

# Fordham Intellectual Property, Media and Entertainment Law Journal

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Volume 8 *Volume VIII*  
Number 3 *Volume VIII Book 3*

Article 6

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1998

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### Recommended Citation

Michele A. Shpetner, *Determining A Proper Test for Inherent Distinctiveness in Trade Dress*, 8 Fordham Intell. Prop. Media & Ent. L.J. 947 (1998).

Available at: <https://ir.lawnet.fordham.edu/iplj/vol8/iss3/6>

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# Determining A Proper Test for Inherent Distinctiveness in Trade Dress

Michele A. Shpetner\*

## INTRODUCTION

When Bob Dole used the anti-drug slogan “Just Don’t Do It” during his 1996 presidential campaign, he drew a cry of foul from Nike, Inc. (“Nike”).<sup>1</sup> The sneaker giant accused Dole of stepping on its trademark toes by adapting Nike’s “Just Do It” advertising slogan to his own uses.<sup>2</sup> Fearful of being perceived as endorsing a presidential candidate, Nike demanded that Dole abandon the catchy motto.<sup>3</sup>

Nike told Dole that its catch phrase “Just Do It” was a registered trademark,<sup>4</sup> created and employed to sell athletic gear.<sup>5</sup> Moreover, Nike declared that the public had, over time, come to identify the saying with Nike and its advertisements.<sup>6</sup> Accordingly, Nike asserted the right to protect the expression “Just Do It”—and its permutations—from exploitation by non-Nike entities.<sup>7</sup> Nike viewed Senator Dole’s slogan “Just Don’t Do It” as an

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\* Fordham University School of Law, J.D. 1998. Special thanks to Professor Joseph D. Garon of Fordham University School of Law, Rick Chertoff, David Stoller, Thomas Shpetner, and my parents Dr. and Mrs. Barry D. Galman.

1. See Michael Wines, *Just Do . . . Whatever*, N.Y. TIMES, Sept. 22, 1996, § 4 (Week in Review), at 2.

2. *Id.*

3. *See id.*

4. *Id.*

5. *See id.*

6. *See id.* When the public begins to identify a trademark with its source, the trademark is said to have acquired “secondary meaning” and receives protection from infringers. See Willajeanne F. McLean, *The Birth, Death, and Renaissance of the Doctrine of Secondary Meaning in the Making*, 42 AM. U.L. REV. 737, 748 (1993); Craig Allen Nard, *Mainstreaming Trade Dress Law: The Rise and Fall of Secondary Meaning*, 1993 DET. C.L. REV. 37 (1993).

7. See McLean, *supra* note 6; Nard, *supra* note 6; see also 15 U.S.C. § 1125(a) (1994) (governing trademark and trade dress infringement).

infringing use of the Nike trademark,<sup>8</sup> thus enjoined under the law.<sup>9</sup>

Dole capitulated to Nike's demand.<sup>10</sup> As his campaign staff discovered, a trademark is an important aspect of a product's image, which a company will go to great lengths to protect.<sup>11</sup> In general, a trademark is defined as "any word, name, symbol, or device, or any combination thereof,"<sup>12</sup> that is adopted and used by a manufacturer or merchant "to identify his goods and distinguish them from those manufactured and sold by others."<sup>13</sup> Where the owner of a trademark has spent energy, time, and money in presenting a product to the public, his investment is legally protected from misappropriation by imitators or trespassers.<sup>14</sup> For businesses, trademarks are a kind of "badge of honor,"<sup>15</sup> because they allow consumers to identify and intelligently choose among products.<sup>16</sup> Misuse of a trademark by an imitator may result in the lost sales and tarnished reputation of the original trademark owner, and may trick the public into buying fraudulent goods which are not associated with the trademarked goods.<sup>17</sup> As a result, trademark infringement harms both the manufacturer and the consumer.<sup>18</sup>

Trade dress—a legal species within the trademark family—refers to a product or service's overall appearance and its total im-

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8. *See* Wines, *supra* note 1.

9. *See* 15 U.S.C. § 1125(a) (1994) (protecting slogans and other trademark devices against any use that is likely to cause confusion as to the source of goods or cause a mistake as to the affiliations, associations, or connections between persons or producers of goods).

10. *See* Wines, *supra* note 1.

11. *See* 1 J. THOMAS MCCARTHY, TRADEMARKS AND UNFAIR COMPETITION § 8:1 (4th ed. 1997) [hereinafter MCCARTHY, TRADEMARKS].

12. 15 U.S.C. § 1127 (1994).

13. *Id.*

14. *See* S. REP. NO. 79-1333, at 2 (1946), *reprinted in* 1946 U.S.C.C.A.N. 1274, 1275.

15. 134 CONG. REC. H10419 (daily ed. Oct. 19, 1988) (statement of Rep. Kastemeier).

16. *Id.* ("Trademarks are considered the essence of competition, because they make possible a choice between competing articles by enabling the buyer to distinguish one from the other.").

17. *See* *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4 (2d Cir. 1976) (discussing the possibilities of confusion between similar trademarks).

18. *See id.*

age presented to consumers.<sup>19</sup> By contrast, a trademark appears as a name or symbol, and labels a product or service.<sup>20</sup> A product's trade dress includes such aspects as the product's size, shape, color, graphics, packaging, label, advertising techniques, and marketing techniques.<sup>21</sup> In examining those aspects, courts have granted trade dress protection to a broad spectrum of products and ideas, including restaurant layouts;<sup>22</sup> form letters;<sup>23</sup> playground equipment;<sup>24</sup> designs and packaging relating to brands of ice cream,<sup>25</sup> cleaning supplies,<sup>26</sup> pantyhose,<sup>27</sup> vodka,<sup>28</sup> lamps,<sup>29</sup> and

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19. A product or service's total image implicates a broad spectrum of marks, symbols, design elements and characters. See 15 U.S.C. § 1125(a) (1994). In particular, section 1125(a) provides for a cause of action for unprivileged imitation of a distinctive trademark or trade dress. *Id.* § 1125(a)(1)(a)-(b); see also *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 765 n.1 (1992); Jamison Dean Newberg, *The Same Old Enchilada? The Supreme Court Simplifies the Protection of Inherently Distinctive Trade Dress In Two Pesos v. Taco Cabana*, 13 REV. LITIG. 299 (1994).

20. For example, the McDonald's golden arched "M" is a trademark, and the corresponding red and gold theme used throughout McDonald's packaging is its trade dress. See *McDonald's Corp. v. McBagel's, Inc.*, 649 F. Supp. 1268 (S.D.N.Y. 1986) (holding the use of the name "McBagel's" infringed McDonald's trademark). The court discussed the golden arches, and the use of the "Mc" formative with generic food items, such as "Egg McMuffin," "Chicken McNuggets," and "Big Macs," among others. The court found that the golden arches and the "Mc"/"Mac" formative were strong trademarks. *Id.* at 1274. The court explained that the strength of a trademark depends in large part on how distinctive it is, or its tendency to identify goods or services sold under the trademark with the particular source. *Id.* at 1270-71. "The McDonald's [trade]marks and every aspect of its distinctive business, including McDonald's unique restaurants and their golden arches are well known." *Id.* at 1271.

21. *LeSportsac, Inc. v. K Mart Corp.*, 754 F.2d 71, 75 (2d Cir. 1985) (noting that while trade dress traditionally involved the packaging or labeling of a product, the term now includes the shape and design of the product as well) (citing *John H. Harland Co. v. Clarke Checks, Inc.* 711 F.2d 966, 980 (11th Cir. 1983)); see also *Vaughan Mfg. Co. v. Brikam Int'l, Inc.*, 814 F.2d 346, 348 n.2 (7th Cir. 1987).

22. See, e.g., *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992) (finding Mexican restaurant decor inherently distinctive); *Fuddrucker's, Inc. v. Doc's B.R. Others, Inc.*, 826 F.2d 837 (9th Cir. 1987) (finding black and white checkered floor and restaurant layout inherently distinctive); see also *Prufrock Ltd. v. Lasater*, 781 F.2d 129, 131-32 (8th Cir. 1986) (noting that "section 43(a) [of the Lanham Act] can be used to protect a restaurant's trade dress from confusingly similar imitations but that a competitor cannot have exclusive trade dress rights in the mere method and style of doing business").

23. See, e.g., *Computer Care v. Service Sys. Ent.*, 982 F.2d 1063 (7th Cir. 1992) (finding car care repair reminder letter inherently distinctive).

24. See, e.g., *Kompan, A.S. v. Park Structures, Inc.*, 890 F. Supp. 1167 (S.D.N.Y. 1995) (holding Kompan's use of curves and colors inherently distinctive).

25. See, e.g., *AmBrit, Inc. v. Kraft, Inc.*, 812 F.2d 1531, 1536 (11th Cir. 1986)

household appliances.<sup>30</sup> Trade dress litigation often arises when a consumer mistakenly assumes that a product or service is associated with a source, other than its actual source, due to similarities between the two products' appearances.<sup>31</sup>

Trade dress falls within the scope of the Lanham Act,<sup>32</sup> the primary federal legislation protecting trademarks. The Lanham Act's underlying purpose is to protect both consumers and competitors from fraud and a variety of misrepresentations of products and services.<sup>33</sup> To qualify for statutory protection under section 43(a) of the Lanham Act ("section 43(a)"),<sup>34</sup> a trademark or trade

(finding square size, bright coloring, and polar bear and sunburst images on the package of the "Klondike" ice cream bar protectable as trade dress), *cert. denied*, 481 U.S. 1041 (1987).

26. *See, e.g.*, *Blue Coral, Inc. v. Turtle Wax, Inc.*, 664 F. Supp. 1153, 1163 (N.D. Ill. 1987) (looking at elements such as the color of the packaging, the color of the liquid, and the use of a clear rather than an opaque bottle to determine whether trade dress was protectable).

27. *See, e.g.*, *Sara Lee v. Kayser-Roth Corp.*, 81 F.3d 455, 465 (4th Cir. 1996) (holding L'eggs pantyhose trademark and trade dress of an egg inherently distinctive).

28. *See, e.g.*, *Carillion Importers Ltd. v. Frank Pesce Co. Inc.*, 913 F. Supp. 1559 (S.D. Fla. 1996) (holding Stolichnaya Crisall Vodka's bottle shape and label design protectable as trade dress), *aff'd*, 112 F.3d 1125 (11th Cir. 1997).

29. *See, e.g.*, *Bauer Lamp. Co., Inc. v. Shaffer*, 941 F.2d 1165, 1170 (11th Cir. 1991) (holding lamp design inherently distinctive).

30. *See, e.g.*, *Bloomfield Indus., Div. of Specialty Equip. Cos., Inc. v. Stewart Sandwiches, Inc.*, 716 F. Supp. 380, 385 (N.D. Ind. 1989) (denying summary judgment in coffee maker trade dress case).

31. *See* Martin P. Hoffman, *Trade Dress/Product Simulation Overview*, C913 ALI-ABA 219, 222 (1994).

32. Trademark Act of 1946 ("Lanham Act"), ch. 540, 60 Stat. 427 (codified as amended at 15 U.S.C.A §§ 1051-1127 (West 1998 & Supp. 1998)).

33. *See* MCCARTHY, TRADEMARKS, *supra* note 11, § 8:1, at 282-83. Section 43(a) of the Lanham Act, in pertinent part, provides that:

Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any work, 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 . . . shall be liable in a civil action by any person who believes that he or she is likely to be damaged by such act.

15 U.S.C. § 1125(a) (1994).

34. 15 U.S.C.A. § 1125 (West 1997).

dress must be “inherently distinctive”<sup>35</sup> or must acquire sufficient secondary meaning to be capable of distinguishing a particular business or product from that of another.<sup>36</sup>

Trade dress law mirrors trademark law in purpose and available protections.<sup>37</sup> Problems arise, however, because trademarks and trade dress are not identical concepts.<sup>38</sup> Determining inherent distinctiveness in a trademark case is a clear-cut procedure involving the application of a universally accepted rule;<sup>39</sup> however, determining inherent distinctiveness in trade dress is a real snake’s nest by comparison.<sup>40</sup>

The confusion over “inherent distinctiveness” in trade dress results from courts’ attempts to apply to trade dress specific categories of distinctiveness originally developed in the context of trademark litigation.<sup>41</sup> While the law is clear that trademark classifications apply equally to both trade dress and trademarks,<sup>42</sup> trademark distinctions often do not translate seamlessly to trade

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35. See Ronald J. Horta, *Without Secondary Meaning, Do Product Design Trade Dress Protections Function as Infinite Patents?*, 27 SUFFOLK U.L. REV. 113, 116 (1993).

36. See Joel W. Reese, *Defining the Elements of Trade Dress Infringement Under Section 43(a) of the Lanham Act*, 2 TEX. INTELL. PROP. L.J. 103, 108 (1994); see also *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992).

37. See Horta, *supra* note 35, at 132.

38. See *Knitwaves, Inc. v. Lollytogs, Ltd.*, 71 F.3d 996, 1006-08 (2d Cir. 1995) (discussing trademarks, trade dress, and varying approaches to determining trade dress infringement).

39. See *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (citing *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4 (2d Cir. 1976)).

40. See Melissa R. Gliberman, *From Fast Cars to Fast Food: Overbroad Protection of Product Trade Dress Under Section 43(a) of the Lanham Act*, 45 STAN. L. REV. 2037 (1993); Siegrun D. Kane, *Trademark Infringement Litigation 1996: “The Day of the Copycat”*, 432 P.L.I./PAT. 193 (1996); Susan Orenstein, *Trademark Protection is Expanded: Product’s Image Protectable Even If Not Widely Recognized*, RECORDER, June 29, 1992, at 1.

41. See Ralph S. Brown, *Design Protection: An Overview*, 34 UCLA L. REV. 1341, 1379 (1987); Theodore H. Davis, *Copying in the Shadow of the Constitution: The Rational Limits of Trade Dress Protection*, 80 MINN. L. REV. 595 (1996); William F. Gaske, *Trade Dress Protection: Inherent Distinctiveness As An Alternative to Secondary Meaning*, 57 FORDHAM L. REV. 1123, 1136 (1989); Jenny Johnson, *Two Pesos, Inc. v. Taco Cabana, Inc.: The Supreme Court’s Expansion of Trade Dress Protection Under Section 43(a) of the Lanham Act*, 24 LOY. U. CHI. L.J. 285, 286 (1993).

42. See *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (stating that the Lanham Act does not draw a distinction between trademarks and trade dresses, and regulates both); Reese, *supra* note 36, at 108.

dress disputes.<sup>43</sup> Specifically, trade dress actions concern shapes, colors, and design elements, which do not easily fit within the categories designed to suit the words or symbols of a trademark.<sup>44</sup> Because the trademark tests rarely apply smoothly to trade dress litigation, federal courts do not universally agree on which characteristics constitute “inherently distinctive” protectable trade dress.<sup>45</sup> This lack of agreement has led to inconsistent results in trade dress actions.<sup>46</sup>

Complicating matters further, both the Second and Third Circuit have recently held that a product’s design, namely the actual product itself, rather than solely its packaging, may function as the product’s trade dress.<sup>47</sup> As a result, these courts not only grapple with trademark law as it applies to trade dress, but also split trade dress into two distinct camps: (1) product configuration and (2) package design.<sup>48</sup> Thus, courts not only vary in their approaches to defining inherent distinctiveness, but also vary on whether the same definition of inherent distinctiveness that applies to a product’s packaging should also apply to a product’s configuration.<sup>49</sup>

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43. See *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4 (2d Cir. 1976). The *Abercrombie* court placed potential trademarks into four categories in an order that roughly corresponds to “the degree of [trademark] protection accorded [them]: (1) generic; (2) descriptive; (3) suggestive; and (4) arbitrary or fanciful.” *Id.* at 9. Of these four categories, the last two, “suggestive” and “arbitrary or fanciful,” are considered to be “inherently distinctive,” that is, capable of federal registration without any further proof of secondary meaning. An inherently distinctive mark is any term that is fanciful, arbitrary or suggestive and, therefore, under trademark law does not require secondary meaning for legal protection. See MCCARTHY, TRADEMARKS, *supra* note 11, § 11:2, at 11-15; see also Johnson, *supra* note 41; James E. Stewart & H. Michael Huget, *Trade Dress: Protecting a Valuable Asset*, 74 MICH. B.J. 56 (1995) (discussing properties of inherently distinctive trade dress).

44. See *Chevron Chem. Co. v. Voluntary Purchasing Groups*, 659 F.2d 695, 700 (5th Cir. 1981), *cert. denied*, 457 U.S. 1126 (1982); Reese, *supra* note 36, at 104-05.

45. See Kane, *supra* note 40 (surveying the landscape of disagreement among courts regarding the qualifications of inherently distinctive trade dress); see *infra* Part II (discussing various tests employed by different courts).

46. See Kane, *supra* note 40.

47. See, e.g., *Duraco Prods., Inc. v. Joy Plastic Enters., Ltd.*, 40 F.3d 1431, 1438 (3d Cir. 1994); *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996 (2d Cir. 1995).

48. See, e.g., *Duraco Prods., Inc. v. Joy Plastic Enters., Ltd.*, 40 F.3d 1431 (3d Cir. 1994); *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996 (2d Cir. 1995).

49. See Nancy Dwyer Chapman, *Trade Dress Protection in the U.S. After the Supreme Court Decision in Two Pesos*, 387 PLI/PAT. 7 (1994); see, e.g., *Duraco Prods., Inc. v. Joy Plastic Enters., Ltd.*, 40 F.3d 1431 (3d Cir. 1994); *Knitwaves, Inc. v. Lollytogs*

To make matters worse, a related trademark concept known as “secondary meaning” is often confused as a synonym for inherent distinctiveness. In fact, the two concepts are separate links on a chain. Inherent distinctiveness and secondary meaning are the heart and soul of trade dress protection,<sup>50</sup> because if a mark is not found to be inherently distinctive, the court may nonetheless protect the mark if the litigant can prove the existence of “secondary meaning.”<sup>51</sup> Secondary meaning is viewed as “acquired inherent distinctiveness,” which exists when “everybody knows”<sup>52</sup> that a product’s trade dress indicates the source of the product. For example, the Third Circuit has held that it is common knowledge that a small, three-dimensional square puzzle with moving parts, made up of orange, white, blue, and yellow squares is a “Rubik’s Cube.”<sup>53</sup> The Rubik’s Cube has thus acquired secondary meaning over time, and the buying community identifies the product’s trade

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Ltd., 71 F.3d 996 (2d Cir. 1995).

50. Distinctiveness, generally, is a trademark classification term meaning that the mark is unique or different in such a way that it will automatically be capable of distinguishing a producer’s goods or services from those of its competitors. *See Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4 (2d Cir. 1976). “Inherent distinctiveness” exists if a trademark has been classified as “arbitrary or fanciful” because it possesses features that neither assist in describing the product nor functionally assist in the product’s effective packaging. *See Chapman, supra* note 49, at 20. The factors used to determine inherent distinctiveness include determining whether the trademark is considered to be uncommon, unique or unusual in a particular market. *See id.* at 17. Unlike inherent distinctiveness, “secondary meaning” is concerned with whether the trademark *actually* identifies the source of particular goods, not whether the trademark is *capable* of identifying a particular source. *See id.* at 17. The judicial doctrine of secondary meaning is well settled, and recognizes that a descriptive word, phrase or image, after a period of time and exclusive association with particular goods or services, can identify the goods or services with their producer. *See Gaske, supra* note 41, at 1123. Essentially, secondary meaning is equivalent to the concept of buyer association, and has nothing to do with the distinctiveness of the packaging as it relates to the product itself. *See id.*

51. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 769 (1992); *see Reese, supra* note 36, at 108 (defining the established common law *Abercrombie & Fitch* spectrum of categories used to classify the levels of distinctive trademarks).

52. *Horta, supra* note 35, at 113; *see also Fuddruckers, Inc. v. Doc’s B.R. Others, Inc.*, 826 F.2d 837, 843 (9th Cir. 1987) (holding restaurant motifs virtually identical, and noting that if “trade dress is *inherently distinctive*, the further requirement of a showing of secondary meaning should be superfluous”).

53. *See Ideal Toy Corp. v. Plawner Toy Mfg. Corp.*, 685 F.2d 78 (3d Cir. 1982) (design of “Rubik’s Cube” protected as trade dress).



dress with its specific source: Rubik.<sup>54</sup> Acquiring secondary meaning is predominantly the means by which an otherwise unprotectable mark may obtain protection.<sup>55</sup> Although inherent distinctiveness and secondary meaning are two different concepts, a finding of either leads to trademark and trade dress protection.<sup>56</sup>

Controversy exists because, in many trade dress cases, courts have melded secondary meaning and inherent distinctiveness into one giant concept, instead of keeping the ideas separate.<sup>57</sup> These courts erroneously label this composite as “inherent distinctiveness.”<sup>58</sup> The trade dress rulings of such courts are inconsistent with the rulings of courts that properly distinguish between secondary meaning and inherent distinctiveness.<sup>59</sup>

When courts intertwine ingredients of secondary meaning with inherent distinctiveness, they deny protection to otherwise valid inherently distinctive trade dress, absent a showing of secondary meaning.<sup>60</sup> This runs counter to the Lanham Act, which requires a finding of *either* secondary meaning *or* inherent distinctiveness.<sup>61</sup> Nevertheless, court rulings based on the erroneously mixed concept remain technically consistent with the mandates of the Lanham Act, although ideologically inconsistent with the Lanham Act

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54. See McLean, *supra* note 6, at 745; Chapman, *supra* note 49.

55. See Horta, *supra* note 35; see also *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992).

56. See *Two Pesos*, 505 U.S. at 769.

57. See, e.g., *Knitwaves, Inc. v. Lollytogs, Ltd.*, 71 F.3d 996 (2d Cir. 1995); *Duraco Prods., Inc. v. Joy Plastic Enters., Ltd.*, 40 F.3d 1431 (3rd Cir. 1994); see also McLean, *supra* note 6.

58. See, e.g., *Knitwaves*, 71 F.3d 996; *Duraco Prods.*, 40 F.3d 1431.

59. Compare *Chevron Chem.*, 659 F.2d at 702-03 (holding trade dress inherently distinctive because arbitrary and fanciful according to the *Abercrombie* trademark spectrum), with *Duraco Prods.*, 40 F.3d 1431 (holding trade dress not inherently distinctive because of a lack of secondary meaning; *Abercrombie* spectrum was discussed by the court and completely disregarded).

60. See Chapman, *supra* note 49, at 11, 14-15 (noting that in *Two Pesos* the Supreme Court criticized the Second Circuit's position in *Vibrant Sales, Inc. v. New Body Boutique, Inc.*, 652 F.2d 299 (2d Cir. 1981), that “unregistered marks did not enjoy the ‘presumptive source association’ found in registered marks, and so needed to prove secondary meaning”); see also Joan L. Dillon, *Two Pesos: More Interesting for What It Does Not Decide*, 83 TRADEMARK REP. 77 (1993); Stewart & Huget, *supra* note 43.

61. 15 U.S.C.A. § 1125(c) (West 1997); *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992).

Act itself.<sup>62</sup>

The 1992 Supreme Court decision in *Two Pesos v. Taco Cabana*<sup>63</sup> spurred a flurry of new activity in the area of trade dress protection by addressing this issue of merging the concepts of inherent distinctiveness and secondary meaning.<sup>64</sup> In *Two Pesos*,<sup>65</sup> the Supreme Court set out to resolve the circuit split regarding the requirements for protecting inherently distinctive trade dress. The Court held that a Mexican restaurant's inherently distinctive trade dress motif was protectable despite a lack of secondary meaning.<sup>66</sup> The Court's ruling echoed the Lanham Act's language that trade dress was protectable from infringement if it was either "inherently distinctive," or had acquired "secondary meaning."<sup>67</sup> By articulating the "either/or" standard,<sup>68</sup> the Court's opinion upheld a majority of circuit decisions which narrowly applied the trademark test for inherent distinctiveness to trade dress cases.<sup>69</sup> The opinion

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62. See *Chapman*, *supra* note 49, at 15-16 (noting that the Court in *Life Industries Corp. v. Ocean Bio Chem. Inc.* said that the inherently distinctive standard is less stringent than the secondary meaning standard); see also Dillon, *supra* note 60.

63. 505 U.S. 763 (1992). The court found that "trade dress" is the total image of the business, and found that Taco Cabana's trade dress included the shape and general appearance of the exterior of the restaurant, the identifying sign, the interior kitchen floor plan, the decor, the menu, the equipment used to serve food, the servers' uniforms, and other features reflecting on the total image of the restaurant. *Id.* at 764.

64. See *Chapman*, *supra* note 49, at 17-20 (discussing the Court's ruling that non-functional trade dress is protected under the Lanham Act); see also Dillon, *supra* note 60. Just prior to the decision in *Two Pesos*, the climate in the field of trade dress litigation was really heating up. See, e.g., Daniel J. Gifford, *The Interplay of Product Definition, Design and Trade Dress*, 75 MINN. L. REV. 769, 779 (1991) (stating that while trade dress protection is not new, recently there has been "exponential growth" in number of trade dress cases); Jere M. Webb, *The Law of Trade Dress Infringement: A Survey of Recent Developments*, COMPUTER LAW, Sept. 1991, at 11 (noting tremendous increase in number of trade dress infringement cases in recent years).

65. 505 U.S. 763 (1992).

66. See *id.*

67. See *id.* at 769.

68. See Horta, *supra* note 35, at 113.

69. See, e.g., *Seabrook Foods, Inc. v. Bar-Well Foods, Ltd.*, 568 F. 2d. 1342 (C.C.P.A. 1977) (holding that the design was not the primary means of identification such that, with no secondary meaning, likelihood that the mark would be confused with opposers mark was not established); *AmBrit, Inc. v. Kraft, Inc.*, 812 F.2d 1531 (11th Cir. 1986) (holding that plaintiff's trade dress was inherently distinctive, so that secondary meaning issue did not need to be addressed); *Chevron Chem. Co. v. Voluntary Purchasing Groups*, 659 F.2d 695 (5th Cir. 1981) (holding that with a showing of likelihood of

categorically abandoned secondary meaning requirements for inherently distinctive trade dress.<sup>70</sup>

Specifically, *Two Pesos* held that if trade dress is inherently distinctive under the Lanham Act, secondary meaning need not be proven.<sup>71</sup> Unfortunately, while the court afforded protection to inherently distinctive trade dress, it did not specify exactly what constituted “inherent distinctiveness.”<sup>72</sup>

The effects of the *Two Pesos* decision extend beyond a \$3.7 million judgment and a court order to renovate the rooflines and color schemes of Two Pesos’ restaurant decor.<sup>73</sup> While the Supreme Court effectively resolved the long-standing dispute among the Courts of Appeals<sup>74</sup> and sent a clear message that trade dress protection would not depend on a showing of secondary meaning,<sup>75</sup> the Court left the door open for creative interpretations of inherent distinctiveness.<sup>76</sup> As *Two Pesos* did not include guidelines or criteria for determining what combination of elements qualified as being “inherently distinctive,” the Supreme Court effectively left circuit courts to fashion definitions of their own.<sup>77</sup>

One consequence of *Two Pesos* is the assortment of current tests, inconsistently applied, to determine “inherent distinctiveness” in trade dress litigation.<sup>78</sup> The existence of multiple tests has yielded a variety of results.<sup>79</sup> Commentators have found that the

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confusion secondary meaning is not required), *cert. denied*, 457 U.S. 1126 (1982).

70. *See, e.g.*, *Paddington Corp. v. Attiki Importers & Distribs.*, 996 F.2d 577 (2d Cir. 1992) (finding that a determination of inherently distinctive did not require proof of secondary meaning).

71. *Two Pesos*, 505 U.S. at 771, 775.

72. *Id.* at 776.

73. *See* Dillon, *supra* note 60.

74. In *Two Pesos*, the Supreme Court overruled the Second Circuit, and upheld the Fifth, Seventh and Eleventh Circuits’ rule regarding the necessity of showing secondary meaning when trade dress is inherently distinctive. *See Two Pesos*, 505 U.S. at 772; discussion *infra* Part I.F.

75. *See* Newberg, *supra* note 19, at 310.

76. *See* Chapman, *supra* note 49.

77. The *Two Pesos* opinion did not set parameters for determining inherent distinctiveness, resulting in controversy among circuit courts as to whether stricter standards should be applied to evaluate protectability for product configurations (shape of actual product) as compared with overall packaging appearance. *See* Kane, *supra* note 40.

78. *See infra* Part II (discussing tests).

79. *See infra* Part II (exploring the various results of different tests). *See generally*

existence of so many disparate tests and approaches to determining inherent distinctiveness in trade dress can harm new businesses as well as established products, and can prescribe rather than prohibit confusion and unfair competition.<sup>80</sup> In fact, a manufacturer's trade dress rights could be helped or harmed based solely on the lawsuit's jurisdiction.<sup>81</sup> The need for a canonical "test" is mandated, and is crucial to resolving what has been called one of the "most difficult issues in all of trade dress law."<sup>82</sup>

This Note argues that courts apply too many inconsistent tests to ascertain whether trade dress is inherently distinctive, producing results that vary widely from circuit to circuit. Part I outlines the relationship between trade dress and trademark, then analyzes the Supreme Court's decision in *Two Pesos*, which designated *either* inherent distinctiveness *or* secondary meaning as the core of trade dress protection. Part II examines the aftermath of *Two Pesos*, including the various circuit court definitions and tests for inherent distinctiveness—a concept not precisely defined by the Supreme Court. Part III proposes a universal test to identify inherent distinctiveness in trade dress. This Note concludes that such a clear and uniform test is needed to end the circuit-to-circuit inconsistencies in determining inherent distinctiveness in trade dress.

## I. TRADEMARK AND TRADE DRESS PROTECTION

In *Two Pesos*, the Court held that trade dress is "distinctive" if it is either "inherently distinctive" or has acquired "secondary meaning."<sup>83</sup> While secondary meaning was clearly defined by the court, inherent distinctiveness was not.<sup>84</sup> This part surveys trademark and trade dress protection, and the applicable law that governs both. Sections A, B, and C analyze the facets of inherent distinctiveness in the trademark and trade dress arenas. Section D

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Chapman, *supra* note 49.

80. See Stewart & Huget, *supra* note 43; see also *Two Pesos*, 505 U.S. at 772; Newberg, *supra* note 19.

81. See *Krueger Int'l, Inc. v. Nightingale Inc.*, 915 F. Supp. 595, 601 (S.D.N.Y. 1996) (discussing various circuit court tests for inherent distinctiveness, and the results); see also Stewart & Huget, *supra* note 43.

82. *Krueger*, 915 F. Supp. at 600.

83. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 776 (1992).

84. See *id.*

examines section 43(a) of the Lanham Act, which regulates both trademark and trade dress infringement cases. Section E explains the basic principle of “distinctiveness” in trade dress, and distinguishes the notions of “inherent distinctiveness” and “secondary meaning.” Section F reviews the Supreme Court’s treatment of “inherent distinctiveness” in the 1992 *Two Pesos* decision.

#### A. *Trademark Classifications: The Abercrombie & Fitch Spectrum*

Fundamentally, trade dress and trademarks are related concepts; both involve a product or service’s overall image.<sup>85</sup> Nonetheless, as this section explains, the two concepts focus on different aspects of that image. This section explores how trademarks differ from trade dress.

A trademark is a word, name, or symbol that identifies a particular good or service.<sup>86</sup> Well-known trademarks include the word Xerox for a brand of photocopy machines,<sup>87</sup> the name Kleenex for a brand of tissues,<sup>88</sup> and the circular hood ornament used on all Mercedes Benz automobiles.<sup>89</sup>

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85. *Id.* at 768.

86. 15 U.S.C. § 1127 (1994).

87. See Diane Kiesel, *Protecting a Good Name is a Never-Ending Fight*, 71-Mar A.B.A.J. 62 (1985). Kiesel wrote that:

When thirsty restaurant patrons want a cola, they’ll sometimes ask their waiter for a Coke. When a man nicks his face with a razor, he’ll fumble through the medicine cabinet and, chances are, he’ll mutter, “Where are the Band-Aids?” rather than “Oh, for an adhesive bandage!” When the boss wants copies of a report, chances are, he or she will say, “Give me ten Xeroxes,” instead of “Make ten photocopies.”

*Id.* at 62.

88. Words like Xerox and Kleenex came close to losing their trademark status because such a large section of the general public started calling all copy machines “Xerox machines” and referring to all types of tissue as “Kleenex.” Both companies work hard to police the usage of their trademarks and to preserve their trademark status. One strategy is making sure that the word Xerox is never used alone, thus coming to represent the generic item that is a photocopy machine. Every advertisement for Xerox states the trademark name next to the item: “Xerox brand office machines. Likewise, “Kleenex” is the coined trademark and “tissues” is the generic term for the product. See *id.* at 62.

89. See Baila H. Celedonia, *Review of Basic Principles of Trademark Law*, 432 PLI/PAT. 7 (1996); see also *Mozart Co. v. Mercedes Benz of North Am., Inc.*, 833 F.2d 1342, 1346 (9th Cir. 1987). Other trademarks commonly used as generic names for products include: Baggies plastic bags, Fiberglas glass fibers, Jeep vehicles, Jell-O gela-

The formula for determining inherent distinctiveness in a trademark is devoid of mystery.<sup>90</sup> Judge Friendly outlined the now classic test for determining a trademark's distinctiveness in the well-known case *Abercrombie & Fitch v. Hunting World*.<sup>91</sup> Under the *Abercrombie* test, trademarks are classified as (1) generic, for marks that tell what the product is, not where it came from; for example, aspirin<sup>92</sup> or thermos;<sup>93</sup> (2) descriptive, for marks that merely describe the product; for example, "Lite" for lower-calorie beer;<sup>94</sup> (3) suggestive, for marks that denote a quality or trait of the product in a way that requires the exercise of some degree of imagination; for example, Coppertone suntan lotion<sup>95</sup> or Chicken of the Sea tuna fish;<sup>96</sup> (4) arbitrary, where a common word is used

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tin dessert, Q-tips cotton swabs, Saran Wrap plastic film, Sheetrock gypsum wallboard, Styrofoam plastic foam, and Vaseline petroleum jelly. See Kiesel, *supra* note 87, at 63.

90. See 15 U.S.C. § 1125; see also *Abercrombie & Fitch v. Hunting World*, 537 F.2d 4, 9 (2d Cir. 1976).

91. 537 F.2d 4 (2d Cir. 1976).

92. See *Bayer Co. v. United Drug Co.*, 272 F. 505 (S.D.N.Y. 1921) (holding that a generic trademark has lost its connection with a particular source, and is identified by the public as the genus or class of which the individual product or service is a member); see also *Bristol-Myers Co. v. R.H. Macy & Co.*, 151 F. Supp. 513 (S.D.N.Y. 1957) (finding infringement of "Bufferin" trademark when a department store labeled its product "Buffered Aspirin," but advertised it as "Bufferin," thus tending to render the "Bufferin" trademark generic and descriptive).

93. See *King-Seeley Thermos Co. v. Aladdin Indus., Inc.*, 321 F.2d 577 (2d Cir. 1963) (holding that "Thermos" became generic when a substantial majority of the public did not know that word had trademark significance); see also *Coca-Cola Co. v. Overland, Inc.*, 692 F.2d 1250 (9th Cir. 1982) (holding the federally registered trademark "Coke" has not become generic for cola).

94. See *Miller Brewing Co. v. G. Heileman Brewing Co.*, 561 F.2d 75 (7th Cir. 1977) (holding that "'light' is a common descriptive word when used with beer, as well as in other similar contexts, and neither such word nor its phonetic equivalent, for example the misspelled version "lite," could be appropriated as a trademark for beer"), *cert. denied*, 434 U.S. 1025 (1978).

95. See *Douglas Lab. Corp. v. Copper Tan, Inc.*, 210 F.2d 453 (2d Cir.) (holding that "Coppertone" for suntan lotion was suggestive, not descriptive, and was eligible for trademark protection), *cert. denied*, 347 U.S. 968 (1954). The *Douglas Lab.* court clarified that suggestive trademarks are inherently distinctive, and are afforded the greatest protection because their intrinsic nature serves to identify the particular source of the product. *Id.*

96. See *Van Camp Sea Food Co., Inc. v. Alexander B. Stewart Orgs.*, 50 F.2d 976, 979 (C.C.P.A. 1931) (holding that "Chicken of the Sea" as a trademark for use on canned tuna fish is not descriptive, but suggestive, and newcomer trademark applicant cannot register the term "White Chicken" for use on canned tuna fish because "White Chicken"

outside its normal context in a mark; for example, Camel cigarettes<sup>97</sup> or Ivory soap,<sup>98</sup> or (5) fanciful, where a word or symbol is invented for use as a trademark; for example, Exxon gasoline<sup>99</sup> or Kodak film.<sup>100</sup>

As a rule, suggestive, arbitrary, and fanciful marks are always considered to be inherently distinctive,<sup>101</sup> and thus, always qualify for statutory protection. The rationale is that suggestive, arbitrary,

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is merely descriptive, and is confusingly similar to "Chicken of the Sea.").

97. See *Hallmark Cards, Inc. v. Hallmark Dodge, Inc.*, 634 F. Supp. 990, 998 (W.D. Mo. 1986) (stating that "Camel" for cigarettes is arbitrary in that "[it is] found in the dictionary but [does] not describe or suggest the [product] to which [it] is related"). An arbitrary mark consists of a word, symbol or picture which has a commonly understood meaning, but which, when used in conjunction with particular types of goods or services, does not suggest or describe any aspect, quality or characteristic of those goods or services. See MCCARTHY, TRADEMARKS, *supra* note 11, § 11:4, at 350; see, e.g., *Arrow Distilleries, Inc. v. Globe Brewing Co.*, 117 F.2d 347 (4th Cir. 1941) (holding that "Arrow" liquors is a highly protectable, arbitrary, and fanciful mark); *Greyhound Corp. v. Rothman*, 84 F. Supp. 233 (D. Md.) (holding that "Greyhound" is a highly protectable, arbitrary, and fanciful mark for a bus line), *aff'd*, 175 F.2d 893 (1949).

98. See *A.J. Canfield Co. v. Vess Beverages, Inc.*, 796 F.2d 903 (7th Cir. 1986) (preventing unfair competition by prohibiting Vess from using the term "chocolate fudge" on its diet chocolate soda cans). The court used Ivory soap as an example of an arbitrary term for soap versus products made from ivory elephant tusks. *Id.* at 906.

99. See *Exxon Corp. v. Xoil Energy Resources, Inc.*, 552 F. Supp. 1008 (S.D.N.Y. 1981) (finding that Exxon was an "invented" word, had become a household name, and was subject to the broadest trademark protection). The court also found that there was no likelihood of confusion between Xoil and Exxon, because they begin with different letters of the alphabet and were not similar as trademarks. *Id.*

100. See *Eastman Kodak Co. v. Rakow*, 739 F. Supp. 116 (W.D.N.Y. 1989) (enjoining a comedian from using the stage name "Kodak," as it would dilute Eastman Kodak's very strong, fanciful trademark name, and might suggest some sort of sponsorship or partnership between the two parties). The term fanciful as a classifying concept in trademark law is usually applied to words or concepts invented solely for their use as trademarks. See MCCARTHY, TRADEMARKS, *supra* note 11, § 11:3, at 347; see, e.g., *Northam Warren Corp. v. Universal Cosmetic Co.*, 18 F.2d 774 (7th Cir. 1927) (holding that "Cutex" cuticle-removing liquid is a protectable, fanciful mark); *Clorox Chem. Co. v. Chlorit Mfg. Corp.*, 25 F. Supp. 702 (E.D.N.Y. 1938) (holding that "Clorox" bleach is a fanciful mark).

101. Suggestive, arbitrary, and fanciful marks are considered inherently distinctive, in that their "intrinsic nature serves to identify a particular source of a product" or they are "capable of identifying a particular source of a product," whether or not the trade dress has acquired secondary meaning or a wide public association with the source. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 767 (1992) (citing *Abercrombie*, 537 F.2d at 4); *Park 'N Fly, Inc. v. Dollar Park and Fly, Inc.*, 469 U.S. 189, 184 (1985) (citing *Abercrombie*, 537 F.2d at 9).

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and fanciful marks are unique marks by definition.<sup>102</sup> If a mark is descriptive, however, it is not deemed inherently distinctive.<sup>103</sup> The only way a descriptive mark can receive protection is when the plaintiff can establish that the mark has acquired secondary meaning.<sup>104</sup> Thus, for a court to find a descriptive mark to be distinctive, the plaintiff must prove that consumers associate the trademark specifically with the plaintiff's product.<sup>105</sup> For example, buyers associate the Nike "swoosh" with Nike athletic gear, even if the word "Nike" does not appear with the swoosh.<sup>106</sup>

Inexorably, generic marks, the final category, are never protectable, due to their widespread, every-day placement in the English language, and because they are incapable of identifying a particular source of a product.<sup>107</sup> For example, Visa challenged American Express by asserting that a "platinum card," is a generic term.<sup>108</sup> Visa argued that the phrase "platinum card," like "gold card," is available for use by the world at large, and should not be protected as a distinctive American Express trademark.<sup>109</sup> Visa successfully maintained, in an out of court settlement, that American Express should not be the only credit card company allowed to legally offer a "platinum card" level of service bearing that name.<sup>110</sup>

The application of the *Abercrombie & Fitch* spectrum<sup>111</sup> re-

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102. See *Abercrombie*, 537 F.2d at 4.

103. See *id.*

104. In order for a descriptive mark to become distinctive, a plaintiff must prove secondary meaning, which is consumers' association between the mark and its source that has developed over time. See *id.* at 9.

105. See *id.*; see also *Paddington Corp. v. Attiki Importers & Distrib., Inc.*, 996 F.2d 577, 583 (2d Cir. 1993) (discussing the *Abercrombie* test for classification of trademarks).

106. See *Nike, Inc. v. "Just Did It" Enter.*, 799 F. Supp. 894 (N.D. Ill. 1992) (holding Nike had been granted trademark protection from non-parody reproduction of Swoosh stripe), *rev'd on other grounds*, 6 F.3d 1225 (7th Cir. 1993).

107. *Two Pesos Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768-69 (1992).

108. *American Express Is Sued by Visa USA Over Platinum Cards*, WALL ST. J., Oct. 18, 1996, at B2.

109. In the past, American Express also lost rights to the generic term "gold card." *Id.*

110. *Legal Affairs: The Card Industry Settles Its Platinum Feud*, CREDIT CARD NEWS, Aug. 15, 1997, at 1.

111. See *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir.



cently led to victory for the makers of L'eggs pantyhose. In *Sara Lee v. Kayser-Roth Corp.*,<sup>112</sup> the Fourth Circuit protected the trademark "L'eggs" as applied to pantyhose, preventing Kayser-Roth from using the name "Leg Looks" for their brand of pantyhose.<sup>113</sup> The Fourth Circuit found the name "L'eggs" to be suggestive, and therefore entitled to protection, as it imaginatively suggested a trait of the product.<sup>114</sup> The court noted that "although the mark ['L'eggs'] may not be wholly fanciful (because it is phonetically identical to a common word) or arbitrary (because it is not actually a 'real' word), it is unquestionably suggestive, and therefore a strong, distinctive mark."<sup>115</sup> Thus, Kayser-Roth was estopped from using "Leg" as the first word of their product's name because the "L'eggs" trademark was found to be so strong and inherently distinctive based on the *Abercrombie* classification system.<sup>116</sup>

### B. Trade Dress

Trade dress is the packaging and product design that makes up the overall look of a product or service.<sup>117</sup> For example, Klondike Ice Cream Bars are square in shape, and wrapped in pebble-textured silver foil, and feature a picture of a navy blue polar bear and a shining sun.<sup>118</sup> These arbitrary aspects, taken as a whole, make up Klondike's trade dress.<sup>119</sup> This section discusses trade dress and what makes it inherently distinctive.

The distinctiveness of Klondike's trade dress was litigated in

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1976).

112. 81 F.3d 455 (4th Cir. 1996).

113. *Id.*

114. *Id.* at 465.

115. *Id.*

116. *Id.*

117. See Newberg, *supra* note 19, at 307; *LeSportsac, Inc. v. K Mart Corp.*, 754 F.2d 71, 75 (2d Cir. 1985) (citing *John H. Harland Co. v. Clarke Checks, Inc.*, 711 F.2d 966, 980 (11th Cir. 1983)); see also *Vaughan Mfg. Co., v. Brikam Int'l, Inc.* 814 F.2d 346, 348 n.2 (7th Cir. 1987).

118. See *AmBrit Inc., v. Kraft, Inc.*, 812 F.2d 1531 (11th Cir. 1986), *cert. denied*, 481 U.S. 1041 (1987).

119. See *id.* Klondike's choices comprise arbitrary and unique ice cream marketing techniques. See *id.* at 1531. Klondike chose silver foil, the square, non-wooden stick shape of the bar, and the graphics on the packaging without regard for the content of the product to be sold. See *id.*

*AmBrit v. Kraft*.<sup>120</sup> The court evaluated Klondike's packaging along three lines of inquiry: (1) whether Klondike's shape or design was common; (2) whether Klondike's shape or design was unique in the ice cream bar field; and (3) whether Klondike's shape or design was merely a refinement of an already well-known form of ornamentation for ice cream goods.<sup>121</sup> The court answered each of these questions in the negative, and held that the Klondike bar was inherently distinctive and thus worthy of trade dress protection.<sup>122</sup>

The court stated that animals, specifically polar bears, had no natural association with ice cream, and were chosen arbitrarily to signify Klondike ice cream bars.<sup>123</sup> In addition, the court noted that ice cream bars were typically wrapped in paper or cellophane, and Klondike's decision to use foil was a creative choice not previously seen in the ice cream market.<sup>124</sup> Similarly, Klondike's decision to utilize a silver foil wrapper, despite the wide range of available colors, was unique.<sup>125</sup> Klondike's preference for foil with a pebbled rather than a smooth texture, and without designs such as snowflakes to enhance the wrapper, was also innovative and particular to Klondike ice cream bars.<sup>126</sup>

The *AmBrit* court noted that another ice cream bar manufacturer could certainly manufacture square ice cream bars, and even use a polar bear picture on the packaging, but could not copy the total combination of Klondike's shape and package elements.<sup>127</sup> Otherwise, consumers might reach for a package of Klondikes, but

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120. 812 F.2d 1531 (11th Cir. 1986), *cert. denied*, 481 U.S. 1041 (1987).

121. *See id.* at 1536 (citing *Brooks Shoe Mfg. Co. v. Suave Shoe Corp.*, 716 F.2d 854 (11th Cir. 1983) (quoting *Seabrook Foods, Inc. v. BarWell Foods Ltd.*, 568 F.2d 1342, 1344 (C.C.P.A. 1977))).

122. *See id.* at 1536-37.

123. *See id.* at 1536-37.

124. *See id.*

125. *See id.*

126. *See id.*

127. *Id.*; *see also* *Seabrook Foods, Inc. v. Bar-Well Foods, Ltd.*, 568 F.2d 1342, 1344 (C.C.P.A. 1977) (discussing that a frozen vegetable package can potentially be inherently distinctive); *Krueger Int'l, Inc. v. Nightingale, Inc.*, 915 F. Supp. 595 (2d Cir. 1996) (holding that a chair's overall look and design can be inherently distinctive); *Stuart Hall Co., Inc. v. Ampad Corp.*, 51 F.3d 780 (8th Cir. 1995) (holding that a notepad's design can be inherently distinctive).

end up with another brand of ice cream bars that are not of the same quality, nor are what the consumer really intended to purchase.<sup>128</sup> Klondike put a great deal of thought, marketing, strategy, and money into not only maintaining the quality of their ice cream bars, but in making sure that when consumers reach for the silver polar bear packaging, they get what they pay for, instead of a fraudulent or “copycat” product.<sup>129</sup> Trade dress law, therefore, functions to protect both Klondike from loss of sales, and consumers from confusion.<sup>130</sup>

When evaluating the Klondike trade dress, the *AmBrit* court, like most trade dress courts, did not look at each design element in a vacuum.<sup>131</sup> If one element of Klondike’s trade dress was found to be common, it would not necessarily have resulted in Klondike’s trade dress being denied “inherently distinctive” status.<sup>132</sup> The court evaluated each element of Klondike’s trade dress, and subjected the *total combination* of these elements to the court’s three-pronged test.<sup>133</sup> The court thus ultimately held that Klondike’s trade dress was “inherently distinctive” because its packaging comprised random elements which were unique to the ice cream market.<sup>134</sup>

Importantly, the court recognized that consumers’ impressions are a completely separate issue from determining whether the actual product is distinctive within its specific market niche.<sup>135</sup> In reaching its decision, the court did not consider how consumers

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128. See 15 U.S.C. § 1125(a) (1994) (seeking to protect consumers from confusion and manufacturers from unfair competition).

129. See *AmBrit*, 812 F.2d at 1547-49.

130. *Id.* at 1535-36.

131. See *id.* at 1537; see also *Krueger Int’l, Inc. v. Nightingale, Inc.*, 915 F. Supp. 595, 603 (S.D.N.Y. 1996) (discussing numerous prior trade dress cases, and federal circuit courts’ proclivity to evaluate trade dress as a whole, rather than examining each individual component of trade dress in and of itself).

132. See *AmBrit*, 812 F.2d at 1537; see also *Kompan, A.S. v. Park Structures, Inc.*, 890 F. Supp. 1167, 1173-74 (N.D.N.Y. 1995) (holding overall look of playground equipment can be inherently distinctive, even if individual trade dress elements are common when examined individually).

133. See *AmBrit*, 812 F.2d at 1537.

134. See *id.*

135. *Id.*; see also *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992).

viewed Klondike's trade dress,<sup>136</sup> or their reactions to Klondike's foil and polar bear packaging, nor did it attempt to ascertain whether the average consumer thought that Klondike's packaging was striking or memorable.<sup>137</sup> Instead, the court focused on the choices Klondike made when designing its packaging, and compared those choices to similar products in Klondike's specific market.<sup>138</sup> This type of analysis purposely narrowed the court's investigation to distinguishing whether the product shape and packaging was distinctive in the product's market, and intentionally avoided a determination of whether consumers considered the packaging to be unique.<sup>139</sup>

The problem that plagues trade dress attorneys is that the three pronged *Klondike* test is by no means the national standard for determining inherent distinctiveness in trade dress litigation.<sup>140</sup> In fact, since no universal, archetypal test exists, there are multiple versions of two, three, and four pronged tests being applied all over the country.<sup>141</sup> Courts continuously fashion new tests based on subjective interpretations of what is "inherently distinctive."<sup>142</sup> In addition to the *Klondike* test,<sup>143</sup> other accepted tests include: the *Krueger* chair test,<sup>144</sup> the *Duraco* plastic container test,<sup>145</sup> the *Knitwaves* sweater test,<sup>146</sup> the *Seabrook* frozen vegetables test,<sup>147</sup> and the *Chevron* gardening and lawn bottles test.<sup>148</sup> These various

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136. *AmBrit*, 812 F.2d at 1537; see also McLean, *supra* note 6.

137. See *AmBrit*, 812 F.2d at 1537.

138. *Id.* at 1540.

139. *Id.* at 1541.

140. See *infra* Part II (discussing an assortment of tests currently employed by various courts).

141. See Chapman, *supra* note 49.

142. See *infra* Part II (discussing cases); see also *Kreuger Int'l, Inc. v. Nightingale, Inc.*, 915 F. Supp. 595 (2d Cir. 1996) (listing and explaining the variety of differing "inherent distinctiveness" tests used by courts across the nation).

143. See *AmBrit*, 812 F.2d at 1531.

144. See *Krueger Int'l, Inc. v. Nightingale, Inc.*, 915 F. Supp. 595 (2d Cir. 1996).

145. See *Duraco Prods., Inc. v. Joy Plastic Enters., Ltd.*, 40 F.3d 1431 (3d Cir. 1994).

146. See *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996 (2d Cir. 1995).

147. See *Seabrook Foods, Inc. v. Bar-Well Foods, Ltd.*, 568 F.2d 1342 (C.C.P.A. 1977).

148. See *Chevron Chem. Co. v. Voluntary Purchasing Groups*, 659 F.2d 695, 700 (5th Cir. 1981), *cert. denied*, 457 U.S. 1126 (1982).

trade dress tests are not uniform.<sup>149</sup> Commentators have argued that this confusion occurs because both the Lanham Act and Supreme Court have unequivocally defined the concept of “distinctiveness,” while no binding authority has defined the meaning of *inherent* distinctiveness.<sup>150</sup> Courts therefore create their own recipes for determining what makes a feature “inherently” distinctive, and resulting definitions vary from courtroom to courtroom.<sup>151</sup> Problematically, each test relies on different factors to determine inherent distinctiveness in trade dress, even though the Lanham Act does not protect designs on sweaters any differently than it protects designs on frozen vegetable packaging.<sup>152</sup>

### C. *The Synthesis of Trademark and Trade Dress*

This section states the conclusive test for determining inherent distinctiveness in a trademark, and contrasts this clear formula with the uncertain approach for determining the same issue in trade dress.

The criteria for establishing inherent distinctiveness in trade dress are murky and unresolved.<sup>153</sup> As many courts have observed, the *Abercrombie* classifications do not translate easily to certain aspects of the trade dress context.<sup>154</sup> For example, the *Abercrombie* trademark test is easily applied when the trade dress involves product packages and labels, which, like trademarks, have the advantage of using words and symbols independent of the product to

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149. See *infra* Part II (discussing cases); see also Chapman, *supra* note 49.

150. See Chapman, *supra* note 49, at n.10; Dillon, *supra* note 60; Gliberman, *supra* note 40; Johnson, *supra* note 41, at 286; Newberg, *supra* note 19; see also 15 U.S.C. § 1125(a) (1994); *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992).

151. See *infra* Part II (discussing varying approaches courts take to determine inherent distinctiveness in trade dress); see also Chapman, *supra* note 49.

152. See 15 U.S.C. § 1125(a) (1994).

153. “This issue of inherent distinctiveness is a real snake’s nest. When it comes to a word, you can pretty easily tell. . . . But try to apply that same kind of analysis to neon lights or vinyl seating in a restaurant. Where do you go here? Is a light inherently distinctive?” Orenstein, *supra* note 40, at 1 (“[W]e have no guidance on what inherently distinctive means, and there are going to be a lot of optimistic people filing cases to help us define it.”).

154. See *Krueger, Int’l, Inc. v. Nightingale Inc.*, 915 F. Supp. 595, 601 (S.D.N.Y. 1996).

convey information to consumers.<sup>155</sup>

Applying the *Abercrombie* trademark test, however, becomes daunting when it comes to product designs, as illustrated by the conflict in *Krueger International, Inc. v. Nightingale, Inc.*<sup>156</sup> In *Krueger*, the court found the design and overall look of a Krueger's chair to be inherently distinctive, and prevented Nightingale from making and marketing an exact copy of the Krueger chair.<sup>157</sup> The court was faced with the *Abercrombie* conundrum: Does the shape of a chair seat "suggest" a chair seat? Does it "describe" a chair seat? Or is it just a chair seat?<sup>158</sup> Can an industrial product, such as a chair seat, no matter how beautifully designed, transcend its common properties and be "arbitrary," "fanciful," or "suggestive" of the chair seat maker?

This dilemma of applying the very literal, word-centered trademark law to the more visual aspects of trade dress law has led some courts to treat trade dress issues differently, depending upon the type of trade dress involved.<sup>159</sup> In fact, a split has developed whereby some courts apply *Abercrombie*'s "arbitrary, fanciful or suggestive" trademark test only to trade dress issues involving a product's *package* and the design of the package.<sup>160</sup> These courts assert that they cannot properly apply the *Abercrombie* test to trade dress cases that focus on a product's *shape* or configuration.<sup>161</sup> Yet, other courts make no distinction between product configuration and product packaging, and attempt to apply *Abercrombie*'s classification system to both.<sup>162</sup>

Unlike packaging, a product's configuration is the product it-

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155. See, e.g., *Paddington Corp. v. Attiki Importers & Distribs.*, 996 F.2d 577, 583-84 (2d Cir. 1992) (holding No. 12 Ouzo label and bottle to be inherently distinctive).

156. 915 F. Supp. 595, 601 (S.D.N.Y. 1996).

157. *Id.*

158. *Id.* at 601.

159. See *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996 (2d Cir. 1995); *Duraco Prods., Inc. v. Joy Plastic Enters., Ltd.*, 40 F.3d 1431 (3d Cir. 1994).

160. See *Knitwaves, Inc.*, 71 F.3d 996 (2d Cir. 1995); *Duraco Prods., Inc.*, 40 F.3d 1431 (3d Cir. 1994).

161. See *Knitwaves, Inc.*, 71 F.3d 996 (2d Cir. 1995); *Duraco Prods., Inc.*, 40 F.3d 1431 (3d Cir. 1994); see also Reese, *supra* note 36.

162. See, e.g., *Krueger*, 915 F. Supp. at 595 (citing numerous cases that applied the *Abercrombie* classification system to product configuration and product packaging alike).

self, as opposed to what it is wrapped in. Some courts allege that since the product itself is on the line, it deserves special consideration, regardless of where it falls on the *Abercrombie* spectrum.<sup>163</sup> Therefore, while it is well settled that trademark law generally governs trade dress law, there is controversy over (1) whether to divide trade dress law into two distinct camps, namely, package design and product configuration, and (2) trademark law's role in determining inherent distinctiveness in product configuration cases.<sup>164</sup>

#### D. Statutory Protection for Infringement

Although there are some conceptual differences between trademarks and trade dress, the Lanham Act statute<sup>165</sup> makes no distinction between the two, and broadly governs both trademark and trade dress infringement actions.<sup>166</sup> This section explores the underlying premise of the Lanham Act, and what it seeks to protect.

Section 43(a) of the Lanham Act does not draw a distinction between trademarks and trade dress.<sup>167</sup> The Lanham Act's purpose is to secure to a mark's owner his business' reputation, and to protect a consumer's ability to distinguish among competing products.<sup>168</sup> The statute thus fosters the producer's interest in maintain-

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163. *Id.*

164. See *Knitwaves*, 71 F.3d 996; *Duraco*, 40 F.3d 1431; Roslyn S. Harrison, *Trade Dress Law in the U.S., Western Europe, and Pacific Rim Countries*, 488 PLI/PAT. 461, 468 (1997).

165. 15 U.S.C. § 1125(a) (1994).

166. See *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992) (holding that trade dress which is inherently distinctive is protectable under the Lanham Act without showing that it has acquired secondary meaning).

167. See *id.* at 770.

168. See 15 U.S.C. § 1125(a) (1994). The statute provides that:

Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any work, 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 . . . shall be liable in a civil action by any person who believes that he or she is likely to be damaged by

ing his product's quality by imputing the producer with the benefits of his product's good reputation.<sup>169</sup> The statute simultaneously protects a consumer's ability to distinguish among competing producers, by preventing valid trademarks or trade dress from being copied.<sup>170</sup>

### 1. Infringement

While trademark infringement focuses on one aspect of a product's "image," trade dress infringement focuses on the "total image of a plaintiff's product, package and advertising and compare[s] this with the defendant's image."<sup>171</sup> A trademark differs from a product's trade dress because it signifies a symbol that has come to represent a product.<sup>172</sup> For example, Nike's trademark swoosh symbol signifies a Nike product, even if the actual word "Nike" is not present on the product.<sup>173</sup> Trade dress is slightly more complex because it consists of a combination of symbols that, taken together, comprise a product's overall look.<sup>174</sup> For example, a tennis shoe's overall image involves the shape of the toe, the color of the shoelaces, the colors and design of the sole of the sneaker, the stitching on the sneaker's exterior, the type of holes the laces go through, and the shape, color, and texture of the total shoe. These trade dress elements, however, do not automatically represent a Nike product in the tennis shoe market the way that seeing Nike's swoosh automatically represents a Nike product, even when the

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such act.

*Id.*

169. See *id.* § 1127; see also *Park 'N Fly Inc. v. Dollar Park and Fly Inc.*, 469 U.S. 189, 198 (citing S. REP. NO. 79-1333, at 3-5) (1946) (citations omitted)).

170. See 15 U.S.C. § 1127; see also MCCARTHY, TRADEMARKS, *supra* note 11, § 2.05[4], at 2-29.

171. See MCCARTHY, TRADEMARKS, *supra* note 11, § 8:1, at 282-83 (quoted in *M. Kramer Mfg. Co., v. Andrews*, 783 F.2d 421, 448 n. 25 (4th Cir. 1986) (finding video poker game trade dress infringement)).

172. See *Reese*, *supra* note 36, at 108-09 (stating that a trademark—a word or symbol—must be capable of distinguishing a particular product or business from another); see also *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992).

173. See *Nike, Inc. v. "Just Did It" Ent.*, 799 F. Supp. 894 (N.D. Ill. 1992) (holding Nike had been granted trademark protection from non-parody reproduction of Swoosh stripe), *rev'd on other grounds*, 6 F.3d 1225 (7th Cir. 1993).

174. See *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992).



word “Nike” does not appear.<sup>175</sup>

An example of distinctive trade dress is exemplified by LeSportsac bags. In the early 1980s, LeSportsac popularized durable lightweight nylon luggage and handbags featuring unique tan trimming marked with the LeSportsac name logo.<sup>176</sup> All retailers marketing cheaper, less durable versions of this bag design were enjoined from continuing because LeSportsac’s tan trimming and design were deemed inherently distinctive trade dress.<sup>177</sup>

## 2. Litigation

In a trade dress action, like a trademark action, the fact finder must separately determine three things per the Lanham Act: (1) whether a product is distinctive, or if not, has acquired secondary meaning;<sup>178</sup> (2) whether a purchaser will likely be confused as to the source of the product;<sup>179</sup> and (3) whether the trade dress is “functional.”<sup>180</sup> The court will not even reach the question of like-

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175. See *Nike*, 799 F. Supp. at 894.

176. See *LeSportsac, Inc. v. K Mart Corp.*, 754 F.2d 71, 75 (2d Cir. 1985) (finding lightweight luggage bag inherently distinctive).

177. See *id.*

178. Secondary meaning is known as “acquired distinctiveness” and exists when the public, over time, begins to identify a product with its source. See *supra* notes 50-59 and accompanying text; *infra* Part I.E.2 (discussing secondary meaning).

179. See, e.g., *Lesportsac*, 754 F.2d at 71 (finding lightweight luggage bag inherently distinctive).

180. *Krueger Int’l, Inc. v. Nightingale Inc.*, 915 F. Supp. 595, 605 (S.D.N.Y. 1996). Trade dress is deemed “functional” if the shape of the product, or the product’s packaging is dictated by the functions it performs. *Id.* at 605. The court in *Krueger* relied on standards set forth in *AmBrit*, discussed *infra* Part II.B.2, and *Seabrook*, discussed *infra* Part II.B.1. If trade dress is functional, no amount of secondary meaning or consumer confusion will turn the design into a trademark. See E. Lynn Perry, *The Supreme Court Gives Two Pesos’ Worth - Trade Dress and the Franchise Trademark Portfolio*, 12 FALL FRANCHISE L.J. 35, 40 (1992); see also *Bloomfield Indus., Div. of Specialty Equip. Cos., Inc. v. Stewart Sandwiches, Inc.*, 716 F. Supp. 380, 385 (N.D. Ind. 1989) (denying summary judgment in coffee maker trade dress case). In *Bloomfield*, the court relied on standards set forth in *AmBrit* and *Seabrook*, as well as *Chevron*, discussed *infra* Part II.B.3. The focus of this Note is to analyze the standards used to determine inherent distinctiveness in trade dress, not to discuss consumer confusion and trade dress functionality. Specifically, Part I.E distinguishes between the concepts of inherent distinctiveness and secondary meaning. Part II examines differing circuit court “tests” used to ascertain inherent distinctiveness in trade dress. The standards considered include whether trade dress is intended as source identification, see *Knitwaves Inc. v. Lollytogs Ltd.*, 71 F.3d 996 (2d Cir. 1995), whether trade dress is arbitrary, fanciful or suggestive in relation to the prod-

likelihood of confusion in the marketplace until persuaded that the putative mark or dress is sufficiently distinctive to warrant prima facie protection.<sup>181</sup> Thus, a finding of distinctiveness under the Lanham Act protects the public from experiencing confusion, mistake, and deception in the purchase of goods and services, while simultaneously protecting the integrity of the trademark owner's product identity.<sup>182</sup>

The Lanham Act's criteria are not easily satisfied, as evidenced in *Blau Plumbing Inc. v. S.O.S. Fix-It, Inc.*<sup>183</sup> In *Blau Plumbing*, a special city map in Blau Plumbing's yellow pages advertisement was not subject to either trade dress or trademark protection, and the company's competitor, S.O.S. Fix-It, was permitted to use a similar map in their advertising even though it was admittedly copied from *Blau Plumbing*.<sup>184</sup> The court stated that the Blau Plumbing map was simply the company's way of saying "We serve all of Milwaukee"—which is a descriptive slogan, thus not distinctive enough to qualify for either trademark or trade dress protection.<sup>185</sup> Importantly, the court stated that "[i]t would not do to give Blau

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uct, see *Stuart Hall Co. v. Ampad Corp.*, 51 F.3d 780 (8th Cir. 1995), whether a product has a unique overall look, see *Kreuger Int'l, Inc. v. Nightingale Inc.*, 915 F. Supp. 595 (S.D.N.Y. 1996), whether the trade dress is unusual and a memorable source identifier, see *Duraco Prods., Inc. v. Joy Plastic Enters., Ltd.*, 40 F.3d 1431 (3rd Cir. 1994), whether a product's look is unique in a particular market, see *Seabrook Foods, Inc. v. Bar-Well Foods, Ltd.*, 568 F.2d 1342 (C.C.P.A. 1977), functionality, see *Chevron Chem. Co. v. Voluntary Purchasing Groups, Inc.*, 659 F.2d 695 (5th Cir. 1981), *cert. denied*, 457 U.S. 1126 (1982), and whether the product's combination of trade dress elements is unique in a particular field, see *Paddington Corp. v. Attiki Importers & Distribs., Inc.*, 996 F.2d 577 (2d Cir. 1993).

181. See *Blau Plumbing Inc. v. S.O.S. Fix-It*, 781 F.2d 604, 608 (7th Cir. 1986).

182. See *Park 'N Fly, Inc. v. Dollar Park and Fly*, 469 U.S. 189, 198 (1985) (stating that an airplane logo can be an incontestable trademark and that "the Lanham Act provides national protection of trademarks in order to secure to the owner of the mark the goodwill of his business, and to protect the ability of consumers to distinguish among competitors").

183. 781 F.2d 604, 608 (7th Cir. 1986) (holding that a drain cleaning company's yellow pages advertisement not subject to trade dress protection; secondary meaning not required if the trade dress is a distinctive, identifying mark). In *Blau Plumbing*, the court reasoned that "[t]here is probably no substantive legal difference between [the terms trade dress and trademark]." *Id.* at 608.

184. *Id.*

185. See *id.* at 609 (citing *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.3d 4, 9-11 (2d Cir. 1976)).

more protection for its . . . [advertisement] . . . conceived as 'trade dress' than it would be entitled to if the box [advertisement] were called a common law trademark."<sup>186</sup>

Thus, although one company made an exact copy of a competing company's advertisement, and was potentially defrauding consumers while stealing the competing company's sales, the copying was permissible because the original advertisement was not found to be distinctive enough to warrant protection from "copycats."<sup>187</sup>

#### E. *Distinctiveness*

Both the Supreme Court and section 43(a) of the Lanham Act specify that trade dress must be distinctive in order to receive protection from infringement.<sup>188</sup> "Distinctiveness," in general, is defined as whether the appearance of the product is sufficient to "allow consumers to identify the product from the trade dress."<sup>189</sup> The general rule regarding distinctiveness in trade dress is clear: an identifying mark is distinctive and capable of being protected if it either (1) is inherently distinctive, or (2) has acquired distinctiveness through secondary meaning.<sup>190</sup> This section explains the umbrella concept of distinctiveness, and the difference between inherent distinctiveness and secondary meaning.

A finding of a product's overall distinctiveness is crucial to trade dress protection.<sup>191</sup> Distinctiveness can be proven two different ways: by determining a product's inherent distinctiveness, or

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186. *Id.* at 608.

187. *Id.* S.O.S. Fix-It's yellow pages advertisement was found to be a direct imitation of Blau Plumbing's advertising, which was not distinctive enough to warrant trade dress protection. The Seventh Circuit discussed how inconsistency, inequity, and confusion would result from treating trade dress infringement differently than trademark infringement under the Lanham Act. *See id.* In *Blau Plumbing*, Judge Posner noted that "[t]rade dress," a commonly used term in the law of unfair competition, denotes the form in which a producer presents his brand to the market . . . . If a seller adopts a trade dress confusingly similar to a competitor's, this is unfair competition actionable under section 43(a)." *Id.* at 608.

188. *See Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 763 (1992).

189. *Bauer Lamp. Co., Inc. v. Shaffer*, 941 F.2d 1165, 1170 (11th Cir. 1991) (citing *Ambrit, Inc. v. Kraft, Inc.*, 812 F.2d 1531, 1536 (11th Cir. 1986)).

190. RESTATEMENT (THIRD) OF UNFAIR COMPETITION, § 13, at 37-38, and Comment A (Tent. Draft No. 2, Mar. 23, 1990).

191. *See Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992).

determining that the product has acquired distinctiveness in the marketplace over time.<sup>192</sup> Per the Supreme Court, and the Lanham Act, the notion of uniqueness in the marketplace (inherent distinctiveness) should be kept separate from the notion of consumer recognition acquired over time (secondary meaning).<sup>193</sup>

Some courts mesh these two different ideas together, and thus confuse determining inherent distinctiveness with determining secondary meaning.<sup>194</sup> This can best be illustrated by a hypothetical example.

In certain jurisdictions, the Tide laundry detergent package could be deemed inherently distinctive because the court finds that over time, consumers have begun to associate the bright orange box, the yellow swirl, and the use of bold black letters with Proctor and Gamble's Tide laundry detergent. These jurisdictions examine not the product and its design, but consumers' perceptions regarding the product and its design. Thus, these jurisdictions actually seek to establish secondary meaning, but define this process as seeking to establish inherent distinctiveness.

In other jurisdictions, Tide laundry detergent would be denied status as inherently distinctive trade dress, because rather than focusing on consumer awareness, the court would find that the use of bright colors and bold letters is prevalent throughout the laundry detergent market, and that numerous other detergents use the same colors, box size, box shape, and bold letters, albeit in different combinations. These jurisdictions might find that Tide's package design was not unique in its particular market, thus not worthy of protection. These jurisdictions correctly examine the product and its design, in and of itself, to determine whether it is inherently distinctive.

### 1. Inherent Distinctiveness

One of the most difficult analytical issues in trade dress law is determining whether a product design is "inherently distinctive."<sup>195</sup>

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192. *See id.*

193. *See id.* (citing 15 U.S.C § 1125(a)).

194. *See id.*

195. *See* Krueger Int'l, Inc. v. Nightingale Inc., 915 F. Supp. 595, 600 (S.D.N.Y.

Trade dress is inherently distinctive if the design, shape, or combination of elements are so unique in a particular market, that one can assume, without proof, that they could automatically be perceived by the customer as indicia of origin—a trademark.<sup>196</sup> The Seventh Circuit will not even consider protecting trade dress—even if there is a likelihood of confusion between competing trade dresses—until it first determines that inherent distinctiveness has been established.<sup>197</sup> Essentially, this inquiry asks whether the labeling and packaging of one product is unmistakable enough on its face to be different from other similar products, and could thus be recognizable by consumers as having a specific origin or source.<sup>198</sup>

For example, Marlboro's trade dress in cigarette advertisements is protected because, prior to the Marlboro Man and Marlboro Country, no other cigarette manufacturer had evoked the image of the American West for the purpose of selling cigarettes.<sup>199</sup>

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1996). Importantly, when trade dress is deemed "inherently distinctive," it qualifies for statutory protection against infringers. *See id.*; *see also* *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992) (holding that trade dress is inherently distinctive since it is capable of identifying products or services as coming from a single source).

196. *See AmBrit Inc., v. Kraft, Inc.*, 812 F.2d 1531 (11th Cir. 1986), *cert. denied*, 481 U.S. 1041 (1987).

197. *Rock-A-Bye Baby, Inc. v. Dex Prods., Inc.*, 867 F. Supp 703 (N.D. Ill. 1994) (summary judgment denied in trade dress case involving stuffed bear toys for infants). In *Rock-A-Bye Baby*, the court relied on *Two Pesos*, discussed *infra* Part I.F (citing *Spraying Sys. Co., v. Delavan, Inc.*, 975 F.2d 387, 392 (7th Cir. 1992) (holding spray nozzle not inherently distinctive)).

198. *Carillion Importers Ltd. v. Frank Pesce Co.*, 913 F. Supp. 1559 (S.D. Fla. 1996). The trade dress of *Stolichnaya Cristall Vodka* creates an overall impression that is inherently distinctive. The court found that unlike the intricately shaped bottles of *Absolut*, *Finlandia*, and other vodkas in evidence before the court, *Stolichnaya Cristall* employs a conventionally shaped, clear glass wine bottle that is stamped "Made in the U.S.S.R." The bottle has a black plastic neck wrapping and a narrow black label. The decorative touches on the label include the product's name in prominent white and gold lettering, gold scrollwork around the product's name, and small red lettering below the name that touts the product's characteristics. The bottle also has a second small label comprised of four overlapping gold medallions that is located on the neck of the bottle. Despite the commonplace use of some of these individual components in the marketing of alcoholic beverages other than ultra premium vodkas, their use here is a fanciful addition to the vodka market. *See id.* at \*4 ("Combined, these components have an elegant, minimalist style that is suggestive of refinement and quality. Such a design is distinctive in the vodka marketplace and protectable as trade dress.").

199. *See Philip Morris Inc. v. Star Tobacco Corp.*, 879 F. Supp. 379 (S.D.N.Y. 1995) (holding Marlboro's Western trade dress inherently distinctive).

The Southern District of New York found that Marlboro's usage of the western motif was unique in the cigarette market, and regardless of *actual* consumer awareness, consumers could *potentially* be aware of that fact.<sup>200</sup>

## 2. Secondary Meaning

If a product is not "inherently distinctive," the fact finder must determine whether that product has acquired "secondary meaning."<sup>201</sup> Secondary meaning renders a trade dress protectable if the originator of the trade dress can prove two things: (1) that the trade dress identifies the source of a product; and (2) that there is a likelihood of confusion<sup>202</sup> between the original trade dress and the trade dress of the allegedly infringing product.<sup>203</sup> It is important to note that the Lanham Act never explicitly mentions secondary meaning, except when ultra-specifically discussing descriptive trademarks, which are not considered inherently distinctive.<sup>204</sup>

Secondary meaning is acquired over time, and exists when the purchasing public has come to associate the trade dress with the particular source of the product.<sup>205</sup> For example, the Nike "swoosh" has become equivalent to the actual word "Nike" as an indicator of source for sneakers and athletic gear.<sup>206</sup>

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200. *See id.*

201. Secondary meaning is sometimes referred to as "acquired distinctiveness," and is established when "the user of . . . a trade dress has shown that by long and exclusive use in the sale of the user's goods, the [dress] has become so associated in the public mind with such goods that the [dress] serves to identify the source of the goods and to distinguish them from those of others." *Aromatique, Inc. v. Gold Seal, Inc.*, 28 F.3d 863, 870 (8th Cir. 1994) (holding potpourri pillow-shaped package with ribbon tie not inherently distinctive), *reh'g denied*, 1994 U.S. App., LEXIS 26010 (8th Cir. Sept. 20, 1994).

202. When determining the likelihood of confusion, a court must consider the type of trademark, similarity of design, similarity of products, identity of retail outlets and purchasers, identity of the advertising media utilized, actual confusion, and intentional copying. *See Schwinn Bicycle Co. v. Ross Bicycles, Inc.*, 678 F. Supp 1336, 1345 (N.D. Ill. 1988) (holding exercise bike acquired secondary meaning).

203. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992); *see also* *Wallace Int'l Silversmiths, Inc. v. Godinger Silver Art Co.*, 916 F.2d 76, 79 (2d Cir. 1990) (holding ornamental silverware design not subject to trademark protection), *cert. denied*, 499 U.S. 976 (1991).

204. 15 U.S.C. § 1125(a) (1994).

205. *See Two Pesos*, 505 U.S. at 766 n.4.

206. *See Nike, Inc. v. Leslie*, 1987 WL 13664, at \*1 (M.D. Fla.) (finding "the marks

A very high standard of proof is needed to establish secondary meaning.<sup>207</sup> Specifically, trade dress with secondary meaning must fulfill the primary function of *identifying* the plaintiff.<sup>208</sup> The plaintiff's *mere association* with the trade dress is not sufficient.<sup>209</sup> The existence of secondary meaning can be determined by examining (1) direct consumer testimony, (2) consumer surveys, (3) exclusivity of trade dress use, (4) length and manner of use, (5) amount and manner of advertising, (6) amount of sales and number of customers, (7) established place in the market, and (8) proof of intentional copying.<sup>210</sup>

In an effort to elucidate the concept of inherent distinctiveness, many courts have, perhaps unintentionally, melded the concept of secondary meaning into their definition of inherent distinctiveness.<sup>211</sup> Instead of focusing solely on a product's uniqueness in the marketplace when attempting to determine inherent distinctiveness,<sup>212</sup> certain courts shift their focus from the package itself to the consumers' associations with the product's configuration.<sup>213</sup> These courts improperly base their rulings on the secondary mean-

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Nike, the Swoosh Design, and Nike & Swoosh Design are each arbitrary, fanciful and strong trademarks, and are afforded the broadest ambit of protection from infringing uses"); *see also* Nike, Inc. v. "Just Did It" Ent., 799 F. Supp. 894 (N.D. Ill. 1992) (granting Nike swoosh and slogan trademark protection from non-parody reproduction), *rev'd on other grounds*, 6 F.3d 1225 (7th Cir. 1993).

207. Secondary meaning is acquired over time as consumers begin to associate a product with the product's source. It is important to note that secondary meaning is only established when consumers absolutely identify the product with its source. *See* McLean, *supra* note 6, at 749-50.

208. *See, e.g.,* Paddington Corp. v. Attiki Importers & Distribs., 996 F.2d 577, 582-83 (2d Cir. 1993).

209. Thomas & Betts Corp. v. Panduit Corp., 65 F.3d 654, 658-59 (7th Cir. 1995) (finding shape of cable ties used to bundle wires not indicative of secondary meaning), *cert. denied*, 516 U.S. 1159 (1996).

210. *See, e.g.,* Echo Travel, Inc. v. Travel Assoc., Inc., 870 F.2d 1264 (7th Cir. 1989) (finding Daytona Beach poster did not acquire secondary meaning); Bloomfield Indus. Div. of Spec. Equip. Cos., Inc. v. Stewart Sandwiches, Inc., 716 F. Supp. 380 (7th Cir. 1989) (finding coffee maker capable of having protectable trade dress).

211. *See, e.g.,* Knitwaves, Inc. v. Lollytogs Ltd., 71 F.3d 996 (2d Cir. 1995); Duraco Prods., Inc. v. Joy Plastic Enters., Ltd., 40 F.3d 1431 (3rd Cir. 1994).

212. *See* Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4 (2d Cir. 1976), discussed *supra* Part I.A.

213. *See, e.g.,* Knitwaves, 71 F.3d 996 (wool sweaters); Duraco Prods., 40 F.3d 1431 (plastic urns).

ing aspect of trade dress, never addressing the substance of inherent distinctiveness claims.<sup>214</sup> Much controversy exists because when certain courts examine trade dress, rather than questioning whether it is inherently distinctive, and identifies a product's source, they are actually contemplating whether the trade dress has acquired secondary meaning.<sup>215</sup> Incorporating secondary meaning as part of the definition for inherent distinctiveness is in direct violation of the Supreme Court's specific holding that trade dress can be protectable if it is *either* inherently distinctive or has acquired secondary meaning.<sup>216</sup>

#### F. *The Supreme Court's 1992 Ruling*

This section analyzes the *Two Pesos* decision, and the conflicts arising therefrom. Although *Two Pesos* settled a circuit split, the Court's decision opened the floodgates for an assortment of tests, inconsistently applied, to determine inherent distinctiveness in trade dress.<sup>217</sup>

*Two Pesos, Inc. v. Taco Cabana, Inc.*<sup>218</sup> involved a dispute between two Mexican restaurants, Taco Cabana and Two Pesos, concerning their similar festive decor, which included colorful umbrellas and awnings, patio dining, bright paintings and murals, and decorative Mexican artifacts.<sup>219</sup> Taco Cabana alleged unfair competition and trade dress infringement under section 43(a) of the Lanham Act.<sup>220</sup> The district court and circuit court ruled that Taco Cabana's trade dress was protectable, and in fact had been copied and infringed upon by Two Pesos.<sup>221</sup> Both courts held that the combination of elements in Taco Cabana's trade dress was not merely descriptive of the type of food served in the restaurant, and

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214. See Stewart & Huget *supra* note 43.

215. See Stuart Hall Co. v. Ampad Corp., 51 F.3d 780, 787 (8th Cir. 1995).

216. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992).

217. See Chapman, *supra* note 49, at 42 n.10; Dillon, *supra* note 60; see also Greg L. Pehlman, *Unfair Competition—Infringement Claims Under the Lanham Act—Relaxed Standards for Protection of Distinctive Trade Dress*, 60 TENN. L. REV. 449 (1993).

218. 505 U.S. 763 (1992).

219. *Id.*

220. *Id.*

221. *Id.*; see also Newberg, *supra* note 19, at 300.



was capable of serving as an indicator of source.<sup>222</sup> They granted an award of \$3.7 million and ordered Two Pesos to radically alter the overall design of its restaurants.<sup>223</sup>

In a unanimous decision, the Supreme Court upheld the Fifth Circuit's ruling, thus resolving a perennial conflict between the Second and Fifth Circuits regarding the necessity of showing "secondary meaning" when a trade dress is inherently distinctive.<sup>224</sup> The Court stated that trade dress is protectable if it is *either* inherently distinctive *or* has acquired secondary meaning.<sup>225</sup> The Court's decision thereby pronounced that if trade dress is inherently distinctive, it is protectable from the outset.<sup>226</sup> Therefore, a finding of inherently distinctive trade dress eradicates the need to prove secondary meaning, since secondary meaning is no longer considered to be part and parcel of proving inherent distinctiveness.<sup>227</sup> The *Two Pesos* decision further clarified that trade dress is not protectable if it is merely in the process of acquiring secondary meaning, and that the actual existence of secondary meaning must be proven in lieu of proving inherent distinctiveness.<sup>228</sup>

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222. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992); *see also* Newberg, *supra* note 19, at 300.

223. *Taco Cabana Int'l, Inc. v. Two Pesos, Inc.*, 932 F.2d 1113, 1117 (5th Cir. 1991). Incidentally, the rival chains continued to litigate after the Supreme Court's ruling because Two Pesos allegedly furthered customer confusion by not adhering to the Supreme Court's order to alter its trade dress. *See* Bill Carlino, *Trade Dress Distress: Supreme Court Ruling May Be Cat's Meow for Companies Set to File Copycat Lawsuits*, NATION'S RESTAURANT NEWSPAPER, Nov. 9, 1992, at 1. In 1993, Taco Cabana announced that it would acquire all of Two Pesos restaurant assets for approximately \$22 million. Taco Cabana President and CEO Richard Cervera noted, sarcastically, that converting existing Two Pesos restaurants would be "aided by the very striking physical resemblance of the two chains." Greg Hassell, *A Tex-Mex Merger: Taco Cabana Gets Its Two Pesos Worth*, HOUS. CHRON., Jan. 13, 1993, at B1.

224. The Fifth Circuit did not require proof of source identification (secondary meaning) to show that trade dress is inherently distinctive. For example, the court in *Chevron Chemical Co. v. Voluntary Purchasing Groups*, 659 F.2d 695, 702 (5th Cir. 1981), *cert. denied*, 457 U.S. 1126 (1982) focused primarily on the arbitrariness of the trade dress and its relevance to the product. In contrast, the Second Circuit required proof of both arbitrariness of trade dress as well as proof of consumer source identification, thereby including proof of secondary meaning as a requisite for inherent distinctiveness. *See, e.g.,* *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996 (2d Cir. 1995).

225. *See* *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 774 (1992).

226. *Id.*

227. *Id.*

228. *Id.*

*Two Pesos* unified the standard for trademark and trade dress law, and held once and for all that protection for trade dress requires either inherent distinctiveness or secondary meaning, but not both.<sup>229</sup> The *Two Pesos* decision codified the majority rule followed by the Fifth,<sup>230</sup> Seventh<sup>231</sup> and Eleventh Circuits,<sup>232</sup> but overruled the Second and Third Circuits<sup>233</sup> which previously combined the concepts of inherent distinctiveness and secondary meaning under the singular definition of “inherent distinctiveness” in trade dress.<sup>234</sup>

Since secondary meaning is no longer required, whether a product is deemed inherently distinctive is vital to whether or not a company’s trade dress receives protection from potential infringers.<sup>235</sup> Importantly, *Two Pesos* did not set out a clear test as to when a given combination of elements will be deemed inherently distinctive as a whole,<sup>236</sup> and accepted the lower court jury finding of “inherent distinctiveness” without ever reviewing or examining the criteria the jury used in making this finding.<sup>237</sup> The Court did

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229. *Two Pesos*, 505 U.S. at 770.

230. *Taco Cabana Int’l, Inc. v. Two Pesos, Inc.*, 932 F.2d 1113, 1120 (5th Cir. 1991), *aff’d*, 505 U.S. 763, *reh’g denied*, 505 U.S. 1244 (1992).

231. *See Computer Care v. Service Sys. Enter.*, 982 F.2d 1063 (7th Cir. 1992) (finding car care repair reminder letter inherently distinctive).

232. *See Brooks Shoe Mfg. Co. v. Suave Shoe Corp.*, 716 F.2d 854 (11th Cir. 1983) (finding athletic shoes not inherently distinctive).

233. *See, e.g., Paddington Corp. v. Attiki Importers & Distribs.*, 996 F.2d 577 (2d Cir. 1992).

234. *See Chapman, supra* note 49, at n.10; *Dillon, supra* note 60; *Glieberman, supra* note 40; *Johnson, supra* note 41, at 286; *Newberg, supra* note 19; *Stewart & Huget, supra* note 43; *see also Brown, supra* note 41, at 1379; *Davis, supra* note 29; *Gaske, supra* note 41, at 1136; *Kane, supra* note 40.

235. *See Nard, supra* note 6.

236. *See McLean, supra* note 6.

237. *See Two Pesos*, 505 U.S. at 765. The district court instructed the jury that: Trade dress is the total image of the business. Taco Cabana’s trade dress may include the shape and general appearance of the exterior of the restaurant, the identifying sign, the interior kitchen floor plan, the decor, the menu, the equipment used to serve food, the servers’ uniforms and other features reflecting on the total image of the restaurant.

*Id.* at 764 n.1. The court of appeals accepted this definition and quoted from *Blue Bell BioMedical v. Cin-Bad, Inc.*, 864 F.2d 1253, 1256 (5th Cir. 1989), that “[t]he ‘trade dress’ of a product is essentially its total image and overall appearance.” *Two Pesos*, 505 U.S. at 764 n.1. The jury was also instructed that to be found inherently distinctive, the trade dress must not be descriptive. *Id.* at 766 n.3. In its *Two Pesos* decision, the Su-

not give an explicit definition, and left the concept of “inherent distinctiveness” largely ambiguous.<sup>238</sup> District courts have thus been left to wrestle with the inevitable question: just how inherently distinctive must trade dress be to warrant protection?<sup>239</sup>

The *Two Pesos* ruling may be interpreted as beneficial for newer, smaller businesses which create a special look, style, or product, because that look would be protected from the day the business opens its doors,<sup>240</sup> or the day the product enters the market.<sup>241</sup> Competitors of an inherently distinct trade dress owner are more likely to attempt to steal or appropriate the trade dress at the outset of its use, rather than after the trade dress has been used in the market for a long period of time.<sup>242</sup> This is likely to result in a financial loss to the developer of the trade dress if the trade dress is not deemed inherently distinctive from the start.<sup>243</sup>

In light of the *Two Pesos* decision, a business considering entry into the marketplace is now be able to introduce its new goods or services bearing a distinctive design, with the security that the law will protect its concept at the outset.<sup>244</sup> The new business will not have to administer comprehensive, costly statistical surveys to establish that customers actually associate its trade dress with its

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preme Court held that trade dress which is inherently distinctive is protectable under section 43(a) without a showing that it has acquired secondary meaning:

Section 43(a) neither mentions nor contains the concept of secondary meaning, and where secondary meaning does appear in the Lanham Act, is as a requirement applying only to merely descriptive marks and not to inherently distinctive ones. Engrafting a secondary meaning requirement onto § 43(a) also would make more difficult the identification of a producer with its product, and thereby undermine the Lanham Act's purposes of securing to a mark's owner the goodwill of his business and protecting consumers' ability to distinguish among competing producers. Moreover, it could have anticompetitive effects by creating burdens on the start-up of small business.

*Id.* at 763.

238. See David Klein, *The Ever-Expanding Section 43(a): Will The Bubble Burst?*, 2 U. BALT. INTELL. PROP. L.J. 65 (1993).

239. See generally Stewart & Huget, *supra* note 43 (discussing the elements of the distinctiveness analysis).

240. *Id.*

241. See *Carillion Importers Ltd. v. Frank Pesce Co.*, 913 F. Supp. 1559 (S.D. Fla. 1996).

242. *Two Pesos*, 505 U.S. at 767-71.

243. *Id.* at 774-75.

244. See Newberg, *supra* note 19, at 311.

business, nor will it have to prove that customers are actually confused about the ownership of similar design concepts.<sup>245</sup>

The *Two Pesos* ruling could be viewed alternatively as having anticompetitive results, by allowing potential monopolization of certain looks, styles or products.<sup>246</sup> Some commentators see *Two Pesos* as a radical extension of trademark law that guarantees an onslaught of litigation because protection would be given to concepts that would not otherwise qualify for copyright or patent registration and protection.<sup>247</sup> Commentators have predicted that designs that do not qualify for copyright or patent protection may unfairly be given trade dress protection under the broadest reading of *Two Pesos*,<sup>248</sup> which would grant a perpetual monopoly to the first user of a product's design.

## II. VARIOUS TESTS CURRENTLY USED BY COURTS TO DETERMINE INHERENT DISTINCTIVENESS IN TRADE DRESS

This part enumerates the differing circuit court tests currently used to ascertain whether trade dress is inherently distinctive, by

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245. *Id.*

246. See Gleiberman, *supra* note 40; Johnson, *supra* note 41.

247. Because trade dress protection extends to the overall packaging or design of a product, even if a product's individual components are not protectable, manufacturers of patentable designs will likely seek protection under section 43(a) of the Lanham Act rather than under copyright or patent law. In comparison to copyright protection, which generally lasts only for the life of an author plus fifty years, and patent protection, which lasts fourteen years, trade dress protection may extend indefinitely. See Johnson, *supra* note 41, at 307.

248. See *Hubbell Inc. v. Pass & Seymour, Inc.*, No. 94 CIV.7631, 1995 WL 464906, at \*3 (S.D.N.Y. Aug. 4, 1995) (holding that patent law would be undermined if protection given to trade dress).

The focus of this Note does not explore trade dress copying as it relates to patent law or copyright law. In a recent Second Circuit decision the court noted that although trade dress may supplement copyright and patent law by protecting unpatentable product configurations and novel marketing techniques, overextension of trade dress protection can undermine restrictions in copyright and patent law that are designed to avoid monopolization of products and ideas. Consequently, courts should proceed with caution in assessing claims to unregistered trade dress protection so as not to undermine the objectives of these other laws. See *Hubbell Inc. v. Pass & Seymour, Inc.*, No. 94 CIV.7631, 1995 WL 464906 (S.D.N.Y. Aug. 4, 1995) (quoting *Milstein, Inc. v. Greger, Lawlor, Roth, Inc.*, 58 F.3d 27 (2d Cir. 1995) (addressing the allegation that a greeting card manufacturer would gain a monopoly on a distinctive type of greeting card by claiming that the distinctive features of that type are part of its protected trade dress)).

diagramming the contrasting interpretations and analytical approaches developed by district courts following *Two Pesos*.<sup>249</sup>

Despite the Supreme Court's efforts to unify trade dress and trademark law in *Two Pesos*,<sup>250</sup> the problem remains that currently no standard approach to determining inherent distinctiveness in trade dress has been adopted by all courts.<sup>251</sup> Courts have developed many different tests to determine inherent distinctiveness in trade dress, and the existence of multiple tests—varying from courtroom to courtroom<sup>252</sup>—leads to inconsistent results in granting trade dress protection.<sup>253</sup> Importantly, different circuit courts use different “tests” for inherent distinctiveness, hence the outcome of a trade dress action can vary based solely on jurisdiction.<sup>254</sup>

Such incongruity is exemplified by comparing two New York cases, *Krueger International, Inc. v. Nightingale*,<sup>255</sup> and *Knitwaves Inc., v. Lollytogs Ltd.*<sup>256</sup> The courts in these two cases employed their own special “tests” for inherent distinctiveness, and these tests bore no resemblance to each other.

In *Krueger*, the court held that the overall look of a chair<sup>257</sup> was protectable trade dress when a competitor produced an exact

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249. 505 U.S. 763 (1992).

250. See *Two Pesos, Inc., v. Taco Cabana, Inc.*, 505 U.S. 763 (1992).

251. See Chapman, *supra* note 49.

252. See *infra* Part II.C.3 (examining the criteria used by the *Krueger* court in determining inherent distinctiveness).

253. See *infra* Parts II.C.1-3 (comparing *Duraco* with *Stuart Hall* and *Krueger*); see also Chapman, *supra* note 49.

254. See, e.g., *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996, 1002 (2d Cir. 1995) (“[W]e applied the ‘more discerning’ ordinary observer test and compared only the protected portion of the design.”); *Stuart Hall Co. v. Ampad Corp.*, 51 F.3d 780 (8th Cir. 1995); *Kreuger Int’l, Inc. v. Nightingale Inc.*, 915 F. Supp. 595 (S.D.N.Y. 1996); *Duraco Prods., Inc. v. Joy Plastic Enters., Ltd.*, 40 F.3d 1431 (3rd Cir. 1994); *Seabrook Foods, Inc. v. Bar-Well Foods, Ltd.*, 568 F.2d 1342 (C.C.P.A. 1977); *Chevron Chem. Co. v. Voluntary Purchasing Groups, Inc.*, 659 F.2d 695 (5th Cir. 1981), *cert. denied*, 457 U.S. 1126 (1982); *Paddington Corp. v. Attiki Importers & Distribs., Inc.*, 996 F.2d 577 (2d Cir. 1993); see also Davis, *supra* note 29.

255. 915 F. Supp. 595 (S.D.N.Y. 1996).

256. 71 F.3d 996 (2d Cir. 1995) (holding “squirrel” and “leaf” children’s sweater designs are not inherently distinctive).

257. The Matrix chair is a strong, lightweight, stackable chair. *Krueger*, 915 F. Supp. at 607-08.

copy of the chair. The court found that the individual design elements of the chair served both “aesthetic and source-identifying purposes.”<sup>258</sup> The *Krueger* court established that the chair was inherently distinctive by using standards in direct opposition to a prior Second Circuit case, *Knitwaves, Inc. v. Lollytogs Ltd.*<sup>259</sup>

The *Knitwaves* court held that a design’s primary purpose can be either aesthetic or source identifying, but not both, and evaluated inherent distinctiveness by whether the manufacturer intended to use the design “to identify the source and distinguish his or her goods.”<sup>260</sup> The *Krueger* court rejected *Knitwaves*’ “false dichotomy between aesthetics and source-identification,”<sup>261</sup> and concluded that the Matrix chair had a “distinctive”<sup>262</sup> and “unique”<sup>263</sup> overall look and that manufacturers “generally seek unique designs as an important source identifier.”<sup>264</sup> The *Krueger* court reached its decision by applying the principles of several of the other existing “tests” implemented in other circuits.<sup>265</sup>

This part reviews the assortment of tests currently used to determine inherent distinctiveness in trade dress. Section A revisits the pivotal trademark case, *Abercrombie & Fitch v. Hunting World, Inc.*<sup>266</sup> Section B isolates *package design* cases and the conflicting tests used to determine inherent distinctiveness in trade dress. Section C distinguishes *product configuration* cases and analyzes divergent circuit court tests used to determine inherent

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258. *Id.* at 607. The court went on to state that “[a]lthough each of the individual design elements serves both functional and aesthetic purposes, it is the overall look that [we] must consider.” *Id.* at 607 (citing *Jeffrey Milstein, Inc. v. Greger, Lawlor, Roth, Inc.*, 58 F.3d 27, 32 (1995)).

259. 71 F.3d 996 (2d Cir. 1995).

260. *Id.* at 1008.

261. *Krueger Int’l, Inc. v. Nightingale, Inc.*, 915 F. Supp. 595, 606 (S.D.N.Y. 1996).

262. *Id.*

263. *Id.*

264. *Id.*

265. The test the *Krueger* court applied included a combination of factors culled from the court opinions in *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4 (2d Cir. 1976), discussed *infra* Part II.A.; *Stuart Hall Co. v. Ampad Corp.*, 51 F.3d 780 (8th Cir. 1995), discussed *infra* Parts II.C.2, III.B; *Seabrook Foods, Inc. v. Bar-Well Foods Ltd.*, 568 F.2d 1342 (C.C.P.A. 1977), discussed *infra* Part II.B.1; and *Chevron Chem. Co. v. Voluntary Purchasing Groups*, 659 F.2d 695 (5th Cir. 1981), *cert. denied*, 457 U.S. 1126 (1982), discussed *infra* Part II.B.3.

266. 537 F.2d 4 (2d Cir. 1976), discussed *infra* Part II.A.

distinctiveness.

The cases discussed illustrate the present dispute concerning whether package design cases<sup>267</sup> should be treated differently from product configuration cases.<sup>268</sup> Although both package design and product configuration are considered trade dress,<sup>269</sup> some courts assert that a product's shape (configuration) can never be inherently distinctive per the *Abercrombie* spectrum.<sup>270</sup> These courts aver that secondary meaning must always be proven in order for product configuration to receive protection. This conception seems to require courts to skirt around the Supreme Court's ruling in *Two Pesos*<sup>271</sup> which afforded protection to trade dress that is either inherently distinctive or has acquired secondary meaning.<sup>272</sup>

#### A. *The Abercrombie & Fitch Spectrum*

The classic test for determining a trademark's distinctiveness was outlined in *Abercrombie & Fitch Co. v. Hunting World, Inc.*<sup>273</sup> The *Abercrombie* spectrum is widely accepted in many trade dress infringement court opinions, and is universally accepted in trademark case decisions.<sup>274</sup>

The basic factors that courts consider are the degree to which the trademark or trade dress is generic, descriptive, suggestive, arbitrary, or fanciful.<sup>275</sup> Many courts across the country incorporate the *Abercrombie* spectrum into their versions of inherent distinctiveness tests.<sup>276</sup>

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267. Package design refers to a product's container, label or overall appearance. See Kane, *supra* note 40, at 200.

268. Product configuration refers to the shape of the product itself. See *id.*

269. See *id.*

270. See, e.g., *Health O Meter, Inc. v. Terrallion Corp.*, 873 F. Supp. 1160, 1170 n.5 (N.D. Ill. 1995) (questioning whether such is actually the law of the Seventh Circuit).

271. 505 U.S. 763 (1992); see *supra* Part I.F (discussing the *Two Pesos* case).

272. Certain courts have divided trade dress into two subsections: product configuration and package design, and hold that stricter standards of proof are required to determine inherent distinctiveness in product configuration. See *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 966 (2d Cir. 1995); discussion *infra* Part II.C.1.

273. 537 F.2d 4 (2d Cir. 1976).

274. See *Two Pesos*, 505 U.S. 763 (1992); Newberg, *supra* note 19, at 311.

275. See *Abercrombie*, 537 F.2d at 9.

276. See *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 773 (1992); Jeffrey Milstein, Inc. v. Greger, Lawlor, Roth, Inc., 58 F.3d 27, 31 (2d Cir. 1995); Paddington

### B. Package Design Cases

Although the Supreme Court does not distinguish product configuration trade dress cases from package design trade dress cases,<sup>277</sup> this section demonstrates that other courts have made this distinction when determining inherent distinctiveness of trade dress. Package design cases refer to a product's container, label, or overall appearance.<sup>278</sup> Product configuration cases involve the shape of the product itself.<sup>279</sup> Courts differ on whether *Abercrombie*<sup>280</sup> should apply to all trade dress cases—both package design and product configuration—to neither, or to one or the other.<sup>281</sup>

Although the applicability of the *Abercrombie* classifications to trade dress was not at issue in *Two Pesos*, the Court noted that the Fifth Circuit below had applied the *Abercrombie* classifications to the trade dress issue and discussed them without disapproval.<sup>282</sup> Certain circuits continually apply the *Abercrombie & Fitch* spectrum<sup>283</sup> to trade dress infringement cases involving package design.<sup>284</sup> These circuits seem to have adopted Justice Thomas' concurrence in *Two Pesos*, in which he clearly supported applying the *Abercrombie & Fitch* system to trade dress.<sup>285</sup>

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Corp. v. Attiki Importers & Distribs., Inc., 996 F.2d 577, 583-84 (2d Cir. 1993).

277. See *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992).

278. See *Kane*, *supra* note 40 at 200.

279. See *id.*

280. See *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4 (2d Cir. 1976).

281. See analysis *infra* Parts II.B and II.C (discussing product configuration, package design, and everything in between).

282. 505 U.S. at 767; see *Taco Cabana Int'l, Inc. v. Two Pesos, Inc.*, 932 F.2d 1113, 1120, n.8 (5th Cir. 1991); see also *Paddington*, 996 F.2d at 583 (2d Cir. 1993).

283. See *supra* Part I.A (discussing *Abercrombie & Fitch*).

284. See *Stewart & Huget*, *supra* note 43; see also *Duraco*, 40 F.3d 1431 (discussing cases involving package design as opposed to product configuration).

285. Justice Thomas wrote that:

Over time, judges have come to conclude that packages or images may be as arbitrary, fanciful, or suggestive as words or symbols, their numbers limited only by the human imagination. A particular trade dress, then, is now considered as fully capable as a particular trademark of serving as a 'representation or designation' of source under 43(a). As a result, the first user of an arbitrary package, like the first user of an arbitrary word, should be entitled to the presumption that his package represents him without having to show that it does so in fact.

505 U.S. at 787 (citing *AmBrit*, 812 F.2d at 1536 ("[S]quare size, bright coloring, pebbled



In *Two Pesos*,<sup>286</sup> the Court considered the trade dress of restaurants, and stopped just short of *expressly* ruling on whether *Abercrombie* classifications should apply to all trade dress cases; but the Second, Fourth, Fifth, Seventh, and Eleventh Circuits agree that they do.<sup>287</sup>

### 1. The *Seabrook* Test—Court of Customs and Patent Appeals, 1977

The *Seabrook* test, based on the *Abercrombie* classifications,<sup>288</sup> was developed in 1977 by the Court of Customs and Patent Appeals.<sup>289</sup> In *Seabrook Foods, Inc. v. Bar-Well Foods Ltd.*,<sup>290</sup> the court enunciated a test for inherent distinctiveness, based on such factors as commonality of shape, ornamentation, and distinctiveness from accompanying descriptions.<sup>291</sup>

In *Seabrook*, a frozen vegetable package “leaf” design was not deemed to be an “unmistakable, certain, distinct” means of identifying “Seabrook Farms.” Instead, the court decided that the design was a decorative panel that served as background for the word portion of the trademark. Bar-Well Foods was able to prove that Sea-

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texture, polar bear and sunburst images” of the package of the “Klondike” ice cream bar held inherently distinctive), *cert. denied*, 481 U.S. 1041 (1987); *see also* RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 13, 16. (1995).

286. 505 U.S. at 787.

287. *See* Sara Lee Corp. v. Kayser-Roth Corp., 81 F.3d 455 (4th Cir. 1996); *Paddington*, 996 F.2d at 577, 583; *Taco Cabana*, 932 F.2d at 1113 (5th Cir. 1991); *Blau Plumbing Inc. v. S.O.S. Fix-It, Inc.*, 781 F.2d 604, 609 (7th Cir. 1986); *AmBrit, Inc. v. Kraft, Inc.*, 812 F.2d 1531, 1539 (11th Cir. 1986).

288. *See* *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4 (2d Cir. 1976).

289. *Seabrook Foods, Inc. v. Bar-Well Foods Ltd.*, 568 F.2d 1342 (C.C.P.A. 1977); *see also* *Brooks Shoe Mfg. Co. v. Suave Shoe Corp.*, 716 F.2d 854, 857-58 (11th Cir. 1983); *Robarb, Inc. v. Pool Builders Supply of Carolinas, Inc.*, 21 U.S.P.Q.2d 1743, 1745 (N.D. Ga. 1991).

290. 568 F.2d 1342 (C.C.P.A. 1977).

291. The *Seabrook* test includes the following factors:

Whether [the trade dress] is a “common” basic shape or design, whether it was unique or unusual in a particular field, and whether it was a mere refinement of a commonly-adopted and well-known form of ornamentation for a particular class of goods viewed by the public as a dress or ornamentation for the goods, or whether it was capable of creating a commercial impression distinct from the accompanying words.

*Seabrook*, 568 F.2d. at 1344.

brook's design was not uncommon in the frozen food market.<sup>292</sup>

The *Seabrook* test is very useful because it clarifies the importance of market context. The *Seabrook* test asks "whether the design, shape or combination of elements is so unique, unusual or unexpected in this market that one can assume without proof that it will automatically be perceived by customers as an indicium of origin."<sup>293</sup> Any test of inherent distinctiveness must ask, "Inherently distinctive as compared to what?"<sup>294</sup> The Fifth Circuit implicitly asked a similar question in *Two Pesos* when it considered whether, within the universe of Mexican restaurant chains, the plaintiff's particular restaurant decor was common or uncommon.<sup>295</sup>

Similarly, the court in *Robarb, Inc. v. Pool Builders Supply of Carolinas, Inc.*,<sup>296</sup> relying on the *Seabrook* test, held that plaintiff's trade dress for a swimming pool clarifier was inherently distinctive. Specifically, the court stated that "the combination of the transparent bottle, dark blue liquid, white cap and layout of the white printing carry a distinctive visual impression."<sup>297</sup> In contrast, the court in *Turtle Wax, Inc. v. First Brands Corp.*,<sup>298</sup> employing both the *Seabrook* and *Chevron* tests,<sup>299</sup> found that the

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292. *See id.*

293. *Krueger Int'l. Inc. v. Nightingale Inc.*, 915 F. Supp. 595, 603 (S.D.N.Y. 1996); *see Philip Morris, Inc. v. Star Tobacco Corp.*, 879 F. Supp. 379 (S.D.N.Y. 1995). In *Philip Morris*, the court reasoned that:

This trade dress is inherently distinctive. Philip Morris says without contradiction that *no* cigarette manufacturer had evoked the image of the American West for the purpose of selling a particular brand until the Marlboro Man saddled up and rode into Marlboro Country. The juxtaposition of product and setting is entirely arbitrary, perhaps even fanciful. Accordingly the Marlboro trade dress is protectable under section 43(a) of the Lanham Act without (under the *Two Pesos* holding) any showing of secondary meaning.

*Id.* at 383 (emphasis added); *see also AmBrit, Inc. v. Kraft, Inc.*, 812 F.2d 1531 (11th Cir. 1986) (applying *Seabrook* test to product design), *cert. denied*, 481 U.S. 1041 (1987).

294. *Krueger*, 915 F. Supp. 595 (S.D.N.Y. 1996).

295. *Taco Cabana Int'l, Inc. v. Two Pesos, Inc.* 932 F.2d 1113, 1118-19 (5th Cir. 1991), *aff'd*, 505 U.S. 763 (1992).

296. 21 U.S.P.Q.2d 1743 (N.D. Ga. 1991).

297. *Id.* at 1745.

298. 781 F. Supp. 1314 (N.D. Ill. 1991).

299. *See id.* at 1318; *see also Seabrook*, 568 F.2d at 1342, discussed *supra* Part II.B.1; *Chevron*, 659 F.2d at 695, discussed *infra* Part II.B.3.

plaintiff's combination of packaging elements for its car polish product was not sufficient to establish an inherently distinctive trade dress. According to the court in *Turtle Wax*, plaintiff's trade dress was merely a combination and refinement of elements already found in abundance in the field of automotive chemicals, even though other products of a similar nature did not possess all of the elements of plaintiff's combination.<sup>300</sup> *Seabrook* highlights the notion that a design cannot be considered in a vacuum.<sup>301</sup>

## 2. The *AmBrit* Test—Eleventh Circuit, 1986

An often cited Eleventh Circuit case, *AmBrit, Inc. v. Kraft, Inc.*<sup>302</sup> applied the *Seabrook* test, and evaluated the distinctiveness of Klondike ice cream bars in terms of (1) whether the shape or design was common, (2) whether it was unique in a particular field, and (3) whether it was a mere refinement of the well-known form of ornamentation for a particular class of goods.<sup>303</sup> The purpose of this inquiry was to withhold protection of common forms of presentation in a particular field of competition.<sup>304</sup>

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300. *Turtle Wax*, 781 F. Supp. at 1321. The court reasoned that:

Although he found the individual elements of plaintiff's trade dress to be commonplace in the industry, the Magistrate Judge did note that no product possessed those same elements in combination . . . . According to *Turtle Wax*, this finding compelled the conclusion that Liquid Crystal's trade dress was new and unique. However, such a rule essentially would extend trade dress protection to every new compilation of elements in a particular field and would run afoul of the *Seabrook* tenet that a trade dress is not unique and distinctive if it merely refines common forms of ornamentation utilized in a particular field of goods . . . . Any other rule essentially would require a finding of inherent distinctiveness whenever a new product enter the market.

*Id.* (holding Liquid Crystal trade dress not inherently distinctive) (relying on *Seabrook* and *Chevron*, discussed *supra* Part II.B.1 and *infra* Part II.B.3).

301. See, e.g., *Thompson Medical Co. v. Pfizer, Inc.*, 753 F.2d 208, 213 (2d Cir. 1985) (examining Sportscreme and Sportsgel alleged trademarks, the court held "the determination whether a mark is descriptive or suggestive cannot be made in a vacuum").

302. 812 F.2d 1531, 1539 (11th Cir. 1986), *cert. denied*, 481 U.S. 1041 (1987).

303. See *AmBrit, Inc. v. Kraft, Inc.*, 812 F.2d 1531, 1536 (11th Cir. 1986) (citing test first established in *Seabrook Foods, Inc. v. Bar-Well Foods, Ltd.*, 568 F.2d 1342, 1344 (C.C.P.A. 1977)), *cert. denied*, 481 U.S. 1041 (1987).

304. See *Turtle Wax*, 781 F. Supp. at 1321, in which the court stated:

Presumably it can be said about the trade dress of any new product that no competitive product combines precisely the same elements in its trade dress. However, that fact alone does not make the product's trade dress inherently dis-

In *AmBrit*, Kraft's ice cream Polar B'ar infringed on AmBrit's inherently distinctive trade dress for the Klondike Bar. Both packages featured a polar bear and an arctic sun, and Klondike's package was held to be arbitrary, thus inherently distinctive.<sup>305</sup> The court also ruled that the colors used on Klondike's packaging were inherently distinctive.<sup>306</sup>

Relying on *AmBrit*, the court in *Callaway Golf Company v. Golf Clean, Inc.*<sup>307</sup> found that the trade dress of Callaway's "Big Bertha" golf clubs was inherently distinctive.<sup>308</sup> The court ruled that the trade dress incorporated the common, basic shape and design of golf clubs, but that features such as "chunky" and "aggressive" wide top line, semicircular relief facet on the sole of the club, large straight cut rear cavity, distinguishing white score lines, and unique medallion in cavity's insert created a unique total image for the clubs.<sup>309</sup> The court said that "the record reveals no prior use of any combination of the [plaintiff's] trade dress elements that is at all similar to the unique impression conveyed by [their] trade dress."<sup>310</sup> Callaway's arbitrary combination of features makes their Big Bertha Irons inherently distinctive.<sup>311</sup>

### 3. The *Chevron* Test—Fifth Circuit, 1981

In *Chevron Chemical Co. v. Voluntary Purchasing Groups, Inc.*,<sup>312</sup> the Fifth Circuit determined that the plaintiff's gardening and lawn bottles packaging were inherently distinctive, noting that "the possible varieties of advertising display and packaging are virtually endless."<sup>313</sup> Under the *Chevron* test, a trade dress may be

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tinctive. Any other rule essentially would require a finding of inherent distinctiveness whenever a new product enters the market.

*Id.*

305. For an in-depth discussion of *AmBrit*, see *supra* Part I.B.

306. See *AmBrit*, 812 F.2d at 1536.

307. 915 F. Supp. 1206 (M.D. Fla. 1995) (holding Big Bertha golf clubs are inherently distinctive).

308. *Id.* at 1212.

309. *Id.*

310. *Id.* at 1212 (quoting *AmBrit*, 812 F.2d at 1537).

311. *Id.*

312. 659 F.2d 695 (5th Cir. 1981), *cert. denied*, 457 U.S. 1126 (1982).

313. *Chevron Chem. Co. v. Voluntary Purchasing Groups*, 659 F.2d 659, 703 (5th Cir. 1981), *cert. denied*, 457 U.S. 1126 (1982).

protected notwithstanding an absence of secondary meaning “[i]f the features of the trade dress sought to be protected are arbitrary and serve no function either to describe the product or assist in its effective packaging.”<sup>314</sup> This language echoes the standards set forth in *Abercrombie & Fitch*.<sup>315</sup> The Supreme Court explicitly approved the application of the *Chevron* test to product designs in its decision in *Two Pesos*.<sup>316</sup>

The Supreme Court noted that the *Chevron*<sup>317</sup> test for inherent distinctiveness, or variations of it, is followed by the Fifth, Seventh, Ninth and Eleventh Circuits.<sup>318</sup> Although *Chevron* does not set out each of the individual *Abercrombie* classifications, the Court stated that “[t]he Fifth Circuit was quite right in *Chevron* . . . to follow the *Abercrombie* classifications consistently and to inquire whether trade dress for which protection is claimed under § 43(a) is inherently distinctive.”<sup>319</sup>

Most importantly, the *Chevron* test establishes that rather than any one feature, it is “the combination of elements and the total impression that the dress gives to the observer that should be the focus of a court’s analysis of distinctiveness.”<sup>320</sup> “If overall dress is arbitrary, fanciful, or suggestive, it is inherently distinctive despite its incorporation of generic or descriptive elements.”<sup>321</sup> The court wrote that “[o]ne could no more deny protection to a trade dress for using commonly used elements than one could deny protection to a trademark because it consisted of a combination of

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314. *Id.* at 702. The court further noted that “[t]he combination of particular hues of . . . colors, arranged in certain geometric designs, presented in conjunction with a particular style of printing . . . create a distinctive visual impression” (regarding packaging of lawn and garden products). *Id.* at 703.

315. *See Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4 (2d Cir. 1976)..

316. *See Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 773 (1992).

317. *Chevron*, 659 F.2d at 695.

318. *Two Pesos*, 505 U.S. at 770.

319. *Id.* at 773.

320. *Paddington Corp. v. Attiki Importers & Distribs., Inc.*, 996 F.2d 577, 584 (2d Cir. 1993) (citing *Chevron*, 659 F.2d at 695, 702).

321. *Paddington*, 996 F.2d at 584; *cf. LeSportsac, Inc. v. K Mart Corp.*, 754 F.2d 71, 76 (2d Cir. 1985) (holding despite functionality of individual elements of sports bag, bag is nonfunctional “when viewed in its entirety”).

commonly used letters of the alphabet.”<sup>322</sup> Under *Chevron*, it is in the best interest of the potential trade dress owner to choose trade dress that would acquire inherently distinct status immediately, namely an arbitrary, fanciful, or suggestive trade dress.

#### 4. The *Paddington* Test—Second Circuit, 1993

Consistent with most of the post-*Two Pesos* case law in the New York area,<sup>323</sup> in *Paddington Corp. v. Attiki Importers & Distributors, Inc.*,<sup>324</sup> the court applied the *Seabrook* and *Chevron* approaches, to determining inherent distinctiveness in trade dress. In *Paddington*, an importer of the anise liqueur ouzo under the label “No. 12 Ouzo” brought a trademark and trade dress infringement suit against a rival ouzo importer using the label “#1 Ouzo.” The importers’ bottle designs, labeling, and gift boxes were “strikingly similar” in appearance,<sup>325</sup> containing similar design elements and “using identical shades of red, white and black.”<sup>326</sup> The court of appeals concluded that the No. 12 Ouzo bottle was inherently distinctive.<sup>327</sup>

Notably, *Paddington* marks a departure from the Second Cir-

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322. *Paddington*, 996 F.2d at 584 (applying *Chevron* test).

323. See *Krueger Int’l, Inc. v. Nightingale Inc.*, 915 F. Supp. 595, 604 (S.D.N.Y. 1996); *Paddington*, 996 F.2d at 577; *Mulberry Thai Silks, Inc. v. K & K Neckwear, Inc.*, 897 F. Supp. 789, 796-97 (S.D.N.Y. 1995) (finding in men’s necktie industry “the use of geometric design elements, bright colors and the like is common”); *Casa Editrice Bonechi, S.R.L. v. Irving Weisdorf & Co.*, 1995 WL 528001 at \*6 (S.D.N.Y. 1995) (applying *Seabrook* test to souvenir guidebooks); *Jaret Int’l, Inc. v. Promotion In Motion, Inc.*, 826 F. Supp. 69, 75 (E.D.N.Y. 1993) (applying *Seabrook* test to sour candies); *EFS Mktg., Inc. v. Russ Berrie & Co., Inc.*, 836 F. Supp. 128 (S.D.N.Y. 1993) (holding no trade dress protection for Troll doll with pointed ears, pug nose, pot belly, wild hair and outstretched arms, because such elements are common in doll industry).

324. 996 F.2d 577 (2d Cir. 1993).

325. *Id.* at 586.

326. *Id.*

327. In *Paddington*, the court ruled that:

There is nothing descriptive about the bottle and label design that conveys anything about its particular contents, except for the use of the trademark “No. 12 Ouzo,” and the fact that the bottle . . . indicates to the observer that it contains a liquid that probably is potable. The tone and layout of the colors, the style and size of the lettering, and, most important, the overall appearance of the bottle’s labeling, are undeniably arbitrary. They were selected from an almost limitless supply of patterns, colors and designs.

*Id.* at 584.

cuit's pre-*Two Pesos* stance that it would not be clear error to find that No. 12 ouzo's trade dress was weak based on lack of secondary meaning. In *Paddington*, the Second Circuit followed *Two Pesos*, and ruled that "[b]ased on the record before us, the No. 12 trade dress clearly is arbitrary and fanciful and would appear to a consumer to be intended to identify the origin of the product, and therefore it is a strong mark,"<sup>328</sup> with no proof of secondary meaning required.<sup>329</sup>

Following *Paddington*, the court in *Kompan, A.S. v. Park Structures, Inc.*<sup>330</sup> found a playground equipment manufacturer's trade dress likely to be inherently distinctive. The court stressed that even if each of the design elements in a product's trade dress would not be inherently distinctive on its own, the court must look at the combination of elements and the total impression it gives the observer in order to determine whether the trade dress is distinctive.<sup>331</sup>

Thus, according to *Kompan*, because producers have almost unlimited choice in design, trade dress choices will normally be inherently distinctive.<sup>332</sup> If, however, a particular industry customarily uses certain trade dress, then trade dress is generic rather than

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328. *Id.* at 585; see *Charles of the Ritz Group, Ltd. v. Quality King Distribs., Inc.*, 832 F.2d 1317, 1321 (2d Cir. 1987) ("Opium" perfume's trademark and trade dress are arbitrary rather than generic or descriptive and thus are among the strongest and most highly protected class of trademarks"); *AmBrit, Inc. v. Kraft, Inc.*, 812 F.2d 1531, 1539 (11th Cir. 1986) (in analyzing the strength of trade dress, "the scope of protection increases as the trade dress moves toward the arbitrary end of the spectrum"), *cert. denied*, 481 U.S. 1041 (1987).

329. See *Paddington*, 996 F.2d at 585.

330. 890 F. Supp. 1167 (N.D.N.Y. 1995).

331. In *Kompan*, the court stated that:

Although other manufacturers sometimes used curved lines, they neither use them as consistently as *Kompan* nor emphasize the curves as design elements in the way that *Kompan* does. In addition, *Kompan* uses color in a way not replicated by the other manufacturers. Other manufacturers also use the primary colors, red, blue, and yellow, emphasized in *Kompan*'s designs, but none do so as predominantly or in the same combinations of shades and hues. A potential consumer familiar with *Kompan*'s use of color might well recognize a *Kompan* product by its color combinations alone.

*Id.* at 1174 (citing *Paddington*, 996 F.2d at 584).

332. See *id.* at 1173.

distinctive and is not entitled to protection.<sup>333</sup>

### C. Product Configuration Cases

Trade dress is sometimes broken into two camps: product configuration and package design. Product configuration cases deal with the shape of the product itself, unlike package design cases, which concern the overall packaging appearance of a product.<sup>334</sup> This section isolates product configuration cases, and articulates the various tests used to determine inherent distinctiveness in trade dress. Courts employ a variety of dissimilar tests, none of which are identical.

For example, the Second and Third Circuits have adopted strict, but differing, standards for finding inherent distinctiveness in product configuration cases, and have rejected the *Abercrombie* classifications<sup>335</sup> as a workable standard.

In *Duraco Products, Inc., v. Joy Plastic Enter., Ltd.*,<sup>336</sup> the Third Circuit fashioned its own test requiring product configuration trade dress to be “unusual and memorable;” “conceptually separable from the product;” and “likely to serve primarily as a designator of origin of the product.”<sup>337</sup> In *Knitwaves, Inc. v. Lollytogs Ltd.*,<sup>338</sup> the Second Circuit created its own test for inherent distinctiveness involving the manufacturers’ “intent” to use the product’s shape to distinguish his goods.

Other courts are split as to whether *Knitwaves*’ and *Duraco*’s

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333. See *id.* at 1173; see also *Jeffrey Milstein, Inc. v. Greger, Lawlor, Roth, Inc.*, 58 F.3d 27, 31 (2d Cir. 1995) (“‘Trade dress’ has taken on a more expansive meaning and includes the design and appearance of the product as well as that of the container and all elements making up the total visual image by which the product is presented to customers.”); cf. *Fabrication Enters. v. Hygienic Corp.*, 64 F.3d 53, 58 (2d Cir. 1995); *Mulberry Thai Silks, Inc. v. K&K Neckwear, Inc.*, 897 F. Supp. 789, 792 (S.D.N.Y. 1995) (refusing to protect a particular trade dress because its overall design was common to all products within its industry); *Computer Care v. Service Sys. Enters., Inc.*, 982 F.2d 1063, 1068-69 (7th Cir. 1992).

334. See *Duraco*, 40 F.3d at 1434.

335. See *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4 (2d Cir. 1976); discussion *supra* Part I.A.

336. 40 F.3d 1431 (3rd Cir. 1994).

337. *Id.*

338. 71 F.3d 996 (2d Cir. 1995).



strict standards should apply in lieu of the *Abercrombie* classifications<sup>339</sup> to product configuration and/or package design cases.<sup>340</sup> This section will discuss the various approaches courts take when determining the inherent distinctiveness of a product's configuration.

### 1. The *Knitwaves* Test—Second Circuit, 1995

In *Knitwaves, Inc. v. Lollytogs Ltd.*,<sup>341</sup> the Second Circuit announced a departure from its earlier approach to trade dress law.<sup>342</sup> *Knitwaves* involved the design of children's sweaters, particularly the use of "leaf" and "squirrel" designs placed on the sweaters.<sup>343</sup> The court stated that the *Abercrombie* classifications did not make sense when applied to product features, and were therefore inapplicable to product designs.<sup>344</sup> The court created a new test for inherent distinctiveness to determine whether the manufacturer "used" or "intended to use" the design to "identify the source and distinguish his or her goods."<sup>345</sup> In fashioning its "intent" requirement, the *Knitwaves* court relied on dicta from the Supreme Court's 1995 opinion in *Qualitex Co. v. Jacobson Products Co.*<sup>346</sup> *Qualitex* addressed the issue of whether a color could serve as a registered trademark.<sup>347</sup> Upon determining that a color could not be inher-

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339. *Abercrombie*, 537 F.2d 4.

340. See Newberg, *supra* note 19; Stewart & Huget, *supra* note 43.

341. 71 F.3d 996 (2d Cir. 1995).

342. See *id.*

343. *Id.*

344. *Id.* at 1006-1009.

345. *Id.*

346. 514 U.S. 159, 162 (1995).

347. As a matter of policy, color alone is not protected as trade dress, unless it has acquired secondary meaning. See *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 162 (1995) (holding that a single color is entitled to registration and protection); *Norwich Pharmacal Co. v. Sterling Drug, Inc.*, 271 F.2d 569, 572 (2d Cir. 1959) (holding color will not be protected where it is functional; pink is functional for stomach medicine because it creates a pleasing effect for Pepto-Bismol stomach medicine), *cert. denied*, 362 U.S. 919 (1960); *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116 (Fed. Cir. 1985) (holding that pink is not functional for insulation); *Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 1531-32 (Fed. Cir. 1994) (holding that black is functional for outboard motors because compatible with other boat colors), *reh'g denied*, 1994 U.S. App. LEXIS 30952 (Fed. Cir. 1994), *cert. denied*, 514 U.S. 1050 (1995); *R.L. Winston Rod Co. v. Sage Mfg. Co.*, 838 F. Supp. 1396, 1401 (D. Mont. 1993) (all shades of green are functional for graphite fishing rods because only a limited number of dye colors are

ently distinctive,<sup>348</sup> the Court conceded that a color could acquire secondary meaning because “over time, customers may come to treat a particular color . . . as signifying a brand.”<sup>349</sup> The Court concluded that the green-gold color of an ironing board cover at issue in *Qualitex*, although not inherently distinctive, had acquired secondary meaning and therefore could be registered as a trademark.<sup>350</sup>

Notably, *Qualitex* was a trademark case that hinged entirely on secondary meaning. According to the Supreme Court in *Two Pesos*, secondary meaning is not a factor used to determine inherent distinctiveness in trade dress.<sup>351</sup> Detractors of the *Knitwaves* opinion note its reliance on *Qualitex*, rather than *Two Pesos*, and the resulting requirement of proving secondary meaning to establish a piece of clothing’s inherent distinctiveness.<sup>352</sup>

## 2. The *Stuart Hall* Test—Eighth Circuit, 1995

The court in *Stuart Hall Co. v. Ampad Corp.*,<sup>353</sup> per *Two Pesos*,<sup>354</sup> correctly separated the issues of inherent distinctiveness and secondary meaning when determining an overall finding of inherent distinctiveness in trade dress. *Stuart Hall* involved notebook designs.<sup>355</sup> Specifically, the court held that the layout and packaging of Stuart Hall’s notepad was protected from being copied by Ampad because it was inherently distinctive not to consumers, but in and of the type of product itself.<sup>356</sup>

Contrary to the Second Circuit’s *Knitwaves* ruling, the Eighth Circuit, in *Stuart Hall*,<sup>357</sup> made a forceful and persuasive argument that “the Supreme Court has not authorized us to abandon *Aber-*

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available due to difficulties in the dye process).

348. See *Qualitex*, 514 U.S. at 162.

349. *Id.* at 162.

350. *Id.* at 162 (finding green-gold dry-cleaning press pads subject to trademark protection).

351. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992).

352. See Kane, *supra* note 40.

353. 51 F.3d 780 (8th Cir. 1995).

354. See *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992).

355. *Id.*

356. *Id.*

357. *Stuart Hall Co., Inc. v. Ampad Corp.*, 51 F.3d 780 (8th Cir. 1995).

*crombie*,” no matter how much difficulty it causes.<sup>358</sup> The Eighth Circuit reasoned that *Two Pesos* was clearly a case of product design and that court expressly approved the application of the *Abercrombie* classifications to the design of a Mexican restaurant chain.<sup>359</sup> Moreover, the court in *Stuart Hall* found that the entire thrust of *Two Pesos* was to unify the standards for trademark and trade dress, not to balkanize this complex field into yet more sub-categories.<sup>360</sup>

This Eighth Circuit approach resembled the Fifth Circuit’s approach in *Chevron Chemical Co. v. Voluntary Purchasing Groups*,<sup>361</sup> and emphasized the issue of functionality.<sup>362</sup> The question presented by the Eighth Circuit, therefore, is whether and how much the trade dress is dictated by the nature of the product, not whether consumers remember or are “struck by”<sup>363</sup> the design, or associate the design with its source.<sup>364</sup>

### 3. The *Krueger* Test—Southern District of New York, 1996

In the 1996 *Krueger Int’l., Inc. v. Nightingale Inc.*, decision,<sup>365</sup> the district court departed from the Second Circuit’s decision in *Knitwaves*<sup>366</sup> and agreed with the Eighth Circuit’s conclusion in *Stuart Hall*<sup>367</sup> that the Supreme Court envisions trade dress as a “single concept” with trademark law requiring a single test for in-

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358. *Id.* at 788.

359. *See id.*

360. *See Krueger*, 915 F. Supp. at 602 (discussing *Stuart Hall*).

361. 659 F.2d 695 (5th Cir. 1981) (finding gardening and lawn care bottles and packaging inherently distinctive), *cert. denied*, 457 U.S. 1126 (1982); *see discussion supra* Part II.B.3.

362. *Stuart Hall*, 51 F.3d at 786. The question asked by the court was: [W]hether, and how much, the trade dress is dictated by the nature of the product . . . . If the specific design of the trade dress is only tenuously connected with the nature of the product, then it is inherently distinctive . . . . If the design of the trade dress is dictated by the nature of the product, then secondary meaning must be proven.

*Id.*

363. *Id.*

364. *Id.*

365. 915 F. Supp. 595 (S.D.N.Y. 1996).

366. 71 F.3d 996 (2d Cir. 1995); *see discussion supra* Part II.C.1.

367. 51 F.3d 780 (8th Cir. 1995); *see discussion supra* Parts II.C.2, III.B.

herent distinctiveness.<sup>368</sup> In *Krueger*, the court ruled that the overall look of Krueger's Matrix chair was inherently distinctive and was protectable trade dress.<sup>369</sup> Further, the court prohibited Nightingale from producing an exact copy of Krueger's Matrix chair.<sup>370</sup> The court stated that the 1995 *Knitwaves* decision positing a new test for inherent distinctiveness "confuse[d] the analytical requirements for inherent distinctiveness with those of secondary meaning."<sup>371</sup>

The *Krueger* court went on to state that "inherent distinctiveness cannot hinge on how a producer intends to promote a design."<sup>372</sup> If such were the case, the evidentiary requirements for inherent distinctiveness "would be almost identical to those for secondary meaning, and there would be no point in having two categories."<sup>373</sup> The *Krueger* court explained that a producer of a product could only prove "intent" by presenting evidence of how he or she had advertised (or positioned) the product, and by introducing consumer surveys showing how well the advertising worked.<sup>374</sup> This is the kind of evidence typically required for a showing of secondary meaning, not inherent distinctiveness.<sup>375</sup> "An inherent quality, by contrast, is one which 'inheres' in a product, regardless of what the producer intends, particularly if the product is too new to have acquired secondary meaning."<sup>376</sup> The Supreme Court *Two Pesos* decision did not create an "intent" requirement, and stated only that an inherently distinctive design is one that is "capable of identifying a particular source of the product."<sup>377</sup>

Furthermore, the *Krueger* court noted that the Supreme Court

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368. *Krueger*, 915 F. Supp. at 602.

369. *Id.* at 607.

370. *Id.*

371. *Id.* at 602.

372. *Id.* at 602.

373. *Id.*

374. *See id.*

375. *See id.* (citing *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 851 n.11 (1982)) ("To establish secondary meaning, a manufacturer must show that, in the minds of the public, the primary significance of a product feature . . . is to identify the source of the product rather than the product itself.").

376. *Krueger*, 915 F. Supp. at 602 (citing *Two Pesos*, 505 U.S. at 769).

377. *Id.*

explicitly cautioned that attaching a requirement of secondary meaning for inherently distinctive trade dress onto section 43(a) of the Lanham Act would “undermine the purposes of the Lanham Act.”<sup>378</sup> Essentially, the *Krueger* test focuses on the preservation of healthy competition and protects designs that are “pleasing” as long as they are not merely “basic elements of a style” and thus part of the public domain.<sup>379</sup>

#### 4. The *Duraco* Test—Third Circuit, 1994

In *Duraco Products, Inc. v. Joy Plastic Enters., Ltd.*,<sup>380</sup> the court held that a plastic Greek urn manufactured by Duraco was not inherently distinctive because there was no evidence that consumers associated the faux marble plastic urn with the Duraco source name.<sup>381</sup> In the wake of *Two Pesos*, which overruled the Third Circuit’s previous requirement that trade dress must always have secondary meaning to be protected, the *Duraco* court crafted a new test for inherent distinctiveness. Rejecting the *Abercrombie* test as inappropriate for product configuration, the Third Circuit held that unfair competition law did not preclude others from copying trade dress unless the trade dress represented to consumers the source of the goods.<sup>382</sup> The court stated that in order to be inherently distinctive, a product’s feature<sup>383</sup> or combination or arrangement of features, or a product’s configuration, namely the product itself,<sup>384</sup> or the product’s packaging, must be (1) unusual and memorable,<sup>385</sup> (2) conceptually separable from the product,<sup>386</sup> and

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378. *Id.* (quoting *Two Pesos*, 505 U.S. at 774); see 15 U.S.C. § 1125(a) (1994).

379. *Krueger*, 915 F. Supp. at 606 (quoting *Wallace*, 916 F.2d at 81).

380. 40 F.3d 1431 (3d Cir. 1994).

381. *See id.*

382. *Id.* at 1442-1448.

383. An example of a product’s “feature” is the color pink used by Pepto Bismol. *See Norwich Pharmacal Co. v. Sterling Drug, Inc.*, 271 F.2d 569, 572 (2d Cir. 1959).

384. *See Klein, supra* note 239, at 85 (“Product configurations, as a class, are less likely to indicate their source to consumers and therefore, even if inherently distinctive, would be protectable only on proof of secondary meaning.”).

385. The definition of unusual and memorable trade dress is that “[i]t must partake of a unique, individualized appearance, so that a consumer informed of all the options available in the market could reasonably rely on it to identify a source.” *Duraco*, 40 F.3d at 1449; *see Computer Care v. Service Sys. Enters.*, 982 F.2d 1063, 1069 (7th Cir. 1992); *Hoffman, supra* note 31, at 222 (asserting trade dress is inherently distinctive only if “so

(3) likely to serve primarily as designator of origin of the product.<sup>387</sup> This three-part test thus requires that the trade dress must serve a source-identifying function in order to receive trade dress protection.<sup>388</sup> Moreover, unless the trade dress is “memorable, that is, striking or unusual in appearance, or is prominently displayed on the product packaging, or otherwise somehow apt to be impressed upon the minds of consumers so that it is likely to be actually and distinctly remembered,” it cannot serve as a designator of origin.<sup>389</sup> No other circuit has yet to adopt this test,<sup>390</sup> and many have explicitly rejected it.<sup>391</sup>

In *Duraco*, a strikingly similar faux-marble urn of compara-

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unique . . . in a particular market, that one can assume, without proof, that it will automatically be perceived by customer[s] as an indicia [sic] of origin—a trademark”) (citing MCCARTHY, TRADEMARKS AND UNFAIR COMPETITION § 1:1, at 4 (2d ed. 1984 & Supp. 1988), and *AmBrit, Inc. v. Kraft, Inc.*, 805 F.2d 974, cert. denied, 481 U.S. 1041 (1987)).

386. To be conceptually separable, the product configuration must be recognizable by the consumer “as an indicium of source, rather than a decorative symbol or pattern.” *Duraco*, 40 F.3d at 1449 (quoting *Stuart Hall*, 31 U.S.P.Q.2d at 1471, 1994 WL 228939 at \*4, rev’d, 51 F.3d 780 (8th Cir. 1995)).

387. *Duraco Prods., Inc. v. Joy Plastic Enter., Ltd.*, 40 F.3d 1431, 1450 (3d Cir. 1994).

388. *See id.* at 1451.

389. *Id.* at 1449; *see also* *Stuart Hall Co. v. Ampad Corp.*, 31 U.S.P.Q.2d 1468, 1470, 1994 WL 228939 (W.D. Mo. 1994) (“The trade dress must be remembered before it can be confusing”), rev’d, 51 F.3d 780 (8th Cir. 1995); *cf. AmBrit*, 812 F.2d at 1536 (setting forth criterion to measure distinctiveness); *Computer Care*, 982 F.2d at 1069 (holding that sales brochures are inherently distinctive if consumers can identify the product from the trade dress and the trade dress is arbitrary or suggestive); *see also* *Paddington Corp. v. Attiki Importers & Distribs., Inc.*, 996 F.2d 577, 583-84 (2d Cir. 1993).

390. *But see* *Sassafras Enters., Inc. v. Roshko, Inc.*, 915 F. Supp. 1 (N.D. Ill. 1996); discussion *infra* Part II.C.5.

391. *See, e.g.*, *Stuart Hall Co. v. Ampad Corp.*, 51 F.3d 780 (8th Cir. 1995). The court stated that:

We read *Two Pesos* as resting on a presumption that “trade dress” is a single concept that encompasses both product configuration and packaging, and find that its holding applies to trade dress as a whole, not merely to packaging. *Two Pesos* concerned the trade dress of a Mexican restaurant . . . . The *Duraco* opinion views a restaurant’s decor as more like packaging than product configuration, and finds that therefore *Two Pesos* bears no implications regarding product configuration. We perceive a restaurant’s decor as being as akin to product configuration as to packaging . . . . [P]roduct configuration, like packaging, can be inherently distinctive, and if it is, no showing of secondary meaning is required.

*Id.* at 788 (citations omitted).

tively poorer quality was allowed by the district court to continue competing with the Duraco urn, because “there is no evidence that consumers, whether K-Mart buyers or retail customers, perceived that the product emanates from a single source, or for that matter, that the public identified the Duraco planter with the Duraco name.”<sup>392</sup> The court stated that buyers were motivated by profit margin, and the public was motivated by buying an inexpensive “impulse item.”<sup>393</sup> The *Duraco* court stated that protectable trade dress must not appear to the consumer to be a mere component, or essence, of product *gestalt*.<sup>394</sup> Rather, it must appear to be a “red flag” indicator of the product source.<sup>395</sup> Therefore, uniqueness of product configuration is not enough by itself to make configuration inherently distinctive, as required for trade dress protection.<sup>396</sup>

#### 5. The *Sassafras* Test—Northern District of Illinois, 1996

The only other case endorsing the “unusual and memorable”<sup>397</sup> source-identifying capabilities of inherently distinctive trade dress

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392. *Duraco*, 40 F.3d at 1437.

393. *Id.*

394. *Id.* at 1449; see Dillon, *supra* note 60, at 85 (defining protectable trade dress as “a combination of elements selected to identify origin, rather than to serve as mere decor”).

395. *Duraco*, 40 F.3d at 1450. The court facetiously crowned its comparison with the adapted aphorism, “[a]n urn is an urn is an urn.” *Id.* at 1437 n.3; cf. *Gertrude Stein, Sacred Emily* (1913) (“Rose is a rose is a rose is a rose.”), in *GEOGRAPHY AND PLAYS* 178, 187 (1922). The configuration of the Grecian-style faux-marble plastic planter was not inherently distinctive, because consumers were likely to appreciate the planter’s design as an attractive aspect of the product, but not as a source-indicator (i.e. the Duraco planter).

396. The court in *Duraco* explicitly rejects transplanting the categorical distinctiveness inquiry developed for trademarks, see *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976), to product configurations, where alleged trade dress can lie in the very product itself. See *Duraco*, 40 F.3d at 1440. Note that the *Duraco* decision deals exclusively with trade dress said to inhere in the product itself, rather than trade dress alleged in a product’s packaging. These two very different situations will arguably diverge in various incidents. This Note attempts to discuss the dicta in *Duraco*, which is not product configuration-exclusive in order to give a more relevant assessment of various tests for inherent distinctiveness in trade dress. In *Two Pesos* the Supreme Court specifically stated that the sole issue before the court was whether secondary meaning must be proven for an inherently distinctive trade dress *vel non*. *Two Pesos*, 505 U.S. at 767, n.6.

397. *Duraco*, 40 F.3d at 1440.

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set out in *Duraco* is a recent case within the Eighth Circuit, *Sassafras Enterprises, Inc. v. Roshko, Inc.*<sup>398</sup> The case involved a household appliance, specifically a pizza baking system and the accompanying recipe book.<sup>399</sup> The pizza oven was not found to be inherently distinctive.<sup>400</sup> Following *Duraco*, the court stated that, as with trademarks, a product's appearance is entitled to trade dress protection only if the appearance signifies the product's source.<sup>401</sup> The *Sassafras* court held that competitors are free to copy a product's configuration down to the minutest detail, no matter how unique or original that product may be.<sup>402</sup> It is interesting to note that the Illinois *Sassafras* court did not follow the established Eighth Circuit *Stuart Hall* case<sup>403</sup> decided one year prior to *Sassafras*.

### III. THE PROPOSED NATIONAL TEST

There are many different tests currently being used to determine inherently distinctive trade dress. This is troubling because proving inherent distinctiveness is crucial to protecting one's product or service from being illegally duplicated by copycats.<sup>404</sup> While the Supreme Court and the legislature have required a finding of inherent distinctiveness to protect trade dress, neither has defined precisely what inherent distinctiveness means.<sup>405</sup> Thus, courts have had to invent their own various definitions of the term over the years, and now disparity and incongruity abound.<sup>406</sup> A clear, nationally accepted test to determine inherent distinctiveness in trade dress is needed to stop contradictory rulings from being made across the country, and to protect trade dress owners' rights

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398. 915 F. Supp. 1 (N.D. Ill. 1996) (pizza stoneware set and instruction book not inherently distinctive).

399. *Id.*

400. *Id.*

401. *Id.*

402. *Id.*

403. 51 F.3d 780; see discussion *supra* Part II.C.2; discussion *infra* Part III.B.

404. See 15 U.S.C. § 1125(a) (1994); *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992).

405. See 15 U.S.C. § 1125(a) (1994); *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992).

406. See Gaske, *supra* note 41, at 1137; cf. Brown, *supra* note 41, at 1378-79; Johnson, *supra* note 41, at 285-86.



in some kind of consistent, reliable fashion.

By combining the best elements of various circuit court tests for determining inherent distinctiveness in trade dress, this part develops a test that can be implemented in *all* trade dress cases—encompassing both product configuration and package design alike, and everything in between.

The proposed test is very similar to the test posited by the court in *Stuart Hall Co. v. Ampad Corp.*,<sup>407</sup> because this proposed test relies on many of the same underlying cases. The new test devised in this part adds new definitions to the steps that the *Stuart Hall* appellate court took to arrive at its finding that Stuart Hall's notepad design was inherently distinctive. These new definitions are culled from other case law to clarify particular concepts so as to eliminate any source of confusion as to the meanings of terms such as "unique."

Section A sets forth the various tests currently employed by courts nationwide, and the ensuing confusion. Section B discusses both the overruled and current *Stuart Hall*<sup>408</sup> decisions, treating the decisions as a "case study" to illustrate the controversy resulting from the Supreme Court's 1992 *Two Pesos* decision. Section C sets forth the specific prongs of this Note's proposed national test, and explains why each element is important to determining inherent distinctiveness in trade dress.

#### A. *Confusion Among Courts*

Tests for determining inherent distinctiveness in trade dress remain ambiguous in the Second, Third, and Eighth Circuits. In these circuits, the rules for trade dress protection were upended in 1992 by the Supreme Court's ruling in *Two Pesos, Inc. v. Taco Cabana, Inc.*<sup>409</sup> Prior to *Two Pesos*, a plaintiff seeking trade dress protection in these circuits had to prove that the dress had acquired secondary meaning.<sup>410</sup> *Two Pesos* held that protection for trade

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407. 51 F.3d 780 (8th Cir. 1995).

408. *Id.*

409. 505 U.S. 763 (1992); *see supra* Part I.F (discussing the *Two Pesos* ruling).

410. *See Health o Meter, Inc. v. Terrillon Corp.*, 873 F. Supp. 1160, 1171 (N.D. Ill. 1995) (holding split-mat scale design inherently distinctive) (citing *Two Pesos*, discussed

dress requires either inherent distinctiveness or secondary meaning, but not both.<sup>411</sup>

The absence of a dispositive gauge for determining inherent distinctiveness has resulted in Circuit courts, and even district courts within the same jurisdiction, using dissimilar measurements and factors to determine whether trade dress is inherently distinctive.<sup>412</sup> In some cases, the court's test for inherent distinctiveness requires that the trade dress be so unique that consumers will automatically associate the product with a particular source.<sup>413</sup> In other cases, consumer awareness does not come into play and the dispute is over precisely how the trade dress describes or relates to the product itself.<sup>414</sup>

For example, in *Abercrombie & Fitch Co. v. Hunting World, Inc.*,<sup>415</sup> the Second Circuit introduced a classification system for determining distinctiveness that focused solely on the connection between the trade dress and the product, not the trade dress and the consumer.<sup>416</sup> In contrast, in *Duraco Products, Inc. v. Joy Plastic Enters.*,<sup>417</sup> the Third Circuit used a test for determining distinctiveness that focused singularly on the connection between the trade dress and the consumer, and ignored the *Abercrombie & Fitch*

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*supra* Part I.F, and relying on the *Chevron* test, discussed *supra* Part II.B.3).

411. *Two Pesos*, 505 U.S. at 770-71.

412. The crux of the problem is that a "distinctive" trade dress, that is, trade dress that is different or the first of its kind, might or might not be "inherently distinctive." See *supra* Part II (analyzing various tests used to determine inherent distinctiveness in trade dress); see also John B. Hardaway III, Jeffrey L. Wilson, & J. Bennett Mullinax, *Trade Dress Protection*, 4-DEC S.C. LAW. 14 (1992).

413. See *Duraco Prods., Inc. v. Joy Plastic Enters., Ltd.*, 40 F.3d 1431 (3rd Cir. 1994) (holding that a plastic Greek urn manufactured by Duraco was not inherently distinctive, because there was no evidence that consumers associated the faux marble plastic urn with the Duraco source name); see also *supra* Part II.C.4 (discussing *Duraco*).

414. See *Stuart Hall Co. v. Ampad Corp.*, 51 F.3d 780 (8th Cir. 1995) (holding that the layout and packaging of a notepad was protected from being copied by a competitor because it was inherently distinctive not to consumers, but in and of the type of product itself); see also *Krueger Int'l, Inc., v. Nightingale Inc.*, 915 F. Supp. 595, 602 (S.D.N.Y. 1996) (stating that an 'inherent' quality is one which 'inheres' in a product, regardless of whether the producer of the product intends the product to identify its source).

415. 537 F.2d 4 (2d Cir. 1976).

416. See *supra* Part I.A (discussing the test for inherent distinctiveness set forth in *Abercrombie*).

417. 40 F.3d 1431 (3d Cir. 1994).

classification system.<sup>418</sup> Employing yet another test in *Knitwaves, Inc. v. Lollytogs, Ltd.*,<sup>419</sup> the Second Circuit recently focused on the consumer-trade dress connection, but went one step further and brought in the issue of the manufacturer's intent to use the design of the trade dress to indicate the source of his or her product.<sup>420</sup> Then a few months later in *Kreuger International, Inc. v. Nightingale, Inc.*,<sup>421</sup> the Second Circuit changed its tune and focused instead on the availability of alternative designs and the overall appearance of the combination of elements. Alternatively, in *Chevron Chemical Co. v. Voluntary Purchasing Groups, Inc.*,<sup>422</sup> the Fifth Circuit did not require proof of source identification to show that trade dress is inherently distinctive and, like *Abercrombie*, the focus was on the arbitrariness of the trade dress and its relevance to the product.<sup>423</sup> Yet another test, applied in *Seabrook*,<sup>424</sup> also sometimes referred to as the *AmBrit*<sup>425</sup> test, focuses on a comparison of a plaintiff's trade dress to others in the same class of goods, not on the trade dress's impact on consumers.<sup>426</sup>

### B. A Case Study

The potential exists for tests for inherent distinctiveness to be devised and enacted contrary to established law. The evolution of the Eighth Circuit *Stuart Hall* case is an excellent case study. Before being overruled, the district court's decision in *Stuart Hall*<sup>427</sup> demonstrated that in the absence of a nationwide standard, courts

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418. See *supra* Part II.C.4 (discussing the test for inherent distinctiveness set forth in *Duraco*).

419. 71 F.3d 996 (2d Cir. 1995).

420. See *supra* Part II.C.1 (discussing the test for inherent distinctiveness set forth in *Knitwaves*).

421. 915 F. Supp. 595 (2d Cir. 1996); see discussion *supra* Part II.C.3.

422. 659 F.2d 695 (5th Cir. 1981), *cert. denied*, 457 U.S. 1126 (1982).

423. See *supra* Part II.B.3 (discussing the test for inherent distinctiveness set forth in *Chevron*).

424. See *Seabrook Foods, Inc. v. Bar-Well Foods, Ltd.*, 568 F.2d 1342 (C.C.P.A. 1977).

425. See *AmBrit, Inc. v. Kraft, Inc.* 812 F.2d 1531 (11th Cir. 1986), *cert. denied*, 481 U.S. 1041 (1987).

426. See *supra* Parts II.B.1, II.B.3 (discussing the tests for inherent distinctiveness set forth in *Seabrook* and *AmBrit*).

427. 31 U.S.P.Q. 2d (BNA) 1468, 1470, (1994) WL 228939 (W.D. Mo. 1994), *rev'd* 51 F.3d 780 (8th Cir. 1995).

can broadly, and incorrectly, interpret the Supreme Court's ruling regarding inherent distinctiveness in trade dress.<sup>428</sup>

In 1994, the *Stuart Hall* district court rejected the widely used *Chevron* test<sup>429</sup> and put a new twist on the difficult issue of defining an "inherently distinctive" trade dress by requiring a "striking" appearance.<sup>430</sup> The trade dress at issue in this case consisted of various features of note pads, including their tear-off covers, permanent covers, and inside page layouts. The court denied the plaintiff's motion for a preliminary injunction, holding that its trade dress was "eminently forgettable rather than memorable."<sup>431</sup> Although there was evidence that the defendant copied every detail of the layout of the plaintiff's inside page, the court found that the plaintiff's layout was extremely weak in its mental impact and had a routine appearance.<sup>432</sup> Thus, the court found that the page layout was not "intentionally designed to identify the *source* of the product," but rather simply "to supply a practical, nice-appearing inside page."<sup>433</sup>

The court acknowledged that other courts have seldom, if ever, used the terminology "striking" or "memorable" in defining an inherently distinctive trade dress.<sup>434</sup> However, the court noted that this definition was consistent with the requirement that a protectable mark or trade dress be "recognizable as an indicium of source, rather than a decorative symbol or pattern."<sup>435</sup> The court reasoned, "[t]o surpass merely decorative or aesthetically pleasing features

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428. *Id.*; see also *supra* Part I.F (discussing *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992)).

429. See *Chevron*, 659 F.2d 695 (5th Cir. 1981), discussed *supra* Part II.B.3.

430. In *Stuart Hall*, the court required that:

In order to be inherently distinctive in a manner to serve as a source-identifier, it seems evident that a trade dress must have sufficient strength of visual impact to impress itself on the mind of the consumer, and thus be subject to recall when the consumer next enters the market. The trade dress must thus be *striking* in appearance, or at least *memorable*.

*Stuart Hall*, 31 U.S.P.Q. 2d (BNA) at 1470 (emphasis added).

431. *Id.*

432. See *id.*

433. *Id.* (emphasis added); see also William G. Barber, *Recent Developments in Trademark Law*, 3 TEX. INTEL. PROP. L.J. 47 (1994).

434. See *Stuart Hall*, 31 U.S.P.Q. 2d (BNA) at 1470.

435. *Id.* at 1471 (citing 3 CALLMANN, UNFAIR COMPETITION § 18.01, at 2 (4th ed. 1988)).

and become a source identifier, a trade dress must be striking and memorable.”<sup>436</sup> In a footnote, the judge offered the following as appearances he personally finds striking and memorable: “Durante’s nose, Holmes’ mustache, Chief Judge Arnold’s bow ties and Congressman Leach’s sweaters.”<sup>437</sup>

Citing *Abercrombie*,<sup>438</sup> *Chevron*,<sup>439</sup> and *Seabrook*,<sup>440</sup> the appellate court held that “the classification of trade dress as arbitrary or fanciful or suggestive, and thus inherently distinctive, requires no showing that the trade dress is memorable or striking.”<sup>441</sup> The Eighth Circuit had consistently applied *Abercrombie*<sup>442</sup> in the past, and in light of *Two Pesos*’ approval,<sup>443</sup> “[saw] no reason to abandon the classic test now.”<sup>444</sup> The court found that the district court erred as a matter of law by requiring that *Stuart Hall*’s trade dress be striking, or at least memorable, to be inherently distinctive.<sup>445</sup> The “striking and memorable” requirement was found to be inconsistent with the established law of the Eighth Circuit, the majority of other circuits, and the Supreme Court, so the court confirmed its adherence to the *Abercrombie* test for inherent distinctiveness of trade dress.<sup>446</sup>

### C. *The Proposed Test*

The sheer number and variety of differing tests and criteria used to determine inherent distinctiveness in trade dress clearly mandates the need for a national, uniform approach to this issue. Accordingly, this Note proposes an efficient three-pronged approach combining the best elements of the *Abercrombie* categori-

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436. *Id.* at 1471.

437. *Id.* at 1470, n.1.

438. *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4 (2d Cir. 1976); see discussion *supra* Part I.A.

439. *Chevron Chem. Co. v. Voluntary Purchasing Groups*, 659 F.2d 695 (5th Cir. 1981), *cert. denied*, 457 U.S. 1126 (1982); see discussion *supra* Part II.B.3.

440. *Seabrook Foods, Inc., v. Bar-Well Foods Ltd.*, 568 F.2d 1342 (C.C.P.A. 1977); see discussion *supra* Part II.B.1.

441. *Stuart Hall*, 51 F.3d at 788.

442. 537 F.2d 4 (2d Cir. 1976).

443. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992).

444. 51 F.3d 780, 788 (8th Cir. 1995).

445. *Id.* at 788.

446. *Id.*

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zation system,<sup>447</sup> the *Seabrook* test,<sup>448</sup> the *AmBrit* test,<sup>449</sup> and the *Chevron* test.<sup>450</sup>

Importantly, the proposed test specifically defines inherent distinctiveness in trade dress. The test argues that there is no reason to require a plaintiff to show consumer connotations associated with inherently distinctive trade dress, because buyer association with a product is solely a question of secondary meaning, not inherent distinctiveness.<sup>451</sup> The proper question is how much the trade dress is dictated by the nature of the product, good, or service, and whether it is capable of indicating the product's source, not whether consumers remember or are struck by the design, or whether consumers associate the design with its source.<sup>452</sup> Again, this latter question is one of secondary meaning, not inherent distinctiveness.

The proposed test prevents the unfair competition that would result from the copying of an unusual or unique package design or product configuration when secondary meaning cannot be proven. However, failure to satisfy all three prongs of the proposed test will necessitate proof of secondary meaning in order to receive protection from trade dress infringement.

The proposed test provides three prongs that must be satisfied for trade dress to be deemed inherently distinctive. First, it is necessary to determine whether the design or shape or combination of elements is *common or basic*. If ordinary, everyday designs are pervasively used in commerce, those designs may not be protected as being inherently distinctive of a particular product or source. The Lanham Act specifically provides protection only to trade dress that is capable of distinguishing a product and its source from similar products.<sup>453</sup>

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447. 537 F.2d 4 (2d Cir. 1976); *see supra* Part I.A.

448. 568 F.2d 1342 (C.C.P.A. 1977); *see supra* Part II.B.1.

449. 812 F.2d 1531 (11th Cir. 1986), *cert. denied*, 481 U.S. 1041 (1987); *see supra* Part II.B.2.

450. 659 F.2d 695 (5th Cir. 1981), *cert. denied*, 457 U.S. 1126 (1982); *see supra* Part II.B.3.

451. *See id.*; *supra* Part I.E.

452. *AmBrit*, 812 F.2d at 1531; *see supra* Part II.B.2.

453. 15 U.S.C. § 1125(a) (1994); *see supra* Part I.D. As illustrated in *AmBrit*, an ice cream package featuring the random, arbitrary combination of textured silver foil, a

At this point, the second prong of the proposed test becomes important: whether the *total impression* that the design or shape gives to the observer is *unique, unusual or unexpected in a particular field*.<sup>454</sup> There are three important distinctions regarding this factor.

The first distinction is that even if each element alone would not be inherently distinctive, the *combination* of elements can still be inherently distinctive. It is well established that trade dress encompasses a product or service's *overall* look and total image.<sup>455</sup>

The second distinction is that "unique" is to be defined as arbitrary, fanciful or suggestive on the *Abercrombie* scale<sup>456</sup> and applies to the combination of elements and the total impression the trade dress gives to the observer.<sup>457</sup> Uniqueness plays a large part in determining whether a product's trade dress is inherently distinctive, and is a difficult standard to satisfy. For example, ornamentation lacks inherent distinctiveness if it is merely a variation of decoration commonly used for a type of goods, such as "stripes, bars and designs" on athletic shoes.<sup>458</sup>

By looking at the overall combination of elements, the proposed test prevents a product's trade dress from being inherently distinctive merely because no competitive product combines precisely the same elements in its trade dress. At the same time, a particular trade dress can still be considered inherently distinctive, meaning arbitrary and different from others in the field, without being particularly "striking or memorable"<sup>459</sup> The possible variations of design elements for a package design or product configuration are virtually infinite in the areas of fanciful, arbitrary and sug-

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polar bear, and a shining sun is inherently distinctive Klondike Ice Cream Bar trade dress. 812 F.2d 1531; *see supra* Part II.B.2.

454. *See Seabrook*, 568 F.2d at 1342; *see also supra* Part II.B.1.

455. *See supra* Part I.F; *Chevron*, 659 F.2d 695 (stating that the Lanham Act does not require proof of secondary meaning when the overall impression of the trade dress is distinctive), *cert. denied*, 457 U.S. 1126 (1982); *see, e.g., Two Pesos*, 505 U.S. at 763.

456. *See Abercrombie*, 537 F.2d at 4; discussion *supra* Part I.A.

457. *Id.*

458. *See Brooks Shoe Mfg. Co. v. Suave Shoe Corp.*, 716 F.2d 854, 858 n.10 (11th Cir. 1983).

459. *Id.*

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gestive trade dress.<sup>460</sup> By setting out a clear definition of “uniqueness,”<sup>461</sup> and adhering to established trademark law,<sup>462</sup> the proposed test prevents monopolization, and does not improperly expand trade dress protection into areas reserved for copyrights and patents.<sup>463</sup>

The third distinction to draw regarding the second prong of the proposed test is that isolated third party uses of various elements of the plaintiff’s trade dress do not detract from the distinctiveness of the overall impression of those elements of the plaintiff’s product.<sup>464</sup>

The final prong of the proposed test is to determine that the design or shape or combination of elements is not a mere refinement of a commonly adapted and well-known form of ornamentation for the goods or services. According to *Paddington*,<sup>465</sup> which followed parts of the tests set forth in *Seabrook*,<sup>466</sup> *AmBrit*<sup>467</sup> and *Chevron*,<sup>468</sup> the tone and layout of colors, size, lettering, and style can be selected from an almost limitless supply of patterns, colors and designs.<sup>469</sup> If a particular industry customarily uses certain combinations in trade dress then the trade dress is generic rather than distinctive, and is not entitled to protection.<sup>470</sup>

In accordance with the Supreme Court’s ruling in *Two Pesos*, if a product is inherently distinctive under the proposed test, secon-

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460. See Gaske, *supra* note 41, at 1134 n.97 (“[T]he use of the inherent distinctiveness test has been justified in a trade dress case because ‘the wide range of available packaging and design options allows a producer to appropriate a distinctive identity without unduly hindering his competitor’s ability to compete.’”) (quoting *Sicilia Di R. Biebow & Co. v. Cox*, 732 F.2d 417, 426 n.7 (5th Cir. 1984)).

461. See *Seabrook*, 568 F.2d at 1342, discussed *supra* Part II.B.1; *Krueger*, 915 F. Supp at 595, discussed *supra* Part II.C.3.

462. See *supra* Part I.D (discussing 15 U.S.C. § 1125(a)); see also *supra* Part I.A (discussing *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4 (2d Cir. 1976)).

463. See *supra* notes 248 and 249 and accompanying text.

464. See, e.g., *Paddington*, 966 F.2d at 577, discussed *supra* Part II.B.4; *Kompan*, 890 F. Supp at 1167, discussed *supra* notes 24, 132 and accompanying text.

465. 966 F.2d 577; see *supra* Part II.B.4.

466. 568 F.2d 1342; see *supra* Part II.B.1.

467. 812 F.2d 1531; see *supra* Part II.B.2.

468. 659 F.2d 695, *cert. denied*, 457 U.S. 1126 (1982); see *supra* Part II.B.3.

469. *Id.*

470. See *Kompan*, 890 F. Supp at 1167, discussed *supra* notes 24 and 132 and accompanying text.



dary meaning need not be demonstrated.<sup>471</sup> If a product cannot pass all three prongs of the proposed test, then secondary meaning must be proven to warrant protection from infringement. If neither inherent distinctiveness (using the proposed test) nor secondary meaning can be proven, then the trade dress is not subject to protection.

#### CONCLUSION

In *Two Pesos, Inc. v. Taco Cabana, Inc.*, the Supreme Court resolved a split in the circuits regarding trade dress protection. The Court held that trade dress is protectable based on a finding of either inherent distinctiveness or secondary meaning, and that a finding of both was not required. This either/or standard required courts to subsequently treat inherent distinctiveness and secondary meaning as separate links on a chain, as opposed to confusing the two concepts as synonymous terms. Problematically, while the Court precisely defined what constitutes a finding of secondary meaning, the Court left the exact meaning of inherent distinctiveness undefined. Thus, over the years district courts have devised homegrown recipes for determining inherent distinctiveness in trade dress, and the ingredients vary from jurisdiction to jurisdiction.

A standard test to determine inherent distinctiveness in trade dress needs to be adopted nationwide. Various incongruous tests are currently employed by courts across the country, producing circuit to circuit inconsistencies and widely varying results in trade dress protection litigation. The proposed test is a clear, concise, immediately useable tool, which combines the best features of the various circuit tests being used today, and provides a uniform approach to determining inherent distinctiveness in trade dress.

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471. See *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992); discussion *supra* Part I.F.