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Entrepreneur's Guide to Intellectual Property - Blog Series: Protecting Your Products and Packaging with Trade Dress

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You have invested in research and development and spent a lot of money creating a distinctive image for your product. Now you are faced with the challenge of how to protect this investment from competitors who may seek to copy or knock-off your product designs or packaging. Summarized here is how you can use trade dress to protect your investment.

Trade dress is the total image of a product and may include features such as size, shape, color or color combinations, texture and graphics. Trade dress is comprised of the aspects of overall appearance that distinguish a firm's goods and identify their source, without serving any other significant function.

The United States Patent and Trademark Office (USPTO) permits the registration of trade dress if it is non-functional, distinctive and serves to identify and distinguish the goods of a particular provider from those of others. Registration is for an initial term of ten years and can be extended indefinitely so long as the required maintenance fees are paid and the trade dress continues to function as an identifier of source. The first step is to determine whether the trade dress sought to be registered is a "product design," or instead, "product packaging." This distinction determines the manner in which the trade dress is evaluated by the USPTO. Product packaging trade dress includes the total image created by the packaging in which a product is marketed and is conceptually separable from the product itself. Product configuration trade dress encompasses the design or particular features of the product and is inseparable from the product itself.

Product Design

Registration of "product design" trade dress on the USPTO's Principal Register requires a showing of "acquired

distinctiveness." Trade dress has "acquired distinctiveness" when in the minds of the purchasing public it serves to identify the source of the product. Volkswagen's "Beetle" automobile is an example of well established product design trade dress. Typically, acquired distinctiveness is shown by consumer surveys, affidavits from consumers or those involved in the relevant industry, sales figures, the nature and extent of advertising and promotion (particularly advertising and promotion that emphasizes the trade dress elements of the product). Acquired distinctiveness may also be established by substantially exclusive use of such trade dress in commerce for a period of five years.

Product Packaging

An applicant seeking to register its "product packaging" trade dress need not show "acquired distinctiveness" but may be able to obtain registration upon a showing that its packaging is "inherently distinctive." Packaging is "inherently distinctive" when by its intrinsic nature it identifies a particular source. An example of inherently distinctive product packaging trade dress is the squat, bright orange Tide laundry detergent container.

To prevail on a claim of trade dress infringement, you must show (i) that your trade dress is either inherently distinctive or has acquired secondary meaning, as the case may be, and (ii) that the accused party's trade dress causes a likelihood of consumer confusion as to the source of the respective products. Courts use various factors to determine whether there is a likelihood of confusion between the trade dress of two products. Typically, those factors include the similarity of trade dresses, the strength of the plaintiff's trade dress, the area and manner of concurrent use of the respective trade dresses, the degree of care likely to be used by consumers in making their purchases, actual confusion, and the intent of the accused party to pass off its product as that of the trade dress owner. No single factor is dispositive, and the weight given to each factor varies from case to case based upon the relevant facts.

Recommendations to Protect Trade Dress

When promoting products, tout the uniqueness of the non-functional features by using verbal descriptions and printed materials (sell sheets, labels, web pages, etc.) that emphasize the "uniqueness," "distinctiveness," "originality," and "exclusivity" of the design or packaging. Tell the trade and consumers to "look for" certain specific distinguishing ornamental characteristics of your products.

1. Put the public and competitors on notice of your trade dress claims. For example, you could include a legend on materials accompanying your product such as the following: "The shape and appearance of this distinctive [product] [and packaging] are trademarks and trade dress of [your company name]."
2. For any trade dress that consists of a product configuration that can be graphically depicted, reproduce such item on the product label, hang tags, packaging and/or on other promotional items. If the product configuration is not yet registered, it can be depicted in tandem with the symbol "™". If it is federally registered, it should be depicted in tandem with the symbol "®".
3. Do not tout the utilitarian features of your trade dress. Doing so may provide grounds for a competitor to challenge your trade dress as being "functional" and therefore unprotectable.
4. File applications with the USPTO to protect your trade dress. When applicable, present affidavits and evidence that support a claim for "acquired distinctiveness."

Conclusion

Trade dress, patent and copyright protection are tools that you can use to protect the investment and goodwill in your products and their packaging. These forms of protection are not mutually exclusive and one or more may be available with respect to a particular product or design. Considering these forms of protection early in the product life-cycle can provide you an opportunity to pursue protection and best position your company to challenge those who may seek to copy or knock-off your products.

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