Trade Dress

Evolution, Strategy and Practice

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Foreword by Cooper C. Woodring

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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.

Acknowledgments

IT GOES WITHOUT saying that a book like this does not get written without the contributions of people other than the authors. We have had the opportunity to work with some of the best attorneys and clients anyone could ask for over the years and this book would not have been possible without them. The opportunities and guidance we were provided by these individuals gave us the experiences we needed to grow and develop as attorneys. These people are too numerous to name here, but suffice it to say, "You know who you are." Thanks to the Catholic University School of Law, and the Villanova University School of Law (Darius and Bill's respective alma maters), and all of our professors there, for giving us the background and support we needed to flourish as attorneys.

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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 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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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 7, 2012

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 handheld 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.

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THE ROOTS OF TRADE DRESS

A. 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 color schemes and unique shapes 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. However, part 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 seen 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

[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).