

Trade Dress & the Store Brand Industry

by Hal Reick • Price Heneveld Cooper DeWitt & Litton, LLP

The trade dress of a product, or its packaging, is its overall appearance, including its shape, color(s), texture, and graphic elements and designs. To have a protectable trade dress, these elements must be both nonfunctional and distinctive. Examples of unprotectable functional elements of a package include a clear bottle for liquids where the color of the liquid may also indicate flavor or fragrance. Knurled caps on a container to assist in their easy removal are functional, as are dosage caps which allow measurement of a certain volume of fluid from the container and hand grips on a container to allow ease of handling. Other examples of functional features include label graphics showing dosage forms of the product (i.e., tablet, caplet, or softgel) or the use of fruit to indicate the flavor of a product.

Distinctiveness can either be in the form of an inherently distinctive design (usually a relatively unique design not normally associated with a particular product) or have acquired distinctiveness (also known as secondary meaning). Secondary meaning is obtained with long-term, exclusive use, resulting in a consumer, upon seeing a particular trade dress, recognizing the trade dress as representative of a product or packaging from a particular, albeit

unknown, source. A product itself can have a protectable trade dress only upon a showing of secondary meaning¹ whereas a package trade dress can be protectable either by being inherently distinctive (e.g., an unusual appearance) or by secondary meaning. An example of a product which has been held to have acquired distinctiveness through secondary meaning is the Owens-Corning pink insulation, which was held to have acquired secondary meaning after many years and millions of dollars in advertising the product emphasizing its pink color. Some graphic features are so common that they cannot become distinctive and, therefore, are unprotectable as a trade dress. Examples include a label showing an automobile on a car wax product, a label showing wheels on a wheel cleaning product, or a label showing a sun design for a sun screen product.

If a trade dress is found to be legally protectable (i.e., is nonfunctional and distinctive) for liability for trade dress infringement, there must be a likelihood of confusion. In the store brand industry, store brand products typically include the store brand name, trademark and/or logo prominently displayed on the product and throughout the store. One case held that such a prominent display of the well known store brand

logo on the product container would prevent a likelihood of confusion.² Courts typically, however, examine the overall appearance of the product and/or packaging, including physical elements, such as shape, size, color, texture, graphic elements, and other physical properties which are visible to the consumer at the time of purchase. Assuming that the products are prominently labeled with the store brand and include invitations to compare frequently accompanied by “compare and save” shelf talkers³, retail stores have significant latitude in their packaging to invite comparison to a national brand product without creating a likelihood of confusion.

When selecting a trade dress, care should be taken to avoid combining features of a competitor’s trade dress in the same or similar arrangement. Also, it should be kept in mind that graphic elements, if sufficiently original, can be the subject matter of copyright protection. ■

1 *Walmart Stores Inc. v. Samara Brothers Inc.*, 120 S. Ct. 1339 (2000)

2 *Conopco Inc. v. May Department Stores Co.*, 43 F.3d 1556 (Fed. Cir. 1994). *Cert. denied.* 514 U.S. 1078.

3 *American Home Products Corp. v. Barr Laboratories, Inc.*, 656 F.Supp. 1058, 1069 (D. NJ 1987) and 834 F.2d 368 (3d Cir. 1987)