Trade Dress Fundamentals

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This practice note provides an overview of federal trade dress protection and enforcement under the Lanham Act. It addresses the potential categories of trade dress, the requirements for trade dress protection (i.e., distinctiveness and nonfunctionality), the advantages of federal registration, and trade dress enforcement (including trade dress infringement, dilution, and counterfeiting claims). This practice note also discusses the importance of an integrated protection strategy that comprises trade dress, copyright, and design patent protection, where feasible.

For more information on registration and enforcement, see Trademark Registration and Maintenance Resource Kit and Trademark Enforcement Resource Kit. For a sample complaint, see Complaint (Verified Complaint for Direct and Contributory Counterfeiting, Trademark and Trade Dress Infringement, and Unfair Competition).

Categories of Trade Dress

The categorization of trade dress is important, as it directly impacts protectability and enforcement. There are three primary categories of trade dress:

- Product design or configuration
- Product packaging
- Other nontraditional trademarks

Each of these categories is discussed in further detail below, along with how to classify ambiguous trade dress that is neither product design nor product packaging (e.g., restaurant décor, color marks, scent and flavor marks, and sound marks).

Trade Dress Basics

Trade dress is, generally speaking, the total image and overall appearance of a product or service. It may include features such as:

- Size
- Shape
- Color or color combinations
- Texture
- Graphics
- Sounds, scents, and flavors
- Motion and moving images
- Particular business techniques
- The look and feel of a website


While trade dress is not explicitly defined in the Lanham Act, it is considered a "symbol" or "device" and, therefore, falls within the definition of a trademark or service mark. Wal-Mart Stores, Inc. v. Samara Bros., 529 U.S. 205 (2000); see also 15 U.S.C. §§ 1127 and 1125(a). Trade dress may thus be protected and enforced under the Lanham Act, whether it is registered or unregistered, similar to trademarks and service marks (though there are important distinctions, as discussed in this practice note).

For an overview of trademark law, see Trademark Fundamentals. For more on trade dress protection and enforcement, see Trade Dress Protection and Trade Dress Enforcement below.
**Product Design or Configuration**

This category refers to the configuration or shape of a product (either an entire product or a particular feature). Examples of registered product design trade dress include the shape of a GIBSON guitar body, the shape of a WEBER kettle barbecue grill, and the overall appearance of the APPLE IPHONE, as shown in the images below.


Applicants often describe product configurations with the specificity of a utility patent claim. For instance, Weber described its kettle barbecue grill as follows:

> The mark consists of a three-dimensional pictorial representation of the distinctive configuration of the kettle and leg portions of applicant’s barbecue grills. The kettle portion includes a bottom of generally semi-spherical shape having a top of generally semi-ellipsoid shape and supported by three downwardly and outwardly extending legs projecting from the bottom of the bottom portion.


Product design trade dress can never be inherently distinctive. It may only be protected if it has acquired distinctiveness (i.e., if there is proof of secondary meaning). Wal-Mart Stores, Inc. v. Samara Bros., 529 U.S. 205 (2000) (“Consumers are aware of the reality that, almost invariably, even the most unusual of product designs—such as a cocktail shaker shaped like a penguin—is intended not to identify the source, but to render the product itself more useful or appealing.”). Product design trade dress must also be nonfunctional to be protectable.

For more on inherent and acquired distinctiveness, see “Distinctiveness Requirement” under Trade Dress Protection below. For more on functionality, see “Nonfunctionality Requirement” under Trade Dress Protection below.

**Product Packaging**

Traditional types of product packaging include labels, wrappers, boxes, and other containers, such as the COCA-COLA bottle and TIDE’s “squat, brightly decorated plastic bottles for its liquid laundry detergent.” Wal-Mart Stores, Inc. v. Samara Bros., 529 U.S. 205 (2000).

Other examples of product packaging trade dress that are registered include a container for mouthwash, a skull bottle for vodka, and the label for JACK DANIEL’S whiskey, as shown in the images below.

Product packaging, unlike product design trade dress, is capable of being inherently distinctive. Wal-Mart Stores, Inc. v. Samara Bros., 529 U.S. 205 (2000) (noting that the "predominant function" of certain categories of word marks and product packaging is source identification). If packaging is found not to be inherently distinctive, it may still be protected if it has acquired distinctiveness. Product packaging must also be nonfunctional to be protectable.

For more on inherent and acquired distinctiveness, see "Distinctiveness Requirement" under Trade Dress Protection below. For more on functionality, see "Nonfunctionality Requirement" under Trade Dress Protection below.

**Other Nontraditional Marks**

Not all trade dress fits neatly into the categories of product packaging (which may be inherently distinctive) and product design (which may not). In its Wal-Mart decision, the Supreme Court discussed trade dress from a previous case that it had found inherently distinctive, the décor of a Mexican restaurant (the plaintiff had described the trade dress as "a festive eating atmosphere having interior dining and patio areas decorated with artifacts, bright colors, paintings and murals").

The Court classified this trade dress as either product packaging "or else some tertium quid that is akin to product packaging." However, the Court cautioned that in close cases, lower courts "should err on the side of caution and classify ambiguous trade dress as product design, thereby requiring secondary meaning." Wal-Mart Stores, Inc. v. Samara Bros., 529 U.S. 205 (2000) (citing Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763 (1992)).

Examples of registered trade dress that may fall into this “third category” include the interior décor of a restaurant (CHIPOTLE and IN-N-OUT BURGER) and the shape of a building (WALGREENS), as shown in the images below.

When describing such trade dress, it is often necessary to be very specific. For instance, In-N-Out Burger described its restaurant interior as follows:

The color(s) red and white is/are claimed as a feature of the mark. The mark consists of a three-dimensional trade dress depicting the interior of a restaurant. The interior includes white sectional dividing walls having horizontal rows of red stripes. The interior also includes clear glass panels positioned above parts of the dividing walls. The interior also includes a customer seating area with booths, barstools and chairs, wherein the chairs are red, the barstools are white, and the booths have red upholstery, and white countertops and tabletops. The interior further includes a customer ordering area with sections of red tile walls and white tile walls around the customer ordering area and a silver counter. The matter shown in broken lines is not part of the mark and serves only to show the position of the mark.

See U.S. Reg. No. 4,839,216.

Other types of nontraditional trade dress include:

- Single colors and color combinations
- Scents and flavors/tastes
- Sounds
- Motion and moving images
- Sales or marketing techniques
- Catalogs
- Advertisements
- Websites

See, e.g., Abercrombie & Fitch Stores, Inc. v. Am. Eagle Outfitters, Inc., 280 F.3d 619 (6th Cir. 2002) (mail-order catalog was either product packaging or "an objectively observable 'particular sales technique' used to sell clothing"); Kleck v. Bausch & Lomb, Inc., 145 F. Supp. 2d 819 (W.D.
Color marks, scent and flavor marks, sound marks, and motion marks are discussed in further detail below.

**Color Marks**

Marks that consist solely of a color, or color combinations, can be protected if they have acquired distinctiveness and are nonfunctional. Color marks cannot be inherently distinctive. Qualitex Co. v. Jacobson Prods. Co., 514 U.S. 159 (1995). If these requirements are met, it is even possible to register different shades of the same basic color.

Examples of registered color marks include:
- Robin’s-egg blue for TIFFANY’s boxes and bags (U.S. Reg. Nos. 2,359,351 and 2,416,795)
- Pink for OWENS CORNING home insulation (U.S. Reg. No. 1,439,132)
- The color combination of green and yellow for JOHN DEERE equipment (U.S. Reg. No. 3,877,114)
- The BURBERRY tartan pattern for clothing, handbags, mobile phone cases, etc. (U.S. Reg. No. 4,123,508)
- The “color green Pantone 7488U,” also for medical gloves.

Scent and Flavor Marks

Like color marks, scent and flavor marks can never be inherently distinctive; they may only be protected if they have acquired distinctiveness and are nonfunctional. Such marks may only be registered upon a “substantial showing” of acquired distinctiveness. See, e.g., In re Pohl-Boskamp GmbH & Co., 2013 TTAB LEXIS 7 (TTAB Feb. 25, 2013).

Examples of registered scent marks include:
- A cherry scent for synthetic lubricants for high performance racing and recreational vehicles (U.S. Reg. No. 2,463,044)
- A “high impact fragrance primarily consisting of musk, vanilla, rose and lavender” for hair conditioners (U.S. Reg. No. 4,057,947)
- The “scent of bubble gum” for “shoes, sandals, flip flops, and accessories, namely, flip flop bags” (U.S. Reg. No. 4,754,435)
- A scent “of a sweet, slightly musky, vanilla fragrance, with slight overtones of cherry, combined with the smell of a salted, wheat-based dough” (U.S. Reg. No., 5,467,089)
- The scent of “banana and evergreen, with a hint of ammonium and kerosene” for “gun-cleaning preparations for guns and gun parts” (U.S. Reg. No. 6,016,544)

There are no current registrations for flavor marks. But see In re N.V. Organon, 2006 TTAB LEXIS 206 (TTAB June 14, 2006) (discussing, and ultimately rejecting, an orange flavor for antidepressants as functional).

For more information on scent marks, see Gilson on Trademarks § 2.11[4]. For more information on flavor marks, see Gilson on Trademarks § 2.11[5].

### Sound Marks

Sound marks may be inherently distinctive, but if the corresponding goods make the sound in their normal course of operation (such as alarm clocks or telephones), a showing of acquired distinctiveness is necessary for registration. Sound marks also must be nonfunctional. See, e.g., In re Vertex Grp. LLC, 2009 TTAB LEXIS 60 (TTAB Feb. 13, 2009).

Examples of registered sound marks include:

- The NBC chimes for broadcasting services (U.S. Reg. No. 916,522)
- MGM’s lion roaring, for motion pictures and related services (U.S. Reg. No. 1,395,550)

The NBC chimes are specifically described as "a sequence of chime-like musical notes which are in the key of C and sound the notes G, E, C, the ‘G’ being the one just below middle C, the ‘E’ the one just above middle C, and the ‘C’ being middle C, thereby to identify applicant’s broadcasting service." See U.S. Reg. No. 916,522.

For more information on sound marks, see Gilson on Trademarks § 2.11[3].

### Motion Marks

Marks that comprise motion or moving images may also be registered. Some examples include:

- The 20th Century Fox Film Corp.’s "moving floodlights" logo (U.S. Reg. No. 1,928,424)
- The movement of the doors of a Lamborghini (U.S. Reg. No. 2,793,439)

For more information on motion marks, see Gilson on Trademarks § 2.11[7].

### Trade Dress Protection

To receive federal Lanham Act protection, trade dress must be:

- Distinctive
- Nonfunctional

Each requirement is discussed in further detail below.

#### Distinctiveness Requirement

For both trademarks and trade dress, there are two types of distinctiveness:

- Inherent distinctiveness
- Acquired distinctiveness

Inherently distinctive trademarks are so unique that they are capable of identifying the source of goods or services upon first use. Marks that are arbitrary (e.g., CAMEL cigarettes), fanciful (e.g., KODAK film), or suggestive (e.g., TIDE laundry detergent) are inherently distinctive. See, e.g., Wal-Mart Stores, Inc. v. Samara Bros., 529 U.S. 205 (2000).

If a trademark lacks inherent distinctiveness, it may still be protected if it has acquired distinctiveness. This is commonly referred to as secondary meaning, which occurs when, "in the minds of the public, the primary significance of [the mark] is to identify the source of the product rather than the product itself." Inwood Labs., Inc. v. Ives Labs., Inc., 456 U.S. 844 (1982).

Each type of distinctiveness, as it pertains to trade dress, is discussed below.

#### Inherent Distinctiveness

Only the following types of trade dress may be inherently distinctive:

- Product packaging
- Sound marks

See Categories of Trade Dress above.

In the registration context and in opposition and cancellation proceedings, the TTAB and the Federal Circuit (which hears appeals of TTAB decisions) use the Seabrook Foods test to assess inherent distinctiveness. This test asks whether the trade dress in question:

- Consists of a common basic shape or design
- Is unique or unusual in a particular field
- Is a "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"
- Is capable of creating a commercial impression distinct from any accompanying words

In litigation, courts use one of two tests to assess inherent distinctiveness:

- The Abercrombie “spectrum of distinctiveness” test
- The Seabrook Foods test

The Abercrombie test, traditionally applied to word marks, uses a spectrum of five categories (generic, descriptive, suggestive, arbitrary, and fanciful) to determine the distinctiveness of a mark. Suggestive, arbitrary, and fanciful marks are inherently distinctive. See Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4 (2d Cir. 1976), and Trademark Distinctiveness Spectrum.


The Seabrook Foods test, however, is the more common test used in trade dress cases, and has been adopted by a number of circuits. See, e.g., Miller's Ale House, Inc. v. Boynton Carolina Ale House, LLC, 702 F.3d 1312 (11th Cir. 2012); Amazing Spaces, Inc. v. Metro Mini Storage, 608 F.3d 225 (5th Cir. 2010); Yankee Candle Co. v. Bridgewater Candle Co., 259 F.3d 25 (1st Cir. 2001).

**Acquired Distinctiveness (Secondary Meaning)**

The following types of trade dress can never be inherently distinctive and always require proof of acquired distinctiveness, or secondary meaning:

- Product designs or configurations
- Color marks
- Scent marks
- Flavor marks

See Categories of Trade Dress.

Secondary meaning (i.e., that a substantial or significant number of consumers associate the trade dress in question with the producer of the goods or services) can be proven by direct or circumstantial evidence. Direct evidence includes consumer testimony and consumer surveys. Surveys, in particular, are commonly submitted in trade dress litigation and are often the most powerful type of evidence.

With respect to circumstantial evidence, most circuits have a nonexclusive, multi-factored test for assessing secondary meaning. Relevant factors may include:

- Amount and manner of advertising
- Length and manner of use
- Exclusivity of use
- Amount of sales and number of customers
- Unsolicited media coverage
- The plaintiff’s established place in the market
- Proof of intentional copying


In the registration context, applicants may submit an affidavit of five years’ use, which may be accepted as prima facie evidence that the mark has acquired distinctiveness. 37 C.F.R. § 2.41(a)(2). However, such affidavits are typically not sufficient “for matter that is not inherently distinctive because of its nature,” such as product designs or configurations and the overall color of a product. In such cases, actual evidence is necessary to establish distinctiveness. See Trademark Manual of Examining Procedure (TMEP) 1202.

**Nonfunctionality Requirement**

Trade dress that “comprises any matter that, as a whole, is functional” may not be registered, even if the trade dress is inherently distinctive or has acquired a secondary meaning. 15 U.S.C. § 1052(e), (f). Functionality is also a ground for cancellation of registered trade dress (15 U.S.C. § 1064(3)) and is a defense against incontestability (15 U.S.C. § 1115(b)(8)).

For a more detailed discussion on cancellation and incontestability, see TTAB Litigation: Cancellation Proceedings and Trademark Registrations: Maintenance and Renewal — Claim of Incontestability.

The functionality doctrine is unique to trade dress law. There are two types of functionality:

- Utilitarian functionality
- Aesthetic functionality

Each type of functionality is discussed below.

**Utilitarian Functionality**

Under the utilitarian functionality doctrine (sometimes referred to as the "traditional" functionality test), a product feature is functional if either:

- The feature is essential to the use or purpose of the product
- The feature affects the cost or quality of the product
If a feature is found functional under the traditional test, the inquiry ends, and there is no need to consider competitive necessity (i.e., evidence of alternative designs). TrafFix Devices, Inc. v. Mktg. Displays, Inc. 532 U.S. 23 (2001). (Prior to TrafFix, courts routinely considered competitive necessity in all trade dress cases.)

An expired utility patent that claims a trade dress feature or features is strong evidence of functionality. In such circumstances, the party seeking trade dress protection bears a heavy burden of showing that the feature is not functional (e.g., by showing that the feature is merely an ornamental, incidental, or arbitrary aspect of the device). TrafFix Devices, Inc. v. Mktg. Displays, Inc. 532 U.S. 23 (2001). Conversely, for purposes of registration, a design patent is a factor that weighs against a finding of functionality. See Trademark Manual of Examining Procedure (TMEP) 1202 (design patents by definition protect only ornamental and nonfunctional features).

For more information on utility and design patents, see Design Patents vs. Utility Patents Checklist.

In assessing utilitarian functionality, courts consider factors such as:

- Whether the design yields a utilitarian advantage (e.g., is there a utility patent that covers a feature of the trade dress?)
- Whether alternative designs are available (this factor especially varies by circuit, given the TrafFix decision—for instance, some circuits do not consider it at all, while others still find it relevant to the overall inquiry but not required)
- Whether advertising touts the utilitarian advantages of the design
- Whether the particular design results from a comparatively simple or inexpensive method of manufacture

See, e.g., Talking Rain Bev. Co. v. S. Beach Bev. Co., 349 F.3d 601 (9th Cir. 2003); Valu Engineering, Inc. v. Rexnord Corp., 278 F.3d 1268 (Fed. Cir. 2002). Note, however, that tests vary by circuit. For a circuit-by-circuit overview of functionality tests both before and after the TrafFix decision, see Gilson on Trademarks § 2A.04[5][d].

Aesthetic Functionality

In cases of aesthetic functionality, a product feature is functional if its exclusive use “would put competitors at a significant non-reputation-related disadvantage” (i.e., if there is a competitive necessity for the feature). TrafFix Devices, Inc. v. Mktg. Displays, Inc. 532 U.S. 23 (2001) (citing Qualitex Co. v. Jacobson Prods. Co., 514 U.S. 159 (1995)). Aesthetic functionality cases typically involve trade dress with aesthetically or visually pleasing features, such as clothing or jewelry designs.

However, as discussed above, if a product feature is found functional under the traditional test (i.e., if the feature is essential to the use or purpose of the product or if it affects the cost or quality of the product), a court must end the inquiry and not consider competitive necessity / aesthetic functionality.

Note that circuits disagree on the applicability of the aesthetic functionality doctrine. The Second and Seventh Circuits, for instance, have long recognized the doctrine. See, e.g., Christian Louboutin S.A. v. Yves St. Laurent Am. Holding, Inc., 696 F.3d 206 (2d Cir. 2012) (“[A] mark is aesthetically functional, and therefore ineligible for protection under the Lanham Act, where protection of the mark significantly undermines competitors’ ability to compete in the relevant market.”); Jay Franco & Sons, Inc. v. Franek, 615 F.3d 855 (7th Cir. 2010) (“A design’s aesthetic appeal can be as functional as its tangible characteristics.”).

Other circuits have either rejected the doctrine or limited its application (such as the Third and Fifth Circuits), or have not had the occasion to consider the doctrine (such as the First and Eighth Circuits). For a circuit-by-circuit overview of how courts treat aesthetic functionality, see Gilson on Trademarks § 2A.04[5][d].

Advantages of Federal Registration

Trade dress need not be registered with the U.S. Patent and Trademark Office (USPTO) to be protected, so long as it is distinctive and nonfunctional, but there are significant benefits to registration. First and foremost are the legal presumptions of ownership and validity. See 15 U.S.C. § 1115(a).

The presumption of validity is especially important in litigation. It shifts the burden of proof to the defendant, requiring the defendant to show that the claimed trade dress is invalid (i.e., that the trade dress is not distinctive and/or is functional) by a preponderance of the evidence. Functionality, in particular, is often a major battleground in litigation, and thus having a registration can be essential to winning (or losing) your case.

For more on validity, see Trade Dress Protection above. For more on trade dress litigation, see Trade Dress Enforcement below.
Other advantages of federal registration include:

- Exclusive right to use the trade dress nationwide with the goods/services listed in the registration
- Constructive notice of ownership
- For intent-to-use applications, the filing date of the application constitutes constructive first use (see Trademark Applications: Drafting the Application — Special Considerations for Intent-to-Use Applications)
- Potentially indefinite term of protection
- The ability to gain “incontestable” status (see Trademark Registrations: Maintenance and Renewal — Claim of Incontestability)
- Federal jurisdiction in the event of litigation
- The ability to prevent the importation of infringing goods (see Policing and Enforcing Trademarks — United States Customs and Border Protection)
- Use of the registration as a basis for registering the trade dress in foreign countries (see International Trademark Filing Systems)

For more information on trademark registration, see Trademark Registration and Maintenance Resource Kit. For TTAB decisions concerning the registrability of trade dress, see TTAB Decision Tracker: Product Packaging and Product Design Distinctiveness and TTAB Decision Tracker: Functionality.

Trade Dress Enforcement

Registered trade dress may be enforced under Section 32 of the Lanham Act (15 U.S.C. § 1114). Unregistered trade dress may be enforced under Section 43(a) of the Lanham Act (15 U.S.C. § 1125(a)) if the trade dress is used in commerce in connection with a product or service and is otherwise protectable.

Registered trade dress is presumed valid, thereby shifting the burden of proof to the defendant to show that the trade dress is invalid (i.e., functional and not distinctive) by a preponderance of the evidence. See 15 U.S.C. § 1115(a). It is thus advisable to register trade dress before filing suit, when possible. For other benefits of registration, see Advantages of Federal Registration above.

Note, however, that a plaintiff must always describe the alleged trade dress with specificity and explain why the features are distinctive and nonfunctional, regardless of whether the trade dress is registered or unregistered. See, e.g., Tumblebus Inc. v. Cramer, 399 F.3d 754 (6th Cir. 2005) (“To recover for trade dress infringement under § 43(a) of the Lanham Act, a party must first identify what particular elements or attributes comprise the protectable trade dress.”); Heller Inc. v. Design Within Reach, Inc., 2009 U.S. Dist. LEXIS 71991 (S.D.N.Y. Aug. 14, 2009) (“Registration, particularly a vague registration, does not affect the plaintiff’s obligation to specify the elements of its allegedly distinctive dress.”).

Trade dress infringement claims are the most common claims asserted under the Lanham Act. Other potential claims include counterfeiting and dilution. Each type of claim is discussed below, along with the available remedies.

Trade Dress Infringement

To bring a claim for trade dress infringement, a plaintiff must show three elements:

- Distinctiveness
- Likelihood of confusion
- Nonfunctionality (in cases where the trade dress is not registered)

For more on the requirements of distinctiveness and nonfunctionality, see Trade Dress Protection above.

Likelihood of Confusion

Each circuit has its own multi-factored test for likelihood of confusion (the Polaroid factors in the Second Circuit, the Lapp factors in the Third Circuit, and so on), which are applied in both trademark and trade dress cases. See, e.g., Innovation Ventures, LLC v. N2G Distrib., Inc., 763 F.3d 524 (6th Cir. 2014). For an overview of each circuit’s factors, see Likelihood of Confusion Factors Circuit-by-Circuit Chart.

While the factors vary slightly by circuit, they involve essentially the same inquiries. The Third Circuit, for instance, considers the following 10 factors:

1. The degree of similarity between the parties’ trade dress
2. The strength of the plaintiff’s trade dress
3. The price of the goods and other factors indicative of the care and attention expected of consumers when making a purchase
4. The length of time the defendant has used its trade dress without evidence of actual confusion arising
5. Intent of the defendant in adopting its trade dress
6. Evidence of actual confusion
7. Whether the goods, though not competing, are marketed through the same channels of trade and advertised through the same media
8. The extent to which the targets of the parties’ sales efforts are the same

9. The relationship of the goods in the minds of consumers because of the similarity of function

10. Other facts suggesting that the consuming public might expect the plaintiff to manufacture a product in the defendant’s market, or that the plaintiff is likely to expand into that market

See Interpace Corp. v. Lapp Inc., 721 F.2d 460 (3d Cir. 1983); McNeil Nutritionalis, LLC v. Heartland Sweeteners, LLC, 511 F.3d 350 (3d Cir. 2007) (applying the Lapp factors in a trade dress case); Likelihood of Confusion Factors: Key Legal Principles and Representative Cases (3d Cir.). No one factor is determinative, and not all factors are given equal weight in the analysis.

The following two examples contrast how different courts, in trade dress cases, reached opposite conclusions on likelihood of confusion.

**Likelihood of confusion found.** The Eighth Circuit found a likelihood of confusion between defendant’s "Cody Cow" Stretch Pet (a stuffed animal which wrapped around the edges of computer monitors, computer cases, or televisions) and plaintiff Gateway’s cow print design for computer products. Relevant factors included:

- Gateway conducted an extensive ten-year advertising campaign, spending over $1.3 billion worldwide and over $1 billion in the United States on advertising and promotional items
- There was evidence regarding defendant’s intent to confuse consumers
- There was evidence of actual confusion (a nationwide survey showed a 39% confusion rate)
- The parties were in close competitive proximity
- There was a high degree of similarity between the parties’ trade dress
- Consumers were not likely to exercise great care in purchasing defendant’s product (which sold for less than $20)

See Gateway, Inc. v. Companion Prods., Inc., 384 F.3d 503 (8th Cir. 2004).

**No likelihood of confusion found.** The Seventh Circuit found no likelihood of confusion between the grilles on Jeep’s sports utility vehicles (SUVs) and those of the Hummer H2. Relevant factors included:

- The similarities between the grilles was modest and limited to how the slots were stamped
- There was little market overlap, even though both parties’ SUVs would be sold at car dealerships, because of differences in size and price (the Jeeps usually sold for no more than $28,000, while the Hummer H2 usually cost more than $50,000, and the H2 was much larger in size than the Jeeps)
- Consumers were likely to use a very high degree of care (especially since they were likely to make their purchases from well-branded dealerships)

See AM Gen. Corp. v. DaimlerChrysler Corp., 311 F.3d 796 (7th Cir. 2002).

For more on likelihood of confusion, see Likelihood of Confusion Resource Kit; see also Gilson on Trademarks § 2A.05 (discussing likelihood of confusion in the trade dress context).

**Possibility of Virtual Confusion**

Trade dress infringement may even exist in the virtual world. For instance, the manufacturers of real-world products have filed suit for trade dress violations in recent years based on similar products existing in the virtual worlds of video games. A First Amendment defense has often been successful in defending such cases, but not always. Compare Elec. Arts, Inc. v. Textron Inc., 2012 U.S. Dist. LEXIS 103914 (N.D. Cal. Jul. 25, 2012) (refusing to dismiss Bell Helicopter/Textron’s counterclaim for trade dress infringement on First Amendment grounds; the court found it “plausible” that consumers might believe that Bell endorsed the Battlefield 3 video game in which certain Bell helicopters were depicted), with AM Gen. LLC v. Activision Blizzard, Inc., 2020 U.S. Dist. LEXIS 57121(S.D.N.Y. Mar. 31, 2020) (granting summary judgment to defendant Activision on trade dress infringement claims related to plaintiff’s “Humvee” vehicle depicted in the game Call of Duty, while noting “the improbability of confusion between a vehicle and a video game”).

**Remedies**

A successful litigant in a trade dress infringement action may obtain the same types of remedies under the Lanham Act that are available for trademark infringement, regardless of whether the trade dress is registered or unregistered. These remedies include:

- Injunctive relief (i.e., temporary restraining orders (TROs) and preliminary and permanent injunctions)
- Plaintiff’s actual damages (e.g., plaintiff’s lost profits, the cost of corrective advertising, loss of goodwill, and/or a reasonable royalty)
- Increased or trebled actual damages
Defendant's profits
Costs
Reasonable attorneys' fees (in exceptional cases)

See 15 U.S.C. § 1117(a). For a more detailed discussion on these remedies, see Trademark Infringement and False Designation of Origin Claims, Remedies, and Defenses — Remedies.

Trade Dress Dilution
The owner of famous trade dress that is distinctive (either inherently or through acquired distinctiveness) can assert a claim for dilution if, at any time after its trade dress has become famous, the defendant uses trade dress in commerce that is likely to cause dilution by blurring or dilution by tarnishment. 15 U.S.C. § 1125(c).

If the trade dress is unregistered, the plaintiff has the burden of proving that the claimed trade dress, taken as a whole, is not functional and is famous. 15 U.S.C. § 1125(c)(4).

Fame
Trade dress is famous if "it is widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark's owner." 15 U.S.C. § 1125(c)(2)(A). Courts may consider all relevant factors when assessing fame, including the following nonexclusive statutory factors:

- The duration, extent, and geographic reach of advertising and publicity of the trade dress (whether advertised or publicized by the owner or third parties)
- The amount, volume, and geographic extent of sales of goods or services offered under the trade dress
- The extent of actual recognition of the trade dress
- Whether the trade dress is registered on the principal register

The standard for fame is a fairly high bar, and only a few select courts have found trade dress to be famous for purposes of a dilution claim. Some notable examples include:

- The shape of Pepperidge Farm's Goldfish cracker
- Gucci's diamond "double G" design
- Apple's iPhone 3G trade dress


Likelihood of Dilution by Blurring or Tarnishment
To state a dilution claim, a plaintiff must also show that the defendant's use of its famous trade dress in commerce is likely to cause either:

- Dilution by blurring
- Dilution by tarnishment

Dilution by blurring occurs when a defendant's use of the same or a similar trade dress impairs the distinctiveness of the famous trade dress (e.g., use of the Coca-Cola bottle for a different type of soda). Courts may consider all relevant factors when assessing dilution by blurring, including the nonexclusive factors set forth in the statute. See 15 U.S.C. § 1125(c)(2)(B).

For instance, Gucci's diamond "double G" design (discussed above) was found diluted by blurring by a similar pattern used by Guess:
Dilution by tarnishment occurs when a defendant's use of the same or a similar trade dress harms the reputation of the famous trade dress, such as use of the dress with inferior goods or services or in an unwholesome or unsavory context (e.g., use of the Coca-Cola bottle for alcohol). See 15 U.S.C. § 1125(c)(2)(C).

For more information on these types of dilution, see Trademark Dilution Claims, Remedies, and Defenses — Likelihood of Dilution by Blurring and Trademark Dilution Claims, Remedies, and Defenses — Likelihood of Dilution by Tarnishment.

**Remedies**
The remedies for a dilution claim are generally limited to injunctive relief. See 15 U.S.C. § 1125(c)(1). However, in cases of willful violations, the plaintiff may also recover the following remedies:

- Defendant's profits
- Plaintiff's damages
- Costs
- Reasonable attorneys' fees (in exceptional cases)
- Destruction of infringing articles (if the articles were previously seized pursuant to an ex parte seizure order, the plaintiff must give 10 days' notice to the U.S. attorney for the judicial district in which the destruction order is sought, absent good cause for lesser notice)

See 15 U.S.C. §§ 1125(c)(5), 1117(a), and 1118. For a more detailed discussion on ex parte seizure orders, see Anti-counterfeiting Strategies and Counterfeiting Claims — Seeking an Ex Parte Seizure. For more information on dilution in the trade dress context, see Gilson on Trademarks § 2A.06.

**Trade Dress Counterfeiting**
Counterfeiting claims may be asserted where a plaintiff’s trade dress is registered on the Principal Register. Such claims are especially attractive because they allow a plaintiff to obtain an ex parte seizure order early in the case (i.e., seizure of the counterfeit goods without notice to the defendant) and an essentially mandatory award of treble damages or profits, whichever is greater, and attorneys' fees. See 15 U.S.C. §§ 1116(d)(1)(B), 1114(1)(a), and 1127; 18 U.S.C. § 2320(e)(1)(A); see also, e.g., Audemars Piguet Holding S.A. v. Swiss Watch Int'l, Inc., 2015 U.S. Dist. LEXIS 3207 (S.D.N.Y. Jan. 12, 2015) (trebled damages not appropriate where the parties' watch designs were not “substantially indistinguishable” and defendant's use of the trade dress was not "spurious").

To state a claim for counterfeiting, the defendant's trade dress must be:

- Spurious (i.e., not genuine or authentic)
- Identical with, or substantially indistinguishable from, the plaintiff's registered trade dress
- Used on the same goods or services covered by the plaintiff’s registration
- Likely to cause confusion

See 15 U.S.C. §§ 1116(d)(1)(B), 1114(1)(a), and 1127; 18 U.S.C. § 2320(e)(1)(A); see also, e.g., Louis Vuitton Malletier S.A. v. LY USA, Inc., 676 F.3d 83 (2d Cir. 2012); K&N Engineering, Inc. v. Bulat, 510 F.3d 1079 (9th Cir. 2007).

For a more detailed discussion on counterfeiting, see Anti-counterfeiting Strategies and Counterfeiting Claims.

**Integrated Protection Strategy (Trade Dress / Design Patent / Copyright)**

Trade dress is closely related to two other areas of intellectual property: design patents and copyrights. Together, these areas create an "IP Trifecta" that can be used to form a strong wall of protection around product designs and packaging. For more on the interrelationship between these areas, see IP Protection Comparison for Literary Works; Marketing Images, Characters, and Slogans; Product Designs; and Inventions.

In the Apple v. Samsung case, for example, Apple successfully asserted both design patent and trade dress claims related to the iPhone and iPhone 3G against Samsung’s Galaxy products. See Apple, Inc. v. Samsung
Elecs. Co., 2013 U.S. Dist. LEXIS 13238 (N.D. Cal. Jan. 29, 2013) (jury found that Apple's registered and unregistered trade dress was protectable and diluted and that Apple's design patents were valid and infringed); but see Lanard Toys Ltd. v. Dolgencorp LLC, 958 F.3d 1337 (Fed. Cir. 2020) (finding that the design of a chalk holder made to look like a #2 pencil was not infringed by a product with a similar design, despite the existence of a design patent and a copyright registration, where plaintiff failed to prove that its trade dress had acquired secondary meaning).

Given the potential benefits of various forms of IP protection, you should advise clients to consider an integrated protection strategy using the IP Trifecta early in a product’s life cycle, at the conception/prototype stage, as set forth below.

**Design Patent Protection**

Determine whether the product design is patentable. If so, strongly consider filing a design patent application because:

- It is easier and faster to obtain a design patent versus a utility patent (design patents are typically issued within 12 to 15 months of the application filing date). See Design Patents vs. Utility Patents Checklist.
- A design patent is a factor that weighs against a finding of functionality (for purposes of trade dress protection). See Trademark Manual of Examining Procedure (TMEP) 1202.
- Design patent protection creates a period of exclusivity, which can support a trade dress applicant’s claim of acquired distinctiveness based on five years of substantially exclusive and continuous use in commerce (for product configuration trade dress and other types of trade dress that are not capable of being inherently distinctive). See 37 C.F.R. § 2.41(a)(2); 8-1200 Trademark Manual of Examining Procedure (TMEP) 1202.

For more information on design patents, see Design Patent Applications: Drafting the Application.

**Copyright Protection**

Consider filing one or more copyright applications covering the appearance of the product design at the same time the design patent application is filed (or early in the product’s life cycle, if design patent protection is not available). Preferably, the application(s) should be filed within three months of the first public disclosure of the product design, in order to retain the right to obtain statutory damages in a potential infringement action.

Because copyright applications are not examined as extensively as design patent applications, a registration will typically issue in a matter of months. This registration provides the owner with a right to sue in federal court and, importantly, a presumption of validity.

Copyright protection may be especially valuable where:

- Design patent and/or trade dress applications are still pending -or-
- There is insufficient evidence of inherent or acquired distinctiveness

For a more detailed discussion on copyright registration, see Registration of Copyrights. For a general overview of copyright law (including copyright eligibility, the requirements for copyright protection, enforcement, and remedies), see Copyright Fundamentals.

**Trade Dress Protection**

If the product design may be easily categorized as product packaging, or akin to product packaging, consider filing an application for trade dress registration simultaneously with the design patent and/or copyright applications, or once the design patent issues (a design patent provides strong evidence of nonfunctionality). For more on categorization, see Categories of Trade Dress above.

If the product design consists of the product’s configuration or shape, or cannot be easily categorized, do not file an application until the trade dress has acquired distinctiveness (i.e., when there is evidence of secondary meaning). For more on acquired distinctiveness, see “Distinctiveness Requirement” under Trade Dress Protection above.

Note that five years of substantially exclusive and continuous use in commerce may constitute prima facie evidence of distinctiveness, but only for product packaging trade dress (or other types of trade dress that are capable of being inherently distinctive). Actual evidence of secondary meaning is necessary for product configurations. See 37 C.F.R. § 2.41(a)(2); Trademark Manual of Examining Procedure (TMEP) 1202.

For more information on trademark registration, see Trademark Registration and Maintenance Resource Kit.
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