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TRADE DRESS PROTECTION: INHERENT DISTINCTIVENESS AS AN ALTERNATIVE TO SECONDARY MEANING

INTRODUCTION

Trade dress is the overall appearance or the "look" of a product. Although originally limited to a product's package, the concept of trade dress now includes the design of a product itself. One court has defined it as "the total image of a product[,] which may include features such as size, shape, color or color combinations, texture, graphics, or even particular sales techniques." In analyzing trade dress, the elements of the product's appearance must not be isolated and examined individually, but must be considered as a whole.

Trade dress is a more expansive term than trademark. A trade dress, nevertheless, may be federally registered as a trademark on either the


Some of the leading trade dress cases involve restaurant decor. See, e.g., Fuddruckers, 826 F.2d at 839; Prufrock Ltd. v. Lasater, 781 F.2d 129, 130 (8th Cir. 1986). A mark applied to a restaurant is considered a service mark, rather than a trademark. 1 J. McCarthy, Trademarks and Unfair Competition § 19:30, at 937-38 (2d ed. 1984 & Supp. 1988). A service mark is "used in the sale or advertising of services to identify and distinguish the services of one person, including a unique service, from the services of others and to indicate the source of the services, even if that source is unknown." Lanham Act § 45, 15 U.S.C. § 1127 (1982 & Supp. V 1987). Service marks may be registered, and they receive the same treatment and protections as trademarks. See Lanham Act § 3, 15 U.S.C. § 1053 (1982). The trade dress of a service, such as restaurant decor, should be treated the same as the trade dress of a product. See Fuddruckers, 826 F.2d at 841; Prufrock, 781 F.2d 132. Therefore, this Note does not distinguish between the trade dress of a service and that of a product.

2. See S. Kane, Trademark Law: A Practitioner's Guide 43 (1987) ("Product design as well as product packaging and labeling are now all referred to as trade dress."); see, e.g., LeSportsac, Inc. v. K Mart Corp., 754 F.2d 71, 75 (2d Cir. 1985) ("the design of a product itself may function as its packaging . . . and hence be protectable trade dress"); Ideal Toy Corp. v. Plawner Toy Mfg., 685 F.2d 78, 80 n.2 (3d Cir. 1982) (packaging and appearance of "Rubik's Cube" considered trade dress).


5. See M. Kramer Mfg. v. Andrews, 783 F.2d 421, 448 n.25 (4th Cir. 1986). A trademark is "any word, name, symbol, or device or any combination thereof adopted and used by a manufacturer or merchant to identify and distinguish his goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown." Lanham Act § 45, 15 U.S.C. § 1127 (1982 & Supp. V 1987). For definitions and examples of types of trademarks, see infra notes 75-76.
Principal Register\(^6\) or Supplemental Register\(^7\) if the trade dress meets the requirements for trademark registration.\(^8\) Trade dress, however, often remains unregistered because the trade dress contains functional features or was not originally intended to identify the source.\(^9\) Although an unregistered trademark lacks the presumed validity of a registered trademark, it may still be protected from infringement if it has either "secondary meaning" or "inherent distinctiveness."\(^10\) In the case of an unregistered trade dress, the courts do not agree whether the same requirements must be met for protection or whether a different test is appropriate.\(^11\)

This Note discusses whether trade dress should be protected from unauthorized use when it has no secondary meaning but is inherently distinctive. Part I examines the legislation covering trade dress protection and how courts have interpreted this legislation. Part I then examines

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6. Registration on the Principal Register requires submission of an application and fee to the United States Patent & Trademark Office and a mark that: (1) meets the Lanham Act definition of trademark; (2) is in actual use in interstate commerce; (3) is "affixed" to the goods, and (4) is not barred from registration by Lanham Act § 2, 15 U.S.C. § 1052 (1982). 1 J. McCarthy, supra note 1, § 19-6, at 884-85. Section 2 of the Lanham Act bars the registration of marks comprising, for example, immoral matter, the flag of the United States, or the name of a living person without his consent. See 15 U.S.C. § 1052 (1982).

7. Registration on the Supplemental Register requires merely that a mark be "capable of distinguishing the applicant's goods or services." 1 J. McCarthy, supra note 1, § 19-8, at 886. It is not necessary that the mark actually indicate origin, only that it is capable of doing so over time. See id. § 19-8B, at 889; S. Kane, supra note 2, at 78. United States trademark registration is a prerequisite to obtaining trademark registration and protection in many foreign countries. A basic purpose of the Supplemental Register is to provide such registration. 1 J. McCarthy, supra note 1, § 19-8, at 886. A mark may not be registered on the Supplemental Register if it is eligible for registration on the Principal Register. Id. § 19-8F, at 891. Registration on the Supplemental Register excludes a mark from certain advantages of registration on the Principal Register such as prima facie evidence of the exclusive right to use a mark and constructive notice of a claim of ownership. Id. § 19-8A, at 887.


9. See S. Kane, supra note 2, at 43; 1 J. McCarthy, supra note 1, § 19-8, at 889; Schuman, supra note 8, at 796-97; Strimbeck, The Developing Federal Law on the Protection of Product Trade Dress Under the Lanham Act, 15 USC Sec. 1127, 23 N.H. B. J. 85, 85-86 (1982). A merchant or manufacturer may not think to immediately register a trade dress as a trademark because his goal may have been simply to create an attractive or practical package rather than an indicator of the product's source. See Schuman, supra note 8, at 800; Strimbeck, supra, at 88.


the inherent distinctiveness and secondary meaning tests as they apply to the two components of trade dress, product design and package design. Part II analyzes whether the inherent distinctiveness test can properly be used to protect product design as trade dress, given the distinctions among trademark, copyright and patent laws. Part III applies the same analysis to whether package design can receive trade dress protection under the inherent distinctiveness test. This Note concludes that inherent distinctiveness is a proper test for protecting a trade dress of package design from infringement but not for protection of the design of a product itself.

I. TRADE DRESS PROTECTION

A. Section 43(a) of the Lanham Act

The Lanham Act governs trademark registration and protection. Congress enacted the Lanham Act to serve two primary purposes. The first is to protect the consuming public from counterfeit or imitated marks and false trade descriptions so that consumers actually receive the products they desire. Second, the Act protects the manufacturers’ and merchants’ goodwill and their investment of “energy, time, and money” from “misappropriation by pirates and cheats.”

Section 43(a) of the Lanham Act codifies the federal unfair competition law, which includes the protection of trade dress from infringement. A successful claim for trade dress infringement under section 43(a) requires proof of three elements. First, the trade dress must be

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14. Id. at 3, reprinted in 1946 U.S. Code Cong. Serv. 1274, 1274. An additional objective of the Lanham Act is to defeat monopolies and stimulate competition through the limited protections offered by a trademark. Id. at 3-4, reprinted in 1946 U.S. Code Cong. Serv. 1274, 1274-75. For a comparison of trademark restrictions on competition with the monopolies granted by patents and copyrights, see infra notes 46-51 and accompanying text.
15. Section 43(a) of the Lanham Act provides in pertinent part:
Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which ... is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person ... shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.
16. See, e.g., American Greetings Corp. v. Dan-Dee Imports, Inc., 807 F.2d 1136, 1140 (3d Cir. 1986) (“[Section] 43(a) provides a cause of action for unprivileged imitation, including trade dress infringement.”); J. Gilson, Trademark Protection and Practice § 7.02, at 7-7 (1987) (“[section 43(a)] prohibits use of a confusingly similar ... [trade
nonfunctional. Second, the trade dress of the competitor’s product must be so similar to the trade dress of plaintiff’s product that confusion as to the product’s source is likely. Courts agree on these first two elements but are split on the third requirement. A number of courts require that the trade dress have acquired “secondary meaning,” while other courts require that the trade dress either have “secondary meaning” or be “inherently distinctive.”

B. Secondary Meaning and Inherent Distinctiveness

The traditional approach to trade dress protection, steadfastly followed by a number of courts of appeals, requires that the trade dress have “secondary meaning.” Secondary meaning is the mental associa-

dress”); I J. McCarthy, supra note 1, § 8:1, at 284 (“[section] 43(a) has often been used as a vehicle by which to assert trade dress protection”).

Although trade dress infringement certainly comes under section 43(a), disagreement exists as to whether trade dress infringement qualifies as a “false designation of origin” or as a “false representation.” Trade dress infringement has often been deemed a “false designation of origin.” Truck Equip. Serv. Co. v. Fruehauf Corp., 536 F.2d 1210, 1216 (8th Cir.), cert. denied, 429 U.S. 861 (1976); see, e.g., Inwood Labs., Inc. v. Ives Labs., Inc., 456 U.S. 844, 863 (1982) (White, J., concurring) (confusingly similar product or package design may be a “false designation of origin”); Brunswick Corp. v. Spinit Reel Co., 832 F.2d 513, 516 (10th Cir. 1987) (action under section 43(a) for injury caused by “false designation of origin”); Stormy Cline Ltd. v. Progroup, Inc., 809 F.2d 971, 974 (2d Cir. 1987) (“false designation of origin” linked to trade dress protection).


If a trade dress is “essential to the use or purpose of the article or... affects the cost or quality,” it is functional and fails the first requirement. See Inwood Labs., Inc. v. Ives Labs., Inc., 456 U.S. 844, 850 n.10 (1982). For a thorough discussion of functionality, see Note, The Problem of Functional Features: Trade Dress Infringement Under Section 43(a) of the Lanham Act, 82 Colum. L. Rev. 77 (1982).

18. See, e.g., Brunswick, 832 F.2d at 516-17; AmBrit, 812 F.2d at 1535; First Brands, 809 F.2d at 1381; Stormy Cline, 809 F.2d at 974; American Greetings, 807 F.2d at 1141.

19. See supra note 11 and accompanying text.

20. See infra note 22 and accompanying text.

21. See infra notes 32-33 and accompanying text.

22. See, e.g., First Brands Corp. v. Fred Meyer, Inc., 809 F.2d 1378, 1381 (9th Cir. 1987); Stormy Cline Ltd. v. Progroup, Inc., 809 F.2d 971, 974 (2d Cir. 1987); American Greetings Corp. v. Dan-Dee Imports, Inc., 807 F.2d 1136, 1141 (3d Cir. 1986); Prufrock Ltd. v. Lasater, 781 F.2d 129, 132 (8th Cir. 1986); Kwik-Site Corp. v. Clear View Mfg.,
tion by a substantial part of the consuming public of a product's trade dress with its source, whether that source is known or unknown. Secondary meaning results from "long use and favorable acceptance" and is acquired when a trade dress is associated with a single source, not just with the product itself. Examples of trade dress found to have secondary meaning include the color and shape of antifreeze bottles, "tummy graphics" on teddy bears, and restaurant decor. Once secondary meaning has been acquired, the combination of features constituting a trade dress is protected.

The original "source" need not actually produce or sell goods that have been "copied" to claim infringement of its trade dress; the trade dress need only acquire secondary meaning causing consumers to identify an infringer's product with a particular source. For example, the unauthorized production of a toy car that was modeled after a car in a popular television series, "The Dukes of Hazard," violated section 43(a) because consumers identified the toy car with the source of the television series, not with the toy manufacturer.

The Fifth Circuit departed from the accepted approach of trade dress protection by holding that proof of secondary meaning is not necessary for an "inherently distinctive" trade dress. Other courts have employed this rule. Under this approach, inherent distinctiveness functions as an alternative test for trade dress protection and not as a

758 F.2d 167, 178 (6th Cir. 1985); Keebler Co. v. Rovira Biscuit Corp., 624 F.2d 366, 378 (1st Cir. 1980).


26. See First Brands Corp. v. Fred Meyer, Inc., 809 F.2d 1378, 1383 (9th Cir. 1987).


28. See Prufrock Ltd. v. Lasater, 781 F.2d 129, 132 (8th Cir. 1986).

29. See American Greetings, 807 F.2d at 1144.


31. See id. at 334.


33. See, e.g., AmBrit, Inc. v. Kraft, Inc., 812 F.2d 1531, 1535-37 (11th Cir. 1986) (ice cream bar wrapper held inherently distinctive), cert. denied, 481 U.S. 1041 (1987); Blau Plumbing, Inc. v. S.O.S. Fix-It, Inc., 781 F.2d 604, 608 (7th Cir. 1986) (secondary meaning not required "if the trade dress is a distinctive, identifying mark"); J.M. Huber Corp. v. Lowery Wellheads, Inc., 778 F.2d 1467, 1469-70 (10th Cir. 1985) (inherent distinctiveness test applied to alphanumeric symbols used on a label).
replacement for the secondary meaning test. Accordingly, if trade dress either has acquired secondary meaning or is inherently distinctive, it may not be copied with impunity.

In contrast to secondary meaning, inherent distinctiveness does not require public exposure over a long period of time. To be inherently distinctive, a product must have certain intrinsic characteristics that distinguish it and immediately become an indication of source. Courts have found trade dress that is "arbitrary or fanciful, and not descriptive or functional" to be inherently distinctive. Examples include the wrapper of the Klondike ice cream bar, packaging for Ortho agricultural chemicals, "emotionally expressive non-occasion greeting card[s]," and slippers in the shape of bear paws.

II. PRODUCT DESIGN AND THE ROLES OF INTELLECTUAL PROPERTY LAWS

The scope of trade dress protection, originally limited to a product's package, has grown over the years to include the design and appearance of the product itself. As a result of this expansion, the range of trade dress protection has gradually crept into the domains of other intellectual property laws, such as copyrights and design patents. Although patent, copyright and trademark protection may be claimed for a single product, fundamental distinctions exist among the various forms of intellectual property laws.

34. See, e.g., Vaughan Mfg. v. Brikam Int'l, Inc., 814 F.2d 346, 348 (7th Cir. 1987) ("secondary meaning need not be shown where the trade dress, by itself, is a distinctive, identifying mark, but must be shown where the trade dress is not inherently distinctive"); AmBrit, Inc. v. Kraft, Inc., 812 F.2d 1531, 1535 (11th Cir. 1986) ("plaintiff must prove that its trade dress is inherently distinctive or has acquired secondary meaning"), cert. denied, 481 U.S. 1041 (1987); cf. Brunswick Corp. v. Spinit Reel Co., 832 F.2d 513, 517 n.2 (10th Cir. 1987) (inherent distinctiveness not considered since secondary meaning not challenged).


37. Id.; see Vaughan Mfg. v. Brikam Int'l, Inc., 814 F.2d 346, 348 (7th Cir. 1987).

38. Sicilia, 732 F.2d at 425 n.3; see Chevron Chem. Co. v. Voluntary Purchasing Groups, 659 F.2d 695, 702 (5th Cir. Unit A Oct. 1981), cert. denied, 457 U.S. 1126 (1982). For factors commonly used to determine the inherent distinctiveness of a trade dress and examples of their applications, see infra notes 121-27 and accompanying text.


40. See Chevron, 659 F.2d at 703.


42. See Animal Fair, Inc. v. Amfesco Indus., 620 F. Supp. 175, 190 (D. Minn. 1985), aff'd, 794 F.2d 678 (8th Cir. 1986).

43. See supra notes 1-3 and accompanying text.

44. The reader should keep in mind that a functionality test also must be applied to determine trade dress protection and that the discussion here only pertains to trade dress that is nonfunctional. See supra note 17 and accompanying text.

45. See S. Kane, supra note 2, at 7; 1 J. McCarthy, supra note 1, § 6:1, at 147.
The basic purpose of trademark law is to prevent others from using a mark if it is likely to cause confusion as to a product's source. In contrast, copyright law aims primarily to prevent deliberate, substantial copying of an original work that is in a tangible form. A design patent stops others from making, using and selling, "any new, original and ornamental design for an article of manufacture." The periods of protection for trademarks, copyrights and patents vary according to the degrees of restrictions imposed on competition by each; copyrights and patents restrict competition to greater degrees than trademarks and, therefore, offer protection for shorter periods. The distinctions among copyrights, patents, and trademarks must be maintained. Although some products may meet the criteria for protection by copyright, patent, and trademark laws, trademark protection must not be given to the kinds of products that only meet the criteria for protection by copyright or patent laws so that the greater protections offered by copyright and patent laws are not extended for the potentially limitless trademark time period.

The problem is illustrated by Animal Fair, Inc. v. Amfesco Industries, Inc., which involved novelty slippers in the shape of bear claws. In Animal Fair, the plaintiff sought to enjoin the manufacture and promotion of a similar slipper by a competitor and brought an action for violations of copyright and unfair competition laws. The court held that there was likelihood of success on the merits in both the copyright and section 43(a) claims. Because the issue was the deliberate and substantial copying of the plaintiff's original product, the court was justified in granting an injunction.

50. *Id.* § 171.

A copyright allows the author to bar the intentional copying of his copyrighted work and therefore offers a greater degree of protection than a trademark. See 17 U.S.C. §§ 106, 501 (1982). However, a copyright lasts a shorter period, generally life of the author plus fifty years. See *id.* § 302(a). Works for hire receive copyright protection for seventy-five years from first publication or one hundred years from first creation, whichever is earlier. See *id.* at § 302(c).

A design patent restricts competition to the greatest degree because it gives the patent holder the right to bar anyone from making, using or selling the patented item. See 35 U.S.C. § 271 (1982). It endures only fourteen years. *Id.* § 173. Trademark protection may exist independently during or after the copyright or patent period. See 1 J. McCarthy, *supra* note 1, § 6:3, at 156-57; *infra* note 67.

53. See *id.* § 6:2, at 148-49.
54. 620 F. Supp. 175 (D. Minn. 1985), aff'd, 794 F.2d 678 (8th Cir. 1986).
55. *Id.* at 177.
56. *See id.* at 189.
57. *See id.* at 191.
tial copying of a product design, the copyright action would have given
the plaintiff's product design sufficient protection from imitation, espe-
cially considering the short duration of the market for novelty items.58
However, the court went on to find a violation of section 43(a) as well,
holding that the slippers met both the inherent distinctiveness and sec-
dary meaning tests for trade dress protection.59 The successful plaintiff
thus had the right to the exclusive manufacture of bear-claw slippers of
the type which he had designed not only for the copyright period of life
of the author plus fifty years but also, under trademark law, for as long as
he desired, potentially forever.

In Animal Fair, the court granted trademark status to the design of a
product itself because the court found the design inherently distinctive.60
This essentially gives the product design protection beyond that intended
by trademark law.61 Providing protection for a product design because of
its originality matches the basic purposes of patent and copyright laws
more exactly than that of trademark law, which is concerned with pro-
ecting the identity of sources of goods.62 Originality is an essential ele-
ment for copyright and design patent protections,63 and a distinctive
product design should be evaluated under those laws rather than under
the inherent distinctiveness standard applicable to trade dress.64 Applying
the inherent distinctiveness test under trademark law to product de-
sign results not only in the prevention of unfair competition but also in
the prevention of any competition at all in a product deemed inherently
distinctive.65

When a product design acquires secondary meaning, however, a suffi-
cient basis exists to give that product trademark status and protection.
The heavy burden of proving secondary meaning ensures the existence of
a strong connection in the public's mind between a product and a
source.66 While the inherent distinctiveness test permits the first manu-
ufacturer or merchant who comes out with an inherently distinctive trade
clothing to claim protection, the secondary meaning test does not entitle the
manufacturer or merchant to protection simply by coming out with a

58. See id. at 183 (two year maximum market for novelty items).
59. See id. at 190.
60. Id.
61. See supra notes 13-14 and accompanying text.
62. 1 J. McCarthy, supra note 1, § 6:2, at 148-49.
63. See supra notes 48, 50 and accompanying text. The term "originality" has differ-
ent meanings under copyright and patent laws. The copyright originality requirement is
met more easily by "almost any independent effort." See 1 M. Nimmer & D. Nimmer,
Nimmer on Copyright § 2.01[B], at 2-11 to 2-15 (1988). Originality in the patent sense
requires novelty and must go beyond the prior art in a way that is not obvious. See 35
64. See infra notes 121-27 and accompanying text.
65. Application of the inherent distinctiveness test to package and display design does
not present this problem because of the infinite variety of alternatives available. See infra
notes 97-98 and accompanying text.
66. See infra notes 99-115 and accompanying text.
product first. Unlike inherent distinctiveness, secondary meaning is a rigorous test based on empirical proof that a trade dress has become an indicator of source. A product design meeting this test should be given trademark protection, in spite of the resulting restrictions on competition, in order to promote the purpose of the Lanham Act—the prevention of confusion in the marketplace as to a product's source. Copyright protection, although it would not restrict competition as much, would not provide the full protection the Lanham Act was meant to give a definite identifier of source.

III. THE INHERENT DISTINCTIVENESS TEST AND PACKAGE DESIGN

Although inherent distinctiveness is not an appropriate test for the protection of product design, it is a valid test for package design. With respect to package design, the application of trademark law to trade dress is appropriate because of the similarities between trademarks and trade dress. In addition, protecting an inherently distinctive package design does not violate the principles of unfair competition, but rather such protection is supported by them.

A. Application of Trademark Law to Package Design

In applying the inherent distinctiveness test for the first time in a trade dress case, the Court of Appeals for the Fifth Circuit applied the same standards that are employed in trademark cases. While a number of courts base the application of section 43(a) to trade dress on unfair competition, other courts have brought trade dress within the realm of trademarks by holding that section 43(a) protects trade dress that has attained the status of an unregistered trademark.

Under trademark law, inherently distinctive symbols and designs can be registered and protected as trademarks without proof of secondary

67. A trade dress could have copyright protection or could be granted a design patent and, during the period of patent or copyright protection, develop sufficient secondary meaning to have trademark protection. See In re Mogen David Wine Corp., 372 F.2d 539, 543, 545 (C.C.P.A. 1967) (Smith, J., concurring) (design patent laws and trademark laws independent and not in conflict); 17 U.S.C. § 301(d) (1982) (“Nothing in this title annuls or limits any rights or remedies under any other Federal statute.”).

68. See infra notes 100-15 and accompanying text.


71. See infra note 91 and accompanying text.

72. See, e.g., Brunswick Corp. v. Spinit Reel Co., 832 F.2d 513, 517 (10th Cir. 1987) (trade dress may be "so distinctive as to become an unregistered trademark eligible for protection under the Lanham Act"); Blau Plumbing, Inc. v. S.O.S. Fix-It, Inc., 781 F.2d 604, 608 (7th Cir. 1986) ("there is probably no substantive legal difference between [the] terms [trade dress and trademark]"); "courts have generally not thought it important whether trade dress is a form of trademark; but it is"); LeSportsac, Inc. v. K Mart Corp., 754 F.2d 71, 75 (2d Cir. 1985) ("‘trade dress’ of a product... may become an unregistered trademark").
meaning.\(^7\) "[T]rademark law requires a demonstration of 'secondary meaning' only when the claimed trademark is not sufficiently distinctive of itself to identify the producer."\(^7\) Terms, symbols and designs that require secondary meaning include descriptive terms, geographically descriptive terms, personal names, grade or quality designations, slogans and literary titles.\(^7\) Inherently distinctive trademarks include arbitrary, fanciful and suggestive marks.\(^7\) Generic terms lack the capacity for inherent distinctiveness and secondary meaning and therefore can never be trademarks.\(^7\) Because trade dress protection is often based on the theory that a trade dress is an unregistered trademark, the principles of trademark law should apply to trade dress.\(^7\) As the Court of Appeals

\(^7\) See Chevron, 659 F.2d at 702; 1 J. McCarthy, *supra* note 1, § 7:7, at 196.

\(^7\) Chevron, 659 F.2d at 702.


A descriptive mark is "descriptive of: the intended purpose, function or use of the goods; of the size of the goods, of the class of users of the goods, of a desirable characteristic of the goods, or of the end effect upon the user." 1 J. McCarthy, *supra* note 1, § 11:5, at 442-43 (footnotes omitted). Examples of descriptive marks include Bufferin for buffered aspirin, Food Fair for supermarkets, Lights for low tar and nicotine cigarettes, Raisin-Bran for raisin and bran cereal and Vision Center for optical clinics. *Id.* at 449-53.

\(^7\) 1 J. Gilson, *supra* note 16, § 2.09, at 2-68; 1 J. McCarthy, *supra* note 1, § 15:1, at 656; Ropski & Johnson, *supra* note 11, at 213.

"Arbitrary marks comprise those words, symbols, pictures, etc., which are in common linguistic use but which, when used with the goods or services in issue, neither suggest nor describe any ingredient, quality or characteristic of those goods or services." 1 J. McCarthy, *supra* note 1, § 11:4, at 439. Examples of arbitrary marks include Command for hair care products, Nova for a television series and Sun for a bank. *Id.* at 441.

"'Fanciful' marks consist of 'coined' words which have been invented for the sole purpose of functioning as a trademark." *Id.* § 11:3, at 436. Clorox, Kodak and Kotex are examples. *Id.* at 438. Suggestive marks "suggest[] some quality or ingredient of goods" and must be distinguished from descriptive marks. *Id.* § 11:20, at 488. Suggestive marks include Chicken of the Sea for tuna fish, Loc-Top for bottle closure caps, Playboy for a magazine and Wrangler for western boots and jeans. *Id.* at 499-502.


\(^7\) See Blau Plumbing, Inc. v. S.O.S. Fix-It, Inc., 781 F.2d 604, 608 (7th Cir. 1986) (it is "high time" that trademark law be applied to trade dress cases).

Indeed, trade dress cases often rely on holdings in trademark cases. Standards established in trademark cases have been used to determine secondary meaning in trade dress cases. See Vaughan Mfg. v. Brikam Int'l, Inc., 814 F.2d 346, 349 (7th Cir. 1987) (citing A.J. Canfield Co. v. Vess Beverages, Inc., 796 F.2d 903, 908 (7th Cir. 1986)); Sno-Wizard Mfgs. v. Eisemann Prods. Co., 791 F.2d 423, 427 (5th Cir. 1986) (quoting Zatarains, Inc. v. Oak Grove Smokehouse, Inc., 698 F.2d 786, 795 (5th Cir. 1983)). For a discussion of proof of secondary meaning, see *infra* notes 99-115 and accompanying text.

for the Seventh Circuit stated, "Labels should not determine rights." 79

The similarities between trademarks and trade dress support the application of trademark law to package design cases. Trade dress and trademarks both use the same classifications: generic, descriptive, suggestive or arbitrary with distinctiveness increasing toward the suggestive and arbitrary end of the classification range. 80 Because package design involves such an infinite variety of possible elements, 81 it is analogous to arbitrary, fanciful and suggestive marks and, like those marks, inherent distinctiveness is a proper test for protection from infringement. 82

The application of the inherent distinctiveness test to trade dress has been criticized because the trade dress thus "seeks to avail itself of the benefits ... registration would have secured to it" without actually being registered. 83 Unregistered trademarks, however, may be protected under section 43(a) 84 and the inherent distinctiveness test has been applied to them. 85

B. Application of the Law of Unfair Competition to Package Design

Even if the similarities between trademarks and trade dress are not accepted as a basis for applying the inherent distinctiveness test to package design, use of the test is still justified under the broader law of unfair competition. 86 Commentators and courts have been unable to develop a

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81. See infra notes 97-98 and accompanying text.

82. See supra note 76 and accompanying text. Product design is closer to a descriptive trademark, rather than an arbitrary, fanciful or suggestive mark, because it is the equivalent of descriptive words. See In re DC Comics, Inc., 689 F.2d 1042, 1051 (C.C.P.A. 1982) (Nies, J., concurring); supra notes 75-76 and accompanying text. Descriptive marks require secondary meaning and, therefore, requiring secondary meaning for a product design is in keeping with trademark law. See supra note 75 and accompanying text.


84. See S. Kane, supra note 2, at 200; 2 J. McCarthy, supra note 10, § 27-3, at 345.


86. The scope of unfair competition is greater than that of trademark infringement. There is ... a fundamental distinction ... between trade-mark infringement and unfair competition. Trade-mark infringement rests on a relatively narrow principle compared to unfair competition. The essential element of a trade-mark is the exclusive right of its owner to use a word or device to distinguish his product. On the other hand, a claim of unfair competition considers the total physical image given by the product and its name together. Thus, unfair competition exists if the total impression of package, size, shape, color, design and name upon the consumer will lead him to confuse the origin of the product.
workable definition of unfair competition, and a determination of unfair competition must be made on a case-by-case basis. The law of unfair competition may be easiest to comprehend through its objectives, which include "the promotion and encouragement of competition" and the "prevention of one person from passing off his goods or his business as the goods or business of another." Imitation may be considered unfair competition, and consequently, the law of unfair competition protects trade dress from infringement.

A goal of the Lanham Act is to protect merchants and manufacturers from unfair competition and, as a result, section 43(a) has shifted most unfair competition cases from state to federal courts since 1970. One way manufacturers compete is by using similar package designs, and standards are necessary to determine whether this kind of competition is unfair. Secondary meaning is one such standard, but it is often difficult or impossible to prove. Thus, requiring secondary meaning as a prerequisite to trade dress protection raises the risk of unfair competition. The inherent distinctiveness test prevents the unfair competition that would result from the copying of an unusual or unique package design when secondary meaning cannot be proven.

In guarding against unfair competition, fair competition must not be restricted. Providing protection of inherently distinctive package and display designs does not inhibit fair competition. The possible variations of design elements for a display or package are virtually infinite in the areas of fanciful, arbitrary and suggestive trade dress, and the potential

Jean Patou, Inc. v. Jacqueline Cochran, Inc., 201 F. Supp. 861, 863 (S.D.N.Y. 1962), aff'd, 312 F.2d 125 (2d Cir. 1963); see Sun-Fun Prods., Inc. v. Suntan Research & Dev. Inc., 656 F.2d 186, 192 (5th Cir. Unit B Sept. 1981); 1 J. McCarthy, supra note 1, § 8:1, at 282-83. The emphasis on total image contained in this definition of the scope of unfair competition echoes the importance of total image in the definition of trade dress. See supra notes 1-3 and accompanying text.

87. See 1 J. McCarthy, supra note 1, § 1:3-4, at 12-16.

88. Id. § 1:1, at 2.


90. See 1 J. McCarthy, supra note 1, § 1:1, at 4.

91. See Vaughan Mfg. v. Brikam Int'l, Inc., 814 F.2d 346, 347 n.1 (7th Cir. 1987); Fabrica Inc. v. El Dorado Corp., 697 F.2d 890, 894 (9th Cir. 1983); 1 J. McCarthy, supra note 1, § 1:5, at 16; Schuman supra note 8, at 781.


93. See 1 J. McCarthy, supra note 1, § 1:9, at 24-25. Section 43(a) is not limited to trademark infringement and includes all forms of unfair competition. See Blau Plumbing, Inc. v. S.O.S. Fix-It, Inc., 781 F.2d 604, 608 (7th Cir. 1986).

94. See 1 J. McCarthy, supra note 1, § 8:1, at 282-85.

95. Schuman, supra note 8, at 807; see infra notes 99-115 and accompanying text.

96. See infra notes 108-12 and accompanying text regarding the difficulty of proving secondary meaning based on intentional copying.

97. The use of the inherent distinctiveness test has been justified in a trade dress case because "[t]he wide range of available packaging and design options allows a producer to appropriate a distinctive identity without unduly hindering his competitors' ability to compete." Sicilia Di R. Biebow & Co. v. Cox, 732 F.2d 417, 426 n.7 (5th Cir. 1984). However, due to their general use and the resultant lack of identity with a source of goods, common colors and shapes do not qualify as inherently distinctive trade dress and
negative effects of a design monopoly being created by application of the
inherent distinctiveness test do not exist.98

C. Additional Arguments for Use of the Inherent Distinctiveness Test
for Package Design Protection

Whether application of the inherent distinctiveness test to trade dress
is based on trademark law or the law of unfair competition, additional
arguments support inherent distinctiveness as a test for product design
protection.

1. Difficulty of Proving Secondary Meaning

In litigation, the party claiming trade dress protection based on the
secondary meaning test has the burden of proof,99 and secondary mean-
ing is sometimes very difficult and costly to prove.100 Limiting trade
dress protection to the secondary meaning test could make it impossible
to provide protection for package and display designs that, otherwise,
would easily be adjudged inherently distinctive. There are three basic
methods of proving secondary meaning and each presents its own pitfalls
and roadblocks to the protection of trade dress.

First, market survey data may be the most effective way of proving
secondary meaning if the survey shows the trade dress has established
the necessary connection between the producer and the product in the
mind of the consuming public.101 However, the expense of a survey
could deter a trade dress owner from seeking protection for his trade
dress.102 Even if one can afford to conduct a survey, they are difficult to
design and may not be successful.103 To be admissible as evidence, a
survey must be conducted according to generally accepted market re-
search principles and the results must be used according to proper statis-
tical methods.104

are not protected unless secondary meaning is proven. See Blau Plumbing, Inc. v. S.O.S.
Fix-It, Inc., 781 F.2d 604, 610 (7th Cir. 1986); Freixenet, S.A. v. Admiral Wine & Liquor
Co., 731 F.2d 148, 153 (3d Cir. 1984); 1 J. McCarthy, supra note 1, § 7:8, at 202.
98. See Fuddruckers, Inc. v. Doc's B.R. Others, Inc., 826 F.2d 837, 844 (9th Cir.
1987); Chevron Chem. Co. v. Voluntary Purchasing Groups, 659 F.2d 695, 702-03 (5th
Quilting Co., 618 F.2d 950, 953 (2d Cir. 1980) (applying New York law), cert. denied,
459 U.S. 832 (1982).
99. Palladino, Techniques for Ascertaining If There Is Secondary Meaning, 73
(quoting Zatarains, Inc. v. Oak Grove Smokehouse, Inc., 698 F.2d 786, 795 (5th Cir.
1983) (trademark infringement case)).
101. 1 J. McCarthy, supra note 1, § 15:14, at 691.
102. Palladino, supra note 100, at 404.
103. See, e.g., Brunswick Corp. v. Spinit Reel Co., 832 F.2d 513, 522-23 (10th Cir.
1987) (defendant alleged "technical and methodological deficiencies" in survey); First
Brands Corp. v. Fred Meyer, Inc., 809 F.2d 1378, 1383 (9th Cir. 1987) (flawed survey
"biased respondents, did not control for guessing, and failed to take into account the
A consumer survey may not be necessary if other evidence sufficiently indicates that consumers would associate the trade dress with a producer. A large volume of sales or extensive advertising that features the trade dress is the second way of proving secondary meaning. Extensive advertising, however, will not prove secondary meaning if the trade dress is not prominently featured in the advertisements or promotional efforts.

Finally, deliberate attempts by one producer to capitalize on the secondary meaning of another's trade dress by imitating that trade dress may be evidence of secondary meaning. This method of proof, however, presents problems. Intentional copying alone may not be enough to establish secondary meaning because the imitator's primary reason for copying a trade dress may not have been to benefit from the secondary meaning of another's trade dress. A product's trade dress may be copied because of its attractive or innovative design without any intention of taking advantage of consumer recognition, or competitors may copy functional features that lack secondary meaning. In addition, the fact that a competitor had the intent to imitate may be difficult to prove. Use of intentional imitation as proof of secondary meaning creates an

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strong association of the brand name . . . with [the class of product] in general); Snowizard Mfg. v. Eisemann Prods. Co., 791 F.2d 423, 427 (5th Cir. 1986) (survey results failed to establish secondary meaning due to erroneous interpretation of results and biased interview techniques); see also 5 J. Weinstein & M. Berger, Weinstein's Evidence ¶ 901(b)(9)[03], at 901-115 to -120 (1983). For an in-depth discussion of how to design questions to measure secondary meaning, see Palladino, supra note 100.


106. See Vaughan, 814 F.2d at 349; First Brands Corp. v. Fred Meyer, Inc., 809 F.2d 1378, 1383 (9th Cir. 1987); LeSportsac, 754 F.2d at 78.


108. See, e.g., Fuddruckers, Inc. v. Doc's B.R. Others, Inc., 826 F.2d 837, 844 (9th Cir. 1987) (“evidence of deliberate copying is relevant to a determination of secondary meaning”); M. Kramer Mfg. v. Andrews, 783 F.2d 421, 448 (4th Cir. 1986) (“evidence of intentional, direct copying establishes a prima facie case of secondary meaning” and shifts the burden to defendant to prove lack of secondary meaning); Blau Plumbing, Inc. v. S.O.S. Fix-It, Inc., 781 F.2d 604, 611 (7th Cir. 1986) (adoption by defendant of plaintiff's trade dress because he thinks it has acquired secondary meaning is an inference of secondary meaning); see also Strimbeck, supra note 9, at 89-91, 93 (not necessary to prove secondary meaning if the alleged infringer intended to copy).


economic problem as well. Providing protection to the source of an inten-
tionally imitated trade dress permits “the first seller of a product [to]
appropriate the simplest of trade dress, the most elementary of descrip-
tive terms, and there[by] make it more costly for the next seller to com-
pete with him.”\footnote{112}

The stringent requirements of each of the three methods result in a
heavy burden on the party seeking to prove secondary meaning.\footnote{113} In
\textit{J.M. Huber Corp. v. Lowery Wellheads, Inc.},\footnote{114} for example, despite evi-
dence that the plaintiff had used a trade dress for thirty-four years, sold
$45 million worth of products bearing the trade dress in a ten-year pe-
riod, spent about $500,000 in advertising, and distributed about 12,000
catalogs, he was unable to convince the court that secondary meaning
had been acquired.\footnote{115} The heavy burden of proving secondary meaning,
even when the package design is inherently distinctive, runs contrary to
the legislative intent of the Lanham Act to protect consumers from imi-
tated marks and to protect the goodwill and investment of manufacturers
and merchants.\footnote{116} The alternative test of inherent distinctiveness pro-
vides potential protection for trade dress that would otherwise be left
unprotected because of the difficulty of proving secondary meaning.

\section{2. Inherent Distinctiveness Test Standards}

The acceptance of an inherent distinctiveness test acknowledges that
an unusual design will quickly lead to the association of a trade dress
with a source of origin. However, the degree of distinctiveness must be
extraordinary to justify the use of the inherent distinctiveness test.\footnote{117}
The problem with this test has been to express standards that sufficiently
denote the high degree of distinctiveness necessary for a package design
to become an identifier of source.

Courts rejecting the inherent distinctiveness test seem unable to com-
prehend how inherent distinctiveness can be an identifier of source. The
Court of Appeals for the Second Circuit, for example, considers it
anomalous to find a false designation of origin or false representation
without a showing of secondary meaning because “there would be no

\begin{itemize}
\item \footnote{112. \textit{Blau Plumbing}, 781 F.2d at 611.}
\item \footnote{113. 20th Century Wear, Inc. v. Sanmark-Stardust, Inc., 815 F.2d 8, 10 (2d Cir. 1987).}
\item \footnote{114. 778 F.2d 1467 (10th Cir. 1985).}
\item \footnote{115. \textit{Id.} at 1470 (no secondary meaning proven due to lack of “market survey data or other empirical evidence”); \textit{see also} S. Kane, supra note 2, at 50 (courts and adversaries can be expected to note absence of surveys). In \textit{LeSportsac, Inc. v. K Mart Corp.}, 754 F.2d 71 (2d Cir. 1985), “proof of phenomenal sales success, substantial advertising expenditures, unsolicited media coverage, [licensing] requests . . . and [defendant's] deliberate attempt to imitate” was considered not necessarily sufficient to prove secondary meaning. \textit{See id.} at 78.}
\item \footnote{116. \textit{See supra} notes 13-14 and accompanying text.}
\item \footnote{117. \textit{See In re DC Comics, Inc.}, 689 F.2d 1042, 1051 (C.C.P.A. 1982) (Nies, J., con-
curring) (“the more unusual the design”); Brown, \textit{Design Protection: An Overview}, 34
UCLA L. Rev. 1341, 1379 (1987) (“remarkable distinction”).}
\end{itemize}
standard against which to measure such falsity." The Court of Appeals for the Ninth Circuit recently held that a trade dress owner failed to provide an explanation of how inherent distinctiveness can be an indicator of source in the absence of secondary meaning, despite the "intuitive appeal" of his argument. The argument against the inherent distinctiveness test has been best summarized by a commentator who stated that a determination of inherent distinctiveness is "an impermissible exercise of intuitive judging. It substitutes an impression that the design is outstanding . . . for the proofs . . . of secondary meaning." Definable standards, however, have been developed and implemented. To evaluate the inherent distinctiveness of a trade dress, the design must be examined to determine whether it is unique and not a basic shape or merely a refinement of the ornamentation normally found on a type of product. Although these factors may be more difficult to apply in package design cases than in trademark cases because of the need to consider the total appearance of trade dress, they have been successfully applied in trade dress cases.

Basic shapes or common designs, such as geometric shapes used in advertising or common elements of restaurant decor are not inherently distinctive. Uniqueness may determine whether a product's trade dress is inherently distinctive, although individual package designs have frequently been held not unique. Ornamentation lacks inherent distinctiveness if it is merely a variation of decoration commonly used for a type of goods, such as "stripes, bars and designs" on athletic shoes.

119. See Fuddruckers, Inc. v. Doc's B.R. Others, Inc., 826 F.2d 837, 843 (9th Cir. 1987). Many other cases simply state that secondary meaning is the appropriate test without rejecting or acknowledging the possibility of the inherent distinctiveness test. See, e.g., First Brands Corp. v. Fred Meyer, Inc., 809 F.2d 1378, 1381 (9th Cir. 1987); Stormy Clime Ltd. v. Progroup, Inc., 809 F.2d 971, 974 (2d Cir. 1987); American Greetings Corp. v. Dan-Dee Imports, Inc., 807 F.2d 1136, 1141 (3d Cir. 1986).
120. Brown, supra note 117, at 1380.
126. See Brooks Shoe Mfg. v. Suave Shoe Corp., 716 F.2d 854, 858 & n.10 (11th Cir. 1983).
When considering these factors to determine inherent distinctiveness, the importance of the overall appearance of a trade dress, not its constituent elements, must be emphasized.¹²⁷

CONCLUSION

The Lanham Act provides protection for trade dress, which includes product design and package design. A distinction must be drawn, however, between these two categories. The inherent distinctiveness test should not be applied to determine whether a trade dress that consists of product design should be protected from infringement. Secondary meaning is the only appropriate test in that case because application of the inherent distinctiveness test improperly expands trade dress protection into areas reserved for copyrights and patents.

The inherent distinctiveness test is, however, proper for trade dress consisting of package and display design. Because of the numerous possibilities for package and display design, application of the inherent distinctiveness test to this type of trade dress does not restrict competition. To the extent that trade dress identifies a source, it functions as a trademark, whether registered or unregistered, and the same tests that are used for trademarks should apply to protect package and display design from unprivileged copying.

William F. Gaske


However, an exception to the general rule that elements of trade dress should not be considered individually occurs when “third party use of one or more . . . elements of a plaintiff’s trade dress . . . is so extensive and so similar to the plaintiff’s that it impairs the ability of consumers to use the trade dress of the products to identify their source.” AmBrit, 812 F.2d at 1537.