

# Trademark Law

Prof. Madison

**Today: Acquired distinctiveness**

**Key concepts from Class 4:**

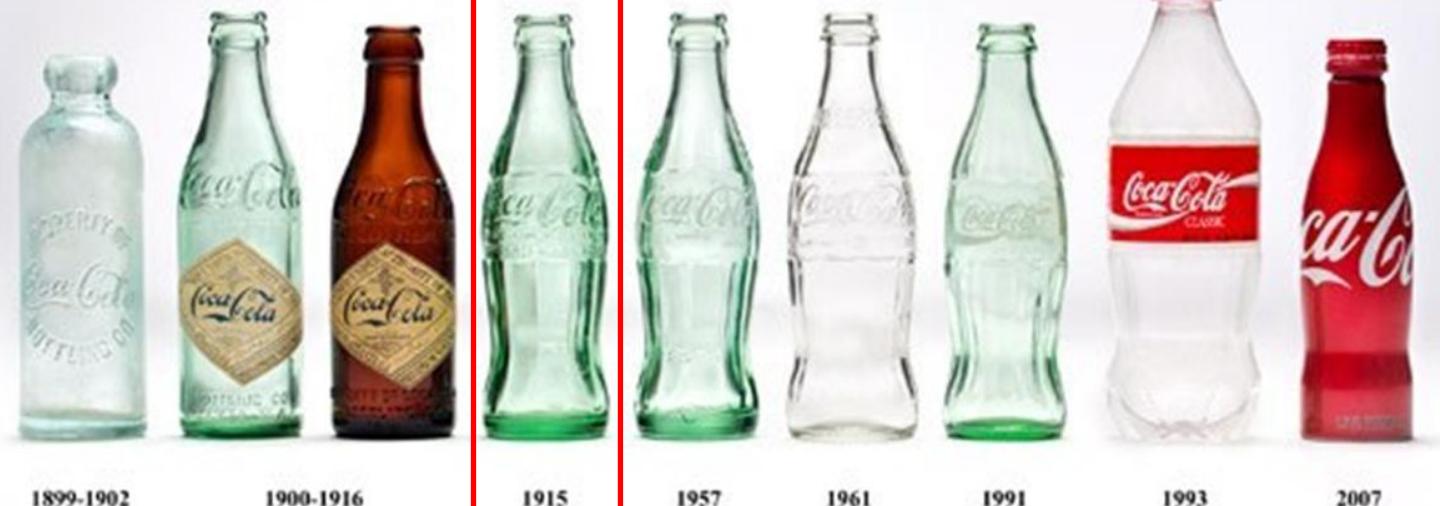
Legal rules and concepts as tools for problem solving.

Mark X for Product (Service) Y.

The *Abercrombie* distinctiveness spectrum.

Acquired distinctiveness and secondary meaning for word marks.

Design patent issued to TCCC, 1915. Valid for 14 years. Trademarks last – potentially – indefinitely.





SOUTH ELEVATION



EAST ELEVATION

“Cheddar’s” received a cease and desist letter from In ‘n Out.

In what respects is trademark law the right / best solution for In ‘n Out?

In what respects should TM law protect *Cheddar’s*?

In what respects should TM law protect *In ‘n Out*?



**Trade dress:** the design and/or appearance of things, including both their features and related marketing and advertising.

Should trade dress ever be protected via the Lanham Act?  
**If so**, should the *Abercrombie* distinctiveness spectrum be applied to trade dress claims? **If so**, how?

Do **consumers** rely on trade dress to distinguish the source of goods or services? Or do they look at the attractiveness of things, or the way they work? (Are the designs “merely ornamental” to them?)

Do **producers** acquire goodwill in trade dress? Or do they design things (and packaging) in order to make them attractive / saleable?

## Two Pesos, Inc. v. Taco Cabana, Inc. (U.S. 1992)



Do consumers believe that this restaurant has a particular name or source, *based on the design/décor*? Should they? Why? Should the restaurant owner have to *prove* that the design is distinctive as to source?



## SUN GLOW® PRESS PADS

Leading the industry in fit, performance and durability, **Sun Glow® Press Pads** are consistently used by more award-winning dry cleaning plants, by a margin of 8 to 1, than any other press pad on the market.

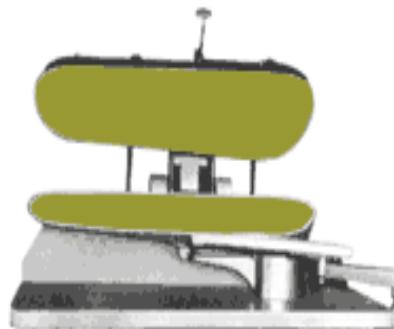


Color as trade dress.

## SUN GLOW® NOMEX® GRID PLATES

In 1995, Qualitex introduced the Sun Glow® Nomex® Grid Plate: the perfect complement to our Sun Glow® Press Pads.

Designed for superior performance, with a scientifically engineered metal baffle, Sun Glow® Nomex® Grid Plates will improve your finishing quality and efficiency by:



- reducing moisture and condensation
- virtually eliminating shine, moiré and double seam impressions
- evenly dispersing steam
- providing unsurpassed durability

Qualitex Co.  
v. Jacobsen  
Products Co.,  
Inc.  
(U.S. 1995)



Why and how are these colors distinctive as to source, or not?

Ask: Do consumers recognize an X for Y equation? How do you know?

Ask: Why does the thing look like that? To identify the source? Some other reason?



**Wal-Mart Stores, Inc. v.  
Samara Brothers, Inc.  
(U.S. 2000)**

**Wal-Mart Stores, Inc. v.  
Samara Brothers, Inc.  
(U.S. 2000)**



Plaintiff

Defendant





**In re Slokevage (Fed. Cir. 2006):  
Is the design inherently distinctive?**



**What's the trade dress claim based on?**

**Do consumers think that the trade dress is indicative of source?**

**LVL XIII Brands, Inc. v. Louis Vuitton Malletier S.A. (S.D.N.Y. 2016)**



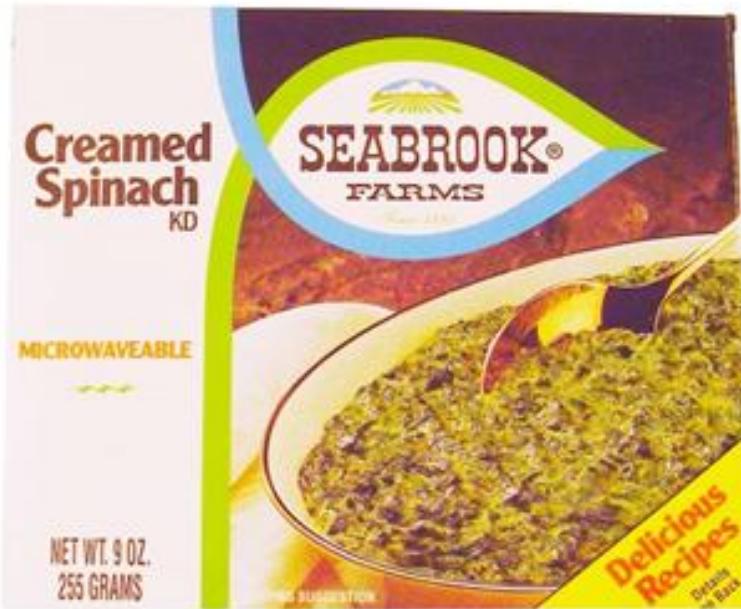
For footwear.

Are the “three stripes” product configuration, product packaging, or something else (“tertium quid”)?

What else do you want to know?

What questions do you ask your client?

# Alternatives to the *Abercrombie* spectrum for establishing distinctive trade dress:



**Seabrook Foods v. Bar-  
Well Foods, Ltd.  
(CCPA 1977)**

"Seabrook" factors:

1. Common basic shape or design
2. Unique or unusual in a field
3. Mere refinement of a commonly-adopted form of ornament for a class of goods
4. Capable of creating a commercial impression distinct from the accompanying words

Int. Cl.: 39

Prior U.S. Cls.: 100 and 105

United States Patent and Trademark Office

Reg. No. 2,859,845  
Registered July 6, 2004

SERVICE MARK  
PRINCIPAL REGISTER



AMAZING SPACES (TEXAS CORPORATION)  
9040 LOUETTA ROAD, SUITE B  
SPRING, TX 77379

FIRST USE 4-0-1998; IN COMMERCE 4-0-1998.  
SER. NO. 76-540,844, FILED 8-15-2003.

FOR: STORAGE SERVICES, IN CLASS 39 (U.S. CLS. 100 AND 105).  
DOMINIC J. FERRAIUOLO, EXAMINING ATTORNEY



**Is the star design (inherently) distinctive?  
Is it “common,” or “basic,” or “unusual?”  
*Relative to what?***

**Amazing Spaces, Inc. v. Metro Mini Storage  
(Fed. Cir. 2010)**

**“Menu infringement”**



“Chadders”



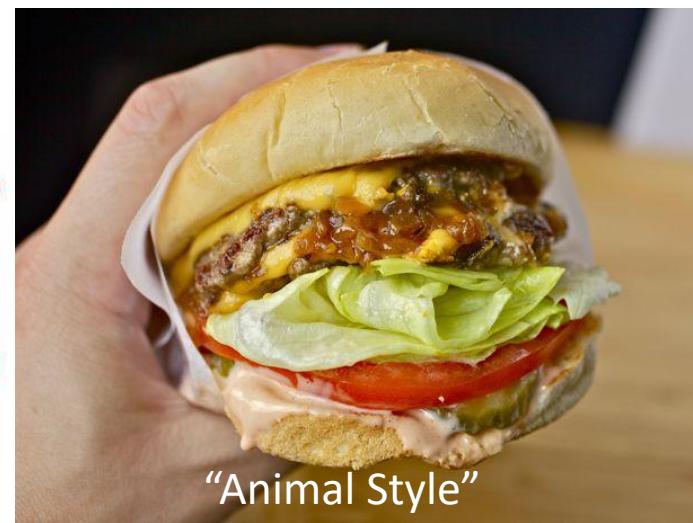
**“Burger infringement”**



“Wild Style”



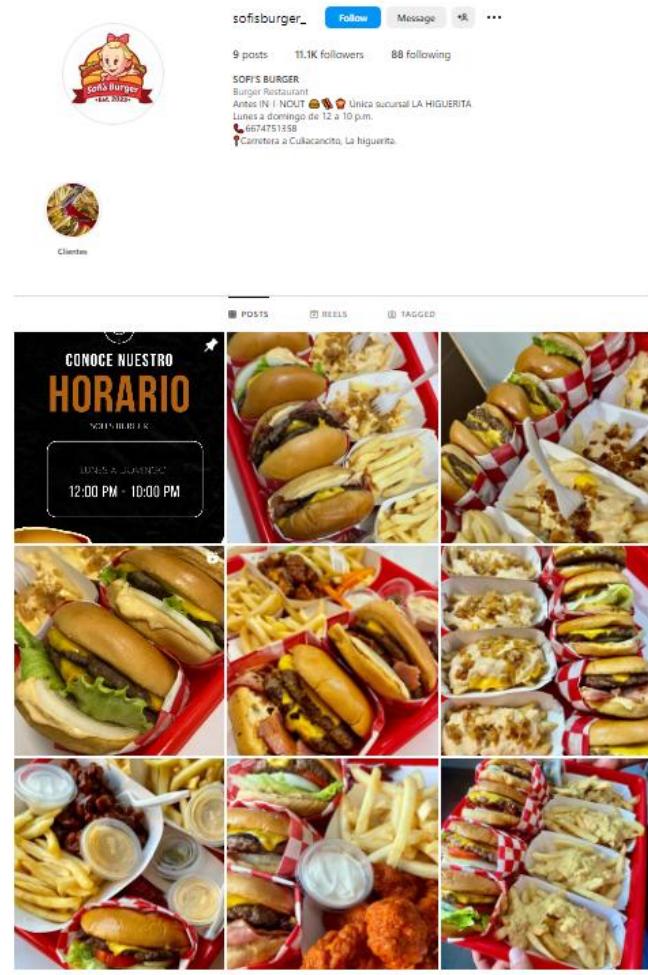
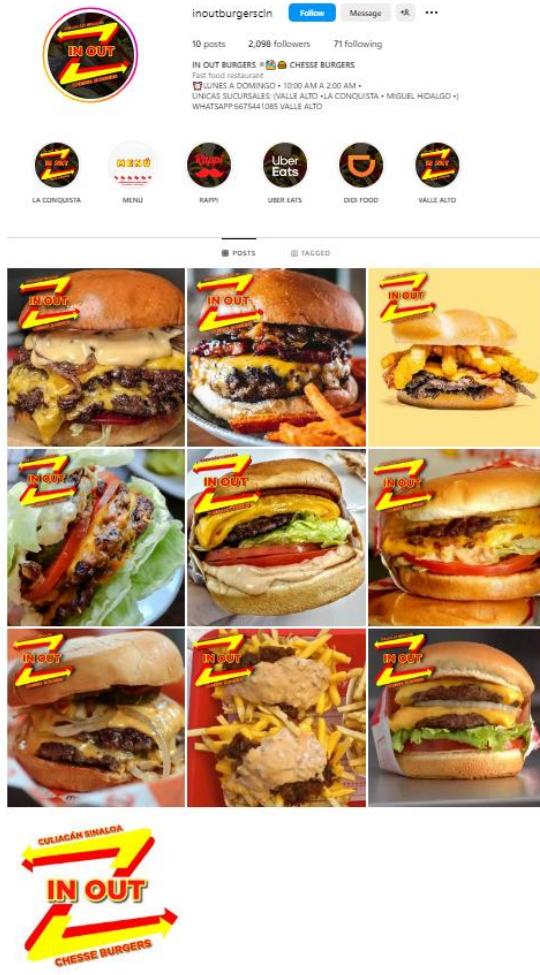
“In n Out”



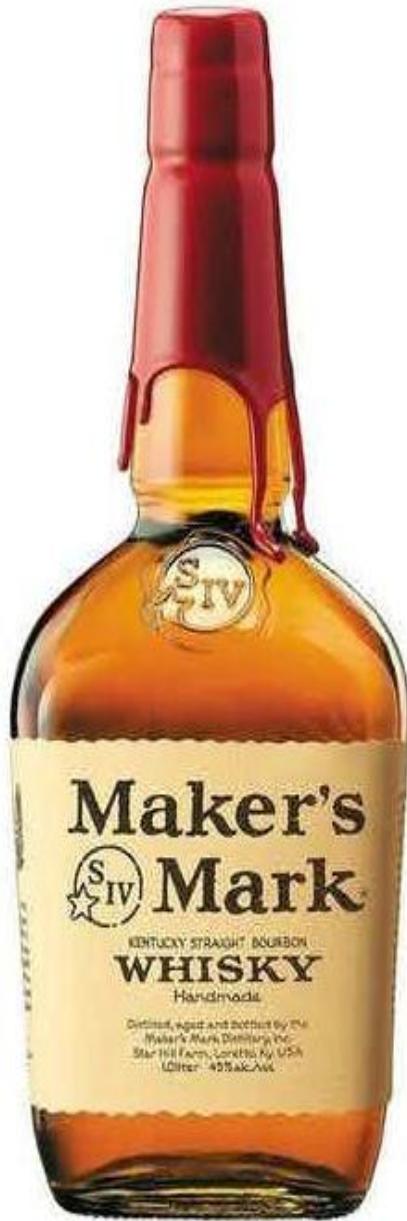
“Animal Style”

**Define the In-n-Out marks**

**Define them as product packaging, product design, or ‘tertium quid’**  
**Explain whether and how they are distinctive**



In 'n Out attracts a lot of copycats. These are in Mexico (in 2023).  
 Should intentional copying count as evidence of acquired distinctiveness of source for product configuration trade dress?



**Maker's Mark Distillery, Inc. v.  
Diageo North America, Inc.**  
(W.D. Ky. 2010; aff'd 6<sup>th</sup> Cir. 2012)



A COLUMBIA PRODUCTION

*The End*

