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DEFINING THE ELEMENTS OF TRADE DRESS INFRINGEMENT UNDER SECTION 43(A) OF THE  
LANHAM ACT

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#### **\*104 I. Introduction**

“Trade dress” is the total image and overall appearance of a product or business as reflected in such features as size, shape, color or color combinations, design of a label, texture, graphics or sales techniques.<sup>1</sup> As evident from the broad definition of trade dress, virtually any combination of features of a product or business could be defined as trade dress.

In defining the specific trade dress of a product and determining whether infringement of that trade dress has occurred, consideration is given only to the aggregate of all the features.<sup>2</sup> In other words, the analysis of a trade dress infringement claim focuses on the combination of all the features, not the individual features. A manufacturer or business can freely use certain elements or features of a competitor’s trade dress as long as that use does not constitute use of the competitor’s

overall image.<sup>3</sup> The appropriate inquiry is whether the alleged trade dress infringer has copied a distinctive combination of features.<sup>4</sup>

Federal protection of trade dress is derived from section 43(a) of the Lanham Act.<sup>5</sup> To establish a trade dress infringement claim under section 43(a) of the Lanham Act, a plaintiff must prove both the \*105 validity of the trade dress and the infringement of that trade dress. In more simplified terms, the analysis of a trade dress infringement claim focuses on the following two questions: (1) Is the trade dress entitled to protection?; (2) Has an infringement of that trade dress occurred?<sup>6</sup> The question of whether the trade dress is entitled to protection is answered by the distinctiveness and nonfunctionality of the trade dress.<sup>7</sup> The question of whether an infringement of the trade dress has occurred is answered by determining whether a likelihood of confusion exists between the senior trade dress and the junior trade dress.<sup>8</sup>

This article represents a modest attempt to decipher the elements of a section 43(a) claim from the perspective of trade dress infringement. The novelty of this article is the fact that it focuses entirely on trade dress infringement, rather than section 43(a) in general. However, because trade dress infringement is merely a judicial designation of a particular species of infringement under section 43(a),<sup>9</sup> most of the following discussion will be applicable to all section 43(a) claims.

## II. Section 43(a) of the Lanham Act

### *A. Trade Dress Infringement Under § 43(a) of the 1946 Lanham Act*

Section 43(a) of the Lanham Act provides the basis for federal protection of trade dress.<sup>10</sup> Section 43(a) does not designate a particular claim for trade dress infringement or trademark infringement, but rather prohibits generally unfair competition.<sup>11</sup>

When originally enacted in 1946, section 43(a) addressed two wrongs committed in connection with goods or services: a “false designation of origin” and a “false description or representation.”<sup>12</sup>

#### *1. “False Designation of Origin”--*

“False designation of origin” was originally limited to false advertising of geographic origin.<sup>13</sup> For example, false advertising of geographic origin would be representing that California oranges came from Texas.<sup>14</sup> In 1963, in a precedent-setting decision, the Sixth Circuit expanded this definition of \*106 “origin” to include origin of source of manufacture.<sup>15</sup> Many federal circuits followed the Sixth Circuit’s lead.<sup>16</sup> Expanding the definition of “origin” to include origin of manufacture transformed the “false designation of origin” language into a vehicle for asserting a traditional trademark infringement claim.<sup>17</sup> In other words, the expanded definition of origin provided owners of unregistered trademarks, names and trade dress with the exclusive right to use a distinctive trademark or trade dress. If any competitor used the unregistered, but protected, trade dress in a manner that would likely confuse consumers, then the owner could sue the competitor under section 43(a) for using a false designation of origin. As noted by Justice White, “[t]he use of a product or package design that is so similar to that of another producer that it is likely to confuse purchasers as to the product’s source may constitute ‘false designation of origin’ within the meaning of the [Lanham] Act.”<sup>18</sup>

#### *2. “False Description or Representation”--*

Not all courts and authorities agreed that “false designation of origin” includes origin of manufacture, and that, therefore, trade dress infringement constitutes a “false designation of origin.”<sup>19</sup> For example, the Fifth Circuit found that “false designation of origin” is limited to geographic origin and, thus, trade dress infringement falls under the “false description or representation” language.<sup>20</sup>

The reason given by the Fifth Circuit for refusing to extend the false designation of origin language to include origin of manufacture is based upon the geographic references in section 43(a).<sup>21</sup> When originally enacted in 1946, section 43(a) provided that any person who uses a false designation of origin or any false description or representation:

shall be liable to a civil action by any person doing business in the locality falsely indicated as that of origin or in the region in which said locality is situated, or by any person who believes that he is or is likely to be damaged by the use of any such false description or representation.<sup>22</sup>

The above quoted language strongly suggests that false designation of origin would refer only to geographic origin.<sup>23</sup>

Some federal courts have, directly or indirectly, referred to trade dress infringement as a “false description or representation.”<sup>24</sup> Even courts that have expanded the definition of origin to include origin of manufacture have classified trade dress infringement as a “false description or \*107 representation.”<sup>25</sup> Under this reasoning, trade dress infringement could be both a “false designation of origin” and a “false description or representation.”

### ***3. Purely an Academic Question--***

Although the federal courts may disagree as to which wrong is violated by infringing upon the protected trade dress of another, the federal courts unanimously agree that section 43(a) creates a federal cause of action for trade dress infringement.<sup>26</sup> Section 43(a), with respect to unregistered marks and trade dress, is now firmly recognized as the “equivalent of a claim for trademark infringement.”<sup>27</sup> Consequently, even though significant from a historical perspective, a discussion of which wrong trade dress infringement would fall within is strictly academic. Under either a “false designation of origin” or a “false description or representation,” section 43(a) is invoked and its requirements must be fulfilled.<sup>28</sup>

### ***B. Section 43(a) After the Trademark Law Revision Act of 1988***

If the question of whether trade dress constitutes a false designation of origin or a false description or representation had any relevance before 1988, that relevance was eliminated when Congress enacted the Trademark Law Revision Act of 1988 (the 1988 Act).<sup>29</sup> Section 43(a), as amended by the 1988 Act, provides as follows:

#### **(a) Civil action**

(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, or

(B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person’s goods, services, or commercial activities, 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.<sup>30</sup>

The 1988 Act expanded the false designation of origin and false description or representation language to include broader range of wrongs. As noted by one legal commentator, “all of the statutory remedies available to the owner of a registered mark are now equally available to the plaintiff who uses § 43(a) as the vehicle to assert claims of infringement of unregistered marks, trade names, or trade dress. . . .”<sup>31</sup>

\*108 The amendments to section 43(a) in the 1988 Act were intended only to codify the pre-1988 case law.<sup>32</sup> Congress sought to revise the outdated language in the original section 43(a) so as to incorporate judicial changes in the section.<sup>33</sup> According to the legislative history, the only substantive change that Congress intended was “to make clear that misrepresentations about another’s products are as actionable as misrepresentations about one’s own.”<sup>34</sup>

## **III. Is the Trade Dress Entitled to Protection?**

### ***A. Categories of Distinctiveness***

Protection under section 43(a) for trade dress or an unregistered mark is based on the same principle which qualifies a mark for registration under section two of the Lanham Act: distinctiveness.<sup>35</sup> The general requirement for registration under section two is that the mark be capable of distinguishing the applicant’s goods from the goods of others.<sup>36</sup> Thus, to be protected under section 43(a), a trademark or trade dress must be capable of distinguishing a particular product or business from the product or business of another.<sup>37</sup>

In order to determine whether a particular trade dress has attained this requisite level of distinctiveness, the courts classify the

distinctiveness of the trade dress into one of the following four categories of increasing distinctiveness: (1) generic; (2) descriptive; (3) suggestive; or (4) arbitrary or fanciful.<sup>38</sup> On the low end of the distinctiveness spectrum is the generic mark which is not registrable and not entitled to protection under section 43(a).<sup>39</sup> One step above the generic mark is the descriptive mark which may be protected if the mark has acquired distinctiveness through secondary meaning.<sup>40</sup> On the high end of the distinctiveness spectrum are the suggestive, arbitrary and fanciful marks which are classified as “inherently distinctive” and are entitled to protection without a showing of secondary meaning.<sup>41</sup>

The lines separating the categories are not always precise or definite.<sup>42</sup> Classifying a trade dress or trademark into a category is further complicated by the fact that a term that fits into one category for \*109 a particular product may be in a different category for another product.<sup>43</sup> For example, “Ivory” is a generic term for elephant tusks, but is an arbitrary term as applied to soap.<sup>44</sup> A term used for a particular product may even originate in one particular category but switch to a different category over time because of advertising and usage.<sup>45</sup>

The categories of distinctiveness were originally developed to determine whether trademarks, meaning words or symbols, were distinctive enough for protection.<sup>46</sup> The problem with applying the categories to trade dress is that trade dress does not easily fit within the categories.<sup>47</sup> However, the law is well-settled that the categories apply as equally to trade dress as to trademarks.<sup>48</sup>

### ***1. Generic--***

Generic marks “refe[r] to the genus of which the particular product is a species.”<sup>49</sup> The generic mark tells the buyer what kind of product he is buying, rather than from where or from whom did the product originate.<sup>50</sup>

The dominant principle for determining whether a mark is generic is the primary significance test.<sup>51</sup> Under the primary significance test, the party seeking protection of a term must “show that the primary significance of the term in the minds of the consuming public is not the product but the producer.”<sup>52</sup> If the primary significance of the mark is to identify a product, rather than a producer, \*110 then the mark is generic.<sup>53</sup> The principal focus in the primary significance test is whether consumers identify the mark as a product brand or as a product genus.<sup>54</sup> If the consumers identify the mark as a product brand, rather than a product genus, then the primary significance of the mark is to identify the producer. On the other hand, if consumers identify the mark as a product genus, the primary significance of the mark is to identify the product and the mark is generic.

Because a generic mark inherently lacks the power to distinguish its product from other products, a generic mark is not registerable; and a registered mark may be canceled at any time if it becomes generic.<sup>55</sup> Under the same reasoning, generic trade dress can not be protected under section 43(a).<sup>56</sup> An underlying rationale for denying trademark protection to generic marks is that generic marks so signify the nature of the product that the interests of competition outweigh any interest the holder of the mark may have in distinguishing its product.<sup>57</sup>

### ***2. Descriptive--***

A mark is descriptive if it “conveys an immediate idea of the ingredients, qualities or characteristics of the goods.”<sup>58</sup> One legal commentator has noted that a mark is “descriptive” if it describes “the intended purpose, function or use of the goods[,] the size of the goods, the class of users of the goods, a desirable characteristic of the goods, or the end effect upon the user.”<sup>59</sup> In *Bristol-Myers Squibb Co. v. McNeil-P.P.C., Inc.*, the Second Circuit noted that a term can be descriptive in two ways: “[i]t can literally describe the product, or it can describe the purpose or utility of the product.”<sup>60</sup> The Fifth Circuit defined a descriptive term as one that “identifies a characteristic or quality of an article or service. . . such as its color, odor, function, dimensions, or ingredients.”<sup>61</sup>

A descriptive mark is not inherently distinctive, because it does not inherently identify a particular source. However, a descriptive mark may be entitled to protection under section 43(a) if the descriptive mark acquires distinctiveness through secondary meaning.<sup>62</sup> The underlying rationale for making protection of descriptive marks contingent upon secondary meaning is to prevent persons from obtaining exclusive rights in marks which are likely to be useful to competing manufacturers in describing the attributes of the goods or business.<sup>63</sup> Conditioning the protection of descriptive marks upon secondary meaning ensures that “potential market entrants should not be foreclosed from using descriptive terms to label their products.”<sup>64</sup>

### ***\*111 3. Suggestive--***

A mark is suggestive if “it requires imagination, thought and perception to reach a conclusion as to the nature of the goods.”<sup>65</sup> In comparison to descriptive marks, suggestive marks “do not describe the product but call to mind some attribute of it. . . .”<sup>66</sup>

The difficult task of classifying a mark as suggestive, as opposed to descriptive, produces a significant consequence.<sup>67</sup> If the mark is classified as descriptive, it is entitled to protection under section 43(a) only after it has been proven that the mark has established secondary meaning.<sup>68</sup> On the other hand, if the mark is classified as suggestive, it is considered inherently distinctive and is entitled to protection without a showing of secondary meaning.<sup>69</sup>

#### **4. Arbitrary or Fanciful--**

Use of the terms fanciful and arbitrary as categories of distinctiveness is most easily understood in the context of words. Fanciful terms are words invented solely for use as trademarks.<sup>70</sup> When fanciful terms use common words in an unfamiliar way, the use is called arbitrary.<sup>71</sup> The key distinction between the arbitrary and fanciful classification and other categories of distinctiveness is that arbitrary and fanciful marks bear no relation to the underlying product or service, whereas the other classifications have at least a minimal relation to the product.<sup>72</sup>

Arbitrary and fanciful marks are considered inherently distinctive and are entitled the highest degree of trademark protection without proof of secondary meaning.<sup>73</sup> The rationale for according a high degree of protection to arbitrary and fanciful marks is that restrictions on the use of such marks do not hinder competition.<sup>74</sup> The draft of the *Restatement (Third) of Unfair Competition* explains the rationale for according arbitrary and fanciful marks a high degree of protection as follows: Because a fanciful term has no meaning other than its implicit function as an identifying symbol, prospective purchasers can be expected to view it as an indication of source or other association with a particular user. Recognition of trademark rights in fanciful terms protects the significance of the designation as a symbol of identification without diminishing the vocabulary by which competitors can convey information about similar products.

...

\*112 There is also no reason to anticipate that restrictions on the use of such arbitrary designations will hinder communication by other competitors.<sup>75</sup>

### **B. Secondary Meaning**

As noted in the previous section, a trademark or trade dress that is merely descriptive can acquire the requisite level of distinctiveness for protection through secondary meaning.

#### **1. General Definition--**

The judicially created doctrine of secondary meaning is used to indicate that a trademark or trade dress “has come through use to be uniquely associated with a specific source.”<sup>76</sup> The principal focus of secondary meaning is whether the public identifies with the source of the product. In other words, do the buyers of the product have a mental association between the trade dress of a product and its source?<sup>77</sup> As the Supreme Court stated in *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*,<sup>78</sup> “[t]o establish secondary meaning, a manufacturer must show that, in the minds of the public, the primary significance of a product feature or term is to identify the source of the product rather than the product itself.”<sup>79</sup> In particular, secondary meaning is established by proving that a substantial segment of the consuming public associated the product or business with its source at the time the junior mark entered the market.<sup>80</sup> The focus is on the consuming public, not necessarily the general public.<sup>81</sup>

#### **2. Secondary Meaning Required Only If Trade Dress Is Merely Descriptive--**

In 1992, the United States Supreme Court resolved a conflict between the circuits on the question of whether trade dress which is inherently distinctive is protected without proof that it has acquired secondary meaning.<sup>82</sup> The Supreme Court unanimously agreed that proof of secondary meaning is not \*113 required to prevail on a claim under section 43(a) where the trade dress is inherently distinctive.<sup>83</sup> Since trademark law required proof of secondary meaning to establish distinctiveness

only if the mark was merely descriptive, the Court established the same rule for trade dress infringement.<sup>84</sup> The Court reasoned that trade dress infringement under section 43(a) should be treated the same as trademark infringement under section 43(a).<sup>85</sup>

After *Two Pesos*, the primary and possibly only significance of secondary meaning for trade dress infringement under section 43(a) is to prove distinctiveness when the trade dress is merely descriptive. As noted by one court, secondary meaning is simply the “means by which an otherwise unprotectable descriptive marks may obtain protection.”<sup>86</sup>

### **3. Methods of Proving Secondary Meaning--**

In evaluating secondary meaning, many courts place tremendous weight on the presence or absence of surveys or quantitative evidence. In fact, some courts have found that a plaintiff’s failure to submit survey evidence is compelling evidence that secondary meaning did not exist.<sup>87</sup> Other courts have noted that survey evidence is the “most direct and persuasive” method of establishing secondary meaning.<sup>88</sup>

In addition to considering survey evidence, most courts have established a list of factors for evaluating the secondary meaning of a trademark or trade dress. Although these secondary meaning factors vary from circuit to circuit, the factors used by most circuits are based generally on the same considerations. The list of factors used by the Second Circuit provide a thorough example of the types of considerations which are probative in assessing secondary meaning: (1) the plaintiff’s advertising expenditures; (2) consumer surveys linking the trade dress to a particular source; (3) sales success; (4) unsolicited media coverage; (5) attempts to plagiarize the trade dress; and (6) the length and exclusivity of the use.<sup>89</sup> As noted by the Second Circuit, “no single factor is determinative” and all factors do not need to be proven.<sup>90</sup> Another illustrative example of the type of factors used for assessing secondary meaning is the Eleventh Circuit’s list of factors: (1) the length and manner of the mark’s use; (2) the nature and extent of advertising and promotion; (3) the efforts made by the plaintiff to promote a conscious connection in the public’s mind between the name and the plaintiff’s product or business; and (4) the extent to which the public actually identifies the name with the plaintiff’s product or business.<sup>91</sup>

\*114 In addition to considering the above general factors, most courts place a strong emphasis on whether the trade dress was intentionally copied. Most circuits follow the view that a presumption or inference of secondary meaning arises if intentional copying of the trade dress is established.<sup>92</sup> The presumption is based upon the reasoning that the competitor intentionally copied the trade dress of the senior user in order to capitalize on the senior user’s secondary meaning.<sup>93</sup> In other words, the presumption or inference of secondary meaning assumes that the only logical reason for intentionally copying the trade dress of a competitor is to capitalize on the senior user’s secondary meaning. Not all circuits have agreed with this reasoning. Two circuits have held that evidence of intentional copying is a probative indication of secondary meaning, but that such evidence alone does not establish secondary meaning.<sup>94</sup>

### **4. “Secondary Meaning in the Making” Doctrine--**

Under the “secondary meaning in the making” doctrine, a party who is making efforts to develop secondary meaning in its claimed trademark, but who has not yet succeeded, is protected against competitors who knowingly create a similar mark with the intent of appropriating the mark or capitalizing on its popularity.<sup>95</sup> The secondary meaning in the making doctrine has received little recognition outside a few decisions from the Southern District of New York.<sup>96</sup> Every circuit, including the Second Circuit, that has had the opportunity to consider the validity of the doctrine has rejected it.<sup>97</sup>

### **\*115 C. Nonfunctionality**

Nonfunctionality, along with distinctiveness, determines whether a particular trade dress is entitled to protection.<sup>98</sup> If the trade dress has acquired the requisite level of distinctiveness and is nonfunctional, then the trade dress is entitled to protection. The absence of either distinctiveness or nonfunctionality causes the trade dress to be ineligible for protection, because consumers, as a matter of law, do not associate the trade dress with a particular source.<sup>99</sup>

#### **1. What is Functionality?--**

Functional features of a product are those that “competitors would find necessary to incorporate into their products in order to be able to effectively compete.”<sup>100</sup> In other words, functional features are features “which constitute the actual benefit that the consumer wishes to purchase, as distinguished from an assurance that a particular entity made, sponsored, or endorsed a

product.<sup>101</sup> Functionality does not mean that the trade dress performs a particular function.<sup>102</sup> The relevant inquiry is whether the features of the product which constitute the trade dress are essential to the use or purpose of the product or affect the cost or quality of the product.<sup>103</sup> If so, the features are functional. In more definite terms, a design is functional if the particular design affords benefits to the person marketing the goods or services, apart from any benefits attributable to the design's significance as an indication of source, that are important to effective competition by others and that are unavailable through the use of alternative designs.<sup>104</sup>

The Seventh Circuit has provided a descriptive illustration of the functionality doctrine by contrasting the oval shape of a football with an automobile hood ornament.<sup>105</sup> To illustrate functionality, consider the oval shape of a football. The oval shape of a football is clearly a functional feature, because it is essential to the use or purpose of the football and could not be replaced by an alternative design. The manufacturer of an oval shaped football could not claim the oval shape as protected trade dress feature, because competitors would not be able to effectively compete by selling round, oblong or hexagonal footballs. To illustrate nonfunctionality, consider an automobile hood ornament of the Greek god Mercury. Since the Mercury hood ornament is not essential for the use or \*116 purpose of an automobile and could easily be replaced by an alternative design, it is clearly nonfunctional.<sup>106</sup>

In the context of trade dress, functionality limits the protection of a certain features so that competitors can effectively compete to produce the same product. The doctrine of functionality involves a balancing of competing policy interests between the protection of trademark rights and free competition.<sup>107</sup> When properly applied, the functionality doctrine allows the owner of a particular trade dress to protect those distinctive product features that are not necessary to the use or purpose of the product, but rather serve to identify the manufacturer of the product. On the other hand, the functionality doctrine prevents the owner of a particular trade dress from monopolizing a product simply by monopolizing those features that are necessary for the use or purpose of the product.<sup>108</sup>

## ***2. Functionality for Trade Dress Features -- Continuum of Functionality--***

As with all trade dress analysis, determination of the functionality of a particular trade dress focuses in on the aggregate of features, not the individual features.<sup>109</sup> In other words, the issue is whether the overall trade dress is functional, not whether certain features which comprise that trade dress are functional.<sup>110</sup>

The functionality of a particular trade dress is a question of fact,<sup>111</sup> while the correct legal standard to apply to determine functionality is a question of law.<sup>112</sup> To assist the trier of fact, some courts have established a number of factors for determining whether certain trade dress is functional. The Ninth Circuit recognized two important factors as "the availability of alternative designs[,] and whether a particular design results from a comparatively simple or cheap method of manufacture."<sup>113</sup> The Second Circuit recognized the following list of nonexclusive factors: (1) the degree of functionality of similar features; (2) the degree of similarity between the nonfunctional features of the competing products; and (3) the feasibility of alternative arrangements of functional features that would not impair the utility of the product.<sup>114</sup> As noted by Judge Newman in *Stormy Clime Ltd. v. Progroup, Inc.*,<sup>115</sup> \*117 the above factors can be placed on a continuum. At the functionality end of the continuum, "unique arrangements of purely functional features constitute a functional design."<sup>116</sup> At the opposite "ornamental" end of the continuum, "distinctive and arbitrary arrangements of predominantly ornamental features that do not hinder potential competitors from entering the same market with differently dressed versions of the product are non-functional. . . ." <sup>117</sup> When the trade dress falls at either end of the continuum, the factual determination of functionality is relatively simple. Difficulty arises when the features that comprise the trade dress do not conveniently fall at one end of the continuum, but rather fall somewhere in the middle.<sup>118</sup> For example, some of the features may be functional, while other features are clearly nonfunctional, or the ornamental features may actually hinder potential competitors from entering the same market.<sup>119</sup>

## ***3. Criteria for Establishing Nonfunctionality--***

### ***a. Principal Inquiry: Ability to Effectively Compete.--***

The principal inquiry in determining the functionality of a particular trade dress is how protection of the trade dress would affect competition.<sup>120</sup> If protection of the trade dress would hinder competition or prevent others from effectively competing, then the trade dress is functional and not entitled to protection under section 43(a).<sup>121</sup> From this broad premise, functionality can be more narrowly defined by the following concepts: (1) utilitarian functionality test; and (2) aesthetic functionality test.



### ***b. Utilitarian Functionality Test.--***

The primary method for determining the functionality of a trademark or trade dress is the utilitarian functionality test. Under the utilitarian functionality test, a design or feature is functional if it is “superior or optimal in terms of engineering, economy of manufacture, or accommodation of utilitarian function or performance.”<sup>122</sup> In practical terms, a design or feature is functional under the utilitarian concept if the design or feature gives its manufacturer a cost advantage in production, shipping, marketing, or any other similar expense.<sup>123</sup>

The utilitarian functionality test focuses on whether consumers chose the design because the design identifies the source of the product or whether consumers chose the design because the design has certain advantages related to the utility of the product.<sup>124</sup> The utilitarian functionality draws a distinction \*118 between the value of a feature for the utility or function of the product and the value of the feature as a method of identifying or distinguishing the product. Consider the following simple illustration:

Products X and Y each have distinctive combination of features arranged in an arbitrary design which constitute the individual trade dress of each product. If consumers prefer product X over product Y because the trade dress of product X make product X easier to carry or easier to use, then the trade dress is functional and not entitled to protection. The trade dress would also be functional if the trade dress of product X allows the manufacturer of product X to produce product X at a lower cost. However, if consumers prefer product X because the trade dress of product X indicates superior quality or prestige, then the trade dress is nonfunctional and may not be copied.

The contemporary definition of functionality used by the courts indicates a utilitarian view of functionality.<sup>125</sup> For example, the Supreme Court’s frequently cited definition of functionality follows the utilitarian concept. In dicta, the Supreme Court defined functionality as the following: “In general terms, a product feature is functional if it is essential to the use or purpose of the article or if it affects the cost or quality of the article.”<sup>126</sup> The standard for functionality under the Supreme Court definition implies a utilitarian view in that the standard bases functionality on a feature’s importance to the product’s function or utility. The Supreme Court’s definition merely restates the utilitarian view that the focus for determining functionality should be on the utility of the feature to the product and the effect of the feature on the cost of the product.

### ***c. Aesthetic Functionality Test.--***

The aesthetic functionality test denies Lanham Act section 43(a) protection to those product features that are purely ornamental, but that are essential to effective competition.<sup>127</sup> In other words, features that are strictly ornamental will be functional and not entitled to protection if protection of the features would hinder competition or prevent others from effectively competing.

The concept of aesthetic functionality is not a new attribute to the law of unfair competition. The concept of aesthetic functionality, even though it was not referred to as aesthetic functionality, developed through a number of cases around the turn of the century.<sup>128</sup> Despite these early origins, the modern standard for aesthetic functionality originated with the 1952 case of *Pagliero v. Wallace China Co.*<sup>129</sup> In *Pagliero*, the Ninth Circuit found that the aesthetic design features of hotel china were functional and \*119 not entitled to protection, because protection of such features would prevent others from effectively competing.<sup>130</sup> Under the *Pagliero* definition of functionality, a product feature is functional and not entitled to trademark protection if it is “an important ingredient in the commercial success of the product.”<sup>131</sup>

The expansive definition of functionality by the *Pagliero* court has been frequently criticized by commentators<sup>132</sup> and has been either rejected or narrowed by most courts.<sup>133</sup> The primary criticism of the “important ingredient” standard is that it would almost always permit a second comer to imitate the trade dress of a successful product.<sup>134</sup> A successful product that has accumulated a certain level of goodwill would generally attribute at least a portion of its commercial success to its trade dress. The trade dress may in fact be the reason why the product is successful. The end result of the important ingredient standard is that it provides a disincentive to product manufacturers because as the trade dress becomes more appealing and successful, it would receive less trademark protection.<sup>135</sup>

Even though the important ingredient standard is too broad, the aesthetic functionality concept serves a legitimate purpose within the functionality doctrine. Traditional notions of functionality are based upon the utilitarian concept that a feature is functional if is necessary to the use or purpose of the product. By definition, aesthetic features merely ornament a product. Consequently, a strict utilitarian definition of functionality excludes the aesthetic features because ornamentation is not considered necessary to the use or purpose of the product. The legitimate purpose that the aesthetic functionality concept

serves is that it prevents the protection of certain features which would not technically fit within the utilitarian definition, but which would still be necessary to effectively compete in the same product market. The need for aesthetic functionality becomes apparent when a product manufacturer seeks trade dress protection for aesthetic features which are essential to the use or purpose of the product or when protection of aesthetic features would prevent competitors from effectively competing. A perfect example of the need for aesthetic functionality is hotel china. Under a strict utilitarian definition, the aesthetic design pattern on the china would be nonfunctional and entitled to protection. Since the design on the china plays an essential role in a consumer's selection of china, allowing the manufacturer to protect a particularly popular design would drastically hinder competition and prevent other competitors from effectively competing. Aesthetic functionality prevents protection of the necessary aesthetic features in order to promote the traditional functionality interest in free competition.

The courts have recognized the importance of the aesthetic functionality concept and attempted to replace the overinclusive "important ingredient" standard with more practical alternatives.<sup>136</sup> The most clearly defined and well reasoned test for determining aesthetic functionality comes from the Second Circuit.<sup>137</sup> The Second Circuit rejected *Pagliari* and adopted the view of the preliminary *Restatement (Third) of the Law for Unfair Competition*.<sup>138</sup> Under the Restatement's view, if protection of an \*120 ornamental feature would significantly hinder competition by limiting the range of adequate alternative designs, then the aesthetic functionality doctrine denies protection of the ornamental feature.<sup>139</sup> The Restatement's test requires that specific evidence indicate that similarly attractive "overall" aesthetic designs are unavailable to competing manufacturers.<sup>140</sup> As noted by the Second Circuit, the Restatement's rule "avoids the overbreadth of *Pagliari* by requiring a finding of foreclosure of alternatives while still ensuring that trademark protection does not exclude competitors from substantial markets."<sup>141</sup> The Fifth Circuit followed a similar rationale by requiring that a finding of nonfunctionality means that a wide array of choices remain available to prospective competitors.<sup>142</sup>

In considering aesthetic functionality, the Third and Sixth Circuits have adopted different approaches based on the ornamental feature's relationship to the utilitarian function of the product and the feature's importance as an indication of source.<sup>143</sup> Under the Third Circuit view, a particular design is nonfunctional and entitled to protection if the design "is not significantly related to the utilitarian function of the product, but is merely arbitrary."<sup>144</sup> Under the Sixth Circuit's view, ornamental features are entitled to protection if the features are used as an identification of source and the features are not significantly related to the product's utilitarian function.<sup>145</sup> Even the circuit that established the *Pagliari* important ingredient standard, the Ninth Circuit, has limited, if not rejected, that standard.<sup>146</sup> The Ninth Circuit follows a rationale similar to that of the Third and Sixth Circuits by focusing on the utilitarian functionality of the trade dress and on whether the aesthetic feature act as an indication of source.<sup>147</sup>

#### ***4. Burden of Proof on Functionality--***

One area of confusion that has arisen in the application of the functionality doctrine is whether the plaintiff has the burden of proving nonfunctionality as part of the prima facie case or whether the defendant has the burden of proving functionality as a defense.<sup>148</sup> In the First, Third, Fifth, Ninth, Eleventh Circuits, the proponent of a claim of trade dress infringement must prove that the trade dress \*121 is nonfunctional.<sup>149</sup> In the Second, Seventh, and Tenth Circuits, functionality is a defense to a trade dress infringement claim.<sup>150</sup>

#### ***5. Relationship Between Functionality Doctrine and Patent Law--***

The Second Circuit provided the following warning to courts in their application of section 43(a): "Courts must proceed with caution in assessing claims to unregistered trademark protection in the design of products so as not to undermine the objectives of the patent laws."<sup>151</sup> The caution that the Second Circuit referred to is administered by means of the functionality doctrine. The functionality doctrine ensures that section 43(a) does not undermine the objectives of patent law. By granting limited periods of protection to novel, non-obvious, and useful inventions and new, original, and ornamental designs, the patent law fosters progress in science and the useful arts.<sup>152</sup> For the period of the patent, the patent holder reaps the rewards of his invention or design and society is rewarded by new and useful products. When the patent expires -- seventeen years for invention patents,<sup>153</sup> and fourteen years for design patents,<sup>154</sup> -- the patent falls within the public domain and society receives a valuable, novel idea. If section 43(a) protected functional trade dress, then these valuable ideas, which have only limited protection under patent law, would never reach the public domain and the owner of the idea would have monopoly of an unlimited duration.<sup>155</sup> The functionality doctrine prevents the indefinite protection under section 43(a) of those features which should receive only limited protection under the patent law.<sup>156</sup>

## **IV. Has Infringement of the Trade Dress Occurred?**

### ***A. What is Likelihood of Confusion?***

Once the findings of distinctiveness and nonfunctionality establish that the trade dress is entitled to protection, the inquiry shifts to whether the trade dress has been infringed.<sup>157</sup> “Likelihood of confusion” is the basic test to determine whether infringement has occurred.

\*122 When originally enacted, section 43(a) included no express reference to the “likelihood of confusion” standard.<sup>158</sup> To account for the judicial developments in section 43(a), the Trademark Law Revision Act of 1988 modified section 43(a) to include an expansive likelihood of confusion standard. After the effective date of the Trademark Law Revision Act of 1988, a likelihood of confusion exists if the infringing trademark or trade dress 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, . . .<sup>159</sup>

### ***B. Confusion Among Whom?***

Section 43(a) does not expressly state in whom the likelihood of confusion must exist.<sup>160</sup> As a general rule, the courts consider whether a likelihood exists that “an appreciable number of ordinarily prudent purchasers” of the products in question will be misled or confused.<sup>161</sup> However, section 43(a) does not always require that the likelihood of confusion be among the consuming public or potential customers of a manufacturer or business. The Fourth Circuit has found that a trade dress infringement action could be based on a likelihood of confusion among the general public, as opposed to typical purchasers, if the “public confusion will adversely affect the plaintiff’s ability to control his reputation among laborers, lenders, investors, or other group [sic] with whom the plaintiff interacts.”<sup>162</sup> The Second and Sixth Circuits have also extended the likelihood of confusion to the general public based on an adverse impact on the senior user’s reputation.<sup>163</sup>

### ***C. Reverse Confusion***

In the typical trade dress infringement case, likelihood of confusion occurs when there is a misimpression that the senior user is the source or sponsor of the junior user’s product or business.<sup>164</sup> This is called ordinary confusion. Reverse confusion occurs when the misimpression is that the junior user is the source or sponsor of the senior user’s goods or business.<sup>165</sup> In a reverse confusion case, successful marketing or advertising by the junior user causes consumers to mistakenly assume that the senior user is a second comer or infringer. The difference between the two types of confusion lies in the reputation or goodwill established by the parties. In an ordinary confusion case, the senior user generally has established a certain reputation or goodwill. In a reverse confusion case, the senior user generally \*123 has not established as strong a reputation or goodwill as the junior user, thus, allowing for a likelihood of confusion as to who is the senior user.<sup>166</sup>

Prior to 1988, a question existed as to whether reverse confusion is actionable under section 43(a).<sup>167</sup> In 1988, in *Banff, Ltd. v. Federated Dept. Stores, Inc.*,<sup>168</sup> the Second Circuit explicitly held that reverse confusion is actionable under section 43(a) of the Lanham Act.<sup>169</sup> The *Banff* court noted that “[t]he objectives of that Act -- to protect an owner’s interest in its trademark by keeping the public free from confusion as to the source of goods and ensuring fair competition -- are as important in a case of reverse confusion as in typical trademark infringement.”<sup>170</sup> The First Circuit has taken a different approach. The First Circuit has recognized that reverse confusion is actionable under section 43(a) as long as the confusion involves a misimpression as to the source or sponsorship of the senior user’s product.<sup>171</sup> The First Circuit refused to recognize reverse confusion when the injury to the senior user is merely the public’s perception that the senior user is an infringer, or pirate.<sup>172</sup>

### ***D. Indicia of Confusion -- The Likelihood of Confusion Factors***

The majority of circuits determine likelihood of confusion by means of a balancing test, in which several factors indicating a likelihood of confusion are evaluated with no one factor being determinative.<sup>173</sup> The factors used by most courts originate from two sources: the Second Circuit’s opinion in *Polaroid Corporation v. Polarad Electronics Corp.*,<sup>174</sup> and section 729 of the *Restatement of Torts*.

In *Polaroid*, Judge Friendly listed the following eight factors, which are viewed by most courts and commentators as the key considerations in determining whether a likelihood of confusion exists: (1) the strength of the mark; (2) the degree of similarity between the two marks; (3) the proximity of the products; (4) the likelihood that the senior user of the mark will bridge the gap; (5) evidence of actual confusion; (6) the junior user’s bad faith intent in adopting the mark; (7) the quality of the junior user’s product; and (8) the sophistication of the relevant consumer group.<sup>175</sup>

\*124 The second source of likelihood of confusion factors, which Judge Friendly cited as authority for the *Polaroid* factors, is section 729 of the *Restatement of Torts*.<sup>176</sup> The factors listed in section 729 are not the exact same factors listed by the *Polaroid* court, but both sets of factors involve many of the same considerations. Section 729 provides the following list of factors for determining likelihood of confusion:

(a) the degree of similarity between the designation and the trade-mark or trade name in  
(i) appearance;

(ii) pronunciation of the words used;

(iii) verbal translation of the pictures or designs involved;

(iv) suggestion;

(b) the intent of the actor in adopting the designation;

(c) the relation in use and manner of marketing between the goods or services marketed by the actor and those marketed by the other;

(d) the degree of care likely to be exercised by purchasers.<sup>177</sup>

The likelihood of confusion factors relevant for determining whether a likelihood of confusion exists between two trade dresses are “essentially the same” factors as those used for determining whether a likelihood of confusion exists between two trademarks.<sup>178</sup> Not all circuits use exactly the same combination of factors, and the designations given to each factor frequently differ among the circuits. However, the likelihood of confusion factors, referred to as “digits” of confusion by some courts,<sup>179</sup> listed by the *Polaroid* court and the factors listed in section 729 of the *Restatement of Torts* are the essential considerations used by all circuits in assessing whether a likelihood of confusion exists.<sup>180</sup> However, neither source represents an exclusive list of all factors indicating a likelihood of confusion.<sup>181</sup>

Application of the likelihood of confusion factors involves a weighted balancing conditioned upon the facts of the infringement suit.<sup>182</sup> In theory, no one factor can conclusively establish a likelihood of confusion, nor can any one factor determine the outcome of the case without proper analysis of the other factors.<sup>183</sup> Certain factors may be extremely probative under one set of facts but have relatively little weight under another set of facts.<sup>184</sup> Consequently, each factor should be independently analyzed and then balanced against the other factors.

### **\*125 1. Strength of the Trade Dress--**

The strength of a trademark or trade dress is “its tendency to identify the goods sold as emanating from a particular source, even when the source is unknown to the consumer.”<sup>185</sup> Therefore, an important factor for determining the strength of a trade dress is the level of distinctiveness in which the trade dress fits.<sup>186</sup> For example, descriptive trade dress would presumably be a weaker indication of source than arbitrary trade dress. However, the level of distinctiveness of the trade dress is not controlling.<sup>187</sup> Certain trade dress may be categorized at a high level of distinctiveness but may nonetheless be a weak indication of source.<sup>188</sup>

As a general rule, the strength of the trade dress determines the scope of its protection. As the trade dress becomes stronger, it receives more protection.<sup>189</sup> This rule is based on the premise that as the trade dress becomes weaker, it is less likely that consumers will view the trade dress as an indication of source.<sup>190</sup>

### **2. Degree of Similarity--**

The degree of similarity, also referred to as similarity of design, involves simply a visual, side-by-side comparison of the two trade dresses.<sup>191</sup> The degree of similarity factor has been described as “really nothing more than a subjective eyeball test.”<sup>192</sup> As with all trade dress analysis, the comparison should focus on a combination of all the features which comprise the trade dress, rather than similarities in individual features.<sup>193</sup> Thus, the degree of similarity is not measured by how many features are similar but by whether the two trade dresses “create the same general overall impression.”<sup>194</sup>

In determining the degree of similarity, the central issue is whether the similarity between the two trade dresses is likely to

cause confusion as to the source of the product.<sup>195</sup> Consequently, an important consideration in assessing similarity is the existence and prominence of markings on the junior user's product. Prominently displayed markings or trade names may adequately distinguish the junior trade dress from the senior trade dress and dispel any consumer confusion as to origin, sponsorship or approval of the junior user's product. For example, in the case *Bristol-Myers Squibb Co. v. McNeil-P.P.C., Inc.*,<sup>196</sup> the Second Circuit found that the prominently displayed trade name "Tylenol" on an over-the- \*126 counter pain reliever outweighed all evidence that the trade dress of the "Tylenol" pain reliever might be confused with a competing pain reliever.<sup>197</sup>

A related consideration to the degree of similarity factor is whether consumers have the ability to compare the two products side-by-side. If consumers do not have the ability to make a side-by-side comparison at the time of purchase, then the consumers are more likely to be confused as to the source of the products. As noted by the Fifth Circuit, "the inability [of consumers] to compare the products side by side and observe the precise differences in appearance may increase the likelihood of confusion."<sup>198</sup> For example, competing products may not be sold by the same store. Since consumers do not have the opportunity to make a visual comparison of the two products at the time of purchase, similarities in the products may lead consumers to confuse the two products.

### ***3. Proximity of the Products--***

The proximity of the products factor considers whether the two products compete with each other.<sup>199</sup> Under this factor, the likelihood of confusion increases to the extent that the products "serve the same purpose, fall within the same general class, or are used together."<sup>200</sup> Consequently, the courts frequently consider "whether the products differ in content, geographic distribution, market position, and audience appeal."<sup>201</sup>

In determining the proximity of the products, the inquiry is whether "it is likely that consumers mistakenly will assume either that [the junior user's goods] somehow are associated with [the senior user] or are made by [the senior user]."<sup>202</sup> The proximity of the products factor assumes that consumers understand that two separate products exist but may be confused, because of similarities between the two types of products, as to who manufactures the products.<sup>203</sup>

### ***4. Likelihood that the Senior User Will Bridge the Gap--***

Likelihood that the senior user will "bridge the gap" refers to whether the senior user is likely to enter the market in which the junior user is operating.<sup>204</sup> If it is likely that the senior user will move into the market in which the junior user is operating or if the junior and senior user already operate in the same consumer market, then there is an even greater likelihood of confusion.<sup>205</sup> The bridge the gap \*127 factor seeks to protect "the senior user's interest in being able to enter a related field at some future time."<sup>206</sup> If the products are competitive, "there is no gap to be bridged."<sup>207</sup>

### ***5. Evidence of Actual Confusion--***

Although evidence of actual confusion is not necessary to prove a likelihood of confusion,<sup>208</sup> the courts have placed particular emphasis on the existence of actual confusion. An absence of evidence of actual confusion has been referred to as "patently the best evidence of [a] likelihood of confusion."<sup>209</sup>

Actual confusion can be measured by either individual instances of consumer confusion or survey evidence of consumer confusion.<sup>210</sup> Under either method, the number of occurrences of actual confusion necessary to establish the actual confusion factor is not an absolute number, but rather is based on the totality of the circumstances in each individual case.<sup>211</sup> For example, two instances of actual confusion were enough to establish actual confusion in one case;<sup>212</sup> but nineteen instances of actual confusion did not amount to actual confusion in another case.<sup>213</sup>

One factor that may influence the importance of the actual confusion factor and the number of instances of actual confusion needed to prove actual confusion is the price of the product. If the product is relatively inexpensive or an item normally purchased on impulse, a lack of actual confusion may not be of great importance in the balancing of factors.<sup>214</sup> Similarly, actual confusion for inexpensive or impulse purchases may be established through a relatively low number of instances of actual confusion.<sup>215</sup> These rules are based on the premise that customers of relatively inexpensive, low involvement purchases might not discover that they had been confused; and, if they did discover any confusion as to the source or sponsorship of the product, they would probably not spend the time to report the confusion.<sup>216</sup> Consequently, a lack of actual confusion concerning inexpensive, low involvement purchases may not be indicative of a likelihood of confusion; however, the presence of actual confusion in such purchases may indicate a substantial likelihood of confusion.

## ***6. Junior User's Intent In Adopting Its Trade Dress--***

As noted by the Second Circuit, “[e]vidence of intentional copying by a junior user may be indicative of an intent to create a confusing similarity between the products.”<sup>217</sup> The intent factor considers whether the junior user sought to cash in on the senior user’s goodwill or reputation.

\*128 Most courts find that the junior user’s bad faith intent alone creates a rebuttable inference of a likelihood of confusion.<sup>218</sup> In more specific terms, if the junior user adopted the trade dress with the intent of deriving benefit from the reputation or goodwill of the senior user, most courts find that an inference arises that a likelihood of confusion exists. The rationale for creating the inference of confusion is that if the junior user intentionally sought to “cash in” on the senior user’s reputation, then junior user should bear the burden of proving that the trade dresses are not confusingly similar.<sup>219</sup>

A prior business or contractual relationship, such as a licensing or distributorship agreement, may provide strong evidence of the junior user’s bad faith intent to derive benefit from the senior user’s reputation.<sup>220</sup> However, a prior business or contractual relationship is not necessary to prove the junior user’s bad faith intent. Several courts have found that the mere fact that the junior user intentionally chose product features which closely resemble the features of an established manufacturer or business may alone be sufficient to establish the junior user’s bad faith intent.<sup>221</sup>

## ***7. Quality of the Junior User's Product--***

The lack of any substantial difference in quality between products with confusingly similar trade dress supports the inference that the products originated from the same source.<sup>222</sup> In other words, similarities in quality increase the likelihood of confusion between identical products with similar trade dress.<sup>223</sup> However, the products do not have to be of similar quality for this factor to be weighed in favor of the senior user. If the junior user’s product is of inferior quality, the senior user’s reputation may be damaged if consumers think that the products came from the same source. Therefore, the quality of the junior user’s product may weigh in favor of the senior user if the junior user’s product is of inferior quality.<sup>224</sup>

This original *Polaroid* factor is generally given little weight by the courts and has been merged by many circuits into other likelihood of confusion factors.<sup>225</sup>

## ***8. Sophistication of the Relevant Consumer Market--***

As a general rule, the more sophisticated the average consumer of the product is, the less likely the consumer will be confused as to the source or sponsorship of the product.<sup>226</sup> The sophistication of the consumer factor can be analyzed in terms of what degree of investigation or involvement the average consumer of the product puts forth for the purchase of the product. The more involved the purchase, the \*129 less likely it is that consumers will be confused concerning similarities in the trade dresses. For example, the purchase of an over-the-counter pain reliever, a relatively “low involvement” purchase, involves a greater probability of consumer confusion<sup>227</sup> than the purchase of multi-million dollar construction services, a relatively “high involvement” purchase.<sup>228</sup>

In the balancing of the *Polaroid* factors, the sophistication of the average consumer may be given extraordinary weight. A highly sophisticated consumer market may even preclude a finding of a likelihood of confusion even though other factors clearly indicate a likelihood of confusion.<sup>229</sup>

## ***9. Channels of Distribution and Marketing--***

If the junior user’s and senior user’s products are distributed or marketed through the same channels, a greater likelihood of confusion exists.<sup>230</sup> The channels of distribution and marketing factor is actually a combination of two factors: (1) whether the products are distributed through the same retail outlets or to the same purchasers; and (2) whether the products are marketed through the same channels or through similar advertising.<sup>231</sup>

As noted by both the Fifth and Eleventh Circuits, “[d]issimilarities between the retail outlets for and the predominant customers of plaintiff’s and defendant’s goods lessen the possibility of confusion, mistake, or deception.”<sup>232</sup> In other words, if the senior user and junior user sell their products from the same retail outlets to the same purchasers, there is a greater likelihood of confusion.<sup>233</sup> Similarly, if the products are marketed through the same advertising media or through similar

advertising campaigns, a greater likelihood of confusion exists.<sup>234</sup>

Channels of distribution and marketing is not one of the original *Polaroid* factors, but it has been adopted by many courts as a replacement for other less descriptive factors.<sup>235</sup>

### ***E. The Second-Comer Doctrine***

The second-comer doctrine imposes section 43(a) liability on those “second comers” who, in bad faith, deliberately attempt to exploit the reputation and goodwill established by the senior user of a distinctive mark.<sup>236</sup> The effect of the second-comer doctrine is to impose a duty on the second comer “to so name and dress his product as to avoid all likelihood of consumers confusing it with the product of the first comer.”<sup>237</sup>

\*130 The second-comer doctrine has not been extended far beyond a few opinions from the Second Circuit and its continued viability has even been questioned by the Second Circuit.<sup>238</sup> Many courts simply consider the principles of the second-comer doctrine under the intent factor, because the second-comer doctrine is essentially just an emphasis on the strength of the mark and junior user’s bad faith intent.<sup>239</sup> Despite the fact that the viability of the second-comer doctrine is questionable, the Second Circuit has unequivocally maintained that the second-comer doctrine would impose section 43(a) liability in one particular situation: if the second comer falsely represented its goods as those of the trademark owner.<sup>240</sup>

### ***F. Standard of Review***

A split of authority exists between the circuits on the standard of review for findings on likelihood of confusion.<sup>241</sup> Some circuits consider a finding on likelihood of confusion to be a factual finding, which can be reversed only if clearly erroneous.<sup>242</sup> Other circuits use a two-level standard of review where the district court’s determination of the individual *Polaroid* factors are reviewed as findings of fact, subject to reversal only if clearly erroneous, while the balancing of the factors and the ultimate determination on likelihood of confusion is a conclusion of law, subject to a de novo review.<sup>243</sup> Under the two-level standard of review, the findings on each individual likelihood of confusion factor are foundational facts, while the ultimate determination on the likelihood of confusion is a legal conclusion.<sup>244</sup>

## **V. Conclusion**

Analysis of a trade dress infringement claim under section 43(a) of the Lanham Act is a complex and in-depth procedure for which this article only scratches the surface. In this article, I have attempted to provide the practitioner with the basic legal framework to answer the following two questions: (1) Is the trade dress entitled to protection? (2) Has infringement of that trade dress occurred?

The answers to the above two questions are provided by the elements of a section 43(a) claim: distinctiveness, nonfunctionality and likelihood of confusion. The protection question is answered by determining whether the trade dress has acquired the requisite level of distinctiveness and by determining whether the trade dress is nonfunctional. The infringement question is answered by determining whether a likelihood of confusion exists between the senior user’s trade dress and the junior user’s trade dress.

Once the elements of a section 43(a) claim are satisfied, the end result is a protectable interest in the “image” of your product or business.

### Footnotes

<sup>a1</sup> Associate, Orgain, Bell & Tucker, Beaumont, Texas; J.D., Texas Tech School of Law, 1993.

<sup>1</sup> See, e.g., *Two Pesos, Inc. v. Taco Cabana, Inc.*, 112 S. Ct. 2753, 2755 n.1 (1992) (“*Taco Cabana II*”); *Abbott Lab. v. Mead Johnson & Co.*, 971 F.2d 6, 20 (7th Cir. 1992); *Esercizio v. Roberts*, 944 F.2d 1235, 1238-39 (6th Cir. 1991), *cert. denied*, 112 S. Ct. 3028 (1992); *Blue Bell Bio-Medical v. Cin-Bad, Inc.*, 864 F.2d 1253, 1256 (5th Cir. 1989); *John H. Harland Co. v. Clarke Checks, Inc.*, 711 F.2d 966, 980 (11th Cir. 1983).

<sup>2</sup> See, e.g., *Vaughan Mfg. Co. v. Brikam Int'l, Inc.*, 814 F.2d 346, 350 (7th Cir. 1987); *First Brands Corp. v. Fred Meyer, Inc.*, 809 F.2d 1378, 1381 (9th Cir. 1987); *American Greetings Corp. v. Dan-Dee Imports, Inc.*, 807 F.2d 1136, 1141 (3d Cir. 1986).

<sup>3</sup> *Taco Cabana Int'l, Inc. v. Two Pesos, Inc.*, 932 F.2d 1113, 1118 (5th Cir. 1991) (“*Taco Cabana I*”), *aff'd*, *Taco Cabana II*, 112 S. Ct. 2753 (1992).

<sup>4</sup> *Id.*

<sup>5</sup> See Lanham Act, Pub. L. No. 79-489, § 43(a), 60 Stat. 427, 441 (codified in 15 U.S.C. § 1125(a) (1988)).

<sup>6</sup> See *CJC Holdings, Inc. v. Wright & Lato, Inc.*, 979 F.2d 60 (5th Cir. 1992); *Taco Cabana I*, 932 F.2d 1113; *Yarmuth-Dion, Inc. v. D'Ion Furs, Inc.*, 835 F.2d 990, 992-93 (2d Cir. 1987) (following the two-step test); *Centaur Communications, Ltd. v. A/S/M Communications, Inc.*, 830 F.2d 1217, 1220-23 (2d Cir. 1987).

<sup>7</sup> See *infra* section III.

<sup>8</sup> See *infra* section IV.

<sup>9</sup> See, e.g., *Blau Plumbing Inc. v. S.O.S. Fix-It, Inc.*, 781 F.2d 604, 608 (7th Cir. 1986).

<sup>10</sup> See 15 U.S.C. § 1125(a) (1988). Section 43(a) is the only provision in the Lanham Act that protects an unregistered mark. *Centaur Communications*, 830 F.2d at 1220-23.

<sup>11</sup> For a definition of unfair competition, see 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 1.03 (3d ed. 1992).

<sup>12</sup> 15 U.S.C.A. § 1125(a) (1982). Prior to the 1988 amendment, § 1125(a) provided as follows:  
(a) Any person who shall affix, apply, or annex, or use in connection with any goods or services, or any container or containers for goods, a false designation of origin, or any false description or representation, including words or other symbols tending falsely to describe or represent the same, and shall cause such goods or services to enter into commerce, and any person who shall with knowledge of the falsity of such designation of origin or description or representation cause or procure the same to be transported or used in commerce or deliver the same to any carrier to be transported or used, shall be liable to a civil action by any person doing business in the locality falsely indicated as that of origin or in the region in which said locality is situated, or by any person who believes that he is or is likely to be damaged by the use of any false description or representation. *Id.*

<sup>13</sup> *Taco Cabana II*, 112 S. Ct. at 2762 (Stevens, J., concurring).

<sup>14</sup> *Id.*

<sup>15</sup> *Federal-Mogul-Bower Bearings, Inc. v. Azoff*, 313 F.2d 405, 408 (6th Cir. 1963).

<sup>16</sup> See, *20th Century Wear, Inc. v. Sanmark-Stardust, Inc.*, 747 F.2d 81, 92 (2d Cir. 1984) (“[A] plaintiff [in a trade dress infringement claim] must allege that a competitor’s product design or packaging is likely to confuse consumers as to the product source -- such a design or packaging falsely designates its origin.”); *Keebler Co. v. Rovira Biscuit Corp.*, 624 F.2d 366, 372 (1st Cir. 1980).

<sup>17</sup> See 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 27:03[1][b] (3d ed. 1992).



18 Inwood Lab., Inc. v. Ives Lab., Inc., 456 U.S. 844, 863 (1982) (White, J., concurring).

19 *Taco Cabana II*, 112 S. Ct. at 2762 (Stevens, J., concurring) (“The full text of the section [43(a)] makes it clear that the word ‘origin’ refers to the geographic location in which the goods originated, . . . .”); *Chevron Chem. Co. v. Voluntary Purchasing Groups*, 659 F.2d 695, 700 (5th Cir. 1981), *cert. denied*, 457 U.S. 1126 (1982). *See also* Kenneth B. Germain, *Unfair Trade Practices Under Section 43(a) of the Lanham Act: You’ve Come A Long Way, Baby -- Too Far, Maybe?*, 49 IND. L.J. 84, 110-11 (1974) (disapproving of designation of “origin” as origin of manufacture).

20 *Chevron*, 659 F.2d at 700.

21 *Id.*

22 15 U.S.C. § 1125(a) (1988).

23 *See Chevron*, 659 F.2d at 700.

24 *See Ross Bicycles, Inc. v. Cycles USA, Inc.*, 765 F.2d 1502, 1509 (11th Cir. 1985), *cert. denied*, 475 U.S. 1013 (1986) (quoting 15 U.S.C. § 1125).

25 *See Frisch’s Restaurants, Inc. v. Elby’s Big Boy of Steubenville, Inc.*, 670 F.2d 642, 646-47 (6th Cir. 1982), *cert. denied*, 459 U.S. 916 (1982).

26 *Taco Cabana II*, 112 S. Ct. at 2763 (Stevens, J., concurring).

27 *Union Mfg. Co. v. Han Baek Trading Co.*, 763 F.2d 42, 47-48 (2d Cir. 1985).

28 *Taco Cabana II*, 112 S. Ct. at 2763 (Stevens, J., concurring) (“Today, it is less significant whether the infringement falls under ‘false designation of origin’ or ‘false description or representation’ because in either case § 43(a) may be invoked.” (footnote omitted)). *See also* 2 J. THOMAS MCCARTHY, TRADEMARKS AND UNFAIR COMPETITION, § 27.03[1][b] at 27-21 to 27-24 (3d ed. 1992) (noting that it makes no difference whether an infringement is classified as a “false designation of origin” or a “false description or representation.”).

29 Trademark Law Revision Act of 1988, Pub. L. No. 100-667, sec. 132, § 43(a), 102 Stat. 3935, 3946 (amending 15 U.S.C. § 1125(a) (1988)) (effective November 16, 1989).

30 15 U.S.C. § 1125(a) (Supp. 1992).

31 2 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 27.02[4] (3d ed. 1992).

32 *See* S. Rep. No. 515, 100th Cong., 2d Sess., at 40 (1988), *reprinted in* 1988 U.S.C.C.A.N. 5577, 5603. *See also* *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1107 (9th Cir. 1992), *cert. denied*, 113 S. Ct. 1047 (1993); *Alpo Petfoods, Inc. v. Ralston Purina Co.*, 913 F.2d 958, 964 n.6 (D.C. Cir. 1990) (“Congress intended that the § 43(a) amendments largely codify pre-1988 case law.”).

33 *See* sources cited *supra* note 32.

34 S. Rep. No. 515, 100th Cong., 2d Sess., at 40 (1988), *reprinted in* 1988 U.S.C.C.A.N. 5577, 5603.

35 *See Taco Cabana II*, 112 S. Ct. at 2757; *A.J. Canfield Co. v. Honickman*, 808 F.2d 291, 299 n.9 (3d Cir. 1986); *Thompson*

Medical Co. v. Pfizer, Inc., 753 F.2d 208, 215-16 (2d Cir. 1985).

36 See 15 U.S.C. § 1052 (1988); *Taco Cabana II*, 112 S. Ct. at 2757.

37 See cases cited *supra* note 35.

38 The categories of distinctiveness were developed with respect to trademark protection by Judge Friendly in *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976).

39 See, e.g., *Abercrombie*, 537 F.2d at 9.

40 See, e.g., *id.* at 9-10. “Secondary meaning” means that the mark or dress “has come through use to be uniquely associated with a specific source.” *Taco Cabana II*, 112 S. Ct. at 2756 n.4 (quoting RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 13 cmt. e (Tentative Draft No. 2, 1990)).

41 See, e.g., *Abercrombie*, 537 F.2d at 10-11.

42 See, e.g., *id.* at 9 (“The lines of demarcation, however, are not always bright.”). See also Ralph H. Folsom & Larry L. Teply, *Trademarked Generic Words*, 89 YALE L.J. 1323, 1351-53 (1980) (commenting on the difficulty in distinguishing between generic and descriptive marks).

43 See *Soweco, Inc. v. Shell Oil Co.*, 617 F.2d 1178, 1183 (5th Cir. 1980); *Abercrombie*, 537 F.2d at 9.

44 See *Abercrombie*, 537 F.2d at 9.

45 See, e.g., *King-Seeley Thermos Co. v. Aladdin Indus., Inc.*, 321 F.2d 577, 579 (2d Cir. 1963) (holding that “thermos,” once suggestive, was now generic); *Haughton Elevator Co. v. Seeberger*, 85 U.S.P.Q. (BNA) 80 (1950) (holding that the word “Escalator,” which was originally fanciful or at least suggestive, is now generic).

46 See *Abercrombie*, 537 F.2d at 9.

47 When considering the distinctiveness of a trademark or trade name, the courts have before them either words or symbols which convey a particular visual image. The courts can then determine whether that image describes the product, suggests the type of product, or has absolutely no relation to the product. With trade dress, the image is conveyed, not necessarily by words or symbols, but by a combination of product features. When considering the distinctiveness of trade dress, the courts must determine what image is being conveyed by the aggregate of the features and then determine what relationship exists between the image and the product.

48 See *Ambrit, Inc. v. Kraft, Inc.*, 812 F.2d 1531 (11th Cir. 1986), *cert. denied*, 481 U.S. 1041 (1987); *Sicilia Di R. Biebow & Co. v. Cox*, 732 F.2d 417, 425 n.3 (5th Cir. 1984) (“The same [distinctiveness] principles apply in the context of trade dress, although selection is from designs and configurations, not words.”). Since the categories of distinctiveness apply equally to trade dress as to trademarks and since many courts discuss distinctiveness in terms of “marks,” this article discusses the categories of distinctiveness in terms of marks for the purpose of simplicity. See, e.g., *Taco Cabana II*, 112 S. Ct. at 2757 (using the term “marks” in a discussion of distinctiveness in a case involving only trade dress).

49 *Taco Cabana II*, 112 S. Ct. at 2757. (quoting *Park ‘N Fly, Inc. v. Dollar Park and Fly, Inc.*, 469 U.S. 189, 194 (1985)). See also CHARLES E. MCKENNEY & GEORGE F. LONG, III, *FEDERAL UNFAIR COMPETITION: LANHAM ACT § 43(a) § 3.03*, at 3-20 (3d prt. 1992) (providing a lengthy definition of “generic terms”).

50 See *General Conference Corp. of Seventh-Day Adventists v. Seventh-Day Adventist Congregational Church*, 887 F.2d 228, 231 (9th Cir. 1989) (“A generic mark is one that tells the buyer what the product is, rather than from where, [sic] or whom it came.”),

*cert. denied*, 110 S. Ct. 1134 (1990).

- 51 *See Honickman*, 808 F.2d at 299 n.9 (recognizing that the primary significance test applies to unregistered marks under section 43(a)). *See also* *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 118 (1938) (creating the primary significance test); 15 U.S.C. § 1064(3) (1988) (mandating that the primary significance test shall be the test for determining whether a registered mark is generic); CHARLES E. MCKENNEY & GEORGE F. LONG, III, *FEDERAL UNFAIR COMPETITION: LANHAM ACT § 43(a) § 3.03*, at 3-31 (3d prtg. 1992) (noting that the standards enunciated in *National Biscuit* continue to apply); Ralph H. Folsom & Larry L. Teply, *Trademarked Generic Words*, 89 YALE L.J. 1323, 1327-29 (1980) (discussing the primary significance test).
- 52 *Kellogg*, 305 U.S. at 118. *See also Honickman*, 808 F.2d at 300.
- 53 *Honickman*, 808 F.2d at 301. *See also Kellogg*, 305 U.S. at 118.
- 54 *See Honickman*, 808 F.2d at 301.
- 55 *See* 15 U.S.C. §§ 1052, 1064(3) (1988); *Park 'N Fly*, 469 U.S. at 194.
- 56 *See, e.g., Taco Cabana II*, 112 S. Ct. at 2757; *Ambrit*, 812 F.2d at 1537 n.20.
- 57 *See, e.g., Honickman*, 808 F.2d at 304. *See also Thompson Medical*, 753 F.2d at 216 (identifying unfairness to competitors as a rationale for denying protection to generic and descriptive marks).
- 58 *Abercrombie*, 537 F.2d at 11 (quoting *Stix Prods., Inc. v. United Merchants & Mfrs.*, 295 F. Supp. 479, 488 (S.D.N.Y. 1968)).
- 59 1 J. THOMAS MCCARTHY, *MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION*, § 11.05[2][a] (3d ed. 1992) (footnotes omitted).
- 60 973 F.2d 1033, 1040 (2d Cir. 1992) (quoting *20th Century Wear*, 747 F.2d at 88).
- 61 *Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786, 790 (5th Cir. 1983) (quoting in part *Vision Center v. Opticks, Inc.*, 596 F.2d 111, 115 (5th Cir. 1979), *cert. denied*, 444 U.S. 1016 (1980)).
- 62 *Taco Cabana II*, 112 S. Ct. at 2757.
- 63 *See Papercutter, Inc. v. Fay's Drug Co.*, 900 F.2d 558, 562 (2d Cir. 1990).
- 64 *Thompson Medical*, 753 F.2d at 216.
- 65 *Abercrombie*, 537 F.2d at 11 (quoting *Stix Products*, 295 F. Supp. at 488).
- 66 Stephen L. Carter, *The Trouble with Trademark*, 99 YALE L.J. 759, 771 (1990).
- 67 *See, e.g., Taco Cabana II*, 112 S. Ct. at 2760 (recognizing that inherently distinctive trade dress is entitled to protection without proof of secondary meaning); *Thompson Medical*, 753 F.2d at 216 (recognizing that suggestive marks are eligible for protection without proof of secondary meaning); *Honickman*, 808 F.2d at 296-97 (recognizing the difficulty in distinguishing between the categories).

68 *See Taco Cabana II*, 112 S. Ct. at 2757-58.

69 *Id.* at 2757. *But cf. Ambrit*, 812 F.2d at 1537 (holding that third-party use of one or more suggestive elements of the senior party's trade dress may deprive that trade dress of its inherent distinctiveness if the third-party use is so extensive and so similar to the senior party's that it impairs the ability of consumers to use the trade dress of the products to identify their source).

70 *Abercrombie*, 537 F.2d at 11 n.12.

71 *Id.*

72 *See, e.g., American Television and Communications Corp. v. American Communications and Television, Inc.*, 810 F.2d 1546, 1549 (11th Cir. 1987); *Opticks*, 596 F.2d at 116.

73 *See, e.g., Taco Cabana II*, 112 S. Ct. at 2757; *Papercutter*, 900 F.2d at 561-62 (summarizing *Abercrombie*, 537 F.2d at 9-11).

74 *See* RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 13 cmt. c (Tent. Draft No. 2, 1990).

75 *Id.*

76 *Taco Cabana II*, 112 S. Ct. at 2756 n.4. The issue of secondary meaning is generally a question of fact. *See, e.g., Braun Inc. v. Dynamics Corp. of Am.*, 975 F.2d 815, 825 (Fed. Cir. 1992); *Sno-Wizard Mfg., Inc. v. Eisemann Prods. Co.*, 791 F.2d 423, 427 (5th Cir. 1986).

77 *Sicilia Di R. Biebow*, 732 F.2d at 425 n.4 (quoting 1 J. THOMAS MCCARTHY, TRADEMARKS AND UNFAIR COMPETITION § 15:2, at 516 (1st ed. 1973)).

78 456 U.S. 844 (1982).

79 *Id.* at 851 n.11 (quoting *Kellogg*, 305 U.S. at 118).

80 *See, e.g., Braun*, 975 F.2d at 825-26 (senior mark must establish secondary meaning before junior mark enters the market); *Investacorp, Inc. v. Arabian Inv. Banking Corp.*, 931 F.2d 1519, 1525 (11th Cir. 1991) (secondary meaning must attach to the senior mark before the junior mark enters the market), *cert. denied*, 112 S. Ct. 639 (1991).

81 *See, e.g., Centaur Communications*, 830 F.2d at 1221-22 (relevant consuming public of the parties' magazines was "executives in the international marketing and advertising community in the United States"); *Playboy Enters., Inc. v. Chuckleberry Pub., Inc.*, 687 F.2d 563, 567 (2d Cir. 1982) (relevant consuming public was heterosexual adult males).

82 *See Taco Cabana II*, 112 S. Ct. at 2757. The Second Circuit had consistently held that proof of secondary meaning was required in order to prevail on a claim for trade dress infringement. *See, e.g., Stormy Clime Ltd. v. ProGroup, Inc.*, 809 F.2d 971, 974 (2d Cir. 1987); *Han Baek Trading Co.*, 763 F.2d at 48; *LeSportsac, Inc. v. K Mart Corp.*, 754 F.2d 71, 78 (2d Cir. 1985); *Vibrant Sales, Inc. v. New Body Boutique, Inc.*, 652 F.2d 299, 303 (2d Cir. 1981), *cert. denied*, 455 U.S. 909 (1982). The Fourth Circuit had indicated that, as a general rule, proof of secondary meaning was required in order to prove trade dress infringement. *See M. Kramer Mfg. Co. v. Andrews*, 783 F.2d 421, 448-49 (4th Cir. 1986) ("To enjoin a competitor's use of a particular trade dress, a plaintiff must show two things: that his own trade dress has acquired a secondary meaning and that there is a likelihood that the defendant's use of that trade dress will confuse the public."). Several other circuits had decided, as the Fifth Circuit did in *Taco Cabana* and *Chevron*, that secondary meaning was required only if the product was not inherently distinctive. *See Honickman*, 808 F.2d at 297; *Ambrit*, 812 F.2d at 1535-36; *Blau Plumbing*, 781 F.2d at 608-09. *See also Fuddruckers, Inc. v. Doc's B.R. Others, Inc.*, 826 F.2d 837, 843-44 (9th Cir. 1987) (indicating, but refusing to decide, that secondary meaning would not be required if the product was inherently distinctive).

83 *Taco Cabana II*, 112 S. Ct. at 2761.

84 *See id.* at 2758-60.

85 *See id.*

86 University of Georgia Athletic Ass'n v. Laite, 756 F.2d 1535, 1540 (11th Cir. 1985).

87 *Braun*, 975 F.2d at 827; *American Television*, 810 F.2d at 1549.

88 *Sno-Wizard*, 791 F.2d at 427 (quoting *Zatarains*, 698 F.2d at 795).

89 *George Basch Co. v. Blue Coral, Inc.*, 968 F.2d 1532, 1536 (2d Cir. 1992) (citing *Thompson Medical*, 753 F.2d at 217. The Third, Fourth and Seventh Circuits consider similar factors for determining secondary meaning. *See* *Dranoff-Perlstein Assocs. v. Sklar*, 967 F.2d 852, 858-59 (3d Cir. 1992); *Perini Corp. v. Perini Constr., Inc.*, 915 F.2d 121, 125 (4th Cir. 1990); *Echo Travel, Inc. v. Travel Assocs.*, 870 F.2d 1264, 1267 (7th Cir. 1989).

90 *George Basch*, 968 F.2d at 1536 (quoting *Thompson Medical*, 753 F.2d at 217). *See also Centaur Communications*, 830 F.2d at 1222-25 (commenting on the various factors).

91 *See, e.g., Investacorp*, 931 F.2d at 1525; *Conagra, Inc. v. Singleton*, 743 F.2d 1508, 1513 (11th Cir. 1984). The Fifth and Sixth Circuits consider similar factors in determining secondary meaning. *See* *Burke-Parsons-Bowlby Corp. v. Appalachian Log Homes, Inc.*, 871 F.2d 590, 598 (6th Cir. 1989); *Zatarains*, 698 F.2d at 795. The Ninth Circuit follows a comparable set of factors. *See* *Transgo, Inc. v. AJAC Transmission Parts Corp.*, 768 F.2d 1001, 1015 (9th Cir. 1985), *cert. denied*, 474 U.S. 1059 (1986). The factors listed by the Ninth Circuit are as follows: (1) whether actual purchases of the product bearing the claimed trademark associate the trademark with the producer; (2) the degree and manner of advertising under the claimed trademark; (3) the length and manner of use of the claimed trademark; and (4) whether use of the claimed trademark has been exclusive. *Id.*

92 *See, e.g., Esercizio*, 944 F.2d at 1239; *Vision Sports, Inc. v. Melville Corp.*, 888 F.2d 609, 615 (9th Cir. 1989); *Centaur Communications*, 830 F.2d at 1228; *M. Kramer Mfg.*, 783 F.2d at 447-48; *Truck Equip. Serv. Co. v. Fruehauf Corp.*, 536 F.2d 1210, 1220 n.13 (8th Cir. 1976), *cert. denied*, 429 U.S. 861 (1976); *National Football League Properties, Inc. v. New York Giants, Inc.*, 637 F.Supp. 507, 518 n.7 (D.N.J. 1986). *See also* RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 16 cmt. b (Tent. Draft No. 2, 1990) (“Evidence that the trade dress or product design was intentionally copied by a competitor can support an inference of secondary meaning if the circumstances an intent to benefit from the good will of the prior user through confusion.”).

93 *See, e.g., Audio Fidelity, Inc. v. High Fidelity Recording, Inc.*, 283 F.2d 551, 558 (9th Cir. 1960) (“There is no logical reason for the precise copying [of another’s design] save an attempt to realize upon the secondary meaning that is in existence.”).

94 *See Blau Plumbing*, 781 F.2d at 611 (noting that evidence of the defendant’s deliberate attempts to confuse consumers through copying the plaintiff’s trade dress is “some indication” that the trade dress has acquired secondary meaning); *Brooks Shoe Mfg. Co. v. Suave Shoe Corp.*, 716 F.2d 854, 859-60 (11th Cir. 1983) (holding that proof of intentional copying does not conclusively establish secondary meaning).

95 *Honickman*, 808 F.2d at 295 n.3 (quoting 1 J. THOMAS MCCARTHY, TRADEMARKS AND UNFAIR COMPETITION § 15:21, at 704-05 (2d. ed. 1984)). *See also* CHARLES E. MCKENNEY & GEORGE F. LONG, III, FEDERAL UNFAIR COMPETITION: LANHAM ACT § 43(a) § 3.05, at 3-50 (3rd prtg. 1992).

96 *See* *PAF S.R.L. v. Lisa Lighting Co.*, 712 F.Supp. 394 (S.D.N.Y. 1989); *Jolly Good Indus., Inc. v. Elegra Inc.*, 690 F.Supp. 227 (S.D.N.Y. 1988); *Metro Kane Imports, Ltd. v. Federated Dep’t. Stores, Inc.*, 625 F.Supp. 313 (S.D.N.Y. 1985), *aff’d without opinion sub nom.* *Metro Kane Imports, Ltd. v. Brookstone Co.*, 800 F.2d 1128 (2d Cir. 1986).

97 *See* *Laureyssens v. Idea Group, Inc.*, 964 F.2d 131, 139 (2d Cir. 1992); *Cicena Ltd. v. Columbia Telecommunications Group*, 900

F.2d 1546, 1549-50 (Fed. Cir. 1990); *Black & Decker Mfg. Co. v. Ever-Ready Appliance Mfg. Co.*, 684 F.2d 546, 550 (8th Cir. 1982); *A.J. Canfield Co. v. Concord Beverage Co.*, 629 F.Supp. 200, 211-12 (E.D. Pa. 1985), *aff'd on other grounds sub nom. A.J. Canfield Co. v. Honickman*, 808 F.2d 291 (3d Cir. 1986). *See also* *G. Heileman Brewing Co. v. Anheuser-Busch, Inc.*, 873 F.2d 985, 999 (7th Cir. 1989) (noting in dicta that the Seventh Circuit has never recognized the secondary meaning in the making doctrine). *See also* RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 13 cmt. e (Tent. Draft No. 2, 1990) (“The doctrine if taken literally, is inimical to the purpose of the secondary meaning requirement.”); John M. Scagnelli, *Dawn of a New Doctrine? -- Trademark Protection for Incipient Secondary Meaning*, 71 Trademark Rep. 527, 542-43 (1981) (criticizing the doctrine).

98 *Taco Cabana II*, 112 S. Ct. at 2758.

99 *See, e.g., Thompson Medical*, 753 F.2d at 216.

100 *See, e.g., Vaughan Mfg.*, 814 F.2d at 349. The Seventh Circuit summarized the factual question of functionality as the following: [T]he jury has to determine whether the feature for which trademark protection is sought is something that other producers of the product in question would have to have as part of the product in order to be able to compete effectively in the market. . . or whether it is the kind of merely incidental feature which gives the brand some individual distinction but which producers of competing brands can readily do without. *W.T. Rogers Co. v. Keene*, 778 F.2d 334, 346 (7th Cir. 1985).

101 *Vuitton et fils S.A. v. J. Young Enterprises, Inc.*, 644 F.2d 769, 774 (9th Cir. 1981) (quoting *International Order of Job’s Daughters v. Lindeburg & Co.*, 633 F.2d 912, 917 (9th Cir. 1980), *cert. denied*, 452 U.S. 941 (1981)). *See also* *Sega Enters. Ltd. v. Accolade, Inc.*, 977 F.2d 1510, 1531 (9th Cir. 1992) (quoting *Vuitton*).

102 *Vuitton*, 644 F.2d at 774.

103 *Inwood Lab.*, 456 U.S. at 850 n.10.

104 Harvey S. Perlman, *The Restatement of the Law of Unfair Competition: A Work in Progress*, 80 TRADEMARK REP. 461, 468 (1990).

105 *W.T. Rogers*, 778 F.2d at 339. *See also* *Abbott Lab. v. Mead Johnson & Co.*, 971 F.2d 6, 20 (7th Cir. 1992) (quoting *W.T. Rogers*).

106 *W.T. Rogers*, 778 F.2d at 339.

107 *See, e.g., Brunswick Corp. v. Spinit Reel Co.*, 832 F.2d 513, 519 (10th Cir. 1987); *Sicilia Di R. Biebow*, 732 F.2d at 428-29. *See also* CHARLES E. MCKENNEY & GEORGE F. LONG, III, FEDERAL UNFAIR COMPETITION: LANHAM ACT § 43(a), § 4.07, at 4-38 (1989) (discussing the competing policy interests of the functionality doctrine).

108 *See, e.g., Coach Leatherware Co. v. Ann Taylor, Inc.*, 933 F.2d 162, 171 (2d Cir. 1991) (“Basic Lanham Act principles dictate that an owner may not use a trademark to circumscribe the flow of useful ideas and designs in the marketplace.”); *LeSportsac*, 754 F.2d at 77 (recognizing the rationale of the functionality doctrine as “encouraging competition by preventing advances in functional design from being monopolized.”).

109 *See, e.g., Vaughan Mfg.*, 814 F.2d at 350; *First Brands*, 809 F.2d at 1381; *Ambrit*, 812 F.2d at 1538 (“That individual elements of packaging are functional does not, however, render the package as a whole unprotectable.”); *LeSportsac*, 754 F.2d at 76; *Textron, Inc. v. U.S. Int’l Trade Comm’n*, 753 F.2d 1019, 1026 (Fed. Cir. 1985).

110 *See* cases cited *supra* note 111.

111 *LeSportsac*, 754 F.2d at 77; *Taco Cabana I*, 932 F.2d at 1119; *Esercizio*, 944 F.2d at 1246; *Vuitton*, 644 F.2d at 775 (“The issue of functionality has been consistently treated as a question of fact.”); *Clarke Checks*, 711 F.2d at 982; *But see* *Unital, Ltd. v. Sleepco Mfg., Ltd.*, 627 F.Supp. 285, 290 (W.D. Wash. 1985) (“Functionality is a legal conclusion, not a factual description of

usefulness.”).

112 *Sega Enters.*, 977 F.2d at 1530-31.

113 *Id.* at 1531 (quoting *Clamp Mfg. Co. v. Enco Mfg. Co.*, 870 F.2d 512, 516 (9th Cir. 1989), *cert. denied*, 493 U.S. 872 (1989)). The Ninth Circuit noted the availability of alternative methods of manufacture requires that the court at least find “that commercially feasible alternative configurations exist.” *Id.*

114 *Stormy Clime*, 809 F.2d at 977. *See also* *Wallace Int’l Silversmiths, Inc. v. Godinger Silver Art Co.*, 916 F.2d 76, 79-80 (2d Cir. 1990) (recognizing the *Stormy Clime* factors), *cert. denied*, 111 S. Ct. 1622 (1991).

115 809 F.2d 971, 977 (2d Cir. 1987).

116 *Id.*

117 *Id.*

118 *Id.*

119 *See, e.g., Coach Leatherware*, 933 F.2d at 171 (“Lanham Act protection does not extend to configurations of ornamental features which would significantly limit the range of competitive designs available.”) (citing *Wallace Int’l Silversmiths*, 916 F.2d at 81).

120 *See, e.g., Abbott Lab.*, 971 F.2d at 21; *Wallace Int’l Silversmiths*, 916 F.2d at 79; *Spinit Reel*, 832 F.2d at 519; *Sicilia Di R. Biebow*, 732 F.2d at 429. *Cf. In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1341-42 (C.C.P.A. 1982) (discussing “functionality” of trade dress sought to be registered as a trademark).

121 *See* cases cited *supra* note 122.

122 *Sicilia Di R. Biebow*, 732 F.2d at 429.

123 *See Abbott Lab.*, 971 F.2d at 21.

124 *See, e.g., Warner Bros., Inc. v. Gay Toys, Inc.* (“*Warner II*”), 724 F.2d 327, 330 (2d Cir. 1983) (“Functional symbols (those that are essential to a product’s use as opposed to those which merely identify it) are not protected under § 43(a.)”); *Standard Terry Mills, Inc. v. Shen Mfg. Co.*, 803 F.2d 778, 781 (3d Cir. 1986) (quoting *United States Golf Ass’n v. St. Andrews Systems*, 749 F.2d 1028, 1033 (3d Cir. 1984)).

125 *See, e.g., Esercizio*, 944 F.2d at 1247; *Wallace Int’l Silversmiths*, 916 F.2d at 80-81 (noting that the legal doctrine of functionality implies only utilitarian considerations); *Vaughan Mfg.*, 814 F.2d at 350; *Standard Terry Mills, Inc. v. Shen Mfg. Co.*, 803 F.2d 778, 781 (3d Cir. 1986); *Sicilia Di R. Biebow*, 732 F.2d at 427-29.

126 *Inwood Lab.*, 456 U.S. at 850 n.10. In *Warner II*, 724 F.2d 327 (2d Cir. 1983), Judge Oakes defined the two standards under the Supreme Court’s general definition. Judge Oakes noted that a design feature is “essential” only “if the feature is dictated by the functions to be performed; a feature that merely accommodates a useful function is not enough.” *Id.* at 331. Judge Oakes also noted that a design feature “affect[s] the cost or quality” of a product if the feature allows the product to be manufactured at a lower cost, or if the feature improves the operation of the product. *Id. See also Stormy Clime*, 809 F.2d at 975 (quoting *Warner II*); *LeSportsac*, 754 F.2d at 76 (quoting *Warner II*).

127 *See, e.g., Wallace Int’l Silversmiths*, 916 F.2d at 81.

128 See, e.g., *Rushmore v. Manhattan Screw & Stamping Works*, 163 F. 939 (2d Cir. 1908); *Yale & Towne Mfg. Co. v. Alder*, 154 F. 37 (2d Cir. 1907); *Enterprise Mfg. Co. v. Landers, Frary & Clark*, 131 F. 240 (2d Cir. 1904); *Champion Spark Plug Co. v. A.R. Mosler & Co.*, 233 F. 112, 116 (S.D.N.Y. 1916). See also Bradford J. Duft, “Aesthetic” Functionality, 73 TRADEMARK REP. 151, 167-69 (1983) (explaining the early origins of aesthetic functionality); Deborah J. Krieger, *The Broad Sweep of Aesthetic Functionality: A Threat to Trademark Protection of Aesthetic Product Features*, 51 FORDHAM L. REV. 345, 362-63 (1982).

129 198 F.2d 339 (9th Cir. 1952). See also *Sicilia Di R. Biebow*, 732 F.2d at 427 (calling *Pagliari* “the most prominent definition of aesthetic functionality”); Bradford J. Duft, “Aesthetic” Functionality, 73 TRADEMARK REP. 151, 176 (1983) (discussing *Pagliari*); Deborah J. Krieger, *The Broad Sweep of Aesthetic Functionality: A Threat to Trademark Protection of Aesthetic Product Features*, 51 Fordham L. Rev. 345, 364 (1982) (same).

130 198 F.2d at 343-44.

131 *Id.* at 343.

132 See Jessica Litman, *The Problem of Functional Features: Trade Dress Infringement Under Section 43(a) of the Lanham Act*, 82 COLUM. L. REV. 77, 88 (1982); Deborah J. Krieger, *The Broad Sweep of Aesthetic Functionality: A Threat to Trademark Protection of Aesthetic Product Features*, 51 FORDHAM L. REV. 345, 372 (1982).

133 See, e.g., *Esercizio*, 944 F.2d at 1247; *Wallace Int’l Silversmiths*, 916 F.2d at 80; *Sicilia Di R. Biebow*, 732 F.2d at 428-29; *Clarke Checks*, 711 F.2d at 983 n.27; *Paraflex*, 653 F.2d at 825; *Vuitton*, 644 F.2d at 773.

134 E.g., *Sicilia Di R. Biebow*, 732 F.2d at 427-28.

135 E.g., *Paraflex*, 653 F.2d at 825.

136 See *Esercizio*, 944 F.2d at 1247; *Wallace Int’l Silversmiths*, 916 F.2d at 80; *Sicilia Di R. Biebow*, 732 F.2d at 428-29; *Clarke Checks*, 711 F.2d at 982-83 n.27; *Paraflex*, 653 F.2d at 825; *Vuitton*, 644 F.2d at 773-75.

137 *Wallace Int’l Silversmiths*, 916 F.2d at 81.

138 *Id.*

139 RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 17 cmt. c (Tent. Draft No. 2, 1990).

140 *Id.*

141 *Wallace Int’l Silversmiths*, 916 F.2d at 81.

142 *Sicilia Di R. Biebow*, 732 F.2d at 429-30.

143 See *Paraflex*, 653 F.2d at 825; *Esercizio*, 944 F.2d at 1247-48.

144 *Paraflex*, 653 F.2d at 825. See also *Shen Mfg.*, 803 F.2d at 781 (quoting *Paraflex*).

145 See *Esercizio*, 944 F.2d at 1247. The United States Court of Customs and Patent Appeals follows a similar position and requires



that the design feature be significantly related to the utilitarian function of the product. *See In re DC Comics, Inc.*, 689 F.2d 1042, 1050 (C.C.P.A. 1982).

146 *See Vuitton*, 644 F.2d at 773 (“We disagree with the district court insofar as it found that any feature of a product which contributes to the consumer appeal and saleability of the product is, as a matter of law, a functional element of that product.”).

147 *See First Brands*, 809 F.2d at 1382 n.3.

148 *See* CHARLES E. MCKENNEY & GEORGE F. LONG, III, FEDERAL UNFAIR COMPETITION: LANHAM ACT § 43(a) § 4.02, at 4-3, 4-4 (1989) (recognizing the split of authority).

149 *Fisher Stoves, Inc. v. All Nighter Stove Works, Inc.*, 626 F.2d 193 (1st Cir. 1980); *American Home Products Corp. v. Barr Laboratories*, 834 F.2d 368, 369-70 (3d Cir. 1987); *Taco Cabana I*, 932 F.2d at 1117-18 (classifying functionality as a element of a claim for trade dress infringement); *Rachel v. Banana Republic, Inc.*, 831 F.2d 1503, 1506 (9th Cir. 1987); *Ambrit*, 812 F.2d at 1535; *Reader’s Digest Ass’n, Inc. v. Conservative Digest, Inc.*, 821 F.2d 800, 803 (D.C. Cir. 1987).

150 *Stormy Clime*, 809 F.2d at 974; *LeSportsac*, 754 F.2d at 76; *Abbott Lab.*, 971 F.2d at 20 (stating that functionality is an affirmative defense as to which the defendant bears the burden of proof); *SpinIt Reel*, 832 F.2d at 520. *See also Inwood Lab.*, 456 U.S. at 863 (White, J., concurring) (noting that functionality is a defense to a suit under § 43(a) of the Lanham Act).

151 *Stormy Clime*, 809 F.2d at 977-78.

152 *Id.* at 978.

153 35 U.S.C. § 154 (1988).

154 35 U.S.C. § 173 (1988).

155 *See Stormy Clime*, 809 F.2d at 977-78.

156 *See Sega Enters*, 977 F.2d at 1531 (“The Lanham Act does not protect essentially functional or utilitarian product features because such protection would constitute a grant of a perpetual monopoly over features that could not be patented.”); *Coach Leatherware*, 933 F.2d at 171; *Vaughan Mfg.*, 814 F.2d at 349 (“The [functionality] defense exists because granting exclusive rights to functional features of products is the domain of patent, not trademark law.”); *Paraflex*, 653 F.2d at 824.

157 *See Thompson Medical*, 753 F.2d at 216 (“Where a mark is ineligible for protection, there is no need to examine likelihood of confusion.”).

158 *See* 15 U.S.C.A. § 1125(a) (1982).

159 15 U.S.C. § 1125(a)(1) (1988). As noted in the Senate report accompanying the amendment, the changes in § 43(a) created by the Trademark Revision Act of 1988 are intended only to codify existing judicial interpretation of § 43(a). S. Rep. No. 515, 100th Cong., 2d Sess., at 40 (1988), *reprinted in* 1988 U.S.C.C.A.N. 5577, 5603.

160 *See* 15 U.S.C. § 1125 (1988).

161 *Mushroom Makers, Inc. v. R.G. Barry Corp.*, 580 F.2d 44, 47 (2d Cir. 1978), *cert. denied*, 439 U.S. 1116 (1979). *See also Perini*, 915 F.2d at 127 (quoting *Mushroom Makers*); *Centaur Communications*, 830 F.2d at 1225 (quoting *Mushroom Makers*).

162 *Perini*, 915 F.2d at 128. *See also* *Communications Satellite Corp. v. Comcet, Inc.*, 429 F.2d 1245, 1251 (4th Cir. 1970) (likelihood of confusion among investors), *cert. denied*, 400 U.S. 942 (1970).

163 *See Esercizio*, 944 F.2d at 1244-45; *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 205 (2d Cir. 1979).

164 *See DeCosta v. Viacom Int'l, Inc.*, 981 F.2d 602, 607-08 (1st Cir. 1992).

165 *See, e.g.*, *W.W.W. Pharmaceutical Co. v. Gillette Co.*, 984 F.2d 567, 571 (2d Cir. 1993); *DeCosta*, 981 F.2d at 608; *Banff, Ltd. v. Federated Dept. Stores, Inc.*, 841 F.2d 486, 490-91 (2d Cir. 1988).

166 *See* cases cited *supra* note 167.

167 *See Big O Tire Dealers, Inc. v. Goodyear Tire & Rubber Co.*, 561 F.2d 1365, 1371-72 (10th Cir. 1977) (considering whether reverse confusion is actionable under Colorado law), *cert. denied*, 434 U.S. 1052 (1978); *Victory Pipe Craftsmen, Inc. v. Faberge, Inc.*, 582 F. Supp. 551, 555 (N.D. Ill. 1984) (“No federal court has directly addressed whether reverse confusion is actionable under § 43(a).”). *See also* *Plus Prods. v. Plus Discount Foods, Inc.*, 722 F.2d 999, 1003-04 (2d Cir. 1983) (implicitly recognizing that reverse confusion is actionable under section 43(a)); *Lobo Enters., Inc. v. The Tunnel, Inc.*, 822 F.2d 331, 333 (2d Cir. 1987) (same); *Yarmuth-Dion*, 835 F.2d at 995 (noting that the Second Circuit had not decided the issue of reverse confusion at that time).

168 841 F.2d 486 (2d Cir. 1988).

169 *Id.* at 491. *See also W.W.W. Pharmaceutical*, 984 F.2d at 571 (recognizing that reverse confusion is actionable in the Second Circuit).

170 *Banff*, 841 F.2d at 490.

171 *See DeCosta*, 981 F.2d at 608.

172 *Id.* at 609-10.

173 *See, Taco Cabana I*, 932 F.2d at 1122 n.9 (listing the seven factors used by the Fifth Circuit); *Esercizio*, 944 F.2d at 1241-42; *Perini*, 915 F.2d at 127; *Roulo v. Russ Berrie & Co.*, 886 F.2d 931, 937 (7th Cir. 1989); *Centaur Communications*, 830 F.2d at 1225; *Beer Nuts, Inc. v. Clover Club Foods Co.*, 805 F.2d 920, 925 (10th Cir. 1986) (citations omitted) (listing the factors used by the Tenth Circuit).

174 287 F.2d 492, 495 (2d Cir. 1961), *cert. denied*, 368 U.S. 820 (1961).

175 *Id.* The *Polaroid* factors were originally limited to products that were “noncompeting,” “noncompetitive,” or “different,” but have been extended to products that are competing. *Thompson Medical*, 753 F.2d at 214 (citations omitted).

176 RESTATEMENT OF TORTS § 729 (1938).

177 *Id.*

178 *Clarke Checks*, 711 F.2d at 981 (citing *Sun-Fun Prods., Inc. v. Suntan Research & Dev. Inc.*, 656 F.2d 186, 192 (5th Cir. Unit B Sept. 1981)).

179 *See, e.g., Chevron*, 659 F.2d at 703.

180 *See* cases cited *supra* note 175.

181 *See, e.g., Pizzeria Uno Corp. v. Temple*, 747 F.2d 1522, 1527 (4th Cir. 1984) (adding “similarity of advertising” as a factor); *Sun-Fun Prods.*, 656 F.2d at 189 (adding “previous contractual or business relations between the parties” as a consideration).

182 *See, e.g., Thompson Medical*, 753 F.2d at 214.

183 *Id.*

184 *Compare Sicilia Di R. Biebow*, 732 F.2d at 433 (according little weight to actual confusion factor) *with Ambrit*, 812 F.2d at 1543-45 (according substantial weight to actual confusion factor).

185 *Centaur Communications*, 830 F.2d at 1225 (citing *McGregor-Doniger Inc. v. Drizzle Inc.*, 599 F.2d 1126, 1131 (2d Cir. 1979)) *See also* *Bristol-Myers Squibb Co. v. McNeil-P.P.C., Inc.*, 973 F.2d 1033, 1044 (2d Cir. 1992) (“The strength of a particular mark or dress is measured by its distinctiveness or the degree to which it indicates the source or origin of the product.”).

186 *Centaur Communications*, 830 F.2d at 1225.

187 *Id.* at 1226.

188 *See, e.g., Plus Prods.*, 722 F.2d at 1005 (finding “PLUS” to be a suggestive mark but nonetheless weak); *Lever Bros. v. American Bakeries Co.*, 693 F.2d 251, 256-57 (2d Cir. 1982) (finding “AUTUMN” to be an arbitrary mark but nonetheless weak).

189 *See, e.g., Ambrit*, 812 F.2d at 1539.

190 *See, e.g., Plus Prods.*, 722 F.2d at 1006; *Lever Bros.*, 693 F.2d at 256; *Sun Banks of Florida, Inc. v. Sun Fed. Sav. & Loan Ass’n*, 651 F.2d 311, 315-16 (5th Cir. 1981).

191 *See Sicilia Di R. Biebow*, 732 F.2d at 432.

192 *Ambrit*, 812 F.2d at 1540. (citations omitted).

193 *See, e.g., Thompson Medical*, 753 F.2d at 218; *LeSportsac*, 754 F.2d at 79; *Sicilia di R. Biebow*, 732 F.2d at 432.

194 *Bristol-Myers*, 973 F.2d at 1046 (quoting *RJR Foods v. White Rock Corp.*, 603 F.2d 1058, 1060 (2d Cir. 1979)).

195 *Bristol-Myers*, 973 F.2d at 1046.

196 973 F.2d 1033 (2d Cir. 1992).

197 *Id.* at 1046. For similar holdings involving product display of trade name, *compare* *American Rolex Watch Corp. v. Ricoh Time Corp.*, 491 F.2d 877, 879 (2d Cir. 1979) (noting that the prominent display of “Ricoh” on the challenged watch eliminated consumer confusion) *and* *Bose Corp. v. Linear Design Labs, Inc.*, 467 F.2d 304, 310 (2d Cir. 1972) (“[T]here is hardly likelihood of confusion or palming off when the name of the manufacturer is clearly displayed.”) *with Banff*, 841 F.2d at 492 (finding that the attachment of the infringing user’s name did not eliminate the similarity between two marks).

198 *Sicilia Di R. Biebow*, 732 F.2d at 433 (alterations in original) (quoting *Sun-Fun Prods.*, 656 F.2d at 192).

199 *See, e.g., W.W.W. Pharmaceutical*, 984 F.2d at 573.

200 *Lang v. Retirement Living Publishing Co.*, 949 F.2d 576, 582 (2d Cir. 1991).

201 *W.W.W. Pharmaceutical*, 984 F.2d at 573 (citing *C.L.A.S.S. Promotions, Inc. v. D.S. Magazines, Inc.*, 753 F.2d 14, 18 (2d Cir. 1985)).

202 *Lois Sportswear, U.S.A., Inc. v. Levi Strauss & Co.*, 799 F.2d 867, 874 (2d Cir. 1986).

203 *McGregor-Doniger Inc. v. Drizzle Inc.*, 599 F.2d 1126, 1134 (2d Cir. 1979) (“[T]he degree of proximity between the two products is relevant here primarily insofar as it bears on the likelihood that customers may be confused as to the *source* of the products, rather than as to the products themselves.”) (emphasis in original).

204 *See Centaur Communications*, 830 F.2d at 1227. Some circuits consider this factor to be whether a likelihood exists that the senior user will expand its product lines. *See AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 354 (9th Cir. 1979); *Esercizio*, 944 F.2d at 1242.

205 *See, e.g., Nikon Inc. v. Ikon Corp.*, 987 F.2d 91, 95 (2d Cir. 1993).

206 *Centaur Communications*, 830 F.2d at 1227 (quoting *Scarves by Vera, Inc. v. Todo Imports, Ltd.*, 544 F.2d 1167, 1172 (2d Cir. 1976)).

207 *Banff*, 841 F.2d at 492.

208 *See, e.g., Centaur Communications*, 830 F.2d at 1227.

209 *Chevron*, 659 F.2d at 704. *See also Ambrit*, 812 F.2d at 1543 (“Actual consumer confusion is the best evidence of likelihood of confusion.”).

210 *See, e.g., Spinit Reel*, 832 F.2d at 522; *Ambrit*, 812 F.2d at 1543-44.

211 *Ambrit*, 812 F.2d at 1543.

212 *Safeway Stores, Inc. v. Safeway Discount Drugs, Inc.*, 675 F.2d 1160, 1167 (11th Cir. 1982)

213 *Sun Banks of Florida*, 651 F.2d at 319.

214 *Chevron*, 659 F.2d at 704-05.

215 *See, e.g., Ambrit*, 812 F.2d at 1544; *Falcon Rice Mill, Inc. v. Community Rice Mill, Inc.*, 725 F.2d 336, 345 n.9 (5th Cir. 1984).

216 *See Ambrit*, 812 F.2d at 1544.

217 *Bristol-Myers*, 973 F.2d at 1044.

218 *See, e.g., Esercizio*, 944 F.2d at 1242-43; *Bauer Lamp Co. v. Shaffer*, 941 F.2d 1165, 1172 (11th Cir. 1991); *Mobil Oil Corp. v. Pegasus Petroleum Corp.*, 818 F.2d 254, 258 (2d Cir. 1987); *First Brands*, 809 F.2d at 1385; *Beer Nuts*, 805 F.2d at 927; *M. Kramer Mfg.*, 783 F.2d at 448 n.24; *Chevron*, 659 F.2d at 704.

219 *See Beer Nuts*, 805 F.2d at 927; *Chevron*, 659 F.2d at 704.

220 *Blue Bell Bio-Medical v. Cin-Bad, Inc.*, 864 F.2d 1253, 1257 (5th Cir. 1989).

221 *See, e.g., Ambrit*, 812 F.2d at 1543 (noting that intent may be based on circumstantial evidence); *Beer Nuts*, 805 F.2d at 927-29; *Chevron*, 659 F.2d at 704.

222 *See Banff*, 841 F.2d at 492; *Centaur Communications*, 830 F.2d at 1228.

223 *Banff*, 841 F.2d at 492.

224 *See Ikon*, 987 F.2d at 95; *W.W.W. Pharmaceutical*, 984 F.2d at 575. *But see Plus Prods.*, 722 F.2d at 1006-07 (finding that the inferior quality of the junior user's product actually decreases, rather than increases, the likelihood of confusion).

225 *See, e.g., Taco Cabana I*, 932 F.2d at 1122 n.9; *Esercizio*, 944 F.2d at 1242; *Roulo v. Russ Berrie & Co., Inc.*, 886 F.2d 931, 937 (7th Cir. 1989), *cert. denied*, 493 U.S. 1075 (1990); *Fuddrucker, Inc. v. Doc's B.R. Others, Inc.*, 826 F.2d 837, 845 (9th Cir. 1987). *See also Toys "R" Us, Inc. v. Canarsie Kiddie Shop, Inc.*, 559 F.Supp. 1189, 1198 (E.D.N.Y. 1983) (considering the quality of the junior user's product under the proximity of the products factor).

226 *Bristol-Myers*, 973 F.2d at 1046. One court has stated that sophistication of the consumers could possibly increase the likelihood of confusion, depending on the circumstances of the market and the products. *Centaur Communications*, 830 F.2d at 1228.

227 *Bristol-Myers*, 973 F.2d at 1046-47.

228 *Perini*, 915 F.2d at 127-28.

229 *See id.*

230 *See Ambrit*, 812 F.2d at 1541-42.

231 *See Cin-Bad*, 864 F.2d at 1259 n.7 (including similarity of advertising and similarity of retail outlets and purchasers as two separate factors); *Ambrit*, 812 F.2d at 1538 (same); *Elby's Big Boy*, 670 F.2d at 648 (including marketing channels used as a factor); *First Brands*, 809 F.2d at 1384 n.6 (same).

232 *Clarke Checks*, 711 F.2d at 976 (quoting *Amstar Corp. v. Domino's Pizza, Inc.*, 615 F.2d 252, 262 (5th Cir. 1980)).

233 *See Ambrit*, 812 F.2d at 1541.

234 *See id.* at 1542; *Clarke Checks*, 711 F.2d at 976.

- 235     *See* cases cited *supra* note 231.
- 236     *See Thompson Medical*, 753 F.2d at 214-15; *Spring Mills, Inc. v. Ultracashmere House, Ltd.*, 689 F.2d 1127, 1135 (2d Cir. 1982). *See also* *American Chiclet Co. v. Topps Chewing Gum, Inc.*, 208 F.2d 560, 562-63 (2d Cir. 1953) (supplying the classic definition of the second-comer doctrine).
- 237     *See Pegasus Petroleum*, 818 F.2d at 259 (quoting *Harold F. Ritchie, Inc. v. Chesebrough-Pond's, Inc.*, 281 F.2d 755, 758 (2d Cir. 1960)).
- 238     *See Thompson Medical*, 753 F.2d at 214-15.
- 239     *Cf. supra* notes 219-21 and accompanying text (inference of likelihood of confusion arises if the junior user adopted the trade dress with the intent of deriving benefit from the reputation or goodwill of the senior user).
- 240     *See Thompson Medical*, 753 F.2d at 214-15.
- 241     *Elby's Big Boy*, 670 F.2d at 651 (Stevens, J., dissenting from the denial of certiorari).
- 242     *See, e.g., Falcon Rice Mill*, 725 F.2d at 344; *Jellibean, Inc. v. Skating Clubs of Georgia, Inc.*, 716 F.2d 833, 840 n.16 (11th Cir. 1983); *Squirtco v. Seven-Up Co.*, 628 F.2d 1086, 1091 (8th Cir. 1980); *Roviara Biscuit*, 624 F.2d at 377.
- 243     *See Bristol-Myers*, 973 F.2d at 1043; *Elby's Big Boy*, 670 F.2d at 651; *J.B. Williams Co. v. Le Conte Cosmetics, Inc.*, 523 F.2d 187, 191-92 (9th Cir. 1975), *cert. denied*, 424 U.S. 913 (1976).
- 244     *Elby's Big Boy*, 670 F.2d at 651.