

COMMON SLOGANS IN TRADEMARK LAW

Analysis of Common Slogans in Trademark Law

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Introduction

Companies typically use a catchy slogan to get the consumer's attention and make the brand stick in their head. You may be familiar with slogans such as "Where's the beef?", "CLAP ON, CLAP OFF", "I've fallen and I can't get up", and "you sank my Battleship". All of these slogans have an association with a brand, and the owner of that brand will typically register the slogan with the United States Patent and Trademark Office so that no other brand can use the slogan, protecting the promise of quality that the brand sets forth. We will analyze these four slogans and determine if they are still owned by their respective brands, or if the trademark has expired, opening the slogan to other brands.

Part One: "Where's the beef?"

When the average consumer hears the slogan, "Where's the Beef?", their brain immediately associates it with the fast food restaurant chain, Wendy's. The brand used the slogan in many commercials throughout the 1980s, and the marketing strategy has clearly worked. Most people would instantly be able to recognize the slogan and picture the food that Wendy's sells.

According to the U.S. Patent and Trademark Office (1986), the mark for the slogan was filed on April 13, 1984. This trademark was owned by Wendy's International Inc, and the Attorney of Record was Jennifer N. Fuller. Over two years later, on July 29, 1986, the mark was published for opposition. On October 21 of that same year, the mark was registered with the serial number of 73475398, and the registration number of 1414006. This filing allowed for Wendy's to merchandise the slogan, through t-shirts, office supplies, pins/buttons, novelty cups,

and many other styles of merchandise, without fear of other companies using the slogan for their own merchandise. Both the original and current filing basis code is 1A, meaning Wendy's had to prove that the mark was used, not just an intent to use. As of May 26, 2017, the mark was declared dead. It was, however, renewed for the second time on February 9, 2017. While the merchandising mark was cancelled, Wendy's still owns the rights to the slogan.

Part Two: "CLAP ON, CLAP OFF"

If you were alive in the 80's you probably recognize this slogan: "CLAP ON, CLAP OFF". This, of course, is referring to the commercial for The Clapper, a device that detects the sound of a clap, and turns on/off your devices or lights connected to it. This device is still sold today, though the commercials are hardly on the air anymore. Even though this was popular in the 80's, there wasn't a registered trademark for the slogan until October 5, 2018. The trademark, registered by Joseph Enterprises, Inc., describes the jingle for The Clapper. The mark specifies that it can only be applied to the words "CLAP ON, CLAP OFF, CLAP ON, CLAP OFF, THE CLAPPER" and only if sung to the notes B3, E4, E4, C#4, B3, E4, E4, C#4, B3, A3, A3.

On April 24, 2020, the "CLAP ON, CLAP OFF" slogan trademark was abandoned, and the status was moved to 'dead'. Any client that wants to use this slogan, should have no problem getting it registered with the office, since it is currently not owned by any party. If this mark was still alive, the client would only be able to use it if he did not place it with the corresponding musical notes mentioned above. If the client started using this song before the trademark was filed, but still used it after the filing, the client would be legally in the wrong. This is because the client is not the person that registered the trademark, even if he used it first.

Part Three: “I’ve Fallen and I Can’t Get Up”

The slogan “I’ve fallen and I can’t get up” is associated by the emergency medical response device called Life Alert. This trademark was filed initially in 1990, by Emergency Response People, Inc. It is now considered dead, as of March 12, 1999. The mark was then picked up by Life Alert Emergency Response, Inc. in 2006. The trademark is still active today, so the local business that wants to use the slogan for their bathtub company would be legally in the wrong. This slogan can only be used by Life Alert Emergency Response, Inc., for the device defined in the trademark. Any other company using this slogan for any purpose can be sued for trademark infringement.

Part Four: “You Sank My Battleship”

Most would recognize the phrase “You sank my Battleship” and associate it with the popular Hasbro game, Battleship. Those people may assume that the slogan is trademarked and therefore cannot be used. However, after searching for the slogan on the US Patent and Trademark Office’s Trademark Electronic Search System (TESS), no such trademark registration exists. This means it is safe to assume that the slogan can be used by any company that wishes to do so. They could also theoretically register the slogan as their own, despite it being popularly associated with the Battleship game.

Discussion

The purpose of a trademark is to unmistakably identify a certain brand or service to the consumer. That brand or service must be able to control their brand image through the use of trademarks and specific branding. This control, however, is put in limbo when it comes to retailers in the online realm. *MultiTime Machine, Inc., v. Amazon.com, Inc.* (2015)

is a perfect example of this. MultiTime Machine (MTM) sells high end watches direct to consumer, or through very limited retailers. Amazon is not one of the approved retailers that can sell the watches. If a customer goes to Amazon.com and tries to search for an MTM watch, that customer will be directed to multiple watches from MTM's competitors. MTM argued that this was an infringement on the company's copyrights, since Amazon is directing sales away from MTM, to their competitors. They also argue that this is a clear attempt at confusing the customer into thinking Amazon sells MTM watches. The court ruled in favor of Amazon, stating that it Amazon makes it very clear that the watches sold on the website are not from MTM. The listings clearly state where the watches come from, and confusion of the customer is possible, but unlikely. The court determined that customer confusion must be *likely*, not just possible.

A similar problem occurred in the Tiffany (NJ) v. eBay case (2010). Tiffany, one of the world's largest manufacturers of high end jewelry in the world, found that users on the eBay website were selling counterfeit Tiffany jewelry. When a listing is found as counterfeit on the site, eBay takes swift action to remove it. Due to this, the court ruled that Tiffany must be responsible to police their own trademark rights, and it is not eBay's responsibility to do so.

References

Wendy's International, Inc (1986). *Serial No. 73475398*. Location: U.S. Patent and Trademark Office.

Joseph Enterprises, Inc (2018). *Serial No. 88145290*. Location: U.S. Patent and Trademark Office.

Life Alert Emergency Response, Inc (2006). *Serial No. 78911769*. Location: U.S. Patent and Trademark Office.

MULTITIME MACHINE, INC. V. AMAZON.COM, INC. 804 F. 3d 930 (9th Cir. 2015)

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