

Trade Dress: What It Is and How to Protect It¹

September 8, 2021

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I. Trade Dress Is Either a Trademark or Service Mark.

“Trade dress” functions as either a trademark or service mark. A “trademark” is any word, term, phase, symbol, logo, design, shape, tag line, background, color, scent, sound, device, or combination thereof, which distinguishes the goods (i.e., products) of one supplier from those of other suppliers. See 15 U.S.C. §1127; *Qualitex Co. v. Jacobson Prod. Co.*, 514 U.S. 159, 162 (1995) (the statutory language describes what can qualify as trademarks “in the broadest of terms”). A “service mark” is the same as a trademark, but distinguishes services instead of goods.² *Id.*

The term “trade dress” was coined in a 1992 case referring to the way a product is “dressed up” to go to market. *Jeffrey Milstein, Inc. v. Greger, Lawlor, Roth, Inc.*, 58 F.3d 27, 31 (2d Cir. 1992). Trade dress is sometimes defined as the “total image” or “overall appearance” of a product, packaging, or service, and “may include features such as size, shape, color or color combinations, texture, graphics, sounds, scents, flavors, or even certain sales techniques.” *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 764 n.1 (1992); *John J. Harland Co. v. Clarke Checks, Inc.*, 711 F.2d 966, 980 (11th Cir. 1983); *Rose Art Industries, Inc. v. Raymond Geddes & Co.*, 31 F. Supp.2d 367, 372 (D.N.J. 1998); *Qualitex*, 514 U.S. at 162 (“[A]lmost anything at all that is capable of carrying meaning” may be used as a “symbol” or “device” and constitute trade dress that identifies the source or origin of a product. Protection may extend to a single feature or a combination of features in a trade dress.); *Vorando Air Circulation Sys., Inc. v. Duracraft Corp.*, 58 F.3d 1498, 1502 (10th Cir. 1995).

A. Examples of Trade Dress as a Trademark.

Following are examples of trade dress that functions as a trademark: (1) the Coca-Cola® bottle shape; (2) the Haig & Haig® scotch bottle shape; (3) the color of pill capsules; (4) the shape of pill capsules; (5) the body style of the Ferrari® Daytona Spyder; (6) golf club designs; (7) desk lamp designs; (8) pink fiberglass insulation; (9) green and gold dry-cleaning press pads; (10) book cover designs; (11) Louboutin® red-soled shoes; (12) the Maker’s Mark® whiskey bottle with “dripping” plastic top; (13) Reese’s® Peanut Butter Cup packaging; (14) Mogen David® wine bottle; (15) Converse® sneaker appearance; (16) the Samsung® Galaxy phone design; (17) the Apple® iPhone design; (18) handbag designs; (19) brief case designs; (20) Reynold’s Wrap® packaging; (21) the Fender® guitar shape; (22) Klondike® bar packaging; (23) sneaker tread patterns; (24) Winnebago® trailer design; (25) Crocs® shoe designs; (26) silverware designs; (27) greeting cards; (28) the Kodak® red and yellow box; (29) peppermint scent for office supplies; (30) the colors gold and black for tie-down straps; and (31) magazine covers.

B. Examples of Trade Dress as a Service Mark.

Following are examples of trade dress that functions as a service mark: (1) the décor of a Mexican Restaurant; (2) trade show layout and style; (3) the NBC® three-tone chime; (4) printed

¹ This article is for educational purposes and does not constitute legal advice. It represents current, general opinions of the author, and not of his law firm or colleagues.

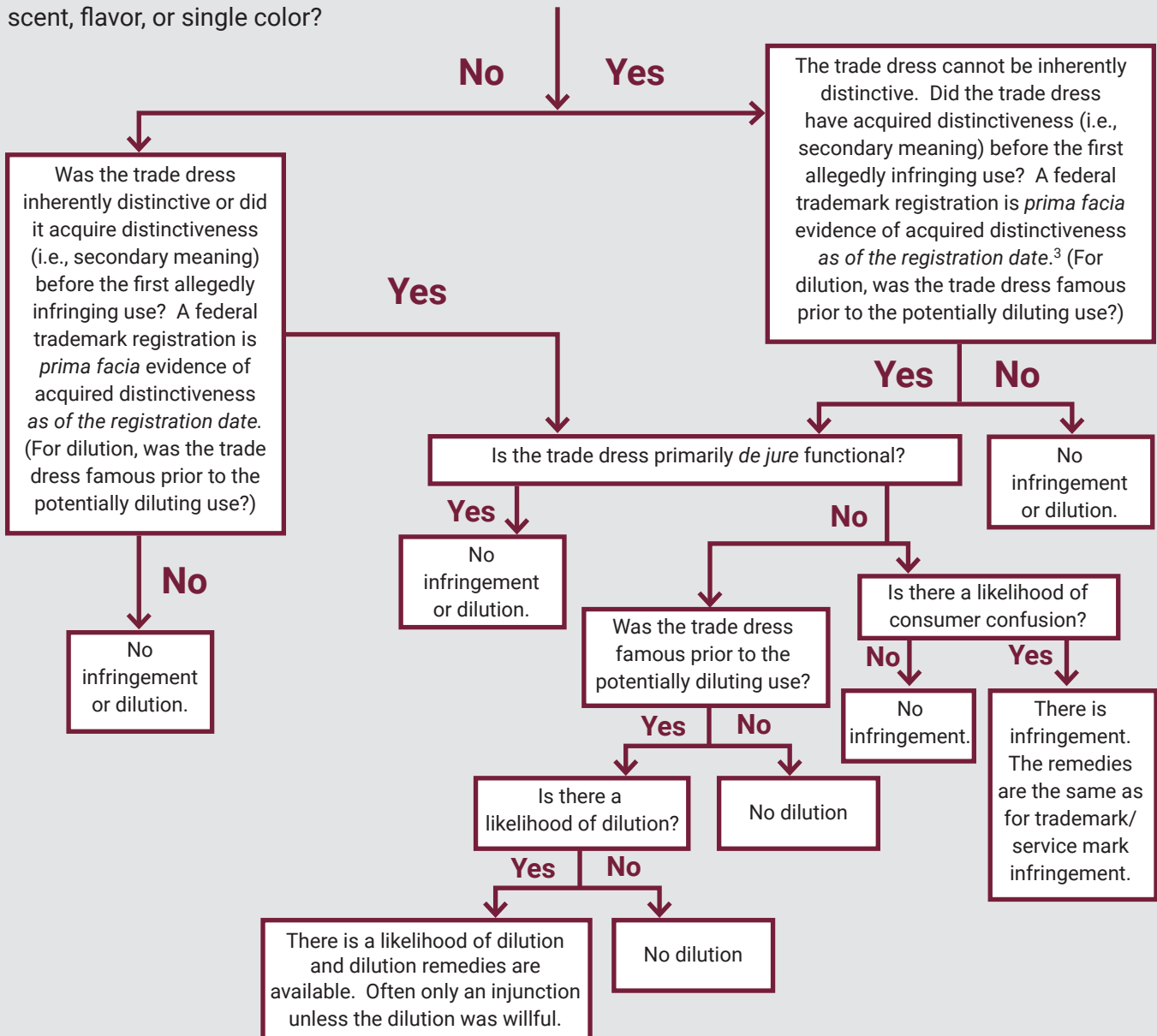
² Unless indicated otherwise, the term “trademark” means trademark and service mark.

marketing materials; (5) the Mobile® gas pump design; (6) golf course designs; (7) the IHOP® restaurant exterior design; (8) the McDonald's® restaurant exterior design; (9) website designs (sometimes referred to as "look and feel"); (10) rose oil scent for advertising and marketing services; (11) method of displaying wine; and (12) attributes of a Beatles tribute band.

II. Trade Dress Infringement and Dilution Flowchart.

The chart below outlines the factors necessary to prove trade dress infringement or dilution. These factors are explained in greater detail herein.

Is the trade dress (1) part of a product, such as clothing, shoes, lawn mower, or tractor, or (2) a scent, flavor, or single color?



³ *Converse, Inc. v. Int'l Trade Comm'n Skechers U.S.A., Inc.*, 909 F.3d 1110, 1117-18 (Fed. Cir. 2018) (the presumption of secondary meaning accompanying a USPTO registration operates prospectively from the date of registration).

III. Trade Dress Must Be Inherently Distinctive or Have Acquired Distinctiveness.

Trade dress must be either inherently distinctive or have acquired distinctiveness (also called secondary meaning) to be protected. When an overall trade dress is distinctive, the fact that it also includes descriptive (or generic) elements does not render it unprotectable. *Computer Care v. Service Systems Enterprises, Inc.*, 982 F.2d 1063 (7th Cir. 1992).

A. Inherent Distinctiveness.

If a trade dress is inherently distinctive it is protectable without a showing of acquired distinctiveness. *Two Pesos*, 505 U.S. at 775. As with other trademarks, the inherent distinctiveness of a trade dress is categorized along the generic-descriptive-suggestive-arbitrary-fanciful spectrum. *Id.* at 768; *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976). The latter three: suggestive; arbitrary; and fanciful, are always considered inherently distinctive because “their intrinsic nature serves to identify a particular source....” *Two Pesos*, 505 U.S. at 768.

In *Seabrook Foods, Inc. v. Bar-Well Foods Ltd.* a three-part test was developed to determine inherent distinctiveness, and asks whether the trade dress is a: (1) “‘common’ basic shape or design”; (2) “unique or unusual in a particular field”; or (3) “mere refinement of a commonly-adopted and well-known form of ornamentation for a particular class of goods viewed by the public as a dress or ornamentation for the goods.” 568 F.2d 1342, 1344 (C.C.P.A. 1977). An example of applying this test is in *AmBrit, Inc. v. Kraft, Inc.*, in which trade dress infringement of the Klondike bar wrapper was asserted. 812 F.2d 1531 (11th Cir. 1986). The wrapper included “pebbled foil featuring the colors silver, blue and white” and had “a 3 x 3 inch panel of silver, white, and blue, the words ‘Islay’s’ and ‘Klondike’ and the figure of a polar bear.” *Id.* at 1533-34. Applying the three *Seabrook* factors the court found that “[t]he overall appearance of the Klondike trade dress and of its constituent elements is arbitrary or suggestive. The trade dress does not describe the ice cream product, rather it suggests to the consumer the coldness of the product. Such trade dress is inherently distinctive under Section 43(a).” *Id.* at 1531, 1536-37.

B. Acquired Distinctiveness.

Acquired distinctiveness is shown by evidence that a substantial segment of relevant consumers associates the trade dress only with a particular product or service. *Levi Strauss & Co. v. Blue Bell, Inc.*, 778 F.2d 1352, 1358 (9th Cir. 1985). Some factors that may be considered to determine acquired distinctiveness are: (a) a period of continuous and substantially exclusive use; (b) testimony of third parties; (c) survey evidence; (d) intentional copying by others; (e) type and amount of sales, promotions, and advertising using the trade dress; (f) number of customers exposed to the trade dress; and (g) unsolicited media coverage of the product or service embodying the trade dress. *Id.*; *Sally Beauty Co. v. Beautyco, Inc.*, 304 F.3d 964, 977 (10th Cir. 2002).

C. Trade Dress for a Product Design, Single Color, Scent, or Flavor Must Have Acquired Distinctiveness.

Trade dress that is part of a product (as opposed to packaging⁴), such as clothing, shoes, a lawn mower, or a tractor; or for a single color, a scent, or a flavor, cannot be inherently distinctive

⁴ When it is difficult to determine whether a proposed trade dress is packaging versus a product design, the trade dress is treated as a product design. *Id.*

and can only be protected upon proof of acquired distinctiveness. *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 206, 214-15 (2000) (product designs can never be inherently distinctive but distinctiveness may be acquired); *Qualitex*, 514 U.S. at 159-160 (a single color can be protected upon a showing of acquired distinctiveness); *In re N.V. Organon*, 79 U.S.P.Q.2d 1639, 1649 (T.T.A.B. 2006) (flavor is analogous to product design and may be protected upon a showing of acquired distinctiveness unless it is functional); *In re Clark*, 17 U.S.P.Q.2d 1238, 1239 (T.T.A.B. 1990); *Pohl-Boskamp GmbH & Co. KG*, 106 U.S.P.Q.2d 1042, 1049 (T.T.A.B. 2013) (a substantial showing of acquired distinctiveness is required to protect a fragrance or flavor); *Duraco*, 40 F.3d 1431, 1434 (3d Cir. 1994); *but see* TMEP §1202.13 (it is unclear how a flavor could function as a source indicator because it is utilitarian and consumers generally have no access to a product flavor prior to purchase.)

D. Examples of Trade Dress Decisions Concerning Inherent Distinctiveness or Acquired Distinctiveness.

1. Inherent Distinctiveness.

Fuddruckers, Inc. v. Doc's B.R. Others, Inc., 826 F.2d 837, 843 (9th Cir. 1987) (restaurant décor inherently distinctive); *Two Pesos*, 505 U.S. at 773-74 (1992) (same – restaurant interior is akin to product packaging); *In re Chippendales USA, Inc.*, 622 F.3d 1346, 1351 (Fed. Cir. 2010) (an abbreviated tuxedo costume consisting of wrist cuffs and a bowtie collar without a shirt “constitute[d] ‘trade dress’ because it [was] part of the ‘packaging’” for exotic dancing services); *In re Chevron Intell. Prop. Grp. LLC*, 96 U.S.P.Q.2d 2026, 2029 (T.T.A.B. 2010) (“‘three-dimensional, six-sided beveled shape’ [pole spanner design used to promote services] is a mere refinement of a commonly used form of a gasoline pump ornamentation rather than an inherently distinctive service mark for automobile service station services.”); *In re Brouwerij Bosteels*, 96 U.S.P.Q.2d 1414, 1421-22 (T.T.A.B. 2010) (product packaging trade dress in the nature of a beer glass and stand with wording and scrollwork would be perceived as a mere refinement of a commonly-known glass and stand rather than an inherently distinctive indicator of source for the goods); *In re File*, 48 U.S.P.Q.2d 1363, 1367 (T.T.A.B. 1998) (novel tubular lights used in connection with bowling alley services would be perceived by customers as “simply a refinement of the commonplace decorative or ornamental lighting . . . and would not be inherently regarded as a source indicator.”); *In re J. Kinderman & Sons, Inc.*, 46 U.S.P.Q.2d 1253, 1255 (T.T.A.B. 1998) (“while the designs [of packaging for electric lights for Christmas trees] applicant seeks to register may be unique in the sense that we have no evidence that anyone else is using designs which are identical to them, they are nonetheless not inherently distinctive.”); *In re Hudson News Co.*, 39 U.S.P.Q.2d 1915, 1923 (T.T.A.B. 1996), *aff’d per curiam*, 114 F.3d 1207 (Fed. Cir. 1997) (“[f]or the ‘blue motif’ of a retail store to be registrable on the Principal Register without resort to Section 2(f), the trade dress would have to be immediately recognizable as a distinctive way of identifying the source of the store services.”); *In re Mars, Inc.*, 105 U.S.P.Q.2d 1859, 1869-71 (T.T.A.B. 2013) (packaging configuration for pet food, resembling many cans used in the pet food field, is a common basic shape, even though it was inverted, and a mere refinement of existing trade dress within the field); *Yankee Candle Co. v. Bridgewater Candle Co., LLC*, 259 F.3d 25, 42-45 (1st Cir. 2001) (trade dress for common elements of candle labels was nondistinctive product packaging for which insufficient evidence of acquired distinctiveness had been shown); *In re Creative Beauty Innovations, Inc.*, 56 U.S.P.Q.2d 1203, 1208 (T.T.A.B. 2000) (bottle configuration found inherently distinctive); *In re Fre-Mar Indus., Inc.*, 158 U.S.P.Q. 364, 367 (T.T.A.B. 1968) (“[A]lthough the particular shape is a commonplace one for flashlights, it is nevertheless so unique and arbitrary as a container in the tire repair field that it may be inherently distinctive....”); *In re Int’l Playtex Corp.*, 153 U.S.P.Q. 377, 378 (T.T.A.B. 1967) (container configuration having the appearance

of an ice cream cone inherently distinctive for baby pants); *Best Cellars Inc. v. Grape Finds at Dupont, Inc.*, 90 F. Supp. 2d 431 (S.D.N.Y. 2000) (method of displaying wine was inherently distinctive).

2. Acquired Distinctiveness.

Walmart, 529 U.S. at 215 (clothing design can only be protected upon a showing of secondary meaning); *Qualitex*, 514 U.S. at 163 (color of dry cleaning press pads protectable upon showing of secondary meaning); *Reader's Digest Ass'n v. Conservative Digest*, 821 F.2d 800, 804 (D.C. Cir. 1987) (magazine cover had acquired distinctiveness and was protectable); *In re Owens-Corning Fiberglass Corp.*, 774 F.2d 1116 1127-28 (Fed. Cir. 1985) (pink color for fiberglass insulation protectable based on secondary meaning); *Pohl-Boskamp*, 106 U.S.P.Q.2d at 1049 (a substantial showing of acquired distinctiveness is required to protect a fragrance or flavor).

IV. Trade Dress Cannot be Primarily De Jure Functional.

If a trade dress is primarily *de jure* functional, which includes operable functionality and aesthetic functionality, it cannot be protected even if it is distinctive, and even if there is confusion between the parties' respective products/services. *American Greetings Corp. v. Dan-Dee Imports, Inc.*, 807 F.2d 1136, 1141 (3d Cir. 1986).

A. Operable Functionality.

Operable (or utilitarian) functionality relates to how a product works. An operable functional feature is one that "is essential to the use or purpose of the article or [that] affects the cost or quality of the article," and one that competitors must use to fairly compete. See *Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 1531 (Fed. Cir. 1994) (the policies underlying the functional limitation on trademark protection explicitly invoke an inquiry into competitive fairness). If exclusive use of the feature would put competitors at a significant non-reputation related disadvantage, the feature or collection of features is operable functional. *Qualitex*, 514 U.S. at 165 (citing *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844, 850-51 (1982)).

Some factors considered in assessing operable functionality are: (1) an active or expired utility patent disclosing the utilitarian advantages of the design; (2) an active or expired design patent covering the design; (3) advertising which touts the utilitarian advantages of the design; (4) the availability and costs of functionally equivalent designs; and (5) facts indicating that the design results in a comparatively simple or cheap method of manufacturing the product. *In re Morton-Norwich Products, Inc.*, 671 F.2d 1332, 1340-1341 (C.C.P.A. 1982); *Valu Engineering Inc. v. Rexnord Corp.*, 278 F.3d 1268, 1274 (Fed. Cir. 2002); *In re Vico Products Mfg. Co.*, 229 U.S.P.Q. 364, 365-67 (T.T.A.B. 1985) (whirlpool jet design primarily dictated by functional considerations); *Best Lock Corp. v. Schlage Lock Co.*, 413 F.2d 1195, 1199 (C.C.P.A. 1969) (claims of expired utility patent established functionality of figure eight lock configuration); *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 29 (2001) (expired utility patents for dual-spring design established that the alleged trade dress was functional).

B. Aesthetic Functionality.

Aesthetic functionality relates to non-utilitarian aspect(s) of a product's appearance that is not related to source indication, but instead related to the appearance being desirable. *British Seagull, Ltd. v. Brunswick Corp.*, 35 F.3d 1527, 1533 (Fed. Cir. 1994) (color black for boat engines is functional although it has no effect on either the cost of making the motors, or their quality, but it is compatible

with many boats' color schemes, and black makes the motors look smaller); *Wallace Int'l Silversmiths, Inc. v. Godinger Silver Art Co., Inc.*, 916 F.2d 76, 80 (2d Cir. 1990); *M-5 Steel Mfg., Inc. v. O'Hagin's Inc.*, 61 U.S.P.Q.2d 1086, 1096 (T.T.A.B. 2001) (metal ventilating ducts and vents that match the appearance of surrounding roof tiles are more pleasing in appearance and are aesthetically functional); *Inwood Labs*, 456 U.S. at 851 n.11 (blue and blue-red capsule colors were functional); *In re American National Can Co.*, 41 U.S.P.Q.2d 1841 (T.T.A.B. 1997) (registration refusal upheld for fluted beverage container that was aesthetically functional); *Deere & Co. v. Farmhand, Inc.*, 560 F. Supp. 85 (S.D. Iowa 1982) (The color green for farm equipment was desired because farmers prefer equipment having the same color), *aff'd*, 721 F.2d 253 (8th Cir. 1983); *In re Howard S. Leight and Associates, Inc.*, 39 U.S.P.Q.2d 1058, 1060 (T.T.A.B. 1996) (bright coral-colored ear plugs were functional because they are more readily visible).

Examples of trade dress that were found not to be aesthetically functional include a green and yellow color scheme for farm equipment and red shoe soles. *Deere & Co. v. FIMCO Inc.*, 302 F. Supp. 3d 837, 880 (W.D. Ky. 2017), *superseded in part*, 301 F. Supp. 3d 704 (W.D. Ky. 2018) (green and yellow color scheme for farm equipment was protectable); *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holdings, Inc.*, 696 F.3d 206, 218 (2d Cir. 2012) (lower court finding that the red sole of a shoe was aesthetically functional was reversed on appeal (except for shoes also having red uppers)).

V. Registering Trade Dress in the USPTO.

A federal trademark registration is *prima facie* evidence of the validity, ownership of, and exclusive right to use a registered trade dress. 15 U.S.C. §1057(b). A federal registration shifts the burden of proof on non-functionality and validity of the trade dress to the defendant. *Id.*; *Au-Tomotive Gold v. Volkswagen of Am.*, 457 F.3d 1062, 1072 (9th Cir. 2006).

Regardless of the basis for filing an application for federal registration, if a proposed trade dress is non-functional and either inherently distinctive or has acquired distinctiveness, it may be registered on the Principal Register. See *In re Procter & Gamble Co.*, 105 U.S.P.Q.2d 1119, 1123, 1126 (T.T.A.B. 2012) (finding the overall shape of a container with a cap, and the shape of the cap by itself, inherently distinctive for mouthwash). To establish that a trade dress has acquired distinctiveness, the USPTO may accept as evidence proof of substantially exclusive and continuous use in commerce for five years before the date on which the claim of distinctiveness is made. 15 U.S.C. §1052(f).

VI. The Test for Trade Dress Infringement/Dilution is Likelihood of Consumer Confusion and/or Likelihood of Dilution.

Once rights are established in a trade dress, a defendant's trade dress must create a likelihood of confusion or likelihood of dilution for the trade dress owner to prevail in litigation.

A. Likelihood of Confusion.

Factors considered in considering a likelihood of confusion include: (1) the strength of the protected trade dress (inherent strength and commercial strength); (2) the similarity of the defendant's trade dress to the protected trade dress;⁵ (3) the defendant's intent when selecting and using the accused trade dress; (4) the similarity between the products/services with which the protected trade dress is used versus those with which the accused trade dress is used; (5) whether the parties' respective products/services move through similar trade channels and/or are provided to the same or similar consumers; (6) the marketing channels that both the protected trade dress owner and the

⁵ An accused product design must be "substantially similar" to infringe a trade dress. *Yankee Candle Co. v. Bridgewater Candle Co., LLC*, 259 F.3d 25, 33 (1st Cir. 2001).

defendant use and likely plan to use in the future; (7) the level of care that relevant consumers take when purchasing the parties' respective products/services; (8) the use and prominence of brand names and product names on the defendant's products or service, i.e. whether the use of those words reduces or eliminates likelihood of customer confusion; and (9) evidence of actual consumer confusion. See *Two Pesos*, 505 U.S. at 768; *Jeffrey Milstein, Inc. v. Greger, Lawler, Roth, Inc.*, 58 F.3d 27, 31 (2d Cir. 1995).

B. Likelihood of Dilution.

To show a likelihood of dilution the trade dress owner must prove: (1) the trade dress, taken as a whole, is distinctive, not functional, and is famous; (2) if the trade dress includes any federally registered mark or marks, the unregistered matter, taken as a whole, is famous separate and apart from any fame of such federally-registered marks (15 U.S.C.A. §1125(c)(4)); (3) and dilution by blurring or tarnishment.

In determining whether a trade dress is likely to cause dilution by blurring, the court may consider all relevant factors including: (1) the degree of similarity between the trade dress and the famous trade dress; (2) the degree of inherent or acquired distinctiveness of the famous trade dress; (3) the extent to which the owner of the famous trade dress is engaging in substantially exclusive use of the mark; (4) the degree of recognition of the famous mark; (5) whether the user of the trade dress intended to create an association with the famous trade dress; (6) any actual association between the trade dress and the famous trade dress. 15 U.S.C. § 1125(c)(2)(B). Dilution by tarnishment means an association arising from the similarity between a mark or trade name and a famous trade dress that harms the reputation of the famous trade dress. 15 U.S.C. § 1125(c)(2)(C).

VII. Remedies for Trade Dress Infringement and Dilution.

The remedies for trade dress infringement are the same as those for trademark infringement, i.e., injunctions under 15 U.S.C. §1116, recovery of the defendant's profits or the plaintiff's actual damages (trebled in the court's discretion if the infringement is found to be willful), attorney's fees in exceptional cases, and destruction of infringing articles. 15 U.S.C. §§1114-1119.

Damages that can be awarded for trade dress infringement include: (1) the defendant's profits. (*Clearline Techs. Ltd. v. Cooper B-Line, Inc.*, 948 F. Supp. 2d 691, 706 (S.D. Tex. 2013)); (2) actual losses suffered due to the infringing activity, including the plaintiff's lost profits, and lost goodwill (*Experience Hendrix L.L.C. v. Hendrixlicensing.com Ltd*, 762 F.3d 829, 844-45 (9th Cir. 2014)); (3) the costs of corrective advertising to counteract consumer confusion due to the infringing activity (*Big O Tire Dealers, Inc. v. Goodyear Tire & Rubber Co.*, 561 F.2d 1365, 1374 (10th Cir. 1977)); (4) reasonable royalties that would have been paid by the defendant to use the trade dress (*Sands, Taylor & Wood v. Quaker Oats Co.*, 34 F.3d 1340, 1350 (7th Cir. 1994)); (5) litigation costs (*Tacori Enterprises v. Beverly Jewellery Co.*, No. CV 0605170 GAFRCX, 2009 WL 10669482, at *10 (C.D. Cal. Feb. 10, 2009)); and (6) attorney's fees, which may be granted in exceptional cases. *Taco Cabana Intern., Inc. v. Two Pesos, Inc.*, 932 F.2d 1113; 15 U.S.C. § 1117(a).

The remedies for trade dress dilution are the same as for trademark dilution, i.e., (1) injunctive relief (15 U.S.C. §1125(c)(1)), and (2) damages and/or the destruction of infringing articles if the dilution was willful. 15 U.S.C. §1125(c)(5).

VIII. Conclusion.

Trade dress must be non-functional and viewed by relevant consumers as a source indicator to be protectable. If protectable, trade dress can be enforced in an action for infringement and/or dilution (if the trade dress is famous).



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