

Trade Dress at a Glance: Protecting the Look and Feel of a Product

July 20, 2023

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When safeguarding their consumer reputation, most companies recognize the value in their brand names, logos, slogans, and their associated goodwill and the importance of protecting those assets. However, many neglect to protect their trade dress: the look and feel of a company's product, packaging, or services.

Trade dress can be a powerful source-identifying tool: rather than protecting a specific name or logo, trade dress is about the "overall design and appearance" of a product. It can include elements that may not be protectable on their own. *Nora Beverages, Inc. v. Perrier Group of Am., Inc.*, 269 F.3d 114, 118 (2d Cir. 2001). Trade dress can come in many forms, and courts have upheld trade dress protection in colors, store layouts, and website designs.

The U.S. Supreme Court recently referenced trade dress as part of its discussion on whether elements of a dog squeaky toy infringed on several Jack Daniel's trademarks — including their styled white filigree and distinctive square bottle. More on that decision and its implications on First Amendment protections can be found in our previous client alert [here](#). This article focuses instead on how companies can incorporate trade dress protections into their intellectual property portfolio.

The Elements of Trade Dress

To qualify as a protectable trade dress, the product packaging or design must meet two main criteria: it must be inherently distinctive (or have acquired a secondary meaning that makes it source-identifying) and be nonfunctional.

"Distinctiveness" can be a nebulous term, and courts consider the distinctiveness of product design and packaging differently. The Supreme Court has held that a product's design is not inherently distinctive without acquiring secondary meaning that ties it to a brand. *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 212 (2000). A product's packaging, however, or the overall design elements of a restaurant or retail store (which the Court viewed as being more akin to packaging than product), can be inherently distinctive. In instances where an element of package design is particularly unique or fanciful or when several commonplace elements are taken together to make a whole, trade dress may lead a consumer to associate it with a particular company or brand.

Some packaging design elements are distinctive enough to qualify as protectable trade dress in their own right. One of the most famous examples is the design of a glass bottle of Coca-Cola; without any additional labeling or context, the average consumer can immediately identify the brand behind it and the product contained within it. Some characteristics, like specific colors, may not be inherently distinctive at their outset but can acquire a secondary meaning through their use — such as Tiffany & Co.'s distinct blue box.

Trade dress looks at the entirety of a design. Even commonplace elements without a solid secondary meaning, such as the

examples above, can be part of a distinctive trade dress. Grouped together, such elements can form a unique whole, and the more elements used to establish the overall look and feel, the more likely a trade dress is to be protected. For example: in 2013, Apple was able to secure protection for its retail locations' overall look and feel. Taking the elements of their store design as a whole, Apple conveyed an overall image that was distinct and identified their brand.

In some cases, a trademark registered and protected in its own right gained more robust protection through its incorporation into trade dress. In *Gucci Am., Inc. v. Guess?, Inc.*, 868 F. Supp. 2d 207, 248 (S.D.N.Y. 2012), Guess was found not to have infringed on one of Gucci's trademarked logos with their similar mark, but the Court found that when the logos were both used in a similar brown-on-beige product design, it was a step too far.

Non-functionality is the other essential element of trade dress. Functionality, in this case, covers elements necessary for product use and those that affect cost or quality. When the features that make the product useable and the aesthetic elements that allow a customer to identify the source are one and the same, courts are reluctant to classify those features as trade dress. Visually distinct components that are also protected by a utility patent, for example, are generally not protected as trade dress. *TraFFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 29 (2001). However, the inclusion of functional elements in a trade dress does not necessarily render it unprotected. The hands and dial of a watch are undoubtedly useful, but their aesthetic qualities are trade dress. *Cartier, Inc. v. Sardell Jewelry, Inc.*, 294 F. App'x 615 (2d Cir. 2008). A functional aspect that incidentally creates a distinctive feature (such as a decorative embossment made by a patented process) can also be protected trade dress. *McAirlaids, Inc. v. Kimberly-Clark Corp.*, 756 F.3d 307, 312 (4th Cir. 2014).

Taking Appropriate Action

Trade dress is protected by federal law, and companies concerned that a competing product is imitating the look and feel of their trade dress can sue under the Lanham Act. Although it is possible to protect trade dress without registering it with the U.S. Patent and Trademark Office first, an ounce of prevention is worth a pound of cure. Taking the proactive step of registering a trade dress makes it easier for companies to enforce their rights: for example, 15 U.S.C.A. § 1125(a)(3) states that a person who seeks to protect an unregistered trade dress has the burden of proving the elements they wish to protect are nonfunctional. Registering their trade dress on the principal register can save a company that burden. Companies, particularly the design and marketing departments, should consult with their trademark attorneys early in product development to avoid unintended infringement pitfalls in their products and packaging and to determine if registering their trade dress is practical and serves their specific needs.

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