

Lagunalaw Updates

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Can An Advertising Slogan, Jingle or Tagline Be Protected, and, If So, How?

Many businesses know that their names and logos can be protected as trademarks, but they often are not so certain about protection of secondary references they use, such as slogans, jingles, taglines, or the like. Thus, the issue discussed here is whether such slogans can be protected, and if they can, how can they be protected.

The good news is that slogans and similar secondary references can, in many circumstances, be protected, primarily under trademark law, although generally not under copyright law or patent law. There are numerous instances in which the slogan or jingle of one company has been protected against literal copying or even a similar slogan which brings to mind the first one. Such mere “association” may itself be stopped within certain limits.

More good news is that it is not necessary to “register” such slogans to protect them, or even actually to use them first. That’s right, a fairly recent change in the federal trademark laws allows you to file an application to register a slogan (or other trademark) based on your “intent” to use it, even though you haven’t used it yet. Your intended slogan will then normally be protected, as against use of similar one by anyone anywhere in the United States, if such use began *after* the filing date of your application. Without such an “intent to use” application – which is not available at the state level yet—ownership normally goes to the first person to use a particular slogan.

Nonetheless, registration, whether in the United States Patent and Trademark Office, or in the state of California or another state, is extremely helpful when enforcing your rights. However, in most *for-foreign* countries, use alone will create no rights, and registration is essential to receive any protection. The registration process will be the subject of a future article.

As to how such slogans are protected, both California and federal law provide appropriate means of protection. Remedies for usurping someone else’s slogan, by use of an identical or similar slogan (usually called

‘infringement,’), range from an immediate injunction stopping the use of the infringing slogan, to an award of damages, if any, caused by such infringement. The profits made by the infringing company can also be awarded under appropriate circumstances. In one major case, a large consumer food manufacturer was ordered to pay about \$46 million dollars for using another’s trademark as part of its own advertising slogan.

Indeed, the available relief also includes an award of up to three times the actual damages if the infringement is a deliberate or “willful” infringement or was done in bad faith. More extreme remedies can include an award of many times the actual damages, to “punish” the copy cat, and seizure, as soon as a lawsuit is filed, of all materials which use the offending slogan. An even more drastic option may include actual recall of the products using the infringing slogan or an order to send out written notices, with an offer to return the products for a refund, to customers who purchased the offending products.

Although products are the usual problem, services businesses generally have the same rights. For example, a beer manufacturer using the slogan, “Where there’s Life, there’s Bud” had protectable rights when an exterminating company adopted a similar slogan, “Where there’s Life, there’s Bugs.” This is an example of a “Products” slogan. An example of a service slogan which has been protected more than once is the well-known “The Greatest Show on Earth” jingle used by the Ringling Bros-Barnum & Bailey Circus. The circus primarily provides entertainment services, just as, for example, a musical group does, rather than selling products, although these days, almost everyone has moved into “merchandising” products such as T-shirts, stickers, buttons, and similar objects using well-known slogans and trademarks.

In most cases, the right to protection requires ownership of a valid slogan which is either immediately distinctive or which, over time or due to substantial advertising or publicity, has become associated with your business. The second requirement is that the use of the other slogan must be likely to cause confusing in the marketplace. This can mean that potential customers will mistakenly believe that your company is the actual source of the other company’s products or services, or that there is some type of loose affiliation or relationship between the two companies or their products, or that one company has licensed or given its consent to the other’s use of a similar slogan.

However, there is a very notable exception to the “confusion” requirement, where a trademark or slogan can be protected even against use by another company in a completely unrelated business where there is no “likelihood of confusion.” This exception is called “dilution.” Dilution occurs even in the absence of any competition or likelihood of confusion, such as where suits of POLAROID for unrelated products, like POLAROID cars, or BUIC birth control pills, might reduce the identity or strength of the trademark by its owner or bring it into disrepute. About 27 states currently have a “dilution” law, including California, New York and Florida. Those states laws are now also helped by a federal dilution law which finally became effective on January 16, 1996. Under this federal law, if your slogan or jingle is “famous”—whatever that means, which is the subject of considerable debate in the courts—then it will be protected against dilution under certain conditions. Dilution also applies to famous trademarks.

Using the previous example of a fairly well-known slogan, THE GREATEST SHOW ON EARTH, its owner, Ringling Bros., recently sued the state of Utah in federal court in Virginia, for using the similar slogan, THE GREATEST SNOW ON EARTH, to promote Utah’s obvious natural attraction and encourage visitors to come to its ski resorts. Ringling Bros. Had previously registered its slogan in the United States Patent and Trademark Office, but had not been able to stop Utah from also registering its similar slogan. The court ruled that under the new federal dilution law, the owner of a famous slogan could stop the use not only of an identical slogan, but also use of a slogan which was similar, but not identical. In another case, however, a court in New York refused to stop, at least on a preliminary basis, the use of THE GREATEST BAR ON EARTH by a bar, finding neither dilution nor likelihood of confusion under the particular facts of that case. Perhaps fortunately for Laguna Beach, no one has yet adopted a slogan like THE GREATEST PAGEANT ON EARTH.

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