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US TRADE DRESS PROTECTABILITY

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US TRADE DRESS PROTECTABILITY

TRADE DRESS



Product Packaging



Product Design

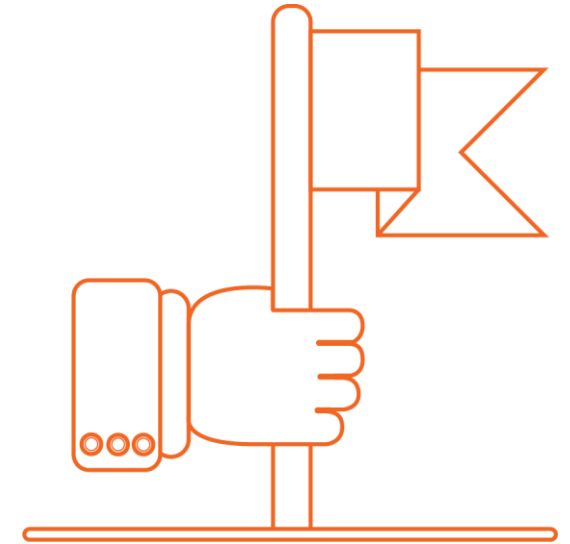


REQUIREMENTS FOR PROTECTION OF TRADE DRESS



1. Distinctive

- Inherent Distinctiveness
 - Available for Packaging Trade Dress ONLY
 - Not Single Product/Packaging Color
 - Not Product Configuration
- Acquired Distinctiveness



2. Non-functional

- Usually at issue in product design cases



INHERENT DISTINCTIVENESS EVIDENCE

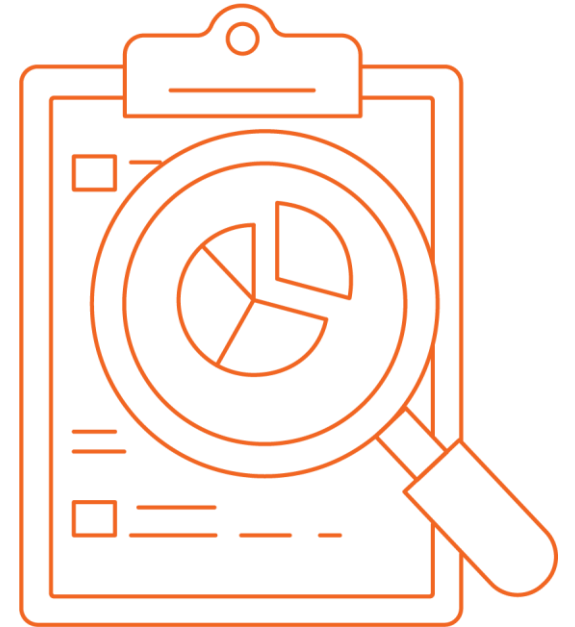
- Common, basic shape or design?
- Unique or unusual in a particular field?
- Mere refinement of commonly adopted or well-known form of ornamentation?



ACQUIRED DISTINCTIVENESS EVIDENCE

Consumer Association with a Single Source:

- Length of use
- Exclusivity of use
- Heavily advertised?
- Significant sales?
- Intentional copying?
- Testimony of industry professionals
- **Consumer survey evidence**



┌ **NON-FUNCTIONALITY EVIDENCE**

- Proving the negative

Claimed trade dress:

- Is not essential to the use or purpose of the product
- Does not affect the product's cost or quality
- Does not create economies of manufacture
- Is not a competitive necessity such that protection would put competitors at a non-reputation related disadvantage





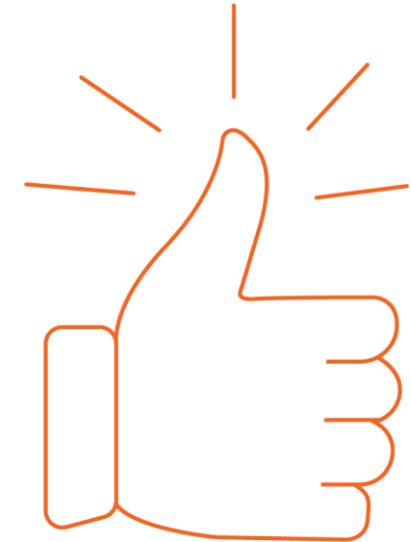
FEDERAL REGISTRATION PRODUCT CONFIGURATION & SINGLE COLOR

┌ FEDERAL REGISTRATION – WHAT'S THE BIG DEAL?

- Relevance in a common law system



- Federal Trademark Registration →
 - Prima Facie Evidence of Validity/Protectability
Exception: Presumption can be rebutted
- Incontestable Federal Registration →
 - Conclusive Evidence of Validity
Exception: Functionality

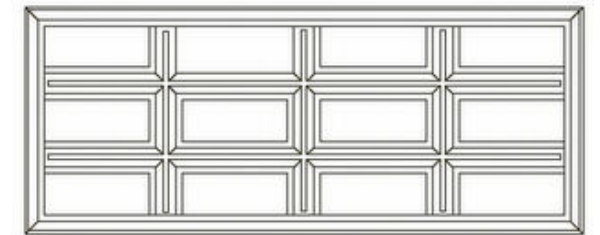


REG. 4322502 (2013) CHOCOLATE BAR CONFIGURATION



ACQUIRED DISTINCTIVENESS EVIDENCE

- **Consumer Survey:** 42% recognition rate among chocolate consumers
- **Exclusive Use:** Since 1968 (40+ years)
- **Sales:** \$4 Billion 1998 – 2010
- **Advertising:** \$186 Million 1986 – 2010

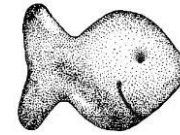


REG. 3290648 (2007) "SMILING FISH" CONFIGURATION

ACQUIRED DISTINCTIVENESS EVIDENCE

- **Exclusive Use:** Since 1997 (10 years)
- **Revenues:** \$2.2B 1997 – 2006
- **Units Sold:** 1.3B Packages 1997-2006
- **Advertising:** \$239M 1997-2006
 - "Look for" ads
- **Media Impressions:** 10B 2001 – 2006

"More than 60% of all U.S. households with children under the age of 12 have **Goldfish** crackers in the household."



「BUT THIN PROTECTION -- “SMILING WHALE?”



PRODUCT SINGLE COLOR REGISTRATION



┌ U.S. APP. NO. 86757390 – REFUSED BY TTAB (2017)



Goods: “Toroidal-shaped, oat-based breakfast cereal”



「ACQUIRED DISTINCTIVENESS EVIDENCE – Yellow Box



- **Length of Use:** 70+ Years
- **Marketing Spend:** \$1 Billion 2005-2015
- **Revenues:** \$4 Billion 2005-2015
- **“Look For” advertising:** TV ads 1991-1997– “big yellow box”
- **Media mentions:** “The iconic cereal known by its distinctive yellow box” - *USA Today*





THIRD-PARTY MAJOR BRAND CEREAL PACKAGING



42



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44



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46



47



48



THIRD-PARTY TOROIDAL OAT CEREAL PACKAGING



31



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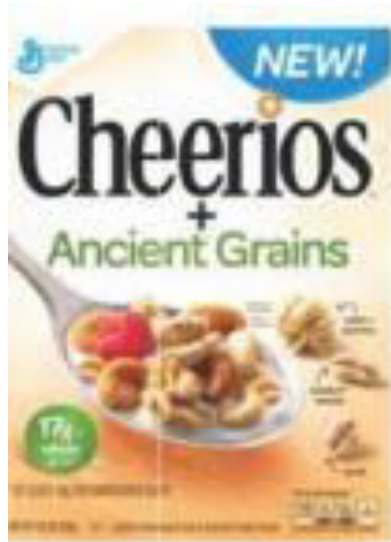
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SELF-INFLICTED WOUND?

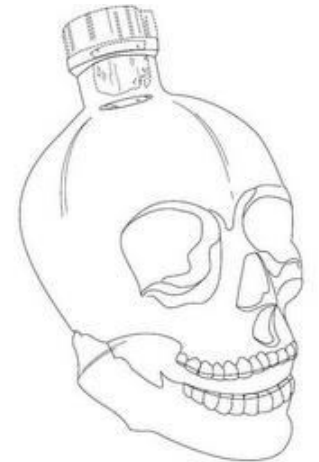




FEDERAL REGISTRATION PRODUCT PACKAGING

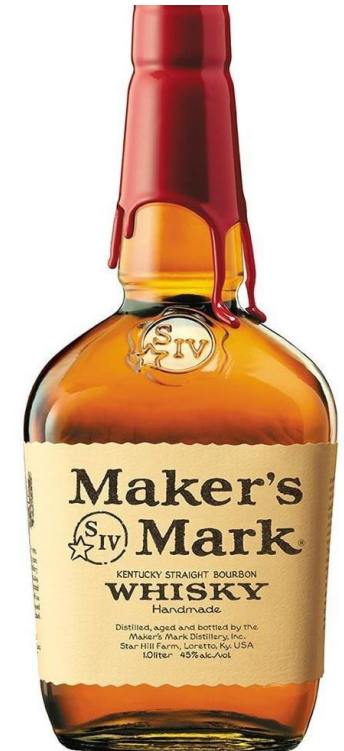
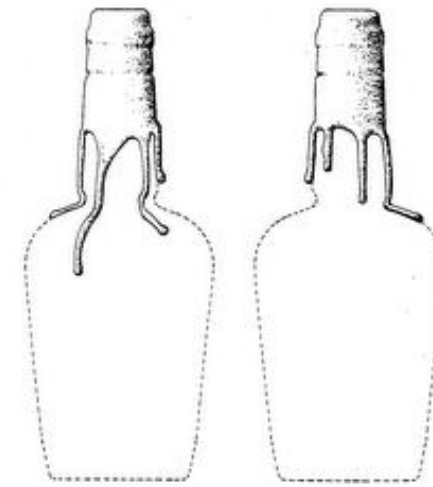
REG. 4043730 (2011) SKULL VODKA BOTTLE

- Registered based on inherent distinctiveness
- Industry award for unique packaging
- Blogs/online reviews mentioning unique shape
- Industry press: "untraditional and impressive packaging"
- General press coverage mentioning unusual shape
 - Celebrity owner/endorser



REG. 1370465 (1985) RED DRIPPING SEAL

- Registered based on inherent distinctiveness
- No evidence or claim of acquired distinctiveness required
- Brief examination – Examiner requested statement for record that Applicant was not aware of use of similar design for alcohol beverage products





└ RECENT PRODUCT PACKAGING CASES

「MAKER'S MARK V. DIAGEO (6TH CIR. 2012)

- Incontestable Registration = validity established
- Lower court and appellate court focused on commercial strength of the mark
- 50+ years of use of the seal
- 22M in annual advertising focused on seal
- Extensive press coverage/reports mentioning the seal



「GLOBEFILL V. ELEMENTS SPIRITS (C.D. CAL.) 2017



- Incontestable registration = conclusive evidence of validity
- Testimony regarding consumer inquiries/potential confusion
- Consumer survey evidence
- Evidence of copying



「COTY V. EXCEL BRANDS (SDNY 2017)」



UNREGISTERED TRADE DRESS CLAIMED



- Opaque black bottle
- Black cap
- CK logo displayed on center portion of bottle and packaging
- SHOCK name displayed in uppercase lettering in neon green graffiti typeface below the CK mark on bottle and packaging

"Although some individual features of a given fragrance . . . may be common in the fragrance industry, the impression given by all of the features in combination is plainly inherently distinctive."



SPANGLER CANDY V. TOOTSIE ROLL (ND OHIO MAR. 13, 2019)





RECENT PRODUCT DESIGN CASES

ADIDAS V. SKECHERS (9TH CIR. 2018)



- Unregistered trade dress
- No functionality claim
- Issue in dispute = acquired distinctiveness



「ACQUIRED DISTINCTIVENESS EVIDENCE



- Exclusive use since 1970s
- Top selling shoe of all time for Adidas
- 40 millionth pair sold in 2014
- Extensive promotions including placements with celebrities, musicians, athletes
- Extensive media coverage: *Time, Elle InStyle, Vogue, Wall Street Journal*
- Frequently appeared on lists of the most influential sneakers of all time
- *Footwear News* 2014 “Shoe of the Year”



LEAPERS V. SMTS (6TH CIR 2018)



Issue = Functionality



UNREGISTERED TRADE DRESS CLAIMED



- Wave-like scalloping with soft, round edges
- Straight, parallel, unbroken lines
- Consistent use of wavelike scalloping at all relevant points on the rifle scope
- Wide banding, with rough proportionality between the raised and lowered portions of the scalloping



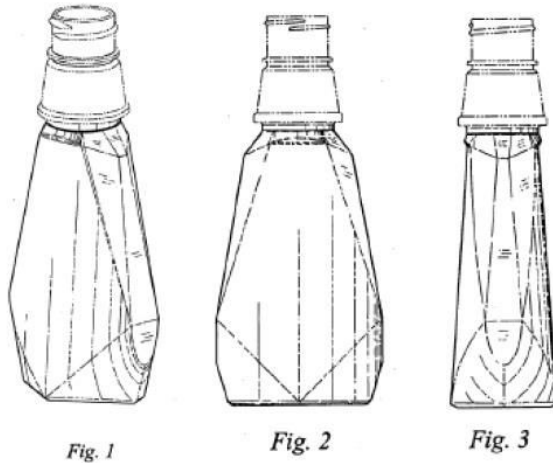
┌ NON-FUNCTIONALITY EVIDENCE



- Plaintiff was unaware of any functional benefit
- Plaintiff designed knurling for aesthetic appeal
- Competitors apply knurling in a wide variety of patterns
- Many of competitors' designs provide superior grip/grasp for the user



STRATEGIES – OTHER FORMS OF PROTECTION



Design Patent – Any new, original, and ornamental design for an article of manufacture (configuration or design applied to configuration)



Copyright – Original creative works

