

• *Making sense of the law*

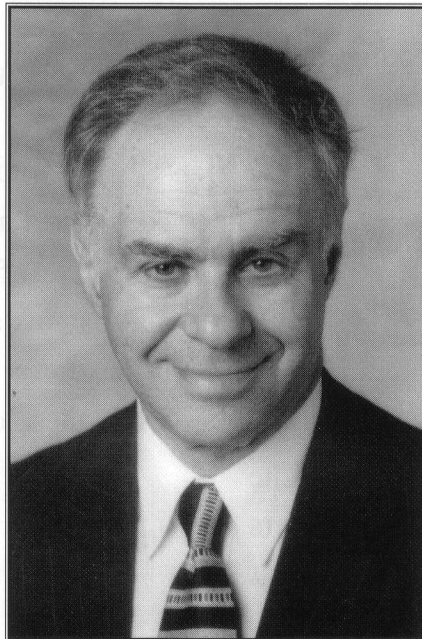
Blueprint Against Infringement: Trade Dress – a New Helping Hand for Product Protection

By George Gottlieb, Esq.

Trade dress is the most elusive of all forms of intellectual property protection, because - unlike the laws of copyright, trademarks, and patents - there is no trade dress statute — no specific group of rules passed by Congress to help guide competitors, or the Courts. The use of trade dress as a legal tool to protect the public against deception and confusion regarding a product or product look (or even the look of the interior of a restaurant!) was promoted by a Supreme Court ruling that certain designs, based on their appearance and not on their function, are “inherently distinctive” or have “acquired distinction”, and are therefore eligible for protection against infringement. The law of trade dress is, in reality, primarily judge-made law, based upon case precedent.

To prevail on a claim of trade dress infringement, a claimant must prove that: 1) the trade dress is inherently distinctive, or has acquired distinctiveness through secondary

meaning (A design that is “inherently distinctive” is one the purchasing public would immediately recognize as coming from a particular source. However, if sales and advertising over an extended period have caused recognition, then the design would be considered to have “acquired distinctiveness” through secondary meaning), 2) there is a likelihood of confusion by the consuming public, and 3) the trade dress is non-functional.

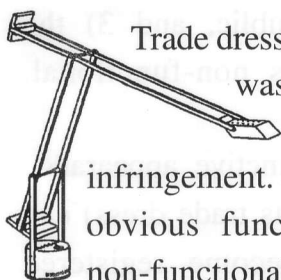


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This distinctive appearance of a design (its trade dress) can sometimes become registered with the U.S. Patent and Trademark Office (USPTO) via a trademark or design patent application. We are all familiar with the shape of the Coca-Cola bottle, which first appeared as the famous soft drink’s container in 1916. The Coca-Cola Company was successful in registering the bottle’s shape as a trademark almost 50 years later by employing the concept of trade dress, noting that the inherently distinctive look of the shape was

such that the consumer would identify the product contained within as coming from a particular source - the Coca-Cola Company.

While receiving a trademark or design patent registration from the USPTO gives the owner certain tangible and exclusive rights, actual use of the trade dress itself is the primary event that gives legal rights to the user. The legal issue of infringement will be decided by a local federal court, and not by the USPTO. However, if a registration has been obtained, the resulting official recognition from a federal agency as to distinctiveness can certainly provide a substantial secondary reason for the courts to back the owner's claims. Most trade dress infringement lawsuits today however, are based on unregistered trade dress.



Trade dress based on product configuration was used to protect the famous Tizio desk lamp from infringement. Although the lamp has an obvious function, only its double-armed non-functional distinctive look was used in a trade dress lawsuit to protect its design from copying. Later, the same trade dress enabled this product to be registered as a trademark in 1991, which was 18 years after it was first sold. The registration will be valid as long as the owners continue to sell the lamp, which is the same for any registered U.S. trademark.

Recently, in a much-publicized 1997 court battle, two California producers of Chardonnay wine, Kendall-Jackson Vineyards & Winery and

E & J Gallo Winery, took the issue of trade dress to greater heights. When Gallo packaged its Turning Leaf Chardonnay in a bottle which was markedly similar to Kendall-Jackson's Vintner's Reserve Chardonnay, the much-smaller Kendall-Jackson took Gallo to court, accusing the industry giant of unfairly copying its bottle design and therefore capitalizing on the market segment that had been dominated by the Kendall-Jackson Chardonnay. Although a federal jury in San Francisco ruled that Gallo's Turning Leaf bottle was not a copy of the rival Vintner's Reserve bottle, and rejected Kendall-Jackson's 30 million dollar claim, the case created headlines and sent a new message to the wine industry: imitation is not considered to be flattery, and will be challenged legally and with great force. The effect will certainly have an impact on other industries as well.

Although trade dress should not be considered a first-line defense against intellectual property infringement - copyrights, trademarks and patents are much more direct and practical - trade dress can certainly offer substantial help when these other tools are ruled out.

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