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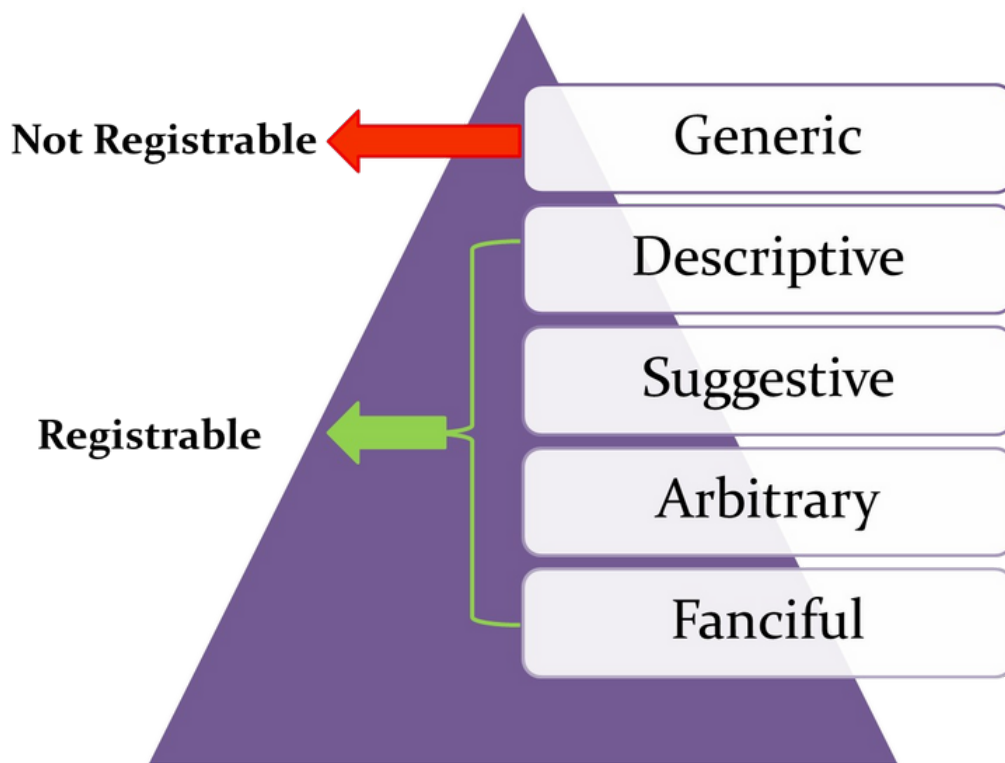
Dichotomy of Laudatory Trade Marks: descriptive or suggestive?

In today's dynamic commercial environment, brand image and identity are of utmost importance. A successful brand/trade mark/label is one that leaves a striking impression with the consumer and creates immediate recall and long-lasting association and distinguishes itself from its numerous competitors. At the same time, such a brand should be protectable both in its entirety, as well as its essential elements. Therefore, brand selection is not only an exercise in marketing, but must also incorporate analysis from a trade mark law perspective.

Considering that trade mark rights can be availed of in perpetuity, it is imperative that from its inception, the brand/trade mark is capable of distinguishing the goods and services of one person from another. It is critical that the nuances of trade mark law are considered at the time of creating/adopting a mark, not only to ensure that the brand is entitled to the highest degree of protection, but also to prevent any inadvertent objections from prior third-party. It cannot be stated enough that a weak trade mark can lead to loss of years of investments in brand creation, establishment, goodwill and reputation.

One crucial aspect to be considered at the time of brand adoption, is the "*spectrum of distinctiveness*"¹ which assists in determining the degree of protection that may be granted to a brand owner's trade mark. For more than a century trade mark lawyers and academicians have categorized trade marks according to the degree of distinctiveness inherent in them. Typically, the spectrum of distinctiveness is as under:

¹Gary J. Sosinsky, Laudatory Terms in Trademark Law: Square Pegs in Round Holes, 9 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 725 (1999).



Laudatory terms:

Laudatory terms are words which are used for expressing praise or admiration or puff up a product/brand. Terms such as “100%”, “Super”, “Best”, “Platinum” are examples of laudatory terms.

Depending on the use of the terms within a brand, they have been adjudicated to be suggestive or descriptive. A laudatory term can be suggestive thus rendering the trade mark inherently distinctive and entitled for protection. However, if a laudatory term is descriptive in nature then it is incapable of being protected in the absence of acquired distinctiveness being established. Therefore, the question is the degree of protection such marks are entitled to, and what are the possible best practices that can entitle a brand incorporating such laudatory terms to maximum protection.

Descriptive or Suggestive:

A descriptive trade mark is one that describes the characteristics, quality, ingredients, features, or functions of the goods or services for which the trade mark has been adopted. Descriptive trade marks can only be protected on proof of acquired distinctiveness and secondary meaning.

On the other hand, suggestive trade marks are inherently distinctive, as the consumer must use their imagination to decipher the nature of goods or services rendering high level of distinctiveness for the trade mark.

There are primarily three tests to determine whether a mark is descriptive or suggestive: *Dictionary definition test*, *Degree of imagination test*, and *Competitor test*. When applying the Definition test, the dictionary meaning of the word has to be seen in the context of the goods or services and determine if a direct relationship is established between the trade mark and the goods then the mark is of descriptive nature. In the Imagination test, it must be determined that when a consumer comes across the trade mark, any imagination or mental leap is required to form an association between the mark and the product. When some level of imagination or mental leap is required then the mark is suggestive. In the Competitor test, the extent of actual need of the competitors to use the mark to identify their goods or services is determined.

Pertinently, in India, Section 9(1) of the Trade Marks Act provides for absolute grounds for refusal of registration for marks that are devoid of distinctive character, marks of descriptive nature, and marks which have become customary in the current language or *bona fide* and established practices. However, if any such mark has acquired distinctive in the minds of consumers on account of commercial use of the³ trade mark over a longstanding period, such mark can then be granted protection. The Supreme Court in *Godfrey Philips India Ltd. Girnar Foods*, upheld the decision of the Division bench that “SUPER” is a laudatory term and descriptive for the goods being tea however, is entitled to protection if it has assumed a secondary meaning or has acquired distinctiveness.

The Courts in India have oscillated from holding laudatory terms as being descriptive and suggestive in nature. While making such determination the Courts give utmost importance to the goods or services for which the laudatory term is being adopted. In a recent judgement of the Delhi High Court in *Franfinn Aviation Services Private*

²Theodore H. Davis Jr., *Litigation in the Federal Courts and State Courts of General Jurisdiction*, 112 TRADEMARK REP. 119 (2022).

³(2004) 5 SCC 257.

Limited v. Tata Sia Airlines⁴ Ltd., held that the mark “FLY HIGH” is laudatory and has become common to trade for being descriptive in nature for aviation services, and thus not entitled to injunctive relief. On the other hand in the in the case of Bata India Limited v. Chawla Boot House⁵ and another, the court opined that “POWER” is a laudatory term however for footwear it is a suggestive mark as it is not immediately connectable to footwear. The Court held that “POWER” is a distinctive mark for the plaintiff’s good and thus deserves protection under the law.

Conclusively, a laudatory term adopted as a trade mark is also entitled to protection as long as it is capable of functioning as a trade mark, which is to enable the consumers to distinguish the goods or services of one person from another. Mere laudation is not inimical to a term’s capability of functioning as a trade⁶mark. A laudatory term can be of descriptive nature or suggestive in nature and depending upon such determination, the degree of protection it is entitled to can be determined.

Even though it is tempting to adopt a laudatory term for a brand nevertheless the brand owner should not turn a blind eye to the nuances of trade mark law. As a trade mark is adopted for the sole purpose of forming a connection between the goods/services with the consumers it becomes pertinent that the brand owner is capable of protecting its brand from unauthorized third parties.

Disclaimer: The information contained in this article is provided for informational purposes only, and should not be construed as legal advice on any subject matter.

⁴MANU/DE/4176/2022.

⁵(2019) 259 DLT 292.

⁶In re Bush Bros. Co., 884 F.2d 569, 12 U.S.P.Q.2d 1058 (Fed. Cir. 1989).



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