Registrable and Enforceable?

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June 6, 2018

# Slogans



- The EUIPO rejected the trademark:

## **FOREVER FASTER**

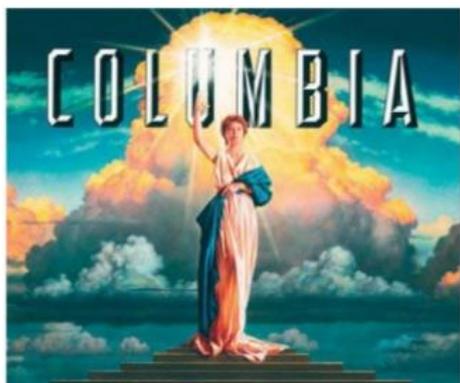
- This is registered in Canada.
- The EUIPO rejected the trademark:

## **LA QUALITE EST MEILLEURE DES RECETTES**

- In Canada, this was approved...in French and in English!

## What is a Trademark?

- A mark or sign that is used by a person to distinguish or serves to distinguish goods or services manufactured, sold, leased, hired or performed by him/her from those manufactured, sold, leased, hired or performed by others
- Definition to be broadened to include non-traditional marks



# Day to Day Practice



- If a slogan functions or will be functioning as a trademark, it can be registered
- A slogan must be used or intended to be used within the meaning of the Trademarks Act

# Day to Day Practice



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## Protect your brand

Your business, products and services have a brand image that is recognizable to customers. Learn how to protect your marketing investment.



### Your brand has value

Building a brand image is a very important part of marketing.

Everything that sets your business apart—its name, product and service names, slogans, logos, taglines and even sound marks—produces a brand image that your customers come to know.

If your brand is distinctive, it will make your customers loyal and give you an edge over your competition. In fact, your brand can become one of the most valuable things about your business as customers come to know it well it over time. This value can become so great that you can use it to bargain for [financing with banks](#) and other lending institutions.

### Your trademark stands for your brand

Protecting your brand and the products and services it stands for is critical to your future sales. Your trademark is an important part of your brand, and registering it gives you the exclusive right to use it to sell your products and services.

Trademarks include letters, words, logos, product and service names, slogans and more. If you do not protect your trademark, a competitor could use it or something similar, which could confuse your customers.

# Registrability of Slogans

# Day to Day Practice



- Slogans are usually made up of common dictionary terms
  - it's what makes them catchy and memorable
- But it can also make them prone to being:
  - suggestive or clearly descriptive
  - confusing with other marks using similar or identical words
- Scope of protection for slogans may be somewhat limited

# Slogans in Canada



**FINGER LICKIN' GOOD (KFC)**

**WE ARE FRESH OBSESSED (Metro)**



**(Loblaws)**

**THE WORLD'S LOCAL BANK (HSBC)**

**DON'T LEAVE HOME WITHOUT IT (American Express)**

**THE ULTIMATE DRIVING EXPERIENCE (BMW)**

**WHAT'S IN YOUR WALLET (Capital One)**

# Slogans in Canada



**CONSUMING THIS PRODUCT MAY GIVE YOU JOY**



**GREAT THINGS FOR CANADA**

**JOIN THE MOVEMENT TO SAVE BREAKFAST**

**INGREDIENTS YOU CAN SEE, QUALITY YOU CAN TASTE**

**GREAT EXPERIENCE MATTERS**

# Legislative Restrictions



- A trade-mark is not registrable if it is:
  - confusing with another mark
  - clearly descriptive or deceptively misdescriptive in English or French
  - a mark which is prohibited by [section 9](#) or [10](#) of the Act
  - in conflict with a geographical indication

# Descriptive Slogans



- Slogans can be susceptible to descriptiveness objections
- *Loblaws Inc. v. Whole Foods Market IP, L.P. 2016 TMOB 81*
  - **CANADA'S HEALTHIEST GROCERY STORE**
- Trade-marks Opposition Board:
  - slogans are not subject to a different standard or treated any differently than other trade-marks
  - if they are clearly descriptive or deceptively misdescriptive so as to offend the [Act](#) and if they do not demonstrate distinctiveness, they are not registrable

# Descriptive Slogans



Trademarks	Goods/Services
CANADA'S FAVOURITE SPONGE	sponges
CANADA'S BUILDING CENTRE	retail outlets selling building supplies
CANADA'S MOST TRUSTED SPECIALIZED RECRUITMENT FIRM	Personnel placement, employment counselling and recruitment services
WORLD'S BEST FOOD STORE	Grocery store services
CANADA'S BEST LOOKING SPORTS PUB	Restaurant and bar services
CANADA'S MEETING PLACE	Operation of a convention centre
CANADA'S FAVOURITE KETCHUP!	Condiments, namely ketchup
CANADA'S TRUSTED MORTGAGE PROFESSIONALS	Mortgage brokerage
CANADA'S MOST TRUSTED LEGAL RECRUITERS	Personnel placement, employment counselling and recruitment services
CANADA'S PARTS PEOPLE	Retail sale of cars, trucks, industrial machinery parts and accessories.
CANADA'S WELLNESS STORE	retail outlets for distribution and sale of medical and rehabilitative products

# Confusion Between Slogans



- Oppositions based on similar slogans
- *Randstad Holding N.V. v. Hays plc, 2017 TMOB 168*
  - Ranstad's mark: SHAPING THE WORLD OF WORK
  - Hays' mark: POWERING THE WORLD OF WORK
- Recruitment services
- Weak marks
- Use as secondary marks

# Section 9 Marks



- Official Marks

0920222	<u>BEST RECIPES EVER</u>	.	ADVERTISED	1, 2, 3, 4, 5, ...
0920011	<u>SERVING THOSE WHO SERVE</u>		ADVERTISED	1, 2, 3, 4, 5, ...
<small>SPTO 0919485 v/trademark</small>	<u>IT'S YOUR BUSINESS. START. GROW. SUCCEED.</u>		ADVERTISED	1, 2, 3, 4, 5, ...
0919934	<u>OUR VISION TO BE THE WORLD RENOWNED JEWEL OF THE 30,000 ISLANDS ON GEORGIAN BAY</u>		ADVERTISED	1, 2, 3, 4, 5, ...
0921029	<u>A DIFFERENT TODAY. A BETTER TOMORROW.</u>		ADVERTISED	1, 2, 3, 4, 5, ...
0924117	<u>HELP ME TELL MY STORY</u>		ADVERTISED	1, 2, 3, 4, 5, ...
0918673	<u>PUTTING KNOWLEDGE TO WORK</u>		ADVERTISED	1, 2, 3, 4, 5, ...
0917577	<u>HEALTHIER CHILDREN. A BETTER WORLD.</u>		ADVERTISED	1, 2, 3, 4, 5, ...
0913328	<u>BUILDING BLOCKS OF PARENTING: COMFORT, PLAY AND TEACH</u>		ADVERTISED	1, 2, 3, 4, 5, ...
0913291	<u>HELPING PEOPLE BREATHE EASIER</u>		ADVERTISED	1, 2, 3, 4, 5, ...

## Section 9 Marks

- Scandalous, obscene or immoral word or device



**F  
CANCER**



**WTF**

DON'T \*\*\*\* WITH A CANUCK

FOOT P\*\*\*Y

S\*\*T FACED BEER

D\*\*K MOVE

- *Cohen v. Susan Fiedler Incorporated*, 2014 FC 967

# Extreme Examples of “Slogans”



1512415	<u>LOVE ME FOR THE ESSENCE OF WHO I AM... ADMIRE ME FOR MY STRENGTH AND SPIRIT. CHERISH ME FOR MY PASSION AND DRIVE. RESPECT ME FOR MY ASPIRATIONS THAT DARE ME TO DREAM. WHAT'S MOST IMPORTANT IS THAT YOU LOVE ME... FOR ME.</u>	REGISTERED	3
1790409	<u>philosophy: progress is made in baby steps. each micro win contributes to a manifestation of our best selves. these micro-efforts can smooth the bumpy road of time, and along the way, lead to micro-moments of monumental renewal on our path to wellbeing.</u>	REGISTERED	
1824566	<u>From potential emerges promise. Science proves that when the sun goes down, your skin goes to work to rebuild what the day takes away. When the sun comes up, your skin does its best to withstand the weight of the world so you can put your best face forward. The promise of a new day is here. Make every moment count.</u>	APPROVED	3
1830340	<u>philosophy: much like a ballet, life is a delicate dance requiring flexibility, patience and perseverance. as we continue to learn the choreography of compassion and kindness, we experience that living with grace gives us the quiet strength to move to our own rhythm.</u>	APPROVED	3

# Translation Requirements



- Charter of the French Language (Quebec)
  - Every inscription on a product, on its packaging, or on any document provided with it must be in French.
  - No other language may be given greater prominence than the French language
- Exceptions include “recognized trademarks”
- What is a “recognized trademark”?

# Enforcement and Strategies

# Confusing Slogans



- Slogans are generally quite difficult to enforce
  - But the tide may be turning...
- *Sleep Country Canada Inc. v Sears Canada Inc. 2017 FC 148*
  - Sleep Country: **WHY BUY A MATTRESS ANYWHERE ELSE?**
  - Sears: **THERE IS NO REASON TO BUY A MATTRESS ANYWHERE ELSE**
- Interlocutory injunction granted to Sleep Country

# Strategies



- Selection of a slogan

**IDEAS FOR LIFE** (Panasonic)

**IMAGE IS NOTHING. THIRST IS EVERYTHING. OBEY YOUR THIRST** (Sprite)

**LET YOUR FINGERS DO THE WALKING** (Yellowpages)  
**THAT WAS EASY** (Staples)

**PROBABLY THE BEST BEER IN THE WORLD**  
(Carlsberg)

**REACH OUT AND TOUCH THEM** (AT&T)

**IT'S NOT FOR WOMEN** (Dr. Pepper)

# Strategies



- Distinctive elements
- Registrability opinions
- Extensive Use of the Slogan

Thank You!