

Laudatory Terms – Super Trademarks or Not Worth the Trouble?

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Related Capabilities

- Trademark, Copyright + Advertising
- Intellectual Property Litigation

Hello loyal TMCA readers – This is the first installment of what we hope to be an informative series of posts called Quirky Questions: TMCA Edition. Our labor and employment colleagues have a great blog, [Quirky Questions](#), where they answer unanticipated questions regarding workforce issues. If you have employment questions (and we know many of you may do), we encourage you to check it out. Over here at The TMCA we will be answering some quirky questions of our own, but in the areas of trademarks, copyrights and advertising. We hope you enjoy the series and feel free to send in your suggestions for future posts.

Under U.S. trademark law, trademarks fall along the spectrum of distinctiveness.



Generic	Descriptive	Suggestive	Arbitrary	Coined or Fanciful
WATER: water	SHARP: televisions	BLU-RAY: high capacity data storage	APPLE: computers	GOOGLE: online services

Word marks may be inherently distinctive (such as suggestive and coined or fanciful marks) or may acquire distinctiveness through use (descriptive words that have acquired

secondary meaning and become protectable as a trademark). The spectrum informs the scope of protection afforded to a mark – the higher a mark is on the spectrum, the stronger it is in terms of the owner’s ability to enforce its rights against 3rd party users of similar marks. In short, good, strong trademarks should aim high on the level of distinctiveness.

Laudatory Terms

Laudatory terms are those that attribute quality or excellence to goods or services or are complimentary or superlative. Although it may be possible to secure trademark rights in a laudatory term, laudatory trademarks are generally considered weak and entitled to a narrow scope of protection, even after a showing of secondary meaning. The USPTO considers laudatory terms to be merely descriptive under the Trademark Act. See Trademark Manual of Examining Procedure (TMEP) § 1209.03(k). These terms may acquire secondary meaning over time through extensive use and promotion and become protectable as a mark. The Court of Appeals for the Federal Circuit has stated, however, that “a phrase or slogan can be so highly laudatory and descriptive as to be incapable or acquiring distinctiveness as a trademark.” See TMEP § 1209.01(c)(ii).

The Federal Circuit or the USPTO has found these laudatory phrases to be merely descriptive:

- SNAP SIMPLY SAFER: cannulae, medical needles and syringes
- THE ULTIMATE BIKE RACK: bicycle racks and related accessories
- BEST PROTEIN: dietary and nutritional supplements
- DRIVE SAFELY: automobiles and parts
- THINK GREEN: waste disposal and treatment of waste
- WORLD’S HEALTHIEST GROCERY STORE: grocery store services

There are other laudatory marks that do not actually describe a feature of the product, but instead generally suggest the product is of higher or better quality than other similar products. They require some thought and perception to connect the mark to the goods or services. For example, these marks have been registered on the Principal Register without disclaimers or claims of acquired distinctiveness:

- SUPER: vehicle lights
- PLUS: magazines and online magazines
- SELECT: automobile ignition parts
- GOLD MEDAL: pest control services

Although these laudatory terms are registered on the Principal Register, they are widely used in many industries to describe products or services. Thus, they are also weak and ultimately less valuable as trademarks.

False Advertising

Apart from being weak, another potential issue with laudatory terms is false advertising. Use of laudatory trademarks can be considered advertising puffery if the attribute claim is

general and subjective, such as “Greatest Pizza.” However, a laudatory phrase that makes a more specific, verifiable claim could be subject to a false advertising challenge, such as “most powerful vacuum” because it could be objectively verified as true or not.

At the end of the day, exercise caution in adopting laudatory terms as trademarks as they may not be accorded a worthwhile scope of exclusivity and are therefore less valuable. Ideally, it is best to select a mark that is inherently distinctive like fanciful or arbitrary marks. Unique and distinctive brand names have the greatest equity potential.