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RECONCEPTUALIZING THE INHERENT DISTINCTIVENESS OF PRODUCT DESIGN TRADE DRESS

GRAEME B. DINWOODIE*

*Traditionally, trademark rights subsisted in words or two-dimensional pictorial images. Twenty years ago, courts recognized that a product's very design might also function as its trademark. To be accorded this status, however, the manufacturer must demonstrate that her product design identifies the source of her product—that the design is, in the trademark vernacular, “distinctive.” In this Article, Professor Graeme Dinwoodie addresses the question of how to determine when a product shape or design identifies its source. In 1992, in *Two Pesos v. Taco Cabana*, the United States Supreme Court endorsed the assimilation of the principles governing the distinctiveness of word marks and non-verbal marks. But classical distinctiveness analysis was developed to adjudicate the protectability of verbal or pictorial marks, and it has proved inadequate to assist in the determination of the distinctiveness of a product design. Judicial efforts since *Two Pesos* to tackle this problem have misconstrued the concept of distinctiveness. Professor Dinwoodie suggests how courts might reformulate the concept of distinctiveness in terms that are not linguistically conditioned and that better reflect spatial or geometric subject matter. He contends that this reformulation requires the development of the concept of the “predictive inquiry,” an inquiry into likely consumer associations in the marketplace. Such an approach would clarify the scope of*

* Assistant Professor of Law, University of Cincinnati College of Law; LL.B., Glasgow University, 1987; LL.M., Harvard Law School, 1988. This Article is part of a larger study I have been conducting of intellectual property protection for industrial designs under U.S. and E.U. law, and was written in partial fulfillment of the requirements for the degree of Doctor of the Science of Law in the Faculty of Law, Columbia University. I am very grateful to Jane Ginsburg, Chair of my J.S.D. Committee at Columbia Law School, both for her support and encouragement of that project, and for her insightful comments on earlier drafts of this Article. I am also indebted to Jean Braucher, Tom Eisele, Brian Havel, Jerry Reichman and Michael Van Alstine for providing me with constructive suggestions on earlier drafts, and to my research assistant, Charles Sieving, for his invaluable help. Responsibility for the views expressed and any errors that remain is, of course, mine alone.

protection for product design trade dress, an issue that within the last eighteen months has been the subject of six petitions for certiorari filed with the Supreme Court and which continues to confound the courts.

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INTRODUCTION

Traditionally, and still most typically, trademark disputes concern the use of words or two-dimensional pictorial images employed by manufacturers or service providers to identify their products.¹ Increasingly, however, producers are invoking the federal trademark statute, the Lanham Act,² to protect the design features of their product (including three-dimensional elements such as shape or size) against confusing imitation. Black & Decker would prefer that its newly-marketed Snakelight flashlight not be forced to compete against knock-offs;³ Ferrari dislikes the idea that cars other than its classic Daytona Spyder might possess the Spyder's well-known profile;⁴ Stickley seeks to enjoy the fruits of the resurgent market for Mission-style furniture⁵ without competition from cheaper imitation pieces;⁶ and, the manufacturer of best-selling golf clubs wants to curtail the cottage industry of club manufacturers that simulate the shape and design features of its premium-priced products.⁷ It is now

1. See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 9 cmt. g (1995) [hereinafter RESTATEMENT] ("Words remain the most common type of trademark . . ."). The earliest forms of trademark were pictorial symbols, such as the silversmith's hallmark. See 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 7.06, at 7-33 (3d ed. 1995).

2. 15 U.S.C. §§ 1051-1127 (1994).

3. See *Black & Decker Corp. v. Int'l Sales & Mktg.*, 36 U.S.P.Q.2d (BNA) 1851, 1853 (C.D. Cal. 1995).

4. See *Ferrari S.P.A. Esercizio v. Roberts*, 944 F.2d 1235, 1237-38 (6th Cir. 1991); see also *Chrysler Corp. v. Silva*, 892 F. Supp. 321, 323-24 (D. Mass. 1995) (concluding that design of Dodge Viper was protected under Lanham Act, although infringement was not established).

5. Mission-style furniture is "'known for its severely plain and rectilinear style . . . visually enriched only by expressed structural features and the warm tones of the wood.'" *L. & J.G. Stickley, Inc. v. Canal Dover Furniture Co.*, 79 F.3d 258, 260 (2d Cir. 1996) (quoting DAVID M. CATHERS, FURNITURE OF THE AMERICAN ARTS AND CRAFTS MOVEMENT 1 (1981)).

6. See *L. & J.G. Stickley, Inc.*, 79 F.3d at 264-65 (vacating preliminary injunction because not clear that consumers associated design with plaintiff, rather than with maker of the original furniture design); see also *Imagineering, Inc. v. Van Klassens, Inc.*, 53 F.3d 1260, 1263-64 (Fed. Cir.) (protecting look of garden furniture), *cert. denied*, 116 S. Ct. 277 (1995).

7. See *Callaway Golf Co. v. Golf Clean, Inc.*, 915 F. Supp. 1206, 1209 (M.D. Fla. 1995).

the Lanham Act⁸ under which each of these manufacturers seeks, and often obtains, redress.⁹

The Lanham Act provides protection, however, only for words, symbols or designs that identify the source of a product—that are, in trademark parlance, “distinctive.”¹⁰ Courts have long recognized that consumers may identify a product by its packaging, thus justifying the use of the Lanham Act to protect against a rival’s deceptive use of similar packaging.¹¹ Recent extension of protection beyond a product’s packaging (for example, the appearance of the box in which the flashlight is sold) to features of the product itself (for example, the appearance of the flashlight) is, in some respects, merely judicial acknowledgement of the equal capacity of product design or configuration to identify products for consumers.¹² In the minds of

8. Designs of useful articles are also within the coverage of the Copyright Act, and can be the subject of design patent protection. See 17 U.S.C. § 101 (1994) (copyright may subsist in the design of useful articles to the extent that such design incorporates artistic features that can be identified separately from, and are capable of existing independently of, the utilitarian aspects of the article); 35 U.S.C. § 171 (1994) (patent available for new, original, and ornamental designs). Each of these alternative forms of intellectual property protection has, however, failed to offer adequate protection to product design. See Ralph S. Brown, *Design Protection: An Overview*, 34 UCLA L. REV. 1341, 1344-57 (1987); Jay Dratler, Jr., *Trademark Protection for Industrial Designs*, 1988 U. ILL. L. REV. 887, 891-96; J. H. Reichman, *Design Protection and the New Technologies: The United States Experience in a Transnational Perspective*, 19 U. BALT. L. REV. 6, 19-81 (1989-90).

9. The list of product designs protected under the Lanham Act goes on. See, e.g., Kohler Co. v. Moen, Inc., 12 F.3d 632, 643-44 (7th Cir. 1993) (shape of water faucet); Bauer Lamp Co. v. Shaffer, 941 F.2d 1165, 1172 (11th Cir. 1991) (form of neoclassical lamps); W.T. Rogers Co. v. Keene, 778 F.2d 334, 338 (7th Cir. 1985) (outline of stacking desk trays); Krueger Int’l, Inc. v. Nightingale, Inc., 915 F. Supp. 595, 607 (S.D.N.Y. 1996) (design of stacking chairs); Kompan A.S. v. Park Structures, Inc., 890 F. Supp. 1167, 1174 (N.D.N.Y. 1995) (configuration of children’s playground equipment); Health O Meter, Inc. v. Terrillon Corp., 873 F. Supp. 1160, 1171 (N.D. Ill. 1995) (look of weighing scales).

10. See *infra* notes 34-40 and accompanying text. The Lanham Act is not intended to encourage (or protect) innovation as such. See *Qualitex Co. v. Jacobsen Prods. Co.*, 115 S. Ct. 1300, 1304 (1995); cf. Dratler, *supra* note 8, at 909 (“[F]ostering innovation is only a minor and incidental purpose of trademark protection.”). Designs are, therefore, not protected merely because they are creative or novel. See *infra* note 36. Congressional efforts to offer *sui generis* protection for a designer’s creativity have failed. It is the absence of such a *sui generis* design law, and the failings of the design patent system, that caused designers to seek protection under the Lanham Act, exerting pressure on the threshold requirement of distinctiveness. The Supreme Court has cautioned, however, that it is for Congress, not the courts, to close any gap in protection that exists. See *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 147 (1989).

11. See, e.g., *George Basch Co. v. Blue Coral, Inc.*, 968 F.2d 1532 (2d Cir. 1992) (container for metal polish); *Federal-Mogul-Bower Bearings, Inc. v. Azoff*, 313 F.2d 405 (6th Cir. 1963) (packaging for engine parts); *Eastman Kodak Co. v. Royal-Pioneer Paper Box Mfg.*, 197 F. Supp. 132 (E.D. Pa. 1961) (packaging for photographic film).

12. Product configuration typically refers to the three-dimensional design of a useful product. See, e.g., Reichman, *supra* note 8, at 116. Courts and commentators, however,

both producers and consumers, many products are no longer identified and distinguished only by a verbal mark or pictorial symbol, but rather are set apart from other similar goods by their very shape or appearance.¹³

It is how this attribute is to be determined, how to ascertain the circumstances in which products differentiate themselves literally by their own "look," that is the subject of this Article. The expansion of Lanham Act coverage to include product design has severely stretched the capacity of the existing concept of distinctiveness to determine the appropriate boundaries of protectable subject matter. Classical distinctiveness analysis was developed to adjudicate the protectability of verbal or pictorial marks, and those modes of analysis have proved inadequate when transplanted to product designs. In this Article, I seek to refocus the distinctiveness inquiry, and to suggest how courts might reformulate the concept of distinctiveness in terms that more optimally reflect spatial or geometric, rather than linguistic or pictorial, subject matter.

The vast majority of product design infringement suits proceed under the principles of federal unfair competition law embodied in

use a multitude of terms—"product configuration," "product appearance," "product design," and "product feature"—interchangeably and without great attention to consistency. *Compare id.* (stating that product configuration refers to three-dimensional design), *with Duraco Prods. v. Joy Plastic Enters.*, 40 F.3d 1431, 1439 (3d Cir. 1994) (defining product configuration without reference to three-dimensional aspects); *see also infra* note 300 (discussing whether the Second Circuit's concept of "product feature" is interchangeable with the Third Circuit's concept of "product configuration."). Three-dimensional designs of useful products are the primary focus of this Article because it is with respect to those designs that deficiencies in intellectual property protection are most acute, in part because they more directly trigger competitive concerns surrounding the protection of useful matter. As explained more fully below, however, I am hesitant to accord any significance to categorization of any matter as "packaging," "product design," or "product configuration." *See infra* Part IV(E)(1). Subject to this caveat, and only where a distinction is explicitly drawn, for the purpose of this Article, I use the terms "product design," "product appearance," or "product features" to incorporate both three-dimensional product configuration and other features, such as two-dimensional surface decoration, that are part of the appearance of the product itself. *Cf. Brown, supra* note 8, at 1358 (noting difference between "[c]onfiguration (which is like 'overall shape' in copyright discourse) and design (which is at once our generic term and also denotes ornamentation)").

13. *See Sicilia Di R. Biebow & Co. v. Cox*, 732 F.2d 417, 425 (5th Cir. 1984) ("[C]ourts have realized . . . that many designs and features have both functional and identifying aspects. 'Some designs adopted for the purpose of identification are not wholly useless but perform a utilitarian function.'" (citation omitted)); *see also* John B. Thomas, *Thomson Designers Tuned In To Users*, 16 INDIANAPOLIS BUS. J., July 31-Aug. 6, 1995, at 1A, 33A ("That is the purpose of design: to make your product stand out." (comments of design manager, assured by corporate management that design would play a big role in product development)).

section 43(a) of the Lanham Act,¹⁴ but a producer may also institute an action under section 32 of the Act¹⁵ if the product design has been registered as a trademark with the Patent and Trademark Office.¹⁶ The governing principles are, for the most part, the same whether the claim is pursued under either section 32 or section 43,¹⁷ each cause of

14. A trademark can be registered as such under the Lanham Act, and can also be protected as an unregistered trademark under the principles of unfair competition law embodied in section 43(a) of the Lanham Act. See 15 U.S.C. § 1125(a) (1994); see also *infra* notes 17-18 (discussing section 43(a)). Section 43(a) is widely accepted as having created, and providing the statutory basis for, a federal law of unfair competition. See *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 780 (1992) (Stevens, J., concurring) (“Section 43(a) . . . has been widely interpreted to create, in essence, a federal law of unfair competition.”); cf. *Kohler Co. v. Moen, Inc.*, 12 F.3d 632, 646-47 (7th Cir. 1993) (Cudahy, J., dissenting) (“[T]he Lanham Act (comprising the federal law of trademarks and unfair competition) essentially federalizes the common law of trademarks and unfair competition.”).

15. Section 32 provides the basis for an action alleging infringement of a registered trademark. See 15 U.S.C. § 1114 (1994); see also *infra* note 18 (quoting § 1114); see, e.g., *Ark Plas Prods. v. Value Plastics, Inc.*, 913 F. Supp. 1246 (W.D. Ark. 1996) (action for infringement of registered trade dress consisting of design of industrial pipe fittings); *Eldon Indus. v. Rubbermaid, Inc.*, 735 F. Supp. 786 (N.D. Ill. 1990) (action for infringement of registered trade dress consisting of design of stackable office trays and vertical sorters). The paucity of cases pursued as section 32 claims reflects not only the historical roots of trade dress claims in unfair competition law, but also the relatively few substantive advantages that accrue from registration in light of the expansion of section 43(a), which was endorsed by Congress in the 1988 revisions to the trademark statute. See *The United States Trademark Association Trademark Review Commission Report and Recommendations to USTA President and Board of Directors* (proposing conforming language of section 43(a) to expanded scope of protection offered by courts and extending registered trademark remedies to section 43(a) actions), reprinted in 77 TRADEMARK REP. 375, 426-27 (1987); see also *Qualitex Co. v. Jacobsen Prods. Co.*, 115 S. Ct. 1300, 1308 (1995) (identifying advantages of trademark registration: “ability to prevent importation of confusingly similar goods, . . . constructive notice of ownership, incontestable status [and] prima facie evidence of validity and ownership”); *infra* note 17 (discussing incentives to pursue registration).

16. Proceeding parallel to developments in federal unfair competition law, courts first affirmed federal trademark registration of the shape of *containers or packaging*, see, e.g., *In re Mogen David Wine Corp.*, 328 F.2d 925 (C.C.P.A. 1964) (shape of wine decanter); *In re Haig & Haig Ltd.*, 118 U.S.P.Q. (BNA) 229 (Comm’r Pat. 1958) (shape of whiskey bottle), and later recognized that *product configurations* could also be registered under the Lanham Act. See, e.g., *Kohler Co. v. Moen, Inc.*, 12 F.3d 632, 638 (7th Cir. 1993) (affirming registration of faucet design); see also *In re Minnesota Mining & Mfg. Co.*, 335 F.2d 836, 838 (C.C.P.A. 1964) (recognizing that product design could be registered on Supplemental Register, because it might be registered on Principal Register with proof of established secondary meaning); *In re Honeywell, Inc.*, 497 F.2d 1344, 1349 (C.C.P.A. 1974) (accepting possibility of registration but remanding to determine functionality of thermostat appearance); cf. *Aromatique, Inc. v. Gold Seal, Inc.*, 28 F.3d 863, 868 (8th Cir. 1994) (noting that trade dress may be registered on the Principal Register of the Patent & Trademark Office) (packaging case).

17. “The general principles qualifying a mark for registration under § 2 of the Lanham Act are for the most part applicable in determining whether an unregistered mark is

action resting on a likelihood of public confusion as to the source of the respective products.¹⁸ Product design infringement claims, like packaging infringement claims, are commonly referred to as “trade dress” claims, with the term “trademark” being reserved for situations where the identifier of the product’s source is a word or a pictorial symbol. Here too, the scope of protection under the Lanham Act is now largely unaffected by whether the action is denominated as one of “trade dress” infringement or “trademark” infringement, and I use these terms interchangeably throughout this

entitled to protection under Section 43(a).” *Two Pesos*, 505 U.S. at 768. Unfair competition encompasses more than what is traditionally thought of as trademark infringement. See 1 MCCARTHY, *supra* note 1, § 2.02, at 2-13. However, the substantive rights afforded a registered trademark owner are largely coextensive with those available to the owner of an unregistered mark bringing an action for unfair competition under section 43(a). See S. REP. NO. 79-1333, at 2 (1946), *reprinted in* 1946 U.S.C.C.A.N. 1274, 1275 (“There is no essential difference between trade-mark infringement and what is loosely called unfair competition. Unfair competition is the genus of which trade-mark infringement is one of the species All trade-mark cases are cases of unfair competition and involve the same legal wrong.”). *But see, e.g.*, 15 U.S.C. § 1124 (1994) (providing trademark *registrant* with procedure to facilitate border interdiction of infringing goods). In the context of product design protection, the applicable substantive principles do not differ significantly as between trademark law and unfair competition law. *Cf.* Graeme B. Dinwoodie, In Defense of Trade Dress Protection For Product Design 37-39 (Dec. 13, 1995) (work in progress, on file with the author) (arguing that the Fourth Circuit decision in *Shakespeare Co. v. Silstar Corp. of America*, 9 F.3d 1091 (4th Cir. 1993), which would deny the availability of a functionality defense to a claim of infringement of an incontestable mark, has perhaps provided further incentive to pursue registration and the incontestable status that can flow therefrom).

18. Section 32 of the Lanham Act imposes liability upon “[a]ny person who shall, without the consent of the registrant . . . use . . . a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion,” but no longer limits actionable confusion to source-confusion. See 15 U.S.C. § 1114; *see also id.* § 1125(a) (imposing liability upon “[a]ny person who, on or in connection with any goods or services . . . uses any word, term, name, symbol, or device . . . or false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which . . . is likely to cause confusion . . . as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship or approval of his or her goods, services, or commercial activities by another person”). In 1962, Congress amended section 32 of the Lanham Act, “evincing a clear purpose to outlaw the use of trademarks which are likely to cause confusion, mistake, or deception of any kind, not merely of purchasers nor simply as to source of origin.” *Syntex Labs., Inc. v. Norwich Pharmacal, Co.*, 437 F.2d 566, 568 (2d Cir. 1971). In this Article, I use the terms “source-identifier” and “confusion as to source” as shorthand for the broader concepts now encompassed by modern trademark law. See Lisa H. Johnston, *Drifting Toward Trademark Rights in Gross*, 85 TRADEMARK REP. 19, 23-24 (1995) (discussing expansion of source-identifying function of trademarks); *cf.* Nicholas S. Economides, *The Economics of Trademarks*, 78 TRADEMARK REP. 523, 527 (1988) (“By the beginning of the twentieth century trademarks were understood not to be useful in identifying the source, but rather as identifying a quality standard.”).

Article.¹⁹

Although product design trade dress claims took root under the Lanham Act as early as twenty years ago,²⁰ they have burgeoned of

19. "For all practical purposes, there should be no difference in the substantive law of product simulation whether one uses the labels 'trademark,' 'trade dress' or simply 'unfair competition.' Changing the labels does not change the rules of recovery." 1 MCCARTHY, *supra* note 1, § 7.25, at 7-113. As the Court of Appeals for the Third Circuit has explained:

Attempts to incorporate protection for a product's overall design or appearance into section 43(a) have come under a variety of guises. Some courts have found an unregistered trademark in the product's trade dress, overall design, combination of features, or appearance. Others simply find that copying a product's overall trade dress or design is unfair competition. Still others have found such copying to be trade dress infringement without attempting to link it to trademark infringement or designating it a subcategory of unfair competition.

American Greetings Corp. v. Dan-Dee Imports, Inc., 807 F.2d 1136, 1140 n.2 (3d Cir. 1986) (internal citations omitted). In *Blau Plumbing, Inc. v. S.O.S. Fix-It, Inc.*, 781 F.2d 604, 608 (7th Cir. 1986), Judge Posner concluded that there was "probably no substantive legal difference" between trade dress and trademarks. Citing Professor McCarthy's comment that *Chevron Chemical Co. v. Voluntary Purchasing Group* had "brought trade dress cases into the mainstream of trademark law," Judge Posner commented, "And high time. Labels should not determine rights." *Id.* As discussed below, the Supreme Court has endorsed this assimilation. See *infra* note 72 and accompanying text; see also *Two Pesos*, 505 U.S. at 773 ("There is no persuasive reason to apply different analysis to [trade dress and trademarks under section 43(a)]."); *Aromatique*, 28 F.3d at 868 ("The difference between trade dress and trademark is no longer of importance in determining whether trade dress is protected by federal law."). But see *infra* notes 149-52 and accompanying text (discussing whether *Qualitex* suggests that color per se will be protected only upon proof of secondary meaning).

20. Professor Litman identifies *Truck Equipment Service Corp. v. Fruehauf*, 536 F.2d 1210 (8th Cir. 1976) ("*TESCO*"), as the first successful "product imitation" action brought under section 43 of the Lanham Act. See Jessica Litman, Note, *The Problem of Functional Features: Trade Dress Infringement Under Section 43(a) of the Lanham Act*, 82 COLUM. L. REV. 77, 83 (1982); see also Robert Unikel, *Better by Design: The Availability of Trade Dress Protection for Product Design and the Demise of "Aesthetic Functionality"*, 85 TRADEMARK REP. 312, 314 (1995) (identifying *TESCO* as the "turning point" in protection of product design as trade dress). In that case, the Court of Appeals for the Eighth Circuit affirmed a successful infringement claim predicated upon the extension of packaging trade dress principles to protect the appearance of the hopper of a truck. See *TESCO*, 536 F.2d at 1216. *TESCO* cast the claim as one of "false designation of origin" (the language of section 43 of the Lanham Act) or "unfair competition." See *id.* at 1215-16. It was not until later that references to product design as "trade dress" appear. See Reichman, *supra* note 8, at 87 (tracing use of "trade dress" to describe product configurations to the Ninth Circuit case of *Fabrica, Inc. v. El Dorado Corp.*, 697 F.2d 890 (9th Cir. 1983)). Earlier efforts to protect the appearance of a product as trade dress or as a false designation of origin under section 43(a) had failed on their facts, although courts addressing the issue had not denied that such a cause of action might be available. See, e.g., *Spangler Candy Co. v. Crystal Pure Candy Co.*, 353 F.2d 641 (7th Cir. 1965); *Bose Corp. v. Linear Design Labs*, 340 F. Supp. 513 (S.D.N.Y. 1971), *aff'd*, 467 F.2d 304 (2d Cir. 1972); *Remco Indus. v. Toyomenka, Inc.*, 286 F. Supp. 948 (S.D.N.Y.), *aff'd*, 397 F.2d 977 (2d Cir. 1968). Formerly, trade dress protection (under either state or federal law) had been afforded only to a product's packaging, and not to the product itself:

Historically, product imitation was the copying of the appearance of a product

late, encouraged in part by the two most recent trademark decisions of the United States Supreme Court.²¹ These decisions suggest an expansionist approach to the scope of Lanham Act protection. In *Two Pesos, Inc. v. Taco Cabana, Inc.*,²² the Court accorded protection to the decor and ambiance of a Mexican fast-food restaurant, and approved the assimilation of the principles governing the distinctiveness of verbal trademarks and non-verbal trade dress. The *Two Pesos* decision, however, raised as many questions as it answered. These include (1) the *means* by which the assimilation of the principles governing the distinctiveness of verbal marks and non-verbal dress is to be effected, and (2) the *extent* of any such assimilation. Those questions remained unresolved even after the Court's 1995 decision in *Qualitex Co. v. Jacobsen Products Co.*,²³ in which the Court recognized that a color per se could be registered as a product's trademark under the Lanham Act.²⁴

itself, while trade dress infringement was the copying of a product's package. There has been a considerable area of overlap, however, as a product's appearance may function as its packaging, incorporating elements intended to distinguish it from competing products. Recently, the distinction between product imitation and trade dress infringement has tended to disappear.

Litman, *supra*, at 79; see also Reichman, *supra* note 8, at 87 ("[*Fabrica*] and similar decisions . . . began to stretch the notion of trade dress to the point where prior distinctions between 'package' or 'container' and 'product configuration' became blurred and hardly worth defending.").

21. See *Qualitex Co. v. Jacobsen Prods. Co.*, 115 S. Ct. 1300 (1995); *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992).

22. 505 U.S. 763 (1992); see also *infra* text accompanying notes 67-81 (discussing *Two Pesos*).

23. 115 S. Ct. 1300 (1995).

24. The expansion of federal protection for product designs under the Lanham Act, suggested by *Two Pesos* and *Qualitex*, has also raised difficult questions regarding the interaction of trademark and patent law, which might offer cumulative protection to consumer products. The Supreme Court has considered unfair competition protection for product configurations under state law on three occasions over the past thirty years. See *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141 (1989); *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234 (1964); *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225 (1964). In its most recent analysis (*Bonito Boats*), the Court found that a Florida plug-molding law interfered with the federal policy favoring free competition in unpatented designs. However, the Supreme Court has not directly addressed the relationship between patent law and federal trademark protection for product designs since the enactment of the Lanham Act. The Court's previous decision dealing with federal unfair competition protection, *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111 (1938), was handed down six months after the emasculating of federal common law in *Erie Railroad v. Tompkins*, 304 U.S. 64 (1938), but was brought and argued on the basis of federal common law, the Lanham Act being passed eight years later. See *Kellogg Co.*, 305 U.S. at 113 n.1. Other more recent decisions have considered the scope of federal protection for non-verbal marks, but have not addressed the broader questions implicated by the patent/federal trademark relationship. See, e.g., *Qualitex*, 115 S. Ct. at 1308 (holding that nonfunctional color per se can, with secondary meaning, be registered as a trademark);

This Article attempts to fill that void. In Parts I and II, I provide a brief outline of the two bases upon which a plaintiff may demonstrate the distinctiveness of its mark—namely, inherent distinctiveness and secondary meaning. Part II also explains the means by which the distinctiveness of verbal marks has classically been determined. In Part III, I summarize the debate surrounding the question, resolved affirmatively by the Supreme Court in *Two Pesos*, of whether a non-verbal trade dress can be inherently distinctive.

Part IV contains the heart of this Article. There, I address the questions left unanswered by *Two Pesos*. Neither *Two Pesos* nor *Qualitex* offers any significant guidance as to the *means* by which the analytical assimilation of verbal and non-verbal matter is to be achieved. Difficulties with the application of existing distinctiveness analysis have been most sharply encountered in addressing the question of when a product design is “inherently distinctive,” a possibility which *Two Pesos* appears to endorse.²⁵ This Article argues that the conceptual confusion precipitated by the advent of inherently distinctive product designs can be dispelled by a limited reconceptualization of distinctiveness.²⁶ I reject the suggestion that the concept of distinctiveness should implement competitive concerns, preferring to assign that task to the doctrine of functionality. Instead, this Article develops the concept of the “predictive inquiry”—whether the prod-

Inwood Labs., Inc. v. Ives Labs., Inc., 456 U.S. 844, 856-59 (1982) (reversing lower court on point of procedure).

Two Pesos thus effectively re-ignites the contest between patent and unfair competition protection, and litigants are now pressing the Supreme Court to reconsider the issue. In the last year, two litigants have unsuccessfully petitioned the Supreme Court to resolve this alleged conflict. See *Vornado Air Circulation Sys., Inc. v. Duracraft Corp.*, 58 F.3d 1498 (10th Cir. 1995), *petition for cert. filed*, 64 U.S.L.W. 3271 (U.S. Sept. 29, 1995) (No. 95-524) (petition on file with author), *cert. denied*, 116 S. Ct. 753 (1996); *Imagineering, Inc. v. Van Klassens, Inc.*, 53 F.3d 1260 (Fed. Cir. 1995), *petition for cert. filed*, 64 U.S.L.W. 3020 (July 21, 1995) (No. 95-127) (petition on file with author), *cert. denied*, 116 S. Ct. 277 (1995). This alleged conflict is a proper concern, but should be addressed in stages of trade dress analysis other than inherent distinctiveness. In a forthcoming article, I explain why an appropriate scope of protection for product design does not interfere with or frustrate the purposes of patent law, and refute the suggestion that trade dress protection must be subordinated to patent law in determining the availability of intellectual property protection for consumer products. See *Dinwoodie*, *supra* note 17. Trade dress protection for product designs, if properly circumscribed, can coexist peacefully with patent law principles; ultimately, however, the most appropriate scope of intellectual property protection for designs can best be provided by the adoption of a carefully-tailored *sui generis* design law that balances the needs of producers for protection with the rights of rivals to compete.

25. See *infra* Part IV(C)(2).

26. See *infra* Part IV(E).

uct design would be likely to identify the product's source—as the basis for an analysis of inherently distinctive product design.²⁷ I then identify several “predictors” pertinent to any such inquiry.²⁸ These predictors reflect the empirical bases upon which courts reach their predictive conclusions as to whether consumers are likely to associate the design of a product with its source.

This Article also considers a series of judicial efforts to articulate alternative standards by which to adjudicate the inherent distinctiveness of product design. I contend that those efforts are inconsistent with a proper understanding of the concept of distinctiveness and pay insufficient regard to the means by which the modern consumer makes purchasing decisions. Moreover, the practical effect of each alternative test developed by the lower courts since *Two Pesos* is to deny the inherent distinctiveness of product design.²⁹ This result violates the spirit of the Supreme Court's decision in *Two Pesos*.³⁰

A second question remaining unanswered after *Two Pesos* is the *extent* of the assimilation of the principles governing verbal and non-verbal marks. In the wake of *Two Pesos*, several courts and commentators have attempted to limit that assimilation, suggesting that product design should continue to be treated differently from verbal marks or product packaging, i.e., that a new partition be established between packaging and design.³¹ In this Article, I repudiate any dis-

27. See *infra* Part IV (E).

28. See *infra* Part IV (E)(2).

29. See *infra* Part IV (D)(3).

30. Critics of *Two Pesos* might argue that the proponents of these tests adhere more faithfully than did the Supreme Court in *Two Pesos* to the principles articulated by the Court three years earlier in *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141 (1989) (holding state anti-copying law preempted by federal patent law because it interfered with the federal policy favoring free competition of unpatented designs). See, e.g., J.H. Reichman, *Past and Current Trends in the Evolution of Design Protection Law—A Comment*, 4 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 387, 392-94 (1993) (“Nowhere in the *Two Pesos* opinion was there the slightest awareness of a possible contradiction with the pro-competitive ethos of *Bonito Boats* . . .”). As discussed below, however, the legitimate competitive concerns aroused by product design trade dress protection should be addressed via the doctrine of functionality. See *infra* notes 89-101 and accompanying text. Courts seeking to implement the philosophical message of *Bonito Boats* in the inherent distinctiveness inquiry are using the wrong analytical vehicle. Their concern may be legitimate; their response is not.

31. On three occasions last year, the Supreme Court declined to consider whether the developing distinction between product configuration and product packaging, see *infra* Part IV(D)(2)(a), conflicts with and undermines the Court's decision in *Two Pesos*. See *Thomas & Betts Corp. v. Panduit Corp.*, 65 F.3d 654 (7th Cir. 1995), *petition for cert. filed*, 64 U.S.L.W. 3518 (U.S. Jan. 22, 1996) (No. 95-1169) (asking court to consider whether the test for secondary meaning should differ depending upon the classification of the trade dress at issue as product packaging or product configuration), *cert. denied*, 116 S. Ct. 1044

inction between packaging and design.³² The rationale for the distinction is circular, and the classifications are incapable of consistent application. Instead, I propose that the inherent distinctiveness of all trade dress be adjudicated by the same predictive inquiry: whether it is likely that consumers will identify the product by reference to the features claimed as trade dress.³³

I. THE CONCEPT OF DISTINCTIVENESS

The primary prerequisite to trademark protection is proof of a mark's distinctiveness.³⁴ Unlike patent or copyright law, no measure of the creative nature of the design is necessary. A trademark need not be original, novel or non-obvious.³⁵ Nor will a design be pro-

(1996); *Chums, Ltd. v. Snuggz/USA, Inc.*, 64 F.3d 669 (10th Cir. 1995), *petition for cert. filed*, 64 U.S.L.W. 3417 (U.S. Nov. 27, 1995) (No. 95-869) (seeking review by court on application of distinction in context of determining whether likelihood of confusion exists), *cert. denied*, 116 S. Ct. 914 (1996); *Versa Prods. Co. v. Bifold Co.*, 50 F.3d 189 (3d Cir. 1995), *petition for cert. filed*, 63 U.S.L.W. 3834 (U.S. May 12, 1995) (No. 94-1863) (requesting review on issue of whether product configuration and product packaging should be treated differently in determining whether likelihood of confusion exists) (petition on file with author), *cert. denied*, 116 S. Ct. 54 (1995); *see also infra* note 256 (discussing arguments raised in *Thomas & Betts* petition).

32. *See infra* Part IV(E)(1).

33. *See infra* Part IV(E).

34. *See Canal Co. v. Clark*, 80 U.S. 311, 323 (1871) ("[T]he trade-mark must either by itself, or by association, point distinctively to the origin or ownership of the article to which it is applied.")

35. *See Banff Ltd. v. Limited, Inc.*, 869 F. Supp. 1103, 1116 (S.D.N.Y. 1994) ("That the combination is 'obvious' . . . does not mean that the design is not original, nor, more importantly, that it is not arbitrary or fanciful . . ."), *later proceeding*, *Banff Ltd. v. Express, Inc.*, 921 F. Supp. 1065 (S.D.N.Y. 1995); *see also* *The Trade-Mark Cases*, 100 U.S. 82, 94 (1879) ("The trade-mark recognized by the common law is generally the growth of a considerable period of use, rather than a sudden invention. It is often the result of accident rather than design . . ."); *Canal Co.*, 80 U.S. at 322 ("[I]t is not necessary that the word adopted as a trade-name should be a new creation, never before known or used . . ."); *Manhattan Indus. v. Sweater Bee by Banff, Ltd.*, 627 F.2d 628, 630 (2d Cir. 1980) (recognizing trademark rights in mark abandoned by one company and immediately adopted for same goods by unrelated company). The Court of Appeals for the Second Circuit has, however, recently indicated that the product features of exact reproductions of well-known and historically-significant public domain designs are unlikely to be distinctive, because it will be difficult to establish that consumers associate the product design with the manufacturer of the reproductions, rather than with the maker of the popular originals. *See L. & J.G. Stickley, Inc. v. Canal Dover Furniture Co.*, 79 F.3d 258, 264 (2d Cir. 1996) (denying trade dress rights in design of reproduction furniture line); *see also* *EFS Mktg. v. Russ Berrie & Co.*, 76 F.3d 487, 490 (2d Cir. 1996) ("In view of the district court's finding that 'both parties' dolls [are] virtually indistinguishable from the . . . public domain doll,' . . . it is most unlikely that consumers would look to [the plaintiff] . . . as the sole producer of the troll dolls." (citation omitted)); *cf. Frederick Warne & Co. v. Book Sales Inc.*, 481 F. Supp. 1191, 1195 (S.D.N.Y. 1979) (noting that for publisher of Beatrix Potter books to show it has trademark rights in the books' cover illustrations requires not just that "the illustrations in question have come to signify Beatrix Potter as

tected as a trademark merely because it satisfies those levels of ingenuity.³⁶ Rather, it must represent a feature by which consumers identify and distinguish a product from others.³⁷

Distinctiveness is central to trademark protection because, without it, no goodwill attaches to the claimed mark. Absent that goodwill, use by competitors of the same or a similar mark would neither be an appropriation of the property of others, nor would it confuse consumers.³⁸ For these two basic concerns of trademark law to be aroused, consumers must first associate the mark with a specific source.³⁹ The concept of distinctiveness is expressly embodied in the

author of the books; plaintiff must show that they have come to represent its goodwill and reputation as *publisher* of those books"). A design may be copyrightable even if it incorporates elements of a pre-existing public domain design, provided that the variations from the public domain design are not merely trivial, but substantial or distinguishable. See *Godinger Silver Art Co. v. International Silver Co.*, 37 U.S.P.Q.2d (BNA) 1453, 1455 (S.D.N.Y. 1995). Such a copyright extends, however, only to the designer's incremental original contribution. See 17 U.S.C. § 103(b) (1994).

36. See *Sunburst Prods. v. Cyrk Int'l*, Nos. 95-1091, 95-1104, 1996 WL 550071, at *4 (Fed. Cir. Sept. 30, 1996) ("To be inherently distinctive a product design must be more than novel . . ."); *Pebble Beach Co. v. Tour 18 I, Ltd.*, 936 F. Supp. 1299, 1343, (S.D. Tex. 1996) ("Merely because no other golf holes resemble or are designed exactly like plaintiffs' does not make the holes inherently distinctive."); *Blue Coral, Inc. v. Turtle Wax, Inc.*, 664 F. Supp. 1153, 1163 (N.D. Ill. 1987) (commenting that if a shape were inherently distinctive merely because no competitive product combines precisely the same elements in its trade dress, every new product on the market would be inherently distinctive); cf. *Duraco Prods. v. Joy Plastic Enters.*, 40 F.3d 1431, 1450 (3d Cir. 1994) ("Protecting a product configuration without a showing of secondary meaning because the configuration is pleasant rather than because it identifies the source of the product would risk seriously transgressing the protective zones mapped by the patent laws."). These principles pertain whether a plaintiff is proceeding nominally under trademark law or unfair competition law. Distinctiveness is also the key to common-law protection. See *Crescent Tool Co. v. Kilborn & Bishop Co.*, 247 F. 299, 300 (2d Cir. 1917).

37. See 15 U.S.C. § 1052 (1994); *infra* note 42.

38. See *Canal Co.*, 80 U.S. at 323; *Charles Jacquin et Cie v. Destileria Serralles, Inc.*, 921 F.2d 467, 472 n.5 (3d Cir. 1990) ("A consumer must recognize that a particularly packaged product comes from Source A before she can be confused by a similar package from Source B."); see also *Thomas & Betts Corp. v. Panduit Corp.*, 65 F.3d 654, 658 (7th Cir. 1995) ("[T]rademark law allows a producer to prohibit the copying of a product feature which serves as a signifier of source in order to preserve his reputation and the goodwill consumers have for his brand."), *cert. denied*, 116 S. Ct. 1044 (1996). As Professor McCarthy has explained: "A trademark . . . has no kind of existence apart from the goodwill of the product or service it symbolizes." 1 MCCARTHY, *supra* note 1, § 2.07, at 2-34. " 'Goodwill is that which makes tomorrow's business more than an accident. It is the reasonable expectation of future patronage based upon past satisfactory dealings. Goodwill is dependent on identification.' " 1 *id.* § 2.08[1], at 2-38 to 2-39 (quoting EDWARD S. ROGERS, GOOD WILL, TRADEMARKS AND UNFAIR TRADING 13 (1914)).

39. The purposes of trademark law, as embodied in the Lanham Act, are "to 'secure to the owner of the mark the goodwill of his business and to protect the ability of consumers to distinguish among competing producers.'" *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 703, 774 (1992) (quoting *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S.

definition of "trademark" contained in the Lanham Act: "any word, name, symbol, or device or any combination thereof [used by any person] to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others, and to indicate the source of the goods, even if that source is unknown."⁴⁰

The courts define trade dress in more expansive terms, as "the total image of a product"; it "may include features such as size, shape, color or color combinations, texture, graphics, or even particular sales techniques."⁴¹ While this may appear broader than the statutory definition of trademark, the two concepts afford largely the same scope of protection. It is the ability of a claimed mark or dress to serve an identifying function that sets the outer limits of protection rather than conceptual classification as a "word, name, symbol, or device or any combination thereof" or "total image."⁴²

189, 198 (1985)).

40. 15 U.S.C. § 1127 (1994). In the legislative history of the 1988 Trademark Law Revision Act, Congress confirmed its intention that product configurations be considered registrable subject-matter. See S. REP. NO. 100-515, at 44 (1988), reprinted in 1988 U.S.C.C.A.N. 5577, 5607 ("The revised definition [of 'trademark'] intentionally retains . . . the words 'symbol or device' so as not to preclude the registration of colors, shapes, sounds or configurations where they function as trademarks."); cf. 15 U.S.C. § 1091 (1994) (any "package" or "configuration of goods" that is capable of serving as a trademark may be registered on the Supplemental Register).

41. *John H. Harland Co. v. Clarke Checks, Inc.*, 711 F.2d 966, 980 (11th Cir. 1983); accord *International Jensen, Inc. v. Metrosound U.S.A., Inc.*, 4 F.3d 819, 822-23 (9th Cir. 1993) (similarly defining trade dress); *Paddington Corp. v. Attiki Importers & Distribs., Inc.*, 996 F.2d 577, 582 (2d Cir. 1993) (citing *Harland*); see also *Two Pesos*, 505 U.S. at 764 n.1 ("The 'trade dress' of a product is essentially its total image and overall appearance." (quoting *Blue-Bell Biomedical v. Cin-Bad, Inc.*, 864 F.2d 1253, 1256 (5th Cir. 1989))); *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996, 1005 (2d Cir. 1995) ("While 'trade dress' at one time 'referred only to the manner in which a product was dressed up to go to market with a label, package, display card, and similar packaging elements,' the concept 'has taken on a more expansive meaning and includes the design and appearance of the product as well as that of the container and all elements making up the total visual image by which the product is presented to customers.'" (citation omitted)); *Mana Prods. v. Columbia Cosmetics Mfg.*, 65 F.3d 1063, 1069 (2d Cir. 1995) ("[T]rade dress today encompasses a broad concept of how a product presented to the public looks . . ."); *SK & F Co. v. Premo Pharm. Labs.*, 481 F. Supp. 1184, 1187 (D.N.J. 1979) ("Trade dress is a term reflecting the overall general impact, usually visual, but sometimes also tactile, of all these features taken together."), *aff'd*, 625 F.2d 1055 (3d Cir. 1980).

42. *Qualitex Co. v. Jacobsen Prods. Co.*, 115 S. Ct. 1300, 1304 (1995) ("It is the source distinguishing ability of a mark—not its ontological status as color, shape, fragrance, word, or sign—that permits it to serve these basic purposes [of trademark law]."); see also 15 U.S.C. § 1052 (providing for registration of marks "by which the goods of the applicant may be distinguished from the goods of others").

II. BASES FOR ESTABLISHING DISTINCTIVENESS AND THE *ABERCROMBIE* SPECTRUM

The distinctiveness of a trademark generally may be established by demonstrating that the mark (1) is inherently distinctive, or (2) has acquired distinctiveness.⁴³ In the first instance, distinctiveness is measured by locating the mark in one of a spectrum of conceptual categories that blend without clear differentiation into one another. This analysis, most authoritatively outlined by Judge Henry Friendly in *Abercrombie & Fitch Co. v. Hunting World, Inc.*,⁴⁴ dictates that a mark will be regarded as inherently distinctive if it is "arbitrary," "fanciful" or "suggestive" in relation to the goods upon which it is affixed.⁴⁵ Marks classified as "descriptive" of the goods are not inherently distinctive and can be protected only by way of the second basis, that is, upon proof that they have actually acquired distinctiveness in the minds of consumers.⁴⁶

43. See *Two Pesos*, 505 U.S. at 769; see also RESTATEMENT, *supra* note 1, § 13. These two methods of establishing distinctiveness and securing protection are available to plaintiffs under both section 32 and section 43 of the Lanham Act. See RESTATEMENT, *supra* note 1, § 13 cmt. e ("The doctrine of secondary meaning is applicable both at common law and under the various state and federal trademark registration statutes . . . The doctrine is also applicable to actions for infringement of unregistered designations under § 43(a) of the Lanham Act."); *id.* § 13 cmt. b ("Inherently distinctive designations are eligible for protection immediately upon use . . . They are also eligible for registration under state and federal trademark statutes without further evidence of distinctiveness."); see also 15 U.S.C. § 1052(f) (descriptive mark may be registered upon proof that the mark has become distinctive of the applicant's goods in commerce); *Two Pesos*, 505 U.S. at 769 (concept of secondary meaning has been applied to actions under section 43); *cf.* *Duraco Prods. v. Joy Plastic Enters.*, 40 F.3d 1431, 1439 (3d Cir. 1994) ("[T]he Supreme Court in *Two Pesos* used 'distinctive' in a dual sense, meaning either inherently distinctive or having acquired distinctiveness through secondary meaning.").

44. 537 F.2d 4 (2d Cir. 1976).

45. See *id.* at 9-11; see also *Two Pesos*, 505 U.S. at 768 (adopting Judge Friendly's formulation). As the Court of Appeals for the Eighth Circuit has explained: "The . . . definitions [of these terms] address the relation between the product and the trade dress . . ." *Stuart Hall Co. v. Ampad Corp.*, 51 F.3d 780, 786 (8th Cir. 1995). "A term is suggestive if it requires imagination, thought and perception to reach a conclusion as to the nature of goods." *Stix Prods. v. United Merchants & Mfrs.*, 295 F. Supp. 479, 488 (S.D.N.Y. 1968), *quoted in Abercrombie & Fitch Co.*, 537 F.2d at 11. A fanciful mark consists of a word that has been invented for the sole purpose of functioning as a trademark. See 1 MCCARTHY, *supra* note 1, § 11.03, at 11-10. EXXON is an example of a fanciful mark. "Arbitrary marks comprise those words, symbols, pictures etc., that are in common linguistic use but which, when used with the goods or services in issue, neither suggest nor describe any ingredient, quality or characteristic of those goods or services." 1 *id.* § 11.04[1], at 11-14.

46. "A term is descriptive if it forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods." *Stix Prods.*, 295 F. Supp. at 488, *quoted in Abercrombie & Fitch Co.*, 537 F.2d at 11. Generic marks can never be protected as trademarks. See *Miller Brewing Co. v. G. Heileman Brewing Co.*, 561 F.2d 75, 81 (7th

Marks conceptually classified as arbitrary, fanciful or suggestive with respect to the product to which they are affixed are regarded as inherently distinctive, and protected without more, because the "intrinsic nature [of such marks] serves to identify a particular source of a product."⁴⁷ These marks are considered likely to identify the product source because they have minimal natural or necessary conceptual connection with the products they mark. They are, as it were, ciphers with little meaning with respect to the product, until they label it. The inherent distinctiveness of these marks is, in effect, a legal presumption that they will operate to identify the source of the product and distinguish it from others.⁴⁸

No empirical proof of actual source-identification or consumer association is, or can be, demanded of inherently distinctive marks. Descriptive marks, in contrast, must evidence acquired distinctiveness, which is shown through proof of secondary meaning.⁴⁹ The *Restatement (Third) of Unfair Competition* indicates that "[s]econdary meaning exists only if a significant number of prospective purchasers understand the term, when used in connection with a

Cir. 1977) (trademark rights cannot be acquired in generic term); *King-Seeley Thermos Co. v. Aladdin Indus.*, 320 F. Supp. 1156, 1159 (D. Conn. 1970) (term THERMOS had become generic and thus unprotectable as a trademark); see also 15 U.S.C. § 1064(3) (1994) (petition to cancel trademark registration can be made on ground that the registered mark has become generic); *id.* § 1127 (trademark shall be deemed to have been abandoned when any course of conduct of the owner causes the mark to become a generic name for the goods in connection with which it is used). In trademark law, "[a] generic term is one that refers, or has come to be understood as referring, to the genus of which the particular product is a species." *Abercrombie & Fitch Co.*, 537 F.2d at 9. See generally 1 J. GILSON, TRADEMARK PROTECTION AND PRACTICE § 2.02[1] (1994) (discussing the test for determining whether a mark is generic); 2 MCCARTHY, *supra* note 1, § 12.01 (same).

47. See *Two Pesos*, 505 U.S. at 768.

48. See 1 GILSON, *supra* note 46, § 2.09[1] ("The public is presumed to regard [inherently distinctive marks] on first encounter as designating the origin of the products and distinguishing them from the products of others."); see also *Mulberry Thai Silks, Inc. v. K & K Neckwear, Inc.*, 897 F. Supp. 789, 794 (S.D.N.Y. 1995) ("[A] *sine qua non* of any test of inherent distinctiveness must be a requirement that the design be of such a character 'that one can assume without proof that it automatically will be perceived by customers' as an identifier of the source of the product . . ." (quoting 1 MCCARTHY, *supra* note 1, § 8.02[4], at 8-18.1)); *Thompson Med. Co. v. Pfizer, Inc.*, 753 F.2d 208, 216 (2d Cir. 1985) ("Suggestive marks are eligible for protection without any proof of secondary meaning, since the connection between the mark and the source is presumed."); *Blisscraft of Hollywood v. United Plastics Co.*, 294 F.2d 694, 700 (2d Cir. 1961) ("The presumption that a fanciful word or mark becomes distinctive and identifies the source of goods upon which it is used immediately after adoption and bona fide first use is basic in trademark law.").

49. See Sidney A. Diamond, *Untangling the Confusion in Trademark Terminology*, 78 PAT. & TRADEMARK REV. 195, 199 (1980) ("[T]o 'acquire a secondary meaning' is the same as to 'become distinctive.'").

particular kind of good, service, or business, not merely in its lexicographic sense, but also as an indication of association with a particular, even if anonymous, entity."⁵⁰ In the context of packaging or product designs, the term denotes that "the feature, although not inherently distinctive, has come through use to be uniquely associated with a particular source."⁵¹

Important differences exist between the two bases of establishing distinctiveness. One such difference is evidentiary. The inherent distinctiveness analysis is prospective, even speculative. It is a predictive inquiry. In contrast, the secondary meaning inquiry focuses on evidence of actual consumer association.⁵² Another difference is

50. RESTATEMENT, *supra* note 1, § 13 cmt. e.

51. *Id.*; see also *Two Pesos*, 505 U.S. at 766 n.4 (quoting RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 13 cmt. e (Tentative Draft No. 2, 1990) definition as applied to trade dress); *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 851 n.11 (1982) ("To establish secondary meaning, a manufacturer must show that, in the minds of the public, the primary significance of a product feature or term is to identify the source of the product rather than the product itself."), *quoted in Two Pesos*, 505 U.S. at 766 n.4, and in *Qualitex Co. v. Jacobsen Prods. Co.*, 115 S. Ct. 1300, 1303 (1995). The truism that to be protected a mark must "identify the source of the product rather than the product itself" has given rise to misunderstanding by several courts. The meaning of this mantra was explained by Judge Helen Nies in *In re DC Comics, Inc.*:

A word, name, symbol or device, indicates 'source' within the meaning of the truism if it indicates *goods of one producer* to the public, and it indicates 'goods' if the public does not identify the asserted mark with goods from a particular source. The board apparently interpreted the truism as imposing a requirement that to indicate 'source,' a word, name, symbol or device must not identify *goods* of anyone. This misunderstanding led the board and has led some courts into an esoteric and extraneous inquiry focusing on what motivates the purchasing public to buy particular goods, the product itself or the source. Once it is understood that a trademark is functioning to indicate 'source' when it identifies *goods of a particular source*, the truism then reflects the . . . objectives of trademark law

689 F.2d 1042, 1054 (C.C.P.A. 1982) (Nies, J., concurring). The use of the adjective "secondary" is also somewhat misleading in that the key to the concept is that its source-identification meaning is now a significance ascribed to the term by consumers, whereas formerly consumers attributed to the term only a linguistic, descriptive or other initial meaning (i.e., "secondary" is used in a temporal rather than a cognitive sense). See *L. & J.G. Stickley, Inc. v. Canal Dover Furniture Co.*, 79 F.3d 258, 263 (2d Cir. 1996) ("Secondary meaning refers to 'a subsequent significance added to the original meaning' of the trade dress due to a producer's use of it.") (quoting RESTATEMENT, *supra* note 1, § 13 cmt. e) (emphasis added). The alternative terms "acquired distinctiveness" or "learned association" better express the concept. See *International Jensen, Inc. v. Metro-sound U.S.A., Inc.*, 4 F.3d 819, 824 (9th Cir. 1993).

52. Secondary meaning may be proven by direct or indirect evidence from which we can circumstantially infer consumer association. Direct evidence of secondary meaning normally takes the form of consumer surveys linking trade dress to a particular source. See *Vision Sports, Inc. v. Melville Corp.*, 888 F.2d 609, 615 (9th Cir. 1989). While particular factors vary among circuits, indirect indicia of secondary meaning are: advertising expenditures; sales success; unsolicited media coverage; attempts to plagiarize the trade

that, in temporal terms, because inherent distinctiveness can be presumed immediately upon use, it affords instant protection. Secondary meaning takes time to develop. Even if it is inferred circumstantially, proof of secondary meaning must await the development of the evidence from which it can be inferred, and thus protection is not available upon first use.⁵³

III. THE POSSIBILITY OF INHERENTLY DISTINCTIVE SHAPES

Prior to the development of product design protection under the Lanham Act, producers were protected against competitors' confusing or deceptive use of product design features under common-law principles of unfair competition.⁵⁴ In modern times, recourse was first sought primarily under state unfair competition laws, until the Supreme Court's 1964 decisions in *Sears, Roebuck & Co. v. Stiffel Co.*,⁵⁵ and *Compco Corp. v. Day-Brite Lighting, Inc.*,⁵⁶ substantially closed that particular avenue of protection and forced producers to use federal unfair competition law to protect product designs.⁵⁷

dress; and the length and exclusivity of use. See *George Basch Co. v. Blue Coral, Inc.*, 968 F.2d 1532, 1536 (2d Cir. 1992); see also *Echo Travel, Inc. v. Travel Assocs.*, 870 F.2d 1264, 1267 (7th Cir. 1989) (noting that factors to be considered include: consumer testimony; consumer surveys; exclusivity, length and manner of use; amount and manner of advertising; amount of sales and number of customers; established place in the market; and proof of intentional copying). Advertising expenditures are of limited probative value in establishing secondary meaning unless there is evidence of that expenditure's effect. See *First Bank v. First Bank Sys., Inc.*, 84 F.3d 1040, 1045 (8th Cir. 1996); *Braun Inc. v. Dynamics Corp. of Am.*, 975 F.2d 815, 826-27 (Fed. Cir. 1992). Nor does a large consumer demand in itself determine the question of secondary meaning. See *Braun*, 975 F.2d at 827; *Aloe Cream Labs., Inc. v. Milsan, Inc.*, 423 F.2d 845, 850 (5th Cir. 1970); see also *International Jensen, Inc.*, 4 F.3d at 824 ("While evidence of a manufacturer's sales, advertising and promotional activities may be relevant in determining secondary meaning, the true test of secondary meaning is the effectiveness of this effort to create it.").

53. See *infra* note 74 and accompanying text.

54. See, e.g., *Ross Whitney-Corp. v. Smith Kline & French Labs.*, 207 F.2d 190, 197 (9th Cir. 1953) (shape of pills); *Rushmore v. Manhattan Screw & Stamping Works*, 163 F. 939, 942 (2d Cir. 1908) (shell for automobile search lights); *Yale & Towne Mfg. v. Alder*, 154 F. 37, 38 (2d Cir. 1907) (padlocks); *Enterprise Mfg. v. Landers, Frary & Clark*, 131 F. 240, 241 (2d Cir. 1904) (shape of grinding mills); *George G. Fox Co. v. Hathaway*, 85 N.E. 417 (Mass. 1908) (shape, color and condition of bread); *Dior v. Milton*, 155 N.Y.S.2d 443 (Sup. Ct. 1956) (fashion designs).

55. 376 U.S. 225 (1964).

56. 376 U.S. 234 (1964).

57. See Jerome H. Reichman, *Design Protection And The Legislative Agenda*, 55 LAW & CONTEMP. PROB. 281, 288 (1992). In the *Sears* and *Compco* cases, both of which involved the unauthorized copying by the defendant of the unpatentable, uncopyrighted designs of lighting fixtures, the U.S. Supreme Court found claims under Illinois unfair competition law to conflict with and be pre-empted by federal patent law under federal supremacy principles. See *Sears*, 376 U.S. at 232-33; *Compco*, 376 U.S. at 238. Courts interpreted *Sears/Compco* narrowly, permitting the use of federal unfair competition law

Under state unfair competition law, while words or symbols could be protected without proof of secondary meaning if they were inherently distinctive,⁵⁸ a product configuration only received protection upon proof of secondary meaning.⁵⁹ As the Supreme Court

to protect product designs. See Dinwoodie, *supra* note 17, at 92-93; see, e.g., *Truck Equip. Serv. Corp. v. Fruehauf*, 536 F.2d 1210, 1214 (8th Cir. 1976). This distinction was supported not only by a careful reading of the *Sears/Compco* decisions, which were clearly founded upon the Supremacy Clause of the United States Constitution, but also by reference to one of the declared purposes of the Lanham Act, namely to ensure uniform protection in a national economy after *Erie Railroad v. Tompkins*, 304 U.S. 64 (1938). See H.R. REP. NO. 76-944, at 4 (1939) (according to *Erie*, "there is no Federal Common Law However, trade is no longer local, but is national It would seem as if national legislation along national lines securing to the owners of trade-marks in interstate commerce definite rights should be enacted."). Moreover, in *Sears*, the Supreme Court expressly excluded from the scope of its decision protection under federal statutes, see 376 U.S. at 232, and the Court has since confirmed that its *Sears/Compco* reasoning has no application to federal causes of action under the Lanham Act. See *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 166 (1989); see also Dinwoodie, *supra* note 17, at 92-93 (discussing limits of *Sears/Compco*). One writer has recently suggested that only *Sears* rested upon application of the Supremacy Clause. See Theodore H. Davis, Jr., *Copying in the Shadow of the Constitution: The Rational Limits of Trade Dress Protection*, 80 MINN. L. REV. 595, 610-611 (1996) ("Notwithstanding the Court's reliance on the Supremacy Clause in *Sears*, its decision on the same day in *Compco* made no reference whatsoever to that provision."). Although the *Compco* opinion does indeed omit express reference to the Supremacy Clause, the Supreme Court itself (which handed down both opinions on the same day) appears to have treated *Sears* and *Compco* as companion cases, presenting the same issues, and resting upon the same reasoning. See *Sears*, 376 U.S. at 225 (stating question before Court); *Compco*, 376 U.S. at 234 (stating that the question before the Court was the same as in *Sears*); *id.* at 237-38 (repeated reference throughout opinion to the fact that the operative proposition had been stated in *Sears*); see also *Bonito Boats*, 489 U.S. at 152-57 (treating *Sears* and *Compco* decisions largely as one); RESTATEMENT, *supra* note 1, § 16 reporters' note at 169-70 (noting that the Supreme Court has made clear that *Sears* and *Compco* rest solely on the Supremacy Clause).

58. See *Two Pesos*, 505 U.S. at 786 (Thomas, J., concurring) (citing *Heublein v. Adams*, 125 F. 782, 784 (C.C.D. Mass. 1903)).

59. See *Crescent Tool Co. v. Kilborn & Bishop Co.*, 247 F. 299, 300 (2d Cir. 1917); 1 MCCARTHY, *supra* note 1, § 7.23[1]; see also *Duraco Prods. v. Joy Plastic Enters.*, 40 F.3d 1431, 1443 (3d Cir. 1994) (collecting cases). Early courts failed to articulate fully their reasons for requiring secondary meaning for shapes but not verbal marks in common-law claims. It appears that the primary basis for placing an additional hurdle in the way of product configuration plaintiffs was the concern that trademark could supplant patent law and provide infinite patent protection. See *American Fork & Hoe Co. v. Stampit Corp.*, 125 F.2d 472, 475 (6th Cir. 1942) ("In the absence of a patent the freedom of manufacture cannot be cut down under the name of preventing unfair competition." (quoting *Flagg Mfg. v. Holway*, 59 N.E. 667, 667 (Mass. 1901))). It is clear that these courts proceeded from the premise of free imitation, whereas many modern courts start with an assumption of protecting against piracy. See, e.g., *J.C. Penney Co. v. H.D. Lee Mercantile Co.*, 120 F.2d 949, 955 (8th Cir. 1941) ("The public interest in competition ordinarily outweighs the interest in securing to a person the rewards of his ingenuity in making his product attractive to purchasers." (quoting RESTATEMENT OF TORTS § 742, at 622 (1938))).

noted in 1989, "[t]he common law tort of unfair competition [had] been limited to protection against copying of nonfunctional aspects of consumer products which [had] acquired secondary meaning such that they operate[d] as a designation of source."⁶⁰ When the courts began to offer enhanced protection to product shapes under federal unfair competition law, they substantially imported the elements of the common-law unfair competition claim. However, a conflict arose between the principles of common-law protection and federal trademark law. The common-law rule that, to be protectable, a shape must have acquired secondary meaning, clashed with the trademark rule that certain classifications of marks would be treated as inherently distinctive and protected without proof of actual consumer association.

The federal courts split on the issue of whether trade dress in the form of a product shape could be protected as inherently distinctive, without proof of secondary meaning, in actions brought under the Lanham Act. Certain courts viewed the assimilation of the common law of unfair competition with the trademark provisions of the Lanham Act as complete, and drew no distinction between trade dress and trademarks. Each could be inherently distinctive, thus obviating the need to prove secondary meaning in such cases.⁶¹ A larger number of courts,⁶² however, retained the common-law rule that trade

60. *Bonito Boats*, 489 U.S. at 158; *see also* 1 MCCARTHY, *supra* note 1, § 7.23[1] ("At common law, product and package configurations, to be protected against unfair competition by simulation, have to meet three basic criteria: (1) nonfunctionality; (2) proof of secondary meaning; and (3) likelihood of confusion.").

61. *See, e.g.*, *Roulo v. Russ Berrie & Co.*, 886 F.2d 931, 936 (7th Cir. 1989) (greeting cards); *Vaughan Mfg. Co. v. Brikam Int'l, Inc.*, 814 F.2d 346, 348 (7th Cir. 1987) (accepting possibility of inherently distinctive product configuration) (folding tables); *AmBrit, Inc. v. Kraft, Inc.* 812 F.2d 1531, 1535 n.13 (11th Cir. 1986) (wrapping); *Sicilia Di R. Biebow & Co. v. Cox*, 732 F.2d 417, 426 (5th Cir. 1984) (design of citrus juice bottles); *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1343 (C.C.P.A. 1982) (product and container configurations can be inherently distinctive); *Chevron Chem. Co. v. Voluntary Purchasing Groups, Inc.*, 659 F.2d 695, 702 (Former 5th Cir. 1981) (packaging); *Remcraft Lighting Prods., Inc. v. Maxim Lighting, Inc.*, 706 F. Supp. 855, 857 (S.D. Fla. 1989) (accepting possibility of inherently distinctive product configurations) (lamps); *Westward Co. v. Gem Prods., Inc.*, 570 F. Supp. 943, 951 (E.D. Mich. 1983) (packaging); *see also* *Blau Plumbing, Inc. v. S.O.S. Fix-It, Inc.*, 781 F.2d 604, 608 (7th Cir. 1986) ("If any of these cases stands for the broader proposition that secondary meaning must be shown even if the trade dress is a distinctive, identifying mark, then we think they are wrong . . ."); *cf. M. Kramer Mfg. v. Andrews*, 783 F.2d 421, 448 & 449 n.26 (4th Cir. 1986) (noting cases recognizing the possibility of inherently distinctive trade dress, but including secondary meaning requirement in articulation of test).

62. This approach was adopted most notably in the Second Circuit, *see infra* notes 64-66, but the distinction between trade dress and verbal trademarks was also adhered to by other courts. *See, e.g.*, *Can-Am Eng'g Co. v. Henderson Glass, Inc.*, 814 F.2d 253, 256

dress protection was contingent upon proof of secondary meaning.⁶³ Decisions in the Second Circuit, where proof of secondary meaning was required, diverged on whether the basis for that requirement was that the action was brought under the unfair competition provision of the Lanham Act, section 43(a),⁶⁴ or because it involved trade dress

(6th Cir. 1987) (requiring plaintiff to show that "product features . . . are nonfunctional and have acquired secondary meaning"); *American Greetings Corp. v. Dan-Dee Imports, Inc.*, 807 F.2d 1136, 1141 (3d Cir. 1986) (listing secondary meaning as an element of trade dress claim); *Pruffrock Ltd. v. Lasater*, 781 F.2d 129, 132 (8th Cir. 1986) (applying the secondary meaning requirement to the claimed trade dress of a restaurant); *Black & Decker Mfg. Co. v. Ever-Ready Appliance Mfg. Co.*, 684 F.2d 546, 550 (8th Cir. 1982) (holding that lack of secondary meaning precludes claim of trade dress infringement); *Keebler Co. v. Rovira Biscuit Corp.*, 624 F.2d 366, 378 (1st Cir. 1980) (referring to secondary meaning as an "essential element" of a trade dress claim); *White Swan, Ltd. v. Clyde Robin Seed Co.*, 729 F. Supp. 1257, 1260 (N.D. Cal. 1989) (court declaring itself "unpersuaded" that cylindrical, shaker-type container with design on label can be protected without secondary meaning: "although other circuits have clearly stated that an inherently distinctive trade dress may be protected without proof of secondary meaning, the Ninth Circuit has refused to take such a step"); see also *Tesco Chems., Inc.*, 181 U.S.P.Q. (BNA) 59, 60 (T.T.A.B. 1973) (explaining that product configuration is registrable only if it has acquired secondary meaning because such a shape is "necessarily merely descriptive"); cf. *In re DC Comics, Inc.*, 689 F.2d 1042, 1050-51 (C.C.P.A. 1982) (Nies, J., concurring) (suggesting that no product shape could be inherently distinctive, although packaging might). In *Two Pesos* the Supreme Court suggested that the Ninth Circuit followed the *Chevron* rule of the Fifth Circuit, which accepted the possibility of inherently distinctive trade dress, see *Two Pesos*, 505 U.S. at 773-74 & 781 n.13, but the case law in the Ninth Circuit was more ambivalent than the court implied. See, e.g., *White Swan*, 729 F. Supp. at 1260; *Fuddrucker, Inc. v. Doc's B.R. Others, Inc.*, 826 F.2d 837, 843 (9th Cir. 1987) (not deciding issue, but both accepting possibility of claim based upon inherent distinctiveness, and noting that if purchasers do not in fact make the source association then "it is difficult to see" how the trade dress is distinctive); *First Brands Corp. v. Fred Meyer, Inc.*, 809 F.2d 1378, 1381 (9th Cir. 1987) (including secondary meaning as a requirement of trade dress cause of action under section 43(a) or at common law, but not addressing issue of inherent distinctiveness).

63. The Court of Appeals for the Fifth Circuit, which rejected the Second Circuit position, took the view that "section 43(a) created a *sui generis* federal statutory cause of action for 'false representation' [and that, t]herefore, common-law decisions interpreting this tort, while suggestive, are not controlling." *Chevron Chem. Co.*, 659 F.2d at 702; see also *Two Pesos*, 505 U.S. at 779 (Stevens, J., concurring) ("We find nothing in the legislative history of the Lanham Act to justify the view that [section 43(a)] is merely declarative of existing law." (quoting *L'Aiglon Apparel, Inc. v. Lana Lobell, Inc.*, 214 F.2d 649, 651 (3d Cir. 1954))). Justice Thomas, in concurring in *Two Pesos*, and agreeing that secondary meaning was not required in trade dress actions under section 43 of the Lanham Act, asserted that section 43(a) merely codified the common-law torts of trademark infringement and passing off. See 505 U.S. at 785 (Thomas, J., concurring). Although the Second Circuit's approach implemented the distinction operable at common law, Justice Thomas was willing to join the opinion of the Court on the basis of his view of prior judicial developments accepting that packages or images may be as arbitrary as words or symbols. See *id.* at 785-87 (Thomas, J., concurring).

64. See, e.g., *Vibrant Sales, Inc. v. New Body Technique, Inc.*, 652 F.2d 299, 303-04 (2d Cir. 1981) (suggesting that "registered marks are presumed to represent the source in the minds of the public, whereas unregistered marks are not, absent a showing of secon-

inhering in a shape as opposed to a verbal trademark.⁶⁵ Later courts emphasized the latter, although their decisions often also rested on a combination of the non-verbal composition of the mark and the unregistered nature of the trade dress at issue.⁶⁶

dary meaning"). The analysis of the *Vibrant* court affords too great a presumption (and the wrong presumption) to registration. Contrary to the assertions in *Vibrant*, the presumptions flowing from registration are rebuttable presumptions regarding the correctness of administrative decisions, namely that a mark is inherently distinctive, if registered on that basis, or possesses secondary meaning, if registered on that basis. See *Aromatique, Inc. v. Gold Seal, Inc.*, 28 F.3d 863, 870 (8th Cir. 1994) (stating that registrant receives presumption corresponding to basis upon which registration granted); *Pizzeria Uno Corp. v. Temple*, 747 F.2d 1522, 1529 (4th Cir. 1984) (same); *McGregor-Doniger, Inc. v. Drizzle, Inc.*, 599 F.2d 1126, 1132 (2d Cir. 1979) (registration of mark without requiring secondary meaning affords a rebuttable presumption that the mark is more than merely descriptive); see also 15 U.S.C. § 1057(b) (1994) (registration is *prima facie* evidence of mark validity, that registrant owns the mark and has exclusive right to use the mark); cf. 15 U.S.C. § 1115(b) (1994) (incontestability establishes conclusive evidence of valid ownership and right to use, subject to stated defenses). In contrast, the presumption of consumer association that lies at the root of inherent distinctiveness is not based on registration (although registration *on that basis* affords a helpful rebuttable presumption in an infringement action) but upon the likelihood that consumers would immediately identify the product by reference to the feature or mark at issue. Thus, a mark which is inherently distinctive "even if not registered, remain[s] inherently capable of distinguishing the goods of the users of these marks." *Two Pesos*, 505 U.S. at 772.

65. See *Thompson Med. Co. v. Pfizer, Inc.*, 753 F.2d 208, 213 n.10 (2d Cir. 1985) (reconciling *Vibrant* with other trademark decision by noting that it involved a "design claimed to be a trademark" whereas other trademark decision involved a "word mark"). The Second Circuit did not explain why the distinction between shapes and verbal marks justified this difference in approach. See *Two Pesos*, 505 U.S. at 781 n.14 (Stevens, J., concurring). However, the differentiation arguably could be founded not only on the common-law origins of the protection of shapes under unfair competition law but also upon the practical difficulty of rendering an objective judgment about the distinctiveness of shapes based upon the classical conceptual categories, and without some more concrete evidence, such as that typically advanced in a secondary meaning analysis. See Malla Pollack, *Unconstitutional Incontestability? The Intersection of the Intellectual Property and Commerce Clauses of the Constitution: Beyond a Critique of Shakespeare Co. v. Silstar Corp.*, 18 SEATTLE U. L. REV. 259, 264 n.27 (1995) ("These tests, and these categories of marks, were created in an age when word marks predominated. Acceptance of packages and the configuration of the goods themselves as marks strains the system. The Supreme Court's decision that unregistered trade dress may be protected without a showing of secondary meaning exacerbates this problem."). The Second Circuit's approach, which sought the assistance of empirical study of consumer association, thus not only paid deference to the common-law roots of the protection offered but also incidentally corresponded with recognition that traditional trademark classifications of distinctiveness are rather enigmatic when the mark is not verbal. See *infra* text accompanying notes 105-12. As suggested below, however, it is possible to fashion guidelines for the development of evidence relevant to the distinctiveness question without imposing a secondary meaning requirement. See *infra* Part IV(E)(2).

66. See, e.g., *Murphy v. Provident Mut. Life Ins. Co.*, 923 F.2d 923, 927 (2d Cir. 1990) ("[I]n our circuit, . . . non-verbal marks that are unregistered always require proof of secondary meaning."); *Stormy Clime, Ltd. v. ProGroup, Inc.*, 809 F.2d 971, 974 (2d Cir. 1987); *Union Mfg. Co. v. Han Baek Trading Co.*, 763 F.2d 42, 48 (2d Cir. 1985) ("Unlike arbitrary or suggestive verbal marks, which are eligible for protection under section 43(a)

In *Two Pesos, Inc. v. Taco Cabana, Inc.*,⁶⁷ the Supreme Court addressed the split among the circuits. The trade dress at issue in *Two Pesos* was the decor and ambiance of a fast-food Mexican restaurant. At trial, the jury found that the plaintiff had established a trade dress that was inherently distinctive but which had not acquired secondary meaning in the Texas market.⁶⁸ The jury also found that the trade dress was nonfunctional and that there was a likelihood of confusion.⁶⁹ Applying its rule that permitted protection of inherently distinctive trade dress without proof of secondary meaning, the Court of Appeals for the Fifth Circuit affirmed the verdict of trade dress infringement, and the Supreme Court in turn affirmed the Fifth Circuit.⁷⁰

Reasoning that “there is no persuasive reason to apply to trade dress a general requirement of secondary meaning which is at odds with the principles generally applicable to infringement suits under section 43(a),” the Court decided that an inherently distinctive trade dress can be protected without proof of secondary meaning.⁷¹ The Court found no textual basis (either in the terms of the Lanham Act or in its legislative history) for applying different standards to trade

without proof of secondary meaning, non-verbal marks that are unregistered always require proof of secondary meaning.” (citations omitted) (footnote omitted)). In *Two Pesos*, where the issue was resolved, the Supreme Court itself was not entirely clear about the body of Second Circuit case law it was addressing. See 505 U.S. at 772-73. It noted the Fifth Circuit’s acknowledgment that the Fifth Circuit approach “conflict[ed] with . . . the holding of the Court of Appeals for the Second Circuit in *Vibrant* . . . that section 43(a) protects unregistered trademarks or designs only where secondary meaning is shown.” *Id.* at 767. Yet, the Supreme Court also characterized the “line of decisions by the Court of Appeals for the Second Circuit” as finding “protection for trade dress unavailable absent proof of secondary meaning.” *Id.* at 772. Overall, the scope of the Court’s decision—as the Court defines its scope—is a composite, and relates to the absence of a distinction between verbal and non-verbal marks in actions under section 43(a). See *id.* at 767 (noting that the Court granted certiorari on the question “whether trade dress which is inherently distinctive is protectable under section 43(a) without a showing that it has acquired secondary meaning”); see also *id.* at 773 (“The Second Circuit has . . . continued to deny protection for trade dress under section 43(a) absent proof of secondary meaning, despite the fact that section 43(a) provides no basis for distinguishing between trademark and trade dress.”). The *Two Pesos* decision is critical of either derogation from full assimilation of Lanham Act claims under a unitary set of standards, whether on the basis of registration or mark composition. See *infra* note 72. But see *Qualitex Co. v. Jacobsen Prods. Co.*, 115 S. Ct. 1300, 1303 (1995) (appearing to base protection of color per se on existence of secondary meaning, equating color per se with descriptive words).

67. 505 U.S. 763 (1992).

68. See *id.* at 766.

69. See *id.* at 767.

70. See *id.*

71. See *id.* at 770.

dress and trademarks, especially since protection of trade dress and trademarks under section 43(a) serve the same statutory purpose.⁷²

The Court also recognized that a secondary meaning requirement would make investment in trade dress vulnerable in the early stages of product marketing and distribution.⁷³ Where the distinct-

72. See *id.* at 774. The Supreme Court addressed its various textual arguments both to the suggestion that verbal marks and non-verbal trade dress be treated differently and to the contention of the *Vibrant* court that a distinction should be drawn between cases alleging infringement of a registered mark and causes of action under section 43(a). As to the former, the court concentrated on the lack of any textual basis for a difference, noting that section 43(a) did not contain any reference to "trade dress" or "trademarks," or to "verbal" or "symbolic" marks, let alone establish any distinctions among them. See *id.* Rebuttal of the *Vibrant* distinction found affirmative support in the fact that secondary meaning is mentioned only in connection with the registration of descriptive marks and not in section 43(a). See *id.*

73. See *id.* at 771 (recognizing argument that "a general requirement of secondary meaning imposes an unfair prospect of theft or financial loss on the developer of fanciful or arbitrary trade dress at the outset of its use"); *id.* at 775 ("[A]dding a secondary meaning requirement . . . would present special difficulties for a business . . . that seeks to start a new product in a limited area and then expand into new markets."). The Court accepted the force of this argument even though, in the same opinion, the Court rejected the doctrine of "secondary meaning in the making," which was designed to address precisely this vulnerability. Some district courts in the Second Circuit had periodically floated the doctrine in the two decades before *Two Pesos*; if adopted, it would have greatly aided designers in that exposed early period of marketing by protecting goodwill that was still nascent. Under the doctrine, a producer received protection for its as-yet non-distinctive marks against competitors' deliberate efforts to copy the mark, provided that the producer was attempting to create secondary meaning. See *Metro-Kane Imports, Ltd. v. Federated Dept. Stores*, 625 F. Supp. 313, 316 (S.D.N.Y. 1985) (accepting that trade dress will be protected against "intentional, deliberate attempts to capitalize on a distinctive product" where secondary meaning is "in the making but not yet fully developed"), *aff'd*, 800 F.2d 1128 (2d Cir. 1986). Only one reported decision appeared to rest squarely on the doctrine, see *Metro-Kane*, 625 F. Supp. at 316 (granting preliminary injunction on basis of doctrine), but several district court opinions appeared receptive to its adoption. See, e.g., *Jolly Good Indus., Inc. v. Elegra Inc.*, 690 F. Supp. 227, 230-31 (S.D.N.Y. 1988); see also 2 MCCARTHY, *supra* note 1, § 15.21[2], at 15-83 n.6 (collecting cases). See generally John M. Scagnelli, *Dawn of a New Doctrine?—Trademark Protection for Incipient Secondary Meaning*, 71 TRADEMARK REP. 527 (1981).

Although this doctrine had the advantage of affording instant protection, it was inconsistent with the basic premise of trademark law that only marks with consumer association (actual or presumed) can be protected. Outside the Second Circuit, courts rejected the doctrine. See, e.g., *Black & Decker Mfg. Co. v. Ever-Ready Appliance Mfg. Co.*, 684 F.2d 546, 550 (8th Cir. 1982); *Devan Designs Inc. v. Palliser Furniture Corp.*, 25 U.S.P.Q.2d (BNA) 1991, 2000 (M.D.N.C. 1992) (criticizing the doctrine on the basis that "secondary meaning in the making focuses on the intent and actions of the seller, but Lanham Act protection rests upon mental processes of the public in its association of the trade dress with a particular producer"), *aff'd*, 998 F.2d 1008 (4th Cir. 1993); *A.J. Canfield Co. v. Concord Bev. Co.*, 629 F. Supp. 200, 211-12 (E.D. Pa. 1985), *aff'd on other grounds*, 808 F.2d 291 (3d Cir. 1986); see also RESTATEMENT, *supra* note 1, § 13 cmt. e reporters' note at 117 ("The doctrine, if taken literally, is inimical to the purpose of the secondary meaning requirement."); 2 MCCARTHY, *supra* note 1, § 15.21[2], at 15-86 (criticizing doc-

iveness of a mark is based upon secondary meaning, infringement will only occur if the secondary meaning existed prior to the date upon which the accused infringer commenced using a confusingly similar trade dress.⁷⁴ Deferral of protection, as is precipitated by the refusal to countenance inherently distinctive trade dress, thus creates the danger that “the acquisition of trademark rights in a design may be prevented by the timely entry of others into the market using the same or similar designs.”⁷⁵ According to the Court, that vulnerability

trine). It targeted blatant piracy rather than consumer confusion or the misappropriation of goodwill, because without the consumer association that is at the root of secondary meaning, there would be no confusion and no goodwill to misappropriate. In any event, the Court of Appeals for the Second Circuit—whose district courts had developed the doctrine—itsself rejected the doctrine in 1992, concluding that it “constrains unnecessarily the freedom to copy and compete.” *Laureyssens v. Idea Group, Inc.*, 964 F.2d 131, 138 (2d Cir. 1992). The Second Circuit had previously indicated in dicta that it would be reluctant to adopt the doctrine. See *Lang v. Retirement Living Publ’g Co.*, 949 F.2d 576, 581 (2d Cir. 1991); cf. *Murphy v. Provident Mut. Life Ins. Co.*, 923 F.2d 923, 929 (2d Cir. 1990) (explaining that even if court were to adopt the doctrine, this was not the case in which to do it). The Court of Appeals for the Federal Circuit had also previously concluded that the “Second Circuit, if faced with the question, would reject the doctrine of secondary meaning in the making.” *Cicena Ltd. v. Columbia Telecomms. Group*, 900 F.2d 1546, 1550 (Fed. Cir. 1990). Within one month of rejection by the Second Circuit, the Supreme Court in *Two Pesos* also rejected the doctrine. See *Two Pesos*, 505 U.S. at 775.

74. See *Tone Bros., Inc. v. Sysco Corp.*, 28 F.3d 1192, 1201 (Fed. Cir. 1994); *Co-Rect Prods., Inc. v. Marvy! Adver. Photography, Inc.*, 780 F.2d 1324, 1330 (8th Cir. 1985) (“The user must also show that secondary meaning existed prior to the date on which the defendant commenced using the same or similar mark.”).

75. *In re DC Comics, Inc.*, 689 F.2d 1042, 1051 (C.C.P.A. 1982) (Nies, J., concurring). Judge Nies cast this situation not as a danger, but as part of the balancing of competing public interests that supported a deferral of protection. See *id.* While all trademarks relying on secondary meaning for protection are susceptible to imitation in the first months or years after being placed on the market, this weakness is more significant for product configuration trade dress because so few are protected from the start as inherently distinctive. While “no absolute time span can be posited as a yardstick in cases involving secondary meaning,” *Centaur Comms., Inc. v. A/S/M Comms.*, 830 F.2d 1217, 1225 (2d Cir. 1987), the longer a product is on the market, the stronger a claim of acquired distinctiveness becomes. See, e.g., *Duraco Prods. v. Joy Plastic Enters.*, 40 F.3d 1431, 1454 (3d Cir. 1994) (more than five years on market insufficient to establish secondary meaning); *Braun, Inc. v. Dynamics Corp. of Am.*, 975 F.2d 815, 826 (Fed. Cir. 1992) (“[W]hile not impossible, it is difficult for a product to acquire secondary meaning during an 18-month period.”); *Cicena*, 900 F.2d at 1552 (noting that eighteen months on the market cuts against a finding of secondary meaning); *Devan Designs*, 25 U.S.P.Q.2d (BNA) at 1998 (eighteen months insufficient period); cf. *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1130 (Fed. Cir. 1993) (secondary meaning established *despite* short time of one year on market). Assertions that “[i]n a world of fad products and modern merchandising, a new trademark can receive wide exposure and secondary meaning within a very short time,” *Devan Designs*, 25 U.S.P.Q.2d (BNA) at 1998, are little comfort to many producers. Initial vulnerability is a particular problem for small producers who have neither the resources nor the marketing or distribution network to ensure expedited and broad product exposure. It is also a problem that may be more acute for certain indus-

would undermine the statutory purpose both of protecting goodwill and of protecting consumers.⁷⁶

Finally, the potentially anti-competitive effects that a secondary meaning requirement might create influenced the Court.⁷⁷ An initial

tries where, for reasons cultural or otherwise, the marketing blitz is unused or counter-productive. *See id.* (holding that eighteen months insufficient period to establish secondary meaning in furniture line notwithstanding "national media attention and marketing" because it "was not promoted via a marketing blitz like certain new cars or other products"); *see also* S. Priya Bharathi, *There is More Than One Way to Skin a Copycat: The Emergence of Trade Dress to Combat Design Piracy of Fashion Works*, 27 TEX. TECH L. REV. 1667, 1691 (1996) ("In a rapidly changing industry [such as fashion] where trends arise almost every season, the length of time required to establish secondary meaning is unlikely to be met."); Steven Schortgen, Note, "Dressing" Up Software Interface Protection: The Application of Two Pesos To "Look And Feel," 80 CORNELL L. REV. 158, 191 (1994) ("In the rapidly changing computer [software] landscape, the length of time required to establish secondary meaning could be quite long relative to significant changes in technology . . .").

76. *See Two Pesos*, 505 U.S. at 774 ("By making more difficult the identification of a producer with its product, a secondary meaning requirement for a nondescriptive trade dress would hinder improving or maintaining the producer's competitive position."). While, from a producer's perspective, denying a possible claim of inherent distinctiveness does indeed create an exposure to imitative competition, the Court's argument fails in the circumstance, admittedly rare but present in *Two Pesos*, where there is an affirmative finding of no secondary meaning. If it is demonstrated that there is in fact no consumer association, then no consumers will be confused and no goodwill will be misappropriated because there is none to be taken. Any rule that limits the availability of trademark protection necessarily renders the producer's position less favorable, but if empirical evidence suggests that consumer association is non-existent it is difficult to see how the producer has lost anything that is protected by trademark law. *Cf.* Kenneth B. Germain, *Unfair Trade Practices Under Section 43(a) of the Lanham Act: You've Come a Long Way, Baby—Too Far, Maybe?*, 49 IND. L.J. 84, 103 (1973) ("Unless the public has come to know a particular mark as indicating a particular source of origin, a finding of the requisite falsity would be anomalous since there would be no standard against which to measure such falsity.") (commenting on pre-1988 Lanham Act language in section 43). The Court does not fully explain its reasons for accepting a claim based on inherent distinctiveness in the face of empirical rebuttal of the factual premises underlying that concept. It treats as an immutable truth (consumers are likely to make an association) that which is no more than a factual generalization demonstrated to be incorrect in the particular instance before the court. The prediction that consumers will likely associate a product shape with a specific source should surely give way to *factual findings* that it *does not*. While protection needs to be offered to distinctive designs, and the Court properly acknowledges that such protection might appropriately be accorded designs on the basis that they are likely to identify source, it is not appropriately furnished by trademark law to designs that affirmatively do not do so. (Although a defendant could use this argument to trump a finding of inherent distinctiveness in litigation soon after the product's first marketing, the burden of rebutting the conclusion of inherent distinctiveness by showing a lack of secondary meaning would at least rest with the defendant.)

77. The *Two Pesos* Court noted:

[A]dding a secondary meaning requirement could have anticompetitive effects, creating particular burdens on the start-up of small companies. . . . It would present special difficulties for a business . . . that seeks to start a new product in a limited area and then expand into new markets. Denying protection for inher-

period of vulnerability would have the most burdensome effect on the start-up of small businesses, whose product developments could be appropriated by large companies with established and substantial distribution channels. Thus, an absolute secondary meaning requirement would discourage new market entrants.⁷⁸ The Court rejected concerns that its approach was overprotective and would exhaust a limited number of trade dresses, noting that the functionality rule (which limits the availability of claimed trade dress rights if protection would hinder competition) already worked against such anti-competitive effects.⁷⁹ Although not mentioned by the Supreme Court, another consequence of removing an absolute secondary meaning requirement, which is especially helpful to smaller businesses with more limited resources, is that the cost of pursuing litigation is arguably reduced because of the lesser need⁸⁰ for commis-

ently distinctive nonfunctional trade dress until after secondary meaning has been established would allow a competitor, which has not adopted a distinctive trade dress of its own, to appropriate the originator's trade dress in other markets and to deter the originator from expanding into and competing in these areas.

Two Pesos, 505 U.S. at 775.

78. Cf. *id.* (noting concession that "protecting an inherently distinctive trade dress from its inception may be critical to new entrants to the market"). Over-emphasis on the vulnerability of market entrants, without regard to whether the design acts, or is likely to act, as a source-identifier, carries the risk of extending trade dress law beyond its legitimate objectives of confusion-avoidance and the protection of goodwill. See *supra* note 76. The problem of safeguarding the creative efforts of new market entrants as such would best be resolved by adoption of an appropriately tailored design law. See Graeme B. Dinwoodie, Addressing Functionalism 8 (Sept. 27, 1995) (calling for *sui generis* design law that "provide[s] the certainty of protection for industrial designs while maintaining a properly competitive environment") (draft article on file with author).

79. See *Two Pesos*, 505 U.S. at 774-75; see also *Qualitex Co. v. Jacobsen Prods. Co.*, 115 S. Ct. 1300, 1306 (1995) (explaining that protection can be afforded colors per se without restricting alternatives because the functionality doctrine is available to prevent such anticompetitive consequences). The Supreme Court has noted that "in general terms a product feature is functional if it is essential to the use or purpose of the article or if it affects its cost or quality." *Inwood Lab., Inc. v. Ives Labs, Inc.*, 456 U.S. 844, 850 n.10 (1982) (O'Connor, J., concurring), quoted in *Qualitex*, 115 S. Ct. at 1306. A significant factor in determining whether a claimed product design trade dress is functional, and thus unprotectable, is the range of feasible alternative designs. See, e.g., *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996, 1006 (2d Cir. 1995) (rejecting defendant's argument of functionality where no evidence that the number of designs available to compete with plaintiff's product were limited). For a fuller analysis of the functionality doctrine and its role as the safety-valve built in to trade dress protection of product design, see Dinwoodie, *supra* note 17, at 2-40.

80. Surveys assessing the different question of actual consumer confusion do, however, remain important in establishing trade dress claims, and in particular in proving infringement. A trade dress plaintiff need not demonstrate actual consumer confusion in order to prove infringement: a likelihood of consumer confusion is sufficient. See RESTATEMENT, *supra* note 1, § 23 cmt. b; RICHARD L. KIRKPATRICK, LIKELIHOOD OF

sioned surveys to demonstrate the requisite secondary meaning.⁸¹

CONFUSION IN TRADEMARK LAW § 7.1, at 7-1 (1995); 3 MCCARTHY, *supra* note 1, § 23.02[1], at 23-30; *cf.* RESTATEMENT, *supra* note 1, § 36 cmt. i (“[A]ctual confusion . . . is normally a prerequisite to the recovery of compensatory damages.”). Proof of instances of actual consumer confusion is, however, persuasive evidence of a likelihood of consumer confusion. *See* Michael J. Allen, *The Role of Actual Confusion Evidence in Trademark Infringement Litigation*, 83 TRADEMARK REP. 267, 269 (1993). Conversely, some courts have suggested that “[i]f a defendant’s product has been sold for an appreciable period of time without evidence of actual confusion, one can infer that continued marketing will not lead to consumer confusion in the future.” *Versa Prods. Co. v. Bifold Co.*, 50 F.3d 189, 205 (3d Cir.), *cert. denied*, 116 S. Ct. 54 (1995); *see also* Allen, *supra*, at 299 (arguing that inability of plaintiff to introduce evidence of instances of actual confusion may in certain circumstances be relevant, but should not lead to the blanket presumption that confusion is unlikely); *cf.* *Chevron Chem. Co. v. Voluntary Purchasing Groups, Inc.*, 659 F.2d 695, 704 (Former 5th Cir. 1981) (absence of evidence of actual confusion does not necessarily prove that confusion unlikely). Proof of actual confusion may take the form of the testimony of a reasonably prudent purchaser who was in fact confused by defendant’s use of the trade dress, or of consumer surveys. *See* RESTATEMENT, *supra* note 1, § 23 cmt. c (“Actual confusion can be established through the direct testimony of consumers . . . [and] through evidence of conduct probative of confusion such as misdirected letters and telephone calls.”); *see also* Allen, *supra*, at 299 (“Many courts have considered a properly conducted likelihood of confusion market survey to be probative evidence of actual confusion.”); *cf.* 3 MCCARTHY, *supra* note 1, § 23.01[2], at 23-11 (“While survey evidence is sometimes said to be evidence of ‘actual’ confusion, it is so only to the extent that the survey mirrors the real world setting which can create an instance of actual confusion.”). The best evidence of actual confusion is testimony of actually confused purchasers, but most trade dress plaintiffs will seek to introduce survey evidence to support assertions of likely confusion. *See* 3 *id.* § 23.02[2][e], at 23-40 (“In borderline cases where evidence of actual confusion is not available or is not overwhelming, the gap should best be filled by a properly conducted survey of the relevant class of prospective customers of the goods or services at issue.”). Such surveys are not, however, essential. *See* RESTATEMENT, *supra* note 1, § 23 cmt. c (“Surveys are useful but not indispensable evidence of the likelihood of confusion, and no inference on that issue should be drawn from a mere failure to offer survey evidence.”). *But cf.* *Merriam-Webster, Inc. v. Random House, Inc.*, 35 F.3d 65, 72 (2d Cir. 1994) (“The lack of survey evidence counts against finding actual confusion.”), *cert. denied*, 115 S. Ct. 1252 (1995).

81. *See* Paul Farhi, *Texas Tortilla Flap Widens Trademark Law’s Reach*, WASH. POST, June 27, 1992, at D5 (noting that “previously . . . a company might have had to conduct consumer surveys and bring in expert testimony to prove that a product’s packaging or presentation was essential to its identity among consumers, an expensive proposition”); Mark Hamstra, *Trade Dress Lawsuits: Unique, Nonfunctional, Design Signatures are Key to Copycat Cases*, NATION’S RESTAURANT NEWS, Oct. 9, 1995, at 142, 142 (1995) (noting importance of *Two Pesos* in eliminating need for exhaustive consumer research and expert witnesses); *see also* *Taco Cabana, Inc. v. Two Pesos, Inc.*, 932 F.2d 1113, 1120 n.7 (5th Cir. 1991) (remarking on the “necessarily imperfect (and often prohibitively difficult) methods for assessing secondary meaning”), *aff’d*, 505 U.S. 763 (1992); *cf.* *Roulo v. Russ Berrie & Co.*, 886 F.2d 931, 936-37 (7th Cir. 1989) (noting that plaintiff “did not offer as much evidence on the secondary meaning of her cards as on their [inherent] distinctiveness, no doubt since it is easier to show the cards are unique than to poll greeting card consumers on whether they identify [her] cards with a single source”). The Lanham Act permits a prevailing plaintiff to recover the cost of its action, *see* 15 U.S.C. § 1117(a) (1994), but this is unlikely to include the costs of conducting consumer surveys. *See* *Gillette Co. v. Wilkinson Sword, Inc.*, No. 89 Civ. 3586, 1992 WL 30938, at *10 (S.D.N.Y. Feb. 3, 1992) (declining to award costs of conducting consumer confusion survey).

Thus, even in the Second Circuit, trade dress infringement under either section 32 or section 43 is now established by showing: (1) the trade dress is distinctive *either* because it is inherently distinctive *or* because it has achieved secondary meaning; (2) the trade dress is nonfunctional; and (3) the defendant's use of plaintiff's trade dress is likely to cause confusion.⁸²

Although a survey is not required to establish secondary meaning, its absence may be considered as part of the secondary meaning analysis. See *Eldon Indus., Inc. v. Rubbermaid, Inc.*, 735 F. Supp. 786, 817 (N.D. Ill. 1990); cf. *Herbko Int'l, Inc. v. Gemmy Indus.*, 916 F. Supp. 322, 329 (S.D.N.Y. 1996) (recognizing that plaintiff's failure to produce survey evidence weighs against a finding of secondary meaning but does not preclude it). In some cases, the lack of survey evidence appears almost to have been determinative of the issue of secondary meaning. See, e.g., *Spex, Inc. v. Joy of Spex, Inc.*, 847 F. Supp. 567, 577 (N.D. Ill. 1994) ("[P]laintiff's failure to produce consumer surveys is crippling (although not dispositive), especially when combined with the scarcity of direct consumer testimony on [the] issue [of secondary meaning]."); *Investacorp, Inc. v. Arabian Inv. Banking Corp.*, 722 F. Supp. 719, 723-24 (S.D. Fla. 1989) (stating that plaintiff's failure to provide survey evidence is significant evidence of no secondary meaning), *aff'd*, 931 F.2d 1519 (11th Cir. 1991); see also *Braun Inc. v. Dynamics Corp. of Am.*, 975 F.2d 815, 827 (Fed. Cir. 1992) (finding by jury of secondary meaning was speculative, because there was "no survey, quantitative evidence, or testimony suggesting secondary meaning"); *American Television & Communications Corp. v. American Communications & Television, Inc.*, 810 F.2d 1546, 1549 (11th Cir. 1987) (concluding that plaintiff's failure to submit survey evidence of secondary meaning supported finding that none existed).

82. See *Dorr-Oliver, Inc. v. Fluid-Quip, Inc.*, 94 F.3d 376, 380 (7th Cir. 1996) (design of industrial product); *L. & J.G. Stickley, Inc. v. Canal Dover Furniture Co.*, 79 F.3d 258, 262 (2d Cir. 1996) (design of line of reproduction furniture); *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996, 1007 (2d Cir. 1995) (design of sweaters) (regarded by court as "product features"); *Mana Prods. v. Columbia Cosmetics Mfg.*, 65 F.3d 1063, 1068-69 (2d Cir. 1995) (design of makeup compacts) (apparently regarded by court as packaging); *Fabrication Enters., Inc. v. Hygenic Corp.*, 64 F.3d 53, 57-58 (2d Cir. 1995) (color design of set of latex exercise bands); *Villeroy & Boch Keramische Werke K.G. v. THC Sys., Inc.*, 999 F.2d 619, 620 (2d Cir. 1993) (design of high quality china); *Paddington Corp. v. Attiki Importers & Distribs., Inc.*, 996 F.2d 577, 582-83 (2d Cir. 1993) (product packaging); *EFS Mktg. v. Russ Berrie & Co.*, 836 F. Supp. 128, 134 (S.D.N.Y. 1993) (design of toy dolls), *aff'd*, 37 U.S.P.Q.2d (BNA) 1646 (2d Cir. 1996). Although the *Knitwaves* court approvingly cited this twin track approach to trade dress distinctiveness, it may have effectively re-established the bar to inherent distinctiveness for product features that *Two Pesos* swept away for other forms of trade dress. See *infra* Part IV(D)(3).

To these three requirements, the Tenth Circuit has added a fourth for product configuration trade dress: the product configuration must not be a significant inventive component of an invention covered by an expired utility patent. See *Vornado Air Circulation Sys., Inc. v. Duracraft Corp.*, 58 F.3d 1498, 1500 (10th Cir. 1995) ("Where a product configuration is a significant inventive component of an invention covered by a utility patent, so that without it the invention cannot fairly be said to be the same invention, patent policy dictates that it enter into the public domain when the utility patents on the [products] expire. To ensure that result, it cannot receive trade dress protection under section 43(a)."), *cert. denied*, 116 S. Ct. 753 (1996). It is not clear quite what the Tenth Circuit means by "significant inventive component." See Recent Case, 109 HARV. L. REV. 1457, 1460 (1996) (arguing that the Tenth Circuit's test "lacks doctrinal coherence"); see also *Thomas & Betts Corp. v. Panduit Corp.*, 935 F. Supp. 1399, 1409 (N.D. Ill. 1996) ("[T]he subject of an expired utility patent which is disclosed as the 'best mode' in

IV. THE STANDARD FOR INHERENTLY DISTINCTIVE TRADE DRESS

Although the *Two Pesos* Court decided that non-verbal trade dress could be inherently distinctive, it did not directly address how inherent distinctiveness was to be determined. Two leading tests had been articulated by the lower federal courts before *Two Pesos*, and others are being developed in the wake of that decision. In order to assess the merit of the respective tests, it is helpful to re-emphasize what courts are trying to determine in considering inherent distinctiveness.

A. *Relevant Considerations: Likely Consumer Association, Not Competitive Impact*

The central question in determining inherent distinctiveness is whether "because of the nature of the designation and the context in which it is used, prospective purchasers are likely to perceive it as a designation [of source]."⁸³ Commentators and courts have suggested, however, that the distinctiveness inquiry attempts to gauge both the likely reaction of prospective purchasers and the potential impact on other sellers.⁸⁴ In the context of word marks, the appraisal of pur-

the patent cannot be the subject of trademark protection with respect to the invention disclosed to the public."); *Zip Dee, Inc. v. Dometic Corp.*, 931 F. Supp. 602, 611-12 (N.D. Ill. 1996) (recasting *Vornado* requirement in terms of functionality because the Tenth Circuit's test "goes into uncharted" territory). Earlier Supreme Court case law emphasized the relevance of prior utility patents to the scope of protection, *see, e.g., Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 120 (1938), but the Tenth Circuit appears to regard this consideration in absolute terms. *See Dinwoodie, supra* note 17, at 95-102.

83. RESTATEMENT, *supra* note 1, § 13; *see also Mana*, 65 F.3d at 1070 (discussing distinctiveness in terms of likely consumer response); *infra* note 186 (citing cases).

84. *See* RESTATEMENT, *supra* note 1, § 13 cmt. c. Paul Goldstein, for example, has succinctly articulated the double-barreled nature of the inquiry:

Trademark law's distinctiveness requirement serves two related purposes. One is to ensure that a mark identifies a single source for goods or services, thus securing consumer expectations respecting source. Second, by denying protection to descriptive terms, the requirement ensures that competitors will be free to use those terms in describing their own goods or services.

PAUL GOLDSTEIN, COPYRIGHT, PATENT, TRADEMARK AND RELATED STATE DOCTRINES 223 (Rev. 3d ed. 1993); *see also Duraco Prods. v. Joy Plastic Enters.*, 40 F.3d 1431, 1448 (3d Cir. 1994) (distinctiveness analysis of product configurations different from that applied to other trade dress because of possibility of substantially hindering competition, range of competitive alternatives, and likelihood that consumers will trust it as an indicium of source); *Estee Lauder, Inc. v. Gap, Inc.*, 932 F. Supp. 595, 608-11 (S.D.N.Y. 1996) (analyzing distinctiveness of mark by considering how consumers are likely to construe the mark and whether protection would impair the ability of competitors to describe their products); RESTATEMENT, *supra* note 1, § 14 cmt. b ("The classification of a designation as either suggestive or descriptive thus depends upon both the likelihood that prospective purchasers will perceive it as an indication of source and the potential effect on competitors of its appropriation as a trademark by a particular seller."); 1

chaser reaction involves assessing whether consumers are likely to attach source-identifying rather than lexicographic significance to the use of the mark.⁸⁵ The analysis of the impact on competitors centers on whether restrictions on use of the mark would “interfere with the ability of other sellers to convey information about competing goods.”⁸⁶ The archetypal analysis of the treatment of merely descriptive terms exemplifies these different considerations. A word that merely conveys the nature or characteristics of the product on which it appears is more likely to be viewed by consumers not as an identifier of source but as a mere description of the product.⁸⁷ Similarly, preventing competitors from using such a word to describe their

MCCARTHY, *supra* note 1, § 11.21[2] (“The imagination test [for suggestiveness] naturally leads into the competitors’ need test.”); *cf.* *Thompson Med. Co. v. Pfizer Inc.*, 753 F.2d 208, 216 (2d Cir. 1985) (“The rationales for denying protection to marks that do not connote a source of origin include: (1) the public’s inherent ‘right’ to call a product by its name; (2) exclusive appropriation of a generic/descriptive mark is ‘unfair’ to competitors; and (3) such an appropriation creates or entrenches a monopoly.” (citations omitted)); Pollack, *supra* note 65, at 263-64 (noting that tests of whether a mark is descriptive or suggestive include: looking at the role played by imagination, considering whether or not competitors need the term to indicate the nature of their goods, and focusing on the extent to which competitors already use the term).

85. See RESTATEMENT, *supra* note 1, § 13 cmt. c; *see also Thompson Med.*, 753 F.2d at 213 (“[T]he determination whether a mark is descriptive or suggestive cannot be made in a vacuum; it is necessary to surmise the mental processes of those in the marketplace at whom the mark is directed.”); *In re Colonial Stores Inc.*, 394 F.2d 549, 551 (C.C.P.A. 1968) (noting that whether a mark is suggestive or descriptive is based upon “what it would mean to the potential consumer when applied to applicant’s goods”); *Estee Lauder*, 932 F. Supp. at 609-11 (analyzing distinctiveness of mark by considering how consumer is likely to construe the mark).

86. RESTATEMENT, *supra* note 1, § 13 cmt. c; *accord In re DC Comics, Inc.*, 689 F.2d 1042, 1044 (C.C.P.A. 1982) (“Trademark law has traditionally imposed restrictions on the right to exclude others from using certain ‘descriptive’ symbols to ensure that the opportunity for all to associate such symbols with their common referents remains unencumbered.”); *Thompson Med.*, 753 F.2d at 216 (“In protecting only those descriptive terms that have acquired secondary meaning, we recognize that potential market entrants should not be foreclosed from using descriptive terms to label their products.”); *see also Estee Lauder*, 932 F. Supp. at 608 (noting that classification of a mark as suggestive or descriptive is helped by “consideration of whether protection should be restricted to avoid precluding competitors from describing their products in an appropriate and necessary way”); 1 MCCARTHY, *supra* note 1, § 11.21[2] (explaining the difference between suggestive and descriptive marks as whether “the suggestion made by the mark [is] so remote and subtle that it is really not likely to be needed by competitive sellers to describe their goods”); Adam J. Cermak, *Inherent Distinctiveness in Product Configuration Trade Dress*, 3 U. BALT. INTELL. PROP. L.J. 79, 88 (1994) (“The policy of not protecting both generic and merely descriptive marks is thus cast in terms of adverse impact on competing market players . . .”).

87. *See Beckwith’s Estate v. Commissioner of Patents*, 252 U.S. 538, 543 (1920) (“The function of a trade-mark is to point distinctively, either by its own meaning or by association, to the origin or ownership of the wares to which it is applied, and words merely descriptive of qualities, ingredients or characteristics, when used alone, do not do this.”).

products impedes their ability to communicate relevant and accurate information about those products.⁸⁸ Thus, merely descriptive terms are not regarded as inherently distinctive, as assessed by reference either to likely consumer association or to the potential impact on competitors, and will not be protected absent proof that consumers in fact have come to associate that term with a specific source.

Despite the apparent neatness of these coupled considerations of likely association and competitive consequences, and notwithstanding the relevance of competitive impact to the scope of trademark protection,⁸⁹ it is difficult to discern the relevance of the effect on other

88. As the Court of Appeals for the Seventh Circuit explained:

[Plaintiff] cannot appropriate the English language, and by doing so render a competitor inarticulate. . . .

....

... [I]t is no purpose of trademark protection to allow a firm to prevent its competitors from informing consumers about the attributes of the competitors' brands. That is why trademarks that are fanciful . . . or arbitrary . . . or suggestive . . . are favored, why generic words . . . may not be trademarked at all, and why descriptive words . . . may be trademarked only if they have acquired secondary meaning

Blau Plumbing, Inc. v. S.O.S. Fix-It, Inc., 781 F.2d 604, 609-10 (7th Cir. 1986); *see also* *Thomas & Betts Corp. v. Panduit Corp.*, 65 F.3d 654, 657 (7th Cir. 1995) ("[In the case of descriptive marks,] a court must determine whether the mark really signifies a particular source or the product itself [T]he dispute concerns limitations on the language competitors can use to communicate with consumers about their products and the effect such limitations would have on competition."), *cert. denied*, 116 S. Ct. 1044 (1996); *In re Abcor Dev. Corp.*, 588 F.2d 811, 813 (C.C.P.A. 1978) (stating that the reasons for not protecting descriptive marks are "(1) to prevent the owner of a mark from inhibiting competition in the sale of particular goods; and (2) to maintain freedom of the public to use the language involved, thus avoiding the possibility of harassing infringement suits by the registrant against others who use the mark when advertising or describing their own products").

89. The functionality analysis is centered on the effect on competition of protecting the trade dress at issue. *See supra* note 79 and accompanying text. Because trademark law (unlike copyright or patent law) offers potentially perpetual protection to the design of functional products without regard to their originality or creativity, many commentators fear that trademark protection for designs might be anti-competitive. *See, e.g.*, Reichman, *supra* note 8, at 111 (arguing that broad trade dress protection could result in patent-like monopoly protection, "without any requirements of novelty or nonobviousness, that could last as long as the proprietor cared to defend it"); Anthony E. Dowell, Note, *Trade Dress Protection of Product Designs: Stifling the Progress of Science and the Useful Arts for an Unlimited Time*, 70 NOTRE DAME L. REV. 137, 137 (1994) ("Federal courts have thus created a powerful form of intellectual property that requires little or no standards for protection, affords monopoly rights, lasts forever, and eliminates rightful competition."); *see also* Ralph S. Brown, *Copyright-Like Protection For Designs*, 19 U. BALT. L. REV. 308, 318 (1989) (noting need for judicial sensitivity to conferring perpetual patents in form of trade dress protection); David Klein, *The Ever-Expanding Section 43(a): Will the Bubble Burst?*, 2 U. BALT. INTELL. PROP. L.J. 65, 88 (1993) ("It is anti-competitive to provide section 43(a) protection to the trade dress of a product's feature, where that feature is sought after by consumers, as opposed to, or in addition to, that feature being a means for indicating source."); Reichman, *supra* note 57, at 284-85

sellers to the question of distinctiveness.⁹⁰ Consider the same two stated concerns at the stage where the descriptive term achieves secondary meaning and thus is protectable as a trademark. The demonstration of secondary meaning indicates that consumers have come to associate the term with a specific source and have made that association notwithstanding any descriptive meaning they might first have attributed to the term. However, the effect on competitors of preventing use of the term is no different than before.⁹¹ Distinctiveness is a measure of consumer association, and analysis of competitive impact adds little to our understanding of whether word

(characterizing protection for product designs under section 43(a) as “far more of the wrong kind of protection than is good for a competitive economy”). Indeed, the perceived inability of the courts to circumscribe this extension of trademark protection provoked one scholar, even before *Two Pesos*, to label this developing body of trademark law as “the most protectionist design law of them all.” See Reichman, *supra* note 8, at 98. I address these additional concerns in a forthcoming article entitled *In Defense of Trade Dress Protection For Product Design*. There, I argue that any potentially anti-competitive ramifications can be averted by paying heed to the essential nature and limits of trademark protection. See Dinwoodie, *supra* note 17, at 2 (arguing that the limits of trademark protection—distinctiveness, nonfunctionality and likelihood of confusion—prevent conflict with the goal of encouraging competition). The strength and acceptability of trademark protection for product designs lie, somewhat ironically, in the limits of that protection. In particular, in *In Defense of Trade Dress Protection For Product Design*, I discuss the exclusion from protection of so-called “functional” designs, an exclusion designed to forestall the potentially anti-competitive consequences of broad trademark protection for product designs; and, I appraise the application of the trademark infringement test to product design marks. See *id.* Trademark and unfair competition law protects a mark owner only against the use of its design in such a way as to cause confusion as to the source or certain other attributes of goods or services. It does not prohibit the mere copying and marketing by another of the same design under a clearly differentiated trademark.

90. Professor Litman has argued that while functionality—the issue of whether protecting a particular feature would hinder competition—may well be an important consideration in determining relief, it has no bearing on whether consumers are likely to be confused. See Litman, *supra* note 20, at 85. Similarly, it sheds no light on whether a design serves to identify its source.

91. While the meaning of the term for consumers, upon achieving secondary meaning, is to identify a specific product, that does not alter the fact that for competitors there is, upon protection of the previously descriptive mark, a restriction on the use of terms that convey accurate information regarding its competing product. This problem is mitigated, but not fully resolved, by the descriptive fair use defense. See 15 U.S.C. § 1115(b)(4) (1994) (recognizing defense, even in an action for infringement of incontestable mark, on basis of good faith non-trademark use to describe product); *cf.* Sunmark, Inc. v. Ocean Spray Cranberries, Inc., 64 F.3d 1055, 1059 (7th Cir. 1995) (concluding that truthful good faith descriptive use by defendant cannot be wrong, even if it causes confusion, at least with respect to unrelated products). The Court of Appeals for the Second Circuit has in one recent case afforded a particularly broad scope to the fair use defense in the product design context. See *Car-Freshner Corp. v. S.C. Johnson & Son*, 70 F.3d 267, 270 (2d Cir. 1995) (holding that defendant's sale of a pine-tree shaped, pine-scented air freshener under its own trademark was a good faith descriptive use that did not infringe plaintiff's trade dress in pine-tree shaped air fresheners).

marks identify and distinguish a particular product.⁹² Competitive concerns may underlie trademark protection, but they do not provide appropriate guidance on the concrete question of distinctiveness.

This point is further highlighted by the *Restatement's* discussion of these considerations in assessing the inherent distinctiveness of symbols and designs. The *Restatement* carefully explains the factors that contribute to whether a prospective purchaser is likely to consider a design a source-identifying feature, such as whether the shape is "commonplace" or "striking [or] unusual."⁹³ Its analysis of the impact on competitors is, however, less illuminating and wholly conclusory: "Recognition of exclusive rights in symbols or designs that are inherently distinctive is also unlikely to inhibit the legitimate activities of competitors."⁹⁴ How that is determined—or what are "legitimate activities"—is not explained in the *Restatement*, and indeed cannot be explained as a matter of distinctiveness.

The most common judicial implementation of the perceived need to examine the competitive impact of protecting shapes⁹⁵ involves an assessment of the range of viable alternative shapes for

92. Despite this, courts routinely connect the needs of a competitor with the question of distinctiveness. *See, e.g.,* *Estee Lauder, Inc. v. Gap, Inc.*, 932 F. Supp. 595, 608 (S.D.N.Y. 1996) (noting that the classification of a mark as suggestive or descriptive is helped by "consideration of whether protection should be restricted to avoid precluding competitors from describing their products in an appropriate and necessary way"); *Vornado Air Circulation Sys., Inc. v. Duracraft Corp.*, No. 92-1543-WEB, Memorandum and Order at 29 (D. Kan. Mar. 4, 1994) ("Because a descriptive mark is one which a competitor would likely need to use in describing his product, the term does not indicate that a product comes from a particular source."), *rev'd on other grounds*, 58 F.3d 1498 (10th Cir. 1995), *cert. denied*, 116 S. Ct. 753 (1996). The proper connection is not between competitive need and source-identification, but rather between the intrinsic nature of a descriptive term and the likelihood that a consumer would regard such a term as indicating a source.

93. RESTATEMENT, *supra* note 1, § 13 cmt. d.

94. *Id.*

95. Other courts have determined (and denied) distinctiveness by more direct appeal to the competitive impact of protecting an idea. *See, e.g.,* *Jeffrey Milstein, Inc. v. Greger, Lawlor, Roth, Inc.*, 58 F.3d 27, 32-34 (2d Cir. 1995) ("In evaluating claims to distinctive trade dresses, two additional considerations should be borne in mind . . . Second, just as copyright law does not protect ideas but only their concrete expression, neither does trade dress law protect an idea, a concept, or a generalized type of appearance.") (denying trade dress claim because plaintiff sought protection for the generalized idea of using die-cut photographs on greetings cards); *Fashion Victim, Ltd. v. Sunrise Turquoise, Inc.*, 785 F. Supp. 1302, 1308 (N.D. Ill. 1992) (rejecting claim of trade dress in tee-shirt design because to find design inherently distinctive would grant monopoly in idea of depicting skeletons in sexual positions on tee-shirts); *Jungle Rags, Inc. v. Rainbow Graphics, Inc.*, 29 U.S.P.Q.2d (BNA) 1704, 1708 (M.D. Fla. 1993) (flap in shirt in shape of animal's mouth not inherently distinctive because to make that finding would grant monopoly on the fashion idea).

such products or packaging.⁹⁶ Cast in these terms, a similar workable analysis might be applied to words and shapes. Such questions are, however, more appropriately left to the functionality inquiry, not only because of the lack of conceptual connection to distinctiveness, but also in order more fully to accommodate competing policies in this area. By considering the issue of competitive impact as part of

96. See, e.g., *Duraco Prods. v. Joy Plastic Enters.*, 40 F.3d 1431, 1448 (3d Cir. 1994) (resting stricter test of inherent distinctiveness for product configurations on basis that "[a] product configuration . . . commonly has finite competitive variations that, on the whole, are equally acceptable to consumers"); *id.* at 1442 (identifying rationales supporting the trademark taxonomy as including the competitive effect of the number of alternatives left from a finite number of possibilities); *Paddington Corp. v. Attiki Importers & Distribs., Inc.*, 996 F.2d 577, 583 (2d Cir. 1993) ("Since the choices that a producer has for packaging its products are . . . almost unlimited, typically a trade dress will be arbitrary or fanciful and thus inherently distinctive . . ."); see also *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 786-87 (1992) (Thomas, J., concurring) (explaining common-law development toward acceptance of inherently distinctive shapes by reference to recognition that number of alternatives unlimited); *Chevron Chem. Co. v. Voluntary Purchasing Groups, Inc.*, 659 F.2d 695, 702-03 (Former 5th Cir. 1981) (explaining acceptance of inherently distinctive packaging by reference to available alternatives); RESTATEMENT, *supra* note 1, § 13 cmts. b-c (noting that protection of inherently distinctive designations or fanciful terms does not diminish the ability of sellers of similar products to communicate information about their goods).

Commentators have also assessed distinctiveness of designs in terms of alternatives. See, e.g., *Dratler, supra* note 8, at 950-51 (proposing "alternatives test" to determine distinctiveness of design); C. Andrew Wattleworth, Comment, *Inherently Distinctive Product Configurations Under § 43(a) of the Lanham Act: Where Do We Stand in the Aftermath of Two Pesos*, 26 CUMB. L. REV. 1071, 1096 (1995-96) (endorsing variant of Dratler's proposal). Professor Dratler suggests that an alternatives-based distinctiveness doctrine could "separate trademarks from the proper subject matter of design patents" and "help preserve freedom of competition while alleviating much . . . doctrinal confusion." Dratler, *supra* note 8, at 950-51. The distinctiveness doctrine is not, however, intended to serve those roles. There is no reason why the subject matter of a design patent might not also operate as a trademark. See *In re Mogen David Wine Corp.*, 328 F.2d 925, 930 (C.C.P.A. 1964); *Krueger Int'l, Inc. v. Nightingale, Inc.*, 915 F. Supp. 595, 604 (S.D.N.Y. 1996) ("A design patent is analytically distinct from a protectable trade dress, and industrial products may qualify for both kinds of protection without violating the policy goals of either patent or trade dress law."); cf. Regulations of the U.S. Copyright Office, 37 C.F.R. § 202.10(a) (1995) (providing that availability of design or utility patent protection does not affect registrability of copyright in pictorial, graphic or sculptural work). Furthermore, freedom of competition can appropriately be protected by the later application of the functionality doctrine without denying that such a feature might also operate as an identifier of source. See *Dinwoodie, supra* note 17, at 31-32. That denial fails to acknowledge the conflicting competitive concerns that stem from the likelihood of confusion. As Professor Litman has observed, "[t]he promotion of competition involves more than the prevention of monopoly over any item of value." Litman, *supra* note 20, at 97; see also *Fabrication Enters., Inc. v. Hygenic Corp.*, 64 F.3d 53, 59 (2d Cir. 1995) ("[T]he competitive benefits of protecting the source-identifying aspects of the feature under the Lanham Act may outweigh the competitive costs of precluding competitors from using the feature."). In particular, competitive goals are furthered by avoiding confusion as to the source of products.

the distinctiveness inquiry, a distinctive shape that is one of only a limited number of alternatives may receive no protection whatsoever, even though it clearly satisfies the threshold for trademark protection—distinctiveness.⁹⁷ If, instead, analysis of competitive effect were to be conducted after protectability had been established, some measure of remedial assistance could be provided to the mark owner, even if only in the form of confusion-dispelling labeling.⁹⁸

This alternative approach balances and attempts to accommodate concerns surrounding both anti-competitive situations: the imposition of unreasonable constraints on creation, and potential purchaser confusion that could arise with a second-comer's unregulated use of a shape with which consumers have come to associate a specific source.⁹⁹ Observations made by the Supreme Court in its two

97. A threshold based solely upon competitive impact also presents the possibility of over-protection for undistinctive shapes to which there remain alternatives. Even a feature that is not essential or the only option (and thus nonfunctional) can clearly still fail to meet the standard for inherent distinctiveness. See *Pebble Beach Co. v. Tour 18 I, Ltd.*, 936 F. Supp. 1299, 1344 n.41 (S.D. Tex. 1996) (“[T]he non-functionality of trade dress does not dictate a corresponding finding of inherent distinctiveness”); *Mana Prods. v. Columbia Cosmetics Mfg.*, 858 F. Supp. 361, 367 (E.D.N.Y. 1994) (noting that case colors were not arbitrary just because they did *not need* to be that color and because there were other options), *aff’d*, 65 F.3d 1063 (2d Cir. 1995).

98. At common law, courts often required the imitator of a functional design to take reasonable steps (such as labeling) to avoid confusion. See, e.g., *Shredded Wheat Co. v. Humphrey Cornell Co.*, 250 F. 960, 965 (2d Cir. 1918); see also *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 120 (1938) (holding that defendant was free to use pillow-shaped form “subject only to the obligation to identify its product lest it be mistaken for that of plaintiff”). This approach has been adopted by several courts in causes of action under section 43(a), see, e.g., *Keene Corp. v. Paraflex Indus., Inc.*, 653 F.2d 822, 824 (3d Cir. 1981); *Vuitton et Fils, S.A. v. Young Enters.*, 644 F.2d 769, 774 (9th Cir. 1981); *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 203 (2d Cir. 1979), and it is also endorsed by the recently-published *Restatement (Third) of Unfair Competition*. See RESTATEMENT, *supra* note 1, § 16 cmt. d (“Although the possibility or even certainty of . . . confusion will not deprive competitors of their right to copy functional designs, the general proscription against misrepresentations of source may require subsequent users of functional but distinctive designs to take reasonable precautions to minimize the risk of confusion.”); see also *Duraco*, 40 F.3d at 1445 (noting that the doctrine remains intact); cf. *Litman*, *supra* note 20, at 87 n.78 (discussing operation of nonfunctionality as element of plaintiff’s claim, as opposed to affirmative defense for defendant, and noting that such a rule prevents a producer of functional features from obtaining any relief including precautionary labeling); *id.* at 78 (arguing that the functional nature of features be considered not in determining liability but in setting the type and scope of relief). Although the Supreme Court in *Qualitex* described functionality as a complete defense to an action under section 43(a), the Court did not purport to address the remedial measures that might still be available to a court to avoid the concomitant false representation made by the defendant. See *Qualitex Co. v. Jacobsen Prods. Co.*, 115 S. Ct. 1300, 1304 (1995).

99. “[B]oth product distinguishability and the doctrine of functionality are procompetitive policies” *Litman*, *supra* note 20, at 96-97. As the Court of Appeals for the

most recent trademark decisions, particularly in *Qualitex Co. v. Jacobsen Products Co.*, support the suggestion that the availability of competitive alternatives (or a lack thereof) should not impact any determination of distinctiveness (inherent or otherwise),¹⁰⁰ but rather is a matter for the functionality doctrine.¹⁰¹

Second Circuit noted recently in the context of conducting a functionality analysis:

[A] court conducting a functionality inquiry must take account of two risks which, if badly managed, might result in either too great or too little protection of competition. On the one hand, to the extent that the product feature or design at issue enhances the distinctiveness of the product, there is a risk that failure to protect the feature or design will cause confusion and allow competitors to benefit unfairly from the original manufacturer's investment in its product's appearance. If such confusion occurs, meaningful competition is frustrated because "[w]ithout some . . . method of product identification, informed consumer choice, and hence meaningful competition in quality, could not exist." On the other hand, because a product feature or design that enhances the distinctiveness of the product also might contribute to the usefulness of the product, there is a risk that protecting the feature or design would give the manufacturer an unfair competitive advantage because competitors will be prohibited from incorporating that feature into their designs.

Fabrication Enters., 64 F.3d at 58 (citations omitted).

100. Actual third party use of similar trade dress features may be of relevance to distinctiveness insofar as it may blur consumer association of the product trade dress with a specific source. See *Mana Prods. v. Columbia Cosmetics Mfg.*, 65 F.3d 1063, 1070 (2d Cir. 1995) ("When it is readily allowed that other cosmetic distributors and retailers have used the identical packaging or containers, it defies logic to suggest that the packaging was inherently distinctive."); see also *infra* notes 118-21 and accompanying text (discussing relevant distinctiveness considerations); cf. *Fabrication Enters.*, 64 F.3d at 61 (noting that objection to use by third parties relevant in determining distinctiveness). For a discussion of the relevance of a lack of alternatives to this issue, see *infra* note 389.

101. See *Qualitex*, 115 S. Ct. at 1306 (1995) (accepting that protection can be afforded colors per se without depleting alternatives because the functionality doctrine is available to prevent such anticompetitive consequences); *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 774-75 (1992) (rejecting argument that allowing inherently distinctive trade dress would be anti-competitive because the functionality doctrine "serves to assure that competition will not be stifled by the exhaustion of a limited number of trade dresses"). But cf. *Two Pesos*, 505 U.S. at 786 (Thomas, J., concurring) (suggesting that "[t]rade dress, which consists not of words or symbols, but of a product's packaging (or 'image,' more broadly), seems at common law to have been thought incapable ever of being inherently distinctive, perhaps on the theory that the number of ways to package a product is finite." (emphasis added)). The capacity of the functionality doctrine to perform this role, and thus to allow distinctiveness to be considered independently of the range of available alternatives, requires that the functionality defense always be available to a defendant. A recent appellate decision—which denies the functionality defense to a defendant alleged to have infringed a registered mark that has become incontestable—endangers this capability. See *Shakespeare Co. v. Silstar Corp. of Am.*, 9 F.3d 1091, 1097-99 (4th Cir. 1993); see also *Northwestern Corp. v. Gabriel Mfg. Co.*, No. 95 Civ. 2004, 1996 WL 251433, at *4 (N.D. Ill. May 8, 1996) (following *Shakespeare*); *Kransco Mfg. Inc. v. Hayes Specialties Corp.*, 33 U.S.P.Q.2d (BNA) 1999, 2001 (E.D. Mich. 1994) (same), *aff'd in part, rev'd in part*, 77 F.3d 503 (Fed. Cir. 1996); Dinwoodie, *supra* note 17, at 37-39 (arguing that functionality defense should always be available).

B. Pre-Two Pesos Tests

1. *Chevron*: Product/Mark

Prior to *Two Pesos*, courts permitting trade dress protection for shapes on the basis of inherently distinctive features had formulated two tests to assess inherent distinctiveness. The first test was articulated by the Court of Appeals for the Fifth Circuit in *Chevron Chemical Co. v. Voluntary Purchasing Groups*.¹⁰² In *Chevron*, the plaintiff sought to enjoin a competitor from copying the packaging in which the plaintiff sold garden products. The defendant sold its competing products in bottles of similar shape and size with a similar label design, but replaced the plaintiff's registered verbal trademark with the name of its own product. The plaintiff claimed trade dress rights in its packaging and alleged that defendant's use of similar packaging gave rise to a likelihood of confusion as to the source of the respective products. The district court dismissed the plaintiff's claim because no secondary meaning had been proved to attach to the packaging trade dress. The Court of Appeals for the Fifth Circuit rejected the suggestion that secondary meaning was a prerequisite to every trade dress infringement suit. Instead, the court decided that the same principles should apply to trade dress as applied to trademarks, and thus secondary meaning was required only if a dress was not inherently distinctive.

The *Chevron* court purported to apply the classical *Abercrombie* trademark analysis to trade dress features, although it did provide some limited elaboration. It identified inherently distinctive shapes as features that are "arbitrary" and, supplementarily, that "serve no function either to describe the product or assist in its effective packaging."¹⁰³ The Fifth Circuit appears to have been influenced in accepting this test by the belief that just as "the number of nonfunctional words and symbols available for use by later comers in the marketing of their products is unlimited," so too "the possible varieties of advertising display and packaging are virtually endless."¹⁰⁴ By

102. 659 F.2d 695, 702 (Former 5th Cir. 1981); see also *Lisa Frank, Inc. v. Impact Int'l, Inc.*, 799 F. Supp. 980, 988 (D. Ariz. 1992) (applying both *Chevron* and *Seabrook*); *Turtle Wax, Inc. v. First Brands Corp.*, 781 F. Supp. 1314, 1318 n.6 (N.D. Ill. 1991) (recognizing that Seventh Circuit has not decided whether to apply *Seabrook* or *Abercrombie*).

103. *Chevron*, 659 F.2d at 702.

104. *Id.* at 702-03. Reflecting this reference to alternatives, courts purporting to apply the *Chevron* test often look at whether other products of the same type can be developed without using the shape at issue. See, e.g., *Paddington Corp. v. Attiki Importers & Distributors, Inc.*, 996 F.2d 577, 584 (2d Cir. 1993) (holding that bottle's trade dress inherently

equating packaging and words in terms of possible alternatives, the court felt able to adopt the *Abercrombie* test.

However, the *Abercrombie* test, adopted by the *Chevron* court, is based on a linguistic reference between word and mark and is thus ill-suited to determine the inherent distinctiveness of shapes generally and of product design in particular. In assessing the conceptual strength of word marks, and the degree of correlation between word and product upon which that assessment is based, the limits of lexicon and established usage provide invaluable guidance.¹⁰⁵ Courts have, however, acknowledged the difficulty of locating verbal marks on the distinctiveness spectrum.¹⁰⁶ Even the relatively circumscribed meanings that flow from the place of words as the primary forms of societal communication (not to mention the presence of objectivizing tools such as dictionaries),¹⁰⁷ though well understood by judges,¹⁰⁸

distinctive where it was selected from an "almost limitless supply of patterns, colors and designs"); *Mana Prods. v. Columbia Cosmetics Mfg.*, 858 F. Supp. 361, 367 (E.D.N.Y. 1994) (makeup compacts not inherently distinctive under *Chevron* when "[t]he size and shape of the products at issue are characteristic of the entire genre of hand-held makeup compacts . . . [and] it is difficult to imagine an 'infinite variety' of meaningful alternatives that would not hamper the products' usefulness as portable makeup cases that fit in one hand"), *aff'd*, 65 F.3d 1063 (2d Cir. 1995). The court's mention of alternative shapes sowed the seed for unhelpful fusion of the distinctiveness and functionality questions by later courts applying *Chevron*. See *infra* notes 387-92; *supra* note 92 and accompanying text.

105. "To make [the] test meaningful, it is necessary, therefore, to consider the established usages and associations which inhere in the words [sought to be protected as marks]." *In re Colonial Stores Inc.*, 394 F.2d 549, 551 (C.C.P.A. 1968); cf. RESTATEMENT, *supra* note 1, § 13 cmt. b ("A word with no existing meaning coined to identify the products of a particular manufacturer, for example, is inherently distinctive because its lack of lexicographic significance makes it likely that the designation will be perceived as a symbol of identification.").

106. See, e.g., *Banff, Ltd. v. Federated Dept. Stores*, 841 F.2d 486, 489 (2d Cir. 1988) ("[W]e must acknowledge that placing a mark in one of these four categories is far from an exact science, and that the difference[] between the classes, which is not always readily apparent, makes placing a mark in its proper context and attaching to it one of the four labels a tricky business at best.").

107. See *Cadbury Beverages, Inc. v. Cott Corp.*, 73 F.3d 474, 479 (2d Cir. 1996) (describing a fanciful mark as "a term without any dictionary meaning"); *Spraying Sys. Co. v. Delavan, Inc.*, 975 F.2d 387, 392-93 (7th Cir. 1992) (looking at dictionary definition in determining that mark descriptive); *Daddy's Junky Music Stores v. Big Daddy's Family Music Ctr.*, 913 F. Supp. 1065, 1073 (S.D. Ohio 1996) (referring to dictionary to determine word's typical connotation, and thus to ascertain the uniqueness of plaintiff's particular use of word); see also *Murphy Door Bed Co. v. Interior Sleep Sys.*, 874 F.2d 95, 101 (2d Cir. 1989) (remarking that dictionary references may be evidence of genericness); *GILSON*, *supra* note 46, § 7.02[7][d], at 7-72 ("[W]ith trade dress there are no dictionaries to consult, and often little more than the 'eyeball test' to apply."). While courts use dictionaries to assist in determining whether a verbal mark is *inherently* distinctive, similar reference in assessing secondary meaning may be positively unhelpful. At that stage of the analysis, the question for a court is whether the meaning denoted in the dictionary has

cannot conclusively determine the conceptual classification of verbal marks.¹⁰⁹ Nevertheless, they do steer and confine the distinctiveness inquiry, rendering analysis more predictable.

With shapes or the composites of features encountered in trade dress cases, less guidance is readily available.¹¹⁰ Shapes are subject to

precluded the purchasing public from reaching an additional understanding of the term as a source-identifier. See 1 MCCARTHY, *supra* note 1, §11.06[2] ("Dictionary definitions are relevant evidence of the ordinary significance of words."); cf. GILSON, *supra* note 46, § 2.02[2], at 2-35 (noting, in discussing determinations of genericness, that dictionaries "may not reflect word meaning among those persons who purchase the particular products involved").

108. As a result of judicial awareness of the meaning of language, opinions analyzing the conceptual strength of word marks often appear to be entirely intuitive. While the conceptual classification of a mark is necessarily somewhat speculative, a court's reliance on its own language skills is merely an unsurprising (if not necessarily appropriate) shortcut, by-passing dictionaries, to the predictive consideration of established meanings.

109. See *Walt-West Enters. v. Gannett Co.*, 695 F.2d 1050, 1057 (7th Cir. 1982) ("The labels themselves are merely springboards for analysis, not a substitute for it. The point is a basic one, but bears repeating, for it is all too often forgotten when the law is reduced to a few conclusory classifications: such abstract categories are analytical touchstones for a much more sophisticated inquiry.").

110. Cf. SUSANNE K. LANGER, *PHILOSOPHY IN A NEW KEY: A STUDY IN THE SYMBOLISM OF REASON, RITE, AND ART* 93-96 (2d ed. 1951) (arguing that visual forms "are just as capable of *articulation*, i.e. of complex combination, as words," but visual forms have no vocabulary, no "defining dictionary," and no "translating dictionary"). Langer argues that because visual forms are not discursive their complexity

is not limited, as the complexity of discourse is limited, by what the mind can retain from the beginning of an apperceptive act to the end of it An idea that contains too many minute yet closely related parts, too many relations within relations, cannot be 'projected' into discursive form: it is too subtle for speech.

Id. at 93. Thus, although Langer recognizes that discursive forms (i.e., language) differ from presentational forms (e.g., visual symbols), she suggests that the meaning conveyed by a visual form is in fact more precise and nuanced than that communicated by language. See *id.* at 95 ("[T]o the intelligent eye, an incredible wealth and detail of information is conveyed by the portrait, where we do not have to stop to construe verbal meanings. That is why we use a photograph rather than a description on a passport or in the Rogues' Gallery."). Langer also argues, however, consistent with the thesis of this Article, that non-discursive forms (such as shapes) have no independent meaning devoid of the context in which they are combined and presented. See *id.* at 94-97; *id.* at 97 ("The meanings given through language are successively understood, and gathered into a whole by the process called discourse; the meanings of all other symbolic elements that compose a larger, articulate symbol are understood only through . . . their relations within the total structure."). As discussed below, alternative sources of information do exist to guide our assessment of the distinctiveness of product designs. See *infra* Part IV(E)(2). Proceeding from that premise, one writer has argued that the *Abercrombie* taxonomy should be applied to product designs because "[s]ources such as encyclopedias, design manuals, and surveys can assist in determining whether a particular design is inherently distinctive." David W. Opperbeck, *Form and Function: Protecting Trade Dress Rights in Product Configurations*, 20 SETON HALL LEGIS. J. 1, 38 (1996). The availability of alternative evidence to direct our analysis of the distinctiveness of product design calls, however, for the formulation of an analytical model that easily taps those sources of information. It does not warrant straining to measure likely public association by reference to a set of

fewer objective constraints on comprehension or meaning; the processing of visual signals is far more ambiguous than the processing of signals with immediate linguistic connotation. Shapes register visually, and to apply a test formulated for gradations of linguistic meaning effects an unhelpful sensory equation.¹¹¹ Thus, in practice, the use of the classical distinctiveness categories becomes somewhat Delphic for shapes.¹¹²

categories (i) that are designed to test likely public perception of word marks, and (ii) that are themselves merely vehicles by which to evaluate that ultimate predictive question. See *supra* note 109.

111. Courts applying tests of distinctiveness in the context of shapes have occasionally attempted to express their conclusion in verbal terms. See, e.g., *Windmill Corp. v. Kelly Foods Corp.*, 76 F.3d 380 (6th Cir. 1996) (Table opinion, decision published at 1996 WL 33251, at *4) (to satisfy the secondary meaning test "the article must proclaim its identification with its source"); *Ferrari S.P.A. Esercizio v. Roberts*, 944 F.2d 1235, 1246 (6th Cir. 1991) (finding secondary meaning in exterior design of Ferrari cars and noting that "[t]he evidence is that Ferraris need no labeling; the shape of the vehicles 'says Ferrari'"); *Chevron Chem. Co. v. Voluntary Purchasing Groups, Inc.*, 659 F.2d 695, 699 (Former 5th Cir. 1981) (reporting the district court's dismissal of unfair competition claim because there was no evidence that "trade dress says 'Ortho'" to consumers); *Mana Prods. v. Columbia Cosmetics Mfg.*, 858 F. Supp. 361, 366-67 (E.D.N.Y. 1994) ("The makeup compacts at issue in the present case, however, draw upon a small, rudimentary vocabulary of forms which, even in combination, do not speak audibly of the products' origin."), *aff'd*, 65 F.3d 1063 (2d Cir. 1995). This modification of the communicative medium might reflect not only a desire to relate the decision to the classical trademark terminology, but also a broader inclination regarding the use of metaphors in American law. Cf. Bernard J. Hibbitts, *Making Sense of Metaphors: Visuality, Aurality, and the Reconfiguration of American Legal Discourse*, 16 CARDOZO L. REV. 229, 232 (1994) (noting a "jurisprudential turn from metaphoric visuality towards metaphoric aurality"). Use of the metaphor is not, however, restricted to courts. See Gary van Deursen, *The Globalization of Design*, APPLIANCE MANUFACTURER, March 1995, at 10 ("The image your product projects depends on the language that speaks to the consumer. Rely on your designers to create tangible and intangible product language capable of speaking to global consumers."). Other courts have acknowledged the sensory differences involved in analyzing verbal trademarks and non-verbal trade dress. See, e.g., *Fun-Damental Too, Ltd. v. Gemmy Indus.*, No. 96 Civ. 1103, 1996 WL 125641, at *1 n.1 (S.D.N.Y. Mar. 21, 1996) ("In a trade dress case, seeing does not necessarily mean believing, but it sometimes helps. Therefore, attached to this opinion are copies of photographs depicting the trade dress of the competing products.").

112. *Krueger Int'l, Inc. v. Nightingale Inc.*, 915 F. Supp. 595, 601 (S.D.N.Y. 1996) ("[T]he *Abercrombie* classifications do not translate easily to the trade dress context . . . Does the shape of a chair seat 'suggest' a chair seat? Does it 'describe' a chair seat? Or is it just a chair seat? No matter how beautifully designed, an industrial product is what it is."); see also *Mulberry Thai Silks, Inc. v. K & K Neckwear, Inc.*, 897 F. Supp. 789, 793 (S.D.N.Y. 1995) ("Nor does pinning the label 'arbitrary' or 'fanciful' on the design necessarily assist in focusing the analysis on the concern of the Lanham Act . . ."); Pollack, *supra* note 65, at 264 n.27 ("These tests, and these categories of marks, were created in an age when word marks predominated. Acceptance of packages and the configuration of the goods themselves as marks strains the system."); cf. Dratler, *supra* note 8, at 938 (suggesting that because distinctiveness doctrine was developed for use with verbal marks it requires some reformulation for application to industrial designs). In its most recent non-verbal trademark case, *Qualitex Co. v. Jacobsen Products Co.*, 115 S. Ct. 1300, 1303

To say, for example, that the shape of an article or container is "suggestive" of the source of a particular product just by examining it comes very close to being nothing more than what Professor Ralph Brown has called an exercise in "intuitive judging," a gauge perhaps of the depth of judicial spirit or imagination, but hardly a serviceable formulation for directing our assessment of the distinctiveness of shapes.¹¹³ To the extent that any less intuitive analysis is being conducted, it is misdescribed by explanation in terms of the *Abercrombie* spectrum.

2. *Seabrook*: Product/Similar Products

Whereas the *Chevron* court looked to the distinctiveness of the trade dress by conceptual reference only to the product itself, in

(1995), the Supreme Court did not try to place the particular color on the *Abercrombie* spectrum, but instead analogized to that spectrum. The Court compared color to descriptive terms, but did not explicitly identify the color as a descriptive mark. The need to depart from strict application of the *Abercrombie* analysis will recur as the subject-matter of trademarks continues to expand. For example, "[i]n the [computer graphic user interface] context, how can one say whether a particular set of menus, or a pattern on screens, or computer-generated noises at particular times are suggestive of the software itself, describe the software, or are completely arbitrary or fanciful?" Matthew E. Watson, *Trade Dress Theory and the Software Graphic User Interface: Sorting Through the Gooney Mess*, 34 JURIMETRICS J. 251, 284 (1994).

While it is easy to see how a word or phrase, or perhaps even a picture, can be descriptive, it is not clear what it means for the design of a product or a software user interface to be descriptive . . . [T]he traditional definitions . . . only make sense in the context of standard trademarks (*i.e.*, words and pictures).

Lisa T. Oratz, *User Interfaces: Copyright vs. Trade Dress Protection*, 13 COMPUTER LAW, 1, 4 (1996). Or, how would a trademarked scent be placed on the *Abercrombie* spectrum? *Cf. Clarke*, 17 U.S.P.Q.2d (BNA) 1238, 1239-40 (T.T.A.B. 1990) (permitting trademark registration of scent as applied to sewing thread).

113. Professor Brown has argued:

To say that the overall design of a useful article is "inherently distinctive" of a particular source just by examining it and perhaps dissecting it, seems to me an impermissible exercise of intuitive judging. It substitutes an impression that the design is outstanding, or eccentric, or clever, or something, for the proofs of association with a source, gained in the marketplace, that add up to a showing of secondary meaning.

Brown, *supra* note 8, at 1380; *see also* *Stuart Hall Co. v. Ampad Corp.*, 31 U.S.P.Q.2d (BNA) 1468, 1471 (W.D. Mo. 1994) ("[L]ike obscenity, it is far easier to make observations and reach conclusions directly than to articulate standards in a meaningful way."), *rev'd*, 51 F.3d 780 (8th Cir. 1995); *cf.* Melissa R. Gleiberman, Note, *From Fast Cars to Fast Food: Overbroad Protection of Product Trade Dress Under Section 43(a) of the Lanham Act*, 45 STAN. L. REV. 2037, 2042-43 (1993) ("What makes words, symbols, and even product packaging 'inherently distinctive' is that they do not describe the product with which they are identified. When the mark being protected is the configuration of the product itself, to say that the design feature is not descriptive of the product is simply inaccurate in the large majority of cases.")

Seabrook Foods, Inc. v. Bar-Well Foods, Ltd.,¹¹⁴ the Court of Customs and Patent Appeals conducted the evaluation by comparing the trade dress to others in the field.¹¹⁵ Courts applying the *Seabrook* test¹¹⁶ consider whether a shape or feature is “a ‘common,’ basic shape or design, whether it [is] unique or unusual in a particular field, or whether it [is] a mere refinement of commonly-adopted and well-known forms of ornamentation for a particular class of goods viewed by the public as a dress or ornamentation for the goods.”¹¹⁷

The exclusion of basic or common designs is closely keyed to relevant distinctiveness considerations. Extensive use of the same or similar designs may impair the likelihood that consumers can or will use the design to identify a specific product.¹¹⁸ Thus, if most products

114. 568 F.2d 1342 (C.C.P.A. 1977).

115. See *id.* at 1345; *Stuart Hall*, 51 F.3d at 787 (“[T]he *Chevron* and *Abercrombie* tests focus on the arbitrariness of the trade dress and its relevance to the product, whereas the *Seabrook* test focuses on a comparison of the trade dress with others in the field.”).

116. This test is also referred to as the *AmBrit* test. See *AmBrit, Inc. v. Kraft, Inc.*, 812 F.2d 1531, 1536-37 (11th Cir. 1986) (upholding the inherent distinctiveness of the packaging of ice-cream novelty products). Some courts have conducted an analysis of inherent distinctiveness under both the *Seabrook* and *Abercrombie* tests. See, e.g., *Turtle Wax, Inc. v. First Brands Corp.*, 781 F. Supp. 1314, 1318 n.6 (N.D. Ill. 1991) (deciding to apply both because the Seventh Circuit had not identified which test to apply). Other courts apply *Seabrook*, but their analysis is interspersed with references to the *Abercrombie* categories of distinctiveness. See, e.g., *Wiley v. American Greetings Corp.*, 762 F.2d 139, 141 (1st Cir. 1985) (“[A design is considered] ‘inherently distinctive’ if it is fanciful or arbitrary, as opposed to descriptive or generic [W]hether it is arbitrary or merely descriptive, is ordinarily a question of fact . . . that is decided by reference to [the *Seabrook* standard].”). Even the *AmBrit* court, in addition to evaluating the packaging trade dress by the standards it announced, attempted to frame its conclusion in terms of the *Abercrombie* spectrum, characterizing the overall appearance of the packaging as “arbitrary and suggestive.” See *AmBrit*, 812 F.2d at 1537.

117. *Seabrook*, 568 F.2d at 1344; accord *AmBrit*, 812 F.2d at 1536 (utilizing the same language); see also *Nexus Prods. v. Gentle Concepts, Inc.*, 28 U.S.P.Q.2d (BNA) 1257, 1266 (M.D. Fla. 1993) (applying *Seabrook* to appearance of bottles for hair care products); *Remcraft Lighting Prods., Inc. v. Maxim Lighting, Inc.*, 706 F. Supp. 855, 857-858 (S.D. Fla. 1989) (applying *Seabrook* to product configuration).

118. See *AmBrit*, 812 F.2d at 1537; *Seabrook*, 568 F.2d at 1345; RESTATEMENT, *supra* note 1, § 13 cmt. d (basic or common shapes are not inherently distinctive because “their appearance on numerous products makes it unlikely that consumers will view them as distinctive of the goods or services of a particular seller”); 1 MCCARTHY, *supra* note 1, § 7.12, at 7-55 (“Ordinary geometric shapes . . . are regarded as non-distinctive and protectable only upon proof of secondary meaning.”); cf. *AmBrit*, 812 F.2d at 1537 (“[I]solated . . . third party uses of various elements . . . do not detract from the distinctiveness of the overall impression conveyed by the combination of those elements on the [product].”). Even when dealing with verbal or pictorial marks, the measure of a mark’s inherent distinctiveness is affected by the use of the same mark by others in the market. See *International Star Class Yacht Racing Assoc. v. Tommy Hilfiger U.S.A., Inc.*, Civ. No. 94-2663, 1995 WL 241875, at *6 (S.D.N.Y. April 26, 1995) (“Extensive third party use of ‘star’ and its graphic symbol weakens the inherent distinctiveness of the mark and indi-

of the type in dispute are of similar appearance, courts are unlikely to find inherent distinctiveness.¹¹⁹ On the other side of this inquiry, if a dress is unique or unusual, prospective purchasers are more likely to perceive it as a source-designator.¹²⁰ Such analysis, which measures industry rather than lexicographic significance, is arguably even more attuned to consumer perception than verbal mark analysis by virtue of its express market orientation.¹²¹ Moreover, the *Seabrook* test, anchored by reference to other product shapes, sets up an inquiry for which evidence can be developed and a more predictable judgment formed (both by courts and legal advisers) than the *Chev-*

brates that the mark's primary meaning is . . . descriptive."), *aff'd in part, rev'd in part*, 80 F.3d 749 (2d Cir. 1996); RESTATEMENT, *supra* note 1, § 14 cmt. b ("It is also appropriate to consider the extent to which the same or similar terms have been used by others in connection with comparable goods. If the term has been frequently employed by other sellers, an inference of descriptiveness may be justified.").

119. *See, e.g.*, *Naso v. Park*, 850 F. Supp. 264, 270 n.3 (S.D.N.Y. 1994) (concluding that since most microfilm reels are of similar appearance, it is doubtful that inherent distinctiveness can be shown). As the *Wiley* court explained in finding that a red heart-shaped design on the chest of a teddy bear was too common to be protected:

It is hornbook law that "[o]rdinary geometric shapes such as circles, ovals, squares, etc., even when not used as background for other marks, are regarded as non-distinctive and protectable only upon proof of secondary meaning." A plain heart shape, like an "[o]rdinary geometric shape," carries no distinctive message of origin to the consumer, and could not carry such a message [absent secondary meaning] given the heart shape's widespread use as a decoration for any number of products put out by many different companies.

762 F.2d at 142 (internal citations omitted) (first and second alteration in original); *see also* *Mana Prods. v. Columbia Cosmetics Mfg.*, 65 F.3d 1063, 1070 (2d Cir. 1995) ("When it is readily allowed that other cosmetic distributors and retailers have used the identical packaging or containers, it defies simple logic to suggest that the packaging was inherently distinctive."); *Turtle Wax*, 781 F. Supp. at 1321 (rejecting claim of inherently distinctive trade dress for automotive polish where basic shape and design of plaintiff's trade dress were common and merely a combination and refinement of elements already found in abundance in automotive products).

120. *See* 1 MCCARTHY, *supra* note 1, § 8.02[4] (suggesting that *Seabrook* represents "ways to ask whether the design, shape, or combination of elements is so unique, unusual or unexpected in this market that one can assume without proof that it will automatically be perceived by customers as an indicia [sic] of origin"). However, a trade dress will not be considered inherently distinctive merely because "no competitive product combines precisely the same elements in its trade dress." *Turtle Wax*, 781 F. Supp. at 1321; *see also* *Blue Coral, Inc. v. Turtle Wax, Inc.*, 664 F. Supp. 1153, 1163 (N.D. Ill. 1987) (reasoning that if a shape was inherently distinctive merely because no competitive product combines precisely the same elements in its trade dress, every new product on the market would be inherently distinctive).

121. The context of the marketplace significantly affects distinctiveness because that background can either blur or sharpen consumer association. *See* *Paddington Corp. v. Attiki Importers & Distribs., Inc.*, 996 F.2d 577, 583-84 (2d Cir. 1993) ("[P]ackaging lime-flavored soda in green twelve-ounce cans is so common in the soft drink industry that such packaging probably is not inherently distinctive, although without that industry practice green cans would be either suggestive or arbitrary and therefore inherently distinctive.").

ron/*Abercrombie* test permits.¹²²

Although *Seabrook* represents a much more workable test, rooted in predictive factors more practically pertinent to non-verbal marks, few courts applying it have recognized a product configuration as inherently distinctive.¹²³ This may in part be due to the small number of courts applying the test, but may also be attributable to the test's exclusion of "mere refinements" of commonly adopted and well-known forms of ornamentation. Consideration of whether a design is a "mere refinement" of existing designs is also proper in the predictive inquiry of whether consumers are likely to associate the product design with its source. The likelihood of consumer association is lessened not only by prior identical designs, but also by only small differences separating the design of two rival products. However, most industrial design tends to improve incrementally on what has gone before,¹²⁴ and this "mere refinement" consideration thus

122. See 1 GILSON, *supra* note 46, § 7.02[7][d], at 7-73 ("The [*Seabrook*] test appears much more reliable than 'not descriptive' for purposes of educating future courts and juries."); see also *Krueger Int'l, Inc. v. Nightingale Inc.*, 915 F. Supp. 595, 603 (S.D.N.Y. 1996) ("The *Seabrook* test is the most useful of the three tests, in my view, because it clarifies the importance of market context . . . [It] highlights the notion that a design cannot be considered in a vacuum . . . Any test of inherent distinctiveness must ask, 'Inherently distinctive as compared to what?'").

123. Nominally, most courts finding inherently distinctive product configuration trade dress have done so after applying *Abercrombie/Chevron*, or without articulating their reasons for doing so. See *infra* notes 276-77. Two courts have expressly applied *Seabrook* and found an inherently distinctive product configuration. See *Krueger*, 915 F. Supp. at 607 (design of metal-frame stacking chairs inherently distinctive under *Seabrook*); *Callaway Golf Co. v. Golf Clean, Inc.*, 915 F. Supp. 1206, 1212 (M.D. Fla. 1995) (design of "Big Bertha" golf clubs inherently distinctive under *Seabrook*). Courts have also recognized inherently distinctive product features under the *Seabrook* standard where the feature at issue has been primarily two-dimensional in nature. See, e.g., *Lisa Frank, Inc. v. Impact Int'l, Inc.*, 799 F. Supp. 980, 988-89 (D. Ariz. 1992) (finding product design replicated in both two and three dimensions inherently distinctive, citing and applying both *Chevron* and *Seabrook*).

124. Much industrial design today is largely a form of innovation that proceeds incrementally upon existing designs. It ordinarily concerns "variations on known style trends that seldom take major strides beyond the prior art," Reichman, *supra* note 57, at 291, and only infrequently advances the product beyond publicly anticipated extensions of existing styles. See *Dinwoodie*, *supra* note 78, at 36. Often the design project is a response to a minor problem with an existing design. See *id.* at 34 (noting responsive nature of industrial design); see, e.g., *Duraco Prods. v. Joy Plastic Enters.*, 40 F.3d 1431, 1435 (3d Cir. 1994) (describing process of creation of plastic planters and, in particular, changes made to prevent problem of prior design tipping over); *Gasser Chair Co. v. Infanti Chair Mfg. Corp.*, No. 88 Civ. 3931, 1996 WL 370162, at *1 (E.D.N.Y. June 28, 1996) (noting that design of chair came from "need to solve . . . problems" with prior designs), *vacated*, No. 96-1448, 1996 WL 455579 (Fed. Cir. Aug 1, 1996); see also James Braham, *What Do Design Firms Really Do?*, 67 MACHINE DESIGN 42, 43 (1995) (describing designers as "problem solvers"); Ralph Caplan, *The C-Word*, I.D., Jan./Feb. 1995, at 38, 40 ("[T]he

renders design vulnerable to an unfavorable finding on the issue of inherent distinctiveness. It should, therefore, be regarded merely as a relevant predictive factor rather than an absolute bar to inherent distinctiveness.¹²⁵

C. A Secondary Meaning Requirement for Product Design

1. Rationales (Before *Two Pesos*)

Prior to 1992, in courts rejecting the possibility of inherently distinctive shapes, the absolute requirement of secondary meaning burdened all trade dress causes of action, whether involving product packaging or product configuration.¹²⁶ Before the Supreme Court dispensed with that requirement in *Two Pesos* in 1992, however, some courts and commentators had suggested that a line should be drawn not between trade dress and trademarks, but between product design and other forms of trade dress.¹²⁷ In particular, in the dis-

practice of design addresses the user in terms of a problem to solve, a job to do, an irritant to remove, a strategy to formulate, an itch to scratch.”).

125. This effect of applying the “mere refinement” factor might also be mitigated by reading the elements of the *Seabrook* test in the alternative, but courts have weighed the three elements together. See Adam J. Cermak, *Inherent Distinctiveness in Product Configuration Trade Dress*, 3 U. BALT. INTELL. PROP. L.J. 79, 89 (1994).

126. See, e.g., *Coach Leatherware Co. v. AnnTaylor, Inc.*, 933 F.2d 162, 168 (2d Cir. 1991) (design of handbag); *Stormy Clime Ltd. v. ProGroup, Inc.*, 809 F.2d 971, 974 (2d Cir. 1987) (design of rain jacket); *American Greetings Corp. v. Dan-Dee Imports, Inc.*, 807 F.2d 1136, 1141 (3d Cir. 1986) (graphic design on stomach of teddy bears); *Prufrock Ltd. v. Lasater*, 781 F.2d 129, 132 (8th Cir. 1986) (restaurant decor); *Union Mfg. v. Han Baek Trading Co.*, 763 F.2d 42, 48 (2d Cir. 1985) (stainless steel thermos design); *Black & Decker Mfg. Co. v. Ever-Ready Appliance Mfg. Co.*, 684 F.2d 546, 550 (8th Cir. 1982) (design of folding step stool); *Keebler Co. v. Rovira Biscuit Corp.*, 624 F.2d 366, 378 (1st Cir. 1980) (packaging); *White Swan, Ltd. v. Clyde Robin Seed Co.*, 729 F. Supp. 1257, 1260 (N.D. Cal. 1989) (cylindrical, shaker-type container with design on label).

127. See, e.g., *Sicilia Di R. Biebow & Co. v. Cox*, 732 F.2d 417, 426 n.7 (5th Cir. 1984) (“Unlike a product’s configuration, which may acquire trademark value over time and by exposure to consumers, arbitrary and nonutilitarian trade dress or packaging usually is designed to act immediately as an identifier of source.”); *In re DC Comics, Inc.*, 689 F.2d 1042, 1050-51 (C.C.P.A. 1982) (Nies, J., concurring) (noting different considerations where one seeks protection of a product design itself). The *Sicilia Di R. Biebow* court suggested that several of the claimed reasons for the secondary meaning requirement were particularly diminished when applied to packaging: “such trade dress generally does not begin with a ‘primary’ meaning,” and the “wide range of available packaging and design options allows a producer to appropriate a distinctive identity without unduly hindering his competitor’s ability to compete.” 732 F.2d at 426 n.7; see also RESTATEMENT (THIRD) OF UNFAIR COMPETITION, § 16 cmt. b (Tentative Draft No. 2, Mar. 23, 1990) (suggesting that product design, unlike packaging, could not be inherently distinctive) [hereinafter RESTATEMENT TENT. DRAFT NO. 2]; 1 MCCARTHY, *supra* note 1, § 7.23[2] (“Some courts and commentators would draw a line between product shapes and other trade dress formats such that product shape is never inherently distinctive (and hence

tinctiveness context, it was argued that while some forms of trade dress (such as packaging) might be inherently distinctive, product shapes could not be, and would always require proof of secondary meaning.

These arguments rested on a variety of related bases. Those viewing competitive concerns as appropriate to the distinctiveness inquiry raised several questions. Some argued that a different range of alternatives exists with respect to product design as opposed to product packaging.¹²⁸ Others perceived the distinction between packaging and design as another aspect of the balance between (1) the general default rule of free competition (and the penumbral patent "right to imitate or copy"), under which competitors should be encouraged to enter the market with similar designs before the originator's secondary meaning develops, and (2) avoidance of the deception that might occur upon entry into the market after the plaintiff has made exclusive use of the design over a substantial period of time.¹²⁹ By deferring protection until secondary meaning was established, a balance of those two competing interests could be

always requires proof of secondary meaning) while other formats such as packaging could be."); Brown, *supra* note 8, at 1380-81 (arguing that development of inherently distinctive trade dress should be confined to packaging and advertising); Reichman, *supra* note 8, at 109 (commenting that inherently distinctive trade dress "could be rationalized so long as the term trade dress retained its historical reference to packaging and container designs"); William F. Gaske, Note, *Trade Dress Protection: Inherent Distinctiveness as an Alternative to Secondary Meaning*, 57 *FORDHAM L. REV.* 1123, 1139 (1989) (arguing that while inherent distinctiveness is appropriate for package design, it is not for product design).

128. See, e.g., *Sicilia Di R. Biebow*, 732 F.2d at 426 n.7 (suggesting that several of the reasons for the secondary meaning requirement were particularly diminished when applied to packaging; including the "wide range of available packaging and design options allows a producer to appropriate a distinctive identity without unduly hindering his competitor's ability to compete"); *RESTATEMENT TENT. DRAFT NO. 2*, *supra* note 127, § 16 cmt. b ("[T]he competitive interest in copying product designs is more substantial than in the case of packaging, containers, labels, and related subject matter. Product designs are therefore not considered inherently distinctive; such designs are protectable only upon proof of secondary meaning The wide range of designs available for labels and packaging generally permits the recognition of exclusive rights without significantly hindering competition."); Reichman, *supra* note 8, at 110 n.694 (arguing that inherent distinctiveness appropriate for package design but not product design because infinite number of packaging alternatives); Gaske, *supra* note 127, at 1139 (same); cf. *Perfect Fit Indus. v. Acme Quilting Co.*, 618 F.2d 950, 953 (2d Cir. 1980) (discussing secondary meaning requirement, and noting that monopolization is not a problem in the realm of trade dress "because the possible varieties of advertising display and packaging are virtually endless").

129. See, e.g., *DC Comics*, 689 F.2d at 1051 (Nies, J., concurring) (expressing the view that "[d]eferred protection" of product designs "represents a balance of two competing interests" of competitive imitation and prevention of confusion).

achieved.¹³⁰

The distinction between product design and other forms of trade dress was sustained for others by the relative likelihood of packaging and product design operating immediately as an indicium of source.¹³¹ The late Judge Helen Nies of the Court of Appeals for the Federal Circuit, for example, argued that one reason why product design cannot be inherently distinctive is that "[t]he public simply is not likely to associate origin immediately with the shape of goods (or a representation thereof) In our economy, we expect that similar products will come from a number of sources"¹³²

Finally, many commentators reprised various workability concerns regarding the applicability of the *Abercrombie* analysis to product configurations. The difficulty of *Abercrombie* to rationalize fully the basis for protection of shapes as inherently distinctive is revealed most starkly in relation to product design.¹³³ Both product design and packaging suffer from the complications of applying to shapes a test formulated to judge linguistic meaning. However, the form of appraisal mandated by *Abercrombie* connotes a relation (and thus a distinction) between the mark and the product. Product configuration trade dress (arguably unlike that which comprises the appearance of packaging)¹³⁴ cannot provide that relation.¹³⁵ *Aber-*

130. *See id.* (Nies, J., concurring).

131. *See id.* (Nies, J., concurring); *see also* RESTATEMENT TENT. DRAFT NO. 2, *supra* note 127, § 16 cmt. b ("[I]t is less common for consumers to recognize the design of a product as an indication of source. Product features are more likely to be seen merely as utilitarian or ornamental aspects of the goods.").

132. *DC Comics*, 689 F.2d at 1051 (Nies, J., concurring).

133. *See* *Krueger Int'l, Inc. v. Nightingale Inc.*, 915 F. Supp. 595, 601 (S.D.N.Y. 1996) ("[T]he *Abercrombie* classifications do not translate easily to the trade dress context. The problem is not severe when the trade dress involves product packages and labels [But t]he problem is often daunting . . . when it comes to product designs." (citation omitted)); *Hanig & Co. v. Fisher & Co.*, No. 92 C 1779, 1994 WL 97758, at *4 (N.D. Ill. Mar. 24, 1994) ("These terms are best used to classify words used as trademarks. They can be, and are, extended to labeling and packaging But difficulties arise when these categories are applied to the design of a physical object."); *see also DC Comics*, 689 F.2d at 1051 (Nies, J. concurring) ("The semantics, in referring to a design as 'distinctive,' impedes clarity in analysis."); Brown, *supra* note 8, at 1380 ("To say that the overall design of a useful article is 'inherently distinctive' of a particular source just by examining it and perhaps dissecting it, seems to me an impermissible exercise in intuitive judging."); Dratler, *supra* note 8, at 903 ("At first glance, the distinctiveness spectrum may appear to have little to do with industrial designs. Unlike verbal marks, industrial designs do not describe anything; they just are."). *But see* Opderbeck, *supra* note 110, at 38 ("The standard [*Abercrombie*] taxonomy should not be much more difficult to apply in product configuration cases than in other trade dress or trademark cases.").

134. The difference lies in the fact that where the trade dress involves product packages, words or labels, the symbols that convey information about the product are

crombie analysis requires the design feature to serve a schizophrenic existence, both as the product and the identifier, rendering analysis more complex.

Our inability to find any relation between the mark and the product, to be used in guiding our distinctiveness inquiry, should not necessarily lead to the conclusion that no reliable predictor of likely consumer association can be found.¹³⁶ As discussed below, alternative indicia of likely consumer response are available for consideration, forestalling the need to ask always for evidence of actual association in the form of secondary meaning.¹³⁷ Yet, the observation that the *Abercrombie* test is stretched further by product design than by packaging clearly has some merit. In addition to the lack of a relation by which to evaluate a product's configuration, packaging is more frequently considered arbitrary (in the vocabulary of *Abercrombie*) in relation to the product. It can be wholly incongruous in relation to the product, with less severe commercial consequences than would flow from a feature of the product itself being incongruous. As a consequence, packaging can more easily avoid the murky suggestive/descriptive line (a line which is most intimately connected

independent of the product. See *Krueger*, 915 F. Supp. at 601; see also *Duraco Prods. v. Joy Plastic Enters.*, 40 F.3d 1431, 1441 n.8 (3d Cir. 1994) ("We do not suggest that the same [*Abercrombie*] taxonomy might not be efficacious in the context of product packaging.") (rejecting *Abercrombie* as applied to product configuration).

135. See *Stuart Hall Co. v. Ampad Corp.*, 51 F.3d 780, 786 (8th Cir. 1995) ("These definitions [of the *Abercrombie* categories] address the relation between the product and the trade dress . . ."). If the relation (such as it existed) had to be explained in terms of classical distinctiveness analysis, critics contended that it could at best be placed at the level of descriptiveness. This provided a further argument against permitting inherently distinctive product configuration trade dress. See *DC Comics*, 689 F.2d at 1051 (Nies, J., concurring) ("[A] product design or a representation of a product is manifestly equivalent to words which describe its appearance and must be given the same treatment as inherently descriptive words."); see also *Tesco Chemicals, Inc.*, 181 U.S.P.Q. 59, 60 (T.T.A.B. 1973) (explaining that product configuration is registerable only if it has acquired secondary meaning because such a shape is "necessarily merely descriptive."); cf. *Blau Plumbing, Inc. v. S.O.S. Fix-It, Inc.*, 781 F.2d 604, 608 (7th Cir. 1986) ("[T]hese holdings may just reflect the fact that trade dress may be undistinctive without being descriptive."). In *Qualitex Co. v. Jacobsen Products Co.*, 115 S. Ct. 1300, 1303 (1995), the Supreme Court employed a similar analytical device, analogizing consumer association of color to descriptive terms. In essence, this creates a presumption that color cannot rise above descriptive on the *Abercrombie* scale and thus requires secondary meaning to be protected. See *infra* notes 150-51.

136. The lack of a relation between the mark and product is often seized on by critics of inherently distinctive product designs to justify a requirement of secondary meaning. That argument presupposes, however, that the lack of a relation prevents there being any reliable predictors of association. As I demonstrate below, see *infra* Part IV(E), those predictors exist.

137. See *infra* Part IV(E)(2).

to linguistic meaning) around which most trademark disputes are fought, and to which most significance is attached by courts under the traditional analysis.¹³⁸

For example, packaging for diapers in the shape of the Eiffel Tower would almost certainly be considered arbitrary and inherently distinctive,¹³⁹ and much packaging can be, and is, of that nature without having adverse effects on the product's market share. If the diapers themselves were sold in the form of the Eiffel Tower, however, the product design—while it likely would be considered arbitrary and inherently distinctive—would most probably be unsaleable. Many products with a wholly incongruous design would probably be less marketable, and thus the cases coming before courts do not involve designs that are clearly arbitrary in *Abercrombie* terms.¹⁴⁰ It is with respect to product design trade dress that the deficiencies of *Abercrombie* are most thoroughly exposed; the task of applying *Abercrombie* to product design has thus precipitated judicial reassessment of its usefulness.

138. See *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 10-11 (2d Cir. 1976) (noting difficulty drawing the line between descriptive and suggestive marks); *Estee Lauder, Inc. v. Gap, Inc.*, 932 F. Supp. 595, 608 (S.D.N.Y. 1996) ("Differentiation between suggestive and descriptive marks is not always easy."); *Franklin Knitting Mills, Inc. v. Fashionit Sweater Mills, Inc.*, 297 F. 247, 248 (S.D.N.Y. 1923) ("It is quite impossible to get any rule out of the cases beyond this: That the validity of the mark ends where suggestion ends and description begins."); cf. *Watson*, *supra* note 112, at 283-85 (arguing for the elimination of the categories of suggestive and descriptive as applied to graphic user interfaces, and noting that "[t]hese categories are the most difficult to differentiate between and they are better suited to determining the distinctiveness of word marks").

139. See *International Playtex Corp.*, 153 U.S.P.Q. (BNA) 377, 378 (T.T.A.B. 1967) (finding that cone shaped packaging for baby pants inherently distinctive).

140. There is a distinction to be drawn here between features of a product where the manufacturer seeks to integrate form and function (most kitchen appliances, for example), and features of a product that are intentionally superfluous (novelty items, for example). The *Abercrombie/Chevron* formulation is particularly hostile toward functionalist design (i.e., design integrating form and function) rather than the supplementary application of ornament to a functional product. See *Dinwoodie*, *supra* note 78, at 23 (describing evolution of industrial design in conformance with ethos that "form and function blend inseparably into one"). Under the classical categories, the strength, and inherent distinctiveness, of verbal marks is often shown by demonstrating the degree of arbitrariness in mark selection, or by how incongruous the mark is with respect to the product upon which it is affixed. See, e.g., *Sands, Taylor & Wood Co. v. Quaker Oats Co.*, 978 F.2d 947, 953 (7th Cir. 1992) (explaining that the test for suggestive marks asks whether imagination is necessary to connect a name that is incongruous or figurative with the product); *Blisscraft of Hollywood v. United Plastics Co.*, 294 F.2d 694, 700 (2d Cir. 1961) (holding a mark to be inherently distinctive where incongruous).

2. Effect of *Two Pesos* on Secondary Meaning Requirement for Product Designs

In *Two Pesos*, the trade dress at issue comprised the decor of a restaurant. Arguably, that decision does not foreclose the possibility of drawing a distinction between product shape and other forms of trade dress, such as packaging (or restaurant decor).¹⁴¹ The precise issue of an inherently distinctive product configuration clearly was not before the Supreme Court, although neither can restaurant decor be considered an archetypal packaging case. If characterization were necessary, we might develop a separate category called "service dress," to describe the get-up of a service rather than a product.¹⁴²

The Court of Appeals for the Third Circuit has explicitly recognized this more limited scope of the Supreme Court's decision. Characterizing *Two Pesos* as a packaging case, in two recent cases the Third Circuit has accorded significance to the distinction between product packaging trade dress and product configuration trade dress.¹⁴³ The Court of Appeals for the Second Circuit, after an initial

141. See Bradley K. Groff, *Bare-Fisted Competition or Palming Off? Protection of Product Design as Trade Dress under the Lanham Act*, 23 AM. INTELL. PROP. L. ASS'N Q.J. 65, 96 (1996) (suggesting that a continued secondary meaning requirement for product configurations can be squared with the holding in *Two Pesos*).

142. See *infra* text accompanying notes 301-04; *infra* note 337.

143. See *Duraco Prods. v. Joy Plastics Enters.*, 40 F.3d 1431, 1439 (3d Cir. 1994); see also *Versa Prods. Co. v. Bifold Co.*, 50 F.3d 189, 197-200 (3d Cir. 1995). The Third Circuit has forged its distinction between packaging and product configuration for the purpose of analyzing (1) inherent distinctiveness; (2) secondary meaning; and (3) likelihood of confusion. The Third Circuit's analysis of inherent distinctiveness is discussed in Part IV(D)(2)(a) of this Article. The *Versa* case, in which the court drew the line between product configuration and packaging in determining likelihood of confusion, is discussed in Dinwoodie, *supra* note 17, at 42-59. The incorporation of the distinction into the court's analysis of secondary meaning has taken two forms. First, whereas the mere fact of commercial success ordinarily favors a trademark plaintiff in establishing secondary meaning, the Third Circuit has indicated a reluctance to infer secondary meaning from sales success in the case of product configurations, because such success may be attributable merely to the appealing design of the product rather than its source-designating capacity. See, e.g., *Duraco*, 40 F.3d at 1453 ("[P]roduct configuration again differs dramatically from trademark and from product packaging, since the success of the particular product—especially if similar competing products exist—does not readily lead to the inference of source identification and consumer interest in the source; it may well be that the product, inclusive of the product configuration, is itself inherently desirable, in a way that product packaging and trademarks are not."); see also *Thomas & Betts Corp. v. Panduit Corp.*, 65 F.3d 654, 663 (7th Cir. 1995) (same), *cert. denied*, 116 S. Ct. 1044 (1996); *Devan Designs Inc. v. Palliser Furniture Corp.*, 25 U.S.P.Q.2d (BNA) 1991, 1997 (M.D.N.C. 1992) (same), *aff'd*, 998 F.2d 1008 (4th Cir. 1993) (*per curiam*). But see *Aromatique, Inc. v. Gold Seal, Inc.*, 28 F.3d 863, 872-73 (8th Cir. 1994) (applying similar reasoning to justify non-protection of packaging).

Second, the Third Circuit has demonstrated an unwillingness to permit product configuration trade dress plaintiffs to avail themselves of evidentiary presumptions that can

reluctance to partition different types of trade dress, has drawn the same distinction as the Third Circuit without characterizing the nature of the trade dress at issue in *Two Pesos*.¹⁴⁴ The drafters of the

normally be relied upon to assist in establishing that a trade dress is imbued with secondary meaning. For example, many courts hold that intentional copying gives rise to a rebuttable presumption of secondary meaning, *see, e.g.*, *Ferrari S.P.A. Esercizio v. Roberts*, 944 F.2d 1235, 1239 (6th Cir. 1991) (noting that secondary meaning can be presumed from admission of intentional copying); *Osem Food Indus. v. Sherwood Foods, Inc.*, 917 F.2d 161, 163 (4th Cir. 1990) (rebuttable presumption of secondary meaning arises from evidence of intentional copying), or at least is a factor to be considered in support of secondary meaning. *See, e.g.*, *Vision Sports, Inc. v. Melville Corp.*, 888 F.2d 609, 615 (9th Cir. 1989) (“[P]roof of copying strongly supports an inference of secondary meaning.”); *Schwinn Bicycle Co. v. Ross Bicycles, Inc.*, 870 F.2d 1176, 1182 n.13 (7th Cir. 1989) (explaining that intentional copying is probative evidence of secondary meaning but declining to create presumption); *Brooks Shoe Mfg. Co. v. Suave Shoe Corp.*, 716 F.2d 854, 859-60 (11th Cir. 1983) (same). The rationale behind these various levels of evidentiary preference is that when a defendant copies the trademark of a competitor it is likely (and thus can be inferred or presumed) that it intended to appropriate the commercial advantage attaching to that trademark (i.e., the goodwill of the consumers) which must therefore exist. *See Osem Foods Indus.*, 917 F.2d at 165; *Audio Fidelity, Inc. v. High Fidelity Recordings, Inc.*, 283 F.2d 551, 558 (9th Cir. 1960) (“There is no logical reason for the precise copying save an attempt to realize upon a secondary meaning that is in existence.”).

Regardless of the merit of these inferences as generally applied (and some courts have questioned the correctness of such presumptions generally, citing both false premises and circularity), the Third Circuit has indicated that, in a product design trade dress action, it will attach lesser weight to evidence of intentional copying in assessing secondary meaning. *See Duraco*, 40 F.3d at 1453; *see also Cicena Ltd. v. Columbia Telecomms. Group*, 900 F.2d 1546, 1552 (Fed. Cir. 1990) (“Attempting to capitalize on a market demand for a type of product does not always indicate secondary meaning.”); *Thomas & Betts Corp.*, 65 F.3d at 663 (holding that the copying of a product design does not necessarily support a conclusion of secondary meaning); *Devan Designs*, 25 U.S.P.Q.2d (BNA) at 2000 (“*Especially in product design cases*, there may be an even more likely reason why one might copy another’s trade dress such as to capitalize on a particularly attractive or saleable product design.” (emphasis added)). Indeed, the *Duraco* court noted, in support of a finding of no secondary meaning, that “Joy emulated Duraco’s design because Joy believed it to be a superior one, not to trade on Duraco’s non-existent goodwill.” *Duraco*, 40 F.3d at 1453.

In the last year, the Supreme Court received three petitions for certiorari requesting it to consider whether a distinction is to be drawn between product configurations and packaging in trade dress analysis. One of those petitions addressed the distinction between packaging and product configuration in the context of analyzing secondary meaning. *See Thomas & Betts*, 65 F.3d 654 (7th Cir. 1995), *petition for cert. filed*, 64 U.S.L.W. 3518 (U.S. Jan. 22, 1996) (No. 95-1169), *cert. denied*, 116 S. Ct. 1044 (1996); *see also infra* note 256 (discussing petition in *Thomas & Betts*). The other two petitions asked whether the distinction is relevant in conducting an assessment of the likelihood of confusion. *See Versa Prods. Co. v. Bifold Co.*, 50 F.3d 189 (3d Cir. 1995), *petition for cert. filed*, 63 U.S.L.W. 3834 (U.S. May 12, 1995) (No. 94-1863), *cert. denied*, 116 S. Ct. 54 (1995); *Chums, Ltd. v. Snugz/USA, Inc.*, 36 U.S.P.Q.2d (BNA) 1125 (10th Cir. 1995), *petition for cert. filed*, 64 U.S.L.W. 3417 (U.S. Nov. 27, 1995) (No. 95-689), *cert. denied*, 116 S. Ct. 914 (1996).

144. *See Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996, 1007-08 (2d Cir. 1995). The ambiguities of the *Knitwaves* decision are discussed further *infra* at text accompanying

recently revised *Restatement* also appear to read *Two Pesos* restrictively, apparently viewing product configuration as largely untouched by the Supreme Court's decision.¹⁴⁵

Some courts have suggested a broader scope for *Two Pesos* and a more direct application to product design. The Eighth Circuit, for example, has expressly rejected the Third Circuit's reading of *Two Pesos*: "[W]e view *Two Pesos* as a case that involves product configuration, . . . its holding leads directly to the conclusion that product configuration, like packaging, can be inherently distinctive, and if it is, no showing of secondary meaning is required."¹⁴⁶ Other courts, by their action, have endorsed the concept of inherently distinctive product configuration trade dress.¹⁴⁷ And the influential Court of

notes 210-41. One district court in the Second Circuit, in an opinion handed down two months after *Knitwaves*, suggested that *Two Pesos* was "clearly a case of product design." *See Krueger Int'l, Inc. v. Nightingale Inc.*, 915 F. Supp. 595, 602 (S.D.N.Y. 1996).

145. *See* RESTATEMENT, *supra* note 1, § 16 cmt. b ("At least with respect to packaging and related features . . . it is now recognized that trade dress can be inherently distinctive . . . Product designs are . . . not ordinarily considered inherently distinctive and are thus normally protected only upon proof of secondary meaning."). The language of the adopted *Restatement* does, however, admit of the possibility of inherently distinctive product designs; the previous draft (which was published prior to *Two Pesos*) did not. *Compare id.* (recognizing the possibility of inherently distinctive product designs), with RESTATEMENT TENT. DRAFT NO. 2, *supra* note 127, § 16 cmt. b ("Product designs are . . . not considered inherently distinctive; such designs are protectable only upon proof of secondary meaning.").

146. *Stuart Hall Co. v. Ampad Corp.*, 51 F.3d 780, 788 (8th Cir. 1995); *see also* *Insty*Bit, Inc. v. Poly-Tech Indus., Inc.*, 95 F.3d 663, 672-73 (8th Cir. 1996) (finding that a genuine issue existed as to whether design of plaintiff's drill products was inherently distinctive); *Krueger*, 915 F. Supp. at 602 (*Two Pesos* was "clearly a case of product design"); *Reese Prods. v. Valley Indus.*, 50 Pat. Trademark & Copyright J. (BNA) 228, 229 (D. Ind. May 15, 1995) ("*Two Pesos* not only conceptually but also actually covered product configuration trade dress, and it is that standard . . . which must and will be applied in this case."); *Devan Designs*, 25 U.S.P.Q.2d (BNA) at 1996 n.2 (stating that Supreme Court in *Two Pesos* indicated that protection via inherent distinctiveness applied to designs as well as packaging).

147. *See, e.g., Krueger*, 915 F. Supp. at 607 (design of metal-frame stacking chairs inherently distinctive); *Callaway Golf Co. v. Golf Clean, Inc.*, 915 F. Supp. 1206, 1212 (M.D. Fla. 1995) (design of "Big Bertha" golf clubs inherently distinctive); *Kompan A.S. v. Park Structures, Inc.*, 890 F. Supp. 1167, 1183-84 (N.D.N.Y. 1995) (granting preliminary injunction on basis of inherently distinctive trade dress of playground equipment); *Banff Ltd. v. Limited, Inc.*, 869 F. Supp. 1103, 1116 (S.D.N.Y. 1994) (denying defendant's motion for summary judgment on whether design of sweater inherently distinctive), *later proceeding*, *Banff Ltd. v. Express, Inc.*, 921 F. Supp. 1065 (S.D.N.Y. 1995) (granting defendant's renewed motion for judgment as a matter of law on question of inherent distinctiveness in light of intervening Second Circuit decision establishing distinction between packaging and product features); *Vornado Air Circulation Sys., Inc. v. Duracraft Corp.*, 92-1543-WEB, Memorandum and Order at 29 (D. Kan. Mar. 4, 1994) (appearance of household fan grill inherently distinctive), *rev'd on other grounds*, 58 F.3d 1498 (10th Cir. 1995), *cert. denied*, 116 S. Ct. 753 (1996); *see also* *Fun-Damental Too, Ltd. v. Gemmy Indus.*, No. 96 Civ. 1103, 1996 WL 125641, at *8-9 (S.D.N.Y. Mar. 21, 1996) (concluding that trade dress

Appeals for the Federal Circuit appears ready to equate product packaging and product configuration for this purpose.¹⁴⁸

of novelty bank, consisting of the overall impression conveyed by the product's features and its packaging, was inherently distinctive); *Fundex Inc. v. Imperial Toy Corp.*, 26 U.S.P.Q.2d (BNA) 1061, 1063-64 (S.D. Ind. 1992) (finding that plaintiff presented sufficient evidence to support claim that overall appearance of jump rope, including its color scheme, padded handles, nylon weave, and corrugated packaging, was inherently distinctive trade dress) (denying defendant's motion for judgment as a matter of law). Decisions of district courts in the Second Circuit must, however, now be read in light of the Court of Appeals' decision in *Knitwaves*. Every court applying the test outlined in *Knitwaves* to product configuration has found the trade dress at issue not to be inherently distinctive. *See, e.g.*, *EFS Mktg. v. Russ Berrie & Co.*, 76 F.3d 487, 491 (2d Cir. 1996) (toy dolls); *Grupke v. Linda Lori Sportswear, Inc.*, 921 F. Supp. 987, 996 (E.D.N.Y. 1996) (tee-shirt design); *Herbko Int'l, Inc. v. Gemmy Indus.*, 916 F. Supp. 322, 328 (S.D.N.Y. 1996) (design of game board); *Judith Ripka Designs, Ltd. v. Preville*, 935 F. Supp. 237, 257-58 (S.D.N.Y. 1996) (jewelry); *Banff Ltd. v. Express, Inc.*, 921 F. Supp. 1065, 1071 (S.D.N.Y. 1995) (sweaters); *see also* *New York Racing Ass'n, Inc. v. Perlmutter Publ'g, Inc.*, No. 95 Civ. 994, 1996 WL 465298, at *2 (N.D.N.Y. July 19, 1996) (finding trade dress consisting of images on souvenir merchandise not inherently distinctive under *Knitwaves*). Decisions in the wake of *Two Pesos* suggest that the Ninth Circuit would treat the Supreme Court's endorsement of inherently distinctive trade dress as extending to product configuration and not limited to packaging or packaging-type claims. *See, e.g.*, *Locomotor U.S.A., Inc. v. Korus Co.*, 46 F.3d 1142 (9th Cir. 1995) (Table decision, opinion published at 1995 WL 7489, at *7 (remanding trade dress claim to district court in light of *Two Pesos* to determine inherent distinctiveness of elements of trade dress that included luggage design)).

148. *See* *Imagineering, Inc. v. Van Klassens, Inc.*, 53 F.3d 1260, 1263-64 (Fed. Cir.) (involving product design and citing *Two Pesos* for the proposition that "trade dress is inherently distinctive when, by its 'intrinsic nature,' it identifies the particular source of a product") (affirming jury finding of inherently distinctive furniture), *cert. denied*, 116 S. Ct. 277 (1995); *Alan Tracy, Inc. v. Trans Globe Imports, Inc.*, Nos. 94-1205, 94-1381, 1995 WL 331109, at *5 (Fed. Cir. June 2, 1995) (affirming trial court finding of inherently distinctive feature of lighting fixture lens because physical configuration is uncommon and creates a distinctive visual impression) (applying the law of the Eleventh Circuit); *see also* *Braun, Inc. v. Dynamics Corp. of Am.*, 975 F.2d 815, 825 & nn.18-19 (Fed. Cir. 1992) (noting tests in *Abercrombie* and *Chevron* and remanding to district court to apply to determine inherent distinctiveness of blender design). In *Imagineering*, the court was applying the law of the Second Circuit. *See* 53 F.3d at 1263 (because trade dress issues not unique to the court's exclusive jurisdiction, the Federal Circuit defers to the law of the regional circuit in which district court sits). However, it reached its conclusion without reference to any specific legal standard of distinctiveness other than *Two Pesos*.

The response of the Seventh Circuit, which had accepted the possibility of inherently distinctive shapes prior to *Two Pesos*, *see* *Vaughan Mfg. Co. v. Brikam Int'l, Inc.*, 814 F.2d 346, 348 (7th Cir. 1987), has been somewhat ambiguous. In *Kohler Co. v. Moen Inc.*, a decision of otherwise high protection principles, the court expressed the view that product configuration trade dress can never be inherently distinctive, but acknowledged that it was not necessary for the court to decide that issue because secondary meaning was conceded. 12 F.3d 632, 641 n.11 (7th Cir. 1993) ("The only distinction courts make between trade dress generally and product configuration cases in particular is to require plaintiffs asserting a claim for infringement of trade dress in product configuration under § 43(a) of the Lanham Act to prove secondary meaning because a product's shape is never inherently distinctive."); *see also* *Nelson/Weather-Rite, Inc. v. Leatherman Tool Group, Inc.*, No. 93 C 2274, 1995 WL 669091, at *10 (N.D. Ill. Nov. 8, 1995) (describing *Kohler* as

The sole trademark decision of the United States Supreme Court since *Two Pesos* does not clearly resolve the issue of whether the Court intended to extend the assimilation of trade dress to verbal marks it announced in *Two Pesos* to all trade dress, including product design. Language in the Court's opinion in *Qualitex Co. v. Jacobsen Products Co.*¹⁴⁹ fosters the notion that, despite *Two Pesos*, certain non-verbal marks—such as the color per se claimed as a mark in that case—might require secondary meaning to establish distinctiveness.¹⁵⁰

having noted held that “the distinction between trade dress generally and product configuration is such that a proponent of trade dress protection for product configuration must almost certainly prove secondary meaning because a product's shape is never inherently distinctive”); cf. *Waldmann Lighting Co. v. Halogen Lighting Sys., Inc.*, 28 U.S.P.Q.2d (BNA) 1682, 1684 (N.D. Ill. 1993) (noting courts' reluctance to find “a product's design, as opposed to its packaging,” inherently distinctive (citation omitted)). Most courts in that circuit have, however, subsequently declined to interpret *Kohler* as suggesting that the Seventh Circuit had adopted an absolute requirement of secondary meaning for product configurations, see, e.g., *Sassafras Enters., Inc. v. Roshco, Inc.*, 915 F. Supp. 1, 4-5 (N.D. Ill. 1996) (“Although . . . inherent distinctiveness is less likely to be present where the appearance of the product itself is at issue . . . it is obviously not impossible for a product's configuration to be inherently distinctive.”); *Dorr-Oliver Inc. v. Fluid-Quip, Inc.*, 894 F. Supp. 1190, 1198 n.10 (N.D. Ill. 1995) (arguing that to read *Kohler* otherwise would contradict *Two Pesos*), *rev'd on other grounds*, 94 F.3d 376 (7th Cir. 1996); *Health O Meter, Inc. v. Terraillon Corp.*, 873 F. Supp. 1160, 1170 (N.D. Ill. 1995), and a different panel of the Seventh Circuit has upheld the protectability of a product design that had been based on inherent distinctiveness (although in an opinion otherwise less protective than *Kohler*, providing limited relief and without comment on inherent distinctiveness). See *Badger Meter, Inc. v. Grinnell Corp.*, 13 F.3d 1145, 1151 (7th Cir. 1994); see also *Computer Care v. Service Sys. Enters.*, 982 F.2d 1063, 1069 (7th Cir. 1992) (affirming finding of inherent distinctiveness of two-dimensional product features); *Fundex Inc.*, 26 U.S.P.Q.2d (BNA) at 1063-64 (holding that trade dress comprising composite of the product features and its packaging could be inherently distinctive, and denying defendant's motion for judgment as a matter of law). Recent Seventh Circuit decisions suggest that the court of appeals is seeking to rein in product design trade dress protection, but the court has sought to do so in its analysis of secondary meaning, likelihood of confusion, and the potential conflict of trade dress protection with patent law. See *infra* note 292. The only mild expression of dissatisfaction with more liberal district court interpretations of inherent distinctiveness can be discerned in dicta in *Dorr-Oliver*. See 94 F.3d 376, 380 n.6 (7th Cir. 1996). There, the district court had found that a clamshell-shaped starch washer used in processing corn was an inherently distinctive design. See *Dorr-Oliver Inc. v. Fluid-Quip, Inc.*, 894 F. Supp. 1190, 1198-99 (N.D. Ill. 1995) (not clearly identifying the test applied). The court of appeals reversed the district court's grant of an injunction on the ground that plaintiff had failed to establish likelihood of confusion. Although the court did not reach the distinctiveness question, it noted that the defendant had presented “a number of compelling arguments for reversal,” and made a point of referencing the lower court's finding of inherent distinctiveness. See *Dorr-Oliver*, 94 F.3d at 380; *id.* at 380 n.6.

149. 115 S. Ct. 1300 (1995) (holding that the color of a product per se may be registered as a trademark upon proof of secondary meaning and nonfunctionality).

150. See *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996, 1008 (2d Cir. 1995) (“[The *Qualitex*] Court concluded [that] a product's color is . . . eligible for trademark protection only when it acquires secondary meaning . . .”); *Mana Prods. v. Columbia Cosmetics*

Although Justice Breyer's opinion does not explicitly discuss the secondary meaning requirement, the Court contrasted marks consisting of color per se with inherently distinctive marks and compared them with descriptive terms.¹⁵¹ In other sections of the opinion, however, the Supreme Court appears to be proceeding on the premise that "designs" can be inherently distinctive (although that term need not be construed as a reference to *product designs*).¹⁵²

Mfg., 65 F.3d 1063, 1071 (2d Cir. 1995) ("In light of the Supreme Court's decision in *Qualitex*, color is capable of obtaining trademark status in the same manner [as] a descriptive mark . . . by attaining secondary meaning."); *Fabrication Enters., Inc. v. Hygenic Corp.*, 64 F.3d 53, 58 n.3 (2d Cir. 1995) ("Pursuant to *Qualitex*, Lanham Act protection for a single color may be garnered only upon a showing of secondary meaning."); see also Kevin M. Jordan & Lynn M. Jordan, *Qualitex Co. v. Jacobsen Prods. Co.: The Unanswered Question—Can Color Ever be Inherently Distinctive?*, 85 TRADEMARK REP. 371, 392 (1995) ("Justice Breyer may have intended to preclude color from ever being considered inherently distinctive."); Jeffrey M. Samuels & Linda B. Samuels, *Protection For Color Under U.S. Trademark Law*, 23 AM. INTELL. PROP. L. ASS'N Q.J. 129, 136 n.30 (1996) ("Justice Breyer's decision in *Qualitex* seems to assume that secondary meaning will always have to be established before color alone will be protected."); Michael Schwarz, *Registration of Colours as Trade Marks*, 17 EUR. INTELL. PROP. REV. 393, 394 (1995) ("[I]n view of the *Owens-Corning* case and the reasoning in the *Qualitex* case, it is unlikely that a colour-only trade mark will ever be registered on the Principal Register in the absence of a showing of secondary meaning."); Daniel R. Schechter, Comment, *Qualitex Co. v. Jacobsen Prods., Inc.: The Supreme Court "Goes for the Gold" and Allows Trademark Protection for Color Per Se*, 5 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 481, 505 (1995) ("Importantly, the [*Qualitex*] court indicated that a product's color can not be considered a 'fanciful,' 'arbitrary' or 'suggestive' mark. In practical terms, this means that product color will not be able to be registered without acquiring secondary meaning"). But see *Sunbeam Prods. Inc. v. West Bend Co.*, 39 U.S.P.Q.2d (BNA) 1545, 1548 (S.D. Miss. 1996) ("[In *Qualitex*], the Court held that color alone in certain instances can be inherently distinctive . . ."). For a discussion of the competing interpretations of *Qualitex* on this point, see Michael B. Landau, *Reconciling Qualitex with Two Pesos: Ambiguity and Inconsistency from the Supreme Court*, 3 UCLA ENT. L. REV. 219, 248-53 (1996).

151. See *Qualitex Co.*, 115 S. Ct. at 1303 (noting that "a product's color is unlike 'fanciful,' 'arbitrary,' or 'suggestive' words or designs, which almost *automatically* tell a customer that they refer to a brand"); *id.* (analogizing consumer association with color to descriptive terms, and stating that lack of objection to protection existed with respect to color that has attained secondary meaning); *id.* at 1307 (reasoning that logic of protecting descriptive marks that have acquired secondary meaning applies also to color per se).

152. See *id.* at 1303. If, as *Qualitex* hints, evidence of secondary meaning is required of marks that are less likely automatically to identify source, it is arguable that that rule should also have applied in *Two Pesos* or should apply with product configurations. Alternatively, of course, the policy considerations that mandate inherently distinctive shapes should permit the same argument with respect to color. See Jonathan Hudis, *Removing the Boundaries of Color*, 86 TRADEMARK REP. 1, 7 (1996) ("If, under [*Two Pesos*], inherently distinctive trade dress is capable of Lanham Act protection, so too should be color arbitrarily or suggestively applied to a product or service."); Jordan & Jordan, *supra* note 150, at 397 ("Surely in a decision so clearly holding that color is no different than any other mark capable of being trademarked, the logical conclusion must be that the entire test for distinctiveness—secondary meaning or inherently distinctive—applies to color.").

The majority of courts directly addressing the issue, however, appear inclined to extend the teachings of *Two Pesos* to product configurations, which can therefore constitute inherently distinctive trade dress. Even the Third Circuit, which asserted that *Two Pesos* did not decide whether a product configuration can ever be inherently distinctive,¹⁵³ has drawn back from retaining an absolute secondary meaning requirement for product configuration.¹⁵⁴ The court reached that conclusion based upon the independent belief that the policy concerns surrounding an absolute secondary meaning requirement (which the Supreme Court had expressed in *Two Pesos*) applied with as much force to product configurations as to other trade dress.¹⁵⁵ Instead, the Third Circuit has held that the traditional *method* of trade dress analysis does not apply to a claim under section 43(a) that a product configuration has been infringed, thus establishing a schism of a different sort—an analytical methodology schism—between product packaging and product configuration.¹⁵⁶ The distinction drawn by the Third Circuit does not give rise to an absolute refusal to countenance inherently distinctive product configurations, but rather to a different formulation of the test for

153. See *Duraco Prods. v. Joy Plastic Enters.*, 40 F.3d 1431, 1445 (3d Cir. 1994).

154. See *id.* at 1445-46 (“[W]e do read *Two Pesos* as giving an imprimatur to finding trade dress in a product configuration to be inherently distinctive under certain narrow circumstances.”); see also *Versa Prods. Co. v. Bifold Co.*, 50 F.3d 189, 203 n.10 (3d Cir. 1995) (acknowledging that product configuration may be inherently distinctive). The *Duraco* court appeared to recognize a conceptually valid (if factually unsubstantiated) basis upon which to differentiate between product and packaging design in considering inherent distinctiveness, reciting that “a product configuration can not generally give rise to a similar presumption [of achieving customer association immediately upon use], as consumers usually appreciate a product’s configuration for its contribution to the inherent appeal of the product, not (in the absence of secondary meaning) its signifying function.” 40 F.3d at 1441.

155. See *Duraco*, 40 F.3d at 1446 (concluding that policy concerns of hindering the pro-competitive capacity of product demarcation, leaving trademark owners vulnerable in the early stages of product marketing and placing burdens disproportionately on small start-up businesses seemed equally applicable to product configuration trade dress).

156. Other courts have refused to establish such a schism. See, e.g., *Stuart Hall Co. v. Ampad Corp.*, 51 F.3d 780, 788 (8th Cir. 1995) (“[W]e decline to create a distinction between protection of packaging and protection of product configuration, as such a distinction would run contrary to the holding of *Two Pesos*.”); *id.* at 787 (“We . . . read *Two Pesos* as resting on a presumption that ‘trade dress’ is a single concept that encompasses both product configuration and packaging, and find that its holding applies to trade dress as a whole, not merely to packaging.”); *Krueger Int’l, Inc. v. Nightingale Inc.*, 915 F. Supp. 595, 602 (S.D.N.Y. 1996) (“[T]he entire thrust of *Two Pesos* was to unify the standards for trademark and trade dress, not to balkanize this complex field into yet more subcategories. I agree with the Eighth Circuit’s conclusion that the Supreme Court envisions trade dress as a ‘single concept’ with trademark law requiring a single test for inherent distinctiveness.”).

inherent distinctiveness.

A similar result has been reached in the Second Circuit. In the aftermath of *Two Pesos*, the Second Circuit initially declined litigants' invitations to consider drawing a distinction between packaging and product design.¹⁵⁷ Lacking guidance, several district courts in the Second Circuit assimilated the treatment of product design and packaging and found inherently distinctive product configurations, largely under the *Abercrombie* test.¹⁵⁸ Indeed, seven of the seventeen¹⁵⁹ post-*Two Pesos* decisions finding inherently distinctive product configurations emanated from the Second Circuit.¹⁶⁰ Five of those seven decisions preceded the decision of that court in *Knitwaves, Inc. v. Lollytogs Ltd.*,¹⁶¹ however, in which it reversed the district court's finding of an inherently distinctive sweater design, and followed the Third Circuit in concluding that the test for inherently distinctive product configurations must diverge from that used to as-

157. See *Tough Traveler, Ltd. v. Outbound Prods.*, 60 F.3d 964, 968 (2d Cir. 1995); *id.* at 970 n.1 (Jacobs, J., concurring); see also *Mulberry Thai Silks, Inc. v. K & K Neckwear, Inc.*, 897 F. Supp. 789, 793 (S.D.N.Y. 1995) ("Subsequent to *Two Pesos*, [the Second Circuit] has applied the *Abercrombie* typology to the determination of inherent distinctiveness in a packaging trade dress case, but it has not yet considered the issue in the context of a product design or configuration case." (citations omitted)).

158. See *supra* note 147; *infra* note 162.

159. For an explanation of the basis for this calculation, and some possible additions to the list, see *infra* note 276.

160. See *Gasser Chair Co. v. Infanti Chair Mfg. Corp.*, No. 88 Civ. 3931, 1996 WL 370162, at *12 (E.D.N.Y. June 28, 1996) (design of chair), *vacated*, 1996 WL 455579 (Fed. Cir. Aug. 1, 1996) (vacating judgment and remanding to the district court because the terms of the injunction did not adequately identify the enjoined products); *Krueger Int'l, Inc. v. Nightingale Inc.*, 915 F. Supp. 595, 612 (S.D.N.Y. 1996) (design of metal-frame stacking chair); *Adler, Inc. v. World Bazaars, Inc.*, 897 F. Supp. 92, 96-97 (S.D.N.Y. 1995) (appearance of Christmas tree ornament); *Kompan A.S. v. Park Structures, Inc.*, 890 F. Supp. 1167, 1174 (N.D.N.Y. 1995) (configuration of playground equipment); *Tough Traveler, Inc. v. Outbound Prods.*, No. 94-CV-449, Memorandum Decision and Order at 4 (N.D.N.Y. Sept. 23, 1994) (overall appearance of child carrier) (on file with author), *rev'd on other grounds*, 60 F.3d 964 (2d Cir. 1995); see also *Banff Ltd. v. Limited, Inc.*, 869 F. Supp. 1103, 1116 (S.D.N.Y. 1994) (denying defendant's motion for summary judgment on question of whether sweater design inherently distinctive), *later proceeding*, *Banff Ltd. v. Express, Inc.*, 921 F. Supp. 1065, 1071 (S.D.N.Y. 1995) (setting aside jury verdict in favor of plaintiff and granting defendant's renewed motion for judgment as a matter of law on question of inherent distinctiveness in light of *Knitwaves*); *Knitwaves, Inc. v. Lollytogs Ltd.*, 92 Civ. 6285 (JSM), Ruling from the Bench (Sept. 1, 1992) (design of sweater) (copy of transcript on file with author), *rev'd*, 71 F.3d 996 (2d Cir. 1995). In addition, one district court in the Second Circuit has found an inherently distinctive trade dress where that trade dress consisted of the composite impression conveyed by the product design and its packaging. See *Fun-Damental Too, Ltd. v. Gemmy Indus.*, No. 96 Civ. 1103, 1996 WL 125641, at *7-9 (S.D.N.Y. Mar. 21, 1996) (assessing distinctiveness of novelty bank trade dress under *Abercrombie*).

161. 71 F.3d 996 (2d Cir. 1995).

sess the inherent distinctiveness of packaging.¹⁶²

D. *A Distinction between the Test Used for Product Design and That Used for Packaging*

1. Distinction Justified

The first Third Circuit case to address the distinction between product design and product packaging, *Duraco Products v. Joy Plastic Enterprises*,¹⁶³ involved a claim of trade dress infringement by manufacturers of plastic planters in the shape of Grecian urns. The plaintiff had failed to prove secondary meaning and thus relied on a claim of inherent distinctiveness to pursue its trade dress cause of action.¹⁶⁴ The Third Circuit, while accepting *Two Pesos* as an

162. See *id.* at 1007-09, 1012-13; see also *Herbko Int'l, Inc. v. Gemmy Indus.*, 916 F. Supp. 322, 328 (S.D.N.Y. 1996) ("In a product design claim, the traditional trademark and trade dress analysis (which requires determining whether the mark or dress is generic, descriptive, suggestive, or arbitrary or fanciful) does not apply."). The two cases decided after *Knitwaves* are *Krueger* and *Gasser*. In *Krueger*, the District Court for the Southern District of New York declined to apply *Knitwaves* and found an inherently distinctive product configuration under the *Seabrook* test. See *Krueger*, 915 F. Supp. at 607; *infra* note 241 (discussing *Krueger* opinion). In *Gasser*, the court did not identify which test it was applying. See *Gasser*, 1996 WL 370162, at *12. The five pre-*Knitwaves* decisions include the district court decisions in *Knitwaves* (reversed by the Second Circuit) and in *Banff* (where the jury verdict in favor of plaintiff was set aside after the *Knitwaves* opinion was handed down by the Second Circuit). The first indication of real analysis in the Second Circuit of the continuing usefulness of *Abercrombie* came in a district court decision of Judge Kaplan, see *Mulberry Thai Silks, Inc. v. K & K Neckwear, Inc.*, 897 F. Supp. 789, 793 (S.D.N.Y. 1995), where he noted that "subsequent to *Two Pesos*, [the Second Circuit] has applied the *Abercrombie* typology to the determination of inherent distinctiveness in a packaging trade dress case, but it has not yet considered the issue in the context of a product design or configuration case." See *Paddington Corp. v. Attiki Importers & Distribs., Inc.*, 996 F.2d 577, 583-84 (2d Cir. 1993) (applying *Abercrombie* to packaging). Eventually, having declined to consider the question in *Tough Traveler*, and applying *Abercrombie* without extended discussion in *Milstein*, see *Mulberry Thai Silks*, 897 F. Supp at 796, the Second Circuit, in *Knitwaves*, accepted that "*Abercrombie* [made] little sense when applied to product features." *Knitwaves*, 71 F.3d at 1007. The Second Circuit has drawn the distinction between packaging and product configuration without explicitly questioning the general applicability of *Two Pesos* to product configurations, and has implicitly accepted the possibility of inherently distinctive product configurations. See *infra* text accompanying note 249.

163. 40 F.3d 1431 (3d Cir. 1994).

164. See *id.* at 1437. The district court had rejected the claim not only on the grounds of lack of distinctiveness (finding the dress descriptive under *Abercrombie*), but also on the grounds of functionality (despite evidence of several other designs that could compete effectively in the market) and lack of likelihood of confusion (because "consumers are disinterested in the identity of the manufacturer" and there was "no evidence of actual consumer confusion"). See *id.* On the last point, a trade dress claim extends beyond confusion as to the identity of the manufacturer. See 15 U.S.C. § 1125(a) (1994); *supra* note 18. And lack of actual confusion, while tending in the defendant's favor, should not be

endorsement of inherently distinctive product configurations, felt free to distinguish between product packaging and product configuration because the Supreme Court did not define what makes a trade dress inherently distinctive.¹⁶⁵ In *Knitwaves*, the Second Circuit adopted the same reading of *Two Pesos*, namely, that *Two Pesos* merely decided that if a trade dress is inherently distinctive, it will be protected without secondary meaning.¹⁶⁶

Both the Second and Third Circuits built the distinction between the test for packaging and that for product design on a variety of rationales already canvassed by those supporting an absolute secondary meaning requirement for all product configurations.¹⁶⁷ In particular, neither court found the generic-descriptive-suggestive-arbitrary-fanciful categories outlined in *Abercrombie*, which the Fifth Circuit had applied to the trade dress of the packaging for garden products in *Chevron*, helpful in product configuration cases. In product configuration cases, unlike those involving product packaging,¹⁶⁸ there could be no relationship between the mark and the product which comprised the mark.¹⁶⁹ Nor did they feel constrained by *Two Pesos* to

determinative of a claim for injunctive relief. See *Allied Mktg. Group, Inc. v. CDL Mktg., Inc.*, 878 F.2d 806, 813 (5th Cir. 1989) ("Although evidence of actual confusion on the part of consumers 'is patently the best evidence of likelihood of confusion,' it is not necessary to demonstrate actual confusion in order to prevail on a trade dress infringement claim." (quoting *Chevron Chem. Co. v. Voluntary Purchasing Group, Inc.*, 659 F.2d 695, 704 (Former 5th Cir. 1981)). The Third Circuit did not, however, reach any of these issues and rested its decision on a lack of distinctiveness.

165. See *Duraco*, 40 F.3d at 1445.

166. See *Knitwaves*, 71 F.3d at 1007 ("The *Two Pesos* decision left this circuit with the task of determining what it means for trade dress to be 'inherently distinctive.'").

167. See *supra* Part IV(C)(1).

168. Both courts stressed that the traditional analysis was capable of efficacious application to product packaging. See *Knitwaves*, 71 F.3d at 1007; *Duraco*, 40 F.3d at 1441 n.8. A court in the Third Circuit has since applied *Abercrombie* to a packaging trade dress claim. See *Sweetzel, Inc. v. Hawk Hill Cookies, Inc.*, No. Civ. A 95-2632, 1995 WL 550585, at *7 (E.D. Pa. Sept. 14, 1995).

169. See *Duraco*, 40 F.3d at 1441 ("The very basis for the trademark taxonomy—the descriptive relationship between the mark and the product, along with the degree to which the mark describes the product—is unsuited for application to the product itself."); *id.* at 1434 ("[T]raditional trade dress doctrine does not 'fit' a product configuration case because unlike product packaging, a product configuration differs fundamentally from a product's trademark, insofar as it is not a symbol according to which one can relate the signifier (the trademark, or perhaps the packaging) to the signified (the product)."); *id.* at 1440-41 ("Being constitutive of the product itself and thus having no such dialectical relationship to the product, the product's configuration cannot be said to be 'suggestive' or 'descriptive' of the product, or 'arbitrary' or 'fanciful' in relation to it."); *Knitwaves*, 71 F.3d at 1007-08 (2d Cir. 1995) (citing *Duraco*); see also *Versa Prods. Co. v. Bifold Co.*, 50 F.3d 189, 198 (3d Cir. 1995) (noting that *Abercrombie* standard is improper for product configuration trade dress cases). The *Stuart Hall* court rejected this analysis, arguing that "because a product's trade dress is not the entire product itself, but specific features of

find otherwise. As the *Duraco* court explained:

Although *Two Pesos* made extensive reference to the discrete trademark categories [outlined in *Abercrombie*], that decision does not foreclose our refusal to embrace the trademark distinctiveness taxonomy in product configuration cases. In *Two Pesos* the Supreme Court specifically stated that the sole issue before it was whether secondary meaning must be proven for an inherently distinctive trade dress *vel non*, and hence the applicability of the *Abercrombie & Fitch* classifications to trade dress was not at issue.¹⁷⁰

These courts have thus viewed the Supreme Court's endorsement of *Chevron* as limited to the Fifth Circuit's holding that trade dress could be inherently distinctive, and not the particular test adopted in *Chevron* for what constitutes inherently distinctive trade dress. Moreover, both *Chevron* and *Two Pesos* concerned product packaging as opposed to product design.

In addition to arguments challenging the workability of the *Chevron/Abercrombie* test, the *Duraco* court supported its distinction

the product . . . we find no difficulty in looking at a specific feature of a product and determining whether and to what degree that feature is dictated by the nature of the product." *Stuart Hall Co. v. Ampad Corp.*, 51 F.3d 780, 788 (8th Cir. 1995). This defense of *Abercrombie* appears both to infuse functionality thinking into the distinctiveness analysis, and to ignore the truism that trade dress is the overall appearance of an article. See *infra* note 334.

170. *Duraco*, 40 F.3d at 1442 (internal citations omitted). The interpretation of *Two Pesos* by the Court of Appeals for the Second Circuit in *Knitwaves* has not met with universal acceptance by the district courts in that circuit. In *Krueger International, Inc. v. Nightingale Inc.*, 915 F. Supp. 595, 602 (S.D.N.Y. 1996), Judge Sotomayor concluded that "*Two Pesos* was clearly a case of product design and it expressly approved the application of the *Abercrombie* classifications to the design of a Mexican restaurant chain." *Id.*; cf. *id.* at 603 (suggesting that "the Supreme Court explicitly approved the application of the *Chevron* test to product designs in its decision in *Two Pesos*"). Although Judge Sotomayor had expressed doubts about the efficacy of applying *Abercrombie* to product design, she acknowledged the force of the argument advanced by the Eighth Circuit that "the Supreme Court has not authorized us to abandon *Abercrombie*, no matter how much difficulty it causes." *Id.* at 602; see also *Pebble Beach Co. v. Tour 18 I, Ltd.*, 936 F. Supp. 1299, 1343 n.39 (S.D. Tex. 1996) (finding merit in *Duraco*'s distinction between packaging and product design, but applying *Abercrombie* to product design because reading *Two Pesos* to endorse that approach). The Second Circuit's interpretation appears more consistent both with the question presented to the Supreme Court in *Two Pesos* and with the Supreme Court's opinion itself. Indeed, Judge Sotomayor eventually applied *Seabrook* to the trade dress at issue. She did, however, reject the line drawn by the Court of Appeals in *Knitwaves* between product packaging and product design as "not clearly address[ing] the standards in this area as set by the Supreme Court." *Krueger*, 915 F. Supp. at 601; see also *id.* at 602 ("[T]he entire thrust of *Two Pesos* was to unify the standards for trademark and trade dress, not to balkanize this complex field into yet more subcategories. I agree with the Eighth Circuit's conclusion that the Supreme Court envisions trade dress as a 'single concept' with trademark law requiring a single test for inherent distinctiveness.").

with other arguments reminiscent of those advanced by proponents of an absolute secondary meaning requirement: First, the *Duraco* court suggested that, if compelled to apply the classic trademark taxonomy, it would view product configurations as no more than descriptive of the product because they are identical with it.¹⁷¹ Second, the range of alternative product configurations was finite, as opposed to the limitless range of possibilities with packaging.¹⁷² Third, the relative likelihood that a product configuration, as opposed to packaging, would serve as a source-identifier for consumers was small.¹⁷³

The Second Circuit alluded to many of the same arguments as did the *Duraco* court.¹⁷⁴ In addition, it concluded that the *Chev-*

171. See *Duraco*, 40 F.3d at 1441.

172. See *id.* at 1448 ("Product packaging designs, like trademarks, often share membership in a practically inexhaustible set of distinct but approximately equivalent variations A product configuration, contrariwise, commonly has finite competitive variations that, on the whole, are equally acceptable to consumers."); see also *Paddington Corp. v. Attiki Importers & Distribs., Inc.*, 996 F.2d 577, 583 (2d Cir. 1993) ("Since the choices that a producer has for packaging its products are . . . almost unlimited, typically a trade dress will be arbitrary or fanciful, and thus inherently distinctive."); *Banff Ltd. v. Limited, Inc.*, 869 F. Supp. 1103, 1115 (S.D.N.Y. 1994) (citing *Paddington*), later proceeding, *Banff Ltd. v. Express, Inc.*, 921 F. Supp. 1065 (S.D.N.Y. 1995). The *Duraco* court drew the descriptiveness conclusion and the analysis of alternatives together by attempting to recraft the entire distinctiveness spectrum in terms of the competitive effect of the number of alternatives left from a finite number of possibilities. See *Duraco*, 40 F.3d at 1442; cf. *Dratler, supra* note 8, at 951-52 (proposing alternatives-based test for distinctiveness).

173. See *Duraco*, 40 F.3d at 1448 ("[A] consumer is substantially more likely to trust a product's packaging rather than its configuration as an indicium of source."); see also *Devan Designs Inc. v. Palliser Furniture Corp.*, 25 U.S.P.Q.2d (BNA) 1991, 1996 (M.D.N.C. 1992) ("As a practical matter . . . it is less common for consumers to recognize the design of a product as an indication of source. Product features are more likely to be seen merely as utilitarian or ornamental aspects of the goods." (citation omitted)), *aff'd*, 998 F.2d 1008 (4th Cir. 1993); RESTATEMENT, *supra* note 1, § 16 cmt. b (same). The *Duraco* court also characterized this consideration in terms of consumer motivation:

[I]nsofar as consumer motivation to purchase a product will much more likely be predicated on an appreciation of a product's features than on an appreciation of a product's name . . . one cannot automatically conclude from a product feature or configuration . . . that, to a consumer, it functions primarily to denote the product's source [A] product configuration can not generally give rise to a . . . presumption [of consumer association] as consumers usually appreciate a product's configuration for its contribution to the inherent appeal of the product, not . . . its signifying function.

Duraco, 40 F.3d at 1441. Consumer motivation should not, however, be relevant to distinctiveness. See *infra* note 208.

174. See *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996, 1007-08 (2d Cir. 1995); see also *EFS Mktg. v. Russ Berrie & Co.*, 76 F.3d 487, 491 (2d Cir. 1996) ("In *Knitwaves*, . . . we explained that product-configuration trade dresses are less likely than packaging-configuration dresses to serve the source-identification function that is a prerequisite to

ron/Abercrombie methodology afforded broad protection without what the court regarded as an appropriate inquiry into the intention of the producer in adopting the product shape in question:

Not only does the classification of marks into “generic,” “descriptive,” “suggestive,” or “arbitrary or fanciful” make little sense when applied to product features, but it would have the unwelcome, and likely unintended, result of treating a class of product features as ‘inherently distinctive,’ and thus eligible for trade dress protection, even though they were never intended to serve a source-identifying function.¹⁷⁵

As discussed below, the intent of the producer in adopting a mark to identify goods is (and should be) neither sufficient nor necessary to establish trademark rights. Trademark rights reflect consumer association, not producer intent.

2. The Tests Articulated: *Duraco* and *Knitwaves*

Having justified a different test for the inherent distinctiveness of product configurations, each court had to develop one. Existing Second and Third Circuit law was of no assistance, because prior to *Two Pesos* both courts denied the possibility of inherently distinctive trade dress.¹⁷⁶ Each was working with a clean slate.

a. The *Duraco* Test

The *Duraco* court concluded that the circumstances for treating a product configuration as inherently distinctive were

characterized by a high probability that a product configuration serves a virtually exclusively identifying function for consumers—where the concerns over “theft” of an identifying feature or combination or arrangement of features and the cost to an enterprise of gaining and proving secondary meaning outweigh concerns over inhibiting competition, and where consumers are especially likely to perceive a connection between the product’s configuration and its source.¹⁷⁷

Lanham Act protection . . . [Consumers] are more likely to be attracted to the product for the product’s features, rather than for the source-identifying role the features might play.”).

175. *Knitwaves*, 71 F.3d at 1007.

176. See *supra* note 62 and accompanying text.

177. *Duraco*, 40 F.3d at 1448; see also *id.* at 1434 (summarizing the circumstances in which product configurations may be inherently distinctive). The focus on demonstrating a “high probability that a product configuration serves a virtually exclusively identifying function for consumers” can be read two ways, although either interpretation significantly

In attempting to cast these “circumstances” in the form of a workable test, the Third Circuit concluded that “to be inherently distinctive, a product feature or a combination or arrangement of features, *i.e.*, a product configuration, for which Lanham Act protection is sought must be (i) unusual and memorable, (ii) conceptually separable from the product, and (iii) likely to serve primarily as a designator of origin of the product.”¹⁷⁸

i. Unusual and Memorable

To be inherently distinctive under *Duraco*, the product configuration “must partake of a unique, individualized appearance, so that a consumer informed of all the options available in the market could reasonably rely on it to identify a source.”¹⁷⁹ Most tests of inherent distinctiveness consider how “unusual” a feature can be regarded.¹⁸⁰

narrows the scope of inherently distinctive product configurations. It may mean that the product configuration serves that function and few others; or it may mean that *only the product configuration* serves that function. The former interpretation is almost certainly what the court had in mind (*i.e.*, the exclusivity relates to the function, not the product configuration). That is, however, a difficult showing to make because “[m]ost trade dress cases involve such claimed features as shape, color, stitching, and materials, which . . . usually both identify the product’s source and serve some utilitarian or aesthetic purpose.” *Interactive Network, Inc. v. NTN Communications, Inc.*, 875 F. Supp. 1398, 1407 (N.D. Cal. 1995). The latter interpretation, while arguably not what the court was addressing, is an important consideration for some courts in determining distinctiveness of trade dress. In *Ohio Art Co. v. Lewis Galoob Toys, Inc.*, 799 F. Supp. 870, 876-77 (N.D. Ill. 1992), for example, the District Court for the Northern District of Illinois found significant, in concluding that the product shape had not come to signify a single source of supply, the fact that all the advertising for the product prominently exhibited the word mark for the game. The reasoning of the *Duraco* court is also consistent with this analysis and with the approach adopted in several recent cases strongly suggesting that consumers’ purchase decisions are presumptively based upon the name, the packaging and the advertising (including the name) rather than the product shape. *See Duraco*, 40 F.3d at 1448 (“[B]ecause of consumers’ common abundant experience with similar goods being sold in different packaging, a consumer is substantially more likely to trust a product’s packaging, rather than its configuration, as an indicium of source.”); *Versa Prods. Co. v. Bifold Co.*, 50 F.3d 189, 209 (3rd Cir. 1995) (commenting that in a product configuration case “the greatest weight must be given to the primary means by which consumers identify the products’ sources: packaging, trademarks, and advertising”); *see also Dorr-Oliver, Inc. v. Fluid-Quip, Inc.*, 94 F.3d 376, 383 (7th Cir. 1996) (“In the case of a high-priced, single-purchase product, there is generally no likelihood of confusion when the manufacturer’s name is clearly displayed on the product.”); *Dinwoodie*, *supra* note 17, at 42-48 (discussing premise); *Reichman*, *supra* note 30, at 395 (noting that courts were rediscovering “the corrective power of proper labeling” to dispel any confusion that might flow from similarities in product design).

178. *Duraco*, 40 F.3d at 1434; *see id.* at 1448-49. The *Duraco* court found the plaintiff’s urns not to be inherently distinctive, because they failed the second and third elements of the test. *See id.* at 1452.

179. *Id.* at 1449.

180. Any distinctiveness test that focuses on the “unusual or memorable” aspect of the

Seabrook, which mandates consideration of whether a shape or feature is "unique or unusual in a particular field," does so by its very terms, but even courts purporting to apply *Chevron/Abercrombie* routinely consider this factor.¹⁸¹ It is under this rubric that designs

dress brings to mind a threshold measure of creativity lying somewhere between copyright originality and design patent novelty/non-obviousness. Indeed, several copyright decisions post-*Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340 (1991), have adverted to the unusual or unique nature of works of authorship claimed to be protected by copyright. See, e.g., *BellSouth Adver. & Publ'g Corp. v. Donnelley Info. Publ'g, Inc.*, 999 F.2d 1436, 1442 n.13 (11th Cir. 1993) (noting that plaintiff did not deviate from typical arrangement). The evidence used to establish the "unusual" nature of the design may approximate that used in demonstrating novelty and non-obviousness in a design patent application. See *infra* note 356. An assessment of the "unusual" nature of the design in the trademark context is, however, intended to appraise likely consumer response, not the level of authorial creativity. Distinctiveness for trade dress purposes will not be negated merely because the development of such a design could have been anticipated by other producers or because it had previously been used by others. See, e.g., *Manhattan Indus. v. Sweater Bee by Banff, Ltd.*, 627 F.2d 628, 630-31 (2d Cir. 1980) (recognizing trademark rights in mark abandoned by one company and immediately adopted for same goods by unrelated company); see also *supra* note 35 (discussing adoption of public domain designs). But cf. *L. & J.G. Stickley, Inc. v. Canal Dover Furniture Co.*, 892 F. Supp. 413, 423 n.14 (N.D.N.Y. 1995) (recognizing trade dress rights in design of furniture line notwithstanding that designs had at one time been in the public domain), *rev'd*, 79 F.3d 258, 263 (2d Cir. 1996) (holding that product features of exact reproductions of historical designs not distinctive because not clear that consumers associated design with plaintiff, rather than with maker of the originals). Applicants for a design patent, on the other hand, must show that the design was novel; the design cannot previously have been known to or used by others in the United States. See 35 U.S.C. § 102 (1994) (setting out novelty standard). The nonobviousness requirement also imposes upon design patent applicants the obligation to show that the design was not obvious, at the time it was made, to a designer of ordinary skill. See *id.* § 103; *In re Nalbandian*, 661 F.2d 1214, 1216 (C.C.P.A. 1981) (deciding that design patent's obviousness should be determined from vantage point of designer of ordinary capability who designs articles of the type presented in application). Copyright protection for design features that borrow from pre-existing designs is also constrained. See 17 U.S.C. § 103(a) (voiding copyright protection for any part of a work that unlawfully uses pre-existing material); *id.* § 103(b) (extending protection only to designer's incremental original contribution); see also *supra* note 35 (discussing distinctiveness of adopted public domain designs).

181. See, e.g., *Mana Prods. v. Columbia Cosmetics Mfg.*, 858 F. Supp. 361, 367 (E.D.N.Y. 1994) (finding that colors or color combinations of plaintiff's compacts do not appear sufficiently unusual to produce a distinct association in the minds of consumers), *aff'd*, 65 F.3d 1063, 1070 (2d Cir. 1995) ("In the compact industry, nothing about a rectangular or square shape or black color is 'striking, unusual, or otherwise likely to differentiate the products of a particular producer . . .'" (quoting RESTATEMENT, *supra* note 1, § 13 cmt. d)); see also *Aromatique, Inc. v. Gold Seal, Inc.*, 28 F.3d 863, 869-70 (8th Cir. 1994) (plaintiff's pillow-shaped cellophane packages were not inherently distinctive because commonplace); *Computer Care v. Service Sys. Enters.*, 982 F.2d 1063, 1069 (7th Cir. 1992) ("[E]vidence of uniqueness supports a finding that a trade dress is inherently distinctive." (citation omitted)); *Fundex Inc. v. Imperial Toy Corp.*, 26 U.S.P.Q.2d (BNA) 1061, 1063-64 (S.D. Ind. 1992) (evidence that, apart from the defendant's product, plaintiff's trade dress was unique in the jump rope market supported a finding of inherent distinctiveness). Thus, in *Krueger International, Inc. v. Nightingale Inc.*, 915 F. Supp. 595, 603-04 (S.D.N.Y. 1996), Judge Sotomayor was able to reconcile *Abercrombie*-based case

customary in the industry cannot be inherently distinctive.

Although the "memorable" nature of the feature would not appear to add very much to the analysis, in predicting whether a shape or feature is likely to operate as a source identifier with consumers it surely is relevant that the shape is likely to register with the consumer.¹⁸² By any standard and in any context, a mark failing to do so is unlikely to be considered distinctive.

The Eighth Circuit, however, in rejecting what it characterized as the *Duraco* test of "memorability," has since argued that the focus of the *Duraco* court's analysis appears to be on a nexus central to acquired distinctiveness rather than inherent distinctiveness.¹⁸³ In particular, the Eighth Circuit asserted that courts do not look at the impact of a feature on consumers under either *Seabrook* or *Chevron*, or in assessing word marks.¹⁸⁴ Rather, under the *Abercrombie* test, a court focuses "on the arbitrariness of the trade dress and its relevance to the product," and under the *Seabrook* test "on a comparison

law in the Second Circuit with the *Seabrook* test by reference to this common inquiry. Courts also look to the unusual nature of the mark in assessing the distinctiveness of word marks. See, e.g., *W.W.W. Pharm. Co. v. Gillette Co.*, 984 F.2d 567, 572 (2d Cir. 1993) ("Sportstick" is not so distinct and unusual to be fanciful, nor does it sufficiently evoke the characteristics of the product to be descriptive."); cf. *Fisons Horticulture, Inc. v. Vigoro Indus.*, 30 F.3d 466, 478-79 (3d Cir. 1994) ("The significant factor is not whether the word itself is common, but whether the way the word is used in a particular context is unique enough to warrant trademark protection." (quoting *Wynn Oil Co. v. Thomas*, 839 F.2d 1183, 1190 n.4 (6th Cir. 1988))).

182. See *Stuart Hall Co. v. Ampad Corp.*, 31 U.S.P.Q.2d (BNA) 1468, 1470 (W.D. Mo. 1994) (to be inherently distinctive, the "trade dress must have sufficient strength of visual impact to impress itself on the mind of a consumer, and thus be subject to recall when the consumer next enters the market"), *rev'd*, 51 F.3d 780, 784 (8th Cir. 1995). The district court cited as examples: "Durante's nose, Holmes' mustache, Chief Judge Arnold's bow ties, and Congressman Leach's sweaters." *Stuart Hall*, 31 U.S.P.Q.2d (BNA) at 1470 n.1. Nor was the *Duraco* court the first to consider the "eye-catching" or memorable nature of trade dress while conducting an analysis of inherent distinctiveness. See, e.g., *Days-Ease Home Prods.*, 197 U.S.P.Q. (BNA) 566, 568 (T.T.A.B. 1977) (finding that shape of container of liquid drain cleaner inherently distinctive when, in addition to being "unique" or "different," it was "extremely eye-catching").

183. See *Stuart Hall*, 51 F.3d at 786-88.

184. See *id.* at 786 ("The question [under *Abercrombie* is] not . . . whether consumers associate the design with its source."); *id.* (noting "*Abercrombie*'s emphasis on the relation of the product's trademark or trade dress to the product, rather than on the relation of the consumer to the product"); *id.* at 786-87 ("The *Seabrook* test focuses on a comparison of plaintiff's trade dress to others in the same class of goods, not on the trade dress's impact on consumers."); *id.* at 787 ("None of these tests [*Chevron* or *Seabrook*] in any combination examines the trade dress's impact on consumers."); see also *Reese Prods. v. Valley Indus.*, 50 Pat. Trademark & Copyright J. (BNA) 228 (D. Ind. May 15, 1995) ("[W]hen deciding whether trade dress is inherently distinctive, the court must compare the item with others in the same field, *not* its impact on consumers.").

of the trade dress with others in the same field.”¹⁸⁵

To restrict any consideration of the effect on consumers to an analysis of secondary meaning is flawed in two ways. First, a refusal to consider the feature-consumer nexus ignores the long-term purpose of product comparison, namely, to assist in predicting impact on consumers. The *Abercrombie* and *Seabrook* tests of distinctiveness seek not to ascertain a level of abstract novelty, but through examination of the “feature-product” or “product-other product” relationship to estimate the degree of differentiation that the product feature can be expected to provide. These tests of distinctiveness are merely vehicles in the attempt to predict the likelihood of source-identification.¹⁸⁶ Contrary to the assertions of the Eighth Circuit, courts ultimately do inquire of the trade dress’s impact on consumers, but do so indirectly and for a predictive purpose, by considering these series of other subsidiary relations.¹⁸⁷

Second, the *Stuart Hall* court suggested that proving inherent distinctiveness and proving secondary meaning are unrelated en-

185. *Stuart Hall*, 51 F.3d at 787.

186. See *Days-Ease Home Prods.*, 197 U.S.P.Q. (BNA) at 568 (“The question of ‘inherently distinctive’ obviously must be determined in relation to the goods for which registration is sought, the uniqueness of the container’s configuration in this field, which would condition the reaction of purchasers to the shape, and *what would be the anticipated reaction of the average purchaser to this shape.*” (emphasis added)); see also RESTATEMENT, *supra* note 1, § 13 cmt. c (analyzing categories of distinctiveness by reference to whether consumers are more or less likely to perceive a term in its ordinary lexicographic sense rather than as a symbol of identification); *id.* § 13 cmt. d (“A symbol or graphic design is not inherently distinctive unless the nature of the designation and the manner of its use make it likely that prospective purchasers will perceive the designation as an indication of source.”); 1 MCCARTHY, *supra* note 1, § 8.02[4], at 8-23 (suggesting that *Seabrook* represents “ways to ask whether the design, shape, or combination of elements is so unique, unusual or unexpected in this market that *one can assume* without proof that it will automatically be perceived by customers as an indicia [sic] of origin” (emphasis added)). Indeed, even the test of inherent distinctiveness developed by the *Duraco* court, and criticized by this Article, is soundly based on likely consumer response. See *Duraco Prods. v. Joy Plastic Enters.*, 40 F.3d 1431, 1448 (3d Cir. 1994) (restricting inherent distinctiveness of product configurations because as a result of “consumers’ common abundant experience with similar goods being sold in different packaging, a consumer is substantially more likely to trust a product’s packaging, rather than its configuration, as an indicium of source”).

187. Juxtaposing the alternative term of acquired distinctiveness with that of inherent distinctiveness reveals this role more clearly, as might conceiving of inherent distinctiveness as presumed distinctiveness. See 2 MCCARTHY, *supra* note 1, § 15.01[1], at 15-4 (“In a sense, [inherently distinctive marks] are irrebuttably presumed to have achieved customer recognition and association immediately upon adoption and use.”); cf. *Romm Art Creations Ltd. v. Simcha Int’l, Inc.*, 786 F. Supp. 1126, 1136 (E.D.N.Y. 1992) (“An inherently distinctive trade dress is proof of secondary meaning.” (citations omitted)).

deavors, and that source-identification is relevant only to the latter.¹⁸⁸ This is incorrect. Rather, I would argue that they represent two *evidentiary* routes to the same conclusion, one based upon measured performance and the other on anticipated or predicted performance.¹⁸⁹ The Eighth Circuit accurately identified the change effected by *Two Pesos* (a change acknowledged by *Duraco*) as one from actual consumer recognition (i.e., a requirement of secondary meaning) to likely *or* actual consumer recognition.¹⁹⁰ This change in the means of measuring distinctiveness is what the Supreme Court's elimination

188. See *Stuart Hall*, 51 F.3d at 787 ("The requirement of source-identification applies not to whether a trade dress is inherently distinctive, but to whether it has secondary meaning."); see also *Ark Plas Prods. v. Value Plastics*, 913 F. Supp. 1246, 1252 (W.D. Ark. 1996) (defining inherent distinctiveness by reference to tenuousness of design to nature of product, and secondary meaning by reference to consumer association); cf. *Winning Ways, Inc. v. Holloway Sportswear, Inc.*, 913 F. Supp. 1454, 1463 n.5 (D. Kan. 1996) (noting that the language of the *Duraco* and *Knitwaves* tests closely resembles the standard for secondary meaning). Such a distinction has no basis in trademark or unfair competition law, and miscomprehends the respective roles of inherent distinctiveness and secondary meaning. Nor does the Lanham Act provide support for the distinction the Eighth Circuit suggests. Whether to be registered as inherently distinctive or, under section 2(f) of the Lanham Act, 15 U.S.C. § 1052(f) (1994), by virtue of having acquired distinctiveness (i.e., achieved secondary meaning), the word or symbol must "identify and distinguish" goods from those manufactured or sold by others "and indicate the source of the goods." *Id.* § 1127 (definition of "trademark"). These same standards for registrability govern protectability under section 43(a). See *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768, 784 (1992) (Stevens, J., concurring); *supra* note 17.

189. See *Duraco*, 40 F.3d at 1439 ("[T]he Supreme Court in *Two Pesos* used 'distinctive' in a dual sense, meaning either inherently distinctive or having acquired distinctiveness through secondary meaning." (citations omitted)).

190. See *Stuart Hall*, 51 F.3d at 788. Contrary to the claims of the *Stuart Hall* court, according protection on the basis of likely consumer recognition does not undermine *Two Pesos*. It more fully articulates the scope of *Two Pesos*'s liberalization of the proof of distinctiveness. However, although the *likely* consumer recognition at the root of inherent distinctiveness is less burdensome as a means of establishing distinctiveness, any infringement analysis will also consider the commercial strength of the mark in the marketplace (i.e., secondary meaning). Categorization as arbitrary, fanciful or suggestive is sufficient to *establish* protection for a mark; the strength of a mark and the scope of its protection will depend not only upon conceptual distinctiveness, but also upon its distinctiveness in the marketplace. See *AmBrit, Inc. v. Kraft, Inc.*, 812 F.2d 1531, 1539 (11th Cir. 1986) ("A finding of inherent distinctiveness indicates that the . . . trade dress will be protected, but the appropriate degree of protection is determined by examining a number of factors that establish the standing of the trade dress in the marketplace . . ."); *McGregor-Doniger, Inc. v. Drizzle, Inc.*, 599 F.2d 1126, 1131 (2d Cir. 1979). Nor should the question of whether a design is likely to identify a source be mistaken with the lesser standard of whether it is "capable" of distinguishing goods from those of others, which provides the basis for registration of a mark on the Supplemental Register. Cf. *In re Minnesota Mining & Mfg. Co.*, 335 F.2d 836, 840 (C.C.P.A. 1964) (noting difference between what a mark is likely to do to a purchaser and what it is capable of doing). For the advantages of registration on the Supplemental Register, see 2 MCCARTHY, *supra* note 1, § 19.09[1][d].

of a secondary meaning requirement should achieve.¹⁹¹

ii. *Conceptual Separability*

This second factor of the *Duraco* analysis may by its terms evoke copyright analysis,¹⁹² but the Third Circuit's explanation reveals nothing more than a modified version of the doctrine of mere ornamentality.¹⁹³ Under this rule, if a design is perceived by the purchasing public as solely or merely ornamental, it cannot be a trademark, although incidental ornamentality does not exclude the mark from protection.¹⁹⁴ The court may have been suggesting that the requirement of conceptual separability is not satisfied by features that are recognizable to the consumer not as an indicium of source, but rather as a mere component of the product. The rule (of which the mere ornamentality rule is itself a particularized application) that to be protectable the dress or mark must function *as a dress or mark*, however, already addresses that possibility.¹⁹⁵ And this is a wholly

191. See *Duraco*, 40 F.3d at 1450 ("The inquiry here does not duplicate that employed for secondary meaning; instead of focusing on consumers' actually acquired mental associations, the inquiry focuses on whether a consumer would likely perceive the feature or combination or arrangement of features as something that renders the product more desirable regardless of the source of the product, or primarily as a signifier of the product's source.").

192. See 17 U.S.C. § 101 (1994) (defining "pictorial, graphic, or sculptural works"); H.R. REP. NO. 94-1476, at 55 (1976) ("Unless the shape of . . . [the] industrial product contains some element that, physically or conceptually, can be identified as separable from the utilitarian aspects of that article, the design would not be copyrighted . . ."). See generally Shira Perlmutter, *Conceptual Separability and Copyright in the Designs of Useful Articles*, 37 J. COPYRIGHT SOC'Y 339 (1990) (analyzing the copyright test of conceptual separability).

193. See *Duraco*, 40 F.3d at 1449 ("To be conceptually separable, the product configuration must be recognizable by the consumer as an indicium of source, rather than a decorative symbol or pattern . . ." (citation omitted)).

194. See 1 MCCARTHY, *supra* note 1, § 7.06, at 7-33; see also Dratler, *supra* note 8, at 950 (explaining doctrine). "If customers perceive a design as not only attractive, but as an indicator of source, then it is a trademark." 1 MCCARTHY, *supra* note 1, § 7.06, at 7-34. As with the first *Duraco* factor (the "unusual" nature of a symbol or design), the *Restatement* includes consideration of whether a design is likely to be viewed as "mere ornamentation" rather than as a symbol of identification as part of the inherent distinctiveness analysis. See *RESTATEMENT*, *supra* note 1, § 13 cmt. d.

195. In analyzing the urns at issue, the court found a lack of conceptual separability based upon the fact that "[t]he features of the Grecian Classics for which *Duraco* [sought] protection [were] designed to achieve the goal of having the planter appear as if constructed of marble or stone, and thus constitute[d] part and parcel of the overall product." *Duraco*, 40 F.3d at 1452. That reasoning is reminiscent of early case law which suggested that a product configuration could not itself be the product's trade dress indicating the source of the product. Indeed, the case cited by the court, *Davis v. Davis*, 27 F. 490, 492 (C.C. Mass. 1886), stands for that proposition. Exactly how close the parallel is depends upon how the product, from which the design features must be separable, is defined. See

appropriate consideration, focusing as it does on likely consumer response to the product design. *Duraco* appears to go further, however, stating that “the configuration for which protection is sought must not appear to the consumer as a mere component, or the essence of the product gestalt, but rather must appear as something attached (in a conceptual sense) to function in actuality as a source designator.”¹⁹⁶

This is a requirement that has no basis in modern trademark law.¹⁹⁷ For over two decades, federal courts have acknowledged the capacity of product features both to comprise the product and to identify the source.¹⁹⁸ A feature that is a component of the product

Duraco, 40 F.3d at 1452 n.13. However, if (as was the case in *Duraco*) the court defines the product category to be analyzed as the particular product itself, no design will ever be found to be inherently distinctive. Cf. *In re DC Comics, Inc.*, 689 F.2d 1042, 1045 (C.C.P.A. 1982) (“[Applicant] cannot be considered to have created a new product category . . . simply by having originated and promoted certain unique characters and products related to them.”); *id.* at 1053 (Nies, J., concurring) (“Competing products in our economy need not be precisely identical.”). The *Seabrook* test also requires a court to identify the relevant product category for the purpose of product comparison. See, e.g., *Turtle Wax, Inc. v. First Brands Corp.*, 781 F. Supp. 1314, 1343 (N.D. Ill. 1991) (adopting Magistrate’s Report) (explaining that before applying the *Seabrook* test, the court must “decide how to define the ‘field’ or ‘class of goods’ to which [plaintiff’s product] belongs”). As the distinctiveness analysis focuses upon consumer association, any product market to be considered should be comprised of those products with which the relevant product is likely to be compared by the consumer. See *id.* (concluding that because consumer will be comparing the package to a wide variety of packages of polishes and other automotive products it is the category of automotive products which comprises the field of goods to which the product belongs and to which court must look in deciding whether trade dress is inherently distinctive).

196. *Duraco*, 40 F.3d at 1449-50.

197. In addition, it would appear to contain a bias against functionalist design in protecting supplementary attached identifying features rather than those integrated within the product gestalt. Indeed, the court’s example of a design feature that would be conceptually separable under the court’s analysis—an “arbitrary carving etched into the back of a chair to identify the source”—reveals just that. See *id.* at 1452. This is precisely what has bedeviled the parallel copyright test, namely a concentration on physical separability to the detriment of integrated design. See Perlmutter, *supra* note 192, at 340-41. Courts have been careful, in applying the functionality exclusion, not to deny trade dress protection merely because a feature is *de facto* functional. See *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1337 (C.C.P.A. 1982) (noting that although the design of a product is *de facto* functional if directed to performance of a function, it is not thereby *de jure* functional and may be legally recognized as an indicator of source). The same thoughtfulness needs to be displayed in assessing distinctiveness.

198. See *Fabrication Enters., Inc. v. Hygenic Corp.*, 64 F.3d 53, 55 (2d Cir. 1995) (“The design of a product may serve at least two purposes. It may identify the source of the product, and it can serve a utilitarian purpose.”); *WSM, Inc. v. Tennessee Sales Co.*, 709 F.2d 1084, 1087 (6th Cir. 1983) (“That an item serves or performs a function does not mean, however, that it may not at the same time be capable of indicating sponsorship or origin where aspects of the item are nonfunctional.” (citation omitted)). Despite this acknowledgment that a product feature may serve two or more roles, one author has re-

may also serve to identify the source of the product,¹⁹⁹ and accordingly this factor should not be used to prevent fact-specific consideration of the peculiarities of each individual case.²⁰⁰ The manner in which consumers perceive product features is as varied as the number of products themselves, and the test for inherent distinctiveness should reflect that fact.

iii. Primarily a Source-Designator

Finally, under *Duraco*, a product configuration for which Lanham Act protection is sought must be "likely to serve primarily as a designator of origin of the product."²⁰¹ This consideration cannot be applied too strictly because "most trade dress cases involve such claimed features as shape, color, stitching, and materials, which . . . usually both identify the product's source and serve some utilitarian or aesthetic purpose."²⁰² The court again clearly intended to be uncompromising in applying this requirement, however, declaring that "if the configuration itself, separate from the product, is likely to serve some substantial purpose other than as a designation of origin—that is, besides to set it apart from other sources' products in

sponded to recent developments by suggesting that product design should be protected under the Lanham Act only if it serves an exclusively source-identifying function. See Groff, *supra* note 141, at 68 (arguing that trade dress protection should be extended to product design only in the "rare instances where the design serves *only* source-identifying purposes"); cf. *Duraco*, 40 F.3d at 1434 (suggesting that the circumstances where a product configuration might be inherently distinctive are "characterized by a high probability that a product configuration serves a *virtually exclusive* identifying function" (emphasis added)).

199. See 1 MCCARTHY, *supra* note 1, § 7.26[5], at 7-152.5 ("The 'merely ornamental' rule is simply a facet of the basic trademark question: is the disputed feature in fact perceived by customers as a trademark or not? Do customers perceive this feature as *mere* attractive ornamentation or *also* as a symbol that identifies and distinguishes a single source?" (emphasis added)).

200. Cf. *In re Swift & Co.*, 223 F.2d 950, 954 (C.C.P.A. 1955) ("Since the line distinguishing between mere ornamentation and ornamentation which is merely an incidental quality of a trade-mark is not always clearly ascertainable, the application of legal principles to fit one situation or the other requires proper reflection upon the impression likely to govern the ordinary purchaser in the market place. For that reason, the merits of each case . . . must be individually and accordingly adjudged.").

201. *Duraco*, 40 F.3d at 1434. Again, the *Restatement* suggests this factor is relevant to the question of inherently distinctive shapes. See RESTATEMENT, *supra* note 1, § 13 cmt. d.

202. *Interactive Networks, Inc. v. NTN Communications, Inc.*, 875 F. Supp. 1398, 1407 (N.D. Cal. 1995). This dual function can be true both of two-dimensional decoration and three-dimensional product shape. See, e.g., *Three Blind Mice Designs Co. v. Cyrk, Inc.*, 892 F. Supp. 303, 311 (D. Mass. 1995) ("Despite its decorative function, the imprint of plaintiff's trademark . . . is widely understood as a designation of source . . .").

consumers' minds—then it cannot be inherently distinctive."²⁰³

The *Duraco* court did not state that such a feature would be less likely to be inherently distinctive, but rather that it *cannot* be inherently distinctive.²⁰⁴ The former would have been a largely unobjectionable assertion. The *Duraco* court was probably correct that, in most cases, a feature's role as something other than source-identifier may give rise to a greater possibility that the same design feature will not operate as a source-identifier. Consumer association will most easily arise or be presumed when a mark carries but a single meaning, or where a descriptive primary meaning is wholly displaced. There is no need, however, for that to be an absolute barrier to inherent distinctiveness. A shape can serve both purposes without diminution in the value of either. As with the court's articulation of its second consideration, this analysis represents a gross oversimplification of the complexity of consumers' purchase decisions.²⁰⁵

In assessing this factor, the court placed great stress on the intent of the product designer in adopting the features at issue, as well as on the motivation for the purchasing decision of consumers (for aesthetic advantages).²⁰⁶ The focus on the producer's intent was used by the *Duraco* court to affirm the judgment against the plaintiff producer: "Abundant and uncontroverted testimony established that Duraco adopted its features to create the appearance of a marble, stone, or cement Grecian or classical-style urn, not to identify itself as the source."²⁰⁷ The intent of the producer is not, however, generally relevant to whether a feature operates as a source-identifier,²⁰⁸ and,

203. *Duraco*, 40 F.3d at 1450.

204. *See id.* ("[I]f the feature . . . is likely to be notably desirable to consumers for some reason other than its function as a source-designator, it cannot be considered inherently distinctive.")

205. *See* Unikel, *supra* note 20, at 335-36:

Consumers generally purchase a particular product for a variety of interrelated reasons It is thus naive to assume that a product's significant features and overall design can serve only one of two polar opposite goals—indication of source or important ingredient in the product's commercial success [I]f indication of source or affiliation is a significant (though not exclusive) feature of a product's design or configuration . . . affording trade dress protection to that design or configuration is necessary to guard against consumers being . . . misled

206. *See Duraco*, 40 F.3d at 1450 (with respect to whether a mark serves primarily as designator of source, "a source's intent in adopting the particular configuration is highly probative"); *cf.* Joan L. Dillon, Two Pesos: *More Interesting for What it Does Not Decide*, 83 TRADEMARK REP. 77, 85 (1993) (defining protectable trade dress as "a combination of elements selected to identify origin, rather than to serve as mere decor").

207. *Duraco*, 40 F.3d at 1452.

208. *See infra* text accompanying notes 220-30. Nor is the motivation of the purchaser

for the reasons outlined below in discussing the “primary intent” test of the *Knitwaves* court,²⁰⁹ consideration of such intent should be avoided in fashioning a test of inherent distinctiveness for product design.

b. The *Knitwaves* Test

While the Second Circuit embraced the reasoning of *Duraco* in support of a distinction between product features and product packaging, it declined to adopt in full the three-part test formulated by the Third Circuit because such a test was “not rooted in the language of the Lanham Act.”²¹⁰ Instead, the Second Circuit in *Knitwaves* concluded that to be inherently distinctive a product feature must be “likely to serve primarily as a designator of origin of the product.”²¹¹ The Court augmented this general standard by excluding from the class of inherently distinctive marks “product features or designs whose primary purposes are likely to be functional or aesthetic.”²¹² Applying this test, the court decided that the plaintiff’s sweater designs were not inherently distinctive: “As *Knitwaves*’ objective in the two sweater designs was primarily aesthetic, the designs were not

relevant as such to the determination of distinctiveness. As Congress recognized in enacting the Trademark Clarification Act of 1984, Pub. L. No. 98-620, § 102, 98 Stat. 3335 (1984), consumer motivation should not be relevant to distinctiveness considerations. See 15 U.S.C. § 1064(3) (1994) (“The primary significance of the registered mark to the relevant public rather than purchaser motivation shall be the test for determining whether the registered mark has become . . . generic . . .”). The question is consumer association, not motivation. See *In re DC Comics, Inc.*, 689 F.2d 1042, 1054 (C.C.P.A. 1982) (Nies, J., concurring). To the extent that consumer motivation reveals likely consumer association, however, it may act as a minor predictor in answering the question of inherent distinctiveness.

209. See *infra* Part IV(D)(2)(b).

210. *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996, 1009 n.6 (2d Cir. 1995).

211. *Id.* at 1008 (citing *Duraco*, 40 F.3d at 1449); see also *EFS Mktg. v. Russ Berrie & Co.*, 76 F.3d 487, 491 (2d Cir. 1996) (“[*Knitwaves* articulated the] standard for an inherently distinctive, product-configuration trade dress; *i.e.*, when assessing the distinctiveness of such a dress, a court should consider ‘whether it is likely to serve primarily as a designator of origin of the product.’” (citations omitted)). Under this general standard alone, the Court of Appeals for the Second Circuit has since noted that the design of exact reproductions of original Gustav Stickley furniture “by definition” cannot primarily designate the manufacturer of the reproduction, and thus cannot be inherently distinctive trade dress. See *L. & J.G. Stickley, Inc. v. Canal Dover Furniture Co.*, 79 F.3d 258, 263 (2d Cir. 1996).

212. *Knitwaves*, 71 F.3d at 1008; see also *Herbko Int’l, Inc. v. Gemmy Indus.*, 916 F. Supp. 322, 328 (S.D.N.Y. 1996) (“[T]he test to determine whether a product qualifies for protection for trade dress inherent in the product’s design is whether the trade dress is ‘likely to serve primarily as a designator of origin of the product,’ as opposed to serving primarily aesthetic purposes.”).

primarily intended as source identification."²¹³ Thus, in the Second Circuit "a plaintiff must do more than demonstrate that the appearance of its product serves some source identifying function. It must demonstrate that the primary purpose behind the design was to identify its product's source."²¹⁴

The Second Circuit's test of primary intent corresponds loosely to the third element of the *Duraco* test. As such, the same criticisms that can be levelled at that element are also applicable to the *Knitwaves* test: a product design can carry both aesthetic and source-identifying meaning;²¹⁵ and, distinctiveness is a measure of the design's effect on consumers.²¹⁶ Indeed, despite its reproach of the Third Circuit test, the Second Circuit also failed to adhere to the text of the Lanham Act, and departed from well-established conceptions of distinctiveness, by transforming a test of consumer association into one of producer intent.²¹⁷ The statutory language protects as trade-

213. *Knitwaves, Inc.*, 71 F.3d at 1009; see also *Grupke v. Linda Lori Sportswear, Inc.*, 921 F. Supp. 987, 996 (E.D.N.Y. 1996) (applying *Knitwaves*, and granting defendant's motion for summary judgment on question of inherent distinctiveness where tee-shirt design held to be "primarily aesthetic" and there was "no evidence that plaintiffs intended their design to identify the source of the tee-shirts"); *Judith Ripka Designs, Ltd. v. Preville*, 935 F. Supp. 237, 257 (S.D.N.Y. 1996) (applying *Knitwaves* and finding jewelry designs not inherently distinctive because primary purpose of design is aesthetic, not source-identifying); *Banff Ltd. v. Express, Inc.*, 921 F. Supp. 1065, 1071 (S.D.N.Y. 1995) (granting defendant's renewed motion for judgment as a matter of law on question of inherent distinctiveness because plaintiff "chose its design primarily for aesthetic reasons" and there was "absolutely no evidence that [plaintiff] chose its design primarily to identify the source of its product"). In both *Knitwaves* and *Banff*, the plaintiff's claim for infringement of copyright in the design of the sweater succeeded. See *Knitwaves*, 71 F.3d at 1005; *Banff*, 921 F. Supp. at 1067. The plaintiff in *Grupke* brought a claim for infringement of the copyright in its tee-shirt design. See *Grupke*, 921 F. Supp. at 990-91 (copyright cause of action not challenged by the primary defendant in its successful motion for summary judgment on the trade dress claim).

214. *Banff*, 921 F. Supp. at 1071 (applying *Knitwaves*) (citation omitted); see *Herbko*, 916 F. Supp. at 328 (citation omitted); see also *Grupke*, 921 F. Supp. at 996 ("[In *Knitwaves*,] the Court of Appeals for the Second Circuit held that trade dress inherent in clothing designs receives protection under the Lanham Act only if 'primarily intended as [a] source identifier.'" (citation omitted)). The district court in *Krueger International, Inc. v. Nightingale Inc.*, 915 F. Supp. 595 (S.D.N.Y. 1996), characterized the *Knitwaves* test as "whether the manufacturer 'used' or 'intended to use' the design to identify the source and distinguish his or her goods." *Id.* at 601-02 (citation omitted). The *Krueger* formulation represents only part, however, of the analysis suggested by the Second Circuit.

215. See *supra* text accompanying notes 197-205.

216. See *supra* text accompanying note 208.

217. Consideration of the intent of the defendant does enter into trademark infringement analysis at several points. First, many courts hold that intentional copying gives rise to a rebuttable presumption (or, at least, an inference) of secondary meaning. See *supra* note 143. Second, while intent to confuse is not essential to a finding of infringement, the

marks any symbols or devices that operate as source identifiers. It is restricted neither to devices that operate primarily to identify source nor to features that are intended to act as source designators.²¹⁸ It is perfectly possible that a design adopted primarily for aesthetic purposes could be likely to identify source if the aesthetic at issue is particularly distinctive.²¹⁹

i. Producer's Intent

An intent-based test (let alone one founded on the "primary" intent of the producer) is inconsistent with both the purpose of the distinctiveness requirement and the language of the Lanham Act, and

intent or good faith of the defendant in copying the claimed trade dress is one of several factors considered in determining likelihood of confusion. See *Polaroid Corp. v. Polaroid Elec. Corp.*, 287 F.2d 492, 495 (2d Cir. 1961) (defendant's good faith in adopting mark relevant to likelihood of confusion); see also RESTATEMENT, *supra* note 1, § 22 (noting that likelihood of confusion may be inferred from defendant's adoption of the trade dress with an intent to cause confusion or to deceive). Some courts have gone further, and will infer likelihood of confusion from mere intentional copying, rather than from an intent to confuse. See, e.g., *Paddington Corp. v. Attiki Importers & Distribs., Inc.*, 996 F.2d 577, 586-87 (2d Cir. 1993) (indicating that a defendant's intentional copying gives rise to a presumption of likely confusion); cf. *Schwinn Bicycle Co. v. Ross Bicycles, Inc.*, 870 F.2d 1176, 1184 (7th Cir. 1989) (explaining that intentional copying may tend to support likelihood of confusion, but does not give rise to a presumption); *American Home Prods. Corp. v. Barr Labs., Inc.*, 834 F.2d 368, 371 (3d Cir. 1987) (same); *Brooks Shoe Mfg. Co. v. Suave Shoe Corp.*, 716 F.2d 854, 859-60 n.13 (11th Cir. 1983) (same). But cf. RESTATEMENT, *supra* note 1, § 22 cmt. c (commenting that likelihood of confusion should not be inferred from intentional copying unless lack of alternative explanation suggests an intent to cause confusion or to deceive); Andrew C. Finch, Comment, *When Imitation Is the Sincerest Form of Flattery: Private Label Products and the Role of Intention in Determining Trade Dress Infringement*, 63 U. CHI. L. REV. 1243, 1244 (1996) (arguing "that courts should not presume a likelihood of confusion from a private label manufacturer's intentional copying of the trade dress of a brand name product").

218. The reference in the statutory definition of a trademark to the "intent" of the trademark owner, included in the *Qualitex* opinion's recital of the definition and quoted by the Second Circuit in *Knitwaves*, is simply a reflection of the expanded grounds upon which a trademark registration application may be based after the Trademark Law Revision Act of 1988. See 15 U.S.C. § 1051(b) (1994) (registration application can be based upon intent to use the mark as well as past use); Trademark Law Revision Act of 1988, Pub. L. No. 100-667, § 134, 102 Stat. 3935, 3946-48 (amending definition of "trademark"); S. REP. NO. 100-515, at 44 (1988), reprinted in 1988 U.S.C.C.A.N. 5577, 5607 (noting amendment of definition of "trademark" to reflect legislation's provision for an intent-to-use application system). It is not clear whether the Second Circuit attached any weight to that term in this context, but given this limited purpose for which it is included in the definition, none should be given. Cf. *Krueger*, 915 F. Supp. at 602-03 ("[A] close reading of *Qualitex* does not support the notion that the 'use or intended use' language of the Lanham Act provides a definition of inherent distinctiveness.").

219. Clearly, certain aesthetic designs do in fact identify source. See, e.g., *Three Blind Mice Designs Co. v. Cyrk, Inc.*, 892 F. Supp. 303, 311 (D. Mass. 1995) ("Despite its decorative function, the imprint of plaintiff's trademark... is widely understood as a designation of source...").

is likely in practice to preclude the possibility of inherently distinctive product appendages).²²⁰ As the Supreme Court recognized over a century ago, trademarks are “often the result of accident, rather than design.”²²¹ Assessment of the intent of the producer thus misconstrues the concept of a trademark.²²² Similarly, and not surprisingly in light of the Supreme Court’s observation, the definition provided by the Lanham Act has at its core merely that the mark “identify and distinguish” particular goods, and the *Restatement* inquires as to the perception (actual or likely) of consumers.²²³ A trademark is defined

220. In articulating its primary intent test, and concentrating on the mental processes of the producer, the Second Circuit repeated the conceptual error into which it has been drawn in determining the scope of copyright protection for the design of useful articles. In that context, the court has conditioned copyright protection upon whether design elements can be identified “as reflecting the designer’s artistic judgement exercised independently of functional influences.” *Brandir Int’l v. Cascade Pac. Lumber Co.*, 834 F.2d 1142, 1145 (2d Cir. 1987) (adopting test suggested in Robert C. Denicola, *Applied Art and Industrial Design: A Suggested Approach to Copyright in Useful Articles*, 67 MINN. L. REV. 707, 741 (1983)). The influences that guided the creation of a useful article do not, however, answer the question posed by the relevant provision (section 101) of the copyright statute—can the artistic features of the work be *identified* separately from and *exist* independently of the utilitarian aspects? See *Brandir*, 834 F.2d at 1152 (Winter, J., dissenting) (concluding that statute requires examination of the article not the process that created it); see also Perlmutter, *supra* note 192, at 372 (“The test’s reliance on the creative process rather than the *result* of that process can be found nowhere in the statutory language, legislative history or judicial interpretation”). Similarly, the intention of the producer is unresponsive to the heart of the Lanham Act’s distinctiveness inquiry, namely whether the mark *identifies* goods and *distinguishes* them from the goods of others. The Lanham Act requires examination of how a mark does behave, or is likely to behave, not of how the producer hopes it will behave. Cf. *International Jensen, Inc. v. Metrosound U.S.A., Inc.*, 4 F.3d 819, 824 (9th Cir. 1993) (“While evidence of a manufacturer’s sales, advertising and promotional activities may be relevant in determining secondary meaning, the true test of secondary meaning is the effectiveness of this effort to create it.”).

221. *The Trade-Mark Cases*, 100 U.S. 82, 94 (1879).

222. See *Seabrook Foods, Inc. v. Bar-Well Foods Ltd.*, 568 F.2d 1342, 1345 (C.C.P.A. 1977) (“[R]egardless of the [mark owner’s] intentions, it is the association, by the *consumer*, of the . . . design with the [mark owner] as the source that is determinative.”); *Plastilite Corp. v. Kassnar Imports*, 508 F.2d 824, 827 (C.C.P.A. 1975) (holding that in determining distinctiveness, “it is the association of the mark with a particular source by the ultimate consumers which is to be measured—not [applicant’s] intent” in adopting the mark); *Estee Lauder, Inc. v. Gap, Inc.*, 932 F. Supp. 595, 599 (S.D.N.Y. 1996) (noting that whether a term is protected as a trademark does not depend upon the plaintiff producer’s intentions); see also Christopher D. Keirs, *Protecting Today’s Products: Selected Trademark and Trade Dress Issues*, 6 J. PROPRIETARY RTS. 14, 15 (Nov. 1994) (“[Y]our trademark is not what *you* think it is; it’s what *consumers* think it is.”).

223. See RESTATEMENT, *supra* note 1, § 13(a) (inherent distinctiveness reflects whether prospective purchasers are likely to perceive mark as source-identifier); *id.* § 13(b) (acquired distinctiveness reflects whether prospective purchasers have come to perceive mark as a source-identifier).

by its marketplace operation, not by the process through which it was adopted. Goodwill is created by public association, not private aspiration.

Intent is also an unreliable predictor of likely consumer association for evidentiary reasons.²²⁴ More than any other indicium that we might seek to scrutinize, it is unnecessarily subjective and minimizes the weight attached to external evidence of likely association. According any weight to intent begets self-serving testimony, typically attaching most significance to the testimony of those who in all likelihood have a personal stake in the outcome of the proceedings.²²⁵ These fears have been borne out in cases where courts, incorrectly, have paid heed to the intent of the producer.²²⁶

224. Arguably, reference to whether a design was intended to identify a product's source might inform, to some extent, a determination of whether it is likely to do so (i.e., there might be some degree of correlation between intent and achievement). Cf. *Estee Lauder*, 932 F. Supp. at 599 (“[T]he question whether ‘100%,’ standing alone, is a trademark or used in a trademark sense does not depend upon [plaintiff’s] intentions, which are no more than circumstantial evidence of likely consumer perception.”). The minimal nature of that correlation and of the guidance it can afford, and the risk that intent might come to determine rather than to inform a court’s analysis, cautions against even minor reference to intent as a predictive factor. Intent stocks the potential to distort the distinctiveness inquiry, and thus, for the reasons stated in the text, consideration of a producer’s intent should be avoided.

225. See *Judith Ripka Designs, Ltd. v. Preville*, 935 F. Supp. 237, 245 (S.D.N.Y. 1996) (“The Court is dubious that testimony as to source of inspiration of design can usually be effectively weighed at trial.”). In jurisdictions, such as the Second Circuit, that focus on the producer’s intent, failure to produce such evidence can prove fatal to a plaintiff’s claim notwithstanding its intrinsic unreliability. See, e.g., *New York Racing Ass’n, Inc. v. Perlmutter Publ’g, Inc.*, No. 95 Civ. 994, 1996 WL 465298, at *2 (N.D.N.Y. July 19, 1996) (finding trade dress not inherently distinctive under *Knitwaves* where no evidence that plaintiff’s objective in using the trade dress was primarily source-identification); *Banff Ltd. v. Express, Inc.*, 921 F. Supp. 1065, 1071 n.5 (S.D.N.Y. 1995) (setting aside jury verdict for the plaintiff and explaining that “[a]s [plaintiff] offered no evidence that it designed its sweater primarily to identify its product’s source, the jury’s trade dress verdict is clearly against the ‘weight of evidence’” (citations omitted)). For an appropriate refusal to accord weight to the designer’s intent in determining inherent distinctiveness, see *Ergotron, Inc. v. Hergo Ergonomic Support Sys., Inc.*, No. 94 Civ. 2732, 1996 WL 143903, at *6-7 (S.D.N.Y. Mar. 29, 1996) (disregarding affidavit of president of plaintiff that product “was developed to be unique” where trade dress was in fact composed of common designs which had been adopted by others in the field) (applying *Seabrook*); see also *Estee Lauder*, 932 F. Supp. at 599 (noting that “no definitive conclusion need be reached as to [plaintiff’s] intention, if indeed [plaintiff] may be said to have had any,” because distinctiveness does not depend upon plaintiff’s intent).

226. For example, in *Casa Editrice Bonechi S.R.L. v. Irving Weisdorf & Co.*, 37 U.S.P.Q.2d (BNA) 1417, 1422 (S.D.N.Y. 1995), the district court regarded evidence of the intent of the manufacturer in adopting the claimed trade dress highly probative. The evidence on the issue was provided in the form of testimony of the president of the plaintiff producer, and not surprisingly it was that the color design in which trade dress was claimed was “selected purely arbitrarily.” *Id.*; cf. *Herbko Int’l, Inc. v. Gemmy Indus.*, 916

Reliance by the *Knitwaves* court on the producer's intent runs counter to these generally unquestioned observations about the nature of trademarks and the realities of eliciting evidence.²²⁷ It will also operate to exclude protection for product features because there,²²⁸ unlike with word marks or packaging, an intent other than exclusive source-identification can easily be attributed to the producer.²²⁹ Finally, the court's emphasis on "primary intent"

F. Supp. 322, 328 (S.D.N.Y. 1996) (assessing inherent distinctiveness in large part by construing the deposition testimony of the president of the plaintiff producer regarding the purpose for which product feature was designed, and finding trade dress not inherently distinctive, notwithstanding president's testimony that it "took a lot of time and effort to make it so that it stood by itself alone in the marketplace").

227. Recent decisions in other courts also reflect increased consideration of intent. *See, e.g., Callaway Golf Co. v. Golf Clean, Inc.*, 915 F. Supp. 1206, 1212 (M.D. Fla. 1995) (noting that the design of "Big Bertha" golf clubs deliberately chosen to produce an unique image in finding product design inherently distinctive under *Seabrook*). The Court of Appeals for the Seventh Circuit has not yet followed the Second or Third Circuits in adopting a more stringent test for inherently distinctive product shapes. *See Sassafras Enters., Inc. v. Roshco, Inc.*, 915 F. Supp. 1, 5 (N.D. Ill. 1996); *see also supra* note 148 (discussing Seventh Circuit case law). Absent the adoption of an explicit test by the court of appeals, however, district courts in that circuit are beginning to cite the *Duraco* test, *see, e.g., FASA Corp. v. Playmates Toys, Inc.*, 912 F. Supp. 1124, 1149 (N.D. Ill. 1996), and to base inherent distinctiveness decisions on evidence of intent that was found to be probative in *Duraco* and determinative in *Knitwaves*. *See, e.g., Sassafras*, 915 F. Supp. at 5-6 & n.9.

228. There are some instances where consideration of intent has not defeated the inherent distinctiveness claim. *See, e.g., Callaway Golf*, 915 F. Supp. at 1212 (design of "Big Bertha" golf clubs inherently distinctive); *Casa Editrice Bonechi*, 37 U.S.P.Q.2d (BNA) at 1422 (design of covers for guide books inherently distinctive); *see also Fundex Inc. v. Imperial Toy Corp.*, 26 U.S.P.Q.2d (BNA) 1061, 1062, 1063-64 (S.D. Ind. 1992) (noting, but apparently not relying on, testimony of president of plaintiff that trade dress chosen out of a desire to "make something that would stand out" and because it "gave a nice . . . appearance" to the product) (applying *Abercrombie*).

229. *See New York Racing Ass'n*, 1996 WL 465298, at *2 (finding trade dress not inherently distinctive under *Knitwaves* where no evidence that plaintiff's objective in using the trade dress was primarily source-identification); *Judith Ripka Designs*, 935 F. Supp. at 257-58 (applying *Knitwaves* and finding jewelry design not inherently distinctive); *Banff*, 921 F. Supp. at 1070-71 (setting aside jury verdict in favor of plaintiff and granting defendant's renewed motion for judgment as a matter of law on question of inherent distinctiveness); *Grupke v. Linda Lori Sportswear, Inc.*, 921 F. Supp. 987, 996 (E.D.N.Y. 1996) (applying *Knitwaves*, and granting defendant's motion for summary judgment on question of inherent distinctiveness where tee-shirt design held to be "primarily aesthetic" and there was "no evidence that plaintiffs intended their design to identify the source of the tee-shirts"); *Herbko*, 916 F. Supp. at 328 (S.D.N.Y. 1996) (applying *Knitwaves* and finding design of game not inherently distinctive notwithstanding evidence that plaintiff's design was intended to identify source, because plaintiff's statements "could also suggest that [plaintiff] designed the 'Crossword Companion' [(plaintiff's product)] in order to make it aesthetically pleasing"). The district court in *Krueger International, Inc. v. Nightingale Inc.*, 915 F. Supp. 595 (S.D.N.Y. 1996), rejected the *Knitwaves* test because, among other things:

[It] confuses the analytical requirements for inherent distinctiveness with those

presupposes a unity or predominance of purpose that does not necessarily accord with the decision-making process of manufacturers. As Judge Sotomayor remarked in *Krueger*:

[The *Knitwaves*] approach is neither helpful nor logical. In the instant case, it would force me to determine whether the plaintiff chose its chair design because it was attractive or because it was meant to serve as a trademark (*i.e.*, a source identifier). The likely answer is, both. . . . [E]very producer hopes to create a design that is more pleasing than not and that that design will be associated with it.²³⁰

of secondary meaning. Inherent distinctiveness cannot hinge on how a producer intends to promote a design. If such were the case, the evidentiary requirements for inherent distinctiveness would be almost identical to those for secondary meaning, and there would be no point in having two categories.

Id. at 602. The *Krueger* court is correct that intent is irrelevant to inherent distinctiveness, but it is no more relevant to an analysis of secondary meaning. See *Winning Ways, Inc. v. Holloway Sportswear, Inc.*, 913 F. Supp. 1454, 1464 n.8 (D. Kan. 1996) (“As the definition of secondary meaning makes clear, what [plaintiff] intended is irrelevant; what counts is the purchaser’s perceptions.”); see also *Co-Rect Prods., Inc. v. Marvy! Adver. Photography, Inc.*, 780 F.2d 1324, 1332 (8th Cir. 1985) (“[D]esires or intentions of the creator . . . are irrelevant. Instead, it is the attitude of the consumer that is important.”); *Ohio Art Co. v. Lewis Galoob Toys, Inc.*, 799 F. Supp. 870, 883 (N.D. Ill. 1992) (stating that it is irrelevant to secondary meaning analysis that plaintiff intended the product configuration to be a source-identifier). The most probative advertising for the purposes of secondary meaning is, however, typically that which emphasizes the supposedly distinctive feature and which does so as an overt symbol of identification rather than one with decorative or functional benefits. See *In re Owens-Corning Fiberglass Corp.*, 774 F.2d 1116, 1126-27 (Fed. Cir. 1985) (advertising that emphasized the color pink as primary theme cut in favor of secondary meaning attaching to color pink for fiberglass insulation); *Devan Designs Inc. v. Palliser Furniture Corp.*, 25 U.S.P.Q.2d (BNA) 1991, 1997 (M.D.N.C. 1992) (“When advertisements promote the functional and decorative features of a product without promoting an association between good and producer, it is not helpful in establishing secondary meaning.” (citation omitted)), *aff’d*, 998 F.2d 1008 (4th Cir. 1993).

[Indeed], advertising that touts a product feature for its desirable qualities and not primarily as a way to distinguish the producer’s brand is not only not evidence that the feature has acquired secondary meaning, it directly undermines such a finding. It supports instead the inference that consumers consider the claimed trade dress a desirable feature of the product and not primarily a signifier of source.

Thomas & Betts Corp. v. Panduit Corp., 65 F.3d 654, 662 (7th Cir. 1995), *cert. denied*, 116 S. Ct. 1044 (1996). Such rules—which focus on the conscious separation of functional features and their source identifying capacity, whether in designing or marketing the product—naturally invite a focus on the designer’s intent. See, e.g., *Devan Designs*, 25 U.S.P.Q.2d (BNA) at 1999 (distinguishing protection of other lamps on the ground that, unlike the plaintiff in those cases, plaintiffs never intended the product to act as the signature for their company). It is unsurprising, therefore, that the *Krueger* court equated the usual evidence of secondary meaning with proof of designer’s intent. See *Krueger*, 915 F. Supp. at 602.

230. See *Krueger*, 915 F. Supp. at 606. (Judge Sotomayor also rejected the *Duraco* test, noting that it left much to be desired. See *id.* at 602.) The district court in *Krueger*

ii. *Primarily a Designator of Origin*

Inherent distinctiveness is a measure of the likelihood that a mark will identify its source,²³¹ not the likelihood of the mark primarily identifying its source (as the Second Circuit would have it).²³² Certainly, an increased number of roles played by a product feature reduces the likelihood that it will serve to identify source; this is particularly true if its non-source-identifying roles are perceived by the consumer as prominent purposes of the feature.²³³ Subject to expressly stated exceptions, however, the Lanham Act permits marks conveying two or more meanings to be treated as distinctive even where their source-identification meaning is not exclusive.²³⁴ The Act

tried to rehabilitate the *Knitwaves* test by suggesting that "*Knitwaves's* [sic] emphasis on the producer's 'intent' may be analogous to asking, 'What is the custom in this industry?' Or: 'How does this industry, including this claimant, use designs?'" *Id.* at 604. The *Knitwaves* test, however, requires wholesale reconsideration, not mere rehabilitation. If industry custom is what the *Knitwaves* test seeks to ascertain (which is itself difficult to accept), that is the subject about which it should inquire. The district court in *Herbko* recently endorsed this strained connection of intent and industry custom. The *Herbko* court went further, however, and in a rather startling inversion of the analytical inquiry, suggested that reference to industry custom—and thus whether a design would automatically be perceived by consumers as an indicium of origin—was relevant in order to determine the producer's intent. *See Herbko*, 916 F. Supp. at 328.

231. Various formulations of the test for secondary meaning, although not that found in section 2(f) of the Lanham Act, 15 U.S.C. § 1052(f) (1994), refer to the "primary significance" of the mark or product feature in the minds of consumers. *See supra* note 51. But these expressions arguably reflect the context of marks already determined to be merely descriptive, and thus viewed as wholly unable to identify source (e.g., by virtue of undivided lexicographic significance), and requiring in practice to overcome any such descriptive significance in order to distinguish the producer's goods from those of others. *Cf. Winning Ways*, 913 F. Supp. at 1464 ("Trade dress has secondary meaning if 'its primary significance in the minds of potential consumers is *no longer* as an indicator of something about the product itself but as an indicator of its source or brand.'" (citing *Vornado*) (footnotes omitted) (emphasis added)). As noted below, *see infra* text accompanying note 238, marks that are not *merely* descriptive are not required to demonstrate secondary meaning if they are also likely to identify source. The "primary significance" language in these formulations of the secondary meaning test has also been challenged generally. *See* Petition for a Writ of Certiorari, *Thomas & Betts Corp. v. Panduit Corp.*, (No. 95-1169) (Jan. 22, 1996), at 10-11 (on file with author) (arguing that the "primary significance" standard for secondary meaning has never been endorsed by the Supreme Court), *cert. denied*, 116 S. Ct. 1044 (1996).

232. *See* RESTATEMENT, *supra* note 1, §13(a). The Second Circuit's requirement that the product design be likely to serve *primarily* as a designator of origin of the product is a clear deviation from established understandings of inherent distinctiveness. *See Herbko*, 916 F. Supp. at 328 ("Under [the *Knitwaves*] test, it is *no longer enough* for a plaintiff to 'demonstrate that the appearance of its product serves *some* source identifying function'; rather, the plaintiff must show that 'the primary purpose behind the design was to identify its product's source.'" (emphasis added) (quoting *Banff Ltd. v. Express Inc.*, 921 F. Supp. 1065, 1071 (S.D.N.Y. 1995))).

233. *See supra* notes 203-05 and accompanying text.

234. *Compare* 15 U.S.C. § 1052(e)(1) (1994) (excluding from registration marks that

requires only that the mark is one by which the goods of the mark owner can be distinguished from the goods of others.²³⁵ And courts have long recognized that product shapes may simultaneously serve many different functions, including that of source-identification.²³⁶

The import of the Second Circuit's deviation from these standards—a movement also effected by the *Duraco* court via the third leg of its announced test—is particularly apparent in considering the treatment of descriptive marks (to which both the *Knitwaves* and *Duraco* court analogized product configuration trade dress). Section 2(e)(1) of the Lanham Act excludes from registration (without proof of secondary meaning) marks that are “merely descriptive,” not marks that are “primarily descriptive.”²³⁷ Courts applying this statutory test in the context of word marks have construed the descriptiveness exclusion to oust from the category of inherently distinctive marks only those marks that contain *solely* descriptive matter.²³⁸ Where word marks function both descriptively and sugges-

are “merely descriptive” (emphasis added)), with *id.* § 1052(e)(2)-(4) (excluding from registration marks that are “primarily geographically descriptive,” “primarily geographically deceptively misdescriptive,” or “primarily merely a surname” (emphasis added)), and *id.* § 1064(3) (a petition to cancel on basis that mark has become generic to be determined by “primary significance of the registered mark to the relevant public” (emphasis added)).

235. See *id.* § 1052; *id.* § 1127 (definition of “trademark”); cf. *L. & J.G. Stickley, Inc. v. Canal Dover Furniture Co.*, 79 F.3d 258, 263 (2d Cir. 1996) (“Secondary meaning refers to ‘a subsequent significance added to the original meaning’ of the trade dress due to a producer’s use of it” (quoting RESTATEMENT, *supra* note 1, § 13 cmt. e) (emphasis added)).

236. See *supra* notes 198, 202.

237. 15 U.S.C. § 1052(e)(1).

238. See, e.g., *Eastman Kodak Co. v. Bell & Howell Document Management Prods. Co.*, 994 F.2d 1569, 1576 (Fed. Cir. 1993) (“In order for [applicant’s] marks to be found merely descriptive, they must be used *solely* as model designators and not in any source-indicating function.”); *In re Abcor Dev. Corp.*, 588 F.2d 811, 813 (C.C.P.A. 1978) (“Although a mark may be generally descriptive, if it also functions as an indication of origin, it is not ‘merely descriptive’ ”); *In re Majestic Distilling Co.*, 420 F.2d 1086, 1087 (C.C.P.A. 1970) (“A mark may be ‘merely descriptive’ and not registerable if it *only* describes a characteristic of the goods.” (emphasis added)); *In re Colonial Stores Inc.*, 394 F.2d 549, 552-53 (C.C.P.A. 1968) (finding word mark suggestive rather than merely descriptive because it did not tell the potential purchaser *only* the characteristics of the goods but also had a suggestive sense); *Estee Lauder, Inc. v. Gap, Inc.*, 932 F. Supp. 595, 609 (S.D.N.Y. 1996) (answering in the affirmative the question “whether a mark that consists of a double or triple entendre, at least one meaning of which is suggestive, is protectible without proof of secondary meaning”) (collecting cases); *Neapco Inc. v. Dana Corp.*, 12 U.S.P.Q.2d (BNA) 1746, 1748 (T.T.A.B. 1989) (an alphanumeric designation that functions only in part in a descriptive sense to designate model or grade may be inherently distinctive and not require proof of secondary meaning to be protected as a trademark); see also WEBSTER’S THIRD NEW INTERNATIONAL DICTIONARY 1413 (1986) (“*mere-ly* adv. . . 1 . . . PURELY, 2 . . . ENTIRELY, . . . WHOLLY, 3 . . . no more than, . . . ONLY, SIMPLY, SOLELY”).

tively, they are protected as inherently distinctive. Product configurations that both serve aesthetic or utilitarian functions, and are likely to identify source, are similarly situated: the equal protection mandate of *Two Pesos* requires that they be accorded similar treatment.

Any test that defines distinctiveness of a useful product's configuration in terms of a primary purpose will drift toward the establishment of false dichotomies among aesthetics, function and source-identification.²³⁹ The *Knitwaves* test exemplifies this tendency.²⁴⁰ It sets up a false choice between aesthetics and source-identification, although the option of choosing between utilitarian and source-identification considerations may be the more common, but equally unnecessary, dilemma that confronts courts determining the protection of consumer products under a primary intent test.²⁴¹

239. See *Krueger Int'l, Inc. v. Nightingale Inc.*, 915 F. Supp. 595, 606 (S.D.N.Y. 1996) ("The approach in *Knitwaves* . . . revives a false dichotomy between aesthetics and source identification. *Knitwaves* seems to instruct that a design can serve only one primary purpose: either aesthetic or source-identifying, but not both. This approach is neither helpful nor logical."); cf. *Herbko Int'l, Inc. v. Gemmy Indus.*, 916 F. Supp. 322, 328 (S.D.N.Y. 1996) (analyzing the alleged roles of the product configuration in mutually exclusive terms: "the product configuration . . . appears to enhance the product's aesthetic value, rather than identify the source of the product" (emphasis added)).

240. See *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996, 1006 (2d Cir. 1995) ("[S]ince the primary purpose of *Knitwaves'* sweater designs is aesthetic rather than source-identifying, *Knitwaves'* sweater designs do not meet [the requirement of distinctiveness]."). Consideration of whether the design of the sweaters was primarily aesthetic arguably stiffens the mere ornamentality rule and creates instead for product design a "primary ornamentality" exclusion from protection. Cf. 1 MCCARTHY, *supra* note 1, § 7.06, at 7-33 ("If customers perceive a design as not only attractive, but as an indicator of source, then it is a trademark."); 1 *id.* § 7.26[5], at 7-146 ("The 'merely ornamental' rule is simply a facet of the basic trademark question: is the disputed feature in fact perceived by customers as a trademark or not? Do customers perceive this feature as *mere* attractive ornamentation or *also* as a symbol that identifies and distinguishes a single source?" (emphasis added)).

241. Although each court applying *Knitwaves* has found that the product design at issue was not inherently distinctive, see *infra* note 281 and accompanying text, some district courts in the Second Circuit have not fully embraced the *Knitwaves* test. One district court has expressly refused to apply the test formulated by the Second Circuit. See *Krueger*, 915 F. Supp. at 606. The *Krueger* court's rejection of the *Knitwaves* test rested on three grounds: (1) failure of *Knitwaves* to address the standards set out by the Supreme Court in *Two Pesos*, which envisioned a single test for inherent distinctiveness rather than a further balkanization of the applicable rules; (2) reliance on the intent of the producer confused the standard with that for secondary meaning; and (3) the revival of a false dichotomy between aesthetics and source-identification. See *id.* at 601-02, 606. The first and third of these criticisms are well-based, as is the *Krueger* court's refusal to consider the intent of the producer in evaluating the inherent distinctiveness of product design. The criticisms are discussed at various parts of this Article. See *supra* notes 170, 229-30, 239; *infra* note 249 and accompanying text. Instead of applying *Knitwaves*, Judge Sotomayor applied the *Seabrook* test and found the design of metal-frame stacking chairs

3. Analysis of *Duraco* and *Knitwaves* Tests

The opinions rendered by the Second and Third Circuits are significant in two fundamental ways. First, like the *Seabrook* court, both courts plainly recognized the difficulties in assessing inherent distinctiveness without reference to some standard of practical application to product design trade dress. *Abercrombie's* linguistic-based analysis is insufficient in this context.²⁴² Second, the *Duraco* and

inherently distinctive. See *Krueger*, 915 F. Supp. at 607. Two other district courts in the Second Circuit have sought to limit the scope of the *Knitwaves* decision. Judge Scheindlin applied a variant of the *Seabrook* test to determine the inherent distinctiveness of computer workstation furniture in *Ergotron, Inc. v. Hergo Ergonomic Support Systems, Inc.*, No. 94 Civ. 2732, 1996 WL 143903, at *7 (S.D.N.Y. Mar. 29, 1996) (holding that design of computer workstation furniture not inherently distinctive). Although Judge Sotomayor clearly articulated her criticisms of the *Knitwaves* test, the basis for Judge Scheindlin's decision to depart from *Knitwaves* is less clear. Judge Scheindlin expressly acknowledged that the Second Circuit had abandoned the classical distinctiveness analysis, and that the Court of Appeals had "stated that the test should be whether [the trade dress] is likely to serve primarily as a designator of origin of the product." *Id.* at *5 (citations omitted) (internal quotations omitted) (alteration in original). Yet, she founded her application of an alternative test on the statement that "neither the Second Circuit in *Knitwaves* nor the Supreme Court has adopted an explicit test to determine the inherent distinctiveness of a trade dress." *Id.* This is either a studious disregard of the Court of Appeals' opinion, or an interpretation of the *Knitwaves* opinion as an articulation merely of the broad inquiry underlying the inherent distinctiveness analysis rather than a test in and of itself. Judge Scheindlin's non-application of *Knitwaves* is particularly baffling given her opinion in *Banff Ltd. v. Express, Inc.*, 921 F. Supp. 1065 (S.D.N.Y. 1995). There, she set aside a jury verdict in favor of a trade dress plaintiff and granted a renewed motion for judgment as a matter of law on the basis of the Second Circuit's reformulation of the test for inherent distinctiveness in *Knitwaves*. See *id.* at 1070-71.

Finally, Judge Mukasey has read the *Knitwaves* formulation as limited to cases where trade dress rights are claimed in the product, "alone and apart from its packaging." See *Fun-Damental Too, Ltd. v. Gemmy Indus.*, No. 96 Civ. 1103, 1996 WL 125641, at *8 (S.D.N.Y. Mar. 21, 1996). In contrast, where the trade dress was claimed in the "product . . . displayed as an integral part of the dress," Judge Mukasey determined distinctiveness by application of the traditional *Abercrombie* categories. See *id.* at *8-*9 (finding overall impression conveyed by the product's features and its packaging to be inherently distinctive). See *infra* note 336, for a fuller discussion of Judge Mukasey's opinion.

242. Other courts, although not fully adopting the tests articulated by the Second or Third Circuits, have also acknowledged the deficiencies of *Abercrombie* with respect to product design. See, e.g., *Sassafras Enters., Inc. v. Roshco, Inc.*, 915 F. Supp. 1, 5 n.8 (N.D. Ill. 1996); *Krueger*, 915 F. Supp. at 601. Courts in the Third Circuit have recognized the distinction drawn by the *Duraco* court between packaging and product configuration, and have applied *Abercrombie* in the former case. In *Sweetzel, Inc. v. Hawk Hill Cookies, Inc.*, Civ. No. CIV.A. 95-2632, 1995 WL 550585, at *7 (E.D. Pa. Sept. 14, 1995), a district court in the Third Circuit applied *Abercrombie* to a packaging trade dress claim, reasoning that "[a]lthough the Court of Appeals for the Third Circuit has rejected the *Abercrombie* criteria for determining inherent distinctiveness in actions for infringement of product configuration, it has distinguished product packaging actions such as *Two Pesos* in doing so." *Id.* Similarly, the *Knitwaves* court appears to have endorsed the continued application of the *Abercrombie* test in product packaging cases. See *Knitwaves*,

Knitwaves tests signal a strong preference on the part of certain circuit courts that, despite the liberalizing influence of *Two Pesos* that appears to have inspired many other courts,²⁴³ product configurations are less likely to be inherently distinctive than other forms of trade dress.²⁴⁴

The retreat from *Abercrombie* is thus being sounded by two courts which had refused to acknowledge inherently distinctive trade dress prior to *Two Pesos*.²⁴⁵ One might speculate whether the recognition by these courts of the limits of the *Abercrombie* test stems from the re-examination of first principles to which they have been forced to resort anew. It is to be hoped that the guidance of those principles will ultimately extend also to their respective tests for inherent distinctiveness, for each court appears to have strayed from a proper understanding of the concept of distinctiveness. Although *Two Pesos* compelled both courts to reconceptualize a basic requirement of trademark law, that should not be the signal to regress to a position where inherent distinctiveness of trade dress is effectively denied, or where the capacity of product shapes to perform a function, evoke aesthetic pleasure in the beholder, and at the same time identify the source of the product, is questioned once more.

Yet, that is what each court may have achieved. Despite explicit disavowals,²⁴⁶ the Second Circuit's primary intent test for inherently distinctive product configurations has effectively reimposed the secondary meaning requirement from which trade dress plaintiffs were apparently liberated by *Two Pesos*.²⁴⁷ Indeed, that the Second Circuit

71 F.3d at 1007; see also *supra* notes 134, 168 (discussing the continued application of the *Abercrombie* test in the packaging context); *infra* note 275 and accompanying text (same).

243. See *infra* notes 274-77 and accompanying text.

244. See *Sassafras*, 915 F. Supp. at 4; *Tyco Indus. v. Tiny Love, Ltd.*, 914 F. Supp. 1068, 1082 (D.N.J. 1996) (finding design of baby product not inherently distinctive under the "stringent" *Duraco* test without extended discussion); see also *Pebble Beach Co. v. Tour 18 I, Ltd.*, 936 F. Supp. 1299, 1343 n.39 (S.D. Tex. 1996) ("The *Duraco* test creates a more stringent standard of [inherent] distinctiveness."); Mitchell Zimmerman, *Trade Dress Protection for User Interfaces Revisited and Interred?*, 13 *COMPUTER LAW* 4, 8 (1996) (concluding that *Duraco* test is likely to create "insuperable obstacles" to finding inherently distinctive product configuration); *infra* note 281 and accompanying text (listing cases in the Second Circuit applying *Knitwaves* and finding no inherent distinctiveness). But see *Health O Meter, Inc. v. Terraillon Corp.*, 873 F. Supp. 1160, 1171 (N.D. Ill. 1995) (suggesting that if *Duraco* test were applicable in Seventh Circuit, the design of plaintiff's scales would meet the test).

245. See *supra* notes 62-66 and accompanying text.

246. See *Knitwaves*, 71 F.3d at 1009 n.6.

247. The Second Circuit in *Knitwaves* implicitly interpreted *Duraco* as achieving the same result. See *id.* (declining to follow *Duraco* test because not rooted in language of the Lanham Act); see also *Pebble Beach*, 936 F. Supp. at 1343 n.39 (finding merit in *Duraco* but applying *Abercrombie* because reading *Two Pesos* to endorse that approach).

intends that result can be discerned from its choice to associate product features not with the trade dress treated by the Supreme Court in *Two Pesos* but rather with the protection of color per se addressed by the Supreme Court in *Qualitex*.²⁴⁸ The *Knitwaves* court was faced with a choice between the two Supreme Court decisions: the full assimilation of trade dress and trademarks underlying *Two Pesos*, and the limited derogation from that principle suggested by the otherwise expansionist decision in *Qualitex*. Was product design fully within the scope of the *Two Pesos* decision or was it akin to color per se, and thus protectable only upon proof of secondary meaning?

The Second Circuit obfuscated on this point. The very articulation of a test for inherently distinctive product configuration clearly presupposes the possibility that a product configuration can be inherently distinctive. The *Knitwaves* court appears to incline toward *Qualitex* rather than *Two Pesos*,²⁴⁹ however, citing as "equally applicable to product features" the observation by the *Qualitex* court to the effect that a product's color "is unlike 'fanciful,' 'arbitrary,' or 'suggestive' words." The Second Circuit's conclusion that, despite *Two Pesos*, the presumption of source-identification at the root of inherent distinctiveness "may not be made with regard to product features or designs whose primary purposes are likely to be functional or aesthetic,"²⁵⁰ is thus a lopsided compromise of these conflicting viewpoints. Although the court purported to set out a standard that avoided imposing "additional, nontext-based requirements, such as the requirement of secondary meaning struck down in *Two Pesos*,"²⁵¹ for the reasons discussed above, that is precisely what the *Knitwaves* primary intent test will likely achieve.²⁵² It relegates

248. *Duraco* was decided before *Qualitex*, and the Third Circuit was thus steered only by the wholly expansionist decision in *Two Pesos*. Viewed functionally, and less doctrinally, the decisions of both the Second and Third Circuits might be seen as an implementation of the free competition mandate of *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 167 (1989), in preference to the equal protection edict of *Two Pesos*. This Article argues, however, that the concerns for competition reflected in the *Bonito Boats* decision should analytically be accommodated via the functionality doctrine rather than the test for inherent distinctiveness. See *supra* notes 89-101 and accompanying text.

249. One district court in the Second Circuit that has expressly declined to apply the *Knitwaves* test founded its decision, among other things, on the failure of the Second Circuit to address clearly "the standards in this area as set by the Supreme Court" in *Two Pesos*. See *Krueger Int'l, Inc. v. Nightingale Inc.*, 915 F. Supp. 595, 601 (S.D.N.Y. 1996).

250. *Knitwaves*, 71 F.3d at 1008.

251. *Id.* at 1009 n.6.

252. See *supra* notes 217-19, 234-38 and accompanying text. Although the *Knitwaves* opinion is addressed to the question of inherent distinctiveness, Judge Oakes appears in one passage to suggest that intention to serve a source-identifying function is relevant to

product configuration once more to a lesser class of source-identifiers.

Much of the articulation by the *Duraco* court of its test does not suggest any radically new doctrinal framework in which to analyze the inherent distinctiveness of product shapes,²⁵³ and its consideration of whether the design is unusual or merely ornamental is clearly appropriate. To the extent that it mirrors the focus on intent and on primary purpose displayed by the *Knitwaves* court, however, it also distorts the traditional understanding of trademarks and suggests more slender protection for product design.²⁵⁴

Thus, while both courts purport to leave open the prospect of inherently distinctive product design, they are clearly dubious of that possibility, which in truth is quite chimerical under either test. The configuration-specific tests the courts formulated may achieve the same result sought by proponents of a secondary meaning requirement. In *Two Pesos*, the Supreme Court recognized that an absolute requirement of secondary meaning for trade dress protection would create a problem of piracy in the early stages of product marketing and distribution.²⁵⁵ That same vulnerability exists where secondary meaning, though not required in every instance, is in effect the only reliable route to trademark protection. In the Second and Third Cir-

eligibility for trade dress protection, implicating perhaps even protection by virtue of secondary meaning. See *Knitwaves*, 71 F.3d at 1007. A subsequent district court decision lends some substance to this concern by applying the *Knitwaves* test and granting defendant's renewed motion for judgment as a matter of law on the distinctiveness question without considering secondary meaning. See *Banff Ltd. v. Express, Inc.*, 921 F. Supp. 1065, 1071 (S.D.N.Y. 1995); see also *Judith Ripka Designs, Ltd. v. Preville*, 935 F. Supp. 237, 257 (S.D.N.Y. 1996) (applying *Knitwaves* test to jewelry design, and then turning to analysis of inherent distinctiveness: "Plaintiff's jewelry, moreover, is not inherently distinctive" (emphasis added)). The defendant in *Banff*, however, had argued at the summary judgment stage that the plaintiff had not plead secondary meaning. See *Banff Ltd. v. Express, Inc.*, 869 F. Supp. 1103, 1116 n.10 (S.D.N.Y. 1994). The better reading of *Knitwaves* is that it purports to deal only with the question of inherent distinctiveness. See 71 F.3d at 1008 (articulating primary intent test as determinant of whether to presume source identification); *id.* at 1009 (concluding that primary aesthetic objective of sweater design resulted in the designs failing to "qualify for protection of trade dress inherent in product design" (emphasis added)).

253. The *Duraco* test largely reflects the considerations announced in the new *Restatement (Third) of Unfair Competition* published a month after the opinion of the Third Circuit was handed down. See RESTATEMENT, *supra* note 1, § 13 cmt. d.

254. See *Tyco Indus. v. Tiny Love, Ltd.*, 914 F. Supp. 1068, 1082 (D.N.J. 1996) (finding design of baby product not inherently distinctive under *Duraco* without extended discussion); *supra* note 244; *infra* note 281.

255. See *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 771 (1992) (noting petitioner's concession that a general requirement of secondary meaning imposes an unfair prospect of theft or financial loss on the developer of fanciful or arbitrary trade dress at the outset of its use).

cuits, that may now be the case.²⁵⁶ No court applying either *Knitwaves* or *Duraco* has found a product design inherently distinctive.²⁵⁷ The tests the two courts announced, correctly founded on the inappropriateness of *Abercrombie*, are blatant efforts at revisionism.

256. Moreover, these courts are restricting the possibility of inherently distinctive product configurations at the same time that a similar trend is suggesting that "secondary meaning in a product configuration case will generally not be easy to establish." *Duraco Prods. v. Joy Plastic Enters.*, 40 F.3d 1431, 1453 (3d Cir. 1994); *accord* *Sassafras Enters., Inc. v. Roshco, Inc.*, 915 F. Supp. 1, 10 (N.D. Ill. 1996) (quoting *Duraco*); *see also* *Devan Designs Inc. v. Palliser Furniture Corp.*, 25 U.S.P.Q.2d (BNA) 1991, 1998 (M.D.N.C. 1992) ("[W]here it is not a trademark but a trade dress at issue and that alleged trade dress is in the design of the product itself, . . . it will usually take longer, if it is possible at all, to achieve secondary meaning."), *aff'd*, 998 F.2d 1008 (4th Cir. 1993). The recently-evidenced hostility of the Third Circuit towards product configuration trade dress claims is emphasized by the fact that in *Duraco* the exclusive sale of the products in the shape in question for five years was held to be "not so long a time as to raise a strong inference of consumer association." *Duraco*, 40 F.3d at 1454; *see also* *Ergotron, Inc. v. Hergo Ergonomic Support Sys., Inc.*, No. 94 Civ. 2732, 1996 WL 143903, at *9 (S.D.N.Y. Mar. 29, 1996) (five years exclusive use not sufficient to withstand defendant's motion for summary judgment on issue of secondary meaning). This is a very pro-defendant observation, particularly in light of the presumption contained in section 2(f) of the Lanham Act, which allows the Patent and Trademark Office in registration proceedings to take five years exclusive use as *prima facie* evidence of acquired distinctiveness. *See* 15 U.S.C. § 1052(f) (1994); *cf.* *Stuart Hall Co. v. Ampad Corp.*, 51 F.3d 780, 790 (8th Cir. 1995) ("[Plaintiff's] exclusive and continuous use of its trade dress for the period of time that creates a statutory presumption of secondary meaning for trademark registration weighs in favor of a finding of secondary meaning . . ."). The Court of Appeals for the Seventh Circuit has also articulated a more stringent standard for secondary meaning in the context of product configuration trade dress. *See Sassafras*, 915 F. Supp. at 10-11; *see also* *Thomas & Betts Corp. v. Panduit Corp.*, 65 F.3d 654, 658 (7th Cir. 1995) (noting that with product configuration, the issue in determining secondary meaning "is not the primary meaning to consumers of a particular signifier, but is instead whether a product feature's primary significance to consumers is as an identifier of source or as an element which contributes to the inherent appeal of the product"), *cert. denied*, 116 S. Ct. 1044 (1996). This heightened standard led the Seventh Circuit to the conclusion that to prove secondary meaning "[i]t is not enough that the consumers associate the form of the product with a particular producer . . . Consumers must also care that the product comes from a particular producer (though they need not be able to identify him) and must desire the product with the particular feature because it signifies that producer." *Id.* at 658-59. The plaintiff in *Thomas & Betts* petitioned the Supreme Court for a writ of certiorari, and asked the Supreme Court to consider whether a "more stringent" standard exists with respect to establishing secondary meaning for product configurations. *See* *Thomas & Betts Corp. v. Panduit Corp.*, 65 F.3d 654 (7th Cir. 1995), *petition for cert. filed*, 64 U.S.L.W. 3518 (U.S. Jan. 22, 1996) (No. 95-1169). The Supreme Court has, however, recently declined to hear the case. *See* *Thomas & Betts Corp. v. Panduit Corp.*, 116 S. Ct. 1044 (1996) (denying certiorari).

257. For cases declining to find product design inherently distinctive trade dress under *Knitwaves*, *see infra* note 281. *See also* *Tyco*, 914 F. Supp. at 1081-83 (finding design of baby product not inherently distinctive under *Duraco* without extended discussion). *But cf.* *Health O Meter, Inc. v. Terraillon Corp.*, 873 F. Supp. 1160, 1171 (N.D. Ill. 1995) (stating that if *Duraco* test were applicable in Seventh Circuit, the design of plaintiff's scales would meet the test).

They ignore the teachings of *Two Pesos* and effectively turn back the clock to the days before product configurations were welcomed, on the basis of their operation in the marketplace, into the fold of source-identifiers.²⁵⁸

In the modern marketplace, however, consumers do often base purchasing decisions on visual communication, which may flow equally from the shape of the product itself as from supplementary identifying decoration.²⁵⁹ There are many types of products and many markets in which consumers might (or manufacturers might wish to encourage them to) identify the product by reference to the design of the product itself.²⁶⁰

258. One pair of commentators has expressed a marginally more positive view of *Knitwaves*, suggesting that *Knitwaves* at least defines the reach of the Second Circuit's earlier decision in *Paddington*, where the court had extended the *Abercrombie* analysis to packaging trade dress. See Barry Werbin & Darlene Fairman, "*Inherently Distinctive*" Gains New Clarification, NAT. L.J., Feb. 12, 1996, at C29, C30 ("The 2d Circuit's decision in *Knitwaves* is a welcome clarification of the intended scope of *Paddington* and provides a more practical and realistic test for inherent distinctiveness than does the 8th Circuit in *Ampad*."); *supra*, notes 160, 162; *infra* note 274 (discussing pre-*Knitwaves* case law in the Second Circuit). Certainly, the rejection of *Abercrombie* is to be welcomed. However, the test with which *Abercrombie* has been replaced is simply misconceived, as Werbin & Fairman themselves concede, and will only rekindle rather than resolve the debate. See Werbin & Fairman, *supra* at C30 ("*Knitwaves* likely will spawn further litigation and analysis as courts grapple to apply the 2d Circuit's new test . . . to product-configuration cases, while at the same time they struggle to avoid running afoul of the Supreme Court's admonition in *Two Pesos* that trade dress can be protected if inherently distinctive without proof of secondary meaning.").

259. See *Excerpts from Motion for Leave to File Brief Amicus Curiae and Brief Amicus Curiae of Int'l Trademark Ass'n in Support of Petition in Conopco, Inc. v. May Dept Stores Co.*, reprinted in 85 TRADEMARK REP. 154, 154 (1995) ("In today's marketplace, the purchasing decision for many products and services is based on visual communication. Trade dress serves a selection function at least as significant as that served by trademarks."); Keirs, *supra* note 222, at 16 ("Product configurations are becoming an increasingly important indication of origin."); van Deursen, *supra* note 111, at 10 ("The image your product projects depends on the language that speaks to the consumer. Rely on your designers to create tangible and intangible product language capable of speaking to global consumers."); cf. Braham, *supra* note 124, at 48 ("Many products today are becoming look-alike, lower-priced commodities . . . For any to stand out, differentiation is needed, and that means business for industrial designers."). Nor should there be a concern that by accepting the possibility of dual-identifiers the design feature could piggyback protection on a verbal mark that is the true source-identifier. A threshold question for the protection of a design feature is whether it functions independently of the word or other source-identifier, creating a commercial impression distinct from the accompanying words. See 2 MCCARTHY, *supra* note 1, § 15.02[5], at 15-17.

260. See, e.g., *Versa Prods. Co. v. Bifold Co.*, 50 F.3d 189, 194 (3d Cir.) (noting that plaintiff deliberately created the product's appearance, contrasting with the other products available on the market at the time, to identify the product in the market as plaintiff's product), *cert. denied*, 116 S. Ct. 54 (1995). Indeed, one of the most valuable products of the late twentieth century, the computer program, might almost entirely be identified (at least post-sale) by its design features as embodied in its user interface. See Rhoda L.

Such a situation might develop by necessity, as in the case of products that are small, or the surface of which is not susceptible to marking.²⁶¹ The particular process by which a good is manufactured may render labeling impossible.²⁶² Many products, for reasons of cost, as well as marketing strategy, are left unpackaged or packaged in a common undistinctive manner.²⁶³ A product may be marketed to a group of consumers whose ethnicity or diversity of ethnicity might reduce the identifying value of words of particular language.²⁶⁴

Rudnick, *Window Dressing: Trademark Protection for Computer Screen Displays and Software*, 80 TRADEMARK REP. 382, 382 (1990) ("The screen display design, the way the product looks to and interacts with the user, has become the consumer's primary product identification.").

261. For example, the dry cleaning press pads at issue in *Qualitex Co. v. Jacobsen Products Co.* could not be stamped with a verbal mark or pressed clothes would have been branded with the name. See Donna Gill, *Supreme Court May Add Own Hue to Color Depletion Theory*, CHICAGO LAW., Nov. 1994, at 13; see also *Qualitex Co. v. Jacobsen Prods. Co.*, 115 S. Ct. 1300, 1308 (1995) (recognizing that a firm "might find it difficult to place a usable symbol or word on a product (say, a large industrial bolt that customers normally see from a distance); and, that in such instances, the manufacturer might wish to use color, pure and simple . . . to identify the product"); *Duraco*, 40 F.3d at 1453 (noting that consumers may identify source from product configuration "if the good is one with some features of importance to a consumer's choice that a consumer ordinarily cannot recognize in the market (such as the safety and efficacy of a drug) and one in which, because of the nature of the product's use or consumption, identifying source designations might not readily be prominently displayed"); *Ross-Whitney Corp. v. Smith Kline & French Labs.*, 207 F.2d 190, 196 (9th Cir. 1953) (shape of pills); cf. *McNeill-PPC, Inc. v. Granutec, Inc.*, 919 F. Supp. 198, 202 (E.D.N.C. 1995) (discounting suggestion that lettered markings on the surface of Tylenol gelcaps inform person preparing to ingest the capsule of the source of the drug); *George G. Fox Co. v. Hathaway*, 85 N.E. 417, 418 (Mass. 1908) (protecting shape, color and condition of bread; distinguishing low protection cases on ground that it is "not so easy to mark loaves of bread of the same size, shape and color, in such a way that will readily be distinguished from one another").

262. See, e.g., *Fabrication Enters., Inc. v. Hygenic Corp.*, 64 F.3d 53, 60 (2d Cir. 1995) (product—small latex exercise bands—manufactured by a process which leaves a talc film that cannot be stamped).

263. See Steven J. Orfield, *Perception and Product Design*, 43 APPLIANCE MFR. 24, 25 (Nov. 1, 1995) ("Many consumer product companies sell their products in retail environments where the product is on the shelf or floor and is unboxed."). Many goods that are packaged when transferred to the purchaser are displayed without packaging at the point of sale. For example, housewares, such as knives, are "usually displayed by the seller and selected by the consumer out of their packaging." *Forschner Group, Inc. v. Arrow Trading Co.*, 904 F. Supp. 1409, 1422 n.17 (S.D.N.Y. 1995) (declining to consider packaging in determining likelihood of confusion as to source of pocket knives); see also *Aromaticque, Inc. v. Gold Seal, Inc.*, 28 F.3d 863, 873 (8th Cir. 1994) (noting that because consumers want to see and smell the potpourri before they purchase it, it is wrapped in clear cellophane in a manner that allows the fragrance of the enclosed product to escape). Certain consumer goods, typically more expensive electronic items, may be stocked in a packaged form in the retail store, but with an unpackaged display model available for consumers to use in determining whether to purchase the product.

264. See *Qualitex Co. v. Jacobsen Prods. Co.*, 13 F.3d 1297, 1305 (9th Cir. 1994) (plaintiff used green/gold color to identify dry cleaning pads where many in dry cleaning

Manufacturers might seek to develop a distinctive shape for marketing reasons. Consistent with the functionalist credo, producers might wish to avoid supplementary material of any kind. And consumers might come to associate a design as a source-identifier even *without* a conscious effort on the part of the manufacturer to produce such an association or identification. Product shape will also assume enhanced importance in the after-sale market, where a verbal label or distinctive packaging is no longer of significant effect. In those situations, the packaging or verbal mark that is allegedly of greater concern than product shape at the point of initial purchase may be discarded, separated, erased or differently presented.²⁶⁵ It is simply incorrect to suggest that in all cases packaging or labeling will identify a product's source with greater certainty and immediacy than will the product's shape.²⁶⁶ Indeed, the presumption of consumer emphasis on packaging and verbal marks appears inconsistent with the recognition that associations and assumptions made by consumers post-sale might also be appropriate concerns of trademark law.²⁶⁷

Despite this, *Duraco* and *Knitwaves* treat product configurations as presumptively less capable of product differentiation by holding

industry in California did not speak English well), *rev'd*, 115 S. Ct. 1300 (1995); *cf.* *Ocean Garden, Inc. v. Marktrade Co.*, 953 F.2d 500, 507 (9th Cir. 1991) (analyzing the likelihood of confusion in packaging trade dress case, and noting that many Asian customers who do not speak English purchase on appearance alone).

265. Consumers of so-called status products, for example, may decline to purchase those items unless they remain distinctive when divested of packaging. See David M. Tichane, *The Maturing Trademark Doctrine of Post-Sales Confusion*, 85 TRADEMARK REP. 399, 399-400 (1995).

266. The Third Circuit in *Duraco* acknowledged that there may be circumstances in which a consumer may be more likely to rely on product configuration. See *Duraco*, 40 F.3d at 1453. However, although recognizing that in such circumstances "a consumer may be more *likely* to rely on a product configuration as a source designator," *id.* (emphasis added), the court suggested that such recognition would merely make secondary meaning easier to establish. See *id.* There is no reason why the fact that consumers are likely to identify the source of a particular product type by reference to configuration should be relevant to secondary meaning. Indeed, it should only be relevant to inherent distinctiveness: actual association can be measured without a calculation of that likelihood.

267. See, e.g., *Ferrari S.P.A. Esercizio v. Roberts*, 944 F.2d 1235, 1245 (6th Cir. 1991) (recognizing that post-sale confusion was actionable under the Lanham Act); *Lois Sportswear, U.S.A., Inc. v. Levi Strauss & Co.*, 799 F.2d 867, 871 (2d Cir. 1986) (same); see also *McNeill-PPC, Inc. v. Granutec, Inc.*, 919 F. Supp. 198, 204 (E.D.N.C. 1995) ("Granted, the packaging is different, but if the consumer receives the pill from a friend, or places the pill in another container, it is likely that the consumer will assume he or she is taking a Tylenol product when in fact it could be Granutec's generic counterpart.") (finding actionable post-sale confusion). See generally Michael J. Allen, *The Scope of Confusion Actionable Under Federal Trademark Law: Who Must Be Confused and When?*, 26 WAKE FOREST L. REV. 321 (1991) (discussing development of doctrine of post-sale confusion, under which likelihood of confusion of consumers in the aftermarket may still be actionable).

them to a higher standard if they crave immediate protection. The consequent restriction of trade dress protection for product configurations could snowball by eroding the basis for consumer reliance upon product configurations as indicia of source, which in turn could further reduce the basis for offering designs protection.²⁶⁸ This will almost certainly cause manufacturers to reduce the use of distinctive product shapes as source-identifiers. If producers receive the strongest protection for appended supplemental marks or packaging, they can be expected to tailor their products and packaging accordingly.

Protecting appended marks more fully than integrated product features effectively restricts producers' options, and ultimately the consumers' choice of the most worthy and varied designs. Encouraging the identification of products only by supplemental markers rather than integrated features is born, in part, of wrong-headed paternalism.²⁶⁹ A lesser degree of protection for product design also restricts the informational role of trade dress. Consumers benefit from the greatest number of indicia by which to distinguish products: some may focus more strongly on words, while others on shapes. There is no reason to dissuade consumers from exercising their purchasing decisions on the basis of additional valuable information.²⁷⁰ It

268. See *Duraco*, 40 F.3d at 1451 ("If product configurations are easily protected, consumers might learn to rely on configurations as source designators; if protection is rare, consumers will disregard product configurations as source designators, and no confusion will result."). The Court of Appeals for the Tenth Circuit has engaged in a similar analysis with equal awareness of the "self-fulfilling" nature of its action. See *Vornado Air Circulation Sys., Inc. v. Duracraft Corp.*, 58 F.3d 1498, 1509 (10th Cir. 1995) ("[C]onsumer confusion resulting from the copying of product features is, in some measure, a self-fulfilling prophecy. To the degree that useful product configurations are protected as identifiers, consumers will come to rely on them for that purpose, but if copying is allowed, they will depend less on product shapes and more on labels and packaging."), *cert. denied*, 116 S. Ct. 753 (1996).

269. One author, for example, has suggested that to allow either product design or (in apparent distinction) a trademark to serve as a source-identifier "could engender confusion among consumers rather than prevent it." Gregory L. Pehlman, Note, *Unfair Competition—Infringement Claims Under the Lanham Act—Relaxed Standards for Protection of Distinctive Trade Dress: Two Pesos, Inc. v. Taco Cabana, Inc.*, 112 S. Ct. 2753 (1992), 60 TENN. L. REV. 449, 465 (1993); see also *Duraco*, 40 F.3d at 1451 ("But partial protection, if not carefully circumscribed, may eventually cause even greater consumer confusion, as consumers will face difficulties determining what features are legitimate source designators (because inherently distinctive) and which are not."). Mr. Pehlman appears particularly concerned that the availability of (at least) two forms of source-identification would confuse the witless consumer. See Pehlman, *supra*, at 465 n.137. This rather ignores the possibility that consumers will be *better* informed and thus more capable of making more educated purchase decisions. Such a scenario is wholly consistent with the pro-competitive purposes of trademark law.

270. *But see* John B. Pegram, *Trademark Protection of Product and Container Configurations*, 81 TRADEMARK REP. 1, 27 (1990) ("The solution to the confusion problem is

is not for the courts to shape the ways in which manufacturers create product-source associations, or the ways in which consumers develop those associations.²⁷¹ Inducement for producers to recoil from what is regarded as the primary challenge of modern industrial design seems counter-productive,²⁷² and unfortunately has been followed by other courts.²⁷³

4. Faith in the Old

Immediately following *Two Pesos*, courts in the Second Circuit, including panels of the Court of Appeals, applied *Abercrombie* without much discussion of its fit to trade dress.²⁷⁴ Despite the

public education. If the public understands that copying is likely, the public will come to rely upon labeling and will not assume that all products of a similar configuration come from the same source.”).

271. Cf. *Qualitex Co. v. Jacobsen Prods. Co.*, 115 S. Ct. 1300, 1302-03 (1995) (“[H]uman beings might use as a ‘symbol’ or ‘device’ almost anything at all that is capable of carrying meaning . . .”).

272. Compare *In re DC Comics, Inc.*, 689 F.2d 1042, 1053 (1982) (Nies, J., concurring) (“No principle of trademark law requires the imposition of penalties for originality, creativity, attractiveness, or uniqueness of one’s product or requires a holding that . . . a unique product design of a product, cannot also function as an identification of source.”), with *Duraco*, 40 F.3d at 1451 (noting that the test adopted by the court “encourages consumers to rely on a product’s configuration as a source designator only when it rather plainly serves an identifying function”).

273. This egregious disregard of the designer’s aim is evident in, and indeed paraded by, the Tenth Circuit in *Vornado*. There, the court recognized that “a producer may find efficiencies in combining the brand-identifying function with a product’s utilitarian function by using a useful product feature as a trademark or trade dress,” but despite this decided to “accord this type of efficiency little weight. Although the efficient combining of form and function is at the heart of good industrial design, promoting it is not a Lanham Act objective.” *Vornado*, 58 F.3d at 1510 n.20.

274. See, e.g., *Innovative Networks, Inc. v. Satellite Airlines Ticketing Ctrs., Inc.*, 871 F. Supp. 709, 723-24 (S.D.N.Y. 1995) (evaluating distinctiveness of airline business center under *Abercrombie*); *EFS Mktg. v. Russ Berrie & Co.*, 836 F. Supp. 128, 135 (S.D.N.Y. 1993) (toy dolls) (citing *Two Pesos* and *Paddington*), *aff’d*, 76 F.3d 487, 491 (2d Cir. 1996) (applying *Knitwaves*); see also *Mana Prods. v. Columbia Cosmetics Mfg.*, 65 F.3d 1063, 1069-70 (2d Cir. 1995) (applying *Abercrombie* analysis to determine inherent distinctiveness of design of cosmetic compacts, reasoning that trade dress had “embraced” these classifications) (considered by court to be packaging); *Jeffrey Milstein, Inc. v. Greger, Lawlor, Roth, Inc.*, 58 F.3d 27, 31-32 (2d Cir. 1995) (applying *Abercrombie* to determine the distinctiveness of greeting card designs); *Paddington Corp. v. Attiki Importers & Distribs., Inc.*, 996 F.2d 577, 583 (2d Cir. 1993) (“While the applicability of the *Abercrombie* classifications to trade dress was not at issue in *Two Pesos*, the Court noted that the Fifth Circuit below had applied the *Abercrombie* classifications to the trade dress at issue and discussed them without disapproval. While the Court . . . stopped just short of expressly ruling on whether the *Abercrombie* classifications apply to trade dress, we agree with the Fifth Circuit . . . that they do.” (citations omitted)) (applying *Abercrombie/Chevron* test to product packaging); *Banff Ltd. v. Limited, Inc.*, 869 F. Supp. 1103, 1115 (S.D.N.Y. 1994) (“While the [*Abercrombie*] test originated in the context of trademarks, the Second Circuit has held it applicable to trade dress claims as well.”), *later proceeding*, *Banff Ltd.*

developments in the Third Circuit, other courts moved in step with the Second Circuit and continued to engage in the classical analysis and, following *Chevron*, continued to apply *Abercrombie* as the test of inherent distinctiveness for all trade dress.²⁷⁵ Indeed, most of the seventeen courts that have made findings of inherently distinctive product configurations in infringement actions in the wake of *Two Pesos* and have identified the basis for their conclusion, have done so after application of *Abercrombie/Chevron* rather than *Seabrook* or *Duraco*.²⁷⁶ Several of the courts have made no attempt to articulate a

v. Express, Inc., 921 F. Supp. 1065 (S.D.N.Y. 1995).

275. See, e.g., *Insty*Bit, Inc. v. Poly-Tech Indus., Inc.*, 95 F.3d 663, 672-73 (8th Cir. 1996) (applying *Abercrombie* to product design); *Stuart Hall Co. v. Ampad Corp.*, 51 F.3d 780, 788 (8th Cir. 1995) ("This Circuit has followed *Abercrombie* in the past, and, in light of *Two Pesos*' approval, we see no reason to abandon the classic test now."); *Braun Inc. v. Dynamics Corp. of Am.*, 975 F.2d 815, 825 nn.18-19 (Fed. Cir. 1992) (noting tests in *Abercrombie and Chevron* and remanding to district court to determine whether design of blender inherently distinctive); *Pebble Beach Co. v. Tour 18 I, Ltd.*, 936 F. Supp. 1299, 1343 n.39 (S.D. Tex. 1996) (applying *Abercrombie* to product design based on Supreme Court discussion in *Two Pesos*); *Reese Prods. v. Valley Indus.*, 50 Pat. Trademark & Copyright J. (BNA) 228 (N.D. Ind. May 15, 1995) (applying *Abercrombie* but finding shape of trailer hitch not inherently distinctive); *Rubbermaid Commercial Prods. v. Con-tico Int'l*, 836 F. Supp. 1247, 1260-61 (W.D. Va. 1993) (applying *Abercrombie* to determine distinctiveness of trash bin designs). The *Abercrombie* component of the test is still applied in the packaging context (but not in product design cases) in the Second and Third Circuits. See, e.g., *Fun-Damental Too, Ltd. v. Gemmy Indus.*, No. 96 Civ. 1103, 1996 WL 125641, at *7 (S.D.N.Y. Mar. 21, 1996) (applying *Abercrombie* to determine distinctiveness of trade dress consisting of packaging and design features); *Sweetzel, Inc. v. Hawk Hill Cookies, Inc.*, No. Civ. A-2632, 1995 WL 550585, at *7 (E.D. Pa. Sept. 14, 1995); *supra* note 168 (discussing continued application of *Abercrombie* to determine distinctiveness of packaging in Second and Third Circuits).

276. Several of these courts have expressly applied *Abercrombie* or *Chevron*. See, e.g., *Body Support Sys., Inc. v. Blue Ridge Tables, Inc.*, No. 1:96CV161-D-D, 1996 WL 403943, at *6 (N. D. Miss. July 17, 1996) (concluding that plaintiff was likely to prove design of therapeutic cushion to be inherently distinctive and granting motion for preliminary injunction); *Adler, Inc. v. World Bazaars, Inc.*, 897 F. Supp. 92, 96-97 (S.D.N.Y. 1995) (finding the trade dress of a Christmas tree ornament to be inherently distinctive because arbitrary or fanciful); *Health O Meter, Inc. v. Terrailon Corp.*, 873 F. Supp. 1160, 1171 (N.D. Ill. 1995) (design of plaintiff's scales inherently distinctive); *Banff Ltd. v. Limited, Inc.*, 869 F. Supp. 1103, 1116 (S.D.N.Y. 1994) (denying defendant's motion for summary judgment on whether sweater design inherently distinctive, and sending to trial), *later proceeding*, *Banff Ltd. v. Express, Inc.*, 921 F. Supp. 1065, 1070-71 (S.D.N.Y. 1995) (setting aside jury verdict in favor of plaintiff and granting defendant's renewed motion for judgment as a matter of law on question of inherent distinctiveness granted); *Tough Traveler, Ltd. v. Outbound Prods.*, No. 94-CV-449, Memorandum Decision and Order at 4 (N.D.N.Y. Sept. 23, 1994) (overall appearance of child carrier inherently distinctive) (on file with author), *rev'd on other grounds*, 60 F.3d 964 (2d Cir. 1995); *Vornado Air Circulation Sys., Inc. v. Duracraft Corp.*, No. 92-1543-WEB, Memorandum and Order at 27-29 (D. Kan. Mar 4, 1994) (on file with author) (appearance of household fan grill inherently distinctive), *rev'd on other grounds*, 58 F.3d 1498 (10th Cir. 1995), *cert. denied*, 116 S. Ct. 753 (1996); see also *Kompan A.S. v. Park Structures, Inc.*, 890 F. Supp. 1167, 1174 (N.D.N.Y. 1995) (finding the configuration of playground equipment to be inher-

basis for their conclusion.²⁷⁷ A minority of others, most notably in the

ently distinctive) (relying on *Paddington*, which had adopted *Abercrombie* test); *cf. Insty*Bit, Inc.*, 95 F.3d at 672-73 (concluding that genuine issue exists as to whether design of plaintiff's quick-change drill was inherently distinctive under *Abercrombie*). Others have simply cited to the language of *Two Pesos*, in which the Supreme Court declared that trade dress in the "suggestive," "arbitrary" or "fanciful" categories of *Abercrombie* is inherently distinctive because by "its intrinsic nature" it identifies the particular source of the product. See *Imagineering, Inc. v. Van Klassens, Inc.*, 53 F.3d 1260, 1263-64 (Fed. Cir.) (but noting the "new look" of the product design at issue), *cert. denied*, 116 S. Ct. 277 (1995).

My calculation of the number of inherently distinctive product configurations is premised on the definition of "product configuration" provided *supra* note 12. An expanded definition of "product design" would increase the number of product designs that have been recognized as inherently distinctive since *Two Pesos* (and such recognition has almost entirely been accorded after application of the *Abercrombie/Chevron* test, if a test has been identified). For example, if two-dimensional product design is also considered, the total of seventeen inherently distinctive product configurations would require to be increased to at least twenty. Courts have found two-dimensional product design to be inherently distinctive trade dress under *Abercrombie*. See *Computer Care v. Service Sys. Enters., Inc.*, 982 F.2d 1063, 1068-69 (7th Cir. 1992) (affirming finding of inherent distinctiveness of reminder letters, sales brochures and monthly reports provided as part of auto service "reminder letter" business); *Casa Editrice Bonechi S.R.L. v. Irving Weisdorf & Co.*, 37 U.S.P.Q.2d (BNA) 1417, 1422 (S.D.N.Y. 1995) (applying *Abercrombie* and finding cover design of guidebooks inherently distinctive); *Lisa Frank, Inc. v. Impact Int'l, Inc.*, 799 F. Supp. 980, 988-89 (D. Ariz. 1992) (applying *Seabrook* standard in finding group of two and three-dimensional novelty stationery items inherently distinctive, but also finding *Chevron* satisfied); see also *Letica Corp. v. Sweetheart Cup Co.*, 805 F. Supp. 482, 487-88 (W.D. Mich. 1992) (genuine issue as to whether pattern on disposable cups inherently distinctive, but granting alleged infringer's motion for summary judgment because no likelihood of confusion) (applying *Abercrombie*). Nor does my initial calculation include trade dress consisting of the overall impression conveyed by a composite of the product's features and its packaging. See *Fun-Damental Too, Ltd. v. Gemmy Indus., No. 96 Civ. 1103*, 1996 WL 125641, at *8-9 (S.D.N.Y. Mar. 21, 1996) (trade dress of novelty bank inherently distinctive) (applying *Abercrombie*); see also *Fundex Inc. v. Imperial Toy Corp.*, 26 U.S.P.Q.2d (BNA) 1061, 1063-64 (S.D. Ind. 1992) (holding that plaintiff presented sufficient evidence to suggest that product/packaging composite could be inherently distinctive trade dress) (applying *Abercrombie* categories). Similarly, the number would rise further if the features of a golf course hole or the exterior design of a museum were considered a product design. See *Pebble Beach Co. v. Tour 18 I, Ltd.*, 936 F. Supp. 1299, 1342-43 & n.39 (S.D. Tex. 1996) (finding design of golf course hole inherently distinctive because it contains "arbitrary source-identifying features," and in light of the "uniqueness" of its appearance) (applying *Abercrombie*); *Rock & Roll Hall of Fame & Museum Inc. v. Gentile Prods.*, 39 U.S.P.Q.2d (BNA) 1140, 1142-43 (N.D. Ohio 1996) (finding the shape of the Rock and Roll Hall of Fame to be inherently distinctive because "unique" and "fanciful" but not identifying applicable test of distinctiveness; enjoining sale of unauthorized posters depicting the building).

277. See *Alan Tracy, Inc. v. Trans Globe Imports, Inc.*, 60 F.3d 840 (Fed. Cir. 1995) (Table decision, opinion published at 1995 WL 331109, at *2) (without identifying test, affirming trial court finding of inherently distinctive feature of lighting fixture lens because "physical configuration is uncommon and creates a distinctive visual impression"); *Gasser Chair Co. v. Infanti Chair Mfg. Corp.*, No. 88 Civ. 3931, 1996 WL 370162, at *12 (E.D.N.Y. June 28, 1996) (finding design of chair to be inherently distinctive without identification of test applied, but apparently by reference to evidence of *actual* consumer

Eleventh Circuit, have continued to apply *Seabrook*, although findings of inherently distinctive product configurations under *Seabrook* have been more rare.²⁷⁸

The *Duraco* court suggested, with some degree of accuracy, that courts applying *Abercrombie* have done so nonchalantly, without inquiring whether it makes sense to do so or articulating fully why they have done so.²⁷⁹ Moreover, four of the decisions finding inherently

association, and declaring that a "trade dress is inherently distinctive when its 'gestalt' identifies the product as coming from an identified source."), *vacated*, No. 96-1448, 1996 WL 455579, at *2 (Fed. Cir. Aug 1, 1996) (vacating judgment and remanding to district court because terms of injunction did not adequately identify enjoined products); *Sunbeam Prods. Inc. v. West Bend Co.*, 39 U.S.P.Q.2d (BNA) 1545, 1551 (S.D. Miss. 1996) (design of household mixer inherently distinctive, without identifying test but citing to decision of the Fifth Circuit in *Two Pesos*); *Dorr-Oliver Inc. v. Fluid-Quip, Inc.*, 894 F. Supp. 1190, 1198-99 (N.D. Ill. 1995) (finding clamshell-shaped starch washer used in processing corn inherently distinctive shape without adopting a specific test but noting that design is not functional and is unique), *rev'd on other grounds*, 94 F.3d 376 (7th Cir. 1996); *Black & Decker Corp. v. Int'l Sales & Mktg.*, 36 U.S.P.Q.2d (BNA) 1851, 1853 (C.D. Cal. 1995) (trade dress of "Snakelight" flashlight inherently distinctive) (without identifying test applied, but basing decision on lack of prior similar design in marketplace and departure from previous flashlight designs in the marketplace); *Knitwaves, Inc. v. Lollytogs Ltd.*, 92 Civ. 6285 (JSM), Ruling from the Bench (Sept. 1, 1992) ("[I]t seems to me clear that we have a design that is inherently distinctive.") (sweater design) (copy of transcript on file with author), *rev'd*, 71 F.3d 996 (2d Cir. 1995); *see also* *Badger Meter, Inc. v. Grinnell Corp.*, 13 F.3d 1145, 1151 (7th Cir. 1994) (identifying no test because jury finding of inherent distinctiveness not challenged by defendant on appeal).

278. *See, e.g.*, *Callaway Golf Co. v. Golf Clean, Inc.*, 915 F. Supp. 1206, 1212 (M.D. Fla. 1995) (determining that design of "Big Bertha" golf clubs inherently distinctive under *Seabrook*); *Taylor Made Golf Co. v. Trend Precision Golf, Inc.*, 903 F. Supp. 1506, 1507 (M.D. Fla. 1995) (applying *Seabrook/AmBrit* in determining that claimed trade dress of golf club—placement of colors on club—was not inherently distinctive); *Jungle Rags, Inc. v. Rainbow Graphics, Inc.*, 29 U.S.P.Q.2d (BNA) 1704, 1708 (M.D. Fla. 1993) (concluding that flap in shirt in shape of animal's mouth not inherently distinctive); *see also* *Sunburst Prods. v. Cyrk Int'l*, Nos. 95-1091, 95-1104, 1996 WL 550071, at *4 (Fed. Cir. Sept. 30, 1996) (applying *Seabrook* and finding design of waist pouch not inherently distinctive); *Ergotron, Inc. v. Hergo Ergonomic Support Sys., Inc.*, No. 94 Civ. 2732, 1996 WL 143903, at *6 (S.D.N.Y. Mar. 29, 1996) (deciding that design of computer workstation furniture not inherently distinctive under *Seabrook*); *Swisher Mower & Machine Co. v. Haban Mfg., Inc.*, 931 F. Supp. 645, 649-50 (W.D. Mo. 1996) (design of mower not inherently distinctive under *Seabrook*); *Devan Designs Inc. v. Palliser Furniture Corp.*, 25 U.S.P.Q.2d (BNA) 1991, 1996 n. 2 (M.D.N.C. 1992) (applying *Seabrook* to furniture line and rejecting claim of inherent distinctiveness), *aff'd*, 998 F.2d 1008 (table decision, opinion published at 27 U.S.P.Q.2d (BNA) 1339 (4th Cir. 1993) (citing, without analysis, *Abercrombie* rather than *Seabrook*)). There have been two cases finding inherently distinctive product configurations under *Seabrook*. *See Callaway Golf Co.*, 915 F. Supp. at 1212 (design of "Big Bertha" golf clubs inherently distinctive under *Seabrook*); *Krueger Int'l, Inc. v. Nightingale Inc.*, 915 F. Supp. 595, 607 (S.D.N.Y. 1996) (design of metal-frame stacking chairs inherently distinctive); *see also* *Lisa Frank, Inc. v. Impact Int'l, Inc.*, 799 F. Supp. 980, 988-89 (D. Ariz. 1992) (applying *Seabrook* standard in finding two- and three-dimensional novelty stationery items inherently distinctive, but also finding *Chevron* satisfied).

279. *See Duraco*, 40 F.3d at 1440; *see also* Oratz, *supra* note 112, at 4 (observing that

distinctive product configurations under *Abercrombie* emanated from the Second Circuit, and must now be reconsidered in light of the decision of the Court of Appeals in *Knitwaves* accepting that "*Abercrombie* [made] little sense when applied to product features."²⁸⁰ Indeed, in the wake of *Knitwaves*, one district court in the Southern District of New York that had previously applied *Abercrombie* in denying defendant's motion for summary judgment on the question of inherent distinctiveness, has set aside a jury verdict in favor of the plaintiff and granted a renewed motion for judgment as a matter of law on the basis of the Second Circuit's reformulation of the test for inherent distinctiveness in *Knitwaves*.²⁸¹

Despite the developments in the Third and (belatedly) Second Circuits, courts applying *Abercrombie/Chevron* have found product configuration trade dress to be inherently distinctive with increasing frequency since *Two Pesos*. This increase may be attributable in part to the general liberalizing trend endorsed by *Two Pesos*. It has also been suggested, however, that it might be attributable to some loose language found in that Supreme Court opinion.²⁸² The Court, in its

courts applying *Abercrombie* to trade dress "either do not bother to explain what it means for a trade dress to be 'descriptive' or they simply rely on the traditional definitions, which only make sense in the context of standard trademarks (*i.e.*, words and pictures)".

280. *Knitwaves*, 71 F.3d at 1007. In addition, the Court of Appeals for the Second Circuit has expressed its disagreement with the conclusion of inherent distinctiveness reached by the Court of Appeals for the Federal Circuit—applying Second Circuit law—in *Imagineering, Inc. v. Van Klassens, Inc.*, 53 F.3d 1260 (Fed. Cir. 1995). See *L. & J.G. Stickley, Inc. v. Canal Dover Furniture Co.*, 79 F.3d 258, 263 n.3 (2d Cir. 1996) ("We believe that the *Imagineering* case does not present a correct analysis of inherent distinctiveness . . .").

281. See *Banff Ltd. v. Express, Inc.*, 921 F. Supp. 1065, 1070-71 (S.D.N.Y. 1995). No court applying *Knitwaves* has found a product design trade dress to be inherently distinctive. See *id.*; accord *EFS Mktg. v. Russ Berrie & Co.*, 76 F.3d 487, 490-91 (2d Cir. 1996) (applying *Knitwaves* and affirming District Court decision, which was based on *Abercrombie*, that toy dolls not inherently distinctive); *Grupke v. Linda Lori Sportswear, Inc.*, 921 F. Supp. 987, 996 (E.D.N.Y. 1996) (applying *Knitwaves*, and granting defendant's motion for summary judgment on question of inherent distinctiveness where tee-shirt design held to be "primarily aesthetic" and there was "no evidence that plaintiffs intended their design to identify the source of the tee-shirts"); *Herbko Int'l, Inc. v. Gemmy Indus.*, 916 F. Supp. 322, 328 (S.D.N.Y. 1996) (applying *Knitwaves* and finding design of game board not inherently distinctive where product configuration "appears to enhance the product's aesthetic value, rather than identify the source of the product"); *New York Racing Ass'n, Inc. v. Perlmutter Publ'g, Inc.*, No. 95 Civ. 994, 1996 WL 465298 at *2 (N.D.N.Y. July 19, 1996) (finding trade dress consisting of images on souvenir merchandising not inherently distinctive under *Knitwaves* where no evidence that plaintiff's objective in using the trade dress was primarily source-identification); *Judith Ripka Designs, Ltd. v. Preville*, 935 F. Supp. 237, 257 (S.D.N.Y. 1996) (applying *Knitwaves* and finding jewelry design not inherently distinctive because primary purpose of design was aesthetic).

282. See, e.g., Nancy D. Chapman, *Trade Dress Protection in the United States After the*

discussion of inherent distinctiveness, referred to whether a mark is "capable" of distinguishing goods from those of others,²⁸³ which is the basis for registration on the Supplemental Register.²⁸⁴ Registration on the Supplemental Register is, however, premised on inchoate distinctiveness; inherent distinctiveness is a presumption of the existence of distinctiveness.

One observer has postulated that post-*Two Pesos* courts have confused the two standards, holding trade dress to be inherently distinctive on the basis of an incorrect lower standard.²⁸⁵ Since *Two Pesos*, there has been a significant increase in the number of product configurations found to be inherently distinctive, and many of these opinions recite the "capability" language from the Supreme Court opinion.²⁸⁶ It is difficult to evaluate, however, whether courts are

Supreme Court Decision in Two Pesos, 387 P.L.I./PAT. 7, 14-15 (1994) (criticizing use of "capability" language in *Two Pesos* and *Paddington*).

283. See *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 773 (1992).

284. See 15 U.S.C. § 1091 (1994). Marks that are insufficiently distinctive to obtain registration upon the Principal Register, but which are capable of becoming distinctive, may be registered on the Supplemental Register. See *id.* Marks that are merely descriptive are commonly registered on the Supplemental Register until such time as they acquire distinctiveness in the form of secondary meaning and can thus be registered on the Principal Register. See JAMES E. HAWES, TRADEMARK REGISTRATION PRACTICE, § 3.01 at 3-3 to 3-4 (1996). For the advantages of registration on the Supplemental Register, see 2 MCCARTHY, *supra* note 1, § 19.09[1][d].

285. See Chapman, *supra* note 282, at 13-16.

286. See, e.g., *Tough Traveler, Ltd. v. Outbound Prods.*, No. 94-CV-449, Memorandum Decision and Order at 4 (N.D.N.Y. Sept. 23, 1994) (on file with author) ("The critical issue 'is not whether a trade dress has in fact come to identify a specific producer, but whether it is "capable of identifying a particular source of the product." ' " (quoting *Paddington*, 996 F.2d at 582-83 (quoting *Two Pesos*, 505 U.S. at 770))), *rev'd on other grounds*, 60 F.3d 964 (2d Cir. 1995); *Vornado Air Circulation Sys., Inc. v. Duracraft Corp.*, 92-1543-WEB, Memorandum and Order at 4 (D. Kan. Mar. 4, 1994) ("To be entitled to protection, a mark must be capable of distinguishing the applicant's goods from those of others"), *rev'd on other grounds*, 58 F.3d 1498 (10th Cir. 1995), *cert. denied*, 116 S. Ct. 753 (1996); see also *Aromatique, Inc. v. Gold Seal, Inc.*, 28 F.3d 863, 869 (8th Cir. 1994) ("A distinctive trademark is one that is capable of identifying the source of goods because it is either inherently distinctive or, if not inherently distinctive, has acquired distinctiveness by acquiring secondary meaning"); *Paddington Corp. v. Attiki Importers & Distribs., Inc.*, 996 F.2d 577, 582-83 (2d Cir. 1993) (interpreting *Two Pesos* as requiring a court to consider "not whether a trade dress has in fact come to identify a specific producer, but whether 'it is capable of identifying a particular source of the product.' " (quoting *Two Pesos*, 505 U.S. at 771)); *Hanig & Co. v. Fisher & Co.*, Civ. No. 92 C 1779, 1994 WL 97758, at *3 (N.D. Ill. 1994) ("Fanciful, arbitrary, and suggestive marks are considered to be inherently distinctive, in the sense that they are capable of functioning immediately as a designation of origin."); *Life Indus. Corp. v. Ocean Bio-Chem, Inc.*, 827 F. Supp. 926, 931 (E.D.N.Y. 1993) ("The focus of the 'inherently distinctive' inquiry is not whether a trade dress has come to identify a specific producer, but rather whether the dress is 'capable of identifying a particular source of the product.' " (quoting *Two Pesos*, 505 U.S. at 770)), *rev'd on other grounds sub nom.* *Life Indus. Corp. v. Star Brite Distribs., Inc.*, 31 F.3d 42, 46 (2d Cir. 1994) (affirming district court on issue of distinctiveness).

holding trade dress to the lower standard, since the *Chevron/Abercrombie* analysis in which they purport to engage reveals nothing of their reasoning. The capability test is incorrect and is not the appropriate standard by which to assess inherent distinctiveness. The opinions in which it is cited are, however, equally as indicative of the unworkability of the *Chevron/Abercrombie* analysis as of any lower standard the courts might be applying. Recitation of the capability language appears to perform in much the same way as does the mantra of *Abercrombie* in trade dress cases: to provide a useless veneer to intuitive judgments of protectability. The solution to these problems lies in articulating a concrete test for predicting likely consumer association; in so doing, it should be made clear that there is a substantial difference between likely association and any inchoate association that is "capable" of developing.²⁸⁷

E. Some Suggested Analytical Modifications

In the wake of *Two Pesos*, two schools of judicial thought have developed with respect to the inherent distinctiveness of product designs. The first school, which has found full voice only since late 1994 and is largely (although not exclusively) confined to the Third and Second Circuits,²⁸⁸ has not fully embraced the spirit of *Two Pesos*.²⁸⁹

287. See *In re Minnesota Mining & Mfg. Co.*, 142 U.S.P.Q. (BNA) 366, 369 (C.C.P.A. 1964) (noting difference between what a mark is likely to do to a purchaser and what it is capable of doing). Nancy Chapman suggests that, ironically, protection based on a "capability" standard presents the same problems and deficiencies as does the doctrine of secondary meaning in the making that was expressly rejected by the *Two Pesos* Court. See Chapman, *supra* note 282, at 15; *supra* note 73. Professor McLean has suggested that the Supreme Court's opinion revived the doctrine under a different guise. See Willa-jeanne F. McLean, *The Birth, Death and Renaissance of the Doctrine of Secondary Meaning in the Making*, 42 AM. U. L. REV. 737, 771 (1993) ("The court has resurrected the secondary meaning in the making doctrine as the 'inherently distinctive' test."). Certainly, the Supreme Court's endorsement of the statement (made by the court of appeals) that a producer has a proprietary interest in a mark it has developed regardless of actual market response, appears to emphasize the prevention of piracy without regard to whether confusion is likely or goodwill exists to be appropriated. If that endorsement is taken too literally, there is a potential circumvention of the distinctiveness requirement that parallels the secondary meaning in the making doctrine. However, the Court's holding was not quite so broad, and merely decided that protectability could be based upon a likelihood of consumer association (inherent distinctiveness) as well as actually demonstrated association (secondary meaning). Read in this light, the concerns expressed by Professor McLean appear unjustified.

288. The Tenth Circuit has also indicated a recent willingness to restrict protection for product configuration trade dress, but its most notable efforts in this regard have been in refereeing the alleged conflict between patent and trade dress rights. See *Vornado Air Circulation Sys., Inc. v. Duracraft Corp.*, 58 F.3d 1498, 1510 (10th Cir. 1995), *cert. denied*, 116 S. Ct. 753 (1996); see also Dinwoodie, *supra* note 17, at 95-102. In *Vornado*, the Tenth Circuit reversed the grant of an injunction by the district court, which had found

Having failed to establish a border between verbal marks and non-verbal dress, these courts have regrouped by drawing a line between product packaging and product configurations. By formulating a stricter test for product configurations, and indicating a general revisionist suspicion regarding the capacity of product configurations to act as source-identifiers, they have hampered the capacity of trademark law to offer effective protection to product designs.

Other courts appear drunk on the liberalizing draught of *Two Pesos*. This group included the Second Circuit until the *Knitwaves* decision,²⁹⁰ and remains exemplified by the Eighth,²⁹¹ (although in-

the design of plaintiff's household fan grill to be inherently distinctive under *Abercrombie*. See *Vornado Air Circulation Sys., Inc. v. Duracraft Corp.*, 92-1543-WEB, Memorandum and Order at 29 (D. Kan. Mar 4, 1994) (on file with author) (appearance of household fan grill inherently distinctive), *rev'd on other grounds*, 58 F.3d 1498 (10th Cir. 1995). The Court of Appeals reversed on the ground that

where a product configuration is a significant inventive component of an invention covered by a utility patent, so that without it the invention cannot fairly be said to be the same invention, patent policy dictates that it enter into the public domain when the utility patents on the fans expire. To ensure that result, it cannot receive trade dress protection under section 43(a).

Vornado, 58 F.3d at 1500. Although the court did not address inherent distinctiveness, it noted (quoting *Two Pesos*) that "trade dress features (or feature) are inherently distinctive because their intrinsic nature is such as to 'almost automatically tell a customer that they refer to a brand.'" *Id.* at 1502 (citation omitted). Although this is merely a general statement, found in *Two Pesos*, of the meaning of inherent distinctiveness, one district court in the Tenth Circuit has declined to decide whether this amounts to a new test for inherent distinctiveness in that circuit, or whether *Vornado* impliedly adopts *Abercrombie* for product configuration trade dress. See *Winning Ways, Inc. v. Holloway Sportswear, Inc.*, 913 F. Supp. 1454, 1463-64 (D. Kan. 1996) (trade dress of jackets not inherently distinctive under either *Abercrombie* or new standard).

289. The *Duraco* court, in particular, appeared influenced more by the earlier Supreme Court decision in *Bonito Boats* and by the principles of free competition and judicial restraint to which the Supreme Court gave prominence in that case. See *Duraco Prods. v. Joy Plastic Enters.*, 40 F.3d 1431, 1445-47 (3d Cir. 1994). Professor Reichman, in 1993, noted the early signs of *Two Pesos* having (ironically) breathed new life into *Bonito Boats*. See Reichman, *supra* note 30, at 394 (noting "amount of resistance to the protection of product configurations [*Two Pesos*] may paradoxically have stirred up, at least at the appellate level, as one panel after another seems to rediscover the virtues of free competition and the limits on judicial activism implicit in *Bonito Boats*").

290. Two district courts in the Second Circuit have found product designs to be inherently distinctive since *Knitwaves*, but have reached that conclusion by refusing to apply the test announced by the Second Circuit. See *Gasser Chair Co. v. Infanti Chair Mfg. Corp.*, No. 88 Civ. 3931, 1996 WL 370162, at *12 (E.D.N.Y. June 28, 1996) (finding that design of chair was inherently distinctive), *vacated*, No. 96-1448, 1996 WL 455579, at *2 (Fed. Cir. Aug 1, 1996) (vacating judgment and remanding to District Court because terms of injunction did not adequately identify enjoined products); *Krueger Int'l, Inc. v. Nightingale Inc.*, 915 F. Supp. 595, 607 (S.D.N.Y. 1996) (design of metal-frame stacking chairs inherently distinctive) (applying *Seabrook*). One other court has found a composite of product design and packaging inherently distinctive. See *Fun-Damental Too, Ltd. v. Gemmy Indus.*, No. 96 Civ. 1103, 1996 WL 125641, at *8-9 (S.D.N.Y. Mar. 21, 1996) (trade dress of novelty bank inherently distinctive) (applying *Abercrombie*).

creasingly more ambivalent) Seventh²⁹² and Federal²⁹³ Circuits. These

291. Although the Court of Appeals for the Eighth Circuit strongly endorsed the *Abercrombie* test in *Stuart Hall Co. v. Ampad Corp.*, 51 F.3d 780, 788 (8th Cir. 1995), and applied it again in *Insty*Bit, Inc. v. Poly-Tech, Indus., Inc.*, 95 F.3d 663, 672-73 (8th Cir. 1996), other language in the *Stuart Hall* opinion has been relied upon by district courts in that circuit as an alternative test for the inherent distinctiveness of product configuration. For example, the court in *Ark Plas Products v. Value Plastics, Inc.*, 913 F. Supp. 1246, 1252 (W.D. Ark. 1996) has summarized its understanding of distinctiveness as follows:

Trade dress is inherently distinctive if the design of the trade dress is "only tenuously connected with the nature of the product," and "secondary meaning, which requires a showing that consumers attached significance to the trade dress as a source signifier, need not be proven." If the design of the trade dress is "dictated by the nature of the product then secondary meaning must be proven."

Id. (citing *Stuart Hall*, 51 F.3d at 786). This approach rests on the false premise, *see supra* notes 183-91 and accompanying text, that consumer association is relevant only to secondary meaning, and confuses a test of functionality with that of inherent distinctiveness. *See Krueger Int'l, Inc. v. Nightingale Inc.*, 915 F. Supp. 595, 603 (S.D.N.Y. 1996) (Eighth Circuit approach quoted emphasizes functionality); *see also* *Versa Prods. Co. v. Bifold Co.*, 50 F.3d 189, 197 n.5 (3d Cir. 1995) (suggesting that standard of whether design dictated by functional considerations was same standard as that for functionality); *cf. Empi v. Iomed*, 923 F. Supp. 1159, 1163-64 (D. Minn. 1996) (attempting to separate those statements in the *Stuart Hall* opinion that refer to a "prior test for the inherent distinctiveness component rather than the functionality component of the trade dress analysis"). Moreover, the *Ark Plas* court's conclusion that the design of the piping at issue was dictated by the nature of the product because *it was the product*, *see Ark Plas*, 913 F. Supp. at 1252, would prevent any product configuration from being inherently distinctive under this test. It is by no means clear, however, that the *Stuart Hall* court intended any test other than *Abercrombie* to apply to product configuration claims. *But cf. Swisher Mower & Machine Co. v. Haban Mfg., Inc.*, 931 F. Supp. 645, 649-50 (W.D. Mo. 1996) (applying *Seabrook* in finding that design of mower was not inherently distinctive).

292. One district court in the Seventh Circuit has recently sought to apply a different test to product design than to product packaging, but its efforts simply resulted in a non-test. *See Nelson/Weather-Rite, Inc. v. Leatherman Tool Group, Inc.*, No. 93 C 2274, 1995 WL 669091, at *10 (N.D. Ill. Nov. 8, 1995) (noting that both *Chevron* and *Seabrook* were packaging cases, and deciding that the appropriate test for the design of the product itself was that found in *Accurate Leather & Novelty Co. v. LTD Commodities, Inc.*, 18 U.S.P.Q.2d (BNA) 1327 (N.D. Ill. 1990)). That so-called "test" amounts to no more than the generally accepted *definition* of trade dress. *See id.* Thus, perhaps not surprisingly, the court concluded that "merely articulating this test shows that it is a subjective test which should not be determined as a matter of [summary judgment]." *See Nelson/Weather-Rite*, 1995 WL 669091, at *10. Generally, *for the purpose of determining inherent distinctiveness*, courts in the Seventh Circuit (including the court of appeals) appear to be treating product design and packaging alike, although acknowledging the deficiencies of *Abercrombie* and recognizing the lesser likelihood that product configurations (as opposed to packaging) will be inherently distinctive. *See supra* notes 148, 227, 242, and cases cited therein.

Efforts in the Seventh Circuit to restrict product design trade dress protection have found expression in other developments. First, the Court of Appeals for the Seventh Circuit has articulated a more stringent secondary meaning standard for product configuration trade dress than is applicable in the packaging trade dress context. *See Thomas & Betts Corp. v. Panduit Corp.*, 65 F.3d 654, 658-59 (7th Cir. 1995), *cert. denied*, 116 S. Ct. 1044 (1996); *see also supra* note 256 (discussing the heightened standard). Second, several courts have suggested potential restrictions on product design protection not

courts are clearly more receptive to the possibility of inherently distinctive product configurations.²⁹⁴ One study of trade dress infringement actions concluded that only two product configurations were found to be inherently distinctive in the thirty-year period prior to *Two Pesos*.²⁹⁵ Yet, at least seventeen have been endowed with that

dissimilar to that announced by the Tenth Circuit in *Vornado Air Circulation Sys., Inc. v. Duracraft Corp.*, 58 F.3d 1498, 1500 (10th Cir. 1995), *cert. denied*, 116 S. Ct. 753 (1996) (discussed *supra* notes 82, 288). The Court of Appeals for the Seventh Circuit first hinted at a *Vornado*-like restriction in *Thomas & Betts*, *see* 65 F.3d at 659, and the issue has since been taken up by two district courts in the Northern District of Illinois, including the *Thomas & Betts* court on remand. *See* *Thomas & Betts Corp. v. Panduit Corp.*, 935 F. Supp. 1399, 1409 (N.D. Ill. 1996) (“[T]he subject of an expired utility patent which is disclosed as the ‘best mode’ in the patent cannot be the subject of trademark protection with respect to the invention disclosed to the public.”); *Zip Dee, Inc. v. Dometic Corp.*, 931 F. Supp. 602, 611-12 (N.D. Ill. 1996) (concluding that trade dress protection should not be available for a product configuration that has been claimed as part of a utility patent if the product configuration is functional within the context of the patent in which it was claimed or is functional in the trademark sense). Finally, the Seventh Circuit has applied the likelihood of confusion requirement strictly in the context of product configurations, modifying its usual infringement analysis to take account of the “undeniable tension” between product design trade protection and patent law principles. *See* *Dorr-Oliver, Inc. v. Fluid-Quip, Inc.*, 94 F.3d 376, 383 (7th Cir. 1996) (endorsing approach of Third Circuit in *Versa* to the effect that: where product configurations are at issue, substantial identity of designs will not cut strongly in plaintiff’s favor; and, there is generally no likelihood of confusion stemming even from substantially identical designs when the manufacturer’s name is clearly displayed on the product). The theme common to *each* of these analytical deviations (not just the second) is the concern of the Seventh Circuit that broad trade dress protection for product design might conflict with patent law principles. *See id.* at 383; *see also* *Thomas & Betts*, 65 F.3d at 658.

293. The Court of Appeals for the Federal Circuit has indicated some movement toward lesser protection for product configuration in a recent decision concerning functionality and, with respect to trade dress generally, in the context of the test for likelihood of confusion. *See* *Elmer v. ICC Fabricating*, 67 F.3d 1571, 1580 (Fed. Cir. 1995) (finding claimed trade dress in vehicle-mounted advertising functional because co-extensive with utility patent on signs) (applying Eleventh Circuit law); *Conopco, Inc. v. May Dept. Stores Co.*, 46 F.3d 1556, 1565 (Fed. Cir. 1994) (finding no likelihood of confusion despite similarities in packaging trade dress because of defendant’s prominent addition of its logo to packaging) (applying Eighth Circuit law); *see also* *Dinwoodie, supra* note 17, at 59-65 (discussing *Conopco*). Litigants have recently—without success—asked the Supreme Court to consider both of these issues. *See, e.g., Bader’s Dutch Biscuit Co. v. Hearthside Baking Co.*, 64 F.3d 666 (9th Cir. 1995), *petition for cert. filed*, 64 U.S.L.W. 3436 (U.S. Jan. 2, 1996) (seeking resolution of conflict among circuits as to whether presence of defendant’s name prominently displayed on packaging should preclude finding of infringement), *cert. denied*, 116 S. Ct. 921 (1996); *supra* note 24 (citing cases seeking review on alleged patent/trademark conflict).

294. For other courts that have found inherently distinctive product design, *see supra* notes 276-78 (citing cases from the Second, Fifth, Seventh, Eighth, Ninth, Tenth, Eleventh and Federal Circuits). The list would expand to include the Sixth Circuit if the exterior design of a museum were considered a product design. *See* *Rock & Roll Hall of Fame & Museum Inc. v. Gentile Prods.*, 39 U.S.P.Q.2d (BNA) 1140, 1142-43 (N.D. Ohio 1996) (finding the shape of the Rock and Roll Hall of Fame to be inherently distinctive).

295. In the survey, presented to the Patent, Trademark and Copyright Section of the

status in the four years since the Supreme Court decision.²⁹⁶ Although this view is more in accord with the role of product shapes in the modern marketplace, because almost all of those decisions applied *Chevron/Abercrombie* in finding inherent distinctiveness (or did not identify the standard being applied), the basis for their conclusions is rarely articulated.

Although the set of inherently distinctive product designs might

American Bar Association in 1992, Lawrence Evans and Elizabeth Hoover found that in 106 reported product configuration trade dress infringement cases between 1961 and 1991, very few courts found the product configuration to be inherently distinctive and protectable without proof of secondary meaning. See Lawrence E. Evans, Jr. & Elizabeth A. Hoover, *Protection of Product Configurations Under the Lanham Act*, 1 U. BAL. INTEL. PROP. L.J. 126, 133 (1993). Although the authors of the study suggest that two product configurations were found to be inherently distinctive, see *id.* at 136, in fact the study reveals only one such case. See *Bauer Lamp Co. v. Shaffer*, 941 F.2d 1165, 1170-71 (11th Cir. 1991) (concluding that sufficient evidence existed to support jury verdict based on assertion that configuration of lamp inherently distinctive). In both of the cases cited by the authors of the study as examples of inherently distinctive product configurations, the court decided only that such a possibility existed but did not make any finding of inherent distinctiveness with respect to the product configuration before it. See Evans & Hoover, *supra*, at 136 n.104 (identifying cases); see also *Vaughan Mfg. Co. v. Brikam Int'l, Inc.*, 814 F.2d 346, 348 (7th Cir. 1987) (recognizing that secondary meaning need not be shown where trade dress inherently distinctive, but concluding that design in issue was not inherently distinctive) (affirming grant of preliminary injunction on basis of sufficient evidence of secondary meaning); *Remcraft Lighting Prods., Inc. v. Maxim Lighting, Inc.*, 706 F. Supp. 855, 858 (S.D. Fla. 1989) (denying defendant's motion for summary judgment on question of inherent distinctiveness). The study was restricted to infringement actions rather than registration proceedings: there are several decisions that uphold registration on the basis of inherent distinctiveness. See Arthur Seidel, *The Procurement of Trademark Registrations for the Configuration of Three Dimensional Articles* 111, 128 n.8 (ALI-ABA Course of Study, Nov. 17, 1989) available in WESTLAW C461 ALI-ABA 109 (collecting cases); see, e.g., *Schaeffer Marine Inc.*, 1 U.S.P.Q.2d (BNA) 1580, 1584 (T.T.A.B. 1986) (design of marine fittings and hardware). The study also excluded from its scope various types of product, including: clothing and shoes, packaging, exterior building features and interior decor, colors, pills, candy and foods, jewelry and watches, dish and silver patterns, other patterns, magazine formats, scents, sounds, and dolls, stuffed animals and figurines. See Evans & Hoover, *supra*, at 149 n.179; see also *id.* at 137 n.108 (listing cases in these categories finding inherently distinctive trade dress); see, e.g., *Animal Fair, Inc. v. Amfesco Indus., Inc.*, 620 F. Supp. 175 (D. Minn. 1985), *aff'd*, 794 F.2d 678 (8th Cir. 1986) (slippers in shape of bear's foot). In essence, the survey only considered product configurations in the three-dimensional sense. Other courts had found product trade dress comprising more than mere configuration to be inherently distinctive. See, e.g., *Roulo v. Russ Berrie & Co.*, 886 F.2d 931, 935-39 (7th Cir. 1989) (line of greeting cards).

296. See *supra* notes 276-78. Five of those seventeen must be reconsidered in light of the decision of the Court of Appeals for the Second Circuit in *Knitwaves*. (At least two of those five arguably would, in any event, have been omitted from the Evans & Hoover study.) The trend, however, may suggest not only increased *post hoc* litigation of commercial disputes through the vehicle of trade dress infringement claims, but also an *ex ante* decision by producers to afford greater attention to product configuration as source-identifiers after *Two Pesos*.

appropriately be a small one, that does not diminish their commercial importance. Neither treating product configurations as second-class source-identifiers, nor failing to articulate reasons for protecting one design but not another, represents a satisfactory solution. In this section, I outline some of the features of an approach that seeks to avoid both problems.

1. Significance of Classifications

Proponents of a secondary meaning requirement, and the *Duraco* and *Knitwaves* courts in articulating a stricter test of inherent distinctiveness, each invoked a series of related justifications for demanding more of product features seeking trade dress protection than was asked of packaging claimants. Each cited competitive concerns precipitated by an allegedly lesser range of alternatives.²⁹⁷ Although, as discussed above, any such concern is more properly addressed as a matter of functionality,²⁹⁸ at least two of the other doubts expressed regarding inherently distinctive product configurations or features raise issues proper to the question of distinctiveness:

- (1) Is the consumer likely to identify a product by its shape?
- (2) Can a test be developed that provides, and properly expresses, the relevant bases for a court's analysis of the first question?

Although the latter point addresses the deficiencies of the classical trademark test rather than the relative possibility of inherently distinctive product design itself, development of a workable test for product design naturally occurs if attention is focused on the proper

297. See *supra* notes 128, 172 and accompanying text.

298. See *supra* text accompanying notes 89-101. One could, in any event, take issue with the assumption that there will always be more competitive alternative packaging than product designs. Cf. Wally Olins, *Corporate Identity*, in *DESIGN HISTORY: PAST, PROCESS, PRODUCT* 1, 7 (Terry Bishop ed., 1979) ("What is interesting about detergent packs, for example, is that they are all brash and blatant. They shriek in a uniform voice."). The very fact that some packaging has been held to be functional under an alternatives-based test, while many product designs have not, merely accentuates this point. See, e.g. *Aromatique, Inc. v. Gold Seal, Inc.*, 28 F.3d 863, 873-84 (8th Cir. 1994) (packaging for potpourri functional); cf. *Kompan A.S. v. Park Structures, Inc.*, 890 F. Supp. 1167, 1173 (N.D.N.Y. 1995) (noting, in product configuration case, that "because producers have an almost unlimited choice in design, trade dress choices will normally be inherently distinctive" (citing *Paddington Corp. v. Attiki Importers & Distribs., Inc.*, 996 F.2d 577, 583 (2d Cir. 1993), a packaging case)). But see *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 786 (1992) (Thomas, J., concurring) (suggesting that "trade dress, which consists not of words or symbols, but of a product's packaging (or 'image,' more broadly), seems at common law to have been thought incapable ever of being inherently distinctive, perhaps on the theory that the number of ways to package a product is finite" (emphasis added)).

rationales for denying or restricting inherently distinctive product configurations in every instance.

Assessment of the likelihood that a design will identify the product is clearly a proper analysis in which to engage because a prediction of consumer association is at the heart of inherent distinctiveness. It is not clear, however, that objections interposed on that ground require the creation of a stricter test for product configurations. First, the rationale for such a test is circular. Its promulgation is premised on the conclusion it seeks to determine, namely, that product configurations are less likely than packaging to identify source. Second, if a different test applies only to product configurations, but not product packaging, difficult questions of classification would arise.²⁹⁹ Third, if the standard to which each category of trade dress is held is significantly different, that classification may become outcome-determinative, and thus prejudice the issue of likely association.

These concerns significantly undermine the dual-standard approach based upon classification of a trade dress as product or packaging. The Third Circuit in *Duraco* defined the term "product configuration" as "trade dress alleged in the product itself, whether in a specific feature or in some combination or arrangement of features, and to distinguish that type of trade dress from product packaging."³⁰⁰ The problem lies in applying the definition, however, not in articulating it. The conflicting responses to *Two Pesos* illustrate the difficulties. The Third Circuit has stated definitively that restaurant decor is akin to packaging, and thus that *Two Pesos* was a packaging case.³⁰¹ The Eighth Circuit, with equal certitude, declared

299. See *infra* notes 308-39 and accompanying text.

300. *Duraco Prods. v. Joy Plastic Enters.*, 40 F.3d 1431, 1439 (3d Cir. 1994); accord *Versa Prods. Co. v. Bifold Co.*, 50 F.3d 189, 193 n.1 (3d Cir. 1995) (quoting *Duraco*). The term "configuration" may traditionally connote three-dimensional features, see *supra* note 12, but the Third Circuit's definition appears to encompass any feature of the product's design. It is therefore interchangeable with the concept of "product feature" identified by the Second Circuit in *Knitwaves* as subject to a different test of inherent distinctiveness. See *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996, 1007 (2d Cir. 1995). The boundaries of both the Third Circuit's class of "product configuration" and the Second Circuit's concept of "product feature" are set by the dress consisting of part of the product, as opposed to packaging which is separate from the product. See *id.*; *Duraco*, 40 F.3d at 1439. Given their common genesis in the lack of a relation between the dress and the product (and the citation by the Second Circuit to the *Duraco* decision), the line drawn by the two courts would appear to be the same notwithstanding their use of different terminology. Cf. *Herbko Int'l, Inc. v. Gemmy Indus.*, 916 F. Supp. 322, 328 (S.D.N.Y. 1996) (noting new test for inherently distinctive "product design" and concluding that "product configuration" of plaintiff's product did not satisfy that test).

301. See *Duraco*, 40 F.3d at 1445; see also Groff, *supra* note 141, at 96 n.145 (arguing

that restaurant decor is akin to product configuration.³⁰² If the “product” is defined as the ambient experience of dining, the Eighth Circuit’s classification as product feature seems tenable: if the product being sold by the plaintiff was the food, one could more readily conceive of the decor as packaging.³⁰³

This highlights the difficulties of drawing categorical lines where in fact there exists a spectrum of trade dress:

[R]estaurant decor is an ideal illustration of the fact that there is no distinct line between protection of packaging and product configuration; some trade dresses, like restaurant decor, will be somewhere in between or perhaps could be seen as both and to create a distinction between the two artificially treats things that are alike differently.³⁰⁴

Accommodation of the hues of the spectrum requires a much more flexible and generally applicable legal standard, inviting a more case-specific analysis. The test of inherent distinctiveness should not, by resort to artificial distinctions based on an assumed empirical certainty that does not exist, foreclose the assertion of trade dress rights.

that *Duraco* reasoning is preferable because “it is not typically the restaurant or its decor being sold, but rather the food and services contained within the restaurant”). On Mr. Groff’s reasoning, the exterior design of a building is ordinarily packaging. But what if the design of the building is depicted on posters or other products of intrinsic value? See *Rock & Roll Hall of Fame & Museum Inc. v. Gentile Prods.*, 39 U.S.P.Q.2d (BNA) 1140, 1142-43 (N.D. Ohio 1996) (finding the shape of the Rock and Roll Hall of Fame to be inherently distinctive and enjoining sale of unauthorized posters depicting the building).

302. See *Stuart Hall Co. v. Ampad Corp.*, 51 F.3d 780, 787 (8th Cir. 1995) (suggesting that restaurant decor is akin to product configuration because it is “part of the restaurant experience,” and unlike packaging because it is “not thrown away once the product is removed from its packaging”); see also *Krueger Int’l, Inc. v. Nightingale Inc.*, 915 F. Supp. 595, 602 (S.D.N.Y. 1996) (“*Two Pesos* was clearly a case of product design.”). Before *Two Pesos*, the Ninth Circuit appeared to suggest that it would apply the same analysis to restaurant decor trade dress cases as it does to trade dress cases involving product packaging. See *Fuddrucker, Inc. v. Doc’s B.R. Others, Inc.*, 826 F.2d 837, 842 (9th Cir. 1987).

303. Patrons of restaurants dine at particular establishments for a variety of reasons. These include: the quality and variety of the food; the nature of the service; the ambience; and the price. See ZAGAT SURVEY: NEW YORK CITY RESTAURANTS (1995) (rating restaurants by “Food,” “Decor,” “Service” and “Cost”). Are the operatic waiters at Asti’s part of the service being provided, or do they merely “package” the food being served? Is Asti’s identified by reference to the service a patron receives, the food she is served, or the overall experience she enjoys (which may or may not include the food and the service)? Is the “food” the product, or is it the “experience” that is being sold? Cf. Rachel Beck, *Deliciously Beautiful People Are The House Specialty*, L.A. TIMES, Oct. 31, 1995, at D10 (“Crowds don’t come to the Fashion Cafe for the superb cuisine, but instead are intrigued by its museum-like setting and near-celebrity experience.”); Bill Carey, *The Hard Rock Cafe’s Hard Life Franchise Thrives Despite Feuds, Legal Wrangling*, CINC. ENQ., Nov. 22, 1993, at C3 (“Hard Rock isn’t a restaurant anyway. It’s a clothing store with food.”). Does it make any sense to assay an answer to these questions?

304. *Stuart Hall*, 51 F.3d at 788.

Rather, the test should permit a court to consider the empirical bases upon which the claim of inherent distinctiveness is founded.

The attraction of a system classifying trade dress as packaging or product design is, however, strong, because a study of decided cases clearly demonstrates more reliable trade dress protection for items that can (with relative ease) be referred to as packaging. A terminological distinction between packaging and the product itself also has an historical basis in judicial efforts to identify the valid subject matter of trade dress.³⁰⁵ The quandaries that are created by the need to classify trade dress as packaging or product design are not insignificant and are not restricted to restaurant decor cases.³⁰⁶ A review of case law and of products readily available to today's consumers suggests many circumstances where the trade dress sought to be protected might be regarded as either packaging or product configuration, as a composite of both, or as something-else lying between those two poles.³⁰⁷

305. See Reichman, *supra* note 8, at 87. Professor Reichman places the assimilation of packaging and product design as late as 1983. See *id.* at 87-88; see also 1 MCCARTHY, *supra* note 1, § 7.25[5], at 7-109, 7-112 (quoting Reichman's identification of 1983 as the date of assimilation). The distinction was also historically important in that a minority of courts at one time applied the functionality rule only in product design imitation cases. See Litman, *supra* note 20, at 79 n.21; cf. Theodore H. Davis, Jr., *Copying in the Shadow of the Constitution: The Rational Limits of Trade Dress Protection*, 80 MINN. L. REV. 595, 624-25 (1996) (arguing that functionality analysis different with packaging as opposed to product design).

306. There are a surprisingly high number of cases involving restaurant decor. See Hamstra, *supra* note 81, at 142 (discussing several cases, some reported and some quickly settled); see, e.g., *Morton v. Rank America, Inc.*, 812 F. Supp. 1062, 1068 (C.D. Cal. 1993) (claiming that Planet Hollywood restaurants infringed upon the trade dress of Hard Rock Cafe); see also Davis, *supra* note 305, at 598 (listing representative cases addressing the protectability of restaurant appearance as trade dress). The design of buildings other than restaurants might also present difficult questions of classification. Does the building design "package" the amenities available inside, or is it a product in and of itself? See *Rock & Roll Hall of Fame & Museum Inc. v. Gentile Prods.*, 39 U.S.P.Q.2d (BNA) 1140, 1142-43 (N.D. Ohio 1996) (finding the shape of the Rock and Roll Hall of Fame to be inherently distinctive and enjoining sale of unauthorized posters depicting the building). A similar question might be posed regarding the features of a golf course hole. See *Pebble Beach Co. v. Tour 18 I, Ltd.*, 936 F. Supp. 1299, 1341 (S.D. Tex. 1996) (trade dress consisting of "the shapes of plaintiff's golf holes, the length and width of the holes, the placement and shape of sand and water hazards, the size and shape of the greens, the slope and elevation of the holes, and the golf holes' surrounding vegetation") The court in *Pebble Beach* treated the golf course design as a product feature. See *id.* at 1343 n.39 (applying *Abercrombie* based on conclusion that *Two Pesos* endorsed application of *Abercrombie* factors to product features).

307. Nor are trade dress claims limited to the design of specific packaging or products. In *Walt Disney Co. v. Goodtimes Home Video Corp.*, 830 F. Supp. 762, 766 (S.D.N.Y. 1993), "Disney's claim differ[ed] from most trade dress claims in that the alleged trade dress [was] not a specific package or the appearance of a single product, but rather the

For example, in *Fabrica v. El Dorado Corp.*,³⁰⁸ the court protected the trade dress of a folder used to display samples of carpeting fabrics. As Professor Reichman has noted, “[t]he design of the folder . . . served *both* as a package, in that it displayed the plaintiff’s carpet samples to the public, *and* as a product, in that any other carpet company could use a similar folder to display its own carpet samples to its own customers.”³⁰⁹ Similarly, in *Mana Products v. Columbia Cosmetics Manufacturing*,³¹⁰ plaintiff’s cosmetic compacts, in which trade dress was claimed, could have been viewed as packaging for the powder, blush, and eye shadow they contained. They might also have been viewed as products in themselves, with a sales value quite separate from the contents, much like handbags. Often, the category into which the trade dress falls may depend upon the precise elements that are claimed as protectable trade dress. At the oral argument in *Mana*, plaintiff’s counsel narrowed the scope of its claims from the broader assemblage of “compact shapes, names, colors, catalogs, price lists and sales materials regarding the cosmetics” to the more defined “similar size, shape, and color of certain powder, blush, and eye shadow compacts.”³¹¹ Yet, even with that sharpened focus, the classification question is not without difficulty.

Our understanding of these terms might be enhanced by focusing on what would be regarded as the essential attributes of “product features” or “product configuration.” The rationale motivating the abandonment of *Abercrombie* by the Second and Third Circuits sug-

overall look of a number of different packages.” *Id.* at 767. The *Disney*-type trade dress claim is essentially one for “family trade dress” or “product line trade dress.” *Id.*; see also *Chevron Chem. Co. v. Voluntary Purchasing Groups, Inc.*, 659 F.2d 695, 705-06 (Former 5th Cir. 1981) (protecting trade dress of series of garden products); *Harlequin Enters. v. Gulf & Western Corp.*, 503 F. Supp. 647, 652-53 (S.D.N.Y. 1980), *aff’d*, 644 F.2d 946 (2d Cir. 1981) (protecting cover design of books in series).

308. 697 F.2d 890 (9th Cir. 1983).

309. Reichman, *supra* note 8, at 87; see also 1 MCCARTHY, *supra* note 1, § 7.25[5], at 7-112 n.25 (commenting that the folder was “an article which was both a package and a product”). Professor Reichman claims that the expansion of trade dress protection to product design means that every product “comes equipped with at least two trade dresses.” Reichman, *supra* note 8, at 115. “One [apparently akin to product design] comprises the exterior shell or three-dimensional form that houses whatever else the product consists of,” while the traditional trade dress—packaging—consists of “the package or container placed around the product when sold or transported from one place to another.” *Id.* This is almost as far as one can proceed in the definitional task, and it is not very far. See also Rochelle Cooper Dreyfuss, *We Are Symbols and Inhabit Symbols, So Should We Be Paying Rent? Deconstructing The Lanham Act and Rights of Publicity*, 20 COLUM.-VLA. J.L. & ARTS 123, 125 n.14 (1996) (“‘[C]onfiguration’ refers to the actual shape of the product.”).

310. 858 F. Supp. 361, 366 (E.D.N.Y. 1994), *aff’d*, 65 F.3d 1063 (2d Cir. 1995).

311. *Id.* at 364.

gests that the core aspect of a "product feature" is that it is part of the product it identifies, thus destroying any assessable relation between the product and the mark. This raises as many questions as it answers, however, by bringing to the fore the issue of how permanent or integral to the product a feature must be in order to be "part of it."³¹² For example, is the dust jacket of a book³¹³ a product feature or packaging? Is a feature used by the producer as packaging but retained in place by consumers in the use or storage of the product part of the product?³¹⁴

If our understanding of what is "part of the product" were constrained by physical connection,³¹⁵ we might exclude from consideration as product features the screen display user interfaces of computer programs.³¹⁶ These interfaces both identify software for users after sale more directly than any word marks and represent important aspects of the product to the consumer.³¹⁷ Yet, they are

312. Cf. *Stuart Hall Co. v. Ampad Corp.*, 51 F.3d 780, 787 (8th Cir. 1995) (treating restaurant decor akin to product configuration because "part of the restaurant experience").

313. See *Merriam-Webster, Inc. v. Random House, Inc.*, 35 F.3d 65, 67-68 (2d Cir. 1994) (claiming trade dress rights in dust jacket of dictionary); see also *Reader's Digest Ass'n v. Conservative Digest, Inc.*, 821 F.2d 800, 805 (D.C. Cir. 1987) (holding format of magazine cover was protected trade dress); *Casa Editrice Bonechi S.R.L. v. Irving Weisdorf & Co.*, 37 U.S.P.Q.2d (BNA) 1417, 1422 (S.D.N.Y. 1995) (holding that design of book covers, including color coding scheme, was distinctive trade dress).

314. For example, does material used by a producer to cushion or encase a product during transport to the purchaser or showroom presentation (probably viewed as packaging, cf. *Reichman*, *supra* note 8, at 115) become a product feature if the consumer continues to use it to keep the product clean or unscratched even when in use? Would that determination change depending upon whether consumers perceived that material as part of the value of what was being purchased? Cf. *Audio Fidelity, Inc. v. High Fidelity Recordings, Inc.*, 283 F.2d 551, 556 (9th Cir. 1960) (protecting trade dress of record sleeve as packaging); *infra* notes 319-21 and accompanying text.

315. Cf. *Groff*, *supra* note 141, at 67 n.6 ("[P]roduct design' refers to the physical attributes of a product itself, rather than those of the product's packaging or labeling.").

316. Cf. *Watson*, *supra* note 112, at 284 ("There are many different ways to package a software product through the use of a [graphic user interface]."). Although a number of commentators have considered the application of trade dress protection to software user interfaces, see, e.g., Lauren Fisher Kellner, Note, *Trade Dress Protection for Computer User Interface "Look and Feel"*, 61 U. CHI. L. REV. 1011, 1019 (1994), only two reported opinions have addressed the issue. See *Oratz*, *supra* note 112, at 3. In neither case did the plaintiff's trade dress claim succeed. See *id.*; see also *Zimmerman*, *supra* note 244, at 4 (noting that although no court has ever held a user interface to be protectable as trade dress, trade dress claims have become "popular 'add-on' causes of action to copyright claims, capable of imposing major litigation costs if not of altering the outcome").

317. See *Rudnick*, *supra* note 260, at 382 ("The screen display design, the way the product looks to and interacts with the user, has become the consumer's primary product identification."). Increasingly, producers of personal computers (the hardware) are also recognizing that product design can serve to identify their products and differentiate them

physically detached from the product (the software) that they identify, and are connected only electronically.³¹⁸

The integrity of the dress to the product, which is at the heart of these analyses, may also be viewed in economic rather than physical terms. One such conception of whether a claimed dress is part of the product might therefore focus on the value of the feature to the product, and inquire whether the product would be less valuable if the feature were not included in the purchase.³¹⁹ Classifying anything that enhances the value of the product as a product feature, however, would encompass many features that would clearly be thought of as packaging, such as packaging that made transport of the product safer (for example, spillproof or refrigerated containers for beverages), or its presentation as a gift to another more appealing (such as a box from Tiffany's for a piece of jewelry).³²⁰

from those of other personal computer manufacturers. See Bart Ziegler, *Computers Begin To Break Design Barrier: Clunky and Chunky May Give Way to Sleek Physiques, Array of Colors*, ASIAN WALL ST. J., Oct. 18, 1995, at 8; cf. *Compaq Computer Corp. v. Procom Tech., Inc.*, 908 F. Supp. 1409, 1425 (S.D. Tex. 1995) (asserting claim based upon trade dress of design of computer hard drive trays but finding no likelihood of confusion).

318. Compare this example with the trade dress claimed (and found infringed) in *M. Kramer Manufacturing v. Andrews*, 783 F.2d 421, 447-49 (4th Cir. 1986), where plaintiff's trade dress consisted of the design of the console in which a video game was housed and the artwork on the glass panel upon which the video graphics were displayed. Would the test to be applied vary depending upon whether the graphics were generated by the software, etched into the glass (as was the case in *Kramer*), attached as labels or fixed in place by being wrapped around the console?

319. Alternative economic-based tests could be envisaged. For example, rather than consider whether the product would be *less valuable* if the feature were not included in the purchase, one could inquire as to whether the product could *in any way* be sold without the features claimed as trade dress. A further potential test might focus on the converse situation: whether the feature claimed as trade dress could be sold independently of the other parts of the putative product. For example, if a children's product were sold along with another small toy as a free gift, would the free gift be considered packaging for the primary product, or a related feature of "the product"? Cf. *Warner Vision Entertainment Inc. v. Empire of Carolina Inc.*, No. 95 Civ. 9386, 1996 WL 67932, at *1 (S.D.N.Y. Feb. 15, 1996) (noting that free toys, which were not sold independently of the video cassettes with which they were distributed "are essentially a premium used to entice purchasers to buy the video, rather than part of the actual product for sale") (considering question in order to determine the product markets in which the plaintiff's logo had been used).

320. Such an approach also strongly evokes the concept of aesthetic functionality, which at the zenith of its influence voided protection for features that were important ingredients in the commercial success of a product. See *Pagliari v. Wallace China Co.*, 198 F.2d 339, 343 (9th Cir. 1952). This formulation of the aesthetic functionality rule can be traced to the first *Restatement of Torts*. See *RESTATEMENT (FIRST) OF TORTS* § 742 cmt. a (1938) ("When goods are bought largely for their aesthetic value, their features may be functional because they definitely contribute to that value and thus aid the performance of an object for which the goods are intended."). As I discuss in a forthcoming article:

Perhaps, instead, the classification question could be answered by focusing instead on the concept of packaging. Both the Second and Third Circuit defined or explained the class of subject matter governed by these new tests in contradistinction to packaging. However, the packaging of a product is itself a nebulous concept. At its most narrow, it may be taken to mean simply physical wrapping that is of no independent value: something which is "separate from a product and to be thrown away once the product is removed from the packaging."³²¹ For example, the wrapping by which children recognize their favorite candy; the Coke bottle that serves to identify and distinguish Coke from other beverages; the container for spray-on household cleaner that consumers associate with the Fantastik brand.³²² Construed more broadly, however, packaging can be thought of as all of the means by which the product is marketed or presented to the purchasing public.³²³ Which construction is adopted

The aesthetic functionality doctrine as first articulated can be, and was, subjected to significant and telling criticism. In that virulent form, the doctrine possessed the potential to emasculate protection for industrial designs, and in particular for successful designs. It instituted a perverse incentive that rewarded fruitless designs with unnecessary protection, but exposed successful designs to unchecked imitation.

Dinwoodie, *supra* note 17, at 12-13. As a result, "virtually every circuit to consider the issue in the past ten years has rejected the restrictive *Pagliero* standard which focuses exclusively on consumer demand, in favor of standards emphasizing the competitive effect of affording trade dress protection to product design features." Unikel, *supra* note 20, at 320; *see also* Dinwoodie, *supra* note 17, at 17-21 (arguing for single functionality standard without reference to aesthetic or utilitarian nature of feature).

321. *Stuart Hall Co. v. Ampad Corp.*, 51 F.3d 780, 788 (8th Cir. 1995). The Eighth Circuit concluded that because the rooms and furnishings at issue in *Two Pesos* were part of the "restaurant experience," *Two Pesos* involved product configuration. *Id.* If, as the *Stuart Hall* court suggested, the disposable, throwaway nature of the item is essential to the classification as packaging, items of packaging which consumers frequently retain in connection with the use of the product arguably cannot be considered as packaging for this purpose. *See supra* note 314. A similar problem of differentiating between packaging and the product itself has been addressed by some European commentators in attempting to interpret the scope of the exhaustion doctrine found in Article 7 of the E.C. Trademark Directive. *See, e.g.*, Karen Dyekjær-Hansen, *The Trade Mark Directive and the Protection of Brands and Branding*, 18 EUR. INTEL. PROP. REV. 62, 64 (1996) (drawing the line by reference to whether the alleged packaging is "clearly a severable part in terms of marketing, image building and product safety").

322. *See American Chicle Co. v. Topps Chewing Gum, Inc.*, 208 F.2d 560, 560-61 (2d Cir. 1953) (chewing gum package); *Coca-Cola Co. v. Alma-Leo U.S.A., Inc.*, 719 F. Supp. 725, 728 (N.D. Ill. 1989) (shape of Coca-Cola bottle); *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1334 (C.C.P.A. 1982) (shape of container for household cleaner).

323. *Cf. CMM Cable Rep., Inc. v. Keymarket Communications, Inc.*, 870 F. Supp. 631, 638 (M.D. Pa. 1994) (discussing the format of a radio promotion—casting the cash award offered to listeners as an "hourly wage"—as "packaging," with no intrinsic value as a product or service); *Häagen-Dazs, Inc. v. Frusen Glädjé Ltd.*, 493 F. Supp. 73, 74 (S.D.N.Y. 1980) (noting plaintiff's objections to the manner in which defendants had

might be of some consequence: Trade dress protection extends not only to the appearance of a product or its packaging, but also to the overall image of a product.³²⁴ Features of a product that pertain or contribute to its total image might be viewed as packaging only under a broad reading of that term.³²⁵

The uncertainties of the term "packaging" are well illustrated by the Eleventh Circuit's decision in *Original Appalachian Artworks, Inc. v. Toy Loft, Inc.*³²⁶ There, the court recognized trade dress rights in a marketing technique whereby, among other things, the producer of toy dolls provided each purchaser

with a "birth certificate" and "Official Adoption Papers" which include[d] an "oath of adoption" to be subscribed to by the buyer; individually naming each doll that is produced and communicating this fact by means of a name tag affixed to each doll's clothing; sending the buyer a birthday card for his [doll] on the first anniversary of the date of sale; and signing each doll's derriere "Xavier" while advertising that the dolls are a "limited signed edition."³²⁷

The court characterized this delineation of plaintiff's trade dress as packaging and supported its classification as such in two ways.³²⁸ First, it analogized marketing techniques to packaging by describing packaging as a "sales technique designed to make the product readily

"packaged" their product, meaning the marketing techniques used by the defendant).

324. See *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 764 n.1 (1992) ("The 'trade dress' of a product is essentially its total image and overall appearance." (citation omitted)); see, e.g., *id.*, 505 U.S. at 765 (claiming trade dress in "a festive eating atmosphere having interior dining and patio areas decorated with artifacts, bright colors, paintings and murals"); *Roulo v. Russ Berrie & Co.*, 886 F.2d 931, 935 (7th Cir. 1989) ("feel" of greeting cards); *Hartford House, Ltd. v. Hallmark Cards, Inc.*, 846 F.2d 1268, 1269 (10th Cir. 1988) (trade dress consisting of "non-occasion emotional messages concerning love, personal relationships, and other similar subjects, superimposed on watercolor or airbrush artwork that generally has a landscape motif or nature theme"); *Philip Morris Inc. v. Star Tobacco Corp.*, 879 F. Supp. 379, 383 (S.D.N.Y. 1995) (protecting image of the American West as applied to cigarettes); *Hampton Inns, Inc. v. Ameritel Inns, Inc.*, No. 93-459-5-BLW, 1995 WL 762148, at *2 (D. Idaho Oct. 19, 1995) (plaintiff claiming trade dress in the "interior and exterior designs of its hotels, including an emphasis on service at a mid-priced hotel"); *Romm Art Creations Ltd. v. Simcha Int'l Inc.*, 786 F. Supp. 1126, 1140-41 (E.D.N.Y. 1992) (protecting look of artist's posters). But see *Häagen-Dazs*, 493 F. Supp. at 75-76 (denying protection to claimed trade dress of "unique Scandinavian marketing theme").

325. Cf. *Schwinn Bicycle Co. v. Ross Bicycles, Inc.*, 870 F.2d 1176, 1182 n.12 (7th Cir. 1989) ("To determine unfair competition, the court must consider the total image of plaintiff's product, package and advertising and compare this with defendant's image" (citation omitted)).

326. 684 F.2d 821 (11th Cir. 1982).

327. *Id.* at 823.

328. See *id.* at 831.

identifiable to consumers and unique in the marketplace.”³²⁹ This broad concept, however, amounts to nothing more than a loose description of a trademark.³³⁰ Second, the court explained that “the adoption procedure truly is part of the packaging of [plaintiff’s] product both in the sense that dolls are never sold without the adoption papers and birth certificate and because the adoption procedure is designed to make [plaintiff’s] dolls distinctive in the marketplace.”³³¹ This too is circular and counter-intuitive.³³²

These strained explanations highlight the arbitrariness and incertitude that classification as “packaging” or “product design” engenders.³³³ The adoption papers and name tags could just as easily have been treated as a feature of the product. The essence of the court’s conclusion, as revealed in its failed efforts to proffer a definition of packaging, was that the plaintiff’s trade dress identified or was likely to identify the source of the dolls. That is the heart of the distinctiveness inquiry, and should be the focus of any analysis.

The nature of how a trade dress, as opposed to a traditional verbal mark, is circumscribed also presents problems for classification. Trade dress is a complex composite of features. In assessing distinctiveness, a trade dress must be considered as a whole and not as merely the sum of its parts.³³⁴ The appearance or trade dress that may

329. *Id.*

330. Indeed, packaging is often defined in pre-*Two Pesos* cases as elements that distinguish a product from those of competitors. *Cf. Litman, supra* note 20, at 79 (“There has been a considerable area of overlap, however, as a product’s appearance may function as its packaging, incorporating elements intended to distinguish it from competing products.”). Such an approach to the classification suggests that the packaging/product terminology operated historically not to mark off the exterior borders of protectable subject-matter, but rather merely to describe *a posteriori* those features thought incapable of identifying source from those considered able to perform that role. Given modern acceptance of the capacity of product configurations to identify source, even the historical relevance of the classification perhaps can be called into question.

331. *Original Appalachian Artworks*, 684 F.2d at 831.

332. The court appears to have concluded that the adoption procedure was packaging because the product was never sold without the adoption papers. *See id.* at 831. That is to say, the court viewed packaging as in some way integral to the product. In contrast, the intuitive conception of what constitutes packaging is that its primary attribute is its superfluosity to the product. *See Stuart Hall Co. v. Ampad Corp.*, 51 F.3d 780, 788 (8th Cir. 1995).

333. *But see Groff, supra* note 141, at 68 (arguing that “courts must make a greater effort to distinguish the design of a product itself from that of a product’s packaging or labeling, recognizing that the former is typically protectable, if at all, only under the patent laws”).

334. *See, e.g., Paddington Corp. v. Attiki Importers & Distribs., Inc.*, 996 F.2d 577, 584 (2d Cir. 1993) (“One could no more deny protection to a trade dress for using commonly used elements than one could deny protection to a trademark because it consisted of a

come to identify goods might well be a combination of the product and its packaging. For example, in *Aromatique, Inc. v. Gold Seal, Inc.*, trade dress was claimed in

the combination of natural-looking potpourri packaged in a pillow-shaped, doubled cellophane bag whose opening was gathered and tied with cords with a hanging tag attached thereto. *Aromatique* does not claim that any one of these features is protectable; it is, instead, the combination that is at issue.³³⁵

By which test should such a trade dress be adjudged,³³⁶ and should a

combination of commonly used letters of the alphabet.”); *American Greetings Corp. v. Dan-Dee Imports, Inc.*, 807 F.2d 1136, 1141 (3d Cir. 1986) (“Trade dress is a complex composite of features . . . the law of unfair competition in respect to trade dress requires that all of the features be considered together, not separately.” (quoting *SK & F Co. v. Premo Pharm. Labs.*, 481 F. Supp. 1184, 1187 (D.N.J. 1979)); *Kompan A.S. v. Park Structures, Inc.*, 890 F. Supp. 1167, 1174 (N.D.N.Y. 1995) (finding that, although each element of design might not be inherently distinctive, the combination of elements was, and thus trade dress of playground equipment inherently distinctive); *Jaret Int’l, Inc. v. Promotion in Motion, Inc.*, 826 F. Supp. 69, 74 (E.D.N.Y. 1993) (“The proper focus under section 43(a) is on ‘the entire look of the product or packaging . . . [and] each aspect should be viewed in relation to the entire trade dress.’” (quoting *Bristol-Myers Squibb Co. v. McNeil-P.P.C., Inc.*, 973 F.2d 1033, 1042 (2d Cir. 1992)) (emphasis added)); see also *Roulo v. Russ Berrie & Co.*, 886 F.2d 931, 936 (7th Cir. 1989) (protecting trade dress of overall appearance of greeting cards).

335. 28 F.3d 863, 873 (8th Cir. 1994); see also *Jeffrey Milstein, Inc. v. Greger, Lawlor, Roth, Inc.*, 58 F.3d 27, 33 (2d Cir. 1995) (claiming trade dress in appearance of greeting card, including the blank interior and the cellophane wrapping in which they are packaged); *Schwinn Bicycle Co. v. Ross Bicycles, Inc.*, 870 F.2d 1176, 1182 n.12 (7th Cir. 1989) (“To determine unfair competition, the court must consider the total image of the plaintiff’s product, package and advertising and compare this with defendant’s image. . . .” (citation omitted)); *Sassafras Enters., Inc. v. Roshco, Inc.*, 915 F. Supp. 1, 3 (N.D. Ill. 1996) (claiming protectable interest in the total image of a set of pizza utensils and a “recipe, use and care book”); cf. *Jaret Int’l Inc. v. Promotion in Motion, Inc.*, 826 F. Supp. 69, 71 (E.D.N.Y. 1993) (candies sold in boxes with clear plastic window showing candies, and box has graphic design that comprises the claimed trade dress) (trade dress claimed only in packaging without reference to candies); 1 MCCARTHY, *supra* note 1, § 8.03, at 8-29 (in determining likelihood of confusion, “[a]lmost any nonfunctional element that the ordinary purchaser sees is eligible for proof that it serves to identify and distinguish source. This includes size, shape, color, design, texture, word and symbol marks of both the product and its dress or package.”). The phenomenon of an image derived from a combination of product and container is common. See, e.g., *Estee Lauder, Inc. v. Gap, Inc.*, 932 F. Supp. 595, 604 n.18 (S.D.N.Y. 1996) (noting that the color of the defendant’s bottle is a result of the bottle contents rather than the bottle itself, but that this is not readily apparent to the purchaser).

336. This dilemma was confronted recently by Judge Mukasey in the Southern District of New York. See *Fun-Damental Too, Ltd. v. Gemmy Indus.*, No. 96 Civ. 1103, 1996 WL 125641, at *8 (S.D.N.Y. Mar. 21, 1996); see also *Fundex Inc. v. Imperial Toy Corp.*, 26 U.S.P.Q.2d (BNA) 1061, 1063-64 (S.D. Ind. 1992) (applying *Abercrombie* to determine inherent distinctiveness of trade dress comprising composite of product’s features and its packaging). The plaintiff in *Fun-Damental Too* claimed protection for the trade dress of its “Toilet Bank” product, a novelty bank in the familiar form of a tank toilet. The Toilet

different test be applied with respect to different aspects of it?³³⁷

Bank, which emitted a “real flushing sound” when its user deposited a coin and pressed the flush handle, was displayed and sold in stores in an open box. The box bore illustrations of the means of operation (dropping a penny in the bowl), but the toilet bowl was covered by clear plastic to prevent customers from placing any object in the bowl while the bank was on display. The defendant’s product (the “Currency Can”) closely imitated the design of the product, the nature of its packaging, and the markings on the box.

Judge Mukasey emphasized that the plaintiff’s product, “alone and apart from its packaging” was not at issue in the lawsuit. See *Fun-Damental Too*, 1996 WL 125641, at *8. Rather, the trade dress allegedly infringed was a composite of the product’s design and its packaging, and on this basis Judge Mukasey did not employ the *Knitwaves* test. Instead, following the approach of the *Paddington* court in pure packaging cases, Judge Mukasey assessed the distinctiveness of plaintiff’s trade dress under the traditional *Abercrombie* test and found it to be inherently distinctive. See *id.* at *9. Judge Mukasey, however, proffered no explanation for his adoption of the *Paddington* packaging test over the *Knitwaves* product design test. His opinion quotes the Second Circuit’s grounding of the *Knitwaves* test in the lesser likelihood of product design identifying the source of a product, see *id.* at *8, but does not engage in a comparable analysis of the relative likelihood that a composite of packaging and design (as opposed to pure packaging or pure design) might identify source. Cf. *infra* note 337. Implicitly, the opinion suggests that a trade dress consisting of both a product’s design and its packaging is no less likely than packaging alone to identify source. It is not clear, however, whether that conclusion rests upon the presence of *any* packaging in the claimed trade dress, or upon the packaging being the *primary* component of the protected appearance, or upon some other unarticulated basis. Putting aside the absence of analysis to support any such conclusion, further line-drawing (whether at the point of “any” packaging, “primarily” packaging, or any other stop on the continuum between pure design and pure packaging) merely compounds the problems of classification.

If this interpretation of *Knitwaves* is correct, a plaintiff that can classify *any* (or a *primary*) feature of its product as “packaging” can avail itself of the easier standard in establishing inherent distinctiveness. It renders the already-questionable process of classification doubly dubious. Moreover, while the *Fun-Damental Too* opinion acknowledges the sensory differences involved in analyzing non-verbal trade dress, see *Fun-Damental Too*, 1996 WL 125641, at *1 n.1, it does not address any of the other deficiencies of the *Abercrombie* test in the context of non-verbal marks. See *supra* text accompanying notes 105-13. Given these difficulties, it is perhaps unsurprising that the court’s analysis (which largely focuses on the defendant’s lack of need to employ the design, packaging and markings used by plaintiff) more closely resembles an analysis of functionality than a prediction of whether consumers are likely to identify the source of the Toilet Bank by its appearance. See *id.* at *8-*9.

337. Moreover, if the relative likelihood that a particular class of trade dress will identify source should determine the level of scrutiny to which a particular trade dress will be subjected, why should the alleged distinction between packaging and product features represent the sole dividing line? Trade dress can be (arbitrarily) divided into at least six categories: two-dimensional packaging design, three-dimensional packaging design, service dress, product image, two-dimensional product design, and three-dimensional product design. And, it can be depicted as a composite of any of these categories. Studies would reveal, on a generalized level, the relative likelihood of consumers relying on features in each of these categories (classification difficulties aside). For example, although the lack of a relation between the product and the mark exists whether the design is two or three-dimensional, a study of case law would probably suggest that two-dimensional design is more likely to be protected and thus relied on as an indicium of source. On the theory of the *Duraco* court, should we not act on those generalizations and promulgate

The predicament that attends this exercise merely confirms the folly of attempting to reach conceptual conclusions as to inherent distinctiveness by the application of over-generalized rules, without regard to the empirical bases that guide our analysis or support our conclusions.³³⁸ The mistake is exacerbated by resting those rules on an arbitrary classification as product or packaging, an inquiry that yields little clear guidance to the courts. If, instead, inherent distinctiveness of trade dress generally is judged by a single standard—whether the claimed trade dress is likely to act as a source-identifier for consumers—classification problems are avoided. There is no reason to draw spurious bright lines between categories of trade dress where empirical evidence is available to assist in our appraisal of likely consumer association. Conclusions that may seal the fate of the trade dress claim are best assessed by reference not to generalized assumptions but more particularized proof. Empirically-sustainable conclusions regarding the likelihood that a shape will identify source should trump any category-based predisposition toward that inquiry. Moreover, such an approach is consistent with “the entire thrust of *Two Pesos*, [which] was to unify the standards for trademark and trade dress, not to balkanize this complex field into yet more subcategories.”³³⁹

2. Which Evidence?

A test developed (and a conclusion derived) with reference to concrete evidence would also meet concerns about intuitive judging by providing empirical data to guide decisions, while facilitating the protection from the outset generally prevented by the requirement of secondary meaning. Conclusions of inherent distinctiveness cannot be empirically based, because they represent a conceptual assessment

different tests to implement those generalized observations? For precisely the problems of arbitrariness and over-generalization discussed in the text, the answer must be no.

338. It is equally true, however, that in assessing the facts, we should not lose sight of the conceptual analysis in whose aid we are considering those facts (i.e., are consumers likely to associate a product design with a single source?). Without the empirical underpinning, the conceptual conclusion is uncertain; without the guidance of a proper conceptual understanding, those underlying facts are of little consequence. Cf. IMMANUEL KANT, *CRITIQUE OF PURE REASON* 93 (N. K. Smith trans., 1929) (discussing the necessary union between “intuitions” (or facts) and conceptual understanding to produce knowledge). It is the contention of this Article that only by testing our conceptual conclusions by reference to the empirical bases upon which they are founded, can a proper analysis of inherent distinctiveness be performed.

339. *Krueger Int'l, Inc. v. Nightingale Inc.*, 915 F. Supp. 595, 602 (S.D.N.Y. 1996); see also *Stuart Hall Co. v. Ampad Corp.*, 51 F.3d 780, 788 (8th Cir. 1995) (“[W]e decline to create a distinction between protection of packaging and protection of product configuration, as such a distinction would run contrary to the holding of *Two Pesos*.”).

of how consumers will perceive a shape. The bases upon which those conclusions are reached can, however, be tested.³⁴⁰ *Abercrombie* does not provide the tools by which to examine the basis for a conclusion of inherent distinctiveness outside the context of verbal marks.³⁴¹ *Abercrombie*'s spectrum may provide a means for facilitating and communicating judicial analysis of word marks but it cannot serve as the *lingua franca* for trademarks and trade dress because it cannot convey the basis for our appraisal of product shapes.

Like many areas of trademark law, the question of inherent distinctiveness will remain highly case-specific, and concrete guidance will occur only with the accretion of factually analogous case law. Setting out the nature of the inherent distinctiveness inquiry in greater detail will, however, assist in counteracting the potential uncertainty that individualized applications of a rule of reason can cause.³⁴² Accordingly, this section of the Article articulates the types of evidence and modes of analysis courts should use in performing the predictive inquiry.

The *Seabrook* test represents a starting point, asking whether a shape or feature is "a 'common' basic shape or design, whether it [is] unique or unusual in a particular field, [or] whether it [is] a mere refinement of commonly-adopted and well-known forms of

340. To require empirical support for those conclusions, rather than merely for the basis upon which those conclusions were reached, would be to re-impose the requirement of secondary meaning.

341. *But see* Opderbeck, *supra* note 110, at 38 ("The standard [*Abercrombie*] trademark taxonomy serves as a useful surrogate for public perception."). My call for empirical content to substantiate and guide the conceptual analysis reflects various concerns. Empirical substantiation affords greater legitimacy to determinations that necessarily (and appropriately) are conceptual in nature, and places some limits on judicial discretion. *But cf.* Paul Gewirtz, *On "I Know It When I See It,"* 105 *YALE L.J.* 1023, 1030-35 (1996) (arguing that nonrational activities of the mind can play an important role in judging, and suggesting that a conclusion reached with no conscious process of deduction, and with no after-the-fact attempt to give reasons, is not necessarily less sound than one produced by sustained analysis). Additionally, resting decisions on empirically ascertainable evidence will enhance predictability for producers and their legal advisers.

342. Greater use of rules of reason rather than per se rules would appear to portend less guidance *ex ante*, but in truth this usual drawback to rules of reason is but a minor inconvenience when viewed in light of the uncertainty induced by the current methodology or by alternative bright-line approaches. *But cf.* Opderbeck, *supra* note 110, at 38 ("The Second Circuit's abandonment of [the *Abercrombie*] taxonomy in favor of a more generalized inquiry can only lead to increased litigation and inconsistent results."). The use of per se rules under a system attempting categorization of cases also typically reduces administrative costs, *see* William M. Landes & Richard A. Posner, *Trademark Law: An Economic Perspective*, 30 *J.L. & ECON.* 265, 289 (1987), but those benefits are dependent upon a degree of certainty surrounding the classifications being employed. Trademark protection of product design does not easily admit of that certainty, particularly in determining distinctiveness.

ornamentation for a particular class of goods viewed by the public as a dress or ornamentation for the goods."³⁴³ These considerations serve, in part, the function that dictionaries perform in guiding determinations of the distinctiveness of word marks.

As a preliminary matter, the objective of the inquiry also provides some general guidance as to the scope of the evidence that would be relevant. The evidence seeks to facilitate an assessment of the *likelihood* that consumers will associate a product feature with its source in a particular instance.³⁴⁴ It would be different from the evidence adduced in support of a claim of secondary meaning. The secondary meaning inquiry is directed at whether consumers *actually* have made an association with respect to the plaintiff's particular product.³⁴⁵ Even indirect evidence of secondary meaning, such as sales volume, is qualitatively different from prediction-enhancing evidence, because indirect evidence of secondary meaning, while involving some degree of conjecture, relates to the demonstrated marketplace performance of a specific product.³⁴⁶ The presumption

343. *Seabrook Foods, Inc. v. Bar-Well Foods, Ltd.*, 568 F.2d 1342, 1344 (C.C.P.A. 1977) (footnotes omitted); *see also* *AmBrit, Inc. v. Kraft, Inc.*, 812 F.2d 1531, 1536 (11th Cir. 1986) (applying same test). The *amicus curiae* brief of the United States Trademark Association (as it was then called) in *Two Pesos* suggested the *Seabrook* test as the proper inquiry to be made in a trade dress case. *See Amicus Brief* at 15, excerpted in 82 TRADEMARK REP. 440, 450-51 (1992) ("[A]lthough certain types of trade dress may be inherently distinctive and protectable without a demonstration of secondary meaning, a careful inquiry along the lines set forth in *Seabrook* is required before reaching that conclusion."); *see also* *Krueger Int'l, Inc. v. Nightingale Inc.*, 915 F. Supp. 595, 603 (S.D.N.Y. 1996) ("The *Seabrook* test is the most useful of the three tests, in my view, because it clarifies the importance of market context . . . [It] highlights the notion that a design cannot be considered in a vacuum . . . Any test of inherent distinctiveness must ask, 'Inherently distinctive as compared to what?' "); Dillon, *supra* note 206, at 82 ("The United States Trademark Association's Brief Amicus was devoted in large part to an attempt to educate the Court with respect to the nature of the inquiry required.") (citing *Seabrook* test).

344. Whether a design is likely to identify a source should not be confused with the lesser standard of whether it is "capable" of distinguishing goods from those of others, which provides the basis for registration on the Supplemental Register. *Cf. In re Minnesota Mining & Mfg. Co.*, 335 F.2d 836, 840 (C.C.P.A. 1964) (noting difference between what a mark is likely to do to a purchaser and what it is capable of doing).

345. *Cf. Stuart Hall Co. v. Ampad Corp.*, 51 F.3d 781, 788 (8th Cir. 1995) (criticizing *Duraco* test for inherent distinctiveness as varying only from secondary meaning in that secondary meaning assesses *actual* consumer recognition while *Duraco's* test of inherent distinctiveness would measure *likely* consumer recognition). Such analysis would also differ from the secondary meaning inquiry in that its inquiry would be prospective and thus could be the basis for obtaining immediate protection. *See supra* text accompanying note 53.

346. The most persuasive form of secondary meaning evidence, surveys testing actual consumer association, is fully empirical. Indirect indicia, such as sales and advertising data, still require courts to engage in a degree of speculative analysis, but with more fo-

underlying inherent distinctiveness centers on *likely* performance. Accordingly, the range of evidence advanced to assist the predictive inquiry is broader and could relate also to consumers' past and likely associational responses with respect to *products of the type* in question.³⁴⁷

Pertinent predictive evidence would relate, *inter alia*, to the nature of the design, to the context in which the design is likely to be perceived by prospective purchasers, or to the nature of the product. This evidence is intended to provide courts with guidance, with reliable predictors, in their inquiry into likely consumer association.

a. Nature of the Design

Consideration of the nature of the design mandates analysis of whether the design consists of a basic or common geometric shape, as suggested by the first component of the *Seabrook* test. Standard geometric shapes are less likely to make a product stand out from the crowd. Such designs are thus less likely to be regarded as inherently distinctive, unless the context in which the shape is used is highly unusual or is part of a larger collection which, as a whole, is unusual.

Consideration of this body of evidence might also extend to whether the design feature is understood by the public to serve other purposes. While the mere fact that a product feature serves other purposes should not prevent a finding of inherent distinctiveness,³⁴⁸ normally the fewer functions other than source-identification performed by the feature heightens the likelihood that it will be thought of as a trademark. For example, the overall shape of the Black & Decker Snakelight flashlight is associated by consumers with its source.³⁴⁹ If the design of the product was, however, also understood

cused guidance. *See* *Herbko Int'l, Inc. v. Gemmy Indus.*, 916 F. Supp. 322, 329 (S.D.N.Y. 1996) (noting that "such factors as advertising expenditures, sales success, unsolicited media coverage of the product, attempts to plagiarize, and the length and exclusivity of use . . . only guide the analysis . . . [of whether] the consuming public has come to identify the design [of the product] with its maker. . . ." (citations omitted)).

347. *See* 2 MCCARTHY, *supra* note 1, § 15.02[5], at 15-17 (in determining inherent distinctiveness of design trade dress, "[t]he issue is whether this shape is so different or unusual for this type of goods or services that its distinctiveness can be assumed" (emphasis added)); *see also* *AmBrit, Inc. v. Kraft, Inc.*, 812 F.2d at 1536 (test for inherent distinctiveness asks whether a shape "is . . . a mere refinement of commonly-adopted and well-known forms of ornamentation for a particular class of goods" (citations omitted) (emphasis added)); *cf.* *Mana Prods. v. Columbia Cosmetics Mfg.*, 65 F.3d 1063, 1070 (2d Cir. 1995) (looking at industry custom to determine whether a design is inherently distinctive).

348. *See supra* Part IV(D)(2)(b)(ii).

349. *See* *Black & Decker Corp. v. Int'l Sales & Mktg.*, 36 U.S.P.Q.2d (BNA) 1851, 1853 (C.D. Cal. 1995).

by the public to take a particular form in order to disperse the light emanating from the flashlight bulb, many consumers might perceive that such a design, rather than identifying this particular flashlight and setting it apart from others, took that form merely to disperse light as widely as possible.³⁵⁰ This predictor parallels the verbal mark inquiry of whether a mark is descriptive in relation to the product upon which it is affixed.³⁵¹ Both analyses seek to determine whether the likelihood that consumers perceive the mark or dress as a source-identifier might be reduced by some competing understanding of the shape or mark.

b. Contextual Marketplace Considerations

Examination of the context in which a design is likely to be perceived serves as a surrogate for examination of the relation that exists between a verbal mark and the product it identifies.³⁵² In this portion of its analysis, a court would in effect consider the relation between the product feature as part of the product and the product feature as source-identifier. Here, the admission of evidence relating to other products of the type at issue will be of most significance.

Contextual evidence will often supply the greatest guidance on the question of inherently distinctive shapes by establishing a background of the marketplace against which likely association can be estimated.³⁵³ Contextual evidence may be divided into two primary

350. Similarly, if consumers perceived that the Snakelight flashlight consisted of its particular shape in order to facilitate its attachment to nearby objects and thus to permit its owner use of both hands, that might *reduce* the likelihood that consumers would view the shape as a source-identifier. It does not, however, *eliminate* that likelihood.

351. See *supra* note 87 and accompanying text.

352. See *Krueger Int'l, Inc. v. Nightingale Inc.*, 915 F. Supp. 595, 603 (S.D.N.Y. 1996) ("Any test of inherent distinctiveness must ask, 'Inherently distinctive as compared to what?'"); see also *id.* ("The *Seabrook* test is the most useful of the three tests, in my view, because it clarifies the importance of market context.").

353. See *G. Heileman Brewing Co. v. Anheuser-Busch, Inc.*, 873 F.2d 985, 995 (7th Cir. 1989) ("Consumer perception should be assessed by examining the average potential consumer in the context of the existing marketplace and exposed to the information currently available in the marketplace."). Professor Dreyfuss has suggested that trademark protection for designs that possess both aesthetic and identifying meanings is one of several areas in which a contextual focus would be particularly helpful. See Dreyfuss, *supra* note 309, at 149-54 (1996) (identifying several settings where courts should evaluate confusion in a "manner that reflects . . . [the] context-sensitive dynamic of interpretation"). Dreyfuss concludes:

The more nuanced approach would acknowledge that design can have two meanings—decoration and identification. It would then ask what, in the purchasing context, consumers would take the design to mean. In some situations, for instance, where consumers were seeking designs compatible to what they already own, the likelihood is that the signifier would be perceived in its

groups. First, existing designs in the market that are similar might significantly blur the distinctiveness of the design at issue and thus suggest a lesser likelihood that consumers would identify the shape with a single source.³⁵⁴ Evidence on this point would defeat any claim of inherent distinctiveness for product features reflecting market standardization of design because such features would be unlikely to identify a single source. In contrast, an unusual or unique design, like neologisms in the context of verbal marks,³⁵⁵ should fare more favorably. This focus on the uniqueness of the design implements the second and third components of the *Seabrook* inquiry.³⁵⁶

decorative sense. Those uses—in the example, “compatibility uses”—would then be considered to fall outside the protection of trademark law. In contrast, in aesthetic functionality cases that are premised on the naked assertion that consumers like the design, where there are no contextual clues favoring the non-identifier meaning, it may be reasonable for a court to conclude that there is a likelihood of confusion.

Id. at 153-54.

354. See *Mana Prods. v. Columbia Cosmetics Mfg.*, 65 F.3d 1063, 1070 (2d Cir. 1995) (considering industry custom); *Paddington Corp. v. Attiki Importers & Distribs., Inc.*, 996 F.2d 577, 583-84 (2d Cir. 1993) (discussing the effect on distinctiveness analysis of trade dress being of type commonly used in industry). It is evidence of established usage that will assist in determining how unusual the shapes are. See *In re Colonial Stores Inc.*, 394 F.2d 549, 551 (C.C.P.A. 1968) (“To make [the distinctiveness] test meaningful, it is necessary, therefore, to consider the established usages and associations which inhere in the words [sought to be protected as marks].”). Expert evidence may be helpful on this point. See *Judith Ripka Designs, Ltd. v. Preville*, 935 F. Supp. 237, 257-58 (S.D.N.Y. 1996) (considering evidence of expert on the appearance of the products of other manufacturers in the industry); cf. *Ergotron, Inc. v. Hergo Ergonomic Support Sys., Inc.*, No. 94 Civ. 2732, 1996 WL 143903, at *7 (S.D.N.Y. Mar. 29, 1996) (rejecting affidavit of industrial design expert because expertise or knowledge in field not established, and because of lack of reference in affidavit to industry standards). Expert evidence on the ultimate issue of likely consumer perception may be of lesser assistance. Cf. *Arner v. Sharper Image Corp.*, 39 U.S.P.Q.2d (BNA) 1282, 1290 n.10 (C.D. Cal. 1995) (concluding that “an industrial design expert’s testimony regarding what an ‘ordinary purchaser’ would perceive is not helpful under Rule 702” of the Federal Rules of Evidence).

355. See *supra* notes 45, 105, 107 (discussing fanciful marks).

356. The evidence that would be persuasive on this point is not entirely unlike that needed for the type of lengthy, in-depth analysis of novelty and non-obviousness engaged in by the Patent Office in examining a design patent application. The plaintiff may have in its files or collective knowledge, facts gathered in developing the design that bear upon these issues; but, unless that is the case, this is evidence that (like evidence of secondary meaning) may still require time-consuming and costly development. In *Imagineering, Inc. v. Van Klassens, Inc.*, 53 F.3d 1260, 1264 (Fed. Cir.), *cert. denied*, 116 S. Ct. 277 (1995), the Court of Appeals for the Federal Circuit affirmed a jury finding of inherent distinctiveness in light of evidence in the record of media and trade journal descriptions of the design of plaintiff’s furniture as “novel,” “exclusive” and possessing a “totally different look,” as well as receipt of design prizes and inclusion in a museum exhibition, and testimony from furniture suppliers that they “had not seen anything like” plaintiff’s furniture. See also *Tone Bros., Inc. v. Sysco Corp.*, 28 F.3d 1192, 1206 (Fed. Cir. 1994) (finding inherent distinctiveness of container supported by evidence that plaintiff’s container was “first of its kind in the food service” industry), *cert. denied*, 115 S. Ct. 1356 (1995); Black

A second, and important, body of contextual evidence, would demonstrate the extent to which products of the type at issue are typically identified by their design as opposed to other indicia of source. This may be evidenced, *inter alia*, by trademark registrations and judicial recognition of valid trade dress rights. The fact that the primary producer of fiberglass insulation is identified by reference to the overall color of the product, for example, gives some indication of the means by which consumers might distinguish competitors' insulation products from that of Owens-Corning.³⁵⁷

The mere fact that one product design has been found to be distinctive does not, however, mean that the design of all products of that type necessarily will be inherently distinctive.³⁵⁸ Moreover, the strength of any inference of likely consumer association will weaken as the second product at issue becomes more removed from the first product type. For example, the fact that the shape of a Ferrari car has acquired distinctiveness makes it more likely that consumers will identify the source of "sports cars" by their shape.³⁵⁹ That inference is strongest with the same product line (e.g., another "classic car"), but will be entitled to less weight as the identity of product type recedes (e.g., the *Ferrari* determination might say little about the likelihood of truck purchasers identifying the source of their vehicles by reference to the shape of the truck). This consideration may be of particular importance—and the predictive inference may be accorded most weight—in assessing the inherent distinctiveness of "family trade dress" (i.e., where the dominant and distinctive part of a trade dress is applied to a variety of products by the same producer).³⁶⁰

& Decker Corp. v. Int'l Sales & Mktg., 36 U.S.P.Q.2d (BNA) 1851, 1853 (C.D. Cal. 1995) (concluding that design of "Snakelight" flashlight inherently distinctive given that "[p]rior to Black & Decker's introduction of its 'Snakelight' product, no one offered a similar flashlight in the marketplace," in light of numerous design awards and recognizing that "the Black & Decker design was a departure from the previous flashlight designs in the market"). These types of evidence appear to suggest analysis broadly equivalent to a liberal objective novelty requirement. For a discussion of the requirements of novelty and non-obviousness in design patent law, see ERNEST B. LIPSCOMB III, 5 WALKER ON PATENTS § 16.8 (3d ed. 1986); *see also supra* note 180 (explaining difference between design patent requirements and trade dress distinctiveness requirement).

357. *See In re Owens-Corning Fiberglass*, 774 F.2d 1116, 1128 (Fed. Cir. 1985).

358. *See, e.g., Ergotron, Inc. v. Hergo Ergonomic Support Sys., Inc.*, No. 94 Civ. 2732, 1996 WL 143903, at *6 (S.D.N.Y. Mar. 29, 1996) (rejecting assertion that design of plaintiff's furniture inherently distinctive because the Federal Circuit had found a different plaintiff's furniture design to be inherently distinctive in *Imaging*).

359. *See Ferrari S.P.A. Esercizio v. Roberts*, 944 F.2d 1235, 1239-40 (6th Cir. 1991); *cf. Chrysler Corp. v. Silva*, 892 F. Supp. 321, 323-24 (D. Mass. 1995) (design of Dodge Viper protected by virtue of demonstrated secondary meaning).

360. *Cf. 3 MCCARTHY, supra* note 1, § 23.19 (discussing "family of marks" doctrine).

Where a product design has acquired distinctiveness, the later use by the same producer of that shape as part of a related product is more likely to be understood by consumers as an identification of source, and thus more easily protected as inherently distinctive. Once consumers recognize the shape of a Cadillac as indicative of its source, they will more likely identify as Cadillacs subsequent models employing the same design features.

Even absent registrations or litigated determinations of trade dress rights, the type of evidence that might shed light on this inquiry concerning typical modes of identification appears often in the factual record. For example, in determining the secondary meaning of the trade dress of guitars and rebutting a claim that guitar heads were incapable of functioning as trademarks, the Federal Circuit has sustained the admission of expert testimony and excerpts from treatises and manuals regarding the custom of guitarists to identify guitars by the shape of the guitar heads.³⁶¹ Such evidence, indicative of the *likelihood* that a feature of a particular product would serve to identify source, is relevant (and, indeed, more appropriately so) to the question of inherent distinctiveness.³⁶² In *Krueger International, Inc. v. Nightingale Inc.*,³⁶³ the court based a finding of inherent distinctiveness on affidavits regarding the high density stacking chair market: “[M]anufacturers of these chairs generally seek unique designs as an important source identifier. Unlike the clothing industry, in which labels are prominent because designs change frequently, the chair industry does not rely heavily on labels to communicate with customers and its designs remain stable over time.”³⁶⁴ Courts apparently have taken judicial notice, as part of other analyses, of consumer purchasing propensities regarding particular products.³⁶⁵ And courts frequently are made aware of consumer exposure to and experience with brand name/private label retail practices.³⁶⁶ The exposure of the

361. See *Yamaha Int'l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 1582-83 (Fed. Cir. 1988).

362. The court did not consider how that evidence might be relevant to inherent distinctiveness because the applicant had based its application on secondary meaning under section 2(f) of the Lanham Act. See *id.* at 1581.

363. 915 F. Supp. 595 (S.D.N.Y. 1996).

364. *Id.* at 607.

365. See *Seabrook Foods, Inc. v. Bar-Well Foods Ltd.*, 568 F.2d 1342, 1346 (C.C.P.A. 1977) (Rich, J., dissenting) (“[F]rozen foods . . . are purchased . . . as everyone knows, to a large degree on the basis of package appearance as well as by the name of the producer or specific word marks.”).

366. See, e.g., *Conopco, Inc. v. May Dept. Stores Co.*, 46 F.3d 1556, 1565 (Fed. Cir. 1994), *cert. denied*, 115 S. Ct. 1724 (1995); *Warner Lambert Co. v. McCrory's Corp.*, 718 F. Supp. 389, 398-99 (D.N.J. 1989). The *Conopco* court also received testimony from an

relevant purchasing public (i.e., likely purchasers of that type of product) to such practices, which may affect the likelihood that consumers will identify the product by reference to its shape, would be particularly valuable evidence.³⁶⁷

Consumer receptiveness to identification by shape might also be suggested by showing the typical manner in which goods of that type are presented to or seen by prospective purchasers, thus assisting a prediction of likely association with shape rather than (or in addition to) a verbal mark. Likely consumer association with product design might be minimized if goods of that type are seen only rarely absent packaging or other more traditional indicia of source. In *Munsingwear, Inc. v. Jockey International, Inc.*,³⁶⁸ the plaintiff claimed trade dress rights in the design of its underwear. Each party adduced evidence regarding the degree of consumer exposure to the product design in an unpackaged state. The defendant's evidence included testimony as to the manner in which the product was displayed (on mannequins), purchased (in clear wrapping bearing manufacturers' names), and as customarily used by consumers (in a manner not visible to the general public). The purpose for which the evidence was elicited was to demonstrate the minimal risk of post-sale confusion. The generally concealed nature of underwear not only reduces that possibility, but also arguably reduces the likelihood of consumer association developing in the first place.³⁶⁹ In contrast, if products are routinely presented to the public and seen by the public in an unwrapped state, it is more likely that the product design will act as a

expert in consumer psychology regarding the attention paid by consumers to a particular form of labeling (obscurely placed disclaimer in small print). See *Conopco*, 46 F.3d at 1572 (Mayer, J., concurring in part, dissenting in part).

367. See *Badger Meter, Inc. v. Grinnell Corp.*, 13 F.3d 1145, 1152-53 (7th Cir. 1994) (addressing likelihood of confusion, wherein the court refers to evidence of knowledge of private labeling practices within the market for small water meters, primarily water utilities); see also *Duraco Prods. v. Joy Plastic Enters.*, 40 F.3d 1431, 1435 (3d Cir. 1994) (noting that brand-name awareness in the outdoor garden products area is slight).

368. 31 U.S.P.Q.2d (BNA) 1146 (D. Minn. 1994).

369. While the *Munsingwear* court is probably correct that "[t]he lack of post-sale exposure of the product to the general public reduces the risk that any customers will be confused as to source," *id.* at 1150, it does not preclude the possibility. Post-sale confusion (and consumer reliance on product design as a source-identifier) is more easily dismissed if one assumes an identity of the first purchaser and the wearer of the underwear. If, in fact, the product was purchased by someone-else, the wearer might never have been exposed to the point-of-sale verbal marks or wrapping, and thus might be more likely to rely on the product design as a means of source-identification (and perhaps may be confused in purchasing subsequent products on that basis). Further evidence of purchasing patterns might, therefore, affect the strength of this observation in particular cases.

source-identifier.³⁷⁰

c. Nature of the Product

Even without contextual evidence of how products are typically presented to the public, the very nature of the product itself might act as a predictor of likely reliance on shapes. Evidence that might be relevant in this regard is also often considered in analyzing likelihood of confusion. In *Chevron Chemical Co. v. Voluntary Purchasing Groups, Inc.*³⁷¹ for example, the court considered, but dismissed, the likelihood that consumers would read the packaging label rather than rely on the overall appearance of the packaging trade dress because of the nature of the products at issue (toxic garden products).³⁷² For reasons of safety or decency, certain products are more likely than others to be displayed away from eye level, reducing the scope for reliance on verbal marks.³⁷³ Where the product design is the most accessible signifier, reliance on it should be more likely.³⁷⁴

A court might also consider whether the nature of the product is such that producers are incapable of using supplementary words or packaging to identify the product.³⁷⁵ Products that are small, or the surface of which is not susceptible to marking, clearly will not bear prominent word marks, thereby compelling consumers to differentiate on some other basis.³⁷⁶ The shape of a Phillips screw, for example,

370. The same may be true of products that are typically sold or seen in transparent and unmarked packaging. *Cf. Aromatique, Inc. v. Gold Seal, Inc.*, 28 F.3d 863, 873-74 (8th Cir. 1994) (potpourri).

371. 659 F.2d 695 (Former 5th Cir. 1981).

372. *See id.* at 704; *see also* *Dr. Seuss Enters. v. Penguin Book USA, Inc.*, 924 F. Supp. 1559, 1571 (S.D. Cal. 1996) (“[B]ooks are mixed search-experience goods that are generally perused but not fully inspected before purchase.”); *id.* at 1571 n.18 (referring to academic literature regarding search and experience goods and noting that “[s]earch goods are goods whose quality consumers can inspect before purchase [while e]xperience goods . . . may be evaluated only after purchase and consumption”).

373. *Cf. Shakespeare Co. v. Silstar Corp. of Am.*, 906 F. Supp. 997, 1011 (D.S.C. 1995) (explaining that eye level display of fishing rods facilitated consumer awareness of prominently displayed manufacturers’ names).

374. *See Landes & Posner, supra* note 342, at 291; *see also* *Krueger Int’l, Inc. v. Nightingale Inc.*, 915 F. Supp. 595, 607 (S.D.N.Y. 1996) (“The sole permanent label is molded into the plastic underneath the seat, where a sophisticated buyer would find it but a less sophisticated one might not. No consumer would see the label without looking for it.”) (considering practices in high density stacking chair market).

375. *See supra* text accompanying notes 261-64.

376. It is also worth noting various items of evidence that would not be highly probative because of reduced value as predictors. In particular, neither intent of the producer, *see supra* Part IV (D)(2)(b)(i), nor the motivation of the purchaser, *see supra* note 208, are reliable indicators.

might be expected to act as an identifier of its source more readily than the Phillips brand name embossed in minute form on the side of the screw.³⁷⁷ Consumers probably do not expect cufflinks to bear a verbal mark because of their size. Thus it is more likely that consumers would identify the source of the Carrick Company's Rennie Mackintosh-style cufflinks by their "trellis and rose" design.³⁷⁸

d. The Need for Evidence

Evidence clearly can, and to enhance accountability and predictability should, be developed to assist a determination of whether a design feature is likely to engender consumer association.³⁷⁹ This approach acknowledges the fact-specific nature of the bases for the analysis and the varying likelihood that a shape, however classified, would act as a source identifier. It might well lead (even inevitably or appropriately) to greater numbers of inherently distinctive packaging than product configurations, and to greater numbers still of inherently distinctive verbal marks.³⁸⁰ Each claimed mark would be

377. Cf. *Qualitex Co. v. Jacobsen Prods. Co.*, 115 S. Ct. 1300, 1308 (1995) (recognizing that a firm might find it difficult to "place a usable symbol or word on a product (say, a large industrial bolt that customers normally see from a distance)," and that in such instances the manufacturer might wish to use color alone to identify the product). Trade dress protection of the shape of the "Phillips screw" (which has become a standard feature of many consumer products) might, of course, now implicate the competitive concerns at the root of the functionality exclusion. See *supra* note 79.

378. The Rennie Mackintosh Collection, which is based on the designs of the celebrated Scottish artist and architect Charles Rennie Mackintosh (1868-1928), is a series of jewelry pieces produced by the Carrick Jewellery of Glasgow, Scotland. The "trellis and rose" pattern is derived from the decor of the Willow Tea Rooms, which Mackintosh designed in 1903. See generally ELIZABETH WILHIDE, *THE MACKINTOSH STYLE: DESIGN AND DECOR* (1995). The Carrick Jewellery probably would not face the problems in proving distinctiveness encountered by the manufacturer of reproduction Stickley-design furniture, see *supra* note 35, because Mackintosh never applied his designs to jewelry. See Fiona MacCarthy, *Glasgow Nouveau Charles Rennie Mackintosh Was Honoured Everywhere But In His Home City: That Is The Legend, But It's Not True*, *GUARDIAN* (London), April 13, 1996, at T044.

379. Cf. *Remcraft Lighting Prods., Inc. v. Maxim Lighting, Inc.*, 706 F. Supp. 855, 858 (S.D. Fla. 1989) (commenting that question of inherent distinctiveness is a question of fact requiring evidence regarding whether the design is sufficiently distinct that it can be differentiated from other products).

380. A review of existing case law suggests that lines of furniture, jewelry, unwrapped products, and products of a type never marked would probably represent the products with the greatest chance of demonstrating likely consumer association. Courts have not attempted to develop the evidence discussed here for the purpose of predicting likely consumer association, however, and the opportunity to make an argument of likely association should not be limited to particular products. If the empirical basis for making the prediction can be shown, advancement of the argument should be permitted without introducing additional hurdles for product design plaintiffs.

assessed by the same yardstick, however, avoiding both the arbitrariness of classification and the prejudging of ultimate issues involved in holding claimants to different standards based on premises that do not necessarily equate with the facts of a particular case. There is no reason, by formulating a fixed legal rule, to entrench a particular perspective concerning the factual question of the likelihood that a product would be identified by its shape.³⁸¹

That courts might (and, other than *Seabrook* courts, largely do) shrink from such an approach is hardly surprising in light of a dearth of explanation or empirical support for judgments made on the likelihood that verbal marks will immediately operate as source-identifiers. With word marks, the factual record often comprises little more than reliance on judicial notice of the English language—although that can, in part, be attributed to judicial knowledge of the English language operating as empirical evidence of meaning.³⁸² The proposal advanced in this Article seeks to refocus the inherent distinctiveness inquiry and create a workable test for trade dress in an age where word marks are no longer the sole means of source-identification. Examining the commercial context of a product is crucial to a secondary meaning analysis of actual association, and there is nothing to suggest that such contextual consideration could

381. Although in particular factual contexts consumers might not primarily rely on product configuration to identify source, embedding an overly-generalized premise in the governing test appears destined not to identify those product designs that truly are inherently distinctive. The incorporation of factual premises into a rule of law might be justified on grounds of efficiency, of predictability, of equal treatment, or on other public policy bases such as placing the burden of proof on the party in whose possession evidence to contradict the premise is most likely to be found. See generally Cass R. Sunstein, *Problems With Rules*, 83 CAL. L. REV. 953, 971-77 (1995) (articulating benefits of rules). Neither the *Duraco* nor the *Knitwaves* court provided any such justifications for the creation of a stricter test for product configurations. Competitive concerns can be accommodated by applying the functionality rule, and the relative likelihood of product and packaging shapes identifying source should adequately be measured by asking that very question rather than creating rules designed to *ensure* the outcome thought generally likely to ensue.

I have argued in this Article that there is no need to impose a blanket assumption regarding likely consumer response, and that, instead, resort should be had to empirical evidence regarding actual association or the basis for likely consumer response. Of course, the analogous argument failed in *Two Pesos*, where the Supreme Court rejected the assertion that where empirical evidence of distinctiveness (in the form of secondary meaning, or lack thereof) was available, it should prevail over judicial predictions or presumptions regarding distinctiveness (inherent distinctiveness). See Brief for Petitioner at 16 n.8, *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992) (No. 91-971) (on file with author); see also *supra* note 76.

382. See *supra* note 108.

not also inform an analysis of inherent distinctiveness.³⁸³

3. Assessing Alternatives in Distinctiveness Inquiries

Any such test, in common with the *Seabrook* test, obviously would pay heed to other products on the market, thus bearing a superficial similarity to the functionality inquiry.³⁸⁴ In this Article, I have suggested that the functionality inquiry be separately conducted further along in the trade dress analysis, thus striking a balance between the imposition of unreasonable constraints on creation and the potential purchaser confusion that could arise with a second-comer's unregulated use of a shape with which consumers have come to associate a specific source.³⁸⁵ Whether a trade dress is distinctive is a question wholly separate from the matter of its functionality. The functionality of a dress need not even be considered if distinctiveness is not established.³⁸⁶

In practice, courts and litigants habitually conflate arguments addressed to each of these separate questions.³⁸⁷ Indeed, in many instances courts have directly adverted to functionality in determining whether a mark is distinctive.³⁸⁸ Language in those opinions fuses the

383. "Trademark strength is an 'amorphous concept with little shape or substance when divorced from the mark's commercial context.'" *McGregor-Doniger, Inc. v. Drizzle, Inc.*, 599 F.2d 1126, 1133 (2d Cir. 1979) (quoting *E.I. DuPont de Nemours & Co. v. Yoshida Int'l*, 393 F. Supp. 502, 512 (E.D.N.Y. 1975)).

384. Although the *Abercrombie/Chevron* test does not mandate such a comparison, courts purporting to apply that test often look at the range of alternatives in assessing inherent distinctiveness, perhaps because the *Chevron* court cited the unlimited packaging alternatives in support of the concept of inherently distinctive trade dress. *See supra* note 104.

385. *See supra* notes 89-101 and accompanying text.

386. *See Turtle Wax, Inc. v. First Brands Corp.*, 781 F. Supp. 1314, 1323 n.12 (N.D. Ill. 1991) (functionality need only be addressed once plaintiff has established a protectable trade dress); *see also Schwinn Bicycle Co. v. Ross Bicycles, Inc.*, 870 F.2d 1176, 1183 n.14 (7th Cir. 1989) (functionality to be addressed separately from distinctiveness); *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1343 (C.C.P.A. 1982) (same); UNITED STATES DEPARTMENT OF COMMERCE, TRADEMARK MANUAL OF EXAMINING PROCEDURE § 1202.03(a) (2d ed. 1993) (distinctiveness and functionality should be analyzed separately).

387. *See Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996, 1006 (2d Cir. 1995) (arguments raised by defendant "under rubric of functionality, however, support a related (and more successful) argument," namely that the claimed trade dress was not distinctive); *see also Krueger Int'l, Inc. v. Nightingale Inc.*, 915 F. Supp. 595, 603-04 (S.D.N.Y. 1996) (noting that several tests of distinctiveness are essentially tests of functionality); *Carillon Importers Ltd. v. Frank Pesce Group*, 913 F. Supp. 1559, 1564 (S.D. Fla. 1996) ("In many ways, functionality is a close corollary to distinctiveness, and it reinforces the idea that the law protects a product's image in the mind of a consumer rather than aspects of a product that are required for its use.").

388. *See, e.g., Sno-Wizard Mfg. v. Eisemann Prods.*, 791 F.2d 423, 427 n.4 (5th Cir.

two inquiries, frequently defining functionality in contradistinction to distinctiveness.³⁸⁹ It is from conceptual confusion such as this that consideration of competitive impact inappropriately enters the distinctiveness evaluation. The confusion is often spawned by language in *Chevron* and is most prevalent in courts applying that test.³⁹⁰ One

1986); *Sicilia Di R. Biebow & Co. v. Cox*, 732 F.2d 417, 425 (5th Cir. 1984) ("If a particular configuration or design is found to be inherently or sufficiently distinctive, it cannot also be functional in the legal sense."); see also *Allied Mktg. Group, v. CDL Mktg., Inc.*, 878 F.2d 806, 813 n.6 (5th Cir. 1989) ("In *Sicilia*, we noted that a configuration or design that is sufficiently distinctive cannot also be functional in a legal sense."); *Dorr-Oliver Inc. v. Fluid-Quip, Inc.*, 894 F. Supp. 1190, 1198 (N.D. Ill. 1995) (analyzing inherent distinctiveness by reference to functionality and number of alternative designs, and then separately addressing functionality as an affirmative defense), *rev'd on other grounds*, 94 F.3d 376 (7th Cir. 1996); cf. *Kurt S. Adler, Inc. v. World Bazaars, Inc.*, 897 F. Supp. 92, 96-97 (S.D.N.Y. 1995) (analyzing inherent distinctiveness by reference to whether protection would foreclose competitors from using utilitarian or aesthetic features necessary to compete).

389. See, e.g., *Sicilia Di R. Biebow & Co.*, 732 F.2d at 425 & n.3 ("To find legal functionality is to find that plaintiff's trade dress does not serve as a trademark. . . . A trade dress feature is distinctive if it is arbitrary or fanciful and not descriptive or functional."); see also *In re DC Comics, Inc.*, 689 F.2d 1042, 1049 n.5 (C.C.P.A. 1982) (Rich, J., concurring) (noting confluence in some courts of functionality and distinctiveness, and of aesthetic functionality with secondary meaning in particular); cf. *Versa Prods. Co. v. Bifold Co.*, 50 F.3d 189, 197-98 n.5 (3d Cir. 1995) ("[The] district court concluded that the trade dress was inherently distinctive because it was 'arbitrary,' meaning it was not 'dictated by functional considerations' (which appears to be the same standard the court employed for its functionality inquiry)."). The dichotomy is often set up from the opposite starting point. See, e.g., *Dratler*, *supra* note 8, at 939 ("[F]eatures of an article that merely serve to identify the source or sponsorship of the article are not functional and can serve as trademarks."). The best explanation offered for a connection between the two concepts has been served up by Professor McCarthy:

A subsidiary reason against the protection of functional features may be that the distinctiveness of a symbol varies in inverse proportion to its functionality. If a feature is functional, it is likely that all similar articles will have a similar functional feature, and one seller's feature is not likely to evoke any response in buyers that it is unique or is a distinctive symbol of origin.

1 MCCARTHY, *supra* note 1, § 7.26[1], at 7-118. But see *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1343 (C.C.P.A. 1982) ("We cannot say that there exists an inverse proportional relationship in all cases between distinctiveness of design and functionality."). Even this explanation, to some extent, misses the precise point. The likelihood that consumers would not distinguish the product because of several similar designs flows from the presence of such designs, which may be the result of a great variety of factors. The competitive need to design the product in that particular shape (functionality) may be one such reason, but there may be others unrelated thereto. Similarly, the mere fact that a product is legally functional (in the sense that to protect it against copying would cause competitive problems) might not affect distinctiveness if the product is as yet the only such product on the market.

390. See, e.g., *Stuart Hall Co. v. Ampad Corp.*, 51 F.3d 780, 786 (8th Cir. 1995) ("The question [the *Abercrombie* definitions] present is whether, and how much, the trade dress is dictated by the nature of the product. . . ."); *Krueger*, 915 F. Supp. at 603 (commenting that *Chevron* test is "essentially a test of functionality"); see also *supra* notes 92, 104 (discussing the role of competitive need and lack of alternatives in distinctiveness analy-

court in the Northern District of Illinois has insightfully explained that these courts use the term "functionality" in two senses:

[The first use of the term] relates only to application of the *Chevron* test and to [the] conclusion that the trade dress is nonarbitrary in that it serves a 'function' to describe plaintiff's product and to assist in its effective packaging. . . . Such a functionality analysis requires a completely different inquiry than that involved in the consideration of a functionality defense to trade dress infringement.³⁹¹

The confusion exhibited (and engendered) by some of these courts can perhaps also be explained by the close parallels between the functionality doctrine and the concept of generic marks, the latter of which clearly implicates the distinctiveness inquiry.³⁹² Both require that trademark law be wary of according protection to a mark that is approaching the status of an industry standard, and many commentators have acknowledged the similarities.³⁹³ Consider the hypothetical example of "packaging lime-flavored soda in green twelve-ounce cans," discussed by the Second Circuit in *Paddington Corp. v. Attiki Importers & Distributors, Inc.*³⁹⁴ The court suggested that such packaging trade dress would be generic because it is "so common in the soft drink industry that such packaging probably is not inherently distinctive, although without the industry practice green cans would be either suggestive or arbitrary and therefore inherently distinctive."³⁹⁵ Other courts, if faced with that example, might have as easily avoided awarding the exclusive rights to use green cans to one soda company by invoking the doctrine of functionality. The rationale for doing so would, however, be different. Those courts basing their decision on

sis).

391. *Turtle Wax, Inc. v. First Brands Corp.*, 781 F. Supp. 1314, 1322-23 n.12 (N.D. Ill. 1991); see also *Duraco Prods. v. Joy Plastic Enters.*, 40 F.3d 1431, 1451 (3d Cir. 1994) ("[T]he primarily source-designating inquiry is different from the functionality inquiry, for it limits inherently distinctive product configurations not to those that are important for competitors to be able to copy, but rather to those whose primary significance is as an intrinsic indicator of the product's source.").

392. See *In re DC Comics, Inc.*, 689 F.2d 1042, 1048 (1982) ("[A] finding of . . . functionality is, in a sense, similar to a rejection for genericness."); see also *Duraco*, 40 F.3d at 1442 ("In trade dress law, the inquiry into functionality resembles the genericness inquiry in trademark law; the two doctrines share essentially the same underlying rationale, preserving competition.").

393. See, e.g., *Dratler*, *supra* note 8, at 951-52 (comparing functionality doctrine with test for genericness); cf. *Hudis*, *supra* note 152, at 9 (noting that functionality is "akin to the concept that generic words or phrases are not capable of trademark protection, because a single proprietor cannot appropriate common vernacular from the English language used to refer to products").

394. See 996 F.2d 577, 583-84 (2d Cir. 1993).

395. *Id.* at 583-84.

the genericism doctrine premise their conclusion on the green cans no longer representing a single source. The packaging would not be distinctive.³⁹⁶ Those courts permitting copying on the basis of functionality would in essence be determining that it was not possible to compete effectively in the soda market unless able to sell the soft drink in green cans.³⁹⁷

Clearly, also, similar evidence may impinge upon both the issue of inherent distinctiveness and the analysis of functionality. The perspective with which a court views alternative products for the purpose of the inherent distinctiveness test should, however, be quite different from how it regards similar (but not necessarily identical) evidence in determining functionality. Competing products or shapes might speak to several assorted concerns and be probative of various matters.

Products of the same shape are relevant to inherent distinctiveness because consumer association is more likely to exist where there are no similar shapes to blur consumer perception of specific affiliation. It is the *current (or recent past)* presence on the market of products of the same shape, however, that might suggest a lesser likelihood of consumer reliance on a shape as a source-identifier.³⁹⁸

396. See 15 U.S.C. § 1064(3) (1994) (whether registered mark has become generic is to be determined by primary significance of the mark to the public; no mention of competitive consequences). *But see Duraco*, 40 F.3d at 1440 (explaining generic doctrine in terms of competitive consequences).

397. *But see Dratler, supra* note 8, at 951-52 (suggesting alternative difference in purpose: functionality doctrine preserves integrity of the patent system, while generic doctrine preserves competition). The basis upon which a court denied full relief to the plaintiff in the green can hypothetical might be of importance, in that if the dress is distinctive but functional, the court might require the copier to label its competing product in order to differentiate it from plaintiff's. See *supra* text accompanying notes 97-99.

398. See, e.g., *Tone Bros., Inc. v. Sysco Corp.*, 28 F.3d 1192, 1206 (Fed. Cir. 1994) ("[T]he inherent distinctiveness of a trade dress depends on what other types of trade dress were being used in the particular field prior to the introduction of the trade dress at issue."), *cert. denied*, 115 S. Ct. 1356 (1995); *Paddington Corp. v. Attiki Importers & Distrib., Inc.*, 996 F.2d 577, 583-84 (2d Cir. 1993) ("[P]ackaging lime-flavored soda in green twelve-ounce cans is so common in the soft drink industry that such packaging probably is not inherently distinctive, although *without the industry practice* green cans would be either suggestive or arbitrary and therefore inherently distinctive." (emphasis added)); *Callaway Golf Co. v. Golf Clean, Inc.*, 915 F. Supp. 1206, 1212 (M.D. Fla. 1995) (finding product design inherently distinctive and noting that "when [plaintiffs] introduced their Big Bertha irons in 1994 they looked noticeably different than any other club on the market"); *Black & Decker Corp. v. Int'l Sales & Mktg.*, 36 U.S.P.Q.2d (BNA) 1851, 1853 (C.D. Cal. 1995) (trade dress of "SnakeLight" flashlight inherently distinctive given lack of prior similar design in marketplace); *Philip Morris Inc. v. Star Tobacco Corp.*, 879 F. Supp. 379, 383 (S.D.N.Y. 1995) ("This trade dress is inherently distinctive . . . [N]o cigarette manufacturer had evoked the image of the American West for the purpose of selling a particular brand until the Marlboro Man saddled up and rode into Marlboro country.");

The predictive calculation of inherent distinctiveness should not be affected by whether the same product *could* be manufactured and sold competitively in another or only the same shape. Unknown, as-yet undeveloped or unmarketed, possible alternatives do not affect the likelihood that consumers will identify the shape with a specific source because consumers are probably unaware of those possibilities. The evidentiary inquiry, therefore, should simply be whether there are other products of similar shapes commonly on the market.³⁹⁹ The only means by which the lack of possible alternatives might affect inherent distinctiveness is if that dearth of options is reflected in general, commonplace use of the product feature.⁴⁰⁰ In that case, however, it is the prevalence of many similar products, rather than the absence of alternatives that led to that phenomenon, which detracts from the claim of inherent distinctiveness.

The functionality analysis considers whether it is competitively possible for the shape of a rival product to be different from the plaintiff's trade dress. There are two dimensions to this inquiry that set it apart from the determination of inherent distinctiveness. First, it requires analysis of the chances of an alternative shape being pro-

Blue Coral, Inc. v. Turtle Wax, Inc., 664 F. Supp. 1153, 1163 (N.D. Ill. 1987) (“[I]n deciding whether a trade dress is inherently distinctive . . . we still must consider how unique this new compilation is in comparison to what is already in the field.”).

399. See *Paddington*, 996 F.2d at 584 (finding trade dress of Ouzo bottle inherently distinctive where “[t]here is no evidence in the record of any industry practice of using a design like the one that appears on the bottles’ labels”); *Roulo v. Russ Berrie & Co.*, 886 F.2d 931, 936 (7th Cir. 1989) (determining inherent distinctiveness by analysis of evidence of greeting cards already on the market), *cert. denied*, 493 U.S. 1075 (1990); *Hanig & Co. v. Fisher & Co.*, No. 92 C 1779, 1994 WL 97758, at *6 (N.D. Ill. Mar. 24, 1994) (“In order to determine whether a trade dress is distinctive, it is necessary . . . [to] compare it with the trade dress of competitors. A trade dress that might be distinctive in the first instance will not be seen as distinctive if similar ones are common in the marketplace.”); *Turtle Wax, Inc. v. First Brands Corp.*, 781 F. Supp. 1314, 1320-21 (N.D. Ill. 1991) (finding lack of inherent distinctiveness because dress consisted of elements that were already present in the relevant market); *Robarb, Inc. v. Pool Builders Supply of the Carolinas, Inc.*, 696 F. Supp. 621, 625 (N.D. Ga. 1988) (no evidence presented which shows that third party usage has been so extensive as to undermine inherent distinctiveness of trade dress of plaintiff's pool cleaner, which had been first of its type on the market). In *Duraco Products v. Joy Plastic Enterprises*, 40 F.3d 1431 (3d Cir. 1994), for example, the court was presented evidence regarding (1) the similarity between the plaintiff's product and all others in the market; (2) “patently different” designs that competitors had come up with; and (3) “five designs by [plaintiff's] expert designer that . . . could compete effectively in the market.” *Id.* at 1436. The third set of evidence would be relevant only to functionality.

400. See *Mana Prods. v. Columbia Cosmetics Mfg.*, 65 F.3d 1063, 1070 (2d Cir. 1995) (“[W]hen the possibilities of the ultimate trade dress for a product are limited *and the trade dress is therefore in commonplace use*, it is unlikely that consumers will view the trade dress as distinctive of the goods or services of a particular seller.” (emphasis added)).

duced and marketed *competitively*. The mere fact that some alternative is available is not determinative of that issue.⁴⁰¹ Second, the functionality analysis should extend (but not limit) its scrutiny to any other possible shapes, even if they are not yet available on the market, i.e., courts evaluating functionality should consider products that *could* be introduced to the market as well as those already on the market.

In sum, whereas distinctiveness will be harmed by evidence of *many available similar* designs, nonfunctionality will be adversely affected by a *lack of possible different* designs, necessitating a still more conjectural inquiry into competitive possibilities rather than current market perception.⁴⁰² The evidence that informs those two analyses may well be similar, but the analyses are different and the policy concerns divergent.⁴⁰³

CONCLUSION

In the modern consumer marketplace product design features may simultaneously serve many purposes, including aesthetic, functional and identificatory. Product designs can and do serve to

401. "Functionality does not depend on whether other possible designs are feasible. Rather the test is whether the particular features claimed as a trademark are necessary for effective competition." *Ohio Art Co. v. Lewis Galoob Toys, Inc.*, 799 F. Supp. 870, 885 (N.D. Ill. 1992) (citations omitted); *see also* *Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571, 1580 (Fed. Cir. 1995) (availability of alternative designs alone does not determine functionality issue where not shown that those alternatives substantially eliminate any competitive need for the claimed features); *Keene Corp. v. Paraflex Indus., Inc.*, 653 F.2d 822, 827 (3d Cir. 1981) ("[M]erely because there are other shapes and designs 'which defendant could use and still produce a workable' product, the design used is not thereby non-functional."); *Interactive Network, Inc. v. NTN Communications, Inc.*, 875 F. Supp. 1398, 1407 (N.D. Cal. 1995) ("Where a feature is the best one, or one of a few superior designs, competition would be hindered by a monopoly on this scheme."). *See generally* *Dinwoodie*, *supra* note 17, at 33-35 (discussing relevance of alternatives to functionality inquiry).

402. *Compare* *AmBrit, Inc. v. Kraft, Inc.*, 812 F.2d 1531, 1537 (11th Cir. 1986) (rejecting challenge to inherent distinctiveness, and noting that "the record reveals no *prior* use of any combination of the [product's] trade dress elements that is at all *similar* to the unique impression conveyed by [plaintiff's] trade dress" (emphasis added)), *with* *Stormy Clime, Ltd. v. ProGroup, Inc.*, 809 F.2d 971, 978 (2d Cir. 1987) (noting that, in determining functionality, district court should have considered whether any *feasible* shingled rain jacket *could* be manufactured that would not appear similar in key respects to that of plaintiff).

403. Courts too easily and too frequently elide these distinctions. *See, e.g.*, *Vornado Air Circulation Sys., Inc. v. Duracraft Corp.*, 92-1543-WEB, Memorandum and Order at 28 (D. Kan. Mar. 4, 1994) (design of fan not arbitrary or fanciful where, because of consumer performance expectations and economic limitations, the universe of *feasible* designs was limited) (on file with author), *rev'd on other grounds*, 58 F.3d 1498 (10th Cir. 1995), *cert. denied*, 116 S. Ct. 753 (1996).

identify the source of products; they can, in the trademark vernacular, be distinctive. Trademark law must accept that reality and refrain from relegating product design trade dress to a second-class status. The common-law rule requiring trade dress to demonstrate secondary meaning as a condition to protection effected just that discriminatory treatment, exposing trade dress to imitation in the early stages of marketing.

The arguments advanced in support of this unequal treatment do not hold water. There is no reason, either in the text of the Lanham Act or on broader policy grounds, to deny a producer the opportunity to prove the distinctiveness of its product's design by means available to other marks. The Supreme Court's acceptance of this argument in *Two Pesos*, however, merely opened an equally significant debate. Neither in *Two Pesos*, nor in its later *Qualitex* opinion, does the Court provide the solution to the distinctiveness conundrum: how a producer should demonstrate the inherent distinctiveness of its product design trade dress.

The answer to this question must derive from the notion central to the concept of inherent distinctiveness, namely, whether consumers are likely to perceive the product design as a source-identifier. The competitive impact of protecting the product feature as a trademark is of no relevance to the question of distinctiveness, but instead should be addressed by the later application of the rule against the protection of functional designs. This approach balances concerns surrounding two equally anti-competitive situations: the imposition of unreasonable constraints on creation, and potential purchaser confusion that could arise with a second-comer's unregulated use of a shape with which consumers have come to associate a specific source.

Determination of inherent distinctiveness is thus a predictive inquiry. However, while the well-tested *Abercrombie* analysis exists to assist in this inquiry for verbal marks, that form of appraisal does not make a successful transition to product design. Its defining concepts—descriptiveness and suggestiveness—are linguistically conditioned. The limits of lexicon and established usage thus mesh with the substance of the test to provide invaluable guidance on likely consumer perception. Product design features are not subject to the same constraints on comprehension or meaning as words, and do not fit easily within the linguistic concepts at the heart of the *Abercrombie* analysis.

Those courts that have adopted *Abercrombie* to assess the inherent distinctiveness of product design in the wake of *Two Pesos* have recognized a significantly increased number of inherently distinctive

product configurations. However, those decisions evince intuitive judging, and fail to reveal (as they must) the basis for a prediction that the product design features being protected will give rise to consumer association. To the extent that any less intuitive analysis is being conducted, it is misdescribed by explanation in terms of the *Abercrombie* concepts.

Courts must thus acknowledge not only the similarities that verbal and non-verbal marks possess when functioning as trademarks, but also the differences required of the precise means by which we assess our understanding of words and shapes. Both the Second and Third Circuits have recognized this fact, and the deficiencies of *Abercrombie* it reveals, in devising a different test by which to adjudicate the inherent distinctiveness of product designs. The respective tests formulated by each to replace *Abercrombie* fail, however, to articulate an appropriate vision of distinctiveness. Each provides significantly more slender protection for product design by holding product design to a higher standard of inherent distinctiveness than other forms of trade dress. That higher standard is implemented by tests that focus inappropriately on the intent of the producer, and that repudiate judicial recognition of the capacity of product designs simultaneously to comprise the product and to identify source. Intent is of little relevance to the concept of distinctiveness, which is founded on consumer association. And, while an increased number of roles played by a product feature reduces the likelihood that it will serve to identify source, acceptance of the dual capacity of designs is too well entrenched to be reversed now by such blatant revisionism.

These tests, by holding product design to a higher standard than other forms of trade dress, repeat the error of courts requiring secondary meaning as a condition to protection. Indeed, particularly for functionalist design, reimposition of the secondary meaning requirement might be what each test has achieved, relegating product configuration once more to a lesser class of source-identifiers. The mere possibility that this is the case could be the catalyst for an erosion of the basis for consumer reliance upon product configurations as indicia of source, which in turn could further reduce the basis for offering designs protection immediately upon use. Such a development would effectively restrict producers' options (and ultimately consumer choice), and also restrict the informational role of trade dress by limiting the range of ways in which the producer can reliably communicate with the consumer.

The distinction between "packaging" and "product design," central to these new tests, rests on questionable foundations. The

arguments advanced by the Second and Third Circuits in support of a different test for each category of trade dress are either irrelevant to the distinctiveness question (in the case of competitive concerns) or reflect inappropriate generalizations of what are highly fact-specific questions concerning likely consumer behavior. The rationale for a stricter test for product design is circular, encourages arbitrariness and incertitude by introducing difficult questions of classification, and may prejudge the issue of likely association. That product designs currently are less likely to operate as source-identifiers should not give rise to forms of analysis that will ensure that result. Consumer understanding is complex and varied. It should not be oversimplified by application of over-generalized assumptions, but instead should be ascertained by application of fact-sensitive tests. For these reasons, I advocate a single standard for all trade dress, requiring a predictive inquiry involving analysis of the commercial background against which the product will be marketed and the prediction made: Is it likely that consumers will identify the product by reference to the features claimed as trade dress? Pertinent predictors would include the nature of the design, the context in which the design is likely to be perceived by prospective purchasers, and the nature of the product. These predictors reflect empirical bases, the grounded justifications upon which courts may reach the conceptual conclusion that consumers are likely to associate the product design with its source.

Trade dress protection is not, and should not be, the sole means by which product design can be protected against unfair imitation. It is, however, an appropriate form of protection for product designs that are distinctive. The confusing reproduction of distinctive product designs appropriates not only the fruit of a manufacturer's creativity, which might be remedied by the patent or copyright laws, but also the goodwill that attaches to that design as a source-identifier. Nothing is more central to the idea of trademark protection; no consequence is more offensive to the notion of fair competition.

The most pressing challenge for courts, which the Supreme Court has thus far declined to accept, is to develop a workable concept of inherent distinctiveness as applied to product design. The intuitive attraction of building on what years of experience have shaped for verbal marks should be resisted. Those were years in which product designs were treated as a second-class identifier. Instead, courts must recognize that the Supreme Court has created a clearing, currently unbounded, the proper development of which re-

quires casting aside the remnants of linguistic analyses and refocusing instead on what inherent distinctiveness is all about. It is about a predictive inquiry, an inquiry about likely consumer response. It is from this reconceptualization that the work must commence, and from which the modes of analysis should not stray far.