



Registration and Protection of Slogan Trademarks

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As we all know, a good advertising slogan is catchy, easy to remember, and highly recognizable. It is also a powerful weapon to express the proposition or pursuit of an enterprise in terms of its business philosophy and increase consumer engagement. For example, De Beers' "A diamond is forever", Li Ning's "Anything is possible" and so on. These classic advertising slogans highly familiar to consumers have been successfully registered as trademarks and they have been playing an important role in promotion of these companies' brands and increase of their popularity. Therefore, if a company wishes to protect its original advertising slogan from being used by others, in addition to the registration as copyrighted works for protection, it is also a good choice to register the advertising slogan as a trademark. However, in practice, ordinary advertising slogans cannot be registered as trademarks. So, what kind of advertising slogans can be registered and protected as trademarks?

The author has briefly summarized and analyzed the registration of domestic advertising slogan marks, based on relevant administrative and judicial precedents, hoping to provide some useful ideas for the registration and protection of a company's advertising slogan marks.

I.Registration and Rejection of Advertising Slogans Marks

Articles 8 and 9 of current *Trademark Law* clearly stipulate that a trademark is a sign that distinguishes one's own goods from others' goods, and should have distinctive characters. In the second part of the current *Trademark Examination Guidelines* on the examination of the distinctiveness of trademarks, it is also pointed out that phrases or sentences that express the characteristics of goods or services, and common advertising and promotion terms should be deemed as lacking distinctiveness and belong to the circumstance that a mark cannot be registered as a trademark stipulated in Article 11.1.(3) of the *Trademark Law*. However, the combination with other elements and the mark is overall distinctive will be an exception.

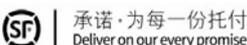
It can be seen that whether a company's advertising slogan mark can be registered as a trademark mainly depends on whether it violates the relevant provisions of the *Trademark Law* and whether it has distinctive characters so as to distinguish the origin of goods or services.

1.Precedent Registrations Published on the Trademark Office's ("TMO") Database

Following a search on the TMO's online database, the author has revealed many classic advertising slogans that everyone is very familiar with, such as "GREE 格力 让世界爱上中国造 (GREE, Made in China, Loved by the World) and Device", "我就喜欢 I'm lovin' it" and so on. As shown in Table 1, we can see that amongst the applicants who have successfully registered their advertising slogan trademarks, there are many Fortune 500 companies and

multinational companies. However, no matter whether it is a Chinese company or a foreign company, if the advertising slogan is of high level of originality or has obtained distinctiveness through intensive promotion and use, it may be registered as a trademark and protected by the trademark law.

Table 1

No.	Trademark Registration Nos.	Registrant	Trademark	In Real Promotion and Use
1.	18230365	GREE Electric Appliances, Inc. of Zhuhai	 <p>(GREE / Made in China, Loved by the World)</p>	 <p>(GREE / Made in China, Loved by the World)</p>
2.	4333019	The Beijing News	 <p>(The Beijing News / Responsible for reporting all)</p>	 <p>(Responsible for reporting all / The Beijing News)</p>
3.	28593405	Shenzhen SF Tyson Holding (Group) Co., Ltd.		
4.	8569282	Alibaba Group Holding Co., Ltd.	 <p>(To make it easy to do business anywhere)</p>	
5.	34181130	Beijing Wu Xi Tang Culture Co., Ltd.	<p>你好历史</p> <p>(Hi History)</p>	

6.	5400099	China Mobile Limited	<p>我的地盘听我的</p> <p>(My Zone, My Decision)</p>	 <p>(M-Zone / My Zone, My Decision)</p>
7.	5275831	Li Ning Sports (Shanghai) Co., Ltd.	 <p>一切皆有可能</p> <p>(Anything is possible)</p>	 <p>一切皆有可能</p> <p>(Anything is possible)</p>
8.	13974136	Bridgestone Corporation	 <p>真挚用心 为你前行</p> <p>(Sincere for your journey)</p>	 <p>普利司通轮胎</p> <p>真挚用心 为你前行</p> <p>(BRIDGESTONE Tires / Sincere for your journey)</p>
9.	40550181	TOTO Ltd.	<p>智臻致净</p> <p>(To the Best Smart and Clean)</p>	 <p>(To the Best Smart and Clean / To the best, to the clean)</p>
10.	13491554	WM. Wrigley Jr. Company	<p>益达关爱牙齿更关心你</p> <p>(Extra, care about your teeth, care about you more)</p>	 <p>(Extra, care about your teeth, care about you more)</p>
11.	3931639	General Electric Company	<p>GE 梦想启动未来</p> <p>(GE, dreams start the future)</p>	 <p>GE 梦想启动未来</p> <p>(GE, dreams start the future)</p>
12.	30547285	The Coca-Cola Company	 <p>酷爽不变 轻盈有加</p>	 <p>酷爽不变 轻盈有加</p>

			(Sprite / fiber+ / Same coolness, light plus)	(Sprite / fiber+ / Same coolness, light plus)
13.	19012692	McDonald's Corporation	 (I'm lovin' it)	 (I'm lovin' it)
14.	6050544	De Beers UK Limited	钻石恒久远 一颗永流传 (A diamond is forever)	 (FOREVERMARK / A diamond is forever)
15.	20655825		 (FOREVERMARK / A diamond is forever)	
16.	18485376	Koninklijke Douwe Egberts B.V.	 (Maxwell House / Good to the last drop)	 (Maxwell House / Good to the last drop)

2. Precedent Rejections Published on the TMO's Database

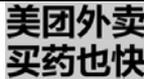
In the public information on the TMO's online database, the author has also revealed many refused precedent applications. As shown in Table 2 below, for example, marks such as "Made in China, Loved by the World" without "GREE", "Responsible for reporting all" without "The Beijing News", and "Care about your teeth, care about you more" without "EXTRA", etc., were not approved for registration due to the reason that the slogans overall are likely to be regarded as ordinary advertising phrases by consumers, and thus lack the inherent distinctiveness. In addition, amongst the rejected marks, such as "WeChat Pay Cashless Day", which includes the distinctive word "WeChat", the trademark is used as an entirety with respect to the designated services, although it cannot be regarded as directly indicating the characteristics of the designated services, it is not likely to be recognized as a mark that can distinguish the origin of services. As such, it will also be deemed as lack of inherent distinctiveness that a trademark should have and thus has been rejected.

Table 2

No.	Trademark Application Nos.	Applicant	Trademark
1.	18230296	GREE Electric Appliances, Inc. of Zhuhai	 <p>(Made in China, Loved by the World)</p>
2.	7695087		<p>好变频 格力造</p> <p>(Good inverter air conditioner, made by GREE)</p>
3.	41990791		<p>万物互联 一呼百应</p> <p>(Everything is connected, all responsive to a single call)</p>
4.	42037960		<p>格力自主制造让家电 万物互联 一呼百应</p> <p>(GREE autonomous manufacturing, makes the electric appliances)</p> <p>Everything is connected, all responsive to a single call)</p>
5.	4333018	The Beijing News	 <p>(Responsible for reporting all)</p>
6.	23376567	Shenzhen SF Tyson Holding (Group) Co., Ltd.	<p>承诺, 为每一份托付</p> <p>(Deliver on our every promise)</p>
7.	28973396		<p>顺丰寄无忧</p> <p>(SF delivery without any worries)</p>



8.	10027784	WM. Wrigley Jr. Company	关爱牙齿 更关心你 (Care about your teeth, care about you more)
9.	6163957	Alibaba Group Holding Co., Ltd.	让天下没有难做的生意 (To make it easy to do business anywhere)
10.	3684962	Kraft Foods Holdings, Inc.	滴滴香浓, 意犹未尽 (Good to the last drop)
11.	27709482	Daimler AG	心所向 驰以恒 (Lead to heart, move to persistency)
12.	37691116	Beijing San Kuai Technology Co., Ltd.	美团配送 分钟必达 (Meituan delivery, always on time)
13.	23456793	Tencent Technology (Shenzhen) Co., Ltd.	微信支付无现金日 (WeChat Pay, Cashless Day)
14.	29917838	Markor International Home Furnishings Co., Ltd.	美时美克尽在美家 (Beatiful time, beautiful moment, all in Markor home)
15.	36565021	Zhou Liu Fu Jewellery Co., Ltd.	用心承诺 每时每刻 (Promise with heart, at every moment)
16.	34324835	Jaguar Land Rover Limited	NEVER STOP DISCOVERING
17.	30451026	Daimler AG	BEST NEVER REST
18.	26207016	Franklin Covey Co.	高效能人士的七个习惯 (The 7 Habits of Highly

			Effective People)
19.	43877728	Beijing San Kuai Technology Co., Ltd.	 (Meituan delivery, fast for medicines as well)
20.	21547782	Beijing Jingdong 360 Degree Electric Commerce Co., Ltd.	 (Nov. 11 this year / Good things with low price at JD.com / Nov. 1-12)

II. Main Refusals against Advertising Slogan Marks

1. Main Refusal Grounds

Based on the administrative and judicial precedents in recent years, currently the advertising slogan mark applications are mainly rejected pursuant to Article 11.1.(3) (other marks devoid of distinctive characters shall not be registered as trademarks) and Article 10.1.(7) (marks that may mislead consumers with respect to the characteristics of the product's function, effect, use, etc.) of the *Trademark Law*. Further, Article 11.1.(3) of the *Trademark Law* is the main applicable grounds in the refusals. Details are provided as below.

2. Analysis on Refusal Appeals

The author has searched the Trademark Review and Adjudication Decisions published on the TMO's online database, and selected some of the refusal appeal cases listed below.

Table 3

No.	Trademark	Class	Decision Nos.	Decision
Whether the application is in violation of Article 11.1.(3) of the <i>Trademark Law</i>				
1.	美团配送 分钟必达 (Meituan delivery, always on time) No. 37691116	38	Shang Ping Zi [2020] No. 000259287	Violate
2.	格力自主制造让家电 万物互联 一呼百应 (GREE autonomous manufacturing, makes the	7	Shang Ping Zi [2020] No. 0000315736	Violate

	<p>electric appliances</p> <p>All connected, all responsive to a single call)</p> <p>No. 41998392</p>			
3.	 <p>(This! Is Street Dance)</p> <p>No. 42372133</p>	24	Shang Ping Zi [2020] No. 0000291116	Violate
4.	<p>心所向驰以恒</p> <p>(Lead to heart, move to persistency)</p> <p>No. 27709482</p>	12 , 37	Shang Ping Zi [2019] No. 0000062862	Violate
5.	<p>微信支付无现金日</p> <p>(WeChat Pay, Cashless Day)</p> <p>No. 23456793</p>	35	Shang Ping Zi [2018] No. 0000120430	Violate
6.	<p>Naturally different, naturally free</p> <p>No. 46223043</p>	29	Shang Ping Zi [2021] No. 0000078059	Violate
7.	<p>每天一杯幸运咖 幸运陪伴你我他</p> <p>(Lucky coffee every day, good luck around you and me)</p> <p>No. 45894494</p>	32	Shang Ping Zi [2021] No. 0000072033	Violate
8.	<p>新生塑颜奇迹赋能</p> <p>(Newborn shaping miracle empowerment)</p> <p>No. 40274331</p>	3	Shang Ping Zi [2020] No. 0000171766	Violate
9.	<p>高效能人士的七个习惯</p> <p>(The 7 Habits of Highly Effective People)</p> <p>No. 26207016</p>	9 , 16 , 41	Shang Ping Zi [2019] No. 0000005358	Violate

10.	<p>快手，发现真实有趣的世界 (Kuai Shou, find a real and interesting world) No. 23410193</p>	45	Shang Ping Zi [2018] No. 0000210861	Violate
11.	<p>知识星光 照亮未来 (Light of knowledge, brighten the future) No. 46068551</p>	16	Shang Ping Zi [2021] No. 0000058218	Violate
12.	<p>纵享丝滑 (Enjoy the smoothness) No. 36398562</p>	30	Shang Ping Zi [2020] No. 0000047236	Violate
13.	<p> (This! is Street Dance) No. 29384381</p>	41	Shang Ping Zi [2020] No. 0000012176	Partially Violate
14.	<p> (This! is Street Dance) No. 29364059</p>	41	Shang Ping Zi [2019] No. 0000186206	NO
15.	<p>I LOVE COCO IR. No. 1303973</p>	3, 9, 14, 16, 18, 25	Shang Ping Zi [2018] No. 0000028137	NO
16.	<p> 简单是原始的，不可替代 Simple is original, no substitute No. 41235333</p>	30	Shang Ping Zi [2021] No. 0000069414	NO
<p>Whether the application is in violation of Article 10.1.(7) and Article 11.1.(3) of the Trademark Law</p>				
17.	<p> (Nov. 11 this year / Good things with low price at JD.com / Nov. 1-12) No. 21547782</p>	35	Shang Ping Zi [2018] No. 0000065167	Violate

18.	<p>肠动力常年轻</p> <p>(Bowel power, always young)</p> <p>No. 21762015</p> <p>No. 21762025</p> <p>No. 21761551</p>	29	Shang Ping Zi [2018] No. 0000046627	Violate
		32	Shang Ping Zi [2018] No. 0000046625	
		5	Shang Ping Zi [2018] No. 0000046629	

A.Regarding Article 11.1.(3) of the *Trademark Law*

As mentioned in Table 3, based on the cases published in recent years, once an advertising slogan mark application is rejected due to lack of distinctiveness, it will be very difficult to overcome the refusal in the appeal. Most of the cases in Table 3 were determined to be easily recognized by consumers as ordinary advertising phrases or non-original advertising phrases, which were difficult to distinguish the origin of goods (or services), and lacked the distinctive characters of trademarks. Moreover, in a number of cases such as No. 37699116 “美团配送 分钟必达 (Meituan delivery, always on time)” and No. 41998392 “**万物互联 一呼百应** (GREE autonomous manufacturing, makes the electric appliances, all connected, all responsive to a single call), etc., the applicants have submitted evidence of use in relation to the relevant applied-for marks. However, the applications were all determined as “the evidence submitted by the applicant is not sufficient to prove that the applied-for mark has acquired the distinctiveness of a trademark through promotion and use in relation to its designated goods or services”.

Of course, if the submitted evidence is sufficient, there will be exceptions. For example, case Nos. 13 and 14 in Table 3 are the two identical trademarks that Youku Internet Technology (Beijing) Co., Ltd. (“Youku”) filed in Class 41. Although they were both filed in Class 41, the results were different due to the different designated services. In both cases, Youku submitted program introduction, related evidence of promotion and use, and related media reports for “This! Is Street Dance”. The China National Intellectual Property Administration (“CNIPA”) concluded after review that the evidence submitted by the applicant can prove that “This! Is Street Dance” program has already achieved certain reputation in the entertainment industry, and it is believed that based on the promotion and use of the variety show of the same name, the applied-for trademark has acquired a higher level of recognition and distinctiveness. Therefore, the CNIPA finally decided that No. 29364059 with respect to entertainment services and TV entertainment programs in Class 41, can function to distinguish the origin of services and thus has acquired the distinctiveness that a trademark should have, and all its designated services are preliminarily approved for registration. However, with regards to No. 29384381 filed by the same applicant in Class 41, the evidence submitted by the applicant is all evidence of promotion



and use in relation to the applied-for trademark in entertainment service industry. It cannot prove that the applied-for trademark has been used with respect to “lending library; organization of lotteries” and acquired the distinctiveness to distinguish the origin of services. As such, the application with respect to the above two services was rejected and the application with respect to the remaining services, i.e. “organization of shows [impresario services]; production of shows; etc.” has been preliminarily approved for registration. Based on the above, it is noted that when an applicant submits evidence of use, it should also pay attention to whether the evidence can fully prove that the applied-for mark has obtained certain reputation with respect to the relevant goods or services and whether it is easy to be recognized by consumers as a trademark.

The author has also found that in this type of refusal appeal cases, most applicants will also attempt to persuade the examiner that the trademark application is distinctive by submitting precedent registrations of the same or similar trademarks. For example, in the trademark refusal appeal for No. 27709482 “心所向驰以恒 (Lead to heart, move to persistency)” (Class 12 and Class 37), the applicant submitted the registration of the same trademark (No. 20952947) registered in Class 35, claiming that the precedent registration was not rejected due to lack of distinctiveness. However, through examination, the CNIPA held that the trademark review should follow the principle of review case by case, and the circumstance described by the applicant was different from this case, and cannot be referenced or be the basis for the preliminary approval for the trademark application in this case. Therefore, it can be seen that in China, in the case of refusal appeal, listing the same or similar trademark registration precedents is not a very effective way to overcome the refusal based on the grounds of lack of distinctiveness. The CNIPA will make a comprehensive decision on whether the applied-for mark is inherently distinctive or not with respect to its designated goods or services, based on the principle of review case by case.

B.Regarding Article 10.1.(7) of the Trademark Law

Article 10.1.(7) of the *Trademark Law* stipulates that if a mark is deceptive and is likely to mislead the public with respect to the quality and other characteristics or the place of origin of the goods, it shall not be registered as a trademark. Therefore, if an advertising slogan includes words that are likely to mislead the relevant public, the CNIPA will also cite Article 10.1.(7) of the *Trademark Law* to reject the trademark application.



For example, No. 17 in the above Table 3, i.e. No. 21547782 “ (Nov. 11 this year / Good things with low price at JD.com / Nov. 1-12)”, in the refusal appeal of the application, although the applicant emphasized that the trademark includes “京东 (JD.com)” which is the trade name of the applicant, the applied-for mark as an entirety can function to distinguish the origin of service. The applicant also submitted a large amount of evidence of promotion and use. However, the CNIPA held that “好物低价 (good things with low price)” in the applied-for trademark is likely to mislead the relevant public when used on the designated services, and thus it is in violation of the prohibitive provisions in Article 10.1.(7) of the *Trademark Law*.

Another example is No. 18 in the above Table 3, i.e. the refusal appeal of trademark application No. 21762015 “**肠动力常年轻**” (Bowel power, always young)”. In this case, the CNIPA held that the trademark application is only consisted of “**肠动力常年轻**” which means “bowel power is always young”, which is likely to be understood by consumers as “to provide bowel power to keep young all year round”. When used in association with the designated goods, the mark is likely to mislead consumers with respect to the function, effects and use of the goods, and then mislead the consumers to purchase. As such, the applied-for mark belongs to the circumstance prescribed in Article 10.1.(7) of the *Trademark Law*, and shall not be used as trademarks.

Based on the above, if an advertising slogan is used in association with its designated goods or services and is likely to mislead the relevant public with respect to the quality and other characteristics or the place of origin of the goods, even if the trademark includes a distinctive element with high reputation, or even if a large amount of evidence of use can be provided, it is still difficult to overcome the grounds for refusal based on Article 10.1.(7) for registration. Therefore, in the selection of advertising slogans, we recommend that the applicant try the best to avoid vocabulary or expressions that are likely to mislead the relevant public.

3. Analysis on the Judicial Litigation Cases

With regards to the registration and protection of advertising slogans, how to determine in the judicial process? The author also used IP House database, and has searched some judicial cases in order to extract opinions from current judicial practice and summarize the judgment trends and ideas of the court in the registration of advertising slogans.

Table 4

No.	Trademark	Application No.	Final instance judgement No.	Date of Judgement	conclusion
Whether the application is in violation of Article 11.1.(3) of the <i>Trademark Law</i>					
1	喜迎美好生活 (Happily welcome the beautiful life)	34102295	(2020) Jing Administrative Final No. 6312	2021/01/28	Violate
2	未来，不等待 (Future, don't wait)	16352526	(2019) Jing Administrative Final No. 1206	2019/05/06	Violate
3	HOTELS THAT DEFINE THE DESTINATION	IR No. 1275837	(2018) Jing Administrative Final No. 5443	2020/01/20	Violate

4	我要学习去 (I want to go study)	20689817	(2018) Jing Administrative Final No. 5280	2018/11/28	Violate
5	UNLEASH THE CAFFEINE FREE BEAST!	15588484	(2019) Jing Administrative Final No. 2789	2020/03/09	Violate
6		31328081	(2020) Jing Administrative Final No. 5689	2020/12/23	Violate
7	你好历史 (Hi History)	34181130	(2020) Jing Administrative Final No. 2566	2020/07/29	NO
8	海外有家 (A home overseas)	18097950	(2018) Jing Administrative Final No. 99	2018/04/04	NO
9	等 一 個 人 咖 啡 Café.Waiting.Love	15243824	(2016) Jing Administrative Final No. 5103	2017/01/11	NO
Whether the application is in violation of Article 10.1.(7) of the Trademark Law					
10	怕上火喝加多宝 (Keep the inflammation away, drink Jia Duo Bao)	11064135	(2018) Jing Administrative Final No. 1041	2018/5/10	Violate

Based on the first 9 cases in Table 4, the court and the CNIPA are basically consistent in their determination standards with respect to the Article 11.1.(3) of the *Trademark Law*, but whether the disputed trademark is a commonly used term or direct descriptive reference with respect to the designated goods or services, it will be more carefully reviewed by the court. With regards to the judgment of Article 10.1.(7) of the *Trademark Law*, due to the limited number of cases, only the example of “怕上火喝加多宝 (Keep the inflammation away, drink Jia Duo Bao)” has been cited herein. In this case, the second instance court also upheld the first instance judgment. Generally, once an advertising slogan trademark application is rejected due to lack of distinctiveness or being misleading, it will be very difficult to get such a decision overruled in the administrative litigation stage. Specifically, the court’s analysis and judgment may be roughly summarized into the following four points.

A.If the submitted evidence of use cannot prove that the applied-for mark has acquired inherent distinctiveness with respect to the relevant goods or services, the application will be determined in violation of Article 11.1.(3) of the *Trademark Law*

In the refusal appeal of “喜迎美好生活 (Welcome to the Good Life)” filed by Hefei Zhong Sheng Fu Net Technology Co., Ltd. (“Zhong Sheng Fu”)ⁱ, although Zhong Sheng Fu submitted evidence of use for the disputed trademark on its WeChat official account, the court held that the evidence is not sufficient to reach the extent to enable an advertising slogan mark which is inherently indistinctive acquire distinctiveness through its use. As such, the court did not support the appellant’s claim. However, in the cases of ZTE Corporation’s “未来, 不等待 (Future, Don’t Wait)”ⁱⁱ, Sheraton International IP, LLC’s “HOTELS THAT DEFINE THE DESTINATION”ⁱⁱⁱ, Kuai Bu (Xiamen) Internet Technology Co., Ltd.’s “我要学习去 (I want to go study)”^{iv}, etc., the court of second instance also held the same opinion that “the evidence submitted by the appellant is not sufficient to prove that the disputed trademark has a high reputation through its promotion and use with respect to the designated goods or services so that the relevant public could recognize it as a mark indicating the origin of the goods or services and thus has acquired distinctiveness.

Based on the above, we are of the view that the court’s judgment standard is basically the same as that of the CNIPA. If the appellant cannot sufficiently prove that the disputed trademark has a high reputation with respect to its designated goods or services and is easily to be identified as a trademark, it cannot overcome the refusal grounds of lack of inherent distinctiveness.

B.Registration of prior identical or similar trademarks and effective judgments are not certain grounds for registration of the disputed mark.

In the refusal appeal for “UNLEASH THE CAFFEINE FREE BEAST!”^v trademark filed by Monster Energy Company (“Monster Energy”), Monster Energy emphasized the fact that the disputed trademark has been approved for registration in Classes 5, 29, 30 and 32. However, the court pointed out that “trademark review should be based on a case-by-case basis. Due to differences in the composing elements, historical background, awareness of the relevant public, status of commercial use, etc. of each trademark, and the fact that the trademark in dispute has been approved for registration on other goods without judicial review, the approved registration of the disputed trademark with respect to other goods cannot be taken as the natural basis that the disputed trademark has acquired distinctiveness and should be preliminarily approved and published in this case.”



In the refusal appeal for “ (GUESS HOW MUCH I LOVE YOU and Device)”^{vi} filed by Walker Books Limited, the court also pointed out that the relevant previous effective judgment made by the superior court can be used as a reference for the determination of the said case, but the difference between the previous case and the said case should be taken into consideration and the previous effective judgment cannot be applied rigidly. Based on the facts ascertained, the Supreme People's Court (“SPC”) previously made an administrative judgment (2011) Administrative Retrial No. 9 that, taking into account the distinctive features



of the device element and colors in the trademark, the SPC held that trademark “(BEST BUY and Device)” is distinctive. However, the disputed trademark in this case is not a trademark with claimed colors, and the device part is likely to be recognized as lace or pattern, and thus is of low level of distinctiveness. In view of the combination of the device and text parts of the disputed trademark as an entirety, it still lacks distinctiveness.

Based on the above, with regards to the same or similar precedent registrations submitted by the appellant, the court and the CNIPA basically hold the same opinion that, that trademark review is affected by various conditions such as the formation time, the formation circumstances, and the evidence submitted in the case. The application, review, and approval of other trademarks are not necessarily related to the disputed trademark, and thus cannot be the basis for its verdict.

C.If the disputed mark is not a commonly used term in the relevant industry or direct reference to the designated goods or services, although such mark has the influence as advertising slogan, the relevant public may distinguish the origin of goods or services through the specific slogan, such mark shall not constitute the circumstance stipulated in Article 11.1.(3) of the Trademark Law

From the three cases of “你好历史 (Hi History)”, “海外有家 (A home overseas)”, and “等一個人咖啡 (Café Waiting Love)” (Nos. 7 to 9 in Table 4) where the rejections have been successfully overcome, we are of the view that when hearing the case, the court will pay more attention to whether the disputed trademark is a commonly used term or direct reference in the field of its designated goods or services.

For example, in the “你好历史 (Hi History)” case^{vii} filed by Beijing Wu Xi Tang Technology Co., Ltd., the court held that the disputed trademark was not an ordinary oral language or popular slogan commonly used by the general public, nor had it been used as a common name or advertising language. In the “海外有家 (A home overseas)” case^{viii} filed by Beijing Wo Ai Wo Jia Real Estate Brokerage Co., Ltd., the court held that the disputed trademark is not a direct reference to the related services such as “real estate management; real estate agency services”, and it is not likely to be recognized by the relevant public as advertising terms. It is a suggestive mark that requires consumers to associate. In the case of “等一個人咖啡 (Café Waiting Love)”^{ix} filed by Amazing Film Studio (“Amazing Studio”), the court held that the disputed trademark points to the name of Amazing Studio’s film “Waiting for Love”, which is different from the usual phraseology “waiting for someone”. It is neither a usual expression, nor does it reflect the marketing concepts, promotional methods, business skills or other content of a specific operator. As such, it is not a sign that is not likely to be recognized as a trademark by the relevant public, such as advertising language.

Based on the above, at the court stage, if we can prove that the advertising slogan is not a common language or a direct reference to the related goods or services, and it has a certain reputation after extensive use, our claim may still be supported.

D.Marks that include misleading description shall not be registered as a trademark

In the refusal appeal of Wong Lo Kat Limited’s No. 11064135 “怕上火喝王老吉(Keep the inflammation away, drink Jia Duo Bao)”^x, the court of second instance pointed out that “Keep the inflammation away, drink Jia Duo Bao” was originally an advertising slogan, and the relevant public would consider it to be a promotion of product functions. The slogan can be literally understood as “if you are worried about getting inflammation, drink...”, indicating that the designated products for use have the medical and health function of preventing or even removing inflammation. The mark is used in association with the designated goods “dietetic beverages adapted for medical purposes” and will make the relevant public think that drinking the above-mentioned beverage bearing the trademark has the medical and health function of preventing or even eliminating the inflammation. Therefore, the term “Keep the inflammation away, drink...” may mislead the public. The judgment of the first instance and the accused refusal appeal decision made by the CNIPA regarding the application of the disputed trademark both held that the applied-for mark has violated the provisions of Article 10.1.(7) of the *Trademark Law*, and the above decision is not improper. Therefore, should a trademark include misleading descriptions therein, it will be difficult to overcome the refusal grounds even at the stage of litigation.

III.Recommendations on Increasing the Possibility of Registering An Advertising Slogan Mark

1.Try the best to select words with high level of distinctiveness or originality

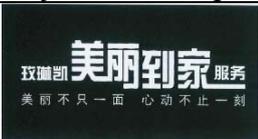
Generally speaking, advertising slogan marks often have a certain degree of descriptiveness for the designated goods or services, or although they may not be directly related to the designated goods or services, they express the company’s business philosophy or propositions. It is not likely for consumers to regard it as a trademark, and it is inherently lack of distinctiveness that a trademark should have. How can we overcome the situation that advertising slogan marks tend to be ordinary and lack originality? The author believes that the following methods can improve the overall distinctiveness of the slogan marks to a certain extent.

(1) Choose vocabulary with a high level of originality or implicit expression, and avoid vocabulary commonly used in the industry.

For example, words such as “Open all year round” directly express the characteristics of the content in banking and other financial services. However, if it is changed to the implicit expression “NEVER SLEEP”, the inherent distinctiveness of the mark will be greatly enhanced.

Rejection Example	Registration Example
全年无休 YearMart (Open all year round, YearMart)	YOUR CITI NEVER SLEEPS
No. 26786836	No. 3200413

(2) Try to be as short and abstract as possible, and avoid using too long narrative sentences.

 <p>For example, in the refusal appeal of No. 11460004 “(Mary Kay, Beauty at Home Service / Beauty is more than one side, heartbeat is not at one moment.)”^{xi}, the court of second instance emphasized that the relevant text in the trademark adopted a narrative expression, which reflected the business philosophy of Mary Kay brand and belong to advertising phrases. The relevant public is likely to understand the mark as a promotion of the Mary Kay brand, rather than as an indication of the source of goods or services as an entirety. As such, the applied-for mark does not possess the inherent distinctiveness in the sense of trademark law.</p>	
Rejection Example	Registration Example
 <p>(Mary Kay, Beauty at Home Service / Beauty is more than one side, heartbeat is not at one moment.)</p>	<p>玫琳凯 美丽到家 (Mary Kay, Beauty at Home)</p>
No. 11460004	No. 11358628

<p>(3) Try to choose words that have no fixed semantic relevance for combination. For example, there is no fixed semantic link between “beyond” and “petroleum”, so such combination is deemed as possessing distinctiveness as an entirety, and has been successfully registered.</p>	
Rejection Example	Registration Example
<p>不仅贡献石油 (Not Only Contributing Petroleum)</p>	<p>超越石油 (Beyond Petroleum)</p>
No. 4932991	No. 5472277

2. Avoid using word of pure description or misleading description in the advertising slogan

When selecting advertising words, we recommend trying to avoid using words that are purely descriptive or that only directly express the functions and uses of goods or services, or words that are likely to be associated with the effects of products. For example, Eastroc

Beverage(Group) Co., Ltd. filed an application for “ (累了困了 喝东鹏特饮 – When tired and sleepy, drink Dong Peng Special Drink)” (No. 41470489) in Class 32 with respect to “energy drinks; herbal beverages; etc.”. The application was rejected due to reason that the mark expresses the characteristics and function of the beverage products. However, Fujian Le Mo Internet of Things Technology Co., Ltd. filed an application for “ (When tired and sleepy, Le Mo Bar/Please Le Mo)” in Class 35 with respect to “import-export agency services; sales promotion for others; etc.”. and the application

has been successfully registered as the mark does not directly indicate the characteristics of the relevant services.

Of course, as previously mentioned, we also recommend avoiding words that include misleading descriptions, such as “怕上火喝加多宝” (Keep the inflammation away, drink Jia Duo Bao)” and “肠动力常年轻” (Bowel power, always young)”. Otherwise, even if they are used extensively in association with related goods or services, it shall not be protected by trademark law.

3. Increase the distinctiveness as an entirety by combination

In practice, it is possible to combine advertising slogans devoid of distinctiveness with distinctive words, devices, numbers, letters and other signs, and such combination of devices and texts may make the mark distinctive as an entirety. For example, adding highly distinctive words or devices to the mark and highlighting the distinctive element to make it prominent can enhance the overall distinctiveness of the mark to a certain extent:

Rejection Example	Registration Example
让天下没有难做的生意 (To make it easy to do business anywhere)	 让天下没有难做的生意 (To make it easy to do business anywhere and Device)
No. 6163957	No. 8569282
 (Made in China, Loved by the World)	 (GREE / Made in China, Loved by the World)
No. 18230296	No. 18230365
未来，不等待 (Future, don't wait)	 (ZTE / Future, don't wait)
No. 16352526	No. 15945989
滴滴香浓，意犹未尽 (Good to the last drop)	 (Maxwell House / Good to the last drop)
No. 3684962	No. 18485376

Of course, it is not necessarily certain that as long as a distinctive text or device is added, the

mark will be registrable. For example, in the example of Gree in the table below, although the company’s house mark “格力 (GREE)” is added therein, it is not designed prominently. It is more likely for the relevant public to understand the mark as an advertisement for the GREE brand, but not recognize the mark as the indication of origin of the goods or services as an entirety. Therefore, it is also in violation of Article 11.1.(3) the *Trademark Law*.

Rejection Examples	
万物互联 一呼百应	格力自主制造让家电 万物互联 一呼百应
No. 41990791	No. 42037960

4. Increase the promotion and keep the relevant evidence

As previously mentioned, no matter whether it is the CNIPA or the courts, for advertising slogan marks, the application will be comprehensively examined with respect to two aspects, i.e. inherent distinctiveness and acquired distinctiveness. If a company’s advertising slogan lacks inherent distinctiveness, we recommend that the company increase the promotion and actively collect its advertising and publicity evidence, in order to make the mark itself acquire distinctiveness through extensive actual promotion and use. As mentioned above, in the refusal

appeal for “ (This! Is Street Dance)” (No. 29364059), Youku submitted a large amount of evidence of use to prove the reputation of the disputed trademark in the entertainment industry, and thus obtained the support of the CNIPA and successfully registered the mark in Class 41 with respect to entertainment services, TV entertainment programs and other related services.

IV. Conclusion

At present, in the fierce market competition, how to select a unique advertising slogan to highlight the corporate culture and product connotation has been closely integrated with the business activities of the company and has become an important weapon for the company to win in the competition. Advertising slogans have gradually become important intangible assets of companies. As mentioned above, original advertising slogans and advertising phrases that can distinguish the origin of production may be protected by the trademark law by filing applications for registration. In addition, for the protection of advertising slogans, the protection of works by the Copyright Law can also be considered at the same time. Of course, if a trademark such as “有凉感无风感 (There is sense of coolness but no feeling of wind)”^{xiii} lacks inherent distinctiveness, but in actual use and business activities, it has established a connection with a specific company, the company can also seek protection under the Anti-unfair Competition Law, based on the characteristics of the advertising language itself and combined with its own actual situation and needs.

ⁱ (2020) Jing Administrative Final No. 6312 judgement made by Beijing High People’s Court



- ii (2019) Jing Administrative Final No. 1206 judgement made by Beijing High People's Court
- iii (2018) Jing Administrative Final No. 5443 judgement made by Beijing High People's Court
- iv (2018) Jing Administrative Final No. 5280 judgement made by Beijing High People's Court
- v (2019) Jing Administrative Final No. 2789 judgement made by Beijing High People's Court
- vi (2020) Jing Administrative Final No. 5689 judgement made by Beijing High People's Court
- vii (2020) Jing Administrative Final No. 2566 judgement made by Beijing High People's Court
- viii (2018) Jing Administrative Final No. 99 judgement made by Beijing High People's Court
- ix (2016) Jing Administrative Final No. 5013 judgement made by Beijing High People's Court
- x (2018) Jing Administrative Final No. 1041 judgement made by Beijing High People's Court
- xi (2015) High Administrative (IP) Final Zi No. 3799 judgment made by Beijing High People's Court
- xii https://www.thepaper.cn/newsDetail_forward_2780350 (Advertisement of “有凉感无风感 There is sense of coolness but no feeling of wind” Infringes Other's Rights? Midea Sued Gree for Unfair Competition and Decision has been Made!) Last visit: July 15, 2021.