

Next Time: 777-88; 816-32

Administrative

**Class 19: Trade Dress  
And Genericide**

**Class 19: Trade Dress And Genericide**

Last Time

Lanham Act

Federal TM and Unfair Competition Law  
Title 15, Chapter 22

We still refer to the old Lanham Act section numbers

- 2 (Registration) = 15 USC 1052
- 32 (Infringement of registered marks) = 15 USC 1114)
- 43 (Infringement of unregistered marks) = 15 USC 1125

A Little Bit on Registration

Registration at the USPTO

Use-based system

First party to use gets the registration.  
Since 1989: Intent to use filing with constructive use priority date

Registration does not create the TM

Without it, can sue under 43(a) and state law.

Benefits of registration

1. Nationwide constructive use and notice.
2. Possibility of incontestable status after five years.
3. Right to sue in Federal Court

The Process, roughly

**Class 19: Trade Dress  
And Genericide**

Last Time

Distinctiveness

Test

Two Classes

Inherently Distinctive

NOT inherently Distinctive

Might become distinctive once secondary meaning

Classification

1. Generic

Unprotectable

2. Descriptive

Protectable with secondary meaning

Protectable below here

3. Suggestive

4. Arbitrary

5. Fanciful

Line between Descriptive and Suggestive?

**Class 19: Trade Dress And Genericide**

Trade Dress

Two Pesos v. Taco Cabana

Basic facts

Taco Cabana: Opened in 1978 in San Antonio; Grew to six in San Antonio by 1985.

Trade Dress: Festive eating atmosphere; artifacts, bright colors, paintings, and murals.



Spread to Houston and Austin in 1986.

Two Pesos: First in Houston in 1985. "Very similar motif"

Suit under 43(a) No registration.

Held

Wal-Mart v. Samara Bros.

Basic Facts

Wal-Mart hired designer to explicitly copy Samara Bros' Dress designs.



Baby Gap Sells (Non-Samara)

Held

Squaring the two cases?