

Focus

LOS ANGELES DAILY JOURNAL • MONDAY, JANUARY 23, 2006 • PAGE 9

So Far, Hooters Can't Claim Ownership of Short-Shorts

By Randy Broberg
and Cheryl Withycombe

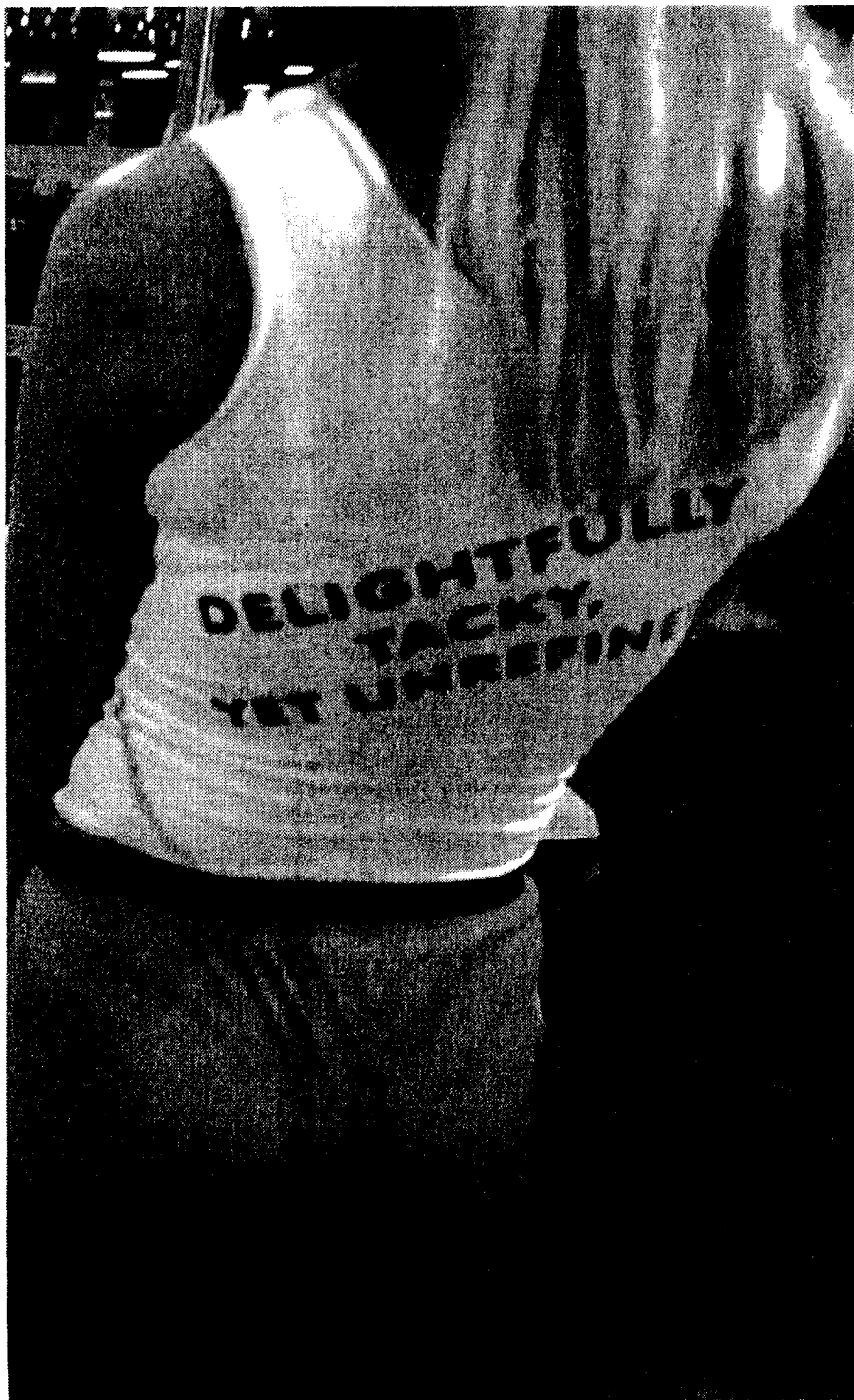
It's not possible for a single restaurant to have exclusive rights to waitresses wearing tight tank tops and short shorts — or is it?

The Hooters brand restaurant chain may be better known for the provocative dress of its employees than for its burgers and chicken wing cuisine, but until recently, the main trademark issue that might have come up was whether the "Hooters" mark merely represented the owl mascot or had some other double meaning. A good look at the outfits in controversy can be found at Hooters of America Inc.'s own Web site, www.hooters.com. You be the judge.

In Hooters' own words, "The chain acknowledges that many consider 'Hooters' a slang term for a portion of the female anatomy. Hooters does have an owl inside its logo and uses an owl theme sufficiently to allow debate to occur over the meaning's intent. The chain enjoys and benefits from this debate. In the end, we hope Hooters means a great place to eat."

But now it seems the trademark issues are really getting interesting. Hooters' Web site statement already acknowledges that "[t]he element of female sex appeal is prevalent in the restaurant," but now Hooters is asserting that it has legal protection for the "look and feel" and titillating experience customers encounter when dining there.

To press this claim, Hooters has sued the Winghouse restaurants in Florida to get them to stop its waitresses from wearing black short-shorts and black tank tops, even though the tank tops bear the Winghouse "wing" logo and not any version of "Hooters" or owls. Since the marks themselves are different, the case hangs on the tight tops and short shorts.



Associated Press

Hooters brand restaurants claimed exclusivity on the chain's short-shorts uniform, but a federal judge in Florida disagreed. The case is on appeal.

Is it possible for Hooters to successfully claim exclusive rights to the use of a waitress outfit consisting of short shorts and tight tank tops? Can skimpy outfits like this be considered legally protected "trade dress" belonging exclusively to just one company? These were the kind of questions before the district court in Florida in the case *HI Ltd. Partnership v. Winghouse of Florida Inc.*, No. 6:03-cv-116 (M.D. Fla. 2004).

Trade dress is a form of trademark protection. It is widely known that trademarks can be any word or logo that serves to indicate the source of goods or services. But trademarks may also be packaging styles (like the Gateway cow spots), building architecture (like those of certain fast food restaurants), colors (like Owens Corning's pink insulation or the black/gray/black color scheme of Never Compromise brand golf putters), shapes of jars, bottles and boxes (like the Coca Cola bottle or the hour-glass-shaped Pace brand picante sauce jar).

and tight tank tops have come to be widely recognized as by themselves, indicating that a particular brand restaurant is being encountered (what the trademark law calls "secondary meaning") or that the outfits are inherently distinctive. Second, the Hooters outfits can't primarily be functional or merely ornamental.

At the district court level, Hooters was unable to prove that bar waitresses wearing tight tank tops and short shorts didn't primarily serve a functional, as opposed to brand, purpose. In fact,

that Reinhold would never have chosen for any functional reason.

Likewise, if the Hooters Girl wardrobe was really all that inherently distinctive and non-functional, then you wouldn't expect that women who don't work at Hooters would buy the outfits just for their obvious functional appeal.

Another movie that drew our attention to restaurant trade dress was "Office Space," in which Jennifer Aniston had issues with her uniform requirement of wearing "37 pieces of flair." Following the Hooters decision, one might

Even sounds can be registered as trademarks, if they are distinctive (like the multi-tone siren of the Viper brand car alarm). The U.S. Supreme Court, in *Two Pesos Inc. v. Taco Cabana Inc.*, 505 U.S. 763 (1992), upheld trade dress rights in restaurant decor, as long as it is inherently distinctive and nonfunctional.

But Hooters is claiming something a little bit broader than these examples. It is claiming that the overall impression, ambiance or experience of dining in a Hooters restaurant somehow constitutes its proprietary trade dress. According to Jerome Gilson's "Trademark Protection and Practice," trade dress "consists of the total image of a product or service, including ... retail decor, architectural features, menus, restaurant layouts, styles of service, costumes, and occasionally marketing techniques as well." Section 7.02[7][c].

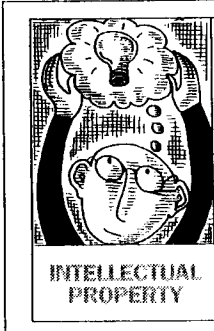
Under this theory, Hooters claimed trade dress rights in their retail decor, certain architectural features, menus, restaurant layout and most controversial of all, the Hooters Girl outfits.

Hooters claimed that Winghouse copied its entire trade dress: the waitresses outfits, the rustic interior woodwork, dining tables consisting of red wood surrounded by lighter pine wood and then covered with a shiny epoxy, a paper towel spool on the tables, wood-weave plate-ware, a parchment paper menu with the story of the restaurant on the back, surfboards on the walls and beach music.

The district court held that Hooters was unable to establish protectable trade dress in its overall restaurant theme because the "elements of Hooters' trade dress consist of fairly generic items commonly found in sports bar and grills, beach-themed restaurants and raw bars."

Other elements appear to be pretty functional, like having paper towels at the ready when eating barbecued chicken wings. Therefore, the court focused directly on the Hooters Girl outfits.

For Hooters' claim to exclusivity in its Hooters Girl outfits, Hooters needs, first, to prove either that its short shorts



Can skimpy outfits like this be considered legally protected 'trade dress' belonging exclusively to just one company?

Hooters' employees admitted that the Hooters waitresses' main purpose is functional — specifically to attract male customers to the restaurants. Perhaps not surprisingly, in a previous Hooters employment discrimination case, the company had admitted: "the Hooters [g]irls' predominant function is to provide vicarious sexual recreation, to titillate, entice, and arouse male customers' fantasies."

Facing facts that seem self-evident, but even now admitted, the district court judge held that no reasonable jury could conclude that the primary function of the Hooters tank tops and short shorts was not to attract male customers. This finding defeated Hooters' trade dress claim because trade dress cannot be merely functional. Said Judge Anne C. Conway, "Hooters cannot monopolize this generic theme any more than an upscale steak restaurant featuring tuxedo-clad servers could preclude competitors from using the same or similar uniform."

Hooters appealed the district court decision. A three-judge panel heard the case on Jan. 13.

Another problem with the Hooters case not discussed by the district court judge is the fact that Hooters sells to anyone on the Internet the very outfits it claims are indicators of source. How can Hooters claim its tank tops and short shorts are indicators of the brand of restaurant when anyone can buy the clothing and wear it anywhere they want? Who can forget the comical "Captain Hook Fish & Chips" outfit being worn by Judge Reinhold in "Fast Times at Ridgemoor High?" Now there was an inherently distinctive restaurant outfit

ask how many pieces of flair would be required for Hooters to successfully establish protectable trade dress in its Hooters Girls outfits? Like the restaurant manager's answer in the movie, however, there is no clear minimum number of pieces of flair, whether for restaurants seeking trade dress or for any company in any industry seeking to protect the "look and feel" of its products.

Rather, any company seeking to protect the look and feel of not just restaurants but any kind of product or service should adhere to the following guidelines:

- Adopt a look and feel that serves no functional purpose.
- Adopt a brand image that is not merely decorative.
- Adopt a trade dress that's not already in use by your competitors.
- Use your trade dress consistently and uniformly throughout all geographic areas and in all marketing channels.
- Don't allow imitators.
- Keep up your efforts over a significant period of time.
- Apply to register your trade dress as a trademark in the U.S. Patent & Trademark Office.

Finally, remember Hooters' own motto applies to branding as well: "You can sell the sizzle, but you have to deliver the steak."

Randy Broberg, a partner in the Del Mar Heights office of Allen Matkins, heads the firm's intellectual property practice. **Cheryl Withycombe**, an attorney concentrating on trademark law, also practices in the Allen Matkins Del Mar Heights office.