

# Trade Dress and the TTAB: If Functionality Don't Get You, Nondistinctiveness Will<sup>1</sup>

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In recent years, the Trademark Trial and Appeal Board has not been a particularly active player in the trade dress arena. Since the Supreme Court's March 2000 ruling in *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 54 USPQ2d 1065 (2000), the TTAB has issued more than two thousand decisions, in *ex parte* appeals and *inter partes* proceedings. Only about one percent of those rulings have dealt with trade dress issues: i.e., with product configurations or designs, product packaging, and/or color. Of those trade dress rulings, the number that have been deemed citable can be counted on the fingers of one hand.

This paucity of Board decisions may reflect a reluctance on the part of applicants to seek registration for trade dress in light of current case law. Or perhaps most trade dress applications are refused registration and the refusal is not appealed. Some approved and published applications may not be opposed. Other trade dress applications may yield registrations on the Supplemental Register and therefore never be published for opposition. In any event, the relatively few Board decisions in trade dress cases — even the non-citable ones — provide useful guidance to trademark practitioners as to whether to seek registration and how to achieve it.

In *Wal-Mart*, the Supreme Court raised the bar for registration of product design trade dress by ruling that a product configuration or feature can never be inherently distinctive — acquired distinctiveness must always be shown. It also re-visited its decision in *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 34 USPQ2d 1161 (1995), in order to declare that a color likewise cannot be an inherently distinctive mark. One year later, in *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532

U.S. 23, 58 USPQ2d 1001 (2001), the Court adopted a “new” test for determining whether an applied-for mark (i.e., trade dress) is functional as a matter of law — and thus ineligible for registration — focusing on the utility of the design rather than on competitive need.

Thus the *TrafFix* and *Wal-Mart* decisions present two hurdles that must be cleared in order for a trade dress applicant to reach the PTO finish line and attain registration. In the great majority of the trade dress cases decided by the Board since 2000, the applicant has failed to complete the course.

To summarize current law, if the trade dress at issue is *de jure* functional under *TrafFix*, the race is over: the trade dress is *not* registrable.

If the trade dress applicant overcomes the *TrafFix* functionality hurdle, then the *Wal-Mart* hurdle of distinctiveness is encountered. Whether secondary meaning is required in order to achieve registration, or whether the trade dress may be registrable based on its inherent distinctiveness, depends on the type of trade dress at issue. “Product design” trade dress is registrable only upon proof of acquired distinctiveness. Similarly, if the trade dress is a color, it may be registered only upon proof of acquired distinctiveness. If the trade dress may be classified as “product packaging,” however, then a shortcut to registrability is available: packaging trade dress that is sufficiently distinctive may be registrable based on its inherent distinctiveness alone. If the packaging is not so distinctive, proof of secondary meaning will be required.<sup>3</sup>

A review of the TTAB's trade dress decisions since the year 2000 will show just how formidable these two hurdles have been for trade dress applicants at the TTAB level.

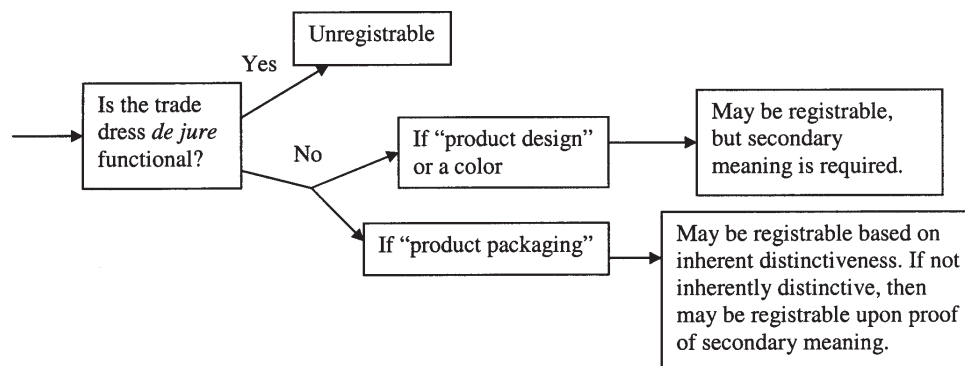


Fig. 1: The Functionality and Distinctiveness Hurdles To Registrability

## I. Functionality — *de jure, vel non?*

*De facto* functionality is not a ground for refusal to register. Many product configurations are *de facto* functional — i.e., they perform some function or have some utility. The question is whether the particular design (or other trade dress) is *de jure* functional — i.e., whether as a matter of law it is incapable of serving as a source indicator.

The Board discussed this basic distinction in *In re Ennco Display Systems, Inc.*, 56 USPQ2d 1279 (TTAB 2000),<sup>4</sup> in which a wayward Examining Attorney had refused registration of eight product designs on the purported ground of *de facto* functionality.

A product configuration which is a superior design essential for competition is *de jure* functional and may be refused registration on that ground. See Section 2(e)(5) of the Trademark Act, 15 U.S.C. Section 1052(e)(5); *Morton-Norwich Prods., Inc.*, 213 USPQ 9 (CCPA 1982). In contrast, a product configuration that is not a superior design essential for competition, but merely performs some function or utility, is only *de facto* functional. *De facto* functionality is not a ground for refusal under the statute. 56 USPQ2d at 1282.<sup>5</sup>

### A. Reconciling *TrafFix* and *Morton-Norwich*

Prior to *TrafFix*, the TTAB's test for determining whether a particular product design or feature was *de jure* functional could be found in *In re Morton-Norwich Prods, Inc.*, 213 USPQ 9 (CCPA 1982). *Morton-Norwich* requires consideration of the following four factors in determining whether the design in question is "the best or one of a few superior designs available" and thus whether allowing the owner to "exclude others . . . from using this trade dress will hinder competition or impinge upon the rights of others to compete effectively:"

- (1) the existence of a utility patent disclosing the utilitarian advantages of the design;
- (2) advertising materials in which the originator of the design touts the design's utilitarian advantages;
- (3) the availability to competitors of functionally equivalent designs; and
- (4) facts indicating that the design results in a comparatively simple or cheap method of manufacturing the product. 213 USPQ at 15-16.

In *TrafFix* the Supreme Court took a different approach. Whereas the *Morton-Norwich* test considers whether competitors have a need to use the design — i.e., whether the design is superior to other designs and whether feasible alternatives are available — *TrafFix* reaffirmed the "traditional rule" of *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844, 214 USPQ 1 (1982), that "a product feature is functional if

it is essential to the use or purpose of the article or if it affects the cost or quality of the article." 532 U.S. at 32, 58 USPQ2d 1006. If the product design or feature is *de jure* functional under the *Inwood* test, there is no need to consider whether there is a competitive necessity for the design (i.e., no need to consider alternatives). In cases of aesthetic functionality, however, an inquiry into whether protection of the trade dress would put competitors at a "significant non-reputation-related disadvantage" is proper. *TrafFix*, 532 U.S. at 33, 58 USPQ2d 1006.

But does *TrafFix* dictate that alternatives are to play no role in determining whether a feature or design is *de jure* functional in a utilitarian sense? What happens to the third factor of the *Morton-Norwich* test, which focuses on the availability of alternative, functionally equivalent designs? Not to worry. The CAFC in *Valu Engineering, Inc. v. Rexnord Corp.*, 61 USPQ2d 1422 (Fed. Cir. 2002), concluded that the Supreme Court's decision in *TrafFix* did not alter the *Morton-Norwich* analysis:

We did not in the past under the third factor require that the opposing party establish that there was a "competitive necessity" for a product feature. Nothing in *TrafFix* suggests that consideration of alternative designs is not properly part of the overall mix, and we do not read the Court's observations in *TrafFix* as rendering the availability of alternative designs irrelevant. Rather, we conclude that the Court merely noted that once a product feature is found functional based on other considerations there is no need to consider the availability of alternative designs, because the feature cannot be given trade dress protection merely because there are alternative designs available. But that does not mean that the availability of alternative designs cannot be a legitimate source of evidence to determine whether a feature is functional in the first place. 61 USPQ2d at 1427.

Thus according to the CAFC's reading of *TrafFix*, it is still appropriate for the TTAB to consider the availability of alternative designs as "part of the overall mix" as an aid in deciding "whether a feature is functional in the first place."<sup>6</sup> The availability of alternative designs (i.e., the lack of competitive need), however, cannot justify trade dress protection for a design that is, based on other considerations, *de jure* functional.

In *Valu Engineering*, the CAFC affirmed a TTAB decision sustaining an opposition to registration of three product configuration marks (ROUND, FLAT, and TEE)



for the cross-sectional shape of conveyor guard rails, on the ground of *de jure* functionality. The Board had applied the customary *Morton-Norwich* functionality analysis in finding that all four factors pointed toward *de jure* functionality:

“an abandoned utility patent application filed by Valu but rejected under 35 U.S.C. § 103 ‘disclosed certain utilitarian advantages of [Valu’s] guide rail designs, and that those advantages . . . result from the shape of the guide rail designs,’ *Rexnord*, slip op. at 12; Valu’s advertising materials ‘tout the utilitarian advantages of [Valu’s] guide rail designs,’ id. at 23; the ‘limited number of basic guide rail designs . . . should not be counted as ‘alternative designs’ because they are ‘dictated solely by function,’ id. at 30; and Valu’s guide rail designs ‘result[] in a comparatively simple or cheap method of manufacturing,’ id. at 41.” *Valu Engineering*, 61 USPQ2d at 1424.

As we shall see, the TTAB continues to utilize the four *Morton-Norwich* factors, guided by *Valu Engineering*, in determining the *de jure* functionality of trade dress in utilitarian functionality cases.

When aesthetic functionality is the issue, the Board will usually apply the “competitive necessity” standard found in *Qualitex* and blessed by *TrafFix*:

It is proper to inquire into a “significant non-reputation-related disadvantage” in cases of aesthetic functionality, the question involved in *Qualitex*. Where the design is functional under the Inwood formulation there is no need to proceed further to consider if there is a competitive necessity for the feature. In *Qualitex*, by contrast, aesthetic functionality was the central question, there having been no indication that the green-gold color of the laundry press pad had any bearing on the use or purpose of the product or its cost or quality. *TrafFix*, 532 U.S. 33, 58 USPQ2d at 1006-7.

However, the Board does not always make it clear whether, in a given case, it considers the trade dress at issue to fall within the utilitarian or the aesthetic category. In any event, it seems to find the *Morton-Norwich* test to be a comfortable, all-purpose tool for determining the functionality issue in most cases.

## B. Trade dress found *de jure* functional

In this century, the Board has deemed citable three of its eleven decisions dealing with the issue of *de jure* functionality of trade dress: *Gibson* (guitar shape), *Ferris*

(the color “pink” for wound dressings), and *M-5 Steel* (shape of roofing vents). In all three it found the purported mark to be unregistrable on that ground, surely signaling to practitioners that the path to registrability for trade dress will not be an easy one. A review of these eleven decisions will provide some insight into the Board’s approach to trade dress functionality.

### 1. Utility patents prove fatal

The existence of a utility patent directed to the product design or feature has invariably proven fatal to an applicant’s attempt to register its trade dress. *Morton-Norwich* includes as one of its functionality factors, whether a patent *discloses* the utilitarian advantages of the design sought to be registered. 213 USPQ at 15-16. In *TrafFix*, the Supreme Court focused on the invention *claimed* in a utility patent:

A prior patent, we conclude, has vital significance in resolving the trade dress claim. A utility patent is strong evidence that the features therein claimed are functional. If trade dress protection is sought for those features the strong evidence of functionality based on the previous patent adds great weight to the statutory presumption that features are deemed functional until proved otherwise by the party seeking trade dress protection. Where the expired patent claimed the features in question, one who seeks to establish trade dress protection must carry the heavy burden of showing that the feature is not functional, for instance by showing that it is merely an ornamental, incidental, or arbitrary aspect of the device. 532 U.S. at 29-30, 58 USPQ2d 1005.

In the cases discussed here, the TTAB has not had reason to distinguish between what is *disclosed* and what is *claimed* in a pertinent utility patent, nor is it likely that, in this context, such a distinction would make a significant difference.

In *In re Briles Rivet Corp.*, S.N. 75053459 (Jan. 31, 2001) [not citable], the TTAB affirmed a refusal to register a mark comprising “a configuration of a toroidal head of a rivet” on the ground of *de jure* functionality. Applying the *Morton-Norwich* test in this pre-*TrafFix* case, the Board noted that Applicant’s own utility patents “each include as an essential claim the toroidal shape of the head of a rivet. \* \* \* Clearly, this factor weighs strongly in favor of a finding of *de jure* functionality.” In addition, the fact that Boeing required Applicant’s rivet in one of its aircraft demonstrated that the subject design is one of a very few superior designs for its functional purpose.



In *In re All Rite Prods, Inc.*, S.N. 75260089 (Sept. 27, 2001) [not citable], the Board applied *TrafFix* in finding the configuration of a fork for a vehicle utility carrier to be unregistrable on the ground of *de jure* functionality. The disclosure of All Rite's utility patent and the inclusion of the fork as part of the claimed invention provided "strong evidence" of functionality and added "great weight" to the presumption that the trade dress is functional. Because the Examining Attorney and the Applicant had addressed the issue in terms of the *Morton-Norwich* test, including a consideration of alternative designs, the Board went on to find that, under that test, "the same result would pertain."<sup>7</sup>



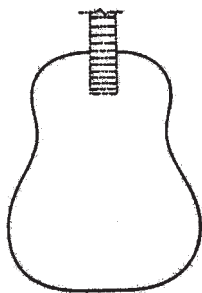
Very recently, in *Goodyear Tire & Rubber Co. v. Camoplast, Inc.*, Opp. No. 91152083 (June 30, 2004) [not citable], the Board sustained an opposition to registration of the product design shown here for "rubber tracks used in land vehicles," holding the design to be *de jure* functional. The application described the mark as the tread pattern on the track surface, consisting of two rows of alternating, equally-spaced tread lugs. Camoplast's own brochure described the functional features of the tread design. Moreover, its utility patent disclosed the utilitarian advantages of a design essentially identical to that of the trademark application, and the patent claims were directed to the shape of the lugs and their relative juxtaposition. Applying *TrafFix* and *Morton-Norwich*, the Board found this evidence regarding the first and second *Morton-Norwich* factors sufficient to establish the *de jure* functionality of the design.



## 2. Advertising spells defeat

An applicant who touts the utilitarian advantages of a product configuration or feature may as well not bother seeking its registration. The second *Morton-Norwich* factor will effectively squelch any such attempt.

For example, in the citable decision in *In re Gibson Guitar Corp.*, 61 USPQ2d 1948 (TTAB 2001), the Board affirmed a Section 2(e)(5) refusal to register, ruling that the body shape of Applicant's "Round Shoulder Jumbo" guitar is *de jure* functional. Fatal to Gibson's cause was its advertising touting the acoustical advantages of the guitar's configuration: "This unique body shape creates a sound which is much more balanced and less 'muddy' than ordinary dreadnought acoustics." The Board also noted the assertion made in a competitor's



advertisement for an identically-shaped guitar: "Round shouldered dreadnoughts have a unique sound." In applying the *Morton-Norwich* factors, the Board expressed uncertainty as to whether the availability of alternative designs should still be considered in light of *TrafFix*. (The CAFC had just addressed this point in *Valu Engineering*). In any case, Gibson failed to show that there were any guitar shapes that could produce the same sound as its configuration, and so the Board's "dread" regarding the role of alternatives was all for "nought."

And in *In re Ivanko Barbell Co.*, S.N. 78134755 (June 16, 2004) [not citable], the Board affirmed (without heavy lifting) a Section 2(e)(5) refusal to register the product configuration shown here as a trademark for a "barbell plate with seven holes." The application described the mark as a three-dimensional configuration of a barbell plate having a raised circumferential border and seven holes surrounding a central hole with a raised border. Ivanko's own advertising materials touted the utilitarian advantages of having "more grip holes to make it easier to pick up" and a rounded contour for "ease of use and exercise safety," and these statements were decisive in the Board's application of what it called the *Valu Engineering* test (i.e., the four *Morton-Norwich* factors). Ivanko asserted that other designs are available, but the Board pointed out that, under *TrafFix*, "competitive necessity" is not a prerequisite to a finding of functionality. Ivanko also asserted that its barbell plate costs more, not less, to manufacture, but the Board found this fact insignificant: "improving the utilitarian features of a product often dictates that the manufacturing process be more expensive or complicated."



It appears that the Examining Attorney, for some reason, offered into evidence Ivanko's design patent covering the product shape in question. The Board understandably ruled that "A design patent is not evidence of the utilitarian advantages of applicant's design." More significantly, it also cited CAFC and TTAB precedent for the proposition that the existence of a design patent does not *per se* bestow upon the design "the aura of distinctiveness or recognition as a trademark." But *Morton-Norwich* indicates that ownership of a design patent is a factor in applicant's favor: "It is interesting to note that appellant also owns design patent 238,655 for the design in issue, which, at least presumptively, indicates that the design is not *de jure* functional." 213 USPQ at 17, note 3.

### 3. Color me unregistrable

Moving from the utilitarian toward the aesthetic, the Board, in a citable pre-*Traffix* ruling, found the color “pink” to be *de jure* functional for surgical and post-surgical wound dressings. *In re Ferris Corp.*, 59 USPQ2d 1587 (TTAB 2000). The Board followed the Supreme Court’s decision in *Qualitex*:

A color is *de jure* functional “if it is essential to the use or purpose of the article or if it affects the cost or quality of the article.” *Qualitex*, 514 U.S. at 164, citing *Inwood Lab., Inc. v. Ives Lab., Inc.*, 456 U.S. 844, 850 n. 10 (1982). The critical inquiry in these cases is whether exclusive use of the color would put competitors at a significant disadvantage. *Qualitex*, 514 U.S. at 165, 34 USPQ2d at 1164. (59 USPQ2d at 1589).

For purposes of determining whether a color is *de jure* functional, the Board listed five factors that have been considered by the courts: (i) whether the color serves a non-trademark purpose; (ii) whether that purpose is important to consumers; (iii) whether the color is the best, or at least one of the few superior colors available for that purpose; (iv) whether competitors are using the color for that purpose; and (v) whether there are alternative colors available for similar use by others. The Board observed that “[t]here is no question that ‘flesh color’ for wound dressings serves the utilitarian purpose of blending well with the natural color of human skin.” Based on NEXIS excerpts regarding bandage colors and competitors’ catalogs offering “flesh colored” wound dressings, the Board concluded that pink is “one of the few superior ‘flesh’ colors available for wound dressings.” To grant Ferris exclusive rights to the color “pink” would “limit the options of competitors and preclude them from using similar ‘flesh colors’ on their products.”

In its recent decision in *Texaco Inc. v. Pennzoil-Quaker State Co.*, Opp. 91120520 (May 28, 2004) [not citable], the Board cited *Traffix* but applied a *Morton-Norwich* “competitive need” analysis in finding another “color” mark to be functional. Although Pennzoil sought registration of “the color clear used on containers of motor oil,” the Board agreed with Texaco that Pennzoil was not trying simply to claim a single color: “it seems obvious that applicant is trying to carve out transparent plastic containers as a source identifier for its automotive motor oils.” After

reciting the *Traffix* functionality language, the Board observed that in *Valu Engineering* “the Federal Circuit has held that this decision [*Traffix*] does not alter the oft-cited case of its predecessor in the area of functionality, *In re Morton-Norwich*.”

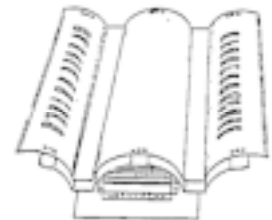


The *Morton-Norwich* case, cited by both parties to this proceeding, clarified that in determining whether the configuration of a plastic spray bottle container was *de jure* functional, one needs to look to the competitive need to copy the claimed design feature.

In determining the “competitive necessity” of the Pennzoil mark, the Board found that, under the second *Morton-Norwich* factor, Applicant occasionally promoted the utilitarian features of the clear bottle: e.g., consumers can see what they are buying; it gives consumers the impression that the oil is pure and clean; and consumers can tell exactly how much oil has been used. The Board found “more damaging” the evidence under factor three (alternative designs): Applicant introduced the clear bottle after determining that there was an “obvious competitive advantage” to displaying the coloration of its products, even though the clear bottle is more expensive to manufacture. Thus Texaco made a *prima facie* case of functionality by pointing out “numerous non-reputation related reasons for adopting a clear container, and these are competitive reasons that should not be denied to applicant’s competitors.” Pennzoil failed to rebut that showing.

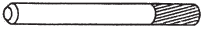
### 4. Aesthetic functionality hits the roof

The third citable Board decision involved elements of both utilitarian and aesthetic functionality.<sup>8</sup> In *M-5 Steel Mfg., Inc. v. O’Hagin’s Inc.*, 61 USPQ2d 1086 (TTAB 2001), the Board found unregistrable three product configuration marks for “metal roofing tiles and metal ventilating ducts and vents for tile or concrete roofs.” The designs mirrored the shapes of roof tiles sold by various manufacturers. Applicant’s abandoned utility patent application, its promotional literature, and the testimony of its president, Harry O’Hagin, touted the designs’ appealing and unobtrusive appearance when installed in the place of tiles. The promotional material also asserted that these vents were cheaper to install. The Board, guided by the Supreme Court decisions in *Qualitex* and *Traffix*, and likening the case to *Brunswick Corp. v. British Seagull Ltd.*, 32 USPQ2d 1120 (Fed. Cir. 1994) [the color black for outboard motors held to be functional and unregistrable], concluded — in language that echoed the aesthetic functionality test — that registration of Applicant’s designs “would hinder competition by placing competitors at a substantial competitive disadvantage.”



### C. Trade dress found not *de jure* functional

The situation, of course, is not completely hopeless for the applicant seeking to register a product design or color. On occasion, a configuration or color challenged on Section 2(e)(5) grounds survives the functionality gauntlet.

For example, a divided Board panel in *In re Music City Marketing, Inc.*, S.N. 75035717 (Nov. 14, 2000) [not citable], a pre-*TrafFix* ruling, reversed the PTO's finding of *de jure* functionality of a product configuration comprising  "the design of a cigarette" for a "smoking pipe." (The drawing is lined for the color tan.) The Examining Attorney argued that the design was superior to other available designs and thus would give Music City a competitive advantage: its specimens and promotional material showed that the product is a smoke-cessation aid, and the Examining Attorney asserted that the realistic cigarette design looks and feels like a real cigarette and allows the would-be nonsmoker to remain relatively inconspicuous. The panel majority, however, noting that the identified goods were not smoke-cessation devices, applied *Morton-Norwich* and *Qualitex* in finding that recognition of trademark rights would not *significantly* hinder competition. There was no relevant utility patent and no evidence that "a smoking pipe in a cigarette configuration is any cheaper or easier to manufacture." Music City's advertising did not tout the *utilitarian* advantages of the design, and there was no evidence of the unavailability of alternative designs.

In a persuasive dissent, Judge Simms accused the majority of minimizing the significance of Music City's touting of the *appearance* of its goods (i.e., their inconspicuous nature), giving inadequate weight to the use of similar designs for smoke-cessation devices, and failing to use "common sense."<sup>9</sup>

A color mark smartly survived a functionality challenge in *Newborn Bros. and Co. v. Dripless, Inc.*, Opp. No. 91113471 (Aug. 16, 2002) [not citable]. The Board dismissed an opposition to registration of the color "yellow" applied to "caulking guns."



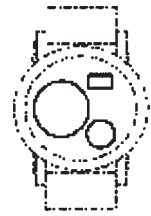
Opposer Newborn contended that the mark was functional in both the utilitarian and aesthetic senses because customers may request caulking guns in yellow, yellow is

more visible on store shelves, and colors are employed to indicate different models.<sup>10</sup> However, the Board, applying *TrafFix* and *Morton-Norwich*, found no convincing evidence of utilitarian functionality: there were no relevant patents; Applicant's advertising did not tout any utilitarian advantage for its yellow guns; other colors are available; and painting caulking guns yellow is not a comparatively simple or cheap method of manufacture.

As to aesthetic functionality, Opposer Newborn failed to establish that competitors need the color "yellow" to

compete effectively. In fact, although it had been in the business longer than Dripless, Newborn "apparently did not see the need to produce caulking guns in the color yellow prior to applicant's use of yellow." As we shall see, Applicant Dripless succeeded in proving that its "yellow" mark had acquired distinctiveness, and thus it managed to clear both hurdles to registrability.

Finally, in *In re Lange Uhren GmbH*, S.N. 75883446 (Apr. 15, 2003) [non citable], the TTAB reversed a refusal to register (on the Supplemental Register) the design shown here for "chronometers, chronographs for use as watches." The Board found the design not *de jure* functional and capable of functioning as a mark. According to the application, the design comprises a configuration of a watch face consisting of two circles and a rectangle, the circles serving as borders for the hour, minute, and second hands, while the rectangle borders the date of the month. The Examining Attorney attempted to apply the *Morton-Norwich* functionality test in contending that the design is functional, but the Board "cleaned his clock" on every point: Applicant's patent did not disclose the utilitarian advantages of the design; its advertising did not tout any utilitarian advantages; many alternative designs are available; and those alternative designs would not be more costly to produce.



To summarize these eleven functionality cases: a utility patent disclosing or claiming the utilitarian advantages of the trade dress, and/or promotional material touting those advantages, will be roadblocks to registration. If neither is present, the trade dress applicant has a fighting chance to achieve registrability. Of course, the issue of distinctiveness may derail that effort.

## II. Distinctiveness — Inherent, Acquired, or Absent?

In light of *Wal-Mart*, product designs and color marks can never be inherently distinctive. Product packaging trade dress, however, may be inherently distinctive, and the Board is willing to find inherent distinctiveness under the right circumstances. It did so in the two cases discussed immediately below, the first being citable.

### A. Inherently distinctive trade dress

Shortly after the Supreme Court's decision in *Wal-Mart*, the TTAB faced the question of what test to apply in determining whether packaging trade dress is inherently distinctive. *In re Creative Beauty Innovations Inc.*, 56 USPQ2d 1203 (TTAB 2000), involved the shape of a container for bath products. Applicant argued that *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992),

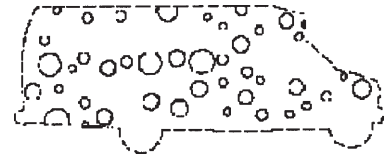
demand application of the test found in *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 189 USPQ 759 (2<sup>nd</sup> Cir. 1976), which requires classifying the trade dress into one of the four traditional trademark categories: “in an ascending order which roughly reflects their eligibility to trademark status and the degree of protection accorded, these classes are (1) generic, (2) descriptive, (3) suggestive, and (4) arbitrary or fanciful.” 189 USPQ at 764. The Examining Attorney contended that even after *Two Pesos*, the Board and the CAFC continued to apply the test articulated in *Seabrook Foods, Inc. v. Bar-Well Foods Ltd.*, 196 USPQ 289 (CCPA 1977). The *Seabrook* test was formulated for product packaging trade dress cases, and sets forth the following factors for consideration: “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.” 196 USPQ at 291.



In *Wal-Mart*, when Respondent Samara urged adoption of the *Seabrook* test for determining whether a *product design* is inherently distinctive, the Supreme Court questioned the usefulness of *Seabrook*. 529 U.S. at 213-14, 54 USPQ2d at 1069. Consequently, in *Creative Beauty* the TTAB felt compelled to consider whether *Seabrook* “remains good law.” It concluded that the Court did not adopt *Abercrombie* to the exclusion of *Seabrook* as the test for determining the inherent distinctiveness of trade dress other than product design, but it also noted that the Court did signal that *Abercrombie* “has utility apart from its use in evaluating word marks.” 56 USPQ2d at 1207. The Board resolved the issue by deeming the two tests to be complementary. Noting the statements of Creative Beauty’s general manager as well as of others in the field, the Board went on to find this award-winning container design to be unique and unusual, and not a mere refinement of existing designs, under *Seabrook*, and fanciful or arbitrary under *Abercrombie*.

In an uncitable decision, the Board again found inherent distinctiveness in product “packaging.” In *In re PRG Parking Management, L.L.C.*, S. Nos. 76396894 and 76396895 (Dec. 9, 2003) [not citable], it applied the *Seabrook* test without specifically mentioning the case by name. Reversing a refusal to register under Sections 1, 2, 3, and 45 of the *Trademark Act*, the Board concluded that the design shown here functions as a service mark in connection with airport shuttle van transport services and parking lot services. The applied-for marks comprise the trade dress of a parking shuttle van;

one of the two applications claimed the specific colors yellow and black. The Examining Attorney contended that the designs are commonplace and merely ornamental, but the Board wholly disagreed. It noted the record evidence depicting the vans of three other shuttle companies and demonstrating common techniques for ornamenting a van: either contrasting colors for the top and bottom half of the van or a solid color with writing and a detailing line in a contrasting color. In this context, the Board found the design of multi-sized circles over the entire surface of a shuttle van to be “quite different” from the examples of record. Describing PRG’s trade dress as “original, distinctive, and very peculiar in nature” and “completely arbitrary” for the identified services, the Board held that the marks are inherently distinctive because they “create a commercial impression as an indication of origin.”



## B. Not inherently distinctive “packaging”

In three uncitable decisions, the TTAB found “product packaging” trade dress to be not inherently distinctive.

Two years after *Creative Beauty*, the Board considered whether the cap for a container of glue was an inherently distinctive trademark. In *re Pacer Technology*, S.N. 75477402 (June 11, 2002) [not citable]. Applying the *Seabrook* test (with no mention of *Abercrombie*), the Board agreed with the Examining Attorney that “this winged configuration is, at best, a variation or ‘mere refinement’ of a useful, basic design scheme for adhesive product applicator caps.” The evidence consisted of a number of design patents showing a variety of similar cap designs, some owned by Pacer’s competitors. Pacer complained that these design patents “did not show actual use in commerce,” but the Board found them to be “probative of the fact that consumers are not likely to find applicant’s claimed feature (wings arrayed evenly around a pointed crown) to be at all unique, original or peculiar in appearance.”



Apparently believing that the CAFC would not “adhere” to the Board’s decision, Pacer appealed. In *re Pacer Technology*, 67 USPQ2d 1629 (Fed. Cir. 2003). It contended that the design patents relied on by the TTAB did not amount to the “substantial evidence” necessary to support the Board’s ruling because the PTO had not shown that those patented designs were in actual use. The appellate court, however, observed that “to meet its *prima facie* burden, the PTO must, at a

minimum, set forth a 'reasonable predicate' for its position of no inherent distinctiveness." It held that the PTO had established a *prima facie* case, and could not be expected to "shoulder the burden of conducting market research to establish the actual presence of the design patent container caps in the relevant market." 67 USPQ2d at 1632.

In a rather murky "packaging" trade dress decision, *In re Nordson Corp.*, S.N. 75578830 (March 13, 2003) [not citable], the Board affirmed a refusal to register the mark shown here for metal nozzles for dispensing hot melt adhesives, finding the mark not inherently distinctive. The mark comprises two rings or grooves encircling the nozzle; the stippling on the drawing is for shading purposes only and does not indicate color. The Board concluded that the mark is not a product configuration or product design; however, the rings or grooves have "a functional aspect" in that they are used for the placement of color codes that indicate orifice diameter and engagement dimensions. The Board viewed the "real question" to be "whether purchasers would view the rings or grooves, in and of themselves, as a trademark, that is, whether the mark is inherently distinctive." The Board found nothing in the record to convince it that purchasers would immediately perceive the rings or grooves as a trademark. "Rather, they will be viewed as simply the place where the color coding appears."



It is clear after *Wal-Mart* that a color cannot be an inherently distinctive trademark. But what about a combination of colors? The Board in *In re Landmann Wire Rope Prods., Inc.*, S.N. 75723127 (Oct. 22, 2002) [not citable] raised that question, but declined to provide an answer. It found that, in any case, Landmann had failed to prove inherent distinctiveness for the mark shown here for "wire rope" (red and silver). The Board noted



that unless an ornamental design "is of such nature that its distinctiveness is obvious, convincing evidence must be forthcoming" to prove that the design serves as a source indicator (citing *In re Owens-Corning Fiberglas Corp.*, 227 USPQ 417, 422 (Fed. Cir. 1985)). It noted an interesting twist here: the evidence showed that color is at times used as a trademark in the wire rope industry. Nonetheless, the Board concluded that "Applicant's design of two different color strands is not the type of design that purchasers . . . would immediately recognize as a trademark." Applicant did not make a Section 2(f) claim, and so the issue of acquired distinctiveness did not arise.

### C. Trade dress with acquired distinctiveness

A few applicants have managed to satisfy the TTAB that certain trade dress has acquired distinctiveness. Even one product design applicant!

Of course, a trade dress applicant seeking to establish secondary meaning must show that "the primary significance of the product configuration[] in the minds of consumers is not the product but the producer." *In re Ennco Display Systems, Inc.*, 56 USPQ2d 1279, 1283 (TTAB 2000). Moreover, "the burden is heavier" in cases involving product configuration because consumers do not associate a product design with a particular producer as readily as they do a trademark or packaging trade dress.<sup>11</sup> *Id.* at 1284.

Secondary meaning may be proven by direct and/or circumstantial evidence. Direct evidence includes "testimony, declarations or surveys of consumers as to their state of mind." Circumstantial evidence, from which consumer association might be inferred, includes use of a purported mark for a number of years, extensive sales and advertising, and any like evidence showing wide exposure of the mark to consumers. *Id.* at 1283.

Returning to the yellow caulking gun mark in *Newborn Bros. and Co. v. Dripless, Inc.*, *supra*, Applicant Dripless was seeking registration under Section 2(f). It met its burden to prove acquired distinctiveness by submitting evidence of, *inter alia*, "large and growing" sales since 1990 (reaching nearly one million dollars in 1996), "substantial" advertising and promotional expenditures, and direct evidence (consumer letters) that purchasers recognize the color "yellow" as identifying Dripless as the source of the goods.

The Board found "particularly significant" Applicant's "extensive 'image' advertising and promotion stressing the color 'yellow' in a trademark sense." Dripless highlighted the mark on its stationery, its website, and its advertisements and point-of-sale materials by having "pictures and/or words appear in the color yellow and/or by using one of applicant's phrases about yellow" (e.g., "Grab the 'yellow gun' and get the



job done!"). Thus Dripless cleared both hurdles to trade dress registrability and won the gold medal.

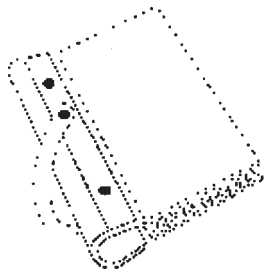
The color combination conundrum came to light again in *In re Chun Kee Steel & Wire Rope Co.*, S.N. 75510018 (Sept. 20, 2002) [not citable], wherein the Board deemed a two-color combination mark for wire rope (red and green) to be registrable on the basis of acquired distinctiveness. Although the Examining Attorney contended that, under



*Wal-Mart*, color combination marks can never be inherently distinctive, the Board again dodged the question. Concluding that customers would not immediately recognize Applicant's color scheme as a trademark, it found the mark to be not inherently distinctive in any case (citing *In re Owens-Corning, supra*). However, in view of the evidence that consumers of wire rope are aware that color combinations may be used as trademarks, the Board found sufficient Applicant's less than overwhelming Section 2(f) evidence: some \$1.8 million in sales since 1993, reference to the color combination on invoices for the goods, and declarations from two customers.<sup>12</sup>

Finally, we come to the only case in which a product shape was found to have acquired distinctiveness, *In re F. Schumacher & Co.*, S.N. 75613624 (Apr. 1, 2004) [not citable]. The Board reversed a refusal to register the rounded binding design shown here for wallpaper sample books, but affirmed a refusal to register the design for wallpaper. Although Applicant and the Examining Attorney considered the design to be "product packaging" with regard to sample books, and argued over whether the design was inherently distinctive, the Board concluded that the design "is more akin to product design and not product packaging" and therefore ruled that acquired distinctiveness must be shown. However, even assuming *arguendo* that the rounded spine design constituted product packaging for sample books, the Board deemed the mark to be "almost, but not quite, inherently distinctive." Applying the *Seabrook* test, the Board found that the design is a "common basic shape" in that many books other than wallpaper sample books have a rounded binding, and that the rounded binding is a "refinement of standard flat bindings."

As to acquired distinctiveness, the Board observed that here, where the mark is almost inherently distinctive, "a very minimal showing pursuant to Section 2(f) should be sufficient" to establish acquired distinctiveness. It noted that the determination of distinctiveness must be made "through the eyes of typical purchasers and users of the goods in question." Schumacher proved secondary meaning vis-à-vis "the true purchasers and users of wallpaper sample books," wallpaper sales professionals. Its use of the mark for more than five years as of the time of the appeal was a factor in its favor. More importantly, Schumacher's vice-president declared that the design was specifically selected so as to "stand out," and was of "great value" despite the added cost of producing the rounded binding. And a professional sales person declared that "from the very beginning" she viewed the rounded binding as an indicator that the books emanated solely from Schumacher.



As to Schumacher's wallpaper, however, the ultimate purchasers are ordinary consumers. Schumacher "failed to make of record any evidence whatsoever establishing that the rounded binding on its wallpaper sample books was initially viewed or has ever been viewed by ordinary purchasers . . . as distinctive or as having become distinctive."

## D. Trade dress without acquired distinctiveness

Trade dress applicants seeking to register a product shape or color as a trademark usually fail to satisfy their "heavier" burden to prove acquired distinctiveness. The applicants in four of the five citable cases discussed in this paper were among those unsuccessful applicants.

### 1. Four citable cases

*In re Ennco Display Systems, Inc.*, 56 USPQ2d 1279 (TTAB 2000), discussed above, provides a useful review of the types of evidence that may support a claim of acquired distinctiveness. The Examining Attorney had conceded during prosecution that Applicant Ennco's product configurations for eyeglass and lens holders and brackets were not *de jure* functional, and so their registration as trademarks would be possible if acquired distinctiveness could be shown. However, the Board found Ennco's evidence to be insufficient to meet the "heavier" burden applicable in product configuration cases. 56 USPQ2d at 1284.

Ennco's "form" declarations from distributors and customers were unspecific and merited little weight. Its advertising and promotional expenses were not broken down by product. Its annual sales figures of 166,666 units sold did not "come close to meeting the substantial level of sales and advertising we conclude is required to establish acquired distinctiveness in this case." More importantly, none of the advertising focused on the "trademark significance of the product configurations, rather than the utilitarian or desirable features of the products." *Id.* at 1285.

Ennco's use of the purported marks for more than five years (ranging from seven to seventeen years) was not alone enough to bestow acquired distinctiveness under Section 2(f).<sup>13</sup> Its evidence of copying by competitors was not "concrete," and in any case "it is more common that competitors copy product designs for desirable qualities or features." Finally, as to its claimed license agreements, Ennco failed to introduce any such agreement into evidence, and "some of the license agree-



ments may have been entered into merely to avoid litigation.” *Id.* at 1286.

In three other citable cases, the Board found *de jure* functionality (as discussed above) but proceeded to consider the applicant’s Section 2(f) evidence for the sake of completeness of the record. In each case the evidence was insufficient to prove secondary meaning.

In the *Ferris* pink bandage case, the Board noted that “the burden is heavier in this case because of the inherent non-distinctive nature of the applied-for mark. It is our view that consumers do not associate a single color of a product with a particular manufacturer as readily as they do a trademark or product packaging trade dress.” Applicant *Ferris* submitted evidence of \$10 million in sales revenue since 1989 and more than \$1 million in advertising and promotional costs for the goods, as well as 145 customer letters. Again, the Board found that Applicant “did not come close to the substantial level of sales and advertising required.”<sup>14</sup> Moreover, its customer letters were “problematic” because some were incomplete, and the “form language” was ambiguous as to whether the customers were referring to the color mark or Applicant’s registered mark “The Pink Dressing.”

In *M-5 Steel*, the Board noted that there were at least two other companies producing roof vents similar to Applicant’s, making it “difficult for Applicant to establish acquired distinctiveness.” Applicant O’Hagin’s not only could not show substantially exclusive use of the mark, but it did not submit evidence that it promoted the product designs as trademarks, or that consumers recognized the designs as source indicators.

And in *Gibson Guitar*, the Board noted that Gibson’s “evidentiary burden is high,” given the fact that “applicant’s guitar configuration is extremely similar to those used by other manufacturers.” Although Gibson had used the configuration since 1934, its sales were “relatively small,” averaging fewer than 1600 guitars annually, and there was no significant evidence of record that Gibson had directed consumers to view the shape as a trademark. Thus the Board concluded that Gibson had not proven secondary meaning.

## 2. Seven uncitables

In seven uncitable decisions — five involving product configurations, one product “packaging,” and the seventh a “color” — the Board ruled that the applicant had failed to show acquired distinctiveness for the trade dress in question. Particularly noteworthy in six of the cases is the lack of evidence regarding promotion of the trade dress as a mark; in the seventh, Pennzoil’s efforts to promote “clearness” as a source indicator for its motor oils were not enough to warrant a finding of secondary meaning.

In *In re Libby Glass, Inc.*, S.N. 75250499 (Sept. 28, 2000) [not citable], Applicant *Libby* sold almost nine

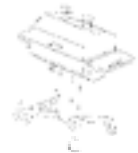
hundred thousand dozen beverage glasses (or 10,800,000 units) incorporating its design, translating into more than nine million dollars in sales, and it expended about 20% of sales revenues on advertising and promotion. Although the Board observed that this glassware “has been actively promoted and sales have been significant,” *Libby* provided insufficient evidence from which to conclude that prospective purchasers view the shape of the glassware as a source indicator. There had been no attempt to draw customers’ attention to the design as an indicator of source; in fact, *Libby*’s advertising material referred to the design as “traditional” and “classic styling.”



Another guitar case serves as an example of how not to prove acquired distinctiveness for a product design. In *re Driskill*, S.N. 75580063 (Jan. 23, 2002) [not citable]. One could imagine Mr. Driskill’s guitar gently weeping as the Board affirmed a refusal to register the product configuration shown here as a trademark for guitars. Driskill offered no evidence of the level of his sales and advertising, no evidence of promotion of the guitar shape as a trademark, and no evidence that potential purchasers look to the shape of a guitar body as a source indicator. Thus his product design trade dress was deemed to be unregistrable under Sections 1, 2, and 45 of the *Trademark Act* because it does not function as a mark.



Another product shape fell short of secondary meaning in *In re Holland Co.*, S.N. 75568851 (May 14, 2002) [not citable]. The Board affirmed a refusal to register under Sections 1, 2, and 45 of the *Trademark Act* the product configuration shown here for “outdoor cooking grills” on the ground that the design is not inherently distinctive and had not acquired distinctiveness. Observing again that the burden of proof is heavier in a case involving a product configuration, the Board found *Holland*’s use of the design for more than five years, its advertising expenditures of more than \$3 million, and affidavits from its president and sales representative as to the uniqueness of the design, to be insufficient to satisfy Section 2(f).



In the *Ivanko Barbell* case, discussed above, the Board also considered whether Applicant’s barbell plate configuration, if it were not functional, had acquired distinctiveness. *Ivanko* submitted the results of a survey showing that 58.5% of respondents associated the appearance of the barbell plate with *Ivanko*. The Board noted, however, that “several factors undercut the weight that we give the survey:” a total of only 117 re-



sponses were analyzed, all the survey interviews took place at two industry conferences, and participants were limited to persons who work for health clubs or exercise equipment manufacturers. The Board gave Ivanko's survey only limited weight, found its sales (\$531,000 in five years) and advertising evidence (not broken down by product) not particularly strong, and concluded that Ivanko failed to meet its burden of proof.

And in *In re Igelmund*, S.N. 75516221 (July 29, 2004) [not citable], the Board agreed with the Examining Attorney that Igelmund had failed to prove acquired distinctiveness for the product configuration shown here for "security fixtures for personal computers, namely shackle-like devices for securing personal computer safety cables." Igelmund submitted three of his own declarations, as well as a declaration from a single catalog retailer/customer, a catalog advertisement, and an instruction sheet. Igelmund's declarations stated that more than 500,000 units had been sold since 1996, but he offered "no advertising that demonstrates promotion of the product configuration . . . as [his] mark," and the record was "devoid of direct evidence that other kinds of retailers" or "the ultimate purchasers of the goods . . . view the matter sought to be registered as a distinctive source indicator for applicant's goods."

Turning to product packaging, in the previously-discussed *In re Pacer Technology* the TTAB chose to consider Pacer's alternative position that its design for a glue container cap had acquired secondary meaning. Because of the relatively nondistinctive character of the mark, the Board noted that the level of proof needed for acquired distinctiveness is substantially higher. Other than several "flawed" form declarations submitted by Pacer, there was no evidence in the record that purchasers would view this design feature as a source indicator. "In fact, we have absolutely no indication that applicant has ever even mentioned the asserted mark in its product advertisements."

Finally, in the *Texaco v. Pennzoil* "clear container" opposition, Applicant Pennzoil made the Section 2(f) question more interesting because it spent millions of dollars promoting its motor oils, resulting in "untold hundreds of millions of separate visual impressions, many of which depicted one or more of applicant's clear containers." Moreover, Pennzoil prominently used such slogans as "The Difference is Clear" and "The Choice is Clear," and the containers themselves carried the statement "CLEAR BOTTLE IS A TRADEMARK OF PENNZOIL QUAKER STATE COMPANY." Nonetheless, Pennzoil's proofs fell short.

The Board observed that the required showing for acquired distinctiveness "is tied to the scope of what [the] applicant is trying to protect." If the Board were to place Applicant's mark along the *Abercrombie* spectrum, the mark would fall at the "generic/highly descriptive" end. Thus when compared with the proof re-

quired for a descriptive term, a slogan, or a label, Applicant's Section 2(f) showing must be "much greater." The Board noted "the ubiquity of nearly identical packaging for many related automotive products." As to Pennzoil's advertising, the promotional efforts "focused primarily on the benefits" of the motor oils, and "was only tangentially promoting the clear bottle." In the aforementioned slogans, "the allusion to the transparency of the container may not be obvious to all prospective purchasers." And the "small type" of the statement on the containers "will be overlooked by most, and what [the statement] means may well not be understood by many others who do notice these statements." Emphasizing the absence of "objective empirical or other direct evidence in the nature of surveys or any other indicators of applicant's success in demonstrating consumer recognition of applicant's clear container as a trademark," the Board ruled that Pennzoil had not met its Section 2(f) burden of proof.

In sum, of the fourteen trade dress applicants who sought to prove acquired distinctiveness, eleven failed. Product configuration applicants were particularly unsuccessful, winding up short of the finish line in eight of nine cases.

### III. Conclusion

In light of the Supreme Court's rulings in *Wal-Mart* and *TrafFix*, achieving registration of trade dress at the PTO has become increasingly difficult. One who seeks to register product configuration trade dress in particular had better be a good hurdler. If the utilitarian advantages of the configuration or other trade dress are disclosed and/or claimed in a utility patent, or if the applicant has touted such advantages in its advertising, there is little or no chance of proving non-functionality.

Even if the functionality hurdle is cleared, the product configuration trade dress applicant must then meet the "heavier" burden of proof that applies to the establishment of secondary meaning for a product shape. Unless the applicant has made a significant effort to promote the configuration as a trademark, there is again little hope that registration can be achieved.

Trademark practitioners, given the opportunity, would advise trade dress clients to avoid "touting" advertising and instead to make use of "look for" advertising that emphasizes that the design in question is a trademark. Unfortunately, owners of purported trade dress tend to seek the advice of their trademark lawyers only after the success of the product has been established in the marketplace, and by then the "damage" has often been done — for example, in the form of boastful advertising.

Of course, each case involves its own particular fact pattern, and excessive generalization is always risky. Nonetheless, this discussion of the TTAB's trade dress decisions since 2000 will, it is hoped, provide some

guidance for the practitioner contemplating an attempt at trade dress registration or already engaged in a TTAB-level battle to secure registration.

<sup>1</sup> "I've got a fist of iron, and a fist of steel. If the right one don't get you, then the left one will." *Sixteen Tons*, written by Merle Travis in 1945 and made famous by Tennessee Ernie Ford in 1955.

<sup>2</sup> Counsel, Foley Hoag LLP, Boston, MA. This paper was presented at the INTA Trade Dress Forum in New York City on October 8, 2004.

<sup>3</sup> In *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 23 USPQ2d 1081 (1992), the Supreme Court held that the décor of a restaurant could be protected under Lanham Act Section 43(a) without proof of secondary meaning. In *Wal-Mart*, the Court stated that the restaurant décor in *Two Pesos* did not constitute product design. Instead, "It was either product packaging . . . or else some *tertium quid* that is akin to product packaging . . ." 529 U.S. at 215, 54 USPQ2d at 1069. This paper will not further discuss the registrability of "restaurant décor," nor will it address other, more obscure forms of trade dress, like golf course holes or building facades; not a single TTAB case since 2000 has addressed those types of trade dress.

<sup>4</sup> *Ennco* was decided a mere month after *Wal-Mart*, and the Board first confirmed that, although *Wal-Mart* involved an unregistered product design in the context of an infringement action under Section 43(a) of the *Trademark Act*, *Wal-Mart* is applicable to the registration of product designs under Section 2 of the *Act*. The Board therefore ruled that *Ennco*'s product designs could not be inherently distinctive as a matter of law and would be protectable only upon a showing of acquired distinctiveness.

<sup>5</sup> *Ennco*'s discussion of the distinction between *de facto* and *de jure* functionality incorporates the "essential for competition" approach of *Morton-Norwich*, which was seemingly supplanted by the *TrafFix* approach.

<sup>6</sup> The TMEP states that "[e]vidence of the availability of alternative designs may be helpful where the record is otherwise unclear regarding the utilitarian functionality of the design at issue." (citing *Valu Engineering*). Thus Examining Attorneys may continue to request information about alternative designs. TMEP § 1202.02(a)(v)(B). (3rd ed., May 2003)

<sup>7</sup> This case was decided before *Valu Engineering*, and the Board panel did not address the issue of whether *Morton-Norwich* was compatible with *TrafFix*.

<sup>8</sup> "This case seems to involve elements of both utilitarian and aesthetic functionality. Here, for example, there is evidence of utility in applicant's patent application, as well as statements touting the superiority of applicant's design in applicant's promotional literature, and statements that applicant's design results in reduced costs of installation. On the other hand, there is no question that applicant's roof designs which match the appearance of surrounding roof tiles are more pleasing in appearance because the venting tiles in each case are unobtrusive." 61 USPQ2d at 1096.

<sup>9</sup> As to acquired distinctiveness, the Examining Attorney had (prior to issuance of the *Wal-Mart* decision) accepted Applicant's Section 2(f) evidence (3 million units sold and \$225,000 in advertising over ten years; form letters from retailers). Judge Simms asserted that the application should be remanded to the PTO for reconsideration of that evidence in light of *Wal-Mart*: "the Examining Attorney may have accepted a lesser showing of acquired distinctiveness than is now arguably required where product design is, *as a matter of law*, not registrable as inherently distinctive."

<sup>10</sup> The Board ruled that Opposer bore the burden to prove its claim of functionality by a preponderance of the evidence. In contrast, as to civil actions involving trade dress that is not registered on the Principal Register, Section 43(a)(3) states that "the person who asserts trade dress protection has the burden of proving that the matter sought to be protected is not functional."

<sup>11</sup> The Supreme Court in *Wal-Mart* made the same observation regarding consumers: "In the case of product design, as in the case of color, we think consumer predisposition to equate the feature with the source does not exist. Consumers are aware of the reality that, almost invariably, even the most unusual of product designs — such as a cocktail shaker shaped like a penguin — is intended not to identify the source, but to render the product itself more useful or more appealing." 529 at 213, 54 USPQ2d 1069.

<sup>12</sup> The *Chun Kee* decision suggests that the applicant in *Landmann Wire Rope, supra*, should try its luck with a Section 2(f) application.

<sup>13</sup> The Board cited *Devan Designs Inc. v. Palliser Furniture Corp.*, 25 USPQ2d 1991 (M.D. N. Car. 1992) for the proposition that "if a trade dress consists of the overall design of the product itself, then it will usually take longer to acquire distinctiveness." 56 USPQ2d at 1286.

<sup>14</sup> The Board cited cases in which \$5.5 million in advertising, \$100 million in advertising and \$3 billion in sales, and \$56 million in sales were deemed insufficient under Section 2(f).