



## **“Every time a good time” – Protecting slogans in Germany**

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“In recent times, the functions of advertising and branding have obviously approached each other to an extent that often both phenomena can no longer be sharply distinguished.” This Federal Patent Court’s statement of March 22, 1999 was the beginning of a process which led to a more liberal view on the requirements for protecting slogans. Eva M. Reinhardt and Dr. Henning Hartwig take a close look on the latest development also being confirmed by recent decisions of the Federal Supreme Court.

In Germany, the protection of advertising slogans or catchwords has played a rather subordinate role in the case law to date. The registration as a trademark of such advertising phrases which, according to the German Patent and Trademark Office (GPTO) and the Federal Patent Court, did not fulfill the functions of a trademark, was – with very few exceptions – generally refused. Copyright protection was only obtainable in cases of creative individuality, which was mostly denied, especially in cases of short advertising jingles. The best chances to proceed against the copying of an advertising slogan were to be had under unfair competition rules. Even here, however, “typical” advertising slogans were regularly considered by the courts as lacking competitive individuality and, therefore, not being protectable under German unfair competition law.



## **Key Decisions of the Federal Supreme Court**

From a trademark law perspective, the Federal Supreme Court has now, with its decisions “*Radio von hier*” and “*Partner with the Best*”, initiated a change in the relevant jurisdiction by taking a less restrictive view on the requirements for the registrability of advertising slogans.

In line with the previous case law, the preceding Federal Patent Court denied registration in both cases on grounds that the wordmarks “*Radio von hier, Radio wie wir*” (“radio from here, radio like us”) and “*Partner with the Best*” were merely describing and promoting the respective goods and services. According to the Court, these slogans neither contained an independently characterizing aspect nor a significantly imaginative surplus, and therefore lacked distinctiveness. Despite a certain originality, these expressions would therefore not qualify for registration.

In this respect, the Federal Supreme Court – thereby taking into account a literature of long-time criticism of the Federal Patent Court’s jurisdiction – criticized that the latter had set the standards for the assumption of distinctiveness of advertising slogans too high. According to the Federal Supreme Court, no stricter standards may be applied to the distinctiveness of slogans as are applied to other wordmarks. Although the public may in many cases take an advertising slogan for a promoting statement which does not serve primarily to identify the provenance of the product, this, however, would not justify the application of different standards of distinctiveness in comparison to other wordmarks, since the function of identification and the advertising effect, both inherent to a trademark, do not exclude each other.

## **Requirements for protecting advertising slogans**



Consequently, it is decisive – just like with the “classical” wordmarks – whether the slogan has “a content exclusively describing the product, or whether any element of distinction, no matter how small, relating to the registered goods and services, can be additionally ascertained.” A canon of interpretation as to when such “elements of distinction, no matter how small” are to be assumed is simultaneously provided by the Federal Supreme Court: A lack of distinctiveness is to be assumed with regard to descriptive or promoting and advertising statements of a general nature and, as a rule, with any longer sequence of words. Contrarily, “shortness, a certain originality and succinctness” can be taken as evidence for distinctiveness as well as “ambiguity and the resulting need for interpretation of the advertising statement”, which are means to transform a trademark application into a catchy and significant advertising slogan.

On the basis of these general considerations, the Federal Supreme Court judged the slogan “*Radio von hier, Radio wie wir*” as well as the statement “*Partner with the Best*” as being sufficiently distinctive. According to the Federal Supreme Court, the slogan “*Radio von hier, Radio wie wir*” can be determined as a short and succinct sequence of words which distinguishes itself clearly from a longer sequence. Additionally, this slogan was understood to be particularly catchy and lively because of its simple rhyming message, and stimulating to the intellect because of its ambiguity. The slogan “*Partner with the Best*” was held to show distinctiveness on grounds of the unclear and grammatically incorrect linking of its elements as well as because of a strong need for interpretation.

Apart from generally lowering the requirements of distinctiveness of advertising slogans, the decision “*Partner with the Best*” is also interesting with regard to a second aspect: The



Federal Supreme Court further stated that the numerous appearance of *single elements* of a slogan – for instance on web sites – cannot lead to the assumption that the *slogan as a whole* may not be registered, since its free use by competitors must be safeguarded. This ruling is grounded on the consideration that – as a rule – a registered sequence of words is always to be judged as a whole entity. Therefore, any search “for documents in which single words of a slogan are found distributed within a textual entity (...) cannot lead to a statement as to the frequency of occurrence of the slogan as such.” This ruling will surely not only gain significance in relation to the ascertainment of the distinctiveness of a sign, but will also have an effect on the question of the concrete scope of protection of registered slogans.

### **First reactions of Federal Patent Court and GPTO**

Naturally, first reactions of the Federal Patent Court and the GPTO to the latest ruling of the Federal Supreme Court regarding the criteria for registration of advertising slogans did not take long to come. The Federal Patent Court's 28<sup>th</sup> Senate, for example, clearly adopted the recent turnaround of the Federal Supreme Court in its decision “*Ein schönes Stück Natur*” (“A beautiful piece of nature”), albeit coming to the conclusion that this slogan would not meet the requirements for registrability, being merely descriptive for the goods concerned (various dairy products and food). Like the 28<sup>th</sup> Senate, the Federal Patent Court's 33<sup>rd</sup> Senate, too, explicitly approved of and adopted the recent jurisdiction of the Federal Supreme Court regarding the distinctiveness of advertising slogans.

However, the decision of the 33<sup>rd</sup> Senate is surpassing the jurisdiction of the Federal Supreme Court insofar as the Senate expressly stated that shortness, succinctness, acoustic attrac-



tiveness and a certain originality *alone* are not sufficient for the recognition of distinctiveness. Short, catchy, succinct, elegant or funny and linguistically creatively formulated phrases are judged by this Senate as being stylistic means of such common use that the public would not take such a way of expression to identify an individual company. Nonetheless, the advertising slogan applied-for – “*Energie mit Esprit*” (“Energy with esprit”) – was held to contain the necessary distinctiveness without a need to be kept free for competitors. According to the Federal Patent Court’s 33<sup>rd</sup> Senate, no unambiguous sense was discernable but, instead, this slogan was inducing various different associations with the obvious intent of ambiguity. Therefore, it was neither appropriate as directly descriptive statement nor as an easily understandable general advertising statement. No sensible statement was resulting from the word sequence “*Energie mit Esprit*”, but on first appearance it was deemed “strange”, “euphorical” and “unrealistic” with regard to the relevant goods (energy made of electricity, gas, heat or steam). These forms of energy being mostly invisible to the consumer and showing no individual creativity or special design could therefore obviously not have any “esprit”. Faced with the contradictory and unclear sense of the word sequence “*Energy with Esprit*”, which was deemed as having multiple meaning and being in need of interpretation, the addressed circles of the public would view this advertising slogan as being sufficiently imaginative to an extent that it could serve as a distinguishable characteristic identifying one specific company, particularly since it obviously contained no direct descriptive statement.

Thus, the Federal Patent Court’s 33<sup>rd</sup> Senate combined two characteristics of distinctiveness which the Federal Supreme Court had formulated earlier *alternatively* and not *cumulatively*, the latter having stated: “Evidence for a qualification to distinguish the goods and services of one supplier from those



of others can be (...) shortness, a certain originality and succinctness of a word sequence which can make it a catchy and meaningful advertising slogan. Ambiguity and a resulting need of interpretation may *as well* supply evidence for sufficient distinctiveness.”

The GPTO reacted as well to the change of the High Court’s jurisdiction regarding the qualification for the registration of advertising slogans. For example, it recently registered the word sequence “*hier passiert’s!*” (“here is where it’s happening”) for i.a. “CDs, films, videos, print products, photographs, education, entertainment” or the slogan “*Sie machen es wahr*” (“you will make it come true”) for “perfumeries”.

## Summary

The Federal Supreme Court’s statement that an advertising slogan is nothing else than a wordmark consisting of several elements, of the distinctiveness of which nothing may be required that deviates from the general principles, was long overdue and is very welcome. The recent decision “*Unter Uns*” (“in private”) – where the above-said principles for the qualification to register slogans have been confirmed and underlined – shows that the decisions “*Radio von hier*” and “*Partner with the Best*” are not single case decisions but the start of a new jurisdiction.

Nevertheless, these decisions leave some questions open that will only be answered bit by bit. For example, it is not yet sufficiently clear what is meant by the Federal Supreme Court when saying “a lack of distinctiveness can therefore be assumed also with advertising slogans (...) in case of promoting and advertising statements of a general nature.” It is to be feared that this “loophole” will be used in the future by the Federal Patent Court and, in particular, by the GPTO to deny



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registration to advertising slogans – in spite of the latest decisions of the Federal Supreme Court – pointing out that these are “promoting and advertising statements of a general nature”. Likewise, the (sometimes contradictory) interpretation and application of the latest jurisdiction of the Federal Supreme Court by the different Senates of the Federal Patent Court is creating questions which have not yet been answered in a final way and which will again engage the Federal Supreme Court in the time to come. And finally, the registrations of advertising slogans will create new debates on their respective scope of protection and, consequently, on the risk of confusion.

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