

Trade Dress Rehearsal: Perfecting Your Trade Dress Practice

Presented to:

Alt Legal

By:

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Agenda

- Trade Dress Introduction
- Trade Dress Legal Issues
 - *TrafFix* and Other S. Ct. TD Precedents
 - Recent TD Decisions
- Navigating Trade Dress Vulnerabilities



Trade Dress Introduction

Trade Dress
Introduction

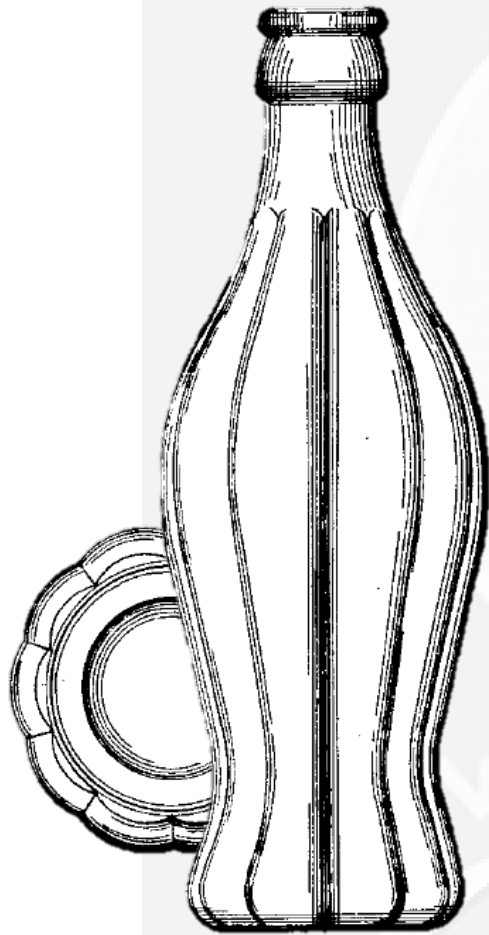
What is Trade Dress?

Trade dress comprises the features of the visual appearance of a product/service or its packaging that indicate the source of the product/service to consumers

Examples

Examples

Coca-Cola



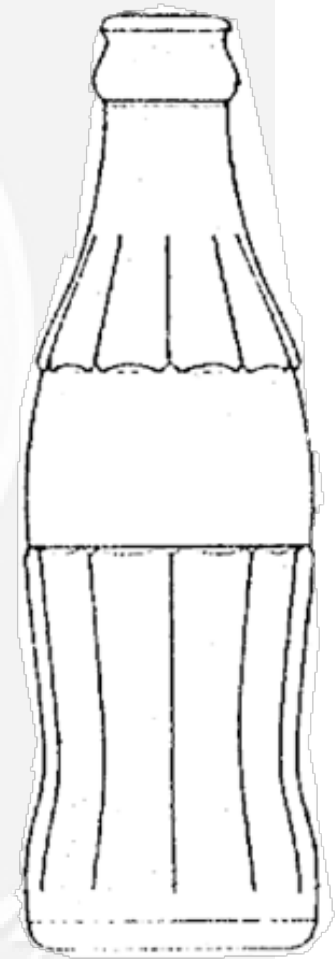
U.S. Pat. No. D48160
Issued Nov. 16, 1915
Expired Nov. 16, 1929



U.S. Reg. No. 2085197
First Use: July 8, 1916
Registered: Aug. 5, 1997

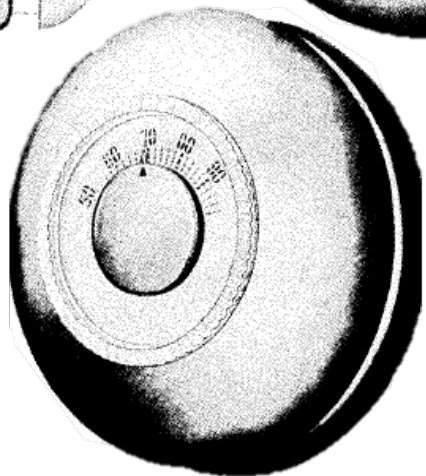
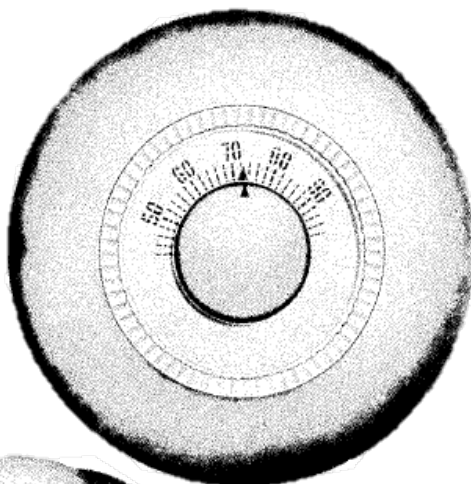
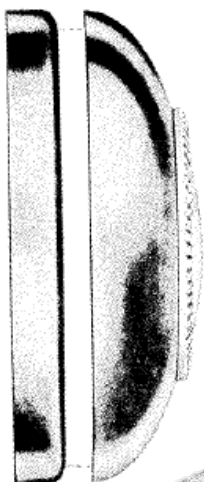


U.S. Reg. No. 2155915
First Use: July 8, 1916
Registered: May 12, 1998



U.S. Reg. No. 1057884
First Use: July 8, 1916
Registered: Feb. 1, 1977

Honeywell



U.S. Pat. No. D176657
Issued Jan. 17, 1956
Expired Jan. 17, 1970

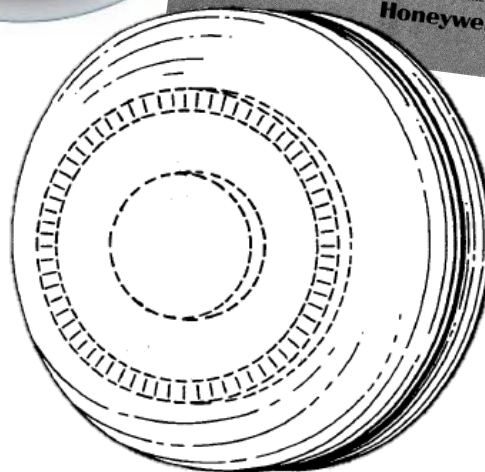
REACH FOR THE GOLD!
THREE WAYS YOU'LL COME OUT A WINNER IN 1984.

WIN A FREE TRIP TO THE OLYMPICS!
When you install a Honeywell T87 Round, you get a chance to take part in a worldwide measure of excellence. The 1984 Olympic stakes. You could win an all-expense paid trip for two to the Summer Games in Los Angeles (July 31 to August 3). You'll fly you to the Olympics and Sports Illustrated. You'll enjoy accommodations aboard the luxury Norwegian cruise liner Sagafjord, and have tickets to the Games.
Three trips will be awarded. Go watch your mail or ask your participating wholesaler for an official entry blank. And mail it before June 1, 1984. There's nothing to buy.

GET A FREE ROUND DESK MEDALLION
Buy 12 T87 Round thermostats between February 15 and June 1, 1984, and get a free Honeywell Round commemorative desk medallion. These heavyweight, limited-edition medallions are sure to become collectors' items.
Watch your mail for details of the offer, or ask your participating TRADELINE wholesaler.

SELL THE WORLD'S MOST POPULAR THERMOSTAT
Install the T87 Round. Its accuracy, styling, legendary thermostatic quality, and reliability make it THE symbol of the Olympics is THE symbol of quality in climate.
This Gold in '84, enter our "Reach for the Gold" Sweepstakes, get your free commemorative medallion when you buy 12 Rounds, and see the world leader.
Honeywell. Any way you go, you win!

Together, we can find the answers.
Honeywell



U.S. Reg. No. 1622108
First Use: 1952
Registered: Nov. 13, 1990

US Reg. No. 6,368,694 for “Footwear” Cl. 25

- First Use: 4/1985
- Filed: 7/31/2020
- Registered: 6/1/2021



Trade Dress Identifies



Trade Dress Differentiates



Trade Dress Differentiates



Proving Trade Dress Infringement

TD Infringement Proof (Unregistered Product Design TD)

TD owner must show that TD is
“(1) nonfunctional,
(2) has acquired secondary
meaning, and
(3) is confusingly similar to the
allegedly infringing product design.”

DayCab Co., Inc. v. Prairie Tech., LLC, 67 F.4th 837 (6th Cir. 2023)

TD Infringement: Burden of Production *Generally*

	Unregistered	Registered	Incontestable
Distinctive	Owner	Infringer	Can't Challenge (<i>Park 'n Fly</i>)
Nonfunctional	Owner	Infringer	Infringer
Infringed	Owner	Owner	Owner

TD Infringement: Distinctive: Burden of Production

	Unregistered	Registered	Incontestable
Distinctive	Owner	Infringer	Can't Challenge (<i>Park 'n Fly</i>)

- Registration is *prima facie* evidence...
- ...but *prima facie* of what, and how does that shift the burden of proof?
see "The Fog and Art of War," Charles Cook and Ted Davis, 103 TMR 438 (2013)
- *Park 'n Fly* predates big TD cases

Trade Dress/ Other IP Rights Comparison

Overlapping Rights

Utility Patents

Design Patents



Copyright

Trade Dress

Trade Secret

Main US Design Rights: Term, Requirements, Infringement

	Term	Design Requirements	Infringement Assessment
Design Patent	15 years from Issuance	New (Novel/Nonobvious) Original Ornamental For article of manufacture Sufficient disclosure	Construe claim Substantially the same to ordinary observer, in view of the prior art
Copyright	A long time (e.g., life of author + 70 years)	Original Fixed in a tangible medium Design is separable (useful article)	Substantial similarity Actual copying
Trade Dress	Until no longer used in commerce (∞?)	Use in commerce (intent) “Device” Distinctive Nonfunctional Operates as a Mark	Likelihood of confusion factors

Primary US Design Rights: \$ Remedies

\$ Remedies

Design
Patent

Standard utility patent damages:

Π 's lost profits/no less than reasonable royalty, willfulness, attorney fees in exceptional cases

Or else: disgorgement of Δ 's "total" profit

Copyright

Π 's actual damages, and any additional Δ profits,

Or else: statutory damages, including willfulness

Also, "prevailing party" attorney fees

Trade
Dress

Π 's lost profits, and any additional Δ profits,

willfulness, attorney fees in exceptional cases



Trade Dress Legal Requirements

Trade Dress
Legal Requirements

Is the Trade Dress
a “Device”?

Qualitex v. Jacobson Prods. 514 U.S. 159 (1995)

Int. Cl.: 7

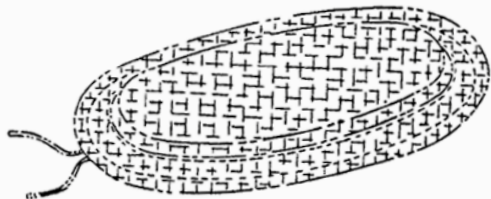
Prior U.S. Cl.: 23

United States Patent and Trademark Office

Reg. No. 1,633,711

Registered Feb. 5, 1991

**TRADEMARK
PRINCIPAL REGISTER**



QUALITEX COMPANY (ILLINOIS CORPORATION)
4248 NORTH ELSTON AVENUE
CHICAGO, IL 60618

FOR: MACHINE PARTS; NAMELY, PRESS PADS AND COVERS FOR PRESS PADS FOR COMMERCIAL AND INDUSTRIAL PRESSES, IN CLASS 7 (U.S. CL. 23).

FIRST USE 11-21-1957; IN COMMERCE 11-21-1957.

THE DRAWING IS LINED FOR THE COLOR GOLD.

THE MARK CONSISTS OF A PARTICULAR SHADE OF GREEN-GOLD APPLIED TO THE TOP AND SIDE SURFACES OF THE GOODS. THE REPRESENTATION OF THE GOODS SHOWN IN PHANTOM LINING NOT A PART OF THE MARK AND SERVES ONLY TO INDICATE POSITION.

SEC. 2(F).

SER. NO. 74-013,732; FILED 12-26-1989.

DAVID H. STINE, EXAMINING ATTORNEY


Registered



For
**Press
Pads**

CANCEL

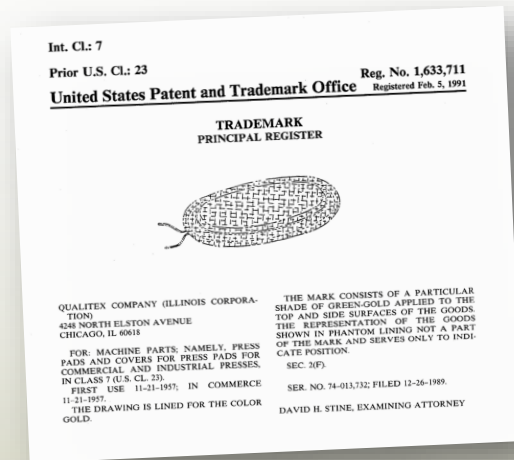
REGISTRATION?

Qualitex v. Jacobson Prods. 514 U.S. 159 (1995)

- Lanham Act describes universe of TMs in “broadest of terms”: “any word, name, symbol, or device, or any combination thereof.” § 1127
- “Symbol” or “device” mean “almost anything at all that is capable of carrying meaning,” so not restrictive.
- Almost no eligibility limits under US law

Qualitex: Aesthetic Functionality (?)

- Jacobson argued that “color depletion” should bar registration
- But that’s an “occasional problem to justify a blanket prohibition.”
- An earlier S. Ct. case hints at aesthetic functionality in *dicta*
- Appellate courts have opined too
- But the doctrine’s still amorphous



Is the Trade
Dress Distinctive?

Two Pesos v. Cabana 505 U.S. 763 (1992)



“a festive eating atmosphere having interior dining and patio areas decorated with artifacts, bright colors, paintings and murals.

The patio includes interior and exterior areas with the interior patio capable of being sealed off from the outside patio by overhead garage doors.

The stepped exterior of the building is a festive and vivid color scheme using top border paint and neon stripes.

Bright awnings and umbrellas continue the theme”

Trade Dress Description in First Amended Complaint

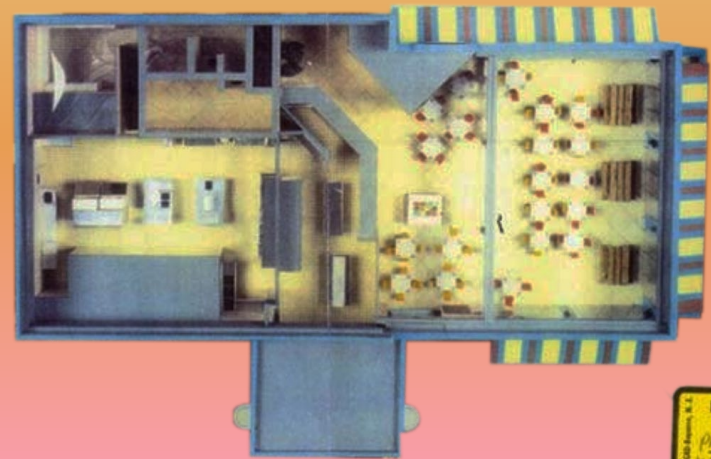


Two Pesos, the S. Ct. and Distinctiveness

- Trade dress is a Lanham Act “Device” (*Two Pesos* predates *Qualitex*)
- Trade dress is for goods *and* services
- Unregistered trade dress can be inherently distinctive (holding)



Two Pesos v. Taco Cabana 505 U.S. 763 (1992)



Taco Cabana

Two Pesos

INFRINGES

Wal-Mart v. Samara 529 U.S. 205 (2000)



Samara
Dress



Wal-Mart
Dress

Wal-Mart v. Samara 529 U.S. 205 (2000)

- *Qualitex* held that, for color, “no mark can ever be inherently distinctive”
- Product design should also never be inherently distinctive
- While *Two Pesos* “unquestionably establishes” that trade dress can be inherently distinctive, that was product packaging not product design trade dress
- Categorize ambiguous trade dress (e.g., cola bottle) as product design



Samara
Dress



Wal-Mart
Dress

US TD Distinctiveness: Owner's "Heavy" Burden of Proof

	Unregistered	Registered	Incontestable
Product Design, Color, or Ambiguous	Secondary Meaning	Secondary Meaning, But Registration is <i>Prima Facie</i> Evidence	None (Registration is Conclusive Evidence).
Product Packaging	Inherent Distinctiveness or Secondary Meaning	Inherent Distinctiveness (at least if not 2(f)) else Secondary Meaning, but Registration is <i>Prima Facie</i> Evidence	Can't Challenge Distinctiveness (<i>Park 'n Fly</i>)

Is the Trade
Dress Functional?

Functionality in the Lanham Act

- Registration shall not be refused unless the mark “comprises any matter that, as a whole, is functional.” § 2(e)(5)
- Registration shall not preclude an infringer from “proving any legal or equitable defense or defect ... which might have been asserted if such mark had not been registered.” § 33(a), *see also* § 33(b)(8)
- For unregistered trade dress infringement, the trademark owner “has the burden of proving that the matter sought to be protected is not functional.” § 43(a)(3)

Primary US Design Rights: Functionality

Functionality Attacks

Design Patent

The design is dictated by function.

Functional parts should be disregarded.

Copyright

Functional and ornamental aspects are not separable.

Trade Dress

The design, or features thereof:
Are essential to use or purpose, or
affect cost or quality.

Protection would result in a significant
non-reputation related disadvantage.

Singer Mfg. v. June Mfg. 163 U.S. 169 (1896)



Singer Machine



June Machine

Singer Mfg. v. June Mfg. 163 U.S. 169 (1896)

“... on the termination of the patent there passes to the public the right to make the machine in the form in which it was constructed during the patent. We may therefore dismiss without further comment the complaint as to the **form** in which the defendant made his machines.”



Patent Model for First Singer Patent, 8294

Singer Mfg. v. June Mfg. 163 U.S. 169 (1896)

But passing
off was still
found based
on cringey
facts



Kellogg v. Nat'l Biscuit 305 U.S. 111 (1938)

“Kellogg Company was free to use the pillow-shaped form, subject only to the obligation to identify its product lest it be mistaken for that of the plaintiff.” *Id.* at 120.



1933 National Biscuit Packaging



1930s Kellogg's Packaging

Inwood Labs. v. Ives Labs. 456 U.S. 844 (1982)

- Ives copied pill colors after patent expiration
- District court found colors to be functional,
- but 2d Cir. reversed
- Really about appellate review, but footnote 10 endures...



Ives*



Inwood*

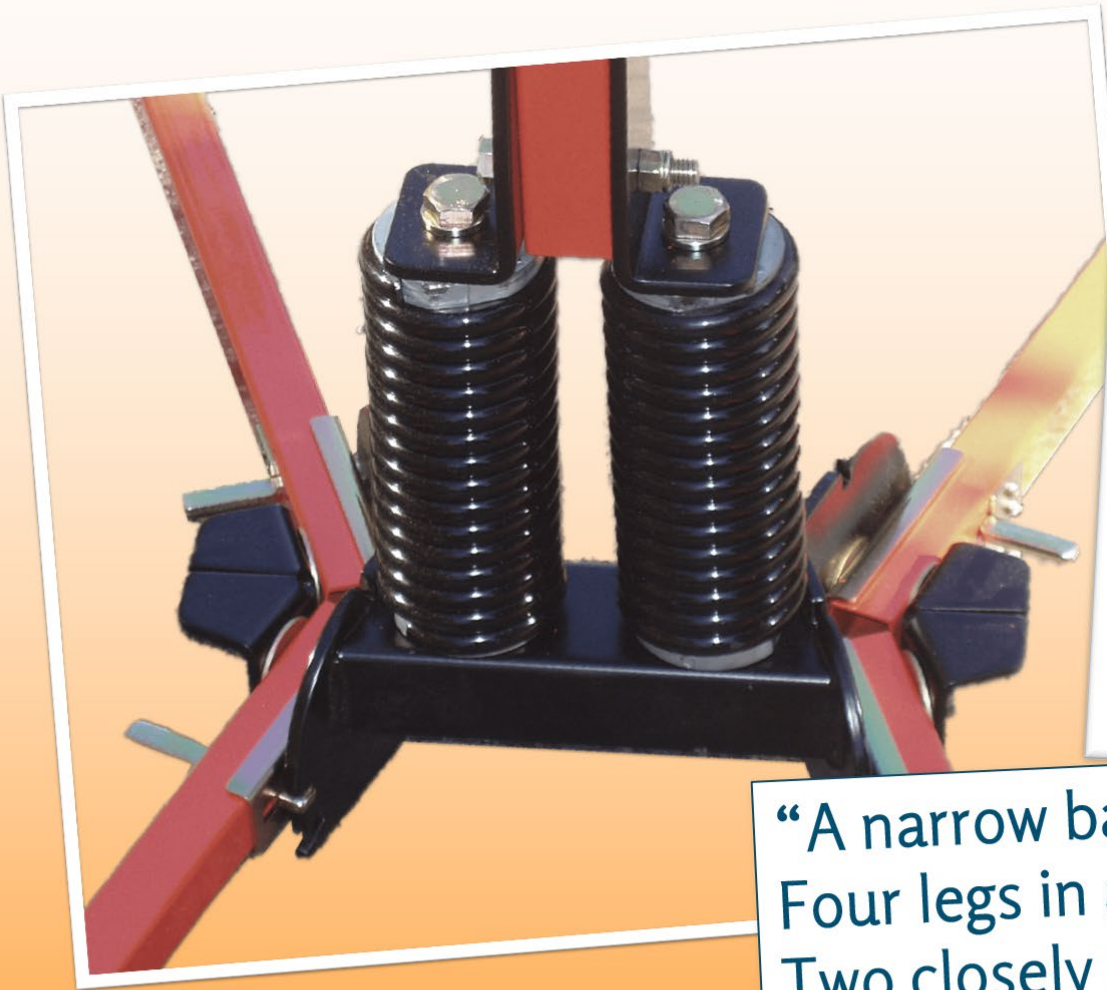
(* simulated trade dress)

Inwood Labs. v. Ives Labs. 456 U.S. 844 (1982)

10. In general terms, a product feature is functional if it is essential to the use or purpose of the article or if it affects the cost or quality of the article. See *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 232, 84 S.Ct. 784, 789, 11 L.Ed.2d 661 (1964); *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 122, 59 S.Ct. 109, 115, 83 L.Ed. 73 (1938).

TraFFix Devices v. Marketing

532 U.S. 23 (2001)



“A narrow base;
Four legs in an X-shape configuration;
Two closely spaced coil springs;
A single upright, for holding a sign; and
A traffic-type sign”

Morton-Norwich Functionality Factors

1. utility patent that discloses the utilitarian advantages of the design sought to be registered;
2. advertising touting the utilitarian advantages of the design;
3. availability of alternative designs; and
4. whether the design results from a comparatively simple or inexpensive method of manufacture

Conclusion: **FUNCTIONAL**

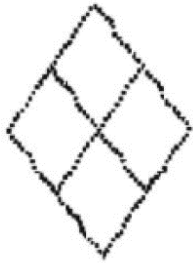
Traffix: Singer-type Election Unresolved

“Traffix and some of its amici argue that the Patent Clause of the Constitution, Art. I, § 8, cl. 8, of its own force, prohibits the holder of an expired utility patent from claiming trade dress protection. We need not resolve this question.” *Id.* at 35.

Georgia-Pacific v. Kimberly-Clark

647 F.3d 723 (7th Cir. 2011)

- SJ of Invalidity of 4 Incontestable TM Registrations **Affirmed**

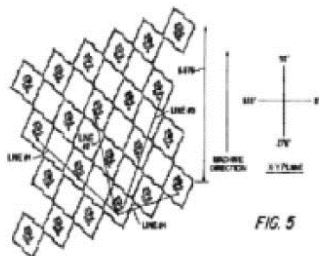
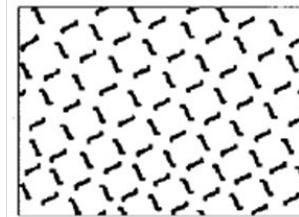


Reg. No. 2,710,741

Reg. No. 1,778,352

Reg. No. 1,806,076

Reg. No. 1,979,345



'057, '156, and '639 patents

'776 and '830 patents

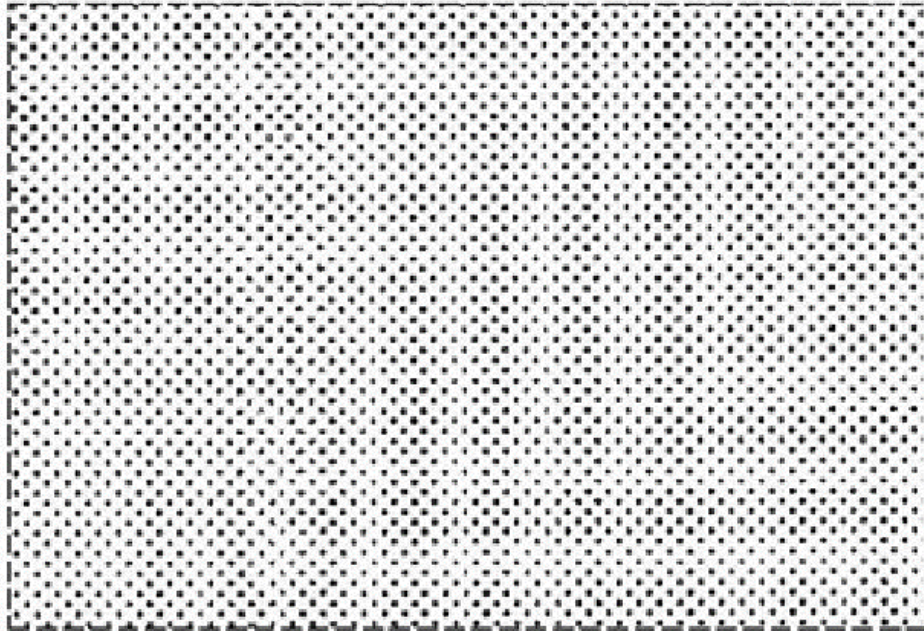
Georgia-Pacific Lattice Designs

“COTTONELLE” &
“SCOTT” Accused
Products

McAirlaids v. Kimberly-Clark

756 F.3d 307 (4th Cir. 2014)

- SJ of Invalidity of TM Registration
Reversed

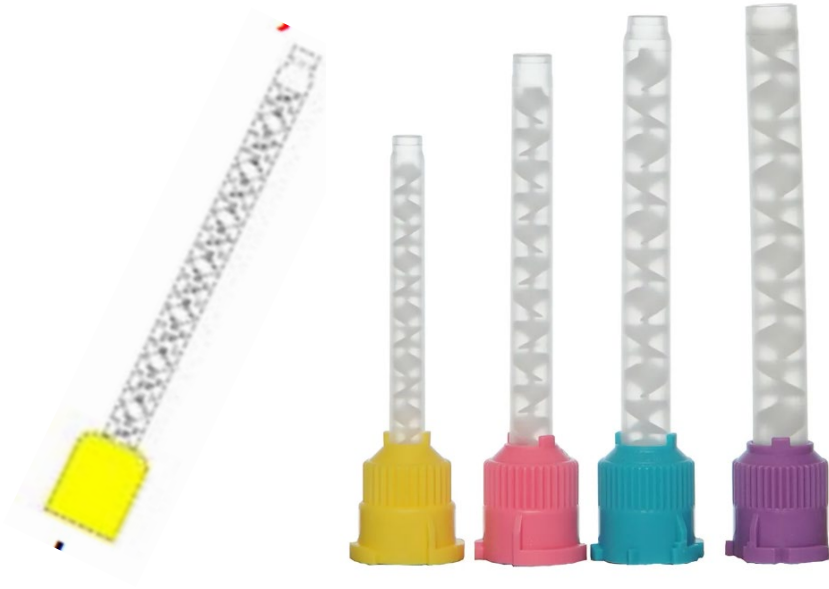


McAirlaids Reg. No. 4104123



“GOODNITES” Accused Product

Sulzer Mixpac v. A&N Trading 988 F.3d 174 (2d Cir. Feb. 18, 2021)



4674109 Registered 2015
First Used 1997
2(f)

Accused
Product

Ezaki Glico v. Lotte 986 F.3d 250 (3d Cir. Mar. 10, 2021)



1527208

Registered 1989
First Used 1978
2(f)/Incontestable

Accused
Product

Ezaki: 3d Circuit Decision

- Lanham Act does not define functionality

- Dictionary definition of “functional”:

“designed or developed chiefly from the point of view of use: UTILITARIAN.”

Webster's Third New International Dictionary (1966).

- Thus, “a feature’s particular design is functional if it is useful.”

Ezaki Glico, 986 F.3d 250 at 255

PIM Brands v. Haribo 81 F.3d 317 (Sept. 13, 2023)

- Shape and color features only have single function: convey flavor
- Unlike *Ezaki* features, which had multiple functions
- Here, do not need to analyze each feature



PIM

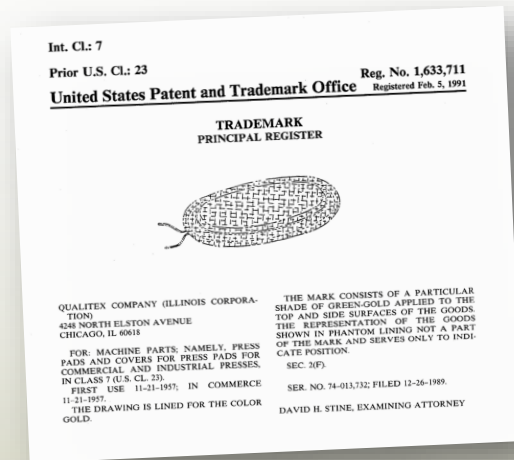


Haribo

Aesthetic Functionality

Qualitex: Aesthetic Functionality...Sort of

- Jacobson argued that “color depletion” should bar registration
- But that’s an “occasional problem to justify a blanket prohibition.”
- *Inwood* hinted at aesthetic functionality in *dicta*
- Appellate courts have opined too
- But the doctrine’s still amorphous



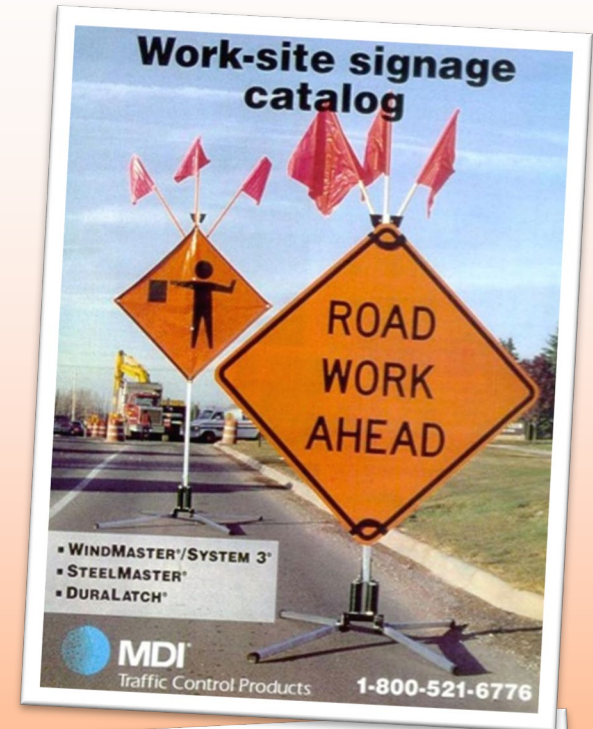
Traffix: What Else Does “Functional” Mean?

- “Traditional Rule” of Functionality:
“In general terms a product feature is functional,’ and cannot serve as a trademark, ‘if it is essential to the use or purpose of the article or if it affects the cost or quality of the article.’”

Traffix(quoting *Qualitex*(quoting *Inwood Labs.*))

- “This Court has expanded on that meaning, observing that a functional feature is one ‘the exclusive use of [which] would put competitors at a significant non-reputation-related disadvantage.’”

Traffix(quoting *Qualitex*)

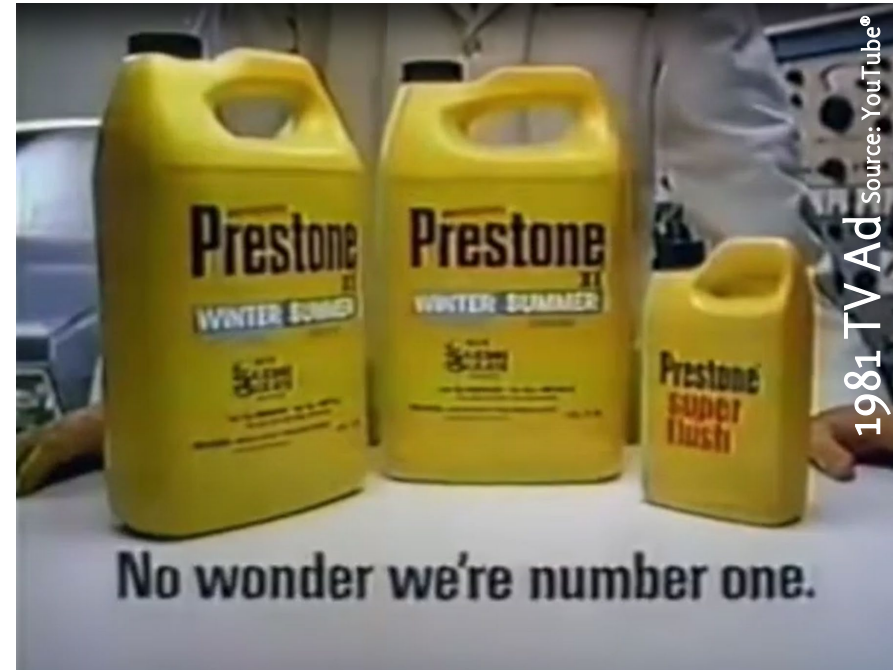


First Brands v. Fred Meyer

809 F.2d 1378 (9th Cir. 1987)

For preliminary injunction, not abuse of discretion to conclude “that if Carbide were granted protection of its PRESTONE II trade dress, it would in effect be getting a trademark on the color yellow as a background color for an ordinary-shaped container.”

Id. at 1383-84



Louboutin v. Yves St. Laurent, 696 F.3d 206 (2d Cir. 2012)

Christian Louboutin



Dated:

03/14/2007



S.A. Christian L
au capital d
19, rue Jean-Ja
7500

Tél. :

2 36 08 50



Does the Trade
Dress Operate as
Source Identifier?

Failure to *Operate* as a Mark

- Mere ornamentation does not identify and distinguish goods, and thus fails to operate as a trademark
- Mere ornamentation may include words, slogans, designs, or other trade dress
- USPTO may refuse registration of mere ornamentation under §§ 1, 2, and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052, and 1127

LTTB v. Redbubble 840 Fed. Appx. 148 (9th Cir. 2021)

“LTTB's marks do not function as trademarks because they are aesthetic only and do not identify the source of the goods.” *Id.* at 152.





Navigating Vulnerabilities

Navigating
Vulnerabilities

Strategies: Monitor Growing Defenses

- Failure to Operate

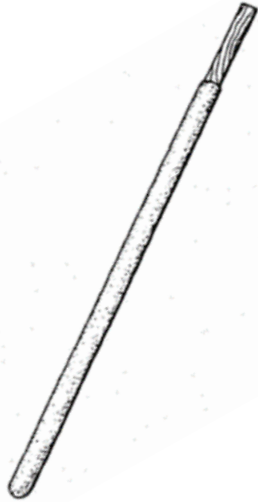
See Trademark Failure to Function, Prof. Alexandra Roberts, Iowa Law Review (2017)

- Aesthetic Functionality

(particularly, significant colors in certain industries)

- Election Doctrine

Strategies: Functionality: 3d Circuit



1527208

Registered 1989
First Used 1978
2(f)/Incontestable



5029701

Registered 2016
First Used 2003
2(f)/Incontestable

Functional = Useful

Strategies: Functionality

- (Third Circuit)
- Incontestability Will Never Save You
- Argue for consideration of all *Morton-Norwich* factors
- Consider Supplemental Protection (*e.g.*, design patents if new)

Strategies: Try to Register

	Unregistered	Registered	Incontestable
Distinctive	Owner	Infringer	Can't Challenge <i>(Park 'n Fly)</i>
Nonfunctional	Owner	Infringer	Infringer
Infringed	Owner	Owner	Owner

- And counter function dissection...

TBL Licensing v. Vidal 98 F.4th 500 (4th Cir. April 15, 2024)

- Functionality across 8 elements: collar, two-tone sole, lug soles, hourglass heel counter, quad stitching, shape of the vamp stitching, hexagonal eyelets, and bulbous toe box
- 2 *Morton-Norwich* factors removed
- 4th Circuit just ruled on secondary meaning





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