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# Trademark Trial and Appeal Board: Family of Marks can have Different Owners so Long as there is Unity of Control

By Emily Weiss

*Wise F&I, LLC, et al. v. Allstate Insurance Co., Consolidated Opp. No. 91226028 (T.T.A.B. Sept. 23, 2016)*

*In Wise F&I, LLC v. Allstate Insurance Co., Consolidated Opp. No. 91226028 (T.T.A.B. Sept. 23, [More](#))*

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In *Wise F&I, LLC v. Allstate Insurance Co.*, Consolidated Opp. No. 91226028 (T.T.A.B. Sept. 23, 2016), the Trademark Trial and Appeal Board (the “Board”) addressed whether a family of marks can form the basis of a likelihood-of-confusion claim when the registrations for such marks are not all owned by a single entity. The Board held that the marks in a family of marks can be owned by multiple entities so long as the entities are related and there is “unity of control” over the marks.

Applicant Allstate Insurance Co. (“Allstate”) had applied to register the marks MILEWISE and ALLSTATE MILEWISE for insurance services. Slip op. at 3. Opposers were four related entities, three of which were subsidiaries of the fourth. *Id.* at 5. Opposers jointly filed notices of oppositions against both applications, alleging likelihood of confusion under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d). *Id.* at 3. Opposers based their claim on prior use and registration of eight registrations and one application (which had since matured to registration) for various WISE-inclusive marks for automotive

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finance, insurance, and warranty services, and identity theft insurance. *Id.* at 3-4. The registrations were not all owned by any single Opposer, but rather all four Opposers owned one or more registrations. *Id.* Based on these marks, Opposers alleged that they owned a WISE family of marks, and that Allstate's MILEWISE and ALLSTATEMILEWISE marks were likely to cause confusion with their family of WISE marks. *Id.* at 5.

Allstate filed a motion to dismiss, asserting that Opposers could not base their Section 2(d) claim on a family of marks because the registrations were not owned by a single entity and therefore, as a matter of law, the common characteristics of the alleged family of marks could not identify a common source of origin. *Id.* In response, Opposers argued that the family-of-marks doctrine does not require single ownership, but rather that "the marks share a common origin where the shared characteristics of the marks is recognized as indicative of a common origin of the goods or services." *Id.* at 8.

The Board agreed with Opposers, explaining that "related entities can rely on a family of marks as a basis for a Section 2(d) claim—notwithstanding the fact that the pleaded marks are not all owned by a single entity—if the complaint contains sufficient factual allegations that they are related, and that there is unity of control over the pleaded marks such that the marks are indicative of a single source." *Id.* at 11. The Board stated that allegations sufficient to show unity of control depend on the circumstances of the case. *Id.* at 12. In an earlier case, the Board had found "unity of control" because one entity owned all of the outstanding stock of the other entity and "thus controlled the activities and operations of [the subsidiary], including the selection, adoption and use of the trademarks." *Id.*

Here, there was no allegation of "unity of control" showing that Opposers' marks identified a single source for all of the services identified by the respective marks. *Id.* The Board therefore granted the motion to dismiss without prejudice and allowed Opposers to file an amended notice of opposition. *Id.* at 15.

We look to the amended notice and subsequent proceedings, if any, for more guidance on what allegations would be sufficient to support a claim of unity of control.