

A Fight Over the Trade Dress Can Be a Mess, But a Necessary One to Protect Your Brand

By Andrew P. Botti

"They make a wilderness and call it peace." – Tacitus

I. Trade Dress May Be Better Than the Rest

The above reference to Tacitus defines well many trade dress court battles. These fights over trade dress are legendary, costly, and complicated, but sometimes very necessary. A product's trade dress is often critical to the success of a business as it may readily identify said business in the mind of the consumer. The entire point of the product's trade "dress" is to identify its source, i.e., the manufacturer, etc., in the eyes of the public. In this way, an excellent distinctive product may establish an outstanding reputation for the business. Under the law, the subject "trade dress" must be: 1) used in commerce; 2) non-functional; and 3) distinctive. The dictionary meaning of "distinctive" is "characteristic of one person or thing, and so serving to distinguish it from others." In this context, the "it" is the product source, not the product itself. In order to win on a claim of trade-dress infringement, plaintiff must prove the trade dress: distinctive, non-functional, and that "another's use of a similar trade dress is likely to cause confusion among consumers as to the product's source."

II. The Marked Distinction

Trade dress differs from the more commonly known and understood "trademark." A trademark is typically a word or a symbol of some sort placed on the product itself or perhaps its packaging, or both. For example, Shell Oil used a mark in the form of a shell from the ocean. The mark's purpose is to protect those engaged in commerce from unfair competition. When someone attempts to sell inferior goods under another's mark, this skullduggery is known at common law as "passing off." That is, "representing one's goods or services as those of another." *Two Pasos, Inc.*, 505 U.S. 763, 778 (1992). The so-called Lanham Act, a federal statute enacted in 1947, "creates a federal cause of action for trademark and trade dress infringement claims." *Id.* 780. "Marks are often classified in categories of generally increasing distinctiveness." *Id.* at 768. The classic definitions for a trademark are: (1) generic; (2) descriptive; (3) suggestive; (4) arbitrary; or (5) fanciful. *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2nd Cir. 1976). "The latter three categories of marks, because their intrinsic nature serves to identify a particular source of a product, are deemed inherently distinctive and are entitled to protection." *Two Pasos, Inc.* at 768. It is well established that: "Marks which are merely descriptive of a product are not inherently distinctive. When used to describe a product, they do not inherently identify a particular source, and hence cannot be protected." *Two Pasos*, at 769. I had a case once where someone had taken over a former Getty gasoline station. Instead of putting up their own signs, they continued operations under the name "Aris Getty," which they painted on the gas pumps. They also left in place the large logo-like "Getty" sign which was clearly visible from the busy road which ran in front of the station. The new owners were caught "passing off" their generic gas as Getty gas when long-time Getty customers stopped at the station to refill their tanks and were told that the station did not accept Getty credit cards! The federal court issued an injunction ordering the miscreants to take down all references to Getty and its mark.

III. Trade Dress Defined

Trade dress is somewhat different. Trade dress involves 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.” *Gurglepot, Inc. v. New Shreve, Crump & Low LLC*, 153 F. Supp. 3d 441, 448 (D. Mass. 2015). Trade dress has also been defined as “the design and appearance of a product together with elements making up the overall image that serves to identify the product presented to the consumer.” *Hillside Plastics, Inc. v. Dominion & Grimm USA, Inc.*, 2018 WL 4537205.

I once had a matter where a major drug store chain decided to sell its own “brand” of cough drops. To try and do so successfully, it decided to copy the packaging of an extremely well known and popular cough drop manufacturer. The two “brands” were literally displayed right next to each other on the drug stores’ shelves. Confusion as to source was inevitable. Fortunately, the drug store conceded this point upon challenge, avoiding a lengthy court battle. It changed its package so it did not resemble the package of the cough drop manufacturer.

IV. Design Itself is Not Fine

Trade dress protection is intended to protect the identifiers of a product’s source. Trade dress can be manifested as a product’s packaging. A company claiming a trade dress violation must demonstrate to the court that its product’s dress is, in fact, distinctive inherently, or by acquiring distinctiveness, also known as “secondary meaning.” In this context, “inherently” means that the intrinsic nature of the product identifies a particular source. A product’s design or configuration, standing alone, has been found to never be inherently distinctive. *Wal-Mart*, 529 U.S. at 213-214 (product’s design/configuration trade dress can never be found inherently distinctive). The Supreme Court opined that “a product’s design-based trade dress ‘is distinctive, and therefore protectable, only upon a showing of secondary meaning.’” Secondary meaning occurs when “in the minds of the public, the primary significance of a [mark] is to identify the source of the product rather than the product itself.” *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844, 851 n. 11 (1982). Unlike trade dress, “[t]he 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.” *Wal-Mart* at 212. *Wal-Mart* went on to state:

Consumers are therefore predisposed to regard these symbols as indication of the producer, which is why such symbols “almost automatically tell a customer that they refer to a brand.”

Id. “In the case of product design...we think consumer predisposition to equate the feature with the source does not exist.” *Id.* at 213. The Court went on:

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 source, but to render the product itself more useful or more appealing.

Id. “[W]here product design is concerned we have little confidence that a reasonable clear test [for inherent distinctiveness] can be devised.” *Id.* at 213.

Product packaging, however, may be inherently distinctive. *Smartling, Inc. v. Skawa Innovation Ltd.*, 358 F.Supp.3d 124, 148 (D. Mass. 2019). Acquired distinctiveness or secondary meaning

indicates that a product's "dress" identifies its source in the public's mind, rather than identifying the product itself. *Id.* at 148. Indirect proof of secondary meaning requires consideration of the following factors:

- 1) the length and manner of the use of the trade dress; 2) the nature and extent of the advertising and promotion; 3) the efforts used to promote a conscious connection between the public, the trade dress, and the source; 4) the products' established place in the market (possibly through continuous use in the market); and 5) proof of intentional copying.

Genesis Strategies, 50 F.Supp.3d at 67 (D. Mass. 2014). The inquiry is highly fact intensive. As to the fifth factor set forth above, in the context of a competitor copying the design and look of a website, the Court has found:

There is... little doubt that [defendant] copied other aspects of Smartling's trade dress. Although it may be that [defendant] copied Smartling's website out of mere laziness, it would not be unreasonable for a jury to conclude that [defendant] copied features of Smartling's [sic] website because they viewed [it] as distinctive and attractive to consumers.

Id. at 150. The Court in *Smartling* found that there was enough evidence to show a possible likelihood of confusion.

V. Secondary Meaning is Primary

The proof of the existence of secondary meaning, or acquired distinctiveness, "entails vigorous evidentiary requirements." *Yankee Candle Co., Inc. v. Bridgewater Candle Co., LLC*, 259 F.3d 25, 43 (1st Cir. 2001). These include proof of "actual confusion," as well as intentional copying of the trade dress at issue. Other items of proof include, but are not limited to: similarity of the goods; juxtaposition of advertising; and classes of purchasers. In *Big Top USA v. Wittern Group*, 998 F. Supp. 30 (D. Mass 1998) the Federal District Court refused to grant preliminary injunctive relief to the plaintiff who made giant gum ball machines. I represented the defendant accused of copying the design of said machines, and selling same in competition with the plaintiff. After taking live testimony from the parties, the Court made the following findings:

...the Court concludes that Big Top has failed to demonstrate a likelihood of confusion: On Big Top's side of the ledger is the following evidence: (1) [Defendant's] intent to copy Big Top's trade dress...(2) the similarity of the fanciful trade dress; (3) the similarity of the product; and (4) the similarity of the channels of trade, with both sides marketing their gumball machine primarily to vendors.

For the Defendant "copier's" side, the Court found:

...the following factors: (1) the high level of sophistication of the vendors; (2) compelling evidence that the vendors were never confused and fully understood that [Defendant] manufactured [similar machines]; (3) little possibility that consumers are likely to be confused based on the large differential in price between the machines; (4) the relative weakness of the Big Top trade dress given Big Top's new in the gumball market; and (5) the lack of evidence that Big Top had established goodwill in the marketplace.

Big Top USA at 53-54. Ultimately, the Court refused to issue the requested injunction which would have effectively put the Defendant out of the market. In so doing, the Court opined:

The Lanham Act provides protection from those who copy non-functional distinctive trade dress, but it does so only where there is a likelihood of confusion as to source in a relevant market. On this record, the Court cannot conclude that Big Top has established a substantial likelihood of success on the merits of its Lanham Act claim against [Defendant][.]

Id. at 54. The Court noted from the outset that copying per se is not illegal: "One has the right to ape – if he can – the unpatented product." *Hypertherm, Inc. v. Precision Prods., Inc.* 832 F.2d 697, 700 (1st Cir. 1987). "Copying is not only good, it's a federal right- a necessary complement to the patent system's grant of limited monopolies." Id. at 42. The Court noted that not all trade dress is "automatically" protected from copying. In fact:

trademark law allows a producer to prohibit the copying of a product feature which serves as a signifier of source in order to preserve his reputation and the goodwill consumers have for his brand. On the other hand, effective competition and the penumbra of the patent laws require that competitors be able to slavishly copy the design of a successful product.

Id., citing *Thomas & Betts Corp. v. Panduit Corp.*, 65 F.3d 654, 658 (7th Cir. 1995).

VI. Which Test is Best for Trade Dress?

In a subsequent 1998 First Circuit case, the appellate court pointed out:

Courts have struggled with whether the Abercombie test, originally designed for words, should be imported wholesale into that specialized area of trade dress claimed to come from product design.

I.P. Lund Trading ApS v. Kohler Co., 163 F.2d 27, 39 (1st Cir. 1998). The Lund Court also opined that: "The functionality doctrine prevents trademark law, which seeks to promote competition by protecting a firm's reputation, from instead inhibiting legitimate competition by allowing a producer to control a useful product feature." Id. at 36. It is critical to note that under the Lanham Act, the owner of a product who wants to preserve it via trade dress can register the design with the United States Patent and Trademark Office. Such registration serves as constructive notice of the registrant's ownership of the trade dress. Moreover, in a trade dress legal fight:

The effect of registration under the Lanham Act...is to shift the burden of proof from the plaintiff, who in a common law infringement action would have to establish his right to exclusive use, to the defendant, who must introduce sufficient evidence to rebut the presumption of plaintiff's right to such use.

Keebler Co. v. Rovira Biscuit Corp., 624 F.2d 366, 373 (1st Cir. 1980). Thus, registration should be attempted for all trade dress.

About Andrew P. Botti

Andrew represents corporations, smaller businesses, and family owned and operated enterprises in complex business and employment-related issues. He advises management and business owners/operators on business disputes, shareholder issues, employee discrimination claims, and commercial litigation matters. He has tried numerous cases to verdict in both state and federal court, and has appeared before various administrative and legislative agencies such as the Massachusetts Commission Against Discrimination. Andrew has testified before the Joint Committee on Labor and Workforce Development of the Massachusetts legislature regarding the efficacy of "An Act Relative to Non-competition Agreements," and has been actively involved in the debate over recent efforts to eliminate non-competes in their entirety.



Andrew was appointed to the Massachusetts Economic Development Planning Council by Governor Charlie Baker. The Council's mission was to develop a written comprehensive economic development policy for Massachusetts, and construct a strategic plan for its implementation. The plan was eventually signed into law by the Governor.

In December 2014, Andrew was appointed by Governor-Elect Charlie Baker to the Baker-Polito Transition Team Subcommittee on Jobs and the Economy. In this capacity, Andrew helped prepare findings and recommendations for the new administration.

Andrew is currently a member of the Board of Directors of AIM, the Associated Industries of Massachusetts. Founded in 1915, AIM is the oldest and largest statewide association working to serve and foster the business interests of Massachusetts employers. He formerly served as Chairman of the Board of SBANE, the Smaller Business Association of New England, from 2009 - 2011. SBANE (now known as the New England Business Association) was founded in 1938 to promote and foster the interests of smaller businesses throughout the 6 state region.

Andrew received his J.D. from Northeastern University (1991) and B.A. from Columbia University (1983). He was previously a litigation partner at Donovan Hatem LLP, and a Senior Associate at Burns & Levinson, LLP.