

Pizza! Pizza!: Little Caesar's Repeated Term Slogans Are Not a "Family of Marks"

January 12, 2017 | Blog | By [Susan Neuberger Weller](#)

VIEWPOINT TOPICS

- Trademark & Copyright
 - Trademark Litigation
-

RELATED PRACTICES

- Trademark & Copyright
 - Trademark Litigation
-

RELATED INDUSTRIES

- Retail & Consumer Products

Although most people will recognize the ubiquitous PIZZA! PIZZA! slogan mark owned by the pizza chain [Little Caesar's](#), the company's collection of repeated term marks does not rise to the level of a "family of marks" according to the Trademark Trial and Appeal Board. In a precedential decision, the Board held that to grant this status to the slogan marks at issue would give Little Caesar's excessively broad rights not justified by the facts. *In re LC Trademarks, Inc. (TTAB December 29, 2016)*. However, the Board did clarify that proof of the existence of a "family of marks" can be a factor used to prove that otherwise descriptive marks have acquired distinctiveness.

So, what is a "family of marks?" According to the U.S. Court of Appeals for the Federal Circuit, it is 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." A family of marks may exist if the purchasing public recognizes that the common characteristic among the marks indicates a common origin of goods or services. Generally, but not exclusively, the "common characteristic" in a family of word marks is usually a similar prefix or suffix (for example, the a family of "Mc" formative marks owned by McDonald's Corp.), although there is no reason that it be limited to these types of elements.

How do you prove that you own a "family of marks?" To carry this burden, the U.S. Trademark Trial and Appeal Board reiterated in the Little Caesar's case that a trademark owner must show that its "family": (1) has a recognizable common characteristic, (2) that it is distinctive, and (3) that this distinctive and recognizable common characteristic has been promoted in such a way as to create "recognition among the purchasing public that the common characteristic is indicative of common origin of the goods or services."

So, what is needed to prove that an otherwise descriptive mark has become distinctive? Under Section 2(f) of the Trademark Act, proof of at least five years of substantially continuous and exclusive use of a mark may be sufficient grounds to find that the mark has acquired the distinctiveness necessary to function as a fully valid and enforceable trademark. However, if the mark is considered "highly descriptive," it may be necessary to prove that distinctiveness has been acquired through other types of evidence, such as:

- copying of the mark by third parties
- significant level of advertising expenditures
- significant level of sales success/revenue
- the length and exclusivity of the use
- unsolicited media coverage
- consumer studies

None of the above factors is determinative individually, and each case is decided based upon its own facts.

In the Little Caesar's case, the mark at issue – DEEP! DEEP! DISH PIZZA. -- had not been in use for at least five years and evidence on the factors above was not submitted to prove acquired distinctiveness. Rather, the company claimed that the mark had "acquired distinctiveness" because it was based upon and part of a "family of marks."

The good news for Little Caesar's is that its arguments on this legal issue were successful, and the Board clarified that the existence of a "family of marks" could be used as a factor to prove acquired distinctiveness under the appropriate circumstances. Unfortunately, the Board did not find that Little Caesar's had demonstrated that the mark at issue was part of a "family of marks." Rather, it determined that the company's repetition of differing, descriptive terms in slogans did not, by itself, overcome the descriptive nature of the slogans.

Finally, the Board did not find any evidence to support the third factor, namely, that the public had come to associate the common characteristic of the alleged "family of marks" as a source indicator. It noted that "the ultimate test in determining whether a designation has acquired distinctiveness is Applicant's success, rather than its efforts, in educating the public to associate the proposed mark with a single source."

Creating a "family of marks" is not immediate nor is it simple. However, with proper planning and a focused branding strategy, it can be done effectively and successfully with long-term and broad benefits.

Authors



Susan Neuberger Weller, Member

Susan Neuberger Weller manages the Trademark & Copyright Practice at Mintz. Susan assists clients with securing and protecting IP assets across the globe. She's worked with clients in a variety of industries, including pharmaceuticals, medical devices, software, electronics, and entertainment.