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Trade Dress Infringement

Trade dress (<https://www.mandourlaw.com/trade-dress/>) is a subset of trademark rights that protects the packaging, design, and overall feel or appearance of a product. Trade dress serves as a source identifier for goods and services. It can be used to protect products, such as the shape of a Coca-Cola bottle or the overall appearance of a luxury sports car. It can also be used to protect services. Fast food restaurant chains, for example, have a distinctive color scheme that can be protected trade dress.

In addition to physical products or brick-and-mortar stores, trade dress can also protect the look and feel of a website (<https://via.library.depaul.edu/cgi/viewcontent.cgi?referer=https://www.google.com/&httpsredir=1&article=1138&context=jatip>), if the website is not protected by copyright law. Mobile phone applications (“apps”) can also be protected trade dress. A plaintiff seeking to enforce trade dress rights in its website or mobile apps will need to meet trade dress requirements of non-functionality, distinctiveness, and a likelihood of confusion in order to be successful.

Trade dress rights, like trademark rights, are governed by and protected by a mixture of the Federal Lanham Act, individual state laws, and common law. Although a product’s trade dress can receive certain common law protections, registering trade dress with the U.S. Trademark Office provides the owner with significantly more intellectual property protections.

WHAT IS TRADE DRESS INFRINGEMENT?

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Trade dress infringement occurs when one product's design or packaging copies or mimics that of another product to the extent that there is a likelihood of confusion in the mind of the purchasing public.

In addition to making a claim for infringement, a plaintiff may also make claims of **dilution**, which is the weakening in the ability of a trademark to clearly distinguish its source.

Dilution can occur in two ways:

- **Blurring** happens when one company's actions impair the distinctiveness of another company's products, such as placing famous trade dress designs on an unrelated product; and
- **Tarnishment**, which is the weakening of a trademark by associating with unflattering or unsavory associations, such as drugs, sex, or criminal activities.

Fair use is a common defense to claims of trade dress infringement. It can be raised when a defendant utilizes elements of the plaintiff's trade dress to describe the plaintiff's products, not to identify the plaintiff as the source of the goods or services.

Use of trade dress for the purpose of news reporting, commentary, criticism, artistic works, parody, or satire may also be sufficient to avoid a claim of trade dress infringement, in part because trade dress rights only protect the packaging or design when it is used in commerce.

TRADE DRESS INFRINGEMENT ELEMENTS

There are four elements that are typically examined in trade dress infringement cases:

- Definition;
- Functionality;
- Distinctiveness; and
- Likelihood of confusion.

If the plaintiff is raising additional claims, it may need to prove additional elements. In trade dress dilution cases, for example, the plaintiff will also need to demonstrate that its brand is famous but does not need to demonstrate a likelihood of confusion.

DEFINING PROTECTED TRADE DRESS

In order to prove trade dress infringement, a plaintiff will need to define what the protected elements are. If the trade dress was previously registered with the U.S. Trademark Office, the plaintiff can rely on the registration documentation to prove this element.

When a brand has not previously registered its trade dress, it can still make an infringement case if it is able to:

- Describe the specific elements that comprise the trade dress, and
- Identify how the elements combine to constitute the trade dress.

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Failure to accurately define trade dress by merely providing a list of design features could result in dismissal of the plaintiff's complaint at the pleading stage. In order to preserve its case, the plaintiff must show how these elements synthesize into a cohesive unit.

FUNCTIONALITY

Functional elements cannot receive trade dress protection. Generic shapes, like a box or bottle are functional because they are essential to the product's function or storage. However, a label on the container can be protected, as can a unique shape, such as the elaborate or unique shape of certain liquor or soda bottles.

When considering the functionality question, courts generally look at the overall feeling of the trade dress. However, some courts examine features independently to reach a conclusion regarding functionality.

There are four "Morton-Norwich" factors courts review to determine functionality:

- Whether the product has patent protection. If it is protected by a utility patent, then this points to evidence of functionality, but a design patent is typically evidence of non-functionality
- Whether there is advertising that points to a product being utilitarian
- Whether alternative designs are available, and
- Whether the design stems from a comparatively inexpensive or simple method of manufacturing.

The functionality of a product will partially depend on its industry. The bright neon color on a traffic safety vest is functional, while the same color on an otherwise normal t-shirt may not be. Similarly, the size and decorative font of lettering may or may not be functional.

In California, which is in the Ninth Circuit, the burden is on the plaintiff to prove that a product's trade dress is not functional. If the trade dress is registered with the U.S. Trademark Office, other jurisdictions may shift this burden to the defendant, who would then have to prove that the trade dress in question is functional.

DISTINCTIVENESS

Second, the trade dress must be shown as either being inherently distinctive or having obtained distinctiveness due to secondary meaning. Trade dress is protected because it serves as a source indicator – consumers need to be able to look at the product or its packaging and identify the brand or the manufacturer.

Registration on the U.S. Trademark Office's Principal Register is the best and easiest way to show distinctiveness, because distinctiveness is necessary for trade dress registration. However, common law trade dress rights holders can still make the claim for distinctiveness in a trade dress infringement case.

When considering distinctiveness, courts look at product design and product packaging. Product packaging, including the interior design of a business or restaurant, can be inherently distinctive. However, product design can only become distinctive by [Click here to chat](#)

secondary meaning.

In determining whether trade dress is inherently distinctive, a court will look at whether the dress is:

- A “common” basic shape or design, such as a circle;
- Unique or unusual in its field;
- A refined or stylized element that is common among the particular class of goods or services; or
- Capable of creating a commercial impression that is distinct from the accompanying words.

If trade dress is not inherently distinctive, it may have gained secondary meaning to the extent that the consuming public can identify the origin of the goods or services based on the packaging alone. In order to demonstrate secondary meaning, also known as acquired distinctiveness (<https://www.mandourlaw.com/acquired-distinctiveness/>), the plaintiff should show:

- Long use of the trade dress in commerce,
- Examples of media coverage,
- Consumer surveys and testimony demonstrating that consumers recognize the trade dress as belonging to the owner, and
- Advertising expenditures.

While color alone may be protectable trade dress, it cannot be inherently distinctive. The trade dress owner must show that the color has obtained secondary meaning within its class of goods or services to receive protection from infringement. The turquoise blue of Tiffany & Co (<https://www.tiffany.com/>). has achieved this protection, but Cheerios was unable to receive protection for its yellow boxes (<https://www.bizjournals.com/twincities/news/2017/09/01/trademark-board-sorry-big-g-cheerios-yellow-isnt.html>).

LIKELIHOOD OF CONFUSION

The plaintiff must demonstrate a likelihood of confusion by the consuming public in order to be successful in a trade dress infringement claim.

When examining whether there is potential likelihood for confusion, courts look at the eight DuPont Factors (<https://www.mandourlaw.com/likelihood-consumer-confusion-dupont-factors/>) which include:

- The similarity of the trade dress in their overall appearance and commercial impression
- The similarity between the plaintiff's and the defendant's products
- Which channels the two parties use to market their products, and the similarities between these channels and marketing techniques,
- Likelihood of each brand to expand into the same geographic or marketing area, and
- The sophistication of the product's intended consumers.

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Plaintiffs do not need to demonstrate actual confusion in order to meet this burden, although such a showing would improve their chances of success on the merits of the case.

FAMOUS BRAND

In order to succeed on a claim of dilution, a plaintiff will also need to demonstrate that its brand is famous, and that unlawful use of the trademarks in commerce dilutes their distinctive nature.

To demonstrate fame, a brand owner will need to show that its trade dress is widely recognized by the general consuming public at the time the dilution claim is made.

Formerly famous brands that have fallen out of the public eye, or brands that are only famous to a certain subset of consumers do not meet this standard.

The court will consider:

- The duration, extent, and geographic reach of advertising and publicity of the trade dress,
- Whether it is advertised or publicized by the owner or third parties;
- The amount, volume, and geographic extent of sales of goods or services offered under the trade dress;
- The extent of actual recognition of the trade dress; and
- Whether the trade dress is federally registered.

When making a trade dress dilution claim, it is not necessary for the plaintiff to show a likelihood of confusion. Instead, the trade dress owner will need to show that there is a likelihood of dilution. This standard is currently encoded under the Trademark Dilution Revision Act (https://en.wikipedia.org/wiki/Trademark_Dilution_Revision_Act) of 2006.

TRADE DRESS INFRINGEMENT DAMAGES

Plaintiffs in trade dress infringement cases typically seek court-ordered injunctions, preventing the defendant from engaging in the infringing activity.

At the outset of a court case, a plaintiff may seek a preliminary injunction to prevent further potential damage to its brand while the case progresses. In order to obtain a preliminary injunction (<https://www.inta.org/INTABulletin/Pages/PreliminaryInjunctionsinUSTrademarkInfringement>) the plaintiff must show:

- A likelihood of success on the merits of the plaintiff's case
- Irreparable harm in the absence of the preliminary injunction
- The balance of equities is in its favor, and
- The preliminary injunction is in the public interest.

After a case finishes, the court may grant a permanent injunction, preventing the defendant from engaging in infringing activity in the future.

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Trade dress infringement liability also carries the potential for monetary damages. The Lanham Act (https://www.law.cornell.edu/wex/lanham_act) does not provide for statutory damages in typical trade dress infringement cases. Instead, it allows the plaintiff to recover

- The defendant's profit,
- Actual losses suffered due to the infringing activity, including lost profits, and lost goodwill,
- The costs of corrective advertising to counteract consumer confusion due to the infringing activity,
- Reasonable royalties that would have been paid by the defendant to use the trade dress,
- Litigation costs, and
- Attorney's fees, although these are only granted in exceptional cases.

If the court finds that the trade dress infringement in question involved willful use of counterfeit trade dress, it can award statutory damages of up to \$2 million per counterfeit trade dress per type of goods or services sold or distributed.

Some states, such as California, will also grant punitive damages to a plaintiff if the defendant engaged in willful trade dress infringement.

TRADE DRESS INFRINGEMENT CEASE AND DESIST LETTER

If someone is infringing your trade dress, the first step is to send a cease and desist letter (<https://www.mandourlaw.com/cease-desist-letters/>) to the infringing party. This letter will include:

- Information regarding the trade dress rights that are being infringed, including registration information, if applicable
- An explanation of how the other party is infringing your trade dress rights. This can include photographs and videos, as well as your legal analysis regarding the infringing actions
- A demand that the other party immediately cease all infringing activity and provide proof of compliance within three days
- A statement that, should the other party fail to comply, you are prepared to file a federal lawsuit to enforce your trade dress rights.

When a cease and desist letter is sent, it can include a demand for payment in exchange for release of all legal claims. Most trade dress owners utilize cease and desist letters and litigation as the primary means to stop infringing activity.

It is particularly important for trade dress owners to actively enforce their rights. Failure to do so could result in a naked license, whereby the trade dress owner could lose the right to exclusivity of their products.

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However, being too aggressive in enforcing trade dress rights could negatively affect a company's public perception. Because of this, sending a cease and desist letter can be a more measured alternative to immediately proceeding with litigation when infringing activity is discovered.

TRADE DRESS INFRINGEMENT EXAMPLES

Trade dress infringement can occur in any industry, and across industries, if the infringing product is related to the original in the consumer's mind. In 2017, John Deere won a trade dress infringement case (<https://www.deere.com/en/our-company/news-and-announcements/news-releases/2017/corporate/2017oct17-deere-wins-trademark-lawsuit/>). An agricultural spraying company produced equipment utilizing John Deere's famous green and yellow color combination. The court ruled in favor of John Deere because of the potential likelihood of confusion among consumers.

Monster Energy successfully enforced (<http://www.ipwatchdog.com/2018/12/23/monster-energy-prevails-trademark-punitive-damages/id=104053/>) its trade dress protections against an automotive tool maker who was using its black and green designs. Although the products were in different industries, Monster Energy was able to show a significant following in the motorsport field, where the infringing company was marketing its products. Because of this, ordinary consumers of the energy drink may incorrectly believe the automotive tools were produced or sponsored by Monster, allowing for a finding of trade dress infringement.

Similarly, the makers of the "Tommy" machine gun sued a vodka maker (<https://www.mandourlaw.com/blog/gunmaker-files-trademark-lawsuit-over-tommy-guns-vodka/>) for trade dress infringement. Although the products were sold in different industries, the vodka was sold in bottles that were an exact replica of the machine gun famously used by Al Capone. This case settled outside of court, which is the fate of the majority of federal lawsuits.

Businesses, including restaurants, can create a distinctive look through their decoration. *Two Pesos, Inc. v. Taco Cabana, Inc.*

(https://en.wikipedia.org/wiki/Two_Pesos,_Inc._v._Taco_Cabana,_Inc.) is a famous Supreme Court case, where one chain of Mexican-style fast food restaurants copied the trade dress of another chain, which had a "festive eating atmosphere... decorated with artifacts, bright colors, paintings, and murals." Even though the decorative trade dress was not registered with the Trademark Office, the design was capable of distinguishing the original restaurant.

Trade dress protections can also extend to performances. In one case (<http://thedisography.org/discoDbDetail.php?req=883>), a Beatles tribute band successfully prevented former bandmates from copying the look and feel of their stage show.

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If you have a trade dress infringement issue, we would be happy to assist. Please contact (<https://www.mandourlaw.com/contact/>) us today.

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SAN DIEGO OFFICE

16870 West Bernardo Drive, Suite 400
San Diego, California 92127

Phone: (858) 487-9300

[Click to Contact us \(/contact/\)](#)

ORANGE COUNTY OFFICE

2030 Main Street, Suite 1300
Irvine, California 92614

Phone: (949) 474-9330

[Click to Contact us \(/contact/\)](#)

LOS ANGELES OFFICE

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