Nice Tie: Trade Dress Protection for Visual Artistic Style When Competitors Offer Artist-Inspired Products

Cover Page Footnote
I thank Professor Hugh Hansen for his suggestions and guidance in the preparation of this Note. I am also grateful to Marilyn Goldberg for her insights into the art licensing industry.
It is important to be as sensitive to the artist of the past as to the contemporary artist, not to misrepresent the past, not to turn the past to purely commercial ends.\textsuperscript{1}

\section*{INTRODUCTION}

More than a few people have gone to an art museum and wanted to walk out with a few choice pieces. Unfortunately, due to record-setting prices at recent art auctions in New York, not everyone will be able to afford to take home her very own Old Master painting.\textsuperscript{2} But all is not lost. There is still a way to purchase the work of one's favorite artist without having an eight-figure market portfolio. The solution for the shopper of nonextraordinary means is art merchandise.\textsuperscript{3}

Art merchandise is the broad term for the category of products that incorporate the features of an artist's work into a consumer product. More than just posters of famous paintings, art merchandise has exploded into almost all areas of consumer goods.\textsuperscript{4} The vast variety of...
products includes the familiar Monet neckties, Caillebotte umbrellas, and almost anything featuring Picasso. But there are also Cézanne beach towels, Rodin "Thinker" pastas, Winslow Homer credit cards, Piet Mondrian ready-to-wear dresses, and even blow-up dolls of Edvard Munch's famous "cheek-clasping, gape-mouthed wraith from his painting The Scream." While some art merchandise is based on work that is in the public domain, a great deal of it is licensed. In 1998, sales of licensed art products totaled $5.4 billion. While the works of famous artists are being licensed to manufacturers, however, another line of products has also entered the art merchandise market: artist-inspired products. By marketing artist-inspired products that imitate the visual styles of artists who already have a market presence, the products' manufacturers threaten the goodwill and reputation that the artists have built up over a lifetime.

This Note examines how federal trademark law can be applied to protect an artist's visual style when a third party seeks to appropriate that style and use it to sell art merchandise. Part I discusses how art have licensed their images and names are Marc Chagall, Jasper Johns, Pablo Picasso, Joan Miró, Frank Stella, Mark Rothko, and Jackson Pollock. See Finding Rights Holders for Painters, Paintings Is a Fine Art, Licensing Letter, June 1994, at 6, 6 [hereinafter Finding Rights].


7. Goldberg Interview, supra note 4 (noting that Pablo Picasso is, by far, the most recognizable and marketable artist due to the quantity of work he produced and the variety of styles he employed).


9. See Deni Kasrel, Phila. Bus. J., Museums Cash in on Retail, June 20, 1997, at 1 (observing that the label on the package says "food to think about").

10. See Temin, supra note 6 (reporting that Winslow Homer's painting Boys in a Pasture will now be featured on a Visa card issued by BayBank).

11. See Chuck Twardy, Pop Goes the Easel, News & Observer (Raleigh, N.C.), May 5, 1996, at G1 (reporting that in the 1970s, New York's Metropolitan Museum of Art was criticized for selling the garments that featured the rectangles and primary colors of the artist's work).

12. See id. (reporting that the item's package touts it as an "icon of angst").

merchandise has become a lucrative industry in recent years and the manner in which art is marketed to the general public. Part II outlines the origin of trademark law and the policies that support it. This part also examines the development of federal trade dress doctrine. Part III analyzes how an artist can use federal trade dress doctrine to prevent third parties from using her visual style on art merchandise. This part explains how a visual artistic style can indicate that a particular artist is the source or sponsor of goods, and how, by appropriating the artist's visual style, a third party causes confusion in the minds of purchasers and viewers as to the source or sponsorship of goods.

I. The Art of Merchandising

This part explains how art is merchandised and identifies recent developments in this burgeoning industry. In addition, this part examines the process for licensing artwork for use in merchandising efforts and focuses on the reasons why a manufacturer would consider creating an artist-inspired product.

A. The Rise of an Industry

Art merchandising is not a new phenomenon in museums. In 1871, New York's Metropolitan Museum of Art (the "Met") became the first American museum to sell art merchandise. Serious museum merchandising efforts, however, did not begin until over 100 years later. In the late 1970s, "The Treasures of Tutankhamen" show visited the Met, and museum merchandising was taken to a new level. The Tutankhamen show proved that a museum exhibit could not only be popular, but profitable as well. Since then, almost every major museum has entered into the market. While museums have offered less

15. See Judith H. Dobrzynski, Art(? to Go: Museum Shops Broaden Wares, at a Profit, N.Y. Times, Dec. 10, 1997, at A1; see also Lisa W. Foderaro, The Met Pioneered with Reproductions, N.Y. Times, Feb. 18, 1997, at B5 (stating that even before the Met's founding trustees had a building, they bought 174 old master paintings from Europe and commissioned engravers to make engravings of ten of them); Carol Strickland, Art of the Deal: One Museum's History of Merchandising, Christian Sci. Monitor, June 19, 1997, at 12, 12 (observing that, in 1871, before the Met officially opened its doors in a former dancing school, it was selling a portfolio of Old Master engravings for $25 a set).

16. See Artner, supra note 5; Twardy, supra note 11.

17. See Twardy, supra note 11.

convincing justifications, as a general matter, museums are enticed into selling art merchandise for one reason: economics. With government sources reducing the amount of public funding provided to the arts, and corporate and individual donors attaching increasingly onerous strings to their contributions, museums are turning to art merchandising as a form of self-help. Revenue from art merchandising is used to bridge the gap between rising expenses and falling donations. As a result, museums are increasingly turning to licensing as a way to increase art merchandise revenues.

Art merchandising is big business for museums. Surveys by industry groups reveal that profits from museum stores lead all other sources of earned income. The Met, which has fourteen stores in the U.S. and twenty-eight licensed stores abroad, had total merchandise revenue of $87.4 million in the fiscal year ending June 30, 1997. The average gross profit margin on museum-marketed art merchandise is

19. See Miro, supra note 3 (reporting that a museum executive has stated that “[t]his is not a commercialization of art or the museum; it's a popularization, designed to attract more people to visit”). Another museum spokesperson observed that “there's a financial component in what we do . . . but our primary desire is to have visitors take something of the museum away with them . . . . And that gets our name out.” Artner, supra note 5. Yet another spokesperson has commented that merchandising allows artists to “become better known and more accessible.” Lee Siegel, Johns Goes to Pieces, ARTnews, June 1996, at 31, 31 (quoting Elizabeth Addison, deputy director for marketing and communication at New York Museum of Modern Art). Those who oppose the current level of art merchandising argue that saturating the market with such a large volume of reproductions of great works only deadens the responses of consumers when they see the actual works of art. See Artner, supra note 5. Perhaps the most pithy observation regarding the dangers of the mass commercialization of art is that “[i]t's one thing to reproduce a likeness of an artwork. It's another to eat off of it.” Miro, supra note 3.
20. See Gregg, supra note 1, at 123.
21. See Dobrzynski, supra note 15; Gregg, supra note 1, at 120; see also Strickland, More Registers Ring, supra note 8, at 10 (quoting museum merchandise manager as stating that “[m]useums are definitely depending more and more on retail sales for revenue.”).
22. See Dobrzynski, supra note 15.
23. See Museum Licensors Focus on Home Furnishings, Licensing Letter, May 1993, at 1, 8 [hereinafter Museum Licensors] (quoting a museum source as noting that “[i]n the last 10 years there's been a tremendous proliferation of museums entering licensing as a way to increase revenues . . . .”). As an alternative to licensing products based on its collection, a museum could develop products in-house. See id.
24. See Strickland, More Registers Ring, supra note 8 (observing that in the mid-1980s, the Museum Store Association, a nonprofit trade group, had 700 members; as of 1997, it has 1800 members).
25. Surveys of the Association of Art Museum Directors and the American Association of Museums found that 18% to 26% of earned income came from art merchandising. See Dobrzynski, supra note 15.
27. See Dobrzynski, supra note 15. As of 1997, the Met sold some 20,000 different items. See Gregg, supra note 1, at 121.
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forty-eight percent, ten percent above reputable department stores.28 To maximize their merchandising potential, many museums have shifted away from using volunteers to run their shops, instead opting to enlist the services of seasoned marketing and retail professionals.29 The appeal of individual artists can also make for a banner year at a museum's gift shop. For example, in 1993, the Matisse exhibit at New York's Museum of Modern Art (the "MoMA") helped push merchandising revenues to $25 million, from $16 million in 1992.30 In 1994, revenues were back down at $18 million.31 Finally, one need not go to a museum store to purchase art merchandise. Since 1996, several major museums have invited QVC to feature their wares on its home shopping television program.32

Recent developments in art merchandising have only made the market more competitive. For example, art merchandising is not just restricted to museums.33 Due to the success that the museums have realized, art merchandise is entering conventional retail distribution channels.34 The Museum Company, founded in 1989, sells merchandise representing the collections of 200 museums worldwide.35 With eighty-four stores in the U.S and Canada and three in Great Britain, the company is seeking to open eight to ten additional stores each year.36 On another front, in 1988, retail competitors lobbied Congress to repeal the exemption in the Internal Revenue Code that allows mu-

28. See Dobrzynski, supra note 15. Net profit for the Met in 1996 was 10-12% of gross revenue. See Lisa W. Foderaro, Museums Step Up Their Retailing to Turn Art into Revenue, N.Y. Times, Feb. 18, 1997, at B5 [hereinafter Foderaro, Museums Step].
29. See Kasrel, supra note 9 (quoting a retail consultant stating that museums now "hire people with retail backgrounds and a diversity of skills in merchandising product development"); Foderaro, Museums Step, supra note 28 (noting that as museum merchandising departments have become more sophisticated, they have begun to add retailing professionals to their staffs); see also Strickland, More Registers Ring, supra note 8 (reporting that, in 1997, New York's Museum of Modern Art named James Gundell, senior vice president and merchandise manager at Bloomingdale's, as its director of retail operations).
30. See Foderaro, Museums Step, supra note 28.
31. See id.
32. See Gregg, supra note 1, at 120; see also Diane Haithman, Fine Art on QVC: Museums Star on Cable "Mall", July 31, 1996, Chi. Sun-Times, at 49 (stating that the recent joint marketing effort of QVC and the Philadelphia Museum of Art was "very successful"); Jane L. Levere, Museums and QVC Find They Can Do Business Together by Going Beyond the Typical Art Crowd, N.Y. Times, Aug. 15, 1997, at D7 (quoting the cautionary observation by museum official that "TV marketing of products has a bit of a hucksterism to it. If you embrace it wholeheartedly, you could hurt your brand.").
34. See Finding Rights, supra note 4, at 6.
35. See Corn, supra note 3.
seums to earn income on merchandise without paying taxes. Only museum sales on merchandise that is "substantially related" to the educational mission of the institution can qualify for this tax exempt treatment. All other sales from merchandising operations are taxable at regular corporate tax rates. Although museums have been accused of changing their methods of accounting to minimize their merchandising profits on paper, Congress has thus far refused to repeal the exemption. Finally, in light of the huge increase in art merchandising operations, artists and their estates are becoming more aggressive in protecting their names and images.  

37. See Twardy, supra note 11. Testifying before a House subcommittee, William Edwards of the Museum Company said that “[s]lick catalogs and fancy shopping center stores do not reflect a museum’s commitment to education . . . . They represent a cynical exploitation of tax laws and preferred postal rates which were designed for a nobler purpose.” Miro, supra note 3.  


39. See id. § 511(a); see also Foderaro, Museums Step, supra note 28 (noting that to avail themselves of this exemption, museums put art images on their merchandise, as merchandise that only has the museum’s name or logo does not qualify for the exemption). The need to prove the link between its merchandising operations and its educational mission has prompted the Met to make a point of publicly stating that it puts its profits from merchandising into its education budget. See Gregg, supra note 1, at 122. For this same reason, the museum’s mail-order catalogs state that the products are “inspired by” an object in the museum. Id. In addition, on licensed products, museums include hangtags and packaging that explain the educational significance of the products. See Museum Licensors, supra note 23, at 8.  

40. See Lee Rosenbaum, Met Shops Run Deficit (or Do They?), Art Am., Feb. 1996, at 112, 112 (stating that William Edwards, former deputy director for auxiliary activities at the MoMA and co-founder of the Museum Company, charged that the MoMA changed its method of accounting “because there was a fear that too much attention was being focused on the profitability of museum shops”). Many museums began making similar changes in their accounting systems around 1987. See, e.g., Robin Kamen, Competitors Pinch Met’s Retail Chain, Crain’s N.Y. Bus., Mar. 29-Apr. 4, 1993, at 1 (observing that, after 1987, the Met began allocating data processing and other charges against its merchandising revenues).  


42. See, e.g., David Colman, Picassos Reclaim Their Patrimony, N.Y. Times, Apr. 28, 1996, (Style) at 39 (reporting that the Picasso family is attempting to curtail the current level of exploitation of Picasso’s name and artistic images, and is spending $6 in legal fees for every $1 of royalties received); Winnie Hu, Store Wars: When a Mobile Is Not a Calder, N.Y. Times, Aug. 6, 1998, at E1 (stating that the Whitney Museum of American Art and two other museums have removed mobile sculptures from their gift shops out of awareness of the concern of the Alexander Calder family that the public would confuse the mobiles with those of Calder); Alan Riding, A Family Feud Over a Picasso (on Wheels), N.Y. Times, Apr. 19, 1999, at E1 (reporting that the Picasso family goes to court 20 times each year to fight commercial abuses of Picasso’s name and images); Nancy L. Ross, Artistic License, Wash. Post, Apr. 3, 1997, (Home) at 4 (reporting that the Picasso family filed over a dozen suits in three years to enjoin the use of his images on boxer shorts, tote bags, and neckties, and to have his name removed from a red pepper pizza served at a Greenwich Village restaurant); Siegel, supra note 19, at 31 (reporting that after learning that MoMA was selling a jigsaw puzzle of his work Flag (1954-55), Jasper Johns grew so “disturbed” that he ordered the museum to remove the puzzle from the shelves and incinerate the entire stock).
ARTIST-INSPIRED PRODUCTS

B. Producing an Art Product

To produce an art product, a manufacturer can either license an artist’s existing artworks or pay another artist to produce images for him. Often, when a manufacturer chooses the latter option, he seeks to produce an artist-inspired product. This section considers both options.

1. Licensing a Product

To lawfully market a licensed art product, a manufacturer must take a number of steps. First, he has to determine which artist he wants to license. The two major organizations that represent artists and their estates in the United States are the Visual Artists Guild of America and Artists’ Rights Society. After selecting an artist and entering into an agreement to become the artist’s licensee, he must create a suitable product that will meet with the approval of both the source of the reproducible art (the museum or owner of the work) and the underlying rights holder (the artist, or more often, the artist’s estate). While many rights holders do not have stringent requirements for licensed products, some are very protective of the artist’s public image. In addition, sources also have different standards. Most license agreements contain provisions that require the manufacturer

43. See Finding Rights, supra note 4, at 6 (describing the necessary steps in licensing an artist’s work).
44. See id. The Visual Artists Guild of America was started twenty years ago and represents over 500 American artists and estates including Jasper Johns, Grant Wood, Maxfield Parrish, and Thomas Hart Benton. See id.
45. See id. Artists’ Rights Society represents thirty U.S. artists and estates including Jackson Pollock, Frank Stella, and Mark Rothko. See id. Through its affiliated foreign societies, it also represents, among other artists, Joan Miró, Marc Chagall, Pablo Picasso, and Henri Matisse. See id.
46. See id. Sources can also be stock houses, publishers of books and posters, galleries, and private collections. See id.
47. See id.; see also 2 Ralph E. Lerner & Judith Bresler, Art Law 1405 (2d ed. 1998) (suggesting that the artist should give written approval of not only the goods themselves, but also all packaging, advertising, and promotional materials). If the work has fallen into the public domain, as with artists who have been dead for over 50 years, the manufacturer must still obtain the approval of the source. See 17 U.S.C. § 302 (1994). Artists such as De Kooning and Balthus are in the public domain and offer the manufacturer an alternative to using the images of artists whose work is still under copyright. The remainder of this Note focuses not on the source of the reproduction, but instead on the rights holder, that is, the artist or the estate of the artist.
48. See supra note 42 and accompanying text.
49. See Gregg, supra note 1, at 123 (suggesting that while products like the Cézanne baseball have a market with some museums, other museums would not have sold it). The President of the Met has stated that the museum has strict guidelines regarding putting a Monet painting on a coffee mug or other such uses of its images: “We stick to the high end,’ he says. ‘A lot of other museums are going downstream, because that’s where the money is.” Id. About 20% of the merchandise in the Met’s shop is produced in the Met’s own reproduction studio in New York. See Corr, supra note 3. Most of the other products are produced by licensees, under the Met’s supervision. See id.
to produce products in the style, appearance, and quality according to the manufacturer's own highest production standards.\textsuperscript{50} To maximize their market potential, artists often grant exclusive licenses to individual manufacturers for specific product categories.\textsuperscript{51} The license agreements contain representations that, subject to the grant of specific rights in the agreement, the artist is the sole and exclusive owner of all merchandising rights in his work and that the artist owns the copyright to the work.\textsuperscript{52} Once the product has been approved, the manufacturer must make payments to both the source and the rights holder.\textsuperscript{53} The fees paid to the source and the rights holder can be structured as flat fees or royalties based on a percentage of the revenue generated from sales of the product.\textsuperscript{54} Royalties generally range from two to twenty percent,\textsuperscript{55} with ten percent being standard.\textsuperscript{56}

2. Artist-Inspired Products

Given the creative, legal, and financial requirements involved in licensing an art product, there is tremendous incentive for manufacturers to avoid these steps and simply market products that do not require compliance with the time-consuming and expensive art licensing process. It is at this point that some manufacturers have entered the art merchandise market with "artist-inspired products" ("AIPs"). A manufacturer creates an AIP when he designs a product resulting in a new image that incorporates in its rendition the visual style of an artist with whom he does not have a license agreement. For example, one manufacturer may license the image of Jackson Pollock's \textit{Blue}


\textsuperscript{51} See id. at 45-46. By granting exclusive licenses by product category, artists can choose the manufacturers who are most successful in each market in order to maximize their profit potential. See id.; see also 2 Lerner & Bresler, supra note 47, at 1404 (stating that the goods in connection with the license should be defined as narrowly as possible; for example, an artist who wants to license a work for posters and paper plates should enter separate agreements with different manufacturers instead of granting a license to a single manufacturer for "paper goods").

\textsuperscript{52} See 2 Lerner & Bresler, supra note 47, at 1404. Other provisions in the agreement address the artist's right to be indemnified for any liability incurred relating to the merchandising of the works that are subject to the agreement, the term and territory of the agreement, and the artist's right to an accounting of profits. See id. at 1405.

\textsuperscript{53} See id. at 1404 (noting that often an upfront fee is paid to the artist on the signing of the license agreement); Finding Rights, supra note 4, at 6.

\textsuperscript{54} See Moore, supra note 50, at 48-52. As a general matter, licensing for publishing rights is remunerated on a flat fee basis while merchandise licensing usually involves a royalty. See Finding Rights, supra note 4, at 6. Some of the sales bases used to calculate royalties include the retail price of the product sold, the net selling price (the price charged to wholesalers), and net receipts (retail price of product less selling discounts and promotions). See Moore, supra note 50, at 51.

\textsuperscript{55} See Moore, supra note 50, at 52. Factors that determine the royalty rate include the underlying sales base for calculation of the royalty, the market, the industry, the product category, and the value of the work to the manufacturer. See id.

\textsuperscript{56} See Finding Rights, supra note 4, at 6.
and create a silk scarf depicting that image. This is a legitimate licensing of an art product. A second manufacturer, however, may create a silk scarf with an image that is done in Pollock’s “drip and splat” style. While the image depicted is not one of Pollock’s works, it would be in Pollock’s style and, short of comparing it to a catalog of all of Pollock’s works, could be mistaken as a depiction of an actual Pollock work. The incentives for the manufacturer are obvious. He can avoid getting the approval of the artist’s estate and the source of the art because he is not depicting the actual work of the artist. In addition, royalties need not be paid, and quality control is not an issue.

Most AIPs are created by in-house artists who work for the manufacturer. These artists are educated in the style of the artist used for inspiration (the “inspiring artist”), and they often incorporate into the depiction not only the style of the inspiring artist, but the artist’s choice of subject matter as well. Not surprisingly, manufacturers almost always create AIPs in the styles of inspiring artists who have already had a significant product presence in the market. AIPs are often sold through the same distribution channels as licensed art products, and while some AIPs are priced below comparable licensed art products by an inspiring artist, many are in the same price range as legitimately licensed art products. AIPs are produced for the same products for which the inspiring artist has already established a licensed product (e.g., AIP necktie competing with a necktie licensed by the inspiring artist), as well as for products that the inspiring artist has yet to license (AIP mousepad with no competition from a comparable licensed product by the inspiring artist).

AIPs are packaged in various ways. Some refer to the inspiring artist on the packaging or on the label. They may reveal their nature by referring to the inspiring artist with phrases such as “inspired by,” “apres,” or “homage to.” Other AIPs do not indicate whether they

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59. See Goldberg Interview, supra note 4.
60. See id. The use of identical subject matter, however, is not a necessary requirement of creating an AIP. Of course, it may be argued that every artist has been inspired by the works of another artist at some point in her career, even if the source of the inspiration is not obvious. For example, Alexander Calder was inspired to create his mobiles after visiting the studio of Piet Mondrian and viewing Mondrian’s proto-installation art comprised of squares of colored paper pinned to the walls. See Roberta Smith, All Calder, High and Low, N.Y. Times, Mar. 27, 1998, at E35. The kind of “inspiration” that is present in AIPs however, is simply that of a conscious effort to create a work that appears to have been created by the inspiring artist.
61. See Goldberg Interview, supra note 4.
62. See id.
63. See id.
64. See id.
are actual depictions of the inspiring artist's work.\textsuperscript{65} One common
thread is that few, if any, AIPs admit their "inspired by" provenance
on the front of the product or in a manner that a third party, observing
the product in use, would be aware of such provenance.\textsuperscript{66}

Despite the protection afforded under copyright law, artists need
additional protection in cases involving AIPs. While copyright law
protects an artist from having her actual works appropriated, it will
not protect the artist when a party is using her visual style (and not
her works) to market products to the general public.\textsuperscript{67} A number of
articles have addressed the issue of whether an artist can protect the
visual style in her works (i.e., her actual paintings or sculptures),\textsuperscript{68} but

\textsuperscript{65} See id.
\textsuperscript{66} See id.
\textsuperscript{67} Copyright law defines a "derivative work" as "any ... form in which a work
may be recast, transformed, or adapted." 17 U.S.C. § 101 (1994). While this protec-
tion may prevent a party from creating a work that is derivative of the artist's actual
work (e.g., a certain painting), it does not provide protection for the artist's overall
style used in her oeuvre. Therefore, a party could use an artist's visual style and still
avoid violating the copyright law's derivative work doctrine simply by changing the
subject matter of the work.

\textsuperscript{68} See, e.g., Lynne A. Greenberg, \textit{The Art of Appropriation: Puppies, Piracy, and
Post-Modernism}, 11 Cardozo Arts & Ent. L.J. 1 (1992) (urging reformulation of the
Copyright Act's creativity and originality standards when applied to the visual arts);
Willajeanne F. McLean, \textit{All's Not Fair in Art and War: A Look at the Fair Use De-
defense After Rogers v. Koons}, 59 Brook. L. Rev. 373 (1993) (examining the Second
Circuit's decision in \textit{Rogers v. Koons} and concluding that the new standard enunci-
ated for using the fair use defense unnecessarily imposes new burdens on the visual
artist seeking to use such defense); Judith B. Prowda, \textit{Application of Copyright and
Trademark Law in the Protection of Style in the Visual Arts}, 19 Colum.-VLA J.L. &
Arts 269 (1995) (urging restraint in the application of copyright and trademark pro-
tection to visual artistic style); Niels B. Schaumann, \textit{An Artist's Privilege}, 15 Cardozo
Arts & Ent. L.J. 249 (1997) (proposing that artists be afforded the freedom to copy
"anything and everything" from other works of art subject to the limitation that the
new art posed no competitive threat to the copied work of art); Michelle Brownlee,
\textit{Note, Safeguarding Style: What Protection Is Afforded to Visual Artists by the Copy-
right and Trademark Laws?}, 93 Colum. L. Rev. 1157 (1993) (recognizing trademark
and copyright protection of visual artistic style and proposing a different standard of
copyright infringement that aims to protect the style of visual works); William P. Fitz-
patrick, \textit{Note, The Hazards of Extending Copyright or Trademark Protection to an
Artist's Visual Style}, 17 Colum.-VLA J.L. & Arts 453 (1993) (reviewing copyright and
trademark arguments for protecting artistic style and arguing that attempts to extend
artists' property rights beyond their actual works to protection of their visual style
risks accelerating the depletion of ideas in the public domain); Christopher Man,
Urb. & Contemp. L. 1995, 213 (1995) (arguing that courts should curtail the recent
explosion of artistic rights by tailoring the rights to the goals of the privacy, trade-
mark, unfair competition, and copyright laws that protect them); Lori Petruzelli,
\textit{Comment, Copyright Problems in Post-Modern Art}, 5 DePaul J. Art & Ent. L., 115
(1995) (suggesting that the Copyright Act should not be changed to accommodate the
specific problems created by post-modern art); Mark Traphagen, \textit{Stretching the Can-
vass: Protection of Visual Artistic Styles in Works of Fine Art Under Section 43(a) of the
Lanham Act} Ent. & Sports Law, Summer 1992, at 3 (arguing that claims of trade
infringement by artists against other artists should be dismissed unless the allegedly
infringing work itself is explicitly misleading to the public).
the issue of whether an artist can protect her style when applied to unlicensed art merchandise has not yet been addressed. Part II examines trademark law and the steps that a plaintiff seeking to protect her trademark must take to obtain this protection.

II. THE LAW OF TRADEMARKS

This part begins by looking at the general law of trademarks and its purposes. This part then examines the elements required to sustain a claim of trade dress infringement.

A. Generally

The law of trademarks is one subset of the broader category of law known as unfair competition. Trademark law is based on "[t]he policy of consumer protection, property rights, economic efficiency and universal concepts of justice . . ." From an economic standpoint, trademarks enable purchasers to identify goods and services that they have found satisfactory in the past and reject goods and services that they have found unsatisfactory. This process of identifying goods


70. See, e.g., Hanover Star Milling Co. v. Metcalf, 240 U.S. 403, 413 (1916) ("[T]he common law of trade-marks is but a part of the broader law of unfair competition."). The Senate also recognized the nature of trademark law when it reported the bill that became the Lanham Act. See S. Rep. No. 79-1333, at 3 (1946), reprinted in 1946 U.S.C.C.A.N. 1274, 1275 ("There is no essential difference between trade-mark infringement and what is loosely called unfair competition. Unfair competition is the genus of which trade-mark infringement is one of the species."). The Supreme Court has stated that "[t]he law of unfair competition has its roots in the common-law tort of deceit: its general concern is with protecting consumers from confusion as to source." Bonito Boats, Inc. v. Thunder Craft Boats, Inc., 489 U.S. 141, 157 (1989).

71. See 1 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, § 2:2, at 2-3 (4th ed. 1996) (hereinafter McCarthy); see also Restatement (Third) of Unfair Competition § 9 cmt. c (1995) (discussing numerous policies that justify the protection of trademarks). The Senate stated in its report on the Lanham Act that "[t]o protect trade-marks . . . is to protect the public from deceit, to foster fair competition, and to secure to the business community the advantages of reputation and good will by preventing their diversion from those who have created them to those who have not." S. Rep. No. 79-1333, at 3 (1946), reprinted in 1946 U.S.C.C.A.N. 1274, 1275.

72. See S. Rep. No. 79-1333, at 3 (1946), reprinted in 1946 U.S.C.C.A.N. 1274, 1275 (observing that trademarks "make possible a choice between competing articles by enabling the buyer to distinguish one from the other"); 1 McCarthy, supra note 71, § 2:3, at 2-3 to -4. Judge Augustus Hand explained the nature and scope of trademark law:

A trade-mark is not property in the ordinary sense but only a word or symbol indicating the origin of a commercial product. The owner of the mark acquires the right to prevent the goods to which the mark is applied from being confused with those of others and to prevent his own trade from being diverted to competitors through their use of misleading marks. There are no rights in a trade-mark beyond these.
and services with trademarks creates goodwill. An owner of goodwill is entitled to relief when another party seeks to use the owner's goodwill to his own advantage. Put simply, a trademark is merely a convenient means for facilitating the protection of one's good-will in trade by placing a distinguishing mark or symbol—a commercial signature—upon the merchandise or the package in which it is sold.

The main federal statute protecting trademarks is the Lanham Trademark Act of 1946. Traditionally, trademark protection was af-

Industrial Rayon Corp. v. Duchess Underwear Corp., 92 F.2d 33, 35 (2d Cir. 1937).

73. Justice Frankfurter once defined trademark law as follows:

The protection of trade-marks is the law's recognition of the psychological function of symbols. If it is true that we live by symbols, it is no less true that we purchase goods by them. A trade-mark is a merchandising short-cut which induces a purchaser to select what he wants, or what he has been led to believe he wants. The owner of a mark exploits this human propensity by making every effort to impregnate the atmosphere of the market with the drawing power of a congenial symbol. Whatever the means employed, the aim is the same—to convey through the mark, in the minds of potential customers, the desirability of the commodity upon which it appears. Once this is attained, the trade-mark owner has something of value. If another poaches upon the commercial magnetism of the symbol he has created, the owner can obtain legal redress.


Commenting on the importance of protecting trademarks, Justice Holmes stated that a trademark "stakes the reputation of the plaintiff upon the character of the goods."


74. Justice Pitney described the nature of a trademark action as follows:

The redress that is accorded in trade-mark cases is based upon the party's right to be protected in the good-will of a trade or business. The primary and proper function of a trade-mark is to identify the origin or ownership of the article to which it is affixed. Where a party has been in the habit of labeling his goods with a distinctive mark, so that purchasers recognize goods thus marked as being of his production, others are debarred from applying the same mark to goods of the same description, because to do so would in effect represent their goods to be of his production and would tend to deprive him of the profit he might make through the sale of the goods which the purchaser intended to buy. Courts afford redress or relief upon the ground that a party has a valuable interest in the good-will of his trade or business, and in the trade-marks adopted to maintain and extend it. The essence of the wrong consists in the sale of the goods of one manufacturer or vendor for those of another.

Hanover Star Milling Co., 240 U.S. at 412-13 (citations omitted). The Second Circuit has recognized that "[t]he trademark laws are designed not only to prevent consumer confusion but also to protect 'the synonymous right of a trademark owner to control his product's reputation.'" Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd., 604 F.2d 200, 205 (2d Cir. 1979) (quoting James Burrough Ltd. v. Sign of the Beefeater, Inc., 540 F.2d 266, 274 (7th Cir. 1976)). The Senate Report on adopting the Lanham Act states that "[a] trademark...gives the right to prohibit the use of it so far as to protect the owner's good will against the sale of another's product as his." S. Rep. No. 79-1333, at 3 (1946), reprinted in 1946 U.S.C.C.A.N. 1274, 1275 (quoting Prestonettes v. Coty, 264 U.S. 359, 368 (1924)).


forded only to "fanciful or arbitrary words and symbols." One of the major strengths of the Lanham Act is that it was the first federal statute to prohibit deceptive marketing by proscribing the use of false designations and misrepresentations. This innovation was accomplished through section 43(a) of the Act, which states:

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—

(A) 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, or

(B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person’s goods, services, or commercial activities, 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.

By enacting section 43(a), Congress provided for statutory protection that goes beyond registered marks by extending coverage to qualifying unregistered marks. The Supreme Court has stated that § 43(a)...


77. Restatement (Third) of Unfair Competition § 9 cmt. g (1995). For examples of various subject matter that have been protected by trademark doctrine, see generally 1 McCarthy, supra note 71, ch. 7.

78. See Restatement (Third) of Unfair Competition § 9 cmt. e (1995); see also Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763, 767-68 (1992) ("The Lanham Act was intended to make ‘actionable the deceptive and misleading use of marks’ and ‘to protect persons engaged in . . . commerce against unfair competition.’" (alteration in original) (footnote omitted) (quoting 15 U.S.C. § 1127)); S. Rep. No. 100-515, at 40 (1988), reprinted in 1988 U.S.C.C.A.N. 5577, 5603 (explaining that § 43(a) was reworded “to codify the interpretation it has been given by the courts. Because Section 43(a) of the Act fills an important gap in federal unfair competition law, the committee expects the courts to continue to interpret the section.”); 1 McCarthy, supra note 71, § 5-9, at 5-17 (stating that the Trademark Law Revision Act of 1988 codified the case law that had developed under § 43(a) and amounted to Congress approving of the use § 43(a) as the “premier federal vehicle” for the protection of unregistered marks).


80. See Inwood Labs., Inc. v. Ives Labs., Inc., 456 U.S. 844, 858 (1982) (observing that section 43(a) “prohibits a broader range of practices than does § 32,” which applies to registered marks); Blau Plumbing, Inc. v. S.O.S. Fix-It, Inc., 781 F.2d 604, 608 (7th Cir. 1986) (“The statute is not limited to trademark infringement and in any event protects unregistered (common law) trademarks as well as federally registered trademarks . . . .”); Romm Art Creations Ltd. v. Simcha Int’l, Inc., 786 F. Supp. 1126, 1134 (E.D.N.Y. 1992) (“Courts have long recognized that recovery under § 43(a) is not restricted to federally registered trademarks, but extends to ‘words, symbols, col-
"protects qualifying unregistered trademarks and that the general principles qualifying a mark for registration under section 2 of the Lanham Act are for the most part applicable in determining whether an unregistered mark is entitled to protection under section 43(a)."\(^8\)

Over time, the trademark protection afforded to words and symbols that indicated the origin or source of a product was extended to include the source-indicating trade dress of a product.\(^2\) For purposes of the Lanham Act, trade dress is treated the same as a trademark.\(^3\) In addition, unregistered trade dress owners are entitled to the same remedies that are available to holders of registered trademarks.\(^4\) Traditionally, trade dress doctrine protected the overall appearance of the wrappers, labels, and containers that were used to package a product.\(^5\) Recent developments in trade dress law, however, have expanded its coverage.\(^6\) Trade dress has been described as "essentially [a product's] total image and overall appearance."\(^7\) Trade dress has also been defined as "involv[ing] the total image of a product and may include features such as size, shape, color or color combinations, texture, graphics, or even particular sales techniques."\(^8\) Recent deci-
sions have extended trade dress protection to, among other things, the appearance of a lamp, the use of a lighthouse in the design of a hole on a golf course, the layout of a magazine cover, the layout and decor of a restaurant, and the appearance of a video game console. Not surprisingly, the extension of trade dress to so many diverse forms has led to some backlash.

B. The Elements of a Section 43 Claim

The protection of an unregistered trade dress is clearly within the scope of section 43(a). The elements of a claim for trade dress infringement under section 43(a) are well-established: a plaintiff must prove that (1) her trade dress is distinctive, and (2) a likelihood of confusion exists between her product and the defendant's. Even if
the plaintiff meets her burden, the defendant will not be liable if the plaintiff's trade dress is functional. A feature is functional if it is "essential to the use or purpose" of an article, or if it "affects the cost or quality of the article."  

1. Source Identification

The first requirement a plaintiff must meet to assert a claim for trade dress infringement under the Lanham Act is to prove that the trade dress is distinctive, i.e., it is indicative of the source of a product. The test used to determine the distinctiveness of a trademark was outlined by Judge Friendly in Abercrombie & Fitch Co. v. Hunting World, Inc. The Abercrombie test established categories based on the level of distinctiveness of a mark. The categories, in order of increasing distinctiveness, are: (1) generic, (2) descriptive, (3) suggestive, and (4) arbitrary or fanciful. Marks that are classified as generic indicate the genus to which the product belongs and, therefore, can never be indicative of source. Suggestive and arbitrary or fanciful marks, at the very least, require "imagination, thought and perception to reach a conclusion as to the nature of goods" and are,

86 F.2d 931, 935 (7th Cir. 1989); Ambrit, Inc. v. Kraft, Inc., 805 F.2d 974, 978 (11th Cir. 1986).

97. See supra note 96. The burden of proving that a trade dress is functional, and therefore not eligible for protection, is on the defendant. See Knitwaves, Inc., 71 F.3d at 1005 (citing Villeroy & Boch Keramische Werke K.G. v. THC Systems, Inc., 999 F.2d 619, 620 (2d Cir. 1993)); Vornado Air Circulation Sys., 58 F.3d at 1503; Brunswick Corp. v. Spinit Reel Co., 832 F.2d 513, 520 (10th Cir. 1987).


99. See supra note 96.

100. A trademark is defined as "any word, name, symbol, or device, or any combination thereof" used by a person "to identify and distinguish his or her 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." 15 U.S.C § 1127. The Supreme Court has stated that "it is common ground that § 43(a) protects qualifying unregistered trademarks and that the general principles qualifying a mark for registration under § 2 of the Lanham Act are for the most part applicable in determining whether an unregistered mark is entitled to protection under § 43(a)." Two Pesos, 505 U.S. at 768.

101. 537 F.2d 4, 9-11 (2d Cir. 1976). In Two Pesos, the Supreme Court cited the Abercrombie test with approval for purposes of classifying the distinctiveness of a trade dress. See 505 U.S. at 768. But see Duraco, 40 F.3d at 1441 (rejecting the Abercrombie taxonomy in cases where the court is considering the trade dress of a product configuration).

102. See Abercrombie, 537 F.2d at 9.

103. See id.

104. See id. at 9-10. Examples of generic marks include "Cereal," "Dog Food," and "Hammer" as applied to those respective products.

105. Id. at 11. An example of a fanciful mark is a coined word that did not exist before it was used in connection with the goods. Words such as "Kleenex" and "Jell-O" are fanciful marks. Arbitrary marks are words that are used in connection with goods where the nature of the goods is not implied by the mark. Examples of arbi-
ARTIST-INSPIRED PRODUCTS

therefore, deemed inherently distinctive (automatically satisfying the requirement of distinctiveness). Finally, marks that are merely descriptive are not deemed to be inherently distinctive, but can acquire distinctiveness (and indicate source) if they become distinctive of the party's goods through use in commerce. The process of descriptive marks becoming distinctive through use in commerce is referred to as acquiring "secondary meaning." Courts have found that proof of a defendant's copying can be sufficient, in and of itself, to establish secondary meaning because there is no reason to copy a nonfunctional feature other than to capitalize on already existing secondary meaning. While some circuits had previously required a plaintiff claiming a trade dress violation under section 43(a) to prove secondary meaning, the Supreme Court, in its most recent case addressing trade dress, held that if the trade dress was proven to be inherently distinctive, then no showing of secondary meaning was required.

To be an indicator of source, a trade dress need not identify by name the origin or sponsor of the product. The use of a trade dress

106. See Abercrombie, 537 F.2d at 10-11.
107. See id. at 10; see also 15 U.S.C. § 1052(f) (1994) (declaring that "nothing in this chapter shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce"). Marks that are directly descriptive of the nature of the goods are less likely to be understood by consumers as being indicative of source and are, therefore, not inherently distinctive. See Restatement (Third) of Unfair Competition § 13 cmt. c (1995). Examples of descriptive marks are "Car-Freshener" used in connection with an automobile deodorizer and "Sportscreme" in connection with a pain reliever for muscular injuries. See id. § 14 cmt. a.

108. See Park 'N Fly, Inc. v. Dollar Park & Fly, Inc., 469 U.S. 189, 194 (1985). Among the factors that courts have found relevant to the inquiry of whether a trade dress has acquired secondary meaning are advertising expenditures, consumer studies, sales success, unsolicited media coverage, attempts to plagiarize, and length and exclusivity of use. See Bristol-Myers Squibb Co. v. McNeil-P.P.C., Inc., 973 F.2d 1033, 1041 (2d Cir. 1992).


112. 15 U.S.C. § 1127 states:
does not mean that the articles on which the dress is used were necessarily manufactured by the owner of the dress. It is enough that the goods were manufactured for the dress owner, that the dress owner controls the production of the goods, or that the goods pass through the dress owner's hands and that he gives the goods the benefit of his reputation or his name and business style. The requirement that the dress indicate a single source does not prevent the owner of the dress from using the dress on an item and marketing the item through more than one distributor.

2. Likelihood of Confusion

The second requirement to sustain a claim for trade dress infringement is that the plaintiff must demonstrate that there is a likelihood of confusion. The likelihood of confusion is the "likelihood that an appreciable number of ordinarily prudent purchasers are likely to be misled, or indeed simply confused, as to the source of the goods in question." That is, a potential purchaser may see the goods of the defendant and possibly believe that the plaintiff is the source of the goods. To be confused, a consumer need not believe that the owner of the trade dress actually manufactured the item and placed it on the market; it is enough that the public believed that the owner of the

The term "trademark" includes any word, name, symbol, or device, or any combination thereof—

(1) used by a person, or
(2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter, to identify and distinguish his or her 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.

15 U.S.C. § 1127 (emphasis added); see Processed Plastic Co. v. Warner Communications., Inc., 675 F.2d 852, 856 (7th Cir. 1982) ("It is not necessary for the public to be aware of the name of the manufacturer which produces a product."); Mastercrafters Clock & Radio Co. v. Vacheron & Constantin-LeCoultre Watches, Inc., 221 F.2d 464, 466 (2d Cir. 1955).

115. See Mastercrafters, 221 F.2d at 466 (holding that more than one distributor for Atmos clock does not violate single source requirement where ultimate source is Swiss manufacturer).
116. See supra note 96.
117. Mushroom Makers, Inc. v. R.G. Barry Corp., 580 F.2d 44, 47 (2d Cir. 1978) (per curiam); see also Alpha Indus., Inc. v. Alpha Steel Tube & Shapes, Inc. 616 F.2d 440, 443 (9th Cir. 1980) ("Likelihood of confusion exists when consumers viewing the mark would probably assume that the product or service it represents is associated with the source of a different product or service identified by a similar mark." (quoting Scott Paper Co. v. Scott's Liquid Gold, Inc., 589 F.2d 1225, 1229 (3d Cir. 1979))).
118. See Fleischmann, 314 F.2d at 155.
119. See Dallas Cowboys Cheerleaders, Inc. v. Pussy Cat Cinema Ltd., 604 F.2d 200, 204 (2d Cir. 1979).
mark "sponsored or otherwise approved" the use of the mark on the item at issue.\textsuperscript{120}

The likelihood of confusion has been extended to situations where the defendant would gain credibility in the initial phases of the sale process even though the third party would later be able to discern the plaintiff from the defendant. For example, in Mobil Oil Corp. v. Pegasus Petroleum Corp.,\textsuperscript{121} plaintiff Mobil used the familiar "flying horse" symbol in connection with its petroleum business but not in connection with its oil trading activities.\textsuperscript{122} Defendant Pegasus was exclusively engaged in the oil trading business and did not use the flying horse symbol.\textsuperscript{123} Mobil sued to enjoin Pegasus from using the mark "Pegasus" in connection with the petroleum industry or related businesses.\textsuperscript{124} In affirming the district court's judgment, the Second Circuit stated that the fact there was no actual confusion between the parties was not dispositive.\textsuperscript{125} In other words, according to the court, the issue is not whether there is a likelihood that a third party would do business with Pegasus, thinking it were related to Mobil.\textsuperscript{126} Instead, the touchstone is whether there was a likelihood that Pegasus would "gain crucial credibility during the initial phases of a deal."\textsuperscript{127} Under this doctrine, a likelihood of confusion exists if the defendant enjoys an unfair advantage by getting an opportunity to make his pitch before the third party realizes that he is not dealing with the plaintiff.\textsuperscript{128}

The likelihood of confusion requirement has been held to apply not just to purchasers and potential purchasers, but also to members of the public at large who may only see the article in use but not be potential buyers.\textsuperscript{129} The application of the likelihood of confusing the

\textsuperscript{120} Id. at 205.
\textsuperscript{121} 818 F.2d 254 (2d Cir. 1987).
\textsuperscript{122} Id. at 256. Mobil's winged horse symbol was a registered trademark. See id. at 255.
\textsuperscript{123} See id. at 256.
\textsuperscript{124} Id. at 255.
\textsuperscript{125} See id. at 259 (stating that "the absence of misdirected mail and telephone calls between the parties, and the fact that Pegasus Petroleum must post a letter of credit as security during its oil trading deals while Mobil need not" are not properly considered in this inquiry). The court was reviewing the fifth Polaroid factor: evidence of actual confusion. See id. For a general discussion of the Polaroid factors, see infra notes 134-36 and accompanying text.
\textsuperscript{126} 818 F.2d at 259.
\textsuperscript{127} Id. (offering as an example a situation where "an oil trader might listen to a cold phone call from Pegasus Petroleum—an admittedly oft used procedure in the oil trading business—when otherwise he might not, because of the possibility that Pegasus Petroleum is related to Mobil").
\textsuperscript{128} See id.
\textsuperscript{129} See Landscape Forms, Inc. v. Columbia Cascade Co., 113 F.3d 373, 382 (2d Cir. 1997) (stating that in cases where the views of third parties are related to the goodwill of the aggrieved manufacturer, "[t]he likelihood of confusion test concerns not only potential purchasers but also the general public"). In addition, in Syntex Laboratories, Inc. v. Norwich Pharmacal Co., 437 F.2d 566 (2d Cir. 1971), the Second Circuit
public at large is called into play where the purchaser is conspiring with the producer of the infringing item to freeride off of the trademark holder’s goodwill. This approach is grounded in a concept referred to by one commentator as “psychic load.” As McCarthy notes, “a trademark not only symbolizes the good will behind the physical product, but also the penumbra of psychological factors that surround the product.”

For example, as the Second Circuit observed in *Mastercrafters Clock & Radio Co. v. Vacheron & Constantin-LeCoultre Watches, Inc.*, some customers would buy plaintiff’s cheaper [product] for the purpose of acquiring the prestige gained by displaying what many visitors at the customers’ homes would regard as a prestigious article.

To determine whether a likelihood of confusion exists, courts apply a multifactor test. The Second Circuit’s test uses the eight factors set forth in *Polaroid Corp. v. Polorad Electronics Corp.* The Polaroid factors are: (1) the strength of the prior owner’s mark, (2) the degree of similarity between the two marks, (3) the proximity of the products, (4) the likelihood that the prior owner will bridge the gap between the two products, (5) actual confusion, (6) and the reciprocal of defendant’s good faith in adopting its own mark, (7) the quality of the defendant’s product, and (8) the sophistication of the buyers. This list of factors, however, is not exhaustive. Other circuits have similar tests for determining whether a likelihood of confusion exists.

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130. 1 McCarthy, *supra* note 71, § 2:37, at 2-68.
131. *Id.*
132. 221 F.2d 464 (2d Cir. 1955).
133. *Id.* at 466. The court went on to say that “the likelihood of such confusion suffices to render plaintiff’s conduct actionable.” *Id.; see also A.T. Cross Co. v. Jonathan Bradley Pens, Inc.*, 470 F.2d 689, 692 (2d Cir. 1972) (criticizing defendant’s appeal to purchasers that donees receiving defendant’s pen would think that they were receiving a Cross pen).
134. 287 F.2d 492 (2d Cir. 1961).
135. *See id.* at 495. *See also Bristol-Myers Squibb Co. v. McNeil-P.P.C., Inc.*, 973 F.2d 1033, 1043 (2d Cir. 1992) (citing *Polaroid*, 287 F.2d at 495); *Mobil Oil Corp. v. Pegasus Petroleum Corp.*, 818 F.2d 254, 256 (2d Cir. 1987) (same).
136. *See Bristol-Myers*, 973 F.2d at 1043; *Mobil Oil*, 818 F.2d at 256; *Polaroid*, 287 F.2d at 495.
137. The Ninth Circuit has held that the factual elements that make up the likelihood of confusion include: “evidence of actual confusion, the defendant’s intent in adopting the mark, similarity of marks, similarity of goods and marketing channels, and the strength of the mark.” *Fuddruckers, Inc. v. Doc’s B.R. Others, Inc.*, 826 F.2d 837, 845 (9th Cir. 1987); see *Park ’N Fly, Inc. v. Dollar Park and Fly, Inc.*, 782 F.2d 1508, 1509 (9th Cir. 1986). The Seventh Circuit has stated that:

[In assessing the likelihood of marketplace confusion, the factors to be considered include the similarity of the trade dresses, the products to which the trade dresses are attached, the area and manner of concurrent use, the degree of care likely to be exercised by consumers, the strength of the plain-
As a practical matter, to determine if a likelihood of confusion exists, courts accord great weight to a defendant’s intention to adopt the plaintiff’s trade dress. In addition, courts have found that intent alone may be enough to support a finding of the likelihood of confusion. At the very least, if intent is proved, a presumption is raised that a likelihood of confusion resulted.

For an artist to bring a claim under the Lanham Act to protect her visual style from being used in connection with an AIP, she will have to bring an action for trade dress infringement under section 43(a). Essentially, an artist will argue that her style is a trade dress qualified for protection as an unregistered mark. As such, the infringing manufacturer, by using the artist’s trade dress to sell an AIP, is confusing the public into thinking that the artist is the source or sponsor of the AIP, and thereby infringing the artist’s goodwill. Part III examines how an artist will make her case.

III. Application of the Lanham Act to Visual Artistic Style

This part first examines the inherent difficulty in defining what an artist’s visual style actually is. This part then examines how an artist...
would proceed under the Lanham Act to protect her trade dress from infringement by the producer of an AIP.

A. What Is Style?

It has been observed that, “[o]bviously, subject is what is said, style is how.”

This aphorism, however, does not readily apply to nonliteral expression. The word “style” is derived from the Latin word *stilus*, which denoted the needle that was used to write on wax-coated tablets at antiquity. Explaining the etymology of “style,” H.W. Janson wrote that “originally, it referred to distinctive ways of writing—the shape of the letters as well as the choice of words.” To have style, a thing must “not be inconsistent within itself—that it must have an inner coherence, or unity, that it possess a sense of wholeness, of being all of a piece.” As for the elements of style, another commentator writes that a property “counts as stylistic only when it associates a work with one rather than another artist.”

In the visually artistic sense, “style” has been defined many ways. One proffered definition is that “style means the particular way in which the forms that make up any given work of art are chosen and fitted together.” Other definitions emphasize “a coherence of qualities” or “a distinctive manner or mode.” A more metaphorical

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143. See id.
144. See 29 The Dictionary of Art 878 (Jane Turner ed., 1996) [hereinafter Dictionary of Art]. An alternative Latin etymology has also been offered. The Greek word *stylos* was used “to denote the proportional differences between the orders of architecture.” Id. at 879. While this usage is largely disregarded today, it “influenced the English spelling of the word in the 18th century.” Id. *But see* George Kubler, *Toward a Reductive Theory of Visual Style*, in *The Concept of Style* 163, 166 (Berel Lang ed., 1987) (synthesizing the dual etymology by stating that *stilus* has always pertained to arts of temporal form and *stylos* has always related to arts of spatial organization, thus differentiating time from space).
145. H.W. Janson, History of Art 50 (4th ed. 1991); *see also* 29 Dictionary of Art, supra note 144, at 878-79 (stating that the term was first applied to first century A.D. writings of Horace and Virgil). Another source states that “style” was first applied metaphorically to describe “the manners of public speaking appropriate for different occasions.” Hugh Honour & John Fleming, *The Visual Arts: A History* 12 (1st ed. 1982).
146. Janson, supra note 145, at 50. Janson also states that “style has a way of impressing itself upon us even if we do not know what particular kind of style is involved.” Id.
147. Goodman, supra note 142, at 807. Goodman also points out that not all properties that indicate the maker of a work are stylistic, such as a label on a picture, the chemical properties of the pigments in a painting, and other such documentation that may help place origin. See id.
148. Individual style has even been defined by one scholar as “what we characteristically refer to when we use the phrase ‘the style of a’—where a stands in for the name of a painter—to refer to something in the work of a.” Richard Wollheim, *Pictorial Style: Two Views*, in *The Concept of Style*, supra note 144, at 183, 184.
149. Janson, supra note 145, at 50.
150. Dictionary of Art, supra note 144, at 876.
suggestion is that style is "a visual language with a vocabulary of forms or motifs and a syntax governing their relationship."152 While delineating precisely what "style" is lends itself to artful creativity, the term "style," as it is used in this Note, is to be understood in a more limited sense. "Style" will refer to the visual features of an artist's work that, considered in their totality, demonstrate a consistency and unity in the work.153 The reason for employing this narrow, albeit incomplete, definition of style is a pragmatic one: in a case for trade dress infringement, courts evaluate the total image and overall appearance that the dress creates.154 Therefore, a more complete explanation of "style" is not necessary for consideration of a suit under the Lanham Act.

B. Step One: Source Identification

The first requirement for an artist to meet in asserting an infringement of the trade dress of her visual style under the Lanham Act is to prove that she has a trade dress that is distinctive.155 As a general matter, an artist may license her images to various manufacturers for the production of products that the artist will not actually herself produce.156 In addition, any product to which an artist licenses her work need not identify the artist by name for the artist's trade dress to become a source indicator.157

1. Defining a Trade Dress

Before an artist can begin to argue that her visual style identifies her as the source of goods and qualifies as a protectable trade dress, she must expressly articulate what her trade dress is.158 While courts

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151. Id. (citation omitted).
152. Honour & Fleming, supra note 145, at 12.
153. Of course, not all work by every artist will have a definable "style." The work must demonstrate "consistency and unity."
154. See supra notes 87-88 and accompanying text.
155. See supra Part II.B.1.
156. See supra notes 112-15 and accompanying text.
157. See supra notes 112-15 and accompanying text.
158. See Landscape Forms, Inc. v. Columbia Cascade Co., 113 F.3d 373, 381 (2d Cir. 1997) ("[F]ocus on the overall look of a product does not permit a plaintiff to dispense with an articulation of the specific elements which comprise its distinct dress."). For example, the Fifth Circuit described the distinctive trade dress of a Mexican restaurant as:
   a festive eating atmosphere having interior dining and patio areas decorated
   with artifacts, bright colors, paintings and murals. The patio includes inte-
   rior and exterior areas with the interior patio capable of being sealed off
   from the outside patio by overhead garage doors. The stepped exterior of
   the building is a festive and vivid color scheme using top border paint and
   neon stripes. Bright awnings and umbrellas continue the theme.
   Taco Cabana Int'l, Inc. v. Two Pesos, Inc., 932 F.2d 1113, 1117 (5th Cir. 1991), aff'd,
   505 U.S. 763 (1992). In holding that a plaintiff had a distinctive trade dress in its pain
   reliever packaging, the Second Circuit described the trade dress as
typically view exhibits of the parties’ wares at issue in a case.\textsuperscript{159} This requirement actually amounts to explaining in words what the artist’s style is.\textsuperscript{160} This requirement is particularly crucial in a section 43(a) action for an equitable remedy, because a court needs a detailed description of the plaintiff’s trade dress to fashion injunctive relief that is tailored to provide adequate protection to the trade dress owner, without being so broad as to give the holder a monopoly in a certain class of expression.\textsuperscript{161}

\begin{quote}
consist[ing] of an outer carton with a solid deep blue background, white lettering for the name “Excedrin PM,” which appears on a single line, with “Excedrin” in lower case lettering except for the initial “E” and “PM,” which are in capital letters. In the lower right portion of the face of the box is a depiction of two light blue tablets, each marked “PM.”
\end{quote}

Bristol-Myers Squibb Co. v. McNeil-P.P.C., Inc., 973 F.2d 1033, 1037 (2d Cir. 1992). In finding that a plaintiff had a protectable trade dress in the look of its line of greeting cards, the Seventh Circuit described the trade dress as

beige, single-face (no fold) cards containing sentimental verses and frequently using ellipses written in [plaintiff’s] handwriting with brown ink. An example of a verse reads: “I want to shout and tell the world how much I love you... but instead I’ll just... whisper.” Flanking the message on the left and right borders is a series of four stripes, two silver foil stripes enveloping one brown and one colored stripe in the middle. The FS cards are displayed in a four-sided freestanding rotating rack, each side containing eight cards of the same colored stripe displayed vertically. At the top of the rack is a removable header bearing a sketch of [plaintiff’s] likeness, her name, and the words “Feeling Sensitive... A lost and found department for those with feelings... in search of the words.” The backs of the FS cards indicate that the verses are taken from [plaintiff’s] book “I’ll See You Sometime... Between Now and Soon.” Each card was priced at eighty cents.”

Roulo v. Russ Berrie & Co., 886 F.2d 931, 935 (7th Cir. 1989).

\textsuperscript{159} See, e.g., Knitwaves, Inc. v. Lollytogs Ltd., 71 F.3d 996, 1114-17 (2d Cir. 1995) (providing exhibits of sweaters at issue); Roulo, 886 F.2d at 943-44 (providing exhibits of greeting cards at issue); Fuddruckers, Inc. v. Doc’s B.R. Others, Inc., 826 F.2d 837, 849-56 (9th Cir. 1987) (providing exhibits of restaurant layout at issue); John H. Harland Co. v. Clarke Checks, Inc., 711 F.2d 966, 985-88 (11th Cir. 1983) (providing exhibits of bank checks and carryaround cases at issue).

\textsuperscript{160} See supra note 158 and accompanying text. But see Samara Bros., Inc. v. Wal-Mart Stores, Inc., 165 F.3d 120, 126 n.2 (2d Cir. 1998) (stating that the court will not look at the allegations of “the complaint in a vacuum,” but instead focus on “all evidence adduced at trial” including the exhibits submitted by each party).

\textsuperscript{161} See Landscape Forms, Inc. v. Columbia Cascade Co., 113 F.3d 373, 381 (2d Cir. 1997) (“Courts will... be unable to shape narrowly-tailored relief if they do not know what distinctive combination of ingredients deserves protection.”); see also Sunbeam Prods. Inc. v. West Bend Co., 39 U.S.P.Q.2d 1545, 1556 (S.D. Miss. 1996) (issuing a preliminary injunction enjoining defendant from selling mixer that infringed the trade dress of plaintiff’s mixer). The Sunbeam court stated that the plaintiff’s trade dress consisted of:

(1) the elongated torpedo shaped main body containing the motor and electronic switch; (2) the electronic switch control being placed on the aft end of the main body; (3) the open ended handle attached at a single location at the front of the main body and containing a slight arc from front to rear; (4) the tear drop chrome front face plate located on the front of the main body; (5) the beater eject knob located on the left front portion of the handle; (6) the black and white overall color scheme of the mixer specifically broken down as (a) white main body; (b) chrome tear drop front face plate; (c) black open
If a plaintiff offers only a general description of the trade dress that she seeks to protect, courts will find that it lacks sufficient detail to qualify as distinctive. For example, in *Jeffrey Milstein, Inc. v. Greger, Lawlor, Roth, Inc.*, the plaintiff alleged that its trade dress in greeting cards consisted of "straight-on, strong photographic, glossy images of animals, persons or objects on die-cut cards that are cut without bleed of any kind." The Second Circuit held that the plaintiff did not have a protectable trade dress in "an idea, a concept, or a generalized type of appearance." The court stated that the plaintiff was "alleging infringement of the general format of its entire line of die-cut greeting cards."

In addition to articulating exactly what trade dress is being infringed, an artist needs to ensure that the works that are illustrative of her style have a consistent overall look. In *Walt Disney Co. v. Goodtimes Home Video Corp.*, the plaintiff, Walt Disney Company, alleged that the defendant infringed the trade dress of the packaging that it used to market its family of videocassettes called Classic...
From the outset, the district court noted that "Disney's claim differs from most trade dress claims in that the alleged trade dress is not a specific package or the appearance of a single product, but rather the overall look of a number of different packages." In light of this difference, the court observed that Disney first had to establish that it even had a trade dress before it could move on to the requirements of distinctiveness and likelihood of confusion. The court found that the lack of a consistent look for the packaging of the seventeen videos in the collection precluded a finding of distinctiveness. After reviewing the elements of Disney's putative trade dress, the court concluded that while the packages had some common elements, there was not a "consistent overall look, and therefore the trade dress that Disney allege[d was] infringed does not exist."

While an artist must show that the works that are illustrative of her style have a consistent overall look, she cannot be foreclosed from proving a trade dress in her visual style simply because minor elements of the dress are not present in every piece. In *Samara Bros., Inc. v. Wal-Mart Stores, Inc.*, the plaintiff sought to have its trade dress in the look of its line of children's clothes protected. The court stated that the design elements of the plaintiff's garments combined to produce a "distinctive combination of ingredients" that qualified the look for protection. The court stated that it was not suggesting that "in order to gain protection each garment must contain identical specified design elements." Instead, the court stated that it expects an "inevitable variation" in the items in a product line. While the court accepted variation in some of the elements of

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168. *Id.* at 763.
169. *Id.* at 766.
170. *See id.*
171. *See id.* at 768.
172. *Id.* An artist may actually have several styles that identify her as the source of her work. For example, Picasso produced work in different styles during his Blue Period, Cubist Period, Rose Period, etc. Therefore, in examining his style for trade dress purposes, his estate would only have to prove the distinctiveness of the style that is deemed to be infringed by the goods in the case at bar.
173. 165 F.3d 120 (2d Cir. 1998).
174. *See id.* at 126. The trade dress that the plaintiff sought to protect included the typical use of seersucker fabric; large bold appliques; large collars with the appliques generally integrated into the collar and any pockets on the garment; general absence of printed images, black outlines, alphanumeric characters, three-dimensional features or heavy ornamentation (such as bibs or fringe) which are frequently used in children's clothing; and full-cut, one-piece conservative bodies.
175. *Id.* at 129 (quoting Landscape Forms, Inc. v. Columbia Cascade Co., 113 F.3d 373, 381 (2d Cir. 1997)).
176. *Id.*
177. *Id.*
the trade dress, it ruled that an item that lacks a "major design element" does not warrant protection.\textsuperscript{178}

2. Greeting Card Cases

Two cases involving the trade dresses of greeting cards have found that the combination of elements used by the first creator was a source indicator, and, therefore, entitled to protection. The holdings of these cases provide direct support for an artist's ability to protect her trade dress from an AIP infringer. This section examines these cases.

a. Hartford House

The first case is \textit{Hartford House Ltd. v. Hallmark Cards Inc.}\textsuperscript{179} In \textit{Hartford House}, the plaintiff sued Hallmark for infringing the trade dress of two of its successful lines of greeting cards.\textsuperscript{180} To determine if Hartford House had a protectable dress, the court analyzed the features of Hartford House's greeting card lines.\textsuperscript{181} According to the court, if the features were functional, then they could not be protected because the usefulness of functional features in identifying the product's source is outweighed by the public's interest in product improvement by granting competitors access to those features.\textsuperscript{182} In evaluating the features of the plaintiff's lines of cards, the court did not consider each feature separately, but instead looked at the overall impression created by the features.\textsuperscript{183} The court stated that the ultimate

\textsuperscript{178} Id.
\textsuperscript{179} 647 F. Supp. 1533 (D. Colo. 1986), aff'd, 846 F.2d 1268 (10th Cir. 1988).
\textsuperscript{180} Id. at 1535.
\textsuperscript{181} The court found that the following elements comprised that look or trade dress:
1. A two-fold card containing poetry on the first page and the third page;
2. Unprinted surfaces on the inside three panels;
3. A deckle edge on the right-side of the first page;
4. A rough edge stripe of color, or wide stripe, on the outside of the deckle edge of the first page;
5. A high quality, uncoated and textured art paper for the cards;
6. Florescent ink for some of the colors printed on the cards;
7. Lengthy poetry, written in free verse, typically with a personal message;
8. Appearance of hand-lettered calligraphy on the front and third page with the first letter of the words often enlarged;
9. An illustration that wraps around the card and is spread over three pages, including the back of the card;
10. The look of the cards primarily characterized by backgrounds of soft colors done with air brush blends or light watercolor strokes, usually depicting simple contrasting foreground scenes superimposed in the background.
\textsuperscript{182} See id. at 1537-38.
\textsuperscript{183} Id. at 1539 ("The creation and arrangement of individual product features into a particular overall design may itself constitute a non-functional product feature."); see also Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd., 604 F.2d 200, 203-04 (2d Cir. 1979) (finding overall look of costume distinctive despite functional
mate issue as to whether the product features are functional is whether the configuration of features "will hinder competition or impinge on the right of others to compete in the sale of goods." The court found that there were "infinite alternative designs available" to the defendants, and that it would not be difficult for the defendant to devise distinguishing features for its competing card line. Finally, the district court held that the plaintiff had established proof of secondary meaning because the defendant was aware of the plaintiff's position in the market and had intentionally copied plaintiff's trade dress simply to "cash in" on plaintiff's already established goodwill and reputation.

On appeal, the Tenth Circuit affirmed the judgment of the district court. The court restricted its decision to the issue of whether the features of Hartford House's cards were functional. The court stated that the proper test for determining if a combination of features is functional is "whether protection of the combination would hinder competition or impinge upon the rights of others to compete effectively." The Tenth Circuit approved of the district court's finding that the availability of alternative designs is a "key factor" in determining that the trade dress is nonfunctional. Significantly, the Tenth Circuit stated that the plaintiff "has not been granted exclusive rights in an artistic style or in some concept, idea, or theme of expression." The court noted that the plaintiff's artwork was merely one part of the trade dress and that the look that is being protected is the "overall appearance of the cards."

_Hartford House_ offers some obvious support to the artist seeking to prevent manufacturers from selling AIPs using her visual style. Clearly, an artist does not have a monopoly on the individual features

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184. _Hartford House_, 647 F. Supp. at 1540 (quoting Sicilia Di R. Biebow & Co. v. Cox, 732 F.2d 417, 429 (5th Cir. 1984)).
185. Id.
186. See id.
187. _Id._ at 1542-43.
188. Hartford House, Ltd. v. Hallmark Cards, Inc., 846 F.2d 1268 (10th Cir. 1988).
189. See _id._ at 1272.
190. _Id._ at 1273.
191. _Id._; see also _Wallace Int'l Silversmiths_, Inc. v. Godinger Silver Art Co., 916 F.2d 76, 81 (2d Cir. 1990) (holding, in a case that involved a baroque style of silverware, that "where an ornamental feature is claimed as a trademark and trademark protection would significantly hinder competition by limiting the range of adequate alternative designs, the aesthetic functionality doctrine denies such protection").
192. _Hartford House_, 846 F.2d at 1274 (footnote omitted).
193. _Id._ at 1274 n.4.
of her style. Therefore, characteristics of an artist's style, such as broad brush strokes, bright colors, and the use of enamel paint, cannot be protected individually. If, however, the artist can define her style by proving a unique combination of elements, she can avoid losing her case on the ground that what she seeks to protect is functional. In addition, the Tenth Circuit recognized that there are many different styles that competitors could use to sell their products in the context of greeting cards. For example, a necktie manufacturer need not use a print in a Picasso style to sell his product; he could just as easily use the actual images of an artist whose work is in the public domain (such as van Gogh, Cézanne, etc.). Hartford House also helps address the issue of secondary meaning for an artist. If the artist is already licensing her work to sell goods, the fact that a competitor copies her dress is sufficient "in and of itself to establish secondary meaning." By definition, AIPs are derived from the visual artistic style of the artist. Just as the defendant's greeting card line appeared using the plaintiff's successful dress, AIPs almost always appear in the style of artists who already have a successful product in the market.

b. Roulo v. Russ Berrie & Co.

In the other case involving greeting cards, the Seventh Circuit held that the plaintiff had proven that it had a protectable trade dress. In Roulo v. Russ Berrie & Co., the court found that the fact that the plaintiff's cards "incorporated common, indistinct elements such as lines and handwriting does not refute the fact that [plaintiff's] combination of these elements was sufficiently unique to warrant trade-dress protection." The plaintiff's demonstration of the distinctiveness of its cards by showing the cards to the court was sufficient to prove distinctiveness and did not require an additional showing of secondary meaning. Therefore, an artist arguing for trade dress protection of her distinctive style may meet her burden of showing that her work has a distinctive style by showing her work to the court.

3. Cold Comfort: Romm Art

Romm Art Creations Ltd. v. Simcha Int'l., Inc. represents the greatest degree of trade dress protection that a federal court has ac-

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194. See supra note 191 and accompanying text.
196. See supra note 61 and accompanying text.
197. 886 F.2d 931 (7th Cir. 1989).
198. Id. at 936.
199. See id. at 936-37.
200. Of course, an artist must still articulate her trade dress to the court to ensure that her dress is recognized ab initio. See supra Part II.B.1. For examples of plaintiffs' trade dress, see supra note 158.
corded to an artist's visual style. In *Romm Art*, the court held that the plaintiffs had proven that the limited editions and fine art prints of an artist's works were entitled to trade dress protection.202 The plaintiffs in *Romm Art* were engaged in the business of distributing limited editions and fine art posters of works by the artist Tarkay.203 Each limited edition and poster was based on an original work from the artist's highly successful "Women and Cafes" series.204 The defendants marketed their own series of works that the plaintiffs alleged were "slavishly similar and entirely derivative of" the "Women and Cafes" series.205 After viewing the posters and the prints at issue, the court concluded that the Tarkay trade dress identified the origin of the items, and, therefore, met the criteria for an arbitrary or fanciful mark.206 The court went on to state that "[a] combination of visual features that creates a distinctive visual impression is not functional and is protectable."207 Because the Tarkay posters and limited editions created "just such a distinctive visual impression" and the trade dress was not functional, the court held that the Tarkay trade dress was protectable under section 43(a) of the Lanham Act.208 Significantly, the court acknowledged the importance of the holdings in *Hartford House*,209 *Harlequin Enterprises Ltd. v. Gulf & Western Corp.*,210 and *Hughes v. Design Look Inc.*211 in its determination that the Tarkay trade dress was entitled to Lanham Act protection.212

While *Hartford House* provides a foundation for the proposition that an artistic style can be protectable,213 *Romm Art* goes further in supporting that position. *Hartford House* concerned the overall look of the greeting cards.214 This included the card design, that is, where the fold was located, the kind of paper used, and the style of print employed.215 *Romm Art* focuses more on the style of the artwork itself. The subject matter of the case concerned posters and fine art prints, but the decision of the court did not rest on the design of these items. In other words, the kind of paper used and the style of the frame were not included in the plaintiff's trade dress. Instead, trade

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202. See id. at 1141.
203. See id. at 1130.
204. See id.
205. Id. at 1131.
206. See id. at 1136.
207. Id.
208. Id.
209. 647 F. Supp. 1533 (D. Colo. 1986), aff'd, 846 F.2d 1268 (10th Cir. 1988); see supra notes 179-95 and accompanying text.
210. 644 F.2d 946, 948-49 (2d Cir. 1981) (applying section 43(a) to the overall features of a book cover design).
211. 693 F. Supp. 1500, 1500-08 (S.D.N.Y. 1988) (applying section 43(a) to fine art images used in a poster calendar).
212. See *Romm Art*, 786 F. Supp. at 1135.
213. See supra notes 179-96 and accompanying text.
214. See supra note 193 and accompanying text.
215. See supra note 181 and accompanying text.
dress protection was extended only to the style of the artwork itself, a proposition denied by the Tenth Circuit in *Hartford House*.\(^1\) *Romm Art* offers a great deal of support for the artist who licenses her work to be used in connection with different items (scarves, notebooks, T-shirts, etc.) because the style of the artwork itself is protected as a source indicator.

*Romm Art* has been criticized by a federal court\(^2\) and several commentators.\(^3\) In addition, prior to the *Romm Art* decision, a New York district court had expressly rejected a section 43(a) claim similar to the claim in *Romm Art*. In *Furstenberg v. Coffaro*,\(^4\) the court held that Salvador Dali’s style, which consisted of “particular lines, unique figural constellation, colors, stylistic features and design of a certain subject in an image created by Dali and lawfully owned by plaintiff,”\(^5\) was not protectable under section 43(a).\(^6\) The court stated that the claim was properly brought under the federal copyright statute and not the trademark statute.\(^7\)

\(^{216}\) See supra note 193 and accompanying text.

\(^{217}\) See *Leigh v. Warner Bros.*, 10 F. Supp. 2d 1371, 1381 (S.D. Ga. 1998) (suggesting that by mistakenly relying on dicta in the *Hartford House* district court opinion, the *Romm Art* court “confused the popularity of Tarkay the artist with the use of the ‘Tarkay look’ as a product source designator.” Therefore, the *Romm Art* holding is contrary to the basic tenets of trademark law.” (quoting *Fitzpatrick*, supra note 68, at 464)).

\(^{218}\) See 1 *McCarthy*, supra note 71, § 8:6 n.9, at 8-20 (opining that *Romm Art* is a “unique result that seriously impinges on the copyright law's policy that artistic style is no one's exclusive property”); *Bell*, supra note 94, at 399 (arguing that the prints did not deserve trade dress protection because they were inspection goods, i.e., there was no feature of the artwork that consumers would value except its appearance, which itself was created by the supposed trade dress); *Prowda*, supra note 68, at 300 (stating that the decision is supported neither by precedent nor the works at issue); *Traphagen*, supra note 68, at 5 (suggesting that the court confused the popularity of Tarkay the artist with the source-indicating functions attributable to trademarks and trade dress); *Fitzpatrick*, supra note 68, at 455-66 (faulting the *Romm Art* court for summarily dismissing the functionality requirement, not analyzing the specific elements of the putative trade dress to determine distinctiveness, ruling that several of the Polaroid factors for proving the likelihood of confusion were established based on the same evidence that was used to prove distinctiveness, failing to recognize that in a work of fine art the design and the product are one in the same and not separable, and confusing the popularity of Tarkay the artist with the use of the “Tarkay look” as source designator).

\(^{219}\) 697 F. Supp. 1282 (S.D.N.Y. 1988). In addition, in *Hughes v. Plumsters, Ltd.*, 1989 U.S. Dist. LEXIS 16452, at *1* (N.D. Cal. Aug. 28, 1989), a district court decided a case that involved the use of an image of a cat produced in the “Andy Warhol” style (but not actually produced by Warhol) on a T-shirt with the caption “Andy Warhol's Cat” under the image. The court held that, as a matter of law, confusion as to the source of the artwork did not constitute confusion as to the source of the T-shirt (and therefore, no Lanham Act violation). See id. at *4*-*5*. Significantly, the plaintiff did not have a competing clothing line and the court found that likelihood of confusion was an issue for the jury. See id.

\(^{220}\) *Furstenberg*, 697 F. Supp. at 1289 (quoting Plaintiff's Memorandum).

\(^{221}\) See id. at 1290.

\(^{222}\) See id.
Romm Art's flaws, however, are not necessarily fatal to the artist trying to stop a manufacturer from marketing an AIP using her visual style. A major difference between the prints and posters at issue in Romm Art and art merchandise generally is that, in the context of art merchandise, the artistic image is a true trade dress separable from the product. In Romm Art, the prints and posters were based on actual works of Tarkay. These items, just like Tarkay's actual works, were valued only for their aesthetic qualities. That is, they had value only in their appearance, and their appearance was comprised solely of the putative trade dress. If one were to disregard the trade dress, there would be no discernible product remaining. In contrast, with art merchandise, there is a separate product underlying the trade dress. For example, if one were to disregard the Dali print on a duffel bag, there would still be a product (i.e., the duffel bag) underlying the trade dress. In this way, the trade dress is not the product and, instead fits comfortably under section 43(a) because it is used "in connection with . . . goods."

While concerns have been raised that Romm Art will lead to monopolies in ideas and accelerate the depletion of ideas in the public domain, these concerns do not properly arise in the context of art merchandise. The argument for protecting artistic expression is not premised upon commercial ends, but instead upon the right to free expression. The purpose of trademark and trade dress doctrine is to protect parties that have built up goodwill in the marketplace from those seeking to freeride off of that goodwill and thereby reap profits to which they are not entitled. In ruling that a distinctive trade

223. See supra note 204 and accompanying text.
224. See Bell, supra note 94 at 399; Fitzpatrick, supra note 68, at 457-58, 463.
225. See Bell, supra note 94, at 399.
226. This distinction is maintained in the context of art merchandise that is not meant to be a proxy for the actual work of art (e.g., posters), but instead is comprised of art attached to a discreet object. For examples of art merchandise, see supra note 4 and accompanying text.
228. See id. at 458.
229. See Ginsburg, supra note 69, at 19-21; Traphagen, supra note 68, at 5; Fitzpatrick, supra note 68, at 475-76. In the context of ensuring that trademark law does not inhibit free expression, one commentator has stated that applying the Lanham Act to cases involving alleged infringements of works of fine art produces a strained legal analysis because the Lanham Act is better suited to protect interests in "nonexpensive commercial and consumer products." Traphagen, supra note 68, at 6; see also Brownlee, supra note 68, at 1174-75 ("The fact that trademark law seems to offer greater protection to art produced more for commercial reasons than simply 'for art's sake' is not surprising, because the goals of trademark law are primarily the protection of business goodwill and safeguarding consumers against deception.").
230. See supra notes 73-75 and accompanying text; see also, e.g., Vuitton Et Fils S.A. v. J. Young Enterprises, Inc., 644 F.2d 769, 777 (9th Cir. 1981) (finding liability where defendant Young "as the imitator, is appropriating Vuitton's reputation in the marketplace for Young's own purpose and gain. . . . By choosing to appropriate Vuit-
dress in a consumer product is protectable, courts have found that there are enough trade dress alternatives available such that competition in the market will not be foreclosed. Therefore, protecting an owner's trade dress does not prevent other parties from effectively competing in the market. Accordingly, a manufacturer of an AIP need not use an image in the style of an artist who already has a market presence to sell merchandise. In addition, this point also addresses the issue that trade dress protection will overprotect commercial artists to the detriment of artists who choose not to work in such a setting. As trade dress only seeks to protect parties in commerce, artists who seek trade dress protection for their visual style

232. See Knitwaves, Inc. v. Lollytogs Ltd., 71 F.3d 996, 1006 (2d Cir. 1995) (holding that defendant did not make the required showing to prove functionality of plaintiff's sweater design because it has "adduced no evidence whatsoever that the number of designs available for 'fall motif' sweaters is limited"); Hartford House, Ltd. v. Hallmark Cards, Inc., 846 F.2d 1268, 1273 (10th Cir. 1988) (holding that "the availability of alternative appealing designs is a key factor in determining that a trade dress is nonfunctional" because "[t]his is not a case where there are a limited number of designs available . . . "). As the Ninth Circuit has observed:

Nothing prevents [the defendant] from constructing or manufacturing its own similar line of luggage with its own unique trademark, and marketing that line without confusing the public about the origin and manufacturer of the goods. . . . Competition is not hindered by requiring [the defendant] to develop its own distinctive design for use in the decoration of its manufactured products . . . .

Vuitton, 644 F.2d at 777.

233. If the use of a certain aesthetic trade dress is necessary to effectively compete in a market, then the dress is deemed to be "functional" and is not protectable. See Pagliero v. Wallace China Co., 198 F.2d 339, 343-44 (9th Cir. 1952) (finding "Baroque" style of china was functional). But see Wallace Int'l Silversmiths, Inc. v. Godinger Silver Art Co., 916 F.2d 76, 81 (2d Cir. 1990) (criticizing Pagliero for "overbreadth" in its formulation of the aesthetic functionality doctrine and, instead, requiring a "finding of foreclosure of alternatives" before trademark protection is denied); Vuitton, 644 F.2d at 774 ("The policy expressed in Pagliero and the cases decided under it is aimed at avoiding the use of a trademark to monopolize a design feature which, in itself and apart from its identification of source, improves the usefulness or appeal of the object it adorns."). A feature of a product is not per se functional just because it contributes to the consumer appeal and saleability of a product. See Vuitton, 644 F.2d at 773.

234. See Knitwaves, 71 F.3d at 1006 (stating that plaintiff's use of squirrels and leaves in a fall motif on its sweaters did not limit defendant's ability to create alternative designs in a fall motif; plaintiff was only entitled to protection from defendant creating designs so similar as to create a likelihood of confusion). Professor Ginsburg suggests that a manufacturer marketing a wastebasket with a "Matisse-inspired design" may claim that the product makes a statement about the value of "not-so-modern" art that is widely accepted by the contemporary middle class. See Ginsburg, supra note 69, at 21. She concludes that where the context of the item is "mass commercial," the item's identity as merchandise will predominate over considerations for free expression and the manufacturer will be subject to trademark and unfair competition laws. See id.

235. See Fitzpatrick, supra note 68, at 474-75.
as used in art merchandise will not be able to prevent other artists who may incorporate the artist's style in their own fine artworks.

There is yet another distinction between *Romm Art* and art merchandise. Trademark doctrine protects against the confusion of "the average purchaser."\(^\text{236}\) Purchasers of fine art will likely be informed, sophisticated parties capable of discerning similar styles. In contrast, purchasers of art merchandise are likely to be less informed and therefore more likely to be deceived in the marketplace.\(^\text{237}\) Protecting purchasers of art merchandise is, therefore, consistent with the protection from confusion that trademark law seeks to accomplish.\(^\text{238}\)

4. Further Refinement of Source Identification

Some courts have drawn a distinction between trade dress cases that deal with product packaging and those that deal with product design and configuration.\(^\text{239}\) Most significant of those cases in the context of protecting visual artistic style is *Knitwaves, Inc. v. Lollytogs Ltd.*\(^\text{240}\) In *Knitwaves*, the plaintiff was a manufacturer of sweaters that were decorated with leaves, squirrels, and other fall motifs.\(^\text{241}\) The

\(^{236}\) See Fleishmann Distilling Corp. v. Maier Brewing Co., 314 F.2d 149, 155 (9th Cir. 1963). The court stated that "[t]he law is not made for the protection of experts, but for the public—that vast multitude which includes the ignorant, the unthinking and the credulous, who, in making purchases, do not stop to analyze, but are governed by appearance and general impressions." *Id.* at 156 (quoting Stork Restaurant v. Sahati, 166 F.2d 348, 359 (9th Cir. 1948)).

\(^{237}\) This argument relates directly to the last *Polaroid* factor, regarding the sophistication of buyers in the marketplace. See *supra* Part II.B.2 (discussing the *Polaroid* factors); *see also* Brownlee, *supra* note 68, at 1174 (arguing that trademark law will protect "artists who mass produce art for commercial resale" more than artists who produce fine art because the observers and consumers of mass produced art have considerably less expertise in discerning differences in the constituent works and would be more likely to be confused as to the origin of the works).

\(^{238}\) For discussion of the confusion requirement of a claim under the Lanham Act, see *infra* Part III.C.

\(^{239}\) Most significant of these cases is *Duraco Prods., Inc. v. Joy Plastic Enterps., Ltd.*, 40 F.3d 1431 (3d Cir. 1994). In *Duraco*, the Third Circuit held that in cases of product configuration, the *Abercrombie* taxonomy for determining distinctiveness is inapplicable and instead, in order for a trade dress to be inherently distinctive, it "must be (i) unusual and memorable; (ii) conceptually separable from the product; and (iii) likely to serve primarily as a designator of origin of the product." *Id.* at 1449. *Duraco* has not been adopted by other circuits. See, *e.g.*, *Knitwaves*, 71 F.3d at 1009 n.6 (recognizing the reasoning of the *Duraco* court in distinguishing between product features and product packaging, but expressly declining to apply the *Duraco* court's three part test); *Stuart Hall Co., v. Ampad Corp.*, 51 F.3d 780, 787 (8th Cir. 1995) (stating that trade dress is a single concept encompassing both product configuration and product packaging and expressly declining to adopt the *Duraco* standard). In addition, determining precisely where the packaging ends and the product begins can be dispositive. See *Landscape Forms, Inc. v. Columbia Cascade Co.*, 113 F.3d 373, 379 (2d Cir. 1997) ("[T]his circuit appears to be moving toward a rule that packaging is usually indicative of a product's source, while the design or configuration of the product is usually not so.").

\(^{240}\) 71 F.3d 996 (2d Cir. 1995).

\(^{241}\) See *id.* at 999-1001.
Second Circuit held that where the trade dress is not product packaging, but instead consists of product features, the Abercrombie categories are not applied to determine distinctiveness. Instead, the proper inquiry is whether the trade dress is "likely to serve primarily as a designator of origin of the product." The court held that "since the primary purpose of [plaintiff's] sweater designs is aesthetic rather than source-identifying, [plaintiff's] sweater designs do not meet the first requirement of an action under [section] 43(a) of the Lanham Act—that they be used as a mark to identify or distinguish the source."

In Mulberry Thai Silks, Inc., v. K & K Neckwear, Inc., the district court considered the plaintiff's claim of trade dress infringement with respect to his line of neckties that he designed in-house and had produced by outside textile manufacturers. The court found that "the design of the fabric used in a necktie is not suggestive of the product or its source at all—in a fundamental sense it is the product itself." The court expressly refused to apply either the Abercrombie or the Duraco tests, but it did observe that "two designs may be sufficiently similar to be mistaken, one for the other, without either design being associated with any particular source." In such a situation, there is not a protectable trade dress.

Knitwaves and Mulberry Thai Silks raise an important issue for the artist seeking to keep AIPs using her style off of the market. The artist must establish that the style of her work on the product is not merely indicative of source, but primarily indicative of source. In Samara Bros., however, the Second Circuit distinguished the aesthetic elements of the Knitwaves sweaters from the design elements making up the Samara trade dress. The court recognized Samara's intent to use consistent design elements to create a look that would be identified with the company and thereby build brand loyalty. The court

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242. See id. at 1007. In a later case, the Second Circuit held that the Abercrombie analysis continued to apply to product packaging cases. See Fun-Damental Too, Ltd. v. Gemmy Indus. Corp., 111 F.3d 993, 1001 (2d Cir. 1997).
243. Knitwaves, 71 F.3d at 1008 (quoting Duraco, 40 F.3d at 1449).
244. Id. at 1006. Accord Banff Ltd. v. Express, Inc., 921 F. Supp. 1065, 1071 (S.D.N.Y. 1995) (interpreting Knitwaves, in another sweater case, as requiring that "a plaintiff must do more than demonstrate that the appearance of its product serves some source identifying function. It must demonstrate that the primary purpose behind the design was to identify its product's source.").
246. The court described the dress that the plaintiff was seeking to protect as not more than its "particular use of bright colors and geometric patterns, in an industry in which the use of such design elements is common." Id. at 797. Accordingly, the court found that the dress was not inherently distinctive. See id.
247. Id. at 793.
248. Id. at 797.
249. 165 F.3d 120 (2d Cir. 1998). For a discussion of the case, see supra notes 173-78 and accompanying text.
250. 165 F.3d at 125.
also stated that Samara's product line was its core business and the "lifeblood of the company." The court went on to state that the two sweaters at issue in *Knitwaves* had never before been manufactured by the Knitwaves nor was there an intent on the part of Knitwaves to establish the "fall motif" as its core product in the marketplace. Clearly, under this decision, an artist seeking to protect a visual style that is used most successfully in connection with the sale of goods is in a better position than if the style she seeks to protect does not have proven marketability or was not used by the artist to build identity recognition in the marketplace.

At this point, a distinction can be drawn between the aesthetic value of works of fine art and the aesthetic value of works used in connection with art merchandise. Works of fine art are valued for their aesthetic qualities. Under the *Knitwaves* doctrine, it seems impossible that an artist would be able to obtain trade dress protection for a visual style employed to create a work of art. This is obvious because the trade dress is adopted for its aesthetic properties and was not adopted primarily for the purposes of identifying its source. The images of art on art merchandise, however, have significantly less aesthetic appeal than the actual works themselves. Images of works of art are wrapped around coffee mugs, shrunken down to fit onto the faces of wristwatches, and cropped to fit onto neckties and other odd shaped objects. This process of visual distortion reduces the aesthetic value of these images and gets to the heart of why the images were chosen in the first place. They are used to make an association. For art merchandise, the drawing power of the product is the association with the artist. The primary purpose of the image is to identify the artist and associate the artist with the product. In this way, the association with the artist is primary and the aesthetic value of the image is secondary.

251. See id.
252. See id.
253. See supra notes 224-27 and accompanying text.
254. See supra notes 240-44 and accompanying text.
255. See Warner Bros., Inc. v. Gay Toys, Inc., 724 F.2d 327, 333 (2d Cir. 1983) (stating, in a case that involved the trade dress of a toy, that there was no doubt that consumers wanted the toy in part because they identified it with the television series in which it was featured). Even the way in which one refers to art merchandise is evidence of the association made between the artist and the item, e.g., Caillebotte umbrellas, Monet neckties, etc. For additional examples, see supra notes 5-12 and accompanying text.
256. To the extent that the mark "increases consumer appeal only because of the quality associated with [the] goods, or because of the prestige associated with owning a genuine [article], then the design is serving the legitimate function of a trademark; it is identifying the source of the product, and thus should be protected." Vuitton Et Fils S.A. v. J. Young Enters., Inc., 644 F.2d 769, 776 (9th Cir. 1981).
C. Step Two: Likelihood of Confusion

In the context of art merchandise, a potential purchaser could see the defendant manufacturer’s AIP and believe, by virtue of the visual style, that the AIP is sponsored by the plaintiff. This form of confusion exists most obviously when a potential customer views products on a store shelf. If the manufacturer of an AIP can get a potential purchaser to look at his merchandise, which she would otherwise not consider purchasing, by using the visual style of an inspiring artist, then he has created the kind of confusion that is proscribed by this doctrine. Labels and hangtags on the merchandise do not change the fact that the AIP manufacturer has caused confusion by getting the potential purchaser to look at his goods and investigate further.

A second kind of confusion does not emphasize the effect on potential purchasers, but, instead, looks to the effect on third parties that see the article in use by a purchaser. This principle easily applies to AIPs. Even if the purchaser is not confused as to the source of the article that she is buying because of the packaging or labeling, she invariably removes such designations after she purchases the article. Therefore, even if a scarf comes with a tag that says, “apres Dali,” and the purchaser easily sees it, the manufacturer of the AIP can still cause confusion. When the purchaser wears the scarf, those who see her wearing it are likely to be confused, believing that the scarf depicts a Dali image. In this way, the purchaser has the prestige of wearing a Dali scarf when she has not actually purchased one.

CONCLUSION

The art merchandise industry is becoming increasingly competitive. As the amount of art licensing increases and art merchandise becomes available in almost every possible form, the incentive grows for manufacturers to avoid the formal process of licensing artists’ images. While artists are becoming more protective of their reputations, some manufacturers are resorting to producing AIPs in the visual styles of artists who already have a presence in the market.

257. See supra notes 121-28 and accompanying text.
258. See infra note 260.
259. See supra notes 129-33 and accompanying text.
260. The use of labels alone cannot insulate an infringer from liability for consumer confusion. See Samara Bros., Inc. v. Wal-Mart Stores, Inc., 165 F.3d 120, 128 (2d Cir. 1998) (“We do not mean to intimate that the distinctive elements of any trade dress may be freely appropriated as long as the junior user clearly identifies the source of the goods.” (citing Bristol-Myers Squibb Co. v. McNeil-P.P.C., Inc., 973 F.2d 1033, 1047 (2d Cir. 1992))); Sunbeam Prods., Inc. v. West Bend Co., 123 F.3d 246, 259 (5th Cir. 1997),cert. denied, 118 S. Ct. 1795 (1998) (“While we have recognized that labels may dispel consumer confusion, under appropriate circumstances, we have never held that this is an absolute affirmative defense to every trademark infringement claim.”).
261. See United States v. Hon, 904 F.2d 803, 808 (2d Cir. 1990) (involving knockoffs of Rolex watches that a casual observer would likely believe to be genuine articles).
By availing herself of section 43(a) of the Lanham Act, an artist can make a case for trade dress infringement of her visual style as used in connection with art merchandise. The direction of recent trade dress cases supports the artist’s claim that her visual style, when used in connection with art merchandise, is a trade dress indicative of source. Despite the weaknesses in the Romm Art decision, an artist can still make a case that her style is distinctive. As there are alternative product designs available to the AIP manufacturer, an artist’s style will not be found to be functional. In addition, while works of fine art are valued solely for their aesthetic qualities, the use of an artist’s image on art merchandise has less aesthetic value and can be source-indicating. When an AIP manufacturer uses the artist’s style to market his own goods, he is likely to confuse the purchasing public and the casual observer into believing that his AIP is sponsored by or associated with the artist. In this manner, the AIP manufacturer freerides off of the artist’s goodwill and infringes the artist’s right to control the use of the reputation she has built up over her career.