



# Product Configuration Trade Dress

#designlaw2016

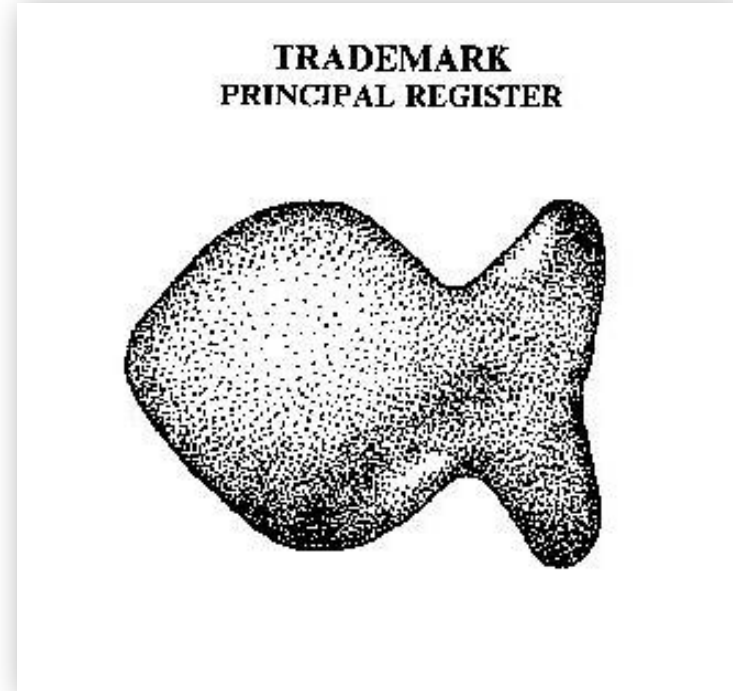
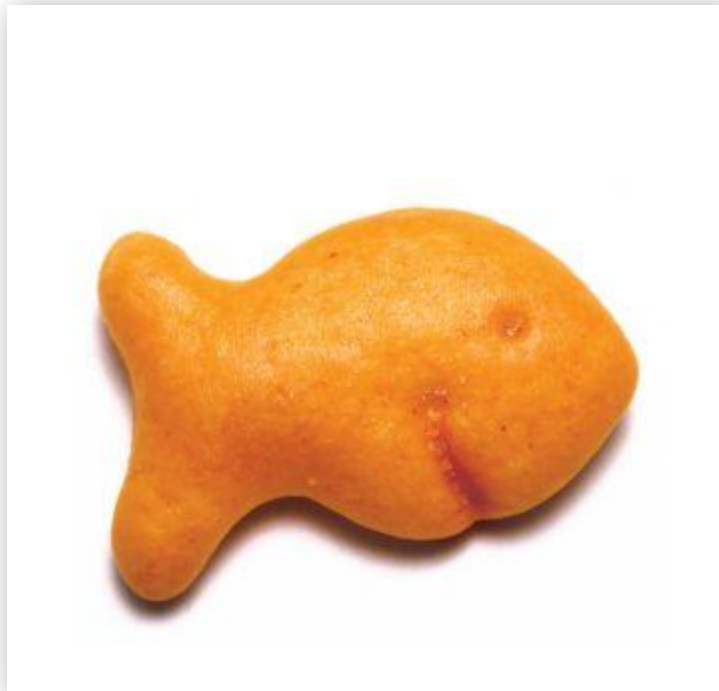


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INTELLECTUAL PROPERTY LAW

# Trade Dress – Infringement

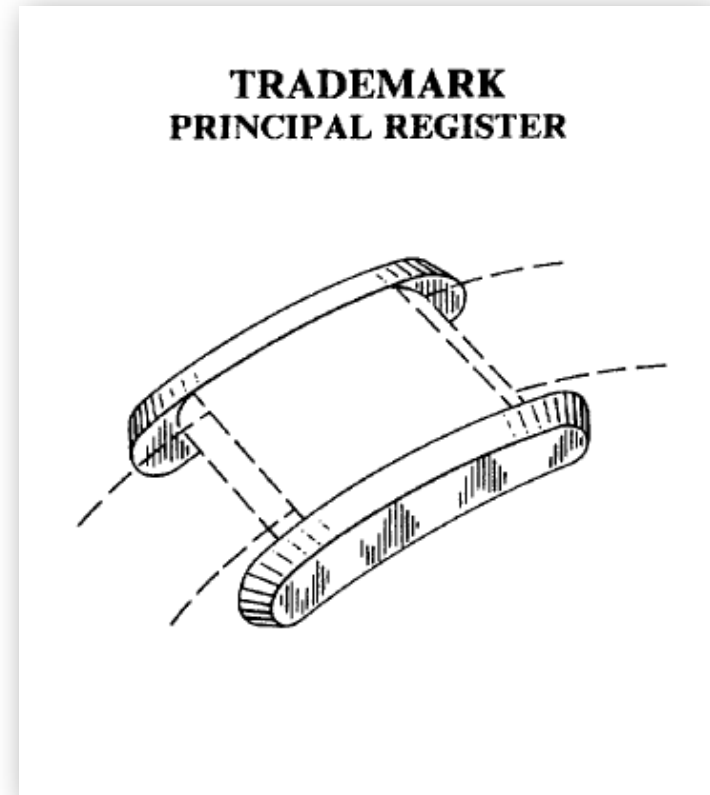
## Erik S. Maurer

# Pepperidge Farm's Goldfish Cracker Design



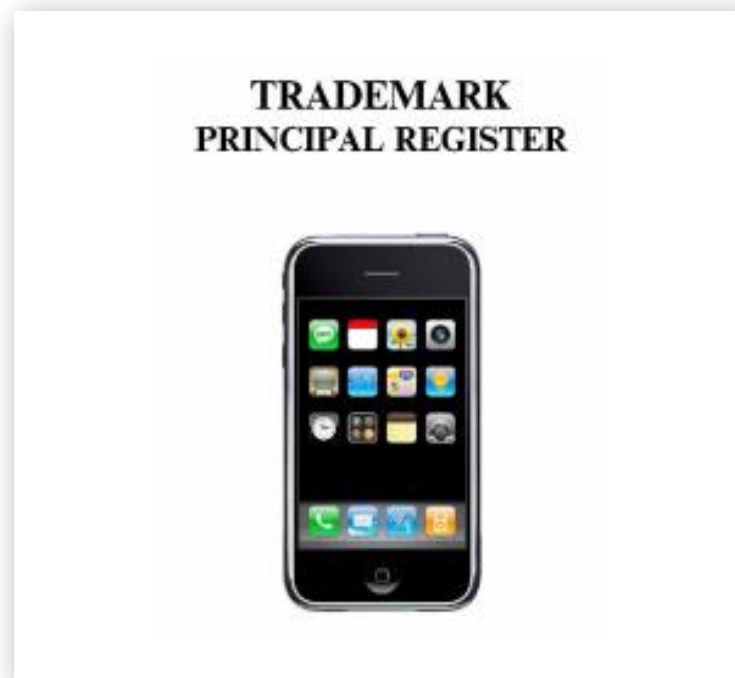
*Nabisco, Inc. v. PF Brands, Inc.*, 50 F. Supp. 2d 188, 205  
(S.D.N.Y. 1999) *aff'd*, 191 F.3d 208 (2d Cir. 1999)

# Cartier Tank Watch Design



*Cartier, Inc. v. Four Star Jewelry Creations, Inc.*, 348 F.  
Supp. 2d 217 (S.D.N.Y. 2004)

# Apple iPhone Design



*Apple, Inc. v. Samsung Electronics Co., Ltd.*, No. 11-CV-01846, 2014 WL 4145499 (N.D. Cal. Aug. 20, 2014)



# Initial Considerations

- Federal, State and Common Law rights can co-exist
- Federal, State and Common Law causes of action co-exist
- Secondary meaning is particularly important because primary meaning of a product configuration is generally the product itself
- Two primary theories of liability:
  - Infringement: consumer confusion
  - Dilution: associations that erode a famous mark

# Infringement

## Design Patent

vs.

## Trade Dress

- CAFC controls
- Right to exclude flows from patent grant
- Substantial similarity test /overall visual impression
- Prior art informs EG analysis and validity
- Protects property right

- Regional circuits control
- Rights arise from use, not just registration
- Multi-factor consumer confusion test
- “Prior art” informs strength of the mark
- Protects consumers



# Infringement

## A. Ownership of Relevant Trademark(s)

1. Registration – presumption of ownership
2. Acquired distinctiveness / secondary meaning

## B. Likelihood of Consumer Confusion

1. Forward Confusion / Reverse Confusion



## Likelihood of confusion factors (*Polaroid*, 2d Circuit)

1. Strength of the asserted mark(s)
2. Similarity of the asserted marks and accused designs
3. Proximity of the parties' products in the marketplace
4. Bridging the gap between plaintiff's and defendant's products
5. Actual confusion
6. Defendant's intent
7. Quality of accused products
8. Sophistication of consumers



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# Typical Infringement Proofs

- Expert Testimony
  - Survey evidence
    - Strength of the mark
    - Confusion
  - Marketing analyses
- Actual Consumer Confusion
- Copying Evidence / Defendant's Intent
  - Strong marks more likely to be copied
  - Similarity of asserted and accused marks

## Some things to think about...

- Have a strategy: (A) initial design protection, (B) auditing for and building trade dress rights, (C) registering and enforcing marks
- Use care in defining the mark
  - Protectability
  - Infringement
- Know your forum before filing
  - Especially re. defenses and treatment of evidence
- Leverage the story in the marketplace



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Thank you

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# Acquired Distinctiveness for Trade Dress

Charles H. Hooker III

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1. Registration – presumption of protectable rights in a trade dress.
2. Unregistered trade dress – must show distinctiveness.



# Spectrum of Distinctiveness



<b>Fanciful</b>	Has no other meaning than as a mark. E.g., Google, Kodak.	<p>More distinctive</p>  <p>Less distinctive</p>
<b>Arbitrary</b>	Common meaning but no relation to the goods or services. E.g., Apple.	
<b>Suggestive</b>	Suggests a quality or characteristic of the goods or services, but requires a "mental leap." E.g., Family Market.	
<b>Descriptive</b>	Describes the goods or services. E.g., Food Fair.	
<b>Generic</b>	Identifies the type, kind, or "genus" of goods or services. E.g., bag, box, magazine.	Neither distinctive nor protectable





- “Trade Dress” is “a category that originally included only the packaging, or ‘dressing,’ of a product, but in recent years has been expanded . . . to encompass the design of a product.” 529 U.S. 205, 209 (2000).
- “[D]esign, like color, is not inherently distinctive.” *Id.* at 212.
- “[I]n an action for infringement of unregistered trade dress . . . , a product’s design is distinctive, and therefore protectible, only upon a showing of secondary meaning.” *Id.* at 216.



# Not All Trade Dress Is Product Design



“There is no persuasive reason to apply to trade dress a general requirement of secondary meaning that is at odds with the principles generally applicable to infringement suits under § 43(a).” *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 770 (1992).



# Secondary Meaning



Trade dress has developed secondary meaning or “acquired distinctiveness” when its **“primary significance, in the minds of the public, is to identify the product’s source rather than the product itself.”** *Wal-Mart Stores v. Samara Bros.*, 529 U.S. at 211.



# Secondary Meaning



“To acquire a secondary meaning in the minds of the buying public, an article of merchandise when shown to a prospective customer must prompt the affirmation, ‘That is the article I want because I know its source,’ and not the negative inquiry as to ‘Who makes that article?’ In other words, the article must proclaim its identification with its source, and not simply stimulate inquiry about it.” *Herman Miller, Inc. v. Palazzetti Imports & Exports, Inc.*, 270 F.3d 298, 311 (6th Cir. 2001).



# Test for Secondary Meaning

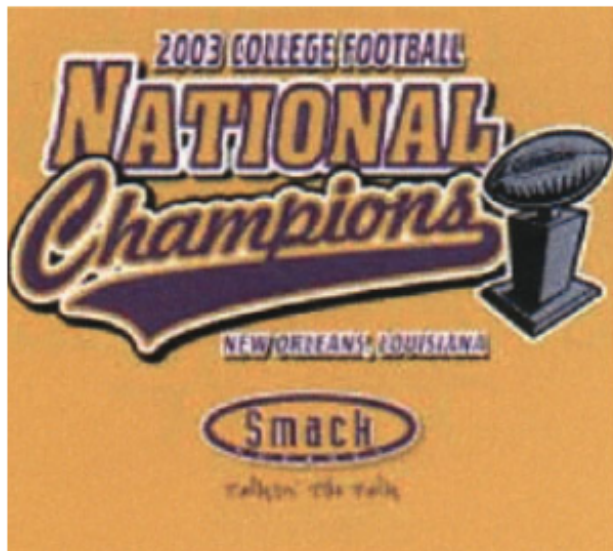


1. Length and manner of use of the trade dress;
2. Volume of sales;
3. Amount and manner of advertising;
4. Nature of use trade dress in newspapers and magazines;
5. Consumer-survey evidence;
6. Direct consumer testimony;
7. Defendant's intent in copying the trade dress.

*Bd. of Supervisors for Louisiana State Univ. Agric. & Mech. Coll. v. Smack Apparel Co.*, 550 F.3d 465, 476 (5th Cir. 2008).



# Trade Dress With Secondary Meaning



*Smack Apparel Co.*, 550 F.3d at 476.



*adidas Am., Inc. v. Skechers USA, Inc.*,  
149 F. Supp. 3d 1222, 1235 (D. Or. 2016) (on appeal).



# No Secondary Meaning



*Sazerac Co. v. Skyy Spirits*, 1995 WL 814250 (E.D. La. 1995), *aff'd* 1996 U.S. App. LEXIS 22908 (5th Cir. July 29, 1996).



*Olem Shoe Corp. v. Washington Shoe Co.*, No. 09-23494-CIV, 2011 WL 6202282, at \*21 (S.D. Fla. Dec. 1, 2011), *aff'd* 591 F. App'x 873 (11th Cir. 2015).



# Failure to Enforce



*Herman Miller, Inc. v. Palazzetti Imports & Exports, Inc.*, 270 F.3d 298, 328 (6th Cir. 2001) (remanded to district court to consider whether 40 years of non-enforcement, in the face of hundreds of imitators, served to so weaken any protectable right to the point where no secondary meaning existed).



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# Functionality

Joe Hamid

October 14, 2016

Design Law Symposium 2016

# Functionality – Test

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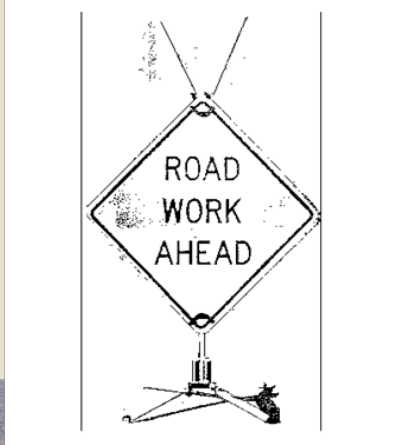
- Existence of expired utility patent
- Utilitarian advantages touted in advertising
- Availability of alternative designs
- Is design one of few ***superior*** designs
- Manufacturing advantages



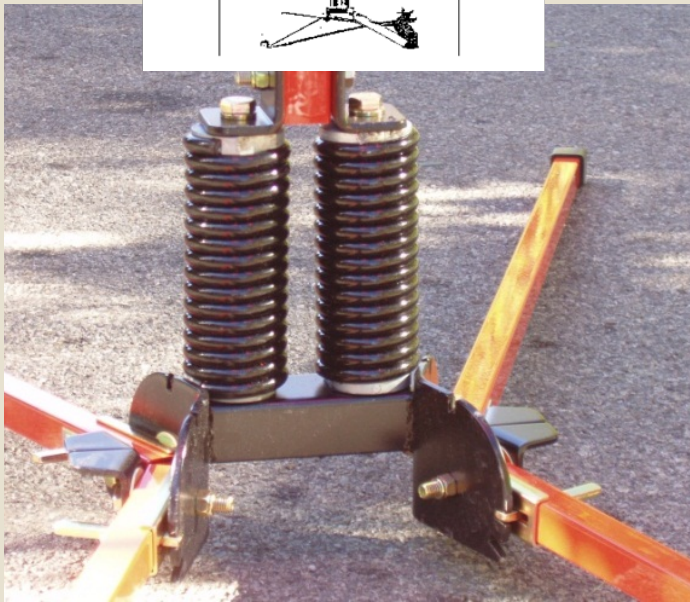
*In re Morton-Norwich,*  
671 F.2d 1332 (C.C.P.A. 1982)

# Functionality – Test

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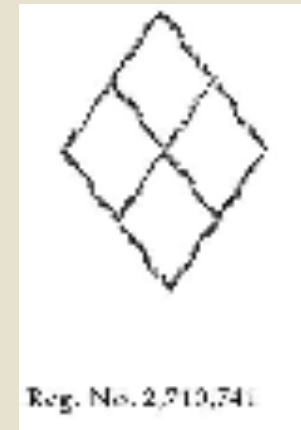
- Is the feature **essential** to the use or purpose of the product?
- Does the feature affect the cost or quality of the product?
- Would granting exclusivity through trademark put competitors at risk of a significant non-reputation related disadvantage?



*TrafFix Devices v. Marketing Displays, 532 U.S. 23 (2001)*

# Functionality – Test

- Existence of utility patent, expired or not
- Utilitarian properties of unpatented elements
- Advantages touted in advertising
- Availability of alternative designs
- Effect on cost or quality



*Georgia-Pacific Consumer Prods v. Kimberly-Clark,*  
647 F.3d 723 (7th Cir. 2011)

# Functionality

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Apple iPhone 3GS



Galaxy S i9000



# Aesthetic Functionality in the 9th

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Are the features that defendant is imitating an “important ingredient in the commercial success of a product” (unprotected) or a “mere arbitrary embellishment . . . primarily adopted for the purposes of identification” (protected)?



*Pagliero v. Wallace*,  
198 F.2d 339 (9th Cir.1952)

# Aesthetic Functionality in the 2nd

“[W]here an ornamental feature is claimed as a trademark and trademark protection would significantly hinder competition by limiting the range of adequate alternative designs, the aesthetic functionality doctrine denies such protection.”



*Wallace Int’l Silversmiths, Inc., v. Godinger Silver Art Co.*,  
916 F.2d 76 (2d Cir. 1990)

# Aesthetic Functionality / Fair Use

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Louboutin's red outsole mark is protectable ONLY when the red sole contrasts with a shoe of a different color. YSL's all red shoes do not "use" the trademark and therefore do not infringe. Court did not reach aesthetic functionality or fair use.

*Christian Louboutin S.A. v. Yves Saint Laurent*,  
696 F.3d 206 (2d Cir. 2012)

# Proving or Disproving Functionality

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- Market survey – what do others in the relevant market use?
- Marketing/advertising – what do parties claim about feature at issue in their promotional material?
- Evidence concerning adoption of feature – why was it adopted?



# Town Hall Discussion

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# Reception

## Faculty Conference Center

### 5<sup>th</sup> Floor