

# Can you hear me now? How to make Your trademark slogan heard over the crowd

BY [MARTHA ALLARD](#)  
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Some trademark slogans are so memorable and widely advertised that they work their way into our vernacular. “Like a good neighbor, State Farm is there,” has been in use by State Farm Mutual Automobile Insurance Company since 1971 and it is hard to deny having ever heard it. Other slogans—“Can you hear me now? Good” by Cellco Partnership and “Just do it” by Nike, Inc.—are other examples.

What causes a slogan to be so successful? Generally, the best slogans are short, simple statements that are synonymous with the overall brand. As a rule of thumb, the longer the phrase, the less likely it is to function as a trademark and the more likely it functions as advertising copy. Because some slogans can enjoy such success, when your marketing team comes to you with a new slogan, it’s important to know that the slogan can and should be protected and enforced in the same way as a traditional trademark.

On the protection side, run a search for the slogan to ensure that it does not infringe the rights of a prior user. If the search results are favorable, consider applying to register the slogan with the U.S. Patent and Trademark Office. Slogans may be registered in the same way that trademarks comprising a single word may be registered, and upon registration, they enjoy the same benefits, including a legal presumption of ownership and of the exclusive right to use the slogan nationwide in connection with the goods or services, and the right to use the ® symbol.

The strength of a slogan, like all trademarks, is measured on a continuum. The strongest slogans are arbitrary or coined phrases and enjoy the broadest scope of protection, which—to put it simply—means they are the easiest to enforce. Moving down the continuum, suggestive marks comprise terms that hint at a feature or characteristic of the goods or services. Descriptive marks are weaker still but can be registered if they have acquired secondary meaning. Generic terms can never function as a trademark and are the weakest on the continuum; that is, “Sale Today” would probably never be considered a trademark at least, for example, for use with retail sales.

It is not uncommon for trademarks, especially slogans, to fall into the “descriptive” category, meaning they convey some information about the product or service. Marketing teams like to use descriptive phrases precisely because they are descriptive and help to convey information about characteristics of the product or service being advertised. Unfortunately, descriptive slogans usually also describe the goods and services of the competitor. As a practical matter, descriptive marks are entitled to a narrow scope of protection and can sometimes coexist with other similar descriptive slogans so long as there are minor differences between them. As a result, it is possible that several companies can simultaneously use slogans that are only slightly different from each other without confusion. This is the reason why so many companies can use slogans such as “America’s Freshest Ice Cream” or some variation of this without infringing another’s trademark.

Once a slogan is registered, to maintain its distinctiveness, it is necessary to police it and enforce your rights against infringers. Catchy slogans, particularly ones that are highly advertised, are easy targets for would-be infringers because many can be cleverly adapted for new uses, products and services.

Infringement in this form is often an innocent mistake and more an attempt to show off the sharp (or crude) wit of the infringer rather than a desire to push the boundaries of trademark law.

Enforcement efforts for some popular slogans range from somewhat successful to extremely successful. For example, California Milk Processor Board has successfully opposed applications to register “Got wine” and “Got Water.” The phrase is an easy target and fits nicely on bumper stickers and because of that it has literally gotten some mileage in a lot of variations, such as “Got Jesus?” “Got Algae?” “Got Moose?” “Got Fish?” and “Got Stress?” The California Milk Processor Board may tolerate some uses but at one point drew the line with an offensive use. It threatened a lawsuit against People for the Ethical Treatment of Animals for its anti-dairy campaign, “Got Pus? Milk Does” in part because it asserted there was no truth to the claim. It also objected to the domain name gotmilk.com, but the complaint was denied because the terms were deemed not confusingly similar.

In contrast, Nike aggressively enforces its mark and has had much success. For example, Nike objected to the registration of the slogan “Just Weld It” and “Just Fake It,” both for use with clothing, and “Just Chew It” for gum. While copying may be the highest form of flattery, Nike was not so flattered as to allow any of these applications, and they were abandoned because of Nike’s objection.

A distinctive, registered slogan can do more than stop infringing traditional trademarks; it can also be the basis to force the transfer of objectionable domain names. For example, The California Milk Processor Board won the transfer of the domain names gotricemilk.com, gotmilkprices.com, 1800gotmilk.net and 1855gotmilk.com. Similarly, State Farm obtained the transfer of the domain name likeagoodneighbor.com and Nike obtained the transfer of the domain names just-do-it.org and justdoit.org.

Given this, when advising your marketing team, what should you as in-house counsel do? Encourage your marketing team to create slogans that are strong trademarks, i.e., unique and non-descriptive. That way, the slogan can be registered as a trademark, it will be entitled to a broader scope of protection, and, as a result, it will be easier to stop others from using it. A registered slogan can also be the basis to object to domain names. After the slogan is wildly successful and enforceable, then ask your team: Can you hear me now?

## **About the Author**

Martha Allard is an IP attorney at Bass, Berry & Sims in Nashville. Allard’s practice involves a broad spectrum of IP issues, including trademark and copyright registration and enforcement, anti-counterfeiting, and patent matters. She can be reached at 615-742-7944 or [mallard@bassberry.com](mailto:mallard@bassberry.com).

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