1989

Trade Dress Protection: Inherent Distinctiveness as an Alternative to Secondary Meaning

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Recommended Citation
Available at: http://ir.lawnet.fordham.edu/flr/vol57/iss6/17
TRADE DRESS PROTECTION: INHERENT
DISTINCTIVENESS AS AN ALTERNATIVE TO
SECONDARY MEANING

INTRODUCTION

Trade dress is the overall appearance or the "look" of a product.\(^\text{1}\) Although originally limited to a product's package, the concept of trade dress now includes the design of a product itself.\(^\text{2}\) 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."\(^\text{3}\) 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.\(^\text{4}\)

Trade dress is a more expansive term than trademark.\(^\text{5}\) A trade dress, nevertheless, may be federally registered as a trademark on either the


\(^{2}\) 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.

\(^{3}\) 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\textsuperscript{6} or Supplemental Register\textsuperscript{7} if the trade dress meets the requirements for trademark registration.\textsuperscript{8} Trade dress, however, often remains unregistered because the trade dress contains functional features or was not originally intended to identify the source.\textsuperscript{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."\textsuperscript{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.\textsuperscript{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

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 800; Stimbeck, 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 inher-
ent distinctiveness is a proper test for protecting a trade dress of package
design from infringement but not for protection of the design of a pro-
duct itself.

I. TRADE DRESS PROTECTION

A. Section 43(a) of the Lanham Act

The Lanham Act governs trademark registration and protection.12
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.13 Second, the Act protects the manufacturers’ and
merchants’ goodwill and their investment of “energy, time, and money”
from “misappropriation by pirates and cheats.”14

Section 43(a) of the Lanham Act15 codifies the federal unfair competi-
tion law, which includes the protection of trade dress from infringe-
ment.16 A successful claim for trade dress infringement under section
43(a) requires proof of three elements. First, the trade dress must be

Code Cong. Serv. 1274, 1274-76.
14. Id. at 3, reprinted in 1946 U.S. Code Cong. Serv. 1274, 1274. An additional ob-
jective 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 de-
vice, 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 com-
mercial 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.
News (to be codified at 15 U.S.C. § 1125(a)).
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 Prac-
tice § 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 association of a product with a particular source. 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 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 Clime Ltd. v. Progroup, Inc., 809 F.2d 971, 974 (2d Cir. 1987) ("false designation of origin" linked to trade dress protection).


18. 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).

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 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); Prufock 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 wrap-
per 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 intellec-
tual 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 in-

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 distinct-
ive”); 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).


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.

39. See AmBrit, Inc. v. Kraft, Inc., 812 F.2d 1531, 1536 (11th Cir. 1986), cert. de-

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.
intellectual property law. 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.

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.

46. See 1 J. McCarthy, supra note 1, § 6:2, at 148-49.
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.

52. See 1 J. McCarthy, supra note 1, § 6:2, at 147-48.
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, especially considering the short duration of the market for novelty items. 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 secondary meaning tests for trade dress protection. 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. This essentially gives the product design protection beyond that intended by trademark law. 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 protecting the identity of sources of goods. Originality is an essential element for copyright and design patent protections, and a distinctive product design should be evaluated under those laws rather than under the inherent distinctiveness standard applicable to trade dress. Applying the inherent distinctiveness test under trademark law to product design 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.

When a product design acquires secondary meaning, however, a sufficient 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. While the inherent distinctiveness test permits the first manufacturer or merchant who comes out with an inherently distinctive trade dress 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 different 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 U.S.C. § 103 (1982 & Supp. IV 1986).
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

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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. Spin It 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. Terms, symbols and designs that require secondary meaning include descriptive terms, geographically descriptive terms, personal names, grade or quality designations, slogans and literary titles. Inherently distinctive trademarks include arbitrary, fanciful and suggestive marks. Generic terms lack the capacity for inherent distinctiveness and secondary meaning and therefore can never be trademarks. 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. As the Court of Appeals

73. See Chevron, 659 F.2d at 702; 1 J. McCarthy, supra note 1, § 7:7, at 196.
74. Chevron, 659 F.2d at 702.
75. 1 J. Gilson, supra note 16, § 2.09, at 2-69; 1 J. McCarthy, supra note 1, § 15:1, at 657; Ropski & Johnson, supra note 11, at 213-14.
76. 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.
77. 1 J. Gilson, supra note 16, § 2.02, at 2-8.2 to 2-9; S. Kane, supra note 2, at 18; 1 J. McCarthy, supra note 1, §§ 12:1, 12:14, at 520, 560; Ropski & Johnson, supra note 11, at 214-15. "[G]eneric designations tell . . . what the product is, not where it came from." 1 J. McCarthy, supra note 1, § 12:1, at 520. Generic terms include aspirin, brassiere, cola, mart, shredded wheat and yo-yo. Id. § 12:4, at 533-37.
78. 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 Mfg. 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."\(^7^9\)

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.\(^8^0\) Because package design involves such an infinite variety of possible elements,\(^8^1\) it is analogous to arbitrary, fanciful and suggestive marks and, like those marks, inherent distinctiveness is a proper test for protection from infringement.\(^8^2\)

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.\(^8^3\) Unregistered trademarks, however, may be protected under section 43(a)\(^8^4\) and the inherent distinctiveness test has been applied to them.\(^8^5\)

**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.\(^8^6\) Commentators and courts have been unable to develop a

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\(^7^9\) Blau Plumbing, Inc. v. S.O.S. Fix-It, Inc., 781 F.2d 604, 608 (7th Cir. 1986).


\(^8^1\) See infra notes 97-98 and accompanying text.

\(^8^2\) 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.

\(^8^3\) Fuddruckers, Inc. v. Doc's B.R. Others, Inc., 826 F.2d 837, 843 (9th Cir. 1987) (citation omitted).

\(^8^4\) See S. Kane, supra note 2, at 200; 2 J. McCarthy, supra note 10, § 27-3, at 345.


\(^8^6\) 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 its 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
negative effects of a design monopoly being created by application of the inherent distinctiveness test do not exist.\textsuperscript{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,\textsuperscript{99} and secondary meaning is sometimes very difficult and costly to prove.\textsuperscript{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.\textsuperscript{101} However, the expense of a survey could deter a trade dress owner from seeking protection for his trade dress.\textsuperscript{102} Even if one can afford to conduct a survey, they are difficult to design and may not be successful.\textsuperscript{103} To be admissible as evidence, a survey must be conducted according to generally accepted market research principles and the results must be used according to proper statistical methods.\textsuperscript{104}

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\textsuperscript{98} 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.


\textsuperscript{100} See Palladino, Techniques for Ascertaining If There Is Secondary Meaning, 73 Trademark Rep. 391, 404 (1983); infra notes 113-15 and accompanying text.


\textsuperscript{102} 1 J. McCarthy, supra note 1, § 15:14, at 691.

\textsuperscript{103} Palladino, supra note 100, at 404.

\textsuperscript{104} 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.\textsuperscript{105} A large volume of sales or extensive advertising that features the trade dress is the second way of proving secondary meaning.\textsuperscript{106} Extensive advertising, however, will not prove secondary meaning if the trade dress is not prominently featured in the advertisements or promotional efforts.\textsuperscript{107}

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.\textsuperscript{108} 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.\textsuperscript{109} 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.\textsuperscript{110} In addition, the fact that a competitor had the intent to imitate may be difficult to prove.\textsuperscript{111} Use of intentional imitation as proof of secondary meaning creates an


\textsuperscript{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.


\textsuperscript{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).

\textsuperscript{109} Brooks Shoe Mfg. v. Suave Shoe Corp., 716 F.2d 854, 859-60 (11th Cir. 1983) (quoting 1 J. McCarthy, Trademarks and Unfair Competition § 15:4, at 531 (1973)).

\textsuperscript{110} See Fuddruckers, Inc. v. Doc's B.R. Others, Inc., 826 F.2d 837, 844-45 (9th Cir. 1987).

economic problem as well. Providing protection to the source of an intentionally imitated trade dress permits "the first seller of a product [to] appropriate the simplest of trade dress, the most elementary of descriptive terms, and there[by] make it more costly for the next seller to compete with him."112

The stringent requirements of each of the three methods result in a heavy burden on the party seeking to prove secondary meaning.113 In J.M. Huber Corp. v. Lowery Wellheads, Inc.,114 for example, despite evidence 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 period, 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.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 imitated marks and to protect the goodwill and investment of manufacturers and merchants.116 The alternative test of inherent distinctiveness provides potential protection for trade dress that would otherwise be left unprotected because of the difficulty of proving secondary meaning.

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.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 comprehend how inherent distinctiveness can be an identifier of source. The Court of Appeals for the Second Circuit, for example, considers it anomolous to find a false designation of origin or false representation without a showing of secondary meaning because "there would be no

112. Blau Plumbing, 781 F.2d at 611.
113. 20th Century Wear, Inc. v. Sanmark-Stardust, Inc., 815 F.2d 8, 10 (2d Cir. 1987).
114. 778 F.2d 1467 (10th Cir. 1985).
115. Id. at 1470 (no secondary meaning proven due to lack of "market survey data or other empirical evidence"); see also S. Kane, supra note 2, at 50 (courts and adversaries can be expected to note absence of surveys). In 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. See id. at 78.
116. See supra notes 13-14 and accompanying text.
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.\textsuperscript{127}

\section*{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.

\textit{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.