

Blog Post

Slogans As Marks: When Does a Slogan Function as a Mark

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Slogans can, but do not always, function as trademarks. To be sure, the United States Patent and Trademark Office (“USPTO”) frequently allows slogans such as JUST DO IT! or QUALITY THROUGH CRAFTSMANSHIP, among many others, to be registered as trademarks. However, the USPTO’s recent trend has been to deny registration to slogans on the ground they fail to function as a mark, because they are informational. On October 29, 2020, the USPTO Trademark Trial and Appeal Board (the “Board” or “TTAB”) issued a precedential decision on this issue, denying registration of a term it deemed to be “a widely used concept or sentiment.” *In re Texas With Love, LLC*, Serial No. 87/793,802 (October 29, 2020).

Applicant Texas With Love, LLC applied to register the trademark TEXAS LOVE for hats and shirts. The application included the requisite specimens of trademark use, in this case, the applicant’s online store displaying the trademark TEXAS LOVE in close association with the goods.

Notwithstanding Applicant’s evidence of trademark use, the Examining Attorney rejected the application, finding that TEXAS LOVE failed to function as a trademark because it is a “commonplace term, message, or expression widely used by a variety of sources that merely conveys an ordinary, familiar, well-recognized concept or sentiment,” specifically,

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support for, or affiliation or affinity with the State of Texas. In support of this finding, the Examining Attorney submitted abundant evidence that third parties use the term TEXAS LOVE printed on their apparel.

The Applicant appealed and the Board affirmed the rejection.

A. Failure to Function

The Board began by noting that “[t]he Trade-Mark Act is not an act to register words but to register trademarks. Before there can be registrability, there must be a trademark (or a service mark) and, unless words have been so used, they cannot qualify for registration...Not every word, name, phrase, symbol or design, or combination thereof which appears on a product functions as a trademark.” Indeed, “[m]ere intent that a phrase function as a trademark is not enough in and of itself to make it a trademark.” Thus, the key question the Board considered was whether the relevant public, *i.e.*, purchasers or potential purchasers of the Applicant’s goods, would view the term TEXAS LOVE as identifying the source or origin of the Applicant’s goods or whether they would perceive it to be merely a sentiment.

Although it was accepted that the Applicant’s own specimens showed trademark use of TEXAS LOVE, the Applicant’s use was not dispositive in how the **public** would perceive the term. The Board considered the many examples in the record of third party using the term ornamentally on the front of shirts. These examples reflected use of the phrase in a manner that would only be perceived by consumers as conveying support for, or affinity or affiliation with, the State of Texas. “When confronted with so many similar uses of a term to convey essentially the same concept or sentiment, consumers will perceive the term as a common message rather than a source identifier.” Widespread use of a phrase may be enough to render it incapable of serving as a source indicator.

In short, the evidence showed that the phrase TEXAS LOVE is too commonly used in connection with a wide variety of goods that typically carry such messages for it to be perceived as a trade mark. The Board reasoned that the Applicant should not be able to deny potential competitors (who according to the record also use the phrase) the right to use it freely.

B. Equal Protection

The Applicant also argued that denial of registration of TEXAS LOVE violated the U.S. Constitution's equal protection clause because the USPTO approved identical marks about other states, *e.g.*, FLORIDA LOVE, CALIFORNIA LOVE, etc. Applicant thus maintained that the USPTO treated Texas citizens like itself differently from those of Florida or California in "contextually identical" situations. The Board rejected that argument as lacking both factual and legal support. The Applicant provided no evidence that the USPTO treats citizens of Texas differently than those of other states. There was no evidence as to how the other marks were used, whether there was third-party use on the same or similar goods, what meanings were conveyed by the marks, or how extensively the marks were used."

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In re Texas With Love clarifies what may have been an ambiguity concerning the registrability of slogans. If a trademark applicant creates and applies a slogan that conveys an original, never (or rarely)-before-used sentiment, it may be registered, as Nike did with JUST DO IT! or McDonalds did with I'M LOVIN' IT. However, if the USPTO find evidence that the trademark applicant is not the first one to use that slogan, or that there is widespread use by others, registration will be difficult to obtain.

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