

TRADEMARK & UNFAIR COMPETITION

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Class 5: Distinctiveness Analysis of Nonverbal Marks

CLASS OUTLINE

- Nonverbal Marks
 - Trade Dress
 - Color
 - Product Configuration (i.e., “design”)
 - The Product Packaging - Product Configuration Divide













Trade Dress

- Trade dress originally referred to overall visual impact of packaging (the way the goods were “dressed”)
- Now encompasses product design itself, or design features of location where service is provided (can apply to both goods & services)
- Can be totality of elements, or some subset of:
 - Size and shape
 - Color combinations
 - Graphics, fonts
 - Costume or make up (e.g., of performers)

History of Trade Dress

1. Common Law: Trade dress has always been protectable to some degree as “unfair competition” but not necessarily as “trademark infringement”
2. Lanham Act: Trade dress is protectable under the general unfair competition remedy -- §43(a)
3. Registration: PTO would not register trade dress for the first ten years of Lanham Act (1948-1958), then reversed course and began to register

To be protectable, trade dress must be:

1. Distinctive; and
2. Non-functional

Two Pesos v. Taco Cabana



Jury Responses in *Taco Cabana*:

1. Taco Cabana has a trade dress
2. The trade dress is non-functional
3. The trade dress is inherently distinctive
4. The trade dress has not acquired secondary meaning
5. The alleged infringement creates likelihood of confusion

Taco Cabana's trade dress description

“ ...a festive eating atmosphere having interior dining and patio areas decorated with artifacts, bright colors, paintings, and murals. The patio includes interior and exterior areas with the interior patio capable of being sealed off from the outside patio by overhead garage doors. The stepped exterior of the building is a festive and vivid color scheme using top border paint and neon stripes. Bright awnings and umbrellas continue the theme.”







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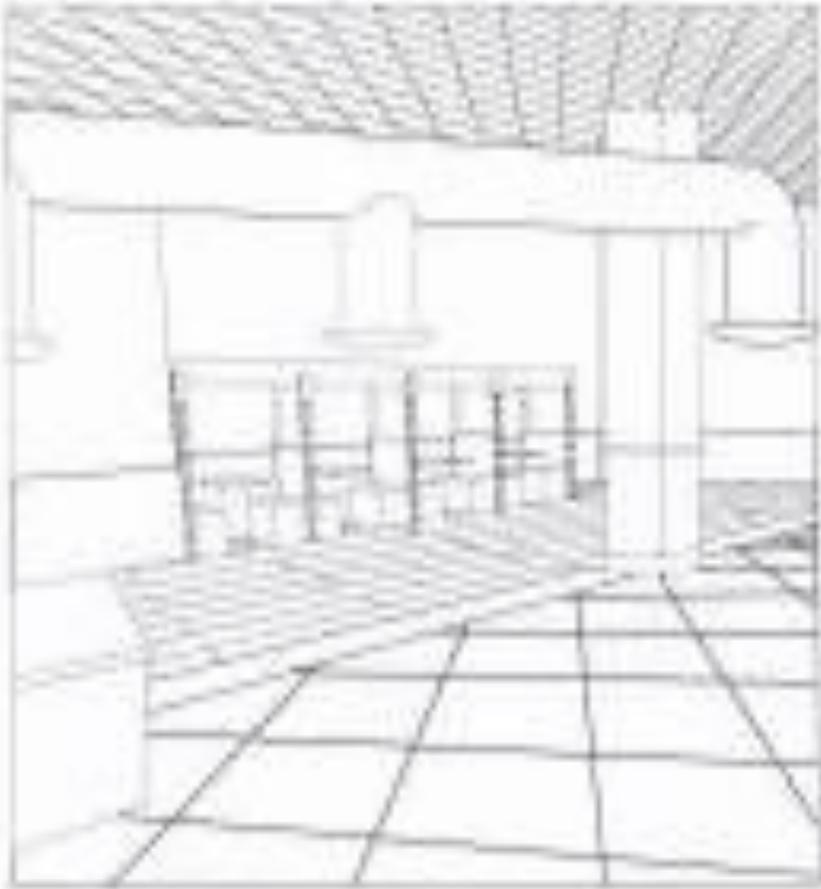
Trade Dress and Distinctiveness





Potbelly sued Coggins, claiming trade dress infringement because Coggins “was offering similar six-inch conveyor subs at a similar base price, a comparable selection of drinks and snacks, and the same style of cubby-hole shelves containing chips. Other similarities included design elements such as natural wood and concrete floors, a tin-style ceiling, signs with a vintage look and a chalkboard menu.”

Potbelly Sandwich Works' application to register its trade dress:



“Color is not claimed as a feature of the mark. The mark consists of trade dress for the appearance and design of the interior of a restaurant produced by a combination of a tin ceiling, open duct work, wainscoting and a floor having a wood section and a hard surface section. The solid lines show the positioning of the mark in connection with the restaurant and those features claimed by the applicant as its mark.”



RESTAURANTS

LOCATIONS DESIGN ART MUSIC

Architectural Abduction.

We think food tastes better when it's served in a cool environment. The design of our restaurants mirrors the idea behind our food: simple materials put together creatively, elevating them to a higher level. Each Chipotle uses the same materials, but no two look the same. Yet each is unmistakably "Chipotle".

Nation's Restaurant News, Jan. 25, 1993:

SAN ANTONIO -- Taco Cabana, the Mexican patio cafe concept that last June won a \$3.7 million U.S. Supreme Court trade dress battle with Two Pesos Inc. of Houston, has agreed to acquire its longtime rival.

Richard Cervera, president of Taco Cabana, said, "We think we can convert those restaurants to Taco Cabana and realize some significant economies of scale . . ." He expects the company to convert the 22 full-size units involved in the proposed purchase . . .

Cervera said the trade-dress litigation may have been a secondary factor in Two Pesos' decision to sell. "In that we sued them all probably took some management focus away," he said. "I think the principal reason was that they just weren't making money. I think they had made \$400,000 year-to-date, and that probably would have gotten eaten up with just our attorneys' fees."

Potbelly to replace Coggins

Issue: 5/22/06 | News

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...ing to GW, ending a nearly 17-month legal fight with
...y.

...acy Schario said Coggins officially closed Wednesday. Potbelly,
...ill open in the space on June 5.

...ertain after it was sued by Illinois-based Potbelly. Potbelly sued
...between the two sandwich shops.

...ped represent Potbelly in the lawsuit against Coggins, said a
...y.

...settlement are confidential, he said two of the general
...to open any more stores infringing Potbelly trademark and for
...Tower location in order for Potbelly to move in.



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Trademark Assignment Abstract of Title

Total Assignments: 2

Serial #: [78455138](#) **Filing Dt:** 07/22/2004 **Reg #:** [3008760](#)

Registrant: J.D. Coggins SM LLC

Mark: COGGINS' SANDWICH MANUFACTORY

Assignment: 1

Reel/Frame: [3678/0900](#) **Received:** 12/14/2007 **Recorded:** 12/14/2007

Conveyance: ASSIGNS THE ENTIRE INTEREST

Assignor: [J.D. COGGINS SM LLC](#)

Assignee: [POTBELLY SANDWICH WORKS, LLC](#)
222 MERCHANDISE MART PLAZA
23RD FLOOR
CHICAGO, ILLINOIS 60654

Correspondent: SANA HAKIM
P.O. BOX 1135
CHICAGO, IL 60690-1135

Assignment: 2

Reel/Frame: [3696/0855](#) **Received:** 01/15/2008 **Recorded:** 01/15/2008

Conveyance: TRADEMARK COLLATERAL SECURITY AND PLEDGE AGREEMENT







Qualitex v. Jacobson Products





Pink	Saccharine	Sweet N'Low®
Blue	Aspartame	Equal®
Yellow	Sucralose	Splenda®





Wal-Mart v. Samara Brothers



Trade Dress and Distinctiveness

“In the case of product design, as in the case of color, we think that consumer predisposition to equate the feature with the source does not exist.”

And so...

Product packaging → can be inherently distinctive (& restaurant design is more like product packaging)

Product design → can't be; requires secondary meaning

“Merely decorative”

Examiner Handbook 1202.03 - Refusal on Basis of Ornamentation

Subject matter that is merely a decorative feature does not identify and distinguish the applicant's goods and, thus, does not function as a trademark. A decorative feature may include words, designs, slogans, or other trade dress. This matter should be refused registration because it is merely ornamentation and, therefore, does not function as a trademark as required by §§1, 2, and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052, and 1127.

“Commercial Impression”

Examiner Handbook 1202.03(a) - Commercial Impression:

The examining attorney must determine whether the overall commercial impression of the proposed mark is that of a trademark. Matter that is purely ornamental or decorative does not function as a trademark and is unregistrable on either the Principal Register or the Supplemental Register.

The significance of the proposed mark is a factor to consider when determining whether ornamental matter serves a trademark function. Common expressions and symbols (e.g., the peace symbol, “smiley face,” or the phrase “Have a Nice Day”) are normally not perceived as marks.

The examining attorney must also consider the size, location, and dominance of the proposed mark, as applied to the goods, to determine whether ornamental matter serves a trademark function.

Trade Dress and Distinctiveness

	Protectable?	Secondary Meaning Required?
Restaurant Design	Yes	No
Product Color	Yes	Yes
Product Design	Yes	Yes