



## TRADE DRESS PROTECTION AND THE PROBLEM OF DISTINCTIVENESS

Mark V.B. Partridge

### Abstract

The problem of trade dress protection is this: What rules should we apply to trade dress protection to best satisfy the goals of trademark law? The merit of various proposed solutions can be measured by evaluating how effective they are in achieving those goals in various disputes. Both distinctiveness and likelihood of confusion should be understood from the perspective of the relevant public, not from that of the court, the trademark owner or the infringer. The questions we seek to answer only have coherent meaning if we consider the perception of the public. Otherwise, we are unable to determine if the plaintiff has any goodwill to protect or if the defendant's acts are unfair. When the results or reasoning of a trademark or trade dress decision seem flawed or confused, the cause often lies in a failure to analyze the problem based on the perception of the public. To the extent, however, that such questions have been obscured behind a layer of other concerns—behind a layer of categories, factors and analytical distinctions—we may be falling short of the central goals of trademark law. Refocusing on these questions may bring us closer to those goals. Trade dress seems to be an area in particular need of this refocus as the debate over protection continues.

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The problem of trade dress protection is this: What rules should we apply to trade dress protection to best satisfy the goals of trademark law? The merit of various proposed solutions can be measured by evaluating how effective they are in achieving those goals in various disputes.

Trademark law is directed toward three general goals: (1) protection of the public from confusion, mistake and deception;<sup>1</sup> (2) protection of the trademark owner's goodwill;<sup>2</sup> and (3) prevention of unfair acts by others.<sup>3</sup> These goals are inter-related, with the primary goal being the protection of the public.<sup>4</sup> That primary goal is the basis for understanding the meaning of the other goals. To understand the other two goals we must consider them in the context of public perception. Otherwise, the other two goals become abstractions, with no coherent meaning.

The identity of a trademark owner's goodwill is determined by public perception.<sup>5</sup> It is the collection of favorable associations found in the public mind. Goodwill is damaged when those favorable associations of the public are damaged. Likewise, in the trademark context, whether an act affecting the business of another is unfair depends on its effect on the public mind.

As an example, suppose that Armstrong Corporation adopts the name AMAZE for widgets. The Brewster Company later adopts AMAZE for gadgets. Armstrong cries that this is an unfair act. But is it? The mere fact that the names are the same means nothing. The answer depends on the public mind. Does the public associate the name AMAZE with Armstrong? When the public encounters Brewster's use of AMAZE, is it confused or deceived?

The answers to these questions turn on an analysis of the two basic issues of trademark law—distinctiveness and likelihood of confusion. Rephrasing the questions using those terms of art, we must first decide if AMAZE is distinctive, meaning that the public associates the name used in connection with widgets with a

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<sup>1</sup> See, e.g., *Blue Bell, Inc. v. Farah Mfg. Co.*, 508 F.2d 1260, 1265 (5th Cir. 1975) ("The primary, perhaps singular purpose of a trademark is to provide a means for the consumer to separate or distinguish one manufacturer's goods from those of another.").

<sup>2</sup> See, e.g., *Scarves by Vera, Inc. v. Todo Imps. Ltd.*, 544 F.2d 1167, 1172 (2d Cir. 1976) ("The trademark laws protect . . . the senior user's interest . . . in protecting the good reputation associated with his mark from the possibility of being tarnished by inferior merchandise of the junior user. . . .").

<sup>3</sup> See, e.g., *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 773 (1992) ("[T]he protection of trademarks and trade dress under § 43(a) serves the . . . statutory purpose of preventing . . . unfair competition.").

<sup>4</sup> E.g., *Blue Bell*, 508 F.2d at 1265.

<sup>5</sup> See, e.g., *Vittoria N. Am., L.L.C. v. Euro-Asia Imps. Inc.*, 278 F.3d 1076, 1082 (10th Cir. 2001) ("A trademark symbolizes the public's confidence or 'goodwill' in a particular product.") (quoting *Premier Dental Prods. Co. v. Darby Dental Supply Co.*, 794 F.2d 850, 853 (3d Cir. 1986)).

single source. If so, then we must decide if there is a likelihood of confusion—that is, whether the relevant public is likely to experience confusion, mistake or deception due to Brewster’s use of AMAZE.

Both issues should be understood from the perspective of the relevant public, not from that of the court, the trademark owner or the infringer. The questions we seek to answer only have coherent meaning if we consider the perception of the public. Otherwise, we are unable to determine if the plaintiff has any goodwill to protect or if the defendant’s acts are unfair. When the results or reasoning of a trademark or trade dress decision seem flawed or confused, the cause often lies in a failure to analyze the problem based on the perception of the public.

This article will focus on the distinctiveness analysis for trade dress protection. The article begins with a review of the fundamental principles arising in early decisions, and it then turns to the development of categories as a tool for the distinctiveness analysis. Next, the article addresses the problems in the application of that analysis, and it discusses the resolution offered by the Supreme Court in *Two Pesos, Inc. v. Taco Cabana, Inc.*<sup>6</sup> and *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*<sup>7</sup> Finally, the article considers how well that resolution addresses the problem of trade dress protection.

## I. TRADE DRESS DEFINED

Trade dress has been defined by the Supreme Court as “the total image of a product[,] and may include features such as size, shape, color or color combinations, texture, graphics, or even particular sales techniques.”<sup>8</sup> It includes “the shape and design of the product itself.”<sup>9</sup> It can be viewed as any aspect of overall appearance that “act[s] as a symbol that distinguishes a firm’s goods and identifies their source, without serving any other significant function.”<sup>10</sup>

## II. HISTORICAL BACKGROUND

The concepts surrounding distinctiveness began to emerge in the case law of the early twentieth century. In 1917, for example, the Sixth Circuit considered a trade dress infringement case involving the packaging for fly paper.<sup>11</sup> The case is significant for its recognition of the rationale for such protection:

Wherever, then, the first user has through a particular trade dress, as here, *so identified his product as to indicate that it is his*, every principle of fair

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<sup>6</sup> 505 U.S. 763 (1992).

<sup>7</sup> 529 U.S. 205 (2000).

<sup>8</sup> *Two Pesos*, 505 U.S. at 764 n.1 (quoting *John H. Harland Co. v. Clarke Checks, Inc.*, 711 F.2d 966, 980 (11th Cir. 1983)).

<sup>9</sup> *Nabisco, Inc. v. PF Brands, Inc.*, 50 F. Supp. 2d 188, 199 (S.D.N.Y. 1999) (quoting J. THOMAS MCCARTHY, 1 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 8.5, at 8-14 (4th ed. 1996)).

<sup>10</sup> *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 166 (1995) (holding that color per se was protectable).

<sup>11</sup> *O.&W. Thum Co. v. Dickinson*, 245 F. 609, 611 (6th Cir. 1917).

dealing, fair competition, forbids any subsequent user of the same product to adopt any part of the first user's dress without otherwise effectively distinguishing his dress from that of the first user.<sup>12</sup>

How are we to know when a plaintiff has "so identified" his product so as to earn protection?<sup>13</sup> It is through the combination of "details[] for the very purpose of denoting the origin of his product."<sup>14</sup> Those details may be unremarkable when segregated, but when aggregated, they create trade dress that identifies the product as his.<sup>15</sup> "[I]t is through such distinctive characteristics, considered in a unitary way, that the first user and the public can be protected against confusion and deception as to his product."<sup>16</sup>

In this language, we see the beginning of the principle that "distinctive" trade dress may serve to identify the source of the product. The perspective of the consumer is implied, but not directly identified. The public's perception appears more clearly in the language of a 1933 case involving the mark DOBBS for hats.<sup>17</sup> The court notes that efforts to distinguish one mark from another in the marketplace "will largely depend upon the connotations which the public has become habituated to attach to the plaintiff's use of the name."<sup>18</sup> The name has come to mean more than just a name; it has taken on a new meaning:

Since this name *has acquired its secondary meaning* largely by advertising, that fact and the content of such advertising will indicate the association of ideas which attaches in the public mind to the name.<sup>19</sup>

The defendant's mark is an infringement because it evoked "[p]recisely the same images" in the public mind as the plaintiffs.<sup>20</sup>

How do we decide if the trade dress or trademark is distinctive? In 1925, a case arose over the use of the mark GOLD MEDAL for flour.<sup>21</sup> The court recognizes that the right to protection may vary according to the type of mark:

To take another view of the matter, the degree of exclusiveness of appropriation accorded to the originator of a trade-name often varies with the kind of name he originates. If the name or mark be truly arbitrary, strange, and fanciful, it is more specially and peculiarly significant and suggestive of one man's goods, than when it is frequently used by many and in many differing kinds of business. . . . The phrase "Gold Medal" is distinctly not in the same class of original, arbitrary, or fanciful words as "Kodak" and "Aunt Jemima." It is a laudatory phrase, suggestive of merit,

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<sup>12</sup> *Id.* at 619 (emphasis added).

<sup>13</sup> *Id.*

<sup>14</sup> *Id.*

<sup>15</sup> *See id.*

<sup>16</sup> *Id.*

<sup>17</sup> *Hat Corp. of Am. v. D.L. Davis Corp.*, 4 F. Supp. 613, 622 (D. Conn. 1933).

<sup>18</sup> *Id.*

<sup>19</sup> *Id.* (emphasis added).

<sup>20</sup> *Id.*

<sup>21</sup> *Fr. Milling Co. v. Washburn-Crosby Co.*, 7 F.2d 304, 305 (2d Cir. 1925).

recognized by some organization of authority awarding a prize. It is only allied to some particular business or person by insistent, persistent advertising.<sup>22</sup>

The court is identifying an important distinction in trademark law that has become more sharply cleaved over time—the distinction between terms that are inherently distinctive—that is, terms that immediately identify source—and terms that are not, and only acquire distinctiveness through advertising or other persistent use. In other words, they acquire a “secondary meaning.”

The implication of these early cases and others like them is that mere adoption and use of a device is not enough. One’s mere attempt to identify one’s product as his own is not sufficient in itself. The evidence should show that the attempt successfully makes that impression on the public mind. Justice Frankfurter commented on this “psychological function” of trademarks in 1942, stating: “Whatever the means employed, the aim is the same—to convey through the mark, in the minds of potential customers, the desirability of the commodity upon which it appears. Once this is attained, the trade-mark owner has something of value.”<sup>23</sup>

An important corollary is also suggested by Justice Frankfurter’s language. If the mark or trade dress conveys nothing to the public mind, the owner has nothing of value. A device may perhaps serve as an indication of source in the public mind immediately, because the device is “original, arbitrary, or fanciful,”<sup>24</sup> or it may only do so after “insistent, persistent advertising.”<sup>25</sup> The important issue is the factual question of the effect of the device on the public mind. Over time, however, there has been a tendency to shift attention from that important issue and instead focus on whether the device fits into one analytical category or the other.

### III. THE LOVE OF CATEGORIES

The Second Circuit provided the classic statement on the categories of distinctiveness in a case involving the mark SAFARI for clothing.<sup>26</sup> The court stated:

The cases, and in some instances the Lanham Act, identify four different categories of terms with respect to trademark protection. Arrayed in an ascending order which roughly reflects their eligibility to trademark status and the degree of protection accorded, these classes are (1) generic, (2) descriptive, (3) suggestive, and (4) arbitrary or fanciful.<sup>27</sup>

In the lengthy explanation that follows in the case, there is little mention of the relationship of the categories to the perspective of the public.<sup>28</sup> The public is given a passing nod in mentioning that a generic term cannot be protected regardless of

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<sup>22</sup> *Id.* at 306.

<sup>23</sup> *Mishawaka Rubber & Woolen Mfg. Co. v. S.S. Kresge Co.*, 316 U.S. 203, 205 (1942).

<sup>24</sup> *Fr. Milling*, 7 F.2d at 306.

<sup>25</sup> *Id.*

<sup>26</sup> *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 7 (2d Cir. 1976).

<sup>27</sup> *Id.* at 9.

<sup>28</sup> *See id.* at 9-11.

“what success it has achieved in securing public identification.”<sup>29</sup> The case leaves the impression that the critical question is the identification of the correct category. If that holy grail is known, all else is revealed.

The Fifth Circuit did a better job of connecting the test to the public mind in *Chevron Chemical Co. v. Voluntary Purchasing Groups, Inc.*,<sup>30</sup> the leading case on the application of the categories of distinctiveness to trade dress. Deciding a dispute over the trade dress for agricultural chemicals, the court recognizes the public’s place in the equation, stating:

The purpose of a trademark is to enable consumers to distinguish between similar goods or services supplied from different sources. Some words and phrases are patently distinctive and, therefore, qualify facially for legal protection . . . . However, descriptive terms, geographical place names, and family surnames are not inherently distinctive and do not alone identify any particular company’s product. They were not protected as trademarks unless they had acquired distinctiveness through extensive use by a single supplier, *so that the public would recognize them as identifying the source of the product*. This consumer identification is known as “secondary meaning.”<sup>31</sup>

Acknowledging that trademark law requires a showing of secondary meaning “only when the claimed trademark is not sufficiently distinctive of itself to identify the producer,” the court concludes that “[t]he same principles should apply to the protection of trade dress[].”<sup>32</sup> Therefore, trade dress that is sufficiently distinctive in itself would be protectable without a showing of secondary meaning.<sup>33</sup> This condition is met if the features at issue were arbitrarily selected and served no function either to describe the product or assist in its effective packaging.<sup>34</sup>

The beginning of the lost connection between distinctiveness and the public mind is present in the *Chevron* case. If trade dress can be categorized as a “collection of arbitrary features,”<sup>35</sup> then it can be protected without the need to consider the effect of those arbitrary features on the public. But why is it necessarily true that arbitrary features should be protected without more? The *Chevron* case suggests a basis for decision closer to the real issue—whether the trade dress is sufficiently distinctive of itself to identify the producer.<sup>36</sup> That question focuses on the perception of the public, not on the placement of the device at issue into categories.

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<sup>29</sup> *Id.* at 9.

<sup>30</sup> 659 F.2d 695 (Former 5th Cir. 1981).

<sup>31</sup> *Id.* at 702 (emphasis added).

<sup>32</sup> *Id.*

<sup>33</sup> *Id.*

<sup>34</sup> *Id.*

<sup>35</sup> *Id.* at 703.

<sup>36</sup> *See id.* at 702.

IV. *TWO PESOS*

The *Chevron* case provided a framework for analysis that was adopted by many of the circuits.<sup>37</sup> Following the *Chevron* analysis, trade dress that is sufficiently distinctive of itself to identify the producer may be considered inherently distinctive and entitled to protection without a showing of acquired distinctiveness.<sup>38</sup> An example of such trade dress is the package in the *Chevron* case consisting of a combination of colors, geometric designs and lettering styles that create a “distinctive visual impression.”<sup>39</sup> A type of trade dress that would not meet that test would be packaging that serves as a description of the product. Such trade dress would not of itself identify the producer, but it might acquire distinctiveness, or secondary meaning, through use so that the public would recognize the trade dress as identifying the source of the producer.

In *Two Pesos, Inc. v. Taco Cabana, Inc.*,<sup>40</sup> the Supreme Court considered the protection of trade dress in the décor of Mexican restaurants.<sup>41</sup> The case arose from a special verdict after a jury trial in which the jury found that the plaintiff's trade dress was inherently distinctive but lacked secondary meaning.<sup>42</sup> The jury's findings in *Two Pesos* were consistent with the Fifth Circuit precedent of *Chevron*, holding that trade dress could be protected without secondary meaning if it was inherently distinctive.<sup>43</sup> The finding was inconsistent, however, with precedent from other circuits that protected trade dress only where secondary meaning is shown.<sup>44</sup> To some observers, the jury verdict in *Two Pesos* seemed hopelessly confused. Because secondary meaning means acquired distinctiveness, how could the trade dress be distinctive and not distinctive at the same time?

The Supreme Court granted certiorari to consider whether inherently distinctive trade dress was protectable without the necessity of showing secondary meaning.<sup>45</sup> The trade dress at issue was defined as

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

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<sup>37</sup> See, e.g., *AmBrit, Inc. v. Kraft, Inc.*, 812 F.2d 1531, 1535 n.13, 1535-36 (11th Cir. 1986) (adopting the Fifth Circuit's approach in *Chevron*, stating that “the plaintiff must establish that its trade dress is inherently distinctive or has acquired secondary meaning”); *Blau Plumbing, Inc. v. S.O.S. Fix-It, Inc.*, 781 F.2d 604, 608 (7th Cir. 1986) (“If any of these cases stands for the broader proposition that secondary meaning must be shown even if the trade dress is a distinctive, identifying mark, then we think they are wrong, for the reasons explained by . . . the Fifth Circuit in *Chevron*.”). But see, e.g., *Stormy Clime Ltd. v. ProGroup, Inc.*, 809 F.2d 971, 974 (2d Cir. 1987) (stating that for § 43(a) protection, a “plaintiff must show that the trade dress of its product has acquired secondary meaning in the marketplace”).

<sup>38</sup> *Chevron*, 659 F.2d at 702.

<sup>39</sup> *Id.* at 703.

<sup>40</sup> 505 U.S. 763 (1992).

<sup>41</sup> See *id.* at 765 n.1.

<sup>42</sup> *Id.* at 766.

<sup>43</sup> *Chevron*, 659 F.2d at 702.

<sup>44</sup> See, e.g., *Vibrant Sales, Inc. v. New Body Boutique, Inc.*, 652 F.2d 299, 304 (2d Cir. 1981) (“Since plaintiff concededly made no attempt to adduce any evidence that its product's appearance . . . had acquired secondary meaning, its Lanham Act claim should have been dismissed.”).

<sup>45</sup> *Two Pesos*, 505 U.S. at 767.



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.<sup>46</sup>

The Supreme Court endorsed the categories of descriptiveness set out in *Abercrombie*.<sup>47</sup> Finding no basis in the Lanham Act for treating trade dress any differently from trademark, the Court held that inherently distinctive trade dress was entitled to protection without a showing of secondary meaning:

The Fifth Circuit was quite right in *Chevron*, and in this case, to follow the *Abercrombie* classifications consistently and to inquire whether trade dress for which protection is claimed under § 43(a) is inherently distinctive. If it is, it is capable of identifying products or services as coming from a specific source and secondary meaning is not required. This is the rule generally applicable to trademarks, and the protection of trademarks and trade dress under § 43(a) serves the same statutory purpose of preventing deception and unfair competition. There is no persuasive reason to apply different analysis to the two.<sup>48</sup>

The Court's decision in *Two Pesos* confirms the general rule for distinctiveness and establishes that the rule applies to trade dress as well as trademarks.

#### V. APPLICATION OF *TWO PESOS*

*Two Pesos* left the courts to struggle to create tests and factors to determine when trade dress is inherently distinctive. The general rule is: "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>49</sup> "Distinctiveness" refers to the mark's capability to distinguish the applicant's goods from those of others.<sup>50</sup> Marks that serve to identify a particular source of a product because of "their intrinsic nature" are deemed "inherently distinctive."<sup>51</sup> Marks that do not inherently identify a particular source may acquire distinctiveness.<sup>52</sup> Since these principles apply equally to trade dress, it follows that trade dress that identifies a particular source of product because of its intrinsic nature should also be deemed "inherently distinctive" and entitled to protection without a showing of secondary meaning.

How are we to determine if trade dress is inherently distinctive? This question was not at issue in *Two Pesos*. However, with its implicit endorsement of the views

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<sup>46</sup> *Id.* at 765.

<sup>47</sup> *Id.* at 768 (citing *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976)).

<sup>48</sup> *Id.* at 773.

<sup>49</sup> *Id.* at 769.

<sup>50</sup> *Id.* at 768.

<sup>51</sup> *Id.*

<sup>52</sup> *Id.* at 769.

stated in *Chevron*, the Court seems to support the view that trade dress should be categorized the same way as trademarks were in *Abercrombie*.<sup>53</sup> In other words, if the trade dress can be categorized as suggestive, arbitrary or fanciful, then it should be considered inherently distinctive.<sup>54</sup> But what do these categories mean with respect to trade dress? On that point, *Two Pesos* provides little help.

After *Two Pesos*, some of the circuits turned to *Abercrombie* and *Chevron*.<sup>55</sup> For example, in 1998, the Fifth Circuit transferred the *Abercrombie* categories in full in *Pebble Beach Co. v. Tour 18 I Ltd.*<sup>56</sup> *Pebble Beach* involves the protection of golf hole designs.<sup>57</sup> The *Pebble Beach* decision recognizes that “[t]rademarks and trade dress are distinctive and protectible if they serve as indicators of source.”<sup>58</sup> Trademarks and trade dress can be classified according to the categories stated in *Abercrombie*.<sup>59</sup> Those that are suggestive, arbitrary, and fanciful are inherently distinctive, and require no showing of secondary meaning, “because their intrinsic nature serves to identify a particular source of product.”<sup>60</sup> Thus, the court connects the categories with the public mind.

The application of the test in *Pebble Beach* is instructive:

Arbitrary and fanciful marks or trade dress bear no relationship to the products or services to which they are applied. The trade dress of Pebble Beach and Pinehurst’s golf holes is a configuration of commonplace features of a golf hole and therefore does bear a relationship to the product, a golf hole. A suggestive mark or trade dress suggests, rather than describes, some particular characteristic of the goods or services to which it applies and requires the consumer to exercise the imagination in order to draw a conclusion as to the nature of the goods and services. The configurations of the features in Pebble Beach and Pinehurst’s golf-hole designs create golf holes and nothing more. They require no exercise of one’s imagination to realize that one is viewing a golf hole.<sup>61</sup>

Given that the golf holes are not arbitrary, fanciful or suggestive, they are not inherently distinctive.<sup>62</sup> The application of the test now seems several steps removed from the point of the descriptiveness requirement—whether the device in questions serves to identify source. Instead, the inquiry is focusing on whether a golf hole

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<sup>53</sup> See *id.* at 773 (“The 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>54</sup> See *id.* at 768 (stating that marks that are “suggestive,” “arbitrary,” or “fanciful” are “inherently distinctive and are entitled to protection”).

<sup>55</sup> See, e.g., *Pebble Beach Co. v. Tour 18 I Ltd.*, 155 F.3d 526, 540 (5th Cir. 1998); *Insty\*Bit, Inc. v. Poly-Tech Indus., Inc.*, 95 F.3d 663, 673 (8th Cir. 1996); *Stuart Hall Co. v. Ampad Corp.*, 51 F.3d 780, 785 (8th Cir. 1995).

<sup>56</sup> 155 F.3d 526 (5th Cir. 1998).

<sup>57</sup> *Id.* at 532.

<sup>58</sup> *Id.* at 540.

<sup>59</sup> *Id.*

<sup>60</sup> *Id.*

<sup>61</sup> *Id.* (citations and internal quotation marks omitted).

<sup>62</sup> *Id.* at 540-41.

“bear[s] a relationship to . . . a golf hole.”<sup>63</sup> The question almost seems silly. Regrettably, we become sidetracked by the application of the test—by our effort to categorize—and lose sight of the real issue.

In *Stuart Hall Co. v. Ampad Corp.*,<sup>64</sup> another case following *Abercrombie and Chevron*, the connection between the test and the real issue seems even more attenuated:

These definitions address the relation between the product and the trade dress, not the relation between the trade dress and the consumer. The question they present is whether, and how much, the trade dress is dictated by the nature of the product, not whether . . . consumers associate the design with its source.<sup>65</sup>

The court is arguing against a test for inherent distinctiveness adopted by the lower court that required a showing that the trade dress was “striking and memorable.”<sup>66</sup> Unfortunately, the reasoning used creates further separation between the public mind and the protection of trade dress, taking us to the point where trade dress is protected if it “is only tenuously connected with the nature of the product.”<sup>67</sup> That test bears little, if any, relationship to whether the public will react to the trade dress as an indication of source.

Finding the *Abercrombie* and *Chevron* analysis inadequate, other circuits have relied on *Seabrook Foods, Inc. v. Bar-Well Foods Ltd.*,<sup>68</sup> an early attempt to establish factors for determining when trade dress is inherently distinctive.<sup>69</sup> In *Seabrook Foods*, the Court of Customs and Patent Appeals<sup>70</sup> identified the following factors for inherent distinctiveness: (1) whether the design is a “‘common’ basic shape or design”; (2) whether the design is “unique or unusual in a particular field”; (3) whether the design is “a mere refinement of a commonly-adopted and well-known form of ornamentation for a particular class of goods”; and (4) whether it is “capable of creating a commercial impression distinct from the accompanying words.”<sup>71</sup>

The Third Circuit adopted yet another test for determining distinctiveness of product configuration trade dress in *Duraco Products, Inc. v. Joy Plastic Enterprises*,

<sup>63</sup> *Id.* at 540.

<sup>64</sup> 51 F.3d 780 (8th Cir. 1995).

<sup>65</sup> *Id.* at 786.

<sup>66</sup> *Id.* at 784.

<sup>67</sup> *Id.* at 786.

<sup>68</sup> 568 F.2d 1342 (C.C.P.A. 1977).

<sup>69</sup> See, e.g., *Ashley Furniture Indus., Inc. v. SanGiacomo N.A. Ltd.*, 187 F.3d 363, 371 (4th Cir. 1999) (“[D]ifficulties in applying *Abercrombie* to product configuration can often be mitigated by considering the principles stated in *Seabrook* . . . .”); *I.P. Lund Trading ApS v. Kohler Co.*, 163 F.3d 27, 33 (1st Cir. 1998) (“In analyzing inherent distinctiveness in the context of product design, we hold that while the well-known *Abercrombie* test provides a useful analogy, strict application of the test is not required; we reiterate this court’s adherence to the *Seabrook Foods* test.”); *Landscape Forms, Inc. v. Columbia Cascade Co.*, 113 F.3d 373, 378 n.3 (2d Cir. 1997) (“The questions posed in *Seabrook* . . . may, in different contexts, be useful tools to assess whether a design is ‘likely to be perceived as a source indicator.’”); *Wiley v. Am. Greetings Corp.*, 762 F.2d 139, 141 (1st Cir. 1985) (applying the *Seabrook Foods* factors).

<sup>70</sup> The Court of Customs and Patent Appeals is a predecessor court of the Court of Appeals for the Federal Circuit. See S. REP. NO. 97-275, at 2 (1981), reprinted in 1982 U.S.C.C.A.N. 11, 12.

<sup>71</sup> *Seabrook Foods*, 568 F.2d at 1344.

*Ltd.*<sup>72</sup> The court in *Duraco* finds that the classification of product-configuration trade dress as distinctive remains an open issue after *Two Pesos*:

Because the Supreme Court in *Two Pesos* did not decide the question whether trade dress, and in particular trade dress in a product configuration, can actually ever be considered inherently distinctive—for purposes of that case, the Court assumed that the restaurant decor at issue was so—we must first embark on a journey to delineate when, if ever, product configurations should be deemed inherently distinctive.<sup>73</sup>

The Third Circuit rejects the *Abercrombie* taxonomy: “[W]e do not think it helpful or proper to transplant the categorical distinctiveness inquiry developed for trademarks to product configurations, where the alleged trade dress lies in the very product itself.”<sup>74</sup> This is so because the product configuration is the thing itself: “Being constitutive of the product itself and thus having no such dialectical relationship to the product, the product’s configuration cannot be said to be ‘suggestive’ or ‘descriptive’ . . . or . . . ‘fanciful’ . . . .”<sup>75</sup>

According to the *Duraco* decision, product-configuration trade dress is inherently distinctive only where there is

a high probability that a product configuration serves a virtually exclusively identifying function for consumers—where the concerns over “theft” of an identifying feature or combination or arrangement of features and the cost to an enterprise of gaining and proving secondary meaning outweigh concerns over inhibiting competition, and where consumers are especially likely to perceive a connection between the product’s configuration and its source.<sup>76</sup>

Under the *Duraco* test, a product configuration trade dress may be deemed inherently distinctive if it is: (1) “unusual and memorable”; (2) “conceptually separable from the product”; and (3) “likely to serve primarily as a designator of origin of the product.”<sup>77</sup>

The case law developed after *Two Pesos* leaves many problems unresolved. First, there are significant differences between the circuits as to the choice and application of the tests for determining inherent distinctiveness. Thus, it is very difficult to predict results from one circuit to another, or even from one court to another. Second, some of the circuits apply different tests to package trade dress as opposed to product-configuration trade dress. What justification is there for different treatment? Finally, if trade dress is subject to the same test as trademarks for determining inherent distinctiveness, how does one determine if a trade dress is “arbitrary,” “suggestive,” or “merely descriptive”? These categories have relatively

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<sup>72</sup> 40 F.3d 1431, 1434 (3d Cir. 1994).

<sup>73</sup> *Id.* at 1440.

<sup>74</sup> *Id.*

<sup>75</sup> *Id.* at 1440-41.

<sup>76</sup> *Id.* at 1434, 1448.

<sup>77</sup> *Id.* at 1434, 1448-49.

well-settled meaning when it comes to word marks, but what do the categories mean when applied to trade dress?

## VI. *WAL-MART*

In 2000, the Supreme Court turned again to the question of distinctiveness, this time involving the trade dress consisting of the overall appearance of a children's seersucker outfit in *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*<sup>78</sup> The Samara Brothers claimed trade dress rights in the overall appearance of its outfits and sued Wal-Mart for the sale of imitations.<sup>79</sup> The jury found in favor of the Samara Brothers and awarded damages of about \$1.6 million.<sup>80</sup> The district court denied Wal-Mart's motion for judgment as a matter of law, and the Second Circuit affirmed.<sup>81</sup> Both courts concluded that inherently distinctive product configuration was entitled to protection without a showing of secondary meaning.<sup>82</sup>

The Supreme Court called upon the parties to address the standards for making that determination. The Samara Brothers argued that the lower-court decisions were consistent with *Two Pesos* in holding that inherently distinctive trade dress was entitled to protection without showing secondary meaning.<sup>83</sup> However, the Court went in a different direction, holding that product configuration could only be deemed distinctive upon a showing of secondary meaning.<sup>84</sup>

The Court recognized that the distinction between inherently distinctive marks and marks that require secondary meaning has solid foundation in the Lanham Act.<sup>85</sup> Although the *Two Pesos* decision confirms that there is no reason to limit that distinction only to trademarks, there is also no reason to assume that every category of thing eligible for protection under the Lanham Act necessarily includes some members that are inherently distinctive.<sup>86</sup>

The Court's decision rests on the fundamental recognition that the perspective of the public is primary:

The attribution of inherent distinctiveness to certain categories of word marks and product packaging derives from the fact that the very purpose of attaching a particular word to a product, or encasing it in a distinctive packaging, is most often to identify the source of the product. Although the words and packaging can serve subsidiary functions—a suggestive word mark (such as “Tide” for laundry detergent), for instance, may invoke positive connotations in the consumer's mind, and a garish form of packaging (such as Tide's squat, brightly decorated plastic bottles for its liquid laundry detergent) may attract an otherwise indifferent consumer's

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<sup>78</sup> 529 U.S. 205 (2000).

<sup>79</sup> *Id.* at 207-08.

<sup>80</sup> *Id.* at 208.

<sup>81</sup> *Id.*

<sup>82</sup> *Id.*

<sup>83</sup> *Id.* at 214.

<sup>84</sup> *Id.* at 215.

<sup>85</sup> *Id.* at 210-11.

<sup>86</sup> *Id.* at 211.

attention on a crowded store shelf—their predominant function remains source identification. Consumers are therefore predisposed to regard those symbols as indication of the producer, which is why such symbols “almost *automatically* tell a customer that they refer to a brand” and “immediately . . . signal a brand or a product ‘source.’” And where it is not reasonable to assume consumer predisposition to take an affixed word or packaging as indication of source—where, for example, the affixed word is descriptive of the product (“Tasty” bread) or of a geographic origin (“Georgia” peaches)—inherent distinctiveness will not be found. . . . In the case of product design, as in the case of color, we think consumer predisposition to equate the feature with the source does not exist. Consumers are aware of the reality that, almost invariably, even the most unusual of product designs—such as a cocktail shaker shaped like a penguin—is intended not to identify the source, but to render the product itself more useful or more appealing.<sup>87</sup>

This language is worth quoting at length because it shows an awareness by the Supreme Court that the central focus of trademark law should be on the consumer. We are concerned with the consumer’s attention in the supermarket, or the consumer’s predisposition to recognize some devices as indications of source, or the consumer’s contrary tendency to recognize product features as ornamental or functional rather than an indication of source.

In the Court’s view, product-configuration trade dress is never a thing that intrinsically identifies source to consumers.<sup>88</sup> The Court rejects the possibility that a test could be devised to determine if that were the case: “[W]here product design is concerned we have little confidence that a reasonably clear test can be devised.”<sup>89</sup>

Although not specifically stated, the decision conveys a sense of overall dissatisfaction with the judicial attempts to determine where trade dress in general is inherently distinctive:

To the extent there are close cases, we believe that courts should err on the side of caution and classify ambiguous trade dress as product design, thereby requiring secondary meaning. The very closeness will suggest the existence of relatively small utility in adopting an inherent-distinctiveness principle, and relatively great consumer benefit in requiring a demonstration of secondary meaning.<sup>90</sup>

The *Wal-Mart* decision leaves many issues open for debate. Is it necessarily true that product configuration can never be inherently distinctive? If there are some such configurations, should they not be entitled to protection without a showing of secondary meaning? Does not the reasoning of *Two Pesos* still require that possibility? Already there are efforts underway for legislation to overrule that aspect of the *Wal-Mart* holding. There also will be continued debate on the meaning of

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<sup>87</sup> *Id.* at 212-13 (first omission in original) (citations omitted).

<sup>88</sup> *Id.* at 214-15.

<sup>89</sup> *Id.* at 213.

<sup>90</sup> *Id.* at 215.

inherent distinctiveness for packaging trade dress, although the problems may be less difficult than with product-configuration trade dress.

While these debates will continue, the Supreme Court's decision can have a positive impact. As we think through these issues, we should focus first on the perspective of the public—what it means for a device to actually be distinctive and protectable—and then only secondarily on the categories and factors for making that determination. Further, we should not allow the tests to become ends in themselves, separated from the real issue of consumer perception.

## VII. CONCLUSION

In another context, the Supreme Court held that color was capable of protection as a trademark, stating: “It is the source-distinguishing ability of a mark—not its ontological status as a color, shape, fragrance, word, or sign—that permits it to serve these basic purposes [as a mark].”<sup>91</sup> The same principle should be applied in our thinking about trade dress. It is the source-indicating ability of the trade dress—not its ontological status as descriptive, suggestive, arbitrary or fanciful—that matters. We err when we depart from that understanding.

In the future, instead of debating whether a trade dress should be categorized as inherently distinctive or only protectable with secondary meaning, we might instead consider issues more central to the primary goal of trademark law. Is the public likely to be confused? This reasoning may lead us from the inquiries we have been making to slightly different questions and considerations. Does the trade dress create any impression on the public mind? How does it do that? What are the impressions created? Are those impressions protectable? If so, does the defendant's trade dress create the same or similar impressions? Is the public likely to be confused as a result?

The author does not suggest that these questions are novel. Rather, it is the author's point that they have been present all along. To the extent, however, that such questions have been obscured behind a layer of other concerns—behind a layer of categories, factors and analytical distinctions—we may be falling short of the central goals of trademark law. Refocusing on these questions may bring us closer to those goals. Trade dress seems to be an area in particular need of this refocus as the debate over protection continues.

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<sup>91</sup> *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 164 (1995).