

## [Food Fight: Is 'Footlong' Really Just About 12 Inches?](#)

### ***Media Law Bulletin***

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In an era where leading a healthy lifestyle is at the peak of public consciousness, voracious eaters take comfort—there's a nationwide feud in the food industry over the term "footlong." And, better yet, the healthy fast food alternative, Doctor's Associates, Inc., better known as Subway, started it.

### **Foot-long Fever**

Five years ago, Subway franchise owner Stuart Frankel of Miami, Fla., came up with a brilliant idea. He grew tired of the lag in sales on weekends in his Subway shop and decided to offer 12-inch sandwiches for a flat five dollars, marketed as "\$5 Footlongs." Soon, he had customers lining up out the door for what apparently was perceived to be a great deal. Subway's chief of marketing learned of the \$5 promotion deal that was such a hit in Florida and replaced Subway's prior promotion strategy as the healthy alternative to greasy fast food options, which featured Jared Fogle as Subway's spokesperson after having lost 245 pounds on an all-Subway diet. By early 2008, Subway was marketing the \$5 footlong deal nationally with great success. During a time when everyone's business was slow, Subway's sales grew 17 percent in 2008.

Ironically, Subway's new marketing campaign has, in fact, sent rippling effects among fast food chains to promulgate a whole line of foot-long sized food items of epic proportions. In 2010, Sonic added a \$3 foot-long hot dog topped with hot chili and melted cheese to its menu. Sonic called it the "Footlong Quarter Pound Coney." Carl's Jr. Restaurants and its sister chain Hardee's test marketed a foot-long cheeseburger in Southern California and Indiana last year. The cheeseburger contained three burger patties and three cheese slices and stirred quite a controversy with its 850 calories and 20 grams of saturated fat. And, not to be outdone, Quizno's began a spicy 13-inch sandwich menu not too long thereafter, dubbed "Toasty Torpedoes."

## **Nationwide Food Fight**

In an era where messages of portion control, calorie-counting and healthy eating are everywhere, restaurant companies are nonetheless working hard to preserve the ability to sell and market food products that are 12 inches in size.

In conjunction with its "\$5 Footlongs" marketing campaign, Subway applied in November 2007 for the first of two trademarks for the term "footlong"—first, to refer to sandwiches and later in reference to restaurant services. While the Patent and Trademark Office has initially rejected Subway's attempt to register the term for restaurant services, Subway's trademark application for using the term for sandwiches is still pending.

Long John Silver's, Taco Bell Corporation, KFC Corporation, Dairy Queen, Pizza Hut, Inc., Domino's, A&W Restaurants, Inc. and many others have filed opposition proceedings against Subway in its application for registering the term "footlong" as a trademark. For example, in KFC Corporation's notice of opposition filing, KFC asserted that all KFC restaurants, along with the consuming public, will be damaged if Subway is granted exclusive rights in the term "footlong." Excluding others from legitimately using the term in connection with sandwiches or other closely related food products would, KFC alleged, injure KFC restaurants, the consuming public and others who use such language to identify their sandwiches and particularly the length of their sandwiches.

KFC's opposition papers, along with at least 10 other restaurant corporations that have filed oppositions to Subway's trademark registration application, eerily anticipate the kind of food demands restaurant corporations face from the consuming public.

## **The Non-Hyphenated, Grammatically Incorrect Term—A Noun or an Adjective?**

Amid the frenzy of foot-long fever, what exactly is the debate? The controversy is over the use of the apparently lucrative term 'footlong'—one word, without hyphenation. The debate can be pretty much reduced down to a single question: Does the term "footlong" denote Subway's series of foot-

long sandwiches or is it merely a descriptive term used to refer to food products that are approximately 12 inches long in size?

Since filing its registration application, Subway has tried to stop sandwich shops for using the term “footlong” to describe any of their sandwiches through various methods. For example, in January 2009, Subway sent a cease and desist letter to Sheetz, Inc. for its \$4 footlong sandwich campaign.

According to Subway’s cease and desist letters, the right to use the term “footlong” belongs exclusively to Subway and, moreover, offers of all other food products in advertisements using the term creates confusion to the average consumer. Subway followed up by filing suit in the U.S.

District Court for the Eastern District of Virginia and seeking a temporary restraining order to stop Sheetz from promoting its foot-long sandwiches as “footlong.” *Doctor’s Associates Inc. v Sheetz, Inc.*, Case No. 1:09CV88 (E.D. Va. Jan. 29, 2009) (complaint filed). The presiding judge over the suit against Sheetz, Inc., Judge Claude M. Hilton, denied Subway’s request for a temporary restraining order and the case was subsequently dismissed.

On January 31, 2011, Subway yet again embarked upon another attempt to stop another sandwich shop from using “footlong.” Subway sent a cease-and-desist letter to Casey’s General Stores, Inc., an Iowa-based convenience store with more than 1,600 stores all over the Midwest. Casey’s served one-foot-long sandwiches and used the term “footlong” in its menu. Upon receiving Subway’s cease and desist letter, Casey’s decided to take on Subway in its challenge. Rather than complying, on February 11, 2011, Casey’s fed fuel to the fire by filing suit against Subway in the U.S. District Court for the Southern District of Iowa seeking a declaration that its use of the term “footlong” is non-infringing. *Casey’s General Stores, Inc. v. Doctor’s Associates Inc.*, Case No. 11-cv-0064 (S.D. Iowa Feb. 11, 2011)(complaint filed).

More specifically, Casey’s complaint alleges that its use of the generic term “footlong” to describe the size of sandwiches is not a violation of any right owned by Subway, and that Subway has no trademark rights in the term “footlong.” Casey’s further asserts that Subway’s conduct constitutes unfair competition and that any attempt by Subway to assert trademark rights against Casey’s for its use of the term amounts to frivolous litigation, such that it is entitled to damages and attorneys’ fees. Subway has yet to file a response to Casey’s petition.

## **Nationwide Implications**

Some say that the outcome of the “footlong” trademark feud could affect restaurant menus across the nation, leaving more or less food on the table, so to speak. As fast food chains all over the country continue to ramp up to oppose Subway’s trademark application for the term “footlong” and Subway’s accompanying attempts to enforce its claimed ownership rights, we can’t help but wonder whether a bigger issue is being overlooked. If the average human stomach is the size of a closed fist . . . is the rest of the sandwich just ammunition to keep everyone in the fight?

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