

2000

40 IDEA 105

RECENT DEVELOPMENTS IN TRADE DRESS INFRINGEMENT LAW

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The extent to which a competitor's trade dress may be copied without crossing the infringement line is a hot legal topic pitting both brand name manufacturers against private label imitators and brand name companies against brand name competitors. The purpose of this article is three-fold: 1) to define protectible "trade dress"; 2) to outline the legal theories for trade dress infringement; and 3) to discuss the leading trade dress infringement cases, including claims for infringement of product packaging, color, scent, sound marks, and product configurations.

I. What is Protectible Trade Dress

Trade dress encompasses the total image and overall impression created by a product. It embraces both the look of a product and its packaging, in addition to the design, shape, and color of the product. "'Trade dress' involves the total image of a product and may include features such as size, shape, color or color combinations, texture, graphics, or even particular sales techniques." n1 Historically, trade dress referred to the product packaging and labeling, but the courts have expanded the term to include the total appearance of a product. n2 However, trade dress does not grant exclusive rights to a vague image or a product marketing theme, such as linking Scandinavia to premium ice cream. n3

Product packaging, containers, configurations, and shapes are proper subjects for trademarks, provided that they have acquired secondary meaning and are non-functional. Examples of protected packaging include the Pam Cooking Spray can, n4 a whisky bottle, n5 and the Ouzo liqueur bottle. n6 Examples of protected trade dress for product configurations include the shape and appearance of Ferrari automobiles n7 and the Rolls-Royce grille. n8

Nabisco, Inc. recently challenged the validity of Pepperidge Farm's trademark registration for the configuration of its fish-shaped crackers. n9 Nabisco planned to introduce a fish-shaped cheese cracker into the snack food market by including the cracker in a mix based on the Nickelodeon cartoon series "CatDog". n10 Pepperidge Farm objected to these plans, maintaining that Nabisco was attempting to capitalize on the success of its Goldfish crackers and to confuse consumers by launching a similar fish-shaped cracker. n11

Adopting an offensive stance, Nabisco brought a declaratory judgment action alleging that Pepperidge Farms' trademark for the fish-shape of its crackers is invalid. n12 Nabisco argued that there are "no valid trademark rights in the goldfish-shaped product configuration." n13 Pepperidge Farm defended on the ground that its trademarks for the Goldfish name and shape are valid, registered trademarks. n14 The District Court found that the goldfish-shaped cheese cracker was a unique and fanciful idea and that Pepperidge Farm had spent considerable revenue to cultivate a secondary meaning and boost the image of its Goldfish cracker. n15

The court ordered Nabisco to recall all CatDog products from retailers and cease the use of the goldfish shape in the manufacture, distribution, sale, advertisement or promotion of any of its products. n16

II. Legal Avenues to Protect Trade Dress

A. Federal Registration

Trade dress can be registered as a trademark with the United States Patent and Trademark Office ("PTO") if the trade dress is:

1) inherently distinctive or has acquired secondary meaning; and 2) is non-functional. n17 These elements are further discussed below.

Registered trademarks, including trade dress, are protected under section 32 of the Lanham Act. n18 Although trade dress may also be protected under section 43(a) of the Lanham Act, which protects unregistered marks, n19 as well as under state statutes n20 and common law, n21 federal registration provides many important benefits. Federal registration serves as the foundation for nationwide protection of trademark rights. n22 Federal registration also establishes federal jurisdiction in infringement actions, n23 provides the potential basis for treble damages, n24 and is admissible as prima facie evidence of the owner's rights in and to the trade dress. n25

Perhaps most importantly, federal registration prevents others from registering the same or confusingly similar trade dress with the PTO. n26 In addition, registration on the Principal Register constitutes constructive notice of the registrant's claim to exclusive ownership of the trade dress. n27 Further, under certain conditions the registration may become incontestable, thereby limiting the basis on which others may seek registration cancellation. n28

B. Section 43(a) of the Lanham Act

As mentioned, protection for trade dress may be found in section 43(a) of the Lanham Act, which does not require federal registration. n29 Section 43(a) prohibits the use of any "word, term, name, symbol, or device, or any combination thereof, or any false

designation of origin" which is "likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of . . . or as to the origin, sponsorship, or approval" of one party's product with the product of another party. n30 The courts have broadly interpreted this language "to provide protection against deceptive marking, packaging, and advertising of goods and services in commerce." n31

The standards for section 43(a) protection are similar to those required for trade dress registration under section 32 of the Lanham Act. The plaintiff must prove that the trade dress is either inherently distinctive or has acquired distinctiveness through secondary meaning. n32 In addition, the plaintiff must establish that the defendant's trade dress will likely be confused with that of the plaintiff. n33

1. Inherent Distinctiveness

The trade dress requirements of inherent distinctiveness or secondary meaning are more fully articulated in the leading case of *Two Pesos, Inc. v. Taco Cabana, Inc.* n34 which involves the trade dress of a Mexican restaurant. In this case, the Supreme Court held that the establishment of inherent distinctiveness sufficiently evokes trade dress protection without the need for proof of a secondary meaning. n35

Although the *Two Pesos* Court did not establish guidelines to measure the inherent distinctiveness of trade dress, a number of federal courts of appeals have established their own parameters. For example, the three-pronged test applied in the Third Circuit to determine if a trade dress is inherently distinctive is whether it is 1) unusual and memorable; 2) conceptually separable from the product; and 3) likely to serve primarily as a designator of origin of the product. n36 On the other hand, the Eleventh Circuit examines 1) whether the particular trade dress consists of a "common basic shape or design"; 2) "whether it is unique or unusual in a particular field"; and 3) "whether it is a mere refinement of a commonly-adopted and well-known form of ornamentation for the [particular class of] goods." n37

The Second Circuit, in the 1993 case, *Paddington Corp. v. Attiki Importers & Distributors, Inc.*, n38 adopted a dissimilar approach and applied the trademark standards for distinctiveness set forth in *Abercrombie & Fitch Co. v. Hunting World, Inc.* n39 The *Paddington* court followed the "spectrum of distinctiveness" test used to measure the strength of word marks, including, whether a mark is arbitrary, fanciful, suggestive, descriptive, or generic, to determine whether a particular trade dress is inherently distinctive. n40

However, in 1995 in *Knitwaves, Inc. v. Lollytogs Ltd.*, n41 the Second Circuit retreated from the "word spectrum" test and adopted a different standard to determine inherent distinctiveness. n42 In this case, the court examined the inherent distinctiveness of "squirrel" and "leaf" designs on girls' sweaters. n43 According to the standard set forth in *Knitwaves*, the trade dress owner must show that the primary intention of the design in question is as a source identifier for that product design to be inherently distinctive. n44 The court held the "leaf" design on *Knitwaves'* sweaters was insufficient as an indicator of source to warrant trade dress protection. n45

Later, in 1998, the Second Circuit reached a different conclusion in *Samara Bros. v. Wal-Mart Stores, Inc.*, n46 when it found that the "overall look" of a line of children's

clothing, including seersucker fabric and bold appliques, merited trade dress protection. n47 The court distinguished Samara from Knitwaves because Samara's clothing line used a consistent design while Knitwaves' clothing line incorporated a seasonal motif that previously had never been used. n48 The fact that Samara produced a clothing line containing a consistent design for a number of years persuaded the court to allow trade dress protection. n49 The U.S. Supreme Court granted certiorari in this case on October 4, 1999. The issue to be determined is, "What must be shown to establish that a product's design is inherently distinctive for purposes of Lanham Act trade-dress protection?" n50

In trade dress infringement cases, establishing that the plaintiff's trade dress is inherently distinctive and therefore entitled to trade dress protection does not end the inquiry, because a finding of inherent distinctiveness "does not guarantee that the mark is a strong one." n51 In *Conopco, Inc. v. Cosmair, Inc.*, n52 Calvin Klein Cosmetics Co., with its Conopco licensee, sought a preliminary injunction against Ralph Lauren Corp. and its Cosmair licensee on the basis that Ralph Lauren's Romance perfume bottle infringed the trade dress of Calvin Klein's Eternity perfume bottle. n53 The court found that while the Eternity bottle was inherently distinctive as an incontestably registered trademark, "the Eternity perfume bottle's trade dress is weak because, considered as a whole, it is quite similar to perfume bottles used by past and present fragrance designers, and is therefore not particularly distinct." n54 The court further found an absence of persuasive evidence establishing secondary meaning, n55 dissimilarity in appearance between the two bottles, n56 differing marketing techniques employed by the parties, n57 and that the Romance name was prominently included on the bottle cap and box of that bottle. n58 Therefore it denied the motion for a preliminary injunction. n59

2. Secondary Meaning

If a company's trade dress is not inherently distinctive, the company may seek to prove secondary meaning under Section 43(a) of the Lanham Act. According to the Supreme Court in *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, n60 secondary meaning is acquired when "in the minds of the public, the primary significance of a product feature . . . is to identify the source of the product rather than the product itself." n61 The plaintiff must prove that the public associates the total "image" of its package with one source and that consumer confusion will result from the presence of the two products in the marketplace. n62

Some cases indicate that secondary meaning is not necessary to protect trade dress in packaging or display. n63 However, most cases state that intentional copying of trade dress is probative of secondary meaning. n64 In fact, some courts have held that intentional copying creates a presumption that the second comer intended to create a confusing similarity of appearance and will be presumed to have succeeded. n65

3. Functionality

In order for trade dress elements to be protected they must also be primarily non-functional. The Supreme Court has stated that, "in general terms, a product feature is functional [and cannot serve as a trademark] if it is essential to the use or purpose of the article or if it affects the cost or quality of the article." n66 The functionality defense appears most frequently in product configuration cases because a product's shape is often a consideration in product design or manufacture.

In *Qualitex Co. v. Jacobson Products Co.*,⁶⁷ the Supreme Court expanded the functionality definition articulated in *Inwood* and added that a product may be functional if the plaintiff's exclusive use of the design inhibits competition.⁶⁸ The Second Circuit follows the *Qualitex* definition by emphasizing that a defendant who asserts a functionality defense must show that the plaintiff's packaging is useful and that the useful feature is an essential element for effective competition in that market.⁶⁹

C. Likelihood of Confusion

To prevail in an infringement action, the plaintiff must demonstrate that the defendant's trade dress will likely be confused with that of the plaintiff.⁷⁰ The test is whether the total image and impression created by the defendant's product or package results in a likelihood of confusion in the mind of an ordinary purchaser.⁷¹

Evidence of actual buyer confusion is not necessary.⁷² The courts evaluate the strength of the trade dress, the similarity of the design, the similarity of the products, the overlap of retail outlets and purchasers, the similarity of advertising media, the defendant's expressed or imputed intention, and any instances of actual confusion.⁷³ Striking similarity to a plaintiff's trade dress is probative of intentional copying, which is a compelling factor.⁷⁴

In addition, the courts also compare the parties' packaging and labeling and consider any elements that the ordinary purchaser observes.⁷⁵ This includes the size, shape, color, design, texture, and word and symbol trademarks of both the product and packaging.⁷⁶ The ultimate determination, by nature, is subjective.⁷⁷ As Justice Holmes stated in a trade dress case, "Beyond stating the principles to be applied there is little to be said except to compare the impression made by the two [conflicting packages]."⁷⁸

1. Dilution

Owners of "famous" trademarks have successfully used the Federal Trademark Dilution Act to protect trade dress.⁷⁹ Dilution is defined as "the lessening of the capacity of a famous mark to identify and distinguish goods or services, regardless of the presence or absence of (1) competition between the owner of the famous mark and other parties, or (2) likelihood of confusion, mistake, or deception."⁸⁰

Unlike a trade dress claim under section 43(a) of the Lanham Act, a dilution claim does not require a showing of likelihood of consumer confusion.⁸¹ Rather, the critical factor in a dilution case is whether the mark is sufficiently famous and well-known to the consuming public, not likelihood of confusion.⁸² Thus, a trademark owner does not have to prove that the marks compete in the marketplace, are used on related goods or services, or are likely to be confused.⁸³

The threshold requirement to bring a dilution case is that a trademark owner must demonstrate that its mark became "famous" prior to the defendant's use of the identical or similar mark.⁸⁴ The courts consider the following factors to determine whether a mark is famous:

- (A) the degree of inherent or acquired distinctiveness of the mark;

- (B) the duration and extent of use of the mark in connection with the goods or services with which the mark is used;
- (C) the duration and extent of advertising and publicity of the mark;
- (D) the geographical extent of the trading area in which the mark is used;
- (E) the channels of trade for the goods or services with which the mark is used;
- (F) the degree of recognition of the mark in the trading areas and channels of trade used by the marks' owner and the person against whom the injunction is sought;
- (G) the nature and extent of use of the same or similar marks by third parties; and
- (H) whether the mark was registered. n85

Trademark owners have been able to demonstrate the requisite fame without being a Nike or McDonald's, provided the marks are distinctive and generate wide recognition in their community. The "famous" requirement is a stricter standard than most state dilution statutes which require that the mark be distinctive or well recognized. n86

Dilution can occur in two ways: tarnishment and blurring. Tarnishment of a trademark occurs when an unauthorized user degrades the distinctive quality of a mark by associating it with undesirable, shoddy, or unsavory goods or services. n87 Blurring occurs when a defendant uses a plaintiff's trademark to identify the defendant's goods or services. n88 This creates the possibility that the mark will cease to serve as a unique identifier of the plaintiff's product. n89

In *I.P. Lund Trading v. Kohler Co.*, n90 the First Circuit confronted both trade dress infringement and dilution claims regarding competing faucet designs. n91 Lund, owner of the VOLA faucet, brought an action against Kohler based on Kohler's introduction of the Falling Water Faucet, a similar but less expensive faucet. n92 Lund claimed that the Falling Water Faucet infringed and diluted the trade dress of the VOLA faucet. n93

To determine the inherent distinctiveness of the VOLA faucet, the court chose not to follow the Abercrombie test, but adopted the test set forth in *Seabrook Foods*. n94 The court believed the *Seabrook Foods* test was consistent with the *Knitwaves* test. n95 After analyzing the VOLA faucet and evidence presented, the court held that the VOLA faucet was not inherently distinctive because it was not an indicator of source and had not acquired a secondary meaning. n96 However, if a claim under section 43(a) fails to establish a lack of confusion among consumers, trade dress owners may still prevail under the Federal Trademark Dilution Act or state dilution laws. In this instance, the court held that the VOLA faucet did not satisfy the requirement of fame necessary to prevail on a claim brought under the Federal Trademark Dilution Act. n97

III. Leading Trade Dress Infringement Cases

A. Private Label: Imitations of Name Brand Product Packaging

Consumers are often confronted with private label imitations of brand name products in supermarkets, drug stores, and other stores. These less expensive versions of name

brand medicines, perfumes, and countless other consumer products bear the claims: "Compare to X" and "If you like 'X', you'll love 'Y'".

Manufacturers invest considerable time, money, and effort to create distinctive "trade dress" that will promote good will and public recognition of their products. Private label manufacturers often adopt the same or similar trade dress for their lower-priced products and substitute their names for the brand names.

In those cases where manufacturers have sought legal redress, manufacturers claim that private labelers profit at the manufacturers expense. Without any of their own expenditures, the private labelers are able to adopt the trade dress that a manufacturer has made an effort to establish. Manufacturers argue that private labelers cause consumer confusion. Private labelers rebut these arguments and contend that they provide an important benefit to consumers who understand that private label products with similar trade dress are actually lower-priced alternatives. This defense has gained judicial acceptance over the last ten years and has led to rulings against name brand manufacturers. Clearly, the pendulum has swung to the benefit of private labelers.

For example, courts found in favor of the private labeler in each of the following cases: the adoption of the trade dress of a leading mouthwash, n98 the packaging of a name brand pain reliever, n99 the trade dress of an athletic shoe, n100 and the trade dress of a name brand boat caulk. n101 The private labelers won their claims based on the same fact -- the private label name was predominately displayed on the packaging and there was no evidence of confusion or "passing off."

In a case where a private labeler copied the trade dress of Vaseline Intensive Care Lotion, the court concluded that the private labeler was entitled to mimic the trade dress of a well-known name brand product as long as the private label brand clearly displayed the private labeler's name. n102

The swing in favor of private labelers is by no means conclusive. In November 1997, a federal district court in Michigan found that a private labeler of an over-the-counter pharmaceutical product infringed the trade dress of a name brand product. n103 Arbor Drugs, a manufacturer of generic over-the-counter pharmaceutical products, did not dispute that its product packaging for Arbor Ultra Lactase, a digestive aid for lactose-intolerant persons, was similar to McNeil's product packaging for Lactaid Ultra, also a digestive aid for lactose-intolerant persons. n104 However, Arbor argued that its private label name was prominently displayed on the packaging and that the package contained both a "Compare to" statement and a disclosure that the product was not manufactured by McNeil Consumer Products, the distributor of Lactaid Ultra. n105 After review of both products' packaging, the court found that McNeil's packaging was "inherently distinctive" and entitled to protection against copying by Arbor. n106

Although this case was decided in favor of the name brand manufacturer, private labelers should not consider packing up their products. The court in the Arbor Drugs case distinguished the Vaseline case by pointing out that the products at issue in that case had been competing side by side for over 10 years. n107

According to the current status of the law, the rule appears to be that if private label products, which imitate the trade dress of the name brand, have been competing in the

marketplace with name brand products for a substantial period of time, they may continue to do so as long as the private label name is prominently displayed on the packaging. However, it appears that newcomers cannot adopt a name brand trade dress (according to the Eastern District of Michigan) even if the private labeler prominently displays the private label name on the packaging.

B. Color

In the landmark decision of *Qualitex Co. v. Jacobson Products Co.* n108 in 1995, the Supreme Court unanimously held that a color alone can be registered as a trademark. n109

Since the 1950's, Qualitex has used a special shade of green-gold color on the dry cleaning pads that it makes and sells to dry cleaning firms for use on dry cleaning presses. n110 In 1989, a competitor of Qualitex, Jacobson Products, began to sell its own press pads with a similar green-gold color to dry cleaning firms. n111 In 1991, Qualitex registered the green-gold color on its press pads with the PTO. n112 The district court held that press pad purchasers identified Qualitex's press pads by their color and that Jacobson intentionally copied the overall look of Qualitex's press pads. n113

The Ninth Circuit reversed the district court's judgment for Qualitex on the ground that the Lanham Act does not permit registration of color alone, n114 and Qualitex appealed to the Supreme Court. n115 The Supreme Court held that the language of the Lanham Act and the basic underlying principles of trademark law "include color within the universe of things that can qualify as a trademark. The language of the Lanham Act describes that universe in the broadest of terms. It says that trademarks "include any word, name, symbol, or device, or any combination thereof" n116

Since human beings might use as a "symbol" or "device" almost anything at all that is capable of carrying meaning, this language, read literally, is not restrictive. n117 The Court stated that, like a word, name, or symbol, a color can attain secondary meaning in the minds of the public so that its primary significance is to identify the source of the product. n118 In addition, the Supreme Court stated that since a color will not always be essential to a product's use or function, the "functionality" doctrine discussed above does not automatically bar the registration of a color by itself. n119

In another color-related case, *Black & Decker Inc. v. Pro-Tech Power Inc.*, n120 the Court found that Black & Decker's yellow and black color scheme for its line of DeWalt professional power tools was a valid trademark. n121 In 1993, Pro-Tech Power began using the colors yellow and black on a line of power tools which closely resembled the look of the DeWalt tools. n122 Black & Decker brought suit against Pro-Tech alleging, among other claims, that the use of yellow and black on its power tools was an infringement of Black & Decker's trade dress. n123

The district court held that Black & Decker's yellow and black color scheme was non-functional and had acquired secondary meaning as a result of evidence submitted by Black & Decker regarding its marketing efforts, media coverage, and customer comments about the color scheme. n124

Since the color scheme was virtually identical, the companies competed in the same market, and there was evidence of actual consumer confusion, the court held that a

likelihood of confusion existed between Pro-Tech's power tools and the DeWalt power tools. n125 Pro-Tech was enjoined from using the colors yellow and black in connection with power tools. n126

Accordingly, Qualitex stands for the principle that a color alone may serve as a trademark and may be registered where that color has attained secondary meaning by identifying and distinguishing a particular brand and the color is not functional.

C. Scent Marks

A recent trend in the trade dress arena is registration of "sensory marks," namely, scent and sound marks. Scent marks are classified by the PTO into three categories according to the scent's relationship to the product.

The first category includes "primary scent marks," in which scent is the foremost reason that consumers purchase the product, namely, perfumes and air fresheners. n127 The second category contains "secondary scent marks," in which scent is an important rather than primary consideration of the consumer. n128 Examples of secondary scent marks include soap: the primary purpose of the product is to cleanse and the secondary purpose is to scent the body. n129 The third and final category contains "unique scent marks," which are marks that normally do not have a scent or one specific scent that consumers traditionally associate with the product. n130 Examples are scented yarn or motor oil. n131

The PTO will recognize primary and secondary scent marks for registration; however, the PTO will allow registration of unique scent marks only if substantial evidence of secondary meaning is introduced. n132 In re Clarke addresses the issue of scent marks. n133 In this case, Clarke filed an application to register a "mark" that was a "high impact, fresh floral fragrance reminiscent of Plumeria blossoms." n134 Following the initial refusal of the application because the mark did not function as a trademark, Clarke appealed to the Trademark Trial and Appeal Board ("TTAB"). n135 The TTAB held that Clarke submitted sufficient evidence that the scented fragrance for thread and embroidery yarn had acquired secondary meaning and could serve as a trademark. n136 Accordingly, registration of Clarke's mark was allowed. n137

Since Clarke, there have been other attempts to register "unique scent marks" with the PTO. For example, there are separate applications pending in the PTO to register the scent of cherry n138 for synthetic lubricants for high performance racing and recreational vehicles, and the scents of strawberry n139 and grape n140 for lubricants and motor fuels for land vehicles, aircraft, and watercraft. A pending application to register a "lemon fragrance" for toners for digital laser printers, photocopiers, microfiche printers, and telecopiers was abandoned on November 7, 1998. n141 Because the scents are not functional or necessary elements for lubricants, motor fuels, and toners, they are "unique scent marks" and, under Clarke, may be entitled to protection upon a showing of secondary meaning.

D. Sound Marks

Sound marks can identify and distinguish one's services through audio, rather than visual, means and are another subset of sensory marks. Sound marks may be registered if they function as source indicators when they create an association of the sound with the

service. The first such mark to be registered was the "musical notes G, E and C played on chimes," which was registered by the National Broadcasting Company for its radio broadcasting services. n142

To date, federal registrations have been granted for the sound of a howling wolf for beer, n143 the sound of thunder and rain for automatic misting units for delivering a timed water mist to fruits and vegetables in display cases, n144 the sound of a cat's meow for entertainment services, n145 and probably one of the most recognizable sound marks, Tarzan's yell. n146

Harley-Davidson, Inc. has filed an application to register the "exhaust sound of applicant's motorcycles, produced by V-twin, common crankpin motorcycle engines." n147 The application cleared the PTO's examination process but did not clear the 30-day opposition period. n148 Oppositions were filed by Honda Motor Co. and American Honda Motor Co., Inc., Yamaha Hatsudoki Kabushiki Kaisha, Nostalgia Motorcycle Co., Inc., Polaris Industries, Inc., Kawasaki Motors Corp., U.S.A., Custom Chrome, Inc., Mid-USA Cycle Pars, Inc., Suzuki Motor Corporation, and S & S Cycle Incorporation. n149 This application for registration and the oppositions are pending. n150

IV. Conclusion

Trade dress is an evolving and dynamic area of trademark law. To obtain legal protection for trade dress, an owner must establish that the trade dress is inherently distinctive or has acquired secondary meaning and is non-functional. To date, trade dress protection has been extended to product packaging and configurations, as well as color, sound and scent marks. It remains to be seen whether trade dress protection will ever be extended to "touch" or "feel" marks.

n1 *John H. Harland Co. v. Clarke Checks, Inc.*, 711 F.2d 966, 980, 219 U.S.P.Q. (BNA) 515, 528 (11th Cir. 1983).

n2 See 1 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, § 8.4, at 8-10 (rel. no. 8, Dec. 1998).

n3 See *Haagen-Dazs, Inc. v. Frusen Gladje Ltd.*, 493 F. Supp. 73, 75, 210 U.S.P.Q. (BNA) 204, 206 (S.D.N.Y. 1980).

n4 See *AHP Subsidiary Holding Co. v. Stuart Hale Co.*, 1 F.3d 611, 613, 27 U.S.P.Q.2d (BNA) 1758, 1759 (7th Cir. 1993).

n5 See *Ex parte Haig & Haig Ltd.*, 118 U.S.P.Q. (BNA) 229, 231 (Dec. Comm'r Pat. 1958).

n6 See *Paddington Corp. v. Attiki Importers & Distrib., Inc.*, 996 F.2d 577, 584, 27 U.S.P.Q.2d (BNA) 1189, 1193 (2d Cir. 1993).

n7 See *Ferrari s.p.a. Esercizio Fabriche Automobil E Corse v. Roberts*, 944 F.2d 1235, 1239-40, 20 U.S.P.Q.2d (BNA) 1001, 1005-06 (6th Cir. 1991).

n8 See *Rolls-Royce Motors Ltd. v. A & A Fiberglass, Inc.*, 428 F. Supp. 689, 698, 193 U.S.P.Q. (BNA) 35, 45 (N.D. Ga. 1977).

n9 See *Nabisco, Inc. v. PF Brands, Inc.*, 50 F. Supp. 188, 192 (S.D.N.Y. 1999).

n10 See *id.* at 192.

n11 See *id.* at 192-93.

n12 See *id.* at 194.

n13 *Id.* at 193.

n14 See *id.* at 194.

n15 See *id.* at 209.

n16 See *id.* at 212.

n17 See *Stuart Hall Co. v. Ampad Corp.*, 51 F.3d 780, 783 (8th Cir. 1995) (citing *Prufrock Ltd. v. Lasater*, 781 F.2d 129, 132 (8th Cir. 1986)).

n18 See Trademark (Lanham) Act of 1946, ch. 540, § 32, 60 Stat. 427, 437 (codified as amended at 15 U.S.C. § 1114 (1994)).

n19 See Trademark (Lanham) Act of 1946, ch. 540, § 43(a), 60 Stat. 427, 441 (codified as amended at 15 U.S.C. § 1125(a) (1994)).

n20 See, e.g., Ariz. Rev. Stat. § 44-1441 (1999); Fla. Stat. Ann. ch. 495.011 (1999); 765 Ill. Comp. Stat. 1036/5 (West 1999); Md. Code Ann., Bus. Reg. § 1-401 (1999); N.Y. Gen. Bus. Law § 360 (McKinney 1999); Okla. Stat. tit. 78, § 21 (1999); Tex. Bus. & Com. Code Ann. § 16.01 (West 1999); Wash. Rev. Code § 19.77.010 (1999).

n21 See, e.g., *Syndicate Sales, Inc. v. Hampshire Paper Corp.*, 192 F.3d 633, 52 U.S.P.Q.2d (BNA) 1035 (7th Cir. 1999); *Ashley Furniture Indus. v. SanGiacomo N.A. Ltd.*, 187 F.3d 363, 51 U.S.P.Q.2d (BNA) 1609 (4th Cir. 1999); *Sunbeam Prod. v. West Bend Co.*, 123 F.3d 246, 44 U.S.P.Q.2d (BNA) 1161 (5th Cir. 1997); *Nabisco, Inc. v. PF Brands, Inc.* 191 F.3d 208, 51 U.S.P.Q.2d (BNA) 1882 (2d Cir. 1999).

n22 See 15 U.S.C. § 1057(c) (1994).

n23 See *id.* § 1121.

n24 See *id.* § 1117(a).

n25 See *id.* § 1057(b).

n26 See *id.* § 1057.

n27 See *id.* § 1072.

n28 See *id.* § 1065.

n29 See Trademark (Lanham) Act of 1946, ch. 540, § 43(a), 60 Stat. 427, 441 (codified as amended at 15 U.S.C. § 1125(a) (1994)).

n30 *Id.*

n31 *20th Century Wear, Inc. v. Sanmark-Stardust, Inc.*, 747 F.2d 81, 91, 224 U.S.P.Q. (BNA) 98, 104 (2d Cir. 1984).

- n32 See *Duraco Prod., Inc. v. Joy Plastic Enter., Ltd.*, 40 F.3d 1431, 1439, 32 U.S.P.Q.2d (BNA) 1724, 1730 (3d Cir. 1994).
- n33 See *id.* at 1439, 32 U.S.P.Q.2d at 1730.
- n34 505 U.S. 763, 23 U.S.P.Q.2d (BNA) 1081 (1992).
- n35 See *id.* at 763, 23 U.S.P.Q.2d at 1081.
- n36 See *Duraco*, 40 F.3d at 1449, 32 U.S.P.Q.2d at 1738.
- n37 *Brooks Shoe Mfg. v. Suave Shoe Corp.*, 716 F.2d 854, 857-58, 221 U.S.P.Q. (BNA) 536, 538 (11th Cir. 1983) (quoting *Seabrook Foods, Inc. v. Bar-Well Foods Ltd.*, 568 F.2d 1342, 1344, 196 U.S.P.Q. (BNA) 289, 291 (C.C.P.A. 1977)).
- n38 996 F.2d 577, 27 U.S.P.Q.2d (BNA) 1189 (2d Cir. 1993).
- n39 537 F.2d 4, 9, 189 U.S.P.Q. (BNA) 759, 764 (2d Cir. 1976).
- n40 *Paddington*, 996 F.2d at 583, 27 U.S.P.Q.2d at 1192.
- n41 71 F.3d 996, 38 U.S.P.Q.2d (BNA) 1739 (2d Cir. 1995), *aff'd*, 104 F.3d 353 (2d Cir. 1996).
- n42 *Id.* at 1008, 38 U.S.P.Q.2d at 1746.
- n43 *Id.* at 999, 38 U.S.P.Q.2d at 1738.
- n44 *Id.* at 1008, 38 U.S.P.Q.2d at 1746.
- n45 See *id.* at 1009, 38 U.S.P.Q.2d at 1747.
- n46 165 F.3d 120, 49 U.S.P.Q.2d (BNA) 1260 (2d Cir. 1998).
- n47 *Id.* at 126, 49 U.S.P.Q.2d at 1265.
- n48 *Id.* at 125, 49 U.S.P.Q.2d at 1264.
- n49 See *id.*
- n50 *Wal-Mart Stores, Inc. v. Samara Bros.*, 120 S. Ct. 308, 308 (1999).
- n51 *Streetwise Maps, Inc. v. Vandam, Inc.*, 159 F.3d 739, 744, 48 U.S.P.Q.2d (BNA) 1503, 1507 (2d Cir. 1988) (quoting *W.W.W. Pharm. Co. v. Gillette Co.*, 984 F.2d 567, 572, 25 U.S.P.Q.2d (BNA) 1593, 1597 (2d Cir. 1993)).
- n52 49 F. Supp. 2d 242 (S.D.N.Y. 1999).
- n53 See *id.* at 245.
- n54 *Id.* at 248-49.
- n55 *Id.* at 249.
- n56 *Id.* at 250.
- n57 *Id.* at 251.
- n58 See *id.*
- n59 See *id.* at 257.

n60 456 U.S. 844 (1982).

n61 *Id.* at 851 n.11 (1982) (citing *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 118 (1938)).

n62 *Id.* at 863.

n63 See *Feathercombs, Inc. v. Solo Prod. Corp.*, 306 F.2d 251, 258, 134 U.S.P.Q. (BNA) 209, 215 (2d Cir. 1980).

n64 See *Perfect Fit Indus. v. Acme Quilting Co.*, 618 F.2d 950, 954, 205 U.S.P.Q. (BNA) 297, 301 (2d Cir. 1980).

n65 See *id.*

n66 *Inwood*, 456 U.S. at 851 n.10.

n67 514 U.S. 159, 170 U.S.P.Q.2d (BNA) 1161 (1995).

n68 See *id.* at 165, 170 U.S.P.Q.2d at 1165.

n69 See *Fun-Damental Too, Ltd. v. Gemmy Indus. Corp.*, 111 F.3d 993, 1002, 42 U.S.P.Q.2d (BNA) 1348, 1355 (2d Cir. 1997).

n70 See McCarthy, *supra* note 2, § 8.1 at 8-4 to 8-5.

n71 See McCarthy, *supra* note 2, § 8.15 at 8-41.

n72 See *Jean Patou, Inc. v. Jacqueline Cochran, Inc.*, 201 F. Supp 861, 866, 133 U.S.P.Q. (BNA) 242, 246 (S.D.N.Y. 1962), *aff'd*, 312 F.2d 125, 136 U.S.P.Q. (BNA) 236 (2d Cir. 1963).

n73 See 2 Jerome Gilson, *Trademark Protection and Practice*, § 7.02[7] (May 1998).

n74 See *id.*

n75 See *id.*

n76 See *id.*

n77 See *id.*

n78 See *Joseph Schlitz Brewing Co. v. Houston Ice & Brewing Co.*, 250 U.S. 28, 30 (1919).

n79 See generally Federal Trademark Dilution Act of 1995 § 3, 15 U.S.C. § 1125(c) (Supp. IV 1998).

n80 Federal Trademark Dilution Act of 1995 § 4, 15 U.S.C. § 1127 (Supp. IV 1998).

n81 See *Panavision Int'l, L.P. v. Toeppen*, 945 F. Supp. 1296, 1301, 40 U.S.P.Q.2d (BNA) 1908, 1912 (C.D. Cal. 1996).

n82 See *id.*

n83 See *Panavision*, 945 F. Supp. at 1301, 40 U.S.P.Q.2d at 1912; see also *Lockheed Martin Corp. v. Network Solutions, Inc.*, 985 F. Supp. 949, 959, 44 U.S.P.Q.2d (BNA) 1865, 1874 (C.D. Cal. 1997).

n84 See, e.g., *Nabisco, Inc. v. PF Brands, Inc.*, 191 F.3d 208, 214, 51 U.S.P.Q.2d (BNA) 1882, 1885 (2d Cir. 1999); *Sunbeam Prod. v. West Bend Co.*, 123 F.3d 246, 252, 44 U.S.P.Q.2d (BNA) 1161, 1164 (5th Cir. 1997).

n85 Federal Trademark Dilution Act of 1995 § 3, 15 U.S.C. § 1125(c)(1) (Supp. IV 1998).

n86 See *Ringling Bros.-Barnum & Bailey Combined Shows, Inc. v. Utah Div. Of Travel Dev.*, 170 F.3d 449, 50 U.S.P.Q.2d (BNA) 1065 (4th Cir. 1999); *Hasbro, Inc. v. Clue Computing, Inc.*, 66 F. Supp. 2d 117, 52 U.S.P.Q.2d (BNA) 1402 (D. Mass. 1999).

n87 See *Clinique Labs. Inc. v. Dep Corp.*, 945 F. Supp. 547, 562 (S.D.N.Y. 1996).

n88 See *id.*

n89 See *Ringling Bros.-Barnum & Bailey Combined Shows, Inc. v. B.E. Windows, Corp.*, 937 F. Supp. 204, 209, 40 U.S.P.Q.2d (BNA) 1010, 1014 (S.D.N.Y. 1996) (citing to *Deere & Co. v. MTD Prods., Inc.*, 41 F.3d 39, 43, 32 U.S.P.Q.2d (BNA) 1936, 1938 (2d Cir. 1994)).

n90 163 F.3d 27, 49 U.S.P.Q.2d (BNA) 1225 (1st Cir. 1998).

n91 See *id.* at 32, 49 U.S.P.Q.2d at 1226.

n92 See *id.*

n93 See *id.*

n94 See *id.* at 33, 49 U.S.P.Q.2d at 1227.

n95 See *id.* at 41, 49 U.S.P.Q.2d at 1234.

n96 See *id.*

n97 See *id.*

n98 See *Warner Lambert Co. v. McCrory's Corp.*, 718 F. Supp. 389, 399, 12 U.S.P.Q.2d (BNA) 1884, 1892 (D.N.J. 1989).

n99 See *Bristol-Myers Squibb Co. v. McNeil-P.P.C., Inc.*, 973 F.2d 1033, 1047, 24 U.S.P.Q.2d (BNA) 1161, 1171 (2d Cir. 1992).

n100 See *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1134, 25 U.S.P.Q.2d (BNA) 1913, 1926 (Fed. Cir. 1993).

n101 See *Life Indus. Corp., v. Star Brite Distrib., Inc.*, 31 F.3d 42, 47, 31 U.S.P.Q.2d (BNA) 1536, 1540 (2d Cir. 1994).

n102 See *Conopco, Inc. v. May Dep't Stores Corp.*, 46 F.3d 1556, 1565, 32 U.S.P.Q.2d (BNA) 1225, 1231 (Fed. Cir. 1994).

n103 See *McNeil-PPC Inc. v. Guardian Drug Co.*, 98 F. Supp. 1066, 1074, 45 U.S.P.Q.2d (BNA) 1437, 1444 (E.D. Mich. 1997).

n104 See *id.* at 1068, 45 U.S.P.Q.2d at 1438.

n105 *Id.*

n106 *Id.* at 1070, 45 U.S.P.Q.2d at 1440.

n107 *Id. at 1072, 45 U.S.P.Q.2d at 1442.*

n108 *514 U.S. 159, 34 U.S.P.Q.2d (BNA) 1161 (1995).*

n109 *See id. at 174, 34 U.S.P.Q.2d at 1167.*

n110 *See id. at 159, 34 U.S.P.Q.2d at 1162.*

n111 *See id.*

n112 *See id.*

n113 *See Qualitex Co. v. Jacobson Prod. Co., 21 U.S.P.Q.2d (BNA) 1457, 1458-59 (C.D. Cal. 1991), aff'd in part, rev'd in part, 13 F.3d 1297, 29 U.S.P.Q.2d (BNA) 1277 (9th Cir. 1994), rev'd in part, 514 U.S. 159, 34 U.S.P.Q.2d (BNA) 1161 (1995).*

n114 *See Qualitex Co. v. Jacobson Prod. Co., 13 F.3d 1297, 1302, 29 U.S.P.Q.2d (BNA) 1277, 1280 (9th Cir. 1994), aff'g in part, rev'g in part, 21 U.S.P.Q.2d (BNA) 1457 (C.D. Cal. 1991), rev'd in part, 514 U.S. 159, 34 U.S.P.Q.2d (BNA) 1161 (1995).*

n115 *See Qualitex, 514 U.S. at 159, 34 U.S.P.Q.2d at 1162.*

n116 *Id. at 159, 34 U.S.P.Q.2d at 1162 (quoting 15 U.S.C. § 1127 (1994)).*

n117 *Id. at 159-60, 34 U.S.P.Q.2d at 1162.*

n118 *See id. at 159, 34 U.S.P.Q.2d at 1163.*

n119 *Id. at 159, 34 U.S.P.Q.2d at 1164.*

n120 *26 F. Supp. 2d 834 (E.D. Va. 1998).*

n121 *See id. at 837.*

n122 *See id. at 845.*

n123 *See id. at 841.*

n124 *See id. at 853.*

n125 *See id.*

n126 *See id. at 868.*

n127 *Faye M. Hammersley, The Smell of Success: Trade Dress Protection for Scent Marks, 2 Marq. Intell. Prop. L. Rev. 105, 124 (1998) (citing Bettina Elias, Do Scents Signify Source? An Argument Against Trademark Protection for Fragrances, 82 Trademark Rep. 475, 509 (1992)).*

n128 *Id. at 125.*

n129 *See id.*

n130 *Id.*

n131 *See id.*

n132 *See id.*

n133 *In re Clarke, 17 U.S.P.Q.2d (BNA) 1238, 1238 (T.T.A.B. 1990).*

n134 *Id.*

n135 See id. at 1238.

n136 See id. at 1240.

n137 See id.

n138 See U.S. Trademark Application Serial No. 74/720,993, in the name of Mike Mantel d/b/a Manhattan Oil (filed Aug. 25, 1995).

n139 See U.S. Trademark Application Serial No. 75/360,102, in the name of Mike Mantel d/b/a Manhattan Oil (BFITU filed Sept. 19, 1997).

n140 See U.S. Trademark Application Serial No. 75/360,104, in the name of Mike Mantel d/b/a Manhattan Oil (filed Sept. 9, 1997).

n141 See U.S. Trademark Application Serial No. 75/120,036, in the name of QC Group Corp. (BFITU filed June 17, 1996) (abandoned Nov. 7, 1998).

n142 *In re General Elec. Broad. Co.*, 199 U.S.P.Q. (BNA) 560, 563 (T.T.A.B. 1978).

n143 See U.S. Trademark Registration No. 2,207,874 issued to Anheuser-Busch, Inc. (Dec. 8, 1998).

n144 See U.S. Trademark Registration No. 2,187,082 issued to Kes Irrigation Systems, Inc. (Sept. 8, 1998); U.S. Trademark Registration No. 2,203,470 issued to Kes Irrigation Systems, Inc. (Nov. 7, 1998).

n145 See U.S. Trademark Registration No. 1,158,156 issued to MTM Enter., Inc. (May 19, 1998).

n146 See U.S. Trademark Registration No. 2,210,506 issued to Edgar Rice Burroughs, Inc. (Dec. 15, 1998).

n147 U.S. Trademark Application Serial No. 74/485,223, in the name of Harley-Davidson, Inc. (filed Feb. 1, 1994).

n148 See id.

n149 See id.

n150 See id.