
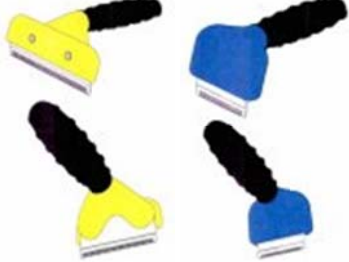
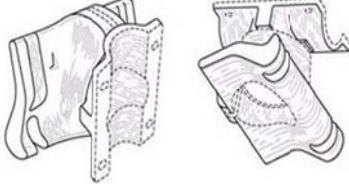
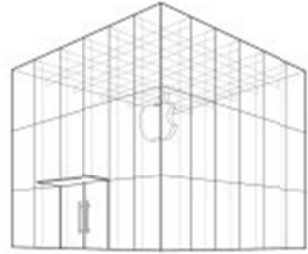




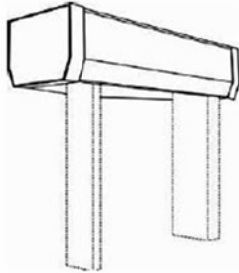
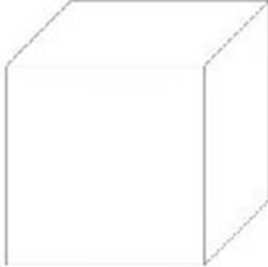


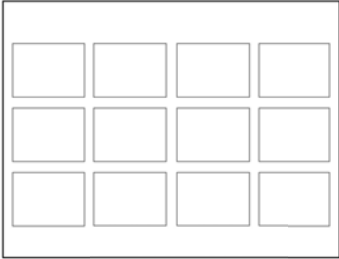
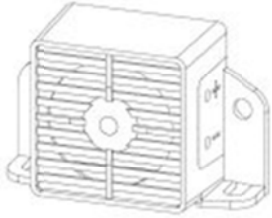

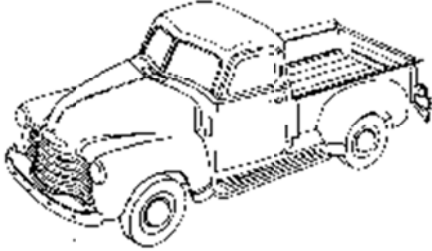
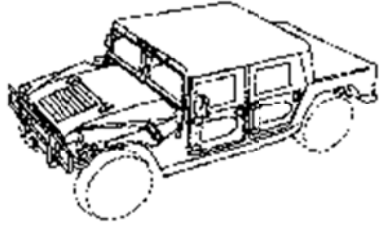



Goods	Distinctive or not	USA
Toilet Paper IC 016	Functional - Court of Appeals determined the quilted design to be functional and not trademarked. Georgia-Pacific Consumer Prods. LP v. Kimberly-Clark Corp., 2011 U.S. App. LEXIS 15558 (7th Cir. Ill. July 28, 2011)	 <p>Reg. Nos. 2,710,741; 1,778,352; 1,806,076; and 1,979,345</p>
Product Configuration - Pet Grooming Tools in Int'l Class 21	<p>Functional- The Trademark Office rejected the pet grooming product design as functional.</p> <p>Note: Advertising on the applicant's website touting the utilitarian advantages of these features which would make it impossible for the Applicant to overcome the functional rejection.</p>	 <p>77426019 77426013 (FURMINATOR, INC.)</p>
Product configuration - brackets for attaching traffic signals to mast arms. Int'l Class 6.	Not Distinctive - The Board determined the design was not inherently distinctive and applicant failed to show acquired distinctiveness. <i>In re Pelco Products, Inc.</i> , Serial No. 78485818 (September 19, 2008).	
Design and layout of a retail store – Apple Inc.'s Computer Store in Int'l class 35.	Acquired Distinctiveness 2(f) – Registered September 06, 2011	 <p>(Apple) Reg. No. 4021593</p>

<p>Product Configuration - Apple's iPhone Int'l Class 9</p>	<p>Acquired Distinctiveness 2(f) – Registered July 22, 2008</p> <p>Apple filed suit against Samsung in the Northern District of California for a variety of alleged intellectual property infringements including several of Apple's trade dress registrations (U.S. Registration Nos. 3,470,983, 3,457,218, 3,475,327).</p>	 <p>Reg. No. 3470983 (Apple)</p>
<p>Product Configuration - Apple's iPhone in Int'l Class 9</p>	<p>Acquired Distinctiveness 2(f) - Registered July 01, 2008.</p>	 <p>(Apple) 3457218</p>
<p>Product Configuration – Apple's iPhone in Int'l Class 9</p>	<p>Acquired Distinctiveness 2(f) – registered July 29, 2008</p>	 <p>3475327 (Apple)</p>
<p>Product Design - "two bands that encircle the barrel of the flashlight"</p>	<p>Acquired Distinctiveness 2(f)</p> <p>Note: After the mark published for opposition, Brinkmann Corporation opposed registration of Mag Instrument's mark as being functional because it "represents the charging rings" of applicant's flashlights. The TTAB sustained Brinkmann's opposition. In September 2010, Mag Instrument appealed the TTAB decision to the Court of Appeals for the Federal Circuit. Thus</p>	 <p>76484030 (Mag Instruments)</p>

	registration is pending the outcome of the appeal.	
Product Configuration - Chevron's Pole Spanner Sign	Not Distinctive - In re Chevron Intellectual Property Group LLC (2010) (Applicant's evidence failed to show acquired distinctiveness). "Even assuming that applicant's service station services are highly successful, such success does not, in and of itself, demonstrate recognition by the purchasing public of applicant's pole spanner design as a service ."	 78490836 (Chevron) Ser. No.
Product configuration for boxed wine -- Int'l Class 33.	Acquired Distinctiveness - Registered August 12, 2008	 3484927 (Target Brands)
Configuration of the goods (crackers) which are in the shape of a chickadee. Int'l Class 30.	Not Inherently distinctive -on Supplemental Register -July 21, 2009	 3659617 (Target Brands)
The mark consists of product configuration of a knitted hat having a stylized facemask featuring a beard and mustache	Not inherently distinctive - Supplemental Register June 14, 2011	 Reg. No. 3979820 APPAREL, INC.) (BEARDED

<p>The mark consists of product configuration of twelve squares in an evenly spaced configuration of four across and three down. The goods and services are downloadable software in Class 9, 32</p>	<p>Distinctive -- Opposed by Apple, Inc. August 10, 2011 for not showing acquired distinctiveness.</p>	 <p>Ser. No. 85018067 (Monterey Group One)</p>
<p>PRODUCT CONFIGURATION for BACK-UP WARNING ALARMS FOR VEHICLES in Class 12.</p>	<p>Acquired Distinctiveness 2(f) - registered June 21, 2011</p>	<p>77-860687 (ELECTRONIC CONTROLS COMPANY)</p> 
<p>PRODUCT CONFIGURATION OF APPLICANT'S SPEAKERPHONE DEVICE – in class 9 & 38</p>	<p>Acquired Distinctiveness 2(f) - Registered June 6, 2006</p>	 <p>Reg. No. 3100113 (Polycom, Inc.)</p>
<p>Product Configuration of a toy car in Int'l Class 28.</p>	<p>Acquired Distinctiveness 2(f) - Registered July 2, 2002</p>	<p>Reg. No. 2587073 (General Motors)</p>

		
<p>Product configuration of a motor vehicle, namely a sport utility vehicle in class 12.</p>	<p>Acquired Distinctiveness - Registered March 21, 2006</p>	 <p>Reg. No. 3070072 (General Motors LLC)</p>
<p>The mark consists of a lacquered red sole on footwear in class 25</p>	<p>Acquired Distinctiveness 2(f) - registered January 1, 2008</p> <p>Christian Louboutin SA v. Yves Saint Laurent America Inc., (No. 11 Civ. 2381 (VM) SDNY, August 11, 2011) the US District Court for the Southern District of New York denied a motion for a preliminary injunction by Christian Louboutin against defendants associated with Yves Saint Laurent holding that Louboutin's trademark for a "lacquered red sole on footwear" was not entitled to protection under the Lanham Act.</p>	<p>Reg. No. 3361597 (Christian Louboutin)</p> 

Product Configuration of a bed in class 20.	Acquired Distinctiveness 2(f)	 <p data-bbox="1276 446 1486 470">Reg. No. 2649183</p>
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Law and Practice in the U.S.

The U.S. does not have 3D marks per se. Instead, U.S. law recognizes trade dress protection for packaging, product configuration, restaurant decor and color.

A. Definition of Trade Dress

The definition of trade dress is broad. Trade dress may include "features such as size, shape, color or color combinations, texture, graphics, or even particular sales techniques." John J. Harland Co. v. Clarke Checks, Inc., 711 F.2d 966, 980 (11th Cir. 1983). More recently, case law has extended trade dress protection to product packaging, product configuration, color and décor. Trade dress that is entitled to protection under Lanham Act § 43(a) must be distinctive and non-functional.

A trade dress can be registered on either the principal or supplemental register based on the Lanham Act's definition of trademark 15 U.S.C. § 1127, which states "any word, name, symbol, or device, or any combination thereof" used "to identify and distinguish goods or services, including a unique product, from those manufactured or sold by others . . ."

If the trade dress is unregistered, the basis for protection is section 43(a) of the Lanham Act (15 U.S.C. §1125(a)), which provides protection for "any word, term, name, symbol, or device, or any combination thereof" used "on or in connection with any goods or services, or any container for goods." If unregistered, the trade dress owner has the burden of proving it is non-functional.

Registration Standards

The statutory requirements for registration of a trade dress are the same as those for traditional word or logo marks. 15 U.S.C. §§ 1052 and 1091. The Applicant must show that the trade dress is not functional and is distinctive or has acquired secondary meaning. The determination that a proposed mark is functional constitutes an absolute bar to registration on either the Principal Register or the Supplemental Register - regardless of evidence showing that the proposed mark has acquired distinctiveness.

Whereas product packaging can be inherently distinctive, product design and color cannot be inherently distinctive. Applicants must show secondary meaning to obtain a registration. If the Applicant cannot show distinctiveness, the Applicant may register product configuration and color as trade dress on the supplemental register.

Applicant must also overcome a possible ornamentation rejection, i.e. applicant's goods are merely decorative and do not identify and distinguish applicant's goods. To overcome this, applicant can submit evidence that the trade dress is unique and not common in the field.

B. The Law

1) Restaurant Décor Can be Inherently Distinctive

Two Pesos, Inc. v. Taco Cabana, Inc., 112 S.Ct. 2753 (1992), the Supreme Court held that inherently distinctive trade dress is protectable without proof of secondary meaning.

Restaurant décor and Marketing themes (Tertium Quid Marks)

It is important to note that the Court did not treat the restaurant décor in Two Pesos as a product design - as product design trade dress cannot be inherently distinctive as a matter of law. Instead, it was considered instead to be "tertium quid" trade dress. Marketing themes for store designs are also considered "tertium quid" trade dress and may be protected as such. *Prufrock Ltd. v. Lasatier*, 781 F. 2d (8th Cir. 1986). Both product design and the tertium quid classes of trade dress normally will require consideration of functionality as part of the analysis as to whether the trade dress should be recognized as a protectable trademark.

Note: Apple has filed a trademark for its store design:



2) Color Can be Protected as a Trademark

Qualitex Co. v. Jacobson Products Co., Inc., Co., 514 U.S. 159 (1995) the Court held that under the right circumstances The Lanham Act permits registration of a trademark that consists, purely and simply, of a color. Although see the Christian Louboutin case below - which appears to indicate that color marks will be hard to obtain in the fashion industry.

3) Product Design and Color Trade Dress Cannot be Inherently Distinctive

Product design trade dress cannot be inherently distinctive - acquired distinctiveness must always be shown. *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 54 USPQ2d 1065, 1068 (2000).

If trade dress is a color, it cannot be an inherently distinctive mark, and may be registerable only upon a showing of acquired distinctiveness. *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159 (1995).

4) Functional Matter Cannot be Protected as Trade Dress

Functional matter cannot be protected as trade dress or a trademark. 15 U.S.C. §§1052(e)(5) and (f), 1091(c), 1064(3), and 1115(b). A feature is functional as a matter of law if it is "essential to the use or purpose of the product or if it affects the cost or quality of the product." *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 58

USPQ2d 1001, 1006 (2001); *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159, 165, 34 USPQ2d 1161, 1163-64 (1995); *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844, 850, 214 USPQ 1, 4 n.10 (1982).

Functionality Tests

- a) Martin Norwich Factors - *In re Morton-Norwich Products, Inc.*, 671 F.2d 1332 (CCPA 1982). The following factors are to be used when determining functionality: (1) the existence of a utility patent disclosing the utilitarian advantages of the design; (2) advertising materials in which the originator of the design touts the design's utilitarian advantages; (3) the availability to competitors of functionally equivalent designs; and (4) facts indicating that the design results in a comparatively simple or cheap method of manufacturing the product.
- b) The Inwood Test (The Traditional Rule): *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844 (1982), the Court held if the configuration or feature of the product is essential to the use or purpose of the product, or affects the cost or quality, it is not necessary to consider whether competitors need to use the design. Thus under the Inwood Test, if a product configuration is found to be essential to the use or purpose of the product, or it affects the cost of the product, then it is de jure functional and will never be protectable as a trademark.
- c) *Traffix Devices, Inc. v. Marketing Displays, Inc.* 532 U.S. 23, 58 USPQ2d 1001 (2001). The Supreme Court evaluated the evidentiary weight to be given to an expired utility patent when evaluating the functionality of a trade dress feature. In doing so, the Supreme Court confirmed the Inwood Test as the valid test for functionality. The Supreme Court determined that the Court of Appeals misinterpreted the test for functionality. Whereas the Court of Appeals considered the competitive necessity of the design, the Supreme Court reaffirmed the Inwood rule, "that a product is functional if it is essential to the use or purpose of the article, or if it affects the cost or quality of the article." Under the Inwood Test there is no need to consider whether there is a competitive necessity for the design. Thus the Traffix opinion confirmed that if a design is found to be functional, there is no need to look at (a) competitive need for the design, or (b) any secondary meaning the design may have garnered.

d) After *Traffix*, The Federal Circuit held the Martin Norwich Factors to be consistent with the Inwood Test and that the existence of alternative designs (lack of competitive need) can be considered when determining whether a feature is functional in the first place. However, once it is found functional, it cannot be given trade dress status merely because there are alternative designs available. *Valu Engineering, Inc. v. Rexnord Corp.*, 61 USPQ2d 1422 (Fed. Cir. 2002).

e) Aesthetic Functionality - Only Considered if Article Passes the Inwood Functionality Test

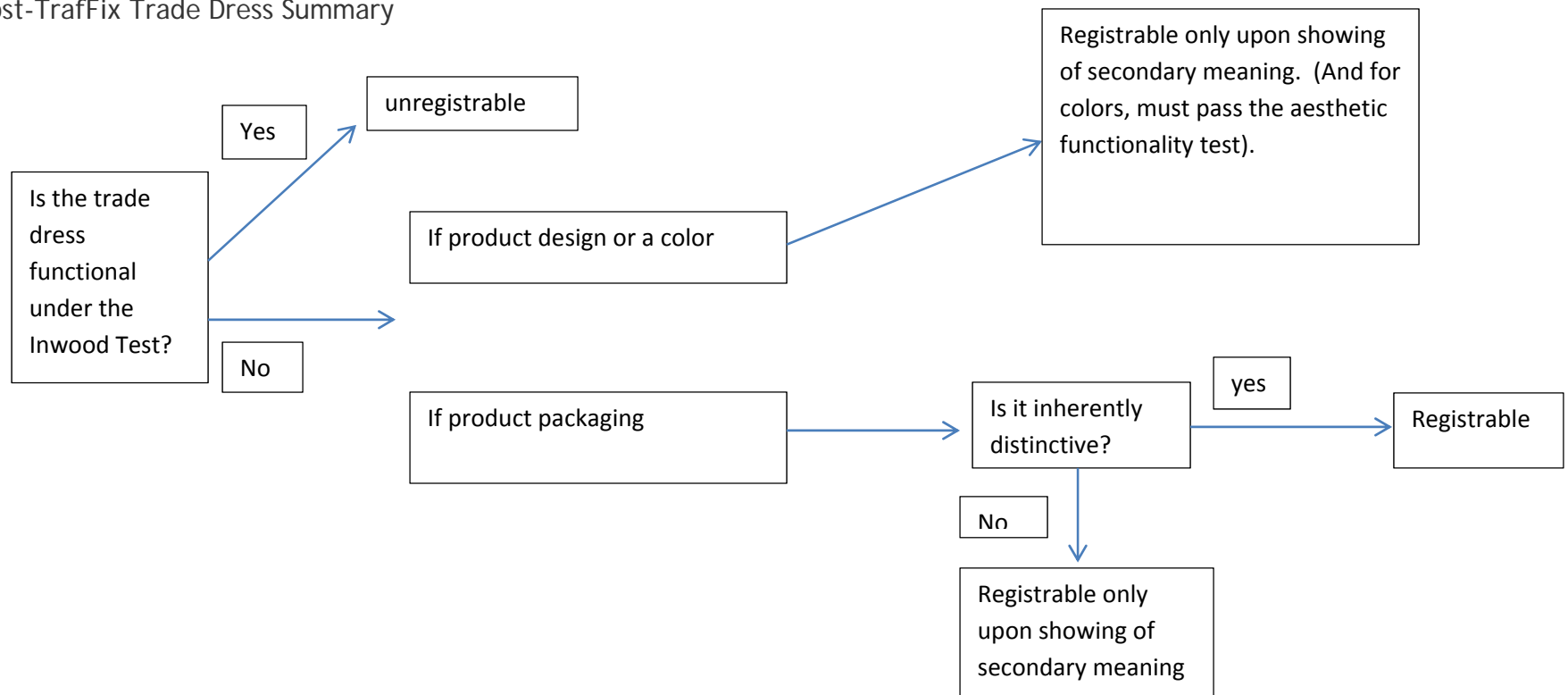
The *Traffix* decision also commented on the aesthetic functionality test which is used to evaluate color marks and product features that enhance the attractiveness of the product. If and only if the article is found not to be functional under the Inwood test, is it appropriate for a court to utilize the aesthetic functionality prong of the test. To determine whether a feature is aesthetically functional (and not protectable), is whether trademark protection for the feature would impose a significant non-reputation-related competitive disadvantage. This test is appropriate in cases where the mark sought to be registered is a color or other matter that does not easily fit within the "utilitarian" definition of functionality. See the *Christian Louboutin* case below.

The following are examples of where courts found a color or design feature functional under the aesthetic functionality test (1) In *Publications International, Ltd. v. Landoll, Inc.*, 164 F.3d 337 (7th Cir. 1998), the Seventh Circuit held that the color gold used as gilding on pages of a cookbook to prevent "bleeding" is a prime example of aesthetic functionality because it connotes opulence and is commonly used in the bookbinding business. *Id.* at 342. (2) In *Brunswick Corp. v. British Seagull, Ltd.*, 35 F.3d 1527 (Fed. Cir. 1994), the Federal Circuit held that the color black as applied to the exterior surface of outboard boat engines is functional because of the competitive need for color compatibility and ability to decrease apparent motor size. *Id.* (3) The Ninth Circuit held the design pattern on china to be functional because the "essential selling features of hotel china, if, indeed, not the primary, is the design. The attractiveness and eye-appeal of the design sells the china." *Pagliero v. Wallace China Co.*, 198 F.2d 339 (9th Cir. 1952).

5) Secondary Meaning

For obtaining a trade dress registration, the Examining Attorney will likely require more than a mere affidavit showing five years of continuous and exclusive use. The TMEP recommends submitting actual evidence that the mark is perceived as a mark for the relevant goods or services. The TMEP recommends (1) a declaration from appropriate in-house source (e.g. CEO) with sales figures for the goods in dollar amounts and units for the past 5 years; (2) a declaration from a marketing executive regarding advertising expenditures, channels of media, number of ads placed over the last five years, and (3) declarations from distributors and dealers and/or customers that assert recognition of the product configuration as originating from applicant. For purposes of evaluating secondary meaning during litigation, courts examine various factors to assess if a learned association exists between the source and the appearance of the product. Normally, the association is shown by direct consumer testimony that purchasers associate the design with the source. Courts also consider whether plaintiff's use of the particular design or configuration has been exclusive, and the length and manner of advertising and sales figures.

Post-Traffix Trade Dress Summary



Some Recent Trade Dress Cases in various federal district/circuit courts

Poly-America, L.P. v. Stego Indus., L.L.C., 2011 U.S. Dist. LEXIS 82647 (N.D. Tex. July 27, 2011). Poly-America, L.P. ("Poly") brought suit against Stego Indus., L.L.C. ("Stego") seeking a judgment declaring that Stego's trademark is not



registrable under the Lanham Act. Stego's Trademark is Reg. 2790352 for yellow plastic sheeting used in the construction industry as a vapor barrier and as a vapor retarder. Under the Traditional Inwood Test, Stego had to prove by a preponderance of the evidence that yellow is not "essential to the use or purpose" and does not affect the "cost or quality" of its vapor barrier. *Id.* (citing *Traffix*, 532 U.S. at 32). The Court found yellow to be functional under the traditional test. "[T]he evidence proves that yellow — as a bright, light color — provides utilitarian benefits, both in hot climates and where the underlying soil is of a darker hue, by absorbing less heat and contrasting well with the underlying soil and overlaying rebar." *Id.* Not all aspects of a product need to be functional to take a product feature out of trade dress protection, rather "[f]unctionality may be established by a single competitively significant application. . . ." *Id.* (quoting *Valu*, 278 F.3d at 1277-78).

McNeil Nutritionals, LLC v. Heartland Sweeteners, LLC, 511 F.3d 350 (3rd Cir. 2007).



Manufacturers of nationally branded products received some encouragement after the Third Circuit awarded a preliminary injunction against look-alike, store-brands (private-labels) for trade dress

infringement. Specifically, this case concerned whether the packaging of private label products is similar enough to a directly competing national-brand product so as to create a likelihood of confusion among consumers. The plaintiff-appellant McNeil Nutritionals, LLC (McNeil) sells and markets Splenda, a highly successful national brand of sucralose, an artificial sweetener. The defendants-appellees Heartland Sweeteners LLC and Heartland Packaging Corp. (collectively, Heartland) package and distribute sucralose as store brands to a number of retail grocery chains. McNeil brought a trade dress infringement action against Heartland, alleging that Heartland's product packaging is confusingly similar to McNeil's SPLENDA trade dress packaging. The court considered the fact that there are a number of different artificial sweeteners on the market each of which use color to differentiate and identify the active ingredient in a given product. Sweet'N Low (saccharin) is red and pink, Equal (aspartame) is blue, and Splenda is yellow. The court recognized that it is a common practice for store-brands to use similar color to identify the active ingredient in the sweetener. The court determined that store brands can use product packaging that is similar to a well-known branded product, as long as the store brand clearly displays its name and/or logo on the product. The Court reasoned that:

[C]onsumers are highly aware of the existence of store-brand products; when they are shopping in a particular store they are aware of the store's name; each of the Heartland products on sale in grocery stores displays the store name/logo; the Heartland and Splenda products typically appear next to each other; and there are other signals to the consumer on grocery store shelves; such as price differentials and shelf-talkers inviting consumer[s] to compare and save, that indicate to the consumer that the Heartland and Splenda products are not the same. *Id.*

The sucralose products sold by the Ahold supermarkets (second photo) did not have a store name or logo prominently displayed and the Court reversed the refusal of a preliminary injunction with respect to Ahold box. The sucralose products sold by Safeway were found to be sufficiently different from McNeil's SPLENDA trade dress as they contained prominent store brand logo on the box.

Aurora World, Inc. v. TY Inc., 719 F. Supp. 2d 1115 (C.D. Cal. 2009)

Plaintiff launched a brand of plush toy characters in which it claimed trade dress rights. The plaintiff characterized the plush toy trade dress as consisting of "large, round eyes, with large black pupils and colored borders. . . . placed close together on the front of each character's face" and "recognizable stitching patterns, expressions, and color elements." Plaintiff asserted that defendant's plush animal toys were substantially similar and infringed on plaintiff's copyright and trade dress rights. As for the trade dress claim, the court applied the aesthetic functionality test to

determine if the aesthetic features of the plush toys served a purpose other than being a source identifier. The Court found the plush toy features to be aesthetically functional and denied the preliminary injunction. The court stated that “[a] manufacturer or designer has an incentive to make a . . . plush toy aesthetically pleasing because that drives the consumer’s decision to buy the plate or toy. Such designs are, therefore, functional.” *Id.*

Christian Louboutin SA v. Yves Saint Laurent America Inc., (No. 11 Civ. 2381 (VM) SDNY, August 11, 2011)

The US District Court for the Southern District of New York denied a motion for a preliminary injunction by Christian Louboutin against a collection of defendants associated with Yves Saint Laurent holding that Louboutin’s trademark for a “lacquered red sole on footwear” was not entitled to protection under the Lanham Act. The Louboutin court held that, the lacquered red color was chosen largely for aesthetic appeal, and aesthetic appeal may constitute a functional element in certain contexts of the fashion industry. The court distinguished high-heeled shoes from more industrial items, such as dry cleaning pads, where color is not needed for its aesthetic appeal. The court stated that trademark protection of a color alone in this context is too broad and “would unduly hinder not just commerce am competition but art as well.” The court’s order may limit trademark protection in the fashion industry. On August 10, 2011 Louboutin filed notice of its appeal to the Second Circuit. While the case is on appeal, the district court said it would wait to decide whether to cancel Louboutin’s trademark

Heller Inc. v. Design Within Reach, No. 09 Civ. 1909 (JGK), 2009 WL 2486054 (S.D.N.Y. Aug. 14, 2009).

Heller Inc. (“Heller”) makes and sells the “Bellini Chair” and owns a U.S. trade dress registration for the chair’s design. Heller Inc. sued defendant Design Within Reach (“DWR”) for various claims including trademark dilution and trade dress infringement. As for the trade dress claims, the court dismissed them for being too vague. Heller described the trade dress merely as an “ornamental and sculptural chair” and included two images of the chair as exhibits, one of which was the image in Heller’s trade dress registration. The court explained that instead of submitting an image of the trade dress, the plaintiff must articulate the distinctive features of claimed trade dress. The plaintiff must clearly articulate the scope of its alleged trade dress and not merely rely on images when making a trade dress infringement claim.

Recording Trade Dress Registration at Customs

Registrants can record their trade dress (and trademark and copyright) registrations with customs to potentially block the importation of similar designs. Recording with U.S. Customs is relatively cheap and easy to do.

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