

Using Trade Dress to Protect Your Intellectual Property, With or Without a Patent

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Patents, trademarks and copyrights are familiar concepts in protecting the product emerging from today's competitive business environment. A relatively new tool, trade dress, is not as well known but is equally powerful in protecting invaluable intellectual property rights. Globally, trade dress is rapidly becoming a dominant force. The wise business person or entrepreneur will take a few moments to learn how trade dress law can work to their benefit.

What exactly is trade dress? Trade dress is the "total image." It is the overall "look and feel" of a product. Trade dress is very broad, covering the design of a particular product-including arbitrary combinations of "useful" or functional features - and even the product's packaging. The term applies to restaurant decor, both interior and exterior, and the written materials used in brochures, texture and finishes, color combinations, design elements, artwork, logos, signs, shapes, sounds smells, and many other features of a business or its product.

Trade dress is one of the hottest areas of law today in the world. There are probably hundreds of cases involving trade dress cited each year, mainly in the federal courts. In fact, the last two intellectual property law cases the United States Supreme Court decided - one in 1991, the other in 1996 - both centered on trade dress law issues. There is a constant debate going on these days over where trade dress has stretched too far or is still stretching.

So broad is trade dress as the courts are currently interpreting it, that the Supreme Court has said, that even a single color can be protected as trade dress, under the right circumstances. In *Qualitex v. Jacobsen*, the court said that the distinctive green-gold color used by the manufacturer of a pad for dry cleaning presses, was protectable and had been infringed by a similar color used by a California competitor. The court also ruled that this particular color could actually be registered in the United States Patent and Trademark Office as a trademark. Indeed, the PTO has been allowing such registrations for a number of years, ever since it allowed registration of the color pink by Owens-Corning for fiber-glass insulation.

One of the most controversial points is whether trade dress protection applies even to product designs which are not patented, or protects them after a utility or design patent expires, and the extent to which having a utility patent covering product features does or not knock out trade dress protection. The last issue is really an open question in the Ninth Circuit Court of Appeals, which covers California cases. And to some extent in the Court of Appeals for the Federal Circuit, which hears appeals in patent cases.

There are countless examples of trade dress in almost every industry. The design of the product, THE CLUB, which many people have seen or used, has been litigated many times, including here in Southern California. Recently, several prominent golf course

owners, notably Pebble Beach, sued to protect the visual appearance of their well-known golf holes, which a Texas company had allegedly copied "to the tee."

The Nature Company sued one of its competitors for allegedly copying the overall appearance and scheme of its retail stores. A Mexican restaurant successfully sued another one for copying the distinctive look of its theme restaurants, and was awarded damages. The U.S. Supreme court upheld this result.

Biotechnology companies in Orange County have trade dress rights, including pharmaceutical colors and color combinations, as do companies producing medical devices. Jewelry designers have trade dress rights in their product designs. The list is endless. The author has even litigated such esoteric items as compensators used on gun barrels, which were protected by a temporary restraining order and a preliminary injunction in the local federal courts; commercial fire sprinkler heads found in hotel ceilings and elsewhere; the overall appearance of furniture and lighting fixtures; and is currently working on trade dress registration of, among other things, the overall appearance of AMERICAN AIRLINE planes, and the distinctive shape of the MARTINELLI'S apple juice bottle.

Trade dress can be protected by filing a federal trademark application to register it, just like any other protectable trademark. Ultimately, a suit can be filed if trade dress is infringed, which allows for an immediate injunction to stop the copying, an award of damages, lost profits and other appropriate monetary relief as appropriate. Ample relief is available under the right circumstances, including attorneys' fees, and up to three times your normal damages or punitive damages where your rights have been flagrantly ignored.

And that, in a nutshell, is the broad, strong protection available under trade dress law, whether or not you have, could have had, or had a patent on your product or service, subject to certain limits in certain courts.

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