Look and Feel Trademark Protection in the United States

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Trademark vs. trade dress

Trademark

Trade dress

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Definition of trade dress

- Trade dress = total image of product
  - Includes features such as size, shape, color or color combinations, texture, graphics, even sales techniques and design of product
  - Elements combine to create the whole visual image presented to customers
  - Originally limited to product packaging, *i.e.*, product "dressing"

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Forms of design protection

- Trade dress
  - Must indicate source of goods/services
  - No filing deadline
  - Protection continues as long as use continues
  - Infringement proven by "likelihood of confusion"

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Forms of design protection

- Copyright
  - Must be original expression fixed in tangible medium
  - No filing deadline
  - Protection shorter of 95 years from first publication or 120 years (if work made for hire)
  - Infringement proven by copying (access + substantial similarity)

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Forms of design protection

- Design patent
  - Must be novel, original, ornamental, not obvious, and not primarily functional
  - 1 year deadline to apply
  - Protection lasts 14 years from issuance
  - Infringement proven if ordinary observer finds designs are same

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Source of trade dress protection

- Lanham Act, 15 U.S.C. §§ 1051, *et seq*.
- Protected as a "symbol" or "device"
  - Section 32(1) protects registered TMs
  - Section 43(a) protects unregistered TMs
    - To be protected, unregistered trade dress must designate source, *i.e.*, function like a registered trademark even though registration lacking

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Elements of trade dress infringement claim

1. Valid, protectable trade dress

   -Distinctive

   -Non-functional

2. Priority
3. Likelihood of confusion

- Similar to trademark infringement

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Likelihood of confusion

1. Strength of plaintiff's trade dress
2. Similarity of parties' trade dress
3. Similarity of parties' goods/services
4. Similarity of parties' distribution channels
5. Sophistication of consumers
6. Actual confusion
7. Defendant's intent

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Two Pesos v. Taco Cabana

505 U.S. 763 (1992)

Taco Cabana

Two Pesos

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Two Pesos trade dress

- "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 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."

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Two Pesos v. Taco Cabana

Challenge to describe trade dress

- Software that "produced a calcium scoring and diagnostic report that was proprietary, unique, and distinctive in the medical imaging applications industry" not a sufficient description
- Website with "high-end three-dimensional graphic art" and "original and innovative artwork of superior quality" also not sufficient
  - Trade dress claims vulnerable to dismissal if complaint does not describe in detail

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Two Pesos and secondary meaning

- Is proof of secondary meaning required?
  - Secondary meaning = consumers understand descriptive words refer to a particular source
- Apply trade dress to spectrum of distinctiveness
  - Held: If inherently distinctive (*i.e.*, suggestive, arbitrary, or fanciful), no secondary meaning required
  - If not inherently distinctive (*i.e.*, descriptive), need to show secondary meaning
  - Either way, distinctive trade dress is protectable if criteria is met

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Spectrum of distinctiveness

Inherently Distinctive		**Not Inherently Distinctive**	**No Distinctiveness**
No Secondary Meaning Required		Secondary Meaning Required	No Trademark Significance
Arbitrary And Fanciful	Suggestive	Descriptive, Geographic, Personal Name	Generic

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SOFTWARE™


Wal-Mart v. Samara Brothers

529 U.S. 205 (2000)

Samara Brothers

Wal-Mart

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Wal-Mart v. Samara Brothers

- Held: product design protectable only if becomes distinctive through secondary meaning
- Copyright or design patent available to protect producer of design trade dress who can't show secondary meaning
- Distinguished from *Two Pesos* because restaurant trade dress more like product packaging
- In close cases, courts err on side of categorizing trade dress as product design, requiring secondary meaning

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Wal-Mart and software trade dress

- Software trade dress usually requires secondary meaning
  - "The trade dress claim [involving the parties' interfaces] should be viewed as arising out of the design of plaintiff's interface, and thus requires the plaintiff to demonstrate that its interface has obtained secondary meaning in the minds of consumers." *Computer Access v. Catalyst* (N.D. Calif. 2001)
- Color elements always require secondary meaning
- Means initial adoption of design is vulnerable to copying under trade dress law

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Functionality

- As with TMs, trade dress cannot be functional
  - Functionality = feature is essential to the use or purpose of the article or affects the cost or quality of article
    - Exclusive use of feature would put competitors at disadvantage
  - Statutory bar
  - Burden on proving nonfunctionality is on plaintiff
  - If trade dress is functional, it is not protected and may be freely copied

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Functionality factors

Courts consider whether:

1. Design yields utilitarian advantage
2. Alternate designs are available
   - Courts want to avoid giving seller patent-like monopoly
3. Advertising touts utilitarian advantages
4. Particular design results from a comparatively simple or inexpensive method of manufacture

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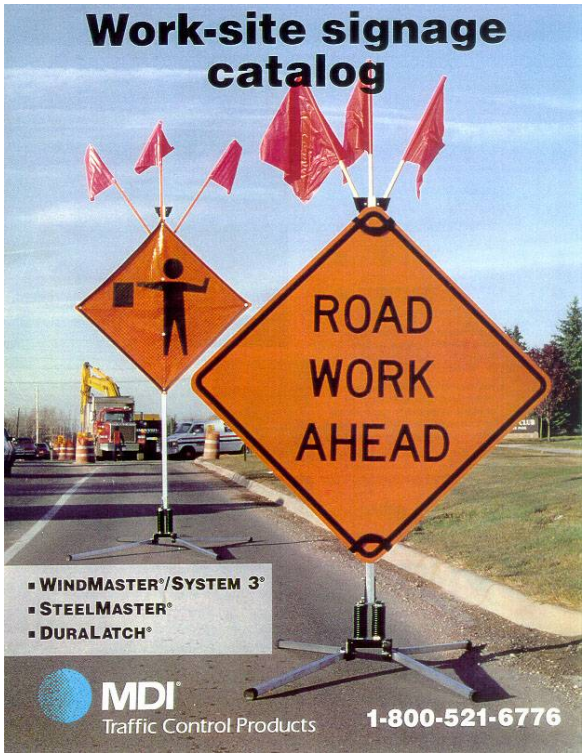
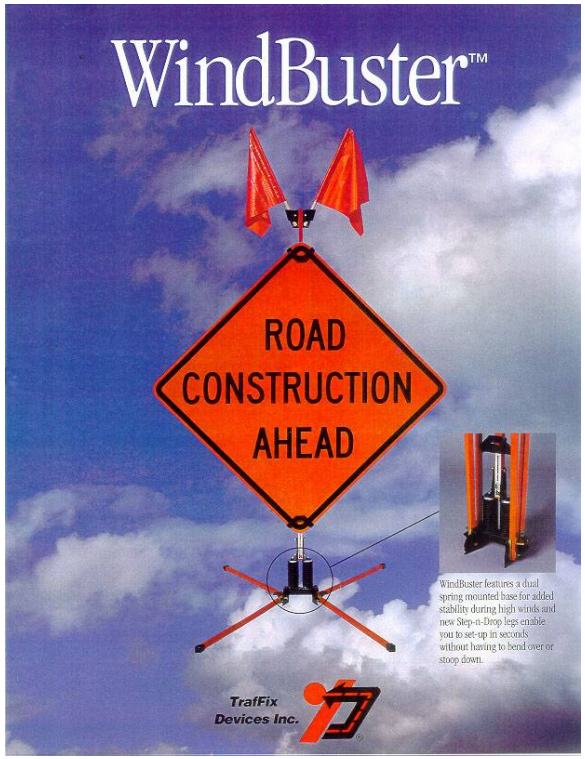
TrafFix v. Marketing Displays

532 U.S. 23 (2001)





Marketing Displays TrafFix

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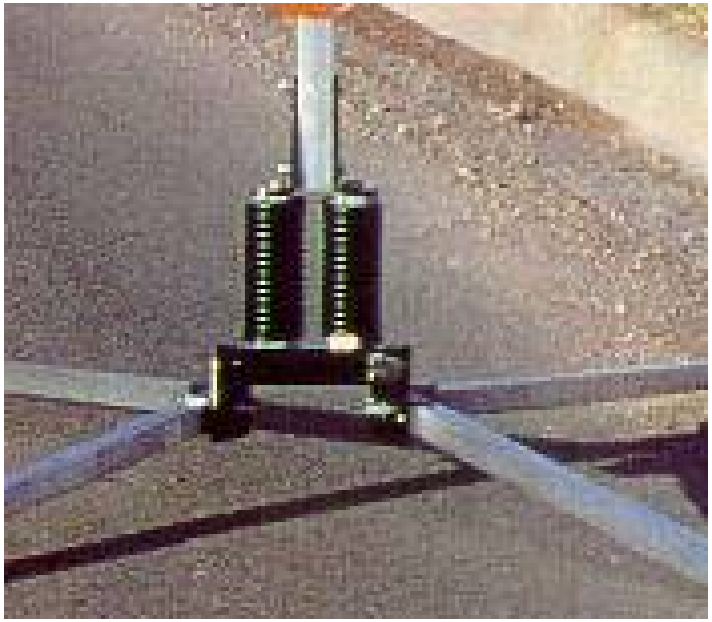
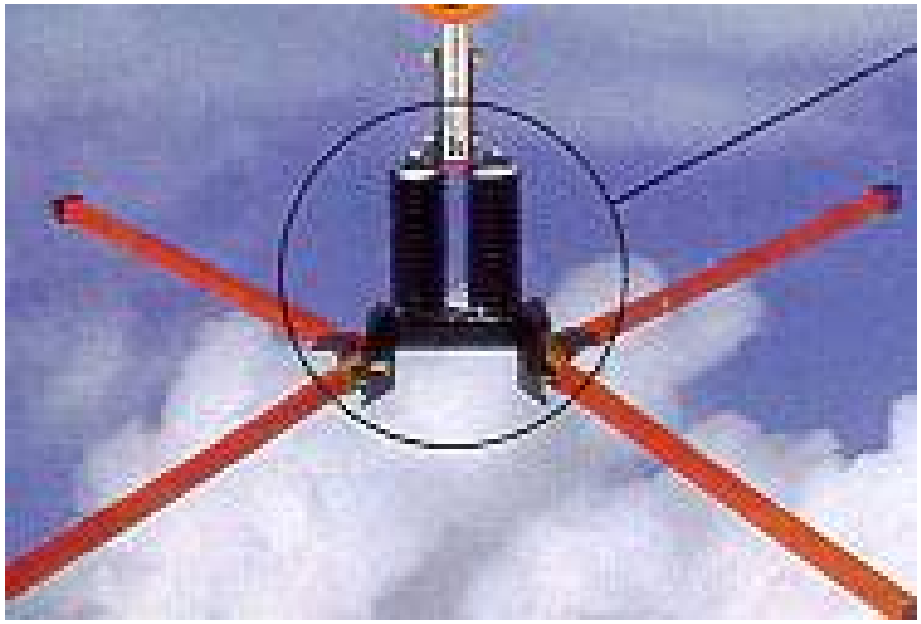
TrafFix v. Marketing Displays



Marketing Displays



TrafFix

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TrafFix v. Marketing Displays

- Utility patent expired; competitor started selling signs with visible spring mechanism
- Former patent holder sued, alleging trade dress protection
- Utility patent = strong evidence trade dress is functional
- Held: Dual springs functional because keep sign upright in heavy wind conditions
  - Therefore, no trade dress protection
    - Copying perfectly legal

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Trade dress protection of GUIs

- Few trade dress cases involving websites or graphical user interfaces (GUIs)
  - *Apple v. Samsung*, 920 F.Supp.2d 1079 and 920 F.Supp.2d 1116 (N.D. Calif. 2013)
  - Forces analogies to *Taco Cabana*, *Wal-Mart*, and *TrafFix*
  - Also analogies to copyright cases
    - *Apple Computer v. Microsoft*, 35 F.3d 1435 (9th Cir. 1994)
    - *Lotus v. Borland*, 49 F.3d 807 (9th Cir. 1995)

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Trade dress infringement?

Samsung Apple

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Questions?

Thank you!

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