

TRADE DRESS

TRADE DRESS

Evolution, Strategy, and Practice

Darius C. Gambino

William L. Bartow

Foreword by Cooper C. Woodring

2021

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Dedication

Bill thanks his wife, Kelly, and his son Billy, for their love, support, and understanding. Bill also thanks his parents, Harry and Mary Jean, and sister, Jeanne, for their encouragement and guidance.

Darius thanks his wife, Jennifer; his son, Grant; and his daughter, Grace, for their love, patience and support. Darius also thanks his parents, Gerald and Carol, for always being there.

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Introduction

Trade dress is a type of intellectual property that generally refers to the visual appearance of a product or its packaging, which signifies the source of the product to consumers. While trade dress law is most certainly an offshoot of trademark law, it is a mistake to consider them as a unified legal concept. Trademarks can be described as words, phrases, logos, or combinations thereof. Alternatively, trade dress is more aptly described as including three-dimensional shapes, sounds, scents, and color schemes. Although trademark and trade dress law do share some common elements, there are some clear differences which have led to the development of an entirely separable and distinct body of case law.

While the concept of trade dress has existed for some time, the doctrine lay dormant for many years, until it was again thrust upon the scene by the Supreme Court decisions in the *Two Pesos*, *Wal-Mart*, and *TrafFix Devices* cases. These decisions raised the profile of trade dress and changed the perception of trade dress for many intellectual property practitioners. These decisions also ultimately resulted in increased attention being paid to trade dress at the developmental stage. Much like with patents, many companies have implemented programs to identify and protect trade dress at the earliest possible opportunity in the wake of these decisions. By the same token, many more trademark applications were filed with the U.S. Patent and Trademark Office in the last fifteen years seeking protection of trade dress. There is no doubt that trade dress litigation will soon become a major competitor to patent litigation as a means of intellectual property enforcement. Based on the fact that trade dress litigation is, in most cases, significantly cheaper than patent litigation, one would be wise to consider it as a viable alternative.

Trade Dress: Evolution, Strategy, and Practice analyzes the differences between the major types of trade dress (product configuration and product packaging), describes the standards of proof for each, and explains how these standards have been interpreted (and in some cases misinterpreted) by the federal courts. The book also reviews the evolution of trade dress in the United States and its recent emergence as an enforcement alternative. Finally, it offers practical suggestions on how best to utilize trade dress rights in protecting a client's valuable intellectual property interests.

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Thanks also to the trademark and trade dress legal scholars who preceded us, without whom we could not have possibly completed this book. Special thanks to Professor J. Thomas McCarthy—your treatise remains the gold standard in this area.

Bill: I would like to thank my wife, Kelly; my son, Billy; my parents, Harry and Mary; my sister, Jeanne; and all of my family and friends. The guidance, encouragement, understanding, support, and new perspectives that I have received from you over the years is invaluable to me, and I thank you all for sharing it with me.

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Darius: I would like to thank my parents, Gerald and Carol; my wife, Jennifer; my children, Grant and Grace; my family; and all of my friends—without you, none of this is possible. Your support, encouragement, and advice (and criticism) have always been very important to me, and I thank all of you from the bottom of my heart.

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To my wife and children, never doubt for a minute that you are what matters most. To my parents, thank you for everything—I wouldn't be where I am today without you.

A special thanks to my grandmother Phyllis, who passed away in 2008, in case I never told you—you encouraged all of my inspirations and aspirations, and for that I dedicate this book to your memory.

Darius C. Gambino
William L. Bartow
June 1, 2021

Preface

THIS BOOK IS intended to be an introduction to the basic concepts of trade dress law and a reference guide for intellectual property practitioners. This book is not intended to be a comprehensive study of trade dress. It is meant to aid those who may have limited experience with trade dress in navigating what are sometimes treacherous waters. Primarily, it is intended to provide necessary background to attorneys, who will undoubtedly be encountering trade dress issues more and more frequently in the coming years. The proliferation of product configuration trade dress described in this book is making trade dress litigation a viable, and more economical, alternative to patent litigation. Patent practitioners in particular would do well to add some basic understanding of trade dress law to their knowledge base.

We have both spent a good portion of our careers in the patent field. What we found out over the years was that in order to advise our clients properly, we needed an understanding of not just patent law, but also trademark, copyright, and other areas of intellectual property law, so our practices expanded. Inevitably, we came upon our first trade dress cases. While some of the concepts contained in this book may seem foreign at first, our experiences provide proof that the basic legal principles of trade dress can be easily assimilated.

We hope that this book will be an aid to intellectual property practitioners who encounter trade dress issues in their daily practice, and a resource for all attorneys.

All the best.

—Darius and Bill

Foreword

Cooper C. Woodring

Industrial Designer and Fellow of the Industrial Designers
Society of America (FIDSA®)

Ed Sabol, founder of NFL Films, is quoted as saying, “Tell me a fact and I’ll learn. Tell me the truth and I’ll believe. But tell me a story and it will live in my heart forever.”

I’d like to tell you a story about trade dress.

Most would agree that it takes time to gain perspective on any subject, so let’s look back on the issue of trade dress from, say, 488 years from now, in the year 2500.

Instead of being attorneys, imagine that we are archaeologists and cultural anthropologists, gathered together on the eastern coast of a landmass that was known as “The Americas.” We have gathered here to investigate a vanished culture that existed after the Industrial Revolution, during a period called “The Nuclear Age.” After removing layer after layer of industrial particulate, some possibly radioactive, the artifacts of a wealthy civilization of people who surrounded themselves with unprecedented numbers of mass-produced objects is discovered.

Because there are no remaining records to explain this vanished culture, we will learn about them as we have learned about other lost civilizations: by examining their artifacts. However, by now we have advanced the sophistication of our investigative techniques by not only examining the outward appearance of artifacts, but by also by figuring out how their appearance teaches us about where the articles came from, or their source. We believe they called this outward appearance of the articles “trade dress.”

As an example, one set of the objects we discovered were small rectangular hand-held communications devices with very few moving parts and a flat glass front. One such artifact has some lettering remaining on its rear side that reads, “Designed by Apple in California,” which we believe was on the opposite coast of the landmass called The Americas. Others have no lettering at all. Irrespective of this lettering, we can determine the source by examining the artifact’s size, shape, color, materials, texture, degree of gloss, graphics, and even the artifact’s aura, cachet, and status—in essence, we can use these clues to tell us who made the device.

Another artifact we discovered was initially confused with a similar artifact until we learned which was which by examining both artifacts’ “trade dress.” The first was an attractive young female’s rather skimpy costume. We learned it was worn by a small group of “leaders of cheers” from a place they called Dallas. The second artifact was a similarly skimpy costume worn by a much larger group of attractive young females who served food and drink, mostly drink we think, in a place whose name sounded like the hoot of an owl. We were able to distinguish between these two groups of artifacts by examining and comparing their overall appearances, which were quite distinctive from one other.

These mass-produced objects tell us about this society’s social traits and values, its religions, its political and economic systems, and, most important, its quality of life.

We call this period “The Century of the Common Man” because it is the first time the right to happiness and material well-being are obtainable for the average person. Evidence of this trend is discovered in their “Everyday Art,” art that infuses common objects—from products to buildings to interiors—with practicality, safety, convenience, comfort, affordability, and beauty, in the form of an appearance so distinctive that we can identify its source.

In these people’s century, art was no longer created by the few, or for the few. Rather, art became integrated into their society’s products, and art infused their homes and lives with qualities once reserved for museums. We know this by examining the “trade dress” of their artifacts. This was the century when good design was no longer a luxury or novelty—when it became a necessity and was considered by most nations to be a competitive weapon and a national resource.

This culture also learned that what was worth stealing was also worth protecting. So they developed laws that often took many decades to mature such that they could provide adequate and needed protection for designs that were inherently distinctive or had acquired distinctiveness. These laws became powerful tools for successful manufacturers to protect the considerable investment they had made in the appearance of their artifacts, by designing into their artifacts visual qualities that their customers could associate with them, and them alone. As less successful manufacturers witnessed others ability to create distinctive designs and then protect their goods in trade, they quickly adopted this successful formula, and soon hardly a manufacturer survived that did not practice this new business model. We believe these people were very clever to devise a method of offering protection to the makers of distinctive goods that was so advantageous. Unlike several other forms of legal protection they had, this one did not require government approval, it was free, and it lasted forever—very clever.

Darius C. Gambino and William L. Bartow have written a book about the rather complicated subject of trade dress that even I, an industrial designer with degrees only in fine arts, can understand. They accomplished this without “dumbing down” the contents for the book’s broader audience. The authors explain, for example, the critical choice that must be made between product *packaging* trade dress and product *configuration* trade dress, in crystal-clear language. For example, they explain that by claiming the trade dress of a car body as a *package* rather than as a *configuration*, you eliminate the need to prove acquired distinctiveness (secondary meaning), and they note that in many cases the failure to make such proof can sink your trade dress infringement case before you ever get to an assessment of likelihood of confusion. This is but one of many examples they cite that, in my experience, are not well understood by attorneys.

Last, I would like to congratulate Darius and Bill for not just taking over two years out of their lives to write a book, but for sharing their collective knowledge and experience with the rest of us, when others might have kept their competitive advantage to themselves for obvious reasons. I would also like to thank the authors for not just writing a book, but telling a story. As Ed Sabol said, “Tell me a story and it will live in my heart forever.”

Thank you, Darius and Bill.

CHAPTER 1

The Roots of Trade Dress

SYNOPSIS



§ 1.01 Introduction

§ 1.02 The Trademark Acts of 1870 and 1881

§ 1.03 The Trademark Act of 1905

§ 1.04 The Trademark Act of 1946—The Lanham Act

§ 1.05 The Lanham Act Amendments of 1988 and 1999

§ 1.06 The Modern-Day Supreme Court Decisions

§ 1.01 Introduction

Trade dress is literally everywhere—from the fast food restaurant where you stop for a quick hamburger on the way home from work, to the iPod you used at the gym, to the car you drove to get to all those places. Companies have been using unique color schemes, shapes and ornamental designs to define their brands, and to get customers to remember their products, for some time. The enforcement of trade dress rights, however, took some time to take shape. Part of the delay had to do with the fact that trade dress was not statutorily recognized until 1988. A portion of the delay also had to do with a lack of understanding of the scope of trade dress rights. Today, trade dress rights may be some of a company’s most important intellectual property assets, on par with patents, trademarks, and copyrights.

Trade dress law is generally viewed as judicially created law.¹ Traditionally, trade dress was referred to as “the overall appearance of labels, wrappers, and containers used in packaging a product.”² However, the scope of trade dress protection has broadened considerably over the years. Many entities, including the United States Patent and Trademark Office (USPTO), the Federal Courts, and the Supreme Court have increased the scope of trade dress protection through various case law decisions.³ From its humble origins, trade dress has evolved to include the general packaging of a product, as well as a product’s design or shape.⁴ Trade dress law in the United States has also shifted from being rooted in common law to having an independent federal statutory basis.

It took over a century for the term “trade dress” to be explicitly stated in a federal statute. The common law would initially refer to trade dress infringement as unfair competition.⁵ It was not until the late 1800s that the term “trade dress” was explicitly used in court decisions. Further, it was not until the 1946 Trademark Act that trade dress was believed to be at least implicitly protected by federal statute.⁶ In 1988, the Lanham Act became the first federal statute to explicitly refer to “trade dress.”⁷

Initially, the common law only distinguished between trademarks and unfair competition, where trademarks were considered to be a subsection of unfair competition law.⁸ Trademark infringement and unfair competition found their “roots in the common law action of deceit and the gravamen of the original tort for such protection was fraudulent marketing of goods through imitation of another’s trademark.”⁹ These common law actions led to the creation of the tort action for passing off or palming off.¹⁰ The common law was concerned with preventing deceit of customers through dishonest behavior. Simply stated, the group of torts including unfair competition, trademark, and trade dress each held to the tenet that “one merchant shall not divert customers from another by representing what he sells as emanating from the second.”¹¹

Traditionally, trademarks were provided with more protection than trade dress, with courts requiring proof of secondary meaning for trade dress enforcement.¹² “That is, the trade dress owner was required to show that “the consuming public recognized the design of the product and associated it with a single producer” and that the consumer would “buy [the product] in part by the source of the product.”¹³ On the other hand, unfair competition law focused on business integrity and legitimate trading.¹⁴ Although a manufacturer was able to produce and sell any article that was not protected by a patent, this had to be done fairly. The application of this concept in the Seventh Circuit, for example, was evident in their definition for trade dress during this period. The Seventh Circuit defined trade dress as

[t]he appearance of an article [that] has become associated in the public mind with the first comer as manufacturer or source, and, if the second comer imitates the article exactly, that the public will believe his goods have come from the first, and will buy, in part, at least, because of that deception.¹⁵

During this early period, the belief, or mantra, was that “equity will protect the honest, and restrain the dishonest trader.”¹⁶ In time, equity would not be sufficient to protect trade dress, and the move toward a statutory regime would begin.

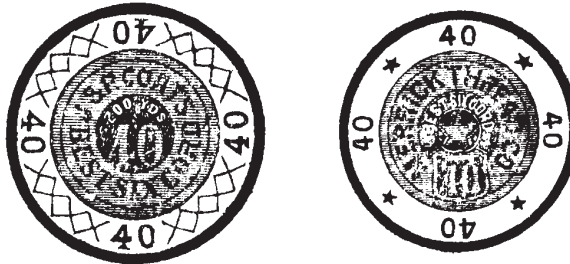
§ 1.02 The Trademark Acts of 1870 and 1881

The first federal statute that permitted trademark registration was passed in 1870.¹⁷ This law was only in effect for nine years when it was declared unconstitutional in 1879 by the Supreme Court. The reason for this was that the statute included coverage for both intrastate commerce (i.e., commerce within one state) and interstate commerce (i.e., commerce between two or more states), in violation of article 1, section 8, clause 3 of the Constitution.¹⁸ Section 8 of the Constitution states that Congress has the power to “regulate commerce with foreign nations, and among the several states, and with the Indian Tribes.”¹⁹ Thus, intrastate commerce was not controllable by Congress. In supporting this ruling, the Supreme Court stated that “Congress’s power to regulate trademarks was limited to an exercise of Commerce power.”²⁰ Commerce power was limited to interstate and foreign commerce by the Constitution.²¹

The theory was that there was no specific language in the Constitution granting Congress the power to regulate trademarks, as there was for copyrights and patents.²² For these reasons, the power to regulate trademarks had to be limited to regulation of interstate and foreign activity.²³

In 1881, Congress passed a new statute that sought to avoid this constitutional conflict. The Trademark Act of 1881 allowed for the registration of marks only used in commerce with foreign nations and Indian tribes, but not intrastate commerce or interstate commerce.²⁴ Not surprisingly, many found that the 1870 and 1881 Trademark Acts were inadequate means for protection of trademarks (and trade dress) because at that time only a small subset of products were being sold in international trade channels. Accordingly, common law unfair competition claims remained the primary means for resolving trademark and trade dress disputes.

One of the first cases explicitly drawing a distinction between trademark, unfair competition, and trade dress was *Coats v. Merrick Thread Co.*, decided in 1882.²⁵ This case followed the common law tradition by focusing on secondary meaning and consumer confusion to determine whether a trade dress violation was present.²⁶ The plaintiffs had been manufacturing thread in Paisley, Scotland, under the name J&P Coats since 1830.²⁷ In 1840, the plaintiffs placed the thread on the market in the United States, and around 1867 they started manufacturing thread in Rhode Island due to consumer demand.²⁸ Prior to the plaintiff's entry in 1840, six-cord thread like theirs was not made in the United States.²⁹ The defendants, Merrick Thread Company, had been manufacturing 200-yard spools of six-cord thread in Massachusetts since 1865.³⁰ The ends of the spools for both companies held a black and gold label of concentric rings with the name, size, and quality of the thread.³¹ The ends of the spools are shown below, with J&P Coats on the left and Merrick Thread Co. on the right.



In 1870, the plaintiffs obtained a design patent for “embossing the ends of swing-thread spools” covering the “design for ornamenting the ends of the sewing-thread spools” consisting of loops and a number corresponding to the number of thread wound on the spool.³² In addition, the ends of the thread spools bore a black and gold label.³³ This design patent expired in 1877.³⁴ After expiration of their design patent, the plaintiffs notified the defendants of their “exclusive use of this combination” and brought suit over the defendants’ use of the label shown above.³⁵ In finding no unfair competition violation by the defendants, the court stated that the color combination and printing of the amount of thread on the spool labels was a scheme widely used by others.³⁶ In other words, the court found the J&P label lacked secondary meaning and thus was not capable of forming the company’s trade dress. Further, the Court stated:

If the plaintiff’s had been the first and only ones to make use of this label, another person seizing upon appropriating a black and gold label of the same size, and for the same purpose, might be held guilty of infringement.³⁷

This statement clearly indicates that trade dress (i.e., the design of a label) was protectable, but with the caveat that secondary meaning be shown. Interestingly, the Court largely ignored the plaintiff's evidence showing that consumers who tried to purchase its product instead purchased the Merrick product (i.e., evidence of actual confusion).³⁸ The Court attributed this phenomena to careless consumers.³⁹ In summary, the Court found no trade dress protection for plaintiffs label, and thus no unfair competition violation.

§ 1.03 The Trademark Act of 1905

Due to the perceived inadequacies of the Trademark Act of 1881, Congress passed the Trademark Act of 1905, which allowed “fanciful and arbitrary [marks]” to be federally registered.⁴⁰ The limitation of statutory protection to “fanciful and arbitrary” marks was a clear nod to the prerequisite of secondary meaning. The Trademark Act of 1905 left many trademarks out in the cold, such as trademarks comprising “personal names of individuals, firms, or corporations.”⁴¹ In addition to being “fanciful and arbitrary,” marks had to be in use ten years prior to registration for enforceability.⁴² These stern prerequisites limited most (if not all) attempts to register trade dress under the Act. These changes also added confusion to trade dress enforcement, in that plaintiffs would often make trade dress claims under the Trademark Act, whereas their claims should have resided in the common law of unfair competition.

For example, in *Kellogg Co. v. Nat'l Biscuit Co.*, the plaintiffs made patent, trademark, and unfair competition claims for the shape of a shredded wheat biscuit.⁴³ The Supreme Court focused on the container used to sell the shredded wheat (i.e., a cereal box), in addition to the shredded wheat food product itself. In finding no unfair competition, the Court stated that there was no consumer confusion due to the look, layout, and lettering of the box.⁴⁴ Further, the Court indicated that shredded wheat was sold within specially decorated containers almost 100 percent of the time. Therefore, consumer confusion was unlikely, and Kellogg was not engaging in deception.⁴⁵

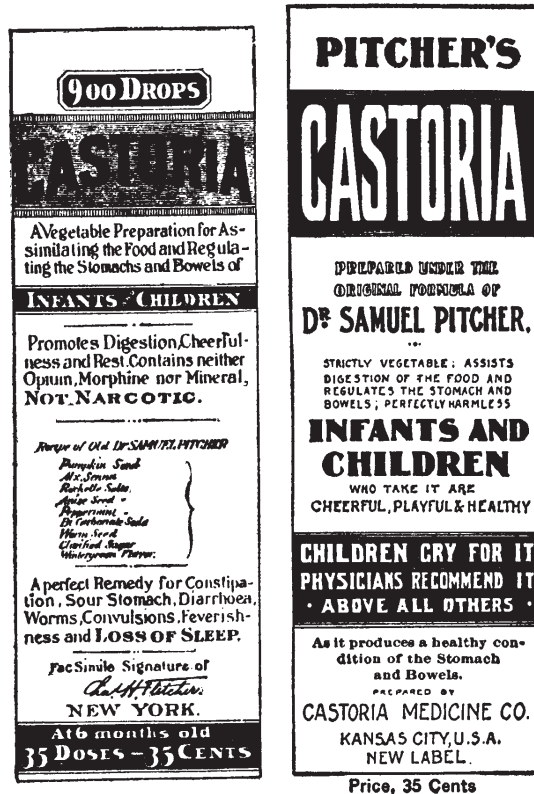
As to the shape of the shredded wheat, the Court appeared to find that such protection fell into the public domain with the expiration of Kellogg's patents:

The plaintiff has not the exclusive right to sell shredded wheat in the form of a pillow-shaped biscuit—the form in which the article became known to the public. That is the form in which shredded wheat was made under the basic patent. The patented machines used were designed to produce only the pillow-shaped biscuits. And a design patent was taken out to cover the pillow-shaped form. Hence, upon expiration of the patents, the form, as well as the name, was dedicated to the public. ... Kellogg Company was free to use the pillow-shaped form, subject only to the obligation to identify its product lest it be mistaken for that of the plaintiff.⁴⁶

However, the Court also noted that the design patent at issue had been previously declared invalid for lack of novelty. As a result, the Court's comments about the relationship between trade dress and design patents are dicta. Additionally, the Court noted the functionality of the pillow-shaped biscuit, which would make it incapable of trade dress protection (as discussed in more detail in Chapters 5 and 6).⁴⁷ In fact, virtually every court since Kellogg has found that trade dress protection can exist for a product beyond the expiration of a design patent.⁴⁸ Kellogg may be considered one

of the first true trade dress cases, as it squarely addressed both product packaging (i.e., the look and layout of the box) and product configuration (i.e., the shape of the shredded wheat cereal), concepts which predominate in trade dress law today. One could argue that the claims and analysis in Kellogg set the stage for modern trade dress litigation.

Another notable case during the early development of trade dress law was *Centaur Co. v. Marshall*, where an injunction bid relating to competing product labels was denied.⁴⁹ Both Centaur and the Marshall sold a product called Castoria (a laxative for children) with labels covering the outside of the medicine bottle.⁵⁰ Centaur sought to enjoin Marshall from covering their medicine bottles with wrappers that were in some ways similar to Centaur's wrappers.⁵¹ Centaur provided no evidence of deception, leaving the court to decide whether the wrappers were similar enough to create confusion.⁵² The labels are shown below:



In resolving the case, the court focused on the second comer's deceit, stating:

The deceit or the probable deceit, of the purchaser, so that he buys, or probably will buy, the articles of one manufacturer or vender in the belief that they are those of another, is a sine qua non of such a suit, because everyone has the undoubted right to sell his own goods or goods of his own manufacture as such, however much such sales may damage or injure the business of his competitors.⁵³

The court went on to state that everyone has the right to sell medicine under the name Castoria.⁵⁴ The court noted, however, that it is the consumer's duty to inspect the label.⁵⁵ The only duty of the manufacturer is to construct a label that allows a consumer to identify the manufacturer of the product.⁵⁶ Since the Marshall label clearly indicated that the product was from Kansas City, the court found confusion unlikely.⁵⁷ That is, "the radical differences between the wrappers are so marked and striking that such a purchaser can hardly mistake the one for the other."⁵⁸ Based on these factors, the court found that entering an injunction against Marshall would be improper.

From 1881 to 1946, courts enforced trade dress with a focus on consumer confusion and the intent of the defendant as described in *Merrick*, *Kellogg*, and *Centaur*. For example, in *Elizabeth Arden, Inc. v. Frances Denney, Inc.*, the plaintiff claimed that the defendant copied the trade dress of its beauty products—the shape, color combinations, and arrangement of goods.⁵⁹ The plaintiff also claimed that these attributes of the products, including their arrangement, had acquired secondary meaning and that customers relied on such when purchasing the products.⁶⁰ In affirming the trial court ruling in favor of the defendant, the Court of Appeals focused on consumer confusion and the defendant's intent.⁶¹ The court opined that "purchasers should not buy their boxes under the impression that they were buying the plaintiff's," and thus that it was not the defendant's intent to deceive the purchasers.⁶²

In another case, *E. Kahn's Sons Co. v. Columbus Packing Co.*, the defendant mimicked plaintiff's containers for selling kettle-rendered lard and pure lard.⁶³ Similar to *Arden*, the Columbus court focused on the intent of the defendants and consumer confusion. Here, however, the defendants were enjoined because the plaintiff had "reaped tremendous advantages from [its trade dress]," and the defendant had "too closely simulated [it]."⁶⁴ It is clear that the court found secondary meaning in the trade dress, and an intent by the defendant to cause confusion.

In *Rhymer v. Rhymer* the court considered the defendant's utter disregard for consumer confusion relevant in its finding infringement.⁶⁵ The defendant made cabinet heaters that mirrored the design of the plaintiff's cabinet heaters.⁶⁶ However, the defendant's construction quality, craftsmanship, and dependability was lower than the plaintiff's.⁶⁷ The only discernible feature that served to distinguish the two products to a consumer was a plate displaying the brand name.⁶⁸ However, when the defendant placed its heater for sale in the Montgomery Ward catalog, it was the policy of Montgomery Ward to not allow such nameplates.⁶⁹ Therefore, when listed in the catalog, the defendant's product was listed without the nameplate.⁷⁰ As a result, consumers ordered the defendant's heater in the belief that it was the plaintiff's.⁷¹ In upholding the trade dress violation ruling of the lower court, the Sixth Circuit stated:

Having assumed the plaintiff's trade dress deliberately, and therefore without doubt intending to profit by the plaintiff's good will, and having in respect to the heaters sold to Montgomery Ward dispensed with the distinguishing marks by which both confusion and liability therefore could be avoided, it put within the power of its customers an opportunity for invading the plaintiff's property right, and the maker has been generally held to responsibility for contributing to the unfair competition which in such cases results.⁷²

By the mid-1940s most courts were applying unfair competition law to trade dress claims, with eye to "restrain deceitful and fraudulent competition in whatever garb of misrepresented identity it assumes."⁷³ As the District Court of Massachusetts stated,

“[U]nfair competition must rest upon proof that the public was deceived or that defendants intended to deceive and took steps which were calculated to deceive the public as to the source of the goods in question.”⁷⁴ A showing of secondary meaning was also required. This entailed providing evidence that “the appearance of the article has become associated in the public mind with the first comer as manufacturer or source, and if a second competitor imitate[s] the article exactly, that the public will believe his goods have come from the first, and will buy, in part, at least because of that deception.”⁷⁵ In some instances, trade dress law had developed beyond the law of unfair competition by this time.

The most notable trade dress case during this period was *Sinko v. Snow Craggs Corp.*, which held that a trade dress is protectable if it has achieved secondary meaning.⁷⁶ The plaintiff (Sinko) claimed that defendant (Craggs) copied the distinctive marking and color combinations on gear shift knobs for automobiles.⁷⁷ The Sinko knob was jeweled, round, and fluted. Craggs approached Sinko to supply it with jeweled knobs, but the parties could not agree on the terms. Thereafter, Craggs started making its own jeweled knobs.⁷⁸ Sinko also held a design patent for the knob, but it was found to be invalid by the district court.⁷⁹

The court noted that “Craggs went very far in imitating Sinko’s product,” to the point that they were “almost indistinguishable” in the market.⁸⁰ The court further stated that this was a case where “the second comer imitates the article substantially, in effect producing a facsimile of the first comer’s whole article.”⁸¹ However, Craggs did not copy the packaging which the knobs were contained in for sale in the market.⁸² Since Sinko’s design patent for the knob was found to be invalid, the court found that Sinko did not have a monopoly on the design.⁸³ Therefore, whether Craggs was allowed to imitate Sinko’s design depended on whether the trade dress of Sinko’s knob had acquired secondary meaning.⁸⁴ The court looked to the decision in *Crescent Tool Co. v. Kilborn & Bishop Co.*, which defined secondary meaning as

[t]he appearance of the article has become associated in the public mind with the first comer as manufacturer or source, and, if the second comer imitates the article exactly, that the public will believe his goods have come from the first, and will buy, in part, at least, because of that deception. Therefore it is apparent that it is an absolute condition to any relief whatever that the plaintiff in such cases show that the appearance of his wares has in fact come to mean that some particular person—the plaintiff may not be individually known—makes them, and that the public cares who does make them, and not merely for their appearance and structure.⁸⁵

The court held that Sinko had not established a relationship reputation with consumers and dealers such that the trade dress of the knobs was associated with Sinko alone.⁸⁶ The court found that jewels have been used extensively in automobile equipment manufactured by others for a long time, and therefore it was unlikely that the jewels could be used to identify the manufacturer.⁸⁷ Further, no evidence was provided of any “large expenditures in advertising” by Sinko. The court also stated that there was not enough time between the manufacturing of the knobs by Sinko and Craggs for the identification of Sinko as the sole source for the jeweled knobs.⁸⁸ In sum, the court found that there was insufficient evidence to establish secondary meaning.

This period also saw several cases limiting state power over federal patent law, which in turn impacted trade dress claims. For example, in *Sears, Roebuck & Co. v.*

Stiffel Co. and Compco Corp. v. Day-Brite Lighting, Inc., the Supreme Court held that states were not permitted to challenge federal patent and copyright laws in passing laws preventing “producers from copying an article that is not protected by any federal patent or copyright.” The courts found generally that the federal government already “established the existence of free competition” for this particular article.⁸⁹ These developments effectively removed state law as an option for trade dress enforcement.⁹⁰

§ 1.04 The Trademark Act of 1946—The Lanham Act

In 1946, the United States witnessed passage of the Trademark Act of 1946 (also known as the Lanham Act), which many believed “codified what had been a cobbled patchwork of federal common law and state statutes.”⁹¹ Congressman Fritz Garland Lanham of Texas sponsored the bill, and the Act still bears his name. Lanham stated that the purpose of the 1946 Act was to “protect legitimate business and the consumers of our country.”⁹² Further, Congress aimed to “protect the public from deceit, to foster fair competition, and to secure the business community the advantage of reputation and good will by preventing their diversion from those who have created them to those who have not.”⁹³ Congress also aimed “to protect the public so it may be confident that, in purchasing a product bearing a particular trademark which it favorably knows, it will get the product which it asks for and wants to get.”⁹⁴

Notably, the Lanham Act included section 1052, which many have interpreted as an express inclusion of trade dress. Section 1052 states that “no trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register.”⁹⁵ The immediate effect of the Lanham Act was the broadening of the scope of trademarks that could be registered and protected; however, there was still no express recitation of “trade dress” in the statute.⁹⁶ This omission was soon to be addressed by the United States Patent and Trademark Office (USPTO).

In *Ex parte Haig & Haig, Ltd.*, Assistant Commissioner of the USPTO Daphne Robert Leeds held that a bottle shape was protectable as a trademark under the Lanham Act.⁹⁷ This case concerned a whiskey bottle known as the “Pinch Bottle” or “Dimple Bottle.”⁹⁸ The decision reasoned that there was no prohibitive language in the Lanham Act barring an applicant from registering the design of a bottle.⁹⁹ Further, the recitation of “symbol or device” was interpreted to include the product’s appearance.¹⁰⁰ Since the design of the whiskey bottle was found to be “original” and “distinctive” and had a “peculiar appearance” that caused consumers to recognize the product, the USPTO found that protection of the design should be afforded through registration on the Principal Register.¹⁰¹ Thus, in this 1958 holding, Commissioner Leeds effectively authorized the registration of trade dress on the Principal Register. Not unexpectedly, an application for registration of what many consider the most famous product configuration trade dress in the world (the shape of the original Coca-Cola bottle) soon followed in 1959.¹⁰²

Professor Lunney of Tulane University School of Law contends that the *Haig* decision was an egregious error in statutory interpretation.¹⁰³ In his article “The Trade Dress Emperor’s New Clothes,” Lunney posits that Congress only meant for trade dress to be registered on the Supplemental Register.¹⁰⁴ Lunney argues that the sort of “symbol or device” referred to in the Lanham Act is “the common law’s definition

of a technical trademark,” which had a specific meaning under the 1905 Trademark Act. He further contends that the 1905 Act prohibited protection of “descriptive words and trade dress.”¹⁰⁵ Lunney argues that Congress intentionally omitted the language of “label, package, configuration of goods” from the definition of the trademarks registrable on the Principal Register, but included these terms in other areas of the Act.¹⁰⁶ In his view, this indicated Congress’s clear intent to exclude trade dress from registration. Despite the above, *Haig* legitimized the registration of trade dress on the Principal Register.¹⁰⁷ Interestingly, *Haig* mentioned nothing about the requirements of non-functionality and secondary meaning that were part of the common law at the time.¹⁰⁸

As a result of the *Haig* opinion, federal courts started accepting trade dress as protectable under the 1946 Trademark Act.¹⁰⁹ For example, in *In re Days-Ease Home Products Corp.*, the court stated that “while a configuration or shape of a container is not registrable for the container, per se, it may be registrable for the particular contents thereof if the shape is non-functional in character, and is, moreover, inherently distinctive or has acquired a secondary meaning as an indication of original for such goods,” which is a direct quote from *Haig*.¹¹⁰ This statement was also adopted by the Trademark Trial and Appeal Board (TTAB) in the seminal case of *In re Morton-Norwich Prod., Inc.*¹¹¹

Throughout this period, trade dress protection shifted from labeling and packaging, to also including containers and wrappers.¹¹² Many, at this point, believed that trade dress filled the gap between copyright and patent protection because the “primary purpose of labels and trade dress [was] to identify merchandise and give directions for use.”¹¹³ Without trade dress protection during this period, many believed that competitors could “copy all details which contribute to beauty, attractiveness, and utility.”¹¹⁴ In short, trade dress allowed a company to have protection for the recognizable features of a product.¹¹⁵ As one commentator states:

Typically, under modern merchandising methods, an originator may have expended large sums for advertising, and managed to establish thereby a substantial market for his product, identified to the consuming public by its familiar trade dress.¹¹⁶

§ 1.05 The Lanham Act Amendments of 1988 and 1999

In 1988, Congress stated that the Lanham Act was in “need of updating and fine tuning to reflect changes in other laws and business practices.”¹¹⁷ Therefore, the Lanham Act was amended to expressly state that trade dress was registrable, and that unregistered trade dress was also protectable.¹¹⁸ The most notable addition was the protection of unregistered trade dress, which had not previously been recognized by statute.¹¹⁹ The amendments made clear that “the words ‘symbol or device’ [should be construed] so as not to preclude the registration of colors, shapes, sounds or configurations where they function as trademarks.”¹²⁰ In adding this language to the Lanham Act, Congress effectively reaffirmed (and expanded on) the *Haig* decision.¹²¹ The Senate Reports state that section 43(a) was revised to include “violations of trade dress and certain non-functional configurations of goods and actionable false advertising claims,” although section 43(a) of the Lanham Act still does not explicitly recite trade dress in its text.¹²²

The term *trade dress* was not explicitly stated in the Lanham Act until 1999, when it was amended to include section 3 of 15 U.S.C. § 1125(a), which states:

In 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.¹²³

It is well understood that this addition did not significantly change the law, but instead reflected what the federal judiciary had believed for decades. However, Congress felt that the addition would promote competition and provide an incentive for registering trade dress.¹²⁴

§ 1.06 The Modern-Day Supreme Court Decisions

In 1991, *Two Pesos v. Taco Cabana* became the first modern trade dress case to proceed to the Supreme Court. More than anything, *Two Pesos* invigorated interest in trade dress, which had waned (at least with regard to litigation in federal court) from the time of the *Haig* decision.

The *Two Pesos* case was concerned with “whether the trade dress of a restaurant may be protected under § 43(a) of the Trademark Act of 1946 (Lanham Act)” without a showing of secondary meaning.¹²⁵ At the district court level, the jury was instructed that “trade dress is the total image of the business.”¹²⁶ Taco Cabana described its trade dress as “a festive eating atmosphere having interior dining and patio areas decorated with artifacts, bright colors, painting and murals.”¹²⁷ Two Pesos opened a restaurant with a similar motif.¹²⁸ The jury found that Taco Cabana had a trade dress that was non-functional and inherently distinctive.¹²⁹ The jury also found that there was a high likelihood of confusion between the Taco Cabana and Two Pesos restaurants.¹³⁰ The Court of Appeals upheld the jury verdict.¹³¹

In affirming the lower courts’ rulings, the Supreme Court first stated that the Lanham Act protects both registered and unregistered marks.¹³² The general rule is that “an identifying mark is distinctive and capable of being protected if it either (1) is inherently distinctive or (2) has acquired distinctiveness through secondary meaning.”¹³³ The Court then acknowledged that section 43(a) of the Lanham Act does not mention trade dress by term, or list a secondary meaning requirement.¹³⁴ Based on this reading, the Court held that a showing of secondary meaning is not required for inherently distinctive trade dress.¹³⁵

In dicta, the Court also noted that requiring secondary meaning for inherently distinctive marks would “undermine the purposes of the Lanham Act.”¹³⁶ The Supreme Court cited to the following statement from the legislative history:

Protection of trade dress, no less than of trademarks, severs the Act’s purpose to ‘secure to the owner of the mark the goodwill of his business and to protect the ability of consumers to distinguish among competing producers.’ National protection of trade marks is desirable, Congress concluded, because trademarks foster competition and the maintenance of quality by securing to the producer the benefits of good reputation.¹³⁷

The Court also expressed concern that requiring secondary meaning would have anticompetitive effects on small companies, by allowing a competitor to adopt their

distinctive trade dress.¹³⁸ Justices Stevens and Thomas concurred, stating that federal courts over the past few decades had transformed the law of trade dress.¹³⁹ Further, Justice Stevens averred that Congress had not specified whether secondary meaning was required under section 43(a) of the Lanham Act, but claimed that Congress had taken steps that suggested that secondary meaning was not required.¹⁴⁰

Shortly after *Two Pesos*, *Qualitex v. Jacobson* was decided. In *Qualitex*, the Supreme Court held that a color was protectable under the Trademark Act. Qualitex used a special shade of green for pads sold to dry cleaning firms.¹⁴¹ Jacobson, a competitor, started to sell pads of virtually the same color.¹⁴² Qualitex then registered the green color as a trademark and sued Jacobson for trademark infringement. At the Appeals level, the court held that the Lanham Act did not allow registration of a trademark only directed to color.¹⁴³

The Supreme Court found that registration of color alone was not barred under the Lanham Act.¹⁴⁴ In reaching this decision, the Supreme Court looked to Section 45, which defines a trademark as “any word, name, symbol, or device, or any combination thereof.”¹⁴⁵ The Court stated that “since human beings might use as a ‘symbol’ or ‘device’ almost anything at all that is capable of carrying meaning, this language, read literally, is not restrictive.”¹⁴⁶ The Court noted the Coca-Cola bottle, NBC’s three chimes, and plumeria blossoms on sewing thread as examples, and posited the following: “If a shape, a sound, and a fragrance can act as symbol why, one might ask, can a color not do the same?”¹⁴⁷ The Court then remarked that the goals of trademark law are to “encourage[] the production of quality products and simultaneously discourage[] those who hope to sell inferior products by capitalizing on a consumer’s inability quickly to evaluate the quality of an item offered for sale.”¹⁴⁸

In response to the defendant’s concern that there are limited colors, and thus trademark protection of a color should not be provided, the Court stated that there are likely to be similar colors available.¹⁴⁹ Further, the Court noted that competitors are protected by the functionality doctrine because the doctrine forbids protection of any feature that is “essential to the use or purpose of the article or affects its cost or quality.”¹⁵⁰ Using this framework, the Court held that Qualitex’s green color acted as a symbol and had developed secondary meaning.¹⁵¹ The Court additionally found that the color served no other purpose than to indicate the origin of the product.¹⁵²

The next trade dress case to go to the Supreme Court after *Qualitex* was *Wal-Mart v. Samara*.¹⁵³ In *Wal-Mart*, the Supreme Court held that proof of secondary meaning was required for unregistered product configuration trade dress, and thus that only product packaging could be inherently distinctive.¹⁵⁴ On the concept of secondary meaning, the *Wal-Mart* decision directly contradicted a portion of the *Two Pesos* decision, and drew a clear line of demarcation between product configuration and product packaging trade dress. The trade dress at issue in *Two Pesos* (restaurant décor) was classified by the Court as product packaging, and the trade dress at issue in *Wal-Mart* (the look of certain children’s clothes) was classified as a product configuration. This dividing line has remained in place since the *Wal-Mart* decision and can often be the cause of much uncertainty in trade dress litigation. As will be discussed in more detail in Chapter 2, the way trade dress is classified can make a big difference between winning and losing your case.

Finally, in 2001, the Supreme Court decided *Traffix Devices v. Marketing Displays*, holding that functionality of a product bars trade dress protection, particularly where that functionality is described in a prior utility patent application for the same

product.¹⁵⁵ There the plaintiff had obtained several utility patents on the “dual-spring design” of certain temporary road signs. The springs were intended to prevent the signs from blowing over when faced with strong gusts of wind.¹⁵⁶ The Supreme Court held that the existence of expired utility patents describing the “dual-spring design” was “strong evidence” of the functionality of the claimed trade dress, which the plaintiff could not overcome.¹⁵⁷

Trade dress has evolved significantly over the years, from the early common law, through *Haig* and the original Lanham Act, and finally to the current Lanham Act and Supreme Court cases like *Two Pesos* and *Traffix*. Today, trade dress refers to “the overall appearance and image in the marketplace of a product or commercial enterprise” and is afforded federal protection similar to that of trademarks.¹⁵⁸ While some (such as Professor Lunney) might argue that *Haig* improperly accorded federal protection to trade dress, it now a well-accepted legal principle. Put simply, trade dress is here to stay, and the better understanding one has of its ins and outs, the better one can understand where trade dress is ultimately headed.

Notes

¹ EAGAN, TRADE DRESS PROTECTION § 1.5; Willajeanne F. McLean, *Opening Another Can of Worms: Protecting Product Configuration as Trade Dress*, 66 U. CIN. L. REV. 119, 121 (1997–98).

² J. THOMAS MCCARTHY, 1 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 8.1 (4th ed. 2004) (citing RESTATEMENT (THIRD) UNFAIR COMPETITION § 16).

³ Lars Smith, *Trade Distinctiveness: Solving Scalia’s Tertium Quid Trade Dress Conundrum*, 2005 MICH. ST. L. REV. 243, 251–52 (2005).

⁴ Smith, *supra* note 3, at 246. *See, e.g.*, *Hartford House, Ltd. v. Hallmark Cards, Inc.*, 6 U.S.P.Q.2d 2038, 2040 (10th Cir. 1988) (stating that trade dress once protected only packaging and now protects the appearance of a product) (citing *Brunswick Corp. v. Spinit Reel Co.*, 832 F.2d 513, 517 (10th Cir. 1987)).

⁵ Smith, *supra* note 3, at 252.

⁶ *Id.*

⁷ *Id.*

⁸ Jeff Resnick, *Trade Dress Law: The Conflicts Between Product Design and Product Packaging*, 24 WHITTIER L. REV. 253, 257 (2002).

⁹ *Id.*

¹⁰ *Id.* at 258.

¹¹ *Id.* (citing *Yale Elec. Corp. v. Robertson*, 26 F.2d 972, 973 (2d Cir. 1928)).

¹² *Id.* at 246.

¹³ *Id.* at 246 nn.17, 18.

¹⁴ *Sinko v. Snow-Craggs Corp.*, 42 U.S.P.Q. 298, 299 (7th Cir. 1939).

¹⁵ *Id.* at 300.

¹⁶ *Id.*

¹⁷ MCCARTHY, *supra* note 2, at § 5.3.

¹⁸ *Id.*

¹⁹ *Id.*

²⁰ *Id.* Commerce power refers to those powers provided to Congress in article 1, section 8, clause 3, which states that Congress has the power to “regulate commerce with foreign nations, and among the several states, and with the Indian Tribes.”

²¹ *Id.*

²² *Id.* Article I, section 8, clause 8 of the Constitution states that Congress has the power “to promote the progress of science and the useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries.”

²³ *Id.*

²⁴ *Id.*

²⁵ Matthew Formeller, *Trade Dress Protection for Web Sites: Is It Time for the Law to Overtake Theory?*, 18 DEPAUL J. ART TECH. & INTELL. PROP. L. 157, 161 (2007).

²⁶ *Coats v. Merrick Thread Co.*, 149 U.S. 562 (1892).

²⁷ *Id.* at 567.

²⁸ *Id.*

²⁹ *Id.*

³⁰ *Id.* at 568.

³¹ *Id.*

³² *Id.* at 567–68.

³³ *Id.* at 567.

³⁴ *Id.* at 568.

³⁵ *Id.* at 569.

³⁶ *Id.* at 569, 73.

³⁷ *Id.*

³⁸ *Id.* at 572–73.

³⁹ *Id.* at 572–73.

⁴⁰ MCCARTHY, *supra* note 2, at § 5.3.

⁴¹ *Id.* (citing *American Steel Foundries v. Roberston*, 269 U.S. 372 (1926)).

⁴² *Id.* (citing *Thaddeus Davids Co. v. Davids Mfg. Co.*, 233 U.S. 461 (1914)).

⁴³ *Kellogg Co. v. Nat’l Biscuit Co.*, 305 U.S. 111 (1938).

⁴⁴ *Id.* at 120–21.

⁴⁵ *Id.* at 121.

⁴⁶ *Id.* at 120.

⁴⁷ *Id.* at 122; MCCARTHY, *supra* note 2, at § 6.11.

⁴⁸ *See, e.g.*, *In re Mogen David Wine Corp.*, 372 F.2d 539 (C.C.P.A. 1967); *Kohler Co. v. Moen Inc.*, 12 F.3d 632 (7th Cir. 1993).

⁴⁹ *Centaur Co. v. Marshall*, 97 F. 785 (8th Cir. 1899).

⁵⁰ *Id.* at 786.

⁵¹ *Id.*

⁵² *Id.*

⁵³ *Id.* at 788.

⁵⁴ *Id.* at 789.

⁵⁵ *Id.*

⁵⁶ *Id.*

⁵⁷ *Id.* at 789–90.

⁵⁸ *Id.*

⁵⁹ *Elizabeth Arden, Inc. v. Frances Denney, Inc.*, 39 U.S.Q.P. 86, 86 (3d Cir. 1938).

⁶⁰ *Id.*

- ⁶¹ *Id.* at 87.
- ⁶² *Id.*
- ⁶³ E. Kahn's Sons Co. v. Columbus Packing Co., 29 U.S.P.Q. 257, 257 (6th Cir. 1936).
- ⁶⁴ *Id.* at 259–60.
- ⁶⁵ Rymer v. Rymer, 21 U.S.P.Q. 300 (6th Cir. 1934).
- ⁶⁶ *Id.* at 301–2.
- ⁶⁷ *Id.* at 301–2.
- ⁶⁸ *Id.* at 301.
- ⁶⁹ *Id.*
- ⁷⁰ *Id.*
- ⁷¹ *Id.* at 301–2.
- ⁷² *Id.* at 303.
- ⁷³ Ressinger v. Sears, Roebuck & Co., 66 U.S.P.Q. 18, 19 (ED Ill. 1945).
- ⁷⁴ Erickson v. Emerson, 61 U.S.P.Q. 42, 50 (D. Mass. 1944).
- ⁷⁵ *Id.* at 19.
- ⁷⁶ George Benjamin, *Is Design and Construction "Piracy" Unfair Competition?*, 23 PAT. OFF. Soc'y 862, 866 (1941) (stating that Sinko v. Snow Craggs Corp. was one of the leading modern U.S. decisions for unfair competition).
- ⁷⁷ Sinko, 42 U.S.P.Q. at 299.
- ⁷⁸ *Id.*
- ⁷⁹ *Id.* at 300.
- ⁸⁰ *Id.*
- ⁸¹ *Id.*
- ⁸² *Id.*
- ⁸³ *Id.*
- ⁸⁴ *Id.*
- ⁸⁵ *Id.*
- ⁸⁶ *Id.* at 301.
- ⁸⁷ *Id.*
- ⁸⁸ *Id.*
- ⁸⁹ Formeller, *supra* note 25, at 163.
- ⁹⁰ *Id.*
- ⁹¹ Resnick, *supra* note 8, at 258.
- ⁹² *Id.* at 259.
- ⁹³ *Id.*
- ⁹⁴ Michael S. Perez, *Reconciling the Patent Act and the Lanham Act: Should Product Configurations Be Entitled to Trade Dress Protection After the Expiration of a Utility or Design Patent?*, 4 TEX. INTELL. PROP. L. J. 383, 385 (1995–96) (citing S. Rep. No. 1333, 79th Cong. 2d Sess. 3 (1946), reprinted in 1946 U.S. CODE CONG. SERV. 1274, 1274).
- ⁹⁵ 15 U.S.C. § 1052.
- ⁹⁶ Smith, *supra* note 3, at 246.
- ⁹⁷ Ex parte Haig & Haig, Ltd., 118 U.S.P.Q. 229 (Dec. Comm'r Pat. 1958); Glynn S. Lunney, *The Trade Dress Emperor's New Clothes: Why Trade Dress Does Not Belong on the Principal Register*, 51 HASTINGS L.J. 1131, 1137–38 (2000).

⁹⁸ Haig, 118 U.S.P.Q. at 229.

⁹⁹ *Id.* at 230.

¹⁰⁰ Lunney, *supra* note 97, at 1138. Section 45 of the Act defines a trademark as “any word, name symbol, or device or any combination thereof adopted and used by a manufacturer or merchant to identify his goods and distinguish them from those manufactured or sold by others.” Lunney believes that symbol and device referred to “the common law’s definition of a technical trademark,” which had a specific meaning under the 1905 Trademark Act, which prohibited protection of “descriptive words and trade dress.” *Id.* at 1138, 40. The descriptive words or trade dress were protectable under unfair competition law. *Id.* at 1140. Further, Lunney indicates that Congress intentionally omitted the language of “label, package, configuration of goods” from the definition of the trademarks registrable on the principal register and included these terms in other areas of the Act. *Id.* at 1139 (citing *Keene Corp. v. United States*, 508 U.S. 200, 208 (1993)). Such omission is generally seen as an intentional act. *Id.*

¹⁰¹ *Id.* at 230–31.

¹⁰² See U.S. Reg. No. 696,147 (Filed March 19, 1959; Registered April 12, 1960).

¹⁰³ Lunney, *supra* note 97, at 1138.

¹⁰⁴ *Id.* at 1134.

¹⁰⁵ *Id.* at 1138, 1140.

¹⁰⁶ *Id.* at 1139 (citing *Keene Corp. v. United States*, 508 U.S. 200, 208 (1993)).

¹⁰⁷ *Id.*

¹⁰⁸ *Id.*

¹⁰⁹ Smith, *supra* note 3, at 247. See also McLean, *supra* note 1, at 122 (stating that “although not mentioned in the original version of the Lanham Act, trade dress is protected under its § 43(a), which protects unregistered marks and symbols from imitation.”).

¹¹⁰ In re Days-Ease Home Products Corp., 197 U.S.P.Q. 566, 567–68 (T.T.A.B. 1977) (citing Ex parte Haig & Haig). See also *Aromatique Inc. v. Gold Seal Inc.*, 31 U.S.P.Q.2d 1482, 1481 (8th Cir. 1994) (listing Ex parte Haig & Haig as holding that a Scotch whiskey Haig Pinch Bottle is a protectable mark); In re Owens-Corning Fiberglas Corp., 227 U.S.P.Q. 417, 418–19 (Fed. Cir. 1985) (listing Ex parte Haig & Haig as allowing protection of containers).

¹¹¹ In re Morton-Norwich Prod., Inc., 209 U.S.P.Q. 437, 439 (T.T.A.B. 1980) (citing generally Ex parte Haig & Haig).

¹¹² *Ciro Gamboni, Unfair Competition Protection after Sears and Compco*, 55 TRADE-MARK REP. 964, 975 (1965), 15 COPYRIGHT L. SYM. (ASCAP) 1 (1967).

¹¹³ *Id.*

¹¹⁴ *Id.* at 16.

¹¹⁵ *Id.*

¹¹⁶ *Id.*

¹¹⁷ Senate Report No. 100-515.

¹¹⁸ “In 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.” 15 U.S.C. § 1125.

¹¹⁹ Resnick, *supra* note 8, at 259.

¹²⁰ Lunney, *supra* note 97, at 1185 n.199.

¹²¹ Smith, *supra* note 3, at 253–54.

¹²² Senate Report No. 100-515, VI. Section-by-Section Analysis, section 3.

¹²³ 15 U.S.C. § 1125(a) (3).

- ¹²⁴ Hearing Transcript on HR1565 Before the Congressional Subcommittee on Courts and Intellectual Property, 106th Congress, May 5, 1999.
- ¹²⁵ *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 763, 765 (1991).
- ¹²⁶ *Id.* at 764 n.1.
- ¹²⁷ *Id.*
- ¹²⁸ *Id.*
- ¹²⁹ *Id.* at 766.
- ¹³⁰ *Id.*
- ¹³¹ *Id.* at 767.
- ¹³² *Id.* at 767–68.
- ¹³³ *Id.* at 769.
- ¹³⁴ *Id.* at 774.
- ¹³⁵ *Id.*
- ¹³⁶ *Id.*
- ¹³⁷ *Id.*
- ¹³⁸ *Id.* at 775, 786.
- ¹³⁹ *Id.* at 776.
- ¹⁴⁰ *Id.* at 783.
- ¹⁴¹ *Qualitex Co. v. Jacobson Prod. Co., Inc.*, 514 U.S. 160, 161 (1994).
- ¹⁴² *Id.*
- ¹⁴³ *Id.*
- ¹⁴⁴ *Id.* at 162.
- ¹⁴⁵ *Id.*
- ¹⁴⁶ *Id.*
- ¹⁴⁷ *Id.*
- ¹⁴⁸ *Id.* at 164.
- ¹⁴⁹ *Id.* at 168.
- ¹⁵⁰ *Id.* at 169.
- ¹⁵¹ *Id.* at 166.
- ¹⁵² *Id.*
- ¹⁵³ *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205 (2000).
- ¹⁵⁴ *Wal-Mart*, 529 U.S. at 216; Smith, *supra* note 3, at 248.
- ¹⁵⁵ *Traffix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23 (2001); MCCARTHY, *supra* note 2, at § 8.8.
- ¹⁵⁶ *Traffix Devices*, 532 U.S. at 25.
- ¹⁵⁷ *Id.* at 29–30.
- ¹⁵⁸ Smith, *supra* note 3, at 252 n.46 (citing Black’s Law Dictionary 1530 (8th ed. 2004)); McLean, *supra* note 1, at 123.