Trademark management

Register slogans as community trademarks after Vorsprung durch Technik? Yes we can!

The recent Audi decision provides trademark owners with useful guidance over the development of slogans. That slogans could be registered as community trademarks (CTMs) has never been seriously doubted or disputed from a principle point of view. However, since slogans are neither explicitly included in, nor excluded from, the trademark definition used in the Community Trademark Regulation (207/2009), successful registration of a slogan as a CTM depends on fitting it into the definitions laid out in Article 4 of the regulation and negotiating the hurdles of Article 7, which lays down the absolute grounds for refusal of a CTM application by the Office for Harmonization in the Internal Market (OHIM).

Since this is a question of interpretation it is no surprise that slogans – just like other signs which are required to distinguish the goods or services of one undertaking from those of other undertakings – have given rise to some captivating litigation over the years. However, the decision of the Court of Justice of the European Union in Audi AG v OHIM (Case C-398/08) concerning the registration of Audi’s slogan ‘Vorsprung durch Technik’ (Case C-64/02, October 21 2004) does not contain elements likely to enable the relevant public to remember the expression easily and immediately as a distinctive mark for the goods and services covered by the application. It consigned to the dustbin the CFI’s finding that Vorsprung durch Technik could have such an inherent capacity for all the goods and services covered by the application. It consigned to the dustbin the CFI’s finding that Vorsprung durch Technik does not contain elements likely to enable the relevant public to remember the expression easily and immediately as a distinctive mark for the goods and services covered, over and above its obvious promotional meaning.

The ECJ also reaffirmed that the criteria for the assessment of distinctive character are the same for other categories of mark (referring to its decision in OHIM v Erpo Möbelwerk (Case C-64/02, October 21 2004) concerning the slogan ‘Das Prinzip der Bequemlichkeit’). In this regard, any specific difficulties in establishing the distinctiveness of slogans, because of their very nature (difficulties which the ECJ allows to be taken into account), do not justify laying down specific criteria supplementing or derogating from the criterion of distinctiveness as interpreted in the ECJ’s existing case law (see Procter & Gamble v OHIM (Case C-473/01 P and C-474/01, April 30 2004), OHIM v Erpo Möbelwerk, Henkel v OHIM (Case C-144/06, October 4 2007), Eurohypo v OHIM (Case C-304/06, May 8 2008) and Storck v OHIM (Case C-25/05, June 22 2006)).

Given this, one can not, therefore, require that a slogan be easily and immediately perceived by the relevant public as a distinctive sign for the goods and services in order to be registrable as a trademark. The ECJ adds this specific requirement to other requirements that it has already declared out of order: “imaginativeness” and “conceptual tension which would create surprise and so make a striking impression” (see OHIM v Erpo and SAT.1 v OHIM (Case C-392/02, September 16 2004)).

In other words, the registration of slogans as a trademark is safeguarded from specific requirements other than those laid down in, and confirmed by, ECJ case law. Of course, this is also helpful with regard to the fight against requirements without merit that slip into the registration process. But the ECJ’s decision goes far beyond this attempt to create a level playing field. It states, beyond doubt, that the mere fact that a slogan is perceived by the relevant public as a promotional formula, and that because of its laudatory nature, it could in principle be used by other undertakings, is not in itself sufficient to support a conclusion that the slogan is devoid of distinctive character.

This follows sound reasoning. A slogan can be perceived by the public is both promotional and as an indication of the commercial origin of good or services. The one does not exclude the other. That said, the ECJ concludes with a remark which at first glance seems pointless to mention, but which on closer inspection provides good guidance when developing slogans that can be trademarks: a slogan that has a number of meanings, constitutes a play on words and/or is imaginative, surprising and unexpected, and is in that way easy to remember, is most likely to endow that slogan with distinctive character.

Of course, that ultimately depends on the perception of the public, but with Vorsprung durch Technik the ECJ has created a promising playground for practice. Can we play in it? Yes we can!