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**TRADE DRESS 101: BEST PRACTICES
FOR THE REGISTRATION OF
PRODUCT CONFIGURATION TRADE DRESS
WITH THE USPTO**

*By Karen Feisthamel, Amy Kelly and Johanna Sistek**

I. INTRODUCTION

Registration of trade dress can be a challenging process for even the most experienced trademark practitioners. This article will focus on product configuration trade dress and discuss ways to overcome the two hurdles to registration: establishing non-functionality and proof of distinctiveness. The registration of other trade dress, such as packaging or color, will not be addressed. The examination guidelines of the United States Patent and Trademark Office (USPTO), as applied to product configuration trade dress in light of recent case law in this area, will be examined, as will the lessons to be learned from file histories of registrations of product configuration trade dress that were granted in various product categories, such as food, household items, and musical instruments. Lastly, “best practices” for registering product configuration trade dress will be proposed.

II. THE LEGACY OF WAL-MART

Two recent Supreme Court decisions have affected the ability to register and protect product configuration trade dress by addressing the questions of inherent distinctiveness and the evidentiary role of a prior utility patent in determining non-functionality. In 2000, in *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*,¹ the Supreme Court addressed the issue of the evidentiary burden that must be met by a plaintiff seeking to claim

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1. 529 U.S. 205, 120 S. Ct. 1339 (2000).

trade dress protection for an unregistered product configuration—the design of a dress for girls—under Section 43(a) of the Lanham Act. In the decision, the Supreme Court distinguished product design (product configuration) trade dress from word marks and packaging trade dress, and put product designs into the same category as color. The Supreme Court stated that while word marks and packaging were capable of being inherently distinctive, product designs (configurations) could never be inherently distinctive. As a result, the Supreme Court held that a plaintiff seeking to protect an unregistered product design under Section 43(a) must first establish that the product design has acquired secondary meaning (or distinctiveness).

The USPTO has incorporated the *Wal-Mart* ruling into its examination guidelines in Section 1202.02(b) of the Trademark Manual of Examining Procedure (TMPE), which provides that registration of a product configuration trade dress on the Principal Register must be supported by evidence of acquired distinctiveness. As will be discussed below, in practice that rule is inconsistently applied by Examining Attorneys.

In 2001, in *TrafFix Devices, Inc. v. Marketing Displays, Inc.*,² the Supreme Court evaluated the evidentiary role of an expired utility patent covering the features claimed in an application to register product configuration trade dress in establishing the non-functionality of the trade dress. The product configuration trade dress at issue was the shape and placement of springs attached to road signs that allowed the road signs to sway in windy conditions, rather than be blown over. The spring design had been covered by a utility patent that had been acquired by the plaintiff, but had since expired. The Supreme Court decided that an expired utility patent was strong evidence of the functionality of the asserted product configuration trade dress, but did not rule that the mere existence of the expired patent absolutely barred protection of the spring design as product configuration trade dress under the Patent Clause of the United States Constitution.³ The Supreme Court also reiterated that the *Inwood*⁴ test for functionality was still valid. The *Inwood* test factors will be discussed below. The *TrafFix* opinion also stated that if a product feature is found to be functional, it is not necessary for a court or an Examining Attorney to look at (a) the competitive need for the design, or (b) any secondary meaning the design may have garnered. The findings of the Supreme Court in *TrafFix* have been incorporated into the

2. 532 U.S. 23, 121 S. Ct. 1255 (2001).

3. U.S. Const. art. 1, § 8, cl. 8.

4. *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844 (1982).

USPTO's examination guidelines for product configuration trade dress in Section 1202.02 of the TMEP.

III. EXAMINATION REQUIREMENTS FOR DETERMINING FUNCTIONALITY

The first step in considering the registrability of product configuration trade dress (or a portion thereof) is to determine whether the product configuration is functional. This is not to be confused with whether the product configuration in question actually functions as a trademark. The product configuration sought to be protected will be found functional if it is "essential to the use or purpose of the product or if it affects the cost or quality of the product," which is commonly known as the "*Inwood* test."⁵ As the Supreme Court noted in *Qualitex Co. v. Jacobson Products Co., Inc.*:

The functionality doctrine prevents trademark law, which seeks to promote competition by protecting a firm's reputation, from instead inhibiting legitimate competition by allowing a producer to control a useful product feature. It is the province of patent law, not trademark law, to encourage invention by granting inventors a monopoly over new product designs or functions for a limited time, 35 U.S.C. §§154, 173, after which competitors are free to use the innovation. If a product's functional features could be used as trademarks, however, a monopoly over such features could be obtained without regard to whether they qualify as patents and could be extended forever (because trademarks may be renewed in perpetuity).⁶

Functional product configurations, like generic terms, cannot be registered on either the Principal or Supplemental Registers of the USPTO.⁷ Thus, if under the *Inwood* test the product configuration is found to be essential to the use or purpose of the product, or it affects the cost or quality of the product, then it will never be protectible as a trademark.

Whether the product configuration, or any of its elements, sought to be protected are functional is a fact-intensive determination, with the initial burden placed on the Examining Attorney to make a *prima facie* case.⁸ The Examining Attorney

5. *Id.* at 850 n.10.

6. *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159, 164 (1995).

7. In 1998, the Trademark Act was amended to codify the long held practice of the USPTO to preclude registration of functional product configuration on either the Principal or Supplemental Register. Technical Corrections to Trademark Act of 1946, Pub. L. No. 105-330, § 201, 112 Stat. 3064, 3069.

8. TMEP § 1202.02(a)(iv)

cannot issue a refusal based on functionality without supporting evidence.⁹ Since the Examining Attorney must consider how the proposed product configuration is used before determining functionality, the issue of functionality is generally not raised in intent-to-use applications until an Amendment to Allege Use or a Statement of Use has been filed.¹⁰ However, as a courtesy, the Examining Attorney may give an advisory statement in a first Office Action that a functionality refusal may be anticipated upon the filing of an allegation of use.¹¹

Until the 2003 revision to the TMEP, the USPTO's examination guidelines drew a distinction between trade dress that was *de facto* functional and trade dress that was *de jure* functional. This distinction, which had its roots in *In re Morton-Norwich, Inc.*,¹² breaks down as follows: A product configuration comprising a superior design essential for competition was *de jure* functional, and non-registrable. On the other hand, a product configuration that has some functional or utilitarian purpose, but is not a superior design essential for competition, was considered *de facto* functional, and registrable upon a showing of acquired distinctiveness.¹³

With the issuance of the revised TMEP in 2003, the USPTO updated the examination guidelines to reflect the holdings in *Qualitex*, *Wal-Mart* and *TrafFix*, and their impact on, *inter alia*, the registrability of product configuration trade dress. In so doing, the USPTO recognized that the distinction between *de jure* and *de facto* functionality was no longer relevant, at least semantically, and by and large, Examining Attorneys should no longer raise the distinction when addressing functionality.¹⁴ Though the USPTO recognizes the Supreme Court's reaffirmation of the *Inwood* rule (if the configuration or feature of the product is essential to the use or purpose of the product, or affects the cost or quality, it is not necessary to consider whether competitors need to use the design) an applicant seeking to register product configuration trade dress can still anticipate queries from the Examining Attorney into the following areas, commonly referred to as the *Morton-Norwich* factors, namely:

9. *Id.*

10. TMEP § 1202.02(e)

11. *Id.*

12. 671 F.2d 1332 (C.C.P.A. 1982). *See also* TMEP § 1202.02(a).

13. *Id.*

14. *See* TMEP § 1202.02(a)(iii)(B); *See also In re Ennco Display Systems, Inc.*, 56 U.S.P.Q.2d 1279, 1280 (T.T.A.B. 2000).

- (1) whether a utility patent, either in force or expired, exists that discloses the utilitarian advantages of the design sought to be registered;
- (2) whether the applicant has advertising that touts the utilitarian advantages of the design;
- (3) whether alternative equally functional designs are available to competitors; and,
- (4) whether the design results from a comparatively simple or inexpensive method of manufacture.

In reconciling the continued reliance on the old *Morton-Norwich* factors, the Court of Appeals for the Federal Circuit has concluded that it is still appropriate to consider whether alternate designs are available in the overall process, as it can be a “legitimate source of evidence to determine whether a feature is functional in the first place.”¹⁵

If the product configuration in question is the subject of a utility patent that discloses the utilitarian advantages of that configuration, under *TrafFix*, the applicant bears an especially “heavy burden of overcoming the strong evidentiary inference of functionality,” and Examining Attorneys have been given guidance to issue a final refusal on functionality.¹⁶ If a configuration is not the subject of a utility patent, that does not necessarily mean that a functionality refusal will be avoided, as an Examining Attorney may still make out a *prima facie* case of functionality by relying upon evidence stemming from the other *Morton-Norwich* factors.

It should be noted that Examining Attorneys will conduct their own research to assess the *Morton-Norwich* factors by checking computer databases and the Web for both the applicant’s promotional materials as well as those of competitors, and by checking trade journals and the like.¹⁷ Nonetheless, the applicant is generally the better source for the most relevant materials, and the applicant can be expected to provide advertising or promotional materials, as well as information about the production process of the product, such as whether it is less expensive to produce than other designs, and whether other designs exist. Applicants are cautioned to be aware of whatever advertising or promotional materials exist that highlight or otherwise emphasize

15. *Valu Engineering, Inc. v. Rexnard Corp.*, 61 U.S.P.Q.2d 1422, 1427 (Fed. Cir. 2002).

16. *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 27 (2001); TMEP § 1202(a)(v)(B).

17. TMEP § 1202.02(a)(v).

the advantages to be gained from the product configuration in question.¹⁸

A word should be said about “aesthetic functionality.” The concept is often confused with ornamentation, which serves as the basis for a refusal under Sections 1, 2 and 45 of the Lanham Act, and involves an inquiry into whether a proposed design functions as a trademark, or is merely seen as decorative or ornamental. Aesthetic functionality had been slowly finding disfavor among courts as a viable legal principle, and had been largely discounted by the pre-cursor to the Federal Circuit,¹⁹ but it was given new life in *TrafFix*, when the Supreme Court referenced the principle, albeit in dicta, while distinguishing its earlier decision in *Qualitex*. Aesthetic functionality, as explained by the USPTO, involves instances in which:

[T]he nature of the proposed mark makes it difficult to evaluate the functionality issue from a purely utilitarian standpoint. This is the case with color marks and product features that enhance the attractiveness of the product. The color or feature does not normally give the product a truly utilitarian advantage (in terms of making the product actually perform better), but may still be found to be functional because it provides other real and significant competitive advantages and thus should remain in the public domain.²⁰

Accordingly, Examining Attorneys are counseled that competitive need is a relevant consideration when assessing whether a product configuration is aesthetically functional, though they are also cautioned that the instances in which analysis of aesthetic functionality and inquiries into competitive need are appropriate will be infrequent.²¹

IV. EXAMINATION REQUIREMENTS FOR DETERMINING ACQUIRED DISTINCTIVENESS

As discussed above, *Wal-Mart* established that product configuration trade dress can never be inherently distinctive. The TMEP has incorporated that rule in Section 1202.02(b)(i), which requires that Examining Attorneys issue refusals in all applications seeking registration of product configuration trade dress unless the applicant claims that the trade dress has acquired

18. See, e.g., *In re Gibson Guitar Corp.*, 61 U.S.P.Q.2d 1948, 1950 (T.T.A.B. 2001) (holding the design of a guitar body was functional, noting the applicant’s literature clearly stated the shape of the guitar produced a better sound).

19. See *In re DC Comics, Inc.*, 689 F.2d 1042 (C.C.P.A. 1982).

20. TMEP § 1202.02(a)(iii)(C).

21. *Id.*

distinctiveness under Section 2(f) of the Lanham Act and the applicant includes sufficient evidence to show that the trade dress has acquired such distinctiveness.

The guidelines for establishing acquired distinctiveness are generally covered by the TMEP in Section 1212. There, the TMEP lays out three types of acquired distinctiveness evidence: (1) ownership of one or more prior registrations on the Principal Register for the same mark, for related goods; (2) five years of continuous and exclusive use of the mark; and (3) actual evidence of acquired distinctiveness. The first type of evidence is not typically found in product configuration trade dress cases, since a product configuration trade dress is likely to be limited to one type of product. For example, the Coca-Cola bottle shape is used for selling cola drinks, and is unlikely to be used for a different type of product, such as beer. The second type of evidence, five years of use, is the easiest to obtain and submit. The applicant need only obtain and submit an affidavit at the time of filing an application or in a later-filed submission that states that the mark set forth in the application has been in continuous and exclusive use in commerce for at least five years prior to the date of the affidavit. A declaration under 37 C.F.R. § 2.20 or 28 U.S.C. § 1746 may be submitted in lieu of an affidavit.²²

In product configuration trade dress cases, an Examining Attorney will likely require more than a mere affidavit under Section 2(f). TMEP § 1212.05(a) recommends that in such cases, the Examining Attorney should require the applicant to provide evidence that the design is perceived as a source identifier for the particular goods recited in the application. The rule outlined in 37 C.F.R. § 2.41 and TMEP § 1212.06 states that an applicant may submit as evidence of distinctiveness: declarations with information regarding the duration, extent, and nature of the use of the mark; advertising expenditures; statements from the trade and/or public; and other appropriate evidence. Basically, an applicant needs to explain to the Examining Attorney how the mark is used and show how effective that use has been in establishing the mark as a source identifier in the minds of the purchasing public.

An applicant and its trademark counsel should consider preparing the following types of evidence as suggested by TMEP § 1212: (1) a declaration from an appropriate in-house source (*e.g.*, Controller, Chief Financial Officer, sales executive) with sales figures for the relevant goods in dollar amounts and units, for the past five years, and information regarding the geographical extent of sales within the United States; (2) a declaration from an

22. TMEP § 804.01(b).

appropriate in-house source (*e.g.*, a marketing executive) regarding advertising expenditures, the channels or media used for distribution of advertisements, and the number of advertisements placed, over the past five years, accompanied by sample advertisements that point out the product; and (3) declarations from distributors, dealers, and/or customers that assert recognition of the product configuration as originating with the applicant.

The TMEP makes it clear that the type and quantity of evidence needed to establish acquired distinctiveness will vary depending on the nature of the product configuration trade dress. That gives Examining Attorneys quite a bit of leeway in what they will require and, as will be discussed below, a review of USPTO file histories indicates that the range of evidence required by Examining Attorneys has varied widely.

V. LESSONS LEARNED FROM EXISTING USPTO PRODUCT CONFIGURATION TRADE DRESS REGISTRATIONS

In order to determine the “best practices” for registration of product configuration trade dress, it is helpful to see how earlier trademark applicants have made their way successfully to registration. The authors have reviewed file histories from three different categories of goods: food products in Classes 29 and 30; furniture and household goods in Classes 20 and 21; and musical instruments in Class 15. As set forth in more detail below, the file histories were illustrative of the evidence that has been required, if any, to show that product configuration trade dress had acquired distinctiveness and was thus registrable on the Principal Register of the USPTO.²³

A. Product Configuration for Food Products in Classes 29 and 30

The file histories of existing post-*Wal-Mart* registrations of product configuration trade dress of food products in Classes 29 and 30, ranging from snack foods to main dishes to candy, were reviewed. In general, the applicants were required to include a declaration of acquired distinctiveness under Section 2(f), based on

23. “The indication of the applicant’s intent to rely on § 2(f) can take a variety of forms, for example, a statement that registration is requested under § 2(f); a statement that the mark has become distinctive, or that the applicant believes the mark has become distinctive of the goods or services in commerce; the statement relating to five years’ use in commerce as suggested in § 2(f); or a statement that evidence is being submitted in support of acquired distinctiveness.” TMEP § 1212.07.

five or more years of use in commerce, and also to submit additional evidence of acquired distinctiveness. A couple of lucky applicants, such as Stella d'Oro, the owner of the S-shaped breakfast cookie, and Dippin Dots, the owner of the bead-shaped, freeze-dried ice cream, were able to obtain registration simply upon the strength of the Section 2(f) declaration based solely on extended use. However, in general, applicants needed to submit evidence of sales and advertising, as well as declarations from customers or dealers. The registrations that were reviewed are summarized in the table below:

Product Configuration/ Reg. No.	Section 2(f) Claim (by amendment, unless noted)	Years of Use	Additional Evidence
Leaf Design on butter patty 2,8245,26	Yes	25 years	None required
Dippin Dots multi-colored freeze-dried ice cream 2,756,102	Yes (in application)	9 years	None required
Pineapple- shaped cookies 2,934,375	Yes	5 years	Sales, advertisements, customer declarations, publicity
S-shaped cookie 2,904,812	Yes	44 years	None required
Corn chips shaped like a tortilla bowl 2,766,278	Yes	1 year	Declaration from marketing staff with advertising expenditures, sales, photographs
Cracker shaped like a butterfly 2,766,278	Yes	24 years	Declarations from marketing and controller with sales and advertising expenditures

Product Configuration/ Reg. No.	Section 2(f) Claim (by amendment, unless noted)	Years of Use	Additional Evidence
Lollipop shaped like a snowman 2,899,321	Yes	2 years	Customer and dealer declarations; declaration from executive with sales and advertising figures
Cookie/candy stick 2,615,119	Yes (in application)	9 years	Prior U.S. registration for related goods
Chocolate shaped like an umbrella 2,776,806	None required	Not submitted	None required

***B. Product Configuration Trade Dress for
Furniture and Furnishings in Classes 20 and 21***

File histories for furniture and household related products in Classes 20 and 21, including chairs, bed frames, lamps, glass candle holders and the like were also reviewed. As one would expect, these applicants were generally required to include a claim of acquired distinctiveness under Section 2(f), although the amount of additional supporting evidence required varied. While some of the applicants had to submit evidence of sales and advertising, as well as declarations of customers and distributors, others were able merely to point to more than five years of use in commerce. To the extent one central theme existed, those who submitted their evidence of acquired distinctiveness at the time of filing the application, or before USPTO examination, appeared to avoid any challenges to the sufficiency of the evidence provided. The registrations that were reviewed are summarized in the table below:

Product Configuration/ Reg. No.	Section 2(f) Claim	Years of Use	Additional Evidence
Children's chair in ladder-like form 2,796,663	Yes	30+ years	Distributors letters, advertising and sales figures, third party designs

Product Configuration/ Reg. No.	Section 2(f) Claim	Years of Use	Additional Evidence
Container lid with raised surfaces axially radiating from center 2,833,638	Yes	35 years	None required
Chair with metal frame and leather cushions 2,893,025	Yes	49 years	Submitted with application: advertisements, catalogs, third party commentary; sales and advertising figures; declaration of museum curator
Stools with metal frame and leather cushion 2,894,977	Yes	49 years	Submitted with application: advertisements, catalogs, third party commentary; sales and advertising figures; declaration of museum curator
Sofa with metal frame and leather cushions 2,894,980	Yes	49 years	Submitted with application: advertisements, catalogs, third party commentary; sales and advertising figures; declaration of museum curator
Table with metal base and glass top 2,894,979	Yes	45 years	Submitted with application: advertisements, catalogs, third party commentary; sales and advertising figures; declaration of museum curator

Product Configuration/ Reg. No.	Section 2(f) Claim	Years of Use	Additional Evidence
Vase with curved mouth/base shape 2,708,713	Yes	13 years	Dealer and consumer letters, advertising and sales material; advertising and sales figures
Dispenser for pre-moistened wipes 2,942,442	None required	Not submitted	None required
Dispenser for napkins 2,825,879	None required	Not submitted	None required
Plastic mailbox body and post 2,831,220	Yes	9 years	Sales and advertising figures, samples of promotional and advertising materials, including sell sheets and trade show displays, unsolicited media coverage
Plastic mailbox body and post with bin for newspaper 2,873,136	Yes	9 years	Sales and advertising figures, samples of promotional and advertising materials, including sell sheets and trade show displays, unsolicited media coverage
Array of square holes arranged in rows and columns in the bottom flat straining portion of a floor sink filter basket. 2,915,510	Yes	17 years	Sales and advertising figures

Product Configuration/ Reg. No.	Section 2(f) Claim	Years of Use	Additional Evidence
Penguin wearing a hat, all of which forms a container 2,635,420	None required	Not submitted	None required
Three dimensional glass candlestick holder with long stem (in various shapes) ²⁴ 2,752,827; 2,771,468; 2,771,469; 2,771,470; 2,771,475; and 2,771,477	Yes (in application)	5 years	None required
Birdfeeder, with perch members and a pitched roof 2,852,855	Yes (submitted as preliminary amendment before examination)	11 years	Declaration of generalized sales; advertising and promotional materials showing use of "mark"

24. These marks registered without any refusals by the Examining Attorney, notwithstanding an unpublished decision by the TTAB in *In re Libby Glass, Inc.* (App. Ser. No. 75/250,499, Sept. 28, 2000) finding an applicant's submission of a declaration of more than five years use, along with advertisements, sales and advertising figures, were insufficient to show that the configuration of a beverage glass had been promoted and recognized as a trademark.

Product Configuration/ Reg. No.	Section 2(f) Claim	Years of Use	Additional Evidence
Basket design of a woven basket weave upper portion and metal patterned badge or base with silver coloration 2,777,215	Yes	10+ years	Print ads, sales and advertising figures, promotional materials, statements from gallery owners, dealers and collectors
Three dimensional figurine head 2,701,748	Yes	8 years	Sales and advertising figures, consumer declarations, samples of catalogs and promotional materials showing channels of trade
Plastic pocket handle for boxes 2,682,347	Yes	12 years	Sales and advertising figures, Central District California decision granting summary judgment, holding valid trademark; settlement agreement with competitor
Three dimension brushhead portion of a power tooth brush 2,733,754	Yes	5 years	Successfully argued 5 years use was sufficient

***C. Product Configuration Trade Dress
for Musical Instruments in Class 15***

Also reviewed were post-*Wal-Mart* file histories for applications to register product configuration trade dress for various musical instruments or musical implements in Class 15.

As illustrated by the chart below, while product configuration trade dress for guitar headstocks are quite common, there are also product configuration trade dress applications and registrations for guitar bodies, capos, music stands, and even harmonicas. Upon the Examining Attorney's initial refusal, most often due to functionality or the matter not functioning as a trademark, many applicants successfully rebutted the functionality refusal but could not establish sufficient grounds or produce sufficient evidence to prove acquired distinctiveness. Consequently, many applicants amended their applications to seek registration on the Supplemental Register. Those considering registration of product configuration trade dress in musical instruments are encouraged to review a recent article on this topic, which may provide further guidance.²⁵

Most of the application files reviewed that contained Class 15 goods did not include claims of acquired distinctiveness at the time the applications were filed. Instead, the applications were amended to claim Section 2(f) acquired distinctiveness during the USPTO's examination process. In at least one instance, the acquired distinctive evidence was rejected, and the application was amended to seek registration on the Supplemental Register. (*See* Reg. No. 2,935,596.)

The registrations that were reviewed are summarized in the table below:

Product Configuration/ Reg. No.	Section 2(f) claim	Years of use	Additional Evidence
"Frame guitar" configuration 2,956,986	Yes	0 years	Advertising, promotional materials, testimonials, magazine articles
Musical instrument cases 2,910,709	None required	Not submitted	None required

25. Robert M. Kunstadt and Ilaria Maggioni, *Tell Tchaikovsky the News: Trade Dress Rights in Musical Instruments*, 94 TMR 1271 (2004).

Product Configuration/ Reg. No.	Section 2(f) claim	Years of use	Additional Evidence
Design configuration of a cover plate for harmonica 2,963,857	Yes (with application)	21 years	Submitted with application: declaration of applicant and promotional brochures, selected advertisements, news article submitted upon filing
Hooked-shaped guitar headstock 2,741,204	Yes	16 years	Declaration of Chief Financial Officer, examples of competitors' marks applied to headstocks; advertising, declaration from guitar dealers and consumers
Guitar body and headstock with rounded trapezoidal shape 2,890,729	Yes	9 years	Evidence of other guitar body designs; prior U.S. Registrations for guitar shapes
Guitar body and headstock with teardrop shape 2,768,761	Yes	9 years	Evidence of other guitar body designs; prior U.S. Registrations for guitar shapes
Compact guitar body shape with folding, collapsible leg rest 2,768,741	Yes	9 years	Photos of other compact travel guitar designs

VI. “BEST PRACTICES” FOR REGISTRATION OF PRODUCT CONFIGURATION TRADE DRESS

An applicant seeking to register a product configuration trade dress should first read TMEP § 1200 (available online at the USPTO website www.uspto.gov), and specifically TMEP § 1202.02, in its entirety. This will offer valuable insight into how the examining corps will approach an application to register a “product configuration trade dress” trademark.

The two hurdles an applicant and its counsel will face in seeking to register product configuration trade dress are (1) proving the asserted mark is non-functional, and (2) proving the asserted mark has acquired distinctiveness. Regarding the non-functionality issue, it would be prudent for counsel to review the *Morton-Norwich* factors with the applicant **before** filing an application in order to determine whether there are any factors that might defeat the application. In particular, if the counsel is not the applicant’s patent attorney, counsel should find out from the applicant if any portion of the product configuration trade dress was previously covered by a utility patent. Counsel should ask for copies of the applicant’s most recent advertisements for the goods identified by the asserted mark and review them to see if the applicant is promoting utilitarian advantages of the claimed product configuration trade dress. If that is the case, counsel may have to recommend to the applicant that it modify its advertising to promote the product configuration trade dress as a source identifier (*i.e.*, “look-for” advertising), rather than as a source of a utilitarian advantage. It appears from the file histories reviewed above that non-functionality becomes a determining factor in applications to register product configuration trade dress marks that are used with household items that typically have a utilitarian purpose, more so than product configuration trade dress for goods such as food products (*e.g.*, a goldfish-shaped cracker), where the shape makes the item attractive.

Counsel and the applicant should also confer, prior to filing, regarding the probable need to prove acquired distinctiveness. Although in some cases an application may be granted based on five years of continuous and substantially exclusive use of the product configuration trade dress as a mark and the filing of a corresponding Section 2(f) declaration, the TMEP guidelines direct Examining Attorneys to require more evidence than just that declaration. Consequently, early on in the application process, counsel should warn applicants of the likely need to gather evidence of sales and advertising, as well as declarations from customers and distributors of the types discussed above.

VII. TIPS FOR SEARCHING PRODUCT CONFIGURATION TRADE DRESS MARKS

Compared with adoption of a word mark or logo, it is not as likely that an applicant or its counsel will conduct a clearance search for a product configuration trade dress mark. Typically, the subject product design has been in use for some time prior to initiation of the application process. However, it may be prudent before proceeding with an application to conduct a search of the USPTO database to determine whether the proposed product configuration trade dress mark is similar to product configuration trade dress marks that have previously been registered, or are the subject of pending applications. Such a search will also provide some guidance as to how others have described product configuration trade dress marks or complied with other application formalities. As searching the USPTO database for product configuration trade dress can be a frustrating process, some guidance is offered here.

The process for U.S. trademark applications does not require the applicant (or the Examining Attorney for that matter) to classify the mark as a traditional mark or as a nontraditional mark. Rather, the applicant may display its mark in one of two USPTO-recognized formats: “Standard Characters” or “Stylized and/or Design.” Nontraditional marks are categorized into the latter format, but not all “Stylized and/or Design” marks are nontraditional. As a result of this lack of discrimination between types of marks, it can be quite challenging to locate nontraditional marks on the U.S. Registries. There is no searchable field for “color marks,” “product design” or “trade dress.” Therefore, when searching the Registries, one must resort to skilled searching strategies—and luck—to bring forth the desired marks. For any system so heavily reliant on the accuracy of data entered, searchers of the Registries are at the mercy of those who key in the application details and all amendments thereto to make sure one can pull up every application and every registration that should fall within the search strategy.

So what “skilled searching strategy” identifies nontraditional marks, and specifically product configuration trade dress? First, become familiar with the various searchable fields available, such as “Owner” and “International Class.” Probably the most useful searchable field is “Description of Mark.” Ideally, all nontraditional marks will have a reliable entry in this field that identifies the specifics of the claimed mark, beginning with the prompt, “The mark consists of _____ (*fill in the blank*).” In a perfect system for Registry searchers, this field might serve as an optimal location to find clues to the presence of product configuration trade dress applications and registrations. One might search for the term “configuration” within the “Description

of Mark” field. Of course, that search alone will net far more hits than could be realistically reviewed. One should therefore consider ways to refine that search to the desired types of marks, such as by combining this search with a relevant International Class, such as Class 33 for alcoholic beverages or Class 15 for musical instruments. While such a combined search might help narrow the results to a manageable number of hits, there is no guarantee that (1) all product configuration trade dress marks that fall within that Class have been captured, or that (2) this search in fact only captured product configuration trade dress marks.

One should review the search results received to this point to see if other terms are commonly used to describe the desired product configuration trade dress marks, such as “shape” or “body,” or perhaps the generic name of the item itself, such as “bottle” or “guitar.” Another way to tailor a product configuration trade dress search would be to use the “Goods/Services” field to identify relevant goods, such as “cosmetics” or “furniture.” In some circumstances, it may be possible to narrow the search even further by identifying the appropriate U.S. Classification that is generally more specific than the International Classification.

When searching, creativity is a virtue. No single strategy or set of strategies will always be the winning combination. Searching for any type of nontraditional mark, and especially product configuration trade dress marks, requires persistent and malleable attacks on several fronts. Of course, any discussion of electronic searches must include the requisite caveat that relying on strategies that are too narrow will not solicit all (or hopefully all) of the applications and registrations that should be considered.

Once the searching has been completed, attention is then turned to the substance of the search results themselves. Depending upon the goods for which the search was conducted, one of the most obvious conclusions will be that the application or registration record obtained is not a product configuration trade dress mark at all. In fact, a broad search of “configuration” as a term used in the “Description of Mark” field will yield thousands of hits, while only a portion of those are indeed product configuration trade dress files. The term “configuration” is often used in its common dictionary definition sense to refer to a structural arrangement of parts or elements, and it is not intended as a term of art. A search of “configuration” in the “Description of Mark” field in a Class 25 search will generate over 150 hits, but just a few are truly applications or registrations for product configuration trade dress marks. For example, Registration No. 2,402,945 is for a long list of clothing items, including socks, undergarments, head wear, ski hats, athletic uniforms, sweat suits and gloves. The description of the mark reads, “The mark consists of a three-dimensional configuration of a hanging container with convex sides, a

rectangular slit on the bottom, and a hole on the top, which wraps around applicant's wool clothing." One might convincingly argue that this registration—and many others like it—are for product packaging trade dress and not product configuration trade dress. Another example is Registration No. 2,218,513 for infant and children's clothing, which is described as a mark consisting of "a three-dimensional configuration of a Chinese food restaurant take-out pail." Clearly, the products at issue, infant and children's clothing, do not resemble a Chinese take-out box. Again, this is a packaging mark only.

Conducting a search for registered or pending product configuration trade dress marks may be difficult. A review of the results as well as the associated file histories can provide further suggestions for the best approach to take to successfully register a specific product configuration trade dress as set forth within this article.
