

Kluwer Trademark Blog

Who stops you (?) – Should suggestive questions be protected as trademarks?

Bettina Clefsen (b/cl IP) · Wednesday, June 5th, 2024



After yet so many decisions denying trademark protection for slogans in Germany, the Federal Patent Court in Germany recently allowed registration of the slogan mark “Who stops you” (decision of the [Federal Patent Court in Case 29 W \(pat\) 523/21](#)).

The trademark was filed for a variety of goods in Classes 9, 12 and 25, most notably also for “Electronic control systems for vehicle components, in particular brakes” in Class 9 as well as “Actuating devices for brake systems of vehicles” and “Rotary handles and actuating devices as well as the associated transmission elements for actuating the brake” in Class 12.

The German Trademark Office refused registration in relation to all goods arguing that the mark lacked distinctiveness. The mark was a simple English language phrase which was easily understood by German consumers in its proper meaning.

According to the Office, “Who stops you” was merely a message that appeals to the customer’s sense of values and self-determination and expresses encouragement, which is typical of advertising language. Irrespective of whether electronic controls, vehicle parts or clothing, headwear or footwear are offered with the words “who stops you” and regardless of where the sign is affixed to the goods, the customer always interprets it merely as an encouraging appeal or an invitation to purchase the goods offered under this sign. Moreover, the mark did not have an unusual structure or special features capable of detaching the word sequence from the underlying

meaning and making the sign something other than a mere (advertising) message.

On appeal, the Federal Patent Court reminded that only the complete absence of any distinctive character constitutes a ground for refusal. A generous standard must be applied. For advertising slogans and other slogan-like sequences, the same standards apply, i.e. they are not subject to stricter requirements. It also did not matter if the slogan could be understood as being promotional if it could also serve as indication of origin.

The Court accepted a minimum degree of distinctiveness for “Who stops you” in relation to all goods claimed overruling the assessment of the Office. According to the Court, the statement did not reveal any overriding descriptive meaning or a close descriptive reference regarding the goods claimed – even being brakes (although this was not given consideration in the first instance decision). There was an intermediate step required to get to “the brake” as an answer to the question “who stops you (when driving a car or cycling)?”. As an analysis was required to reach the reason for being stopped, the Court held that there was no apparent or overriding descriptive meaning or reference of the phrase in relation to the goods at issue.

The decision is in line with decision on earlier slogan mark applications containing a question such as **“Habt Ihr kein Zuhause?”** (“**Don’t you have a home?**”) which was allowed amongst others for real estate service (decision of the Federal Patent Court dated 12 May 2010 in Case 26 W (pat) 99/09) whereas the slogan mark **“Kleben Sie noch – oder frankieren Sie schon?”** (“**Are you still gluing – or are you already franking?**”) was denied registration for goods being or relating to franking machines (decision dated 20 September 2007 in case 29 W (pat) 50/05).

At EUTM level, most slogan marks containing a question were refused protection. Examples include:

- **“WHAT DO YOU WANT TO SAVE?”** in relation to computer storage services
- **“Who trades what?”** in relation to trade and business-related services in Class 35
- **“WHAT CAN WE DO FOR YOU TODAY?”** amongst others in relation to airport passenger services
- **“HOW CAN I MAKE YOU SMILE TODAY?”** amongst others in relation to retail store services connected with the sale of dental impression kits, orthodontic and dental supplies
- **“CAN YOUR TONGUE TASTE THE DIFFERENCE?”** in relation to non-alcoholic beverages

Summing up, the general tendency at EUIPO seems more restrictive than at the German Patent and Trademark Office when it comes to trademark protection for slogans containing suggestive questions. From my point of view, the Court’s decision seems at least questionable as far as it concerns brakes and related articles.

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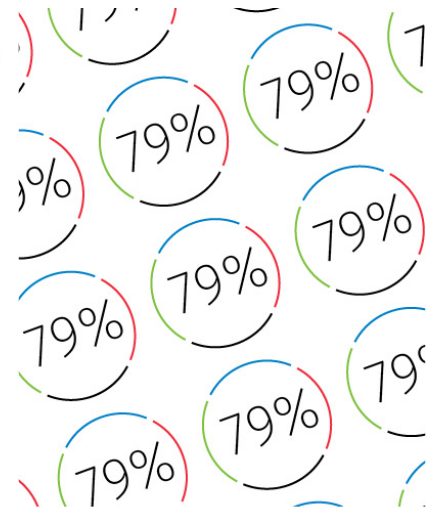
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