

Branding the Sandwich: Establishing Trademarks in Restaurant Menu Items

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Restaurants, whether quick-service or sit-down, are of course known by their brands. The menu items that one orders are not, however, necessarily known by brands. Such items can be merely descriptive or generic, such as “hamburger,” particularly if there is no special recipe for the dish itself. If the restaurant believes it serves a special item, prepared in a unique style or with a famous recipe or sauce, often it desires to distinguish that item with a brand—something that sets it apart from others’ products and lets consumers recognize it easily. The considerations that arise in the selection and promotion of such brands are the subject of this article.

When choosing a name for a menu item, with the goal of that name becoming a brand or trademark, several avenues are available. If the restaurant brand is strong and amenable to expansion, expanding that brand to menu items is a possibility. There is, of course, much precedent for such expansion. A well-known example is McDonald’s “Mc” family of marks, which includes McNuggets®, McSkillet®, McCafe® and McGriddles®, although McDonald’s also has many product brands that do not contain its famous “Mc” prefix. Establishing a family of marks in this manner can help develop the strength of the house mark—making rights easier to enforce—and make the family of brands less vulnerable to attack. Using a house mark as part of a menu item name bolsters the strength of not only the menu item brand but also the house mark.

Connecting the goodwill and reputation of the house mark with those of a particular product is not without risk. For example, the new product might not be as successful or as popular as past menu items, and the house mark could, as a result, lose some of its goodwill. Moreover, with any branded product, whether the brand relates to the house mark or not, one may be wedded to the original recipe or taste for that product, as they become inextricably linked to the product brand. If one decides to change that recipe or taste, one must consider whether to do so under the same product brand or whether to launch the revised product under a new mark.

Yet another option is to develop a secondary product brand for use on one or more products. An unconnected mark will not gain strength quite as quickly without the synergistic force of a family of marks. In time, however, and with a sufficient advertising budget, it may become quite strong. Brands can become well known if the product itself garners a following, such as Outback Steakhouse’s “Bloomin’ Onion™” or Pizza Express’s “Neptune” gourmet tuna/anchovy pizza or its “Bambinoccino” kids’ drink.

A middle course is to select a product brand that does not relate to the house mark directly but instead suggests it. Examples of this strategy are the Red Robin franchise’s stylized RR and Burger King’s BK.

The connection between the product brand and the suggested house mark may take more time to establish than would the connection between a product that shares its name with a house mark, but less time than would the strength of a wholly unconnected mark.

Of course, one may simply call each product by its common name (assuming it is a common product) and describe any unique attributes of the product in the menu. Such an approach may allow one to dispense with or minimize the depth of a trademark search. Believing that a product name is or should be descriptive does not necessarily make it so, as the Hard Rock Café painfully discovered when it included a “pig sandwich” on its menu and was sued. The plaintiff was initially awarded attorneys’ fees and costs upon a finding of willful infringement, only to have the award of attorneys’ fees reversed by the appellate court. *Texas Pig Stands, Inc. v. Hard Rock Cafe International*, 951 F.2d 684 (5th Cir. 1992). Although commentators have disagreed with the Texas district court’s determination that “pig sandwich” was neither generic nor merely descriptive, the appellate court did not reverse that determination.

Last, co-branding often is used for menu items for which a well-known product is used as an ingredient with the consent of and a license from the trademark owner. This strategy allows a restaurant to capitalize on either its or another’s strong brand and share that goodwill with a menu item that might not be as well known or that is not particularly distinctive. For instance, T.G.I. Friday’s has incorporated JACK DANIEL’S products into its JACK DANIEL’S Grill line of menu items, allowing it to capitalize on the brand strength of the well-known whiskey. In addition to adding a name brand as an ingredient, menu items can be co-branded with marks corresponding to specific weight-loss programs, such as WEIGHT WATCHERS. As well as these benefits, any co-brand of menu items shares the risks of co-branding in other environments. Such risks include the potential for harm to one brand if the other suffers an injury to its reputation and the potential that consumers will not recognize the co-brand as that of another party.

The strategy for availability searching should consider that menu item brands, however well publicized or sold, might not be registered. However, if the item brand is an extension of a house brand, it may be discovered in a search for the restaurant brand. Searching should include not only the applicable food or beverage categories but also restaurant services, which can, depending on the facts in each situation, be considered likely to cause confusion. One also should not forget that there can be confusion, or claims thereof, even if the food items are sold in different channels, such as the “Skillet Sensations” mark, which was chosen by separate parties for both restaurant menu items and prepared frozen entrees, resulting in a trademark infringement claim by the alleged prior user and a change of mark for the newcomer.

In the United States, once a brand is selected and registration sought, one must select and submit appropriate specimens of use. If a product is packaged and sold in materials that display the brand, such as a branded wrapper or cup, it is fairly easy to meet this requirement. The requirement can, however, pose challenges for a restaurant menu item brand. According to the *Trademark Manual of Examining Procedure*, menus are considered displays associated with goods. Section 903.03(f) of the TMEP provides that menus and similar items can serve as acceptable specimens as long as they are

designed to catch the attention of purchasers and prospective purchasers as an inducement to make a sale. Further, the display must prominently display the trademark in question and associate it with, or relate it to, the goods. ... The display must be related to the sale of the goods such that an association of the two is inevitable.

Menu item brands, like all trademarks, help us recognize a particular product so that we can enjoy it again and again. Successful brands guide customers to choose the brand owner’s restaurant above all others.