OUTSIDE PERSPECTIVES

Hey, I Know that Look!
Maximizing Trade Dress Rights Before Infringement

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When my little boy sees a red box with a girl on it, he knows the "Sun-Maid" raisins he likes are inside. My husband knows that any black, dome-topped grill is a "Weber," and that the goldfish-shaped crackers in our pantry come from Pepperidge Farm. In order to find my "Cheerios" at the store, I look for the yellow box with the big red heart on it. Without a doubt, my family relies on "trade dress" to recognize our favorite products, and so do countless consumers every day.

"Trade dress" refers to protectible "dress" of a product or service. Usually, "trade dress" refers to the appearance or shape of a product or its packaging. However, it also includes non-traditional trademarks, such as the interior décor of a Chipotle restaurant, NBC's three-chime jingle, or the color of a UPS delivery truck.

The look of a product can act as a symbol conveying a trademark-type meaning, such as a familiar taste, a high quality, or a trusted source. Trade dress rights can be extremely important assets in terms of product reputation and selling power, and can influence purchasing decisions. Moreover, trade dress protection can last forever.

Despite the value of trade dress, many companies do not take any proactive measures to protect it. Taking steps to protect trade dress before it is infringed can significantly aid companies in later enforcement efforts.

Register Trade Dress

In an infringement action, establishing that trade dress is protectible usually involves significant time, effort, and expense. The burdens on a plaintiff can be reduced to a substantial extent if the trade dress is registered with the U.S. Patent and Trademark Office prior to the infringement, for the following reasons:

- Registration constitutes *prima facie* evidence of trade dress validity and of the exclusive right to use the trade dress;
- Registration effectively confers constructive notice of trade dress rights, and can afford actual notice to companies conducting searches;
- After five years, under certain conditions, the registration can become "incontestable," affording it extra protection against attack; and
- In an infringement lawsuit, the owner of registered trade dress does not have the burden of establishing it is not functional as part of its case in chief.

In any trade dress application, care should be taken to identify the elements that together will act as an indicator of source in the minds of consumers. It is not a good idea to register, as trade dress, a number of different variations of the appearance of a product. Doing so can undermine a claim of trademark significance in any one of the design variations.

Beware of Utilitarian Claims

In order for trade dress to be protectible, it must not be functional. "A utility patent is strong evidence that the features therein claimed are functional." *Traffix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 29 (2001). Therefore, trade dress elements should not be identified as part of any utility patent claims.

Along these same lines, companies should take care not to tout any functional or useful aspects of trade dress features in advertising. *See, e.g., Talking Rain Beverage Co. Inc. v. South Beach Beverage Co*, 349 F.3d 601, 603-04 (9th Cir. 2003) (finding plaintiff's bottle trade dress functional because it was easy to grip, and relying on plaintiff's own advertising characterizing the bottle as a "grip bottle" and employing the slogan "Get a Grip").

However, a company can consider applying for design patent protection for the combination of elements claimed as trade dress. Such protection can presumptively indicate that the trade dress is not func-

tional. *See, In re Morton-Norwich Products, Inc.*, 671 F.2d 1332, 1342, n.3 (C.C.P.A. 1982).

Adopt Unique Trade Dress and Teach Consumers to Look For It

It goes without saying that unique and unexpected trade dress is more likely to be deemed protectible. Therefore, companies seeking to develop products or packaging subject to trade dress protection should avoid using elements already in use by competitors.

Engaging in advertising that specifically asks consumers to "look for" particular trade dress is strongly recommended. Such advertising can be immensely helpful in persuading the Trademark Office or a court that consumers see the trade dress as an indicator of source, or an indicator of quality and reputation, rather than as mere decoration.

Many companies have developed clever "look for" slogans and advertisements, calling consumers' attention to trade dress. For example, UPS's slogan "What can brown do for you?" supports its registered trade dress protection in the color brown as affixed to delivery trucks for parcel delivery services. Lucini Italia Company adopted the slogan "Only the most cared for olives make it to the Lucini bottle," which helped solidify consumers' association of Lucini's unique olive oil bottle with a single source and high quality. AstraZeneca AB bolsters its trade dress protection in the color purple for "Nexium" pills through a whole campaign of purple, including the slogan "The Purple Pill," the domain name "purplepill.com," a "Purple Plus" savings card, and its pervasive use of the color purple in advertising.

Keeping detailed records can maximize the benefit of "look for" advertising, by persuading a fact-finder that the advertising had a pervasive or wide-reaching effect. A copy of each such advertisement should be saved, together with records proving up advertising expenditures, how many times each advertisement ran, in what publications or media, the number of consumer impressions created, and the like.

Trade dress can be reinforced through other ways, such as using it in a highly consistent manner, using it across product lines, and specifically tying point-of-sale displays and advertising/promotional materials to trade dress elements, through use of similar graphics, colors, overall looks and layout design, etc.

Engage in a Marketing Blitz

Certain types of trade dress, such as packaging, can sometimes be deemed automatically or "inherently" distinctive. Other types of trade dress are routinely held to a higher standard, such as product shapes or colors, for which a showing of "acquired distinctiveness" is required.

When trade dress that is not "inherently distinctive" is first introduced, it can be freely copied by competitors. This presents a conundrum for companies attempting to establish trade dress protection, particularly in shapes or colors. They cannot claim trade dress rights until they have used the trade dress "substantially exclusively" for at least some period of time, during which consumers are taught to look for the trade dress as an indicator of source. Therefore, if competitors immediately copy the trade dress, the initiator will have lost the opportunity to establish "acquired distinctiveness"—because there will have been no period of "substantially exclusive" use during which consumers can be educated.

In light of this, companies should seriously consider engaging in a marketing "blitz" when any product or service bearing important trade dress is first introduced. The blitz should, to the extent possible, include large scale advertising, reflect significant expenditures, and be permeated by "look for" advertising. Courts have recognized that because today's media is so far-reaching, trade dress can achieve mass exposure in a matter of months. Through a blitz, trade dress rights may be established in a very short period of time, and thus before competitors can copy.

This article is for discussion and informational purposes only, and should not be considered legal advice.

Tamara Miller is a Member in the intellectual property law firm of Leydig, Voit & Mayer Ltd. Ms. Miller has significant experience in trade dress matters, from litigation involving packaging and product configuration marks to registration of colors, labels, bottles, and shapes with the U.S. Trademark Office. She can be reached at 312-616-5600 or tmiller@leydig.com.