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Seizing Trade Dress Opportunities through Creative Claims and Proactive Measures



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The “trade dress” of a product or service is often overlooked as part of a company’s IP portfolio. However, trade dress can convey just as much goodwill as a traditional trademark. Moreover, trade dress protection can last forever.

Taking steps to identify and strengthen trade dress before it is infringed can significantly aid companies in later enforcement efforts. This article first identifies examples of creative trade dress applications, in order to spark ideas relative to counseling clients in the area of trade dress. Then, this article outlines some proactive measures companies can take to maximize trade dress rights.

I. Savvy companies have claimed trade dress rights in many contexts

Trade dress is usually thought of in relation to the appearance or shape of a product or its packaging. Additionally, many of us have long been aware of non-traditional marks that are usually characterized as trade dress, such as sounds, smells, and flavors. But trade dress has much more to offer. The examples below demonstrate that trade dress protection may be available for many aspects of a business that are not so obvious.

A. Marketing and sales techniques

Trade dress has been defined as including “the total image of a business,” which can even include “particular sales techniques.” *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 765 n.1 (1992) (citations omitted). In *Original Appalachian Artworks, Inc. v. Toy Loft, Inc.*, 684 F.2d 821, 831 (11th Cir. 1982), the court afforded trade dress protection to the “adoption procedures” used by plaintiff to sell its dolls, which included providing adoption papers and birth certificates with the dolls. Notably, the court did not focus on the actual appearance or content of the adoption papers and birth certificates, but rather focused on the idea of the adoption procedure as being designed to make plaintiff’s dolls distinctive in the marketplace. *Id.* The court rejected the defendant’s argument that sales techniques are not protectable through trade dress, noting that “[t]he courts, moreover, have recognized that an unfair competition claim can extend to marketing techniques.” *Id.* (citation omitted).

B. Events

In *Toy Manufacturers of America, Inc. v. Helmsley Spear, Inc.*, 960 F.Supp. 673, 680 (S.D.N.Y. 1997), the court held that organizers of an event may protect the “trade dress” of the event itself. More specifically, the court found that attendees of a particular toy convention had come to recognize a combination of features which, taken together, constituted protectable trade dress. The trade dress included the event name, location, date, registration process, and the color and design of the registration forms. But see *Home Builders Ass’n of Greater St. Louis v. L & L Exhibition Mgt., Inc.*, 226 F.3d 944, 948 (8th Cir. 2000) (while conceivably a trade show organizer could acquire trade dress protection in “tangible features that provide

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a distinct image, such as the shape and style of exhibitor booths”, locations and times of year “are not items of trade dress”).

C. Interior and exterior appearances of businesses

In *Two Pesos*, the Supreme Court held that the total image of a restaurant could qualify as inherently distinctive trade dress. Based on that decision, several restaurants have successfully registered their interior and/or exterior décor as trade dress, such as Chipotle, Miami Subs, Metropolitan Club, and Fazoli's.

Other types of businesses have followed suit. For example, Walgreen Co. obtained a registration covering the well-known exterior shape of its retail drug and general merchandise stores. BP p.l.c. registered the exterior configuration of its service stations. Wynn Resorts Holdings, LLC registered the curved shape of its hotel and casino building.

Retail store shelving colors and configurations have also been the subject of successful trade dress prosecution. Homer TLC, Inc. (The Home Depot) registered the color orange as displayed on steel racking within its retail home improvement stores, while Build-A-Bear Retail Management, Inc. registered the design of a product display bin used in its stores.

D. Signage and advertising materials for services

Trade dress protection for colors and combinations thereof can be invoked not just for products, but also for signage and advertising materials. For example, Western Union Holdings, Inc. registered the colors black and yellow as applied to in-store, point of sale signage. 7-Eleven, Inc. owns a registration covering a pattern of stripes in the colors orange, green, and red as displayed on stores and used in advertising. Cedar Valley Exteriors, LP acquired protection for the color orange as applied to yard signs and other advertising materials for its construction, repair, inspection, and roofing services.

E. Internet websites

While the law in this area is not yet developed, several courts have at least indicated that websites can potentially be protected through trade dress. In *Blue Nile, Inc. v. Ice.com, Inc.*, 478 F.Supp.2d 1240, 1246 (W.D. Wash. 2007), the owner/operator of online diamond retail stores claimed it had a trade dress interest in the “look and feel” of its diamond search webpages. Characterizing the plaintiff's theory as “novel”, the court denied the defendant's motion to dismiss. Likewise, in *Peri Hall & Associates, Inc. v. Elliot Institute for Social Sciences Research*, 2006 WL 742912, *3-4 (W.D. Mo. 2006), the court granted a preliminary injunction after finding that the plaintiff was likely to succeed in its claim of website trade dress infringement, among other claims.

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2. Taking proactive measures and using trade dress wisely can aid in later enforcement efforts

A. Trade dress registration

In an infringement action, establishing that trade dress is protectable 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. Trademark Office. Registration constitutes prima facie evidence of trade dress validity and confers constructive and sometimes actual notice of rights. Trade dress registrations can, under certain conditions, become “incontestable,” affording trade dress extra protection against attack. Moreover, registering trade dress relieves the owner of the initial burden of proving in court that the trade dress is non-functional.

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. Applying to register different variations of the trade dress through multiple applications can undermine a claim of trademark significance in any one of the variations. .

B. Avoidance of utilitarian claims

In order for trade dress to be protectable, 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.

Similarly, 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”).

C. “Look for” advertising

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, rather than mere decoration. Keeping detailed records can maximize the benefit of “look for” advertising to the extent they can demonstrate the advertising had wide-reaching effect.

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.

D. Marketing blitzes

In order to quickly achieve secondary meaning, companies should consider engaging in a marketing “blitz” when any product or service bearing important trade dress is first introduced. If possible, the blitz should include large-scale advertising, reflect significant expenditures, and be permeated by “look for” advertising. Because of the expense associated with a blitz, companies would be well advised to engage in trade dress clearance efforts prior to the launch. Courts have recognized that because today’s media is so far-reaching, trade dress can sometimes achieve mass exposure in a matter

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of months. Through a blitz, secondary meaning may be established before competitors can copy.

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