

What is Trade Dress?

Trade dress is the design and appearance of a product together with the elements making up the overall image that serves to identify the product presented to the consumer. *Yankee Candle Co., Inc. v. Bridgewater Candle Co., LLC*, 259 F.3d 25, 38 (1st Cir. 2001). In other words, trade dress is a product's "look and feel." Trade dress may include features such as size, shape, color or color combinations, texture, graphics, or even particular sales techniques. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 765 n.1 (1992). Trade dress is a broad concept, encompassing both product packaging and product design/configurations. *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 209-10 (2000). Book and magazine covers; the appearance of a teddy bear toy; a Rubik's cube puzzle, the appearance of a lamp; the overall design of a sports shoe; the appearance of a video game console; a combination of features of a folding table, the appearance of a water meter; the decor, menu and style of a restaurant, and the distinctive performance style of a rock music group are among the things courts have held to constitute trade dress. 1 J.T. McCarthy, *Trademarks and Unfair Competition* § 8.01[2] at 8-8 to -9 (3rd ed. 1996) (citing cases). Trade dress is not all encompassing, however. A marketing approach or theme, for example, generally does not constitute trade dress. See *Woodsmith Pub. Co. v. Meredith*, 904 F.2d 1244, 1248 (8th Cir. 1990); *Revlon, Inc. v. Jerell, Inc.*, 713 F. Supp. 93, 97 (S.D.N.Y. 1989). Nor does the method or style of doing business. *Prufrock Ltd. v. Lasater*, 781 F.2d 129, 131-32 (8th Cir. 1986).

What Trade Dress is Protectable?

It is well established that trade dress can be protected under federal law. *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 28 (2001). See 15 U.S.C. § 1125(a). For trade dress to be protected, however, it must be both non-functional and distinctive. *Wal-Mart Stores, Inc.*, 529 U.S. at 210; *Two Pesos*, 505 U.S. at 775.

In general terms, a product feature is functional, and not protectable, "if it is essential to the use or purpose of the article or if it affects the cost or quality of the article." *Qualitex v. Jacobson Prods., Co.*, 514 U.S. 159, 165 (1995). Having a utility patent on a product is strong evidence that the patented features are functional and thus not protectable trade dress. *Traffix Devices, Inc.*, 532 U.S. at 29.

Trade dress will meet the distinctive requirement if it either: 1) is inherently distinctive; or 2) has acquired distinctiveness through secondary meaning. *Two Pesos*, 505 U.S. at 769. Generally, distinctiveness of product design trade dress will not be considered inherent and can only be obtained through secondary meaning. *Wal-Mart Stores, Inc.*, 529 U.S. at 214-16. Distinctiveness of product packaging trade dress, on the other hand, may be either inherent or acquired. *Id.* at 214-15.

Trade dress is inherently distinctive if its intrinsic nature serves to identify a particular source. *Wal-Mart Stores, Inc.*, 529 U.S. at 210. In other words, inherently distinctively trade dress is that which has a design, shape or combination of elements so unique,

unusual or unexpected that it will automatically be perceived by customers as an indicia of origin. McCarthy, § 8.02[4] at 8-23. Courts have held such items as a ouzo bottle, ice cream bar wrapping and the appearance of car sales brochures, reminder letters and reports to be inherently distinctive. See *Paddington Corp. v. Attiki Importers & Distrib., Inc.*, 996 F.2d 577, 584 (2d. Cir. 1993); *AmBrit Inc. v. Kraft Inc.*, 812 F.2d 1531, 1537 (11th Cir. 1986); *Computer Care v. Service Sys. Enterprises, Inc.*, 982 F.2d 1063, 1069 (7th Cir. 1992).

Trade dress that has acquired distinctiveness through secondary meaning is trade dress that the public has begun to associate with a single source or producer, even if the actual producer is unknown, rather than just the product itself. *Wal-Mart Stores, Inc.*, 529 U.S. at 211. In many instances, the only practical way to develop secondary meaning in trade dress is by advertising a product's features claimed as trade dress in such a way that the feature and source become readily associated. McCarthy, § 8.01[2] at 8-16.

How Can I Protect My Trade Dress?

Trade Dress may be registered with the USPTO if it satisfies the federal standards of trademark or service mark protection. *Aromatique, Inc. v. Gold Seal, Inc.*, 28 F.3d 863, 868 (8th Cir. 1994). See *Wal-Mart Stores, Inc.*, 529 U.S. at 209. Registration constitutes "prima facie evidence of the validity of the registered mark . . . , of the registrant's ownership of the mark, and of the registrant's exclusive right to use the registered mark . . ." 15 U.S.C. § 1057(b). Additionally, registration gives notice that the trade dress is claimed by the producer. *Id.* § 1072.

Trade dress infringement is grounds for a civil action, regardless of whether trade dress is registered or not. 15 U.S.C. § 1125(a). If the trade dress is unregistered, however, the burden to show that the trade dress is protectable is on the producer. *Id.* § 1125(a)(3).