

Sheldon Mak Rose Anderson

TRADEMARK FAMILIES

by
Sheldon Mak Rose & Anderson

Can a trademark have a family?

It certainly can if it is a member of a trademark family. The members of a trademark family are commonly owned trademarks that share a prefix, suffix, word, syllable or other feature that identifies each mark as being a member of the family. The common characteristic is called the "surname" of the family, even though it is not always the last part of each of the trademarks of the family. A trademark family can be legally recognized as such if the trademark family owner has advertised the family in such a way that the public recognizes the surname of the family as identifying products or services originating with the trademark family owner. Trademark law rewards the trademark family owner for promoting the trademark family by preventing others from using a mark with the surname for related services or goods, even though the mark may not be confusingly similar to any individual member of the trademark family. This article will discuss why trademark owners have been successful or unsuccessful in gaining legal recognition for their trademark families, and the measures those owners can take to increase the likelihood that a court or the Patent and Trademark Office will recognize their trademark families.

A well-known trademark family received judicial recognition in the case of *McDonald's Corp. v. McBagels, Inc.*, 649 F. Supp. 1268, 1 U.S.P.Q.2d 1761 (S.D.N.Y. 1986), in which the court preliminarily enjoined the defendant, McBagels, Inc., from using the word "McBAGELS" in connection with a bagel bakery and restaurant. McDonald's argued that it owned a family of trademarks characterized by the use of the formatives or surnames "Mc" or "MAC," usually in combination with the generic name of a food item. Examples of the McDonald's family of trademarks include "McDONALD'S," "McDONALD'S HAMBURGERS," "EGG McMUFFIN," "McCHICKEN," "McDONUTS," "BIG MAC," "McPIZZA," "MAC FRIES," "CHICKEN McNUGGETS," and many others. The court noted that "[t]he existence vel non of a family of marks is a question of fact based on the distinctiveness of the common formative component and other factors, including the extent of the family's use, advertising, promotion, and its inclusion in a number of registered and unregistered marks owned by a single party." 1 U.S.P.Q.2d at 1763.

The McDonald's court was impressed by the extent of the advertising devoted by McDonald's to create recognition for various members of the family, independent and substantial news media use of the "Mc" formative in independently created articles about McDonald's, and McDonald's efforts in policing the use of the "Mc" formative. The court had "no hesitation" in finding that McDonald's owned a family of marks using "Mc" or "MAC" as a formative.

In the case of *Marion Laboratories v. Biochemicals/ Diagnostics*, 6 U.S.P.Q.2d 1215 (T.T.A.B. 1988), the Trademark Trial and Appeal Board denied registration of the mark "TOXI- PREP" over the opposer's "TOXI-" family of marks consisting of members including "TOXI-DISCS," "TOXI-GRAMS," "TOXI-TUBES," "TOXI-LAB," "TOXI-KIT," "TOXI-TIPS," and others, used for various laboratory diagnostic kits "very similar" to the TOXI-PREP clinical screening kit. The Board stated the two elements needed to establish ownership of a family of marks: "it must be shown by competent evidence first, that prior to the entry into the field of the opponents mark, the marks containing the claimed 'family' feature or at least a substantial number of them, were used and promoted together by the proponent in such a manner as to create public recognition coupled with an association of common origin predicated on the 'family' feature; and second, that the 'family' feature is distinctive (i.e., not descriptive or highly suggestive or so commonly used in the trade that it cannot function as the distinguishing feature of any party's mark)." *Id.* at 1218-19 (quoting *Land-O-Nod Co. v. Paulison*, 220 U.S.P.Q. 61, 65-66 (T.T.A.B. 1983)). The opposer had no difficulty in demonstrating use of its claimed "TOXI-" marks prior to the filing date of the applicant's application for registration of "TOXI-PREP." The

opposer also proved that it had used and promoted its marks together in brochures and price lists prior to the applicant's application date. This, together with evidence of recognition of the family feature by consumers, indicated that "purchasers are generally exposed to several of the marks at once and would be likely to associate the goods bearing the "TOXI-" prefix with a common source." *Id.* at 1219.

The applicant in Marion Laboratories argued that "TOXI-," the "surname" of the family, was not distinctive. The Board agreed that if the asserted family feature is descriptive, highly laudatory or commonly used in the trade, it cannot serve as the basis for a family of marks, at least in the absence of a showing of distinctiveness. In holding that "TOXI-" was "no more than suggestive" of the opposer's goods, the Marion Laboratories board stated that a "suggestive" portion or term could function as a family feature, depending on whether the common feature would be recognized by the relevant public so that the public would ascribe a common origin to marks containing the common feature.

The courts have recognized other families of trademarks when the trademark family owner appears to satisfy the elements of prior promotion of the surname and distinctiveness of the surname. For example, the Court of Appeals for the Federal Circuit recognized a "STIX" family of trademarks for reagent strips in *International Diagnostic Technology, Inc. v. Miles Laboratories, Inc.*, 746 F.2d 798, 223 U.S.P.Q. 977 (Fed. Cir. 1984) (MULTISTIX-C, N-MULTISTIX SG, CHECKSTIX, C-STIX). The predecessor of the Federal Circuit, the Court of Customs and Patent Appeals, recognized a "FISH" family of trademarks for sailboats in *AMF, Inc. v. American Leisure Products*, 474 F.2d 1403, 177 U.S.P.Q. 268 (C.C.P.A. 1973) (SAILFISH SPORTABOUT and fish design, ALCORT SUNFISH, ALCORT CATFISH, FLYING FISH, and a sunfish design). The District Court for the District of Oregon recognized a "DICT" family of trademarks for dictating machines in *Dictaphone Corporation v. Dictamatic Corp.*, 199 U.S.P.Q. 437 (D. Or. 1978) (DICTAPHONE, DICTABELT, DICTAMITE, DICTAPAK, DICTAFAX, DICTAGRAM, and many others). On the other hand, courts have denied family status when the putative surname did not appear to be distinctive or was not recognized by the public as originating from a single source. E.g., *Creamette Co. v. Merlino*, 299 F.2d 55, 132 U.S.P.Q. 381 (9th Cir. 1962) ("-ETTE" trademarks for macaroni products, such as "CREAMETTES," "DUMPLINGETTES," and "SPAGH-ETTES," were not recognized as a family because the "-ETTE" suffix was in such widespread use that it was not distinctive); *Quaker Oats Co. v. General Mills, Inc.*, 134 F.2d 429, 56 U.S.P.Q. 400 (7th Cir. 1943) ("-IES" trademarks for breakfast cereals, such as "WHEATIES," "KORNIES," and "MAIZIES," were denied family status because of lack of public recognition that General Mills owned a family of marks); *Polaroid Corp. v. American Screen Process Equipment Co.*, 166 U.S.P.Q. 151 (T.T.A.B. 1970) (Polaroid Corp. held not to have established a family of "POLA-" trademarks for photographic products because of failure to show that the public ascribes ownership of all "POLA-" trademarks in the field to Polaroid Corp.).

If the goods or services with which the mark in question is used are very similar to the goods or services with which the family of marks is used, use of the common family characteristic or surname usually decides the question of confusion. The trademark of another generally will infringe the trademark family if the family's surname is found in the other's trademark and the goods or services are related to those with which the trademark family members are used. Thus, a mark could infringe the family even though the mark is not so similar to any single one of the marks in the trademark family as to be likely to cause confusion, to cause mistake or to deceive, even when that mark is used on similar goods and services.

The advantage of possessing a legally recognized family of trademarks may be seen in the McDonald's case discussed above. The McDonald's court found that "McBAGELS" infringed the "Mc" family of marks, even though McDonald's did not sell bagels and did not use any trademarks or service marks similar to McBAGELS, because McBAGELS bore the family surname in combination with the generic name of a food item and was used for goods and services related to the goods and services with which the "Mc" family was used. McDonald's extensive expenditures and efforts in advertising its "Mc" family of marks (McDonald's was then the nation's fifth largest advertiser overall) were rewarded by legal recognition of McDonald's exclusive right to use trademarks and service marks bearing the family surname with prepared fast foods and related services. In the more recent case of *Quality Inns International v. McDonald's Corporation*, 695 F. Supp. 198, 8 U.S.P.Q.2d 1633 (D. Md. 1988), the court enjoined the use of "McSLEEP" for lodging because of confusion with the "Mc" family of marks even though the "Mc" family did not include service marks for lodging. In other cases mentioned above, "TOXI-PREP" caused confusion with the "TOXI-" family in Marion Laboratories; "DICTAMATIC" infringed the "DICT-" family in Dictaphone Corp.; "GOLDFISH" infringed the "FISH" family in AMF; and "STIQ" caused confusion with the "STIX" family in International Diagnostic.

The cases suggest a number of ways in which a trademark owner can create a legally recognizable family of trademarks. These are:

1. Pick a distinctive or "strong" surname for the family. The surname should preferably be fanciful, such as McDonald's "Mc," or arbitrary, such as Apple's "APPLE" for computer products. At the least, it should be suggestive, such as AMF's "FISH" for sailboats.
2. The members of the family should be promoted together in advertising in order to create an association with each other. If the advertisement is primarily about one product, the advertisement should have copy referring to the other members of the trademark family and the trademark owner, such as "TOXI- LAB diagnostic kit is one of many fine 'TOXI' products available from Marion Laboratories, Inc." or "Please write for information about other 'TOXI' diagnostic kit materials available from Marion Laboratories, Inc.."
3. Register the members of the family. The existence of a large number of registrations is, in itself, insufficient to establish ownership of a family of trademarks. The registrations do, however, evidence ownership and use of the marks in question and will establish senior and preclusive rights against subsequent users of the marks.
4. Police the surname by preventing registration of others' marks using the surname and eliminating infringement as it becomes known. A watching service is particularly valuable for protecting a family of marks by identifying attempted registrations of marks using the surname.
5. Persuade the press to write articles about the goods or services with which the family of marks is used. The articles should mention as many of the trademarks of the family as possible.

In conclusion, a trademark owner is likely to be granted legal recognition of its family of trademarks if that owner uses a number of trademarks or service marks characterized by a distinctive feature that is at least "suggestive," and so advertises or promotes the members of the trademark family together or in association with the owner that members of the consuming public are likely to believe that goods or services sold under or used with marks bearing the common element or surname originate from the same source or are associated with the trademark owner. Legal recognition of trademark family status is important because the issue of substantial similarity of the marks becomes dependent upon the common feature or surname and not upon a comparison of the mark in question to any individual member of the family.

© Copyright Sheldon & Mak 1995

Sheldon Mak Rose & Anderson PC
100 E. Corson Street, Third Floor
Pasadena, California 91103-3842
626-796-4000
626-795-6321 fax