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Gary J. Sosinsky
Fordham University School of Law

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NOTE

Laudatory Terms in Trademark Law: Square Pegs in Round Holes

Gary J. Sosinsky*

INTRODUCTION

American society just might have a fetish for being the best. At any sporting event, one would be hard pressed to hear the chant “We’re Number Two!” Leaders of companies often say they desire to make their company the best in their field.¹ The Super Bowl champion visits the White House after the season ends. The runner-up simply goes home. Many American car companies compare their cars to a Mercedes, the alleged top car company in the world, or at least one car many consumers dream of having. At high school graduations, the valedictorian speaks to the graduates, their friends and family. As for the salutatorian, it’s a nice try and a ceremony with her mouth shut. It is not a far stretch to say then, that Americans try to associate themselves with “the best.” American industry is all too conscious of this fact, and American companies often coin their products with terms associated with being the best. This is where our trouble starts. Can one company monopolize the right to label its product in a way that connotes it is the finest product on the market?

Arguably, trademark law is woven into the fabric of our country’s economics. Companies such as McDonalds, Nike, Microsoft and Intel are money-making machines. However, when these

* J.D. Candidate, 1999, Fordham University School of Law; Masters of Public and Private Management, Yale University School of Management, 1996. I would like to thank my family for a lifetime of love and support.

1. The odd exception to this is Avis Rent-A-Car, which makes a big deal as being smaller and more hard-working than the industry leader, Hertz. Avis’s “We Try Harder” slogan (whether true or not) has made its mark in the marketplace.

companies were first established, no one could have predicted the success that each of these entities would enjoy. Where once, each of these company names meant very little, now these corporations and their trademarks stand for something very special—a huge corporate empire with the money and goodwill that go along with it. The goal of trademark law is to protect the public, the companies that have created the trademark, and the associated goodwill that goes hand in hand with the trademark.² In addition, it has been stated that trademarks render four functions deserving of court protection:

- (1) identifying one producer's goods and distinguishing them from the goods of others;
- (2) signifying that all goods bearing the trademark come from or are controlled by a single source;
- (3) signifying that all products containing the mark are of equal quality; and
- (4) helping a producer in advertising and selling the goods.³

The companies mentioned above as well as much smaller businesses have utilized trademark law to make the purchasing public aware of what is theirs and what is not. As was implied earlier, trademarks, used properly, are statements of quality.⁴ By linking their products to a certain level of quality, companies position their

2. S. REP. NO. 1333 (1946), *reprinted in* 1946 U.S.C.C.A.N. 1274 (cited in DONALD A. GREGORY, ET. AL., *INTRODUCTION TO INTELLECTUAL PROPERTY LAW* 84-85 (1994) (citation omitted)). When the Senate Committee reported out the bill that was to become the Federal Trademark Act of 1946 (the Lanham Act), it noted that trademark law had two purposes:

One is to protect the public so it may be confident that, in purchasing a product bearing a particular trade-mark which it favorably knows, it will get the product which it asks for and wants to get. Secondly, where the owner of a trade-mark has spent energy, time, and money in presenting to the public the product, he is protected in his investment from its misappropriation by pirates and cheats. This is the well-established rule of law protecting both the public and the trade-mark owner.

Id.

3. See 1 J. THOMAS MCCARTHY, *MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION* § 3:2 (4th ed. 1996).

4. See JOHN D. OATHOUT, *TRADEMARKS* 34 (1981).

products and stimulate sales, boosting the economy.

Both the public and producers of goods benefit from trademark law. The public benefits because its “search costs” are lessened and the companies benefit because each one knows that if a particular consumer wishes to purchase its good or service, the consumer will not have to sift through different products that are very similarly named in order to find the one that he or she is looking for.⁵ The company earns income that helps its bottom line and the consumer spends her hard-earned money on a product or service that should satisfy her needs.

Though registration of a trademark is not necessary to protect a mark from others using it as their own, it is recommended to do so.⁶ Trademark rights live forever as long as the holder of the mark neither abandons the mark nor permits it to lose its trademark significance by becoming a generic term.⁷ When protection lasts

5. Customers look for specific brands because of the qualities associated with that brand. *See id.*; *see also* Union Nat’ Bank of Texas, Laredo, Texas, v. Union Nat’ Bank of Texas, Austin, Texas, 909 F.2d 839, 844 (5th Cir. 1990) (explaining the value of trademarks in reducing consumer search costs); William Landes & Richard Posner, *Trademark Law: An Economic Perspective*, 30 J.L. & ECON. 265, 268-70 (1987) (discussing the economic benefits of a brand name).

6. It is recommended to establish your rights by applying to register the mark in the U.S. Patent and Trademark Office even before use. *See* Kenneth B. Germain, *Scratching the Surface of Trademark Law*, C602 ALI-ABA 6 (1991). A company can base its application to register a mark on one of a few premises: (a) a bona fide intention to use the mark in federally regulated commerce (the mark then must be used in the ordinary course of business); (b) a foreign owner’s country of origin application filed during the previous six months, or its country of origin registration, in either case with a statement of a bona fide intention to use the mark in the course of business; or (c) actual use of the mark in commerce. *See id.*; *see also* 15 U.S.C.A. § 1051 (West 1998).

7. *See generally* Silverman v. CBS Inc. 870 F.2d 40 (2d Cir. 1989), *cert denied*, 492 U.S. 907 (1989) (for a discussion of abandonment of trademarks); *see also* Star-Kist Foods, Inc. v. P.J. Rhoades & Co., 769 F.2d 1393 (9th Cir. 1985) (finding that a trademark was not abandoned when the owner of the mark ceased using the mark for a period of unprofitability but intended to use the mark again when the economics were more favorable). For a discussion of generic terms, *see generally* DuPont Cellophane Co. v. Waxed Prods. Co., 85 F.2d 75 (2d Cir. 1936) (holding that whether a trademark has been abandoned includes whether the mark has been voluntarily surrendered to the public); *see also* King-Seeley Thermos Co. v. Aladdin Industries, Inc. 321 F.2d 577 (2d Cir. 1963) (holding that the term THERMOS was generic and not entitled to federal trademark protection when the great majority of the American public referred to any vacuum-insulated container as a thermos).

forever, it is not difficult to see why coining a “proper” trademark is important to any business.

In 1997, Estee Lauder brought an action against the Gap, claiming that the Gap’s use of the term “100%” on its body lotion packaging would cause consumers confusion because the term “100%” was similar to Estee Lauder’s use of the term “100%” on its body lotion packaging.⁸ The Second Circuit held that the term “100%” was “suggestive” and worthy of protection as long as consumers would be confused by the two different brands, a finding that Estee Lauder could not prove.⁹ The most interesting part of the case was the court’s discussion of whether or not the term “100%” could be protected as a trademark.¹⁰ The issue was whether “100%” was deemed “suggestive” or “descriptive.” If suggestive, the term could be protected, but if descriptive, the term could not be protected absent a showing of secondary meaning.¹¹ The court stated the term “100%” was a laudatory one, such as “Best,” “Plus,” or “Super” in that it appears to praise any product it is associated with, just as “Best” would do the same.¹² The *Estee Lauder* case demonstrated that coping with the protection of laudatory terms is a challenging task.

Generally, it has been held that laudatory terms are descriptive and therefore not protected without a showing of secondary meaning.¹³ Therefore, the *Estee Lauder* case, by holding “100%” suggestive, re-kindled an old dilemma in trademark law. Whether a term is labeled suggestive or descriptive is critical for the company trying to register or protect the term because showing that a term has secondary meaning, as is necessary for descriptive terms, is a difficult burden.¹⁴ For laudatory terms, there appears no easy answer.

This Note argues that laudatory terms have been mislabeled as

8. See *Estee Lauder Inc. v. The Gap, Inc.*, 108 F.3d 1503 (2d Cir. 1997).

9. See *id.* at 1512.

10. See *id.* at 1509-10.

11. See *id.*; see also *supra* Part I.

12. See 108 F.3d at 1509.

13. See 2 MCCARTHY, *supra* note 3, § 11:17. (stating the prevailing view).

14. See, e.g., *Murphy v. Provident Mut. Life Ins. Co.*, 923 F.2d 923, 927-28 (2d Cir. 1991) (discussing that there is no specific formula for determining secondary meaning).

descriptive for many years, when in fact they are actually more akin to suggestive terms. These laudatory terms however, should not be given the protection afforded suggestive terms; secondary meaning should be required if the laudatory term is to be monopolized by the user. Part I outlines trademark law and the various levels of protection for a mark. Part II, in chronological order, analyzes various cases that discuss the issue of laudatory terms, and shows the inconsistencies in courts' handling of these cases. Part III argues that laudatory terms should be analyzed uniformly by courts—as being suggestive in a literal sense yet needing secondary meaning to be protected. Accordingly, this Note concludes that laudatory terms do not fit nicely into the current trademark framework and it is this uncertainty that has led the judicial system astray.

I. TRADEMARK LAW

In order to understand the laudatory term analysis, it is necessary to start at the beginning and take a brief look at the history and the purposes of trademark law. This Part analyzes the trademark spectrum of possible marks. With this background, an analysis of laudatory terms and the potential problems they pose will be possible.

A. *History of Trademark Law*

For thousands of years, civilization has used symbols to identify ownership and origin of goods and wares.¹⁵ It might be that the earliest kind of marking was that of branding cattle and other animals.¹⁶ We derive the English word “brand” from the Anglo-Saxon word “to-burn”.¹⁷ Quarry marks and stonecutters' signs have been found in Egyptian structures erected as early as 4000 B.C.¹⁸ In the ruins at Pompeii, Roman signboards were located.¹⁹ In medieval England, sword manufacturers were required to use

15. See 1 MCCARTHY, *supra* note 3, § 5:1.

16. See *id.*

17. See *id.*

18. See *id.*

19. See *id.*

identifying marks so that defective weapons could be traced back to the unfortunate seller.²⁰

Compared to Anglo-American property law, trademark law is very new.²¹ There are only a handful of trademark cases found in seventeenth and eighteenth century England.²² Sometime in the early seventeenth century, a cloth-maker was held to have a cause of action against a competitor who had copied the plaintiff's mark and placed it on his lesser quality merchandise.²³ In the very early nineteenth century, English and American common law gradually developed the doctrine of "passing off" or "palming off."²⁴

Federal trademark law traces its beginnings to 1870, when the United States Congress passed the Act of July 8, 1870.²⁵ This statute was struck down by the Supreme Court less than a decade later.²⁶ Congress went back to the drawing board and when Congress finished drawing, it had codified the common law and created the Trademark Act of 1946, commonly referred to as the Lanham Act ("Lanham Act" or "Act").²⁷ The Lanham Act has survived the test of time because it has adopted to the outside forces of the marketplace when necessary.²⁸

20. *See id.*

21. *See id.* § 5:2.

22. *See id.*

23. *See id.* (citing *Southern v. How*, 79 Eng. Rep. 1243 (1618)).

24. *See* 1 MCCARTHY, *supra* note 3, § 5:2.

25. Act of July 8, 1870, ch. 230, 16 Stat. 198. *See* Tara J. Goldsmith, *What's Wrong with this Picture? When the Lanham Act Clashes with Artistic Expression*, 7 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 821, 826 (1996); OATHOUT, *supra* note 4, at 6.

26. *See* *Trade-Mark Cases*, 100 U.S. 82, 86 (1879) (finding the 1870 Act unconstitutional because Congress used the Patent and Copyright Clause of the Constitution to justify its regulation of trademarks, but stating that the Commerce Clause could be relied on); Goldsmith, *supra* note 25, at 826.

27. Trademark Act of 1946 ("Lanham Act") ch 540, 60 Stat. 427 (codified as amended at 15 U.S.C.A §§ 1051-1127 (West 1998 & Supp. 1999)).

28. *See generally* Ethan Horwitz & Benjamin Levi, *Fifty Years of the Lanham Act: A Retrospective of Section 43(a)*, 7 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 59 (1996) (providing a historical accounting of the Lanham Act); Joseph D. Garon, *The Lanham Act: A Living Thing*, 7 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 55 (1997) (discussing the evolution of the Lanham Act). In the beginning, the only function of a trademark was to designate the source of a product, whereas with the growth of industry in the United States and around the world, the function has broadened to include, "in addition to identification of origin, both a guarantee of quality for the purchaser and a source of advertis-

From the beginning, the Lanham Act has been a triumph for the businesses of America.²⁹ The Act is based on the firm principle that when a business has spent time and money to develop an identification for its product, it is not equitable to allow another business that has not spent the resources, to use the unique mark and cash in on the goodwill of the party that has made the critical investment.³⁰ Therefore, a trademark owner has the right to stop others from infringing on his mark when a likelihood of confusion will arise among consumers.³¹ This is so even if the goods purchased through deception are of equal or higher quality than those

ing for the manufacturer.” *Id.* at 56 n.8 (citing 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION §§ 3.04[1], 3.05 (3d ed. 1992 & Supp. 1996)).

29. See Garon, *supra* note 28, at 55.

30. It has been stated that “[t]he Lanham Act is the embodiment of the purpose to secure to every businessman the advantage which public preference for his goods gives to him and to protect him in the exclusive right to the names and marks which perpetuate the good will which merit earns.” Garon, *supra* note 28, at 55-56 (quoting Edward S. Rogers, *Introduction*, in DAPHNE ROBERT, THE NEW TRADE-MARK MANUAL, A HANDBOOK ON PROTECTION OF TRADE-MARKS IN INTERSTATE COMMERCE (1947)); see also Goldsmith, *supra* note 25, at 829 (citing *Frisch’s Restaurant v. Shoney’s Inc.*, 759 F.2d 1261, 1264 (6th Cir. 1985)); *The Sports Auth., Inc. v. Prime Hospitality Corp.*, 89 F.3d 955, 963 (2d Cir. 1996) (stating that the court considers the defendant’s intent in adopting his mark).

31. See 15 U.S.C.A. § 1114 (West 1998). Section 114 states:

- (1) Any person who shall, without the consent of the registrant-
 - (a) use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive; or
 - (b) reproduce, counterfeit, copy or colorably imitate a registered mark and apply such reproduction, counterfeit, copy or colorable imitation to labels, signs, prints, packages, wrappers, receptacles or advertisements intended to be used in commerce upon or in connection with the sale, offering for sale, distribution, or advertising of goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive, shall be liable in a civil action by the registrant for the remedies hereinafter provided. Under subsection (b) hereof, the registrant shall not be entitled to recover profits or damages unless the acts have been committed with knowledge that such imitation is intended to be used to cause confusion, or to cause mistake, or to deceive.

Id.; see, e.g., *Polaroid Corp. v. Polarad Elec. Corp.* 287 F.2d 492 (2d. Cir. 1961) (applying the Polaroid factors), *cert denied*, 368 U.S. 820 (1969); *Sports Authority* 89 F.3d at 955.

that were meant to be purchased.³² Hence, it is confusion and the similarity of marks that is the thrust of the Lanham Act.³³

Knowing this, the process of developing and protecting trademarks is complex.³⁴ Developing a branded product requires a great deal of long-term investing in advertising, promotion and strategy.³⁵ A brand is “a seller’s promise to consistently deliver a specific set of features, benefits, and services to the buyers.”³⁶ In addition, “a brand first brings to mind certain attributes.”³⁷ For instance, Mercedes suggests durable, well engineered, fast and high prestige automobiles.³⁸ A potent brand is said to have high brand equity.³⁹ Furthermore, it is this high level of brand equity that all businesses wish their products to possess.⁴⁰ Simply, brand equity starts with a name.⁴¹ Because advertising budgets are normally at a fixed amount and every company wants more bang for its buck, companies favor names—trademarks and brands, that sell themselves.⁴² This is where marketers get themselves in trouble. It is important to have the right trademark for selling purposes, but it is equally important to have a mark that will be protected by the Act should others use the same or a very similar mark. Stripped to its essence, the law is clear that to succeed in a Lanham Act suit for

32. See *Truck Equip. Serv. Co. v. Fruehauf Corp.*, 536 F.2d 1210, 1216 (8th Cir. 1976), *cert. denied*, 429 U.S. 861 (1976) (finding a Lanham Act violation even though plaintiff’s and defendant’s goods were ‘of equal quality’).

33. See Goldsmith, *supra* note 25, at 829-30; see also *Kohler Co. v. Moen Inc.*, 12 F.3d 632, 643 (7th Cir. 1993) (“[o]thers can produce designs similar to the trademark so long as there is no likelihood of consumer confusion”); 3 MCCARTHY, *supra* note 3, § 23:1.

34. See, e.g., John D. Danforth, *Effective Management of an International Trademark Portfolio*, 455 PLI/PAT. 435, 437 (1996) (providing a methodology for the development and protection of a trademark); see also PHILIP KOTLER, *MARKETING MANAGEMENT* 444 (8th ed. 1994) (discussing brands and brand management).

35. See KOTLER, *supra* note 35, at 444.

36. *Id.*

37. *Id.*

38. See *id.*

39. See *id.* at 445.

40. KOTLER, *supra* note 35, at 445.

41. See *id.* at 445 (“brand equity is higher, the higher the brand loyalty, name awareness, perceived quality, strong brand associations, and other assets such as patents, trademarks, and channel relationships”).

42. See Danforth, *supra* note 34, at 438.

trademark infringement, a plaintiff has two obstacles to surpass: (1) the plaintiff must prove that its mark is entitled to protection and, just as important, (2) that the defendant's use of its own mark will likely cause confusion with plaintiff's mark.⁴³ Whether or not a mark is protected is clearly important to the success of the products the mark is associated with.

B. *Trademark Spectrum*

The Lanham Act broadly defines the term trademark. Trademarks are any word, symbol or device used in commerce to identify and distinguish goods.⁴⁴

“The strength of a trademark in the marketplace and the degree of protection it is entitled to are categorized by the degree of the mark's distinctiveness in the following ascending order: generic, descriptive, suggestive, and arbitrary or fanciful.”⁴⁵ “A generic term is a common name, like automobile or aspirin, that describes a kind of product”⁴⁶ and does not identify the source of the product.⁴⁷ The actual name of a product cannot be used as someone's trademark because that would leave others without the critical term

43. See 15 U.S.C.A. § 1114(1)(a); see also *Sports Auth. Inc. v. Prime Hospitality v. Prime Hospitality Corp.* 89 F.3d 995, 960 (2d Cir. 1996) (citation omitted); *Gruner + Jahr USA Pub. v. Meredith Corp.* 991 F.2d 1072, 1075 (2d Cir. 1993) (holding that PARENT'S DIGEST was not likely to cause a sufficient number of ordinary prudent purchasers to be confused with PARENTS magazine).

44. 15 U.S.C.A. § 1127. A Trademark is:

[A]ny word, name, symbol, or device, or any combination thereof—(1) used by a person, or (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this Chapter, to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.

Id.

45. *Gruner + Jahr*, 991 F.2d at 1075; see also *Estee Lauder Inc. v. The Gap, Inc.*, 108 F.3d 1503, 1508 (2d Cir. 1997) (discussing the classifications for trademarks); *20th Century Wear, Inc. v. Sanmark-Stardust Inc.*, 747 F.2d 81, 87 (2d Cir. 1984), *cert denied*, 470 U.S. 1052 (1985); *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976) (discussing the spectrum of trademark protection); GREGORY, *supra* note 2, at 86-90.

46. *Gruner + Jahr*, 991 F.2d at 1075.

47. See GREGORY, *supra* note 2, at 89-90; *Gruner + Jahr*, 991 F. 2d at 1075.

to advertise or publicize its own product.⁴⁸ Therefore, a common generic name is never entitled to trademark protection.⁴⁹ The Act dictates cancellation of a registered mark if at any time it “becomes the common descriptive name of an article or substance.”⁵⁰ Names such as “YO-YO,”⁵¹ “ASPIRIN,”⁵² “CELLOPHANE,”⁵³ “MULTISTATE BAR EXAMINATION,”⁵⁴ “THERMOS,”⁵⁵ “SHUTTLE,”⁵⁶ “TOLL HOUSE,”⁵⁷ “OPRY,”⁵⁸ and “LITE,”⁵⁹ are in this generic category. At the opposite end of the distinctiveness spectrum is an arbitrary or fanciful term.⁶⁰ This type of term may always claim trademark protection, “is never a common name for a

48. See SIEGRUN D. KANE, TRADEMARK LAW 15 (2d ed. 1991).

49. See DORIS E. LONG, UNFAIR COMPETITION AND THE LANHAM ACT, 44 (1993) (citation omitted); see also *Gruner + Jahr*, 991 F.2d at 1075 (stating that a common name can never obtain trademark protection); *DuPont Cellophane Co. v. Waxed Prods Co.*, 85 F.2d 75, at 80-81 (2d Cir. 1936); *King-Seeley Thermos v. Aladdin Indus., Inc.*, 321 F.2d 577, 579-81 (2d Cir. 1963) (discussing thermos as a generic term); see also GREGORY, *supra* note 2, at 89-90 (discussing marks that are incapable of trademark protection).

50. 15 U.S.C.A. § 1064(c)(West 1998).

51. See *Donald F. Duncan, Inc. v. Royal Tops Mfg. Co.*, 343 F.2d 655 (7th Cir. 1965) (an action for the alleged infringement of Yo-Yo’s trademark).

52. See *Bayer Co. v. United Drug Co.* 272 F. 505 (S.D.N.Y. 1921) (holding that the “aspirin” mark had entered the public domain).

53. See *DuPont Cellophane Co. v. Waxed Prods. Co.*, 85 F.2d 75, 76-77 (2d Cir. 1936) (holding that DuPont’s advertising had used cellophane as a generic term, descriptive of the product, not of its source).

54. See *National Conference of Bar Examiners v. Multistate Legal Studies, Inc.*, 692 F.2d 478 (7th Cir. 1982) (holding that the phrase “MBE” had a common descriptive quality).

55. See *King-Seeley Thermos Co. v. Aladdin Indus., Inc.*, 321 F.2d 577 (2d Cir. 1963) (holding that “thermos” is a generic term).

56. See *Eastern Air Lines v. New York Air Lines*, 559 F. Supp. 1270 (S.D.N.Y. 1983) (holding that “air-shuttle” is a generic term).

57. See *Nestle Co. v. Chester’s Mkt., Inc.*, 571 F. Supp. 763 (D. Conn. 1983), *re-manded and vacated on other grounds*, 756 F.2d 280 (2d Cir. 1985) (TOLL HOUSE for cookies found to be generic despite more than \$1 billion in sales over a ten year period and \$140 million in advertising).

58. See *WSM, Inc. v. Hilton*, 724 F.2d 1320 (8th Cir. 1984) (OPRY found to be generic despite use for over fifty years).

59. See *Miller Brewing Co. v. Falstaff Brewing Corp.*, 655 F.2d 5 (1st Cir. 1981) (LITE held to be generic for low-alcohol beer despite very high sales and advertising levels).

60. See *Gruner + Jahr Publ’g v. Meridith Corp.*, 991 F.2d 1072, 1075 (2d Cir. 1993); see also GREGORY, *supra* note 2, at 86-87 (stating that a fanciful mark is the most distinctive); *Danforth*, *supra* note 34, at 438 (discussing the spectrum of trademark protection).

product, and bears little or no relationship to the kind of product represented.”⁶¹ An arbitrary term has a dictionary meaning but does not describe the product at hand.⁶² An example would be Ivory for soap.⁶³ A fanciful mark is a name that is made-up to identify the trademark owner’s product—such as EXXON for oil products and KODAK for photographic services.⁶⁴ The categories described above are easy for a court to deal with. The other categories are not as simple for the judiciary.⁶⁵

The other two categories determining a trademark’s strength are “suggestive” and “descriptive.”⁶⁶ A suggestive mark is an inherently distinctive mark, just as an arbitrary or fanciful one is.⁶⁷ The category of suggestive marks arose because the judicial system needed to protect marks the common law did not—any mark that was not fanciful or arbitrary.⁶⁸ There also existed a need to give protection to marks that were neither exactly descriptive on the one hand nor truly fanciful on the other—a need that was particularly keen because of the bar in the Trademark Act of 1905⁶⁹ on the registration of merely descriptive marks regardless of proof of secondary meaning.⁷⁰ Since creating the category, the courts have had a difficult time defining it.⁷¹ Judge Learned Hand has made the unhelpful statement: “[i]t is quite impossible to get any rule out of the cases beyond this . . . [t]hat the validity of the mark

61. See *Gruner + Jahr*, 991 F.2d at 1075-76.

62. See *id.*

63. See *id.*

64. See *id.*; see also 2 MCCARTHY, *supra* note 3, §§ 11:2-11:4A; Danforth, *supra* note 34, at 438.

65. See, e.g., *Franklin Knitting Mills, Inc. v. Fashionit Sweater Mills, Inc.*, 297 F.2d 247, 248 (2d Cir. 1923), *aff’d per curiam*, 4 F.2d 1018 (2d Cir. 1925) (discussing where a mark falls on the spectrum, the court stated, “[i]t is impossible to get any rule out of the cases beyond this.”)

66. See *Gruner + Jahr*, 991 F.2d at 1076; see also GREGORY, *supra* note 2, at 87-88 (discussing non-inherently distinctive marks).

67. See GREGORY, *supra* note 2, at 87; *Gruner + Jahr*, 991 F.2d at 1076; see also *Abercrombie*, 537 F.2d 4, 10-11 (2d Cir. 1975).

68. See 2 MCCARTHY, *supra* note 3, § 11:63.

69. Act of Feb. 20, 1905, ch. 592, 33 Stat. 724.

70. See *Abercrombie*, 537 F.2d at 10; *Orange Crush Co. v. California Crushed Fruit Co.*, 297 F.892 (App. D.C. 1924); 2 MCCARTHY, *supra* note 3, § 11:63.

71. See *Abercrombie*, 537 F.2d at 10.

ends where suggestion ends and description begins.”⁷² If one took a survey of all the trademarks existing today, one would find that the majority of those marks would be suggestive of the product.⁷³ “A term is suggestive if it requires imagination, thought and perception to reach a conclusion as to the nature of the goods.”⁷⁴ It has also been said that a suggestive term “suggests, rather than describes, some characteristic of the goods to which it is applied and requires the consumer to exercise his imagination to reach a conclusion as to the nature of the goods.”⁷⁵ Examples of suggestive marks include CHARRED KEG for whiskey,⁷⁶ GUNG HO for toys,⁷⁷ and ORANGE CRUSH for an orange-flavored beverage.⁷⁸

Descriptive marks “describe or identify an ingredient, quality, characteristic, function feature, purpose, or use of the goods or services to which the mark is applied.”⁷⁹ Courts have utilized a couple of tests to determine if a mark is descriptive.⁸⁰ First, the “dictionary definition test” looks to the dictionary definition of the term in question to see if that definition “includes or suggests a direct rela-

72. *Franklin Knitting Mills, Inc. v. Fashionit Sweater Mills, Inc.*, 297 F. 247, 248 (2d Cir. 1923), *aff'd per curiam*, 4 F.2d 1018 (2d Cir. 1925); *see Abercrombie*, 537 F.2d at 10. *See also* 2 MCCARTHY, *supra* note 3, § 11:66 (“The descriptive category almost imperceptibly shades over at its fringe into the suggestive domain”); *Union Carbide Corp. v. Ever-Ready, Inc.* 531 F.2d 366 (7th Cir. 1976), *cert. denied*, 429 U.S. 830 (1976):

[I]t is often a difficult distinction to draw and is, undoubtedly, often made on an intuitive basis rather than as the result of a logical analysis susceptible of articulation. This only emphasizes the need to give due respect to the determinations of the Patent Office if the distinction is to be drawn in a consistent manner.

Id. at 379.

73. *See* 2 MCCARTHY, *supra* note 3, § 11:65.

74. *Abercrombie*, 537 F.2d at 11; *Stix Prods, Inc. v. United Merchants & Mfrs Inc.*, 295 F. Supp. 479, 488 (S.D.N.Y. 1968); *see generally* *General Shoe Corp. v. Rosen*, 111 F.2d 95, 98 (4th Cir. 1940) (examining a suggestive term).

75. LONG, *supra* note 49, at 49 (quoting *Vision Ctr. v. Opticks, Inc.*, 596 F.2d 111, 115-16 (5th Cir. 1979), *cert. denied*, 444 U.S. 1016 (1980)).

76. *See In re Majestic Distilling Co.*, 420 F.2d 1086, 1088 (C.C.P.A. 1970).

77. *See Hasbro Inc. v. Lanard Toys, Ltd.*, 858 F.2d 70 (2d Cir. 1988).

78. *See Orange Crush Co. v. California Crushed Fruit Co.*, 54 App. D.C. 313 (1924).

79. GREGORY, *supra* note 2, at 88.

80. *See* LONG, *supra* note 49, at 47.

tionship with the products or services in question”.⁸¹ Another test is the “imagination test”, a test that weighs the link between the actual words of the mark and the product that they are connected to.⁸² “If the term standing alone conveys information as to characteristics of the goods, it is descriptive.”⁸³ A third test considers if competitors would need the term to describe their products.⁸⁴ Descriptive marks are not protected as marks unless they have acquired secondary meaning.⁸⁵ Secondary meaning has been described by one court as the situation where most consumers have come to think of the word not as descriptive but as the name of the product.⁸⁶ Descriptive marks are not given exclusive protection with-

81. *Id.* at 48; *see also* Zatarains, Inc. v. Oak Grove Smokehouse, Inc., 698 F.2d 786, 792 (5th Cir. 1983)(applying dictionary definition test).

82. LONG, *supra* note 50, at 48; *see also* Zatarains, Inc. v. Oak Grove Smokehouse, Inc., 698 F.2d 786 (5th Cir. 1983) (applying this test).

83. LONG, *supra* note 50, at 48.

84. *See id.*; *see also* Union Carbide Corp. v. Ever-Ready, Inc. 531 F.2d 366, 379 (7th Cir. 1976), *cert. denied*, 429 U.S. 830.

85. *See* 15 U.S.C.A. § 1052, which states:

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—

...

(e) Consists of a mark which—

(1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them;

...

(f) Except . . . nothing herein shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant’s goods in commerce.

Id. Gruner + Jahr Publ’g v. Meredith Corp., 991 F.2d 1070, 1076 (2d Cir. 1973); *see also* Valmor Prods. Co. v. Standard Prods. Corp. 464 F.2d 200, 202 (1st Cir. 1972) (finding that plaintiff’s use of a mark, VALMOR, on its products and in its advertising over 45 years had established a close connection between the trademark name and its products); *In Re Wileswood, Inc.* 201 U.S.P.Q. 400, 404 (P.T.O.-T.T.A.B. 1978) (holding the laudatory, descriptive term AMERICA’S FINEST not registrable because it had not acquired secondary meaning with regard to popcorn).

Id.

86. *See* Int’l Kennel Club of Chicago, Inc. v. Mighty Star, Inc. 846 F.2d 1079 (7th Cir. 1988) (quoting Blau Plumbing, Inc. v. SOS Fix-It, Inc., 781 F.2d 604, 609 (7th Cir. 1986)); *see also* Vaughan Mfg. Co. v. Brikam, Inc., 814 F.2d 346, 348 (7th Cir. 1987) (stating that “secondary meaning denotes an association in the mind of the consumer between the trade dress [or name] of a product and a particular producer.”); Centaur Communications, Ltd. v. A/S/M Communications, Inc., 830 F.2d 1217, 1221 (2d Cir. 1987) (a “mark comes to identify not only the goods but the source of those goods, even though

out secondary meaning for two reasons. First, a descriptive term that solely informs the consumer of a particular quality of the product does not automatically function to identify and distinguish any particular seller's product.⁸⁷ As well, because a trademark serves to perform this very function, a descriptive mark is not capable of exclusive trademark protection without a showing of procured distinctiveness.⁸⁸ Second, descriptive terms should be available to all companies to describe their products.⁸⁹ The Court of Customs and Patent Appeals stated that trademark law does not protect descriptive marks because it is necessary "to maintain freedom of the public to use the language involved."⁹⁰ Marks that have been found to be descriptive include "VISION CENTER,"⁹¹ "EVERREADY,"⁹² "HOME SAVINGS,"⁹³ and "SHEAR PLEASURE."⁹⁴

As one may expect, it takes lots of time and money to have one's goods acquire secondary meaning.⁹⁵ Therefore, the fine line between suggestive and descriptive marks is a critical one indeed.⁹⁶ The former has trademark protection from birth while the latter has protection only after a showing that consumers link the name and the source of the product.⁹⁷ Therefore, the question of where laudatory terms fall on the distinctiveness spectrum, suggestive—protected as inherently distinctive, or descriptive—protected only if secondary meaning has attached, will determine how well they

the relevant consuming public might not know the name of the producer").

87. See GREGORY, *supra* note 2, at 88.

88. See *id.*

89. See *id.*

90. In Re Abcor Dev. Corp., 588 F.2d 811, 813, (C.C.P.A. 1978).

91. See *Vision Ctr. v. Opticks, Inc.*, 596 F.2d 111 (5th Cir. 1979), *cert. denied* 444 U.S. 1016 (1980) (for a place to purchase eyeglasses).

92. See *Union Carbide Corp. v. Ever-Ready Inc.*, 531 F.2d 366 (7th Cir. 1976), *cert. denied*, 429 U.S. 830 (1976) (for batteries and light bulbs).

93. See *Home Sav. of Am. v. Home Sav. Ass'n.*, 219 USPQ 157 (S.D. Tex. 1982) (for savings and loan services).

94. See *Pullan v. Fulbright*, 227 U.S.P.Q. 493 (Ark. Ct. App. 1985) (for hair-dresser/beauty shops).

95. See LONG, *supra* note 49, at 68-69.

96. See, e.g., In re Occidental Petroleum Corporation, 167 U.S.P.Q. 128 (T.T.A.B. 1970); *Estee Lauder Inc. v. The Gap, Inc.*, 108 F.3d 1503 (2d Cir. 1997).

97. See *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 10 (2d Cir. 1976); In Re Wileswood Inc., 201 U.S.P.Q. at 404.

stand up to a challenge from a competitor's term.⁹⁸

II. ANALYSIS OF LAUDATORY TERMS

This section will delve into the heart of the matter—laudatory terms. First, a very brief look at the leading trademark treatise's opinion on laudatory terms will be discussed. Next, through an analysis of case law on the issue, the concept of laudatory terms and their usage should become clearer. This section will look at the usage of laudatory terms spanning over one hundred years. The forthcoming cases deal with such products as beer, facial products, mortgage services and much more.

“Laudatory” can be defined as “containing or expressing praise”.⁹⁹ Professor McCarthy states: “marks that are merely ‘laudatory’ and descriptive of the alleged merit of a product are also regarded as being ‘descriptive’.”¹⁰⁰ In addition, it has been stated that “[m]erely laudatory terms are also considered to be descriptive.”¹⁰¹ However, it has very recently been stated that laudatory marks contain an expression about the quality of the product and can be either suggestive or descriptive, depending on the mark and the situation.¹⁰²

The concept of using laudatory terms as marks goes back as far as the Nineteenth century.¹⁰³ It is well known that beer is taken seriously in America and a couple of early cases stress this point.¹⁰⁴ In *Beadleston & Woerz v. Cooke Brewing Co.*,¹⁰⁵ Beadleston filed for an injunction to restrain Cooke from using the term “Imperial” because “Imperial” was claimed to be a trademark of Beadleston.¹⁰⁶ Beadleston used as its trademark the coat of arms of the state of New York alongside “Beadleston & Woerz”, the words

98. See, e.g., *Estee Lauder Inc. v. The Gap, Inc.*, 108 F.3d 1503 (2d Cir. 1997).

99. THE RANDOM HOUSE COLLEGE DICTIONARY 758 (1984).

100. 2 MCCARTHY *supra* note 3, § 11:17.

101. Danforth, *supra* note 34, at 438.

102. See Baila H. Celedonia, *Review of the Basic Principles of Trademark Law*, 559 PLI/LIT 147, 157 (1997).

103. See, e.g., *Beadleston & Woerz v. Cooke Brewing Co.*, 74 F. 229 (7th Cir. 1896).

104. See *id.*; *Pabst Brewing v. Decatur Brewing Co.*, 284 F. 110 (7th Cir. 1922).

105. 74 F. 229 (7th Cir. 1896).

106. See *id.* at 230.

“Empire Brewery” and the name of the beer to which the trademark was attached.¹⁰⁷ The label of Cooke’s beer read “Cooke’s Imperial Beer”—these words alongside a shield of stars and stripes with the monogram ‘C’.¹⁰⁸ The Seventh Circuit stated that there was no “palming off” the goods of another because the labels were dissimilar, each company’s beer was sold in different geographic markets, and Cooke used “Imperial” in good faith.¹⁰⁹ Furthermore, the Seventh Circuit explained that a trademark must be designed to indicate the producer of a commodity and to separate that particular product from the wares of others.¹¹⁰ Moreover, the court stated that the mark cannot be held to be valid if it is used to identify the class, grade, style, or utility of the article.¹¹¹ In holding that the plaintiff’s goodwill was not diluted, the court stated that “Imperial” was used to describe the quality of the beer whereas the rest of the distinctive package identified the source of the beer.¹¹² The court concluded that “[t]he monopoly of use granted by the law of trademarks should not be extended to embrace terms of doubtful signification”.¹¹³

In *Pabst Brewing v. Decatur Brewing Co.*,¹¹⁴ the term “Blue Ribbon” had been registered and used by the plaintiff on a certain make of its beer and had acquired secondary meaning due to the large number of sales of this brand of beer.¹¹⁵ The defendant, at a later date, put out a malt extract under the name of “Blue Ribbon”, registered it as its trademark for malt extract, and sold a very large

107. *See id.*

108. *See id.*

109. *See id.* at 230-31.

110. *See id.* at 231.

111. *See id.*

112. *See id.* The court noted that various dictionaries defined “Imperial” in a very standard way—“of superior size or quality.” *Id.* at 232. The record in this case was filled with examples of “Imperial” being used for general quality - “Imperial Champagne,” “Imperial Whisky,” “Imperial Gin,” “Imperial Cigars,” “Imperial Ginger Ale,” “Imperial Cider” and Imperial Port.” *Id.*

113. *Id.* at 233. *See also* McGraw Tire & Rubber Co. v. Griffith, 198 F. 566 (S.D.N.Y. 1911) (holding there was unfair competition and an infringement of the trademark “Imperial” when the defendant tire company bought “Imperial” tires from the plaintiff, subsequently incorporated under the name “Imperial Tire Company,” and sold tires with the name “Imperial” that were not made by the plaintiff’s business).

114. 284 F. 110 (7th Cir. 1922).

115. *See id.* at 110.

quantity of the extract.¹¹⁶ The court stated that the term “Blue Ribbon” signifies high merit and had long acquired special significance, wholly apart from its use as a trade name for any product.¹¹⁷ Holding that the term could only be protected as against other beers, it was held that the defendant could use “Blue Ribbon” for its brand of malt extract because no likelihood of confusion was likely.¹¹⁸ The analysis of the court is unclear whether “Blue Ribbon” was seen as a descriptive or a suggestive term, but the court clearly limited the scope of protection to a very narrow class of product - the same exact product that the complainant marketed.¹¹⁹ The *Pabst* court neither mentioned the word “laudatory” nor stated that the beer had ever been awarded a “Blue Ribbon”.¹²⁰ Hence, whether or not “Blue Ribbon” was seen as descriptive of the product was unclear.¹²¹

A few years later, the Second Circuit, in *France Milling Co. Inc. v. Washburn-Crosby Co. Inc.*,¹²² stated that the term “Gold Medal” is a laudatory phrase that is *suggestive* of merit.¹²³ The *France Milling* court further stated that the phrase is only joined with a business by persistent advertising.¹²⁴ For this reason, the court held that “Gold Medal”, similar to “Blue Ribbon”, could only be protected to the specific well-known commodity that it has come to be associated with.¹²⁵ The plaintiff in *France Milling* had sued to protect its trade-mark “Gold Medal” in the prepared pan-

116. *See id.* at 111.

117. *See id.* at 112. Interestingly, the Court gave another definition from the Century Dictionary which stated that “Blue Ribbon” indicated membership in total abstinence organizations. *Id.* The Court further stated that “Blue Ribbon” had been registered in the Patent Office over sixty times for a variety of products.

118. *See Pabst Brewing v. Decatur Brewing Co.*, 284 F. 110, 113 (7th Cir. 1922). The court found it noteworthy that the plaintiff, Pabst, had produced its own malt extract and did not use the “Blue Ribbon” name. *Id.* at 111-112. Malt extract was used in the production of home-brewed beer during the period of national prohibition.

119. *See id.* at 112-13.

120. *See id.*

121. *See id.*

122. 7 F.2d 304, (2d Cir. 1925).

123. *See France Milling Co. v. Washburn-Crosby Co., Inc.*, 7 F.2d 304, 306 (2d Cir. 1925).

124. *See id.* at 306. Persistent advertising is, of course, heavily linked with the concept of secondary meaning and terms that would be described as “descriptive.” *See id.*

125. *See id.*

cake and buckwheat flour market.¹²⁶ In 1904, the plaintiff obtained a gold medal for the flour at the Louisiana Purchase Exposition in St. Louis.¹²⁷ The defendant and counter-claimant, Washburn, one of the largest producers of wheat flour in the world, had used “Gold Medal” as a trade-mark for wheat flour since 1880, but had never, until 1923, produced or sold pancake flour.¹²⁸ As of 1923, the two companies were competitors in the prepared flour business. The court stated that as commercial commodities, “straight” wheat flour and prepared flour were dissimilar.¹²⁹ The court did not stop there—it then stated that among consumers, “Gold Medal” flour meant defendant’s flour, but because the name is not original per se, it could only be protected for the single item of wheat flour that its registration was associated with.¹³⁰ As can be seen from the above, these two courts only protected the terms “Blue Ribbon” and “Gold Medal” to the extent that they were used in connection with a very specific item.¹³¹ The early trend, therefore, was to classify these laudatory terms as if they were vague enough that no merchant should be allowed to monopolize the term barring a showing that the public overwhelmingly identified the laudatory term with a specific good that the merchant sold—generally a “descriptive” type of analysis.¹³²

*Hughes v. Alfred H. Smith Co.*¹³³ discussed the term “Ideal” as applied to hairbrushes and held that the term was not descriptive and hence, was entitled to registration as a trademark.¹³⁴ The court

126. *See id.*

127. *See id.* at 304. This fact makes this case somewhat distinguishable from *Pabst Brewing*, where it is unclear if the beer had been awarded a Blue Ribbon.

128. *See France Milling Co. v. Washburn-Crosby Co., Inc.*, 7 F.2d 304, 304 (2d Cir. 1925).

129. *See id.*

130. *See id.* at 306. (“One who devises a new . . . word to describe his wares may . . . by timely suit prevent others from taking his word or set of words to gild the repute of even wholly different goods []; but one who takes a phrase which is the commonplace of self-praise like ‘Blue Ribbon’ or ‘Gold Medal’ must be content with that special field which he labels with so undistinctive a name.”)

131. *See id.*; *see also Pabst Brewing*, 284 F. at 112-13.

132. *See LONG*, *supra* note 49, at 47; *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 10 (2d Cir. 1976).

133. 209 F. 37 (2d Cir. 1913).

134. *See id.* at 39. In 1886, Pearson obtained a patent for a brush. *See id.* at 38. Hughes’s predecessors began selling similar brushes which led to an agreement between

stated that the “Ideal” brushes were understood by consumers to be associated with Hughes, the sellers of the brushes, and not Pearson, the manufacturer of the brushes.¹³⁵ The defendant argued unsuccessfully that the term “Ideal” had been so firmly connected with the patented brush so as to become a generic name for the item.¹³⁶

Returning to the alcoholic theme, in 1935, the Second Circuit held that “Imperial” as applied to whisky could not be registered as a valid trademark and therefore, the preliminary injunction issued by the district court was reversed.¹³⁷ The plaintiff claimed ownership of the trademark “Imperial” since 1933 and had been selling distilled whiskey under the name “Imperial” since 1887, mainly in Canada until 1891, when it began advertising and selling its whiskey in the United States.¹³⁸ The defendant, in 1934, began selling whiskey in three different grades, “De Luxe,” “Imperial,” and “Regal.”¹³⁹ Interestingly, the defendant’s sales of whiskey were far larger than the plaintiff’s.¹⁴⁰ The court first stated that “Imperial” was *descriptive* and indicative of quality.¹⁴¹ However, it then stated that “Imperial” is a *generic* word, adjective in its nature and invalid as a trademark.¹⁴² Yet, the court recognized that the question of whether a word is capable of becoming distinctive of the products that a producer churns out might be a question of fact and not to be determined solely on the basis of the descriptive qualities of the term.¹⁴³ Therefore, stating that the term could possibly function as a trademark and was not actually invalid, the court searched for evidence of secondary meaning.¹⁴⁴ The court noted the good

Pearson and Hughes’s predecessors whereby Pearson would only sell his brushes to Hughes, with such brushes being called “Ideal.” *Id.*

135. *See id.*

136. *See Hughes v. Alfred H. Smith Co.* 209 F. 37, 39 (2d Cir. 1913).

137. *See Hiram Walker & Sons, Inc. v. Penn-Maryland Corp.*, 79 F.2d 836 (2d Cir. 1935).

138. *See id.* at 837.

139. *See id.*

140. *See id.*

141. *See id.* The court also stated that “Imperial” is commonly used as a synonym for imposing size, appearance or excellence. *See id.* at 835.

142. *See Hiram Walker & Sons, Inc. v. Penn-Maryland Corp.*, 79 F.2d 836, 835 (2d Cir. 1935).

143. *See id.*

144. *See id.* at 839.

faith on the part of the defendants and stated that because the defendant had no intention of utilizing the good name of the plaintiff to sell its own products, the burden shifted to the plaintiff to provide evidence that “‘Imperial’ and the certain whisky made by it had become synonymous to the buying public.”¹⁴⁵ In this case, the court differed with the *France Milling* court in that here, the court stated “Imperial” was “descriptive” and “generic”¹⁴⁶ whereas in *France Milling*, the court stated that “Gold Medal” was “suggestive” of merit.¹⁴⁷

The United States Court of Customs and Patent Appeals, in 1954, stated that the phrase “Consistently Superior” was laudatory or exclamatory, and the applicant seeking to register this phrase on the Principal Register of the United States Patent Office would need to have very convincing proof that the term had acquired distinctiveness under the Lanham Act; this mark did not meet that high burden.¹⁴⁸ The applicant had used “Consistently Superior” in conjunction with its bakery products since 1919 but did not file an application to register the phrase as a trademark until 1947.¹⁴⁹ The applicant advertised its products and the phrase in order forms, pamphlets, magazines, and on the side of the applicant’s trucks.¹⁵⁰

145. *Id.* at 839.

146. *See id.* at 837-38.

147. *See France Milling Co. v. Washburn-Crosby Co.*, 7 F.2d 304,306 (2d Cir. 1925).

148. *See Application of Duvernoy & Sons, Inc.* 212 F.2d 202 (C.C.P.A. 1954). 15 U.S.C.A. § 1052 states:

Except as expressly excluded . . . nothing herein shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant’s goods in commerce. The Commissioner may accept as prima facie evidence that the mark has become distinctive, as applied to the applicant’s goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years next preceding the date of the filing of the application for its registration.

Id.

149. *See id.* at 203.

150. *See id.* The court quoted approvingly from the Soliciter for the Patent Office: It is submitted that the evidence in the present case clearly fails to show that the primary purpose of the words ‘Consistently Superior’ was to indicate origin. There is no exhibit offered in which those words appear without the name of the appellant and, in most cases, the words are much less prominently displayed than the name. Thus, for example, on the wagons and trucks pictured . . . [in] the record, the name Duvernoy & Sons, Inc., always appears in bold letters,

Besides stating that the mark had not attained the pivotal distinctiveness, the court also held that “Consistently Superior” is a laudatory statement *incapable* of indicating the source of a good or service.¹⁵¹ Interestingly, the court did not mention the “descriptive”, “suggestive”, or “generic” designations in its opinion.¹⁵²

The 1960’s may have ushered in a change in American thinking, but the courts continued prodding along in their analysis of laudatory terms. The Murray Corporation of America opposed Red Spot Paint and Varnish Company’s application for a trademark of the term “Easytint” because the latter wished to use that term for white paint that was made to be mixed with other colors of paint, and the former had previously registered “Easy” for use with “[e]namel supplied in self-spraying containers for application to domestic laundry and other appliances”.¹⁵³ The question for the court was whether “Easytint” was sufficiently close to “Easy” so as to be likely to cause confusion to consumers.¹⁵⁴ At the outset, the court found “Easy” to be suggestive and that the plaintiff was not entitled to exclusive use of “Easy.”¹⁵⁵ Noting that the marks prod-

while ‘Consistently Superior’ is so small as to be almost illegible in some of the photographs. It is scarcely conceivable that anyone seeing such a wagon or truck could form the opinion that the words ‘Consistently Superior’ were relied on to inform the public as to the origin of the product.

Id. at 204.

151. *See id.*

152. *See id.* at 202-04.

153. *The Murray Corp. of America v. Red Spot Paint and Varnish Co.*, 280 F.2d 158, 159 (C.C.P.A. 1960).

154. *See id.*

155. *See id.* at 160-61. In reaching its conclusion, the court noted a number of third party registrations for paint products such as “Easycoat,” “Eze-Ply,” “Easy Way” and “Strikeasy”. *See id.* at 159 n.2. The court also surveyed the “1953 Trademark Directory” issued by the Trademark Bureau of the National Paint, Varnish and Lacquer Association, Inc. which included various marks such as “Easy,” “Easyflo,” “Easy-Kote,” “Easylac,” “E-Z-Cleen,” “E-Z-Duz-It,” “and “Ezy-To-Use.” *See id.* at 159 n.3. In noting the plethora of marks, the court stated:

In determining whether a word or syllable has a descriptive or suggestive significance as applied to merchandise it is proper to take notice of the extent to which it has been used in trademarks by others on such merchandise. If it has been frequently so used, the inference is warranted that it is not purely arbitrary; that it would be likely to be understood by purchasers as identifying or describing the merchandise itself, rather than the source thereof, and hence as having little or no trademark significance.

ucts were somewhat different and were sold through different channels, the court stated that no likelihood of confusion existed.¹⁵⁶ In 1962, the Second Circuit held that the phrase “Supreme” could not be protected absent a clear showing that the phrase had come to be regarded among consumers as indicative of the company’s vodka.¹⁵⁷ The appellant in this action was questioning the Patent Office Trademark Trial and Appeal Board, which sustained the appellee’s opposition to the appellant’s registration of the trademark “Supreme”.¹⁵⁸ The court stated that such expressions are “puffing of wares” which do not indicate of origin, are generally available to all companies, and therefore are not entitled

Id. at 392 (quoting *Shoe Corp. of Am. v. Juvenile Shoe Corp. of Am.*, 266 F.2d 793, 796 (C.C.P.A., 1959)).

156. *See id.* at 159-61. The factors used to determine likelihood of confusion are: (1) the strength of the plaintiff’s mark, (2) the degree of similarity between the plaintiff’s and the defendant’s marks, (3) the proximity of the products, (4) the likelihood that the plaintiff will ‘bridge the gap’ between the two products, (5) actual confusion between the two marks, (6) the defendant’s good faith in adopting its mark, (7) the quality of the defendant’s product(s), and (8) the sophistication of buyers of the plaintiff’s and defendant’s goods or services.

Sports Authority, 89 F.3d at 960 (citing *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir. 1961)); *see also* *Plus Prods. v. Medstet Modalities Assoc., Inc.*, 211 U.S.P.Q. 1199 (1981) (holding that “Zn-Plus,” “Mn-Plus,” and “Ca-Plus” for vitamin supplements were compound marks, suggestive in nature, and not in conflict with the opposer’s mark, “Plus,” also in the vitamin field); *Visa Int. Service Ass’n. v. E. Fin. Fed. Credit Union* 967 F.2d 596 (9th Cir. 1992) (holding that opposer’s mark for its network linking automatic teller machines, “Plus System”, was a weak and suggestive term, laudatory in nature, similar to Plus Product’s marks, and that Visa could not get a preliminary injunction preventing Eastern from using a “Money Plus” Mastercard); *Avtex Fibers Inc. v. Gentex Corp.*, 223 U.S.P.Q. 625 (T.T.A.B. 1984) (holding that “PFR Plus” is not merely descriptive, but rather suggests that the applicant’s fabrics contain something more than permanently flame retardant fibers and therefore, the term is registrable).

157. *See* *Supreme Wine Co., Inc. v. The Am. Distilling Co.*, 310 F.2d 888 (2d Cir. 1962). The court relied on *In re Lewis Cigar Mfg. Co.*, 95 U.S.P.Q. 224 (Pat. Off. 1952), which stated:

Section 23 of the [Lanham] Act does not prohibit the registration of a trademark merely because it is laudatory in character. However, Section 23 does require that the mark be of such a nature that it is capable of distinguishing applicant’s goods or services. From the above quoted definition of ‘Supreme’ it is seen that it is a common ordinary laudatory term which is available for use by producers of merchandise in various fields to advertise their products, and hence is incapable of indicating the source of origin.

Supreme Wine Co., 310 F.2d at 890.

158. *See id.* at 888-89.

to trademark protection.¹⁵⁹

In 1970, the United States Court of Customs and Patent Appeals, in *Roux Laboratories, Inc., v. Clairol Inc.*,¹⁶⁰ stated that the phrase “Hair Color So Natural Only Her Hairdresser Knows For Sure” was laudatory and “somewhat descriptive” of the desired qualities of the product but capable of acquiring distinctiveness as a trademark if it had acquired secondary meaning among consumers.¹⁶¹ Roux’s opposition to the registration of this term was based on a belief that it, like Clairol, was in the business of selling hair tinting products and that it had used certain descriptive terms in its advertisements.¹⁶² The court noted that Clairol had a very successful advertising campaign¹⁶³ which sufficiently hyped the slogan so that it served as a means by which consumers could identify the goods from a certain source.¹⁶⁴

Demonstrating that reversals of lower court decisions are not uncommon in laudatory mark analysis, the Patent Office Trademark Trial and Appeal Board, reversing the Examiner of Trademarks, held that “Super Iron” was suggestive and registrable because it either signified that the soil supplement contained a greater amount of iron than most soil supplements or contained iron of a higher quality than the iron found in other soil supplements.¹⁶⁵ The court distinguished this situation from one where the term

159. *See id.* at 889. The court relied on the test in *Hiram Walker* and stated that the applicant did not meet this burden of showing that the term had come to be associated with its products. *Id.*

160. 427 F.2d 823 (1970).

161. *See id.* at 828. The court found that Clairol’s large amount of advertising had made an impact in the public and the phrase could be registered. *See id.* at 829.

162. *See id.* at 824. Roux had used the following advertising copy in its ads: “only you and your hairdresser know where nature stopped and Roux began,” “to pick up where nature left off . . . [t]he essence of haircoloring is to look so natural that no one knows you used a cosmetic.” *See id.* at 824 n.3.

163. *See id.* at 825. The ads featured a large, color photograph of an attractive woman, often accompanied by a young child; the question ‘Does she . . . or doesn’t she?’ prominently imprinted on or above the photograph; the slogan ‘Hair Color So Natural Only Her Hairdresser Knows For Sure’ also conspicuously imprinted on or below the photograph, and set apart from the other portions of the advertisement. *See id.*

164. *See Roux Laboratories*, 427 F.2d 823, 831 (1970).

165. *See In re Occidental Petroleum Corp.*, 167 U.S.P.Q. 128 (T.T.A.B. 1970). The Examiner of Trademarks refused registration, stating that “‘super’ is variously defined as having the (specified) ingredient present in a large or unusually large proportion. . . .” *Id.*

“Super” is used in conjunction with the name of the applicant’s goods.¹⁶⁶ Further showing the uncertainty in the system is the decision of the Patent and Trademark Office Trademark Trial and Appeal Board in the *In re Ralston Purina Company* matter.¹⁶⁷ An application was filed to register “Ralston Super Slush,” “Slush” disclaimed, on the Principal Register for a concentrate that is used to make a slush drink.¹⁶⁸ The Examiner refused registration on the ground that “Super” when used in combination with goods, is solely an “adjectival superlative that merely describes a quality of applicant’s slush drink and therefore must be included in the disclaimer with the word “Slush”.¹⁶⁹ The Board stated that “whether a term or word is merely descriptive must be decided in relation to the goods or services for which registration is sought, the context in which it is used, and the average purchasers of such goods or services.”¹⁷⁰ After noting that the term “Super” had been held to be both descriptive and suggestive, the Board found that the term “Super” was heavily used in advertising as puffery and connotated a vague desirable quality that was not merely descriptive of the product it was associated with, a concentrate for making a slush type soft drink, the Examiner was reversed and registration was allowed.¹⁷¹

In a trademark infringement case in which the plaintiff’s corporate name was possibly being diluted, the First Circuit, in 1972, stated that “Valmor,” as applied to goods such as face powder, talcum powder, wigs and hair tonic, was suggestive of quality.¹⁷² Standard Products Corporation, the defendant, appealed from an order of the district court enjoining it from further use of “Valmor” in its beauty aid products, and canceling its registration of “Val-

166. *See id.*

167. 191 U.S.P.Q. 237 (T.T.A.B. 1976).

168. *See id.* at 237-38.

169. *See id.*

170. *See id.*; *see also* *In Re Crompton Co.*, 170 U.S.P.Q. 166 (T.T.A.B. 1971) (holding that the term “super Wle” for corduroy fabric is not merely descriptive, even though it is laudatory in nature).

171. *See Ralston Purina*, 191 U.S.P.Q. at 238.

172. *See Valmor Prods. Co. v. Standard Prods. Corp.*, 464 F.2d 200, 202 (1st Cir. 1972).

mor.”¹⁷³ Also, the court stated that although under some circumstances self-laudatory trademarks should not be registered or protected, the plaintiff, through forty-five years of advertising, had established a strong link between the mark and its products.¹⁷⁴

In *In re American Cynamid Company*,¹⁷⁵ the Patent Office Trademark Trial and Appeal Board, in 1973, found the phrase “The Premium Grade Malathion” capable of functioning as a trademark for an insecticide, and therefore the term could be registered on the Supplemental Register.¹⁷⁶ Hitting on a recurrent theme of reversing lower courts, the Board reversed the Examiner’s decision that the trademark was so descriptive as to be incapable of distinguishing the applicant’s insecticide from other similar products.¹⁷⁷ The Board noted that the phrase was laudatory but still capable of protection.¹⁷⁸ The Board was persuaded by the applicant’s showing of the mark’s conspicuous location on the labels of the product, the level of advertising, and affidavits from twenty one mosquito control officers from various parts of the country stating that they associate “The Premium Grade Malathion” with the applicant.¹⁷⁹ Recognize this case is different than the others above because the applicant sought to register the phrase on the

173. *See id.* at 201. The defendant’s registrations for “VALMOR,” canceled by the district court, were for a combination electric hair brush and massager, a cordless electric manicure set, an electric hair curling iron and similar other products. *Id.*

174. *See id.* at 202. The Appellate court held the district court’s finding that there was a likelihood of confusion (the federal statutory test of trademark infringement) not to be clearly erroneous. *See id.* at 203. The district court concluded that there was a “substantial likelihood of confusion in the minds of consumers as to the source of the various products sold under the Valmor name.” *Valmor Prods. Co. v. Standard Prods. Corp.*, 464 F.2d 200, 202 (1st Cir. 1972). This conclusion was based on findings that the products of the plaintiff and defendant were closely related in function, were advertised in similar places, appealed to the same consumer demographic and were sold in the same type of store. *See id.*

175. 176 U.S.P.Q. 350 (T.T.A.B. 1973).

176. *See id.* at 351. The test for whether something could be registered on the Supplemental Register is whether the mark could become recognized, through use in commerce, by the average purchaser or is distinctive of the applicant’s goods. *See OATHOUT*, *supra* note 4, at 82-83. Prior distinctiveness is not a prerequisite for registration of a mark on the Supplemental Register. *See id.*

177. *See American Cynamid Co.*, 176 U.S.P.Q. at 350-51.

178. *See id.*

179. *See id.* at 350.

more lenient Supplemental Register rather than on the Principal Register.¹⁸⁰

*Plus Products v. Redken Laboratories, Inc.*¹⁸¹ is a variation on the current theme because it discusses the protection that laudatory terms are afforded when these words are combined with other non-laudatory words. In *Plus Products*, the opposer of the registration had been using “Plus” as a trademark for cosmetics, vitamins preparations for the skin and hair, high protein products, and vitamins.¹⁸² The applicant applied to register “pH-Plus” for a successful line of cosmetic products that had been used for approximately five years under that name.¹⁸³ The “likelihood of confusion” issue turned on whether the simultaneous marketing of the various products of applicant and opposer with the “pH Plus” and “Plus” marks respectively, were likely to cause confusion.¹⁸⁴ After noting the plethora of marks for cosmetics and toiletries that contain the word “Plus”, the Appeal Board stated that highly suggestive terms, because of their prolific registration, have been given limited protection only for a “substantially identical designation and/or to the subsequent use thereof on substantially similar goods.”¹⁸⁵ The Board then stated that the addition of another term, whether suggestive or descriptive, to a highly suggestive or laudatory term, may be sufficient to distinguish between the two marks at issue.¹⁸⁶ In this case, the court said it was a very close call whether “pH” could distinguish in this manner because the products at issue were very similar.¹⁸⁷ In holding that “pH-Plus” was not primarily descriptive of the applicant’s goods, the Board heavily relied on the amount of sales and advertising accruing to the applicant and then

180. *See id.*

181. 199 U.S.P.Q. 111 (T.T.A.B. 1978).

182. *See id.* at 112.

183. *See id.* at 113.

184. *See id.* at 114. The Board stated that the suggestive connotation of “Plus” is the exact reason why the applicant, opposer, and others in various fields have utilized and/or registered as trademarks designations that contain the word “Plus”. *Id.* at 115. However, the Board reiterated that these other valid registrations will not validate the applicant’s mark if it would be confusingly similar to another mark. *See id.*

185. *Id.* at 116. Marks registered included “Beauty Plus,” “Plus 30,” “Color Plus,” “K-Plus,” and “Iron Plus.” *Id.* at 115.

186. *See id.* at 116-17.

187. *See id.* at 117.

concluded that for those people exposed to the advertising of the applicant, “pH-Plus” served as an indication of source.¹⁸⁸ The Board primarily looked to the applicant’s large sales volume to find that there was no likelihood of confusion.¹⁸⁹

The Patent and Trademark Office Trademark Trial and Appeal Board, when deciding *In Re Wileswood, Inc.*,¹⁹⁰ stated that its task was to determine “whether ‘America’s Best Popcorn!’ and ‘America’s Favorite Popcorn!’ . . . are merely suggestive of high quality . . . , and thus registrable . . . or are so laudatory and lacking in the ability to distinguish applicant’s goods . . . as to be unregistrable.”¹⁹¹ The applicant claimed that to be unregistrable under the Act, the mark must be ‘only’ descriptive of the goods.¹⁹² Furthermore, the applicant argued that the mark as a whole must be weighed and that these marks were “attention getting, tongue-in-cheek, self-laudatory, or boastful designations or characterizations of its popcorn” which could not be literally true because no one could objectively measure this popcorn against all others.¹⁹³ The Board stated that the meaning of the marks must incorporate the goods which they are linked with, the context these expressions are used, the relevance of the marks in relation to the goods, and the probable reaction of consumers to the phrases as these phrases are perceived in the market.¹⁹⁴ No advertising expenditures were included in the record though the Board noted that the products were sold in only three retail outlets.¹⁹⁵ Since the Board found that the terms were laudatory and descriptive, it held that proof of secondary meaning was required in order to register these term.¹⁹⁶ Following the rationale of McCarthy’s treatise,¹⁹⁷ the Board further

188. See *Plus Prod. v. Redken Lab., Inc.*, 199 U.S.P.Q. 111 (T.T.A.B. 1978). The term “pH” was disclaimed as a measure of acidity or alkalinity. *Id.*

189. See *id.*

190. 201 U.S.P.Q. 400 (1978).

191. See *id.* at 401.

192. See *id.* at 400; 15 U.S.C.A. § 1052(e).

193. See *id.* at 400-01.

194. See *id.* at 401.

195. See *In Re Wileswood, Inc.* 201 U.S.P.Q. at 401-02.

196. See *id.* at 404. The Board looked to an earlier case that canceled that registration on the Supplemental Register of “America’s Finest” for overalls. See *Kotzin v. Levi Strauss & Company*, 111 U.S.P.Q. 161 (1956).

197. See 2 MCCARTHY, *supra* note 3, § 11:18.

stated that because a descriptive term merely informs the consumer of the supposed quality of a product, and many products have similar qualities, the descriptive term will not assist the consumer in differentiating products of different producers.¹⁹⁸ The Board cited BEST for writing paper and TASTY for bread as examples of terms that are laudatory *and* informative, stating that the information conveyed is the vendor's claims for its wares.¹⁹⁹ Refusal of registration was affirmed.²⁰⁰

The issue of how a laudatory mark can change over time was discussed in *20th Century Wear, Inc. v. Sanmark-Stardust Inc.*,²⁰¹ in which the Second Circuit reversed the district court and held that "Cozy Warm Energy Savers" was a descriptive term with a meaning that had changed over time.²⁰² The plaintiff was in the business of selling women's pajamas and nightgowns to retailers, mail order and discount houses.²⁰³ The defendant, located in the building next to the plaintiff's, sold these same items as well as many other clothing items.²⁰⁴ The plaintiff's garments came in plastic bags which contained various inserts, one stating in bold print "Cozy Warm ENERGY SAVERS" in white with the trademark notice attached.²⁰⁵ The mark was accepted by the Trademark Office on the condition that 20th Century, the plaintiff, disclaim exclusive use of "cozy" and "warm" apart from the registered

198. *See In re Wileswood, Inc.*, 201 U.S.P.Q. at 402.

199. *See id.* at 402-04. *See also* *Burmel Handkerchief Corp. v. Cluett, Peabody & Co.*, 127 F.2d 318, 29 C.C.P.A. 1024 (1942) (holding "Handkerchiefs of the Year" invalid). The court explained:

In the final analysis such expressions as we are discussing with relation to objects of trade are a 'puffing of wares' and are intended to call attention to the superiority of the advertised goods. Such expressions are a condensed form of describing in detail the outstanding character or quality of the objects to which they are applied . . . [C]ommon expression[s] which can indicate nothing but high quality surely would not be indicative of origin to the purchasing public.

Id.; *In re Nat'l. Tea Co.*, 166 U.S.P.Q. 288 (T.T.A.B. 1970) (holding the expression "Smackin Good" as applied to food products was similar to "delicious" and merely descriptive of the quality of the goods).

200. *See id.* at 404.

201. 747 F.2d 81 (2d Cir. 1984), *cert denied*, 470 U.S. 1052 (1985).

202. *See id.* at 87.

203. *See id.* at 85.

204. *See id.* at 85.

205. *See id.*

mark.²⁰⁶ Just a few months after registration, defendant began selling pajamas and nightgowns using a tag containing the words “Cozy Warm CONSERVES-ENERGY.”²⁰⁷ The writing was quite similar to 20th Century’s.²⁰⁸ The Second Circuit stated that before the energy crisis in the 1970’s, the mark would have been considered suggestive, but in 1984, the term was merely descriptive of the product and needed secondary meaning to be protected.²⁰⁹ The Second Circuit stated that as a result of the energy crisis in the 1970’s, numerous clothing vendors began using terms such as “energy saving” and “cozy warm” to push the acceptance of their products.²¹⁰ This led to a well-informed public, the court continued, so that consumers could readily link the term to the virtues of the product.²¹¹ The Second Circuit also stated that a term can be descriptive in two ways—“[i]t can literally describe the product, or it can describe the purpose or utility of the product.”²¹² The case was remanded so that the district court could look into secondary meaning.²¹³

In 1986, the Patent and Trademark Office Trademark Trial and Appeal Board dealt with a foreign translation issue when it upheld the decision of the Examining Attorney and refused to register the term “Selecta” for a beer.²¹⁴ The Board rejected the applicant’s

206. See *20th Century Wear*, 747 F.2d at 85.

207. See *id.* at 85-6.

208. See *id.* at 86.

209. See *id.* at 88.

210. See *id.*

211. See *20th Century Wear, Inc. v. Sanmark-Stardust Inc.*, 747 F.2d 81, 88 (2d Cir. 1984), *cert denied*, 470 U.S. 1052 (1985).

212. See *id.*; see also RUDOLF CALLMANN, *THE LAW OF UNFAIR COMPETITION, TRADEMARKS AND MONOPOLIES* § 18.05 (4th ed. 1983). Under the first branch, “if qualities, ingredients, effects or other features of the product are indicated naturally and in ordinary language, so that the consumer understands its significance without any exercise of the imagination, the words are descriptive.” *Id.* Under the second strand, Callmann explains three subcategories of marks that describe the product’s purpose or utility: “(1) marks describing the problem or condition that the trademarked product is designed to remedy . . . ; (2) marks that describe the use to which the product or service is put; and (3) marks that describe the effect that the product or service is suppose to produce after it is used.” 747 F.2d at 88 (citing CALLMANN § 18.05).

213. See *20th Century Wear*, 747 F.2d at 90.

214. See *In Re San Miguel Corporation*, 229 U.S.P.Q. 617 (T.T.A.B. 1986) (refusing registration on the ground that SELECTA was merely descriptive of the beer.)

position that the mark, the Spanish term for “Select”, would not be translated to “Select” by the average beer purchaser and therefore would be viewed as an indication of origin.²¹⁵ Using the doctrine of foreign equivalents, under which the foreign words are translated into their English equivalents and then tested for descriptiveness or genericness, the Board concluded that the term was “laudatorily descriptive.”²¹⁶

Ringling Bros.-Barnum & Bailey Combined Shows sued to protect their slogan, “The Greatest Show on Earth”.²¹⁷ Ringling Bros., the owner of the trademark, obtained a preliminary injunction from the lower court, that was affirmed by the Seventh Circuit, against the defendant’s car dealership that ordered the defendant to cease using the phrase “The Greatest Used Car Show On Earth”.²¹⁸ The district court had found that the Ringling Bro.’s mark was descriptive and weak, but also believed that the mark had become associated with the famous circus.²¹⁹ The Seventh Circuit found that the defendant, by utilizing big red circus-styled lettering, attempted to use the slogan in a way that was designed to evoke the circus.²²⁰ Moreover, the Seventh Circuit found that protecting the Ringling Bros. mark would not be the equivalent of granting Ringling Bros. a monopoly over other laudatory slogans.²²¹ The “final straw” was the court’s finding that the defendant did not act in good faith when it first used its slogan.²²²

In 1989, the Court of Appeals for the Federal Circuit reversed the Trademark Trial and Appeal Board and held that “Deluxe” for canned pork and beans could be registered on the Supplemental Register, because it was capable of becoming distinctive through

215. *See id.* at 618.

216. *See id.* “Select” had been disclaimed on the applications of beer producers in the past (i.e. Stroh’s and Koehler). In addition, the Board noted that numerous third parties outside the business industry had used this term in their marks to describe the alleged high quality of their product. *Id.*

217. *See Ringling Bros.-Barnum & Bailey Combined Shows, Inc. v. Celozzi-Ettelson Chevrolet, Inc.*, 855 F.2d 480 (7th Cir. 1988).

218. *See id.* at 481.

219. *See id.*

220. *See id.* at 482.

221. *See id.* at 482-83.

222. *See Ringling Bros.*, 855 F.2d at 484.

use in commerce, even though the term is merely descriptive and could not be registered on the Principal Register.²²³ The Court admitted that the term is generally a laudatory one, but “laudation is not inimical to a term’s capability of functioning as a trademark.”²²⁴ The term did not describe a particular grade of canned pork and beans.²²⁵ The Court went on to state that first, the C.C.P.A. has previously described “Deluxe” as “obviously suggestive” and “descriptive.”²²⁶ Second, “Deluxe” was used in many trademarks and trade names.²²⁷ Lastly, the capability of “Deluxe” to function as a trademark is shown by the many registrations of the term for various food products.²²⁸ The Board had argued first, that “Deluxe” is not a common descriptive name for canned pork and beans containing bacon and brown sugar and second, does not signify anything other than a “vaguely desirable characteristic”.²²⁹ However, the Federal Circuit relied on previous registrations for “Deluxe” and held that because of the lenient requirements of the Supplemental Register, the applicant had a right to register the mark there.²³⁰

The Second Circuit, in a case mentioned in the Introduction, recently dealt with the issue of a numeric term, “100%”, as a

223. See *In re Bush Bros. & Co.*, 884 F.2d 569 (Fed. Cir. 1989); 15 U.S.C.A. § 1052(f) (providing that five years of exclusive and continuous use as a mark may be deemed prima facie evidence of secondary meaning.); see also *supra* note 176, for a discussion of the Supplemental Register; *In re Wella Corp.*, 565 F.2d 143, 144 (C.C.P.A. 1977) (stating that “descriptiveness alone does not necessarily preclude registration on the Supplemental Register.”), quoted in *Bush Bros.*, 884 F.2d at 570. The Bush Brothers court noted that generally, courts have not scrutinized potential applications for registration on the Supplemental Register because obtaining registration on this Register is very liberal. *Id.* at 570.

224. 884 F.2d at 572. The Court relied on *In re Ralston Purina*, 191 U.S.P.Q. 237 (T.T.A.B. 1976), *In re Am. Cynamid*, 176 U.S.P.Q. 350 (T.T.A.B. 1973), and *In re Occidental Petroleum*, 167 U.S.P.Q. 128 (T.T.A.B. 1970). *Id.*

225. See 884 F.2d at 572. The applicant’s canned pork and beans contained bacon and brown sugar. See *id.* at 571-72.

226. See *id.* The Court noted that “Deluxe Choice” for pasteurized processed cheese and “Creamy Deluxe” for frostings (with a disclaimer for creamy) have been registered on the Principal Register. *Id.*

227. See *id.*

228. See 884 F.2d, at 572.

229. *Id.*

230. See *id.*

laudatory mark.²³¹ Both the plaintiff, Estee Lauder, and the defendant, The Gap, were planning on using “100%” as part of their trademark and in conjunction with their respective skin care products.²³² Estee Lauder beat The Gap to the market and sued to prevent The Gap from using this term on its products.²³³ The Southern District of New York found that Lauder’s “100%” mark was suggestive and therefore protectable because the term “100%” had no particular meaning, but rather suggested an idea of quality.²³⁴ New York’s Southern District also found that “100% Time Release Moisturizer”, the full name of Lauder’s product, was suggestive in nature.²³⁵ The Second Circuit agreed that 100% was suggestive and stated “[a] term that is merely self-laudatory, such as ‘plus’ or ‘super,’ seeking to convey the impression that a product is excellent or of especially high quality, is generally deemed suggestive.”²³⁶ Additionally, the court noted that marks should be looked at in context, rather than in the abstract.²³⁷ When looking at the mark in context, the Court determined that because “100% Time Release Moisturizer” had a few possible meanings, the term was suggestive and protected without any analysis of secondary meaning.²³⁸ However, the court found that because there was no likelihood of confusion among ordinarily prudent consumers, Estee Lauder was not entitled to relief.²³⁹ The Court implied that nu-

231. See *Estee Lauder Inc. v. The Gap, Inc.*, 108 F.3d 1503 (2d Cir. 1997).

232. *Id.* at 1506.

233. *Id.* at 1506-07.

234. See *Estee Lauder, Inc. v. The Gap, Inc.*, 932 F. Supp. 595, 608 (S.D.N.Y. 1996), *rev’d on other grounds*, 108 F.3d 1503 (2d Cir. 1997).

235. See *id.* at 609. The court said the phrase “100% Time Release Moisturizer” could be interpreted three ways: “(1) this bottle contains nothing but time release moisturizer, (2) this product moisturizes 100% of the time, and (3) this is 100% (the brand) time release moisturizer . . .” *Id.*

236. *Estee Lauder*, 108 F.3d, at 1509. See, e.g., *Plus Prods. v. Plus Discount Foods, Inc.*, 722 F.2d 999, 1005 (2d Cir. 1983) (“‘PLUS,’ when applied to goods, ‘merely implies additional quantity or quality’”); cited in *Estee Lauder*, 108 F.3d at 1509; In re Ralston Purina Co., 191 U.S.P.Q. at 237-38 (“‘SUPER,’ when used to ‘connote a vague desirable characteristic or quality allegedly connected with [a] product,’ is suggestive”) cited in *Estee Lauder*, 108 F.3d at 1509.

237. *Estee Lauder*, 108 F.3d at 1509.

238. See *id.* at 1510.

239. See *id.* at 1510-12. The Second Circuit found that the “100%” in both products were (1)dissimilar in appearance; (2)the packaging was different; (3)”100” is not original; 4)the products are sold in different stores; (5)Estee Lauder’s product would be priced

merical terms, if used in a vague, non-arbitrary way and not used because an attribute was actually measured or tested, are in danger of not being protected by the Lanham Act.²⁴⁰ It has been suggested that the court may have been making a distinction between “laudatory terms that describe some quality of a product . . . which it would deem ‘descriptive’ - and those laudatory terms that merely assert high-quality generally regardless of the product or service . . . which it would deem ‘suggestive’.”²⁴¹

The final case discussed in this Part, *Platinum Home Mortgage Corp. v. Platinum Financial Group, Inc.*,²⁴² shows that the analysis of courts is no better now than it was many years ago. In this matter, the plaintiff, an offeror of mortgage services, sought a preliminary injunction to keep the defendant, another offeror of mortgage services, from using “Platinum” in its name.²⁴³ The Seventh Circuit stated that under the common law, terms denoting quality were protectable only upon a showing of secondary meaning.²⁴⁴ The lower court explained that the rationale for labeling these terms as descriptive is that “adjectives which can be truthfully applied to a whole range of goods and services cannot identify the goods of one particular firm.”²⁴⁵ Similar to the court in *20th Century*, the lower court stated that words indicating quality often see their meanings

almost twenty times more than the Gap’s; (6)Estee Lauder does not plan to enter Gap’s market; and (7)and that the Gap did not act in bad faith. *Id.* at 1512.

240. 15 U.S.C.A. § 1125(A) (West 1998). Lauder’s vice president of skin care marketing decided to use “100%” as the trademark “because it would suggest to consumers certain attributes of” the product—its long lasting quality and the notion that it is the best such product available. *See* 932 F. Supp. at 599.

241. Dawn Marie Bottie, *Marketer v. Lawyer: Age-Old Tension Resurfaces in Gap 100% Case*, 3 INTELL. PROP. STRATEGIST 8, (May 1997).

242. 149 F.3d 722 (7th Cir. 1997).

243. *See id.* at 725. Both parties offered their services in Illinois.

244. *See id.* at 728; *see also* *Platinum Home Mortgage Corp. v. Platinum Fin. Grp., Inc.*, No. 97 C 5293, 1997 WL 567909, at *2 (N.D. Ill. Sep. 5, 1997), *aff’d* 149 F.3d 722 (citing *In re Bush Bros.*, 884 F.2d 569 (Fed. Cir. 1989); *Plus Products v. Plus Discount Foods*, 722 F.2d 999 (2d Cir. 1983); *Hiram Walker & Sons v. Penn-Maryland Corp.*, 79 F.2d 836 (2d Cir.1935)).

245. *See Platinum Home Mortgage Corp.*, 1997 WL 567909, at *2 (citing 2 MCCARTHY ON TRADEMARKS § 11:18). The Seventh Circuit stated “Platinum” describes the quality of the plaintiff’s services but the term does not identify one particular source or origin of these services. *See Platinum*, 149 F.3d at 728.

change over time and across cultures.²⁴⁶ Furthermore, the lower court stated that once, people thought of “Platinum” primarily to describe jewelry or metal, but today people think of the term as indicating excellence; it may be truthfully applied to many goods and services.²⁴⁷ Agreeing with the lower court, the Seventh Circuit concluded that the term was descriptive, and that “Platinum” described the quality of the plaintiff’s business and needed secondary meaning to be protected, connection that could not be found.²⁴⁸

III. LAUDATORY TERMS ARE LITERALLY SUGGESTIVE, NOT DESCRIPTIVE, YET SHOULD NOT BE PROTECTED UNDER THE LANHAM ACT ABSENT SECONDARY MEANING

In this last section of this piece two general arguments will be championed. It will first be shown that laudatory terms, despite often being treated in a legal sense as if they were descriptive, are in fact suggestive of the products they represent. By employing a broad definition of “descriptive,” it can be shown that the terms discussed throughout this piece do not come within the definition. It will also be posited that secondary meaning should be found before these terms can be protected. In this context, many of the courts’ decisions and/or rationales will be critiqued. Lastly, a simple solution will be proposed that should help the courts successfully cope with the laudatory term issue.

A. *Laudatory Terms, No Matter How One Slices Them, Do Not Describe Anything*

Though Professor McCarthy states that laudatory terms are descriptive,²⁴⁹ this can be quickly disproved by an analysis into the actual meaning of “descriptive.” It can be shown that laudatory terms are not “descriptive” by stating the broadest definition of “descriptive” found and then showing that even this inclusive definition is not adequate to keep the laudatory terms discussed above within its grasp. The definition provided by Rudolf Callmann will

246. See *Platinum Home Mortgage Corp.*, 1997 WL 567909 at *2-3.

247. See *id.*

248. *Platinum*, 149 F.3d at 728-29.

249. See 2 MCCARTHY, *supra* note 3, § 11:17.

be used: a term can be descriptive in two ways—"[i]t can literally describe the product, or it can describe the purpose or utility of the product."²⁵⁰ Callmann breaks down "descriptive" into two segments. Under the first branch, "if qualities, ingredients, effects or other features of the product are indicated naturally and in ordinary language, so that the consumer understands its significance without any exercise of the imagination, the words are descriptive."²⁵¹ Under the second strand, Callmann explains three subcategories of marks that describe the product's purpose or utility.²⁵² First, "marks describing the problem or condition that the trademarked product is designed to remedy."²⁵³ Second, "marks that describe the use to which the product or service is put."²⁵⁴ Last, "marks that describe the effect that the product or service is suppose to produce after it is used."²⁵⁵

Beginning with the first branch, the laudatory terms discussed above do not describe a quality of the product. A quality of a product is an attribute of a product that someone can pin down or recognize and declare unequivocally, "this apple is green" or "this tomato sauce is thick." Ah, you say, but who is to judge whether the sauce (Sauce X) is thick or not. Perhaps mom made the thickest sauce around and even though sauce X is probably the thickest on the market, mother's loving children believe it is not up to snuff. This is a good point—but an irrelevant one for the argument. It is clear that thickness can be judged on a scale, a make-believe "thickometer," or even by a simple comparison with the help of a strainer. The thickness measurement, in comparison to terms such as "Blue Ribbon"—assuming that no prize was ever won, "Imperial," and "Supreme," is precise. These latter three terms do not describe an attribute or a quality of a product, and hence, would be next to impossible to measure.

Also, the laudatory terms listed in the preceding paragraph do

250. 747 F.2d 81, 88 (2d Cir. 1984); *see also* CALLMANN, *supra* note 211, §§ 18.04, 18.05 (discussing the 20th Century Wear Inc. precedent).

251. CALLMANN, *supra* note 211, § 18.05.

252. *Id.*

253. *Id.*

254. *Id.*

255. *Id.*

not describe an ingredient of a product. In the sauce example, tomato would be descriptive of an ingredient in the sauce—no tomato, no sauce. Hence, labeling the sauce tomato-like would be descriptive of the sauce under anyone's definition. Attempting to say that imperialness or supremacy is an ingredient of the sauce would be nonsensical.

Next, the effects of the product cannot be described by the laudatory terms discussed earlier. An effect of a product can be explained by an aspirin which will affect the body's blood flow and hopefully, the headache. If the tomato sauce is very spicy, it will make one's mouth burn. If a product is "supreme" it will not have a predictable effect. It is not possible for a product to "supreme" my mouth or "imperialize" me. Hence, laudatory terms, do not indicate effects in "natural and ordinary language". It is necessary then, to analyze the second branch of the operative definition.

The last part of the first branch of Callmann's definition mentions "other features." Because Callmann introduces the first branch of his definition with the word "literal," it appears clear that these "other features" are meant to be interpreted as attributes that can be seen or measured in some way. A literal feature of Sauce X might be its thickness or color. It most definitely would not be its imperialness or its supremacy. Therefore, laudatory terms, represented by the few noted above, do not meet the first branch of Callmann's "descriptive" definition because they do not describe qualities, ingredients, effects, or other features of a product in natural and ordinary language.²⁵⁶

The second branch of Callmann's definition of descriptiveness can be disposed of as well. The first of the three subcategories under this strand of the definition are "marks that describe a problem or condition that the trademarked product is designed to remedy."²⁵⁷ A mark such as "Headache-Gone" or "So-Long Bad Breath" might satisfy this requirement. It is clear, for instance, that "Super Iron," "Plus," and "America's Best" do not describe a problem that the good or service can cure. The second part of this

256. See CALLMANN, *supra* note 212, § 18.05.

257. *Id.*

strand of the definition of descriptiveness relates to the uses to which the product can be put. “Super Iron,” “Plus,” and “America’s Best” do not meet this requirement. None of these terms, by itself, describe how a product can be used to satisfy a need. All three terms are too general and vague to be pinned down in this fashion.

The last hurdle set up by Callmann’s definition is his statement that “marks that describe the effect that the product or service is suppose[d] to produce” are “descriptive.”²⁵⁸ Could someone feel more “Plus” today than he or she did yesterday? It would be highly unlikely. In addition, it is a virtual certainty that someone could not possibly feel more “Imperial” or “Supreme” as a factual matter. Perhaps, after eating the top quality sauce, one will feel like he or she is part of the “in” crowd, but this emotion is not aptly stated in the laudatory terms I have mentioned above. Once, again, these terms are too vague to be applied in this manner. By utilizing a very broad definition of “descriptive” and showing that laudatory terms do not fall within its reach, the concept of suggestiveness must be examined to see if these terms fit nicely into its arms.

B. *Laudatory Terms Generally Suggest the Desired Attributes of the Products they are Associated With*

A term is suggestive if it necessitates imagination, thought and perception to reach a conclusion as to the nature of the goods.²⁵⁹ Scrutinizing terms such as “Gold Medal”, “Imperial”, “Plus,” “Super”, “Select,” “Deluxe,” “Greatest Show” and “100%”, what comes to mind is a bit unclear . . . but that is exactly the point. It takes a little thought to figure out what these terms imply. Perhaps “Plus” implies that the product has more of some ingredient or that the product is of a higher quality than the average product. Each idea is possible yet neither idea is a sure bet.²⁶⁰ “Select” seems to

258. *Id.*

259. *See* *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 11 (2d Cir. 1976) (quoting *Stix Products, Inc. v. United Merchants & Mfrs., Inc.*, 295 F. Supp. 479, 488 (S.D.N.Y. 1968); *20th Century Wear, Inc. v. Sanmark-Stardust Inc.*, 747 F.2d 81, 87 (2d Cir. 1984); LONG, *supra* note 49, at 49.

260. *See* *Estee Lauder*, 108 F.3d at 1509.

imply high quality. Rightfully, this is what most people would think when they see “Select” as a mark. What kind of high quality is a different story. What is good for the goose may not be good for the gander. Again, it is the perception of the consumer that is all important. To one consumer, “Deluxe” may be interpreted as “this product” contains more ingredients than other such products. To another consumer, “Deluxe” may be associated with higher quality ingredients or service. One consumer may associate “100%” with powerful ingredients or effects while another may interpret the same term to mean a certain purity level exists. With a suggestive term, as opposed to a descriptive term, the producer of the product is allowing more freedom for the consumer to perceive the product in her own way. With a descriptive term, the product name is more likely to tell the potential customer what the product is all about, therefore, leave the customer with little to imagine.

Laudatory terms, says professor McCarthy, are meant to imply high quality and to impart an intangible expectation about the product.²⁶¹ This explanation seems to point in the “suggestive” direction. However, professor McCarthy then states that “[s]elf-laudatory or ‘puffing’ marks are regarded as a condensed form of *describing* the character or quality of the goods and that they can *describe* some intangible facet of a product.”²⁶² It is posited that professor McCarthy’s view that a laudatory term can *describe* some intangible facet of a product is misplaced. It is put forth that laudatory terms can only *suggest* these aspects of goods or services. McCarthy’s definition appears to be at odds with Callmann’s definition because Callmann’s “qualities” need to be indicated in “natural and ordinary language” so that the consumer can understand the significance of the mark.²⁶³ Once the qualities of a product have been condensed into a vague laudatory term to describe them, some amount of imagination is required on the part of the consumer to decipher the appropriate, if there is one, meaning of the term. If this task is done correctly, it is somewhat time consuming and often inaccurate. Callmann’s definition seems to

261. See 2 MCCARTHY, *supra* note 3, § 11:17.

262. *Id.*; see also *Burmel Handkerchief Corp. v. Cluett, Peabody & Co.*, 127 F.2d 318 (C.C.P.A. 1942).

263. See CALLMANN, *supra* note 212, § 18.05.

imply that qualities are tangible in his analysis and this is why they can be explained by simple language.²⁶⁴ Because it is championed that laudatory terms cannot properly describe a product or describe an “intangible facet” of a product, McCarthy’s definition appears flawed, and for that reason, it is believed that Callmann’s definition is more accurate and broader than McCarthy’s.

Furthermore, I have yet to see a definition of “suggestive” that states a *substantial* amount of imagination is required on the part of the consumer.²⁶⁵ Only *some* imagination appears necessary—a low threshold to surmount. A definition of “suggest” will strengthen the argument: to bring before a person’s mind indirectly or to call something up in the mind through association or natural connection of ideas.²⁶⁶ This definition does an admirable job of capturing what laudatory terms are designed to do. These terms are vague terms that try to aid or perhaps confuse the consumer in thinking about a product a certain way. The maker of “Coppertone” tanning products clearly wished to convey the idea that the product will help yield the skin a healthy glow. The manufacturer of “Kickers” is well aware that this term will conjure up images of shoes. If one owns an “Accuride” drawer slide mechanism, one should expect that the product will perform the same way each time it travels along its path.

C. *The Laudatory Term Case-Law Has Been Inconsistent*

Many of the cases mentioned throughout this paper can be critiqued because they have often mischaracterized the laudatory marks as being descriptive. The first case mentioned in Part II, *Beadleston*,²⁶⁷ contained a clear analysis of the purposes of trademark law,²⁶⁸ However, the court erroneously stated that “Impe-

264. *See id.*

265. *See* *Estee Lauder Inc. v. The Gap, Inc.*, 108 F.3d 1503, 1509 (2d Cir. 1997); *Gruner + Jahr USA Publ'g v. Meredith Corp.*, 991 F.2d 1072, 1076 (2d Cir. 1993).

266. THE RANDOM HOUSE COLLEGE DICTIONARY 1314 (rev. ed. 1984).

267. *Beadleston & Woerz v. Cooke Brewing Co.*, 74 F. 229 (7th Cir. 1896).

268. *See id.* at 230-231. The court discussed consumer confusion, good faith on the part of the defendant, and trademarks as tools that set one producer’s goods apart from those of others. *Id.*

rial” was descriptive of the beer.²⁶⁹ The court fell into this trap because the plaintiff manufactured beers of different qualities. Nonetheless, the fact the plaintiff manufactured different grades of beers, does not add very much to the descriptive quality of the beer that was put in this particular can. “Imperial”, it is admitted, can suggest the relative quality of the beer compared to other beers—this is a matter of taste of course, but the plaintiff is not registering the trademarks for three of its beers at the same time. Though the context of a term is studied when deciding registration, it is doubtful that any comparison between beers is taken into account when determining the registerability of the term. There may be perquisites associated with a Seventh Circuit Judge position but taste tests probably are not among them. Consequently, “Imperial” says very little about the qualities of the beer. Likewise, the *Hiram Walker* court used the term “descriptive” when discussing “Imperial”.²⁷⁰ By stating that “Imperial” meant high quality, the court reasoned how the proponent of the mark wished the purchasing public to reason. However, until “imperialness” can be measured, the phrase is vague and merely suggestive. As previously stated, “Imperial” *describes* nothing, it only *implies* high quality.

Next, when the Board analyzed “America’s Favorite Popcorn” and “America’s Best Popcorn”, it stated the terms were laudatory *and* descriptive of the popcorn, which made the phrase informational.²⁷¹ This last statement is incorrect in all but the laudatory label. The Board was, though, accurate in determining that, because no secondary meaning existed with respect to the popcorn product, refusal of registration was proper.²⁷² Ironically, if it was possible to determine whether this was America’s favorite popcorn, and if that were answered in the affirmative, then perhaps the term would be descriptive and not entitled to registration—a penalty for making a superior snack item.

Furthermore, “Smackin’ Good” is not descriptive, but rather suggestive. The Board was incorrect in labeling the term descrip-

269. *See id.* at 231.

270. *See Hiram Walker*, 79 F.2d at 837-38.

271. *See In re Wileswood, Inc.*, 201 U.S.P.Q. 400, 404 (T.T.A.B. 1978). Because, the popcorn was sold only in a few stores, the phrase seems ridiculous.

272. *See id.* at 404.

tive in *In re National Tea Co.*²⁷³ Obviously, no one gets smacked when tasting the tea. Perhaps the tea has a crisp taste, not unlike a crisp smack across the face, if such a comparison can be made. In addition, the “goodness” of the product is advertised even though this characteristic, if it is one, is not measurable. Likewise, “Selecta” is suggestive and not descriptive, but the Board incorrectly determined that the term was descriptive.²⁷⁴ “Select” may imply that the product or its ingredients are chosen from a plethora of choices. It may also imply that the product is relatively better than other products on the market, whether from other producers or even the producer of the “Select” brand.

The *In re Occidental Petroleum* Board was correct in stating that “Super Iron” was suggestive of a large quantity of iron, but was remiss in not analyzing the secondary meaning issue.²⁷⁵ After correctly, but quickly, deciding the descriptive/suggestive issue, the Board apparently found it easy to conclude that the mark was worthy of protection—simply because the phrase was suggestive. Perhaps the Board decided too easily that registration was proper. Labeling “Super” suggestive was also the proper way to proceed in determining whether or not to allow registration for the term “Super Slush”.²⁷⁶ However, as in *Occidental Petroleum*, the Board quickly decided that registration was appropriate and was careless in omitting a discussion of secondary meaning.

With the *Platinum Home Mortgage* decision, it is apparent that the court erred in labeling “Platinum” descriptive of the plaintiff’s services. According to the liberal definition of “descriptive” given above, this term clearly does not fall within its realm. On the contrary, the term suggests excellence or high quality, or some other special feature that the vendor possesses. Thus the court erred when it noted that this term could be “truthfully applied to a whole range of goods and services.”²⁷⁷ There is nothing truthful about this term as it relates to mortgages. Platinum and mortgages have

273. 166 U.S.P.Q. 288 (T.T.A.B. 1970).

274. See *In re San Miguel Corporation*, 229 U.S.P.Q. 617 (T.T.A.B. 1986).

275. See *In re Occidental Petroleum*, 167 U.S.P.Q. 128 (T.T.A.B. 1970).

276. See *In re Ralston Purina*, 191 U.S.P.Q. 237, 238 (T.T.A.B. 1976).

277. See *Platinum Home Mortgage Corp. v. Platinum Fin. Grp., Inc.*, No. 97 C 5293, 1997 WL 567909, at *2 (N.D. Ill. Sep. 5, 1997), *aff’d* 149 F.3d 722.

nothing to do with each other. Loosely using terminology such as “truthful,” is dangerous for a court’s thinking because it confuses what should be suggestive terms with descriptive ones, with the resulting change in analysis. Having said this, the term Platinum is a not a poor choice for the name of a business because it seems just as arbitrary or suggestive as it does descriptive. It therefore should have been protected from another firm in the same business using the same name because customer confusion would likely result. The user of the name “Platinum” should not expect this name to be protected against firms using the name outside the mortgage industry because customer confusion would be unlikely.

Fortunately, some courts have understood the dilemma when analyzing laudatory terms.²⁷⁸ Both the *Pabst Brewing* and *France Milling* cases seem to be close to the championed theory in their analysis’. Both cases implied that the marks at issue, “Blue Ribbon” and “Gold Medal” respectively, were indicative or suggestive of quality and only worthy of protection if consumers would be confused as to the source of the product.²⁷⁹ Neither court claimed that the term at issue was descriptive.²⁸⁰ This is accurate because the two terms suggest high quality and nothing more. The plaintiff in *Pabst*, never earned a blue ribbon as far as we can tell, and the plaintiff in *France Milling*, though garnering a Gold Medal during the Louisiana Purchase Exposition at St. Louis in 1904, could not claim that its pancake and buckwheat possessed some “gold-medal” quality; it could only claim through the term that its flour was liked by many, and perhaps, enjoyed more than other flour produced by its competition.

Similarly, when the *Hughes* court held the term “Ideal” was not descriptive,²⁸¹ it was correct in its analysis. In addition, the court then noted that there was secondary meaning associated with the term “Ideal”—a “descriptive” analysis.²⁸² Rightly, the court realized that because “Ideal” described no aspect of the hairbrush the

278. See *supra* Part II.

279. See *Pabst Brewing Co. v. Decatur Brewing Co.*, 284 F. 110, 112-13 (7th Cir. 1922); *France Milling Co. v. Washburn-Crosby Co.*, 7 F.2d 304, 306 (2d Cir. 1925).

280. See *Pabst*, 284 F. at 112-13; *France Milling* 7 F.2d at 306.

281. See *Hughes v. Alfred H. Smith Co.*, 209 F. 37, 39 (2d Cir. 1913).

282. See *id.* at 38-39.

term was commonplace enough to be utilized by others.²⁸³ Unless “Ideal” was so ingrained in consumers’ minds, it was not worthy of protection, despite its “suggestive” nature.²⁸⁴

Likewise, the *Duvernoy* court mentioned that the term “Consistently Superior” was laudatory but did not mention whether it was descriptive or suggestive.²⁸⁵ The court however, looked for evidence of a secondary meaning because the mark was weak.²⁸⁶ This was the correct approach because, again, trademark law should not give firms an incentive to use weak marks for products that the firms wish protected. By not mentioning the “suggestive” or “descriptive” sections of the trademark spectrum, the court avoided blatantly linking suggestive terms with a secondary meaning analysis, an analysis that would seem misguided because traditionally, only descriptive terms are put to the secondary meaning hurdle. This judicial strategy is crafty, even if unintentional. Yet, the analysis in this case was smart and effective because it provided no incentive for the firm to use a vague self-laudatory name. Similarly, the court’s analysis in *Supreme Wine* is worthy of respect because the court first noted that the term “Supreme” was to call attention to the superiority of the product and then stated that to protect this weak mark, secondary meaning was necessary.²⁸⁷ Once more, the court, perhaps wisely, avoided the use of “suggestive” and “descriptive” and focused instead upon the inherent weakness of the mark in separating the goods of the plaintiff from the goods of others.²⁸⁸ Furthermore, on point was the Board’s analysis of the term “The Premium Grade Malathion” in *In re American Cynamid Co.*²⁸⁹ The Board stated that the phrase was “laudatory, if not, a descriptive designation” and capable of acquiring secondary meaning.²⁹⁰ The Board seemed to realize that laudatory terms are not descriptive of the product they are paired up

283. *See id.* at 39.

284. *See id.*

285. *See Duvernoy*, 212 F.2d at 204.

286. *Id.*

287. *See Supreme Wine Co. v. American Distilling Co.*, 310 F.2d 888, 889 (2d Cir. 1962).

288. *See id.*

289. 176 U.S.P.Q. 350 (T.T.A.B. 1973).

290. *See id.* at 351.

with. “Premium Grade” is not a technical term in the industry and therefore, the phrase is suggestive of high quality. Another example of a wise approach to the problem is the *Valmor* case.²⁹¹ The First Circuit stated correctly that “Valmor” was suggestive of the skin care products of the complainant.²⁹² Immediately after finding the term to be suggestive, the court elaborated “[m]ore importantly, though, even if under some circumstances self-laudatory trademarks should not be registered or protected . . . the district court here found that . . . advertising over forty-five years has . . . established a close connection between the trademark name and its products”²⁹³ Wisely, the court did not dwell on the word, whether suggestive or descriptive, linked to the product, but realized the term was vague, looked for secondary meaning, analyzed customer confusion, and concluded that the plaintiff’s rights in the name were being infringed.²⁹⁴ More likely than not, this case posed less of a dilemma because the plaintiff’s company was incorporated under the name “Valmor”, and the term at issue was a somewhat inventive combination of two suggestive terms, “value” and “more.”

In discussing combination terms, it should be noted that the combination term in *Plus Products*²⁹⁵ must have greatly challenged the Board, because its reasoning was intensely convoluted. By correctly stating that “Plus” was suggestive and then re-analyzing the term after the addition of “pH”, the Board was using an additional term, “pH”, to help distinguish “pH Plus” from “Plus,” the marks of the proponent and opposer respectively. First, it seems odd that the court assumed “pH” was “obviously descriptive” when one can disagree. The term “pH” is a measure of acidity, but it is not a specific measurement and describes nothing. The term suggests some sort of chemical compound but nothing more. The health care products at issue have an acidity, but so does ice cream, so letting consumers know that the product has an acidity discloses little. The term “pH” seems to suggest that the product manufac-

291. See *Valmor Prods. Co. v. Standard Prods. Corp.*, 464 F.2d 200 (1st Cir. 1972).

292. See *id.* at 201-02.

293. *Id.* at 202.

294. See *id.*

295. *Plus Prods. v. Redken Labs, Inc.*, 199 U.S.P.Q. 111 (T.T.A.B. 1978).

turer is concerned about the acidity and a certain level of acidity is more desirable than other levels, but this all falls under the suggestive umbrella.²⁹⁶ Second, the Board appeared to err by using a likelihood of confusion analysis rather than a secondary meaning examination to conclude that “pH Plus” was not primarily descriptive of the applicant’s products.²⁹⁷ Of course, a likelihood of confusion analysis would be appropriate in deciding whether or not to protect the mark, but generally, likelihood of confusion is not mixed in with a discussion of whether the mark is primarily descriptive of a product. The Board did not use a secondary meaning analysis because it concluded “Plus” was suggestive of ingredients in the products. However, by labeling the term suggestive and relying on advertising levels, the Board appeared to follow the path recommended below, and arrived at a satisfactory conclusion.²⁹⁸ If this seems confusing, it is because it *is* confusing.

Returning to *Estee Lauder*,²⁹⁹ the Second Circuit was correct in concluding “100%” was suggestive. Interestingly, the court pronounced that laudatory terms were *generally* deemed suggestive.³⁰⁰ Though we have seen other cases have agree with this proposition, it is contrary to McCarthy’s position that laudatory terms, on the whole are descriptive.³⁰¹ The court’s position seems to be the correct one. However, before the praise for the court goes unabated, the *Estee Lauder* court held that “100%” was protectable simply because it was a suggestive term.³⁰² This is the long-standing notion, but one which this section of the Note preaches against. Here, it is urged that empty terms such as “100%”, when “100%” is used vaguely, despite being suggestive, should require secondary meaning before being protected. The reasons why will be discussed below.

296. Applicant disclaimed “pH” as a measure of acidity or alkalinity. *See id.* at 117.

297. *See id.* at 117-18.

298. It should be noted that the opposer could also use “pH” in describing its products if those products could be so described. *See id.* at 118. This appears curious because the Board, though stating “pH” is descriptive (which is doubted here), was vague when explaining how this term could describe any product.

299. *See Estee Lauder Inc. v. The Gap, Inc.*, 108 F.3d 1503 (2d Cir. 1997).

300. *See id.* at 1509.

301. *See 2 MCCARTHY*, *supra* note 3, § 11:17.

302. *See id.* at 1510.

D. *For the Treatment of Laudatory Terms to Match the Goals of Trademark Law, A Slightly Different Analysis is Required*

A pattern seems to have developed among some of the cases discussed. Those courts that eschewed the descriptive/suggestive dichotomy, such as *Duvernoy* and *Supreme Wine*, relied on a secondary meaning analysis. The *In re Occidental Petroleum* decision, attempting to fit the term into the dichotomy, chose to label the term “Super Iron” suggestive, ignored the secondary meaning analysis, because, it is well understood that suggestive terms do not require secondary meaning to be registerable. By ignoring the dichotomy, it appears that some courts are realizing that laudatory terms do not fit neatly into the current framework. By not relying on the trademark spectrum, and instead using common sense, a path can be followed that often will lead to correct decisions being made in the laudatory term framework. This is not to imply that the trademark spectrum is outdated or of no use in deciding when words and phrases are protectible. For the great many cases, the spectrum is adequate for this purpose. Nevertheless, for words and phrases that are clearly laudatory, such as “Plus” and “Super”, the spectrum seems deficient because a strict following of the dichotomy will more likely lead to the granting of protection, because the word is, if one is intellectually honest, suggestive, and no secondary meaning analysis is undertaken. Protection would be more persuasive if the term was more creative—perhaps a clearly fanciful or arbitrary term or certainly even a clearly non-laudatory suggestive term, and there are many that exist. The ingenuity would be sufficient enough to persuade this author that the term is worthy of protection against those to attempt to dilute its effectiveness by utilizing the same or a similar term.

From the preceding discussion, it should be clear that this argument champions the position that before these laudatory/suggestive terms are worthy of protection, secondary meaning should be found to exist—a high hurdle to leap. Counsel to companies will be abetted in their quest to have their clients use more arbitrary and fanciful terms if a substantial hurdle, lack of trademark protection, is put in the way by the courts. Realizing that it is

not the goal of trademark law to influence firms in naming their products, this argument does take the position that it is right to reward firms for using a mark that will gain protection and erroneous to reward firms that intend to use weak and vague marks to label their goods and services. Laudatory terms are not necessary for firms to sell products. Those firms that would be dissatisfied with the ideas presented herein can still use truly descriptive terms to name their wares. Nonetheless, it is smart law to require some showing that consumers link the laudatory term with a product before the word or phrase can be protected. Without this requirement, companies can use cryptic laudatory terms and leave the consumer guessing what is meant by “Super” or “Plus” and be rewarded by having these terms protected. Because these terms cannot be defined, a product can have less iron than all of its competitors’ products yet be labeled “Super Iron.”

An arbitrary name will not give the consumer more information about a product than a laudatory term, but it is less likely to be misleading because arbitrary or fanciful terms, on the whole, do not “brag”. Also, firms competing with the company using the laudatory name may have a better product than the “laudatory” firm, yet if the firm with the inferior product can easily protect its mark, it will be encouraged to use the laudatory term on its goods or services, and possibly mislead consumers. Again, protection of consumers is arguably the pivotal goal of trademark law and this argument should further that goal in a small way. Trademark law does not wish to reward companies for misidentifying their goods or using chicanery in any way.³⁰³

Though the Lanham Act has been amended often in the past, the most recent major amendments coming in the form of the Trademark Law Revision Act of 1988,³⁰⁴ alterations to the Lanham Act would not fix the issue herein. The Act does not talk of the distinctiveness spectrum and yet the courts, on the whole, do an admirable job with trademark law issues. Certainly, laudatory terms cause many problems for the system, but attempting to spell

303. See 15 U.S.C.A. § 1052.

304. Trademark Law Revision Act of 1988, Pub. L. No. 100-667, 102 Stat. 3935 (codified as amended at 15 U.S.C. §§ 1051-1128 (1994)). The Federal Trademark Dilution Act of 1995 contained relatively few changes. See *id.*

out what laudatory terms are and the distinctions among them, would only befuddle the problem. The beauty of the Lanham Act is the flexibility it gives those that wish to use a trademark to distinguish their products.³⁰⁵ As a matter of fact, the only section of the Act which hits on our issue is section 1052(e), which states that terms which are merely descriptive are not registerable.³⁰⁶ Therefore, it is plain that the Act takes a somewhat laissez-faire approach in its view on trademarks, and service marks, and any tinkering with this policy should be done carefully and sparingly. There is no need to go that route here.

CONCLUSION

The Lanham Act does not define what a laudatory term is or how it should be protected. Yet, many businesses prefer to use these terms because they tend to signal to consumers that the product or service is of good quality and perhaps, better quality than the products it competes with. Because the Lanham Act does not mention laudatory terms, and even if it did, it could not do so adequately because the term is so elusive, the judiciary has been all over the map. The courts that have realized that laudatory terms do not specifically describe anything about the product, but rather

305. 15 U.S.C.A. § 1052 states:

No trade-mark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—

(a) Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute;

...

(d) Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive . . .

(e) Consists of a mark which (1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them, (2) when used on or in connection with the goods of the applicant is primarily geographically descriptive of them.

Id.

306. *See* 15 U.S.C.A. § 1052(e).

suggest some quality about the product, are the courts that are on the right track. In addition, the requirement that a laudatory term should have a secondary meaning associated with it before it can be protected under the Lanham Act should encourage firms to use these terms sparingly. By limiting the use of these terms and encouraging ones that are closer to arbitrary on the distinctiveness spectrum, the courts can champion the general goals of trademark law: (1) to protect firms that have spent capital developing trademarks from the free-riding of other firms off of this effort, and (2) to protect consumers from purchasing a good or service that is not what was expected. Laudatory terms do not fit very neatly into the current trademark framework, but with care, common sense, and a desire to fulfill the goals of the Lanham Act, they can be adequately dealt with by the judicial system.