Informational Perhaps, But Not a Trademark!

Recent Wal-Mart case before Trademark Trial and Appeal Board shows registering informational slogans remains a difficult endeavor

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One area of trademark law that continuously puzzles people is the tension between having a word or phrase associated with a product or service that is "informational" in that it immediately conveys to the consumer exactly what the product or service is, verses a word or phrase that may be more suggestive, arbitrary, or fanciful. The former does not acquire trademark rights and is not registerable if it is descriptive, while the latter will have an easier time acquiring trademark rights and is more likely to be registerable. Those in charge of marketing or advertising a product often tend to prefer the former because it means there is little explanation required to the customer as to what the product or service is, making marketing or advertising simpler because there is no explanation required. However, those in charge of building a brand understand that descriptive, generic, or substantially informational (when it comes to slogans) cannot acquire trademark rights, and therefore are virtually impossible to build into a protectable brand.

Why is that? Because if one company uses known terms that are descriptive or informational regarding a product or service they offer to customers, it would be unfair to grant that one company sole ownership of the ability to use those descriptive or informational words to the exclusion of their competitors offering the same or similar products or services. For example, if Starbucks attempted to claim trademark rights in "COFFEE™" for coffee, and the US Trademark Office granted a trademark registration for the word COFFEE® as a registered trademark for coffee, then competitors such as Dunkin or Caffe Nero would be unable to use the word "coffee" in any of their marketing, packaging, advertising, etc., to describe or sell…coffee. Such an outcome would obviously be impractical to say the least.

Wal-Mart's Attempt to Register Informational Slogan "Investing in American Jobs"

In the case *In re Wal-Mart Stores, Inc.*, the Trademark Trial and Appeal Board (TTAB), in a precedential decision, affirmed the US Patent and Trademark Office's (USPTO) refusal to register the slogan INVESTING IN AMERICAN JOBS. Wal-Mart applied to register the mark INVESTING IN AMERICAN JOBS in connection with various retail and online store services. The Examining Attorney refused registration stating that the slogan failed to function as a service mark because it was merely informational and commonly used as a slogan to indicate Wal-Mart's support for and sale of American-made or assembled goods. Wal-Mart requested reconsideration, which was denied, and then Wal-Mart appealed to the TTAB. The TTAB held that the slogan was not registrable as a service mark because it was merely informational and failed to indicate the source of Wal-Mart's services.

On appeal, Wal-Mart submitted evidence that it claimed demonstrated consumer recognition of INVESTING IN AMERICAN JOBS as a mark, including:

- Corporate spending related to promotion of the slogan

- Consumer attendance at Wal-Mart events featuring the slogan
- Website statistics for webpages featuring the slogan

In the Office Action refusing the registration, the Examining Attorney submitted evidence showing common usage of the slogan by a number of commercial businesses, media articles, and blogs. The Examining Attorney took the position that Wal-Mart's use of the slogan merely communicated the company's practice of investing in American businesses, and that the slogan did not function as a source indicator for consumers.

The TTAB agreed with the Examining Attorney, finding Wal-Mart's evidence may show many consumers encountered its use of the slogan, but it does not show public recognition of the slogan as a trademark. The Examining Attorney's evidence of informational usage by third parties increases Wal-Mart's burden of claiming exclusive ownership, and shows that consumers are exposed to use of the slogan to convey its informational message and therefore would not perceive Wal-Mart's use as indicating a single commercial source.

The TTAB further indicated that even if there was evidence that some consumers associated the slogan with Wal-Mart, that alone would not entitle Wal-Mart to exclusive rights in an otherwise common informational slogan. Consumers would perceive the slogan as merely an informational statement that Wal-Mart is selling certain goods made or assembled by American workers, and not that the slogan would be recognized as an indicator of source.

Trademarking Slogans and Tag Lines Requires More than Descriptive Language

This outcome appears to be consistent with other attempts in the past to register informational slogans. For example, YOU HAVE MAIL by AOL, THE BEST BEER IN AMERICA by the Boston Beer Co., DRIVE SAFELY by Volvo Cars of N. America, and PROUDLY MADE IN USA by Remington, were all refused registration based on similar legal reasoning, that they are merely informational and/or common laudatory phrases that numerous companies in industry use to describe their goods or services.

A takeaway is that creating quality trademarks is not as easy as it may seem. The best tag lines or slogans require creativity that goes beyond merely informing the consumer about the product or service.

For more information, please contact **Sean Detweiler**.