



ON RED-HAIRED WAITRESSES, SHAKESPEARE, AND PRODUCT  
CONFIGURATION: A RESPONSE TO JUSTICE STEVENS

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Abstract

Justice John Paul Stevens' Inaugural Lecture in Trademark Law honoring Beverly Pattishall truly is a memorable read. Justice Stevens has provided a clear rationale for the Supreme Court's most recent line of trade dress cases that most thought impossible. In fact, most have not even thought that there was a rationale, let alone a clear one, to a line of cases where the Court seems to be straining to balance the competing interests in American trademark jurisprudence. Rather than the arbitrary conclusion reached by the Supreme Court in distinguishing product configuration from product packaging, most commentators have recommended a more flexible approach. The common thread in this scholarship is that trade dress protection should be afforded manufactures but on a consistent basis without favoring one type of trade dress over another. A few commentators have argued that no trade dress should be subject to protection without secondary meaning. These commentators suggest that courts have rushed into the current scheme of protection without thoroughly considering all of the likely effects on the marketplace as well as on creativity. The real struggle that the Court seems to be facing is the intersection between patent law and policy and trade dress law and policy. Fear of granting patent-like rights to trade dress claimants in perpetuity may explain the Supreme Court's trade dress jurisprudence.

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## ON RED-HAIRED WAITRESSES, SHAKESPEARE, AND PRODUCT CONFIGURATION: A RESPONSE TO JUSTICE STEVENS

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Justice John Paul Stevens' Inaugural Lecture in Trademark Law honoring Beverly Pattishall truly is a memorable read. All references to waitresses with red hair, Shakespeare and whether a rose would be as sweet smelling if by any other name, and the title of this comment notwithstanding, Justice Stevens has provided a clear rationale for the Supreme Court's most recent line of trade dress cases that most thought impossible.<sup>1</sup> In fact, most have not even thought that there was a rationale, let alone a clear one, to a line of cases where the Court seems to be straining to balance the competing interests in American trademark jurisprudence. The objectives of the American trademark system are to protect the consumer from confusion as to the source of goods or services, to protect the goodwill of the trademark owner, and to provide a system where market entry or expansion is not unduly difficult so that third parties might be able to compete.<sup>2</sup> Balancing these three objectives, which themselves are in competition with one another, has been a formidable task.

Justice Stevens' rationale for the line of trade dress cases generated by the Supreme Court in the last decade is easily stated: sound judicial reasoning based on utilitarian common sense provides adequate delineation of rights rather than statutory text.<sup>3</sup> To reach this conclusion, Justice Stevens reviews the Court's four most recent decisions regarding trade dress law, *Traffix*,<sup>4</sup> *Wal-Mart*,<sup>5</sup> *Qualitex*,<sup>6</sup> and *Two Pesos*.<sup>7</sup> Justice Stevens eloquently places these four cases in the context of the search for Shakespeare's true identity, his father's restaurant where some servers had red hair, and whether names, in and of themselves, mean something. Justice Stevens concludes that the current status of the Supreme Court's jurisprudence on trade dress protection is sound.<sup>8</sup> The current status is that product configuration trade dress may never be inherently distinctive but product packaging trade dress may be.

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<sup>1</sup> John Paul Stevens, *Section 43(A) of the Shakespeare Canon of Statutory Construction*, 1 J. MARSHALL REV. INTELL. PROP. L. 179 (2002).

<sup>2</sup> 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 2:2, at 2-2 (4th ed. 1999).

<sup>3</sup> See Stevens, *supra* note 1.

<sup>4</sup> *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23 (2001) (finding that Traffix had failed to show non-functionality of its dual-spring stand design precluding trade dress protection where the design at issue had been the subject of a utility patent).

<sup>5</sup> *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205 (2000) (holding that for unregistered trade dress to be protected under section 43(a) of the Lanham Act, proof of secondary meaning to show distinctiveness is required).

<sup>6</sup> *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159 (1995) (holding that a color may qualify for registration as a trademark if it has secondary meaning).

<sup>7</sup> *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992) (holding that trade dress that is inherently distinctive is protectable under section 43(a) without a showing that it has acquired secondary meaning).

<sup>8</sup> See Stevens, *supra* note 1, at 183-87.

Although a very interesting read, Justice Stevens has avoided mention of the rather well developed legal scholarship that surrounds and permeates the issue of when, if ever, trade dress could be protectable if it lacks secondary meaning.<sup>9</sup> The point of this brief comment is to show that this scholarship has much to teach the Court. I encourage Justice Stevens and other judges to consider this type of scholarship in the future when they consider cases outside of the scope of their expertise.<sup>10</sup> I suspect that this scholarship, if taken seriously, could inform this debate, perhaps, more than Shakespeare, the sweet smell of roses, or the color of waitresses' hair. After all, the fundamental doctrine established by the Supreme Court remains unchanged: trademark protection is available for appellations of source to the extent the appellation is used and for as long as it is used.<sup>11</sup> That is, unless Shakespeare's rose or the hair color of employees working at Justice Stevens' father's restaurant indicate the source or origin of some good or service in the minds of the relevant purchasing public, there is no trademark worth protecting.

The question unanswered by the four cases and Justices Stevens' speech is would the smell of a rose (or the hair color of waitresses) be product packaging and thus protectable if inherently distinctive without secondary meaning, or product configuration which is not protectable even if inherently distinctive without secondary meaning? Given the amount of press this issue has received in the academic literature<sup>12</sup> and the number of cases the Supreme Court has heard on this issue in the last decade, one would expect the actual number of cases to be rather capacious. This apparently is not the case. That is, in the last decade, since *Two Pesos*, there have been fifty-one trade dress

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<sup>9</sup> Another issue not addressed by Justice Stevens and one too complicated for this brief comment is the inter-connectivity of patent law and policy with trade dress law and policy. In the end, the issue for much trade dress protection is that it may have been the subject of an expired utility patent or may have been patentable at one time. If granted trade dress protection, society would potentially be giving the trade dress the equivalent of perpetual patent protection, far exceeding the policy behind the patent statute.

<sup>10</sup> To be fair, Justice Stevens' concurrence in *Two Pesos*, however, is the only place in the four cases where any one of the Justices cites academic literature. 505 U.S. at 776-86 (Stevens, J., concurring in the judgment).

<sup>11</sup> Section 45 of the Lanham Act provides that a "trademark" includes any word, name, symbol, or device, or combination thereof . . . used by a person, . . . to identify and distinguish his or her goods." 15 U.S.C. § 1127 (2000); see also MCCARTHY, *supra* note 2, § 3:1, at 3:1 (providing that both the common law and federal law follow the federal Lanham Act definition).

<sup>12</sup> A search of the LEXIS database "Law Reviews, Combined" on Feb. 22, 2002 revealed that *Traffix* had been cited 12 times, *Wal-Mart* 48 times, *Qualitex* 238 times, and *Two Pesos* 350 times. Obviously, not every cite is substantive, but these cases have certainly grabbed the attention of academic commentators. Specifically, some commentators describe the growth of trade dress law as an "explosion." Mark A. Lemley, *The Modern Lanham Act and the Death of Common Sense*, 108 YALE L.J. 1687, 1700-01 (1999).

In the last fifteen years, product configuration cases have exploded onto the trademark scene. Companies have successfully claimed trademark rights in the decor of a restaurant, an artistic style of painting, the design of a golf course, the shape of a faucet handle, the diamond shape of a lollipop, the unique registration process of a toy fair, the shape of a mixer, and the design of personal organizers, and they have sought protection for sweater patterns, the shape of troll dolls, the shape of a building, the helical blade of fans, the shape of cable ties, and the shape of Grecian-urn-style plastic planters. Some plaintiffs have even succeeded in protecting as product configurations the very features of their products for which they had previously received a patent.

*Id.* (footnotes omitted).

cases argued before United States district or appellate courts.<sup>13</sup> Eighteen cases were brought alleging some product packaging was valid and infringed.<sup>14</sup> Of those eighteen cases, five cases found the product packaging trade dress to be valid and infringed.<sup>15</sup> Product configuration cases were almost twice as popular. In the same time period, United States district or appellate courts heard thirty-three configuration cases.<sup>16</sup> Of those thirty-three cases, the court found the product configuration valid and infringed in eight cases.<sup>17</sup>

Interestingly enough, of the trade dress cases appealed to the United States Courts of Appeals, four of those cases were granted certiorari by the Supreme Court and were the subject of extensive opinions.<sup>18</sup> This data makes one wonder what it is about trade dress protection that makes it the subject of such scrutiny by the Supreme Court.

The real focal point of most of this commentary is whether trade dress can be inherently distinctive and, if so, what the test for inherently distinctive trade dress ought to be. Graeme Dinwoodie, in a 1997 article, criticized at some length the notion of different legal tests for inherently distinctive trade dress based upon some distinction between packaging and design.<sup>19</sup> Dinwoodie argued as follows:

The distinction between “packaging” and “product design,” central to these new tests, rests on questionable foundations. The arguments advanced by the Second and Third Circuits in support of a different test for each category of trade dress are either irrelevant to the distinctiveness question (in the case of competitive concerns) or reflect inappropriate generalizations of what are highly fact-specific questions concerning likely consumer behavior. The rationale for a stricter test for product design is circular, encourages arbitrariness and incertitude by introducing difficult questions of classification, and may prejudice the

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<sup>13</sup> The fifty-one case total is reached by adding the eighteen product packaging cases, *infra*, note 14, with the product configuration cases, *infra*, note 16.

<sup>14</sup> A search of the LEXIS database “Circuit Court Cases—By Circuit, Combined Sources 4” on Feb. 22, 2002 with the search terms “product packaging w/5 infringe!” netted eighteen cases.

<sup>15</sup> In five cases, the court found that the product packaging trade dress was valid and infringed. *See* Sara Lee Corp. v. Kayser Roth Corp., 81 F.3d 455 (4th Cir. 1996); Empire Indus. v. Tony (U.S.A.), Inc., No. 98 C 1416, 1998 U.S. Dist. LEXIS 10904 (N.D. Ill. July 13, 1998); Bodylines Inc. v. E. Mishan & Sons Inc., No. C 97-01572 VRW, 1997 U.S. Dist. LEXIS 23126 (N.D. Cal. May 28, 1997); Winning Ways v. Holloway Sportswear, 903 F. Supp. 1457 (D. Kan. 1995); Health O Meter v. Terraillon Corp., 873 F. Supp. 1160 (N.D. Ill. 1995).

<sup>16</sup> A search of the LEXIS database “Circuit Court Cases—By Circuit, Combined Sources 4” on Feb. 22, 2002 with the search terms “product configuration w/5 infringe!” netted thirty-three cases.

<sup>17</sup> In eight cases, the court found the product configuration valid and infringed. *See* Sunbeam Prods. v. W. Bend Co., 123 F.3d 246 (5th Cir. 1997); Libbey Glass, Inc. v. Oneida, 61 F. Supp. 2d 700 (N.D. Ohio 1999); SNA, Inc. v. Array, 51 F. Supp. 2d 554 (E.D. Pa. 1999); Stoneworks, Inc. v. Empire Marble & Granite, Inc., CASE NO. 98-2017-CIV-HIGHSMITH, 1998 U.S. Dist. LEXIS 21762 (S.D. Fla. November 20, 1998); Severin Montres, Ltd. v. Yidah Watch Co., 997 F. Supp. 1262 (C.D. Cal. 1997); Decor Grates v. Fararo, File NO. 92 C 6395, 1997 U.S. Dist. LEXIS 3328 (N.D. Ill. March 13, 1997); Zip Dee, Inc. v. Dometic Corp. 931 F. Supp. 602 (N.D. Ill. 1996); Health O Meter v. Terraillon Corp., 873 F. Supp. 1160 (N.D. Ill. 1995).

<sup>18</sup> *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23 (2001); *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205 (2000); *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159 (1995); *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992).

<sup>19</sup> Graeme B. Dinwoodie, *Reconceptualizing the Inherent Distinctiveness of Product Design Trade Dress*, 75 N.C. L. REV. 471, 604-05 (1997).

issue of likely association. That product designs currently are less likely to operate as source-identifiers should not give rise to forms of analysis that will ensure that result. Consumer understanding is complex and varied. It should not be oversimplified by application of over-generalized assumptions, but instead should be ascertained by application of fact-sensitive tests. For these reasons, I advocate a single standard for all trade dress, requiring a predictive inquiry involving analysis of the commercial background against which the product will be marketed and the prediction made: Is it likely that consumers will identify the product by reference to the features claimed as trade dress? Pertinent predictors would include the nature of the design, the context in which the design is likely to be perceived by prospective purchasers, and the nature of the product. These predictors reflect empirical bases, the grounded justifications upon which courts may reach the conceptual conclusion that consumers are likely to associate the product design with its source.<sup>20</sup>

Dinwoodie's 1997 study is inherently rational. Why treat product configuration as a suspect class of source identifiers? Why treat only product configuration as requiring a higher showing of source identification? That is, the objectives of trademark law would be better served by not providing arbitrary hurdles that trademark claimants need to overcome. As Dinwoodie points out, simple predictors that do not discriminate against the type of trade dress at issue may better fulfill the objectives of trademark protection—protect the consumer from confusion, protect trademark owners' good will and allow third parties to compete.

In 1991, before *Two Pesos*, Daniel Gifford predicted an expansion of trade dress protection.<sup>21</sup> He reasoned as follows:

So long as in any industry there is—in Judge Posner's analytical terms—no shortage of supply in alternative designs, design protection engenders competition in bringing new product designs to market. Competition in product design furthers the social interest in maximizing consumer choice. This furtherance of consumer choice is compatible with the consumer interest in price competition so long as no producer corners the market on attractive designs. So long as there is no limit on potentially attractive designs, no one producer will be able to exploit its own design for more than the premium commanded by the relative value of that design vis-a-vis all other designs in competition with it: It is the premium commanded by a differentiated product in competition with other products.<sup>22</sup>

Gifford argued that protecting product configuration would stimulate new designs

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<sup>20</sup> *Id.* at 604-05.

<sup>21</sup> Daniel J. Gifford, *The Interplay of Product Definition, Design and Trade Dress*, 75 MINN. L. REV. 769 (1991).

<sup>22</sup> *Id.* at 787.

in manufactured goods.<sup>23</sup> Gifford predicted that women's clothing, for example, not subject to copyright protection because it is functional, may be protected as trade dress and thus stimulate further creativity.<sup>24</sup>

Rather than the arbitrary conclusion reached by the Supreme Court in distinguishing product configuration from product packaging,<sup>25</sup> most commentators have recommended a more flexible approach.<sup>26</sup> The common thread in this scholarship is that trade dress protection should be afforded manufactures but on a consistent basis without favoring one type of trade dress over another.<sup>27</sup>

Perhaps the strongest and most recent proponent of recognizing inherently distinctive trade dress regardless of whether the dress is packaging or configuration is William Fryer.<sup>28</sup> Fryer argues that if the functionality doctrines in trademark law are adhered to, there is no justifiable reason to recognize some trade dress as possibly inherently distinctive and arbitrarily excluding other trade dress.<sup>29</sup> Fryer argues for a case-by-case analysis and concludes that many countries other than the United States protect trade dress based on whether it identifies the source or origin of some good or service, is not functional, and consumers would likely to be confused or deceived if copied, not on whether the trade dress is packaging or configuration.<sup>30</sup> Fryer argues that the line of Supreme Court cases addressed by Justice Stevens' speech puts the United States in disharmony with the respective laws of many other countries and the European Union specifically.<sup>31</sup>

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<sup>23</sup> *Id.* at 791.

<sup>24</sup> *Id.* at 788. Needless to say, the Supreme Court apparently disagreed with this in *Wal-Mart*, 529 U.S. 205 (holding that children's clothing designs were not entitled to trade dress protection).

<sup>25</sup> See *Wal-Mart*, 529 U.S. at 215. "Two Pesos is inapposite to our holding here because the trade dress at issue, the decor of a restaurant, seems to us to not constitute product design." *Id.* "It was either product packaging—which, as we have discussed, normally is taken by the consumer to indicate origin—or else some *tertium quid* that is akin to product packaging and has no bearing on the present case." *Id.*

<sup>26</sup> See Margreth Barrett, *Trade Dress Protection for Product Configurations and the Federal Right to Copy*, 20 HASTINGS COMM. & ENT. L.J. 471 (1998); Adam J. Cermak, *Inherent Distinctiveness in Product Configuration Trade Dress*, 3 U. BALT. INTELL. PROP. L.J. 79, 94-101 (1994) (proposing a multi-factor test where flexibility is the key); Jay Dratler, Jr., *Trademark Protection for Industrial Designs*, 1988 U. ILL. L. REV. 887, 975 (supporting trade dress protection of industrial designs because "precisely the same features of trademark law may serve a useful purpose in protecting industrial designs" and "[b]ecause it relies on customer confusion and overtones of fraud, trademark law can coexist with patent and copyright principles based more on strict notions of property"); William F. Gaske, Comment, *Trade Dress Protection: Inherent Distinctiveness as an Alternative to Secondary Meaning*, 57 FORDHAM L. REV. 1123, 1130 (1989) (suggesting that all trade dress be subject to the same standard and be required to have secondary meaning before it can be protected).

<sup>27</sup> See, e.g., Michael B. Landau, *Reconciling Qualitex with Two Pesos: Ambiguity and Inconsistency from the Supreme Court*, 3 UCLA ENT. L. REV. 219, 222 (1996) (noting that by requiring secondary meaning for the protection of color as a trademark, the Court followed neither the Lanham Act nor its own precedent). There is no statutory justification for the Court requiring secondary meaning for the protection of color, nor is there sufficient justification for blithely dismissing the possibility that color could ever be inherently distinctive. *Id.* Just as it was improper to make legal distinctions between registered and unregistered marks or between trade dress and trademarks, it is also improper to make a legal distinction between color and all other types of marks if not directed by the statute. *Id.*

<sup>28</sup> William T. Fryer, III, *Trademark Product Appearance Features, United States and Foreign Protection: A Need for Clarification and Harmonization*, 34 J. MARSHALL L. REV. 947 (2001).

<sup>29</sup> *Id.* at 969.

<sup>30</sup> *Id.* at 964.

<sup>31</sup> *Id.* at 970. Some countries go much further in protecting product configuration. *Id.* at 969. Japan protects the shape of a product for three years from its entry in the market, regardless of notice to third

A few commentators have argued that no trade dress should be subject to protection without secondary meaning. These commentators suggest that courts have rushed into the current scheme of protection without thoroughly considering all of the likely effects on the marketplace as well as on creativity.<sup>32</sup> They also argue that “trade dress” does not fit into the meaning of “symbol” as set out in section 45 of the Lanham Act.<sup>33</sup>

The real struggle that the Court seems to be facing is the intersection between patent law and policy, and trade dress law and policy.<sup>34</sup> Fear of granting patent-like rights to trade dress claimants in perpetuity may explain far more of the Supreme Court’s trade dress jurisprudence than anyone’s common sense.

The fact of the matter remains that even if a restaurant decided to only employ red-haired people and even if the true author of the Shakespeare Canon was Edward de Vere, the seventeenth Earl of Oxford, or not,<sup>35</sup> allowing product packaging to be inherently distinctive but requiring product configuration to have secondary meaning or be unprotectable no matter how inherently distinctive that product configuration is seems to violate the very Shakespeare Canon of Statutory Construction on which Justice Stevens relies: “interpretations that produce absurd results are probably wrong, because it is unreasonable to believe that legislatures intended such results.”<sup>36</sup>

Perhaps if the Supreme Court had reviewed or considered the rather well-developed academic literature on the issue of inherently distinctive trade dress, only a small portion of it cited here, during its analysis of these four cases, the Court may have come to a different understanding of “common sense.” After all, a rose is only as sweet smelling by any other name if it identifies the source or origin of some *distinguishable* good or service. Otherwise, using the same scent on similar products may just be trademark infringement.

I suspect that the real result of this line of cases will be that most practitioners will merely claim all trade dress to be product packaging to allow for a claim of inherent distinctiveness. The next line of trade dress cases will likely be the common sense

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parties and regardless of registration of any kind. Fusei kyoso boshiho [Unfair Competition Prevention Law], Law No. 14 of 1934, amended by Law No. 47 of 1993. The relevant portion of the statute reads as follows: “[An act of unfair competition shall be defined as] the act of making exact or near exact copies of another’s product, provided the product configuration is not the general shape of such products and, in the case of unique goods, the function and use of such good shall not be protected ...” *Id.*; see also Kenneth L. Port, *Translation and Commentary: Japanese Intellectual Property Law in Translation: Representative Cases and Commentary*, 34 VAND. J. TRANSNAT’L L. 847, 868-79 (2001).

<sup>32</sup> Wuajeanne F. McLean, *Opening Another Can of Worms: Protecting Product Configuration as Trade Dress*, 66 U. CIN. L. REV. 119, 149 (1997).

<sup>33</sup> Glynn S. Lunney, Jr., *Trade Dress Does Not Belong on the Principal Register*, 51 HASTINGS L.J. 1131, 1148 (2000).

<sup>34</sup> See, e.g., Thomas F. Cotter, *Is This Conflict Really Necessary?: Resolving an Ostensible Conflict Between Patent Law and Federal Trademark Law*, 3 MARQ. INTELL. PROP. L. REV. 25 (1998).

<sup>35</sup> See Stevens, *supra* note 1, at 188-90 (wondering whether the presumption that a play or a poem is worth reading if written by William Shakespeare would be as strong if the author were really Edward de Vere, the seventeenth Earl of Oxford).

<sup>36</sup> *Id.* at 179.

Like all of Shakespeare’s plays, the Canon contains five parts: Read the statute; read the entire statute; read the statute in its contemporary context; if necessary, consult the legislative history; and, finally, use your common sense—interpretations that produce absurd results are probably wrong, because it is unreasonable to believe that legislatures intended such results.

determination of whether a trade dress is packaging or configuration. The Court has not only left open the question of whether a rose by any other name is as sweet smelling, the Court has also left open whether the smell of that rose is product packaging or configuration.

Stay tuned.