

When most people think of trademarks, words or logos come to mind. However, trademark subject matter is a much more expansive concept. Many other types of “things” (often simply called “devices” for lack of a better term) are trademarks, many of them registered with the USPTO. Some of these other things/devices are sounds, motion marks, and single colors (e.g. brown is a trademark of UPS). These are all discreet branding devices, easily defined, and categorized. Apart from these classes of trademarks (i.e words, sounds, logos, scents, colors, etc.) there are many other types of trademarks broadly referred to as “trade dress”. Interestingly, as much attention that trade dress gets in legal circles, including case law, the term is not defined anywhere in the Lanham Act. Trade dress is based on the word “device” in the Lanham Act but has primarily been defined and expanded in scope by judicial decisions over many years.

Although trade dress is often defined as the total look or appearance of a product, that definition is not very accurate. Trade dress is better defined as anything – other than words or logos – capable of receiving trademark protection under the Lanham Act and, therefore, also capable of registration under certain conditions. While this would include the things mentioned above, like color, sound, motion marks and scents, it also includes more “complex” things like product design (shape, surface design, and other appearance aspects), individual features or combinations of features of a product, product packaging (including its shape and/or its graphic design), building designs (interior and exterior) used for retail establishments, “service dress” (e.g. the design of a passenger vehicle for airport parking services), and other things that are not easily described

(e.g. a parade of ducks that takes place every day at a certain hotel chain).

It's best not to try to categorize trade dress at all but instead to think about trademarks in general to be words, logos or everything else. The latter category contains all kinds of trade identity "devices" that are often difficult to categorize (how would one categorize the yellow border trademark that is owned by National Geographic and used on their magazines?...is it a trademark, logo, packaging, product design (probably not)?). The only consideration that a court must make is whether trade dress is product design because of the stricter rule that applies (as mentioned above).

Trademark applicants will often try to convince the USPTO that their mark is not product design. For example, in a case involving a pocket "design" that comprised a flap that revealed the wearer's...um...skin..the TTAB held that this was product design despite the applicant's attempt to have it categorized as a trademark (because it was a somewhat discreet, isolated feature of a product as opposed to "overall design"). That did not matter according to the TTAB. In general courts will err on the side of classifying something as product design when there is doubt (because this is what the Supreme Court mandated in a leading case on the subject).

In terms of the rules that control what trade dress may and may not be registered, various relatively recent court decisions, several from the Supreme Court, have greatly simplified the way to analyze trade dress for registration purposes. In short, trade dress is first classified as either product design or everything else. If the trade dress is product design, then in all cases "secondary meaning" is required (secondary meaning is covered in an earlier posting, but essentially means evidence that

consumers do in fact perceive the design in question as a trademark and not merely the design of a product). The product design also must not be functional. The burden of proof is on the applicant to show that its product design is not functional and has secondary meaning.

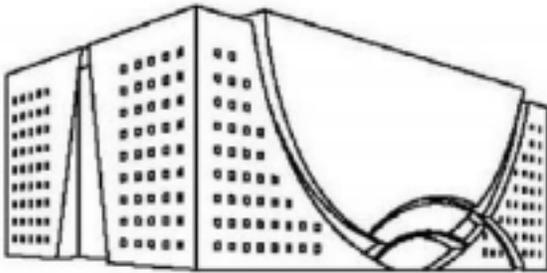
For all other categories of trade dress, in order to be capable of registration the trade dress must be inherently distinctive. The test is the so-called Seabrook test, as follows:

In determining whether a design is inherently distinctive, the following factors are considered:

- Whether the subject matter sought to be registered is a “common” basic shape or design;
- Whether the subject matter sought to be registered is unique or unusual in a particular field;
- Whether the subject matter sought to be registered is a mere refinement of a commonly-adopted and well-known form or ornamentation for a particular class of goods or services viewed by the public as a dress or ornamentation for the goods; and Whether the subject matter sought to be registered is capable of creating a commercial impression distinct from the accompanying words.

Interestingly, the burden is on the USPTO to make a prima facie case of non-distinctiveness. The question of inherent distinctiveness rests on whether the public in the relevant market would view the design as a source identifier for applicant's product or service. The burden on the USPTO examining attorney, in meeting a prima facie case, is to establish a "reasonable predicate" for the position that the subject matter is not inherently distinctive.

An illustration of how this may play out in an actual case is the recent attempt by The Furniture Mart to register the following building design as trade dress:



The TTAB ruled in favor of The Furniture Mart, holding that the USPTO did not provide any evidence that the design did NOT meet the Seabrook test: "At the outset it needs to be pointed out that the examining attorney did not submit a single piece of evidence in support of her position that the proposed mark is not inherently distinctive. In applying the Seabrook test for inherent distinctiveness, the examining attorney's mere argument, without any supporting evidence, fails to make out a prima facie case that consumers would not perceive and rely on the building design at issue as

an indication of source for applicant's services. Specifically, the record is devoid of any evidence to show that the subject matter sought to be registered is a common design, that the building design is not an unusual one, that the design is simply a refinement of a well-known design or ornamentation, or that the proposed mark fails to function as a mark without the accompanying words "World Market Center.""

This is good news for anyone wanting to register trade dress. Except for product designs, most trade dress that has some degree of uniqueness is certainly capable of registration. The burden of proof favors the applicant, and that is good news for those wanting to protect their trade dress.