

TRADE DRESS PROTECTION AND PET ROCKS: ARE BOTH JUST HISTORY?

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I. What is Trade Dress?

- A. Trade dress is the visual image by which the product or service is presented to the relevant consuming public. It can include shape, appearance, and color of the product itself or packaging which is distinctive enough to identify the source of the goods or services. See, 1 J. Thomas McCarthy, Trademarks and Unfair Competition §§ 8:1-8:7, 7:23-7:33 (2d ed. 1984).
- B. Trade dress is protectable as an unregistered trademark under Section 43(a) of the Lanham Act, (15 U.S.C. § 1125(a)), when it is nonfunctional. Trade dress involves the total image of the product or service including size, shape, color, texture, graphics. Trade dress must be either inherently distinctive (See, Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763, 112 S. Ct. 2753 (1992)), or acquire secondary meaning in the relevant market place so as to be identified with a particular producer or source of goods or services. John H. Harland Co. v. Clarke Checks, Inc., 711 F.2d 966, 219 U.S.P.Q. 515 (11th Cir. 1983); LeSportsac, Inc. v. K Mart Corp., 754 F.2d 71, 225 U.S.P.Q. 654 (2d Cir. 1985).
- C. Trade dress can also be registered.

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II. History of Trade Dress Protection.

- A. The elements for a cause of action for trade dress infringement are: (1) the trade dress is inherently distinctive or has acquired secondary meaning; (2) the trade dress is primarily non-functional; and (3) the defendant's trade dress is confusingly similar, creating a likelihood of confusion in the relevant consumer group. Roulo v. Russ Berrie & Co., 886 F.2d 931, 12 U.S.P.Q.2d 1423 (7th Cir. 1989), cert. denied, 493 U.S. 1075 (1990).
- B. Trade dress is governed by trademark law rules and principals and has developed as an arm or trademark law, not a competing body of law. The courts viewed the expansive use of trade dress protection as furthering section 43(a)'s prohibition on the use of any..."word, term, name, symbol, or device, or any combination thereof" which is "likely to cause confusion, or to cause mistake, or to deceive as to the affiliation , connection or association..." of one party's goods an services with another's.
- C. The logic of trade dress law fits with consumer buying patterns--at the grocery, the pharmacy, the hardware store or the department store consumers often spot a product by its distinct packaging, color scheme or shape. A competitor on the shelf with a similar product and package may easily trade on the other products reputation. Traditionally, placing your own trademark on the deceptively similar trade dress did not constitute a defense. Harlequin Enterprises Ltd. v. Gulf & Western Corp., 644 F.2d 946, 210 U.S.P.Q. 1 (2d Cir. 1981); Source Perrier S.A. v. Waters of Saratoga Spring, Inc., 217 U.S.P.Q. 617 (S.D.N.Y. 1982). The test of confusion was not a side by side comparison, but the overall impression created by the trade dress. RJR Foods, Inc. v. White rock Corp., 603 F.2d 1058, 203 U.S.P.Q. 401 (2d Cir. 1979).

III. The Federal Circuit: Don't worry, everybody reads the labels.

- A. The Second Circuit began to chip away at the broad scope of trade dress protection in Bristol-Myers Squibb Co. v. McNeil-P.P.C., Inc., 973 F.2d 1033, 24 U.S.P.Q.2d 1161 (2d Cir. 1992). The court affirmed the finding that defendant McNeil intentionally copied the packaging and colors of plaintiff's successful EXCEDRIN PM product for its competing TYLENOL PM. The court reversed liability however because, it found, the trade name (i.e. trademark) on each product formed the most distinctive and obvious part of the trade dress so confusion would be unlikely. The court did not adopt a per se position that the mere inclusion of your own mark on an otherwise distinctive trade dress of a competitor would always cure the problem of confusion. See also, L.A. Gear, Inc. v. Thom McAn Shoe Co., 988 F.2d 1117, 25 U.S.P.Q.2d 1913 (Fed. Cir.), cert. denied, 114 S. Ct. 291 (1993).
- B. The Federal Circuit has extended this new limited reading of trade dress to almost a per se rule in Conopco, Inc. v. May Dept. Stores Co., 46 F.3d 1556, 32 U.S.P.Q.2d 1225 (Fed. Cir. 1994), cert. denied, 115 S. Ct. 1724 (1995). The court of appeals reversed detailed findings of fact on likelihood of confusion, including testimony of a consumer who bought the defendant's generic hand lotion thinking it was VASELINE INTENSIVE CARE. The trade dress of the generic was identical, except the front contained the Venture department store logo with the words VENTURE INTENSIVE CARE hand lotion. The court found the prominent display of the Venture logo dispositive despite all other evidence. When the decision is read as a whole, the court's reasoning clearly assumes that mass market consumers read the labels before buying. If the Federal Circuit is correct, there is no place for trade dress

law, because no consumer would ever be fooled just by packaging, color scheme, shape or size.

- C. This decision, if taken to its logical limit, means an end to trade dress protection. I know from my own buying habits that the underlying assumption is incorrect. I do not always read the label. Do you? The Conopco decision may equate trade dress protection with pet rocks, just another footnote in history.

NOTE: Trade dress may still be alive in state court actions.