

A Guide to Trade Dress

By

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1. Legal Basis

A trademark in the case of goods (or a service mark in the case of services) is any word, name, symbol or device or combination thereof either used or intended to be used by a person to identify and distinguish his or her goods or services from those of others and to indicate their source of origin.

Regardless of the form that a trademark takes, it must be used in a way that creates a separate commercial impression on the viewer or listener, apart from other material used with it. For example, if used on the label of a product, the trademark must stand out separately and impress the viewer as an indication of origin of the goods, apart from the other elements of the label.

Trade dress, such as the shape of a bottle of perfume, may be protected as a trademark if the shape makes a separate commercial impression and its impact on the consumer is primarily to identify or distinguish the perfume and not merely to serve as decoration. In other words, trade dress is but one of the many forms that a trademark can take.

Likewise, the configuration of a product, namely, its design or shape, may identify its source of origin. If so, the configuration is a trademark. In order to make this determination, two issues must be considered. The first issue has to do with functionality and the second has to do with distinctiveness. These two issues should be considered separately in any configuration analysis.

2. General Principles

The first step is to make a determination regarding the utilitarian functionality of the configuration. While the functionality of the configuration of products is a continuum ranging from little or no functionality to the extremely functional, there are three distinct levels of functionality that must be considered: nonfunctional; merely de facto functional; and de jure functional.

Nonfunctional means that the configuration serves no utilitarian end. If the configuration is nonfunctional, the analysis shifts to distinctiveness that is discussed below.

If a configuration is de facto functional, or functional as a matter of fact (as opposed to as a matter of law), it means that the product design or shape is directed to the performance of a function. For example, the design or shape of a spray bottle may be directed to the performance of the function of holding and spraying liquid. The design or shape does, in fact, have function and, therefore, would be considered at least de facto functional. If the configuration does serve a utilitarian function, then it must be determined whether this functionality is de jure functionality or merely de facto functionality.

De jure functional means that the configuration is functional as a matter of law. A configuration is functional as a matter of law when the design or shape is essential to the use or purpose of an object or if it affects the cost or quality of the object. If something is de jure functional it cannot be a trademark because of the need to keep the configuration available for competitors to use. Showings of acquired distinctiveness will not overcome a finding of de jure functionality. If the

configuration is nonfunctional or is de facto functional, the trademark is either inherently distinctive or has acquired distinctiveness.

A discussion of “functionality” is always in reference to the design or shape of the product (in the sense of its appearance) and not the product itself. While the emphasis regarding functionality should be on the overall design or shape of the product, it is sometimes helpful to analyze the configuration from the standpoint of its various features. Care must be taken, however, for in the final analysis a configuration must be considered as a whole when determining whether it is a trademark. There are various sources and items of evidence that are probative of this determination.

The existence of a utility patent may disclose the utilitarian advantage of a particular design or shape of a product. It is important to read the patent carefully to determine if it is actually the configuration that is the subject of the patent. If it is not, the probative value of the patent as evidence of functionality is diminished. Note that a design patent would not support the proposition that the configuration is functional since design patents do not protect the utilitarian functions of the design. The ownership of a design patent in and of itself would not establish that the configuration is nonfunctional. The existence of any patents involving the configuration is probative. The existence of any patents involving similar configurations is likewise probative.

Advertising touting the utilitarian aspects of a product’s design or shape would support a claim of de jure functionality.

The availability of alternative product design or shapes would indicate that the configuration is only de facto functional. On the other hand, the unavailability of alternative product design or shapes would indicate that the configuration is de jure functional.

If the product design or shape results from a comparatively simple or cheap method of manufacturing the article, this would indicate that the configuration is de jure functional. This is the case since this product design or shape must be made available for others to use if they are going to compete effectively.

Furthermore, the inclusion of a minor feature that is not utilitarian but is still necessary to competitors, will not change the functional nature of the configuration since trademark rights would extend to the entire configuration.

As stated above, the question of distinctiveness is separate from the question of functionality. For example, a configuration that is inherently distinctive cannot be a trademark if it is de jure functional. That is, because of considerations of competition, the configuration, as a matter of law, will not be recognized as a mark. This is similar to the way the law will not recognize generic terms as trademarks even though extensive evidence of acquired distinctiveness may be submitted.

On the other hand, a configuration that is nonfunctional might not be recognized as a trademark absent a showing of acquired distinctiveness due to the fact that it is not inherently distinctive. The distinctiveness of a trademark turns on how the purchasing public would perceive the

configuration. That is, would the purchasing public immediately recognize the configuration as being a trademark (inherently distinctive) or would it only be so recognized because of extensive sales, advertising, etc. (acquired distinctiveness).

A configuration is inherently distinctive as a trademark when it is an immediate indicator of the source of origin or sponsorship of a product. Evidence of inherent distinctiveness often includes (1) the absence of similar configurations in the marketplace, (2) instant and enormous commercial success of the product and (3) design awards the product has received for its configuration.

A configuration acquires distinctiveness as a trademark when it becomes a distinctive indicator of the source of origin or sponsorship of a product. Evidence of acquired distinctiveness often includes (1) how long the configuration has been in use as a trademark, (2) the type and amount of advertising of the configuration a trademark and (3) the effort, if any, to associate the configuration with the source of origin or sponsorship of a product. This evidence may include specific dollar sales under the configuration, advertising figures, samples of advertising, consumer or dealer statements of recognition of the configuration as a trademark, surveys and any other evidence that establishes the distinctiveness of the configuration as an indicator of source of origin or sponsorship. The fact that a configuration has been copied is also evidence of acquired distinctiveness, provided the configuration is not de jure functional.