Wal-Mart Stores, Inc. v. Samara Bros., Inc. (2000)

- Product design acting as an indication of source
- Comparison of product design as a source indicator to word marks and packaging
  - Affixed word marks or certain packaging allow a customer to almost automatically determine that the mark/packaging is an indicator of source
  - For those items where it is not reasonable to conclude that a customer will "automatically" think "single source" – need secondary meaning
    - Descriptive word marks
    - Geographic designations
    - Names
    - Product design
- Why? – no clear test possible; threat of suit
  - Design patent or © protection reduces harm to producer
- What about Two Pesos?
  - Product design is "different" from trade dress
  - Distinguishing between these two is easer than determining when product design is inherently distinctive

In re Slokevage 441 F.3d 957 (Fed. Cir. 2006)

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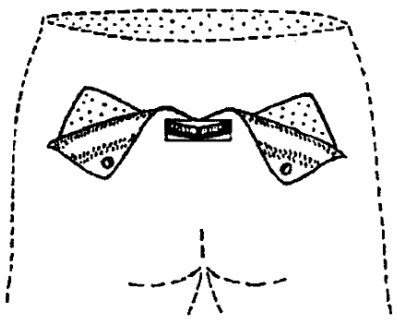
dress configuration, which is located on the rear of various garments, is depicted below:



Although Slokevage currently seeks to register a mark for the overall configuration of her design, she has already re-

In re Slokevage 441 F.3d 957 (Fed. Cir. 2006)

We agree with the Board that Slokevage's trade dress constitutes product design and therefore cannot be inherently distinctive…. Slokevage urges that her trade dress is not product design because it does not alter the entire product but is more akin to a label being placed on a garment. We do not agree. The holes and flaps portion are part of the design of the clothing-the cut-out area is not merely a design placed on top of a garment, but is a design incorporated into the garment itself. Moreover, while Slokevage urges that product design trade dress must implicate the entire product, we do not find support for that proposition. Just as the product design in Wal-Mart consisted of certain design features featured on clothing, Slokevage's trade dress similarly consists of design features, holes and flaps, featured in clothing, revealing the similarity between the two types of design.

McKernan v. Burek (D.Mass. 2000)

McKernan's Tunnel Permit

Burek's Tunnel Permit

Sandwich Ship Supply's Tunnel Permit

Best Cellars, Inc. v. Wine Made Simple, Inc. (S.D.N.Y. 2003)

Fedders Corp. v. Elite Classics (S.D. Ill. 2003)

In re Brouwerij Bosteels (TTAB 2010)

Art Attacks Ink, LLC v. MGA Entertainment Inc. (9th Cir. 2009)

Question . . .

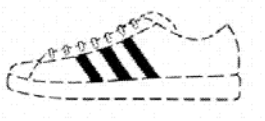
Int. Cl.: 25

Prior U.S. Cls.: 22 and 39

United States Patent and Trademark Office

Reg. No. 3,029,135
Registered Dec. 13, 2005

TRADEMARK
PRINCIPAL REGISTER



ADIDAS-SALOMON AG (FED REP GERMANY AKTIENGESELLSCHAFT (AG))
ADI-DASSLER STRASSE 1-2
D-91074 HERZOGENAURACH, FED REP GERMANY

FOR: FOOTWEAR, IN CLASS 25 (U.S. CLS. 22 AND 39).

FIRST USE 1-1-1952; IN COMMERCE 1-1-1952.

THE MARK CONSISTS OF THREE PARALLEL STRIPES WITH SERRATED EDGES APPLIED TO FOOTWEAR, THE STRIPES ARE POSITIONED ON THE FOOTWEAR UPPER IN THE AREA BETWEEN THE LACES AND THE SOLE. THE DOTTED OUTLINE OF THE FOOTWEAR IS NOT CLAIMED AS PART OF THE MARK AND IS INTENDED ONLY TO SHOW THE POSITION OF THE MARK.

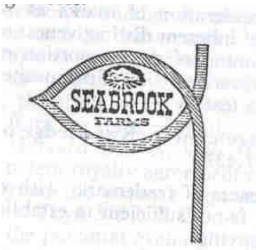
SEC. 2(F).

SER. NO. 78-539,734, FILED 12-29-2004.

ALINA MORRIS, EXAMINING ATTORNEY

Seabrook Foods, Inc. v. Bar-Well Foods Ltd. (C.C.P.A. 1977)

Product configuration trade dress and single colors (whether applied to the packaging of the product or the product itself) are per se incapable of inherent distinctiveness, and it is likely that courts would also find smells, tastes, and textures also to be incapable of inherent distinctiveness. But this leaves a wide array of nonverbal marks, including product packaging trade dress, that remain capable of inherent distinctiveness. The question, then, is how to determine whether a particular mark that falls into one of these categories is in fact inherently distinctive. While the *Abercrombie* spectrum works reasonably well for verbal marks, it is not clear that it is well-suited to the inherent distinctiveness analysis of nonverbal marks. Instead, as we will see in the *Amazing Spaces* opinion below, most courts have adopted the so-called *Seabrook* factors, from *Seabrook Foods, Inc. v. Bar–Well Foods Ltd.*, 568 F.2d 1342 (CPPA 1977), to analyze the inherent distinctiveness of nonverbal marks.



Seabrook Foods, Inc. v. Bar-Well Foods Ltd. (C.C.P.A. 1977)

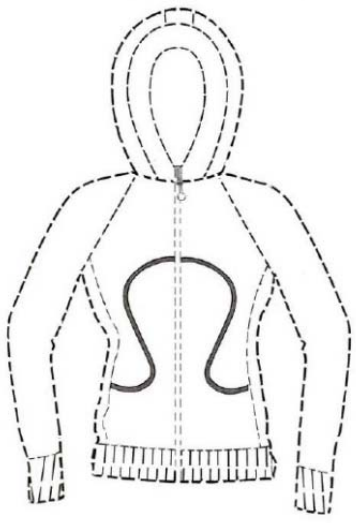
- Seabrook Foods, Inc. v. Bar-Well Foods Ltd., 568 F.2d 1342, 1344 (C.C.P.A. 1977)

  "In determining whether a design is arbitrary or distinctive this court has looked to

  – whether it was a 'common' basic shape or design,
  – whether it was unique or unusual in a particular field,
  – whether it was a mere refinement of a commonly-adopted and well-known form of ornamentation for a particular class of goods viewed by the public as a dress or ornamentation for the goods, or
  – whether it was capable of creating a commercial impression distinct from the accompanying words."

Example of "mere ornamentation"

- Note further that if a court finds a feature of product packaging to lack both inherent and acquired distinctiveness or a feature of product configuration to lack acquired distinctiveness, then the court will often (but not always) deem the feature to be "mere ornamentation." For example, in *In re Lululemon Athletica Canada, Inc.*, 105 U.S.P.Q.2d 1684 (TTAB 2013), the TTAB analyzed the wave design for apparel shown below. The TTAB did not apparently consider the design to be product configuration (and thus per se incapable of inherent distinctiveness). It nevertheless found that the design lacked inherent distinctiveness and acquired distinctiveness and would be perceived by consumers as mere ornamentation.



Fun-Damental Too, Ltd. v. Gemmy Industries Corp. (2d Cir. 1997)

- Although some of the individual elements of a trade dress are generic or descriptive, the impression given by all of them in combination may be inherently distinctive. Such was what the district court found here; and we cannot say that this finding is clearly erroneous.
- This "total look" approach is the only workable way to consider such elements of the trade dress as the arrow sticker that is affixed to the Toilet Bank's tank. Because the box is open in order to display the product, it was proper to analyze Fun–Damental's trade dress as seen by consumers—including the Toilet Bank product. Further, there is no risk of "spillover" protection for the Toilet Bank as a product here since the injunction is limited to the sale of a similar product in a *particular* package, rather than an absolute ban on the sale of the Currency Can in an open-style box. In sum, we conclude that looking at the product itself in the context of its packaging is a proper method of analyzing open-style packaging for trade dress protection.

Amazing Spaces, Inc. v. Metro Mini Storage (5th Cir. 2010)

Int. Cl.: 39

Prior U.S. Cls.: 100 and 105

United States Patent and Trademark Office

Reg. No. 2,859,845
Registered July 6, 2004

SERVICE MARK
PRINCIPAL REGISTER

AMAZING SPACES (TEXAS CORPORATION)
9040 LOUETTA ROAD, SUITE B
SPRING, TX 77379

FOR: STORAGE SERVICES, IN CLASS 39 (U.S. CLS. 100 AND 105).

FIRST USE 4-0-1998; IN COMMERCE 4-0-1998.

SER. NO. 76-540,854, FILED 8-15-2003.

DOMINIC J. FERRAIUOLO, EXAMINING ATTORNEY

Amazing Spaces, Inc. v. Metro Mini Storage (5th Cir. 2010)

AMAZING SPACES
Self Storage • Boxes • Wine Storage