



Trademark Law

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Graham & Dunn PC



Trade dress





Definition of trade dress

- Trade dress = total image of product
 - Includes features such as size, shape, color or color combinations, texture, graphics, even sales techniques and design of product
 - Elements combine to create the whole visual image presented to customers
 - Originally limited to product packaging, *i.e.*, product “dressing”
 - Now expanded to décor, restaurant menu and style; or distinctive dress and performing style of rock group or professional wrestler

Trade dress vs. trademark



Trademark



Trade dress



Source of protection

- Protected under Section 43(a) as a “symbol” or “device”
 - Section 43(a) protects unregistered TMs
 - However, Section 2 standards apply
 - Indeed, trade dress can be registered
- To be protected, trade dress must designate source, *i.e.*, function like a registered TM even though registration may be lacking



Secondary meaning

- Is secondary meaning required? Apply trade dress to *Abercrombie* spectrum of distinctiveness
 - If inherently distinctive (*i.e.*, suggestive, arbitrary, or fanciful), no secondary meaning required
 - If not inherently distinctive (*i.e.*, descriptive), need to show secondary meaning
 - Colors and “design” trade dress protectable but need secondary meaning
- Either way, distinctive trade dress is protectable
- However, placing on spectrum can be difficult



Functionality

- As with TMs, trade dress cannot be functional
 - Functionality = feature is essential to the use or purpose of the article, or affects the cost or quality of article
 - Exclusive use of feature would put competitors at disadvantage
 - *E.g., Talking Rain v. South Beach*
 - Burden on proving nonfunctionality is on plaintiff
 - *See* Section 43(a)(3)
 - If trade dress is functional, it is not protected and can be freely copied



Functionality factors

Courts consider whether:

1. Design yields utilitarian advantage
2. Alternative designs are available
 - Courts want to avoid giving seller monopoly
3. Advertising touts utilitarian advantages
 - *E.g., Talking Rain v. South Beach*
4. Particular design results from a comparatively simple or inexpensive method of manufacture
 - *E.g., Kellogg v. National Biscuit*
 - Incontestability does not preclude functionality



Policy implications

- What is the impact on competition:
 - Of requiring secondary meaning even with trade dress that's inherently distinctive?
 - Of requiring trade dress to be nonfunctional?



Prima facie infringement case

1. Valid, protectable trade dress
 - *I.e.*, non-functional and distinctive
 - Inherently distinctive or secondary meaning
2. Priority
 - *I.e.*, first to use has superior rights
3. Likelihood of confusion
 - *I.e.*, *Sleekcraft*, *DuPont*, *Polaroid* factors
 - Sound familiar?



Taco Cabana v. Two Pesos

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Two Pesos v. Taco Cabana

- Taco Cabana's trade dress = shape and general appearance of exterior of restaurant, identifying sign, interior kitchen floor plan, décor, menu, equipment used to serve food, servers' uniforms, and other features reflecting total image of the restaurant

Two Pesos v. Taco Cabana



Taco
Cabana



Two
Pesos

Two Pesos v. Taco Cabana



Taco Cabana's old look

Two Pesos v. Taco Cabana



Taco Cabana after *Two Pesos*



Wal-Mart v. Samara Brothers

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Wal-Mart v. Samara Brothers



**SAMARA
BABY GAP**



**SAMARA-style
DISNEY**



Wal-Mart v. Samara Brothers

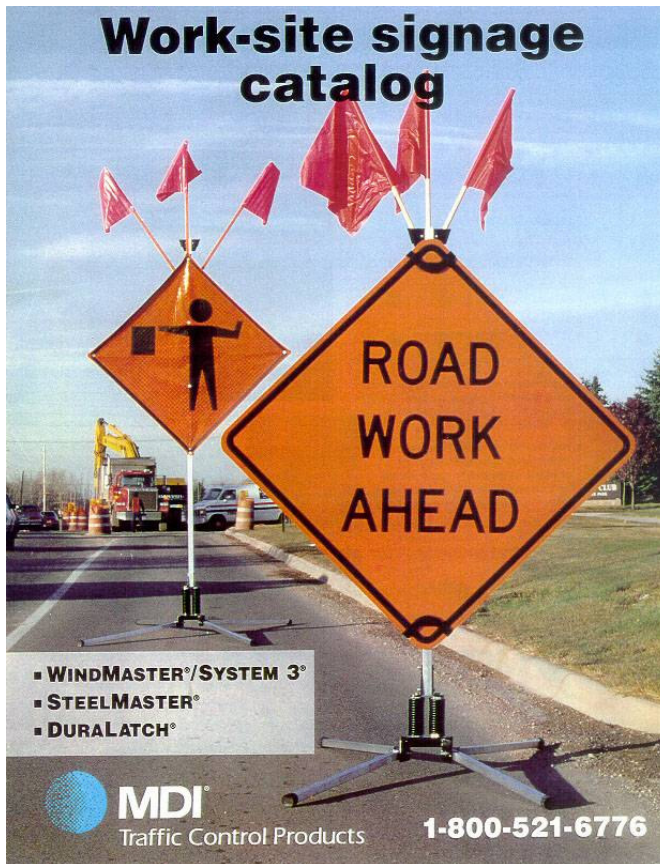
- Held: product design protectable only if becomes distinctive through secondary meaning
- Copyright or design patent available to protect producer of design trade dress who can't show secondary meaning
- Distinguished from *Taco Cabana* b/c restaurant trade dress more like traditionally-protected product packaging
- In close cases, courts err on side of categorizing trade dress as product design, requiring secondary meaning



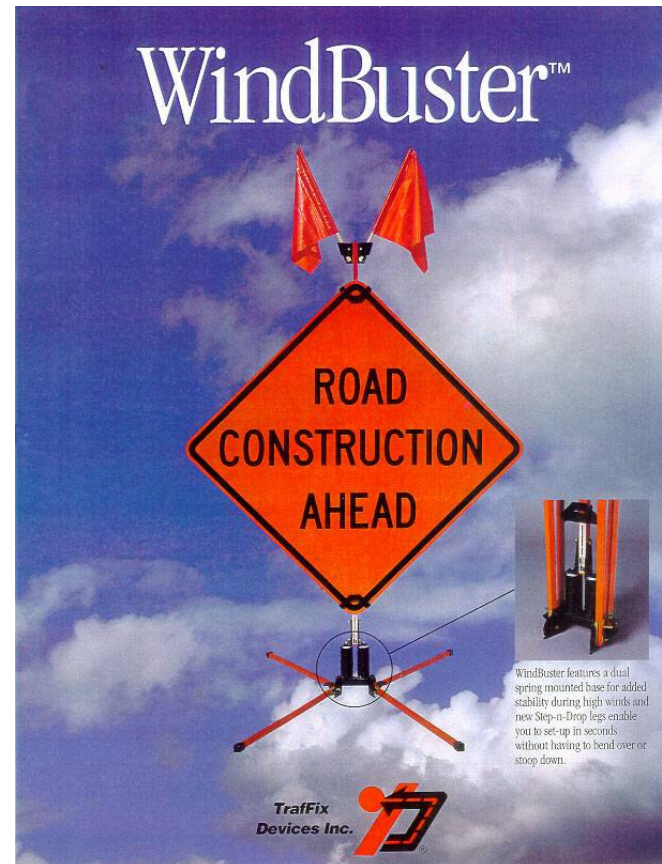
*TraFFix Devices v. Marketing
Displays*

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TraFFix v. Marketing Displays



Marketing Displays

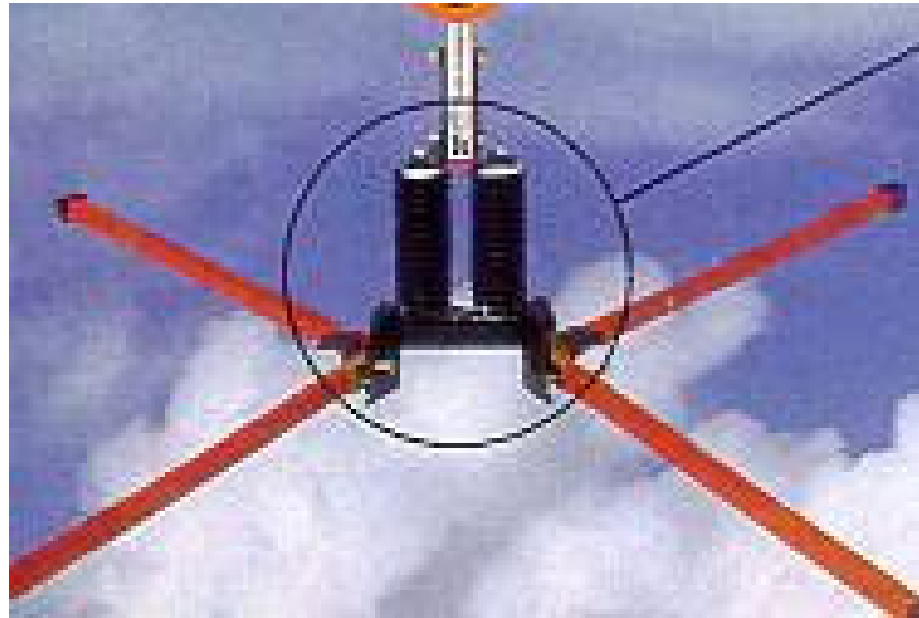


TraFFix

TraFFix v. Marketing Displays



Marketing Displays



TraFFix



Traffix v. Marketing Displays

- Utility patent expired and competitor started selling signs with visible spring mechanism
 - Where else have we seen this happen?
- Utility patent = strong evidence that trade dress is functional
- Dual springs functional b/c keep sign upright in heavy wind conditions



HI Limited v. Winghouse

HI Limited v. Winghouse



HI Ltd/Hooters



Winghouse

Trade dress infringement?



Burck ("Naked Cowboy") v. Mars, Inc.

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Trade dress infringement?



RDF v. Fox, 372 F.Supp.2d 556 (C.D. Calif. 2005)



Thank you!

Any questions?