

2000

Has Abercrombie Become Unfashionable - A Review of Trends in Product Configuration Trade Dress Cases and a Proposed Test for Uniformity

Lucy C. Ridgway

Follow this and additional works at: <https://dc.law.mc.edu/lawreview>



Part of the [Law Commons](#)

Custom Citation

20 Miss. C. L. Rev. 179 (1999-2000)

This Comment is brought to you for free and open access by MC Law Digital Commons. It has been accepted for inclusion in Mississippi College Law Review by an authorized editor of MC Law Digital Commons. For more information, please contact walter@mc.edu.

HAS *Abercrombie* BECOME UNFASHIONABLE?
A REVIEW OF TRENDS IN PRODUCT CONFIGURATION
TRADE DRESS CASES AND A PROPOSED TEST FOR UNIFORMITY

Lucy C. Ridgway*

In *Two Pesos, Inc. v. Taco Cabana, Inc.*, the Supreme Court reconciled the split in authority among the federal courts of appeals regarding whether proof of secondary meaning was required to prevail on a trade dress infringement claim.¹ Since *Two Pesos*, plaintiffs no longer must prove that their product's trade dress or configuration has obtained secondary meaning; rather, the Court held that trade dress was capable of being "inherently distinctive."² However, the Court offered no guidance as to what makes trade dress "inherently distinctive" as opposed to "merely descriptive" or "generic."³

Consequently, another circuit court split has developed in which several circuits have held that the traditional trademark taxonomy, the *Abercrombie* test, should also be applied in trade dress cases.⁴ Other circuits have rejected the *Abercrombie* analysis, particularly with regard to product configuration trade dress, and have instead fashioned their own tests to determine whether a product configuration is inherently distinctive.⁵ The result is a variety of disparate tests that can yield inconsistent results depending on the jurisdiction of the trademark suit.⁶ Thus, the Supreme Court's attempt to unify trademark and trade dress law has led to even more inconsistency, especially in the realm of product configuration trade dress.

The purpose of this Comment is to review the lower courts' interpretation of *Two Pesos* with respect to product configurations, a subset of trade dress, and to offer a test that would better serve to identify inherently distinctive product configurations. Part I provides a brief overview of the development of the trade dress doctrine and the expansion of this doctrine to include product configurations. Part II presents the various tests fashioned by the lower courts to determine whether a product configuration is inherently distinctive. Further, this section attempts to prove that the various tests courts employ yield inconsistent results and may improperly extend trademark protection to useful product features. Finally, Part III suggests a test for determining inherent distinctiveness in product configuration trade dress cases that is uniform and promotes competition by strictly applying the functionality doctrine.

* The Author would like to thank Professor H. Lee Hetherington for his encouragement and scholarly advice throughout the development of this Comment.

1. 505 U.S. 763 (1992).

2. *Id.* at 770.

3. See *Duraco Prods., Inc. v. Joy Plastic Enters.*, 40 F.3d 1431 (3d Cir. 1994).

4. See *Ashley Furniture Indus. v. SanGiacomo N.A. Ltd.*, 187 F.3d 363 (4th Cir. 1999); *Pebble Beach Co. v. Tour 18 I Ltd.*, 155 F.3d 526, 540 (5th Cir. 1998); *Stuart Hall Co. v. Ampad Corp.*, 51 F.3d 780, 788 (8th Cir. 1995).

5. See *I.P. Lund Trading ApS v. Kohler Co.*, 163 F.3d 27, 41 (1st Cir. 1998); *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996, 1006-09 (2d Cir. 1995); *Duraco*, 40 F.3d at 1432.

6. See, *Ashley*, 187 F.3d at 363; *Lund*, 163 F.3d at 27; *Pebble Beach*, 155 F.3d at 526; *Knitwaves*, 71 F.3d at 996; *Stuart Hall*, 51 F.3d at 780; *Duraco*, 40 F.3d at 1431.

I. DEVELOPMENT OF THE TRADE DRESS DOCTRINE

In 1946, trademark law was codified with the adoption of the Lanham Act.⁷ According to this Act, a trademark is “any word, name, symbol, or device, or any combination thereof used by a person . . . to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.”⁸ Famous trademarks include the word “Coke,” the slogan “Did somebody say McDonald’s?,” and the Nike “swoosh.”

In addition to words, slogans, and symbols, section 43(a) of the Lanham Act may also protect a product’s packaging and the product itself.⁹ This is known as trade dress protection.¹⁰ Specifically, the term “trade dress” refers to the packaging and product design that make up the overall look of a product.¹¹ In order to receive protection under section 43(a) of the Lanham Act, a product’s trade dress must distinguish the product from those manufactured by others as well as serve as an indicator of the source of the product.¹² In other words, trade dress must be inherently distinctive or capable of becoming distinctive through secondary meaning.¹³

Trade dress was initially limited to include only a product’s packaging or wrapping—for example, the appearance of the container in which a pen is sold. This definition, however, has been judicially expanded to include features of the product itself—for example, the appearance of the pen.¹⁴ The inclusion of product configurations in the trade dress analysis is, in some respects, mere judicial acknowledgement of the equal capacity of a product configuration to serve as a source identifier in the minds of consumers.¹⁵ To establish infringement of a product configuration trademark under the Lanham Act, just as in other trade dress actions, a product configuration must be distinctive and nonfunctional.¹⁶

A. Distinctiveness

The traditional approach in evaluating the inherent distinctiveness of trademarks was articulated by Judge Friendly in *Abercrombie & Fitch Co. v. Hunting*

7. 15 U.S.C. §§ 1051-1127 (1994).

8. *Id.* § 1127.

9. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 774 (1992).

10. *Id.*

11. *Id.* at 764.

12. 15 U.S.C. § 1125 (1994). Section 43(a) of the Lanham Act provides:

(1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which-

(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person . . . shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

13. *Id.*

14. *John H. Harland Co. v. Clarke Checks, Inc.*, 711 F.2d 966, 980 (11th Cir. 1983).

15. *See id.* In fact, this expanded view of trade dress was adopted statutorily in 1980 when Congress amended the Lanham Act.

16. *Two Pesos*, 505 U.S. at 769 (citing RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 13 (1993)).

*World, Inc.*¹⁷ According to the *Abercrombie* test, trademarks are classified as (1) generic; (2) descriptive; (3) suggestive; (4) arbitrary; or (5) fanciful.¹⁸ These categories essentially reflect the relationship of the mark to the product or service it is meant to identify.¹⁹ Generic words and symbols—such as the word “car” for automobile—constitute the common name of the product or service.²⁰ Such marks are incapable of differentiating one producer of a product or service from another; thus, words and symbols in the generic category can never be protected as trademarks.²¹ Like generic marks, words and symbols in the second category—descriptive marks such as the term “crunchy” for cookies—are not viewed as inherently distinctive.²² However, descriptive marks can become distinctive if they are used sufficiently to acquire secondary meaning.²³ Secondary meaning exists when a significant number of prospective purchasers associate the mark, when used in connection with a particular type of good, service or business, with a particular source.²⁴ A mark that has acquired secondary meaning is capable of distinguishing the goods, services, or business of one person from those of others.²⁵

Suggestive, arbitrary and fanciful marks are considered inherently distinctive and may receive Lanham Act protection without a showing of secondary meaning.²⁶ A mark is suggestive if it “requires imagination, thought and perception to reach a conclusion as to the nature of the goods.”²⁷ For example, the trademark “Coppertone” is suggestive of suntan lotion. Both arbitrary and fanciful marks have no relation to the product or service they are meant to identify.²⁸ Arbitrary marks—such as the word “Apple” for computers—consist of marks that use common words in an unfamiliar way.²⁹ Fanciful marks comprise words and symbols invented solely for their use as trademarks.³⁰ Examples of fanciful marks include the coined words “Exxon” and “Xerox.”³¹

The confusion with classifying distinctiveness in product configuration cases resulted from courts applying tests originally developed in the context of word marks to product configuration trade dress.³² While the *Abercrombie* spectrum works well in relation to word marks, courts have had difficulty applying these classifications to trade dress generally, and product configurations specifically.³³ Although the most recent Supreme Court case in this area resolved a major con-

17. 537 F.2d 4, 9 (2d Cir. 1976).

18. *Id.*

19. *Id.*

20. *Id.*

21. *Id.*

22. *Id.* at 10.

23. *Id.*

24. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 13(b) (1993).

25. *Id.*

26. *Abercrombie*, 537 F.2d at 11.

27. *Id.* (citing *Stix Prods., Inc. v. United Merchants & Mfrs. Inc.*, 295 F. Supp 479, 488 (S.D.N.Y. 1968)).

28. *Pebble Beach Co. v. Tour 18 I Ltd.*, 155 F.3d 526, 540 (5th Cir. 1998).

29. *Abercrombie*, 537 F.2d at 12.

30. *Id.*

31. *Id.*

32. See Chad M. Smith, *Undressing Abercrombie: Defining When Trade Dress is Inherently Distinctive*, 80 J. PAT. [& TRADEMARK] OFF. SOC'Y 401, 429 (1998).

33. See *Duraco Prods. v. Joy Plastic Enters.*, 40 F.3d 1431, 1440-41 (3d Cir. 1994).

flict in trade dress jurisprudence—whether trade dress could be inherently distinctive—the appropriateness of applying the traditional trademark taxonomy to trade dress and product configurations was not decided.³⁴

B. Functionality

In addition to being distinctive, a product's trade dress must be nonfunctional to receive protection under section 43(a) of the Lanham Act.³⁵ The functionality doctrine prevents trademark law, which seeks to promote competition by protecting a trademark owner's goodwill, from inhibiting legitimate competition by allowing a producer to control a useful product feature.³⁶ The "right to copy" allows producers to copy the functional features of competing products to foster legitimate competition in the marketplace.³⁷ It is the province of patent law, not trademark law, to encourage invention by granting inventors a monopoly over product designs for a limited time, after which competitors are free to use the innovation.³⁸ If a product's functional features could be used as trademarks, a monopoly over such features could be obtained while avoiding the stringent requirements of patent law.³⁹ Further, the monopoly could be extended forever as trademarks may be renewed in perpetuity.⁴⁰ Therefore, in determining whether a product feature is functional, courts must strike a balance between the "right to copy" and the right of businesses to protect their method of trade identification.⁴¹

II. *Two Pesos*: A UNIFIED APPROACH TO THE INHERENT DISTINCTIVENESS STANDARD IN TRADEMARK AND TRADE DRESS

In 1987, Taco Cabana, a Mexican restaurant chain, sued Two Pesos, a rival chain, claiming that Two Pesos deliberately copied Taco Cabana's décor.⁴² Taco Cabana argued that the restaurant's trade dress—a combination of nonfunctional features such as bright festive colors and distinctive roof design—created a distinctive total image for its restaurant chain that was entitled to Lanham Act protection.⁴³ The trial court agreed and held that "trade dress may include the shape and general appearance of the exterior of the restaurant, the identifying sign, the interior kitchen floor plan, the décor, the menu, the equipment used to serve food, the servers' uniforms and other features reflecting on the total image of the restaurant."⁴⁴ The jury found that Two Pesos intentionally and deliberately infringed Taco Cabana's trade dress and awarded Taco Cabana millions of dollars in damages.⁴⁵

34. See generally *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992).

35. *Qualitex Co. v. Jacobson Prods., Co.*, 514 U.S. 159, 165 (1995).

36. *Id.* at 164.

37. *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1336-39 (C.C.P.A. 1982).

38. *Id.*

39. *Id.*

40. *Id.*

41. *Id.* at 1339.

42. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 765 (1992).

43. *Id.*

44. *Id.* at 765 n.1.

45. *Id.* at 764.

On appeal, *Two Pesos* argued that trade dress was not capable of being inherently distinctive; therefore, *Taco Cabana* should have been required to prove that the restaurant's décor had acquired secondary meaning.⁴⁶ Before the Supreme Court's decision in 1992, some courts of appeal held that trade dress was not capable of being inherently distinctive, and secondary meaning needed to be proved in order to afford protection.⁴⁷ The Court, in a unanimous decision, held that "trade dress that is inherently distinctive is protectable under [section 43(a) of the Lanham Act] without a showing that it ha[d] acquired secondary meaning."⁴⁸ Thus, the Supreme Court adopted the majority rule followed by the Fifth,⁴⁹ Seventh⁵⁰ and Eleventh Circuits⁵¹—that trade dress was capable of being inherently distinctive.

By overruling the Second and Third Circuits, which had required a showing of secondary meaning for protection of trade dress, the *Two Pesos* Court unified the standard for trademark and trade dress law.⁵² As in traditional trademark cases, a trade dress plaintiff whose product is inherently distinctive can receive automatic protection without a showing of secondary meaning. *Two Pesos*, however, did not set out a clear test as to what constitutes inherently distinctive trade dress. Lower courts have thus been left to grapple with the inescapable question: How should inherent distinctiveness in trade dress be determined?

III. THE AFTERMATH OF *Two Pesos*: A CIRCUIT-BY-CIRCUIT REVIEW OF TESTS FOR INHERENT DISTINCTIVENESS IN PRODUCT CONFIGURATION CASES

This section reviews the various tests currently used to determine whether a product configuration is inherently distinctive. The cases discussed illustrate the present dispute regarding whether the traditional trademark taxonomy—the *Abercrombie* spectrum—applies to product configuration cases. For example, the First, Second and Third Circuits have rejected the *Abercrombie* test and have fashioned their own tests to determine whether product configuration trade dress is inherently distinctive.⁵³ The Fourth and Eighth Circuits continue to use the five gradations of inherent distinctiveness set forth in *Abercrombie* for both lingual marks and product configuration trade dress.⁵⁴

46. *Id.* at 766.

47. *See, e.g.,* *Vibrant Sales, Inc. v. New Body Boutique, Inc.*, 652 F.2d 299 (2d Cir. 1981).

48. *Two Pesos*, 505 U.S. at 767.

49. *See* *Taco Cabana Int'l, Inc. v. Two Pesos, Inc.* 932 F.2d 1113, 1120 (5th Cir. 1991).

50. *See* *Computer Care v. Service Sys. Enters. Inc.*, 982 F.2d 1063 (7th Cir. 1992).

51. *See* *Brooks Shoe Mfg. Co. v. Suave Shoe Corp.*, 716 F.2d 854 (11th Cir. 1983).

52. *Two Pesos*, 505 U.S. at 770.

53. *See* *I.P. Lund Trading ApS v. Kohler Co.*, 163 F.3d 27 (1st Cir. 1998); *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996 (2d Cir. 1995); *Duraco Prods., Inc. v. Joy Plastic Enters.*, 40 F.3d 1431 (3d Cir. 1994).

54. *See* *Ashley Furniture Indus., Inc. v. SanGiacomo N.A. Ltd.*, 187 F.3d 363 (4th Cir. 1999); *Stuart Hall Co. v. Ampad Corp.*, 51 F.3d 780 (8th Cir. 1995). The Fifth Circuit continues to use the *Abercrombie* analysis in trade dress cases; however, the court has not explicitly adopted this test in a product configuration trade dress case. Although the Fifth Circuit has not rejected the *Abercrombie* test in product configuration cases, it has cited *Duraco* favorably, stating "the gravamen of trademark law is source identification." *See* *Sunbeam Prods., Inc. v. West Bend Co.*, 123 F.3d 246 (5th Cir. 1997) (holding the plaintiff's product configuration had acquired distinctiveness through secondary meaning, thus failing to reach the issue of what constitutes inherently distinctive product configurations).

A. *First Circuit*—I.P. Lund Trading ApS v. Kohler Co.

In 1998, the First Circuit tackled the issue of what constitutes an inherently distinctive product configuration.⁵⁶ The case involved allegations that the defendant's faucet impermissibly copied the plaintiff's "falling water" faucet design.⁵⁷ Lund's faucet was designed by noted architect Arne Jacobsen and received numerous design awards.⁵⁸ Kohler admittedly copied the design and offered the faucet for sale at a lower price.⁵⁹

The First Circuit Court of Appeals affirmed the district court's holding that the *Abercrombie* factors did not apply and that Lund's faucet was not inherently distinctive.⁶⁰ Discussing the relevance of *Two Pesos* in determining a test for inherent distinctiveness, the court stated:

[W]e do not believe that the Supreme Court's endorsement of the *Abercrombie* test in *Two Pesos* requires a strict application of the *Abercrombie* test in all contexts, particularly where product design is involved. The Supreme Court stated only that '[m]arks are often classified in' the five *Abercrombie* categories. The Court did not mandate the application of the *Abercrombie* test; rather, it affirmed the use of the *Abercrombie* factors in the case before it. The holding of *Two Pesos* was that plaintiffs seeking protection for inherently distinctive trade dress are not required to demonstrate secondary meaning. Unless the Court decides to carve out an exception to this rule for claims about product design, which we deem unlikely, then the holding must be honored. And so we agree with the Eighth Circuit that the test for inherent distinctiveness should not be altered to the degree that it eviscerates the distinction between inherently distinctive trade dress and trade dress that has acquired secondary meaning. We do not believe, however, that analysis of the problem using different factors than the *Abercrombie* factors results in such an outcome.⁶¹

The court concluded by rejecting the *Abercrombie* test as a means of determining inherent distinctiveness in product configurations and held that the proper inquiry was an adaptation of the *Seabrook Foods* test enunciated by the Court of Customs and Patent Appeals in *Seabrook Foods, Inc. v. Bar-Well Foods, Ltd.*⁶² The threshold question in the *Seabrook Foods* test, according to the First Circuit, was "whether the design, shape, or combination of elements is so unique, unusu-

55. *Lund*, 163 F.3d 27 (1998).

56. *Id.*

57. *Id.* at 32.

58. *Id.* at 34.

59. *Id.*

60. *Id.* at 41.

61. *Id.* at 40 (citations omitted).

62. 568 F.2d 1342 (C.C.P.A. 1997). The *Seabrook Foods* court set out a three-prong test that the First Circuit modified into a single inquiry. The original test stated:

In determining whether a design is arbitrary or distinctive this court has looked to whether it was a 'common' basic shape or design, whether it was unique or unusual in a particular field, [or] 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

Id. at 1344.

al or unexpected . . . that one can assume without proof that it will automatically be perceived by customers as an indicator of origin—a trademark.”⁶³

Unlike the other tests formulated in opposition to the *Abercrombie* test, this test does not foreclose the possibility of proving secondary meaning where the configuration is not inherently distinctive.⁶⁴ If a product design is not so unique, unusual or unexpected that it would qualify as inherently distinctive, a producer could still show that customers have come to associate the design with the producer. Thus, the line between inherent distinctiveness and secondary meaning is not blurred by this test.

Although the district court applied a different test in determining that the Lund faucet was not inherently distinctive, the First Circuit held that the finding could not be termed clearly erroneous and therefore affirmed.⁶⁵ The court held that the test used by the district court—the *Knitwaves* test⁶⁶—was consistent with the test set out by the court of appeals; however, the First Circuit criticized the *Knitwaves* test as relying, problematically, on the producer’s intent in creating a product that was indicative of its source.⁶⁷

B. Second Circuit—*Knitwaves, Inc. v. Lollytogs Ltd.*⁶⁸

Knitwaves involved the copying of plaintiff’s “squirrel” and “leaf” design appliqués on children’s sweaters.⁶⁹ The district court found that the sweater design was inherently distinctive, and that the defendant’s copies created a likelihood of confusion.⁷⁰ Rejecting the *Abercrombie* test as inappropriate for product configuration, the Second Circuit reversed the district court’s finding of distinctiveness, holding that product features must be “likely to serve primarily as a designator of origin of the product” to be inherently distinctive.⁷¹ Applying this test, the court found that the plaintiff’s sweater designs were not inherently distinctive because the designs were merely aesthetic and not intended to serve primarily as source identification.⁷² Therefore, according to the Second Circuit, “a plaintiff must do more than demonstrate that the appearance of its product serves some source identifying function. It must demonstrate that the primary purpose behind the design was to identify its product’s source.”⁷³

Courts and commentators have criticized the *Knitwaves* test as relying inappropriately on the producer’s intent.⁷⁴ Distinctiveness is a measure of the product

63. *Lund*, 163 F.3d at 40 (quoting J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 8:13 (4th ed. 1996)).

64. *Id.*

65. *Id.* at 32.

66. See *infra* notes 66-75 and accompanying text.

67. *Lund*, 163 F.3d at 41.

68. 71 F.3d 996 (2d Cir. 1995).

69. *Id.*

70. *Id.* at 997.

71. *Id.* at 1008 (citing *Duraco Prods., Inc. v. Joy Plastic Enters.*, 40 F.3d 1431, 1449 (1994)).

72. *Id.* at 1009.

73. *Banff Ltd. v. Express, Inc.*, 921 F. Supp. 1065, 1071 (S.D.N.Y. 1995) (applying *Knitwaves*).

74. See *I.P. Lund Trading ApS v. Kohler Co.*, 163 F.3d 27 (1998); *Krueger Int’l, Inc. v. Nightingale, Inc.*, 915 F. Supp. 595 (S.D.N.Y. 1996), *overruled by* *Landscape Forms, Inc. v. Columbia Cascade Co.*, 113 F.3d 373 (2d Cir. 1997); Graeme B. Dinwoodie, *Reconceptualizing the Inherent Distinctiveness of Product Design Trade Dress*, 75 N.C. L. REV. 471 (1997).

feature's effect on consumers and has nothing to do with the intent of the producer.⁷⁵ If inherent distinctiveness were to hinge on how a manufacturer intended to promote her design, the evidentiary requirements for inherent distinctiveness and secondary meaning would be virtually identical.⁷⁶ This is the very criticism the First Circuit sought to avoid by basing its test solely on the predictive inquiry of whether the product feature will be perceived by customers as an indicator of origin.⁷⁷

*C. Third Circuit—Duraco Products, Inc. v. Joy Plastic Enterprises.*⁷⁸

The Third Circuit was the first circuit to confront the issue of what constitutes inherently distinctive trade dress after the Supreme Court's decision in *Two Pesos*.⁷⁹ In *Duraco*, the manufacturer of Grecian urn-style plastic planters sought a preliminary injunction to prevent the defendant from manufacturing a similar product.⁸⁰ The Third Circuit held that the urns were not inherently distinctive because there was no evidence that consumers associated the planters with the Duraco source name.⁸¹ Although the *Duraco* court held that the urns were not distinctive, the court found that product configurations could be inherently distinctive; however, the existing tests for inherent distinctiveness—the *Abercrombie* spectrum—should only apply to word marks and product packaging trade dress.⁸²

In declining to adopt the *Abercrombie* test, the court gave two reasons the classic trademark taxonomy should not be applied to product configuration trade dress: (1) product configurations bear a different relationship to the product than do trademarks (i.e., a product's configuration cannot be said to be "arbitrary," "suggestive" or "descriptive" in relation to itself); and (2) unlike traditional trademarks, one cannot automatically assume that product configurations will serve a source-identifying function.⁸³ In place of the *Abercrombie* test, the court introduced a stricter test for inherent distinctiveness. In the Third Circuit, to be inherently distinctive, product configurations must be: "(i) unusual and memorable; (ii) conceptually separable from the product; and (iii) likely to serve primarily as a designator of origin of the product."⁸⁴

While several circuits have derived their tests for inherent distinctiveness from this expression by the Third Circuit,⁸⁵ no court has expressly adopted the test, and two courts have expressly rejected it.⁸⁶ The Eighth Circuit criticized the *Duraco*

75. *Lund*, 163 F.3d at 40-41.

76. *Id.*

77. *Id.* at 49.

78. *Duraco Prods., Inc. v. Joy Plastics Enters.*, 40 F.3d 1431 (3d Cir. 1994).

79. *Id.*

80. *Id.* at 1433.

81. *Id.*

82. *Id.* at 1440.

83. *Id.* at 1440-41.

84. *Id.* at 1434.

85. See, *I.P. Lund Trading ApS v. Kohler Co.*, 163 F.3d 27 (1st Cir. 1998); *Knitwaves, Inc. v. Lollytogs, Ltd.*, 71 F.3d 996, 1008 (2d Cir. 1995).

86. See *Ashley Furniture Indus. v. SanGiacomo N.A. Ltd.*, 187 F.3d 363 (4th Cir. 1999); *Stuart Hall Co. v. Ampad Corp.*, 51 F.3d 780, 788 (8th Cir. 1995).

test as contrary to the Supreme Court's ruling in *Two Pesos*.⁸⁷ The Eighth Circuit read *Two Pesos* as relying "on a presumption that 'trade dress' is a single concept that encompasses both product configuration and packaging."⁸⁸ Thus, to differentiate between the two was inappropriate. Moreover, the Eighth Circuit read *Two Pesos* as approving the *Abercrombie* test for determining inherent distinctiveness of product configuration trade dress.⁸⁹

Finally, a criticism similar to that in *Knitwaves* has been leveled against *Duraco*. Critics of *Duraco* have complained that the Third Circuit's test improperly merged the concepts of inherent distinctiveness and secondary meaning.⁹⁰ A manufacturer would have to present evidence of product advertising and consumer surveys to prove that a product feature would have a likely impact on consumers.⁹¹ This is the type of evidence typically used to prove secondary meaning, not inherent distinctiveness.⁹² According to critics, this would undermine *Two Pesos*, which held that courts may not condition protection of inherently distinctive marks on a showing of secondary meaning.⁹³

*D. Fourth Circuit—Ashley Furniture Industries, Inc. v. SanGiacomo N.A. Ltd.*⁹⁴

As recently as 1999, the Fourth Circuit was faced with the issue of what constitutes an inherently distinctive product configuration.⁹⁵ In *Ashley Furniture Industries, Inc. v. SanGiacomo N.A. Ltd.*, Ashley sued SanGiacomo for copying the design of one of Ashley's bedroom furniture suites.⁹⁶ Applying the *Abercrombie* test, the Fourth Circuit held that the overall appearance of the furniture was either arbitrary or fanciful and therefore inherently distinctive.⁹⁷ Echoing the Eighth Circuit's analysis in *Stuart Hall Co. v. Ampad Corp.*, the court determined that the *Abercrombie* analysis was the appropriate test for inherent distinctiveness in product configurations under *Two Pesos*.⁹⁸ The *Ashley* court rejected the tests fashioned by the First, Second and Third Circuits by relying, once again, on the criticism enunciated in *Stuart Hall*.⁹⁹ These reasons will be expanded in the next section.

*E. Eighth Circuit—Stuart Hall Co. v. Ampad Corp.*¹⁰⁰

In *Stuart Hall*, the Court of Appeals for the Eighth Circuit, applying the *Abercrombie* test, held that the nonfunctional layout and packaging of Stuart

87. See *Stuart Hall*, 51 F.3d at 780.

88. *Id.* at 787.

89. *Id.* at 788.

90. *Krueger Int'l, Inc. v. Nightingale, Inc.*, 915 F. Supp. 595, 602 (S.D.N.Y. 1996).

91. *Stuart Hall*, 51 F.3d at 788.

92. *Id.*

93. *Id.*

94. *Ashley Furniture Indus. v. SanGiacomo N.A. Ltd.*, 187 F.3d 363 (4th Cir. 1999).

95. *Id.*

96. *Id.* at 366.

97. *Id.* at 373.

98. *Id.* at 371.

99. *Id.*

100. *Stuart Hall Co. v. Ampad Corp.*, 51 F.3d 780 (8th Cir. 1995).

Hall's notebook day-planners was inherently distinctive; therefore, Ampad's similar planners infringed on Stuart Hall's product design trademark.¹⁰¹ The court emphatically rejected any test for inherent distinctiveness outside of *Abercrombie* as being inconsistent with *Two Pesos*.¹⁰² According to the Eighth Circuit, *Two Pesos* held that product configuration and product packaging should be treated uniformly.¹⁰³ Therefore, the *Abercrombie* analysis should be applied in both instances.¹⁰⁴ Further, the court argued that a test which relied on a product configuration trademark's likely impact on consumers would blur the lines between inherent distinctiveness and secondary meaning.¹⁰⁵

Despite the Eighth Circuit's rejection of the tests espoused by the Second and Third Circuits, commentators have suggested that the Eighth Circuit's unwillingness to deviate from the *Abercrombie* test is baseless.¹⁰⁶ In determining whether a product configuration is inherently distinctive, the ultimate question to be determined is the likely impact on consumers.¹⁰⁷ As one commentator wrote:

when the mark or trade dress is inherently distinctive, we assume that consumers will attach a source-indicating meaning to it. When a mark or dress is not inherently distinctive, we cannot make that assumption. Thus we require the plaintiff, through imposition of the secondary meaning requirement, to prove that consumers actually understand its mark or dress to indicate the product's origin. The difference between a finding of inherent distinctiveness and a finding of distinctiveness due to secondary meaning is the difference between finding what consumers are likely to think and finding what they do think.¹⁰⁸

Therefore, an inquiry into whether a product configuration serves a source-identifying function does not infringe on the territory of secondary meaning.¹⁰⁹

IV. A UNIFORM TEST FOR DETERMINING INHERENT DISTINCTIVENESS IN PRODUCT CONFIGURATION TRADE DRESS

A. Remaining True to the Purpose of Trademark Law

As many of the cases discussed illustrate, a primary purpose of trademark or trade dress protection is to protect that which identifies a product's source. Trademark law seeks to prevent the use of the same or similar marks in a way that confuses the public about the actual source of the goods. That is, protection of trademarks seeks to protect a producer's good will. However, competitors are free to copy as long as consumers are not confused as to the product's source and the goodwill of the senior producer is not harmed.

101. *Id.* at 783.

102. *Id.* at 788.

103. *Id.* at 787.

104. *Id.*

105. *Id.* at 788.

106. See Margreth Barrett, *Trade Dress Protection For Product Configurations and the Federal Right to Copy*, 20 HASTINGS COMM. & ENT. L.J. 471, 494 (1998).

107. *Id.*

108. *Id.*

109. *Id.*

In the last fifteen years, companies have begun to use the law of unfair competition, and particularly section 43(a) of the Lanham Act, in an attempt to prohibit competitors from copying their products—a trend which was encouraged by the Supreme Court's decision in *Two Pesos*. Businesses have successfully claimed trademark rights in the décor of a restaurant,¹¹⁰ the shape of a faucet handle,¹¹¹ the design of bedroom furniture,¹¹² the shape of a lollipop,¹¹³ the shape of a mixer,¹¹⁴ and the design of personal organizers.¹¹⁵ Companies have attempted to protect the pattern on a sweater,¹¹⁶ the shape of troll dolls,¹¹⁷ the design of fan blades,¹¹⁸ the shape of a Grecian urn planter,¹¹⁹ and the design of cable ties.¹²⁰

While this trend has given businesses a new weapon in the fight against unfair competition, uncontrolled judicial protection of product features may have the unwanted consequence of hurting consumers by stifling legitimate competition. Therefore, any test used to determine inherent distinctiveness in product configurations must be strict enough to preclude protection of designs and configurations that can rightfully be copied; otherwise, a fundamental purpose of trademark law will be compromised.

B. The Proposed Test

Of the four tests currently in use, the *Seabrook Foods* test—as modified by the First Circuit—provides the best option for a uniform test to determine inherent distinctiveness in product design. As previously discussed, the other tests are not satisfactory for a variety of reasons. The *Abercrombie* test works well when applied to lingual marks but makes little sense when used to determine the inherent distinctiveness of product designs.¹²¹ The *Knitwaves* test, though similar to the *Seabrook Foods* test, relies problematically on a producer's intent to create a source-identifying product.¹²² Finally, the *Duraco* test is seemingly contrary to the Supreme Court's opinion in *Two Pesos* to the extent that the test merges the concepts of secondary meaning and inherent distinctiveness.¹²³

The proposed uniform test is a single inquiry that asks “whether the design, shape, or combination of elements is so unique, unusual or unexpected . . . that one can assume without proof that it will automatically be perceived by customers as an indicator of origin—a trademark.”¹²⁴ This test was specifically tailored for use in product design cases; therefore, the main problem associated

110. See *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992).

111. See *Kohler Co. v. Moen, Inc.*, 12 F.3d 632 (7th Cir. 1993).

112. See *Ashley Furniture Indus. v. SanGiacomo N.A. Ltd.*, 187 F.3d 363 (4th Cir. 1999).

113. See *Toppis Co. v. Gerrit J. Verburg Co.*, 41 U.S.P.Q. 2d 1412, 1416 (S.D.N.Y. 1996).

114. See *Sunbeam Prods., Inc. v. West Bend Co.*, 123 F.3d 246, 252-57 (5th Cir. 1997).

115. See *Stuart Hall Co. v. Ampad Corp.*, 51 F.3d 780, 788-90 (8th Cir. 1995).

116. See *Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996, 1006 (2d Cir. 1995).

117. See *EFS Mktg., Inc. v. Russ Berrie & Co.*, 76 F.3d 487 (2d Cir. 1996).

118. See *Vornado Air Circulation Sys., Inc. v. Duracraft Corp.*, 58 F.3d 1498, 1503 (10th Cir. 1995).

119. See *Duraco Prods., Inc. v. Joy Plastic Enters.*, 40 F.3d 1431, 1436 (3d Cir. 1996).

120. See *Thomas & Betts Corp. v. Panduit Corp.*, 65 F.3d 654, 656 (7th Cir. 1995).

121. See Smith, *supra* note 32.

122. See Dinwoodie, *supra* note 74.

123. See *Stuart Hall Co. v. Ampad Corp.*, 51 F.3d 780 (8th Cir. 1995).

124. *I.P. Lund Trading ApS v. Kohler Co.*, 163 F.3d 27, 40 (1st Cir. 1998).

with the *Abercrombie* test—applying a test developed for use with lingual marks to product configurations—is avoided. Unlike the *Knitwaves* test, the First Circuit’s test makes no mention of producer intent, but instead relies on the product’s potential for source-identification in the minds of consumers. Moreover, this test is consistent with the Supreme Court’s holding in *Two Pesos*, which requires courts to separate the inquiry for inherent distinctiveness from that of secondary meaning in trademark and trade dress cases.

Finally, the First Circuit’s test is unlikely to inhibit legitimate copying of functional product features by competitors because of the requirement that the protected feature be “unique, unusual, or unexpected.”¹²⁵ In applying this test, courts should be careful to protect only product features that are so unique as to identify the product’s source and not to protect those features that competitors must copy to legitimately compete. Additionally, strict application of the functionality doctrine should accompany the adoption of this test or any other uniform test.

V. CONCLUSION

Since the Supreme Court’s decision in *Two Pesos* in 1992, the United States Courts of Appeals have adopted a variety of incongruous tests to determine whether product configuration trade dress is inherently distinctive. These tests have created vast discrepancies from circuit to circuit in trade dress protection litigation. Moreover, some of these tests have been criticized as being contrary to the purpose of the Lanham Act. Thus, a standard test for inherent distinctiveness in product configuration trade dress that is in line with the Lanham Act needs to be adopted nationwide. The proposed test provides a simple, straightforward approach for determining inherent distinctiveness in product configuration trade dress that utilizes the best features of the current tests while avoiding their weaknesses. In sum, the test is a clear and uniform method to guide a court’s determination of whether product configuration trade dress is inherently distinctive.

125. *Id.*