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COMMENTS

RENOVATING TACO CABANA: THE LANHAM ACT'S PROTECTION OF PRODUCT DESIGN AFTER SAMARA⁺

*Paul A. Briganti**

The law of trade symbols is of modern development, largely judge-made and only partly codified. Its impetus comes from the demands of modern advertising, a black art whose practitioners are part of the larger army that employs threats, cajolery, emotions, personality, persistence and facts in what is termed aggressive selling. Much aggressive selling involves direct personal relationships; advertising depends on the remote manipulation of symbols, most importantly of symbols directed at a mass audience through mass media, or imprinted on mass-produced goods. The essence of these symbols is distilled in the devices variously called trademarks, trade names, brand names, or trade symbols.¹

I. INTRODUCTION

For over half a century since Congress enacted it, the Lanham Trademark Protection Act² (the "Lanham Act" or the "Act") has remained an effective tool for reducing consumer confusion over who has manufactured a product, while ensuring manufacturers that their distinctive trademark ideas will remain exclusively theirs.³ The Act affords protection to trademarks and

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* J.D. Candidate, May, 2002, Villanova University School of Law, B.A. Political Science, Cum Laude, Fairleigh Dickinson University, 1999. I dedicate this article to my parents, Robert and Jacqueline, for their love and encouragement.

1. Ralph S. Brown, Jr., *Advertising and the Public Interest: Legal Protection of Trade Symbols*, 57 *YALE L.J.* 1165, 1165-66 (1948), reprinted in 108 *YALE L.J.* 1619, 1619-20 (1999).

2. Trademark (Lanham) Act of 1946, Pub. L. No. 79-489, 60 Stat. 427 (1946) (codified as amended at 15 U.S.C. §§ 1051-1127 (1999)). The Act was named for its primary sponsor, Congressman Fritz Garland Lanham.

3. See Joseph D. Garon, *Half a Century of Federal Trademark Protection: The Lanham Act Turns Fifty: The Lanham Act: A Living Thing*, 7 *FORDHAM INTELL. PROP. MEDIA & ENT. L.J.* 55, 56 (1996) (explaining that since its enactment, the Lanham Act has evolved to embrace the significance of trademarks in modern society); J. Thomas McCarthy, *Lanham Act* §

trade dress that, after close scrutiny, are deemed either inherently distinctive⁴ or have, over time, acquired distinctiveness, also known as secondary meaning.⁵ Since 1976, in order to determine whether a trademark is inherently distinctive, most federal courts have looked to the classic trademark taxonomy articulated by the United States Court of Appeals for the Second Circuit in *Abercrombie & Fitch Co. v. Hunting World, Inc.*⁶

Historically, many United States Courts of Appeals have agreed that the *Abercrombie* standard is applicable to issues of infringement of product packaging, which is one of two types of trade dress.⁷ There has been a difference of opinion among several circuits, however, over whether the *Abercrombie* classification is applicable to issues involving product design, the second type of trade dress, and whether product design can ever be inherently distinctive.⁸ Recently, in *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*,⁹ the United States Supreme Court addressed this circuit split, holding categorically that product design can never be inherently distinctive. Implicit in the Court's holding is that product design will receive protection under the

43(a): *The Sleeping Giant Is Now Wide Awake*, 59 LAW & CONTEMP. PROBS. 45, 45 (1996) (stating that section 43(a) is preeminent federal law for asserting infringement of unregistered trademarks claims). At least one commentator is skeptical of the seemingly positive evolution of the Act, and suggests that courts have overly refined it through interpretation and construction. *But see* Mark A. Lemley, *The Modern Lanham Act and the Death of Common Sense*, 108 YALE L.J. 1687, 1687-88 (1999) (arguing courts have eliminated core principles from the Act through over-refinement). According to the commentator, courts have erroneously categorized trademarks as property interests over the years, "as things valuable in and of themselves, rather than for the product goodwill they embody." *Id.* In addition, the commentator asserts, courts have extended the protections of the Lanham Act too far, to the point where marks that are afforded protection today would not have received protection fifty-four years ago when the Act was enacted. *See id.* (contending courts offer excessive protection to trademarks under the Act). The commentator concludes that the end result will be the complete estrangement of trademarks from the products they are intended to represent, a result that is not supported by the economic principles that provide the foundation of the Act. *See id.* (stating that consequence will be the divorce of trademarks from products they are designed to stand for).

4. See 15 U.S.C. § 1125(c)(1) (entitling owner of inherently distinctive mark to injunction where mark is infringed).

5. See 15 U.S.C. § 1052(f) (2002) (stating that Lanham Act's protections extend to "a mark used by the applicant which has become distinctive of the applicant's goods in commerce").

6. 537 F.2d 4 (2d Cir. 1976).

7. See Chad M. Smith, *Undressing Abercrombie: Defining When Trade Dress Is Inherently Distinctive*, 80 J. PAT. & TRADEMARK OFF. SOC'Y 401, 406-07 (1998) (stating that over time, courts have applied the standard set out in *Abercrombie*).

8. *Compare* Ashley Furniture Indus., Inc. v. SanGiacomo N.A., Ltd., 187 F.3d 363 (4th Cir. 1999) (applying *Abercrombie* to produce design trade dress), and *Stuart Hall Co., Inc. v. Ampad Corp.*, 51 F.3d 780 (8th Cir. 1995) (holding applicability of *Abercrombie* extends to product design), with *I.P. Lund Trading ApS v. Kohler Co.*, 163 F.3d 27 (1st Cir. 1998) (refusing to apply *Abercrombie* test to product design), *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996 (2d Cir. 1995) (declining to extend *Abercrombie* to product design), and *Duraco Prods., Inc. v. Joy Plastic Enters.*, 40 F.3d 1431 (3d Cir. 1994) (choosing to apply standard different from *Abercrombie* to product design).

9. 529 U.S. 205, 216 (2000).

Act only upon a showing of secondary meaning. *Samara* effectively limits the applicability of *Abercrombie* to only issues involving trademarks and product design trade dress.

This Note examines the *Samara* opinion in light of existing federal trademark law and Supreme Court precedent. Part II examines the Lanham Act and common law trademark principles. Part III sets forth the facts of the *Samara* case. Part IV traces the *Samara* Court's analysis of the product design issues before it. Part V examines the reasoning underlying *Samara*'s holding in light of the Act and relevant Supreme Court trademark precedent. Finally, Part VI discusses the possible impact of *Samara* on both trademark law and the commercial industries it will likely affect.

II. BACKGROUND

A. Statutory Law

1. The Lanham Act

Trademark law is an outgrowth of the law of unfair competition.¹⁰ The Lanham Act codifies, among other things, the relationship between unfair competition principles and concerns over trademark infringement.¹¹ It provides federal protection to valid trademarks from being reproduced in any form that is likely to cause confusion among consumers.¹² Yet in order to begin understanding this protection, the Act's dynamics must first be examined.

10. See *United Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90, 97 (1918) (reasoning that trademark infringement law functions as part of unfair competition law); *Union Nat'l Bank v. Union Nat'l Bank*, 909 F.2d 839, 844 n.10 (5th Cir. 1990) (commenting that trademark law falls under law of unfair competition); *Keebler Co. v. Rovira Biscuit Corp.*, 624 F.2d 366, 372 (1st Cir. 1980) (stating that cause of action for trade infringement is a species of a broad class of business torts for unfair competition).

11. See 15 U.S.C. § 1127 (2001) (providing that the Lanham Act was designed to provide a cause of action for "the deceptive and misleading use of marks in . . . commerce; . . . to protect persons engaged in such commerce against unfair competition; [and] to prevent fraud and deception in such commerce by the use of reproductions, copies, counterfeits, or colorable imitations of registered marks. . .").

12. See 15 U.S.C. §§ 1114, 1125(a) (2001) (imposing civil liability for the creation of a trademark that is likely to cause confusion). It has been said that the primary goal of unfair competition law relating to trademarks is to reduce the likelihood of confusion among consumers over trademarks. See J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 2:8 (4th ed. 1999) (stating that avoiding confusion among buying public is the keystone of unfair competition law that relates to trademarks). For a discussion of the likelihood of confusion element of infringement, see *infra* notes 33-35 and accompanying text.

a. Scope of Protection

In general, the Act affords protection to two categories of product features: trademarks and trade dress.¹³ Trademarks consist of any word, name, symbol, or device that indicates a product's source.¹⁴ Trade dress comprises a product's overall image, which includes elements such as "size, shape, color or color combinations, texture, graphics, or even particular sales techniques."¹⁵ The trade dress category breaks down into two sub-categories: product packaging and product design.¹⁶ Product packaging consists of the overall look, image or particular features of the packaging of a product.¹⁷ Product design is also composed of a product's overall image and appearance, but also includes elements such as size, shape, color or color combinations, and graphics.¹⁸

13. See *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205, 210 (2000) (indicating that, under Lanham Act, trade dress functions as a "symbol" or "device"); *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 773, *reh'g denied*, 505 U.S. 1244 (1992) (stating that section 43(a) of Lanham Act draws no distinction between trademarks and trade dress); Mary A. Donovan, *On Your Mark! Basic Principles of Trademarks*, 599 PLL/PAT 165, 171-72 (2000) (indicating that protection under Act extends to both trademarks and trade dress).

14. See 15 U.S.C. § 1127 (2001) (defining various forms of marks). The Act defines trademarks as:

[A]ny word, name, symbol, or device, or any combination thereof—

(1) used by a person, or

(2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this Act,

to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.

Id.

15. *Two Pesos*, 505 U.S. at 765 (quoting *John H. Harland Co. v. Clarke Checks, Inc.*, 711 F.2d 966, 980 (11th Cir. 1983)).

16. Originally, the trade dress category was limited to product packaging, which consisted of the overall appearance of a product. See MCCARTHY, *supra* note 12, § 8:1, at 8-2 (discussing original scope of trade dress). This included any labels, wrappers and containers used in the product packaging. See *id.* (indicating traditional product packaging components of trade dress).

17. See Inna Fayenson, *A Turning Point for Trade Dress Protection*, N.Y. L.J., Apr. 11, 2000, at 1 (2000).

18. See *Duraco Prods., Inc. v. Joy Plastic Enters., Ltd.* 40 F.3d 1431, 1439 (3d Cir. 1994) (affirming previous holding that trade dress includes appearance of product); *Am. Greetings Corp. v. Dan-Dee Imports, Inc.*, 807 F.2d 1136, 1142 (3d Cir. 1986) (holding appearance of teddy bears constituted "trade dress"). It may be especially difficult for designers to police the use of their protected designs in industries such as the fashion industry, where designers typically combine small portions of competitors' designs in a new design. See Michael Quintanilla, Herman Cohen & Barbara Thomas, *Copycat Designs To Have Day In High Court*, THE L.A. TIMES, Jan. 14, 2000, at E1 (stating that in the fashion industry, designers may succeed in copying competitors' designs by simply implementing minor changes in new design). Designers often find that this blurred combination of design elements makes the de-

Section 2 of the Act provides that certain marks and dress may be registered on the federal Principal Trademark Register, which will entitle the marks and dress to the greatest protection available under section 32 of the Act.¹⁹ Though an individual need not register a mark or dress to establish intellectual property rights to it, registrants enjoy certain advantages over others whose marks or dress are either unregistered or ineligible for registration, such as a presumption that the mark or dress is valid.²⁰ In order to be eligible for registration on the Principal Register, the Act provides that marks and dress must be more than merely distinctive and must be used in commerce.²¹

termination of the origins of fashion trends perplexing. *See id.* (discussing designers' difficulties in determining source of fashion trends).

19. *See* 15 U.S.C. § 1052 (2001) (permitting registration of distinctive marks on Principal Register); 15 U.S.C. § 1114 (2001) (imposing civil liability for infringement of registered marks). Section 2 allows the owner of a mark to sue an infringing party under Section 32, 15 U.S.C. § 1114 (2001). Trade dress may also be registered with the U.S. Patent and Trademark Office (PTO), but only if it satisfies the same criteria. *See* MCCARTHY, *supra* note 12, § 8:7 (explaining that trade dress, like trademarks, may be registered with the PTO). Section 32 of the Act makes it unlawful, without the consent of the registrant, to:

- (a) use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive; or
- (b) reproduce, counterfeit, copy, or colorably imitate a registered mark and apply such reproduction, counterfeit, copy, or colorable imitation to labels, signs, prints, packages, wrappers, receptacles or advertisements intended to be used in commerce upon or in connection with the sale, offering for sale, distribution, or advertising of goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive . . .

Id.

20. *See* Marcy J. Bergman, *Trademark Infringement Litigation Primer*, 569 PLI/Pat 443, 445 (1999) (noting increase in strength of trademark when registered). "[N]ational registration affords an owner of a mark protection against other users of the mark anywhere in the United States, assures registrants federal question jurisdiction, allows for additional remedies, and creates a presumption that the registered trademark is valid." Richard W. James, *Qualitex Co. v. Jacobson Products Co.*, 115 S. Ct. 1300 (1995), 34 Duq. L. REV. 419, 428 (1996) (citing 15 U.S.C. §§ 1071, 1072, 1115, 1117 (1994)). In addition, under section 15, a registered mark becomes incontestable after five years of continuous use. 15 U.S.C. § 1065. *See also* Bruce B. Brunda & In H. Kim, *The Effect of Utility Patents in Trade Dress Infringement*, 42 ORANGE COUNTY LAW 14 (May 2000).

21. 15 U.S.C. §§ 1051-52 (2001) (providing that marks must be distinctive and must be used in commerce to be eligible for registration). Marks and dress may be registered on either the Principal Register or the Supplemental Register. *See* Donovan, *supra* note 13, at 179 (discussing trademark registers). Registration on the Principal Register "is reserved for arbitrary or coined terms, some suggestive terms and certain distinctive trade dress marks." *Id.* The Principal Register affords all of the protections to marks and dress offered by the Act. For a discussion of these protections, *see supra* note 18. Marks may also be registered with state patent and trademark offices where available. Bergman, *supra* note 20, at 445.

Descriptive and some suggestive marks and dress may be registered on the Supplemental Register only if they are capable of becoming distinctive in the future. *See id.* "Marks on the Supplemental Register do not get all of the benefits of marks on the Principal Register. After a mark has been on the Supplemental Register for five years, however, it becomes *prima facie*

A mark exceeds the “merely distinctive” threshold by a showing that the mark is either: (1) inherently distinctive; or (2) has acquired distinctiveness.²² A mark or dress has been used in commerce if it satisfies two criteria: (1) the mark or dress is the subject of proper trademark usage; and (2) the goods bearing the mark or featuring the dress is the subject of commercial sale or transport.²³

Under section 43(a) of the Act, certain marks and dress that are ineligible for registration may still be eligible for protection.²⁴ This section imposes

evidence of distinctiveness and can be registered on the Principal Register.” Donovan, *supra* note 13, at 179-80. For a discussion of arbitrary and suggestive marks and distinctiveness of marks, see notes 60-74 *infra* and accompanying text.

22. 15 U.S.C. § 1052(e)-(f) (2001) (providing criteria for eligibility for registration).

23. See Lawrence E. Evans, Jr., *A Primer On Trademarks and Service Marks*, 18 ST. MARY'S L.J. 137, 142 (1986). An applicant may demonstrate proper usage of a mark by showing that: (1) labels or tags attached to the goods bear the mark; (2) a display associated with the goods bears the mark; (3) a container holding the goods bears the mark; or (4) the goods bear the mark in any manner. See *id.* Because “commerce” “is broadly defined as any type of commerce which may lawfully be regulated by Congress,” an applicant may demonstrate that the goods were sold or transported in commerce by offering evidence that the goods were sold or delivered either from one state to another or from the United States to a foreign state. See *id.* For a technical discussion of the trademark application process, see Carlisle E. Walters & Frank Z. Hellwig, *Federal Trademark Registration Practice: The Application Process*, 251 PLMP 51 (1988).

24. See 15 U.S.C. § 1125(a) (2001) (offering protection for marks that are incapable of being registered). The PTO may refuse to grant registration where:

1. the proposed mark consists of or comprises immoral, deceptive, or scandalous matter;
2. the proposed mark may disparage or falsely suggest a connection with persons (living or dead), institutions, beliefs, or national symbols, or bring them into contempt or disrepute;
3. the proposed mark consists of or comprises the flag or coat of arms, or other insignia of the United States, or of any State or municipality, or of any foreign nation;
4. the proposed mark consists of or comprises a name, portrait or signature identifying a particular living individual, except by that individual's written consent; or the name, signature, or portrait of a deceased President of the United States during the life of his widow, if any, except by the written consent of the widow;
5. the proposed mark so resembles a mark already registered in the Patent and Trademark Office (PTO) that use of the mark on applicant's goods or services are likely to cause confusion, mistake, or deception;
6. the proposed mark is merely descriptive or deceptively misdescriptive of applicant's goods or services;
7. the proposed mark is primarily geographically descriptive or deceptively geographically misdescriptive of applicant's goods or services;
8. the proposed mark is primarily merely a surname; and
9. matter that, as a whole, is functional.

United States Patent and Trademark Office, Frequently Asked Questions on Trademarks.

civil liability where a party uses a mark or dress in commerce in a way that is likely to cause consumer confusion or to deceive consumers into believing that the product has a source different from its source in fact.²⁵

b. Elements of a Claim For Trademark Infringement Under Section 43(a)

Section 43(a) of the Act imposes civil liability, and thus provides for a cause of action, where there is infringement of marks and dress that are ineligible for registration but nonetheless satisfy certain other criteria.²⁶ A successful claim under this section consists of three elements, all of which a plaintiff must prove.²⁷ First, the plaintiff must show that the product's design is nonfunctional by offering evidence that the primary purpose of the design is to identify the product's manufacturer.²⁸

available at <http://www.uspto.gov/web/offices/tac/tmfaq.htm> (citing 15 U.S.C. § 1052 (2001)).

25. See 15 U.S.C. § 1125 (2001). Section 43 states:

Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—

- A. is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or
- B. in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities,

shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

26. See 15 U.S.C. § 1125 (2001). Although section 43(a) does not explicitly refer to the protection of trade dress, the courts have concluded through negative implication that it nonetheless protects dress. See *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992), *reh'g denied*, 505 U.S. 1244 (1992) (stating that section 43(a) offers no basis for differentiating between trademarks and trade dress).

27. See *Brunda & Kim*, *supra* note 20, at 16 (discussing elements of trade dress infringement suit under section 43(a). Three initial procedural criteria must be satisfied before a plaintiff can bring an action for infringement under section 43(a)). See David H. Bernstein, et al., *Trademark and Unfair Competition Issues*, 614 PLI/Pat 203, 209 (2000). First, the plaintiff must have standing to bring the action. Standing is proven under Section 43(a) through a showing of some competitive injury. *Id.* at 210. Second, the plaintiff must show that the court has subject matter jurisdiction over the claim. *Id.* According to the Supreme Court interpretation of the Commerce Clause of the United States Constitution, proof of subject matter jurisdiction requires that the plaintiff show that the defendant's mark or dress is being used in interstate commerce or substantially affects interstate commerce. *Id.* at 211. Finally, the court must determine, after a traditional minimum contacts analysis, that it has personal jurisdiction over the parties. *Id.* at 214.

28. See generally *Brunda & Kim*, *supra* note 20. For a discussion of the doctrine of functionality, see *infra* notes 57-60.

Second, the plaintiff must show that the mark or dress is distinctive.²⁹ Distinctiveness may come in either of two forms: inherent or acquired.³⁰ According to the Supreme Court, a mark or dress is inherently distinctive if it is capable of identifying the source of the product at issue.³¹ Only inherently distinctive marks and dress are automatically eligible for automatic protection on the Principal Register.³² A mark that is not inherently distinctive, however, may become eligible for registration on the Principal Register if it has secondary meaning, which is also known as acquired distinctiveness.³³ A mark or dress has secondary meaning if, over time, consumers have come to recognize it as indicative of the respective manufacturer's goods.³⁴

Finally, the plaintiff must demonstrate that the defendant's alleged infringing mark is likely to cause confusion among consumers over the source of both the plaintiff's and the defendant's respective products at issue.³⁵ A plaintiff can prove likelihood of confusion where there is evidence that "the similarity [between the two competing marks] is sufficient to convey a false impression to the public mind, and is of a character to mislead and deceive the ordinary purchaser in the exercise of ordinary care and caution in such matters"³⁶ A plaintiff who successfully proves these elements will be

29. See *Brunda & Kim*, *supra* note 20, at 16.

30. See *id.*

31. See *Two Pesos*, 505 U.S. at 773.

32. See *Bergman*, *supra* note 20, at 445. Marks that have not yet developed secondary meaning but have the capability of doing so may be registered only on the supplemental register. See *Evans*, *supra* note 23, at 152 n.85 (stating that supplemental register is for "weak" marks that are not inherently distinctive).

33. See *Bergman*, *supra* note 20, at 446 ("A plaintiff whose claim is based on an unregistered mark . . . must be prepared to prove that the mark has acquired secondary meaning.").

34. See 15 U.S.C. § 1052(f) (defining secondary meaning). As the Court further explained, a mark has developed a secondary meaning if, from the perspective of a reasonable consumer, the utility of a product feature is to indicate the source of the product instead of the product itself. See *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844, 851 n.11 (1982).

35. See Willajeanne F. McLean, *The Birth, Death, and Renaissance of the Doctrine of Secondary Meaning In the Making*, 42 AM. U. L. REV. 737, 751 (1993) (discussing the importance of likelihood of confusion element).

36. *McLean v. Fleming*, 96 U.S. 245, 255 (1877). The reasonable consumer need not reach a confused state at the time of purchase; he or she may become confused before or after purchase as well. See Richard L. Kirkpatrick, *Likelihood of Confusion in Trademark Law*, in *Understanding Basic Trademark Law 1999*, at 107, 137 (PLI Patent, Copyrights, Trademarks, and Literary Property, Handbook Series No. G0-006H, 1999) (explaining when consumer confusion may set in). "Prior to sale, a potential purchaser attracted by the infringing mark may be misled into an 'initial interest' in the infringer's product." *Id.* "Postsale confusion occurs when prospective purchasers or others in the relevant public encounter the marks after the goods have been purchased and put to their intended use." *Id.* at 139.

A court may consider several factors when determining the likelihood that a mark or dress would cause confusion among consumers:

1. The degree of resemblance between the conflicting designations;
2. The similarity of the marketing methods and channels of distribution;

entitled under section 43(a) to the appropriate remedy, which may be money damages or injunctive relief.³⁷

B. Case Law

1. The Relationship Between Trademark and Patent Law

a. Some Basic Principles

Trademark law does not exist in a vacuum. Congress and the courts have developed it to avoid material conflict with other areas of jurisprudence, particularly patent law.³⁸ For example, like federal trademark law, federal patent law offers certain protections to product design trade dress.³⁹ The primary purpose behind this patent system is to encourage invention by rewarding inventors with, for a limited period, the right to exclusive use of his or her invention.⁴⁰ The system, under strict standards derived from the United States Constitution, affords a temporary and limited monopoly to the inventor of "any new and useful process, machine, manufacture, or composi-

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3. The characteristics of the prospective purchasers and the degree of care they exercise;
 4. The degree of distinctiveness of the senior user's mark;
 5. Where the goods or services are not competitive, the likelihood that prospective buyers would expect the senior user to expand into the field of the junior user;
 6. Where the goods or services are sold in different territories, the extent to which the senior user's designation is known in the junior user's territory;
 7. The intent of the junior user; and
 8. Evidence of actual confusion.

MCCARTHY, *supra* note 12, at § 23:19 (citing RESTATEMENT (THIRD) OF UNFAIR COMPETITION §§ 20-23 (1995)); *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir. 1961). The former six have been termed "market" factors. *See* Kirkpatrick, *supra* note 36, at 137 (discussing market factors). The latter two factors deal only with "intent" and "actual confusion," respectively. *See id.* (discussing intent and actual confusion factors).

37. *See* 15 U.S.C. § 1114 (2001) (setting forth remedies for infringement). Under section 35 of the Act, a plaintiff who successfully proves trademark infringement of a registered mark or a mark protected under section 43(a) is entitled to money damages in the form of: (1) any profits made by the defendant; (2) any damages sustained by the plaintiff; and (3) attorney's fees. *See* 15 U.S.C. § 1117(a) (2001) (providing remedy of money damages). For a thoughtful discussion of monetary damages available under the Act to plaintiff successfully proving infringement, *see* Christopher P. Bussert, *Monetary Recovery Under Section 35 of the Lanham Act*, in LITIGATING COPYRIGHT, TRADEMARK AND UNFAIR COMPETITION CASES FOR THE EXPERIENCED PRACTICIONER 1997, at 211 (PLI Patent, Copyrights, Trademarks, and Literary Property, Handbook Series No. G4-4025).

38. *Cf.* MCCARTHY, *supra* note 12, § 5:3 (discussing historical developments in trademark law that conflict with other areas of federal law).

39. *See* *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 149 (1989) (comparing protections offered by patent and trademark law).

40. *See* *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 229 (1964) (discussing historical purpose of patent law).

tion of matter, or any new and useful improvement thereof.”⁴¹ In addition, a patent is available to the inventor of any “new, original and ornamental design.”⁴² Though federal patent law offers strong protections to product design, federal trademark law can also offer patent-like protection.⁴³ Nevertheless, there are at least two key differences between the protections that federal trademark law and federal patent law offer. First, the eligibility standards for trademark law protection are generally more relaxed than those of patent law.⁴⁴ Second, while patents have limited lives, trademark protection of a design may last indefinitely.⁴⁵ Not surprisingly, these more liberal trademark standards came to create a tension between patent and trademark law because trademark law theoretically allows a registrant to gain potentially unlimited monopoly control over a product design.⁴⁶ The same design if protected under a patent, however, would at some point become part of the “public domain,” and consequently be available for legal reproduction by anyone once the patent has expired.⁴⁷

b. Federal Patent Law Preemption of State Trademark Law That Protects Unpatented Product Design

The tension between trademark and patent law is not exclusive to federal protection of product design, which is evidenced by a similar federalism-based conflict that arose between the federal and state patent and trademark laws.⁴⁸ Specifically, several states came to develop trademark law that granted patent-like protection to product designs under alleged unfair competition laws that, like federal trademark law, featured more relaxed stan-

41. 35 U.S.C. § 101 (2001). The Patent Clause of the United States Constitution empowers Congress “[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.” U.S. CONST. art. I, § 8, cl. 8.

42. 35 U.S.C. § 171 (2001). According to one commentator, the language of § 171 leads to the conclusion that patent law makes available a utility patent for a product design with features that have some utility and a design patent for a product design that has aesthetic purposes. See Christopher J. Kellner, *Rethinking the Procedural Treatment of Functionality: Confronting the Inseparability of Useful, Aesthetically Pleasing, and Source-Identifying Features of Product Designs*, 46 EMORY L.J. 913, 926 (1997) (discussing protections afforded by patent law to product design).

43. Kellner, *supra* note 42, at 914.

44. See *id.* at 926-29 (comparing stringency of patent law standards for protection to trademark standards).

45. See *id.*

46. See Kevin E. Mohr, *At the Interface of Patent and Trademark Law: Should Product Configuration Disclosed In a Utility Patent Ever Qualify For Trade Dress Protection?*, 19 HASTINGS COMM. & ENT. L.J. 339, 361 (1997) (discussing tension between federal patent and trademark law).

47. See *id.* (comparing protections afforded by trademark law to those afforded by patent law).

48. See Kellner, *supra* note 42, at 929-31 (discussing conflict between state and federal intellectual property law).

dards than those of federal patent law.⁴⁹ In a series of three decisions, the United States Supreme Court provided a resolution to this conflict, which has come to be known as the *Sears-Compco-Bonito Boats* preemption rule.⁵⁰

In its final words on the preemption rule in *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*,⁵¹ the Court clarified its holdings in the companion cases of *Sears Roebuck & Co. v. Stiffel Co.*⁵² and *Compco Corp. v. Day-Brite Lighting, Inc.*⁵³ The Court held that, based on the Supremacy Clause of the United States Constitution and principles of patent law, federal patent law will preempt state trademark law that affords patent-like protection to product designs that would otherwise be unprotected under federal patent law.⁵⁴ In essence, the Court affirmed its statement in *Compco* that trademark law cannot protect product design that is not patented or copyrighted, even if the design has secondary meaning.⁵⁵

In response, Congress and several federal courts attempted to develop a guiding principle for courts confronted with this preemption issue. Their efforts resulted in the functionality doctrine, which provides that a design that is deemed to be functional is not eligible for trademark protection as trade

49. See, e.g., *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141 (1989) (involving state statute that extended patent-like protection to unpatented product design); *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234 (1964); and *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 229 (1964).

50. See Mohr, *supra* note 46, at 360 (discussing *Sears-Compco-Bonito Boats* line of cases).

51. 489 U.S. 141 (1989).

52. 376 U.S. 225 (1964). *Sears* held that a state may not prohibit the copying of a product design that is unpatented and uncopyrighted because it was preempted by federal patent law. *Id.* at 229, 232. To allow a state to protect an unpatented and uncopyrighted design would allow an individual to have monopoly control over the design, which would contravene both the limitation on use inherent in the protections of patent law and the supremacy of patent law under the Supremacy Clause of the federal Constitution. See *id.* at 233 (stating that states cannot grant individual monopoly control over unpatented and uncopyrighted product design).

53. 376 U.S. 234 (1964). *Compco* held that, based on federal patent law, a judge may not issue an injunction enjoining a party from selling an exact copy of an unpatented article even if the reproduction caused consumer confusion over the source of the products that featured the design. See *id.* at 234 (holding that state law prohibiting sale of reproduction of article was preempted by federal law even if there is evidence of confusion among consumers). The Court, as it had in *Sears*, looked to the principles of federal patent law to reach this result. See *id.* at 238 (relying on *Sears*).

54. *Bonito Boats*, 489 U.S. at 152. The Court did state, however, that its holdings in *Sears* and *Compco* should not be read to bar all state protection of unpatented or uncopyrighted product design. See *Compco*, 376 U.S. at 154 (stating that *Sears* and *Compco* do not preclude all protection of product design under state antitrust law). *Sears* made it clear, the Court explained, that states may impose restrictions on the use of designs in appropriate circumstances to reduce likelihood of confusion over product source. See *id.* at 154 (affirming statement in *Sears* that states may require labeling or some other precautions to prevent consumer confusion over source).

55. See *id.* at 165 (stating that even though unpatented product design at issue had developed secondary meaning in a trademark sense, it could not be afforded patent-like protection).

dress.⁵⁶ Since then, the courts have developed two types of functionality: utilitarian and aesthetic.⁵⁷ The Supreme Court has stated that a design is functional in a utilitarian sense if it is “essential to the use or purpose of the article or if it affects the cost or quality of the article.”⁵⁸ At least one United States Court of Appeals has said that a design is aesthetically functional if it is vital to the commercial success of the product and if, absent a copyright or patent, principles of free competition permits its imitation.⁵⁹ Though many circuits have adopted the utilitarian standard, few have adopted the more liberal aesthetic test, reasoning that section 43(a) is silent on an appropriate standard for determining functionality.⁶⁰ According to one commentator, this lack of uniformity demonstrates that the tension between patent law and trademark law still looms over the intellectual property arena.⁶¹

56. See MCCARTHY, *supra* note 12, § 7:64 (discussing purpose of functionality doctrine). In 1999, Congress explicitly added nonfunctionality as an element a plaintiff must prove for recovery under section 43(a). See 15 U.S.C. § 1125(a)(3) (stating that “[i]n a civil action for trade dress infringement under this chapter for trade dress not registered on the principal register, the person who asserts trade dress protection has the burden of proving that the matter sought to be protected is not functional.”).

57. See Kellner, *supra* note 42, at 932-37 (discussing functionality doctrine).

58. *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844, 850 n.10 (1982).

When determining whether a design is aesthetically functional, a court may consider these factors:

- 1) the existence of a utility patent which discloses the utilitarian advantages of the design evidences functionality;
- 2) advertising or promoting the functional or utilitarian advantages of the design element claimed as trade dress;
- 3) the availability of alternative designs which perform the utility function equally well; and
- 4) whether the design embodies a simpler, cheaper, or superior method of manufacturing the product.

See Bradley K. Groff, *Bare-Fisted Competition or Palming Off? The Protection of Product Design As Trade Dress Under the Lanham Act*, 23 AIPLA Q.J. 65, 82 (1995) (quoting *In re Morton-Norwich Prods, Inc.*, 671 F.2d 1332 (C.C.P.A. 1982)).

59. See *Pagliero v. Wallace China Co.*, 198 F.2d 339, 343-45 (9th Cir. 1952) (defining aesthetic functionality).

60. See Groff, *supra* note 58, at 84 (citing *Int'l Order of Job's Daughters v. Lindeburg & Co.*, 633 F.2d 912 (9th Cir. 1980), *cert. denied*, 452 U.S. 941 (1981)); *Famolare, Inc. v. Melville Corp.*, 472 F. Supp. 738 (D. Haw. 1979)). According to one commentator, because the federal courts have not widely adopted the aesthetic standard, the patent-like protections of product designs under trademark law will continue to conflict with the protections offered by patent law. See *id.* (contending that universal adoption of aesthetic functionality doctrine would help eliminate conflict between federal trademark and patent law).

61. See Kellner, *supra* note 42, at 941 (stating that while the goal of the functionality doctrine to separate design and utility patent law and Lanham Act is “admirable and achievable . . . in the abstract, . . . it does not translate well into a test that may be applied to real cases and proven by readily available evidence”).

2. *The Abercrombie Standard of Inherent Distinctiveness of Trademarks*

As Part IIA of this Note discussed, the Lanham Act affords several benefits to inherently distinctive marks that it does not extend to marks with only acquired distinctiveness. The Act, however, fails to define "inherent distinctiveness." Coming to the rescue once again, the courts developed a standard for determining whether a mark is inherently distinctive, as the Act was silent on this matter.⁶² The majority of circuits have adopted the trademark classification devised by the United States Court of Appeals for the Second Circuit in *Abercrombie & Fitch Co. v. Hunting World, Inc.*⁶³ The court's classic taxonomy of trademarks consists of generic, descriptive, suggestive, arbitrary and fanciful marks, with only a few categories of marks being inherently distinctive.⁶⁴ Several other categories may be eligible for protection only after they have acquired distinctiveness.⁶⁵ The remaining categories, however, are never eligible for protection, because they are neither inherently distinctive nor are they capable of acquiring distinctiveness.⁶⁶

Specifically, at one end of the *Abercrombie* spectrum are generic marks, which refer to a particular genus of products.⁶⁷ These marks are never eligible for protection under the Act because they are comprised of words that are commonly used in a certain market and, therefore, are neither inherently distinctive nor can they acquire distinctiveness.⁶⁸

62. See Michele A. Shpetner, *Determining a Proper Test For Inherent Distinctiveness In Trade Dress*, 8 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 947, 951-52 (1998) (discussing confusion among courts over inherent distinctiveness standard). See generally Hermenegildo A. Isidro, *The Abercrombie Classifications and Determining the Inherent Distinctiveness of Product Configuration Trade Dress*, 62 BROOK. L. REV. 811 (1996).

63. 537 F.2d 4 (2d Cir. 1976).

64. See *id.* at 9 (setting forth classification of marks).

65. See *id.* (commenting that certain marks are eligible for protection under Act only if plaintiff demonstrates the mark has acquired distinctiveness).

66. See *id.* at 10 (discussing generic marks, which are not distinctive at all and consequently are afforded no protection under Act).

67. See *id.* at 9 (defining generic marks).

68. See *id.* at 9-10 (concluding that generic marks are ineligible for protection under Act). Generic marks were also afforded no protection at common law or under the Trademark Act of 1905. *Id.* at 9. The court noted that whether a mark is generic largely depends on the market in which the mark is being used. *Id.* at 10. For example, a mark may have become generic in one market while as a result of advertising in another market, the same mark may have secondary meaning and be classified as descriptive, suggestive or fanciful. See *id.* (noting effects of advertising). Therefore, a mark may be protected by the Act in one market but remains unprotected in another. The scope of the Act's protection falls short of marks that are incapable of being distinctive in order to prevent any unfair limitation of competition the might occur through the allowance of an individual to have monopoly control over a common word or phrase. See Isidro, *supra* note 62, at 826 (explaining lack of protection afforded to generic marks). An example of a generic mark is the phrase "orange juice", which is a common term that, by itself, is incapable of distinguishing the source of one product from that of another. *Id.* at 826 n.76. Another example of a generic mark is the word "car" when used for a product that is an automobile. See Lucy C. Ridgway, *Has Abercrombie Become Unfashionable? A Review of Trends In Product Configuration Trade Dress Cases and a Proposed Test*

Next in the spectrum are descriptive marks, which immediately indicate the ingredients, qualities or characteristics of a good.⁶⁹ The Act does not, however, afford automatic protection to marks that are “merely descriptive” and no more, because they are not inherently distinctive.⁷⁰ Yet if a “merely descriptive” mark acquires distinctiveness, it may be eligible for protection under section 43(a).⁷¹

Following descriptive marks are suggestive marks, which allow a reasonable consumer to infer from the mark a characteristic about the product.⁷² Suggestive marks are inherently distinctive and, therefore, are eligible for automatic protection under the Act.⁷³

Finally, at the opposite end of the *Abercrombie* spectrum are arbitrary and fanciful marks, which are the most inherently distinctive of all marks and, therefore, receive automatic protection under the Act.⁷⁴ Arbitrary and

For Uniformity, 20 MISS. C. L. REV. 179, 181 (1999) (discussing example of generic marks).

69. *See id.* at 11 (citing *Delaware & Hudson Canal Co. v. Clark*, 80 U.S. 311, 323 (1872)). According to one commentator, a descriptive mark indicates “the intended purpose, function or use of the goods; the size of the goods, the class of users of the goods, a desirable characteristic of the goods, the nature of the goods, or the end effect upon the user.” MCCARTHY, *supra* note 12, § 11:16. An example of a descriptive mark is the term “Orange Nectar” if used on an orange juice container, which refers to the color and nature of the product. *See* Isidro, *supra* note 62, at 826 n.78 (discussing example of descriptive mark). A second example of a descriptive mark is the term “crunchy” when used in conjunction with a cookie product. *See* Ridgway, *supra* note 68, at 181 (providing example of descriptive mark).

70. *Abercrombie*, 537 F.2d at 10. Section 2(e) of the Act excludes from the Act’s protection marks that are “merely descriptive.” 15 U.S.C. § 1052(e). Affording protection to marks that are merely descriptive, the court reasoned, “would confer a monopoly not only of the mark but of the product by rendering a competitor unable effectively to name what it is endeavoring to sell.” *Abercrombie*, 537 F.2d at 10.

71. *See Abercrombie*, 537 F.2d at 10. Section 2(f) of the Act states that “except as expressly excluded in paragraphs (a)-(d) of this section, nothing in this chapter shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant’s goods in commerce.” 15 U.S.C. § 1052 § 2(f).

72. *See Abercrombie*, 537 F.2d at 10 (discussing suggestive marks). According to one commentator, suggestive marks invoke a consumer’s imagination, thought and perception in order to signal the nature of the goods associated with the mark. *See* Joel W. Reese, *Defining the Elements of Trade Dress Infringement Under Section 43(a) of the Lanham Act*, 2 TEX. INTELL. PROP. L.J. 103, 111 (1994) (noting mental consumer’s processes involved in evaluating suggestive marks). According to another commentator, despite the requirement of consumer imagination, the capabilities of suggestive marks nonetheless are partially based on the characteristics of the product. *See* Isidro, *supra* note 62, at 823 (noting basis of suggestive marks in product characteristics). An example of a suggestive mark is the term “Coppertone” which constitutes a suggestive mark because it alludes to the dark, tan skin desired by consumers but does not refer to the tanning lotion product itself. *See id.* at 823 n.81.

73. *See Abercrombie*, 537 F.2d at 11 (stating that suggestive marks require no secondary meaning in order to be eligible for protection); *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 786, *reh’g denied*, 505 U.S. 1244 (1992). The *Abercrombie* court noted that if the PTO has allowed an individual to register, there will be a rebuttable presumption that the mark is suggestive, arbitrary or fanciful rather than merely descriptive. 537 F.2d at 11.

74. Reese, *supra* note 72, at 111. Arbitrary and fanciful marks are accorded the highest level of automatic protection, which does not stifle competition. *Id.* The rationale for this rule is that:

fanciful marks differ from the other categories of marks in that they have no ties to the product and were developed by the producer for the sole purpose of associating them with products.⁷⁵

3. Eligibility of Trade Dress For Protection Under Section 43(a)

Some time after the Second Circuit decided *Abercrombie*, disagreement arose in the circuits over whether proof of secondary meaning was required in order for inherently distinctive trade dress to be eligible for protection under the Act.⁷⁶ In *Two Pesos, Inc. v. Taco Cabana, Inc.*,⁷⁷ the Supreme Court was asked to address this issue, and held that trade dress that is deemed inherently distinctive based on *Abercrombie* may be afforded protection without any proof of secondary meaning.⁷⁸ This was the rule for trademarks, the Court explained, and there was nothing in section 43(a) or its legislative his-

[b]ecause a fanciful term has no meaning other than as an identifying symbol, prospective purchasers can be expected to view it as an indication of source or other association with a particular user. In addition, the recognition of trademark rights in fanciful terms does not diminish the vocabulary available to other sellers of similar products.

RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 13, cmt. c (1995).

An example of an arbitrary mark is the name "Ivory," which by itself evokes no images of soap yet over time has come to function as a common term for this sud-producing cleaning product. See Isidro, *supra* note 62, at 826 n.81 (providing example of arbitrary mark). Another example is the name "Apple" when used in conjunction with computers. See Ridgway, *supra* note 68, at 181 (discussing arbitrary mark example). Examples of fanciful marks include the names "Kodak" for photography equipment and "Exxon" for petroleum products, which are terms that were created by manufacturers. See Isidro, *supra* note 62, at 826 n.83 (providing examples of fanciful marks).

75. See Reese, *supra* note 72, at 111 (noting distinction between arbitrary and fanciful marks on one hand and other categories of mark on the other). Although some have argued that there is no substantial difference between arbitrary and fanciful marks, one commentator has stated that the primary distinction between the two types is that "[f]anciful marks are products of the use of arbitrary marks. Fanciful terms are words invented solely for use as trademarks. When fanciful terms use common words in an unfamiliar way, the use is called arbitrary." *Id.*

76. Compare *Vibrant Sales, Inc. v. New Body Boutique, Inc.*, 652 F.2d 299 (1981), *cert. denied*, 455 U.S. 909 (1982) (holding that no showing of secondary meaning required for protection of trade dress), with *Chevron Chemical Co. v. Voluntary Purchasing Groups, Inc.*, 659 F.2d 695, 702 (5th Cir. 1981) (holding that proof of secondary meaning is required for protection of trade dress).

77. 505 U.S. 763, *reh'g denied*, 505 U.S. 1244 (1992). In *Two Pesos*, several entrepreneurs opened Two Pesos, a Mexican restaurant, in a major Texas city. *Id.* at 765. The restaurant was similar in motif to Taco Cabana, an existing Mexican restaurant in Texas. Eventually, the Two Pesos line expanded to cities in which Taco Cabana restaurants were already operating. Taco Cabana sued Two Pesos under section 43(a) for trade dress infringement, arguing the trade dress motif of the Taco Cabana restaurant was an inherently distinctive and therefore a protected mark that was being infringed by Two Pesos. *Id.*

78. See *id.* at 776 (concluding that proof of secondary meaning was not required for inherently distinctive dress in order for plaintiff to succeed under section 43(a) on claim for infringement).

tory to suggest that trademarks and trade dress should be treated differently with respect to the Act's protective features.⁷⁹

4. *The Disagreement Over the Protection of Product Design Trade Dress Under Section 43(a)*

Though *Two Pesos* resolved the conflict over what level of protection the Act affords to inherently distinctive trade dress, it failed to specify whether both types of trade dress—packaging and design—are eligible for the Act's protections.⁸⁰ This division continued even after the Court later held in *Qualitex Co. v. Jacobson Products Company Inc.*⁸¹ that certain categories of trade dress can never be inherently distinctive.⁸² Furthermore, while many circuits have applied *Abercrombie* to product packaging, they were unsure whether, after *Two Pesos*, they could also apply *Abercrombie* to product design.⁸³ These issues caused not only a division among the several circuits that have interpreted *Two Pesos*, but also a degree of uncertainty in intellectual property law.⁸⁴

Though their conclusions have differing bases, the First, Second and Third circuits have held that *Abercrombie* is unsuitable for determining inherent distinctiveness of product design and that proof of secondary meaning is required in order for product design to be protected.⁸⁵ According to the

79. See *id.* at 773 (stating section 43(a) offers no basis for differentiating between trademarks and trade dress). After examining the congressional record for section 43(a), the Court determined that protection of trademarks and trade dress under section 43(a) was in keeping with the Act's underlying unfair competition principles. See Jenny Johnson, *Two Pesos, Inc. v. Taco Cabana, Inc.: The Supreme Court's Expansion of Trade Dress Protection Under § 43(a) of the Lanham Act*, 24 LOY. U. CHI. L.J. 285, 300 (1993) (explaining that protection of trade dress promoted protection against unfair competition). For a discussion of these unfair competition principles, see *supra* notes 5-7 and accompanying text.

80. See Johnson, *supra* note 79, at 301 (noting deficiencies of *Two Pesos*).

81. 514 U.S. 159 (1995).

82. See *id.* at 174 (holding that color may be protected only after showing of secondary meaning). The Court, after applying *Abercrombie*, reasoned that a product's color is different from a fanciful, arbitrary or suggestive mark because it neither immediately indicates brand nor automatically identifies source. See *id.* at 163 (stating that color is different from inherently distinctive trademarks). The Court noted, however, that color might gain protection through development of secondary meaning. See *id.* at 166 (noting that secondary meaning can confer eligibility for protection on color trade dress).

83. See Ridgway, *supra* note 68, at 183 (discussing confusion among circuits on applicability of *Abercrombie*).

84. See Travis L. Bachman, *Inherent Distinctiveness, Product Configuration, and "Product Groups": The Developing Law of Trade Dress*, 23 J. CORP. L. 501, 512 (1998) (noting split among circuits).

85. See *I.P. Lund Trading ApS v. Kohler Co.*, 163 F.3d 27, 32 (1st Cir. 1998) (refusing to apply *Abercrombie* test to product design); *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d at 1008 (2d Cir. 1995) (declining to extend *Abercrombie* to product design); *Duraco Prods., Inc. v. Joy Plastic Enterprises, Ltd.*, 40 F.3d at 1434 (3d Cir. 1994) (choosing to limit applicability of *Abercrombie* to product packaging trade dress).

First Circuit in *I.P. Lund Trading ApS v. Kohler Co.*,⁸⁶ *Two Pesos* does not explicitly require courts to apply *Abercrombie* to product design to determine inherent distinctiveness.⁸⁷ Rather, the *Two Pesos* Court merely determined that *Abercrombie* could be properly applied to the trade dress at issue in *Two Pesos*: product packaging.⁸⁸ After rejecting *Abercrombie*, the First Circuit chose to adopt the test devised by the Court of Customs and Patent Appeals in *Seabrook Foods, Inc. v. Bar-Well Foods, Ltd.*⁸⁹ Under *Seabrook*, a product's design is considered inherently distinctive if it is so unusual or unexpected in the relevant market that a reasonable consumer would automatically see it as an indicator of the source of the product.⁹⁰

In *Knitwaves, Inc. v. Lollytogs Ltd.*,⁹¹ the Second Circuit also concluded that *Two Pesos* does not necessitate the application of *Abercrombie* to product design cases and that product design is never inherently distinctive.⁹² In formulating its own standard, the court focused on the functionality of the product design at issue, and held that a product's design is inherently distinctive only if the features of the design are likely to primarily serve as an indicator of source.⁹³ Under this test, a plaintiff must demonstrate that the product design does more than serve some source-indicating function.⁹⁴

The Third Circuit set forth a three-part standard in *Duraco Products, Inc. v. Joy Plastic Enterprises*⁹⁵ that features elements found in the tests of both the First and Second Circuits. According to *Duraco*, a design of a product is inherently distinctive only if, in the eyes of a reasonable consumer, it

86. 163 F.3d 27 (1st Cir. 1998).

87. *See id.* at 40 (concluding that *Two Peso* Court's application of *Abercrombie* does not necessitate application of *Abercrombie* in all trade dress cases and certainly not where product design is involved).

88. *See id.* (stating that the *Two Pesos* Court merely concluded that *Abercrombie* was applicable to the restaurant décor trade dress at issue).

89. 568 F.2d 1342 (C.C.P.A.1977).

90. *See id.* at 1344 (setting forth *Seabrook* test). The First Circuit concluded that this was the essence of the *Seabrook* test, which featured three prongs that the court deemed were simply restatements of the same proposition. *See I.P. Lund Trading ApS*, 163 F.3d 27 (stating that the three questions under *Seabrook* were merely different ways of posing the same query). Under the original *Seabrook* test, product design is considered inherently distinctive if it: (1) is uncommon; (2) is unique or unusual when compared to other designs in the relevant field; and (3) is more than "a mere refinement of a commonly-adopted and well-known form of ornamentation for a particular class of goods viewed by the public as dress or ornamentation for the goods." *Id.* (citing *Wiley v. American Greetings Corp.*, 762 F.2d 139, 141 (1st Cir. 1985)).

91. 71 F.3d 996 (2d Cir. 1995).

92. *See id.* at 1007 (holding that *Two Pesos* does not command that *Abercrombie* be applied to product design trade dress). The court stated that the thought of applying *Abercrombie* to product design features "make[s] little sense" and "would have the unwelcome, and likely unintended, result of treating a class of product features as 'inherently distinctive,' and thus eligible for trade dress protection, even though they were never intended to serve a source-identifying function." *Id.*

93. *See id.* (setting forth the test based on functionality of product design).

94. *See Banff Ltd. v. Express, Inc.*, 921 F. Supp. 1065, 1071 (S.D.N.Y. 1995) (applying *Knitwaves* standard).

95. 40 F.3d 1431 (3d Cir. 1994).

is: (1) unusual and memorable; (2) capable of being conceptually separated from the product; and (3) likely to serve primarily as an indicator of the source.⁹⁶ The Third Circuit reasoned that while other courts had “nonchalantly” applied *Abercrombie* to product design as if it were product packaging, the two types of trade dress are conceptually different.⁹⁷ In *Stuart Hall Co. v. Ampad Corp.*,⁹⁸ the Court of Appeals reasoned that because the *Two Pesos* Court did not specify which type of trade dress was at issue, it would treat trade dress as a single concept that consists of both product packaging and product design.⁹⁹ In casting aside the determinations made by the Second Circuit in *Duraco*, the Eighth Circuit concluded that the trade dress at issue in *Two Pesos*—restaurant décor—was as much like product design as it was product packaging.¹⁰⁰

In addition, the Fourth Circuit in *Ashley Furniture Industries, Inc. v. SanGiacomo North America, Ltd.*¹⁰¹ has applied *Abercrombie* to product design and deduced that it can be deemed inherently distinctive. The court dismissed the *Duraco* Court’s argument that there are conceptual limitations on the applicability of *Abercrombie* to product design. Instead, the Fourth Circuit reasoned that, like product packaging, which allows for an effective application of the *Abercrombie* standard, the nonfunctional conceptual features of the product that make up its overall image can be separated from the product to allow for analysis under *Abercrombie*.¹⁰² This split among the cir-

96. *See id.* at 1434 (establishing the three-part test for inherent distinctiveness of product design).

97. *See id.* at 1440 (noting conceptual differences between product design and product packaging). The court of appeals explained that, while packaging elements are capable of being analyzed separately from the product at issue, such analysis is impossible with design elements because they are not source-indicating symbols but instead constitute the overall product itself. *See id.* (discussing conceptual differences between product design and product packaging).

98. 51 F.3d 780 (8th Cir. 1995).

99. *See id.* at 787 (stating that trade dress should be treated as one concept).

100. *See id.* (noting that restaurant décor can be considered both product packaging and product design). The Eighth Circuit stated that, in regard to the appearance of the interior of a restaurant, it is virtually impossible to determine where product packaging ends and where product design begins. *See id.* (discussing difficulty of separating product-packaging elements of restaurant décor from its product design elements).

101. 187 F.3d 363 (4th Cir. 1999).

102. *See id.* (stating that *Abercrombie* may be properly applied to nonfunctional features comprising total image of product). In addition, the court explained, *Two Pesos* unequivocally stated that *Abercrombie* is suitable for application to trade dress and that inherently distinctive trade dress is eligible for protection without proof secondary meaning. *See id.* at 371-72 (stating that, under reasoning of *Two Pesos*, *Abercrombie* may be properly applied to product design and showing of secondary meaning is not required for protection of inherently distinctive dress). The Fourth Circuit reasoned that the Supreme Court’s approval and application of the *Abercrombie* analysis to the décor of a restaurant in *Two Pesos* “surely indicates, if it does not require, that lower courts should use that analysis in product configuration cases generally.” *Id.*

cuits has since caught the attention of the Supreme Court, which addressed the confusion in *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*¹⁰³

III. FACTS OF WAL-MART STORES, INC. v. SAMARA BROTHERS, INC.

The facts leading up to *Samara* began in 1995, when Wal-Mart, a retailer, contracted with Judy-Philippine, one of its clothing suppliers, to produce a line of children's garments.¹⁰⁴ The contract called for Judy-Philippine to manufacture the line based on photographs of outfits designed by Samara Brothers, Inc., a children's clothing designer and manufacturer.¹⁰⁵ Wal-Mart sold the "knockoffs" to the tune of more than \$1,150,000 in gross profits.¹⁰⁶

In June 1996, Samara learned of Wal-Mart's sale of its reproduced clothing.¹⁰⁷ Following an investigation, Samara determined that Wal-Mart and several other retailers were selling knockoffs of the Judy-Philippine-designed line.¹⁰⁸ After sending cease-and-desist letters, Samara brought suit in the Southern District of New York against Wal-Mart and the other retailers for, among other things, infringement of unregistered trade dress under section 43(a).¹⁰⁹

At trial, the jury returned a verdict in Samara's favor.¹¹⁰ Wal-Mart proceeded to renew a motion for judgment as a matter of law, which the district court denied in Samara's favor.¹¹¹ On appeal, the Second Circuit affirmed, followed by the Supreme Court's granting certiorari.¹¹² In its opinion, the Court reversed the Second Circuit's decision and remanded the case.¹¹³ The Court held that product design is not inherently distinctive, and, in order to receive protection under section 43(a), must have secondary meaning.¹¹⁴

103. 529 U.S. 205 (2000).

104. *Id.* at 205 (setting forth facts of case).

105. *Id.*

106. *Id.*

107. *Id.* A buyer for one of Samara's clients, JC Penney, complained to Samara that Wal-Mart was selling Samara's clothing at costs below those that JC Penney could under its contract with Samara. *Id.*

108. *Id.* In addition to Wal-Mart, Kmart, Caldor, Hills and Goody's were selling the knockoff Samara garments. *Id.*

109. *Id.* (discussing the procedural history of case). Samara also included in its complaint counts of federal copyright infringement, consumer fraud and unfair competition under New York law. *Id.* Wal-Mart was the only retailer to settle before trial. *See id.*

110. *Id.*

111. *Id.* In support of its dispositive motion, Wal-Mart argued that there was insufficient evidence to support a conclusion that the Samara design could be properly protected under section 43(a) as trade dress. *Id.*

112. *Id.*

113. *Id.* at 216.

114. *Id.* (holding that, under section 43(a), infringement of product design is actionable only after showing of secondary meaning).

IV. NARRATIVE ANALYSIS

A. *The Issue of Whether Product Design is Inherently Distinctive*

In beginning its opinion in *Samara*, the Supreme Court presented the definition of a trademark as well as the protections that section 32 of the Lanham Act affords to registered trademarks.¹¹⁵ The Court explained that the Act permits individuals to register trademarks, which carries with it certain benefits not afforded to unregistered marks.¹¹⁶ In addition, the Court stated, section 43(a) of the Act provides a cause of action that allows the owner of an unregistered mark or trade dress to seek protection from the use by others of a confusingly similar mark.¹¹⁷ The Court explained that the courts have come to include not only product packaging trade dress under the protective scope of section 43(a), but also product design.¹¹⁸

The Court continued its discussion by examining the application of section 43(a) by the courts, which have regularly required that a plaintiff show that that trade dress in question is distinctive, despite the absence from section 43(a) of any such requirement.¹¹⁹ The Court proceeded to explain the concepts of inherent and acquired distinctiveness.¹²⁰ Section 2 of the Act, the Court explained, permits the registration of inherently distinctive goods and prohibits the prevention of the registration of marks that have acquired dis-

115. *Id.* at 209. For an introduction to the general protections afforded by the Act to trademarks, *see supra* notes 13-18 and accompanying text.

116. *Id.* (stating that Act provides for the registration of certain marks). For a discussion of the benefits of registering a mark, *see supra* notes 19-23 and accompanying text.

117. *Id.* (discussing the cause of action created by section 43(a)). The Court explained that, although section 43(a) originally protected only marks, the courts have extended its scope of protection to include trade dress. *See id.* (explaining the inclusion by the courts of trade dress in protection afforded by section 43(a)).

118. *Id.* (explaining the protections of section 43(a)). The Court stated that:

[Section] 43(a) . . . has been held to embrace not just word marks, such as "Nike," and symbol marks, such as Nike's "swoosh" symbol, but also 'trade dress'—a category that originally included only the packaging or dressing of a product, but in recent years has been expanded by many courts of appeals to encompass the design of a product.

Id. (citing *Ashley Furniture Indus., Inc. v. SanGiacomo N.A., Ltd.*, 187 F.3d 363 (4th Cir. 1999)); *Knitwaves, Inc. v. Lollytogs, Ltd.*, 71 F.3d 996 (2d Cir. 1995); *Stuart Hall Co. v. Ampad Corp.*, 51 F.3d 780 (8th Cir. 1995)). The Court stated that the decisions of these circuit courts to specify product design as a type of trade dress was strengthened by a recently added subsection to section 43(a)(3), which provides a cause of action for the infringement of trade dress that is not registered on the Principal Register. *See Samara*, 529 U.S. at 210 (discussing the implications of section 43(a)(3)).

119. *Samara*, 529 U.S. at 210-11 (examining the application of section 43(a) by the courts). The Court also discussed section 43(a)'s explicit requirements for protection of trade dress, nonfunctionality, and likelihood of confusion. *Id.*

120. *Id.* In defining and discussing inherent distinctiveness, the Court cited to the *Abercrombie* classification of marks. *See id.* (explaining *Abercrombie*).

inctiveness.¹²¹ Nevertheless, according to the Court, section 2 does not provide that all categories of marks include some marks that are inherently distinctive, and therefore eligible for protection without secondary meaning.¹²²

The Court next relied on *Qualitex Co. v. Jacobson Products Co.*¹²³ for an example of this proposition.¹²⁴ *Qualitex* held that color trade dress is not inherently distinctive because, unlike fanciful, arbitrary or suggestive marks, it does not immediately indicate source.¹²⁵ The *Samara* Court concluded that, like color, product design could never be inherently distinctive because, instead of indicating the product's source as a fanciful, arbitrary or suggestive mark may do, design serves purposes other than source indication.¹²⁶ Rather, design serves the purpose of rendering the product more useful or more appealing.¹²⁷ To afford automatic protection to aesthetic and utilitarian functionalities by holding that they are inherently distinctive, the Court reasoned, would be contrary to the unfair competition safeguards inherent in trademark law.¹²⁸

The Court proceeded to reject the *Seabrook* test for inherent distinctiveness of product packaging, which *Samara* urged the Court to endorse for use in cases involving product design.¹²⁹ The *Seabrook* standard, the Court explained, was unsuited for product design, because it would rarely provide basis for summary disposition, in that it depended on facts of the case to determine whether a design is inherently distinctive.¹³⁰ The Court explained that, while its decision may seem harsh, an individual who wishes to protect "a design that is inherently source-identifying (if any such exists)" but has

121. *Id.* (discussing registration under § 2 of the act).

122. *Id.* ("Nothing in § 2 . . . demands the conclusion that every category of mark necessarily includes some marks "by which the goods of the applicant may be distinguished from the goods of others' without secondary meaning—that in every category some marks are inherently distinctive.").

123. 514 U.S. 159 (1995).

124. *Samara*, 529 U.S. at 211-12 (discussing *Qualitex*).

125. *Id.* at 212 (providing holding of *Qualitex* that color is not inherently distinctive).

126. *Id.* (stating that color and design have utility and aesthetic functions). The Court based its conclusion on the general trademark principle that, where it is not reasonable to assume a consumer will be predisposed to identifying an affixed word or package as an indicator of source, courts will not find inherent distinctiveness. *See id.* (stating that when in doubt, courts will not find that mark is inherently distinctive).

127. *Id.* (stating that color and design serve aesthetic and utilitarian purposes).

128. *Id.* at 213 (addressing unfair competition concerns).

129. *Id.* at 213-14.

130. *Id.* at 214 (discussing the multi-pronged *Seabrook* test). The Court refused to approve a standard that would permit an entity to threaten suit for infringement based on alleged inherent distinctiveness because such a threat would greatly deter competition. *See id.* ("Competition is deterred . . . not merely by the successful suit but by the plausible threat of successful suit, and given the unlikelihood of inherently source-identifying design, the game of allowing suit based upon alleged inherent distinctiveness seems to us not worth the candle.").

not developed secondary meaning, has other sources of protection available, such as a design patent or a copyright for the design.¹³¹

B. Clarification of *Two Pesos*

The Court entered the final portion of its opinion by clarifying the facts and holding of *Two Pesos*, which Samara contended precluded the Court from holding that product design can never be inherently distinctive.¹³² *Two Pesos*, the Court stated, did hold that trade dress can be inherently distinctive but did not specify whether product design is also a source indicator.¹³³ Yet the Court explained that *Two Pesos* involved the décor of a restaurant, which was “either product packaging . . . or else some *tertium quid* that is akin to product packaging and has no bearing on the present case.”¹³⁴ The Court concluded that while its manner of distinguishing *Two Pesos* may force courts to draw “difficult lines” between design and packaging trade dress, this exercise would be much less intensive than the hair-splitting exercise of determining whether product design is inherently distinctive.¹³⁵

V. CRITICAL ANALYSIS

A. Unfair Competition Concerns

In *Samara*, the Supreme Court wisely considered principles of unfair competition law in holding that because the majority of product designs, at best, are of weak distinctiveness, product design may be properly afforded protection under section 43(a) of the Lanham Act only after a showing of secondary meaning.¹³⁶ As a creature of unfair competition law, trademark law must include safeguards that protect a free market economy.¹³⁷ Because the threat of legal action for trademark infringement may hinder competition, the Court properly exhibited respect for this concern by firmly stating that an individual who claims ownership to a product design will not have the advantage of the presumption of inherent distinctiveness.¹³⁸

131. *Id.*

132. *Id.*

133. *Id.*

134. *Id.* at 215.

135. *Id.* (stating that distinction between *Two Pesos* and *Samara* serves to aid courts in determining inherent distinctiveness in trade dress cases).

136. *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 211 (2000) (citing *Qualitex*, which held that product design can never be inherently distinctive).

137. For a discussion of the unfair competition basis of trademark law, see *supra* notes 10-12 and accompanying text.

138. *Samara*, 529 U.S. at 214 (stating that plausible threat of law suit deters competition). This holding does not render all product design part of the public domain, as individuals may still seek protection of their designs from three sources: (1) trademark protection under section 43(a) once the design has developed secondary meaning; (2) a design patent; and (3) a

Certainly, under *Qualitex Co. v. Jacobson Products Co., Inc.*,¹³⁹ product design, like color, can be thought of as functional; that is, a product feature whose central purpose is to attract consumers and not to indicate source.¹⁴⁰ If color were not primarily an aesthetic feature, surely manufacturers would not devote large amounts of resources to issue consumer color surveys to gauge which color become popular or to develop new, eye-catching color combinations for their products. This can also be said of design, because consumers are aware that a product with an interesting and unusual design—such as “a cocktail shaker shaped like a penguin”—is designed in that fashion to catch attention and not to indicate source.¹⁴¹ Therefore, though trademark law seeks to promote competition, the *Samara* Court properly stated that trademark law would prohibit an individual from exercising monopoly control over such functional product design features in order to prevent stifling competition.¹⁴²

B. There is No Requirement in Section 43(a) That Courts Must Find Product Design Inherently Distinctive

The *Samara* Court properly concluded that section 43(a) of the Lanham Act does not provide that all categories of trade dress necessarily include some types of inherently distinctive trade dress, for several reasons aside from those based on unfair competition principles.¹⁴³ Distinctiveness is a concept devised by the courts to determine whether a mark is likely to cause confusion that Congress has not codified in any amendment of section 43(a). Finally, even if the Act specified that all categories of trade dress include “some” types of inherently distinctive trade dress, the vagueness of the term “some” would likely lead to yet more judicial disagreement over which trade dress qualifies as inherently distinctive trade dress.¹⁴⁴

copyright for their idea.

139. 514 U.S. 159 (1995).

140. *Samara*, 525 U.S. at 211 (holding that, like color, product design is not inherently distinctive).

141. *Id.* at 213 (stating that consumers are aware that even the most unusual designs are not intended as source indicators).

142. *Id.* (discussing the deterrent effect on competition of plausible infringement suits). For a discussion of the encouragement of free competition by trademark law, *see supra* notes 10-12 and accompanying text.

143. *Id.* at 1343-44 (reasoning that nothing in the Lanham Act requires that the conclusion be drawn that every category of mark include some inherently distinctive mark).

144. *Id.* at 211 (“Nothing in § 2 . . . demands the conclusion that every category of mark necessarily includes some marks ‘by which the goods of the applicant may be distinguished from the goods of others’ without secondary meaning—that in every category some marks are inherently distinctive.”).

C. *The Samara Court's Distinction of Two Pesos*

The one flaw of *Samara*, however, is how the Court distinguished the facts of *Two Pesos* from those of *Samara*. The Court stated that *Two Pesos* held only that trade dress can be inherently distinctive but did not indicate that product design was a type of trade dress that could be inherently distinctive.¹⁴⁵ With little discussion, the Court concluded that the trade dress at issue in *Two Pesos*—the interior appearance of a restaurant—was product packaging or some “*tertium quid*” similar to product packaging, which the Court reasoned was unlike the product design trade dress at issue in *Samara*.¹⁴⁶ The Court went on to state that because differentiating between product packaging and product design will often be a difficult exercise, courts should err on the side of finding that, in an ambiguous case, the trade dress at issue is product design.¹⁴⁷ The Court apparently had little trouble, however, in stating in conclusory terms that restaurant décor constitutes product packaging.¹⁴⁸ Indeed, the Court made this determination even though décor arguably falls under the definition of product design, which includes the size, shape, color or color combinations and graphics of a product’s appearance.¹⁴⁹ Therefore, because décor is neither clearly packaging nor clearly design, the Court should have concluded, by its own logic, that décor constitutes product design.

VI. IMPACT

Though *Samara* has settled one issue that had divided several circuits, the decision has raised two collateral issues. First, when *Samara* is read with the *Sears-Compco-Bonito Boats* line of cases, it appears that product design can never be protected under state trademark law. *Samara* held that product design can never be inherently distinctive and must therefore have secondary meaning in order to be eligible for protection under section 43(a).¹⁵⁰ The *Sears-Compco-Bonito Boats* rule provides that state law that seeks to provide patent-like protection to unpatented or uncopyrighted product design will be preempted by federal patent law, even if the product design has secondary

145. *Id.* at 214-15.

146. *See id.* (stating that restaurant décor constitutes product packaging or some variation of it).

147. *Id.*

148. *See id.* (stating that trade dress at issue in *Two Pesos* was product packaging).

149. *See Duraco Prods., Inc. v. Joy Plastic Enters., Ltd.* 40 F.3d 1431, 1439 (3d. Cir. 1994) (affirming previous holding that trade dress includes appearance of product); *American Greetings Corp. v. Dan-Dee Imports, Inc.*, 807 F.2d 1136, 1140 (3d Cir. 1986) (holding appearance of teddy bears constituted “trade dress”).

150. *Samara*, 529 U.S. at 216 (holding that product design can never be inherently distinctive and must have secondary meaning in order to be eligible for protection under section 43(a)).

meaning.¹⁵¹ Therefore, though product design with acquired distinctiveness would be protected under federal trademark law, it theoretically now would be protected under state law trademark law only if it were patented or copyrighted.¹⁵²

Second, *Samara* has raised concerns among several industries that the decision will open the legal door for competitors to make knockoffs of current designs.¹⁵³ These industries contend that *Samara* will make it more difficult to prevent the copying of their designs because they will have to prove acquired distinctiveness through secondary meaning to receive protection under the Act.¹⁵⁴ Nevertheless, according to one intellectual property attorney, acquiring distinctiveness is not especially difficult in certain industries.¹⁵⁵ In the fashion industry, for example, the name of a designer of a certain line or article of clothing may be quickly spread through word of mouth or through grand-scale advertising campaigns.¹⁵⁶ Still, individuals in the same industries welcome the *Samara* holding.¹⁵⁷ Therefore, while *Samara* solved one problem by settling the circuit split over the protection of product design, a study of its wake reveals twice as many concerns.

151. *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141 (1989) (holding that where state law affords greater protection to product design than federal patent law, state law will be preempted). For a discussion of the *Sears-Compco-Bonito Boats* cases, see *supra* notes 50-53 and accompanying text.

152. Thus, an individual is left with no choice but to seek federal protection of his or her product design if the product design fails to meet design patent and copyright standards.

153. See Craig S. Mende, *How the High Court Sliced the Safety Net Against Knockoffs*, BRANDWEEK, Aug. 21, 2000, at 30 (stating that *Samara Bros.* will make it harder to protect product designs); Victoria Slind-Flor, *No One Has a Lock On Fashion*, NAT'L L.J., April 10, 2000, at B7 (quoting a fashion executive, who stated that *Samara* opinion "was written nine to nothing in favor of copying. That's it in a nutshell."); Brenda A. Jacobs & Lisa A. Crosby, *Knock It Off!*, BOBBIN, July 1, 2000, at 97 (stating that *Samara Bros.* "makes the ground rules more clear, which may signal a green light for knockoff artists where there once was a yellow one").

154. See *id.* (noting concerns of industries).

155. See Slind-Flor, *supra* note 153 (providing opinion of intellectual property attorney on difficulty of acquiring secondary meaning).

156. *Id.* (providing fashion industry examples of development of secondary meaning).

157. Lorrie Grant, *Ruling Sets New Standards On Unique Clothing Designs*, USA TODAY, Mar. 23, 2000, at 3B (providing opinion of intellectual property attorney who stated that *Samara Bros.* "will be welcome by the fashion industry, except for those who originate the designs"). The owner of Wal-Mart, for example, stated that the new standard will make it possible for its customers to purchase "the latest fashions at affordable prices." *Higher Bar For Design Protection*, ARIZ. REPUBLIC, Mar. 23, 2000, at D3.

