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## [Subway's "Footlong" Trademark Infringement Claim a Real Stretch](#)

Posted on February 16, 2011 by [Steve Baird](#)



This scene from the [Minnesota State Fair](#) reveals how the "About a . . . Foot Long Hot Dog" stand is a "State Fair Taste Tradition. . . ." With respect to the name, I have always believed that the "About a . . ." qualifier is lawyer-driven to avoid false advertising lawsuits if a ruler might reveal a stretching of the truth and/or the wiener unintentionally coming up short on the promised twelve inches.

Turns out, we have much more to fear in the world of "Foot Longs" than literally false trademark claims or even stubby wieners in a bun at the State Fair, so, let's name that fear: [Subway](#).



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Yes, Subway claims to own the word "footlong" as a trademark for sub sandwiches. Now, I fully appreciate that Subway has probably spent lots and lots of money on [television advertising](#) for its "\$5 Footlongs" promotion, but to claim exclusive rights in the word "footlong" for subs is ridiculous (especially when the ads themselves have multiple references to the fact the term is directed to the length of the sub), in my not so humble opinion. Let's not forget that [Lite is generic for beer](#).

Subway's [cease and desist letter](#) prompted [Casey's General Store](#) (a [convenience store chain](#) based in Des Moines, Iowa) to bring a declaratory judgment [lawsuit](#):

"Specifically, this action seeks, *inter alia*, a declaration that Casey's use of the generic term "footlong" to describe a footlong submarine sandwich, commonly referred to as a "sub", is not a violation of any right currently owned by Subway; and it requests an order so saying and declaring that "footlong" for description of sandwiches including submarine sandwiches is generic. Further Casey's seeks an order that Subway's attempt to assert trademark rights against Casey's for its use of "footlong" for sandwiches and/or restaurant services is frivolous litigation and seeks an award of damages and attorney's fees against Subway."

If Casey's is right, this could satisfy the [exceptional case](#) provision of the Lanham Act, which could result in Subway being ordered to pay Casey's attorneys fees in defending against the claim.

It appears that Casey's aggressive response to the cease and desist letter is designed to take advantage of all the current focus and attention on "[trademark bullying](#)" -- although that specific phrase does not appear anywhere in the complaint.

As you may recall, [I have suggested](#) that "there seem to be enough existing legal tools to handle a real trademark bully, namely, one that brings frivolous, bad faith, vexatious or objectively baseless litigation." Casey's appears uniquely poised to test this proposition.

In support of its claim of frivolity, Casey's relies, in part, on a [transcript](#) from a 2009 Subway case where a federal district court judge in the Eastern District of Virginia indicated he thought that "footlong" should be considered generic for subs.

With respect to Subway's pending trademark and service mark applications for "Footlong" at the USPTO, Casey's has this to say:

Subway has sought trademark protection for "footlong" for sandwiches and restaurant services in trademark application Nos. [77/752,328](#) ("Footlong" for restaurant services) and [77/324,328](#) ("Footlong" for sandwiches). The application for "footlong" for sandwiches was approved for publication by the trademark examiner, but has not issued as a registration because there are [many ongoing opposition proceedings](#) filed by the likes of Long John Silvers, Taco Bell Corporation, Kentucky Fried Chicken, Dairy Queen, Pizza Hut, Inc., and Domino's, just to name a few. The application for "footlong" for restaurant services is currently under rejection as a mark that consists of the generic name for something that is served in providing restaurant services. A true and correct copy of the rejection issued by the trademark examiner is attached hereto as [Exhibit C](#). Subway's attempt to establish an acquired distinctiveness under § 2(f) of the Lanham Act has to date failed.



Here's a question, how on earth did the word "footlong" for sub sandwiches get approved for publication at the USPTO?

Here's another, does Subway deserve to have each and every customer measure the length of their purchased sub to see if it comes up short, and if so, suffer the consequences failing to add the "About a" qualifier too?



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