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Peter Mack

Geoff McNutt

John Vasuta

Michael Song

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## CHOOSING FAME OVER FAMILY

*Peter Mack, Geoff McNutt, John Vasuta and Michael Song\**

### I. INTRODUCTION

The fame of two or more commonly owned trademarks is a powerful weapon in the trademark owner's enforcement arsenal if the trademarks have a particular feature or element in common. Indeed, recent developments in the law of trademarks suggest that the fame of the senior user's group of marks with a common element is a more significant factor in a likelihood of confusion analysis than the senior user's ability to establish that it owns a "family of marks."

The Court of Appeals for the Federal Circuit has defined a "family of marks" as:

[A] group of marks having a recognizable common characteristic, wherein the marks are composed and used in such a way that the public associates not only the individual marks, but the common characteristic of the family, with the trademark owner. Simply using a series of similar marks does not of itself establish the existence of a family. There must be a recognition among the purchasing public that the common characteristic is indicative of a common origin of the goods.<sup>1</sup>

The common characteristic can be a common prefix, suffix, or syllable.<sup>2</sup> The owner of a family of marks may rely upon the presence in its marks of this common element to assert likelihood of confusion as against another trademark that also contains the common element, even if the other trademark as a whole is otherwise not similar in sound, appearance or overall commercial impression to any single mark in the

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\* Peter Mack is a partner, and Geoff McNutt is an attorney with Foley & Lardner, Washington, D.C. John Vasuta is Chief IP Counsel with Bridgestone Americas Holding, Inc., Akron, Ohio. Michael Song is a student at George Mason University School of Law and a clerk with Foley & Lardner.

1. J & J Snack Foods Corp. v. McDonald's Corp., 932 F.2d 1460, 1462 (Fed. Cir. 1991).  
2. Spraying Systems Co. v. Delavan, Inc., 975 F.2d 387, 395 (7th Cir. 1992).

family.<sup>3</sup>

In deciding questions of likelihood of confusion, courts must often place themselves “in the position of an average purchaser or prospective purchaser in an attempt to understand what the normal reaction would be to the marks as they are encountered in the marketplace or in promotional and advertising material.”<sup>4</sup> Thus, the proponent must show by competent evidence: (1) that prior to the entry into the field of the opponent’s mark, all or many of the marks in the alleged family were used and promoted together in such a way as to create a public perception of the common element as an indication of common source; and (2) that the common element is distinctive.<sup>5</sup>

Because the proponent must prove use and promotion, evidence in the nature of sales and advertising expenditures is often crucial to the court’s determination of whether a family of marks exists.<sup>6</sup> This evidence, however, also may be used to show the fame of the marks.<sup>7</sup> The fame of a mark is one of the factors that courts weigh when determining the strength of the trademark, an important factor in any likelihood of confusion analysis.<sup>8</sup> Similarly, the establishment of a family of marks may demonstrate the strength of the group of marks.<sup>9</sup>

Establishing a family of marks can be difficult because of the need to show joint advertising of the family of marks, the distinctiveness of

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3. See, e.g., *McDonald’s Corp. v. McClain*, 37 U.S.P.Q.2d 1274 (TTAB 1995) (finding that the registration of “McClain” for legal services infringed upon McDonald’s Corporation “MC” family mark); *Geoffrey, Inc. v. Stratton*, 16 U.S.P.Q.2d 1691 (C.D. Cal. 1990) (finding that the registration of “PHONES-R-US” infringed upon the “R US” family mark found in Geoffrey Incorporated’s KIDS “R” US and TOYS “R” US”).

4. *American Standard Inc. v. Scott & Fetzer Co.*, 200 U.S.P.Q. 457, 461 (TTAB 1978).

5. *Marion Laboratories, Inc. v. Biochemical/Diagnostics, Inc.*, 6 U.S.P.Q.2d 1215, 1218-19 (TTAB 1988). See also *Polaroid Corp. v. American Screen Process Equip. Co.*, 166 U.S.P.Q. 151, 154 (TTAB 1970); *J & J Snack Foods*, 932 F.2d at 1463 (finding that “[i]t is thus necessary to consider the use, advertisement, and distinctiveness of the marks” when determining whether a family of marks has been established).

6. See *Polaroid*, 166 U.S.P.Q. at 154 (stating that “it has not been shown that the various marks asserted to comprise said ‘family’ or, at least, a goodly number of them, have become familiar or known in the photography field as a result of sales or constant exposure through advertising and promotion”); *Witco Chemical Co. v. Chemische Werke Witten G.M.B.H.*, 158 U.S.P.Q. 157, 160 (TTAB 1968) (finding that “we look primarily to the nature and character of opposer’s advertising and promotional material and any evidence pertaining to purchaser reaction thereto and exposure to the marks over the years” to establish a family of marks).

7. See *Bose Corp. v. QSC Audio Prods., Inc.*, 293 F.3d 1367, 1371 (Fed. Cir. 2002).

8. *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973).

9. *Dictaphone Corp. v. Dictamatic Corp.*, 199 U.S.P.Q. 437, 442 (D. Or. 1978) (holding that “[t]he use of ‘Dictaphone’ together with other marks having ‘Dict-’ or ‘Dicta-’ as a prefix strengthens Dictaphone’ and increases the likelihood of confusion between ‘Dictaphone’ and ‘Dictamatic[.]’”).

the common element, and the consumer's association of marks containing the common element with a single source of origin.<sup>10</sup> Furthermore, a judicial finding that a family of marks exists does not necessarily guarantee an adjudication that confusion is likely, as other factors must also be weighed in this determination.<sup>11</sup>

Fame, on the other hand, is a dominant factor in a likelihood of confusion analysis.<sup>12</sup> Thus, because establishing a family of marks may be difficult, courts and the Trademark Trial and Appeal Board ("TTAB") have recently focused their analyses on the fame of a group of marks when determining likelihood of confusion, even in cases involving a group of marks having a common element or common unifying theme.

## II. DIFFICULTY IN PROVING A FAMILY OF MARKS

Older cases appear hostile to the family of marks doctrine.<sup>13</sup> Although more recent cases have been more objective and receptive to the doctrine, proving the existence of a family of marks is challenging.<sup>14</sup> Some of the reasons why courts have refused to apply the family of marks doctrine include: (i) the lack of distinctiveness of the common element; (ii) differences between the parties' goods; and (iii) the lack of conjoint advertising establishing a common ownership in the mind of the consumer.

### A. *Distinctiveness of the Common Element*

One of the most frequent reasons for courts to reject the existence of a family of marks is the lack of distinctiveness of the common element. This is because the family of marks doctrine is bottomed on the notion that the common feature is a distinctive feature of each mark.<sup>15</sup> Thus, a common element that is merely descriptive or highly

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10. *Marion Labs*, 6 U.S.P.Q.2d at 1218-19.

11. *In re E.I. DuPont*, 476 F.2d at 1361 (providing thirteen factors to help determine whether a likelihood of confusion exists).

12. *Recot, Inc. v. Becton*, 214 F.3d 1322, 1327 (Fed. Cir. 2000) (holding that FIDO-LAY for dog treats was likely to be confused with FRITO-LAY for human snack food).

13. See J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 23:61 (4th ed. 2003); *Creamette Co. v. Merlino*, 299 F.2d 55, 59 (9th Cir. 1962) (stating that some courts have "squinted" at the possibility of acquiring rights in a family of marks).

14. See MCCARTHY, *supra* note 13, at § 23:61.

15. *American Standard Inc. v. Scott & Fetzer Co.*, 200 U.S.P.Q. 457, 461 (TTAB 1978). See also *Champion Int'l Corp. v. Plexowood, Inc.*, 191 U.S.P.Q. 160, 163 (TTAB 1976) (holding that the nature and significance of the prefix FLEX- for flexible material "raises a question as to whether [a family of marks] theory can be bottomed on such a term").

suggestive cannot serve as the distinctive feature of a family of marks. For example, in *Spraying Systems Co. v. Delavan Inc.*, the Court of Appeals for the Seventh Circuit held that the suffix JET for spray nozzles was descriptive, such that there could be no family of marks despite evidence of substantial sales and market share.<sup>16</sup> Similarly, in *American Standard Inc. v. Scott & Fetzer Co.*, the TTAB held that the prefix AQUA was highly suggestive for water faucets and thus could not serve as a distinctive feature of a family of marks.<sup>17</sup>

Courts have also refused to find a family of marks when the mark is commonly used in the trade. For example, in *Servo Corp. of America v. Servo-Tex Products Co.*, the court held that the prefix SERVO is commonly used in the industry as an abbreviation for servomotor or servomechanism such that it could not serve to distinguish a family of marks.<sup>18</sup>

In addition, if the common element is widely used for a variety of products, courts may find that the common element is incapable of establishing a family of marks. For example, in *Creamette Co. v. Merlino*, the Ninth Circuit held that the suffix ETTES (or even ET or ETTE) was so widely used for a variety of products and “capable of being used with such an infinite variety of wholly dissimilar words that [the court doubted] it could ever be a feature of a ‘family’ of marks to be used on any line of goods.”<sup>19</sup>

Courts have found a family of marks, however, when the common element is suggestive. For example, in *Duffy-Mott Co. v. Borden, Inc.*, the TTAB stated that, while the suffix MATO for tomato drinks may “at first blush” seem to be a little too suggestive, the suffix had been “exploited . . . to enhance public recognition of this verbal feature as indicating origin of certain beverages.”<sup>20</sup> Similarly, in *Reynolds & Reynolds Co. v. I.E. Systems Inc.*, the TTAB stated, “[w]hile ACCU no doubt has a suggestive connotation, it is not so highly suggestive as to

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16. *Spraying Systems Co. v. Delavan, Inc.*, 975 F.2d 387, 395 (7th Cir. 1992).

17. *American Standard*, 200 U.S.P.Q. at 461. *See also Spraying Systems*, 975 F.2d at 395 (holding that the suffix JET for spray nozzles was descriptive and the owner had not proven secondary meaning such that there could be no family of marks despite evidence of substantial sales and market share).

18. *Servo Corp. of Am. v. Servo-Tex Prods. Co.*, 289 F.2d 955, 956 (CCPA 1961) (holding that because SERVO is commonly used as an abbreviation for servomotor or servomechanism, it is descriptive).

19. *Creamette Co. v. Merlino*, 299 F.2d 55, 59 (9th Cir. 1962); *See also Quaker Oats Co. v. General Mills, Inc.*, 134 F.2d 429 (7th Cir. 1943) (holding the suffix “ies” not exclusive to the registered trademark of “Wheaties”).

20. *Duffy-Mott Co., Inc. v. Borden, Inc.*, 201 U.S.P.Q. 846, 850 (TTAB 1978).

impair its ability to serve as the basis for a family of marks.”<sup>21</sup>

In sum, because a party relying upon the family of marks doctrine must establish that the purchasing public associates the common element, as well as the whole trademark, with the owner of the family of marks; this common element must be distinctive. Hence, a common element which is merely descriptive, highly suggestive, or is commonly used in the industry or on a variety of products, usually cannot establish a family of marks.

### *B. Differences in the Goods*

Another difficulty in asserting the family of marks doctrine occurs when the marks containing the common element identify goods or services that are different from the goods or services of the alleged infringer. These differences undermine the recognition among the purchasing public that the common element is indicative of a single source of origin, and thus may preclude establishment of a family of marks.

For example, in *Witco Chemical Co. v. Chemische Werke Witten G.M.B.H.*, the opposer’s marks containing the prefix WIT identified various chemical compounds, including products in the paint industry, petroleum industry, ink industry, and textile industry.<sup>22</sup> The TTAB, however, discounted many of the opposer’s marks because they were not used to identify the same type of goods that applicant’s marks identified, namely synthetic detergents.<sup>23</sup> Thus, although the opposer sold many products with the WIT prefix, although the opposer also sold synthetic detergents under other marks not containing the common element, and although the opposer owned one mark (WITCO) that identified synthetic detergents, the TTAB held that this evidence was insufficient to establish a family of marks.<sup>24</sup>

Some courts have also drawn narrow distinctions between related goods to find that there is no likelihood of confusion, even if the existence of a family of marks has been established. For example, in

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21. *Reynolds & Reynolds Co. v. I.E. Systems Inc.*, 5 U.S.P.Q.2d 1749, 1751 (TTAB 1987). *See also* *Marion Laboratories Inc. v. Biochemical/Diagnostics Inc.*, 6 U.S.P.Q.2d 1215 (TTAB 1988) (holding that the suggestive prefix TOXI- for products related to clinical laboratory testing for drugs may serve as a common element).

22. *Witco Chemical Co. v. Chemische Werke Witten G.M.B.H.*, 158 U.S.P.Q. 157, 160 (TTAB 1968).

23. *Id.* at 161.

24. *Id.*

*Reynolds*,<sup>25</sup> the TTAB dismissed an opposition against an application to register the mark ACCULINK for a computer program for asynchronous communications use. The opposer had shown that it owned a family of marks containing ACCU for computerized accounting programs.<sup>26</sup> The TTAB ruled against the opposer, however, on the ground that the specific type of software for operational uses was sufficiently different from software for accounting purposes as to negate a likelihood of confusion.<sup>27</sup>

Similarly, in *Consolidated Foods Corp. v. Sherwood Medical Industries Inc.*, the TTAB held that, even assuming that the use of the suffix SICLE for frozen confectionaries was sufficient to establish a family of marks, a medical patient preparation sponge is such a “radically” different product as to negate likelihood of confusion with respect to the family of marks.<sup>28</sup>

In sum, because the consumer must associate the common element with a common origin of goods, differences in the parties’ goods may undermine reliance on the family of marks doctrine. Moreover, even if a family of marks is established, tribunals may find that there is no likelihood of confusion as between the family of marks and an allegedly infringing mark because of differences in the parties’ goods.

### C. Joint Advertising

Another difficulty in establishing a family of marks is the necessity of showing conjoint advertising or promotion. This conjoint use and advertising must also demonstrate that the consuming public associates the common element with a single source of origin.

For example, in *White Heather Distillers Ltd. v. American Distilling Co.*, the TTAB stated that two marks bearing the common word HEATHER for scotch whiskey, “can hardly be deemed a ‘family’ of marks within the accepted concept of the term, if for no other reason than that the opposer has submitted no testimony, and the record fails to indicate that these marks have ever been advertised together in any manner appraised to project the impression that they all belong to the same party . . . by reason of the common word HEATHER.”<sup>29</sup>

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25. *Reynolds & Reynolds*, 5 U.S.P.Q.2d at 1751.

26. *Id.*

27. *Id.* at 1752.

28. *Consol. Foods Corp. v. Sherwood Med. Indus. Inc.*, 177 U.S.P.Q. 279, 282 (TTAB 1973) (holding that the evidence did not establish a family of marks).

29. *White Heather Distillers Ltd. v. Am. Distilling Co.*, 200 U.S.P.Q. 466, 470 (TTAB 1978). See also *Mallinckrodt, Inc. v. CIBA-GEIGY Corp.*, 195 U.S.P.Q. 665, 667-68 (TTAB 1977)

The tribunals have also held that, even if two or more of the marks in the alleged family have been promoted together, the nature and character of the advertising and promotional material must establish that the consuming public would believe that any mark containing the common element came from a the same source. For example, in *Moore Business Forms, Inc. v. Rogersnap Business Forms, Inc.*, the TTAB held that a brochure and other individual advertisements only referenced at most two of the marks in the alleged family.<sup>30</sup> Thus, despite the alleged use and promotion of sixteen marks, each containing the prefix SPEEDI, the Board held that this conjoint advertising of only one or two at a time did not establish a family of marks.<sup>31</sup>

Furthermore, even if two or more of the marks have been promoted together, the intermingling of these marks with other marks missing the common element may undermine reliance on the family of marks doctrine. For example, in *Dap, Inc. v. Flex-O-Glass, Inc.*, the TTAB stated that, despite the joint promotion of two or three marks bearing the alleged common element, the marks “have been so intermixed or intermingled with other of applicant’s marks that do not contain the [common element] as to seriously dilute or diminish any possible consumer recognition that applicant possesses a family of . . . marks.”<sup>32</sup>

### III. FAME LIGHTENS THE TRADEMARK OWNER’S BURDEN

Because of the stringent requirements for establishing a family of marks, tribunals have sometimes focused on the strength of the group of marks, rather than the establishment of a family. For example, in *Dictaphone Corp. v. Dictamatic Corp.*, the court stated, “[i]n determining the effect of the use of the ‘Dicta-’ word family, it is not necessary to rule on the viability of the so-called ‘family of marks’ doctrine. It is sufficient to say merely that the use of a trademark together with a group of marks having the same prefix can enhance the strength of the trademark.”<sup>33</sup>

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(finding no “conjoint” use where the marks were not promoted together or in association with each other).

30. *Moore Bus. Forms, Inc. v. Rogersnap Bus. Forms, Inc.*, 163 U.S.P.Q. 303, 308 (TTAB 1969) (finding likelihood of confusion based on similarity of marks, not similarity to family of marks).

31. *Id.* at 304.

32. *Dap, Inc. v. Flex-O-Glass, Inc.*, 191 U.S.P.Q. 266, 270 (TTAB 1976). *See also Mallinckrodt*, 195 U.S.P.Q. at 668 (finding that promotional pictures displaying three of the alleged family marks together with eight other marks was insufficient to establish that these marks have come to be recognized and associated together by the purchasing public).

33. *Dictaphone Corp. v. Dictamatic Corp.*, 199 U.S.P.Q. 437, 442 (D. Or. 1978) (stating that

The strength of trademarks can often be demonstrated by another factor that depends on evidence of extensive use, advertising, and promotion; namely, the fame of the mark.<sup>34</sup> Obviously, despite the somewhat similar evidence needed to establish either a family of marks or the fame of a group of marks having a common element, there are differences between the two doctrines.

For instance, famous marks need not be unique, because the fame or recognition may overshadow similar marks owned by others.<sup>35</sup> In addition, famous marks may enjoy an enhanced scope of legal protection because consumers may come to associate the famous mark with diverse products.<sup>36</sup> “A strong mark . . . casts a long shadow which competitors must avoid.”<sup>37</sup>

Some tribunals have relied upon the fame of a set of marks to lower the bar for a party to establish either a family of marks or a likelihood of confusion. While these cases have not always *explicitly* relied on the fame of the marks as a determining factor, they have relied on such evidence of fame to overcome some of the difficulties in asserting the family of marks doctrine. These difficulties include the distinctiveness of the common element or the application of a family of marks to unrelated goods.

#### *A. Distinctiveness of the Common Element*

One way in which fame lowers the bar is to allow challenges based on likelihood of confusion to a newcomer’s adoption of a descriptive or commonly used element that also happens to be the unifying theme of

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“[[t]he use of ‘Dictaphone’ together with other marks having ‘Dict-’ or ‘Dicta-’ as a prefix strengthens ‘Dictaphone’ and increases the likelihood of confusion between ‘Dictaphone’ and ‘Dictamatic[.]’”).

34. See *Bose Corp. v. QSC Audio Prods., Inc.*, 293 F.3d 1367, 1371 (Fed. Cir. 2002).

35. See *Tiffany & Co. v. Classic Motor Carriages, Inc.*, 10 U.S.P.Q.2d 1835, 1840-41 (TTAB 1989) (holding that the long use and advertising, and substantial publicity of the TIFFANY mark established a likelihood of confusion despite the fact the TIFFANY is not a unique name); *Polo Fashions Inc. v. La Loren, Inc.*, 224 U.S.P.Q. 509, 512 (TTAB 1984) (holding that the sales and advertising expenditures is evidence of the significance of the LOREN marks in the marketplace and that it is more than adequate to rebut any inference of the third party uses of LOR for clothing and toiletries).

36. *Tiffany & Co.*, 10 U.S.P.Q.2d at 1840-41 (holding that the famous TIFFANY mark for jewelry was likely to be infringed by CLASSIC TIFFANY for automobiles); *Harley-Davidson Motor Co., v. Pierce Foods Corp.*, 231 U.S.P.Q. 857, 862-63 (TTAB 1986) (holding that due to the long use and extensive promotion of the HARLEY-DAVIDSON mark and HARLEY or HOG nicknames for motorcycles, a consumer would likely be confused with the mark HARLEY-HOG for pork products).

37. *Kenner Parker Toys Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 353 (Fed. Cir. 1992).

the senior user's group of famous marks. This may occur through the well-known doctrine of secondary meaning.

For example, in *Aloe Crème Laboratories, Inc. v. Aloe 99, Inc.*, the TTAB held that an opposer had established a family of marks characterized by the prefix ALO, despite the common element being the phonetic spelling of the generic name for an ingredient in the applicant's and opposer's goods, namely aloe in cosmetic products.<sup>38</sup> The Board held that "because of the original, and for many years, exclusive adoption by opposer of a long list of ALO prefixed marks . . . and opposer's long and extensive use and advertising of these marks, many of which in concert, . . . it must be held that each of opposer's ALO trademarked products acquired a 'secondary meaning' denoting products originating from opposer."<sup>39</sup> The Board also stated that this same evidence not only showed secondary meaning, but also showed that the opposer had established a family of marks.<sup>40</sup>

Although a showing of secondary meaning is not completely synonymous with fame, these are similar concepts, in that both involve proof of long-time use, extensive sales and significant advertising or promotion. In sum, a showing of secondary meaning may allow even a common element that is descriptive to form the basis for a finding of likelihood of confusion.

#### *B. Different Goods*

Even if the goods identified by the group of trademarks are not related to the goods identified by the allegedly conflicting mark, the fame of a group of marks having a common element may also make it easier to prove likelihood of confusion.

One example of a well-known family of marks is the MC and MAC marks owned by McDonald's Corp, the fast-food restaurant chain.<sup>41</sup> Because of the fame of this group of marks, both the TTAB and the courts have found a likelihood of confusion with respect to other marks that also contain the MC or MAC component, even if the other marks identify completely unrelated goods and services.

In *McDonald's Corp. v. McClain*, the TTAB held that, while "ordinary people would certainly not mistake legal services for fast food chain restaurant services, we think some sort of a connection with

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38. *Aloe Crème Laboratories, Inc. v. Aloe 99, Inc.*, 188 U.S.P.Q. 316, 326 (TTAB 1975).

39. *Id.*

40. *Id.*

41. See MCCARTHY, *supra* note 13, at § 23:61.

[McDonald's] would be falsely assumed because of the similarity of [the mark MCCLAIM] to the members of [McDonald's] famous family of 'Mc' marks."<sup>42</sup> Similarly, in *McDonald's Corp. v. Druck & Gerner, DDS., P.C.*, the U.S. District Court for the Northern District of New York found that the mark MCDENTAL infringed McDonald's family of marks, despite the lack of any evidence of the proximity of the products or the likelihood that McDonald's will ever enter the field of dental services.<sup>43</sup> The court held that the McDonald's family of marks was strong due to the widespread familiarity of the public with McDonald's use of "Mc" language.<sup>44</sup>

Similarly, in *International Diagnostic Tech., Inc. v. Miles Laboratories, Inc.*, the Federal Circuit affirmed the TTAB's reliance on the fame of group of marks to establish a family of marks, even though the goods of the parties were different.<sup>45</sup> The court stated:

The board added that the evidence demonstrates 'the renown of opposer's [Miles'] line of -STIX products acquired over many years of use and through sales in the hundreds of millions of dollars' and that Miles 'has also spent millions of dollars in advertising its products through various media.' Accordingly, it concluded that International's mark, used in connection with samplers employed with its diagnostic equipment, so resembles Miles' -STIX family of marks for Miles' diagnostic reagent strips that confusion is likely.<sup>46</sup>

Although the court and the TTAB found that the different products did have some striking similarities, the fame of the marks aided their determination that confusion was likely despite the differences in the parties' goods.<sup>47</sup>

In sum, famous marks are entitled to a broader scope of protection than other marks, and thus the protection extends to a wider variety of products. Courts have applied this general principle to a group of famous marks having a common element or unifying theme, overcoming the difficulty in establishing a likelihood of confusion with respect to other marks that identify unrelated goods or services.

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42. *McDonald's Corp. v. McClain*, 37 U.S.P.Q.2d 1274, 1276 (TTAB 1995).

43. *McDonald's Corp. v. Druck & Gerner, DDS., P.C.*, 814 F. Supp. 1127, 1135 (N.D.N.Y. 1993).

44. *Id.* at 1134. See also *Quality Inns Int'l, Inc. v. McDonald's Corp.*, 695 F. Supp. 198, 221 (D. Md. 1988) (holding that there was a likelihood of confusion between MCSLEEP and McDonald's family of marks).

45. *Int'l Diagnostic Tech., Inc. v. Miles Laboratories, Inc.*, 746 F.2d 798, 800 (Fed. Cir. 1984).

46. *Id.*

47. *Id.*

## IV. CHOOSING FAME OVER FAMILY

*A. Courts*

When analyzing single marks, courts often consider fame as a “dominant factor” in a likelihood of confusion analysis.<sup>48</sup> Courts have also recently concentrated on the fame of a group of marks to establish the strength of the group of marks, rather than to rely on the family of marks doctrine.

For example, the case of *Nina Ricci, S.A.R.L. v. E.T.F. Enterprises, Inc.*,<sup>49</sup> involved an opposition to the registration of the mark VITTORIO RICCI for various clothing and accessories, shoes, and retail store services. The opposer owned several marks including NINA RICCI, SIGNORICCI, and CAPRICCI for perfumes, toiletries, and cosmetic products.<sup>50</sup> The opposer also owned the mark MADEMOISELLE RICCI for a wide variety of clothing and accessories for women.<sup>51</sup>

In the decision below, the TTAB found that the components VITTORIO and NINA of the respective marks were obviously different in sound, appearance, and connotation.<sup>52</sup> The TTAB also accorded little or no importance to the increasing sales of items under the opposer’s marks.<sup>53</sup> Although the TTAB also recognized that the common element RICCI was identical in the respective marks of the two parties, the TTAB nonetheless dismissed the opposition.<sup>54</sup>

The Federal Circuit reversed, finding that the TTAB had failed to consider the other marks of the opposer and their effect on the likelihood of confusion analysis.<sup>55</sup> *Nina Ricci* argued that these other marks indicate that the RICCI suffix is a “unifying name” in the opposer’s marks and the dominant and significant part of opposer’s marks in identifying its goods.<sup>56</sup> The Federal Circuit, without even discussing whether or not the opposer had established a family of marks, concluded that the opposer had demonstrated that there was a likelihood of confusion between NINA RICCI “and related marks,” and the

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48. *Recot Inc. v. Becton*, 214 F.3d 1322, 1327 (Fed. Cir. 2000) (holding that FIDO-LAY for dog treats was likely to be confused with FRITO-LAY for human snack food).

49. *Nina Ricci, S.A.R.L. v. E.T.F. Enters., Inc.*, 12 U.S.P.Q.2d 1901 (Fed. Cir. 1989).

50. *Id.* at 1902.

51. *Id.*

52. *Id.* at 1903.

53. *Id.*

54. *Id.*

55. *Nina Ricci*, 12 U.S.P.Q.2d at 1903.

56. *Id.*

applicant's VITTORIO RICCI.<sup>57</sup> In reaching its conclusion, the court reiterated that "there is no excuse for even approaching a well-known trademark of a competitor . . . and all doubt as to whether confusion, mistake, or deception is likely is to be resolved against the newcomer, especially where the established mark is one which is famous."<sup>58</sup>

Similarly, the recent case of *Bose Corp. v. QSC Audio Prods., Inc.*,<sup>59</sup> began as an opposition to an applicant's attempt to register the mark POWERWAVE for amplifiers and power amplifiers. The opposer, Bose, owned the mark WAVE for audio goods including, radios, clock radios, audio tape recorders and players, portable radio and cassette recorder combinations, compact stereo systems and portable compact disc players, and the mark ACOUSTIC WAVE for loudspeaker systems and music systems consisting of a loudspeaker system and amplifier and at least one of a radio tuner, compact disc player, and audio tape cassette player.<sup>60</sup>

In the proceeding below, the TTAB held that Bose failed to establish the fame of its marks WAVE and POWER WAVE.<sup>61</sup> The TTAB also found that both marks, by including WAVE, were suggestive of sound waves and radio waves.<sup>62</sup> The TTAB also found the applicant's POWERWAVE mark to be suggestive and went on to hold that the marks of the respective parties were different enough in sound and connotation as to create distinctly different commercial impressions.<sup>63</sup>

On appeal, the Federal Circuit reversed, holding that the opposer's marks were "famous and entitled to broad protection."<sup>64</sup> Rather than addressing whether the opposer's marks formed a family, the court stated, "[t]he presence of the *root element* WAVE upon this court's review, introduces a strong similarity in all three marks."<sup>65</sup> In particular, the court held that the presence of WAVE in POWERWAVE conveyed the same overall impression as WAVE in the opposer's marks and that the additional component POWER was insufficient to overcome this

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57. *Id.* at 1903-04.

58. *Id.* at 1904 (quoting *Planter's Nut & Chocolate Co. v. Crown Nut Co., Inc.*, 305 F.2d 916, 924-25 (CCPA 1962)).

59. *Bose Corp. v. QSC Audio Prods., Inc.*, 293 F.3d 1367 (Fed. Cir. 2002).

60. *Id.* at 1369.

61. *Id.* at 1373.

62. *Id.* at 1377.

63. *Id.*

64. *Id.* at 1376.

65. *Bose Corp.*, 293 F.3d at 1378 (emphasis added).

similar impression.<sup>66</sup> Thus, in finding likelihood of confusion, the Federal Circuit relied on both the fame of the marks—as well as the common “root element” WAVE—rather than on the family of marks doctrine.

In sum, both *Nina Ricci* and *Bose* illustrate the Federal Circuit’s focus on fame rather than the family of marks doctrine in determining likelihood of confusion. Both these cases involved marks with a “unifying theme” or “common root element”; and yet, although the family of marks doctrine appeared to be a potentially viable theory in each case, the court did not even mention it.

### B. TTAB

In the recent case of *Bridgestone/Firestone North American Tire, LLC v. Silverstone Berhad*,<sup>67</sup> the Board followed the Federal Circuit’s lead in focusing on the fame of a group of marks rather than on the question of whether the group of marks represented a family of marks. This case involved a set of consolidated proceedings in the nature of oppositions to a series of applications to register SILVERSTONE for tires.<sup>68</sup> The opposers owned the names and marks FIRESTONE and BRIDGESTONE/FIRESTONE for tires, thereby creating a common unifying theme characterized by the “STONE” suffix.<sup>69</sup>

The TTAB sustained the oppositions based not only on the fame of the FIRESTONE and BRIDGESTONE/FIRESTONE marks and names but also on the common STONE suffix.<sup>70</sup> While the TTAB noted that the opposers were “essentially asserting a family of “STONE’-suffixed marks,” it did not analyze the case under the family of marks doctrine.<sup>71</sup>

Instead, the TTAB focused on the fame of the group of marks and found a likelihood of confusion even though there were substantial differences in sound, appearance, or meaning between the marks of the respective parties.<sup>72</sup> Also, while the applicant had introduced some evidence of third party use of the component STONE in the general automotive industry, the TTAB noted that these uses were irrelevant either to the applicant’s or to the opposers’ uses of their respective marks

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66. *Id.*

67. *Bridgestone/Firestone N. Am. Tire, LLC v. Silverstone Berhad*, 2003 WL 1559659 (TTAB 2003).

68. *Id.* at \*1.

69. *Id.*

70. *Id.* at \*10 (also holding that SILVERSTONE was primarily merely a surname).

71. *Id.* at \*9.

72. *Id.*

for tires.<sup>73</sup>

The TTAB also relied on the opposers' use of their STONE suffix in a multi-brand marketing strategy – thus establishing conjoint promotion and association.<sup>74</sup> Nevertheless, rather than relying on the family of marks doctrine, the TTAB instead focused on the fame of the marks, which was clearly evident from the record.<sup>75</sup> The TTAB reiterated that there is “no excuse for even approaching the well-known trademark of a competitor . . . and all doubt as to whether confusion, mistake, or deception is likely is to be resolved against the newcomer, especially when the established mark is one which is famous.”<sup>76</sup>

## V. CONCLUSION

In conclusion, the fame of a group of marks characterized by a common element is a dominant factor in a likelihood of confusion analysis, not only strengthening the mark, but also easing the burden in proving likelihood of confusion. Recently, the courts, and particularly the Federal Circuit, have tended to focus on the fame of a group of marks having a common element rather than on a family of marks theory. The TTAB has followed the Federal Circuit's lead and has given much weight to the fame of a group of marks that contain a common element, without requiring the senior user to establish that it owns a family of marks.

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73. *Bridgestone/Firestone*, 2003 WL 1559659 at \*11.

74. *Id.* at \*10.

75. *Id.*

76. *Id.* (quoting *Kenner Parker Toys Inc. v. Rose Art Indus. Inc.*, 963 F.2d 350, 353 (Fed. Cir. 1992)).