

TRADE DRESS LITIGATION

Craig Bachman and Anne Glazer

Lane Powell Spears Lubersky LLP

May 6, 1999

The frequency of trade dress litigation, a species of unfair competition, has increased in recent years. This article will outline the basics of trade dress law, and delve into current controversies about what is protectible trade dress and what is not.

Trade dress is “essentially [a product’s] total image and overall appearance,” Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763, 112 S. Ct. 2753, 2755 n. 1, 120 L.Ed.2d 615 (1992). It is “the total image of a product or service, including such features as size, shape, color or color combinations, texture, graphics, or even particular sales techniques.” Kohler Co. v. Moen, Inc., 12 F.3d 632, 641 n. 11 (7th Cir. 1993). However, such features constitute trade dress only insofar as they serve to identify and distinguish the source of the product or service.

Historically, trade dress referred to product packaging, i.e., the way in which the product was “dressed up” to go to market. The concept has gradually been expanded to include the design of the product itself. In the landmark Two Pesos case, the Court affirmed the plaintiff’s trade dress rights in the overall design of a restaurant. The Court indicated there is no difference in trade dress law between packaging and product configuration. Indeed, subsequent courts have disagreed over whether Two Pesos was a packaging case or a product configuration case.

The courts have found it much more difficult to apply the law to product configurations than to packaging, and some have treated the two differently. First, they have struggled to determine when a product configuration possesses the required “distinctiveness” to be protectible, that is, when it serves to identify and distinguish source rather than merely for aesthetic appeal or utility. Second, they have found that trade dress law for product configurations is in tension with the scheme of the patent laws, which have long held there is nothing illegal about copying an unpatented product design.

A full discussion of copyright and patent law is beyond the scope of this article, but either of these may provide a cause of action for product or package copying. Copyright law protects any original creative expression, including labels and designs; many product sellers have relied upon it to protect their packaging. See, e.g., Quality King Distributors, Inc. v. L’Anza Research Int’l, Inc., 118 S. Ct. 1125, (1998). Copyright law has limited applicability to product configurations because of its relatively strict requirement that the copyrightable portion be “conceptually separable” from the utilitarian features of the product.

WHY HAVE TRADE DRESS CLAIMS BECOME MORE FREQUENT?

Trade dress is governed by the law of trademarks. Courts attempt to treat trade dress the same way as trademarks, particularly since the Court stated in Two Pesos that the Lanham Act provides no basis for distinguishing between the two. 505 U.S. at 773.

Trade dress infringement is a form of unfair competition. It is addressed in the common law of unfair competition and in Section 43(a) of the US Trademark Act of 1946 (the “Lanham Act”), 15 USC § 1125(a). Causes of action for trade dress infringement are also found in state trade practices statutes such as ORS 646.608(1)(b)-(e).

Several factors have combined in recent years to increase the frequency of trade dress claims. The Two Pesos decision resolved a split among the circuits by removing the requirement that plaintiffs prove secondary meaning in every case. This brought the law of trade dress clearly into line with the law of trademarks and has allowed more plaintiffs to prevail. The Court decided Two Pesos against a backdrop of several decades during which practitioners and courts increasingly recognized the applicability of Section 43(a) to ordinary trademark and trade dress claims.

At the same time, the importance to consumers of trademarks and trade dress as indicia of source and of quality has increased. In contrast to the 1970s, when generic brands and price competition were ascendant, the public now relies more upon familiar brands and is often willing to pay a premium for them. The advent of the information society and the concomitant information overload have only accentuated this trend.

Finally, the same trend has increased the attractiveness of “knocking off” popular products. As markets grow increasingly fluid and marketplace successes are made practically overnight, the dominant player sometimes fails to recognize an unserved demand in the market. A competitor, or a company specializing in “knockoffs,” quickly fills the void.

ELEMENTS OF A TRADE DRESS CLAIM

The Lanham Trademark Act does not expressly refer to trade dress, but unfair competition actions under Section 43(a) provide most of the law in this area. Section 43(a) provides,

“Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which

[] is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person

. . . shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.” 15 USC 1125(a)(1).

In actions under this provision (and its predecessors), the courts have formulated the required elements of any trade dress claim. These are:

1. Plaintiff owns a protectible trade dress, i.e.,
 - a. Plaintiff's trade dress is inherently distinctive or has acquired secondary meaning, and
 - b. Plaintiff's trade dress is not functional.
2. Defendant's use of a similar trade dress is likely to cause confusion, to cause mistake, or to deceive as to defendant's affiliation or connection with plaintiff, or as to the origin, sponsorship or approval of defendant's or plaintiff's goods or services.

Inherent distinctiveness

First, the claimed trade dress must be inherently distinctive or have acquired distinctiveness. "Distinctiveness" the ability of the trade dress to serve the function of identifying and distinguishing the source of the product or service. Distinctiveness acquired through long and extensive use of the dress is commonly known as "secondary meaning."

In Two Pesos, the Court held that a plaintiff need not show secondary meaning if its claimed dress is inherently distinctive. Many cases decided before Two Pesos, including in the Second and Ninth Circuits, required plaintiffs to show secondary meaning.

Since Two Pesos, the courts have struggled to define "inherent distinctiveness" for trade dress, particularly for product configurations. Some courts use the traditional trademark distinctiveness analysis. Under this framework, the court places the plaintiff's mark along the following "spectrum of distinctiveness":

Most distinctive: Arbitrary

Terms that bear no relation to the product or service.

Examples: APPLE computer, MARS candy, ADOBE software, and coined terms such as EXXON, KODAK, POLAROID

Inherently distinctive, but less strong: Suggestive

Terms that require some thought or imagination to determine the nature of the product or service.

Examples: COPPERTONE, HULA HOOP, PLAYBOY, ROACH MOTEL

Not inherently distinctive, but can acquire distinctiveness (secondary meaning):

Descriptive

Terms that describe a feature, quality or characteristic of the product or service.

Examples: BEER NUTS, CHAP STICK, HOLIDAY INN, RAISIN BRAN, MCDONALD'S

Not inherently distinctive, and incapable of acquiring distinctiveness: Generic

Terms commonly used to identify the product or service. These are not trademarks at all.

Examples: MULTISTATE BAR EXAMINATION, SHREDDED WHEAT, SUPER GLUE, BABY OIL

The Supreme Court approved the use of these trademark categories in analyzing the distinctiveness of trade dress. See Two Pesos, citing Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4, 9 (2d Cir. 1976) (Friendly, J.) See also Devan Designs, Inc. v. Palliser Furniture Corp., 998 F.2d 1008 (4th Cir. 1993) (furniture design not inherently distinctive); Chevron Chemical Co. v. Voluntary Purchasing Groups, Inc., 659 F.2d 695 (5th Cir. 1981), cert. denied, 457 U.S. 1126 (1982) (label design for ORTHO weed control products inherently distinctive).

The Abercrombie categories work fairly well for analyzing two-dimensional or stand-alone designs, particularly representative ones. For example, the Gerber baby may be suggestive or descriptive for baby food, but the Apple logo is clearly arbitrary for computers. However, the categories do not work so well for most trade dress, particularly product configurations.

Due to this problem, other important tests have emerged. The Federal Circuit asks:

whether [the design] was a "common" basic shape or design, whether it was unique or unusual in a particular field, whether it was a mere refinement of a commonly-adopted and well-known form of ornamentation for a particular class of goods viewed by the public as a dress or ornamentation for the goods, or whether it was capable of creating a commercial impression distinct from the accompanying words.

Seabrook Foods, Inc. v. Bar-Well Foods Ltd., 568 F.2d 1342, 1344 (C.C.P.A. 1977) (oval fish design on frozen vegetables not inherently distinctive.) See also Blau Plumbing, Inc. v. S.O.S. Fix-It, Inc., 781 F.2d 604, (7th Cir. 1986) ("location box" in advertisement showing locations of plaintiff's offices not inherently distinctive), AmBrit, Inc. v. Kraft, Inc., 805 F.2d 974 superseded by 812 F. 2d 1531 (11th Cir. 1986) (appearance of KLONDIKE ice cream bar packaging inherently distinctive.) Commentators widely favor the Seabrook formulation.

The formulation that seems to be gaining favor is that of Stuart Hall Co., Inc. v. Ampad Corp., 51 F.3d 780 (8th Cir. 1995), which applied the Abercrombie factors and and

Seabrook) (red heart design on CARE BEARS teddy bear was not inherently distinctive). This test is for both packaging and configuration cases.

In a controversial decision, the Third Circuit adopted its own analysis for product configuration cases. It held that a product configuration is inherently distinctive if it is (i) unusual and memorable; (ii) conceptually separable from the product so that the consumer will recognize it as a symbol of the product' source, and not merely as a decorative symbol or pattern; and (iii) likely to serve primarily as a designator of origin of the product. Duraco Products, Inc. v. Joy Plastic Enterprises, Ltd., 40 F.3d 1431 (3d Cir. 1994) (“Grecian urn” planter design not inherently distinctive.) Many commentators have viewed this test as effectively requiring proof of acquired distinctiveness, and as too hostile to product configuration plaintiffs. But see Tom W. Bell, “Virtual Trade Dress: A Very Real Problem,” 56 Md. L. Rev. 384, 403 (1997).

The Second Circuit has had an interesting time with this problem. In Knitwaves, Inc. v. Lollytogs Ltd., 71 F.3d 996 (2d Cir. 1995) (“leaf” and “squirrel” designs of children’s sweaters not inherently distinctive), the court applied the last prong of the Duraco test – whether the design is likely to serve primarily as a designator of origin – and considered the plaintiff’s intent in adopting the trade dress. See also Thomas & Betts Corp. v. Panduit Corp., 65 F.3d 654 (7th Cir. 1995) (“Thomas & Betts I”) (essentially requiring acquired distinctiveness); EFS Marketing, Inc. v. Russ Berrie & Co., 76 F.3d 487 (2d Cir. 1996).

District courts within the Second Circuit revolted against Knitwaves. See Krueger Int’l, Inc. v. Nightingale Inc., 915 F. Supp. 595 (S.D.N.Y. 1996) (expressly rejecting Knitwaves and following Stuart Hall); Fun-Damental Too, Ltd. v. Gemmy Indus. Corp., 1996 US Dist LEXIS 3179 (S.D.N.Y. 1996) (novelty bank inherently distinctive; applying Abercrombie.) The Krueger decision was widely applauded, and presents a useful summary of the state of the law.

Then, in 1997, a different panel of the Second Circuit embraced the Seabrook test and added to it the factor of plaintiff’s intent in adopting the design. Landscape Forms, Inc. v. Columbia Cascade Co., 113 F.3d 373, 378 (2d Cir. 1997); P.E. Guerin, Inc. v. Nanz Custom Hardware, Inc., 45 U.S.P.Q. 2d 1524 (S.D.N.Y. 1997) (finding design of custom doorknob inherently distinctive).

See also, Imagineering, Inc. v. Van Klassens, Inc., 53 F.3d 1260 (Fed. Cir.), cert. denied, 516 U.S. 909, 116 S. Ct. 277 (1995) (holding furniture design inherently distinctive); Vornado Air Circulation Systems, Inc. v. Duracraft Corp., 58 F.3d 1498 (10th Cir. 1995), cert. denied, 516 U.S. 1067, 116 S. Ct. 753 (1996) (fan grill design not inherently distinctive).

Secondary Meaning

If the claimed trade dress is not inherently distinctive, it may nonetheless be protected if it has acquired secondary meaning. Trade dress acquires secondary meaning “when the purchasing public associates the dress with a particular source.” Vision Sports, Inc. v. Melville Corp., 888 F.2d 609 (9th Cir. 1989). The source may be anonymous, as long as it is recognized as a single source.

A plaintiff may establish secondary meaning through direct evidence such as purchaser testimony or a survey. It may also be established indirectly by proof that plaintiff’s use of the dress has been exclusive, the length of plaintiff’s use and the degree and manner of plaintiff’s advertising. Sunbeam Products v. West Bend Co., 123 F.3d 246 (5th Cir. 1997) (likelihood of success in showing “American Classic Mixmaster” mixer had secondary meaning, due to substantially exclusive and continuous use for over 17 years). Proof of copying is also evidence of secondary meaning. See also Vision Sports, Inc.; Leatherman Tool Group, Inc. v. Cooper Indus., Inc., 44 U.S.P.Q. 2d 1275 (D. Or. 1996).

At least one court has established a different and higher standard for proving secondary meaning in a product configuration case. Thomas & Betts I.

Non-Functionality

Plaintiff’s trade dress must also be non-functional. Some courts, including the Ninth Circuit, require the plaintiff to prove non-functionality in its case in chief. Interactive Network, Inc. v. NTN Communications, Inc., 875 F. Supp. 1398 (N.D. Cal. 1995); Leatherman Tool Group, Inc. Some place the burden of proving functionality on defendant.

A design is functional if (1) it is one of a fixed number of “equally efficient” options accessible to competitors and (2) free competition would be unduly burdened if the design received trade dress protection. Two Pesos, 112 S. Ct. at 2760. A feature is functional if it is essential to the use or purpose of the article or if it affects the cost of quality of the article. Inwood Laboratories, Inc. v. Ives Laboratories, Inc., 456 U.S. 844, 850 n.10 102 S. Ct. 2182, 72 L.Ed.2d 606 (1982); International Jensen, Inc. v. Metrosound U.S.A., Inc., 4 F.3d 819, 823 (9th Cir. 1993); Vision Sports, Inc., 888 F.2d at 614. Recent cases have tended to focus on whether the design confers a significant competitive advantage. Landscape Forms, Inc. v. Columbia Cascade Co., 70 F.3d 251 (2d Cir. 1995).

Functionality may be determined by reference to four factors: (a) an expired utility patent disclosing utilitarian advantages of the design; (b) the extent of advertising which tours the utilitarian advantages of the design; (c) the availability of a reasonable number

of design alternatives, and (d) whether the design results from a comparatively simple or cheap method of manufacture. Leatherman Tool Group, Inc.

A design that incorporates functional features may be nonfunctional if it is an “arbitrary combination of functional features, the combination of which is not functional.” Two Pesos. In Sunbeam Products, Inc., the Fifth Circuit affirmed a finding of nonfunctionality even though the dress incorporated functional features named in utility patents.

There are actually two types of functionality: utilitarian functionality and aesthetic functionality. Most cases involve utilitarian functionality, which asks whether the design yields a utilitarian advantage -- lower manufacturing cost, ease of use, etc. In Interactive Network, the three-level scheme and scoring system of an interactive football game involving the prediction of events in televised football games was held functional because it was so intimately related to the purpose of the game.

Courts have struggled with “aesthetic” functionality, because competitors should not be foreclosed from adopting an aesthetically superior design that has made a product successful due to its consumer appeal.

In Pagliari v. Wallace China Co., 198 F.2d 339 (9th Cir. 1952), the Ninth Circuit held that an aesthetic product feature is functional if it is an “important ingredient in the commercial success of the product.” This decision and its progeny have been widely rejected or limited. Restatement (Third) Unfair Competition § 17 Cmt c (Reporter’s Note); Robert Unike, “Better by Design: the Availability of Trade Dress Protection for Product Design and the Demise of ‘Aesthetic Functionality’,” 85 Trademark Reporter 312 (May-June 1995). But see Aromatique, Inc. v. Gold Seal, Inc., 28 F.3d 863 (8th Cir. 1994) (design of pillow-shaped double cellophane bags closed with a cord tied in a square-knot bow, used for potpourri, was functional; applying Pagliari test.)

Even so, aesthetic functionality is not dead. The Supreme Court recently lent its approval to the concept in Qualitex Co. v. Jacobson Products Co., 514 U.S. 159, 115 S. Ct. 1300, 131 L.Ed.2d 248 (1995). In Qualitex, the Court held that color alone (here, the green-gold color of a dry cleaning press pad) may function as a trademark.

It stated, the “ultimate test of aesthetic functionality is whether the recognition of trademark rights would significantly hinder competition.” The Restatement (Third) of Unfair Competition adds that, if a design’s “aesthetic value” lies in its ability to “confer a significant benefit that cannot practically be duplicated by the use of alternative designs,” then the design is “functional.” Restatement (Third) of Unfair Competition 17, Comment c, pp. 175-176 (1995). See also Wallace Int’l Silversmiths, Inc. v. Godinger Silver Art Co., 916 F.2d 76, 81 (2d Cir. 1990), cert. denied, 499 U.S. 976, 111 S. Ct. 1622, 113 L.Ed.2d 720 (1991).

“The upshot is that, where a color serves a significant nontrademark function . . . courts will examine whether its use as a mark would permit one competitor (or a group) to interfere with legitimate (non trademark-related) competition through actual or potential exclusive use of an important product ingredient. That examination should not discourage firms from creating aesthetically pleasing mark designs, for it is open to their competitors to do the same.” Qualitex, 115 S. Ct. at 1306.

The Interplay Between Patent Law and Trade Dress

Some argue that trade dress law for product configurations conflicts with patent law. Patent law gives an inventor the opportunity to obtain a complete monopoly for a limited time, over a useful invention (utility patent) or a novel design (design patent.) To acquire this right, the inventor must disclose the invention so that at the expiration of the patent the invention may be freely practiced. Thomas & Betts Corp. v. Pandoit Corp., ___ F.3d ____, 46 U.S.P.Q. 2d 1026 (7th Cir. 1998) (“Thomas & Betts II”). The Supreme Court has long said that the patent scheme includes a right to copy unpatented designs or designs that are the subject of expired patents. E.g., Bonito Boats, Inc. v. Thunder Craft Boats, Inc., 489 U.S. 141, 151-52, 164-65, 109 S. Ct. 971, 103 L.Ed.2d 118 (1989); Sears, Roebuck & Co. v. Stiffel Co., 376 U.S. 225, 231, 84 S. Ct. 784, 11 L.Ed.2d 661 (1964); Compco Corp. v. Day-Brite Lighting, Inc., 376 U.S. 234, 84 S. Ct. 779, 11 L.Ed.2d 669 (1964).

In contrast, trade dress law allows a seller to prevent, for an unlimited time, the marketing of products having features that are similar or identical to its own, if they are so similar that confusion would be likely to result. Trade dress protection subsists as long as the owner continues to use the dress and as long as it continues to possess the required distinctiveness.

The concern is that using trade dress law a seller may obtain indefinite protection for a feature which, according to patent law, should be free to copy because it is unpatentable or is the subject of an expired patent. The functionality doctrine has been the only safeguard against disruption of the patent scheme through the trade dress protection of product configurations.

In Vornado Air Circulation Systems, Inc., the Tenth Circuit found the functionality doctrine alone insufficient to protect the right to copy. To obtain a patent, an inventor must show that the invention is “useful,” “novel” and “non-obvious.” In contrast, the functionality doctrine precludes protection of trade dress only where the dress yields an advantage over other designs. Therefore, a feature may be patentable yet non-functional. Vornado Air Circulation Systems, Inc., 58 F.3d at 1506. If so, the former patent owner could protect the feature as trade dress even after the patent has expired.

See also Dorr-Oliver, Inc. v. Fluid-Quip Inc., 94 F.3d (7th Cir. 1996) (reversing district court finding of likely confusion).

To avoid this, the Vornado court said that even a non-functional feature cannot be protected if it was part of a claim in a utility patent “and the configuration is a described, significant inventive aspect of the invention . . . so that without it the invention could not fairly be said to be the same invention. . . .” The court held the trade dress in question, a fan design, to be unprotectible under this rule.

In Thomas & Betts II, the Seventh Circuit took a somewhat different course. It indicated that the functionality doctrine is sufficient to balance the rights involved, and clarified that there is no per se prohibition against features disclosed in a patent receiving trademark protection after the patent has expired. The court carefully distinguished Vornado on its facts because the feature at issue in Thomas & Betts, the oval-shaped head of a cable tie, was not part of the claims in the expired patent. That the oval-shaped head was part of the “best mode” set forth in the patent did not alter the result.

A recent entry from our circuit is Dogloo, Inc. v. Doskocil Mfg. Co., 893 F. Supp. 911 (C.D. Cal. 1995). The court granted a preliminary injunction to plaintiff, holding it had demonstrated a reasonable chance of success in demonstrating that the configuration of its igloo-shaped dog house was nonfunctional, though it had been included in a utility patent.

The tension between trade dress and design patents is not so acute as the tension between trade dress and utility patents. Design patent protection, like trade dress protection, is not granted unless the design lacks functionality. See L.A. Gear, Inc. v. Thom McAn Shoe Co., 988 F.2d 1117, 1123 (Fed. Cir.), cert. denied, 510 U.S. 908 (1993). In Kohler Co., the court perceived “no unavoidable conflict between the patent law and federal trademark law as applied to product configurations.” 12 F.3d at 644. Some cases have comfortably addressed design patent claims and trade dress claims in the same case. E.g., L.A. Gear, Inc.; Litton Systems, Inc. v. Whirlpool Corp., 728 F.2d 1423 (Fed. Cir. 1984).

Registration of Trade Dress

The principles discussed in this article apply whether or not the trade dress in question has been registered with the Patent and Trademark Office as a trademark. However, trade dress, like almost anything else that serves to identify and distinguish the source of goods or services, can become the subject of a trademark registration.

The basic requirements for registration are set forth in 15 USC § 1052. Some of the most important ones are:

Use in interstate commerce (may require cross-border sale or transportation).
Use as a trademark or service mark (i.e. not merely ornamental, etc.)
Use with a good or service.
Possesses inherent or acquired distinctiveness.
Nonfunctional.
No likelihood of confusion with earlier-filed or registered mark.

Although an “intent to use” application may be filed before commencing use (marketing or sale) of the mark, the PTO will not grant registration until after use commences. 15 USC § 1051. For details on trademark registration, consult the Trademark Manual of Examining Procedure (2d Ed. 1993, 1st Rev. 1997) (available through US GPO.)

A federal registration provides numerous benefits, including:

Nationwide right. An unregistered mark is enforceable only in the owner’s actual trade area. A federal registration is *prima facie* evidence of the nationwide right to use the mark. 15 USC § 1057(b). It may freeze the territory of other unregistered users, and it prevents later users from acquiring local rights.

Evidentiary benefits. A registration is also *prima facie* evidence of the registrant’s ownership of the mark and the validity of the mark.

Priority before commencing use. By filing an “intent to use” application for an inherently distinctive mark, one can obtain an earlier priority against conflicting marks, “reserving” it for later use. 15 USC § 1057(c).

Notice and deterrence. An application or registration provides actual notice to researchers, deterring others from adopting similar marks. A registration also provides constructive notice of ownership, depriving others of the partial defense of innocent infringement. 15 USC §§ 1072, 1111 (use of “®”), 1114(2), 1115.

Bar to registration. The US Patent and Trademark Office will refuse to register anything confusingly similar to a registered mark.

Incontestibility. A mark that has been registered and used for five years may become “incontestible.” This converts the *prima facie* presumptions to conclusive ones, and removes certain defenses. 15 USC §§ 1065, 1115(b).

Counterfeiting remedies. A trademark registrant can obtain seizure and enhanced damages against counterfeiters. 15 USC § 1117(b).

Customs assistance. Only a federally registered mark can be recorded with the Customs Service for assistance in preventing infringing imports. 19 CFR 133.1(a).

Additional statutory claim. The Lanham Act provides an unfair competition cause of action for infringement of an unregistered mark. However, ownership of a registered mark enables an additional statutory infringement claim. 15 USC § 1114.

Likelihood of Confusion

If plaintiff's trade dress is protectible, defendant's trade dress infringes only if it is so similar that it is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of one party with another, or the origin, sponsorship, or approval of one party's goods, services, or commercial activities by the other. Note that the relevant confusion is not limited to confusion as to the origin of goods. Also, "reverse confusion" (where people are likely to believe that plaintiff's product originates with defendant) is actionable.

Confusion may arise "post-sale," when people view the infringing product in use and assume – temporarily or permanently – that it is associated with the trade dress owner. See, e.g., Dorr-Oliver; Chrysler Corp. v. Silva, 118 F.3d 56 (1st Cir. 1997) (ordering new trial on post-sale confusion regarding design of 1960's-era Dodge Viper).

Courts determine the likelihood of confusion by reference to factors stated somewhat differently in each jurisdiction. In the Ninth Circuit, the factors are:

- Strength of the plaintiff's trade dress
- Proximity of the products
- Similarity of the parties' trade dress
- Actual confusion
- Convergence of marketing channels
- Type of goods and degree of care likely to be used by purchasers
- Defendant's intent in selecting the trade dress
- Likelihood that the parties will extend their product lines.

AMF Inc. v. Sleekcraft Boats, 599 F.2d 341 (9th Cir. 1979) (trademark case); Vision Sports, 888 F.2d at 616.

"Strength" is essentially the same as inherent or acquired distinctiveness. "Proximity of the products" refers to the perceived relationship between non-identical products, e.g., whether customers would expect one to originate from the same source as the other. This factor is less important in trade dress cases, where the products are often identical.

The most important point about “actual confusion” is that it is not required. Actual confusion is powerful evidence of likely confusion. However, its absence generally will not defeat a claim unless the parties’ dress has coexisted in the same market for a long time without confusion.

A showing that defendant intended to capitalize on plaintiff’s goodwill is potent. Some courts have stated that “if the mark was adopted with the intent of deriving benefit from the reputation of [the plaintiff,] that fact alone may be sufficient to justify the inference of secondary meaning.” Chevron, 659 F.2d at 703-04; Sunbeam, Inc.; P.E. Guerin, Inc. This intent may even be inferred from the fact of copying. Id. Most courts will require either actual confusion or intentional infringement before they will award monetary relief in a trade dress case.

An additional factor that often arises in trade dress cases is the presence of defendant’s house mark as part of the overall trade dress. The effect of defendant’s use of its house mark depends upon the circumstances. Sunbeam, Inc. Some courts have found that it had no effect or even increased the likelihood of confusion.

Others have given the presence of a house mark tremendous weight in a determination of no infringement. In Dorr-Oliver, the Seventh Circuit stated, “in the case of a high-priced, single-purchase product [e.g., industrial corn processing machines], there is generally no likelihood of confusion when the manufacturer’s name is clearly displayed on the product.” In Conopco, Inc. v. May Department Stores Co., 46 F.3d 1556 (Fed. Cir. 1994), cert. denied, 514 U.S. 1078, 115 S. Ct. 1724, 131 L.Ed.2d 582 (1995) the court found no likelihood of confusion despite defendant’s intentional imitation of plaintiff’s strong dress in the Vaseline Intensive Care Lotion bottle design, and despite evidence of actual confusion. The court found that defendant’s prominent use of its logo in private labeling, merchandising and marketing its lotion in its own stores alleviated the possibility of confusion.

Conclusion: Current Trends

Trade dress protection may have reached its broadest point in recent years. Here are additional examples of decisions protecting non-traditional trade dress:

The style and subject matter of a collection of paintings. Romm Art Creations v. Simcha Int’l, 786 F. Supp. 1126 (E.D.N.Y. 1982).

The general look and concept of a line of greeting cards. Hartford House Ltd. v. Hallmark Cards, Inc., 647 F. Supp. 1533, 1540 (D. Colo. 1986), aff’d, 846 F.2d 1268 (10th Cir.), cert. denied, 488 U.S. 908, 107 S. Ct. 260, 102 L.Ed. 2d 248 (1988).

The form of reminder letter, promotional brochures and monthly reports used for auto dealer customer reminder services. Computer Care v. Systems Enters., Inc., 982 F.2d 1063, 1065 (7th Cir. 1992).

The design of a golf hole. Pebble Beach Co. v. Tour 18I, Ltd., 942 F. Supp. 1513 (S.D. Tex 1996) (now on appeal).

Decisions like these have generated considerable controversy, and the pendulum may be swinging back to a somewhat more restrictive view. E.g., Stephen F. Mohr, Glenn Mitchell and Steven J. Wadyka, Jr., U.S. Trade Dress Law: Exploring the Boundaries (INTA 1997) at 2; John M. Cone, "Rights in Trade Dress: Are They Expanding Too Far?", The Intellectual Property Strategist Vol. 2; No. 9 (Dec 1997.) In any event, trade dress law, particularly for product configurations, is likely to remain unsettled for some time to come.